

HERBERT SMITH FREEHILLS RESPONDS TO LANDMARK EU COURT RULING ON SCOPE OF TRADE MARK PROTECTION ACROSS EU

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Deals and cases

Responding to news that the Court of Justice of the EU (EU Court) has provided clarification on the use of trade marks as a tool to protect market share, [Joel Smith](#), head of intellectual property UK at Herbert Smith Freehills, says that “the outcome is very favourable to existing trade mark proprietors, as it rejects the notion that trade marks risk being found invalid entirely, if applicants applied in bad faith with no intention of using them fully, at the time of filing an application.”

The EU Court also rejected a separate ground of attack that a lack of clarity or over-broad specification for the trade mark could be a basis for invalidity.

He adds: “Critics will say that the judgment fails to address or regulate the ever increasing thicket of wide registrations and leaves the burden on third parties to contest – but the ruling is succinct and makes it clear that revocation for non-use, after the event, is still possible if the particular goods or services were not in use after 5 years. It certainly seems that the decision favours the status quo for companies to file to protect key brands, taking into account the realistic likely areas of expansion of their use of the trade mark over time.”

Ahead of the judgment, concerns had been raised in some quarters about the extent to which it could be applied in the UK, post Brexit.

Smith, a trade mark specialist, says: “Any business protecting new brands would still be wise to look carefully at what scope they filed for and be clearer in specifying exactly what goods or services they intend to protect. This decision will continue to impact businesses in the UK despite the UK leaving the EU as it emanates from a reference made by the UK High Court. After the UK leaves the EU, the reality is that UK courts are likely to continue TO apply EU case law in this area, given our laws are already so closely aligned. The UK will though lose the ability to influence the outcome, plus it will no longer have a judge representative on the EU Court.”

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