

TaylorWessing

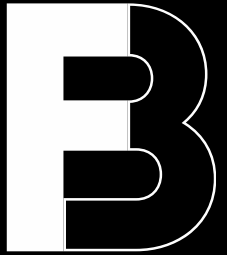
After Brexit - where to sue

4 November 2021 | Jason Rawkins, Inès Tribouillet, Marie Keup, Maarten Rijks and Olaf Gillert

Brands Forum 2021



Scenarios



- Harmonised EU law – EU Trade Mark Regulation and IP Rights Enforcement Directive
- EUTM enforcement
- National TM enforcement
- Cancellation actions

Jurisdiction over EU trade mark infringement proceedings



EUTM infringement proceedings to be brought in courts of Member State where the defendant is based; if defendant non-EU then where claimant based; if claimant also non-EU, then Alicante court. These proceedings can apply to all or as many of the EU Member States as the Claimant elects.

EUTMR 2017/1001 Art 125 (1) (formerly 97(1)) ***and Art 126*** (formerly 98)

> **Impact of Brexit on UK companies?**

OR

"Proceedings may also be brought in the courts of the Member State in which the act of infringement has been committed or threatened". These proceedings can only apply to that particular Member State.

EUTMR 2017/1001 Art 125 (5) (formerly 97(5)) ***and Art 126*** (formerly 98).

Where does act of online infringement occur?

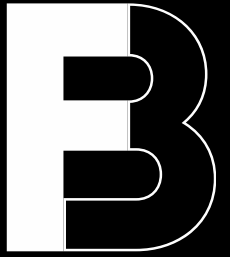


Following CJEU in *AMS Neve v Heritage Audio SL* (2019), Art 125(5) EUTMR means suit may be brought where "the consumers to whom that advertising and those offers for sale are directed are located", notwithstanding that the defendant took decisions and steps in another Member State to bring about that online display.

Whether a website is directed at a particular country is a multi-factorial test which depends on all the circumstances, e.g.

- ▶ Things which can be inferred from looking at content on website itself
- ▶ Elements arising from inherent nature of services offered by website
- ▶ Number of visitors accessing the website from that country

The Courts



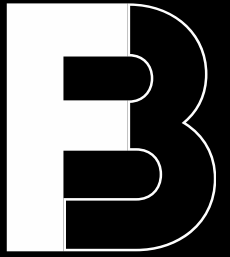
- IP expertise of courts?
- How long to a judgement?
- Preliminary injunctions
- Speedy trials
- Costs/costs recovery
- Language
- Forum shopping within a country

Cancellation actions



- Where can cancellation attacks be made?
- Torpedos

Other national quirks



- Sweden company names
- Austria cross-examination for preliminary injunction
- Benelux: additional grounds for trade mark infringement (Art 2.20(2))
- Court actions in Alicante