

## Suggested Answers to the Questions in Chapter 14

### 1. How does the scope of the 'own name defence' differ under EU and UK trade mark law?

The good answer will:

- Explain that s. 11(2)(a) permits the defendant to make use of his own name and address, so that the registration of a surname or geographical name does not amount to a complete monopoly. The subsection contemplates that the defendant's name or address consists of or contains another's registered trade mark (*Céline*).
- Discuss relevant case law, such as *Reed Executive plc v Reed Business Information Ltd*, *IBM Corporation v Web-Sphere Ltd*, *WEBSHERE*, *Hotel Cipriani Srl v Cipriani (Grosvenor Street) Ltd* [2010] RPC 485 etc.
- Note that under UK law, the own name defence applies to both natural persons and corporate entities.
- Indicate that this is no longer the case with EU law: Art. 1(13) Regulation 2015/2424 abolished Art.12(a) of Regulation 207/2009 and limited the application of the defence to natural persons only (*Sky Plc v Skykick UK Ltd* [2017] EWHC 1769 (Ch); [2017] ETMR 42); and the recast Directive has limited this defence to use of personal names and addresses, as was originally intended (Art. 14(1)(a)).
- Explain that the defence is available on condition that such use is in accordance with honest practices in industrial or commercial matters. The defence hence contains a duty to act fairly in relation to the legitimate interests of a trade mark proprietor (*Maier v ASOS* [2015] EWCA Civ 220; [2015] ETMR 26).

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2. In developing its case law on exhaustion of rights under Art. 7 of the Trade Marks Directive, the Court of Justice has all but forgotten the origin function of trade marks. Discuss.

The good answer will:

- Explain how exhaustion of rights acts as a defence to trade mark infringement (and to the infringement of other categories of intellectual property rights).
- Explain what exhaustion means ('put on the market' with the consent of the owner) and how the wording of Article 7 Trade Marks Directive has been interpreted by the ECJ in cases such as *Peak Holdings*, *Class* and *Diesel* and how consent may be negated by facts such as those in *Copad* and *Coty Prestige*.
- Set out clearly the case law of the ECJ in cases concerned with re-packaging, re-branding, re-labelling and over-stickering; and the cumulative conditions (now set out in *Boehringer I* and *II*) which the parallel importer must satisfy in order to be able to indulge in such conduct.
- Critically evaluate whether the cumulative guidelines from *Boehringer I* and *II* give the brand owner too much power in objecting to parallel imports, and whether the guidelines do indeed reflect the legally recognized functions of trade marks.
- Set out clearly the case law of the ECJ on international exhaustion of rights and consider critically whether the ability of a brand owner to object to goods which have been put in circulation for the first time outside the EEA is justified in view of the legally recognized functions of trade marks.