

Jon Lang Mediation

Trade Marks, Passing Off and Comparative Advertising – mediation examples

a trade mark dispute between two household name technology companies arising out of their respective development of sub-brands, with infringement of a CTM and passing off alleged;

a trade mark dispute concerning a significant high street brand and the co-existence of two owners of the same 'split' trade mark, the dispute involving multiple jurisdictions and trade mark revocation, opposition and infringement proceedings in each;

a multi-jurisdictional trade mark dispute between owners of two iconic brands involving infringement, revocation and invalidity claims brought by each against the other in the UK High Court, OHIM, The General Court of the European Union, the Chinese Trade Mark Office and in over 50 other countries around the world;

a dispute over 'switch selling' of alcoholic beverages giving rise to trade mark infringement and passing off claims;

a dispute between competitors arising out of a comparative advertising campaign raising various issues under the EU Directive on misleading and comparative advertising (2006/114/EC);

a trade mark dispute between a multi-national drinks group and a retailer arising out of a seasonal promotion in which a variety of issues were raised including, in relation to 'detriment' under s10(3), the ASA's CAP code and the Portman Group Code of Practice;

a dispute raising issues under The Business Protection from Misleading Marketing Regulations 2008;

a trade mark licensing dispute between a major chain store and a well-known brand owner over the manner in which various trade marks protected by a number of CTM's were used/developed;

a trade mark infringement action (sections 10(1), 10(2) and 10(3) TMA 1994), a passing off action, and opposition and revocation proceedings in the IPO, between a hotel chain and a financial institution;

a multi-faceted trade mark dispute between media companies including appeals to the High Court against decisions of the trade mark registry refusing, in part, various applications for figurative marks, invalidity proceedings and infringement proceedings;

claims between food manufacturers arising out of the packaging/get up of certain food products involving groundless threats, declarations of non-infringement, partial revocation, injunctions and damages/accounts of profits;

a dispute between a software house and a distributor concerning allegations of trade mark infringement and counterfeiting of discs, manuals and certificates of authenticity;

a passing-off and trade mark dispute involving household name food products;

a trade mark dispute between International publishing houses;

a dispute between a household name international franchisor and one of its franchisees operating in a number of jurisdictions, including issues in relation to the use of various trade marks;

a dispute between a major fashion brand and a food manufacturer concerning the use of the former's trade marks in a competition run as part of an advertising campaign for the launch of a new product;

a trade mark action between a generic manufacturer of a pharmaceutical product and a market leading brand;

an intellectual property dispute (registered and unregistered design right, breach of confidence, passing off, trade mark infringement and copyright) arising out of the setting up of a business in customised body parts for a luxury car brand;

a dispute concerning with quantum of damages for trade mark infringement, an area of contention being the recoverability of lost profit on goods commonly sold along side the protected articles (*Gerber v Lectra* principles);

several other trade mark infringement, validity and royalty disputes in a variety of sectors e.g. publishing, franchising, engineering & construction, food & beverages, furniture, technology, IT, motor, film, telecoms, fashion etc;

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