

# Kluwer Trademark Blog

## UK series marks held to be compatible with EU law

Julius Stobbs (Stobbs IP) · Thursday, June 2nd, 2016

*Comic Enterprises Ltd v Twentieth Century Fox Film Corporation [2016] EWCA Civ 455*

On 25 May 2016, the Court of Appeal held that the series mark provision in the UK Trade Mark Act is compatible with EU law.

In March the decision in the trade mark conflict between Comic Enterprises and Twentieth Century Fox was handed down in relation to the latter's Glee TV series and also on the secondary issue of the Court's review of the validity under EU trade mark law of the registration of "a series of trade marks".

The series provision allows the inclusion of more than one mark in a single application at the UKIPO, so long as the marks are deemed to be effectively the same (they differ only as to matters of a non distinctive character not impacting on the identity of the mark). Historically the UKIPO allowed any number of marks to be included in the series, but a relatively recent rule change has limited the total number to 6. Ireland is one of the few other EU countries that have such a provision.

The idea of the provision is to allow applicants to register their mark in very closely similar variants if those similar variants are to be used, without being forced to pay for separate registrations. It is commonly used for logo marks presented in slightly different colourways.

If the Court had held in Twentieth Century Fox's favour this would not just have impacted on the infringement in this case (because Comic Enterprises' rights would have been invalid) but would have had very wide-ranging effects on UK trade mark law, future filing practice and potentially even past registered marks.

If the series provision had been found incompatible with EU law then potentially any mark registered as a series could have been held invalid. It would also not have been clear how such a validity issue could have been dealt with – could the marks be separated and maintain their filing date for example or would they have to be re-filed? Could the issue be rectified at all (in the way that we now have difficulties in dealing with non IP TRANSLATOR compliant terms in specifications)?

Fortunately this is at least one issue we do not have to deal with.

I welcome this decision, which ensures that this novel and cost-effective element of the UK trade

mark system remains an attractive proposition for brand owners everywhere.

Of course, exactly what marks can be included in a series is still a difficult issue. The UKIPO has been getting more and more strict on what can and can't be included, and rightly so – the provision is not there to save money on registering different marks, but to enable cost effective registration of variants of the same mark.

The Specsavers decision, insofar as it impacts on our interpretation of how colour impacts on the distinctive character of a mark, will of course have an impact on this provision. If colour change is sufficient to change the distinctive character of some marks then logically that colour change should be sufficient to remove the possibility of such marks being included in a series. We shall see how the interpretation of this provision develops with interest!

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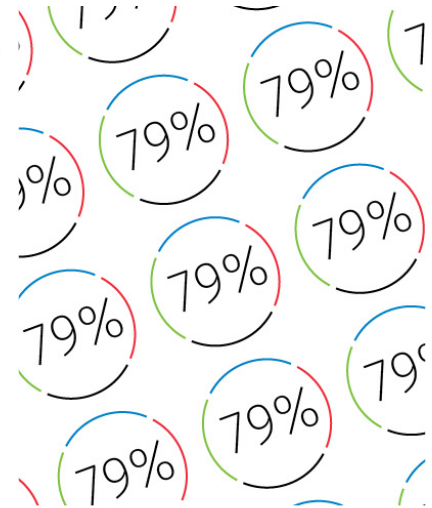
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