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# Kluwer Trademark Blog

## It's not over yet for Skykick

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The long running dispute between Sky and SkyKick is not due to end any time soon. SkyKick has been granted permission to appeal the 2021 decision of the Court of Appeal to the Supreme Court. The Supreme Court's findings are expected to provide important guidance for brand owners regarding whether broad scope trade mark specifications leave a registration open to challenge for bad faith.

### Background

Well known broadcaster Sky initiated trade mark infringement and passing off proceedings against SkyKick, who provides cloud management services. Sky claimed SkyKick infringed a number of its EUTM registrations for SKY which covered a broad scope of goods and services.

SkyKick counter claimed that Sky's registrations had been applied for in bad faith in respect of certain terms in the specification leaving the entire registration invalid. The battle has lasted several years and various decisions have been issued by the Court of Justice of the EU, The High Court, and the Court of Appeal.

### The High Court decision

Applying a preliminary ruling from the Court of Justice of the EU, the High Court found the trade marks partially invalid since they were filed "pursuant to a deliberate strategy of seeking very broad protection of the trade marks regardless of whether it was commercially justified". Sky had no prospect of using the mark for certain goods and services in the EUTMs. Other goods and services in the EUTMs were applied for with no commercial justification of use. The registrations were therefore restricted in scope of goods and services covered. However Sky retained protection for key terms and SkyKick was found to have infringed Sky's registrations in respect of the resultant specification. The claim for passing off was dismissed.

### Court of Appeal decision

Both parties appealed to the Court of Appeal which reversed the High Court's findings on bad faith, finding that a lack of intention to use the mark alone would not amount to bad faith. The Court of Appeal found trade mark applicants do not need to establish an intention to use the trade mark in respect of every sub category of a broad term in the specification to defeat a finding of bad faith. In this case, Sky did not need to establish an intention to use SKY for every conceivable type of computer software to justify including "computer software" at large in its trade mark

specification.

### Appeal to Supreme Court

SkyKick now has permission to appeal the Court of Appeal's decision to the Supreme Court. Brand owners will need to wait at least several more months for the Supreme Court's ruling for further guidance on the breadth of language that may be used in trade mark specifications. Until then there remains uncertainty for many brand owners surrounding the validity of their registrations and the extent to which the scope of the specification may leave the registration open to invalidity on the grounds of bad faith.

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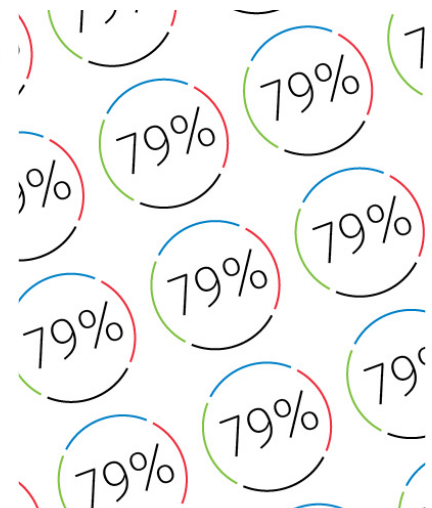
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