

Legal 500

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United Kingdom

Trademark Disputes

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This country-specific Q&A provides an overview of trademark disputes laws and regulations applicable in United Kingdom.

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United Kingdom: Trademark Disputes

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1. To represent a client before Court in respect of a potential trademark infringement matter, do you require a Power of Attorney – and if so, what are the execution formalities required by your courts?

To represent a client before a court in a trade mark infringement matter, a solicitor or other legal professional (e.g. a barrister) does not require a specific Power of Attorney. A solicitor or other legal professional representing a party before a court is required only to establish her professional status as an advocate.

2. Is it a requirement in your jurisdiction to send a cease and desist letter to a potential infringer before commencing proceedings for infringement? What are the consequences for a trademark owner who chooses not to send a pre-action letter?

It is not a strict legal requirement to send a cease and desist letter to a potential infringer before commencing proceedings for infringement. However, the Practice Direction – Pre-Action Conduct and Protocols, which explains the conduct and sets out the steps the court would normally expect parties to take before commencing proceedings for particular types of civil claims, emphasises the importance of pre-action correspondence to encourage the resolution of disputes without the need for litigation. Moreover, failure to send a cease and desist letter can primarily affect the costs aspect of the litigation, leading to adverse cost consequences such as attracting an award of indemnity costs against the claimant.

Therefore, while sending a cease and desist letter is not a mandatory step, it is advisable to follow this practice to avoid potential adverse cost implications and to facilitate the possibility of an early settlement.

3. In your jurisdiction, is there a risk that a pre-action letter could give rise to claim against the trademark owner for unjustified threats? What steps should a trademark owner take to ensure any cease and desist letter does not expose the trademark owner to any liability.

There is a risk that a pre-action letter could give rise to a claim against the trade mark owner for unjustified threats under the Trade Marks Act 1994. To mitigate this risk, it is essential for the trade mark owner to ensure that any cease and desist letter is carefully drafted and complies with the statutory provisions governing actionable threats. This is true even if the threat is conditional or implied, as the term "threat" covers any intimation that would convey to a reasonable person that trade mark rights are intended to be enforced. A letter from solicitors that constitutes a warning of future proceedings could be considered an actionable threat.

Proceedings in respect of an actionable threat may be brought against the person who made the threat for a declaration that the threat is unjustified, an injunction against the continuance of the threat, and damages in respect of any loss sustained by the aggrieved person due to the threat (Section 21C, Trade Marks Act 1994). It is a defence for the person who made the threat to show that the act in respect of which proceedings were threatened constitutes (or if done would constitute) an infringement of the registered trade mark.

To avoid liability for unjustified threats, trade mark owners should ensure that any cease and desist letter containing a threat of infringement proceedings:

- i. relates to an alleged act of infringement that is not considered actionable as an unjustified threat under Section 21A(2), Trade Marks Act 1994. These acts are applying, or causing another person to apply, a sign to goods or their packaging; importing, for disposal, goods to which, or to the packaging of which, a sign

- has been applied; or supplying services under a sign; or
- ii. if not an express threat of infringement, meets the criteria for a "permitted communication" under Section 21B, Trade Marks Act 1994. A communication is permitted if it is made for a permitted purpose, contains only necessary information, and the person making the communication reasonably believes the information is true. Permitted purposes include giving notice that a registered trade mark exists, discovering whether a registered trade mark has been infringed, and notifying someone of a right in or under a registered trade mark.

Additionally, the Intellectual Property (Unjustified Threats) Act 2017 provides further clarification and protections, such as preventing threats being brought against professional advisers acting in a professional capacity.

4. Is it mandatory for the parties to have attempted mediation or other alternative dispute resolution proceedings prior to commencing infringement proceedings?

It is not mandatory for parties to have attempted mediation or other alternative dispute resolution (ADR) proceedings prior to commencing infringement proceedings. However, there are notable guidelines and judicial expectations that encourage parties to consider ADR before resorting to litigation.

The Civil Procedure Rules (CPR), the rules of civil procedure used by certain courts in civil cases in England and Wales, and associated supplemental Practice Directions strongly promote the use of ADR. For example, they impose a duty on the court to encourage ADR where appropriate, and allow the court to impose a stay on proceedings for a specified period to enable settlement of the case through ADR, even if the parties do not agree (CPR rule 1.4(2)(e); rule 26.4(2A)). Furthermore, the court can impose costs sanctions on parties who unreasonably refuse to engage in ADR.

5. Are claims for trademark infringements heard before a general commercial Court or a specialist Court focused on Intellectual Property disputes? Are trademark infringement claims decided by a judge or by a jury?

Claims for trade mark infringement are primarily heard before specialist courts focused on intellectual property

disputes rather than general commercial courts. Specifically, claims for trade mark infringements are primarily brought in the Chancery Division of the High Court or the Intellectual Property Enterprise Court (IPEC), which is a specialised court that is particularly suitable for intellectual property litigation in which the financial value of the claim is under £500,000.

Trade mark infringement claims are decided by a judge, not by a jury. Most claims for trade mark infringement heard before the Chancery Division of the High Court are dealt with by specialist intellectual property judges. Multi-track cases in the IPEC (broadly speaking, cases where the compensation sought exceeds £10,000 and are not considered suitable for the small claims track) are heard by the Presiding Judge of the IPEC, His Honour Judge Hacon, or by one of a number of deputy judges and recorders, all of whom are intellectual property specialists.

6. Is there a time limit for commencing trademark infringement proceedings once the facts giving rise to the infringement are known to the trademark owner. After how long would such a claim be time-barred?

The relevant limitation period for bringing a trade mark infringement claim is six years from the accrual of the cause of action (Section 18, Trade Marks Act 1994). This is subject to certain exceptions where the trade mark owner is under a disability or prevented by fraud or concealment from discovering the facts entitling them to apply for an order. The same timeline applies to passing off claims discussed in question 7 below.

7. In your jurisdiction does the law protect unregistered trademarks of any kind, including by way of unfair competition or protection of trade dress. What are the criteria for their subsistence?

In England and Wales, there is no specific legal action for the protection of unregistered trade marks by way of a general law of "unfair competition" or protection of trade dress. However, the law does protect unregistered trade marks through the tort of "passing off". The principle that underlies passing off was summarized by Lord Oliver as "no man may pass off his goods as those of another."

The criteria for establishing a passing off claim consist of three elements:

1. Goodwill: The claimant must demonstrate that there is

goodwill or reputation attached to the goods or services they supply, which is recognised by the purchasing public through the identifying 'get-up' (such as a brand name, trade description, or packaging).

2. **Misrepresentation:** The claimant must show that the defendant has made a misrepresentation to the public, leading them to believe that the goods or services offered by the defendant are those of the claimant. This misrepresentation does not need to be intentional.
3. **Damage:** The claimant must prove that they have suffered or are likely to suffer damage to their goodwill or reputation due to the erroneous belief caused by the defendant's misrepresentation.

8. In your jurisdiction will the Court hear claims for registered trademark infringement in parallel with claims for unfair competition, infringement of trade dress or other misleading advertising, or does a claimant need to bring such claims in a separate cause of action?

The court will hear claims for registered trade mark infringement in parallel with claims for passing off, or they can be combined in the same action. The reasoning for combining the two is that the statutory cause of action for infringement of registered trade marks is a development of the common law relating to passing off. Both causes of action are directed at the same wrong, which is the exploitation by one party of commercial goodwill properly belonging to another.

In England and Wales, there are laws and regulations prohibiting misleading advertising and non-permitted comparative advertising. However, these laws and regulations do not create a direct right of action for trade mark owners. Instead, certain authorities, primarily Trading Standards and the Competition and Markets Authority (CMA), may initiate proceedings on behalf of trade mark owners, and can seek court orders preventing the publication of unlawful advertising.

In addition, the Advertising Standards Authority (ASA) is the UK's independent regulator of advertising across all media, and adjudicates cases concerning allegedly comparative and misleading advertising under the Committees of Advertising Practice (CAP) Codes. The ASA publishes adjudication reports on its website, which are often reported on by the media and can have a powerful impact due to the adverse publicity that can result from a negative adjudication. However, the ASA does not have power to grant injunctions, levy fines or

award compensation, and will generally not investigate a complaint by a trade mark owner about a competitor's advertisement if the advertisement is also the subject of legal action.

9. In your jurisdiction, do your Courts share jurisdiction with your Trade Mark Office, such that parties need to seek to seize the forum they prefer first in time, or does the Court take precedence and intervene to stay or transfer any live Registry proceedings (for example relating to invalidity or revocation of registered trade mark) which may overlap with an issued infringement claim and related counterclaim?

The courts and the UK Intellectual Property Office (UKIPO) share jurisdiction in relation to certain trade mark matters. Invalidity and revocation proceedings can be brought before the courts or the UKIPO. However, only the courts have jurisdiction in relation to trade mark infringement claims.

In the event of concurrent proceedings before the UKIPO and a court, the UKIPO will often agree to stay proceedings in deference to the court. However, if necessary, the court can intervene to stay or transfer proceedings to ensure efficient use of resources and avoid unnecessary duplication.

10. Where the defendant has a counterclaim for invalidity or cancellation of the registered trademark being asserted against it (either on the basis of earlier rights or as a result of non-use by the trademark proprietor), does the counterclaim become part of the infringement action, so that both issues are heard by the same Court within a single action, with the Court making a determination at its conclusion, or are the validity issues bifurcated and heard in separate parallel proceedings? If in your jurisdiction validity issues are bifurcated, what are the practical consequences of this from a timing perspective? For example, does this mean that a Court will stay the infringement claim and proceed with the validity attack first to avoid finding a trademark infringed, only to have a separate Court find the trademark invalid at a later date?

There is no bifurcation of validity issues in England and Wales. When the defendant has a counterclaim for invalidity or cancellation of the registered trade mark being asserted against it, the general practice is for both issues to be heard by the same court within a single action. This approach ensures that the court can make a determination on both the infringement and the validity of the trade mark at the conclusion of the proceedings.

11. If the main objective in commencing infringement proceedings is to secure an injunction, is a claimant required to state how much their claim is worth at the point their claim is issued?

A claimant seeking an injunction in trade mark infringement proceedings is not required to state how much their claim is worth at the point their claim is issued. The requirement to include a statement of value applies where the claimant is making a claim for money. A trade mark infringement action, particularly when the objective is securing an injunction, is not considered a claim for money. Therefore, such claims can be issued in the court without the need to state the monetary value of the claim. The Court has held that the rules concerning claims for money do not apply to non-money claims like those seeking injunctive relief.

12. Is it possible to seek a preliminary injunction in your jurisdiction? If so, what are the criteria a trademark owner needs to establish and is there a bond or other undertaking in damages payable to compensate the defendant if the Court finds no infringement following a substantive hearing?

Yes, it is possible to seek a preliminary (interim) injunction in relation to trade mark infringement. The criteria for granting such an injunction include:

1. Seriousness of Issue to be Tried: The court must be satisfied that there is a serious issue to be tried. This means the claimant must show that the case is not frivolous or vexatious, and there is a real prospect of success.
2. Balance of Convenience: The court will then assess the balance of convenience, considering:
 - i. if the preliminary injunction is not granted, whether damages would be an adequate remedy for the claimant if it ultimately succeeds at trial. If damages would be an adequate remedy for the claimant, then a preliminary injunction will not normally be granted;

- ii. if the preliminary injunction is granted, whether the claimant's cross-undertaking in damages will provide adequate protection for the defendant if it ultimately succeeds at trial. If the cross-undertaking damages would not offer adequate protection for the defendant, then a preliminary injunction will not normally be granted;
 - iii. more generally, whether the harm to the claimant if the injunction is refused outweighs the harm to the defendant if it is granted.
3. Status Quo: If the balance of convenience does not clearly favour one party, the court may consider maintaining the status quo until the final hearing.

When a court grants a preliminary injunction, it typically requires the claimant to provide a cross-undertaking in damages. This is a commitment by the claimant to compensate the defendant for any losses incurred if it is later determined that the injunction should not have been granted.

13. Is a licensee (whether exclusive or non-exclusive) of a registered trademark entitled to commence proceedings for trademark infringement? Does the trademark proprietor need to be joined as a party to the proceedings, and does it have an effect whether the licensee is registered before the local Trademark Registry?

The entitlement of a licensee to commence proceedings for trade mark infringement depends on whether the licensee is exclusive or non-exclusive.

An exclusive licensee may bring infringement proceedings in their own name if:

- i. the exclusive licensee calls on the owner of the registered trade mark to take infringement proceedings, and the owner refuses to do so, or fails to do so within two months after being called upon;
- ii. the licence provides that the exclusive licensee has the same rights and remedies as if the licence were an assignment, allowing the exclusive licensee to bring infringement proceedings, against any person other than the owner, in their own name.

A non-exclusive licensee may bring proceedings for infringement only with the consent of the owner of the registered trade mark. This requirement ensures that non-exclusive licensees cannot unilaterally initiate legal action without the involvement of the trade mark owner.

In both cases, the involvement of the trade mark owner is

necessary. The owner must be joined as a claimant or added as a defendant in the proceedings unless the court grants leave otherwise. This requirement does not hinder the granting of interim remedies on an application by the licensee alone. In addition, a licensee (exclusive or non-exclusive) who has suffered loss can intervene in infringement proceedings brought by the proprietor for the purpose of recovering that loss.

The registration of the exclusive licence with the UKIPO is not a condition for commencing proceedings. However, failing to register the licence within six months affects the licensee's right to recover damages, although it does not impact the recovery of costs or the right to an injunction.

14. Where the claim for trademark infringement is premised on similarity between the defendant's mark and the trademark owner's registered mark, does the proprietor need to demonstrate that confusion has occurred or simply that there is a risk of confusion? What is the minimum standard required to secure a finding of infringement?

The owner of a registered trade mark does not need to demonstrate actual confusion to secure a finding of infringement based on similarity between the defendant's mark and the registered mark. Instead, it is sufficient to show a risk of confusion: a person infringes a registered trade mark if they use a sign in the course of trade where, because the sign is identical or similar to the trade mark and is used in relation to goods or services identical or similar to those for which the trade mark is registered, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark (Section 10(2), Trade Marks Act 1994).

The likelihood of confusion must be appreciated globally, taking all relevant factors into account, and judged through the eyes of the average consumer who, at a minimum, is deemed to be reasonably well informed, circumspect, and observant. The court must identify the sign actually used by the defendant and compare it to a notional and fair use of the mark in relation to all goods and services for which it is registered, assessing whether there is a risk that the average consumer might think the goods or services come from the same or economically linked undertakings.

15. In your jurisdiction what type of disclosure or discovery is typically ordered by the Court in

respect of trademark infringement actions from both parties?

In trade mark infringement actions, courts typically order a process called "disclosure" (equivalent to "discovery" in other jurisdictions). This process allows parties to obtain evidence from each other after filing their pleadings. Traditionally, "standard" disclosure required parties to conduct a reasonable search for all relevant documents, including those that support or adversely affect a case, while excluding privileged materials.

Due to the increasing complexity and cost of managing electronic documents, a pilot scheme was introduced in the Business and Property Courts (including the Chancery Division of the High Court and the IPEC) in 2019, and made permanent in 2022. This scheme provides courts with the flexibility to tailor the scope of disclosure to the specifics of each case. It also imposes detailed obligations on parties, including a structured dialogue to set the scope of disclosure.

Additionally, courts can issue pre-trial search and seizure orders against both parties and third parties. They can also order the disclosure of documents or information from third parties who are inadvertently involved in the infringer's wrongdoing.

16. What type of expert evidence is permitted by the Court in your jurisdiction? Does the Court accept consumer surveys and are there specific rules about how consumer surveys are conducted. Do the parties need to request prior permission from the Court to adduce survey evidence?

Expert evidence is generally permitted when it provides the court with specialised knowledge that is outside the judge's expertise and can assist in understanding technical issues related to the case. Expert evidence must be substantive and not merely opinion-based. CPR 35 provides that expert evidence should be independent, relevant, and necessary for resolving the proceedings, with a duty to the court that overrides any obligations to the instructing party.

The CPR contains further rules on expert evidence in different kinds of proceedings. For example, trade evidence from individuals in the relevant trade could be treated as expert evidence when it includes opinions on market behaviour, provided it complies with CPR Part 35.

The evidence permitted by the courts includes consumer

surveys. However, there are specific rules governing the admissibility and conduct of such surveys. Survey evidence must generally be of real value to the court and proportionate to the cost involved in producing it. The reliability and methodological adequacy of the survey are crucial factors in determining its admissibility. The *Whitford* guidelines, established in *Imperial Group Plc v Philip Morris Ltd* (1984) R.P.C. 293, outline the requirements for a valid survey. These guidelines include ensuring a relevant cross-section of the public is interviewed, the survey size is statistically significant, full disclosure of the survey methodology, non-leading questions, recording exact answers, and providing interviewer instructions.

Prior permission from the court is required to adduce survey evidence. The permission application should outline the proposed survey's methodology and costs. Surveys should not be admitted unless they are likely to make a real difference at trial, and any application to conduct a survey must typically include the results of a pilot study and an estimate of the costs involved. If permission is granted, the applicant may conduct a full survey and seek permission to adduce expert evidence about the survey results. This ensures that the evidence is scrutinised for its potential value before significant costs are incurred.

17. Does evidence submitted by your client in trademark infringement proceedings have to be accompanied with a statement of truth or other similar declaration?

Yes, evidence (in the form of witness statements) submitted by a client must be accompanied by a statement of truth. This requirement ensures that the evidence is verified and the person providing it acknowledges its accuracy and truthfulness. The statement of truth is a formal declaration that the facts stated in the document are true to the best of the knowledge and belief of the person making the statement.

Documents relied upon are typically put into evidence by including reference to them in a witness statement which will attest to their veracity and which must be supported by a Statement of Truth as above.

18. In your jurisdiction is it possible for a claimant to seek summary judgment of an infringement claim? What are the legal criteria for

a Court to grant summary judgment?

Yes, it is possible for a claimant to seek summary judgment for a trade mark infringement claim. The legal criteria for a court to grant summary judgment are outlined in the CPR Part 24. In brief, the court will grant a summary judgment if:

- i. it considers that the claimant has no real prospect of succeeding on the claim or issue, or that the defendant has no real prospect of successfully defending the claim or issue; and
- ii. there is no other compelling reason why the case or issue should be disposed of at trial.

This procedure aims to ensure the efficient and cost-effective resolution of suitable cases without the need for a full trial.

It is also possible to seek early determination of a case by way of striking out the claim or defence (or part of it) under CPR Part 3.4.2(a) if it discloses no reasonable grounds for bringing or defending the claim.

19. How long does it typically take to reach judgment in a trademark infringement action from issue of the claim, through to first instance decision? What is the lower and upper range of legal costs for such an action?

The duration of a claim in the IPEC is typically six to 12 months from the issuance of the claim to judgment. Factors influencing the duration are case complexity, court schedules and procedural matters.

Costs in the IPEC can vary between a lower range of £50,000 to £150,000 for straightforward cases, to an upper range of up to £300,000 for more complex cases. However, as of October 1, 2022, the recoverable costs are capped at £60,000 for liability and £30,000 for damages inquiries. Damages recovery is limited to £500,000.

The duration of a claim in the Chancery Division of the High Court is generally 12 to 24 months to reach a first instance decision. Factors influencing the duration are the complexity of the case, the volume of evidence and court availability.

Costs in the Chancery Division can vary between a lower range starting at £195,000 for less complex cases, to a higher range of exceeding £1.5 million for intricate or high-value disputes. Typically, the prevailing party can recover 65% to 75% of their legal costs from the losing party. There is no cap in damages in the High Court.

These figures are general estimates. Actual costs and durations can vary significantly based on specific case details, legal strategies, and unforeseen procedural developments.

20. Following a first instance decision, is it possible for either party to appeal the decision? What are the grounds upon which an appeal can be lodged? Is it necessary to request permission to appeal, or are appeals automatically permissible? If either party file an appeal, is the enforcement of the first instance decision stayed pending the outcome of the appeal?

Either party may appeal a first instance decision. The grounds for appealing the decision generally include errors of law, procedural irregularities, or a conclusion that is outside the bounds within which reasonable disagreement is possible. The appeal process is a review rather than a rehearing.

The general rule is that permission to appeal must be sought, and permission will only be granted if the court considers that the appeal would have a real prospect of success or there is some other compelling reason why the appeal should be heard. An application for permission to appeal must be made to the lower court at the hearing where the decision was made or (if refused) can also be made to the appellate court.

The enforcement of the first instance decision is not automatically stayed pending an appeal. A party may request a stay, and the court will decide whether to grant it based on the circumstances of the case.

21. If the parties have been involved in a dispute before the local Trademark Office, what relevance does this have on later infringement proceedings? For example where trademark owner (A) may have already sought to oppose the registration of a third party (B's) mark in proceedings before the local Trade Mark Office, is the trademark owner estopped from seeking invalidity of a registered trade mark where its opposition failed where the invalidity action is based on the same grounds as the unsuccessful opposition?

The involvement of parties in a dispute before the UKIPO can have significant implications for later infringement

proceedings, particularly regarding the doctrines of cause of action estoppel and issue estoppel. These doctrines can estop parties from re-litigating matters that have already been adjudicated.

Opposition proceedings before the UKIPO are administrative, not judicial. They concern registration, i.e. whether a mark should be registered, not whether using it infringes an earlier registered trade mark. By contrast, trade mark infringement actions in the courts (e.g. IPEC or High Court) are separate judicial proceedings and assess actual use in commerce and whether it infringes a registered trade mark. Therefore a failed opposition does not create an absolute estoppel preventing an infringement action. However, estoppel or abuse of process can apply in narrow circumstances. For example:

- a. if the same facts and legal issues were already decided finally and fairly in the opposition before the UKIPO;
- b. if the infringement claim is essentially trying to re-litigate the same core issue (e.g. likelihood of confusion, descriptiveness); and
- c. the claimant is determined to be abusing the court's process.

To assess whether a failed opposition before the UKIPO can be litigated in the courts, the court will look at factors such as whether the UKIPO made findings that are directly relevant to infringement; whether there has been a material change in circumstances since the UKIPO decision; and whether it's fair and just to let the new claim proceed.

In conclusion, if a trade mark owner (A) has already opposed the registration of a third party's (B's) mark in proceedings before the UKIPO and failed, A may be estopped from seeking the invalidity of B's registered trade mark on the same grounds due to the doctrines of cause of action estoppel and issue estoppel, depending on the finality and the specific circumstances of the prior opposition proceedings.

22. In your jurisdiction, does the Court consider both liability and quantum within the same proceeding, or will any damages be assessed after the Court has reached a decision on liability? How are damages for trademark infringement proceedings typically assessed in your jurisdiction?

It is common for the court to separate the issues of liability and quantum in intellectual property cases,

including those involving trade mark infringement. This approach is designed to ensure that the proceedings are conducted as efficiently as possible and to avoid unnecessary complexity. The trial on liability typically precedes the assessment of quantum, and involves determining whether there has been an infringement of the intellectual property right in question. If liability is established, the court then assesses the damages or other remedies in a subsequent proceeding.

Regarding the assessment of damages for trade mark infringement, the court considers several factors. Damages may be calculated based on the loss of business profits caused by the diversion of customers due to the infringement, the loss of business reputation and goodwill, or on a royalty basis. Damages for trade mark infringement can follow the same lines as damages for passing off and includes loss of profits, reduction in prices due to competition, and loss of business reputation and goodwill.

Damages can also be assessed on the "user" principle, which calculates the loss based on the royalty that would have been paid for the use of the mark, even if the use did not lead to lost sales to the claimant.

A successful trade mark owner can also elect, as an alternative to claiming damages, for an account of profits made by the infringer as a result of the infringement (see below).

23. In addition to an injunction and damages, what other remedies are available in your jurisdiction?

After a trade mark infringement case is concluded, several remedies may be available to a successful claimant (Section 14, Trade Marks Act 1994):

1. Account of Profits: A claimant must choose between a remedy in damages or an account of profits. This equitable remedy allows the court to order the infringer to account for and disgorge the profits made from the infringement. The purpose of this remedy is to deprive the infringer of the profits gained through the infringing activities, treating them as if they conducted the business on behalf of the claimant. This remedy may be refused if the infringer was entirely innocent or if the trade mark owner delayed in bringing proceedings.
2. Delivery Up or Destruction of Infringing Goods: The court can order the delivery up or destruction of goods that infringe the trade mark. This remedy ensures that infringing goods are removed from circulation,

preventing further damage to the trade mark owner's rights.

3. Additional Damages: Under the laws of England and Wales, damages are compensatory. However, in cases where the infringement was particularly flagrant or where the defendant benefited significantly from the infringement, the court may award additional damages. This is to punish the infringer and deter future infringements.
4. Disclosure for Election Between Remedies: Before making an informed choice between seeking damages or an account of profits, the claimant is normally entitled to some disclosure from the defendant. This helps the claimant decide which remedy to pursue based on the available information.
5. Forfeiture Orders: Relief by way of forfeiture can be obtained by the registered trade mark owner or licensee. This involves the infringing goods being forfeited to such person as the court may think fit.
6. Publication of the Judgment: Where a defendant is found to have infringed a trade mark, the court has discretion to require a defendant to take appropriate measures at their own expense to disseminate information concerning the judgment. Where a defendant is found to have not infringed a trade mark, the court also has the power to grant an order that requires the unsuccessful claimant to disseminate information concerning the judgment, but only where there is a real need to dispel commercial uncertainty.

24. Following a decision on the merits, is the winner entitled to recover all or a portion of its legal costs incurred in bringing or defending the proceedings. If legal costs are recoverable, what is the procedure involved and how does the Court assess the level of legal costs which should be reimbursed by the losing party.

The winner is generally entitled to recover all or a portion of its legal costs incurred in bringing or defending the proceedings. Costs are assessed either on the standard basis or on the indemnity basis, but the court will not allow costs which have been unreasonably incurred or are unreasonable in amount. On the standard basis, costs must be proportionate to the matters in issue, and any doubt about reasonableness or proportionality is resolved in favour of the paying party.

The approach to costs in intellectual property cases involves considering three questions: (a) who had won; (b) whether the winning party had lost on an issue which was suitably circumscribed so as to deprive that party of the costs of that issue; and (c) whether the case was

suitably exceptional to justify making a costs order on that issue against the party that had won overall. This approach aims to allocate costs fairly, reflecting the overall success and any specific issues where the winning party might have failed. In cases where both parties claim some measure of success, the court will allocate costs based on the extent of each party's success.

25. Once the Court has issued a judgment, how long typically does the losing party have to comply with the Court's judgment including any final injunction issued? What are the consequences for failing to comply and how would the winning party seek enforcement of its

judgement.

In England and Wales, court judgments regarding trade marks are, as a general rule, enforceable immediately. However, the losing party will typically be given a specified period to comply with the court's judgment, including any final injunction issued.

Orders for payment of money are typically payable within 14 days.

In cases of non-compliance with the court's judgment, the successful party may apply to the court, who can hold the person in contempt of court and impose further injunctions and remedies, such as fines, sequestration (confiscation of assets), seizure and destruction of infringing goods, and further damages.

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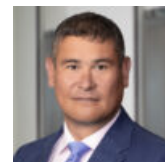
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