

Sky registered trademarks it never intended to use, UK's top court rules

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The Supreme Court ruled that the Court of Appeal erred in holding that the High Court wrongly found that Sky had applied for trademarks in bad faith, requiring a modification of the categories of goods and services (see [here](#)).

Writing for the Supreme Court, Lord David Kitchin said that, in determining whether bad faith is established, "it is reasonable to infer from the size and nature of the list of goods and services the subject of the application and all the other circumstances, including the size and nature of the applicant's business, that the application constituted, in whole or part, an abuse of the system."

In this case, Lord Kitchin deemed it significant that SkyKick's activities were not likely to cause confusion.

"If registrations can be obtained too easily or for too broad a specification of goods or services, the result will be ever greater barriers to entry onto the market for third parties as the supply of suitable marks is diminished," Lord Kitchin wrote.

The Supreme Court also ruled that SkyKick's cloud backup service infringed Sky's trademarks. However, the Supreme Court held that the Court of Appeals properly concluded that SkyKick did not infringe Sky's trademarks with its cloud migration product.

In addition, the Supreme Court clarified that UK courts retained jurisdiction over EU trademark cases filed in the UK before the Brexit transition period, which ended on December 31, 2020.

Finally, the Supreme Court noted that the parties agreed to withdraw the appeal. However, the court denied the request, stating that the outcome "may affect other traders and the public."

At the center of the dispute are one UK and four EU "Sky" and variant marks registered by Sky with respect to a wide range of products and services. Sky claims that SkyKick infringed the marks by using the mark "SkyKick" and variants in relations to email migration and cloud storage products and services (see [here](#)).

SkyKick counterclaimed for a declaration the Sky marks were invalid.

The High Court in four separate rulings and after a reference to a decision from the Court of Justice of the European Union found that Sky applied for the marks in part in bad faith because the registrations were for goods and services for which Sky had no intention to use. The High Court declared some Sky trademarks invalid but held others were valid and infringed by SkyKick's use for email migration and cloud storage services.

The Court of Appeals ruled that Sky had not acted in bad faith and dismissed SkyKick's cross appeal on the question of infringement.

"Sky, like many other businesses, historically filed a range of trade marks in accordance with relevant guidance available at the time. Today's Supreme Court judgment concludes a lengthy legal process to clarify the correct application of the law. We acknowledge this clarification and will follow this moving forward," a spokesperson for Sky told MLex.

SkyKick did not immediately respond to a request for comment.

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Areas of Interest: Intellectual Property

Industries: Computing & Information Technology, Entertainment & Arts

Geographies: Europe, Northern Europe, United Kingdom

Topics:

Trademarks