



Competition Law Association

British Group of the
Ligue Internationale du Droit de la Concurrence
(International League for Competition Law)

www.competitionlawassociation.org.uk
www.ligue.org

GOLDING ESSAY PRIZE 2023

The CLA is offering a prize of £1000 to be awarded for an essay submitted on the following topic:

How should “bad faith” in trade mark applications be used to balance the interests of those who want to use the same or similar brands?

The trade mark dispute between Sky and SkyKick has been running since 2017, during which time the question of whether Sky acted in bad faith when applying for certain trade marks has been considered by the High Court, Court of Appeal and CJEU.

In the High Court, Mr Justice Arnold (as he then was) held that Sky had deliberately registered trade marks for goods and services that it had no intention of using ([2020] EWHC 990 (Ch)). In his view, the evidence demonstrated that Sky had a “deliberate strategy” of seeking broad trade mark protection without any commercial justification but instead with a view to using the marks as a “legal weapon”. As such, he found that the marks in question were partially invalid for bad faith.

In July 2021, the Court of Appeal overturned that decision ([2021] EWCA Civ 1121). According to the Court of Appeal, simply applying for a mark over a broad range of goods and services is not evidence of bad faith, even if the applicant does not intend to use the marks for all of the goods and services protected – they are entitled to a penumbra of protection. Instead, to establish bad faith it is necessary to demonstrate that the applicant’s sole intention in obtaining the registration was to undermine the interests of third parties or to use the right other than to indicate the origin of goods and / or services. Given the previous growth of Sky’s business and the level of brand recognition it enjoyed, the Court of Appeal found that it had good commercial justification for the breadth of the applications it had made and reinstated the registrations in question.

While welcomed by brand owners, the Court of Appeal’s decision arguably tilts the equilibrium in favour of entities with significant reputation and brand recognition while making it harder for new and smaller enterprises to find a mark that does not potentially expose them to trade mark risks. The Supreme Court gave permission to appeal in July 2022.

Did the Court of Appeal strike the right balance or does it give too much leeway to bigger brand owners? Should the Supreme Court adopt a different approach to reduce the trade mark risks for new businesses?

CHAIRMAN:	James Flynn KC	Brick Court Chambers: Tel: 020 7379 3550; Email: james.flynn@brickcourt.co.uk
VICE-CHAIRMAN (IP):	Christopher Stothers	Freshfields Bruckhaus Deringer LLP: Tel: 020 7832 7034; Email: christopher.stothers@freshfields.com
VICE-CHAIRMAN (COMPETITION):	Euan Burrows	Ashurst LLP: Tel: 020 7859 2919; Email: euan.burrows@ashurst.com
NATIONAL REPORTER GENERAL:	Nicholas Gibson	Matrix Chambers: Tel: 020 7404 3447; Email: nicholasgibson@matrixlaw.co.uk
TREASURER:	Jeremy Robinson	Harcus Parker Limited: Tel: 020 3995 3900; Email: JRobinson@harcusparker.co.uk
SECRETARY:	Sharon Horwitz	CMA: Tel: 020 3738 6820; Email: sharon.horwitz@cma.gov.uk
PUBLICITY SECRETARY:	Jason Logendra	The Walt Disney Company: Telephone: 020 8222 1135; Email: jason.logendra@disney.com
ADMINISTRATOR:	Suzanne Snook	Tel: 01245 672 083; Email: admin@competitionlawassociation.org.uk
OTHER COMMITTEE MEMBERS:	Kim Dietzel, Bruce Kilpatrick, Sophie Lawrance, Celia Lloyd Davidson, Nathalie Lobel-Lastmann, Christopher Morcom KC, Collette Rawnsley, Ben Rayment, Tess Waldron	



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The Golding Essay Prize is open to any:

- student (whether currently based in the UK or in a foreign jurisdiction) but excluding any student currently practising as a qualified lawyer, whether full-time or part-time; or
- trainee solicitor, pupil barrister, devil barrister (from Scotland) or trainee patent and trade mark attorney.

The entry qualifications apply as at 28 February 2023.

The essay shall be of a maximum length of 5000 words (inclusive of footnotes) and the closing date for submission of entries is 28 February 2023. Entries should be formatted on A4 in at least 11 point font and 1.5 spacing with footnotes at the bottom of the page, and submitted in electronic form to the CLA secretary, Sharon Horwitz at sharon.horwitz@cma.gov.uk.

Entrants should please place a code word instead of their real name on the essay and include both the code word and real name, with confirmation that the author satisfies the entry qualifications, in the covering e-mail.

The panel of judges will be:

Tess Waldron (Chair)	Powell Gilbert LLP
Simon Clark	Bristows LLP
Verena von Bomhard	Bomhard IP

The decision of the judges is final and the CLA reserves the right not to award the prize if the judges consider that no entry is of a sufficiently high standard or to divide the prize between two or more entries if the judges so decide.

The CLA encourages all entrants to consider submitting their entries for publication, and may lend support to the submission of the winning entry. The winning entry must only be published if it is identified on publication as having won the CLA's Golding Essay Prize. All entrants agree not to submit their entries for publication until after the judges have announced their decision.

Kind regards

Sharon Horwitz
Secretary