

Trade mark strategy in a global market

07 May 2025  Declan Cushley

There is tension between today's global economy - with its ubiquity of online sales and promotions - and the territorial nature of IP rights.

This has led to a number of trade mark disputes. These raise questions such as:

- What constitutes use of a mark?
- Where do online sales take place?
- And what role do advertising and promotional activities play?

Case studies: Understanding 'targeting' in trade mark disputes

Over several years, courts have developed the concept of 'targeting' to help answer some of these questions. As the UK Supreme Court stated in its judgment in the Lifestyle Equities v Amazon case, which concerned the sale of US-branded goods on amazon.com, 'targeting' is to be distinguished from 'accessing': it is to be assessed based on "*all relevant facts and circumstances*" and "*predominantly from the perspective of the average consumer*". This requires a "*close, contextual examination*" of the way a website presents itself to a consumer in the relevant jurisdiction. 'Targeting' is relevant to the assessment of where an act takes place for the purposes of infringement, but also whether a mark has been used in a jurisdiction.

In an interesting recent decision in the England and Wales High Court, the trade mark MOMOFUKU was found not to have been used in the UK for restaurant-related services (Nissin Foods Holdings Co Ltd v MomolP LLC). The trade mark owner, who operated restaurants in the US, Australia and Canada, argued that it carried out promotional activity in the UK and had a significant social media following, and that UK-based customers made reservations for MOMOFUKU restaurants via its website.

Overturning the decision of the Hearing Officer, however, Deputy High Court Judge Iain Purvis concluded:

"It seems to me that (even if one assumes that these reservations are made from the UK) this proves nothing other than that there are people in the UK who are aware of MOMOFUKU. It does not establish use of the mark in the UK, let alone targeting of the UK by the website."

So, there was no genuine use of MOMOFUKU in the UK.

It's helpful to compare the decision with a 2022 judgment of the EU General Court in a case concerning a figurative trade mark for The Standard (Case T-768/20). In this case, EUIPO had revoked the mark for non-use on the ground that the provision of hotel and ancillary services took place in the US (though there were advertisements and offers for sale made to consumers in the EU).

Annuling that decision, the General Court said that, even if a trade mark owner supplies goods or services using the mark outside the EU, it is conceivable that it would make use of the mark "*to create or preserve an outlet for those goods or services in the EU*". It added that advertisements and offers for sale constitute acts of use of a trade mark and therefore they are relevant to demonstrate use of the goods and services for which the mark is registered. The Court concluded:

"Thus it must be held that none of the grounds contained in the [Board of Appeal] decision support the conclusion that the evidence of genuine use of the contested mark referring to advertisements and offers for sale of the applicant's hotel and ancillary services in the

United States and targeted at consumers in the European Union is excluded.”

Implications for trade mark strategy

The difference is in part evidential – there just wasn’t enough evidence in Momofuku, of advertising in the UK. It may also be easier to show use of a US hotel in the UK or EU than a US restaurant, because of the way that hotels are advertised and sold internationally.

If you would like to discuss how these issues affect your trade mark strategy, please contact us.

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