

United Kingdom

“R v. M & Ors”

Decision of the Supreme Court

3 August 2017 – Case No. [2017] UKSC 58

R v. M, R v. C, and R v. T

Trade Marks Act 1994, Sec. 92(1)

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Keywords Non-authorisation of sale · Grey market · Counterfeiting · Consent of the proprietor · Fake goods and unauthorised goods · Deception of the buying public

1. “Such a sign” in Sec. 92(1)(b) plainly means a sign such as is described in (a), i.e. a sign which is “identical to, or likely to be mistaken for, a registered trade mark”. So-called grey market goods are caught by the expression.
2. The offenses set out in paragraphs (a), (b) and (c) of Sec. 92 are, as a matter of plain reading, not cumulative, but separate. The mental element of a view to gain or the intent to cause loss is applicable to all three. So is the element that the use made of the sign is without the consent of its proprietor. Of course, a person may commit all three offences, or different people may commit all three between them. But that is not necessary. Each stands alone.
3. There is no point at which it can be suggested that Parliament plainly confined itself to criminalising fake goods and abjured the criminalising of grey market goods.
4. It is unlawful for a person to put grey goods on the market just as it is to put fake ones there. Both may involve deception of the buying public; the grey market goods may be such because they are defective. The distinction between the two categories is by no means cut and dried. But both are, in any event, clear infringements of the rights of the trade mark proprietor.

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For more on this topic *see* the Overview of 2017 UK Trade Mark and Designs Decisions by Julius Stobbs et al. in this issue of IIC at <https://doi.org/10.1007/s40319-018-0682-6>.
