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IP in the Supreme Court: Trends,
Cases and Consequences

What has the Supreme Court ever done for us?

- ▶ 33 IP cases on SC website in last decade
 - ▶ Since PMS v Magmatic [2016] UKSC 12, 9 March 2016)
 - ▶ NB includes pending (Tesla v Interdigital, Optis v Apple x 2: mobile phones); and
 - ▶ refused applications (Pfizer, BioNTech, AstraZeneca: pharma; Thatchers v Aldi, Howserv/VETSURE)
- ▶ Also: Conversant, Unwired Planet, Regeneron, Actavis - all patent cases

What are the most recent cases?

- ▶ **Iconix, 24 June 2025**

- ▶ Iconix Luxembourg Holdings SARL v Dream Pairs Europe Inc [2025] UKSC 25

- ▶ **Oatly, 11 February 2026**

- ▶ Dairy UK Ltd v Oatly AB [2026] UKSC 4

- ▶ **Emotional Perception**

- ▶ Emotional Perception AI Limited v Comptroller General of Patents, Designs and Trade Marks [2026] UKSC 3

Iconix



Articles of clothing for
use in sports, athletics and
gymnastics

(Class 25)



What happened in Iconix?

- ▶ Miles J held no infringement, only “at most a very low degree of similarity” of marks
- ▶ CA (King, Arnold and Birss LJJ) held this was “irrational” and there was “a moderately high level of similarity” for 2 reasons:
 - ▶ The “similarity issue”. The CA considered in particular the position when viewing D’s mark on a football boot at a game: was it legitimate to do so?
 - ▶ The “confusion issue”. Is post-sale confusion a self-standing basis for trade mark infringement, or only where it affects a subsequent transaction?

What happened in Iconix?

THE NEW YORK TIMES

Supreme Court -

granted permission to appeal because of the two issues, then

(1) held they didn't matter

(2) allowed the appeal

The Similarity Issue

Dream Pairs argument: if considering similarity, just compare intrinsic features of mark and sign (ie ignore “realistic and representative viewing angles”)

Only perform global assessment if there is some similarity ...

and only then consider realistic and representative viewing angles

ie ignore realistic and representative viewing angles when considering similarity

All wrong, said the SC

- ▶ Miles J found some similarity, albeit faint
 - ▶ ... so that of itself was enough to go on to global assessment, and hence enough to consider realistic and representative viewing angles
- ▶ Dream Pairs also relied on CJEU decisions in Equivalenza (2020) and Audi (2024)
 - ▶ But neither Equivalenza nor Audi actually established the proposition
 - ▶ And anyway no logic to the argument – provided post-sale circumstances are realistic and representative, why ignore them?

The Confusion Issue

- ▶ Dream Pairs said: only confusion which affects origin function **at the point of sale** [or in a subsequent transactional context] is actionable as infringement
 - ▶ “transactional context” to cover situation where consumers rely on signs to select goods but don’t pay directly, eg NHS patients
- ▶ Basis of argument was that Miles J had found there was no confusion at point of sale (due to nature of Amazon website)
- ▶ DP accepted that post-sale confusion was *relevant*, but said not enough per se for infringement

All wrong as well, said the SC

- ▶ First and most obvious point – list of acts in 10(4) goes beyond point of sale
 - ▶ includes affixing a sign to goods or packaging, using sign as company name, using in advertising etc
- ▶ Consider eg cork in a bottle of wine
 - ▶ *“It is a very old human trait to wish to acquire a product that one has seen worn by a friend or acquaintance or in their home.”*
- ▶ And loads of cases: eg **Arsenal v Reed**, **Budweiser**, **Ruiz-Picasso**, **Montres Breguet**
- ▶ Plus other reasons (nb *“sixthly”*)

But was Miles J “irrational”?



CA held Miles J “irrational” in finding only faint similarity when sign viewed post-sale, eg when boot was being worn and seen by onlooker



Also “irrational” not to consider post-sale concept



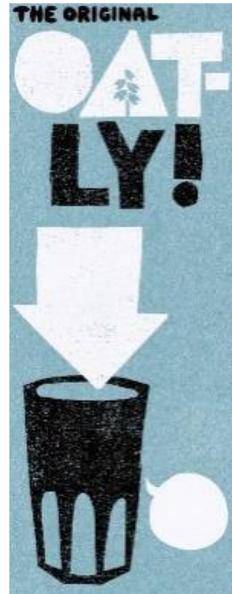
But SC pointed out that Judge had in fact considered such matters; CA merely disagreed with his assessment, hence wrongly concluded he must have made errors of principle – so restored his judgment

What trends are shown?

- ▶ SC always interested in first instance decision as well as CA (but see **Trunki**)
- ▶ If you lose at the CA - points of law will get you to the SC, and you don't need to win these points to win the appeal
- ▶ Continued relevance of post-Brexit EU law: Audi (2024)

What about Oatly?

- ▶ No stranger to litigation: **Oatly AB v Glebe Farm Foods** [2021] EWHC 2189 (IPEC)



- ▶ S 10(2), 10(3), passing off: claim failed

Dairy UK v Oatly AB

- ▶ POST MILK GENERATION, for
 - ▶ Classes 29, 30, 32 (oat-based drinks/sauces etc)
 - ▶ Class 25 (T shirts)
- ▶ What is oat milk?
 - ▶ oat grains, water, enzymes (for hydrolysis), chemical catalysts (to increase pH); separate using eg centrifuge; add salt, calcium, iron, vitamin A, hydrocolloids for stability
- ▶ Dairy UK (UK dairy industry trade association) applies for declaration of invalidity in April 2021

What was the argument about?

EU Regulation no. 1308/2013, point 1

- “milk” means exclusively the normal mammary secretion obtained from one or more milkings without either addition thereto or extraction therefrom.

Point 5

- “[Designations of milk] may not be used for any product other than [milk]”
- But this shall not apply ... “when the designations are clearly used to describe a characteristic quality of the product”

But what does “designation” mean?

- ▶ UKIPO – Dairy win on classes 29, 30, 32 – use of milk is prohibited for non-milk goods and proviso did not apply
 - ▶ Oatly were there and got the T-shirt
- ▶ Richard Smith J – the mark does not “designate” the goods as milk because it does not identify them as milk
 - ▶ Oatly win the first appeal
- ▶ Court of Appeal (Arnold, Snowden, Jeremy Baker LJJ) – Dairy win the second appeal

What the CA said

- ▶ Hearing Officer was right, “milk” cannot be used in relation to any product which is not milk
- ▶ Proviso doesn't work either – mark is not *“clearly used to describe a characteristic quality of the product”*
- ▶ Actually refers to potential **customers**; *“describes the age-related characteristic of a particular cohort of people which Oatly intends should buy or consume its products”*

What did the Supreme Court say?

That the CA was right:

- “designation” means any use of the term to refer to the product, the Mark uses the term “milk” as a “designation”, hence prohibited
- the proviso didn’t save it for reasons given by CA (ie referring to customers, hence why it made sense on T-shirts; unclear – eg did it mean milk free or low milk?)

MILK-FREE would also be a designation but would be saved by the proviso

What trends are shown by Oatley?

EU NEWSBOOK

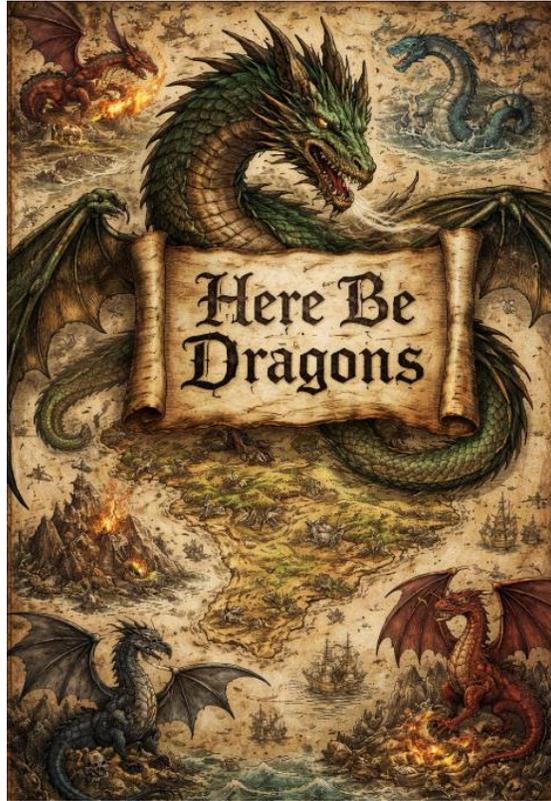


New points still coming up on retained EU law
– no scope for reference



But assistance interpreting the same from EU
case law – SC referred to “TofuTown”, C-422/16

Computer programs ... an old friend



- ▶ ... see also added matter, plausibility...

Emotional Perception

- ▶ *“This appeal is about whether it is possible to patent a particular type of what may loosely be called artificial intelligence”*
 - ▶ Improve recommendations: if you like this media file, you may like this one
 - ▶ Using pairs of files compared using both (a) human/semantic similarity, eg happy/sad (b) physical similarity, eg tempo/tone/rhythm
- ▶ The “trick” was to train the ANN so it could predict similarity (a) from similarity (b)

EPC Art 52

- ▶ (2) The following in particular shall not be regarded as inventions within the meaning of paragraph 1:
 - ▶ (c) ... **programs for computers**;
- ▶ (3) Paragraph 2 shall exclude the patentability of the subject matter ... only to the extent to which a [patent] relates to such subject-matter or activities **as such.**”
- ▶ ... so was this ANN a computer program as such?

What happened below?

UKIPO – yes it was a computer program as such:
excluded

Sir Antony Mann J – no it wasn't a computer
program at all, but if so not excluded

CA (Birss, Arnold, Nicola Davies LJJ) – yes it was a
computer program as such: restore UKIPO decision

... all following **Aerotel** [2007] RPC 7, binding CA
authority

What is “the Aerotel approach”?

Construe	properly construe the claim;
Identify	identify the actual contribution; <ul style="list-style-type: none">• Is what has the inventor really added to human knowledge
Ask	ask whether it falls solely within the excluded subject matter;
Check	check whether the actual or alleged contribution is actually technical in nature <ul style="list-style-type: none">• “may not be necessary but required by Merrill Lynch”

What happened in SC?

- ▶ **Aerotel** all wrong
- ▶ *“The Aerotel approach at best jumbles up the test of an invention with the other requirements for patentability (if indeed it mentions that first question at all) and reverses the logical order of analysis by starting with contribution to the known art (step 2), then addressing the article 52(2) exclusions (step 3), and then finally going back at step 4 to the “technical in nature” question, which is really an aspect of article 52(1)”*

What happened in SC?

- ▶ Aerotel decided prior to Enlarged Board of Appeal (Jacob LJ pointed out potential need to reconsider in such circumstances)
- ▶ In March 2021, EBA did rule on Art 52 in G1/19 – and said that Aerotel was wrong
- ▶ But not as simple as saying “G1/19 should now be followed”, since parts of it tied to EPO procedure and practice

Now: the “any hardware” approach

Ask whether the claim involves the use of or is to a piece of physical hardware, however mundane (whether a computer or a pencil and paper). If yes, Art 52(2) does not apply.



CA in *Aerotel* scathing, but SC agreed that the EBA had approved it in *G1/19*



... and plenty of UK law to say we should follow EPO (see *Conor*, *Lundbeck*, *HGS*, *Actavis v Merck*, *Symbian*) unless the EPO is “steering the convoy towards the rocks”

So what is the law now?

Claim with “any hardware” will pass Art 52 – step 1

UK law of obviousness (*Actavis v ICOS*) same as before, see [65]:
step 3

But now we need an “intermediate step” between 1 and 3 to exclude “*non-technical features (ie features which do not contribute to the technical character of the invention)*” when considering inventive step

What about this “intermediate step”?



It is not just part of EPO practice like problem/solution – it is essential (otherwise Art 52 is too low a threshold for answering Art 56); see [105]



It might be the same as identifying inventive concept (but might not?): see [106]



It means asking whether the feature *“contributes to the technical character of the invention as a whole”*

But...

- ▶ *“It would be unwise for us to embark on carrying out the analysis required by the intermediate step - and in doing so to create binding precedent - without the benefit of both in-depth legal argument and the views of the UKIPO and the specialist judges in the lower courts, none of which are available to us.” [117]*
- ▶ Thus “intermediate step” and inventive step “are questions to be considered by the Hearing Officer”: see [118]

What trends are shown?

Expect the unexpected!

- But see **British Leyland v Armstrong**, 1986

A whole new concept to worry about – “intermediate step”

No guidance either

But is “technical” vs “non-technical” so different from the concepts developed under **Aerotel**?

How will lawyers and trade mark attorneys cope?

THREE NEW SQUARE
MILELON PROPERTY



► *Oh, we'll all manage somehow ...*