

CITMA REVIEW

ISSUE 464 MAY/JUNE 2021

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*How have we
captured a decade
of our profession's
priorities?*

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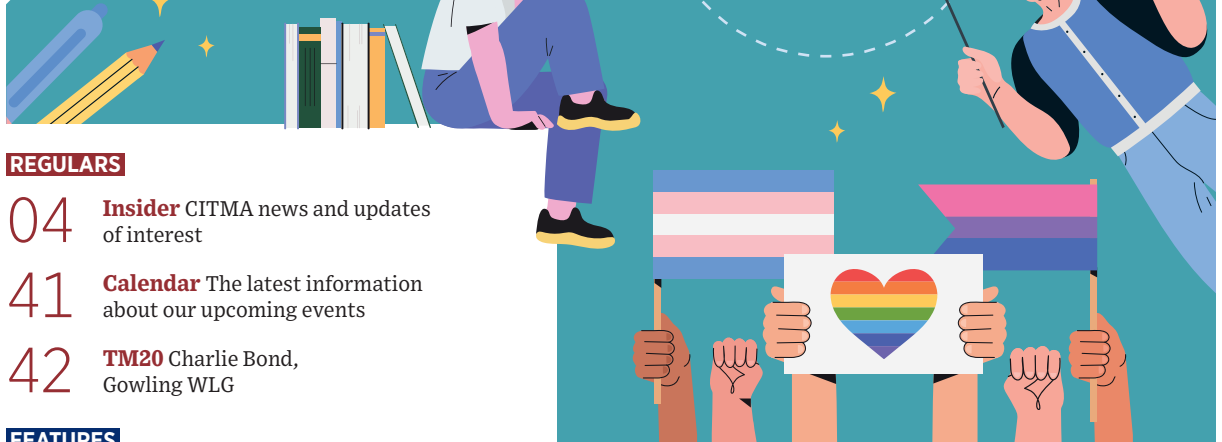


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PRESIDENT'S WELCOME
IT'S A GOOD TIME
TO REVIEW OUR
ACHIEVEMENTS

It has been a busy few months for the profession as we adapt to the shifting landscape since Brexit.

Our avatar-based virtual Spring Conference provided plenty of food for thought about what happens next. I really enjoyed and took a lot from what our speakers, panellists and attendees shared. I am looking forward to the day when we can come together in person, but until then it has been great to be able to use technology in this way to bring us together to learn and network.

Our keen focus on diversity and inclusion continues, and I am looking forward to more discussions and insight at our upcoming webinar celebrating Pride. IP Inclusive has been a cornerstone of the work to make our profession more diverse and inclusive. We and the other founding organisations of IP Inclusive have now jointly agreed a new direction for the organisation, to help it become more independent and less reliant on us. We will of course always support IP Inclusive, but allowing more members of the profession to take responsibility for its day-to-day management is the right thing to do, as it allows ideas to come from all areas.

I personally have been involved with IP Inclusive for a number of years. It's exciting to see it make positive and lasting changes, and I look forward to supporting its next steps.

We might be a fair way into 2021 now, but it's a good time to look back at what we achieved in 2020. We have recently published our annual report, and I'm proud of the achievements of the profession and the role CITMA has played in those. You can read the report at citma.org.uk/2020report

Richard Goddard, CITMA President



CITMA Council members elected

Seven members of our governing Council were elected at our AGM on 24th March 2021.

Sharon Mackison and Carol Nyahasha will be joining our Council for the first time. The other five who were elected are currently serving on our Council and were seeking re-election. Those elected will join the 13 existing Council members to make up a 20-person Council.

CITMA Council is our governing body and meets six times a year to review and set our strategic direction.

Our congratulations to:

- Triona Desmond**
Pinsent Masons LLP
- Leanne Hall**
Serjeants LLP
- Jade MacIntyre**
Allen & Overy LLP
- Sharon Mackison**
Lawrie IP

UK RIDES HIGH IN GLOBAL IP INDEX

The UK still has the world's best framework for the protection of trade marks, according to the 2021 Global Intellectual Property Index. Head to citma.org.uk/gipi2021 to find out more

JADE MACINTYRE



CATHERINE WOLFE



TRIONA DESMOND



FAST FACTS ABOUT OUR COUNCIL

- 20 members, each elected for a two-year term
- Formally elects new CITMA members
- Elects our President, Vice-President & Second Vice-President/Treasurer
- Meets six times a year
- Receives and reviews committee reports
- Is responsible for keeping true accounts
- Sets our strategic direction

Meeting minutes are available at citma.org.uk in the About us/ Governance tab

Carol Nyahasha
Baron Warren Redfern
Catherine Wolfe
Boulton Wade Tennant LLP
Kathy Wright
Astellas Pharma Europe

We recently interviewed Triona Desmond about her experiences as a member of the LGBT+ community and as a Stonewall Educational Role Model in schools. Turn to page 14 to read what she had to say.



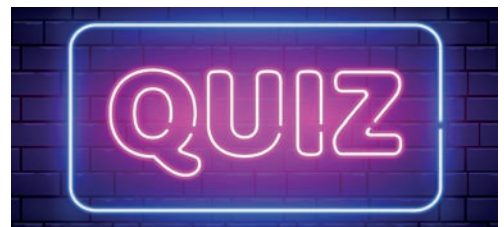
MENTAL HEALTH: CREATING A HEALTHY CULTURE

Mental health charity Jonathan's Voice has published a new guide that will help senior IP leaders create a culture that supports good mental health and wellbeing. Find out more at citma.org.uk/jv2021



BULK CHANGE OF ADDRESS

The UK IPO has announced that it is extending its bulk change of address service until 30th September 2021. This allows for changes to large numbers of addresses brought over from their parent EU rights at the end of the Brexit transition period. Find out more at citma.org.uk/bulk2021



ONLINE QUIZ WINNERS

"The Injectables", a team made up of players predominantly from UDL, came out on top in our first online quiz, with an impressive score of 53 out of a possible 54. Collyer Bristow finished second, and Stobbs IP shared third place with Gowling WLG. Find out more at citma.org.uk/quiz2021

ONE IPO IS GO

David Holdsworth outlines the Office's five-year transformation programme

The past year or so has been challenging for everyone, with COVID-19 depriving us of many of the things and people we love. Amid the gloom, technology has shone out as one saving grace, demonstrating its potential to benefit our lives.

Our vision for the IPO reflects the optimism we feel for the UK building back better. Through our One IPO transformation programme, we will harness the power of digital technology to make life better for IP professionals, businesses and citizens in the UK.

WHY ARE WE CHANGING?

Our transformation is driven by what our customers need. We know we must provide great, customer-focused and modern digital services that are fit for the coming decade. We also want our services to be flexible enough to adapt more quickly to future changes in technology. That is our number one priority.

We also know that IP will play a crucial role in making the UK a more attractive place to invest, driving growth and helping the economy thrive as we plot a new course outside the EU. Better digital services play a part in that, but IP is only as valuable as the use people can make of it. Eventually, we want to provide services that help people both use and monetise their IP.

WHAT'S INVOLVED?

Over the next five years, we don't want to simply modernise and recreate our current processes, systems and services. We want to completely transform what we do and increase the value we contribute to the UK economy.

We want to amalgamate our core services so our customers can manage, secure and challenge IP rights in one place. This includes empowering researchers to make



“

We want our customers to be able to manage, secure and challenge IP rights in one place

better use of IP data through more powerful search tools. One IPO's single, integrated system will deliver this, addressing all your IP needs.

WHEN WILL THIS HAPPEN?

We intend to add all of our existing registered IP rights – patents, trade marks and designs – to the new One IPO system within five years. We will start by working on the new infrastructure that will underpin

our future services. We will then deploy our patents services onto that infrastructure in 2024, and we anticipate adding trade marks from 2025 and designs from 2026.

In the long term, moving on from ageing technology and processes will free up our resources and our people, allowing us to focus on more strategic objectives to help businesses make better use of their IP. That's where we feel we will really enable the UK's innovation as a global IP leader.

LEARN MORE

We are publishing more detailed information about our five-year transformation programme at ipo.gov.uk. We're also hosting a Q&A event – register at businessengagement@ipo.gov.uk. If you'd like to get involved in user testing, contact usertesting@ipo.gov.uk ●



David Holdsworth

is Deputy CEO and Director of Operational Delivery at the UK IPO

LOOKING TO **GROW** YOUR TEAM?



LOOK NO FURTHER

Our 1,600 members are at the heart of the trade mark and design profession.

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CITMA The Chartered
Institute of Trade
Mark Attorneys

Paul McKay explains the value of celebrating underrepresented communities

Storytelling is powerful. Not only does it shape how we view those around us and how others view us, it also shapes how we view ourselves. For the LGBT+ community in particular, telling personal stories can save lives. In a 2018 Stonewall survey of 5,000 LGBT+ people, one in eight LGBT+ people aged 18-24 said they had attempted to take their own life in the previous

year. Hearing the stories of other LGBT+ people can offer direction to those who otherwise see no positive representations of themselves in public life and the media – or who may not be represented at all.

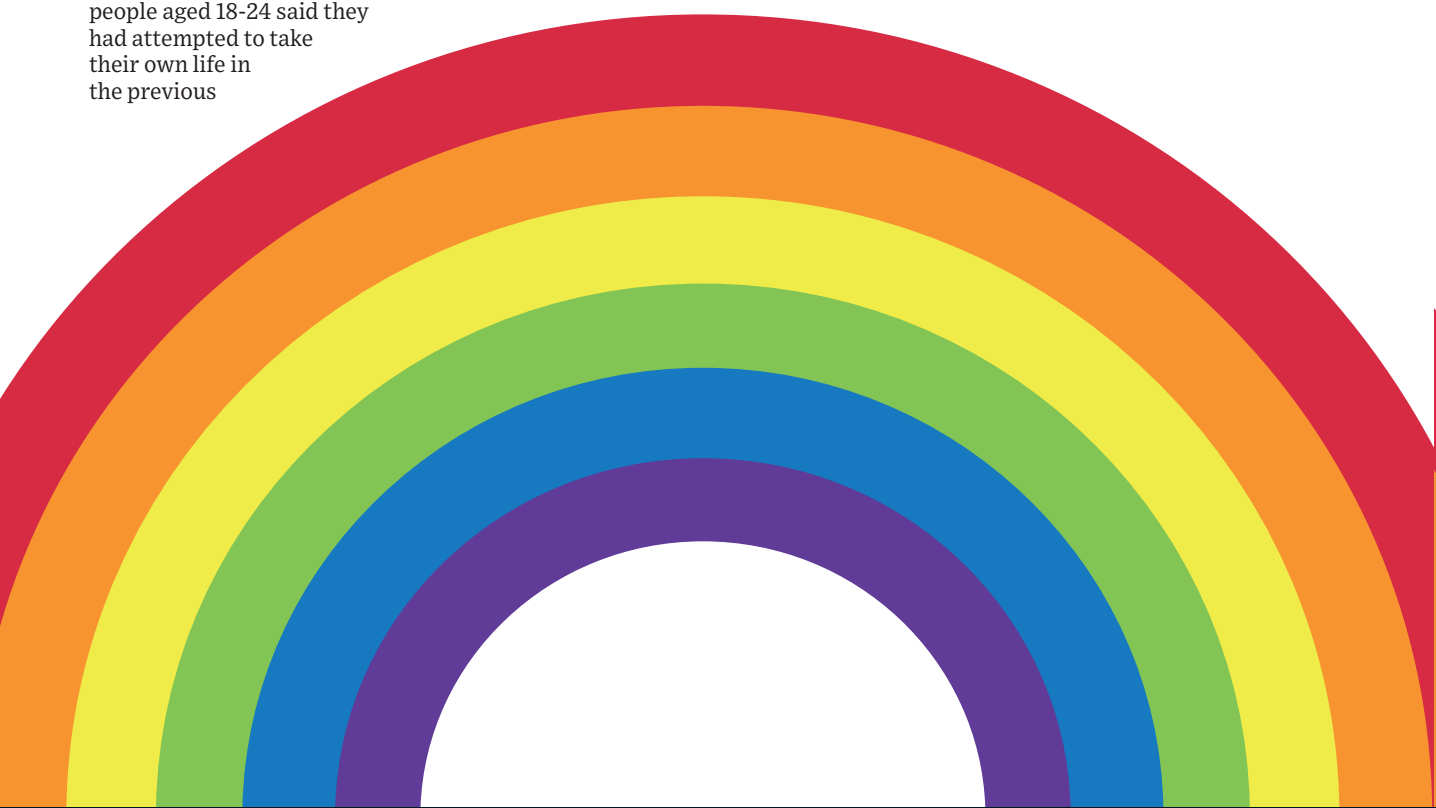
I consider my own coming-out story very uneventful. When I came out – quite late, at 26 – it came along with the end of a two-year relationship with a woman. After many years of anxiety, this huge step was met with nothing but love, support and understanding from those closest to me, including my ex-girlfriend.

I also consider myself fortunate in that I have experienced very

little, if any, discrimination in either my personal or my work life because of my sexuality. I live in London with my boyfriend and our dog, where we openly go about our lives. At work, I am heavily involved in Baker McKenzie's LGBT+ network, which is actively encouraged and which receives full support from the firm at all levels.

PRIVILEGED POSITION

As a member of the LGBT+ community, however, I know that my ability to be so visible is a privilege. As a white, cis-gender (my gender identity matches the sex I was assigned at birth), gay



WHY PRIDE IS SO POWERFUL

man, I am very aware of the fact that out of all the LGBT+ identities, I am a member of the group which probably has it the easiest. We are the most represented in public life and the media.

I understand that my ability to be visible is thanks to many thousands of others who came before me, who fought for the right for myself and many others to be who they are and to live openly. While this progress is of course to be celebrated, it can lead to the question: “Do we still need Pride?”

Sadly, the challenges, issues and stories of other LGBT+ communities – particularly the bi and trans communities – are often underreported and overlooked, so much so that B and T are sometimes referred to as the “forgotten letters”. Despite making up 40% of the LGB UK population, bisexual people are often invisible and their experiences are regularly dismissed. Assumptions about their sexuality are often made depending on their partner – and are often gendered. As Stonewall’s George Alabaster puts it: “Bi women are more likely to be viewed as ‘actually straight’, their sexual orientation considered a mere performance to attract straight men, whereas bi men are frequently seen as going through a ‘phase’ on the way to coming out as gay”.

Meanwhile, bi representation in the mainstream media is limited and, according to Stonewall, bi people are often subject to negative stereotypes such as the idea that they are incapable of monogamy. Ultimately, the significant underrepresentation (and misrepresentation) of the bi community and the dismissal of the bi experience leads to what many refer to as “bi erasure”. At its most

extreme, this can include the belief that bisexuality does not exist.

For the trans community, the past few years have been very mixed. The 2018 open consultation that accompanied the proposed reforms to the Gender Recognition Act 2004 (GRA) exposed a significant amount of negativity and hate speech in the mainstream and social media. The GRA provides the basis by which trans people can change their legal gender on their birth certificate. It was considered groundbreaking at the time but is now outdated and is not reflective of the lived experiences of trans people.

For example, it requires trans people to acquire a diagnosis of gender dysphoria, live in an “acquired gender” for a minimum of two years and submit evidence supporting all this to a Gender Recognition Panel, which they will never meet. For many trans people, living as a gender for which they are not legally recognised means that they do not have access to legal protections, such as the right to always be treated as their correct gender in the legal system.

In a major blow to trans rights, in September 2020 the government confirmed that it has scrapped plans to allow transgender people to self-identify. As trans rights in the UK continue to decline, we are falling behind other countries such as Ireland, Norway and Malta, which have all embraced self-determination.

Despite this, the LGBT+ community in the UK is still privileged. According to the Human Dignity Trust, a total of 72 jurisdictions around the world criminalise private, consensual, same-sex sexual activity, and 15 jurisdictions criminalise the gender identity and/or gender expression of transgender people, using so-called

“ *When we march, it is a chance for these communities to raise a flag to say ‘I exist’ or ‘I am suffering’*”

“cross-dressing”, “impersonation” and “disguise” laws. Of course, this should not detract from the fight for trans rights and bi visibility in the UK, nor from the issues faced by lesbian, intersex, non-binary and asexual communities. Add to this another layer of diversity – whether it’s a disability, socio-economics, your ethnicity or a religious background – and being LGBT+ can be even more difficult, which is why positive stories from the whole community and allies within it are so important.

Pride is an opportunity for these underrepresented voices to be amplified and for their achievements to be recognised and celebrated for all to see. When we march, it is a chance for these communities to raise a flag to say “I exist” or “I am suffering”, and for you to listen to their stories and to show support. And we march for those in countries where marching isn’t an option.

This Pride month, you will no doubt receive invitations to various events from your workplace or potentially through IP Inclusive’s community for LGBT+ people, IP Out. I would strongly encourage you to attend at least one of these events to show your support as an ally, or simply to learn about the issues being faced by your IP colleagues and the wider LGBT+ community. Their stories are powerful. ●



Paul McKay

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EXPERTS ASSEMBLE

Keeping our distance didn't mean we couldn't bring our members together for two memorable days of discussion

Over two days in March, we welcomed more than 200 delegates, speakers and exhibitors to our bespoke virtual Spring Conference to learn and network together. In an innovation first introduced at our virtual Autumn Conference, each delegate was invited to create an avatar to represent themselves in our virtual world. This allowed them to navigate the platform, ask our speakers questions and visit exhibitors' stands. For those who weren't able to take part live, here are some highlights from the conference programme.

KEYNOTE: UNLEASHING INNOVATION

In his keynote address on day one, UK IPO Chief Executive Tim Moss set out how IP can help the UK's economic recovery by "unleashing innovation".

"IP creates confidence for businesses, investors and creators across the UK. It's the confidence that an idea has the support to make it off the drawing board when planning to invest and expecting a return when protecting in your ideas. The IP system can and must sit at the heart of this innovation agenda," he said.

Tim also shared the news of the start of the UK IPO's digital transformation strategy, which will build a single



a common IP system. A new patents system will be delivered as part of phase one, with trade marks and designs to follow in phase two. (See page 6 of this issue for more details on that transformation programme.)

EXHAUSTING DISCUSSION

Where are we going on exhaustion? This was the question addressed by Michael Silverleaf QC (11 South Square) on the first day.

“The government, having started from the position that the UK should have complete international exhaustion, has moved to a position where we should have regional exhaustion within the EEA,” he told delegates. Michael expressed doubts that there would be support for this stance from within the EU and EEA, given its absence from the free trade agreement. Would it even be allowed under WTO rules?

Michael continued: “Looking at the possibility of regional exhaustion, not only is there probably no support from the EU and EEA for EEA-wide exhaustion to include the UK, there is real doubt whether such an outcome is compatible with WTO rules.”

Indeed, a research paper published recently by a team from UCL, Duke University and the University of



Minnesota argues that such an arrangement is illegitimate and would be struck down by the WTO.

Michael concluded with a stark reminder: “We’re entering unknown territory with little or no guidance. We have abandoned a system which had been established for nearly 50 years, and we’re stepping into a future which will be different in innumerable unpredictable ways.”

Earlier in the day, the UK IPO’s Tim Moss had also addressed the issue, saying: “The UK now has the regulatory freedom to choose its own exhaustion of IP rights regime.

“ We’re stepping into a future which will be different in innumerable unpredictable ways

We will be consulting to determine the most appropriate exhaustion regime for the UK and how any change should be implemented.”

VIRTUAL HEARINGS TO BE A FEATURE OF THE FUTURE

“It is clear that remote hearings are here to stay in at least one form or another,” intellectual property judge Mr Justice Mellor told delegates in his day-two keynote. Mellor was joined by fellow IP judge Mr Justice Meade to address the impact of COVID-19 on hearings and what IP hearings will look like in the UK in future.

“Although they can be tiring, there have been good things about the numbers of virtual hearings. Looking to the future, I hope that we can take the knowledge of which hearings lend themselves to remote conduct and reduce physical attendance at court if it is not necessary,” said Mr Justice Meade.

Mr Justice Mellor told delegates that a couple of hearings had really brought home the key advantages of remote hearings – access to justice and efficiency. “These hearings involved parties and attorneys spread right across the UK, and naturally the attorneys and clients didn’t have to travel long distances to a hearing room with the attendant costs in time and money.

“There will still be hearings or trials that will be best conducted in a real court or hearing room, but



I think we can all expect remote hearings to continue to be prevalent even after the pandemic restrictions are fully lifted.”

The Chancery Division of the High Court, where trade mark and design litigation take place, has coped well with the pandemic and the changes to the way hearings have been conducted, delegates heard. Even in the early days of lockdown, it was carrying out 85% of its usual work and quickly bounced back to almost 100% capacity, Mr Justice Mellor explained.

Conscious that there has been a very sharp increase in the number of UK trade mark filings, which is bound to lead to more litigation, appeals and extra demands in future, Mr Justice Meade was keen to point out that the Chancery Division is ready for whatever comes its way.

“We will do our level best to make sure that judicial resources are available... Whether that is full judges, deputy High Court judges

drawn from the profession or by way of hearings in front of the Appointed Person,” he said.

Both justices invited delegates to provide feedback on both the ongoing use of virtual hearings and which kinds of hearings lend themselves to remote attendance, either through CITMA or via IPEC’s Users’ Committee. ▶

IPO CONFIRMS SURGE IN SERVICE DEMAND

There has been a significant increase in demand for UK trade marks and registered designs since Brexit, according to Natasha Chick, the UK IPO's Divisional Director for Tribunals, Trade Marks and Designs. She shared her insight into how things were looking post-Brexit at the UK registry during a panel session with Catherine Wolfe (Boulton Wade Tennant) and Kate O'Rourke (Mewburn Ellis).

Comparing January 2020 to 2021, UK trade mark applications were up by nearly 50%, Natasha explained, and demand for UK registered designs was up some 150% year on year.

Natasha revealed that there had been a dip in demand for trade marks when COVID-19 was first spreading around the globe in spring 2020, but by the summer months demand was booming again – likely caused by small businesses that had started up during lockdown. There was then another increase in demand towards the end of 2020 as represented customers filed UK marks before the end of the Brexit transition period.

The demand for registered designs also dipped around the start of the pandemic, but then increased over the summer. Natasha told the panel that this increased demand for filings had not yet translated into increased demand for tribunal services, but the UK IPO is monitoring this.

CHANGES OF ADDRESS

There has been a 250% increase in demand for changes to the register, including a particularly large volume of applications to change addresses

on newly created comparable rights, Natasha noted. In January, 97% of those requests were handled within 10 working days. In total, 10% of comparable marks were changed to a UK address in January.

Natasha also pointed out that these changes can be made in bulk. If 50 or more need changing, she recommended using the dedicated bulk change of address service, which is available until 30th September 2021. This service is proving popular; 40,000 cases have already been changed using it.

RESOURCING

Natasha admitted that there have been delays in issuing examination reports. This was initially caused by the earlier-than-expected surge in demand during the pandemic. Currently, the UK IPO needs around 35-40 working days for trade marks and registered designs – much longer than the usual 10-day target.

“We want to get back to our previous standard of issuing most examination reports within 10 days,” Natasha reassured the panel. “We have recruited more than 100 additional examiners over the past year, with the majority having been recruited since August.”

Most of these new examiners are for trade marks, but extra design examiners have been recruited too. “Our aim is to get back to issuing examination reports in 10 days within the next financial year. We've already put new case workers and Hearing Officers into our tribunal



service to deal with predicted increases in demand there,” Natasha added.

GETTING TO SPECIFICS

Kate O'Rourke asked Natasha to clarify the rules governing the letters from examiners to holders of earlier rights. Natasha responded: “For trade marks filed since 1st January, examiners are required to notify all earlier rights holders, including those with comparable marks. For those filed before 31st December, notification is only required for holders of existing UK marks, with other marks being provided for the information of the customer applying for the trade mark.” The advice is to speak to the examiner if you believe this has not been done correctly.

Concerns have also been raised regarding the filing date of UK applications based on earlier EU applications that were pending at 11pm on 31st December. On this, Natasha said: “UK law is very clear on what the filing date is for a UK application, and applying for a UK right based on an earlier EU application doesn't change that. The Withdrawal Agreement refers to the two applications as having the same deemed filing date.”

CASE LAW COVERED

In her UK case law update, Jade MacIntyre (Allen & Overy) shared insights on some important UK cases, including that of *THE ROYAL BUTLER*, a trade mark filed by a former butler to the Prince of Wales and the Duchess of Cornwall. The perennial issue of band names also came up, with Jade addressing cases involving Procol Harum, The Bonzo Dog Doo-Dah Band and The UB40 Experience. On day two, Nicole Ockl (Haseltine Lake Kempner) updated delegates on some important EU cases, including decisions involving football icon Lionel Messi, Monster energy drinks and China Construction Bank.



Natasha Chick updates Catherine Wolfe and Kate O'Rourke

“The trade marks will not have the dates on them changed, so the filing date corresponds to the earlier EU mark. That’s important for us because there may be situations where customers may not have been entitled to some of the classification terms they made applications for.

“The Withdrawal Agreement is very clear about the application – it needs to be for the same mark with either all or some of the classification terms that were applied for on the earlier EU right.”

When receiving applications, the UK IPO is storing the UK filing date as well as recording the earlier EU filing date as a priority date. You can ensure this is recorded on the filing receipt and registration certificate when applying for a non-word mark by adding the earlier filing date in the text box. For word marks, the

examiner will add the information and it will appear on the registration certificate. The UK IPO can reissue the filing receipt if required.

Natasha confirmed that even if an application has been subsequently refused by the EUIPO, this does not prevent it being filed in the UK, as long as it was pending at 11pm on 31st December 2020. The UK IPO will then make its own decision.

The UK IPO has not received as many applications as expected for UK rights based on EU applications that were pending at the turn of the year. Natasha encouraged delegates not to wait until the end of the available nine-month window.

CONFIRMATION ON TRANSLATION

Natasha also confirmed that there is no deadline for filing English translations of the regulations relating to an EU certification or collective trade mark registration. Nor is there a requirement to do so, as the UK has committed to not requiring any administrative process to gain a comparable right under the Withdrawal Agreement.

A translation of the regulations might not meet the conditions of the Agreement, and if there is a dispute, the UK IPO can require a translation to be filed, of which the rights holder will receive notice.



IN-HOUSE PANEL PROVIDES NICHE PERSPECTIVE

Our in-house panel – featuring Diageo’s Louise Butler and David Llewellyn from Arm, and chaired by British American Tobacco’s Ese Akpogheneta – considered the impact of Brexit on their practice. The panellists discussed changes in filing practice and expressed a desire for more certainty and clarity on who can do what before the UK and EU offices.

BREXIT EFFECTS DISCUSSED

A rise in UK international trade mark designations and the areas most likely to see post-Brexit case law divergence were among the topics discussed on day two by our Brexit panel, featuring Professor Phillip Johnson (Cardiff Law School), Michael Edenborough QC (Serle Court) and Peter Brownlow (Bird and Bird).

Peter suggested that bad faith could be an early area of post-Brexit divergence from the EU. He told the panel that, procedurally, the UK is well suited to dealing with bad faith cases because of the ability to seek disclosure and the ability to cross examine witnesses – particularly on what the intention of the proprietor was. “I can see bad faith being a ground cited

much more often in UK cases than in the EU, either at the EUIPO or at the litigation court level,” he told the panel. “Therefore, because there will be more cases here, there is a likelihood that we might see some divergence.”

The panel also predicted that there could be a lot more litigation in the UK, and the three panel members will be watching how this develops.

PLENARY SESSIONS

In a plenary session on IP litigation after Brexit, Dr Brian Whitehead (Haseltine Lake Kempner) gave his thoughts on three areas where we might see divergence: estoppel/acquiescence as a defence, the use of trade marks in comparison lists, and bad faith. He

also provided insights on a few areas that may need clarification, notably distinctive character and double identity.

In his own session, Juan Rodriguez Guerra (WIPO) considered current trends in the use of the Madrid Protocol. “Brexit has not had a noticeable impact on the number of international applications filed by UK-domiciled applicants,” he explained. However, Brexit has had an impact on the choice of office of origin. In 2015, 66% of applications by UK-domiciled rights holders were filed via the UK IPO. In 2020 this had risen sharply to 87%.

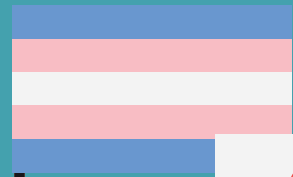
Between 2010 and 2016 demand for UK designations was steady, with some 4,000 a year designating the UK. However, from 2016 onwards, there was a sharp increase to some 19,000 in 2020.



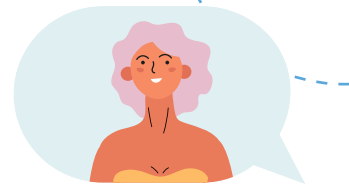
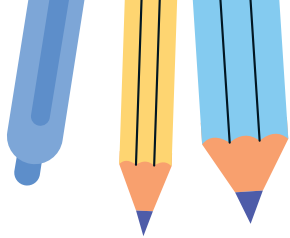
SCHOOL'S IN

Triona Desmond shares her experience of being a Stonewall Educational Role Model and her thoughts on what the world learns from public events like Pride

YOU ARE
NOT
ALONE



OUT
AND
PROUD



CITMA Review: Can you tell us a little about the Stonewall Educational Role Model scheme and how you came to be involved? Why was it something you felt you should give your time to?

Triona Desmond: The Stonewall Educational Role Model scheme brings volunteers from different backgrounds, with different jobs and life experiences, into schools to tell their story about growing up as an LGBT+ person. You go on a one-day training course and get tips on how to prepare and how to engage with the secondary-school students. You also meet some really interesting people on the course.

My firm, Pinsent Masons, works closely with Stonewall and sometimes provides the venue for the scheme's training course. A few places were offered to members of our LGBT+ network. I had heard how good the scheme was, and as a gay woman and mum, I thought it was a fantastic idea. I certainly believed that I would have benefited from someone coming to my own school to talk about being gay and their experience of coming out to family, friends and at work.

CR: What was your first experience of speaking like? Was it daunting? How is it different from a professional speaking engagement, for example?

TD: It was very daunting. It's quite emotional and therapeutic preparing for it and reliving your own "coming out" story. I was so nervous, but someone from Stonewall attends your first visit for support, and my first school, Woodside High School in North London, could not have been more welcoming. The staff and students were so open and warm, and I was even introduced to their "equality council" and told about the great work it did.

CR: What is the most unusual question you've been asked by a student?

TD: One memorable one was: "Do your son's dads know you've stolen their baby?" Bless them – some of the younger students were a bit confused initially by co-parenting.

CR: What kind of feedback do you get from the students you speak to – or the teachers? How do they feel it helps the students and the school community?

TD: The feedback I have received has been so positive – from both students and teachers. Students who told me they thought they could never come out to their parents or even friends seemed to gain a different perspective

“ Some students thought that they could not have kids if they were gay, so it felt really worthwhile showing them that parenting could still be an option

and felt less alone. Some students thought that they could not have kids if they were gay, so it felt really worthwhile opening up to them and showing them that parenting could still be an option. Also, my wife and my son's dads are Asian, and it resonated with students from similar backgrounds that you could be openly gay, raise a child and still be accepted by Asian families. ▶

Triona taking part in the 2019 Pride parade in London with her wife and son





CR: The Stonewall website explains that nearly half of lesbian, gay, bi, and trans young people have experienced bullying. Do you have any personal experience of that kind?

TD: I wasn't "out" at school – or even professionally up until a few years ago – and I've never experienced homophobic bullying. However, hearing homophobic comments or "jokes" in the workplace over the years did contribute to my decision to remain in the closet. In the past, it concerned me that some people in influential positions were clearly uncomfortable with someone being gay. If I'd been open with them, they may have avoided working with me and stopped giving me interesting cases that could have helped my progression. Luckily, people have different views now!

In fact, before coming to Pinsent Masons, I had never worked somewhere where there was an LGBT+ network. As a result, at one firm I ended up desperately trying to hide the fact that I'm gay by referring to my now-wife as a man. While I was at another firm, I got married and had a baby, and the whole time only a handful of work colleagues knew that I was married to a woman!

CR: To what extent might a role model scheme or a mentoring scheme be useful in law/IP firms?

TD: I think mentoring is a really important initiative, and I hear so many success

“ I'm yet to meet another lesbian trade mark attorney, although I'm sure they exist ”

stories as a result of it, especially for those individuals with diverse characteristics.

CR: Who did you look to for role models yourself, as you took your steps through education and into the IP industry?

TD: Until a few years ago, I was not aware of any LGBT+ role models in IP. That's why I'm on the committee for IP Out – the LGBT+ network that is part of IP Inclusive. However, in 2018 I met Lord Smith, the first openly gay British MP and currently the Chair of IPReg. He gave an inspirational talk at one of our IP Out events and was so honest. I see him as a role model now.

CR: Did you feel that you faced any particular barriers either as a woman or as a member of the LGBT+ community – or both?

TD: When I entered the trade mark field many moons ago, it was apparent that the profession was vastly lacking in diversity and it was clear that being gay was not "the norm". However, it has progressed quite a lot and now it is so much more diverse and inclusive. There are far more women in our profession, and it is great that we can support each other through networks such as Women in IP, as well as building a community of allies.

But I'm yet to meet another lesbian trade mark attorney, although I'm sure they exist. Until people feel that the IP community is inclusive, I think they will not



Triona speaking at a school as part of the Stonewall Educational Role Model scheme

feel able to come out and will remain concerned that their sexual identity could affect their career.

CR: Your firm, Pinsent Masons, was Stonewall Employer of the Year 2019 and also ranked fourth in Stonewall's Top 100 Employers 2020 index. Do you feel that there's a commitment to inclusivity in the organisation on a day-to-day basis?

TD: Pinsent Masons really does prioritise diversity and inclusion (D&I) and has numerous initiatives to encourage everyone to bring their whole self to work. It has many support networks and is so transparent. Everyone is really encouraged to get involved, from attending talks by inspirational speakers to unpicking laws and policies. My favourite events are the LGBT+ film nights and its annual LGBT+ conference. Also, there are senior leaders across the business who actively participate in LGBT+ and other D&I initiatives, whether they're straight allies or gay male or female leaders. The commitment is embedded in the firm's culture and it does play a big part in terms of why I could not envisage myself working anywhere else.

CR: The concept of Pride has its origins in the Stonewall riots of 1969, which were prompted by discriminatory policing and a desire to assert human rights. How do you feel things have changed in terms of equality over recent years?

TD: I believe the fight for rights for the LGBT+ community has come a

long way since 1969. Of course, the laws have changed to allow us to marry, have children and adopt, but not all LGBT+ people have the same options, especially in certain parts of the world. In particular (and as Paul McKay points out on page 8 of this issue), the trans community remains marginalised and still struggles to be accepted. There is still a long way to go.

CR: Is it important to you that organisations like Stonewall and events such as Pride exist?

TD: Absolutely. There's still a real need for organisations such as Stonewall to educate and support people and companies in relation to LGBT+ issues. Also, events such as Pride and Black Pride are so important to LGBT+ communities. People need that sense of belonging and community, especially those who are members of ethnic minority communities in which it can be particularly difficult to be out due to cultural differences and in which some people are ostracised from their families for being gay, trans or non-binary.

CR: Understandably, Pride events haven't been able to take place in person for the past year, but would you usually get involved in them? If so, in what way?

TD: I have attended Pride for years. It is so uplifting and always has a lovely sense of community. The atmosphere is fantastic, and as long as the sun shines, we always have a great day with family and friends. After we had our son, we frequently took him. Even at just 18 months old, he loved blowing a whistle and waving a rainbow flag. There is also usually some entertainment for families after the London Pride parade, which is just what you need when little legs get tired.

In 2019, my wife, son and I walked in the London Pride parade with a Pinsent Masons client, which was a great experience. Our son loved it and I got emotional when we saw family and friends along the way cheering us on. It was great that our son could get involved, and he loved the music, the drums and the beaming crowd! It was great to be part of such a powerful event.

CR: You're taking part in a CITMA webinar in June, celebrating Pride Month and discussing the importance of openness and acceptance in the workplace. Is this something that you feel would have been scheduled a decade ago? How well do you feel inclusivity has been implemented within the IP profession?

TD: Sadly, I don't think the topic would have been raised a decade ago, but better late than never. I think inclusivity is important to the IP profession now, and that is one of the reasons why I became a member of the CITMA Council. CITMA is involved in the IP Inclusive network and continues to take positive action on D&I.

CR: And to follow on from that last question, what do you think would be the point you'd most like to make at that event? What would you like the audience to take away?

TD: I hope that we can focus on practical steps that firms can take in terms of making positive changes so that others can feel comfortable to be truly out in the workplace. In particular, I am not aware of any transgender people in our field, and we have to ensure that the IP field is a safe space for all. Of course, not everyone wants to be out at work or to speak openly about their identity. I thought I was one of those people, but when you're encouraged to bring your

GET IN TOUCH WITH IP OUT

IP Out is the IP Inclusive community for LGBT+ people and their allies working in the IP professions.

It provides support and networking opportunities, and it typically aims to organise around four events each year. The events, which are open for all to attend, are a mixture of talks and panel discussions, as well as more informal social events.

Find out more at ipinclusive.org.uk

whole self to work, it's amazing the positive effect it can have on you.

It would be good also to talk about mental health with the LGBT+ community, and the benefits of mentoring – perhaps even as a first step to creating a wider mentoring initiative. I would like the audience to leave feeling that support is available.

CR: Is there anything we haven't addressed yet that you think that readers of the *Review* should know or should consider around the subjects we've talked about?

TD: The best progress happens when dialogue is open and we obtain different perspectives from different people. That's why allies are so important to so many LGBT+ communities. The more people get involved, the more inclusive the IP field will become. ●

Triona will be a panellist at CITMA's Celebrating Pride webinar on 22nd June. Register at citma.org.uk/events



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COVER STORY

How do a decade of *Review* covers reflect the changing priorities of our profession?



It's hard to believe it has been a decade since we made some significant changes to the *Review*, to make it even more relevant and useful to our members. Starting with issue 385 in May 2011 (right), we made a move towards giving more of the magazine over to in-depth features. We also decided to aim for a more design-led approach, using illustrations and imagery to help bring key issues to life, particularly on our covers.

One of the first subjects to take up a cover position was one that we'd return to several times: the debate over plain packaging for tobacco products. It warranted a cover placement back in December 2011/January 2012, appearing again in a suitably enigmatic form a few years later in issue 410 (top right), which was our first to feature no headline text. While the first article noted that the UK's use of plain packaging could put it at odds with its international obligations, the second discussed the impact of such policies in terms of EU harmonisation. From the vantage point of a post-Brexit 2021, concerns about cutting across the harmonisation agenda and the effect on free movement of goods continues to be a timely concern, but for quite different reasons.

Indeed, it will come as no surprise that the UK's relationship with the EU has been a subject we've returned to again and again, for instance providing a preview of the big changes to come from the EUTMR. More recently, of course, Brexit took centre stage – a difficult subject which prompted a raft of practical and campaigning features, as well as some striking covers.

CORE CONCERN

Issue 409, appearing in May 2014, featured our first cover story on



the issue of diversity, which is now a core element of our content strategy. That feature, from Sacha de Klerk, was right to point out that the trade mark profession has been able to attract a good proportion of women – which continues to be the case – but she also reminded readers of the need to retain them as they progress so that they can play a role at Partner level.

Since that early article, and with the launch of IP Inclusive, diversity and inclusion in all its forms has formed the backbone of many of our editions. Notably, in Issue 427, July/August 2016 (above, bottom right), Mark Bearfoot shared his perspective on being an openly gay



Issue 409 was the first of many to address the issue of diversity



“ Our member authors have taken on some tricky subjects, from BLM to climate change



WHIRLWIND MOMENTS

Social issues that touch upon both the profession and our wider communities have also provided the basis for some stunning cover stories. Notably, our members have reflected upon the growing debate around cultural appropriation, with stories taking us from the early concerns about sporting logos all the way through to the whirlwind moment of last summer, when the Black Lives Matter protests focused all attention on the subject of how brands can address their links to historical racism and oppression.

In recent years, we’ve also highlighted technology’s power to change the legal landscape, particularly via blockchain and AI. And the subject of sustainability and the growing threats to our environment certainly couldn’t be ignored. Our member authors have taken on these tricky subjects, covering everything from the trademark implications of upcycling to where campaigning organisations could do better in terms of protecting their brand identities.

Of course, our own landmarks have also been cause for cover celebration. Perhaps the most important was the arrival of our Royal Charter, which was the subject of our one and only special issue in November 2016, with a follow-up feature a year later. Nearly five years on, we’re still fighting your corner by promoting the ongoing value of being a Chartered professional. ●

man in the legal profession, pointing out that while he had happily found all of his workplaces accepting, this was not the experience of so many other LGBT+ colleagues.

Over the years, covers have recognised the need to ensure that everyone can reach their own potential in the workplace, including looking at how we view our mental health and examining ways to support colleagues on the autism spectrum, increase social mobility and put diversity at the heart of firms’ hiring practices. These are conversations that merit our continued attention, and we’re committed to keeping the discussion alive in our pages.

The 2016 Royal Charter Special celebrated the moment we became CITMA



MIND THE GAP

Martin Chinnery provides guidance for those hoping to use the Madrid Protocol in Africa

With an increasing number of African countries joining the Madrid Protocol over the past few years, the International Registration (IR) system has started looking like a more attractive proposition for those who wish to protect their trade marks in Africa.

African countries in which IRs are valid and enforceable include: Algeria, Botswana, Egypt, Gambia, Ghana, Kenya, Liberia, Madagascar, Malawi, Morocco, Mozambique, Namibia, Rwanda, Sao Tome e Principe, Sudan, Tunisia and Zimbabwe.

However, many trade mark owners have come unstuck when relying on IRs to pursue counterfeiters and infringers in this way. The central problem is that a number of countries are signatories to the Madrid Protocol but have not amended their national laws to allow designations of IRs received from the WIPO to be processed, registered and recognised.

ESWATINI

Eswatini, formerly known as Swaziland, signed the Madrid Protocol on 14th September 1998, but its Trade Mark Law and Regulations entered into force in 1994, and make no

reference to the Madrid Protocol. In practice, while the Trade Mark Office processes some international designations received from the WIPO, their validity is questionable due to the lack of local legislation.

LESOTHO

Lesotho signed the Madrid Protocol on 12th November 1998, but its Trade Mark Law is dated 1989 and was last amended in 1997. Designations of IRs received from the WIPO are not processed by the Registry.

OAPI

The African Intellectual Property Organization (OAPI) signed the Madrid Protocol on 5th December 2014 and has been processing designations of IRs received from the WIPO ever since. However, the provisions of a new IP law relating to trade marks, which will give recognition to IRs, are only expected to enter into force later this year. Until the new law comes into effect, the enforceability of IRs in OAPI member states is in doubt.

SIERRA LEONE

Sierra Leone signed the Madrid Protocol on 28th September 1999. Its current law dates back to 2014, but as its Regulations have yet to be introduced, the new law has yet

to officially enter into force. Notwithstanding this, the Trade Marks Registry is already applying the terms of the new law, which introduces the Nice Classification for the first time, as well as 10-year renewal terms, but makes no mention of the Madrid Protocol.

ZAMBIA

Zambia signed the Madrid Protocol on 15th August 2001, but its law dates back to the 1950s and makes no mention of the Madrid Protocol. Further, it does not allow the registration of service marks. There is case law in Zambia which suggests that IRs are not valid due to the failure to incorporate the terms of the Madrid Protocol into the national law.

NOTABLE OMISSIONS

It is worth noting that while more and more countries are joining the Madrid Protocol, plenty of African countries are still not signatories, including several of the continent's largest economies. Among these are: Angola, Burundi, Cape Verde, the Democratic Republic of the Congo, Djibouti, Eritrea, Ethiopia, Libya, Mauritius, Nigeria, the Seychelles, Somalia, Somaliland, South Africa, South Sudan, St Helena, Tanzania and Uganda. ●



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THE GAME HAS CHANGED

IA and IP are claiming the crown in the retail sector, says Esther Jolley

Over the past couple of years, we've seen a raft of big names go into administration, both here in the UK and across the pond. Having faced mounting challenges for some time, including unsustainable rents and changes in consumer behaviour, struggling retail businesses have been dealt a killer blow by COVID-19.

Some have been restructured (Cath Kidston, Mothercare), and some have been bought by other retailers (Early Learning Centre, Jaeger). Yet in other cases, only the intangible assets (IA) and intellectual property (IP) have been bought, and physical stores have been shunned (Topshop, Topman, Debenhams, Laura Ashley). Purchasing just the IA and IP is becoming more prevalent as companies look to snap up the revenue-generating aspects of a business – the websites, licensing and franchise contracts, and customer databases – while leaving the liabilities behind.

These buyers may take a mixture of different approaches to future growth, but what is clear is that the value of IA is being recognised.

MADNESS OR SAVVINESS?

When Boohoo bought the Arcadia Group brands Dorothy Perkins, Burton and Wallis for £25.2m in February 2021, the BBC released an article entitled “Dorothy Perkins? Why would Boohoo want that?”, which seemed to reflect the views of many. There was similar head-scratching when Boohoo then went on to buy the Debenhams brand for £55m.

There was less consternation when it was announced that ASOS, another pure-play online retailer, had acquired the Topshop, Topman and Miss Selfridge brands, broadly considered to be the jewels in the Arcadia crown. Perhaps these were a more obvious fit for an online clothing retailer, but with a higher perceived brand value came a much heftier £330m price tag.

Boohoo is a pure-play online retailer selling fast fashion to a young, fashion-forward, price-conscious consumer. What on earth would it want with a tired, failing department-store brand and three clothing brands that have seen better days? To many, it might seem like madness. But the purchasers know that the value is not in the unprofitable stores, but in the IA, which includes the IP, goodwill and access to customers.

SO, WHERE'S THE VALUE?

Boohoo's purchase was not opportunistic. It already had a plan to buy up other brands, having previously acquired Oasis, Coast and Karen Millen. And contrary to received opinion, Dorothy Perkins, Burton and Wallis are still relatively popular, with around two million active customers in 2020, who collectively spent £180m. Not bad in the middle of a global pandemic. In gaining access to that many new, active customers for £25.2m,

I imagine Boohoo felt that it got a very good deal.

With Debenhams, Boohoo not only acquired the trade marks, but a household name with an online customer base of around six million, supporting a wide range of product categories and a high-traffic website (until recently in the UK's top 10). Fifty per cent of Boohoo's sales are currently outside of the UK, whereas Debenhams predominantly operates in the UK. Perhaps Boohoo sees an opportunity for Debenhams to become a global online marketplace.

Importantly, there is a great deal of value in the IA/IP, which goes beyond just the brand name.

LESSONS FROM LAURA ASHLEY

When Laura Ashley went into administration in April 2020, it was rescued by Gordon Brothers, a global advisory, restructuring and investment firm, which bought up assets including the global brand, its archives and related IP, as well as the online store. The sale included no physical stores. As a result, many, if not all, of the stand-alone Laura Ashley stores in the UK may soon disappear. However, since many of the brand's stores overseas were already operating under franchise agreements, those can remain, because they serve as a revenue stream rather than a revenue drain.

Around 70 licensees globally are selling Laura Ashley licensed products, and Gordon Brothers has indicated that part of its ongoing strategy will be to keep expanding this portfolio. Licensing and franchising are great examples of how brands can use their IP to grow their business and their company value. If the right partners are chosen and the executions are managed well, there is actually little risk to the brand owner.

Laura Ashley has already announced a partnership (likely a license agreement) with Next to sell its homeware products and develop new stores. That means that Laura Ashley products will shortly appear in more than 500 Next stores in the UK and on the website, which operates in more than 70 countries.

Again, it's a massive win for Laura Ashley, which will have no physical



stores to pay for, no inventory to hold or products to manufacture, but will continue to receive the royalties for the use of the brand. Meanwhile, Next gains access to a 67-year-old British brand with strong brand equity, wonderful print archives, a good reputation in the homeware category and existing loyal customers. Win-win.

A PROFITABLE MODEL

Authentic Brands Group (ABG) is a US-based brand development company that recently acquired Brooks Brothers, Forever 21, Barneys New York and Lucky Brand. It already manages a large portfolio of more than 50 consumer brands, including Juicy Couture, Nine West and Frye.

“ The quality of the trade mark portfolio will underpin any brand extension strategy

The company's primary business model involves purchasing retail brands that have run into trouble and licensing the IP out via either store franchising or category licensees. Licensees who are experts in their own markets and categories take advantage of adding a known brand to their portfolio, while ABG builds the brand and collects the royalties, knowing that someone else is taking all the financial and

operational risk. Of course, there is a lot more strategic brand planning required, but essentially it's a very straightforward model and, by all accounts, very lucrative.

In fact, ABG appeared at number three in the 2020 Top 150 Global Licensors Report, with sales of \$12.3bn, up from a 2016 ranking of 21st and \$3bn. As royalty revenue is essentially profit, it's a very nice business model indeed.

VALUE DRIVERS

So, IA and IP are key value drivers for businesses in an increasingly digital world, with brand purchases determined to be more or less attractive and valuable because of the equity, awareness, existing consumer base and so on. The other important part is the quality of the trade mark portfolio, as this will underpin any brand extension and licensing strategy. That portfolio should be maintained with a view to securing and enforcing key strategic rights across the whole range of products and services, as well as all countries where the brand is successfully operating, with an eye on future expansion opportunities.

I expect that what we have seen over the past few years will continue, with the consolidation of physical stores, a bigger push towards digital and more use of licensing and franchising to enable brands to rebuild or grow more quickly, but ultimately more sustainably, over the long term. The retail game has changed, and there's no going back. ●



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CLIENTS & CLIMATE

Kate Hilton-Balfe offers some clear ideas on how to build environmental action into your professional advice

Climate change is arguably the defining challenge of our time. As nations seem on track to fail to limit warming to 2°C – considered the greatest increase that may allow us to avoid catastrophic impacts – the time for taking real actions to reduce our negative impact on the environment is right now.

For trade mark attorneys, this doesn't simply include personal actions such as cutting red meat out of your diet, reducing your overall consumption and increasing reuse and recycling. It also extends to how you advise your clients, for example when it comes to disposing of infringing materials.

The available remedies for a trade mark or design infringement include either delivery up of infringing goods or destruction under oath. This poses a serious sustainability dilemma for both client and trade mark attorney.

Most clients now have a sustainability policy, and requesting the destruction of infringing goods means that all of the materials, energy and fossil fuels used in producing and transporting those goods will go to waste, and more energy will have to be expended to manufacture replacements. Worse still, supposing the goods involve animal products – if, for example, they're sausages packaged



“ As individuals and IP firms, we must all play our part to reduce greenhouse gas emissions and global warming

with a label bearing an infringing trade mark – destruction of the goods is not only bad from an environmental point of view but also has animal welfare implications. These animals will have lived a short and pointless life, only to end up in landfill. It's not a particularly fulfilling existence for a sentient being.

So, the destruction of infringing goods has very few advantages from the environmental point of view. (One exception might

be where using the goods will create yet more greenhouse gases – for example, if the goods have internal combustion engines or rely on fossil fuels to run, as in the case of outdoor heaters, in which case they may be better off being destroyed.)

On the other hand, the destruction of the infringing goods offers many advantages from the point of view of the IP rights holder and may have financial advantages from the point of view of the client. This poses a dilemma, where a choice must be

made between financial and brand maintenance considerations and environmental considerations, which appear on the face of it to be mutually exclusive.

CHARITY CASE?

Perhaps the client can be persuaded to accept that the infringer donates the infringing goods to a charity, with appropriate verification, as an acceptable remedy. But the risk here is that goods donated to charity may pop up in the aftermarket or on secondary auction websites for a long time after they are donated. In that case, the rights holder will have no way of knowing if these are the same infringing goods or a different set. Legal costs and litigation will persist.

Another option is for the rights holder to obtain delivery up of the goods and then arrange to sell them through a verifiable channel, so that the rights holder knows where the goods have been sold. This has the obvious problem that the rights holder is placing non-genuine products on the marketplace, and there may be a subsequent downside to this in weakening the rights holder's brand and reputation.

A further option is for the rights holder to obtain delivery up and then ship the products outside of any territory where the rights holder has trade mark or design rights itself, or to require that the infringer arranges to do this with appropriate verification. Again, the problem arises that even in a territory in which the rights holder has no trade mark or design rights, its brand may still be known. Having non-authorised or non-genuine articles in that market may then perpetuate damage to the rights holder's reputation and brand.

One last option is for the rights holder to permit sales of the remaining infringing articles, subject to the necessary assurances and payment of damages being obtained from the infringer. An

OTHER WAYS TO PUT SUSTAINABLE PRINCIPLES INTO ACTION INCLUDE:

• PUTTING A SUSTAINABILITY POLICY IN PLACE – AND PUBLICISING IT.

You would not want to be at a disadvantage when seeking corporate trade mark work because your firm is not making clear its sustainability policy or has failed to satisfy the sustainability policy criteria of a potential client. Those policies should also include using suppliers that have effective sustainability policies of their own.

• REDUCING YOUR ENERGY CONSUMPTION.

Even if you use a “green” tariff based on renewable energy sources, it is a good idea to reduce your energy consumption. When it comes to heating, the Health and Safety Executive's Approved Code of Practice specifies that workplaces should be kept

above 16°C, but workers can ask management to keep the temperature as low as possible.

• REDUCING YOUR WATER CONSUMPTION.

Suggestions include introducing a rainwater recycling system for any uses which require non-drinkable water, encouraging colleagues to boil and use only as much water as they need, and installing low-flow plumbing fixtures for toilets and aerators for faucets.

• ORGANISING FOR CHANGE.

Set up an environmental committee, preferably with approval from your employer. Encourage your firm to improve its environmental performance, perhaps by working towards ISO 14001 Environmental Management certification or the PAS 2060 Carbon Neutrality Specification. You could also try bringing in speakers and training, such as carbon literacy training, or running campaigns such as “Meat Free Mondays”.

account of the profits and legal costs will enable you to make a balanced judgment of whether the client's sustainability and environmental policy is more important than its brand quality and brand maintenance policy. Ultimately, is it more important that a client company operates sustainably and with minimum environmental impact, or is it more important that the client company operates with strong brand values?

Of course, while a trade mark attorney can give the options to the client, it is ultimately down to the client to decide how to

prioritise its own corporate policies and values and determine how they should be implemented. However, as individuals and IP firms, we must all play our part and work with our clients to take every opportunity to reduce greenhouse gas emissions, global warming and our overall negative impact on the environment. ●



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For Athlon, it figures

Amelia Skelding describes a decision in which a figurative element was a deciding factor

In Decathlon v EUIPO, French sports products retailer Decathlon lost its appeal against the General Court’s judgment that there was “no likelihood of confusion” between its earlier EU trade mark (EUTM) registration for DECATHLON and the figurative ATHLON mark applied for by Athlon Custom Sportswear.

INITIAL TIMELINE

On 14th December 2016, Athlon filed an EUTM application for the mark shown opposite. It covered “clothing; hats” in class 25 and “sporting articles and equipment” in class 28. The application was published on 18th January 2017.

On 14th April 2017, Decathlon filed a notice of opposition based on its earlier EU word mark for DECATHLON registered in 2004 and covering “clothing; caps” in class 25 and “gymnastic and sporting articles” in class 28. The ground relied on in support of the opposition was Article 8(1)(b) EUTMR. This states that the trade mark applied for

class 28 and amended the goods in class 25 to “athletic clothes and hats”.

APPEAL

The Second Board of Appeal (BoA) annulled the decision of the OD on 27th March 2019 and rejected the opposition in its entirety, holding that there was no likelihood of confusion between the marks at issue. The BoA considered the goods at issue to be identical, even after the limitation request by Athlon. However, it took the view that the signs had a very low degree of visual similarity, an average degree of phonetic similarity and – for the part of the public that would understand the verbal elements of the signs – a certain conceptual similarity.

Due to the signs’ low degree of visual similarity and the absence of objective and solid evidence showing an enhanced distinctive character for the earlier mark, there was found to be, in spite of the identity of the goods at issue, no likelihood of confusion between the marks for the relevant public throughout the EU, whether they understood the meaning of the words “decathlon” and “athlon” or not.

SIGN COMPARISON

The BoA found that the earlier mark was a word mark that would be perceived by the relevant public as consisting of one indivisible unit. It considered that, in the overall impression created by the mark applied for, more weight had to be attributed from a visual standpoint to the figurative element and the stylised word element “athlon”.

The BoA also considered that the word element “athlon”, which was common to the marks at issue, did not have a clear meaning for the majority of the relevant public and had a normal level of distinctiveness. It took the view that the other elements of the mark applied for were of limited relevance, if any.

The Applicant disputed the BoA’s findings, arguing that it was wrong to attach more weight to the figurative elements of the mark than to the word element “athlon”.

“ *Visual differences counteracted the phonetic similarity and the conceptual similarity resulting from the common word element* ”

shall not be registered “if because of its identity with or similarity to the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected”.

On 6th July 2018, the Opposition Division (OD) upheld the opposition for all the goods on the ground that there was a likelihood of confusion. On 3rd September 2018, Athlon filed a notice of appeal against the decision of the OD.

On 5th November 2018, Athlon withdrew its application in respect of all the goods in



According to the Applicant, the word element dominated the mark applied for and the figurative elements were negligible. The Applicant also submitted that the word element “athlon” constituted the only distinctive element of the mark applied for, and therefore, the marks at issue were visually similar to a high degree.

CONFUSION

In the global assessment of the likelihood of confusion, the visual, aural or conceptual aspects of the opposing signs do not always have the same weight. In the present case, the Court said that the visual aspects of the signs dominated for two reasons.

First, where two marks have a weakly distinctive component in common, the impact of those elements on the global assessment of the likelihood of confusion is itself low. In this case, it was found that the word element “athlon”, which was common to the signs at issue, was weakly distinctive and so would not be perceived as an indication of commercial origin.

Consequently, the visual differences between the marks, which arise primarily from the stylisation of the common word element and of the figurative element in the mark applied for, dominate in the overall impression on the relevant public created by the signs. These differences counteracted the phonetic similarity and, for part of the public, the conceptual similarity resulting from the common word element “athlon” and the concept to which it refers.

Second, the marketing circumstances are a relevant factor in the global assessment. In the present case, the goods at issue, namely athletic clothes and hats, are in a sector in which visual perception of the marks will generally take place prior to purchase. Consequently, the visual aspect is of greater importance in the global assessment of the likelihood of confusion.

Consequently, in the light of the weak distinctive character of the element “athlon”, the dominance of the visual similarity and the circumstances under which the goods in question were marketed, it was found that there was no likelihood of confusion. Therefore, the action was dismissed in its entirety.

The fact that the word “athlon” was weakly distinctive and did not have a clear meaning to a majority of the relevant public played an important role in deciding this case. Accordingly, the Court attached significant weight to the visual impression of the mark applied for, meaning that the figurative elements tilted the assessment of likelihood of confusion – and thus the outcome of the case – in favour of Athlon Custom Sportswear.

KEY POINTS

- + Do not underestimate the impact of figurative elements when comparing signs with a highly similar word element
- + Where two marks have a weakly distinctive component in common, their impact on the assessment of likelihood of confusion will also be low

MARK

THE ATHLON MARK



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99 problems

But comparison ain't one for Ace of Spades, Jon Banford reports

Ace of Spades Holdings LLC (Ace of Spades) was founded by Jay-Z as a vehicle for his luxury champagne brand, Armand de Brignac. Moët Hennessy recently bought a 50% stake.

In the cases subject to this decision, six of Ace of Spades' EU trade marks (EUTMs) were cited as earlier marks. Four of these marks consisted of the 3D form of a bottle. One has a reflective surface and an embossed label bearing both distinctive and non-distinctive verbal and graphic material, all in gold. Three do not have the main label but have a reflective surface, in silver-grey and two shades of "rose" respectively. A fifth mark consists of the 3D form of a bottle with a frosted surface, all in gold. The sixth is a position mark, consisting of the location of particularly shaped labels on a bottle. Each mark covered champagne in class 33.

The predecessor in title to Krupp and Borrmann had applied for three EUTMs. Each consisted of the 3D form of a bottle with a reflective surface and an embossed label bearing both distinctive and non-distinctive verbal and graphic material, in gold, silver or "rose" respectively (see example opposite). The specifications each covered champagne in class 33.

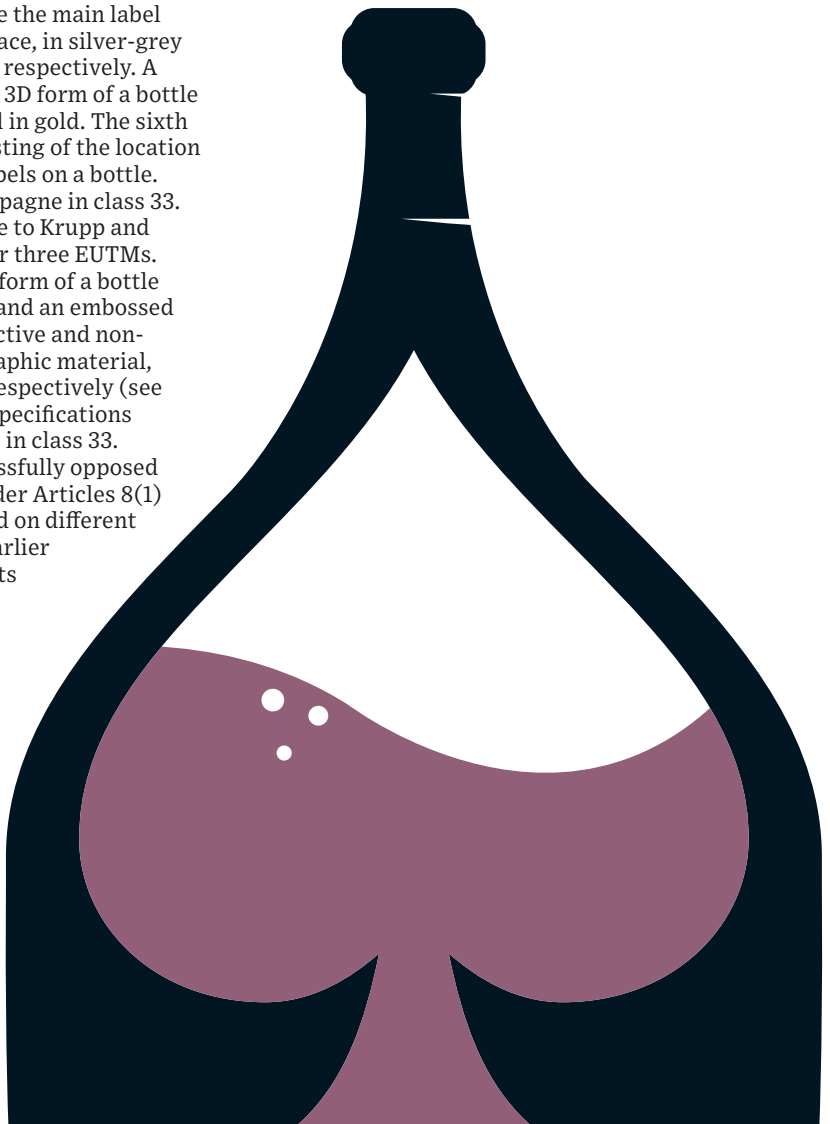
Ace of Spades unsuccessfully opposed all three applications under Articles 8(1)(b) and (5) EUTMR, based on different combinations of its six earlier marks. It then appealed its failure before the Board of Appeal (BoA) to the General Court (GC).

APPEAL DECISION

With respect to Article 8(1)(b), the BoA analysed Ace of Spades' marks, finding that certain elements were "common on the market" for the packaging of champagne: the overall bottle

shapes; their colours; the black foil capsules; the position of labelling on the bottle; and the reflective bottle surface present in four of the marks. The BoA declared that these elements had "very little, if any, impact on the overall impression created by those marks".

In contrast, the BoA found that the most distinctive elements of Ace of Spades' marks were the spade design incorporating a stylised letter "A", which formed the main



“ The BoA only took into account what it held to be the more distinctive elements

label of the first mark, the smaller spade designs on the neck labels of the first five marks, and the verbal element “Armand de Brignac” on the main label. Other elements of the labels, such as “champagne”, were considered non-distinctive. No element was deemed dominant.

The BoA’s analysis of the marks applied for found that the overall shape of the bottle, the neck and main labels, the black foil capsules and the overall colours of the marks were “non-distinctive”, as were verbal elements such as “brut”, “rose” and/or “champagne”. The leafy designs around both labels were deemed to be “mostly decorative”, but the verbal elements “JC” and “Jean Call” were considered distinctive.

The BoA appears in each case to have performed a visual comparison of the respective marks solely on the basis of elements considered to be distinctive. Since these consisted of unrelated verbal material (such as “Armand de Brignac” against “Jean Call”), or visual material not present in the marks applied for (eg, the spade designs), its conclusion that the respective marks were all visually dissimilar was straightforward.

The BoA also carried out phonetic and conceptual comparisons of the marks, but concluded that in each case the visual comparison was determinative. (This aspect of the BoA’s decision was not ultimately overturned.)

The BoA thus concluded that despite the identity of the goods involved, the respective marks were all dissimilar. Thus, neither Article 8(1)(b) nor 8(5) was breached. The appeal was refused.

GC DECISION

The GC overturned the BoA’s decision for taking the wrong approach to comparing respective marks to assess similarity. The

BoA had only taken into account what it held to be the more distinctive elements of the marks and had therefore failed to make a global assessment of the earlier marks as a whole. While the BoA referred to these elements as making “very little, if any contribution” to the overall impressions produced by the marks, it had not written off any of these elements as negligible, so they should have been taken into consideration. Therefore, the BoA’s assessments of visual similarity between marks were in error, being based on defective assessments of the overall impression produced by each mark.

The GC also pointed out that although individual elements of the marks might be considered non-distinctive, certain combinations of them might have a degree of distinctiveness. It also queried whether some elements were as commonplace and non-distinctive as the BoA thought.

Ace of Spades had only argued regarding its 3D marks, so the position mark was not considered. Article 8(5) was found not to have been breached, although this was because Ace of Spades had not proved any reputation specifically linked to its 3D marks.

The GC remitted the cases back to the BoA. It did not decide whether the marks are indeed similar; it simply set out how the assessment of similarity should be carried out.

The GC overturned the decision of the BoA because the visual comparisons of the respective marks, which were in these instances determinative, had not been carried out by comparing the marks as a whole. Elements deemed non-distinctive or “contributing little” to the overall impression produced should nevertheless have been taken into account. Combinations of such elements might be distinctive, and only elements declared negligible could be ignored.

KEY POINTS

- + Global comparisons of marks – even 3D marks – should take into account all their non-negligible components
- + The decision leaves open the weighting of such components in an assessment
- + Elements that have little or no individual distinctiveness can be distinctive in a particular combination
- + Individually or in combination, non-distinctive elements may still contribute to the overall impression produced by a mark

MARKS

FIRST OPPOSED MARK



FIRST ACE OF SPADES 3D MARK



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Role of cognitive spark confirmed

Khemi Salhan explains why a slogan was seen as more than the sum of its words

In this appeal, the General Court (GC) provided clear guidance on how brand owners can ensure that their slogans achieve distinctiveness. The GC confirmed that laudatory connotations would not preclude a mark from fulfilling the essential origin function: a mark can be both promotional and indicate the mark's commercial origin. Issues arise only where the relevant public perceives the mark as mere advertisement. The GC further confirmed that distinctiveness is achieved when the slogan triggers a cognitive process in the mind of the relevant consumer. However, the GC noted that it would not hold slogan marks to a higher standard than other marks.

MAKING HEADLINES

The slogan IT'S LIKE MILK BUT MADE FOR HUMANS has proved somewhat controversial for Swedish oat milk giant Oatly, the Applicant in these proceedings.

The slogan originally made headlines in 2015, after Oatly was sued by Sweden's dairy lobby, which alleged that it disparaged human consumption of cow's milk. The case, and as a result the slogan, garnered significant media attention, and Oatly's business went from strength to strength as a result. In May 2018, Oatly filed an application for the slogan with the EUIPO for goods in classes 18, 25, 29, 30 and 32.

The EUIPO refused the registration of the slogan in classes 29 (dairy substitutes), 30 (oat-based food products) and 32 (preparations for making

beverages, including oat-based beverages) on absolute grounds, holding that the mark was devoid of distinctive character.

Oatly first challenged the decision at the BoA. However, the BoA held that, in light of the goods in question and given the length

“ *Brand owners should be taking note of the ‘cognitive spark’ threshold* ”

of the slogan, the mark would be understood as a promotional slogan rather than indicating the origin of the goods. It further held that the mark contained no element capable of bestowing distinctive character. Oatly appealed this decision to the GC.

The GC held that use of the conjunctive “but” as part of the slogan created an opposition in the mind of the consumer and challenged the commonly accepted notion that milk is an important element of a human's diet. The message conveyed therefore triggers a cognitive process in the minds of the relevant public. The GC held that, as a result of this cognitive process, the consumer will find the slogan memorable and will distinguish Oatly's goods from those of another undertaking. As such, the GC dismissed the finding of the BoA and upheld the registration.

UNDERSTATED BUT EFFECTIVE

This case shows a recognition by the courts that a trade mark can do more

than just designate the origin of the goods. The acknowledgment that a trade mark may also serve as an indication of a brand owner's investment in marketing (as in *Interflora v Marks & Spencer*) is reflected in the Court's reasoning here, albeit not explicitly.

The slogan in this case did not use unusual words, but instead took a simple phrase and flipped the consumer's typical understanding of milk on its head. This was deliberately provocative but also understated; the result was achieved through the use of "but" as part of a straightforward observation. The requirement for the slogan to trigger a cognitive process that, in turn, may satisfy the essential function may encourage other brand owners to seek to register slogan marks. Given the increasing importance of slogans to brand value, brand owners across the EU should be taking note of the "cognitive spark" threshold to achieve trade mark protection.

In any event, the GC has signalled that the cognitive spark is directly related to the issue of the essential function. However, it will be interesting to see whether, over time, the GC and other bodies will rely on the cognitive spark as a non-origin function to indicate distinctiveness.

HELPFUL OBSERVATIONS

The GC's decision also led to a number of helpful observations for those in the

advertising industry. First, that advertising slogans are not excluded from trade mark registration by virtue of the fact that laudatory connotations can do more than just indicate the origin of the goods. The GC explained that a slogan mark will be devoid of distinctive character if the relevant public perceive it only as a "mere promotional formula". Where a mark is perceived by a member of the general public as both promotional and indicating the commercial origin of the goods and services, and even where the promotional aspect is understood to be the primary function of the slogan, it may be capable of distinguishing the goods from those of another undertaking.

Second, it was confirmed that it is not appropriate to apply a stricter threshold of distinctiveness to a slogan than to other kinds of marks. In particular, the GC noted that advertising slogans cannot be required to "display 'imaginativeness' or even 'conceptual tension'". It was reiterated that only a minimum degree of distinctive character is sufficient to preclude a mark from being devoid of distinctive character. However, the GC did note that the public's perception of different categories of mark, including (for example) slogan marks, is not necessarily the same. It could therefore be more difficult to demonstrate distinctiveness in relation to those certain categories of mark. Regardless, the take-home message for brands should be to opt for distinctive, easy-to-remember phrases that clearly indicate the origin of the goods.

KEY POINTS

- +
- The primary function of a slogan may be as an advertising tool, but this does not prevent it from also indicating the origin of the goods
- +
- A slogan can fulfil the essential function of a trade mark where it creates a cognitive spark in the mind of the consumer
- +
- A higher standard of distinctiveness should not be applied to these slogan marks



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Powerbar case has little pull

Dale Carter reviews a decision that simply reinforced familiar principles



On 28th August 2018, the predecessor to the Applicant applied to register the figurative mark shown opposite. Registration was sought for goods in classes 5, 29 and 30, covering nutritional supplements, fruit-based food products and various confectionery, candy, cereal and chocolate goods.

The Application was opposed under Article 8(1)(b) EUTMR. The Opponent relied on various trade mark registrations containing the word element “powerbar”. The Opposition Division (OD) focused its decision on the Opponent’s EUTM registration for POWERBAR, registered for overlapping goods in classes 5, 30 and 32.

The opposition was upheld in its entirety, and the Applicant appealed the decision.

PUBLIC PERCEPTION

The Board of Appeal (BoA) first considered the relevant public and its expected degree of attention. The OD had held that the public’s degree of attention was average in relation to the goods in classes 29 and 30, but that it could vary from average to high in relation to the goods in class 5.

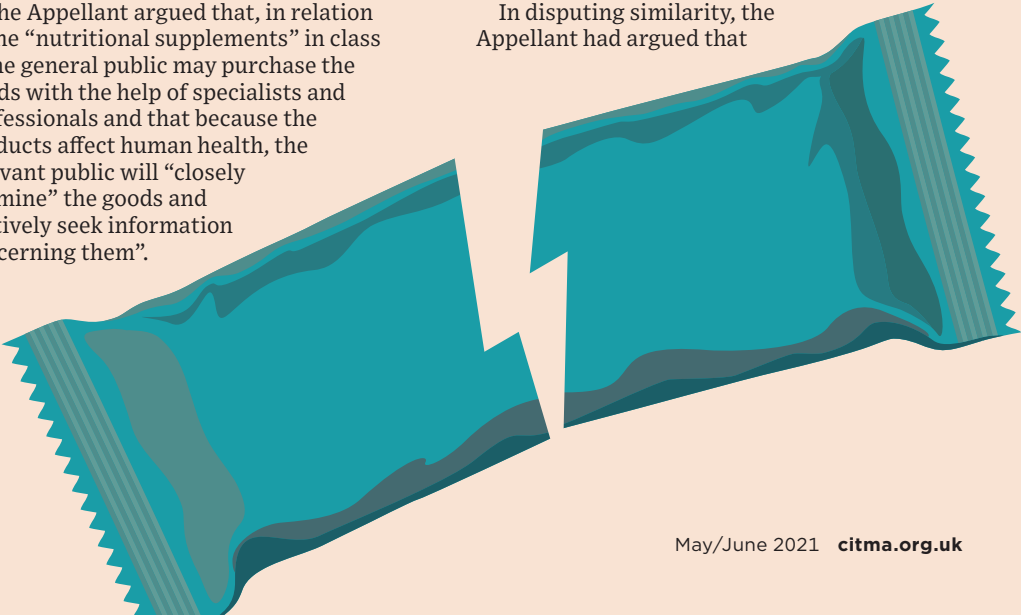
The Appellant argued that, in relation to the “nutritional supplements” in class 5, the general public may purchase the goods with the help of specialists and professionals and that because the products affect human health, the relevant public will “closely examine” the goods and “actively seek information concerning them”.

The BoA held that nutritional supplements are intended for both the general public and also for specialised circles, such as nutritionists. Referencing established case law, the BoA stated that “where goods or services are perceived with different levels of attention depending on their specific characteristics, the group with the lowest level of attention must be taken into account for the assessment of the likelihood of confusion”. The BoA therefore held that the assessment should focus on end consumers whose level of attention is higher than average in the case of nutritional supplements. The BoA confirmed that the relevant public’s degree of attention is mostly average in relation to the goods in classes 29, 30 and 32.

GOODS COMPARED

The BoA then turned to the comparison of the goods. The goods in class 5 were found to be identical. The BoA agreed with the OD’s assessment that the goods applied for in class 29 were similar to varying degrees to the goods in class 30 covered by the earlier mark.

In disputing similarity, the Appellant had argued that



the contested “fruit-based snack food” is in a different class to “grain-based food bars”. The BoA reminded the Appellant that goods or services will not be considered similar or dissimilar purely on the basis of the classes that they appear in under the Nice Classification. The BoA also found identity or similarity between the goods in class 30.

The Appellant had taken particular issue with the “grain-based food bars” covered by the earlier mark being compared with the contested goods “chocolate bars”, “fruit ice bars” and “high-protein bars”, as “they derive from different basic products and appeal to different target groups”. The Appellant had also stated that “it is not apparent how ‘chewing gums’ are intended to constitute a similar category of goods to ‘confectionery’. These goods do not address the same target group, and therefore a similarity cannot be established.”

The BoA explained that “a chewing gum is a soft candy which is chewed but not swallowed, and it is covered by the broader category of confectionery”. The goods were therefore found to be identical. The BoA also found identity between “chocolate bars” and “confectionery”, “fruit ice bars” and “ices”, and “high-protein cereal bars” and “grain-based food bars”, because these fell within the broad categories covered by the earlier mark.

LANGUAGE CONSIDERATIONS

In the contested decision, the OD had conducted its comparison of signs from the perspective of the Spanish consumer. The BoA adopted the same approach and found that the relevant Spanish-speaking public would not attribute a descriptive meaning to the earlier mark POWERBAR in relation to the goods at issue. Rather, these consumers would perceive the mark as “a fanciful term with an average degree of distinctiveness”. However, in finding this, the BoA did acknowledge that the element “power” may be descriptive and less distinctive for the goods at issue where Spanish consumers understand the meaning of the English word.

Addressing the contested sign, the BoA found that the verbal element “powerbär” and the figurative bear’s head device were equally visually dominant, but noted that verbal components usually have a stronger impact on the consumer vis-à-vis figurative components.

The BoA held that “despite the addition of the umlaut/diaeresis in the letter ‘A’, the otherwise fully matching verbal element ‘powerbar’ is included in the challenged sign, creating an impression of visual similarity in the mind of the Spanish-speaking public”. The relative significance of the figurative element in the contested sign therefore did not neutralise the “immediate and direct similarities”. The signs were found to be visually similar to an average degree and aurally similar to a very high degree.

Conceptually, the BoA found the signs to be similar to a low degree. The verbal elements of the signs as a whole were not found to be meaningful for the relevant public. The element “power”, where it conveys a weakly distinctive concept, leads to a very limited degree of conceptual similarity between the signs.

In finding an overall likelihood of confusion, the BoA referred to the similarity of the signs, especially their aural similarity. This was held to be particularly important where, for example, the food supplements are purchased with the help of a professional and the brand is referenced verbally.

The BoA also concluded that even if “some elements of the earlier mark have a weak distinctive character, such as the element ‘power’, the overall impression conveyed by both signs would be enough to trigger a likelihood of confusion amongst the relevant public. In this regard, the Court has emphasised on several occasions that a finding of a low distinctive character for the earlier trade mark does not prevent a finding of a likelihood of confusion.”

This somewhat unremarkable decision serves to reinforce well-established principles relating to the multiple factors involved in assessing whether a likelihood of confusion exists.

KEY POINTS

✦ A likelihood of confusion can be found to exist even where some elements of a mark have a weak distinctive character, if the overall impression created by the mark is identical or sufficiently similar

✦ When asserting that no likelihood of confusion exists because elements of a mark are either descriptive or low in inherent distinctiveness, the onus is on the party making those assertions to submit evidence demonstrating that the relevant public perceive the mark in this way

✦ The Office is obligated to reach a decision based only on the evidence and arguments before it, with the presumption that a registered EUTM possesses at least a minimum degree of distinctive character

MARK

THE APPLICANT’S FIGURATIVE MARK



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Spot checked

Sophie Soeting considers why a familiar red mark was refused registration

The UK IPO has denied registration for Tefal's "red dot" mark, featured in the middle of its cooking pan products, due to lack of distinctiveness under s3(1)(b) of the Trade Marks Act 1994 (TMA). Tefal failed to convince the Hearing Officer (HO) that the dot had acquired distinctiveness, despite a UK high street survey which suggested that 60% of those polled would associate it with the company.

On 17th December 2018, Tefal applied to register the trade mark application shown opposite for the following goods in class 21: frying pans, saucepans, casserole and stew pans, cooking pots, crêpe pans, grills and woks. The application was accompanied by a written description stating that the mark was a position mark and further clarifying that the

and Tefal requested a full statement of reasons for the decision, the HO retired. Tefal was subsequently offered the opportunity for another hearing before a different HO or for the retired HO to write the full decision. Tefal acknowledged that it had made all the arguments it wanted to in support of the case and it was content for the retired HO to write the decision. However, in this event, it was a different HO who wrote the full decision. As a result, the HO quoted at length from Tefal's submissions in the decision to avoid any possibility of unfairly paraphrasing Tefal, or not recording them at all.

The HO stated that, while not "banal", the mark consists of a feature of the appearance of the product concerned: a feature of a certain colour, proportion and position, being plainly visible within the overall shape of (any) pan. Further, it was questioned whether the red dot was independent from the pan, noting that the relevant consumer may not identify the feature as a trade mark in and of itself. As a result, the mark could not perform the essential function of a trade mark.

SURVEY IMPACT

It is well known that it can be challenging to devise a survey that will effectively demonstrate acquired distinctiveness. Applying the principles established in KitKat¹, while the initial recognition figure was undoubtedly statistically significant, the HO concluded that the survey evidence failed to demonstrate acquired distinctiveness. The evidence only went to the question of recognition and association with Tefal, and not to the material perception of the use of the red spot as a trade mark.

Tefal sought to distinguish KitKat, arguing that its mark had been in use in the manner applied for for a number of years, whereas in KitKat the mark had not been used in the form applied for, as it was inside a wrapper and not visible at the point of purchase. However, the HO referred to the core underlying rationale

“ *The main brand was clearly the word ‘Tefal’, and the red spot was merely a ‘sub-brand’* ”

dotted lines on the drawing were not part of the mark. The examiner objected to the mark on the basis of s3(1)(b) TMA, noting that the relevant consumer would not attribute trade mark significance to a plain red circle, so the mark was deemed to be devoid of distinctive character.

In response, Tefal sought permission to conduct a survey, involving 250 interviews in high streets across the UK. The examiner stated that Tefal must decide for itself what type of evidence to submit to demonstrate acquired distinctiveness and did not comment on the survey questions proposed by Tefal. In the decision, the HO suggested that, including in *ex parte* matters such as these, there should be an opportunity for a party wishing to adduce such evidence to be able to discuss it with an examiner or HO (on a provisional and informal basis).

UNUSUAL TURN

In a slightly unusual turn of events, shortly after the application was refused



KEY POINTS

+ Carefully consider the format and probative value of survey evidence given the challenges involved. It may be appropriate to seek informal guidance from a Hearing Officer

+ When designing marketing materials, IP strategy should always be taken into consideration, particularly if the advertisements would be required as evidence of use to secure trade mark protection

+ A key question is: Does the proprietor trust a sub-brand to convey an origin message, and is this apparent in the proprietor's marketing?

MARK

THE TEFAL MARK



of KitKat, namely that the Applicant had used the sign applied for as a trade mark.

In support of this argument, the HO referred to an “illuminating passage” in the Birkenstock sole mark case² and stated that it was perfectly legitimate to ask an applicant “what measure, if any, of ‘trust’ or ‘confidence’ it has placed in its sign, such that it has educated the public to it being a guarantee of origin”. Here, he concluded, the main brand was clearly the word “Tefal”, and the red spot was merely a “sub-brand”. It was appropriate to consider to what extent had Tefal had used and promoted the red dot mark over and above its role as a mere feature of the product itself – ie, showing confidence in its sub-brand. The HO concluded that it was difficult to see how Tefal might have shown that kind of confidence in the red dot mark from the evidence provided.

He suggested that while this did not necessarily require independent use of the red dot, “confidence” could have been shown if there were evidence demonstrating,

for example, reference to “The pan with the red spot”, other than as a simple feature, or as he suspected, as a technical feature of the pan (to show when the pan is hot enough).

This approach demonstrates that there could be the potential for sub-brands – not those considered to be the main mark of the brand indicating trade origin – to obtain trade mark protection through use in the marketing of that sub-brand.

In relation to the additional evidence provided by Tefal, the HO acknowledged that the sales and promotional evidence provided were substantial.

¹ [2017] EWCA Civ 358, Société de Produits Nestlé v Cadbury UK
² BL O/072/18, para 31



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Dousing an old flame

Duncan Balloch reports on how the boundaries became blurred for competing fire-protection businesses



This case shows the importance of formalising arrangements when businesses with common origins agree to go their separate ways but plan to continue to use shared assets such as trade marks. Here, in the absence of such arrangements, the judge had to navigate conflicting evidence as to discussions that had taken place 17 years previously, but ultimately found that an oral trade mark licence existed between the parties, which was largely determinative of the issues.

The Claimant, Cormeton Fire Protection Ltd, had provided mechanical fire protection solutions (such as fire extinguishers) since 1967. In 1989, the Claimant teamed up with Mr John Aitchison (the Second Defendant) to provide electronic fire protection solutions, such as fire alarms, under the corporate entity Cormeton Electronics Ltd (the First Defendant). In 2003, the two businesses amicably separated, with the First Defendant moving out of the Claimant's premises and the Second Defendant buying out the Claimant's shareholding in the First Defendant. For many years, both undertakings continued to operate and use the Cormeton name, focusing upon their own areas of expertise and referring work to each other – until 2015 when they fell out.

INFRINGEMENT PROCEEDINGS

In 2016, the Claimant applied to register CORMETON as a trade mark. Around the same time, the Defendant had increasingly started to use the Cormeton name on its own, and in respect of mechanical as well as electronic protection. In 2019, the Claimant commenced infringement proceedings.

The proceedings claimed infringement of the UK word mark CORMETON in classes 6, 9, 37, 40, 41, 42 and 45, infringement of copyright said to subsist in the logo (shown opposite), and passing off. The Claimant also took issue with the First Defendant's use of the sign CORMETON on its own, the domain name www.cormeton.co.uk, the logo and CORMETON

ELECTRONICS in relation to the supply and sale of mechanical fire protection goods. The Claimant had no issue with the Defendant's use of CORMETON ELECTRONICS in relation to electrical safety equipment.

The Defendants denied trade mark infringement, copyright infringement and passing off, on the basis that following the parties' separation in 2003, the First Defendant operated under licence to use the name, domain name and logo and that the Claimant was estopped from denying a licence and/or had acquiesced in the First Defendant's use. The Defendants also counter-claimed for invalidity of the Claimant's mark under s3(3)(b) and/or revocation under s46(1)(d) of the Trade Marks Act 1994 (TMA), arguing that the public would be deceived or misled by the registration given that the Cormeton name had been associated with both businesses for many years.

COPYRIGHT IN THE LOGO

The judge was able to dismiss the claim based upon copyright very swiftly, as it was found that the version of the logo set out in the pleadings was not an artistic work created by the Claimant. The Claimant did not apply to amend its pleadings to substitute a version of the logo in which the Claimant did own copyright until the last half-hour of the trial, which was deemed too late.

DEFENDANT'S DEFENCES

The existence and content of the agreement reached between the parties when they separated in 2003 was hotly disputed in the evidence given at the trial. In the absence of a written agreement, the judge preferred an analysis that accorded with common business practice and with how the parties had actually conducted themselves in the years after 2003. He thus concluded that an oral agreement had been reached, including a licence that allowed the First Defendant to trade under CORMETON ELECTRONICS and CORMETON ELECTRONICS LTD and to use the domain name in relation to the supply and sale of electrical safety equipment. These licensed uses therefore did not constitute infringement of the Claimant's registered trade mark.

However, the First Defendant's use of CORMETON on its own was outside the terms of the 2003 licence, as was any use of the above signs, including CORMETON ELECTRONICS, in relation to mechanical fire protection goods and services. These unlicensed uses of the CORMETON mark were thus *prima facie* infringing.

The Defendant had also argued a number of defences alternatively or in addition to the existence of a licence. First, it argued honest

concurrent use of the CORMETON mark, but the judge ruled that to the extent that its use was licensed, this argument was not available, while the unlicensed uses had not been for long enough, nor were they "honest". Estoppel and acquiescence were also argued but were held not to be available as a defence to registered trade mark infringement.

The judge's findings in relation to passing off were very much aligned with those in respect of trade mark infringement.

INVALIDITY/REVOCAION

The Defendant's counter-claim for invalidity of the Claimant's mark under s3(3)(b) or revocation under s46(1)(d) TMA was found by the judge to be misconceived. Those sections aim to prevent the public from being deceived or misled in respect of matters such as the nature, quality or geographical origin of the goods or services themselves. As a matter of law, those sections could not be used to run "relative grounds" arguments regarding deception or confusion over who was using the mark. Moreover, as licensor of the Defendant's trade mark use, the Claimant retained goodwill in the mark and the licensing of its use could not be deemed misleading.

FURTHER COMMENTS

On the face of it, it may seem surprising that two businesses could operate alongside each other for so long in related fields, only for one to register a trade mark covering the other's goods and services and (partially) succeed in a claim for infringement and passing off. This highlights two things: (1) the power held by the licensor to register the licensed mark and in turn control its use, and (2) the efficacy of a trade mark licence (even a verbal one) as a shield to defend the licensee's right to use the mark to the extent permitted by the licence.

The First Defendant overstepped what it was licensed to do. Where it had once referred orders for mechanical goods to the Claimant, it had decided to start handling these orders itself. It may have been that the Defendant forgot the boundaries of the oral agreement, or perhaps this came about because the relationship had broken down. In any event, it is clear that the Claimant needed to file the trade mark in 2016 to reinforce its position.

KEY POINTS

- + Co-existence agreements should be recorded in writing to avoid future issues and unnecessary costs should the relationship between parties break down
- + Invalidation/ revocation actions based on s3(3)(b) and 46(1)(d) TMA should only be based on absolute grounds, not relative grounds
- + A verbal trade mark licence can still be useful when asserting your rights to trade against a licensor with registered rights

MARK

THE LOGO AT ISSUE



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Alternative avenues are dead ends

Once again, a David gains a victory, writes Henry Schlaefli

The first instance decision, *Bentley 1962 Ltd & Brandlogic Ltd v Bentley Motors Ltd*¹, was widely reported as a David v Goliath-style victory for the smaller companies (collectively, Bentley Clothing). And on closer inspection, Bentley Clothing certainly seemed to have the stronger registered rights.

In this appeal, Bentley Motors tried to exploit some alternative avenues to overturn the first instance findings on double identity. The appeal also provides some interesting commentary on the scope of the historical defences derived from transitional provisions.

CASE BACKGROUND

Bentley Clothing was the owner of three earlier trade marks containing the word “Bentley”, covering articles of clothing and headgear, the earliest of which was registered in 1982. Bentley Motors had sold clothing under signs comprising the word “Bentley” since 1987. During this time, there were a number of disputes between the parties, including an unsuccessful non-use revocation action filed by Bentley Motors. In these proceedings, Bentley Clothing alleged trade mark infringement for use of the sign or signs shown opposite since November 2011.

The first important point in the first instance decision was whether Bentley Motors used one sign or two separate signs, with reference to the “B-in-Wings” device and the BENTLEY word mark. This distinction was crucial in determining whether or not there was infringement under Article 5(1)(a) Directive 2008/95 (double identity). At first instance, His Honour Judge Hacon concluded that there were two separate signs, so Bentley Motors had used the identical word mark BENTLEY. Of key importance to his conclusion was the

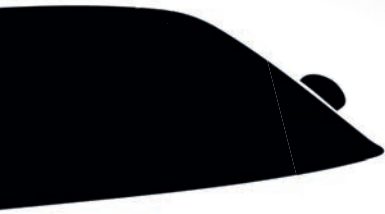
fact that the marks had been used separately prior to 2011 and for a long period of time, meaning it was likely that consumers would have viewed the signs in combination as two familiar signs being used together.

Another point of paramount importance was whether – if double identity and therefore infringement under Article 5(1)(a) were indeed found – a defence of honest concurrent use was available. This defence was unsuccessful on first instance. The judge commented that the evidence gave a strong impression that, from 2000, Bentley Motors had a policy of “grandmother’s footsteps” in relation to Bentley Clothing, consciously developing use of the word “Bentley” in relation to its own clothing goods. The sign’s prominence was increased incrementally in an attempt to avoid provoking a reaction from Bentley Clothing. Such use was not honest concurrent use.

ONE SIGN OR TWO?

The first ground of appeal was that the judge was incorrect to conclude that Bentley Motors had used two separate signs simultaneously,





“ *Bentley Motors consciously developed use of the word ‘Bentley’ in relation to its own clothing* ”

KEY POINTS

- * Rights under Article 5(1)(a) Directive 2008/95 are often powerful, as likelihood of confusion is generally assumed
- * In such cases, it may be possible to argue that use does not affect any of the functions of the earlier rights. Although linked, this line of argument is distinct from the honest concurrent use defence
- * The transitional provisions in the Trade Marks Act 1994 exist to allow the continued use of signs as the law changes, while ensuring that proprietors and users of marks are not unfairly disadvantaged

namely BENTLEY and the “B-in-Wings” device. In particular, the judge was wrong to rely on the conclusion that Bentley Motors itself had, prior to 2014, regarded them as two separate signs. This ground was dismissed on the basis that there was no error in principle in the way the judge went about his assessment on that point. Moreover, Lord Justice Arnold agreed with the conclusion on first instance.

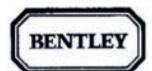
INFRINGEMENT

Bentley Motors’ second ground of appeal was that the judge had erred in his finding of infringement under Article 5(1)(a) because he should have considered whether point (vi) had been satisfied.

CJEU case law sets out the conditions required for infringement under Article 5(1)(a) Directive 2008/95. These are: (i) there must be use of a sign by a third party within the relevant territory; (ii) use must be in the course of trade; (iii) use must be without consent of the proprietor; (iv) the use must

BENTLEY CLOTHING’S MARKS

LOZENGE MARK



WORD MARK

BENTLEY

SERIES MARK

BENTLEY



BENTLEY MOTORS’ MARK

THE B-IN-WINGS DEVICE



be of a sign which is identical to the trade mark; (v) the use must be in relation to goods or services which are identical to those of which the trade mark is registered; and (vi) the use must affect, or be liable to affect, one of the functions of the trade mark.

Lord Justice Arnold commented that the burden of proof regarding point (vi) is an important point that should be referred to the CJEU. After referencing Supreme Petfoods Ltd v Henry Bell & Co. (Grantham) Ltd², he set out his preferred view, which was: “Once the trade mark owner shows that condition (v) use in relation to goods or services... is satisfied, then the defendant bears the onus that such use does not affect, nor is liable to affect, any of the functions of the trade mark.” However, he noted that there are other possible interpretations and this has not yet been decided by the CJEU.

It’s here that Bentley Motors’ pleadings seem to have caused it difficulty. In its initial pleadings, the CMC and its amended pleadings, Bentley Motors had not denied that if there had been use of an identical sign, then there was infringement under Article 5(1)(a). However, it maintained that there was still a defence of honest concurrent use. Lord Justice Arnold concluded that the only case advanced by Bentley Motors as to why condition (vi) was not satisfied was its claim of honest concurrent use. It was now not open to Bentley Motors to contend that the judge should have found that its use did not affect any of the key functions of a trade mark under point (vi) for some other reason.

Lord Justice Arnold added that even if Bentley Motors’ wider arguments – including that the use did not affect any of the functions of the mark – were accepted, these would not have been successful. The crux of Bentley Motors’ argument was that use of BENTLEY with the “B-in-Wings” device during the relevant period was exclusively associated by the consumer with Bentley Motors, such that the use was not liable to affect any of the functions of the earlier rights. This argument was inconsistent with the findings that led to the rejection of the honest concurrent use defence. Of note was HHJ Hacon’s comment that “Bentley Motors’ policy will have had the intended effect of increasingly arrogating to itself goodwill associated with BENTLEY in the clothing business. This amounts to a steady encroachment on Bentley Clothing’s goodwill.” Such use was therefore highly likely to affect the function of the trade mark.

PREVIOUS LEGISLATION

The final ground of appeal was in respect of the interpretation of Bentley Motors’

defence under the transitional provisions: schedule 3, paragraph 4 to the Trade Marks Act 1994. At first instance, it was decided that Bentley Motors had a defence under this provision because the goods it sold, “jackets, silk ties, caps and scarves”, were not identical to the “articles of knitted clothing, shirts and waistcoats” in Bentley Clothing’s lozenge registration. The lack of identical goods meant that use on these would not have constituted an infringement under the Trade Marks Act 1938. It was also found that Bentley Motors had a defence regarding its use of the word “Bentley”, but only in respect of “promotional literature” used to advertise its clothing goods. Use on the goods themselves or on swing tags or other items attached to the goods was objectionable.

“ *Bentley Motors had a defence only in respect of ‘promotional literature’ for its clothing goods* ”

Bentley Motors amended its defence to argue that it should apply more broadly, for example to items of clothing that were not the “articles of knitted clothing, shirts and waistcoats” contained in Bentley Clothing’s registration, and also that the defence should not be limited to “promotional literature”.

In his decision, Lord Justice Arnold listed a number of potential options for the level of detail at which this provision should apply and commented that there may be more granular approaches. However, he settled on the view that he had no basis for interfering with HHJ Hacon’s interpretation of the defence. In addition, he saw no merit in a broader approach which would, in allowing for Bentley Clothing to prevent use of its mark on a wider set of goods with the introduction of the 1994 Act, at the same time give Bentley Motors the ability to use the BENTLEY mark on goods that it had not used it on before, with no avenue for Bentley Clothing to object.

1 [2019] EWHC 2925 (Ch)

2 [2015] EWHC 256 (Ch)



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Find out what Brexit means for designs at our July webinar

Calendar

Our upcoming events for members

DATE	EVENT	LOCATION	CPD HOURS
28th April	CITMA Webinar There's more to law than IP	Online	1
12th May	CITMA Webinar Implementing better mental health support in the workplace	Online	1
19th May	CITMA Webinar Online enforcement	Online	1
10th June	CITMA Paralegal Webinar* Transactions and recording	Online	1
15th June	CITMA Webinar Domain name disputes	Online	1
22nd June	CITMA Webinar Celebrating Pride	Online	1
15th July	CITMA Webinar Brexit and designs	Online	1
8th September	CITMA Webinar Ethical considerations in advising clients	Online	1
22nd September	CITMA Paralegal Webinar* Oppositions and disputes	Online	1
25th November	CITMA Paralegal Webinar* Renewals and maintenance	Online	1
15th December	CITMA Webinar UK case law update	Online	1

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THE TRADE MARK 20

Q&A



Charlie Bond

dreams of doing a backflip

I work as... a Senior Associate at
Gowling WLG.

Before this role, I was... on a
16-month sabbatical travelling the
world. My holiday recommendation
(COVID permitting): Argentina – it's
an incredible country.

My current state of mind is...
surprisingly content. Although
COVID-19 has been a terrible
disruption to the world, it has
encouraged me to explore Leeds
and the surrounding areas. There
is some incredible hiking on offer.

I became interested in IP... when I
decided to venture away from my
history degree at university and
study an elective module in IP. The
lecturer was incredibly engaging.

I am most inspired by... people who
have a new idea and the drive to make
it successful. It takes a lot of courage
to pursue your own enterprise.

In my role, I most enjoy... the
broad spectrum of people and
organisations I work with, from
the inventor working in his shed
to multinational corporations, and
it means every day is different.

In my role, I most dislike... when
IT equipment malfunctions. I'm
hopeless at fixing things, so it
normally takes a disproportionate
amount of time to resolve a problem.



On my desk are... a selection of
sporting balls. I find it easier to
think about things if I'm throwing
something in the air.

My favourite mug says... nothing.
But a friend of mine has a mug that
says, "If Britney can survive 2007,
you can handle today", which on a
bad day is the mug I wish I owned.

**My favourite place to visit on
business is...** anywhere cold,
because wearing a suit in hot
weather is the worst.

**If I were a trade mark/brand, I
would be...** "Once Upon a Vine",
which is a small wine shop near
my home. It's just a simple play
on words that makes me chuckle.

The talent I wish I had is... being
able to do a backflip, but I fear at
my age that ship may have sailed.

The biggest challenge for IP is...
still Brexit. The UK will have a fight
on its hands to remain the preferred
forum for large international disputes.

I can't live without... Mr Kipling's
French Fancies. As a child, I used to
pinch them from cricket teas when
my dad was playing.

My ideal day would include... an
egg-based breakfast, good coffee,
a walk with my other half and then
the Harry Potter movies until I can't
keep my eyes open.

In my pocket is... nothing. My suit
has oddly small pockets, so nothing
fits in them.

**The best piece of advice I've been
given is...** "keep it simple". This is my
mantra when I'm playing rugby, but
it also applies in a legal context. The
best solution is often the simplest.

When I want to relax... I stick a
movie on and eat my body weight
in sugary treats.

In the next five years I hope to...
hike up some tall mountains and
double my all-time rugby try-scoring
tally of one.

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