

# CITMA REVIEW

ISSUE 467 NOVEMBER/DECEMBER 2021



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new light on  
the subject  
of invisible  
disabilities*

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## PRESIDENT'S WELCOME MARKING OUR MOVE FROM ITMA TO CITMA

As this issue arrives with readers, we will be marking five years since we became a Chartered profession. Even so many years down the line, our Royal Charter is a source of great pride, and I was delighted to read what being part of a Chartered profession means to you on page 14 of this issue.

We're particularly proud of the work we've done over the past five years, in some difficult circumstances. For example, Brexit was a major challenge. Our members have proved their resilience and resourcefulness, not least in helping us to make the case for changing the rules on UK address for service. This was a major achievement for the profession and lays the foundations for future work in this area.

During the pandemic, the IP industry has not only survived but thrived. At CITMA, we have also seen continued growth. Our Paralegal Course, for example, had more participants in 2020/21 than ever before, with 110 candidates passing the exam – congratulations to all. I'm delighted that many of these candidates have already become CITMA members, and I'm sure we will continue to welcome more.

The past five years have been an opportunity for us to demonstrate our collective expertise and to build a community that's adaptable and supportive. The next five, I hope, will allow us to reap the fruits of these adversities under less challenging circumstances. Strengthened by the challenges of recent times, we will continue to offer an environment for sharing knowledge and building relationships. And as the benchmark for trade mark and design professional quality in the UK, we look forward to maintaining and developing that reputation.

Richard Goddard, CITMA President



## Our Paralegal Course continues to soar

Alastair Wither  
Alexis Holland  
Alexander Thompson  
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Amy Fenton  
Amy Goodwin  
Anica Cruz  
Ann Ogunyemi  
Anna Anderson  
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Helen Goodidge  
Holly Gillan  
Jade Addy Sutton  
Jennifer Painter  
Jennifer Thomas  
Jennifer Thomas  
Jenny Mayne  
Jessica Copestake  
Jessica Stalabross  
Jin Li  
Jordana Jukes  
Josh Frame  
Julie Knowles  
Juliet Boyd  
Ka Yan Cheung  
Kate Mears  
Kate Orme  
Katherina Giermindl  
Kathy Oi Nee Chan  
Keira Denton  
Kiera Cloete  
Kirsty Eves  
Lai Ngar  
Leia Wan

The 2020/2021 CITMA Paralegal Course, the official qualification for the trade mark paralegal profession, has seen its highest ever number of successful participants.

The top marks were achieved by Szu-Yu Tao and Gyongyver Filser, who both scored 94 out of 100.

The course covers renewals and maintenance, changes of ownership, oppositions and cancellations, trade mark registrations and searches, offering both breadth and depth. It is the benchmark standard for success in our



## YOUR ADVICE COULD BE INVALUABLE

We're always looking for new volunteers to help staff our free online advice clinics. If you're a Chartered Trade Mark Attorney and interested in getting involved, email [tm@citma.org.uk](mailto:tm@citma.org.uk) to learn more.

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Victoria Colley  
Victoria Hampton  
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Wendy Pritchard  
Wing Tung Tong

industry, with the aim of ensuring that quality remains high across the board.

The course unlocks the door to our CPD scheme, allowing practitioners to continue learning and developing throughout their careers.

The 2021/22 course is now under way.

**Our CITMA Paralegal Hub is a great resource, full of features, guides, job listings and event information. Head to [citma.org.uk/paralegal](https://citma.org.uk/paralegal) to find out more**



## IN MEMORIAM: TERRY JOHNSON

We were saddened to hear of the death of Terry Johnson in September. Terry was an active member of CITMA, a member of CIPA's trade mark committee, and had contributed to the editing of the *Trade Mark Handbook* since 2010. Learn more about his work at [citma.org.uk/tjohnson](https://citma.org.uk/tjohnson)



## PARALEGAL AWARDS

Congratulations to Gail Nicol (Cameron Intellectual Property), who has been crowned Best Trade Mark Paralegal at the 2021 National Paralegal Awards. Two other CITMA Paralegals, JoAnna Emery (Cambridge Mechatronics Ltd) and Kate Houten (HGF Ltd), were also shortlisted.



RICHARD TOWNSHEND

## NEW IP MINISTER

George Freeman MP has been appointed as the Minister for Science, Research and Innovation. This role includes responsibility for all matters relating to IP. We wish him well in his new role and look forward to a fruitful relationship. Read more at [citma.org.uk/minister](https://citma.org.uk/minister)



# WE'RE DRIVING THE UK'S IP AGENDA FORWARD

To be a catalyst for innovation, the IPO must also innovate, says Tim Moss

**The UK Government** recognises that innovation is a key pillar of economic growth. It understands that brands play an essential role in our economy. Strong brands inspire confidence and stimulate activity, helping enterprising companies achieve success in global markets. That's why its Innovation Strategy has IP running through its heart, and it's why the UK's IP environment is widely regarded as one of the best in the world.

At the IPO, we are working to make this IP environment even better. Our new IP Access fund is just one example. Building on our IP Audits programme, it helps eligible small-to-medium-sized enterprises secure and use their IP to develop their business, grow securely and respond confidently to the pace of global change.

We are leading an expanded education programme, delivering more training to universities and the research sector than ever before. Our new International IP service also gives British businesses better access to the UK's IP expertise in key export markets around the world, helping to ensure that a lack of IP knowledge does not act as a barrier to international trade and innovation.

Over the next five years, we will completely transform what we do, increasing the value we contribute to the UK economy.

Our One IPO transformation programme is already yielding benefits for our IP rights customers. Our new digital renewals service has slashed bulk renewal times for IP rights from five days to five minutes, and customers who need to renew a registered design can now do so online. Customers can also renew up to 1,500 IP rights – including combinations of patents, trade marks and designs – in a single digital transaction. This is what you can expect from us in the future: a single, integrated system with all of our services in one place.

But this is just a taster of what's to come as we transform our services for the digital age. Emerging technologies undoubtedly herald some significant challenges and opportunities, as was evidenced by the responses we received to our call for views on AI last year. So, at the same time as we consult on possible changes to copyright and patent law to support this technology, we're seizing the opportunities offered by AI to improve our services.

For example, our new pre-apply service for trade marks utilises machine learning in combination with features such as Optical Character Recognition and is already attracting hundreds of users a day. We're also researching how AI could assist with conducting prior art searches and working with the European Patent Office on the development of its next-generation search tool incorporating a semantic search engine. And through the use of AI, we will streamline our internal processes, making them more accurate and efficient.

Imagining what technological change may await us just 10 years in the future can leave us all feeling slightly in awe. At the IPO, we serve some of the world's best creators and innovators – and so we must be creators and innovators ourselves. We will deliver fast, flexible and high-quality digital services as we work to support the Government's long-term vision for the UK as a global leader in creativity and innovation. We're proud of the IPO's contribution to driving this forward. ●



**Tim Moss**

is Chief Executive of the UK IPO



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# “DISABILITY IS ONE PART OF MY STORY, BUT IT’S NOT THE ONLY PART”

Becky Campbell offers full disclosure about her own hidden disabilities

**D**id you know 20% of the UK population is disabled, often with conditions that don’t have physical signs (known as “invisible

disabilities”)? Or that, according to diversity data published by IPReg this year, 6% of trade mark attorneys consider themselves to have a disability as defined in the Equality Act 2010? It’s likely that the real number is much higher too, since there are many reasons

to keep an invisible disability hidden. For example, half of leaders and managers say that they would feel uncomfortable employing or line managing someone with a neurodivergent condition such as autism, attention deficit hyperactivity disorder (ADHD), dyslexia or Tourette’s syndrome (TS).

What’s more, you may not know that I’m one of them – one of the one in seven people that half of leaders and managers would apparently be uncomfortable employing, as I am neurodivergent.

That particular statistic puzzles me, as I believe my different way of

thinking has been as much an asset throughout my life as it has a hindrance. Some people who are neurodivergent do not even consider themselves disabled, although my view is that it’s more of a mixed bag. Like everyone, I have strengths and weaknesses. Mine are simply different from most people’s.

In fact, according to research published by The Institute of Leadership and Management last year, managers were most biased against hiring someone with ADHD or TS, yet David Beckham hasn’t been held back by his TS, and historians now believe that Mozart had the condition. Meanwhile, ADHD is overrepresented among entrepreneurs, including IKEA founder Ingvar Kamprad and Virgin boss Sir Richard Branson.

Firms such as EY are capitalising on this. Its US branch compared neurodivergent and neurotypical professionals and found that while quality, efficiency and productivity of work were all comparable, neurodivergent employees excelled at innovation. The firm has now founded a “Neuro-Diverse Centre of Excellence” in the UK that will hire neurodivergent individuals to help solve EY’s clients’ most challenging business problems.

Our profession, too, must foster an inclusive environment so that we can reap the same benefits. We don’t just benefit from innovation, we specialise in it. And besides our colleagues, it’s likely that many of our clients are neurodivergent and/or disabled in some ways.

And actually, neurodiversity is just one part of my story. I often joke to friends that disabilities seem to be like Pokémon: you gotta catch ‘em all.

## MY ORIGIN STORY

It’s funny how time flies when you’re having fun. And how it slows to a screeching halt when the car you’re in and the oncoming vehicle do the same. During the summer of 2011, I was (I thought)

# 6%

## OF TRADE MARK ATTORNEYS CONSIDER THEMSELVES TO HAVE A DISABILITY, AS DEFINED IN THE EQUALITY ACT 2010

a boringly healthy 24-year-old teaching English in Japan. My post-LPC gap year was quickly turning into a gap biennial, as I'd volunteered to move from the tropical south to the city of Fukushima, where the recent earthquake and nuclear disaster had led to a shortage of foreign teachers. One week into my new job, my colleagues said they

thumb joint. Thanks to the excellent treatment I received from my Japanese doctors, I made a (pretty much) full recovery.

However, some follow-up investigations for persistent back pain revealed that I wasn't quite as healthy as I thought: I had mild scoliosis and a degenerated disc in my lower back. The most recent part of the puzzle has been hypothyroidism, the early symptoms of which I'd put down to ageing or the rest of my medical history. One particularly scary morning, I awoke with impaired vision in one eye caused by extreme dryness. Another time, I was taken to A&E with nausea and dizziness



Becky's conditions require ongoing monitoring and medication

“ *People with disabilities may start from a different place due to their impairments, but often it is the way society is structured rather than their symptoms that limit them* ”

would drive me to the city to meet the board of education. We never made it, because another car drifted into our lane and hit us head-on.

At the hospital, the doctors had to operate quickly due to the risk of internal bleeding. I awoke in the intensive care unit with an oxygen mask attached to my face and completely unable to move. I fell unconscious again almost immediately and would wake only briefly over the next couple of days. I was diagnosed with a perforation of the small intestine, a lung contusion, a broken clavicle and a fractured

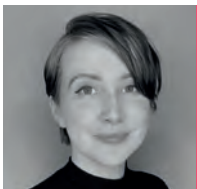
during a heatwave. A blood test revealed that my thyroid, which regulates everything from body temperature and heart rate through to digestion and fertility, hasn't been working properly.

I now take medication every morning to control my metabolism, and I will need to undergo tests to monitor my condition for the rest of my life. Even so, the treatment has given me my energy back. In fact, the combination of hypothyroidism and neurodiversity means I often feel like I'm running a manual Ferrari while my non-disabled colleagues are stuck with an automatic Ford Focus.

### OPPORTUNITY FOR AWARENESS

The pandemic has been a chance for us all to reflect and has brought about a lot more awareness of disability and health conditions, including mental health. I'm grateful that in our profession organisations such as IP Inclusive are leading the way, supported by stakeholders like CITMA and the UK IPO. This will hopefully lead to more people feeling comfortable talking about life with a disability, which will in turn encourage others to talk, as I have here. All of us can be allies in this, by not judging based on physical appearance or assuming that someone is being difficult on purpose.

Above all, remember that disability does not mean inability. People with disabilities may start from a different place due to their impairments, but often it is the way society is structured rather than their symptoms that limit them. We're all complicated and unique individuals; that's one of the wonderful things about being human. Disability is one part of my story, but it's not the only part: I'm a female, Scottish, bisexual trade mark nerd obsessed with bunnies, Japan and gin. I am also disabled. ●



#### Becky Campbell

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*Becky will be speaking as part of our Disability History Month webinar on 24th November.*





# NOW YOU SEE IT

Invisible disabilities and conditions affect people in every sphere of life – including the IP sector. We reveal what the industry can do to help





t the dawn of the COVID-19 pandemic, society at large received a crash course in how the

illness could affect different parts of the population. We learned which groups were most at risk from the virus and who would require the most stringent protection, for instance on the basis of age, ethnicity or dealing with a pre-existing, long-term ailment. But recent evidence shows that we have failed to appreciate how measures to contain the virus have affected one particular group: people with invisible disabilities.

Published in June by the Department of Health and Social Care, this year's UK Disability Survey report revealed that facemask-exempt people with invisible disabilities had been directly harassed – and even physically assaulted – in public spaces over the previous year. Even people with sunflower lanyards, which are specifically designed to announce that holders are living with invisible disabilities, reported having issues. As well as experiencing harassment and assault, some respondents had been denied entry to businesses and public transport as a result of not wearing a mask. Meanwhile, one disabled person drew attention to the difficulties faced by those with hearing loss and who are dependent on lip-reading: “Face masks make it nearly impossible to speak to anyone unless the person is wearing a clear mask/face shield.”

By providing new data for those tracking issues for disabled people, the pandemic has shed overdue light on one of our most underheard and underdiscussed social groups. As the report notes, “it is crucial to raise awareness of invisible disability... and promote an understanding of the diversity of disability.”

#### AWARENESS GAPS

So, what exactly constitutes an invisible disability? Essentially, it's any physical or mental ailment, impairment or disorder that requires careful, day-to-day management but

which, to most observers, is not outwardly evident. Some of the main categories include:

- Hereditary ailments – eg, sickle cell disease, cystic fibrosis;
- Neurological impairments – eg, hearing loss, dystonia;
- Neurodiverse states – eg, autism;
- Mental illnesses – eg, anxiety or depression, eating disorders, bipolar disorder, obsessive-compulsive disorder (OCD); and
- Progressive-degenerative diseases – eg, Parkinson's disease, some symptoms of which are invisible and, for a time, may be the only effects that certain sufferers experience.

Other conditions that could fall on the spectrum are: arthritis, autonomic dysfunction, chronic fatigue syndrome, Crohn's disease, epilepsy and multiple sclerosis. And if we widen the net, people who are living with cancer or heart disease will often have symptoms that are invisible to the outside world.

Comprehensive figures on invisible disabilities are hard to pin down. In the 2019 to 2020 edition of the UK Family Resources Survey, 5.1 million people reported that they were living with a stamina, breathing or fatigue condition, while 4.1 million said that they were managing challenges around mental health. However, each category would contain a blend of respondents whose symptoms are visible and others whose conditions show no outward signs. As Paul Fuller, executive director of partnerships at disability charity Scope, explains, “One in five of us in the UK are disabled, but this is not always obvious.” In recognition of how common it is to have an invisible disability, Scope ▶

“Essentially, an invisible disability is any physical or mental ailment, impairment or disorder that requires careful, day-to-day management but which is not outwardly evident



has recently launched a campaign on the subject in partnership with ITV.

Part of the problem is that the field of invisible disability is littered with information and awareness gaps that risk fostering, in Fuller's words, "negative attitudes, social isolation and a lack of understanding". But as organisations become more aware of issues around workplace diversity, closing those gaps must be a priority for every industry – including the legal sector.

#### POTENTIAL HAZARDS

Birmingham-based Megan Rannard, an Associate at Marks & Clerk, lives with Ehlers-Danlos Syndrome (EDS), a rare hereditary condition that affects her body's joints and connective tissues. Rannard says that she looks "normal and healthy around 80% of the time", with the other 20% spent on crutches or wearing a sling.

However, those percentages are not indicative of day-to-day living, as Rannard regularly struggles with menial, physical tasks, including those related to work. Balancing her condition with her professional routine presents frequent obstacles. "I can't tell my colleagues that I'm going to be unwell for the next 72 hours," she says, "because I won't know until it happens. That can be quite challenging, particularly if work is really busy and I wake up to find that something has dislocated. Juggling the two is tricky: you don't know how busy you're going to be, and you don't know when the next flare-up is going to strike."

For Rannard, everyday aspects of navigating an office are fraught with potential hazards. "It can be surprising for some people how much I struggle with simple things," she says. "Big, floor-to-ceiling glass doors are difficult for me to open. Pulling a heavy chair out from under the meeting-room table can actually

be quite painful. Even when I'm opening the fridge or putting the kettle on in the kitchen, I have to be careful not to dislocate any wrists, elbows or thumbs. So, the whole question of how to put in place a safer work setup isn't just about immediate objects like a desk and keyboard. It extends well beyond those."

EDS has also posed hurdles in the course of Rannard's specialist subject-matter training. "Trade mark attorneys are required to do two courses, which we must attend in person," she explains. "The first course involves travelling down to either London or Bournemouth. In my four years as a trainee, what I've probably found hardest to deal with is the combination of the mental demands of learning, training and taking exams at the same time as having a full-time job, and the physical demands of travelling, doing loads of overnight stays and sitting in lectures.

"Often, the course modules will nudge into the weekend, so you will only have half the weekend left to rest and recuperate. This is all very specific to the IP world. Plus, every year I've had to go through a process of providing proof of disability to secure exam adjustments, as I can no longer write with a pen because of my fingers."

But despite the manifold effects of EDS on her lifestyle, its invisible status most of the time has led Rannard to experience unhelpful preconceptions. "You never quite know how people are going to react," she says. "When I was with some friends recently, I was introduced to someone I hadn't met before. My friends and I were joking about something to do with my condition, and the new person just looked me up and down and said, 'You're not disabled.' I had to say, 'Um, sorry... I am!' When you've had a few experiences like that, it can make the thought of being open and honest about it a bit nerve-racking."

#### RALLYING ALLIES

Rannard is a committee member of IP Ability, a branch of diversity and inclusion awareness group IP Inclusive. One of her fellow members is Kerry Russell, a specialist IP

*“ The field of invisible disability is littered with information and awareness gaps that risk fostering negative attitudes*





**“ Deepening your own understanding of disability is a crucial part of being a good ally. Learn about the advantages you experience as a non-disabled person**

solicitor and head of the internal Diversity and Inclusivity network at law firm Shakespeare Martineau.

“Within our profession, there are definitely challenges around invisible disabilities,” says Russell. “For example, one rather big talking point in IP Ability recently was the decision by the European Patent Office (EPO) to conduct almost all of its proceedings virtually. Given the impacts of COVID-19, the EPO considers this to be the most inclusive way forward. But if you have a hearing impairment and rely on lip-reading, your understanding of proceedings may be only as good as the quality of the stream, or the size of the speaker’s mouth on the screen. And if you have an invisible condition that leaves you with regular migraines, looking at a screen for hours at a time during an EPO session may not be the most appealing prospect.”

On a wider, everyday level, Russell explains: “Someone who is dyslexic may experience challenges with interpreting patent or trade mark documents and may require special

provisions to assist them. On the other hand, a neurodiverse individual may find that they are well suited to a task such as drafting patent specs, because of a facility for interpreting and structuring information.”

Within her own work, she notes: “I really like to be around other people, but I know from workshops I’ve done with my team that some of them are far more geared towards a quiet environment where they can focus on absorbing material without interruptions. So, while lockdown didn’t work for me, it was a good fit for some of my team mates.”

Against this tapestry of differences and contrasts, Russell stresses that empathetic allyship on the part of non-disabled colleagues and senior figures is vital. “This isn’t simply a case of doing some tick-box unconscious bias training,” she says. “It’s about understanding people’s challenges, accepting them as facts of life and acknowledging that different people will approach their challenges in different ways. Some employees may prefer not to talk about them very much at all, while others will feel that they benefit from the pressure valve of regular, confidential chats.”

Effective allyship, Russell notes, is based around three pillars:

1. **DO YOUR RESEARCH.** “Learn as much as you can about the lifestyles of different types of people – not just in the field of disability, but all forms of inclusivity. It’s likely that on your team you will have people with a disability, people who are gay and others who are from different cultural backgrounds. Knowing how those factors influence their daily lives will help you be inclusive. There is plenty of online material to dive into that will open your eyes to how different people experience the workplace.”

2. **HARNESS THE POWER OF NETWORKS.** “If your organisation doesn’t have a disability-focused employee network, create one. Once you have one, make sure it welcomes non-disabled staff. When I entered the workforce, I went to lots of LGBTQ+ events, which was great, but I quickly realised that everyone who turned up was LGBTQ+, so we were all preaching to the choir. Being an ally who has no reason to be part of a particular network but who happily shows up anyway sends a really powerful message.”

3. **MAINTAIN CONSTANT EMPATHY.** “In your day-to-day work with your team, take an open-minded approach and convey to your colleagues, ‘I’m here to talk if you want to, but you don’t have to explain things to me if you don’t want to.’ When I think about my team, we definitely have that type of atmosphere. We get it. We trust each other. We’re here to support each other. That’s really important.”

Fuller agrees that there are many things that can be done at both an individual and organisational level to support people with invisible impairments or conditions. Start, he says, by not making assumptions about other people’s disabilities. “Deepening your own understanding of disability is a crucial part of being a good ally. Read and learn about the advantages and benefits you experience as a non-disabled person and how to champion disabled people’s rights.

“Organisations must do everything they can to champion accessibility and inclusion. Businesses should ask their employees about any needs they might have and create an environment where people feel comfortable expressing themselves and sharing information. Truly inclusive workplaces are those that create opportunities for everyone to thrive.” ●

*The Law Society has created two publications on Easy Wins and Action Points for Disability Inclusion, one for smaller and one for larger organisations. Download these at [lawsociety.org.uk](http://lawsociety.org.uk). For information from Scope, go to [scope.org.uk/campaigns/invisible-disabilities-itv](http://scope.org.uk/campaigns/invisible-disabilities-itv)*





# WHAT YOU TOLD US ABOUT BEING CHARTERED

To mark the fifth anniversary of our Royal Charter, we asked members what it means to them

**H**and-inscribed on vellum by illuminator to the Crown Office Timothy Noad, our Royal Charter is displayed proudly in a bespoke frame at the CITMA office. But our Royal Charter is far more than just a combination of artistic talent and gold leaf; it showcases who we are as a proud profession and underlines the expertise and skill that CITMA members provide.

“I love being Chartered,” says Becky Campbell, an Associate at Mewburn Ellis. “It adds real gravitas to the profession and reassures clients that they’re dealing with

someone who will give them a high level of service.”

When Lee Curtis, now a Partner at HGF, first joined the profession in 1993, his job title was Trainee Trade Mark Agent, which he says often led to confusion. “I was often asked, ‘Is that like an estate agent?’ Over time, I became a Trade Mark Agent, a Trade Mark Attorney and finally a Chartered Trade Mark Attorney.

“What does the Chartered title give me? It shows that our profession

is on a par with other Chartered professions. It might also mean that the Queen understands that I am not an estate agent (no disrespect to estate agents).”



## THE ROYAL SEAL

It was at Windsor Castle in spring 2016, at a meeting of the Privy Council, that the Institute of Trade Mark Attorneys (ITMA) was granted the Royal Charter. This culminated in the Great Seal of the Realm being applied by the Crown Office in November 2016

and the Royal Charter legally coming into effect. Becoming Chartered was not a straightforward process; it was the culmination of a great deal of hard work. Chris McLeod, Partner at Elkington + Fife and former CITMA President, recalls feeling “immense pride” when, as a profession, we were granted the status. For him, it meant far more than just changing a job title or adding a credential to a website profile. “Being able to refer to myself as a Chartered Trade Mark Attorney enables me to distinguish myself from an increasing number of competitors who are not. On a more general level, I think that it gives CITMA members more clout and enables us to gain new clients and reinforce relationships with existing ones, particularly when we can also say that we are regulated externally.”

This is a view backed up by many others, including Jennifer Heath, an Associate at D Young & Co. “In terms of the impact on the wider profession, being able to state to clients that you are a Chartered Trade Mark Attorney adds a certain weight to conversations and provides a further level of assurance,” she says. “It has been an important and invaluable step to signify expertise.”

Many have joined the profession since we became a Chartered occupation. Alexandra Nott, a Chartered Trade Mark Attorney at Dehns, who started her training in 2016, says: “The significance of the Royal Charter is immense and was something I felt keenly, since I had only recently joined the profession when it was awarded. It was exciting to be starting my career in a field that was receiving recognition for its quality, skill and expertise, and it served as a reflection of the incredible talent of trade mark attorneys past and present and has inspired me to follow in their footsteps.”

#### DEMONSTRATING BEST PRACTICE

Regulation and the rigorous process required to become a Chartered Trade Mark Attorney are things being Chartered can help you to demonstrate clearly. As Azhar Sadique, a Partner at Keltie, says: “The Chartered status as applied to the profession has added another layer of professionalism and

commitment to the standards that we are governed by.

“Given the change in the examination system and the ever-growing demand for expertise from our clients, I think it acts as a well-earned tip of the hat to professionals who have worked hard to qualify and act as Chartered Attorneys,” he adds. “There is also a lot of trust in such a status, and it demonstrates immediately that, as a profession, we put our clients’ interests first.”

Chartered Trade Mark Attorney Becky Knott agrees. “Securing Chartered status ensures that the industry recognises the weight of what we do. It’s a seal of approval on our expertise. It has reinforced public trust in the profession, which leads to a greater volume of work and more opportunities. Being able to wear the ‘Chartered’ badge makes me very proud to work in the profession.”

Carol Nyahasha of Baron Warren Redfern feels that “being a Chartered Trade Mark Attorney gives you credibility, and the accreditation is good for the profession as a whole as it lifts the level of everyone to one of recognised professionalism, knowledge and skills. To me, being Chartered has meant having my experience validated to existing and future clients. It makes me very proud being a part of a professional body that sets high standards and holds itself and its members accountable for maintaining them.”

#### A PROUD MOMENT

The honour of being President at the time of launching CITMA fell to Kate

O’Rourke, now a Partner at Mewburn Ellis. She recalls the warmth of the reaction and the joy she felt during “one of the proudest moments of her life”, when she was presented with the Royal Charter for the Chartered Institute of Trade Mark Attorneys at the College of Arms on 23rd November 2016.

“That day was the culmination of a great deal of hard work and dedication by a small group of people, particularly Keven Bader as Chief Executive, who was the main liaison between all of the parties with an interest in the process – not all of whom had supported our previous applications for Chartered status.

“To receive the Charter was to be recognised as the pre-eminent body for trade mark advice in the UK and meant that trade mark attorneys finally had formal status equivalent to our colleagues at CIPA, CILEX, the Law Society and the Bar Council. The congratulations I received after the announcement illustrated the respect that Chartered status brings to the profession and also showed the warmth of affection towards CITMA and its members from people all around the world.”

The feeling of trust and expertise extends well beyond our membership. At the time of launch, Mr Justice Arnold summed it up by saying: “The grant of a Royal Charter operates as a ‘kite mark’ certifying the quality of the body that provides the services – and, in the case of the Chartered Institute of Trade Mark Attorneys, what could be more appropriate?” ●



The CITMA team celebrates with the Royal Charter



# AUTUMN CONFERENCE 2021:

# REPUTATION, RESOLUTION AND REVOLUTION

Once again our delegates delved into a variety of topics over the course of a packed two-day programme

**R**evolutionising our thinking, gaining a deeper understanding of dispute resolution, and the importance of reputation management were the key themes of our Autumn Conference. In particular, our speakers provided insights into the ingredients of a successful mediation, the tools needed to execute a settlement agreement, and different ways to manage reputational risks in a trade mark dispute. These were just some of the topics put under the microscope.

## INSPIRATIONAL ADDRESS

In his keynote address, David Stone (Global Head of IP, Allen & Overy) inspired us to continue practising inclusion and maintaining the diversity and quality of the profession. Referring to the “twin hurricanes” of COVID-19 and Brexit, he noted

that the IP industry has shown “both resilience and kindness through a difficult time”.

He thanked CITMA for our leadership through the tribulations of Brexit, in particular Keven Bader and former President Kate O’Rourke for their work in negotiating the best possible deal for our members and their clients.

Commenting on diversity, David noted that the IP profession is now predominantly female and that first-generation university students

are now well represented. However, barriers to true diversity remain. David commented: “None of the attributes of success are specific to white people, male people or straight people.”

With the COP26 global summit on climate just around the corner, David concluded that we must continue to consider the environmental repercussions when making day-to-day decisions, particularly now that we understand the potential and effectiveness of remote working.

## UK CASE LAW UPDATE

After David’s address, Manuela Macchi (Keltie) offered us a summary of key cases in UK case law this year. She commented first on *Lifestyle Equities CV & Another v Amazon UK Services Ltd & Others*<sup>1</sup>, which the judge described as “not a normal case of trade mark infringement”. This case demonstrates how globalisation and

David Stone







Richard Danks



Manuela Macchi



Lauren Buchan



Jayne McClelland

the possibilities of e-commerce also come with potential pitfalls.

She then moved on to discuss *Fox Group International Ltd v Teleta Pharma Ltd*.<sup>2</sup> Here, Judge Melissa Clark concluded that the threats of infringement proceedings were unfounded. Manuela highlighted the importance of thorough research to ensure that there is real infringement before issuing an action or a claim.

Next, she discussed *Pliteq Inc & Another v iKoustic Ltd and Another*.<sup>3</sup> In which iKoustic continued to advertise Pliteq's products after their partnership had ended, and subsequently directed customers to its own products. Because iKoustic was simply selling off the remainder of its Pliteq stock, the judge determined that this activity did not amount to infringement.

Finally, Manuela commented on *Philip Warren & Son Ltd v Lidl Great Britain Ltd & Others*.<sup>4</sup> In this case, an independent butcher based in Cornwall accused Lidl of passing off through its "Warren and Sons" brand. The case was dismissed due to a lack of evidence of misrepresentation. It demonstrates the importance of local context when considering misrepresentation. Here, the two providers operate at different points in the local market and there was limited crossover.

**IN-HOUSE PERSPECTIVES**

Featuring Lauren Buchan of Dentsu International, Richard Danks of NatWest and Jayne McClelland of Syngenta, and chaired by Eleanor Merrett of CMS, our panel talk covered the parallel issues of how

environmental, social and governance (ESG) factors and developments in innovation change the work we do and how we do it.

On the topic of the environment, Richard noted that, as a cornerstone of a society, banks must be key players in solving climate change. Through developments such as offering customers carbon footprint trackers, individual responsibility becomes possible.

Jayne introduced Syngenta's Good Growth Plan, which outlines key targets based on the UN's guidance. This includes initiatives to benefit small farmers – who account for 78% of the global food supply – biodiversity and soil health, among many others.

Lauren argued that the new focus on the environment is "a shift that has to be addressed", commenting that its newfound relevance is evident in the work she and her colleagues find themselves doing.

every area of the industry. She presented two key questions: "If there were no barriers, how would I do this?" and "What barriers do we need to remove to achieve our goal?" Lauren noted: "I think innovation gets too focused on tech. It's important to remember that an innovative idea can be a simple one."

**REPUTATION, REPUTATION, REPUTATION**

"Reputations do matter. While you are setting up the legal process and really understanding what is going to happen in terms of the cases you are involved in, we are thinking about the other audiences who are not inside that legal process," Claire Davidson, a Partner at DRD Partnership, told delegates. "We are thinking about people who could be employers, shareholders, investors, consumers, clients, policy makers and regulators,



Eleanor Merrett (CMS) chaired our panel providing in-house perspectives on innovation and the impact of ESG

The social and governance elements of ESG are also evident across the board. For example, both Dentsu and NatWest are exploring virtual internships, as these may help to overcome cost and location barriers. Richard emphasised the importance of adopting "more of a sense of personal responsibility", for instance asking: "What are the smaller things that my team and I can do?"

Discussing innovation, Jayne noted that in the past innovation was perceived as achieving higher efficacy and lower levels of wasted effort. However, it now runs through

and through the spectrum of media and social media, the general public."

With so many cases being played out in the court of public opinion, it is important for us all to appreciate what makes a trade mark dispute of interest to the British media. The criteria Claire set out included:

- Legal precedent;
- High-profile brands;
- A David v Goliath narrative; and
- Public interest.

She went on to tell delegates: "The underdog is something that the British media loves. These David and Goliath trade mark stories are often about a ▶



Tom Cadman



David Holdsworth



Andy Bartlett



Claire Davidson

major household name picking on [a brand or organisation that is] smaller. It becomes worse if you have a really fantastic face to the 'David' and a fantastic backstory."

Claire wrapped up by reminding us that we need to recognise that trade mark disputes can become huge news stories across media and social media, and we need to think about how our cases will be perceived beyond the litigation itself. Scenario planning with clients is important, she concluded.

**ONE IPO**

David Holdsworth (Deputy CEO and Director of Operational Delivery) and Andy Bartlett (Director of Transformation) from the UK IPO were on hand to take delegates through the office's One IPO programme. Currently, trade marks, patents and designs all exist in different systems; the IPO wants to bring this all together.

David began by putting the work into the context of the recovery from COVID-19 and the changes following Brexit. "The IP system is an integral part of the economic ecosystem for the UK and any nation around the globe. We have announced a series of initiatives to make IP more

accessible to help businesses maximise the value of IP. For us, being part of that ecosystem is supporting the government in supercharging the economy," he said.

There has been substantial growth in trade mark applications, a strong sign of positive economic activity. David described the almost four-fold increase in monthly trade mark applications to the IPO. It is now consistently seeing between 15,000 and 16,000 new trade mark applications a month. "We are growing, but we need our systems to keep pace to give you the best experience," David told delegates.

**EU CASE LAW UPDATE**

Dr Frederik Thiering from Bird & Bird touched on 10 significant EU judgments from the past year, providing an overview of key developments.

In *Ardagh Metal Beverage Holdings v EUIPO*<sup>5</sup>, the Applicant attempted to file the sound of a can opening followed by a second of silence and a nine-second "tingling" noise. This was rejected because the audio file submitted was not sufficiently unique to the product and was a functional aspect rather than a distinct feature. It also did not "depart significantly from normal customs".

The Applicant appealed again, but this led to confirmation that the sound did not have recognition value.

He also explored *achtung! v EUIPO*.<sup>6</sup> This mark was rejected due to the fact that "achtung" is simply the German word meaning "attention". The Applicant claimed that it can also have other meanings, including referring to appreciation or respect, but the judge established that the inclusion of the exclamation mark specifies that it should be read as "attention". The mark would therefore be perceived as an advisory or advertising message, not as a specific slogan.

Commenting on *Oatly v EUIPO*<sup>7</sup>, Frederik noted that the inclusion of the word "but" in the slogan "It's like milk but made for humans" calls into question the notion that dairy milk is a normal thing for humans to consume. This sets off a cognitive process in the mind of the consumer, building recognition between the statement and the brand.

**MEDIATION: BUST OUT OF THE BOX**



"Mediation offers parties full control over the method by which their dispute will be submitted and the outcome of the process," Tom Cadman from the Chartered Institute of Arbitrators told our delegates. Mediation is a non-binding procedure, which means that those involved do not need to continue after the first meeting. It also means that a decision cannot be imposed upon the parties – it must be agreed by those involved.

Tom suggested that mediation can be a useful route to resolving a dispute where any of these are priorities for one or both of the parties:

- Minimising cost exposure;
- Maintaining control;
- A speedy settlement;
- Confidentiality; and/or
- Preservation or development of a business or commercial relationship

Denise McFarland (Three New Square) was one of those discussing the opportunities offered by alternative dispute resolution







Dr Brian Whitehead (Haseltine Lake Kempner) explored settlement agreements in IP disputes



(eg, a licence, distribution agreement, or research and development contract).

Experienced mediator Guy Tritton, from Hogarth Chambers, told delegates that “out-of-the-box thinking is very important to a successful mediation”. He shared two key ways a mediator might try to break a deadlock.

The first was risk analysis. Using this strategy, the mediator gets the parties to look at their best- and worst-case scenarios should no settlement be reached and the matter goes to trial. For example, he suggested, the mediator will try to reorientate the parties from thinking that they are conceding hugely if they accept £25,000 in damages and not £150,000.

The second route is to focus on the interests of the parties. “Once you identify the interests [of the parties] an agreement can be reached fairly quickly,” said Guy. “For example, it may be in the interests of both parties that the defendant enters into a licence agreement with quality controls that prevent reputation loss.”

However, Denise McFarland from Three New Square offered a different perspective. “Mediation is a great option, but it’s not the only option,” she told delegates. Early neutral evaluation (ENE) is another way to resolve disputes, for example.

Compared to facilitative mediation, ENE involves an independent party expressing a merits-based opinion about the dispute at an early stage. Commercial benefits of ENE include:

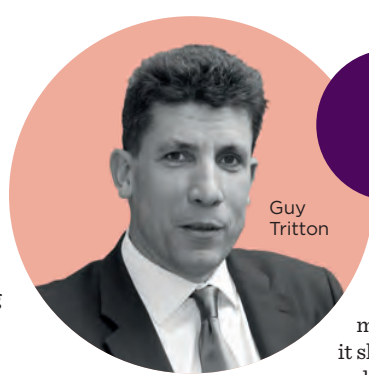
- Speed;
- Assisting with identification of the issues;
- Providing a focal point for the parties; and
- Facilitating a realistic starting point to explore arbitration or mediation.

### SETTLEMENT AGREEMENTS

Dr Brian Whitehead, a Partner at Haseltine Lake Kempner and an

Appointed Person, explored the practicalities of executing a settlement agreement and identified different ways to ensure that the agreement is watertight. He shared three key tools that can be used to achieve a settlement: the without prejudice rule, subject to contract, and Part 36 offers.

While all three are powerful and can be used to significant effect, Brian said that he finds Part 36 offers to be “useful when the parties are largely in agreement that there is infringement but very far apart on damages”. For example, he continued, Part 36 offers can help “where there’s a claim for damage to reputation or a claim for



Guy Tritton

lost sales but the defendant maintains that it should be on a royalty basis”.

He went on to discuss the formal requirements of an agreement. This included consent orders: if proceedings have already been issued, either a Tomlin order or a standard order is required. It is also crucial to consider the clauses bespoke to the contract, including delineating what is and isn’t included in the contract, whether there are any claims already in existence and the parties’ obligations to one another.

On the topic of boilerplate clauses, Brian commented that: “It’s very easy and tempting, because they are a standard block of text, to treat them as unchanging. This is, perhaps needless to say, a mistake.” It’s important to review these clauses each time to ensure that they are necessary in the specific contract and that they don’t require adaptation.

Finally, Brian shared his 10 key areas to take into account and a case study to demonstrate the potential for enforcement rights to degrade over time.

- 1 [2021] EWHC 118 (Ch)
- 2 [2021] EWHC 1714 (IPEC)
- 3 [2020] EWHC 2564 (IPEC)
- 4 [2021] EWHC 2372 (Ch)
- 5 T-668/19
- 6 C-214/19 P
- 7 T-253/20



Dr Frederik Thiering (Bird & Bird) took delegates through a review of significant EU judgments





# GET THE BALANCE RIGHT

Beverly Robinson reports that when it comes to training during the time of COVID-19, there's no ready-made formula



**F**ortunately, the legal sector in the UK has remained fairly stable throughout the COVID-19 pandemic.

Although some areas of law have suffered more than others, the IP industry continues to benefit from constantly developing business and innovation. Nevertheless, even for IP, there have been significant changes to working practices. Firms have had to adapt quickly and efficiently to the new working environment. In particular, trainees and junior members within the industry have faced specific challenges. So, how have the firms and individuals in our professional community responded?

#### ROUTES TO QUALIFICATION

Although the main routes to qualification for trade mark attorneys have not changed, methods of teaching and assessment have had to adapt (and quickly) over the past 18 months or so.

Vishal Dattani, a Trainee Trade Mark Attorney at Appleyard Lees IP LLP, attended the Queen Mary University of London course this year, in what we can all agree have been exceptionally challenging circumstances. "I have had to manage working online both in the office and while studying," he explains, adding that "the teaching at Queen Mary has had to change to a combination of 'live' (online) and recorded lectures due to the pandemic. Adapting to a new style of teaching was a tricky obstacle and one which places more of an onus on the individual."

Lizzie Sergeant, a Trainee Trade Mark Attorney at CMS, is just coming up to the end of her training, having attended the Nottingham Trent University course this year. In her view, the Nottingham course has been



well conducted given the unusual circumstances, with opportunities to collaborate and undertake group activities. However, it hasn't provided the same learning experience as in previous years, she feels, mostly due to the lack of separation between work and the course, and the amount of screen time involved.

Having completed the Queen Mary course in 2019/20, Nicole Marshall, a Trainee Trade Mark Attorney at Appleyard Lees IP LLP, experienced taking exams in both the traditional circumstances of an exam hall and online at home. "While at-home exams can create a less-pressurised environment and so levels of stress and anxiety surrounding the exam may be reduced, it was not all positive," she says. "Revising for and taking my exams from home, without

personal interaction with course friends and colleagues, was a much lonelier experience. Much of the preparation was done alone, and I had to celebrate the end of my exams and the course alone too, which is something that had a much greater mental impact than I realised it would do. The lack of social interaction during revision and afterwards was definitely something that I had to overcome."

For many, an important part of attending the training courses is getting to meet and build relationships with individuals at the same level. With in-person classes being replaced with online learning, the opportunity to build these career-lasting relationships is lost. "Meeting your peers online is an option, but I don't think it's a replacement for forming those relationships in person," says Vishal.

I can sympathise. I'm still in touch with many of the people I trained with, and I know from my own experience that the relationships you build while training provide a vital support network throughout your career. After I qualified, I attended a series of seminars and talks specifically aimed at newly qualified trade mark attorneys (PQE 1-2 years), and perhaps

*“ Meeting your peers online is an option, but I don't think it's a replacement for forming those relationships in person ”*

similar types of events in the future will help the recent cohort of trainees to build these important relationships.

### GAINING PRACTICAL EXPERIENCE

One of the biggest challenges that firms have faced is making sure that the benefits of shared knowledge and collaborative working that come from being together in an office is not lost. The value of overhearing conversations, observing colleagues and learning by osmosis from those around us should not be underestimated. This type of learning forms a big part of development for all levels of attorneys but is particularly important for trainees and more junior members of a team who are reliant on this type of training to gain the practical experience required to move forward.

For this reason, firms are keen for trainees and more junior members of the team to migrate back to the office. “The last 18 months have shown that being in the office and interacting with qualified colleagues is key to elevating a candidate from

simply qualifying as an attorney, to becoming a trusted commercial adviser,” says Jennifer Good, a Trade Mark Director at HGF. “It’s the ‘soft skills’ that are learnt through seeing how others deal with clients that help to give trainees the confidence to know how to tackle queries that may come their way.”

Sam Turton is a Trainee Trade Mark Attorney at Appleyard Lees IP LLP and has experienced this first-hand. “It has been somewhat a challenge to be in a trainee role and working from home. It would have been ideal to train in the office alongside other more experienced attorneys in order to better understand how the law is put into practice and how we make information accessible for the client. At the office, there are always other people around to ask the smaller, routine questions that are easier to deal with in person rather than via email.”

“There definitely isn’t the same exposure to the day-to-day, ad-hoc conversations or opportunities, which in turn generate feedback and identify other areas for development,” says Lizzie Sergeant. “The

“ *Having to undertake my training remotely has encouraged me to be more proactive, independent and resourceful* ”

opportunities are still there, but there is a greater need to put yourself forward for things and communicate more actively, which is often more challenging for trainees.”

Nonetheless, even though almost half of Lizzie’s training has been based on remote learning and despite the ongoing challenges, she has had a really positive experience of training. It has shown her that there is room for a range of different training formats and that remote training can provide some really valuable opportunities. “Since the pandemic, I have found that there is a much greater emphasis on checking in on colleagues, which has allowed me to grow my internal network, both with colleagues in the UK and internationally, and ultimately provided me with more insight on various matters. Generally, having to undertake my training remotely has encouraged me to be more proactive, independent and resourceful.”

### MENTORING RELATIONSHIPS

Firms have introduced measures to try and replicate the benefits of office working, but there is no doubt that the training/mentoring dynamic has changed. “Even where trainees were part of a close-knit team before the pandemic hit, they are less likely to call or email a colleague or line manager to





check that they are heading in the right direction than they would have been to ask a quick question in the office,” notes Jennifer. “This has led to tasks inadvertently being completed incorrectly, which takes up extra time for both the trainee and the line manager.”

The pandemic does certainly seem to have made people think more about the trainee and mentor relationship, and the importance of maintaining channels of communication between junior and more senior members of a team. “Mentors have had to adapt a more proactive approach, and this in turn sets an example to the junior team members,” says Lizzie. “Having benefited from regular check-ins and workload reviews, I try to do the same with other members of the team and any new joiners.”

“I think the onus has shifted and there is now even more responsibility on trainees to make an effort to speak to their mentor and seek opportunities,” says Vishal. “It’s important to put yourself forward for things and ask to participate in meetings and calls so you still get to experience more senior fee-earners in practice. Then, actively seeking feedback is also important to make sure you are getting the most out of that training.”

#### **SOUPED-UP SUPPORT**

Most firms have introduced additional support for trainees. This might mean, for example, a dedicated training principal in addition to the partner/mentor overseeing the training, or open Zoom sessions to ensure that trainees and more junior members of the team have a strong support network in place.

“We now have daily drop-in sessions each morning, which allow all fee-earners to sit in to discuss any issues or queries they may have or just to have a



catch-up generally,” says Vishal. “This has provided a forum where I’m able to share and discuss any queries I may have, and I can listen to others and learn from different experiences, approaches and thought processes. These sessions have also allowed me to collaborate cross-office and speak to members of the firm and work on matters that I may not have previously had the opportunity to get involved with.”

A common theme in my discussions with colleagues and peers is that remote working has resulted in a breakdown of barriers between people who wouldn’t normally have had the opportunity to work together, particularly in cross-office environments. Nicole Marshall has found that circumstances have presented an opportunity for her to work with a broader range of colleagues, allowing her to benefit from a broader range of experience.

“Working and training from home has definitely increased the collaboration of the trade mark team across the firm,” she says. “As a trainee in Manchester, when we were working from the office, if I had a query I would usually go to senior staff from within the same office. I would have little contact with the trade mark teams in Leeds, Halifax and Cambridge. However, now that we are working from home and most queries are made via email or instant messenger, it is a lot easier to discuss matters with colleagues across the other offices. This has

allowed me to receive training from multiple people and learn from their experiences.”

#### **SOCIAL INTERACTION**

The loss of social interaction during the pandemic has affected most people, regardless of position or level of qualification. Feeling isolated is detrimental to wellbeing and mental health, and firms recognise that this is key to nurturing a happy and productive workforce.

For many, building and maintaining these important relationships comes more naturally in an office environment. “While we’ve seen some line managers put in additional effort to remain in contact with trainees during the pandemic – both on work-related matters and for more social interaction – this can sometimes be a bit forced or awkward, particularly if there is nothing specific to discuss. In the office, colleagues are much more likely to just say ‘Hello’ and have a quick catch-up without much in particular to say, or to pick up on signs that might suggest that a trainee is worried or anxious. It is therefore much easier to look after each other and notice issues swiftly when we are in the office together,” explains Jennifer.

If anything, Lizzie believes that the circumstances over the past 18 months have resulted in people taking more of an interest in others’ wellbeing. “I have regular scheduled meetings with supervisors to talk through work



*“ In a world where agile working is becoming more and more normal, it’s good to instil the skills associated with that at all levels*

matters, and separate meetings scheduled to have general chats, so we still have that personal interaction. I wouldn’t say the support is better or worse in comparison with pre-COVID times, but there is probably a more conscious effort from both sides (trainee and supervisor) to maintain a good relationship, which is no bad thing.”

With more emphasis on online events, there has generally been more opportunities for trainees and more junior team members to attend events. “During the pandemic, networking has changed drastically to adapt to the restraints created by lockdowns and restrictions,” says Sam. “In my experience, networking opportunities have still been plentiful, albeit mostly through the medium of Zoom. In many ways, this adapted form of networking is beneficial to trainees, given that everyone gets the same amount of time to speak and there is no way for people to retreat into cliques.”

Vishal has also found that this has presented opportunities that might not otherwise have been there. “I have been fortunate to be given the opportunity to sit in on meetings between the Anti-Counterfeit Group and the

legal teams who work in-house for multinational worldwide companies, or stakeholders such as the UK and US border forces, which might not have been possible had the meetings all been in person.”

**LOOKING FORWARD**

As we navigate our way out of the pandemic, most firms have seen a gradual return to some office working over the past couple of months, with both employers and employees keen to regain some of that social interaction and collaborative working. However, it is clear to see that the pandemic is going to have a long-term effect on the industry and the way we work.

“I think that working partly from home as an option is viable and that recent circumstances have shown that it can be done if properly supported,” says Vishal. “Having said this, I think that seeing your mentor in person is

critical to development. Going forward, I think a balance of two or three days in the office and two or three days at home per week would work well.”

In a similar vein, Lizzie feels that adapting with the times and benefiting from a mix of both home working and office working is a good way forward. “The pandemic has provided an opportunity for training methods to be re-evaluated, and if there is scope for various forms of training, then I think that’s good. I don’t think remote working should entirely replace office-based working, as there are benefits to both, and in a world where agile working is becoming more and more normal, it’s good to instil the skills associated with that at all levels.”

Historically, the legal industry has had a bad reputation for long working hours and a poor work/life balance, and most firms were starting to look at introducing some elements of agile working before the pandemic. However, the pandemic accelerated this trend and illustrated vividly the benefits of hybrid working arrangements. Although most firms recognise that there is a definite benefit to retaining some office time, most are now introducing hybrid arrangements allowing greater flexibility and a much-improved work/home balance. The key seems to be getting the balance right and ensuring that support networks are still in place, particularly for trainees and more junior members of the team. ●



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# NAVIGATING THE NEW NORMAL

As restrictions ease, things won't necessarily be easy for all of us

**W**hile many of us are relieved that COVID-19 restrictions are lifting, moving back into more “normal” patterns comes with new stresses and anxieties. We asked Elizabeth Rimmer, CEO at LawCare, for some tips to help you make a smoother transition:

**Rebuild healthy barriers.** For the past 18 months or so, many of us have not been working from home; we have been living at work. Our four walls have become classrooms, social spaces and offices. You may not have the break you need between activities to provide a transition from work time to leisure time, or even understand the difference between the two. Give yourself a period between work and a leisure activity to get yourself into the proper mindset to get the most from both.

**Feed your focus.** Legal work requires focus, concentration and mental acuity, which is why self-care is crucial. For example: eat and drink appropriately; get back into a routine, including exercise and social or creative time; and take a lunch break, whether you're working from home or in an office.

**Don't give up on good habits.** Stick with any positive changes you may have made over the time when activities were more restricted. Value and maintain the new hobbies, regular walks, experimental cooking and the like. Continue to enjoy those things that make you feel energised.

**Amp up your empathy.** For some people, particularly those with a disability such as dyslexia or

dyspraxia, requirements to wear masks or the need to return to public transport can be sources of anxiety. In the meantime, the return of commuting to the daily routine can be difficult for those who are managing caring responsibilities and now have to add another element to their busy timetables. Be attuned to the way these changes might affect all of your colleagues and support them where you can.

**Say no - it's OK.** Avoid the tendency to say yes to too many things in the excitement to be able to do new things again. First, ask yourself: “Is taking on this new responsibility manageable?” And go at your own pace. When it comes to the new normal, one size does not fit all. If you're feeling concerned about resuming an old pattern, for example attending a social event, don't feel pressure to do so.

**Locate your support.** Your firm may have mental health champions and employee assistance resources, but you can also turn to charities such as Jonathan's Voice for advice. Fit for Law ([fitforlaw.org.uk](http://fitforlaw.org.uk)) is also a source of online learning about understanding emotions and stress. It offers bite-sized activities that are evidence-based and is backed by the Open University. LawCare's *Legal Mind* podcast is another place to find detailed resources around managing stress from a legal perspective. ●

*Elizabeth participated in an IP Inclusive stress management webinar in April in which she touched on these subjects. Access the recording via the IP Ability section at [ipinclusive.org.uk](http://ipinclusive.org.uk). Find out more and access help from LawCare at [lawcare.org.uk](http://lawcare.org.uk) or via its free helpline 0800 279 6888*





# Proof of use proves problematic

Jessica Guest explains why e-actions might have been beneficial



**On 18th May 2017**, Wolfgang Diesel (the Applicant) filed an EU trade mark application for the stylised mark DIESEL SPORT, BEAT YOUR LIMITS covering, *inter alia*, sports equipment and clothing. Diesel S.p.A. (the Opponent) filed an opposition based on likelihood of confusion with various earlier registrations for the word mark DIESEL under Article 8(1)(b) EUTMR.

During the course of the opposition proceedings, the Applicant submitted two requests for proof of use of the earlier marks relied on to oppose, both of which were found to be inadmissible. The EUIPO subsequently upheld the opposition in relation to goods in classes 21, 25 and 28. The Applicant appealed this decision.

The case was referred to the Grand Board of Appeal, which found there was a need to clarify practice on proof of use requests and invited the Executive Director of the EUIPO to comment. These comments offer useful guidance on acceptable proof of use requests, as well as the benefits of using “e-actions” via the EUIPO’s online User Area.

## FAILED REQUESTS

On 14th March 2018, the Applicant submitted observations in reply to the opposition, alongside a request for proof of use of the earlier marks relied upon. The request was found to be inadmissible, as it did not meet the “separate document” requirement under Article 10(1) EUTMDR. On 27th April 2018, the Applicant filed a second proof of use request, presented in a separate document, which the EUIPO also dismissed because it came after the expiry of the deadline to request proof of use.

The Applicant submitted the initial proof of use request in a single electronic document named “Request; Observations. pdf”. On appeal, it argued that the request was presented on a separate sheet of the document, making it compliant with Article 10(1) EUTMDR. The Grand Board of Appeal

rejected this argument, finding that the request had been merged into the Applicant's observations. In particular, it noted the continuous page numbering of the document – as did the Executive Director – and concluded that the proof of use request did not satisfy the separate document requirement.

In clarifying the requirements under Article 10(1) EUTMDR, the Executive Director highlighted that the need for a separate document does not mandate a separate electronic file attachment (or hard copy equivalent). Rather, the request for proof of use must be clearly presented on a standalone basis and not merged into the Applicant's observations. A request annexed to the Applicant's observations in the same electronic file, for example, can be considered a separate document provided it is clearly and correctly identified.

The comments of the Executive Director outline in more detail various acceptable formats for proof of use requests, along with signature requirements. Among these options, the Executive Director highlighted the benefits of the dedicated "Request proof of use" e-action. Although it is not compulsory to submit a proof of use request using this online function,

*“ Factual evidence can play an important role in the comparison of goods and services*

doing so will automatically guarantee compliance with the requirements of Article 10(1) EUTMDR. The Executive Director noted that this is likely to become the primary method for requesting proof of use in the very near future, particularly following the removal of fax as a means of communication with the EUIPO on 1st March 2021.

After finding that the first proof of use request did not satisfy the requirements of Article 10(1) EUTMDR, the Grand Board of Appeal went on to confirm that the Applicant's second request was belated and could not be taken into account. The Executive Director noted that, rather than submitting this second request outside of the relevant time limit, the Applicant would have been better advised to apply for a continuation of proceedings under Article

105(1), as continuation would generally be granted in these circumstances.

#### LIKELIHOOD OF CONFUSION

Having dismissed the Applicant's requests for proof of use, the Grand Board of Appeal next considered the opposition on its merits, including an interesting discussion of the similarity of the class 21 goods at issue.

Both the Opposition Division and the Grand Board of Appeal accepted that the Applicant's goods in this class had been wrongly translated from German (the language of the application) into English as "hip flasks" instead of "drinking bottles for sporting activities". As German is an official language of the EU, the original German text was found to be decisive. It was therefore "drinking bottles for sporting activities" that were to be compared against the Opponent's class 21 goods, namely, various household goods including "glassware".

The Applicant argued on appeal that these goods are dissimilar because drinking bottles for sporting activities are never made of glass for safety reasons. In reply, the Opponent provided examples gathered from an Amazon search of glass drinking bottles for sporting activities. The Grand Board of Appeal found these examples persuasive and upheld the previous finding of identity between the class 21 goods. This acts as a useful reminder that factual evidence can play an important role in the comparison of goods and services.

The Grand Board of Appeal also confirmed the contested decision's remaining findings on similarity and concluded that the Applicant's mark had been correctly refused on the grounds of Article 8(1)(b) EUTMR in respect of the goods under appeal in classes 21, 25 and 28.

This decision, and in particular the comments of the Executive Director, can act as a helpful reference point on the configuration of acceptable proof of use requests. It also offers a warning on the potential pitfalls involved in requesting proof of use, many of which can be avoided by using the dedicated e-action available to EUIPO online users.

#### KEY POINTS

✦ Using dedicated e-actions via the EUIPO User Area automatically guarantees compliance with formal requirements

✦ If a proof of use request is refused, the applicant should apply for a continuation of proceedings rather than submitting a corrected request outside of the relevant time limit

#### MARK

THE OPPOSED APPLICATION



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# Marked for defeat

This decision was as easy as ABC, says David Yeomans

**This judgment relates** to two figurative marks shown opposite. The Applicant, Cole Haan LLC, had applied for the Contested Mark at the EUIPO. That application was opposed by Samsøe & Samsøe Holding A/S, based, *inter alia*, on the Earlier Mark. The Opposition Division upheld the opposition on the basis of likelihood of confusion. The Fourth Board of Appeal (BoA) upheld that decision on appeal. It was that decision that the Applicant then appealed.

## AGREED FACTS

For the purposes of the appeal, the parties agreed that the BoA had been correct in determining that:

- (1) The goods at issue were identical or similar;
- (2) The Contested Mark is a representation of the letter Ø, which is part of the alphabet used in Danish, whereas the Earlier Mark is a representation of either the Greek letter φ or the letter Φ from the Cyrillic alphabet, used in, *inter alia*, Bulgarian; and
- (3) The relevant public was “the French-speaking public with no command of Danish, Bulgarian or Greek”.

The second and third points are each worthy of their own article. Each finding had a significant bearing on the outcome of this decision. However, being agreed, there was no real commentary from the Court on either.

The Applicant pursued its appeal, therefore, on what the Court described as “in essence, a single plea in law” – namely that there was no likelihood of confusion.

## VISUAL COMPARISON

In respect of the visual assessment of the marks, the Applicant argued that the BoA erred in finding that “the signs at issue both consist of a circle bisected by a straight vertical line”. The Court agreed that the BoA had erred (the Contested Mark’s line is not vertical), but found this “erroneous statement” had no bearing on the decision. The Court stated that, elsewhere in its decision, the BoA had referred to both the vertical and horizontal line, and

properly reproduced both marks, making clear that it had properly considered the visual differences.

The Applicant further argued that “the relevant public is accustomed to distinguishing letters with similarities”. The Court, upholding previous case law, held that “knowledge of a foreign language cannot, in general, be assumed”. In relation to the case at hand, the Court held that:

- (1) Even if that were the case, the point relates to letters or symbols in the language spoken by the relevant consumers; and
- (2) The letters Ø, Φ and φ are not used in French, which is spoken by the relevant public. Those letters therefore belong to foreign languages.

“ *It’s hard not to wonder whether the outcome was inevitable once the parties agreed on the relevant public* ”

As a result of these points, the Court held that the Applicant’s assertions were irrelevant for the purpose of assessing the perception of visual similarities between signs which, like the signs at issue, represent letters that do not exist in the relevant consumers’ language.

## PHONETIC COMPARISON

The BoA found that phonetic comparison was not possible because neither sign has meaning for the majority of the relevant public and therefore would not be verbalised.

The Applicant argued that: “Consumers, even without understanding those languages, know that, first, the mark applied for has a meaning in the ‘Scandinavian languages’, represents a letter in the Danish alphabet and means ‘island’ in that language and, secondly, the Earlier Mark represents a letter in the Greek and Bulgarian alphabets.”





(3) Even when the word is recognised as being foreign, it may not be pronounced in the same manner as in the original language; and

(4) In the assessment of the likelihood of confusion, it will still be necessary to establish that a majority of the relevant public has the ability to pronounce the word in question correctly.

#### CONCEPTUAL COMPARISON

The BoA found that a conceptual comparison was not possible. The Applicant contested this, arguing that:

(1) The relevant public will recognise the signs at issue as being two letters from different foreign languages; and

(2) The letter Ø, represented by the Contested Mark, has other meanings understood by consumers across the EU (such as the number zero).

The Court upheld the BoA's decision and reasoning in finding that for the majority of the French-speaking public, which does not understand Bulgarian, Danish or Greek, the earlier sign has no meaning, from which it concluded that no conceptual comparison of the signs at issue is possible.

#### GLOBAL ASSESSMENT

The Applicant accepted that the distinctive character of the Earlier Mark is low and that the visual aspect of the signs at issue in the overall impression created by them plays a greater role than their phonetic and conceptual aspects. However, it maintained that on a global assessment, no likelihood of confusion arose. Unsurprisingly, having failed in all the individual elements above, this argument also found no favour.

It's hard not to wonder whether the outcome of this decision was inevitable once the parties agreed that the relevant public for assessing the marks was "the French-speaking public with no command of Danish, Bulgarian or Greek". Where a figurative mark represents a letter of an alphabet, careful consideration needs to be given by a mark owner or applicant as to how that mark will be considered or understood by consumers who have no familiarity with the language to whose alphabet the mark belongs.

#### KEY POINTS

- ✦ Defining the relevant public can be crucially important if the application is for a mark that represents a letter in a particular alphabet
- ✦ Knowledge of a foreign language cannot be assumed
- ✦ If the relevant public does not speak the foreign language of the applied-for letter/alphabet, then a phonetic and conceptual comparison will not be possible

#### MARKS

CONTESTED MARK



EARLIER MARK



Rejecting the Applicant's arguments in this regard, the Court again relied on the fact that knowledge of foreign languages cannot be assumed and held, *inter alia*, that:

(1) It is difficult to establish with certainty how the average consumer will pronounce a word from a foreign language in their own language;

(2) It is far from certain that the word will be recognised as being foreign;



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# The secret of a success

Katherine Thompson reveals the reasons behind a failed invalidation attempt

**The General Court (GC)** has denied Victoria's Secret Stores Brand Management, Inc.'s attempt to invalidate a registration for BODYSECRETS (shown opposite). An invalidity action was brought under Articles 7(1)(b), (c) and (d) EUTMR. The GC upheld the decision of the Board of Appeal (BoA) and found the mark to be validly registered on all counts.

The mark was filed in 2015, covering classes 3, 5 and 25. The application was opposed under Article 8(1)(b), though not by Victoria's Secret. The opposition failed, and the mark proceeded to registration. In 2017, Victoria's Secret (the Applicant) applied to invalidate the mark, and that decision was appealed first to the BoA and then to the GC.

## FOUR PLEAS

The appeal relied on four separate pleas. In its first plea, the Applicant argued that the figurative elements of the Contested Mark are so minimal as to be negligible. The mark should have been considered as if it were a word mark, given the very limited degree of stylisation. This was given short shrift, and the GC found that the BoA had attached no importance to the figurative elements of the mark.

In its other three pleas, the Applicant argued that the BoA had made an incorrect assessment of the mark under Articles 7(1)(b), (c) and (d), and that in doing so it had made an incorrect assessment of the evidence submitted by the Applicant. That evidence consisted of eight magazine articles with headlines such as "12 Celebrity Body Secrets", "Marilyn Monroe beauty and body secrets revealed" and "Ferne McCann reveals beach body secrets". At first glance, it seems that

*“ The reliance on the dictionary definition perhaps fails to give enough weight to the importance of context in colouring the consumer's understanding ”*

this sort of evidence would be very helpful to the Applicant's case. Most brand owners would rather not see their mark being used in the headline of a press article, other than to refer to their own products. However, in this instance, the evidence was not found to demonstrate that the mark lacked distinctive character.

### COURT CRITICISM

There were two main aspects to the GC's criticism. Most importantly, it was found that none of the press articles related to the specific goods covered by the registration. While the articles discussed diet and exercise regimes and their impact upon the body, there was no reference found to specific products in classes 3, 5 or 25.

Second, the Applicant used the evidence to argue that the phrase "body secrets" would be understood as a "promotional formula" indicating that the goods are used to improve physical appearance. However, the GC found no use of the expression as a "promotional formula" in advertisements or similar contexts.

This potentially sets a high bar for what the evidence needs to show, if it indicates that actual third-party use of the phrase in advertisements is required to demonstrate that an expression would be understood as a promotional formula. It is a useful reminder of the differences between use in the course of trade, and other types of use of a phrase.

Aside from the evidence, the Applicant argued that the expression "body secrets" suggests that the goods in question are secret and exclusive in nature and therefore superior to the ordinary version of those goods. The Applicant argued that the expression indicates that the goods are used to improve physical appearance, and that these meanings of the words were relevant for the assessment under Articles 7(1)(b) and (c).

In response, the GC cited the dictionary definitions of "body" as "the complete physical form of a person or animal" and of "secrets" as something which is "kept from knowledge or observation". In its most literal interpretation, the expression "body secrets" therefore refers to parts of the body that are hidden or unknown. On this basis, the expression was found not to be perceived as a promotional formula, or as having laudatory connotations capable of commending the quality of the goods. The Applicant was found not to have shown that the relevant public would understand the expression as referring to hidden tips that can improve one's physical appearance.

### IMPORTANCE OF CONTEXT

This perhaps highlights the differences between the straightforward dictionary definition of a word and the connotations it can have when used in context. No one reading the article "12 Celebrity Body Secrets" genuinely expects to be uncovering information that has previously been "kept from knowledge or observation". In that context, the reader is much more likely to expect tips and tricks, or even just reformulations of common-sense advice. Although the dictionary meaning of "secret" has some relevance in implying that the information being imparted is not widely known, no reader is expecting the same sort of revelations that might follow a headline: "Secret government dossier leaked". The straightforward reliance on the dictionary definition perhaps fails to give enough weight to the importance of context in colouring the consumer's understanding of this element of the mark.

However, for all that the dictionary definition may lack nuance, the Applicant did find it difficult to demonstrate that there was a sufficiently direct connection between the meaning which it argued the consumer would understand the mark to have and the goods in question. The decision provides a useful reminder of the presumption that a mark has been validly registered, and of the thresholds for demonstrating that a mark is lacking in distinctive character.

For the sake of completeness, the Applicant did include a plea under Article 7(1)(d), but given the treatment of the evidence in the other parts of the decision it was very difficult to demonstrate that the expression "body secrets" had become commonplace in the trade to refer to the goods in question at the relevant date.

Having not previously opposed the application on the basis of its prior rights, it will be interesting to see whether Victoria's Secret now chooses to apply to invalidate on that basis. In the meantime, the decision confirms that simply because a mark can be shown to be used in a non-trade mark sense in certain contexts, this does not automatically mean that the mark lacks distinctiveness for the goods for which it is registered.

### KEY POINTS

- Victoria's Secret challenged on absolute grounds but not on prior rights
- Evidence of non-trade mark use is not necessarily evidence that the mark lacks distinctiveness

### MARK

THE CONTESTED MARK

BODYSECRETS



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# Second skirmish for football clubs

Adrian Dykes considers a trade mark rematch

## KEY POINTS

✦ This decision appears to push the boundaries of *Medion*. It affords a broad scope of protection to a simple four-letter acronym

✦ The conclusion seems to stray towards finding confusion solely based on a common element – that is, calling to mind rather than indirect confusion

✦ This decision highlights the importance of professional representation in opposition proceedings

## MARK

LEEDS' APPLICATION



**This opposition case** was brought by Leicester City Football Club (Leicester) against Leeds City Football Club Ltd's (Leeds) application to register the mark shown below in classes 16, 25, 26 and 41. Leicester's opposition relied on its 2018 registration for LCFC, registered in identical classes. The application itself was for a series mark covering colour and black-and-white versions, but nothing turns on that point.

For the uninitiated, Leicester plays in the Premier League. It famously won that League in the 2015/16 season, despite the bookies having written the club off with 5,000:1 odds on winning and considering it a prime candidate for relegation. Leeds does not play in the Premier League, and indeed should not be confused with Leeds United Football Club (which does) or The Leeds City Football Club, which plays in the Yorkshire Amateur League and uses a different crest (notably without the abbreviation LCFC).

Leeds was shown the red card in the earlier opposition decision O/755/18<sup>1</sup>, when a very similar series mark was refused in the same classes under s5(2)(b) of the Trade Marks Act 1994 on the basis of Leicester's LCFC registration. The Hearing Officer (HO) held that LCFC retained its independent distinctive character<sup>2</sup>, which was dominant in the crest. Therefore, the marks were held to be visually similar to a medium degree, aurally identical (or similar to medium to high degree, depending on which elements are pronounced in Leeds' mark), and conceptually similar to a medium to high degree.

Given the identity/similarity of the goods, there was a likelihood of confusion, particularly bearing in mind the principle of "wrong way round" confusion.<sup>3</sup> In this case, confusion was held to be inevitable if consumers were to encounter Leicester's

LCFC mark after seeing the Leeds mark on identical/similar goods.

## SECOND ATTEMPT

Leeds filed again, tweaking the mark slightly and narrowing the specification. After filing the counterstatement – and not being put off by the earlier decision – Leeds, which was unrepresented, then left the goal wide open, taking the unusual step of filing no evidence and no submissions – preferring, it seemed, to watch from the sidelines.

Predictably, Leicester sought to rely on the earlier decision. However, the HO made new findings on the similarity of the marks, cutting back on the earlier decision by holding the marks to be visually similar "to a fairly low degree", aurally identical, dissimilar, or similar to a fairly low degree (again, depending on what is pronounced), and conceptually similar to a medium degree. This could have enabled Leeds to rely on the interdependence principle (as the first HO had), including the finding that the marks were in no aspect less than similar to a medium degree.

Leicester had argued that LCFC enjoyed an enhanced level of distinctiveness, particularly off the back of its 2015/2016 Premier League win. However, the evidence did not support such a finding in relation to LCFC, but only in relation to the signs LEICESTER CITY and LEICESTER.

Therefore, with the goalposts moved in relation to the similarity of marks but all other factors being equal, the HO went on to apply the global appreciation test, which is better understood than the offside rule.

The HO did not consider the issue of "wrong way round" confusion. However, she dismissed any likelihood of direct confusion (mistaking the marks for each other), holding there to be "significant visual differences" between the marks, having regard to the principle in *Medion* and the identity and high degree of similarity between the goods/services.



“ Leeds left the goal wide open, taking the unusual step of filing no evidence and no submissions – preferring, it seemed, to watch from the sidelines

The HO then went on to consider indirect confusion (ie, the possibility of recognising that the marks are different, despite including a common element, and believing that the later mark is another brand related to the earlier mark). Despite the lower degree of similarity between the marks, the identical shared element was held to be enough to support a finding of indirect confusion, even if applying a high degree of attention. The coincidence of the letters LCFC was sufficient to lead consumers to believe that the marks are used by the same or economically linked undertakings, and the additional words in Leeds’ mark were not sufficient to obviate this.

Leeds’ mark is particularly complex, and the HO recognised that it would obviously be recognised as a football crest. This decision seems to be pushing the boundaries of *Medion*, affording a broad scope of protection to a simple four-letter acronym. The HO even acknowledged that consumers would clearly understand that the mark relates to a football club, or even a city’s football club, which should have

triggered the global appreciation test. The conclusion appears to stray towards finding confusion based solely on a common element; that is, a calling to mind rather than indirect confusion. Football clubs in Loughborough, London, Lincoln, Luton and Londonderry should take note.

Once again, this decision highlights the importance of professional representation in opposition proceedings. One wonders whether Leicester can expect a third application to oppose in the future and look forward to scoring a hat-trick of victories.

1 Reported in *CITMA Review*, March/April 2019, p.31.

2 [2004] C-120/04, *Medion AG v Thomson Multimedia Sales Germany & Austria GmbH*

3 [2014] EWHC 185 (Ch), *Comic Enterprises Ltd v Twentieth Century Fox Film Corporation*



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# Contending with a curve ball

Steven Jennings suggests considering a caveat



**This is an** appeal (with Lord Justice Arnold giving the judgment on behalf of the Court of Appeal) from a decision handed down on 10th September 2020, in which it was held that the marks AMERICAN EAGLE (the Sign) and EAGLE RARE (the Trade Marks) were similar on the basis of a likelihood of indirect confusion.<sup>1</sup> Here, the Appellants sought to overturn the finding of indirect confusion on appeal but failed. The decision has a number of potential implications for those involved in searching for, filing and prosecuting trade marks because of what it tells us about how to assess indirect confusion as a likely risk factor when conducting an availability search or filing an opposition.

## INITIAL CASE

The initial case had established that the relevant consumer would be the ordinary bourbon consumer and that (at paragraph 47) “there is a greater than usual degree of brand loyalty within the bourbon market and so, on average, the consumer has a somewhat higher degree of attentiveness than a consumer of certain other spirits”. Bear in mind also that the expert witnesses helped to establish that annual sales of bourbon in the UK amounted to 16.8 million bottles. It might therefore come as a surprise that a market share (at its most generous) of 0.1% of the total bourbon market or 1.1% of the premium market met the test in paragraph 34, that “it suffices that a significant part of the public concerned has knowledge”.

Further, the Claimants’ expert provided examples of brands that a consumer could

find confusingly similar but which have different owners and coexist on the US Register; for example, Heaven Hill and Heaven’s Door. As an expert, he must be aware these all coexist in use, even if he did not know that the USPTO maintains prior rights as an absolute bar to registration, so that if the marks really were confusingly similar, one would not expect such coexistence.

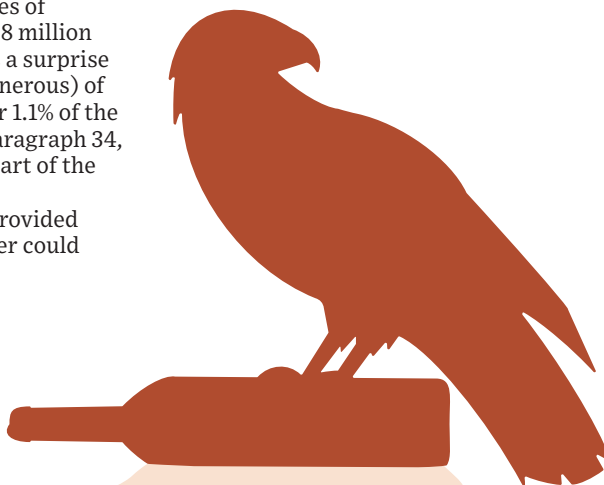
## THE APPEAL

The Court referred to the Appointed Person (AP) decision in LA Sugar Ltd v Back Beat Inc.<sup>2</sup> In that case, the owner of 26 RED SUGAR had opposed the Applicant for the device mark LA SUGAR. He outlined three scenarios in which indirect confusion could occur:

(1) Where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that only the brand owner would use it in a trade mark.

(2) Where the later mark simply adds a non-distinctive element to the earlier mark, of the kind that one would expect to find in

“ A finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion





## “ Practitioners may want to consider adding a caveat to their search reports noting any significant prior contact



a sub-brand or brand extension (terms such as “lite”, “express”, “worldwide”, “mini”, etc.).

(3) Where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension (FAT FACE to BRAT FACE, for example).

The Court then gave a further example of indirect confusion that leads consumers to believe that it is a co-branded product, referring to *Cheeky Italian Ltd v Sutaria*<sup>3</sup>, which determined that “a finding of a likelihood of indirect confusion is not a consolation prize for those who fail to establish a likelihood of direct confusion” and that “if there is no likelihood of direct confusion, ‘one needs a reasonably special set of circumstances for a finding of a likelihood of indirect confusion.’”

The Court reprised the judge’s findings that there was some visual and aural similarity between the Sign and Trade Marks, bearing in mind evidence that the Trade Marks were occasionally abbreviated to EAGLE (although given their minimal sales, this must have been negligible), which led to his conclusion that there was “a significant degree of similarity, but not overwhelming similarity” between the Sign and the Trade Marks.

### KEY FACTORS?

In paragraph 24 of the Appeal, the judge found that, given the inherently distinctive character of the Trade Marks – in that no other bourbon whiskey in the UK had a name that included the word “eagle” – the average consumer that saw or heard the Sign would be likely to call the Trade Marks to mind. He went on to say that there would be “a natural association in the mind of the consumer between a new brand using the word ‘eagle’ and Eagle Rare, given the coincidence of the product and the name, even if the average consumer would not instinctively consider them to be one and the same product”.

What’s more, he added: “In particular, once American Eagle 4 Year Old is established and becomes more widely known than Eagle Rare, having been positioned by the Defendants to compete with Jack Daniels and the like in the mass market, it will be natural for a consumer to assume that Eagle Rare is a special version of American Eagle.”

The role of possible brand extensions appears to have played a factor in the judge’s mind, even though the Appellants claimed that the Respondents, in their 20-year history, appear to have only produced the Eagle Rare 10 Year and Eagle Rare 17 Year, which come in the same traditional shape of bottle and with an additional label of authenticity.

### PRIOR CONDUCT

Finally, two instances of the prior conduct of the owner of the Appellants’ business, Mr Hainsworth, may have had some effect on the original judge, although this was not discussed in the Court of Appeal. The first involves an application to register VERA LYNN for spirits without permission, which was refused by the UK IPO. The second was that he could not deny knowledge of the Claimants given that he had a substantial minority shareholding in West Cork Distillers, with whom the Claimants had reached a settlement that “Skibbereen Eagle” would only be used in relation to Irish whiskey.

Just as practitioners were beginning to get comfortable with the concept of unfair advantage, this appears to throw a curve ball, indicating that potential assessments of similarity in prior rights searches may have become unfeasible. However, I do not believe that this case shows a general trend, but rather “a reasonably special set of circumstances”.

Practitioners may want to consider adding a caveat to their search reports, noting that if the client has had any significant prior contact with any of the parties included in the search report, then this should be advised to them in case it affects the likelihood of the proposed use being deemed an infringement.

1 [2020] EWHC 2424 (Ch), Sazerac Brands, LLC & Others v Liverpool Gin Distillery Ltd & Others

2 [2009] O/375/10, LA SUGAR (Opposition)

3 [2015] O/219/16, THE CHEEKY INDIAN (Opposition)

### KEY POINTS

- ✦ A special set of circumstances is needed for indirect confusion
- ✦ Clients’ prior conduct may affect the outcome of a case
- ✦ Ask whether your clients have had dealings with any parties revealed in a search report, as this may lead to you revising your assessment

### MARKS

IMAGES OF EAGLE RARE AND AMERICAN EAGLE PACKAGING



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# Hard times for Easy marks

Emilia Petrossian gives her view of the latest case involving a well-known family

**The Claimant, EasyGroup** Ltd, brought an infringement and passing off action against Easylife Ltd (formerly Easylife Group Ltd) and Mr Gregory Grant Caplan (together, the Defendants) based on use of the signs EASYLIFE GROUP, EASYCLEAN, EASY GREEN, and EASYCARE in relation to similar goods and services to those of the Claimant, which it contended therefore gave rise to a likelihood of confusion on the part of the public. These claims were denied by the Defendants, which counterclaimed with revocations against some of the Claimant's registered trade marks.

The case involved some 59,000 documents and saw multiple amendments to the particulars of claims in the run-up to the trial. A request that a number of claims be entered into the case a few months before trial was rejected on the basis that they were entirely new.

## THE CLAIMS

The Claimant claimed to have used a family of marks containing the prefix "Easy" for 27 years, including the distinctive get-up for easyJet

(opposite). The Claimant also owns a number of domain names, including easygroup.co.uk, many of which will likely be familiar to readers.

The Defendants claim to have used the sign EASYLIFE for around 21 years as part of a family of brands, including Easylife Group, Easyclean, Easycare, easylifegroup.com and easy-life-group.com. Being fearful of the Claimant's reputation as a serial litigator, the first Defendant changed its name from Easylife Group Ltd to Easylife Ltd and subsequently wound down use of its signs and domain names, maintaining only the sign EASYLIFE and the newly acquired domain name easylife.co.uk.

## REVOCATION

As reported, the Defendant countered with a revocation claim against a number of the Claimant's registered trade marks. It is the Claimant's evidential burden to prove that there has been real commercial use of its registered marks, which the Claimant failed to do in respect of some of the marks, specifically:

“ *The case involved some 59,000 documents and multiple amendments to the claims in the run-up to the trial* ”



(1) EASYLAND – proof of use consisted only of witness evidence and in relation to goods sold in the easyHotel, which were not dependent upon the retention of the EASYLAND mark.

(2) EASY4MEN – the Claimant admitted that the mark was not used in relation to some goods in class 3, did not provide sufficient evidence to prove genuine use in relation to the remainder, and was relying on goods developed 14 years ago.

(3) EASYGROUP – the class 35 specification was limited to “the bringing together, for the benefit of others, of a variety of goods, enabling customers to conveniently view and purchase those goods through a retail general merchandise shop” by agreement of both parties and confirmed by the Court.

(4) EASYJET – the Claimant provided genuine use for the mark EASYJET, apart from “tourist office services”, which resulted in the mark being partially revoked.

### INFRINGEMENT

As a result of the revocation/limitation of some of the Claimant’s registered marks, the Court considered the infringement action only in relation to the marks EASYJET in class 39 and EASYGROUP in class 35 (shown right). In assessing infringement under s10(2) of the Trade Marks Act 1994, the judge considered the recent decision in *W3 Ltd v easyGroup*<sup>1</sup>, where the Court held that the word “easy” was descriptive of services and not distinctive. This resulted in easyGroup’s “easy+” EU trade marks being invalidly registered in relation to “advertising” and “temporary accommodation”.

This provided a guideline for assessing marks in this case, and the Court held that although the easyJet and easyGroup marks were distinctive, and the family of marks may make confusion more likely, the common feature of the Defendants’ signs was the word “easy”, which is of a descriptive nature. The Court therefore concluded that the average consumer would not be confused. The first part of the mark was descriptive, the second part dissimilar to the Claimant’s family of marks, and the get-up distinctly different. Further, while the Claimant argued that there were incidences of actual confusion, these were insignificant.

In relation to the claim under s10(3), for the Claimant to succeed, it was required to demonstrate that the Defendants’ signs are identical or similar to the Claimant’s registered marks, that there is a reputation and that there is a link between the sign and the trade mark in the mind of the average consumer. The Court established that although the Claimant had a reputation for the mark EASYJET, the reputation for the mark EASYGROUP was weak.

Again relying on the assessment in the *W3* case, the Court ruled that the signs were not identical, that there was no link, that there was insufficient evidence to show detriment of reputation and no evidence that the Claimant’s reputation had been diminished in the mind of the average consumer. Further, there was no evidence of a change in the economic behaviour of the average consumer or serious likelihood of a change in the future, and no evidence was found of tarnishment or dilution of the reputation in the mark. Therefore, the infringement claim failed on both grounds.

### PASSING OFF

According to the decided case law, the Claimant must show the classic trinity of goodwill, misrepresentation and damage or the case will fall. There were no arguments about the Claimant’s well-known reputation. However, in relation to misrepresentation, the Claimant failed to show that there was:

(1) Proximity of the Defendants’ field of activity to that of the Claimant. The activities were held to be in different fields, and the public was therefore not likely to be confused; and

(2) A relevant economic connection. The question here was whether there is a degree of likelihood “that an online retail business which also sells via catalogue direct to customer homes using lower-case ‘easy’, a dissimilar sign and selling retail products is likely to deceive?” It was found that it was not.

The Court held that there was no real likelihood that use of the Defendants’ signs would damage the Claimant’s goodwill or divert trade from it. The passing off claim therefore failed.

### OPEN QUESTION

The case was dismissed, the Claimant’s EASYLAND and EASY4MEN marks revoked for non-use and the mark EASYJET partially revoked in relation to “tourist office services”. The Court did not deal with the concurrent use or own-name defence, so one can only wonder what the outcome of such an assessment would have been. Whether the change of name was in accordance with honest practices in commercial matters is open to question, given that the change happened after the Claimant contacted the Defendants about its rights.

1 [2018] EWHC 7 (Ch)

### KEY POINTS

- ✦ Relying on the descriptive element of your mark can be detrimental
- ✦ The risk of revocation should be considered before relying on registered trade marks in an infringement action, as this may affect your success in the proceedings
- ✦ Use of registered trade marks is key to success in protecting a brand and succeeding against third-party use
- ✦ In a passing off action, the claimant must also show that the defendant operates in the same field of activity as it does, or else there is no deceit

### MARKS

THE EASYJET  
GET-UP

The easyGroup  
marks

The Easylife mark



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# Defendant surely feeling its oats

Beverley Robinson shares her unique insights into a topical case

**The recent global** move towards more plant-based and sustainable diets has given rise to a substantial growth in the oat-drink market, resulting in a growing number of companies looking to take advantage of this expanding market. In this case, the Claimant failed to convince the judge that the Defendant's PureOaty oat-based drink infringed its trade mark rights relating to its well-known Oatly products.

The decision highlights the difficulties faced by trade mark owners when trying to enforce rights in a descriptive trade mark against competing companies and products. It is also a reminder that a claim under s10(3) of the Trade Marks Act 1994 (TMA) will rarely succeed where there is no likelihood of confusion under s10(2).

As a participant in CITMA's Marshalling Scheme, I was able to hear counsel's submissions and observe the cross-examination first hand, and I also had the chance to discuss the case one-on-one with the judge. Here's what I learned.

## MARKET LEADER

The Claimant is a market-leading Swedish company responsible for the popular Oatly drinks, with a net worth of more than \$10bn. The Defendant is a family-run independent farming business, producing gluten-free oats for third-party manufacturers in addition to its own

range of gluten-free products. Following the Defendant's launch of its rebranded PureOaty product last year (which was previously called "Oat Drink"), the Claimant issued court proceedings on the grounds that the Defendant's use of the name PureOaty and the front panel of its packaging amounted to an infringement of its various OATLY trade marks under s10(2) and s10(3) TMA and passing off.

## CONFUSION QUESTION

It was clear from the outset that the Claimant faced an uphill battle in arguing that the marks OATLY and PUREOATY are similar overall, given that the similarity lies in a commonality of a descriptive element. This became even more apparent during the cross-examination of the witnesses, during which the General Manager of the Claimant's business appeared to concede that there was no real risk of the brands being confused.

The judge was not persuaded by the Claimant's arguments that the average consumer would see the "pure" element



“ There was no evidence of any actual instances of confusion, despite there being ample opportunity for these to arise

of the Defendant’s trade mark as a mere descriptor and would focus entirely on the word “oaty”, but instead agreed with the Defendant that its mark would be perceived as a juxtaposition of two words, which are equally descriptive. The marks only coincided as a result of the common element “oat”, and the average consumer would see this element as having no significance in relation to the trade origin of the goods.

In reaching the decision that there was no likelihood of confusion, the judge noted the fact that there was no evidence of any actual instances of confusion, despite there being ample opportunity for these to arise. The Claimant argued that documents disclosed by the Defendant, which included information as to how third parties had accidentally referred to the PureOaty product as “Pure Oatly”, demonstrated a likelihood of confusion. However, the judge concluded that these merely pointed to confusion over the name of the Defendant’s product and not confusion as to the trade origin of the goods.

**STRONG GROUND**

The Claimant’s strongest ground for infringement was s10(3), its main argument being that by using a similar name the Defendant was seeking to unfairly benefit from its reputation.

Significant evidence was provided in support of the Claimant’s reputation and goodwill, which was not in dispute. The case therefore hinged on whether the Defendant unfairly benefited from the Claimant’s reputation, which came down to whether its product created a “link” with the Claimant’s product and whether the Defendant had purposefully set out to achieve this.

The judge had already concluded that there was only a very low level of similarity between the marks, yet accepted that use of the PUREOATY sign was likely to bring Oatly’s trade marks to the minds of many average consumers, even if only by virtue of it being an oat drink and the Claimant’s importance in that market. As such, the Defendant’s product created a link with the Claimant’s products.

**KEY POINTS**

- + It will be difficult to argue confusing similarity between marks where the sole similarity lies in the commonality of a descriptive element
- + While evidence of actual confusion is not necessary for finding a likelihood of confusion, the absence of such evidence can be telling in circumstances where there has been ample opportunity for any confusion between two brands to come to light
- + The concept of unfair advantage does not seek to prevent a business from learning from its competitors and adopting similar approaches

**MARKS**

OATLY PACKAGING



PUREOATY PACKAGING



A “link” between the marks is not sufficient in itself to constitute infringement, and the Defendant argued that such a link does not call to mind any value or reputation that is specifically and uniquely associated with the Oatly brand. A link between the marks can only arise as a result of both brands using the descriptive word “oat”, and the average consumer would be well aware that this has nothing to do with denoting a common trade origin but instead communicates what the products are.

The judge ultimately concluded that there is no unfair advantage to be gained simply by using elements of a mark that are descriptive. While the evidence submitted by the Claimant indicated that the Defendant was well aware of the Claimant’s products and may have taken note of the Claimant’s marketing strategy – and indeed taken inspiration from it – the concept of unfair advantage does not seek to prevent a business from learning from its competitors and adopting similar approaches.

Interestingly, counsel for the Claimant pointed out in its submissions that it was aware of only two cases that had failed under s10(2) but succeeded on s10(3) (*L’Oreal v Bellure*<sup>1</sup>, and *Specsavers*<sup>2</sup>), highlighting the difficulties of succeeding on s10(3) alone.

One particular matter of contention between the parties was the fact that Rebecca Rayner, who runs Glebe Farm Foods alongside her brother and who was believed to have played a significant role in the branding decisions of the Defendant’s product, was not called as a witness. Referring to the comments of the Court of Appeal in *Jaffray v Society of Lloyds*<sup>3</sup>, counsel for the Claimant invited the judge to draw adverse inferences on matters on which Rebecca Rayner could have provided evidence. While it was clear from the evidence

“ A large part of the success of the Oatly products is attributed to the products having adopted an informal and less corporate image commonly known as ‘wackaging’ ”

that Ms Rayner was heavily involved in the branding of the Defendant’s original “Oat Drink” product, the case as pleaded by the Claimant did not focus on the initial version of the product but rather on the rebranding of the product to “PureOaty”. The witnesses that did provide evidence on behalf of the Claimant played an active role in the rebranding of the product, and the judge found no reason to doubt the Claimant’s evidence or draw any adverse inferences.

#### WAS THERE IMITATION?

The Claimant also argued that the Defendant’s product imitated Oatly products by reproducing elements such as the colour, a “speckled texture”, the font, the language and an image of a coffee cup, amounting to passing off.

A large part of the success of the Oatly products is attributed to a repositioning and rebranding by the Claimant in 2014, which saw the products adopting an informal and less corporate image commonly known as “wackaging”. The Claimant sought to argue that a similar style of packaging had been adopted by the Defendant as a deliberate attempt to imitate the Claimant’s success. However, the evidence showed that this style of packaging is in no way distinctive to the Claimant and its products. Although the judge found that there were some similarities between the Defendant’s packaging and the Claimant’s, these were at a very high level and consisted of generic features not distinctive to the Claimant. The judge concluded that the overall impression of the two products is very different and there is no risk that consumers will confuse the products or be deceived into thinking that they are connected in any way.

1 [2009] C-487/07

2 [2013] C-252/12

3 [2002] EWCA Civ 1011



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# Calendar

Our upcoming events for members and other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
3rd-10th November	CITMA Seminar for Litigators	Online	4
4th November	CITMA Webinar Contentious proceedings at the UK IPO	Online	1
11th November	IP Inclusive: Not just for Movember	Online	1
16th November	CITMA Webinar EU case law update	Online	1
24th November	CITMA Webinar Disability History Month	Online	1
25th November	CITMA Paralegal Webinar* Renewals and maintenance	Online	1
30th November	CITMA Live Mediation Seminar	Online	2
9th December	Better decision-making (and how diversity can help)	Online	1
15th December	CITMA Webinar UK case law update	Online	1

■ CITMA event ■ IP Inclusive event

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# THE TRADE MARK 20

Q&A

JOHN  
LEWIS  
& PARTNERS

## Michelle Ward

strives for exceptional service

**I work as...** a Chartered Trade Mark Attorney, and I'm the founder of Indelible IP.

**Before joining the profession I was...** a scientist. Or least that was the plan. I have a degree in plant sciences.

**My current state of mind is...** happy and content. I enjoy what I do, have my family around me and live in a beautiful part of the country.

**I became interested in IP when...** I did what I thought was a temporary job until I could get my dream role in plant research. I worked as an admin assistant for a patent attorney and got drawn into the world of IP.

**I am most inspired by...** those who have shown determination and succeeded at what they set out to do, often against the odds.

**In my role, I most enjoy...** making a difference for the businesses I work with, and getting them out of difficult and stressful situations.

**In my role, I most dislike...** breaking the news that the new brand an entrepreneur has been dreaming of using needs changing due to a conflict.

**On my desk is...** a cup of decaf coffee. I love coffee, but I have to limit my caffeine intake!



“  
*Small and medium-sized businesses are more likely to try to do their own IP work*”

**My favourite mug...** has a picture of Piglet, a character who listens and is always there for his friend. Important attributes.

**My favourite place to visit on business was...** Seattle. I loved the mix of city, sea and mountains.

**If I were brand, I would be...** John Lewis. It's trusted for its reliability and customer service, key attributes that I strive for in business.

**The biggest challenge for IP is...** raising the profile of Chartered Trade Mark Attorneys among small businesses. Experience suggests that small and medium-sized businesses are more likely to use unregulated services or to try to do their own IP work.

**The talent I wish I had is...** speaking a foreign language. My brain just doesn't seem to be wired for it.

**I can't live without...** my Garmin watch, although I don't necessarily meet my daily step goals!

**My ideal day would include...** a walk in the mountains.

**In my pocket is...** no pockets today!

**The best piece of advice I've been given is...** be yourself.

**When I want to relax I...** go for a walk or read.

**In the next five years I hope to...** have successfully guided my teenage daughters as they make some important career choices. Unfortunately, neither of them has shown an interest in IP.

**The best thing about being a member of CITMA is...** the support and sense of community it provides, particularly since I set up my own business.

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