

# CITMA REVIEW

ISSUE 449 MAY 2019

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## GAME CHANGER?

*It may be  
time to take a  
new route to IP  
dispute resolution*

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Institute of Trade  
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# WELCOME & CONTENTS



**Tania Clark**  
CITMA President

“  
*I hope that you are pleasantly surprised with your firm's 2018 filing figures*

In this issue, I hope you'll go straight to page 6 for a report on our Spring Conference, which took place in London in March. The programme was preceded by an Intensive Design Seminar, and both events were very well attended, with nearly 120 enjoying the seminar and more than 240 delegates at the conference, including overseas attorneys from 28 countries.

I know that most of you, however, will flick right to page 17 for news of 2018's top trade mark filers, and I hope that you are pleasantly surprised with your firm's figures.

Elsewhere in this issue, we interview PIPCU head DCI Teresa Russell to find out what she has learned in her first year in post, and we also have international reports from New Zealand and Israel.

The next major event in our calendar is the INTA Conference in Boston, and no doubt I will meet some of you among the throng of more than 10,000 attendees. Safe travels to all.

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The CITMA party was joined in Boston by Sir Colin Birss

## CITMA TAKES TO THE ROAD

**CITMA President** Tania Clark and First Vice-President Richard Goddard, along with representatives from CIPA and the UK IPO, have participated in a series of US “roadshows” to help strengthen and develop relationships between the UK and US IP professions.

The roadshows, organised in conjunction with the American Intellectual Property Law Association, included stops in Washington, DC; Boston, Massachusetts; and Palo Alto, California.

Sir Colin Birss, Judge of the High Court of England and Wales, joined the

delegation to give keynote addresses in Washington, DC, and Boston.

On the three-event trip, the delegation was able to emphasise the strengths of the UK’s IP system and reassure our counterparts in the US that Brexit will not negatively affect the UK profession.

## UK IPO TO END INTERNATIONAL MARK FEE COLLECTION

The UK IPO will stop collecting and forwarding fees for international trade mark applications from May.

Some IP firms use their deposit account at the UK IPO to pay WIPO official fees for

international trade mark applications. The UK IPO then arranges to pay these fees to WIPO in Swiss francs. This is in accordance with rule 34(2)(b) of the Common Regulations under the Madrid Agreement,

whereby the UK IPO collects and forwards fees to the international bureau. The UK IPO will no longer be offering this service from 6th May 2019.

International trade mark applications based

on UK trade marks will still need to be filed with the UK IPO as the office of origin, and will still require payment of a £40 handling fee, but the international fees will have to be paid directly to WIPO in Swiss francs.

## SUMMER RECEPTION 2019

Summer is coming, and that means CITMA members will again be meeting at our Summer Reception, which is returning to The Refinery in London. Visit [citma.org.uk](http://citma.org.uk) for full details and we'll see you there!

# UK IS NAMED THE WORLD'S TM LEADER

The UK has the best environment in the world for trade marks, a report by the US Chamber of Commerce has revealed.

The *International IP Index 2019*, published in February, also revealed that the UK is the second best overall environment for IP in the world, behind the US. In addition, the UK was ranked second for IP enforcement.

Regarding the UK, the report noted, in particular:

- its strong and sophisticated national IP environment;
- that it is a model for inductive-style relief for rights holders when battling online infringement; and
- overall strong cross-sectoral enforcement, highlighted by the work of the UK's specialist crime unit and cross-industry and government cooperation.

The report noted the significant economic benefits from improving IP protection, including making economies 26 per cent more competitive and 39 per cent more likely to attract foreign investment.

### TOP 10 ENVIRONMENTS FOR TRADE MARKS

1. UK
2. US
3. South Korea
4. France
5. Germany
6. Ireland
7. Netherlands
8. Sweden
9. Switzerland
10. Japan

### TOP 10 OVERALL IP ENVIRONMENTS

1. US
2. UK
3. Sweden
4. France
5. Germany
6. Ireland
7. Netherlands
8. Japan
9. Switzerland
10. Singapore

Read the full findings from the report at [uschamber.com/ipindex](http://uschamber.com/ipindex)

## MEMBER MOVES



### Kate O'Rourke

Kate, a Past President of CITMA, has joined Mewburn Ellis as leader of its European trade mark practice. She will lead plans to develop the firm's client portfolio. Email her at [kate.orourke@mewburn.com](mailto:kate.orourke@mewburn.com)



### Rob White

Rob joined Groom Wilkes & Wright in March, having been in private practice since 2000. Contact Rob at [rwhite@gwwtrademarks.com](mailto:rwhite@gwwtrademarks.com)



### Terry Daly

Terry has joined the Legal & External Affairs team at British American Tobacco as a Trade Mark and Marketing Counsel.

### Considering a career move?

Visit the CITMA jobs board at [citma.org.uk/job\\_board](http://citma.org.uk/job_board)

# CITMA PARALEGAL TAKES HOME NATIONAL AWARD

**CITMA Paralegal** Rebecca McBride of Pinsent Masons LLP won the Best Trade Mark Paralegal award at the National Paralegal Awards in March. She beat fellow CITMA Paralegal Roy Scott and Peter Fisher from C P Law Associates.

The awards, organised by the Professional Paralegal Register, showcase and celebrate paralegal talent from across the UK. Rebecca is the first winner of a National Paralegal Award specifically for the trade mark legal sector.

Rebecca is the CITMA Paralegal representative on the CITMA Council and is active on a number of committees and working groups.



“

*I want us to get to a position where accreditation by IPReg is seen as a badge of honour*



# DELEGATES DELVE INTO DISRUPTION

This year's Spring Conference speakers attempted to bring forward solutions in somewhat turbulent times, as this summary of several presentations shows

## VISIONARY KEYNOTE TACKLES TRAINING AND ACCREDITATION

Keynote speaker and Chair of IPReg Lord Smith shared his vision for the future of the regulator and the IP professions – from education and CPD to adding value for the creative industries.

He told delegates: “IPReg wants to operate as a really efficient and modern regulator. I am determined that we continue to make progress. I want us to get to a position where accreditation by IPReg is seen as a badge of honour and respect for attorneys who wish to practise in this field.”

Lord Smith went on to state that his overall objective is that IPReg become a genuinely valued regulator. He set out some of the “immediate



The CITMA Spring Conference 2019 welcomed delegates to IET London: Savoy Place, an iconic location with views overlooking the Thames

tasks” that IPReg needs to undertake in the next two years in order to help achieve this goal. These include upgrading its computer systems and introducing a new CRM system. An office move is also in the pipeline to help save on costs.

Finally, Lord Smith hopes to oversee a review of rules and procedures, which, he acknowledged, are “not particularly adequate”. This review will be conducted in close cooperation with CITMA: “We want to ensure that your priorities are the ones we look at first.”

IPReg oversees qualification for Trade Mark and Patent Attorneys. On this subject, Lord Smith told delegates that IPReg will look at routes into the profession.

“We do need to rethink how we accredit and continue to oversee the

education provision for the training of Trade Mark Attorneys by places like Queen Mary University of London and Nottingham Law School.

“Regular monitoring of what is going on is something that we are going to want to put in place. It isn’t enough to do it once every five years.

“We also think that there must be scope for encouraging other providers to come into the picture. Relying on a very small number of providers is not necessarily going to be the best way going forward.”

Currently, qualified attorneys need to complete 16 hours of CPD each year to remain accredited. Lord Smith outlined his approach to reviewing the current standard.

“I don’t think that we have got the issue of CPD completely right. It is important from the point of view of consumers that we can rely

on attorneys keeping up-to-date in the knowledge, skills and experience that they have. At the moment, this tends to be something of a formulaic exercise.

“We don’t necessarily need a one-size-fits-all approach to CPD, so let’s have a discussion over the next year or two about how we might be able to do this a little bit better.”

Lord Smith also took the opportunity to discuss what he believes is the crucial role that IP plays in the well-being and future of the UK economy.

“In an advanced industrial economy, the source of our continuing and developing wealth has to be the ideas and the intellectual and scientific work that create new products, develop new services and bring new things into play.”

# Spring Conference 2019

## WHAT'S IN A NAME? IN PHARMA, PLENTY

The naming process in the pharmaceutical industry is full of challenges, but can bring incredible value. Christian Schalk from Bayer revealed the advantages and pitfalls.

“The pharmaceutical industry is special and highly regulated. Product owners must interact with both trade mark offices and health authorities – two parties with different interests and requirements.”

The trade mark offices' primary concern is the viability of the name, he said, while the health authority is looking out for customer safety. So, before it has even begun, the naming process in pharmaceuticals is subject to greater challenges than in many other industries.

Despite this, it's a key process, because there are considerable benefits to registering trade marks for pharmaceutical products, Christian explained. The main one is that, provided there's an accompanying patent, the owner has exclusive rights over the trade mark, which gives it enhanced protection. This doesn't apply to an international nonproprietary name (INN) – the name of the active ingredient of a product – which no one can own.

WHO encourages pharmaceutical companies to market products using only their company name and the INN, which would make it hard for customers to see the difference between products. Marketing with trade marks provides products with a clear identity and, therefore, an advantage over those companies that follow WHO's advice.

A trade mark can also represent all the information and experience customers have of a brand. This makes for instant quality recognition, simplifying customers' decision-making process when faced with lots of choice. Trade marks ensure greater longevity, too, as they stay alive after patents and copyright have expired.

But a good pharmaceutical trade mark can be very difficult to secure. Product owners not only have to contend with two regulatory authorities, but must also navigate linguistic complexities – and even



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*40 per cent of pharmaceutical trade marks are rejected by the authorities*”

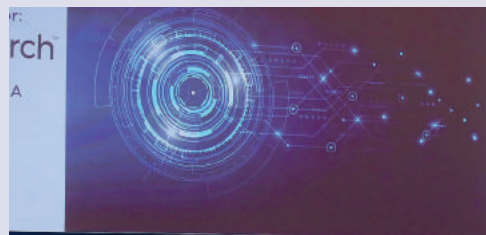
consider how the name will look when written by a doctor with messy handwriting. With that in mind, it's of little surprise that 40 per cent of pharmaceutical trade marks are rejected by the authorities.

Christian used the example of two medicines, Lamictal and Lamisil. One treats epilepsy, the other fungal infections. The chance of confusion is too risky and dangerous. Even in the digital era, there will always be times when prescriptions are handwritten.

Another concern is semantics across languages. If a trade mark

is not thoroughly vetted, a word completely inoffensive in one language could mean something offensive in another. Christian gave vivid examples, including Oviol, a German contraceptive. The name has no meaning in German, beyond being a trade mark. However, removing the first “o” leaves “viol”, which in French means “rape”.

Christian's lecture received warm applause. While it was clear that complications can frustrate the naming process of pharmaceutical products, it was clear to the audience how beneficial securing a trade mark registration can be.







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The tools we  
have at our  
disposal as  
lawyers are  
not always  
the most  
effective

## THINKING OUTSIDE (AND INSIDE) THE BOX

“What’s in the box?” asked barrister, mediator and magician Guy Hollingworth as he introduced the engaging subject of mediation in a trade mark context.

“Mediation is incredibly well suited to trade mark disputes,” Guy told the audience, following this statement with a magic trick to illustrate his point. Guy positioned two volunteers – CITMA President Tania Clark, and Sylvie Martin Acosta of IBM – either side of the lectern, on which sat a box emblazoned with a question mark.

“Disputes are often caused when people don’t tell the truth,” said Guy as he handed Tania and Sylvie an envelope each. Inside each envelope was an instruction to either lie or tell the truth about what was in the box. After being invited to have a look inside, Sylvie stated that the box contained four white circles. Tania confidently said five white cubes.

“We have a dispute,” Guy said. “So, whom do we believe?”

Despite being on home ground, our President didn’t gain the trust of the audience, who decided Sylvie was telling the truth.

In fact, “truth” was written on the card inside both envelopes.

“When we hear two contradictory versions of events, we assume that one person must be right, and one person must be wrong,” Guy explained.

But that wasn’t the end of the trick: inside the box was a mysterious item called the Ambiguous Cylinder, invented by a Japanese mathematician. When placed beside a mirror, the

cylinder looks like four white circles from one side, but five white cubes from the other.

“The tools we have at our disposal as lawyers are not always the most effective or the best,” said Guy, when the excited audience had settled, “certainly if you’re trying to find common ground or a solution to a problem.”

To resolve a problem or dispute, being able to see what’s on both sides at the same time is very helpful to everyone involved: nothing hidden, no tricks, no one right, no one wrong. This is where mediation comes into its own as an alternative to litigation.

A neutral mediator helps two parties find common ground without attempting to impose a solution. The process can lead people away from their adopted positions towards the interests and needs of both parties.

Despite what Guy calls the “adversarial tradition prevalent throughout Europe”, which favours litigation, mediation is gradually becoming more widely used – perhaps because it’s considerably cheaper than litigation, or maybe because it has an overall success rate of 89 per cent, with most disputes being settled on the day. It’s no wonder that mediation in trade mark disputes is being encouraged at both a national and international level. ●



Jean-François Vanden Eynde of event sponsor Corsearch addressed AI’s role in operational effectiveness. Left: Corsearch’s table proved popular. Right: delegates enjoy some informal networking



CITMA members can find presentations from the event at [citma.org.uk/events.html](http://citma.org.uk/events.html)

# SEMINAR FOCUSES ON ADDED VALUE OF DESIGN RIGHTS



Amy Salter recounts an intensive learning event

### CITMA's Intensive Design

Seminar, held in conjunction with the Spring Conference in March, brought together a host of notable speakers for an engaging afternoon exploring practical insights and strategic considerations for design rights protection. The theme of the afternoon was the added value that design rights can provide to ensure comprehensive IP protection, alongside trade marks and patents.

John Coldham of Gowling WLG chaired the seminar and provided an engaging opening, giving an overview of the afternoon's programme of speakers and statistical insight into the increasing investment in design filings in the UK.

### IN-HOUSE PERSPECTIVES

Lia Young, Senior Corporate Counsel for Caterpillar, and James Sweeting, Senior IP Counsel for Superdry, offered an insightful in-house perspective on designs and explained how their respective businesses seek to ensure robust IP protection by relying on a "patchwork" of IP rights. This highlighted the important – yet potentially underutilised – role of designs in providing coherent brand and product protection. Both speakers provided examples of successful enforcement strategies relying on design rights where trade mark and patent protection fell short.

Their business perspectives were followed by a well-received



discussion focusing on how businesses identify when to invest in registered design protection. Lia and James acknowledged that design rights can sometimes be devalued or overlooked, in favour of trade marks and patents, due to their lack of substantive examination, but emphasised the significant benefits that design rights can yield, particularly when a business is looking for a quick and commercial solution.

### HAGUE UPDATE

Grégoire Bisson of WIPO and Andrew Sadler of the UK IPO then provided a useful and detailed summary of the UK's accession to the Geneva Act of the Hague Agreement for Industrial Designs, and an update on the latest

developments in the WIPO Hague system for protecting design rights internationally. Detailing the unique benefits of the Hague system for UK applicants, particularly in respect of applications that designate examining jurisdictions, they explained the key specific requirements of national offices and how the risks of refusal on the grounds of insufficient disclosure, product indications and lack of novelty when filing multiple applications can be mitigated using the Hague system.

### BREXIT IMPACT

Tom Sharman of Reddie & Grose discussed the implications of Brexit in relation to designs, providing a



An in-house perspective was provided by counsel for Superdry and Caterpillar

## REFORM PROPOSED

To close the afternoon, Mr Justice Richard Arnold reviewed the effect of descriptions and representations on the scope of protection of registered designs, providing an overview of the legislative framework for design rights, its interpretation through case law and proposals for reform.

Arnold J questioned the purpose served by descriptions for registered designs and whether they should be abolished in light of the legislation's express provision that descriptions must be disregarded when assessing the scope of protection of a design. In addition, he highlighted that, while the extra-statutory guidance providing for the use of dotted lines to visually disclaim elements of a design has been endorsed by the General Court, there remains a distinct lack of guidance for visually claiming an absence of surface decoration as a feature of a design, or claiming protection for the shape of a product regardless of the presence or absence of surface decoration.

Arnold J put forward two proposals for reform:

1. amend the current legislation so that a description, if filed, would affect the scope of protection of the design; or
2. abolish descriptions, but provide a "tick box" on the application form to indicate the scope of protection claimed, providing for designs that consist of, include or are absent of surface decoration, or consist of the shape of an article regardless of surface decoration.

Arnold J's parting remark concluded that, in any event, the legislation should be amended to give effect to the Common Practice on visual disclaimers. ●

*CITMA members can access presentations from this event at [citma.org.uk/events.html](http://citma.org.uk/events.html)*

## “ The concluding observations made by Daniel Alexander QC reflected on the potentially increasing importance of registered designs and unregistered design rights in the litigation ‘armoury’ ”

comparison of the current design rights available in the UK and the anticipated state of play post-Brexit. Along with an overview of the practical implications of Brexit for existing design registrations, he gave an impressive whistle-stop tour of the potential impact of Brexit on pending proceedings at both the UK IPO and EUIPO, assignments, licences and pending litigation.

reflected on the potentially increasing importance of registered designs and unregistered design rights in the litigation “armoury”, highlighting the value of diversifying the rights relied on in litigious proceedings, with the cautionary warning that patents (the original right relied on in the case study) cannot be assumed to be inevitably more “potent” than design rights.

### LITIGATION LANDSCAPE

Daniel Alexander QC and Beth Collett of 8 New Square discussed the advantages and disadvantages of pursuing multi-right-based litigation, providing practical examples by way of a case study: *Cantel v Arc* (2018). Their concluding observations



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# PIPCU: THE YEAR FROM HERE

As she marks one year at the Police Intellectual Property Crime Unit, DCI Teresa Russell reveals what she's learned

**“OUR INDUSTRY AND PARTNER-AGENCY RELATIONSHIPS ARE A VITAL INGREDIENT IN TACKLING IP CRIME”**

Our working relationships with the UK IPO, the creative industries and brands continue to be essential in protecting against the threat, harm and risks posed by IP crime. Working with the IPO intelligence hub, we produced our first law enforcement strategic threat assessment in April, and this will shape the way we manage and mitigate those risks. It will allow us to take a more informed approach to identifying and addressing existing and emerging trends, as well as to identify our intelligence gaps. It's a huge piece of work, which will be an annual

## Interview

*“ One of the main challenges we have is that illicit streaming is seen to be socially acceptable. There is no stigma around it*

the majority of London schools and is putting processes in place to stop children from accessing illicit sites using school networks. We hope to spread this across the country.

One of the main challenges we have is that illicit streaming is seen to be socially acceptable. There is no stigma around it. Young people wouldn't necessarily understand or care about the knock-on effects that it has in relation to revenue and job losses – or the personal harm it can bring in relation to the insertion of malware or viruses into their devices. It is not unusual to have three or four generations in a single household viewing copyrighted content unlawfully (and possibly unknowingly). Getting the message into schools, and influencing and changing behaviour and mindsets at an early age, will be extremely beneficial in the long term.

**“THE AMOUNT OF DIGITAL DATA WE HAVE TO TRAWL THROUGH IS ENORMOUS, SO WE NEED EXPERT SUPPORT”**

We now have an investigator and two digital media investigators, who are funded by one of our partners.

A lot of evidence and intelligence-gathering comes from electronic devices, so having dedicated digital media investigators does expedite the work that we are doing. These three individuals are subject-matter experts and have positively enriched and developed our capabilities as a team.

**“WE'VE GOT TO HIT ORGANISED CRIME WHERE IT HURTS”**

One of the things I have also looked at over the past year is setting the direction of the unit towards tackling the criminals operating higher up the ladder. We've been using a suite of intelligence options to identify the upper-tier organised crime groups and those who are profiting the most from these illegal activities, and we've also been using our financial asset confiscation capabilities. We have a number of financial investigations running alongside the conventional ones. It's about hitting criminals in their pockets – taking their money and cars, taking their houses. Financial investigations take longer, but I'm hoping the rewards will be far greater and have a much more disruptive impact.

**“WE WILL CONTINUE TO REACH OUT TO INTERNATIONAL ORGANISATIONS, WHATEVER THE BREXIT PROCESS BRINGS”**

Law enforcement recognises the need to collaborate at an international level. Going forward, we will seek to work with our partners – it's just a matter of how we do that. There is universal acknowledgement that we need to work together to share intelligence – after all, criminals are not going to put up borders. We need to develop mechanisms that allow us to continue to work together.

**“WE NEED TO DEMONSTRATE THE TRUE IMPACT OF IP CRIME”**

We've had a lot of success regarding convictions. But, if you look at the ▶

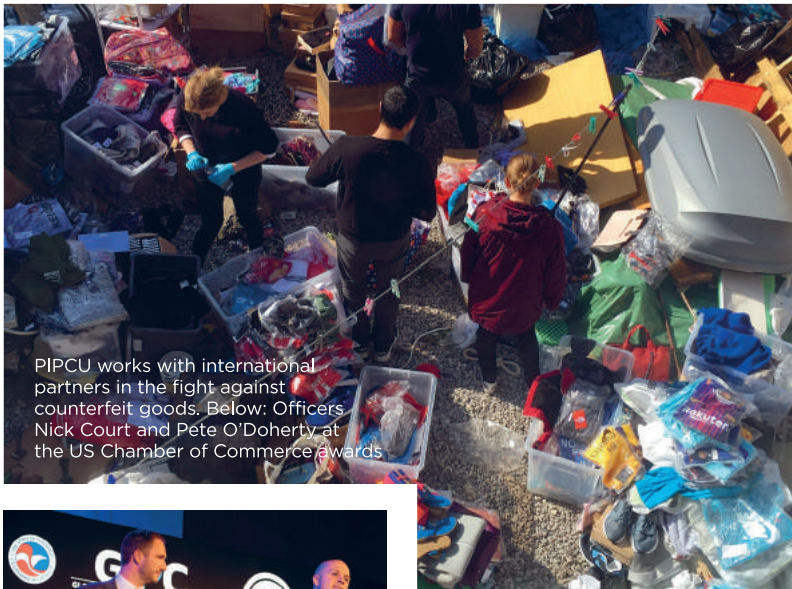
assessment moving forward and will be refined once the process of producing it becomes fully embedded into our “business as usual”. The document will also inform the government's enforcement strategy. This important piece of work could not have been completed without the assistance of our partners and other law enforcement agencies, which have fed information into the intelligence hub.

**“IT IS VITAL TO GET THE EDUCATION PIECE STARTED AT A VERY EARLY AGE”**

And we've made a really good breakthrough this year, working with the London Grid for Learning. It provides internet connectivity to



DCI Russell's small team of under 30 has won international recognition



PIPCU works with international partners in the fight against counterfeit goods. Below: Officers Nick Court and P ete O'Doherty at the US Chamber of Commerce awards



We continue to strive to protect brands and the creative industries.

**“I’VE LEARNED ABOUT THE SIZE AND SCALE OF COUNTERFEITING AND DIGITAL PIRACY”**

It took me about four or five months to get an understanding of what IP crime is all about, what the stakeholder needs and expectations are, and how to meet those requirements. So it’s been an interesting and exciting year for me. I’ve also come to understand the size and scale of counterfeiting and digital piracy, and their effects. We’ve hit the ground running this year, and I’m looking forward to a number of protracted investigations moving to executive action stage in the coming months, building on and adding to our successes to date.

*“ If you look at the treatment of IP crime compared with other crime types, sentences are less severe, so the ‘risk versus reward’ balance may appear attractive*

treatment of IP crime compared with other crime types (such as drug dealing), sentences are less severe, and therefore the “risk v reward” balance may appear attractive and the risk worth taking. This means it is important for law enforcement agencies not only to identify the existing threats of trade mark and copyright infringement (which we do), but also, where possible, to demonstrate the crossovers into other criminality and the associated threats and harm. By doing this, we will raise awareness of IP crime.

**“IT’S GREAT TO BE LIKED FOR A CHANGE”**

I think this is the first time I’ve been in a unit where industry loves us! But, at times, it can be a challenge to manage expectations. Equally, it is healthy to be questioned and held accountable for the work we do and how we perform.

We have a finite amount of resources and so we can’t prosecute our way out of every single crime, which is why we look at contemporary ideas around disruption and prevention. After all, prevention is better than cure.

**“HAVING AN ENTHUSIASTIC TEAM MAKES OUR JOB SO MUCH EASIER”**

I have never worked with such an enthusiastic, tenacious and dedicated team. I encourage my staff to come up with ideas and innovative ways to tackle IP crime. Some ideas have been phenomenal in terms of creating a tangible outcome, particularly around disruption. There’s a real buzz in the air when the team is in the office. There is a strong team work ethic in everything we do – whether executing warrants or dealing with the thousands of exhibits that we seize. We are like one big family, working together to get the job done and obtain the best possible outcome. It makes my job really easy, and I’m proud and feel privileged to be leading a team that is recognised internationally for its work.

For a very small unit – we have just under 30 people – to be recognised by the US Chamber of Commerce [with the Intellectual Property Champions Award for Excellence in Enforcement] is a huge accolade, and we are humbled to receive those acknowledgements.

**“PEOPLE IN THIS INDUSTRY ARE PASSIONATE”**

The golden thread I’ve seen running through the community of people who work in this industry is passion. They are passionate about protecting their brands and rights. When you’ve got that common passion, determining what we want to achieve is the easy bit, and the “how” follows suit. We all bring something to the table, and that’s why working with industry and other law enforcement agencies is vital to success.

One example is how the IPO engaged with the Crown Prosecution Service (CPS) around the UK regions in apprising them of IP crime and legislation. As a result of that work, we now have dedicated IP crime lawyers for each region, and that has proved to be very beneficial. We’ve had some great successes working with the CPS in London and nationally, and we continue to build on those successes and that knowledge. It is all very positive. ●

*DCI Teresa Russell spoke to Caitlin Mackesy Davies*

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IP

This is an exciting time for us - we're growing!

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# CHANGES OFFER ENHANCED POWERS

Lynell Tuffery Huria examines recent developments and planned changes affecting New Zealand's trade mark law

**With the ratification** of the Comprehensive and Progressive Agreement for Trans-Pacific Partnership last year came changes to IP legislation in New Zealand, including some minor amendments to its trade mark law. The changes took effect from 30th December 2018.

First among these was an increase in damage award powers for the Courts. In addition to awarding compensatory damages for trade mark infringement, New Zealand's Courts will now be able to grant additional punitive damages.

Further, in cases where counterfeit goods are found, the Courts must order the destruction of the goods unless special circumstances exist. Unsuccessful defendants will no longer be able to simply remove the trade mark from counterfeit products and continue to sell those goods.

Finally, the Customs Service has been given enhanced powers on two fronts:

- It can now temporarily detain counterfeit goods that are imported into and exported from New Zealand. Previously, it could only detain goods.
- It can now detain goods even if the rights holder does not have a Customs Notice in place, to give the rights holder the opportunity to put in place a Customs Notice.

## MĀORI TRADE MARKS

Under the Trade Marks Act 2002, all trade marks that incorporate a Māori word or Māori imagery are referred to the Trade Marks Māori Advisory Committee to determine whether the use or registration of the mark would be considered offensive to the indigenous people of New Zealand. If the mark is considered offensive, then it will not be registrable under s17(1)(c) of the Trade Marks Act.

Due to the uniqueness of Māori words and imagery, we have seen an increase in the number of Māori trade marks being applied for. With this increase, a change in members on the Advisory Committee and more settlements between Māori and the government (including the passing of *sui generis* legislation effectively granting IP-like protection to iconic Māori names and images), we have also seen an increase in objections to Māori trade marks on the basis of offence.

A recent decision by the Assistant Commissioner also confirmed that Māori trade marks must be considered in accordance with Te Ture mō Te Reo Māori 2016 (Māori Language Act 2016), which recognises Māori as an official language of New Zealand

and introduces many principles for the protection and development of the Māori language. It is important for any applicant to carefully consider the risk of an offensiveness objection before using and adopting a Māori word or image as its trade mark in New Zealand.

## COMING CHANGES

In 2019, the Regulatory Systems (Economic Development) Amendment Bill, which proposes amendments to several Acts, including New Zealand's Trade Marks Act, is expected to be passed into legislation.

The most relevant amendment is the reduction of the grace period for renewals of trade marks from 12 months to six. A transitional provision will maintain the current grace period for one year after the new Act comes into force.

The Intellectual Property Office of New Zealand is also considering introducing a legislative amendment later in 2019 recognising prior use as a basis for overcoming an objection based on a prior mark.



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# THE FILINGS TOP 1000

*We've dived into the 2018 data to find the UK's most active trade mark representatives*

**Once again, we** are pleased to bring you news of the top UK-based filers of UK and EU trade mark applications, with the help of Corsearch data. As always, we've highlighted the top 100 firms and individual practitioners filing within the calendar year.

We have reviewed the data and, where possible, combined entries that clearly relate to the same firm. Data of this nature is seldom flawless, so we cannot accept responsibility for errors or omissions, notably where an individual practising at a firm is listed individually. Nonetheless, we believe the tables give a broadly accurate representation of filings in 2018.

## DATA COLLECTION DETAILS

Data provided by Corsearch. Figures represent filers that are the current UK agents for UK or EU trade marks for which applications were made in the 2018 calendar year. Figures do not include WIPO-designated filings, corporate filers or representatives of single corporate entities. Where firms have acquired other firms during the year, the full representation of filings may not be captured. Where firms have multiple IPO accounts under different naming conventions, we cannot guarantee complete representation. Where entries are tied, entities are included in alphabetical order. Figures should not be relied on for official reporting, marketing, advertising or publicity purposes. ▶

TOP 100 UK TRADE MARK FILERS 2018

	Name	Filings			Filings
1	Trade Mark Wizards Ltd	805	53	Laytons LLP	159
2	Marks & Clerk LLP	758	=	Venner Shipley LLP	159
3	Trademark Eagle Ltd	621	55	ip21 Ltd	155
4	Murgitroyd & Company	603	56	Dolleymores	153
5	HGF Ltd	575	57	Haseltine Lake LLP	151
6	Wilson Gunn	546	=	Kempner & Partners LLP	151
7	Barker Brettell LLP	519	59	Carpmaels & Ransford LLP	150
8	D Young & Co LLP	515	60	Miller & Chuang	149
9	Stobbs IP	493	61	Simmons & Simmons LLP	142
10	Urquhart-Dykes & Lord LLP	483	62	Sheridans	141
11	Boult Wade Tennant LLP	449	63	Ashfords LLP	140
12	Appleyard Lees IP LLP	409	64	Abel & Imray	137
13	Bird & Bird LLP	391	65	Maucher Jenkins	134
14	Groom Wilkes & Wright LLP	364	66	Katarzyna Eliza Binder-Sony (LegalForce RAPC Worldwide)	133
15	Swindell & Pearson Ltd	328	=	Trade Mark Direct	133
16	Bayer & Norton Business Consultant Ltd	321	68	Wynne-Jones IP Ltd	132
17	Beck Greener	311	69	WP Thompson	119
=	Keltie LLP	311	70	Lawrie IP Ltd	118
19	Fieldfisher LLP	307	71	Bailey Walsh & Co LLP	116
20	Albright IP Ltd	292	72	Sipara Ltd	111
21	J A Kemp	283	73	RevoMark	108
22	Mathys & Squire LLP	275	=	Trademarkroom Ltd	108
23	Colman + Smart Ltd	272	75	Penningtons Manches LLP	104
=	Gill Jennings & Every LLP	272	=	Womble Bond Dickinson (UK) LLP	104
25	Novagraaf UK	271	77	Fox Williams LLP	100
26	CMS Cameron McKenna Nabarro Olswang LLP	267	78	Osborne Clarke LLP	99
27	Lewis Silkin LLP	266	79	Stephens Scown LLP	94
28	Withers & Rogers LLP	262	80	Chapman IP	93
29	Dehns	257	=	Harrison IP Ltd	93
30	Forresters IP LLP	250	=	Oakleigh IP Services Ltd	93
31	Baker McKenzie LLP	245	83	Handsome IP Ltd	91
32	Nucleus IP Ltd	230	84	Freeths LLP	90
33	CSY	229	85	Eversheds Sutherland (International) LLP	87
34	The Trade Marks Bureau	228	86	Bristows LLP	84
35	Cooley (UK) LLP	222	=	Hogan Lovells International LLP	84
36	Wildbore & Gibbons LLP	218	88	Brookes IP	81
37	Page White and Farrer	212	=	DLA Piper UK LLP	81
38	Axis IP Services Ltd	211	=	Marcaria.com LLC	81
39	Taylor Wessing LLP	204	91	Agile IP LLP	80
40	Lane IP Ltd	202	=	Baron Warren Redfern	80
=	Mishcon de Reya LLP	202	93	Bates Wells Braithwaite	79
42	Mewburn Ellis LLP	197	94	Bonamark Ltd	76
43	Reddie & Grose LLP	196	=	London IP Ltd	76
44	Elkington & Fife LLP	194	96	Birketts LLP	75
45	Kilburn & Strode LLP	190	97	Ansons	74
46	Stevens Hewlett & Perkins	188	=	Lincoln IP	74
47	Briffa	185	99	Chancery Trade Marks	71
48	TM4U Ltd	184	100	Ancient Hume Ltd	70
49	A A Thornton & Co	179	=	Brand Protect Ltd	70
50	FRKelly	176	=	Clarion Solicitors Ltd	70
51	Trademarkit LLP	170	=	TLT LLP	70
52	Potter Clarkson LLP	161	=	Wiggin LLP	70

TOP 100 EU TRADE MARK FILERS 2018

	Name	Filings		Name	Filings
1	HGF Ltd	439	=	Venner Shipley LLP	109
2	Lane IP Ltd	395	53	Wildbore & Gibbons LLP	106
3	Barker Brettell LLP	383	54	Briffa	99
4	Marks & Clerk LLP	381	55	Sipara Ltd	93
5	D Young & Co LLP	365	56	Stratagem IP Ltd	90
6	Boulton Wade Tennant LLP	343	57	Abel & Imray	85
7	Stobbs IP	326	=	Osborne Clarke LLP	85
8	Cooley (UK) LLP	316	59	WP Thompson	84
9	Fieldfisher LLP	288	60	Locke Lord LLP	80
10	Kilburn & Strode LLP	283	61	Edwin Coe LLP	79
11	Page White and Farrer	264	=	Finnegan Europe LLP	79
12	Katarzyna Eliza Binder-Sony (LegalForce RAPC Worldwide)	254	63	Dummett Copp LLP	78
13	Bird & Bird LLP	250	64	Stevens Hewlett & Perkins	77
14	CSY	241	=	Wynne-Jones IP Ltd	77
15	Baker McKenzie LLP	236	66	Axis IP Services Ltd	75
16	Gill Jennings & Every LLP	234	=	Carpmaels & Ransford LLP	75
17	Forresters IP LLP	226	68	Allen & Overy LLP	73
18	Keltie LLP	215	=	Dolleymores	73
19	CMS Cameron McKenna Nabarro Olswang LLP	213	70	Potter Clarkson LLP	72
20	Filemot Technology Law Ltd	211	71	Global IP Law Ltd	71
21	Urquhart-Dykes & Lord LLP	209	72	Norton Rose Fulbright LLP	69
22	The Trade Marks Bureau	206	=	Simmons & Simmons LLP	69
23	Murgitroyd & Company	204	74	Trade Mark Wizards Ltd	68
24	Withers & Rogers LLP	198	75	EIP	67
25	Mewburn Ellis LLP	195	76	Sandersons	64
26	Beck Greener	194	77	Squire Patton Boggs (UK) LLP	62
27	Trade Mark Direct	192	78	Nucleus IP Ltd	59
28	J A Kemp	173	79	Ashfords LLP	58
29	Mishcon de Reya LLP	172	80	Harrison IP Ltd	54
30	Taylor Wessing LLP	169	=	Laytons LLP	54
31	Jeffrey Parker & Company	168	=	Mohun Intellectual Property Ltd	54
32	Reddie & Grose LLP	167	83	Bailey Walsh & Co LLP	53
33	Wilson Gunn	160	84	Hansel Henson Ltd	52
34	Mathys & Squire LLP	158	85	Charles Russell Speechlys LLP	51
35	Groom Wilkes & Wright LLP	157	=	Oakleigh IP Services Ltd	51
36	Haseltine Lake LLP	150	=	Wiggin LLP	51
37	Kempner & Partners LLP	146	88	Fox Williams LLP	50
38	Dehns	142	89	Pinsent Masons LLP	49
39	Appleyard Lees IP LLP	141	90	Womble Bond Dickinson (UK) LLP	48
40	Maucher Jenkins	139	91	Baron Warren Redfern	47
41	RevoMark	131	=	DLA Piper UK LLP	47
42	Colman + Smart Ltd	127	93	Irwin Mitchell LLP	46
=	Lewis Silkin LLP	127	94	Orveda Ltd	45
44	Swindell & Pearson Ltd	124	=	Rapisardi Intellectual Property Ltd	45
45	Trademark Eagle Ltd	118	96	Clarke Willmott	43
46	A A Thornton & Co	117	97	Bear & Wolf IP LLP	42
47	Ladas & Parry LLP	116	=	Eversheds Sutherland (International) LLP	42
48	Bristows LLP	115	99	Bryers LLP	41
=	Sheridans	115	100	Foot Anstey LLP	39
50	Albright IP Ltd	114			
51	Novagraaf UK	109			

With thanks to Chris McLeod, Chartered Trade Mark Attorney and Partner at Elkington & Fife, and a member of the *CITMA Review* working group, who reviewed the Corsearch data.

# TIME TO CHANGE THE GAME?

Jeremy Blum examines the circumstances in which an alternative to litigation might prove alluring



While this publication regularly reports on IP dispute resolutions as determined by the CJEU, the UK IPO and the Courts of England and Wales, one avenue for resolving conflicts is much more rarely discussed. That is arbitration.

An arbitration arises as a result of the parties making an agreement that, in the event of a conflict, the parties submit to arbitrate the dispute. While such an agreement may occur after a dispute arises, it is more likely to happen because a contract that includes an arbitration clause had already been put in place between the parties.

But why would a party agree to enter into a contract with an arbitration clause instead of opting for the more obvious dispute resolution routes offered by the various court systems mentioned above?

## BESPOKE OPTION

Primarily, the perceived benefit is the ability for the parties to tailor the nature of the proceedings to suit the particular dispute in issue. For instance, the parties may agree to:

- **The seat:** The arbitration can take place in any location, including, for instance, a neutral location where neither party is domiciled, thus removing the notion of a “home court” advantage.
- **The law:** The parties may agree that a dispute is to be governed by a single legal system. This negates the risk of conflicting decisions in multiple courts when a dispute is multi-jurisdictional in nature.
- **The procedure:** The parties can agree which procedural rules will govern the proceedings (which may or may not mirror the governing law). This may have a significant bearing on, for instance, the disclosure obligations of those parties, the use of cross-examination and whether written or oral submissions are used.
- **The tribunal:** The parties can usually choose the arbitral tribunal (either an individual or a panel). This eliminates some of the perceived risk of having a non-technical judge

or a judge with no specialism in the legal subject matter of the dispute.

Other alluring benefits are speed, confidentiality and finality. A key driver for arbitration is the ability to designate proceedings (including the result) as entirely confidential, such that they are entirely transparent to third parties (including other potential competitors/customers). And, unlike traditional court proceedings, appeals in arbitrations are much less frequent, and, accordingly, an arbitration may provide more finality to a dispute (especially when coupled with a single governing law). It is possible for the parties to agree to an expedited procedure, thus resolving the dispute more rapidly than would a conventional court action.

“  
*A key driver for arbitration is the ability to designate proceedings as entirely confidential*”



A final factor that may be perceived as a significant benefit is the enforceability of an award. While an arbitral award is not automatically enforced, the New York Convention means that most countries recognise such an award and will act to enforce it. This may be of particular relevance in a multi-jurisdictional dispute, because an award can be enforced wherever it is deemed to be most effective (for instance, in a jurisdiction

in which the losing party has sufficient assets).

#### **REASONS TO BE CAREFUL**

Of course, many of these “tailoring” options are double-edged. For instance, if a party were to succeed in a breach-of-contract claim, it may have an interest in such proceedings being made public as a show of strength. However, if that same company were to lose such proceedings, it may not want

the weakness in a (possible boilerplate) contract to be exposed to third parties.

Further, while one party may wish to speed up proceedings, the other may wish to slow proceedings down and, therefore, such benefit may be rendered moot. Accordingly, it is worth noting the converse position and considering the downsides of arbitration to parties.

For example, the lack of sanctions available to an

arbitral tribunal can result in parties being less strict with deadlines, resulting in delays. It is also possible for parties to play tactical games, and this ultimately results in an increase in costs.

There is also a perception that, due to the lack of an appeal option (except in very extreme circumstances), the arbitral tribunal may lean towards finding a compromise between the parties, as opposed to the clear, reasoned decision that would be provided in a traditional court hearing.

Each of these “downsides” is itself double-edged and will depend on each party’s situation, but all are worthy of consideration by those thinking about entering into a contract with an arbitration clause.

#### ARBITRATION AND IP

It must also be said that arbitration cannot be used for all IP disputes. This is primarily because of two issues. First, as noted above, an agreement to arbitrate (usually in contractual form) is required. A party cannot, for example, commence an arbitration as a result of an alleged trade mark infringement. Unless there has been a contractual agreement to arbitrate disputes surrounding the trade mark, the appropriate forum would be the courts.

The second roadblock relates to sovereignty. An arbitration will allow underlying IP rights to be considered in a single hearing, thus negating the risk of inconsistency, and will potentially result in much-reduced costs. However, a one-stop-shop arbitration approach does raise a potential public policy issue when considering IP disputes, due to the inherent “deal” struck between individual states and the rights holder (eg disclosure of an invention in exchange for a monopoly), and this is dealt with in different ways across the New York Convention countries.

“

## *Confidential information cases, IP licence/royalty disputes and ownership are the most commonly arbitrated IP matters*

By way of example:

- Some countries do not allow the validity of an IP right to be assessed in an arbitration and will only consider the infringement aspects.
- Some will only allow the finding on the validity of the IP right to be effective on an *inter partes* basis, such that the status of the right on third parties is unaffected.
- Other countries will allow the arbitral tribunal to determine the validity of the right such that the right may be revoked on the basis of its decision.

The second of these options may be perceived as a significant benefit to the rights holder, because it means that, whatever the outcome of this particular dispute, the IP right remains intact for the purposes of third parties.

So the ability to arbitrate IP rights will depend on the governing law and potential locations in which an award may be enforced. These are both things to be considered before entering into a contract with an arbitration clause.

#### KEEP IT CONFIDENTIAL

In practice, IP rights that are arbitrated are those defined by contract. In our experience, confidential information cases, IP licence/royalty disputes and ownership are the most commonly arbitrated IP matters. Confidential information shared between parties is usually protected by a contractual agreement defining what is and is not confidential and how the information can be used.

An arbitration will determine whether the confidential

information has been misused, but, to make that determination, the question is whether the contract has been breached. Similarly, an IP royalty dispute will have a governing contract setting out the terms of the royalty arrangement, and the arbitration will determine whether a party has breached that arrangement. The benefit of arbitration in these cases is that the confidential information and the terms of the royalty payment are strictly confidential; the public would not be aware that an arbitration had taken place, let alone be privy to the details of the dispute, as would be the case in court proceedings.

In “traditional” dispute resolution proceedings, a rights holder (who, in practice, often holds a bundle of national rights) would have to bring parallel proceedings against the same party, based on the same underlying bundle of rights in order to resolve a single IP dispute. As set out above, this runs a serious risk of inconsistency in the outcome in each jurisdiction, and can result in duplication of procedural elements of proceedings, along with an increase in the associated cost of doing so (eg discovery in the US and disclosure in the UK, and the need to adduce expert evidence in multiple jurisdictions).

So, while not necessarily the most common route to resolve IP disputes, arbitration offers an array of options that might allow parties to streamline disputes and, ultimately, reduce the ever-increasing costs of litigation. Surely that makes it worth a look? ●



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## Israel

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# HABITAT v HABITAT: STORING UP TROUBLE

The Israeli Courts failed to consider the consumer, argues Eran Soroker

**To set the scene:** both sides sell furniture and household items; one is a local chain store and the other is an international trade mark owner. Both want to use and register the trade mark HABITAT in Israel. Who is to prevail? Sadly, a recent Israeli Supreme Court decision failed to decide conclusively.

This tale begins back in the 1970s, when an Israeli businessman, Mr Meirovitch, was operating a furniture store under the name Habitat. In 1976, Mr Meirovitch filed a motion to cancel HABITAT trade marks registered under Habitat Design International (Habitat International) on the basis of non-use. At the time, Habitat International informed the Israeli Trademark Registrar that it would not respond to the cancellation

motion, and the Registrar subsequently cancelled the trade marks. In 1979, Mr Meirovitch registered several HABITAT trade marks under his name.

Nearly 40 years later, in 2015, news spread that Habitat International planned to enter the Israeli market and to use HABITAT. Mr Meirovitch filed a lawsuit with the Tel Aviv District Court to prevent Habitat International from infringing his trade marks and from operating under HABITAT in Israel. Habitat International filed a counter lawsuit

seeking to prevent Mr Meirovitch from using HABITAT.

Whose rights will prevail?

### GOOD FAITH FOCUS

On 13th November 2017, the Tel Aviv District Court handed down a judgment in the claim and counterclaim. The Court focused on the good faith doctrine and applied it to both parties. It examined Mr Meirovitch's good faith at the time he filed the trade mark applications to determine whether he was aware of Habitat International. The Court





found that Mr Meirovitch had acted in bad faith. He was aware of Habitat International and acted to ride on its goodwill. This finding was based on the following facts: Mr Meirovitch chose an English name for his trade mark, rather than a Hebrew one; he did not provide evidence to support his claim that the Habitat brand was conceived in cooperation with an Israeli advertising agency; and his testimony suffered from what seemed to be a case of selective memory.

At the same time, the Court examined Habitat International's good faith. It found that Habitat International had acted in bad faith, because it did not enforce its rights in Israel for 40 years while Mr Meirovitch operated to create goodwill for HABILITAT in Israel.

It seems both parties acted in bad faith. So who may register or use the mark?

The Court ordered cancellation of the HABILITAT trade marks that were registered by Mr Meirovitch.

It also concluded that, in the event that the parties did not reach a settlement within 90 days, Habitat International would be permitted to use the trade mark HABILITAT INTERNATIONAL in both English and Hebrew in its advertising, and to use HABILITAT on its products. At the same time, Mr Meirovitch would be permitted to continue using HABILITAT.

#### **SUPREME COURT APPEAL**

On 17th December 2018, the Israeli Supreme Court handed down a judgment in an appeal filed by Mr Meirovitch. The Supreme Court rejected the appeal and affirmed the findings and result of the Tel Aviv District Court. Both parties acted in bad faith. Both parties were permitted to use the mark HABILITAT in parallel: Habitat International was permitted to use HABILITAT INTERNATIONAL in its marketing activities and HABILITAT on its goods, while Mr Meirovitch was permitted

**“ While the Courts were busy analysing the bad faith of the parties, they neglected the public interest**

to continue using HABILITAT (in English or Hebrew). No exclusive rights were granted to either of the parties. The issue of registration was not further addressed or decided.

#### **INCORRECT EMPHASIS**

The outcome of the ruling of both Courts is problematic. Both Courts' main focus and emphasis were on the bad faith of the parties. Less emphasis was given to consumer confusion and the notion that trade mark ownership should provide for the exclusive right to use and register the mark.

Two separate issues are involved – the use of HABILITAT and the registration thereof. The Courts failed to distinguish between these issues, ruled in error regarding the use and did not decide on the registration.

The result is confusion: two competitors with different brand values may use HABILITAT in Israel in the same field: furniture. The outcome balances the rights of the parties but ignores the public. While the Courts were busy analysing the bad faith of the parties, they neglected the public interest of preventing likelihood of confusion in the use of the same trade mark for the same goods.

In this regard, the goodwill that Mr Meirovitch acquired is significant. The Courts should have considered that Mr Meirovitch has sold high-end furniture for more than 40 years and

has become a commercial success story. Consequently, Habitat's stores in Israel have gained vast recognition and goodwill, and consumers identify Habitat with Mr Meirovitch. It is likely that a competitive furniture store operating under the same name will confuse consumers.

#### **BETTER SOLUTION**

The Courts failed to decide on the issue of registration, having simply cancelled Mr Meirovitch's 1970s trade marks. And the battle between the parties seems to continue on the registration front. In a search of the Israeli Trademark Registrar's database, we found that both parties recently filed separate applications to register Habitat-related trade marks.

The Courts could have reached a better solution, by which one of the parties would have been granted the exclusive right to use and register HABILITAT. For example, the Courts could have compensated the party that will lose rights in the HABILITAT trade mark. One possibility is a “Buy Me Buy You” mechanism, through which one of the parties could have bought the possibility to act in Israel as Habitat. Another option is that one party pay the other compensation or royalties for the sole use of HABILITAT in Israel.

Ultimately, the Courts should have decided between the parties and determined which should prevail. ●



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# No profit, no excuse

Emily Gittins explains why a not-for-profit entity was found to infringe

**This was a** decision following the first IPEC trial to be heard outside London, by HHJ Melissa Clarke. The Claimants, providers of mental health training courses, successfully sued the Defendant for trade mark infringement in relation to its provision of mental health care services and associated training within several NHS trusts.

## THE MARKS

The Claimants were the registered proprietor and exclusive licensee of UK and EU registered trade marks for the word RAID. The UK mark was registered in respect of class 41 for educational and training services, while the EU mark was registered in class 41 for teaching publications and class 16 for educational training services relating to psychology and mental health. The marks were used by the Claimants as an acronym for “Reinforce Appropriate, Implode Destructive” within their training to reinforce positive behavioural support.

The Claimants sued the Defendant, an NHS foundation trust, for trade mark infringement under sections 10(1) and 10(2) of the Trade Marks Act 1994 (TMA) and Articles 9(2)(a) and 9(2)(b) of Regulation (EU) 2017/1001 (EUTMR). The alleged infringement was the provision of a mental health assessment and discharge service and associated training, under the sign RAID, in both word form and via a stylised mark that was itself an acronym for “Rapid Assessment Interface and Discharge”. The Defendant described the service it referred to as providing a new model for patient assessment and discharge for individuals attending hospital due to severe mental health crises and trauma.

## SIMILARITY

The Defendant’s word mark was found to be aurally and visually identical to the registered trade marks, and there was no conceptual difference between them. The use of the Defendant’s word mark was also found to be identical to that of the registered trade marks.



*“ It was established by evidence that the Defendant’s services had provided a financial benefit*

The Defendant’s stylised mark (shown on page 27) was not identical to the registered RAID mark. The addition of “rays” obscured the shape of the letter D, which was found to be noticeable to the average consumer. Although the rays were considered to be more distinctive than the RAID element of the mark in colour and monochrome versions, the mark was found to be highly similar to the registered trade marks.

## ESTABLISHING USE

The Defendant submitted that use of its sign in relation to training and education services had been internal. HHJ Clarke referred to the case of Google France, where internal use of a trade mark was not considered to be use for the purposes of assessing use in the course of trade. In any event, the services provided by the Defendant could not be considered internal for the following reasons:

- training had been provided by the Defendant to individuals across five hospitals and two NHS trusts;



- a roll-out of the Defendant’s service across the country permitted membership to individuals from within and outside the NHS; and
- the Defendant’s marks were placed on doors within hospitals and were visible to those who worked within the hospitals and permitted visitors.

The Defendant also submitted that it was not using its sign “in the course of trade” because there was no commercial activity. HHJ Clarke noted that genuine use included “use of the mark on the market ... not just internal use by the undertaking concerned”<sup>1</sup> and, following principles previously established in case law, use in the course of trade would be satisfied where a sign had been “used in the context of a commercial activity with a view to economic advantage; and not as a private matter”.<sup>2</sup> Evidence adduced demonstrated that the NHS commissioned services from a range of providers, both public and private, and that these entities received funding for the goods and services they provided. As a result, the Defendant was in competition with alternative providers in the marketplace. It was not relevant that the Defendant’s primary aim was not to make a profit.<sup>3</sup>

Therefore, the fact that the Defendant had obtained payment as a result of entering into

a service-level agreement with two NHS trusts was found to be sufficient to establish commercial activity for economic advantage. It was also established by evidence that the services of the Defendant had provided a financial benefit to the trusts and their hospitals in return.

Training provided by the Defendant was found to be an integral part of the services provided, while the sharing of best practice with individuals including the Defendant’s staff improved its services. As a result, both activities were also considered to be commercial activity for economic advantage.

#### OTHER ISSUES

The Defendant’s training services, teaching materials and roll-out of training to other locations in the UK were identical to the Claimants’ services, and the Defendant’s word mark was found to infringe s10(1) TMA and Article 9(2)(a) EUTMR in respect of these services.

HHJ Clarke went on to consider infringement under s10(2) TMA and Article 9(2)(b) EUTMR with regard to the Defendant’s stylised mark for all of its services (likelihood of confusion), and the Defendant’s word mark in relation to mental health care service provision.

In finding that there was a likelihood of confusion, the judge considered that the Claimants had provided services to numerous NHS trusts, and that the average consumer would likely be aware that the NHS uses private training providers like the Claimants. As a result, it was found that an average consumer could believe that there was a relationship between the Claimants and the Defendant. In addition, despite the average consumer displaying a high level of attention to detail, the marks had few differentiating factors for the average consumer to notice.

#### LEARNING

This case provides some helpful guidance regarding use of trade marks by non-profit entities, and the circumstances under which they may be considered to act in the context of commercial activity with a view to economic advantage. This case also serves as a reminder that internal use can be difficult to establish in circumstances where services and materials are provided to different entities.



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#### KEY POINTS

- This was the first IPEC trial to be heard outside London
- Services provided by a non-profit entity may still amount to use in the course of trade
- A mark may have enhanced distinctiveness even in circumstances where it is not considered distinctive and there is minimal evidence of confusion

THE DEFENDANT’S SIGN (STYLISTED)



1. Verein Radetzky-Orden v Bundesvereinigung Kameradschaft “Feldmarschall Radetzky”, C-442/07, [2008] ECR I-09223
2. Arsenal Football Club plc v Matthew Reed, C-206/01, [2003] CH 454
3. *Supra*, note 1

# No figure of fun

Rebecca Davey runs through the reasons why use of a mark on children's playthings was no laughing matter



**The Claimant in** this recent IPEC decision, Luen Fat Metal and Plastic Manufactory Ltd (LFMPM), is the proprietor of a UK trade mark registration for the series of marks FUNTIME, FUN TIME and FUN-TIME (the UK Mark), covering “games, toys and playthings; electronic games”, as well as an EU trade mark (EUTM) registered with an acquired distinctiveness claim, but with a note that “the trade mark was inherently distinctive” nonetheless. LFMPM alleged that the use of FUN TIME TOYS on toy products by Trespass (the Defendant), as shown on page 29, constituted infringement.

## THE IPEC DECISION

The Court initially assessed whether the Claimant's UK Mark was inherently distinctive and, if not, whether it had acquired distinctiveness. It was held that, although the UK Mark had a low degree of inherent distinctiveness, because it made an indirect allusion to the characteristics of the goods, this did not mean that it was devoid of any distinctive character under s3(1)(c) of the Trade Marks Act 1994 (TMA). Because inherent distinctiveness was found, it was not necessary

“ The Court held that the average consumer would be the adult making the purchase, rather than the child who would be the end user

to consider acquired distinctiveness. The Court nevertheless confirmed that the evidence filed was sufficient to demonstrate that the UK Mark also had acquired distinctiveness. As a result, the UK Mark was declared valid.

#### INFRINGEMENT DECISION

The next issue for consideration was whether Trespass's use infringed under s10(2) TMA. Notably, an initial claim under s10(1) TMA was dropped during the course of proceedings. First, it had to be established whether use “in relation to” the goods had taken place. Here, Trespass maintained that its use of FUN TIME TOYS was merely descriptive. However, the judge concluded that Trespass's use would be taken by the average consumer as trade mark use.

The Court held that the way in which FUN TIME TOYS was presented on the packaging would be interpreted by the average consumer as being an indication of the supplier of the toys. Therefore, it was concluded that use had taken place. On this point, it is interesting to note that the Court held that the average consumer would be the adult making the purchase, rather than the child who would be the end user.

#### QUESTION OF CONFUSION

On the question of likelihood of confusion, the IPEC held that the sign used by Trespass

was visually, aurally and conceptually very similar. The appearance of TRESPASS on the packaging did not prevent the likelihood of confusion, even though it was accepted that TRESPASS was well known. As such, infringement under s10(2) TMA was established.

In view of the finding of infringement under s10(2) TMA, the claim under s10(3) was only briefly touched on, and the Court concluded that use of the UK Mark did establish reputation and that Trespass's use gave rise to a “link” in the minds of the average consumers. As a result, the use would both cause detriment to the distinctive character of the UK Mark and take unfair advantage. Infringement under s10(3) TMA was, therefore, also established. The Court left open in this context whether use of an EUTM in one EU Member State was sufficient to establish a reputation in the EU for the purposes of Article 9(2)(b) of Regulation (EU) 2017/1001 by focusing solely on the UK mark.

This IPEC decision highlights the importance of conducting clearance searches in order to identify potential infringement risks, even for marks that are only intended to be used as part of sub-branding and may be highly allusive to the characteristics of a product or service.

#### KEY POINTS

- ✦ Even where a mark has a low degree of inherent distinctiveness and makes an indirect allusion to the characteristics of the goods, this does not mean that it is devoid of any distinctive character
- ✦ The average consumer was identified as the person making the purchase, rather than the end user

#### DEFENDANT'S USE - EXAMPLES



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# Match approach lacks appeal

Aspects of the Opponent's arguments were questioned, reports Rosalyn Newsome



**On 1st September** 2016, Adil Akhter applied to register the mark MUSLIM MATCH for a wide range of services in class 45. The application was opposed by Match Group LLC (the Opponent), which provides online social introduction and dating services, under sections 5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 on the basis of an earlier UK registration, and the earlier EU registration MATCH.COM. The opposed application designated a wide range of services in class 45, which, for the purposes of this summary, have been separated into Group A and Group B.

Group A included a variety of dating, introduction and online networking services provided via the internet, mobile devices and applications, including “computer dating” and “video dating”, as well as marriage arranging and agency services.

Group B leaned more towards relationship and marriage guidance and counselling, including “divorce mediation services” and legal advice, information and representation. It also included “organization of religious meetings; personal legal affairs consultancy; provision of emotional support for families; social work services; wedding chapel services; [and] religious services”.

The Hearing Officer (HO) confirmed that the Opponent's evidence demonstrated that “the earlier EU registration MATCH.COM is used for all the services it is registered for” and was therefore “satisfied that there has been genuine use of the EU mark including longstanding and extensive use in the UK”.

## PARTIAL SUCCESS

The opposition was successful in relation to the Group A services under s5(2)(b), but rejected under s5(2)(b) for the Group B services, which the HO concluded lacked sufficient similarity with the earlier registered services. The HO examined the Group B services under the s5(3) and s5(4)(a) grounds of the opposition and concluded that “a link will not be made” under s5(3) and that “[the Opponent's] claim [under s5(4)(a)] is materially the same as that

advanced under section 5(2)(b) such that I cannot see it is in a stronger position here than the services which have survived the grounds under section 5(2)(b)”. The opposition was unsuccessful for the Group B services.

The Opponent filed a partial appeal under s5(2)(b) and s5(3), arguing that some of the Group B services should have been found similar to its services that relate to marriage and counselling. Alternatively, a link should have been found to the services relating to couples and relationships. The Appointed Person (AP) was critical about the presentation of certain aspects of the appeal case and questioned why the Opponent did not appeal all three grounds of the opposition.

## AP CRITICAL

In the decision, the AP also criticised the HO for providing insufficient reasoning for the original rejection of the opposition under s5(4)(a), stating that it should have been determined in accordance with the requirements for liability under the law of passing off and not by reference to s5(2)(b). This should have been addressed by the Opponent in the appeal. Indeed, the AP intimated that “if the case had proceeded differently at first instance and on appeal” a different outcome may have been reached under s5(4)(a).

## KEY POINT

- +
- Ensure any opposition decision issued correctly examines each individual basis of the opposition and applies the correct associated reasoning independently and in accordance with the legal requirements

THE OPPONENT'S EARLIER UK REGISTRATION

match



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# Case clothed

A common word component favoured the Opponent, says Donna Trysburg

**In this decision**, the Hearing Officer (HO) found a likelihood of confusion between the stylised mark ITS AN ADDICTION, depicted below right (the Contested Mark), applied for in relation to clothing in class 25, and the earlier plain word mark ADDICTION, registered for identical goods.

Jamie Bunyan and Stephanie Afonso Cadete (the Applicants) filed the UK application for the Contested Mark on 17th September 2017. London IP Exchange Ltd opposed, basing its opposition on s5(2)(b) of the Trade Marks Act 1994 and a UK trade mark registration for the plain word mark ADDICTION (the Earlier Mark), registered in class 25 and relied on insofar as it was registered for clothing.

A history between the parties was briefly alluded to in the decision and a search of the UK register reveals that the Applicants had previously applied for a trade mark very similar in appearance to the Contested Mark; the only difference being the absence of the words ITS AN.

## CONSIDERATIONS

The goods of the application and the Earlier Mark were identical. The HO found, with reference to guidance from T-117/03 New Look v OHIM, that the average consumer of clothing is a member of the general public who typically pays an average level of attention, and that the act of purchasing clothing is primarily a visual process. Aural considerations may also play a role via word of mouth recommendations, or where a shopper is assisted by sales staff.

Turning to a comparison of marks, the dominant and distinctive component of the Contested Mark was held to be the word ADDICTION, corresponding to the entirety of the Earlier Mark. Although the Contested Mark differed from the Earlier Mark due to the presence of ITS AN within the letter A of ADDICTION, and the underlining of the letters -TION, these elements, the HO said, were “much smaller in scale, play only a weak role



and have much less visual impact”. The marks were found to be visually and conceptually similar to a high degree and aurally similar to a medium degree if the words ITS AN were verbalised, and aurally identical if they were not.

## FINDINGS

The HO found the goods to be identical and considered that the average consumer would pay a reasonable degree of attention during a primarily visual purchasing process. The HO found a high degree of similarity between the marks overall and considered that the Earlier Mark had an average degree of inherent distinctiveness. Bearing in mind the principles of interdependency and imperfect recollection, and specifically remarking on visual similarity being a “key factor” in her decision, the HO held there was a likelihood of direct confusion.

The opposition under s5(2)(b) therefore succeeded, an unsurprising decision given the identical goods, the overwhelming dominance of the word ADDICTION in the composition of the Contested Mark and the failure of the (unrepresented) Applicants to support a contention that several ADDICTION marks coexist on the register, with evidence of coexistence on the market. The decision to refuse the application was still open to appeal at the date of writing.

## KEY POINTS

- ✦ Adding extra elements to a trade mark will not avoid a likelihood of confusion where the additional matter plays a weak role, is smaller in size and has less visual impact than the element that the marks have in common
- ✦ The purchase of clothing is primarily a visual process, and so the visual comparison between marks is critical in this context and is afforded more weight
- ✦ Coexistence of trade marks on the register is not in itself sufficient to establish that an element in common has a weakened distinctive character

THE CONTESTED MARK

**ADDICTION**

THE “ITS AN” ELEMENT



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# Another fine Ness

Beverley Robinson looks into a case where an earlier mark made a difference

**Ness Scotland Ltd** (Ness) applied to register the trade mark shown below right (top) in relation to non-alcoholic drinks and water products in class 32. The application was opposed by Ian William Henderson on the basis of his earlier trade mark registration for LOCH NESS TONIC, covering identical goods in class 32 and alcoholic beverages in class 33. According to Mr Henderson, a likelihood of confusion existed as a result of the similarities between the respective marks and goods.

Ness claimed that: there was no distinctive similarity between the marks; the words LOCH NESS were non-distinctive, and the figurative element of the opposed mark was the dominant and distinctive element of that mark. Ness applied for Mr Henderson's mark to be declared invalid on these grounds, and separately on the basis of an earlier registration for a LOCH NESS WATER logo, shown below right (bottom). Ness submitted that, if Mr Henderson were right to claim that his trade mark is confusingly similar to Ness's opposed mark, then it is also similar to Ness's even earlier mark.

## NO ASSOCIATION

Mr Henderson claimed that: there is no association in the public mind between Loch Ness and beverages; the words LOCH NESS have a normal degree of distinctiveness for the goods at hand; and the combination of the words with TONIC is distinctive in any case. The Hearing Officer (HO) concluded that the words LOCH NESS are inherently likely to designate the geographical origin of water beverages in the mind of average consumers, and that TONIC is descriptive of a carbonated water product.

Interestingly, Ness's invalidation under s3(1) of the Trade Marks Act 1994 was struck out because of a lack of supporting evidence. The validity of Mr Henderson's mark was therefore not open to review by the HO, who

had to consider the opposition on the basis that the mark was validly registered and had at least a minimum degree of distinctive character.

The HO accepted Ness's argument that the figurative U device of the opposed mark was the distinctive and dominant element of that mark and, while the marks were aurally identical and conceptually similar, there was only a low degree of visual similarity. Overall, the marks were not similar enough to cause confusion.

## EARLIER RIGHT

Turning to the invalidation based on Ness's earlier right, the HO considered that the distinctive and dominant element of Ness's earlier mark resided in the figurative device and not the verbal elements. While the words LOCH NESS WATER and LOCH NESS TONIC created a degree of similarity between Ness's earlier mark and Mr Henderson's mark, there was only a low degree of overall similarity and no distinctive similarity. Despite the class 32 goods being identical, there was no likelihood of confusion and Ness's application to invalidate was also rejected.

It was always going to be difficult for Mr Henderson to argue a likelihood of confusion between his mark and Ness's opposed mark, but not his mark and Ness's earlier mark. Indeed, the HO confirmed that, had Ness's primary arguments concerning the distinctiveness of Mr Henderson's mark not been successful, the invalidation based on Ness's earlier right would have succeeded.

## KEY POINTS

- Aural identity between marks is not conclusive, particularly where the dominant and distinctive element of a mark is a heavily stylised device
- It is important to fully substantiate any claim made in proceedings with supporting evidence

### THE NESS MARK



### THE NESS EARLIER REGISTRATION



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# An exercise in discretion

The IPO saw the sense of allowing late paperwork, says Laura Robyn

**In May 2018**, Billions London Ltd (the Applicant) filed a UK trade mark application for the BILLIONS LONDON device mark (shown below right) in class 25. The application was opposed by Billionaire Trademarks BV (the Opponent) under s5(2) (b) of the Trade Marks Act 1994, based on its earlier UK and EU trade mark registrations.

No defence was received by the 19th November 2018 deadline set by the UK IPO. The Tribunal enquired and was told by the Applicant that physical copies of the TM8 forms (in this and a parallel opposition in respect of a second application) were filed by post on 7th November 2018. The UK IPO investigated and confirmed that it only received the TM8 filed in respect of a parallel opposition, not the present case. The Applicant then emailed in another TM8 on 22nd November 2018, following which the Tribunal issued a preliminary view that the late TM8 could not be admitted to the proceedings. The Applicant requested a preliminary hearing. The Opponent did not file any submissions or attend.

## HEARING

At the hearing, the Applicant made representations that the TM8 form had been sent to the IPO “to the best of the Applicant’s knowledge”. No light could be shed, however, on why the IPO only received one of the two TM8 forms.

The Hearing Officer (HO) ran through the relevant procedural provisions governing the Registrar’s discretion to admit the late filing of TM8s:

- Rule 18(2): Where the applicant fails to file a form TM8 within the relevant period, the application shall, unless the Registrar otherwise directs, be treated as abandoned.
- Jointly applying Rules 77(1) and 77(5), it follows that the deadline is only extendable if (i) it is attributable to a default, omission or error by the Registrar/Office/International Bureau, or (ii) it appears to the Registrar that it should be rectified.

Dismissing the avenue of an error on the part of the Registrar/Office/International Bureau, the HO went on to consider the relevant case law delineating the scope and application of the Registrar’s discretion. Citing two Appointed Person decisions in particular, the HO concluded that the discretion conferred by Rule 18(2) is a strict and narrow one that can only be exercised in “extenuating circumstances” (Kickz) and that there must be “compelling reasons” (Mercury) for doing so. The HO considered the relevant factors for consideration laid down in Music Choice:

- the reason for and extent to which the deadline was missed;
- the nature of the opponent’s allegations in its statement of grounds;
- the consequences of treating the applicant as opposing or not opposing the opposition;
- any prejudice caused to the opponent by the delay; and
- any other relevant consideration, eg related proceedings between the parties.

## DECISION

In its decision, the HO noted in particular that: there were concurrent opposition proceedings between the two parties; no submissions were made in relation to any prejudice caused by the delay; and, if the TM8 were not admitted, further cost and delay would be caused to both parties, given that the Applicant would need to refile and the Opponent would, in all likelihood, oppose the new application. On this basis, the late-filed form TM8 and counterstatement were admitted into the proceedings.

## KEY POINTS

- This case is a useful reminder of the relevant considerations that are taken into account when a non-extendable deadline is missed
- Trade mark applicants need to be alive to critical counterstatement deadlines and take all reasonable steps to ensure they are met

THE APPLICANT’S  
DEVICE MARK

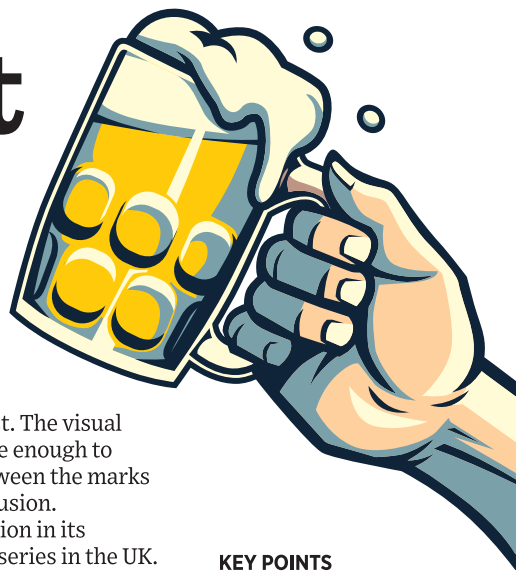


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# Ale's well that ends well

The HO determined HBO's defence was too weak, explains Dale Carter



**Wadworth and Company Ltd** is a family-owned brewery in Wiltshire, the county that is home to the stone circles of Avebury and Stonehenge. Inspired perhaps by its surroundings, Wadworth launched a golden ale called "Wadworth Game of Stones" and filed a UK trade mark application for the beer-pump label pictured below right, covering class 32 goods.

Home Box Office, Inc (HBO) opposed Wadworth's application, relying on the following grounds:

1. a likelihood of confusion with its earlier registrations, including the word mark GAME OF THRONES, registered for "beer" in class 32;
2. unfair advantage of and detriment to the repute and distinctive character of HBO's GAME OF THRONES marks in the UK; and
3. the law of passing off.

## STRONGEST CASE

Although HBO's registrations were not subject to proof of use and could be considered across the full breadth of their specifications, in deciding the opposition under s5(2)(b) of the Trade Marks Act 1994, the Hearing Officer (HO) considered HBO's strongest case only, namely its word mark registration covering identical goods.

When analysing Wadworth's mark, the HO noted that the stone-circle device and the word WADWORTH each had individual distinctive character. However, due to their size and central position, the words GAME OF STONES were the dominant distinctive element. This element shared a high degree of aural similarity with HBO's mark, which was particularly relevant where the purchasing act involved a spoken request. There were significant visual and conceptual differences between the marks, leading the HO to conclude that the level of visual and conceptual similarity was low. The HO reasoned that the average consumer was the beer-drinking general public, who would exhibit a normal level of attention when purchasing the goods. In dismissing HBO's s5(2)(b) ground, the HO concluded that beer was rarely purchased

solely by way of an aural request. The visual and conceptual differences were enough to offset the aural similarities between the marks and remove a likelihood of confusion.

HBO filed evidence of reputation in its GAME OF THRONES television series in the UK. However, as none of this evidence related to the services for which HBO's earlier mark was registered, it could not be relied on to support a claim to reputation. HBO's s5(3) ground was therefore rejected.

## PASSING OFF

HBO argued that Wadworth had imitated its mark and that this would lead to initial interest confusion (ie misrepresentation) and damage. The HO agreed that the GAME OF THRONES mark has significant goodwill in the UK for television entertainment services. However, Wadworth's intent to deceive was far from obvious. Although Wadworth was likely to have taken inspiration from HBO's mark, this was a parody and not an attempt to mislead consumers. In dismissing HBO's initial interest confusion argument, the HO was mindful of there being no common field of activity. At best, HBO's mark would be brought to mind, but the connection was weak and an insufficient proportion of the relevant public would be deceived.

This decision highlights the importance of protecting marks for the goods and services for which they are being used. HBO's evidence of use for the purposes of s5(3) fell outside its registered specification of services. This led to HBO's arguably most powerful ground of opposition being dismissed for a failure to substantiate its rights.

## KEY POINTS

- ✦ Evidence of use of a mark for the purpose of establishing enhanced distinctive character or reputation requires the mark to have been used for the registered goods/services
- ✦ Initial interest confusion may amount to misrepresentation
- ✦ Comical parody falls short of deception within the context of passing off

## WADWORTH'S APPLICATION



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# Taking back the beat

David Birchall summarises a decision that recognised the sway of similarities



In 2015, Beats Electronics, LLC, a subsidiary of Apple Inc, opposed an application by Disashop SL to register the mark shown below right (top) as an EU trade mark (EUTM) in respect of various goods and services.

Beats based its opposition (under Articles 8(1)(b) and 8(5) of Regulation (EU) 2017/1001) on, among other marks, earlier EUTMs for each of the two marks shown below right (bottom).

## ORIGINAL DECISION

In early 2018, EUIPO's Opposition Division (OD), despite agreeing that many of the goods and services in the contested application and Beats' EUTMs were identical, rejected Beats' opposition in its entirety. It found that, visually, the marks differed in their overall layout, proportion, shape and colour, and were only "similar at most to a low degree". The OD also found that, aurally, the earlier marks would be perceived as "b", while the later mark would be pronounced as "d". Thus, there was no likelihood of confusion. EUIPO held that Beats' evidence had not proven reputation and had not proven that its device mark would be recognised independently of its word mark.

## APPEAL

Beats appealed in respect of the goods and services that had been found to be at least similar to those for which its earlier marks were protected. Beats argued that, as demonstrated by its evidence, its own mark was used in red and white (the same colourway as the contested mark) and that the letters "d" and "b" were mirrored reflections of each other, without additional distinguishing features.

The Board of Appeal (BoA) agreed that the essential characteristics of the earlier marks were reproduced in the opposed mark and that,

even if some would see the earlier marks as a "b" and the contested mark as a "d", the overall impression given by the contested mark was that it was "a mirror image of the earlier marks". The BoA concentrated on the section of the public that would not recognise the letters and would instead perceive the marks purely as devices. From this angle, the BoA found the marks similar to an average degree. On the basis that the earlier marks had no apparent meaning in relation to the goods and services for which they were protected, the BoA held that they had a normal degree of distinctive character and found it unnecessary to consider Beats' claims of reputation and enhanced distinctiveness.

The BoA held that consumers usually focus on similarities rather than differences, the minor differences in the marks not being sufficient to outweigh their visual similarities.

The appeal succeeded in its entirety under Article 8(1)(b).

According to EUIPO's published statistics, only 54 per cent of BoA decisions issued in 2018 on EUTM oppositions confirmed the original decision in its entirety. In more than 17 per cent of the 2018 decisions, the appeal succeeded in full. More than 29 per cent of the decisions overturned the original opposition decision either in part or in full. As Beats' case demonstrates, an appeal is sometimes required to obtain the decision sought.

## KEY POINTS

- + Consumers usually focus on similarities rather than differences
- + More than 29 per cent of 2018 BoA decisions overturned the original EUTM opposition decision either partly or fully

THE DISASHOP MARK



THE BEATS ELECTRONICS MARKS



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# Forever failure

Confusion was concluded, reports Leanne Gulliver

**In 2013**, the US fashion retailer Forever 21 Inc (the Applicant) applied to register the word mark FOREVER 21 under EU trade mark (EUTM) No 011981917 in respect of goods in classes 3, 8 and 26 (the Application).

The French cosmetics brand Make Up For Ever (the Opponent), owned by Louis Vuitton Moët Hennessy, successfully opposed the Application in respect of class 3 (namely, cosmetics) on the basis that, contrary to Article 8(1)(b) of Regulation (EU) 2017/1001, the Application was confusingly similar to its earlier EUTM No 3416443 for the word mark MAKE UP FOR EVER (the Registration).

## PROOF OF USE

As the Registration was granted protection in 2005, the Applicant requested proof that the Registration had been genuinely used in the EU during the period 30th August 2008 to 29th August 2013 in connection with class 3 goods (broadly speaking, skin-whitening creams and powders, false eyelashes and make-up).

The Opponent filed its proof of use with a statutory declaration, which included (but was not limited to) extracts from its website, cover pages of catalogues, invoices to clients/distributors in 11 EU countries, press and magazine clippings, and online articles about its products in English and French.

The Applicant argued that not all of the evidence indicated genuine use in terms of time, place, extent, nature and use of the goods for which the mark had been registered. However, the Opposition Division (OD) held that the evidence, particularly the invoices and catalogues, together with the statutory declaration, provided sufficient information concerning the commercial value, the territorial scope, and the duration and frequency of use to find that the Registration had been genuinely used

## KEY POINTS

✦ Evidence of use must consist of indications concerning the place, time, extent and nature of use. A combination of these factors may indicate genuine use

✦ A likelihood of confusion for only part of the relevant public of the EU is sufficient to reject the contested application

✦ It was appropriate to focus the comparison of the signs on the non-English-speaking part of the public, such as the Latvian, Lithuanian, Polish and Romanian public

during the relevant period in the EU in connection with the class 3 goods.

## CONFUSION CONSIDERED

The OD considered that the contested goods belonged to the same sector of cosmetics and perfumery as the Opponent's goods. In particular, these goods are produced by the same companies, target the same end users and are being sold in the same places through the same channels of distribution. Therefore, the goods were at least similar to a low degree, and were directed at the public at large, whose degree of attention is average.

Further, the OD considered the signs to be visually and aurally similar. In reaching this conclusion, the OD noted that the element MAKE UP in the Registration would be understood across the EU, and has become part of the vocabulary of other European languages, such as Latvian, Lithuanian, Polish and Romanian. Since the relevant goods were cosmetics, this element was considered non-distinctive. However, while the element FOR EVER is English, it was not likely to be understood by the public in parts of the EU where English is not commonly spoken. The OD therefore found it appropriate to focus the comparison of the signs on the non-English-speaking part of the public.

The OD held that there was a likelihood of confusion on the part of the non-English-speaking part of the public. The Application was therefore rejected for all of the contested goods in class 3.



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# Good vibes gone bad?

David Yeomans wonders whether this mark will ever reach registration

**This case concerns** an opposition filed by Laurent Zentz (the Opponent) against EU trade mark application No 1376535 (shown below right) by Valuestore.it SR. The mark contains the wording GOOD VIBES ONLY in very small text above the element TOCA.

The opposition was based on a claim of likelihood of confusion with an earlier EU registration of the word mark GOODVIBES. The Opponent also attempted to run a double-identity claim, which was, not surprisingly, given very short shrift by the Opposition Division (OD).

The application sought registration for clothing, footwear and headgear in class 25, and various games and sporting articles in class 28. The goods applied for were all deemed identical to goods for which the earlier mark was protected, so the outcome of the opposition came down to whether the respective marks were similar enough for there to be a likelihood of confusion, bearing in mind the identity of the goods.

## LAUDATORY MEANING

The OD held that, for English-speaking consumers, the phrase “good vibes” would be laudatory of the characteristics of the goods at issue, and was therefore of weak distinctiveness. It thus decided to assess the similarity of the signs from the perspective of the non-English-speaking public, because this would be the most advantageous scenario for the Opponent (since the earlier mark would be considered to have normal, as opposed to weak, distinctiveness).

The marks were held to be visually similar to a low degree on the basis that the TOCA element of the mark applied for dominates it visually. Phonetically, the marks were held to be either dissimilar (to consumers who wouldn’t pronounce the “good vibes” element of the

mark applied for on the basis of its position and size within the mark) or similar to only a low degree. A conceptual comparison was not possible, because the marks were held to convey no meaning.

As the goods were deemed identical and the signs somewhat similar (at least visually), the OD went on to examine the likelihood of confusion. Perhaps unsurprisingly in the circumstances, no likelihood of confusion was found. In addition to the differences between the marks, the OD held that some of the goods in class 28 may be relatively expensive, and so would be carefully scrutinised prior to purchase, further reducing any risk of confusion.

“

*Had the GOOD VIBES element been more prominent, the outcome may have been different*

mark applied for was likely key; had the GOOD VIBES element been more prominent, I expect the outcome would have been different.

If the Opponent doesn’t appeal, then the Applicant will have won this particular battle. However, at the time of writing, its application still faces another ongoing opposition, so it remains to be seen whether this application will ever make it onto the register.

## KEY POINTS

- ✦ A finding of likelihood of confusion is not guaranteed, even if the mark applied for reproduces the earlier mark and the goods at issue are identical
- ✦ The fact that the common element was such a small part of the mark applied for was likely key

THE GOOD VIBES MARK



## NO GUARANTEES

This case reminds us that likelihood of confusion is not guaranteed even if the mark applied for reproduces the earlier mark and the goods at issue are identical. Each case is to be assessed on its own merits. In this case, the fact that the common element was such a small part of the

mark applied for was likely key; had the GOOD VIBES element been more prominent, I expect the outcome would have been different.

If the Opponent doesn’t appeal, then the Applicant will have won this particular battle. However, at the time of writing, its application still faces another ongoing opposition, so it remains to be seen whether this application will ever make it onto the register.



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# Could it be coincidence?

Gavin Stenton is interested in whether inspiration was drawn

In a surprising decision, the EUIPO Opposition Division (OD) has dismissed an opposition by Joe & The Juice A/S (the Opponent) against an EU designation/application by Central Park labels GmbH (the Applicant) for the sign shown below right (bottom), allowing the designation to proceed to registration.

The Applicant's EU designation covered clothing, footwear and headgear in class 25 and various goods in class 18, including luggage and umbrellas. In its opposition notice, filed on 17th November 2017, the Opponent relied on a number of senior Danish and EU trade mark registrations for the logo mark shown below right (top), in both colour and greyscale, as well as the word mark JOE & THE JUICE, each covering various food products in class 30, non-alcoholic beverages in class 32, services for providing food and drink in class 43 and (in some cases) business management services in class 35. In reaching a decision, the OD focused on the Opponent's colour logo as representing its strongest case.

Due to the differences between the goods and services at issue, the opposition was based exclusively on Article 8(5) of Regulation (EU) 2017/1001 (ie pertaining to reputation and unfair advantage). Interestingly, the Opponent did not seek to rely on any unregistered rights (under unfair competition, passing off or otherwise), despite claiming that its marks enjoyed a substantial reputation in a number of EU territories.

## ANALYSIS

The Opponent succeeded in establishing a reputation in its earlier mark in Denmark in relation to "cafés" and "snack-bars" only. In analysing the Opponent's evidence of

reputation, the OD placed particular emphasis on that originating from independent third parties, such as the Opponent's auditors. Further, the OD exercised its discretion under Article 8(5) of Regulation (EU) 2018/625 to allow some of the Opponent's survey evidence that had been filed "relatively shortly" after the applicable deadline, on the basis that it was to "merely strengthen and clarify the evidence initially submitted". In doing so, the OD noted that the web-based survey in question was completed after the deadline had passed and could not therefore have been filed in advance.

In comparing the signs, the OD found them to be visually similar to a low degree, aurally similar to a very low degree and conceptually dissimilar. The OD also found the majority of elements comprising the Opponent's sign (with the exception of JOE) to be weak individually, on the basis that they alluded to the Opponent's services.

The OD favoured a detailed comparison of the signs, identifying and comparing their individual elements, rather than their overall impression, get-up, composition and colour scheme, and in doing so concluded that the relevant public was not likely to establish the requisite "link" between the two signs, particularly given the divergence in goods and services. The opposition was therefore rejected.

## APPLICANT INSPIRED?

Under the circumstances, this may appear to be a surprising decision and an appeal is perhaps likely. It would certainly be interesting to know whether the Applicant drew any inspiration from the Opponent's earlier marks or whether the similarities in terms of composition and get-up are purely coincidental.

## KEY POINTS

- ✦ Senior unregistered rights should always be considered in parallel with registered rights and be pleaded where available, as passing off and unfair competition laws can sometimes fill the gaps that trade mark law cannot
- ✦ Evidence of reputation from independent third parties is likely to enjoy greater probative value
- ✦ Facts or evidence filed outside a relevant time limit may still be accepted if they are supplemental and/or were not available within the time limit

EARLIER MARK



CONTESTED SIGN



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Michael Ridge, an Associate at Penningtons Manches LLP, co-authored.

# Apple and Pear compared

The Applicant enjoyed the fruit of its labours, writes John Coldham

**Pear Technologies Ltd** applied to register a logo for a pear, shown below right (top), as a trade mark at EUIPO. Despite the mark being refused at EUIPO and by the Board of Appeal, Pear overturned these decisions in the General Court (GC).

Pear's application for its logo covered various goods and services, including "personal computers". The application was refused in the first two outings following opposition by Apple, which opposed the registration on the basis of its well-known Apple logo and registration, shown below right (bottom).

Apple was successful in opposing the registration in front of the Opposition Division and Fifth Board of Appeal (BoA) pursuant to Article 8(5) of Regulation (EU) 2017/1001, namely that the Pear mark was similar or identical to the Apple mark and would take unfair advantage of the Apple mark's reputation.

The GC agreed with Pear and annulled the decision of the BoA on the grounds that the marks were not similar.

## SIMILARITY ASSESSMENT

According to European trade mark case law, similarity of marks is assessed by analysing the extent of visual, phonetic and conceptual similarity, and then reaching an overall assessment. The GC stated that the marks were not visually similar, but that "the conflicting marks, each considered as a whole, produce overall impressions which are dissimilar overall on a visual level", and the only similarities between the marks were "the presence of black colour and the similar positioning of the figurative elements placed above the depictions of the apple and the pear, which will probably go unnoticed among the relevant public".

The GC pointed out a number of differences between the marks, including that: they

depicted different fruits; the shapes of the fruits were dissimilar; the Pear mark was composed of a number of different squares without a solid edge; and the Pear mark featured the word element PEAR.

Turning to the question of conceptual similarity, the hearing on the extent of this became quite eclectic, with various bases for assessment considered. The Court heard submissions on the relative location of different fruits in a supermarket, whether consumers would be aware of the common genetic qualities of apples and pears, and whether the mere fact of their being fruit was sufficient. The Court concluded that there was no conceptual similarity between the marks, even pointing

out that, in several European countries, "apples and pears are used in proverbs to illustrate that two things are different and not comparable".

## ASSESSMENT ERROR

In the GC's view, the BoA had erred in its assessment because it had taken account, in its visual comparison, of the

reputation of the earlier mark and taken inspiration from the idea that the relevant public would therefore be able to establish a link between the conflicting marks. However, the reputation of the earlier mark is not a relevant factor when assessing the similarity of the conflicting marks. Whether there is a link between them in the mind of the public concerned is only considered if the similarity hurdle is met, which the GC decided was not the case here.

## KEY POINTS

- The BoA erred in its assessment by taking into account reputation alongside its visual comparison. This should only be considered where visual similarity is established
- Reputation forms no part of the analysis of visual and conceptual similarity

THE PEAR LOGO



THE APPLE LOGO



“  
The hearing on  
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conceptual  
similarity became  
quite eclectic



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Gowling WLG acted for  
Pear Technologies

# Earlier dates don't mean earlier rights

Catherine Byfield reports on a failed attempt to beat the clock

In 2008, Swemac Innovation AB (SI AB) registered SWEMAC for surgical and medical apparatus and related research and development services. The registration was later invalidated on the basis of a Swedish company name, SWEMAC Medical Appliances AB (the Earlier Sign), registered in 1997 for development, manufacture and sale of medical apparatus and equipment. This application was rejected, as it had not been proved that the Earlier Sign was of more than mere local significance, and therefore it did not fulfil the conditions of Article 8(4) of Regulation (EU) 2017/1001.

On appeal, additional evidence was submitted regarding the use of the Earlier Sign. The Board of Appeal (BoA) upheld the appeal, finding Article 8(4) satisfied, a likelihood of confusion and no establishment of coexistence, and rejecting SI AB's submission on acquiescence.

## FRESH EVIDENCE

In this General Court (GC) appeal by SI AB, it advanced two pleas. Crucially, SI AB claimed that it had a company name, Swemac Orthopaedics AB, and an unregistered trade mark, SWEMAC, that predated the Earlier Sign. On appeal to the GC, it sought to evidence this, as well as coexistence of the signs at issue and that there was no likelihood of confusion. These documents were submitted for the first time and were therefore held to be inadmissible.

The GC held that there is no provision to assess whether the registered proprietor did in fact have an earlier right predating the Earlier Sign. This would be a matter for national courts in cancellation proceedings.

SI AB submitted that the relevant public were highly skilled and informed users, such as surgeons and medical institutions, and the goods and services expensive. Therefore, an exceptional level of attention would be applied in selecting them. It also argued, against

likelihood of confusion, the alleged prior peaceful coexistence between the parties.

The GC found that SI AB had failed to prove coexistence or that the Swedish public did not confuse the signs when faced with them. Given the identity and similarity of the goods and services, and the similarity of the marks, there must be a likelihood of confusion, even taking into account a high level of attention.

SI AB further argued that the BoA erred in its assessment of acquiescence. It contended that it should be assessed in relation to "implied informed consent", rather than date of registration, and that the two parties resulted from a split of an original company, Swemac Orthopaedics, and had worked on the same premises for 10 years.

The GC reiterated the requirements for acquiescence, especially that there must be knowledge of the use after the mark is registered. As the five-year clock does not start ticking until after registration, there could not be acquiescence where the registration was less than five years old. The appeal was dismissed.

## FINAL WORD

Although there are no surprises here, it is useful to remember that the timely filing of evidence can be key, and that there is no scope to "beat" the date of an earlier right in invalidity proceedings.

## KEY POINTS

✦ In respect of Article 8(4), applicants for invalidity or opposition must set out not only that they satisfy the necessary conditions under national law that they rely on, but also the content of that law

✦ Coexistence on the market can reduce the likelihood of confusion, providing the marks concerned are identical. However, it is necessary to demonstrate this by way of evidence

✦ The registered proprietor was held to have failed to prove coexistence of the signs at issue or that the Swedish public did not confuse those signs when faced with them



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Legislative change in Canada is the focus of our CITMA Webinar on 16th July. For details, see [citma.org.uk](http://citma.org.uk) →



# Events

More details can be found at [citma.org.uk](http://citma.org.uk)

DATE	EVENT	LOCATION	CPD HOURS
26th April	CITMA Lecture – Manchester Trade marks: unfair advantage, bad faith and genuine use	Marks & Clerk LLP, Manchester	1
30th April	CITMA Lecture – London Domain name disputes post-GDPR	London	1
14th May	CITMA Paralegal Webinar GDPR and its relevance to the work of CITMA Paralegals	Log in online	1
13th June	CITMA Webinar Update on EU case law: trade marks, designs and copyright	Log in online	1
2nd July	CITMA Summer Reception	The Refinery, London EC4	
16th July	CITMA Webinar A year of change: Canada's new trade mark laws	Log in online	1
3rd September	CITMA Webinar	Log in online	1
6th September	CITMA Paralegal Seminar	London	
24th September	CITMA Lecture – London	Carpmaels & Ransford, London WC1	1
8th October	CITMA Webinar Artificial intelligence	Log in online	1
12th November	CITMA Paralegal Webinar The Chinese “super trade mark”	Log in online	1
14th November	CITMA Webinar UK case law update	Log in online	1
26th November	CITMA Lecture – London Fashion and IP	Allen & Overy LLP, London E1	1
6th December	CITMA Northern Christmas Lunch	TBC	
13th December	CITMA London Christmas Lunch	London Hilton Park Lane, London W1	

## SUGGESTIONS WELCOME

We have an excellent team of volunteers who organise our programme of events. However, we are always eager to hear from people who are keen to speak at a CITMA event, particularly overseas members, or to host one. We would also like your suggestions for event topics. Please contact Jane at [jane@citma.org.uk](mailto:jane@citma.org.uk) with your ideas.

# THE TRADE MARK 20

## Q&A

# Maya Muchemwa

enjoys making an argument

**I work as...** a Trade Mark Attorney (newly qualified) at Marks & Clerk in Manchester.

**Before this role, I was...** a paralegal at one of the Big Four supermarkets, where I worked on a variety of matters, including contracts, IP, employment and small claims litigation.

**My current state of mind is...** it could be worse.

**I became interested in IP when...** at a young age, I first realised that I automatically associated certain brands with certain things (eg Cadbury with Easter). I later studied IP as a module during my undergraduate degree.

**I am most inspired by...** my parents' work ethic. They moved from Zimbabwe to the UK with very little, and two children in tow, and have worked hard to establish themselves, going beyond their expectations.

**In my role, I most enjoy...** thinking up arguments to defend my clients' positions.

**In my role, I most dislike...** giving clients bad news, particularly refusal decisions when I don't agree with the decision myself.

**On my desk is...** a red stiletto-shaped phone stand, which was a gift, given to me by my colleague Jack when I became qualified.

**The talent I wish I had is...** the ability to read minds. It would help me build relationships quicker. But I wouldn't want to know what people think of my outfit choices every day!



“

*The ability to read minds would help me build relationships, but I wouldn't want to know what people think of my outfit choices every day!*

**My favourite mug says...** “Out of my mind, back in 5 mins”.

**My favourite place to visit on business is...** London. It's so lively, and I always feel like I've contributed to the country's GDP when I leave!

**If I were a brand, I would be...** Coca-Cola, because of its ability to reinvent itself and remain current in order to achieve longevity.

**The best piece of advice I've been given is...** try again!

**The biggest challenge for IP is...** Brexit in the immediate future, but, longer term, AI and computerisation will present some challenges.

**I can't live without...** friends and family, my phone and music.

**My ideal day would include...** music, a scroll through Twitter, a few chapters of whatever book I'm reading at the time, an episode of my favourite South African soap *Scandal!* and a nap.

**In my pocket is...** sorry, no pockets on my outfit today.

**When I want to relax, I...** have a shower, get some popcorn and watch a box set I've seen before, so I can dip in and out of sleep.

**In the next five years, I hope to...** build on the knowledge I've acquired so far and travel a bit more.

**The best thing about being a member of CITMA is...** the tight-knit member community.



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