

CITMA REVIEW

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WHY MENTORING MATTERS

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the power
of personal
support*



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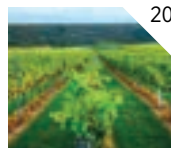
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Published on behalf of CITMA by

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20 Mortimer Street,
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www.thinkpublishing.co.uk

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CITMA REVIEW
CITMA Review content is provided by members on a voluntary basis, and reader suggestions and contributions are welcome. If you would like to contribute an article to a future issue, please contact Caitlin Mackesy Davies at caitlin@thinkpublishing.co.uk

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PRESIDENT'S WELCOME
OUR PROFESSION
IS SURE TO THRIVE

We are into another new year and I would like to take the opportunity to reflect on the year that has passed and to look forward to what 2023 will hold.

Last year saw two great CITMA conferences, the launch of another round of our Paralegal Course, the beginning of our representation project and much more. We have been able to work and learn together as a profession, and invest time in working for a positive environment for the future of our industry.

December also gave us the opportunity to come together at an array of CITMA Christmas events. It was great to see so many familiar and new faces at our London and Leeds Christmas lunches – thank you to everyone who attended and who worked to make these events a success.

At our London Christmas Lunch, we were also able to celebrate our 2022 CITMA award winners. I'd like to take this opportunity to once again pass on my congratulations to all of them.

During the upcoming year, we can look forward to another packed programme of learning and social events, with opportunities available both across the country and remotely. Booking is now open for our Spring Conference, which will take place at The Waldorf Hilton in London in March. I hope to see lots of you there for another great day of learning and networking, with our wide array of expert speakers joining us to offer insight on a characteristically broad range of topics.

Finally, I wish you all the best of luck for 2023 – no doubt it will be another busy year, but I'm sure that our profession will continue to thrive.

Rachel Wilkinson-Duffy,
CITMA President



Left to right: John Glover, Sonia Amrar, Christina Chan, Lauren Fisher

CELEBRATING
OUR STUDENTS'
SUCCESSSES

The annual CITMA awards are our chance to celebrate the top trade mark students in the country. We are delighted to announce the 2022 winners. Our winners were once again able to receive their awards in the company of our members at our London Christmas lunch.

In 2022 our awards recognised the Student members receiving the highest marks on the trade mark qualification courses at Queen Mary University of London, Bournemouth University, Brunel University and Nottingham Law School. In addition, the Roy Scott Award was presented to the student who achieved the top mark in the CITMA Paralegal Course.

SIMON O'CONNOR

OUR SPRING CONFERENCE IS COMING SOON

Book now for this special event that will explore Strategies for Success. For details go to citma.org.uk/events



MEMBERS.PARLIAMENT.UK / RICHARD TOWNSHEND

CITMA award winners 2022

Postgraduate Certificate in Trade Mark Law and Practice at Queen Mary University of London

- Jean-Francois Bruneau, BAT Mark
- Szu-Yu Tao (Celia Tao), Pinsent Masons

Postgraduate Certificate in IP at Bournemouth University

- Danielle Wears, Pure Ideas

Professional Certificate in Trade Mark Practice course at Nottingham Law School

- Christina Chan, Stevens Hewlett & Perkins

Intellectual Property Law Postgraduate Certificate at Brunel University

- John Glover, William Grant & Sons

Intellectual Property Litigation and Advocacy Certificate at Nottingham Law School (Hogarth Chambers Award)

- Sonia Amrar

The Roy Scott Award

- Lauren Fisher, Albright IP

CITMA extends its congratulations to all of these outstanding students



IP HANDBOOKS: FREE TRIAL

Thomson Reuters is offering CITMA members a free 30-day trial allowing access to the following CIPA/CITMA publications on ProView eBook: *The Trade Mark Handbook*; *The European Union Trade Mark Handbook*; *The Community Designs Handbook*. See citma.org.uk/proview



GEORGE FREEMAN RETURNS AS IP MINISTER

George Freeman MP has been re-appointed as the minister with responsibility for IP, less than five months after resigning. He takes over from Dean Russell MP. The role sits within the Department for Business, Energy and Industrial Strategy (BEIS). See citma.org.uk/gfreeman



SPRING CONFERENCE 2023

Share strategies for success and meet our international community of trade mark professionals at our Spring Conference in London on 16th March 2023. Hosted in The Waldorf Hilton, the conference will equip you with practical advice to take into your work. Find out more and book at citma.org.uk/sc23review



IT'S OVER TO THE LSB

Two years of work will yield a fresh way forward,
believes Lord Chris Smith

On 10th November 2022, we at IPReg were able to submit our proposals for a major overhaul of all of our regulatory arrangements to the Legal Services Board (LSB). We've worked very hard on our Regulatory Arrangements Review for two years now, issuing first a call for evidence and then a detailed consultation, holding a range of discussions with key stakeholders, analysing evidence gleaned from across the IP sector, and submitting a draft application for initial comment to the LSB. Now the final document is in, and we will await the LSB's response over the next few months.

One of the things I was most determined to do when I became Chair of IPReg was to set about simplifying and clarifying our rules and procedures. There were too many overlaps and anomalies and I was certain we could do better. I hope that this is precisely what we have now achieved with our submission. We have now been able to set out, in one place, all of the regulatory arrangements relevant to Patent and Trade Mark Attorneys. We begin by setting out a series of overarching principles: the need for ethical behaviour and for attorneys always to act with integrity, for example. We set out a Code of Conduct. We emphasise the importance of consumer protection in matters like cost transparency.

We bring in greater clarity around admission and authorisation processes. We propose the modernisation of CPD requirements to make them more meaningful. And we set out what I hope will be clear operational rules.

“
*My goal is to make
IPReg a regulator
that attorneys are
proud to be
regulated by*

We've been driven by a number of ambitions. We have tried to write the rules in plain English. We have ensured substantial consultation with as many parts of the IP world, including consumers, as possible. We are seeking to encourage and support innovation. And we want to enhance equality, diversity

and inclusivity in the profession. We will also want to test how all of these changes actually work as we implement them. We'll want to do a proper impact assessment as they bed in and assess whether they're working well. We won't, of course, have managed to get everything right from the outset; and we need to be able to learn from experience as the new rules are implemented.

But I'm confident that the process we've been through and the discussions and consultations we have undertaken have resulted in something to be proud of. The LSB still has to give its imprimatur, and I'm sure it will question some things, but I'm hopeful that we're almost there. When we've secured LSB approval for a final version we will then get in touch with every registered attorney to let them know the shape of the changes.

My goal is to make IPReg a regulator that attorneys are proud to be regulated by. The same will, I hope, be true of these new revised rules and procedures. ●



The Rt Hon the Lord Smith of Finsbury
is Chair of IPReg

SACCOMANN ✕

We are seeing real buoyancy in the Trade Marks profession, and **an ongoing, creative approach to working life** which is opening up opportunities for both businesses and individuals alike. Here's a selection of our current instructions, but if you'd like more bespoke advice as to how **we can help improve your career, life and / or business**, please contact one of our consultants.

Trade Mark Paralegal/PA : London

TJB139766

Exceptional offering to be an integral part of the firm's trade marks practice. Desirably, you'll be a CITMA qualified professional with experience working directly with fee earners. You'll be pivotal providing an outstanding level of support in this varied and challenging role. In return you'll receive excellent training, whilst benefitting from their flexible working offering and impressive overall reward package.

Trade Mark Paralegal : London or Bristol

TJB138549

We are working on behalf of a leading and progressive IP practice with capacity to welcome a skilled and highly motivated Trade Mark Paralegal. With full support from the line managers, on offer is a diverse role assisting Trade Mark Attorneys with all manner of their workload, direct client contact and delegation of workflow between fee earners, paralegals and CSA, to ensure that deadlines are met and an overall consistently high client service is reached.

Trade Mark Paralegal/Formalities : London

TJB139682

This young but impressive IP arm of a multi-disciplinary law practice is keen to welcome dynamic individuals who can fully support their rapidly growing global portfolio. This is great time to join this small collegiate team. To manage a wide variety of soft IP matters, you'll need to be pragmatic and keen to embrace new technology. To meet the demands of a formalities position you'll possess 2+years experience (fully remote will be considered). For paralegals, those with no IP experience but a growth mindset will be warmly welcome to apply.

Part-Qualified Trade Mark Attorney : Leeds

CEF138855

Prominent full-service practice offers a diverse workload with clients from multinationals, global brands, universities and SMEs, across sectors such as retail, hospitality, healthcare, media, engineering and agriculture. Searching, global trade mark filing and prosecution will offer you the day-to-day variety to develop and broaden your skillset and for those with an interest in contentious work, the expert trade mark litigation practice operates from this office.

IP Solicitor or Trade Mark Attorney : London

CEH137148

Hugely exciting time to join a busy, growing team within a stellar practice! Sought are those qualified either 2-3 years PQE or 5-7 years PQE who are confident handling a mix of the following areas of work: filing and prosecution, registrations, revocations, advisory work, oppositions, and designs work as well as High Court litigation and IPEC. It's a brilliant opportunity for those who are happy handling non-contentious matters with exposure to contentious work as and when it arises.

Trade Mark Attorney or IP Solicitor : London

CEH139607

Exemplary boutique law practice has an unmissable opening for a Trade Mark Attorney or pragmatic IP Solicitor with upwards of 6 years PQE and a strong background in trade mark prosecution. Established and renowned for their outstanding work on behalf of clients across a plethora of media, technology and entertainment sectors, the excellent quality of work here will certainly not disappoint. Rest assured a unique and genuinely supportive culture exists!

Trade Mark Attorney or IP Solicitor : London

CEH127768

Unmissable opportunity if you are circa 2-4 years PQE within private practice or an in-house trade marks department. The full support of a dynamic and collegiate team will be behind you with plenty of high quality, immensely interesting work with clients across digital media and consumer facing fields, such as fashion and retail. You'll cover prosecution, oppositions, cancellations, maintenance and clearance searches as well as advising clients on protection, exploitation and the enforcement of IP rights.

Trade Mark Attorney : London

LKA138606

Leading full-service IP practice seeks finals standard to circa 5 years PQE. With a meritocratic ethos and an impressive pool of clients, the sizeable trade marks team have active Partners and some excellent training structures in place to ensure you receive an outstanding level of support to fully enrich and propel your career forward. Of particular interest are those commercially informed candidates who relish all aspects of business development with a focus on future growth.

Trade Mark Attorney : London

LKA139667

Exclusive instruction! High profile IP firm with deep sector knowledge is keen to welcome an Associate. This progressive, agile and meritocratic practice offers a supportive and stimulating environment to develop your skills and meet your career aspirations. Joining this thriving practice, you'll benefit fully from the vast collective knowledge of the team. A collegiate culture exists here, with a focus on wellbeing and a healthy work/life balance. A hybrid working culture is in place.

Trade Mark Attorney : Flex location

LKA138030

Friendly firm of IP specialists is keen to welcome those at finals standard or qualified to join their sizeable team. A good level of technical expertise is required for those who enjoy all day-to-day aspects of the trade mark life cycle. For more experienced attorneys who can work autonomously, remote working is on offer. There's plenty of high-quality work and get involved with business development if you wish. A healthy work/life balance awaits.

For further information about this selection of opportunities or to discuss any other aspect of IP recruitment, please contact:

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'Tweet' us at www.twitter.com/saccomannip www.linkedin.com at the 'Sacco Mann Intellectual Property Group'

Sacco Mann is an equal opportunity employer and offers the services of an Employment Agency for Permanent Recruitment. PQE Levels are purely for guidance. We are happy to consider all applicants with the necessary skills.



London



CHEER WAS HERE

Our first Christmas events since 2019 brought our profession together once again

LONDON PHOTOGRAPHY: SIMON O'CONNOR

8 | CITMA CHRISTMAS





Leeds





NET ZERO:

**THE TIME
IS NOW**

CITMA is taking emissions reduction seriously and assisting others to do the same

At CITMA, we are committed to accelerating the move to a sustainable, low-carbon economy and reducing our impact on the environment. Our ambitious plans aim to see CITMA become a net-zero organisation in the next few years. At the same time, we seek to guide our members and their firms to contribute to our profession being as close to net zero as we can.

Why are we doing this? It's simple: every organisation, regardless of size, should be taking its responsibility to be sustainable seriously. We are no different. There will be challenges along the way, but this is a move that every sector of the economy needs to make, and the time to get started is now.

While achieving net zero is an economic and environmental necessity, it also brings with it significant opportunity. Like any time of change, this is a great time to review what you do as far as environmental sustainability and how you do it. The opportunity to review all areas of your practice may even result in cost and efficiency savings.

EVERYONE'S ISSUE

There is plenty of widely reported research into climate change and its present and future impact upon our planet. There are also predictions of what we, collectively, need to limit warming to in order to avert disaster.

For example, the Intergovernmental Panel on Climate Change special report *Global Warming of 1.5°C*, published in 2018, warned that we must limit global temperature rise to 1.5°C above pre-industrial levels and reach net-zero CO₂ emissions by 2050 for the best chance of avoiding catastrophic climate breakdown. This might sound dramatic, but the warnings are coming thick and fast. For instance, according to the Carbon Trust, allowing a temperature rise of 2°C would lead to “37% of the global population being exposed to severe heat at least once every five years and climate ‘tipping points’ being reached”.¹ Parties including the UN Secretary General and a group of international scientists have declared that we have reached a “code red” moment when it comes to climate action.²

Yet while November 2022 saw world leaders come together in Sharm El Sheikh for the UN's climate change conference COP27, and one year on from the warning bells that were sounded at COP26 in Glasgow, very little has changed. Despite 80% of global emissions being covered by net-zero targets, warns the Carbon Trust, “they don't go far enough ... Even if all of the current national emissions reduction pledges are met, it is likely net zero by the middle of the century will be missed, and warming will exceed 1.5°C. It is therefore vital for governments to go further and revise the ambition of their national commitments, with transition plans and policies which get us to net zero by 2050.”

“ We are aiming to be net zero by 2027, ideally sooner

In fact, the UK was the first country to set 2050 as a legally binding target to be net zero. In its 2021 *Net Zero Strategy*, the UK Government said that: “The science could not be clearer: by the middle of this century the world has to reduce emissions to as close to zero as possible, with the small amount of remaining emissions absorbed through natural carbon sinks like forests, and new technologies like carbon capture. If we can achieve this, global emissions of greenhouse gases will be ‘net zero’.”

These targets will only be met if all organisations, including CITMA, move towards and achieve net zero in the near future. Companies large and small are setting their stall out, and even high-polluting industries like aviation are taking this challenge on. For example, budget airline easyJet has recently pledged to be net zero by 2050 – and if they can do it, in such a carbon-intensive sector, surely we all can. ▶



SENSE CHECK: WHAT IS NET ZERO?

Simply put, net zero refers to reaching a point where the amount of greenhouse gas you contribute to the atmosphere is equal to the amount removed.

Net zero and carbon neutral are both terms used to describe carbon reduction and they have similar results but are not the same. Being net zero is expanded in scale and includes all greenhouse gases, including methane and nitrous oxide. Another major difference is the inclusion of the wider supply chain in net zero as a mandatory element.

OUR NET-ZERO PLEDGE

We pledge that we will:

- Promote responsibility for the environment within CITMA and communicate and implement this policy at all levels.
- Be a driving force for stronger climate leadership across the trade mark profession we represent through our actions and guidance.
- Try to understand our environmental impact and set objectives and targets annually in order to improve our environmental performance. We will regularly review these targets.
- Provide adequate resources to meet our commitment to this policy and the environment.
- Define and communicate to all staff, officers and volunteers their shared and individual responsibility.
- Ensure our energy consumption and waste production is minimised using reduction, re-use and recycling methods where possible, whether employees are working in the office or from home.
- Ensure that all our activities, including events and meetings, are developed in a way that is complementary to this policy.
- Take into account the sustainability credentials of suppliers in our purchasing decisions.
- Report our environmental performance in our annual report and other relevant communications.
- Promote active and greener travel methods and provide our staff and volunteers with support to take these options where appropriate and give due consideration to whether travel is justified.
- Eliminate the need for all but essential paper for our office and events. Where paper is used we will ensure it is produced from sustainable sources and can be recycled.
- Work with and challenge our office provider to ensure it has appropriate sustainability policies in place that match our goals.
- Establish an internal taskforce to champion our environmental work.

WHY NOT OFFSET?

It is easy to think it would be simple to calculate our emissions and pay to offset these by investing in carbon mitigation elsewhere. However, it is widely accepted that this offsetting approach must be limited to residual emissions only. In other words, trying to offset the whole world's emissions by planting trees and investing in offshore wind and the like, in return for polluting at the same level, is not a sustainable strategy. Therefore, we must do our bit to reduce our carbon output, stop sending greenhouse gases into the atmosphere and only offset any final residual emissions having given our best efforts to avoid them.

Like many organisations, we are aiming to reduce our emissions across all our work and move to net-zero ways of working. This does not mean stopping everything that we do. It doesn't mean that we won't have an office. It doesn't mean that our committees cannot meet in person or that our Christmas Lunch will be downsized – far from it. But in all these areas we can work in a more sustainable way and make decisions that drive down our emissions.

We are aiming to be net zero by 2027, ideally sooner. There are four ways in which we will do this:

1. Reduce. We will seek to decarbonise everything we do. By empowering staff and volunteers to make sustainability a core pillar of our work, from procurement to how we run our events, we can reduce our carbon or other emissions to a low residual level. We will tackle head-on the emissions we directly control and influence the emissions of our supply chain by putting pressure on the suppliers who control these.

2. Offset. Although reduction and climate leadership are our main steps, we might not be able to reduce absolutely everything we do to a base of zero. Therefore, we will have an offsetting plan in place to bridge the gap where needed.

3. Report. We will make ourselves publicly accountable on our net-zero performance and will report on our sustainability and progress towards net zero in our annual report. By early 2023 we will have calculated our baseline carbon emissions



and set annual targets. We will aim to seek formal accreditation in 2027, or sooner, as a net-zero organisation and seek to maintain this indefinitely.

4. Lead. We will be a climate leader within the IP legal sector, making the case to our members and their employers that we must collectively reduce our impact on the planet and become a net-zero profession. As a sector body we have the power to influence thousands of people and have a far bigger impact than by reducing our own emissions alone.

WELL ON OUR WAY

We are not new to thinking sustainably. Since 2019, we have all but eliminated paper from our conferences. We no longer routinely print slide decks, which allows us to save thousands of sheets of paper per year.

We are changing how your copy of the *CITMA Review* is delivered, so from the March/April issue, it will

“ It is widely accepted that this offsetting approach must be limited to residual emissions only

be wrapped in easily recycled paper rather than biodegradable plastic. In fact, everything that you receive in the post from CITMA can be recycled.

We have worked with our publisher to ensure the *Review* is printed in a sustainable way using vegetable-based inks and water-based solutions in its processes. The printer also conforms to high standards requiring it to prove responsible recycling of all materials used in production.

We are now starting to consider what we can do beyond our immediate stage of the supply chain. Our thinking has now expanded to consider questions such as the sustainability of the companies that supply us and whether or not their ways of working align with our goals.

AN IMPORTANT INVITATION

Members, firms and other professional bodies – we want to work together as a profession to achieve our ambitious goals and collectively provide leadership. To this end, we will encourage firms to make a public pledge to be net zero to create accountability. You can read our own pledge on these pages (see box, opposite). We will also provide resources and a forum to



share best practice so all firms can decarbonise.

We know from our own journey that identifying where to start is not straightforward – we want to help with that starting point. But we are not here to dictate to firms exactly how to be sustainable; achieving

the goal of net zero will look different for each firm and each will have different timescales and challenges to overcome.

For those of you reading this and thinking, “Is this effort really necessary?”, we must consider the possibility that, in the future, it will be compulsory for entities above a certain size to report their emissions. Taking action now will put you ahead of the game should this happen. And even if you are not sure about the scale and scope of the environmental necessity, reducing emissions can be good for business. With more and more consumers prioritising the environmental credentials of the companies that they work with, now is the time to ensure that your firm is on a clear path in this regard. ●

1. www.carbontrust.com/news-and-events/insights/what-is-net-zero-and-why-does-it-matter. Accessed 16th November 2022
2. academic.oup.com/bioscience/advance-article/doi/10.1093/biosci/biac083/6764747?login=false. Accessed 16th November 2022.

WHY MENTORING MATTERS

Carol Nyahasha draws on her own experience to demonstrate the power of personal support in the profession





“The greatest good you can do for another is not just to share your riches but to reveal to him his own,” Benjamin Disraeli famously said. It’s a sentiment that immediately sprang to mind when I sat down to gather my thoughts about the value of mentoring in our profession.

Over the years, I have benefited from receiving mentorship from colleagues within and outside the profession who were invested in my personal and career development. Those relationships made me feel very supported, and through my mentors I was able to better understand how things worked, my place in my firm and the wider profession. As a mentee, I had people who were willing to stand beside me and provide me with career guidance whenever I needed it. This meant that as I have progressed through my career I have felt it to be essential to ‘pay it forward’, becoming a mentor in turn.

It was with this background of a positive experience as a mentee and mentor in mind that I joined the Careers in Ideas Task Force. Careers in Ideas is an IP Inclusive initiative, created to raise awareness of, and improve access to, IP sector careers whether in trade marks, patents or

general IP, in-house or in industry, or as part of a government body such as the UK IPO. Careers in Ideas volunteers produce information, resources and events for two key groups: school, college and university students who might want to join the IP professions, along with their advisers; and IP professionals doing outreach work such as career talks and open days.

In the course of our outreach work, we noticed that would-be entrants into the IP profession experience a particular lack of information and guidance due to many factors, including their socio-economic background and lack of access. To address this, I helped start up the Careers in Ideas Mentoring Scheme, with the objective of supporting talented people from groups that are under-represented in terms of ethnicity, socio-economic background and disability, or face significant barriers to employment.

The aim is not just that they can enter the IP profession, but that they will thrive in their IP career. This further serves to make our profession truly reflect and engage with broader society. As I said, I find mentoring rewarding on both a personal and professional level. Being involved in the Careers in Ideas Mentoring Scheme lifts this to another level. It is particularly heart-warming to be helping ▶

“
In the course of our outreach work, we noticed that would-be entrants into the IP profession experience a lack of information and guidance

usher in a new generation of practitioners, given that a number of our mentees are either recent graduates or in their final year of studies.

Our current contingent of volunteers includes professionals from across the IP profession – Patent and Trade Mark Attorneys, paralegals, trainees, IP solicitors and partners from law or IP departments. Charlotte Wilding, a Chartered Trade Mark Attorney and Partner at Wedlake Bell, was one of the first to volunteer when the scheme launched in 2021. Charlotte has been involved in several such schemes in both the mentor and mentee role. For example, as a mentor in the Future Frontiers scheme, she worked with disadvantaged pupils about to finish their GCSEs and looking towards the next stage of their education.

While Charlotte admits that mentoring those who are already in or wanting to enter the profession is much easier than mentoring 13- and 14-year-olds, she found Future Frontiers a great chance to encourage and support others at a critical point in their life. It also pushed her outside of her comfort zone. She considers mentoring to be an amazing process that will undoubtedly teach you about yourself, whether you take the role of mentor or mentee.

Over the years, I have found that it is not just mentees who benefit from the mentoring relationship. Mentors get the opportunity to develop their leadership and communication skills, and gain new perspectives and an



enhanced sense of meaning in their professional lives.

Being a mentor has helped me hone my interpersonal skills and general knowledge about the IP sector, making me a better mentor and hopefully a better practitioner in the process.

And I passionately believe that every time we learn something new, this fresh knowledge should come along with a sense of duty to pass that knowledge on to someone else. This is true regardless of what position you hold. Doris Akufo-Addo, Senior Trade Mark Paralegal at Stobbs IP, agrees with this.

The Careers in Ideas Mentoring Scheme was her first experience as a mentor and she has found that “there is a feel-good factor” in being a role model and supporter.

“To give back by guiding someone, sharing my wisdom and nurturing their talent is inspirational and a humbling experience,”

she says. Her recent mentee, she explains, was a go-getter with great listening skills who needed assistance on navigating their way towards a firm foothold in IP. Together, they

“ Being a mentor has helped me hone my interpersonal skills and general knowledge about the IP sector ”

figured it out, with Doris helping her mentee to reflect and strategise on how to handle contacts. The end result, according to Doris, is that she has seen her mentee blossom and become more confident.

A mentoring scheme does not need to be formal to be beneficial to its participants. Cherry Shin, a Chartered Trade Mark Attorney at Appleyard Lees LLP, has been involved in three mentoring programmes. First, an internal mentoring scheme at Appleyard Lees where she was a mentee. Second, as mentor for Careers in Ideas, and finally as a mentor in her firm’s internal buddy scheme.

Cherry thinks it is important to be open to talking about yourself and your experiences first and foremost as part of the mentoring role. “By providing an outline of the experiences we have had, mentees may be able to take comfort from the





fact that they too can speak about their thoughts. However, moving on from there, it is important for the mentee to identify the areas in which they require more guidance. There is so much information mentors can give, but it is important to be aware of what the mentee wants to learn and can benefit from.”

As a mentee, Cherry found it helpful to have her mentor check in from time to time. This made her feel like she was looked after and that the onus was not only on her to initiate opportunities to receive guidance. Having also had a mentor who made the experience more informal, she was able to see mentoring as a kind of conversation, rather than always being a strictly structured programme. Informal mentoring helps employees grow and employers retain critical talent and is a fantastic way to keep people motivated and feeling valued. For example, Cherry supports trainees at her current firm by providing them with help before their exams and by leading revision sessions outside of work hours.

If mentoring offers personal satisfaction, there’s no doubt that it also benefits our profession as a whole. Doris believes that transferring knowledge, giving back and empowering new entrants helps to grow the profile of the profession. Cherry, like me, has a particular interest in widening the diversity ▶

FIRST PERSON:

What users say about the Careers in Ideas Mentoring Scheme

“The scheme proved to be invaluable and worthwhile in every way. Particularly, it opened my understanding to the fact that relatability can create a strong bond between a mentor and mentee. Sharing experiences and lessons also takes away feelings of isolation. From the scheme, I have acquired amazing advice and developed my interview and presentation skills. I have also learned to be patient, persevere and maintain a positive outlook regardless of the challenges in my IP journey. Above all, I have learned to be confident, refuse to fall victim to social prejudices and the importance of remaining visible even beyond my comfort level.”

– LLM graduate and aspiring Chartered Trade Mark Attorney

“I would recommend the mentoring scheme as it provides practical guidance on what it realistically means to be a trade mark lawyer. My mentor helped me develop a rounded understanding of trade mark law. In providing commercial examples she improved my understanding of how trade mark law influences and guides major commercial decisions. My mentor’s friendly and down-to-earth demeanour promotes a welcome environment in which any questions can be asked. I now have a better understanding of what it takes to be a trade mark solicitor. I have also improved my understanding more generally about the industry and career as a whole.”

– Law graduate and aspiring IP solicitor

“My mentor is really thoughtful and approachable. She understands the hurdles that I face as an international candidate fresh out of university. We have been in constant contact during the past few months and our topics covered not just career planning and interview preparations, but also cultural and linguistic nuances that we have both encountered in different countries. Through our conversations, I have discovered my own unique selling points, which I may never have realised without such an initiative. She also arranged work experience for me: I gained insights into the daily life of a Trade Mark Attorney and also made friends at the firm. After the experience, I got more and more interviews and developed confidence in each, while adopting a stoic attitude towards rejections. Eventually, I managed to get my current role! I would recommend that anyone who has difficulties on their career route find a mentor with a similar background. Meaningful connections can really ignite sparks of passion and wisdom. But remember that it is down to you, the mentee, to keep driving the mentoring relationship forward. Make sure to set out from the outset how you expect it to work, and how you will monitor progress and meet relevant targets.”

– Law graduate and aspiring Trade Mark Attorney

“ Helping another person to find their own path and success is not only satisfying but also exciting

pool within the field of IP. She feels that mentoring is an opportunity to guide mentees into a trade mark career path that they may not be at all aware of. Conversely, she has also helped mentees to learn that a route may not be for them. As a paralegal, Doris also thinks that she is able to help would-be recruits see the IP profession in its entirety – as a spectrum from fee-earners to support professionals – and to demonstrate that there are many unique roles available.

By now, it will come as no surprise that I would urge all readers to consider mentoring and decision-makers to set up or encourage some form of mentoring for their staff if their firm does not already do so. But perhaps Charlotte sums it up best when she says: “Helping another person to find their own path and success is not only satisfying but also exciting. Likewise, as a mentee, I have found the process helpful in clarifying exactly what steps I needed to take to go forward – and to understand that while the best-laid plans may not always work, there are always other options. I find the role of the mentor is to take a step back and really help the mentee look at both the broader picture and the smaller details that make each step towards an end goal possible.” ●

Find out more about the Careers in Ideas Mentoring Scheme at careersinideas.org.uk or email carolcareersinideas@gmail.com

Following an indication of demand for a mentoring scheme in the recent membership survey, CITMA is actively looking at the feasibility and how best to run a mentoring scheme for CITMA members.

SETTING UP A MENTORING SCHEME: CAROL'S TOP FIVE TIPS

1 Get support from stakeholders
The Careers in Ideas Mentoring Scheme would never have been possible had it not been for the support of Andrea Brewster, Chief Executive of IP Inclusive, and the Careers in Ideas team lead Chris Burnett (Birkett Long LLP). Set your ideas and goals in a clear, concise format and make it easy for decision-makers to see the potential benefits of the scheme.

2 Be clear about your goals
You cannot be everything to everyone so focusing on a particular challenge will result in a mentoring scheme that benefits those who take part. For example, you might want to help your trainee Trade Mark Attorneys better understand their role in the firm and what is expected of them, or perhaps you want to mentor senior staff who wish to take the partnership route.

3 Get the right volunteers on board
This goes hand in hand with the last point, as your mentors need to be aligned with what you are trying to achieve for your mentees. You also need to make it clear what the time commitments will be.

4 Offer training and support to both mentors and mentees
This should be provided before the scheme starts. While there is a willingness to participate in mentorships, some participants need guidance on how to handle elements of the mentorship, for example, meetings, setting boundaries for the mentoring relationship, and how to be a good and effective mentor or mentee.

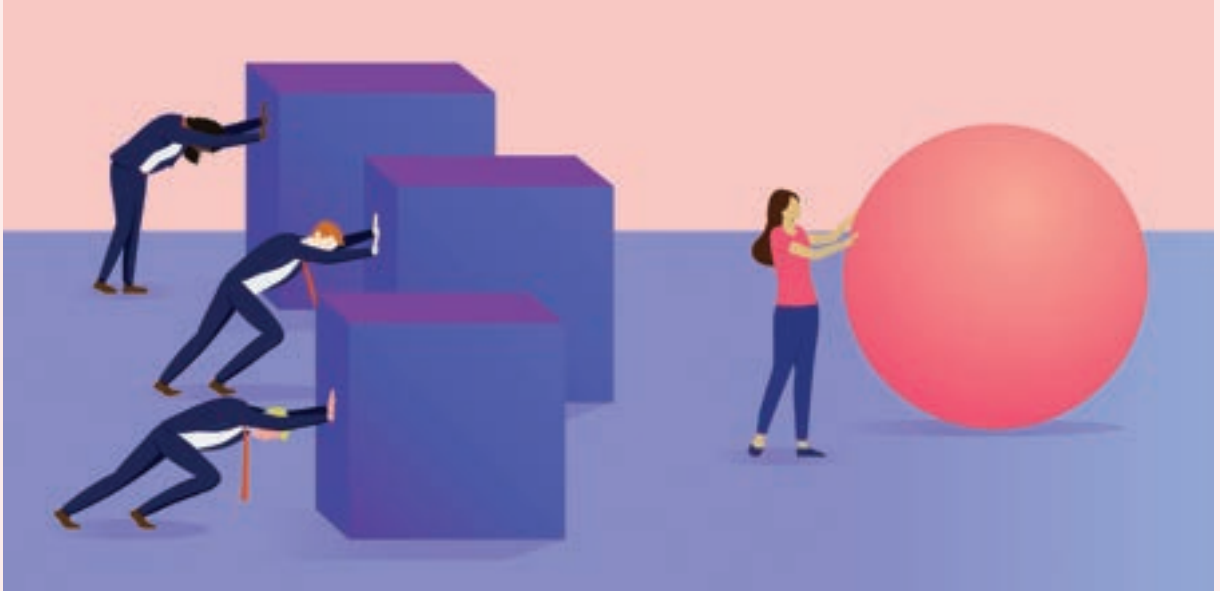
5 Support your scheme
Ensure that there is a dedicated admin function that will see through the running of the scheme, including overseeing appropriate training and matching of participants. After all, your volunteers will all have 'day jobs'. At Careers in Ideas we opted to use an online platform, which takes away a considerable proportion of the admin burden.



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MAKE YOUR WORKLOAD WORK

Work smarter, not longer, with these practical strategies to conquer your to-do list

That lawyers have a workload that just keeps coming is a truth universally acknowledged. With so many competing priorities, it can be hard to keep on top of everything, and problems with your workload can have unwelcome consequences for your mental health, your team's efficiency and client satisfaction. That's why we've gathered some practical strategies to help you approach your workload in a sustainable way.

1. Master prioritisation

Effective prioritisation can help you feel more in control. So compare tasks on your to-do list in terms of their deadlines and impact. Give priority to tasks that are both urgent and important; others can be delegated or have deadlines renegotiated. If a task is not related to your role's purpose and objectives, deprioritise it or even remove it from your list. Experiment with prioritising at least one non-client task per day or week so that these do not get neglected. Remember also that priorities are relative and will change, so assess your list daily.

2. Get comfortable delegating

Knowing what to delegate and to whom, and ensuring tasks are completed by their rightful owners, is essential to keeping your workload under control. Delegation is about distributing tasks optimally among a team according to factors such as their strengths and capacity. This means knowing your team, and what's going on with them, is essential.

3. Take back your time

To prioritise and delegate effectively, you need to create discretionary time in your diary to plan and review your work. Reflect on the elements that steal minutes from your day (meetings, interruptions, travel, procrastination) and consider how you can adapt to reduce their demands on your time. For example, start meetings at five past the hour or experiment with non-negotiable chunks of uninterrupted focus time for specific tasks.

4. Be assertive

Asking for help before an issue becomes larger is essential – it doesn't make you a "failure" or a

"bother". Be realistic about your capacity, what you can and cannot take on, as well as where you might need help. Explain yourself clearly and assertively but keep it brief and respectful. Ensure you use confident and open body language; communicate honestly what you need and listen to what the other person says in response.

5. Make time for face time

Meetings with your manager are a time to check in about workload and can normalise the subject. Are you comfortable with the deadlines you've been set? Are the right resources available? Are you satisfied with your work-life balance? Don't forget to review any implemented changes or support at subsequent check-ins to assess their impact and adapt where needed.

6. Look after yourself

Finally, taking care of your mental and physical health will ensure you are feeling your best and boost your resilience reserves. For example, regular breaks are essential to remaining productive. This will keep you performing and focusing at your best. ●



Dominic Farnsworth raises a glass to the success of a new PDO

English wines have historically been met with derision on the international stage. Our wine producers have been seen by many as eccentric hobbyists struggling to grow grapes in a climate that is just too cold to ripen grapes sufficiently. How things change. The chalk beds that are a major contributor to the quality of French Champagne stretch under the Channel before surfacing in England and this, combined with global warming, means that England is now producing award-winning fizz that more than holds its own against premium sparkling wine from around the world.

Bottles of Nyetimber, Gusbourne, Rathfinny, Chapel Down and Ridgeview are a common sight on both supermarket shelves and restaurant wine lists in the UK and, increasingly, abroad. It is somewhat telling that the Champagne houses, recognising this quality and mindful of the risks posed by climate change to their vineyards, are snapping up English vineyards. The market is in a period of high growth, with industry body WineGB reporting a 69% increase of sales of English and Welsh wines in the period from 2019 to 2021. Last year alone, 1.7 million new vines were planted.

Against this backdrop, we are beginning to see the expansion of Geographical Indications (GIs) into the UK wine market. GIs protect product names that originate from a specific place and possess qualities or a reputation based on that origin, thus guaranteeing authenticity. There are two classes of GI: Protected Designation of Origin (PDO) and Protected Geographical Indication (PGI). For fine wines, where origin is so tightly connected to quality, PDO is the desired certification, requiring that grapes come from the same area and all stages of the production process are undertaken there.

In June 2022 the Sussex Wineries group announced that the Department for Environment, Food & Rural Affairs (Defra) had granted "SUSSEX" PDO status for

still and sparkling wines produced in Sussex (the geographical area covering the combined counties of East Sussex and West Sussex), which produces approximately 25% of all UK wine. In this respect, Sussex has now joined the list of well-known and similarly protected UK PDOs including Stilton Cheese and Cornish Clotted Cream.

To qualify for this status wines will be subject to strict requirements, which for sparkling wines include: a limited geographical area in which the grapes can be grown and the wine produced; permitted varieties of grape to be used; hand harvesting; maximum yields; minimum alcohol by volume of 11%; the production method used (this must be the “traditional method”, the same as used in Champagne and Cava); and bottle-aging requirements pre-release to market. Finally, the wine needs to be tested, tasted and approved by an independent review body before it can claim PDO status.

Not all of the UK wine industry has welcomed this news. Some wineries within Sussex buy in grapes from outside the county. If they blend these into their Sussex-originated wine the blend can no longer be designated as Sussex. Meanwhile, if they bottle their Sussex-grape wine separately and use the PDO then there is a risk of a large tranche of their non-Sussex production run being regarded as somehow lesser in quality.

Reservations are not solely commercial – some go to the heart of the fundamental purpose of a GI. It is supposed to acknowledge the quality specific to the origin of a particular product, which, for wines, is linked to geographical issues of soils, altitude, aspect and drainage. Why then have the boundaries of the PDO been defined by the arbitrary administrative borders of counties that are clearly not determined by such factors? Sussex Wineries, with much support, claims the PDO is to the consumer’s benefit as the public will have confidence, relying on the PDO, that the wines can be guaranteed to come from one of England’s premium-quality production areas

A vineyard in the Sussex area, recently granted PDO status



“ Sussex has now joined the list of well-known and similarly protected UK PDOs including Stilton Cheese

and to have satisfied the stringent quality control criteria that such wines must meet.

NEW WORLD WISDOM

So what does the future hold for UK wine post-Sussex PDO? For clues, we can look to New World wine-producing areas such as the US and Australia. In the US, viticulture areas are protected as American Viticultural Areas (AVAs). Napa Valley in California is the most famous of these. Originally, the Valley as a whole was granted AVA status. Over time, as different factors have been established that differentiate one zone of the Valley from others, 16

different sub-regions within the Valley have now been granted their own AVA status. In Australia, nine viticultural sub-regions have been identified within the Margaret River region. They have not yet been formally recognised, but pressure is building.

Both of those examples pale by comparison to Burgundy in France, where centuries of monitoring the variations between different vineyards has led to 84 zones having Appellation d’Origine Contrôlée status (and within those 562 Premier Cru and 33 Grand Cru individually defined vineyards). One can therefore expect to see other UK areas, perhaps counties such as Kent and Hampshire, also applying for PDO status since they are producing high-quality wines from those same chalk beds, but are now missing out on the PR spin that Sussex can give to its wines. Beyond that, over the coming decades we can reasonably anticipate that, in common with the more developed wine regions we’ve mentioned, more tightly defined sub-zones within existing PDOs will start to emerge.

Interestingly, the smallest PDO in respect of wine is one that is limited to one vineyard. Here, England has a surprise up its sleeve. Sussex is not the first UK wine ►



The UK is the second largest wine importer in the world



“ The BWS sector will continue to provide a rich seam of interesting work to IP lawyers

in craft beer brewing (in the UK an increase from 1,489 to 2,426 breweries since 2018), with each brewer offering a range of different brands, has spawned plenty of need for IP advice in respect of searches, registration programmes and sponsorship, advertising and brand partnerships. The spirits market has been particularly dynamic. Gin distilleries in the UK grew from 710 to 820 in 2021 alone and industry intelligence is that other sectors such as rum and tequila have not yet hit their stride in terms of new product innovation. Old, established brands are not standing still either, bringing many different flavours of gins and vodkas to retailers’ shelves. Scotch Whisky is now using different “finishes” (maturing Whisky in old Sherry, Port, Bourbon and Cognac barrels to help sculpt flavour) to expand its premium ranges. Less fettered by tradition, spirits have also been the focus for radical development in bottle shape and packaging, which has led to some interesting product get-up disputes (see the report on *Au Vodka Ltd v NE10 Vodka Ltd [2022]* on page 36 of this issue).

The BWS sector will continue to provide a rich seam of interesting work to IP lawyers over the coming years, but beyond the usual cut and thrust of brand protection work, the opportunity to have a hand in the creation of future PDOs for England’s accelerating wine industry should be an intriguing and professionally rewarding challenge. ●

PDO. That honour falls to Camel Valley Vineyards in Cornwall, which in 2017 was awarded a PDO for DARNIBOLE for its wine produced using the Bacchus grape.

CROSS-BORDER COMPLEXITY

It must be noted, in relation to new PDOs, that the protection of GIs has become significantly more complex following Brexit. First, there is the issue of mutual recognition between the UK and EU of each other’s GIs. This at least is now clear, since from 1st January 2021 any GI having UK origin and EU protection is able to maintain this in the EU, under the EU-UK Trade and Cooperation Agreement. At the same time, those GIs having an EU origin continue to be recognised in the UK. However, any pending or new applications for GI status for UK products need to be submitted first through the UK process and then if successful through the EU process, should EU protection be required.

Second, there is the position as regards Northern Ireland (NI). There is a strong political and economic desire to avoid a “hard border” between NI and the Republic of Ireland and also GI-specific complications, since certain products, such as Irish Whisky, fall under a GI that encompasses both NI and the Republic of Ireland. This has resulted in NI remaining under the EU scheme, whereas England, Wales and Scotland will use the new UK process.

The PDO application for SUSSEX was made back in 2015, with Defra granting temporary approval before submitting to the EU authorities in 2016 for approval under the EU GI scheme. The application was pending as at 1st January 2021 and so reverted to Defra for consideration under the new UK GI scheme, receiving GI status some 18 months later. If Sussex Wineries wishes to extend protection of its PDO throughout the EU, then a further application will need to be made.

SUSSEX was the second UK PDO to be granted, the first being Gower Salt Marsh Lamb.

WIDER TRENDS

The UK is the second largest wine importer in the world, one of the hubs of the international wine market and a major force in product and packaging innovation and related advertising in the beer, wine and spirits (BWS) sector.

Many readers will have noticed the uptick in drink-related work over the last decade, especially as the alcohol-free product category is also in growth. The explosion



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Premier IP firm Mathys & Squire is looking to appoint a new Senior Trade Mark Partner to take a leading role in our trade marks practice.

The firm has an established and highly regarded trade mark practice which spans an enviable list of high profile clients and growing portfolios. This appointment is key to realising our ambitious growth strategy for trade marks, which will significantly expand the scale and breadth of the trade marks team.

The appointee will be pivotal in defining client acquisition strategies and play an active role in business development, mentoring trainees and attorneys, encouraging cross-departmental collaborations, and will work closely with the leadership team to ensure our procedures reflect the current and future needs of the firm and its clients.

We have several offices around the UK and have a flexible and agile approach to working patterns, therefore the appointed candidate could be based in London, Manchester, Birmingham, Cambridge or Oxford.

At Mathys & Squire, we have a thriving workplace with a friendly culture and a clear set of firm values that affirm our commitment to quality, excellence, and fairness. We are fostering a collaborative, inclusive environment and are proud of our culture which celebrates openness, as well as diversity of people, opinion, and expertise. We are looking for people who embody these beliefs and are ready to continue this journey with us.

TAKING ON THE WORLD

Adam Williams sets out the key themes that will guide the IPO's international engagement

Back in 2019, the UK IPO contributed an article to the *CITMA Review* that looked to the future for our international work and the role of our IP attaché network. Needless to say, at the time we wrote that story, we hadn't anticipated the disruption caused by a global pandemic or the need to mobilise our excellent attachés to, at times, support response efforts that ranged from procuring PPE to repatriating British nationals stuck overseas. However, we have remained undeterred in our efforts to support UK rightsholders

around the world and, despite the challenging environment, we've had many successes through our international engagement.

As we look ahead to what we can achieve in 2023, I wanted to take this opportunity to outline our priorities and share my reflections on how we can work together to have the greatest impact for UK rightsholders on the global stage.

We have a hard-earned and well-deserved reputation as a leading IP office with both UK industry and our international partners. Our goal is to use this reputation to help create an international IP

environment that maximises the benefits of innovation, creativity and science for the UK economy and wider society. To achieve this, we've set out four key themes to steer our international engagement efforts.

ONE **BOOSTING THE UK'S** **COMPETITIVENESS**

In order to maximise the benefits of the UK's IP-intensive economy, it will be vital that the IPO supports UK exporters and helps to shape international IP systems that work for UK businesses. We are helping to secure the UK's competitive

“ Please consider this an open invitation to get in touch with the IPO’s team and the attachés to share your expertise

advantage by supporting UK businesses to develop, protect and commercialise their IP in overseas markets. Last year, we updated and professionalised our business support work into the new International IP Service – a comprehensive resource ranging from country-specific IP guides right through to direct business support from our network of IP attachés.

IP enforcement is also a major part of our international efforts to improve outcomes for UK rightsholders. In delivering our IP Counter-Infringement Strategy (2022–2027) we will continue to work with partners around the world to improve IP enforcement capability. For example, in October six Brazilian Public Prosecutors came to the UK to learn how we tackle IP crime. These prosecutors returned to Brazil to expand that country’s “Operation 404” IP enforcement programme, which has already resulted in seizures of physical counterfeits and the taking down of infringing websites valued at over £50m.

TWO CONTRIBUTING TO THE UK’S TRADE AMBITIONS

Free Trade Agreements (FTAs) have become an increasingly important part of the IPO’s work. Our role is to help secure the best outcomes on IP in UK FTA negotiations. Beyond FTAs, we also continue to seek positive IP outcomes at the World Trade Organization (WTO), including at the WTO Trade-Related Aspects of IP Rights (TRIPS) Council.

At the time of writing, the UK is engaged in negotiations with a number of its priority trading partners, including Parties to the

Comprehensive and Progressive Trans-Pacific Partnership, India, Switzerland, the Gulf Cooperation Council (GCC), Mexico and Canada, with more talks on the horizon in 2023. Through these trade negotiations we aim to bring other trading partners’ standards closer towards the UK’s high standards, in order to promote and support trade, innovation, creativity and growth.

THREE BUILDING A NEW RELATIONSHIP ON IP IN EUROPE

The UK has left the EU, but not Europe. Europe will, of course, remain a major marketplace for UK products, ideas and services. The IPO is building new strategic relationships on IP with our European partners. For instance, we have already begun a programme of engagement with our bilateral partners in Europe, including meetings with Germany, Ireland and an enhanced engagement with the Swiss IP office.

In establishing our new role and relationships in Europe, I’m delighted to say that we have also recruited a new IP attaché, based in Brussels. This position will be central to progressing our network across not only the EU institutions but also the business community within the UK’s largest trading partner and with individual EU Member States.

FOUR ACTING AS A GLOBAL IP LEADER

I am very proud to say that we are widely recognised as one of the best IP offices in the world, due to the UK’s world-class IP system and the quality of our rights-granting services; and as an employer. Our ambition is to be an active, well-informed and trusted partner that leads the way in global IP fora and is open to sharing our expertise and learning from others. For example, our exchanges between

trade mark experts with China have delivered real insight into resolving the challenges of dealing with bad-faith trade mark applications, which is consistently the biggest concern for UK brand owners exporting to China.

I am also determined that we use our influence at WIPO to expand the impact of the global patent, trade mark and designs systems as well as providing convenient and cost-effective solutions for UK businesses seeking to register, manage and exploit IP rights globally. Last year we joined the WIPO Lex Judgments database, a great platform on which to showcase the UK’s excellence in IP judgments to a global audience.

OPEN INVITATION

Our network of IP attachés based in Brussels, Geneva (UN institutions), the GCC, India, South-East Asia, China, the US and Brazil are here to support UK interests in those markets. I am committed to ensuring that this work reflects the needs of UK businesses. The trade mark profession is uniquely placed to understand the challenges and opportunities for rightsholders and brand owners. Please consider this an open invitation to get in touch with the IPO’s team and the attachés to share your expertise and insights into how we can help maximise the value of export markets for UK businesses.

We have also learned that our previous business support offer was difficult to access and navigate. We want the new International IP Service to be an easy-access one-stop-shop for all potential exporters, investors and collaborators looking beyond the UK market. I would like to encourage you to promote this offer to your clients, partners and stakeholders and also consider how we can improve our impact. ●



Adam Williams

is CEO and Comptroller-General at the UK IPO



Back in the saddle

Sector norms were at the heart of a rejection, says Felicity Hide

By means of a recent decision of the Second Board of Appeal of the EUIPO, the Dior saddle bag takes its place in a long line of shape marks rejected under Article 7(1)(b) of the EU Trade Mark Regulation, in that the mark was considered inherently devoid of distinctive character.

Dior filed in 2021 to register the “saddle bag” shape shown on page 27, with goods claimed being, not surprisingly, bags, but also a range of other leather goods in class 18, and sunglasses, spectacles and cases in class 9.

By 2021 Dior’s saddle bag was well established on the luxury market. It was designed by John Galliano and launched in 1999,

and variants of the shape have been used ever since by Dior. In keeping with the prestige of the Dior mark, consumers pay a high price for one of these bags, a point that came up before the Board of Appeal (BoA).

However, to deal first with the original objection, the Examiner at first instance stated that the Dior bag wasn’t significantly different from other bags on the market and pointed out that bags come in a huge range of shapes – from rectangular to oval, long to wide, with or without a flap, with zipper or with buttons, and so on. The list given was not meant to be exhaustive but did provide an indication of the diverse market within which the Dior bag had to stand out in order to be accepted for registration. Indeed, the legal test was whether the shape was so materially different from the state of the market that it was a “significant departure from the norms” of the sector concerned. The Examiner found that the Dior bag would be perceived merely as a variant of the shapes already on the market, and not a significantly different variant.

TESTS FOR DISTINCTIVENESS

As an interim step of the appeal, the BoA’s Rapporteur pointed out to Dior several bags already on the market, also shown on page 27. Dior’s response encompassed not only the bags

found by the Rapporteur, but a range of other points, each of which was dismissed in turn by the BoA. It gave the usual tests for assessing the distinctiveness of a shape mark, namely:

- The criteria for shape marks are no different; however, the perception of the relevant public isn't necessarily the same for a shape mark.
- Consumers aren't in the habit of making assumptions on the origin of products due to their shape and so it could prove more difficult to establish distinctive character for a shape mark than for a word or figurative mark.
- Only shape marks which represent a significant departure from the norms of the relevant sector are likely to fulfil the required origin function.

Dior argued that the relevant public would pay a high degree of attention to the shape in question because this is a luxury product with a high price point. By contrast, the original examination report had stated that the consumer's degree of attention would be "average to high" and would vary according to the price level of the product. The BoA agreed and found that the relevant public couldn't be reduced to those purchasing luxury goods only: bags and leather goods (as listed in the description of goods) are found in a range of shops from supermarkets upwards, and all of those consumers must be taken into account.

NOT A SIGNIFICANT DEPARTURE

The "norms of the sector" appear to be at the heart of this case and the BoA stated that these couldn't be reduced to the most usual shapes of bags, but that all bags that consumers were used to seeing were relevant. It appears that this is where the facts of the case diverged from the Guerlain Rouge G lipstick case (T-488/20). In the Guerlain case, the market for lipsticks showed a more restricted variety of cylindrical or oblong shapes and Guerlain successfully registered its rounded lipstick case shape. However, here the BoA pointed out that for bags there were "a multitude and abundance of forms to which the public is regularly exposed" (paragraph 19). Set within this multitude, the Dior saddle bag wasn't a significant departure from the norm.

This does appear to be a rather over-inclusive view of what the norms of the sector are. Even if bags exist that are shaped, say, like penguins, that need not mean that a penguin-shaped bag is normal. The BoA seems to indicate that any bag on the market forms part of the variety of "norms" of the sector, and within that context it seems practically impossible for the Dior bag – or indeed a bag of any shape – to be a significant departure. The examples found by the Rapporteur ought not, in this writer's view,

“ It seems that the bar for securing registration for shape marks is as high as it ever was, perhaps higher

to have been fatal to the Dior case: there are examples of almost anything on the internet, but that doesn't make each and every example "normal". Only one of the Rapporteur's examples seemed to resemble the Dior shape, and it is entirely possible that it was itself inspired by the original Dior bag. Dior provided ample evidence regarding its own use of its bag, but that evidence was in relation to the secondary claim to acquired distinctiveness, and not to the norms of the market for the purpose of the absolute grounds objection.

In the context of this wide design freedom relating to bags, the BoA rejected the appeal insofar as "bags; handbags; leather pouches; leather travel cases; toilette cases and make-up cases" were concerned. For those goods, the case goes back to the Examination Division for it to consider the acquired distinctiveness secondary claim.

For the remaining goods, Dior did secure registration, and these included sunglasses, spectacles and their cases in class 9, and suitcases and other leather goods in class 18. It is interesting to note that for these accepted goods, the BoA was "not aware" of any such goods in a saddle shape (paragraphs 29 and 30). Bearing in mind the earlier observation that the BoA was "not required to provide examples of identical products on the market" (paragraph 24) it seems odd that the Board's Rapporteur actively researched bags but did not do so for the accepted leather goods.

It seems that the bar for securing registration for shape marks is as high as it ever was, perhaps higher. Within a design field where "anything is possible", it seems from this case that both "everything is normal" and "nothing is a departure from the norm".

Judgment published in French.



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KEY POINTS

- + The bar for registration of shape marks remains high
- + In design-focused sectors, it may be difficult to establish a departure from the norm

MARKS

DIOR MARK



MARKET EXAMPLES





Core of the issue

Teresa So reveals why an appeal argument attracted agreement

In a recent decision, the General Court (GC) considered whether a colour mark could be sufficiently distinctive to be registered as an EU trade mark (EUTM) for goods in classes 6, 9 and 17.

On 13th February 2019, the German electromagnetic component manufacturer Magnetec GmbH (Magnetec) filed EUTM application No. 018022608 for the colour mark (colour code RAL:5012) shown on page 29. The application was filed for: a range of alloy goods in class 6; magnetic cores, inductive components, motor cables and related goods in class 9; and insulating sheaths for the electrical wrapping of cables and insulating

sheaths for the electrical wrapping of wires in class 17.

On 26th November 2019, the EUIPO refused the application on the basis that the mark is devoid of any distinctive character under Article 7(1)(b) of Regulation 2017/1001 (EUTMR).

MAGNETEC MOVES

On 27th January 2020, Magnetec appealed the decision and filed a limitation of the goods. The EUIPO Board of Appeal (BoA) then took the following three actions:

1. The BoA dismissed Magnetec's limitation of goods as inadmissible on the ground that the limitation "blurred the boundaries" between raw materials and finished products, and therefore did not satisfy the conditions of Articles 33 and 49(1) EUTMR, which require goods and services to be identified with sufficient clarity and precision.
2. The BoA considered that the EUIPO Examiner had not taken into consideration the Applicant's request that the intrinsic distinctive character of the mark applied for be examined first.
3. The BoA found, in any event, that the claimed colour was devoid of any distinctive character for the goods covered by the application.



Consequently, the BoA dismissed the appeal and referred the case back to the Examiner to assess the existence of the distinctive character acquired through the use of the mark.

GENERAL COURT APPEAL

Magnetec appealed to the GC, relying on two pleas in law. First, infringement of Articles 33 and 49(1) EUTMR. This plea concerned the admissibility of Magnetec’s limitation of its goods, and in essence, the GC sided with Magnetec, holding that the limitation request was sufficiently clear for the purpose of Articles 33 and 49(1) EUTMR and that the BoA was wrong to consider the limitation as inadmissible.

Its second plea focused on infringement of Article 7(1)(b) EUTMR. This concerned the registrability of colour marks pursuant to Article 7(1)(b). In considering this ground of appeal, the GC reiterated the well-known principles, namely that: the distinctive character of a trade mark must be assessed first in relation to the goods or services for which registration is sought, and second in relation to the relevant public’s perception of them.

In particular, in order for a mark to be registrable, the GC asserted that: “colours or combinations of colours must fulfil three

conditions: (1) They must constitute a sign; (2) the sign must be capable of graphic representation; and (3) the sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings.”

In the BoA decision, it considered that magnetic cores in class 9 were used for electromagnetic and electrical shielding, which are special components to be inserted into larger machines or installations and would be used in a way that is not visible to the user. As such, the relevant consumer for these goods would be the specialised public throughout the EU dealing with these machines or installations, who would have a high level of professional knowledge in the electrotechnical field. The BoA took the view that this does not apply to the class 6 and 17 goods, which “would be of interest to a wider range of customers”.

The GC held that the BoA’s position that goods in classes 6 and 17 would be of interest to a wider range of customers does not make it possible, clearly and unequivocally, to establish the target audience for these products. As a result, the BoA defined the relevant public in relation to magnetic cores in class 9 only, and not for the remaining goods.

NO SWEEPING CHANGES

In coming to this conclusion, the GC reiterated that the distinctive character of a mark must – in particular – be assessed in relation to the perception of the relevant public. This is all the more so since, in the case of a colour *per se* mark, a distinctive character can only be conceived before any use in exceptional circumstances.

Since the EUIPO had failed to identify properly the relevant public for all the goods applied for, the GC upheld Magnetec’s appeal and annulled the BoA decision in its entirety. While this case does not provide sweeping changes to the assessment of registrability of colour *per se* marks, it highlights that the distinctiveness of a mark must be evaluated having regard to the average consumers of the relevant goods and/or services.

Decision available in French and German only.

KEY POINTS

- ✦ This decision reiterates that colours can be recognised as inherently distinctive and registrable in exceptional circumstances only
- ✦ While this case does not provide sweeping changes to the assessment of registrability of colour *per se* marks, it highlights that the distinctiveness of a mark must be evaluated having regard to the average consumers of the relevant goods and/or services

MARK

EUTM APPLICATION
NO. 018022608



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Baggage claim found empty

Louis Vuitton failed to bag success on acquired distinctiveness, writes Stephanie Taylor

The General Court of the European Union (GC) has upheld the EUIPO Board of Appeal's (BoA's) decision to reject the evidence filed by Louis Vuitton as insufficient in relation to its claim of acquired distinctiveness in relation to its Damier Azur pattern.

In 2008, Louis Vuitton secured registration of its Damier Azur pattern as an EU designation of its International Registration covering a range of goods in class 18. In 2015, Mr Norbert Wisniewski filed an invalidity action on absolute grounds. This was upheld by the EUIPO Cancellation Division, which held that the mark lacked distinctive character. Louis Vuitton appealed this decision and the

appeal was dismissed on the basis that the BoA found that the mark was inherently devoid of distinctive character and that Louis Vuitton had not demonstrated that the mark had acquired distinctive character through use. Louis Vuitton then appealed to the GC.

CHEQUERED HISTORY

In its decision *Louis Vuitton Malletier v EUIPO – Wisniewski* (Representation of a chequerboard pattern, T-105/19), the GC agreed with the BoA's finding that this mark (shown on page 31) did not possess inherent distinctive character. However, it also found that the BoA had not properly addressed the issue of whether the

mark had acquired distinctive character by failing to review the evidence provided by Louis Vuitton in this regard. Louis Vuitton had filed evidence to try and argue that the mark had acquired distinctive character through its use of the mark throughout the EU.

The case was remitted back to the Fifth Board of Appeal at the EUIPO, which determined that, after examining all the evidence submitted by Louis Vuitton, it had not demonstrated distinctive character acquired through the use of the chequerboard pattern and dismissed the action. Once again, Louis Vuitton appealed this finding to the GC.

However, because its evidence did not demonstrate that the mark had acquired distinctive character in Lithuania, Latvia, Slovakia, Slovenia and Bulgaria, the GC agreed with the BoA's finding that the mark had not acquired distinctive character in the EU as a whole.

As background, it is accepted case law following the Kit Kat decision¹ that in order to demonstrate that a trade mark has acquired distinctive character, an applicant is not required to file evidence of such use in each EU Member State (ie if it can be shown that due to a geographic, cultural or linguistic proximity between two Member States, the relevant public of the first has a sufficient knowledge of the products and services that are present on the national market of the second).

In this case, while Louis Vuitton submitted a small number of invoices showing sales in these territories, these were not deemed to be sufficient, with the Court commenting: "it is for the applicant to submit sufficient evidence to demonstrate the distinctive character acquired through use of the contested mark, including by selecting a sample of invoices representative of its activities throughout the European Union". Louis Vuitton had argued that it did not have stores in Estonia, Lithuania, Latvia, Slovakia, Slovenia and Bulgaria and that when assessing the overall awareness of a luxury brand by the general public, sales volume was not always proportionate to awareness. This was on the basis that due to the marketing strategy employed by the brand, the general public may be aware of the brand even if they have not made a purchase.

Furthermore, the evidence of advertising campaigns appeared to show that Louis Vuitton had targeted other Member States and it was questionable whether customers in Estonia, Lithuania, Latvia, Slovakia, Slovenia and Bulgaria would have been exposed to these advertising materials – although given that Louis Vuitton had provided evidence of circulation in Estonia of fashion magazines that carried Louis Vuitton advertising, the Court

was minded to disagree with the BoA's findings for that single territory.

The Court did criticise the BoA's dismissal of statements from experts on the basis that the wording of the statements was uniform – relying on the decision in *Combination of the colours green and yellow*, T-137/08 – and held that "the fact that those statements are identical in content does not diminish their probative value. Indeed, according to the case-law, the fact that a sworn statement was made at the request of one party and that that party may have coordinated its drafting does not, in itself, undermine its content and probative value, given that, in the absence of evidence to the contrary, it must be assumed that the signatory of the statement signed it voluntarily and takes responsibility for the content thereof."

Finally, Louis Vuitton argued that due to the geographical and cultural proximity of Latvia and Lithuania to Poland and Sweden, on the one hand, and of Bulgaria, Slovakia and Slovenia to Romania, on the other hand, the fact that the mark had been found to have acquired distinctive character in Poland, Sweden and Romania should be sufficient for a finding of distinctive character in the other territories. However, the Court held that criteria set out in Kit Kat had not been adhered to – there was no evidence to show that customers in Latvia and Lithuania had knowledge of goods for sale in Poland and Sweden, and Bulgaria, Slovakia and Slovenia, in relation to Romania. The Court also found that Louis Vuitton had not shown that they grouped those Member States in the same distribution network or that it had treated them, particularly in terms of its marketing strategy, as if they constituted one and the same market.

CONCLUSION

On balance, the Court held that the evidence provided for Estonia was sufficient to make a finding of acquired distinctiveness for this territory. However, for the remaining States, Louis Vuitton had not met this standard and therefore had not demonstrated that the mark had acquired distinctiveness throughout the EU.

1. *Société des produits Nestlé and Others v Mondelez UK Holdings & Services*, C-84/17 P, C-85/17 P and C-95/17 P

KEY POINTS

✦ The General Court has clarified the requirements for a finding of acquired distinctiveness in the EU, with reference to the Kit Kat decision

✦ Ensure that evidence filed in support of a claim of acquired distinctiveness addresses use throughout the EU as a whole and not just a substantial part of it

MARK



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Mum's the winner

A super reputation didn't impress, suggests Nawel Chemali

Unilever Global IP Ltd (Unilever) applied to register the trade mark **WONDER MUM** in class 3 on 17th December 2019 (No. 3452217). On 30th July 2020, DC Comics (Partnership) (DC) opposed this application under ss5(2)(b), 5(3) and 5(4)(a) of the Trade Marks Act 1994 (TMA), relying on its earlier EU trade mark (EUTM) No. 14275739 **WONDER WOMAN** in classes 3, 9, 16 and 41, registered in 2015.

DC stuck to the soft 300-page limit on evidence and submitted a witness statement accompanied by various exhibits in support of its opposition. Upon careful consideration of all 279 pages, the Hearing Officer (HO) held that there simply was no likelihood of

confusion between the words **WONDER MUM** on class 3 goods (such as bath, shower or hair products) and the trade mark **WONDER WOMAN**, or the eponymous fictional character for that matter. All grounds of the opposition were rejected and DC appealed.

DC appealed the HO's decision under six different grounds. The first two grounds, relating respectively to the approach to conceptual similarity and to the interdependency principle, were quickly dismissed on appeal by Mr Justice Green. The fifth ground of appeal was only to be considered if Ground 4 was successful (spoiler alert: it was not!). This leaves us with Grounds 3, 4 and 6.

REPUTATION

Considering Grounds 3 and 4, the HO found that **WONDER WOMAN** did not have reputation for comics nor for entertainment for the purposes of s5(3) TMA. Although this

“ *The HO found that **WONDER WOMAN** did not have reputation... for the purposes of s5(3)* ”

“ Making such generalised statements does not amount to actual evidence, but rather to assertion

decision can seem surprising at first, it is difficult to see how the HO could have decided otherwise given the facts of this case.

Indeed, the HO can only base a decision on the facts and evidence (or lack thereof) before it. In this case, DC had the burden to prove reputation for its mark in the UK and in the EU (as it was relying on its EUTM given the opposition was filed prior to Brexit). DC stated that: “Wonder Woman is the most famous female comic book hero in the world with nearly 80 years of continuous use since her comic book debut in December 1941.”

The following was also included in the witness statement: “Sales of WONDER WOMAN comics have generated significant revenues for DC Comics. The following are approximate figures for the worldwide revenue generated in the period 2009 to 2019 (the United Kingdom revenue figures will of course be less, but nevertheless a notable proportion of the whole)...”

If actions – or in this instance, figures – speak louder than words, DC needed to refrain from making generalised statements and provide actual numbers of comic sales in the UK and EU. Therefore, the HO, being presented with generalised statements, and finding these to be opinion evidence rather than factual evidence, failed to find that WONDER WOMAN had a reputation for comics (or any other class 16 goods). DC appealed this finding and argued no detailed figures were required as it had already indicated that UK sales were “a notable proportion of the whole”.

On appeal, Mr Justice Green agreed with the HO’s findings and added: “What notable means in this context and whether a particular proportion is notable are matters of opinion...”. Essentially, it was impossible to know what percentage of worldwide sales were attributable to the UK (including the EU) as there were no underlying figures.

Similarly, regarding reputation for entertainment, and although DC had actually provided figures to support this claim (the gross takings of its 2017 *Wonder Woman* film, and those of two other films in that period featuring Wonder Woman), the HO still found that this evidence was insufficient to prove reputation for entertainment goods and services in the UK and EU. This was because the issue here was to decide whether WONDER WOMAN was used as a trade mark or as the title of an artistic work. The HO

referred to the Dr. No case¹ and decided that the evidence was inconclusive. Mr Justice Green, agreeing with the HO’s reasoning, rejected both grounds.

PASSING OFF

In the evidence filed by DC supporting its Ground 6 claim to goodwill (consisting mainly of listings of merchandise on amazon.co.uk and a Brand Assurance Report) the HO found that many of the products did not include the words WONDER WOMAN. Furthermore, there was no information as to how many of such goods were sold in the UK. As a result, the HO concluded that as DC was relying only on its “extensive merchandising programme linked to films” and not the films themselves, there was no substance to the claim to goodwill. Consequently, the HO did not find that DC’s customers or potential customers were being misled into thinking that goods with WONDER MUM on them were commercially linked to DC.

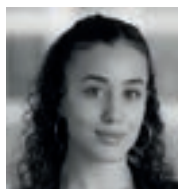
DC claimed to own “goodwill in the United Kingdom in WONDER WOMAN and the WONDER WOMAN character more generally as a result of its use in connection with a range of goods and services for an extensive merchandising programme linked to films, publications and entertainment services”. DC added that the relevant public would “know the WONDER WOMAN character and they know that those stories come from a certain source”.

Again, making such generalised statements does not amount to actual evidence, but rather to assertion, as Mr Justice Green explained on appeal. He reiterated the position of the HO that “inadequate evidence of goodwill in relation to merchandising meant that there could have been no such misrepresentation” before rejecting this final ground. Therefore, DC failed to heroically save the day and its appeal was dismissed entirely.

1. Danjaq LLC v EUIPO, T-435/05

KEY POINTS

- General statements must be backed by objective evidence or risk being considered assertion rather than evidence
- Figures provided must be relevant to the territory in which evidence is required
- Where a trade mark relates to a fictional character or a film, evidence must be directed towards proving that it indicates, to the relevant public, the commercial rather than artistic origin



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A bumper decision

Abigail Wise explains why limits and scope were driving factors in a VW case

The Claimant, Leighton Vans, had been producing and selling an altered VW Transporter van plastic bumper. The Defendant, All Seasons Leisure, began offering for sale two fibreglass versions of an altered bumper that the Claimant argued were made to its design. The Defendant accepted that the first of the two bumpers was made to the Claimant's unregistered design and was willing to cease offering it for sale. In relation to the second bumper, the Defendant disputed the design infringement and argued that the design was different in form and function, and that any similarity was a result of the shared requirement to fit the VW Transporter.

Although the Defendant was prepared to offer undertakings, these did not satisfy the Claimant. Further, the Claimant also wanted information on the Defendant's bumper manufacturers and suppliers to either pursue them as joint tortfeasors or to inform them about its designs. The Defendant resisted the disclosure, as it accepted that, to the extent infringing acts had taken place, this was its responsibility and it would answer for any losses.

The questions before the Court were therefore the terms of any injunction and whether disclosure should be ordered. Mr Justice Miles' judgment provides useful insight and guidance on the approach to scoping injunctions in design rights cases, as well as the circumstances in which the disclosure of the identity of third-party manufacturers or suppliers will be ordered.

INJUNCTION TERMS

Whether an injunction should be granted was a fairly straightforward question as, on the American Cyanamid principles,¹ there was a serious issue to be tried in relation to whether both bumpers amounted to design infringement. Damages would not be sufficient because of the potential reputational damage, and the cross-undertakings offered by the Claimant justified a short-term injunction in

relation to both bumpers. However, the bulk of the judgment turned on what the terms of the injunction should be.

The Defendant's proposal was for undertakings restricting the manufacture and use of products identical to the Claimant's design. The Claimant wanted the prevention of production, sale or use of products "incorporating the designs or any of them set out in schedule 2 to this order ('the designs') or to which the designs (or any of them) are or have been applied and/or made to the designs (or any of them) or made to any substantially similar designs to them, such articles being referred to as 'prohibited articles'."

The Defendant's proposal was too restrictive such that minor changes would release the Defendant from any liability. In contrast, the Claimant's draft injunction extended beyond the protection offered by s226(3) of the Copyright, Designs and Patents Act 1988 (CDPA). In particular, s226(3) prevents copying of a design so as to produce articles exactly or substantially to that design. The Claimant's proposal would prevent articles being made to designs substantially similar to the Claimant's design, a level of protection different from the statutory prohibition. On questioning, it was clear the Claimant did not intend this over-extension, and instead sought wording that would reflect the protection offered by s226(3) CDPA.

The Claimant's approach remained problematic as it effectively sought to prevent the Defendant from breaching the CDPA. The Court is generally unwilling to grant injunctions preventing unlawful activity as it does not sufficiently enable the Defendant to work out what it can and can't do.² Compounding this problem is that any question of a breach would require an analysis of whether there had been infringement under s226(3).

Suggestions that the Defendant should obtain consent from the Claimant in scenarios where it thinks its activities may be infringing did not solve the uncertainty, as it would give the Claimant an effective veto and would allow it to decide what the Defendant should and should not be allowed to do.

Ultimately, the Court granted a short-term injunction to prevent the Defendant from making and selling the two sets of alleged infringements

that had been identified. Miles J noted that if the Defendant sought to avoid the injunction by making further changes to its bumper designs, the Claimant would be able to return to the court and expand the injunctive relief.

DISCLOSURE

On the issue of disclosure of the identity of manufacturers and suppliers of the Defendant's products, the question was whether this was necessary. The consideration of necessity derives from the Norwich Pharmacal principles.³ Counsel for the Defendant noted these principles were summarised recently in *Orb ARL v Fiddler*⁴ by Popplewell J, who stated that necessity was a threshold condition for making a Norwich Pharmacal disclosure order. A disclosure order can only be made if it is a necessary and proportionate response in all the circumstances.

The Claimant wanted all parties related to the manufacture of the bumpers to be disclosed. It wasn't clear that there would be any real prejudice to the Defendant or third parties if this information were provided, nor would the disclosure involve a breach of confidence. However, as there was no reason to doubt the moulds the Defendant had obtained had been destroyed and the Defendant had accepted it would be primarily liable to the extent infringing acts had taken place, there was no necessity for a disclosure order. Miles J was also concerned that the Claimant's desire to protect its IP rights was disproportionate. As a result, Miles J refused to make a disclosure order.

This case reiterates that the terms of an injunction should spell out exactly what actions would constitute a breach. Should a defendant attempt to get around any specific terms, there is an option to return to court and seek to expand the scope. The Court will not make a generally worded injunction ordering defendants to cease engaging in infringing conduct.

The case also confirms that the Court will only grant a disclosure order about the identity of third parties involved in infringing activities if it is necessary, as opposed to merely being desirable.

1. *American Cyanamid v Ethicon* [1975] RPC 513 HL
2. See *Biro Swan Limited v Tallon Limited* [1961] RPC 326
3. *Norwich Pharmacal Co v Customs and Excise Commissioners* [1974] AC 133, HL
4. [2016] EWHC 361 (Comm)

KEY POINTS

- + This case provides useful practical guidance to IP practitioners on the scope and terms of potential injunctions in design rights cases
- + The Court will not make a generally worded injunction ordering a defendant to cease engaging in infringing conduct
- + The Court will only grant a disclosure order about the identity of third parties involved in infringing activities if it is necessary, not merely desirable



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Get-up case goes forward

Claudine Sheers lays out the first steps in an expedited action

On 2nd September 2022 AU Vodka Ltd (the Claimant) applied for an interim injunction against NE10 Vodka Ltd (the first Defendant) and Leon Hogan (the second Defendant) in respect of the launch of a new vodka called NE10. The Claimant's application was based on alleged passing off by the Defendants of the Claimant's get-up of its vodka bottles, owing to the presentation of the NE10 product.

In a decision dated 21st September, Mr Justice Mellor denied the Claimant's application for an interim injunction. In addition, the allegations that the second Defendant was primarily liable were struck out, although the Judge declined to strike out the allegations of joint liability. The Judge

instructed the trial to be expedited and it is likely to take place at the beginning of 2023.

BACKGROUND

The Claimant launched its vodka under the Au⁷⁹ brand in 2015. The Claimant sells a range of vodkas of different flavours under the brand, each sold in a tall, slim bottle finished in metallic gold. The bottle includes a square label containing the Au⁷⁹ mark and a smaller label near the bottom of the front of the bottle.

The first Defendant launched its vodka brand NE10 on 22nd August 2022. Its product range consists of three vodka bottles in various metallic colours, namely pink, blue and silver. The colour varies depending on the flavour of the vodka contained inside. The NE10 bottle

has a tall, thin profile, and at the top of the bottle is a shield-shaped plate containing the words “NE10 VODKA”. Nearer the base of the bottle, a rectangular plate shows the flavour of the vodka.

The Claimant made a number of allegations in pre-action correspondence concerning the branding and appearance of the first Defendant’s product and the second Defendant’s involvement. The second Defendant was (at the time the claim was issued) the sole director of the first Defendant and its majority shareholder. The Claimant issued its claim and application for an interim injunction on 2nd September 2022, relying solely on passing off in respect of the get-up of the Claimant’s product.

DECISION

Counsel for each party referred the Judge to the principles set out in *American Cyanamid*,¹ namely: whether there is a serious question to be tried; whether damages would be an adequate remedy for either party, and if not, where does the balance of convenience lie? The Judge noted that although the *American Cyanamid* principles are intended to avoid the need for the Judge to conduct a “mini-trial” on the merits, authorities recognise that in passing off cases it is “frequently necessary to form a view as to the strength of the claimant’s claim in order to understand the scale of any likely damage”.²

The Judge was satisfied that the Claimant had a reputation subsisting in the appearance of its products and that there was a serious issue to be tried as to where that reputation resides. This was a matter for trial, but the Judge considered it necessary to form some view to assess whether damages might be an adequate remedy if no injunction were granted. He reviewed the manner in which the get-up was pleaded by the Claimant. The Judge noted that the Claimant’s evidence suggested the Claimant’s labelling is being noticed, since consumers refer to it as “Au Vodka”. As regards misrepresentation, the Judge was not persuaded that any of the evidence submitted demonstrated actual deception. However, he noted that the evidence at trial could provide a different result.

As to whether damages would be an adequate remedy for the Claimant, in light

of the Judge ordering an expedited trial, he was satisfied that damages and an injunction at trial would suffice if the Defendants were found liable. In contrast, as to whether or not damages would be an adequate remedy for the Defendants in the case of an injunction being incorrectly granted, the Judge agreed that an injunction would “kick the legs out” from underneath the Defendants after their successful launch. As regards the status quo, the Judge concluded that the chronology of events appears not to favour either side. Therefore, the Judge concluded that the balance of convenience favoured denying the application for an injunction.

Finally, the Judge dealt with the second Defendant’s application to have the case against him struck out. The Judge found that the second Defendant had not committed any of the acts that may give rise to liability personally, and as such the claim that he was personally liable was struck out. As regards the alleged joint liability of the second Defendant, the Judge was satisfied that the allegations were sustainable in law. He noted, however, that the particulars of his liability were likely to be required to be supplemented in due course.

This case is a reminder that passing off and trade mark claims will necessarily require an examination of the merits of the claim where a court is asked to grant an interim injunction. Although the principles in *American Cyanamid* seek in part to avoid this, the peculiarities of these cases make it difficult, if not impossible, to consider the adequacy of damages without doing so.

As the Judge noted, passing off claims based on get-up alone are rare. He proceeded on the basis that consumers tend not to rely on the shape and appearance of products alone, although he was clear that evidence at trial may be capable of overturning that general proposition. In addition, the fact that the Defendants have managed to defeat an application for an interim injunction should not give them comfort that they will necessarily win at trial, as much will turn on the evidence available at the time of the proceedings.

1. *American Cyanamid Co (No 1) v Ethicon Ltd* [1975] UKHL 1 (5th February 1975)
2. *Novatis v Hospira* [2013] EWCA Civ 583

KEY POINT

- ✦ Passing off and trade mark claims will necessarily require an examination of the merits of the claim where a court is asked to grant an interim injunction

BOTTLE EXAMPLES



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Hip, hip, hooray

A family polo business has cause to celebrate, reports Luke Franks

The world of Polo has throughout its history spawned a fashion culture, through which companies that design and produce polo sportswear branch out into highly fashionable casual wear to be worn by the average person. One of the latest trade mark skirmishes between companies involved in this sector concerns Lifestyle Equities CV, proprietor of the Beverly Hills Polo Club brand, which opposed registration of the Hipwood Polo brand, as used by a famous British polo-playing family.

A BRIEF HISTORY

On 3rd February 2021, Nicola Blakely filed a UK trade mark application for the Hipwood family's figurative mark (shown on page 40), which features on their polo equipment, including items such as saddle cloths. The classes covered by the trade mark application included 9, 16, 18, 21, 25, 28, 35

and 41, with such goods specified as polo helmets, technical polo-wear, polo mallets and polo saddles.

Following the publication of the trade mark application on 30th April 2021, Lifestyles Equities CV filed an opposition based on three grounds:

- Section 5(2)(b) of the Trade Marks Act 1994 (TMA) – a trade mark shall not be registered if, because it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier mark.
- Section 5(3) TMA – a trade mark that is identical with or similar to an earlier trade mark shall not be registered if, or to the extent that, the earlier trade mark has a



reputation in the UK and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark; and

- Section 5(4)(a) TMA – a trade mark shall not be registered if, or to the extent that, its use in the UK is liable to be prevented by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade where the rights to the unregistered trade mark or other sign were acquired prior to the date of application for registration of the trade mark or date of the priority claimed for that application.

Sections 5(2)(b) and 5(3) relied on the earlier mark UK00915737653, which covered among other things clothing, polo-shirts, belts and footwear. Under s5(4)(a) the Opponent claimed its earlier mark had been in use in the UK since 1982.

UK IPO DECISION

The Hearing Officer (HO) found that the Applicant's class 25 goods, polo technical-wear, were identical to the Opponent's goods of "clothing". It was also found highly similar to the Opponent's casual

“ Overall, there was no aural similarity, a medium degree of visual similarity and a low degree of conceptual similarity found between the two marks

clothing because both have a similarity in physical nature, purpose (to clothe the body) and methods of use. The Registry also commented that it would consider non-technical polo-wear also to be covered by the Opponent's goods of "clothing".

The finding that "polo technical-wear" was covered by the Opponent's clothing led to the conclusion that class 28 goods "polo balls" and "polo mallets" had a low degree of similarity; class 28 "protective knee pads" were of a medium to high similarity; and class 9 "polo helmets" were of a medium to high similarity to the Opponent's "clothing".

On comparing the marks the Registry found that the element of a polo player on horseback and the second element – the words BEVERLY HILLS POLO CLUB – contributed roughly equally to the overall impression of the Opponent's mark.

The Registry found that the elements of a polo player on horseback and the element of the words "Hipwood Polo" contributed roughly equally to the overall impression of the Applicant's mark.

The comparison of marks keenly pivoted around the conceptual similarity between them. The Opponent's mark was viewed to invoke the idea of a polo club in the famous Beverly Hills area of Los Angeles, California, whereas "Hipwood" in the Applicant's mark would be perceived firstly as a surname. The Registry considered that Hipwood Polo would therefore either be perceived as a polo business owned or run by a family or individual with the surname Hipwood or as a polo business or club located in a place called Hipwood. The Registry did not identify Hipwood as being a place and in any case it did not consider Hipwood Polo would be perceived as a polo club located in Beverly Hills, California.

Overall, there was no aural similarity, a medium degree of visual similarity and a low degree of conceptual similarity found between the two marks.

The Registry considered the distinctive character of the Opponent's mark as a prelude to determining the likelihood of confusion. Regarding distinctive character, the Opponent's earlier mark was found to

“ Most of the evidence filed was too generalised towards the Opponent’s use of the earlier mark on clothing in general

have no inherent distinctiveness in relation to technical polo-wear. The device element, a polo player on horseback, invokes the idea of the sport of polo, and the word element was found to have an average level of distinctiveness as it extended to a particular polo club. However, in relation to casual wear the earlier mark was found to have an above-average degree of distinction, since casual clothing is not intended to be worn in polo games. In addition, the Opponent filed substantial evidence, including EU and UK sales figures from 2006 to 2021 showing consistent sales in clothing year-on-year. The evidence was acknowledged to be general and non-specific in nature, which meant the evidence did not support the claim that there was inherent distinctiveness for the earlier mark in technical polo-wear through use.

In the determining likelihood of confusion the Registry applied the usual interdependency principle whereby a lesser degree of similarity between the goods and services may be offset by a greater similarity between the marks and vice versa. It applied the principle that the more distinctive the earlier mark, the greater the likelihood of confusion, and factored in imperfect recollection to find that there was no likelihood of confusion between the marks for any of the goods or services.

The Registry did not consider that the average consumer would perceive the similarities between the marks as meaning the goods and services came from the same undertaking, because: (i) the common element Polo was not “so strikingly distinctive” for any of the relevant goods and services which directly relate to the game of polo; (ii) the later mark did not simply add a nondistinctive element of the earlier mark; and (iii) a



changeover from the place name Beverly Hills to the place name/surname Hipwood appeared to be far from entirely logical and consistent with a brand extension of the earlier mark.

Therefore, the grounds under s5(2)(b) failed. The opposition under s5(3) failed as no link could be found to argue the two marks would be mistaken for one another by the average consumer. The opposition under s5(4)(a) failed upon the same reasoning as s5(2)(b).

COVERAGE NEEDED

A key takeaway from this case is to ensure that the evidence filed to support that a client’s earlier mark is inherently distinctive specifically covers all the goods and services. The Opponent in this case failed to file evidence that supported the idea that technical polo-wear had an inherent distinctiveness through use of the earlier mark. Most of the evidence filed was too generalised towards the Opponent’s use of the earlier mark on clothing in general. This functioned as a disadvantage because the Applicant’s mark covered technical polo-wear more than casual clothing.

Nevertheless, the position ultimately failed because the Registry did not consider that there was any likelihood of confusion on the basis of the actual marks.

As an interesting additional point, the costs awarded were: £300 in regards to preparing a counterstatement and “considering other side distinctive case”; £800 in relation to finding and concealing evidence; £400 in relation to written submissions. The Applicant is a qualified solicitor and attempted to claim for both her fees and the fees incurred to take advice from a KC. The Registry agreed with the Opponent in rejecting the Applicant’s attempts to claim reward for her costs in that regard, being effectively a litigant-in-person acting on her own behalf.



Luke Franks

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KEY POINTS

- ★ A comparison of the two marks found there to be a low to medium degree of similarity
- ★ The main similarity found in the goods was broken down into technical polo-wear and non-technical polo-wear (casual clothing)
- ★ The evidence filed by the Opponent was insufficient and too generalised to support that the earlier mark had inherent distinctiveness through use

MARKS

OPPONENT’S MARK



APPLICANT’S MARK





Our Spring Conference will centre on Strategies for Success. Learn more at citma.org.uk/events

Calendar

Our upcoming events for members and other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
12th January	CITMA Webinar Managing stress in the workplace	Online	1
19th January	CITMA Webinar Lessons from the Only Fools & Horses case	Online	1
24th January	CITMA Seminar IP infringement online	Online	2
26th January	IP Inclusive event Unconscious bias: A Scotland network coffee date	Hybrid	1
30th January	IP Inclusive event (Office) space: The final frontier?	Online	1
6th February	IP Inclusive event Menopause matters	Online	
8th February	CITMA Webinar Software and technology due diligence	Online	1
16th March	CITMA Spring Conference Strategies for Success	The Waldorf Hilton, London WC2	5
18th April	CITMA Edinburgh Quiz	Le Monde Hotel, Edinburgh EH2	
20th April	CITMA Webinar ADR disputes	Online	1

THE TRADE MARK 20

Q&A



Kate O'Rourke

I am... a Partner, Head of the Trade Mark Practice Group and a member of the Management Board at Mewburn Ellis LLP.

Before this role... I worked in general law firms in the UK for many years, but I started my career at FB Rice in Sydney, Australia. I also briefly worked in-house at the Ministry of Sound nightclub, which was an *interesting* experience.

My current state of mind is... excited, as I've just booked a holiday to Egypt. I've dreamed of seeing the pyramids ever since I did a project on Tutankhamun in primary school.

I became interested in IP... when I was at university and took a part-time job as a trade mark searcher, which in those days involved looking at microfiche! Searchers from all the different firms met at the IPO sub-office in Sydney and I realised that IP attracted the most fun and fascinating people.

I am most inspired by... people fighting against climate change, which is threatening the way we live and the future of the planet.

In my role, I most enjoy... training and encouraging the new people joining the profession and nurturing the careers of the people with whom I work.

In my role, I most dislike... interminable video calls.



“
*I realised that IP
attracted the
most fun and
fascinating people*”

On my desk is... a photo of my son Ben at his graduation, with me as his very proud mum.

My favourite mug... has a picture of a kookaburra on it.

My favourite place to visit on business is... Sydney, as I can also catch up with family and old friends.

If I were a brand, I would be... The British Museum. I love history and learning about different cultures. (I would probably send many exhibits back to where they came from.)

The biggest challenge for IP is... to make sure that all representatives at the UK IPO are properly qualified and regulated so that our well-deserved reputation for an excellent IP system is not undermined.

The talent I wish I had is... being able to sing. I'm reliably told that listening to me sing is torture.

I can't live without... the news. I'm constantly checking on what is happening around the world.

My ideal day would include... a visit to Tate Modern, which has great food and a fabulous view, as well as stunning art.

In my pocket is... nothing. I prefer to use a bag.

The best piece of advice I've been given is... never underestimate yourself, particularly as a woman.

When I want to relax, I... go to a gallery or a museum, or for a long walk.

In the next five years, I hope to... see greater diversity in the IP profession at all levels of practice.

The best thing about being a member of CITMA is... the opportunity to work with so many inspirational people who strive to continually improve the work and skills of the IP profession in the UK and who encourage people to thrive.



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info@ip-support.co.uk

Our current vacancies include:

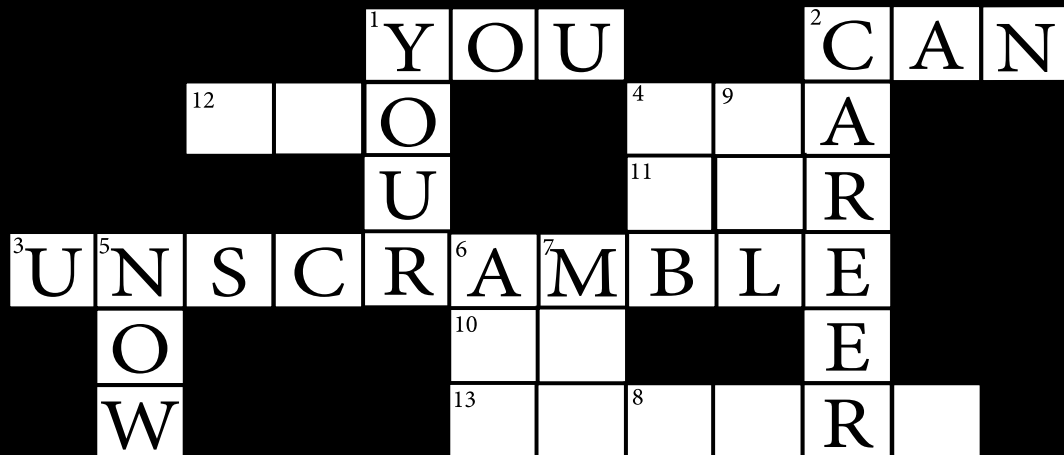
Supervising Trade Mark Attorney – London/Hybrid

Senior Soft IP Associate – London/Hybrid

Senior Trade Mark Administrator – Fully Remote

Trade Mark Project Assistant – Fully Remote

Trade Mark Renewals Assistant – London/Hybrid



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LIVERPOOL**

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