

CITMA REVIEW

ISSUE 438

DECEMBER 2017/JANUARY 2018

Inside

CHECK YOUR
PRIVILEGE **p12**

UNDERSTANDING THE
IMPOSTER SYNDROME **p16**

MEET THE UK IPO'S
NEW CEO **p18**



1^{to} Remember

We reflect on our first full year
as a Chartered profession



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As we approach the end of 2017, I am delighted that we can reflect on our first year as a Chartered profession.

I hope our review of CITMA's first year inside this issue brings back many positive memories for you (page 8).

Our social media-themed Autumn Conference brought together excellent speakers from across, and outside, our profession. The report on page 6 provides insight into some of the key takeaway points.

We are delighted to have the thoughts of the IPO's newest CEO, Tim Moss (page 18), and Jo Maughan's advice on fighting the Imposter Syndrome keeps the importance of inclusion in the profession at top of mind (page 16).

We also hear about celebrity children and their trade mark registrations from George Sevier (page 24), while Aaron Wood assesses recent litigant-in-person appearances (page 22).

I hope you enjoy a relaxing festive break and would like to take this opportunity to wish you a happy 2018.

Kate O'Rourke
CITMA President

Inside this issue

Regulars

- 4 CITMA Insider** New industry appointments abound, a reader book review and a renewal reminder
- 49 Events** What's coming up in 2018
- 50 TM20** Amelie Gerard reveals her continental side

Features

- 6 Autumn Conference** Speakers addressed the interaction of social media and IP law
- 8 CITMA celebrates** Richard Hayward looks back on one wonderful year since CITMA became Chartered
- 12 Privilege** The cloak of privilege is becoming threadbare, says Jane Jarman. Is there a solution?
- 16 Wellbeing** Jo Maughan advises on fighting the Imposter Syndrome
- 18 Interview** The UK IPO's newest CEO speaks about the outlook for IP in the UK
- 22 Litigation** Aaron Wood's most recent assessment of litigant-in-person appearances
- 24 TM trends** George Sevier surveys the celebrity trendsetters trade marking the next generation
- 26 Designs** Jade MacIntyre dissects the four designs decisions that made a difference in 2017
- 30 Neptune** John Coldham confirms how the High Court has cleared up "aspects" of design law in a recent case

Case comments

- 32 O/407/17** Rosalyn Newsome takes a cool view on KOMPACT
- 33 O/376/17** Alex Woolgar reviews a camp-related conflict
- 34 O/383/17** Oliver Tidman outlines a case concerning indications of origin
- 35 O/394/17** A gesture of peace provoked hostility, says Richard May
- 36 O/429/17** SIMCITY was blocked, as Chris Morris reports
- 37 O/434/17** Rebecca O'Kelly-Gillard suggests the court may have split hairs
- 40 O/428/17** Evidence of use didn't take root with the Registrar, writes Chris Hoole
- 41 O/427/17** Dale Carter explains why the Applicant was behind the curve
- 42 O/419/17** Teresa So unpacks a FIDELITY failure
- 43 O/436/17** Mail mark was stopped, writes Carrie Bradley
- 44 O/437/17** Loren Ravenscroft on why the HO stopped use of a PDO
- 45 C-56/16 P** Sarah Talland on the last dregs of a Port battle
- 46 C-673/15 P; C-676/15 P** Jackie Mullen distils the essence of Darjeeling actions
- 47 T-305/16** Lara Elder on why a Primark slogan prevailed
- 48 T-586/15** Emmy Hunt describes a somewhat surprising result

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Published on behalf of CITMA by:
Think, Capital House,
25 Chapel Street, London NW1 5DH
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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
The views expressed in the articles

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CITMA | INSIDER

New CIPA leaders elected

CITMA looks forward to working with Stephen Jones and Julia Florence



STEPHEN JONES has been elected President of CIPA, succeeding Tony Rollins. Stephen, also a member of CITMA, took over the role following CIPA's AGM in October. Julia Florence, a Senior Patent Counsel at GSK, was elected Vice-President.

CITMA President Kate O'Rourke congratulated both Stephen and Julia (pictured above) on the new

positions, saying: "With challenges on the horizon, collaboration between CITMA, CIPA and the rest of the legal profession has perhaps never been more important.

"I also look forward to working closely with them both to build on joint initiatives including IP Pro Bono and IP Inclusive, and to develop new projects."

Campinos is new EPO President

Executive Director of EUIPO António Campinos has been elected President of the EPO. His five-year term of office in the new role starts on 1st July 2018.

Mr Campinos will succeed Benoît Battistelli, who has been the EPO's President since 2010 – the same year that Mr Campinos started at EUIPO, based in Alicante.

A former President of the Portuguese Institute of Industrial Property, Mr Campinos was the Portuguese representative on the Administrative Council of the EPO for a number of years before joining EUIPO.

CITMA President Kate O'Rourke said: "We wish Mr Campinos every success at the EPO. He has led and developed the EU trade mark system with passion and authority over the past few years, and we would like to thank him for his work.

"We would also like to demonstrate our gratitude for his continued support of CITMA and the UK Chartered Trade Mark Attorney profession throughout his tenure."



Renewal reminder

All CITMA members should now have received their invitation to renew their CITMA membership

for 2018. We hope that you will act promptly to secure your membership and access to its benefits for the next year. If you have any questions about your subscription, benefits or the renewal process, please contact Luke O'Neill at luke@citma.org.uk



New CITMA publication

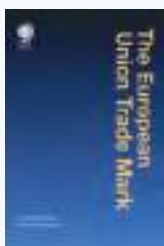
We are delighted to announce the publication of *Anti-Counterfeiting: Practice and Procedure* by Ralph Wehrle of Briffa.

The new publication is the only detailed guide to practice and procedure for trade mark practitioners in relation to anti-counterfeiting currently available. It is available to purchase now at citma.org.uk/shop

Member *move*



Chris Morris, previously of Burges Salmon, has rejoined Haseltine Lake LLP as an Associate Partner. Chris can be contacted at cmorris@haseltinelake.com



Reader book review

Mark Caddle finds a European guide simple yet effective

Mark Holah and Patricia Collis
The European Union Trade Mark: A Practical Guide, first edition, Globe Law and Business
361 pages, hardback, £175
Also available in other formats

THE EU trade mark (EUTM) – or Community trade mark, if you have not yet managed to shake off that old moniker – system underwent fundamental change in 2016. This provided an opportune time for a detailed outline of the system and its workings, as well as commentary on its change. Mark Holah and Patricia Collis, both of Bird & Bird's Brand Management group, grasped the opportunity to do so in *The European Union Trade Mark: A Practical Guide*.

The book certainly lives up to its title, giving a detailed account of the EUTM system and its quirks, with the overarching aim of practicality and utility. With an extremely useful glossary and an easily navigable layout, this is a must-have for any trade mark practitioner, particularly those who are encountering the EUTM for the first time.

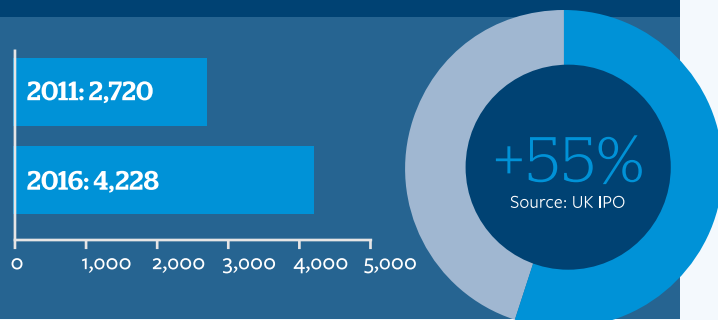
Its simplicity and ease of access make the book both penetrable and enlightening. A special mention must also be made of its treatment of the history of the EUTM and its underpinning rationale, which provides a gentle introduction to non-EU practitioners less familiar with the EU and its unique framework. Without the weight and in-depth analysis of some of its contemporaries, this book could become a permanent fixture on many a practitioner's desk in times to come.

Q Spotlight statistics

Fintech boosts UK filings

The number of trade marks registered by financial services firms rose to a record high in 2016, at 4,228. Commenting on the recent rise, a spokesperson for professional services firm RPC said that investment in fintech is the catalyst: "The use of trade marks in financial services is popular due to the relative ease with which financial products can become commoditised by the launch of 'me too' products by competitors."

Financial services TM registration - rising wave



Top 10: world's strongest nation brands

- | | |
|------------------------|---------------|
| 1 Singapore | 6 Finland |
| 2 Switzerland | 7 New Zealand |
| 3 United Arab Emirates | 8 Sweden |
| 4 Hong Kong | 9 Norway |
| 5 Netherlands | 10 UK |

Source: Brand Finance, *Nation Brands 2017* (October 2017). Brand Finance measures the strength and value of the nation brands of 100 leading countries, using a method based on the royalty relief mechanism employed to value the world's largest companies.



We set our sights on social media

At CITMA's Autumn Conference, an exciting range of speakers educated us on the interaction between social media and IP law. Here are some selected highlights

Social media provides plenty of opportunities for brands to promote themselves, but counterfeiters have exactly the same platform and opportunity, and are making it increasingly difficult for customers to tell which products are fake and which are real. How do you know where and when this is happening? Helen Saunders, Head of Intelligence and Operations at internet monitoring company INCOPRO, shared her insight.

Saunders began by outlining the shape of the social media ecosystem, which is essentially made up of:

- micro-blogging and content-sharing sites such as Twitter and Instagram;
- social networking sites such as Facebook; and
- messaging apps such as WhatsApp and Snapchat.

While social media is dominated by the large global platforms, there are also other notable players, such as VKontakte, a predominantly Russian platform. In South-east Asia, messaging apps such as WeChat, LINE and Kakao Talk are driving social interactions online.

Brands use all of these channels to market themselves, either through their own organic posts or via paid advertising. Acknowledging the opportunity for brand/user interaction, many social media sites have created new ways for brands to undertake commercial activities, such as enabling payments through the sites/apps or creating platforms specifically to sell products. However, as quickly as brands move onto these platforms, counterfeiters follow suit.



ADS AT ISSUE

Targeted ads on social media are a particularly big issue, as counterfeiters target their knock-off goods to run alongside the real thing. The highly customisable nature of these campaigns means that brands and counterfeiters alike can find the exact audience they want to reach and promote themselves based on demographics, interests and other characteristics. This poses challenges for finding infringement, as no two users have the same social media experience.

In China, the WeChat app allows users to share content and make transactions. Around 300 million of its users have enabled its payment solution, WePay, making it a highly attractive method by which to sell products. Consequently, 92 per cent of global luxury brands use it to market their products.

▲
Helen Saunders shared her insight on the social media ecosystem with an attentive audience

CITMA and its members took to Twitter to share thoughts on the event



Counterfeiters are using the same opportunity to drive their business. Their stock can be viewed on “WeChat Moments”, often driven by posts on other social media platforms, such as Instagram. It’s an easy process for consumers – they simply email the counterfeiter for prices and to arrange shipping, and transfer the money via WeChat Pay. The transaction is largely hidden from public view, making it difficult to disrupt.

Even when social media platforms don’t facilitate financial transactions for goods directly, counterfeiters use these sites to drive traffic to their domains, where potential customers can then buy the product.

Hashtag abuse is key to driving traffic to posts, and then onto other social media platforms or online spaces. Critically, counterfeiters will rarely use just one site to sell their products; instead, they will have multiple domains and accounts at their disposal, making it far more difficult to track the counterfeit seller back to the source, and making them more resilient to takedowns.

MONITORING MOVES

To tackle this issue, brands now need to ensure they monitor their entire social media presence, as well as offending domains. Counterfeit sellers will often have back-up website addresses, and use social media to tell their “fan base” about a new site as soon as the old one is taken down, meaning they will be ready to sell fake merchandise again within hours. Therefore, an indiscriminate “whack-a-mole” approach to eliminating counterfeiters can be endless and ultimately pointless.

If, however, brands take a holistic approach, they can use the links between social media accounts, counterfeit websites and marketplaces to take down the counterfeiter’s whole network. Correlating common contact information between accounts, for example, can allow a brand to identify the commercial epicentre of a network and cease a host of offending accounts all at once. To do this, brands must monitor marketplaces, app stores, website operations and social media in conjunction with one another to ensure that they are not just cutting off one branch of a multi-branch operation. ■

When to act? Our speakers answer

What action can and should you take when your brand is being infringed online, and when is it right to act? Those were the questions answered by Catherine Wiseman (Barker Brettell) and Azhar Sadique (Keltie)

Approaches such as cease-and-desist letters can lead to negative publicity, said Wiseman, so: “We need to take a step back sometimes and think: ‘Is that really the right approach to achieve our desired outcome?’ Most social media sites tell you that takedown action should be used as a last resort, and suggest that you contact the infringer first.”

She went on to suggest engaging with an infringer through the sites’ messaging facilities, “as many infringements on social media result from naivety or a lack of knowledge

about IP, and a little education is all that is needed”.

Of course, there are many options available to brands and their Chartered Trade Mark Attorneys, including the social media site’s takedown facility

and litigation. Sadique (pictured) looked at which action should be taken first.

One of his key tips was to consider all options and the fallout from each in terms of both social media response and PR.

He suggested creating social media-specific guidelines and policies with a client in order to define in advance of an issue what actions the Attorney will be authorised to take.

“It’s about getting a game plan together: deciding what is manageable, what we can achieve and what the client can achieve. Clients won’t have bottomless pockets. We need to be creative – as creative as the infringers.”



1 wonderful year

To mark the first anniversary of our Royal Charter, Richard Hayward reflects on how we reached this landmark

The passing of the first anniversary of our Royal Charter provides the perfect chance to reflect on what has been a memorable year for the profession.

After the Privy Council agreed to grant ITMA a Royal Charter in spring 2016 at a meeting at Windsor Castle, the wheels were fully in motion leading up to the launch of CITMA on 24th November 2016.

But perhaps it wasn't until the big red box that proudly displays our Royal Charter was on view at our London Christmas Lunch last December that the achievement and realisation that we are now a Chartered profession sank in.

The Charter document itself is a work of art, beautifully illuminated by the talented Timothy Noad. It was formally presented to CITMA by the Windsor Herald at a ceremony on 23rd November 2016, the day before the official launch).

However, our heritage as an organisation dates back to the 1930s. This is something that CITMA is rightly proud of and can never lose sight of, and indeed helped us in our application to become Chartered.

Only a pre-eminent organisation with a solid record of achievement in its field can be granted a Royal Charter. It is this recognition that makes the award even more special, and has cemented CITMA's role as the go-to body for expertise on trade marks and designs.

On the launch of CITMA, the then Minister for Intellectual Property, Baroness Neville-Rolfe, said: "The Institute of Trade Mark Attorneys fully deserves its Chartered status. I am glad their hard work and commitment to achieving the highest levels of both technical and professional knowledge have been recognised."

TWO-YEAR JOURNEY

The journey to the launch lasted some two years. Back in 2014, ITMA first

“



The Charter provides further support to

the claim that we are the experts in the field of trade marks

Aaron Wood, Founder, Wood IP

submitted its intention to apply for a Royal Charter. The following year, we submitted our formal petition to the Privy Council, before it was granted and sealed in 2016.

The Chartered title is a well-known seal of excellence across many professions, from accountancy to engineering, and for the same to be applied to Trade Mark Attorneys is a signal of the quality of the service they provide.

As Mr Justice Arnold remarked in a video we published shortly after launching: "The grant of a Royal Charter acts as a quality mark, or a kite-mark, certifying the quality of the body that provides the services in question. In the case of the Chartered Institute of Trade Mark Attorneys, what could be more appropriate?"

“



I believe this reaffirmation of CITMA as the pre-eminent professional body for trade marks and designs in the UK has a continuing impact on how the organisation is perceived by the

IP community more generally

Rachel Wilkinson-Duffy, Associate, Baker McKenzie



CITMA's events drive progression and allow members to continually raise the bar in respect of the strategies they are able to provide to their clients



Azhar Sadique, Director, Keltie

Guests at the launch of CITMA admire the detail of our Royal Charter



It is for this very reason that it is important for all members who are also on the Register of Trade Mark Attorneys to proudly use the title "Chartered Trade Mark Attorney".

For consumers, the title provides a point of protection and the reassurance that they are dealing with a regulated professional. But it also means they can be confident in the level of service that will be provided; trust is one of the most important commodities that any professional can offer.



The Charter draws a clear line between those who are qualified and regulated and those who are not. That is important for the public. It's about safeguarding and guaranteeing a level of quality. It also sounds great!

Tom Hooper, Trade Mark Associate, Taylor Wessing

DISTINGUISHING MARK

One of CITMA's strategic goals is to ensure its members are successful. All the work we are doing to promote the Royal Charter and the profession is intended to benefit you and the work that you do.

We hope that being able to use the Royal Charter to distinguish yourselves from unregulated practitioners is beneficial. We will be continuing our push to ensure businesses and the general public understand this essential point of difference.

Another big part of our launch was a new logo and tone of voice. We wanted to present CITMA as a modern organisation that is forward-thinking but proud of its heritage. It is pleasing to see many members wearing their pin badges at our events and when they are out representing the profession.

The Royal Charter gives us a higher platform from which to build.

CITMA PARALEGAL

The Royal Charter is not just of benefit to qualified and registered Trade Mark Attorneys – we have a wealth of talent throughout our membership. And again, we encourage every member at every level to state with pride that they are a member of CITMA.

In particular, the past year has been an important one for those supporting the work of Chartered Trade Mark Attorneys. Administrators, formalities assistants, paralegals – these support roles may have many names, but nobody disputes their importance to the profession.

Trade mark paralegal is, in its own right, a profession. This is one of the reasons we agreed that it was the right time to formally recognise the role, and also help develop it, with the launch of the CITMA Paralegal membership and title.

Continuing professional development (CPD) has been an

“



The Charter is recognition of the expertise of CITMA members, which is good not only for members, but also, more importantly, for business and the public

Mark Foreman, Director of Trade Marks, Osborne Clarke



important part of the lives of legal professionals for a number of years, helping to raise and maintain standards across the board. And to help develop our CITMA Paralegals, we will be introducing a CPD requirement from 2019.

From 2018, we will also be raising the pass mark for the CITMA Paralegal Course, again helping to bring up standards. Those who are CITMA Paralegals will truly be able to demonstrate that they are experts in their chosen profession.

EVENTS ACTIVITY

Events continue to play a big part in the work of CITMA, and we continue to focus on delivering quality events that enhance the professional lives of our members.

Our events are about more than just offering the chance to gain CPD hours – they are about bringing the profession together to provide networking and community-building opportunities, and the chance to share ideas and learn from each other. This is one of the things that makes our profession stand out.

Our first Spring Conference as CITMA was a particular highlight, bringing together practitioners from

Above: CITMA Paralegal graduates celebrate their exam results. **Below:** Delegates at the CITMA Spring Conference



“



The Royal Charter has made me feel very proud of all

CITMA has achieved
Becky Knott, Trainee Trade Mark Attorney, Barker Brettell

across the globe – helping people to extend their networks and learn while having a good time. The gala dinner under the hull of the *Cutty Sark* was an occasion to remember, and a great way to mark the first big conference since we became a Chartered profession.

CHANGING TIMES

Our Royal Charter is not the only major development bringing change. The June 2016 EU referendum result has created challenges that we can only overcome collectively. But the Royal Charter gives us a greater platform to effect change, and with the impetus of our original scenarios publication for post-Brexit EU trade marks and designs, we continue to be at the forefront of the conversation and endeavour to influence across Government and key stakeholders. Through meetings with the European Commission, IPO, EUIPO and MPs, we have been influencing decision-makers, and this work will continue.

Through our Law and Practice Committee, we also continue to make an impact and influence ongoing practice consultations and updates. We regularly make representations on governmental consultations to help shape changes in law and practice. The recent work of our committee on the Intellectual Property (Unjustified Threats) Bill is testament to this.

EXCITEMENT AHEAD

We can look to the future with excitement. While we may not know exactly what the future will bring in terms of our challenges, we will continue to drive forward and work to enhance the profession.

I hope you continue to be proud to be part of CITMA. Together we can continue to promote and enhance our profession. ■



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CHECK YOUR PRIVILEGE

*The cloak of privilege is becoming threadbare,
says Jane Jarman. Is there a solution?*



The law of legal professional privilege (LPP) has been having something of a bad time of late. For a client, the ability to refuse to give evidence, or to withhold a document from production, is said to be a fundamental human right, facilitating the right to speak freely to a lawyer to obtain legal advice and assistance. Many lawyers assume that any form of client-based consultation or document is protected by the “cloak” of LPP, whether legal advice privilege or litigation privilege, because it is “by its nature, privileged”.

Yet a spate of recent decisions concerning the ambit of LPP, such as the RBS Rights Issue Litigation¹ (RBS) and SFO v Eurasian Natural Resources Corporation Ltd² (ENRC), tends to support a suspicion that the cloak has been rendered a little threadbare. This problem of definition is compounded for registered Trade Mark Attorneys, who are in a particularly invidious position, as the claims to privilege are via statutory extension³ and tied to a restrictive definition of work-type⁴ that may no longer be fit for purpose. In this increasingly volatile context, are there any viable solutions to deal with what is an ever more uncertain concept?

FIRST HURDLE

First, as confirmed in *R (on the application of Prudential plc) v Special Commissioner of Income Tax*, for the client of a registered Trade Mark Attorney, LPP is statutory in nature⁵,

creating an initial hurdle. Section 87 of the Trade Marks Act 1994 (TMA), which is essentially a form of legal advice privilege, is a strange hybrid. The term “communications as to any matter” can seem to paint quite a broad canvas, but when restricted to specific subject matter “relating to the protection of any design or trade mark”, the aspect is narrowed. What do we mean by “protection”? Would statutory construction prove sufficiently elastic to bring advice as to the exploitation of IP rights, such as via an assignment or a licence, within the frame?

LEAKY LIFEBOAT

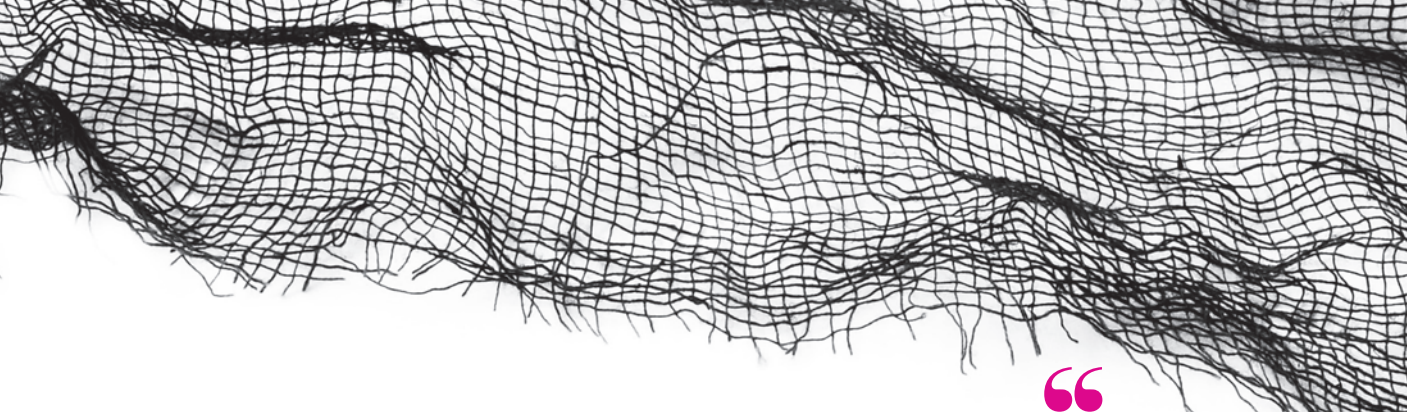
Second, although s87 refers to the application of privilege “in like manner as if the trade mark attorney had at all material times been acting as the client’s solicitor”, this is less of a “privilege lifeboat” than may be supposed. It is still linked to specific subject matter. A solicitor is not so constrained.

Further, common-law “solicitor LPP” is hardly stable. Litigation privilege and legal advice privilege have been narrowed, most notably in the *Three Rivers*⁶ litigation.

Legal advice privilege applies to confidential communications between the client and lawyer for the purpose of giving or obtaining legal advice. At each point, there is a hurdle to be vaulted, such as the identity of the client, the lawyer, or the relevant legal context, underpinned by a bewildering array of case law. The definition of “litigation privilege” is no less problematic: a

“

Trade Mark Attorneys are in a particularly invidious position, as the claims to privilege are via statutory extension and tied to a restrictive definition of work-type that may no longer be fit for purpose



confidential communication between client or lawyer and third parties arising when litigation is in progress or contemplated for the dominant purpose of conducting litigation, seeking advice or obtaining evidence. In ENRC, papers generated during an internal investigation into allegations made by a “whistle-blower” fell at the dominant-purpose hurdle.

Third, LPP is under concerted attack in the courts. Claims to privilege have come under the microscope, with increased scrutiny and challenge.⁷ The old assertion that certain documents “are by their nature privileged” has become difficult to sustain on disclosure.⁸ The final “jolt” came with the decision in RBS when, in the unusual circumstances of that case, the lawyers’ working papers and notes were only privileged when they gave “a clue to the trend of legal advice being imparted”.⁹ In other words, LPP is in trouble.

RETHINK NEEDED?

So, is it time to rethink the law of privilege? The current level of complexity is at variance with the idea of the “fundamental human right”. And while the common-law concept is not exactly predicated on the basis of a “fireside chat”, recent judgments do little to address the way in which large organisations conduct investigations and request, and act upon, legal advice.

Although not every scrap of paper touched by a lawyer should be protected by privilege, the fact that, in both RBS and ENRC, the definition was rendered so narrow that some of the working papers of lawyers were not covered is, at the very least, unhelpful. Indeed, such an interpretation could provide the impetus to develop over-elaborate and artificial stratagems to create privilege, which are rarely successful.

In addition, the current state of confusion regarding the limits of LPP may undermine the regulatory objectives of s1 of the Legal Services Act 2007 (LSA). Privilege is a substantive right of the client, not the lawyer. It is ironic,

therefore, that one of the stated regulatory objectives is to increase “public understanding of the citizen’s legal rights and duties”, since the framework supporting one of the most important legal rights has become so fractured that a client’s understanding of privilege is partial at best.

BEHIND THE TIMES

Finally, Trade Mark Attorney privilege has failed to keep pace with changes in the legal services sector. To peg it to the limited subject matter set out in s87 TMA is also arguably at variance with s1 LSA, which seeks to promote “competition in the provision of services”. As long as this “lite” version of legal advice privilege persists, there will always be a competitive disadvantage between the registered Trade Mark Attorney and the solicitor when they provide the same advice. If the privilege is that of the client, why does the status of the legal advisor matter?¹⁰ This disparity may be invisible to most clients, but there are those to whom it is apparent, and who may feel compelled to request that a solicitor is added in to secure privilege.

It is clear, then, that there are some very real problems of definition and application in the law of privilege – but are there any solutions? The most obvious approach may be to adopt, and extend, the reasoning of the majority in Prudential. If the question of any extension of LPP to those providing legal advice other than as solicitors or barristers is a matter for Parliament, why not place LPP on a statutory footing for all lawyers? This approach would be consistent with the stated aims of the LSA and would level the regulatory playing field for all lawyers. ■



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Trade Mark Attorney privilege has failed to keep pace with changes in the legal services sector

1. The RBS Rights Issue Litigation [2016] EWHC 3161 (Ch).
2. SFO v Eurasian Natural Resources Corporation Ltd [2017] EWHC 1017 (QB). This decision is now subject to appeal, as at 2nd October 2017.
3. See s190 Legal Services Act 2007 (advocacy and conduct of litigation) and s87 Trade Marks Act 1994 (legal advice). The main focus here is s87.
4. s87 Trade Marks Act 1994.
5. As confirmed by the majority in R (on the application of Prudential plc) v Special Commissioner for Tax [2013] UKSC 1.
6. Three Rivers District Council and Others v Governor and Company of the Bank of England (No 6) : HL 11 Nov 2004 and Three Rivers District Council and Others v The Governor and Company of the Bank of England [2003] EWCA Civ 474 (Three Rivers No 5).
7. “The burden of proof is on the party claiming privilege to establish it ... A claim for privilege is an unusual claim in the sense that the party claiming privilege and that party’s legal advisors are, subject to the power of the court to inspect the documents, the judges in their or their own client’s cause.” Per Beatson, J in West London Pipeline and Storage Ltd v Total UK Ltd & Others [2008] EWHC 1729 (Comm) at para 86.
8. “However, although it may have been conventional at one time to state that other documents are ‘by their nature privileged’, such a statement has no place in modern litigation, let alone litigation of very real complexity. It is clearly unhelpful, without describing the documents said to be privileged, to say that ‘their nature’ explains why they are privileged because the recipient of the list of documents has no way of knowing which documents, or classes of documents, are being referred to.” Per Master Marsh in Astex v Astrazeneca AB [2016] EWHC 2759 (Ch) at para 15.
9. The RBS Rights Issue Litigation [2016] EWHC 3161 (Ch). The papers included notes of employee interviews which amounted to transcripts without legal analysis. The employees were not the client.
10. Lord Sumption’s analysis in Prudential was that the test should be one of function or activity rather than based on status. His analysis that the law has a “pragmatic willingness to recognise the changing patterns of professional life” was compelling but in the minority. See R v Prudential [2003] UKSC 1 at para 123.



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- Trade Mark Attorney, Manchester ♦ *Would suit a part or newly qualified attorney*
- Recently Qualified Trade Mark Attorney, London ♦ *Up to 5 years' PQE*
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Please contact:

Luke Rehbein (luke.rehbein@dawnellmore.co.uk) for attorney vacancies

Daniel Airey (daniel.airey@dawnellmore.co.uk) for support vacancies

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It's 2000 and I'm in a wood-panelled room at a major law firm, sitting around a small, round table along with a distinguished Senior Partner from one of the Big Four accountancy firms and a lawyer from the host firm. We're looking at a sentence in a disclosure letter on the subject of some £2m of a remote, uncertain tax liability not being provided in the accounts.

The purchaser's voice comes through on the phone's speaker: "We need to know more about this uncertain tax liability. It could be a price adjustment." I look around the table. My colleagues look worried. Inside my head, my own thoughts are racing: "I should have noticed it before. I'm so stupid. The whole deal is going to fall through. I'm a failure. Everyone will find out I wasn't up to the job. I never was good enough. I'll be sacked."

These are the thoughts of someone suffering from the Imposter Syndrome, and at that moment I was suffering from it badly. I suffered from it in silence into my early 40s, when, while a Tax Director at BP, I had a conversation over lunch with a colleague who said she had similar thoughts. What a relief that was! I realised that others thought and felt the same way, which is why I want to share my story – so anyone reading this knows that if they are suffering from the Imposter Syndrome, they are not alone.

ACHIEVERS' AFFLICTION

The Imposter Syndrome is defined as a collection of thoughts and feelings of inadequacy. It tends to be suffered by high achievers who, despite their evident success, live in fear of being exposed as a fraud. Sufferers are unable to internalise their success, putting it down, instead, to luck, timing or deceiving others to believe

THE ENEMY INSIDE

*Jo Maughan
shares advice for
managing the
Imposter Syndrome*



“

For people suffering from the Imposter Syndrome, the soundtrack is very specific. It's not just 'I'm not good enough', it's also 'I'm going to be found out; I'm a fraud'

that they are more intelligent than they believe themselves to be.

The term was first coined in 1978 by clinical psychologists Suzanne Imes and Pauline Clance, and has become increasingly talked about in recent years. High-profile names like Kate Winslet and Emma Watson have publicly stated that they have suffered from it at times.

It may be that you can't identify specific moments of self-doubt. Perhaps you tend to take on new roles or tasks impulsively, but then, once in a role or once you've got that task, the Imposter Syndrome kicks in. Your inner voice says: "Help, I'm here. Why did they think I could do this?" A feeling of underlying panic bubbles away.

The thoughts and feelings that the Imposter Syndrome creates come from our critical inner voice: a voice we all have and that is part of our limbic brain. For people suffering from the Imposter Syndrome, the soundtrack is very specific. It's not just "I'm not good enough", it's also "I'm going to be found out; I'm a fraud".

FIGHTING BACK

The good news is you can learn to manage your inner imposter. I use the word "manage" because, in my experience, the inner voice doesn't completely go away; rather, it gets quieter, the situations in which it pops up become fewer, and the strength of my emotional reactions lessen. It no longer holds me back like it used to, and I don't experience the high levels of anxiety I once did.

I've taken a twofold approach to managing my inner imposter. First, I've learned to manage my state – how I feel in the present moment. Second, I've learned to manage my critical inner voice, which, thrillingly, has led to an enormous improvement in my confidence.

Here's one simple state management tool you can try, called a "positive anchoring exercise":

1. Think of a moment when you felt really positive, happy and confident. This can be inside or outside work.

I like to remember a moment when on holiday in Switzerland with my husband. We got to the top of a mountain and looked out from the ridge. The sun is shining; it's just beautiful. I am completely happy.

2. Sit or stand, and then close your eyes.
3. Take a number of deep breaths into and out of your body.
4. Revisit the chosen moment in your mind's eye. See yourself there again.
5. Relive the moment in your mind's eye. See what you saw. Hear what you heard. Feel what you felt. Keep breathing to magnify your positive, confident feelings. Turn up the colour and volume.
6. Now "anchor" the positive feelings at the "crescendo" moment with a discreet, subtle touch. (By choosing and creating a touch point somewhere on your body, you will create a new association in your brain so that the touch will be linked to the positive memories and feelings. When you make the touch again in the future, you will bring back a rush of positive feelings that alter your state. Therefore, the touch you choose for your "anchor" needs to be discreet so others won't notice you making it. It also needs to be a touch you won't accidentally make: for example, the signal could be the touching of your little finger with your thumb, or the action of putting your hand behind the base of your back.)
7. Break your touch. Let the positive feelings subside. Come back to the present moment.
8. Repeat steps four to seven again to cement the anchor.

The next time you are about to enter an important meeting, just be with yourself for a moment. Breathe, close your eyes, relax, make your special touch and enjoy the rush of positive feelings that flood back. You will have just brought yourself into a positive state, enabling you to be at your best.

Learning to manage one's inner imposter takes practice and commitment, because you are learning to rewire your neural pathways to create new thinking patterns and emotional responses. It is very doable, however – and so worth it! ■



JO MAUGHAN

is a career and leadership coach

Jo recently spoke on this topic for IP Inclusive. For more information, visit jomaughan.co.uk and ipinclusive.org.uk



THE CHANGE AGENT

Tim Moss brings a wealth of public and private experience to his role as CEO at the UK IPO. We find out what he hopes to achieve in his newest challenge

CITMA Review: Our readers will be aware of your recent appointment, but could you give us a brief summary of your background and how you came to take up this post?

Tim Moss: My career has been a mix of private-sector manufacturing industry and public-sector service delivery. I started out in the manufacturing sector, running factories and managing organisational change and transformation in companies such as Delta plc, Norsk Hydro and Pirelli Cables. In 2001, I took a year out to gain my MBA at Swansea University. I then moved into the public sector, joining Companies House in 2002 as Deputy Director of Operations. Then I moved into a role as Director of Strategy, and finally took up the post of Chief Executive and Registrar of Companies in September 2012. During my time at Companies House, I was heavily involved in work on new legislation, digital transformation and open data.

Companies House and the IPO have worked closely together for a number of years – we have similar structures and collaborate together in a number of areas, including business outreach, training, customer insight and finance systems, and we share a Finance Director. The IPO has a great reputation: it not only plays a fundamental role in the UK economy in increasing productivity and growth, and providing a great environment in which to register and enforce IP rights, but also has a great reputation internationally. When the IPO post came up, it seemed like a natural fit – particularly as it is based in South Wales – and the chance to lead another great UK public service is one I relish.

CR: Could you outline your role and responsibilities?

TM: As CEO and Comptroller General, I am ultimately responsible for all aspects of the IPO operation. I am supported by a fantastic team who have wide and varied knowledge and expertise. One of the great things about this role is the variety of responsibilities. You have all the issues associated with running a £90m public-service organisation with 1,200 staff, and the variety that comes with dealing with the spectrum of IP issues and a fantastic array of customers and stakeholders. In any one day, I could be: dealing with delivery of services to customers; completing tasks related to my role as Government Accounting Officer for the IPO trading fund; learning from stakeholders; developing our future strategy; contributing to the wider Department for Business, Energy & Industrial Strategy (BEIS) agenda on innovation or digital transformation; or joining an office team to learn more about their roles and how we can make the IPO an even better place to work.

Tim Moss – bio in brief

- Tim took up his post as CEO and Comptroller General of the IPO on 1st May 2017. Honours list for services to the economy and the people of Swansea.
- His previous roles include: Registrar of Companies for England and Wales, and Chief Executive, at Companies House (March 2012 to April 2017); and President of the Corporate Registers Forum (2013 to 2017).
- He has a natural sciences degree from the University of Cambridge and an MBA from Swansea University.
- He lives on a working farm in South Wales with his wife and two children, and is reported to occasionally herd sheep and cows on the weekend.
- He was awarded a CBE in the 2016 Queen's Birthday

Source: gov.uk; *Civil Service World*, 19th June 2013

The other great aspect is that I also work closely with the EPO, EUIPO, WIPO and other IP offices around the world.

CR: How does the IPO compare with Companies House?

TM: In a lot of ways, they are very similar. Both are agencies of BEIS and trading funds, which gives more flexibility to adapt to customer needs. They are also broadly similar in size and full of wonderful people. Both organisations focus very strongly on customer engagement and service delivery, and are involved in digital transformation, although Companies House is further along its transformation than the IPO. They are, however, very different in terms of the range of services they provide, and while Companies House owns the delivery of its services, it does not have responsibility for

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It is important for the IPO that CITMA is a 'critical friend' that works with us to ensure that the IP framework continues to support business in the best way possible



the underlying policy. IPO is IP for the UK. We cover policy, delivery of services, education and awareness, and dispute resolution – and coordinate enforcement activities. This is one of the things that attracted me to the role.

CR: *Our members probably deal with IPO representatives on a daily basis, and often several times a day. How would you describe the relationship between practitioners and the IPO?*

TM: Very positive, strong and collaborative – and very important! The ability to directly contact the individual examiner/hearing officer responsible for the case enables quick and convenient dialogue to resolve any outstanding matters. It's also a great source of instant and candid feedback on our performance and service offering – which we highly value.

We also gain valuable insights about wider issues – whether they are matters of practice, policy issues or potential changes to the legal framework. All of these help build a collaborative relationship, which furthers our understanding of potential problems and how to solve them. We cannot do our job effectively if we don't have a good relationship with our customers, including members of the trade mark profession.

CR: *What do you see as the greatest challenges and opportunities for the IPO for the immediate future?*

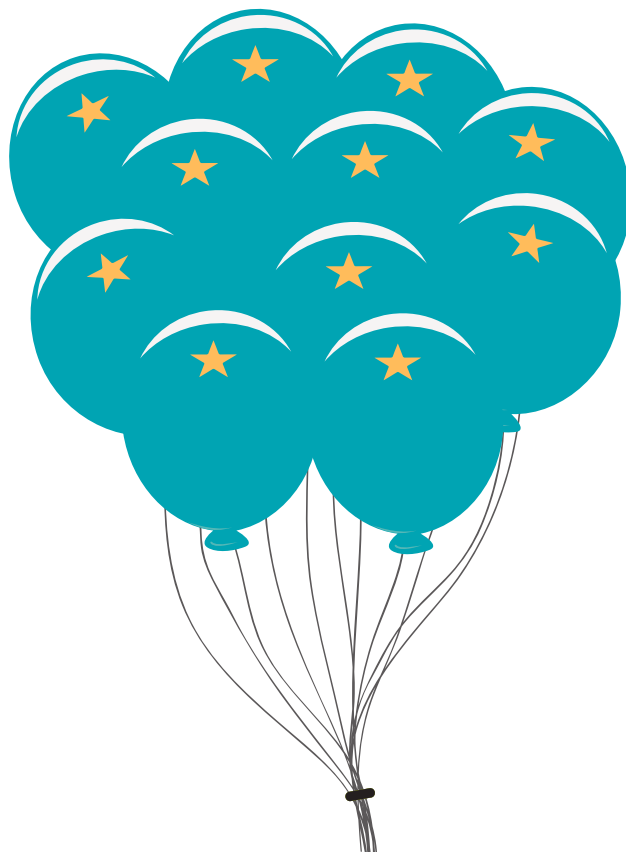
TM: Brexit has to be up there! Although, without question, this will be a challenge to every business and government organisation, I believe we need to look at it in a positive way, seeking out every opportunity possible that might arise from exiting the EU. We will contribute fully to the Government's work towards Brexit, with the clear goal of ensuring an effective IP regime that supports UK innovation and creativity. Our aim is to ensure the UK remains one of the best places in the world to obtain and protect IP.

CR: *What do you consider to be the most positive aspects of the IPO?*

TM: There are so many, and a lot of them are down to the people who work here. It didn't take me long to see that there is clear engagement, enthusiasm and commitment from all areas of the organisation. The energy and passion from people for what they do is infectious.

CR: *In view of the UK's accession to the Hague Agreement, how is the IPO progressing with preparations for filing and receiving international designs applications?*

TM: Joining the Hague Agreement in a national capacity has been important to us for some time, and this is reflected in the fact that ratification is one of our 2017–2018 ministerial targets.



I believe we need to look at Brexit in a positive way, seeking out every opportunity possible that might arise from exiting the EU

In terms of our business preparations, we have been working closely with WIPO to ensure that we are ready to receive and process international designs applications once we launch the new service. We have developed an IT-enabled process to receive and examine applications, and this has been tested. Our designs examiners have also been collaborating with their WIPO counterparts to complete their desk instructions. Closer to the introduction of the new service, we will publish business guidance for external users and ensure that designers are made aware of the benefits of the service through a strong communications campaign.

GR: What level of increase has the IPO experienced in UK design and trade mark applications since the EU referendum, and what changes has the IPO implemented to deal with this?

TM: In recent years, ahead of the EU referendum, we had seen significant increases in both trade mark and designs demand. We monitor demand daily and it remains very healthy, and the trend continues upwards. For example, trade mark applications are currently up 24 per cent on this time last year. Designs are up 124 per cent, although much of this is a clear indication of the successful service improvements implemented last year. In response, we recruited 15 new trade mark examiners, who began their training in January 2017, and we have maintained a reserve list of a further 19 examiners, which will allow us to respond more quickly to any significant increase in demand that materialises in the short term. In addition, the teams have demonstrated some great continuous improvement, enabling us to be more efficient.

CR: What role do you see for CITMA as a representative organisation for the profession in supporting initiatives from the IPO or challenging ideas and policies?

TM: It is important for the IPO that CITMA is a “critical friend” that works with us to ensure that the IP framework continues to support business in the best way possible. That includes input and challenge on business support, policy development and the day-to-day running of the application/registration system.

Most recently, we have had valuable engagement from CITMA on the detail of the impact of Brexit on IP, and on representation, rights and the strategic role of IP in supporting innovation. We also have regular meetings via the Marks and Designs Forum, which enable us to discuss all key policy initiatives, and the demand and performance of our operational, practice and tribunal functions – and to receive feedback on them in a wider forum.

GR: Will the IPO be amending its ministerial targets and goals as set out in the Corporate Plan 2017-2020 in light of any developments occurring as a result of Brexit?

TM: Our latest corporate plan was drafted after the decision to leave the EU was taken. This means that we were able to ensure that our contribution to a successful Brexit is laid out in the plan and appropriately reflected in our targets and priorities.

There is a question about Brexit’s impact on our strategy, which was published before the decision. I am conducting a review and refresh of our strategy to consider and reflect the impact of

Partnership projects: providing support

CITMA partners with the IPO on a range of business support activities, says Tim Moss, including:

- IP audits for high-growth businesses. These are administered by the IPO and carried out by IP professionals from CITMA and CIPA. In addition, the IPO has worked with both CITMA and CIPA to develop the guidance for the programme.
- IP Master Classes: intensive, three-day IP advisor training courses. Since April 2012, the IPO has trained more than 770 advisors, which has helped it integrate IP into public-sector business-support programmes. CITMA, along with CIPA, provides a session within the course around the role of IP attorneys. They have also supported the development of content.
- IP Clinics: through the UK PatLib/Business & Intellectual Property Centre (BIPC) network, CITMA members provide advice to entrepreneurs. The IPO supports both the PatLib and BIPC network through training and relationship building.
- The joint IPO/CITMA/CIPA informal discussion group, which seeks feedback from the profession in relation to changes in practice and any new initiatives.
- The IP for Universities & Colleges (IPUC) steering group.
- IP Tutor Plus – created with CITMA’s input through both the steering group (via IPUC) and the working groups to provide resources for lecturers within higher education.

Tim says: “This not only shows the breadth of issues on which the IPO and CITMA work together, but also demonstrates the importance of a great relationship between the two organisations. We may not always agree, but constructive engagement is always welcomed, and that’s what we get from CITMA.”

this and other significant changes. While the work is ongoing, we have determined that the principles underpinning our strategy remain sound. I like to boil them down to three things – delivering excellent public services, creating the best IP environment and making the IPO a great place to work. Does Brexit change any of these aims? No, it doesn’t. But it might change what we need to do to achieve them, depending on the outcome of the negotiations. Just as this year, changes and progress on the UK’s exit from the EU will be reflected in our planning. ■



STEADY AS SHE GOES

Aaron Wood provides his most recent annual assessment of litigant-in-person appearances

In terms of cases going to oral hearings at the UK IPO, 2017 mimics 2016, the number standing firm at 39 per cent.

Similarly, while last year the top five representatives contributed approximately 20 per cent of all appearances before the IPO, and the top 10 contributed 29 per cent, this year those figures stand at 18 per cent and 31 per cent, respectively. In terms of the top 10 firms making appearances, they accounted for 27 per cent of all appearances, up just two percentage points on last year's tally.

Last year we noted that only 22 firms had 10 or more hearings for the past five years (ie an average of two per year or better), and there has also been little change in terms of numbers here – though some of the names have changed. We also commented last year that only 52 UK firms had an average of one case a year or better: this has slipped to 48 firms over the period from 2010 to 2017. The mean number of cases per firm that has appeared in this period is 4.5, with a median of two cases and a mode of one case over the same period.

INDIVIDUAL APPEARANCES

We also noted that, of the 342 individual representatives (incorporating barristers, solicitors and Trade Mark Attorneys) to have appeared since 2010, only 41 had appeared, on average, more than once per year in that period – and in the period from 2012 to 2016, only 17 had appeared an average of two times or more per year.

These numbers remain stuck in this position, with only 41 individuals with an average of one case or more per year (of whom 30 are counsel), and only 17 individuals with an average of two or more cases over the period from 2013 to 2017 (of whom 12 are counsel). While last year there were 30 new entrants among the 101 that appeared, this year the number dropped to just 25 people making their very first appearance in the period from 2010 to 2017.

Note: The collection data for 2012–2016 reflects the calendar year. For 2017, data refers to 1st January to 1st December.

Significant split:

The split between counsel/solicitor appearances and those by Trade Mark Attorneys has changed from 50/50 to 60/40 in favour of counsel



AARON WOOD
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2017: most appearances



FIRM

Haseltine Lake/Marks & Clerk



BARRISTER

Charlotte Scott



TRADE MARK ATTORNEY

Martin Krause/Aaron Wood



2013-2017: top 10 Barrister appearances



2013-2017: top 10 Trade Mark Attorney/ solicitor appearances

NAME	CHAMBERS
1 Simon Malynicz QC	Three New Square
2 Tom St Quintin	Hogarth Chambers
3 Jonathan Moss	Hogarth Chambers
4 Amanda Michaels	Hogarth Chambers
5 Michael Edenborough QC	Serle Court
6 Charlotte Scott	Hogarth Chambers
7 Philip Harris	St Philips
8 Chris Hall	11 South Square
9 Benet Brandreth	11 South Square
10 Chris Aikens	11 South Square

NAME	FIRM
1 Julius Stobbs	Stobbs IP
2 Ian Bartlett	Beck Greener
3 Martin Krause	Haseltine Lake
4 Aaron Wood	Wood IP
5 Kieron Taylor	Swindell & Pearson
6 Kate McCormick	Trade Mark Direct
7 Rowland Buehrlen	Beck Greener
8 John Reddington	Williams Powell
9 Barbara Cookson	Filemot
10 Marisa Broughton	Withers & Rogers
= Alan Fiddes	UDL
= Angela Fox	Maucher Jenkins

2013-2017: firms making 10 or more appearances

FIRM	NUMBER OF APPEARANCES
Stobbs IP	30
Beck Greener	24
Cleveland Scott York*	21
Haseltine Lake	20
Marks & Clerk	20
Swindell & Pearson	20
CMS*	17
D Young & Co	17
Withers & Rogers	16
Bird & Bird	16
Wood IP	13
HGF	13
UDL	13
Mewburn Ellis	12
Boult Wade Tennant	11
Keltie	10
Mathys & Squire	10
Williams Powell	10
Forresters	10
GWW	10
Kilburn & Strode	10
Maucher Jenkins	10

* In the case of Cleveland Scott York and CMS, the figures quoted represent the combined results of the merger partners



CHILD'S PLAY?

George Sevier surveys the celebrity trendsetters trading the next generation

It may be a new phenomenon for today's famous families, but, in fact, making early applications is a sensible tactic to protect the brands of tomorrow's celebrities. So, who's in the lead on protecting the IP of their progeny?

BRAND BECKHAM – AHEAD OF THE GAME

The Beckhams made the press in May 2017 for organising trade mark protection for the name of five-year-old Harper Beckham. In fact, Victoria Beckham applied for EU trade marks (EUTMs) for the names of all four of her children in December 2016. BROOKLYN BECKHAM (EUTM 16191835), ROMEO BECKHAM (EUTM 16191868), CRUZ BECKHAM (EUTM 16191884) and HARPER BECKHAM (EUTM 16191918) came to grant in May and June 2017.

In each case, the applications were made in the name of "Victoria Beckham, as parent and guardian of [child]". Given the applications were made at EUIPO, there was no requirement for a declaration of intent to use the marks. This may explain the very long list of goods and services in classes 3, 9, 16, 18, 25, 28 and 41 – covering everything from make-up and perfume to clothing, toys and dolls; recording equipment; and entertainment services.

The Beckhams have been silent about their reasoning for the applications. The press was quick to suggest that they were part of a bid to fortify "brand Beckham" and were made ahead of Harper Beckham's name being used for a new brand of clothing. Clothing lines and the like have not materialised yet, but if the Beckham children will, at some point, have their own brands, making the applications at this point will prove a savvy move.

BLUE IVY, RUMI AND SIR CARTER – KEEPING THE HAWKS AWAY

Singer Beyoncé and rapper Jay-Z became parents to Blue Ivy Carter on 7th January 2012. Just four days later, a fashion designer submitted an application to register BLUE IVY CARTER NYC. The designer insisted it was an innocent move to produce children's clothing under a brand that he planned to pitch to the famous parents. The following week, another third-party applicant sought registration for BLUE IVY CARTER GLORY IV. Both applications were denied by the United States Patent and Trademark Office (USPTO) upon examination, saying the name belonged to a "very famous infant", and consumers would falsely assume that the products were approved by the celebrity parents.

Possibly prompted by this activity, over the following six weeks, Beyoncé's company, BGK Trademark Holdings, applied to register BLUE IVY CARTER at the USPTO and EUIPO. The EU registration succeeded (EUTM 10659514), but objection to the US application (86883293) was raised in light of prior registrations for BLUE IVY, and it was ultimately abandoned in 2016, with no proof of use having been filed. Around the time that application was abandoned, BGK Trademark Holdings made a further US application, which has been opposed since May 2017.

Beyoncé and Jay-Z had twins in June 2017. Before any public announcement of their birth had been made, Beyoncé's company filed US trade mark applications for the names of the twins, RUMI CARTER (US applications 87506186 and 87506224) and SIR CARTER (US application

“

At years or even days old, a celebrity's child might be notorious, but unless they have traded under their name, there will not be goodwill in it

87506188). This time, they were one step ahead of any prospective third-party applications for the infants' names.

What if third-party applications had been made at the UK IPO? At years or even days old, a celebrity's child might be notorious, but unless they have traded under their name (and they are unlikely to have sold products or endorsements at such an early stage in their career), there will not be goodwill in it. And without an existing trade mark registration or goodwill, they would not be able to rely on earlier rights to defeat a third-party application. They could argue that the application was made in bad faith, but that may be difficult to prove – it would be much more straightforward if there was a trade mark registration to point to.

JUSTIN BIEBER – A YOUNG TARGET

Canadian pop star Justin Bieber's company, Bieber Time Holdings, sought a trade mark for his name in 2010 (EUTM 9167271), when he was just coming to fame, aged 16. The name is now registered in countries across the world, as is JUSTIN BIEBER'S GIRLFRIEND (Madrid registration 1134655). Since 2010, there have been at least 10 third-party applications for JUSTIN BIEBER, illustrating how celebrity names may be a target for applications.

Bieber also demonstrates how people will seek to capitalise on celebrities' wider brands, going beyond the names of the personalities themselves: Bieber fans are often referred to as "Beliebers". While Bieber does not have his own registration for BELIEBER, Bieber's company has successfully opposed two US applications for the term, arguing that a third party's unauthorised use in connection with merchandising creates a likelihood of confusion as to an official association with Bieber.¹ However, he has let two stylised marks onto the EUIPO register for BELIEBER (EUTM 11761616) and I'M A BELIEBER (EUTM 12001566).

In light of all this, if there is a chance that your own children will be famous one day, you might be advised to file a trade mark application now! ■

1. Bieber Time Holdings, LLC v Mahlon Williams, Cancellation No 92060199 (October 2016); and Bieber Time Holdings, LLC v NYfashion101, Inc, Opposition No 91217097 (October 2014).



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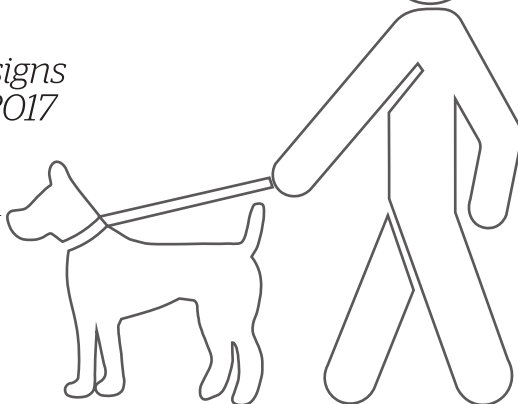
George assists trade mark owners in protecting their brands, particularly online, and advising in relation to advertising, marketing and licensing.

FOUR TO EXPLORE

Jade MacIntyre dissects the four designs decisions that made a difference in 2017

Following a flurry of designs decisions in 2016 – 11 in total – the UK IPO has issued just seven decisions in 2017 (at the time of writing). This represents a return to the norm for the UK IPO: the average between 2013 and 2015 was six decisions per year.

Of the seven in 2017, four are of particular interest, including points of law rarely seen, as well as the first appeal to the Appointed Person.



O/034/17 (INVALIDATION)

I NEED SPACE

3RD FEBRUARY 2017

This case involved an application by Yellow Dog UK to invalidate a UK registered design (UKRD) in the name of Sarah Jones for a dog lead. The case considered the validity of the UKRD based on two grounds: lack of individual character and the inclusion of an earlier distinctive sign.

Yellow Dog stated it had made “The Yellow Dog Lead” available for sale nearly two years prior to the filing date of the design, and claimed this was cause for invalidation under s11ZA(1) of the Registered Designs Act 1949 (the Act).

The Hearing Officer (HO), in considering the invalidity claim, focused on whether the UKRD had individual character at the relevant date, from the perspective of the informed user. The HO accepted the summary of the characteristics of the informed user made by His Honour Judge Birss (as he then was) in *Samsung v Apple*¹,

“

The HO said that the differences were not sufficient to alter the overall impression these designs would make on the informed user



Top: UKRD No 5000131
Above: the Yellow Dog prior design

noting that the test is narrowed by the informed user being particularly observant and the fact that designs are often considered side by side.

In addition, the HO remarked that the scope of

protection for a registered design must be wider than just identical or near-identical products under the test of “different overall impression”, as these rights are not simply concerned with anti-counterfeiting. After assessing the differences between the designs, the HO remarked that these were not sufficient to alter the overall impression these designs would make on the informed user (a dog owner, dog walker or someone who cares for dogs). As a result, the UKRD lacked individual character, and the application for invalidity succeeded.

Yellow Dog had also registered a UK trade mark (UKTM) for I NEED SPACE in class 18 (including dog leads/collars) prior to the filing of the UKRD. Yellow Dog pleaded that this invalidated the design under s11ZA(3) of the Act as it included an earlier distinctive sign.

The HO, referring to ss72 and 10 of the Trade Marks Act 1994, found that the UKTM must be considered a distinctive sign and, as Yellow Dog had a right to prevent the use of the mark for the goods for which it was registered, the second ground of invalidation also succeeded.

O/066/17 (INVALIDATION)

THE RETROFIT STANDING DESK

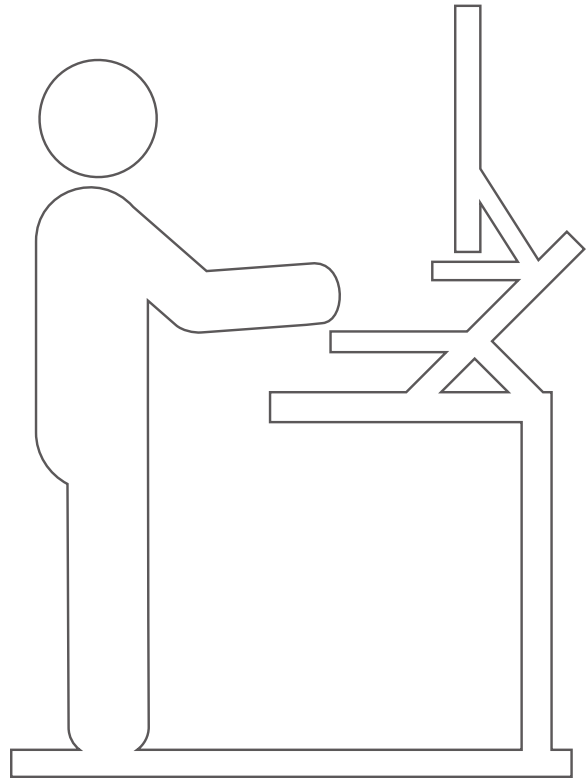
17TH FEBRUARY 2017

This case involved an application by Mr Ryan Roberts to invalidate a UKRD in the name of I Want A Standing Desk Ltd (the Proprietor) for a retrofit standing desk. Roberts claimed that the UKRD should be declared invalid based on lack of individual character and the fact that Roberts was the true proprietor of the design.

Roberts claimed that the UKRD lacked individual character on the basis of his design for a product called DeskStand, which was showcased at an international trade fair in South Africa seven months prior to the filing of the UKRD. Roberts had also sold the DeskStand to customers in the UK and Europe before the UKRD filing. The Proprietor had contacted Roberts prior to filing, complimenting him on the design and claiming to be a distributor interested in discussing distribution opportunities.

As the trade fair was held in South Africa, the Proprietor submitted that Roberts' design had not been disclosed to the public in the European Economic Area (EEA). Therefore, under s1B(5) (b) of the Act, the disclosure "could not reasonably have become known before the relevant date in the normal course of business to persons carrying on business in the [EEA] and specialising in the sector concerned". The HO considered the CJEU decision in *H Gautzsch Großhandel v Münchener Boulevard²*, which established: (i) that disclosure outside the EEA may be sufficient to bring the design to the attention of the circles specialised in the sector concerned within the EEA; and (ii) that the extent of the disclosure need not involve widespread disclosure to relevant persons in the EEA.

Given that the original design for the DeskStand was featured at an international design exhibition, where it was likely to come to the attention of those in the relevant trade circles (including in the EEA), and that there was unchallenged evidence of sale of



As the trade fair was held in South Africa, the Proprietor submitted that Roberts' design had not been disclosed to the public in the EEA



Above: UKRD No 500032
Below: a representation of Roberts' DeskStand



the desk to customers in Europe prior to the filing of the UKRD, the HO found that the prior design had been relevantly disclosed. The Proprietor could not be protected by s1B(5) (b) of the Act.

The HO then proceeded to consider whether the UKRD was novel and possessed individual character. Due to differences between the two designs, the HO decided that the UKRD was novel. However, he found that it would create the same overall impression on an informed user thanks to the key features common to both designs, which were quite different from the design corpus and so afforded Roberts' earlier design a broader scope of protection.

The HO stressed that the UKRD had taken too much of the expression of Roberts' design, ▶

and therefore rejected the Proprietor's submission that this finding would entitle Roberts to a right in the idea for a desk stand, as this would have been contrary to design rights principles.

As to the claim that Roberts was the actual proprietor of the UKRD as a ground for invalidation, the Proprietor submitted that the design had been created completely independently, based on instructions it had given to a third-party design firm. The HO rejected this submission given the similarity of the designs,

lack of evidence as to the instructions provided to the design firm, and the fact that the design firm had been contacted nine days after the Proprietor was in touch with Roberts about the standing desk. However, the HO stopped short of considering whether Roberts could claim to own the UKRD given the slight differences between the two designs, noting that this legal question should await a case that requires it. The HO therefore made no finding on the s11ZA(2) ground for invalidation.

O/086/17 (INVALIDATION)

THE BABY TOOTHBRUSH

28TH FEBRUARY 2017

This case involved an application by Justin Bernhaut to invalidate a UKRD in the name of Bushbaby for a baby toothbrush. Bernhaut claimed as grounds for invalidation that the design had already been published as part of a US patent just under three years before the filing of the UKRD application, which amounted to a disclosure under s1B(6) of the Act.

First, the HO compared the illustrations of the US patent and the UKRD, and concluded that these were the same. Bushbaby claimed in its counterstatement to have developed its own "tooling design". However, the HO noted that this could not be seen in the representations on the register.

As a result, unless the so-called obscure disclosures exception in s1B(6)(a) of the Act applied, as pleaded by Bushbaby, the publication of the patent in the US meant that the UKRD was invalid. In assessing the availability of the exception, the HO considered the same points raised in the "retrofit standing desk" case (discussed above) relating to the Gautzsch decision, and also noted the General Court's decision in *Senz Technologies BV v OHIM*³ to uphold EUIPO's finding that a prior disclosure in the US register



Above: UKRD No 4014852
Right: the illustration of the US patent



of patents could invalidate what was, in those circumstances, a Community design.

The HO concluded that the publication of a patent in the US, as one of the most important industrialised nations of the world, meant: "it would be wrong to conclude that the publication could not reasonably have become known to persons specialising in the relevant sector in the EEA".

The application for invalidation was successful.

O/253/17 (APPEAL TO INVALIDATION)

THE UNION JACK CLOTHING APPEAL

12TH JUNE 2017

This was the first decision of an Appointed Person (AP) under the appeal regime for designs created by the Intellectual Property Act 2014. Decision O/152/16 (March 2016) had declared invalid five registered designs owned by Ahmet Erol, on application by Sumaira Javaid. Erol appealed the invalidation of two of those registered designs, which involved items of clothing prominently featuring a Union Jack. The decision to invalidate was on the basis that the UKRDs did not create a different overall impression when compared to the prior designs.

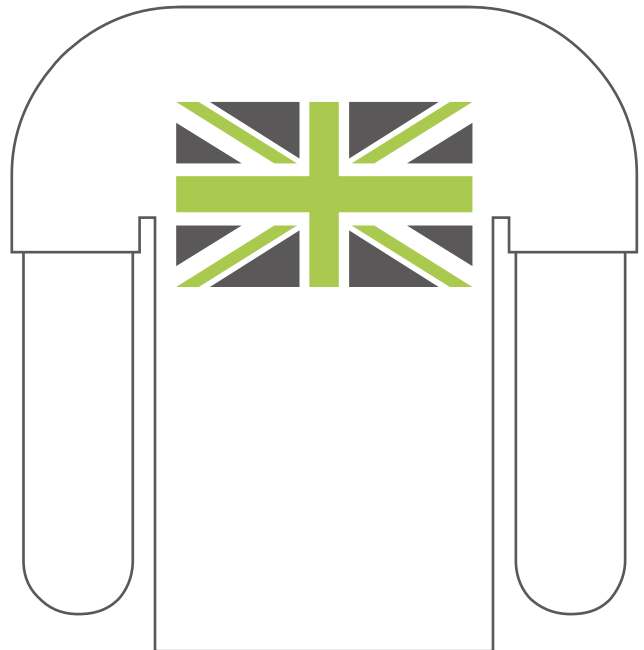
The AP first considered the application by Erol to adduce additional evidence, and established that, as the application did not meet the *Ladd v Marshall*⁴ principles, the additional materials would not be allowed into the appeal.

The AP disagreed with the HO's assessment of the scope of the UKRDs. The HO described this as being: "a Union flag applied to the top half of a garment". The AP found this to be legally flawed, as a design registration relates only to a single design, and the definition above amounted to the abstraction of certain features of the design and thus excessively broadened the scope of the design registration. The HO's approach, in comparing the prior design with a set of abstracted features of the UKRDs, rather than with the UKRDs themselves, had led to the differences between them being disregarded. The AP found this to be incorrect and proceeded to carry out a new comparison of the designs.

Having established that the UKRDs differed from the prior design in more than "immaterial details" and so were new, the AP proceeded to consider whether the UKRDs possessed individual character.

The AP broadened the description of informed user chosen by the HO from "an informed user of souvenir clothing" to an informed user of clothing or T-shirts and hoodies generally, since using the former approach would lead to detailed differences between the Union flag designs weighing more heavily. Based on this, the AP examined the prior design against the registered designs and found that the UKRDs created the same overall impression when compared with the prior design.

It should be noted that one of the UKRDs featured a tick/swoosh. The AP noted that this



UKRD No 4019752



UKRD No 4019267



Prior design – Facebook photo (cropped)



Prior design from witness statements

feature was so insignificant as to not create a different overall impression from that of the prior design. As a result, in spite of the difference in approach between the AP and HO, the end result was the same and the UKRDs remained invalid. ■

1. [2012] EWHC 1882 (Pat).
2. C-479/12.
3. Joined cases T-22/13 and T-23/13.
4. [1954] 1 WLR 1489.



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PULLING IT TOGETHER

John Coldham confirms how the High Court has cleared up “aspects” of design law

Few design cases reach the High Court each year, but when they do, the judges often use the opportunity to settle any areas of law that appear controversial. The recent decision in *Neptune (Europe) Ltd v DeVOL Kitchens Ltd*¹ is the latest example, with Mr Justice Carr providing helpful comments on a number of areas.

Before the changes to UK unregistered design rights (UKUDR) brought about by the Intellectual Property Act 2014, the definition of a design was “the design of any aspect of the shape or configuration (whether internal or external), of the whole or part of an article”. The concept of “any aspect of” a design gave designers extensive freedom to frame the scope of their infringement claims as narrowly as desired in order to capture the alleged infringement. The only limitation was commonplace, a notoriously difficult basis on which to succeed. This ability to carve up the design in order to protect unregistered aspects opened the floodgates for arbitrary divisions of design features to catch infringers, with the decision in *Sealed Air*² providing just one example.

CHANGE CONFUSION

The amendment to the definition of “design”, deleting the phrase “any aspect of”, was drafted with a view to creating a clear distinction between the “parts” of a design that remain

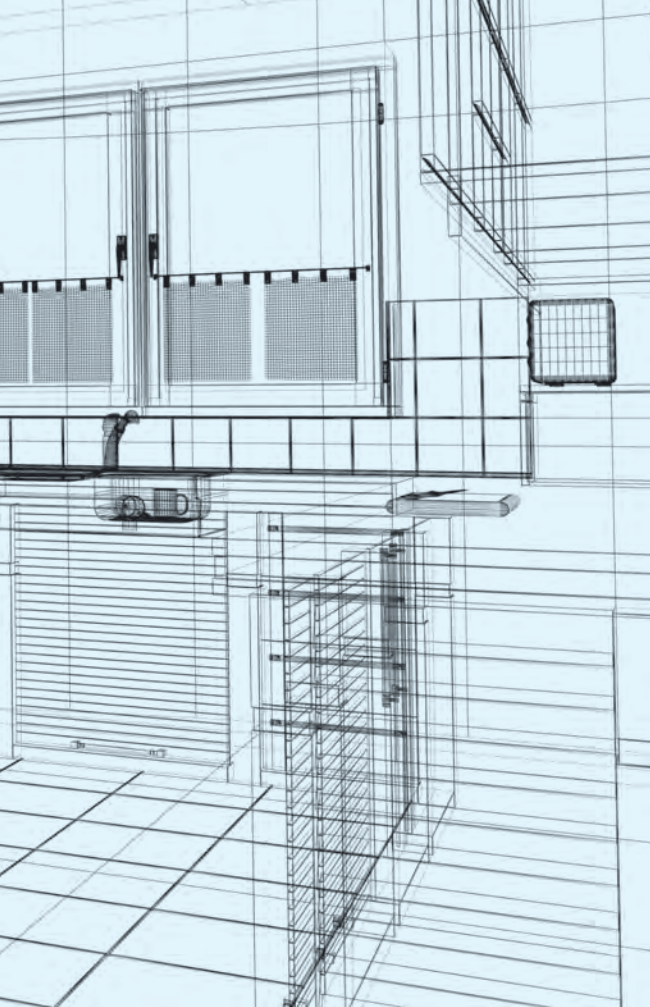
covered by UKUDR and “aspects” of a design that are not. Yet, since this change, the courts have been grappling with how it might affect the real-world scope of a design; after all, if you are still allowed “parts” of an article, what is no longer allowed? If the scope has indeed changed, does it only apply to designs created after 1st October 2014, or to all designs, or somewhere in between?

In *Neptune*³, Carr J dealt with the two uncertainties arising from the change – when it comes into effect and what it covers. He held that if a design was created and infringed prior to 1st October 2014, the old law applies. If it was created prior to that date, but infringed after, the new law applies. Anything created after the change is covered by the new law.

Looking at the difference between an “aspect” of the design and a “part” of the design, Carr J considered Mr Justice Laddie’s example of a teapot in *Ocular Sciences*.⁴ Laddie J noted that aspects of a design for a teapot “could include the combination of the end portion of a spout and the top portion of the lid, which are disembodied from each other and from the spout and the lid”. This reasoning was followed in *Neptune*, where it was held that “parts” of a design are concrete elements, whereas “aspects” are disembodied features that are merely recognisable. As an example in this case, the beading on kitchen units was considered to be a part, not an aspect.

SURFACE DECORATION

In terms of analysing what formed part of the design, *Neptune* submitted that the “cock-beading” on its kitchen cabinets was surface decoration, and thereby excluded from protection.



This was in line with a previous decision in *Mark Wilkinson*⁵ (which similarly dealt with the design of kitchen units).

While Neptune had excluded the beading via its pleadings, Carr J took the opportunity to clarify the position. He distinguished the case from *Mark Wilkinson* on the grounds that the beading on Neptune's cabinets was a "prominent and striking part of the shape of the doors". It was held that the decision as to whether something is surface decoration is a "value judgment" that will turn on the facts of the case.

While this might narrow the previous understanding of the *Mark Wilkinson* case, it acts as a salutary reminder that if you wish to ensure something is not considered part of the design in suit (perhaps because it is not a feature that has been copied), do not rely on the statutory exclusions, but plead your design clearly with express reference to what is excluded, as Neptune did.

MOVING PARTS

The judge accepted Neptune's submission that as UKUDR applies to both functional and aesthetic designs, it would be surprising if the law did not allow for account to be taken of how particular parts of an article moved in use, but was instead restricted to "frozen" views of a dynamic article. Carr J agreed, saying that it would not be possible to consider their functionality if their dynamic features were excluded from protection.

INFRINGEMENT TEST

When considering copying, it is not enough to show that the idea has been copied; there must have been copying of the

“

It was held that the decision as to whether something is surface decoration is a 'value judgment' that will turn on the facts of the case

manifestation of that idea. In this case, the judge did not accept that the design of DeVOL's Shaker range was entirely uninfluenced by, and owed nothing to, DeVOL's knowledge of Neptune's Chichester range. However, he decided that the key witness for DeVOL, Mr McLellan, was honest and had simply convinced himself that the DeVOL design owed nothing to the Neptune design because no more than the idea of using the cabinets had been taken.

When assessing infringement, the judge confirmed that it is necessary to consider the differences as well as the similarities between the products in issue, especially when pleaded as a whole. It will not be enough to show that a particular feature or combination of features (which in a copyright claim might constitute a substantial part) has been copied, unless those features have been pleaded as design rights of their own.

Although Neptune was ultimately unsuccessful, as DeVOL was able to prove that it did not copy and the products were not sufficiently close to constitute infringement, the case is still a useful reminder of the flexibility of UKUDR.

POTENTIAL APPROACH

When setting out the design they wish to rely on, designers can consider which parts of the design are closest to the alleged infringement and – provided they are concrete parts of the article – can exclude those parts that the Defendant's product has designed around. In contrast, designers relying only on a registered design do not have the ability to exclude features (unless they were also excluded in the registration) – and must rely on the whole design as filed. The best approach is for designers to file multiple registered designs for each product, covering different parts of the article (perhaps using the incredibly low-cost UK regime as a starting point for the broadest protection), and then to rely on UKUDR to fill in any gaps when copy products come along. ■

Gowling WLG acted for Neptune in the case discussed.

1. [2017] EWHC 2172 (Pat).
2. *Sealed Air Ltd v Sharp Interpack Ltd* [2013] EWPC 23.
3. [2017] EWHC 2172 (Pat).
4. [1997] RPC 289.
5. *Mark Wilkinson Furniture Ltd v Woodcraft Design (Radcliffe) Ltd* [1998] FSR 63.



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A lot of hot air?

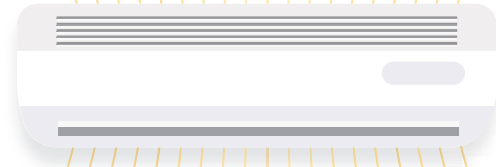
*Rosalyn Newsome takes
a cool view of an air
conditioning-related dispute*

THIS CASE CONCERNED UK application No 3179440 KOMPACT in the name of Ebac Industrial Products Ltd, filed for “standalone dehumidifiers, not being part of air conditioning units” in class 11, and opposition thereto by Cottage Stores LLP. The opposition was based on UK trade mark (UKTM) No 2619258 Kompact, which covered “portable air conditioners and dehumidifiers” in class 11. Cottage opposed the Ebac application under s5(1) and 5(4)(a) of the Trade Marks Act 1994, claiming use of Kompact in relation to portable air conditioners and dehumidifiers dating back to August 2006. Ebac responded by filing a partial invalidation of the Cottage registration in respect of “standalone dehumidifiers, not being a part of air conditioning units” on the basis of its claimed earlier use of KOMPACT since 2005. The invalidation and opposition proceedings were consolidated.

CLAIM DETAIL

In support of the partial invalidation claim, Ebac filed modest evidence showing use of KOMPACT on dehumidifiers, consisting of initial design drawings, relatively low-level but annual sales data for the years 2005 to 2016, and some product advertisements.

In reply, Cottage explained that it sold climate-control equipment across the UK and Kompact was “limited to portable air conditioners which are branded under the name Koolbreeze Kompact”. The evidence showed use of the primary brand Koolbreeze, with Kompact being used as a sub-brand. Cottage was unable to provide records prior to 2006, despite trading since 2002. Brochures were provided relating to Koolbreeze Kompact, but only those from 2012 and 2014 made reference to a dehumidifying function for the portable air conditioners. While it was clear that Cottage had made use of Kompact, the majority of use was of Koolbreeze Kompact



for an air conditioning unit. Cottage filed voluminous sale invoices (2007–2015), but these did not assist its claimed use dating back to August 2006, and were not sufficient to show prior use to Ebac’s claimed first use of 2005.

The Hearing Officer (HO) concluded that Ebac, despite the low level of use evidenced, did demonstrate sufficient goodwill in KOMPACT, and was deemed to have a protectable goodwill in standalone dehumidifiers effective at the relevant date (26th April 2012, the filing date of Cottage’s registration). Consequently, Ebac was successful in the partial invalidation claim. The Cottage registration was thus restricted to “class 11: portable air conditioners and dehumidifiers; but not including standalone dehumidifiers, not being part of air conditioning units”.

Having reached that decision, the HO had to decide on the opposition. As Ebac was now deemed to be the senior user in respect of the challenged goods, the opposition under s5(4)(a) had to fail. Further, following the limited specification of UKTM No 2619258, the s5(1) ground also failed, as the goods for the point of comparison were not identical; indeed, the exact goods of interest to Ebac are now specifically excluded from the Cottage registration.

GAME CHANGER

This is a useful reminder of how consolidated proceedings can easily become a game changer in the strategy and arguments to be adopted. While claiming overly broad grounds for opposition is not to be encouraged, the narrow constraint of s5(1) to purely identical marks and identical goods suggests that it is always safer to include s5(2) as an additional ground in an opposition.

KEY POINTS

- ▶ Treat s5(1) with caution - it will be strictly applied; should s5(2) also be considered?
- ▶ When evidencing unregistered rights, low-level and consistent use can be sufficient



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Survival of the fittest

*Alex Woolgar
reviews how one
summer camp
concern emerged
triumphant*

IN THIS UK opposition, the Applicant, AmeriCamp Ltd, and the Opponent, Nyquest Training and Placement Inc, acted as recruitment agents in the same market: finding students and young people to work at summer camps in Canada. Both recruited independently at first, but, between 2014 and 2016, AmeriCamp acted as *de facto* sub-agent for Nyquest. By early 2015, “Camp Canada” had become at least part of the trading name of the overall commercial effort.

In March 2016, AmeriCamp applied for a series of two stylised logo marks, bearing the prominent text CAMP CANADA, covering various services in classes 35, 39, 41 and 43. Soon after, it applied to invalidate Nyquest’s word mark for CAMP CANADA, applied for in March 2015 and registered in May 2015 in classes 35 and 41. AmeriCamp alleged that it had prior UK rights for CAMP CANADA, and therefore sought invalidation under ss47(2)(b) and 5(4)(a) of the Trade Marks Act 1994, as well as bad faith (ss 47(1) and 3(6)). Nyquest, in turn, opposed AmeriCamp’s application on the basis of ss5(2), 5(3) and 5(4)(a), and 3(6). The proceedings were consolidated, with Allan James sitting as Hearing Officer (HO).

EVIDENCE ISSUES

The dispute was quite evidence-heavy, with each party attempting to show it had gained a passing off right in CAMP CANADA before the other, and in particular before 2014 (when they began to work together). Nyquest registered the domain name campcanada.co.uk in September 2011, and AmeriCamp the domain campcanada.org in January 2014. However, there was little clear evidence of trade by either

party under the CAMP CANADA name until after the parties began working together: only limited email correspondence and a single blog. To the extent that the name

was being used, the HO held that such use either would have been perceived descriptively (in relation to a summer camp programme in Canada) or was *de minimis*.

Consequently, AmeriCamp failed to prove prior rights in the name. Regarding bad faith, the evidence indicated that Nyquest had used the CAMP CANADA name independently from AmeriCamp prior to their commercial partnership, and that to the extent that

the recruitment programme belonged to any party, it belonged to Nyquest.

WEAKENED CASE

The most interesting aspect of this decision is probably that the HO held that AmeriCamp’s claim for bad faith was also weakened by the relative descriptiveness of the name CAMP CANADA for the relevant services. Consequently, Nyquest’s application was consistent with standards of acceptable commercial behaviour, and was not made in bad faith.

Nyquest’s registration therefore survived, and several of the services under AmeriCamp’s application were held to be similar to those under Nyquest’s registration. Further, by the application date, CAMP CANADA had become distinctive of Nyquest, so there was a passing off right. Therefore, the ss5(2) and 5(4)(a) challenges blocked most of AmeriCamp’s application. However, Nyquest had not acquired a reputation in relation to the remaining services, and the bad faith challenge also failed for those services. Overall, Nyquest was found to have “won” and received a contribution towards its costs.



KEY POINTS

- ▶ Trivial prior use of a name is unlikely to establish a passing off right, particularly where the name is relatively descriptive
- ▶ A claim of bad faith will usually be difficult when the trade mark owner had already used the mark as, or as part of, its trading name
- ▶ Descriptiveness of the relevant name can be relevant to the question of bad faith

- ▶ The AmeriCamp application



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Of the essence

Oliver Tidman outlines a case that revolved around indications of origin

MORRISON GLASGOW Distillers Ltd (the Applicant) filed a UK trade mark (UKTM) application for THE GLASGOW DISTILLERY (figurative, depicted below) for a range of goods and services in classes 33, 35, 40, 41 and 43. Glasgow Distillery Company Ltd (the Opponent) opposed the application based on an earlier EU trade mark application, also shown below.

PREVIOUS DECISION

The Opponent's application, the same mark relied upon as the earlier mark in the opposition proceedings, was also subject to opposition proceedings at EUIPO, brought by the Applicant on the basis of its earlier UKTM registration for THE GLASGOW DISTILLERY. To the extent that it is relevant to this decision, EUIPO partially upheld that opposition in respect of class 35 for retail services, all connected with the sale of alcoholic beverages. Consequently, these services (which were initially relied upon by the Opponent) did not proceed to registration, and the Opponent's mark was registered for services in classes 33 and 40. Accordingly, the opposition was based on this specification.

Interestingly, the Applicant made a number of admissions in its counterstatement and submissions as to the similarity of the respective goods and services.

Nevertheless, some services in classes 35, 41 and 43 were considered dissimilar. The Hearing



Officer (HO) referred to the case of Oakley Inc v OHIM¹ to support her decision that the Opponent's goods and the contested services were insufficiently pronounced, so that, from the consumer's point of view, they were unlikely to be offered by one and the same undertaking.

CONFUSION

In view of the high degree of similarity between the marks, the HO found a likelihood of confusion, even though the majority of the goods and services were only found to have a low to medium degree of similarity.

Although the Opponent's mark has a low degree of distinctive character, the HO cited L'Oréal² to argue that this does not preclude a finding of a likelihood of confusion. Even where the level of attention paid is above average and the visual differences between the marks are noticed, effectively it is the phrase THE GLASGOW DISTILLERY that will be seen as an indication of origin in both marks. Accordingly, the HO found that the opposition should succeed in respect of classes 33, 35, 40, 41 and 43 for the remaining goods and services.

This case serves as a reminder to trade mark applicants in opposition proceedings that, even where marks have a weak distinctive character and the contested goods and services are of a low degree of similarity, a finding of a likelihood of both direct and indirect confusion can result.

KEY POINTS

- ▶ Direct and indirect confusion can both occur where consumers mistake one mark for the other and assume that goods and services are from the same undertaking or of undertakings with economic connections
- ▶ Consequently, an opposition could succeed even where the similarity of the goods and services is low

1. Case T-116/06.
2. L'Oréal SA v OHIM, Case C-235/05.

- ▶ The Applicant's mark

THE GLASGOW DISTILLERY

PUMPHOUSE | CLYDESIDE

- ▶ The Opponent's mark


THE
GLASGOW
DISTILLERY CO



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V for victory

A well-known gesture of peace was the object of hostility, writes Richard May

IN NOVEMBER 2016, Long Arm Brewing Co Ltd (the Applicant) filed a UK trade mark application for the sign depicted below in class 32 (the Application).

Robot Energy Ltd (the Opponent) opposed the Application under s5(1) and 5(2)(b) of the Trade Marks Act 1994 using the fast-track opposition procedure. The Opponent is the owner of an EU registration, also depicted below, in class 32 which is less than five years old and not subject to proof of use.

The s5(1) claim was dismissed quickly, because the Application was not identical to the earlier mark based on CJEU guidance in *Arthur et Felicie*. The Hearing Officer (HO) concluded that there were material differences – in particular, the forearm in the Application, which was unlikely to go unnoticed by the average consumer. Consequently, the case turned on the s5(2) analysis.

BEVERAGE CONSUMERS

The contested goods were either beers or non-alcoholic drinks in class 32, and the HO found them to be either identical or highly similar using the familiar *Treat and Meric* principles. On assessing the purchasing habits of the average consumer of drinks in class 32, the HO considered that such goods are made available through a variety of trade channels (eg supermarkets, off-licences, websites, bars, pubs and restaurants). The average consumer will either self-select the goods or choose behind-the-counter goods in licensed premises where the goods are on display.

The HO therefore decided that the visual impact of the Application took on more significance, although she did not discount the potential for aural considerations, as goods may be ordered orally from a member of staff. Although none of the goods in question are

particularly expensive, and all are reasonably frequent purchases, the HO concluded the level of attention will be average, the consumer paying the attention necessary to obtain the right product, taking into account factors such as strength (for beer), taste and flavour.

JUDICIAL NOTICE

The case turned on the comparison of marks. The parties neither filed submissions or evidence nor requested a hearing under the fast-track procedure. Consequently, the HO effectively took judicial notice of the position, particularly on conceptual identity.

According to the HO, the average consumer is likely to perceive both marks as signs meaning victory or peace. And even if they do not, they will consider both marks to refer to a hand performing the same gesture. Overall, the HO decided the marks were visually highly similar and conceptually identical. As both marks were purely figurative, it was unnecessary to make an aural comparison.

APPLICATION REFUSED

The HO concluded that the contested marks shared the same overall impression: a hand forming a "V sign". Consequently, a finding of confusion followed and the Application was rejected. This case highlights the risk of adopting a mark that makes the same overall impression as an earlier mark, even if the later mark is an arguably different visual representation. It also reminds us that hearing officers are prepared to take judicial notice on facts that are so well known to be the subject of serious dispute.

KEY POINTS

- ▶ The tribunal can accept facts, without evidence, by effectively taking judicial notice on facts that are so well known to be the subject of serious dispute
- ▶ The conceptual identity and visual similarity led to a strong shared overall impression, which the Application failed to remove, despite some arguable visual differences
- ▶ The Opponent succeeded without filing written submissions, evidence or attending a hearing under the fast-track procedure

- ▶ Long Arm Brewing's UK application No 3195924



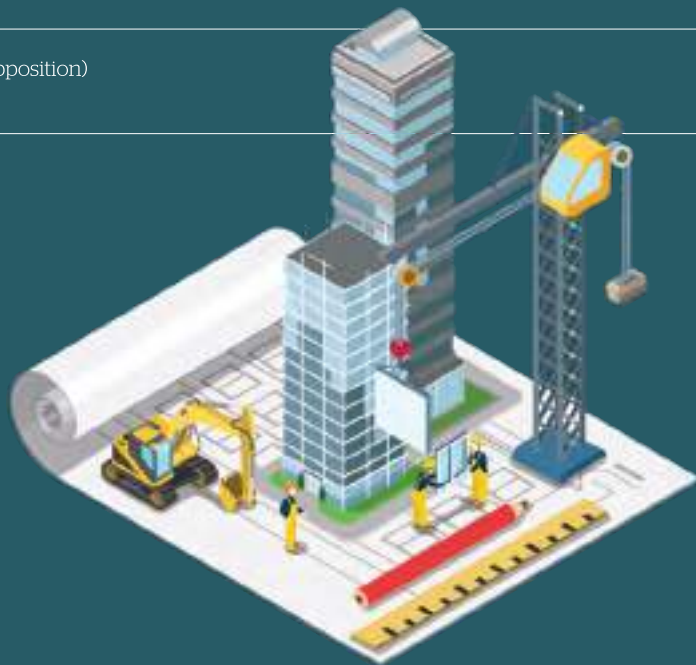
- ▶ Robot Energy's earlier EU registration No 16003089



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If you build it...

Registration may not come, as Chris Morris reports

THIS CASE CONCERNED opposition proceedings at the UK IPO against an application to register the mark SIMCITY BUILDIT by Electronic Arts Inc (EA). The application covered class 9 (games software) and class 41 (entertainment services). The Opponent, Duf Ltd, opposed on the basis of its earlier UK registration for the BUILD IT logo shown below. The earlier registration covered “entertainment services” in class 41, and Duf opposed under s5(2)(b) of the Trade Marks Act 1994, utilising the fast-track procedure.

In accordance with the requirements of the streamlined procedure, EA sought permission to file evidence. Leave was refused, and that decision was confirmed at a case management conference. Both parties filed written submissions, and a decision was reached on the papers without an oral hearing.

SIMILARITY SITUATION

EA admitted that the respective services in class 41 were identical or similar. It initially denied a similarity between the class 9 goods and class 41 services, but conceded some similarity in its written submissions.

In assessing first the similarity of goods and services, the Hearing Officer (HO) confirmed the Applicant’s admission that the respective services were indeed identical. Applying the Meric principles, she also found that the class 9 goods were highly similar to the broadly worded services (entertainment services), since that term would encompass “non-downloadable internet games”, for example.

The HO then went on to consider the average consumer and the purchasing act. The average consumer for games was found to be the general public, who would pay a normal degree of attention. The purchasing act was likely to be primarily visual.

MARK COMPARISON

Turning to a comparison of marks, while there were points of visual difference, the respective signs were found to be visually and aurally similar to a medium degree.

As EA conceded, both marks bring to mind the concept of building something. While the *SimCity* family of games may have a reputation with “knowledgeable gaming consumers”, that fact cannot be taken into account for the purposes of a conceptual comparison. The signs shared a medium degree of conceptual similarity.

Combining the above findings with the fact that the earlier mark was of an average degree of inherent distinctiveness, the HO now summed up her findings on likelihood of confusion.

Following the chain of cases from *Medion v Thomson*, she found that the BUILDIT element of EA’s mark plays an independently distinctive role within the opposed mark. On that basis, there is a likelihood of consumer confusion.

The opposition succeeded.

CONCLUSION

While this decision followed well-established principles, it provides a reminder to brand owners and their representatives that care must be taken and proper searches carried out when new composite marks are being devised – even if the new element will be paired with a long-standing, registered house mark. Inclusion of an earlier registered right does not provide a “free pass”.

KEY POINTS

- ▶ Care must be taken when new composite marks are being devised
- ▶ Even pairing a new element with a long-standing, registered house mark does not provide a “free pass”

- ▶ UK registration No 3125527



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A pukka decision?

Rebecca O'Kelly-Gillard suggests the court may have split hairs here

IN PUKKA HAKKA, Pukka Pies Ltd (Pies) and Zenobia Kassam and Babar Khan (K and K) each brought actions against one another over the registration and cancellation of various marks incorporating the word “pukka”. K and K brought six opposition and cancellation proceedings against a number of Pies’ marks for variations of “Pukka Pies”; Pies responded with an opposition to the application for PUKKA HAKKA made by K and K.

The decision of the Hearing Officer (HO) was extensive and serves as a good summary on the law relating to:

1. evidence in the form of: comparison of goods and services; marks; and dictionary definitions and use of a term in the press; and
2. the limits of the extended protection available under ss5(4)(a) and 5(3) of the Trade Marks Act 1994 (the Act).

K and K sought declarations of invalidity and opposed three of Pies’ registered marks and three applications. K and K argued that “pukka” was a term meaning “authentic, genuine and good” and, as such, that Pies’

marks were devoid of any distinctive character and/or consisted exclusively of signs or indications that served to designate the quality of Pies’ goods under ss3(1)(b) and 3(1)(c) of the Act.

The HO began by assessing the meaning of the term “pukka”, expressing that the important consideration was the meaning of the term as at the various application dates.

In assessing K and K’s evidence, the HO noted:

- It does not automatically follow that because a word is in the dictionary the average consumer will be aware of its meaning(s).
- Context is important when assessing press articles, and care must be taken when using them in evidence. Here, K and K produced only seven press articles, with the HO noting that this was “not a large number if the word were as descriptive as K and K claimed”.
- If the term being analysed is slang, this will be relevant. Slang fashions come and go, and this affects the analysis of a mark as at the application date.

K and K's evidence could not prove that "pukka" would have been immediately understood at the relevant dates to denote a laudatory characteristic of the goods and services of Pies' marks. The HO did not have to deal with K and K's arguments in respect of s3(1)(b), as they were pleaded on essentially the same basis. K and K's invalidity and oppositions therefore failed.

OPPOSITION

Having dealt with the preliminary issue of proof of use in respect of Pies' marks, the HO went on to extensively examine the likelihood of confusion between K and K's application and Pies' marks, starting with the relevant goods and services. As per *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*¹ (Canon), the relevant factors are "the nature, intended purpose and method of use of the goods and services and whether they are in competition with each other or are complementary".

K and K's application covered a wide variety of goods and services in classes 29, 30, 35, 41 and 43. When taken together, Pies' marks covered goods in classes 29 and 30, and specific services in class 41.

The HO found identity in respect of specific goods in classes 29 and 30, and specific services in class 41. She then went on to consider K and K's non-identical goods and services. From that comparison, the following principles can be drawn:

- Even if all of the goods concerned are foods and all are eaten by the general public, this is not enough for a finding of similarity.
- Although there may be an element of competition between goods, this does not necessarily mean they are similar, particularly if they would be found in different locations in a retail environment.
- When comparing retail services against goods, there may be some similarity based upon complementarity and shared trade channels; the goods do not have to be identical to the subject goods of the retail service; and the level of similarity may be weak depending on the presence or absence of the other Canon factors.



The HO then compared Pies' marks with K and K's stylised PUKKA HAKKA. Applying the principles from *Sabel BV v Puma AG*², the HO found:

- a low to medium degree of visual similarity between Pies' composite earlier marks, with this degree of similarity slightly rising in respect of Pies' marks that consisted solely of PUKKA;
- an above medium level of aural similarity between the marks; and
- an average consumer would not know what HAKKA meant: the application created the impression of two words that have no immediate meaning. Conceptually, therefore, the comparison of the marks was considered neutral.

After reviewing Mr Justice Arnold's decision in *Whyte and Mackay Ltd v Origin*

Wine UK Ltd and Another³ (concerning the JURA ORIGIN mark), the HO concluded that, unlike JURA ORIGIN, PUKKA HAKKA did not form a unit with a different meaning to its components taken separately. The dominant and distinctive element of the mark, therefore, was PUKKA.

As such, and taking into account Pies' more recent PUKKA PIE DAY mark upon which it could rely for all of the goods and services registered, the HO found a likelihood of indirect confusion in relation to the identical goods and services. Pies' claim, however, failed in respect of K and K's goods and services that were not identical (in summary, these were services in classes 35, 41 and 43).

FINAL GROUNDS

As Pies' s5(2)(b) ground only partially succeeded, the HO went on to consider its submissions under ss5(4)(a) and 5(3) of the Act.

Section 5(4)(a)

Pies' claim under s5(4)(a) was essentially the same as its claim under s5(2)(b). However, it was argued that Pies' goodwill extended to a goods and services classification that was wider than the specification of its marks, in particular in respect of classes 35, 41 and 43.

The HO analysed what constitutes goodwill, emphasising that it is the benefit and advantage of the good name, reputation and connection of a business (HO's emphasis). With this emphasis in mind, the HO determined that Pies did not have goodwill in any of the following:

- “advertising display apparatus and refrigerated food display apparatus”;
- “games software”;
- “advertising, including promotion and products of third parties through sponsorship arrangements”; and
- “business advisory services in relation to the reduction of carbon footprint and charitable contributions to food banks”.

In respect of all the above, the HO placed great importance on the fact that Pies did not have a business in any of the goods/services claimed. In particular, it never made any sales in respect of any of the above; as such “there [was] no attractive force bringing in custom”.

This is an interesting argument, and one that some would argue splits hairs too finely. For example, the finding that sponsorship of third parties did not constitute a “business in advertising”, but was merely a method of advertising one's own goods, was arguably arbitrary and somewhat unfair in light of the commercial reality of advertising.

Section 5(3)

Finally, Pies sought to argue that K and K's application would take unfair advantage of, or be detrimental to, the distinctive character or repute of its earlier marks.

Although the HO found that Pies had inherent distinctive character and that this had been enhanced through use, this distinctive character was limited to pies. A link would not necessarily be made between marks with a reputation attached to pies and the application in relation to the surviving services, even those relating in some way to food.

CONCLUSION

This decision highlights the benefits of registering a range of different marks and continuing to expand a trade mark portfolio to ensure the broadest protection possible. It further reinforces the requirement to be specific concerning the goods and services applied for, especially given the narrow interpretation of what could be considered as constituting “having a business in” for the purposes of s5(4)(a).

KEY POINTS

- ▶ The assessment of an English-language slang term must be performed as at the application date of a mark
- ▶ To hold goodwill in a service, a rights holder must have “a business” in that service; it is not enough to be merely associated with that service

1. Case C-39/97.
2. Case C-251/95.
3. [2015] EWHC 1271 (Ch).



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Crispy business

Evidence of use didn't take root with the Registrar, writes Chris Hoole

ON 8TH AUGUST 2016, Kettle Produce Ltd (the Applicant) filed to register a figurative UK trade mark (UKTM) (the Mark, shown below). The Mark sought protection in classes 29, 30, 31, 32 and 33 for “vegetables, cooked”, “prepared meals”, “vegetables, fresh”, “non-alcoholic drinks” and “alcoholic beverages, except beer”, respectively.

OPPOSITION BASIS

The application was opposed by Huntapac Produce Ltd (the Opponent). The opposition was filed under the fast-track opposition procedure and based on the earlier UKTM No 2523426, registered for “carrots” in class 31 (the Earlier Mark, shown below). The Opponent relied on s5(2)(b) of the Trade Marks Act 1994 and claimed that the mark applied for was “similar to [its] earlier trade mark and [was] to be registered for goods or services identical with or similar to those for which the earlier trade mark [was] protected”.

As the Earlier Mark was registered more than five years ago, the Opponent was put to proof of genuine use. In fast-track proceedings, an opponent relying on an earlier mark that is subject to proof of use must file evidence of use at the time of filing the opposition. Following the opposition, a party may only file evidence with the leave of the Registrar. Here, the Opponent’s evidence comprised mainly images of packaging (mostly vegetable crisps), where the Earlier Mark was often accompanied by the Opponent’s trading name. Other examples included packaging for other vegetables (except carrots). The Opponent also provided two invoices, neither of which showed use of the Earlier Mark in relation to carrots. The other items of evidence presented were a press release (which failed to show or explain how the Earlier Mark had been publicised externally), a presentation and a brochure (mainly referring to crisps).



DECISION

Although the Opponent submitted 13 exhibits of evidence, the Registrar found no proof of genuine use of the Earlier Mark, noting, in particular:

- The majority of the evidence referred to vegetable crisps and, although “carrots appear to be an ingredient of those crisps”, the goods are different both physically and in law: “carrots” are proper to class 31, whereas “crisps” are listed under class 29.
- The evidence, mostly packaging, was generally undated and of poor quality, and failed to show any obvious use of the Earlier Mark for carrots.
- The Opponent failed to show that products/packaging bearing the Earlier Mark had been put on the market and made accessible to consumers.
- The sales figures provided by the Opponent were “unsubstantiated and undifferentiated”, and thus failed to show “the scale of use in respect of carrots”.

LIMITED OPTIONS

Fast-track opposition proceedings provide only limited opportunity to file and comment on evidence, so evidence submitted must be detailed from the outset. There are significantly fewer chances for a “second bite”. If relying on a mark older than five years, the evidence must show the presence of actual use on the goods and/or services bearing that mark, and detailed and dated sales figures. Therefore, attorneys looking to use the process should consider whether they have sufficient time to compile proper evidence of genuine use prior to the opposition deadline.

KEY POINTS

- ▶ Attorneys should consider whether the fast-track opposition is appropriate if relying on marks older than five years
- ▶ Opportunity to file evidence is limited in the fast track; therefore, any evidence filed must be detailed, dated and thorough
- ▶ Evidence of genuine use in the fast track, filed at the time of the opposition, must show use on the goods protected, use in the market and scale, and be clearly dated

- ▶ The Kettle Produce Ltd mark



- ▶ The Huntapac Produce Ltd mark



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Ahead of the curve

The Applicant had a lot to learn, explains Dale Carter

IN OCTOBER 2015, Fifth Dimension Digital Ltd applied to register the series of marks shown below, covering a range of finance services in class 36. Curve 1 Ltd opposed, based on a likelihood of confusion with its earlier CURVE trade mark covering identical services.

Before considering the merits of the opposition, the Hearing Officer (HO) addressed two issues raised in Fifth Dimension's counterstatement. The first was Fifth Dimension's attempt to rely on its earlier use of the KERV trade mark as a defence to there being a likelihood of confusion. The HO rejected this, as per the reasoning in Tribunal Practice Notice 4/2009. The second issue was Fifth Dimension's claim that it was using novel technology in connection with its services and that this would be a factor that the relevant public would take into account when selecting its services (Curve 1 was using technology that had existed for many years). This argument was rejected. Curve 1's earlier registration was not subject to proof of use, and therefore the HO was required to consider notional use of the mark for all of the registered services and embodying all forms of technology.

SPLIT DECISION

The services were found to be identical. The HO found the marks to be aurally identical but only visually similar to a very low degree. However, there was a split finding on whether a conceptual clash existed. For those consumers who would look for a meaning behind KERV, there would be conceptual identity. For consumers who would perceive KERV as an invented word and would not attempt to conceptualise it, there was no conceptual clash.

The relevant public included members of the public and more specialised commercial

customers. The level of attention of the relevant public was found to be above average.

The HO found that the services may be purchased visually (eg via a website) and aurally (eg via a broker or other intermediary). Despite the higher than normal level of attention of the relevant public and the very low level of visual similarity between the marks, the HO found that there was a direct likelihood of confusion. This finding was primarily based on the aural identity between the marks, which related to an important way in which the services were purchased. Nevertheless, the HO was clearly swayed by the evidence of actual confusion submitted by Curve 1 and by Fifth Dimension's failure to challenge this evidence.

PURCHASE POINTS

This case highlights the importance of assessing the relationship between how goods/services are purchased, and the relative importance of the visual, aural and conceptual assessments between marks.

Had the HO found that the services here were purchased primarily by visual means, the very low level of visual similarity between the marks may have been enough for the HO to find in Fifth Dimension's favour. However, because the services could be purchased aurally and the marks were aurally identical, the strong visual differences between the marks were not sufficient to outweigh the aural and conceptual identity.

KEY POINTS

- ▶ Striking visual differences are not enough to counteract aural identity and partial conceptual identity
- ▶ Evidence of actual confusion among consumers can be highly persuasive in Registry proceedings
- ▶ Failing to challenge evidence filed in proceedings may be deemed acceptance of that evidence

- ▶ The Fifth Dimension marks



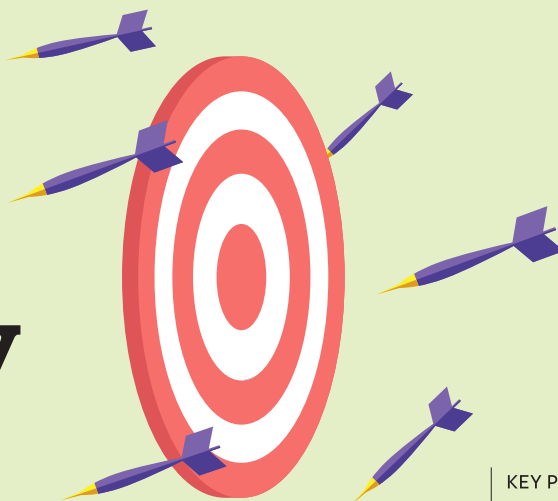
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No faith in Fidelity

Throwing in the kitchen sink was not a successful strategy, notes Teresa So



THIS CASE CONCERNED an invalidity action brought by FIL Ltd & FIL Investment Services (UK) Ltd (the Applicants) against UK trade mark registration No 3035323 FIDERES, a composite mark (depicted below) in the name of Fideres Partners LLP (the Proprietor), covering class 36 services.

Based on a number of prior registrations for FIDELITY and a stylised “F” (depicted below), all registered for class 36 services, the invalidity was brought under ss5(2)(b), 5(3), 5(4)(a) and 47(2)(a) of the Trade Marks Act 1994.

PRELIMINARY ISSUES

One of the preliminary issues concerned the number of marks relied on by the Applicants. The Hearing Officer (HO) was of the view that the number of pleaded marks was excessive. However, the Applicants maintained their position and argued that it was ultimately a matter for the HO to decide which was the strongest mark.

Another issue concerned the s5(4)(a) grounds. The Applicants conceded that the s5(4)(a) grounds did not put them in any stronger a position than the s5(2)(b) grounds. As a result, the s(5)(4)(a) grounds were struck out and the HO proceeded to deal with only ss5(2)(b) and 5(3).

Another preliminary issue concerned “without prejudice save as to costs” correspondence. The HO refused admission of such correspondence before a substantive decision was issued, but held that it could be admitted on submissions on costs.

COMPARISON OF MARKS

The Applicants emphasised the fact that the marks shared identical beginnings and the established principle that the average consumer pays a greater degree of attention to the beginnings of marks. Nevertheless, despite the identical beginnings, identity of services and high degree of distinctiveness (as a result of the use made) in the Applicants’ marks, the HO considered that the very different endings of the words resulted in very low levels of visual, phonetic and conceptual similarity. It was held that there was no likelihood of confusion, and s5(2)(b) failed in its entirety.

REPUTATION

As a result of the use made, a number of the Applicants’ marks were held to have acquired a strong reputation.

Nevertheless, this again was insufficient to offset the low degree of similarity between the marks. The HO considered that none of the Applicants’ marks would be brought to mind when the average consumer encountered the Proprietor’s mark; therefore, a link would not be made. Since no link could be established, there could be no damage, and so s5(3) also failed in its entirety.

KEY POINTS

- ▶ Avoid “kitchen sink” pleadings, which waste time and money, and obscure the real issues
- ▶ Base actions on the strongest marks and avoid excessive pleaded marks
- ▶ The interdependency principle will only go so far in offsetting a lesser degree of similarity of marks (or vice versa), and should not be applied too liberally

- ▶ UK registration No 3035323



- ▶ The Applicants’ marks

i)	ii)
FIDELITY	
iii)	iv)
v)	vi)



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Snail mail is stopped



A suggested restriction wasn't a winning tactic, reports Carrie Bradley

THIS CASE CONCERNED a partial opposition by Associated Newspapers Ltd (the Opponent) against a UK trade mark (UKTM) application for SNAIL MAIL, filed by Wicked Vision Ltd (the Applicant). The Opponent relied upon s5(2)(b) of the Trade Marks Act 1994 on the basis of its earlier UKTM registration for the stylised mark MAIL in overlapping classes 9, 16 and 35.

The Hearing Officer (HO) relied upon the General Court's reasoning¹ that goods designated by an application can be considered to be identical where they are encompassed within (ie a subset of) a broader term covered by an earlier mark, and vice versa. Accordingly, the HO provided a clear and succinct analysis of the comparison of goods and services at issue, concluding that the class 9 goods were identical, the class 16 goods were identical and highly similar, and the class 35 services were also identical.

LIMITATION DISMISSED

A side note of interest is that the Applicant offered a restriction to the class 16 specification of goods, so as to exclude the term "newspapers" (this being the Opponent's core field of activity). The Applicant's commercial logic here, and its attempt to invite the HO to avoid a finding of likelihood of confusion on the basis of this exclusion, is understandable. However, the HO dismissed this limitation as being wholly unsatisfactory since other more general terms would remain within the specification that could still include goods that are highly similar: for example, magazines (which would fall within the remaining term "printed matter").

With regard to the comparison of marks, the HO concluded that they were visually similar to a low degree, and aurally similar to a medium degree, despite the word SNAIL being

articulated before MAIL, the latter being the common element within both marks. Conceptually, the HO considered MAIL to mean "to send by post" and SNAIL MAIL "the physical delivery of mail, as by the postal service, considered as slow in comparison to electronic mail". On this basis, the marks were found to be so highly conceptually similar as to be almost identical.

CONSUMER ATTENTION

The average consumer was deemed to be typical, with a reasonable level of attention during the purchasing act. Likewise, the earlier mark MAIL was deemed to be distinctive to an average degree, since the ordinary dictionary meaning had no direct relationship to the specific goods and services relied upon.

In terms of the global assessment, the HO concluded that the interdependency principle was in full operation, given that the majority of the goods and services had been found to be identical. Likewise, the HO was guided by the Appointed Person² in concluding that there was a tangible risk of indirect confusion between the marks, given that the addition of SNAIL to MAIL simply reinforced the same conceptual hook and so did not assist in creating a gap between them. For this reason, the HO considered that SNAIL MAIL would appear to the average consumer to be an entirely logical and consistent brand extension of MAIL, and would lead to the belief that the marks emanated from the same, or an economically linked, undertaking.

The partial opposition succeeded in its entirety, and the HO awarded costs of £1,200, to be paid by the Applicant.

KEY POINTS

- ▶ Exclusions within specifications will not reduce a likelihood of confusion if other broad terms remain
- ▶ If a later mark appears to be consistent with an earlier brand's logical expansion, then there is a tangible risk of indirect confusion between them

1. Gérard Meric v Office for Harmonisation in the Internal Market, Case T-133/05.
2. LA Sugar Ltd v By Back Beat Inc, Case BL-O/375/10, Iain Purvis QC.



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Just a secco...

The HO put a stop to use of a PDO, says Loren Ravenscroft



IN 2013, the Lambswick Drinks Company Ltd (the Applicant) created a cider using locally sourced Discovery apples, which it named Discovery Cider. It rebranded the cider Oldfields Applesecco and applied for a trade mark in relation to the same in 2016 (the Application), which was opposed by Consorzio Di Tutela Della Denominazione Di Origine Controllata Prosecco (the Opponent), owner of the protected designation of origin (PDO) for PROSECCO.

The Opponent relied upon s3(3), 3(4), 3(6), 5(2)(b) and 5(4)(a) of the Trade Marks Act 1994 in opposition. However, the focus of the Hearing Officer's (HO's) decision was s3(4): that a trade mark should not be registered in contravention of, among other things, EU law. In particular, the focus was on Articles 102 and 103(2) of Regulation (EU) No 1308/2013, which relate to PDOs for wine and the relationship of the same with trade marks.

The HO found that Article 102 did not apply, as it prohibits the registration of trade marks that contain a PDO for products covering wines, grape must and wine vinegar. Here the Applicant's product was cider, and its applied-for mark did not contain PROSECCO in its entirety. On the other hand, Article 103(2) did apply, as it relates to comparable products to the PDO products and prevents "any misuse, imitation or evocation" of a PDO.

In its defence, the Applicant argued, among other things, that the labels and marketing were clear that its product was cider, and that "secco" was understood by consumers in the UK to mean "dry". However, the Applicant's evidence did not support these points. Further, the Opponent submitted evidence showing

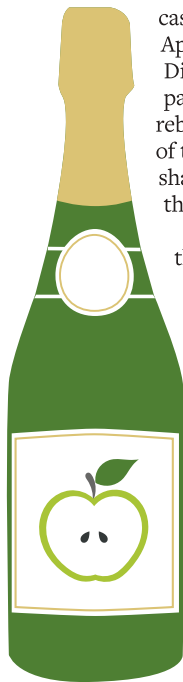
references to the product being marketed as an "alternative to Prosecco" or "like Prosecco" from various websites, including the Applicant's own.

Particularly damning to the Applicant's case, in the eyes of the HO, was the Applicant's rebranding of its product from Discovery Cider to a name that included part of "Prosecco", primarily as this rebrand appeared to happen as a result of the Applicant's and its customers' shared view of the similarities between the taste of the product and Prosecco.

In relation to the mark as a whole, the HO considered that consumers would think the product was from "Oldfields" and was either an apple-flavoured Prosecco drink or was made in a similar style to Prosecco, using apples. Given the Applicant's rebrand, it was clear in the HO's mind that this was the Applicant's intention. The HO therefore rejected the Application on the basis that it erroneously evoked the PDO PROSECCO.

As the Opponent had selected the objection under s3(4) as its strongest case, and the HO had found in its favour on this point, it saw no need to consider the other grounds of opposition.

This case underlines the importance of Article 103(2) as a valuable tool for owners of PDOs to keep marks off the register that include a PDO, or even an element of one.



KEY POINT

- ▶ PDOs can be useful as a tool for keeping trade marks off the register, not least for marks which may not incorporate the PDO in full



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Port in a storm

Sarah Talland reviews the last outing for a long-running beverage battle

THIS DECISION was the finale of a long-running dispute between the Port Institute and Bruichladdich, a Scotch whisky producer, regarding a registered trade mark containing the word “port” for alcoholic beverages other than port wine. This latest and final decision of the CJEU provides some welcome clarification on the scope of geographical indications (GIs), which are protected under EU law, and confirms that national law cannot confer greater protection than that provided by EU law.

In 2011, the Port Institute applied to invalidate an EU registration for the mark PORT CHARLOTTE in class 33, owned by Bruichladdich. The invalidity action was filed on the basis of conflict with the appellations of origin “Porto” and “Port”. In response, Bruichladdich limited the class 33 goods to “whisky”. It is useful to note here that Port Charlotte is the name of a small village in Scotland near the location of Bruichladdich’s whisky distillery. The Cancellation Division rejected the invalidity action, and this decision was later confirmed by the Board of Appeal (BoA).

The Port Institute had sought to argue that the GI protection for “port” ought to be extended to any sign that includes the term “port”, and that national law in Portugal should be considered where the protection afforded is greater than under EU law. Both of these arguments were rejected by the Cancellation Division and the BoA, with the Cancellation Division finding that the word “port” has several meanings and uses that are unrelated to “port wine”. The BoA held that: (1) the GIs were protected only for wines;

(2) whisky is a different product to that covered by the GIs; and (3) the mark PORT CHARLOTTE does not contain a potentially misleading or confusing statement.

The Port Institute appealed the BoA decision to the General Court (GC), which held that the protection for GIs under EU law may be supplemented by relevant national law granting additional protection. This decision was then appealed to the CJEU by EUIPO on the basis that the GC decision was contrary to the principles laid down under the Treaty on the Functioning of the European Union regarding the competence of Member States in circumstances where the EU has already legislated.

In this decision, the CJEU reversed the GC decision and confirmed that the protection afforded to GIs under the relevant EU regulation was to be interpreted as exhaustive, such that it precludes the application of a national system of protection for GIs, which are also protected under the EU regulation. Since the protection for “Porto” and “Port” falls within the relevant EU regulation, the appeal by EUIPO was upheld. The CJEU also upheld the finding of the GC that PORT CHARLOTTE is not an evocation of “Port” or “Porto” (as protected by the GIs) and the Court’s comment on the differences between port wine and whisky.

The CJEU did not consider it necessary to refer the case back to the GC, and so its decision is final.

Wildbore & Gibbons LLP represented Bruichladdich Distillery Co Ltd before EUIPO and the Board of Appeal.

KEY POINTS

- ▶ National law on GIs cannot be used to provide supplementary protection above and beyond that provided under EU law
- ▶ A GI for “port” cannot be used to prevent registration of other trade marks containing the word “port” where it is used legitimately and without confusion with the GI
- ▶ There are several significant differences between port wine and whisky, which should be taken into account



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Leaf to appeal

Jackie Mullen distils the essence of a flurry of actions



IN OCTOBER 2010, French lingerie company Delta Lingerie filed applications for four figurative marks containing the term DARJEELING (one of which is shown below) covering goods and services in classes 25, 35 and 38.

The Tea Board (TTB), a body formed under the Indian Tea Act, 1953 (No 29 of 1953), serves as the custodian of the Darjeeling protected geographical indication (PGI). Fearing misappropriation of the Darjeeling PGI, it filed oppositions against the applications on the basis of its earlier collective marks for DARJEELING covering “tea” in class 30. TTB claimed a likelihood of confusion and a risk of unfair advantage under Articles 8(1)(b) and 8(5) of Regulation (EC) No 207/2009.

TTB’s oppositions were dismissed by the Opposition Division, and subsequently by the Board of Appeal (BoA).

APPEAL ATTEMPTS

TTB was partially successful in its appeal before the General Court (GC), which upheld the second part of its plea. When the BoA conducted its analysis of the application of Article 8(5) in light of the hypothetical premise of the exceptionally strong reputation of the earlier marks, it was wrong to exclude the possible existence of a risk of unfair advantage in relation to all the goods in class 25 and some of the services in class 35. As a result, the GC partially annulled the BoA’s judgment, leaving the BoA to re-examine whether the earlier marks had a reputation and, if so, how strong that reputation was. Both parties appealed.

In its decision of 20th September 2017, the CJEU reaffirmed the findings of the GC; both the appeal and cross-appeal were dismissed.

ESSENTIAL FUNCTION

An important point to note from this case is that the essential function of an EU collective

mark is to distinguish the goods or services of the members of the association that is the proprietor of the trade mark from those of other undertakings, and not to distinguish those goods according to their geographical origin.

EU collective marks and PGIs are governed by distinctive legal regimes and pursue different aims. Although a collective mark may consist of a PGI, geographical origin is not relevant to establishing identity or similarity under Article 8(1)(b).

The CJEU also made a useful determination about how the risk of detriment referred to in Article 8(5) is assessed. Unfair advantage should be considered through the average consumer of the goods or services supplied under the mark of the later applicant, and whether they were attracted by the values and positive qualities connected with the earlier mark. This differs from the position of assessing risk of detriment to the distinctive character or repute of the earlier marks, which focuses on the consumers of the earlier mark.

NEXT STEPS

The matter will be handed back to the BoA so it can reassess the evidence in order to reach a definitive conclusion as to: (a) what amounts to a reputation of an exceptional strength; and (b) whether the DARJEELING mark has such a reputation. It is interesting to note that no mention has been made of the fact that shapes resembling tea leaves have replaced the dots on the letters “j” and “i” in the mark.

KEY POINTS

- ▶ The essential function of an EU collective mark is to distinguish the goods or services of the members of an association from those of other undertakings
- ▶ Geographical origin is not relevant to establishing identity or similarity under Article 8(1)(b)
- ▶ The criteria for assessing the risk of an injury consisting of an unfair advantage differs depending on the customer referenced

- ▶ The Darjeeling PGI



- ▶ A Delta Lingerie figurative mark



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Some effort required

Lara Elder explains why a Primark slogan prevailed

IN THIS DECISION, the General Court (GC) said that the Board of Appeal (BoA) was right to reject an application for a declaration that LOVE TO LOUNGE, registered for clothing, footwear and headgear, was invalid. The mark was not descriptive and required “cognitive effort” on the part of consumers.

BACKGROUND

In August 2009, Primark Holdings applied to register LOVE TO LOUNGE as an EU trade mark for “clothing, footwear [and] headgear”. Registration was granted in January 2010.

In 2013, Lidl Stiftung & Co KG sought a declaration of invalidity on grounds of descriptiveness and lack of distinctive character. Lidl’s application was rejected, and the BoA agreed. Turning to the GC, Lidl argued that the lower court erred in finding the expression “love to lounge” not descriptive and capable of indicating commercial origin. Lidl also claimed that its evidence was incorrectly assessed. The Court disagreed.

ASSESSING EVIDENCE

Lidl relied on the results of an online search to show that the expression “love to lounge” is common and descriptive. (Primark said at least one of these amounted to infringing use.) Lidl’s evidence was found to be inconclusive; screenshots were either undated or dated after the relevant date, and did not show that was unequivocally descriptive. The BoA did not err or base its conclusion on insufficient evidence, said the Court, and nor was there any onus on Primark to prove infringing use.

Since registered marks are presumed to be valid, it is for the applicant to invoke specific facts that call validity into question. Moreover, the applicant’s evidence must show the situation as at the relevant date, not later. The fashion industry is constantly evolving. Five years is long enough, the Court said, for the public’s perception of certain words to change “according to new trends and cultural globalisation”.



There is nothing surprising in the Court’s assessment here. LOVE TO LOUNGE was not synonymous with “loungewear” or “loungers” in the sense of leisurewear, but simply a “vague and evocative message alluding to a particular interest or pleasure in relaxing”. Lidl failed to prove otherwise.

SUMMARY

The Court gives a pithy summary of the case law on slogans. Laudatory marks are not incapable of distinguishing commercial origin; they may perform both functions. Slogans cannot be required to display “imaginativeness”, but they must not be perceived merely as a promotional formula. Lidl’s comparison with the unacceptable LET’S GET COMFORTABLE for furniture was unpersuasive. That slogan merely told consumers about goods that facilitated their comfort. By contrast, LOVE TO LOUNGE required some “cognitive effort” to link it to the goods concerned. It was not highly imaginative, perhaps, but “original to a degree which was likely to be remembered by consumers”.

Ultimately, the case is a reminder that invalidity is for the applicant to prove, evidence should speak to the relevant date and no two slogans are equal.

KEY POINTS

- ▶ Remember that registrations are valid until proven otherwise - the evidential burden falls on the applicant for invalidity
- ▶ Evidence must show the situation as at the relevant date - five years may be enough for our perception of words to change
- ▶ Distinctiveness does not require imaginativeness, but should make the consumer think twice



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Distinctive to the maxx

Emmy Hunt describes the surprising result of an otherwise consistent decision

THE GENERAL COURT (GC) has upheld the decision of EUIPO's Board of Appeal (BoA) in finding that an EU trade mark application for the stylised form of NARAMAXX (shown right) was confusingly similar to the NBC Fourth Realty Corp's (the Opponent's) earlier Bulgarian right in the mark MAXX. The Opponent is the owner of the TK Maxx brand (and associated rights).

The BoA, when comparing the earlier Bulgarian registration for MAXX with NARAMAXX, found that the signs had an above average visual and phonetic similarity. The BoA decided that, conceptually, MAXX would have no meaning to the Bulgarian consumer, and so the conceptual comparison of the marks was neutral. As the earlier mark had an average degree of inherent distinctive character, there would be a likelihood of confusion.

The parties had agreed that the goods and services covered by the application were broadly identical or highly similar to those covered by the earlier right. Consequently, the key issue raised by the Applicant for the GC to address was whether the visual, phonetic and arguable conceptual differences between the earlier mark MAXX and NARAMAXX were sufficient to avoid a likelihood of confusion. In particular, was the element "maxx" sufficiently distinctive that its mere inclusion as part of NARAMAXX was enough to establish a likelihood of confusion?

STRAIGHTFORWARD

This case demonstrates the straightforward and unsurprising approach of the GC in comparing the earlier marks with the stylised

NARAMAXX mark. The GC agreed with the BoA and found that the sign MAXX has no conceptual meaning for Bulgarian consumers. There was no laudatory connotation, as the term "maxx" would not be understood to refer to the word "maximum", as it might for English speakers. It was notable that Bulgaria uses the Cyrillic alphabet.

The GC went on to consider the visual appearance and phonetic similarity of the signs with reference to established case law and found that there was an above average degree of similarity. In combination with the agreed identity and similarity of the goods and services, a likelihood of confusion was inevitably found.

CONSISTENT

The GC's decision to uphold the earlier finding of the BoA is not surprising, and is based on a consistent reasoning. However, it is perhaps more startling that the Opponent found it so easy to establish rights in a sign that seems widely used in the English language to refer to the laudatory word "maximum". It serves as a reminder of the unexpected linguistic differences that can occur in different EU Member States, and which can be crucially important in clearing trade marks for wider use and registration in Europe.

KEY POINT

► An earlier registration of the word mark MAXX in Bulgaria was sufficient to prevent registration of a similar mark that featured the suffix "-maxx" as an EU trade mark

► The NARAMAXX mark



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events

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◀ Our 2018 programme of lectures and webinars will be announced soon. Watch this space and check citma.org.uk for details

SUGGESTIONS WELCOME

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

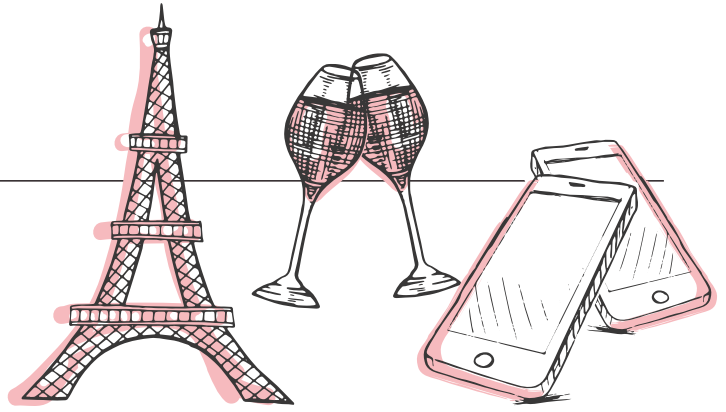
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DATE	EVENT	LOCATION	CPD HOURS
8th March	CITMA Scottish Quiz	Le Monde Hotel, Edinburgh	
21st March	CITMA Intensive Training Seminar IP contracts	Bird & Bird, London EC4	3
21st–23rd March	CITMA Spring Conference IP in a global economy	TBC, London	9
21st March	CITMA Networking Drinks Reception Part of CITMA Spring Conference	TBC, London	
22nd March	CITMA Gala Dinner Part of CITMA Spring Conference	TBC, London	
28th March	CITMA AGM & CITMA Benevolent Fund AGM	Charles Russell Speechlys, London EC4	
19th April	CITMA Designs Seminar – London	Allen & Overy, London E1	2.5
7th December	CITMA Northern Christmas Lunch	TBC	
14th December	CITMA London Christmas Lunch	London Hilton on Park Lane, London W1	



THE TRADE MARK 20

Q&A



I work as... a Trade Mark Attorney (Associate) at Bristows LLP.

Before this role, I... spent four years at Keltie LLP. I am French, from Paris, and I gained experience in trade mark law outside the UK when I worked at Cabinet Plasseraud. Before that, I spent a few years at the University of Paris 1 Panthéon-Sorbonne, where I graduated with a Master of Laws (LLM), and then I achieved an LLM in IP from Queen Mary University of London.

My current state of mind is... happy.

I became interested in IP... while taking a law course by the well-known Professor Pierre Sirinelli at the Sorbonne. I thought that IP was the most interesting area of law, playing a significant role in our society, given that it is closely associated with culture, technical progress and innovation.

I am most inspired by... *Siddhartha*, the 1922 novel by Hermann Hesse about one young man's spiritual journey of self-discovery.

In my role, I most enjoy... researching convincing arguments when drafting submissions.

In my role, I most dislike... dealing with invoices.

On my desk are... two iPhones, three screens, four piles of papers and (for the moment) just one coffee.

My favourite mug says... "Never give up".

My favourite place to visit on business is... Milan. It is a dynamic city associated with fashion, design,

business and great food, without forgetting the sensational spa and garden of the Bulgari Hotel.

If I were a brand... I would wake up as the iconic Apple and hope to reflect its beautiful minimalism. I would then be Ralph Lauren during the day for its equestrian culture, and finally become Ruinart Blanc de Blancs for its timeless quintessence.

The biggest challenge for IP is... Brexit.

The talent I wish I had is... the ability to sing.

I can't live without... champagne. I drink champagne when I win, to celebrate, and when I lose, to console myself (à la Napoleon Bonaparte).

My ideal day would include... a glass of wine on a boat in Italy.

In my pocket are... my iPhones and my Mastercard/American Express.

The best piece of advice I've heard is... "Great things in business are never done by one person. They're done by a team of people." Steve Jobs said that.

When I want to relax, I... smoke a cigar – a Hoyo De Monterrey Epicure de Luxe.

In the next five years, I hope to... advance in my career and become fluent in Italian.

The best thing about being a member of CITMA is... the opportunity to meet people and keep up to date with current developments in IP (and even influence them).



Amelie Gerard
reveals her
continental side

“

IP plays a significant role in our society, given that it is closely associated with culture, technical progress and innovation

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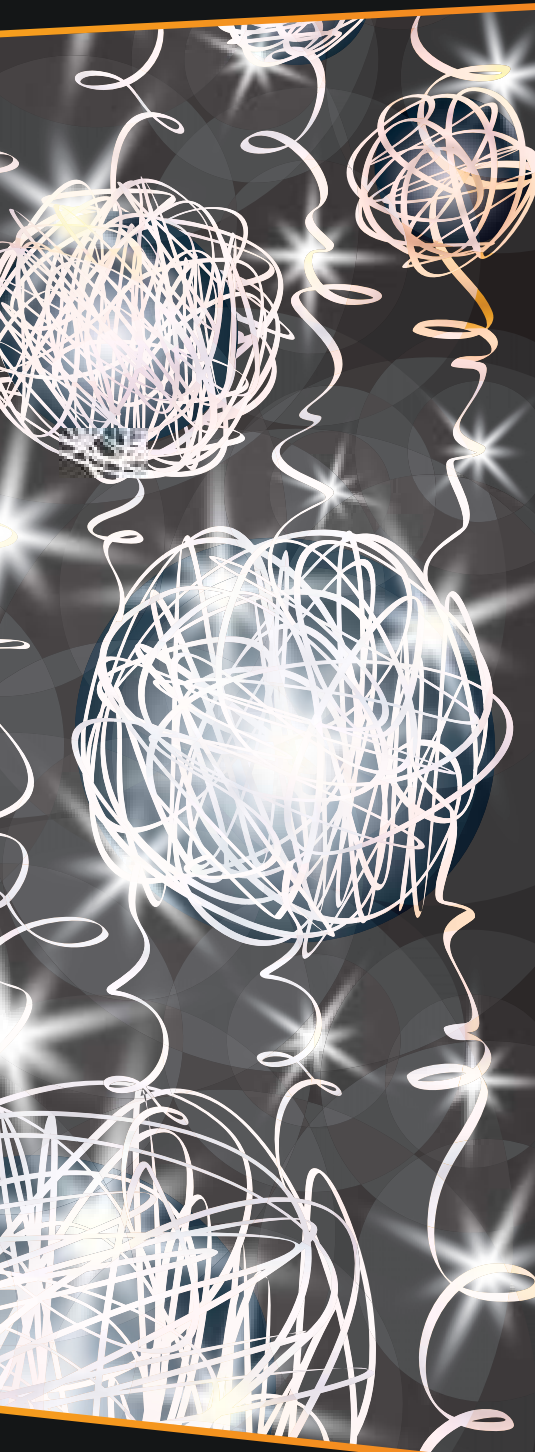
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