

CITMA REVIEW

ISSUE 472 SEPTEMBER/OCTOBER 2022

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COURSE
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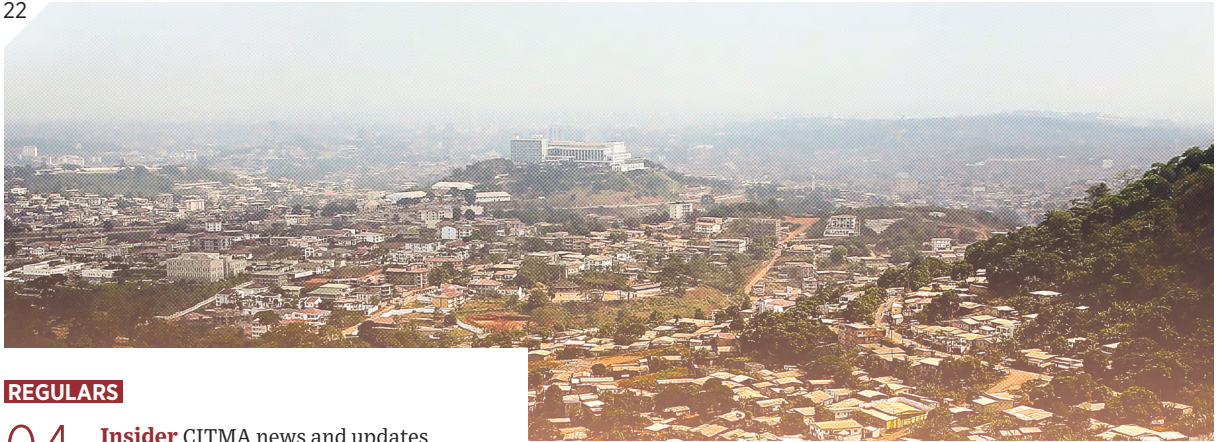


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PRESIDENT'S WELCOME THE COMING MONTHS OFFER OPPORTUNITY

As autumn approaches, I hope that you have all been able to find time for rest and relaxation within your busy schedules.

I was delighted to receive the news in July that Adam Williams has been appointed as interim CEO of the UK IPO, following his time as Director of International Policy. I look forward to continuing CITMA's close relationship with the UK IPO with Adam at the helm. I would like to take this opportunity to thank Tim Moss for all his achievements and hard work during his time in office at the IPO, and of course to wish him the best of luck in his new endeavour with the Welsh Government.

July also saw a total of 85 participants successfully complete the CITMA Paralegal Course (see story, right). This is a great achievement and a demonstration of their hard work and dedication over the past year. With the exam passed, these participants are now eligible to apply for CITMA Paralegal membership and the benefits that entails. I am sure that you will join me in congratulating all those who completed the course. We look forward to seeing what they do next.

We have a lot of opportunities coming up over the next few months for you to enjoy with the CITMA community, in particular the reinstatement of our Christmas Lunch after far too long an absence. It may still feel a long way away, but tickets are already selling fast. If you would like to join us at the Royal Lancaster in London in December, make sure to book your place soon. I look forward to seeing many of you there.

Rachel Wilkinson-Duffy,
CITMA President



CITMA Paralegal Course: CELEBRATING SUCCESS

Congratulations to the 85 participants who passed the 2021/2022 Paralegal Course. The highest mark of 98 out of 100 was achieved by Lauren Fisher of Albright IP Ltd. Everyone who passed the course is now eligible to become a CITMA Paralegal member.

This year's course will begin soon, once again aimed towards any trade mark paralegal with more than 18 months' experience. Making use of a variety of hybrid learning options, this year's course will be fully accessible to candidates all over the world.

The course touches on registered designs and domain names, ensuring that candidates leave with a full understanding of professional practice. For those who do not have sufficient experience to embark on this course just yet, the Introduction to Trade Mark Administration and Formalities Course offers a solid foundation in IP.

Find out more at citma.org.uk/paracourse22

OUR AUTUMN CONFERENCE IS NEARLY HERE

12th October will see CITMA members 'Stepping into the future' in Birmingham. Register now at citma.org.uk/events

Congratulations to:

- Eilidh Anderson
- Shaun Anderson
- Lubna Baquer
- Phoebe Bird
- Natasha Black
- Sarah Bradley
- Melissa Buamah
- Julia Buckingham
- Vasile Daniel Bura
- Maria Casas
- Sophie Charalambous
- Greta Cicchetti
- Danielle Coleman
- Jamie Collins
- Hannah Colton
- Ciara Conlin
- Sue Corlett
- Adeline Couvert
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- Alexandra Cummings
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- Sharn de Klerk
- Hristo Dimchev
- Lauren Edmonds
- Lauren Fisher
- Lidia Foerster
- Chloe Forbes
- Andre Fortunato Da Silva
- Dorothee Frey
- Mark Gardiner
- Daniella Garvey
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- Caroline Linnane
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- Angela Martin
- Claire McLennan
- Steven Miller
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- Katarina Nikolic
- Julie Nilsson
- Bolaji Olowofoyeku
- Guilherme Pagani
- Richard Prentice
- Elijah Rabor-Bell
- Zainab Rhyman Saib
- Max Rivers
- Courtenay Robson
- Indira Seetaram
- Rishi Shah
- Lidia Sidorenko
- Daniel Stanley
- Natasha Tait
- Hannah Thomas
- Anna Torpey
- Ross Warren
- Eloise West
- Lorraine White
- Orlaith Wilkinson
- Lucy Witherington
- Martha Wojtowicz
- Ping Kim Benjamin Wong
- Yim Ping Wong

Well done to
high-scorer
Lauren Fisher, with
her mark of 98%



WIPO DATABASE

More than three million UK trade marks will be added to WIPO's Global Brands Database after the UK IPO signed a cooperation agreement. UK-registered trade marks will now show up in searches of the database made by anyone around the world. Read more at citma.org.uk/wipodata



ADAM WILLIAMS WELCOMED

From 1st September 2022, Adam Williams steps in as interim CEO of the UK IPO. Tim Moss, who has held the post since 2017, is moving to take up a new role as Director General and COO of the Welsh Government. Read more at citma.org.uk/adamwilliams



EXCELLENCE RECOGNISED

We are proud to have been shortlisted for two Association Excellence Awards. These nominations are for our Introduction to Trade Mark Administration and Formalities Course as Best Learning Programme and our Spring Conference as Best Longstanding Event. Read more at citma.org.uk/excellenceawards



REACHING EVERYONE

Andrea Brewster points the way to a truly inclusive workplace

Although our founders were mainly attorneys, IP Inclusive exists for everyone who works in the UK's IP sector.

For us, "inclusivity" means welcoming and respecting people not just regardless of their legally protected characteristics such as gender and race, but also regardless of the organisation they work in, the role they play there and the level they've reached in their career.

It's easy to think of EDI (equality, diversity and inclusion) in terms of improving, say, the gender and ethnicity balance in the boardroom, or recruiting a more diverse pool of graduates. Of course, those things do matter. But gone are the days when the attorneys alone – in particular the senior ones – set the culture of the IP organisation or department.

A successful IP team now has many crucial components, including secretaries, paralegals and other so-called "business support" professionals, such as those in HR, IT, finance, marketing and practice management. These people are just as important as the attorneys. Their sense of belonging, so closely linked to their productivity, impacts strongly on the efficiency of the business and its capacity to attract and retain good staff.

A savvy employer understands the importance of a truly inclusive workplace, which takes account of all team members. So here are some practical things you can do to improve inclusivity in yours:

1 Ensure that people in all roles and at all career levels are represented on your internal EDI committees, working groups and discussion forums. Show them that they are part of the EDI debate and can help shape, and benefit from, the action taken in response.

“

*So-called
'business support'
professionals are
just as important
as attorneys*

2 Encourage all staff to attend meetings and training events on EDI. That includes internal training sessions, IP Inclusive events and appropriate external opportunities.

Remember support staff and/or more junior colleagues may feel less confident requesting time out or expenses for events. So why not invite them to go to one with you? Or stream an EDI

webinar and bring people from across the firm to watch and discuss it together.

3 Include EDI-related activities and learning in everyone's appraisals and career development plans.

4 Avoid making assumptions about people based on their role in the organisation. Take the time to ask about their career ambitions, what they're good at or enjoy doing and the environment they want to work in. Broaden their contributions if you can.

5 Recruit with an open mind. Finding more male paralegals may be just as important as finding more female or non-white attorneys. Check how you are advertising for particular roles – the images you use, the language in the job description, the essential skills and experience you demand.

Above all, never overlook your colleagues. Any of them. The more included they feel, the more they can contribute. And the wider the range of those contributions, the more successful your business will be. ●



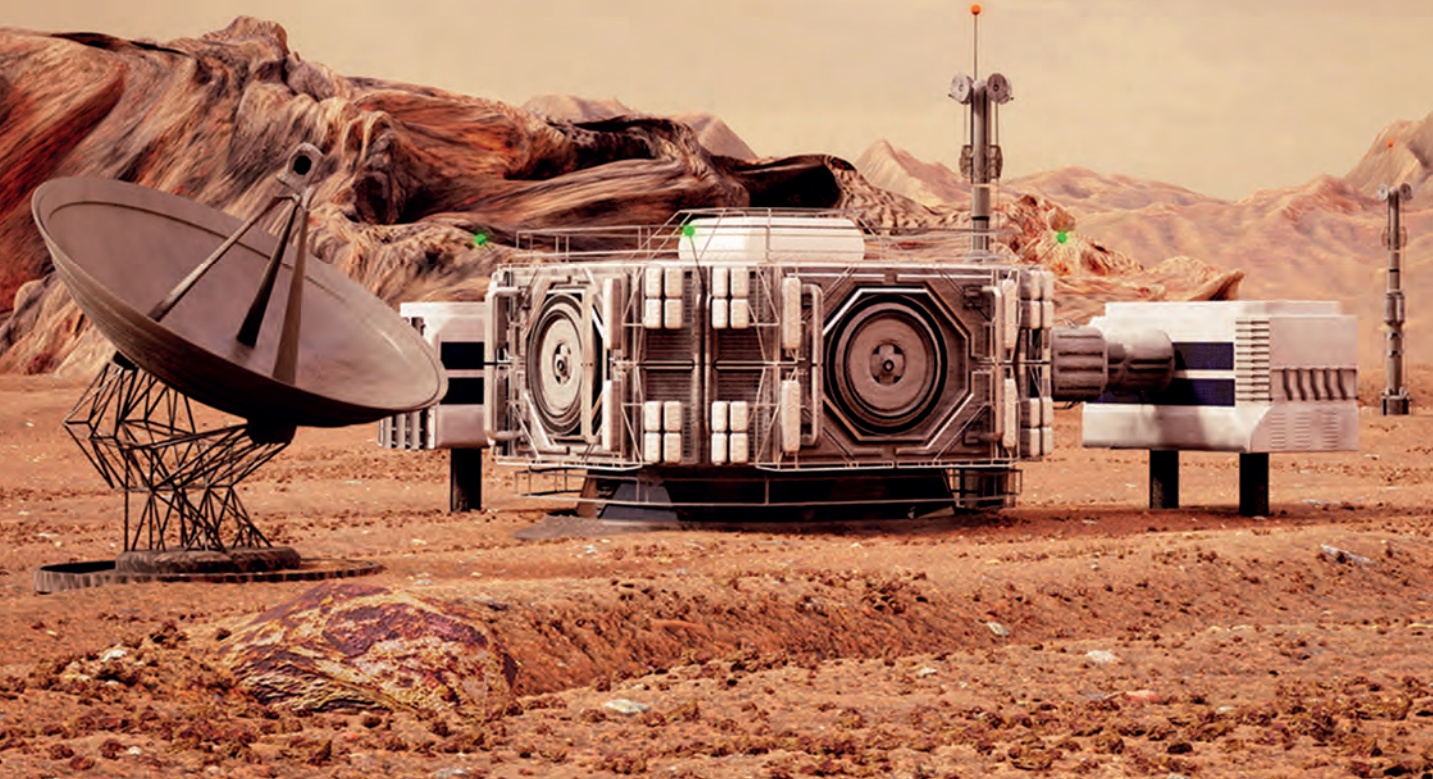
Andrea Brewster OBE

is Lead Executive Officer at IP Inclusive

Find out more at ipinclusive.org.uk

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YET.



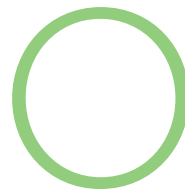
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SUN SHINES ON OUR PROFESSION

The return of our Summer Reception was graced with perfect conditions



On 5th July, some 200 members of our profession came together to enjoy the evening sunshine in the

beautiful Inner Temple Garden in central London. Wildflower borders and the historic Temple complex provided a unique backdrop to the CITMA Summer Reception – the first such event since 2019.

Tasty canapés, bubbly and sparkling elderflower cordial were among the treats available to guests while they enjoyed catching up and making new connections.

Our recently elected President Rachel Wilkinson-Duffy addressed the audience, which comprised

Chartered Trade Mark Attorneys, barristers, CITMA Paralegals and judges among a host of other guests. Rachel set out her plans for CITMA over her two-year term in the role. At the top of her agenda, she explained, are representation rights, championing diversity and inclusion, international liaison and empowering Chartered Trade Mark Attorneys to utilise their litigation rights.

Rachel also paid tribute to Sheila Lesley, CITMA's first female President, in whose name we were due to have the first of what will be an annual honorary lecture. Unfortunately, Mrs Justice Bacon, who was due to give the lecture, was unable to attend due to illness on the day. ●



President Rachel Wilkinson-Duffy set out her plans for CITMA over her two-year term in the role





HOW ABOUT HAGUE?

There are benefits to be reaped from this registration system, says William Burrell

In the context of protecting design registrations in Europe, what often first springs to mind is its application for protecting physical products with a 3D aspect, or perhaps even a graphical user interface. Often overlooked, however, is how a design registration can be used to protect other designs, such as surface ornamentation, graphical symbols and logos.

This is quite right perhaps, since when it comes to such 2D designs, other forms of IP protection are more obvious – most notably trade mark protection. That being said, it always pays to consider whether design registration protection could act as a useful supplement to (or replacement for) trade mark protection.

For instance, a logo or some other new graphical mark/symbol may well not be that distinctive at the point of conception, making trade mark protection at an early point impossible. Equally, it may be that such a mark/symbol is intended to only have a relatively short lifespan (perhaps only a few years), which may make the cost of trade mark protection unwieldy. In these instances, design registration protection comes neatly into the frame.

Indeed, unlike trade mark protection, design registration protection makes no requirement for the design in question to have sufficient distinctiveness. As long as the design has not been publicly disclosed for an undue period of time (usually less than a year, noting

many territories in Europe operate a 12-month novelty grace period in respect of design registration protection), the design may notionally be registrable. Another advantage is that, in many parts of Europe, a design registration can often be achieved in just a few weeks, making protection readily applicable to those marks/symbols that are intended to have a limited period of use.

LACK OF LIMITS

Design registration protection in many European territories also has the distinct advantage that it is not limited to a particular set of goods. So, unlike a trade mark, which requires protection to be applied for in respect of particular goods and services, design registration

protection in the UK and EU will notionally cover usage of the design in respect of any goods employing that design.

With its usefulness so established, what is the best route for obtaining design registration protection?

There are two main routes:

1. Protection via separate national design registrations in each territory of interest (eg, a separate pair of UK and EU registered design applications); or
2. Protection via the Hague design registration system.

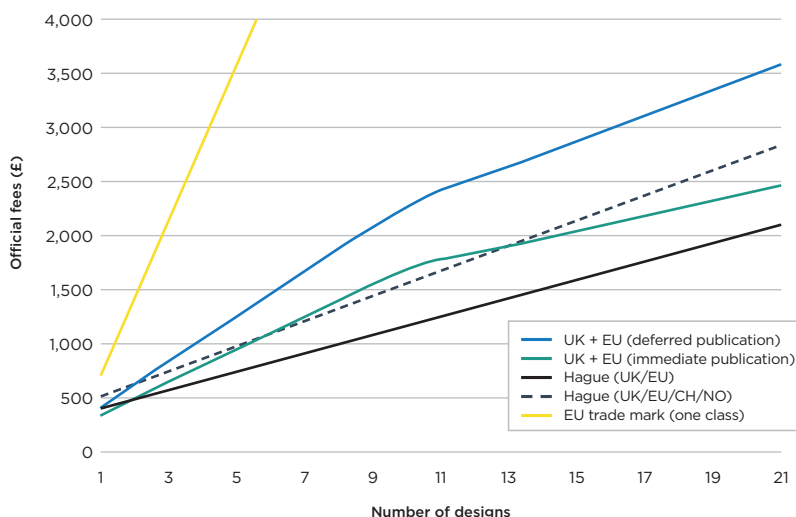
While the 'national' route may have some advantages, in the instances we've highlighted – and particularly where the idea is to seek design registration protection in Europe for multiple marks/symbols simultaneously – usage of the Hague design registration system may be the most cost-effective route. Indeed, at least in respect of design registration protection in the UK/EU (including Germany), it is possible to pursue multiple designs in a single registered design application. This can result in cost savings compared with pursuing each design in a separate application.

To place this in context, Figure 1 (above) outlines the approximate official fees (in pounds) for pursuing design protection in respect of a set of marks/designs via the national route or the Hague design registration system as part of a given registered design application.

One thing to note immediately is that if design registration protection is sought via the national route in the UK/EU, additional official fees are payable if deferred publication is requested (this allows the drawings of each design to be kept unpublished for a period of time after the design registration is allowed). Under the Hague design registration system, however, whether deferred publication is requested or not, the official fees stay the same.

What is clear, however, is that, particularly if there are a few marks/symbols being sought for protection at the same time, it can often be cheaper to obtain the design registration protection via the Hague system.

Figure 1: Typical official fees for single view logo designs – Hague/non-Hague



ECONOMY OF SCALE

Figure 1 also includes the official fees for pursuing a Hague design registration when more comprehensive European protection is required – namely, protection in all of the UK, EU, Norway and Switzerland (Norway and Switzerland also allow registered design protection for logos/symbols). In these cases, the cost saving from using the Hague design registration system really comes into its own.

It is also stark that the official fees for design registration protection are markedly lower than the official fees for obtaining an EU trade mark (EUTM) in just one class. Indeed, the official fees to pursue a Hague design registration in all of the UK, EU, Norway and Switzerland are cheaper than the official fee to obtain an EUTM in just one class.

Tempering the virtues of design registration protection that we've discussed, it must be noted that the versatility of trade mark protection may prove more valuable over the longer term. Design registration

protection in many of the above territories is limited to a maximum duration of 25 years, whereas a trade mark may in principle have an unlimited duration (so long as usage of the trade mark is maintained over the entire period). Moreover, a trade mark may be notionally enforced in respect of third-party marks that are confusingly similar to the mark in question; a design registration in these instances may be more difficult to enforce.

In any case, it is clear that the design registration system in Europe is an extremely powerful and cost-effective tool, and can be an effective supplement to any trade mark protection considered for a potential set of graphical marks/logos/symbols intended for use in Europe. It may also compensate for a lack of trade mark protection where such protection is deemed not practically advisable or too expensive. Indeed, considering the modest official fees involved, the protection gained from such a registration may represent excellent value for money. ●



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COURSE CORRECT

Our concise guide makes it simpler for firms and trainees to navigate the qualification choices



WITH THANKS TO CO-AUTHORS
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AND GAIL NICOL (CAMERON IP)

Qualification as a Chartered Trade Mark Attorney requires the successful completion of two postgraduate courses and at least two years of on-the-job training under the supervision of a qualified trade mark attorney or other suitably qualified mentor. There are a number of options available to trainees for the first postgraduate course and, while this offers some choice and flexibility, it can be difficult for trainees and firms to know which option is most suited to their specific circumstances and requirements.

Some trainees and firms have also found that it is not easy to access all the relevant information needed to make an accurate comparison. This article aims to make this task easier.

To quickly recap, the path to becoming a Chartered Trade Mark Attorney can have a variety of starting points, including a law degree (although other degrees can be useful) or work as a paralegal. The next step should then be to secure a trainee role in IP. This could be at a firm that specialises in IP, a full-service law firm with an IP department or as part of a corporate in-house IP department.

Once you are in post, firms will usually pay for trainees to undertake the formal qualifications required to become a Chartered Trade Mark Attorney. The training route that will follow is not “one size fits all” and each trainee and firm will have different requirements and limitations.

ASSESSING YOUR OPTIONS

The good news for trainees and their firms is that there are several options available for the first postgraduate course and all of these provide an excellent track record of pass rates. The bad news is that there are many other factors to take into account and, without having previous direct experience of each course, it can be difficult to know which option is most suited to a particular trainee or firm. As a result, many firms opt to send their trainees on a

I chose my course because...*

*“I initially chose **Brunel** as it was close to home in London. The fact that the full course was conducted online made it super accessible. I found the course extremely practical with useful working scenarios to help with an insight of working practices. The lecturers were absolutely great and fully supportive, and assistance was always at hand in relation to any concerns. It was tough but extremely engaging. Guest lecturers were all high-profile individuals from the industry and relevant organisations.”*

*“I attended **Brunel University** and studied the Postgraduate Certificate in Intellectual Property Law. The main reason was that successful completion of this course exempted me from the foundation exams under the old trade mark qualification system. Another benefit was that the course was one full day a week at the campus in Uxbridge, meaning I could easily commute there from central London without any residential weekends. The flexibility and scope of the course content was also an important factor, as I wanted to have a good understanding of copyright and designs, as well as a basic working knowledge of patents – and the course provided this. The fact that guest lecturers from private practice and industry were common was also a plus point; it was good to pick up practical tips from experienced people who had been working in IP for a number of years.”*

particular course due to familiarity of content or proximity of the course to its office, rather than making an informed decision based on all the options available.

Some of the key factors to consider when making training decisions are:

- cost (including costs related to travel and accommodation);
- location;
- course content and syllabus and the suitability to the work the trainee is involved in;
- start date of the course and registration deadlines;
- duration and structure of the course, including the number of days away from the office;
- availability of remote learning options;
- assessment style, including whether this is by coursework and/or exam;
- exemptions available based on previous academic qualifications; and
- previous trainees’ experience and feedback.

Across the next few pages, we’ll set out some information on each of the available options to assist with comparison and decision-making. The information provided is accurate at the time of writing, but future students should check the most up-to-date information with each course provider before signing up.

WHAT NEXT?

After completing the first postgraduate course, candidates must undertake the Professional Certificate in Trade Mark Practice at Nottingham Law School. This course is specifically designed to build on the knowledge gained in the first year of study and to develop the professional skills needed to be a Chartered Trade Mark Attorney.

There is no obligation on students to commence the second postgraduate course straight after completing the first. Some students find there is value in staying within their cohort and all moving on to the second course together, ▶

benefiting from the connections they have made and their shared study experience. Other students have found that taking time to gain more experience in their role and expand their knowledge and network is the best move. Everyone is different of course, and students should discuss their training and development plan with their mentor to decide when to begin the Nottingham course.

Once qualified, an attorney can apply to be entered onto the Register of Trade Mark Attorneys, maintained by IPReg, and will need to complete 16 hours of continuing professional development (CPD) each year to stay on the Register. An attorney can also apply to become Chartered via election as an Ordinary member of CITMA.

END GOAL

The end goal, of course, will be to pass the required courses and to gain sufficient well-rounded experience alongside the academic pathway.

Undertaking studies while working can be a challenging and intense period, particularly in the lead-up to exams. However, the combination of theory and practice is designed to ensure that, on reaching qualification, candidates have a grasp of the relevant legal knowledge and how to apply it.

As Aristotle put it: "What we have to learn, we learn by doing." There really is no substitute for rolling up one's sleeves and getting stuck into real-world work. A trainee will be mentored throughout the training journey by a qualified attorney who can advise on balancing client demands and deadlines with study and training time. ●

Get in touch

We are keen to support our Student members and offer a range of useful resources on the CITMA Student Members' Hub at citma.org.uk/students. Students can also contact the CITMA Student Representative, Gail Nicol, with any feedback, questions or concerns by email at citmastudentrep@gmail.com

BOURNEMOUTH

I chose my course because...*

*"I chose the **Bournemouth** course because it required less in-person attendance overall and only ran from January to May/June. I found this particularly beneficial as a disabled person. In addition, Bournemouth has fewer exams and more coursework, which may be preferable to some people. This was preferable for me as I struggle with the physical demands of exams, but this could also be beneficial for a variety of other reasons."*

*"I chose the **Bournemouth** course as, while the patent exam and coursework definitely pushed me outside of my trade marks comfort zone, I knew it would be useful in the long term to have a broader understanding of the IP rights our clients may require. I also found the thorough design teaching a useful foundation for the Nottingham course, in which we are also examined on design rights. Another aspect was that the majority of the Bournemouth assessments were coursework essays rather than timed exams - I found this to be less stressful and easier to manage alongside my professional workload. I spent an estimated four to eight hours outside of lectures per week on independent study. This varied depending on the bits of homework set per week."*

QUEEN MARY

I chose my course because...*

*"When researching the process involved in qualifying as a trade mark attorney, it seemed that the **Queen Mary** course was more prominent in comparison to the Brunel and Bournemouth courses. Having also spoken to practitioners within the profession, the Queen Mary course was the preferred one to place trainees on. Having undertaken the course during the pandemic, and before securing a trainee position, these factors influenced my decision to study at Queen Mary."*

*"I discussed which course to choose with our head of trade marks. As a former **Queen Mary** student herself, she gave me insight into her own experience, which was helpful in making my decision. But, ultimately, it came down to what worked best for me and my employer. I chose Queen Mary due to its excellent reputation and access to lecturers and practitioners who are at the very top of their field. I found the course to be incredibly informative and very enjoyable. There is a lot of reading on this course - I found I spent around eight to 10 hours each week on reading and study, and this significantly increased leading up to exam time."*

* Note: course specifications may have changed since these courses were completed. Check the most up-to-date information with any course provider before signing up. CITMA cannot recommend or endorse any particular course or provider. The decision as to which is most suitable is entirely at the discretion of each trainee and firm.

Over the page you will find a table comparing the offering of four first-year postgraduate courses in IP



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

Trade Mark Attorney : London or Cambridge **CEH138606**

Leading full-service IP practice seeks a Trade Mark Attorney, from finals standard through to circa 5 PQE, ideally London based or within their Cambridge hub. With a meritocratic ethos, the team have active Partners and excellent training structures to ensure you receive an outstanding level of support to fully enrich your career. Of particular interest, are those commercially informed candidates who relish all aspects of business development with a focus on future growth.

Trade Mark Attorney/IP Solicitor :
London or South Coast **CEH137148**

Are you a Trade Mark Attorney or IP Solicitor with 2-4 years PQE? A formidable, top tier, award winning, IP practice who operate on the global stage require your talents! Your expertise will be key in providing an unrivalled service and advice to clients across the protection and enforcement of trade marks. Whilst strengthening ties with existing clients, you'll thrive on business development activities and build on your overseas network of associates and offer excellent support and training to junior members.

Trade Mark Attorney : South West **CEF138030**

Fast growing IP practice seeks a brilliant finals standard or qualified Trade Mark Attorney to join their accomplished team. Flexibly based out of one of their south west offices, there is plenty of existing work and to be proactive in business development if you wish. Acting on behalf of large corporate and multinational clients, this is an outstanding opportunity to develop your career within a supportive, inclusive and forward thinking environment.

Trade Mark Attorney : Birmingham **CEH136398**

Exceptional IP practice is strategically expanding and keen to welcome a talented Trade Mark Attorney into their collegiate Birmingham office. If you're looking for a nurturing platform from which to further hone your skills, passion and enthusiasm, then look no further! You will ideally be newly qualified up to 4 years PQE and be welcomed into the sizeable team. In this dynamic and meritocratic environment your career will thrive.

Part-Time Trade Mark Attorney : Surrey **CEF138528**

We are delighted to be working with a progressive IP practice with a boutique feel. With a wide range of interesting and high-quality work on offer, their friendly team are seeking an experienced Attorney on a part-time 3 day a week basis. If you are a seasoned professional looking for a flexible role within a balanced and supportive environment offering an excellent remuneration, then please do get in touch!

Trade Mark Associate : London **CEF134450**

Our client, a switched on, progressive law firm, who is committed to making a positive impact not only directly to their clients and people, but also to the environment and society who seeks a Trade Mark Associate. Excellent on so many levels, this unique opening has come about due to natural growth within the litigation and commercial teams. Enjoy the balance of an office/home working mix, this role is a golden opportunity to achieve both career and life satisfaction!

Trade Mark Paralegal : London **TJB138130**

We are working on behalf of a unique London based law firm with capacity to welcome an experienced Trade Mark Paralegal. Sitting within the Brands, Design and Copyright team, if you have a solid, confident grounding and seek a new challenge, then this role will not disappoint! Preferably CITMA qualified, organised and methodical you will support the Trade Mark Attorneys across tasks pertaining to the trade mark life cycle and have exposure to prestigious global clients.

Trade Mark Paralegal : Bristol **TJB138549**

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

Trade Mark Secretary / Paralegal : London **TJB137501**

Highly regarded, mid-sized IP practice have an opening for an organised Trade Mark Secretary/Paralegal to support their friendly trade marks team. A great mix of work is on offer including client and foreign attorney liaison, correspondence, document and case management, invoicing as well as preparing/filing trade mark applications. Develop your skillset via their excellent training framework and hybrid working is well established.

Trade Mark Paralegal : London **TJB138081**

Outstanding Trade Mark Paralegal sought with ideally 2+ years demonstrable track record. Preferably CITMA qualified, join this market leading IP practice who thrive on teamwork and collaboration. You'll expertly assist trade mark fee earners in managing all aspects of their client portfolios, therefore, it's essential that you can work on your own initiative. A good work/life balance, flexible working and excellent salary prospects await.

For further information about this selection of opportunities or to discuss any other aspect of IP recruitment, please contact:
Tel: +44(0)113 245 3338 or email: lisa.kelly@saccomann.com
catherine.french@saccomann.com • tim.brown@saccomann.com
or clare.humphris@saccomann.com

www.saccomann.com

Scan the QR Code
for our website



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

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

Course by course: Academic year 1

	Brunel University London, Intellectual Property Law Postgraduate Certificate	Bournemouth University, Postgraduate Certificate Intellectual Property	Queen Mary University of London, Trade Mark Law and Practice Postgraduate Certificate	Queen Mary University of London, Intellectual Property Law Postgraduate Certificate
General				
Start date and duration	September (8 months) or January (12 months, including summer break)	Early January to end May (5 months)	Mid-September (9 months)	Mid-September (4 months)
Course structure	<ul style="list-style-type: none"> Intensive online sessions on Wednesdays 	<ul style="list-style-type: none"> Teaching on weekends from early February until April (Thursday pm to late Saturday pm) Follow-up weekend sessions before assessments are scheduled via Zoom, after 5.30pm Students also complete weekly e-activities in their own time Lectures are recorded 	<ul style="list-style-type: none"> Between 10 and 12 sessions (module dependant) plus tutorials and review classes Attendance in person is required 	<ul style="list-style-type: none"> 3 weeks out of the office (1 week intensive, followed by 4-5 days of lectures for 12 weeks) Sessions are held only on weekdays, with specific days variable Attendance in person is required Live lectures are recorded for content to be revisited
Cost (based on 2022/2023)	£3,690	£5,115	£8,750	£8,750
Additional travel/accommodation costs	N/A (online course)	✓ for 3 x teaching weekends	✓ for trainees based outside of London	✓ for trainees based outside of London
Entry requirements	<ul style="list-style-type: none"> Bachelor's Honours degree (2:2) in any subject Time in practice will be considered 	<ul style="list-style-type: none"> Bachelor's Honours degree (2:2) in any subject Time in practice will be considered and an interview undertaken if not at degree level 	<ul style="list-style-type: none"> Applicants with a degree: 2:2 or above in any subject plus 6 months' experience within the IP field in a trainee position or similar Applicants without a degree: to be ascertained with the course provider 	<ul style="list-style-type: none"> Applicants with a degree: Minimum 2:2 undergraduate degree from any subject area with a suggested minimum of 6 months' experience and sponsorship by an employer Applicants without a degree: to be ascertained with the course provider
Approximate number of days out of office	N/A (but see course structure section above)	6 full days, 1 exam	Between 10 and 12 sessions (module dependant) plus tutorials and review classes	4-5 days a week from September to December; generally, trainees are out of the office for 13 weeks
Course content includes trade marks, patents, designs and copyright	Yes	Yes	Yes	Yes
Unique to this course	N/A	International IP practice unit which focuses on practical application; guest speakers every Thursday during the 3 teaching weekends	Lectures about Chinese and US trade mark law	In-depth patent module; this would be a good choice for a trainee who would like to dual-qualify as a patent attorney

	Brunel University London, Intellectual Property Law Postgraduate Certificate	Bournemouth University, Postgraduate Certificate Intellectual Property	Queen Mary University of London, Trade Mark Law and Practice Postgraduate Certificate	Queen Mary University of London, Intellectual Property Law Postgraduate Certificate
Delivery method				
Location	Online	3 x in-person teaching weekends in Bournemouth with remote option also possible	In person in London, at Lincoln's Inn Fields, Charterhouse Square or West Smithfield; distance learning is not available, but all lectures will be available online	In person in London, in the vicinity of Lincoln's Inn Fields and/or Charterhouse Square or West Smithfield; distance learning is not available, but all lectures will be available online
Lectures	Yes	Yes	Yes	Yes
Group work	Yes	Yes	N/A	N/A but some tutorials may be given before the exam or assessment
Set tasks/work in between lectures	Yes	Yes	Occasionally	No
Recommended time for independent study	3-5 hours per week	36 contact hours (during 3 teaching weekends) + approx. 12 hours per week for e-activities in between the teaching weekends	13-14 hours per week	42-43 hours per week
Individual feedback provided?	Yes	Yes for all assessments; for weekly e-activities, general feedback is provided; students are contacted individually if the teaching team identifies any concerns through the submission of e-activities	Varies by module	No, but most lectures end before time to allow for questions
General feedback	Yes	Yes	Yes	Yes
Software used to access materials	BlackBoard	Brightspace/Turnitin	Proprietary software (QM plus)	Proprietary software (QM plus)
Free access to databases such as Westlaw and Lexis?	To be ascertained with the course provider	Yes, plus free access to Practical Law guide, HeinOnline and access to practitioner-focused journals such as <i>Managing Intellectual Property</i>	Yes, plus free access to all major trade mark textbooks and publications via the Queen Mary library	Yes, plus free access to all major trade mark textbooks and publications via the Queen Mary library
Assessment				
Coursework	<ul style="list-style-type: none"> 1 x coursework, weighting 100%, for Managing Intellectual Property Law 1 x coursework (pass/fail) for the English Legal System 1 x coursework, weighting 100%, for Comparative and International Trade Mark Law 	<ul style="list-style-type: none"> 1 x coursework for Copyright and Trade Marks 1 x coursework for Patents and Designs 2,000 words coursework (worth 40% of the International IP Practice module) 	No	No
Exams	<ul style="list-style-type: none"> 1 x 2hr exam, unseen examinations weighting 100% for Patent Law and Practice 1 x 2hr exam, weighting 100%, for Trade Marks and Allied Rights 1 x 2hr exam, weighting 100%, for Copyright, Designs and Allied Rights 	Yes x 1 (worth 60% of the International IP Practice module)	<ul style="list-style-type: none"> Fundamentals of Law and Professional Ethics (IPReg FL&PE) - multiple-choice quiz (30%); 2,500-word essay (70%) Designs & Copyright Law (IPReg D&C) - exam (100%) Trade Mark Law A - exam (100%) Trade Mark Law B - exam (100%) 	<ul style="list-style-type: none"> Fundamentals of Law and Professional Ethics (IPReg FL&PE) - multiple-choice quiz (30%); 2,500-word essay (70%) Designs & Copyright Law (IPReg D&C) - exam (100%) 2 x Trade Mark Law - exams (50% each) 1 x Patent Law - exam (50%) 1 x Patent Law - multiple-choice quiz (50%)
Open/closed book exams	2 open book; 1 closed book	Closed book	Closed book	All open book
Pass rate in the past 5 years	98%	99%	99%	99%

THE CASE FOR

Geoff Steward reflects on why momentum is building to shake up the IPEC

The past few months have seen discussion in the IP community about the Intellectual Property Enterprise Court (IPEC). The questions at hand are: how is it currently operating and being used by brand owners and their legal teams? And is there a need for reform? This article examines some of the key issues that have been raised in terms of the running of litigation in the IPEC, how these issues are being addressed and the prospects for change.

As the successor to the Patents County Court, the IPEC was established under its current guise in 2017. Its stated aim was to provide a forum for streamlined IP litigation,

for claims with a value not exceeding £500,000, and with a costs cap of £50,000 – meaning that a losing party will not be ordered to pay more than £50,000 in respect of the winning party’s costs. This, in principle, makes the IPEC a relatively straightforward and cost-effective forum for brand owners to use litigation as a means to protect their IP without breaking the bank. Indeed, the IPEC Guide reminds users that: “The IPEC aims to provide a procedure for intellectual property litigation which is speedier and less costly than is the case in the rest of the High Court. It is also designed to safeguard parties from the risk of paying large sums in costs to the opposing party at the conclusion of the proceedings.”

Such a procedure is certainly needed in the world of IP. Action against infringers is most effective

when brought in a timely and easily enforceable manner, and access to justice – without the eye-watering price tag of big-ticket High Court litigation – is critical in keeping smaller brands in business (and bigger brands within their legal spend budgets).

However, it has become increasingly apparent to many of us within IP litigation practices that certain behaviours of IPEC users are resulting in disproportionately high fees to litigants, with many cases being run in a way that makes them indistinguishable from High Court litigation.

Some of these behaviours have been highlighted in recent judgments by the IPEC judges. For example, failing to trim claims to put forward the key elements of a party’s case. This was clearly an issue in the IPEC



“ Instances of these behaviours have not escaped the IPEC judiciary’s attention

case of MEI Fields Designs Ltd v Saffron Cards and Gifts Ltd & Anor,¹ where the Judge, David Stone, noted that: “The Defendants ran their case, by their counsel’s averment, like a stack of matryoshka dolls. Each defence contained another, which contained another. Pleading and disclosure issues were raised. Four contracts required interpretation. This all occupied court time, such that counsel had to cut themselves short in dealing with issues. Indeed, unusually for a copyright case, I was never actually taken to the allegedly infringing cards at issue in these proceedings.”

Similarly, in the recent IPEC case of Shazam Productions Ltd v Only Fools The Dining Experience Ltd & Ors (Rev1),² the Claimant had put forward as part of a claim eight characters said to be protected by copyright, the analysis of two scripts identifying alleged copying plus an analysis of a recording of the allegedly infringing show and particulars of infringement. In light of these vast materials, His Honour Judge Hacon had to make an order at the case management

stage requiring the Claimant to select just one script or one recorded performance of the allegedly infringing works and to identify, in a schedule, 30 features alleged to have been copied from the Claimant’s works (and by reference to which the Court would determine whether or not there had been copying).

Some parties are pushing for permission to adduce multiple witnesses where one would suffice, for permission for expert advice on matters that are really for the judge to determine, and for as broad a scope of disclosure as the case management judge will allow. All of these behaviours escalate the fees billed to the client to disproportionate levels. In addition, because judges rarely have oversight of client fees (particularly where costs recovery is capped), these actions have been without consequence, so there is little incentive to do better and be more nimble.

Finally, some parties are engaging in extensive and largely unnecessary *inter partes* correspondence. This is a classic tactic in High Court litigation

– forcing the opponent to increase its own legal fees in order to engage with all aspects of the claim and the litigation procedure – and is entirely unsuitable for the IPEC.

ISSUES IDENTIFIED

Instances of these behaviours have not escaped the IPEC judiciary’s attention. Judge Nicolas Caddick QC noted in the recent case of Match Group LLC v Muzmatch Ltd³ that: “Both sides assert that the case is simple or straightforward. Despite this and despite this being heard as a two-day trial in the Intellectual Property Enterprise Court, there were 21 lever arch files of documents, 4 lever arch files of authorities and each side’s opening submissions ran to more than 70 pages.”

Overall, these practices make it much more difficult and much less predictable for brand owners to bring claims in the IPEC. Despite the costs cap, the fees involved in running increasingly complex and cumbersome claims can make seeing litigation through to trial financially (or strategically) untenable.

IPEC ACTION

In April 2022, CMS published its inaugural *CMS IPEC Report*, which focused on trends, decisions, data and updates from the IPEC. The report acknowledged the high levels of irrecoverable fees in IPEC cases, the length of time it has been taking to get IPEC cases to trial and the fact that parties and the Court should be ▶

restricting the scope of disputes and actively managing cases to achieve significant savings in costs and time.

In a webinar that followed the report, the IPEC's Presiding Judge, Hacon J, put out a call to the IP legal profession and to users of the IPEC to provide feedback on the IPEC. He made it clear that he was concerned he was not always getting direct and unfiltered feedback from those on the ground.

In response to Hacon J's request for feedback, Stobbs published an open letter to him setting out various ways in which we consider the IPEC is being used incorrectly (which turns on the concerns summarised above) and also suggesting a number of proposals for reform. These proposals have the objective of making IPEC litigation more cost-effective and streamlined. They include:

- Putting a page limit on statements of case.
- The IPEC judges conducting on-paper evidence reviews of core disclosure, with simple disclosure to the IPEC by each law firm of amounts billed to date (as opposed to complicated costs budgeting), before directing whether any evidence of fact or expert evidence is needed.
- Determining case management issues on paper wherever possible, rather than at costly case management conferences (CMCs).
- A default assumption that witness evidence, if any, should be limited to two witnesses, with a page limit.
- Allowing expert reports only in exceptional cases where the goods/services at issue are sufficiently technical that the court requires assistance.

The response we have since received from Hacon J, shortly before the copy deadline for this article, is that across the legal profession he has not found any commonly held view that a particular aspect of the

IPEC multitrack needs to change; and that the IPEC remains a popular forum. He has indicated that he does not consider any form of costs budgeting in the IPEC would work as it would increase cost. He has said that he considers that the scope for wealthy litigants to play the system to bring unfair pressure on the less well funded is much more limited in the IPEC than in the High Court, with cost caps and stronger case management. He has also indicated that overall there is a desire to maintain oral CMCs and that this aids controlling the issues, disclosure, evidence etc.

This may not be the end of the discussion though. The momentum in the ongoing conversation about IPEC reform is highlighted by the topic being put up for debate at an upcoming meeting of CITMA's Law and Practice Committee, as well as at the July meeting of the BBG Legal Group.

MOVING FORWARD

Any misuse of the IPEC ultimately denies brand owners (both small and large) the opportunity to protect one of their most valuable assets in the very place that was specifically set up to make it easier to do so. In our experience, the real problem is not the IPEC and its case management powers, but the way in which some barristers and solicitors overly complicate cases in the IPEC. We would urge those using the IPEC to bear in mind that it is intended to be a streamlined and cost-effective forum for IP litigation for brand owners of all shapes and size, not simply a different forum in which to deploy their old tricks. The recent engagement of the judiciary in this debate will hopefully mean that the IPEC judges are more alive than ever to such tactics. ●

1. [2018] EWHC 1332 (IPEC)
2. [2022] EWHC 1379 (IPEC)
3. [2022] EWHC 941 (IPEC)

“ We would urge those using the IPEC to bear in mind that it is intended to be a streamlined forum



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Emma Dixon, IA Manager at Stobbs, co-authored.

HOW TO BE A BETTER WRITER

Tips for producing
top-class content

With many firms now relying on attorneys to help populate blog pages and sometimes fill out full legal content portals, how can you ensure your writing will appeal to readers and achieve its objectives? We gathered some useful advice.

Set your subject. Your firm may well have a marketing team looking after the content plan and with specific requests aligned to internal targets. But if not, Cherrie Stewart (Ansons) suggests several sources for finding relevant subject matter. These include: the questions most commonly asked by clients; updates on changes of law practice; inspiration from events such as the Olympics (ie, flags) or the Jubilee (ie, Royal symbols), national days (ie, World IP Day); and popular culture, hashtags and memes.

Make it personal. Pollyanna Savva (Howard Kennedy LLP) recommends writing on subjects or sectors in which you have a personal interest. This makes the writing process more enjoyable, she says, and may mean you can give the writing a bit more creative flair. She also recommends asking yourself: “Can I say this in fewer words?” This really helps to keep your writing concise.

Consider your contacts. Similarly, you may be able to add value to a story by tapping into your network,

suggests Carol Nyahasha (Elkington + Fife). While you’ll need to be careful about who you ask and how often to avoid anyone feeling burdened, there may be opportunities to get a unique viewpoint on a subject that makes your article stand out.

Meet your brief. If you’ve been commissioned to write to a specific brief, offers *CITMA Review* Editor Caitlin Mackesy Davies, make sure you understand what is being asked for and the audience it is intended to reach. If you have questions, ask them before you begin so that you set off in the right direction. And where a word count is given, keep to it. This will avoid the need for you – or an editor – to reshape the piece after you’ve put in the hard work.

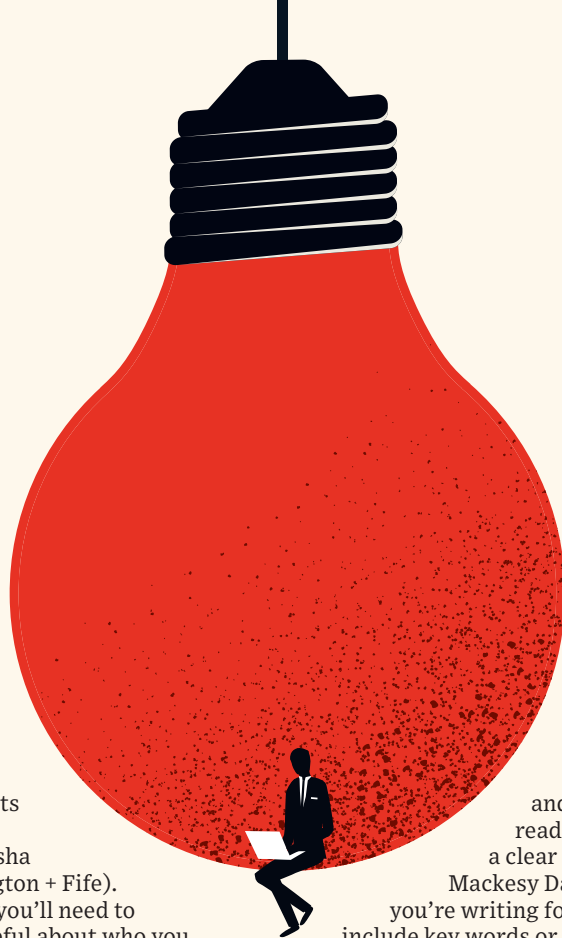
Have a headline in mind. Setting out to write a story with a well-defined angle in view will help you keep your content aligned

and lead your readers along a clear path, says Mackesy Davies. If you’re writing for the web, include key words or terms in your heading to help with SEO and bring readers to your page.

Work backwards. Tania Clark (Withers & Rogers) recommends that if you are writing about the impact of a specific decision, you should draft the “practical implications” part first and then fit the rest of the article around that. This will help you avoid including details that are not strictly needed.

Get a second opinion. Another suggestion from Clark is to ask a non-attorney to check over your article if it is aimed at clients or someone with no trade mark knowledge. Highlight any parts that might not be clear to readers with no prior subject knowledge.

Take your time. Deadlines can, of course, get on top of us all. But if possible, says Rebecca Field (HGF), it is good to draft your article, step away and then come back to it a couple of days later. Taking a break from the piece before the final draft can often mean you come up with new ideas, or you might even think of a better way to present the topic. ●



“

*You may be able to
add value to a story
by tapping into
your network*

IP LAW UPDATE

Martin Chinnery summarises the changes that came into effect this year

A new IP law governing trade marks, designs, utility models and geographical indications entered into force on 1st January 2022. It introduced significant changes in the way trade mark applications are processed and registered within the 17 member states of the Organisation Africaine de la Propriété Intellectuelle (OAPI). The changes introduced include the following.

TRADE MARK DEFINITION

The definition of a trade mark has been broadened to “any visible or audible sign ... which distinguishes the goods or services of a natural or legal person”. This means trade marks can now include sounds and musical phrases. The new law also introduces the registration of certification marks.

EXAMINATION AND OPPOSITION

Previously, the OAPI filing system had a formalities examination only. The new law introduces a substantive examination, to include the possibility of refusal on the basis that a trade mark lacks distinctive character or that it may confuse the public regarding the geographical origin or the nature or characteristics of the goods or services. Furthermore, it is now possible to include goods and service classes in the same application. Previously, separate applications were required, doubling the cost of filing for applicants registering for both goods and services.

Under the previous law, trade marks were published for opposition after registration, with a generous six-month opposition term. Now applications will be published

for opposition purposes before registration and examination. The opposition term has been reduced to three months, and the term for filing an appeal against opposition decisions has been reduced to two months.

INTERNATIONAL REGISTRATIONS

OAPI joined the Madrid Protocol in December 2014 and in practice it has been accepting designations of International Registrations (IRs) ever since. The new law provides the legal framework for the registration and validity of IRs at OAPI. However, the wording of the law is confusing, as it states that designations of IRs “containing the designation of at least one Member State, shall have the effect of a national deposit in each Member State which is also party to that Treaty”. This suggests that OAPI designations of IRs will only be valid in the OAPI member states that are also member states of the Madrid Protocol, but so far no member state of OAPI has joined the Madrid Protocol independently.

Yaoundé, Cameroon, where OAPI is headquartered

OAPI has addressed this by stating that it is authorised to sign IP-related treaties, such as the Madrid Protocol, on behalf of its member states. In the event of the validity of an IR being challenged on the basis that an OAPI member state has not joined the Madrid Protocol in its own right, it is believed that the courts will agree with OAPI's view.

UNREGISTERED TRADE MARKS

While OAPI is a civil-law jurisdiction, granting trade mark rights to the first to file, in certain circumstances the owners of trade marks that have not been registered can take action against trade marks that conflict with their own.

Oppositions have to be based on a conflicting prior right (or absolute grounds), but it is possible for the owner of an unregistered trade mark to file a "claim of ownership" against an application filed in bad faith on the basis that it was filed "by a person who at the time of filing knew, or should have known, that another person had a prior right to use the said mark". Claims of ownership can succeed when the claimant can show use of a trade mark in the OAPI member states prior to the date of the application that is the subject of the claim.

Under the terms of the new law, it is possible for claims of ownership

“ Under the terms of the new law, it is possible for claims of ownership to be filed with the courts after registration

to be filed with the courts after registration. This will make it easier for genuine brand owners to cancel registrations obtained in bad faith, as they will no longer have to prove that their trade mark is internationally well known within the meaning of Article 6bis of the Paris Convention in order to do so.

One peculiarity of claims of ownership is that they cannot be filed against designations of IRs. It is hoped that this will be rectified in the near future.

DIVISIONAL APPLICATIONS

It is possible under the new law to divide applications. Under the old law, the concept was not recognised as there was no substantive examination, so applications were never partially refused.

CO-OWNERSHIP

Although trade marks could be registered in the name of more than one applicant under the old law, the new law contains provisions governing the rights and responsibilities of co-owners, particularly regarding the right to take action for infringement and to grant licences to use a trade mark.

CUSTOMS RECORDALS

The new law introduces the possibility of recording trade marks with the customs authorities for the purpose of detaining suspected infringing goods. Very few African countries allow customs recordals, so it is very good news for brand owners that the concept is being introduced in OAPI. ●



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30 GOING ON PARTNER

Looking to speed into a senior role?
Charlotte Wilding shares her suggestions

Despite the recent uncertainty over the past few years, becoming a partner at a trade mark or law firm remains an attainable and aspirational goal. Here are a few (hopefully) useful tips to help future leaders reach partnership in their thirties and beyond.

KNOW YOUR AUDIENCE
Partnership is unlikely to simply be handed to you – you have to work at putting your best case forward from the very beginning of your career. My end goal was always to become a partner – how to get there was something I had to learn. I always made it clear that though my shorter-term goals were to become a qualified attorney, senior associate, director etc, the ultimate aim was to make partnership. With that in mind, I encouraged

“ *My end goal was always to become a partner* ”

my seniors to advise me on how I could do that and what I personally needed to improve and bring to the table.

Having an understanding, from the very start, of what your particular firm requires in order to climb the ladder is extremely

helpful and puts you a step ahead. Most firms will have information available regarding each promotion stage and every firm requires different targets to be hit. To understand these from the outset will only increase your chances of meeting them.

At the same time, it's not all about your firm. You must know what it is you want from partnership, as well as what you want to achieve as partner. And then tell the current partners about your ambition so there can be no confusion as to what you want.

BE PROACTIVE FROM THE START

Think like a partner from the beginning. You should be proactive in your firm's business development as early as possible. This does not necessarily mean you have to pressure yourself into bringing in a certain number of clients, for example, but you can aim to be part of the team when they do come in. Make yourself invaluable. I made sure to attend as many internal and external events as possible to ensure that I would be thought of when work came in. In such a small industry, it helps to have contacts to find those next opportunities.

ENGAGE WITH THE EXTRAS

A large part of building your network and increasing your profile is working on the 'extras', such as article writing and speaking. Not only does it get your name recognised, but it helps to develop the key skills required in our profession. Look for opportunities to get involved with your firm's blogs, marketing or look for ways to engage with professional publications. Writing articles for the *CITMA Review*, for example, gets your name out there and is a great way to stay on top of recent case law and changes in the industry. This has been something I have been active in since starting in the profession and I encourage my team to do the same.

Public speaking may not be for everyone, and I certainly still find it nerve-racking, but it can be a great

“ Tell the current partners about your ambition so there can be no confusion as to what you want

experience. Again, this is an area that I actively say yes to even when I am unsure (assuming it is a topic I can speak to!) – it gets easier every time.

FIND YOUR OWN NICHE

By working on your network and the 'extras', you may well find your own niche within our niche industry, which will help you stand out. However, don't be disappointed if you do not fit comfortably into a niche. It is also a great talent to accept that there may be areas you are less skilled in, but in which you can encourage others that clearly have those talents.

SUPPORT YOUR TEAM (AND THEY WILL SUPPORT YOU)

I had the great privilege of working with the IP legend David Keltie many years ago and he was a great believer that you want your team to be better than you. Why be the cleverest person in the room, when you can help and encourage others to be the best they can be?

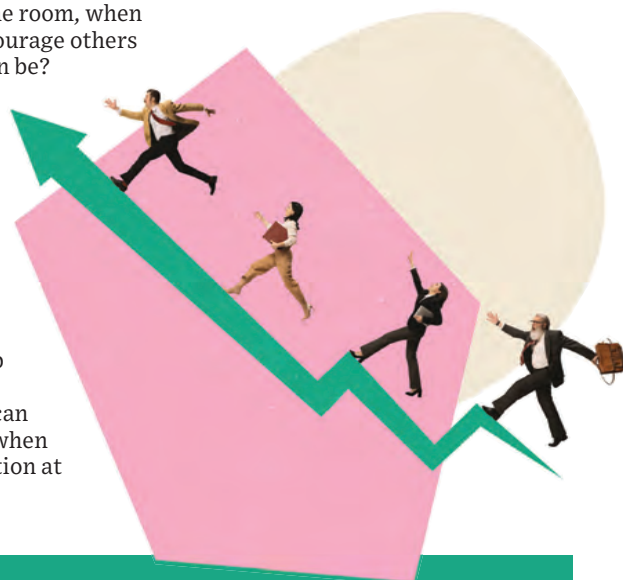
Mentor/mentee relationships can be invaluable for all those involved. Not only can you demonstrate great leadership by getting involved in mentoring, but you will find that it helps you grow and develop both professionally and personally. This can only be a good thing when you're seeking a position at the top table.

SEEK ALTERNATIVES IF NEEDED

Finally, don't hesitate to move on if things aren't working out for you. But equally, don't be too impatient, because the grass isn't always greener. Go with your gut.

One of the hardest decisions I made was to leave the firm I had spent 11 brilliant years at, but the opportunity to head up a trade mark team, which was not available at my firm, was too great to miss. It has proven to be a great decision – allowing me to grow both personally and professionally.

If you do seek opportunities elsewhere, it is absolutely vital to research the firm in as much detail as possible, speak to current employees (where appropriate to do so) and understand the ongoing requirements. Once you have the full picture, it will help you make the right decision. ●



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Oatly wins again

Decision confirms an established stance, reports Erika Coccia

On 28th April 2020, Oatly AB (the Opponent) filed an opposition against EU trade mark (EUTM) application No. 18189132 for OAKY covering “Food supplements” in class 5 (the Application), which had been filed in the name of Jean-Louis Klein (the Applicant).

The Opposition was based on a claim of likelihood of confusion, under Article 8(1)(b) of the EU Trade Mark Regulation (EUTMR), with the Opponent’s prior EUTM registration No. 16364441 for OATLY. That registration (the Earlier EU Mark) covered various goods in class 5 including: “Food supplements and dietary food supplements”. The Opponent further claimed under Article 8(5) EUTMR that use of the Application would take, without due cause, unfair advantage of, or be

detrimental to the distinctive character and reputation of, its prior Swedish trade mark registration No. 350943 OATLY, covering “Oat-based beverages for use as a milk substitute; milk substitutes containing oat” in class 29, “Ice-cream; sauces (condiments)” in class 30, and “Non-alcoholic beverages; oat-based drinks” in class 32.

The Opponent filed extensive evidence to support the claim that its OATLY mark enjoys enhanced distinctiveness and reputation in Sweden for the above goods in classes 29, 30 and 32, but none of this evidence was assessed by the Opposition Division (OD) for reasons of procedural economy.

The OD upheld the opposition in its entirety under Article 8(1)(b) EUTMR based on a likelihood of confusion between the Application and the Earlier EU Mark, taking into account the respective marks’ inherent distinctiveness.

“ This decision has confirmed the stance adopted by the Court of First Instance in New Look



“ The OD determined that neither the word ‘OAT’ in the Earlier EU Mark nor ‘OAKY’ are English words used in common parlance

IDENTICAL GOODS

The OD held that the Applicant’s goods “Food supplements” in class 5 and “Food supplements and dietary food supplements” in class 5 under the Earlier EU Mark are identical goods, aimed at the public at large as well as a specialist public, for example professionals with knowledge or expertise in the nutritional field.

The degree of attention of these consumers is considered higher than average because nutritional or dietary supplements are often purchased to cure, prevent or improve health conditions.

When assessing the conceptual similarity of the marks in suit, which either include or consist of English dictionary words, the OD focused its analysis on non-English speaking consumers within the EU who have no or a basic understanding of English and therefore will not be able to differentiate the marks conceptually.

The OD further determined that neither the word “OAT” in the Earlier EU Mark nor “OAKY” are English words used in common parlance and that it would be unusual for the non-English speaking part of the EU to be familiar with these terms. This is in contrast to the submissions put forward by the Applicant’s lawyers, who alleged that consumers in European countries with a basic knowledge of English will understand the word “OAT”, as this word often appears on bilingual menus or on product labels, which are often bilingual.

From a visual and aural standpoint, the OD ruled that the respective marks are similar to an average degree due to the coinciding beginning “OA*” and the ending letter “*Y”. The marks were found to differ in the middle letters, “TL” and “K”, which will not catch the eye as easily as the beginning letters of the marks because consumers read from left to right and will

therefore place a greater emphasis on the first part of a trade mark. The OD rejected the Applicant’s argument that OATLY and OAKY are short signs, with small differences between the marks being sufficient to distinguish them overall. The OD clarified in its decision that, according to EUIPO practice, short signs consists of up to three letters or numbers, while the marks in suit are made up of five and four letters. From a phonetic point of view, the OD held that the relevant public within the EU will perceive the marks as made up of three syllables (/o/a/tly and /o/a/ky) with a similar rhythm and intonation.

CONFUSION LIKELY

The OD concluded that, based on an overall assessment of the marks, there is a likelihood of confusion between the Application and the Earlier EU Mark due to the identical goods and the average degree of visual and phonetic similarity between the marks.

This decision has confirmed the stance adopted by the Court of First Instance in *New Look (T-435/07)*, where it was held that a word mark in a specific language (in both cases an English term) must be assessed if it is understood by the relevant public in the territories concerned, particularly in those territories of the EU in which English is not the native language or for those territories, such as Spain or Poland, where a basic understanding of English is not the norm.

KEY POINTS

- Based on the unitary character of the EU trade mark, a likelihood of confusion for only part of the relevant public within the EU is sufficient to reject the opposed application
- Differences in the middle parts of word marks play a minor role when assessing the visual and phonetic similarity of the marks
- The conceptual assessment of a word sign in a specific language of the EU must be assessed in relation to all the territories concerned, including those EU countries where English is not a native or commonly known language
- Even consumers who pay a higher degree of attention when selecting products will rely on their imperfect recollection of the marks instead of artificially examining or comparing the marks



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Heart to heart



Emilia Petrossian explains how one dating site mark met its match

Match Group, LLC, Meetic SAS and Match.com International Ltd (together, Match) have been successful in their trade mark infringement and passing off claim against Muzmatch Ltd and Shahzad Younas (together, Muzmatch) and the use of the word “match” on the dating service Muzmatch.

Match, which includes the brands match.com and Tinder (shown on page 30), started its Match dating service in 1995 in the US via www.match.com. Match expanded into the UK in 1996, when it registered its first UK and EU trade marks for MATCH.COM, also shown on page 30. Match uses or has used a variety of other logos.

Muzmatch launched in 2011 as a dating website for Muslims, with its app following in 2015. Its strategy was to use keywords that included the words “match” and “tinder”. Muzmatch uses or has used a variety of logos since its launch, a selection of which are shown on page 30.

In 2016, Match notified Muzmatch that it considered its activities to infringe the MATCH.COM mark and associated device marks, also alleging passing off. The parties entered into settlement discussions during which Match offered to buy Muzmatch under four separate offers, all of which were rejected. The negotiations ended in 2019 and Match brought proceedings against Muzmatch for infringement under s10(2) and s10(3) of the Trade Marks Act 1994 (TMA) and for passing off in 2020.

CONSUMER CONSIDERATIONS

Match claimed that Muzmatch used signs containing “match”, which infringed its Match marks. The average consumer for the Match marks is the general public. However, Muzmatch is a dating service aimed at Muslims and asks users questions about whether they are “very practising”, “moderately practising”, “practising” or “non-practising” Muslims and whether they “never”, “sometimes”, “usually” or “always” pray. Muzmatch claimed that “practising Muslims are not the ‘typical user’ of

dating services”. It wasn’t clear to the Court whether this was a suggestion that the average consumer of Match would not be a practising Muslim or whether it was for the Court to bear in mind when assessing likelihood of confusion.

Nevertheless, the Court held that there is no single category in which to put practising Muslims. Further, the Court held that the common ground is an average consumer who is reasonably well informed, reasonably circumspect and observant, who rarely has the chance to make a direct comparison between the marks and relies on imperfect recollection.

The Court held that there was no question that the Muzmatch signs at issue were clearly used within the relevant territory, in the course of trade and without the consent of Match.

IDENTICALITY AND SIMILARITY

Muzmatch argued that there is no similarity between the marks. Muzmatch’s marks included extra elements such as “muz”, “Muslim”, “UK” or “United Kingdom” and Match’s marks contained extra elements such as “.com”, a heart device and a butterfly device. The Court disagreed with this argument and held that the marks were similar to a medium degree despite the addition of extra words because all marks contained the clear common element “match”. Further, the Court held that the inclusion of “.com” did not prevent clear visual and aural similarity arising from the common use of the word “match”.

The Court also held that changes in the stylised font or inclusion of a device in the mark did not make the marks dissimilar. As marks were not heavily stylised, it did not detract from the similarity of the common word used and inclusion of a device element had no effect on the marks when they are being referred to aurally. A medium level of similarity was found between the marks.

Muzmatch argued that there was only a low degree of similarity between its services and the class 42 services of the Match marks. The Court stated that even

though class 42 services for “information and consultancy services in the nature and field of on-line dating and introduction services” were not provided by Muzmatch, these services were clearly complementary to online dating services and were therefore highly similar.

LIKELIHOOD OF CONFUSION

Match argued that Muzmatch’s signs and use of “match” as a keyword would give rise to confusion, with the general public led to believe that Muzmatch’s services were those of Match.

Muzmatch argued that the only similarity between the marks was “match”, which is non-distinctive and descriptive, and therefore there was no likelihood of confusion. Further, if there were actual confusion, there would be credible evidence of it by now, which had not been demonstrated.

The Court held, on the basis of the evidence provided by Match, that the dominant element in the Match marks was the word “match”, which is associated with the services of Match. Inclusion of additional elements in the Muzmatch signs would not reduce the likelihood of confusion with the Match marks. Therefore, when considering the evidence and the dominant presence of Match in the market since 2011, the Court found that the Muzmatch signs would lead to consumers believing that Muzmatch was connected with and viewed as a sub-brand of Match that targeted Muslim consumers.

On the point of evidence of actual confusion, the Court relied on the case of *Jack Wills v House of Fraser* [2014] ETMR 28 at [99]:

“... absence of evidence of actual confusion is not necessarily fatal to a claim under art.5(1)(b). The longer the use complained of has gone on in parallel with use of the trade mark without such evidence emerging, however, the more significant it is. Other relevant factors are the scale of the use complained of and the likelihood of actual confusion being detected.”

The Court therefore concluded that, although there was an absence of evidence of actual confusion, a likelihood of confusion was present in this case. Accordingly, the claim under s10(2) was successful.

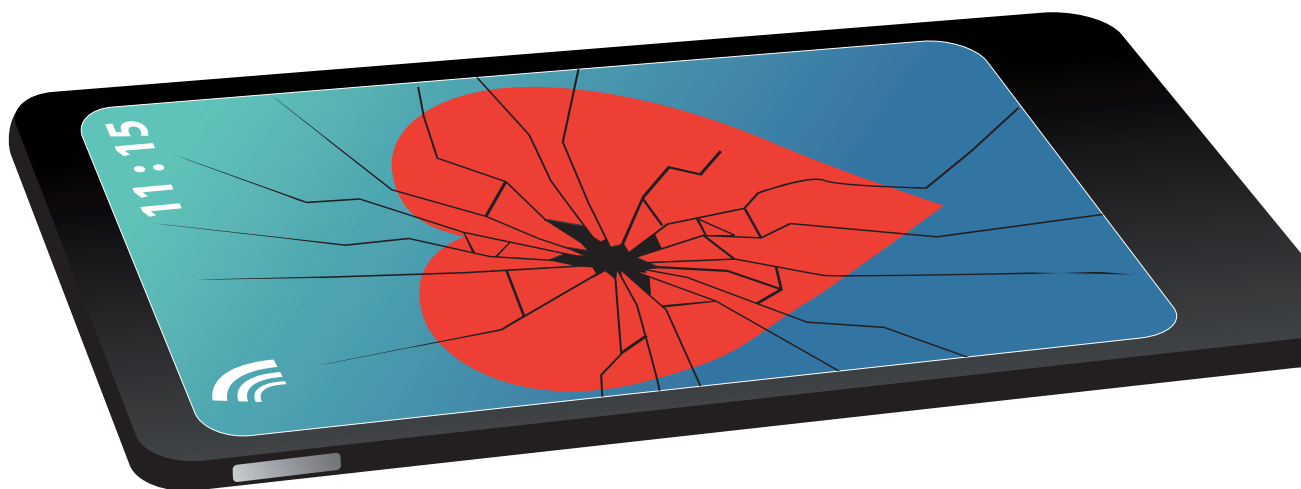
INFRINGEMENT

The Court assessed the claim under s10(3) as if the Muzmatch signs did not give rise to likelihood of confusion within the meaning of s10(2). The Court held that there was no issue with the conditions that the sign must be used by a third party in the relevant

KEY POINTS

- ✦ The descriptiveness of an earlier mark with reputation does not automatically mean that a third party can use that mark
- ✦ Keywords as part of an online searching strategy can infringe a registered owner’s trade mark rights

“ The Court concluded that, although there was an absence of evidence of actual confusion, a likelihood of confusion was present in this case





not established until 2015, when use started. However, the Court still held that the average consumer would have made a link with the Muzmatch signs. Further, the Court also held that consumers would find a link between Muzmatch’s keywords and the Match marks.

The Court held that Muzmatch had taken unfair advantage of the distinctive character and/or reputation of the Match marks, which was supported by the style and colours used by Muzmatch in its branding. However, the Court did not find any change in economic behaviours. Finally, Muzmatch did not establish its conduct was with due cause.

Muzmatch claimed honest concurrent use as a defence, arguing that during settlement discussions with Match its concerns were with the format and style of the mark and not use of the name Muzmatch, and relying on estoppel Muzmatch claimed it acted honestly. It was held that: “Muzmatch’s mistaken views as to the legal basis of its actions cannot transform what were

“ The Court confirmed that Match had acquired goodwill not only in its MATCH.COM mark but also in the word ‘Match’ in all its marks

territory, in the course of trade, without the consent of the proprietor and be in relation to goods or services of the registered mark.

REMAINING ISSUES

The Court held that the word “match” was distinctive in the sense that it was associated with Match and its services. Match had a dominant position in the market which was reflected in the levels of public awareness of its services, advertising and social media. Also, Match’s device marks have an established reputation of their own, being used from 2015. The assessment of the similarity of the marks had already been dealt with as detailed above.

Given that Match acquired a reputation in the market since 2011 and there was held to be a medium level of similarity between the marks and identity of the goods/services at issue, the Court held that consumers would find a link between match.com and the Muzmatch signs. In respect of the Match device marks, acquired distinctiveness was

infringing acts into non-infringing acts”. No honest concurrent use was accepted.

PASSING OFF

In dealing with the passing off action, the Court confirmed that Match had acquired goodwill not only in its MATCH.COM mark but also in the word “Match” in all its marks. Although the services were not specifically targeted at people in the Muslim community, its goodwill would have extended into that community. Further, the Muzmatch signs would lead consumers to believe that it was connected to Match, giving rise to a likelihood of confusion causing damage to Match’s goodwill. Therefore, the claim for passing off also succeeded.

MARKS

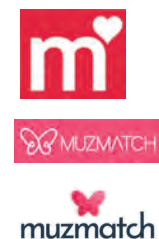
THE MATCH MARKS



OTHER MATCH LOGOS (SELECTED)



MUZMATCH SIGNS (SELECTED)



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Saving face

Catherine Byfield tells how a big watch brand won the day on the issue of watch-face apps

The Claimants in this case are all members of the Swatch group of watch makers (Swatch). Their brands range from Swatch in what is considered a basic range (costing around £175) to Breguet in the prestige market (prices up to hundreds of thousands of pounds).

The Defendant is Samsung, the well-known technology group. The claim relates to the alleged infringement of 23 of the Claimants' trade marks by 30 watch-face apps that were sold on Samsung's online store (SGA Store). The alleged infringements occurred between October 2015 and February 2019 and involved some apps that were downloaded as many as 160,000 times in the UK and EU. The earlier rights in question were word and figurative registrations for the brand names, which featured on the watch-face images (see examples on page 33).

The apps were developed by third-party developers. However, the Claimants' position was that Samsung was intimately involved in and controlled the whole process by which the apps were made available. Samsung denied liability, with defences on the basis that it had not used the marks and that there was no indication of any connection with Swatch. It further relied on Article 14 of the e-Commerce Directive.

FIRST AWARENESS

The Claimants started monitoring the SGA Store in December 2018, when they first became aware of the alleged infringements. They wrote to Samsung on 21st December 2018, demanding the apps be taken down and details of the developers disclosed. The apps identified were taken down by 9th January 2019. The Claimants issued proceedings in February 2019. The alleged infringement in question in this case had therefore ceased well before this decision was issued.

For the sake of clarity, the Judge identified that the conventional position for a trade mark on a watch face is in the centre of the upper portion of the dial. She referred to this as "dial branding". The instances of use on online marketplaces, including Google France,¹ L'Oréal v eBay² and Coty,³ were all

discussed. Swatch took the position that there was both active behaviour and control by Samsung, as well as use in Samsung's commercial communications. Samsung's position was that it simply provided a vehicle for the marks to be used, in the form of the SGA Store. It was the developers, not Samsung, that uploaded the apps to the store.

After considering Samsung's behaviour as a whole, the Judge found it did use the signs in the course of trade. Samsung had orchestrated the provision of the apps to its consumers. Its activities could be described as offering or stocking the goods in the SGA Store under s10(4)(b), or affixing signs included in any dial branding to the smartwatch under s10(4)(a).

COMMERCIAL CHOICE

Persuasive were the fact that Samsung markets its smartwatches as "truly watch-like" and its references to the many watch-face apps available from the SGA Store. Samsung made a commercial choice in deciding to provide a limited number of such apps itself, allowing third parties to develop the majority. This was supported by the evidence given by a witness. ▶

KEY POINTS

- ✦ The Judge found there was infringement of the Claimants' marks under s10(1), s10(2) and s10(3) of the Trade Marks Act 1994
- ✦ Use in app names was found not to be use in relation to smartwatches. However, watch-face apps are similar to smartwatches and have some level of similarity with watches themselves
- ✦ Samsung did not have a defence under the e-Commerce Directive
- ✦ Samsung did use the signs in relation to watch-face apps when it facilitated their sale through its online store



It was in Samsung's commercial interests to have free apps. These apps allow or highlight the use of functions or interfaces that are unique to Samsung devices. This relationship is mutually beneficial, because promotional opportunities are provided by Samsung in relation to the developers' other apps.

Samsung provides a tool for use by developers and all but one of the apps in dispute in this case was developed using this tool. Samsung also hosts developer conferences to showcase apps built on Samsung devices. The relationship between Samsung and the developers was crucial in highlighting Samsung's active role in the provision of the alleged infringing apps. Also key to this is the review process for the approval of the apps.

Samsung reviews all apps for functionality and content before they can be uploaded to the SGA Store. The Judge felt that purchasing an app from this store would be considered "official", as opposed to downloading one from another site. It is reasonable to assume consumers expect these apps to carry an assurance from Samsung as to their functionality with their devices. Conversely, if an app was of poor quality, it would reflect negatively on Samsung.

Samsung conceded that smartwatches are a form of watch. It referred to them as

comprising a "very specialised sub-category". The Judge concluded that smartwatch apps are not identical but similar to smartwatches. They are intended to be used together and are essential for each other's operation. The Judge went on to say that smartwatches are highly similar to watches. And while market data was provided which showed that the two product types are not in direct competition, they must compete to some extent, since consumers wear one or the other and not both at the same time.

Essentially, the apps for sale in the SGA Store, once purchased, would function as a watch. The dial branding appears on the watch-face apps in the same place a consumer would expect to see it on a watch. Post-sale context was important in determining that the marks were used in relation to smartwatches, not merely watch-face apps.

The Judge dismissed Samsung's position that its use was descriptive or functional, saying that "a reasonably observant user would not have been able to ascertain without difficulty that Samsung did not provide the app under an arrangement with Swatch, or that there was otherwise no economic link between the provider of the app and Swatch". She referred to the need for clear identification, which was emphasised by the CJEU in *Google France and L'Oréal v eBay*.

LIKELIHOOD OF CONFUSION

Again, post-sale confusion was important here. The natural assumption must be that a smartwatch displaying one of the disputed apps was either produced by Swatch, under licence or through another economic arrangement. An interesting consideration on this point was that consumers who had gone to the trouble of downloading one of the disputed apps would likely want to show others what they had.

REPUTATION

The Judge accepted that Swatch had provided sufficient evidence to establish a reputation in respect of each of the marks in issue. She went so far as to say that for some of the higher-end brands such as Omega and Longines their reputation was "obvious". She also pointed to the fact that the intention to imitate on the part of the developers supported the idea that these brands did indeed have a reputation.

The Judge was satisfied that use of the signs was capable of having a detrimental effect on the character or reputation of the

“ Samsung’s position was that it simply provided a vehicle for the marks to be used, in the form of the SGA Store



“ It is reassuring to brand owners that simply taking down offending listings, when huge financial and reputational benefit has been garnered, is not necessarily the end of the line

marks and amounted to unfair advantage. There was also the possibility of dilution or tarnishing, particularly in light of the reputation of Swiss-made watches as long lasting, which was in contrast to the short life of smartwatches. Also successful was the argument put forward by Swatch that the use of the signs on watch-face apps amounted to free-riding. Persuasive here was Samsung’s marketing claim that its watches had a “real-watch” aesthetic. From the evidence it appeared that there was a trend among consumers to consider purchasing a watch-face app for a Samsung smartwatch as a step on the ladder, with the aim being to buy a Swiss watch once they could afford it.

Samsung could not rely on a defence on the basis of the e-Commerce Directive. The protection conferred by Article 14 is limited to activities that consist of storage of information. Case law tells us the behaviour needs to be “technical, automatic and passive” in nature. Samsung took many active steps in the way in which it worked with developers and the review process it conducted. It derived a commercial benefit, unrelated to storage of data. The existence of notice and take-down procedures does not in itself provide a defence. Through its review process, Samsung must have become aware of the use of the dial branding. The Judge was critical of Samsung’s review process but concluded that it was sufficient for a diligent economic operator to be alerted to the infringement.

Section 10(1) or s10(2) infringement was found in respect of certain apps. In some cases, this related to the use of the sign on the watch face only and in others to the use in an app name and, in some cases, to both. Section 10(3) infringement was also established in respect of three of the apps.

Clearly the use of the signs by the developers was of direct benefit to Samsung, and its processes, even before these were improved following this issue, were sufficient that it was surely aware of the infringing use. It is reassuring to brand owners that simply taking down offending listings, when huge financial and reputational benefit has

been garnered, is not necessarily the end of the line.

BEHAVIOUR COMPLAINTS

The Defendant made a number of complaints at trial about a lack of cooperation by Swatch in identifying and resolving issues. The Judge felt none of these were strictly relevant to liability. She did note in her judgment that because of the way in which the case was presented, the Court was required to do a significant amount of work to produce the appendices to the judgment. She recommended that, in future, greater consideration be given in advance to what would assist the Court to determine the issues in the case.

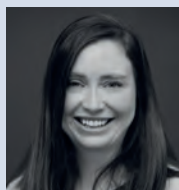
The Defendant’s behaviour here was key. Although it had acted very promptly in taking down the apps complained of once Swatch wrote to it, its behaviour up until that point demonstrated that it knew of the infringements, or certainly should have, and that it “orchestrated the provision of the apps to its consumers”. It had certainly benefited from what was described as a “symbiotic” relationship with the developers.

When you look at the watch-face apps, there are several components that are likely to be recognisable to consumers, some much more obvious than the word/logo marks that were registered. This decision raises questions over the best form of protection for these watch faces, given the “new” value they have in relation to their electronic counterparts.

1. [2010] ETMR 30; [2011] Bus LR 1; [2011] All ER (EC) 411; [2010] EUECJ C-236/08; [2010] ECR I-2417; 3 ALR Int’l 867; [2010] RPC 19
2. [2011] RPC 27; [2011] ETMR 52
3. [2020] ETMR 37

MARKS

EXAMPLES OF WATCH-FACE APPS



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Court opinion is clear

This decision also has wider implications for distribution consent, suggests Giles Parsons

Here, Lord Justice Arnold has given a very clear judgment: when amazon.com offers to sell products to UK consumers in pounds sterling and arranges for shipping to the UK, it is targeting the UK and so making use of the trade marks on those goods in the UK. Further, if amazon.com sells infringing goods from the US to UK customers, that is an infringing sale.

Lifestyle Equities, the first Claimant, is a litigious business that owns and licences EU and UK trade marks for “Beverley Hills Polo Club” (BHPC) clothing. The US marks for “Beverley Hills Polo Club” are owned by an unrelated party. Lifestyle Equities complained that amazon.com was offering and selling US branded goods to consumers in the UK and EU, and in doing so, infringed the UK and EU trade marks. The Court had two questions to answer: were Amazon’s advertisements and offers for sale use of the trade mark in the UK? And did its sales to UK and EU consumers constitute use of the sign in the UK and EU?

At first instance, Mr Justice Green held that there was no infringement. amazon.com was primarily a US site, and it was more expensive and more hassle for UK-based consumers to buy from it. The Judge said he was “troubled” by the evidence of Mr Haddad, the Claimants’ Managing Director. He also discussed the Claimants’ motives, noting: “[The Claimants do] not want UK/EU consumers to be able to see the sort of prices that BHPC goods are being traded at in the US. Yet this is the way of the modern world and consumers do shop around on the internet.”

DIFFERING OPINION

In an emphatic judgment, Arnold J came to a very different conclusion. On the offer for sale, paragraph 67 is very clear:

“If one asks whether that offer was targeted at the UK, in my view it is manifest that the answer is yes. The

purchaser is located in the UK, the shipping address is in the UK, the billing address is in the UK, the currency of payment is GBP and Amazon will make all the necessary arrangements for the goods to be shipped to and imported into the UK and delivered to the consumer in the UK. I do not understand how it can seriously be argued that this offer for sale was not targeted at the UK, notwithstanding the valiant attempt of counsel for Amazon to do just that.”

Although amazon.com is primarily targeted at US consumers, it is not restricted to them. There has to be a specific assessment in relation to the use complained of; even if general adverts on a website do not target the UK, a specific offer for sale to a particular consumer may. There is no requirement for subjective intent on the part of a defendant; subjective intent may be useful in understanding whether objectively there has been use in the relevant jurisdiction.

There is a lot of case law around advertisements for sale, and websites that





“ Although amazon.com is primarily targeted at US consumers, it is not restricted to them

“target” the UK have been found to infringe. Arnold J said that this label (“target”) should not distract from the statutory test, which is: is there “use” of the sign in the relevant jurisdiction?

The first instance Judge had said that Mr Haddad’s evidence was “very revealing”. However, Arnold J said that it was not relevant to the question of infringement. In addition to the “offers”, the sales were also infringements. The first instance

Judge appeared to have been influenced by contract law considerations, such as where title and risk passed. These are not relevant. Arnold J said that the CJEU’s decision in C-98/13 Blomqvist is clear:

“Sale of goods under a sign by a foreign website to a consumer in the UK or the EU constitutes use of the sign in the course of trade in the relevant territory, and ... this [is] so even if there is no antecedent offer for sale or advertisement targeting consumers in that territory.”

Four different sales models were considered in the judgment:

1. Goods were sold through Amazon’s Global Store, which meant that amazon.com listings appeared on amazon.co.uk and amazon.de.
2. Goods were sold by Amazon through amazon.com.
3. Goods were sold on amazon.com by third parties but amazon.com fulfilled the orders.
4. Third-party merchants sold through amazon.com but managed storage, shipping, delivery and other logistics.

KEY POINTS

✦ When amazon.com offers to sell products to UK consumers in pounds sterling and arranges for shipping to the UK, it is targeting the UK and so making use of the trade marks on those goods in the UK

✦ Further, if amazon.com sells infringing goods from the US to UK customers, that is an infringing sale

✦ Mark owners that want to prevent cross-border sales should determine whether distribution agreements include consent for such sales

Amazon had admitted before trial that the adverts, though not the sales, on amazon.co.uk and amazon.de had been infringements.

All the sales models were found by the Court of Appeal to infringe. Amazon did not argue that, if the other uses infringed, the sales through third-party merchants would still not infringe. Arnold J did not decide whether Amazon was jointly liable with the carriers for importation. Neither did he decide whether Amazon Inc was jointly liable for any infringement committed by the other Defendants.

He did subsequently¹ order an inquiry as to damages. Although it was unclear whether Lifestyle Equities would recover a substantial sum (there had only been US\$4,500 of sales through the infringing channels to the UK), it was entitled to an inquiry. In that consequential judgment, Lifestyle Equities was also granted the standard injunction.

IMPLICATIONS

In a passage from the first instance decision, the Judge said that the US goods “are not ‘fake’ or ‘counterfeit’ goods in any normal sense of the word as they have been manufactured and put on sale in the US with the consent of the US rights holder”.

The case turns of course on whether the trade marks were infringed. Trade mark law is territorial, and trade marks are badges that indicate trade origin. The US goods had not been put on the UK or EU market with the consent of the UK and EU rights holder, so use

“ This judgment from Arnold J is written with his usual scholarly method and will be the first reference for trade mark lawyers dealing with potential infringements on foreign websites

of the trade marks on the US goods in the UK or EU was infringing.

This judgment from Arnold J is written with his usual scholarly method and will be the first reference for trade mark lawyers dealing with potential infringements on foreign websites. (Daniel Alexander QC, who appeared for Amazon, may or may not take satisfaction in having his own summary of the law on targeting from *Abanka v Abanca*² cited against him.)

On the face of it, one might think that this case was about an unusual brand, because most brands don’t have different ownership in different territories; but this case has a much wider application than that. If a trade mark owner does not consent to specific goods having been put on the market in the EU, then its trade mark rights in respect of those specific goods have not been exhausted. Trade mark owners that want to prevent cross-border sales should check their distribution agreements – to determine whether there is consent – and their procedures for identifying parallel imports. With the right structure in place, this case makes it easier to stop sales in the EU through unwanted channels outside of the EU.

Amazon sought permission to appeal to the Supreme Court; this was refused by the Court of Appeal, but it may still seek permission from the Supreme Court.

1. See *Lifestyle Equities CV and another v Amazon UK Services Ltd and others (Consequential Issues)* [2022] EWCA Civ 634
2. [2017] EWHC 2428 (Ch), [2018] Bus LR 612



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Invictus is conquered

A royal connection wasn't a convincer, writes Amelia Skelding

On 16th September 2019, Invicta SpA (the Opponent) filed an opposition against UK trade mark application No. 3399958 for INVICTUS (series of two) for clothing, footwear and headgear in class 25 in the name of Invictus Games Foundation (the Applicant). The opposition was based on the EU designation of International Registration No. 1201001 for INVICTA in classes 9, 16, 25 and 35. The Opponent invoked s5(2)(b) of the Trade Marks Act 1994.

After a comparison of the goods and marks, the Applicant's class 25 goods were found to be identical to the Opponent's class 25 goods. The Opponent's mark is a plain word mark in capital letters. The Applicant's mark is a series of two, with INVICTUS being the only word element. The colour variations were found to play a limited role, merely acting as a background. Both marks share the identical first six letters – "INVICT" – differing only in their endings. As the beginnings of marks tend to have more emphasis than their endings, the marks were found to be visually and aurally similar to a high degree.

CONCEPTUAL SIMILARITY

The Invictus Games Foundation oversees an international sporting event for wounded, injured and sick servicemen and servicewomen. The Applicant argued that due to the fame of its founder – Prince Harry, Duke of Sussex – the mark INVICTUS for clothing, footwear and headgear would bring to mind the Applicant, royalty and/or wounded servicemen and servicewomen. However, this argument was rejected because there was insufficient evidence that the general public had been educated accordingly. In addition, the evidence related to INVICTUS GAMES, not INVICTUS *solus*, and there was no evidence of any sales relating to the relevant goods. Therefore, any reputation held by the Applicant was not demonstrated to be held in the mark in suit and also was not shown to be for clothing, footwear and headgear.

The Opponent submitted that both INVICTUS and INVICTA are likely to be

regarded as masculine and feminine forms of the Latin adjective having the stem "*invict-*", meaning "unconquered". It was found that consumers who knew the Latin meaning would find the marks highly similar conceptually, if not identical. Where this meaning was not known or the terms were thought of as invented words, no comparison was possible and they would be conceptually neutral. However, it was accepted that some consumers may perceive the mark as having an association with Invictus Games, but not a significant proportion.

RARE EXCEPTION

As the goods were found to be identical and the marks were found to be visually and aurally highly similar, and conceptually highly similar, if not identical, or neutral, a likelihood of confusion was found and the opposition was successful in full.

This case looks at the rare exception where the notoriety of a famous person means the reputation of the later mark may come into play in the confusion assessment, albeit only for the conceptual comparison. While settled case law focuses on the names of famous people, it would seem that there is an even higher bar for organisations.

KEY POINTS

- ✦ The beginnings of marks tend to have more emphasis than their endings
- ✦ Marks can have a variety of different conceptual meanings
- ✦ All evidence must relate to the specific mark at issue and the relevant goods/services

MARKS

THE APPLICANT'S MARK

INVICTUS
INVICTUS



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Test of faith

Iain Rutherford distils the crucial points arising from this decision



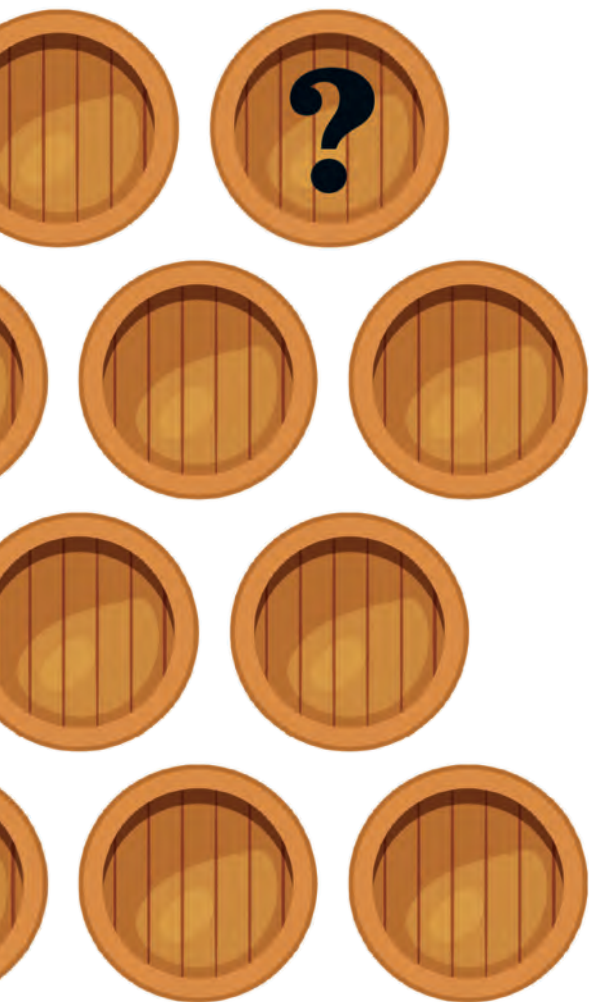
This case concerns a dispute between the owner of a distillery, The Tomatin Distillery Company Ltd (Tomatin Distillery), and a retail development company, The Tomatin Trading Company Ltd (TTC). Tomatin Distillery produces a range of single malt whiskies under the “Tomatin” brand. The distillery is located between Aviemore and Inverness in Scotland, near the hamlet of Tomatin. Tomatin Distillery objected to the proposals by TTC to develop a retail site nearby under the name “Tomatin Trading Company”.

This case confirms the test for establishing bad faith in trade mark applications and considers what is required to establish infringement under s10(2) of the Trade Marks Act 1994 (TMA), as well as the application of the “honest practices” defence in s11(2). It will be especially relevant to whisky companies and other businesses in the food and drink sector looking to protect their brands.

DISPUTE HISTORY

In 1963, Tomatin Distillery registered a word trade mark for TOMATIN in relation to Scotch whisky. In 2018, it successfully applied for two further marks in relation to classes 33 (alcoholic beverages), 35 (retail services), 41 (education) and 43 (bar and leisure services), one being a word mark and the second being a figurative mark (the 2018 Marks).

In January 2019, TTC applied to register its own trade mark in respect of its sign, which consisted of the words TOMATIN TRADING COMPANY and other figurative elements. The application was made in relation to a number of classes, including those covered by the 2018 Marks. TTC subsequently agreed to remove class 33 from its application at the request of Tomatin Distillery but continued with the application in respect of the other classes. Tomatin Distillery opposed the application



“ The onus was on TTC to establish bad faith, and... this was a ‘high test’ that had not been met ”

and TTC challenged the validity of the 2018 Marks. The UK IPO remitted the invalidity challenge to the Court of Session in Scotland, and suspended TTC’s application.

Before the Court of Session Tomatin Distillery argued that the use of “Tomatin” and “Tomatin Trading Company” by TTC amounted to trade mark infringement under s10(2) and s10(3) TMA, as well as passing off.

In response, TTC argued that:

1. The action was premature, as infringement could not be determined until the development was built/operational.
2. There was no risk of confusion because in the development the franchisees would have their own businesses under their own names.
3. The goods and services on offer would differ from those at the distillery.
4. TTC could rely on the “honest practices” defence in s11(2) TMA.
5. The 2018 Marks were invalid, having been registered in bad faith.

After proof (trial), the IP Judge in the Outer House of the Court of Session found in favour of TTC on all of the key issues. Subsequently, Tomatin Distillery appealed some of the aspects of the decision at first instance. There were three key questions to be determined:

1. Was the 2018 figurative mark invalid by reason of bad faith?
2. Did TTC’s sign infringe Tomatin Distillery’s trade mark in terms of s10(2) TMA?
3. Was the “honest practices” defence applicable?

Ultimately, the Inner House found that there was no infringement by TTC but also that Tomatin Distillery had not acted in bad faith.

APPEAL ANALYSIS

The IP Judge had held that there was “cogent and compelling” evidence of bad faith and that Tomatin Distillery did not act with *bona fide* intention to use the 2018 Marks. She considered that Tomatin Distillery had pursued “a deliberate strategy of seeking very broad protection of the trade marks regardless of whether it was commercially justified; and that its motive in doing so was to use the 2018 Marks as a weapon to thwart [TTC]”.

The Inner House noted that the IP Judge appeared to have especially relied on two points. First, that Tomatin Distillery had sought trade mark protection in relation to the services that the media had set out that TTC was pursuing in March 2018. Second, that it made its application for the 2018 Marks soon after that with no credible explanation for the timing, as it had made limited use of TOMATIN in relation to non-whisky goods and services and did not plan to change that going forward.

The Inner House disagreed with the IP Judge. Crucially, it confirmed that the onus was on TTC to establish bad faith, and that this was a “high test” that had not been met. It noted that Tomatin Distillery was to be expected to have sought and obtained trade mark protection, given that IP is its prime asset. As such, Tomatin Distillery could be said to have acted with “commercial prudence”.

At any rate, the Inner House found that Tomatin Distillery had made use of the trade

KEY POINTS

- + This decision highlights the difficulties encountered by brands that name a product after a geographical location
- + Even limited use of the trade mark is sufficient for there not to be bad faith
- + The average consumer of the party arguing trade mark infringement is considered when deciding if there is infringement under s10(2) TMA

MARKS

THE 2018 FIGURATIVE MARK (UK00003314854)



TTC’S FIGURATIVE SIGN (UK00003367610)



mark in relation to non-whisky goods and services per the classes in its application (through its visitor centre), and it did not matter that this use was limited.

INFRINGEMENT IN FOCUS

On appeal, Tomatin Distillery only relied on s10(2) TMA, which sets out that there is infringement if an identical/similar sign is used in relation to similar/identical goods or services, and there exists a likelihood of confusion on the part of the public, including the likelihood of association with the trade mark.

The Inner House found that TTC's sign and Tomatin Distillery's figurative trade mark were not identical, as there were clear visual, phonetic and conceptual design differences. Accordingly, the key issues to consider in deciding if there had been infringement were similarity and the likelihood of confusion.

In the first instance, it was necessary to establish the average consumer of the goods or services. The Inner House identified a number of characteristics that this person would be deemed to have, including that they would be "reasonably well informed ... perceive a mark as a whole, and ... proceed on the basis of overall impression".

There had been debate before the Inner House regarding whether it was the average consumer of Tomatin Distillery's goods and services or TTC's goods and services that should be considered. The Inner House agreed with the IP Judge that it was the former, and that, as the typical consumer of Tomatin Distillery's goods and services was a "whisky aficionado" who was "discerning about single malts", such a consumer was unlikely to be confused.

It also held that it considered that other consumers visiting TTC's retail site, who had less knowledge about whisky, would "readily distinguish between the parties' respective goods and services". The Inner House relied on those consumers understanding "Tomatin" to be a geographical descriptor and considered that the addition of the words "Trading Company" distinguished TTC's sign.

HONEST PRACTICES

In any event, the Inner House held that if there had been infringement, TTC would

have been entitled to rely on the defence in s11(2) TMA, namely that a registered trade mark is not infringed by the use of a sign which concerns geographical origin if the use "is in accordance with honest practices in industrial or commercial matters". The Court made reference to the fact that the sign indicated where the goods or services would be provided, which was not dishonest, and this was also in accordance with the practice of other local businesses. Crucially, it found that Tomatin Distillery did not have a monopoly on the use of "Tomatin" for non-whisky classes.

While the Inner House refused the reclaiming motion (appeal), having found that

“ This decision highlights the difficulties encountered by brands that choose to name their product after a geographical location

Tomatin Distillery had not acted in bad faith in making the application for the 2018 figurative mark, it overturned the IP Judge's decision that this mark was invalid apart from in respect of Scotch whisky. This decision highlights the difficulties encountered by brands that choose to name their product after a geographical location. This will be particularly relevant to companies in the food and drinks sector that rely on geographical markers.

For one thing, there remains a high test for establishing bad faith, especially when the applicant for the trade mark relies on IP as its main asset and can be expected to have sought and obtained trade mark protection out of "commercial prudence". In addition, even limited use of the trade mark is sufficient for there not to be bad faith. Finally, it is the average consumer of the party arguing trade mark infringement who is to be considered when deciding if there is infringement under s10(2) TMA.

Note: Brodies LLP acted as Solicitors for The Tomatin Distillery Company Ltd.



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There is still time to register for our in-person Autumn Conference. Find out more at citma.org.uk/events

Calendar

Our upcoming events for members and other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
6th September	CITMA Webinar Anti-money laundering	Online	1
7th September	IP Inclusive & Jonathan's Voice Darkness to hope	Online	1
8th September	CITMA Lecture Glasgow IP litigation in Scotland	Burness Paull, Glasgow	1
22nd September	CITMA Paralegal Seminar	Gowling WLG, London	3
28th September	CITMA and UK IPO roadshow	Womble Bond Dickinson, Leeds	2
29th September	CITMA and UK IPO roadshow	Brabners, Manchester	2
6th October	CITMA Webinar Copyright in the video games industry	Online	1
12th October	CITMA Autumn Conference* Stepping into the future	The Library of Birmingham	5
13th October	CITMA Webinar Taxation and IP	Online	1
18th October	CITMA Paralegal Webinar Working with non-use requirements	Online	1
8th November	CITMA Webinar UK case law update	Online	1
17th November	CITMA and UK IPO roadshow	Foot Anstey, Bristol	2
2nd December	Christmas Lunch*	Royal Lancaster, London	
9th December	Northern Christmas Lunch*	Browns Brasserie, Leeds	

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THE TRADE MARK 20

Q&A



Olusegun Oyesanya

I work as... an Associate with the IP department in the law firm of Jackson, Etti & Edu in Lagos, Nigeria.

Before this role... I worked as an Associate with SPA Ajibade & Co. The nature of my work was cross-departmental as I was fresh out of law school, Lagos campus. I completed my university degree at Obafemi Awolowo University.

My current state of mind is... joyful and excited about many opportunities opening up for me and my friends and colleagues.

I became interested in IP... when I took the elective course at the university. The dynamics of the sector and the seeming dearth of awareness among many businesses in my country inspired me to work in the sector.

I am most inspired by... my eldest brother because of his understanding and views on issues. He is able to balance radical interests and reintroduce traditional principles of life in the most exciting ways.

In my role, I most enjoy... working on complex transaction deals, such as advising a brand on safe havens or jurisdictions for investment in Africa.

In my role, I most dislike... working on lengthy legal opinions given on a complimentary basis.



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The dynamics of the sector and the seeming dearth of awareness among many businesses in my country inspired me to work in IP

On my desk is... a laptop, cash, a bag and a bottle.

My favourite mug says... nothing (it is blank).

My favourite place to visit on business is... Bali, Indonesia (anticipated). I would like to visit Bali because of its rich cultural tourist attractions.

If I were a trade mark/brand, I would be... Apple or Nike; they are so classy!

The biggest challenge for IP is... matching the pace of technological advancements and developing uniform regulatory adjustments to address infringement.

The talent I wish I had is... singing.

I can't live without... doing something creative.

My ideal work day would include... a cup of coffee in the morning, attending to emails, speaking to juniors and getting involved in a strategy session.

In my pocket is... a wallet and a handkerchief.

The best piece of advice I've been given is... never to run away from challenges and opposition but embrace, adapt (if necessary) and thrive.

When I want to relax I... watch an action blockbuster movie at home with lots of food to eat.

In the next five years I hope to... travel to at least five countries, become an IP star and positively affect my world.

The best thing about being a member of CITMA is... meeting trade mark professionals, forming new connections and having my contributions visible to the world.

www.ip-support.co.uk
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info@ip-support.co.uk

A large, stylized graphic of the letters 'IP' in a serif font, centered within a white circular shape. The background is a light blue-grey gradient. The 'I' and 'P' are white, and the circular shape is also white, creating a high-contrast logo.

IP

Our current vacancies include:

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- Trade Mark Attorney (International Law Firm) – London Hybrid
- Trainee Trade Mark Attorney – London Hybrid
- Trade Mark Paralegals – London, South West & Yorkshire
- Senior Trade Mark Administrator – Fully Remote

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