

CITMA REVIEW

ISSUE 460 SEPTEMBER 2020

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PLASTIC-FREE
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*How are Greta and co.
protecting their brands?*



CAPITALIZE ON YOUR IP

Future-proof business solutions for your Intellectual Property

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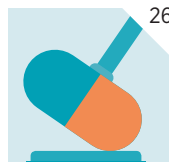
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PRESIDENT'S WELCOME OUR LATEST STEP REFLECTS OUR TIMES

Creating a sustainable future has never been more important. Glaciers in Greenland are melting faster than ever, and the window of opportunity to stop the Earth warming permanently is getting smaller each day.

And, while distressing and disruptive, the events of this year have given many of us the chance to slow down and get outdoors, to take in the nature that surrounds us – whether that's a park in London or out in the countryside.

To contribute to a more sustainable future – and the future of our natural environment – I am pleased to say that from this issue onwards you will receive your *CITMA Review* in a biodegradable starch wrap. We will also continue to look at how we can minimise waste and promote recycling in the profession.

As I mentioned last issue, it is imperative that we move with the times and reflect current concerns. I'm proud to say that in this issue, not only do we have a six-page feature on environmental activists and their trade marks, but we also have a feature on unconscious bias in our society and what we can do to tackle it.

There is still much more for us to do, but I believe we are taking steps in the right direction, and we will continue to do so.

As you may have seen already, we are bringing you a virtual Autumn Conference this year, with technology that allows you to build your own avatar so you can interact with delegates in a whole new way.

Could this be the future of conferences? We will have to see. I hope to see you all there – virtually, of course.

Richard Goddard, CITMA President



Plastic facts:

Assessing our impact

CITMA REVIEW

Our mail-out is now more planet-friendly

In the past, our default method of mailing your *CITMA Review* has been to wrap it in plastic to protect it, but the damaging effects of single-use plastic have made us take a different approach moving forward.

As a result, the wrapper protecting your latest *CITMA Review* is made from a starch-based biopolymer

that consists mainly of potato and maize starch.

We are pleased to share that it contains no plasticisers or toxins and as a result, it is 100 per cent biodegradable and fully compostable.

Simply dispose of it in your household food or garden-waste bin or any compost heap.

ARE YOUR DETAILS UP TO DATE?

Make sure you're getting our latest insights delivered straight to your inbox. Log in to check your contact details are up to date: citma.org.uk/update

1,450

The average number of copies of each Review posted

11.6kg

OF PLASTIC PER ISSUE (8g PER COPY)

That's how much we are saving by moving to a starch-based wrap



REVIEW

That's a saving equivalent to

21,000

plastic straws per issue

93kg

Over one year, this represents a reduction of 93kg of plastic, equivalent to 168,000 plastic straws



THE POWER OF AI

The Legal Services Board has released a report that considers how artificial intelligence (AI) could better support, enable and potentially replace human judgments over the course of a trade mark's lifecycle. On behalf of CITMA, Birgit Clark (Baker McKenzie) joined 10 leading names in legal technology and regulation to debate, discuss and dissect perspectives on lawtech. See citma.org.uk/powerofai

IPO PROPOSES PRELIMINARY INDICATION TRIAL

Demand for the UK IPO's tribunal service continues to grow, a trend that is likely to continue following the end of the Brexit transition period. To help meet future demand, the IPO has said it intends to reintroduce preliminary indications for a trial period of six months. See citma.org.uk/PIsatUKIPO



EUIPO JOINS DAS

The EUIPO has joined WIPO's digital access service (DAS) for registered Community designs (RCDs). Applicants can now exchange RCD priority documents electronically through the DAS. See citma.org.uk/EUIPOjoinsDAS

DIFFICULT TIMES WON'T DERAILED OUR PLANS FOR PROGRESS

Tim Moss brings us up to date on how the Office is responding to the world's ongoing challenges

I'm delighted to write my first contribution to your *CITMA Review* and to provide an update on what's going on at the IPO. I must admit it has been a strange and challenging year so far. The world has faced its biggest challenge yet, with the outbreak of the COVID-19 pandemic causing a significant impact to the global economy. However, the IP framework has flexibility built into it, and we responded with versatility to the challenges thrown at us by these new circumstances.

We relaxed the pressures on users of the IP system by introducing interrupted days and temporary fee changes. We created new internal processes to make sure we continued to deliver for our customers while keeping staff safe. Given the speed at which this disruption descended upon the country, I am very proud of how we responded as an organisation. We were able to maintain a near 100 per cent level of service to our customers while moving to homeworking almost seamlessly.

In the current situation, one thing is clear: innovation is needed now more than ever. It increases productivity, grows markets and creates jobs. IP is crucial to this by providing individuals and businesses with the confidence to invest their time, money and energy into developing something new.

“

I am very proud of how we responded as an organisation

We published our 2020-2021 Corporate Plan in early July, which sets out the detailed actions we will take this year and how that will contribute to making the UK the most innovative country in the world. Our focus is on delivering excellent IP services, creating a world-leading IP environment and making the IPO a brilliant place to work. Our key priorities for the coming year are:

- **Delivering our core services.** We will continue to grant high-quality IP rights on time, meeting the expectations of all our customers.
- **Supporting the UK's independent economic and political future.** We

will work right across Government to make sure we develop our IP system in line with our domestic priorities and help businesses understand the IP implications of leaving the EU.

- **Transforming the way we provide our IP services to customers.** This is essential if we are to deliver excellent IP services in the future. We want to ensure that the services we provide support innovative businesses in an increasingly digital environment, and we will put our customers at the heart of this work.

- **Understanding the impact of technology on the IP framework.** We need to stay ahead of the challenges coming our way and make sure we respond to and enable change.

We have faced many challenges this year and there will be more to come. One important issue that has emerged is address for service. I am glad to say that we have responded to the calls for change here by seeking views from across the IP community, and I look forward to updating you on the outcome of this in the future.



Tim Moss

is Chief Executive of the UK IPO

A letter from the UK IPO will now appear in the September and May issues of *CITMA Review*.

LOOKING TO **GROW** YOUR TEAM?



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D I V E

BREAK YOUR SILENCE

MICRO-AGGRESSIONS

BLACK LIVES MATTER

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Everyone must be a proactive ally if we are to put an end to racism, writes Hannah Burrows

I N C L U S I O N

When people see my name or hear my voice, they do not always expect me to look the way I do. “Oh, are you Hannah?” is often said with surprise, when I have turned up for an interview and the interviewer has looked around the room searching for a face other than mine.

There’s probably no malice in that response, but it’s clear that when that person saw my name on an email or heard my voice on the telephone, they didn’t expect a black person to walk

through the door. This is often due to a preconception of what others think is a name belonging to a black person, or how black people speak.

There is the naïve presumption from some people that because they don’t hear or see acts of overt racism, this means that racism is no longer prevalent in modern society. George Floyd’s death in the US [attributed to the actions of a Minneapolis police officer] was enough to demonstrate to many that this isn’t the case. Racism is very much alive, and it takes many forms: from the most violent cases of police brutality and murder, to

much subtler guises, such as microaggressions or unconscious bias. The latter refers to forms of racism that are not obvious, but that are cumulative and affect the career progression, work environments and mental health of black people.

MICROAGGRESSIONS

Microaggressions are comments or actions that are unintentional or subtle forms of discrimination against culturally marginalised groups such as black people and ethnic minorities (so-called “BAME groups”). These microaggressions

can take the form of physical actions or verbal comments.

Consider the subject of hair. On countless occasions, I have endured the unwanted touch of hands on my new braids – both inside and outside the workplace. Then there are the constant questions: “How does your hair stay in?” or “Is that all your hair?” This may simply be the curiosity of intrigued colleagues about something different or unfamiliar, but as with anything you are unfamiliar with, the most appropriate thing to do is research. There is plenty of information online about Afro hair if you need to access it, rather than making your colleague feel uncomfortable or like a novelty. It’s hard to imagine a similar response to a white colleague’s haircut or freshly dyed hair, even though that too is different.

Other verbal microaggressions include stereotypical and ignorant comments. For instance, I once had a conversation with someone during which I said I didn’t like coconut. A white colleague responded, “but you’re from a hot country”. Hmm... I’m not sure England gets that hot.

Non-verbal microaggressions can involve passive situations. This could be when a black colleague contributes to a discussion or makes a suggestion and they are ignored or overlooked, but when a white counterpart makes the same point that person receives validation.

Likewise, negative personality traits are sometimes attributed to black people. I’ve seen instances where a white colleague’s forthright behaviour has been perceived as assertive, but the same actions from a black colleague have been deemed aggressive, argumentative or an overreaction.

UNCONSCIOUS BIAS

I’m sure we have all attended at least one diversity training session on the subject of unconscious bias. This involves learned stereotypes and prejudices based on certain groups of people, without a

conscious component. And these perceptions can have a significant impact on the recruitment and retention of employees, especially those who are black or members of an ethnic minority.

For example, there is a tendency in the legal profession to consider that the best candidates come from a certain educational background. However, there are plenty of other great candidates who may not have graduated from what is considered to be a top university but who have the right work ethic and a willingness to learn. This type of bias towards a particular educational pathway creates a barrier to entry for those from disadvantaged backgrounds and will disproportionately affect the black community.

Think you would never be biased? If you haven’t already, take a look at the Harvard Implicit Associations test (at <https://implicit.harvard.edu/implicit/>), which includes a test to assess racial bias. The idea behind the test is that you respond as quickly as you can to various questions and prompts to assess the level of unconscious bias you may have towards people of different origins. It can be an eye-opening experience.

There are a number of other ways to move forward too:

- **Be an ally.** This is not simply a question of having a black friend or not being overtly racist. It’s about being actively anti-racist. Speak up when you see microaggressions in the workplace or hear stereotypical or racist comments. Confrontation can be uncomfortable, but it’s not OK to keep quiet when you witness offensive actions or hear inappropriate comments. Silence is complicity.

“ Listen, value and believe people – and ask what you can do to help

- **Listen to your colleagues.** If a colleague is telling you about a difficult situation they’re facing, listen. Too often when an issue is raised, it’s dismissed with speculative reasoning (ie, “There must be another reason why that was said” or “It’s all in your head”). When you’re not experiencing discrimination yourself, it can be hard to believe it’s happening to someone else. But please listen, value and believe people – and ask what you can do to help.

- **Educate yourself.** Read and learn more about systemic racism and white privilege to gain some understanding of what it means to be black in today’s society. This will enable you to better support your black colleagues.

- **Champion inclusion.** Having a diverse workforce and meeting a quota isn’t the end of the matter. It’s about being inclusive, which means listening and supporting individuals’ needs. Initiatives such as IP & ME (a branch of IP Inclusive) have been set up to support people from “BAME” backgrounds in the IP profession. This group is open to people in that community as well as those who consider themselves allies.

Black lives matter, and they need to matter more than they do now. So I encourage you all to take note of the above and take action – now. ●



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EDU-
CATE

A CALL TO

ACTION

Allister McManus
issues an IP wake-up
call to some well-known
environmental
activist groups





Following the release of a damning report by the Intergovernmental Panel on Climate Change in 2018,

plus a fresh wave of reporting of scientific markers that tell us our planet is on a dangerous warming trajectory, there has been a significant acceleration in organised environmental campaigning in recent years. A number of environmental activist groups have started claiming a place in our news cycle.

But as these organisations begin to take up more space in our Twitter feeds, how are they protecting their brands both from appropriation and attack?

THUNBERG TAKES ACTION

The importance of this question is highlighted by the recent issues that Swedish activist Greta Thunberg has had with unauthorised third-party trade mark applications in Germany for a number of marks (shown right). Fortunately, these applications are now all marked as withdrawn on the German Patent and Trademark Office's database, which seems to indicate that Thunberg and her legal team were able to take the appropriate action.

Thunberg has since filed three EU trade mark (EUTM) applications in the name of "Stiftelsen The Greta Thunberg and Beata Ernman Foundation". These were registered on 22nd May 2020 and cover classes 35, 36, 41 and 42 ("advertising, business management", "fundraising services for the promotion of public awareness of environmental issues", "education services" and "scientific research services") for: EUTM No. 018171377, GRETA THUNBERG; EUTM No. 018171380, FRIDAYS FOR FUTURE; and EUTM No. 018171383, SKOLSTREJK FÖR KLIMATET.

Stiftelsen The Greta Thunberg and Beata Ernman Foundation subsequently filed an international

“ Clearly, Greta and co. are no longer wasting time when it comes to trade mark protection

application for the FRIDAYS FOR FUTURE mark on 15th June 2020, based on EUTM application No. 018171380. The international application designates Australia, Canada, India, Japan, Norway, Russia, Switzerland and the US. Clearly, Greta and co. are no longer wasting time when it comes to trade mark protection.

But what other campaigning organisations have taken steps towards trade mark registration?

EXTINCTION REBELLION

The well-known environmental campaigning group Extinction Rebellion (XR) has also experienced problems with unauthorised third-party applications – for example, a German registration No. 302019225688 (shown overleaf). This registration is now marked as cancelled, so it would appear that XR was able to deal with the issue via the German trade mark cancellation process.

However, of further concern to the XR brand is unauthorised use by eco-fascists on posters promoting racism and false affiliation with the XR movement by incorporating XR brand elements. This has included the appearance of imposter stickers incorporating XR-linked typography and its logos that suggest that the group sees COVID-19 as a solution to climate change.

The XR movement, founded in the UK in May 2018, has expanded rapidly and received notable media attention in the wake of its ongoing “rebellions” around the world. Its stated aim is to use non-violent civil disobedience to compel government action to avoid reaching tipping points in the climate system, biodiversity loss and the risk of social and ecological collapse.

XR's most recognisable branding element is the “circled hourglass”, known as the extinction symbol, which serves as a warning that time is rapidly running out for many species. As a means of capturing public attention, XR's co-ordinated branding design is striking and effective. However, despite its highly protectable brand elements, the UK, EU and US trade mark position for XR is pretty dire – in fact, it's virtually non-existent. ▶

Greta Thunberg: provocative marks



No. 3020192285305
in classes 14, 21, 25, 35, 41



No. 3020192303001
in classes 14, 21, 25, 35, 41



No. 3020192285259
in classes 14, 21, 25, 35, 41



No. 3020192302773
in classes 14, 21, 25, 35, 41



No. 3020192285364
in classes 14, 21, 25, 35, 41



No. 3020192303230
in classes 14, 21, 25, 35, 41



This is perhaps partly from necessity. The extinction symbol was created by London-based artist ESP in 2011, and on the website extinctionsymbol.info, the artwork is available for non-commercial use. There, it is explained that use “by individuals in their personal artwork or other forms of expression is strongly welcomed and encouraged”, but this comes with the proviso that any form of commercial use is completely against the symbol’s ethos and should be refrained from.

Nonetheless, it is interesting that two UK trade mark (UKTM) applications relating to the XR movement were filed on 21st November 2019 by London-based design studio This Ain’t Rock’n’Roll Ltd, which has been at the helm of XR’s Extinction Rebellion Art Group, creating the recognisable and striking graphics for the movement. These are UKTM application No. 3446061 for the “circled hourglass”/“extinction symbol” in classes 9, 14, 18, 25 and 26, which was opposed on 6th March 2020 and withdrawn on 6th April 2020, and UKTM application No. 3446046 for EXTINCTION REBELLION in classes 9, 14, 18, 25 and 26.

The remaining pending UKTM application for EXTINCTION REBELLION was opposed on 20th January 2020 by Jason and

rocker tunnel



German registration
No. 302019225688

This Ain’t Rock’n’Roll’s applications:



UKTM application
No. 3446061

EXTINCTION REBELLION UKTM application
No. 3446046

Christopher Kingsley, founders of multimedia games studio Rebellion. The UK IPO website indicates that the opposition proceedings are currently in the evidence rounds, and the period of disruption caused by the COVID-19 pandemic may have extended the original deadlines for these proceedings. The application covers class 9 for “magnetic badges”, class 14 for “metal badges for wear [precious metal]”, class 18 for “bags; luggage... wallets”, class 25 for “clothing; footwear; headgear” and class 26 for “button badges; embroidered badges; buttons... novelty buttons [badges] for wear”.

Considering that there are differences between EXTINCTION REBELLION and REBELLION, and that the XR movement clearly

operates in a different field to the Rebellion studio, settlement via coexistence would seem to be a better option than protracted opposition proceedings.

The XR situation also illustrates a potential issue when it comes to trade mark protection for environmental campaign groups. Who will own the trade mark registrations? By their very nature, these are collective, grassroots movements that are primarily sustained by the involvement and activities of their members, but they can quickly become worldwide concerns. In some cases, this may make it difficult for the name and branding to be easily identifiable as belonging to a single legal entity.

The traditional concept of IP protection may be at odds with an environmental group’s free-spirited attitude and how the movement operates and organises, particularly where it is explicitly non-hierarchical. For example, at the bottom of the XR website homepage, there is the following “copyright info”:

“Extinction Rebellion (XR) is a do-it-together movement. All our design and artwork can be used non-commercially for the purpose of planet saving. This does not mean creating merchandise for fundraising or sending XR a percentage of your sales. We do not endorse



“ *The traditional concept of IP protection may be at odds with an environmental group’s free-spirited attitude and how the movement operates* ”

or create any merchandise and we will pursue and prosecute anyone who does. The extinction symbol was designed in 2011 by street artist ESP, who loans XR usage on the same basis”.

Arguably, this approach does not sit comfortably with the traditional concept of trade mark protection and enforcement, which usually involves strict control when it comes to allowing third-party use of branding elements. This statement is also contradicted by UKTM application No. 3446046 for EXTINCTION REBELLION, which clearly covers various merchandising items such as clothing and novelty badges.

However, attitudes within the movement may have had to change in order to preserve the integrity of the movement’s image, which risks harm by unauthorised third-party use/exploitation. Nonetheless, it’s clear that XR’s lack of trade mark protection for its full name and “circled hourglass” leave it open to exploitation by third parties until a protection and enforcement strategy is in place.

THE SUNRISE MOVEMENT

For the Sunrise Movement group, the US appears to be its priority in terms of trade mark protection. No UK or EU applications/registrations have been located. However, there is a US registration No. 58 and 38782 (Serial No. 88272446) for SUNRISE MOVEMENT, owned by “Sunrise non-profit corporation”, filed on 23rd January 2019 and registered on 20th August 2019. The registration contains a class 35 specification covering “promoting public awareness of the need to make climate change an urgent political priority across the United States, to end the corrupting influence of fossil fuel executives on the country’s politics, and to elect leaders who stand up for the health and wellbeing of all people, by means of public advocacy”. Quite a mouthful.



The Sunrise Movement’s sun badge logo

In registering the word mark, the Sunrise Movement has taken the necessary first steps, but its website contains no branding guidelines. The movement uses a distinctive “sun badge” logo too, which it should also register as a trade mark.

EARTH STRIKE

No UK, EU or US applications/registrations have been located for this group. Its website claims that it has endorsement from XR and “thousands of members in over 60 countries”. Presumably, either trade mark protection is not on the agenda for the Earth Strike movement, or perhaps local trade mark attorneys were also on strike at the time.

Much like XR, Earth Strike states that: “As long as [its] principles are followed, anyone is free to organise a local Earth Strike chapter and run it autonomously how they see fit”. The group is light on stand-out brand elements, although it uses a match and leaf logo, which would benefit from trade mark registration, in addition to protection for the Earth Strike name itself.

FRIDAYS FOR FUTURE

This organisation’s name has an interesting position on the EUTM register. Janine O’Keeffe, the organiser of Thunberg’s popular fridaysforfuture.org website, has recently registered an EUTM

covering a broad but sensible range of goods and services for the mark FRIDAYS FOR FUTURE.

EUTM No. 018147674 was filed on 5th November 2019 and registered on 22nd May 2020 for classes 9 (“electronic publications; sound/video recordings; apps”, 16 (“printed matter”), 18 (“bags; rucksacks; purses; wallets”), 25 (“clothing; headwear; footwear”), 35 (“promotional services relating to awareness of social issues including climate change”), 41 (“provision of educational information relating to current events”), 42 (“research into climate change; advice and consultancy services relating to environmental issues”) and 45 (“providing information about political issues, public policy, and social issues in the fields of climate change and environmental issues”).

However, as discussed earlier, another registration for the identical trade mark (EUTM No. 018171380) is owned by Greta Thunberg’s “Stiftelsen The Greta Thunberg and Beata Ernman Foundation”, filed on 23rd December 2019 for classes 35 (“advertising; business management; advertising and other services to promote public awareness of environmental issues and initiatives”), 36 (“insurance; financial affairs; provision of charitable fundraising services in relation to the promotion of public awareness of environmental issues ...”), 41 (“education and training relating to nature conservation and the environment”) and 42 (“providing scientific information in the field of climate change and global warming”).

It is not clear whether this is coincidental, and we can assume the parties did not engage in opposition



FIRE DRILL FRIDAYS

The website for Fire Drill Fridays claims inspiration from Greta Thunberg’s Fridays for Future movement and celebrity involvement from none other than the well-known actress Jane Fonda. The focus is on eradicating the need for fossil fuels, and taking that fight directly to the US Government and the President. No UK, EU or US applications/registrations have been located,



A Fire Drill Friday environmental protest at the US Capitol in Washington, DC, with actor and activist Jane Fonda speaking about the importance of tackling global warming

proceedings, given their connection. However, two identical marks filed roughly a month apart by different owners for identical/similar goods and services in the same environmental arena is not ideal. A simple assignment from O’Keeffe to Thunberg’s foundation may be the better option.

Of further interest is the USPTO database, which lists an application for FRIDAYS FOR FUTURE (Serial No. 88343068) filed on 17th March 2019 by a German applicant, Gsoedl Michael DBA, for “T-shirts” in class 25, only to be abandoned on 3rd December 2019 for failure to respond to the US office action within the six-month deadline. This applicant does not appear to have any connection with either O’Keeffe or Thunberg. This emphasises the recurring problem of unaffiliated third-party applications for these types of marks, which may be more difficult to challenge without an existing registration.

and while there is plenty of online content and interviews about this organisation, not much stands out in the form of brand elements, aside from a figurative mark incorporating the name itself.

MOBILIZE EARTH

This organisation burst onto the scene in January 2020, thanks to a film featuring Joaquin Phoenix and other famous names. While no UK or EU applications/registrations have been located, the USPTO database lists a registration (No. 4179127; Serial No. 85484056) for MOBILIZE THE EARTH, filed on 30th November 2011 and registered on 24th July 2012, in the name of

The Fire Drill Fridays logo



“ The one thing these groups have in common is the need for increased trade mark protection

Earth Day Network, Inc., a charitable corporation based in New York. The registration covers class 35 (“promoting public awareness of environmental matters”). However, the registration is marked as cancelled from 1st March 2019 because the registrant failed to file the required Declaration of Use within the six-year statutory period.

The organisation’s current website states that “Mobilize Earth is the public name of Project Earth 2025[®], a non-profit organization working towards a thriving future for all. Now is the time to mobilize, to act as individuals, build bridges, find common ground, come together and demand action”. The organisation’s website includes reference to chosen “film partners”, which are XR and non-profit organisation Amazon Watch, and the site includes requests for donations to benefit those groups.

For a group taking such an interesting approach to campaigning, it is a shame that nothing appears to have been done to develop a trade mark portfolio.

THE IDEAL STRATEGY?

It is clear from the examples above that the one thing these groups have in common is the need for increased

trade mark protection, more control over how content is used, clear brand usage guidelines and a sensible enforcement strategy.

For a good example of how to be an effective environmental campaign group and be IP-savvy at the same time, just look to the World Wildlife Fund (WWF) and its brand strategy. A simple review of its website illustrates the staggering degree of professionalism and control over its brand and content that the “world’s leading independent conservation organisation” has achieved. Of course, a healthy budget makes all the difference, but it is worth noting that the WWF website contains everything from branded merchandise to content for children to educate them on environmental issues such as climate change, deforestation and protecting species, all presented at various learning levels. There is even an “environmental footprint calculator”.

In terms of trade mark protection, the WWF, under the entity “WWF-World Wide Fund for Nature (formerly World Wildlife Fund)”, has filed around 231 UKTMs, 11 EUTMs and various USTMs, with a particular focus on its well-known panda bear logo. It even wrestled the former World Wrestling Federation into submission over the use of the WWF mark, forcing it to change its name to World Wrestling Entertainment.

This robust approach to trade marks has arguably not affected the WWF’s ability to produce a staggering number of climate change campaigns over the years, including evocative images of displaced seals sleeping on park benches and Tarzan swinging through a barren rainforest.



So while movements such as XR have made their position on the control and definition of their branding clear to supporters, there are still obvious weaknesses. In terms of overall strategy, XR’s brand is undoubtedly the most exposed and exploited of all the major environmental campaign groups.

Specifically, granting “autonomy” in relation to the use of its branding elements leaves XR open to abuse by eco-fascists and the like. The lack of registered protection for the key branding elements and the added complication that XR is not the original author of the extinction symbol will not help either.

Of course, for all of these groups, a consistent and measured brand enforcement strategy, use of trade mark watch notices to pick up on suspicious applications, and internet monitoring services to identify potential infringements would likely prove costly exercises and would impinge on their scarce resources. However, it would arguably be money well spent in terms of avoiding significant damage to their reputations, which would distract from their important messages on behalf of the planet. ●



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PEER POWER

Elizabeth Rimmer outlines the value of an emotional support service

We all know the phrases “a problem shared is a problem halved” and “it’s good to talk”, but we may not realise just how far the benefits of talking about how we feel – particularly when we’re feeling low – extend.

When we’re in a difficult situation, we lose our problem-solving abilities. It can be impossible to focus, and it can seem overwhelming to choose what action to take. Sometimes, a friendly ear and a nudge in the right direction are all we need to move on. Social and emotional support and the role of individuals, families and communities in delivering this are vital to managing wellbeing. We all need someone to talk to about personal matters without judgment and in confidence – to listen to us and offer help when things get on top of us.

For some of us, however, finding a friendly ear isn’t just a matter of talking to a friend or family member. Perhaps we don’t want to worry those who are closest to us. Maybe they have their own problems going on. We might not have spoken to them in a while because we’ve been so busy at work. We may feel they won’t understand or be afraid to unburden ourselves in front of them. Some of us just don’t have people we can turn to in difficult times for a variety of reasons.

This is where peer support can play an important role. In a peer support situation, people use their own experiences to help others. Getting emotional support from people who have similar lived experiences can improve wellbeing, increase self-esteem and confidence, provide hope that we can move on from a difficult situation and help us manage it.

MUTUAL BENEFITS

A review of more than 1,000 research studies on peer support found that it helps people feel more knowledgeable,

confident and happy, and less isolated and alone. The reciprocity that occurs through peer support builds social capital, which in turn is associated with wellbeing and resilience. The opportunity to support each other is mutually beneficial. It helps us build empathy, and it fosters positive behaviours.

At LawCare, through our network of 100 trained volunteer peer supporters, we offer emotional support by telephone for those who are working in or have worked in the legal profession. Our supporters all have first-hand experience of legal education, training and practice and lived experience of a difficult time in their personal or professional lives.

They understand life in the law and all its challenges; this is what makes our support service unique and our supporters well-placed to help other legal professionals. Our peer supporters reflect the diversity of the legal profession across the UK and Ireland and are drawn from all branches of the legal profession and all career stages. They are from different age groups, genders and ethnic groups.

Our supporters provide knowledge, emotional assistance, experience, practical help and social interaction. They are not counsellors and they can’t provide people with solutions to their problems, but they have been specifically selected and trained in listening skills and are empathetic and non-judgmental. Peer supporters usually provide support over the course of two or three phone calls, but it can involve fewer or more calls depending on the individual’s need.

One of our supporters, Claire, who had herself experienced a critical illness, told us: “One of the real privileges of this is being able to say that I have stood where they stand and understand what they’re thinking, and have felt the anxieties they’re feeling. When you’ve had a

critical illness, just going to work presents a whole new set of issues you’ve never experienced before. It can be an exceptionally bumpy ride. You often feel like you’re taking one step forward, then two steps back. It’s truly amazing to walk that journey with another person to a place where the rollercoaster is less bumpy.”

COMMON ISSUES

The most common issues our peer supporters can help with are:

- Anxiety;
- Stress;
- Depression;
- Addiction;
- Bereavement;
- Relationship problems at work;
- Returning to work after illness or a career break;
- Worrying whether law is the right career for you; and
- Facing disciplinary proceedings with your regulator or employer.

One user contacted us for support when she had turned to alcohol to help her deal with a heavy workload and stress at work. Following help from a LawCare peer supporter, she says: “I’m now back on track thanks to her. I’m doing well and billing, and the pressure has come away from me. I’m also not drinking. She was amazing. Thank you so much, keep up the good work, you saved me!”

IS PEER SUPPORT FOR YOU?

Many people find peer support helps them, but it is not for everyone. Before making an application, think about the following:

- Am I comfortable talking about my experiences to new people? Talking about your experiences can make you feel more aware of your own thoughts and emotions.
- Am I comfortable hearing about someone else’s difficult experiences? Listening to someone else’s account of their experiences can help you feel less alone and introduce you to new



ways of coping, but it may also be unhelpful for you.

- Is it the right time? If you are in an acute crisis, peer support may not be right for you at the moment.

If you feel a peer supporter could help you, however, visit our website and complete the application form. One of our team will then be in touch by telephone to discuss your needs and to match you with an appropriate peer supporter. We expect to reply within two weeks of your application, and it may take up to one month to allocate a peer supporter. While we can't guarantee that we will be able to offer you a peer supporter (as this

does depend on your circumstances and their availability), we try our best! If we are unable to allocate a peer supporter, you are welcome to call our helpline for emotional support.

Finally, rest assured that anything you choose to discuss with your peer supporter is confidential. We will only break your confidentiality if

we are concerned that you are at immediate risk of harm to yourself or others. ●

Find out more about LawCare's peer support service at lawcare.org.uk

The LawCare helpline on 0800 279 6888 is open Monday to Friday, 9am-5.30pm.



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CROSSING THE CLASS DIVIDE

The trend for sin-free beverages is raising interesting questions for brand owners, Vanessa Harrow explains

Alcohol sales may have peaked during the COVID-19 lockdown, but wider industry trends suggest a move towards more health-conscious no- and low-alcohol beverages, or “nolo” beverages as they have come to be known.

Alcohol-free social initiatives such as Dry January and Sober October, plus a “generational shift in attitudes towards alcohol”, have helped to drive this trend. One in three young adults are cutting down their alcohol consumption, and a record 23 per cent are choosing complete abstinence, according to research by the Society of Independent Brewers released in March. Meanwhile, alcohol-free spirit alternatives such as Seedlip (now owned by Diageo), Ceder’s and Stryk have changed the way we drink our G&Ts at home.

Yet this new and booming category of drinks raises some interesting questions for producers, retailers and IP professionals. Is a no-alcohol drink the same as a soft drink, for example? Is a low-alcohol beer a sub-category of beer or more closely related to low-alcohol alternatives to wine and spirits? And what does that mean for brand strength, registrations and enforcement strategies?

Retailers have so far tended to group low- and no-alcohol products together on supermarket shelves, positioning nolo beer alongside nolo wine and spirits. In other words, while alcoholic beer, wine and spirits are in their own distinct categories, nolo is a sub-category of its own, with low- and no-alcohol versions of those products grouped together.

Online, for example, Tesco uses the categories: (i) beer and cider; (ii) wine; (iii) spirits, and (iv) low- and no-alcohol. Asda uses: (i) beer, cider and ales; (ii) spirits and ready to drink; (iii) wine, Prosecco and Champagne; and (iv) no- and low-alcohol. Waitrose has a section called “beer, wine and spirits” (with subgroups for each) and then a separate category of low-alcohol and alcohol-free drinks.

This tallies with the way these drinks are marketed and consumed: ie, as “healthier” alternatives to alcohol, as opposed to a new type

Major brands such as Heineken now offer alcohol-free alternatives



of soft drink. However, this does also mean that low- or no-alcohol variants of alcohol categories that have traditionally been kept separate (eg, beer and vodka) are now beginning to be mixed in shops.

In bars and pubs, though, nolo products are often grouped with their traditional alcohol-based equivalents. This is particularly true of beer brands. No- and low-alcohol beers are often available on tap next to a punter’s usual alcoholic craft beer, for example.

THE LEGAL PERSPECTIVE

Low-alcohol drinks fall under class 33 in the Nice Classification system, with the exception of low-alcohol beer (class 32). Similarly, the drinks that we used to know as “alcopops” fall within class 33, although “beer-based alcopops” fall within class 32, as do non-alcoholic mixers that are used together with alcoholic beverages (such as ginger ale, soda water and other soft drinks).

“ In bars and pubs, nolo products are often grouped together with their traditional alcohol-based equivalents

Historically, “the classification of beer in class 32 [was] not based on its low-alcohol content but rather on its characterisation as a soft drink alternative” (Nice Classification Criteria 320002). This is because at the time the Classification was established, beers were often sold by the same companies that produced and/or sold soft drinks.

In other words, the classification is not about the technical nature of production or the level of alcohol in the product, but rather the channels of commerce and the way the consumer perceives the drink. Proposals to transfer beer to class 33 have always been rejected by the Committee of Experts of the Nice Union, although it’s worth keeping in mind that the classification system is administrative and goods in different classes can still be considered similar. (When assessing similarity of goods and/or services in the two classes, the nature and purpose of the goods or services, distribution channels, sales outlets, producers, methods of use and whether brands are in competition or are complementary to each other will also be considered.)

The choice of class will depend, therefore, on the way the brand intends to position the product. For instance, even if a product is beer-based, if the intention is to market it as a low-alcohol beverage which is not beer, then class 33 would likely be the proper class. Conversely, no alcohol alternatives ▶

Sales of nolo beer have risen by around

18%

over the past five years in Western Europe, according to Euromonitor, with sales worth **£63m** expected in 2020 in the UK alone.

One in three young adults are reducing their alcohol consumption, and a record

23%

are choosing complete abstinence, according to research by the Society of Independent Brewers released in March 2020.

Drinks industry body IWSR predicts nolo spirits will grow at a rate of

81.5%

annually in the UK.

for spirits would be registered under class 32, as is the case for Seedlip (EUTM 013021671: non-alcoholic beverages; water; flavoured waters).

LIKELIHOOD OF CONFUSION

From a legal point of view, it is well established that alcoholic beer (class 32) is usually considered similar to alcoholic beverages in class 33. As stated in the EUIPO decision in Opposition No. B 3 089 186 (Alain Vauthier v VESC Ltd), “although their production processes are different, these goods have the same nature since they belong to the same category of alcoholic drinks intended for the same consumers. They share distribution channels since they can be served in restaurants and in bars and are on sale in supermarkets and grocery stores. They can also be found in the same section of supermarkets. Furthermore, they can originate from the same undertakings.”

From a practical and commercial point of view, however, the risk of conflict between these categories of goods may be more manageable. For instance, spirits brands are potentially more likely to accept a somewhat similar mark in the beer

category than they would in, say, whisky or wine. In other words, while it is technically possible to take enforcement action, there has generally been more tolerance and inherent coexistence between class 33 alcohol brands and class 32 beer brands. However, as both product types move into nolo versions, this historical coexistence may be challenged.

COMMERCIAL REALITIES

Traditionally, alcoholic and non-alcoholic drinks have been considered dissimilar. “According to settled case law, although a very large number of alcoholic and non-alcoholic drinks are generally mixed, consumed or indeed marketed together, either in the same establishments or as premixed

alcoholic drinks, to consider that those goods should, for that reason alone, be described as similar [...] would put a large number of goods which can be described as ‘drinks’ into one and the same category for the purposes of the application of Article 8(1) EUTMR” (Opposition No. B 3 049 343, Bodegas del Palacio de Fefiñanes v Heyday Wines).

Similarly, while “beers are similar to wines”, non-alcoholic beverages and energy drinks are dissimilar to alcoholic goods as “they do not originate from the same companies, do not share their method of use, [and] are neither in competition nor complementary” (Opposition No. B 3 072 241, Fine Wines v Zombie).

However, the change in market and consumer behaviour has begun to alter the legal position. In relation to competition between alcoholic and non-alcoholic versions, the EUIPO Guidelines have this to say: “Non-alcoholic beverages on the one hand, and alcoholic beverages (except beers), are sold side by side in shops, bars and on drinks menus, etc. These goods target the same public and may be in competition. It must be concluded that these goods are similar to a low degree” (T-421/10, ROSALIA DE CASTRO, 2011).

In August 2019, the decision in a UK case looking at no-alcohol versions of drinks (O/491/19, Cotswold Botanicals) referenced a previous case which had held that “spirits, particularly whisky” was



“ Products which have traditionally been seen as dissimilar are perhaps no longer so easily separated. The assessment of similarity must therefore also change

not similar to non-alcoholic beverages. However, the ultimate ruling was that: “Just as non-alcoholic beer and non-alcoholic wine in class 32 are similar to beer in class 32 and wine in class 33, I believe that non-alcoholic gin and non-alcoholic whisky in class 32 would be deemed similar to the alcoholic versions in class 33”. The decision added that: “The purpose of a non-alcoholic spirit is to enable those who enjoy the taste of the spirit to indulge without impeding their ability to drive/work or to avoid conflicting with any religious issues surrounding the consumption of alcohol [...] In my opinion, as the specification of a ‘non-alcoholic beverage’ must include non-alcoholic or de-alcoholised spirits, then the goods must be considered similar to a medium degree.”

As this case reflects, products which have traditionally been seen as dissimilar are perhaps no longer so easily separated, and marketing approaches have adapted such that certain non-alcoholic beverages can now be seen as a substitute for and in competition with alcoholic beverages. The assessment of similarity must therefore also change, from both a legal and commercial perspective.

TAKEAWAYS FOR BRAND OWNERS

Brand owners will need to reconsider how consumers encounter their brands. For example, while spirits and beers are usually separated in supermarkets, a no-alcohol section in the same shop is likely to have a no-alcohol spirit drink sat alongside a non-alcoholic beer. Equally, a bar may offer an alcoholic cider alongside a non-alcoholic cider. This will not only affect brands’ monitoring and enforcement, but also clearance searching.

Moreover, as consumer demand for no-alcohol beverages increases, traditional alcohol brand owners might want to review the scope of their protection to ensure it is fit for purpose. Where a traditional alcohol brand may

previously have registered only in class 33, they may now need to look at broadening the scope to include non-alcoholic beverages in class 32.

Care must be taken, however, to ensure that any such move would not contravene potential settlement agreements that have been prepared on the basis of the historic market separation between non-alcoholic and alcoholic beverages. Brands that have previously co-existed without issue may also suddenly find their risk of conflict increasing.

CAUSE FOR CONFLICT?

Alcohol brand owners and their IP advisers also need to take more care in assessing the potential conflict that could arise from applications covering “non-alcoholic beverages” in class 32. Whereas previously such beverage alternatives weren’t considered a threat and/or the cost of enforcement couldn’t be justified because the commercial impact was not sufficient, no-alcohol beverages have become a potentially lucrative opportunity. IP plays an important role in protecting that investment in innovation, of course, whether through trade marks or trade secrets, patents, designs and so on.

Take Seedlip as an example. It registered its EU trade mark for “non-alcoholic beverages; water; flavoured waters” in class 32 in 2014. A trade mark owner with a registration for “gin” in class 33 may not have historically been concerned by this application (indeed, it passed without opposition), but Seedlip is marketed and consumed as a non-alcoholic spirit, which means it is now likely to be seen as a commercial competitor to a traditional gin brand.

In some instances, there are also potentially tricky brand positioning issues to consider around such product extensions. For example, some soft drink brands are now looking to tap into the market for “grown-up” alcohol alternatives, such as Coca-Cola’s collection of ready-to-drink mocktails, Bar None, launched in the US in 2019.

Interestingly, this may be a relatively difficult move to make, as the branding and marketing approach to these products lends itself much more to those in the alcohol industry. In general, consumers seem to want the alcohol branding experience without the alcohol content. There are exceptions to this, of course, as some consumers might not want to drink a product that is associated with an alcoholic version, whether for moral or religious reasons.

Brands therefore need to look at the message attached to their products and decide whether they should market and promote the different products using the same/similar branding (as with Heineken and Heineken 0.0) or whether they would be better off treating them as two distinct brands and product markets.

It may be some time before we return to pubs, bars and restaurants in the volume that we did before the COVID-19 crisis, but it seems unlikely that our thirst for healthy alternatives to alcohol is likely to be quenched any time soon. Whether or not they are planning to enter this growing market, brand owners in the beverages sector would be wise to rethink their approach to brand coexistence, registration and enforcement. ●



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ALL AVATARS INVITED

Our Autumn Conference is a no-Zoom zone. Instead, we're using the latest digital technology to ensure our event rises to the challenge



On 15th and 16th October, our Autumn Conference 2020 will transport delegates and speakers into a new virtual

world, where we'll aim to equip you with the tools you need for the challenges that lie ahead.

At this critical time for our profession, we are pleased to be able to bring you topical presentations from some of the UK's best speakers in the trade mark community.

We believe we've put together a programme that is relevant for all trade mark professionals and gives you the opportunity to engage with IP professionals from a range of different backgrounds.

You'll also find time to network in our new virtual setting.

IN-PERSON ATMOSPHERE

To create an in-person atmosphere in the digital realm, we've teamed up with an events agency that specialises in bringing the face-to-face experience to every delegate.

You will create your own virtual persona, who will "enter" the conference online. From choosing your hair colour to picking out shoes, you are welcome to get creative with your Autumn Conference attire.

Your virtual avatar will be able to navigate through the conference to

network with other delegates, visit exhibitors, listen to our speakers and join in by asking questions.

Simply click on another "person" to speak to them through your microphone or by using the chat box function. You can even invite other delegates to play Connect Four or chess with you for a little communal downtime.

PROGRAMME IN PROGRESS

As this issue goes to press, we are still confirming the last few pieces of our programme, but our virtual Autumn Conference is shaping up to give you an experience to remember, as well as the chance to earn six hours' CPD. Already confirmed are:

- Richard May, from Osborne Clarke, who will share his insights into what we can expect post-Brexit – from cloned marks to conflict between UK

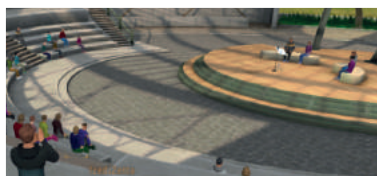
“ We're looking forward to connecting with more delegates than ever ”

and EU cases – and help you get ready for whatever lies ahead.

- Barrister Charlotte Blythe of Hogarth Chambers, who will reveal what she views as the most important UK cases of the past 12 months and share her key takeaways from each.
- Mike Tennant, Chartered Trade Mark Attorney and a Director at Tennant IP, who will break down the top EU cases from the past 12 months and consider what they mean for the profession.



Get ready to enter the virtual world of our Autumn Conference



- You will hear both sides of the Sky v SkyKick case in the course of a lively debate, and enjoy a panel discussion all about artificial intelligence and its impact on the profession with our technology experts.
- A UK IPO Examiner will be on hand to critique where things go wrong in oppositions and how to prepare evidence.

We're also pleased that the UK IPO's Tim Moss and IPReg Chair the Rt Hon Lord Smith of Finsbury will be in attendance as keynote speakers on day one and two, respectively.

Closing remarks on Friday will be provided by our President, Richard Goddard, and our First Vice-President, Rachel Wilkinson-Duffy.

BRANCHING OUT

Throughout the day, and after our day-one speakers are done, we have built in plenty of time for you to take full advantage of the avatar-to-avatar networking.

And feel free to navigate your avatar through our conference, engaging with speakers and getting involved in debates and panel discussions. You can even raise your virtual hand to ask questions during talks, or message the person next to you.

Thanks to the flexibility that a virtual conference provides, we're looking forward to connecting with more delegates than ever at our Autumn Conference. ● ●

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Exhibitor opportunity

Our Autumn Conference is the perfect venue at which to showcase services for the IP profession. For information on sponsorship and exhibition opportunities, please contact sarah@citma.org.uk



CERTIFICATION MARKS: A CRASH COURSE

Jasmine Sihre shares her tips for first-time filers

Certification Marks (CMs) tell you that a product meets a specific standard or possesses a particular set of characteristics. The standard or characteristics are established by a set of regulations filed shortly after the application. This is not a mark that is used to offer goods or services by the proprietor, since any authorised party can use a CM in connection with certifying its goods or services, providing that those goods or services meet the requirements set out in the regulations.

A CM (and a collective mark) may be accepted if it indicates a geographic origin. This is, of course, very different to the requirements for an ordinary trade mark. However, while the function of a CM is

to assure a standard, it should not mislead the consumer into believing that the mark is a badge of origin. An objection of this nature can often be overcome by adding the words “certification mark” to the mark, which is a type of accepted amendment.

TWO-STAGE APPLICATION

The CM application process involves two stages. The first stage includes filing Form TM3 to demonstrate the representation of the mark and the associated goods and services. These are then examined by the UK IPO on absolute and relative grounds. At the second stage, the applicant provides a set of regulations within three months

of the filing date. The regulations are filed with Form TM35 and a fee of £200, and then examined.

And it’s this second stage that can get complicated for a first-time filer.

FIVE IMPORTANT PIECES

The regulations must contain information governing the CM’s use. They may also include definitions and additional clauses regarding aspects such as termination, prohibition and control. Specifically, they should include the following five key points:

- **Who is authorised to use the mark.** The registration can be used by any party if it can show that the relevant characteristics are being certified. However, CMs can be limited to a specific group of users if the certification is in connection with a specialist service. Regulations can also specify who administers the CM and what powers they may have, and whether a certificate will be issued to the user to show that it is certified.



KFC’s chicken on the bone bears the Red Tractor mark

CMs: COMMON EXAMPLES



Woolmark
(wool purity)



CE mark (EU
safety standards)



Fairtrade
mark (ethical
practices)



Red Tractor
mark (farming
standards)

- **The characteristics certified by the mark.** While a list of the goods and services to be certified are included in the application form, this is not enough to demonstrate the characteristics of the product. For example, this can include a description of the product and specify that the products are offered in line with training materials or similar.

- **Testing and supervision.** For the CM application to reach full registration, you need to set out how the certifying body (ie, the proprietor of the mark), will test that the user of the mark is meeting the requirements of the regulations, particularly the characteristics of the product.

The regulation simply needs to outline who would carry out any testing either for or on behalf of the proprietor, as the proprietor does not need to do the testing itself.

Clauses in this section can include: the frequency of assessment; who will carry it out; and whether a certificate will be issued after a test is passed.

- **Fees, if any, to be paid.** Fees are not necessary, but it is common for the proprietor to charge a nominal fee to generate income. If a fee is set, it should be reasonable, to give the user a fair chance of accessing use of the mark in connection with its product. Information about fees should be listed in the regulations, even if no fees are to be charged.

- **Dispute resolution procedures.** An internal complaints procedure needs to be included in the

regulations to govern any dispute between the proprietor and the user. Disputes can arise if, for example, the prospective user is unhappy with the outcome of a decision by the proprietor to prohibit it from using the mark.

The disputes procedure should also include an appeals process. It is important that the appeal procedure is independent from the proprietor and the prospective user, to ensure a fair outcome.

Clauses in this section should include: the information needed to raise an internal complaint and/or file for an independent appeal (ie, what forms need to be completed and where to send them); timeframes for raising a complaint or appeal; and how many days the prospective user should expect to wait to receive a response.

Overall, then, a lot of detailed information is required. It can be very easy to fall into a trap – as I learned the hard way – of receiving multiple rounds of objections, during which the Examiner can end up requesting additional information to clarify the terms of the regulations. This can cause a lot of unnecessary delay, which can be avoided from the start by arming yourself with as much knowledge as possible before you begin.

A SIMPLE RECOMMENDATION

Based on my own experience, I recommend being proactive and following up with a telephone call to engage with the Examiner at an early stage when any questions are raised. This strategy means that any issues arising can be ironed out in the course of a conversation. In contrast, if you use written communications, it is easy to focus on the standard wording of the Examiner's objection and miss the nuances that might better direct



Main image: Fairtrade certification is one of the most familiar CMs, indicating fair pay and better working conditions

Above: Woolmark certification relates to the purity of the wool fibres used

you to what information the Examiner actually needs.

In fact, examiners often prefer this approach. It is also in their interest to ensure that you provide them with the information they really need but may not have explicitly asked for.

In summary, provide as much information as you can. Don't limit yourself to the information contained within the regulations, and if you can demonstrate the uses of the mark with photos or examples in annexures, this is often preferred. The more transparent you are with the examiner, the better your odds of speedy success. ●



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Merck becomes less murky

Patrick Cantrill sees new clarity around a complicated coexistence

This judgment concerns a protracted dispute between two substantial pharmaceutical companies over the usage of the sign MERCK. The Claimant, Merck KGaA (Merck Global), is based in Germany, while the First and Second Defendants (collectively, Merck US) are based in the US.

With origins in Darmstadt dating back to 1668, Merck Global started trading in the US in 1889. However, following the threat of sequestration in World War I, the US operation became independent. From the outset, there was conflict with respect to these separate international activities relating to their respective uses of MERCK. So, in 1955, the parties entered into a coexistence arrangement which was reaffirmed and amended in 1970 (the Agreement). It was agreed that Merck US would not use MERCK as a trade mark or use MERCK as a contraction of its corporate or trading name when promoting its business activities outside of the US. However, it was permitted to use MERCK SHARP & DOHME (MSD), as that trade mark or name would not be regarded as confusingly similar to the trade marks or names of Merck Global.

With the advent of the internet, conflict became more frequent, leading Merck Global to issue proceedings in the UK in 2013 alleging that Merck US had: (i) infringed various of its UK trade marks; and (ii) had breached the Agreement (which at a preliminary hearing, was held to be governed by German law¹). The parties accepted that Merck US had never supplied products or services in the UK under or by reference to the sign MERCK. Instead, the complaint concerned Merck US's use of the sign on MERCK-branded websites, on social media posts, at conferences and

advisory board meetings, in press releases, in agency briefs and in emails.

In 2016, the High Court ruled that the Agreement precluded Merck US from using the word MERCK on its own as a firm or company name in the UK and that the Merck websites and social media activities of which complaint had been made were targeted at users in the UK. This decision was broadly confirmed by the Court of Appeal², but the Court did remit the case back to the judge for him to carry out a granular assessment of whether the acts about which Merck Global had complained did constitute infringement. Consideration had to be given to whether those acts amounted to use in the course of trade “such as to create the impression that there is a material link in the course of trade between the goods or services concerned and the undertaking from which those goods or services originate”.

REASSESSING INFRINGEMENT

For the hearing, each party submitted 16 instances. The judge found that in most (but not all) of the 32 instances, even if Merck US had not intended to sell products or services in the UK by reference to the sign, the prominent use of MERCK (especially where it was used alone) was likely to cause the reasonably observant and circumspect reader to view the use as designating the origin of the goods and services. This type of instance would affect the function of the MERCK sign in the UK, which is to identify Merck Global – not Merck US – as the originator.

For example, the judge ruled that a page on merck.com featuring a message from the CEO under the strapline “MERCK Be Well” about how “At Merck, corporate responsibility is at the heart of the company’s mission” and which explained that Merck US is a developer and provider of drugs for the treatment of cancer, went further than just identifying the corporate entity. It would, he said, instead be regarded by the reasonable reader as

“ The judge ruled that a page on merck.com went further than just identifying the corporate entity



indicating that Merck US is an originator of drugs under the MERCK sign.

Conversely, the judge ruled that a confidential presentation to a group of professionals on a UK-based advisory board looking into Hepatitis C, for which the slides bore MERCK and the logo of Merck US, did not constitute infringement. Such usage simply conveyed technical information to a select audience.

On two other points remitted back by the Court of Appeal, the judge ruled that: (i) the various acts of which complaint was made were not *de minimis*; and (ii) some of the specifications of the registered trade marks needed to be narrowed for reasons of non-use, although this partial revocation did not affect his conclusions on infringement.

RELIEF

The judge disagreed with Merck US's assertion that, as his analysis on infringement was so detailed, a declaration that it had infringed the trade marks and breached the Agreement was unnecessary. Moreover, although Merck US had removed from its website the content of which complaint had been made and was putting other measures in place, the judge disagreed that a prohibitive injunction would be disproportionate, not least because he was conscious that by now there was little spirit of compromise between the parties.

However, he did not require Merck US to publicise the judgment, and he did grant various carve-outs from the injunctions, including but not limited to: (i) where there is a link between a MERCK-branded website and a MSD-branded website if that link generates a pop-up informing the user that it is leaving the MSD website and going onto a site only intended for US residents; (ii) if the MERCK-branded site or social media platforms contain compliant geo-blocking functions; and (iii) use of MERCK in metadata.

On 29th July 2020³, the judge confirmed the wording of the court order and granted Merck Global an interim cost award of £2,370,500, having applied a small discount for the limited success that Merck US had had with regard to partial cancellation of the registered trade marks.

1 [2014] EWHC 3867
2 [2017] EWCA Civ 1834
3 [2020] EWHC 2120

KEY POINTS

- + Coexistence agreements, even those drawn up long before the advent of the internet, can remain relevant and enforceable
- + Following a finding of infringement, declarations and prohibitive injunctions are likely to be granted
- + When assessing infringement, the courts should carry out a detailed and granular analysis of all of the acts of which complaint is made



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Game on!

It will be interesting to see how an unusual argument plays out, says Charlotte Wilding

Manchester United Football Club Ltd (MUFC) has brought an infringement and passing off action against Sega Publishing Europe Ltd (Sega) and Sports Interactive Ltd (SI) regarding their “extensive” use of the sign MANCHESTER UNITED within the *Football Manager* video game.

MUFC bases its claims on its EU trade mark registrations: No. 1333640 for MANCHESTER UNITED in class 9, filed on 6th October 1999 and registered on 12th February 2002, and No. 761312 in class 9, filed on 25th February 1998 and registered on 27th October 1999 (shown opposite).

MUFC alleges that:

1. The specified trade marks have an enhanced distinctive character, extensive reputation and very substantial goodwill in the UK as a result of the use that has been made of them by or with the consent of MUFC;
2. The trade marks are the subject of extensive licensing activity, including such activity in the field of computer games;
3. MUFC exploits the commercial potential of the trade marks to a significant extent both in the UK and globally in relation to a very wide array of other products and services; and
4. MUFC is the owner of a valuable goodwill in the business of licensing the marks in respect of video games and other goods/services.

THE WORD MARK

With regard to the plain word mark, MUFC alleges that the sign MANCHESTER UNITED is used in the *Football Manager* game without licence or consent. Accordingly, MUFC seeks to rely on Articles 9(2)(a) and 9(2)(c) EUTMR. In addition, MUFC alleges that this use is actionable as passing off.

In particular, MUFC argues that this unauthorised use is liable to affect the origin function of its trade mark, as well as the other functions, if a significant proportion of consumers are led to believe that *Football Manager* is licensed or endorsed by MUFC. It is further alleged that the investment function and the advertisement function of the trade mark are impaired by the unauthorised use of the sign MANCHESTER UNITED.

THE OFFICIAL CREST

In addition to the alleged infringement and passing off of its name, MUFC also claims that

“ MUFC claims that its official crest was infringed because it was not used

its official crest was infringed because it was not used (an interesting take on infringement).

In place of the official crest, Sega and SI used a simple red and white striped logo. MUFC argued that this “deprives the registered proprietor of its right to have the club crest licensed” and alleged that the “origin function may be impaired if a significant proportion of consumers are led to believe, contrary to the facts, that *Football Manager* is licensed or endorsed [by MUFC]”. MUFC also claimed that the essential, investment and advertising functions of the trade mark are impaired by the unauthorised use.

THE SEGA AND SI RESPONSE

Sega and SI denied the allegations, claiming that the use of MANCHESTER UNITED is legitimate as it refers to the football team in the context of the game. Also, MANCHESTER UNITED had been used “without complaint” in the game and its predecessor, *Championship Manager*, since 1992.

In fact, Sega and SI’s grounds claim that “copies of the game have also been sent by SI to a number of officials and players at [MUFC] for a number of years, and there have been a number of positive press comments and tweets about the game by them”. Therefore, Sega and SI also claimed that MUFC had acquiesced in its right to take action in any case.

PERMISSION TO AMEND PARTICULARS

MUFC sought to amend the original particulars of its claim by adding a new claim alleging accessory liability under Article 10 EUTMR (which refers to Article 9) regarding use of the mark in “patches”.

Patches are defined as “downloadable files provided by third parties via their websites... allowing gamers to associate certain graphics with the teams in the game. Such graphics include... a replica of... the figurative mark depicting the Manchester United club crest”.

While MUFC did not seek to join any third-party patch provider to the action, it claimed that Sega and SI were jointly liable. In particular, MUFC alleged that Sega and SI were aware of the practice of patch provision by third parties and, in fact, allowed them so that they did not need to obtain a licence to use signs or graphics.

Article 10 gives a proprietor of a trade mark a right to prohibit two acts: (a) affixing a sign to packaging, labels, tags, security or authenticity features or devices or any other means; and (b) offering or placing on the market, or stocking for those purposes, or importing or exporting,

packaging, labels, tags, security or authenticity features or devices or any other means.

Mr Justice Morgan focused on the phrase “any other means” and whether patches fell into this category. MUFC argued that they did, but Sega and SI disagreed. In particular, Sega and SI argued that Article 10 was designed to deal with counterfeiting, which was not relevant to this case.

Morgan J noted that the draft amendment did not identify a relevant risk, which must be shown to exist before Article 10 applies. Instead, MUFC simply asserted that the provision of modified software by third parties amounted to an act prohibited by Article 10. Morgan J was not impressed by the lack of explanation and even commented that “it could be said that the draft pleading is defective” due to the omission. However, he took the view (generous, in his words) that the draft pleading argued that the relevant risk is what actually happened (ie, gamers using patches in *Football Manager*).

Another key issue to be decided was whether use of patches by gamers was use in the course of trade. MUFC argued that some gamers do so to generate revenue from advertising, for example, which is an activity that would meet that test. MUFC also argued that a gamer may be considered an “instrument” by Sega and SI, who were acting in the course of trade.

DECISION

Ultimately, Morgan J held that the use of patches is not use in the course of trade by gamers and therefore the new claim would likely fail. Further, he was of the view that it did not add to the original claim. Accordingly, he denied permission to amend the original claims.

He also confirmed that if MUFC wished to elaborate on this claim to demonstrate why it would succeed (which it had failed to do so adequately) then it would need to do so in the usual way – by issuing an application notice.

Keep an eye out for a decision in respect of this matter. In particular, it will be interesting to see how MUFC’s argument that the official crest has been infringed because it was not used plays out.

KEY POINTS

- ✦ Ensure that all arguments are pleaded in the first instance if possible
- ✦ Even if an argument appears obvious, ensure it is adequately explained to avoid any confusion

MARK

EUTM NO. 761312



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A not-so-super effort

Internet-based evidence was one of the weaknesses here, reports Sophie Soeting

The UK IPO has partially upheld consolidated opposition proceedings against applications for a series of two SUPER HERO figurative marks (shown right) and the word mark SUPER HERO ENERGY (together, the Opposed Marks) filed by IN60 Media Ltd (the Applicant). Protection was sought for the opposed marks in classes 5, 29, 30 and 32.

The Opponent, Bare Biology Ltd, relied upon its figurative mark OMEGA 3 FISH OIL SUPER HERO (the Earlier Mark), registered in classes 5, 29 and 30. Its opposition was made on the basis of s5(2)(b) and s5(3) of the Trade Marks Act 1994.

EVIDENCE

Ultimately, the Opponent did not succeed in providing the required evidence to support its case. Among the evidentiary deficiencies were that the majority of the evidence post-dated the relevant date or was undated and included links to webpages. In previous UK IPO decisions, the use of web links has been considered unacceptable on the grounds that internet content can be changed. The Hearing Officer (HO) considered that the Registry could treat such evidence as unacceptable but that this should be brought to the relevant party's attention during the evidence rounds (which had not happened here). The opposition on the basis of reputation also failed, due to the Opponent's lack of evidence to support its claim.

LIKELIHOOD OF CONFUSION

Despite the device and the presentational difference between the marks, it was concluded that the Opposed Marks and the Earlier Mark were visually similar to a medium degree. Aurally, the figurative mark was considered identical, whereas the word mark was deemed similar to a higher than medium degree. The words OMEGA 3 FISH OIL, included in the earlier figurative mark, would not be pronounced because of their much smaller size and fainter colour. Conceptually, the figurative mark was considered to be highly similar given the reference to a superhero character, whereas the word mark was considered similar to a higher than medium degree, given the additional word ENERGY.

A part of the goods in classes 5 and 30 were similar to a medium degree, whereas other parts of classes 5 and 30 were found to be dissimilar or similar to only a low degree. The goods in classes 29 and 32 were dissimilar. As a result, the opposition was partially upheld under s5(2)(b) in parts of classes 5 and 30 only.

The HO concluded that there was a likelihood of direct confusion in circumstances where only the words SUPER HERO were pronounced. However, when encountered visually, there was also a likelihood of indirect confusion for those goods similar to at least a medium degree, as the average consumer could be led to conclude that the marks were being used by the same or economically linked undertakings.

Finally, the HO noted that the wording "parts and accessories for all the aforesaid goods" in classes 5, 29, 30 and 32 in the Opposed Marks was unclear, citing an interpretation set out by Lord Justice Arnold in *SkyKick*¹ to the effect that "a term which cannot be interpreted is to be disregarded".

¹ [2020] EWHC 990 (Ch), *Sky Plc & Others v SkyKick UK Ltd & Another*

KEY POINTS

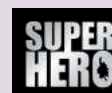
- ✦ Evidence needs to be relevant and clear. Arguments cannot be inferred without the required facts and evidence to support them
- ✦ Links to internet evidence should not be provided as they are inherently unreliable
- ✦ It is difficult to argue reputation if there is very little evidence to support this basis

MARKS

THE OPPONENT'S EARLIER MARK



THE APPLICANT'S FIGURATIVE SERIES MARKS



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Bad robot

Hilary Atherton outlines why Robot's appeal arguments fell away

This was an appeal to the Appointed Person (AP) by Robot Energy Ltd regarding a decision of the Hearing Officer (HO) concerning the topical issue of bad faith. The HO had upheld Monster Energy Company's opposition to Robot's application for HYBRID in its entirety under s3(6) of the Trade Marks Act 1994 on the ground that the mark was applied for in bad faith.

EARLIER OPPOSITION

In January 2018, Robot applied to register the HYBRID mark (shown right) in class 32 for a wide range of soft and non-alcoholic drinks, including energy drinks. Monster had prior trade marks for ENERGY HYBRID in the US, but its UK trade mark applications, including HYBRID, post-dated Robot's applications. Monster opposed the application, among other things, on the basis of bad faith.

The HO found that Robot was systematically filing applications that imitated Monster's marks and that the real purpose of Robot's application was to block or otherwise disrupt Monster's business in the UK. Therefore, the HO found that the application had been made in bad faith and would therefore be refused in its entirety. Robot appealed to the AP.

ROBOT'S APPEAL

At first instance, Monster filed evidence of Robot's systematic applications to register trade marks and trade names already registered and/or used by Monster. This included evidence that all of Robot's applications for HYBRID marks post-dated Monster's US trade mark application for ENERGY HYBRID. In response, Robot filed a witness statement from its Intellectual Property Director. That statement did not address the allegation of systematic applications, save for a denial that Robot had known about Monster's US trade mark application for ENERGY HYBRID when it began filing HYBRID marks in the EU. Monster filed further evidence in reply to support its allegation, including specific references to the details of its US application.

On appeal, Robot argued that it had not been open to the HO to disbelieve its evidence

that it had not known about Monster's US trade mark application for ENERGY HYBRID when it began filing HYBRID marks in the EU. Robot claimed that its evidence had not been formally challenged by Monster. However, the AP disagreed. She found that Monster had maintained at all times that Robot had been engaged in a systematic campaign to apply for registration in the EU of trade marks which imitated to varying degrees the trade marks and trade names registered and/or used by Monster. That included allegations that the filing dates of all Robot's HYBRID marks in the UK post-dated Monster's US application to register ENERGY HYBRID.

Having found that he was not bound to accept Robot's evidence, the HO went on to consider the question of Robot's state of knowledge, looking at the evidence as a whole. In the AP's view, it was open to the HO to find on the evidence filed by Monster that Robot had intentionally imitated its ENERGY HYBRID word mark in the US and elements of Monster's get-up when filing the contested mark.

As a result, Robot's remaining grounds of appeal fell away, and the appeal was ultimately dismissed.

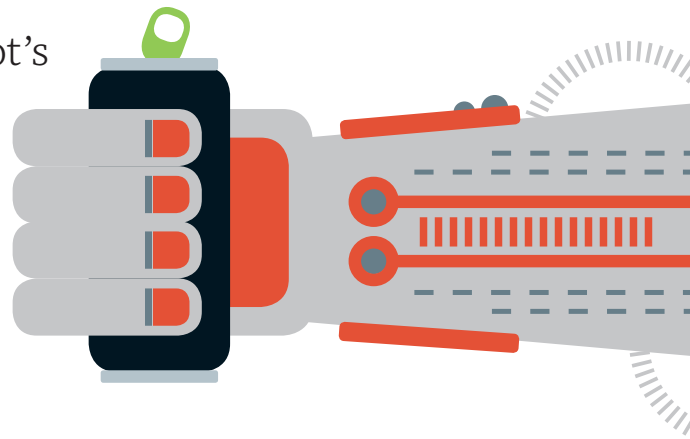
Bird & Bird acted for Monster Energy Company in this matter.

KEY POINT

✦ In proceedings based on s3(6) of the Trade Marks Act 1994, the key question for determination is whether it has been established that the contested application was filed in pursuit of an objective for the purposes of which it could not be properly filed

MARK

THE CONTESTED MARK



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Geek pique

The Court saw similarities sufficient for potential passing off, reports Peter Collie

Yellow Bulldog Ltd (the Applicant) filed two applications for the device mark shown below and incorporating the words GEEK STORE. The applications covered retail services in connection with a range of goods that included video games and equipment, various items of clothing, and low-value gift items (class 35).

AP & Co. Ltd (the Opponent) opposed the applications. The strongest basis was a claim of passing off. The Opponent claimed it had been using the unregistered mark GEEKCORE throughout the UK since 2014 in relation to retail services for a broad range of goods.

OPPONENT'S GOODWILL

The Hearing Officer (HO) examined the evidence of the Opponent's goodwill. The evidence was not without deficiencies. For example, the HO highlighted the lack of detail contained in the invoices provided as evidence, which did not specify the goods that had been traded.

However, the evidence contained a considerable volume of prints obtained from the Wayback Machine website archiving service. The prints demonstrated use of the mark for retail services in connection with a range of goods between the years 2014 and 2018. In addition, data from Google Analytics showed a substantial stream of traffic to the Opponent's website.

Ultimately, the HO was satisfied that the Opponent enjoyed goodwill in the GEEKCORE mark in relation to online retail services for clothing, bags, toys, figurines and novelty mugs.

MISREPRESENTATION AND DAMAGE

The HO then assessed the similarity between the marks. The common presence of the word GEEK was noted. However, there were differences in terms of the words CORE and STORE and in relation to the device element. Overall, the marks were visually dissimilar

but shared a medium and high degree of conceptual and aural similarity respectively.

In terms of the relevant field of activity, both parties offered retail services. A number of the Applicant's retail services (bearing in

mind the specific goods to which they relate) were identical to those in which the Opponent held goodwill.

Even for retail services for goods not sold by the Opponent, the HO emphasised that the nature of the Opponent's retail business is to offer a selection of goods from a diverse range of categories. Therefore, it would not take a "stretch of the imagination" for the Opponent to provide retail services in relation to the remaining goods covered in the application.

In light of the similarity between the marks, the Opponent's goodwill and the apparent overlap between the services, the HO concluded that a misrepresentation would arise which would likely result in the Opponent losing sales. The passing off claim, and therefore the opposition, succeeded.

“
The strongest basis
for opposition was a
claim of passing off

KEY POINTS

- ✦ Retail services in connection with a limited and identifiable selection of goods may lead to a comparatively broad scope of protection
- ✦ Extracts from web archiving services can be helpful evidence of use
- ✦ Invoices should indicate the types of goods that have been traded in order to be of value

MARKS

YELLOW BULLDOG
LTD'S MARK



AP & CO. LTD'S
UNREGISTERED
WORD MARK

GEEKCORE



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That sinking feeling

Richard May reviews what halted the progress of Titanic Gin



In August 2018, Belfast Gin Distillery Ltd (BGD), registered TITANIC GIN in the UK for “spirits and liquors” in class 33 and “spirits distillery services” in class 40 (the Registration).

Danny Boy Label LLP (DBL) applied for a declaration of invalidity in respect of the Registration on the basis that it was registered contrary to s5(2)(b) and s5(4)(a) of the Trade Marks Act 1994. DBL based the invalidity action on its earlier EU trade mark registration for TITANIC (the Earlier Mark) and its use of the sign TITANIC in the UK since 2008 (the Earlier Sign).

GOODWILL

DBL filed what the Hearing Officer (HO) described as “scant evidence”, which largely consisted of 17 invoices showing sales of Titanic whiskey between 2014 and 2017. The related revenue was around £15,000 for 111 cases and 105 bottles, and the sales were made predominantly in the Belfast area.

Despite the paucity of evidence, the HO decided that it was clear that until 2011 the Earlier Sign was being used, albeit on a relatively small scale, on whiskey. When the distillery supplying the whiskey was stopped in the same year, DBL carried on selling its surplus stock and sought a new supplier.

ABANDONED OR RESIDUAL?

The HO considered whether the goodwill had been abandoned or retained post-2011. DBL was attempting to maintain and expand its business by resuming the supply of whiskey, and it sought new artwork for its bottle labels. The HO decided that this indicated it had not abandoned its business.

There was also sufficient evidence to show that DBL had retained its goodwill, despite trading having all but ceased prior to the filing of the Registration. DBL had used the TITANIC mark on whiskey for at least nine years (2008-2017), and even though sales in the last few years were very small and

confined to Belfast, the HO did not think the goodwill would have evaporated in the 16 months between February 2017 (the last invoice date) and June 2018 (the application date).

PASSING OFF

Having acknowledged goodwill, the HO concluded that a substantial number of customers of DBL would be deceived in relation to “spirits and liquors” in class 33, given their obvious similarity with whiskey. The HO came to the same conclusion about “spirits distillery services” in class 40 because there is a “clear connection between a distillery and a spirit”. The passing off ground therefore succeeded.

USE OF A TRADE MARK

DBL failed to succeed, however, under s5(2)(b) through lack of trade mark use. The Earlier Mark, being an EU trade mark, was subject to proof of use in the EU. While use in one Member State can be sufficient to maintain a trade mark, in this instance sales of less than £15,000 over a three-year period were insufficient to prove genuine use in the EU in the context of the whiskey market.

This case highlights the scope of protection afforded to businesses in the UK that genuinely try to continue trading even when sales cease. This case also reminds us that small, localised UK sales might not be enough to enforce old EU trade marks in the UK.

KEY POINTS

- ✦ In a passing off case, demonstrating small and localised goodwill can be enough to succeed
- ✦ UK trade mark law recognises that goodwill doesn't evaporate because trading stops. Goodwill is retained for some period to allow, for example, the business to recommence or to be sold. Any retained goodwill can be enforceable
- ✦ Small, localised trade mark use is unlikely to be enough to maintain EU trade marks, particularly in large product markets



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No case for brand evolution

A mere coincidence of alternating letters was insufficient to find confusion, writes Désirée Fields

In August 2019, Boston Healthcare Ltd (the Applicant) applied to register EMOLITE as a UK trade mark for “emollients for medical purposes; skin care lotions for medical purposes and topical preparations for the treatment of dry skin conditions” in class 5. Novartis AG (the Opponent) opposed the application under s5(2)(b) of the Trade Marks Act 1994, relying on an earlier international registration designating the UK for the mark EDOMIDGE, which covered “pharmaceutical preparations” in class 5.

Finding that “pharmaceutical preparations” referred to drugs used to treat numerous ailments which were available in various formats, the Hearing Officer (HO) found that the Applicant’s goods were encompassed by the Opponent’s goods and identical or at least highly similar given the overlap in users, trade channels, physical nature and opportunity for competitiveness.

SIMILARITY IN SUMMARY

The HO noted that the average consumer included both healthcare professionals and the general public, who would likely pay an above-medium to high degree of attention to the selection of goods. The HO assessed the visual similarity as fairly high, noting that both marks consisted of seven letters, where the first, third, fifth and seventh letters were identical (E, O, I and E) with a further coincidence that the letter M was the fourth letter in the Opponent’s mark and the second letter in the Applicant’s. Aurally, the marks each consisted of three syllables that could be articulated in a number of ways. Due to the identity of the second syllable and the potential for some phonetic similarity in the first and third syllables, the marks’ aural similarity likely ranged from medium to fairly high.

The HO found that neither mark had a conceptual meaning, rejecting the Opponent’s argument that EMOLITE would be understood as a “light emollient”. The HO accepted that LITE in the Applicant’s mark could be considered a phonetic equivalent to LIGHT (indicating a simplified version of an existing product), finding that this introduced some conceptual clarity to the Applicant’s mark. As such, the respective marks were conceptually dissimilar. Where consumers did not identify LITE as a tangible or separate element within the Applicant’s mark, both marks overall would

be considered invented words and conceptually neutral. The HO also found that the Opponent’s mark had a fairly high degree of inherent distinctiveness due to its originality.

“
Both marks overall would be considered invented words”

EVOLUTIONARY EXTENSION

Despite the marks’ visual and aural similarity, the HO held that the differences in the Applicant’s mark were not consistent with an evolutionary brand extension as there was no common element in both marks. Instead, this was simply a coincidence in alternating letters. The HO therefore considered it unlikely that consumers would conclude that the marks originated from the same undertaking. The HO also noted that the level of attention applied during selection would likely be elevated, even if only mildly. As such, consumers would not be directly confused. The opposition was accordingly rejected.



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KEY POINTS

- +
- The average consumer in respect of pharmaceuticals includes both average consumers and healthcare professionals
- +
- Consumers of pharmaceutical products are likely to pay at least an above-medium degree of attention to the selection of goods
- +
- A simple coincidence in a number of letters is insufficient to find confusion. A common element is required to suggest an evolutionary brand extension

No love for XOXO application

Elisabetta Ferraro explains why “Hugs and Kisses” is not a distinctive mark

The General Court (GC) has dismissed an action brought by Global Brand Holdings LLC and upheld the partial refusal of the word mark XOXO, which was primarily made famous by the American TV series *Gossip Girl*.

Despite being registered as a trade mark worldwide, at the EU level the Application was rejected for all the goods in classes 3, 9, 14, 18, 25 (but not for the services in class 35) for lack of distinctive character pursuant to Article 7(1)(b) EUTMR.

DISTINCTIVE CHARACTER?

The GC confirmed that a sign with laudatory connotations can be registered as a trade mark when, away from its promotional meaning, it allows consumers to perceive the commercial origin of the branded goods and services. This is not the case for the expression XOXO, which, used in connection with goods typically offered as gifts, will be understood by the English-speaking public as a promotional message conveying feelings of love and affection rather than as a trade mark. The fact that the sign is meaningless for a large part of European consumers is irrelevant, given that the prohibition under Article 7(1)(b) EUTMR operates even when the grounds for refusal exist for a non-negligible part of the target public.

OTHER CONSIDERATIONS

The fact that the Applicant had already registered identical national trade marks, including EU trade marks, for identical or similar goods and services was deemed irrelevant. The EUIPO is not bound by previous decisions adopted by the same Office or by decisions adopted in each Member State since the EU trade mark regime is an autonomous legal system independent from any national systems.

Therefore, each examination is based on a case-by-case assessment.

The Applicant did not plead acquired distinctiveness under Article 7(3) EUTMR. Therefore, the EUIPO had no obligation to further investigate that point, and neither had the GC, which can only review the legality of appealed decisions in the light of the legal claim relied on by the appellant.

ANALYSIS

This decision will make it more difficult to register as trade marks those signs conveying emotions (either positive or negative) in relation

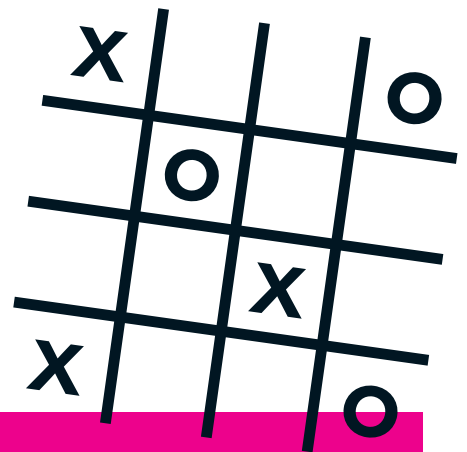
to goods commonly used as gifts. Should they pass the examination screening, they would remain open to invalidity actions. On the one hand, given the perpetual monopoly offered by a trade mark registration, it is in the public interest to refuse the registration of this kind of sign, which should arguably remain available for others to use in commerce. On the other hand, applicants may need to prove acquired distinctiveness in each Member State in order to register “feeling conveyor marks”, as is the case with shape marks. XOXO...

KEY POINTS

✦ Signs with laudatory connotations can be registered as a trade mark if perceived both as a promotional formula and as an indication of the commercial origin

✦ It is irrelevant that a sign is meaningless for many consumers when confusion exists for a non-negligible part of the target public

“*It is in the public interest to refuse this kind of sign*”



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Appeal process proves its appeal

A second attempt can bring success, says Cameron Malone-Brown

On 11th June 2020, the CJEU overruled a General Court (GC) decision concerning a dispute that began in June 2017. Ruling in favour of China Construction Bank Corp. (CCB), the Court held that the reputation or distinctive character of an earlier mark cannot make that mark more or less similar to another mark for the purposes of likelihood of confusion.

CASE HISTORY

In June 2017, CCB filed an EU trade mark application for the Contested Mark (shown right) for various banking and financial services in class 36. Groupement des Cartes Bancaires (GCB) opposed the application based on an Earlier Mark covering a range of financial services in class 36. The opposition was based on Article 8(1)(b) and 8(5) of Regulation No. 207/2009 (now replaced by Regulation No. 2017/1001).

The EUIPO Opposition Division (OD) found in favour of the Opponent based on Article 8(1)(b) alone. In particular, the EUIPO noted that a reputation in France had been found for the Opponent in parallel proceedings (case R 944/2013-4, featuring the same parties). In this previous case, the EUIPO had held that French consumers habitually identified the Opponent as “CB”, and the EUIPO conducted the comparison of the marks on this basis.

CCB appealed to the First Board of Appeal of EUIPO and then to the GC, being unsuccessful at each stage. The present case challenges the GC’s decision to uphold the previous decision.

PRESENT GROUNDS

The present appeal was based on several grounds. The key ground was that the

distinctive character of the Earlier Mark had been considered in assessing the dominant element of the mark in order to then determine the similarity of the marks being compared, rather than being properly considered at the point of deciding the likelihood of confusion. The CJEU accepted this point, allowing the appeal, and agreed that the correct stage to consider enhanced distinctive character was in relation to

the likelihood of confusion, not the similarity of the marks. On this point, the decision concludes that “it is therefore incorrect in law to assess the similarity of the signs at issue in the light of the reputation of the earlier mark”.

The CJEU also held that the GC’s reasoning supporting the Earlier Mark’s reputation (and therefore enhanced distinctive character) was flawed. The reputation had been evidenced for card-based transactions and ought not to have automatically extended to wider financial services.

The decision serves as a reminder, first, that while the enhanced distinctive character of an earlier mark may increase the likelihood of confusion, it does not render marks more similar. Second, a negative decision at first instance need not be the end of a trade mark application. Rather, the appeal process can be highly fruitful if budget allows it.

“
The enhanced distinctive character of an earlier mark does not render marks more similar

KEY POINTS

- ✦ The reputation or enhanced distinctive character of an earlier mark is relevant to the likelihood of confusion, but not to the similarity of the relevant marks
- ✦ The dominant and distinctive elements of a trade mark are not necessarily dictated by the manner in which the mark is known by its consumers
- ✦ Where consumers habitually refer to a brand in a form that differs from its registered protection, it remains the form that is registered that is compared with a contested mark under Article 8(1)(b) EUTMR

MARKS

CONTESTED MARK



EARLIER MARK



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Absolut grounds for refusal

Gavin Stenton reveals why a cashmere mark was found to be non-distinctive

The EUIPO's Board of Appeal (BoA) has dismissed an appeal by MCC (the Applicant) for registration of the word mark ABSOLUT CASHMERE (the Mark) for goods in class 3 (laundry; soaps) and class 25 (eg, clothing) (the Contested Goods), on the grounds that the Mark is devoid of distinctive character for English-speaking members of the public in the EU, under Article 7(1)(b) and Article 7(2) EUTMR.

The Applicant appealed against the Examiner's initial refusal to register the Mark on the following key grounds:

- It disputed the meaning of the Mark, arguing that even if ABSOLUT is conflated with the word "absolute" in the mind of the English-speaking public, the phrase remains an uncommon expression with an unusual grammatical structure;
- "Absolu" and "absolute" have multiple different meanings in both French and English, and none has an obvious connection to the Contested Goods;
- There are other trade marks registered with the EUIPO containing the word "absolut", including ABSOLUT VODKA, which increases the likelihood of the public finding "absolut" distinctive;
- The Mark has already been accepted for registration as a French national trade mark; and
- The Mark has acquired distinctiveness under Article 7(3) EUTMR through its use on the market since 2003.

The BoA rejected each of the arguments made by the Applicant.

LIMIT APPROPRIATE

First, the BoA held that because the Mark contains two English terms, it is appropriate to limit the analysis to the English-speaking public of the EU, and under Article 7(2), a mark can be refused for lacking distinctiveness in any part of the EU. It also said the removal of the letter E from "Absolut" does not affect the conceptual association with the word "absolute" and will therefore only be interpreted as a "laudatory expression" rather than distinguishing the commercial origin of the Contested Goods.

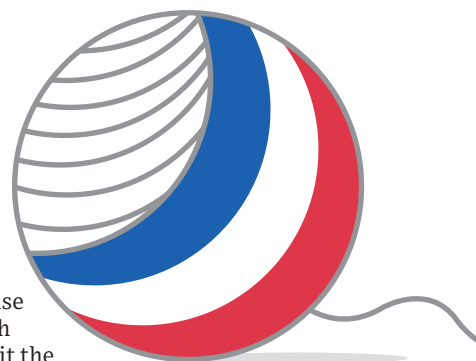
The BoA also held that there is a connection between the Contested Goods and the meaning of the Mark. For class 25 goods, the Mark implies that they are made completely from cashmere, and for class 3 goods, that they are fully suited to the laundering of cashmere.

In relation to other registrations containing "absolut" or "absolute", the EUIPO is not bound by previous decisions, particularly those of an Examiner or a national office.

Finally, acquired distinctiveness was not invoked before the Examiner and therefore cannot be invoked for the first time before the BoA.

For these reasons, the Applicant was wholly unsuccessful in its appeal, with the absolute grounds for refusal being maintained.

The language of the proceedings was French.



KEY POINTS

- The case highlights the importance of linguistic considerations in proving distinctiveness and the EUIPO's ability to narrow the assessment of distinctiveness to just one language of EU Member States
- The misspelling of "absolute" was not sufficient to lend the Mark a distinctive character. For an English-speaker, it indicates the quality of the goods rather than their commercial origin

MARK

ABSOLUT CASHMERE



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Seeing scents

Francesco Simone believes an absurd conclusion was averted on appeal

On 3rd August 2017, Trademarks Solution (the Applicant) applied to register the figurative mark below as an EU trade mark. The application initially covered cleaning products in class 3 and wholesale and retail services in relation to cosmetics and cleaning products in class 35. The Procter & Gamble Company (the Opponent) filed an opposition on the grounds of Article 8(1)(b) EUTMR, based on EU trade marks No. 003530094 for the word mark FEBREZE and No. 010392298 for the figurative mark shown below. The Opponent's registrations cover cleaning, air freshening and scenting products in various classes, and they were both subject to proof of use.

PARTIAL VICTORY

The Opposition Division (OD) held that the Opponent's evidence proved genuine use only in relation to preparations for washing, cleaning and perfuming in class 3 and air freshening products in class 5. While the OD found the trade marks to be similar, it held that there was no likelihood of confusion in relation to some of the goods and services in classes 3 and 35 and it therefore partially upheld the opposition. In particular, the OD considered the Opponent's "household cleaning preparations" similar only to a low degree to the Applicant's "wholesaling and retailing of cleaning preparations". The Opponent partially appealed the decision in relation to these services.

LIKELIHOOD OF CONFUSION

The Board of Appeal (BoA) agreed with the OD that the marks are visually similar to an

average degree and aurally highly similar.

However, the BoA also determined that there is a conceptual similarity as both signs allude to a "breeze" for the English-speaking public.

Turning to the key point of the appeal, the BoA compared the wholesaling and retailing services claimed in the application with the goods for "household cleaning preparations" claimed in the Opponent's earlier registrations. The BoA stated that, in general, while goods and services are different in nature, they can be similar because they can be complementary or serve the same purpose (and thus be competitive). It then pointed to consistent case law finding that there is a similarity to an average degree between goods and the retail services that relate to the same or highly similar goods, mainly on account of their complementary character. On this basis, the BoA determined that the Applicant's services subject to the appeal and the Opponent's goods were similar to an average degree.

In light of the similarity between the marks and between the goods and services concerned, the BoA found that there is a likelihood of confusion and upheld the appeal. The opposed application was therefore also rejected for "wholesaling and retailing of cleaning preparations", partially overturning the OD's decision.

COMPLEMENTARITY MATTERS

This decision brings clarity to the issue of comparing goods with services, correctly analysing all the relevant factors, including the nature of goods and services and their complementarity and purpose. Giving too much weight to the fact that goods and services have a different nature, as the OD did, leads to the absurd conclusion that goods and services could never be similar, even when the services are directly related to the goods.

KEY POINTS

It is well established in case law that there is a similarity to an average degree between goods and the retail services which relate to the same or highly similar goods, mainly on account of their complementary character

The difference in nature between goods and services does not mean they cannot be similar, as they can be complementary and serve the same purpose

MARK

THE APPLICANT'S MARK



THE OPPONENT'S FIGURATIVE MARK



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Goodbye HelloFruity



Nick Bowie explains why not all elements are created equal

This decision concerns an appeal filed by Importaco SA (the Applicant) in connection with Opposition Proceedings No. B3067365, in which the EUIPO held that the Applicant's EU trade mark application No. 17910200 for the HELLO FRUITY logo (the Applicant's Sign, shown right) should be refused based on a likelihood of confusion with earlier EU Registration No. 13716311 for HELLOFRESH, held by HelloFresh SE (the Opponent).

The Applicant sought to overturn the decision of the Opposition Division (OD) in its entirety. It argued that the OD had erred in finding that the HELLO element present in the conflicting trade marks formed the most distinctive element of the Opponent's earlier registration. It contended that this led to an incorrect finding of similarity between the Applicant's Sign and the Opponent's mark and, consequently, a finding of likelihood of confusion.

EQUAL IMPORTANCE

Specifically, the Applicant argued that the verbal elements HELLO and FRUITY present in its sign are of equal importance and that the OD was incorrect to assign disproportionate importance to the distinctive character of the term HELLO. The HELLO element of the Applicant's Sign gave emphasis to the spelling of the English word FRUITY, whereas the Opponent's mark (HELLOFRESH) is a coined term. As a result, the marks are dissimilar in their respective concepts.

Further, the stylised nature of the Applicant's Sign is such that the overall impression it conveys – when combined with the conceptual dissimilarities – is sufficiently distinguishable from the Opponent's mark to avoid confusion.

In response, the Opponent agreed with the OD's decision. Its arguments can be distilled as follows:

1. The Applicant did not dispute a finding of identity between the conflicting goods in classes 29 and 31.

2. Aurally, the Applicant's Sign and the Opponent's mark are similar inasmuch as the first seven characters are present in both marks, as is the prefix HELLO.

3. Visually, the figurative element of the Applicant's sign does not convey any additional distinctive character that counteracts the common verbal elements.

4. Conceptually, the marks are highly similar insofar as they are comprised of the word "hello" and an adjective. Any conceptual differences do not outweigh the visual or phonetic similarities, nor do they outweigh identity between goods. Accordingly, there is a likelihood of confusion.

AGREEMENT WITH THE OD

The Fourth Board of Appeal (BoA) agreed with the OD's decision. Specifically, the BoA held that the common term "hello" is distinctive in connection with foodstuffs in classes 29 and 31. The distinguishable elements present in the Applicant's Sign (namely, the figurative elements and the term "fruity"), while visually relevant, are insufficient to counterbalance the overall impression of visual and aural similarity created by the common element HELLO.

The BoA found an average degree of visual similarity, an above-average degree of aural similarity, and a high degree of conceptual similarity and identity between the goods, ultimately resulting in a likelihood of confusion.

Accordingly, the BoA rejected the appeal in its entirety and made an award of costs of €1,170 in favour of the Opponent.

KEY POINTS

- + This case serves as reminder that appeals are designed to address material misapplications of law
- + Appeals that seek to address reasoned judgment calls made by the Opposition Division are likely to fail

MARK

APPLICATION NO. 17910200

**HELLO
FRUITY**



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Failure at the second bite



Applicants should not stint on substantiation, says Loren Ravenscroft

The EUIPO has issued a decision in an appeal for invalidity by Diffulice SARL (Diffulice) against a 3D mark (shown below) registered by Beiersdorf AG (Beiersdorf) for cosmetic skin creams. The action was brought on 26th July 2017 under Articles 59(1)(a) and 7(1)(b) EUTMR.

In its decision, the Cancellation Division (CD) noted that Diffulice had submitted a single sentence to support its claim and no facts or arguments other than a reference to the examination proceedings. The CD held that an inherent distinctiveness objection being raised in examination does not relieve an applicant for cancellation of its burden of proof and that Diffulice's claim had not been substantiated.

The CD found Beiersdorf's evidence in reply inadmissible, having been sent via courier due to technical limitations and received one day later than the request for Continuation of Proceedings (CoP). Both parties appealed the decision.

DIFFULICE'S APPEAL

Diffulice contended that the CD should have taken "well-known facts" into account, including the Article 7(1)(b) refusal at the examination stage. Further, it argued that Beiersdorf had admitted a lack of inherent distinctiveness by claiming that the mark had acquired distinctiveness, and that its evidence thereto had been insufficient. Nonetheless, the Board of Appeal (BoA) upheld the CD's decision and concluded that it is for the applicant for invalidity to produce the specific arguments and facts that call the validity of the mark into question, which Diffulice had not done. It also held that:

1. Beiersdorf's decision to base its application on acquired distinctiveness was not an admission that the sign lacked inherent distinctiveness.

2. Diffulice's claim that the evidence of acquired distinctiveness in the examination was insufficient is irrelevant, because the cancellation was based only on Articles 59(1)(a) and 7(1)(b).

3. The findings of the Examiner could not be relied upon, as the notice of refusal was not final and the reasoning behind it was not public.

4. Diffulice's evidence before the BoA was the first evidence received and was inadmissible.

CROSS-APPEAL

Beiersdorf argued that "carrying out the omitted act" in its request for CoP should be interpreted to mean that it had done everything it could have, and that the CD should have applied its discretionary powers pursuant to Article 95(2). The BoA agreed and held that:

1. Sending the documents via courier, under the circumstances, amounted to carrying out the omitted act.

2. The CD could have exercised discretion, as the material filed could have been relevant to the outcome, the proceedings were not at an advanced stage and there were exceptional circumstances justifying why the documents were received the day after they were sent.

The decision demonstrates that it is not enough to rely on "well-known facts" raised at the examination stage, and that it is not for the EUIPO to establish whether a contested mark was commonly used in the relevant sector at the time of filing. The cross-appeal indicates that the EUIPO has a wide discretion to decide whether to take late submissions into account under the CoP provision. However, having to rely on such discretion is never a comfortable position to be in, and Beiersdorf was fortunate that the decision went in its favour.

KEY POINTS

✦ It is for an applicant for invalidity to produce the specific arguments and facts which call the validity of the mark into question, and it is important to properly substantiate a call for invalidity

✦ Basing an application on acquired distinctiveness does not amount to an admission that the mark is devoid of distinctive character

✦ The EUIPO has a wide discretion to decide whether or not to take late submissions into account under the Continuation of Proceedings provision

MARK



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We have partnered with Nottingham Law School to present an interactive Live Mock CMC & Hearing later this month. Find out more at citma.org.uk/events

Calendar

Our upcoming events for members, plus other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
15th September	CITMA Webinar Copyright	Online	1
17th September	CITMA Webinar Online enforcement	Online	1
28th September	CITMA Webinar EU case law update	Online	1
29th September	CITMA Live Mock CMC & Hearing <i>Inter partes</i> proceedings with the UK IPO	Online	3
8th October	Dyslexia and dyspraxia demystified	Online	
15th-16th October	CITMA Autumn Conference Rising to the challenge	Online	6
12th November	CITMA Webinar SkyKick	Online	1
16th-22nd November	Careers in Ideas Week	Various	
24th November	CITMA Webinar UK case law update	Online	1
25th & 27th November	CITMA Paralegal Seminar	Online	3

■ CITMA event ■ IP Inclusive event

YOUR INPUT IS WELCOME

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

THE TRADE MARK 20

Q&A



Amy Salter

is fired up by a love of fashion

I work as... an Associate Chartered Trade Mark Attorney at Burges Salmon LLP.

Before this role... I was at another IP firm. Prior to that, I worked in-house for the fashion retailer Superdry.

My current state of mind is... positive and enthused! Burges Salmon actively encourages innovation and collaboration and, in spite the challenges of COVID-19, I'm excited about the future of the firm's fast-growing IP practice.

I became interested in IP... because of my love of fashion. I wanted a career that would help brands protect their creations. My time at Superdry cemented my love of IP, and I enjoy putting into practice what I learned in-house when advising fashion clients such as Victoria's Secret.

I am most inspired by... hard work and perseverance.

In my role, I most enjoy... finding practicable and commercially focused solutions and helping brand owners identify, protect and exploit their valuable assets.

In my role, I most dislike... ill-founded refusals, or entrenched opponents who create obstacles with no commercial logic.

When I want to relax I... reach for a good book.



“

I enjoy putting into practice what I learned in-house

In front of me right now is... a large coffee, a pair of sunglasses and my daily planner. I keep promising myself that I'll start using an online organiser, but there's something so satisfying about physically crossing out completed tasks.

My favourite mug says... nothing. The design washed away months ago from overuse!

My ideal day would include... an early-morning surf, lunch in the sunshine, possibly another cheeky dip in the sea late afternoon and sundowners with friends.

My favourite place to visit on business is... our London office. There's good food, great bars and an easy commute from Bristol.

If I were a brand, I would be... Google. It embraces change by consistently striving to provide new and helpful services that anticipate consumer needs.

The biggest challenge for IP is... to keep up with the rapid pace at which technology is developing, while also accounting for consumer interactions with brands in this context. Oh, and Brexit.

The talent I wish I had is... I'd love to have an ear for languages.

I can't live without... coffee. Well, I could – I just don't want to!

In my pocket is... nothing, because my outfit doesn't have pockets. I should have read these questions before I got dressed this morning.

The best piece of advice I've been given is... every person you meet is a potential door to a new opportunity, personally or professionally.

In the next five years I hope to... help develop our client base, handle some interesting cases at the UK IPO and visit my brother in Australia.

The best thing about being a member of CITMA is... the people.

i-Search

Trademark Availability Searches with Legal Opinion



WE PUT TOGETHER THE WINNING TEAM

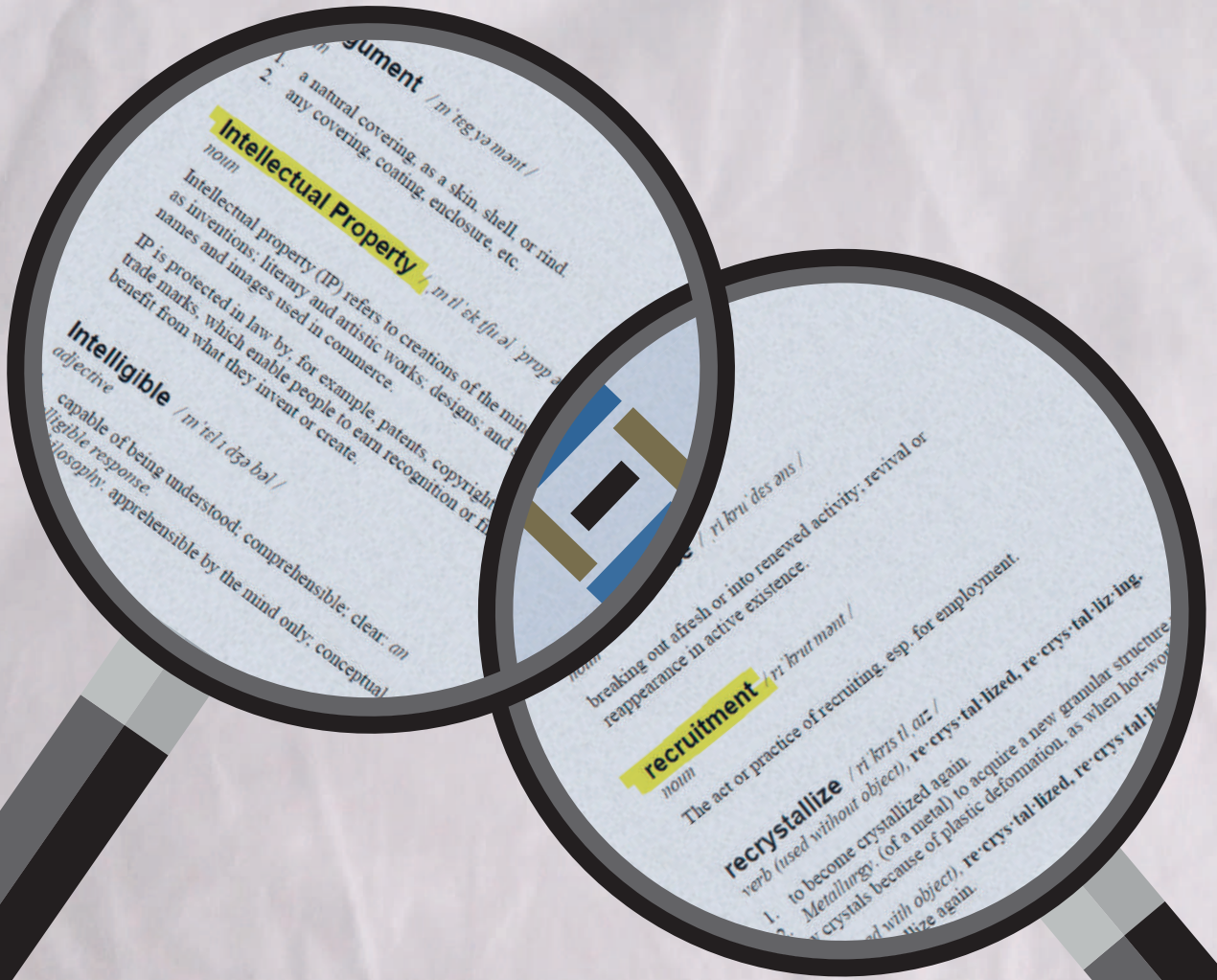
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