

CITMA REVIEW

ISSUE 473 NOVEMBER/DECEMBER 2022

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CONFERENCE
COVERAGE
P8

AFRICA: WHERE TO
START IN TECH IP?
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MAX-IMPACT
PRESENTING
P25

*We learn how IP
has fared in the
face of conflict*

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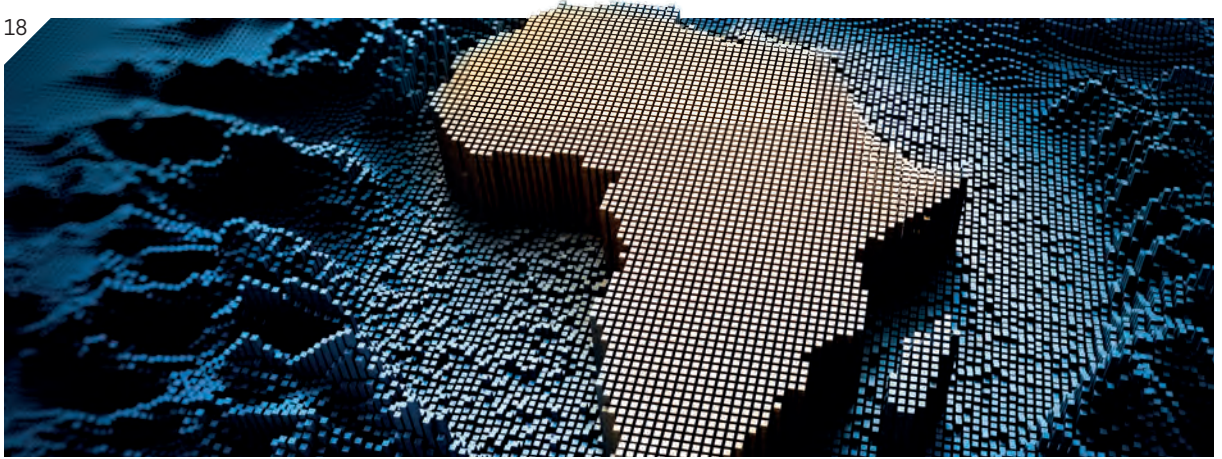


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Published on behalf of CITMA by
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CITMA Review content is provided by members on a voluntary basis, and reader suggestions and contributions are welcome. If you would like to contribute an article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

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PRESIDENT'S WELCOME HELP US RAISE THE REPRESENTATION ISSUE

I was delighted to attend our Autumn Conference in Birmingham recently. It was great to see so many familiar and new faces at the Library of Birmingham to explore the innovations that will shape our profession's future.

On the same day, I was proud to launch our campaign on representation rights before the UK IPO. If successful, the campaign will further strengthen the UK trade mark and IP system.

We are proposing that, in order to represent anyone other than yourself in front of the IPO, you must be an appropriately qualified, regulated and insured professional with knowledge of the UK system.

This change will ensure that IP rights owners can benefit from higher standards of representation and will put UK-qualified practitioners, in particular CITMA members, on a level playing field with their counterparts overseas.

We have engaged with a number of parliamentarians and ministers on this issue and will continue to ensure that it is taken seriously.

We hope that you will play your part in supporting our campaign by getting in touch with your MP to highlight this important issue for the IP community in the UK.

Finally, I am looking forward to seeing many of you at our Christmas lunches in Leeds and London. We have not been able to gather together as a profession for these events for two years now, and returning to this much-loved tradition will be a great way to wrap up the year.

Rachel Wilkinson-Duffy,
CITMA President



Latest course focuses on renewals and recordals

Our Introduction to Trade Mark Renewals and Recordals course is the latest addition to our programme of support for the learning and development of early-career professionals.

The course is geared towards formalities staff with less than six months' experience in the field. It is available to take online at any time, and takes around one to two hours to fully complete. In order to make it as easy as possible to fit the course in, participants will have access to the course for eight weeks after signing up.

The course is intended to make sure that new staff feel confident in the following areas:

- defining what a trade mark is and what it means to renew a trade mark;
- identifying the correct approach to monitoring renewal dates, deciding whether to renew a trade mark and handling late renewals;
- giving a broad overview of the renewal process in the UK and in other countries; and
- explaining what is meant by a recordal and an assignment.

If you would like to learn more about the course, please go to citma.org.uk/rrcourse



CHRISTMAS IS COMING!

We're so excited to meet with members in person during our Christmas lunches in London and Leeds. Look out for coverage of both events in a future *Review*.



IAN BARTLETT: NEW LAW & PRACTICE CHAIR

We are pleased to welcome Ian Bartlett from Beck Greener as Chair of our Law & Practice Committee. The committee discusses the implications of changes to IP law and practice and responds to consultations. It also works closely with important organisations including the EUIPO, the UK IPO and WIPO.



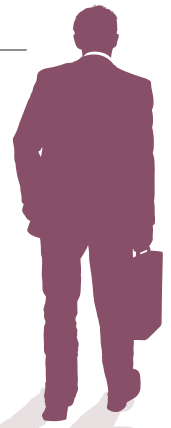
MENTAL HEALTH SILENCE

A new report from IP Inclusive and mental-health charity Jonathan's Voice has found that many in the IP industry are unwilling to discuss their mental health, but see negative effects from stress. A reported 60% of legal professionals, including Chartered Trade Mark Attorneys, felt that their work had been affected by work-related stress during the past year. Read more at citma.org.uk/ipireport



CAREER BREAK POLICY

We have launched a new career break policy, designed to ensure that members who are taking a break from work are supported. Those taking time away can apply to have their CITMA membership fee reduced by 85% while keeping the benefits of membership. Find out more at citma.org.uk/careerbreak



PARTING THOUGHTS

Tim Moss made time to address our readers as he handed over his IPO role

By the time you read these words, I will have taken up my new post as Director General and Chief Operating Officer at the Welsh Government, leaving the IPO in the capable hands of interim Chief Executive Adam Williams. In my final letter to the *CITMA Review*, I want to take this opportunity to reflect on five incredible years.

The overriding theme that stands out has been our shift to putting our customers at the heart of what we do, with everyone pulling together and asking: how can we make things better?

The way we responded to Brexit exemplifies this. Brexit dominated the organisation once we knew it was coming. We just weren't quite sure when it was going to happen or what it would look like. I remember, in the early days, checking whether our forms and systems could cope with the additional work without falling over. Then, once we had the deadline, it was full steam ahead. It was a massive piece of work.

Now we're seeing the positive knock-on impact from that. The increase in trade mark and design applications, and the growth this led to, really was a defining moment.

Then we also had the COVID-19 pandemic. It was difficult, but also brought out the best of our core values. We took risks to get services online in a matter of days and weeks. I was inspired by how we rose to these challenges, ensuring the needs of our customers remained at the centre of our thinking.

Over five years, the number of domestic trade mark applications we received more than doubled – to more



“

As I embrace a new challenge, the outstanding team at the IPO will continue working to build a world-class IP system in the UK

than 150,000 last year. This growth, of course, came with its own set of challenges. At its peak in March 2021, the trade mark application backlog stood at over 30,000.

Last May, I was delighted to announce that we cleared all our backlogs for the first time in many

years. We did this by finding ways to be more efficient, and through our excellent teams' hard work. With the backlogs cleared, the IPO can firmly focus on transformation. Better services mean that, as demand increases, backlogs shouldn't build up as they have historically.

But the One IPO Transformation Programme isn't just about making paper services digital – it's about the IPO's future. Historically, the IPO's systems didn't always do what they should have – with something like 16 ways to register an address. The inherited limitations went back a long way.

As well as a vehicle to get systems up to standard, One IPO is also a springboard for the future. It will ensure the IPO can adapt to take advantage of rapidly changing technologies, from machine learning and AI to whatever opportunities come next.

Engagement with CITMA members remains essential. We are grateful for the recent contributions to our call for views on the design system and the continuing support for our One IPO Transformation Programme.

As I embrace a new challenge, the outstanding team at the IPO will continue working to build a world-class IP system in the UK. The ongoing input of CITMA members is crucial to this. ●



Tim Moss

served as Chief Executive of the IPO until 1st September 2022. He is now Chief Operating Officer at the Welsh Government.

EMPOWERING YOUNG PEOPLE



OWN YOUR IDEA

Your award-winning corporate social responsibility project Own Your Idea has been at the forefront of your efforts to empower future generations. How did Own Your Idea emerge? Can you tell us about the details of the project?

One of the most important indicators of a country's economic growth is its investments in the field of IP. To increase the global competitiveness and brand value of our country, we believe that it is important to raise awareness and educate our young people about IP to enable them to lean into the future with success. This thought process is what led us to develop the project. We say "Own Your Idea" to our young people, who will carry the world into the future with their efforts, inventions and ideas, and to companies and entrepreneurs, who are already carrying out commercial activities with their products and services. Young entrepreneurs who are interested in making inventions, who are excited to create a new product or brand, need to be informed about how to protect their rights both in Turkey and anywhere else in the world. With this project, we have demonstrated that we are one of the biggest supporters of all young people who want to carry their ideas into the future.

Launched in 2019, our Own Your Idea project primarily aimed to raise awareness of IP and started with general IP seminars. We conducted a needs analysis in schools and determined which schools wanted to apply for registrations in particular fields. We then went on to carry out more in-depth workshops and one-to-one sessions based on the needs of schools, assigning specialist volunteer mentors from within our firm.

Our project mainly targets students studying in technical and vocational high schools. We believe that awareness of IP should be raised at a very early age. We ensure that young entrepreneurs are informed about how to protect their rights both in Turkey and in other parts of the world.

Another pillar of our project consists of training sessions for entrepreneurs and SMEs. In these training sessions, companies are provided with essential information on how to protect the products or services they offer and how to increase their competitiveness.

How many people and how many cities have you reached so far with this corporate social responsibility project? Can you share the quantitative return of the project?

To date we have signed protocols with regional departments for education in 13 provinces of Turkey and provided training seminars on IP to all technical and vocational high schools.

Through our training, we have reached over 12,000 young people so far. Detailed workshops and mentoring activities continue in the schools where the second phase of the project has started. We continue our work with the aim of spreading this awareness all over Turkey through our cooperation with various high



schools, entrepreneurship clubs of universities, NGOs, associations, tech cities and technology incubation centres.

The Own Your Idea project also supports the "Decent Work and Growth" and "Industry, Innovation and Infrastructure" goals in Articles 8 and 9 of the 17 Sustainable Development Goals adopted by UN Member States at the Sustainable Development Summit. At last year's 13th Corporate Social Responsibility Summit, organised by the Corporate Social Responsibility Association of Turkey, we were delighted to receive the Silver Achievement Award within the scope of the Sustainable Development Goals Awards with our Own Your Idea corporate social responsibility project.

We have now started exploring partnership and collaboration opportunities with charities and NGOs in the UK, with the aim of growing our project and supporting young people internationally. ●

Established in 1983 to provide services in the field of IP rights, Destek Patent has been a pioneer in the development of the sector as well as the services provided in the field of IP since its establishment. Destek Patent provides services in many areas, such as research, follow-up, interpretation, analysis, comparison, valuation, system establishment and development, training, etc. In addition to registration and protection procedures, Destek has delivered consultancy and representation for more than 260,000 trade marks, nearly 48,000 patents/utility models and nearly 330,000 designs in the national and international arena through its 15 offices and 200 professional staff in Turkey, the UAE, Kazakhstan, Switzerland and the UK.

Faruk Yamankaradeniz

Chief Executive Officer, Destek Patent



AUTUMN CONFERENCE 2022

STEPPING INTO THE FUTURE

Our Autumn Conference in Birmingham was a great opportunity for practitioners at all career stages to learn from each other and collaborate as we explored the questions that will shape our industry's future.

The trade mark profession is undergoing rapid change, and our conference, titled "Stepping into the future", offered us a platform to consider the developments that we expect to see both in the short term and in the coming years.

The conference took place at the Library of Birmingham, an inspiring city-centre venue that offered us a flexible environment in which to learn and network together.

We enjoyed a cabaret-style setup, with delegates gathered at round tables to promote a collaborative approach



to the day. This format allowed us to share our thoughts and reflections as the day progressed, particularly during our session on non-fungible tokens (NFTs).

PRESIDENTIAL OPENER

In her opening address, CITMA President Rachel Wilkinson-Duffy welcomed delegates and reflected on our new representation campaign.



In order to strengthen the standing of the UK's world-class IP system on the international stage, our new campaign suggests to the Government that everyone who represents someone else in front of the UK IPO must be appropriately regulated and insured in the UK and have an appropriate understanding of the UK system.

This change will level the playing field for UK practitioners in relation to their competitors based in other countries where practitioners are already required to be qualified and regulated in order to work in the region. In contrast, the UK currently only requires an address for service.

UK CASE LAW UPDATE

Jonathan Moss (Hogarth Chambers) offered us an update on all the key developments in UK case law over the past year, in particular drawing

our attention to the increasing tendency for the IPO to strike out bad faith claims. "The IPO has been much stricter in my experience in not allowing bad faith applications to go ahead," Jonathan told delegates. He also noted that we have recently seen survey evidence become more prevalent. For example, it was used effectively in the *Lidl v Tesco* case.¹

SPOTLIGHT ON NFTS

The focus of this conference was the changes that our industry will see in the future, and this was most characterised by our exploration of the impact of NFTs on IP. Alex Watt (Howard Kennedy) helped delegates to better understand how we might expect NFTs to affect IP

Alex Watt



practice going forward. He noted some interesting trends, giving the Museum of Modern Art in New York as an example, which is selling a Picasso in order to invest in NFTs.

Making use of our collaborative round-table setup, Alex invited delegates to discuss a series of questions, which helped us to share views on this emerging, and often complex, area of practice. This opened up the room for lots of interesting conversation, with delegates sharing their expertise and opinions to debate and reflect on what the future may hold.

ANTI-COUNTERFEITING AND GEOPOLITICS

To help us understand the relationship between geopolitical upheaval and efforts to prevent counterfeiting, Tom Nener (Pinsent Masons) pointed out three key global events that have been providing increasing opportunities for counterfeiters: ▶



Tom Nener

- the US–China trade war;
- the COVID-19 pandemic; and
- the Russia–Ukraine conflict.

Tom said that it is too early to really understand the impact of the conflict between Russia and Ukraine. However, “we have already seen a spike in counterfeits of certain products, such as cooking oil”, he noted.

In addition, he explained that Russia already hosts a strong market for counterfeit goods, with 40% of handbags sold in the region found to be counterfeit. The Russian Government’s increasing reluctance to enforce foreign IP rights will likely increase the scale of this problem.

Tom also explored the possible avenues that we might consider when promoting a lower level of counterfeiting in a market, particularly in relation to how we might prevent pirated media from spreading on the internet. Internet-based pirating is particularly challenging to control, with perpetrators avoiding becoming tied to a location by continuously moving around. In order to counter this, Tom laid out the importance of developing strategies that target each section of the supply chain, to maximise the chances of interception.

GOOD PRACTICE TIPS

The IPO’s Heather Harrison (Senior Hearing Officer and a Company Names Adjudicator) offered our delegates some insider tips on how to best work with the Office.

She noted that the level of professionalism and competence that the IPO sees from Trade Mark Attorneys “continues to rise” – a testament to the hard work that our members put into representing their clients in front of the



Heather Harrison

IPO. However, Heather identified some pitfalls, including:

- Not reviewing pleadings in advance of final submissions. Reviewing your pleadings allows you to be discerning in terms of what evidence needs to be included. By reviewing your pleadings consistently during the process, you can also identify gaps that may be present in your argument and source the evidence or witnesses necessary to fill those gaps.
- Not keeping to the submission length limit. Submissions that are longer than the specified 300 pages are likely to become repetitive or to include long lists of marks that are rarely helpful outside of bad faith oppositions. As Heather put it: “There are only so many times you need to see something to be persuaded of a point.” Similarly, she noted that it is by far best for a witness to demonstrate why and how the evidence presented supports what they’re saying and to draw attention to the most relevant aspects.
- Applying for confidentiality without good reason specific to your case. In particular, the suggestion that the case is commercially sensitive is not a strong enough reason for confidentiality. Heather encouraged us to bear in mind that, in the majority of circumstances, something that happened a relatively long time ago is very unlikely to be considered reasonably eligible for confidentiality. However, she also reminded us that it is entirely acceptable to redact certain elements of evidence, for example the names or identifying details of witnesses, or the number of units of a product sold.



SECURITY INTERESTS EXPLORED

Mei Mei Wong (DLA Piper), who has a background in finance law, took us through the crossovers between financial transactions and trade marks, and the types of security and security packages that may be created over registered and unregistered trade marks.

She explored the three most common types of security created in relation to trade marks and the steps that might be taken under each one:

- mortgage: the taking of a title upon taking security;
- fixed charge: creation of encumbrance upon taking security; and



Mei Mei Wong



Kane Ridley (left) and Carol Nyahasha (right)



Sally Britton

“ *The level of professionalism and competence that the IPO sees from Trade Mark Attorneys ‘continues to rise’* ”

- floating charge: the appointment of an administrator.
Mei Mei then shared the key risks of which practitioners must be aware in order to come as close as possible to perfect security interests.

PARALEGALS: IMPROVING ACCESS

Kane Ridley (Keltie LLP) and Carol Nyahasha (Elkington + Fife) sat down with Kelly Saliger (CMD) to share their wisdom on the changing nature of the paralegal profession and to consider the ways in which our industry can support paralegals.

They identified that, increasingly, being a paralegal constitutes an interesting, varied and successful career in its own right – it should not be seen only as a stepping stone to becoming a Trade Mark Attorney.

Kane noted that the increased availability of technology means that far less time is now spent on data processing and other time-consuming tasks, allowing paralegals to evolve into more engaging areas of work.

Our speakers commented that mentoring is a particularly valuable way to support paralegal careers, and that investing in growth and development for paralegals is one of the best ways



to ensure a higher rate of retention. Furthermore, long-term mentoring opportunities can allow people to see a clearer trajectory for their own careers.

ICELAND v ICELAND

Mishcon de Reya’s Sally Britton, who was directly involved in the Iceland case that went to an oral hearing before the EUIPO Grand Board recently, shared with delegates her insight into what was involved in the proceedings. This was the first ever oral hearing held by the Grand Board, and Sally offered our delegates a unique look into the proceedings, laying out for us the pathway that resulted in the case being heard.

She helped us to understand the ins and outs of the hearing itself, detailing its particular features to ensure that future teams know what to expect and what to avoid. Finally, she explored the next steps that will now be taken. Although the hearing itself was an uncommon occurrence,

understanding the form that a hearing takes represented a valuable learning opportunity for our delegates.

EXHIBITORS IN ATTENDANCE

We were also joined by a series of exhibitors, who attended the conference in order to make sure that our delegates could gain a full understanding of the services and support networks that are available to them and their clients. These exhibitors included the IPO, Jonathan’s Voice and John Venn & Sons. Thank you to our sponsor, Corsearch, for helping us to bring together such an educational and enjoyable event.

We would also like to thank all of our speakers, delegates and exhibitors for all of the effort that they put into making the day a great success – we look forward to seeing you all again at our Spring Conference, and at more of our events over the coming months. ●

1. 2022 EWHC 1434 (Ch)



SPOILED BY WAR

What happens when IP comes under attack? Cherrie Stewart digs into how trade marks have fared in troubled times

War brings devastation to countries, businesses and individuals.

Disruption ripples outwards from war-torn countries. Trade routes are interrupted or obliterated. Trading partners cease to exist. Alongside the physical attack, an economic war is waged, with tangible and intangible property used as a weapon either in an attempt to apply pressure to a party or to prevent support for a war.

Although acts of sacrifice and peace-making efforts are made, there are also those who will take advantage of conflict and the chaos that war brings – and IP rights are not unaffected. This has been the case throughout history, and recent events affecting Ukraine have seen the strategy continue. While this article can't provide an in-depth analysis of the effect of the Russo-Ukrainian War on IP, it is an attempt to understand some of the issues and potential consequences that have, and may still, result from a time of aggression and confusion.

CONFLICTING IDEAS

At the turn of the 19th century, there were two schools of thought concerning the nature of war. One notion was that war between nations is a war between their individual citizenries. Another was that war is a confrontation between states and not among individuals, who were enemies only accidentally. The Hague Conventions of 1899 and 1907 sought to harmonise these views and put into place international agreements as to how war would be conducted, with the aim of minimising disruption to ordinary people.

Article 46 of the Hague Convention of Land Warfare states that “private property cannot be confiscated”. This has its roots in the Magna Carta of 1215, which codified conditions concerning the safety of foreign merchants and their wares. Essentially, a foreign merchant and their goods could have “safe and secure” passage into, out of and within England. In addition, if they were in England when war was



proclaimed against their country, they would be detained “without injury to their bodies or goods until information be received by us, or by our chief justiciar, how the merchants of our land found in the land at war with us are treated; and if our men are safe there, the others shall be safe in our land”.

This principle appears to have been diluted during both world wars, when governments in all the countries involved put into place Acts and decrees that allowed them to sequester (ie, forcibly take possession of or confiscate) large amounts of property, including bank deposits, industrial facilities, corporate bonds and IP that belonged to individuals or businesses of the nations with which they were at war.

The sequestration of property was not a new policy. Indeed, during the

“Tangible and intangible property is used as a weapon either to apply pressure to a party or to prevent support for a war”

English Civil War and Interregnum of the 17th century, the policy of sequestration was implemented by Parliament. This allowed Parliament to confiscate the property of anyone deemed to be supporting King Charles I.

The First World War began on 28th July 1914, and by the end of that year, the UK, France and Germany

had launched attacks on enemy property within their own borders. In the UK, the Trading with the Enemy Act 1914 was adopted, which held that confiscated enemy assets had to be put in trust and business activities monitored by the Board of Trade. This Act gave rise to an interesting piece of law, *Daimler Co Ltd v Continental Tyre and Rubber Co (Great Britain) Ltd* [1916] 2 AC 307, regarding whether a company as a legal person could be considered to have “enemy” character. Here, the House of Lords determined that the individuals in ultimate control of a company determined its character and therefore a legal person – a definition that can include a company – could be considered to be an “enemy”.

Following the Paris Convention in June 1916 when the Allied governments met to, among other things, agree on how to deal with enemy subjects and property, liquidation of enemy property became the common practice. In the UK, an amendment was made to the Trading with the Enemy Act 1914 and property was liquidated and held in trust pending the outcome of hostilities.

TREATY OF VERSAILLES

As part of reparations under the 1919 Treaty of Versailles, IP that had been sequestered by governments under various national acts was either nationalised or sold to private companies. For example, the German company Bayer AG owned a patent for the formula for a form of acetylsalicylic acid and trade mark registrations for the mark ASPIRIN. These rights were sequestered along with other assets of the

company in the US. Trade mark registrations for the ASPIRIN mark and patents relating to it, as well as IP related to other products in many countries, ultimately ended up in the ownership of US company Sterling Products Inc.

Having acquired the rights to the marks and patents, Sterling required technical assistance from Bayer. Sterling and Bayer entered into an agreement to the mutual benefit of both parties allowing Bayer to recoup some of its losses that had resulted from the reparation provisions under the Treaty of Versailles and Sterling to benefit from Bayer's technical know-how. Interestingly, these agreements led to some of Sterling's assets being seized by the US Government in 1941, when it was then deemed to be collaborating with the enemy to the benefit of the Nazi regime.

Ultimately, the assets, including the Canadian trade mark registration for the mark ASPIRIN, which were lost as a result of the reparation agreement of the First World War, were restored to Bayer when parts of the Sterling business were purchased by Bayer in 1994 – around 75 years after they were first lost.

Bayer was not the only company to lose IP rights as a result of the seizure of enemy assets. For example, at the end of the First World War, the Chemical Foundation purchased 4,500 German-owned chemical patents from the US Government for a fraction of what they were worth.

During the Second World War, the UK Government again confiscated assets in British territories owned by residents of enemy countries, including the former Nazi Germany, Italy and Japan, and countries occupied by them, under the Trading with the Enemy Act 1939.

So, it appears that the consensus in international law is that war is between states and not among individuals. The sanctions that are in place are focused against the state, state institutions and key individuals, but are not blanket sanctions against

the citizens and businesses of the country as a whole. In the recent context, these types of sanctions are, as stated by the UK Government, “aimed at encouraging Russia to cease actions destabilising Ukraine or undermining or threatening the territorial integrity, sovereignty or independence of Ukraine”.

BATTLE AGAINST BIAS?

We do not live in a bubble, and the impact of the culture and events with which we are surrounded can influence our thoughts and actions. Consider the March 2022 case of a Russian judge ruling against Entertainment One, the company that produces Peppa Pig animations. This copyright and trade mark infringement lawsuit brought against Ivan Kozhevnikov was widely reported in the UK media.

With sensationalist headlines such as “PUTIN’S PORKIES: Russia sanctions PEPPA PIG in latest bizarre act of retaliation against the West over Ukraine invasion penalties”, there was public outcry over what was widely considered to be an unfair judgment. It was reported that the judge in question had admitted that the decision was influenced by “unfriendly actions of the United States of America and affiliated foreign countries”, which heavily suggested that IP was being used as a weapon by Russia.

Was this a singular incident caused by a possibly overly patriotic and nationalistic judge who had not maintained the required impartiality, or was it an indication of a change of policy in Russia? Could the fact that, on appeal, the Peppa Pig decision

was overturned in June 2022 indicate it to be the former?

At the same time that controversial story hit the headlines, a cluster of articles appeared stating that many applications for Western trade marks filed by Russian nationals had been “accepted” by the Russian Patent and Trade Mark Office, Rospatent. In response, Rospatent issued a statement on 1st April 2022, indicating that: all Russian trade mark applications, whether accepted or not, are published; that the publication of an application did not in any way indicate that the mark had been accepted for registration; and that there had been a departure from the normal practice of Rospatent. It specifically pointed out that an application to register DYADYA VANYA (дядя Ваня in Russian), similar to MCDONALD’S, had already been withdrawn.

REPUTATIONAL RISK

The reality of bias also means that individuals will take sides in any conflict and firms seen as trading with the enemy may face a public relations battle – even more so if the company has been seen to have profited from war or conflict.

Take the case of the international brand Hugo Boss. The brand's founder and namesake was a member of the Nazi Party, designed and produced Nazi uniforms and used slave labour from concentration camps. After the Second World War, Hugo Boss himself was stripped of his right to own a company, but the company continued to operate under the management of his son-in-law and has become an international brand and one of Germany's largest clothing companies.

More than 80 years later, the company still has to defend itself against claims of “collaboration”. In 1999, it contributed to a fund to compensate former forced labourers and, in 2011, the company issued an apology that expressed its “profound regret to those who suffered harm

One of economic war's unlikely combatants



INK DROP/SHUTTERSTOCK



M&S-branded stores in Russia operate under licence held by a Turkish franchisee

“Coca-Cola did not take what was deemed by the masses sufficient action ... and the campaign #BoycottCoca-Cola resulted

or hardship at the factory run by Hugo Ferdinand Boss under National Socialist rule” – this after the publication of a book that revealed new details about the role of forced labour in its factories.

When Russia invaded Ukraine in February 2022, many Western companies pulled out of Russia in an attempt to prevent a public backlash against them. Those who were deemed slow to act found themselves on the defensive after being criticised for their apparent lack of action – sometimes unfairly perhaps.

For example, high street staple Marks & Spencer found itself in the proverbial crosshairs. Despite having published a statement in support of Ukraine on 3rd March 2022 and pledging a package of financial support, M&S was hit by UK headlines such as: “M&S ROW: Marks & Spencer has blood on its hands after failing to shut shops in Russia, Ukrainian MPs claim” and “M&S

criticised for ‘not going far enough’ to support Ukraine”.

True, in Russia, 48 stores operating under the MARKS & SPENCER trade mark remained open. However, since these were operated by a Turkish franchisee, Fiba, using the trade marks under licence, M&S was not contractually able to close the shops. It did, however, suspend shipments to Fiba’s Russian business.

Coca-Cola also found itself trying to balance the need to maintain the goodwill in its brand and the need to maintain and enforce its trade mark rights. Coca-Cola did not take what was deemed by the masses sufficient action to stop trading in Russia, and a social media campaign under the hashtag #BoycottCoca-Cola resulted. On 8th March 2022, the Coca-Cola Company issued a statement announcing that it was “suspending its business in Russia ... We will continue to monitor and assess the situation as circumstances evolve”.

FILLING THE VOID

The refusal of major brands to export goods to Russia has its own consequences. In particular, it has led to a number of third parties trying to fill the void and an increase of parallel imports into Russia. Russian Decree No. 506 came into force upon its publication on 30th March 2022.

It authorised the identification of types of goods that could be exempted from the laws that relate to regional exhaustion of IP rights.

By May 2022, the Russian Government had published a list of goods for which parallel imports would be acceptable, and in connection with which the principles of regional exhaustion would no longer apply. The list included 55 categories of goods, such as pharmaceuticals and medical products, chemical products, textile fibres and materials, clothing and footwear, equipment and devices for the nuclear industry, electrical machinery and equipment, land vehicles, ships, furniture, and many more, although each category is further qualified.

As a result, Coca-Cola and many other companies have had to take a number of actions in an attempt to prevent parallel imports of their goods into Russia. Having unsuccessfully blocked Pivoindustria LLC from importing branded products, such as Fanta and Coca-Cola Cherry, into Russia – and despite soft drinks not being on the “acceptable” list published by the Russian Government – Coca-Cola is at the time of writing seeking judgment in multiple cases in the Russian courts.

The Russian Government’s adoption of Decree No. 299, which, in effect, allows the use of patents from countries deemed “unfriendly” (eg, the UK) without licence and without appropriate consideration being paid to the owner of said IP, so long as such use is deemed to be needed for the purpose of national security or for other qualified purposes, is not the first act of its kind.

During the First World War, the Australian Government, upon discovering that certain essential products were in short supply, suspended German patents concerning them and allowed local businesses to apply for permission from



ABRAMOVA ELENA/SHUTTERSTOCK

the Government to manufacture patented products and use the associated trade marks. Once again Bayer found itself affected. Its patents were suspended and the right to manufacture aspirin were given to Shmith, Nicholas & Co. Realising that the trade mark ASPIRIN could be reclaimed by Bayer after the war, Shmith, Nicholas & Co adopted and registered the trade mark ASPRO.

A further concern to trade mark owners withdrawing from Russia is the possibility of trade mark registrations becoming vulnerable to non-use cancellation actions. A Russian trade mark registration becomes vulnerable if it has not been used by its owner, or with the owner's consent, within three years of registration.

As enacted in Article 5 of the Paris Convention for the Protection of Industrial Property Rights, of which Russia is a party, proper reasons for non-use include "if legal or economic conditions have prevented the use of the mark in a given country, for example, if the importation of certain products has been prohibited, or prevented by war, or if there was no market for such products" and this is reflected in Russian law and past practice.

Will the withdrawal of trade in support of Ukraine during the Russo-Ukrainian War be considered a proper reason for non-use of a mark in the eyes of Russian courts? Is this non-use of trade marks in Russia outside the control of the trade mark owners? These remain open questions. While the UK is applying economic pressure to Russia, and the possibility of taking more direct involvement in the conflict has been raised, the two countries are not, at the time of writing, "at war".

TERRITORIAL CHANGES

War can also change the geographical boundaries of territories, which has an impact on territorial rights such as IP rights. At the close of the Second

“ While the UK is applying economic pressure to Russia ... the two countries are not, at the time of writing, ‘at war’

World War, Germany was divided into two territories. In West Germany, a "patent-office-free period" began, which ended on 1st October 1948, when mechanisms for the application for patents or the registration of trade marks were once more in place. Meanwhile, in East Germany, an IP system was set up by the German Economic Commission, a body established by the Soviet occupying power, and an IP office was opened in Berlin in September 1948.

When the Republic of Ireland first gained its independence from the UK in 1921, all UK registrations ceased to cover Ireland. For approximately seven years, there were no trade mark registrations. It wasn't until the Industrial and Commercial Property (Protection) Act, 1927 was passed that the owners of UK rights were given the opportunity to apply for the protection they had once enjoyed in that territory.

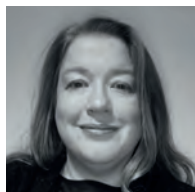
The conflict between Russia and Ukraine has already resulted in territorial changes. In 2014, Russia claimed Crimea as part of its territory, and owners of Ukrainian patents and trade mark registrations were given the opportunity to maintain their local registered rights

by opting into the Russian trade mark system and obtaining a comparable mark there. The applicant had to be a resident of, or have a permanent location in, Crimea, and the trade mark registration or patent had to have been valid on 18th March 2014.

It has been discussed that the potentially conflicting rights resulting from the integration of such Crimean rights into the Russian trade mark register could be resolved in a similar way to the integration of the trade mark registers of East and West Germany in 1990. In other words, where there is a clash of rights, each party's rights would be restricted, as appropriate, to either Crimea or Russia.

On 22nd July 2014, the Ukrainian Government conferred the legal status of an occupied territory on Crimea and declared that it would remain subject to the Ukrainian regime in IP matters. Consequently, there appear to be dual IP rights in Crimea and confusion over jurisdiction. No timeline by which clarity may be found is apparent.

While we do not know precisely what the future holds, if the Russo-Ukrainian War continues, we can predict that the difficulties for brand owners will increase and the ability of Trade Mark Attorneys to provide advice regarding protection of trade marks in Ukraine, Russia and Belarus, and potentially other territories, without including a multitude of caveats, will be severely hampered. If history is our guide, however, what we can be certain of is that the ramifications of the Russo-Ukrainian War will affect the owners of IP rights for many years to come. ●



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TECH START-UPS:

WHERE TO START?

Carol Nyahasha and Olusegun Oyesanya explore the obstacles and outlook for new, IP-rich companies seeking a home in Africa

Creating a brand and launching to market is daunting for any entity. Imagine having to do that in an environment that is not hospitable to start-ups or does not have the regulatory framework to assist in the protection of the brand. This is often the challenge for fledgling technology firms based in African countries and those that are

diaspora-based and cater to a large number of Africa-based customers.

Brand names carry the weight of a business, whether to a new territory or new product/service line. For instance, in Nigeria, MTN (Africa's largest mobile network operator) recently launched its Payment Service Bank and hit 4.2 million subscribers in less than two months. Yet the reason MTN – and the likes of Microsoft, IBM, Amazon and Paystack – can make blockbuster revenues just by affixing

their brand name to a product is simple: the goodwill and reputation associated with the brand name. It is less than likely that a start-up with a not-so-powerful name behind it can achieve the same results.

Adaora Oramah, founder of AMAKA Studio, has built a media-tech platform spotlighting diverse and nuanced stories for women from Africa and the diaspora. Oramah's business is based in the UK, but its readers are mainly based throughout Africa. Therefore, the



“ VCs are keen to back investable start-ups that have strong knowledge of protecting their brand

not be used without her express consent. She eventually based her business, and filed her first trade mark application, in the UK because of the affordable corporate set-up costs and trade mark filing fees and its accessibility to African markets. In fact, for Oramah, the costs and regulatory issues were, and continue to be, the major barriers preventing her from seeking further trade mark registrations in the African countries that are on her brand protection wish list.

FEAR FACTOR

A regulatory framework to protect IP rights is pivotal to IP enforcement and the development of the start-up ecosystem, and to providing that confidence that Oramah is looking for as a tech start-up. Just as importantly, any tech company should expect that its approach to IP assets will be scrutinised almost

the larger the start-up's brand protection, the larger the cheque will be. The lesser the IP security, the more exposure there will be, and that one factor alone may scare away potential investors.

Oramah learned very early on when looking for funding from venture capitalists (VCs) that they were keen to know what steps she had taken to secure her brand name. Based on her experience, she said: “VCs are keen to back investable start-ups that have strong knowledge of protecting their brand.”

Generally speaking, the fate of start-up ideas and their execution rests on the ease of doing business in the country. Doing the maths on this involves looking at regulatory performance on indicators such as procedures (number), time, cost (percentage of income per capita), minimum capital, getting credit, paying taxes, enforcing contracts and trading across borders. The most compatible countries will be those that ensure that government policies are geared towards creating an enabling environment.

So where might tech-based entrepreneurs find areas of adequate confidence in Africa proper? Some countries have begun the legislative process to create enabling environments for start-ups that may begin to appease founders and their backers. This includes protection of their IP rights. For example, dedicated legislation to promote start-up growth has been, or is being, developed in 35 African countries.

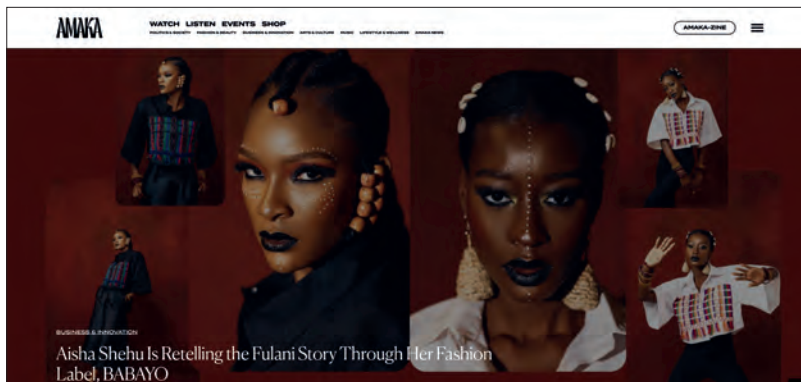
This includes, notably: Uganda's Technology Sourcing Laws and Regulations (2021); Tunisia's 2018 Start-up Act; Egypt's Investment Law (2017); the Senegal Start-up Act 2019; the Kenya Start-up Bill 2021 (pending Presidential assent); the Start-up Proclamation of Ethiopia 2020 (Draft); the Ghana Start-up Bill; the Nigeria Start-up Bill 2022; and Executive Decree No. 20-254 of Algeria (2020). ▶

business focused on achieving trade mark registration in the UK and Nigeria. When asked what her biggest challenge was in building her brand and protecting it, Oramah told the *CITMA Review* that deciding where to set up first was very difficult.

As an innovator and tech start-up owner, Oramah needed to be working from a jurisdiction in which she could innovate with peace of mind and the certainty that the brand would

immediately. As tech start-ups continue to build and rise, investors will be careful to check the security investments that have been made to protect the brand.

Investments or acquisitions can happen in two ways: either the company's brand is retained and proprietary rights are transferred, or the acquired company's brand is subsumed into the investor company's brand. Either way,



START-UP SUPPORT:

COUNTRY FOCUS

KENYA

The Kenya Start-up Bill 2021 includes probably the most advanced legislation in terms of IP protection for tech start-ups. Along with the existing digitalised collaboration from the IP office, the Bill goes further to provide fiscal and non-fiscal assistance for start-ups in with registration, grant, revocation and institution of legal proceedings to enforce their IP rights.

NIGERIA

The Nigeria Start-up Bill 2022, passed in July this year and awaiting Presidential assent at the time of writing, is an exciting piece of legislation for founders and foreign companies that want to open subsidiaries in Nigeria and that also qualify as start-ups. It provides for several tax incentives, access to seed funding, incubation programmes and public-private partnerships that would be accessible under the law.

On IP rights, the Bill would foster digitalised collaboration (a one-stop shop) through which start-ups can register all their IP rights seamlessly. This is a contrast to the need for registration in different IP offices and, in some cases, manual registration. It should be noted, however, that Nigeria still implements the single-class filing system. As noted by Adaora Oramah, it is prohibitively expensive to file in Nigeria – it costs her approximately £6,000 in fees to file in her chosen classes. If it had not been for the fact that Nigeria is a key market for her, she would have utilised her funds in other markets, she says.

SOUTH AFRICA

While the South African start-up environment is one of the most developed on the African continent, it is not without its challenges, given that there is no start-up-friendly policy in place. Due to the high costs associated with set-up infrastructure (eg, business incorporation, legal fees) for start-ups, it has become a trend for South African tech founders to register their companies in the US in order to access international investments. As a result, a group of tech entrepreneurs have proposed a Start-up Act to stop the IP leak from South Africa to the US. According to the Start-up Act Position Paper, its purpose is to outline ways in which to accelerate the success and contribution of start-ups and high-growth firms. Its aim is to remove or reduce the burdens that are keeping such firms from playing a larger role and having a greater impact in the national economy.

TUNISIA

Tunisia was the first African country to enact a start-up law. Start-ups in Tunisia are now entitled to corporate tax exemptions for up to eight years, financing of up to TND5,000 net per month (approximately US\$1,500) and increased access to foreign currencies to expand foreign operations. Although start-ups are still required to protect their IP rights through the established route of registrations with the Industrial Property Office, there are more funds freed up for start-ups that are seriously considering brand protection.

Whether all of these engender brand protection for technology start-ups specifically is a different question. However, most of them do (or will) co-exist with existing legislation that protects IP/trade mark rights in these countries.

Providing some hope, fDi's *African Tech Ecosystems of the Future 2021/2022* report found that: "Despite the relatively nascent stage of start-up ecosystems across Africa, more than \$2bn has been raised over the past two years." However, it cautions that: "Funding remains heavily skewed towards just four countries: Nigeria, Egypt, Kenya and South Africa." The report ranks the top 10 countries with the best start-up environments in Africa as: South Africa, Kenya, Egypt, Ghana, Tunisia, Nigeria, Morocco, Namibia, Rwanda and Côte d'Ivoire. One cautionary note here: it is very likely that South Africa, Kenya, Nigeria, and Egypt appear on this list because of their sheer market size, gross domestic product and foreign direct investment inflows.

According to StartupBlink's *Global Startup Ecosystem Index Report 2022*, only South Africa (3), Nigeria (4) and Kenya (5) appear in the top 10 regional country ranking for the Middle East and Africa. However, just outside that set is Morocco, which the report says offers "the best country-level news", sitting in 12th place regionally and gaining 16 spots to rank 79th globally. In its analysis of cities, it says "the most impressive increase comes from Lagos". Lagos appears at number three in its top 20 cities regionally, having gained 41 places globally to breach the global top 100. Cape Town, Johannesburg and Cairo also feature in the regional top 10. Cairo, notably, leapt 20 points in the global index, while Nairobi lost 27 places in that ranking.

BEST PRACTICE

Certainly, the IP protection challenges faced by tech companies starting their journey in African countries are not new. They range from ineffective policing systems, delays in the judicial process and lack of funding and training for enforcement and judicial

officers, to the burden of manual application and search systems. Despite the evident hurdles, and until government intervention provides solutions, tech start-ups must warm to the task of incorporating brand protection in their set-up costs. Start-ups should always plan with long-term goals in mind, especially putting in place effective monitoring and a solid IP management team. Some effective IP strategies to include when advising tech start-ups with an interest in Africa are as follows:

- Getting a head start and filing a trade mark application for the company's name (or brand names) and logo. Those countries with a developed start-up ecosystem might offer assistance on this front given how prohibitive the costs can be. Seeking local knowledge on how the IP system in a particular country functions is a must, as that will help with formulating a viable filing strategy.
- Pre-filing searches. South Africa has the most established and documented IP regime in Africa, making it easy to carry out searches for prior marks. Some countries require a manual search, which might take months. So, if timing is an issue, consider filing a priority application elsewhere (such as the UK or South Africa) to place a marker in the sand while searches are being carried out in the countries of interest.
- Using filing systems that allow a bundle of rights (eg, Madrid, Organisation Africaine de la Propriété Intellectuelle, and African Regional Intellectual Property Organisation).
- Encourage the monitoring of third-party rights or infringement (trade mark watch service, opposition, court orders, recovery of domain names) given the relatively low costs of putting watch services in place. This is something that Oramah takes seriously given the digital nature of her brand and the prevalence of copycats in the space she operates in.

As the demand for tech-based products increases in Africa, so does the need for differentiation of those products and related services from

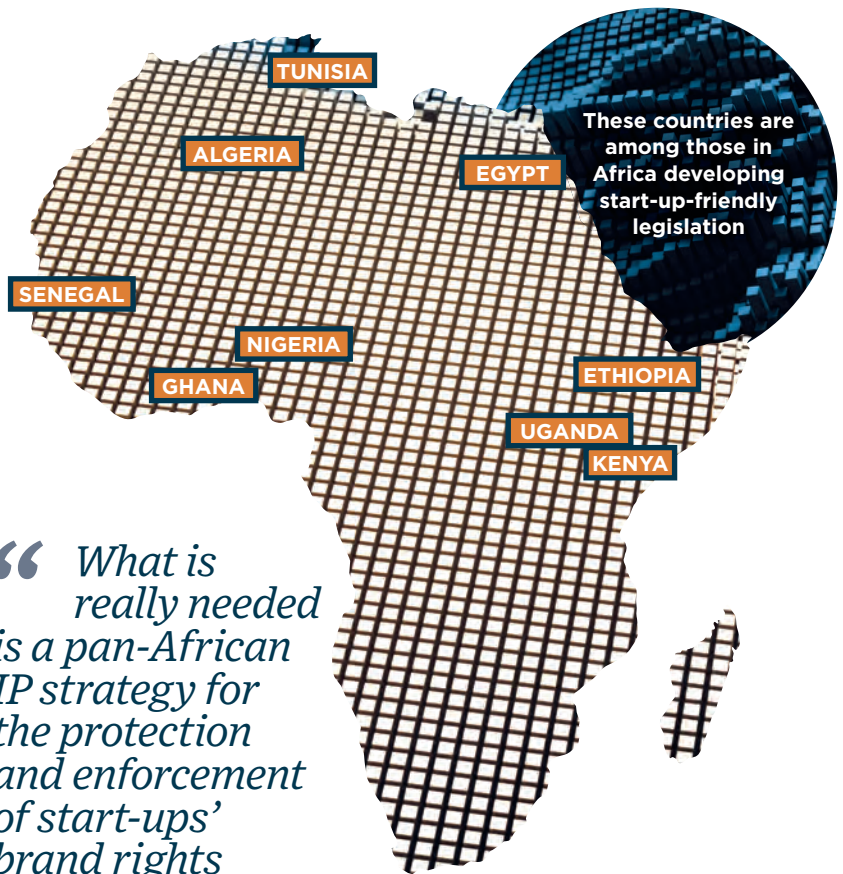
“ What is really needed is a pan-African IP strategy for the protection and enforcement of start-ups’ brand rights

those of competitors. As Oramah puts it: “I am pleased that I protected my AMAKA name when I did and feel like I am covered on all fronts, particularly when it comes to proving to VCs that AMAKA is an investable brand.” She adds that financial accessibility will always be a challenge and a barrier to fully protecting her brand in African countries, but takes comfort in the fact that legislation is making the environment more hospitable to start-ups like hers. This, in turn, should give Africa-based start-ups or those based in the diaspora some added confidence that legislation is catching up with the boom in tech start-ups, albeit at a slower pace than desired.

When it comes to trade marks, of course, brand protection in South

Africa will not suffice for Nigeria, Egypt nor Kenya. Because many tech start-ups hope to expand across Africa (especially fintech companies), what is really needed is a pan-African IP strategy for the protection and enforcement of their brand rights.

Here, there is also hope, at least for the optimists among us. Perhaps the Intellectual Property Rights Protocol of the African Continental Free Trade Area Agreement will unite the trade interests in Africa and provide a stronger and less expensive brand protection structure than the current regimes. Practitioners should keep an eye on the development and effects of this agreement. However, until it fully matures, tech and digital start-ups that are investing in African countries will have to make the most of the available mechanisms. ●



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IN DEFENCE OF THE IPEC

Aaron Wood explains why he believes the streamlined system is working as intended

Is change needed in the IPEC? This is certainly the view of some in the profession, as an article in issue 472 of the *CITMA Review* explored. Yet, based on my own practice, I have formed a different view. For example, on the subject of “misuse”, it is my experience that such abuse is rare.

Central to the earlier article was the concern that IPEC cases are being run as if they were “High Court” litigation. But because the IPEC is a division of the High Court, IPEC cases are High Court litigation by definition. The IPEC is able to hear all levels and types of IP cases – and to provide access to justice to those who otherwise would be shut out – subject to the limits of the

jurisdiction (key among them the three-day maximum trial length).

If we consider *Shazam Productions v Only Fools*,¹ it has been suggested this represents an abuse by the Claimant because this complex case could only be made to fit the IPEC’s timetable thanks to a scope-cutting order by His Honour Judge Hacon at the case management stage. I would like to observe that the case began in the High Court and was ordered to be transferred to the IPEC by Master Teverson. He was persuaded that the Defendants could only afford to defend the claim in the IPEC. As a result, it seems to follow naturally that the case needed careful management to fit the IPEC’s time constraints.

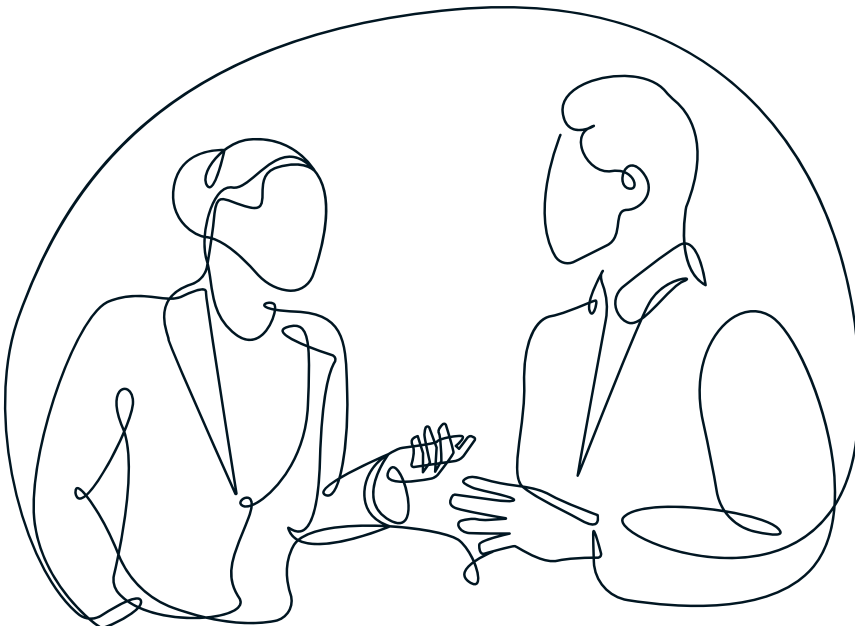
In fact, a Claimant may plead a case as a “High Court” case only to

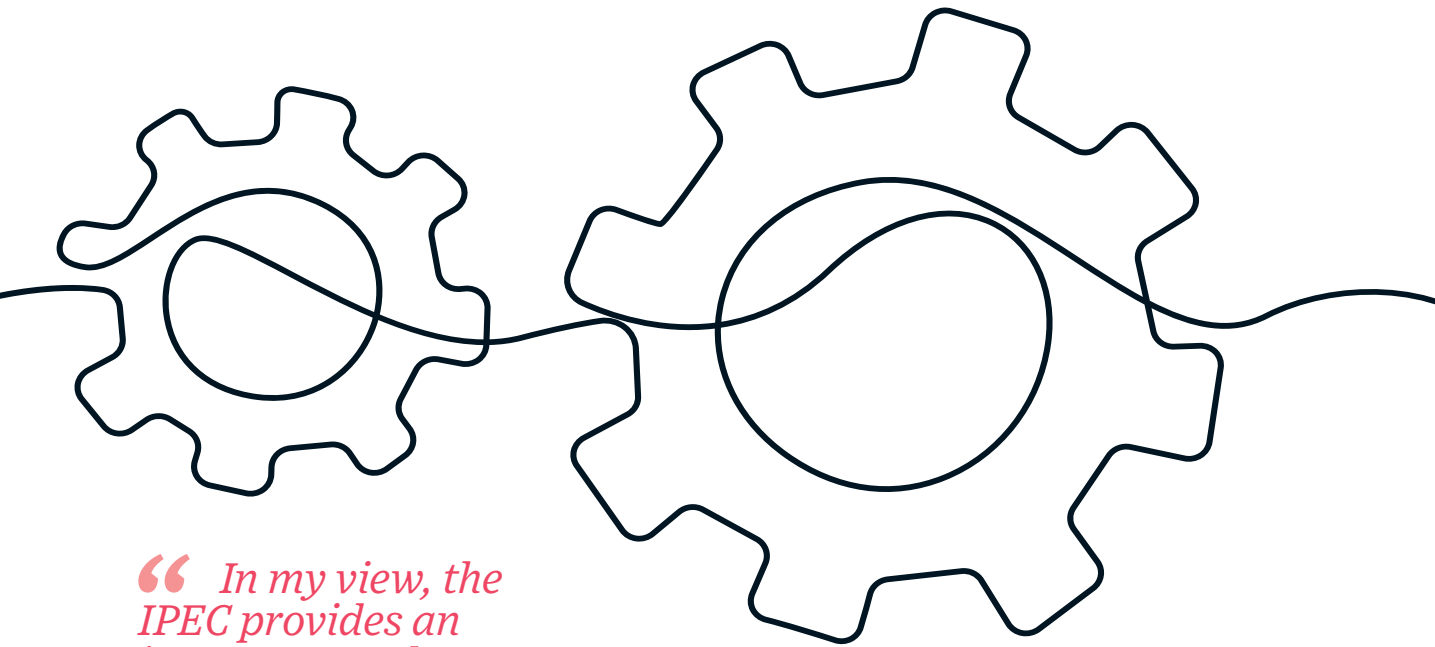
find that it becomes an IPEC case and has to be streamlined. This doesn’t, to my thinking, qualify as abuse, but rather as the system working as it should. The Claimant pleaded a complex case involving (it alleged) infringement of many rights, and the Defendants availed themselves of the financial protection of the IPEC. The IPEC judge used his prowess to make the case work to the limits of the jurisdiction by requiring exemplars. Rather than exposing a weakness, I believe this is a great example of the strength of the IPEC regime.

The use of exemplars is an approach also used in copyright and design cases in the High Court to limit their burden on it, such as in *Neptune (Europe) Ltd v Devol Kitchens Ltd* (25th August 2017) and *Original Beauty Technology & Ors v G4K Fashion Ltd & Ors* (24th February 2021).^{2,3} Even if *Shazam* had stayed in the High Court proper, it is my view that it would have been subject to the same streamlining seen in the IPEC.

“Excessive” statements of case in the IPEC have also been raised as a cause of concern. Here, I would point out that because the IPEC permits a case to be amended post-case management conference (CMC) only on exceptional grounds, a party has to ensure it is not exposed by the failure to plead its case properly.

Cases where it seems that a claimant has exaggerated its financial claim or has pursued the case in a particularly egregious manner (meaning that a defendant is likely to be excessively burdened with irrecoverable costs) are by my tally rare. The case of *Philip Warren & Son Ltd v Lidl Great Britain Ltd & Ors (Ch)* (26th August 2021) provides a telling example, and the judge addressed the risks that result when litigation funders and damage-based assessments are involved.⁴





“ In my view, the IPEC provides an important path to justice, and its judges are careful to ensure things work effectively

As to whether an improvement to the IPEC procedure would come from resolving the CMC on the papers to reduce the cost of that step, my opinion is that the Court was right to reject the suggestion. The CMC is the key cut-off in the IPEC, and the list of issues – formed from comparison of the statements of case – is the vital document that regulates all other case management decisions. Poorly drafted statements of case lead to a case becoming bloated in the later stages by way of a poor list of issues.

My experience of the costs of proceedings is that, while the statements of case can exceed the IPEC cap a little, and the CMC often exceeds it by a few thousand pounds, it is in the steps that follow the CMC (disclosure, witness statements and trial) where the greatest discrepancy between the cap and the actual expenditure occurs. The adage “measure twice, cut once” is relevant here. If suitable focus is applied to the case up to and including the CMC stage, then costs thereafter are often more appropriately incurred.

Where extra work can arise is where a claim or defence is unclear (leading to a request for further information) or where a party makes unreasonable denials (leading to further applications). This is often

not abusive, and less still a failure in the system.

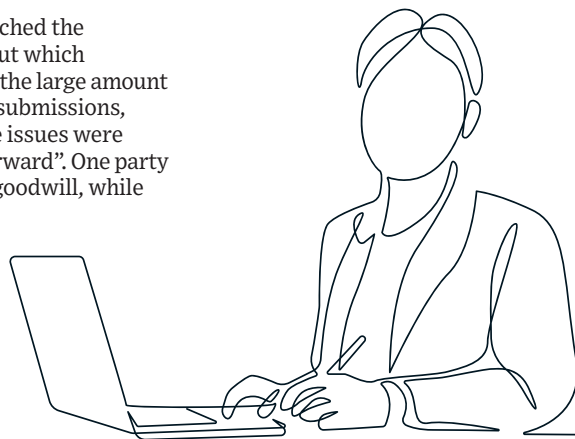
Often, issues in terms of timing and complexity in the IPEC arise where the parties agree in their draft CMC order that there should be all of the “bells and whistles”. A judge at the CMC stage is liable to conclude that, if both sides say something is essential, then it most likely is (the two sides having the greatest understanding of the case); they know what evidence will be marshalled as a result of the steps they propose, and they know what the cost of the exercise will be. The judge assumes that the parties understand the time constraints and recoverability.

Finally, having watched the Muzmatch case,⁵ about which Mr Caddick KC noted the large amount of documentation in submissions, I can confirm that the issues were “simple or straightforward”. One party asserted repute and goodwill, while the other asserted the widespread use of the term MATCH. In my view, voluminous evidence used to make good a point does not mean that a point is complex,

but rather is an attempt to ensure the other side cannot suggest the evidence is insufficient. Such a large volume of evidence can be dealt with by way of exemplars, schedules to assist the Court and (if necessary) additional written closings.

In my view, the IPEC provides an important path to justice, and its judges are careful to ensure things work effectively. It is working, save for the occasional bad actor. ●

1. [2022] EWHC 1379 (IPEC)
2. [2017] EWHC 2172 (Pat)
3. [2021] EWHC 294 (Ch)
4. [2021] EWHC 2372
5. Match Group LLC v Muzmatch Ltd [2022] EWHC 941 (IPEC)



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WORKING WITH WIPO

Oscar Benito shares CITMA's priorities for improvement

For global, interconnected economies, WIPO is undoubtedly a great IP ally. Indeed, its Director General, Daren Tang, has started to lay out his vision of transforming WIPO into a user-centric organisation, rather than an agency-centric one. During CITMA's visit to Geneva earlier this year, Tang thanked the Institute for its proactive and constructive engagement with WIPO. Admittedly, many things can still be improved, and CITMA's proposals to make the Madrid system more user-friendly were captured in the 2017 UK Position Paper. However, CITMA is committed to work with WIPO, the UK IPO and all members of the Madrid union to make these proposals a reality.

There are two particular areas of improvement that CITMA feels could be transformational: getting dated deadlines on provisional refusals of protection; and procuring meaningful statements of grant of protection from all countries.

DATED DEADLINES

The time limits to respond to provisional refusals vary greatly between contracting parties: from 15 days to 15 months. Users of the system continue to find it difficult to ascertain or calculate the actual response date relating to the provisional refusal, and

often the information provided in the guidance documents does not match the advice from local attorneys in most countries. This is obviously an area of huge concern to users. Specific proposals to deliver dated deadlines are expected to be discussed at the Working Group meeting taking place by the end of 2023. Meanwhile, the importance for users of this potential change cannot be underestimated.

SECURING STATEMENTS

Users always expect to receive positive acknowledgement that a "right" has been granted and, ultimately, an official document that embodies said right. The obligation that all countries should issue statements of grant of protection was a massive improvement to the Madrid system. The old "no news is good news" approach was certainly not an acceptable way to manage trade mark portfolios. However, some countries are not yet issuing statements of grant of protection, and some countries merely issue a list of registration numbers. Also, enforcement authorities in

many countries are not accepting statements of grant of protection or WIPO extracts, meaning national certificates are then required.

These difficulties undermine trust in the Madrid system. As a potential solution, CITMA is working with WIPO on a pilot "certificate" that could potentially include the WIPO logo and the logo of the IPO of the designated country. Please let us know if you have any suggestions on the format.

Other topics that CITMA's WIPO Liaison Committee is focusing on include creating classification guidelines on NFTs and addressing the lack of implementation of the Madrid Protocol in some African countries (mainly Eswatini, Lesotho, Sierra Leone and Zambia). On a domestic level, CITMA is following with hope the UK IPO's test to set up an e-filing system for new international registrations. We are also looking into the root cause for the increased irregularity rates for applications from the UK (38% in 2020 to 42% in 2021) with the goal of sharing tips and learning with users. Stay tuned! ●



Oscar Benito

is a member of the CITMA Council and leads its WIPO Liaison Committee



MAX-IMPACT PRESENTING

Bernard Savage sets out how to make every conversation a conversion

Human beings are emotional animals. And when it comes to talks, pitches and presentations, presenting logical arguments alone will not always effect the desired change you are looking for. If you want to influence your audience, there are five key things to remember.

1. Emotion first, logic second

Whether your audience is made up of business owners, IP practitioners, investors or in-house counsel, they have one thing in common – they are all humans. This means that you need to find an emotional connection with them at the start of any communication, whatever the channel or format. You can do this by:

- building rapport through open and warm body language, eg, smiling and making eye contact;
- finding common ground (personal or professional); and
- using stories to make your content more interesting, personable and memorable.

2. The presenter is remembered long after the content

Research indicates that people are easily distracted when listening to talks. Regrettably, much of what you say will be forgotten by your audience. What is less likely to be forgotten is the presenter. You can

use this insight to your advantage by focusing your energy on making your audience like you. Warmth, openness, and friendliness are key here. By appearing comfortable in your own skin, you will better connect with listeners and they are more likely to connect with you.

3. Make what you say “sticky”

The nature of IP is that your content will not necessarily be received at the best time – for example, at the moment when your listener is selecting an IP adviser, planning a business sale or engaging with an investor. This means that you need to have a lasting impact on client conversations so that you are remembered when trade marks, design, image rights, brand protection and/or copyright are eventually discussed. Marketing experts call this making your content “sticky”.

4. It's not about you

It's about your audience. To influence your audience, start by finding out what their issues and goals are. Framing your content

in line with what is important to them means you are more likely to be listened to attentively and successful in selling your idea. In planning any talk, understand that your audience's motivators are based on: financial goals (eg, increasing the value of a business on its sale); making things easy (eg, saving time, energy and aggro); and a feeling of safety (eg, ensuring that their ideas are protected from competition).

5. Always close with a call to action

Even good presenters too often forget to tell their audience exactly what they want them to do next. When wrapping up a talk, pitch or presentation, set out clear and easy next steps. You might want to: suggest connecting on LinkedIn; agree a date/time for a follow-up meeting; ask for a business card; create a sense of urgency and/or scarcity by presenting a deadline for the next step; or discuss the opportunity for a small commitment (perhaps a pilot scheme). ●



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Colour clash continues

Charlie Bond reports on the latest decision in the confectionery wars



This case is an appeal and arose from a now-settled opposition raised by Nestlé against various trade mark applications for Cadbury's signature colour purple.

BACKGROUND



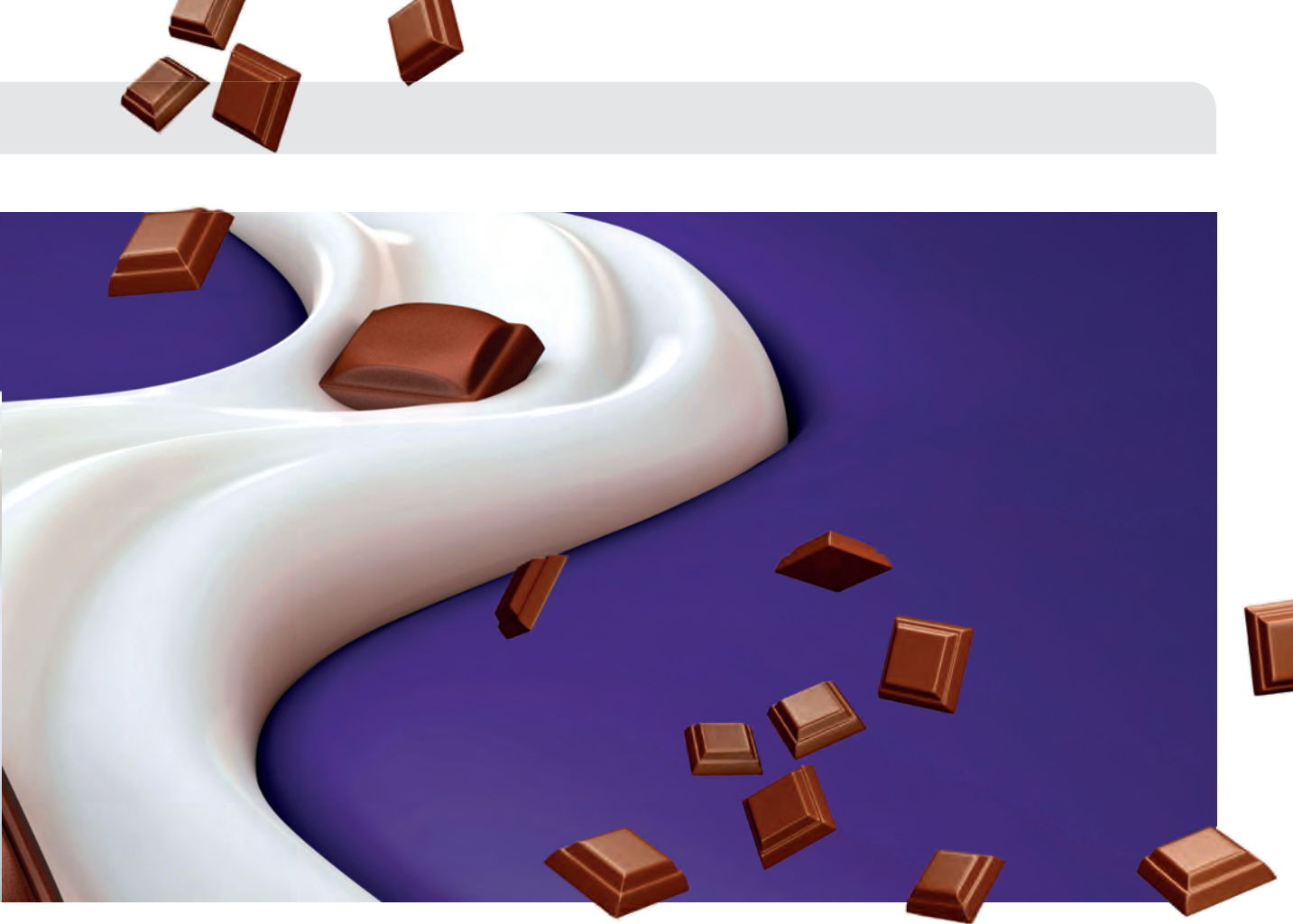
The opposition was first heard by Hearing Office Louise White (the HO) on 12th April 2019, when two of Cadbury's three marks were deemed invalid:

1. Application No. 3 019 361: The colour purple (Pantone 2685C), as shown on the form of application, applied to the packaging of goods (the First Mark). The HO upheld the opposition against the First Mark and deemed it invalid.
2. Application No. 3 025 822: The colour

purple (Pantone 2685C), shown on the form of application (the Second Mark). The HO upheld the opposition against the Second Mark and deemed it invalid.

3. Application No. 3 019 362: The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface of the packaging of the goods (the Third Mark). The HO rejected the opposition against the Third Mark and deemed it valid.

Despite the opposition being settled soon after this decision, the Comptroller-General of Patents, Designs and Trade Marks sought to intervene and continue the appeal in order to create some certainty in an area that has otherwise been quite opaque. This decision



to continue to appeal was approved by Mr Justice Meade within his judgment.

CASE LAW

In his judgment, Meade J applied the principles derived from the case law on registration of colour marks – notably the reasoning of the Court of Justice of the European Union (CJEU) in *Libertel* and the Court of Appeal (CA) in a previous skirmish between Nestlé and Cadbury.^{1,2}

In *Libertel*, the CJEU decided that “a colour per se, not spatially delimited, may ... have a distinctive character ... provided that ... it may be represented graphically in a way that is clear, precise, self-contained, easily accessible, intelligible, durable and objective”. The CJEU indicated that a colour mark could therefore be sufficiently clear and precise by referencing an internationally recognised code such as Pantone or RAL within a registration.

In *Nestlé v Cadbury*, Cadbury had again applied for the registration of the colour purple as a trade mark. The application included a Pantone number and the description “applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods”. This application was rejected by the CA because use of the word

“ *The Comptroller-General of Trade Marks sought to intervene and continue the appeal to create some certainty in an area that has otherwise been quite opaque* ”

“predominant” created multiple, different visual forms and led to the implication that other colours may be used that were not disclosed in the application. Per *Libertel*, the mark therefore lacked the necessary clarity to constitute a sign and so the application failed.

DECISION

In this case, the specific questions which Meade J had to assess were as follows:

1. By referring to the degree of application to the packaging, does the First Mark avoid the problem of ambiguity that the CA identified as having afflicted the mark in *Nestlé v Cadbury*?
2. By using a Pantone designation without reference to the manner of use, is the Second Mark capable of being a sign, or does it also fall foul of having issues with ambiguity as identified in *Nestlé v Cadbury*?

Assessing the two colour mark applications that were at the core of the dispute, Meade J concluded as follows.

The First Mark, which was described as having been “applied to the packaging of the goods”, was invalid as it did not fulfil the requirements of a sign under s1(1) of the Trade Marks Act 1994 (TMA). Meade J agreed with the previous decision of the HO and asserted the description was “significantly, undesirably and unnecessarily unclear whether combination marks including purple and other colours would be within the scope of the right applied for”. It therefore was not capable of being a sign and registered as a trade mark.

The Second Mark, which made no reference to the packaging of the goods at all, was, in contrast, valid as it did fulfil the requirements of a sign. Meade J overturned the previous decision of the HO in stating that the mark was valid. He affirmed that conceptually this was because the mark boiled down to one single thing: the colour purple. This meant that the

internationally recognised code such as Pantone or RAL (as advised in *Libertel*), it is still possible for a colour mark not to meet the required standards set out in s1 TMA and therefore to be deemed unregistrable.

Indeed, as illustrated in Meade J’s decision, a simpler mark with a sole reference to the colour and code could be more likely to succeed in being registered due to its simple and one-dimensional nature. That said, this decision is silent on s3(1)(b) TMA, and therefore colour mark applicants may wish to be mindful of ensuring that, in addition to their marks being clear and precise, they also have a sufficiently distinctive character (or that the mark has acquired such a character through use – something that is very difficult to show with colour marks).

Within the judgment, Meade J also stressed that this case was not intended to give any categorical view on the infringement of colour marks and only refers to the registrability of such marks. By overturning the HO and allowing the registration of the Second Mark, which does not make any reference to the application of the colour, Meade J appears to have given Cadbury a trade mark with broad scope to be enforced.

KEY POINTS

- ✦ A single colour can be registered and function as a mark
- ✦ To meet the threshold of registrability, a mark must be capable of clear and precise representation; reference to internationally recognised codes is not alone sufficient to ensure a mark can be registered successfully
- ✦ Simple and clear marks with less potential for misinterpretation have a greater likelihood of becoming registered

“ *This case has affirmed the reasoning underpinning Libertel – a single colour can be registered and function as a mark* ”

registration was unaffected by the central problems that plagued the invalid First Mark, concerning how the colour was then applied to the packaging.

Although not subject to the appeal, Meade J further commented that the Third Mark (“applied to the whole visible surface of the packaging of the goods”) was also capable of registrability in his view (in agreement with the decision of the HO). Unlike the First Mark, the Third Mark clearly stated how the colour would be applied to the packaging, thereby ensuring the mark was not ambiguous.

IMPACT

This case has affirmed the reasoning underpinning the *Libertel* decision – a single colour can be registered and function as a mark. What appears to remain the downfall of registering colour marks is then meeting the criteria set out in s1 TMA – ensuring that they are capable of clear and precise representation to the extent that another’s goods can be distinguished.

Going forward, therefore, those who wish to register colour marks will need to ensure that the description provided is sufficiently clear and precise. Even with reference to an

QUESTIONS ARISING

Two key questions arise from this outcome. First, how will the mark be interpreted when being enforced against, for example, a potential infringer using the relevant shade of purple only partially on packaging or as part of a logo? Does the lack of any limiting language in the mark description mean any use of the colour is infringing?

Second, might the mark be vulnerable to a non-use validity attack in the future if Cadbury’s packaging uses the purple colour only in conjunction with other marks or branding? Is it then not being used in the form in which it is registered? We will have to wait for the next battle in the confectionery wars to find out...

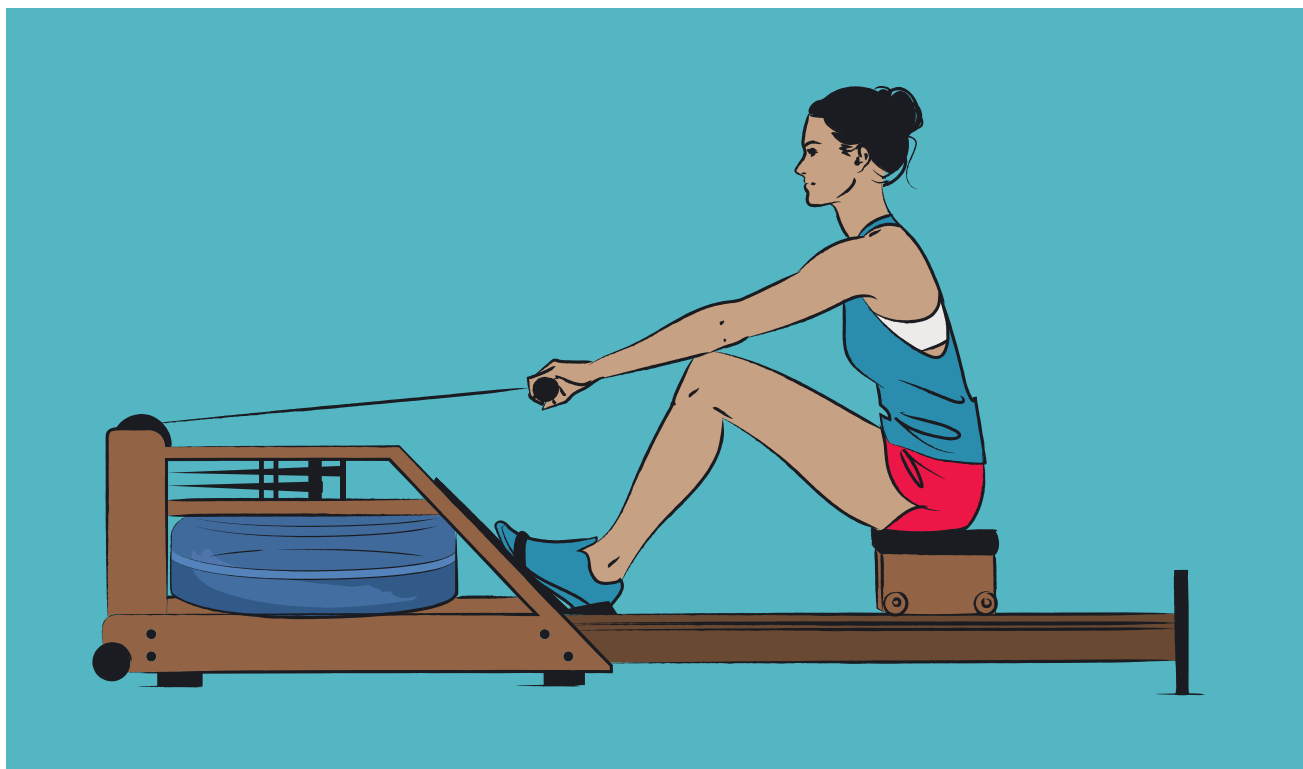
1. *Libertel Groep BV v Benelux-Merkenbureau* Case C-104/01
 2. *Nestlé v Cadbury UK Ltd* [2013] EWCA Civ 1174



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Watershed moment

Ramsay Monime believes this is an important case for 3D works

Can a functional piece of exercise equipment be protected by copyright law as a work of artistic craftsmanship? Quite possibly, said the IPEC.

The piece of exercise equipment in question is the well-known WaterRower rowing machine (the first version is shown on page 31). The machine was designed between 1985 and 1987 by Mr Duke.

Liking Ltd (Liking) was selling a replica of the WaterRower. As a result, WaterRower (UK) Ltd brought copyright infringement proceedings in the IPEC. It argued that the WaterRower is protected by copyright as a work of artistic craftsmanship.

Liking applied to strike out the WaterRower (UK) Ltd claim. Liking argued this on the basis that: (i) the WaterRower was not a work of artistic craftsmanship as it was not protected as such under any of the five tests in the House of Lords decision in *George Hensher Ltd v*

Restawile Upholstery (Lancs) Ltd (Hensher);¹ and (ii) the WaterRower was not protected by copyright under the European Court of Justice's test in *Cofemel/Brompton*,^{2,3} which meant that any inconsistency between UK and EU copyright law did not need to be resolved in this decision.

ARTISTIC CRAFTSMANSHIP

The Judge rejected Liking's first argument that, under *Hensher*, there was no real prospect of proving the WaterRower was artistic. His reasons were:

1. Artistic purpose: Liking argued that the author's primary purpose in creating the work had to be artistic. The Judge's view of ▶

“ *The Hensher decision has often been perceived as a bar to copyright protection for 3D works* ”

this is of note. Namely, he disagreed and said that artistic purpose only had to be one of the creator's purposes. As Mr Duke had an artistic purpose (he wanted to create a water rower that invoked a Shaker design), there was no issue.

2. Something more: Liking conceded that the WaterRower had "eye appeal" but that "more" was required under Hensher to qualify as "artistic". The Judge acknowledged that while some of the Lords in Hensher clearly required "more" than eye appeal, none specified what this was. The Judge thought "more" could be the intention of the author (which was satisfied, see 1 above) or recognition by others that the work was artistic, which was also satisfied based on the evidence adduced by WaterRower (UK) Ltd.

WaterRower (UK) Ltd had adduced evidence that the WaterRower could be purchased in the Museum of Modern Art (MoMA) shop and its design had been acknowledged in an article in *Galerie* magazine. The Judge commented that this type of evidence is probative in two ways. First, for what it says: the article in *Galerie* described the WaterRower as being "masterfully crafted". Second, the presence of the WaterRower in the MoMA shop indicated that "the curators of the MOMA

shop consider it worthy of inclusion – that is, they recognise that it belongs alongside the other artistic works celebrated and sold by the MOMA".

3. Not less artistic than the Hensher examples: Lord Simon (one of the Law Lords in Hensher) set out a series of examples of works that he considered to be artistic. These included: hand-painted tiles, stained-glass windows, wrought iron and some of the work of carpenters, cabinet-makers, printers, bookbinders, cutlers, needleworkers and weavers. The Judge compared these works to the WaterRower and found that he could not conclude on a strike-out basis that the "WaterRower is any less artistic in its conception or appearance".

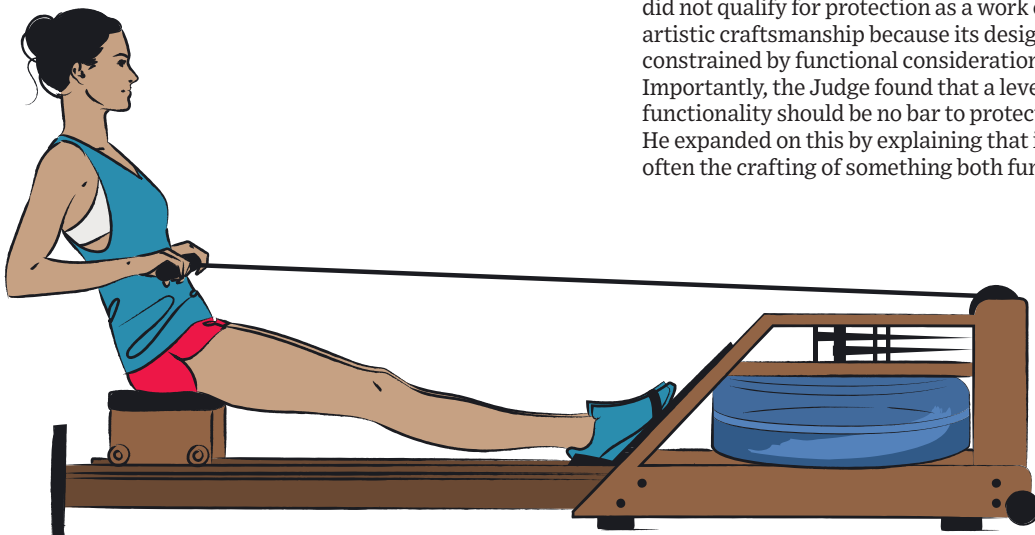
The Judge then rejected Liking's argument that there was no prospect of finding the WaterRower was a work of "craftsmanship". On this issue, he noted that Hensher was not a decision about craftsmanship, because this point had been conceded and therefore any comments in that decision were "strictly *obiter*".

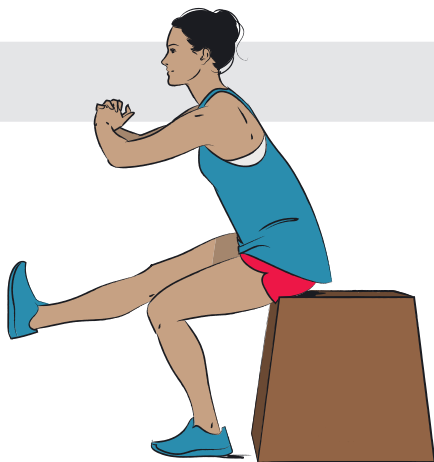
Then the Judge considered the test applied by Justice Mann in *Lucasfilm*⁴ – namely, whether the creator can be considered a craftsman on the basis of: (i) producing high-quality products; (ii) having a justifiable pride in his work; and (iii) not being a slavish copier or jobbing tradesman.

Applying this test to the WaterRower, the Judge found that it was arguable the WaterRower was a work of craftsmanship. He was particularly influenced by the fact Mr Duke had studied naval architecture and had built rowing shells, parts of which are found in rowing machines.

Liking also argued that the WaterRower did not qualify for protection as a work of artistic craftsmanship because its design was constrained by functional considerations. Importantly, the Judge found that a level of functionality should be no bar to protection. He expanded on this by explaining that it is often the crafting of something both functional

“ In this decision, the Deputy High Court Judge has effectively applied a modern approach to the House of Lords' analysis





and artistic that makes a work one of artistic craftsmanship, as had been argued by WaterRower (UK) Ltd in this case. Thus, this argument was dismissed.

COFEMEL/BROMPTON

The Judge considered if there was a real prospect that the WaterRower would be protected by copyright under the Cofemel/Brompton test. There are two cumulative requirements under this test. First, there must be the existence of an original object. Second, there must be the expression of intellectual creation.

The Judge found there was a reasonable prospect of the WaterRower meeting both requirements. He then had to consider Liking's argument that technical and other constraints deprived the WaterRower of originality.

The Judge further found that, although there were certain constraints (eg, the requirement of runners and a seat) on the features, that still left room for creative freedom and thus did not deprive the WaterRower of originality. He was particularly influenced here by images of other water rowers that were in evidence. They demonstrated that there are a number of ways to present the features and thus exercise free creative choices. In respect of the WaterRower, the use of wood, the choice of wood type, the shape and dimension of its features and the size of the body of water were all listed as creative choices.

MODERN APPROACH

Despite this only being an interim decision, it is important. The Hensher decision has often been perceived as a bar to copyright protection for three-dimensional (3D) works. Yet, in this decision, the Deputy High Court Judge has effectively applied a modern approach to the House of Lords' analysis, which arguably broadens what is protected. Examples of this modern approach are peppered throughout the decision. Particularly of note are the Judge's comments that: the primary purpose of the creator does not need to be artistic; that an item offered for sale in the gift shop of a museum effectively signals the design of the work is

“ A piece of everyday gym equipment is not necessarily less artistic than a stained-glass window

revered by the museum; that a piece of everyday gym equipment is not necessarily less artistic than a stained-glass window; and that a level of functionality should not be a bar to protection.

It is also fair to say that this decision, taken with Response Clothing,⁵ represents a policy shift to make it easier to protect 3D works by copyright. Although the repeal of s52 of the Copyright, Designs and Patents Act 1988 was meant to open up protection for such objects, there was still uncertainty about protection because of Hensher. The English Courts, in two decisions from two different judges, have now not ruled out copyright protection for works that would not traditionally be seen to be afforded protection.

What is more, the English Courts have done so in these decisions on the basis that either Hensher is not binding⁶ or the Hensher criteria are not as rigid as originally perceived. This should send a signal to the creative industries that copyright protection is potentially available for 3D designs and less conventional works.

Although the judges in both Response Clothing and this decision declined to deal with the apparent inconsistencies between UK law (with its closed list of works eligible for copyright protection) and EU law following Cofemel (only requiring originality and fixation), the result of both decisions seems to indicate that UK law is moving in the same direction as EU law (albeit by deploying different tests) in recognising copyright protection for works traditionally not associated with such protection.

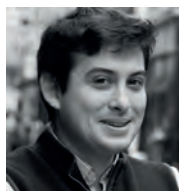
KEY POINTS

- ✦ In bringing a copyright claim for a 3D work, consider issuing in the IPEC as both Response Clothing and WaterRower are IPEC decisions
- ✦ In such claims, collate evidence to support the “artistic” element of the work, which does not need to be the main purpose of it, and the craftsmanship element
- ✦ Assess the level of functionality of the product and consider whether the decorative elements elevate it into something artistic

WATERROWER, FIRST ITERATION



1. [1976] AC 64
2. Cofemel - Sociedade de Vestuário SA v G-Star Raw CV, Case C-683/17, [2020] ECDR 9
3. SI and another v Chedech/Get2Get (Brompton), Case C-833/18, [2020] Bus LR 1619
4. Lucasfilm Ltd & Ors v Ainsworth & Anor [2008] EWHC 1878 (Ch)
5. Response Clothing Ltd v The Edinburgh Woollen Mill Ltd (Rev 1) [2020] EWHC 148 (IPEC)
6. *Ibid*, para 54



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Samsonite is shut out

Adeena Hussain spells out why it failed to bag a 3D registration

The EUIPO Board of Appeal (BoA) here held that the 3D shape mark of Samsonite's tablet case was devoid of any distinctive character because it didn't depart sufficiently from the norms and customs of the relevant sector. It also held that the essential characteristics of the mark, being the "arms" and "legs" of the tablet case, were purely functional and so weren't capable of indicating origin.

BACKGROUND

Samsonite applied to register the 3D shape mark shown on page 33 for goods in class 9, broadly summarised as covers, cases and stands for computers, laptops and tablets.

The EUIPO initially refused the application for registration on the grounds of lack of distinctive character, as per Article 7(1)(b), Regulation (EU) 2017/1001 (EUTMR), because the mark did not depart significantly from the norms and customs of the relevant sector.

Samsonite maintained its request for registration of its mark and tried to argue that, as its mark had a quirky design resembling a cartoon figure, it stood out from other products of a similar type and that this quality acted as a badge of origin. Samsonite also submitted evidence to argue that its shape mark had acquired distinctive character through use.

Following back and forth correspondence between Samsonite and the Examiner, the application was refused again on the grounds of Article 7(1)(b), and additionally on the grounds that the essential characteristics of the mark were functional. This meant that the shape mark as a whole was necessary to obtain a technical result (Articles 7(1)(e)(i) and 7(2) EUTMR). Samsonite appealed the EUIPO's decision with the BoA.

SAMSONITE'S ARGUMENTS

Samsonite attempted to argue that children would see the shape of the 3D mark as a "mini friend" or "companion". However, it was clear that there are a variety of shapes for tablet cases



already on the market, with decorative elements such as faces, eyes and hands, that may also be perceived as “mini friends”.

In particular, the BoA highlighted two products (shown below right) as “quirky” and “eccentric” designs that represent a cartoon figure, similarly to Samsonite’s mark. Since there exists such a wide variety of shapes related to electronic device cases on the market for children, consumers would be used to seeing these types of products and would see Samsonite’s mark as simply a variant of these many shapes.

The BoA also pointed to the fact that there are numerous Registered Community Designs (RCDs) for tablet cases incorporating eccentric features that represent cartoon figures, such as handles meant to indicate arms and legs, and facial features. The online search results that provided the marketplace examples, and the earlier RCDs, confirmed that Samsonite’s shape mark did not depart significantly from the norm or customs of the sector.

It was confirmed that the handles in Samsonite’s mark that represented arms and legs were purely functional in nature and purpose, to allow children to hold the device in the case by the “arms” or to allow the case to stand freely on its “legs”. These functional elements were therefore incapable of conferring

“ *The outcome backs up the contention that it is notoriously difficult to protect unconventional trade marks at the EUIPO* ”

distinctiveness on the mark, as they wouldn’t be seen as an indicator of commercial origin.

TYPICAL FEATURES

The mark was held to possess a combination of features of a case for an electronic device, namely a rectangular opening for the screen, lateral handles and supports to allow it to be free-standing. These elements didn’t depart significantly from the features that are typical for these kinds of goods, so consumers would only see the mark as coming from the diversity of the relevant market and not as an indication of origin itself. The overall impression of the mark was not sufficiently different from that produced by other shapes in the market for the minimum degree of distinctive character required.

Samsonite had also failed to prove sufficiently that the 3D shape mark possessed acquired distinctive character through use, as the evidence that was submitted did not meet the relevant criteria. Because the BoA dismissed the appeal on the grounds of lack of distinctive character, it didn’t go on to consider the grounds under Articles 7(1)(e)(ii) and 7(2) EUTMR.

The outcome here backs up the contention that it is notoriously difficult to protect unconventional trade marks at the EUIPO, whether they be 3D shape marks, sound marks or even motion marks. When it comes to these types of mark, it could be worth considering alternative or supplementary means of protection in addition to trade mark registrations, such as registered design protection. It is also important to always review evidence of acquired distinctiveness carefully, taking note of the EUIPO’s guidelines on the content and type of evidence that will be considered sufficient.

KEY POINTS

- + Functional elements were determined to be incapable of conferring distinctiveness on the mark, as they would not be seen as an indicator of commercial origin
- + Samsonite failed to sufficiently prove that its 3D shape mark possessed acquired distinctive character through use
- + The outcome here backs up the contention that it is notoriously difficult to protect unconventional trade marks at the EUIPO; considering alternative protection is suggested

MARKS

THE SAMSONITE 3D MARK



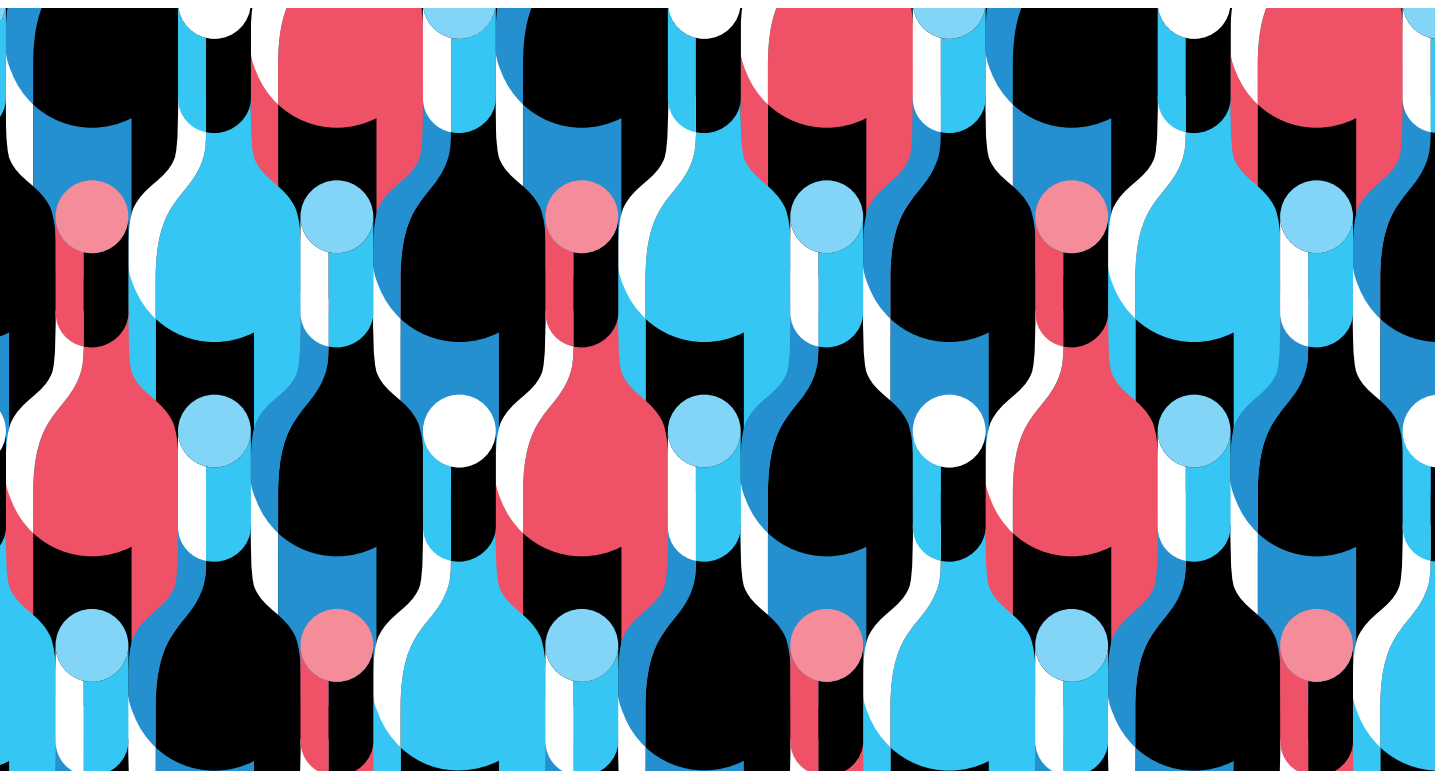
HIGHLIGHTED PRODUCTS



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Absolut case shapes up

Adding features can lend a shape inherent distinctiveness, as Désirée Fields explains

The EUIPO's Board of Appeal (BoA) overturned a decision of the Examination Division, which rejected an EU trade mark (EUTM) application for the shape of a vodka bottle. The BoA was satisfied that the mark applied for, taken as a whole, departed sufficiently from the customs or norms of the sector concerned to be found distinctive and capable of designating origin.

BACKGROUND

In September 2019, The Absolut Company Aktiebolag (TAC) filed a three-dimensional EUTM application for a vodka bottle (shown on page 35), consisting of a tall, rectangular, transparent bottle with copper-coloured panels, a square-shaped bottom, a conical bottle shoulder and a maze-like surface structure. The mark also featured a short neck with a copper-coloured wrapper and copper-coloured front label.

The EUIPO's Examination Division rejected the application under Article 7(1)(b) of Regulation (EU) 2017/1001 (EUTMR), finding that it lacked distinctive character and that the elements of the mark applied for were "not outstanding or eye-catching as to create an overall impression, which would depart significantly from the customs or norm on the corresponding market". TAC argued that the mark had distinctive character in the relevant market sector and supported this with evidence regarding the alcoholic beverage market and the vodka market specifically. Nonetheless, the Examiner rejected the application, finding that the average consumer would perceive the packaging as a mere variation of a container. TAC appealed the decision to the BoA.

MEMORABLE COMBINATION

TAC argued that just because the sector is characterised by a variety of product shapes, surface patterns and colours did not mean that its mark would be perceived as one of them. In the vodka market, there exist a number of distinctive containers that stand out from the crowd and do not merely serve the functional purpose of carrying vodka inside, but also prompt the public to recognise the commercial origin of the product. Here, TAC noted, a mark comparable to its own did not exist and the mark would be perceived by the relevant public as departing significantly from the norms and customs of the vodka sector, making the design elements peculiar to TAC and capable of indicating origin.

COMMON FEATURES

The BoA noted that the application was for a “shape mark” but that it was striking that the elements which had colour consisted of different shades and nuances, ranging from copper to brown or gold. This had to be taken into account in assessing absolute grounds. Where a sign consists of a combination of elements, each of which on its own is devoid of distinctive character, it is still possible for the combined sign to be distinctive, the sign being greater than the sum of its parts.

The BoA considered the six features that TAC identified as distinctive, namely:

- (i) the copper-coloured bottle closure;
- (ii) the rectangular body structure and other features (short neck, conical bottle shoulder, its general structure and proportions);
- (iii) the surface design, consisting of a very striking, crystal-like structure;
- (iv) the design of the back of the bottle being entirely copper-coloured;
- (v) a front label consisting of a prominent frame in an unusual copper colour; and
- (vi) copper-coloured neck foil (neck wrapper).

In relation to (ii), the BoA found that these were not distinctive and “did not stand out” from other products in the alcoholic drinks market. In relation to (iii), the BoA commented that this was “complex and

fanciful” but “not new, original, astonishing or outstanding”. These features were decorative, not easily recollected and did not indicate trade origin.

However, the BoA held that the latter three elements listed (which related to the copper colouring) would “not go unnoticed by consumers”. These elements were coloured in different shades or nuances, ranging from copper to brown to gold, and this colouring occupied a large part of the bottle.

The BoA noted the prominent white frame displaying different shades of the same colours on the front label of the bottle, and the copper-coloured foil wrapper around its neck. Unlike the body structure and surface decoration of the bottle, the colour elements of the mark departed significantly from the available forms and customs already on the market and had a “strong impact on the perception of the whole shape of the bottle”, enabling consumers to remember and recall the design of the back of the bottle.

Given its size and predominance, the BoA said the colour scheme would not be perceived by consumers as purely aesthetic decoration and would enable consumers to identify TAC as the producer of the goods. The BoA stressed that, while a single colour was not normally in itself distinctive, TAC’s bottle displayed various nuances of colour that covered a significant part of its shape. It concluded that the colour features of the mark performed a trade origin function and ruled that the overall representation of the combination of colour and bottle shape was registrable as an EUTM.

INSTRUCTIVE JUDGMENT

The judgment is instructive for businesses seeking to register product shapes and packaging, especially when launching a new product in a bottle or other packaging that has yet to acquire distinctiveness through use. Adding features to a shape, specifically elements of colour, could lend an otherwise arguably non-distinctive shape inherent distinctiveness. Further, although a single colour is normally not distinctive, where shades cover a significant and clearly defined part of the product, an application for a colour mark could be successful.

KEY POINTS

- ✦ Shapes are rarely found to be inherently distinctive
- ✦ Adding features to a shape, specifically elements of colour, can provide a perceived non-distinctive shape with the requisite level of inherent distinctiveness
- ✦ While single-colour marks are difficult to register, where shades and nuances of colour cover a significant and clearly defined part of the product, colour mark applications may be successful

MARK

THE EUTM APPLICATION

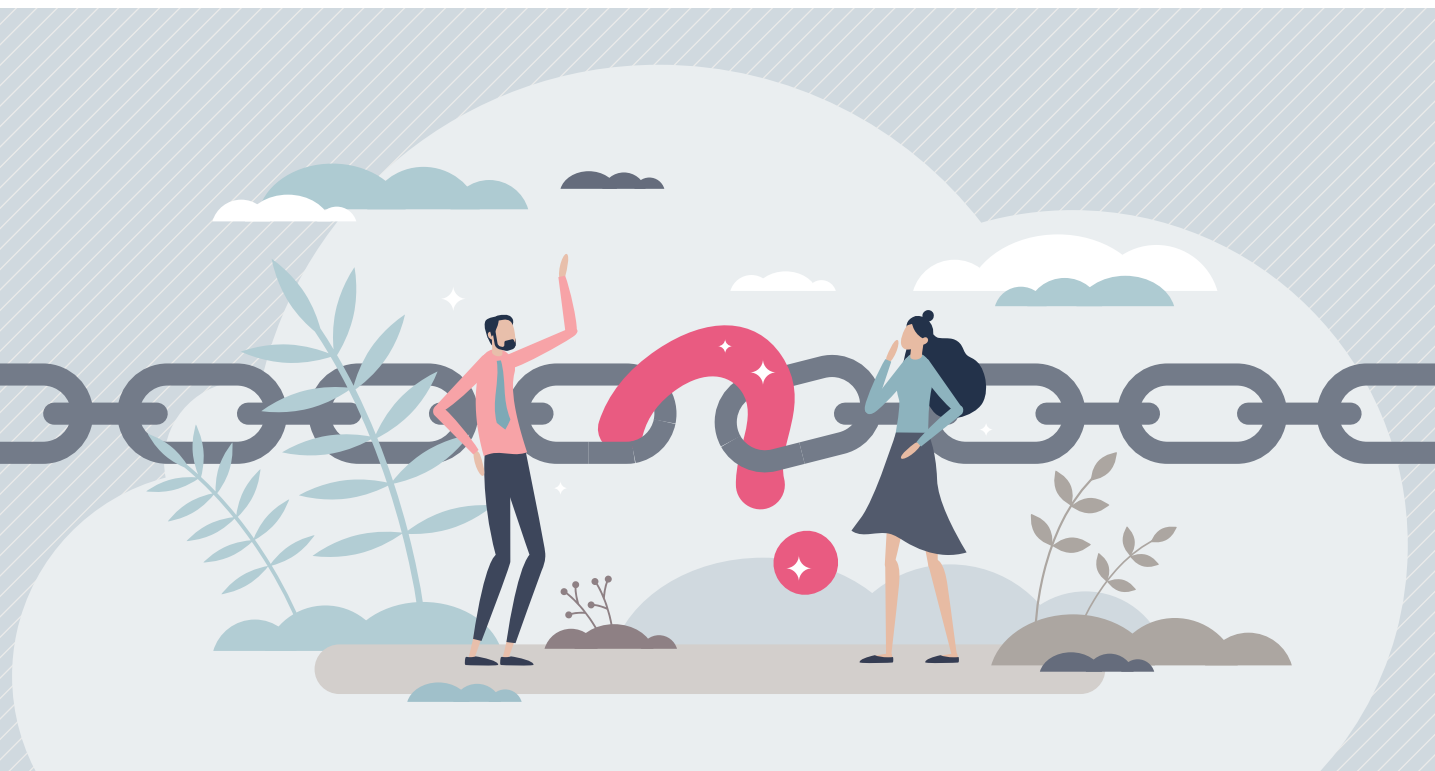


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The missing link

David Birchall considers the rejection of a reputation-based opposition

Procter and Gamble (P&G) opposed an application to register the stylised form of ALLWAYS (shown on page 37) as an EU trade mark (EUTM) for goods in classes 3 and 5 and the following class 35 services: “Business management; Advertising; Business management of wholesale outlets; Business management of retail outlets; Business management of wholesale and retail outlets”.

The opposition was filed under Articles 8(1)(b) and 8(5) of Regulation (EU) 2017/1001 (EUTMR), based on several of P&G’s earlier EUTM registrations. The EUIPO limited its examination to just one of the earlier registrations relied upon, P&G’s EUTM registration No. 4076311 (also shown on page 37) covering goods in classes 3, 5 and 16, since it conferred the broadest protection.

P&G claimed reputation for its mark for the following goods:

- Class 3: Soaps, perfumery, cosmetics,

wipes pre-impregnated with personal cleansing and/or cosmetic preparations.

- Class 5: Sanitary preparations, including feminine hygiene products (such as panty liners, sanitary napkins and tampons, sanitary briefs, interlabial pads for feminine hygiene), wipes pre-impregnated with medical lotions, incontinence diapers, napkins and incontinence pants.
- Class 16: Paper and goods made from this material not included in other classes; paper products for sanitary use such as napkins, handkerchiefs.

ASSESSMENT OF SIMILARITY

On the basis that the only differences were the addition of an L in the opposed mark and figurative elements of a purely decorative or non-distinctive nature, the EUIPO Opposition Division (OD) found the marks to be visually similar to a high degree. The OD found the

marks to be conceptually identical and, on the basis that the second L in the opposed mark would not affect pronunciation, aurally identical.

Interestingly, the OD found the marks to have “no straightforward meaning in relation to the goods in question” and that the earlier mark had a normal degree of inherent distinctiveness. This is a marked contrast to the view taken by the UK trade mark authorities back in the 1980s, when they refused P&G’s application to register its ALWAYS mark on the basis that it was “a word which has very descriptive connotations” and “a term which is likely to be required by other traders in the legitimate course of trade in the goods for which registration is sought for the purpose of describing or drawing attention to their goods”.

Finding the opposed class 3 and 5 goods similar to those protected by P&G’s registration, the OD upheld the opposition against the class 3 and 5 elements under Article 8(1)(b).

The EUIPO rejected P&G’s argument that, since the opposed class 35 services contained no exclusions, they could potentially relate to the Opponent’s goods and that made them similar. The OD found that all the opposed class 35 services were aimed at supporting or helping businesses to do or improve their business and therefore, in principle, directed at the professional public. The OD held that the opposed services are far removed from P&G’s goods in classes 3, 5 and 16 (broadly speaking, non-medicated toiletry preparations, cleaning preparations, pharmaceuticals, sanitary preparations and other preparations for medical or veterinary purposes or pest control preparation paper, cardboard and certain goods made of those materials, office requisites and artists’ materials).

The OD further found that the possibility that the opposed services could relate to/include P&G’s goods was insufficient for finding similarity. It was decided that P&G’s goods have different natures and intended purposes, are delivered by different undertakings through different distribution channels and are neither complementary nor in competition.

The EUIPO distinguished its findings from a previous Board of Appeal decision¹ relied upon by the Applicant on the basis that, in that case, the opposed class 35 services involved actual retail and wholesale services. Finding the opposed class 35 services in this case dissimilar to the goods protected by P&G’s earlier registrations, the EUIPO rejected the opposition against the class 35 services under Article 8(1)(b). It declined to consider P&G’s

claim of enhanced distinctiveness on the basis that, since similarity between the goods and service was a prerequisite for likelihood of confusion, there was no point in doing so.

ASSESSMENT OF REPUTATION

Despite the evidence of reputation filed (on which the Applicant filed no comments), not including any explicit evidence of market share, the OD found P&G’s mark had a reputation in the EU for feminine hygiene products (such as panty liners, sanitary napkins and tampons) before the filing date of the opposed application. The OD held, however, that with completely divergent distribution channels, target customers with different needs and because they were provided by different suppliers, these class 5 goods and the contested class 35 services had no points of contact whatsoever. This large gap made it unlikely that the opposed mark would remind the consumer of the earlier reputed mark.

Consequently, the OD rejected the opposition against the class 35 services under Article 8(5) on the basis that the relevant public would not establish the link or association between the marks that case law² has held is a precondition for an opposition under Article 8(5) to succeed.

The EUIPO’s own guidelines emphasise the difficulty where the market sectors involved differ: “The link will be more difficult to establish in cases where the market sectors concerned by the goods and services are remote, in the sense that a connection between the respective segments of the public is not obvious. In such situations, the opponent must justify why the marks will be associated, by reference to some other connection between its activities and those of the applicant, for example where the earlier mark is exploited outside its natural market sector, for instance, by licensing or merchandising.”

This decision is a reminder that, even where the marks are very similar and the reputation of the earlier mark is proven, the opponent must also demonstrate that a link between the marks will be established by the relevant public.

1. R 2367/2019-1 Alpharma Alliance, S.L. v Helsinn Healthcare S.A. – ALOXA (stylised), 24th February 2020
2. eg, C-252/07 Intel EU:C:2008:655, 27th November 2008, paras 42 and 66; and T-62/16 PUMA ECLI:EU:T:2018:604, 26th September 2018, para 38

KEY POINTS

- ✦ The fact that services such as “advertising” and “business management of retail outlets” might potentially relate to the opponent’s goods does not make such services similar to the opponent’s goods
- ✦ Similarity of goods and services is a *sine qua non* for there to be likelihood of confusion
- ✦ For an Article 8(5) claim to succeed it is necessary to demonstrate that the relevant public will establish a link or association between the signs

MARKS

EUTM NO.
18 407 216



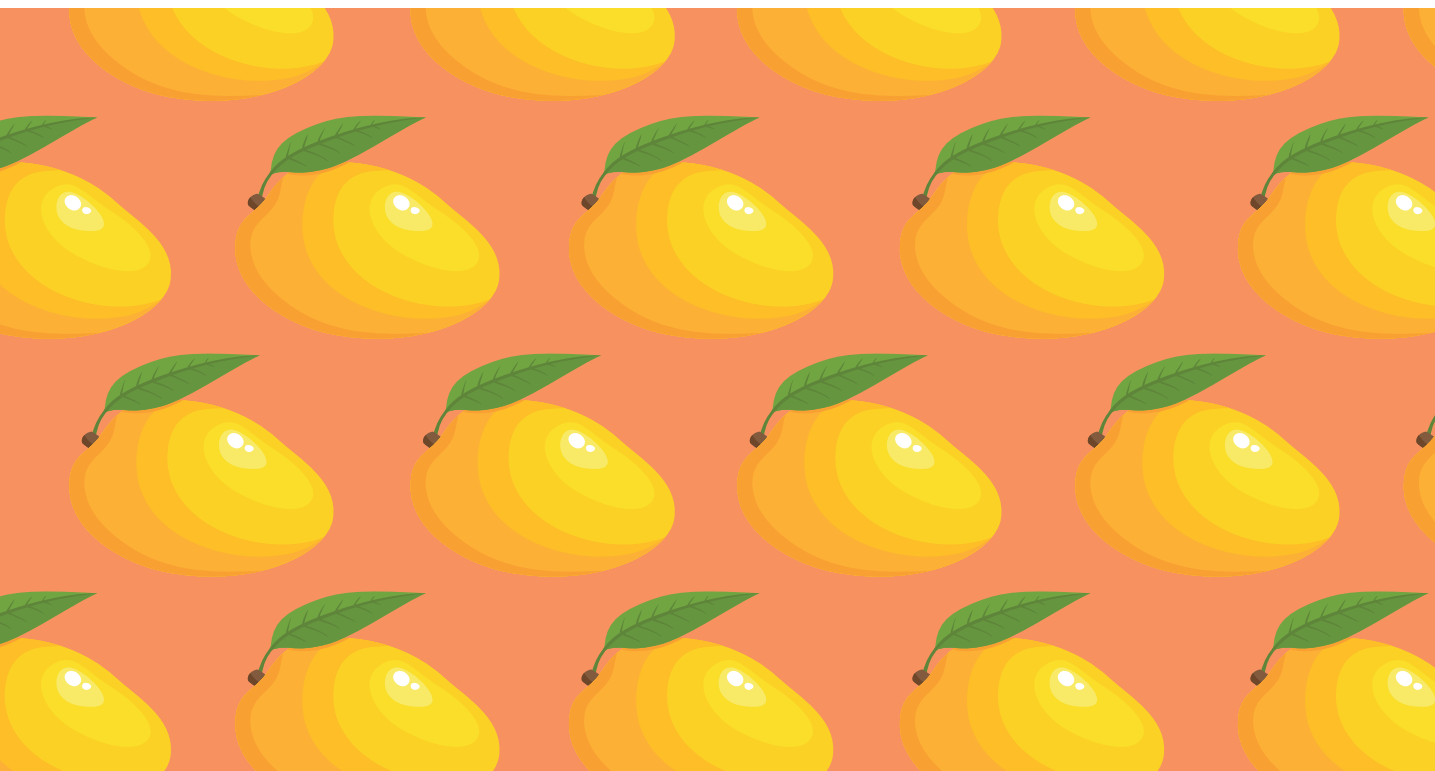
EUTM
REGISTRATION
NO. 4076311



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Ripe for rejection

It took only one ground to uphold this opposition, writes Emilia Petrossian

Consolidated Artists B.V. (the Opponent) successfully brought opposition proceedings against Meilian Cui (the Applicant) and its EU trade mark (EUTM) application No. 018469756 for MAIMANGO (the Opposed Mark) in class 25 on the basis of Article 8(1)(b) of Regulation (EU) 2017/1001 (EUTMR) (likelihood of confusion) and Article 8(5) EUTMR (reputation) in respect of its earlier trade marks for MANGO in various forms.

Although the opposition was based on more than one earlier mark, the Opposition Division (OD) examined the opposition only on the basis of EUTM registration No. 003360815 (the Earlier Mark, shown on page 39) for the sake

of procedural economy. Furthermore, as the likelihood of confusion ground was successful, the reputation ground was not assessed.

The OD held that the average consumer was a consumer with “the average degree of attention, who is likely to vary according to the category of goods or services in question”. It also decided that the relevant territory was the EU.

When comparing the class 25 goods of the Opposed Mark with the goods of the Earlier Mark in class 25, the OD found them to be identical. Where the goods were specified, for example “cycling caps”, they were held to be included in the broader category of the goods of the Earlier Mark, for example “headgear”.

SIMILARITY ASSESSMENT

When assessing the conceptual similarities of the marks, the OD held that the Earlier Mark is to be understood by the public as a tropical fruit that is eaten ripe or used green for pickles or chutney. Although the Opposed Mark as a whole will be perceived as one verbal element, because the two terms together have no obvious meaning, the relevant public will perceive the meaning of these words as a separate concept and break the mark down into elements that will suggest a concrete meaning. Specifically, the public will perceive the terms



“ Although the Opposed Mark contained an additional element, it was not sufficient to exclude a likelihood of confusion

to be “MAI” and “MANGO”, both of which have a meaning. “MAI” means “never” in Italian and “MANGO” has the same meaning as that of the Earlier Mark – fruit. Based on the above assessment, the OD held that the signs were conceptually similar to an average degree.

Further, the OD held that: “As a semantic similarity tends to increase the risk of confusion, the Opposition Division shall focus on the substantial part of the relevant public in Italy which will perceive the word ‘MANGO’ also in the contested sign.” Therefore, the likelihood of confusion was assessed in respect of the relevant public in Italy, which was considered sufficient for the whole of the EU.

When considering visual and aural similarity, the signs were held to be similar to an average degree. This was because the signs coincide in the sole distinctive component of the Earlier Mark, “MANGO”. Further, although the Earlier Mark differed in stylisation, that stylisation

was held not to divert consumer attention from the verbal element of the mark.

DISTINCTIVENESS

The OD held that the Earlier Mark was distinctive per se and decided not to proceed with an assessment of the evidence filed by the Opponent in support of that distinctiveness for the sake of procedural economy.

GLOBAL ASSESSMENT

As discussed above, the class 25 goods were considered to be identical. Further, the marks were held to be visually, aurally and conceptually similar to an average degree, sharing a common and distinctive element, namely “MANGO”. In this regard, the OD stated: “Although there is an established practice according to which it is considered that consumers pay more attention to the beginning of a mark, this consideration cannot prevail in all cases and cannot, in any event, undermine the principle that an examination of the similarity of the signs must take account of the overall impression produced by those signs, since the average consumer normally perceives a sign as a whole and does not examine its individual details (T-344/09, *Cosmobelleza*, EU:T:2013:40, § 52).”

In addition:

“The fact that the contested sign contains the additional element, such as in the case at hand, the term ‘MAI’ does not outweigh the similarities resulting from the coinciding distinctive term ‘MANGO’. The typeface of the earlier mark is not such as to obscure the appearance of the fully distinctive term ‘MANGO’ or otherwise detract the public’s attention from it.”

Therefore, although the Opposed Mark contained an additional element, it was not sufficient to exclude a likelihood of confusion between the marks.

When the OD assessed the similarity between the marks and the goods, it came to conclusion that the public was likely to be confused and would consider the Opposed Mark to be a sub-brand of the Earlier Mark. Therefore, the opposition was successful and the Opposed Mark refused registration in its entirety.

KEY POINTS

✦ The established practice of “consumers paying more attention to the beginning of the mark” is not always relevant, particularly if the entirety of the earlier mark(s) is included in the opposed mark

✦ If a likelihood of confusion or association is established in only part of the relevant public, this may be considered sufficient for the whole of the EU and the mark may still be rejected

✦ The Opposition Division will choose to limit its assessment of an opposition on the basis of procedural economy if one ground is sufficient

MARKS

EUTM
REGISTRATION NO.
003360815

MANGO



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Little beats large

The Court backed a boutique brand, says Eve Duggan

In December 2020, Amber Kotrri applied for the UK series trade mark shown below covering “clothing” in class 25. High-street store Zara opposed on the basis of four earlier word marks for ZARA covering identical goods on the basis of likelihood of confusion and all of the “reputation” grounds. Zara was unsuccessful on all grounds.

It was no surprise that Zara successfully demonstrated enhanced distinctiveness in its ZARA mark. However, the Hearing Officer (HO) still found a number of visual, aural and conceptual differences when assessing the overall impressions of the marks.

In particular, the phrase “HOUSE OF” played a role in this finding. The HO held that the phrase is “flavoured with a gentle grandeur” to such an extent that it had a “degree of distinctiveness” and that “ZANA” did not dominate the later mark. It will be interesting to see how this finding affects future cases as it challenges the presumed view that HOUSE OF is non-distinctive for “clothing”, given it is often used to describe fashion houses.

However, the HO went on to state that “ZANA is the distinctive component of the Contested Mark”, which seems to be at odds with the statements as to the distinctive character of HOUSE OF. Taking the comparison as a whole, and particularly given the different visual impressions, the marks were found to be distinguishable.

REPUTATION GROUNDS

Zara’s reputation was not disputed under this ground. It was the remaining s5(3) legal tests that the claim rested upon – in particular, the risk of association and subsequent injury.

As for the risk of association, the low to moderate degree of similarity between the marks was just enough to prove the necessary mental link. However, the HO referred to the link as “insubstantial and fleeting” and therefore not enough to result in any kind of image transfer or cause any detriment.

This may be the first time that the quality and duration of the “link” have been a factor in s5(3) grounds. Previously, if a link has been found – of any quality or duration – that does suffice to meet the

“link” part of the s5(3) test.

The tension between the assessment of HOUSE OF and ZARA/ZANA demonstrates that opponents should not presume a likelihood of confusion/association because they can prove enhanced distinctiveness and/or reputation for the dominant element of a mark. It is important to ensure the additional legal tests set out under a s5(2) or s5(3) claim can be met, particularly when comparing the overall impressions of marks.

This case attracted significant media attention from multiple news outlets.

It was not an unreasonable opposition for Zara to file, but it appears to have suffered from a “David and Goliath” perception insofar as the media coverage was concerned, and that is an additional reputational factor that should be taken into account, particularly when opposing unrepresented applicants.

“*The opposition seems to have suffered from a ‘David and Goliath’ perception*”

KEY POINTS

- ✦ This may be the first time that the quality and duration of the mental link have been a factor in s5(3) grounds
- ✦ Opponents should not presume a likelihood of confusion/association because they can prove enhanced distinctiveness and/or reputation for the dominant element of a mark
- ✦ Ensure additional legal tests set out under a s5(2) or s5(3) claim can be met, particularly when comparing the overall impressions of marks

MARKS



House of Zana



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We will be feeling festive at our Christmas lunch events in December

Calendar

Our upcoming events for members and other IP events of interest

DATE	EVENT	LOCATION	CPD HOURS
8th November	CITMA Webinar UK case law update	Online	1
17th November	CITMA and UK IPO roadshow	Foot Anstey, Bristol	2
23rd November	CITMA Paralegal Webinar The enigma of counterfeit goods	Online	1
23rd November	IP Out event Queer identities and faith experiences	Allen & Overy, London	1
24th November	CITMA Webinar Taxation and IP	Online	1
2nd December	CITMA Christmas Lunch*	Royal Lancaster, London	
9th December	CITMA Northern Christmas Lunch*	Browns Brasserie, Leeds	
12th January	CITMA Webinar Managing stress in the workplace	Online	1
19th January	CITMA Webinar Lessons from the Only Fools & Horses case	Online	1
24th January	CITMA Seminar IP infringement online	Online	2
8th February	CITMA Webinar Unregistered IP and licensing	Online	1

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THE TRADE MARK 20

Q&A



Rebecca Field

I work as... a Chartered Trade Mark Attorney at HGF. I have been here since 2009 and became a Partner this year.

Before this role... I was a trainee Trade Mark Attorney at Pinsent Masons in Leeds. I had many jobs before my first “proper” one – my favourite was making the trifles at a Morrisons cake shop!

My current state of mind is... wondering when I can have lunch, check on my dog Nelly and take a walk. Also how long I can put off doing watch notices.

I became interested in IP... when I saw an advert on my law school portal – I didn’t know what IP was, but I applied anyway.

I am most inspired by... people who put themselves out there, try something new and if it doesn’t work take the feedback and come back stronger!

In my role, I most enjoy... advising on unique trade mark filings, such as colour and shape, and carving a path to registration.

In my role, I most dislike... billing. It is necessary, but I find it tedious.

On my desk are... a lot of Post-it notes (I am a list maker), highlighters and quite a lot of crafts made by my kids, mainly Hama beads and a Jubilee hat.



“

I am most inspired by people who put themselves out there and try something new

My favourite mug says... Cadbury Caramel. I have had it since I was a teenager; it came with an Easter egg. Clearly, I liked brands even then (and chocolate).

My favourite place to visit on business was... Washington, DC. I thoroughly enjoyed my tour of the USPTO and meeting the Deputy Commissioner for Trade Marks.

If I were a brand, I would be... Terry’s Chocolate Orange, because it reminds me of my childhood.

The biggest challenge for IP is... ensuring it has sufficient board and stakeholder engagement and funds. The brand is the business!

The talent I wish I had is... speaking another language like Italian or Spanish.

I can’t live without... fizzy pop, Bubblemint chewing gum and a cappuccino. Oh, and my kids, dog and husband (in that order)!

My ideal day would include... taking my kids to Warwick Park, going on a flamingo paddleboat, visiting the fun fair and ending up at the café for lunch.

In my pocket is... generally a phone, chewing gum, wipes and random toy pieces I pick up around the house.

The best piece of advice I’ve been given is... the best people fail exams and everyone makes mistakes.

When I want to relax, I... go for a nice walk and listen to a true crime podcast.

In the next five years, I hope to... win the Euromillions and maybe do some trade marks for fun! Keep your fingers crossed for me.

The best thing about being a member of CITMA is... the quality of the webinars and events. More events outside London please!

www.ip-support.co.uk
020 7776 8966
info@ip-support.co.uk

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

IP

Our current vacancies include:

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Trainee/Part Qualified Trade Mark Attorney – London Hybrid
Mid-Senior Trade Mark Attorney – London Hybrid
Trade Mark Formalities Clerks & Paralegals – Multiple locations



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CHRISTMAS**

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» The role will consist of handling a mix of non-contentious and contentious work for a variety of clients across a range of sectors. They also specify those with business development skills will be looked upon favourably!

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