

# CITMA REVIEW

ISSUE 465 JULY/AUGUST 2021

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FROM IPREG  
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MEET MADRID'S  
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**PRESIDENT'S WELCOME  
SUPPORT FOR MEMBERS  
REMAINS OUR FOCUS**

As you will be aware, the demand for UK trade marks and designs has reached unprecedented levels since the turn of the year. It is great to see the number of domestic filings pick up in this way, and we will be helping provide analysis of the impact this has on case law and practice through this magazine and online.

We are continuing to raise important matters with the UK IPO regarding post-Brexit trade marks and designs. I hope our most recent Q&A provides clarity on a number of the issues you have been raising. If you have anything else you would like us to raise with the UK IPO on your behalf, please let us know.

There are also plenty of other ways we are supporting you and all our members. We have just set up a new forum so we can better understand what we can do to support sole practitioners and small firms. If you fall into this category, I would encourage you to speak to the CITMA team about joining the group.

As we report in this issue, we've taken the decision to postpone our Christmas lunches, both in London and the north of England. It was a tough call, but given the amount of planning required and the uncertainty that remains around large events, it was right not to go ahead with something that we could not guarantee would meet your expectations. We are already planning for December 2022, when it will be fantastic to be back together.

Our Autumn Conference, though, will be going ahead – and preparations for it are already at an advanced stage, with a new virtual platform in place. Keep an eye out for further announcements about what is sure to be an insightful and enjoyable conference.

Richard Goddard, CITMA President



**Record demand  
at the UK IPO**

Some 70,000 UK trade mark applications were filed between January and April this year – up from around 37,000 for the same period in both 2019 and 2020 – according to data published by the UK IPO.

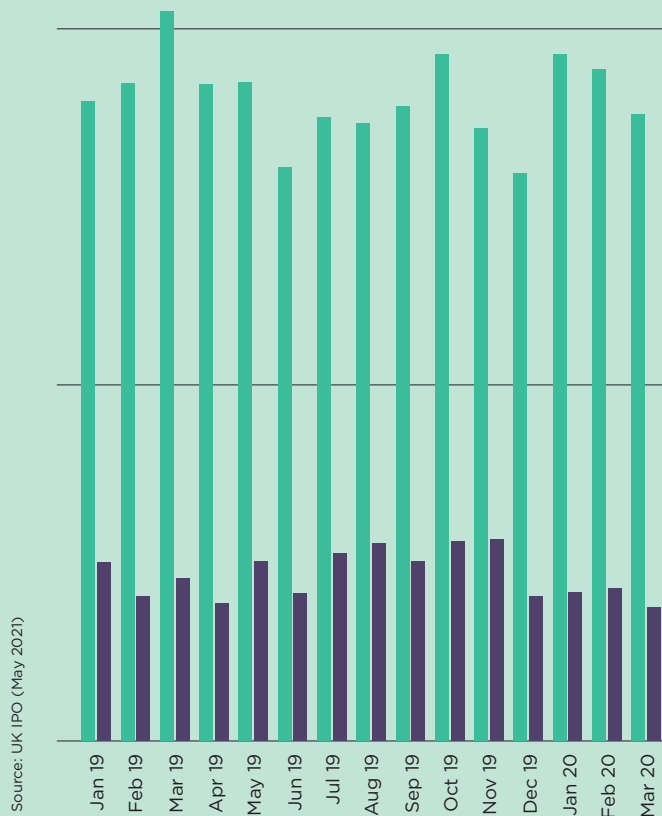
The picture is similar for UK registered design applications, of which there were some 23,000 filed in the first four months of 2021,

compared with just 8,000 in the same period last year.

In April 2021 alone, 6,794 design applications were filed, which is a record high.

The data shows that in February 2021 the number of international trade mark applications designating the UK surged past 2,000 for the first time (2,014 designations). March and April also saw more than 2,000 designations apiece.

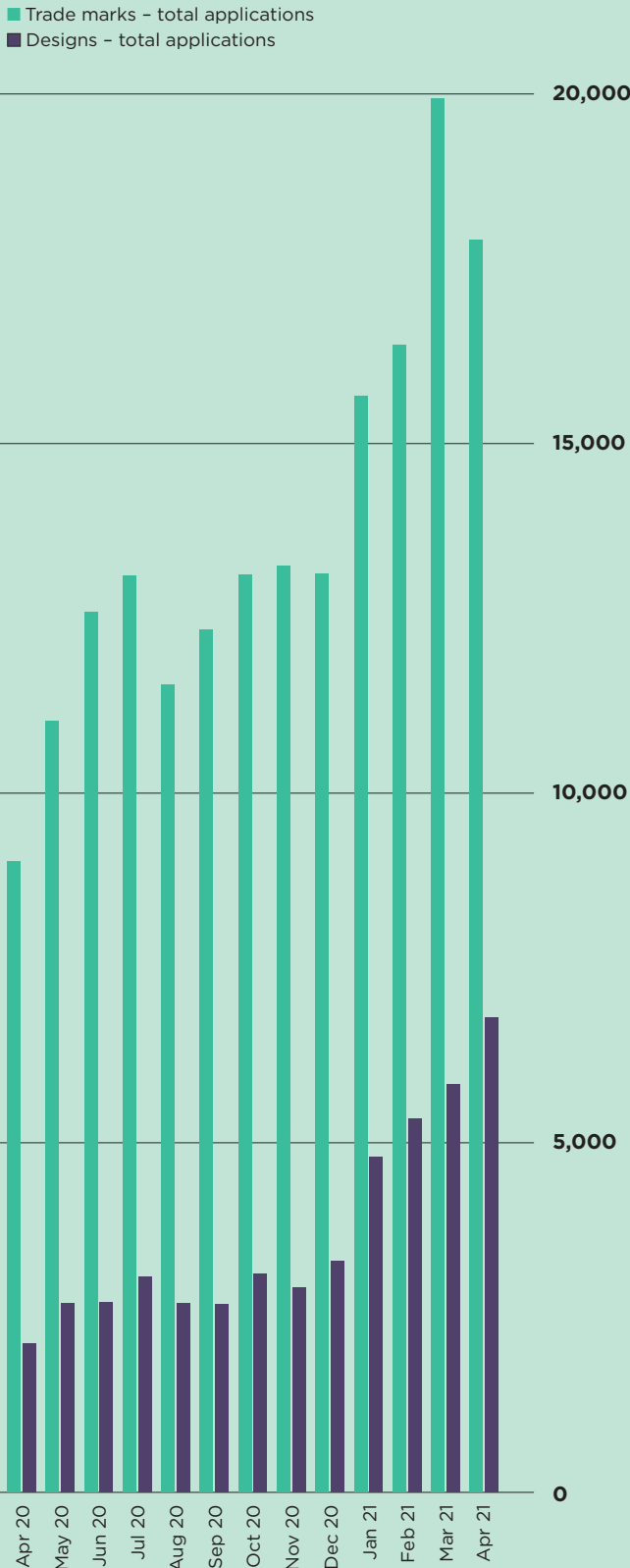
**Trade marks filed, including domestic trade mark applications and international (Madrid) registrations (excluding additional classes). Designs include domestic design applications and international (Hague) registrations**



Source: UK IPO (May 2021)

**DON'T MISS THIS**

Our Autumn Conference will be online on 14th-15th October. Visit [citma.org.uk/events](http://citma.org.uk/events) for more information



**CHRISTMAS LUNCH POSTPONED**

Our popular Christmas Lunch in London will not be taking place this year as we couldn't guarantee the quality of the event for you and our 600 guests. It has been rescheduled for 2nd December 2022 at the Royal Lancaster in London. Read more at [citma.org.uk/xmas21](http://citma.org.uk/xmas21)



**SALARY SURVEY SHOWS UPTICK**

Most Chartered Trade Mark Attorney, Trainee and Paralegal positions are "being offered with an increased starting salary compared to 2020," a report by Dawn Ellmore Employment has found. Visit [citma.org.uk/salary21](http://citma.org.uk/salary21) for more.



**CHINA JOINS TMVIEW**

The number of trade marks searchable on TMview now stands at more than 94 million after some 32 million registered Chinese national trade marks were added to the search tool. TMview now includes marks from 75 participating IP offices from territories in Europe, Africa, Asia, Oceania and the Americas. Find out more at [citma.org.uk/chinatmview](http://citma.org.uk/chinatmview)



# DIVERSITY FINDINGS ARE FASCINATING

Lord Chris Smith explains which responses to a recent sector survey he found most remarkable

One of IPReg's key priorities over the next few years is to stimulate, encourage and facilitate greater diversity in the IP profession. This happens to be one of the major objectives that the Legal Services Board has established for its family of regulators, but this isn't the principal reason why we want to do it. The most important reasons for encouraging diversity are that it helps the profession resemble more closely its customer base, and that it also ensures the widest possible pool of talent is brought into the IP business. An increasingly diverse profession will be a better profession.

That's why IPReg recently contacted all of our registered attorneys and asked if they might complete a diversity questionnaire for us. We had a rapid and good response, with 1,180 attorneys replying. The picture that emerged was fascinating: 42% were women, 10% were from a BAME background and 64% were in the 35-55 age range.

I was heartened by the number of women attorneys, but we need more progress too, especially in encouraging young women to study science and engineering in the first place. Equally, I was disheartened by the relative lack of people of colour coming into the profession.

Two figures from the survey results really stood out for me, though. The first was that more

than 40% said that they were part of the first generation of their family to go to university. I was really pleased to see this. It betokens greater social mobility within the IP profession than – sadly – exists in society more broadly. And the second was that

“

*We need to learn as many lessons as we can and redouble our efforts*

40% of respondents said they had caring responsibilities, mostly for children. This is a salutary reminder to us that we need to make sure that we shape our rules and requirements – for continuing professional development, for example – while bearing in mind the fact that many attorneys will have periods in their career when childcare needs will come first.

We are still analysing the figures carefully, and we hope to repeat the exercise in future years so that we can establish patterns and trends more clearly. But, in the meantime, we need to learn as many lessons as we can. We must redouble our efforts to support the fantastic work of IP Inclusive. We must continue to support schemes encouraging young women to go into STEM subjects. And we must advocate strongly for the most diverse, welcoming and inclusive profession possible.

I know personally – from the world of politics – how important this inclusivity is. When, 35 years ago, I became the first MP to come out publicly as gay, I believed passionately that anyone – no matter who or what they were, or what sexual orientation they happened to have – could be a valid representative for their constituents in Parliament. The same is surely true of trade mark and patent attorneys working for their clients. In the years ahead, let's do even more to demonstrate that truth.



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

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

## Trade Mark Paralegal : South West or London **TJB134005**

Our client is a prominent IP Firm who is seeking an experienced Trade Mark Paralegal to join their friendly team. Based in their South West or London office, you will ideally and advantageously be CITMA qualified with a minimum of 2 years' experience working in a similar IP environment. We warmly invite applications from Trade Mark Secretaries and Paralegals who are highly motivated and keen to consider new opportunities.

## IP Paralegal : London **TJB134017**

Global IP management software company, due to their ongoing success and substantial growth, are eager to appoint an impressive IP Paralegal into their London base. As part of a drive to build up their formalities team in the UK we can guarantee that this is an outstanding opportunity if you are an experienced CITMA or CIPA qualified IP Paralegal in search of a role that is as exciting as it is challenging and a little different!

## Trade Mark Attorney : South East and/or Remote Working **LKA133950**

Hugely successful and impressive firm with a global reach has capacity to welcome a talented qualified or finals standard Trade Mark Attorney to complement their collaborative Trade Mark team. On offer here is a great deal of flexibility, with the option to work from one of their South East offices or be almost fully remote. Your excellent technical knowledge and communication skills will prove vital as you enhance and build on existing client partnerships and welcome new ones.

## Associate Trade Mark Attorney : London or South West **LKA133539**

We have been instructed by a specialist firm who are keen to appoint a commercially astute and creative thinking Trade Mark Attorney who is looking for fresh challenge and career development. You will join the expert team of this future-focussed practice, with the offering of being based out of their central London or their regional office. If you are a Trade Mark Attorney with c.4-6 years PQE and are currently exploring the market then this role should not be overlooked.

## Trade Mark Attorney : London **CEH133797**

Our client can only be described as a leading and truly innovative firm. Based in central London, with IP as one of their main areas of specialism, they are keen to appoint a dynamic Trade Mark Attorney into their impressive practice. In a collaborative and relaxed environment, you will join a diverse team of individual thinkers and be given all the flexibility to develop your own niche area and develop your career.

## Trade Mark Assistant : West Yorkshire **CEH133488**

Are you a highly skilled Trade Mark professional with at least a years' Paralegal, Assistant or Formalities experience gained within a dynamic IP firm or department? The Leeds base of a sizeable, global reaching firm has a stellar opening for a Trade Mark expert to join their IP team. This is a unique and rare opening which offers the opportunity to not only work with a highly reputable private practice but also offers the chance to work in-house with an extremely high-profile client.

## Trade Mark Paralegal FTC : Northern Ireland or Fully Remote **CEH133121**

Opportunity for a skilled Trade Mark Paralegal with a highly reputable law firm who operate internationally at the cutting edge of the legal industry. The IP team sat within this multidisciplinary firm is impressive, offering an outstanding, global, full IP service to stellar international clients and iconic brands. Ideally you will be a CITMA qualified and those with French or German language skills will prove advantageous.

## Trade Mark Paralegal : South Coast **CEH133940**

Are you an enthusiastic and experienced Trade Mark Paralegal who is keen to achieve a perfect work/life balance on the South Coast? Heavyweight firm of Patent and Trade Mark Attorneys with an international presence require a dynamic Trade Mark Paralegal. You'll be ideally CITMA qualified and ready to bring your knowledge and skills to this opportunity and confidently take responsibility for the day-to-day correspondence for an agile team of Trade Mark Attorneys.

## Trade Mark Attorney : Oxford and/or Remote Working **CEH133382**

Progressive boutique IP firm is keen to appoint a talented Trade Mark Attorney to complement their expert team of IP professionals who hail from an impressive array of legal backgrounds. This is a refreshing opportunity if you are exploring the current IP market. With their rich array of clients, this growing business may prove to be a perfect place in which to hone and further develop your trade mark skills, knowledge and passion.

## Trade Mark Attorney : West Yorkshire **CEF133802**

Are you a UK qualified Trade Mark Attorney who post pandemic is looking for a fresh start? We are working on a stellar role on behalf of an impressive international IP firm whose UK base is uncommonly situated in the beautiful hills of West Yorkshire. On offer is a unique opportunity to handle both UK and International work, with scope to manage the Trade Mark side of this small but long established practice with support from a substantial, acclaimed European firm.

For further information about this selection of opportunities or to discuss any other aspect of IP recruitment, please contact:  
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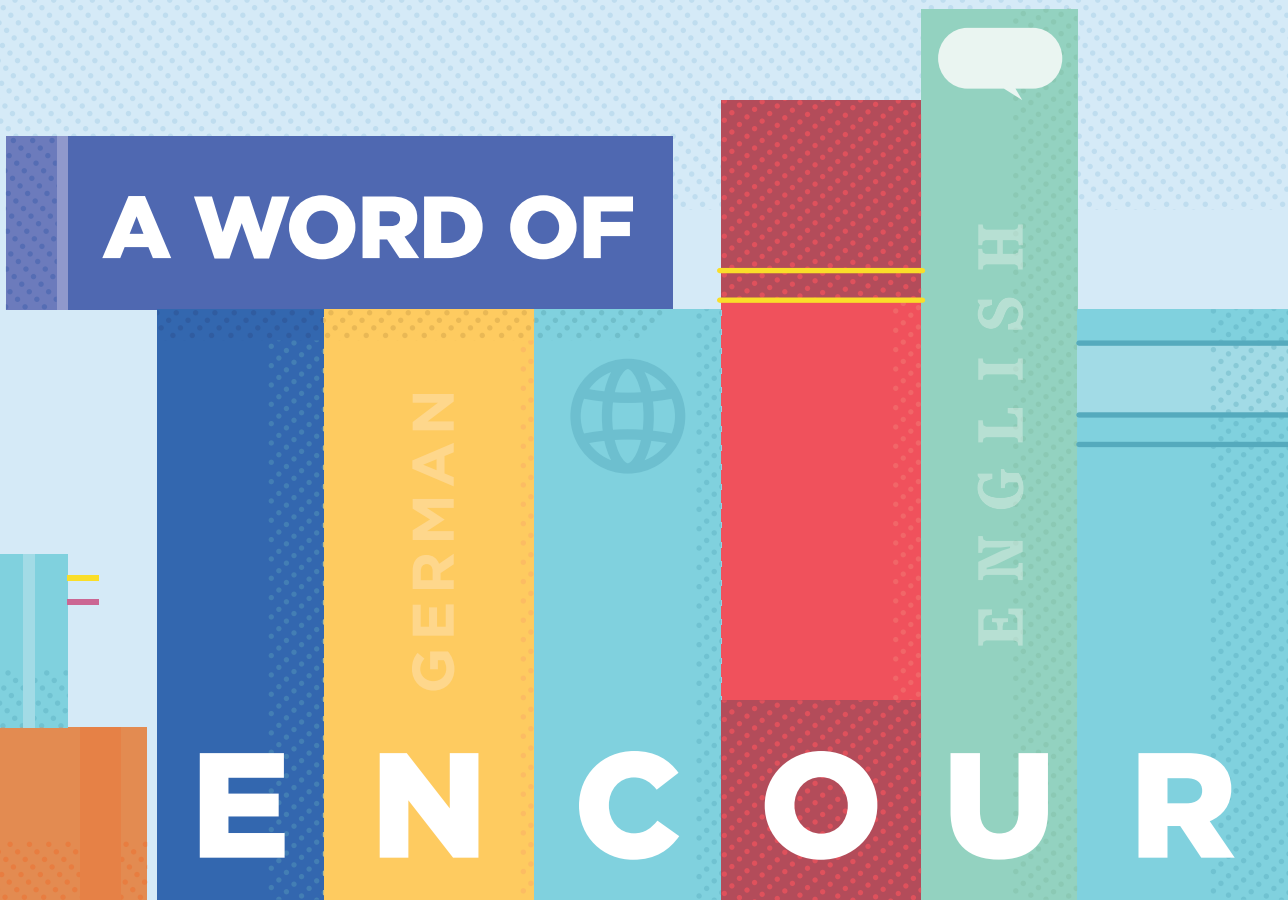
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## Carol Nyahasha explains how a language learning project that started in lockdown has led to lasting benefits

According to the 2011 census, English or Welsh was the main language of 92.3% of the residents of England and Wales, with just 7.7% having a different main language. My childhood was spent in Zimbabwe, and although Shona, a widely spoken Bantu language, was my first language, I learned English at school and my family spoke both languages at home.

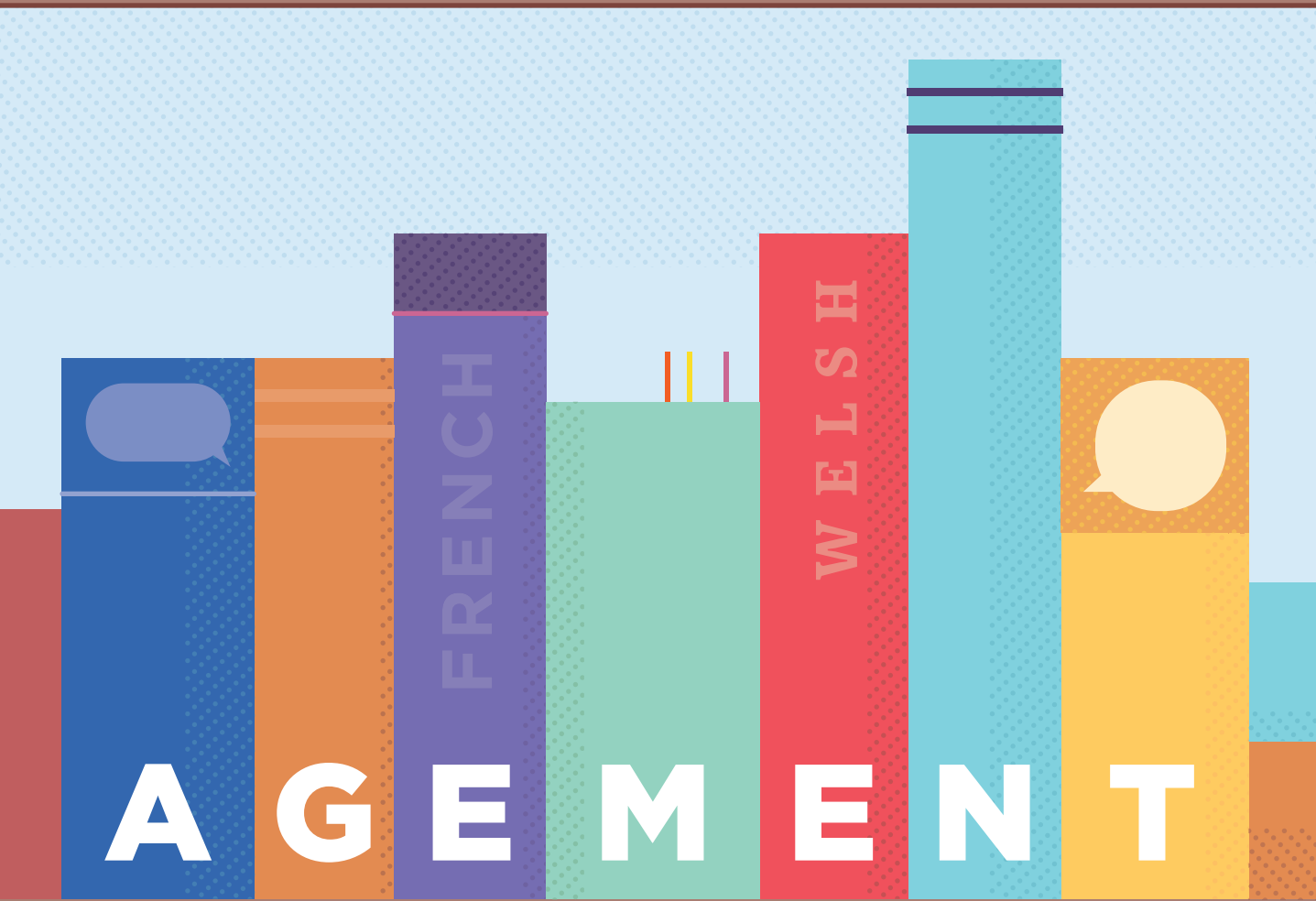
During the first COVID-19 lockdown in March 2020, the absence of a commute meant that I had some additional time on my hands. Like many people, I felt the most beneficial use of this would be to do something that was on my wish list but which I had long set aside in favour of more immediate priorities. I've always been excited by languages, so I took the first steps towards learning a new one.

The year before, I had spent a lot of time in France exploring the vineyards of Provence, so French

was the obvious choice. The project was initially done simply for my own personal development. I had no thoughts of using my newly acquired skill in the workplace, and I didn't even contemplate any benefits it might have for me – except perhaps the prospect of fluently ordering a bottle of wine and understanding which mouth-watering delicacies were on a restaurant menu.

To set the wheels in motion, I contacted a teacher based in Lyon who had come highly recommended in a Facebook group for aspiring French speakers. During hour-long Zoom sessions with her every week, I was able to practise my French and, by pairing these sessions with use of the Duolingo and Babbel apps,





I made considerable progress. After just a few sessions, I began to feel confident about conversing in French and could proficiently book a ticket at the train station, express my views on Brexit and buy groceries at the supermarket.

As (perhaps) fate would have it, I also started work at Baron Warren Redfern, which has some established relationships with French-speaking firms and France-based clients. This meant that my language learning turned out to be beneficial in the workplace, too. It enabled me to introduce myself to my counterparts and clients in their native language, which I found was a real icebreaker and made them feel instantly comfortable and more relaxed. It's fair to say

that although I couldn't write complex legal documents in French, I do feel my clients are more comfortable and relaxed when I am communicating with them, whether this is face to face, by phone or email.

With this experience as a starting point, I felt it would be interesting to speak to a few IP professionals and sector recruiters to find out a bit more about how being multilingual can make a difference in the IP workplace.

#### **AN ANGLOPHILE'S VIEW**

Birgit Clark is the Lead IP Knowledge Lawyer at Baker McKenzie. She has a particularly interesting language story, which I found intriguing and inspiring. She grew up in Germany and ▶





only started learning English in secondary school, where she did the equivalent of what in the UK would be a language A Level. Being an Anglophile, Birgit decided to do an LLM at the University of Aberdeen after qualifying as a German attorney-at-law. Her doctoral degree was completed in Germany, but the pull of the UK proved too great and Birgit decided to work in London for “a year or two to see something of the world”. As it turned out, she met her future husband and 17 years on is still living in England and is qualified as a Chartered Trade Mark Attorney and solicitor.

Birgit feels that being bi- or multilingual is a real asset in the legal field: “Having learned English, Latin and French at school has certainly helped me

in my career, especially regarding trade mark law and particularly when it comes to spotting different connotations and allusions. I was also able to make submissions at the EUIPO in German and easily refer to case law from the German courts. Being de facto bilingual also helps with reading case law from the CJEU and the General Court, especially when the English version is opaque. Double-checking the German version of a decision has often clarified matters quickly.”

Birgit continues to publish academic papers, and being qualified in the UK and Germany has allowed her to write and speak about German case law in English and vice versa, which has opened up a niche for her. However, she cautions that “practising law in a foreign language is much more demanding than just studying for a degree in a foreign language”.

#### CULTURAL FLUENCY

Cherry Shin is a Chartered Trade Mark Attorney at Appleyard Lees and, like me, is a big advocate of learning another language. She was raised in a Korean household and attended Korean school every weekend, but she never thought her Korean language skills would come in handy for work or life in the UK. However, Cherry started her role at Appleyard Lees as the Korea liaison for patent-focused work, finding her language skills useful because the firm had a focus on that territory. Despite her lack of patent knowledge, she travelled

to Korea with the patent team. This all led to the building of stronger relationships and her firm securing trade mark work with some of its Korea-based patent clients.

While Cherry’s experience shows how language skills can lead to opportunities in a specific context, there is no firm evidence to suggest that bilingual candidates are necessarily more attractive to employers in IP. However, with a number of companies now offering free language lessons, there is no denying that employers see the value in having a dynamic, multilingual workforce. Indeed, for any firm or employer that engages with clients or adverse parties that are from different cultures and language groups, having staff who are multilingual should be in some way beneficial, even if these skills aren’t formally recognised or sought out.

For his part, Daniel Long, a Director at recruitment agency IP Support, has noticed an increasing number of instructions for bilingual IP staff over the past few years, with particular demand for candidates with German-language skills. Other languages, including Spanish, French, Japanese, Mandarin and Arabic, are also regularly requested.

“While a second language is most commonly listed as a desirable skill, for some vacancies it is a prerequisite,” he explains. “This is particularly relevant if the role supports a specific client or if the employee will be the point of contact for an overseas office or external counsel. Some vacancies not only require a second language but also a strong understanding of local business culture.” He suggests that “with most IP firms actively growing their European and overseas offices, it is anticipated that language skills will play a key role in future recruitment”.

#### BREXIT BENEFIT?

If the consensus is that language skills alone won’t get you through the door when applying for a new

“ Being de facto bilingual helps with reading case law from the CJEU and the General Court, especially when the English version is opaque

“ While a second language is most commonly listed as a desirable skill, for some vacancies it is a prerequisite

position, they're certainly a strength worth emphasising, not least because they often demonstrate a commitment to developing new skills and an ability to learn quickly. Kevin Bartle, a Director at Dawn Ellmore Employment, feels that languages continue to be a “nice to have” skill on a CV, even if there is no specific requirement for a second language in the job description. “It shows a willingness to learn something new, and that you are striving for self-improvement,” he says. This is particularly relevant if this study continues after you've completed your formal education.

Kevin continues: “Since the UK left the EU, I have seen an increase in UK-based IP firms opening up a European office or expanding an existing European operation. In these scenarios, language skills in the local language can be seen as a distinct advantage over other applicants, even if they might not be strictly necessary for the job.” He goes on to observe: “It's my perception that European languages are the ones that offer the most value in terms of their usefulness in helping to secure a new job.”

#### COMMON GROUND

For her part, Cherry is keen to point out that although language skills may not be necessary for securing a job in IP, they can help to promote good client relationships. “My language

skills have opened up a whole range of new experiences for me, giving me the opportunity to observe cultural differences – for instance, the way an exchange of business cards is handled in Korea. It means I know what to expect before meeting a new client,” she says.

Cherry feels that her language degree in French and Spanish has also come in handy when she attends networking events. “It makes it so much easier to meet new people and build relationships, because it gives you some common ground”. Even if you don't know the language very well or know only a few words, she believes that “languages are great for expanding your network and a great way of making new friends. Every friend you make could turn into a potential client.”

I absolutely agree with this view, although I would caution that while you are still learning you will need to be prepared to come to terms with your mediocrity. Be ready for puzzled looks and sometimes laughter. While these responses can be disheartening, I have found that it is in these moments that I have learned and advanced my French skills the most.

My own takeaway from my conversations with Birgit, Cherry, Kevin and Daniel is that in a multicultural society, having a second language definitely sets you apart from your monolingual peers and can even open doors to better opportunities. Learning a language also equips you with cultural awareness, giving you an appreciation of history, traditions, arts and religions. You also gain a more global mindset, which is seemingly growing in importance for employers.



Learning a second language also gives you the ability to connect with others more easily and to communicate with a wider range of people. It can also open the doors to travel and studying and working abroad. It enhances your networking skills too, making you more appreciative and flexible when it comes to understanding people's opinions and actions.

So, if I've been successful in making the case for picking up a new language, what do I recommend to help you make the project a success? Perhaps predictably, my first tip is to practise a lot: expose yourself to your chosen language often and in small chunks. I do this by passive learning, exploring selected French websites, news channels and social media platforms. This really helps in terms of learning the nuances and day-to-day usage of the French language. Secondly, be aware that you do have to be in for the long haul to become really fluent. If this is your goal, it's best to start as soon as you can, as it can be a long process.

Having issued that note of caution, I can certainly attest that my exploration of French has bolstered my self-confidence. Learning another language is something I would wholeheartedly recommend. Even if you don't know where it will lead, as Birgit and Cherry have demonstrated, it won't be a waste of your time and it will serve you long after our lockdowns have come to an end. ●

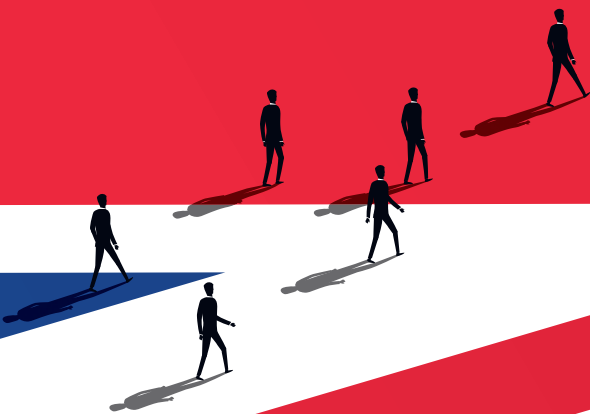


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# THE IP ACROSS THE DIVIDED PE

Cherrie Stewart  
investigates the novel  
solution to Brexit  
that now prevails  
in Northern Ireland



The outcome of the UK's 2016 Brexit referendum created a unique problem for Northern Ireland (NI) – one that required a novel solution.

NI is the only part of the UK that has a land border with the EU. The 1998 Good Friday Agreement, which helped bring an end to the Troubles in NI, stipulated that there was to be no hard border on the island of Ireland. The UK's decision to leave the EU introduced a conflict here, since this requirement clashed with the EU's need to ensure the integrity of its single market for goods by having proper checks on its borders.

The tension between these diametrically opposed requirements resulted in the agreement of the Protocol on Ireland/Northern Ireland (the Protocol), which, in its opening statements, “acknowledges the need for this Protocol to be implemented so as to maintain the necessary conditions for continued North-South co-operation, including for possible new arrangements in accordance with the 1998 Agreement”.

### THE PROTOCOL AND IPRs

With that overriding objective in mind, it was agreed that a limited set of rules related to EU customs and the EU's single market would be applicable in NI. This, of course, has a direct impact on the enforcement of intellectual property rights (IPRs).

Under Article 5(4) of the Protocol, there are a number of provisions of EU law that now apply to IPRs in NI.

Those specifically listed under s45 of Annex 2 relate to:

- Geographical indications of spirit drinks;
- Quality schemes for agricultural products and foodstuffs;
- Geographical indications of aromatised wine products;
- A common organisation of the markets in agricultural products; and
- Customs enforcement of IPRs.

A limited amount of protection is afforded to some Protected Geographical Indications (PGIs). The owner of a right in a PGI can request a customs action in an EU Member State for protection in NI of said rights. For example, NI can be selected as a territory for enforcement action in respect of protected PGIs by checking box XI under s10 of the “European Union – Application for Action” form or by filing a UK Application for Action for NI alone. In addition, decisions granting an application in respect of EU IPRs protected in NI under the Protocol can be made by the competent customs department in either the UK or an EU Member State.

The Protocol does not, however, contain any divergent provisions in respect of other types of IPR (eg, trade marks, patents and copyright), and an EU Application for Action does not cover said rights in NI. For example, in a notice to stakeholders

related to exhaustion of IPRs, the EU stated that: “While the Protocol on Ireland/Northern Ireland provides that certain rules of the EU *acquis* in respect of goods apply to and in the United Kingdom in respect of Northern Ireland, it does not provide for the exhaustion of intellectual property rights in the EU in cases where a good has been legally put on the market of Northern Ireland.”

### CUSTOMS AND EXHAUSTION

Just as in the rest of the UK, any IPRs in goods put on the market in NI are not exhausted in the EEA. However, there is now a difference between NI and the rest of the UK in that there is no requirement to file customs declarations to record the movement of goods, and there are no customs checks at the border between Ireland and NI – or indeed between NI and any EEA Member State, thus making it more difficult to enforce IPRs and prevent the spread of infringing and counterfeit goods.

Currently, goods entering NI from Great Britain (GB) must go through customs at ports on the Irish Sea. A declaration concerning whether a good, originating from GB or a third country, is “at risk of subsequently being moved into the EU, whether ▶





## “ Declaring that goods are ‘at risk of being moved into the EU’ is a potential barrier to IP enforcement

by itself or forming part of another good following processing” is therefore required under Article 5(1) of the Protocol.

Customs authorities have the power to seize goods that they suspect infringe the IPRs of rights holders. Then, once the right holders have certified that the goods are infringing, they can be destroyed.

However, an Application for Action in respect of EU IPRs cannot be enforced on goods coming from the rest of the UK or from a third country. Such an application would have to be filed in an EU Member State and would not be enforceable in NI in respect of any IPRs not specifically outlined in the Protocol.

Declaring that goods are “at risk of being moved into the EU” is a potential barrier to IP enforcement since some NI companies are finding that the consequences of making such a declaration can be highly detrimental to their businesses.

One Northern Irish company, a wholesaler and retailer of doors, floors and associated goods, included on a declaration on a pallet of goods being transported from its premises in England to NI that there was a chance of a very small minority of the goods being exported to Ireland due to the existence of their Irish retail website. A 6% duty was placed on the whole consignment of goods, thereby increasing costs by thousands of pounds. Consequently, the firm has now suspended internet sales to Ireland, and its plans to open a physical outlet there have been paused while it seeks a way to keep costs at a reasonable level in NI when exporting to Ireland.

IPRs in goods put on the market in the EEA are currently exhausted in the UK, including in NI. This may change once the 2021 consultation on what the UK should do about exhaustion and parallel trade in the future – which is now being conducted by the UK Government – is completed and a decision regarding the long-term UK position has been reached.

The customs checks being where they are may make it difficult to prevent the circulation in NI of goods put on the market in the EEA whose IPRs are not exhausted if this position changes.

### OPPORTUNITIES AND RISKS

Invest NI, the designated Economic Development Agency for the territory, has been understandably vocal about the opportunities afforded by NI’s unique position, making statements such as: “This dual market access position means that Northern Ireland can become a gateway for the sale of goods to two of the world’s largest markets and the only place where businesses can operate free from customs declarations, rules of origin certificates and non-tariff barriers on the sale of goods to both GB and the EU.”

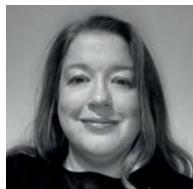
However, concerns have been raised that the “unfettered access” promised by Article 6(1) of the Protocol (which also states that any EU rules invoked by the Protocol would only be applied to trade between NI and GB “to the extent strictly required”) will cause difficulties for the owners of IPRs.

Under the Protocol, there are no customs, regulatory checks or processes for “qualifying” NI goods moving from NI to GB. There are also no additional authorisations or approvals required for placing “qualifying” NI goods on the market in the rest of the UK, with some limited exceptions. For the majority of goods moving from NI to the rest of the UK, there are no export declarations, no import declarations on arrival in GB, no customs duties and no changes to how the goods arrive at ports in GB.

In December 2020, NI Assembly member Diane Dodds raised her concerns over the Protocol and the concept of a “frictionless” border, stating that it was vital that NI did not become “a backdoor for the bloc’s products”.

Of course, in the course of any regime change, teething problems are inevitable. The introduction of the measures required by the Protocol have proved to be no different. There has been friction on the streets of NI and complaints from businesses concerning the new processes and procedures. Due to the difficulties surrounding the implementation of Article 5 of the Protocol, in March this year the UK Government stated its intention to extend the grace period for implementing certain aspects of the Protocol concerning the movement of goods from GB to NI. The EU subsequently sent a formal notice to the UK Government concerning the “breach of its obligations under the Protocol”. At the time of writing, discussions were still ongoing.

We have been presented with the Protocol as a novel solution to the unique problem created by Brexit in NI, and it is unlikely that any substantive changes to the Protocol will arise from the ongoing discussions between the UK and the EU. Fundamentally, the Protocol sets out a framework that has implications for the owners of IPRs and with which we must engage. It is clear that the effects of the Protocol on parallel trade and IP enforcement in NI, and potentially in the rest of the UK too, will need to be closely monitored as we continue to operate in a post-Brexit world. ●



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## Qualified Trade Mark Attorney – Birmingham

### About Us

Forresters IP LLP is a leading full service intellectual property firm with an international client base. We have offices located in Birmingham, Liverpool, London, Munich and Southampton. Since being established in 1884, we have grown from a regional firm into an international practice. Despite our long history we are a young firm with a fresh approach to our clients' requirements and employee career progression. We are rated as one of the leading intellectual property firms in the UK. Our London presence has just been relocated to new offices in the Gherkin.

We have a strong trade mark team with a proactive approach to portfolio protection and maintenance, with expertise in all areas. We handle all aspects of establishment, use, registration, maintenance and enforcement of trade marks.

### The Role

We are currently looking to recruit a qualified trade mark attorney to join the busy and friendly team in our Birmingham office. The successful candidate will deal with all aspects of trade mark practice, including:

- Advising on trade mark, domain name, company name and passing off matters
- Filing and prosecuting trade mark applications and maintaining trade mark portfolios
- Advising on validity and infringement matters
- Involvement in oppositions, enforcement and other contentious matters
- Development of our trade mark business

The job description is not an exhaustive list of all the tasks and the role might include additional duties associated with running of the trade mark department.

The ideal candidate will be capable of working both independently and as part of a team, and have proven organisational skills and excellent oral and written communication skills. The candidate will also possess a commitment to quality and attention to detail, and the ability to work under pressure and meet deadlines. Candidates should possess at least an upper second class degree and be fully qualified.

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In return, we offer a competitive salary, flexible working (core hours), a 35 hour working week, 31 days annual leave, Health Cash Plan, Cycle Scheme, Season Ticket Loan, Private Medical Insurance, Life Assurance and a professional and pleasant working environment.

To apply, please send your CV and a cover letter to [careers@forresters-ip.com](mailto:careers@forresters-ip.com) by the **30th June 2021**. For further information, please see our website <https://forresters-ip.com/>

*Please strictly no agencies.*



**SOME LIKE IT  
HOT**

That's why it pays to approach every dispute with due respect, says Dewdney Drew

**T**he distinction between contentious and non-contentious practice is well known. We are also all aware of the difference – in intensity, shall we say – between disputes before the UK IPO and those before the courts. Perhaps underappreciated, though, are the different intensities at the IPO level, which depend on a variety of non-obvious factors.

As the rules of conflict are somewhat universal and tend to map from one arena to another, a reference to the world of combat sports may help here. Many people will not see much difference between, for example, “professional wrestling” and mixed martial arts. The term “fight” might be used loosely to describe what goes on in either of these realms. They are, however, quite different.

To extend the metaphor, consider catch wrestling. This sport, popular in the 19th century, tended to offer matches that were either very boring or brutally eventful. Given that entertaining the audience was the ultimate goal, the sport’s organisers came to the view that something closer to a “display” was what was needed – and “kayfabe” was born. Essentially play fighting with a more or less pre-agreed outcome, the sport



## “ It can be a nasty shock for an attorney when parties are playing for keeps

mirrors well the steps in much of contentious practice.

A typical example would be a case involving two established corporate clients represented by established firms. Both sides will exchange initial blows (opposition and counterstatement) but will likely expect a settlement. When the settlement is negotiated, the weaker party may secure more than it would get if the opposition went to a decision – sometimes because its attorney is clever, sometimes because the attorney on the other side is polite. The negotiation of the coexistence agreement can float free of the bargaining power of the parties, and other considerations can weigh in. For example: the desire to “wrap things up”; a loss of urgency; a feeling that the agreement should be balanced and symmetrical, even if the bargaining power is not; and a tacit abandonment of further aggressive action.

However, when parties are playing for keeps, an analogy to the Brazilian street-fighting concept of Vale Tudo (“everything goes”) is more apt. And it can be a nasty shock for an attorney when what was expected to be a bout of kayfabe turns into such an anything-goes tear-up.

### GAME CHANGERS

Why might the rules of the game change? Often, a key difference is whether one party stands to be sued, and is likely to be sued, for infringement. Losing an opposition or invalidity in these circumstances can cause real-world problems. Contrast this to an opposition where the opponent is simply trying to prevent the dilution of its brand on the register.

Another factor is where one of the parties is an individual. Whereas a company has multiple employees working together and limited by budget, individuals take things personally and may keep fighting beyond the point at which it makes logical sense to stop. Sole practitioners can follow a similar pattern, possibly for similar reasons. The worst of all worlds might be a situation where a sole practitioner is representing an individual on a contingency fee arrangement.

When it comes to working through these “hot” disputes, there are a number of points to consider.

First, recognise what kind of dispute it is, and don’t adopt the same attitude as one might for a “nice to win” opposition. And don’t expect any consideration on issues such as extensions of time. If you request an extension in an *inter partes* matter, make sure that it is fully supported as per the Trade Marks Manual (Tribunal Section 4.9.1). Consider estoppel risks and don’t get cornered. If you are going to file evidence, file it properly.

Do rope in the expertise of others as needed (eg, counsel and/or specialist solicitors), and think beyond the IPO proceedings. Also, be realistic about your cost estimate, as disputes like these are not cheap. Utilise costs awards and security for costs to contain unreasonable action.

Importantly, if there is an infringement risk to your client, advise on this early and candidly, and consider cessation of usage until the risk exposure is fully assessed. If you initiated such a dispute, consider what your client stands to lose if the tide turns. Also consider the risk of adverse publicity, especially if your client is a public figure.

Be careful of without prejudice correspondence, and if possible avoid without prejudice verbal conversations altogether. There are adversaries who are happy to breach these conventions, and although the item may be inadmissible as evidence, the impression made on the Hearing Officer could be consequential. It may be better to convey such communications

as individual PDFs, rather than through an email chain, as disclosing individual PDFs is less likely to happen “by accident” (chains being easier to forward). Also bear in mind the exceptions to disclosing without prejudice communications listed under *Unilever v Procter & Gamble*<sup>1</sup>, and familiarise yourself with the options around disclosure at the IPO (Trade Marks Manual, Tribunal Section 4.7).

Finally, brush up on bad faith, especially around intention to use. Although it is not common, the UK IPO allows for both disclosure and cross-examination, and requests for these by a determined adversary can raise (and personalise) the stakes very quickly. Even if you expect to defeat a bad faith claim, the journey to that destination might not be one that your client is prepared to take. Following the decisions in *Sky plc v Skykick UK Ltd*<sup>2</sup> and *Kreativni Dogadaji v Hasbro Inc*<sup>3</sup>, consideration should also be given as to how new applications are advised on, lest their genesis later be examined.

The above considerations may not be new to a busy contentious practice, but difficulty can arise when junior staff are passed a matter where the other side is playing for keeps. Even experienced practitioners can be taken by surprise if they have, as is often the case, spent a considerable spell in settling matters for genteel blue-chip clients. In short, while you might be a “black belt” in terms of experience, it pays to approach every dispute with the necessary degree of caution and respect. ●

1 [1999] EWCA Civ 3027

2 [2020] C-371/18

3 [2021] T-663/19



### Dewdney Drew

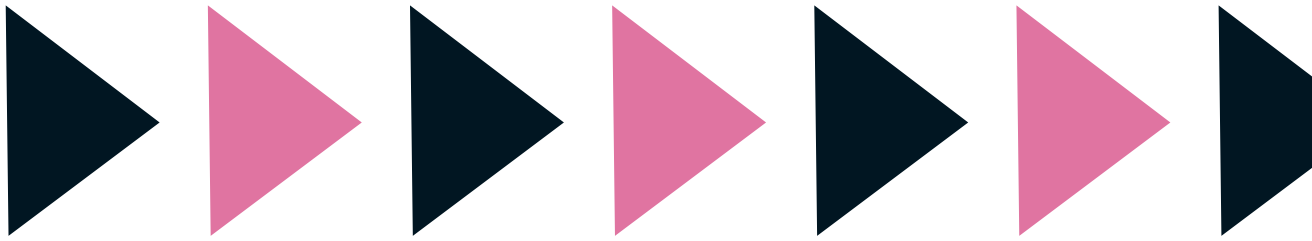
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**HONEY,  
I STARTED  
A PODCAST**



Why take your IP skills  
to the airwaves?  
Aaron Wood talks us  
through his thinking





he rise of podcasting is a trend that no one can have missed. Yet only a small band of legal firms have so far created

a podcast, and the landscape is littered with efforts that amount to just a few episodes. As someone who has recently launched a podcast of my own, *CITMA Review* asked me to weigh in on why I've done so and what I've learned in the process.

#### WHY BOTHER?

"Why bother?" is the ultimate question behind any marketing activity. If we assume that the purpose of any such activity is to have some impact on your firm's workload, then the key question of "Why?" should determine not just whether you do it, but also how.

To generate work, many firms simply open the doors and wait for instructions from longstanding clients, intermediaries and other departments. In that case, marketing activities can be difficult to justify if they are aimed at winning new clients. They may be valuable, however, if they increase the work coming from existing clients or push them to do new work.

My experience of marketing activities is that they can be intermingled with service delivery to provide some time and cost savings and to improve the client experience. As I will explain later, this is one area where podcasts can work. But without peeking too far into the marketing playbook, my view is that I get work from three places: other attorneys (in the UK and overseas); end clients who are reasonably or very sophisticated; and "standard" clients.

A legal podcast that works for all three is probably impossible: provide content to the first two, and the

third will be bamboozled. Provide it to the third, and it will be too basic for the first two. I decided to focus on the first two segments.

As to the "why", to my mind there are four key elements to winning new work:

- Potential clients need to know that I exist;
- They need to know that I am knowledgeable;
- They need to believe that they could work with me; and
- An opportunity needs to arise for them to work with me.

For most of my work, I am grateful for the badge of honour of being a Chartered Trade Mark Attorney. If the client knows what this means, then they already understand that the second requirement has been met. But otherwise, my marketing work tends to focus on putting out content that makes it clear that I am knowledgeable, particularly in places where I will get traction. This might entail converting existing written content into opportunities to interact with me or hear me, and then converting those opportunities into one-to-one discussion and pitches.

*“ A key step is to decide not just who your target audience is, but also who it is not*

Brochures and newsletters are great in the sense that they demonstrate expertise, but many have very poor open rates as they require focused time to read. Plus, even if the prospective client loves the newsletter, they still haven't "met" you, heard your voice or imagined what it might be like to work with you.

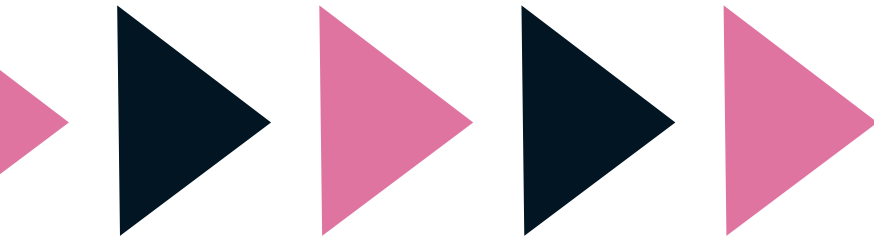
A podcast solves some of those issues: it can be listened to when the prospective client has time, such as on car journeys or in the gym. Even better, they get to hear your voice, so that by the time they actually speak to you they may have been "conversing" with you for hours via podcasts. Given that part of my work is undertaking advocacy at UK IPO hearings for other firms of trade mark attorneys and taking care of litigation, hearing me talk about cases is a key hurdle overcome.

#### FIXING MY FOCUS

A key step is to decide not just who your target audience is, but also who it is not. I think a huge mistake many firms make in their marketing is to try to address everyone, with the result that they engage no one. I decided to focus on in-depth discussions with those at the "coal face". Standard trade mark prosecution clients would probably get nothing from it, but some might realise that I am knowledgeable and send me work anyway.

Once you've decided on your audience, consider what they might want to hear about, who they might want to hear from and how long they might be willing to listen. My conclusions were that they would want to hear about "core" cases in depth and also issues on the periphery that contacts might expect them to know about. I also felt that they would want to hear from lively and engaging speakers who were willing to go out on a limb a little and not just cover things in a "safe" and boring way. Finally, I concluded that they would probably want to hear a lot more detail than they would get from other sources and that they would be willing to go "long-form".

The plan was for this to be a weekly podcast. Before I started, I set (and broke) a rule that I would have six to eight episodes in the ▶



“bank”, as it seemed like that was the point at which some of the other podcasts tended to run dry. I also made another important decision: I would have competitors on the podcast – a real point of difference from podcasts that were intended solely to promote a firm’s services. I would find the best and most engaging speakers on a subject, whether they were competitors, clients or overseas lawyers.

### GETTING TECHNICAL

I have been fortunate enough to chair webinars for CITMA in the past, which means that I am used to – and positively enjoy – getting on the mic and learning new things. Of course, my work as an advocate also helps here, but I find I do have to resist the temptation to cross-examine the guests. One important element of my podcast, I decided, was that it would not be too highly edited. I wanted the listener to really get the feeling of it being a conversation rather than a formal presentation. This has meant that occasionally there are small gaps or filler words, or one speaker speaks over another. Personally, I think that is part of the charm.



The main difficulty for me, then, was understanding the technical requirements. I came into it with absolutely no experience in recording and very little experience in editing, but I had recourse to a few experienced people who gave me some direction.

I have learnt that you can produce a podcast on very little, or you can spend many thousands of pounds. At the very bottom of the budget is simply recording in on your mobile device or a voice recorder and uploading the audio files. This may require no extra spending at all (other than perhaps a new headset and mic to plug into your mobile phone). At the top-end is a soundproofed location with top-of-the-range equipment and software. I decided on an intermediate option, including a range of XLR mics (considered to be audio industry-standard), a RODE-branded board with seven inputs and faders (including a line in and a Bluetooth input) and some free-to-use editing software called Audacity. The Bluetooth and line-in options make it straightforward to do phone-in interviews.

What type of mic you’ll use is a crucial choice. You can get a very high-quality condenser mic with a USB cable for little cost. However, this type of mic tends to pick up all the available sound in the area and requires a pop-filter – a screen placed in front of the mic to avoid the noise of plosive consonants (which produce a sudden release of air). Alternatively, there are also dynamic mics, which often pick up sound in one direction more than

others. This makes them ideal for podcasts because they tend to pick up the voice and not any surrounding noise. If you are recording in a house shared with children or a dog, for example, a dynamic mic may be better.

### GUEST PREP

Preparing for the guests is usually fairly straightforward. I try to put together a good intro for them, which I record before they are interviewed so they can hear it and approve it. I have pre-recorded opening and closing credits, so for each episode I simply record the introduction and the interview and stitch them together in Audacity. The interviews themselves tend to be organised in terms of overall subject matter, but I think it’s important to let the interviewee get their character across as well as the content. I want to be a sheepdog cajoling them to stay on point rather than an attack dog!

So, should you start a podcast? My suggestion: if it makes sense for your overall marketing mix and you know your client profile, then a podcast could be a great next step. You can dip your toe in at next to no expense (other than the cost of hosting the podcasts on a listening platform, from as little as £5 a month). As with most things, activity breeds competency: it’s better to get on with it and improve over time than to sit on the sidelines worrying whether you’ll be good enough. ●

*Find Aaron Wood’s IP Show on Apple Podcasts and other platforms.*



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# THE PERILS OF POPULARITY

Blake R. Wiggs assesses the impact of Canada's accession to the Madrid Protocol on CIPO

## The Canadian Intellectual

Property Office (CIPO) began receiving Madrid registrations designating Canada on 17th June 2019 upon the coming into force of extensive amendments to the Trademarks Act (RSC 1985 c. T-13). As of 26th April 2021, CIPO had received 33,251 inbound Madrid registrations, according to my analysis of its trade mark .xml data, which contains details of all 1,782,294 marks in the Canadian trade mark system.

As any Canadian trade mark practitioner can tell you, CIPO has a backlog of cases awaiting initial substantive examination. As of 26th April 2021, that backlog exceeded 161,000 applications, including many more than two and a half years old.

This backlog is largely a consequence of CIPO's decision to prioritise Madrid applications so that it can meet the deadlines imposed on it by the Protocol. For example, as of 26th April 2021, CIPO had conducted at least an initial examination for more than 96% of all inbound Madrid cases with June 2019 international registration (and thus deemed Canadian filing) dates. However, less than 6% of the non-Madrid cases filed in June 2019 had been examined as of 26th April 2021.

The table opposite sets out the examination status of the 12,377 Madrid and 35,164 non-Madrid cases filed from June 2019 through January 2020 (as captured on 26th April 2021). As you can see,

CIPO has expended significant examination resources on Madrid cases relative to non-Madrid cases.

To be fair, CIPO may not have anticipated Canada's sudden popularity as a designated state for Madrid filings. According to the WIPO's IP Statistics Data Center, Canada is currently in fourth place worldwide – behind only the UK, the US and China – in terms of the number of 2021 Madrid filings designating those jurisdictions (disregarding the 27 EUIPO countries).

On 3rd May 2021, CIPO issued two Practice Notices addressing

the backlog. One provides that: examiners will reduce the number of reports issued; CIPO will “where reasonable” refuse trade marks in a more timely manner; and examiners will consider an argument only once. The Notices also urge applicants to provide complete responses to examiners' reports.

Refusals have been rare in Canadian trade mark practice, but that may soon change. With the backlog growing week by week, significant action is required to maintain confidence in Canada's trade mark system. ●

Case filing date (CIPO)		% examined (at 26th April 2021)		
Year	Month	Madrid	Non-Madrid	Overall
2020	January	5.51%	2.00%	3.08%
2019	December	11.64%	2.65%	5.54%
2019	November	39.45%	3.47%	14.36%
2019	October	68.25%	4.93%	23.41%
2019	September	80.77%	3.83%	25.28%
2019	August	87.98%	4.16%	25.41%
2019	July	93.22%	4.27%	29.32%
2019	June	96.85%	5.68%	15.96%



## Blake R. Wiggs

is a retired intellectual property lawyer based in Vancouver, British Columbia. He is the author of the Canadian Trademark Intelligence blog.





## What's behind the high rate of rejection for UK Madrid users filing overseas?

**A**ssessing the distinctiveness of trade marks can be a subjective and imprecise process, particularly in the context of global screenings. What passes for distinctive in one country

may fail in another. Local practices can vary significantly.

Applicants from the US often believe that their marks are treated most harshly on distinctiveness grounds in other countries. US counsel also believe that overseas applicants to the US benefit from a less restrictive distinctiveness standard. It is likely that numerous

UK applicants and their counsel have similar viewpoints. To date, this has been a question answered only with anecdotes and war stories. However, new information available from Trademarks OnPoint provides actual insights into whether these suspicions are valid.

Trademarks OnPoint has developed a Global Trademark Distinctiveness database that categorises refusals issued to Madrid Protocol extensions. Refusals based on absolute





“ Analysis of this data revealed that applicants from the US and UK were refused on absolute grounds most often

grounds are the basis for the new data collection. By running queries against this data, it is possible to access insights into refusal trends across the globe.

For this study, we analysed three years of WIPO refusal data (2018-2020). This three-year data set covered 1,436,176 extensions and 426,818 refusals. For the purposes of this study, we chose several jurisdictions that received the majority of Madrid extensions, along with key-holder countries (the UK, the US, Japan, Germany, China and South Korea). Analysis of this data revealed that applicants from the US and UK were refused on absolute grounds most often.

One example of how these two countries lead refusals on absolute grounds is supplied by France, where, for some reason, UK extensions were refused at a much higher rate than any other country, with the US in second place (see table below).

Other countries in which UK extensions are the most refused on absolute grounds are the US and Russia. UK extensions to the US are refused 30% of the time, far higher than the average refusal

rate of 23% for all other key-holder countries into the US. Similarly, applicants from the UK lead the pack for absolute grounds refusals in Russia at 25% among the same set of key-holder countries. The average refusal rate among the key-holder countries was 18%.

**DISCLAIMER IN PLAY?**

As both the US and Russia employ a disclaimer practice, it is possible that the refusal percentages reflect the fact many UK marks employ disclaimable elements (Trademarks OnPoint refusal data includes those refusals requiring disclaimers). A more accurate reflection of how UK marks fare on this topic overseas is to look at data from countries that do not have a disclaimer practice.

Accordingly, to find an answer to this question, we analysed several non-disclaimer countries. UK applicants consistently ranked either first or second for refusals across many non-disclaimer practice jurisdictions, including Australia, Germany, India, Norway, Korea, Japan and Singapore.

Germany (see table overleaf) is an example of the way in which UK marks are frequently refused on absolute grounds, with almost a third of all extensions there being refused, at a rate 7% over and above the average refusal rate of 21%. Oddly, the EUIPO is not as hard on UK applicants as most UK counsel assume. While the EUIPO refuses at a much lower rate overall (3% on average across the key-holder countries), UK applicants fare moderately well, with only a 2% refusal rate. Applicants from the US, France and Japan are refused at higher rates (3-4%).

While the data trends bear out the general premise that US and UK applicants suffer higher than

France: Absolute grounds refusal rates

Country of holder	No. of designations	Refusal rate
UK	157	12% (19)
US	953	7% (66)
Japan	414	6% (26)
Germany	810	6% (45)
China	4,178	2% (81)
South Korea	257	1% (3)
<b>Average</b>		<b>4%</b>

Source: WIPO (designation data, 2018-2020); Trademarks OnPoint (refusal rates)



average absolute grounds refusals, it does not explain the reason for these results. We suggest that two fundamental factors are at play that may explain this situation: (i) differing trade mark office perspectives on the threshold for inherent distinctiveness; and (ii) additional absolute statutory bars in some countries. These two factors result in marks that are held to be inherently distinctive and registerable in the US or UK

countries approved, with most examiners presumably finding the term “toothy” to be suggestive of the goods it represents. However, China and Thailand found the mark to lack distinctiveness. Similarly, the mark BELIEVE, BUILD, BECOME (IR 1486070) registered in the UK for cosmetics, apparel and certain business consulting and training services was partially refused by the EUIPO for those class 35 and 41 services. The examiner stated

TEMPERANCE (IR 1510226) for alcoholic beverages. The mark is easily defined as “abstinence from alcoholic drink” – the opposite of the good it represents. The US and Canadian offices easily saw the lack of connection between mark and good and agreed with their counterparts in the EU (where the basic registration was issued) that the mark was inherently distinctive. Nevertheless, China held that the mark lacked distinctiveness.

## “ Food and beverage marks from the UK are fertile ground for disagreement among offices

nevertheless being tripped up by local absolute grounds.

### DISTINCTIVENESS HURDLES

Many registered marks originating from the UK nevertheless fail overseas on pure distinctiveness grounds. Some examples support this observation.

Cosmetics marks always seem to come close to the distinctiveness line. For example, CHECKMYHAIR (international registration no. 1520346) for hair care services was registered in the UK and extended to several other countries. The US approved the mark as distinctive, but the trade mark offices in China, the EU, India and Brazil refused the mark as descriptive. Another mark registered in the UK for toothpaste, TOOTHY TABS (IR 1476306), had its extensions to almost a dozen

that the mark would be perceived as a laudatory slogan intended to communicate an inspirational message. The USPTO had no such problem with the mark. This case bears out the stricter position certain jurisdictions take on slogans.

Food and beverage marks from the UK are also fertile ground for disagreement among the offices. Oddly, the EUIPO was fine with the mark ACADEMY OF CHEESE (IR 1557357) for educational cheese classes. Does this “cheese academy” really exist? It seems to be a light-hearted reference to a fictional cheese school. Still, the trade mark examiners in China, Australia and New Zealand said the mark was descriptive.

A more puzzling example of a lack of understanding of the meaning of a term is the mark

Marks with double meanings also sometimes run into trouble, like NO BULL (IR 1506156), registered in the UK for vegan and vegetarian food items. While the mark was seen as distinctive by the US, EU and Russian offices, Norway held that the mark lacked distinctiveness. While vegan food clearly does not have “bull” in it (in the sense of beef or meat products), the point of the mark was an obvious play upon the slang meaning of the phrase of “not kidding”. Perhaps Norwegian examiners are much more literal thinkers.

Norway also bears out the example of certain offices pulling apart marks, defining their elements and then predictably finding the mark as a whole devoid of distinctiveness. An example of this is the case of BONDASHIELD (IR 1402644). Some six years after the UK IPO registered the mark BONDASHIELD for plastic films for industrial use, the markholder sought protection in the EU, Norway, Japan, South Korea and Turkey. The result? Every office approved the mark except Norway, which held it to be descriptive after tortuously pulling apart the elements of the mark and analysing each. For most English speakers, the mark does not immediately convey the purpose of the good because the “A” element disrupts the flow of the mark and renders it suggestive.

Design marks also sometimes falter overseas, as in the case of the mark shown above (IR 1457644), registered for a variety of goods and services ranging from engines, lubricants and vehicles to vehicle design and installation services. The Applicant extended to nine countries (including the EU, US,

### Non-disclaimer practice: Germany’s absolute grounds refusal rates

Country of holder	No. of designations	Refusal rate
UK	185	28% (51)
US	1,041	24% (253)
China	4,559	21% (959)
Japan	379	21% (79)
France	1,112	18% (197)
South Korea	281	10% (27)
<b>Average</b>		<b>21%</b>

Source: WIPO (designation data, 2018-2020); Trademarks OnPoint (refusal rates)

IR 1457644



IR 1521765



IR 1329995



India and Japan), which all found the mark distinctive. Norway broke in the other direction and held that the two-shape geometric design was devoid of distinctive character.

### CONFUSING REFUSALS

Some distinctiveness refusals are real head-scratchers. For example, the EVOLUTION mark (IR 1242517), registered in the UK for protective eyewear and ear plugs and approved in 20 other countries, was held to be non-distinctive in Germany. While in taking that position Germany may be an outlier, several other refused UK extensions to Germany seem to bear out a difference in office practice on what counts as distinctive. For example, the following marks were approved in the UK but refused in Germany:

- IBET (IR 1527876) for gambling and gaming software;
- FEELUNIQUE (IR 1426265) for retail related to cosmetics;
- THINKFINANCIAL (IR 1526160) for financial goods and services;
- PROPER CHIPS (IR 1521765, see above) for clothing and food items (including crisps).

PROPER CHIPS is another example of a mark sitting on the dividing line. Norway and Ireland also refused the mark as lacking distinctiveness at least with respect to crisps, but Benelux, Switzerland, Spain, France, Italy, Poland and Portugal approved the mark.

### ADDITIONAL ABSOLUTE BARS

One other basis for refusals overseas that tend to ensnare both

US and UK applicants are morality grounds. China has a seemingly inexhaustible supply of reasons why a mark will be deemed “unhealthy”. Some of the categories of such marks include those with sexual, religious, undead, currency, political or rock-and-roll connotations.

For example, a UK mark containing the word SEX (IR 1329995, see above) in connection with clothing was held to be unhealthy and unregistrable in China and Russia. The mark JIMMY CHOO ILLICIT (IR 1291240) for cosmetics and soaps was refused in China as the word “illicit” is unhealthy there.

Marks with religious connotations are also frequently refused, as a Kent-based hair salon branded as THE CHAPEL (IR 1350977) discovered when it extended its registration covering 13 different classes to China. The entire extension failed due to the unhealthy influence of the religious connotation. The CATHEDRAL CITY (IR 935441) mark registered in the UK since 1986 for cheese was similarly tossed out by the Chinese examiners as unhealthy. China also frowns on references to the undead: for example, VAMPIRE VAPE (IR 1334255) for e-cigarettes, was similarly refused as unhealthy.

Marks including references to currency are also immoral in China, such as GOODDOLLAR (IR 1435141) for charitable fundraising goods and services. And anything deemed political will be refused, as was the case for REBEL (IR 1509270) for combs and brushes.

Finally, “edgy” marks also tend to have trouble in China. The mark

CONTAMINATOR (IR 1486086), filed by Marshall Amplification for goods including musical instruments, was refused as unhealthy. The mark GANGSTA’S PARADISE (IR 1515395) for perfumes and cosmetics also met the same fate.

Of course, not all morality refusals come from China. The ENPULA mark (IR 1477203) for pharmaceuticals was filed first in the UK by GlaxoSmithKline and then at WIPO. The EUIPO subsequently refused the mark. Apparently, the term translates to “dick” in Romanian and is therefore immoral under EU practice. China did not find that same translation and granted protection, but GlaxoSmithKline cancelled the IR nonetheless.

So, the data on US and UK Madrid Protocol extension refusals based on absolute grounds, along with the above examples, suggest that

**“ The UK IPO is far more accepting of marks on absolute grounds than other offices**

applicants from these two countries tend to choose marks closer to the line between descriptive and suggestive than those applicants in other countries. On the other hand, perhaps applicants from the UK and US exist in a much more permissive branding environment and are often caught by surprise with a morality refusal. In either event, a UK markholder seeking to file or extend in other countries should be aware that the UK IPO is far more accepting of marks on absolute grounds than other offices. ●



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# Present and corrected

Charlotte Wilding highlights the danger of relying solely on dictum

**Lululemon Athletica Canada Inc. (LLL)** has been partially successful in its opposition against LULULION, albeit that the EUIPO's own error resulted in a revocation of the original, wider opposition decision.

The story begins on 2nd January 2018, when LLL filed an opposition against Shenzhen Jia Li Fu Kang Logistics Co. Ltd's EU trade mark application for LULULION in classes 18, 22 and 28, filed on 30th August 2017.

LLL opposed on the basis of EUTMR Articles 8(1)(b), likelihood of confusion, and 8(5), reputation. The earlier rights relied upon were LLL's EU trade mark registration No. 2304848 in classes 18, 25 and 27 and the EU designation of international registration No. 1086102 in class 35, both for LULULEMON. However, the Article 8(5) ground was later withdrawn by LLL in its observations of 1st April 2020.

“ *The EUIPO held that the marks were visually and phonetically similar to a high degree due to the identical ‘LULUL\_ON’ elements*

LLL also included the German, French, Irish, Benelux, Swedish and Danish designations of international registration No. 1086102 in class 35 and the EU designation of international registration No. 1086103 for LULULEMON ATHLETICA in class 35 in the notice of opposition. However, the EUIPO did not assess the likelihood of confusion in respect of these marks on the basis that the marks covered the same or a narrower scope of goods and services, such that the outcome of the decision would have been the same and therefore assessment was unnecessary.

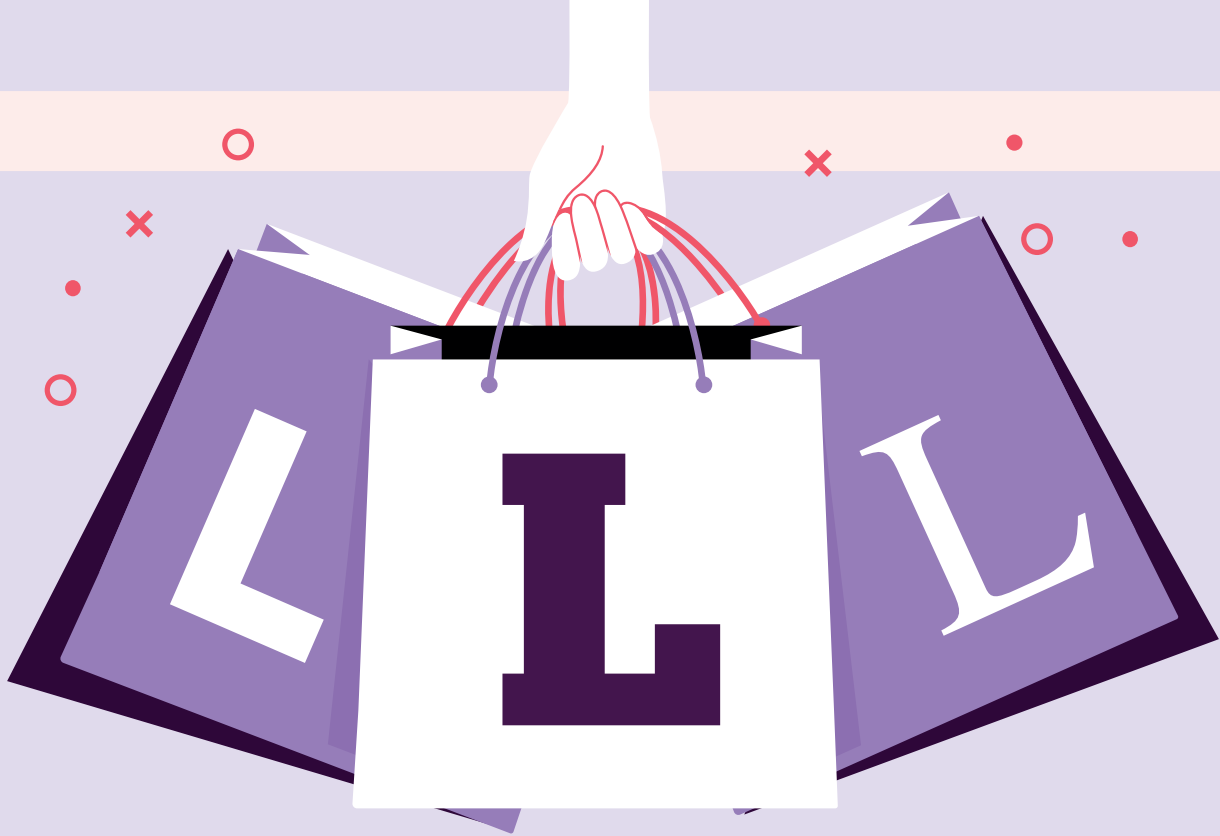
#### ASSESSMENT OF GOODS

In reviewing the contested goods, the EUIPO held that a number of the opposed class 18

goods were either identical or similar, on the basis that the similar goods have the same purpose and usually coincide in producer, relevant public and distribution channels. However, it noted that there were a number of dissimilar goods in class 18, including *inter alia* “collars for animals; leather thread; parasols; umbrellas”. The EUIPO found that such goods had nothing in common with LLL's goods and services, noting that: “In particular, they have clearly different purposes, methods of use, distribution channels, relevant publics and producers. In addition, they are not complementary or in competition”.

This view was also taken in respect of the opposed class 22 goods, despite LLL arguing that such goods were similar to “bags”. The EUIPO held that “similarity cannot be found between the opponent's bags and the several contested bags and sacks for packaging, storage and transport. These products belong to completely different markets (ie, that of fashion against the packaging of goods) and have different method of use, relevant publics and producers.”

When assessing the opposed class 28 goods, the EUIPO specifically referred to the fact that there is a low degree of similarity between retail services concerning specific goods and other specific similar or highly similar goods. This is due to the close connection between the goods on the market from the perspective of the consumer. In particular, consumers are used to seeing similar goods offered for sale in the same store, and they are often of interest to the same consumer. Accordingly, a number of the goods in class 28, such as *inter alia* “bait (artificial fishing); balls for games; golf bags; water wings”, were held to be similar to a low degree to LLL's “retail store services featuring athletic equipment” in class 35. However, the remaining class 28 goods, such as *inter alia* “air pistols [toys]; kites; stuffed toys”, were found to be dissimilar.



### ASSESSMENT OF MARKS

Moving on to the assessment of the marks, LULULEMON versus LULULION, the EUIPO held that the marks were visually and phonetically similar to a high degree due to the identical “LULUL\_ON” elements. Given that the marks have no conceptual meaning, assessment on that basis was not possible, but that would not affect the similarity of the marks in any case.

The EUIPO found that, “taking all the above into account, the Opposition Division considers that the differences between the signs are not sufficient to outweigh the assessed similarities between them. Consequently, the relevant public, when encountering the signs in relation to identical or at least similar goods and services, are likely to think that they come from the same undertaking or from economically linked undertakings”.

### OFFICE ERROR

Ultimately, the EUIPO issued a decision rejecting the opposed application in class 18 and the similar class 28 goods. The opposed application was allowed to proceed in respect of class 22 and the dissimilar class 28 goods.

However, the EUIPO informed the parties on 2nd February 2021 that it intended to revoke this decision as it contained an “obvious error attributable to the Office”. In this regard, while the dictum of the decision stated that all goods in class 18 were refused, the body of the decision held that some goods in class 18 were in fact dissimilar to LLL’s, as

discussed above. Therefore, these dissimilar class 18 goods should not have been refused.

The parties were given until 7th March 2021 to respond to the EUIPO’s intention to revoke but declined to do so. Accordingly, the 2020 decision was revoked and replaced with a corrected decision on 23rd March 2021. In this decision, the opposed application was rejected in respect of the similar class 18 goods, as well as the similar class 28 goods previously listed in the original decision.

The reasoning behind the decision remained the same. The parties were instructed to bear their own costs and were given until 23rd May 2021 to appeal. It appears no appeal has been lodged.

This case is a reminder that you should not rely solely on the dictum of a case, and that you must always review the reasoning behind the decision. Further, unless all the rights relied upon add to an opposition, the EUIPO will likely not review such rights. However, it is always important to include your relevant rights from the outset, as these can always be withdrawn at a later date if not required, or the EUIPO can choose not to assess them.

### KEY POINTS

- ✦ Do not rely solely on the dictum of a decision
- ✦ The EUIPO may be proactive in correcting its own errors
- ✦ Not all earlier rights will be assessed if they do not add to the opposition

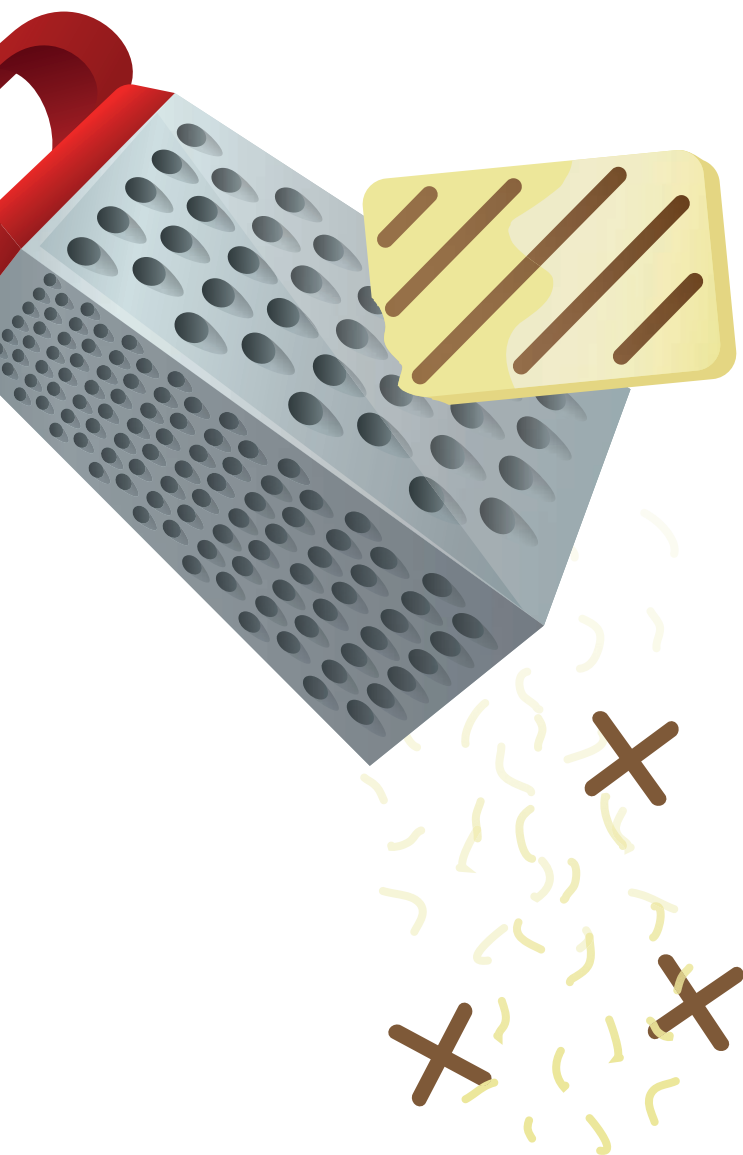


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# Cheesed off

The latest appeal related to Halloumi has amounted to nothing, Ellie Wilson reports



**This case is** an appeal against the Board of Appeal's (BoA) decision to uphold earlier decisions in this matter, which had started with the Cancellation Division refusing the application by the Foundation for the Protection of the Traditional Cheese of Cyprus named Halloumi ("the Foundation") to declare the figurative trade mark shown

opposite ("the contested mark") invalid. The General Court (GC) also made some illuminating comments about the policy regarding EU collective marks.

The basis of the opposition to this trade mark was the EU collective word mark for the word HALLOUMI (No. 1082965), which is owned and robustly enforced by the Foundation. In this case, the Foundation was unsuccessful as its appeal was dismissed once again.

## SIMILARITY OF GOODS

The contested mark was registered not just for cheese (as is the Foundation's collective mark) but also for a range of other products, including eggs, compotes and preserves.

The Foundation argued that the BoA had been wrong to find that, for example, eggs "do not have the same nature as cheese", which led to the somewhat bizarre but zoologically inarguable finding from the GC that, "as regards eggs, although they are indeed goods of animal origin, as is cheese, these generally come from hens, or even ducks, and not from cows or goats".

The GC concluded that the BoA had erred in its findings that some of the goods (meat, fish, poultry and game; meat extracts) were different from cheese, and that there was a degree of similarity, albeit a weak one. As such, there should have been a global assessment of the likelihood of confusion in relation to those goods.

## DISTINCTIVE CHARACTER

The GC considered Article 74(2) EUTMR, which is a derogation from the usual absolute grounds of refusal only to the extent that marks that designate geographical origin are not excluded from registration as EU collective marks. What that derogation does not do is remove the need for a collective mark to also be distinctive.

The word "Halloumi" is a generic name for a type of cheese produced in Cyprus. As such, the inherent distinctiveness of the mark is weak. It follows that the protection conferred by the Foundation's mark is coextensive with its ability to fulfil its



## “ The collective word mark does not confer an exclusive right to the word ‘Halloumi’ ”

essential function of distinguishing the goods of the Foundation’s members from other undertakings. In its arguments, the Foundation asserted that this reasoning would effectively deprive the mark of the rights it confers on its members, but the GC disagreed.

Having assessed the Foundation’s mark as having its scope limited due to its scant inherent distinctiveness, the GC also commented that the mark could be sufficiently protected, and – implicitly – may more suitably be protected by the separate regime of rules governing protected geographical indications.

### GLOBAL ASSESSMENT

The BoA had felt that the contested mark had no “meaning” against which to draw a conceptual comparison with the Foundation’s mark. In this appeal, the GC considered that there was a conceptual similarity, as the contested mark includes the word “Halloumi” and an image of grilled cheese, but the degree of conceptual similarity was low. This was because of the presence of additional words and concepts – “vermion” and “belas” – which added more whimsy to the mark.

Assessing the likelihood of confusion, the GC emphasised that the element of similarity between the signs (ie, the word “Halloumi”) had only weak distinctive character. It follows that the impact of the similar elements on the likelihood of confusion would also be low.

Even having found that the BoA made some errors in its assessment in both the comparison of the goods and of the marks themselves, the GC reached the same conclusion as the BoA, finding no likelihood of confusion between the marks.

### BAD FAITH?

The Foundation argued that the BoA had erred when testing for bad faith

because it had started from the wrong premise: namely, that the Foundation’s mark was purely descriptive. The Foundation also asserted that the wrong test was used, since the BoA found no dishonest intention from the proprietor of the contested mark, arguing that this was not the appropriate criterion under the Court’s case law.

The GC did not see an inconsistency: bad faith presupposes a dishonest state of mind, and this must be understood in the trade mark context of the course of trade. This is equivalent to the question of whether use of a mark is in accordance with honest practices in industrial or commercial matters. Even if the applicant knew a third party was using a similar or identical sign, this is not sufficient to lead to a conclusion of bad faith. The Foundation’s request for invalidation was again refused.

### IMPLICATIONS

This decision will have come as a blow to the Foundation, with the GC emphasising that the collective word mark HALLOUMI for cheese does not confer “an exclusive right to use the word ‘Halloumi’... in all circumstances”. In this case, the Applicant for the contested mark, not a member of the Foundation, was allowed to continue using its contested mark.

The GC stressed the weakness of the Foundation’s mark as a distinctive trade mark and echoed the comments of Advocate General Juliane Kokott in another matter involving the Foundation<sup>1</sup>, that the protection required could be better achieved by the geographical indication rules.

Overall, this latest judgment may give pause to those seeking to enforce collective marks, particularly descriptive or non-distinctive ones.

1 [2020] C-766/18

### KEY POINTS

- + This is the latest chapter in a long-standing series of invalidity proceedings
- + The General Court upheld the decision of the Board of Appeal, despite identifying various (relatively minor) errors in its decision
- + The General Court suggested that marks such as the collective word mark HALLOUMI, which is not distinctive, may be better protected under the rules relating to protected geographical indications

### MARK

THE CONTESTED MARK



Ellie Wilson

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# Safety Bull takes all

For Peter Collie, this case is an interesting illustration of conceptual meaning's role in finding indirect confusion

**DWS Group Ltd** (the Applicant) applied to register the device mark shown opposite. The application mainly covered a range of goods and services for safety and security – for example, “alarm systems” and “fire extinguishers” in class 9 – along with services for the installation and monitoring of security alarms and apparatus in classes 37 and 45.

The application was opposed by MG Contractors ApS (the Opponent), owner of EU trade mark No. 018010080 (the Earlier Mark, shown opposite) which

covers “safety apparatus [for the prevention of accident or injury]” in class 9. The opposition was based on the likelihood of confusion.

## COMPARISON OUTCOMES

The Earlier Mark was not old enough to be subject to proof of use requirements. Varying degrees of similarity were found between the Applicant's goods and services and the category of goods covered by the Earlier Mark. Identity was found between the Applicant's security alarms and other safety apparatus such as “fire extinguishers”, which fell within the category of goods covered by the Earlier Mark. A medium to high level of similarity was found between the Applicant's services (such as the installation of security apparatus) and the goods covered by the Earlier Mark on the basis of overlapping purpose and trade channels, along with complementarity.

All of the remaining goods in the application, such as “Fire proofing preparation” (class 1), “Building materials; metal cupboards” (class 6) and “First aid medical apparatus for sale in kit form” (class 10), were found

IN CASE OF EMERGENCY  
BREAK GLASS



to share at least a low level of similarity with the goods covered by the Earlier Mark.

The Hearing Officer's (HO) finding of similarity for some of these goods appears to have been aided by the Applicant's counterstatement, in which it conceded that there is "low similarity" between its goods and services and the goods covered by the Earlier Mark.

Because the specifications of both marks cover goods and services for safety or security, some of which may even require consultation with professional experts

*“ Even the most attentive of consumers may associate two signs if the conceptual link is strong enough*

prior to purchase, the HO found that they will be purchased with a level of attention in the "high to very high range" and would be purchased by both the general and professional public.

As to the marks, the HO found a low to medium level of visual similarity, a low level of aural similarity, and a medium to high level of conceptual similarity.

The HO highlighted the conceptual significance of the "bull" element in both marks and suggested that it would "invoke the idea of strong and robust equipment to protect the person and property from harm". Both marks were found to convey the concept of safety.

### CONFUSION

The HO emphasised the high level of attention likely to be paid during the purchasing process and that there is likely to be a visual inspection of the goods and services either online or in a shop.

In relation to direct confusion (where the consumer mistakenly matches the later mark for an imperfect image of the earlier mark in their mind), the HO found that the visual differences between the marks are sufficient to rule out a likelihood

of direct confusion in respect of all the Applicant's goods and services.

However, the HO concluded that despite the visual differences between the marks, there was a likelihood of indirect confusion (where the consumer recognises that the later mark is different from the earlier mark but still considers the two undertakings to be economically linked) in respect of all the Applicant's goods and services. Consequently, the opposition succeeded for all goods and services.

### AUTHOR'S ANALYSIS

Fundamentally, the differing outcomes between the assessments of direct and indirect confusion came down to the conceptual overlap between the marks.

The decision illustrates that a strong conceptual component in a mark (in this case, the notion of a bull that has protective or safeguarding qualities) can be a crucial factor for a finding of indirect confusion if that same concept is identifiable in a later mark. Even the most attentive of consumers may associate the two signs if the conceptual link is strong enough.

In this case, the conceptual similarity overrode multiple other factors that were generally in favour of finding no likelihood of confusion, such as visual differences between the marks, goods that shared no more than a low degree of similarity with the Opponent's goods, and an average consumer with a "high to very high" level of attention. This emphasises the potentially far-reaching impact of conceptual elements on a mark's scope of protection.

The significance of conceptual overlap between marks in terms of a likelihood of confusion must be assessed on a case-by-case basis. However, this decision suggests that it is a consideration that should not be underestimated.

### KEY POINTS

- + Conceptual meaning within a mark can be a powerful tool for blocking third-party marks on the basis of indirect confusion, even for marks which are visually and aurally not closely similar
- + A highly attentive average consumer may be indirectly confused where two marks share a clear conceptual notion

### MARKS

THE APPLICANT'S MARK



THE OPPONENT'S EARLIER MARK

**Safety Bull**



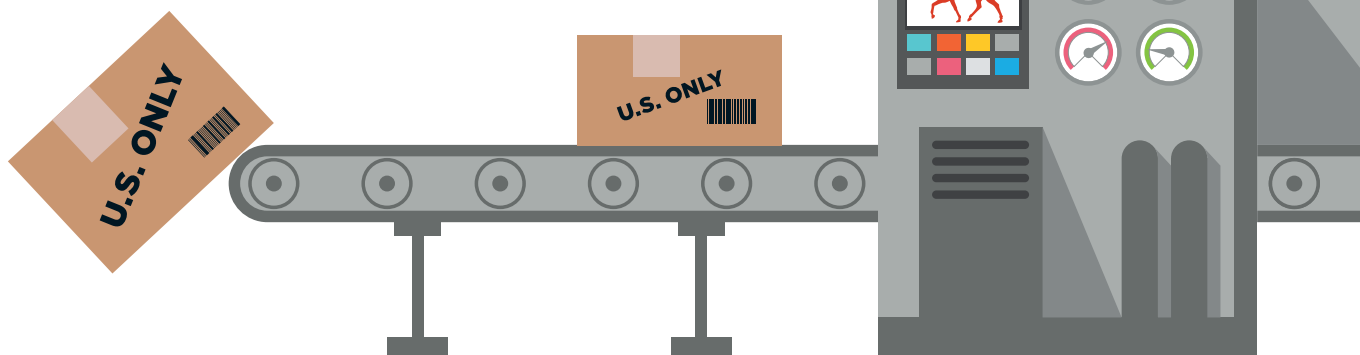
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# BHPC is boxed in

Joel Smith discusses why the judge rejected the Claimants' arguments entirely



**This case involved** a dispute between the owners of the Beverly Hills Polo Club (BHPC) brand and Amazon in relation to the listing and sale of genuine, branded products on Amazon.com for sale to consumers in the UK and the EU.

The High Court provided a reminder of its approach to determining whether a website is targeting consumers in the UK, meaning that the UK court has jurisdiction to determine a claim for trade mark infringement.

## PARTY POSITIONS

The Claimants, Lifestyle Equities CV and Lifestyle Licensing BV (Lifestyle), were the owner and exclusive licensee, respectively, of the well-known BHPC trade marks in the UK and EU. Both companies are owned and controlled by one Mr Haddad. Complexity arose because the ownership of the BHPC brand globally is split between the US and the UK/EU. In the US, the trade marks for BHPC are owned by BHPC Associates LLC, a company controlled by Mr Haddad's brothers.

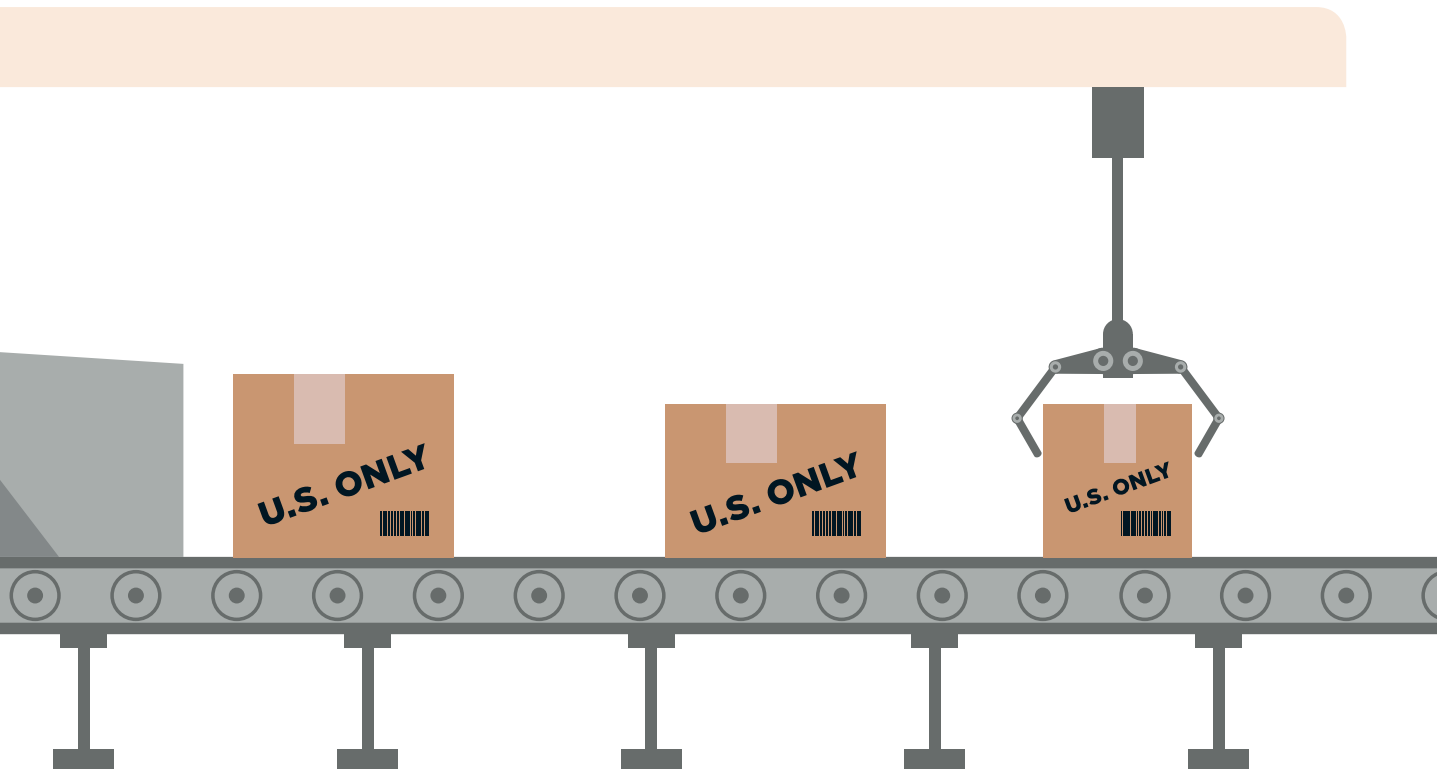
Lifestyle brought proceedings for trade mark infringement and/or passing off against various Amazon entities (not just the UK entity, but two US entities and two Luxembourg entities). It alleged that the BHPC goods, lawfully manufactured, marketed and sold in the US with the consent of the US trade mark owner, were being listed and sold through Amazon.co.uk and Amazon.com to UK and EU consumers,

thereby infringing the trade mark rights of Lifestyle in the UK and EU and amounting to passing off.

The evidence appeared to suggest that BHPC Associates LLC did not object to the sale of the products outside the US, in contrast to Lifestyle, which was extremely concerned about the sales and claimed that this form of "counterfeiting" was destroying its business in the UK and EU.

BHPC branded goods were listed and could be purchased in the UK/EU through four of Amazon's business models. These were: Amazon Exports-Retail, through which goods purchased from Amazon.com could be shipped to the UK; FBA (Fulfilled by Amazon), where third-party sellers list their products on Amazon.com but Amazon handles the payment, shipping and delivery; MFN (Merchant Fulfilled Network), through which third parties sell internationally to customers in the UK by advertising on Amazon.com and whereby Amazon takes payment but does not arrange shipping and delivery; and Amazon Global Store, where a customer on Amazon.co.uk or Amazon.de can access listings on Amazon.com.

All of these Amazon business models were examined by the Court. For the purposes of the trial, the parties agreed for the Court to examine a representative transaction (made by carrying out a test purchase) for each of the four Amazon business models to determine questions of liability.



“ *Targeting was the main issue in this case. The mere fact that a website is accessible is not sufficient* ”

#### LIABILITY QUESTION

The Court focused exclusively on the question of liability for trade mark infringement, as it found that the case on passing off added nothing and that the parties had not advanced further argument on this point.

Targeting was the main issue in the case. The Court referred to Lord Justice Floyd’s comments in *Argos Ltd v Argos Systems Inc.*<sup>1</sup>, where it was made clear that targeting was essentially a jurisdictional requirement when it came to assessing whether trade mark law in the UK was engaged. The mere fact that a website is accessible to consumers in the jurisdiction is not sufficient. The consumers must be targeted.

The Court went on to consider the useful summary of EU law set out by Lord Justice Kitchin (as he then was) in *Merck KGAA v Merck Sharp & Dohme Corp & Others.*<sup>2</sup> The question of targeting must be considered objectively from the perspective of consumers in the UK, looking at all relevant circumstances such as the size of a trader’s business, the nature of the products and

the number of visits made by customers to the trader’s website. It also includes taking into account the subjective intention of the trader concerned, as considered in the *Argos* case. There, Floyd LJ thought that the intention of the website operator was a relevant factor if the operator took deliberate steps to target internet activity in a jurisdiction and to market to consumers there (such as by including the UK in a list or map of territories covered).

The question here was whether the listing of the product itself on Amazon.com targeted consumers in the UK/EU, not whether the whole of Amazon.com did so. The Court found that whether you looked at it from the consumer’s perspective, or at the (limited) data as to sales and viewings from Amazon’s, it was clear that the products listed were not targeted at these consumers. As the evidence from the Claimants showed, the number of sales were small, but the Claimants’ case was aimed primarily at blocking all visibility of the listings to UK/EU consumers. The complaint essentially amounted to an objection to the mere accessibility of the listings on the websites (and the information within those listings), rather than an attempt by the Defendants to target consumers in the UK/EU.

#### USE CONSIDERED

The Court took a detailed look at the case law related to “use” of a trade mark and also whether use was “in the course of trade”. ▶

#### KEY POINTS

- ✦ This case provides a useful review of the law on liability for online platforms outside the UK advertising and selling branded goods to UK consumers
- ✦ The key to establishing the jurisdiction of the UK courts is to see if UK consumers were “targeted”, not merely that a site based overseas is accessible in the UK



In particular, it considered the case of *Blomqvist v Rolex SA*<sup>3</sup>, in which the question was whether the purchase and import from outside the EU of a counterfeit Rolex watch by an individual in Denmark amounted to a commercial activity that could be prevented by EU customs regulations. The Court here concluded that sales of goods that take place outside the UK/EU but to consumers in the UK/EU (and which are not preceded by targeted offers or advertisements for sale, and whether or not they are from an online seller) are not in themselves “use in the course of trade” within the UK/EU and do not constitute infringements of UK/EU trade marks. In fact, here the individuals were purchasing the BHPC goods in a purely private capacity, which cannot be an infringing use in the course of trade.

#### JOINT LIABILITY

The Court reminded itself that the law on joint tortfeasance by common design is as stated in *Sea Shepherd UK v Fish & Fish Ltd*.<sup>4</sup> As Lord Neuberger stated there: “Three conditions must be satisfied. First, the defendant must have assisted the commission of an act by the primary tortfeasor; secondly, the assistance must have been pursuant to a common design on the part of the defendant and the primary tortfeasor that the act be committed; and, thirdly, the act must constitute a tort as against the claimant.” However, given the conclusion on use in the course of trade, there could be no joint liability between the individual and any of the Defendants. Similarly, given that the Court found none of the third-party sellers liable (based on targeting), it followed that none of the Amazon parties could be jointly liable with a third-party seller. The case on joint liability therefore failed.

The Court declined to rule on the question of quantum in relation to trivial infringements pre-2019 by the Amazon Global Store, which the Defendants admitted, but instead encouraged the parties to agree the order rather than order an inquiry as to damages.

#### USEFUL REVIEW

This case involves a useful further review of the law on the liability for online sales platforms advertising and selling branded products from outside the UK to consumers in the UK, and whether an online platform may be liable for supplying or fulfilling the supply of those branded products. It looks in detail at the law on targeting, which spells out that there is no jurisdictional basis to find trade mark infringement in the UK if the listing on the website does not target UK consumers, but is merely accessible by such consumers – even if some of those consumers may go on to purchase the products.

Although the Claimants tried to make the case that Amazon was seeking to supply counterfeit products, which they alleged undermined their business in the UK/EU, the judge rejected that notion completely. He found that Amazon had acted entirely

“ *The goods were purchased in a private capacity, which cannot be an infringing use in the course of trade* ”

reasonably at all times, including by attempting to put in place a set of product restrictions to prevent the cross-listing, sale and shipping of certain BHPC products to consumers in the UK/EU. The Claimants were attempting to block the visibility of the goods for commercial reasons, partly to do with the split ownership of the brand.

*The case is on appeal and will be heard shortly.*

1 [2018] EWCA Civ 2211, para 48

2 [2017] EWCA 1834

3 [2014] C-98/13

4 [2015] UKSC 10



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# Watch what you say

Helene Whelbourn explains how a bit of silence went a long way for Swatch

**This is a** successful appeal by Swatch against the refusal of its applications for SWATCH ONE MORE THING and ONE MORE THING following oppositions by Apple. The decision examines the intentions behind the filing of the applications and whether or not those intentions could have amounted to bad faith. The case is another example where evidence is key. Speculation on intentions is insufficient to succeed in showing bad faith.

## PAST HISTORY

Swatch applied to register the trade marks SWATCH ONE MORE THING and ONE MORE THING in the UK as designations of the international registrations 1281231 and 1281232. The designations were filed in classes 9 and 14 and covered a wide range of goods, including watches and consumer electronics.

Apple opposed the applications under Sections 5(4)(a) and 3(6) of the Trade Marks Act 1994. The objection under s5(4)(a) was made under the common law of passing off and was based on Apple's goodwill in the phrase ONE MORE THING. The objection under s3(6) was on the basis that the applications were made in bad faith, as Swatch would have been aware of Apple's reputation in the phrase, the circumstances in which the applications were filed, and the likely use Swatch would make of the trade marks.

Apple's use of the phrase ONE MORE THING stemmed from its use at launches of Apple products. Steve Jobs would end his presentation, turn to leave the stage and then return saying: "But there's one more thing". The evidence included compilations of ONE MORE THING moments created by Apple fans on YouTube.

The evidence also included an article from thenextweb.com entitled "Swatch has trademarked Apple's iconic 'One More Thing' catchphrase in an epic troll move", which makes references to Swatch poking fun at Apple.

Apple interpreted the applications filed by Swatch as aggressive and retaliatory, following the corresponding dispute over I-WATCH and I-SWATCH. Swatch has also filed an application for TICK DIFFERENT, which Apple claims was a reference to its THINK DIFFERENT trade mark.

In the original opposition decision, the Hearing Officer (HO) rejected the opposition under s5(4)(a) – passing off – on the basis that the use made of the phrase by Apple did not amount to use that would turn the phrase into a "distinguishing element" and ▶

“ Speculation on intentions is insufficient to succeed in showing bad faith



would be taken as an indication of the origin of the products. The HO also found that the public would not be deceived.

The opposition was successful under s3(6) – bad faith. In the opposition case, Apple speculated on the reasons why Swatch had filed the applications, but its primary case at the hearing was that the application was made as a blocking application. However, Apple had not pleaded that as part of its opposition and had stated in the notices of opposition:

“In full knowledge of Apple’s reputation in the ONE MORE THING mark, the Applicant has sought to hijack that mark for its own benefit, either to parody Apple, divert trade from Apple or make use of the reputation subsisting in that mark. The Applicant’s conduct therefore evidently falls short of the standards of acceptable commercial behaviour observed by reasonable and experienced men in the particular area being examined.”

The HO had observed that the grounds of opposition were all actions that required Swatch to actually use the trade marks and so were not filed solely with the intention to block Apple’s use. The HO rejected Apple’s arguments that the grounds were sufficiently broad to cover blocking applications and also refused permission to amend the grounds of opposition to include that allegation.

The HO considered the three grounds on which bad faith was claimed, labelling them “parody”, “diversion of trade” and “making

use of reputation”. The HO rejected the arguments under “diversion of trade” and “making use of reputation”, as to do otherwise would be inconsistent with the decision under s5(4)(a).

The HO did uphold the oppositions on the basis that the applications were filed with the purpose of obtaining an exclusive right that would enable Swatch to engage in commercial parody at the expense of Apple. It was observed that Swatch had not filed any explanation or evidence of its actual intentions behind filing the applications and so had done nothing to displace the arguments. In making the decision, the HO referred to [thenextweb.com](http://thenextweb.com) and other similar articles and the fact that the parties were “already at loggerheads” on other issues.

#### APPEAL

The appeal by Swatch was distilled in the decision to three main points:

(i) Apple’s case on bad faith was predicated on the basis that Apple had enforceable goodwill in its unregistered right ONE MORE THING. As the HO had determined under s5(4)(a), there was no goodwill and so the opposition under s3(6) should also have failed.

(ii) The HO had no evidential basis on which to reach the decision under s3(6).

“ Parodic use is not sufficient to amount to bad faith, particularly bearing in mind the principle of freedom of expression



Swatch relied on *Campbell v Hughes* (IAN ADAM trade mark)<sup>1</sup> to assert that the HO, while entitled to draw inferences from the proven facts, ought not to allow the assessment “to degenerate into an exercise in speculation”; and on *Red Bull GmbH v Sun Mark Ltd*<sup>2</sup> to note that bad faith was a serious allegation that must be distinctly proved and that an applicant was presumed to have acted in good faith unless the contrary was proved. Fundamentally, it is “not enough to prove facts which are also consistent with good faith”.

(iii) An intention of parodic use was not in any event sufficient to amount to bad faith, particularly bearing in mind the principle of freedom of expression (Human Rights Act 1998, s12).

Mr Iain Purvis QC dismissed argument (i), agreeing with Apple that s3(6) is a free-standing objection and “does not require any enforceable right in the mark in the UK”, even though Apple thought it had such a right. He accepted that Swatch’s arguments under (ii) and (iii) required further consideration, however.

Mr Purvis disagreed with the HO’s findings in relation to Swatch’s intentions in filing the applications. Accepting the HO’s statement that the applications were filed as a retaliatory measure with some form of objective of upsetting Apple, he then dismissed that there was a *prima facie* case of intention to parody and found that it had not been established in evidence.

The conclusion was reached based on the following points:

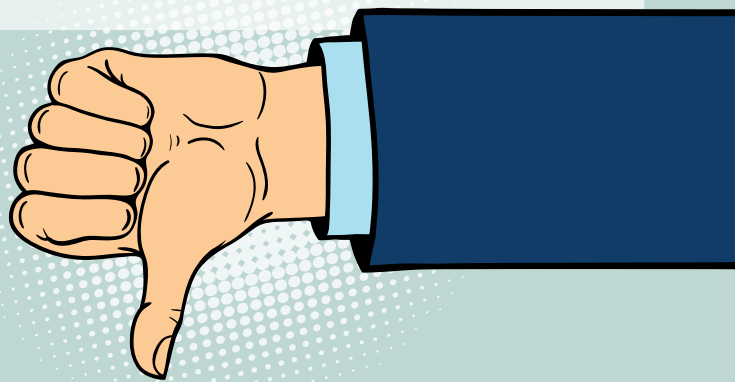
(a) Apple (and the HO) relied on third-party online comments. It was held that the comments had no evidential value since the authors could not have known Swatch’s actual intentions.

(b) The HO was entitled to be unimpressed by Swatch’s failure to express its actual intentions behind filing the applications, but that did not prove anything.

(c) There was no evidence that Swatch made a habit of parody.

(d) It was not clear how such parodic activity would have any benefit when the phrase was only associated with Apple by a small number of people.

Consideration was also given to whether the fact that Swatch was motivated to annoy Apple was sufficient to amount to bad faith. However, this was ultimately dismissed – in part because it was not pleaded but also because Mr Purvis held that he “did not think it can”.



“ The HO could not have any clear idea of how Swatch would use the trade mark, so it could not be concluded that it was filed in bad faith

#### NO OBVIOUS DISHONESTY

Considering (iii), Mr Purvis considered that “poking fun” and parody were not inherently dishonest business practices, stating: “The point at which parodic or humorous activity of that kind would transgress the boundaries of honest business practices must depend on the nature of the humour, the intensity of its use and its consequent impact on the business interests of the recipient.”

The HO could not have any clear idea of how Swatch would use the trade mark because no evidence was filed to show such use, so it could not be concluded that the use would meet the requirement for dishonesty that is crucial to show that an application was filed in bad faith.

It is clear from this and other decisions that the mere act of filing an application is not itself a bad faith act. The purpose behind the filing of the application and the intentions of the applicant will determine if the application was filed in bad faith. Simple speculation on those factors is not sufficient to show bad faith. In addition, bad faith requires dishonesty, and parody is not necessarily a dishonest practice.

1 [2011] RPC 21, para 35  
2 [2012] EWHC 192 (Ch), para 133

#### KEY POINTS

- + To demonstrate bad faith, evidence of the applicant’s purpose or intentions is needed
- + Keeping entirely quiet about one’s intentions, as Swatch did in this case, can sometimes prove strategically advantageous



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# Confusion is a complex concept

The courts are bound to take in the bigger picture, writes Beverley Potts

**This was an** appeal against a successful trade mark infringement and passing off claim before Her Honour Judge Melissa Clarke in the Intellectual Property Enterprise Court, British Amateur Gymnastics Association v UK Gymnastics & Others.<sup>1</sup> The Claimant, the British Amateur Gymnastics Association (BAGA), is recognised by Sport England as a National Governing Body (NGB) for gymnastics in the UK. It is the proprietor of two UK registered trade marks, each of which is a series of two marks, as shown overleaf.

The main Defendant, UK Gymnastics Ltd (UKG), had advertised, offered and provided membership services to gymnasts, gymnastics clubs and coaches; competitions; courses and/or badge/certificate programmes; and educational services under and by reference to the words “UK Gymnastics” and the two logos incorporating those words shown overleaf. The judge held that UKG had infringed BAGA’s trade marks under s10(2) and s10(3) Trade Marks Act 1994 and had also committed passing off. UKG appealed that decision to the Court of Appeal (CoA) on a number of grounds.

## APPEAL DECISION

The CoA overturned BAGA’s third claim of passing off and discharged the relevant parts of the injunction, with Lord Justice Arnold giving the leading judgment. Otherwise, the appeal was dismissed.

On the issue of trade mark infringement and on comparison of signs, the judge had previously found that:

- (i) There was identity or a high degree of similarity between the services offered by UKG and the services identified in classes 28 and 41 of the trade mark filings.
- (ii) The “real difference” between UKG’s word sign and the trade marks was the use







“ *The judge was entitled to find that there was a likelihood of confusion even where the similarity of the signs was low*

of the word “UK” rather than the word “British”. These words were visually and aurally different but, because of their strong conceptual similarity, there was, on a global appreciation, a medium degree of similarity of the word sign to the trade marks; and

(iii) The logo signs had a low degree of similarity, although the similarity was slightly greater in the colour version in the series of each trade mark. The Union Jack elements did not materially increase the conceptual similarity with the trade marks, which was already very strong.

In making these assessments, the judge had emphasised the principles set out in *Specsavers International Healthcare Ltd v Asda Stores Ltd*<sup>2</sup>, namely that:

(1) A lesser degree of similarity of marks could be offset by a greater degree of similarity between the goods or services;

(2) There is a greater likelihood of confusion where the earlier mark has a highly distinctive character, which was accepted to be the case with BAGA’s trade marks; and

(3) The average consumer rarely makes direct comparisons and must rely upon imperfect recollection of the marks.

On balance, the judge had been satisfied that there was a likelihood of confusion for those paying a lower degree of attention, such as child gymnasts or their parents, who may see the signs while attending sporting events and mistakenly believe UKG was the only NGB for gymnastics in the UK.

The Defendants, however, alleged that this finding was inconsistent because it

should have concluded that both the word and logo had a low degree of similarity. While the degree of visual and aural similarity was low, a strong degree of conceptual similarity was found in relation to both types of mark. However, the CoA did not consider the different findings for the two types of mark to be problematic and did not think that the judge had made an error of principle in arriving at her conclusion following a multifactorial evaluative assessment. The logos included visual elements not present in the word sign (ie, block capitals, more prominent words and the flag elements), which allowed a differential assessment of the level of similarity. In any event, it made no difference to the overall conclusion because the judge was entitled to find that there was a likelihood of confusion even where the similarity of the signs was low.

#### NO ERROR ON CONFUSION

UKG also argued that the judge had been wrong to find a likelihood of confusion. There was only one incidence of confusion, which involved an employee, and UKG had not been made aware of any instances of actual confusion. UKG considered this to be significant given that the two organisations had been running in parallel since 2012/2013, and the absence of evidence of confusion becomes more significant the longer the period of trade (relying upon *Stichting BDO v BDO Unibank Inc.*<sup>3</sup>). However, the CoA did not think that the judge had made any error in accepting that the small scale of UKG’s operations (compared with that of BAGA) meant that it was very possible that any confusion could have been “masked” or not brought to BAGA’s attention. It is always relevant to consider what opportunity there has been for confusion to occur and what opportunity there has been for any such

#### KEY POINTS

- + The assessment of likelihood of confusion is multifactorial, and conceptual similarity can play a key role, even when the marks don’t look or sound alike
- + There can be trade mark infringement and passing off without evidence of actual confusion. An absence of actual confusion can become more significant the longer the parties have traded in parallel, but it is also important to consider what opportunities there have been for confusion to occur and be detected
- + Particular care needs to be taken to the specific allegations set out in the statements of case. Judges and parties cannot stray from these and amendments should be made where necessary
- + You need an error of principle to overturn a finding of likelihood of confusion



confusion to be detected (as per Samuel Smith Old Brewery v Philip Lee<sup>4</sup>).

### NGB STATUS

UKG appealed the judge's finding that UKG was not an NGB for the sport of gymnastics in the UK. Recognising the difficulty that this was a finding of fact, the challenge was based on weak arguments regarding definitions that were swiftly dismissed by the CoA. The judge's finding was clearly open to her on the evidence and was not surprising given that the sole director of UKG admitted in cross-examination that "we are not a National Governing Body".

UKG also objected to the judge's ruling that it had engaged in passing off because there was a misstatement on its website claiming that it was an NGB when this wasn't the case. The CoA agreed that this allegation hadn't been pleaded. Instead, the Particulars of Claim alleged that UKG had misrepresented that BAGA had conferred NGB status on it. The judge had not considered whether UKG had made that misrepresentation, so she had found UKG liable for passing off on the wrong basis. It was not open to her to find passing off on the ground of a misrepresentation that hadn't been put to her.

“ Factors such as conceptual similarity can play a part in the overall assessment for likelihood of confusion

Nevertheless, this did not detract from the ruling that UKG had committed passing off by misrepresenting that UKG's services were those of BAGA, the subject of some commercial arrangement with BAGA, or that UKG was connected with BAGA in some way.

### INJUNCTION ISSUE

The passing off injunction as granted by the judge included wording that UKG was to be prevented from "denoting some form of official or approved status" or "asserting to be a National Governing Body contrary to fact". For the reasons set out above, these parts of the injunction extended beyond the pleaded case. In addition, the wording was considered by the CoA to be ungrammatical and unclear as to what UKG could and couldn't do. Finally, as there was no definition of an NGB, the scope of the last part was uncertain. Accordingly, those parts of the injunction were set aside, and the scope of the injunction was narrowed.

### CONFIRMATION

Ultimately, the CoA has confirmed that trade mark owners can succeed in an infringement and passing off action despite there being no evidence of actual confusion. Even where the marks have a low level of aural and visual similarity, there can still be a likelihood of confusion, and factors such as conceptual similarity, the distinctive character of the earlier mark, similarity of services and the level of attention of the relevant consumers can play a part in the overall assessment. This case is also a reminder that the wording of injunctions needs to be clear and precise and correspond to the case as pleaded.

1 [2020] EWHC 1678 (IPEC)

2 [2012] EWCA Civ 24

3 [2013] EWHC 418 (Ch)

4 [2011] EWHC 1979 (Ch)

### MARKS

BAGA'S  
TRADE MARKS

UK No. 3226097

British  
Gymnastics  
More than a sport.

British  
Gymnastics  
More than a sport.

UK No. 3281771

British  
Gymnastics

British  
Gymnastics

UKG'S MARKS

UK GYMNASTICS

UK  
GYMNASTICS



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Our Autumn Conference is on its way! See registration details at [citma.org.uk/events](https://citma.org.uk/events)



# Calendar

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

DATE	EVENT	LOCATION	CPD HOURS
30th June	CITMA Webinar South American trade mark round-up	Online	1
7th July	IP Inclusive - North of England network birthday event	Online	1
9th July	Picnic in the park for Bristol Pride	Castle Park, Bristol	
15th July	CITMA Webinar Brexit and designs	Online	1
21st July	CITMA Webinar Hot property: The scope and scale of global counterfeiting	Online	1
8th September	CITMA Webinar Ethical considerations in advising clients	Online	1
22nd September	CITMA Paralegal Webinar* Oppositions and disputes	Online	1
12th October	CITMA Paralegal Seminar	Online	3
14th-15th October	CITMA Autumn Conference	Online	6
20th October	CITMA Webinar Brand protection: Facing the digital surge	Online	1
21st October	CITMA Student induction	Online	1
4th November	CITMA Webinar Contentious proceedings at the UK IPO	Online	1
16th November	CITMA Webinar EU case law update	Online	1
25th November	CITMA Paralegal Webinar* Renewals and maintenance	Online	1
15th December	CITMA Webinar UK case law update	Online	1

■ CITMA event ■ IP Inclusive event

\*Sponsored by CDN Consular



# THE TRADE MARK 20

Q&A



## Gifty Gakpetor

Tea and biscuits are her touchstones

**I am...** the Director and owner of IPTogether Ltd.

**Before this role, I was...** the sole in-house trade mark attorney for PepsiCo (UK & Ireland).

**My current state of mind is...** optimistic, fuelled by the roll-out of the COVID-19 vaccinations and the easing of lockdown.

**I became interested in IP...** when I landed a job at Carpmaels & Ransford. I embarked on a law degree while holding down a full-time job there, initially as a Patent Formalities Clerk but rising to become the firm's first Paralegal, assisting its in-house IP lawyer. That was the opening of a door.

**I am most inspired by...** a sense of business and social purpose. It keeps you focused. As Steve Jobs said: "Your time is limited, so don't waste it living someone else's life".

**In my role, I most enjoy...** the varied work, which stretches you to bring creative solutions to the client.

**In my role, I most dislike...** spending so much time putting together cost estimates, which don't get you anywhere, and you cannot charge for the time you spent producing them.

**In front of me right now is...** a cup of tea. It's that time of the day.



**My favourite mug says...** Manchester United. My son is a fan.

**My favourite place to visit on business is...** anywhere near a pub. I love a pub lunch.

**If I were a trade mark/brand, I would be...** Aunt Bessie's. It's one of the brands I worked on as a trainee, and it's still going strong! In the current economic climate, we all need that kind of resilience to survive, whether as a business or as an attorney.

**The talent I wish I had is...** tight-rope walking. How do they balance themselves?

**The biggest challenge for IP is...** the influx of trade mark applicants not seeking professional guidance. The resulting lack of IP strategy in their businesses could have a

long-term effect on the economic landscape. Should CITMA and IP lawyers be lobbying for professional representation before the UK IPO to become mandatory?

**I can't live without...** McVitie's biscuits with tea.

**My ideal day would include...** a walk with my husband and relaxing with tea and biscuits on my return.

**In my pocket is...** nothing. Women's clothes are often without pockets. I don't know why.

**The best piece of advice I've been given is...** take it small when you attend INTA, or else you could be overwhelmed. This advice, given to me by an old boss at PepsiCo, worked well for me at INTA in Barcelona when I first set up my company and ventured out for clients.

**When I want to relax...** I read a book with tea and cake by my side.

**In the next five years I hope to...** have travelled to Singapore. I missed the opportunity when INTA was cancelled because of the pandemic.

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IP

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