

# CITMA REVIEW

ISSUE 432

MARCH/APRIL 2017

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**T**his year is shaping up to be as busy and exciting as the last, with negotiations ongoing with the UK IPO and UK Government on the IP landscape post-Brexit; a formal CITMA delegation to WIPO in Geneva; and the imminent user group meeting with EUIPO in Alicante. We continue to emphasise CITMA members' important contribution to IP in the UK, and the need for early certainty on the law and rights of representation. However, this edition of the *CITMA Review* highlights the breadth of other issues that occupy members, with discussions on traditional cultural expressions and format rights, as well as practice-related articles on fees, CVs and mediation.

IP Inclusive is a key focus for us this year. I therefore very much welcome the article from Alison Madgwick on supporting neuro-atypical colleagues.

I look forward to seeing many of you at our Spring Conference – another opportunity to catch up on the varied topics that make up the day of a CITMA member.

*Kate O'Rourke*

**Kate O'Rourke**  
CITMA President

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

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## CITMA | INSIDER

# Brexit update: Irish representation option

**CITMA'S BREXIT** Task Force continues to look at the issues and options with regards to rights of representation. A subgroup has been set up to consider the options for qualification as an Irish trade mark agent, something that we know some CITMA members are considering.

CITMA is still committed to trying to ensure representation before EUIPO is not lost, and continues to raise the matter at every opportunity. We have been discussing the issue with the UK IPO and have recently written to the Ministry of Justice (MOJ), which has an interest in rights of representation for the legal profession more generally. The Law Society has submitted to the Department for Exiting the European Union and the MOJ a report that raises the issue of rights of representation. We are also seeking to meet with both departments to discuss the situation for Chartered Trade Mark Attorneys specifically.

In the meantime, we hope the following provides some useful information in relation to qualification in Ireland.

### REQUIREMENT RECAP

Article 93 of Council Regulation (EC) No 207/2009 requires that a professional representative before EUIPO must be:

- (i) a national of a Member State in the European Economic Area (EEA);
- (ii) entitled to act before a trade mark office of a Member State of the EEA;
- and (iii) have a place of business in an EEA Member State.

However, s86 of the Irish Trade Marks Act, 1996 adds a further requirement

that, to be entitled to act as an Irish trade mark agent, an individual must also be resident in an EEA Member State.

The UK may leave the EEA as well as the EU, and the Irish Patents Office has the authority to remove an existing trade mark agent from the Irish register if that agent loses their entitlement. As such, a CITMA member currently qualifying as an Irish trade mark agent may lose their entitlement and be vulnerable to having their name removed from the Irish register.

### UPCOMING EXAM

Nevertheless, for those interested in qualifying as an Irish trade mark agent, qualification is by a single exam, set this year for 25th April 2017. Applications need to be submitted by **31st March 2017** (exam fee: €200).

For further information on the exam, visit [bit.ly/IrishTMEexam](http://bit.ly/IrishTMEexam).

A candidate needs to obtain a 50 per cent pass rate on each of sections A (Irish trade mark law), B (trade mark practice) and C (EU trade mark practice).

The Irish Patents Office has also recently announced that the exam will, for the first time, include one optional question on industrial designs.

For those interested, Bloomsbury Professional is offering CITMA members a 20 per cent discount on the recently published fourth edition of *Intellectual Property Law in Ireland*. The discounted price will be €196, plus €5.50 postage. Please contact [jennifer.simpson@bloomsbury.com](mailto:jennifer.simpson@bloomsbury.com) to place an order.

We have recently sent members an update on the other work we have been doing with regard to registered rights, and updating the information in the resources section of the CITMA website. For more information about rights of reputation and analysis of potential post-Brexit scenarios, visit [citma.org.uk](http://citma.org.uk)



## Member *moves*



Tomkins has announced that it has welcomed [Seamus Doherty](#) and [Judy McCullagh](#) as partners. They can be contacted at [sdoherty@tomkins.com](mailto:sdoherty@tomkins.com) and [jmccullagh@tomkins.com](mailto:jmccullagh@tomkins.com), respectively.

## New IP minister appointed



CITMA welcomed the appointment in January of Jo Johnson MP as Minister for Intellectual Property. CITMA President Kate O'Rourke commented: "We are looking forward to working closely with Jo Johnson MP, and we would like to congratulate him on the new appointment. Collaboration when planning for the challenges that lie ahead, including the UK's exit from the EU, will be vital."

### Firms expand operations

- Appleyard Lees has opened a new office in Cambridge. The firm currently works with UK and multinational businesses across all continents and technical areas, and has a strong presence in the university sector. Cambridge is considered to be a key location to enable the firm to provide local support to some of the country's most innovative companies.
- HGF has opened a second Dutch office. Its Amsterdam office opened in January and launched the next phase of HGF's European expansion.

### FAST FACTS – JO JOHNSON MP

- Johnson has been MP for Orpington since May 2010, and was appointed Minister of State for Universities, Science, Research and Innovation in July 2016.
- He began his schooling in Brussels and speaks French.
- He was a scholar of modern history at Balliol College, University of Oxford, receiving a first-class degree.
- He has previously worked as an investment banker at Deutsche Bank. Johnson joined the *Financial Times* in 1997, serving in two foreign posts and becoming Associate Editor in 2008.
- He is the brother of Foreign Secretary Boris Johnson.
- He tweets [@JoJohnsonMP](#).

JO-JOHNSON.COM

## Reader book review

*Aaron Wood has a strong reaction to Fragile by Peter Rouse*

**THE LIFE OF** a lawyer can be a hard one. Colleagues pick through every email you write for signs of weakness; work systems are focused on avoiding negligence; senior partners worry about praising anyone too highly in case they come to expect a bonus or think they are in line for partnership. At all levels, many are constantly in fear of their clients not approving of their most recent piece of work.

This is not just my own view; it is echoed in *Fragile*, which provides the starting point for dealing with the myriad issues that stem from the broken way in which many law firms work. The book starts with the individual and, from there, radiates out, taking in issues of self-management, people management and client relationship management.

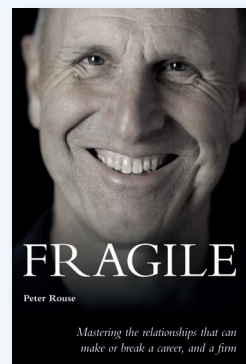
The tag line on *Fragile's* front cover is: "Mastering the relationships that can make or break a career, and a firm". It is my belief that the values espoused in this book reflect the very best practices towards clients, colleagues and yourself.

As someone who started a firm in 2015, I can see immediate value in this book for all practitioners.

I struggle to know whether to recommend it more to senior partners, as a practical guide to how to mould your firm to get the best out of your people; or to the rest, as a reassurance that there is another way to practise, and that some firms will deliver on their promise to support you, respect you and allow you to develop without the blocks of ego and fear.

*Fragile*, Peter Rouse, *Fragile Books* (October 2016)

Paperback, 176 pages; also available as an ebook ▼





# Moot turns gaze to Graze

*Jade MacIntyre summarises the lively arguments made during an educational afternoon*

In January, Bristows LLP hosted the second CITMA moot. This time, the hearing featured the recent application for a declaration of invalidity of Nature Delivered Ltd's (ND's) UK trade mark registration for the mark GRAZE in classes 29, 30, 31, 32, 33, 39 and 43, filed by Elvendon Restaurants Ltd (ER). Amanda Michaels of Hogarth Chambers sat as the Hearing Officer (HO), Daniel Byrne of Bristows represented the Respondent and Aaron Wood of Wood IP represented the Appellant.

ER had sought to invalidate ND's UK registration for the mark GRAZE based on its earlier UK registration for a logo mark (shown on this page) in class 43, and its goodwill in the GRAZING logo and the word GRAZING.

At the original hearing, the grounds for invalidation succeeded for the services in class 43, but failed in respect of the goods. Tasked with a difficult appeal, Mr Wood tried to persuade the Appointed Person (AP) that the HO had erred in refusing to find that food and drink were similar to the class 43 services of the GRAZING logo registration. Much of his argument revolved around the alleged "complementarity" of the goods covered by GRAZE and those of his client. Mr Wood engaged in a lively debate with the AP in trying to persuade her that, even if raw ingredients were not similar to the class 43 services, ready-prepared meals or food and drink items were. Mr Wood admitted later that he was walking a difficult line in trying to avoid claiming the nuts and seed snack boxes were similar to his client's services, which would support ND's claim of earlier goodwill in those goods.

In reply, Mr Byrne addressed the differences between the two marks, and the goods and the

class 43 services, and sought to draw out his client's earlier goodwill regarding the snack boxes. He also questioned whether the evidence of actual confusion provided by ER at the original hearing was sufficient to prove confusion (the evidence was the recollection by a member of ER's staff of a "flurry" of emails and phone calls from people wishing to cancel their subscriptions to ND's services).

In presiding, Ms Michaels ensured the audience understood that an appeal to the AP was generally an interactive process, with questions asked throughout. She recommended that the advocate at an appeal ensures that the AP has sufficient time to read the passages to which they are directed and to complete their notes before moving to the next point. All parties stressed the importance of preparation: the better prepared you are, the easier and more confident your arguments will be.

Jeremy Blum of Bristows then invited questions and comments from the audience. After he had brought the proceedings to a close, the consensus was that the experience was invaluable, because many attendees have yet to attend an actual appeal to the AP. ■

**Grazing**

► The GRAZING logo



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# Madrid & ME

*As official fee increases begin to bite, Jon Parker suggests an alternative way to secure your applications*

**A**s has been well publicised (and reported in this publication), recent months have seen significant rises in official fees for trade mark filings in a number of Middle Eastern countries, with the possibility of more to follow. This has meant that a region that was already expensive, particularly as few countries permit multi-class filings, is becoming prohibitively so for many companies.

As a result, rights owners are looking at a number of options for safeguarding their rights more cost-effectively. In some cases, this has meant not filing at all, or filing for fewer applications than originally planned, in an effort to manage costs. An increasing number of qualifying applicants are also exploring the use of the Madrid Protocol where it is possible to do so.

So, does filing through Madrid offer a viable alternative to rights holders looking to file in the region? In my

view it does – but in the right circumstances. Undoubtedly, however, there are some pitfalls that applicants and their representatives will need to be aware of in using this system.

## **POTENTIAL SAVINGS**

The current members of Madrid in the Middle East and North Africa (MENA) region are Algeria, Bahrain, Egypt, Iran, Israel, Morocco, Oman, Syria and Tunisia. Many MENA countries still require notarised and legalised powers of attorney (PoAs), which increases the cost burden associated with national filings. Some also require legalised certificates of incorporation, along with the PoA. Because the Madrid system enables such national requirements to be bypassed, the potential savings in using Madrid can therefore be considerable.

## **ENFORCEMENT EXPECTED?**

But is a trade mark registration obtained through the Madrid system as useful as a national filing when it

comes to enforcement? When looking at Madrid in the MENA region, one of the first things to consider is the purpose of the filing.

If the filing is merely to obtain a registration that is unlikely to be enforced, then Madrid can offer considerable cost savings, as well as a speedier route to registration, in a number of MENA countries. So, for this type of registration, the Madrid system works really well.

However, if the purpose is to obtain a registration that you expect to use for enforcement purposes, the recommendation is to consider national filings instead of the Madrid route.

Why? Well, not all member states in the region will allow you to obtain a local registration certificate for a protected Madrid designation. As such, you may find it difficult to persuade the relevant officials to take action based on a Madrid designation when you have no certificate that clearly outlines the holder's rights. Therefore, rather than obtaining a registered right that you may later have difficulty enforcing, obtaining a national filing is – while more expensive in the short term – likely to prove the most cost-effective option in the event it becomes necessary to enforce the rights conferred.

There is an exception to this caveat: it is possible to obtain at additional cost a locally issued registration





*When filing through Madrid in the MENA region, it is important to closely monitor your application(s) through ROMARIN*

certificate in both Bahrain and Oman once the designations are protected. It is recommended that applicants take advantage of this option in these countries, as it will allow them to enforce their rights through the local authorities should the need arise.

**OTHER “WATCH OUTS”**

Very few of the MENA member states act regularly as an office of origin under the Madrid system; they are mainly incoming offices. As such, if you are acting for a client that has qualification through a Middle East country, you may wish to run searches through ROMARIN to see whether anyone has filed through the country as an office of origin. Making an application in a country in which you are one of very few applicants could be a high-risk strategy. You will have to work very closely with the officials to assist them through the process.

Also remember that, when using Madrid, there are a number of obligations and deadlines on the office of origin, and the designated countries, that are outside the applicant’s control. There have been a number of cases where an applicant has lost rights because administrative steps were not taken by the relevant trade mark office.

ROMARIN is improving all the time, so, when filing through Madrid in the MENA region, it is important to closely monitor your application(s) through that database. There will be times where you will pick up on objections or issues before you are officially notified. These extra days can be invaluable for putting in place PoAs or other supporting documents to overcome objections, as the deadline to respond often cannot be extended.

As someone who has been practising in the region for 10 years, and who



made use of Madrid when still in the UK, I regularly look to use the system for clients. There have been opportunities where we have been able to use it for clients based in non-member countries, but who qualify through the real and effective presence elsewhere. However, in these situations, it is important to obtain local advice in the country through which the client is believed to qualify as to what a “real and effective presence” may mean to ensure that any international registration obtained stands up to scrutiny.

**OTHER ISSUES**

When using the Madrid system to seek trade mark registration in Arab countries, take care not to also designate Israel. In almost all Arab countries, there are provisions under local trade mark laws to raise objections based on states with which it is forbidden to deal. If, for example, an application designates Egypt, Syria

and Israel, among other countries, the Syrian designation will be refused on public morality grounds, with no chance of overcoming the objection on appeal. There is a reasonable chance that the Egyptian designation will also be refused.

To obtain protection in Arab countries and in Israel, consider making a national filing for Israel while employing the Madrid system for Arab countries to maximise the savings available pursuant to the international system.

**VIABLE OPTION**

Madrid is a viable option for use in the MENA region, particularly for rights that are not expected to be enforced regularly. However, take care to closely monitor the designations through ROMARIN to minimise any potential issues and allow for adequate preparation when official notifications come through. ■



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Jon spoke on this issue at a recent CITMA webinar.



# Signs of change

*Marion Heathcote explains why 2017 could be a promising year for progressing crucial protections of traditional cultural expressions*

**T**he protection of cultural heritage and the expressions of that heritage are integral to maintaining the identity and survival of indigenous peoples. The ability to protect, revive and teach the inherited wisdom of these peoples' ancestors depends on the discrete sustainability of traditional cultural expressions (TCEs), which include *inter alia* signs, songs, dance, handicrafts and other expressions of folklore.

While the past several decades have provided much academic discourse and international political debate about what should be protected, the entitlement to protection and the form such protection should take, this year promises to be eventful, and could potentially see a landmark shift towards a universal model in TCE protection.

WIPO has been working since 2000 with various stakeholders to develop an international framework for guidance on, and associated protection mechanisms for TCEs, traditional knowledge and genetic resources. This year, WIPO's Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC) is due to meet twice, with an agenda that will focus on TCEs. (Previous meetings focused on genetic resourcing and traditional knowledge.) The WIPO General Assembly is also meeting in October 2017 to take stock of IGC's overall progress on these initiatives.

It is therefore possible that, before the year's end, there will be concrete progress towards a consensus on an international framework for the effective protection of genetic resources, traditional knowledge and TCEs.

The topic is not only of interest to indigenous communities that are confronted with the threat of cultural appropriation – others will also benefit from increased clarity. Businesses and brand owners searching for greater social engagement are also becoming aware of the adverse implications of the misuse and misappropriation of TCEs, irrespective of intention. Increasingly, they are seeking guidance on the appropriate measures for promoting, preserving and recognising the cultural diversity of indigenous peoples' heritage, and avoiding inadvertent appropriation and offence.

Should WIPO be successful in negotiations towards producing a draft framework for the protection of TCEs this year – which would be fitting, since 2017 is the 10th anniversary of the adoption of the UN Declaration on the Rights of Indigenous Peoples (UNDRIP) – it will still likely be several years before the framework is finalised and implemented. In the meantime, indigenous communities must rely on existing tools to protect TCEs, and brand owners must be cognisant of the ramifications and potential risks consequent to the use of TCEs.

This article provides an overview of some of the issues that arise in relation

to the protection of TCEs within the traditional Western IP legal paradigm. It also offers some steps that brand owners may take to balance legitimate inspiration with inappropriate use, and suggests opportunities to engage positively with indigenous communities for mutually rewarding and socially enriching partnerships.

## **DEFINING TCEs**

Any discussion of the protection of TCEs must offer a definition of the term, and agreeing on one is not simple. Early attempts to define TCEs focused on developing a content-based definition by describing the kinds of expressions that would constitute the category: for example, oral traditions, games, musical expressions, enacted expressions, paintings, carvings, pottery, mosaics, jewellery, basketwork, textiles, carpets and costumes. However, attempts at a single, exhaustive definition have struggled, because not only are concepts of indigenous knowledge and the expression of that knowledge not readily divisible into parts, but also, even when they are identified, TCEs are as varied and multifaceted as the numerous indigenous communities that employ them.

After years of negotiation among various stakeholders, there is an emerging consensus in the international community on IGC's inclusive definition of TCEs. This definition centres on the source of the knowledge and its cultural significance, rather than its specific

content. It defines TCEs to include cultural expressions that:

- are transmitted from generation to generation;
- are regarded as pertaining to a particular people or its territory; and
- may evolve in response to a changing environment.

This broad and inclusive definition has been widely accepted and is considered to encompass the totality of tradition-based indigenous creations.

## PROTECTION PATHWAYS

Fundamental to the discussion about the protection of TCEs, and the cause of much stakeholder debate, is the extent to which Western IP systems could (or even should) be used.

Before the adoption of UNDRIP, the discourse was particularly critical of the suitability of such systems, because of limitations related to:

- notions of individual creativity, rather than communal knowledge;
- concepts of alienability and exclusivity, rather than cultural inclusivity and sustainability;
- the transformation of rich and sacred expressions into a marketable commodity;
- the requirement that intellectual creation be novel and fixed in a material form, which TCEs may not be able to meet; and
- IP being static at a moment in time, and therefore being incapable of catering to the dynamic and evolving nature of TCEs.

Much of the contra debate questions whether the perceived limitations of Western IP systems do, in fact, preclude protection of TCEs. For instance, there are communal and perennial forms of IP that are already recognised within Western IP systems. It is possible for trade marks to be renewed infinitely, and collective trade marks can be registered by indigenous organisations and used by members to identify themselves. Furthermore, and counter to the allegation that IP systems commodify TCEs, an IP right provides an entitlement to object to such unauthorised commodification or misappropriation. An IP right can also



*An IP right can enable communities that wish to develop economic and cultural partnerships beyond the community to determine the terms of access and use of their cultural materials*

enable communities that wish to develop economic and cultural partnerships beyond the community to determine the terms of access and use of their cultural materials.

The adoption of UNDRIP on 13th September 2007 signified a turning point in the debate. While it is a non-binding instrument, it formally recognised indigenous peoples' right to maintain, develop, control and protect IP over their TCEs. By expressly interlinking indigenous peoples' cultural rights and IP rights, UNDRIP has helped shift the tone of the discussion, including the presumption of a rights entitlement.

The maturation of the discussion has promoted practical use of existing mechanisms and principles to provide some immediate solutions for protecting TCEs. This was epitomised by IGC's release in 2014 of *The Protection of Traditional Cultural Expressions: Draft Articles*. The draft articles draw heavily on existing IP principles to propose a *sui generis* legislative scheme for the protection of TCEs. They constitute a major step towards substantive reform and attempt to empower indigenous communities by giving them tangible legal rights to prevent misuse of their TCEs.

Notably, the draft articles seek to balance the rights of indigenous peoples against broader public interest by:

- defining the term "TCEs" broadly to include all forms of expressions that bear some linkage with the indigenous community's cultural

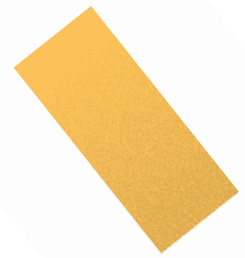
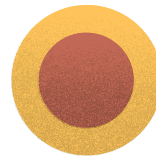
and social identity, and that are being used in that community;

- providing a mechanism for third parties to seek prior consent to make approved use of TCEs;
- providing a clear definition of misappropriation, which includes usages that "disparage, offend or falsely suggest a connection with the community"; and
- providing an unlimited protection period for TCEs as long as the expression can be classified as a TCE.

The IGC met in February 2017 and will meet again in June 2017 to further discuss the draft articles ahead of the WIPO General Assembly's meeting in October 2017.

## IMPACTS AND ACTIONS

Unauthorised use of TCEs, even if inadvertent, is not only a serious and sensitive issue for indigenous peoples, but can also have negative financial and reputational implications for businesses, particularly as appropriation stories can spread quickly and widely via social media. Last year, MAC Cosmetics (a subsidiary of Estée Lauder Companies) was the subject of public backlash when it released its Vibe Tribe make-up collection featuring patterns resembling Navajo tribal geometric designs. Notwithstanding MAC Cosmetics' assertion that its collection was not intended to have any connection with, and was not inspired by, Native American cultures, there remained widespread criticism of the company on social media, including calls for a boycott of its products.



The marketing landscape has also changed considerably. It is no longer sufficient for brands to produce quality products or create a stellar advertising campaign. According to Aline Santos, Unilever's Executive Vice-President of Global Marketing, modern consumers are "really expecting brands to create movements. They want to be part of those movements."

Brand activism provides an opportunity to both tackle the challenge of cultural appropriation and engage in the broader legal and policy discussion of TCE protection within a framework that considers cultural, social, environmental and economic contexts. At a basic level, brand owners and businesses may show their mindfulness and sensitivity to the issue by:

**Not assuming that a particular TCE is in the public domain.** Instead, brand owners should seek out the source of TCEs and look to obtain prior informed consent to use.

**Acknowledging the source of any inspiration.** This will not only minimise the risk of an allegation of appropriation, but will also promote awareness of the indigenous owners and their symbols. Criticism of Louis Vuitton's 2012 spring-summer collection could, arguably, have been avoided if it had clarified the source of its inspiration or shared credit with the Maasai people, who traditionally wear the "shuka" upon which part of the collection appeared to be based.

**Understanding that the meaning and cultural significance of a particular symbol or insignia may dictate its appropriateness for use.** If a particular artefact has sacred significance, brand owners should avoid using it without permission, and should certainly not use it in a manner that would cause offence or trivialise its significance.

In 2012, Victoria's Secret model Karlie Kloss wore a Native American-inspired feathered headdress with a fringed-suede bikini and turquoise jewellery during Paris Fashion Week. This deeply offended native peoples, as the type of headdress

worn by Kloss has spiritual and ceremonial significance; only select members of a tribe are given the right to wear the feathers for their acts of bravery. Several other brands have received critical public scrutiny for similarly seeming to trivialise cultural insignia by turning them into mere fashion accessories.

**Providing proper compensation to the indigenous owners where appropriate, whether in the form of recognition, monetary remuneration or benefit sharing.** This benefits all stakeholders, and also allows the brand owner to demonstrate dedication towards a worthwhile cause, which, in turn, engenders goodwill for the brand. Brazilian designer Oskar Metsavaht was widely applauded for his respectful and ethical use of the Asháninka tribe's TCEs. Not only did Metsavaht seek consent to draw inspiration from the tribe's TCEs for his spring 2016 collection, he also paid royalties to the tribe in return and publicised its fight against the illegal logging of its forests.

**Training employees involved in the creative process.** This is particularly important for the marketing and design teams, so that they are mindful of these issues.

**Conducting availability searches to ascertain whether the proposed sign is likely to be offensive to local communities or have other connotations.** The diverse range and global expanse of indigenous peoples and the lack of a central registry or database on TCEs means that, while brand owners may not have an exhaustive knowledge of different communities and their TCEs, a clearance process to minimise risks should include questions as to the potential associations with TCEs.

## INADVERTENT OFFENCE

While non-exhaustive, the above precautionary steps may help minimise the risk of allegations of cultural appropriation and insensitivity.

Notwithstanding care, however, inadvertent offence can be caused. Walt Disney Pictures received high praise for actively involving Pacific Islands communities in the production of its recent animated film *Moana*, which is based on Polynesian mythology. However, social media users found Disney's merchandise for the movie – its "Maui" Halloween costume in particular – offensive to the Pacific peoples, leading Disney to immediately withdraw the costume. The company's prompt action and sensitive handling of the issue appeared to appease consumers, and the film has been successful. The action not only made good business sense, but was also positive in exposing a wider audience to learning about Pacific Islands cultures.

## DARE TO CARE

While the extent of progress to be made in 2017 remains to be seen, for brand owners and businesses, the debate has already moved from the political arena to the consumer marketplace. Brand owners that are sensitive to the potential issues and otherwise "dare to care" are seen to protect their immediate brand reputation and contribute to the ongoing sustainability of wider cultural heritage. Brand owners and businesses can also make a significant and meaningful contribution to the challenges faced by indigenous peoples, and ensure that the value of their "property" expands beyond mere commodification and is recognised for what it is: an intangible contribution to the survival of diverse cultures that benefits both indigenous and non-indigenous communities for generations to come. ■



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Marion would like to thank **Aparna Watal**, Associate, for her assistance with this article.

# ASD IN THE WORKPLACE

*Alison Madgwick provides a clearer picture of autistic spectrum disorder, and what it takes to support a neuro-atypical colleague*

**T**his article comes in three parts. First, I will offer some useful definitions. Second, I will explain a little about my own relationship with autistic spectrum disorder (ASD), specifically Asperger syndrome (AS), in the hope that it will put the subject in some context. Last but not least, I will summarise what can be done in the workplace to help people with ASD to do their jobs while benefiting from the same respect, tolerance and understanding as their neuro-typical colleagues.

## SETTING THE SCENE

ASD is the umbrella category for a group of conditions that very broadly includes the symptoms of difficulties with social interaction and communication, repetitive behaviours, restricted interests and sensory issues. Autism is the most common and well known of these conditions, and is often used as an umbrella term itself, including synonymously with ASD.

AS was, at the time I was diagnosed with it, classified as a separate condition to autism. However, it has now been redefined as one of the conditions covered by ASD. Some people think AS is synonymous with high-functioning autism. Others, myself included, find the latter term

unhelpful, and offensive to those not classed as “high functioning”, and would prefer that it were not used.

## EARLY IMPACT

Growing up, I knew I was different from the other kids at school. I thought about things differently and often considered my way of thinking to be the more correct, if not the most useful, which could come across as arrogance. I often craved social contact desperately, but my peers didn’t make any sense to me, and interacting with people I couldn’t understand frustrated me.

The only person at school I understood at all was a boy who had something called “Asperger syndrome”. I even asked my parents on occasion whether I might have this syndrome as well. They dismissed my queries, because they didn’t understand the need to “label” children.

Fast-forward to my 18th year. I was at the University of Cambridge reading biological natural sciences. The social problems I had experienced throughout my whole life and had just about learned to cope with were turned on their head once again and shaken about a bit. As if that weren’t enough, there was the work. I very quickly found myself floundering in a mire of unfinished essays and

“  
*I often craved social contact desperately, but my peers didn’t make any sense to me, and interacting with people I couldn’t understand frustrated me*”



untouched example sheets, with a growing sense of “What on earth am I doing here?” That was when I decided to seek advice and received my diagnosis.

Once I had that diagnosis, life got a little simpler. Not simple by a long way, but simpler.

I knew why I was different – not strange or weird or odd, just different – and I started thinking of myself as such. This change in attitude towards myself was probably the most important effect of my diagnosis. That is not to say that I had solved all my social and communication problems, but I was much better able to deal with them.

### **PRACTICAL OUTCOMES**

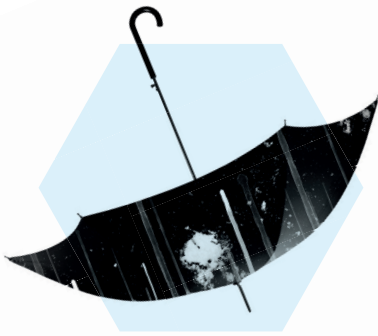
The practical outcomes of my diagnosis were also useful. At university, I received extra time in exams and was able to sit them in a

separate room. This was also allowed when I did the postgraduate certificate in IP at Bournemouth University. Supervisors were made aware that I may find it difficult to work with other people and may need more time to finish off practicals or hand in essays. I was able to work to my full potential (or at least nearer my full potential) and start tackling the confusion that was the social side of my life. At first, I was paranoid about mentioning my AS, assuming that it was not possible to do so without it seeming like an excuse. With time, however, I got used to explaining certain behaviours with neat little phrases like: “Can we please schedule in advance when we’re going to meet? I have Asperger’s and don’t deal well with uncertainty and changes in routine.”

Once I felt more comfortable with myself and my interactions with the world, I was able to start helping

others. At Cambridge, I helped at the Disability Resource Centre and was the Disabled Students’ Officer at my college. I was also the facilitator for the AS social group for a fair while. This not only helped me explain a lot of my own behaviours, but (if I don’t sound too much like I am blowing my own trumpet) I also think I helped the other people in the group. One important reason for this was simply that the previous facilitator did not have ASD!

This, in my opinion, is an example of one of the least helpful ways for neuro-typical people to help neuro-atypicals: to make a space for them and then sit in it themselves. By all means make the space and we will thank you, but then get out of it. If you want to help, the best thing to do is to give the people who are in that group the space to help themselves. Only give support if you are asked for it. ▶



Having said all that, what follows is my advice for how to support a colleague with ASD. It is important to point out that the following list is by no means complete, and reflects my own experiences, which will, of course, be different from other people's. I hope you will find it helpful nonetheless.

### HELPFUL ACTIONS

When dealing with people with ASD, it is helpful to:

#### Give them clear instructions

People on the autistic spectrum often cannot infer meaning or “read between the lines”, so they need precise instructions in order to carry out a task. A lack of clear instructions not only means a job might not get done adequately, but it can also cause the person with autism significant stress. It is often useful to provide instructions in writing, and it can also be helpful to ask the person to repeat back instructions to be sure they have understood.

#### Allow for routines and give adequate notice if these are due to change

People on the autistic spectrum often find routines very helpful, and can get upset and stressed when routines are not in place or are changed without notice. Clarification of working hours and break times can be useful, as can timetables if multiple tasks are to be completed in the same time period.

#### Give feedback and make it clear that it is not criticism

Clear feedback can be very important to someone with autism so that they can be sure that they are doing work correctly, or alter how they are doing it if not. It is, however, important to make sure that this feedback is constructive and not interpreted as criticism. Autistic people are often perfectionists, so perceived failure can hit them hard. Many have also experienced bullying in the past,

so can be more sensitive than others to negative remarks.

#### Listen to the person with autism

This is possibly the most important take-home message of this article.

Of course, self-education is good, and I wholeheartedly encourage you to go and read up on ASD (the National Autistic Society website is good).

At the same time, I would like to stress again that everyone is different.

So, in deciding what reasonable accommodations to make in your office or how to interact socially with an autistic colleague, the person who best knows the answers to your questions about their autism is that colleague.

### UNHELPFUL ACTIONS

When dealing with people with ASD, it is not helpful to:

#### Expect them to be super-good at teamwork

As described above, people on the autistic spectrum often have social and communication difficulties. If they are needed in a team, be aware of their needs and make sure that the others in the team are also aware, ensuring that you have the autistic person's consent to disclose this information to the team.

#### Expect them to join in with social stuff

It varies from firm to firm and office to office, but socialising can be an

important part of working in IP.

As with teamwork, it is important to remain aware of an autistic colleague's needs and not pressure them. If they decide to join in with social activities, be respectful of boundaries, possible sensory issues and the fact that they may need to take some time out at any point to recover from the social interaction.



**WANT TO KNOW MORE?**  
The National Autistic Society offers advice and training for those recruiting or supporting someone on the autistic spectrum. See [autism.org.uk](http://autism.org.uk) for details

#### Make assumptions based on stereotypes

Not everyone on the autistic spectrum is like Dustin Hoffman's character in *Rain Man*.

As the name suggests, it is a spectrum, and many people have learned tricks to make their autism

invisible most of the time. Avoid saying things such as “You can't possibly be autistic”, which can be very upsetting or frustrating for someone who has put a lot of effort into learning how to appear “normal”.

### JOINT EFFORT

Of course, I don't believe the entire onus is on others to make sure a person with ASD gets on well in the workplace. It is important for the autistic person to make an effort as well. If the above suggestions are followed, however, it should be a lot easier for autistic people to work together with their colleagues, and to find ways of working that benefit everyone. ■

*This article is adapted from Alison's guest blog for IP Inclusive, which is published at [ipinclusive.org.uk](http://ipinclusive.org.uk) and reproduced with permission.*



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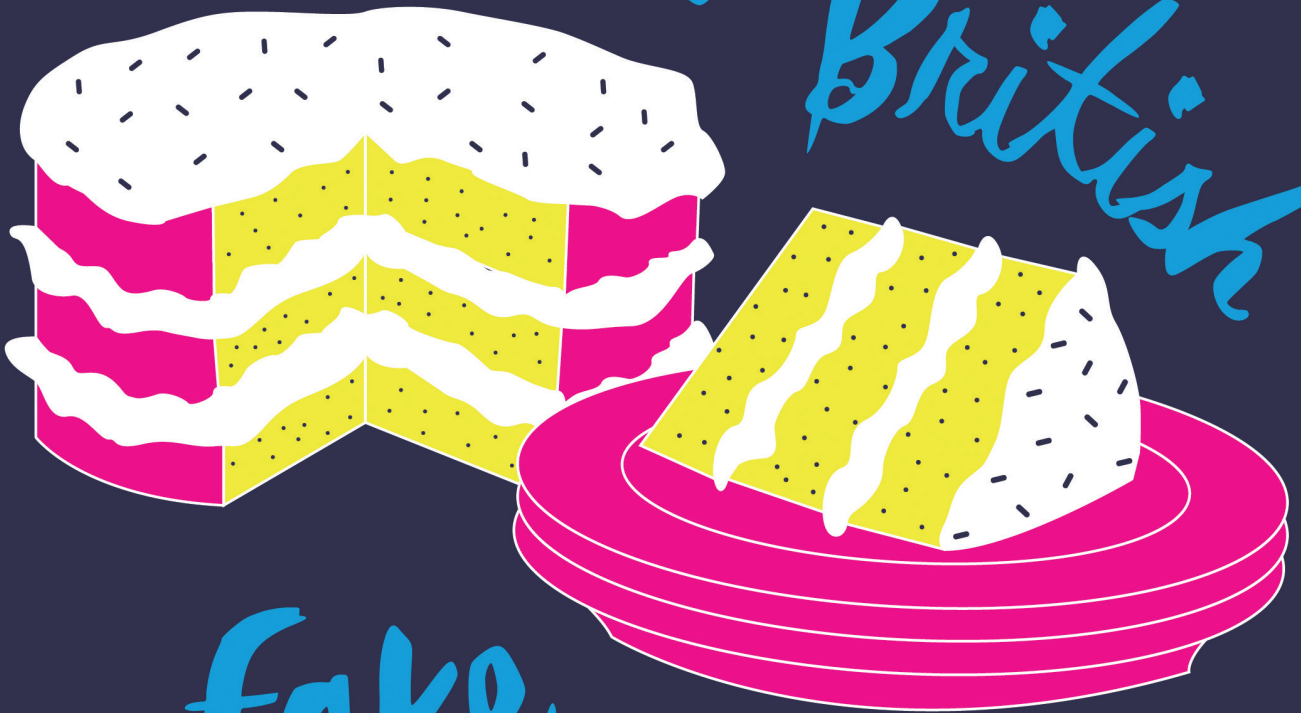
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# Great British



# fake off?

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The UK's most-viewed cooking contest is the latest programme to highlight the soggy state of format rights case law, says Mark Cruickshank

**T**he issue of television format rights has recently been in the spotlight following *The Great British Bake Off*'s (GBBO's)

much-publicised move from the BBC to Channel 4. The move was highly contentious, partly because a majority of GBBO's presenters decided not to make the move, leaving open the possibility of the BBC creating a rival baking programme. It is likely that Love Productions (the producer of GBBO) will be watching this closely, particularly since it had previous disputes with the BBC relating to format rights for two other television programmes.

Subsequent to the GBBO coverage, a rare television format rights decision was issued by the Court of Appeal in *Wade and Perry v British Sky Broadcasting*<sup>1</sup>, which acts as a timely reminder of the legal issues and challenges in protecting television formats in the UK. While this continues to be a relatively "undercooked" area of the law, it is possible to draw some principles from the case law and identify practical steps that can be taken to protect such formats or avoid infringement.

## REVIEW OF RIGHTS

There is no stand-alone right that protects television programme formats in the UK. Instead, they rely on protection via myriad other IP rights. These principally include: (i) copyright in the scripts or format of the programme, the music of a theme song, and the set designs and layout; (ii) confidential information in the format, running order/sequencing of events, and unique features of the programme; and (iii) trade mark rights in the title of the programme, any associated logos and any catchphrases that may be used.

The bulk of the case law on television programme format disputes has focused on copyright infringement and breach of confidence, and thus much of the attention is devoted to them.

## CASE LAW AND CONTEXT

The starting point for any analysis of television format rights is *Green v Broadcasting Corporation of New*



*It is difficult to establish firm guidance from the case law other than, as a generality, raising claims based on infringement of copyright is challenging*

Zealand.<sup>2</sup> That case was brought by Hughie Green, the author, presenter and compère of the television programme *Opportunity Knocks*. He raised proceedings against the Broadcasting Corporation of New Zealand for its broadcast of a similar television programme in New Zealand, also called *Opportunity Knocks*.

The key elements of Mr Green's case were based on the copyright that he claimed subsisted in the script of *Opportunity Knocks* as a literary and dramatic work. The difficulty he faced was that no scripts were ever produced. Therefore, the Privy Council could not find that any literary copyright had been infringed. In respect of the alleged copying of the "dramatic format" of *Opportunity Knocks*, the Privy Council held that: "It is stretching the original use of the word 'format' a long way to use it metaphorically to describe the features of a television series ... which is presented in a particular way, with repeated but unconnected use of set phrases with the aid of particular accessories."

In other words, a television format is distinguished from a dramatic work, such as a play or theatre production, because it does not follow the same format every time. Television programmes (and particularly game shows, which feature prominently in the case law) are, by their nature, different every episode, and are not necessarily scripted or predetermined because they rely on contestant or audience participation.

The authority of Green has been the cornerstone for television format disputes, and this remains the case nearly 30 years on. The reasons for this are twofold. First, most subsequent disputes have either been decided by way of summary judgment or settled out of court. For example, in *Meakin v British Broadcasting Corporation and Others*<sup>3</sup>, the Claimant raised proceedings against the BBC for copyright infringement and breach of confidence by broadcasting a programme entitled *Come and Have a Go... If You Think You're Smart Enough*. The BBC sought to strike out the claim and, for this purpose, the Court proceeded on the basis that the subsistence of copyright in the dramatic format was arguable. However, this issue was ultimately untested, because the Court held that there was no reasonable prospect of Mr Meakin succeeding, and any similarity between his proposals and the BBC programme were no more than general ideas at a fairly high level of abstraction.

Further, in *Celador Productions Ltd v Melville and Baccini v Celador Productions Ltd and Others*<sup>4</sup>, the Court held that there were issues to be tried, but the case appears to have been settled, because there have been no further judgments issued. The high-profile dispute between the *Pop Idol* and *X Factor* formats was also settled out of court without a substantive decision being issued.

The second main reason for the underdeveloped case law is that a large proportion of the claimants in television format disputes have been litigants in person. This has meant that the pleadings and arguments have not been as nuanced as they otherwise might have been in this difficult area of the law had professional advisors been instructed. It may also help explain why so many of the claims have been struck out.

The rare cases in which protection has been granted to television formats have largely been based on confidential information, and this seems to offer the best prospect of success in this field. Of course, as a starting point,

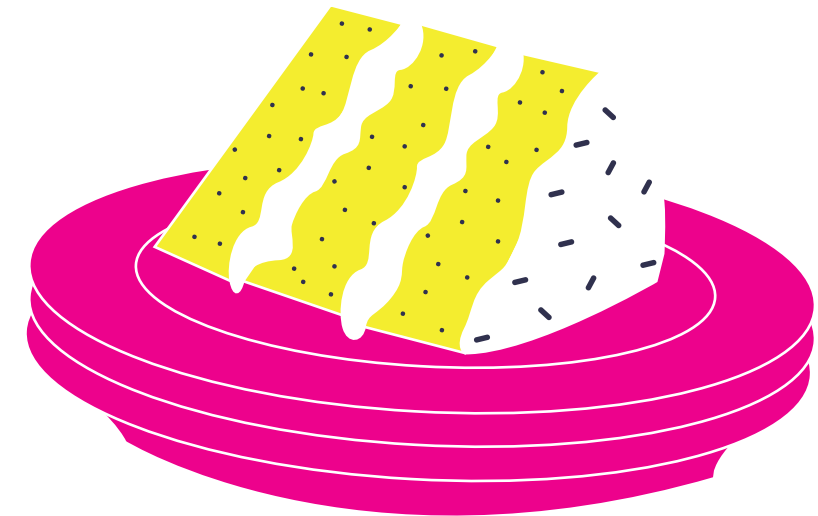
the information must satisfy the common-law test of confidentiality in that the information has the necessary quality of confidence and is disclosed in circumstances importing an obligation of confidence. The case of *Fraser and Others v Thames Television and Others*<sup>5</sup> is one such example. In that instance, the Court decided, among other things, that the television concept was “original, clearly identifiable, of potential commercial value and sufficiently well developed to be capable of realisation”, and that it had been disclosed to the Defendants in confidential circumstances.

Wade, the most recent television format case, is the first fully reasoned decision for some time in this field and, again, was based solely on breach of confidence. The Claimants claimed that British Sky Broadcasting’s (BSB’s) production of the programme *Must Be the Music* (MBM) must have been copied from their earlier idea, which had been submitted to BSB, for a programme entitled *The Real Deal*, because of the similarities between the two. The alleged similarities included the fact that contestants performed chart-eligible, downloadable songs during the show; the judges were exclusively singer-songwriters; and the programme was “primetime rather than edgy”. However, the claim was defeated because BSB was able to demonstrate that it had independently created its MBM format.

In *Wade*, the Court of Appeal stopped short of deciding whether there could be copying of a format where only a combination of the elements was used, rather than the format as a whole. If it had done so, it could have opened the door for a greater likelihood of success for claimants in this area.

## GUIDING PRINCIPLES

It is difficult to establish firm guidance from the case law other than, as a generality, raising claims based on infringement of copyright is extremely challenging. Claims based on breach of confidence seem to offer a greater prospect of success, although it remains to be seen, per *Wade*, whether such a claim could be successful where



only limited elements of the format have been copied.

Nevertheless, there are several practical guidelines that can be drawn from the case law to assist with protection and avoiding infringement:

- First, a party that creates a television format should keep dated and detailed written notes of its ideas. These should include key features of all aspects of the format of the programme – particularly catchphrases; timing and running order or sequencing of events; and those features that are unique or that have not been used in other television programmes.
- Second, the format should be kept confidential. If it is being submitted to television networks for consideration, the party should ensure that appropriate confidentiality provisions are put in place before the material is disclosed.
- Third, relevant IP should be registered where possible. This includes trade marks for programme titles and catchphrases.

Conversely, parties that wish to create television programmes without infringing third-party rights can take steps to minimise that risk. They should create and retain records that demonstrate the independent creation of the television programme format. If third parties submit television programme formats for consideration, whether solicited or otherwise, they should be logged along with a note of who had sight of them. The materials should also be returned or deleted if they are

unsuccessful, and the applicant should be informed of this. Finally, as far as possible, parties should avoid any “cross contamination” between the people who have seen the prospective scripts and those involved in developing rival formats, to avoid any subconscious copying.

## DIFFICULT RECIPE

As long as the case law on television formats remains underdeveloped, it is likely that further disputes will occur. Such formats are increasingly valuable assets in terms of generating viewer numbers, advertising revenue, and sales of associated merchandise and promotional material. As such, it seems only a matter of time until two parties with equal resources allow these difficult issues to be given more detailed consideration, and judicial guidance can be obtained.

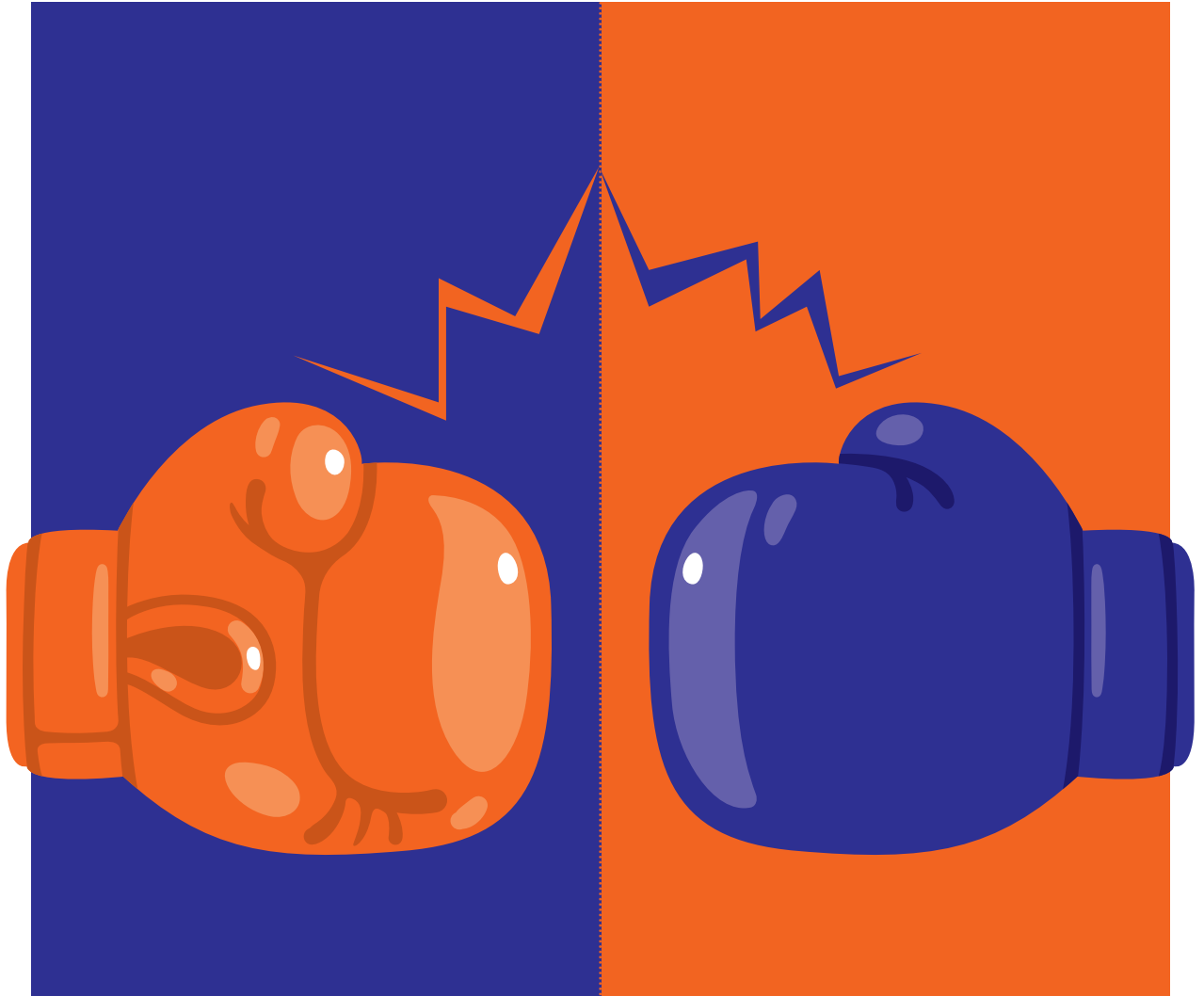
Until then, the protection and enforcement of television format rights are unlikely to be a piece of cake. ■

1. [2016] EWCA Civ 1214
2. [1989] RPC 700
3. [2010] EWHC 2065 (Ch)
4. [2004] EWHC 2362 (Ch)
5. [1984] QB 44



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# IT'S GOOD TO TALK

IT'S CONFIDENTIAL,  
IT'S FLEXIBLE AND IT'S  
SOMETHING BOTH THE UK  
AND EU COURTS WOULD LIKE  
YOU TO SERIOUSLY CONSIDER,  
SAY OUR MEDIATION EXPERTS

**M**ediation, a process whereby parties to a dispute work with a trained, independent third party towards a negotiated settlement, is a voluntary, confidential and flexible process that gives parties control over key features – including timing, format and choice of mediator. What's more, if successful, it can preserve business relationships and confidentiality, produce creative solutions, and free up resources for the furtherance of commercial objectives that would otherwise be lost to the litigation process. Even if settlement is not reached, parties often benefit from having taken part in mediation by hearing each other's perspectives, narrowing issues, and testing the strengths and weaknesses of the case.

That is why, while neither the UK courts nor EUIPO forces parties to engage in formal mediation, they do make it clear that this alternative dispute resolution (ADR) option should be seriously considered. With this in mind, the *CITMA Review* asked experts on both sides to remind readers of the ADR essentials. ▶

# THE UK: ACTION OPTIONS

*Failure to seriously consider mediation could cost you, suggests Jeremy Blum*

**THE UK's** Civil Procedure Rules, pre-action protocols and court guides require that parties consider whether negotiation or some other form of ADR might enable them to settle without commencing litigation. Because the rules do not mandate a means by which settlement is to be attempted, formal mediation is just one ADR option. Discussion, negotiation or early “without prejudice” correspondence are other potential avenues.

In fact, parties must continue to consider the possibility of reaching a settlement at all times – even after proceedings have started – and may be required to provide evidence that ADR has been looked into. Silence or refusal in response to an invitation to participate in ADR might be considered unreasonable by the court, and could lead to the imposition of costs sanctions.

A directions questionnaire completed after statements of case in the majority of IP cases reminds parties that they must make “every effort” to attempt to settle disputes before the hearing of the matter takes place. It requires them to accept or decline a one-month stay in order to attempt to settle the claim at that stage. If a party declines, it must explain the reasons why it is inappropriate at that stage. Legal representatives must confirm that they have advised parties of the need to try to settle, the options available and the possibility of costs sanctions if they refuse. The directions questionnaire also expressly asks whether pre-action protocols have been complied with and, if not, requires explanation.

A court has a wide discretion on the issue of costs and can take into account efforts made before or during litigation to try to resolve disputes. A court can deprive a successful party of some or all of its costs if it determines that it has acted unreasonably in refusing to engage in mediation or another form of ADR.

## PRACTICALITIES

Mediation can be usefully deployed:

- before litigation begins, when significant costs savings can be made;
- after close of pleadings, when parties have a better understanding of the case against them;
- immediately after the case management conference, when parties have sight of steps to trial and associated costs; and
- after judgment, when parties wish to find a more flexible solution than that imposed by the court.

Mediation is not likely to be appropriate where a party requires the court to make a finding on construction, provide injunctive relief or establish legal precedent. In addition, it is only successful if both parties are willing to compromise; a party that is not willing to retreat from an entrenched position is highly unlikely to settle at a mediation.

Should parties agree to mediation, they select a mediator, with regard to the nature and circumstances of the dispute (unless they have agreed otherwise – for example, in a trade mark licence). The mediator may be a specialist trade mark lawyer, a general commercial mediator or a technology expert. As well as reputation and experience, the interaction of the personalities involved is a factor worth bearing in mind. Organisations such as the Centre for Effective Dispute Resolution can provide recommendations for and access to mediators, and directories such as *The Legal 500* rank individual mediators. The UK IPO and EUIPO also provide mediation services.

The mediator’s objective is not to ensure that the parties achieve settlement at any cost, but to ensure they consider the implications of compromising or continuing with the dispute.



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**Catriona MacLeod**, Senior Associate at Bristows LLP, co-authored this item.

## FACILITATION ROLE

Mediation is usually facilitative (the mediator does not adjudicate the merits, but works to facilitate agreement) or, less commonly, evaluative (the mediator might be asked to evaluate the claim and/or identify strengths and weaknesses). Usually, parties will prepare a mediation statement, which may include a starting offer. It may also be appropriate to prepare an outline settlement agreement. This helps focus the relative positions of the parties.

It is critical that persons with authority to settle on behalf of the parties attend the mediation, and that parties establish in advance with their legal advisors where their “lines in the sand” are. It is rarely justifiable for more than two external lawyers for each party to be present.

Statements made in a genuine attempt to settle an existing dispute are prevented from being put before the UK court by the “without prejudice” rule. This type of privilege extends to negotiations conducted through mediation.

Parties should agree in advance how costs will be dealt with. For example, it may be agreed that costs will be excluded from the litigation and split equally. In other circumstances, costs may be rolled into the general costs of litigation.

Where possible, a “neutral” third-party location may avoid any perceived “home advantage”. Commonly, there will be a joint session room and private breakout areas. The mediator will introduce proceedings, inviting each party to make an opening statement. The parties may then divide to identify and consider options – both with and without the mediator – before reconvening. Often, the mediation involves reconvening on a number of occasions, as a party will need to consider its position away from the other party. ■

# EUIPO: MEDIATION INTEGRATION

Gordon Humphreys outlines the EUIPO mediation process

**DIRECTIVE 2008/52/EC** (the Mediation Directive) does not place parties under an obligation to mediate, but sets some minimum standards for the process in relation to cross-border disputes in civil and commercial matters. In fact, since 24th October 2011, EUIPO's Boards of Appeal mediation service has offered its users an alternative to the traditional dispute route of opposition, cancellation and appeal proceedings.

EUIPO is the first pan-European IP organisation to fully integrate mediation as one of its IP dispute-resolution tools. In so doing, it seeks to promote mediation in the EU and implement the spirit of the Mediation Directive for the benefit of its users and stakeholders.

The main legal provisions on which EUIPO mediation proceedings are based are Articles 42(4) and 57(4) of Council Regulation (EC) No 207/2009, and the Presidium Decision on Mediation (Decision No 2011-1). Mediation is offered either at EUIPO in Alicante (free of charge) or at its annex office in Brussels (subject to an administration fee of €750).

Currently, for there to be a mediation, there must be an appeal against a decision of the Opposition Division or Cancellation Division, as well as payment of the appeal fee and the filing of a statement of grounds. There are three alternative ways to initiate mediation:

- Both parties agree to mediate by submitting a joint request.
- One of the parties makes a unilateral mediation request, which is forwarded to the other party by the Boards for acceptance.
- The rapporteur of the appeal case invites the parties to consider mediation, taking into account the circumstances of the file.

When the parties agree to mediation, the appeal proceedings are suspended and the parties are invited to choose a mediator from EUIPO's mediators list, published

on its website. In more complex cases, or where the parties specifically request it, a co-mediator may be appointed at no additional charge.

Once a mediator has been chosen, they immediately contact the parties to start the mediation process. The mediator asks each of the parties to sign a mediation agreement and submit a case summary, which will not be communicated to the other party.

Next, the parties and their representatives agree on a date for the mediation. During the mediation, the parties have the opportunity to inform each other and the mediator of all the relevant facts of their dispute(s), business concerns and legal positions. The mediator will endeavour to facilitate an agreement between the parties, without deciding the case.

Ideally, EUIPO mediation proceedings are concluded with an agreement resolving the parties' trade mark dispute once and for all. The subject of the agreement will be the transfer, withdrawal or limitation of an EU trade mark, opposition or appeal. The agreement will specify all other agreed arrangements, such as future cooperative ventures, coexistence, the assignment of costs, etc.

Once a mediation procedure has been successfully completed, the mediator informs the competent Board of Appeal of the outcome of the mediation, and the case is formally closed.

If, in spite of the mediator's assistance, the parties cannot achieve an amicable settlement, the appeal proceedings will be resumed without delay. ■

*The views expressed in this article are personal and do not necessarily reflect those of EUIPO.*



**GORDON HUMPHREYS** is Chairperson of the Fifth Board of Appeal and an accredited Mediator (CI Arb)

**Sven Stürmann**, Team Leader and accredited Mediator (CEDR) at Knowledge, Information and Support Service, Boards of Appeal, also contributed his expertise.

## MEDIATION IN BRIEF: UK AND EU COMPARISON

	UK	EUIPO BOARD OF APPEAL
<b>When can mediation take place?</b>	At any time before, during or after litigation proceedings	After an appeal is lodged against a decision of the Opposition Division or Cancellation Division, the appeal fee is paid and the statement of grounds is lodged
<b>How is mediation initiated?</b>	By the agreement of the parties	The parties may submit a joint request; one party may submit a unilateral request that the other is asked if they will accept; or the appeal rapporteur may invite the parties to consider mediation
<b>Who is the mediator?</b>	Any individual selected by the parties	A mediator chosen by the parties from EUIPO's mediators list
<b>Suspension of proceedings</b>	Mediation can usually take place concurrently with the proceedings, but a stay is possible	Appeal proceedings are suspended while mediation takes place
<b>Subject matter</b>	Any matter at issue between the parties to the proceedings	The transfer, withdrawal or limitation of an EU trade mark, and all other arrangements, such as future cooperative ventures, coexistence and costs



# Does your CV still matter?

*Social networking sites are nice, but you still need a formal calling card, says Bob Boad. Here's how to ensure that your written profile makes a positive impression*

In this age of information, when so much of our professional history is held in online profiles, easily retrieved by an internet search, and often reported in real time on social media, you might question whether the curriculum vitae still has a role to play. The answer is a resounding “yes”.

There is no substitute for a carefully drafted CV that succinctly sets out your qualifications, experience, achievements and interests. And an experienced interviewer will be looking for more than just a list of your qualifications and employment history. Instead, the document should be the clearest evidence of how you wish to present yourself to an employer and communicate those less quantifiable, but desirable, qualities that point to an ideal candidate.

So, your CV should be:

- **Concise:** No matter how many qualifications, key positions and successful cases you have to your credit, it is important to condense the information – ideally to no more than two pages. Don't worry – if you are selected for interview, the interviewer can, and will, ask further questions to put more “flesh on the bones”.
- **Legible:** Do not try to cram details in by skimping on spacing, using a small typeface or omitting headings – the document should be pleasing to the eye and easy to read. Recognise that your CV is likely to be read on a screen as well as in print, so make sure it works as well in PDF format as it does in hard-copy format.
- **Complete:** Gaps in your work history will catch the eye of most interviewers, and you may be quizzed about them. Being upfront about time spent travelling or between jobs will help establish you as a credible and honest candidate.
- **Tailored:** Always tailor your CV to the specific role for which you are applying. Put the emphasis on what you have accomplished in your present and past jobs, and the key skills you would bring to this one.
- **Free of clichés:** Avoid the usual well-worn jargon, even if you do



believe that you are a self-starter and a natural leader. Instead, take the opportunity to signal how much you enjoy working in this field.

- Error free: I hesitate to give this most basic advice, but it is so important to check and recheck to ensure your document is absolutely correct. Don't just rely on the built-in spellcheck; print out and read your document out loud to catch every single misstep.
- Truthful: Do not include any untruths, or even exaggerations. Prudent organisations will follow up on the references that you provide. In these days of increased workforce mobility and readily available counterfeit degrees and other qualifications, would-be employers are motivated to check out claimed qualifications with the appropriate educational institutions and professional bodies, unless they have personal knowledge of the candidate's credentials. Many will reject candidates as soon as they spot an inconsistency or discover untruths during the interview. If an employer becomes aware of an

issue after you have been hired, it may consider this grounds for dismissing you.

### CAUTIONARY TALE

That last point really should go without saying, but, if you have ever been tempted to embellish your CV or take a lesson in self-promotion from the cast of *The Apprentice*, the case of Michael McCooe should make you think again.

Some serious inaccuracies on his CV resulted in the Solicitors Regulation Authority (SRA) taking an interest. In a decision published in July 2016, the SRA announced that it had agreed with him that, among other things, he would remove himself from the roll of solicitors.<sup>1</sup>

### OTHER ISSUES

Some older jobseekers try to disguise their age by omitting from their CVs the dates when they were in education, and some even leave out their early work experience. However, I am not convinced that this is a wise

move. In the IP world, experience is highly valued, and, in my opinion, ageism is generally less of an issue than it is in some other fields. Looking ahead, we will all need to get used to the idea of working to a more advanced age than we did in the past and make the necessary adjustment to our attitudes.

Obviously, your CV is not the right place, and the interview is not the right time, to reveal that you have a past conviction for dodging a train fare. However, if your application is successful, you may need to consider whether there is an appropriate moment to share such information with your potential employer before its own checks bring the fact to light.

Of course, you may find that the recruiting organisation itself is not as open and forthcoming as you might wish – for example, if you try to find out why the previous postholder left so that you can check that the opportunity matches up to the glamorous description that appeared in the advertisement. We try to encourage both parties involved in the recruitment process to be as honest and open as they can be while assessing one another.

### FIRST STEP

Ultimately, remember that the CV is merely a preliminary part of the recruitment process. It is mainly used to screen out those who are unlikely to be a fit from those who may be suitable. Other candidate-screening procedures and factors, such as how you come across at interview and your personal reputation in the IP field, will eventually decide the outcome, if your carefully crafted CV has got you past the first hurdle. ■

1. Full details of the case can be viewed at [bit.ly/SRAMcCooe](http://bit.ly/SRAMcCooe).



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[2016] EWHC 2911 (Ch), Victoria Plum Ltd v Victorian Plumbing Ltd and Others, High Court, 18th November 2016

**THE CLAIMANT**, Victoria Plum Ltd (which has also traded as Victoria Plumb), and the First Defendant, Victorian Plumbing Ltd, are both bathroom retailers that operate primarily or exclusively online. Both firms were founded in 2001 and have grown to become significant businesses: the Claimant has an annual turnover of around £70m, and the First Defendant's turnover is more than £40m.

The Claimant owns UK trade mark registrations for VICTORIA PLUMB and for a figurative mark including the words "Victoria Plumb", as well as an EU registration for victoriaplum.com.

The Defendants advertised using a number of Google keyword terms that, they accepted, were confusingly similar to the Claimant's trade marks. Despite a long period of the two similarly named businesses trading side by side, Justice Carr decided that the Defendants' use was such that their defence of honest concurrent use could not succeed.

### KEYWORD STRATEGY

Advertisers can select particular words that, when entered as part of a search string on a search engine such as Google, might cause their ad to be displayed above "natural" or "organic" search results (ie those that have not been paid for). Google does not charge for displaying the ad – rather, it charges the advertiser each time its ad is clicked on; hence the term "pay-per-click advertising".

Given that the Claimant and First Defendant operate primarily or exclusively online, keyword advertising is a significant part of their respective businesses.

The Claimant alleged that the First Defendant's use of the following keyword terms, and the resulting ads that displayed those keywords, amounted to infringement of its trade mark registrations: "victoria plumb", "victoria plum", "victorian plumb", "victorian

plum" and other equivalent terms as a single word without the space.

Google does not prevent advertisers from selecting trade mark terms as keywords. The selection of a trade mark as a keyword does not necessarily amount to infringement – it depends on the content of the advertisement that is presented.

In Google France SARL v Louis Vuitton Malletier SA<sup>1</sup>, the CJEU determined that there is infringement if the origin function of a trade mark is adversely affected, which would be the case "if the ad does not enable normally informed and reasonably attentive internet users, or enables them only with difficulty, to ascertain whether the goods or services referred to by the ad originate from the proprietor of the trade mark or an undertaking economically connected to it or, on the contrary, originate from a third party".

The Defendants' ads included terms that were the same as the keywords, as well as "victoria plumbing".

The Google France decision was limited to a double-identity situation (ie the use of a keyword identical to a trade mark registration in respect of identical goods) and has been followed in other double-identity cases, such as Interflora Inc v Marks and Spencer plc.<sup>2</sup> However, in the current case, Carr J applied the same approach in respect of keywords that were admitted to be confusingly similar to, but not identical with, the trade marks. He found the origin function to have been negatively affected and that, subject to the pleaded defences, there was infringement.

### DYNAMIC INSERTION

Some of the Defendants' ads included visible use of "Victoria Plumb" (ie identical to the Claimant's trade mark). The Defendants accepted that these ads, which contained the words "Victoria Plumb", amounted to

# Search back in the spotlight

*George Sevier looks at a recent decision that counsels caution on ad keyword strategy*

infringement and submitted to judgment. However, the content of the ads was not intentional – rather, it was the result of Google’s “dynamic keyword insertion” (DKI) service, which automatically displays the search term as the main text in the ad.

The object of DKI is to make the ad appear more relevant to the internet user, and therefore more likely to be clicked on. This is attractive to advertisers, because it means that the advertiser’s website is more likely to be visited. DKI also benefits Google, because it means that an internet user might be more likely to click on an ad (resulting in pay-per-click revenue) rather than an organic search result.

Advertisers using DKI lose control of their ad content and need to exercise caution when using it. Unless advertisers use DKI “negative match” for particular trade marks, a search for a term that includes a keyword plus a trade mark could result in that trade mark appearing in an ad, which would most likely amount to infringement, as in this case.

## DEFENCES ADVANCED

With regard to those uses that were not the result of DKI, the Defendants admitted using marks that were confusingly similar to the Claimant’s trade marks and sought to rely on defences of estoppel, acquiescence and honest concurrent use. The first two were given short shrift. The Judge considered honest concurrent use at greater length.

The concept is not provided for in the Trade Marks Directive (Directive 2008/95/EC) or Trade Marks Regulation (Council Regulation (EC) No 207/2009), but is a long-recognised defence. In *Phones 4U Ltd v Phone4U.co.uk Internet Ltd*<sup>3</sup>, Lord Justice Jacob said:

“An example of [honest concurrent use] is the old case of *Dent v Turpin* (1861) 2 J&H 139. Father Dent had two clock shops, one in the City, the other in the West End. He bequeathed one to each son – which resulted in two clock businesses each called Dent. Neither could stop the other; each could stop a third party (a villain rather appropriately named Turpin) from using ‘Dent’ for such business. A member of the public who only knew of one of the two businesses would assume the other was part of it – he would be deceived. Yet passing off would not lie for one son against the other because of the positive right of the other business. However it would lie against the third party usurper.”



In the current case, the Defendants alleged that the parties had honestly built up their respective businesses and reputations using confusingly similar names over many years. They said that each party had to live with the confusion, because the Claimant’s trade mark had never denoted to the average consumer the services of a single entity.

## CAUSE FOR CONFUSION

However, the case law makes it clear that, to rely on the honest concurrent use defence, the defendant must not take steps that exacerbate the level of confusion beyond that which is inevitable. In the current case, the Defendants had bid on keyword terms such as “Victoria Plum”, which is the name of the Claimant. Carr J held that, by doing so, they will have caused confusion that may not have existed had they restricted keywords and visible ads to “Victorian Plumbing”. As such, the defence was not available, and this keyword advertising was considered to amount to infringement.

The Claimant had also used “Victorian Plumbing” as a search keyword term, producing ads that contained “Victoria Plum” or “Victoria Plumb”. That was found to amount to passing off.

Although honest concurrent use can provide a defence to infringement, this decision highlights that the breadth of use may be very restricted. This is particularly so online, where bidding on keywords, including typographical errors around one’s own name, would otherwise be an ordinary part of doing business.

## KEY POINTS

- ▶ The selection of a trade mark as a keyword does not necessarily amount to infringement – it depends on the content of the advertisement that is presented
- ▶ Advertisers using dynamic keyword insertion lose control of their ad content and need to exercise caution when using it
- ▶ To rely on the honest concurrent use defence, the defendant must not take steps that exacerbate the level of confusion beyond that which is inevitable

1. C-236/08.
2. [2014] EWCA Civ 1403.
3. [2006] EWCA Civ 244.



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# Naming and blaming

*Ben Evans considers who really owns the goodwill in a professional's surname*

**THE QUESTION OF** whether a partner in a firm of solicitors owns the goodwill that she develops in the course of her professional duties has come before the IPEC.

The First Claimant, Ms Juthika Bhayani, was a respected employment solicitor who had joined Taylor Bracewell LLP (the Defendant) in 2011 as a salaried partner and had entered into a contract of employment and a limited liability partnership with the firm. It was agreed that the Defendant would offer employment law services under the name “Bhayani Bracewell” and register the UK trade mark BHAYANI BRACEWELL.

Following a finding of gross misconduct, the First Claimant left the firm in October 2014 and set up to practise under the name Bhayani Law Ltd, the Second Claimant. In the meantime, the Defendant continued to offer employment law services using the Bhayani Bracewell name.

Ms Bhayani objected and, in 2016, issued proceedings alleging that:

- by using the Bhayani Bracewell name to provide employment law services, the Defendant had falsely represented that Ms Bhayani was still involved with the firm and thus passed off its services as being those of Ms Bhayani; and
- in consequence, that the Defendant's use of the trade mark was liable to mislead the public, and it should thus be revoked pursuant to s46(1)(d) of the Trade Marks Act 1994 (the Act).

The Defendant denied both allegations, contending that: neither Claimant owned any goodwill sufficient to base a claim of passing off, and that any goodwill associated with the Bhayani Bracewell trading name was owned by the Defendant as a result of the partnership agreements; and that it enjoyed a contractual right to use the Bhayani Bracewell name under

the partnership agreements, and thus the trade mark should not be revoked.

Taylor Bracewell counterclaimed, alleging breaches by Ms Bhayani of the partnership agreement, and applied for summary judgment against the Claimants or, in the alternative, to strike out the Claimants' claim.

## SUMMARY JUDGMENT

The parties were in agreement that the alternative applications were, essentially, one and the same. For simplicity, His Honour Judge Hacon treated the application as being for summary judgment only.

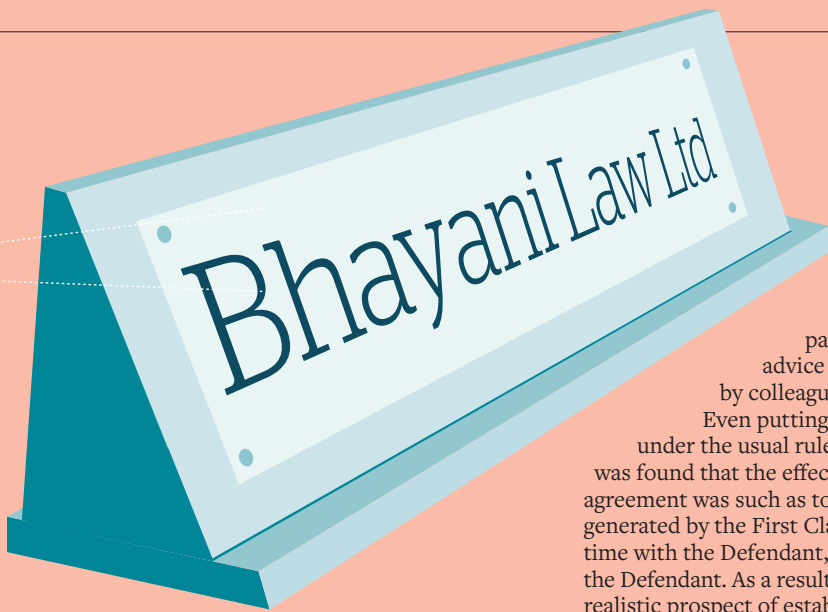
Ms Bhayani's position was that the goodwill she generated while at her previous employer and at the Defendant was associated with her own name and was thus, at all times, owned by her. It was argued that it was not necessarily the case, in law, that goodwill generated by an employee or partner was vested in the employer or partnership – rather, it would depend on the facts that needed to be explored at trial.

It was accepted that Ms Bhayani had acquired a reputation in the field of employment law. However, reputation is not the same as goodwill, and it is goodwill that is required to found an action for passing off: “Reputation alone cannot form the basis of an action for passing off, no matter how high the wattage of celebrity.”



*It was accepted that Ms Bhayani had acquired a reputation in that field. But reputation is not the same as goodwill, and it is goodwill that is required to found an action for passing off*





Following *Starbucks (HK) Ltd v British Sky Broadcasting Group plc*<sup>1</sup>, Hacon J noted that goodwill could not subsist alone and was indivisible from the business with which it was associated. In general, therefore, goodwill generated by an employee or partner would be vested in the employer or partnership.

### IRVINE EFFECT?

However, it was accepted that, on certain facts, an employee or partner could generate goodwill of their own, distinct from that of the employer or partnership. Goodwill could be generated by an individual's acts done outside of duties to the employer or partnership. Distinguishing the case at issue from the well-known case of *Edmund Irvine Tidswell Ltd*<sup>2</sup>, Hacon J reasoned that, in the latter, Mr Irvine was contracted to Ferrari as a racing driver, but that did not include the endorsement of products using his name. Accordingly, the business of endorsing products was deemed to be quite separate from that of a racing driver and generated an independent goodwill that vested in Mr Irvine.

Applied to the present case, Hacon J's view was that Ms Bhayani's professional activities, which had built up the reputation that she enjoyed, were done in the course of the business of her previous employer, or of the Defendant. There were no unusual facts to trigger a situation akin to that in Irvine, and, therefore, under the usual rules, the goodwill vested in Ms Bhayani's previous employer and the Defendant (as appropriate).

Sole practitioners aside, Hacon J noted that "the public are well aware that a solicitor, whether employed or an equity partner, is not a free agent" and that their work "will be both assisted and constrained by the terms of

employment or partnership and by the advice and pressure exerted by colleagues".

Even putting aside the position under the usual rules of passing off, it was found that the effect of the partnership agreement was such as to render any goodwill generated by the First Claimant, during her time with the Defendant, as being owned by the Defendant. As a result, the Claimants had no realistic prospect of establishing that the First Claimant owned goodwill on which to base a case of passing off, and judgment was entered for the Defendant on the passing off claim.

Moving to the revocation issue, Hacon J decided that, even if the Defendant retained a contractual right to use the Bhayani Bracewell name, it did not necessarily follow that its use of that mark would not engage s46(1)(d) of the Act. The claim to revoke the mark had a realistic, as opposed to fanciful, prospect of success at trial, and was therefore allowed to proceed.

Perhaps predicting a backlash against this decision, Hacon J made it clear that, in appropriate cases, it would be possible for a solicitor to take action against a former firm if it represented that the solicitor was still employed by it or remained a partner. Such actions could be on the basis that the goodwill associated with the name of the solicitor vested in the new firm (which could bring a passing off action) or as an injurious falsehood.

### POTENTIAL SHOCK

Although the decision is perhaps unsurprising given the relevant terms of the partnership agreement, it may nonetheless come as a shock to the many professionals who, incorrectly, assume that the reputation they enjoy equates to an actionable goodwill. In future, it seems likely that we will see a greater focus on the IP aspects of partnership agreements in professional firms.

### KEY POINTS

- ▶ Reputation is not the same as goodwill
- ▶ It may still be possible for a solicitor to take action against a former firm on the basis of goodwill vested in a new firm or injurious falsehood
- ▶ Partnership agreements may put a greater focus on IP in future

1. [2015] UKSC 31.
2. [2002] EWHC 367 (Ch).



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# Dated furnishings

*Maya Muchemwa warns that revocation dates must serve the purpose of the objective*



**IN THIS CASE**, the Registrar consolidated two related proceedings: a revocation action for the mark LOVE WHERE YOU LIVE in classes 20 and 35, owned by Varnish Bidco Ltd (the Proprietor); and the Proprietor's opposition action against HARVEYS LOVE WHERE YOU LIVE in classes 20, 24, 27 and 35, filed by GT Global Trademark AG (the Applicant).

The Applicant's revocation application claimed the effective revocation date of 24th July 2015. The Proprietor filed a defence and counterstatement stating that the mark was in use at all material times and had commenced or had resumed use before the revocation application date.

On 23rd July 2015, the Applicant had also filed a new trade mark application for HARVEYS LOVE WHERE YOU LIVE, which was, in turn, opposed by the Proprietor under s5(2)(b) of the Trade Marks Act 1994. The Applicant denied the grounds and referred to its request for proof of use and its revocation application.

The Registrar clarified whether a mark that has been revoked can be relied upon in an opposition if the opposed mark was filed before the claimed effective date of revocation. In this case, the application was filed just a day before. The Registrar's answer was: yes, it can. Even if the mark went on to be revoked in full, the rights in the earlier mark would have been in force at the time of the application for the later mark. Therefore, the Registrar had to consider the proof of use request and the opposition, even if the revocation had been successful.

2013, and plans from early 2015 to reintroduce the trade mark. The Registrar considered the "flyer use" did not qualify as "real commercial use for the purposes of creating an outlet for goods and services" because: (i) the flyers were used briefly (two months); and (ii) any customers following the flyer would not have seen the trade mark on the website provided (there was no evidence it appeared). Therefore, the use was inconsistent with the essential function of a trade mark.

As regards the plans to reintroduce the trade mark, there was very little supporting evidence: pages from a website dated after the relevant periods on which the trade mark appeared at the bottom of the page, and a draft brochure, which included the trade mark on the last page under the small print. The Registrar questioned how visible the mark would have been to consumers in both examples. The mark was therefore found not to have been put to genuine use in both the revocation and opposition proceedings.

## TARGETED TIMING

Although the Applicant was successful, this case highlights the need to get the relevant dates for revocation right, as a revoked trade mark can still be relied upon in an opposition if the claimed relevant period ends after the application is filed. It is important to ensure that the dates serve the intended objective, which is to remove an obstacle from the register *prior* to filing a new application. This can save time and unnecessary costs for trade mark applicants.

## KEY POINT

- ▶ A revoked trade mark can still be relied upon in an opposition if the claimed relevant period ends after the application is filed. Ensure that the dates serve the intended objective

## KEY EVIDENCE

The key pieces of evidence the Proprietor adduced were flyers advertising "MFI" (a Proprietor-affiliated company) that were enclosed in packages with 25,000 customer orders under "Victoria Plumb" (a Proprietor-affiliated company) between July and August



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# All at sea

*Sharon Daboul offers an update on a familiar, even infamous, trade mark decision*

**THE CJEU'S 2004** decision on LA MER<sup>1</sup> is one with which practitioners will be familiar. It ruled that even minimal sales would suffice to establish genuine use of a trade mark in a revocation action.

In this 2016 decision concerning the same parties, the UK IPO agreed to revoke the notorious registration on the basis that it had been used for different goods to those registered.

## FACTS REFRESHER

Laboratoire De La Mer (LDL) had registered the mark LABORATOIRE DE LA MER in the UK for “cosmetics containing marine products” in 1989.

In 2015, La Mer Technology Inc (LMT) applied to revoke the registration, claiming that, under s46(1)(b) of the Trade Marks Act 1994, there had been no relevant use of the trade mark in the five-year period from 1st September 2010 to 31st August 2015.

LDL had used the mark on two product ranges: RESPIMER (a nasal wash for treating nasal congestion) and AUDICLEAN (a product for preventing the build-up of excess earwax). LMT claimed these products were not cosmetics and that use on such goods should not support the registration.

LDL argued that its products were cosmetics because they fell within the definition of the term set out in the EU's Regulation (EC) No 1223/2009 on cosmetic products: “any substance or mixture intended to be placed in contact with the external parts of the human body ... with a view to cleaning them ... protecting them [or] keeping them in good condition”. LDL claimed that AUDICLEAN was intended for cleaning the epidermis of the ears, and RESPIMER for cleaning the mucous membranes of the nasal cavity.

LMT referred to a dictionary definition of “cosmetic” and argued that specifications in trade marks must be given their natural and usual meaning.

Both sides filed evidence. The hearing was attended by LMT, with LDL relying on written submissions.

## LATEST DECISION

In the December 2016 decision, the Hearing Officer agreed with LMT that he should consider the natural meaning of the word “cosmetic” as it would appear to the average consumer of the product. He commented on the way LDL had marketed the goods, its stated purpose being to alleviate medical symptoms, and recognised that most consumers would view the products as medicinal. He added that he was not bound by the cited EU regulation, even if it was applicable to LDL's products.

He concluded: “A cosmetic would be readily understood to mean ‘a preparation for use in beautifying the face, skin or hair’. This is not a description which would be used by anyone with regard to the products relied upon by LDL.”

The application for revocation succeeded, and LMT was awarded costs of £2,800. The mark was considered revoked with effect from 1st September 2015.

## REVIEW REQUIRED

UK trade mark registrations can be revoked for a number of reasons, including that the mark is not used in respect of the goods and services covered by the registration (provided there are no proper reasons for non-use).

The decision is a reminder that, especially with long-standing trade marks, it is important to periodically review how a trade mark is being used and ensure that its protection remains adequate.

## KEY POINTS

- ▶ Words used in a specification should be given their natural and usual meaning
- ▶ A court should consider how a notional consumer would describe the use made of the mark
- ▶ The way products are marketed is taken into account

**1.** La Mer Technology Inc v Laboratoires Goemar SA, C-259/02.



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# LUCKY BREAK

*Désirée Fields reports on why two parties share the rights in respect of a disputed mark*



**ON 5TH JULY 2013**, Mariage Frères, Société Anonyme (MF) filed a UK trade mark application for LUCKY TEA in classes 21 and 30. TWG Tea Company Pte Ltd (TWG) opposed this under sections 3(3)(b), 3(6) and 5(4)(a) of the Trade Marks Act 1994 (the Act) arguing that: (i) the mark was deceptive when used in respect of non-tea or tea-based goods; (ii) MF had no bona fide intention to use its mark for all goods applied for; and (iii) TWG had earlier unregistered rights in LUCKY TEA, LUCKY ME TEA and LUCKY YOU TEA, under which it claimed to have been selling teas since at least 2010





and to have acquired the requisite goodwill. MF filed a counterstatement denying the claims made and put TWG to strict proof of use.

On 28th August 2013, TWG filed a UK trade mark application for a figurative series mark incorporating LUCKY TEA in classes 21 and 30 (shown overleaf). MF opposed the application on the basis of sections 3(6), 5(1), 5(2)(a), 5(2)(b) and 5(4)(a) of the Act. The s3(6) (bad faith) and s5(2)(a) grounds were subsequently withdrawn, and MF proceeded with the claim that TWG’s mark was identical or similar to its mark, and applied for in respect of identical and similar goods. MF also alleged that it had earlier rights in the signs LUCKY NUMBER TEA, LUCKY and LUCKY STAR, had been selling teas under signs incorporating the word LUCKY since 2006, and had acquired goodwill under the sign.

The UK IPO consolidated both sets of proceedings. Both parties filed witness statements and evidence of use in support of their respective oppositions.

### TWG OPPOSITION

#### Section 5(4)(a)

After recounting the classic trinity for a successful passing off claim – goodwill/reputation, misrepresentation and damage –

the Hearing Officer (HO) noted that the relevant date for assessing such a claim was usually the date of the application for registration, or the priority date, if applicable. However, where the applicant had used the mark before the date of the application, it was necessary to consider



*The HO noted that a person was presumed to have acted in good faith unless the contrary was proved*

what the position would have been at the date the behaviour complained about started and to assess if the position would have been different at the later date when the application was made.

In the present case, MF’s mark had been applied for on 18th June 2013. Although this was the primary date for assessing goodwill, MF had alleged that it had used the sign LUCKY NUMBER TEA from November 2006, LUCKY since 2007 and LUCKY STAR since December 2007. Therefore, the position also had to be considered at those dates.

The HO first considered whether TWG had acquired the necessary goodwill at the primary relevant date. The evidence showed that the level of sales in respect of the signs had been

very small under the three marks in the three years prior to the relevant date. Further, the evidence showed that the volume of sales had peaked in 2010 and subsequently declined. Ultimately, the HO concluded that only trivial goodwill existed in the marks.

#### Section 3(6)

The HO considered TWG’s bad faith claim, noting that a person was presumed to have acted in good faith unless the contrary was proved. However, it was possible for the burden of proof to shift where the applicant for revocation could show that the applicant did not have an intention to use a mark across the whole range of goods or services covered by the application.

The HO noted that TWG had raised a compelling case that MF did not have an intention to use its marks across the full range of goods claimed by citing the incompatibility of a sign indicating a type of tea being used in respect of goods unrelated to tea. The HO rejected MF’s argument that it could use the mark to promote coffee and that coffee could be sold under the LUCKY TEA brand, because of the potential to deceive the public if it did so. The HO found that MF acted in bad faith when it claimed to have an intention to use the LUCKY TEA mark in relation to goods in class 30 that were not tea or tea-based. However, the HO dismissed the bad faith claim in relation to class 21 goods.

#### Section 3(3)(b)

The HO noted that an objection under s3(3)(b) should be raised only where there was a real, as opposed to purely theoretical, potential for deception of the public. Although it was clear that, where the mark TEA was applied to beverages or goods for making beverages that were not tea or tea-based, consumer deception would result, the HO accepted that other goods could be flavoured with tea and that the sign could therefore be used in a non-deceptive way. The same applied to goods in class 21.

#### Outcome

The HO found that TWG’s passing off case failed entirely, but that TWG achieved some success in its bad faith and deception claims. Accordingly, the HO rejected MF’s application in relation to a number of goods in class 30. MF’s application was allowed to proceed in respect of all of the goods covered in class 21 and “tea, tea-based beverages; non medical infusions; dried plants and flavourings, and mixtures of the aforesaid goods, for preparing non-medicinal beverages” in class 30. ▶



## MF OPPOSITION

Because TWG only partially succeeded in its attack on the earlier mark, it was necessary to consider MF's opposition.

### Section 5(1)

The HO found that the respective marks were self-evidently not similar because of the fan-like device elements, the shape of the canister, the six-sided label shape and the TWG sign present in TWG's mark. Therefore, MF had no prospect of success under this section.

### Section 5(2)(b)

The HO first found that the goods covered by the respective marks in class 21 were either identical or virtually identical. In respect of class 30, he found that TWG's tea-based products were all included or covered by the terms listed in MF's specification and self-evidently identical. In respect of TWG's coffee and coffee-based beverages, the HO found that the respective goods were highly similar. However, foodstuffs such as spices, sugar, chocolate, baked goods, sauces, puddings and bread were neither in competition with nor complementary to tea-based products, and therefore not similar to MF's goods.

Assessing the similarity of the marks, the HO noted that TWG's mark consisted of a number of elements, but found that the words LUCKY TEA were the dominant element because of their large size and their position in the middle of the label. By contrast, MF's mark consisted of the elements LUCKY TEA. The element "tea" had a descriptive meaning in respect of the goods covered by the application, but the mark's distinctiveness lay in the combination of the two words, the adjectival use of LUCKY turning the composite mark into a complete and understandable phrase.

Visually, the HO found that the respective marks had a medium level of similarity. Aurally, he found that consumers would refer to TWG's mark as LUCKY TEA or possibly TWG LUCKY TEA. Accordingly, it was found that the marks were either aurally identical or shared a high level of similarity. Although the HO did not ignore the various elements in TWG's mark, he found that it was likely to be dominated by the element LUCKY TEA. Therefore, the respective marks as a whole shared a good deal of conceptual similarity.

The HO noted that the class 30 goods of both parties could be described as ordinary grocery products and did not involve an enhanced level of attention. The same was true of the parties' goods in class 21, which were not uncommon or expensive purchases.

The HO then considered the distinctiveness of MF's earlier mark, finding that, although the mark LUCKY TEA as a whole was "not of the lowest or highest level of distinctive character", he would have considered it to be lower rather than higher. The HO found only very small evidence of use in the context of tea and related products in the UK, insufficient to enhance the mark's distinctive character.

Assessing the likelihood of confusion globally, the HO concluded that there was a likelihood of indirect confusion in relation to all the goods in class 21, and coffee and tea-related goods in class 30. There was no similarity between the remaining goods in class 30.

### Section 5(4)(a)

Because MF's opposition wholly succeeded under s5(2) in respect of class 21, the HO disregarded MF's goodwill claim in respect of its LUCKY marks. In respect of class 30, he found that MF had failed to demonstrate acquired goodwill at the relevant date and dismissed the passing off claim.

### Overall outcome

In summary, TWG's opposition succeeded in respect of all non-tea goods in class 30, but failed both in respect of goods in class 21 and any tea-related products in class 30.

## SPLIT DECISION

Although the parties effectively split the ownership of the LUCKY TEA mark, in practice, MF appears to have been the more successful party, as it was held to own the rights to LUCKY TEA in relation to tea and tea-based products. Interestingly, this is not the first trade mark dispute between these parties, who have fought other trade mark battles in the sphere of tea, such as SAKURA<sup>1</sup>, involving an unsuccessful bad faith claim by MF against TWG.

Irrespective of their outcome, these cases are instructive in relation to the standards of proof required in respect of claims of bad faith, confirming that such an allegation requires cogent evidence, but, at least in the LUCKY TEA case, is not impossible to establish, as the burden of proof may well be reversed if the party alleging bad faith is able to provide evidence of a lack of intent to use the mark.

## KEY POINTS

- ▶ Ordinarily, trade mark owners are not required to advance positive evidence of an intention to use
- ▶ The burden of proof may shift where the applicant for revocation can show that the applicant has no intention to use in relation to all goods and services applied for
- ▶ The TWG UK trade mark applications



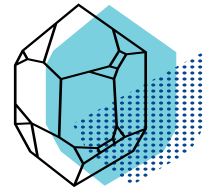
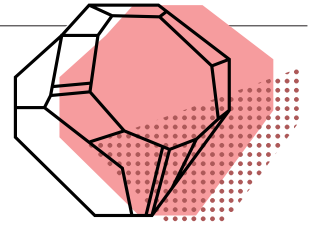
1. O/170/15 SAKURA (Opposition), UK IPO (15th April 2015).



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# The goodwill maze

Charlotte Wilding condenses  
a complex television brand tangle

**MAD PROFESSOR LTD (MP)** is the proprietor of UK trade mark No 3060820 **THE CRYSTAL MAZE (TCM)** for *inter alia* “team building events” in class 41. Adventure Line Productions SAS (**ALP**) sought to invalidate the registration under s5(4)(a) of the Trade Marks Act 1994 (passing off), basing its claim on use of TCM since February 1990 in respect of “entertainment services, in particular television programmes, games and challenges”.

MP denied ALP’s claims with five arguments: its mark was lawfully registered, the marks were not identical, ALP did not own the goodwill, there was no misrepresentation, and there was no damage. The first two were quickly dismissed. Ultimately, the key issue in the case was goodwill – in particular, ownership of it. MP’s mark was filed on 20th June 2014, but the relevant date to consider was 21st June 2011, the first date on which MP made use of TCM on its website.

## CONFUSING CHAIN

The Registry found it clear that “the popularity of the television programme would have generated a valuable and protectable goodwill”. Further, MP stated that it used TCM as a parody, meaning that it must have considered TCM to be an attractive pull for customers. Accordingly, goodwill was found to have survived both relevant dates.

However, if a passing off claim were to succeed, ALP must have owned the goodwill. The chain of title is quite confusing. In brief:

- Chatsworth Enterprises Ltd (CEL) approached Mr Jacques Antoine, creator of the television series *Fort Boyard*, to acquire the rights in that format for Channel 4. As the filming location was not available, a new format was created, *The Crystal Maze*.
- The format rights were assigned to CEL by way of an agreement with Jacques Antoine et Cie (JAC), a company set up by Mr Antoine. It included an automatic reassignment clause that took effect when Channel 4 failed to recommission the programme.

- CEL is the owner of the now expired UK trade mark No 1439028, shown on this page.
- JAC merged with Expand Images in 1996, becoming Studio Expand. In 2004, Studio Expand entered into an agreement with ALP regarding the *Fort Boyard* rights; there was no mention of TCM rights.
- Before its liquidation in 2007, CEL assigned its rights in TCM to Chatsworth Enterprise Ltd (CEL 2). This assignment was contrary to the automatic reassignment clause between CEL and JAC, and, therefore, a settlement agreement was reached in 2009 between ALP (the claimed successor of JAC) and CEL, CEL 2 and Mr Heyworth (Director of CEL and CEL 2). ALP claimed that the 2009 agreement transferred the goodwill in TCM to ALP.

The Registry found that goodwill originally subsisted with CEL. On review of the agreement between CEL and JAC, the Registry held that the goodwill was not assigned back to JAC when the rights to exploit the format were returned to it. Therefore, the assignment of goodwill would need to have taken place under the 2009 agreement.

The Registry’s deliberation is redacted, but it is noted that, while some rights were transferred to ALP, the transfer of goodwill was “too great a leap”. As ALP did not own the goodwill in TCM, the application for invalidation ultimately failed.

## OWNER IMPORTANCE

This case highlights the importance of ensuring that the owner of goodwill is clear. Had the claim been brought by the owner of the goodwill, it would have succeeded, given that the Registry found a likelihood of misrepresentation and damage.

## KEY POINTS

- ▶ All three elements of passing off are required for a claim to succeed
  - ▶ The application for invalidation failed because the Applicant did not own the goodwill
  - ▶ Ensure there is clear ownership of goodwill
- 
- ▶ UK trade mark No 1439028



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# Sweden gets straight answer

*Jessica Wolff welcomes confirmation of a five-year grace period for genuine use*

**IN THIS REFERRAL** from the Supreme Court of Sweden, the CJEU was asked a straight question – and gave a straight answer. But many attorneys will be surprised that the question had to be asked at all.

The Supreme Court asked: “Does it affect the proprietor’s exclusive right that, during a period within five years from registration, he has not made genuine use of the [EU] trade mark in the European Union for goods or services covered by the registration?”

And, it also asked, if the answer to that question was in the affirmative, in what circumstances and in what way would that situation affect the exclusive right?

The question arose because of an action by Länsförsäkringar AB, which owns EU trade mark (EUTM) registration No 5423116 for the device mark shown right. The specification of that registration includes services not currently provided by the proprietor. Those services are similar to the services provided by Matek A/S under the three-colour logo also shown.

Länsförsäkringar successfully applied to the Stockholm District Court on the basis of Article 9(1)(b) of Council Regulation (EC) No 207/2009 (the Regulation) for an order prohibiting Matek from using signs similar to Länsförsäkringar’s mark in Sweden.

Although Länsförsäkringar had not used its trade mark in respect of the services that are similar to those of Matek, Länsförsäkringar’s registration was not yet five years old. So, the Stockholm District Court concluded that Länsförsäkringar could rely on all the services for which it had registered its mark, and found a likelihood of confusion between the trade marks in respect of these similar services.

However, on appeal, the Svea Court of Appeal in Sweden held that the similarity of the goods and services at issue should be assessed not with regard to all the goods and

services for which a mark is registered, but with regard to the goods and services in respect of which the mark has been used, even during the initial five years after registration. Applying this test, the Svea Court of Appeal found no likelihood of confusion.

Länsförsäkringar appealed, and the Supreme Court of Sweden referred the question to the CJEU.

## **NO RESTRICTIONS**

The CJEU’s response was unequivocal: the scope of the exclusive right conferred on the proprietor of an EUTM registration is not restricted in the first five years of that registration by the use made of the mark. It ruled that:

“Article 9(1)(b) of Council Regulation (EC) No 207/2009 of 26 February 2009 on the [European Union] trade mark, read in conjunction with Articles 15(1) and 51(1)(a) of that regulation, must be interpreted as meaning that, during the period of five years following registration of an EU trade mark, its proprietor may, if there is a likelihood of confusion, prevent third parties from using in the course of trade a sign identical or similar to his mark in respect of all goods and services identical or similar to those for which that mark has been registered without having to demonstrate genuine use of that mark in respect of those goods or services.”

Although Recital 10 in the preamble to the Regulation states that “there is no justification for protecting [EUTMs] ... except where the trade marks are actually used”, the Regulation makes clear that there is a five-year “grace period” before this principle kicks in.

*Note: the language of the case was Swedish.*

## **KEY POINTS**

- ▶ Although no use had been made of the registered mark in respect of the similar services, as the mark had not yet been registered for five years, the assessment of likelihood of confusion did not need to take account of that fact
- ▶ Recital 10 of the preamble to the Regulation should not be read as limiting the five-year “grace period” that a proprietor enjoys for beginning use of their mark

- ▶ Registration No 5423116

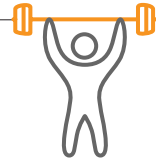


- ▶ The Matek A/S mark



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# No go on Go Sport

*Tom Coop explains why time was called on a missing ground for appeal*

**THE EU GENERAL COURT (GC)** has upheld the decision of EUIPO's Board of Appeal (BoA) to dismiss Groupe Go Sport's appeal because it failed to submit a timely statement of grounds, rejecting arguments that the delay was caused by a technical failure of EUIPO's system.

Go Sport had filed an application that had been opposed by a third party. The opposition was partially upheld on 20th January 2015. On 19th May 2015, EUIPO (having already received the notice of appeal) received two electronic communications relating to the statement of grounds of appeal, but did not receive the grounds themselves. On 26th May 2015, EUIPO sent a letter to Go Sport declaring the appeal inadmissible, citing that no grounds were submitted, and set a deadline of 26th June 2015 to rectify the error. Go Sport submitted observations on 18th June 2015, and a copy of the grounds was included. However, this was declared inadmissible by the BoA. Go Sport appealed the BoA decision based on the grounds that:

1. EUIPO failed to receive the grounds on 19th May 2015 owing to a failure of EUIPO's system; and
2. Go Sport included a copy of the grounds in its 18th June 2015 response and therefore rectified by the deadline of 26th June 2015.

## GC RESPONSE

The GC addressed Go Sport's arguments in turn:

1. Evidence submitted by Go Sport's attorneys showing its client approved the grounds on 13th May 2015 was dismissed; it failed to prove that the grounds had been submitted by the deadline.
2. A technical report dated June 2015 and supporting a claim there was a failure with the EUIPO communication system when it tried to upload the grounds in May was rejected.

An incident report does not prove that there was a failure or that the grounds of appeal were submitted by the deadline.

3. Go Sport submitted a document showing other issues it had experienced with the online communication system previously. This was rejected on the basis that they were mere assertions and did not confirm the grounds had been filed by the deadline. EUIPO also submitted evidence showing the system was working on 19th May 2015, which reduced the validity of Go Sport's arguments in the GC's opinion.
4. Finally, Go Sport argued that its filing of the grounds on 18th June 2015 rectified the deficiency by 26th June 2015. This was rejected by the GC. The 26th June 2015 deadline was an opportunity to prove that submissions had been made by the deadline, not an opportunity to resubmit. To allow the grounds to be accepted without a viable explanation as to why they had not been included on 19th May 2015 would otherwise have allowed Go Sport to circumvent the set deadline.

## WARNING SHOT

This decision serves as a warning to ensure that all documents are included on all electronic submissions to EUIPO. Users of EUIPO's electronic systems should check the online record immediately after submission to ensure all documents are included. If in doubt, consider further steps, such as a resubmission, a call to EUIPO's information centre and/or a fax message.

## KEY POINTS

- ▶ A date for rectification is not an opportunity to resubmit documents
- ▶ When making electronic filings, check immediately that all documents are included



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# Independent thinking

*Once again, previous decisions were shown to hold no sway, writes Rachel Hearson*

ON 14th NOVEMBER 2003, Apax Partners LLP (the Applicant) filed an EU trade mark (EUTM) application for the word mark APAX in classes 16, 35 and 36 for goods and services including printed matter, advertising, business management, insurance and financial affairs services. Apax Partners Midmarket opposed the application based on its international registration for the APAX mark designating Spain in classes 16, 35 and 36 (among others). The opposition was based on Articles 8(1)(a) and (b) of Council Regulation (EC) No 207/2009 (the Regulation).

The Opposition Division upheld the opposition, and an appeal by the Applicant to the Board of Appeal (BoA) was also dismissed.

The Applicant then filed a further appeal to the General Court (GC). The Applicant's sole argument was that the BoA had incorrectly assessed the similarity of the goods and services, citing various previous decisions in support of this. The GC upheld the BoA's decision in full.

The Applicant relied heavily on previous decisions of the Opposition Division and BoA in substantiating its arguments. However, without greater exposition, the GC was not persuaded. The GC, citing the judgments of FLEXI<sup>1</sup> and EXACT<sup>2</sup>, reiterated that the registrability of an EUTM is determined by reference to the Regulation, as interpreted by EU courts, and that the GC is not bound by previous decisions or practices.

## COMPARISON

Noting that the two signs were identical, as were some of the goods/services, the GC focused on the similarity of the remaining goods/services.

In upholding the BoA's decision in full, the GC focused in particular on the purpose and intended consumers of the services, and whether they were likely to be supplied by a single provider. On this basis, "advertising",

"office functions" and "business administration" services were considered similar to "business management" services, and "insurance" services were similar to "financial affairs" services. The Court also concluded that "photographs" were similar goods to "printed matter", as the latter could be devoted entirely to the former (eg photo albums) and the two can serve a common purpose (eg the display of images).

## CONFUSION

The GC emphasised the interdependence of factors relevant to likelihood of confusion. Here, the identity of signs compensated for the low level of similarity between some of the services, and, therefore, a likelihood of confusion was present. This was so even in the case of the class 35 and 36 services aimed primarily at professional business customers with a higher level of attention than the general public.

## LESSONS

This case highlights the importance of establishing the likely consumers and suppliers of services when assessing similarity.

It also reiterates the interdependence of the factors relevant to assessing likelihood of confusion. A low level of similarity between the goods/services does not necessarily preclude likelihood of confusion being found, particularly if the signs are identical.

Finally, this case serves as a reminder to both applicants and opponents not to rely heavily on previous decisions of EUIPO, as these will not bind the GC.

## KEY POINTS

- ▶ It is important to establish the likely consumers and suppliers of services when assessing similarity
- ▶ Likelihood of confusion can be found even when there is a low level of similarity between goods and services
- ▶ The GC is not bound by previous decisions

1. T-352/12.
2. T-228/13.



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Michael Wharton, a Trainee Solicitor at Bond Dickinson, co-authored this article.



# Fingers fight on

*Has the bar for establishing acquired distinctiveness moved up? Katie Goulding awaits the answer*

**THIS CASE CONCERNED** an appeal by Mondelez UK Holdings & Services Ltd, formerly Cadbury, against a decision of the EUIPO Board of Appeal (BoA) in which it was held that Société des Produits Nestlé SA had used its 3D mark, consisting of four fingers aligned together, in almost every EU Member State (15 at the time of filing), and that, as a result of that use, a significant proportion of the EU public perceived the mark as an indication of origin. This followed an assessment of evidence that included (but was not limited to) survey evidence showing consumer recognition in Austria, Denmark, Finland, France, Germany, Italy, the Netherlands, Spain, Sweden and the UK.

Among other pleas, Mondelez claimed that the BoA did not properly assess the territorial scope of proof of acquired distinctiveness: the evidence did not show use throughout the EU.

EUIPO guidelines<sup>1</sup> say that “despite the fact that acquired distinctiveness must be shown throughout the European Union, it would be unreasonable to require proof of acquired distinctiveness for each individual Member State”. The caveat to this is that it must be possible to extrapolate from the evidence certain broader conclusions for territories for which evidence is not submitted.

## HARDER LINE?

Some might say the GC has simply reinforced this caveat in saying that: “In the event that the evidence submitted does not cover part of the European Union, even a part which is not substantial or consists of only one Member State, it cannot be concluded that distinctive character has been acquired through use of the mark throughout the European Union.” Others might say that it has taken a harder line. The ambiguity is in “cover”. Is “cover” sufficient if the other jigsaw pieces make a full picture,

or does the evidence have to relate to actual use in each Member State?

The case is therefore being sent back to EUIPO to verify that the evidence adduced for countries for which no market surveys were submitted satisfies the requirement of acquired distinctiveness throughout the EU.

Coverage to date has not been favourable to Nestlé’s position. However, it is noted that, even with a low recognition rate of 30 per cent in Finland, the evidence, taken globally (including significant investment and long-standing use), enabled the GC to agree that the mark was perceived in Finland as an indication of origin. Of the country hurdles remaining, one would expect a favourable finding relating to evidence in at least Ireland (assuming the evidence is there).

## OPEN DOOR

We wait to see how this one plays out. The take-home for now is: try to address each Member State in evidence. Where evidence doesn’t exist, guide the Office by the hand and tell the story of why use in countries A to Y means the mark is perceived (probably) as an indication of origin in country Z. Do not expect the Office to draw broader conclusions on its own.

The functionality point has been put to bed. The door is ajar again (if it ever closed) for shape marks. Territorial proof aside, Nestlé came close to a surviving registration for sweets and biscuits (and still could). At least where I stand, those four fingers indeed make a biscuit!

## KEY POINTS

- ▶ Whereas, previously, evidence may have been submitted for key territories, brands should now aim to submit evidence for all Member States
- ▶ If there have been no sales or direct advertising in a certain Member State, collate press and social media references that might be extrapolated to reach a broader conclusion
- ▶ Do not allow identical or similar shapes on the marketplace to undermine your case. Enforce your rights; use the full spectrum of IP rights

1. Citing Chocoladefabriken Lindt & Sprüngli AG v OHIM, C-98/11 P.



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# Shape shift

*EUIPO was overturned on the issue of a simple pharmaceutical mark, reports David Yeomans*

**IN THIS JUDGMENT**, the General Court (GC) ruled that the figurative EU trade marks reproduced on this page were not devoid of distinctive character.

Novartis AG (the Applicant) had sought to register the marks for “pharmaceutical preparations” as EU trade marks in class 5. However, EUIPO rejected the applications on the basis that the marks were reminiscent of the shape of pharmaceutical preparations, and because, in any event, the marks were too simple to be distinctive. The Board of Appeal (BoA) dismissed the Applicant’s subsequent appeals, stating *inter alia* that the marks would be perceived as representing the outline of an oval-shaped pharmaceutical lozenge or pill viewed from above and from an angular perspective.

The BoA also stated that the marks did not contain any distinguishing elements that would enable the consumer to differentiate the pharmaceutical preparations bearing the sign from pharmaceutical preparations of other manufacturers, and that the marks did not depart significantly from the norms and customs of the sector. The Applicant appealed to the GC.

## SINGLE PLEA

The Applicant’s appeal relied on a single plea in law, namely infringement of Article 7(1)(b) of Council Regulation (EC) No 207/2009. The Applicant argued that the marks were abstract and ambiguous, and had a unique character that made them recognisable (and therefore distinctive) as a result of the concave impression produced by their shading. The Applicant also made the point that the signs did not form a full circle, and each was therefore much more likely

to be interpreted as a crescent (creating the abstract image of an eclipse), the letter “C”, or another elegant and/or unusual design. By contrast, EUIPO asserted that, once affixed to the packaging of the goods, the marks would be perceived as having the appearance of a pill, such that they could not be distinguished substantially from the basic shapes of the goods concerned.

## DISTINCTIVE AMBIGUITY

The GC found in favour of the Applicant, agreeing that it was very unlikely that the relevant public would distinguish the shape of a pill, even once the signs had been affixed to the packaging of such a product. The GC also dismissed EUIPO’s claim that the marks were too simplistic. While noting that the mere fact that the marks did not represent geometrical figures was not sufficient to support the view that the marks contained the minimum degree of distinctive character required for registration, the GC accepted the Applicant’s argument that the marks were distinctive by virtue of their ambiguity, and the fact that the shading and contrast created a play of light and shadow.

This judgment serves as a useful insight into the threshold of distinctiveness for purely figurative marks. It is also a reminder of the potential merits of an appeal to the GC.

## KEY POINTS

- ▶ The GC deemed that the marks would not be seen as representing the outline of a pill or lozenge, even once affixed to the packaging of the (pharmaceutical) products
- ▶ The BoA’s contention that the marks did not contain any distinguishing elements was deemed erroneous

- ▶ The Novartis marks



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# events

More details can be found at [citma.org.uk](http://citma.org.uk)

DATE	EVENT	LOCATION	CPD HOURS
21st March	<b>CITMA administrators' webinar</b>	Log in online	
23rd March	<b>CITMA lecture – Birmingham</b> Recent developments in design law and the impact Brexit may have	Browne Jacobson LLP, Birmingham	1
25th April	<b>CITMA lecture – London*</b> Parallel imports	Royal College of Surgeons, London WC2	1
9th May	<b>CITMA administrators' webinar</b>	Log in online	
16th May	<b>CITMA lecture – London*</b>	Royal College of Surgeons, London WC2	1
8th June	<b>CITMA lecture – Glasgow</b> Domain name update	Brodies LLP, Glasgow	1
14th June	<b>CITMA webinar</b>	Log in online	1
20th June	<b>CITMA lecture – London*</b>	Royal College of Surgeons, London WC2	1
27th June	<b>CITMA lecture – Bristol</b>	Burges Salmon LLP, Bristol	1
5th July	<b>CITMA CIPA commercial skills webinar</b> Professional ethics	Log in online	1
6th July	<b>CITMA administrators' webinar</b>	Log in online	
13th September	<b>CITMA webinar</b>	Log in online	1
15th November	<b>CITMA webinar</b>	Log in online	1
8th December	<b>CITMA Christmas lunch – London**</b>	London Hilton on Park Lane, London W1	

## SUGGESTIONS WELCOME

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

Brexit will be in the spotlight at our CITMA lecture in Birmingham on 23rd March. Register now at [citma.org.uk](http://citma.org.uk)

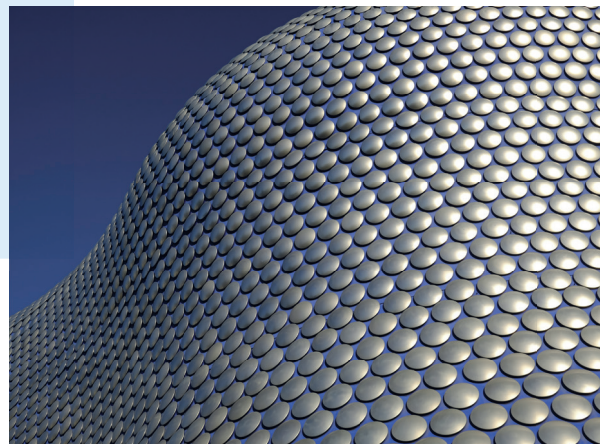
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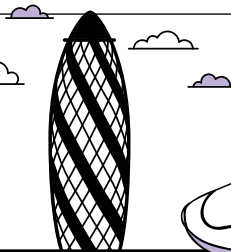
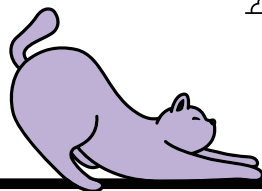
\*\* Pre-lunch drinks sponsored by

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## THE TRADE MARK 20

# Q&A



**I work as...** a trainee Trade Mark Attorney at Barker Brettell LLP.

**Before this role, I was...** a trainee Trade Mark Attorney at another firm, and, before that, an avid English student.

**My current state of mind is...** happy. I feel very fortunate to have a job I love and to be able to live with my partner after a period of being separated by a large distance. All that is missing from my life now is two kittens.

**I became interested in IP when...** I was finishing my degree in English. I loved the subject, but decided that I did not want to study for a PhD or stay in academia, and I was reluctant to go down the solicitor route. I was broadly aware of IP and came across a vacancy for a trainee Trade Mark Attorney role that piqued my interest. It occurred to me that trade marks are a commercial embodiment of the linguistic play that I love, and that the role would afford me the opportunity to conduct in-depth analysis on a daily basis and use my writing skills. I applied for the job, got it and never looked back.

**I am most inspired by...** my parents. They have always been incredibly hard working, encouraged me to aim high and respected my work ethic – without pressuring me. They have also always emphasised how important it is to be happy as well as successful. I owe them a lot.

**In my role, I most enjoy...** working with a variety of clients, big and small. I love problem solving, and a key part of that is knowing how to tailor your advice to each individual client so that they come away happy.

**In my role, I most dislike...** billing. But it is a necessary evil.

**On my desk is...** a bunch of flowers from my partner, Marc Jacobs Daisy perfume, a framed photograph from the 2015 IP Ball and many snacks.

**My favourite mug says...** “You can take the girl out of Bristol, but you can’t take Bristol out of the girl!”

**My favourite place to visit on business is...** currently London. I’m hoping to travel to some more exotic places in the future, but I need to earn my stripes first.

**If I were a trade mark or brand, I would be...** Nike. I think I am a “Just Do It” kind of person – I always crack on with the job at hand. I wish I could say Chanel on account of elegance and style, but I don’t think that is the case!

**The biggest challenge for IP is...** Brexit. There is a lot of anxiety about the future, and an important part of our role right now is to reassure clients that we will find a way forward while safeguarding their rights.

**The talent I wish I had is...** the ability to play the guitar. It’s a work in progress, but I would like to be able to start doing open mic nights again. I love to sing – I just need some backing!

**I can’t live without...** music. It both peps me up and keeps me sane.

**My ideal day would include...** lazily waking up to sunshine and a cup of tea in bed; a stroll through Leamington Spa with my partner, ending with a bit of shopping and a tasty lunch; then meeting up with friends for cocktails.



For Student member  
Becky Knott, all that  
is missing is kittens

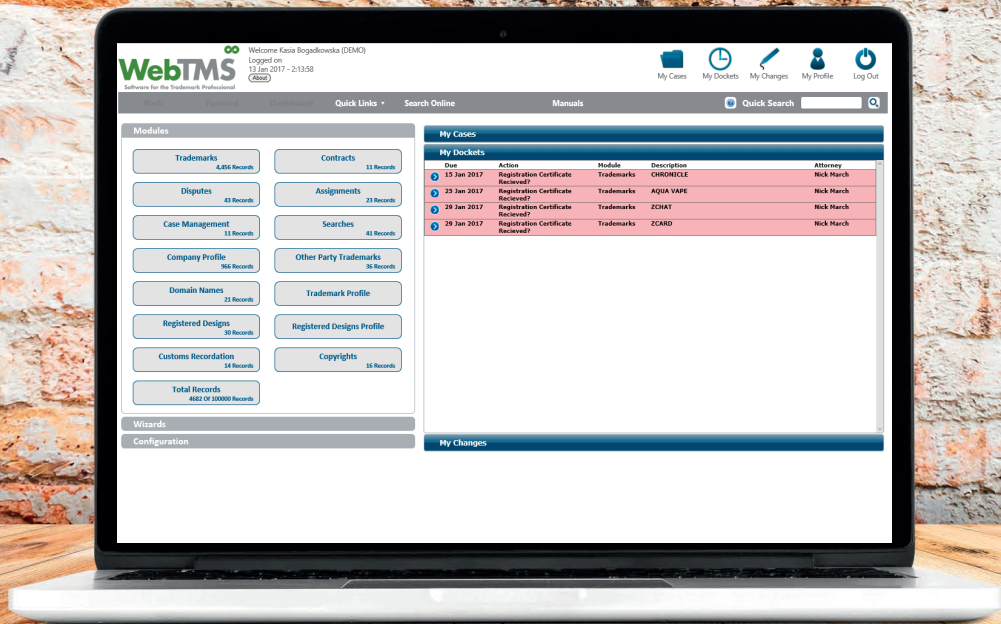
**In my pocket is...** my iPhone. I’m constantly on Twitter trying to keep up to date with developments in IP.

**The best piece of advice I’ve been given is...** to adopt a “hermeneutics of suspicion” – in other words, to check and double-check everything, even if you’re certain you’ve got it right.

**When I want to relax, I...** escape into a good book. Alternatively, I find a cat to cuddle.

**In the next five years, I hope to...** qualify, take responsibility for my own clients and become fluent in Spanish.

**The best thing about being a member of CITMA is...** the people. It is very exciting to share such a fascinating common interest with such a wide range of wonderful individuals.



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# The IP Canvas in India is Changing Rapidly!



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