

# **The Art of Persuasion: written and oral advocacy before the Trade Mark Registry**

Michael Edenborough KC  
CTMA lecture, HGF, Manchester  
11<sup>th</sup> March 2025



serle court



# context

- ❑ adversarial vs inquisitorial proceedings
  - ❑ need a plan of action – “*Tactics without strategy is the noise before defeat.*”
- ❑ matters are now far more formal than historically the case
  - ❑ substantive and interim hearings common
  - ❑ more complex matters – often non-TM issues arise
  - ❑ multiple interlocking matters
  - ❑ developed procedural case law on all aspects: pleadings, evidence, &c
  - ❑ appeals are reviews, and much stricter about new facts / issues



# “trinity of trinity” approach

- ❑ law
  - ❑ black, grey and white
- ❑ evidence
  - ❑ documentary, live, physical (judicial notice)
- ❑ procedure
  - ❑ pleadings, interim issues, substantive hearings

procedure dovetails the evidence into the legal framework

- like a three-legged stool, need all three legs -



# the art of persuasion

- ❑ pleadings and oracy
- ❑ common requirements
  - ❑ note evidence / submissions demarcation – do not muddle
  - ❑ preparation – analysis
    - ❑ what (content), why (justification: “*because*”) and how (format)
  - ❑ clarity – define, delineate and differentiate the matters in issue
    - ❑ precision, essentialness, completeness
  - ❑ elan – impression / memorability
    - ❑ fitting, fair, flair



# pleadings I

- ☐ Statement of Grounds - allegations
  - ☐ tell a story: beginning, middle and end
    - ☐ who we are, why we are here, and what we want
  - ☐ do not overreach – undermines credibility
  
- ☐ Counter-statement - contentions
  - ☐ admit – use more often
  - ☐ not admit – use less often
  - ☐ deny – use only if also advancing respondent's story



# pleadings II

- ❑ facts not beliefs (unless knowledge is required)
- ❑ technical terms, grammar
  - ❑ use correctly – “hanged (not hung) on a comma”
- ❑ ambiguity (avoid, unless wish to be covertly opaque)
- ❑ presentation: headings, definitions, spacings  $\equiv$  pauses



# oracy I

- ☐ fully scripted speech
  - ☐ difficult to bring to life
  - ☐ hinders interaction
- ☐ speaking notes
  - ☐ modular, fully cross-referenced
  - ☐ aids interaction with the tribunal – answer their Qs
- ☐ presentation
  - ☐ modulation of voice / pace
  - ☐ power of silence



# oracy II

## ☐ styles

- ☐ Wise Owl – logic / dry
- ☐ Commanding Eagle – authority / intolerant
- ☐ Friendly Budgie – empathy / compliant
- ☐ Captivating Peacock – passion / superficial
- ☐ [Crows, Ostriches, Cuckoos]





# appeals

- ❑ identify the error of law or principle
  - ❑ multifactorial assessments very difficult to challenge
  - ❑ exercise of discretion almost impossible to challenge
- ❑ show how the correct application leads to a favourable result
  - ❑ otherwise, pointless to intervene
- ❑ appellate tribunals / courts more interactive and focused
  - ❑ not interested in the first instance squabbles, unless material
  - ❑ helps to have merits, rather than mere technical points



# difficult cases

- ❑ important how you conduct a difficult case
  - ❑ duty to court not to mislead, and to enforce solid reasoning
  - ❑ duty to client to present best case
  - ❑ one's reputation before the tribunal, &c
- ❑ clearly distinguish adverse cases on law and /or facts
- ❑ otherwise, must argue law / evidence is wrong
- ❑ learn from one's own and the other side's good / bad points

# IP juniors at Serle Court



Thomas Elias (2008)



Adrian de Froment (2013)



Stephanie Wickenden (2014)



John Eldridge (2019)



Niamh Herrett (2021)



Stefano Braschi (2021)



Anneliese Mondschein (2021)



Ryan Tang (2022)



# Michael Edenborough KC

## ☐ contact details:

- ☐ Serle Court, 6 New Square, Lincoln's Inn, WC2A 3QS, UK
- ☐ (t) + 44 (0)20 7242 6105
- ☐ (e) MEdenborough@SerleCourt.co.uk

## ☐ all areas of intellectual property law and practice, in particular: trade marks / geographical indications and passing-off; copyright / moral rights and designs; and, patents and confidential information

## ☐ author of *Contentious Trade Mark Registry Proceedings* (2<sup>nd</sup> edition, along with Thomas Elias, Adrian de Froment and Stephanie Wickenden as contributors, and Niamh Herrett as index compiler – about 330,000 words resulting in lvii + 696 pages, October 2023, published by CITMA)