

CITMA REVIEW

ISSUE 452 SEPTEMBER 2019

Growth pattern

*Catch up with America's
booming cannabis market*



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The one for your one in a million brand

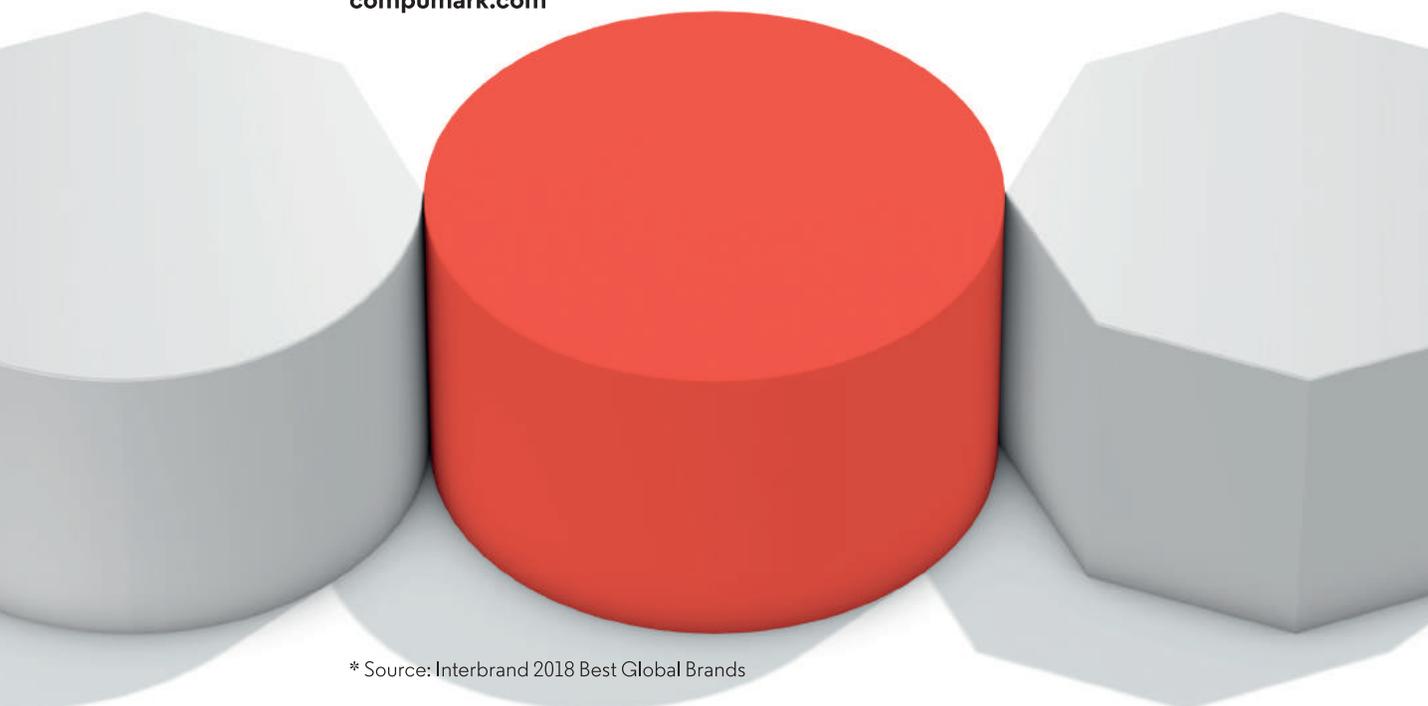
Great brands are one in a million.

That's why 9 out of 10 of the world's most valuable brands* rely on CompuMark to help secure and protect their trademarks.

We combine quality content and industry-leading trademark expertise with next-generation technology to deliver insight you can trust to make critical brand decisions.

That's CompuMark confident.

compumark.com



* Source: Interbrand 2018 Best Global Brands

WELCOME & CONTENTS



Tania Clark
CITMA President

“
See if you can spot yourself in the photos on page 6”

What you earn is an important reflection of your professional contribution to your employer, so you may be interested in the salary survey featured on page 10, which discusses recent trends in remuneration. Feel free to use this survey at your next appraisal.

Despite our outsourcing of the trade mark qualification examinations to various universities, we continue to monitor the level of service being provided via the Education Policy and Development working group. Aaron Wood, Chair of EPAD, reviews its workings on page 8.

We all enjoyed a balmy evening for our Summer Reception in July: see if you can spot yourself in the photos on page 6. Our next major events are the Autumn Conference in Birmingham on 17th October and the London Christmas Lunch on 13th December; both were sell-outs last year so do book soon.

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IN MEMORIAM: David Tatham OBE

It is with great sadness that we must report the passing of David Tatham OBE, who died suddenly on 4th July following complications after cardiac surgery.

David spent all of his professional career working in the pharmaceutical and chemical industry. He qualified as a Trade Mark Attorney in 1961 and was also a qualified company secretary. He retired from the then Imperial Chemical Industries (ICI) in 1994, where he was head of its trade marks department.

David always took a wide view of issues and aimed to (and did) shape the development of trade mark policy. The list of positions he occupied reflects this ambition:

- President of the European Communities Trade Mark Association (ECTA)
- Member of the Council of the then Institute of Trade Mark Attorneys (ITMA)
- Chair of CITMA's Law & Practice Committee
- A founding trustee of the CITMA Benevolent Fund
- President of the Trade Marks Patents and Designs Federation (TMPDF)
- Director of INTA
- Chairman of the trade marks working group of the Union of Industrial and Employer Confederations of Europe (UNICE)
- Chairman of the trade marks working group of the Confederation of British Industry (CBI)
- Secretary to the Pharmaceutical Trade Marks Group (PTMG) – a group that he helped to found.



He was an effective operator and made a difference in each of these posts. His encyclopaedic knowledge of trade mark law and practice, both national and international, along with his commercial approach to the value of intellectual property, ensured that was the case.

When the incoming Conservative Government in 1992 was reluctant to make the parliamentary time for the Trade Marks Bill – the Secretary of State said that when canvassing on the doorstep, no voter had mentioned the revision of trade mark law as a priority – it was to David Tatham that civil servants turned for estimates of the additional

costs to UK industry and commerce who could not register trade marks for services or, very importantly, register their trade marks multilaterally through the Madrid Protocol. He delivered a set of figures, which helped to persuade ministers to legislate, resulting in the 1994 Act.

David was always willing to share his knowledge, skills and expertise. His interpersonal skills meant that he was approachable and welcoming. Following his retirement, he became an arbitrator for WIPO in domain name disputes, and he also undertook consultancy work for WIPO promoting the use of IP and related systems in developing countries.

In 1994, he was awarded the Order of the British Empire by the Queen for services to industry. He was also a Justice of the Peace.

We offer our heartfelt condolences to David's wife and family.

IP MINISTER MEETING

CITMA First Vice-President Richard Goddard was one of a group of IP sector representatives that met with the then IP Minister Chris Skidmore recently. The group discussed a range of subjects, including the importance of incorporating IP into trade agreements and into the curriculum at secondary and university level. We look forward to engaging with the new minister with responsibility for IP.

Mr Justice Henry Carr

We join the entire IP community in mourning the passing of Sir Henry Carr, IP Judge and member of 11 South Square Chambers.



CASE RESEARCH: LOOK NO FURTHER

The CITMA website includes a full, searchable database of all case comments covered in the *CITMA Review* at citma.org.uk/case-comments. Do make use of this useful reference.

BREWSTER TAKES THE LEAD AT IP INCLUSIVE



Andrea Brewster speaking at the launch of Careers in Ideas

IP Inclusive has appointed Andrea Brewster OBE as its first Lead Executive Officer to manage the development of the diversity and inclusion initiative.

Andrea will lead IP Inclusive's day-to-day activities, including co-ordinating and supporting the work of its volunteers. In addition, she will explore opportunities for future development, including potential new structures and funding mechanisms.

IP Inclusive Management (IPIM), the governing body that oversees IP Inclusive, has made the appointment for an initial 12-month period on a paid consultancy basis. This new role is designed to facilitate and support IP Inclusive's growth, while safeguarding the goodwill and confidence of its stakeholders.

A collective initiative from across the IP profession, IP Inclusive was launched in 2015. It encourages diversity and inclusion within the profession.

Chair of IPIM and CITMA First Vice-President Richard Goddard said: "The creation of the Lead Executive Officer role will ensure that IP Inclusive has the leadership and support it needs to build on the great work of the past few years.

"Andrea is the natural choice for the position, and I'm very pleased that she has agreed to take it on. I'm confident that IP Inclusive will continue to go from strength to strength under her leadership."

Tim Moss CBE, Chief Executive and Comptroller General of the Intellectual Property Office (IPO), said: "The IPO is delighted that Andrea will lead IP Inclusive into the next phase of action and growth. We will continue to engage with the IP Inclusive community to build and benefit from inclusion, and we have every confidence that the initiative will go from strength to strength."

Lewis Silkin acquires Ablett & Stebbing

Lewis Silkin LLP has acquired patent and trade mark attorney firm Ablett & Stebbing, bolstering its brands and IP practice.

Ablett & Stebbing, founded in 1993, specialises in technology, engineering, life sciences and chemistry. The deal is believed to be one of the first of its

kind to involve a law firm acquiring an entire patent practice. The deal takes the number of partners in Lewis Silkin's brands and IP team to 16.

CITMA'S AUTUMN CONFERENCE IS A CAN'T-MISS EVENT

Our 2019 Autumn Conference at the ICC in Birmingham promises to offer another great day of CPD sessions and networking opportunities. An exciting range of speakers will help you gain valuable knowledge, while our breakout areas are the perfect venue to network with IP professionals from across the UK's key business regions.

Among the speakers you can expect are: Michael Edenborough of Serle Court, Ian Bartlett of Beck Greener, Oliver Morris from the UK IPO, Gordon Humphreys of EUIPO and Sarah Coomber from Caterpillar UK.

Go to citma.org.uk for full details and to book now.



Right: CITMA President Tania Clark and CIPA President Julia Florence



AN EVENING IN EC4

Some 170 CITMA members came together at our annual summer networking event in central London





All levels of the IP profession mingled with friends, old and new, over drinks and canapés



SEE A FULL PICTURE GALLERY
AT bit.ly/33o7Gci

Manchester meet-up

CITMA President Tania Clark joined a spirited gathering at The Oast House in Manchester, which welcomed members located in the North West.



IMAGES COURTESY OF JORANDI DANEEL, APPELYARD LEES

INSIDE

Aaron Wood reveals the intention behind the initials

Trade mark professionals will be used to acronyms, and EPAD is yet another one to add to our vocabulary. But what is it?

EPAD stands for the Education Policy and Development Committee of CITMA. It seeks to advance CITMA's strategic priorities in relation to education. Clearly, this is a critical role for many in the profession, from Chartered Trade Mark Attorneys (particularly those involved in training or that are newly qualified) to experienced and aspiring CITMA Paralegals.

The committee helps to develop and oversee the education programme for members, while also engaging with relevant organisations such as IPReg, Queen Mary University of London, Bournemouth University and Nottingham Trent University. It seeks to ensure that the courses provided maintain the standards expected by CITMA, IPReg, the profession and the public. The committee will also prepare formal responses to relevant consultations by IPReg and other pertinent bodies.

A full list of its members can be found on the CITMA website in the governance section, including the members of its various working groups that carry out important work in relation to:

- Competency frameworks and accreditation standards
- Education liaison
- Education strategy
- CITMA's Paralegal Course

CORE COMPETENCIES

The role of the Competency Frameworks group is to establish and promote an advanced competency framework for Chartered Trade

Mark Attorneys and to maintain close and regular dialogue with IPReg on the development of the Trade Marks Competency Framework and the Accreditation Standards for Qualifying Examinations and Agencies.

The key areas that the group is currently working on are: IP prosecution and validity skills; IP litigation and enforcement skills; commercial legal skills; and practice management skills. The group is led by this author with support from the committee and working group members.

LIAISONS DANGEREUSES?

The role of the Education Liaison working group is to maintain close and regular dialogue with CITMA members, undertake qualitative research projects regarding education and seek constructive

“ The best way to ensure that CITMA reflects the needs of the profession is the involvement of a diverse range of voices

feedback on the performance of the Examinations Agencies. The group is led by Carrie Bradley, who has done tremendous work in organising a recent survey that went out to last year's students who took the courses at Queen Mary London, Bournemouth University and Nottingham Trent University.

The responses to the survey are invaluable to the working group and the wider EPAD committee, and we're very grateful to those who took the time to respond.

The responses are being digested and will enable an informed approach to our work with the course providers going forward. The working group will be looking to continue receiving similar feedback in the future and will ensure that the concerns – as well as the plaudits – raised by students will inform the ongoing delivery of the courses.

The working group also maintains close and regular dialogue with IPReg and the Examination Agencies on issues identified by our members.

STRATEGIC THINKING

The Education Strategy working group explores future education initiatives and develops relevant proposals including alternative routes into the profession, career pathways, apprenticeships, opportunities for alternative

examination agencies, greater competition, the development of CITMA-accredited professional skills courses by external providers and CITMA-accredited internship and returnship programmes. The group is led by Angharad Rolfe Johnson with support from the committee and working group members.

PREPARING NEW PARALEGALS

The CITMA Paralegal group is tasked with successfully delivering the CITMA Paralegal Course. While this

EPAD



MANY THANKS TO MARK

Council member and EPAD Committee chair Mark Bearfoot moved from Harley Davidson to Tommy Hilfiger to become Legal Director for Brand Protection in the summer of 2018. This also included a move to Amsterdam. Unfortunately, the new role and the relocation have led Mark to take the difficult decision to stand down as EPAD committee chair. During his tenure, Mark achieved a great deal and has advanced CITMA significantly in this key area. The EPAD committee members would like to thank Mark for all his hard work, energy and leadership.

Obviously involves presenting to the students and preparing quality handouts, it is imperative that the course's syllabus is continually monitored to check relevancy with trade mark law and practice, while also ensuring formalities are up-to-date and liaising with other CITMA stakeholders as necessary.

The working group also sets and marks the exam for this course.

It has recently been decided that 2019's course will move more towards following the academic calendar and will begin in September. The course thrives on the feedback provided by past students in its efforts for continuous improvement.

GET INVOLVED

As chair of the EPAD group, my role is to make sure that the committee delivers on its projects and to ensure that the overall direction of the group fits with the strategic drivers of CITMA and the overall desires of its members. As an attorney who works outside London, I am aware of the feeling among some firms and members that there is limited opportunity to have an input into CITMA activities and to play a part in the direction of the profession. This is a fallacy.

The CITMA committees and working groups rely on volunteer

involvement from CITMA members. This ensures that the members are at the heart of what CITMA does and allows it to perform more efficiently.

For my part, there are three particular points that led me to take the position as chair:

1. The desire to ensure that diversity and inclusion continues to influence the committees and the direction of CITMA;
2. The desire to ensure that the educational programme (including, but not limited to, the examinations) fulfil the needs of the profession and the public; and
3. To ensure that members of the profession at all levels have a pathway to continued growth and achievement, which reflects the special position of the profession in the legal landscape.

If you are interested in volunteering, please contact CITMA. The best way to ensure that CITMA reflects the needs and interests of the profession is the involvement of a diverse range of voices in its committees.

In a changing legal landscape, there is an opportunity for members of CITMA at all levels to flourish and to have a career that is fulfilling. Our role is to support this activity for the improvement of the profession as a whole.



Aaron Wood

is the founder of Wood IP
aaron@wood-ip.com

With thanks to co-authors Ese Akpogheneta (BAT) and Dan Smart (Colman+Smart)

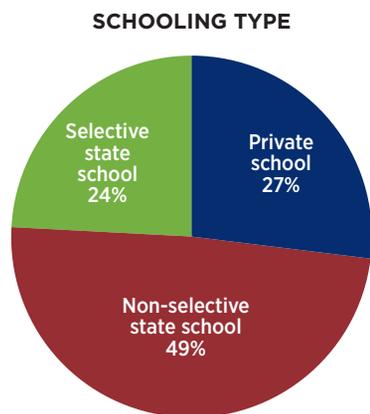
Degrees of success

This year's IP sector salary survey by Fellows and Associates adds information on educational attainment

EDUCATIONAL ATTAINMENT ANALYSIS

The secondary stage

Nearly half of the respondents reported attending a non-selective state school at the secondary stage, almost twice the number of those educated privately.

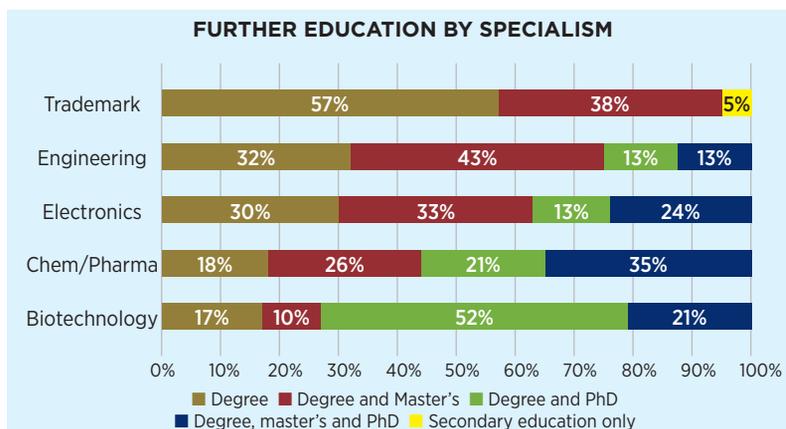


Success stories in FE

Overall, 38 per cent of respondents had pursued education to PhD level. A third held just a degree, and 0.5 per cent were managing a successful career without any further education.

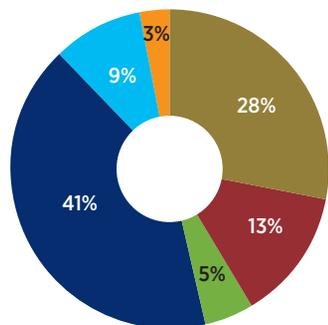
University choices

Although nearly 20 per cent of respondents had studied for their degree at Oxbridge, a total of 72 different universities were attended across the board at degree level.



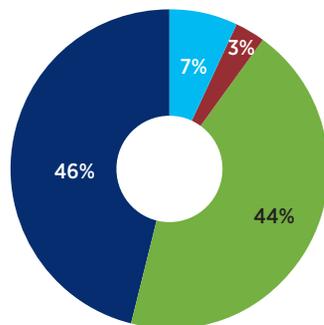
QUALIFICATIONS IN DETAIL

NUMBER OF QUALIFICATIONS



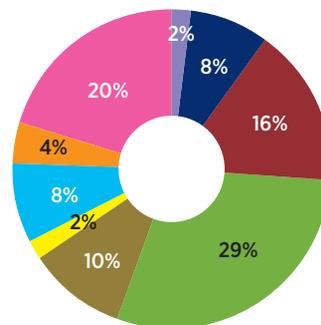
■ Working towards first qualification ■ One qualification ■ Two qualifications ■ Dual qualified ■ Dual qualified plus another qualification ■ Three or more qualifications

TIME ALLOWED FOR STUDY



■ No time off ■ Time allowed to attend in-house training academy ■ Time off to attend specific courses external to the firm ■ Time off to study at home

SALARY INCREASE PER EXAM



■ £1k lump sum per exam ■ £2k lump sum per exam ■ 1%-5% increase ■ 6%-10% increase ■ 11%-15% increase ■ 16%-20% increase ■ 21%-25% increase ■ 26%-30% increase ■ Prefer not to answer

Interestingly, 98 per cent of respondents reported that between 76 and 100 per cent of their exams were funded by their employer, with the remaining two per cent receiving between half and three quarters of their funding.

SALARY SPECIFICS

A new study introduced this year revealed that 62 per cent of respondents were broadly happy

with their current salary; three per cent would actually be happy to work for less. At the other end of the

spectrum, five per cent believe they are undervalued and want an increase of 30 per cent or more.

AVERAGE BASE SALARY BY CATEGORY



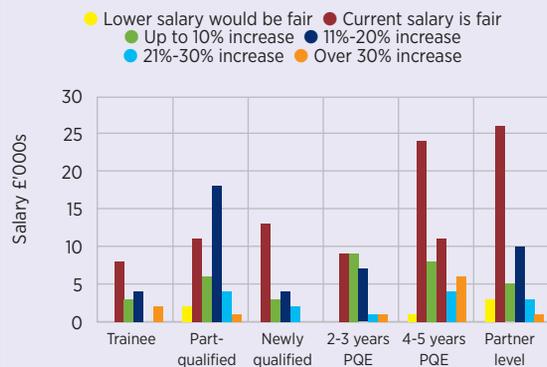
AVERAGE SALARY BY GENDER



UK BASE SALARY RANGE BY CATEGORY

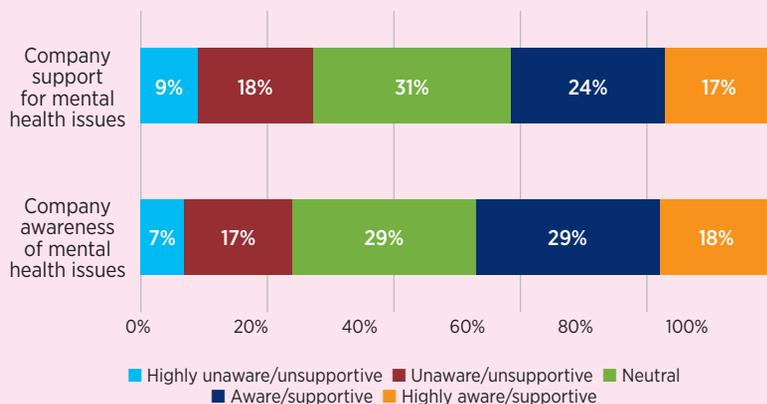


ADEQUACY OF BASE SALARY



SPOTLIGHT: MENTAL HEALTH IN THE WORKPLACE

In recognition of the importance of mental health in the workplace, the report researched company attitudes. The results indicate there is still work to do in creating workplaces that are responsive on this subject.



SURVEY AUTHOR: MICHELE FELLOWS. DATA COLLECTED BETWEEN 1ST MAY 2019 AND 9TH JUNE 2019. NUMBER OF PARTICIPANTS: 210. VIEW THE FULL RESULTS AT FELLOWSANDASSOCIATES.COM

GOING GREY

(IS IT EVER OK?)

Gavin Hyde-Blake delves into the ethical questions involved in IP investigations

How many times have you seen a film or TV programme, or read a book, in which a private investigator breaks the law in order to get the information they need? How many times have you seen them take legal steps you think are not acceptable? Sherlock Holmes did (and still does); Philip Marlowe certainly did; and JK Rowling's latest creation, Cormoran Strike, does – regularly! But what about the real investigators – particularly those involved in your IP investigations? Do you know what they do in the course of an investigation and if they will act in an ethical manner on your behalf?

To be clear, investigators must obey the law – they have no special powers or permissions

to act differently to anyone else. But what of the grey area; acts that are not specifically forbidden yet can be seen as unethical or bad practice? For instance, should an investigator say they work at the UK IPO or Companies House? While not specifically illegal, these examples are clearly unethical.

THE ISSUE WITH ETHICS

Problematically, there is no agreed definition of ethics, so defining an ethical standpoint you would want an investigator to take is a near-impossible task. We all know ethics concern the moral behaviour of individuals towards concepts of “right” and “wrong”. However, rather like beauty, ethics are in the eye of the beholder. Aside from straightforward matters of law, the only other guidelines

“ A good approach is like a perfect dive: it should be graceful, elegant, over quickly and not leave a ripple behind

employed by *The News of the World* to hack into the mobile phones of celebrities. Meanwhile, the names of Andy Coulson and Rebekah Brooks will forever be linked to his unethical and illegal actions, and that activity spelled the end of *The News of the World* after 168 years. The lessons are there to be learned for those using – or allowing someone else to use – a rogue operator.

ETHICS AND THE INVESTIGATIVE PROCESS

There are four main areas of investigation in which ethical questions often arise. The first is in online searches. We're not talking about illegal activity such as hacking, but people are putting a large proportion of their private lives onto online social media platforms. In an IP investigation, most of the related work involves looking at corporate entities, but when it comes to smaller companies and sole traders, the person is the company. So, how far should the investigator delve into personal social media to find evidence of infringement, for example?

There are a couple of points to clarify here, which I think all good IP investigators would follow. First, if the information can be located elsewhere (a directory or corporate listing, for example), then that source should be consulted first. Second, although people have voluntarily placed the social media information onto a public forum, I feel that any steps taken into social media have to be necessary and proportionate – and doubly so when it comes to reporting what is found. Only information that is pertinent to the matter in hand should be searched for, and only that information should be reported. If it can be left out, it should be.

PRETEXT APPROACHES

We've already touched briefly on using an assumed identity in the course of an investigation, and let's deal now with two uncomfortable facts: that investigators sometimes use false names, and that we

investigators have are a moral compass and common sense. But common sense is not always common, and moral compasses can point in the wrong direction.

So, if an investigator obeys the law, can everything else be considered acceptable behaviour? Well, not quite. The German academics Eberhard Schnebel and Margo A. Bienert consider that ethics is “a prerequisite to conduct business”¹, and that goes for investigators as much as anyone else. More so, in fact, than it does for many industries, because an investigator's malfeasance affects not just the investigator, but potentially also the person who has hired them and that person's end-client. For example, the name Glenn Mulcaire may have been largely forgotten, but he was the phone hacker

¹ Eberhard Schnebel and Margo A. Bienert, 'Implementing Ethics in Business Organizations,' *Journal of Business Ethics*, 53:2 (August 2004), pp203-211.

VIEWS FROM THE PROFESSION

THE AUTHOR SPOKE TO A SELECTION OF INVESTIGATORS TO GET THEIR THOUGHTS ON THE SUBJECT OF ETHICS:

Graham Robinson, Managing Director of Bishop IP Investigations:

"We know that our clients are concerned about the ethics and legality of our work and that they are comforted by the fact that we have lawyers within the business who effectively act as compliance officers. If there is any question about something we might do, it is discussed both internally and with our clients."

Nicola Amsel, Partner at Amsel & Co.: *"I am a Fellow and former Principal of the Institute of Professional Investigators and abide by its long-standing Code of Ethics."*

Duncan Mee, Director at Cerberus IP: *"Ethical corporate investigation methods are the cornerstone of the business. If they weren't, we would have no clients!"*

sometimes lie to people about why we are talking to them. The reasons for this are obvious. Any in-depth investigation involving a prearranged business meeting or similar will inevitably lead to someone searching the web for your name to see who they are meeting and where they are from, so a pseudonym has to be employed. But it's also important not to pretend to be from an actual organisation or company, and never pretend to be a real person (impersonation).

Lying to a subject about why we are calling – what is called "using a pretext approach" – is another obvious tactic. We can't phone to say we are an investigator, but where are the limits? When training novice investigators, I try to explain that a good approach is like a perfect dive: it should be graceful, elegant, over quickly and not leave a ripple behind. Avoiding lying is normally the easiest option, particularly for in-use investigations or purchases of domains or trade marks (ie "I'm trying to find out about Brand X – are you still producing it?" or "Hi, I'd like to buy domain-name.com from you: are you amenable to selling it?"). When more elaborate stories are needed, they should not make false promises, or involve talk of large-scale business that may result in a subject spending time or money building up a supply chain or getting new product designs together, for example.

VISUAL EVIDENCE

Rather like social media searches, when it comes to photographs or video, the rule of thumb is to be necessary and proportionate. In an IP investigation, most relevant photographs or video should be of goods and marks, with film of people used only if they are discussing the matter under investigation. Any information obtained that is not pertinent to the subject being investigated should not be reported.

INVESTIGATOR VETTING

I have been saying for the past 20 years that the best investigator for you is the one you can trust. This is as true today as it was when I first said it – more so, possibly, given the amount of personal information that floods onto the internet each day. So how do you achieve a level of trust in your investigator – to understand just what they do and how they do it?

Talk to them. Ask your investigator how they will approach a problem you have. We investigators may offer a smoke-and-mirrors front so that people don't understand the steps we take, but if you want to know exactly what pretext approach your investigator intends to use for a job, ask them to discuss it with you first. If you are unsure of the approach, ask them to change it until you are happy with it.

1. Ask to see their code of ethics (which may or may not be on their website).
2. Send an engagement letter to your investigator stating that all work needs to be within the law and ethical at all times – get them to sign something that says they agree to this.

We IP investigators are just like you in many ways. We have a strong sense of right and wrong and know where the lines are drawn. Ultimately, I believe that no investigator wants to risk their livelihood and reputation by straying into grey areas that cause embarrassment for us, or you or your clients.



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IP

In-House Trade Mark Paralegal - London

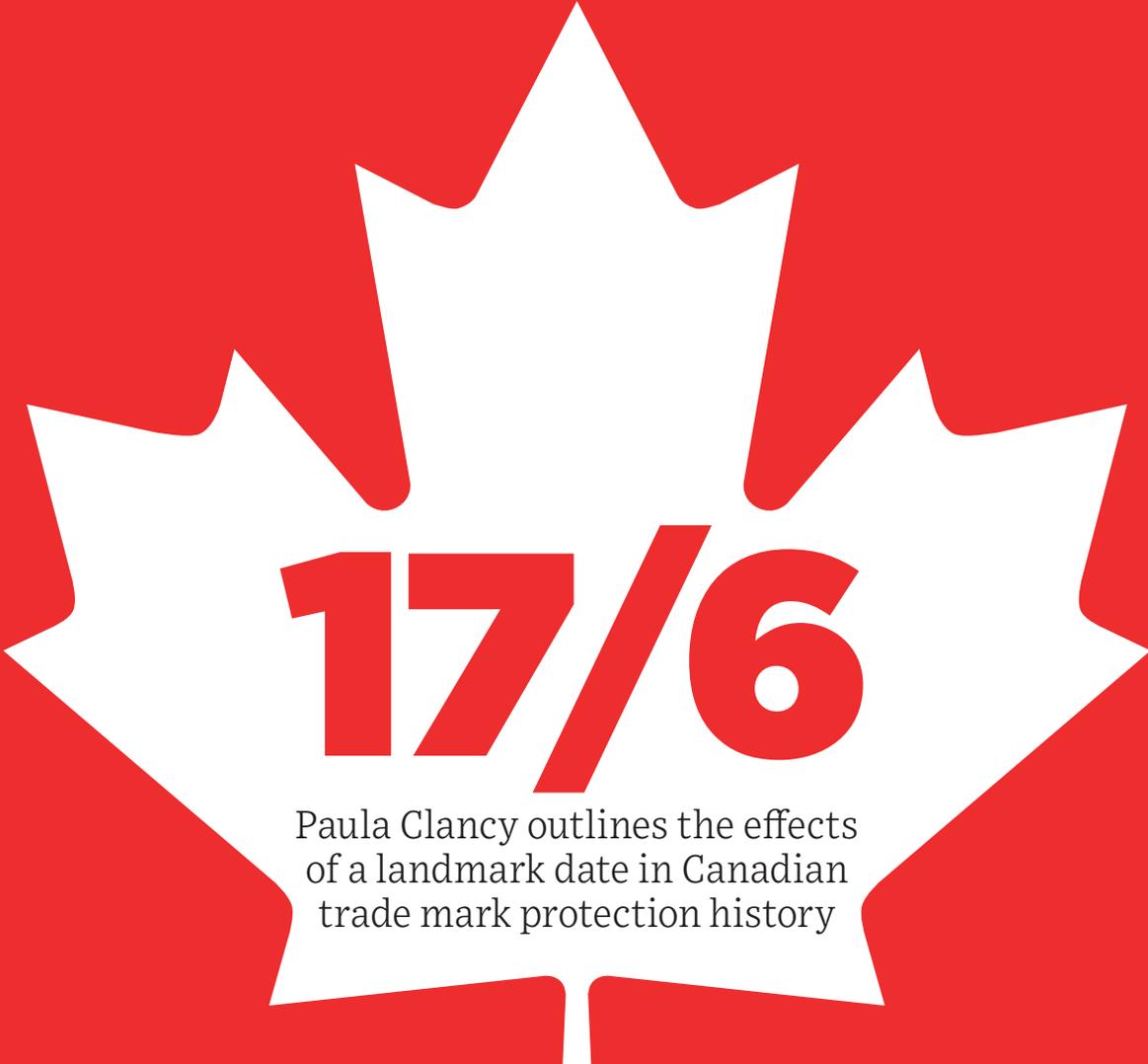
A new position working for a globally recognised house of brands. The role would suit a CITMA Qualified TM Paralegal with a minimum of 2 years' experience.

Senior Trade Mark Paralegal - London

A fantastic opportunity for a TM Paralegal looking to progress their career. The position is with a high-end law firm based in a sought-after location.

Trade Mark Paralegal - London

A 6 month contract with a leading attorney firm. The ideal candidate will have a minimum of 3 years' experience and be used to operating at a higher level.



17/6

Paula Clancy outlines the effects of a landmark date in Canadian trade mark protection history

 On 17th June 2019, Canada acceded to the Singapore Treaty, the Nice Agreement and the Madrid Protocol, simultaneously implementing the most significant changes to the Canadian Trademarks Act in several decades. The new trade mark regime makes it easier and less expensive for Canadian businesses to protect their trade marks internationally and for international companies to secure trade mark protection in Canada. Here are some of the key legislative changes that came into force on that “T-day” and how they affect UK brand owners:

1. ELIMINATION OF BASES FOR REGISTRATION

Trade mark applicants no longer need to claim a filing basis (ie prior use, an intention to use, foreign use and registration) to register a mark in Canada. While this change simplifies the application filing process for

Canadian and foreign applicants, it complicates the pre-clearance and enforcement of marks since the Canadian Trademarks Register will no longer capture use information. As a result, UK brand owners can expect increased investigation costs to determine the priority of intellectual property rights in Canada.

2. ELIMINATION OF REQUIREMENT TO FILE DECLARATION OF USE

A declaration of use is no longer a prerequisite for registration: applications may now issue to registration regardless of whether there has been use of the mark in Canada. This applies to applications filed before and after 17th June. This means that applications will be able to mature to registration much faster. Concerns have been raised that this will lead to an increase in overly broad applications or facilitate trade mark squatting. UK brand owners will need to consider instituting Canadian watch services for key brands to guard against

trade mark trolls who may now more easily obtain trade mark registrations in Canada.

3. CLASSIFICATION OF GOODS AND SERVICES

Goods and services must now be grouped in accordance with the Nice classifications, and applications that were not advertised prior to 17th June will need to be classified. Similarly, existing registrations will need to be classified at the time of renewal. The Canadian Intellectual Property Office (CIPO) may send a classification request at any time, in which case registrants will have a six-month period within which to comply, failing which the registration may be expunged.

As such, UK brand owners should review their Canadian trade mark portfolios and be prepared to provide Nice classification information for all of their pending applications as well as their existing registrations.

Despite the adoption of the Nice classifications, the amended

Trademarks Act still requires a statement “of the specific goods or services in association with which the trademark has been or is proposed to be used”. As CIPO is known to require quite detailed descriptions of goods and services, UK brand owners should ensure that they include sufficient detail to avoid triggering an Office action.

4. INTRODUCTION OF PER-CLASS FEES

A per-class fee structure for applications and renewals has been introduced, to apply only to trade mark applications filed after 17th June. Canada is a bit of an anomaly in that filing fees are calculated based on the goods and services claimed in the application at the date of filing. In other words, unlike other jurisdictions where an applicant may pay a single class fee and later decide which classes to maintain, Canadian filing fees are calculated based on what was included in the application at the time of filing, regardless of whether those goods or services are subsequently removed. Therefore, UK brand owners should be aware that additional filing fees may be required depending on the number of classes that CIPO identifies, regardless of whether or not the applicant is interested in maintaining those classes.

5. CHANGES TO PRIORITY CLAIMS

UK applicants seeking to claim a priority filing date may now rely on any application filed in the preceding six months. Under the previous legislation, applicants could only rely on applications filed in their “country of origin”.

6. REGISTRATION/RENEWAL PERIOD REDUCED TO 10 YEARS

The registration and renewal periods have been reduced from 15 years to 10 years. CIPO has also eliminated the registration fee for applications filed after 17th June, so marks will automatically proceed to registration once the opposition period has expired. Proof of use of the mark is not required at the time of renewal and partial renewals are now permitted.

7. OBJECTION ON THE BASIS OF LACK OF INHERENT DISTINCTIVENESS

CIPO is now able to object to the registration of a mark on the basis that it lacks inherent distinctiveness, which was previously only available as a ground of opposition. Examples of marks that will likely face this type of objection include those that consist of one or two letters of the alphabet, numbers, laudatory words, telephone numbers, TLDs and URLs, surnames, geographic locations and marks that are deemed to be clearly descriptive. UK brand owners should be aware that all applications that were not advertised as of 17th June will be re-examined for inherent distinctiveness.

8. NON-TRADITIONAL MARKS ARE NOW REGISTRABLE

Applicants can file Canadian trade mark applications for shapes, sounds, smells, tastes, textures, holograms, single colours, positioning, 3D and motion marks. However, CIPO now requires evidence of distinctiveness for these types of non-traditional marks, which may make the registration process more difficult.

9. DIVISIONAL APPLICATIONS ARE NOW PERMITTED

Canadian trade mark applications are now divisible and even sub-divisible; likewise, divided applications may be merged. This will be helpful to UK brand owners who face obstacles during examination or opposition. They will now be able to parse out problematic goods and services.

10. NOTIFICATION OF THIRD-PARTY RIGHTS

CIPO introduced a new procedure which permits parties to submit a notification of third-party rights

during examination on the basis that the pending mark could be confused with a registered mark or pending application, or that the description of goods and services includes reference to a registered mark (eg YO-YO™). The notification will be placed on file and will be available for public inspection; however, CIPO will not respond to the notification, nor provide information as to what action was taken. The registrar now has authority to withdraw the advertisement of an application, providing the application has not matured to registration. Therefore, these notifications will be a viable pre-opposition option for UK brand owners who object to the registration of a competing mark.

11. BILL C-86

Finally, additional amendments were introduced in Bill C-86, which received Royal Assent in 2018 and which will likely come into force in 2019. Bill C-86:

- introduces a new “bad faith” ground of opposition and expungement;
- provides that, on appeal of a decision of the registrar, new evidence may only be filed “with leave” of the Federal Court (as opposed to “as of right”);
- gives the registrar the power to award costs and grant confidentiality orders in opposition and cancellation proceedings;
- allows the registrar to impose case management deadlines in opposition and cancellation proceedings;
- requires trade mark owners who wish to enforce a mark that has been registered for less than three years to prove use of the mark in Canada; and
- protects licensees in the event of a bankruptcy of the brand owner.



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Paula provided a CITMA webinar on this subject on 16th July.



A GROWING MARKET

Peter S. Sloane offers a timely update on legalisation, registration and protection in what is a boom time for cannabis products

In late 2017, the *CITMA Review* published an article about cannabis trade marks in the United States. At that time, just seven states and the District of Columbia had legalised cannabis for recreational use, and an additional 19 states had legalised cannabis for medical use. The California market was developing slowly, and sales in Colorado had hit about \$875 million over the course of the previous year.

Much has changed since, and the market for cannabis is on the rise. Recreational cannabis is now legal in 11 states, and several others are actively considering legalisation. Meanwhile, medical cannabis is legal in 22 states. Recreational sales in California reached approximately \$1.2 billion in 2018 (and would have

been higher but for taxes and local licensing restrictions, which make it difficult for legitimate businesses to compete with street sales), and sales of regulated cannabis in Colorado rose to an estimated \$1.5 billion last year. By the end of 2019, retail sales of recreational and medical cannabis in the US are on pace to surpass \$12 billion – approximately a 35 per cent increase over 2018. More growth is expected.

Big brands have, predictably, taken notice and are making moves. In August 2018, Constellation Brands Inc., the market-leading alcoholic beverage company in the US, announced that it was investing some \$4 billion into Canadian cannabis grower Canopy Growth Corp. In December, Altria, the largest tobacco

company in the US, announced that it was buying a 45 per cent stake in Cronos Group, a global cannabis company, for around \$1.8 billion.

Big pharma is also getting in on the act. Last June, the US Food and Drug Administration took a major leap forward when it approved the first cannabis-derived medicine, a seizure disorder drug named Epidiolex. In December, Canadian cannabis company Tilray announced that it had signed an agreement to partner with Novartis subsidiary Sandoz to sell medical cannabis in countries where it is legal.

Yet in January 2018, the considerable growth of the US cannabis market seemed at risk when then-Attorney General Jeff Sessions rescinded the Cole Memorandum (an Obama-era Justice Department directive that essentially halted federal government prosecution of those who complied with state cannabis laws). Many expected a federal crackdown on individuals or businesses for cannabis-related offences to follow. However, Sessions' decision may actually have backfired, galvanising backing for states' rights and cannabis reform in Congress.

With this renewed momentum for cannabis legalisation, it seems timely to review key legal and regulatory changes, explore registration options, and offer pointers for IP practitioners.

THE HEMP GATEWAY

On 20th December 2018, the Agriculture Improvement Bill of 2018 (popularly known as the 2018 Farm Bill) was signed into law. Among other things, it legalised the cultivation and sale of hemp at the federal level by amending the Controlled Substances Act of 1970 (CSA) to declassify hemp as a Schedule 1 controlled substance. Hemp is a strain of the *cannabis sativa* plant species with a rich history of industrial, food and health-related uses. More technically, “hemp” is a term used to classify varieties of cannabis that contain 0.3 per cent or less tetrahydrocannabinol (THC, the active chemical that produces psychological effects) by dry weight. ▶

The 2018 Farm Bill offered a path towards the registration of trade marks for compliant hemp-related goods and services. And on 2nd May 2019, the USPTO issued Examination Guide 1-19 to clarify the procedure for registering marks for cannabis and cannabis-derived goods and for services involving cannabis and cannabis production.

The guide states that for applications that identify goods encompassing cannabis or cannabidiol (CBD, defined as “a chemical constituent of the cannabis plant that is encompassed within the CSA’s definition of marijuana”), the 2018 Farm Bill potentially removes the CSA as a ground for refusal of registration, but only if the goods are derived from ‘hemp’. According to the guide, if an applicant’s goods are derived from hemp, as defined in the Bill, the identification of goods must specify that they contain less than 0.3 per cent THC so that the scope of the resulting registration will be limited to goods compliant with federal law. The same rule applies when applications outline services involving cannabis-related activities (ie, they will be examined for compliance with the CSA and the 2018 Farm Bill). Applicants seeking to register marks for cultivation and other services related to hemp-based products must also show that they have an applicable state, territory or tribal government licence to provide their services.



While many variations of hemp are currently pre-approved as goods and services in the official ID Manual of the USPTO, the majority relate to fibres (hemp-cotton mixed fabrics in class 24, for example). It seems likely that the USPTO will eventually adopt a pre-approved term for lawful products containing 0.3 per cent or less THC content by dry weight. This would provide certainty in examination and allow applicants to avoid inquiry by examiners into the nature of the goods or to object on the grounds of specificity.

The new guidelines are a welcome step in the expansion of trade mark rights for the cannabis industry, and they are a boon for protecting brands in the red-hot CBD market. Unlike its close relative THC, CBD is

not psychoactive. CBD is sold in various forms, including oils, tinctures and topicals, and may help to treat a variety of conditions including anxiety, inflammation and pain. Products infused with CBD include skin care and beauty products, bath products and balms. However, while the guidelines will permit the registration of trade marks for some such hemp-derived goods such as cosmetics, they do not offer any obvious protection for the brands of CBD products derived from cannabis.¹

WHAT ARE THE WORK-AROUNDS?

Registration of cannabis marks remains forbidden at the federal level in the US. The USPTO last addressed the issue in *In re PharmaCann LLC*, 123 USPQ2d 1122 (TTAB 2017).² In that case, the Trademark Trial and Appeal Board affirmed its refusal to register the marks PHARMACANN and PHARMACANNIS for “retail store services featuring medical marijuana” and for “dispensing of pharmaceuticals featuring medical marijuana” on the ground that the Applicant lacked a bona fide intent to use the marks in commerce because the relevant services are prohibited by the CSA and can therefore not be considered to be in lawful use.

Despite the prohibition, foreign cannabis brand owners may have an advantage over domestic colleagues in trying to obtain registration for cannabis-related marks through the USPTO. Foreign applicants do not





Cannabis is coming under fresh scrutiny in the US as the market for CBD products grows

“ *The new guidelines are a welcome step in the expansion of trade mark rights for the cannabis industry* ”

necessarily need to prove use of the mark in the US before obtaining registration. Under s44 of the US Trademark Act,³ if an eligible applicant owns a valid registration from its country of origin, it may base its US application on that foreign registration. By contrast, an American cannabis brand owner must prove use of its mark in commerce prior to registration. If the specimen of use reflects a connection with cannabis, the examiner will likely refuse registration based upon unlawful use.

Of course, the ability to avoid the need to prove use of the mark in the US before obtaining registration does not entirely obviate the risk of refusal for foreign trade mark owners. When reviewing applications, examiners in the USPTO may still search the internet to look for evidence showing that the mark is used as a brand name for cannabis or related goods or services. They will then refuse registration on the ground that the identification of goods or services is too broad and must be read to include unlawful goods or services.

There are some strategies that may help to minimise the risk of such an objection. These include filing single-class applications rather than multi-class filings; the theory being that goods and services that may present an issue in one class should not jeopardise registration of another. For example, Leason Ellis LLP filed single-class applications with the USPTO on behalf of Tikun

PRACTICE POINTERS: CANNY STRATEGIES

- Avoid adopting marks at the outset that are likely to highlight controlled substance issues
- File for trade names, strain names and logos
- Include merchandising products and other ancillary goods that are legal at prima facie
- Use innocuous (but accurate) terms in the identification of goods and services (eg dried herbs or edible oil)
- Make sure that the identification used in the home country registrations will not raise red flags in the US
- Address anticipated technicalities when filing to avoid giving the examiner the opportunity to refuse registration
- Consider copyright protection for packaging design and logos
- Preserve evidence of first use and continued use of the mark, including sales receipts and advertisements, to back up common law rights
- Subscribe to watch services covering federal, state and common law marks
- Follow best practice guidelines for non-cannabis trade mark owners, from conducting availability searches with qualified US counsel to using proper trade mark notice and policing for infringements.

Olam Ltd., a global medical cannabis company and a pioneer in modern medical cannabis agriculture, treatment and clinical research. An application covering “providing information in the fields of health and wellness” in class 44 avoided refusal for unlawful use, while applications for the same mark in other classes have initially been refused under the CSA.

STATE REGISTRATION

Where federal registration is not available, state trade mark registration remains a viable option for cannabis-related businesses. While often looked down upon for what is perceived as weak protection, state registration laws closely mirror US federal trade mark law, albeit with a limited geographic scope.

European and other foreign applicants should bear in mind that many states have stringent filing requirements that are in many instances narrower than their federal counterparts. For example, the majority of state trade mark systems require not only use of the mark in the US, but also use of the mark in the state in which registration has been sought. In this regard, reliance on a foreign registration will not eliminate the use requirement. As such, applicants should only apply for state registration if and when the mark is being used in commerce within the relevant state.

Both the filing requirements and application forms are generally available online through each state’s Secretary of State website. There, applicants can find not only the procedure for filing an application in that jurisdiction, but also guidelines on how to identify goods and services within the application (which generally tracks that of the US federal system), whether specimens of use are required and other practical requirements. ▶

Stores selling hemp and CBD-infused products are now a familiar sight



There is little case law regarding the enforcement of state trade mark registrations, but in *Headspace International LLC v Podworks Corp.*, 5 Wash.App.2d 883 (2018), the Plaintiff relied upon both common law rights and a Washington State trade mark registration for the mark THE CLEAR for cannabis concentrates in asserting an infringement of its trade mark rights. The trial court had granted the Defendant's motion to dismiss, ruling that the Plaintiff had not alleged any lawful use of its mark in the ordinary course of trade in Washington and therefore had no trade mark rights to THE CLEAR in Washington. In reversing the decision and remanding the case, the Court of Appeals did not find any inconsistency between the CSA and the state law which established a framework for regulating commerce in cannabis. While the enforceability of the state trade mark registration was not at issue in the decision, the fact that the Plaintiff relied upon

such registered rights and that the Court found it a valid cause of action suggests that state courts may be willing to hear infringement cases and enforce trade marks even if the underlying goods are illegal under federal law.⁴

ANCILLARY OPPORTUNITIES

Of course, the cannabis industry encompasses much more than just the drug itself. A major industry convention in Las Vegas last year featured more than 1,000 exhibitors in product categories including cultivation real estate, extraction equipment, packaging supplies and paraphernalia. In a crowded market, branding is a crucial element of differentiation among competitors, and trade mark protection is essential to establishing boundaries and enforcing rights.

One of the most prolific litigants in the broader cannabis space in the US is Roor International BV, a German manufacturer of high-end glass pipes for smoking. Since 2018, Roor and its exclusive US licensee Sream are reported to have filed a torrent of trade mark infringement and counterfeiting suits in federal courts across the US. In one such lawsuit, *Sream Inc. v Superior Discount LLC*, 2019 WL 2124887 (E.D.La May 15, 2019), one of the Defendants, Quickys Discount, fought back and asserted counterclaims seeking cancellation of Roor's trade mark registrations based upon invalidity and unenforceability. Sream and Roor moved to dismiss the counterclaims

on the ground that they failed to state a claim on which relief can be granted, but the Court disagreed and denied the motion.⁵

In denying the motion to dismiss, the Court recognised that to qualify for federal trade mark registration, the use of a mark in commerce must be lawful and that the CSA makes it illegal to deal in drug paraphernalia, including glass pipes. With the counterclaims now allowed to proceed, there is a risk that Roor's registrations will be cancelled and that it will be unable to maintain a claim under federal law for counterfeiting. There are a number of enormous benefits to pursuing a claim for counterfeiting rather than mere infringement, including the prospect of obtaining statutory damages in addition to actual damages, which would be lost without a federal registration.

Overall, then, the 2018 Farm Bill and the USPTO's implementation of regulations for the registration of hemp marks should be a source of optimism for cannabis trade mark owners. However, until such a time as the CSA is repealed, those owners will have to be creative in their brand protection strategies in the US. They may also take solace in the fact that, at present, Canopy Growth has just two federally registered trade marks and Cronos Group has none (although both have many pending applications on file). Even the market leaders are finding themselves facing the same challenges when it comes to registering cannabis marks. ●

1 The registration of marks for foods, beverages, dietary supplements or pet treats containing CBD will still be refused as unlawful under the Food Drug and Cosmetic Act. The drug Epidiolex is the only CBD product currently approved by the US Food and Drug Administration.

2 See ttabvue.uspto.gov/ttabvue/86520135-EXA-31.pdf.

3 See tmep.uspto.gov/RDMS/TFSR/current/#/current/sec-dcb5b705-31d5-4c41-be3d-dc16b4f897c0.html.

4 Interestingly, Headspace was also plaintiff in two federal decisions. *Headspace International LLC v New Gen Agricultural Services LLC*, CV-16-3917-RGK (GJS), 2016 WL 9275781 (C.D.CA. 2016) and 2017 WL 2903181 (C.D.CA. 2017). It was also an Applicant in a USPTO opposition proceeding in connection with its now abandoned application for the mark THE CLEAR. *Herbal Wellness Center Inc v Headspace International LLC*, Opposition No 91233785. Herbal Wellness had opposed registration of the mark on mere descriptiveness grounds. Headspace subsequently abandoned its application with consent on a without prejudice basis. Despite the abandonment of the application, the product is still advertised online at clearconcentrate.com.

5 A cancellation proceeding between Quickys Discount and Roor International before the Trademark Trial and Appeal Board of the USPTO has been suspended pending the outcome of the civil action. Cancellation Number 92069681. See ttabvue.uspto.gov/ttabvue/v?pno=92069681&pty=CAN.



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SETTING THE RECORD STRAIGHT

Ewan Grist attempts to move the needle on the idea that design rights are difficult to enforce in the English courts

Design rights are fast stepping out of the shadow of patents and trade marks as an important and versatile set of IP rights for businesses in almost all sectors. No longer seen as the preserve of the fashion, consumer and luxury goods industries, creating great product design and protecting it as a core business asset is now widespread – even in tech-driven areas such as medical ▶

“ The fact that two-thirds of claimants succeeded in their claims should hopefully go some way towards dispelling the myth that it is unduly difficult to succeed in design cases before the English courts

devices, engineering and aviation. Companies are investing in creating good product design because design matters more than ever before in an increasingly image-conscious world. And design is not just about how the product looks; it can also serve as a crucial indication of quality and brand origin.

While companies from all sectors are undoubtedly starting to recognise the value and versatility of design rights, in the UK at least, a myth still persists in some quarters that design rights are harder to enforce successfully than other IP rights.

UNREPRESENTATIVE RESULTS?

There are perhaps two reasons for this misconception. The first is that the four highest-profile design cases in the UK in recent years (Procter & Gamble Co v Reckitt Benckiser; Apple v Samsung; Dyson v Vax; and PMS v Magmatic (Trunki)) have all resulted in findings of “valid but not infringed”. Trunki in particular, which went all the way to the UK Supreme Court, was widely publicised and also widely criticised (perhaps unfairly) for reaching the “wrong” result.

These four well-known design cases, all with the same outcome, have undoubtedly lent weight to the perception that the English courts are reluctant to find infringement. However, as I’ll discuss, the broader statistics of recent design cases suggest that the outcomes of these four cases are not representative of the bigger picture.

NARROW SCOPE

The second reason is harder to discount. Generally speaking, the English courts have tended only to grant a relatively narrow scope of protection to design rights, meaning that the defendant’s product needs to be relatively close to infringe. The exact scope of protection to be afforded to a given design will of course depend on the facts of the case, but only those designs without significant design freedom constraints and those which are radically different from the pre-existing design corpus will be afforded a wide scope of protection. Few designs can claim both.

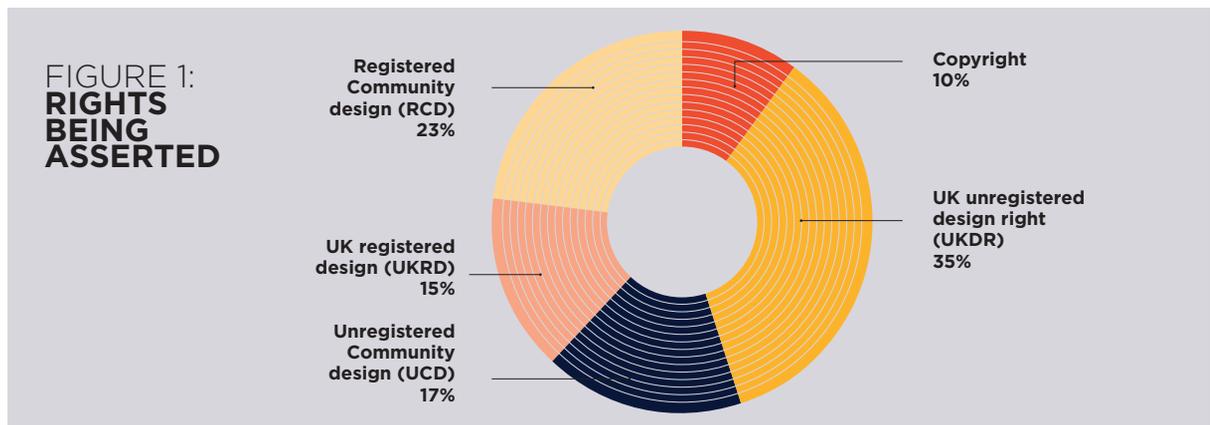
There may also be an unspoken rationale for the courts affording a relatively narrow scope of protection to design rights: registered EU and UK design rights are granted without any substantive examination, any proof of creation/entitlement, any limitation to a field of use, and without any requirement for the applicant even to use the design in question. In such circumstances, it is perhaps a reasonable quid pro quo that the scope of protection for such a right should be narrowly construed.

Of course, construing the scope of protection narrowly does make it somewhat harder for the claimant to succeed on an infringement claim. However, contrary to the popular misconception, the statistics of recent design cases from the English courts show that design owners are successful more often than not.

THE RECORD EXAMINED

I have logged details of all judgments handed down by the English courts over the past 13 years (IPEC, High Court, Court of Appeal or Supreme Court) in actions in which some form of design right (whether registered or unregistered and including artistic copyright relating to a physical product) was alleged to have been infringed. In total, there have been 35 such cases (but there are a greater number of judgments given that some of these cases have been appealed).

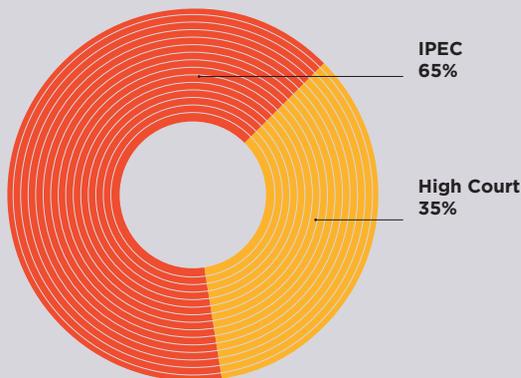
In many of these cases, more than one type of right was asserted. Just under 40 per cent (see Figure 1) were registered designs, compared with just over 60 per cent that were unregistered rights, demonstrating the great importance that the unregistered design regime holds.



**FIGURE 2:
SUBJECT
MATTER
FIELDS**



**FIGURE 3:
COURT OF
FIRST INSTANCE**



“ Average success rate across all asserted rights was 66 per cent

RIGHT TIME, RIGHT PLACE

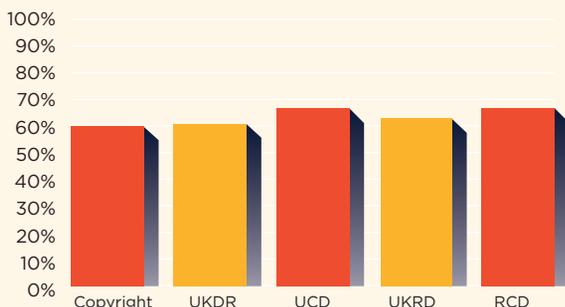
As one might expect, there is a strong showing for design claims related to fashion and homewares, but also a large number of designs relating to medical, health and beauty devices, as well as automotive and aviation, perhaps reflecting the increased recognition of the importance of design protection in these fields.

The statistics also show that a significant majority of design cases are started in the IPEC. This may be attributed to the generally lower complexity and value of an average design infringement case, and the attraction of the IPEC cost cap to the parties. Perhaps more surprisingly, design cases brought in the IPEC appear to have had a noticeably higher success rate than those in the High Court (85 per cent compared with 57 per cent).

AND THE WINNER IS...

While not necessarily providing the full picture, if we define winning as meaning that one or more of the rights asserted was found to be both valid and infringed, the average success rate (across all asserted rights) was 66 per cent. The fact that two-thirds of claimants succeeded in their claims should hopefully go some way towards dispelling the myth that it is unduly difficult to succeed in design cases before the English courts. ●

FIGURE 4: CLAIM SUCCESS RATE



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Data compiled by the author based on published court records for the period July 2007 – February 2019

Gap keeps its distance

George Matthey discovers why limitations have their limits for trade mark protection

On 11th April 2019, the High Court decided on an appeal and a cross-appeal from a decision of the UK IPO in an opposition by GAP (ITM) INC (the Opponent) against an application by GAP 360 LTD (the Applicant).

The Opponent is the renowned worldwide clothing and accessories retailer, originating from and headquartered in San Francisco. It opened its first store in the UK in 1987 and had 140 stores there at the time of filing its evidence, with additional stores in Europe and beyond. Meanwhile, the Applicant was incorporated in May 2011, with the purpose of providing gap-year opportunities to younger generations.

On 5th March 2013, the Applicant applied to register a UK trade mark for GAP 360 with respect to various services in classes 35, 36, 39 and 41 (the Application). Subsequently, the Opponent opposed the application on several grounds, including s5(2)(b) of the Trade Marks Act 1994 on the basis that the Application was similar to a number of the Opponent's earlier trade marks and was to be registered for services that are both similar and identical to those for which the earlier trade marks are protected. In doing so, the Opponent relied upon a number of earlier EU trade mark registrations for GAP, covering services in classes 35, 36, 39 and 41 (the Earlier Marks).

Crucially, during proceedings, the Hearing Officer (HO) allowed the Applicant to amend the description of services in classes 36 and 41, with the addition of the limitation "all relating to gap travel". However, the Applicant did not request such a limitation to be made to the list of class 35 and 39 services. Subsequently, the opposition was held successful in relation to all class 35 and 39 services applied for, but unsuccessful in relation to all class 36 and 41 services applied for. Thus, the limitation, "all relating to gap travel", had proven decisive in the HO's findings.

According to the HO, there was a likelihood that consumers would be confused into believing that the applied-for services in



classes 35 and 39, which did not feature the limitation, were those of the Opponent (or were in some way linked economically). However, in relation to the services in classes 36 and 41, he found that there was no such likelihood of confusion. His reasoning was that the element in common, GAP, in the context of services relating to "gap travel" had a low level of distinctiveness, such that the marks' element in common (GAP) was outweighed by the presence of the additional 360 element in the applied for mark.

Subsequently, both sides appealed:

- the Opponent on the basis that the HO had erred in finding GAP to be non-distinctive or descriptive in relation to services relating to "gap travel", and that the opposition should therefore also succeed in relation to classes 36 and 41; and
- the Applicant on the basis that the HO's rationale should also result in the opposition failing in classes 35 and 39, given that the Application also sought registration for "advertising services relating to the travel industry" in class 35, as well as various transport and travel services in class 39.

DECISION

In his judgment, Mr Justice Henry Carr held that:

- i. the HO had erred in concluding that the limitation precluded a likelihood of confusion in classes 36 and 41, while

KEY POINTS

✦ Limitations, exclusions and such similar qualifications lacking clarity and precision may be ineffective

✦ Extensive particularisation of specifications may be of little use where the goods/services fall within a niche subset of a class heading

✦ An earlier rights-holder will need to show likelihood of confusion among a significant proportion of the relevant public, but not necessarily the majority of consumers



“ During the proceedings, the HO allowed the applicant to amend the description of services

- its absence in the other two classes gave rise to a likelihood of confusion;
- ii. the limitation lacked precision and clarity pursuant to IP Translator, and therefore must be disregarded for the purposes of comparing the services at issue, as its inclusion would create considerable uncertainty in respect of the perceived scope of protection afforded to the registration;
 - iii. as set out in Postkantoor, a competent authority cannot be permitted to register a mark only in so far as the goods or services concerned “do not possess a particular characteristic”. The limitation, “all relating to gap travel”, falls foul of this because it purports to exclude other forms of travel services that do not relate to gap travel;
 - iv. although the HO was correct in finding that the terms “gap year”, “gap” (in the context of travel) and “gap travel” would be understood by a majority of consumers as relating to a break between finishing school and starting university, or between finishing university and starting work [para 15], he had erred by dismissing the

fact that the remaining consumers, although a minority, still constituted a significant proportion of the relevant public and would have no uniform understanding of the word “gap” when used in the context of travel, nor of the expression “gap travel”;

- v. the fact that a significant proportion of average consumers would fail to understand GAP in this context meant that, for the purposes of comparing the signs, that term possesses at least an average level of distinctiveness and, consequently, the 360 element was not to be given more weight. Accordingly, the reproduction of the identical element GAP in the applied-for mark, as well as the high level of similarity and identity of services (irrespective of the limitation), meant that a likelihood of confusion existed on the part of the relevant public with respect to all the services applied for. Thus, the Opposition succeeded in its entirety following appeal and the Applicant’s cross-appeal was dismissed.

NO NICHE BENEFIT

Although the limitation adopted by the Applicant in classes 36 and 41, “all relating to gap travel”, was disregarded on the basis that it lacks sufficient clarity and precision, Carr J noted that the specifications of the Earlier Marks are of broad scope and encompass “gap travel”, and reiterated the HO’s finding that “even if the limitation ‘all relating to gap travel’ makes any difference, it cannot affect the identity of the services because the Opponent’s specifications are unlimited and therefore cover services relating to ‘gap travel’ too.”

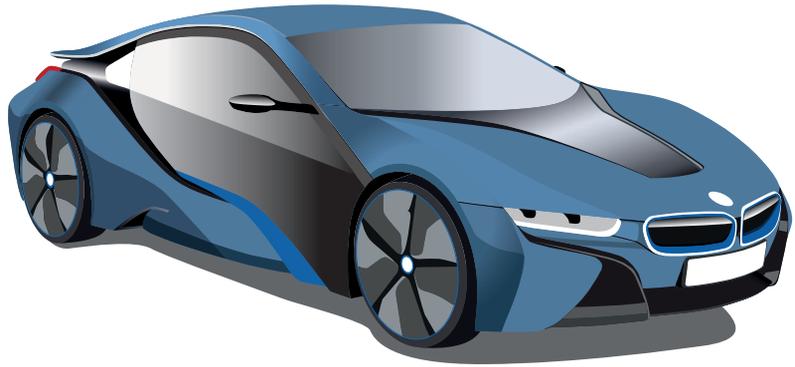
This emphasises that particularisation of the descriptions of goods/services will do little to prevent a finding of identity between goods/services subject to comparison (eg in opposition and/or infringement proceedings) where the Earlier Mark is protected for a broader scope of goods or services, and the applied-for mark seeks protection for a subset (no matter how niche).

It also outlines the important considerations that need to be taken into account when adopting a limitation in a trade mark specification, especially when using a limitation as a strategy to avoid a dispute.



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The name game



Pollyanna Savva finds support for big brands that seek to protect key identifiers

In this case, the Claimant was the registered proprietor of the EU trade mark BMW covering a wide variety of goods and services, including vehicles in class 12 and telecommunications in class 38. Benjamin Michael Whitehouse (the Second Defendant) incorporated a company under the name BMW Associates Ltd, which he claimed was a “one-man-band telecom railway company”. Following discussions, the Claimant and BMW Associates entered into a co-existence agreement. The Claimant undertook not to pursue its complaint and BMW Associates agreed to use BMW only as part of its company name and in respect of its railway telecoms services.

The Second Defendant incorporated another company under the name BMW Telecommunications Ltd (the First Defendant). This was not in breach of the co-existence agreement because the Second Defendant was not a party to it. The Claimant alleged passing off in that the inclusion of BMW in the First Defendant’s name inherently led, or would lead, to a misrepresentation that the First Defendant is associated with BMW. The Claimant also alleged trade mark infringement in accordance with Articles 9(2)(b) and (c) EUTMR.

ONE IN A MILLION

In support of its claim for passing off, the Claimant relied heavily on the decision of the Court of Appeal in *British Telecommunications Plc v One in a Million* [1999]. In this case it was held that the act of registration of domain names incorporating well-known brands amounted to a likelihood of a false misrepresentation.

The Defendants submitted that *One in a Million* ought to be distinguished on two grounds. The first was the addition of “telecommunications” in the company name. The second was the fact that the name was used only once in an invoice and the recipient was not confused as to the company. The Judge held that those facts did not dispel the propensity for confusion as a consequence of the act of registration of the company name.

On the question of infringement, the Defendants submitted that a likelihood of confusion did not exist (the Defendants changed the company name to BW Telecommunications Ltd before the defence was filed) and the requirements of Article 9(2)(c) were not met. Deciding on the basis of the original company name, BMW Telecommunications, His Honour Judge Hacon held that the Court’s rationale in *One in a Million*, in particular the confusion arising from persons consulting the Companies House register, applied equally to likelihood of confusion. The Claimant successfully obtained a summary judgment under passing off and trade mark infringement.

LESSON

The decision is a victory for brand owners seeking to extend the principles of passing off and trade mark infringement to other brand identifiers such as company names. Furthermore, now that Regulation (EU) 2017/1001 has transposed into UK law, claimants in a situation similar to BMW will be able to rely on section 10(4)(ca) of the Trade Marks Act 1994, which states that use of a sign as a company name is a specific use capable of being an infringement.

KEY POINTS

- ✦ Principles underlying infringement of a registered trade mark and passing off can extend to company names
- ✦ The entry into force of Regulation (EU) 2017/1001 expressly prohibits use of trade marks as part of company names under Article 9(3)(d) (s10(4)(ca) of the UK Trade Marks Act 1994



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Beauty registration cut short

Indirect confusion over CROP was compelling, writes Beverley Robinson

Here, The Beauty Crop Ltd (the Proprietor) registered THE BEAUTY CROP logo (shown right) for a range of cosmetic products in class 3 (the Registration).

Lyme Hall Pty Ltd (the Applicant) applied to have the Registration declared invalid on the basis of its earlier EU trade mark registration for CROP in a stylised typeface (shown right), covering “cosmetics including creams, lotions, gels and powders for the face, the body and the hands and make-up preparations for the face”. It sought invalidation on s5(2)(b) EUTMR grounds: the high similarity between the marks and the identity or high similarity between the goods give rise to a likelihood of confusion. The Proprietor filed evidence in defence to the invalidation relying on, in particular, an absence of actual confusion.

CONSUMER CONSIDERED

In determining the average consumer for the goods, the Hearing Officer (HO) considered that the goods were ordinary consumer goods bought fairly often by the general public, who would have a medium degree of attention when selecting these products.

In line with the principle outlined in *Meric*, all of the goods identified in the contested specification as “cosmetics” fell within the broad term “cosmetics” in the earlier specification and were therefore identical; the term “including” in the earlier specification did not limit the coverage to the goods that followed. All of the remaining goods were highly similar, except facial wipes/pads, perfumery and hair lotions, which were similar to a low degree.

The Proprietor argued that the common CROP element of the marks lacked distinctive character when used in the context of cosmetics and would generally be understood as referring to “the produce of the field, or to

the annual or season’s yield of any natural product”. While the HO accepted that the word “crop” may be very mildly suggestive of natural ingredients, this was not sufficient to weaken the inherent distinctiveness of the mark.

The marks were considered visually and aurally similar to a fairly low degree, but conceptually similar to a high degree. The HO rejected the Proprietor’s argument that the inclusion of additional words in the contested mark altered the meaning of the individual words. Although the HO considered the additional words to add the concept of beauty to the later mark, the meaning of “crop” remains intact and the conceptual differences arising from the additional words have little or no distinctive significance.

CONCEPTUAL CONCERN

In terms of direct confusion, the HO considered the visual differences between the marks and the slightly unusual phrasing of the later mark to be sufficient to avoid the consumer thinking that one mark is the other. However, when considering the notion of indirect confusion, it was felt that the conceptual similarities outweigh the visual differences and consumers are likely to believe that the contested mark is another brand of the Proprietor – even for the goods with a low degree of similarity.

As such, the application for invalidation succeeded in full and the Registration was declared invalid.

KEY POINTS

✦ Even where there is no likelihood of direct confusion, indirect confusion can occur if the average consumer thinks that the later mark is another brand of the owner of the earlier mark or a related undertaking

✦ It is not necessary for parties to provide evidence that there will be confusion. Furthermore, without strong evidence that the relevant consumer has encountered both marks it will be difficult to argue that an absence of evidence of actual confusion is significant

MARKS

The Applicant’s earlier mark



The Proprietor’s later mark




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War of the whiskies

Dewdney Drew draws out the importance of detail

In 2013, the family business of Douglas Laing & Company Ltd demerged, with one brother (Fred Laing) staying with the company and the other (Stewart Laing) going on to found Hunter Laing & Company Ltd (the Proprietor). The Proprietor filed a trade mark application for the mark DOUGLAS OF DRUMLANRIG in March 2013, as this was one of the Douglas Laing brands that was going with Stewart Laing to the new business. The demerger was finalised in April 2013.

In 2015, a dispute arose between the Proprietor and Andrew Crombie (the Applicant), resulting in an application for invalidity on the basis of earlier registrations for DOUGLAS BLEND label and CLAN DOUGLAS label, as well as passing off rights in various marks (including DOUGLAS OF DRUMLANRIG) and an allegation that the DOUGLAS OF DRUMLANRIG application had been filed in bad faith. The Applicant's general position was that Douglas Laing had been his licensee, and that he was the true owner of the mark. The Proprietor responded by filing revocation actions against the two earlier registrations on the basis of non-use.

ALL POINTS LOSS

The Applicant lost on all points before the Hearing Officer (HO) at the UK IPO. A great deal of evidence was filed by the Applicant and the hearing included cross-examination of both Andrew Crombie and Stewart Laing. A major weakness in the Applicant's case was a conflation of the position of the Applicant personally and that of a company, The Shieling Scotch Whisky Company Ltd (Shieling), which had been trading since around 1970 but was dissolved in 2009. The alleged assignment of this company's registrations to the Applicant was found to be ineffective for lack of an underlying assignment document, this defect emerging

under cross-examination. Any usage of the relevant marks was held to have been by Shieling and not the Applicant and this had an impact on the claim to passing off rights. The argument that the earlier marks relied on by the Applicant had been used by Douglas Laing under licence was also undermined, along with a lack of evidence for such a licence. The bad faith arguments were wide-ranging, but each was rejected. In particular, the filing of the application prior to the demerger being finalised was held to have been a prudent business decision taken in anticipation.

“
The bad faith arguments were wide-ranging, but each was rejected

The reasons for appeal were “prolix and in large measure opaque” (paragraph 19), but its skeleton argument focused on a request to pierce the corporate veil so as to get around the distinction between the Applicant and Shieling; give effect to a retroactive assignment executed in 2016 after Shieling was restored to the Companies Register; find bad faith on the part of the Proprietor due to rights not being acquired before the application was filed; and find Stewart Laing “negligently incognisant” for not having been aware of earlier rights prior to filing.

All grounds were dismissed. The HO's finding regarding the failed assignment was upheld. The retrospective assignment in 2016, while potentially valid between the Applicant and (the restored) Shieling, was not effective against third parties and could not alter historical facts.

KEY POINTS

- ✦ A TM16 (change of ownership form) without an underlying assignment is ineffective
- ✦ Bad faith is best tested by way of cross-examination
- ✦ When it comes to evidence, quality trumps quantity

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Landmark decision

Declan Cushley describes a dispute that centred on a famous folly

Old John is a Georgian folly and a Leicestershire landmark. Built in 1874, it is located in Bradgate Park and run by the Bradgate Park Trust. The Bradgate Park and Swithland Wood Charity (the Proprietor) registered three variations of images of Old John as trade marks (see right for examples). The marks were Series marks. More recently, the Bradgate Park Trust sought to prevent local businesses from using images of Old John without paying a licence fee. Artists were also asked to pay for a licence to sell images of the landmark.

A local furore commenced, and Andrew Alan Foster (the Applicant) applied to revoke the three marks for non-use. The counterstatements did not defend the marks in every class, so some classes were revoked at an early stage. The decision considered here reviews the extent to which the marks should be revoked in respect of the remaining classes, which include class 9 (refrigerator magnets), class 20 (antlers), class 26 (thimbles), class 43 (restaurant, cafeteria and snack-bar services, catering services) and class 29 (meat, poultry and game, products made from meat, poultry and/or game).

TERMINAL OMISSION

For some goods and services, although use was claimed, no sales figures were provided. So, for example, the failure to evidence sales of antlers or tea-room services proved terminal. For other goods, sales figures were provided for the seven-month period between April and October 2017. Not all such sales met the threshold. During that time, sales of thimbles totalled £2, which did not amount to genuine use. Neither did £16.80 worth of erasers or £17.00 of pencil sharpeners suffice. Badge sales amounting to £234, however, did satisfy the Hearing Officer (HO).

Some images of Old John used were too dissimilar to the registered marks to amount to genuine use, which was fatal to fridge

magnets and restaurant services. However, the use in a badge containing other elements was found to be an acceptable variant.

The HO quoted Mr Justice Arnold in *London Taxi*, noting that purely decorative use did not count; genuine use requires a mark be used to denote trade origin. In a passage one can imagine being cited by recipients of future requests for artistic licences, the HO stated that: "Photographs of landmarks (either in their original form or printed on secondary goods), when they are clearly just photographs of landmarks, are likely to be viewed by the consumer as just an image being used for decorative purposes. The consumer is unlikely to view a photograph presented on goods commonly sold as souvenirs or mementos as indicative of trade origin."

Ultimately, the first and second registrations were entirely revoked. In relation to the third mark, the HO considered what a fair specification would be given the goods and services that had been used. So, sales of venison could not support all of "meat, poultry and game, products made from meat, poultry and/or game" in class 29, and the specification was limited to "venison and products made from venison".



KEY POINTS

- + A good example of how the IPO approaches non-use challenges, and an insight into the economics of gift shops at public parks
- + Genuine use requires a mark be used to denote trade origin

SAMPLE MARKS

UK registration
No 2272671



UK registration
No 2272669A



UK registration
No 2272669B



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Gallivant fails to bridge the gap

Laura Robyn details how a lack of compelling evidence stopped the Opponent's advance

This case concerned an opposition against an application to register the mark BROOKLYN for perfumes in class 3, filed by Laurice El Badry Rahme Ltd (the Applicant). It was opposed by Gallivant Perfumes Ltd (the Opponent) on the basis of unregistered rights in BROOKLYN (s5(4)(a) EUTMR), as well as absolute grounds (s3(1)(a), (b) and (c)) and bad faith (s3(6)).

The Hearing Officer (HO) first considered the absolute grounds advanced, which stated that because “numerous companies use BROOKLYN in relation to perfumes” the mark is a geographical indication, is dilute and incapable of performing the origin function of a trade mark under s3(1)(a), and lacks the necessary degree of inherent distinctiveness to be registrable under s3(1)(b). Both grounds were swiftly dismissed on the basis that the Opponent had not supplied evidence to corroborate its claim (other than “State of the Register” evidence, which has no relevance to the marketplace). The HO could not accept that the UK public would view Brooklyn as a perfume-making centre.

The HO applied the same finding to the assessment of whether the mark was descriptive of perfumes, concluding that “the Opponent has not shown that the average consumer of perfume in the UK believes the borough [Brooklyn] to be well known for anything”. All s3(1) claims fell.

BAD FAITH

The HO deduced from the evidence that the Applicant's earliest use of BROOKLYN dates to 2010, whereas the Opponent's BROOKLYN perfume was launched in March 2017. The Applicant is therefore the senior user, and the HO held that the Applicant's application was consistent with standards of acceptable commercial behaviour. The s3(6) ground also fell.

CONTRADICTIONARY GROUNDS

The HO noted the Opponent's contradictory grounds, it having first asserted that BROOKLYN is not capable of performing as a trade mark only to go on to claim unregistered rights in the same mark for identical goods.

Moving on to the classic trinity, the HO pieced together the Opponent's limited evidence and found that, despite its low sales value in the context of the UK perfume market, the Opponent had goodwill in the BROOKLYN name. Given the identical marks and identical goods, he was satisfied that the Opponent also cleared the misrepresentation and damage hurdles.

However, the HO went on to consider the Applicant's earliest use of BROOKLYN, in selling its “Bond No. 9 Brooklyn” fragrance in the UK. For the purposes of deciding whether the passing off claim was successful, the HO had to determine whether the earliest use of the Bond No. 9 Brooklyn mark constituted genuine use of BROOKLYN.

The HO held that, since the word BROOKLYN appeared repeatedly in the centre of the label in a larger script, the public would likely be able to distinguish the Bond No. 9 and NYC elements as the manufacturer and company location, respectively. He was therefore satisfied that the relevant sales evidence went towards showing use of BROOKLYN, making the Applicant the senior user of the mark.

Consequently, the passing off claim also fell, and the opposition was dismissed in its entirety.

KEY POINTS

- ✦ A claim of bad faith will require more than merely making an application to register in the knowledge that third parties are using the mark
- ✦ The decision confirms longstanding practice that a place name can successfully function as an indication of trade origin; the question being how the relevant consumer would assess the name in connection with the goods/services in question

“
The Opponent also cleared the misrepresentation and damage hurdles



Laura Robyn

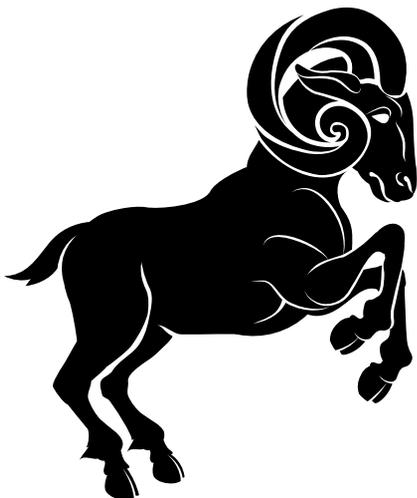
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Crossing the language barrier

Close conceptual similarity may mean confusion cannot be ruled out, opines Désirée Fields

In June 2018, Black Sheep Brewery Plc (the Applicant) applied for BLACK SHEEP as a UK trade mark in respect of alcoholic beverages in class 33. Baron Phillipe De Rothschild S.A (the Opponent), proprietor of UK trade mark MOUTON CADET (meaning “young sheep”), opposed the application under s5(2)(b) and 5(3) of the Trade Marks Act 1994, arguing that: (i) the mark applied for would cause likelihood of confusion with its own mark; and (ii) the use of the mark applied for would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier mark.

The Hearing Officer (HO) found that there were two relevant categories of average consumers: French speakers and non-French speakers. There was no visual or aural similarity between the parties’ marks, meaning that the main point of contention was conceptual similarity. For non-French speakers, the only potential connection between the BLACK SHEEP and MOUTON CADET marks was the association of “mouton” with the English word “mutton”. However, having identified the words as foreign, it was deemed unlikely that an individual would try to make associations with similar-sounding English words. Accordingly, there was no likelihood of confusion between the two marks for non-French-speaking consumers.



Despite the similarities in the literal meaning of each mark, the same conclusion was reached regarding French-speaking consumers. The proportion of French speakers capable of translating the Opponent’s mark was deemed insufficient and, for those that were capable of translation, the lack of visual similarity between the marks and the dual meaning of “black sheep” meant that it was unlikely that they would mistakenly recall one brand in place of the other. The possibility of indirect confusion (acknowledging the differences between the two brands but assuming, due to similarity, that the marks have originated from economically linked undertakings) was also dismissed since “neither mark is a logical extension of the other”.

LINK UNLIKELY

The lack of any similarity between the respective parties’ marks meant that the case under s5(3) fell at the first hurdle regarding non-French-speaking consumers. For French speakers, the lack of any aural or visual similarity between the marks and the limited conceptual similarity suggested that the relevant public would still be unable to make a link in their minds. Accordingly, the opposition failed in its entirety.

While here there was insufficient conceptual similarity between the English-language mark applied for and the earlier foreign-language mark, it is not difficult to imagine a situation where the literal meaning of two marks is more closely aligned. The reasoning of the HO suggests that even if an earlier mark is in a language that is not spoken by the majority of the relevant public, conceptual similarities and a likelihood of confusion may still be found.

KEY POINTS

- +
- Where there is potential conflict between two trade marks, one of which is in a foreign language, the likelihood of confusion between these marks must be assessed in relation to both those who do and those who do not speak that foreign language
- +
- It is possible to find a likelihood of confusion between an English language mark and foreign language mark if they are conceptually identical or similar. However, a global assessment between the two marks must still be carried out



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With thanks to Joshua Tray, Intern at DLA Piper UK.

Pecking order decider



Rob White reflects on a finding of indirect confusion between hen-do brands

Glen Buchanan (the Opponent) is the owner of a UK registration for the mark MISS TO MRS (filed in July 2016) in respect of various classes, including class 16 for inter alia “writing stationery; gift boxes; gift bags; decorative paper garlands for parties” (the Earlier Mark).

Mr Buchanan opposed UK Application No 3269748 (filed in November 2017) by the Sterling James Company, LLC (the Applicant) for the mark MISS TO MRS. WITH ALL MY BITCHES, covering display banner/party decoration-related goods in class 16. The opposition was based on the Earlier Mark under s5(2)(b) and damage to the Opponent’s alleged reputation under s5(3) and 5(4)(a) of the Trade Marks Act 1994. The Opponent claimed use on badges, balloons and gift bags since March 2016 and submitted evidence to support the use.

Under s5(2)(b), the Hearing Officer (HO) concluded that the Opponent’s goods were identical or highly similar to the Applicant’s goods. The relevant consumer would have an average degree of attention for such goods, selecting them visually.

The HO assessed the inherent distinctiveness of the Earlier Mark. It was recognised that the Opponent’s goods could be intended for hen-do celebrations where MISS TO MRS may be seen as a “decorative slogan” rather than a trade mark. However, as the registered goods were not limited, the assessment must be based on notional and fair use of the mark as registered, not the Opponent’s actual use. The Earlier Mark hence had an average degree of distinctiveness for broader goods and a below-average distinctiveness for hen party goods.

The Applicant sought to argue differences in the colour and font of the marks as used. The HO rightly dismissed this, as the comparison must be between the marks as filed. The marks were deemed visually, aurally

and conceptually similar to a medium degree, as the first part of the marks were identical.

Despite the whole of the Opponent’s mark having been taken, applying the Medion principles as discussed by Mr Justice Arnold in *Whyte & Mackay Ltd v Origin Wine UK Ltd* (2015 EWHC 1271), and considering the impact of the CJEU’s ruling in *BIMBO* (C-591/12P), the HO surprisingly concluded there would be no direct confusion.

However, using the principles from *L.A. Sugar* (O/375/10) and assessing notional and fair use, a likelihood of indirect confusion was found, in scenarios both where a consumer encounters the Earlier Mark on goods specifically for hen-do parties, and for more general gift goods.

The Opponent’s evidence under s5(3) was criticised as much of it was undated or after the relevant date. Therefore, this ground failed. Under s5(4)(a), goodwill was found, but only for hen-do party balloons. These were still deemed “highly complementary” to the Applicant’s goods, thus finding misrepresentation and damage.

Although the decision is not surprising, it serves as a reminder to consider notional and fair use of the specification as registered rather than actual use. Success under direct confusion is also not guaranteed, even when the later mark takes the whole of the earlier mark. Where the Medion/BIMBO principles apply, a case for indirect confusion should therefore be fully argued.

KEY POINTS

- ✦ When comparing marks, the UK IPO will only assess notional and fair use of the goods as registered, not actual use
- ✦ If part of the mark is of low distinctiveness for a particular category of goods covered, it may be more distinctive in respect of broader goods
- ✦ Direct confusion is not guaranteed, even when the whole of the earlier mark has been taken, so seek to argue and demonstrate indirect confusion



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Association negotiation

The Applicant established the necessary links, reports Eleni Mezulanik

Mersen France Amiens SAS (the Applicant) filed a cancellation action under Article 59(1)(a) in conjunction with Article 7(1)(c) EUTMR against registered EU trade mark No 17805953 (I-BRUSH) in classes 7 and 9 covering various brushes and holders for use in electric and electronic machines, apparatus and instruments in the name of AB Dynamoborstfabriken (the Proprietor).

The Applicant cited well-established case law and submitted dictionary evidence in order to argue that the mark was descriptive within the meaning of Article 7(1)(c) EUTMR. The Applicant's arguments focused on the mark being purely descriptive in relation to the goods all being (electric) brushes or brush holders (characterised by a brush) that are internet-activated/interactive or otherwise internet-related. As such, the Applicant argued that the elements "I" and "BRUSH" together would be perceived by the relevant consumer as a designation of the technical goods in question, bearing in mind that the awareness of the relevant public is high.

The Proprietor filed counterarguments against the descriptiveness objection and filed arguments on the basis that brushes are not interactive or internet-based. The Proprietor also included other examples of marks prefixed with "I" that have been registered by the EUIPO.

When assessing whether a mark is descriptive, it is settled case law that it must be determined whether the relevant public will make a sufficiently direct and specific association between the expression and the goods/services for which registration is sought (T-311/02 LIMO). Public interest is also taken into account in the assessment of descriptiveness (C-191/01 P, DOUBLEMINT).

It is also settled case law that where a sign is descriptive in respect of a main product (brushes in this case), it is also descriptive

of goods that are ancillary or complementary to it. It was held that all of the relevant goods are complex and technical goods, and that the level of attention of the relevant consumer will be high in relation to electrical goods in general.

The Applicant relied on T-161/09 ilink (paragraph 30) and additional Board of Appeal decisions to support its argument that internet-related goods are commonly prefixed by "I". It was held that the Internet of Things is the extension of internet connectivity into physical

devices and everyday objects that can communicate and interact with others over the internet and can be remotely monitored or controlled. With regard to the EUTM registrations cited by the Proprietor (including I-cigar and iWine), it was held that trade marks must be assessed as a whole in the context of their

particular goods bearing in mind the relevant consumer. Therefore, it is important to note that terms prefixed with "I" combined with another verbal element may not be comparable to this case, and terms which may be considered to be descriptive now may not have been considered descriptive previously.

The Office held that the Applicant succeeded in establishing a direct and specific association between all of the contested goods and the contested mark as a whole, and the registration was declared invalid.

KEY POINTS

- + Restricting the Cancellation Division to an examination of the facts expressly submitted does not preclude it from also taking into consideration facts that are well known, are likely to be known or can be learned from generally accessible sources
- + The Internet of Things is an established commercial phenomenon
- + Office practice and decisions reflect changing markets

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The Proprietor filed arguments on the basis that brushes are not interactive or internet-based



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Date with destiny

Timing was crucial for Louboutin's latest test, says Stephanie Taylor



Van Haren Schoenen B.V. (the Applicant) filed an application for invalidity of EUTM Registration No 8845539 (the Proprietor's mark) in the name of Christian Louboutin (the Proprietor). The mark covers "high-heeled shoes (except orthopaedic footwear)" in class 25 and contains the description: "the trade mark consists of the colour red (Pantone 18.1663TP) applied to the sole of a shoe (the outline of the shoe is therefore not part of the trade mark but serves to show the positioning of the trade mark)".

The Applicant argued that EUTM Regulation 2015/2424 (the amended EUTMR) is binding and contained no transitory law, so if the new regulations did not immediately apply to all registered trade marks, it would lead to a lack of legal certainty. It also argued that the Proprietor's mark consists exclusively of a shape (or another characteristic) that gives substantial value to the goods. Even if the amended EUTMR is not applied, it argued, the Proprietor's mark falls under the scope of the definition of a shape and the registration should therefore be cancelled. The Applicant filed supporting evidence, including a survey that claimed that when shown a picture of red-soled shoes, a majority of women would buy them based on their appearance; less than a quarter would buy based on the brand.

The Proprietor argued that its mark does not exclusively consist of the shape of goods and that the provisions of Article 7(1)(e) EUTMR can only apply to trade marks that

have become registrable since 23rd March 2016 or where registration was applied for no earlier than that date.

The Cancellation Division (CD) determined that the wording of Article 7(1)(e)(iii) EUTMR, notably "signs which consist exclusively of... (iii) the shape, or another characteristic, which gives substantial value to the goods", has only been applicable since 23rd March 2016, the date of entry into force of the amended EUTMR.

Since the Proprietor's mark was filed on 29th January 2010, the regulation in force at that time was Regulation No 207/2009, even if the Proprietor's mark was registered on 10th May 2016, after the entry into force of the amended EUTMR. Referring to C-21/18 Textillis Ltd, Ozgur Keskin v Svenskt AB, the CD confirmed its view that that new regulation is also not applicable to marks applied for before the entry into force of the new regulation, even if registered after that date, because the filing date of the application for registration of an EUTM is the material date for examination of the ground for invalidity under Article 7(1)(e)(iii).

The CD concluded that the mark is exclusively composed of a colour rather than a shape and that the colour of a sole would not dominate the overall impression of a shoe and give it substantial value. The fact that a red-coloured sole was unusual at the time of filing of the registered Proprietor's mark would instead lead to the conclusion that this colour was distinctive per se for the goods of interest.

The CD also criticised the survey adduced by the Applicant on the basis that the questions asked were about the appearance of shoes as a whole and held that the colour of the soles does not usually determine such appearance. Instead, the CD agreed with the Proprietor's assessment that its mark would be seen as an indication of the origin of the goods. As such, the declaration for invalidity was rejected.

KEY POINTS

- ✦ The CD referred to Textillis and confirmed that the wording of Article 7(1)(e)(iii) of the amended EUTMR has only been applicable since 23rd March 2016
- ✦ The CD also confirmed its view that that new regulation is not applicable to marks applied for before the entry into force of the new regulation, even if registered after that date

MARK

The Proprietor's mark



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Rounded evidence required

And don't forget the option to rely on unregistered rights, advises Thomas Hooper

This decision is concerned with an EUIPO Board of Appeal (BoA) decision related to an opposition filed by Sony Computer Entertainment UK Ltd (Sony) against Huawei Technologies Co. Ltd's (Huawei's) EUTM application No 14738298 for the word mark GT9. Sony relied on its earlier EUTM registration No 820738 for the logo shown below and based its opposition on Articles 8(1)(b), 8(4) and 8(5) EUTMR.

The BoA dismissed Sony's opposition based on Articles 8(1)(b) and 8(5), holding that Sony's earlier mark and Huawei's contested sign were dissimilar. Visually, Sony's mark would not have been perceived by consumers as a representation of the letters GT. In contrast, Huawei's GT9 mark was composed of letters and a number. Having decided that Sony's mark was purely figurative, the BoA found that it was impossible to compare the marks aurally (perhaps interestingly). As Sony's mark was an abstract sign, it thus shared no conceptual similarity with Huawei's mark.

Sony also relied on Article 8(4), arguing that it had established earlier unregistered rights to the word mark GT in the UK in relation to

various goods and services. Accordingly, since Huawei had applied for the contested mark on 26th October 2015, Sony was required to prove it had used GT in the course of trade in the UK prior to that date in relation to the relevant goods and services. Sony submitted a significant amount of evidence to attempt this. Nevertheless, the evidence was deemed insufficient, mainly referring to the mark GRAN TURISMO, its figurative registered mark (shown left), or a combination of both. In addition, Sony did not provide secondary evidence to support the witness statements of professionals attesting to how consumers perceived the sign or evidence relating to the commercial volume, duration and frequency of its use of the GT mark.

As regards Sony's claim to protection for retail services for various goods, the BoA held that the fact that Sony sold its own products via the internet did not mean that its main activity was retailing. Such services would have also involved selling third-party products. Similarly, since Sony was organising competitions to promote its own products only and not providing such services to

third parties, it had not proven that it had used the GT mark in relation to those services. As a result of these findings, the BoA held that the evidence submitted was insufficient and Sony's arguments based on Article 8(4) failed.

This case demonstrates the importance of submitting well-rounded

evidence when relying on an Article 8(4) ground. It also serves as a general reminder that prospective opponents are able to rely on their unregistered rights in EU opposition proceedings, provided they are able to submit sufficient evidence to support the existence of such rights and can satisfy the other conditions. This can be useful where an opponent lacks the necessary registered rights to support an opposition under the more common grounds of opposition, such as Articles 8(1) and 8(5), or it could be used to supplement an opposition in addition to those grounds.

“
Sony submitted a significant amount of evidence to attempt to prove use in trade”

KEY POINTS

+ Articles 8(1)(b) and 8(5) will only succeed where there is the requisite degree of similarity between the marks

+ For the purposes of Article 8(4), it is important to submit evidence that demonstrates clear use of the particular mark for which unregistered rights are being claimed

MARK

The Sony mark



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The public plays its part

Linguistic specifics can create confusion, explains Gavin Stenton

This case concerns an opposition filed by Asmodee Group against EUTM application No 17 895 544 for the word mark DOODLE by Shantou Chenghai Coolplay Trading Co. Ltd.

The opposition was based on a claim of likelihood of confusion with an earlier EU registration for the word mark DOBBLE. The application sought registration for: “Toys for babies; building blocks [toys]; scale model vehicles; action toys; toy vehicles; jigsaw puzzles; remote-controlled toy vehicles; scale model kits [toys]; stuffed toys; toy models; flying discs [toys]; toy putty; scale model airplanes; toy airplanes; educational toys; toys” in class 28. The goods applied for were all deemed identical to goods for which the earlier mark was protected, so the outcome of the opposition essentially came down to whether the respective marks were similar enough to give rise to a likelihood of confusion.

First, the Opposition Division (OD) noted that it is irrelevant whether a word mark is registered in upper- or lower-case characters. In the case of word marks, it is the word as such that is protected and not its written form.

When considering visual similarity, the signs were held to be visually similar to an average degree, taking into account that the signs coincide in a majority of their letters (involving DO and LE separated by two characters) and in both their beginning and ending letter combinations.

EU IMPACT

Aurally, the signs were held to be highly similar in certain parts of the EU, particularly for the Czech-, Polish- and Slovak-speaking parts of the public. For this part of the relevant public, the signs are pronounced “DO-DLE” and

“DO-BLE”, generating a highly similar rhythm and intonation in both signs.

The first syllables of the signs also start identically with the sound of the letters “DO”, and the ending of the first syllable is less audible than the beginning of it. In light of the above, the OD found that the signs were aurally highly similar. A conceptual comparison was not possible, as the marks were held to convey no meaning.

Considering that the signs were visually similar, aurally highly similar and the contested goods were identical to the Opponent’s Goods, the OD held that there was a likelihood of confusion in the Czech-, Polish- and Slovak-speaking parts of the public. As a likelihood of confusion for a part of the relevant public of the EU is sufficient for an opposition to succeed, the application was refused.

KEY POINTS

- ✦ A likelihood of confusion for a part of the relevant public of the EU is sufficient for an opposition to succeed
- ✦ Consider carefully how each part of the relevant public will pronounce the signs/marks before filing an EUTM application or opposition, also having due regard to any semantic differences in the languages of the Member States



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Thalgo gets go-ahead

Jasmine Sihre confirms that mark variations can have value

In 2014, **Radoslaw Pielczyk** (the Applicant) registered **DERMAEPIL SUGAR EPIL SYSTEMS** (Stylised & Device) in classes 3 and 5 at the EUIPO.

In 2015, the Intervener, Thalgo TCH, filed an application for a declaration of invalidity for all the goods registered, which was based on an earlier French registration **DERMEPIL** (Stylised & Device) for goods in class 3, registered in 1988. The ground relied on in support of the application was Article 8(1)(b) EUTMR.

The Applicant filed a request for proof of use of the earlier mark, and the Intervener submitted evidence to support that the earlier mark had been put to genuine use in France. The cancellation was partially upheld.

APPEALS PROCESS

The Applicant appealed on the ground that genuine use of the earlier mark had not been proven and that there was no likelihood of confusion between the marks. The Intervener also appealed on the ground that invalidity of the contested mark should also have been applied to the entirety of the specification, not partially.

The Applicant then argued that evidence filed by the Intervener did not relate to use of the earlier mark as registered, and the evidence related to a different trade mark altogether, therefore arguing that the distinctive character of the earlier mark had changed. The Applicant also argued there was no likelihood of confusion between the marks.

The Board of Appeal (BoA) responded to the arguments citing Article 18(1)(a) EUTMR, that use of an EU trade mark is considered to include use “in a form differing in elements that do not alter the distinctive character of the mark in the form in which it was

registered”. It held that the use of variations of the mark did not alter the distinctive character. The purpose of the Article is to allow businesses to adapt the marketing and promotion of goods and/or services.

The BoA held there was a likelihood of confusion on the basis that the goods in question were complementary (*Hut.com v OHIM – Intersport France (THE HUT)*, T-330/12). In this instance, “toiletries” were held as a broader category and therefore

identical to “cosmetics for depilatory purposes”.

The BoA dismissed the Applicant’s appeal and upheld the invalidity action. The BoA held that the earlier mark as registered had been used in different variations, that all the variants included the words **DERMEPIL**, and that the alterations in the use of the mark did not change the distinctive character of the earlier

mark as registered. The General Court upheld the BoA’s decision.

It is worth noting that, in response to a proof of use request, it is possible to file evidence showing use of a registration in variations (if the overall distinctive character does not change). Taking a step back to the pre-filing and clearance stages, to avoid having to defend an action, it is important not to disregard rights that may exist in variations of a registered mark.

“

The BoA held that alterations in the use of the mark did not change the distinctive character

KEY POINTS

Where use of a mark is varied, and if the distinctive character is not compromised, it is acceptable to file this as evidence of genuine use

Goods and services that are not strictly identical can be complementary, therefore raising a risk of likelihood of confusion

MARKS

The Applicant’s registered EUTM



The Intervener’s earlier French registration



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Putting the focus on purpose



The practical use of goods led to a decision dismissal, reports Leanne Gulliver

Here, the General Court (GC) partially upheld Pet King Brands, Inc.'s (Pet King's) opposition to Virbac SA's (Virbac's) EU trade mark (EUTM) application, finding that the Board of Appeal (BoA) had erred in law when assessing the degree of similarity between the goods.

The prime origin of the decision was an application by Virbac in January 2016 to register an EUTM for the word mark SUIMOX for the following class 5 goods: veterinary preparations; veterinary preparations and animal health care products, including antibiotics for animals; nutritional supplements for veterinary use; sanitary preparations for veterinary use; dietetic substances for veterinary purposes; disinfectants for veterinary use; preparations for killing weeds and destroying vermin; and vaccines for veterinary use.

In May 2016, Pet King opposed the registration of the application in its entirety on the basis that, contrary to Article 8(1)(b) EUTMR, the application is confusingly similar to its earlier EUTM (No 871232) for the word mark ZYMOX, which was registered on 18th July 2005 for “medicated ear drops for domestic animals” in class 5.

During the adversarial stage of the proceedings, Virbac limited its class 5 specification to exclude “ear drops for animals”.

In the first instance, the Opposition Division rejected the opposition in its entirety on the grounds that there was no likelihood of confusion. Pet King appealed to the BoA.

BOA ASSESSMENT

The BoA dismissed the appeal, concluding that it was unlikely that EU consumers would believe that the goods covered by the marks at issue would come from the same undertaking or from undertakings that were economically linked.

In reaching its decision and conducting a global assessment, it had taken into account

the following relevant factors: (i) the relevant public was composed of both specialists and the general public with no specific medical, veterinary or pharmaceutical knowledge; (ii) veterinary products sold without prescriptions benefit from a high degree of attentiveness; (iii) some of the goods covered by the application are similar to an average degree, whereas other goods are dissimilar; and (iv) the conflicting signs were similar to a low degree visually and aurally, and they could not be compared conceptually.

GC APPEAL

Pet King subsequently appealed the contested decision to the General Court (GC).

Pet King challenged the BoA's findings concerning the dissimilarity between the goods “medicated ear drops for domestic animals” and “preparations for destroying vermin; the aforesaid goods not including ear drops for animals”. Considering the criteria laid down in Canon (C-39/97), the GC held that these goods have the same purpose, namely goods designed to destroy parasitic worms or insects, including those in domestic animals. Furthermore, while the application expressly excludes “ear drops for animals”, as it still covered similar goods used for a similar purpose, the GC held that the specification restriction was of little importance. As such, the GC concluded that these goods must be regarded as having a high degree of similarity.

As a result, the GC partially upheld the appeal and dismissed the contested decision from the BoA in respect of the similar class 5 goods.

KEY POINTS

- Following Canon, the relevant factors to consider when assessing the similarity of goods and services include their nature and intended purpose

- Removing the precise goods/services covered by an earlier registration will not necessarily avoid confusion if the remaining goods/services are considered similar



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It's not too early to book your place at our forthcoming Christmas gatherings. See citma.org.uk for details →



Events

More details can be found at citma.org.uk

DATE	EVENT	LOCATION	CPD HOURS
5th September	CITMA Lecture – Scotland Evidence before UK IPO and EUIPO matters	Murgitroyd & Company, Glasgow G5	1
6th September	CITMA Paralegal Seminar Ownership	Wedlake Bell, London EC4	3
24th September	CITMA Lecture – London* Evidence in registry proceedings	Carpmaels & Ransford, London WC1	1
10th October	CITMA Quiz – Leeds	The Lamb and Flag, Leeds LS2	
17th October	CITMA Autumn Conference – Birmingham* Seizing opportunities in a time of change	The ICC, Birmingham B1	5
12th November	CITMA Paralegal Webinar* The Chinese “super trade mark”	Log in online	1
14th November	CITMA Webinar* UK case law update	Log in online	1
14th November	CITMA Lecture – Scotland IP case law update	Brodies LLP, Edinburgh EH3	1
26th November	CITMA Lecture – London* Fashion and IP	Allen & Overy LLP, London E1	1
28th November	CITMA Lecture – Leeds Are the UK and EU IPOs ready for non-traditional trade marks?	Womble Bond Dickinson, Leeds LS1	1
3rd December	CITMA Webinar* Introduction to patents	Log in online	1
6th December	CITMA Northern Christmas Lunch**	Leeds	
13th December	CITMA London Christmas Lunch***	London Hilton 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 for event topics. Please contact Jane at jane@citma.org.uk with your ideas.

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Q&A

Katherine Van Deusen Hely

Recalls an inspiring relative

I work as... the founding partner at Caribbean IP.

Before this role, I was... a scientist. I was in a PhD programme in cancer biology for several years before changing track.

My current state of mind is... excited. We have been making our travel and conference plans for the next year, and that always revitalises my enthusiasm for my job.

I became interested in IP when... my cousin suggested I go to law school and join his practice. He was a very compelling guy – and it didn't take much to convince me to pursue a career focused on the Caribbean. It was the best decision I've ever made.

I am most inspired by... my great-grandmother, Abby Crawford Milton, who was instrumental in the women's suffrage movement in Tennessee. She was also a lawyer and a poet and lived to be 110. We named our daughter Crawford in her honour.

In my role, I most enjoy... the flexibility and independence of owning my own firm.

In my role, I most dislike... the business side of running a law firm. I leave a lot of that to my partner, Patrick.

On my desk is... a photo calendar heavily featuring my daughter and loads of Post-It notes.

My favourite mug says... Eugene Dupuch Law School. That's where I worked on my Legal Education Certificate in the Bahamas.



“

It didn't take much to convince me to pursue a career focused on the Caribbean

My favourite place to visit on business is... New York or London, because I love the energy and the chance to walk as much as possible between client visits.

If I were a brand, I would be... Margaritaville. I can't say no to a good margarita!

The biggest challenge for IP... at least in the Caribbean region, is the modernisation of the laws and local practice.

The talent I wish I had is... the ability to sing in key.

I can't live without... a regular workout. I get antsy when I don't have the opportunity to do something active.

My ideal day would include... exploring a charming town in southern France (as I did during my honeymoon), visiting tiny vineyards, and ending with a lovely, relaxed meal.

In my pocket is... nothing. I am pocketless today!

The best piece of advice I've been given is... to embrace your own personality when it comes to marketing and business development. Over the years, I've tried to channel my strengths rather than doing what other people are doing.

When I want to relax, I... go for a pedicure or massage.

In the next five years, I hope to... learn more Spanish. I've been saying I'd do it for a long time.

The best thing about being a member of CITMA is... the resources that it provides. I look forward to receiving my hard copy of the *Review* (especially in the age of everything digital) and learning what's new in the practice.



Dream getaway:
the vineyards
of France

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