

D YOUNG & CO TRADE MARK NEWSLETTER *no.127*

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VETEMENTS v VTMNS

A flagrant attempt to
misappropriate a brand...
and the cat walk

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March for D Young & Co is typically a busy month for client and associate visits, events and conferences. This year is no exception and already last week we had the opportunity to attend the MARQUES Spring Meeting in Frankfurt, Germany, moderating interesting discussions about trade marks filed in bad faith, contrary to public policy, or accepted principles of morality, as well as the latest EU case law. Looking ahead, we look forward to meeting with readers of this newsletter who plan to attend the CITMA Spring Conference in London, UK, on 16 March 2023, or the INTA Annual Meeting in Singapore in May 2023.

Also, we are delighted to have recently received a top tier ranking for our UK trade mark services by the World Trade Mark Review (WTR) 1000 as well our German team being ranked “bronze” for the first time. Our Munich office goes from strength to strength and also kept its good Legal 500 ranking. This is an exceptional accolade as we approach our seven year anniversary, having opened our Munich office in 2016.

Jana Bogatz
Partner, Rechtsanwältin

Events



CITMA Spring Conference London, UK, 16 March 2023

Jennifer Heath, Olivia Oxton, Rachel Pellatt and Abigail Macklin will be attending the conference. Partner Jana Bogatz will be presenting an EU case law update.

INTA 2023 Annual Meeting Singapore, 16-20 May 2023

Members of our trade mark team will be attending INTA 2023 in Singapore.

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Bad faith

VETEMENTS v VTMNS

A flagrant attempt to misappropriate a brand... and the cat walk

This transnational bad faith case concerned an attempt to legitimise infringing use in China, in proceedings before the UKIPO.

Background

VETEMENTS GROUP AG (VETEMENTS) is a Swiss based high-end contemporary fashion brand founded in 2014. VTMNS GROUP LIMITED (VTMNS) is a shell company created in the UK to legitimise the infringing use of VETEMENTS GROUP AG's brand in Asia.

VTMNS filed oppositions against five UK applications filed by VETEMENTS.

VETEMENTS filed oppositions against four UK applications filed by VTMNS. It also filed an invalidity application against VTMNS' UK registration.

All the contested trade marks comprised, or contained, the word “vetements”.

Pleadings

VETEMENTS and VTMNS both claimed that a likelihood of confusion would exist given the identity and/or similarity of the marks and similarity of the goods and services in contention. VETEMENTS further argued bad faith, identity, reputation, and passing off. It claimed:

1. VTMNS's applications were instruments of fraud, filed simply to enable VTMNS to authorise a Chinese entity to use the VETEMENTS mark in China without its consent;
2. the contested marks were identical to its earlier VETEMENTS marks, and sought protection for identical goods;
3. through investment and promotion its marks had developed a substantial reputation in the industry, such that the name “VETEMENTS” was associated with trusted, high-quality, and luxury goods and services. Consequently, use of the contested marks by VTMNS would take unfair advantage of the distinctive character

and reputation of its marks, in addition to causing detriment due to the potential poor quality of goods offered by VTMNS; and

4. it possessed goodwill in the sign “VETEMENTS” in relation to clothing, footwear and accessories, such that use of the contested marks by VTMNS would amount to passing off.

VETEMENTS' pleadings in relation to bad faith were key to these proceedings. A successful finding would result in its actions succeeding in their entirety, and VTMNS' own oppositions then falling away. Therefore, it was incumbent on VETEMENTS to submit corroborative evidence with a clear chronology of events, demonstrating use of its own marks in conjunction with VTMNS' unauthorised use.

Both parties filed evidence and written submissions in support of their positions.

VETEMENTS sought permission to file additional evidence or cross examine VTMNS' witness on the grounds that VTMNS' defence contained inconsistencies and falsified documents.

VETEMENTS' request for cross-examination was refused, however it was granted leave to file additional evidence addressing these points.

Bad faith

VETEMENTS' evidence set out the history of the VETEMENTS brand, establishing that it was launched in 2014 by a collective of well-known and regarded fashion designers, in the EU. VETEMENTS' UK specific evidence comprised a multitude of third party commentaries, advertising

and marketing expenditure, turnover figures, certified retailers of its products, details of its own outlets, and some of its more prominent campaigns.

To provide a narrative of VTMNS' conduct, and to corroborate its assertions of bad faith, VETEMENTS evidenced its use of the VETEMENTS brand in Asia, and argued VTMNS' directors were individuals based in China who had used the VETEMENTS brand without authorisation or consent in China, and VTMNS' applications to register the brand in the UK were motivated by a need to legitimise its Chinese operation. VETEMENTS' evidence established that:

- In 2017 a Chinese company named Xiamen Vetements Brand Management (Xiamen) filed applications for various marks containing or comprising the word "VETEMENTS". Xiamen also began producing and selling goods heavily inspired by VETEMENTS GROUP AG's collections.
- In 2019 Xiamen opened retail outlets in China and Asia, featuring the mark "VETEMENTS".
- Distributors and mall owners sought confirmation that Xiamen was the legal owner and/or approved distributor of VETEMENTS goods in China.
- In 2019 Xiamen created VTMNS GROUP LIMITED in the UK in an attempt to falsify a legitimate relationship with VETEMENTS GROUP AG.
- Xiamen and VTMNS GROUP LIMITED were economically linked.
- Xiamen produced copy-cat products branded without authorisation as VETEMENTS.
- VTMNS GROUP LIMITED had issued declarations authorising Chinese companies to sell VETEMENTS branded products.
- VETEMENTS GROUP AG's use of the "VETEMENTS" marks outside of China predated VTMNS GROUP LIMITED's use, supporting its allegation of plagiarism.

Accordingly, VETEMENTS alleged that VTMNS was part of a commercial operation, whereby its brand was knowingly taken and used in China in a calculated misrepresentation to deliberately take business away from VETEMENTS and preventing it from entering the Chinese market or expanding its business in China. Moreover, the applications filed in the UK by VTMNS GROUP LIMITED were made with a view to providing legitimate documents demonstrating ownership of the trade mark VETEMENTS, for the purpose of misappropriating the same mark in China.

VTMNS argued that it conceived the brand in 2013 and attempted to add credibility to its claim by stating that the brand was derived from the Chinese phrase "Wei Te Meng" meaning "unique, special, positive". VTMNS asserted it began using the VETEMENTS brand in China in 2016, and included undated images of its launch event, commercial posters, retail outlets it owned, and third party coverage of its collection. VTMNS stated that it filed applications for VETEMENTS in the UK to protect its position in exploiting the mark in the UK.

The hearing officer held that VETEMENTS' evidence was sufficient to establish that the alleged facts had occurred, and that VTMNS' conduct in the UK amounted to bad faith. VTMNS' evidence was inconsistent and contradictory. It was unable to explain how it devised the brand independently, nor prove use dating back to 2013. The hearing officer did not accept, given the distinctive nature of VETEMENTS' mark, that VTMNS use of an identical mark on identical goods was mere coincidence.

Accordingly, VETEMENTS' oppositions and invalidity application succeeded in their entirety, and VTMNS' oppositions fell away.

In answer to a claim by VETEMENTS that the hearing officer consider all grounds claimed, the hearing officer continued.

Reputation

The hearing officer found that the reputation of VETEMENTS in combination with its

distinctive nature would result in the relevant public making a mental link between the parties, even when different goods and services were involved. VETEMENTS' claims were therefore successful in their entirety.

Identity and confusion

VETEMENTS was only partially successful with respect to its oppositions under these grounds, as the hearing officer noted that some degree of similarity of goods and services was essential. In relation to goods found to be similar, she concluded that direct confusion would manifest.

Passing off

The hearing officer's decision was brief, noting that whilst the test for misrepresentation is different to that for a likelihood of confusion, in this case it was doubtful whether the difference between the legal tests would produce a different outcome. Though it was accepted that VETEMENTS had moderate reputation in relation to some goods, its claims under passing off would not provide a better outcome with respect to dissimilar goods simply because those goods were different to those for which VETEMENTS had goodwill.

Author:

Rachel Pellatt



In short

These proceedings emphasise the importance of submitting corroborative and substantive evidence, with a clear narrative and chronology of events when alleging bad faith, even if such evidence is outside of the jurisdiction in question.

It is also important to scrutinise evidence for inconsistencies or contradictions and, address the same by rebuttal or cross-examination if it is of material importance to your case – guide the hearing officer!

UKIPO practice changes

Important cost and process changes now in effect

So far in 2023 the UKIPO has issued two practice notices regarding changes to tribunal practice for trade marks, patents, and design rights. The notices involve:

1. A change in practice to costs in patents, trademark and design proceedings.
2. A change in practice in the registrar's service of documents in trademark and registered design *inter partes* proceedings.

Increases in the scale of costs to be awarded in UKIPO proceedings

General practice at the UKIPO is that costs are determined by reference to a scale, with an underlying "contribution-not-compensation" approach. This provides transparency to parties about potential costs liabilities.

In January 2023 the UKIPO announced a new scale with increased costs applying to trademark, patent and design proceedings commenced on or after 01 February 2023. The new scale can be found at Annex A of Tribunal Practice Note 1/2023.

Notably, in some circumstances the scale will not apply, for example:

1. Unreasonable behaviour

The UKIPO has the discretion to award costs "off the scale" to deal proportionately with unreasonable behaviour. Generally, the amount will be commensurate to the additional expenditure a party has incurred as a result. Examples of unreasonable behaviour include unreasonably rejecting efforts to settle a dispute before an action was launched.

2. Unrepresented parties

Generally, unrepresented parties incur lower costs because they do not pay legal fees. If the scale of costs were applied to unrepresented parties they may receive

costs in excess of what they reasonably incurred, undermining the "contribution-not-compensation" approach. Consequently, at the end of proceedings unrepresented parties are sent a proforma. If an award is to be made in favour of an unrepresented party hearing officers will consider the proforma when determining the sum to be awarded.

Related article

For further details, and guidance on costs in specific scenarios, please refer to our article "Increases on the scale of costs to be awarded in UKIPO proceedings", published 09 February 2023: dycip.com/IncreasesscalecostsUKIPO.

Requirement for UK address for service

With immediate effect, in relation to certain intellectual property rights, the UKIPO will seek to obtain a UK address for service (AFS) before any formal serving of documents. Failure to comply may result in a loss of rights.

The notice will most commonly affect international registrations for trade marks and designs that designate the UK, where the World Intellectual Property Organisation (WIPO) representative is based outside the UK. The new practice impacts *inter partes* proceedings and differs depending on the nature of the proceedings:

Invalidation, revocation and rectification proceedings against trade marks, and invalidation proceedings against designs

- On receipt of an application to invalidate, revoke or rectify a trade mark, or to invalidate a design registration without a UK address for service, the UKIPO will direct the registered proprietor to provide a UK address for service within one month
- The request will be sent by post. In light of recent overseas mailing delays this may leave little or no time for the registered proprietor to respond.
- Failure to provide a UK address for service may be construed as the registered

Useful links

- [Tribunal Practice Note 1/2023: dycip.com/TribunalPracticeNotice12023](https://dycip.com/TribunalPracticeNotice12023)
- [Increases on the scale of costs to be awarded in UKIPO proceedings: dycip.com/IncreasesscalecostsUKIPO](https://dycip.com/IncreasesscalecostsUKIPO)
- [UKIPO confirms requirement for UK address for service with immediate effect: dycip.com/UKIPOaddressforservice](https://dycip.com/UKIPOaddressforservice)

proprietor not opposing the application, and may result in the registration being declared invalid, revoked or rectified.

Trade mark oppositions against international registrations designating the UK without an address for service

- On receipt of a notice of opposition against an international registration designating the UK, WIPO will communicate the notice of provisional refusal to the holder.
- This transmission by WIPO constitutes effective service of the opposition.
- At the same time, the UKIPO will direct the holder, using its non-UK address, to provide a TM8 and counterstatement within two months, as well as a valid UK address for service.
- At this point, the holder need only submit a completed TM8 and counterstatement.
- If the holder fails to provide a UK address for service the UKIPO will issue a second direction by post and email, and ask that a valid UK address for service be provided within one month.
- Failure to provide a UK address for service within one month will result in the UK designation being deemed withdrawn.

There is real merit to, and arguably some urgency in, listing a UK firm as representative against international registrations designating the UK. To avoid any potential loss of rights we strongly recommend listing a UK firm against any UK designation from the outset.

Related article

For further information and a list of Q&As in relation to the address for service requirement, please refer to article "UKIPO confirms requirement for UK address for service with immediate effect" published 01 February 2023: dycip.com/UKIPOaddressforservice.

Author:
Sophie Rann



Aromatic botanicals

The pitfalls of choosing a company name

In the United Kingdom, as is the case elsewhere around the world, business owners are reminded to ensure that any new name they choose for their company should not infringe trade marks owned by third parties.

It is also important that one's name is not so close to an earlier registered company name that its use would be likely to mislead consumers

This issue arose in a case before the High Court and involved a dispute before the Company Names Tribunal in the UK. One party complained about another party's registration of a company name which it deemed was too similar to its own. The other party alleged that the complainant did not have goodwill in its name, a basis for lodging a valid objection.

This case considered the correct date on which the claimant's goodwill should be assessed.

Facts

In November 2019 the name Botanica Agriculture and Extraction Ltd was adopted by the claimant, which then complained about the incorporation of a new business, Botanica Ltd, in April 2020. It alleged the name was substantially similar and, further, that it had acquired goodwill in the name Botanica.

Company Names Tribunal decision

In September 2020 Botanica Agriculture and Extraction Ltd applied to the Company Names Tribunal for an order requiring Botanica Ltd to change its name.

The Companies Names Tribunal considered the relevant date for determining whether the applicant had acquired goodwill in its name. Is it:

1. when the later company is registered, in this case in April 2020; or
2. when the complainant lodges its complaint?

This case concerns the potential pitfalls of choosing the "Botanica" company name



The Company Names Tribunal held that it was the former, and that in April 2020, a mere five months after adopting the name itself, the complainant had not established or shown that it had generated sufficient goodwill in the name Botanica.

The appeal

The complainant appealed to the High Court, which concluded that the correct time for determining whether goodwill had been acquired was, in fact, the date on which the Company Names Tribunal complaint was lodged, in this case, five months later.

The High Court did not reverse the Company Names Tribunal's decision. Instead, it ordered the Company Names Tribunal to consider the matter again.

What are the takeaway points?

First, the High Court decision was not in fact surprising given that the Company Names Tribunal had previously held **that the correct date for showing goodwill is the date of the filing of the complaint**. In this particular case, the Company Names Tribunal had simply not followed its previous decisions.

Second, and more relevant for claimants, it is important to **ensure that sufficient**

evidence is shown that goodwill has been generated as at the date of the challenge.

Third, and finally, an important point to remember is that if the defendant can show that continued use of the challenged name would not be likely to mislead, then, notwithstanding the complainant's goodwill, it is likely the complaint will fail. When submitting evidence as the claimant it is important to be wary of any response from the defendant in which it states that it is trading, as this can lead to the application being struck out. In such a case, a request for a hearing can still be made.

The Company Names Tribunal deals only with complaints where a company name is registered for the primary purpose of preventing someone else with legitimate interest from registering it, or demanding payment from them to release it. This is a narrow remit – it is not a substitute for a trade mark infringement or passing off action. For example, the International Business Machines Corporation (IBM) failed in a complaint against the Indian Institute of Business Management (IIBM), despite the names being held to be similar.

Author:

Jeremy Pennant



M&S v Aldi

IPEC finds Aldi gin bottle infringes M&S bottle design

Case details at a glance

Jurisdiction: England & Wales

Decision level: IPEC

Parties: Marks and Spencer PLC v Aldi Store Ltd

Citation: [2023] EWHC 178 (IPEC)

Date: 31 January 2023

Decision: dycip.com/marksandspencervaldi

Marks & Spencer (M&S) has succeeded in a battle with Aldi over copycat gin bottles, successfully enforcing several UK registered designs against Aldi in a decision that should provide some welcome reassurance for designers seeking to use registered designs to protect their products. The gin bottles in question were Christmas-themed, and implemented gold leaf-like contents.

Earlier iterations of these Christmas-themed gin bottles had been sold by M&S since September 2019. These iterations included the “Snow Globe” iteration (see below), which turned out to be prior art for all of the UK design registrations in question.



Moving into 2020, these earlier iterations were then modified by M&S with the addition of lights inside the bottle, and with revisions to the Christmas-themed illustrations used as part of the bottle.

The supermarket first registered the updated bottle designs in December 2020, which included two versions resulting in UK design registrations 6134278 and 6134280, where the integrated light feature was not apparent (see below).



Along with two further versions which resulted in design registrations UK 6134282 and UK 6134284, where the integrated light feature was additionally shown (see above right).



In November 2021 Aldi began selling gin containing gold flakes in a light-up bottle, as part of its “Infusionist” range. The bottles appeared as shown below:



M&S alleged that the advertising and sale of these bottles infringed its UK registered designs. There was no counterclaim of invalidity from Aldi.

M&S argued that there were clear similarities between the sets of designs. One of the similar features identified between the two sets of designs was the identical shapes of the bottles, bearing in mind a number of different bottle shapes could otherwise have been used. Other similar elements included the identical shape of the bottles’ stoppers, the winter scene encompassing tree silhouettes, a snow effect and an integrated light.

Conversely, Aldi had pointed to differences such as the brightness of the winter scene, the lack of a stag and doe in the scene depicted on the Aldi bottle, the existence of the branding “Infusionist” and the differences between the stoppers.

His Honour Judge Hacon said that both sets of bottles were used at home, as opposed to being used at two different points of purchase; hence, there would be a potential direct comparison.

Judge Hacon said the word “Infusionist” (which may or may not be a trade mark,

it was not stated) was clear enough to make an impression and had a presence and a difference from the registered designs. He further commented “I did not understand it to be in dispute that Aldi’s bottle has a “botanics” shape which is either identical to that of the RDs [registered designs] in suit or so close that it is hard to see any real difference”.

Judge Hacon found that with the design corpus in mind, the similarities between the two sets of designs would appear significant to the informed user and cumulatively they would be striking. Stressing the statutory test, (whether the registered M&S designs and the Aldi bottles produce a different overall impression) Judge Hacon concluded that they did not because of the features they had in common. The differences mentioned by Aldi were considered to represent minor (and insufficient) alterations. Registered design infringement was therefore established in respect of all four of the UK design registrations.

Author:
Richard Burton



In short

This decision may provide welcome reassurance for designers seeking to use registered designs to protect their products but it remains to be seen whether we have heard the last of the tale.

Press reports suggest that Aldi intends to appeal the decision. One potential avenue for appeal might well include the extent to which the “Snow Globe” prior art should have been determinative/further limiting on the scope of the UK design registrations.

Not always-so-easyGroup easyGroup successful in infringement action but trade marks partially revoked

Case details at a glance

Jurisdiction: UK

Decision level: High Court

Parties: Easygroup Limited v Easy Live

(Services) Limited, Achilleas Pavlou

Achilleous, Jonathan Richard Dean Burnside

Citation: [2022] EWHC 3327 (Ch)

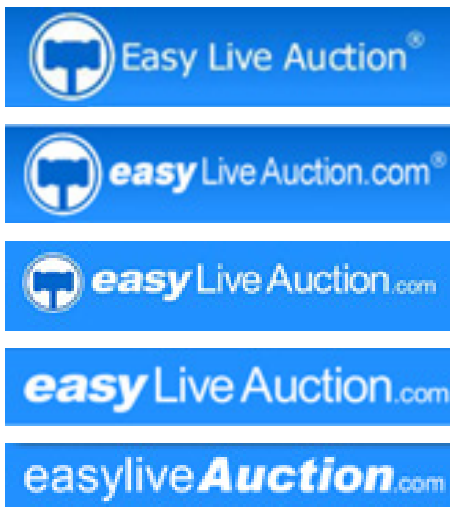
Date: 21 December 2022

Decision: dycip.com/easygroup/td

EasyGroup's infringement proceedings against Easy Live Services Ltd, although successful, have led to the partial revocation of certain easyGroup marks on the basis of non-use.

Background

Easy Live Services Ltd (ELA) develop and market software and other services for use in online auctions. In the course of its business ELA has used a variety of "Easy Live Auction" signs (shown below) and own a trade mark registration for EASY LIVE AUCTION.



easyGroup brought a claim against ELA and its two directors for infringement of its registered marks, including: easyJet, easyGroup, easyMoney, easyProperty and Easy Network.

First, easyGroup alleged that the ELA signs created a likelihood of confusion with its own marks, and so were an infringement of s.10(2) of the Trade Marks Act 1994.

Second, easyGroup alleged under s.10(3) of the Trade Marks Act that the signs ELA used took unfair advantage of, and were detrimental to, the reputation of the easyGroup marks. easyGroup also sought revocation of ELA's registered mark.

ELA denied these allegations and counterclaimed for revocation of several services for which the easyGroup,

This case concerns ELA's services relating to online auctions



easyMoney, easyProperty and Easy Network marks were registered.

Decision

The ruling judge, Sir Antony Mann, found that the visual, oral and conceptual similarities between the ELA signs and easyGroup marks varied from very low to moderate, but that the services at issue were not similar. Hence, the s.10(2) claim failed.

Furthermore, it was found that only the easyJet, Easy Network and easyMoney marks had a reputation for the purposes of s.10(3). Of these, only the Easy Network mark was considered to have been adversely affected by ELA's signs, and so was the only mark in which the s.10(3) claim succeeded.

Whilst goodwill in the easyGroup marks and misrepresentation in relation to two of the ELA signs were established, the claim in passing off failed on the basis of there being no likelihood of damage being suffered by easyGroup.

Date of assessment

One of the key disputes related to the date of assessment for establishing infringement. EasyGroup sought to rely on *Walton International v Verwij Fashion*, taking the relevant start date as being that of first use of the sign, and if that is outside the six-year limitation period, then the first date within the limitation period should be used.

However, in this case, Sir Antony Mann departed from *Walton International v Verwij Fashion* and agreed with ELA that the proper date of assessment is the date of first

use of the infringing sign. This date would only change if there was subsequent use of the sign in a materially different form.

Revocation

ELA argued that the easyGroup marks relied on were not put to genuine use in respect of certain of the relevant services for which they were registered, and counterclaimed for partial revocation of the easyGroup marks.

The court concluded that ELA's counterclaim for revocation should succeed as easyGroup had failed to produce sufficient evidence showing its use. The only exception to this was "Data communications services" registered under the EasyNetwork mark.

The judge decided not to rule in relation to easyGroup's claim for revocation of ELA's mark, but in light of his earlier decisions, he was sceptical that this would survive.

Author:

Laurie Ford



In short

While easyGroup was successful in the claim as a whole, this decision serves as a reminder that trade mark registrations may be cut back if the owner cannot show genuine use of the same for all the services for which the marks are registered.

D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

D Young & Co news

WTR 1000 2023

“An exceptional one-stop shop for all trademark prosecution matters”

“An exceptional one-stop shop for all trademark prosecution matters...with plenty of clients benefiting from the team's pan-European offering.”



D YOUNG & CO
INTELLECTUAL
PROPERTY

Ranked in: UK: England

We are celebrating nine trade mark partners from our offices in the UK and Germany who feature in the World Trademark Review 1000 (WTR 1000) this year, which ranks the firm as “gold” for UK trade mark prosecution and strategy, “silver” for UK trade mark enforcement and litigation and “bronze” for our German trade mark work. We are delighted to be ranked in WTR 1000 Germany for the first time since opening our Munich office in 2016.

WTR writes that “[D Young & Co] has continued to flourish since Brexit and now

manages over 25,000 UK registrations and cloned rights. The close collaboration with its German office has been essential in its recent successes, with plenty of clients benefiting from the team's pan-European offering”.

In addition to the trade mark team's excellent rankings, all individual partners in the team also feature as “recommended experts” in the 2023 survey.

We are grateful to receive such positive feedback from our clients and colleagues and would like to thank those who participated in the directory research process.

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