

# D YOUNG & CO TRADE MARK NEWSLETTER *no.98*

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Welcome to our May newsletter. A reminder that partners from our team will be attending INTA this month. Do get in touch if you would like to arrange a meeting.

We are pleased to share the news that Trade Mark Attorney Richard Burton and Solicitor Anna Reid have been appointed Partners, and Wendy Oliver-Grey is now an Associate Trade Mark Attorney. Our congratulations to Richard, Anna and Wendy.

[The D Young & Co trade mark team, May 2018](#)

Events



19-23 May 2018

**INTA Annual Meeting, Seattle, US**

The D Young & Co trade mark team will be joining trade mark and brand professionals from around the world at the 140th Annual Meeting of the International Trademark Association in May 2018. Partners Jeremy Pennant, Jackie Johnson, Helen Cawley, Matthew Dick, Gemma Kirkland, Tamsin Holman, Richard Burton and Anna Reid will be attending the conference. Please contact us if you would like to arrange a meeting during the conference.

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IP & Brexit

IP & Brexit  
Draft agreement on UK withdrawal

**O**n 19 March 2018 a draft agreement for the withdrawal of the UK from the European Union (EU) was published.

Provisions relating to intellectual property are contained primarily within Articles 50-57 (inclusive) and are summarised below.

In short, the draft provisions relating to unitary EU intellectual property rights following Brexit reflect, for the most part, the ‘common sense’ and logical approach advocated by rights holders and practitioners since the 2016 Referendum, and will assuage concerns of a ‘Brexit Day cliff face’ as regards trade marks and designs.

The transition period will last till December 2020, during which time nothing will change as regards European Union Trade Marks (EUTMs) and designs being valid in the UK. This appears, based on first impressions, to be a sensible and reasonable time frame to enable IP owners and other stakeholders to prepare for Brexit and to ensure that unitary IP portfolios remain robust and enforceable across both the UK and the remaining 27 member states.

Rights of representation before the EUIPO have been discussed in certain quarters, with concerns being raised that some UK practitioners may be unable to act before that Registry post-Brexit. This will not affect D Young & Co, who will be able to handle EU trade mark and design work before, during and after the Brexit process.

With the opening of our Munich office before the Brexit Referendum, we continue to be in a strong position to assist clients with intellectual property

work across the UK and Europe, as well as before the EUIPO and other bodies.

**Draft agreement - IP provisions**

A more detailed summary of the draft withdrawal agreement (focusing on the IP provisions) is set out below:

- The draft Agreement is just that: it is not yet finalised, with terms being conditional pending a final agreement (likely to be later in 2018).
- A transition period has been agreed in principle to run from the date the UK officially leaves the EU (currently 29 March 2019) until December 2020, during which time EU law will still apply in the UK (that is, the law relating to EUTMs and registered EU designs will be unaffected and such rights will continue to cover the UK).
- Any EUTM or design validly registered at the end of the transition period will continue to be protected by an equivalent UK-specific right afterwards. Filing, priority and seniority dates will be maintained, and the first renewal of the UK-specific right will be the same as the EUTM or design (which will continue to cover the remaining 27 member states of the EU).
- The precise mechanics of how this will work (for example, whether there will be a fee) have not yet been finalised.
- If an EUTM or design is declared revoked or invalid following an attack that was pending at the end of the transition period, the corresponding UK-specific right will suffer the same fate, unless the grounds for invalidity or revocation do not apply in the UK (for example, a mark could be deemed descriptive in Latvia and other countries, but not in the UK).
- A resulting UK-specific right will not be revocable for non-use on the basis that the parent EUTM had not been put to genuine use in the UK before the end of the transition period. It will be for the UK government to decide how much longer after the transition period an owner has to commence use in the UK.

The draft agreement for the withdrawal of the UK from the EU was published in March 2018



before the end of the transition period will continue to be valid and enforceable within the UK on identical terms for the remaining period of validity of the database right (fifteen years), provided that the holder of the right continues to comply with the qualification requirements, namely those who are nationals or have habitual residence in the EU or UK, or undertakings established in the EU or UK.

- The jurisdiction provisions of the EUTM Regulation and Designs Regulation shall continue to apply to proceedings commenced prior to the end of the transition period, thereby allowing for the possibility of the UK courts to grant relief extending to countries of the EU, and for the EU courts to grant relief extending to the UK.

**Authors:**

**Matthew Dick & Tamsin Holman**



- EUTMs deemed to enjoy a reputation in the EU will be able to enforce equivalent rights in the UK in respect of the equivalent UK-specific mark as they exist at the end of the transition period, but thereafter will have to be based on use within the UK.
- EU designations of international trade marks or designs filed at WIPO under the Madrid or Hague systems will similarly continue to have effect in the UK (details to be confirmed by the UK government in due course).
- Any unregistered EU design right that arises before the end of the transition period will continue to be valid within the UK on identical terms for the remaining period of validity of the unregistered EU design (which is only three years in any event). It is to be hoped that the UK Government will amend current UK unregistered design law so that it provides equivalent coverage to EU unregistered design law – there are currently major differences (for example, 2D logos

cannot be protected under current UK unregistered design law, but can be under EU unregistered design law).

- Pending EUTMs or designs that have been granted a filing date by the end of the transition period will enjoy a priority period of nine months (not the usual six) from the end of the transition period within which their owners can file an equivalent trade mark/design in the UK and enjoy the same filing/priority date as the parent EUTM.
- Rights exhausted both in the EU and UK under EU law before the end of the transition period will remain exhausted both in the EU and UK thereafter. After the transition period any provisions relating to exhaustion of rights will likely depend on what trade deal is reached between the EU and UK, and also whether or not the UK government decides to recognise, for example, the principle of international (or UK-only) exhaustion of rights.
- Any unique database rights that arise

**.eu domain names**

Please see page 04 of this newsletter for important information regarding .eu domain names and Brexit.

**IP & Brexit latest news**

To keep up to date about what is new and important for Brexit and IP rights, including patents, supplementary patent certificates and the unitary patent and Unified Patent Court, please bookmark our IP & Brexit website pages:

[www.dyoung.com/knowledgebank/ip-brexit](http://www.dyoung.com/knowledgebank/ip-brexit).



# IP & Brexit

## .eu domain names

**W**ith the withdrawal of the UK from the European Union (EU) scheduled to take place on 30 March 2019 at 00:00h (CET), owners of .eu domain names who are based in the UK should take note of the European Commission's "Notice to Stakeholders" published on 28 March 2018.

In brief, all EU regulatory frameworks for the .eu top level domain (TLD) will no longer apply to the UK as of 31 March 2019.

As a result, UK-based proprietors of .eu domain names are likely to be impacted in the following manner:

### 1. Registration and renewal of .eu domain names

Any natural person who resides in the UK, or any undertaking / organisation established in the UK but not also in an EU country will no longer be eligible to:

- register .EU domain names; or
- renew .EU domain names.

### 2. Revocation of .eu registered domain names

As of 31 March 2019, the registry for .eu domain names will be entitled to revoke, on its own initiative and without submitting the dispute to any extra judicial settlement of conflicts, all domain names where the registered proprietors do not reside, or are not established, within the EU.

### 3. Third party challenge of speculative and abusive registrations

Save for the exception of 'well known marks' (as defined under Article 6bis of the Paris Convention), IP rights holders will no longer be able to rely on their UK registered or unregistered rights when seeking to challenge .eu domain names that are subject of speculative and abusive registration.

### Important changes for UK-based proprietors of .eu domain names



### 4. Applicable law

The European Commission have advised that all agreements between accredited .eu registrars and .eu registrants, that designate the UK as the governing law, should be amended so as to designate (as applicable law) the law of an EU member state (as of 31 March 2019).

As a result, proprietors of .eu domain names who are based in the UK are strongly advised to review their domain name strategy and take necessary steps to avoid any negative impact to their .eu domain name portfolio.

By way of example, domain name holders may want to consider assigning ownership of their .eu domain names (registered in the name of a UK based individual / entity) to an EU based individual / entity.

### European Commission notice to stakeholders

You can download a PDF copy of the European Commission's "Notice to stakeholders: withdrawal of the United Kingdom and EU rules on .eu domain names", published 27 March, via its website here: [dycip.com/EC-eudomains](http://dycip.com/EC-eudomains).

### European Commission .eu domain policy

The European Commission policy regarding the top-level domain .eu can be viewed via its website here: [dycip.com/EC-eudomain-policy](http://dycip.com/EC-eudomain-policy)

### IP & Brexit: draft agreement on UK withdrawal

On 19 March 2018 a draft agreement for the withdrawal of the UK from the European Union (EU) was published. Provisions relating to intellectual property are contained primarily within Articles 50-57 (inclusive) and are summarised in our online article "IP & Brexit: the draft agreement on UK withdrawal": [dycip.com/ip-brexit-withdrawal](http://dycip.com/ip-brexit-withdrawal).

### Author:

Alban Radivojevic



### IP & Brexit latest news

To keep up to date about what is new and important for Brexit and IP rights, including patents, supplementary patent certificates and the unitary patent and Unified Patent Court, please bookmark our IP & Brexit website pages: [www.dyoung.com/knowledgebank/ip-brexit](http://www.dyoung.com/knowledgebank/ip-brexit).

# Cut in protection Leading chainsaw manufacturer loses right to colour mark

**A** recent Board of Appeal decision confirms, despite change in ‘graphic representation’ requirements under EUTMR, Sieckmann criteria remains in play.

This case concerns Andreas Stihl AG & Co. KG (Stihl), a leading German chainsaw manufacturer since as early as 1971, and Giro Travel Company (Giro), a Romanian importer of chainsaws.

## Background

In 2008 Stihl applied for a colour mark (shown below) covering class 7 “chain saws”.



The mark claimed the colours orange and grey and included the description “The colour orange is applied to the top of the housing of the chainsaw and the colour grey is applied to the bottom of the housing of the chainsaw”. In 2011 the mark was successfully registered on the basis of acquired distinctiveness through use.

In 2014 Giro imported around 2,000 counterfeit chainsaws into Romania with similar characteristics and colour scheme to that used by Stihl. Stihl launched a civil law suit against Giro in Romania claiming infringement of its EUTM registration.

In response to the infringement action Giro challenged the validity of Stihl’s EUTM on the basis of Article 7(1)(a), (b) and (d), concerning the representation of the mark, lack of distinctive character and the sign was customary in the trade, along with a claim under bad faith.

The Cancellation Division rejected the invalidity action finding the graphic representation in conjunction with the verbal description enabled a systematic arrangement to be identified in which colours are used in a predetermined and uniform way. It was found despite the colour mark

being shown used in conjunction with the word mark “STIHL”, following the findings in “Have a break” (C-353/03) this use did not exclude the colour mark acquiring distinctive character. The Cancellation Division dismissed Giro’s action in its entirety and Giro appealed to the Board of Appeal.

## Board of Appeal decision

The decision focused on the graphic representation claims. The Board of Appeal set out that it is apparent from Article 4 and case law that graphic representation must enable the sign to be represented visually, particularly by means of images, lines or characters, so that it can be precisely identified. It was also stated that the acquired distinctiveness of a sign was not able to override the requirements set out in Article 4.

The Board of Appeal referred to previous CJEU findings in the Heidelberg case (C-49/02) which set out requirements where a sign consisted of a combination of two or more colours. In such instances the colours must be presented in a specific arrangement or layout, associating the colours in a predetermined and uniform way to prevent numerous different combinations of those colours.

When considering the representation of the mark and description, the Board of Appeal found it was confined to indicating that one colour was applied to the top of the chainsaw housing and the other colour was applied to the bottom housing of the chainsaw. This meant the graphic representation of the contested mark was the mere image of two colours without shape or contour, except for the fact the colour orange was always applied to the top housing of the chainsaw. The mark therefore allowed for several different combinations of the two colours.

The Board of Appeal noted that the contested decision took into account that at the time of filing the EUTM Stihl had made reference to an International Registration which depicted an image of a chainsaw in the relevant colours. The Cancellation Division had found this additional documentation submitted at the time of filing the EUTM

enabled a systematic arrangement to be identified in which the colours are used in a predetermined and uniform way. However, the Board of Appeal confirmed references to another mark or other documentation in this manner cannot be used to justify an application meets the requirements under Article 7(1)(a) as they would not be visible on the Register or at publication.

The Board of Appeal concluded the depiction of the colour mark combined with its description was not clear, precise, self-contained, easily-accessible, intelligible or objective. Further, it found as there existed numerous different shapes of chainsaws on the market it is not clear what the scope of protection of the mark actually would be.

**It was held that where a mark consists of a combination of colours its description must show the precise shades of colour, the ratios and their spatial arrangement.**

As the contested EUTM was insufficiently precise in this manner the Board of Appeal found it was registered contrary to the provisions of Article 7(1)(a). The appeal was upheld and the EUTM declared invalid.

## In short

This case confirms despite the change in 2015 to remove the “graphic representation” requirement, the Sieckmann criteria of “clear, precise, self-contained, easily accessible, intelligible, durable and objective” remains relevant for colour marks.

Author:  
Wendy Oliver-Grey



# “La Mafia se sienta a la mesa” General Court finds mark contrary to public policy

➤ **Case details at a glance**  
Jurisdiction: European Union  
Decision level: General Court  
Parties: La Mafia Franchises SL v EUIPO  
Citation: Case T-1/17  
Date: 15 March 2018  
Full decision (link): [dycip.com/lamafia](https://dycip.com/lamafia)

In 2006, La Honorable Hermandad (succeeded by La Mafia Franchises), a Spanish company filed a EUTM application for the following mark in relation to *inter alia* “catering services”:



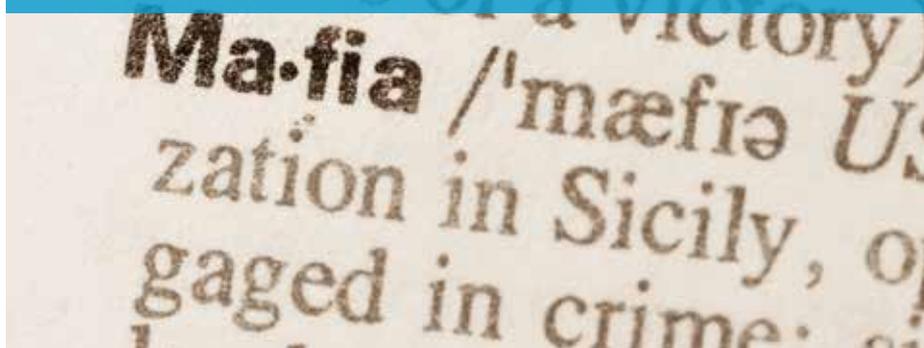
The mark was registered in 2008. Some seven years later in 2015 the Republic of Italy sought to invalidate the mark in its entirety on the basis of Article 7(1) (f) of Regulation 2017/100, namely that it was contrary to public policy and to accepted principles of morality.

**The Cancellation Division of the EUIPO held that the mark “La Mafia se sienta a la mesa” manifestly promoted the criminal organisation known as the Mafia, and that the full text of the word elements of the mark conveyed a message of conviviality and trivialised the word element “la mafia”, thereby distorting the serious connotations of that word.**

La Mafia Franchises sought to annul that decision before the General Court. The General Court dismissed the action confirming the EUIPO first instance decision.

The court emphasised that the word element “la mafia” is the dominant element of the mark and is understood world-wide

The court noted that the word element “la mafia” had deeply negative connotations in Italy



as referring to a criminal organisation that resorts, *inter alia*, to intimidation, physical violence and murder in carrying out its activities, which include drug and arms trafficking, money laundering and corruption. According to the General Court, those criminal activities breach the very values on which the EU is founded, in particular the values of respect for human dignity and freedom, which are indivisible and make up the spiritual and moral heritage of the EU. Moreover, given their cross-border dimension, the court said that the Mafia’s criminal activities are a serious threat to security throughout the EU.

The court added that the word element “la mafia” had deeply negative connotations in Italy, on account of the serious harm done by that criminal organisation to its security. The court therefore said that “la mafia” manifestly brings to mind, for the public, the name of a criminal organisation responsible for particularly serious breaches of public policy.

**The fact that La Mafia Franchises intended to register the mark “La Mafia se sienta a la mesa” with a view to alluding to the Godfather film series, with no intention to shock or offend, was considered to be irrelevant to the negative perception of the mark by the public.**

The court also explained that the reputation acquired by the Spanish company’s mark and the concept of its theme restaurants, connected to the Godfather film series, was irrelevant for the purpose of assessing whether the mark is contrary to public policy. Further, the fact that there are many books and films on the subject of the Mafia in no way was considered to alter the perception of the harm done by that organisation.

Finally, the court sided with the EUIPO and Italy’s assessment that the association of the word element “la mafia” with the sentence “se sienta a la mesa” (meaning “takes a seat at the table” in Spanish) and with a red rose was liable to convey a globally positive image of the Mafia’s activities which could trivialise the perception of the criminal activities of that organisation.

The mark was therefore considered to be likely to shock or offend not only the victims of that criminal organisation and their families, but also any person who, on EU territory, encountered the mark and had average sensitivity and tolerance thresholds. It was therefore declared invalid.

A review of the EUIPO register shows that a number of marks exist consisting of or containing MAFIA are registered; however, more recently a series of applications appear to have been rejected suggesting that the office is tightening its grip on such marks that are liable to cause offence.

**Author:**  
Richard Burton



# Coffee on the rocks Starbucks v Coffee Rocks

Case details at a glance

Jurisdiction: European Union

Decision level: General Court

Parties: Starbucks Corp, EUIPO,

Hasmik Nersesyan

Date: 16 January 2018

Citation: T-398/16

Full decision (link): [dycip.com/coffeerocks](https://dycip.com/coffeerocks)

Whilst not making new law, the decision from the General Court to overturn the rejection of Starbucks' opposition to the COFFEE ROCKS mark show below raises some interesting points for discussion.



The COFFEE ROCKS mark



The Starbucks marks

First, it will act as a warning to new businesses who decide to adopt a logo that shares similar features with a well known and established brand that, even when replacing the distinctive elements, this will not necessarily mean they have done enough to escape the wrath of (or a successful opposition by) the well-established business.

Second, might the General Court's decision be placing the EU Trade Mark Office, the EUIPO, in a difficult position when balancing what is enforceable against what can be registered as a trade mark?

The application to register the COFFEE ROCKS logo was filed in 2013. Starbucks opposed but were unsuccessful both before the Opposition Division and then the Board of Appeal. The Board of Appeal reached the conclusion that Starbucks had failed to overcome the first hurdle, namely to establish that there was any degree of similarity whatsoever between the marks. As a result, Starbucks' two grounds before the General Court were

1. that there was some similarity between the marks (and enough to establish a likelihood of confusion); and
2. the question of its reputation in its logo had not been considered by the Board of Appeal at all.

In comparing the marks the court noted according to case-law, two marks are similar when, from the point of view of the relevant public, they are at least partially identical as regards one or more relevant aspects. Although the Board of Appeal had concluded the marks were visually, phonetically and conceptually dissimilar, the court took issue with the first of these. Starbucks argued, and the court accepted, that there was the same overall general appearance between the marks and use of the same font. Starbucks also drew the court's attention to the fact that the mark applied for could be used in the colour combination covered by their earlier registrations thereby increasing the degree of similarity. Interestingly, the EUIPO acknowledged this at the hearing; however, one wonders if the same degree of similarity would have been found if the subject application had been filed in orange and black, the colours used by the applicant.

The court overruled the Board of Appeal who had effectively held that the similarity between the less distinctive components of the earlier marks and the mark applied for was negligible in the overall impression which those marks made on the relevant public. As a result, the court concluded that the Board of Appeal was wrong to hold that the marks were dissimilar, ruling out any possibility of similarity, even to a low degree.

Having persuaded the court that there was at least some degree of similarity between the marks Starbucks argued that their reputation had not been considered by the Board of Appeal and that this would be decisive in determining whether a conflict might arise between the marks. Starbucks needed to show that the three relevant conditions had been met: first, that the signs at issue are identical or similar, secondly, that their earlier mark(s) had a reputation and, thirdly, that there is a risk that

the use by someone, without due cause, of the sign in respect of which registration as a trade mark is applied for would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier mark.

The court held the similarity between the logos was capable of leading the relevant public to make a connection, that is to say, to establish a link between them and that, once again, the Board of Appeal had failed to consider this aspect of the case sufficiently.

Therefore the court annulled the Board of Appeal's decision and awarded costs in favour of Starbucks. The court may have remitted the case back to the Board of Appeal for further consideration – it is not yet clear from the public record. Alternatively, it simply chose to overturn the rejection of Starbucks opposition with the result that, absent a further appeal to the Court of Justice, the application will be rejected.

The case highlights the risks involved in adopting a mark that mimics or too closely resembles a well known brand even, for a logo, in relation to the less dominant elements.

Following this case there has been further discussion regarding the breadth of protection afforded to Starbucks.

Does this now prevent any third party from using two concentric circles with the word COFFEE to offer coffee related services? Also, although protection was obtained in Spain for the last of the 6 marks shown above in green, would the EUIPO accept an application for such a mark in black and white? In short has the Court concluded with this decision that Starbucks has rights in various elements of their logo which they can assert successfully against a third party but which they might have some trouble in protecting if they were to seek registration before the EUIPO. The EUIPO's position regarding composite marks without any distinctive dominant element is relatively strict and often applications are refused. It would be interesting to see how Starbucks fares.

Author:  
Jeremy Pennant



# D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

## Louboutin SAS v Van Haren Schoenen Additional Opinion of Advocate General Szpunar

In September 2017, we reported Advocate General Szpunar's opinion in *Louboutin v Van Haren Schoenen*. Following the June 2017 opinion, the case was reassigned to the Grand Chamber – composed of thirteen judges, rather than the usual three or five for CJEU chambers. A further hearing was held in November 2017 and the Advocate General has issued an additional opinion.

The Advocate General has maintained his proposed answer to the question referred:

“Article 3(1)(e)(iii)... is...capable of applying to a sign consisting of the shape of a product and seeking protection for a certain colour. The concept of a shape which ‘gives substantial value’ to the goods, within the meaning of that provision, relates only to the intrinsic value of the shape, and does not permit the reputation of the mark or its proprietor to be taken into account.”

In other words, the underlying Louboutin mark may in principle be caught by the “substantial value” objection.

In reaching this conclusion, the Advocate General admits that he is “sympathetic” to the argument put forward by Louboutin that aesthetic characteristics can vary in value and desirability over time according to ever-changing fashion trends [para 47]. However, the Advocate General also notes that the referring Dutch court considers that the red colour of the sole gives substantial value to the goods [para 13].

The Advocate General's opinion is not binding on the CJEU and it will be interesting to see to what extent it is followed. It will ultimately be up to the Dutch court, whilst applying the upcoming CJEU's decision, to decide whether Louboutin's trade mark is invalid.

**Author:**  
**Flora Cook**



### Contributors

Partner, Trade Mark Attorney

**Richard Burton**  
rpb@dyoung.com  
www.dyoung.com/  
richardburton



Partner, Solicitor

**Matthew Dick**  
mjd@dyoung.com  
www.dyoung.com/  
matthewdick



Partner, Solicitor

**Tamsin Holman**  
tph@dyoung.com  
www.dyoung.com/  
tamsinholman



Associate, Trade Mark Attorney

**Wendy Oliver-Grey**  
woo@dyoung.com  
www.dyoung.com/  
wendyoliver-grey



Partner, Trade Mark Attorney

**Jeremy Pennant**  
jbp@dyoung.com  
www.dyoung.com/  
jeremypennant



Solicitor

**Alban Radivojevic**  
azr@dyoung.com  
www.dyoung.com/  
albanradivojevic



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### Contact details

London  
Munich  
Southampton

T +44 (0)20 7269 8550  
F +44 (0)20 7269 8555

[mail@dyoung.com](mailto:mail@dyoung.com)  
[www.dyoung.com](http://www.dyoung.com)

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