

D YOUNG & CO TRADE MARK NEWSLETTER *no.134*

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Welcome to the May 2024 edition of the D Young & Co trade mark newsletter. What a month! Not only have we moved to our new London offices at 3 Noble Street (see page 03), we are very honoured to announce that we have won the UK Trade Mark Prosecution Firm of the Year in the Managing IP Awards, emerging as the winner from a very strong shortlist (see page 08).

While in celebratory mood, we look forward to meeting with colleagues and contacts at the INTA Annual Meeting in Atlanta in May and at ECTA in Antwerp in June.

Gabriele Engels
Partner, Rechtsanwältin

Events



INTA Annual Meeting Atlanta, USA, 18-22 May 2024

Trade mark partners from our London, Munich and Southampton offices Jana Bogatz, Matthew Dick, Tamsin Holman, Gemma Kirkland and Anna Reid will be attending this meeting.

GRUR Meets AIPLA Munich, Germany, 03 June 2024

Partner and Rechtsanwältin Jana Bogatz will be attending this event.

ECTA Conference Antwerp, Belgium, 19-21 June 2024

Partner and Chartered Trade Mark Attorney Richard Burton and Senior Associate Solicitor Peter Byrd will be attending ECTA's 42nd Annual Conference.

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Infringement / passing off

Every Lidl helps? The saga continues at the Court of Appeal

Whilst succeeding in its appeal against copyright infringement, Tesco has failed to overturn first instance findings of trade mark infringement and passing off. Lidl's appeal against the invalidity of its wordless logo marks was also dismissed.

Background

Lidl brought claims against Tesco on the basis that use of the latter's Clubcard Prices sign constituted passing off and infringed Lidl's trade marks and copyright.



Figure 1: Lidl's mark with text (left) and wordless mark (right).



Figure 2: Tesco's Clubcard Prices sign.

In addition to disputing these claims Tesco counterclaimed for revocation of the wordless mark on the basis of non-use, as well as seeking a declaration for it to be declared invalid on the grounds of bad faith. Whilst this claim was initially struck out, the Court of Appeal later allowed the bad faith argument to proceed after finding that Tesco's arguments did give rise to a real prospect of the presumption of good faith being overcome.

The High Court had found in favour of Lidl in relation to all of its claims, deeming that Tesco had infringed both the mark with text and copyright in Lidl's works, and was also liable for passing off.

Additionally, Tesco's counterclaim for a declaration of invalidity of the wordless mark succeeded because Lidl had been unable

to sufficiently explain its intentions at the time of filing to rebut the claim of bad faith.

Passing off

Tesco's main ground of appeal against the passing off decision concerned price-matching allegations brought by Lidl, and that the judge had been wrong to find that the average consumer, upon seeing the Clubcard Prices sign, would be led to believe that the price offered under it was price-matched with Lidl. Specifically, Tesco felt that the judge was wrong to conclude that the evidence presented supported a finding of deception.

Arnold LJ recognised that the initial decision may have been surprising given that no reference to either Lidl or price matching was made, and that Lidl's own price-matching signs differed significantly from the Clubcard Prices sign. However, when considering that the wordless mark had become distinctive through use of the mark with text, he found that the Clubcard Prices sign would call the mark with text to mind. Since it was common ground that Lidl offered lower prices, this meant the average consumer would be led to believe that Tesco was price-matching. This appeal therefore failed.

Trade mark infringement

Tesco challenged the finding of unfair advantage, and claimed that the judge had been wrong to find that there had been a change in the economic behaviour of consumers. Both parties accepted that this issue aligned with the price-matching allegations brought by Lidl which, if made out, would be evidence of such a change. As Lidl was successful in establishing price matching this ground of appeal also failed.

Challenging the finding of detriment, Tesco again tried to argue that the judge had been wrong to find a change in the economic behaviour of consumers. However, Arnold LJ pointed out that the judge's findings had been based on evidence showing that Tesco's Clubcard Prices sign had been successful in slowing the switch of customers from Tesco to Lidl, and that Lidl had felt obliged to engage in corrective advertising promoting its lower prices compared to Clubcard prices.

🔗 Case details at a glance

Jurisdiction: England & Wales

Decision level: Court of Appeal

Parties: Lidl Great Britain Ltd and

Lidl Stiftung & Co KG v Tesco

Stores Limited and Tesco PLC

Date: 19 March 2024

Citation: [2024] EWCA Civ 262

Decision: dycip.com/lidl-tesco-march2024

D Young & Co news

Important notification Change of D Young & Co London and registered office address

These arguments, coupled with the successful price-matching allegations, were successful in overcoming Tesco's appeals in relation to unfair advantage and detriment to Lidl's mark with text.

In its final argument Tesco sought to argue against the finding that it had used its Clubcard Prices sign without due cause. Given that this sign was already found to have taken unfair advantage of the mark with text, this argument was quickly rejected by Arnold LJ.

Therefore, all appeals against the finding of trade mark infringement failed.

Copyright infringement

Tesco's appeal against the finding of copyright infringement was based on two arguments:

1. That Lidl's works were not original, and that the judge had been wrong to find that placing a yellow circle inside a blue square involved free and creative choices.
2. Failing this, Tesco argued that the Clubcard Prices sign didn't reproduce substantial parts of Lidl's works.

Disagreeing with Tesco's first argument Arnold LJ found that, although the degree of creativity involved was minimal, the precise shades of blue and yellow and the precise positioning and dimensions of the circle within the square satisfied the test of originality. However, the scope of copyright protection afforded was consequently very narrow. By using slightly different shape dimensions and shades of blue and yellow Tesco did not infringe Lidl's works. This appeal succeeded.

Invalidation

The final appeal was brought by Lidl against the finding that its wordless mark had been registered in bad faith and consequently invalidated.

In total, there were twelve grounds relied on at appeal, which Arnold LJ felt was indicative of Lidl's inability to recognise

any serious flaws with the judge's reasoning in the first instance.

Arnold LJ reiterated the finding that the presumption of good faith had been rebutted due to an absence of evidence that Lidl intended to use the wordless mark in the form it was registered. It was therefore up to Lidl to explain its intentions which it was unable to do. Hence, Lidl's registration and subsequent re-registrations of the wordless mark were deemed to have been for use as a legal weapon and its appeal failed.

Author:

Laurie Ford



In short

Ultimately, this was a highly fact-specific case from which it is difficult to draw any major conclusions. This is further reinforced by Birss and Lewison LJ's commenting on the difficulties they had in this case which lay "at the outer boundaries of trade mark protection and passing off".

Nonetheless, a key takeaway for brand owners comes from comments made by Arnold LJ about the usefulness of evidence tracking consumer behaviour in supporting claims of trade mark infringement. This can have a meaningful effect on a judge's reasoning, and a party faced with such evidence should carefully consider the extent to which rebuttal evidence should be filed.

D Young & Co, 3 Noble Street, London



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D Young & Co Chair David Meldrum comments: "This exciting move reflects our commitment to growth and innovation. We look forward to welcoming clients to our new London home, in the heart of the City, where we will continue to thrive and create value together."

Our Munich and Southampton offices remain unchanged.

If you usually correspond with our Munich or Southampton offices (and Southampton accounts) please continue to do so:

- D Young & Co LLP, Rosental 4, 80331, Munich.
- D Young & Co LLP, Briton House, Briton Street, Southampton, SO14 3EB.

Establishing genuine use of business and retail services

Habitat's class 35 services revoked on appeal

Habitat is a furniture and home furnishings company. It sells goods online and in stores across the EU. Habitat had an EU trade mark registration for a figurative mark containing "Habitat" for various goods in various classes and for services in class 35 such as retailing in shops of furniture and decorative articles, business services, advertisement services, franchising, and decoration of shop windows.

Habitat responded to an application to revoke its registration in its entirety, filing hundreds of documents, including press files, catalogues, third party articles, receipts, website screenshots, newsletters, evidence of delivery trucks and franchise agreements.

At first instance, Habitat managed to retain the registration for the majority of the goods, however, the Cancellation Division revoked the class 35 specification in its entirety. Despite the fact that Habitat had submitted "very voluminous evidence" showing that it was involved in selling a range of different goods, it had not demonstrated trade mark use in relation to any of the class 35 services.

Why were the class 35 services revoked?

In making its decision the Cancellation Division referred to the explanatory note of the Nice Classification, which provides that the concept of "retail services" relates to three essential characteristics:

1. the purpose of retail services is the sale of goods to consumers;
2. they are addressed to consumers with a view to enabling them to conveniently view and purchase the goods; and
3. they are provided for the **benefit of others**.

The Cancellation Division commented that, in the same way that advertising one's own goods does not constitute use for advertising services, there is no use for retail services where the manufacturer is merely selling its own goods from its shop or website.

Such activity is not an independent service but an activity covered by the protection

Habitat argued it was a retailer of goods of different independent designers



conferred by registration for the goods. Consequently, it would not be appropriate to equate the protection conferred by registration for goods in any of classes 1 to 34 with that conferred by registration for class 35 retail services. The evidence merely showed that Habitat was selling its own goods and carrying out its own business and admin services in relation to its own business: it was not providing any services to third parties.

The appeal

Habitat appealed the decision to revoke its class 35 specification to the Board of Appeal. Arguments were split in relation to retail services and the remaining more business-like services.

Retail services

Habitat highlighted that it sold not only its own goods but also goods from independent designers who created products for Habitat to sell. Essentially, it argued that it was not a manufacturer but a retailer of goods of different independent designers and other third-party companies. Therefore, the sale services provided should be considered as retail services. However, the Board of Appeal found that "Habitat" was affixed to all such goods and so the reference to independent designers would be seen as a product range designation, that is, the name of a collection, which is common in trade industry. Consumers would still regard "Habitat" only as the badge of origin.

More business-like services

Despite the extensive use of the mark, and

the fact that there were signed franchise agreements with companies and designers for the distribution of products, there was no use of the mark in relation to the business services. The services were carried out to benefit the sale of "Habitat" goods and for the management of Habitat's own business. The services were not provided for the benefit of third parties, as an independent service, but in order for the proprietor to organise sales of its own goods under the mark "Habitat". These activities were encompassed by the trade mark protection given for those goods. Consequently, the appeal was dismissed.

Conclusion

This decision highlights that to demonstrate genuine use of a mark in relation to class 35 services, the evidence must demonstrate that the services are provided under the mark for the benefit of others (clients). Carrying out your own business and selling your own goods does not constitute use of a mark in relation to class 35, since it does not constitute an independent service but an ancillary activity.

The function of a trade mark is to act as a badge of origin: when a business is conducting services for its own benefit, consumers will not have the opportunity to perceive the business as providing such services under the mark, such that they will need to rely on the mark as a badge of origin for that service.

Author:
Sophie Rann



COMPTON... straight outta where? Fashion styles and the importance of gansta rap for hip hop culture

In 1988 the hip hop group N.W.A. released the album Straight outta Compton. In 2015 a documentary of the same name was released, propelling the album back into the charts. BIW Invest AG is owner of EU word and figurative/word marks for “COMPTON”, registered in 2015/2016 in classes 25 (and 18).

New Yorker Marketing & Media International GmbH (New Yorker) brought invalidity actions against both marks. New Yorker argued that Compton, with its nearly 100,000 inhabitants at the outskirts of Los Angeles USA, is known as the cradle of gangsta rap. Gangsta rap in turn influenced street fashion. The marks were therefore descriptive of the geographical origin and non-distinctive.

A trade mark is descriptive of the geographical origin within the meaning of Art. 7(1)(c) of the European Union Trade Mark Regulation (EUTMR) if it is:

1. known to the relevant public as a geographical place (at the time of filing of the application); and
2. therefore associated with the category of goods/services that registration is sought for (at the time of filing of the application or likely in the future).

The invalidity division of the European Union Intellectual Property Office (EUIPO) rejected the applications, the EUIPO Board of Appeal declared the marks invalid, and the General Court held that the appeal was well founded.

How to form a relevant subcategory of goods

The Board of Appeal found that the goods (that is, clothing and bags) are of a general nature and cover a large number of individual products. To assess descriptiveness the Board of Appeal formed subcategories. It differentiated between “streetwear items” and “conventional clothing”, concluding that streetwear items are mainly aimed at younger members of the public, are regularly sold in special stores or in separate departments of clothing stores, and express a group affiliation through certain external features. For streetwear, the goods in question would be descriptive.

The General Court found that the Board of Appeal incorrectly used “streetwear” synonymously with “street fashion”, that is, a specific style also known as hip hop fashion. As such, it was unsuitable to form a subcategory that could invalidate the broader category of goods. The decisive criterion is the purpose/intended use. Nature and characteristics of the goods concerned are irrelevant. The intended purpose of clothing is to cover, conceal, clothe and protect the body against the elements. The intended purpose of the class 18 goods was to pack, protect and transport various personal items. Streetwear items served those purposes and can therefore not form a distinct subcategory.

Who is the relevant public?

The General Court found that the Board of Appeal (limiting the assessment to Germany) erred in defining the relevant public: effectively as purchasers of streetwear items with a particular interest in streetwear influenced by the hip hop movement.

The Straight outta Compton documentary propelled the N.W.A album back into the charts



Case details at a glance

Jurisdiction: European Union
Decision level: General Court
Parties: New Yorker Marketing & Media International GmbH v BIW Invest AG
Citation: T 747/22
Date: 28 February 2024
Link to decision: dycip.com/t-747-22

Jurisdiction: European Union
Decision level: General Court
Parties: New Yorker Marketing & Media International GmbH v BIW Invest AG
Citation: T 746/22
Date: 28 February 2024
Link to decision: dycip.com/t-746-22

A narrower circle within the public at large composed of persons, for whom the goods are intended and who have specific knowledge enabling them to better understand the meaning of certain terms or concepts, may be taken into account, but only if they form a substantial part of the relevant public.

The General Court found that the submitted evidence did not prove that the relevant German public knew the city of Compton in 2015. Numerous media articles about the myth of Compton demonstrated an interested audience, but do not evidence the awareness level among the general public. The General Court found that Compton was closely associated with gangsta rap of the west coast USA, but that the city does not, by definition, play an equally central role in hip hop culture and rap music as a whole.

Only 54,7000 people (0,67% of the German public) watched the documentary “Straight outta Compton” and the N.W.A. album of the same name ranked 36 in the album charts in Germany. This was considered informative. However, a few percent is not a substantial part of the relevant public.

Author:
Jacqueline Feigl



In short

This decision gives guidance on how to form subcategories of specifications that can invalidate the broader category of goods/services. Purpose/intended use is a decisive factor. Style, target audience, and a specific distribution channel are irrelevant.

Sub-groups of the relevant public can be relevant too, but must form a substantial part of it. A few percent of the general public is insufficient.

Dry January

Is the sobriety slogan too generic for trade mark protection?

Case details at a glance

Jurisdiction: United Kingdom

Decision level: UKIPO

Parties: Big Drop Brewing Company

Limited v Alcohol Research UK

Citation: O/0131/24

Date: 20 February 2024

Decision: dycip.com/dry-january

In a recent decision from the UK Intellectual Property Office (UKIPO), Big Drop Brewing Company Limited opposed the trade mark application for DRY JANUARY by applicant Alcohol Research.

Background

Alcohol Research UK, a recognised charity promoting alcohol awareness, sought to register DRY JANUARY across various classes for goods and services concerning non-alcoholic products and associated promotional activities. Big Drop Brewing Company, a producer of non-alcoholic beverages, raised multiple (absolute) grounds for opposition under Section 3 of the Trade Marks Act 1994, namely, that the application was descriptive and non-distinctive, and made in bad faith.

Key issues

Big Drop Brewing Company argued that the term “dry January” is commonly used in the trade to describe the abstinence from alcoholic drinks in January, thereby failing to function as a trade mark. Furthermore, Big Drop Brewing Company contended that Alcohol Research UK had no genuine intention to use the mark across the specified goods, potentially blocking other traders from using the term descriptively.

Alcohol Research UK sought to demonstrate evidence of acquired distinctiveness through extensive use in campaigns and promotions directly associated with alcohol abstinence awareness. It argued that DRY JANUARY had become synonymous with its activities and was recognised by the public as such.

Analysis of the decision

The opposition under Section 3(1)(a) of the Trade Marks Act 1994, which concerns marks that cannot constitute a trade mark,

was swiftly dismissed. The hearing officer clarified that “dry January” as a term, is not inherently incapable of distinguishing **any** goods or services. Thus, the mere fact that a term can serve as a trade mark in **any** context is sufficient to overcome an objection under this ground.

However, the opposition fared differently under Section 3(1)(b) of the Trade Marks Act 1994, which concerns signs that are devoid of any distinctive character. The hearing officer determined that DRY JANUARY is on the face of it objectionable, as it directly describes a period of abstaining from alcohol in January: a concept widely recognised and practiced. The use of these words on alcoholic beverages and related services would unlikely be perceived as a trade mark by the average consumer.

Similarly, turning to Section 3(1)(c) of the Trade Marks Act 1994, it was held the term “dry January” was already used by various entities in a non-distinctive manner by the relevant date. The hearing officer found the term was employed to describe the characteristics of products or services related to alcohol abstinence during January. This finding underscores the critical element of how a trade mark is perceived in the marketplace and its association with the goods or services it purports to cover.

Section 3(1)(d) of the Trade Marks Act 1994 addresses the customary nature of the sign in the current language or established practices of trade. The hearing officer pointed out that the use of #dryjanuary as hashtags on social media platforms like Instagram, among other descriptive tags, does not confer distinctiveness. The decision illustrates the difficulty in establishing trade mark rights in tags commonly used for social media campaigns, especially when lacking substantial evidence of distinctive use that links directly back to a single source or entity.

Section 3(6) of the Trade Marks Act 1994 concerns the registration of a trade mark made in bad faith. The hearing officer concluded that the trade mark application by the charity, which had been using the

name for years to expand its scope of activities, was not made in bad faith. Its reasoning hinged on the broader context of the trade mark’s use and the intentions behind its registration, underscoring that filing a trade mark application, even one facing absolute grounds for refusal, does not automatically equate to bad faith.

Conclusion

Ultimately, the hearing officer ruled that DRY JANUARY could not function as a trade mark due to its descriptive nature and the public’s strong association of the term with a general concept rather than any specific trading source. As such, the opposition was successful.

Author:

Sophia Karim



In short

This decision serves as a reminder of the challenges of obtaining trade mark protection for phrases or sayings that are, or have evolved into, common usage. It also emphasises the necessity of presenting strong evidence of distinctiveness, and the pitfalls of attempting to trade mark terms that have become generic descriptors in the industry or broader society.

For trade mark practitioners this case is a reminder of the delicate balance between protecting commercial interests and preventing the monopolisation of descriptive language, as well as the importance of assessing the current and historical public usage of a term.

I spy with my little eye... How to invalidate your own design!

In its decision of 06 March 2024 the General Court confirmed the invalidity of Puma's design for the "Fenty x Puma Creeper" model due to prior disclosure by Rihanna.

Background

"Fenty x Puma" is a collaboration with the singer Robyn Rihanna Fenty (Rihanna). Rihanna partnered with Puma in 2014 as a creative director and brand ambassador. In September 2015 Puma launched the first Fenty x Puma collection, including its "Creeper" model (Fenty Creeper). Looking back at shoe styles, the crepe sole dates back to the years following World War II, but the combination with a sneaker upper (at least) appeared to be a novelty. The Fenty Creeper soon became an "it sneaker".

Designs for this model were filed in July 2016. In the EU, designs were filed for the sole standalone (registered Community design number 003320555-0001) and for the shoe model as a whole (registered Community design number 003320555-0002).

Given the popularity of the Fenty Creeper knock-offs were inevitably to follow, and Puma heavily enforced its designs.

In 2019 a third party filed invalidity actions against these registered community designs (RCDs). Interestingly enough, Puma withdrew its appeal to the Board of Appeal in relation to the sole design. The design has been declared invalid. However, the proceedings

against the RCD for the entire shoe went to the General Court after the Board of Appeal confirmed the invalidity of the design.

Decision

The General Court then confirmed that the design is in fact invalid for lack of novelty and individual character.

The reason for this was that the invalidity applicant was able to dig up Instagram posts and articles showing Rihanna wearing the Fenty Creeper model in 2014.

Puma tried to argue that:

- the images were not detailed enough to make out any of the features of the attacked RCD; and
- with regard to one photo taken from "hausofrihanna.com", the photo would be of questionable origin, could have been added to site at a later date, and it could not reasonably have become known in the normal course of business to the circles specialised in the sector concerned.

However, the General Court confirmed that the design had already been disclosed by the posts and articles in 2014. With regard to this, the General Court highlighted that Rihanna was a world-famous pop star in 2014. Therefore, her fans and those who specialised in the fashion sector "had developed a particular interest in the shoes that she wore on the day on which the

Case details at a glance

Jurisdiction: European Union
Decision level: General Court
Parties: Puma SE v EUIPO
Citation: T 647/22
Date: 06 March 2024
Decision: dycip.com/puma-v-euipo

Related article

Yvonne Stone also recently wrote an article for *World Trademark Review*: "What does the EUIPO want? Clarity and precision for colour combination marks": dycip.com/euipo-wtr-yvs

contract under which the star became the applicant's creative director was signed. It is perfectly reasonable to take the view that in December 2014 a not insignificant proportion of people who were interested in music, or in Rihanna and her clothing, viewed the photos closely to identify the shoes that the star wore, thus recognising the features of the prior design" (see paragraph 53 of the decision).

Outlook

Given the high threshold for an appeal to the Court of Justice of the European Union (CJEU) it is unlikely that Puma will be able to appeal. Therefore, this decision will likely put a damper on Puma's enforcement campaign, at least on the basis of any registered Community designs. On the other hand, at least in Germany, Puma may still try to rely on unfair competition claims. As the territorial scope of such claims is limited to Germany, it will certainly be more cumbersome than pan-EU enforcement based on an RCD.

Author:

Yvonne Stone



In short

Overall, the decision serves as a reminder to get designs filed as soon as possible, ideally before any disclosure to the public. Aside from that, instilling this awareness in any collaborators (for example, Rihanna) may certainly have gone a long way. After all, Rihanna was wearing the shoes in public before their official launch in September 2015. With the designs having been filed in July 2016, this was a long while before Puma's legal department was able to act or at least realise that designs would facilitate enforcement against any knock-offs.

Puma's design was declared invalid by the GC due to prior disclosure by Rihanna



D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

D Young & Co news

UK Trade mark Prosecution Firm of the Year 2024 Managing IP EMEA Awards

Partners Tamsin Holman, Matthew Dick and Anna Reid at the EMEA Awards



Managing IP hosted a gala dinner in London on 11 April 2024 to announce its award winners in recognition of law firms, companies, and practitioners for their intellectual property work achievements in 2023.

We are delighted to announce that the D Young & Co trade mark team was awarded the coveted national award for UK Trademark Prosecution Firm

of the Year for 2024, emerging as the winner from a very strong shortlist.

The award was accepted by partners Tamsin Holman, Matthew Dick and Anna Reid (pictured above).

The trade mark team was also shortlisted for the UK trade mark disputes, UK IPEC firm of the year, UK trade mark attorney of the year (Gemma Kirkland) and UK rising star of the year (Peter Byrd) awards.

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