

D YOUNG & CO TRADE MARK NEWSLETTER *no.59*

November 2011

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10th Consecutive Year
Legal 500 has once again rated
D Young & Co as a leading UK
IP firm, ranking us as top tier in
all patent and trade mark attorney
categories. This is the 10th
consecutive year in the top
tier for the Trade Mark Group.



Details: See back page



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Events



8-11 November 2011

INTA Leadership Meeting

Jeremy Pennant and Ian Starr will be attending the INTA Leadership Meeting in Miami Beach, Florida, USA.

More information: www.dyoung.com/events

Editorial



We are delighted to announce that Helen Cawley has been promoted to partner in the Trade Mark Group. Helen is well known to many of our readers as she handles a busy practice, is a frequent visitor to Japan, where she has many clients, and a regular attendee at the INTA Annual Meeting. Helen joined D Young & Co in 2004 and is keen to continue developing her practice in East Asia: her next trip in December will be extended to include South Korea, as well as Japan. For a photo of Helen please turn to page 8 and, to view Helen's profile see www.dyoung.com/helencawley.

We are also celebrating our 10th consecutive year ranked as a top-tier trade mark practice by the Legal 500. We thank our clients for the feedback they have provided in the evaluation process and also for the on-going trust in our services. We thoroughly enjoy the fascinating, and varied, work we are involved with, and look forward to continuing to provide you with the most effective solutions to any trade mark issues you may have.

We hope you enjoy this newsletter – you can find additional articles, which did not fit into this issue, in the knowledge bank section of our website www.dyoung.com/knowledgebank.

Editor:

Vivienne Coleman



Article 01

Interflora v Marks & Spencer

Use of AdWords Presents Thorny Issue

Following the rulings of the Court of Justice of the European Union (CJEU) in the trinity of Adwords cases involving Google France (C-236/08), Bergspechte (C-278/08) and Portakabin (C-558/08), the CJEU has recently determined a number of related preliminary questions, as referred to it by the High Court of England and Wales, in the 'Interflora' case.

The 'thorny issue'

Marks & Spencer (M&S) had made use of Google's Adwords facility to select the term 'Interflora' (in a variety of spellings) to promote their own flower retail services. Upon a Google user entering any of the submitted terms into its search engine, an advertisement for the services provided by M&S is displayed in the form of a 'sponsored link'. Interflora objected to the actions of M&S and began proceedings.

The referred questions

The questions referred to the CJEU may be summarised as follows:

1. Regarding the Adwords facility, can a proprietor of a trade mark prevent a competitor from using an **identical** mark in relation to **identical** goods/services?
2. Is it relevant that the advert is liable to lead some members of the public to believe that there is an association/economic link between the advertiser and the trade mark proprietor?
3. Is it relevant to the above question that the Adwords facility does not allow a trade mark proprietor to prevent such use?

The previous cases

Use in relation to goods or services

It has already been recognised by the Court in *Google France*, that the selection of a mark as a keyword (within the Adwords service) constitutes use *in relation to goods and services*, notwithstanding the absence of the mark in the displayed results/links.

This is an uncontroversial point, which finds judicial support in the later case of *Bergspechte*.

A more contentious issue however, is the *basis* upon which a trade mark proprietor may *prevent* such use.

The decision in *Google France* concluded that there must be a proven 'adverse effect' in relation to *one of the functions* of the trade mark. Whilst most lawyers had traditionally viewed the function of 'indicating origin' as the principal (if not the only) function, the Court had regard to the cases of *L'Oreal and Others* (C-324/09) and *Arsenal Football Club v Reed* (C-206/01), and concluded that:

1. a trade mark's function of indicating origin is not the only function worthy of protection; and
2. the 'investment function' of a trade mark may be adversely affected where there is 'substantial interference' with the proprietor's use of its trade mark to acquire/preserve its reputation.

In the previous *Google France* case, the CJEU had decided that the 'advertising function' of a trade mark was **not** adversely affected by Adwords. Therefore, the reference to an effect upon the 'investment function' was somewhat surprising, but is to be welcomed by trade mark proprietors as it illustrates a willingness of the Court to recognise the wider protection to be afforded to 'marks with a reputation'.

Additionally, the Court added that such selection and use within the Adwords service may amount to the dilution of the trade mark's distinctive character where it prevents the "reasonably well-informed and reasonably observant internet user" from ascertaining whether the "goods or services offered, originate not from the proprietor of the trade mark, but on the contrary, from a competitor of that proprietor." However, the Court suggested that there may only be an actionable basis in this regard where the advert contributes to the 'genericising' of the mark in question.

The decision

The Court ruled that a proprietor of a trade mark is entitled to prevent the use of a keyword where:

➤ Other decisions noted in this article:

Google France C-236/08:

<http://bit.ly/c23608dec>

BergSpechte C-278/08:

<http://dycip.com/c27808dec>

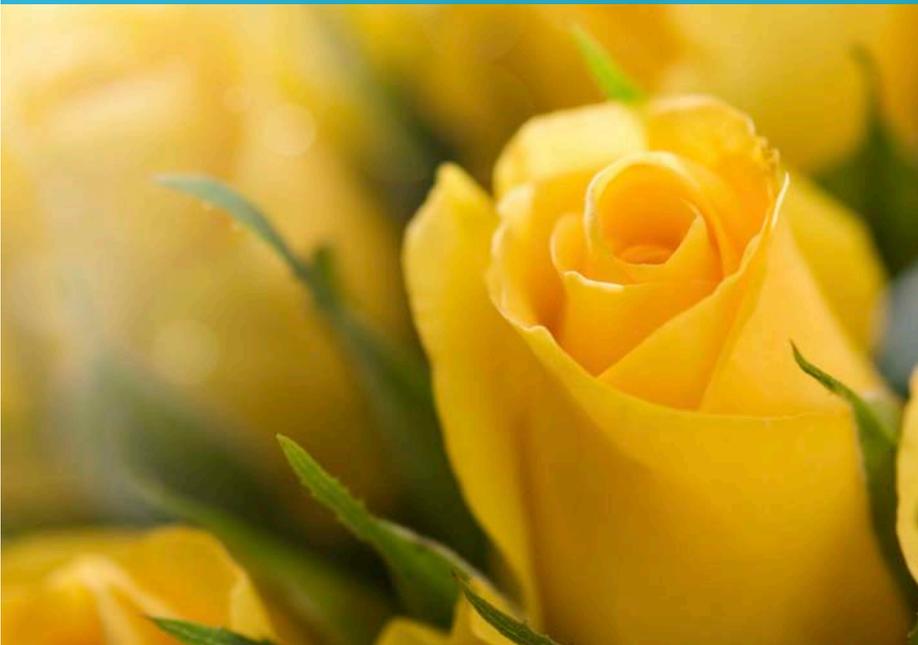
Portakabin C-558/08:

<http://dycip.com/c55808dec>

Article 02

Damages Cap Helps Smaller Businesses Protect IP Patents County Court (Financial Limits) Order

Interflora objected to M&S's use of the keyword 'interflora'



- the keyword constitutes an **identical** sign in relation to **identical** goods/services; and
- use of the keyword is liable to have an adverse effect on *one of the functions* of the relevant trade mark (including the function of 'investment'); and
- the displayed advertising "*does not enable reasonably well-informed and reasonably well-observant internet users, or enables them only with difficulty to ascertain whether the goods/services concerned... originate from that proprietor or, on the contrary, originate from a third party*" (the origin function); or
- in the case of a mark with a reputation, the advertising "*substantially interferes with the... use of its trade mark to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty*" (the 'investment' function).

Who came out 'smelling of roses'?

Whilst it would appear that this decision is encouraging for both Interflora and, indeed, Google, the result is tempered by the Court's consideration of the relevant market, within which "well-observant internet users" operate.

In particular, the Court suggested that the offering of an alternative (as opposed to an imitation) product or service may not offend either of those functions of a trade mark in such circumstances, which appears to narrow the scope of the decision. One of the key issues for the UK Court to decide is likely to be whether or not there is some confusion amongst users (and, in this case, taking into account the unique distribution system operated by Interflora).

All in all, there is everything to play for and the High Court's ultimate decision is awaited with anticipation.

Author:
Scott Gardiner



Useful links:

Full text of decision:

Interflora Inc, Interflora British Unit v Marks & Spencer C-323/09:

<http://dycip.com/c32309dec>

It has often been the case that small businesses have shied away from protecting their IP because the costs of enforcement have resulted in unknown levels of high costs for claimants. Indeed, in the recent Hargreaves Review of Intellectual Property, it was revealed that one in five small to medium sized businesses refrain from enforcing their rights as a result of the high levels of costs levied in court cases.

The tides are changing, however, and with the introduction of The Patents County Court (Financial Limits) Order (No.2) 2011, the costs of protecting IP have now become much more manageable for small- to medium-sized businesses.

The Order sets out a clear definition of the IP disputes concerning copyright and trade mark matters that should be heard in the Patents County Court, and those which should be sent to the High Court.

For claimants with a legal case worth less than £500,000, the case will be heard in the Patents County Court and the 'Financial Limits' Order ensures that damages in these cases will be limited to a maximum of £500,000. For larger legal cases, the matter will be sent to the High Court.

Whilst a cap of £500,000 may still sound high, these costs are significantly less than the damages often awarded in the High Court, which are often unknown. Claimants in the Patents County Court can now, therefore, be confident that enforcing their IP rights will expose them to a much smaller financial risk than if their case was to be heard in the High Court. It is hoped that the Order will encourage smaller claimants to be more proactive in enforcing their rights.

Author:
Gemma Williams



Useful links:

Patents County Court (Financial Limits) Order:

<http://dycip.com/vJ18ps>

Generic Top Level Domains (gTLDs) New Challenges 'After the Dot' for Brand Owners

On 20 June 2011, following a long period of consultation with relevant stakeholders, the Internet Corporation for Assigned Names and Numbers (ICANN) announced its decision to open the internet's naming system and allow any interested organisation (whether private or public) to apply to register new gTLDs and to become operators of the related registries.

In lay terms, this means that we will move from the current 22 gTLDs (including the famous .com, .net, .org etc) to a naming system which, through time and depending on market interest, will allow for the registration and operation of a potentially limitless number of gTLDs in any language or script.

A key factor in ICANN's decision process was the desire to promote competition in the internet market and increase consumer choice. As the worldwide internet community now boasts approximately 1.5 billion users, innovation and diversity are felt to be indispensable pre-requisites of the naming system, which will now "better serve all of mankind" (in the words of Rod Beckstrom, President and Chief Executive Officer of ICANN).

This article focuses on some of the challenges and opportunities that the new gTLDs system will present for brand owners.

Brief notes on the application process and the possible benefits to brand owners

Registering a new gTLD and operating a registry is by no means as easy as registering a domain name. The application process is long (it can take from nine months to up to 20 months or longer), complex (it encompasses a considerable number of stages), and expensive (the basic evaluation fee is US\$ 185,000, but overall costs may well be US\$ 500,000 – 1,000,000).

ICANN wants to ensure that prospective applicants will be in a position to manage a registry financially, technically and operationally. ICANN expects the new gTLDs to be active and operational and, to this end, requires applicants to provide it with full information on themselves and a detailed plan for the launch and operation of the new gTLDs. Therefore, it will not be possible to register new gTLDs as a 'blocking strategy'. The two options for applicants will be to run the registry as a 'close system' (ie, by allowing domain names to be registered only to select parties) or as

an 'open system' (ie, by allowing the public at large to register domain names).

Therefore, brand owners are likely to apply either:

- (1) to secure the registration of their corporate style or trading name (and, funds permitting, key brand(s)) so that they, their groups of companies and, possibly, other selected parties may use it; or
- (2) via umbrella organisations seeking to register new generic gTLDs on behalf of their members, which will then be the only ones entitled to register domain names ending with the new gTLD: eg, the (fictional) International Organisation of Widget Manufacturers may apply for '.widget' on behalf of its members so that only its members worldwide will be able to use the new gTLD.

Generally speaking, the advantages of securing one or more gTLDs for brand owners are said to be:

- (1) brand awareness: they will be able to consolidate their presence in the online market and increase brand reputation;
- (2) brand exclusivity: they are likely to strengthen the association between the trade mark and the business in the public's mind, thereby also preventing dilution or confusion (especially if the sign or trade mark is subject to a co-existence agreement or there are other market operators using an identical or significantly similar sign);
- (3) greater security, consumer education and brand trust: the new gTLD will facilitate the identification of the 'original' from the 'imitation' or 'counterfeit': eg, the owner of the mark 'WIDGET', by trading only from websites with strings ending '.widget', should enable the public to determine with certainty when they are dealing with the original. Further, where the brand owner has a network of trusted distributors or franchisees for its widgets, by letting them register a '.widget' domain name, it will create a 'sense of community' with its business partners and also increase its control over them; and

The launch of the new gTLD system has caused concern amongst trade mark owners



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Scan the QR code below using your internet enabled smart phone to access our knowledge bank



➤ **Missed anything?**
In between issues of this newsletter we posted news about the reclassification of UK trade mark registrations and the UK IPO's Trade Marks Tribunal Practice Notice (2/2011). Visit our website for up to the minute IP related articles and news.

(4) innovation: there will be a return in image, in that the registration of a new gTLD will at the very least denote their innovative approach.

How will brand owners protect their trade marks?

Whilst the launch of the new gTLD initiative has rightly caused concern amongst trade mark owners, several mechanisms and measures will be in place for them to protect their rights and it is vital to be aware of them to ensure that risks are minimised and potential threats are acted upon.

ICANN dispute resolution proceedings

As part of the new gTLD application process, once the administrative check stage is complete, all applications will be published by ICANN. This will give any aggrieved trade mark owner the chance to lodge a formal objection to a gTLD application.

Objections can be filed only on four specific grounds and the relevant ones for trade mark owners will be:

- the String Confusion Objection, where the gTLD string is confusingly similar to an existing TLD or to another applied-for gTLD string in the same round of applications. The International Centre for Dispute Resolution (New York, USA) has agreed in principle to administer this procedure and the fees are currently set at approx. US\$10,000; and
- the Legal Rights Objection, where the gTLD applied for infringes the existing legal rights of the objector (ie, trade mark rights). The Arbitration and Mediation Center of the World Intellectual Property Organization (Geneva, Switzerland) has agreed in principle to administer this procedure and the fees will range between US\$10,000 and US\$23,000 depending on the number of panellists.

Although possibly rare, one could envisage the situation in which the same objector may want to object to a gTLD on both the above grounds. Arguably, the fact that two separate providers are in charge of dealing with the two kinds of dispute makes the objection process

unnecessarily more expensive and logistically complicated.

As ICANN is not contemplating a notification system for the benefit of trade mark owners; it is of real importance that gTLD applications are monitored each time they are published.

Considering the complexity of the application process and the costs involved, it is difficult to envisage that cybersquatters will be flocking to register new gTLDs as they would do for second-level domains. More likely is a dispute between trade mark owners who own the same mark in different countries.

Rights protection mechanisms for second-level domains

New gTLDs will have to implement a series of procedures to ensure that minimum standards of protection are guaranteed to trade mark owners. These will include:

- (1) a sunrise period during which trade mark owners only are allowed to register second level domains before the general public can; and
- (2) ICANN's Uniform Domain Name Dispute Resolution Policy (UDRP)-based dispute resolution procedures, whereby trade mark proprietors will be able to file a complaint and ask for the transfer of infringing domain names registered and used in bad faith.

Considering the vast number of new gTLDs that may potentially be introduced, trade mark owners will have to step up their monitoring and enforcement activities and, depending on the relevance of the gTLDs in question, consider registering a number of second level domain names as a precautionary measure.

Trade mark clearinghouse

As part of the new gTLD program, ICANN will introduce a trade mark clearinghouse, ie, a database for the 'authentication and storage of trade mark information', on the basis of which trade mark owners will be notified of any sunrise period for new gTLDs and will also be notified of any attempts to register second-level domain names that are identical

to their marks. ICANN has recently issued a request for information to identify potentially suitable providers of this service.

It will be crucial for each trade mark owner to ensure that the trade mark clearinghouse contains, at the very least, all of its key trade marks.

Uniform Rapid Suspension (URS) and Post-Delegation Dispute Resolution Procedure (PDDRP)

The new gTLD registries will also have to implement URS and PDDRP procedures:

- Pursuant to the former, trade mark owners can request that blatantly infringing websites are immediately taken down and the domain name points to a URS placeholder page. The trade mark proprietor will be able to obtain the deletion or transfer of the domain name by means of the standard formal complaint procedure also operated by the same registry.
- Pursuant to the latter, trade mark owners will be able to file objections against a new gTLD registry whose activities are alleged to cause or materially contribute to systemic trademark abuse. This procedure will ensure that applicants that are successful in the application process will comply with ICANN's rules and administer their registries in a way that safeguards the rights of trade mark owners.

Again, it is essential that trade mark owners and their advisers are aware of the existence of these mechanisms and are familiar with the relevant procedures.

Whatever one may think of the new gTLD process, the fact is that ICANN intends to accept applications from January 2012 and there may well be a large number of applications. A sensible monitoring and objection process needs to be put in place soon, whether one is seeking one of the new gTLDs or not.

Author:
Cam Gatta



It's My Name

Elio Fiorucci in Fight for Trade Mark Rights to His Name

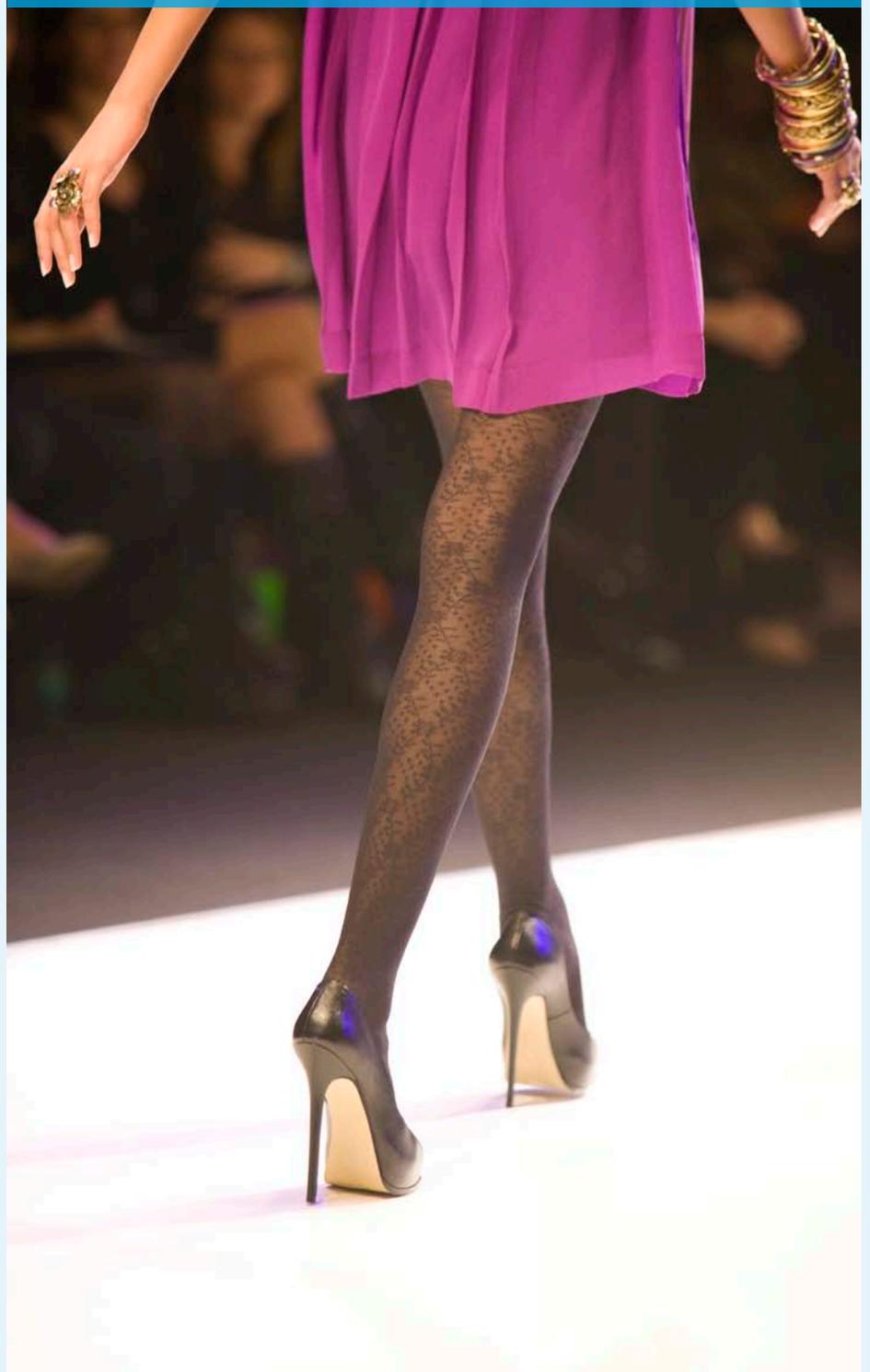
In the 1970s, fashion designer Elio Fiorucci achieved a degree of renown in Italy. However, he fell on bad times in the 1980s and his company, Fiorucci SpA, went into administration. Subsequently, his company was sold to a Japanese multinational, Edwin, in December 1990 and the sale included all Elio Fiorucci's 'creative assets' which included all trade marks wherever they may be registered or applied for in the world, as well as the exclusive right to use the designation FIORUCCI and the right to manufacture and sell clothes and other goods bearing the name FIORUCCI.

Not surprisingly, following the advent of the Community trade mark (CTM) registration system, Edwin applied to register the word mark ELIO FIORUCCI and registration was granted in April 1999. However, in February 2003, Elio Fiorucci applied for revocation of the registration on the grounds that the mark was liable to mislead the public (Art 50(1)(c) CTMR) and for a declaration of invalidity on the basis that he had a right to the name under national law (Art 52(2) CTMR) referring in this case to Article 8(3) of the Italian Industrial Property Code (CPI), which provides that personal names of well known people may be registered by the proprietor or with his consent, and no such consent had been given.

Despite the general assignment to the Japanese company, OHIM found that his name was well-known and that there was no evidence that Elio had given his consent to the registration of that name as a CTM; thus allowing the declaration of invalidity.

Edwin appealed and in April 2006, the Board of Appeal (BOA) decided in favour of Edwin and annulled the decision of OHIM. Their reason for doing so was that the Board of Appeal considered Article 8(3) was intended to prevent third parties exploiting the name of a famous person for commercial purposes, but that Elio himself had already exploited his name for commercial purposes and, therefore, the provision did not apply. The Board also noted that, as far as Art 50(1)(c)

Elio Fiorucci's trade marks were included in the sale of his company to Edwin



➤ Elio Fiorucci

Fiorucci is an Italian fashion label founded by Elio Fiorucci in 1967. The first shop exposed Milan to the styles of Swinging London and American classics such as the T-shirt and jeans.

was concerned neither the trade mark nor its use could mislead the public.

In turn, Elio Fiorucci appealed to the General Court. He sought the cancellation of the BOA's decision and a declaration revoking or invalidating the CTM.

The General Court rejected his plea for revocation on the basis that there was no indication that the consumer would be misled. However, as far as the application for a declaration of invalidity was concerned, the Court considered that the Board had erred in its interpretation of Art 8(3) CPI, and had incorrectly ruled out the application of that provision to the case of Mr Fiorucci.

The Court in this instance annulled the Board of Appeal's decision, insofar as it contained an error in the interpretation of Art 8(3) CPI, and dismissed the remainder of the action. On the issue surrounding the assignment of the mark to Edwin, the Court held simply that the question of whether or not the name had been properly assigned to Edwin had not been examined by the BOA and that it could not substitute its own reasoning on this issue, for that of the BOA.

The judgment of the General Court was appealed as follows: Edwin challenged the judgment before the Court of Justice of the European Union (CJEU) on the basis that the General Court misapplied the provisions of Art 52(2) CTMR and misinterpreted Art 8(3) CPI, that Mr Fiorucci had not proven that he had refused his consent, and that Mr Fiorucci had already assigned all rights in his name to them and that the General Court had not properly examined this issue, nor had it referred the question back to the BOA for re-examination; Mr Fiorucci argued that all parts of his appeal to the General Court should be allowed, including the cancellation of the CTM registration in the name of Edwin, and that costs of the appeal should be reimbursed to him; and OHIM argued that the CJEU should set aside the judgment under appeal or alternatively refer the case back to the GC for further examination of the disputed matters which were, in error, not

examined, and order Elio Fiorucci to pay their costs.

The decision of the CJEU was that the appeal against the General Court's decision must be dismissed in its entirety. Both Edwin and OHIM were ordered to meet their own costs and to contribute between them three quarters of the cost of Mr Fiorucci. Mr Fiorucci was ordered to pay one quarter of his own costs.

The CJEU points out that, in the context of the lack of consideration given to the question of the assignment, the GC gave the BOA a clear indication of the action it should take by making an express reference to the lack of examination of that argument.

It will be interesting to see, when the matter is finalised, whether the assignment taken by Edwin will be found to have included the mark ELIO FIORUCCI, and how this affects Mr Fiorucci's rights under Art 8(3) CPI.

The case brings to mind the ELIZABETH EMANUEL dispute in the UK, where the designer, who together with her husband rose to fame with Princess Diana's wedding dress, assigned her trade marks with goodwill to a third party and then filed opposition and cancellation actions against applications/registrations of the mark ELIZABETH EMANUEL on the basis that the public would be misled.

In ELIZABETH EMANUEL, the assignee prevailed and, having purchased the rights to the trade mark, was responsible for guaranteeing the origin of goods sold under the mark. This is clearly an issue for individuals whose personal name becomes a brand, and is something that needs to be considered carefully if their business and brand is being sold.

Author:
Gillian Deas



Useful link:
Full text of decision T-165/06:

<http://dycip.com/t16506dec>

Article 05

OHIM Introduces Mediation Service Alternative to Appeal Proceedings

OHIM has just announced that it plans to introduce a mediation service with effect from the end of October 2011, as an alternative to proceeding with an appeal to the Board of Appeal. OHIM has trained eight of its most experienced staff to form a mediation team.

To qualify for the new mediation service an appeal must already have been filed at OHIM (with payment of the €800 fee). If mediation takes place at OHIM's premises in Alicante, there will be nothing further to pay. An alternative venue is offered at OHIM's Brussels office on payment of a fixed fee of €750.

Each year, the Board of Appeal deals with around 2,000 appeal cases, many of which take more than 18 months to reach conclusion. OHIM feels that many of such cases hold the potential for an amicable resolution, provided the right environment for discussion is offered to the parties. OHIM believes that this initiative demonstrates its commitment to providing right holders with a range of solutions for resolving trade mark and design disputes.

However, it should be noted that OHIM opposition proceedings already provide a 24 month cooling off period to allow the parties the opportunity to try to negotiate an amicable settlement. Around 80 per cent of the opposition cases handled by D Young & Co LLP settle during this time. Our Trade Mark Group and Dispute Resolution & Litigation Group are experienced in dealing with such negotiations and include highly experienced mediators. Should you have any queries about these services, please contact your usual adviser at D Young & Co.

Author:
Angela Thornton-Jackson



Useful link:
OHIM notice regarding its new mediation service

<http://dycip.com/tvLNgp>

D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

Legal 500 Results D Young & Co Ranked as Top Tier for Patents and Trade Marks 2011

We are delighted to announce that Legal 500 has once again rated D Young & Co as a leading UK IP firm, ranking us as top tier in all three PATMA (patent and trade mark attorney) categories, and for the 10th consecutive year for the Trade Mark Group. Legal 500 recommendations are largely based upon client assessment and comments, so we are particularly grateful to our clients for their invaluable contribution to the research process.

In this year's Legal 500 report, clients say that the D Young & Co Trade Mark Group is "top of its field" with "extensive knowledge".

Our Patent Group has "strong acumen in defending patents" and "deep knowledge and understanding of the science behind patented inventions".

Legal 500 also notes that we are the first firm of patent and trade mark attorneys to establish a Legal Disciplinary Practice (LDP) and highlight our recently established Dispute Resolution & Litigation Group, headed up by "great litigator" partner Ian Starr.

The full report can be viewed online at www.dyoung.com/news-legal5002011

Trade Mark Group News

Congratulations

To Helen Cawley, our new partner in the Trade Mark Group.

Partner

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