

January 2020

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Comparison of signs What is the correct approach to the comparison of signs in EU trade mark law?

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Following the UK's December general election, 2019 closes with more certainty that the UK will leave the EU at the end of January 2020. We will continue to update you on developments during January and on into the New Year and readers may wish to bookmark our website IP & Brexit guide for our latest updates (www.dyoung.com/knowledgebank/ip-brexit).

On behalf of all of us at D Young & Co, we wish you and your families an enjoyable festive season and best wishes for the New Year.

The D Young & Co trade mark team, January 2020

Events



05 February 2020

IP Inclusive women in IP annual event

Partner and Solicitor) Anna Reid of our dispute resolution & legal team will be attending the annual IP Inclusive panel discussion aimed at shedding gender stereotypes and recognising individual traits to create inclusive teams.

www.dyoung.com/news-events

Brexit news



We welcome your Brexit questions (email our advisors at brexit@dyoung.com) and regularly publish news and advice regarding Brexit on our website: www.dyoung.com/knowledgebank/ip-brexit.

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EU trade marks

Comparison of signs What is the correct approach to the comparison of signs in EU trade mark law?

The Advocate General opines on an important question of European Union Trade Mark law. Different approaches to the comparison of signs have developed through case-law. Will the European Court of Justice take this opportunity to clarify which one is correct?

Background to the case

Equivalenza Manufactory SL applied to register the mark shown below left, in relation to perfumes (class 3) in 2014.

The application was opposed by ITM Enterprises SAS on the basis of conflict with its earlier mark below right, registered for identical and highly similar goods (also in class 3).



The EUIPO Opposition Division upheld the opposition on the basis of similarity of the marks and the existence of a likelihood of confusion. That decision was affirmed by the EUIPO Board of Appeal but then overturned by the General Court (GC) which held that the marks were not similar.

GC's assessment of similarity of signs

Specifically, as regards the assessment of similarity of the signs, the GC held that they were visually and conceptually different, and aurally similar to an average degree. The GC then carried out a **global** assessment of the similarity of the signs, including the fact that the visual aspects were particularly important because the average consumer of perfumes usually sees the goods and at least to some extent bases his/her purchasing decision on their visual appearance. Thus, the GC concluded that overall the signs were **not similar**. Accordingly, since the requirement for similarity of signs had not been fulfilled, the Board of Appeal had erred in finding a likelihood of confusion.

The case was then appealed to the CJEU.

Question before the CJEU

The case raises a fundamental question regarding the application of EUTM Regulation Art.8 (1)(b) based on likelihood of confusion.

To recap, Art. 8(1)(b) provides as follows: Upon opposition by the proprietor of an earlier trade mark, the trade mark applied for shall not be registered: ... (b) if, because of its identity with, or similarity to, the earlier trade mark and the identity or similarity of the goods or services covered by the trade marks there exists a likelihood of confusion on the part of the public in the territory in which the earlier trade mark is protected; the likelihood of confusion includes the likelihood of association with the earlier trade mark.

Thus, similarity (at least) between the trade mark applied for and the earlier mark is a prerequisite for a finding of likelihood of confusion.

Given the global assessment approach adopted by the GC, the EUIPO asked the CJEU to specify the method by which, and the circumstances in which, it can be considered that two signs do not satisfy the condition of similarity under Art. 8(1)(b).

AG's opinion

In his opinion, the AG commented that the case-law has not been consistent, with two lines of cases developing. It is therefore important for the CJEU to clarify which one is correct.

The 'strict' approach

This approach, adopted in the majority of cases, is as follows:

- At the stage of comparing the signs, it is necessary simply to compare the visual, aural and conceptual aspects of each.

➤ *Case details at a glance*

Jurisdiction: European Union

Decision level: European Court of Justice (AG opinion)

Parties: EUIPO v Equivalenza Manufactory SL (third party ITM Enterprises SAS)

Date: 14 November 2019

Citation: C-328/18

Link to decision: <https://dycip.com/c-32818>

IP & Brexit

Brexit update UK general election 2019

Should EU trade mark law take the flexible or the strict approach to comparison of signs?



- Where similarity, even if only weak, is found in at least one of those aspects, the signs must be regarded as similar.
- Only if the signs are regarded as similar does one go on to consider whether there is a likelihood of confusion. The assessment of likelihood of confusion involves a 'global assessment' (as is long-established by the case-law), however the global assessment does not take place at the earlier stage of assessing whether the marks are similar to begin with.

The 'flexible' approach

The alternative method, adopted by the GC in this case, is as follows:

- At the stage of comparing the signs, it is necessary to compare the visual, aural and conceptual aspects of each sign.
- Having found some degree of similarity in at least one of those aspects, it is also necessary to carry out an additional analysis to determine the 'overall impression' created by the signs which, if different, should lead to the conclusion that the signs are not similar.
- As part of the assessment of 'overall impression' (that is, still at the stage of deciding whether the signs are similar), it is permissible to look at factors such as the way in which the goods are marketed.

The AG reviewed these two lines of cases and opined that the 'strict' approach is the correct one. This, he commented, was

more in line with the scheme and wording of Art. 8(1)(b) itself. The 'flexible' approach, on the other hand, confuses two analyses (that is, similarity of signs and likelihood of confusion) and entails to some extent prejudging, at the stage of comparing the signs, whether or not there is a likelihood of confusion.

Accordingly, the AG recommended that the CJEU should allow the appeal and set aside the GC's decision.

Significance of the case

This is an important opportunity for the CJEU to clarify the correct approach to the comparison of signs, against a background of inconsistent and confusing case-law.

The EUIPO, having identified the importance of this question, has specifically asked the court for clarification.

It remains to be seen whether the CJEU will take up this challenge and, if so, whether it will follow the opinion of the AG.

Alternatively, will the court confine itself to the specific facts of the case and decline to provide clarification of the law in general? We will report on the judgment itself in due course.

Author:

Tamsin Holman



IP after Brexit guide



The Conservative Party has won the December UK general election with a majority that will allow the Prime Minister to pass legislation relating to Brexit with relative ease.

It is therefore likely that the UK will leave the EU on or by 31 January 2020 at which point, assuming the Withdrawal Deal is agreed by Parliament, the transition period will begin and remain in place until at least 31 December 2020. During the transition period the UK will be governed by EU legislation and will remain in the EU trade mark and design regime but will not be a formal member of the EU. If the Withdrawal Deal is not agreed then the UK will leave the EU immediately on 31 January 2020 with no transition period. We write this update as we go to print in December 2019 and will update readers with further information as and when it is available.

For D Young & Co it is business as usual. As a European firm with an office in Munich, we are able to continue to represent you both in the UK and at the EUIPO regardless of the form Brexit takes and when it happens. There will be no change to the level of service that we provide following the UK's departure from the EU.



Please view our "IP After Brexit" guide for further information:
www.dyoung.com/knowledgebank/ip-brexit.

Nivea Recognise the blue?

After more than a decade, Beiersdorf's abstract colour mark for NIVEA BLUE remains registered. The trade mark dispute, which has kept *inter alia* the German Federal Patent Court (Bundespatentgericht – BPatG) and the German Federal Supreme Court (Bundesgerichtshof – BGH) busy for over ten years has finally come to an end. Rather unspectacularly Unilever at last withdrew its cancellation request and the NIVEA BLUE is still on the register.

Office proceedings

On 30 November 2005 Beiersdorf applied for the abstract colour mark DE 305 71 072 "Blue" (Pantone 280C):

The NIVEA BLUE mark was registered on 12 November 2007 for "preparations for body and beauty care, namely skin and body care products". In January 2009 Unilever filed for cancellation based on absolute grounds. According to Unilever, the mark did not meet the requirements of acquired distinctiveness and, thus, lacked distinctiveness.

The German Patent and Trade Mark Office (Deutsches Patent- und Markenamt – DPMA) agreed with Unilever and the NIVEA BLUE mark was cancelled.

The first BPatG decision

On appeal, the BPatG confirmed the DPMA's decision in March 2013 (docket no. BPatG 24 W (pat) 75/10). According to the BPatG, the NIVEA BLUE mark would not amount to more than a decorative background and, accordingly, would not be perceived as a trade mark.

Furthermore, the BPatG held that to establish acquired distinctiveness the owner would need to show a degree of recognition of more than 75% with the relevant public, meaning that the relevant public would need to assign the colour to a specific undertaking. As the consumer survey submitted by Beiersdorf did not confirm such recognition, Beiersdorf could not rely on acquired distinctiveness.

The case concerned skin and body care products



The BGH decision

Of course, Beiersdorf did not leave it at that, but filed a further appeal with the BGH (docket no. I ZB 65/13).

**More than 50%
recognition is sufficient
to show acquired
distinctiveness.**

In its decision, the BGH clarified that in order to demonstrate acquired distinctiveness, a degree of recognition of "only" more than 50% would suffice. In turn, the threshold of more than 75% established by the BPatG would be too high.

Aside from that, the consumer survey submitted by Beiersdorf would have been methodologically incorrect as the colour shown to the surveyed included a white border.

Consequently, the BGH remitted the case to the BPatG.

The second BPatG decision

Based on the BGH's findings, the BPatG instructed a new consumer survey with GfK SE to assess the degree of recognition of the NIVEA BLUE mark for "preparations for body and beauty care, namely skin and body care products". The consumer survey showed a degree of recognition of over 50% for deodorants, hair care products, body cleansing products, namely shower and bath products, soaps, means for shaving, namely shaving foam, shaving gel, aftershave, skin care products, and facial care products. Based on a press release from Beiersdorf the degree of recognition for skin care even exceeded 71% (see <https://dycip.com/beiersdorf-news>). Unilever did not object to these findings

Case details at a glance

Jurisdiction: Germany

Decision level: Bundespatentgericht

Parties: Unilever (revocation applicant) and Beiersdorf (trade mark owner)

Date: 18 October 2019

Docket number: 27 W (pat) 1/17

Link to decision: <https://dycip.com/niveablue>

and withdrew its cancellation request.

Naturally, Beiersdorf had an interest in adjudication and argued that the withdrawal would require Beiersdorf's consent. In addition, Beiersdorf requested that the BPatG rule on the matter by way of declaratory judgement.

**There is no justified
interest in declaring that
a cancellation action was
filed without good reason.**

The BPatG held that there was no need for Beiersdorf's consent and that Beiersdorf had no justified interest in declaratory judgement. Since the previous decisions were rendered ineffective due to the withdrawal, there was no further need for adjudication.

Author:

Yvonne Stone



In short

Acquired distinctiveness of abstract colour marks in Germany requires a degree of recognition of more than 50%. To show such recognition a consumer survey will be the decisive factor.

Following the withdrawal of a cancellation request there is no justified interest for declaratory judgement.

Similarity

McDonald's sweet dreams They're lovin' it!

After a couple of well publicised losses (see 'related articles' above right for our previous articles in January and August 2019) McDonald's finally score a victory, this time before the General Court. The case highlights however some surprising comments made by the General Court in terms of the comparison of marks regarding their similarity.

Registration was sought by the applicant for the following figurative sign:



Träumen zum kleinen Preis!

The services claimed were 'Providing temporary accommodation'. After the mark was published McDonald's filed a notice of opposition alleging a likelihood of confusion and also dilution under Articles 8(1)(b) and Article 8(5) of the EUTM Regulation.

The opposition was based on sixteen European Union trade marks (EUTMs) including the word marks McDONALD'S, Mc and BIG MAC along with the well-known German trade mark McDONALD'S, for goods in classes 29, 30 and 32 and for restaurant services in (old) class 42. McDonalds claimed a reputation for all of the goods and services covered by their marks in these classes.

No reputation or use was claimed for the provision of accommodation.

In March 2017 the Opposition Division rejected the opposition in its entirety. It held McDonald's had failed to prove a reputation for the majority of the goods and services claimed only finding a reputation for the following services.

Services rendered or associated with operating and franchising restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities;

Case details at a glance

Jurisdiction: European Union

Decision level: General Court

Parties: McDreams Hotel GmbH (appellant) v EUIPO (defendant)

Date: 10 October 2019

Citation: T-428/18

Link to decision: <https://dycip.com/t-42818>

Related articles

"McDonald's BIG MAC trade mark cancelled due to non-use", Richard Burton, 23 January 2019 August 2019: <https://dycip.com/bigmac>

"Supermac's clocks up another success against McDonald's EU trade mark 'Mc'", Richard Burton, 08 August 2019: <https://dycip.com/mc>

preparation and provision of carry-out food. It concluded that the relevant public would not make a mental connection between the earlier sign 'McDONALD'S' and the contested sign, that is to say, establish a 'link' between them.

Considering the global assessment the Opposition Division found that the strong differences between the marks, in particular the different overall impressions conveyed by them, counterbalanced the similarities found between them and the similarity to a low degree of the services and would prevail over the enhanced degree of distinctiveness of the earlier mark.

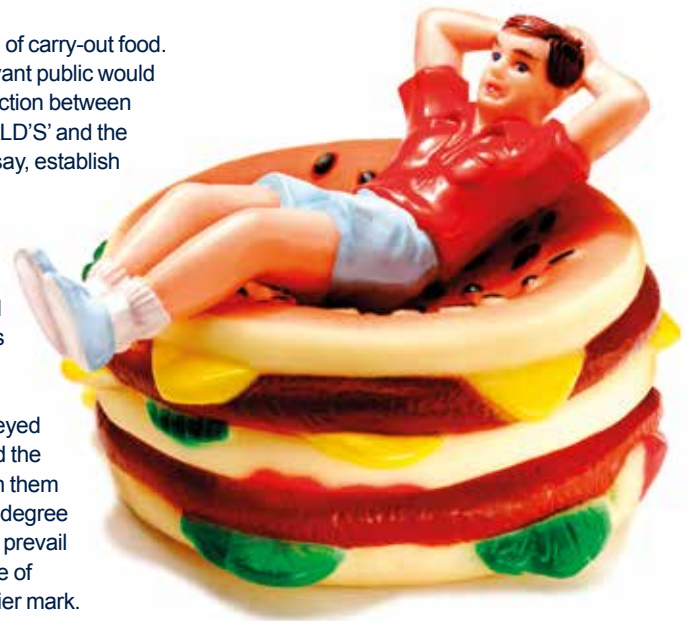
McDonald's appealed and in April 2018 the Board of Appeal (BoA) upheld the appeal and annulled the Opposition Division's decision. It agreed there was no likelihood of confusion but found that the conditions for Article 8 (5) had been met. It held that as the most dominant and distinctive element of the mark applied for was "mc dreams" it "fitted very well" in the opponent's family of marks. The BoA concluded that an unfair advantage would be taken by the registration of this.

The applicant appealed to the General Court (GC).

The GC in comparing the marks somewhat surprisingly stated: "it is appropriate to take into account the fact that the phrases 'dreams' and 'donald's' begin and end with the same consonants, 'd' and 's'". From this they concluded there was a similarity between the marks albeit a low one, reinforced by the existence of the opponent's family of marks.

The GC then asserted that "there is, at the very least, a significant degree of closeness between [the two sets of] services within the meaning of the case-law" including the case of MACCOFFEE, T-518/13.

The court then turned to the question of the link, and confirmed the BoA's conclusion



that the reputation of the earlier mark was exceptional and from this, an unfair advantage was being taken. Having found in McDonald's favour on those points it was unsurprising for the GC to go on and say, following the case of Specsavers C-252/12, "the mark applied for uses a combination of colours which is similar, although not identical, to that most frequently used by" the opponent, which assists reinforcing the finding that the use without due cause of the mark applied for would take unfair advantage of the repute of the earlier trade mark.

Feeling a need to reinforce their decision they felt compelled to say: "...with "the sentence 'träumen zum kleinen preis!' ('sweet dreams at low prices'), such a notion would not be far removed from the idea of low-cost meals that can be conveyed by the mark McDONALD'S".

Did Ronald just get lucky? At the time of writing a further appeal to the CJEU is possible. To us, the position adopted by the Opposition Division was not unreasonable. The question raised in the Black Label case (reported on page 02 of this newsletter) looking at the global assessment is one where some clarity from the CJEU would be welcome.

Author:
Jeremy Pennant

Shnuggle v Munchkin IPEC rules in favour of Munchkin in baby bath design dispute

➤ **Case details at a glance**
 Jurisdiction: *England & Wales*
 Decision level: *IPEC*
 Parties: *Shnuggle Limited (claimant) and Munchkin, Inc and Lindam Limited (defendants)*
 Date: *20 November 2019*
 Citation: *[2019] EWHC 3149 (IPEC)*
 Decision: *https://dycip.com/ewhc3149-ipec*

In *Shnuggle v Munchkin*, the Intellectual Property Enterprise Court (IPEC) of England & Wales has found that Munchkin did not infringe Shnuggle's registered Community designs and unregistered UK design rights by importing and selling its baby bath, the Sit & Soak, into the EU and UK respectively.

Background

In 2012 and 2013, Shnuggle developed its first baby bath (made from expanded polypropylene foam), referred to as the MK1. It was first sold in January 2014. A Registered Community design (RCD) for the MK1 was filed on 20 April 2013 (RCD '196).

Shnuggle was not satisfied with aspects of the MK1 and, therefore, in 2014 it developed the MK2 (which was made from injection moulded polypropylene). This was first sold in early 2015. An RCD was filed on the 20 January 2015 (RCD '763). Importantly, RCD '196 was prior art to RCD '763.



RCD '196

RCD '763

Shnuggle claimed one unregistered design right (UDR) in the MK1 and five UDRs in the MK2. In each instance, the design was to an element of the MK1 or MK2. This element was denoted by identifying on the design those elements which were **excluded** from the design. An example is depicted below. Importantly, elements of the MK2 were copied from the MK1.



Design 4 (MK2). Red denotes excluded elements.

In October and November 2017, Munchkin designed the Sit & Soak. During the design process, the MK2 was a point of reference.

The Sit & Soak is depicted below.



Sit & Soak

In advance of the Sit & Soak launching in the UK, Shnuggle commenced proceedings against Munchkin alleging infringement of the two RCDs and six UDRs.

Decision

In relation to RCD '196, the court held that (while valid) it was not infringed. The judge, Her Honour Melissa Clarke, considered that the following differences would be identified by the informed user:

- the teardrop shape of the Sit & Soak (rather than the flared oval shape of RCD '196);
- the thin, floating edge of the Sit & Soak which is pulled out from the sides in front of the bath (rather than the solid rim of RCD '196);
- the use of the handle in the Sit & Soak (rather than the unobtrusive handles at the side of the rim of RCD '196);
- the back pad of the Sit & Soak (RCD '196 not having such a pad);
- the presence of a drain in the Sit & Soak (RCD '196 not having a drain);
- the different shape bump in the Sit & Soak; and
- the colour of the Sit & Soak (RCD '196 being limited to blue).

In relation to RCD '763, the court held that this was invalid because it lacked individual character when compared to

RCD '196. In any event, it was not infringed because the Sit & Soak gave a different overall impression to the informed user for the same reasons as RCD '196.

Regarding the UDRs, three of the six lacked originality as the elements which were denoted in the MK2 designs were copied from the MK1. Of the remaining three designs, two were commonplace but the third was not (being commonplace at only a high level of generality). In relation to the latter design, while there had been indirect copying, the Sit & Soak did not produce it exactly or substantially.

In addition to the above, Munchkin sought to argue that the UDRs did not subsist because they were not a "part" of the article. In particular, Munchkin submitted that each was an "aspect" of the shape or configuration of the whole or part of an article and, as a result of the change in law by the Intellectual Property Act 2014 (which excised design protection for "aspects"), they were precluded from subsisting.

The court rejected the submission. Having summarised the law, HHJ Clarke applied it to the facts, holding: "I am satisfied that each of the designs is for an actual not abstract part, or concrete part, of the relevant bath. I do not think the arbitrariness or otherwise of a line indicating what is excluded is what dictates whether a design is a concrete or actual part on the one hand or abstract on the other. The issue is whether it is an actual part of the article and whether it can be identified as such. The pink [red] colour is also virtual and arbitrary, but the colour and lines together identify clearly what is excluded and what is not."

Author:
 Antony Craggs



D Young & Co acted for the successful defendant, Munchkin in this case.

Bent(ley) out of shape in trademark dispute

Small UK business wins branded clothing case

Case details at a glance

Jurisdiction: England & Wales

Decision level: High Court

Parties: Bentley 1962 Limited and Brandlogic Limited (claimants) and Bentley Motors Limited (defendant)

Date: 01 November 2019

Citation: [2019] EWHC 2925 (Ch)

Decision: <https://dycip.com/bentley>

In *Bentley 1962 Ltd v Bentley Motors Ltd* ([2019] EWHC 2925 (Ch)), the High Court has found Bentley Motors to have infringed trade marks belonging to a small UK-based clothing company.

While not a landmark case, the decision highlights the importance of trade mark registrations for even the smallest of businesses.

Background

Collectively called “Bentley Clothing”, the two claimants consisted of Bentley 1962, the owner of the rights in issue, and Brandlogic, a family-run firm selling clothes under the brand BENTLEY. Bentley Motors is the famous manufacturer of luxury vehicles. Bentley Clothing could trace its use of the BENTLEY sign on clothing back to 1962, and additionally owned three UK trade marks for BENTLEY, each registered for goods in class 25, including a figurative mark, a series mark and a word mark.

Bentley Motors used the device shown below (called the “combination sign”, being two elements: the word “Bentley” and the “B-in-Wings” device) on clothing and headgear, which formed the basis of Bentley Clothing’s complaint.



BENTLEY

Judgment

The central question for the court was to determine whether the average consumer would perceive Bentley Motors’ use of the combination sign on clothing as being one sign or two, ultimately impacting on whether there could be double identity infringement of the BENTLEY trade mark(s) or whether the combination sign was confusingly similar (or both).

In relation to Section 10(1) of the Trade Marks Act 1994, Bentley Motors agreed that

if the combination sign was perceived as two separate signs, there would be double identity infringement of the BENTLEY word and series mark. The judge was shown various licencing agreements, swing tags and terms and conditions from 2005 onward. He found that Bentley Motors themselves likely considered the elements as two separate signs until 2014, after which brand guidelines said that the two signs would be used together “from now on”. The judge held that the average consumer in the early 2000s would have come to this conclusion naturally as a result of Bentley Motor’s previous use of the separate elements and likely after 2014 as well, as the consumer would not be aware of Bentley Motors’ brand intentions and the elements continued to be used as separate signs after that date.

The judge therefore found that there had been double identity infringement of the BENTLEY trade marks.

Despite having found infringement, the judge considered whether there was likelihood of confusion under Section 10(2) of the Trade Marks Act 1994 in any event.

Bentley Motors argued that, from at least 2002, the average consumer would only think of Bentley Motors and not Bentley Clothing when seeing clothes with the combination sign, given the significant reputation it enjoyed. On assessment, referencing *Maier* ([2015] EWCA Civ 220), the judge confirmed that the court must assume a notional and fair use of the registered trade mark, meaning that Bentley Clothing’s modest use of the marks to that point was irrelevant. The court then held that the dominant component of the combination sign is the word BENTLEY and would therefore lead to a likelihood of confusion.

The first of two defences that Bentley Motors ran was a technical one. Under the transitional provisions of the Trade Marks

Act 1994, it is a defence to infringement where the act is a continuing one and was lawful prior to the 1994 Act, but rendered unlawful subsequently. In this case, under the old law, goods or services sold not otherwise covered under a registered trade mark would be considered lawful.

Prior to 1994, Bentley Motors sold jackets, silks, ties, caps and scarves in a catalogue marked “The Bentley Selection”, none of which were covered under the relevant mark. The judge held that Bentley Motors could continue this practice. Bentley Motors, however, sought to rely on this provision as a wider defence to infringement. In their view, the word BENTLEY is the dominant element of both “The Bentley Selection” sign and the combination sign, which amounts to a continuation of its use of “The Bentley Selection” sign.

The judge disagreed. He held that it was clearly not the intention of Parliament to allow a party to branch out into new uses of the sign by permitting use of a different mark in relation to a wider scope of goods.

The second defence of honest concurrent use was equally unsuccessful. The judge considered the evidence whether Bentley Motor’s behaviour was consistent with honest use, or whether it encroached on Bentley Clothing’s goodwill by taking steps to “exacerbate the level of tolerable confusion”.

The court concluded that whilst there had initially been honest and concurrent use of the combination sign, this ceased to be the case as there was a clear pattern of encroachment, in particular because, since at least 2000, Bentley Motors had deliberately made incrementally increasing use of the sign to avoid raising the ire of Bentley Clothing.

Authors:

Jake Hayes & Alban Radivojevic



This article (in shortened format) first appeared on WTR Daily, part of World Trademark Review, in November 2019. For further information, please see www.worldtrademarkreview.com.

D YOUNG & CO INTELLECTUAL PROPERTY

And finally...

Webinar

IP after Brexit A practical guide to UK & EU trade mark and design practice

On demand: A practical guide to post-Brexit UK & EU trademark and design practice



This webinar examines the differences in the practice of the UK Intellectual Property Office and the more familiar practices of the EU Intellectual Property Office. We will walk you through the practices of the UK Intellectual Property Office and discuss trade mark applications and oppositions and design filings.

Speakers

Speakers Helen Cawley and Richard Burton are members of the Chartered Institute of Trade Mark Attorneys (CITMA). Jana Bogatz is a German attorney (Rechtsanwältin) who specialises in European trade mark and design law. Working from D Young & Co's UK and German offices Helen, Richard and Jana are able to offer a complete

guide to UK and EU practice post-Brexit.

This webinar will be of interest to non-UK/ EU based IP practitioners and in-house counsel with an interest in UK & EU filings post-Brexit, trade mark and design right owners whose existing IP portfolios include UK & EU design and TM registrations, and trade mark and design right owners planning to file in the UK & EU post-Brexit.

Available now on demand
The webinar is now available on demand. For access details, please email us at registrations@dyoung.com.

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