



IP Federation Trade Mark Committee – A view from in-house

2022 was a year of revival and settling down. As we emerged from remote working brought about by the Covid pandemic, the new realities of work away from the office and the resulting benefits and challenges became clearer. The end of 2022 rear-view mirror was useful.

The almost immediate transition to remote working and complete cessation of travel from February 2020 throughout 2021 proved that our IP and broader service teams were nimble. In-house and external legal teams pivoted almost seamlessly to an online digital world. Teleconferencing and video calls catapulted previously camera-shy individuals to new ways of working and interaction. Trade mark offices and some courts turbocharged their digitalisation and remote functionalities. Were it not for the Covid pandemic surely these developments would have taken longer. Trade mark processes and litigation continued largely electronically and successfully.

On balance and perhaps surprisingly the wheels did not fall off. Some efficiencies were actually gained, and broader inclusivity grew as all employees and team members became universally remote and the in-person chat and social networks that can narrow universal opportunities were practically more difficult to facilitate. For global teams with overseas headquarters, where once regional offices were historically “remote or satellite offices” the opportunity for all team members wherever located to demonstrate their abilities grew. The ease of “I’ll pop along the corridor to chat with ...” was replaced by a more level playing field of remote interaction. There was also a real opportunity to understand more about the humans we worked and interacted with.

As we reconvened back in the office during 2022 and for broader in-person continuing professional education (CPE) events and social engagements, we felt an appreciation for social interaction particularly as we reflected on what was lacking during 2020/ 21. Yet there is still cause to recall the value created by the opportunity to focus without office banter and distraction. We all gained real time back in our working days as we avoided daily commute times and for most a better work balance. It seems a hybrid of remote and office work balance is settling in generally and neither full time return to the office or full remote working are post pandemic realities. How far and deep remote working flexibility will eventually settle may yet be determined by HR departments and leaders who face the challenges of recruitment and retention hurdles in order to compete for the best available talent on the market. The pandemic showed us that responsiveness, flexibility and agility are keys to success and a fixation with past practices less so.

The opportunity is to continue to allow time for feedback, reflection on the positives and recognition and elimination of non-value aspects of the day to day.

For the work on our desks in 2022 the reality and impact of Brexit on brand owners trade mark activity were beginning to be felt. Global portfolio owners considered the value of UK national marks, the impact of proof of use requirements and duplication of tasks and costs arising from Brexit. While external advisors grappled with their team's rights of representation in the EU and address for service questions in the UK, the impact of on-going pending EU cases and the breadth of new filing programmes consumed time in-house. The IP Federation has continued to create a helpful conduit for discussion of these topics among IP owners and advisors enabling business and industry input and feedback to key stakeholders and policy makers.

For the duration of the pandemic there was a shift to the online and virtual world and infringing activity shifted too. Phishing attacks rose and so did online infringement. The pandemic saw brand owners tackling producers of branded counterfeit face masks who seized on opportunities to cash in. While 2022 saw a return to some traditional infringement patterns – online infringement volume continued. Bricks and mortar counterfeit investigation activity continued to be impacted during 2022 as China remained largely locked down. With on-line dominance in our every day to day lives it is no surprise that the Metaverse and NFTs were key topics for 2022 trade mark webinars and headline subjects at the first in-person meeting of the International Trademark Association (INTA) since 2019.

After an historic peak of global 2021 trade mark applications, in 2022 trade mark offices saw a reduction in applications but for brand owners there did not feel much respite from the usual volume of oppositions generally and class 9 and 25 applications continued to weigh down the watch notice in-tray.

Business uncertainties still prevailed in 2022 and while there were cautious steps towards gradual opening up, supply chain constriction and the turmoil brought about by the Russia–Ukraine conflict tempered hopes of a strong bounce back. Businesses generally continued to carefully prioritise the most important work with an eye on cost management. From a trade mark perspective brand owners examined their Russian IP assets and registrations. Could trade mark acquisition, maintenance and enforcement legally continue, while respecting the legal sanctions and company policies? If it could continue, should it continue? Brand owners followed the fate of Peppa Pig in Russia with interest.

Bad faith as a general topic in light of recent cases also occupied agenda time as brand owners absorbed decisions and examined their portfolios for clarity, precision and scope of use and looked more closely at new filings to avoid potential claims of evergreening.

Lia Young, Trade Mark Committee Chair
19 January 2023