



IP Federation Trade Mark Committee

2020 has been an active year for the Trade Mark Committee. We began the year with a committee meeting at Norton Rose Fulbright, with the fabulous views of the City that firm has. Ironically, I encouraged the group to “attend the next meeting in person” as we were due to have Darren Meale of Simmons & Simmons attend to demonstrate his trade mark comparison AI tool, Rocketeer™. Little did I know at that point that we wouldn’t be meeting in person, or indeed coming to the City at all, for the rest of the year.

The UK’s departure from the EU has of course continued to be of crucial importance to trade mark owners in industry, especially with the end of the transition period looming, and has taken up a significant amount of the committee’s time. Among the topics we have considered are addresses for service (see another article in this publication for more detail); EU trade mark (EUTM) to UK trade mark conversion and the potential for duplication as a result; and approaches that members will take to EUTM filing after the end of the transition period. It has been helpful to share our approaches and perspectives on these complex topics and I hope that the results have been of merit for preparing our respective organisations for the UK’s new relationship with the EU.

In March, I was interviewed by Jonathan Walfisz of the *World Trademark Review* as part of an article he was writing on the ways UK trade mark professionals can work alongside the government to advise on IP policy. The article was published in early April with the snappy title: “Moving the needle: how trademark professionals achieve change”. It was a great opportunity to share our experiences of interacting with bodies such as the UK Intellectual Property Office (UK IPO) and generally to champion the fine work that the IP Federation does.

We have followed case law developments closely, perhaps most notably in 2020 on the *Sky v SkyKick* case¹ at the Court of Justice of the European Union (CJEU). Katharine Stephens of Bird & Bird gave us a fantastic in-depth analysis of the judgment and we explored what it could mean for us from a practical perspective. We then discussed the case again at our second committee meeting of the year following Arnold LJ’s High Court decision in the light of the CJEU judgment. The consensus was that it was generally a good thing that “total-infection” (an entire right being invalidated due to certain goods and services having been too remote) wasn’t endorsed as a concept but that it was surprising how far Sky trade marks at issue had been declared partially invalid in light of the CJEU guidance. Perhaps this could be the first area in which UK TM law could depart from EU law after the

¹ *Sky Plc, Sky International AG, Sky UK Ltd v SkyKick UK Ltd, SkyKick Inc.* (case C-371/18)
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end of the transition period? Of course, trade mark owners generally will have to be careful of overly-broad specifications in the future, but it seems fair to say that the decisions were not quite as far-reaching as they could have been, in terms of their retroactive treatment of marks.

I have continued to join the UK IPO Marks and Design Forum meetings and report back on them to the committee. These have remained invaluable forums to discuss hot topics with the UK IPO and get updates on the challenges they are facing and the developments they are implementing.

At one of our committee meetings, David Llewellyn of Arm raised the important topic of benchmarking and tracking the work we do through certain KPIs etc., and this has led to some fruitful discussions where we have shared best practices and experiences of practising trade mark law within industry. This has been particularly helpful when reacting to Covid challenges, and I for one have found it valuable to hear of others' experiences of how working life and indeed IP have been impacted. One positive of the pandemic (there aren't many, it seems wise to celebrate them!) has been an increase in attendance of committee meetings as those members with long journeys to central London or home commitments have found it easier to join virtually. I have been really impressed with the turnout this year and really valued everyone's contributions. It has also been nice to see everyone's faces (albeit only on a webcam) during meetings, something that we have not been able to do in the past with our international members.

Finally, as trailed at the start of this article, we had Darren Meale of Simmons & Simmons come to present to us on his exciting AI tool, Rocketeer, which processes data from EU Intellectual Property Office decisions and uses a clever algorithm (can you tell I'm out of my depth?) to give users the chance to compare two marks to see if the case law suggests there would be a likelihood of confusion. Darren is not proposing to replace us with the AI quite yet, as human interpretation of the results is crucial, but this is a fascinating piece of tech which demonstrates how our lives could be made easier by harnessing available data.

Thomas Hannah, Trade Mark Committee Chair