

ISSUE 02 | AUTUMN 2020

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The second lockdown brings the brighter news of possible vaccines ready for rolling out early next year. The chance for a little bit of normality is welcome news. In the UK 2021 brings Brexit, but this firm is confident about the future. With full service offices in Germany, as well as Boulton Wade, S.L. in Spain, we are ready to face the brave new world.

Welcome to the autumn edition of **boulton.bites**

As I sit in my 'home office', the real office seems like a little slice of paradise that I can't wait to revisit! Lockdown part two has descended and I know many of us all over the world are hoping that the holiday season will resemble some sort of normal. A vaccine is in sight so we can now see some light at the end of the tunnel.

Another topic that is dominating headlines here is Brexit. Given the fact that we will likely face uncertainty until the last minute as negotiations for a trade deal go down to the wire, it's a comfort to know that Boulton Wade Tennant's ability to assist clients with UK and EU rights post Brexit will not change. As many of you know, in addition to our four offices in the UK, we have full service offices in Berlin and Frankfurt in Germany, as well as Boulton Wade, S.L. in Madrid, Spain. Therefore, we are well prepared to help you with, and through, Brexit. Brexit will not affect patents, however it will impact on trade mark and design rights. You will find our recommendations for immediate action on **page 4**. Rest assured we are here to help so if you have any questions about Brexit or anything else IP related, please contact us at **boulton@boulton.com** or via your usual advisor.

Delve into this excellent edition of our newsletter and you'll find an interesting article on **Banksy from Isabel Blanco in Spain on page 13**; you can **get to know Alexander Stolz from Berlin on page 16**; and read about **defending the Defender on page 7**.

John Wallace
Head of Trade Marks and
Domain Names practice

Webinar **Why and when to search and the value of trade mark watching services**

3 December at 12.30pm

Speakers: **Felicity Hide** and **Henry Schlaefli**,
moderated by **Rachel Conroy**.

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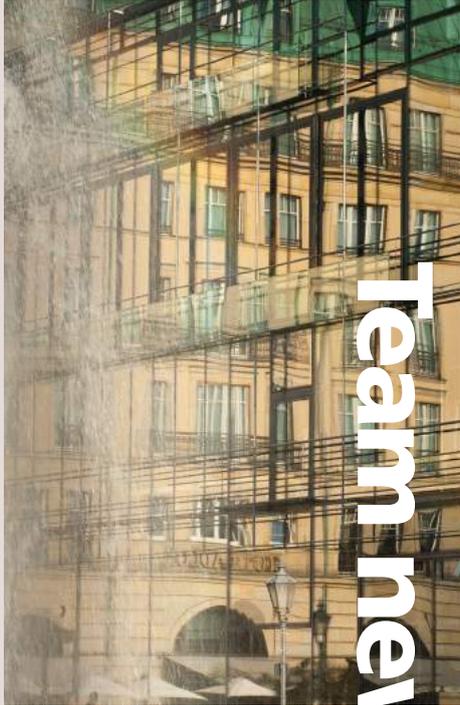
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The firm is hosting a series of webinars on hot topics that will be of interest to any brand owner or IP professional

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Brexit news

We are Brexit ready. Are you?

As the end of the transition period edges closer, we remain ready to fulfil instructions before the EUIPO as normal from 1 January 2021.

Our recent bulletin [here](#) covers some important changes to trade mark and design rights in the UK that will take place on 1 January 2021.

In preparation for the end of the transition period, we recommend:

- For Community Designs that are currently subject to deferred publication – consider publication ahead of 31 December 2020 to ensure that a UK re-registered design is created automatically without payment of any official fees;
- For rights that are due for renewal in 2021, consider whether you will wish to renew the ongoing EU right, the re-registered or comparable UK right, or both;

- Consider making a division in your records of evidence of use of your Trade Marks, clearly distinguishing between EU and UK use, from 1 January 2021;
- Consider notifying any licensees or holders of security interests that the UK re-registered or comparable rights will be coming into effect on 1 January 2021.
- Consider your co-existence and license agreements to make sure these are Brexit compliant.

If you have any questions about UK re-registered or comparable rights, or the effects of Brexit, please contact your usual advisor.



Author: Emily Scott, Trade Mark Attorney

Case in question

Reputation: a well-known fact?

Thanks to six Ballon d'Or wins, several La Liga and UEFA Champions League titles, and the most replica shirt sales of any footballer in history, Barcelona star Lionel Messi is already one of the most widely-recognised names in the sport. However, the Argentinian forward now looks set to cement his legacy even further following a positive decision by the CJEU in a lengthy trade mark battle.

The case dates back to 2011, when Mr. Messi filed an application for an EU trade mark for a figurative device resembling the letter M with his surname in stylised text below in relation to sports clothing and equipment. The application was opposed by Mr. Jaime Masferrer Coma on the basis of likelihood of confusion with his word mark MASSI, also registered for clothing and footwear, amongst other things. There followed a series of appeals by Mr. Messi until, in 2018, the General Court of the EU ruled that the player's reputation ensured a degree of conceptual dissimilarity between the two marks that was sufficiently high to counteract any aural or visual similarity. The General Court therefore found that there was no likelihood of confusion on the part of the relevant public, which they concluded would not be limited to sports fans: it was stated that the majority of people who engage with media such as television and radio would have heard of Mr. Messi.

The CJEU has now dismissed further appeals by the earlier right holder, confirming that the General Court was right to consider Mr. Messi's reputation as an individual when assessing the case, in much the same way that courts take into account the reputation of well-known brands. Indeed, the reputation of Mr. Messi's name was found to constitute a well-known fact; namely, something that is likely to be known by any person or that is available from generally accessible sources. Indeed, this was enough to negate the fact that Mr. Messi had not submitted any evidence in the earlier proceedings to support his claim of reputation: the CJEU ruled that his reputation was so great and so far-reaching that there was no burden of proof with the claim.

The opponent put forward some creative arguments, among them the fact that Mr. Messi's reputation could not be considered EU-wide because basketball is more popular than football in Lithuania and Bulgarian consumers might not recognise the name in Latin characters. They also claimed that it should only be the reputation of the earlier right that is taken into account. However, the Court dismissed these arguments on the basis that they did not challenge Mr. Messi's reputation

being a well-known fact for the majority of EU consumers and because all relevant factors should be considered when assessing likelihood of confusion, regardless of which party has the earlier right. Such factors would include the reputation of an individual filing a new trade mark application, which would influence the perception of the public of the two marks and reduce the risk of confusion.

Under EU trade mark law, marks that have earned a high level of recognition among the public can enjoy enhanced protection, for example blocking similar new applications relating to dissimilar goods and services or, as in this case, earning greater distinctive character that allows them to be differentiated from similar existing registrations. Aspiring trade mark applicants should bear in mind that this reputation can be difficult to acquire and even harder to prove: it is necessary to make substantial marketing efforts to achieve a sufficient level of awareness among the public and cases such as this typically require the submission of substantial amounts of evidence. However, following on from this case, it seems that a particularly great reputation can waive the need to provide such evidence, although the number of brand owners able to use this tactic is likely very small.

This decision sets a precedent that many of the world's best-known sports stars will be keen to follow. Most will spend many more years in retirement than as players, but having the option to make trade marked use of a name for merchandise goods can ensure continued public interest and income after they have left the field for the last time.



Authors: Felicity Hide, Partner and Timothy Greenwood, Trade Mark Assistant

Case in question

Jaguar Land Rover fails to defend the Defender

In the Spring, we explored a decision of the UK Registry to refuse six applications by Jaguar Land Rover (“JLR”) to register various Land Rover vehicle shapes as 3-D trade marks. This followed an opposition by Ineos, a company said to be interested in manufacturing an SUV bearing some similarity to the Defender.

JLR appealed this decision up to the High Court. The High Court decision was handed down on 3 August 2020 and so it’s time to revisit the case.

The decision under appeal

JLR appealed the Registry decision to refuse four of its applications to register the 3-D shapes of the following Land Rover Defender vehicles as trade marks for a range of goods and services including

electrical accessories for vehicles, vehicles, jewellery, watches and badges and vehicle repair, maintenance and customisation services.

3164283 (DEFENDER 90)



3158947 (DEFENDER 90 SPARE WHEEL)



3164282 (DEFENDER 110)



3158948 (DEFENDER 110 SPARE WHEEL)



Ineos had opposed the applications on various grounds but had only been successful in arguing that (i) the marks were devoid of inherent distinctive character other than for goods/services unrelated to motor vehicles, (ii) JLR’s evidence did not establish that the marks had acquired distinctive character through use for any goods/services, and (iii) certain goods, namely air and water-based vehicles, had been applied for in bad faith, because it was implausible that the shapes, which are clearly for land vehicles, could be used for such goods.

Grounds of appeal and decision

JLR appealed on two grounds relating to inherent and acquired distinctiveness of the marks. Ineos contended that the Hearing

JLR appealed on two grounds relating to inherent and acquired distinctiveness of the marks. Ineos contended that the Hearing Officer's ("HO") decision on these two points was correct and should be upheld.

Officer's ("HO") decision on these two points was correct and should be upheld.

JLR's first ground was that the HO had not correctly applied the test for whether the marks "depart significantly from the norms and customs of the sector", and therefore had incorrectly held that the marks lacked distinctiveness.

This failed as the judge found that the HO had carefully weighed up the evidence and was entitled to find that certain features of the vehicles depicted in the marks constituted only a minor variation on the norms of the passenger vehicle sector. The judge commented that much of the evidence that JLR used to claim that the shapes are inherently distinctive was from the perspective of motoring enthusiasts and experts, whereas it is the perception of the average consumer of passenger vehicles that is relevant.

JLR's second ground was that the HO had failed to correctly or completely assess whether the evidence showed that the marks had acquired distinctiveness through use.

The judge held that the HO had not, as JLR claimed, pre-judged the question of acquired distinctiveness based on all evidence except the survey and then approached the survey separately with that prejudice in mind, but had rather carried out a global assessment of the evidence, as required.

The judge also found that the HO did not, as JLR contended, find the absence of confusion between genuine Land Rover Defenders and modified Land Rover Defenders sold by unlicensed customisation businesses determinative, but rather this was only one factor in his decision. The judge commented

that in any case, even if JLR branding was stripped from the customised vehicles, purchasers did not rely on the shape alone to recognise the vehicle, since the evidence showed that the make and model of the base vehicle was always identified on the websites of the customisation businesses.

The judge concluded that overall, the HO had conducted a thorough assessment of the scale, length and nature of JLR's use and promotion of the shapes of the Defender models, and that he was open to find that the evidence was insufficient to demonstrate acquired distinctiveness; that is, that the shapes themselves indicate trade origin, and so the second ground of appeal failed.

Commentary

This reinforces the difficulty of securing trade mark protection for 3-D shapes, even where a product is well known, and reminds us that an appeal is not a retrial: the High Court will not substitute its own assessment unless satisfied that a HO has made a material error in law or that his or her findings are wrong.

Further appeal to the Court of Appeal is possible, and this may be why JLR opted to appeal to the High Court rather than to the Appointed Person.



Author: Donna Trysburg, Trade Mark Attorney



Insight

Geographical indications from 1 January 2021

Geographical Indication (GI) schemes protect the geographical names of food, drink and agricultural products. At the end of the transition period, the UK will set up its own GI schemes, managed by the Department for Environment, Food and Rural Affairs (Defra), and open to producers from the UK and elsewhere.

The new UK schemes will protect the geographical names of:

- food, drink and agricultural products;
- spirit drinks;
- wine; and
- aromatised wine.

They will protect the following three designations of geographical indication:

- Protected Designation of Origin (PDO)
- Protected Geographical Indication (PGI)
- Traditional Speciality Guaranteed (TSG)

Existing UK products

All existing UK products registered under the EU's GI schemes by the end of the transition period will remain protected under the new UK GI schemes.

From 1 January 2021, all UK GIs registered under the EU's GI schemes by the end of the transition period will also continue to receive protection in the EU.

New product applications

From 1 January 2021, producers will need to apply to both the relevant UK scheme to protect a new product name in Great Britain and/or to the relevant EU scheme to protect a new product name in Northern Ireland and the EU. Producers in Great Britain will need to obtain protection under the new UK schemes before applying to the EU schemes. Guidance on how to apply will be published at the end of the transition period.

New GI logos

New UK GI logos to identify products protected under the new UK schemes are available to download and can be used from 1 January 2021. Further information about the logos can be found [here](#).



Author: Hannah Cramp, Trainee Trade Mark Attorney

Case in question

Getting Internet evidence “right”

Clients involved in trade mark opposition and cancellation proceedings should note a recent decision issued by a senior Hearing Officer (“HO”) of the UK IPO.

In 2018, Garbett Licensing Limited (“GLL”) applied to register the following two UK marks.

UK3339150

floss like a boss

UK3339152



A year later, The Pyjama Factory (“TPF”) applied to invalidate (cancel) both registrations, on the grounds that “FLOSS LIKE A BOSS” is a very common saying and in widespread use.

TPF’s argument was that the marks lacked distinctive character and/or consisted exclusively of signs or indications that have become customary language (“the norm”) in trade.

TPF argued that: “FLOSS” describes a popular dance; “LIKE A BOSS” is known as ‘teenage-speak’ for something or someone being ‘cool’; and “FLOSS LIKE A BOSS” was a common term used in the UK since at least 2014 that had spread virally. They also argued that the silhouette figure in UK3339152 was used by many and showed no departure from “the norm”.

TPF’s evidence in support of their case included results of internet searches from before the filing date of the registrations. These included results for ‘free floss like a boss images in 2017’ and ‘download floss like a boss images’. Undated pages from digital libraries were also filed, showing designs containing the term “FLOSS LIKE A BOSS”, along with silhouette figures that TPF argued looked similar to the figure in UK3339152.

In reply, an employee of GLL submitted a witness statement stating that the silhouette was inspired by his son and, although he knew of the floss dance, he had never heard of the term “FLOSS LIKE A BOSS” before GLL came up with the brand and design in June 2018. The statement went on to discuss how the significant success of the brand – with 50,000 “FLOSS LIKE A BOSS” t-shirts sold on Amazon.co.uk between June 2018 and December 2019 – had led to competitors copying the design, causing GLL to apply for the trade marks.

The HO’s decision assessed the evidence and rejected certain exhibits as inadmissible for not bearing dates. Important for future evidence collation, the HO also gave an in-depth summary of how prints from internet search results can be deemed unreliable and ultimately not acceptable.

TPF argued that: “FLOSS” describes a popular dance; “LIKE A BOSS” is known as ‘teenage-speak’ for something or someone being ‘cool’; and “FLOSS LIKE A BOSS” was a common term used in the UK since at least 2014 that had spread virally. They also argued that the silhouette figure in UK3339152 was used by many and showed no departure from “the norm”.

In particular:

- Bare Google search results or ‘hits’ usually comprise short titles, generally influenced by the search term, often reproducing it. These ‘hits’ simply provide or show a website address – they do not actually show the website. This type of evidence was deemed not to support TPF’s case.
- When it came to actual website prints, TPF had used an unusual method of providing snippets of webpages, with links to their metadata purporting to show when those pages were first published; this was very different to the customary way of providing cached pages obtained from internet archive websites.
- Attention should be paid when collating evidence of customer reviews on webpages as, even if the webpage itself was first published at a given date, reviews can bear dates after the “relevant period”.

In the end, TPF succeeded in the invalidation actions. The HO held that the marks did not denote commercial origin at their time of filing. The goods bearing the marks conveyed nothing more than a statement the wearer or user of the goods wished to make – that they liked or were competent in the floss dance.

Takeaways:

- Evidence in the form of “snippets” and/or metadata to support use of a mark will very likely be rejected. This evidence is deemed unreliable because although it shows the date a webpage was launched, it does not reliably show what was on that page at that time.

- The UK Registry appears to have a preference for historic internet evidence from internet archive websites such as the Wayback Machine.
- Prints of webpages from specific dates in the past should be thoroughly reviewed before being adduced as evidence as they can, even if through some computer error, contain dates (or dated consumer reviews) after the “relevant date”.
- Think about what the actual website prints show – a lot in this case showed t-shirts bearing the words “FLOSS LIKE A BOSS” – but UK3339150 did not cover these goods – “clothing” was amended to “trousers and dresses” only, to overcome the non-distinctiveness objection raised during examination.



Author: Luke Portnow, Trade Mark Attorney

News from our
German team

What do hotellery services and sanitary equipment have in common?

At first sight, not very much. However, the European General Court (EGC) had the opportunity to take a deep dive into this question when it ruled on an opposition against an application for the mark „Adlon“ filed by a manufacturer of sanitary equipment in the name of the holder of the Adlon brand, which is actively in use through the famous luxury hotel of the identical name in Berlin, Germany. The application of the later-filed mark contained, amongst other goods, sanitary tubs and basins, bath tubs, shower trays and the like. The earlier mark is registered for hotellery services.

The Opponent claimed a reputation in the earlier mark and so the opposition was filed on the grounds that the younger mark took unfair advantage of the repute of the earlier trade mark. Although the goods of the younger mark do not resemble the services of the earlier mark at first sight, the court concluded that this does not preclude a certain proximity between the later goods and the earlier services, as it could be shown that sanitary installations and the furnishing of hotel rooms are actively marketed by hotels.

Interestingly, and beyond that, the proximity of the goods and services was underpinned by submissions filed by the sanitary equipment manufacturer during the opposition, in which they claimed that their products followed the style of the early 20th century and, in particular, the style of the Hotel Adlon. Taking this into account, the court showed leeway in its decision to consider circumstances that lie outside the wording of the respective registered goods and services.

T-144/19 / EUTM 011115961 / EUTM 002983013

Author: Sebastian Stephen, Patent Attorney



News from our Spanish team

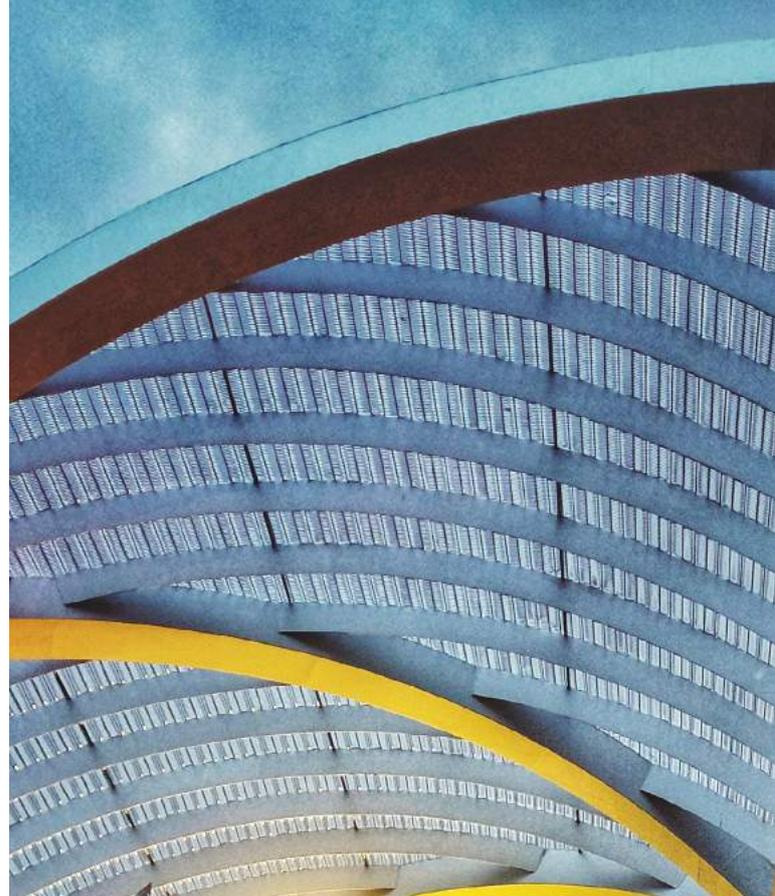
Banksy case: the risk of anonymity

Banksy, the anonymous street artist who stated “copyright is for losers” in *Wall and Piece* has lost a trade mark battle. The EUIPO (Cancellation Division) said that Banksy’s trade mark for the Flower Thrower was made in bad faith and, therefore, the European Union trade mark should be declared invalid for all the contested goods and services.

On 2014, the figurative mark represented below was registered before the EUIPO by Pest Control Office Limited (“the Proprietor”).



Subsequently, in 2019, Full Black Colour Limited (“the Applicant”) filed a declaration of invalidity against the registration on the grounds of bad faith and lack of distinctiveness and descriptiveness.



The parties’ arguments

The Applicant argued that no use had been made of the trade mark, which reproduces one of the works of the street artist Banksy, by the Proprietor, which is the corporate body that deals with the matters of Banksy. The Applicant claimed that the EUTM registration was intended to prevent the use of a work of art but the Proprietor had no intention to use the mark as a trade mark. In reply to the Applicant’s arguments, the Proprietor stated that the Applicant had failed to demonstrate bad faith and the arguments regarding the fame of Banksy should be disregarded as they are flawed and incorrectly applies the law and is contrary to the principals established in the Article 20 of the Charter of Fundamental Rights of the EU.

Conclusion

Bad faith subsists when a trade mark owner lacks any intention to use a trade mark or engage fairly in competition. Banksy launched homewares store in 2019; however, this was after the application for a declaration of invalidity was filed. The EUIPO, therefore, deemed the Proprietor not to have had an intention to use the contested EUTM as a trade mark in relation to the relevant goods and services at the time it was filed. Furthermore, given his anonymity, Banksy cannot protect their rights through copyright and so the contested trade mark seemed to be intended to remedy this lack of protection. As a result, Banksy’s trade mark was declared invalid for all the contested goods and services.



Author: Isabel Blanco, Spanish Lawyer, Boulton Wade S.L.

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Webinar series

The firm is hosting a series of webinars on hot topics that will be of interest to any brand owner or IP professional



Watch our webinars

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Why and when to search and the value of trade mark watching services

3 December at 12.30pm

Speakers: **Felicity Hide** and **Henry Schlaefli**, moderated by **Rachel Conroy**.



Felicity Hide, Partner Rachel Conroy, Partner Henry Schlaefli, Attorney

Trade Marks at the United Kingdom Intellectual Property Office

Hosted by Partners, **Catherine Wolfe** and **Rachel Conroy**.



Catherine Wolfe, Partner Rachel Conroy, Partner

UKIPO and EUIPO TM Appeal procedures – a practical guide

Hosted by Partners, **John Wallace** and **Michael C. Maier**.



John Wallace, Partner Michael C. Maier, Partner

Navigating UK Trade Mark oppositions post-Brexit

Hosted by Partner, **John Wallace** and Trade Mark Attorney, **Anusha Arunasalam**.



John Wallace, Partner Anusha Arunasalam, Trade Mark Attorney

Sky v SkyKick – Trade Mark specifications: What do you need to do now?

Hosted by Partners, **Felicity Hide** and **Rachel Conroy**.



Felicity Hide, Partner Rachel Conroy, Partner

Staff portrait



Who or what inspired you to pursue a career in IP?

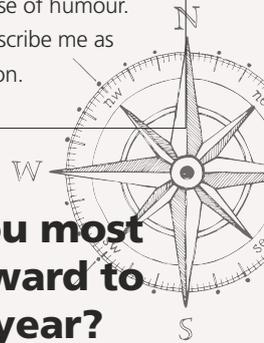
I stumbled across IP during law school, when I was offered work as a student assistant for a professor who was focused on IT and IP. Over time, I was infected by his enthusiasm.

What did you do before joining Boulton Wade Tennant?

I worked for several German corporate and boutique law firms focusing on IP. Boulton Wade Tennant is my first experience with a multinational firm and it's amazing to see how different approaches from our UK, Spanish and German offices fruitfully interact with each other.

How would your family and friends describe you?

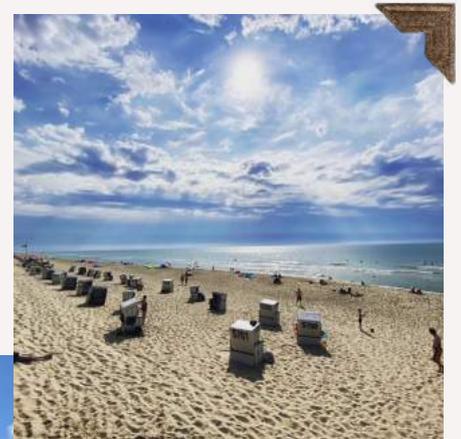
Very curious, I guess, and some would say I have a very deadpan sense of humour. I hope they would also describe me as someone they can count on.



What are you most looking forward to about next year?

My friend's wedding in the Colombian-Caribbean that got cancelled this year but will hopefully happen next year. And hopefully being able to see my UK colleagues in person more often.

Rediscovering the beauty of German coasts during Corona times



Boat trip around Mallorca's shores

What have you learnt over the past 6 months?

I have learned to organise myself efficiently and that I don't need set structures to work productively. I also learned to enjoy the flexibility of working from home, although I definitely also appreciate going to the office to see my colleagues; something I took for granted before the COVID-19 pandemic.



German Solicitor

Alexander Stolz Discusses his inspirations and interests

What do you enjoy doing outside of work?

I do enjoy cooking for - or even better, with (although they describe me as very bossy in the kitchen!) - my friends. I also enjoy travelling (beach and city trips), skiing, playing tennis, going to museums and art galleries, and shopping for furniture. I am also definitely a bookworm.



Cooking at home with my friends

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