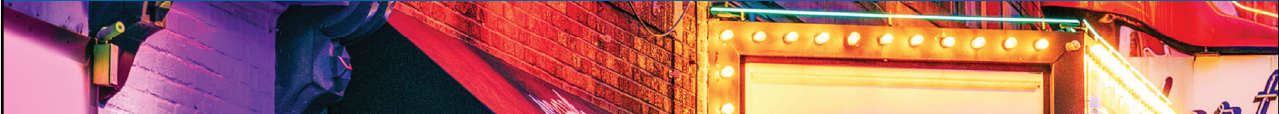




Session 5: Trademarks - Recent developments and strategies

Anna L. King, Banner Witcoff (US)
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UK Trade Mark Update

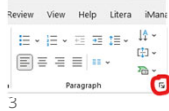
Michael Conway, Birketts LLP
26 June 2026

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Fact pattern scenario(1)

The claimant

- KatzBrew is a leading craft beer manufacturer with nationwide reputation for its conventional beer offering
- Launches new Pineapple beer, sold in 440ml cans and 4x4 can cardboard packaging – first foray into fruit-flavoured beer market
- Deliberate departure from previous packaging strategy
- Multi-million £ advertising push
- Proves to be a hit in the marketplace, sells over £20 million over a 2 year period, 99% through retail outlets, ca. 50% supermarkets



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Fact pattern scenario (2)

Registration strategy

- Registered figurative trade mark consisting of a 'flattened' 2D representation of the Pineapple beer packaging
- Filed in
 - Class 32 (beer; fruit-flavoured beer; craft beer)
 - Class 30 (fruit beverages; flavourings; syrups)
 - Class 33 (alcoholic beverages other than beer, incl. cider, spirits, cocktails)
 - Class 35 (retail services; online marketplace services)
 - Class 43 (bar and hospitality services)
- Specifications drafted broadly, capturing products/ services not in current pipeline
- Email from Head of Legal to Brand Team: "We should assume fast follower activity in this space – recommend filing as widely as possible to create a barrier to entry."
- Internal commercial email: "We'll never go into (e.g.) spirits or mixers, but a wide spec puts us in a stronger position if other retail brands go down the pineapple route."
- Strategy note (Board pack extract): "Objective is to 'ringfence' the pineapple concept in alcohol and adjacent categories to block others from moving in."

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Fact pattern scenario (3)

The defendant

Discount supermarket Crumps has a well-known strategy of producing 'dupes' just far enough away to avoid infringement

Spots success of KatzBrew product and instructs marketing team to launch a 'dupe' pineapple beer

Mimics "descriptive" indicators on the packaging (including pineapple imagery) but with different distribution, switches order of words and uses inherently distinctive CRUMPS name in expectation this will avoid infringement

KatzBrew alleges trade mark infringement based on confusion and reputation/ unfair advantage, Crumps fights back with a counter-challenge that Katz' broad trade mark registrations are invalid due to lack of intention to use across their scope



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Case law (1)

Thatchers v Aldi (CoA decision Jan 2025)

- High Court – no infringement; Aldi's lemon cider may have been inspired by Thatchers and created a mental association, but it was not similar enough, misleading enough, or exploitative enough to amount to trade mark infringement or passing off – reflecting historic approach of English Courts
- Court of Appeal – overturned and found infringement based on taking unfair advantage of reputation:
 - Similarity understated by original judge
 - "Link" not accidental – central to Aldi strategy
 - Aldi made zero investment in marketing yet sold large quantities = objective evidence of unfair advantage
 - Intent of limited relevance



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Case law (2)

Skykick (SC decision Nov 2024)

Sky commenced trade mark infringement and passing off proceedings against SkyKick in 2016

In defence, SkyKick argued that the huge breadth of goods/services covered by Sky's registrations indicated they had been filed without a genuine intention to use the marks for all the goods/services covered, rendering them invalid on the grounds of bad faith

UK Supreme Court agreed – it held no intention to use a trade mark for some or all goods/ services applied for may result in the (****partial****) cancellation of a registration on the grounds it was filed in bad faith

UKIPO PAN 1/25 issued June 2025

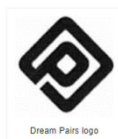


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Bonus theme – post-sale confusion

Iconix v DreamPairs (SC, June 2025) and Dryrobe v D-Robe (HC, December 2025)



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FICPI ABC Nashville Conference Trademarks (Canada)

David MG Bowden

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Quick Update: CIPO Timelines

Time to First Exam: 7.9 Months

No difference in timelines for Madrid vs. Domestic or
custom goods/services vs. pre-approved goods/services

Secondary Examination: highly variable

Approval to Advertisement: 6 to 8 weeks

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Fact Pattern (Canada)

Your client, PharmaCo, has applied in Canada to register REDI-TREAT for prescription pharmaceutical preparations.

The application has been opposed by a competitor, MediCo, based on its prior rights in the trademark READY CURE, also used in association with prescription pharmaceutical preparations.

PharmaCo intends to rely on a survey of dispensing pharmacists to demonstrate that there is no likelihood of confusion between the parties' trademarks among this group.

The survey will likely not be completed before PharmaCo's evidence deadline and may not be available until several months later.

PharmaCo seeks advice on whether it should decline to file the evidence, and then seek to file it as fresh evidence on an appeal to the Federal Court (if the Board's decision is unfavourable).



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Issue 1: Opposition Appeal Procedure

A party is no longer entitled to file fresh evidence on appeal as of right.

Opposition Board now has the authority to designate proceedings as case-managed.

Leave to file new evidence is not always granted:

- Leave granted: *Products Unlimited, Inc v Five Seasons Comfort Limited*, 2026 FC 48 (transitional period, no prejudice)
- Leave refused: *Interactive Media Inc. v. Gamechanger Media, Inc.*, 2026 FC 843 (lack of credibility, inadequate explanation of delay)

Bottom line: it may be possible to file evidence on appeal, but for the most part it is more prudent to seek case management and attempt to set deadlines through that process—even where the other side does not consent.

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Issue 2: Admissibility of Survey Evidence

Canadian Courts and the Opposition Board are skeptical of expert evidence which is directed towards likelihood of confusion.

Expert evidence relating to surveys has been characterized as an exception to this, but is still approached with "caution": *Masterpiece Inc. v Alavida Lifestyles Inc*, 2011 SCC 27

Online Surveys: *Promotion in Motion, Inc v Hershey Chocolate & Confectionery LLC*, 2026 FCA 40

Bottom Line: Survey evidence can be admissible subject to strict requirements relating to reliability and validity. There is always a risk that they could be excluded. However, online surveys are still possible.

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Issue 2: Admissibility of Survey Evidence

Issue	Explanation
Validity Issues	
"The right questions" were not put to the survey participants	Priming bias
The questions were not put to the participants "in the right way"	No "person in the loop"
The questions were not put "in the right circumstances" to participants	Availability of a "back button"
Reliability Issues	
Replicability	Unclear if in-person survey would produce same results
Relevant population	"[A]ctual Canadian Swiss-chocolate consuming population."
"Fundamental Issue"	
Design insufficient to address hearsay problem	The inability of the experts to "ensure that the identity of study participants was unquestioned" or to "control the survey environment and testing parameters"

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Issue 3: Relevant Populations for Pharmaceuticals

Relevant population for prescription pharmaceuticals includes physicians, pharmacists, AND patients: *Samsung Bioepis Co, Ltd. v. Novartis AG*, 2025 FCA 212

Confusion test is hypothetical: it doesn't matter if patients may not actually see the trademarks at issue.

Even where a patient's choice as a consumer is relatively small, that choice is still relevant.

Bottom line: even if the survey is admissible, its focus on dispensing pharmacists means that it likely won't be determinative, and may not be afforded much weight.

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**FICPI ABC Conference
Nashville**

Anna King

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Fact Pattern 1

- Your client, a famous celebrity, has become aware of AI-generated images of them online with fake audio of their voice. The images show the celebrity at a World Cup match that they never attended.



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Fact Pattern 2

- That same celebrity has become aware of AI-generated video of them used on the online retail website for a vendor of sports apparel with fake audio in their voice endorsing the vendor.



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Fact Pattern 3

- Your client, Acme Industries, has become aware of emails being sent using their company name and the signature and photo of their well-known CEO.

Acme Industries

Dear,
I wanted to take this opportunity to reach out directly regarding discounted services being offered...

Sincerely,
John Acme *John Acme*



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A vibrant neon sign for 'Jettie's Orchid Lounge'. The sign features the name 'Jettie's' in a large, stylized, cursive font with a blue and white color scheme. Below it, 'ORCHID LOUNGE' is written in a smaller, blocky font. To the right of the text is a large, glowing neon outline of a violin. The background of the sign is dark, and the neon lights are bright and colorful.

Session 6: AI in Patent Practice

Moderator: C. Gregory Gramenopoulos, Finnegan

Panelists: Chris Parsonson, Solve Intelligence
Helen Chacon, Legora
Oskar Block, Stilta

The FICPI logo consists of a white globe icon with latitude and longitude lines, centered on a blue background. The letters 'FICPI' are written in white, bold, sans-serif font across the center of the globe.
A close-up view of the neon sign for 'Jettie's Orchid Lounge', showing the glowing lights and the violin graphic.

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