

# Figure 1



CELEBRATING INNOVATION

ISSUE 06



*Meet the New Starters at  
Albright IP. See page 20*



Albright IP | PROTECTING INVENTIONS, COMPANIES AND BRANDS SINCE 2007

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ALSO AVAILABLE ONLINE

*We're proud to be supporting the Phoenix Project. See page 22*

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We're already three quarters of the way through 2021 and in spite of the pandemic, we've seen a whirlwind nine months, with lots of new clients to look after, and a considerable increase in workload thanks to Brexit.



We've brought some new talent into both our Trade Mark and Patent teams to help us respond effectively to this welcome growth.

Each new starter brings with them different specialisms which will be a great asset to us, expanding our knowledge base.

At the same time, we'll be providing training and support to help these individuals grow their careers while they are with us. We foresee continued opportunities as companies increasingly seek our help to respond to requirements for brand protection post-Brexit – European registration no longer covers the UK, so filing must be done separately.

We're keen to make sure clients don't miss out on IP protection and to help them maximise opportunities to secure their share in both existing and new markets.

The UK has always had a great reputation for innovation, but there's a risk we may lose out to foreign competition if companies don't take steps now to protect their IP. So, we must keep on innovating!

I hope you enjoy this edition.

**Robert Games**

MANAGING DIRECTOR

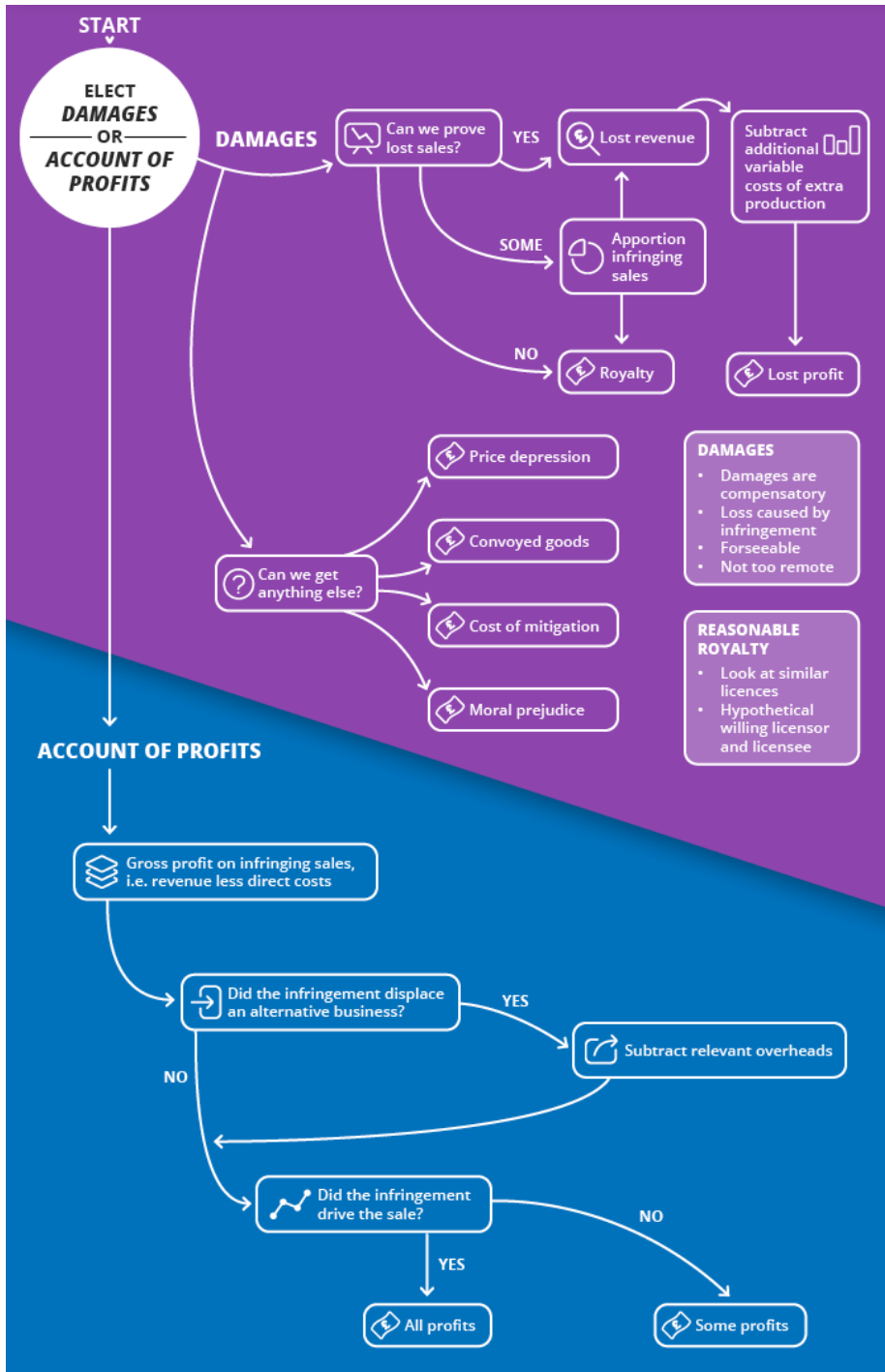
 Albright IP



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# TECHNICAL ARTICLE

## FINANCIAL COMPENSATION FOR INTELLECTUAL PROPERTY INFRINGEMENT





*In this technical article Freddie Noble, Chartered British and European Patent Attorney discusses the subject of financial compensation for Intellectual Property Infringement*

*An intellectual property right is fundamentally a right to prevent competitors from using your brand, invention, design, copyright work, or whatever. But what if they do?*

*A rightsholder who successfully sues for infringement will be able to obtain an injunction – a court order preventing the infringement from continuing. For infringements which have already occurred, there will usually be an entitlement to financial compensation.*

### **Damages or Profits**

A successful claimant will be able to choose either to claim damages – compensation for the loss that they have suffered due to the infringement, or an account of profits – the profits wrongfully made by the infringer. The claimant will obviously want to choose the remedy worth the most, and will normally be able to get an order for disclosure of the defendant's documents in order to gauge the relative value of each option.

### **Damages - Lost Sales**

In theory, damages are compensation paid to a rightsholder for the loss caused by the infringing activity. A certain number of infringing sales will have been made, but a key question is whether all of those infringing sales

represent lost sales to the rightsholder.

All sorts of factors will need to be taken into consideration. As an example, if a counterfeit or pirate product is sold at a much lower price than the original, and customers probably know that they are buying a counterfeit, then it may be very difficult to say that all of those customers would have paid full price for the genuine article if the infringement was not available.

On the other hand, if it is a very good counterfeit and sold at a similar price, so that customers are misled, then each infringing sale probably does represent a lost sale on the part of the rightsholder.

This example of counterfeit goods is relatively straightforward. In other cases, for example a patent infringement, it may be that nobody is being misled, but a rightsholder might still argue that at least a proportion of the infringing sales represent lost sales on their part. Evidence for this may end up being a little inexact. Again, multiple factors will come into it – the price of the product may be an issue; if the infringing product has aesthetic differences then perhaps some customers would not have bought the patent holder's product just because they did not like it, and so on.

In the end a Judge will have to weigh up all the evidence and come to an approximate view as to how many sales were lost by the rightsholder.





### Damages - Reasonable Royalty

What if a rightsholder can't prove lost sales for some or all of the infringements? They are still entitled to a "reasonable royalty". This is an amount determined by looking at how much a hypothetical willing licensee in the position of the infringer would have agreed to pay a hypothetical willing licensor in the position of the rightsholder. Again it is all a bit – well – hypothetical, but relevant evidence might include similar licences in the industry. For example, in "simple mechanical" patent cases, reasonable royalties often seem to be determined at about 5% of sale price.

Reasonable royalty damages often end up being a small fraction of damages for lost profits, so rightsholders will work hard to try to prove lost profits for as many sales as possible, if they think they can.

Infringement of an intellectual property right is in a sense an invasion of the property belonging to the rightsholder. There is recognition that this cannot go uncompensated, even in cases where the rightsholder can point to no other material difference in their position as a result of the infringement. "Reasonable royalty" damages are the manifestation of this principle.



### Other Heads of Damage

Any reasonably foreseeable damage caused by the wrongful infringement can in theory be recovered. Rightsholders may put forward various theories that they have lost out in different ways and need to be compensated. A few examples include damages for price depression, where a rightsholder claims that infringing activity has forced them to drop their prices; lost sales of “convoyed goods”, i.e. goods not specifically covered by the relevant IP right but which are typically sold alongside and provide additional revenue; and costs incurred in mitigating damage, for example the cost of additional advertising to counteract lost business caused by the infringement. Expenses associated with investigating infringements (separately from recoverable legal costs) may also be compensated <sup>[1]</sup>.

### Moral Prejudice and Damages for “Flagrant” Infringement

The Intellectual Property (Enforcement, etc.) Regulations 2006 <sup>[2]</sup> provide for damages awards to take into account “non-economic” factors, such as “moral prejudice”. What is that? There is relatively little guidance so far, but it probably allows – in principle – damages for “pain and suffering” and “mental distress” caused by an infringement. English Courts have been rather reluctant to award damages under this head.

In copyright cases, “additional damages” can be awarded for “flagrant” infringement, and these additional damages can be quite valuable. Additional damages go beyond the compensatory principle and can be well worth claiming.

### Account of Profits

What about the other option – an account of profits? In principle, the rightsholder is entitled to the profits which the infringer has made by infringing, most obviously by selling infringing products. In the first place this is an accounting question – what profits have actually been made by selling this particular infringing product line? This might be less than straightforward, and there could be disputes over the proper allocation of variable and fixed costs. Then what about the central overheads of the business? Whether these can be properly deducted can be a contentious issue.

The legal test is (a) whether the overheads would have been incurred anyway even if the infringement had not occurred and (b) whether the sale of infringing products would not have been replaced by the sale of non-infringing products. In other words, would the same overheads in fact have sustained a non-infringing business if the infringement had not occurred? <sup>[3]</sup>. What this boils down to is that the rightsholder is entitled to recover the extra profits the infringer made due to their choice to carry out the acts which infringed.



Overall the rightsholder is entitled to the profits due to the infringement, so that may also raise the question as to whether the fact of infringement was really driving the sale of the product – i.e. did the consumer want an infringing product, a product having the particular characteristics protected by the IP right, or did they just want a product of a certain broader category? If the infringement did not drive the sale then an apportionment may be made so that the rightsholder is only recovering the profits due to the infringement, rather than all of the profits due to sales of the infringing goods.

In some cases what this can mean is that after all this difficult accounting, an account of profits comes down to more or less the same thing as a reasonable royalty, which is the least a rightsholder can expect if they elect to claim damages. Probably for that reason, damages tends to be the more popular choice. It does all depend on the circumstances though.

An enquiry into damages or an account of profits is the very last thing that happens in IP litigation. But it is well worth both parties having a good look at the possible financial implications early in the process, because with a realistic idea of the value of a claim, a swift and agreeable compromise can often be reached, vastly reducing the legal costs of resolving a dispute.

Estimating damages can be complex, but we've made a handy flow-chart to help a little bit. Also, we would obviously be delighted to advise further on your specific case.

If you have any patent, design or trade mark infringement issues, please contact Freddie via email at [fnoble@albright-ip.co.uk](mailto:fnoble@albright-ip.co.uk), or by telephone: +44 (0) 1242 691 801 and he will be happy to advise and guide you.

### Footnotes

[1] See for example *PPL v Reader* [2005] EWHC 416 (Ch)

[2] Which implemented EU Directive 2004/48/EC and now form part of "retained EU law" following Brexit

[3] See *Design & Display Ltd v OOO Abbott & anr.* [2016] EWCA Civ 95

#### Freddie Noble

BRITISH AND EUROPEAN PATENT  
ATTORNEY



Albright IP





# BEYOND BREXIT

KEEP INNOVATING



Britain's exit from the EU has certainly thrown up challenges for companies as they seek to get to grips with the post-Brexit requirements for trade mark and design registrations.

There is now a requirement to register separately in the UK and Europe and there might be a temptation for some to reduce territorial coverage in view of the extra costs. Having said this, our advice to UK clients has always been to register first in the UK, the home territory and then extend to Europe.

We've always had a reputation in Britain for innovation. But in recent years, other countries, particularly China, have demonstrated an appetite for IP protection, filing an increasing number of registrations in the UK and Europe.

If we don't want to get left behind, then companies must wake up to the importance of protecting their innovations and ideas.

You may have secured registrations for existing brands and products, but it is important to keep innovating and protecting your new brands and designs. It's the only way to be sure of keeping your market share, of gaining a strong foothold in new markets, and preventing competitors from stepping in to fill the gaps.

Taking a continuous review and improvement approach to your product development and protection helps you to keep your business safe. If we slow down on research and innovation, or fail to secure IP in potential markets like the EU, then it's only a question of time before we will lose ground to foreign competitors.

For example, if a patent is allowed to lapse overseas, a competitor can step into your technology, make improvements and get a foothold.

Brexit may or may not be a headache for you now, but IP lasts a long time and can influence a market for years. I continue to urge all British companies to take the right strategic steps, which will allow future growth both here and abroad. There are plenty of incentives to protect your IP, with direct financial benefits from the Government. Now is a good time to secure a competitive edge for the future.

**Robert Games**

MANAGING DIRECTOR

 Albright IP



# WHY PATENT AN INVENTION?



*Figure 1 asks Albright IP Managing Director, Robert Games why should you patent an invention?*



When a prospective client approaches Albright IP, they usually have a reasonably clear idea about what they would like us to do. If they have a new innovation which they regard as an invention, then what they really want is a granted patent to protect it.

But occasionally, in fact rarely, we are asked, “What are the merits in patenting an invention?” and “Would it be better to keep my invention secret?”

In some technologies, particularly software development, secrecy can be a useful tool. This may be because a patent is not actually available due to the lack of an inventive technical contribution, or it may be because a window of 18 months’ secrecy is not considered a sufficient enough market lead time before disclosing the invention in a patent application publication.

The reality is that secrecy can only work in certain circumstances for certain products and it relies on the highest levels of corporate trust. You may consider it risky to rely on securing years of expensive research and development under a veil of secrecy. If you start marketing a product, how long is it before clever, well-funded competition will get to the invention anyway? Is it 2 years, 5 years or 10 years? Or is it 20 years, as offered by a patent monopoly?

## **A patent is a monopoly right**

The basic idea of a patent is that you disclose your idea to the patent office and if the idea is new and inventive, you are granted a monopoly for a limited period (up to 20 years). The other side of the bargain is that the idea is published 18 months after your application. This means that if the patent does not grant, or you let it lapse through non-payment of renewal fees, that the invention is available for others to use. Secrecy is lost and you are not protected.

# WHY PATENT AN INVENTION?



However, whilst you have the granted patent you have the sole right to work the invention, for example, to make it, use it, import it, export it, sell it and keep it. You also have the option to sell it, or licence it to a third party for a fee.

## **Why would you want a monopoly right?**

The ability to control an invention can lead to greater business success, because you can supply something unique. You can charge higher prices and hold back the tide of competition. Furthermore, it gives you a bargaining chip, should you want to take someone else's invention which builds on your ideas. This is called cross-licensing and can be very effective. It is an exchange of technology on agreed terms.

If an invention becomes a standard way of doing something in a field, then it may be that the invention will be licenced under FRAND terms. You are paid royalties for the licence, but the terms must be fair, reasonable and non-discriminatory. These terms are necessary for the greater good, for example, to allow a future medical advancement, or to allow everyone to use the same technology in a mobile phone. They also protect the patent holder and reward their investment in research and development.

## **Can I sell a secret?**

Yes, of course, you can sell or licence a secret. But it is difficult, because you are relying on corporate trust. Once the secret is blown, it is gone for good. There may be good recompense, but the monopoly is over.

# WHY PATENT AN INVENTION?



## Tax benefits of patenting

In the UK, profits from patented products attract large tax incentives. You may be able to reduce corporation tax on your profits from patented inventions by up to 50%. Combined with generous research and development tax breaks, innovative companies have a great incentive to develop their ideas and protect them through patenting.

## The disadvantages to patenting

Most of the disadvantages to patenting that I have heard relate to cost of obtaining a patent. However, the real cost of patenting has reduced due to improved processes and competitive pressure on patent firms. Patents should be good value and really that can only be determined by the quality of the invention combined with good commercial exploitation. They are, after all, commercial tools.

Patents can take time to obtain, but this is not always disadvantageous. Sometimes it is good to keep your competitors guessing what the scope of your granted patent may be.

But the biggest disadvantage levelled at patents is the disclosure requirement. It's true that a patent disclosure is meant to be enabling, that is a skilled person can put the invention into effect. But the requirement is to disclose the invention, not to make a viable product for your competitor.

The difference between the two is not usually small. It could take a long time for someone to reach your stage of development, and if they do, then the patent should enable you to maintain your monopoly.

I am often asked about the cost of enforcement of a patent and if it's practical. In most cases, IP disputes can be settled for a reasonably manageable cost, but IP insurance premiums are very good value and should be considered. They can help you defend your patent, but also be relied on in defending infringement allegations, should they arise.

There are no tax breaks for keeping secrets and a breach of confidentiality can be ruinous. In most technologies, secrets are not an option anyway, because a product sale or a marketing page on the internet does the disclosing and there are reverse engineers aplenty.

I'm a patent attorney, I love my work and I see patents as beneficial. Trade secrets have their place, but patents are powerful monopolies, they form an important part of corporate strategy and together with careful policies around public disclosure, they can deliver huge benefits for your firm.

**Robert Games**

MANAGING DIRECTOR

 Albright IP





## wipr 2021 leaders

Albright IP profiled in top global IP review.  
Albright IP's UK & European Trade Mark attorneys  
Katie Oliver and Julia House, have been named in  
the 2021 edition of the WIPR Leaders.

The WIPR leaders profiles the top IP attorneys from  
across the world and is published by the World  
Intellectual Property Review, a leading publication  
for legal practitioners working in intellectual  
property.

All the Leaders were chosen following a four-month  
nomination process, in which the WIPR  
sought views from 12,000 IP professionals.

*"Needless to say, we're incredibly proud of Katie and  
Julia who head up the Albright IP Trade Mark team  
and who have also recently been listed in the 2021  
World Trade Mark Review. They pride themselves on  
delivering the very best expertise to their clients and this  
recognition is further testament to it."* Commented  
Robert Games, Managing Director, Albright IP.



#WIPRLeaders2021



# DUKU FUNDING SUCCESS



*Albright IP's sister company Duku Product Design has been hard at work pushing forward the boundaries of design and innovation! It has also recently won Government funding to undertake EV charge point research – a particular specialism for the company.*

Back in August Duku received the news that they had won a slice of £20m funding to help bring the world of zero emission electric vehicles one step closer.

Announced by Transport Minister Grant Shapps, the project is one of 31 that is being funded by the Office for Zero Emission Vehicles (OZEV) in partnership with Innovate UK.

The project, which Duku will work with Urban Foresight to deliver, focuses on the development of a new EV charge point design that will be more accessible for older drivers, or those with disabilities.

*"We'll be working with another of our existing partners, Dundee City Council, to explore and trial prototype designs, with the goal of coming up with a tried-and-tested charge point that can be taken to the full production stage," said Duku director, Andrew Aylesbury.*

*"It's a great opportunity for us to build on the work we have already done with the council, Motability and leading disability sector experts to make EV charge points more accessible for all, and we're delighted to be part of the latest OZEV and Innovate UK drive towards powering up the EV transport revolution."*

Work on the new project research has already started and will take around eight months to complete.

# DUKU FUNDING SUCCESS



The OZEV and Innovate UK funding is aimed at finding technologies that will help the UK transition to a world where all new cars and vehicles will be zero emission by 2035. The winning projects address everything from smoothing the process of buying a second-hand EV and rural charging, through to improving vehicle range and charge point accessibility.

Clare Pennington, Project Manager at Urban Foresight added *"We're excited to be working with Duku and partners, building on our previous accessibility projects in the UK. It's essential that the roll out of EV charging infrastructure is accessible, not just to ensure that the government is able to meet its climate change ambitions but to enable all members of our communities to benefit from the advantages that electric vehicle ownership brings."*





*A career in intellectual property might not be the obvious choice for students planning their future. But as Figure 1 found out when we spoke to Albright Director Katie Oliver, if you've got a degree and want a role that offers variety, challenges and daily job satisfaction, it could be the perfect fit...*



### **How did you get into IP?**

It wasn't my initial goal. I did a law degree but was really quite unsure as to what direction I wanted to go in. I thought that a law degree would give me diversity and options.

During my final year, I was also following my love of horses, teaching some children with their ponies and a parent asked me what I was going to do with my law degree. He told me that he ran a Patent and Trade Mark firm. I'd only heard about IP during my degree to a certain point, but he invited me to go and spend some time with him, which I gladly did.

As soon as I was there, I loved it immediately. I loved the diversity, working with so many different clients, different products, different brands. Every day was different. I thought: "This is what I want to do."

After finishing my degree, he invited me to join the firm as a trainee.

### **What was your route to qualification?**

The initial training was two years. Then I went to Queen Mary College in London on a residential part-time course for six months. That was the first part of the qualification, which was followed by a second period of training, again in London.





This focused on the more practical aspect of the law. In total, it took me three-and-a-half years.

## **What advice would you give to anyone considering starting out in a career in IP?**

I think it's very important to get experience as soon as you can. Make contacts with people. Be persistent.

When work experience opportunities arise, grab them with both hands. Try different firms of different sizes and different locations, perhaps even solicitors with a smaller IP department rather than a pure IP firm, to just get as broad an experience as you can to see what works for you.

## **How would you describe the day-to-day job and what it involves?**

There are a lot of misconceptions about Trade Marks and Patents, and I often find myself explaining the differences to clients. So a large part of my role is education. We work with clients from startups through to multinationals, and many of them don't have IP knowledge or experience.

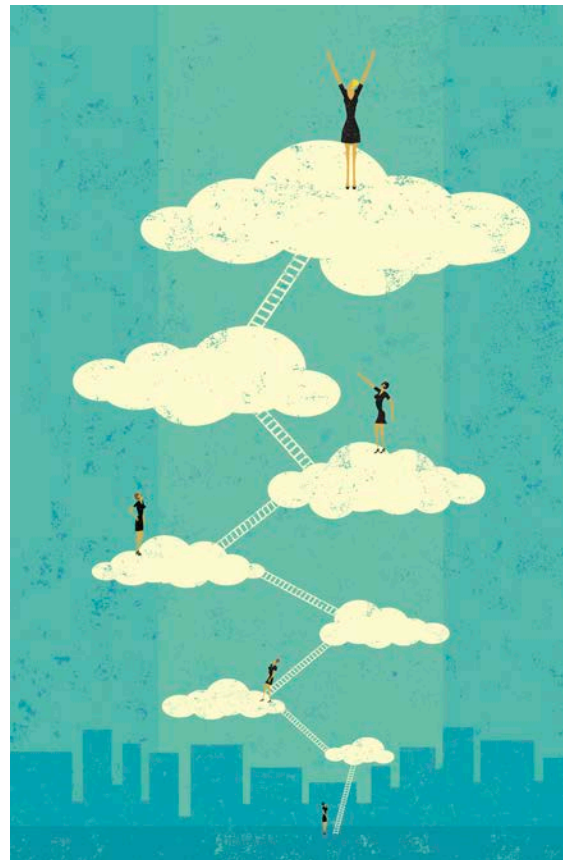
That means we need to hold the client's hand through the registration process and make sure that they are clear in their own mind as to what they're doing, why they're doing it, why it's important, and understanding it in the wider context of their whole business.

It's not just about Trade Marks but also about Registered Designs, whether that's applicable in their business, whether Patents are required,

and particularly in such cases, any non-disclosure issues. It's critical that the client understands what each right is and how it's applicable to their business.

## **If you think IP might be the career path for you, how do you choose an area of specialism or expertise?**

This will depend on your technical background. If you have a technical or science degree, then that will drive you more down the Patent side of things because you need that scientific background to be a Patent attorney.





If you're leaning is towards a law degree, then the Trade Marks area will be the right path for you.

### **What skills would you say anyone wanting to work in IP should possess?**

You've got to have passion for what you're doing. You've got to be self-motivated. You've got to be forward-thinking. You've got to have good communication skills. You've got to be prepared to work hard because the qualification route is demanding. The role is demanding. There's often quite a lot of stress involved. So, you have to be prepared to work very hard and to meet the demands of the client.

### **Is the best route to join an IP company straight after graduating – or are there alternatives?**

Usually, the best route is to join after completing your degree. But everyone is different and it might be that you have some in-house experience in a technology company in a slightly different role and then decide to move into IP. What's critical is getting on-the-job training, this is the key to unlocking your career.

Another route into IP is to start as a paralegal initially, either on the Patent or Trade Mark side. This way, you can get a very strong grounding in





the procedural aspects and then, if you've got a degree, you can move on to attorney training.

### **Is there a particular sort of person who is drawn to a career in IP?**

There's a huge diversity of people. But generally, Patent attorneys are very technical and academic, and look at things in minute detail. These traits are less necessary as a Trade Mark attorney, because they don't have to have that specialism – in a typical day they could be working in everything from clothing or a hi-tech product through to teaching or training. If you like, it's the softer side of IP!

### **What do you like best about your job?**

Diversity. Every day is different, something different is happening. I really like seeing start-up clients, watching them grow here in the UK and then expand abroad, and being part of that journey. It could be for many years. You understand their business and you travel with them. So you feel like it's a real partnership with the client.

### **What would you say to people considering joining Albright IP?**

I think the huge advantage at Albright is the exposure you will get to a very wide breadth of tasks. In many companies, you'll likely be in a role where you're doing the same repetitive task again and again. Here, in most cases, everybody gets a crack at everything, under the guidance of their partner or director. It means you get exposure to so many different types of work and client. For somebody who's coming into the

profession, that experience and opportunity is second to none.

In many cases, the senior managers are working in the same room as trainees or paralegals. So they're hearing what's going on, they're absorbing all the time. We have an open door policy and encourage people to come and talk to us, and it's a very interactive experience.

It all adds up to a brilliant learning curve for new starters and those on their qualification journeys alike.

*Katie Oliver is Trade Marks Director and a Chartered British Trade Mark Attorney at Albright IP*

**Katie Oliver**

TRADE MARK DIRECTOR



Albright IP





*Figure 1 hears from Robert Games about the new team members...*



We've been taking on new talent to deal with a growing workload driven by an expanding client base and continuing post-Brexit work. In recent weeks we've welcomed six new starters. Four of them are training as attorneys in the Patent teams.

In addition to this, two paralegals have also joined the expanding Trade Mark team and will start their training towards becoming qualified Trade Mark attorneys.

The business expansion is necessary to respond to an increasing client base and also to support clients that need additional help with

Trade Marks and Registered Designs now that the UK has left the EU.

2021 has been a very busy year for us so far and we want to make sure we're fully equipped to respond to our client needs. Brexit in particular has caused a surge in work as clients both existing and new now need to file for Trade Marks and Registered Designs separately in both the UK and in Europe.

Our Trade Mark team has worked through a backlog of 'cloned' UK registrations that automatically took place when we left the EU.



All in all, it has resulted in a lot of additional registration work in a short timescale. While it has been challenging to absorb the growing workload, our team has done a fantastic job, even while mostly working remotely. We have some amazing talent in the business, and everyone responded in a really positive way – which means we're able to continue to deliver great service.

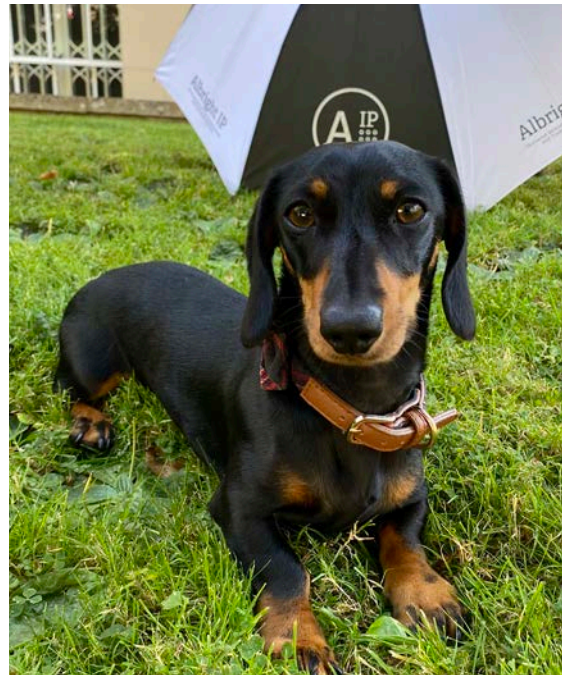
Lauren Fisher and Zainab Rhyman, both first class law graduates have joined Albright IP as trainee paralegals in the Trade Mark team. Charlie Heal, Ciara Felix, Dr Emily Taylor and Alysia Draper, have all now joined the Patent teams, bringing their own specialisms to expand the company's knowledge base.

Dr Taylor has a PhD in Chalcogenide Thin Film Materials for Next Generation Engineering Applications from Bath University, while Alysia Draper has a Masters degree in Chemistry from Cardiff University.

In addition to this Ciara Felix, has a Doctorate from Oxford University, where she studied computational research on the use of ultrasound as a non-invasive treatment for neurological disorders.

Charlie Heal has a first class Masters in Chemistry from the University of York with modules on clean technology and the use of patents in the chemical industry. His Masters focussed on the synthesis and characterisation of chromia-based hydrofluorination catalysts.

We pride ourselves in the training and support we provide to our employees to enable them to develop their careers while they are working with us. We've already taken six of our existing staff through to become qualified Patent Attorneys and I'm delighted to say that this year we've seen Adrian French successfully qualify as a European Patent Attorney.



2021 has also seen the welcome addition of Talula our new office dog who is winning hearts and minds while also keeping us all 'very aware' of when new visitors arrive!







*We're celebrating the launch of a client's new project that aims to provide new hope for disenfranchised young adults...*

An exciting new Gloucestershire-based project that aims to help young adults break the cycle of social and economic exclusion has been launched by an Albright IP client, Marksteen Adamson; the Executive creative director & partner of ASHA & CO.

We are among a number of partners and supporters of the Phoenix Village Project. The project is aimed at young adults who've missed opportunities, fallen through educational gaps, or struggled with challenges such as homelessness or addiction.

**Julia House, a Director and Chartered Trademark Attorney at Albright**, is representing the company on the Phoenix Project and is a member of its advisory panel – helping to trademark the social enterprise's new economic model, 'The Giving Share'.

The model is based on the idea of building an attractive and creatively curated home for commercial businesses that pay a contribution towards the project, in turn providing a sustainable economic foundation on which a range of social services can operate. These include social care, accredited skills training, autonomous health care and advanced mental health provision.

*"The Phoenix Village Project is a great initiative, with its goal of teaching enterprising skills and building sound minds for practical, social and personal regeneration", said Julia House.*

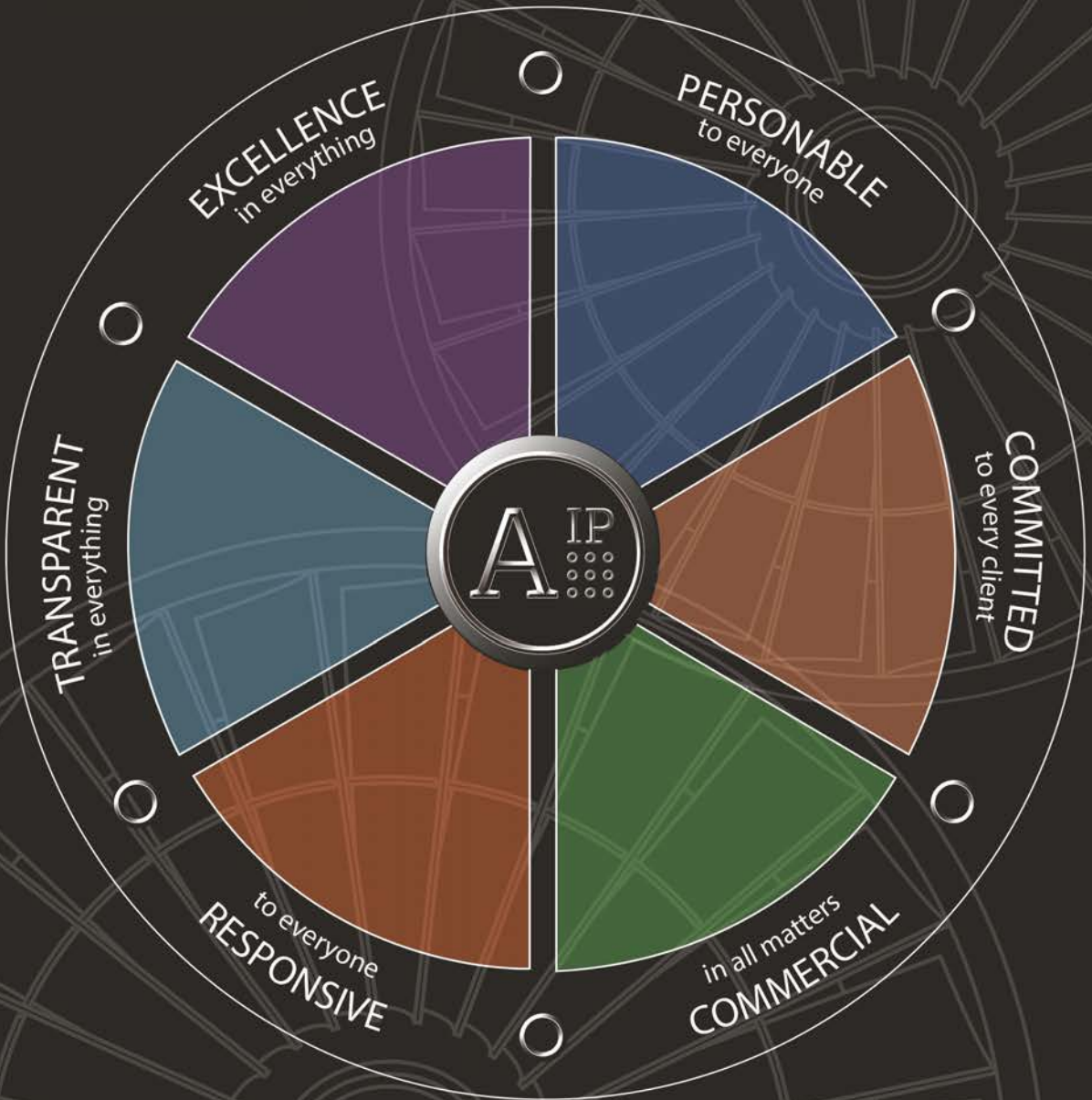
*"We're really pleased to be part of such an important project, and look forward to helping it truly take off and grow."*



Photo credit to MSLA 2021



## "Our Values"



PROTECTING INVENTIONS, COMPANIES AND BRANDS SINCE 2007

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