

Trade mark litigation in the UK (England and Wales): overview

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SOURCES OF LAW

1. What are the principal sources of law and regulation relating to trade marks and trade mark litigation?

The principal sources are legislation and decisions of the courts interpreting the legislation.

National legislation

The relevant laws include the following:

- Trade Marks Act 1994 (TMA), as amended, implements Directive 2008/95/EC (Trade Marks Directive, to be replaced by Directive (EU) 2015/2436 with effect from 15 January 2019, (new Directive)) and sets out the law relating to registration, validity and infringement of national UK trade marks.
- Trade Marks Rules 2008 (SI 2008/1797) as amended, provide more detail about procedures for filing and opposing trade mark applications in the Trade Mark Registry, which forms part of the UK Intellectual Property Office (UKIPO).
- Trade Marks (Relative Grounds) Order 2007 (SI 2007/1976) sets out specific provisions governing the grounds for refusing to register a trade mark under the TMA.
- Civil Procedure Rules (CPR) set out the detailed procedure for trade mark litigation in the courts of England and Wales.
- The national legislation above (except the CPR) applies throughout the entire UK, that is, England and Wales, Scotland and Northern Ireland. The TMA also applies to the Isle of Man, subject to exceptions and modifications.

EU legislation

Relevant EU legislation is the following:

- Regulation (EC) 207/2009 on the Community trade mark (Community Trade Mark Regulation, as amended, which created a community trade mark (CTM) and established the Office of Harmonisation for the Internal Market (OHIM) as the registry for the CTM.
- Amending Regulation (EC) 2015/2424 made changes to the CTM Regulation, now renamed the European Trade Mark Regulation (EUTMR) with effect from March 2016. A CTM is now a European (EU) Trade Mark (EUTM) and OHIM is now known as the European Union Intellectual Property Office (EUIPO).
- Regulation ((EU) 2017/1001) to codify the EU Trade Mark Regulation, and consolidate its amendments applies from 1 October 2017 (EUTM Regulation).
- Directive 2004/48/EC on the Enforcement of Intellectual Property Rights (IP Enforcement Directive) which harmonises certain enforcement mechanisms.

- The Trade Mark Directive sets out the law relating to registration, validity and infringement. The new Directive ((EU) 2015/2436) came into force on 12 January 2016 and must be implemented into the laws of member states by 15 January 2019. The UK Government has not indicated whether it intends to implement the new Directive into UK domestic law following the UK's exit from the EU (see *Question 38*).

International treaties

The UK is also a signatory to the:

- Protocol relating to the Madrid Agreement Concerning the International Registration of Marks 1989 (Madrid Protocol).
- European Convention on Human Rights (ECHR). This has no direct impact but can be raised in litigation.
- WTO Agreement on Trade-Related Aspects of Intellectual Property Rights 1994 (TRIPS).

Court decisions

England and Wales is a common law jurisdiction so non-statutory law and binding precedent judgments from prior cases form part of the law along with legislation.

COURT SYSTEM

2. Can third parties oppose/request cancellation of a national or supranational trade mark application/registration? If so, on what grounds?

A UK trade mark can be opposed before grant in the UKIPO. After grant, a UK trade mark (or an international trade mark) can be declared invalid or revoked by the UKIPO or the courts (see *Question 3*). Where the application is before a court, the procedure is more akin to a trade mark infringement action.

An EUTM can be opposed pre-grant before the EUIPO (opposition division) and can be declared invalid or revoked after grant by the EUIPO cancellation division or the EUTM courts, typically the High Court.

Opposition

Third parties can oppose a UK, EU or international trade mark application by filing a notice of opposition within two months from publication (extendable by a further month for UK marks) or within three months for EUTMs.

UK trade mark opposition proceedings begin with written statements of argument, followed by the service of written evidence, followed by a hearing.

The Trade Marks (Fast Track Opposition) (Amendment) Rules 2013 (SI 2013/2235) implemented a fast-track procedure in which there are no formal evidence rounds and hearings are unlikely. The fast

track is typically used for oppositions based on relative grounds (see below).

Relative grounds. The most frequently used grounds of opposition are the relative grounds (that is, where the opponent claims that the mark applied for is the same as or too close to its own mark).

Relative grounds for refusal of a trade mark (except where the mark is used with the consent of the proprietor of the earlier mark) are that it:

- Is identical to an earlier trade mark registered for identical goods or services.
- Is identical to an earlier trade mark registered for similar goods or services or similar to an earlier trade mark registered for identical or similar goods or services and there is a likelihood of confusion with the earlier mark.
- Is identical or similar to an earlier trade mark and the earlier mark has a reputation in the UK or, in the case of a EUTM, in the EU, and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trade mark.
- Its use in the UK is liable to be prevented by any rule of law (in particular, passing off) or by virtue of another earlier right (in particular, copyright, design right or registered designs).

Absolute grounds. UK trade marks can also be opposed on absolute grounds.

Absolute grounds for refusal are that it:

- Is incapable of graphic representation
- Is devoid of distinctive character.
- Consists of signs or indications of trade to designate the characteristics of the goods or services.
- Consists exclusively of signs or indications which have become customary in the current language or in the bona fide and established practices of the trade.
- Consists of the shape which results from the nature of the goods, or the technical shape or the shape which gives substantial value to the goods.
- Is contrary to public policy or principles of morality.
- Is deceptive.
- Is prohibited from use in the UK by any enactment, rule of law or provision of EU law.
- Is a specially protected emblem.
- Has been applied for in bad faith.

The new Directive (see Question 1) makes some changes to the absolute and relative grounds, which will alter the grounds for opposition (if the Directive is transposed into English law, see Question 38).

Invalidation/revocation

After grant, a UK mark can be subject to an application for invalidation or revocation which are, broadly speaking, on grounds equivalent to those available in an opposition (see above, *Opposition*). Alternatively, it can be revoked on the basis that the mark has not been used over a period of five years from the date of registration or any continuous five-year period after that or on the grounds that the mark has become generic or deceptive.

3. Which courts/government bodies enforce registered trade mark rights?

Trade marks are enforced primarily in the Chancery Division of the High Court, the Intellectual Property Enterprise Court (IPEC) or a County Court where there is also a Chancery District Registry. The UKIPO has no jurisdiction in relation to trade mark infringement claims. Actions for revocation and invalidity can be brought before the High Court, the IPEC, some County Courts or the UKIPO.

The Chancery Division of the High Court, the IPEC and certain other County Courts are the designated courts (EUTM courts) for infringement actions concerning EUTMs.

Criminal proceedings are available in a magistrates' court or the Crown Court depending on the seriousness of the offence.

The High Court includes specialist IP judges and most, but not all, trade mark cases are dealt with by them. The IPEC which is also part of the Chancery Division is a specialised IP court in which smaller value and less complex claims are heard by a specialist IP judge. The Court of Appeal includes judges with IP expertise who often hear trade mark appeals.

Tribunals broadly take precedence as follows:

- Supreme Court (the highest domestic tribunal).
- Court of Appeal.
- Chancery Division of the High Court.
- Intellectual Property Enterprise Court (IPEC) or certain other County Courts.
- Comptroller-General of Patents, Designs and Trade Marks (Registrar) (an administrative official having regulatory functions in respect of certain types of intellectual property and a judicial role in certain intellectual property disputes).

There is no appeal to the Court of Justice of the European Union (CJEU), which is merely a referring court for deciding questions of interpretation of EU law but its decisions take priority on these issues. The TMA must be interpreted in accordance with the Trade Mark Directive.

Following the UK's exit from the EU, the UK will no longer be able to refer questions to the CJEU for clarification of EU law (see Questions 6 and 38).

4. Who can represent parties before each court set out above?

In the High Court, parties must generally be represented by a barrister who presents the case in court. A solicitor is responsible for all other aspects of the case, in particular the conduct of the litigation and certain pre-trial hearings. Some trade mark attorneys and solicitors are qualified to appear before the High Court as advocates, but this is unusual.

In the IPEC, as in the High Court, solicitors, trade mark attorneys and litigants in person can conduct litigation and appear as advocates, although barristers are commonly used. Before the UKIPO, a party can appear personally or appoint anyone to represent them.

5. What is the language of the proceedings? Is there a choice of language?

The language of the proceedings is English. No other choice is available. Arrangements can be made for interpreters/translation, for example for witnesses.

6. To what extent are courts willing to consider, or are bound by, the decisions or opinions of other national or foreign courts that have handed down decisions in similar cases?

English courts are bound by the decisions of higher English courts and by the CJEU on questions of interpretation of EU law. Scottish and Northern Irish courts are also bound by the decisions of higher courts in their own jurisdictions.

Brexit raises significant questions on the status of CJEU jurisprudence. The UK Government's White Paper on Brexit (*Legislating for the United Kingdom's withdrawal from the European Union (Cm9446)*) states that pre-Brexit CJEU case law will be given the same precedent value in UK courts as that of the UK Supreme Court. The position is less straightforward in relation to CJEU case law decided post-Brexit. While the UK Government is clear that in leaving the EU, the direct jurisdiction of the CJEU in the UK will come to an end, it is thought in some areas, CJEU case law will have persuasive value. There is also uncertainty as to when the CJEU's jurisdiction will cease to apply: in October 2017, the UK Government indicated that CJEU case law may continue to be binding during the proposed implementation period following the UK's official departure from the EU in March 2019 (see *Question 38*).

Outside the EU, UK courts are not bound by the decisions of foreign courts, but do consider and can adopt the reasoning of foreign courts where they are considering similar concepts, particularly those of Commonwealth countries.

Limitation periods

7. What limitation periods apply to registered trade mark infringement actions?

There is a limitation period of six years for bringing a claim (five years in Scotland).

SUBSTANTIVE LAW

8. Are unregistered trade marks protected in your jurisdiction?

Unregistered trade marks are protected under the common law action of passing off. Essentially, this entitles a trader who has established a reputation or goodwill in relation to a mark or "get-up" to prevent use by others which amounts to a misrepresentation (typically to the effect that the goods are produced by or connected with the first trader) which causes (or is likely to cause) damage.

9. How is a registered trade mark infringement assessed?

The infringement provisions of the TMA are derived from the Trade Marks Directive, equivalent to those of the EUTM Regulation and, currently, interpreted in accordance with rulings of the CJEU (see *Question 6*) as well as the UK courts and UKIPO.

A person infringes a registered trade mark if he/she uses in the course of trade a sign which is:

- Identical with the trade mark in relation to identical goods or services which are identical with those for which it is registered.
- Identical with or similar to the trade mark and is used in relation to similar goods or services and there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.
- Identical with or similar to the trade mark where the trade mark has a reputation in the UK and the use of the sign, being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.

The likelihood of confusion must be appreciated globally, taking into account all factors relevant to the circumstances of the case (*Sabel v Puma [1998] RPC 199*). The overall impression created by the visual, aural and conceptual similarities and differences between the marks, and where appropriate, the goods and services to which they relate, are assessed from the perspective of the average consumer.

The new Directive (see *Question 1*), if implemented in the UK, will introduce some changes and clarifications to these provisions.

10. On what grounds may a proprietor lose rights in a registered trade mark?

In addition to the absolute and relative grounds for refusal and revocation set out in *Question 2*, a proprietor can lose rights in a registered trade mark by:

- Expiry of ten years from the date of application (unless the registration is renewed).
- Surrender by the proprietor of the trade mark by sending a notice to the Registrar.

11. What defences, if any, are available to an alleged infringer?

In addition to claiming the proprietor's trade mark is invalid (see *Question 2*), an alleged infringer may rely on the following defences:

- Use of a trade mark by a person which constitutes their own name or address. In relation to EUTMs, this now only relates to use by a natural person and not a company. The defence may be available in respect of company names for UK trade marks until the new Directive is enacted, but the position is unclear at present.
- Descriptive use of a trade mark to indicate the characteristics of goods or services.
- Use of a trade mark necessary to indicate the intended purpose of the goods or services (as accessories or spare parts). (The above defences only apply if use is in accordance with honest practices.)
- Various prior user rights.
- Overlapping trade marks: a registered trade mark is not infringed by the use of another registered trade mark in relation to goods or services for which the latter is registered (provided that in the case of a EUTM, the later trade mark cannot be invalidated. A similar position can be taken for UK trade marks given changes in the new Directive, however this has yet to be confirmed).
- Use of the trade mark relates to goods put on the market in the EEA by the owner of the trade mark or with their consent

(provided the owner does not have a legitimate reason to oppose further commercialisation of the goods). This is known as exhaustion.

12. Can a trade mark holder plead registered trade mark infringement and passing off/unfair competition in the alternative in the same action?

A trade mark holder can plead trade mark infringement and passing off in the alternative in the same action. Further, while there is no specific action of unfair competition, passing off encompasses similar issues and trade mark infringement proceedings can be combined with other claims providing similar protection, including injurious falsehood, anti-competitive claims and breach of contract, provided they can be heard by the same forum.

PARTIES TO LITIGATION

13. Who can sue for trade mark infringement?

Trade mark holder

A trade mark owner can sue for infringement of a registered trade mark. This includes co-owners, provided the other co-owners are either joined as claimant(s) or added as defendant(s) unless the court otherwise agrees. A co-owner joined as a defendant will not be liable for costs.

For passing off, the owner(s) of the goodwill can bring proceedings.

Exclusive licensee

An exclusive licensee has certain statutory rights to bring proceedings in its own name (joining the proprietor as a claimant or a defendant unless the court agrees otherwise) provided the licence is registered.

An exclusive licensee can, to the extent provided by in the licence, be given the same rights and remedies as if the licence had been an assignment. This may include the right for the exclusive licensee to bring proceedings in its own name against anyone except the proprietor. In such a case, the rights of the licensee are concurrent with those of the proprietor.

In the absence of such rights, an exclusive licensee can request the licensor to take action and where it refuses or fails to do so within two months of being called to do so.

These statutory rights are commonly excluded by express provision in the licence agreement.

Non-exclusive licensee

There are limited statutory rights (which again, can be and generally are excluded in a licence agreement) for a non-exclusive licensee to bring proceedings provided the licence is registered. These arise where a licensee calls on the proprietor to take action and the proprietor refuses to do so or fails to do so within two months. Again, the proprietor must be joined as either a claimant or defendant unless the court agrees otherwise.

The new Directive harmonises the position of licensees' rights to take action to align it with the rights of licensees of EUTMs (see *below*).

Distributor

A distributor can only bring proceedings if it is an assignee or licensee (subject to the conditions described above) of the trade mark.

Other

No other party has a right to bring proceedings.

EUTMs

Trade mark holder. The owner of an EUTM can sue for infringement after registration (damages can be claimed from the date of publication). A co-owner can claim compensation on behalf of persons who have authority to use the mark where they have suffered damage as a result of unauthorised use of the mark.

Licensees. Subject to the terms of the licence, a licensee (exclusive or non-exclusive) of an EUTM can bring infringement proceedings only with the consent of the proprietor. An exclusive licensee can do so if the proprietor does not bring proceedings after a formal notice period. In contrast to the position for UK marks, a licensee of an EUTM does not need to have registered their licence to be able to sue for infringement (*Youssef Hassan v Breiding Vertriebsgesellschaft mbH Case C-163/15*). A licensee also has the right to intervene in proceedings brought by the EUTM holder for the purposes of obtaining compensation for damage suffered.

14. Who can be sued for trade mark infringement?

Any person who has committed an infringing act (whether through an agent or otherwise) can be sued for trade mark infringement.

Where the defendant is a one-person company it may be appropriate to join the sole director as co-defendant. A director of a limited company which infringes may be personally liable for infringing acts that they personally have committed (but is not liable merely through being a director).

Alternatively, a director (or potentially a third party) may be liable as a joint tortfeasor where the director or third party has procured the company to infringe the registered trade mark or certain collaboration leading to infringement.

An employer will be liable for any infringement by its employees if such infringement occurred in the course of the employer's business and within the scope of the employee's employment, regardless of whether or not the employer had knowledge of the infringing act(s).

Where a company is guilty of a criminal offence under the TMA, any directors, managers, secretary or other similar officers who consented or connived in the offence's commission are liable. Similarly, in relation to a partnership, all culpable partners are liable but any who had no knowledge of or tried to prevent the offence are not liable.

15. What type of acts amount to primary and secondary registered trade mark infringement?

Primary acts of infringement include applying the sign to goods or their packaging, importing or exporting goods under the relevant sign and supplying services under the sign.

Secondary acts of infringement include applying a UK registered trade mark to material intended for use as labelling or packaging goods, as a business paper or for advertising goods or services, with knowledge or reason to believe, at the time of applying the mark, that the application of the mark was not duly authorised by the owner or a licensee.

Under the new Directive, various preparatory acts (which do not require knowledge) are infringements, including:

- Affixing a sign identical with, or similar to, the trade mark on packaging or labels.
- Offering or placing on the market, or stocking for those purposes packaging or labels bearing the similar or identical trade mark.

16. Under what conditions, if any, can an alleged infringer bring proceedings to obtain a declaratory judgment on non-infringement?

UK Trade Marks

Unlike patent law, UK trade mark legislation does not include any express provision for the grant of a declaration of non-infringement (DNI) in the absence of a threat to bring infringement proceedings (see *Question 19*).

DNIs are generally considered by the courts to be unusual in trade mark cases but can, in appropriate cases, serve a useful purpose. The grant of a declaration will be tested against three principles:

- The grant of a negative declaration is one of discretion, rather than of jurisdiction.
- There must be a useful purpose to the DNI.
- The underlying issue must be sufficiently clearly defined in order for it to be rendered justiciable (*Skyscape Cloud Services Ltd v Sky Plc and others* [2016] EWHC 1340 (IPEC)).

EUTMs

A declaration of non-infringement can be sought in relation to a EUTM (to the extent available under national law). The grant of a declaration by the court is discretionary.

17. Is it possible to add or remove parties during litigation?

Parties can be added during litigation if desirable, to resolve issues in dispute. This is subject to the consent of the court and the party being joined if added as a claimant. The new party must be given every opportunity to participate fully in the litigation and cannot be added at a late stage.

Where the court is satisfied that it is no longer desirable for a person or entity to be a party, they can be removed.

ENFORCEMENT OPTIONS

18. What options are open to a trade mark holder when seeking to enforce its rights in your jurisdiction?

Civil proceedings

A trade mark holder can bring civil proceedings for infringement or passing off (see *Question 12*) of a UK mark or EUTM.

Criminal proceedings

Criminal sanctions apply to certain unauthorised uses of trade marks, primarily conduct that amounts to counterfeiting, but can include unauthorised sale of goods manufactured with the permission of the trade mark holder. It is also an offence to falsify trade marks register entries or make false representations that a mark is registered. Further sanctions under the general criminal law of fraud may be relevant to trade mark infringement.

Trading standards authorities (part of local government) are primarily responsible for enforcing criminal trade mark infringement but private prosecutions are possible. The defendant is liable for a fine or prison sentence, with the fine being unlimited and a prison sentence being up to a maximum of ten years for the most serious offences, and may be subject to orders for forfeiture and confiscation under proceeds of crime legislation.

Border measures

A trade mark holder can give notice to HM Revenue & Customs of the impending arrival of infringing goods from outside the EEA or from inside the EEA if the goods have not yet been put into circulation. The goods can then be intercepted, seized and treated as prohibited goods. Customs can also take such action on their own notion.

The above domestic procedure does not apply where Regulation (EU) 608/2013 (Customs Enforcement Regulation) applies, which provides for a similar EU-wide process of notice, interception and seizure. Notably under the EUTM Regulation (and under the new Directive), trade mark holders can prevent third parties from importing infringing goods into the EU, even if those goods will not be released for circulation in the EU, provided that the trade mark holder is entitled to prohibit the goods being placed on the market in the place of final destination of the goods.

19. Is it advisable to send a letter before action (cease and desist letter) to an alleged infringer before commencing registered trade mark infringement proceedings?

There is no specific pre-action protocol for IP cases in the CPR and no requirement to send a letter before action, principally owing to the existence of threats provisions contained in the TMA. However, in cases not covered by any pre-action protocol, the CPR require litigants to act reasonably and proportionately in exchanging information and documents relevant to a claim and generally in trying to avoid the necessity for proceedings.

The threats provisions contained in the TMA, as amended by the Intellectual Property (Unjustified Threats) Act 2017 (in force 1 October 2017), provide a statutory action against groundless threats of trade mark infringements. This includes threats made in relation to EUTMs. Whether a communication is a threat is determined by whether a reasonable person in the position of the recipient of the communication would understand from the communication that there was a registered trade mark and that a person intends to bring infringement proceedings in relation to that trade mark against another person. The threat must ultimately be unjustified.

Threats of proceedings in other jurisdictions may be actionable provided they relate to an action done in the UK.

The statutory provisions enable a person who is aggrieved by threats of an infringement action to go to court demanding that the trade mark proprietor justify the threat (essentially by establishing infringement of a valid mark). If it cannot be justified, the person aggrieved is entitled to a declaration, injunction and/or damages. The legislation makes a distinction between primary and secondary infringers (in other words manufacturers or importers and retailers or customers). The actions of the primary infringer are likely to cause more damage to the proprietor and as such, a trade mark proprietor can threaten a primary infringer (now for primary as well as secondary acts of infringement) without fear of being sued for making unjustified threats. However, the new legislation introduces a safe harbour for communications ("permitted communications") to secondary infringers which might previously have been interpreted as actionable threats.

Threats of proceedings limited to passing off proceedings are not actionable threats. Similarly a threat in England of proceedings for infringement of a foreign mark is not actionable. However, care should be taken as broad or vague threats of proceedings in relation to marks or activities or to a range of jurisdictions or regions, for example "in Europe", can be interpreted as threats to bring English proceedings.

20. To what extent are your national courts able to grant cross-border or extra-territorial injunctions (preliminary or permanent)?

National registered trade marks

Both preliminary and permanent cross-border injunctions are available. The courts of the EU member states have, however, adopted a cautious approach to the grant and enforcement of cross-border injunctions in respect of national registrations. If a defendant is sued in the UK for infringement of various European national trade marks and the defendant challenges the validity of those foreign registrations, the English court is likely to decline jurisdiction under Article 24(4) of Regulation (EU) 1215/2012 (Recast Brussels Regulation).

A recent ECJ case has confirmed that this provision should be interpreted narrowly, ruling that entitlement proceedings relating to a trade mark did not come within its scope as they concerned neither the validity or the registration of the mark (*Hanssen Beleggingen BV v Tanja Prast-Knippling C-341/16*).

Only in limited circumstances in proceedings, for example, against very particular defendants where each is separately accused of the same infringement in the same countries under various national marks may it be possible for a single court to have jurisdiction under Article 8(1) of the Recast Brussels Regulation. The CJEU decisions of *G.A.T. v LuK C-4/03*, *Roche v Primus C-539/03* and *Solvay v Honeywell C-616/10* (all relating to patent infringements) support this view.

However, *Solvay* also makes clear that cross-border relief may be granted in the form of interim injunctions in preliminary proceedings as the national court does not make a final decision on validity. Though the cases relate to patents, the same principles ought to apply to trade marks.

EUTMs

Pan-European injunctions are available in respect of infringement of EUTMs and decisions on validity and infringement cover the whole EU (*Article 102(1), EUTM Regulation*).

The CJEU has clarified that any injunction granted by a member state EUTM court has effect throughout the EU. If, however, that EUTM court finds that the acts of infringement are limited to a single member state/part of the EU, or where a defendant can prove that use of the sign does not or is not liable to affect the function of the trade mark in certain member states (for example, on linguistic grounds) other than the state(s) in which the proprietor has established infringement, the court must accordingly limit the territorial scope of the injunction (*DHL Express (France) SAS v Chronopost SA C-235/09*). Although the English courts have been prepared to offer pan-European injunctions (see *Interflora v Marks and Spencer plc [2013] EWHC 1484 (Ch)*), they have also provided UK only injunctions where *DHL* applies (for example *Enterprise Holdings, Inc v Europcar Group UK Ltd & Anor [2015] EWHC 17 (Ch)*).

21. To what extent are arbitration and alternative dispute resolution (ADR) methods (such as mediation) available to resolve trade mark disputes?

ADR encompasses a range of procedures including arbitration, mediation, expert determination, early neutral evaluation and mini-trial which are all available for resolution of a dispute. Various methods of ADR are fairly commonly used.

Arbitration

It is extremely unlikely that the UKIPO would recognise and execute an arbitral award declaring a trade mark invalid, since validity of a UK trade mark can only be challenged in proceedings before the High Court or UKIPO. If the issue were dealt with in arbitration or other ADR, the result would be effective in relation to third parties if the proprietor agreed to surrender rights and took appropriate action in relation to the registration.

ADR

ADR is common in trade mark disputes, focusing on resolution through licensing or co-existence arrangements, and contractual settlements can be enforced through the courts.

The UKIPO opposition procedure includes a "cooling off" period of up to 18 months to allow parties to negotiate before the adversarial stage of proceedings. Either party can ask for this period but both parties must agree to it. The UKIPO also has a mediation service to which certain types of trade mark disputes can be referred.

The IPEC, like the High Court, can adjourn a case for a specified period to encourage the use of ADR and can require it to be considered. Failure to engage in ADR can have an adverse impact on cost recovery.

Nominet, the domain name registry in the UK, operates a dispute resolution service to help people and organisations settle domain name disputes where the:

- Complainant has rights in a name which is similar to the domain name.
- Person who has registered the domain name has taken unfair advantage of those rights.

Rights in a name may have arisen by way of a trade mark or contractual rights and can be rights enforceable under English law or in other jurisdictions.

The service is limited in scope to disputes involving .uk domain names and does not have jurisdiction to grant an injunction, award damages or make orders for costs. The parties have to bring court proceedings to obtain those remedies, though a decision on who has rights can assist the parties in reaching an amicable resolution on the other issues in the dispute.

PROCEDURE IN CIVIL COURTS

22. What is the format of trade mark infringement proceedings?

In contrast with many other European jurisdictions, the civil court process in England is adversarial rather than inquisitorial and is governed by rules designed to avoid the possibility of either side surprising the other with an ambush at trial. Two key aspects of the English court approach are:

- The use of oral evidence and cross-examination of witnesses.
- Documentary disclosure by each party of material that both helps and hinders their case.

Disputed issues are decided by a judge (or in some cases, a master or a panel of judges in an appeal, or in the UKIPO a specially appointed senior practitioner). Juries are not used.

Trade mark infringement proceedings typically comprise:

- Pleadings: these are high-level formal written statements of each side's case.
- Case management conference: this occurs after the close of pleadings. It sets the timetable for the case, and addresses issues such as the scope of disclosure, number of witnesses and use of survey evidence.

- Disclosure: see *Question 27*.
- Evidence gathering, preparation and exchange of witness statements: witness statements set out the evidence in chief intended to be given by each witness.
- Trial and judgment: the trial is an oral hearing typically lasting a few days. Shortly before the trial, the parties file detailed written arguments.

23. Is a fast-track procedure available?

Proceedings can be expedited in the following ways:

- Speedy trial: where an interim injunction is not appropriate and a degree of urgency can be shown, a speedy trial may be an appropriate alternative. Some aspects (in particular disclosure) may be more limited but, in general terms the procedure is as usual, but intensive, taking place over a shorter period.
- Streamlined procedure: the IPEC generally hears lower value and less complex trade mark actions in a more streamlined and cost-effective way than the other courtsby:
 - limiting evidence (both factual and expert) to only written form.
 - restricting or disallowing cross-examination of witnesses; and
 - preventing or severely limiting disclosure.

The court can also adopt any method of proceeding at a hearing that it considers fair.

The High Court is currently piloting schemes which provide shorter and more flexible procedures for larger claims.

24. What are the rules and practice concerning evidence in trade mark infringement proceedings in your jurisdiction?

Documents

Witness statements and expert reports are prepared and exchanged with the other parties to the proceedings. These set out in detail the evidence that is intended to be given by each witness/expert at trial.

Witness evidence

Witnesses give evidence in writing and orally. Generally, the written witness statement stands as the witness's evidence in chief and the oral testimony begins with cross-examination by the opposing party. The party who called the witness can then "re-examine" to assist the witness in answering any points raised in cross-examination.

Expert evidence

The parties can, with the permission of the court, use expert witnesses.

Before the IPEC, expert evidence will only be permitted in relation to specific issues, and only if the court is satisfied that the benefit of such testimony justifies the cost.

25. To what extent is survey evidence used (for example, to support acquired distinctiveness, or likelihood of confusion)? What is its evidential value?

Survey evidence is sometimes used to prove distinctiveness, likelihood of confusion or deception, and whether the mark is

known to the relevant public. The courts are cautious about the value of surveys, the results being highly dependent on the manner in which the survey is conducted. To reduce time and costs, it is now necessary to obtain the court's approval of a proposed survey before it is carried out.

The Court of Appeal held the following in relation to survey evidence (*Interflora Inc v Marks & Spencer plc* [2012] EWCA Civ 1501 and [2013] EWCA Civ 319):

- A party can conduct a true pilot survey without permission of the court, but this will be at its own risk as to costs.
- No further survey can be conducted or adduced in evidence without the permission of the court.
- Permission must also be sought by a party wishing to adduce evidence from respondents to a survey. Generally this will extend to seeking approval of the methodology and questions.
- The court will only give permission if it is satisfied that the evidence is likely to be of real value and that the likely value justifies the cost.
- Survey evidence is less likely to be permitted for determining likelihood of confusion because the court can put itself into the position of the average consumer without requiring survey evidence.

Details of all surveys must be disclosed (irrespective of the results and whether or not the results are relied on in evidence) and an expert available for cross examination on the results and methodology used. Surveys not conducted in accordance with the strict guidelines outlined by the courts may be given little weight by the court or excluded from the evidence.

26. Is evidence obtained for criminal proceedings admissible in civil proceedings, and vice versa?

In civil and criminal cases, it is for the judge to rule on the admissibility of evidence applying the general rules of evidence, namely, the principles of admissibility, relevance and the rules on hearsay.

Criminal convictions as evidence in civil proceedings

The fact that a person has been criminally convicted by a UK court is admissible evidence in subsequent civil proceedings for the purpose of proving that he/she committed the offence in question. Documents, information, complaints or indictments used in the criminal case are also admissible evidence in a subsequent civil case.

In general, the fact that someone has been convicted of an offence in a foreign jurisdiction is inadmissible as evidence in a civil trial. However, the fact that someone has a foreign conviction may be admissible where the issues in the criminal and civil proceedings are the same.

Judgments in civil proceedings as evidence in criminal trials

The court can refuse to allow evidence on which the prosecution proposes to rely, if the admission of the evidence would have an adverse effect on the fairness of proceedings.

27. To what extent is pre-trial discovery permitted and what other mechanisms are available for obtaining evidence from an adverse party or third parties?

Pre-trial discovery

"Discovery" is termed "disclosure" in English courts. Pre-action disclosure (the term used in English courts) and disclosure against

certain third parties is available in civil proceedings (for example, to assist in an early resolution or reduce costs), though unusual.

Disclosure enables a party to obtain evidence from the other party, as part of all proceedings, typically once all parties have filed their pleadings.

All parties are required to make a reasonable search for all relevant documents in their possession or control, and disclose to the other side all the documents on which they rely which adversely affect its own case and which adversely affect or support another party's case, other than those protected by legal privilege. The court can limit the scope of disclosure.

Other mechanisms

It is possible to obtain pre-trial search and seizure orders (see *Question 28*).

28. Can an order be made to establish proof of infringement (saisie-contrefaçon)? If not, what other mechanisms, if any, are available?

The High Court can make an ex parte order requiring a party to admit its opponent's solicitors (with an independent supervising solicitor) to its premises for the purpose of preserving evidence (by searching for and copying, or seizing, evidence that the defendant has in its possession. An applicant for this order must fulfil onerous requirements, in order to protect the defendant's rights.

Parties to civil proceedings have a duty to preserve disclosable documents (see *Question 27*) as soon as litigation is contemplated. The documents to be preserved include electronic documents which would otherwise be deleted in accordance with a document retention policy or otherwise deleted in the ordinary course of business. Destruction of documents when litigation has been started, or is even contemplated, is regarded as a serious matter in the English courts and can result in costs sanctions, or even contempt of court.

29. How long do trade mark infringement proceedings typically last?

A trade mark action typically comes to trial within ten to 12 months of commencement, depending on the length and complexity of the case, the attitude of the parties and the availability of court time and the court and urgency. A speedy trial can be ordered in urgent cases and can be heard within three to six months (see *Question 23*). A private criminal prosecution may take six to 12 months or longer if the public prosecutor takes over the prosecution.

30. What options, if any, are available to a defendant seeking to stay the proceedings?

If the validity of a trade mark has been already raised before the EUIPO, a defendant can generally obtain a stay of the UK infringement proceedings pending resolution of the invalidity proceedings. The courts only refuse to stay proceedings where there are special grounds, which will be construed narrowly. The grounds must be 'out of the ordinary', for example, where there were exceptional circumstances of urgency due to the imminent launch of an internet TV service (*Starbucks (HK) Ltd v BSKyB Group plc; EMI (IP) Ltd v BSKyB [2012] EWCA, Civ, 1201*).

In cases where there are simultaneous civil actions in the courts in different member states, with one court seized on the basis of an EUTM and the other on the basis of a national trade mark, the court other than the court first seized can stay its proceedings.

In other cases, the defendant can generally introduce delay (particularly in the early stages before the court has set a timetable) by applying for extensions of time allowed for different steps in the action. A claimant can press forward with the pleadings and make applications to court to keep extensions short and set the timetable and particularly the trial date as early as possible. If there is real urgency, a shortened timetable can be obtained. Where appropriate, an interim hearing may force the defendant to press ahead.

PRELIMINARY RELIEF

31. Is preliminary relief available?

A variety of preliminary relief is available including:

- An order for early disclosure and inspection which can even be made before commencement of proceedings.
- A search and seizure order (see *Question 28*).
- A freezing order (Mareva injunction), by which assets of the defendant which may be needed to satisfy judgment will be retained.
- An interim injunction pending trial. To determine whether an interim injunction should be granted, the court looks at the following factors (*American Cyanamid Co. v Ethicon Ltd [1975] A.C. 396*):
 - whether there is a serious question to be tried and, increasingly, the relative strength of the parties' cases;
 - whether damages will be an adequate remedy (because of the nature of the infringement or the defendant's financial position);
 - where the balance of convenience lies (what is just and convenient given the position of both parties);
 - where other factors are evenly balanced, the court will tend to maintain the status quo.
- The claimant is generally required to give an undertaking to pay damages to the defendant for loss resulting from the injunction if it transpires it ought not to have been granted.

Preliminary relief is available where urgency is shown or the relief is otherwise necessary in the interests of justice. A party generally needs to show that without the grant of preliminary relief, its interests will be seriously if not irreparably harmed (for example, reputational damage) and cannot be compensated by payment of damages. Where such urgency cannot be shown, the court can order a speedy trial instead.

32. Can a protective writ be filed at the court at which an ex parte application may be filed against that defendant?

It is not possible to file a protective writ at court in anticipation of a potential application for a preliminary injunction. However, ex parte relief (such as an injunction or search and seizure order) is available only in exceptional cases, where the matter is so urgent that the defendant cannot be notified or where there is a real concern that the defendant can dispose of evidence. Consequently, unless secrecy is essential, the defendant should normally be notified of the application. The defendant can then attend the hearing and either take no part in the proceedings or, more usually, take an active part in opposing the application. However, the defendant is unlikely (and is not expected) to have prepared any adequate evidence. If the injunction is granted, the defendant can then immediately apply to vary or discharge it.

33. What is the format for preliminary injunction proceedings?

General

The procedure for making a with-notice interim injunction application typically comprises:

- Service of an application notice with details of the order sought and evidence in the form of a witness statement(s).
- Service of evidence in reply by the defendant and claimant.
- Exchange of written arguments.
- Oral hearing at which each party's counsel makes submissions.

Level of proof

In the case of interim injunctions, while the court does not conduct a mini-trial of the issues before the full trial, the claimant must establish that there is a serious question to be tried.

Evidence

Generally evidence is given in written witness statements. In some cases (in respect of search and seizure orders and freezing orders), formally sworn affidavits are required. There is no oral evidence or cross-examination. The parties are entitled to provide documents along with their evidence but there is no provision for disclosure at this stage.

Trade mark validity

A defendant can raise the issue of validity but it will not be determined at that stage.

Length of proceedings

Generally speaking, an interim application will be heard within about two months but an injunction may be granted within weeks (or even days or hours), depending on the circumstances.

FINAL REMEDIES

34. What remedies are available in a registered trade mark infringement action?

The remedies available are generally similar for infringement and passing off. These are the following.

Permanent injunction

The granting of a permanent injunction is a discretionary remedy. Generally the court grants an injunction where there is some threat or likelihood that infringement will continue or be repeated. If, however, a defendant has, for example, mistakenly infringed a trade mark proprietor's rights or there is no probability of an infringement being repeated, the court is less likely to grant an injunction.

Any injunction granted or coercive measures ordered by an EUTM court generally has effect throughout the EU. However, if the court finds that the acts of infringement are limited to part of the territory of the EU (for example, based on linguistic grounds), it must accordingly limit the territorial scope of the prohibition which it orders (see *Question 20*).

Monetary remedies

A claimant is entitled to a monetary remedy in respect of infringement and must choose between:

- Account of profits (at the court's discretion).
- Damages (applicable from the date of filing of the application).

Damages are available as of right, while an account of profits is an equitable remedy at common law.

In the IPEC, damages are capped at GB£500,000.

Delivery up or destruction of infringing goods

The court can make an order requiring erasure of the mark, delivery-up, or destruction of the products bearing the infringing mark (though erasure of the mark and delivery-up are not available for passing off).

Publication of the decision

Virtually all decisions are published in legal publications. Even though this is not specifically regarded as a remedy, it can have significant commercial impact. In cases where the IP right holder has been successful, the IP Enforcement Directive expressly provides for the publication and dissemination of judgments in a wider variety of publications at the expense of the infringer and other additional publicity measures appropriate to the circumstances of the case. Such orders are granted only where they will act as a supplementary deterrent to future infringers or to contribute to the awareness of the public at large.

The IP Enforcement Directive does not provide for publicity orders for a successful non-infringer but the English courts have confirmed that they have jurisdiction to grant such an order but only where there is a real need to dispel commercial uncertainty (for example where the claimant has publicised its infringement allegations). Being a discretionary, equitable remedy, whether or not such an order is granted depends on all the circumstances of the case (*Samsung Electronics (UK) Limited v Apple Inc [2012] EWCA Civ 1339*).

Recall order

If a defendant has already released infringing goods from its possession and control, the court will not generally grant an order requiring them to be recalled.

Declaration of infringement and validity

See *Question 16*.

A court can grant a declaration that the trade mark is valid. If validity is contested in subsequent proceedings, the second challenger will face substantial cost penalties if the trade mark is again upheld as valid.

Others

The penalty for committing the criminal offence of unauthorised use of a trade mark or falsification of the register is a fine (in magistrates' courts, this is limited to GB£5,000) or imprisonment for a term of up to ten years for unauthorised use of a trade mark or for two years for falsification of the register (or in magistrates' courts, six months), or both. The offence of falsely representing a registered trade mark also attracts a fine of up to GB£1,000. An application can be made for forfeiture of goods or materials bearing an unauthorised trade mark or a trade mark likely to be mistaken for a registered mark.

35. How are monetary remedies assessed against a registered trade mark infringer?

A claimant who establishes infringement is entitled to choose between a remedy in damages or an account of profits (see *Question 34*). To assist this decision, the defendant may have to disclose sufficient information to enable the claimant/trade mark owner to make a reasoned choice between the account of profits and damages (*Island Records Ltd v Tring International plc [1995] FSR 560*).

Damages

In the High Court, quantum of damages is assessed in a separate set of proceedings from those establishing liability. In most cases, the parties agree a sum to be paid by way of damages.

The general principle in assessing quantum of damages is that the trade mark owner should be put in the same position as if the infringement had not happened, that is, compensated for all reasonably foreseeable losses suffered as a result of the infringement. There is no punitive element.

A court's assessment of damages can take into account a number of factors, including:

- Lost royalty or licence fee.
- Lost profits on the potential sales which would have been made by the defendant.
- Lost profits from any price reduction necessitated by the infringement.
- Compensation for injury to the mark's reputation. If a claimant has licensed his/her rights, damages are typically assessed on the basis of a notional licence fee or reasonable royalty assumed to be agreed between a willing licensor and licensee.

Account of profits

In an account of profits, the profits attributable to the unauthorised use of the trade mark are paid over. Like damages, an account of profits is not a punitive remedy. It is intended solely to deprive the defendant of the benefit flowing from the acts of infringement. An account of profits can be apportioned if only part of the defendant's business benefitted from the infringing actions. Overheads incurred by the business can be deducted.

Appeal remedies

36. What routes of appeal are available to the unsuccessful party?

A decision of the Registrar can be appealed to the Chancery Division of the High Court, or to a person appointed by the Lord Chancellor to hear and decide appeals under the TMA.

Decisions of the High Court and the IPEC can be appealed to the Court of Appeal with permission and there can be a further appeal to the Supreme Court on points of law (with permission and generally where the issue is one of general public importance).

An appeal takes the form of a review rather than a rehearing so it is rare for new evidence to be considered on appeal. The appeal proceeds on the written evidence only together with the written submissions and transcripts of the first instance proceedings including the oral arguments and oral evidence.

Appeal proceedings in England from the High Court to the Court of Appeal typically take about one year (and to the Supreme Court, one to two years).

Appeals can be made from the Court of Appeal to the Supreme Court on points of law (with permission and generally where the issue is one of general public importance). There is no further instance of appeal beyond the Supreme Court.

Litigation costs

37. What level of cost should a party expect to incur to take a case through to a first instance decision, preliminary injunction proceedings and appeal proceedings?

Costs depend on the nature of the type of action sought. If the matter is dealt with at an interim hearing or a summary judgment with no further action necessary, then costs are likely to be in the region of tens of thousands of pounds, depending on the amount of evidence used and its nature.

Proceedings before the Registrar or the IPEC are considerably cheaper than those before the High Court because of the simplified procedure. Costs could typically range from GB£100,000 to GB£1 million. If the matter is to be argued fully at trial with survey evidence, experts and a considerable number of witnesses, the likely costs will be towards the upper end.

Proceedings before the UKIPO or the IPEC will be at the lower end and can be tens of thousands rather than hundreds of thousands of pounds. References to the CJEU will increase costs. Appeal costs are typically around one third to half of the size of first instance costs. Preliminary injunction proceedings are likely to cost several hundreds of thousands of pounds in the High Court and significantly less in the IPEC.

Costs are awarded in the court's discretion but the general principle is that the loser pays the winner's costs which will include the winner's attorney's costs (in practice generally a substantial proportion of them) in relation to the individual issues on which the paying party lost. The court looks at all the circumstances (including the conduct of the parties and offers to settle). The precise level of costs is determined by a detailed assessment procedure. Generally, the courts allow costs that have been reasonably and proportionately incurred.

In the IPEC, the normal rules on costs do not apply. Cases are subject to a cap on recoverable costs of GB£50,000 for liability and GB£25,000 for an inquiry as to damages or account of profits. The court rules set out the maximum costs that a court will award at each stage of a claim.

REFORM

38. What are the important developing and emerging trends in your country's trade mark law?

Brexit

The most important issue facing trade mark owners is Brexit. Following the UK's formal departure from the EU, the UK will fall outside the EU trade mark regime with the result that existing EUTMs will no longer have effect in the UK. This will also apply to EU designations of origin and geographical indications. The UK Government will need to find a legal mechanism allowing for continued protection of these rights in the UK.

Various models have been proposed, some of which may result in additional financial and administrative burden on rights holders as well as on the UKIPO.

In its Position Paper on Intellectual Property Rights (*TF50 (2017) 11*) of 6 September 2017, the EU recognised the uncertainty UK and EU rights holders face and called for a number of general principles to be addressed. The EU takes the position that the UK should introduce legislation to give IP owners rights in the UK equivalent to those lost in the EU, even where there is no equivalent right currently existing in the UK. However the paper does not deal with what, if anything, the EU proposes to do in respect of the EU rights that are lost.

Brexit raises other difficult questions in the context of trade marks. Post-Brexit, existing EUTMs which have only been used in the UK may be at increased risk of revocation as a result of lack of genuine use within a continuous period of five years (and there is no proper reason for this non-use). There is also the question of what will happen to pending applications and what will be done to preserve priority of rights.

The status of CJEU case law is, of course, important given the harmonised nature of trade mark law across the EU under the Trade Mark Directive. The UK Government has stated in its policy paper of 23 August 2017, *Enforcement and dispute resolution - a future partnership* paper that the Repeal Bill will give pre-exit CJEU case law the same binding, or precedent, status in UK courts as

decisions of the UK's Supreme Court "to ensure a smooth and orderly exit". The paper discusses the possibility of taking account of CJEU decisions when interpreting concepts that are "identical in substance" to EU law. Therefore, in areas where the UK does not revise the current legislation, it is thought that the case law of the CJEU will remain persuasive. However, given the criticisms the judiciary have made of the CJEU's interpretation of the law in some areas of trade mark law it will be interesting to see to what extent the courts follow this approach if adopted. It is also unclear at present when the direct jurisdiction of the CJEU will come to an end. In October 2017 the UK Government indicated that CJEU case law may continue to be binding during the proposed implementation period following the UK's formal departure from the EU in March 2019.

Other questions yet to be resolved are whether the UK will implement the new Directive and how the UK Government will deal with exhaustion of rights and parallel imports, where there are complex issues and scope for trade mark owners' rights to change significantly.

Other developments

Other evolving areas include:

- The boundaries of non-traditional trade marks, in particular in relation to shapes and acquired distinctiveness is a changing area of the law.
- The English courts also continue to consider online related issues, such as internet jurisdiction and the targeting of websites. The Court of Appeal has confirmed that blocking injunctions can, where appropriate, be used against ISPs whose services have been used to infringe trade mark rights.
- The changes to the threats provisions which come into force in 2017 (see *Question 19*) seek to provide a better balance between the interests of rights holders and the interests of genuine traders to be able to continue with their lawful activities.

ONLINE RESOURCES

Intellectual Property Office Website

W www.gov.uk/government/organisations/intellectual-property-office

Description. Official website maintained by the UK Intellectual Property Office.

European Union Intellectual Property Office

W <https://euipo.europa.eu/ohimportal/en/databases>

Description. Official website of the European Union Intellectual Property Office.

Civil Procedure Rules

W www.justice.gov.uk/courts/procedure-rules/civil/rules

Description. Official website maintained by the Ministry of Justice containing the Civil Procedure Rules applicable to all civil proceedings, including patent infringement proceedings. See Part 63 for rules applicable to IP claims in particular.

Chancery Division Information

W www.justice.gov.uk/courts/rcj-rolls-building/chancery-division

Description. Official website maintained by the Ministry of Justice containing the court guides for the Chancery Division of the High Court of Justice. The procedure in the Patent Court follows broadly that of the Chancery Division with some differences.

Intellectual Property Enterprise Court Guide

W www.gov.uk/government/publications/intellectual-property-enterprise-court-guide

Description. Official guide maintained by the HM Courts and Tribunals Service that sets out the court procedure applicable to the Intellectual Property Enterprise Court. This should be read alongside the Chancery Division information and the Civil Procedure Rules.

British and Irish Legal Information Institute

W www.bailii.org

Description. Official website of the British and Irish Legal Information Institute containing a database of British and Irish case law and legislation, European Union case law, Law Commission reports, and other law-related British and Irish material.

Practical Law Contributor profiles



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Publications.

- *New law on unjustified threats: greater clarity* (PLC Magazine, October 2017);
- *Hyperlinking to unauthorised content: ECJ imposes conditions* (PLC, September 2016);
- *EU Trade Marks: define your monopoly* (Slaughter and May, August 2016);
- *Changes to the law on threats: balancing interests* (PLC Magazine, February 2016);
- *Intellectual Property Act 2014: Changes to Design and Patent Law* (PLC Magazine, July 2014).



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- *The EU Competition Rules on Intellectual Property Licensing* (Slaughter and May)
- *Changes to the law on threats: balancing interests* (PLC Magazine, February 2016)
- *Intellectual Property Act 2014: Changes to Design and Patent Law* (PLC Magazine, July 2014)