

Our intellectual property practice

We have one of the strongest IP practices among law firms in Europe with over 80 lawyers working exclusively in this area. Advising companies on strategic and business-critical IP strategies and matters is one of our key strengths. Our team regularly works with our clients to develop, protect, enforce and effectively exploit their intellectual property rights and to optimise the IP value in the business and maximise IP-based revenues.

Our core services include:

- litigating all forms of IPRs including patents, copyright, design rights, database rights and trade marks
- devising national and international litigation strategies
- protection and defence of IPRs at Registry level
- brand selection and clearance
- trade mark and design registration
- IPR portfolio management
- trade mark, domain name and company name watching service
- technology transfer
- franchising, licensing and distribution
- advertising, marketing and sponsorship

Our services

Intellectual property disputes

We have acted in many ground-breaking landmark cases including some of the biggest and more difficult cases in recent years which have created new law. Team members have the necessary technical background and experience to be able to handle often complex, multinational heavyweight disputes. Our aim is to resolve disputes as quickly and inexpensively as possible by whatever means available. When necessary, we have the experience and ability to conduct the most complex cases through the courts.

Our IP litigators have considerable experience in handling major IP and licence disputes, both before the courts and in international arbitration and mediation. We have pleaded cases across all forums, right up to the European Court of Justice, as well as in national Patent Offices and the European Patent Office. The group provides early advice on infringement risk and validity assessment of registered IP rights. In the event that a matter proceeds to trial, it is very rare for the court to come to a view different from our initial assessment.

Copyright

Copyright law is going through a rapid change due to developments in technology which results in works being exploited in ways not contemplated by legislation. We understand the technology and are experienced in advising clients on latest developments in the law and how this might affect their business. This ranges from copyright protection in computer programs to streaming content, screen-scraping and linking through to copyright material. We also have extensive experience in advising on traditional copyright disputes dealing with the copying of literary, musical and artistic works.

Anti-counterfeiting and piracy

We have a track record of preparing, advising on and implementing strategies to prevent counterfeiting and piracy as well as trade in parallel imports and infringing compatible goods. We work in conjunction with online surveillance specialists, investigators and government agencies to achieve a costs effective and co-ordinated resolution.

We regularly deal with Trading Standards and HM Revenue & Customs regarding the seizure of counterfeit and pirated goods and assist in the prosecution of those involved.

Domain names

We have extensive experience in advising clients in relation to their domain name portfolios, including implementing domain name watch programmes. We have many years' experience in acting on a wide range of domain name disputes, including successfully recovering numerous domain names in our home jurisdictions on behalf of clients, including under the Nominet DRS (including on appeal), UDRP and EURiD ADR policies.

We have also advised in relation to domain name complaints in many other registries around the world. We successfully obtained cancellation of a domain name for a client in one of the first complaints brought relating to a .pro domain name.

Patents

In today's world IPRs in general, and patents rights in particular, are becoming increasingly important to the future success of a business. This is true both for industry sectors where there is a long history of using patent rights for commercial gain, such as pharmaceuticals, and those industries where the use of patent rights is comparatively new (for example, digital media).

We have a group of lawyers dedicated to patent dispute resolution. Unlike many firms, patent disputes are not handled by commercial litigators but by patent experts, experienced in all forms of dispute resolution, from mediation to expert determination and, where necessary, litigation. The disputes we deal with are varied and range from licence disputes through to disputes about the scope, extent and infringement of rights. We have experience across all types of proceedings right through to full trials.

Trade marks and brand protection

We have a market-leading trade marks practice, which is the largest in any UK law firm by a distance and has been for the last 10 years. We advise multi-jurisdictional clients looking to expand their businesses and brand portfolios on every legal issue concerning worldwide brand strategy.

We currently manage over 20,000 trade marks worldwide of more than 2,500 brand owners – this impressive track record speaks for itself. We have been acknowledged by The Legal 500 directory as the leading trade marks and brand management practice amongst UK law firms for a number of years.

We have a team of 30 advising solely on trade mark and brand protection issues. Including brand selection, brand clearance, filing and prosecuting trade mark and design applications, trade mark litigation, passing off cases and administrative actions.

We understand that enhancing brand value requires dealing with trade marks not in isolation but as part of the wider brand portfolio and within their commercial context.

Licensing & exploitation

As one of Europe's leading licensing and distribution practices, we have a clear understanding of how these models can be used for the growth of businesses, for both those whose entire businesses are structured around these models as well as companies who have never been involved in these methods of growth.

We have extensive experience in the drafting, negotiation and practical implementation of commercial patent agreements of many types in many areas of this world, in a wide range of technologies and markets. Through our technical, legal and commercial skills, we can assist in identifying fresh opportunities and new structures for deals and IP-based relationships.

Our involvement in due diligence activities has proved valuable both for potential investors and for those seeking finance. We also advise and draft other forms of IP agreements, for example revenue-share agreements, assignment documentation, commissioned research agreements and joint venture agreements.

Recent work highlights

B4U Network (Europe) We are acting for the European arm of Bollywood movie and music multi-channel broadcaster B4U in the High Court and Court of Appeal in a case on the cutting edge of copyright law.

Crocs We have worked with Crocs protecting its designs and trade marks against infringers and grey importers across Europe and the Middle East since they first hit the market.

Curves International We have advised Curves in relation to their branding requirements since 2004. The ongoing nature of the work is in managing trade mark disputes primarily outside of the US.

Eli Lilly vs. Human Genome Sciences The first IP case heard by the newly created Supreme Court, this case related to a patent for a particular cytokine predicted to have various putative therapeutic benefits and represents the **primary UK authority on the law of industrial applicability**.

Elvis Presley Enterprises Representing EPE in a wide range of brand related matters, the most high profile of this being High Court proceedings in the UK in which we successfully obtained summary judgment against an ex-licensee in respect of unauthorised use of EPE's trade marks on CDs of Elvis remixes.

Getty Images Acting for Getty Images in a copyright dispute. The case raised interesting arguments of fair dealing and human rights.

Google We support this client in relation to a number of its brands, including GOOGLE, YOU TUBE and ADWORDS, which involves advice on trade mark oppositions and potential claims for trade mark infringement and passing off.

Hearst Corporation We are acting for Hearst Inc, the global media company, and Fleischer Studios Inc. in a High Court claim against a number of parties, for passing off and trade mark infringement.

MTV acting for MTV in a High Court trial regarding its breach of licence and trade mark infringement claims against a licensee of two flagship channels.

Quadriga We have been involved in all intellectual property related aspects of the rapid growth through heavy investment in technology of Quadriga.

Ranbaxy Laboratories Ltd Advising in the defence of patent infringement proceedings in the UK, which is part of a set of proceedings initiated in the US.

Take-Two Interactive We represent Take-Two, the company behind many of the most popular computer games of all time (including GRAND THEFT AUTO, CIVILISATION and RED DEAD REDEMPTION) in the EU.

Our intellectual property practice

UK Passport Service Advising the British Government on patent and design issues arising from the electronic passports and ID cards.

Vestergaard Frandsen We continue to act for this multi-national disease control company, based in Switzerland, in long running litigation in the UK relating to technical trade secrets (misuse of confidential information) in the secret chemical formulas for long lasting insecticidal mosquito nets.

Wagner We advised and represented our client on a patent infringement case involving paint spray technologies against English company Earlex.

Acting for **BleuForêt** against Phildar in a copyright and design infringement claim in relation to the design of tights. BleuForêt, claimed 335.000 EUROS in damages. By a decision dated February 5, 2014, the Nancy Court of Appeal ordered Phildar to pay BleuForêt, 257 000 Euros in damages, 13.000 Euros for lawyer fees and to publish the decision in three magazines and on its website.

Acting for **Toulemonde Bochart** against IKEA in a copyright infringement claim in relation to Toulemonde Bochart's carpet "JOHNNY ZIP" designed by Hilton Mc CONNICO. The case is pending before the Nanterre Court of first instance.

Acting for **Axa Real Estate Managers France** against Actuate Corporation – Sarl Actuate International - Actuate International Corporation (hereafter Actuate) in a copyright infringement dispute concerning software. The case, pending before the Paris Court of first instance related to alleged infringement by Axa Real Estate Managers of the copyright owned by the American editor Actuate on its software. Judgment handed down on 7 May 2014 - the Court of first Instance rejected the claims of Actuate (for 600,000 Euros in damages) and ordered Actuate to pay 30,000 Euros costs to Axa Real Estate Managers. Actuate appealed against the decision of Court of first instance.

Advising **Orange**, a French telecommunications company, on all aspects of intellectual property relating to its business activity.

What they say about us

Chambers 2013 – Intellectual property

"Mark Hodgson has an excellent pedigree as a patent litigator, and is a leading figure in the firm's increasing emphasis on hard IP litigation."

"David Knight is sought after for his knowledge across the spectrum of IP rights, although his forte resides in technology and patent work, including litigation before UK courts and the European Patent Office."

Chambers 2012 – Intellectual property

"They are highly business-oriented and prone to consider the commercial impact of the law rather than just talk about it."

"Deemed to be a "well-informed and thorough" team with a strong line-up of IP specialists, Field Fisher Waterhouse has hitherto been best known for its strengths in trade marks, copyright and design rights."

Legal 500 2013 – Intellectual property and brand management

"Nick Rose heads the IP group, in which Mark Hodgson undertakes patent litigation. Leighton Cassidy is also recommended."

"Fieldfisher is 'very knowledgeable' on trade mark protection issues and has a focus on soft IP matters for media and technology sector clients, as well as handling some patent work."

"Leighton Cassidy advises Forbes and Curves International on brand protection."

Legal 500 Paris 2013 described the Paris IP team as "creative and reactive" and having "specific knowledge of the technical and legal issues" as well as "an excellent understanding of the constraints faced in a business environment".

Bruno Ducoulombier is part of the "Best Lawyers in France" list established by the French newspaper Les Echos, in the Technology and Intellectual Property categories.

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