

Your rights **Your choice**

Understanding Intellectual Property enforcement



Your rights have been infringed, what are your options?

Your technology, confidential information, software, designs and branding are valuable assets.

How do you protect them effectively with the minimum financial and time costs? This guide is designed to help you understand the key benefits and considerations associated with the options available to you if your rights have been infringed. There are a number of routes you can take when trying to protect your assets, but which is best for you?



Intellectual Property Enterprise Court (IPEC)

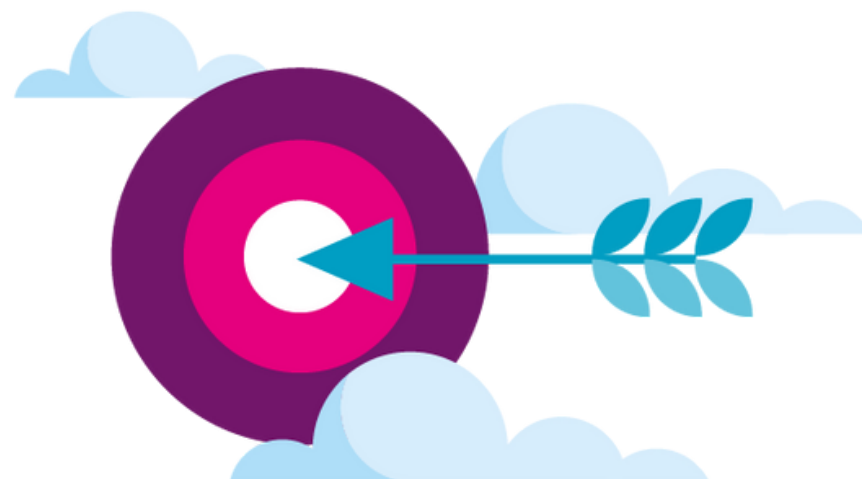
Fast and streamlined, the IPEC is an increasingly popular choice for IP disputes. When you want quick and decisive enforcement of your rights or a cost-effective defence, this can be the best option.

Benefits

- Jurisdiction extends to the full range of IP disputes and some ancillary matters
- All usual remedies are available (including interim injunctions in the multi-track) subject to caps on damages and costs recovery
- Procedures are flexible and efficient. Hearings may be dealt with on paper or by telephone. Key issues will be identified early and evidence limited to specific issues
- If both parties agree, and the judge thinks it appropriate, a preliminary non-binding opinion can be given at an early stage of the case. This may assist early resolution
- The costs recovery cap limits exposure. Costs are summarily assessed
- Parties can agree to waive the damages cap if they wish a dispute of higher value to be heard by IPEC

Considerations

- You may be restricted in the arguments and evidence you can present as trials are limited to two days
- If you win, there may be a shortfall between what you spend and what you recover because of the £50,000 cost recovery cap
- It can take up to 18 months for your case to reach trial due to the popularity of the IPEC as a forum



High Court

With no limits on trial length, damages or costs recovery, full scale High Court proceedings may offer what you need for a major dispute.

High Court procedures allow for in-depth examination of complex issues. The disclosure process enables you to access relevant documents and cross-examination allows you to test your opponent's evidence.

Cases are assessed for technical difficulty at the outset and heard by the most appropriate judge.

Benefits

- For high-value rights, very complex cases and “bet-the-company” disputes, this can offer what you need
- Powerful remedies including unlimited damages or an account of profits, injunctions to prevent further infringement, destruction or delivery up of infringing goods, and publicity orders
- High Court decisions are often very public. The publicity surrounding a win can be a useful tool in your armoury
- Issue based cost recovery can recompense the winning party whilst and discourage parties from raising weak arguments

Considerations

- Parties may make multiple applications which will introduce delay and proliferate the litigation, making the dispute longer and more costly
- Full High Court proceedings can be very expensive as a result of the in-depth analysis and argument involved
- Current procedures require early budgeting to give you an idea of the likely cost of a part or the whole of the proceedings. It is a detailed procedure and can be a costly and time-consuming exercise in itself.

Shorter Trials Scheme (STS)

The STS operates within the High Court. It offers a halfway stage between IPEC and full High Court litigation.

Benefits

- Speed - the case should take no more than a year from commencement to judgment
- When it comes to listing a hearing, STS cases are given priority
- Trials are limited to four days, including reading time
- All of the usual High Court remedies are available

Considerations

- There are restrictions on the length of the statements of case and witness evidence
- It may not be suitable for cases where very in-depth analysis is required and trial is likely to last longer than four days
- Unlikely to be used if one party is resistant

Flexible Trials Scheme (FTS)

This scheme makes use of the High Court system but is more flexible. It can only be used where both sides agree, and permits a simplified and speedier trial compared to full High Court proceedings.

Alternative Dispute Resolution (ADR)

Flexible and open to tailoring, arbitration, mediation or other forms of ADR may be the right choice for a domestic or multi-jurisdictional dispute. It can take a different mindset to choose ADR, and particularly mediation – generally the outcome is more nuanced than a straight win-lose and this has the advantage that both sides can take something away.

Benefits

- The outcome is often not a straight win-lose. A win-win result is possible
- It may be easier to preserve a business relationship with your opponent
- It is easier to keep the dispute and its outcome confidential
- The parties agree a choice of rule book and venue
- ADR can be fast and inexpensive

Considerations

- Opting for ADR and choosing the place and system will need agreement from both sides and can therefore be challenging
- The result may not necessarily be the end of the story. Disputes can sometimes be reopened or challenged in court
- Depending on the system used and the parties' approach, it can be slower and more costly than court proceedings

Some forms of ADR are available within purpose-built systems. For example:

- Domain names
 - WIPO's Uniform Domain Name Dispute Resolution Policy
 - Nominet's Dispute Resolution Service
- TV format rights
 - WIPO Mediation and Expedited Arbitration Rules for Film and Media

Other options to consider

Alongside the dispute resolution methods set out above you can explore alternative approaches.

Trading Standards, the Police - in an appropriate case it is possible to involve Trading Standards or criminal enforcement bodies such as the Police Intellectual Property Crime Unit, or PIPCU, to pursue counterfeiters or to tackle piracy. This can be cost-effective and highly dissuasive to infringers, although you will have less control over what action is taken and the speed and vigour of proceedings.

Schemes such as eBay's VeRO system can be useful at an early stage, or to clamp down on smaller scale infringing activity.

Where online infringement is a problem, it may be possible to obtain website blocking orders from the courts against intermediaries like Internet Service Providers.

Working remotely

In response to the COVID-19 pandemic, the courts have found new ways of working remotely. Completely online or hybrid hearings are becoming more routine, and we expect that this experience will lead to substantially increased use of remote and hybrid hearings in the future. In line with this, we are developing in-house facilities for use as virtual court rooms.

Remote options for arbitration and other forms of ADR are also widely available.



Brexit

The UK left the legal structures of the European Union at the end of the transition period on 31 December 2020. It is unclear at this stage how easy it will be to enforce UK court judgments in European Union member states, or EU court judgments in the UK.

UK courts will no longer be able to grant pan-European injunctions, and pan-European injunctions granted elsewhere will no longer apply in the UK. These changes should be kept in mind when considering a European enforcement strategy, and may give weight to ADR approaches.



About us

Our specialist Intellectual Property disputes team helps organisations protect against the full range of IP infringement, finding solutions to all kinds of issues.

Our team members prioritise understanding not only the issue in hand, but also the wider implications for your business, and offer pragmatic and straightforward advice to protect your valuable assets.

Our intellectual property team offers three partners, twelve lawyers and two paralegals.

Our lawyers also have specialist IP qualifications and expertise. Alasdair Poore is also a Chartered Patent Attorney and former President of the Chartered Institute of Patent Attorneys. He is an active member of CIPA's Trade Marks and Litigation Committees, and he is on both the IPEC and IP Court Users committees as the CIPA representative. Nicola Hanglin is a registered trade mark attorney. Nicola and Richard Plaistowe are also active members of the International Trademark Association and Richard is a member of the INTA Brexit Task Force.

Several members of the team have degree-level qualifications in the physical and life sciences, and post-graduate diplomas in intellectual property law.

Talking IP, our virtual discussion series, looks at hot topics for intellectual property. Find out more on our [website](#).



Case study: Defending the Defender - stopping an off-roader in its tracks

In 2016 when mass production of the classic Land Rover Defender ceased, some businesses saw this as an opportunity to capitalise on the reputation of this iconic vehicle.

Canadian company Bombardier Recreational Products Inc. (BRP) launched an all-terrain vehicle (ATV) in Europe and called it "Defender." When BRP failed to engage in alternative dispute resolution, the battle lines were drawn.

Jaguar Land Rover (JLR) sued BRP for trade mark infringement in the High Court, making use of the Shorter Trials Scheme, a scheme designed to facilitate the speedy resolution of business disputes. Despite challenges to the validity of JLR's trade mark including to the breadth of JLR's trade mark specification, JLR prevailed. A Europe-wide injunction was obtained to prevent the sale of BRP vehicles with this name and BRP was ordered to pay damages and costs.

JLR's Global Legal Director, Keith Benjamin, was delighted with the result, adding:

"We welcome this ruling, recognising the enforceability of our intellectual property rights and preventing use by third parties. The Land Rover Defender is an iconic vehicle that is part of Jaguar Land Rover's past, present and future. The success of our business is based on unique design and engineering attributes, and we intend to protect the brand robustly around the world."



Case study: Basmati rice joins Champagne and Stilton

Cornish Pasties, Stilton and of course Champagne have special protection ensuring that only products produced in a specific region and having specific characteristics can be described using these names.

When Amira Pure Foods, applied to register “Basmati Bus” as a UK trade mark covering restaurant services, the protector of Indian agricultural exporters, APEDA, wished to oppose the application. The restaurants might serve any type of rice, but the public would believe that restaurants with the “Basmati Bus” name would serve dishes containing only Basmati rice. The public could be misled and damage could be done to the Basmati name. APEDA had to rely on the collective goodwill in the name “Basmati” owned by UK traders. The UK IPO ruled that Basmati denoted a clearly defined class of goods and enjoyed protectable goodwill. The IPO said that the public were likely to be misled if Basmati Bus was used by a restaurant serving rice other than Basmati rice. Amira agreed to limit their trade mark to restaurants serving genuine Basmati rice dishes.

The IPO followed previous UK decisions (including on Greek yoghurt and vodka) by holding that the name of a particular food or drink having specific characteristics could be protected on the basis of the goodwill in that name, even when used by a large number of different traders and even when not registered.

Since this decision we have achieved successful outcomes against other applicants for UK and EU trade marks incorporating the name “Basmati,” procuring either a restriction of their goods specification to genuine Basmati rice only or a withdrawal of their application. We have also successfully registered “Basmati” as a UK certification mark.



Case study: Healthcare providers under attack

Patent protection for methods of medical treatment are not permitted, but that does not mean that clinical procedures and diagnoses carried out within a healthcare context are necessarily in the clear. Where an invention identifies a new way of diagnosing a condition, patent protection for an appropriate testing method may be available.

Diagnostic testing carried out within UK healthcare system became the subject of a patent infringement attack from the licensee of a patent claiming a genetic testing method. The diagnostic test was key to determining the correct course of treatment for a debilitating condition. The patent licensee alleged that in-house testing to detect a mutant gene was not permitted, and all diagnostic testing should be carried out by them alone.

Several different UK healthcare providers found themselves facing the same problem, and a coordinated response was needed. We helped the group to develop a united strategy. We advised on patent validity and infringement and, working together, managed to prevent the matter escalating to the courts before the patent expired. The expiration of the patent means that our healthcare clients can continue to carry on the tests themselves without threat of an injunction, and it appears that the licensee is no longer pursuing its claim.



Case study: Research institution facing threats of court action

A research institution entered into a Collaboration Agreement with a US-based commercial partner, intending to develop a gene therapy for a debilitating disease. The programme involved experimental trials on specially bred animal models. The work was supported by funding from research charities, who themselves acquired intellectual property rights under the funding arrangements.

The project began well, but two years in, things began to turn sour. The commercial partner had concerns that the research institution planned to make use of the project results for its own ends. Threats of court action followed, when the commercial partner raised the prospect of seeking an interim injunction to prevent what it saw as unlawful use of the results of the collaboration.

We supported the research institution to find a way through, fending off the threatened litigation, and helping to build a commercial solution to allow the collaboration to continue. We also negotiated agreements with the funding charities, to enable access to their intellectual property for the purposes of the project.



Get in touch

If you have any queries, or would like a preliminary meeting to discuss your options please do contact us, we'll be happy to help.



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