

# 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.

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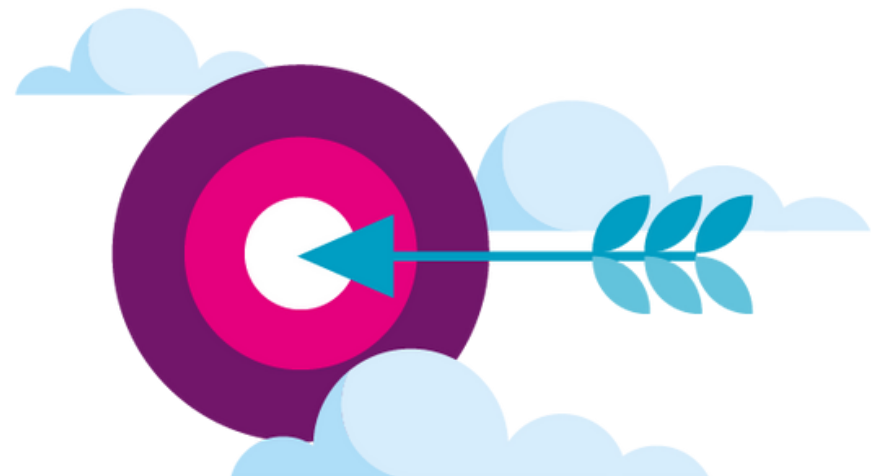
## Benefits

- 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, remotely or in person. 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

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## 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 £60,000 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.

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## 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

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## 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. The STS is characterised by an emphasis on short, specified time periods.

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## Benefits

- Speed - the case should reach trial within 10 months of the issue of proceedings and judgment within 6 weeks thereafter
- Cases will be allocated to a designated judge at an early stage
- 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

## 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. The FTS procedures focus on disclosure and trial.

## 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

# 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.

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## 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

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## 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.



# Enforceability of UK judgments in the EU

The UK left the legal structures of the European Union at the end of the transition period on 31 December 2020. It is still unclear 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 five partners, nineteen lawyers, two qualified trade mark attorneys and one paralegal.

As a team, we are ranked in Chambers Legal Directory in Tier 1 for East Anglia and Tier 2 in the Midlands and in Yorkshire. We are also ranked in Legal 500. Seven of our IP lawyers have individual directory rankings.

Our lawyers also have specialist IP qualifications and expertise. Several members of the team have degree-level qualifications in the physical and life sciences, and our junior IP lawyers complete the University of Oxford Post-Graduate Diploma in Intellectual Property Law and Practice. Our lawyers have deep expertise in the technology, life sciences, healthcare, food and agriculture, education and sports sectors.

We attend the International Trademark Association conference and Leadership and our lawyers sit on INTA's Committees. One of our lawyers was awarded the prestigious INTA Service Award for the Advancement of Association Objectives for helping INTA to navigate the complex IP-related issues involved with the UK's withdrawal from the EU. We regularly attend other national and international IP conferences and speak at industry events.



# 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: Snap, crackle and pop: the EUIPO gets crisped by the CJEU in the Basmati rice appeal

In one of the last appeals to the CJEU in which UK representatives will appear, APEDA was successful in its appeal to the Court of Justice of the European Union (CJEU) concerning an opposition against an application for an EU trade mark containing the word “Basmati.”

The application was opposed by Indo European Foods Ltd (IEF), a UK trader in Basmati rice, on the basis of extended form passing off. The Opposition Division and then, on appeal, the Board of Appeal of the EU Intellectual Property Office (EUIPO) rejected the opposition. IEF appealed this decision to the EU General Court in June 2020.

On 31 December 2020 the Brexit transition period expired, and EU trade mark law ceased to have effect in the UK and UK-trade mark rights could no longer form the basis of an opposition to EU trade mark applications.

In the appeal, the EUIPO argued that as the opposition was based on unregistered UK trade mark rights, on expiry of the Brexit transition period, the opposition proceedings had become devoid of purpose, and IEF no longer had a legal interest in bringing the proceedings.

The General Court upheld IEF's appeal, holding that IEF's interest in bringing proceedings continued to exist. It also held that the extended form of passing off was a basis for opposing an EU trade mark application, commenting favourably on IEF's substantive case.

The EUIPO appealed the General Court's decision to the CJEU and failed in its appeal. The CJEU upheld the General Court's decision, holding that IEF's action had not lost its purpose on the basis that the subject matter of the appeal was the Board of Appeal decision, which had been delivered before the end of the Brexit transition period. The opposition will be referred back to the EUIPO Board of Appeal for reconsideration.

This decision is very significant, concerning the status of appeals against pre-Brexit EUIPO decisions, in matters based on UK-only rights, which were ongoing at the end of the Brexit transition period. Also, even though the UK has left the EU, the extended form of passing off remains relevant as a basis for opposing EU trade marks, as the law of passing off also applies at least in Ireland, which remains a member of the EU.



# 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 meant that our healthcare clients could continue to carry on the tests themselves without threat of an injunction, and the licensee ceased 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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