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Contributing Editor:
Nick Aries
Bird & Bird LLP

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Trade Mark Questions in Emerging Technologies: NFTs, Metaverse and Beyond


Nick Aries


William Wortley

Bird & Bird LLP

Introduction

Non-fungible tokens (NFTs) and the metaverse have been amongst the most talked about commercial hot topics of recent years. A wave of recognisable brands have increasingly been using these technologies, either as part of their roll-out strategy for real-world products and services, or as standalone projects. The increased focus on these technologies has required trade mark holders to re-evaluate the way in which their assets are being utilised, their trade mark filing strategies, and their approach to enforcement. The last few years have also seen a steady increase in the number of disputes relating to NFTs in particular.

In this chapter, we look at some of the issues that rights holders can consider when reviewing their enforcement and filing strategies, and what guidance might be found in the most recent cases in this area.

What is the Metaverse?

Broadly speaking, the "metaverse" is a digital world where users share experiences and interact in real time within simulated scenarios, which may be facilitated by virtual and/or augmented reality technology.

However, to speak of "the" metaverse is arguably currently something of a misnomer. In reality, there are currently multiple metaverses being developed by different actors, underpinned by different technologies. Broadly speaking, at the time of writing, they can be categorised as follows:

(1) "Traditional" centralised metaverses: These largely consist of virtual worlds that already exist in the Web2 environment, centrally governed by a single organisation that controls user data access. The gaming industry has been at the forefront of such metaverses, including Epic Games' Fortnite, where users not only play games but can attend virtual concerts and live out aspects of a virtual life online.

(2) Centralised Web3-type metaverses: These are similar to the traditional centralised metaverse described above but they incorporate the blockchain. An example would be Meta's Earth 2 metaverse.

(3) Decentralised Web3-type metaverses: These systems are guided by a decentralised autonomous organisation (DAO) where users have a greater influence over their administration. One prominent example is Sandbox in which users can buy digital pieces of "land" using Sandbox's native cryptocurrency to build interactive experiences using games and digital assets. Users can also create NFTs and sell those NFTs on Sandbox's native marketplace.

Prominent brands have been amongst the most high-profile early adopters of metaverse technology, particularly those in the fashion industry. For example, Nike acquired RTFKT, a digital design studio producing virtual trainers and other collectibles that can be worn across different online environments. Nike has also created its own virtual Nikeland world within the online game Roblox in which players can buy branded products for their avatars. In respect of high-end fashion, Ralph Lauren has launched a Roblox collection, while Louis Vuitton and Balenciaga both released video games to supplement their real-life catwalk shows.

What are NFTs?

NFTs are cryptographic, digital tokens that are not fungible, containing unique data comprising code and other metadata. Their lack of fungibility means that unlike, say, physical currency, an NFT cannot be readily exchanged for another NFT in such a way that the owner in question continues to own the same thing. (By contrast, a Dollar can be swapped for another Dollar and the owner does continue to own the same thing.)

An NFT is created (or "minted") and resides on a blockchain solution such as the public blockchain Ethereum, or others like Polkadot, Cosmos and Flow. NFT integration in the blockchain allows users/owners to track all transactions/activity in the NFT from the date of minting onwards.

There are NFT marketplaces such as OpenSea or Rarible through which NFTs are bought and sold, and these transactions are reflected in the blockchain ledger at the backend.

Broadly speaking, NFTs fall into one of two buckets:

(1) An NFT linking to a physical asset, such as a luxury good. In this case, a seller creates a digital certificate of ownership and authenticity and embeds it in an NFT that they transfer to the purchaser along with the physical asset. This first bucket is a more eye-catching opportunity for brands compared with the current authentication methods available to them.

(2) An NFT linking to a digital asset, representing a right to do something with a licensed copy of something. In this case, the NFT includes a unique URL that directs the owner to a web server hosting the digital file, such as digital artwork, music or a video clip, or an in-game item for a computer game. The asset linked to the NFT is nearly always held "off chain", i.e., it is not part of the NFT itself.

How Trade Mark Protection Applies to NFTs and the Metaverse

Different approaches are taken internationally with respect to the protection of trade marks and assessment of infringement. In the UK and EU, protection is offered against infringement by using:

(i) an identical trade mark in respect of identical goods or services;

(ii) an identical trade mark in respect of similar goods or services or a similar trade mark in respect of identical goods or services where there is a likelihood of confusion; and
(iii) an identical or similar trade mark on dissimilar goods or services, where the protected mark has a reputation and the infringer takes unfair advantage or causes detriment to the repute ("tarnishment") or distinctive character ("dilution") of the mark.

"Double identity" infringement

In assessing whether there has been double identity infringement under Article 9(2)(a) of the EUTM Regulation/Section 10(1) Trade Marks Act 1994 (TMA), there is a question as to which goods and services are covered by the trade mark as registered. Taking trainers as an example, they would typically be registered in class 25, which is described in the WIPO Explanatory Note as including "footwear … *for human beings*"[1] (emphasis added). Some commentators have questioned whether a registration for a physical item (such as a trainers) could be said to cover all forms of that product (including virtual trainers), such that trade mark owners could argue that the goods are identical.

In considering the scope of the particular registration, the position in the UK is that the meaning of the words describing goods or services must be determined as at the date of registration.[2] Consequently, it may be unlikely that older registrations for physical goods such as trainers could be interpreted to mean that virtual versions of the same goods are considered identical.

By contrast, a recent case in Italy interpreted the specification of goods more broadly, in favour of the rights holder. In the *Juventus v Blockeras* case,[3] the defendant launched an NFT project called "Coin of Champions", involving digital football cards. This offering included a card of the well-known Italian player Christian Vieri wearing a Juventus jersey and showing Juventus's distinctive signs. Juventus sought a preliminary injunction, while Blockeras argued that the marks in question were not registered for "downloadable virtual goods". However, the Italian court deemed that the registration of Juventus's trade marks in class 9 for terms such as "*downloadable electronic publication*" was broad enough to include digital football card NFTs.

For services, it is easier to envisage an argument of double identity infringement. If, for example, an entity were to set up a payment provider service in the metaverse branded "Visa" or "PayPal", those services will likely be identical despite the fact that the transaction was occurring in a virtual world – i.e., they are still providing payment services. The discussion below in relation to the European Union Intellectual Property Office's (EUIPO) practice note about appropriate classification further supports this.

Similarity of goods in the context of NFTs and the metaverse

In respect of infringement cases under Article 9(2)(b) of the EUTM Regulation/Section 10(2) TMA when assessing similarity of goods (or services), the assessment in the UK and EU considers the uses and users of the goods, their physical nature, their trade channels, and whether they are in competition with each other or complimentary. Taking the example of a digital pair of trainers:

(1) The uses of the respective goods: One function of physical trainers is to provide their owner with comfortable footwear that will protect their feet and keep them warm and dry. However, for certain trainers, the use can be just as much about self-expression, the projection of a particular image, and loyalty to a brand. Many trainer brands retain value because of their exclusivity; it has become common for real-world buyers to purchase trainers as collectible items, never actually wear them, and for those trainers to be traded and sold on for profit. Such uses are arguably equally applicable in respect of digital trainers backed by an NFT.
(2) The users of the respective goods: While it might be argued that the users of digital trainers are the avatars that "wear" them, those avatars are arguably inseparable from the human user who controls them (and as time progresses, this division may become increasingly blurred).
(3) The physical nature of the goods: Clearly the physical nature of real-world trainers is completely different from that of a virtual one. However, it might be possible for trade mark owners to argue that the items are visually similar such that they contain an element of physical similarity (e.g., if both physical and digital trainers consist of the same distinctive design).
(4) The trade channels through which the goods in question reach the market: There is commonality here through online retail.
(5) The extent to which the respective goods are in competition with each other or complementary: Physical trainers and virtual ones likely do not compete with one another (although there is room for creative arguments as the metaverse becomes more ubiquitous). However, there is clearly scope for argument that physical and digital trainers are complimentary to one another. Where NFTs are used as a badge of authenticity and ownership in relation to a real-world product, this could be said to constitute complementarity.

Marks with a reputation

In respect of trade mark infringement that takes place in the real world or online, famous marks with a reputation have the advantage of being able to avail themselves of the additional protection afforded to prevent unfair advantage being taken of, or detriment being caused to, the mark under Article 9(2)(c) of the EUTM Regulation/Section 10(3) TMA. Where there is a good case under this heading, arguments about whether goods are identical or similar become moot.

The disputes emerging to date tend to involve marks with a reputation, where this additional protection may be of significant importance. Owners of less well-known brands are less likely to be the first targets of misuse by third parties but will do well to adapt to these new environments in terms of their filing and litigation strategies.

Unregistered rights

As is the case in more traditional IP infringement cases, in the UK, it may be possible for brand owners to argue that an infringer's acts also amount to passing off. The test for passing off is well known and long established, requiring a claimant to prove that:
(i) it has goodwill attached to the brand;
(ii) there has been a misrepresentation by the defendant such that the public believes or is likely to believe that the defendant's goods or services are those of the claimant; and
(iii) the claimant has suffered damage as a result of that misrepresentation.

The flexibility of a passing-off claim can be beneficial when enforcing against emerging paradigms of use, and of course there is the benefit that a claim can be brought without needing a trade mark registration.

The law of unfair competition, generally applicable in many continental European countries, is often wider in scope than passing off and is therefore likely to be a useful additional tool for rights holders seeking to bring actions against NFT and metaverse-related infringement in those jurisdictions. Unfair competition was successfully argued before the Italian courts in the preliminary injunction proceedings issued by Juventus Football Club against Blockeras as discussed above.

Summary

In summary, the benefits of filing new trade marks directly covering NFTs and virtual goods include not needing to argue about whether physical goods in a conventional trade mark specification are identical or similar, and not needing to prove reputation. We discuss below various considerations for such trade mark filings. Even for trade mark owners needing to take action based on older marks, there is certainly still a case to build.

Jurisdiction and Targeting

One question that will need to be answered when bringing proceedings relating to NFTs and/or the metaverse is which is the appropriate jurisdiction. In due time, there may be complex questions around the appropriate jurisdiction if there were to be a maximalist version (or versions) of a single metaverse. However, as things stand, the use of a sign in relation to NFTs and/or in the metaverse effectively occurs online. As such, in respect of at least the UK and EU, the test for whether use of a sign is actionable in a jurisdiction is likely that of "targeting".

Targeting means taking aim at the consumers in another country, with the principles being summarised by Kitchen LJ in *Merck KGaA v Merck Sharp & Dohme Corp.*[4] In his judgment, Kitchin LJ stated that the targeting in question has to amount to a use of the mark in relation to goods in the course of trade in the jurisdiction, and the mere fact that a website or platform is available in a territory is not sufficient for concluding that there has been targeting. The court also held that the question of whether there had been targeting was to be assessed objectively though the eyes of the average consumer, and that it is necessary to evaluate all the relevant circumstances.

A non-exhaustive list of matters to be considered was provided by the Court of Justice of the European Union (CJEU) in *Pammer*,[5] including telephone numbers with an international dialling code, language and mention of international clientele, although it was noted that the evidence is a matter for national courts. Kitchin LJ also said in *Merck* that a finding that an advertisement was directed at consumers in the UK did not depend on there being any clear evidence of the factors that are traditionally considered. The appearance and content of the website would be of particular significance, including whether it was possible to buy goods or services from it. In addition, the relevant circumstances might extend beyond the website itself and include, for example, the nature and size of the trader's business, the characteristics of the goods or services in issue and site traffic stats. These observations are likely to be relevant in an NFT/metaverse environment where some of the traditional factors for assessing targeting may be entirely absent.

One UK case to watch on the topic of targeting is *Lifestyle Equities v Amazon*.[6] In these proceedings, the first instance court found that Amazon.com was not targeted at the UK/EU in part because Amazon operated dedicated websites for those jurisdictions. However, the Court of Appeal disagreed, finding that the sites in question were targeted at the UK, in part because they stated that items could be shipped to the UK. The Supreme Court granted permission to appeal on 13 December 2022; the appeal will likely be heard later this year.

Another case to keep an eye on is the pending CJEU reference in *Lännen v Berky*.[7] The CJEU is expected to rule during the course of this year. In that case, the referring court in Finland is asking how to approach the assessment of targeting and jurisdiction in a trade mark infringement action where there is no express reference in the online use to the geographical area to which goods are to be supplied. The court asks about the extent to which various factors (such as the global nature of the market for the goods in question – consider, by analogy, an NFT) can be taken into account in that assessment.

Approach to Trade Mark Filing

Certain brand owners will be in a position to rely on their existing trade mark portfolio to enforce against misuse in the metaverse or through the offer and sale of NFTs. However, in order to ensure maximum protection, many brand owners have been choosing to make new filings specifically for NFTs and/or the metaverse, resulting in an enormous surge of NFT and metaverse-related trade mark filings in 2022. For example, it was recently reported that there had been nearly 5,000 United States Patent and Trademark Office trade mark application relating to the metaverse and virtual goods or services in the period from January to October 2022, well over double the number for the equivalent period in 2021.[8]

In June 2022, following a surge of NFT and metaverse-related trade mark applications, the EUIPO issued guidance[9] on its approach to the classification of "virtual goods" and "non-fungible tokens (NFTs)", stating that:

(1) Virtual goods are proper to class 9 because they are treated as digital content or images. However, the term "virtual goods" on its own lacks clarity and precision so must be further specified by stating the content to which the virtual goods relate (e.g., downloadable virtual goods, namely, virtual clothing).

(2) By operation of the 12th Edition of the Nice Classification (in force as of 1 January 2023), downloadable digital files authenticated by NFTs would be incorporated in class 9. NFTs are treated as unique digital certificates registered in a blockchain that authenticate digital items but are distinct from those digital items. For the EUIPO, the term "non-fungible tokens" on its own is not acceptable. The type of digital item authenticated by the NFT must be specified.

The EUIPO guidance also stated that services relating to virtual goods and NFTs would be classified in line with established practice for classification for services. This appears to indicate that they do not consider the services on offer in the metaverse to differ significantly from those offered in the virtual world.

Remedies

Relevance of intermediaries

The communities that drive the Web3 and NFT environment have done so under a culture that values privacy, and in many instances, anonymity. As such, issues identifying and serving process on anonymous or pseudo-anonymous infringers are likely to be an important part of launching certain proceedings. As noted below in this chapter, there are certain legal mechanisms being developed to provide tools to overcome these issues, including serving proceedings via an NFT; however, in an environment that generates a vast quantity of user-generated content, it is something that rights holders are going to have to consider carefully.

A more familiar approach to tackling infringement is to pursue notice and take-down strategies where available. In the US, DMCA notices (under the Digital Millennium Copyright Act 1998) have been successful in getting allegedly infringing NFTs taken down from OpenSea in relation to alleged copyright infringement. For example, when the creator of the infamous "Pepe the Frog" cartoon complained of infringement by the Sad Frogs District project, resulting in its delisting. The many and various metaverse operators and NFT platforms are likely to have varying systems in place, and divergent attitudes to take-down notices.

If the notice and take-down procedure is unavailable to rights holders or such notices are repeatedly circumvented by users, where suitable, trade mark owners might consider applying for a court order to compel the platform to disclose the infringer's details, provided they are confident that the platform in question actually has those details. (In the UK, this is known as a *Norwich Pharmacal* order.)

In the most heinous situation, where a platform is set up solely or predominantly for infringing purposes, brand owners could consider seeking a site-blocking injunction. Such injunctions have become more commonplace in the UK in recent years, particularly in the context of online infringement of rights in media content, but they are typically only suitable for sites enabling large-scale piracy and/or counterfeiting. As a result, the instances in which such action will be appropriate and proportionate are likely to be relatively rare.

Should remedies be adapted to accommodate NFTs and the metaverse?

Historically in the UK, there had been some uncertainty as to whether crypto assets constituted "property", a prerequisite for granting proprietary relief over assets in the UK. However, in recent years, there have been several decisions indicating that they should be:

- In *AA v Persons Unknown, re Bitcoin*,[10] the judge concluded that crypto assets such as Bitcoin were property, drawing partly on the UK Jurisdiction Taskforce's November 2019 statement that those assets should be treated as such.
- More recently, in *Deborah Osbourne v Persons Unknown and Ozone*,[11] the court held that there was at least a realistically arguable case that NFTs should be treated as property. This general approach has also been seen in Singapore, where the Singapore High Court recently found that NFTs were digital assets that formed legal property, blocking the sale of a Bored Ape NFT.[12]

While this preliminary hurdle might be overcome, there are likely to be practical issues when considering which remedies to seek to enforce against infringers. For example, if a platform were ordered to delist assets, the problem of pseudo-anonymity might limit efficacy by making it relatively easy for infringers to resurface elsewhere and carry on their infringing activities. Further issues need to be considered if seeking destruction or delivery-up of the crypto assets. NFTs exist on the permanent, immutable blockchain, and cannot be destroyed or removed from that blockchain.

There are some alternatives. "Burning" an NFT is one such example. This is a public, irreversible, and permanent transaction that is recorded on the blockchain ledger. The primary way to "burn" an NFT is to send it to a null web address that no one owns where it is rendered inaccessible and therefore devoid of value. "Burning" does involve the payment of some fees, so it will be necessary to include in any order who is responsible for the payment of those fees. In centralised networks, it might also be possible to break the link between an NFT and digital asset by removing that asset from the URL, but this is unlikely to work in all scenarios, including where the content is hosted on a distributed P2P network.

Regarding damages, it is worth observing that, for NFTs in particular, the value is often in one-off (or limited) high-value transactions. This contrasts with traditional counterfeiting cases where the rights holder tends to be more concerned with shutting down the illicit activity rather than seeking damages, for various reasons. In a situation of enforcement in relation to a valuable NFT, damages may take on a greater focus in the minds of rights holders.

What Cases to Date Can Tell Us About Disputes in the Future

In 2023, we can expect to see more court decisions in disputes that are already afoot, which will influence the direction of future brand protection and enforcement strategies. We can also expect to see new proceedings being instigated about future cases where boundaries are being pushed. Some of the more high-profile disputes going through the courts are as follows.

Hermès v Rothschild (*MetaBirkin*)

The *Hermès v Rothschild*[13] dispute was the first major example of an established luxury brand bringing legal proceedings for the use of a registered trade mark in creating and selling NFTs.

In these proceedings, Mason Rothschild, a Californian artist, created a series of NFTs mimicking Hermès' BIRKIN bag, which he dubbed the "MetaBirkin". The MetaBirkins were initially sold both directly and on OpenSea. Hermès sued in New York, alleging that Rothschild misappropriated Hermès' IP in creating and selling his series of MetaBirkin NFTs, claiming that Rothschild had sold over $1m worth of MetaBirkins by early January 2022. Hermès argued that the NFTs act in the same way as traditional counterfeit products and that Rothschild purposefully used the BIRKIN trade mark in order to inflate the value of his series of NFTs. Rothschild primarily relied on freedom of speech arguments in his defence.

In February 2023, a jury found that Rothschild's sale of the NFTs in question did not amount to protectable free speech under the first amendment, and violated Hermès' rights in the BIRKIN trade mark, awarding the luxury brand $133,000 in damages (consisting of $110,000 estimated profits, and $23,000 statutory damages). At the time of writing, we expect an appeal to be filed soon.

Thinking about how such a dispute might play out in the UK, we can look to the Human Rights Act 1998. Where a court is considering whether to grant relief in a case, Section 12 places an obligation on the court to decide whether such relief may adversely affect the right to freedom of expression in the European Convention on Human Rights (ECHR).

Most UK case law in which brand protection and free expression collide relates to advertising disputes or trade libel. There are, however, a few limited examples where freedom of expression arguments have been considered in trade mark cases. In *Hearst v Avela*,[14] Birss J rejected a defence that a finding of infringement would be a disproportionate restriction on freedom of expression rights, noting that the "speech" in question was "in a purely commercial context", involving the "presentation of words and images on goods in order to sell them". Pumfrey J, in *Miss World v Channel 4*,[15] was also sceptical about the idea that use of a trade mark can of itself generally engage the freedom of expression rights enshrined in the ECHR. As such, it is possible that NFT creators would face similar challenges running such arguments in UK courts as those faced by Rothchild in the *MetaBirkin* case.

Nike v StockX

Nike has been one of the most active fashion brands in the NFT space, particularly with the launch of its Nike x RTFKT NFTs, which have reportedly generated over $185m in revenue. It is therefore unsurprising that it is also a party in one of the forerunning pieces of litigation in the area.

In February 2022, Nike filed a suit against StockX, an e-commerce platform through which users are able to buy and resell items including trainers. StockX had launched The Vault, a feature enabling users to trade NFTs tied to and depicting physical trainers, which they authenticate and store until the current NFT owner elects to redeem them for the physical shoes (at which point the NFT is burned). The NFTs depict the Nike trainers and trade marks.

Nike argues that, rather than merely representing the ownership of physical goods, StockX's actions amount to minting NFTs using Nike's trade marks without consent. Nike says that those NFTs have their own independent value and that consumers buying them believe (or are likely to believe) that the NFTs are connected to Nike.

StockX argues that the NFTs are not digital trainers, instead representing the proof of ownership of real-world, authentic trainers and that consumers would not be confused into thinking that there was a connection between the NFTs and Nike. StockX has also sought to rely on the "first sale doctrine" (similar to the principle of exhaustion in the UK/EU), as well as stating that its use of Nike's trade mark amounts to nominative fair use.

D'Aloia, *LCX* and *MANGO* cases

The interaction of NFTs and the metaverse with litigation is not confined to substantive issues but also concerns procedural matters.

For example, in the UK case of *D'Aloia v Binance Holdings & Others*,[16] the claimant was given permission to serve proceedings by way of a transfer of an NFT on the blockchain. The litigation concerns attempts to recover £2m of cryptocurrency following alleged misappropriation by persons unknown. In granting permission to serve proceedings on the unknown individual associated with digital wallets connected to the fraudulent activity, the judge noted that service by NFT was "likely to lead to a greater prospect" of those behind the purported activity being put on notice of the judge's order, and the commencement of proceedings.

Similarly, in *LCX AG v John Doe Nos. 1–25* in the US, the Supreme Court of the State of New York permitted the claimant to serve orders and other documents on the person(s) in control of an Ethereum wallet address, by airdropping a token containing a hyperlink to a purpose-built website created by the claimant's counsel where the documentation could be accessed.

While it remains to be seen whether service by NFT (or similar technology) will be adopted elsewhere, these two cases could be of utility to trade mark owners seeking to enforce against unknown infringers.

Finally, in the *Mango* case[17] in Spain, the Barcelona first instance court granted a preliminary injunction against clothing brand, Mango. Mango had created a collection of NFTs based on digital copies of famous art works, which were then uploaded on the OpenSea marketplace. While Mango owned the original paintings, the judge questioned Mango's ability to digitalise them and convert them into NFTs. From a procedural point of view, it is interesting that the injunction included an order that the NFTs be transferred to a wallet designated by the claimant until a final judgment on the merits is issued.

Conclusion

There are certainly lots of developments for interested observers of this field to look out for this year. While the main parameters of the likely debates seem fairly clear, the fact-dependent nature of cases in this area, together with the rapidly evolving technological landscape, means that advisors representing brands, platforms, creators and other participants in the eco-system will have to pay close attention when developing strategies and engaging in disputes.

Endnotes

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Nick Aries is a partner and co-head of the firm's representative (non-US law) office in San Francisco. He advises on and coordinates European and UK IP law matters for US-based companies.
Nick is adept at identifying and advising on IP issues in the digital economy, including copyright and trade mark questions raised by online services and social media. He also advises on multi-jurisdictional IP litigation and strategy. Alongside this, his practice covers transactional IP work such as licensing (particularly, brand licensing arrangements), and advice on the IP aspects of large-scale corporate restructures and reorganisations.
Nick has been recognised by *World Trademark Review* as one of the World's Leading Trademark Professionals.
Nick's UK litigation experience covers trade mark infringement and passing off, breach of licence/coexistence agreement, trade secrets, and designs. Example UK cases include *Merck KGaA v MSD*, *Maier v Asos*, *Kenexa v Alberg*, *Codemasters Software v ACO* and *Daimler v Sany*.

Bird & Bird (America) LLP
535 Mission Street, 14th Floor
San Francisco, CA 94105
USA

Tel: +1 415 463 7468
Email: nick.aries@twobirds.com
URL: www.twobirds.com

William Wortley is an associate in Bird & Bird's Intellectual Property Group based in London and has experience acting for clients across a broad range of IP rights, with a particular emphasis on soft IP – copyright, designs, trade marks and trade secrets – as well as areas of defamation and reputation management. His practice encompasses a number of industry sectors including Media, Entertainment and Sport, Retail and Consumer, and Technology and Communications, and he has acted in proceedings in the UK High Court, IPEC and Court of Appeal. William is Co-Editor in Chief of *MediaWrites*, the firm's Media Industry news hub, and a contributor to the *Chartered Institute of Patent Attorney* (*CIPA*) *Journal*.
William is identified as a Key Lawyer for Media and Entertainment in *The Legal 500*.

Bird & Bird LLP
12 New Fetter Lane
London EC4A 1JP
United Kingdom

Tel: +44 20 7415 6000
Email: william.wortley@twobirds.com
URL: www.twobirds.com

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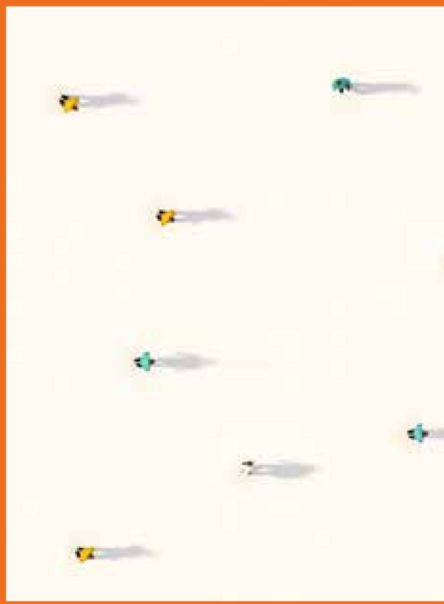

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