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# ICLG

The International Comparative Legal Guide to:

## Trade Marks 2019

**8th Edition**

A practical cross-border insight into trade mark work

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Papula-Nevinpat

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Pham & Associates

PORZIO · RIOS · GARCIA

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Samuriwo Attorneys

Shearn Delamore & Co.

Sołtysiński Kawecki & Szlęzak

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**Publisher**  
Rory Smith

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# United Kingdom

Nick Aries



Daisy Dier James



Bird &amp; Bird LLP

## 1 Relevant Authorities and Legislation

### 1.1 What is the relevant trade mark authority in your jurisdiction?

The relevant authorities are the UK Intellectual Property Office (the “UKIPO”), the High Court of England & Wales, the Court of Session in Scotland and the High Court of Northern Ireland.

### 1.2 What is the relevant trade mark legislation in your jurisdiction?

The pertinent legislation is the Trade Marks Act 1994 (the “TMA”), the Trade Mark Regulations 2018 (the “Regulations”, which implement the Trade Marks Directive (2015/2436) (the “Directive”), and the EU Trade Mark Regulation (2017/1001) (the “EUTMR”).

## 2 Application for a Trade Mark

### 2.1 What can be registered as a trade mark?

The mark must be a sign capable of:

- (1) distinguishing the goods or services of one undertaking from those of other undertakings; and
- (2) being represented in a manner which enables competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor.\*

\* This is a new requirement, brought following the introduction of the Regulations, which replaces the old requirement for ‘graphic representation’. However, the Sieckmann criteria still apply, meaning a mark must be clear, precise, objective, intelligible, easily accessible, durable and self-contained.

### 2.2 What cannot be registered as a trade mark?

A trade mark may be refused registration on ‘absolute’ or ‘relative’ grounds (see sections 3 and 4 below).

### 2.3 What information is needed to register a trade mark?

The application must contain: a representation of the mark; the classes of goods and services for which the mark is being applied

for; and administrative details such as the name and address of the applicant.

### 2.4 What is the general procedure for trade mark registration?

An application must first be submitted to the UKIPO. The UKIPO will then assess whether the mark fails on absolute grounds. If it does, the examiner will issue a report detailing the reasons why. Applicants then have two months to resolve the issues raised. Following the examination, the mark is published for a two-month opposition period (extendable to three months) and may be opposed on the basis of relative grounds at this stage. Once the opposition period expires (or opposition proceedings conclude), the application will proceed to registration.

### 2.5 How is a trade mark adequately represented?

See question 2.1 above.

### 2.6 How are goods and services described?

The UKIPO uses the Nice Classification system which groups goods and services into 45 ‘Classes’, each of which contains a list of pre-approved terms. Although each class has its own heading, these headings should not be relied upon and applicants should list each good or service for which they wish to register the mark within each Class.

### 2.7 What territories (including dependents, colonies, etc.) are or can be covered by a trade mark in your jurisdiction?

UK trade marks cover England, Wales, Scotland, Northern Ireland and the Isle of Man.

### 2.8 Who can own a trade mark in your jurisdiction?

Any natural or legal person.

### 2.9 Can a trade mark acquire distinctive character through use?

A trade mark can acquire distinctive character through use.

### 2.10 How long on average does registration take?

If no oppositions are raised, registration of a mark takes approximately four months. If oppositions are raised it can take considerably longer.

### 2.11 What is the average cost of obtaining a trade mark in your jurisdiction?

At the UKIPO a standard online application for registration of a mark in one class is £170. An additional £50 is charged per additional class in the application. This excludes associated professional fees of a law firm/trade mark attorney.

### 2.12 Is there more than one route to obtaining a registration in your jurisdiction?

There are currently three routes: a UKTM issued by the UKIPO; an EUTM issued by the European Union Intellectual Property Office (the "EUIPO"); or an international registration obtained through the Madrid Protocol designating either the UK or the EU. After Brexit, EUTMs and international registrations designating the UK will no longer cover the UK, but a new equivalent UK right is due to come into existence automatically upon Brexit.

### 2.13 Is a Power of Attorney needed?

No, a PoA is not required.

### 2.14 If so, does a Power of Attorney require notarisation and/or legalisation?

This is not applicable.

### 2.15 How is priority claimed?

Priority is claimed at the application stage.

### 2.16 Does your jurisdiction recognise Collective or Certification marks?

Yes, such marks are recognised in the United Kingdom.

## 3 Absolute Grounds for Refusal

### 3.1 What are the absolute grounds for refusal of registration?

The following absolute grounds apply:

- the mark is not capable of distinguishing the goods and services of one undertaking from other undertakings, or the mark has not been represented in a clear and precise manner;
- the trade mark consists exclusively of a shape or other characteristic which:
  - results from the nature of the goods;
  - is necessary to obtain a technical function; or
  - gives substantial value to the goods in question;
- the mark is devoid of distinctive character;

- the mark is descriptive of the goods and services in question;
- the mark is customary in the relevant trade;
- the mark is contrary to public policy or principles of morality;
- the mark is deceptive;
- use of the mark is prohibited by EU or UK law;
- the application has been made in bad faith; or
- the mark consists of or contains protected emblems.

### 3.2 What are the ways to overcome an absolute grounds objection?

A response to the absolute grounds objection must be filed within two months of receipt of the examination report. How the objection is overcome will depend on the objection that has been raised. Many objections focus on unclear trade mark specifications (i.e. the list of goods and services) and can be overcome by clarifying the terms included in the specification.

Alternatively, if refusal is based on the mark being devoid of distinctive character or being descriptive of the goods or services in question, the applicant may seek to prove that the mark has acquired distinctiveness over time through use of the mark alongside the relevant goods or services.

### 3.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

Any decision from the UKIPO can be appealed to either the Appointed Person or the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

### 3.4 What is the route of appeal?

There are two routes: (1) to an Appointed Person; or (2) to the High Court in England, Wales and Northern Ireland and the Court of Session in Scotland.

## 4 Relative Grounds for Refusal

### 4.1 What are the relative grounds for refusal of registration?

The following relative grounds apply:

- (1) The sign being applied for is identical with an earlier trade mark registered for identical goods or services.
- (2) The sign is identical 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 on the part of the average consumer.
- (3) The sign is identical with or similar to an earlier trade mark and the earlier mark has a reputation in the UK (or, where the earlier mark is an EUTM (pre-Brexit), it has a reputation 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.

### 4.2 Are there ways to overcome a relative grounds objection?

It is possible to overcome relative grounds arguments by successfully defending the opposition raised, or reaching a compromise with the

opponent, for example by amending the specification of the trade mark application so that it does not conflict with the third party's earlier rights. Note that the UKIPO does not *ex officio* raise relative grounds objections: it is down to third parties to oppose the application in question.

#### 4.3 What is the right of appeal from a decision of refusal of registration from the Intellectual Property Office?

See question 3.3 above.

#### 4.4 What is the route of appeal?

See question 3.4 above.

### 5 Opposition

#### 5.1 On what grounds can a trade mark be opposed?

A trade mark can be opposed on absolute and/or relative grounds.

#### 5.2 Who can oppose the registration of a trade mark in your jurisdiction?

Anyone may oppose a trade mark application on the basis of absolute grounds but only owners of earlier rights may oppose a registration on the basis of relative grounds.

#### 5.3 What is the procedure for opposition?

A third party may oppose a trade mark application within two months of its publication in the Trade Marks Journal. It is possible to extend this period by a further month by filing a "Notice of threatened opposition".

The applicant is given two months from the date of notification of the opposition to file their defence. The opponent and applicant may then submit further evidence in turn before the hearing officer issues their decision.

Cooling-off periods for the discussion of settlement and suspensions of the proceedings are available on joint request of the parties.

In most instances a hearing officer will give their decision on the opposition based on written submissions alone, but sometimes an oral hearing will be held.

### 6 Registration

#### 6.1 What happens when a trade mark is granted registration?

A registration certificate is issued.

#### 6.2 From which date following application do an applicant's trade mark rights commence?

Once registered, UK registered trade mark rights take effect from the date of filing.

#### 6.3 What is the term of a trade mark?

UKTMs are valid for 10 years from the date of filing but can be renewed indefinitely.

#### 6.4 How is a trade mark renewed?

A trade mark may be renewed online by submitting a TM11 form at the UKIPO up to six months before or six months after the expiry date of the registration.

### 7 Registrable Transactions

#### 7.1 Can an individual register the assignment of a trade mark?

Yes, such registration is possible.

#### 7.2 Are there different types of assignment?

Assignments may be for the entire trade mark registration, i.e. for all goods/services for which the mark is registered; or assignments may be partial, i.e. for some but not all goods/services.

#### 7.3 Can an individual register the licensing of a trade mark?

Yes, such registration is possible.

#### 7.4 Are there different types of licence?

Licences may be exclusive or non-exclusive. Exclusive licences give the licensee an exclusive right to use the trade mark registration to the exclusion of all others, including the trade mark proprietor. A non-exclusive licence can be granted to any number of licensees.

#### 7.5 Can a trade mark licensee sue for infringement?

Yes, where the licence provides for this, or if the trade mark owner otherwise consents. In addition, where an exclusive UKTM licence contains a provision granting the licensee the same rights and remedies as if it been an assignment, the exclusive licensee can bring infringement proceedings in their own name.

#### 7.6 Are quality control clauses necessary in a licence?

Quality control clauses are necessary to prevent licensees from using marks in such a way that might make them vulnerable to revocation.

#### 7.7 Can an individual register a security interest under a trade mark?

Yes, such registration is possible.

## 7.8 Are there different types of security interest?

As trade marks are considered intangible property, security usually takes the form of a mortgage or charge.

## 8 Revocation

### 8.1 What are the grounds for revocation of a trade mark?

The following grounds apply:

1. No genuine use of the trade mark has been made by the TM owner or with its consent for five years following registration in relation to the goods/services for which the trade mark was registered, or there has been an interruption of such use for a consecutive period of five years, and in each case no proper reason for non-use.
2. As a result of acts or omissions by the trade mark owner, the mark has become the common name in the trade for goods/services for which it is registered.
3. As a result of the use made of it, the trade mark is liable to mislead the public as to the nature, quality or geographical origin of the goods or services.

### 8.2 What is the procedure for revocation of a trade mark?

The applicant of the revocation action must submit a TM26(N) form (non-use grounds) or a TM26(O) form (other grounds) to the UKIPO. The UKIPO will serve this on the trade mark owner who will have two months to file a defence and counterstatement, which will in turn be served on the applicant. Submissions and the filing of evidence will be timetabled subsequently.

Once a hearing has taken place or the submissions have been filed and reviewed, a hearing officer will issue a decision in writing.

### 8.3 Who can commence revocation proceedings?

Any natural or legal person may commence revocation proceedings.

### 8.4 What grounds of defence can be raised to a revocation action?

Where an action on the grounds of non-use has been filed, the burden of proof rests with the owner to demonstrate genuine use, or show that there are proper reasons for non-use.

Additionally, where the five-year non-use period has expired, but use of a trade mark resumes at least three months before an application for revocation is made, the registration shall not be revoked. This exception will not apply to any commencement of use which occurs within three months of an application for revocation, unless there is evidence that preparations for commencement of use began before the proprietor became aware of the application.

For other grounds of revocation beyond non-use, the defence consists of arguing that the ground has not been established.

### 8.5 What is the route of appeal from a decision of revocation?

Appeal may be made either to the Appointed Person or to the High Court.

## 9 Invalidity

### 9.1 What are the grounds for invalidity of a trade mark?

Registration of a mark in breach of absolute or relative grounds for refusal.

### 9.2 What is the procedure for invalidation of a trade mark?

A TM26(I) form should be filed to begin invalidity proceedings. Both parties will then be given opportunities to submit evidence. A hearing may be requested, following which the hearing officer will issue a decision.

### 9.3 Who can commence invalidation proceedings?

Any person can bring invalidity proceedings on the basis of absolute grounds for refusal, but only a proprietor or licensee of an earlier mark can bring proceedings on relative grounds.

### 9.4 What grounds of defence can be raised to an invalidation action?

Acquiescence (for relative grounds) or acquired distinctiveness (for absolute grounds) can be raised. For other grounds of invalidity, the defence consists of arguing that the ground has not been established.

### 9.5 What is the route of appeal from a decision of invalidity?

Appeal may be made either to an Appointed Person or to the High Court.

## 10 Trade Mark Enforcement

### 10.1 How and before what tribunals can a trade mark be enforced against an infringer?

A UKTM may be enforced against an alleged infringer of the mark in the High Court; the Intellectual Property Enterprise Court (the "IPEC"); or in certain county courts.

### 10.2 What are the key pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

The key pre-trial steps may include:

- exchange of pleadings;
- attending a Case Management Conference ("CMC") to determine the timetable and any evidential issues;
- disclosure; and
- exchange of evidence and any expert reports.

The Civil Procedure Rules ("CPR") Directive on Pre-Action Conduct sets out guidance for the parties, which includes ensuring that they understand each other's positions, and making reasonable attempts to settle the proceedings.

On average, proceedings in the Chancery Division of the High Court will reach trial between 18 months and two years from commencement. The timetable in the IPEC is usually quicker.

### 10.3 Are (i) preliminary, and (ii) final injunctions available and if so on what basis in each case?

Preliminary (or 'interim') and final injunctions are available.

Preliminary injunctions require there to be a serious question to be tried, that the balance of convenience favours the claimant and that the claimant will suffer irreparable harm to their business if the defendant's activities continue (or commence). The claimant must also act with urgency.

A court will typically award a final injunction if infringement is established, but the court exercises its discretion in each case.

### 10.4 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, assuming those documents or materials fall within the scope of the 'disclosure' which the court has directed at the start of the case. For example, if the court orders standard disclosure, a party must disclose documents which support or adversely affect his or another party's case, which have been retrieved following a proportionate search. A party may also apply to the court for specific disclosure of relevant documents, where it believes that the current disclosure is inadequate.

### 10.5 Are submissions or evidence presented in writing or orally and is there any potential for cross-examination of witnesses?

Written submissions are made in the form of a skeleton argument. These are supplemented by oral submissions. Written evidence is provided to the court. That evidence will not be presented orally unless a witness is called for cross-examination.

### 10.6 Can infringement proceedings be stayed pending resolution of validity in another court or the Intellectual Property Office?

In theory, yes, but in practice the court is reasonably unlikely to do so unless compelled to under the EUTM Regulation. The latter point will cease to be relevant after completion of Brexit except in certain circumstances.

### 10.7 After what period is a claim for trade mark infringement time-barred?

After the expiry of six years from the date of the last infringement unless there has been deliberate concealment, fraud, or a procedural mistake.

### 10.8 Are there criminal liabilities for trade mark infringement?

Yes, criminal liabilities exist. In general, these offences relate to dealing in counterfeit and 'grey market' goods.

### 10.9 If so, who can pursue a criminal prosecution?

The Crown Prosecution Service or Trading Standards most commonly pursue such actions, but individual trade mark owners may also do so.

### 10.10 What, if any, are the provisions for unauthorised threats of trade mark infringement?

A person aggrieved by an unjustified threat of trade mark infringement proceedings may initiate proceedings seeking a declaration that the threat was unjustified, an injunction preventing the threats being continued, and damages in respect of any losses resulting from the threat. It is a defence to show that the threat was justified, i.e. that the acts alleged to infringe do in fact constitute infringement.

A communication contains a 'threat' if a reasonable person would understand that a registered trade mark exists and there is an intention to bring infringement proceedings in relation to an act done in the UK.

Threats made about use in relation to services, rather than goods, are not actionable.

## 11 Defences to Infringement

### 11.1 What grounds of defence can be raised by way of non-infringement to a claim of trade mark infringement?

Defendants can argue that the conditions for establishing liability are not present, e.g. use was with consent; is not liable to affect the functions of the trade mark; is not 'in the course of trade'; is not in relation to goods/services; no likelihood of confusion, etc.

### 11.2 What grounds of defence can be raised in addition to non-infringement?

There are various grounds of defence, contained within sections 11, 11A and 12 of the TMA, including but not limited to: use of indications as to the characteristics of goods/services, use which is necessary to indicate the intended purpose of a product or service, use of an individual's own name or address, in each case in accordance with honest practices; use of a later registered trade mark which would not be declared invalid in invalidity proceedings; use where the mark asserted is liable to revocation for non-use; and use in relation to goods already placed on the EEA with the trade mark owner's consent (exhaustion). Other grounds include honest concurrent use and acquiescence/delay/estoppel.

## 12 Relief

### 12.1 What remedies are available for trade mark infringement?

The following remedies are available: declarations; injunctions; damages or an account of profits; delivery up and destruction of goods; or publication of the judgment.



### 12.2 Are costs recoverable from the losing party and, if so, how are they determined and what proportion of the costs can usually be recovered?

Normally, the unsuccessful party will be ordered to pay the successful party's costs. These costs are usually assessed after the trial and can be subject to a detailed assessment by the court if the parties do not agree on an amount to be paid. In a case where court-approved costs budgets are in place and not exceeded, the successful party can expect to recover the vast majority of its costs.

## 13 Appeal

### 13.1 What is the right of appeal from a first instance judgment and is it only on a point of law?

Appeals are only on a point of law. Permission is required from either the first instance judge or Court of Appeal. Such permission will be given where the court considers that there is a real prospect of success or another compelling reason for the appeal to be heard.

### 13.2 In what circumstances can new evidence be added at the appeal stage?

The circumstances are very limited and normally limited to where the evidence could not have reasonably been obtained for use in the lower court, and where the use of such evidence would have had a real impact on the result of the case.

## 14 Border Control Measures

### 14.1 Is there a mechanism for seizing or preventing the importation of infringing goods or services and, if so, how quickly are such measures resolved?

Yes, by filing a Customs notice. Pre-Brexit, an EU-wide notice would cover the UK. After Brexit a new notice will be required by UK Customs. The mechanism usually resolves issues very quickly unless the importer objects to the destruction of the goods (fairly rare), in which case the trade mark owner may be required to bring court proceedings for a declaration of infringement, which will slow the process down.

## 15 Other Related Rights

### 15.1 To what extent are unregistered trade mark rights enforceable in your jurisdiction?

Unregistered trade marks are enforceable in the UK through 'passing off' actions. The claimant must establish: that it owns 'goodwill' in the mark; that there has been a misrepresentation leading to deception of the public; and that this has caused the claimant damage.

### 15.2 To what extent does a company name offer protection from use by a third party?

Company names offer protection against third parties using the same or similar names, if the criteria for a passing off claim are met

(see question 15.1 above). A company can also raise a dispute with the Company Names Tribunal about a similar third-party company name.

### 15.3 Are there any other rights that confer IP protection, for instance book title and film title rights?

Not unless the title is registered as a trade mark, meets the conditions for a passing off claim, or is itself protected by copyright (unlikely). There is no separate statutory regime.

## 16 Domain Names

### 16.1 Who can own a domain name?

Any legal or natural person.

### 16.2 How is a domain name registered?

A domain name may be registered via accredited registrars or registration service providers.

### 16.3 What protection does a domain name afford *per se*?

Unless passing off can be established, having a domain name itself offers very little protection against third-party use of a similar name, other than preventing others from registering the same domain name.

## 17 Current Developments

### 17.1 What have been the significant developments in relation to trade marks in the last year?

The most noteworthy development was the introduction of the Trade Mark Regulations 2018, amending the TMA to implement the Directive.

### 17.2 Please list three important judgments in the trade marks and brands sphere that have been issued within the last 18 months.

In the *AMS Neve v Heritage Audio* case ([2018] EWCA Civ 86), the Court of Appeal grappled with the question of where the act of infringement is committed if use on a website is (said to be) infringing an EUTM. Is it the territory targeted by the website (the Court of Appeal found strong support for this view), or the territory in which the persons controlling the website are located (as had been found at first instance)? The circumstances were that an undertaking in Member State A (here, Spain) had placed an advertisement on a website targeted at consumers in Member State B (here, the UK): was this sufficient to confer jurisdiction in Member State B? The question is relevant to which court has jurisdiction to hear online disputes. It has been referred to the Court of Justice of the European Union (the "CJEU") and so the answer will be relevant throughout the EU. (Although CJEU judgments made after exit day will not bind UK courts once Brexit takes effect, they will still be strongly persuasive.)

In the *Sky v SkyKick* case ([2018] EWHC 155), the Court was partly concerned with questions about the permissible breadth of trade mark

specifications of goods and services. In particular, it is not clear whether or not a registered trade mark can be invalidated on the basis that part (or all) of its specification of goods/services lacks clarity and precision. Likewise, it is an open question whether it can constitute bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services. Both these questions, and others, have therefore been referred to the CJEU. The answers to these questions could have a material impact on both filing and enforcement strategies in the UK as well as the EU.

In the *Merck KGaA v Merck & Co., Inc.* case ([2017] EWCA Civ 1834), the Court of Appeal reviewed the law on whether use on websites and social media was targeted at the UK. The test expressed in this case has since been applied by the Court of Appeal in the *Argos* litigation. The intention of the trader to target consumers in the UK may be relevant, as may other circumstances beyond the website itself; for example, the nature and size of the trader's business and the number of visits made to the website by consumers in the UK. When applying these principles to this case, Kitchin LJ held that the defendant, MSD, conducted its healthcare business in many countries around the world, including the UK, and that business was at all material times supported and promoted by the websites in issue. They constituted an integrated group of sites which were accessible by and directed at users in the UK and other countries in which MSD trades. Separately, the Court also took the chance to restate the approach to assessing partial revocation for non-use, which it had previously laid out in the *Maier v Asos* case. Essentially, if a term in a specification is sufficiently broad that it is possible to identify a number of sub-categories capable of being viewed independently, then use in one sub-category would not count

as use in relation to all the other sub-categories. This is to be considered having regard to the perception of the average consumer and purpose and intended use of the products and services in issue.

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### 17.3 Are there any significant developments expected in the next year?

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Brexit is a development which will have a significant impact on trade mark protection and enforcement in the UK, but at the time of writing the precise form and timing of Brexit is not known.

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### 17.4 Are there any general practice or enforcement trends that have become apparent in your jurisdiction over the last year or so?

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In anticipation of Brexit, there has been a significant increase in UK trade mark applications, chiefly at the same time as new marks are being filed with the EUIPO, but also in certain circumstances for marks already registered as EUTMs. Likewise, where viable, claimants are more likely to include at least one UK registered trade mark in an infringement claim brought in the UK, rather than just relying on an EUTM registration. This is a safeguard to ensure that the UK Court will have jurisdiction to continue hearing at least part of the claim after Brexit. After Brexit, claimants seeking injunctive relief covering the UK will need to bring UK court proceedings rather than relying on a pan-EU injunction issued by a court in an EU Member State (as they might previously have done).

**Nick Aries**

Bird & Bird (America) LLP  
415 Mission Street  
37<sup>th</sup> Floor  
San Francisco, CA 94105  
USA

Tel: +1 415 463 7468  
Email: [nick.aries@twobirds.com](mailto:nick.aries@twobirds.com)  
URL: [www.twobirds.com](http://www.twobirds.com)

Nick is a partner and co-head of our 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 WTR 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*.

**Daisy Dier James**

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

Tel: +44 207 415 6000  
Email: [daisy.dierjames@twobirds.com](mailto:daisy.dierjames@twobirds.com)  
URL: [www.twobirds.com](http://www.twobirds.com)

Daisy is an associate in our Intellectual Property Group and a member of our International Product Design Group and Brand Management Team based in London.

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59 Tanner Street, London SE1 3PL, United Kingdom  
Tel: +44 20 7367 0720 / Fax: +44 20 7407 5255  
Email: [info@glgroup.co.uk](mailto:info@glgroup.co.uk)