

IP Enforcement in the UK and Europe

Dr Michael Edenborough QC

**Palo Alto, Washington DC and Houston, USA
8th – 13th March 2012**

serie court

UK Tribunals and Courts

■ First instance Tribunals

- Patent Office
- Trade Marks Registry
- Designs Registry
- Copyright Tribunal

■ Appellate Tribunals

- Appointed Person (trade marks)
- Registered Designs Appeal Tribunal

■ Courts (CPR Part 63)

- Patents County Court
- High Court (Chancery Division, Patents Court, Administrative Court)
- Court of Appeal
- UK Supreme Court (ex House of Lords)

UK Patent Litigation

■ matters exclusive to the Patent Office

- *e.g.* grant of UK patents; restoration (s 28); post-grant amendment; entitlement (but may refer to the Ct)

■ shared jurisdiction of PO / Court

- *e.g.* declaration of non-infringement; infringement (only by agreement, and cannot grant injunctive relief)

■ matters exclusive to the Courts

- *e.g.* threats

■ *cf* German system of bifurcation

UK Trade Mark Litigation

■ matters exclusive to the Registry

- *e.g.* grant of UK TMs; oppositions; rectifications (s 64(4) & (5))

■ shared jurisdiction of TMR / Court

- *e.g.* revocation / invalidity; rectification (s 60 & 64(1))

■ matters exclusive to the Courts

- *e.g.* threats; infringement

■ appeals to the AP or the Court

UK Copyright & Design Litigation

■ Design Registry

- (incl. some UDR matters: CDPA 1988 ss 246 & 247)

■ Copyright Tribunal

- e.g. royalty disputes / licensing fees

■ Court

- Pat Ct: registered designs
- ChD: copyright and UDR

■ proposed new Small Claims IP Court for, in particular, low value copyright claims

serle court

EU and European Tribunals and Courts

■ Tribunals

- Patents: EPO
- Trade Marks and Designs: OHIM

■ Courts

- Community TM and Design Courts
- General Court / Court of Justice
- Appeals and Article 267 references
- Unified Patent Court

European (not EU) Patent Litigation

■ European Patent Office (EPC)

- *e.g.* grant and post-grant opposition
- appeal to Board of Appeal / Enlarged BoA

■ Brussels I Regulation (EC) №. 44/2001

■ Unified Patent Court

- Central Division, Court of Appeal

serle court

EU Trade Mark and Design Litigation

■ OHIM, Alicante

- *e.g.* grant, opposition and cancellation
- appeal to BoA / Grand BoA
- then to General Court, Court of Justice
- No jurisdiction to hear infringement actions

■ Community TM Reg. №. 207/2009 and CD Reg. №. 6/2002

- *sui generis* rules on jurisdiction

EU Copyright Litigation

- **Brussels I Regulation (EC) No. 44/2001**
- *Lucasfilm v Ainsworth* [2011] UKSC 39

Michael Edenborough QC

■ Contact Details:

- Serle Court, 6 New Square, Lincoln's Inn, WC2A 3QS, UK
- (t) + 44 (0)20 7242 6105
- (e) MEdenborough@SerleCourt.co.uk

■ MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)

- All areas of IP law and practice, in particular patents, trade marks, copyright and designs. Over 85 reported cases since 2000, of which two thirds were appeals or judicial reviews. Appeared often before the General Court and Court of Justice (Luxembourg) in appeals from OHIM and Article 267 references (over 40 cases), and in the European Patent Office (Legal and Technical BoA). Acted for the Comptroller-General of Patents, the Registrar of Trade Marks, the UK government, Institute of Trade Mark Attorneys, the Chartered Institute of Patent Attorneys and AIPPI UK Group.