



Michael Edenborough QC

Year of Silk: 2010 Year of Call: 1992

“Michael’s strengths are his wide but detailed knowledge of IP law, and ability to find ways through complex issues. As an advocate, he is calm, measured and clear in his submissions and responses to questions from the bench - one of the best QCs at the IP Bar, particularly for trade mark work.”

The Legal 500

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Practice Overview

Michael's practice involves advice and advocacy on infringement and validity issues concerning all types of IPRs. As such, he deals with declarations of invalidity, revocation, rectification and cancellation of registered intellectual property rights such as trade marks, registered designs and patents. He is often instructed in cases involving the main unregistered IPRs such as goodwill, copyright, designs and confidential information, and also the more unusual rights such as plant varieties, moral rights, database rights and geographical indications. Further, he has been instructed on matters dealing with title to IPRs, Freedom of Information requests relating to IPRs, data protection, the calculation of the financial relief and what other remedies that might be available.

His forte is finding points of law and practice that can be invoked in order to solve a problem that has arisen for the client (be it lay or professional).

In addition, Michael acts as an expert witness on points of English law in foreign cases, and as a mediator in IP cases - in particular where the parties wish to adopt the facilitative approach for their mutual advantage.

Areas of Expertise

Intellectual Property

Principal Areas of Practice within IP

- Trade marks and passing-off
- Copyright and designs (both registered and unregistered)
- Patents and trade secrets / confidential information
- Others IPRs such as plant varieties, certification and collective marks, geographical indications (e.g. PDOs, PGIs, and TSGs), database rights and moral rights

Michael aims to provide commercial solutions for his clients, so as to place them in the best possible position to protect, exploit and enforce their IPRs, or to avoid or minimize their liability if threatened by such rights, be it by negotiation, ADR, registration, litigation or otherwise. His forte is tricky points of law and practice.

He has acted for the Comptroller-General of Patents, the Registrar of Trade Marks and the UK Government before the Court of Justice of the European Union, the House of Lords, the Court of Appeal and the High Court (both Chancery Division and Patents Court) on, inter alia, appeals from the Patent Office and the Registry. He has been instructed by the Chartered Institute of Patent Attorneys, the Chartered Institute of Trade Mark Attorneys and AIPPI UK to advise and act for them in the Court of Justice and the Supreme Court. He appears regularly before the General Court of the European Union (formerly the Court of First Instance), Luxembourg on appeals from the EU IPO, and on Article 267 references and appeals to the Court of Justice (over 50 cases in all). He has also acted before both the legal and technical Boards of Appeal and the Opposition Division of the European Patent Office. He has acted in literally hundreds of matters before the trade mark registry, and in many tens of appeals to the Appointed Person and the High Court.

Michael took silk in 2010, which was 12 years after his first reported case. He now has well over a 100 cases in the law reports, two-thirds of which were appeals or judicial reviews.

The following reported cases are merely a selection of the more important and/or interesting ones to illustrate the type of work in which he is commonly instructed. Some areas of his practice are under-represented by reported cases, as those areas settle more often than others before reaching court and so do not result in a reported case (this is particularly so for GI cases and the patent/confidential information matters in which he is involved).

Trade Marks and Passing-Off Substantive Law

Lifestyle Equities CV v Amazon UK Services Ltd: [2021] ETMR 27, [2021] FSR 19: a trial that addressed Amazon's various international business models in the context of trade mark infringement over the internet.

Fromageries Bel SA v J Sainsbury plc [2020] ETMR 14, [2020] BusLR 440: an appeal to the High Court concerning the invalidation of a colour/shape mark due to lack of certainty.

Skullduggery Rum Ltd v Globefill Inc [2020] ETMR 9: 3D trade mark in the shape of a human skull, Article 7(1)(e)(iii) added value issues.

Lifestyle Equities CV v Santa Monica Polo Club [2018] FSR 15: A trade mark trial concerning the logo of a polo player where the potentially differentiating words "Beverley Hills" and "Santa Monica" were held not sufficient to avoid liability.

Moroccanoil Israel Ltd v Aldi Stores Ltd [2014] ETMR 55: Trial for passing-off with respect to look-a-like packaging.

adidas v Marca Mode Case C-102/07, [2008] FSR 38; [2008] ETMR 44: acted for the UK Government on the scope of protection that should be afforded to a mark that was distinctive only by reason of acquired distinctiveness, in this case the three-stripe mark.

West (t/a Eastenders) v Fuller Smith & Turner (ESB) [2002] FSR 55; and CA: [2003] ETMR 30; [2003] FSR 44, and costs judgment [2004] FSR 32: reducing the specification of the ESB trade mark from "beer" to "bitter".

Trade Marks and Passing-Off Procedural Issues

Chanel v EUIPO Case T-44/20 [2021] ETMR 40: an appeal to the General Court to determine whether an earlier trade mark may be re-orientated spatially so as to increase its similarity with the latter application.

Praesidiad NV v Tescon Sicherheitssysteme Schweiz GmbH [2020] FSR 33: an appeal to the Appointed Person on the nature of discretion to extend time in which to serve a TM8.

Lifestyle Equities CV v Royal Country of Berkshire Polo Club Ltd [2019] FSR 14: securing jurisdiction over foreign defendants for acts of infringement committed overseas.

Pinterest Inc v Premium Interest Ltd [2015] ECC 14: whether a CTM confers a right to use that provides a freestanding defence to a passing-off action.

CIPA's TM Application (IP TRANSLATOR) Case C-307/10 [2010] RPC 31; [2012] ETMR 42; [2013] RPC 20; [2013] ETMR 42: an Article 267 TFEU reference to the CJ on the proper construction of a trade mark specification of goods and services: "means-what-it-says" vs "class headings covers all" approach.

Budejovicky Budvar NP v Anheuser-Busch Inc. [2010] RPC 7: appeal to the CA on the issue of statutory acquiescence, which became the subject of an Article 267 reference to the Court of Justice (Case C-482/09).

Imagination Technologies Ltd v OHIM (Pure Digital) Case T- 461/04, [2008] EMTR 10, appealed to the ECJ Case C-542/07 P, [2010] ETMR 19: concerned the date by which a trade mark application needs to have acquired a distinctive character.

Copyright, Designs and Moral Rights

Utopia Tableware Ltd v BBP Marketing Ltd [2014] ECC 34: trial of registered and unregistered design rights in the design for a beer glass.

Temple Island Collections v New English Teas [2012] FSR 9: the scope of protection of a digitally manipulated photograph (the Red Bus case).

Harrison v Harrison [2010] FSR 25: a rare case concerning the moral rights of derogatory treatment and false attribution.

Landor & Hawa v Azure Designs [2006] FSR 22; [2006] ECDR 31; [2007] FRS 9, CA: leading case on the "method or principle of construction" exclusion to UK design right and the "technical function" exclusion to Community design right.

Woodhouse v Architectural Lighting Systems [2006] RPC 1; [2006] ECDR 11: registered and unregistered design right infringement trial concerning street lamps; and the leading case on cancellation of a registered design on grounds that the applicant was not entitled to the related unregistered right.

Lambretta Clothing v Teddy Smith [2005] RPC 6, CA: leading case on the interaction between copyright protection and design right protection.

Blayney (t/a Aardvark Jewellery) v Clogau St David's Gold Mines [2002] FSR 14; [2003] FSR 19, CA: leading case on the quantification of damages in a copyright infringement action.

Patents

Michael is regularly instructed on a wide variety of patent and technical confidential information cases, covering such technologies as biotech gene mutations, pharmaceuticals, mechanical devices, and methods of doing business. He is also instructed as a part of a team of counsel in patent / confidential information cases that involved other areas of law such as competition, directors' duties and general commercial matters. For example, in a case for the Department of Health, he is the IP silk along with another silk and two juniors in a competition / abuse of the patent system allegation relating to the patenting and supply of a widely-used pharmaceutical; further, he was the junior silk in a 28-day trial involving allegations of breaches of directors' duties relating to two high-tech North Sea oil drilling companies that included patent and copyright issues.

Toshiba's App J-09/07 [2009] EPOR 17: acted for the appellant before the Legal Board of Appeal in the EPO seeking restitutio in integrum for a missed priority deadline.

Blacklight Power v Comptroller-General of Patents [2009] RPC 6, [2009] BusLR 748: acted for the Comptroller-General of Patents in this appeal from the Patent Office, which concerned the appropriate test for inventions that might not have any industrial applicability. The purported invention involved a novel species of hydrogen as proposed by the Grand Unified Theory of Classical Quantum Mechanics.

Rhone-Poulenc Rorer v Yeda Research [2006] RPC 24, PtCt; [2007] RPC 9, CA; [2008] RPC 1, HLs: acted for the Comptroller-General of Patents in this matter dealing with entitlement proceedings, amendments to pleadings and the powers of the Comptroller-General.

R v Comptroller General of Patents, ex parte Penife [2004] RPC 37: a judicial review of a decision of the Patent Office acting as a receiving office for WIPO.

R v Comptroller General of Patents, ex parte Ash and Lacy [2002] RPC 46: a judicial review of a decision of the Patent Office concerning its powers to act ex officio.

Wheatley v Drillsafe [2001] RPC 7, CA: notable as the only patent case in which Aldous LJ was in the minority.

General Procedural Matters

Alliance Pharmaceuticals v EUIPO Case T-279/18 [2020] ETMR 7: construction of ambiguous trade mark specification.

Boyer v Stockbridge [2019] FSR 20: the consequences of a default judgment in the UK trade mark registry

Hendrick v Knight [2014] ETMR 58: the possibility of a pro bono costs order before the Appointed Person.

Her Majesty's Solicitor General v Dodd [2014] FSR 27: committal for contempt of court relating to false witness statements in an IP matter.

R (otao Prudential) v Special Commissioner of Income Tax [2013] 2 WLR 325; [2013] 2 All ER 247: acted for AIPPI UK on an appeal to the Supreme Court on whether the common law right of legal advice privilege extended to advice given by tax accountants.

Enercon TM Case T-472/07 before the CFI, and then appealed to the ECJ Case C-59/09: acted for ITMA in an attempt to secure rights of representation and audience for Trade Mark and Design Litigators.

Evans (t/a Firecraft) v Focal Point Fires [2010] ETMR 29: acted for the CI in establishing that an estoppel can arise from a previous trade mark registry invalidation decision in a subsequent action for passing-off in the High Court.

R v DEFRA ex parte Northern Foods [2006] ETMR 31; [2006] FSR 29: concerning the Protected Geographical Indication "Melton Mowbray Pork Pies"; the reference from the CA to the ECJ Case C-169/06 on the meaning of "region" settled.

Hormel Foods v Antilles Landscape Investments [2005] ETMR 54; [2005] RPC 28: abuse of process and issue estoppel.

Reckitt Benkiser v Home Pairfum [2004] FSR 37; [2005] ETMR 94: refusal to join a new Part 20 defendant as an abuse of process in a threats action.

Telecommunications and Information Technology

While many telecommunications and Information Technology disputes are contractual in nature, many also involve some consideration of intellectual property rights such as patents, satellite and broadcasting rights, copyright and database rights. An in-depth appreciation and familiarisation with these rights is often central to understanding the issues involved.

Michael has experience in dealing with large disputes that utilise such technology, and his previous scientific training is often crucial to discovering and exposing the real problem in such cases.

Sports, Entertainment & Media

In these areas of law, various intellectual property rights are deployed to underpin the justification for the often very-large remuneration packages that are involved. It is common for the traditional boundaries of the IP rights involved to be pushed to the limit (and sometimes to stray perilously close to crossing-over). In such circumstances it is vital to ascertain precisely the proper limits of what can and cannot be done in order to ensure that the resultant contract achieves the desired objectives. In this regard, the handling of goodwill associated with sporting or entertainment celebrities is key to formulating a solution.

Michael has acted for a wide range of clients in these various fields, from the celebrities themselves to their agents and production companies, and handled a multitude of IP rights, such as a registered trade marks, goodwill, copyright, designs (registered and unregistered), and moral rights.

Mediation

Michael's particular expertise in this field is his use of the facilitative, rather than evaluative, approach to mediation. So, rather than acting as a substitute tribunal attempting to determine the relative merits of the case on incomplete evidence and partial submissions, he endeavours to find a way for the parties to reach a solution to their impasse – not one that involves compromise and dissatisfaction on each side, but one that allows each party to gain something positive from the situation. This approach often requires the parties to reconsider their previously held positions and to appreciate both the potential weaknesses in their own case and the potential strengths in the other side's case, and then to perceive where benefits can be gleaned for both sides; sometimes by working together, and on other occasions by leaving each other to follow their separate paths.

Art

Michael has extensive experience in artistic copyright matters having acted for or against a wide range of clients, such as artists, animators, film companies, galleries and museums. Many of those cases also involved a detailed consideration of the related moral rights that may be invoked, such as the right to be identified as the author, the right to object to derogatory treatment, and the right to negate false attribution. For example, he acted for the street artist Stik in his dispute with a gallery over the unauthorised segmentation and sale of the resultant panels of a work of art painted onto the side of a shipping container.

He has dealt with a wide range of copyright works, such as graphic works and sculptures, and works that are not readily categorised under the CDPA 1988 such as installations and other forms of contemporary art.

Further, he has experience advising upon matters relating to artists' resale right.

In addition, due to his previous experience as a scientist, in particular as a chemist and physicist to doctoral level, he has a particular expertise in dealing with art forgeries as he can readily understand the chemical and physical technical data that underpins such claims and counterclaims.

Recommendations

Intellectual Property

Chambers & Partners (2002 to present)

The Legal 500 (2003 to present)

Quotes

'He is fantastic: a heavyweight silk particularly on trade mark matters. He is very user-friendly and is a good cross-examiner with a very nice demeanour with the court. He gets to the nub of the point quickly.'

Chambers and Partners 2022.

'Michael is supremely knowledgeable and very incisive. He is exceptionally good with clients and at explaining difficult issues in a clear, concise and thoughtful way.'

Legal 500 2022.

Michael Edenborough QC at Serle Court is recognised for his *"unrivalled depth of knowledge relating to UK trade mark law"* as well as his *"tenacious and robust approach to advocacy"* and *"persuasive manner and confidence in court"*.

Who's Who Legal 2021

"He is both an analytical and a tactical thinker." "He is very responsive and proactive."

Chambers and Partners 2021

"Michael's strengths are his wide but detailed knowledge of IP law, and ability to find ways through complex issues. As an advocate, he is calm, measured and clear in his submissions and responses to questions from the bench - one of the best QCs at the IP Bar, particularly for trade mark work."

The Legal 500 2021

"One of the best silks for trademark work, he is brilliantly strategic and tactical."

The Legal 500 2020

"A seasoned silk highlighted for his deep expertise in trademark law. He has additional expertise in patents and design rights disputes. ... He is thorough and highly knowledgeable while being good with clients; a real heavyweight for trade mark work; [and] a very bright and careful thinker."

Chambers & Partners 2020

"He is technically brilliant, has incredible analytical skills, and is not afraid to deliver difficult messages to make sure the client has the right advice."

The Legal 500 2019

"Serle Court's Michael Edenborough QC is a highly effective problem solver and superb oral advocate; he knows how to facilitate wins inside and outside of the courtroom."

World Trademark Review 2019

"He is a well-known heavyweight who you want on your side in a high-profile or high-stakes dispute."

Chambers and Partners 2019

"Brilliant barrister" Michael Edenborough QC of Serle Court is a silk "you can rely on for excellent advocacy on the big day".

World Trademark Review 2018

"A seasoned silk highlighted for his deep expertise in trademark law. He has additional expertise in patents and design right disputes. He is also often instructed in cases concerning geographical indications, data protection and moral rights. 'I am always impressed by Michael's technical skills and frankness on all matters.' 'He is very, very good. He's approachable, always gives considered advice and has a huge range of knowledge.' "

Chambers & Partners 2018

" 'His advice is razor sharp and practical' and 'he is great with clients'. The Serle Court silk is a top appellate advocate and a creative problem solver."

World Trademark Review 2017

"He is recognised for his experience assisting government agencies and abilities handling appellate proceedings. He is brilliant in court and his knowledge base is second to none."

Chambers & Partners 2017

"Very easy to work with and knows his stuff inside out"

The Legal 500 2016

"Well known for his authoritative handling of trade mark disputes, including geographical [indication] cases involving food and drink. He is also recommended for copyright and patent matters, and includes government agencies among his clients. 'His commanding presence and fastidious approach immediately win client confidence.' 'A leading light in the realm of trade marks and passing off.'"

Chambers & Partners 2016

"A talented silk who can hold his own in front of the country's most senior judges"

The Legal 500 2015

"...is a details man. He's got a real forensic eye and he can be relied upon to trip up the other side: if there's a weakness in a case, he'll find it. He has appeals to the European courts pretty much tied up."

World Trademark Review 2015

"Best known for trade mark matters, although he has an academic background in biophysics and so is highly adept at cases involving patent issues. 'He is a thoughtful advocate, able to get to the bottom of a point, place it in context, and present it simply and persuasively.' 'Very-user friendly, and clear - judges warm to him.' ."

Chambers & Partners UK 2015

"Combines intellectual rigour with practical advice"

The Legal 500 2014

"Focuses on trade mark matters but is very capable across the whole IP spectrum. He is noted for his skilful advocacy and knowledge of his subject. 'A man with a sterling mind', he is renowned for the superiority of his intellect."

Chambers & Partners UK 2014

"The most visible and trademark-focused barrister out there', He is frequently seen on some of the country's most important cases, particularly those concerned with registry related issues. Praised for 'knowing law and procedure inside out', he is the first choice of counsel for many firms."

World Trademark Review 2013

"is very sharp and gives prompt and very pragmatic advice' according to one of his many votaries. He is celebrated for his achievements before the trade mark registry, as well as for his nous in copyright, design right and patent matters."

Chambers & Partners UK 2013

"reliable, quick to respond, very amiable and easy to get along with." He also possesses "an excellent knowledge of case law."

Chambers & Partners UK 2012

"a real all-rounder who is excellent at finding ways around difficult issues". He provides "concise, practical advice in language that clients understand," pleasing solicitors by virtue of the fact that "he turns things around very quickly."

Chambers & Partners UK 2011

"really gets stuck in" and is also very commercial: "He's someone I really enjoy putting in front of clients," enthused one interviewee. He provides advice that "gets to the point very quickly," and he always exhibits "a phlegmatic approach – he's not a showboater."

Chambers & Partners UK 2010

"robust advocate and one of the few all-rounders who excels in trade mark work, yet also proves a true heavyweight on patent technology matters" - "he seems to know everything and can explain what is going on with ease" - "no one is going to flip a point past you with him on the case."

Chambers & Partners UK 2009

"bringing order out of chaos" - "always on the right wavelength" - "[he has the] knack of mastering the law and applying it" - "[his] hardcore technical knowledge astounds and impresses those around him as does the way he churns out top-quality work."

Chambers & Partners UK 2008

Publications

The Perils of Co-Existence Agreements

CITMA webinar - 10 February 2021

[Handout available here](#)

Cats and Dogs and Commercial Property Considerations

Solicitors' Journal 2019, 162(10), pp 58-59

[Handout Available](#)

Goodwill, or not...?

CITMA, Manchester, 23.11.2017

[Handout Available](#)

Combating the spread of pirated products: experience and prospects

WIPO Regional Seminar, Kyrgyz Republic, 23.06.2016

[Handout Available](#)

Code of Silence: non-agricultural GIs

ITMA Review, 05.2016

[Handout Available](#)

Counterfeiters, copycats and copyists

Intellectual Property Magazine, 01.04.2016

[Handout Available](#)

Interdigitating PO and TM proceedings

28.01.2015

[Handout Available](#)

Poisonous Priorities in Patent Matters

Reddie & Grose, 26.03.2014

[Handout Available](#)

Quantum in IP Matters

Hogan Lovells, 10.12.2013

[Handout Available](#)

IP Enforcement in the UK and Europe

Palo Alto, USA, 08.03.2012

[Handout Available](#)

The Art of Trade Mark Litigation

LSE, 14.01.2010

[Handout Available](#)

Sex and Swastikas

UK IPO, 31.07.2008

[Handout Available](#)

Major Publications and Committees

Author of "Contentious Trade Mark Registry Proceedings", CITMA - March 2018

Consultant Editor of "Butterworths Intellectual Property Law Handbook" - 13th edition August 2017, 14th edition September 2019, 15th edition October 2021

Contributor to the "Concise Commentary on European Trade Mark and Design Law" - 2011

Revised the chapter on Plant Variety Rights for "Intellectual Property in Europe" – 2nd edition 2002

Author of "Organic Reaction Mechanisms: A Step-by-Step Approach" – 2nd edition 1999, hardback and eBook 2017

Author of "Lecture Notes on Intellectual Property Law" – 1st edition 1995, reprinted 1997

Member of the UK IPO Marks and Design Forum

Member of the former UPC and Enforcement Framework Review Groups, and of the former Law Commission's Advisory Panel on Groundless Threats

Nominated for the *Bar Pro Bono Award* in 2003

In the Press

Mentioned in '[M&S settles lawsuit with Aldi over Colin the Caterpillar cake](#)' Retail Gazette

Quoted in '[Hostesses told to disregard NDAs at infamous London dinner](#)' The Global Legal Post, 14.02.2018

'Land Rover Defender lacks 'distinctiveness', court rules' comments for Intellectual Property Magazine

'Meghan Markle and Harry BACK DOWN on Sussex Royal brand – trademark application withdrawn' comments in The Daily Express

Education & Qualifications

MA (Natural Sciences), Cambridge.

DPhil (Biophysics), Oxford.

Memberships

Associate Member of CIPA and CITMA

Member of AIPPI and the Royal Society of Chemistry
