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# Intellectual Property E-Newsletter

July 2019

## Featured in this issue:

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The Boy Who Cried Wolves

Protecting Intellectual Property

Intellectual Property Rights Abroad

Urgent Work! Intellectual Property Litigation

IP Jargon Buster

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# Welcome to the July edition of our Intellectual Property E-Newsletter, keeping you up to speed with the latest IP law updates.

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# The Boy Who Cried Wolves!

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## Copyright Case Update – High Court

**Davies v Wolverhampton Wanderers Football Club [2019] EWHC (Ch) (15 May 2010)**

A pensioner sued Wolverhampton Wanderers Football club for copyright infringement in relation to the iconic wolf's head design which has been used as the club's logo since 1979.

### Background

A football club's badge is one of its most important assets. Its motif is often strong, simple and iconic. It is treated with the utmost respect and is in many ways sacrosanct to its supporters.

You could be forgiven in assuming a club owns its badge – but that is not always the case. The default position in copyright law is that the copyright in a drawing or design vests with the creator. This was examined recently in the High Court.

### Facts

The Claimant, Mr Peter Davies, alleged that he created the wolf's head design used by Wolverhampton Football Club (**Wolves**).

The club commissioned its logo from a designer Mr Ian Jackson in 1979. The logo created was strikingly similar to the Claimant's design. The Claimant therefore alleged that his original design was somehow copied and used by Wolves as its logo.

Despite suspecting that his logo was copied, the Claimant waited almost 40 years to bring a claim against Wolves. He explained that he had no physical evidence to back up his claim. But then in 2015 the Claimant came across animal designs that he drew when he was a boy, each dated around 1961 - 1963. One of the designs was a wolf's head seen face on and drawn in an angular geometrical style which was very similar to Wolves' logo.

The Claimant recalled entering his design into a local art competition in the 1960's. He produced into evidence a newspaper cutting reporting about a 1963 junior art competition in his locality which he claimed he entered. However, he had no strong corroborating evidence to prove that he did.



## Decision

The case was determined by The Honourable Mr Justice Nugee. The Judge assumed that the Claimant did enter his wolf's head design in an art competition in the 1960's. However, he found that it could not be established from the Claimant's evidence that it was the 1963 competition in the newspaper cutting.

The Judge compared the Claimant's designs with Mr Jackson's designs. He held that at a high level of generality the designs were similar. The question for the Judge was whether the similarities between the designs could lead to the conclusion that the Claimant's designs made their way to Mr Jackson who then copied them. The Judge felt that that was implausible and preferred Mr Jackson's evidence that he came up with the club's logo himself and that any similarities with the Claimant's designs were purely coincidental.

The Judge therefore dismissed the Claimant's claim.

## Comment

The Judge had no trouble in believing that the Claimant had truly convinced himself he created the Wolves logo. It was not a fabricated claim. However, the difficulty for the Claimant (and indeed anyone seeking to bring a copyright infringement claim) was lack of evidence showing which design had been entered into the art competition, what art competition was entered into, and how that design was transmitted to the Wolves' designer.

There is lots that can be done to ensure that Copyright is protected. This is something that we explore in more detail in the upcoming section – [How to Protect IP](#).

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# Protecting IP - A Practical Guide

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The protection of IP is a major concern for most businesses. The last thing you want is to come up with an innovative design or create a piece of original artwork only to have it exploited by someone else.

We have tried to set out some practical guidance below to assist in protecting IP. This is intended to be a quick guide. If you are unsure about how to protect your IP then you should seek professional advice.

There are a series of laws that help to prevent IP theft, but you can take extra measures to protect your IP and to avoid infringing someone else's IP by mistake.

**1. Contracts** Ensure that all contracts and consultancy agreements state that you own the IP developed by you or for you by employees or third-party consultants. A strong internal IP can also enhance protection.

**2. Originality** Conduct a search to establish whether your idea is original. The UK Intellectual Property Office Website allows you to carry out patent and trade mark searches. It is advisable to do this early in development. For example, if you have come up with a name for your new company or brand, a trade mark search allows you to see if that name is already registered by someone else.

**3. Copyright** © You can make your copyright protection stronger by making it clear to the wider public that it is protected by copyright. You can do this by adding the copyright symbol ©, your name and the date of creation.

**4. Registration** ® There are formal IP registration procedures in most countries that allow you to formally record ownership of a patent, design or trade mark. The UK Intellectual Property Office (IPO) processes registration applications in the UK. Adding the registered ® symbol to your mark also lets others know that it is protected and helps prevent unauthorised exploitation.

**5. IP Abroad** There are a number of international routes that allow you to protect your IP abroad. If you are planning to do business abroad then you should ensure that you have protection in whatever territory you are operating in.

**6. Licencing** It may be commercially beneficial to allow others to use your IP. By granting a licence you can govern the use of your IP by an authorised user and receive remuneration in the form of a licence fee. Granting a licence is one of the safest ways of ensuring your IP is protected if you are allowing someone else to use it.

**7. Evidence** Keep a record of the development of your IP. Sign and date copies of drawings, screenshot designs, digitally date photographs and keep a log of communications. The more contemporaneous evidence you have then the greater your chance of proving you are the owner of the IP.

**8. Enforcement** Do not be afraid to enforce your IP rights. Maintain your protection, identify breaches and pursue the infringing party, if appropriate and at proportionate cost.



## IP Rights Abroad?

You can normally protect your IP rights by filing an application or registration to an appropriate government body such as the UK Intellectual Property Office (IPO). Normally, the resulting protection given after a successful application is an absolute monopoly over the IP. No-one else will be able to use the IP without your licence or permission.

Applications and registrations are normally associated with patents, registered designs and registered trademarks. Registration is territorial and dealt with on a national level. Therefore, a UK trade mark registration will only protect that mark in the UK and does not extend to the rest of the world. However, there are various routes that allow you to protect your IP internationally. These are briefly summarised below.

### European Union Trade Marks Regulation

The European Union Trade Marks Regulations allows you to register European Union Trade Marks. The effect of a registration is that your trade mark is protected in all EU Member States.

### Community Designs

A design can be protected in EU Member States by way of a Registered Community Design. This involves an application to the Office for Harmonization in the Internal Market (OHIM). This has the effect of protecting the design for 25 years.

### European Patent Convention (EPC)

A patent can be protected in the EU by a European Patent. This involves an application to the European Patent Office (EPO). If the European Patent is granted it becomes a package of national patents across 38 states (plus 2 extension states).

### Patent Cooperation Treaty

This is a streamlined system allowing international patents to be registered in multiple countries around the world.

### Madrid Trade Mark System

This allows a regional trade mark holder to apply for a trademark in states which are a party to the Madrid Union. It involves a single application to the World Intellectual Property Organisation (WIPO).

**If you are thinking about registering your IP rights abroad then it is recommended that you seek professional advice.**





# UK IP Professionals

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IP is a complex area. When registering a trademark or a patent, to pursuing someone in Court, we would always recommend you speak to a professional with specialist skills and knowledge. We have set out some of the key professionals and how they can help you below.

## Solicitors

Solicitors are members of the legal profession that are qualified to give legal advice, prepare legal documents and conduct litigation. Solicitors with a specialism in IP law can advise on a wide range of IP matters including copyright notices, research and development agreements, exploitation agreements, IP assignments and licencing and non-disclosure / confidentiality agreements. Solicitors are authorised to conduct litigation and to represent clients at Court.

## Barristers

Barristers are members of the legal profession who often specialise in litigation and advocacy, but they can also provide legal advice and draft legal documents. Some barristers specialise in IP matters and are often instructed by solicitors in contentious matters where they represent clients at Court.

## Patent Attorneys

A patent attorney is skilled and qualified in patents. An attorney acts for others (usually inventors and companies) in securing, enforcing or advising about patents. In the UK a Patent Attorney is a protected title, and only those who have placed their name on the statutory Register of Patent Attorneys are entitled to use the term. Some patent attorneys are chartered meaning that they can also advise on EU and International patents.

In general, a patent attorney assists clients in securing protection for inventions and advises on the impact of patent rights owned by others on the client's business. The types of work patent attorneys get involved in is widely varied and can include:

- Drafting and filing UK, European and International patent applications directly at the UK Intellectual Property Office (IPO) and European Patent Office (EPO);

- Representing clients in opposition and appeal proceedings;
- Advising on infringement and validity of patents;
- Advising on patent licensing, exploitation and technology transfers; and
- Carrying out Prior Art Searches on products, inventions and concepts that are similar to an idea that a client wants to patent.

### Trademark Attorneys

A trademark attorney specialises in helping clients identify, protect and exploit their trademarks. Like patent attorneys, a trademark attorney is a protected title. Trademark attorneys must be qualified and placed on the Register of Trademark Attorneys. Trademark attorneys can also become chartered by becoming a member of the Chartered Institute of Trademark Attorneys (CITMA).

Some examples of the services that trademark attorneys provide to clients include:

- Advising clients on whether a particular mark is available;
- Conducting searches for existing trademarks;
- Preparing and filing applications to register trademarks directly in the UK, across the EU and internationally;
- Opposing third party trademark applications and registrations through opposition and invalidity proceedings;
- Advising on best practice in using trademarks, to ensure trademarks remain valid and enforceable;
- Advising on trademark infringement; and
- Advising on licencing and exploitation of both unregistered and registered trademarks.







## IP Litigation - Urgent Work

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In IP litigation cases, discovering that an infringement has occurred is only the first step. This is usually followed by evidence gathering / fact finding and perhaps dispatching a formal cease and desist letter with undertakings. This process can take up to a few weeks. If a Court case is issued, then it could take months for matters to conclude at trial or settle.

However, what if you cannot wait? What if the infringement is so serious that immediate action needs to be taken to prevent further harm being done to your business? If that is the case, then the Court provides litigants with the option of seeking urgent relief known as injunctions. This is discussed in more detail below.

### What is an injunction?

An injunction is a Court order that requires someone to do a specified act or to refrain from doing a specified act.

An injunction can be either interim or final. As the name suggests, an interim injunction is granted before a case is concluded at a final hearing (or settled). For example, a copyright holder may want to seek an interim injunction to prevent further copyright infringement before a final hearing takes place. Interim applications are therefore mostly made on an urgent basis.

A final injunction is given at trial and is sometimes referred to as a “perpetual” injunction.

### Types of injunction?

The Court has a wide discretion to order different forms of interim relief which include:

- Freezing injunctions, restricting dealings with assets;
- Orders to provide information (delivery up);
- Seizure of infringing materials; and
- Injunctions against intermediaries such as website blocking injunctions against internet service providers (ISPs).

### When is an injunction appropriate?

Applications for interim injunctions are case specific. There are no fixed rules because every case turns on its own facts and the remedy must be kept flexible. But there are criteria that should be met before the Court will consider granting an injunction:

- An injunction must be “just and convenient”;
- The Court must be satisfied that there is an underlying cause of action or “a serious question to be tried” or “a real prospect of success”;
- The relief sought must meet the “balance of convenience” test i.e. the respective inconvenience or loss to each party if the injunction is granted or not; and
- Where the factors appear to be evenly balanced, the courts will try to preserve the status quo – meaning maintaining the state of affairs that existed immediately prior to the commencement of the breaches alleged.

#### What if there is a delay in making an application?

Delay is not itself a bar to an injunction application. However, generally, it is not recommended to delay in applying for relief especially where factors are evenly balanced. The risk in leaving a breach unchallenged is that the change brought about by it becomes the new status quo (which the Courts often try to preserve).

#### Without notice applications?

You can elect to make an application without notice or on short notice to your opponent however this is a risky tactic and it might backfire if the Court considers that the application is “trigger-happy”.

There is no hard and fast rule. The Court will look at the situation realistically. It is nearly always appropriate to at least try to engage with your opponent in pre-action correspondence prior to making an application for an injunction. This is subject to limited exceptions for example where there is some exceptional urgency where there is literally no time to give notice.

Any order for an interim injunction made without notice must provide for a hearing with all parties known as the “return date” hearing. This is ordered to take place as quickly as possible to minimise any prejudice to the respondent.

#### Undertakings

Injunction applications can be expensive, especially if they are contested. A means of minimising the need for an application and a return date hearing is for a respondent to offer undertakings (promises) to the Court pending a trial of the action. A key feature of an undertaking to the Court is that it will be contained in an order and breach of that order may lead to the Court holding that party in contempt of court.

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# IP Jargon Buster

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Legal language can be confusing even for practitioners.

Our handy jargon buster can help:

## Attorney (IP)

A lawyer that specialises in intellectual property law and who will often have a focus on copyright issues, trademark related issues, registered and unregistered design issues and / or patents.

## Breach of Confidence

A cause of action that is used as a way to protect confidential information by preventing its misuse by someone who has been told the information in confidence. A wide variety of information can be protected including industrial or trade secrets.

## Business and Property Courts

Specialist Courts within the High Court in London, Manchester, Birmingham, Leeds, Cardiff and Bristol. The Intellectual Property List (which includes the Patents Court and the Intellectual Property and Enterprise Court (IPEC)) deals with a wide range of IP cases.

## Copyright

A property right that exists in various “works”, for example literary works, artistic works, musical works, sound recordings, films and broadcasts. Copyright does not protect ideas, only the expression of an idea. Copyright cannot be registered and “registered copyright” does not exist.

## Damages

Awarded in respect of the actual losses suffered by a Claimant. Their purpose is to compensate the claimant for losses suffered because of an infringement of IP rights.

## Database right

Databases are a collection of works, data and other materials which are arranged in a systematic or methodical way and are individually accessible by electronic or other means. They are simply modern forms of property which can be sold or licensed to third parties. Database rights protect the compilation of information in the database. Databases may also be subject to copyright laws.

## Design Right

Design rights protect the 3D designs of products. They apply to designs that are new and have an individual character. Design rights can be registered in the UK and in the EU.

## Franchise Agreement

An agreement between two parties which grants the franchisee a right to exploit a franchise in return for direct or indirect financial consideration. The franchiser licenses its distinctive trading format to the franchisee while remaining an independent trader.



The franchiser is paid royalties for the licence to use their IP rights and maintains control over the franchisee, to protect those rights and maintain the reputation and identity of the franchise.

### Goodwill

The established reputation of a business regarded as an asset and calculated as part of its value when it is sold.

### Infringement

Used in the context of IP litigation (trademark infringement, copyright infringement, design right infringement and patent infringement), this means an unlawful violation of someone's rights. For example, copying an author's work without their permission is an infringement of their copyright.

### Injunction

A court order that either prohibits a person from taking a particular action or requires them to take a particular action. Injunctions may be granted as:

- Final relief at trial, sometimes referred to as "perpetual" injunctions; and/or
- Interim relief, prior to starting court proceedings or during, sometimes referred to as "interlocutory" injunctions.

In an IP context an injunction can be used when pursuing someone and urgent relief is required to minimise the damage done because of an infringement.

### Injunction (Springboard)

An injunction to prevent a former employee who has used confidential information to their own advantage from gaining a head start in competition with their former employer.

### Intangible Assets

Assets that are not physical such as goodwill and IP.

### Intellectual Property

Intangible property rights which are a result of intellectual effort. Intellectual property rights include patents, trademarks, designs and copyright.

### License

Generally, this means giving permission to do or use something that would otherwise not be legal or allowed. In the context of IP law, a license is a grant from the owner of an IP right (the licensor) to another entity (the licensee)

permitting the licensee to use the IP in certain ways, for example, to distribute products under the licensor's trademark.

### Malicious falsehood

A common law offence made out by the malicious publication of false words that refer to the claimant, his property or his business, and which give rise to damage as a direct result of their publication, or for which damages can be claimed under the Defamation Act 1952. A claim for malicious falsehood may also be brought at the same time as a passing off action. Threats to sue for IP infringement may also give rise to a malicious falsehood claim.

### Passing off

Passing off is a cause of action which protects a trader's "get-up". It has the primary effect of protecting the goodwill a trader has developed and which is associated with their business. It has the secondary effect of protecting the buying public from trade deception.

### Patents

A form of intellectual property, generally comprising an exclusive right to commercially exploit an invention. A patent gives its owner a monopoly over their invention.

### Registered Designs

Designs that have been registered in the UK, EU and internationally. The registered design protects the look of the design to include its physical shape, configuration, appearance and decoration. The protection given by registering a design in the UK and EU is up to 25 years.

### Registered Trademark

Trademarks that are registered in the UK, EU or internationally. UK registered trademarks last 10 years but can be renewed. There are different processes when registering a trademark in the EU or internationally. A registered trademark is often shown by the ® symbol.

### Trademark

Trademarks are closely associated with business image, goodwill, reputation and "get-up or feel" of particular goods or services.

### Trade Secret / Confidential Information

A trade secret is a valuable piece of information for an enterprise that is treated as confidential and that gives that enterprise a competitive advantage.

## Myerson Solicitors LLP

*'has a really strong IP team, which is growing.'*

**Jonathan Hassall** leads on contentious matters with *'a lot of experience of litigating unregistered IP rights; he has a very strategic mind and is extremely thorough'*. Hassall routinely advises on a broad range of disputes relating to trade marks, copyright, patents, confidential information and data protection. He is also skilled at advising on design rights and reputation management issues and is regularly instructed by clients from the arts, media, textile and clothing sectors in the UK and internationally. *He is 'attracting work from a broad range of clients'.*

**Carla Murray** leads on non-contentious IP matters.

**Scott Sands** has a *'good tactical awareness which is invaluable when considering commercial strategy'*. The team is representing International Pastry Concepts LLC (a New York based pastry house which invented the CRONUTS products that are sold worldwide) on various matters such as enforcing the client's international trade mark.

The *'excellent'* **Vicky Biggs** is now a senior solicitor in the team.

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**Intellectual Property rights are the fundamental building blocks of many businesses. Our team of experts are able to assist in all aspects of Intellectual Property rights, protecting you and your business.**



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