

AA THORNTON

INTELLECTUAL PROPERTY LAW

It's our people
that make the
difference

Client focused | Collaborative | Professional | Flexible

Trade Marks

About us

We are a leading Intellectual Property firm based in London and Munich. Our team of committed and passionate individuals includes patent, trade mark and design attorneys, as well as litigation solicitors, working with clients across a huge range of technologies and commercial fields. We provide the full range of IP services to clients around the world, from prosecution to litigation, in patent law, trade mark, design and copyright law.

Having an excellent understanding of our clients' industries and the challenges they face is key to us delivering commercial, insightful legal advice. Our highly qualified industry teams are made of attorneys and solicitors who work together to share knowledge and experience. We firmly believe *it's our people that make the difference* and that this sets us apart from others. Simply stated, we speak our clients' technical language!

We offer a completely bespoke service at a competitive price. We pride ourselves on our genuine desire to understand the way clients want to work with us, and provide every client with a personalised, superior service that reflects their commercial needs. Our advice is always in-depth, commercial and accessible. We ensure that your inventions, brands and designs are expertly protected and your risks are minimised.

We love brands. We are passionate about protecting, enforcing and commercialising your trade marks, as well as safeguarding them through dispute avoidance and dispute resolution. We represent clients before the UK IPO, the EU IPO and the WIPO as well as working with an extensive network of established attorneys around the world to provide complete global coverage.

Our tier one team also provides expert advice and services related to design rights, copyright and domain names. We have a wealth of expertise in online enforcement, regularly prosecuting domain name complaints targeted at cyber-squatters. We also have specialist experience in assisting clients with global anti-counterfeiting strategies, even writing the UK section of 'Anti-Counterfeiting 2018 – A Global Guide' by the World Trade Mark Review.

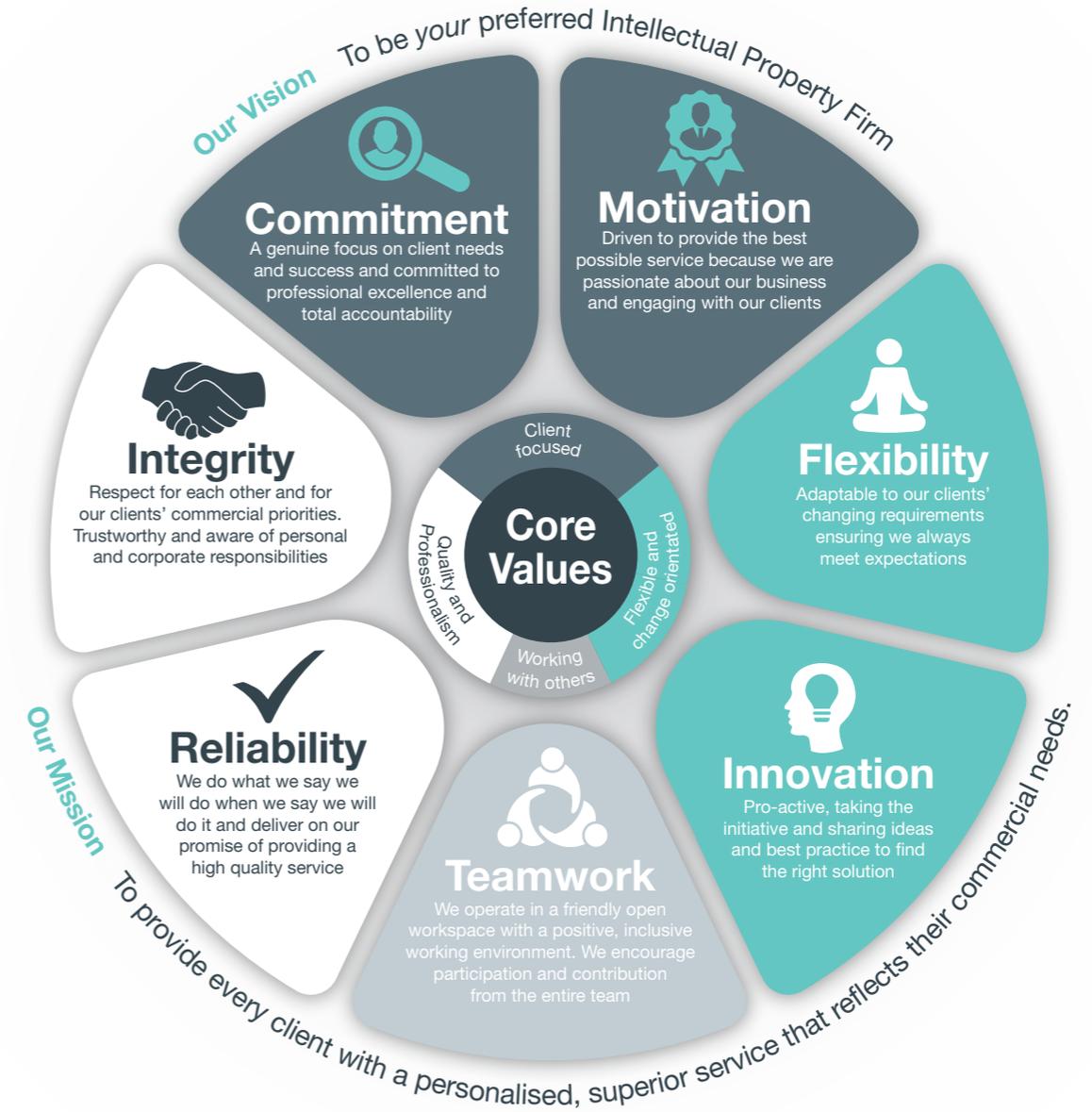
Our vision is *"to be your preferred intellectual property firm"*, and we are committed to providing every client with a personalised, superior service that reflects their commercial needs.



IP INCLUSIVE
Working for diversity and inclusion in IP

We are delighted to be involved with IP Inclusive, which is an organisation that promotes diversity and inclusion within the various IP professions. AA Thornton were among the first signatories to the IP Inclusive charter, which is part of our ongoing commitment to improving diversity and inclusion. We take an active lead in IP Inclusive, such as the project to promote careers in IP to schools and universities through the "Careers in Ideas" initiative.

Our values



Our expertise

As a top tier team, we manage substantial IP portfolios for our clients and provide them with sensible, commercial advice tailored to their needs. We advise on brand management, provide strategic advice, assist in setting up and implementing IP licensing and ownership structures, and carry out IP due diligence.

Our experience and client base spans a number of industry sectors including retail, fashion, food and drink, automotive, pharmaceuticals and medical devices, and we are proud to represent long-established international brands and household names, such as the ones below.



‘Peers are also impressed, noting that “it does a top job defending its clients’ positions”. The long-established – but forward-thinking – outfit can render any trademark service, and has a wealth of enforcement and commercialisation know-how to complement its unassailable prosecution and portfolio management credentials.’

- World Trademark Review

TOP TIER FIRM
LEGAL 500
2020

‘AA Thornton’s caseload regularly includes high-stakes headline-grabbing cases. The team combines strength in trade mark portfolio management with proven prowess in the prosecution of trade mark applications, especially in complex cases involving particular international or legal challenges.’

- Legal 500

Meet the team



Ian Gill
Partner,
Trade Mark Attorney

Ian Gill is a Partner and a UK Chartered Patent and Trade Mark Attorney. Ian is also a European Patent, Trade Mark and Designs Attorney. Ian specialises in contentious and non-contentious issues relating to trade marks and designs.

Ian is also the Director of the IP insurance club PAMIA and sits on the claims committee advising on the merits of and mitigating steps that can be taken in relation to potential claims against patent and trade Marks attorneys.

Ian is a member of the FICPI technology related CET-8 and Brace committees.

Ian is consistently ranked in the independently compiled list of the World Leading Trade Mark Attorneys, WTR 1000.

‘Ian Gill is a true expert and always offers sensible and commercial advice.’

- Legal 500



Rachel Havard
Partner,
Trade Mark Attorney

Rachel Havard is a Partner and a UK Chartered Trade Mark Attorney and European Trade Mark and Designs Attorney.

Rachel handles a wide range of UK and international trade mark cases, and has significant experience of clearing trade marks for use and registration, and in negotiating and drafting trade mark co-existence agreements.

Rachel’s portfolio of clients covers a variety of sectors, including fashion retail, automotives and pharmaceuticals.

‘Rachel Havard is ‘very thorough’ and ‘recommended for her handling of a wide range of UK and international trade mark cases’

- Legal 500



Sarah Darby
Partner,
Trade Mark Attorney

Sarah is a UK Chartered Trade Mark Attorney and European Trade Mark and Designs Attorney. Sarah handles trade marks, designs and copyright in the UK, EU and worldwide.

Sarah advises on all types of trade mark matters from the inception of a brand and checking its availability to obtaining registrations, commercialisation of rights and enforcement of rights in opposition actions, cancellation actions and litigation. Sarah also deals with domain name registrations, purchases and complaints, as well as customs and counterfeit issues.

Sarah advises both domestic and international clients, in industry sectors such as food & drink, luxury goods, agriculture, gaming and sports.

'Sarah Darby is fantastic, highly technical, but with a commercial focus'
- Legal 500



Geoff Hussey
Partner,
Solicitor

Partner Geoff Hussey heads AA Thornton's litigation department. His experience includes acting for a broad range of clients in many sectors including life sciences, electronics, telecoms, chemicals, aviation, food & drink and financial services.

His contentious practice covers trade mark and passing off litigation, design right and copyright litigation and disputes involving trade mark licences. He has experience in relation to disputes concerning contractual arrangements involving IP and copyright, design right and confidential information disputes.

He also advises on non-contentious intellectual property matters including setting up and implementing IP licensing and ownership structures, IP due diligence, IP audits and brand management.

Some of Geoff's notable cases include:

- Virgin Enterprises Limited v Virginic LLC - (First UK trade mark case concerning adjectival suffixes)
- Poul Chang Metal Industry Co. Ltd v Bailcast Limited- (Important precedent design case)
- easyGroup v easyJet - (airline brand licence dispute)
- EMI v BskyB - (NOW TV trade mark infringement)



Dan Byrne
Partner,
Barrister

Dan Byrne is a Partner and Barrister in our IP litigation department who works across the full range of IP rights and has been involved in many high profile brand disputes.

Dan has acted for a large range of clients in many sectors and for some time acted for Stelios' easyGroup in policing the 'easy' family of marks across the varied licensed businesses.

He was instrumental in obtaining the trade mark registration of PREMIUM BONDS for NS&I and has been involved in disputes in some of the highest courts. In addition he regularly adjudicates as a deputy district judge in the Intellectual Property Enterprise Court (small claims) in trade mark cases.

Some of Dan's notable cases include:

- Aesop v Grown Alchemist (France: unfair competition case concerning branding of beauty products)
- Nestle v Cadbury (infringement and validity of shape trade mark for rolos)
- Cadbury v Nestle (validity of shape trade mark for kit kat; EU General Court)



Vanessa Lawrence
Consulting Attorney,
Trade Mark Attorney

Vanessa Lawrence is a Consulting Attorney for the firm. Vanessa is a UK Chartered Trade Mark Attorney and European Trade Mark and Designs Attorney.

Vanessa handles a wide range of UK and international trade mark cases, and works across various commercial sectors including fashion, food & drink, travel and telecommunications.

Vanessa is consistently ranked in the independently compiled list of the World Leading Trade Mark Attorneys, WTR 1000.

'AA Thornton's 'excellent' trade mark team handles all aspects of the trade mark registration process, and is particularly renowned in the fashion sector. Vanessa Lawrence is 'knowledgeable, friendly and extremely professional'
- Legal 500



Louise Foster
Senior Associate,
Trade Mark Attorney

Louise Foster is a UK Chartered Trade Mark Attorney and European Trade Mark and Designs Attorney handling trade mark, design and copyright in the UK, EU and overseas.

Louise also has particular experience and a successful record in conducting domain name disputes under the UDRP and Nominet DRS, for a range of clients tackling various types of cyber-squatting. She also advises on and oversees applications for EU design registration for several collections throughout the year for a high-end fashion brand.

Louise has worked in building and managing anti-counterfeiting strategies and has twice written the UK section of the World Trademark Review's 'Anti-Counterfeiting – A Global Guide'.

Her client base operates in sectors such as fashion & clothing, publishing and media, travel, industrial components and goods, and includes providers of software products and solutions applied across a range of industries.



Suzanne Power
Senior Associate,
Trade Mark Attorney

Suzanne Power is a UK Chartered Trade Mark Attorney and European Trade Mark and Designs Attorney. She handles contentious and non-contentious trade mark, design and copyright matters.

Suzanne is particularly experienced in prosecuting and enforcing clients' IP rights overseas, having overseen client matters in over 170 territories worldwide. Her knowledge of foreign trade systems allows her to deliver strategic advice and support to clients looking to expand into new markets or enforce existing rights overseas. She supplements this with skills in several foreign languages, to provide input on foreign language legal submissions and evidence, and draft bilingual settlement agreements.

Suzanne also supports foreign associates seeking to represent their clients' interests in the UK and EU, such as in co-ordinated efforts to tackle international counterfeiting.

Suzanne's client base includes FTSE 100 companies, SMEs and start-ups, with a particular focus on the fashion, food and drink and pharmaceutical industries.



Sarah Neil
Senior Associate,
Trade Mark Attorney

Sarah Neil is a UK Chartered Trade Mark Attorney and European Trade Mark and Designs Attorney. Sarah advises on the full range of trade mark, design and copyright matters, including clearance, protection and enforcement of IP rights. Sarah's clients operate in industry sectors such as insurance, telecommunications and food & beverage.

Examples of projects Sarah has assisted with include an IP Audit for a UK based telecommunications service provider, advising on obtaining IP protection for new packaging for a beverage, defending threats of registered design infringement made against a well-known producer of bakery products and the enforcement of trade mark rights on behalf of clients both in the UK and overseas.

Sarah also manages IP portfolios by providing strategic advice, with a focus on alignment with client's overall corporate objectives and strategy.

'Sarah Neil is always on hand to offer great advice and always finds the solutions we need!'
- Legal 500



Varuni Parnavitane
Senior Associate
Solicitor

Varuni is an IP solicitor advising on trade mark, design, copyright and patent matters. She has IP experience in a variety of industry sectors including fashion, life sciences, digital media, sports and food & drink.

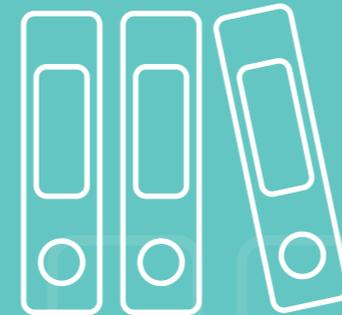
Varuni's practice also includes non-contentious brands advisory work, enforcement strategy, settlement and co-existence strategy advice as well as advice in relation to commercial transactions.

Some of Varuni's notable cases include:

- Radley v Poundworld (IPEC)
- Catchup TV v Gzero (High Court)
- Natures Way v Natures Way Ltd (IPEC)
- Group Lotus PLC v 1Malaysia Racing Team (High Court)



More about our services and expertise



Trade Mark, Design & Copyright Portfolio Management

Our patent and trade mark attorneys regularly advise on IP portfolio management, with a focus on alignment with each client's overall corporate objectives and strategy.

We understand the need to review expenditure, IP asset value and portfolio management decisions on a regular basis, and to check alignment with the current business objectives and market conditions. We approach this with a desire to understand your business needs and to provide a solution that achieves your objectives efficiently and cost-effectively.



Patents

Our patent attorneys have a wealth of experience in all aspects of patent law, and can advise across a wide and diverse range of technical areas.

- Chemistry, Biotechnology & Pharmaceuticals
- Electrical Engineering, Electronics, Telecoms & IT
- Engineering, Physics & Mechanical Devices

Whether you are a sole inventor or large corporation, protecting your ideas is vital. Our European and UK Patent Attorneys can act on your behalf, presenting your case to the UK Intellectual Property Office (UK IPO), the European Patent Office (EPO) and the World Intellectual Property Office (WIPO). Thanks to our network of associates overseas, we can advise on different patent laws and protect or defend you anywhere in the world.



IP Transactions, Ownership & Licensing

We regularly advise clients in relation to commercialising their IP. When entering into negotiations for contracts involving IP it is important that clients' interests are protected and that the appropriate rights are secured in the transaction.

We have the experience and focus to help guide you through what is a technical legal area to achieve a result that meets your commercial aims for all of your non-contentious IP requirements.

Our services include:

- Drafting assignments and licences
- IP contract reviews
- IP due diligence
- IP audits
- Developing IP ownership and licensing structures
- Dispute settlement agreements
- Recording transactions at Intellectual Property Offices



IP Strategy & Audits

We will work with you to put in place effective strategies for the protection and commercialisation of your intellectual property (IP).

Our services include:

- IP audits
- IP due diligence
- IP portfolio management and maintenance advice
- Project reviews to identify potential IP
- Strategy reviews
- IP Litigation strategic advice
- Marketplace and competitor surveillance
- Advice on upcoming Unified Patent Court opt-outs
- Parallel imports – advice, reviews, procedures



IP Litigation

Our IP litigation and legal department advises on all aspects of IP law. Our experience and expertise ranges from dealing with small IP disputes (often resolved in negotiation), to hard-fought high-value IP litigation and coordinating parallel actions in other jurisdictions.

Our litigation approach is, where appropriate, for IP solicitors to work closely with our patent or trade mark attorneys to provide a coordinated approach to both enforcement and protection – ensuring the best possible resolution of IP disputes. The strength of our collective technical expertise also ensures that we can understand the necessary complexities involved in each case.

Our services include:

- IP portfolio and litigation strategies
- Patent litigation
- Trade mark, copyright and design right litigation
- Arbitration and mediation
- Licensing disputes
- Coordinating with local counsel in parallel actions around the world
- Settlement advice



IP Due Diligence & Freedom to Operate or Freedom to Use

We have considerable experience advising clients in relation to commercial due diligence activities across the full spectrum of intellectual property (IP) rights. Clients value our commercial focus and attention to detail in helping them to evaluate and realise new business opportunities.

Our services include:

- IP due diligence for clients seeking to commercialise their own IP
- IP due diligence for clients seeking to acquire third party IP
- Freedom-to-operate or freedom-to-use assessments

Because of our people we are consistently ranked as ‘top tier’ and ‘leading’ by our peers and clients:

The Legal 500 | Chambers & Partners | WTR 1000 |
Managing IP Stars | The Financial Times

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The information in this booklet is general information only and is not intended to constitute legal advice. If you wish to explore protection and associated costs for any of the types of intellectual property discussed, please contact one of our patent, trade mark or design attorneys. July 2020.



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