

AA THORNTON

INTELLECTUAL PROPERTY LAW

It's our people
that make the
difference

Client focused | Collaborative | Professional | Flexible

Litigation

About us

We are a leading Intellectual Property firm based in London and Alicante. 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 winning! We are a bit of a competitive bunch... inside but also outside of the office! We absolutely love winning, be it an opposition at the EPO, an infringement case at the Court of Appeal, or the defence of a trade mark registration all the way to the High Court... or even the London Great City Race! This competitive streak is what drives us to achieve success for our clients.

We want to be involved in the success of our clients. Playing a part in our clients' success by offering them not just excellent legal advice but also strategic and commercial advice is hugely motivating. We win when our clients win, and remember... we love winning!

Our attorneys and lawyers regularly speak at conferences, and publish articles in leading magazines. We relish innovation and enjoy nothing more than working on new or complex technologies.

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.



IPINCLUSIVE
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.

“Exceptional knowledge and experience in complex IP litigation, including in the area of complex emerging technologies.”

**Client Testimonial,
Legal 500**

Our expertise



PATENT
LITIGATION



TRADEMARK
& PASSING OFF
LITIGATION



DESIGN
& COPYRIGHT
LITIGATION



OPPOSITION
& IPO CHALLENGE



ARBITRATION
& MEDIATION

The firm’s litigation team are friendly and approachable with an open and collaborative working style, both internally and in how we work with our clients.

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 approach, where appropriate, is for our 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.

We have extensive experience handling disputes relating to all IP rights, confidential information and contracts & licences, acting at the UK High Court, IP Enterprise Court and the Court of Appeal, as well as in oppositions and other contentious hearings at the EPO, EUIPO, EU General Court and UKIPO.

“
the team is increasingly handling high-
stakes contentious patent cases.
- Legal 500
”



Patent Litigation
We have a wealth of experience across the strategic, legal and technical elements of patent litigation that are essential in forging a successful outcome.

Our team has handled contentious patent matters across all industries and technical fields. This includes a number of significant pharmaceutical and medical device actions (including SPCs), involved electronics and telecoms disputes, automotive and aerospace matters, and cases with technology as complex as quantum chemistry. We enjoy diving into the specifics on the legal and technical sides of patents and we love winning.

Trade Mark Litigation
We are accustomed to handling trade mark and brand disputes for the most famous and well-known marks as well as acting for small start-ups and niche brands.

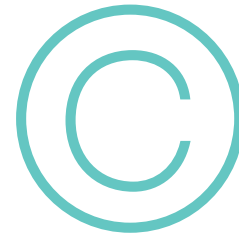
In many ways our litigation is an extension of our tier 1 trade mark attorney team with a number of FTSE 100 and other long-standing clients. Our approach to enforcement is cost-effective and proportionate and importantly tailored to each client. No two clients are the same and no two clients have the same considerations in the protection and enforcement of their trade mark rights. We enjoy a success rate in resolving disputes favourably for clients of which we are proud.



Copyright Litigation

Members of our litigation team have been involved in some of the most important copyright cases of the last 20 years and we regularly advise on contentious copyright matters.

We have an excellent record of resolving copyright disputes without the need to involve the courts and guide our clients in relation to internal copyright policies and use of copyright, often in the context of disputes involving other IP rights.



Licence Disputes, Contracts

We regularly advise clients in relation to contractual and licensing disputes involving intellectual property. Many agreements involve intellectual property and confidential knowhow whether it be a simple transfer of rights or a more complicated collaboration or joint venture. In many cases an understanding the technology is essential to understanding the crux of a dispute and therefore for securing a successful outcome for our clients.

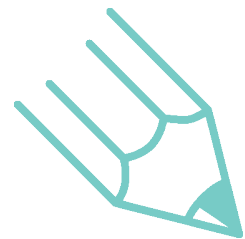
Our team has a diverse range of technical degrees and doctorates which allow us understand the relevant technologies quickly in order get to the real heart of the matter.

Design Litigation

We have a particular strength of expertise in design right law and in handling design right cases through the courts and also through EUIPO proceedings.

Our team has handled design right litigation in relation to a diverse range of products including highly successful childrens' toys, security fences, domestic power tools and automotive tools.

As with any litigation we ensure that litigation is handled appropriately and proportionately, and we were involved in the leading case on how a design right infringement case should be run through the UK courts,



ADR and Dispute Settlement

Our approach to everything we do is driven by the commercial needs of our clients and we always have that in the forefront of our minds.

In many disputes an amicable settlement is possible and may resolve the matter with a saving of time and cost. Litigation strategy is connected to settlement strategy and our familiarity with tools such as Part 36 of the Civil Procedure Rules allows us to take steps which may promote settlement or which may protect the client on costs. We have experience in mediation and other forms of alternative dispute resolution and we understand how important it is to have a negotiation strategy in mind from the very beginning.





Our work

Design case example

Poul Chang Metal Industry Co. Ltd v Bailcast Limited

We have recently secured a declaration of non-infringement from the UK court for Taiwanese company, Poul Chang, in relation to its pneumatic cv-joint boot tool and a Registered Community Design owned by Bailcast. The case secured Poul Chang's business across Europe.

The case also involved success in defending a stay application brought by Bailcast relating to a parallel German infringement action against a Poul Chang German distributor. This was the first time the English courts had to consider the jurisdictional interplay between the Community Designs Regulation and the Brussels Regulation.

Trade Mark case example

Virgin Enterprises Limited v Virginic LLC

We acted for Virgin Enterprises Limited against US company, Virginic LLC, in a successful UK High Court appeal relating to an opposition against the application for a trade mark VIRGINIC and to protect the world famous Virgin brand. Following a refusal of our client's opposition in the UKIPO, we successfully appealed the UKIPO decision in the UK High Court. The High Court overturned the UKIPO and found a likelihood of confusion between the marks refusing the application.

This was the first case in the UK courts relating to the use of an adjectival suffix (in this case "ic") being added to a trade mark.

Patent case example

Adolf Nissen Elektrobau GmbH & Co.KG v Horizont Group GmbH

We acted for Adolf Nissen in its successful revocation of Horizont's road traffic sign patent in the Intellectual Property Enterprise Court (IPEC) in late 2019 enabling its entry into the UK market with a road traffic warning device.

The patent was found to lack inventive step over two pieces of prior art. Unusually, one of which was Adolf Nissen's prior use of a particular device. The case involved an interesting interaction between the technical inventive steps issues and the relevant regulatory framework and practice for road traffic.

Meet the team



Geoff Hussey
Partner,
Solicitor

"Geoff simplifies everything and makes managing litigation easy for in-house counsel. A strategic pragmatic and commercially minded lawyer, he knows how to read adversaries and when to apply leverage."

- General Counsel,
a leading technology software company

Geoff Hussey heads AA Thornton's litigation department having joined from Bid & Bird in 2016. 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 and his IP litigation practice relates to all forms of intellectual property and a wide range of industries.

Geoff has extensive experience in patent litigation before the UK Patents Courts and in patent oppositions particularly in relation to pharmaceuticals, medical devices, chemicals and electronics. His contentious practice also 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 case examples include:

- *Cambridge Quantum Computing v River Lane (quantum chemistry)*
- *Adolf Nissen v Horizont (road traffic warning signs)*
- *Dr Reddy's & Sandoz v Napp (buprenorphine patch)*
- *ConvaTec v Smith & Nephew (silverised gel-forming wound dressings)*
- *Virgin Enterprises v Virginic (cosmetics)*
- *easyGroup v easyJet (airline brand licence)*
- *EMI v BSKyB: NOW TV (TV service)*
- *Poul Chang v Bailcast (cv boot tool)*
- *PMS international v Spin Master (children's toy)*



Dan Byrne
Partner,
Barrister

"Dan was superb and helped us through our case, clearly explaining the next steps and giving superb advice, that resulted in a great outcome for us."

- Matt Gower, CEO of
Equip Outdoor Technologies

Dan Byrne joined the Litigation department of AA Thornton as a Partner after spending a number of years in a top IP litigation practice in Paris. Prior to that he spent many years in practice in a London firm of solicitors, having previously qualified as a barrister at specialist IP chambers.

He is experienced in dealing with complex and technical patent matters, particularly in multijurisdictional litigation and coordination in Europe. He has acted for multinational clients in many different sectors, including telecoms, pharmaceuticals and energy. He also acts for clients in branding and trade mark disputes where cases have included, for example, disputes relating to the shapes of chocolates and passing off.

As a Deputy District Judge in the County Court since 2015 who also sits in the Intellectual Property Enterprise Court (small claims), Dan is adept at seeing cases from different perspectives and providing insights about the court processes.

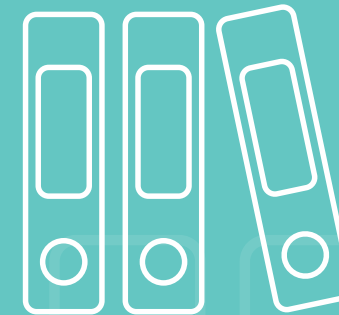
Some of Dan's case examples include:

- *Wobben v Siemens (method of operating a wind turbine; patent validity and infringement)*
- *Biogen, Genentech, Roche v Celltrion (biosimilar product rituximab; patent validity)*
- *Unwired Planet v Samsung (mobile telecommunications – 2G to 3G handover; standards essential patent in the context of a FRAND dispute)*
- *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)*
- *J&J v Sandoz (France: interim injunction concerning darunavir biosimilar covered by SPC)*
- *Sanofi v Mylan (France: searches and seizures concerning insulin injection pen; patent infringement and validity)*

“AA Thornton puts together a strong team with the necessary technical expertise based around our needs, and that teams works with us consistently, allowing us to develop a strong working relationship. Their communication and strategic approaches are insightful and consistently of great assistance.”

**Client Testimonial,
Chambers & Partners**

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

Contact us

T: +44 (0) 20 7405 4044
F: +44 (0) 20 7405 3580
E: Litigation@aathornton.com

aathornton.com/contact-us



Follow us on LinkedIn:
[AA Thornton](#)



Follow us on Twitter:
[@AAThorntonCo](#)

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. October 2020.



IPINCLUSIVE
Working for diversity and inclusion in IP