

THREE NEW SQUARE

INTELLECTUAL PROPERTY



SIMON
MALYNICZ QC
Year of Call: 1997
Silk: 2016

“The best trade mark senior junior at the Bar - no one knows more about the case law”

Legal 500, 2015

PRACTICE AREAS

His practice covers trade marks, passing off, designs, copyright, IT/computer software, media/entertainment, confidential information and patents. He also handles commercial cases with an intellectual property element.

He was appointed to the Attorney General's A Panel of Counsel on 1st March 2014 and was previously on the Attorney-General's B Panel of Counsel from 2008 to 2013.

He appears regularly before all the relevant tribunals including the High Court, Court of Appeal, Patents Court, Patents County Court, and UK Intellectual Property Office. He has extensive experience of the Court of Justice of the European Union (CJEU) and General Court (GC) in Luxembourg. To date he has acted in more than 20 references to the CJEU, covering diverse areas of IP such as:

- Copyright (Football Dataco, SAS Institute, UPC Telekabel Wien, VG Wort, Copydan, Promusicae, AGEDI, LSG, SGAE, FA Premier League)
- Trade marks, (Kit Kat, Specsavers v Asda, IP Translator, Interflora v M&S, Budweiser, Intel, L'Oreal, Adam Opel, Arsenal, Bovemij, UDV, DHL Express)
- Registered designs (FEIA)
- Supplementary protection certificates (Actavis, AHP Manufacturing)
- The Biotech Directive (Monsanto Technology).

He has also acted in more than 50 cases before the General Court on trade mark appeals from OHIM. In several of these he has represented clients on further appeal to the CJEU (Environmental Manufacturing, Clorox, Hrbek, Cadila)

EDUCATION

B.A. (Sydney), M.A. (New School, NY) LLB (Lond.)

CAREER

- Appointed to Attorney General's A Panel of Counsel on 1st March 2014
- Attorney-General's B Panel of Counsel from 2008 to 2013
- Joined Three New Square in February 2011
- Joined Hogarth Chambers from Clifford Chance in 1999.

LEGAL DIRECTORY COMMENTS

CHAMBERS UK 2015 & 2014

Awarded IP Junior Barrister of the Year 2014 at the Chambers Bar Awards

Ranked in Band 1 among leading juniors for Intellectual Property

“Without doubt one of the most accomplished barristers for trade mark disputes, and

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someone who has recently been instructed to act against silks. He is also one of the most experienced ECJ advocates with respect to trade mark and copyright cases" (2015)

"...has appeared in some of the most critical cases of the past year" and that he 'gets straight to the heart of commercial issues and provides the kind of creative advice that clients love.' "Marked out for great things" he handles a variety of matters, but is particularly well regarded for his trade mark practice where he show himself to be "keen and hungry for good work." (2014)

Also ranked as a leading junior in Media & Entertainment

"Has broad expertise pertaining to the media industry, and is notably adept at handling cases with IP components" (2015)

LEGAL 500 2015 & 2014

Ranked in top rank of leading juniors in Intellectual Property:

"The best trade mark senior junior at the Bar - no one knows more about the case law" (2015)

"...authoritative, tenacious and user-friendly" and "an encyclopedic knowledge of trade mark law" (2014)

Also ranked as a leading junior for Media and Entertainment work

"Client friendly, very clever and a good advocate" (2015) and "practical and commercial" (2014)

RECENT & NOTABLE CASES

TRADE MARK/PASSING OFF

- Kit Kat (Shape) – hearing before the CJEU on a reference concerning acquired distinctiveness and technical function
- Interflora v M&S (2013-2015) High Court trial, various appeals to the Court of Appeal and reference to the CJEU concerning Google AdWords infringement, survey evidence.
- Enterprise v Europcar (2015) High Court trial concerning car rental logo trade marks, scope of injunction
- Total v YouView (2014) High Court trial concerning distinctiveness, infringement, bad faith, legal certainty of trade marks
- Woolley v UP Global Sourcing – High Court trial (account of profits) re passing off
- Lush v Amazon – High Court trial for trade mark infringement arising out of the appearance of Amazon's product listings
- Nestle v Cadbury (Colour Purple) (2012-13) High Court and Court of Appeal concerning registrability of Cadbury's colour mark.
- Zee Entertainment v Zeebox (2014)– Court of Appeal case concerning surveys in passing off
- Comic Enterprises v Fox (The Glee case) –(2014/2015) High Court trial and Court of Appeal case concerning trade mark infringement arising out of the title of the US TV series
- Healey Sports Cars v Jensen – High Court appeal concerning use of the JENSEN trade mark for cars
- Specsavers v Asda – acted for UK government before the CJEU in a reference from the national court concerning scope of infringement of trade mark

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- Chartered Institute of Patent Attorneys (IP Translator) [2012] -acting for the UK government in CJEU reference before the Grand Chamber concerning class headings
- Budejovicky Budvar v Budweiser [2012] acting for Czech brewer before the Court of Appeal and in the reference to the CJEU
- Woolley v Ultimate [2012] trial and appeal before the Court of Appeal in a passing off case concerning watches
- BDO v Banco De Oro [2013] trial concerning trade mark BDO for financial services, own name defence

COPYRIGHT

- Copydan [2015]- CJEU reference on private copying.
- UPC Telekabel Wien [2014] CJEU reference on injunctions against ISPs in copyright cases
- VG Wort [2013] – CJEU reference on fair compensation
- SAS Institute [2012]- reference to the CJEU on copyright in computer programs.
- Football Dataco v. Yahoo [2012]- CJEU reference on database right and authors own intellectual creation standard.
- Football Association Premier League – copyright in football broadcasts, reference to the CJEU and appeal to Court of Appeal
- NLA v. Meltwater [2010]– Copyright Tribunal and High Court proceedings concerning copyright infringement by online news aggregators. Acted in strike out proceedings.
- Deakin v. Cardrax [2011] - two week trial before the PCC concerning copyright in greeting cards and joint tortfeasorship.
- SGAE [2010], AGEDI [2008], LSG [2008] and Promusicae [2007], all references to the ECJ concerning various copyright directives.
- PPL v. Attorney-General [2008] Francovich damages case against the government involving copyright exceptions and the Rental Rights Directive.

PATENT

- MMI v. CellXion [2010-2012] – Two High Court trials and two Court of Appeal hearings re patent for mobile telephone interception equipment
- Actavis [2013] CJEU reference on SPCs
- Unilever v SC Johnson [2012] PCC trial on shower head technology
- Universal Engraving v Falctontec [2012] PCC case involving magnetic technology.
- EPO Case G3/08 (Patentability of computer software.) [2010] Acted for the UK.
- Monsanto Technology [2010] – reference to the CJEU on the Biotech Directive, acted for the UK.
- AHP Manufacturing [2009] a reference to the CJEU concerning supplementary protection certificates, acted for the UK.

DESIGNS

- Skruf Snus [2015] appeal to the General Court from OHIM concerning RCD for a snuff box design
- Kohler Mira v. Triton [2010] Community registered design and UKUDR in bathroom products. Interlocutory hearings in Patents Court, with trial due in 2011.
- Care Monitoring v. Burrell [2009], a five day Community design right and UKUDR trial in the PCC concerning patient monitoring devices.
- Fundacion Espanola para la Innovacion de la Artesania ('FEIA') [2008] the first reference to the CJEU on the Community Designs Regulation, acted for UK.
- Oakley v. Animal [2006], Court of Appeal – case concerning the UK's implementation of the Designs Directive.

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Information Technology IT cases include *Artificial Solutions v. Creative Virtual* [2008] a five day trial before Arnold J and *Mass Information Systems v. RBS*, acting for RBS in a contractual dispute with an IT supplier.

FOI work includes acting for the Department of Work and Pensions in *DWP v. Collingbourne* [2010] a two day "trial" (hearing with cross-examination) before the First Tier (Information Rights) concerning trade secrets and the public interest.

COMPLETE LIST OF REPORTED CASES TO DATE

- *Enterprise v Europcar* (trial judgment) [2015] F.S.R. 22, High Court
- *Nazneen Investments v OHIM* [2015] ETMR 1, GC
- *Copydan Bandkopi v Nokia* [2015] ECDR 9, CJEU
- *Interflora v M&S III* (trial appeal) [2015] FSR 10, Court of Appeal
- *Total v YouView* (High Court trial) [2015] FSR 7, High Court
- *Interflora v M&S* (interim injunction) [2015] FSR 13, High Court
- *Indian Motorcycle v Indian Motorcycle* [2015] RPC 15, Appointed Person
- *The Hut.com v OHIM* [2015] ETMR 9, GC
- *Enterprise v Europcar* (survey evidence) [2014] ETMR 50, High Court
- *Woolley v UP Global Sourcing* [2014] F.S.R. 37, High Court
- *Cosmetic Warriors v Amazon* [2014] F.S.R. 31, High Court
- *Comic Enterprises v Fox* [2014] F.S.R. 35, High Court
- *Galileo International Tech v OHIM* [2014] ETMR 59, GC
- *Healey Sports Cars v Jensen* [2014] E.T.M.R. 18, High Court
- *Beyond Retro v OHIM* [2014] ETMR 54, GC
- *UPC Telekabel v Constantin* [2014] ECDR 12, CJEU
- *Adelphoi Ltd v DC Comics* [2014] ECC 11, Appointed Person
- *Elliott v LRC Products* [2014] RPC 13, Appointed Person
- *Zee Entertainment v Zeebox* (Court of Appeal) [2014] F.S.R. 26, Court of Appeal
- *Zee Entertainment v Zeebox* (High Court application) [2014] F.S.R. 26, High Court
- *Nestlé v Cadbury* (Kit Kat Shape) [2014] F.S.R. 28, High Court
- *Specsavers v Asda* (CJEU reference) [2013] E.T.M.R. 46; [2014] F.S.R. 4, CJEU
- *Nestle v Cadbury* (Colour Purple) [2013] EWCA Civ 1174; [2014] R.P.C. 7, Court of Appeal
- *Interflora v M&S II* (Survey Appeal II) [2013] EWCA Civ 319; [2013] FSR 2, Court of Appeal
- *Interflora v M&S I* [2013] FSR 26, [2013] FSR 21, Court of Appeal
- *Nestle v Cadbury* (Colour Purple) [2013] ETMR 2, High Court
- *VG Wort* [2013] ECDR 13, CJEU
- *Awareness Ltd v Plymouth City Council* [2013] RPC 34, Appointed Person
- *Environmental Manufacturing v OHIM* [2013] [2013] ETMR 54, GC
- *Stichting BDO v BDO Unibank* [2013] FSR 35, High Court
- *Meemi v Wardrobe* [2013] ECC 18, High Court
- *YouView v Total* [2013] ECC 17, High Court
- *Budejovicky Budvar v Budweiser* [2013] RPC 12, Court of Appeal
- *Syngenta v Chemsourc* [2013] FSR 11, High Court
- *Football Dataco v Yahoo* [2013] FSR 1, CJEU
- *Chartered Institute of Patent Attorneys (IP Translator)* [2013] RPC 11, CJEU (Grand Chamber)
- *Fruit of the Loom v OHIM* [2012] ETMR 44, GC
- *Interflora v M&S* (survey evidence) [2012] FSR 32, High Court
- *SAS Institute* [2012] RPC 31, CJEU
- *Comic Enterprises v Fox* [2012] FSR 30, PCC
- *Football Association Premier League* [2012] FSR 12, Court of Appeal
- *Tilda Riceland (Basmali)* [2012] ETMR 15, GC

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- Advanced Permitter Systems [2012] RPC 15, Appointed Person
- Cadbury's Trade Mark Application [2012] RPC 18, IPO
- Budejovicky Budvar v Budweiser [2012] RPC 11, CJEU
- Chalk v OHIM [2012] ETMR 23, GC
- Ineos Healthcare v OHIM [2011] ETMR 24, GC
- Galileo v European Union [2011] ETMR 22, High Court
- Diageo v. ICB ("Vodkat") [2011] RPC 2, Court of Appeal
- Pasticceria e Confetteria Sant Ambroeus Srl v G&D Restaurant Associates Ltd ("St Ambroeus") [2010] RPC 28, Appointed Person
- Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc [2010] RPC 7, Court of Appeal
- Diageo v. ICB ("Vodkat") [2010] RPC 12, High Court.
- AHP Manufacturing BV v Bureau voor de Industriële Eigendom (C-482/07) [2010] FSR 23, CJEU
- Fundacion Espanola para la Innovacion de la Artesania (FEIA) v Cul de Sac Espacio Creativo SL (C-32/08) [2010] RPC 13, CJEU
- L'Oreal SA v Bellure NV (C-487/07) [2010] RPC 1, CJEU
- Lastminute.com v OHIM [2010] ETMR 35, GC
- Interflora Inc v Marks & Spencer Plc, [2009] RPC 22, High Court
- Honda Europe v OHIM [2009] ETMR 34, GC
- Intel v CPM United Kingdom [2009] ETMR 13, CJEU
- Promusicae [2008] 2 C.M.L.R. 17, CJEU (Grand Chamber)
- MMI Research Ltd v. Cellxion Ltd [2008] F.S.R. 23, High Court
- Melly's Trade Mark Application; Oppositions of Fianna Fail and Fine Gael [2008] E.T.M.R. 42, Appointed Person
- Adam Opel AG v. Autec AG [2007] E.T.M.R. 33, CJEU
- Bovemij Verzekeringen NV v. Benelux-Merkenbureau [2007] E.T.M.R. 29, CJEU
- Miss World Ltd v. Channel Four Television Corp [2007] F.S.R. 30, High Court
- Valent Biosciences Trade Mark [2007] R.P.C. 34, IPO
- Efax Ltd's Trade Mark Application [2007] R.P.C. 26, IPO
- Tesco Stores Ltd v. Elogicom Ltd [2007] F.S.R. 4, High Court
- VITASOY International Holdings Ltd v. The Sunrider Corp (VITALITE Trade Mark) [2007] R.P.C. 29, High Court
- Oakley Inc v. Animal Ltd [2006] R.P.C. 9, Court of Appeal
- Julius Samann v. Tetrosyl [2006] E.T.M.R. 75, High Court
- Ajit Newspaper Inc's Trade Mark [2006] R.P.C. 25, Appointed Person
- Smirnova v. Smirnoff [2006] R.P.C. 16, IPO
- Bongrain (Cheese Shape) Trade Mark Application [2005] R.P.C. 14, Court of Appeal
- LOWDEN Trade Mark [2005] R.P.C. 18, High Court
- KML Invest AB's Trade Mark Application [2004] RPC 47, Appointed Person
- Arsenal Football Club v. Reed (No. 2) [2003] ETMR 36, High Court
- Arsenal Football Club v. Reed [2003] RPC 9, CJEU
- Adidas-Salomon AG v Microhaven Ltd [2003] ETMR 94, High Court
- Minsterstone Ltd v. Be Modern Ltd [2002] FSR 53, PCC
- FIRETRACE Trade Mark [2002] RPC 15, IPO
- Pearce v. Ove Arup Partnership Ltd [2002] ECDR, High Court
- Arsenal Football Club v. Reed (No.1) [2001] RPC 46, High Court
- Premier Luggage & Bags Ltd v. Premier Co (UK) Ltd [2001] FSR 29 [2001] ETMR 6, Court of Appeal
- BT v. Nextcall [2000] FSR 679, [2000] ETMR 943, High Court.

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