



Iona Berkeley

Year of call: 1999

Iona read Biological Sciences at Trinity College Oxford. During her CPE and BVC courses she was awarded a Diplock and a Queen Mother Scholarship by Middle Temple. Iona's practice covers all areas of intellectual property law and associated areas such as IP related international arbitration, contractual disputes and media and entertainment. Iona is also co-author of the recently released 16th Edition of Kerly's law of Trade Marks and Trade Names, the 15th Edition and the Supplement to it. She is also a co-author of Laddie Prescott and Vitoria on the Modern Law of Copyright and Designs (4th Ed).

Iona has been recommended as a leading IP Junior in Chambers Directory for several years. For example in Chambers 2017 Iona is described as thorough and very accomplished and in Chambers UK 2015 Iona was noted as being very responsive with solid experience. In Chambers UK 2014 it was said that Iona "has very good empathy with instructing solicitors and understands the difficulties they face. She always provides clear instructions" and in Chambers UK 2012 Iona was said to be "known for providing an excellent service to clients, and impresses due to the fact that she has 'a terrific commercial brain as well as a first-rate legal brain'". It was also said she was "excellent in court." Iona has also been described in The Legal 500 Directory as a barrister that 'solicitors whole heartedly recommend'. Highlights include:

- Glaxo Wellcome UK Ltd (t/a Allen and Hanburys) v Sandoz Ltd (High Court); [2017] EWHC 3196 (Ch) (Asthma Inhalers/pharmaceuticals, passing off, application to adduce survey evidence in High Court proceedings for passing off).
- Glaxo Wellcome UK Ltd (t/a Allen and Hanburys) v Sandoz Ltd (CA, High Court); [2017] EWCA Civ 335 (trade mark infringement and passing off,

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Colour per se trade marks, Asthma Inhalers/pharmaceuticals, trade mark declared invalid on Summary Judgment)

- Glaxo Wellcome UK Ltd (t/a Allen and Hanburys) v Sandoz Ltd (CA, High Court); [2017] EWCA Civ 227 (Asthma Inhalers/pharmaceuticals, Passing off, Joint tortfeasorship, Joinder of possible defendants, asthma inhalers)
- Speciality European Pharma v Doncaster Pharmaceuticals (CA, High Court) (Pharmaceutical parallel importation/trade mark infringement case concerning tropium chloride pharmaceutical products and the necessity to rebrand)
- Several major long running ICC and Ad Hoc International Arbitrations, on various issues including long term international licence agreements, settlement and co-existence agreements concerning trade marks and confidential information.
- DKH Retail Ltd v H Young Operations Ltd (IPEC). (This case concerned infringement of UK and Community Unregistered Design Rights in a Superdry gilet.)
- Coward v Phaestos (Copyright infringement and ownership issues. The case concerned automated hedge fund software copyright)
- Whirlpool Corp v Kenwood (3D trade mark infringement and passing off. The case concerned Kitchen Aid and Kenwood food mixers)
- Statoil v The University of Southampton (Patent Entitlement dispute concerning electromagnetic mapping for oil exploration).
- Bambino Mio v Cazitex (Trade mark infringement case concerning nappies)
- EPI v Symphony (Confidential information, passing off, contract. The case concerned degradable plastics)
- The Football Association Premier League v Panini (Copyright infringement case concerning Football player sticker albums)
- Kirin-Amgen Inc v Roche and TKT (Patent case concerning recombinant DNA technology and the protein Erythropoietin)

Iona appears regularly in the Court of Appeal, High Court and the Intellectual Property Enterprise Court. Further she appears regularly in front of the

Appointed Person, and at the IPO in Trade Mark Registry and Patent Office proceedings. Iona also has appeared as counsel in several long running International Arbitrations with hearings in London, Paris and Singapore and has considerable experience of this area. She is also experienced in representing clients at mediations. Past and present clients include: Alparma, Allergan, Diageo, Doncaster Pharmaceuticals, Football Association Premier League, Filofax, Hermès, HTC, Intel, John Lewis Plc, Kenwood, L'Oréal, Nestlé Purina, Panini, Primark, Roche, Russell and Bromley, Sandoz, Sky, Superdry (DKH Retail), Umbro, Xtratherm, University of Southampton, and Waitrose Limited. However Iona is very experienced with working with SMEs, creative individuals as well as large organisations.

The cases Iona has worked on have given her experience relating to a wide range of sectors such as pharmaceuticals, chemicals and plastics, biotechnology, medical devices and products, oil and gas, consumer household products, cosmetics and fragrances, fashion and footwear, financial services, textiles, the film and television industry, advertising, building materials, and publishing including internet work.

Trade Marks and Passing Off

Iona's recent cases include Glaxo Wellcome UK Ltd (t/a Allen & Hanburys) v Sandoz Ltd (Court of Appeal) [2017] EWCA Civ 335 ; [2017] FSR 32. In this case Iona is Junior Counsel for the Defendant Sandoz Ltd. This is an ongoing and large scale action for Trade Mark infringement and passing off brought by Glaxo against Sandoz in relation to asthma inhalers. The UK action forms part of a series of international disputes. Glaxo owned a EUTM colour per se trade mark which is visually represented by a photograph of an inhaler in two shades of purple. Glaxo alleged trade mark infringement of this mark and passing off in relation to its Seretide Accuhaler asthma inhalers as against Sandoz and its recently launched competing Airflusal Forspiro asthma inhaler. Sandoz counterclaimed for invalidity of the Glaxo EUTM colour per se mark. Sandoz brought an application for summary judgment on its counterclaim for invalidity, on the ground that the EUTM registration related not to a single sign but to a multiplicity or class of different signs and its registration was therefore in contravention of Arts 4 and 7(1)(a) of the EU Trade Mark Regulation. The case came before HHJ Hacon sitting in the High Court. Sandoz was successful with the Court finding Glaxo's EUTM invalid. Glaxo appealed to the Court of Appeal but were unsuccessful in their appeal

and their application for permission to appeal to the Supreme Court so the EUTM in issue has been invalidated. The passing off claim continues.

A recent decision in the ongoing passing off case concerned Glaxo's application to adduce survey evidence, where Glaxo was given permission to adduce survey evidence by Birss J on 15 December 2017, this decision can be found at *Glaxo Wellcome UK Ltd (t/a Allen & Hanburys) v Sandoz Ltd* [2017] EWHC 3196 (Ch). Another recent decision that forms part of these UK proceedings is that of *Glaxo Wellcome UK Ltd (t/a Allen and Hanburys) v Sandoz Ltd* [2017] EWCA Civ 227; [2017] FSR 32. In this Application, brought by Glaxo, Glaxo attempted to join two new parties as potential defendants to the proceedings. These new parties formed part of the Sandoz group of companies. One party was joined without objection. However, Sandoz Ltd objected to the joinder of the other two parties, Aeropharm GmbH and Hexal AG. In a reserved judgment which considered interesting questions concerning joint tortfeasance in passing off, issues concerning the Limitation Act 1980 and the recast Brussels I Regulation (EU) 1215/2012, HHJ Hacon sitting as a judge of the High Court found for Sandoz and refused permission to join Aeropharm GmbH and Hexal AG. However, this decision was overturned in the Court of Appeal.

Iona's cases also include *Speciality European Pharma v Doncaster Pharmaceuticals* (Court of Appeal, High Court) a trade marks infringement case concerning pharmaceutical parallel imports where Iona was Junior Counsel for the Defendant in the High Court action and the subsequent appeal. The case concerned the importation by the Defendant, Doncaster Pharmaceuticals Group, of the manufacturer's (Madaus GmbH) anti-diuretic drug with the active ingredient tospium chloride, originally put on the market in France and Germany by Madaus bearing the marks *Urivesc* and *Ceris* and the sale of these repackaged goods by the Defendant under the manufacturer's UK trade mark, *REGURIN*. The Claimant was *Speciality European Pharma Ltd*, the manufacturers' UK trade mark licensee and distributor.). The High Court found for the Claimant, finding that there had been trade mark infringement by the Defendant as the Judge found it was not objectively necessary for the Defendant to use the *REGURIN* trade mark to have effective access to the market in the UK.

This judgment was appealed to the Court of Appeal with Doncaster being successful on Appeal. The Court of Appeal (leading judgment by Lord Justice Floyd) reversed the Judge's finding and held that there was a substantial part of the UK market, that represented by prescriptions written by doctors by reference to the brand name *REGURIN*, to which the parallel importer would have no effective access without rebranding. The Court of Appeal considered

that the suggestion, which had appealed to the Judge, that the parallel importer could adopt its own brand name and market its parallel imports under that brand in competition with the original manufacturer's REGURIN product, was "not a real world alternative" and that, given the supply interruptions to which parallel imports are frequently subject, it would "verging on the irresponsible to encourage a doctor to prescribe a Doncaster brand." The Court of Appeal judgment is reported at *Speciality European Pharma Ltd v Doncaster Pharmaceuticals* [2015] EWCA Civ 54; [2015] 3 All ER 504; [2015] ETMR 19; [2015] RPC 20. The first instance decision is reported at *Speciality European Pharma Ltd v Doncaster Pharmaceuticals Group Ltd* [2013] EWHC 3624 (Ch); [2014] ETMR 11; [2014] RPC 11.

Another of Iona's cases include *Whirlpool Corp. and another v Kenwood Limited* (Court of Appeal, High Court) a three dimensional trade mark infringement and passing off case in relation to a new Kenwood food mixer, the "kMix" and the KitchenAid Artisan food mixer. Kenwood, whom Iona represented as junior counsel, was successful at first instance and in the Court of Appeal. Another case is *Bambino Mio Ltd v Cazitex* (Court of Appeal, High Court), a trade mark infringement action in relation to the Defendant's, Cazitex's, reusable nappies. The UK trade mark (registered for inter alia 'nappies') in issue was 'Bambino Mio', the potentially infringing mark, 'Bambineo'. Iona represented Cazitex, who was again successful both at first instance and in the Court of Appeal, with the trade mark infringement case being dismissed

Sample and Significant Cases

*Glaxo Wellcome UK Ltd (t/a Allen & Hanburys) v Sandoz Ltd** (Court of Appeal, High Court); [2017] EWCA Civ 335; [2016] EWHC 1537 (Ch).

In this case Iona is Junior Counsel for the Defendant Sandoz Ltd, being led by Martin Howe QC. This is an ongoing and large scale action for Trade Mark infringement and passing off brought by Glaxo against Sandoz in relation to asthma inhalers. The UK action forms part of a series of international disputes concerning these pharmaceutical products. Glaxo owned a EUTM colour per se trade mark which is visually represented by a photograph of an inhaler in two shades of purple. Glaxo alleged trade mark infringement of this mark and passing off in relation to its Seretide Accuhaler asthma inhalers as against Sandoz and its recently launched competing Airflusal Forspiro asthma inhaler. Sandoz counterclaimed for invalidity of the Glaxo EUTM colour per se mark. Sandoz brought an application for summary judgment on its counterclaim for invalidity, on the ground that the EUTM registration related not to a single sign but to a multiplicity or class of different

signs and its registration was therefore in contravention of Arts 4 and 7(1)(a) of the EU Trade Mark Regulation. The case came before HHJ Hacon sitting in the High Court. Sandoz was successful with the Court finding Glaxo's EUTM invalid. Glaxo appealed to the Court of Appeal but were unsuccessful in their appeal and their application for permission to appeal to the Supreme Court so the EUTM has been invalidated. The passing off claim continues. A recent decision in the ongoing passing off case concerned Glaxo's application to adduce survey evidence, where Glaxo was given permission to adduce survey evidence by Birss J on 15 December 2017, this decision can be found at *Glaxo Wellcome UK Ltd (t/a Allen & Hanburys) v Sandoz Ltd* [2017] EWHC 3196 (Ch).

Another recent decision that forms part of these UK proceedings is that of *Glaxo Wellcome UK Ltd (t/a Allen and Hanburys) v Sandoz Ltd** (Court of Appeal, High Court); [2017] EWCA Civ 227; [2016] EWHC 2743 (Ch). In this Application, brought by Glaxo, Glaxo attempted to join two new parties as potential defendants to the proceedings. These new parties formed part of the Sandoz group of companies. One party was joined without objection. However, Sandoz Ltd objected to the joinder of the other two parties, Aeropharm GmbH and Hexal AG. In a reserved judgment which considered interesting questions concerning joint tortfeasance in passing off, issues concerning the Limitation Act 1980 and the recast Brussels I Regulation (EU) 1215/2012, HHJ Hacon sitting as a judge of the High Court found for Sandoz but Glaxo were successful in their Appeal to the Court of Appeal.

Speciality European Pharma Ltd v (1) Doncaster Pharmaceuticals Group Ltd & (2) Madaus GmbH* [2015] EWCA Civ 54[2015] 3 All ER 504; [2015] ETMR 19; [2015] RPC 20

<http://www.bailii.org/ew/cases/EWCA/Civ/2015/54.html>

Iona Berkeley appeared as Junior Counsel for the Defendant, Doncaster Pharmaceutical Group, in this High Court trade mark infringement case before Mrs Justice Asplin concerning the parallel importation of pharmaceutical products in the fields of urology.

The case concerned the importation by the Defendant, Doncaster Pharmaceuticals Group, of the manufacturer's (Madaus GmbH) anti-diuretic drug with the active ingredient tospium chloride, originally put on the market in France and Germany by Madaus bearing the marks Urivesc and Ceris and the sale of these repackaged goods by the Defendant under the manufacturer's UK trade mark, REGURIN. The Claimant was Speciality European Pharma Ltd, the manufacturers' UK trade mark licensee and distributor.

The main issue in the case was whether the use of the REGURIN trade mark in the UK by the Defendant was necessary for the Defendant to have effective market access in the UK. The Defendant argued that the attempted enforcement by the Claimant of its trade mark rights in the REGURIN mark in the United Kingdom in order to prevent the re-branding by Doncaster of the Madaus products which Madaus had consented to be placed on the market elsewhere in Europe under other marks constituted a quantitative restriction on imports or a measure having equivalent effect within the meaning of Article 34 of the Treaty on the Functioning of the European Union which was not permitted by Article 36 TFEU because it amounted to a means of arbitrary discrimination or a disguised restriction on trade between Member States (see ECJ Case 379/97 Pharmacia & Upjohn SA v. Paranova A/S [2000] 1 CMLR 51). The week long High Court trial was heard in October 2013 before Mrs Justice Asplin. The Judge found for the Claimant, finding that there had been trade mark infringement by the Defendant as the Judge found it was not objectively necessary for the Defendant to use the REGURIN trade mark to have effective access to the market in the UK. The first instance case is reported at *Speciality European Pharma Ltd v Doncaster Pharmaceuticals Group Ltd* [2013] EWHC 3624 (Ch) [2014] ETMR 11.

This judgment was appealed to the Court of Appeal. The appeal hearing was in December 2014 and judgment was handed down on 6 February 2014 with Doncaster being successful on Appeal. The Court of Appeal (leading judgment by Lord Justice Floyd) reversed the Judge's finding and held that there was a substantial part of the UK market, that represented by prescriptions written by doctors by reference to the brand name REGURIN, to which the parallel importer would have no effective access without rebranding. The Court of Appeal considered that the suggestion, which had appealed to the Judge, that the parallel importer could adopt its own brand name and market its parallel imports under that brand in competition with the original manufacturer's REGURIN product, was "not a real world alternative" and that, given the supply interruptions to which parallel imports are frequently subject, it would "verging on the irresponsible to encourage a doctor to prescribe a Doncaster brand." Iona was junior counsel for the Appellant at the Appeal. The Court of Appeal judgment is reported at *Speciality European Pharma Ltd v Doncaster Pharmaceuticals* [2015] EWCA Civ 54.

Flynn Pharma v Drugsrus Ltd* and Tenelol Ltd*

High Court Trade Mark Infringement proceedings. This case concerned parallel importation of a pharmaceutical product "Phenytoin Sodium Flynn"

for the treatment of epilepsy. Iona Berkeley was junior counsel for the Defendants

Medac v Star Pharmaceuticals*

High Court Trade Mark Infringement proceedings. This case concerns parallel importation of a pre-filled syringe containing the drug methotrexate for the treatment of arthritis, sold under the brand name METOJECT in the UK but sold under the brand name REUMAFLEX in Italy, the country where the product was originally put on the market. The parallel importer re-branded the Italian product as METOJECT in the UK. The case concerned consideration of the several of the conditions as laid down in the ECJ Case of C-427-93, C-429/93 and C-436/93 Bristol Myers Squibb v Paranova [1997] FSR 103 and in particular the condition of necessity with regards the rebranding carried out by the parallel importer. The trial was due to be heard in March 2015 but the Claimant discontinued the action shortly before the trial. Iona Berkeley is junior counsel for the Defendant

One Max Ltd v HTC Corporation*

Trade Mark Opposition by HTC Corporation in relation to the trade mark application 'One Max' by One Max Ltd. Case involved consideration of Rule 18(2) of the Trade Mark Rules 2008. Iona was counsel for the Opponent, HTC Corporation.

G & J Holdings GmbH* v YouView Ltd (IPO) (O-113-14)

Trade Mark Registry Opposition (consolidated proceedings). G & J Holdings Ltd opposed YouView Ltd's three applications to register five trade marks consisting of or containing the words "My View" for various goods and services in Classes 9, 38 and 41. The Opponent opposed the registration of these marks under s. 5(2)(b) of the 1994 Act on the basis of its earlier International Mark for the word "VIEW" which is protected in the Community for various goods in Classes 9, 16, 35, 38, and 41 for identical or highly similar goods. It was held that there was a likelihood of confusion on the basis of the Opponent's earlier mark and the Opposition was successful. This decision was issued on a provisional basis pending resolution of the Community Trade Mark Invalidity proceedings which the Applicant, You View Ltd, had started at OHIM in relation to the Opponent's earlier mark, prior to UK Trade Mark Registry hearing. Iona was counsel for the Opponent.

Harman International Industries Limited v Martin Audio Limited* (IPO) (O-108-14)

Trade Mark Registry Invalidity Applications (consolidated proceedings). Harman International Industries Ltd applied to invalidate two UK trade Marks 'OMNILIVE' and 'OmniLine' both registered in respect of various goods in Class 9. Harman relied on objections under Sections 5(2)(b) and 5 (3) of the 1994 Act on the basis of its earlier Community Trade Mark 'OMNIDRIVE' also registered for various goods in Class 9 and also relied on an earlier right objection under Section 5(4) of the 1994 Act . It was held that there was a likelihood of confusion on the basis of Harman's earlier mark under Section 5(2)(b) of the 1994 Act and the Applications for declarations of Invalidity were successful. Iona was Counsel for the Trade Mark owner, Martin Audio Limited. This case was appealed to the Appointed Person but the appeal settled shortly before the hearing in January 2015.

Bettys and Taylors Group Ltd* v Rivington Foods Limited (IPO)

Trade Mark Registry Opposition. The well- known Betty's Tearooms of Harrogate, York and Ilkley opposed Rivington Foods Limited's Application for a UK trade mark for "Chocolately Rascal" for chocolate biscuits. Betty's opposition was based on its earlier trade marks for "Little Rascal", "Fat Rascal" and "Yorkshire Fat Rascal" for similar and identical goods. Betty's had been selling their famous Fat Rascals and Little Rascals (a cross between a cake, scone and biscuit) for many years. It was held that there was a likelihood of confusion on the basis of Betty's earlier marks and the Opposition was successful. Iona was counsel for the Opponent.

Ferrero SPA v Campbell Soup Company* (IPO)

Trade Mark Registry Opposition. Campbell Soup Company applied for various trade marks for the word mark 'TIM TAM' in relation to various goods including biscuits and confectionery. The Application was opposed by Ferrero SPA, owner of the word trade mark TIC TAC registered in relation to pocket confectionery. The Opposition was dismissed. Iona was counsel for the Applicant.

Bambino Mio Ltd v Cazitex NV* (Court of Appeal, High Court)

This action involved trade mark infringement in relation to the Defendant's, Cazitex's, reusable nappies. The UK trade mark (registered for inter alia nappies) in issue was 'Bambino Mio', the potentially infringing mark 'Bambineo'. After the High Court trial the claim was dismissed, the Judge finding no trade mark infringement. The Claimant appealed to the Court of Appeal but was unsuccessful, with the Appeal being dismissed. Iona was

counsel for the Defendant in the High Court proceeding and junior counsel in the appeal case.

Whirlpool Corp. and another v Kenwood Limited* (Court of Appeal, High Court)

This action involved trade mark infringement and passing off in relation to a new Kenwood food mixer, the “kMix” and the KitchenAid Artisan food mixer. The Community trade mark in issue was a three dimension mark for the shape of a KitchenAid food mixer with the word ‘KitchenAid’ applied to it. Whirlpool alleged that the Kenwood kMix mixer infringed its community trade mark and that Kenwood was also liable for passing off with regards the goodwill KitchenAid owned in relation to its KitchenAid Artisan mixer. The 8 day trial was heard in May 2008 before Geoffrey Hobbs QC sitting as a Deputy Judge of the Chancery Division of the High Court. The claim for both trade mark infringement and passing off was dismissed (see Whirlpool v Kenwood [2009] RPC 2). The Claimants appealed to the Court of Appeal, but their appeal was dismissed after a three day appeal hearing (see Whirlpool v Kenwood [2010] RPC 2) As well as dealing with 3-D trade marks the case also dealt with the issues of unfair advantage, and dealt with the procedural issues of witness gathering surveys. The Court of Appeal judgment was the first to deal with the issue of unfair advantage after the ECJ handed down its ruling in L’Oréal v Bellure. Iona was junior counsel for the Defendant.

Arbre Group LLC* v Worn By (Original Icon Clothing) LLP (Appointed Person (Amanda Michaels))

This was an Appeal to the Appointed Person regarding a procedural decision of the Trade Marks Registry concerning extensions of time for the filing of an Appeal Notice. The Registry originally refused the extension of time. The Applicant, Arbre Group LLC, appealed and was successful on appeal, thus was granted the necessary extension of time. Iona was counsel for the Appellant.

Checker Leather Limited v Sribhan Jacob Co. Limited* (Appointed Person (Richard Arnold QC) This was an appeal to the Appointed Person from the decision of Trade Marks Registry concerning an application to rectify the register. The Applicant, Sribhan Jacob, was successful in its application to rectify the register so as to have the Applicant’s name substituted as the name of the proprietor of the trade mark in issue (See Section 60 TMA1994). The original trade mark proprietor, Checker, appealed against this decision to the Appointed Person who dismissed the Appeal. Iona was counsel for the Applicant/Respondent.

Mars UK Ltd and Mars Inc. v Waitrose Limited*

Application in High Court for pre-action disclosure by Mars UK Ltd as against Waitrose Limited. Mars' potential cause of action was in relation to trade mark infringement and passing off relying on inter alia Mars' Whiskas brand of cat food as against Waitrose's own brand cat food. The hearing was in front of Evans-Lombe J. and Waitrose successfully resisted the application. Iona was counsel for the Respondent.

Wagg Foods Ltd v. Nestlé Purina Petcare (UK) Ltd* (High Court)

This action involved trade mark infringement and passing off in relation to Wagg Foods' dog food and Nestlé Purina's Baker's Complete dog food. The case settled shortly before trial. Iona was junior counsel for the Defendant.

Patents

Iona's significant cases include Statoil ASA v University of Southampton (High Court, IPO) which were patent entitlement proceedings regarding patents concerning electromagnetic mapping for oil exploration and Kirin-Amgen Inc v. (1) Roche Diagnostics GmbH and (2) Roche Diagnostics Ltd and (3)TKT, a High Court patent trial concerning Erythropoietin and recombinant DNA technology. Iona acted as junior counsel for the First and Second Defendants in the latter matter at the first instance trial which lasted some six weeks.

Sample and Significant Cases

(1)Kingspan Insulation Ltd and (2) Kingspan Holding (Irl) Limited) v Xtratherm UK Limited (High Court) *

Patent infringement action (with a counterclaim for invalidity) The subject matter was insulating building materials. The case settled shortly before trial. Iona was junior counsel for the Defendant.

(1)Prins Autogassystemen BV and (2) Prins Autogas Limited* v Vialle Alternative Fuel System BV (Patents County Court now the Intellectual Property Enterprise Court)

This is a Patents threats action under Section 70 of the Patents Act 1977. The subject matter is fuel injection systems for the motor industry. Iona was counsel for the Claimant in this matter.

Kohler Mira Ltd v (1) Norcros Group (Holdings) Ltd and (2) Triton Plc* (High Court)

Patent infringement action (with a counterclaim for invalidity and application to amend the patent in suit). The subject matter was electric showers. The action settled before trial. Iona was junior counsel for the Defendants.

Statoil ASA v University of Southampton* (High Court, IPO)

Substantial Patent Office proceedings for patent entitlement regarding a patent concerned with electromagnetic mapping for oil exploration. The Patent Office found for Statoil and ordered the transfer of ownership of the patent to Statoil, with the order stayed pending the Appeal. The University appealed to the High Court but the matter settled a few days before the

Appeal was due to be heard and the Appeal was dismissed by consent. Iona was junior counsel for the Respondents/Appellants.

Vibriant Technology v Protex Healthcare* (IPO)

Application in the Patent Office for a declaration of invalidity. Iona was counsel for the Patentee. Patent concerned with medical dressings.

Trespaphan UK Ltd v Polinas Plastik and others* (High Court)

This was a patent infringement action relating to packaging films. The case settled shortly before trial. Iona was junior counsel for the Defendant.

Kirin-Amgen Inc v. (1) Roche Diagnostics GmbH and (2) Roche Diagnostics Ltd* and (3)TKT (High Court)

This was the UK patent action which formed part of global litigation concerning the hormone, Erythropoietin, which is now synthetically produced to treat anaemia. Several important patent issues were dealt with in this case Iona was junior counsel for the First and Second Defendants.

(* denotes client)

Copyright & Design Rights

Iona acts regularly for the Football Association Premier League in cases brought against publicans and suppliers of IPTV boxes for infringement of the Football Association Premier League's copyright by the communication of the premier league logos to the public via Television screens.

A recent design right case of Iona's is DKH Retail Ltd v H Young Operations Ltd. The subject matter of the case was UK Unregistered Design rights and Community Unregistered Design rights concerning fashion garments, specifically a gilet. The Claimant, DKH Retail, which trades as the brand Superdry, alleged UK and Community Design right infringement by the Defendant, H Young Operations, which trades as the brand Animal in relation to the Animal Glaisdale gilet which was said to infringe the Claimant's design rights in the Superdry Academy gilet. HHJ Hacon in the Intellectual Property Enterprise Court gave judgment for the Claimant and dismissed all the Defendant's arguments on invalidity, finding the UK and Community Design Rights relied upon valid. Further the Judge found the Claimant was successful in proving infringement of both its Community and UK Unregistered Design rights in the Superdry Academy gilet. The Claimant was granted an injunction, an inquiry as to damages and associated relief. Iona was counsel for the Claimant, Superdry (DKH Retail Ltd).

An important case Iona is involved in is Coward v Phaestos (High Court). This case concerned software for automated hedge fund trading. The dispute was between a hedge fund and a former director, and raised issues over who owned the software (which in turn raised complex issues of partnership, contract and company law), what rights each party had to use the software, copying, and reproduction of a substantial part.

Another important case Iona was involved in is The Football Association Premier League Ltd and others v Panini UK Ltd (Court of Appeal, High Court). This summary judgment/ interim injunction case concerned a claim for copyright infringement regarding football sticker albums and the defence of incidental inclusion.

Sample and Significant Cases

[DKH Retail Ltd* v H Young Operations Ltd \[2014\] EWHC 4034 \(IPEC\)](#)

<http://www.bailii.org/ew/cases/EWHC/IPEC/2014/4034.html>

The subject matter of the case was UK Unregistered Design rights and

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Community Unregistered Design rights concerning fashion garments, specifically a gilet. The Claimant, DKH Retail, which trades as the brand Superdry, alleged UK and Community Design right infringement by the Defendant, H Young Operations, which trades as the brand Animal in relation to the Animal Glaisdale gilet which was said to infringe the Claimant's design rights in the Superdry Academy gilet. The Defendant argued that it did not infringe both sets of design rights and said that the Claimant's asserted rights were invalid on many grounds including with regards UK Design Right, the must fit exception, the method or principle of construction exception and that the designs were commonplace. With regards the Community Design Right the Defendant alleged invalidity on grounds which included the features relied upon were excluded as they were solely dictated by technical function, the spare parts exception, the complex products exception and that the designs had no novelty or individual character. The case also considered the newly amended Section 213 of the Copyright Designs and Patents Act 1988 (the new definition of a design). There was a two day trial in Intellectual Property Enterprise Court in October 2014.

HHJ Hacon in the Intellectual Property Enterprise Court gave judgment for the Claimant and dismissed all the Defendant's arguments on invalidity, finding the UK and Community Design Rights relied upon valid. Further the Judge found that the Claimant was successful in proving infringement of both its Community and UK Unregistered Design rights in its Academy gilet. The Claimant was granted an injunction, an inquiry as to damages and associated relief. Iona was counsel for the Claimant.

Coward v Phaestos*

Software for automated hedge fund trading. The dispute was between a hedge fund and a former director, and raised issues over who owned the software (which in turn raised complex issues of partnership, contract and company law), what rights each party had to use the software, copying and reproduction of substantial part. Iona was junior counsel for the Defendants.

DKH Retail Ltd* v Sports Direct.com Retail Limited and Others (Intellectual Property Enterprise Court)

A community registered design action. DKH Retail Ltd, trading under the well-known brand 'Superdry' have alleged that Sports Direct.com Retail Limited and others have infringed Superdry's Community Registered design for a Jacket. The action was settled before trial. Iona has represented the Claimant.

Lacoste SA and ors v Integrix and anr* (High Court)

A design right infringement action. Lacoste alleged that the Defendants by their import and making available to the public of two Fila shoe designs were infringing Lacoste's UK and Community unregistered design rights in two Lacoste shoe designs. The action settled shortly before trial. Iona was junior counsel for the Defendants.

FanFan Music Liechti & Cie v (1) Divorce Production Ltd and (2) Merchant Ivory Productions Ltd* (High Court)

A music copyright infringement action concerning the film 'Le Divorce'. The action settled before trial. Iona was counsel for the Defendants.

PRS v Amplefuture* (High Court)

A dispute concerning the royalties payable in relation to the supply of mobile phone ringtones. Case settled before trial. Iona was junior counsel for the Defendant.

The Football Association Premier League Ltd and others v Panini UK Ltd* (Court of Appeal, High Court)

This case concerned a claim for copyright infringement by the Football Association Premier League and various individual premier league football clubs against Panini, the well-known sticker album producer. It was claimed that Panini, by publishing photographs in its unofficial football sticker album of action shots of premier league players in their club kits had infringed the copyright in the premier league club crests (such as those of Manchester United and Arsenal) and the FAPL crest. Panini ran the defence of incidental inclusion. At the interim injunction hearing the matter was finally decided on a summary judgment basis, with the FAPL being successful on their claim. The matter was appealed and the Court of Appeal dismissed the Appeal. Iona was junior counsel for the Defendant/Appellant.

Union Textiles de Torcoing Industries SA* v Macart Limited and another (High Court)

This was a breach of confidence and design right action relating to spinning and yarn technology. The case settled before trial. Iona was junior counsel for the Claimants.

John Lewis Plc* v Peacocks (High Court)

Copyright Claim concerning duvet cover designs. Claim settled before trial.

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Iona was junior counsel for the Claimant.

(* denotes client)

Arbitration

Iona has considerable experience in significant arbitrations. She appeared as junior counsel in a long running International ICC Arbitration, concerning a long term trade mark licence agreement which involved significant substantive hearings in Paris on both liability and quantum. In another case Iona was junior counsel acting for Umbro in a major ICC arbitration in respect of an international licensing dispute. Iona has also recently completed hearings in Singapore in another ongoing major international arbitration as junior counsel. The dispute concerned an international trade mark co-existence agreement and its interpretation.

Sample and Significant Cases

Major International Arbitration (2014)

Major International Arbitration (2010-2011)

Major International Ad Hoc Arbitration with hearings in Singapore. The dispute concerns an international trade mark co-existence agreement and its interpretation.

Major ICC Arbitration (2008-2010)

Major ICC arbitration in respect of an international licensing dispute. Iona was junior counsel.

Interim injunction (2007, High Court)

Application in the High Court QBD relating to an application for injunctive relief in accordance with Section 44 of the Arbitration Act 1996. Iona was junior counsel for the Respondent.

Major ICC Arbitration (2002-2006)

Long running Arbitration. Substantial hearings in summer 2006 on quantum and on liability in spring 2004: Contract, trade mark licence agreement, Iona was junior counsel. The case concluded in 2006.

Confidential Information, Breach of Confidence and Contract

A highlight here is *EPI Environmental Technologies Inc v Symphony Plastic Technologies Plc* (Court of Appeal, High Court). The action concerned degradable plastic technology. The Defendants, whom Iona represented as junior counsel, were largely successful at first instance and in the Court of Appeal.

Sample and Significant Cases

Adelphi Masterfil Limited v Brian Potiphar and Filling and Capping Machines Limited (High Court):

Action for breach of a settlement agreement. The six day High Court trial concerned potential breaches of settlement agreement by the alleged misuse of technical design drawings for filling and capping machines used for the production of consumer products such as shampoos and the like. There was also a minor claim to copyright infringement. The case involved interpretation of various clauses of the settlement agreement and significant cross examination of technical witnesses. The Judge found for the Claimant with regards the copyright infringement but found misuse of only a limited number of drawings by the Defendants. Iona was counsel for the Defendants.

*EPI Environmental Technologies Inc v Symphony Plastic Technologies Plc** (Court of Appeal, High Court)

Action for breach of confidence, breach of contract and passing off. The trial was before Peter Smith J. and was held in private for three weeks. The action concerned degradable plastic technology. Symphony was largely successful, the Claimants' action for passing off, breach of confidence and the majority of their breach of contract claims being dismissed. The first instance public judgment was reported at [2005] FSR 22. The Claimants appealed. The Court of Appeal dismissed the Appeal after a four day appeal (see [2006] EWCA Civ 3, 1 WLR 495 (Note)). Iona was junior counsel for the Defendants/Respondents.

Union Textiles de Torcoing Industries SA v Macart Limited and another* (High Court)

This was a breach of confidence and design right action relating to spinning and yarn technology. The case settled before trial. Iona was junior counsel

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for the Claimants.

(* denotes client)

Media and Entertainment

Iona has a significant practice in this area and her media clients have included the Football Association Premier League, Mirror Group Newspapers, the National Union of Journalists, Merchant Ivory Pictures, and Seven Network (an Australian television Network).

Additional Information

Education and Awards

1994 – 97: Trinity College, Oxford, MA, Biological Sciences (2:1)

1997 – 98: City University, CPE Diploma in Law (with Commendation)

1998 – 99: Inns of Court School of Law, Bar Vocational Course (Very Competent)

1997 Diplock Scholarship, Middle Temple

1998 Queen Mother Scholarship, Middle Temple

Publications

Iona is co-author of the recently released 16th Edition of Kerly's Law of Trade Marks and Trade Names, the 15th Edition and the Supplement to the 15th Ed.

Iona is a co-author of Laddie Prescott and Vitoria on Modern Law of Copyright and Designs (4th Ed. Butterworths)

Seminars and Lectures

Iona regularly gives lectures and seminars. The topics Iona has given lectures on include:

- Proving Confusion in Trade Mark cases
- Winning Litigation strategies
- Parallel Import cases
- Trade Mark infringement and enforcement issues
- Patent Infringement Actions in the UK
- Patents; the mindset of the skilled person
- Privacy and breach of confidence

Other

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Member of the Middle Temple, Intellectual Property Bar Association,
the Chancery Bar Association and IPSOC.