

ALLEN & OVERY

# Our global intellectual property capabilities

2021

“They have outstandingly short reaction times, the solution is always presented in a way that I can directly forward it on, so irrespective of whether they are writing to me or a different department, it can be understood; it doesn’t need to be translated for non-lawyers.”

Chambers Europe-wide 2020: Intellectual Property

# Our intellectual property capabilities

Allen & Overy is one of the few major global law firms with a full-service, cross-border intellectual property capability.

We have steadily grown our IP practice to adapt to the needs of the world's leading businesses, understanding that globalisation and rapid advances in technology have brought new opportunities and threats to them. More than ever, our clients need to invest in global IP portfolios and IP enforcement to protect the 'crown jewels' of their business.

A&O's IP practice numbers over 100 specialist lawyers across Europe, Asia Pacific and the U.S. Many of our IP lawyers come from science, technology or engineering backgrounds and have a deep understanding of the sectors our clients operate in; particularly the media, technology, life sciences and consumer sectors.

This combination of technical knowledge and sector expertise is integrated with leading antitrust, arbitration, employment and regulatory expertise, and backed up by one of the largest international networks of any major law firm.

This puts A&O in the strongest position to manage clients' most complex IP issues and to handle strategic litigation and commercial deals around the world – a position we believe few other law firms can match.

## Full-service capability and specialist support

We advise on the full spectrum of IP matters. This includes the contentious and non-contentious aspects of patents, trade marks and brands (including trade mark filing and portfolio management), designs, domain names, sponsorship rights, copyright (including broadcast rights) and trade secrets.

We also advise on the acquisition of IP rights, joint ventures, licensing agreements, collaborative research and development arrangements, technology transfer agreements and distribution agreements.

Our lawyers are supported by a team of specialist legal project managers who ensure the biggest cases and transactions are managed rigorously. We also have an in-house team of science and technical analysts who review and analyse technically complex material – nearly all of whom have a PhD in their respective fields and work alongside leading scientific experts.

As part of our service delivery, we offer a range of training options for our clients. In addition to tailored training, once a year, we host our University of IP, an interactive one day course for in-house lawyers, covering the basics of the main IP rights (trade marks, patents, designs and copyright). Our IP specialists will cover the contentious and non-contentious aspects of IP as well as discuss key IP issues that affect businesses. The University aims to enable attendees to issue-spot more effectively and support their businesses in a more informed way.

# Global planning and coordination

Key to the success of managing IP portfolios, complex transactions and strategic litigation across different jurisdictions is effective international planning and coordination.

Our IP practice has top ranked lawyers around the world. The team is well-integrated and has built up a reputation for handling the most complex multinational IP transactions and disputes, backed up by a team of specialist legal project managers.

The most successful strategies use the differences in national regulations and enforcement systems to their advantage. Our team is experienced in leveraging the strengths and weaknesses inherent in different jurisdictions' legal structures

to the benefit of our clients' overall global position.

In litigation, taking an international view on case management makes it easier to decide whether to seek a quick validity decision from the English courts, or to use a German court's refusal to grant an injunction as a reason why a Spanish court should refuse a similar request.

Without our joined-up thinking, country-by-country transactions and litigation can descend into difficulty, with conflicting strategies, delays and spiralling costs.

“Allen & Overy is unquestionably one of the best commercial law firms worldwide and is excellent in the field of patent litigation. With its vast experience in the practice, it can go to war and emerge victorious.”

IAM Patent 1000 UK 2020

By investing in our global IP practice, A&O has built a strong reputation for developing global strategies by:



**Clarifying business priorities:**

- Integrating within a client’s business to identify priorities.
- Engaging with business stakeholders and counsel to build a picture of market context and IP right territoriality.
- Identifying issues and solutions at an early stage.



**Building the right global and country strategy:**

- Compiling in-depth legal analysis to align global and jurisdictional objectives.
- Establishing risk tolerance.
- Providing comprehensive technical and legal briefings, establishing strategy and know-how.
- Producing global and jurisdictional timelines showing milestones and hard-stops to coordinate pressure points and strategies.



**Delivering strategies effectively:**

- Actively project managing the portfolio, case or deal, using specialist legal project managers when necessary.
- Ensuring lines of communication are established and open.
- Providing real-time insight on the matter across jurisdictions.
- Quickly adapting to evolving circumstances and planning for contingencies.

“Very experienced, knowledgeable lawyers who take great care in the way in which they manage a case and ensure that their clients’ needs are met. They are all very pleasant to work with and I would say that they are one of the leading firms in IP.”

Legal 500, Intellectual Property UK 2022

# Patents

A&O's patents team acts for the world's leading companies in the most complex disputes and transactions. Described as "having an extremely powerful patent litigation arm", we act in multi-jurisdictional and national patent disputes across all major sectors and in the many different courts and tribunals worldwide – using settlement, dispute resolution and mediation when they can offer a better solution.

We advise clients on the most market-leading cases, including advising the active participants in some of the first disputes examining Standard Essential Patents (SEPs) and FRAND terms. We have also advised in relation to

Supplementary Protection Certificates (SPCs) and on the first Second Medical Use (SMU) case.

In addition to our litigation capabilities, clients come to us to help them exploit their patent rights in product and technology sales, joint ventures, licensing agreements, collaborative research and development arrangements, technology transfer agreements and financing arrangements based on patent revenue streams and/or patents as security.

“Working with Allen & Overy is a delight. They’re very hands-on and proactive; they know what needs to be done,” adding that the lawyers “make it very easy to be a client and are the top counsel I’ve worked with”.

Chambers France, IP 2020

\*Chambers UK, IP 2020

## Our experience includes advising:

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- **Huawei** in relation to Conversant's claim for a declaration that it has offered fair, reasonable and non-discriminatory (FRAND) terms in respect of its standard essential patent (SEP) portfolio.
- **A global pharmaceutical and healthcare company** in multi-jurisdictional patent revocation and infringement proceedings against Ceva Santé Animale. This is in relation to the company's patent for a veterinary product for the treatment of coccidiosis and anaemia for farm animals, specifically piglets.
- **An interested party** (as supplier to the defendants) on the UK patent infringement action brought by Unwired Planet against Samsung, Huawei and Google involving five patents declared as standard essential (SEPs).
- **Google** in their first patent case in France regarding patent infringement concerning apps available on Google Play. This very high-profile matter raised questions beyond those involved in any patent infringement case concerning the liability for making allegedly infringing apps available to the public.
- **A global pharmaceutical and healthcare company** as part of their global challenge to patents covering anti-PD-1 antibodies for the treatment of cancer and also in the first of its kind parallel litigation to determine the terms of the licence between the parties.
- **A leading U.S. computer hardware manufacturer** on policy issues relating to the draft Rules of Procedure for the Unified Patents Court (UPC), as well as drafting a submission to the UPC Preparatory Committee on the same.
- **Regeneron**, a U.S. biopharmaceutical company, on its European patent strategy for proprietary transgenic mouse technology (marketed as VelocImmune®) – the largest mammalian genetic engineering project ever completed.
- **A global healthcare company** in a ground breaking enforcement and defence of a dosage regime patent before Polish general courts in numerous litigation proceedings simultaneously. This is the first known case regarding dosage regime patents enforced in Poland. This is an extremely complex, precedent, contentious litigation case in Poland.
- **Archos** in a multinational patent dispute concerning both SEPs and implementation patents relating to mobile.
- **A global pharmaceutical and healthcare company** in the defence of its patents covering the blockbuster drug Cialis used to treat erectile dysfunction.
- **Samsung Electronics** on the French part of its worldwide IP litigation against Apple concerning its smartphones and tablets.
- **Premaitha Health**, an innovative British company that has developed the first CE marked non-invasive prenatal test (NIPT) for chromosomal aneuploidies (including Down's Syndrome), in the defence of patent infringement claims.
- **A multinational genomics company** on a dispute with a major patent portfolio owner relating to integrated systems for the analysis of genetic variation and function. The dispute arises from the patentee's attempts to seek licence fees in relation to a patent pool that it is party to with another major player in genetic sequencing.
- **Magotteaux**, a world leader in the development and manufacturing of grinding media and wear-resistant parts for the mining, cement, coal power and recycling industries, on a multi-jurisdiction patent litigation.
- **Pfizer** in enforcing its second medical use patent for its blockbuster, Lyrica (pregabalin), against Actavis and a large number of generic companies in the UK, France and Germany.

“Clients receive a Rolls-Royce service from a truly international firm, delivering results on a very tight timescale. The firm works as a seamless, joined-up machine.”

# Brands and trade marks

Trade marks are crucial to protect the innovation and investment that goes into developing brands – which for today’s leading businesses are significant company assets.

Our trade marks specialists support brand owners in developing, protecting and exploiting their brands on every level: from initial trade mark clearance and selection, to filing, managing complex international portfolios and any enforcement and disputes that arise.

Unlike many major law firms, we provide the full spectrum of legal support for brands and trade marks in-house, with a team of trade mark administrators and trade mark attorneys working together with our team of IP lawyers.

We have invested significantly in expanding our trade mark and design offering. Having grown the practice in London, in March 2019 we expanded the UK team into Belfast. Our Belfast trade mark team sits within the Legal Services Centre, part of our Advanced Delivery suite providing innovative ways to deliver our legal services to our clients.

Whether managing trade mark portfolios for fixed fees, or providing strategic legal support for brand owners across the globe, we have a market-leading practice that covers everything the world’s top businesses need:

Advising on whether specific marks are available for use and registration in territories of interest

Filing trade mark and design applications worldwide and taking them through to registration, building brand portfolios to maximise clients’ IP assets

Protecting clients’ trade mark applications and registrations against third-party attack

Protecting against infringement by running watch services and advising on strategies to halt infringements

Developing brand strategies and managing brand portfolios long-term

Implementing and executing effective dispute resolution strategies to defend clients’ brands, including domain names

Working with customs authorities to seize counterfeit goods around the globe

A&O is ranked ‘Gold’ in WTR 1000

World Trademark Review 2020

## Our experience includes advising:

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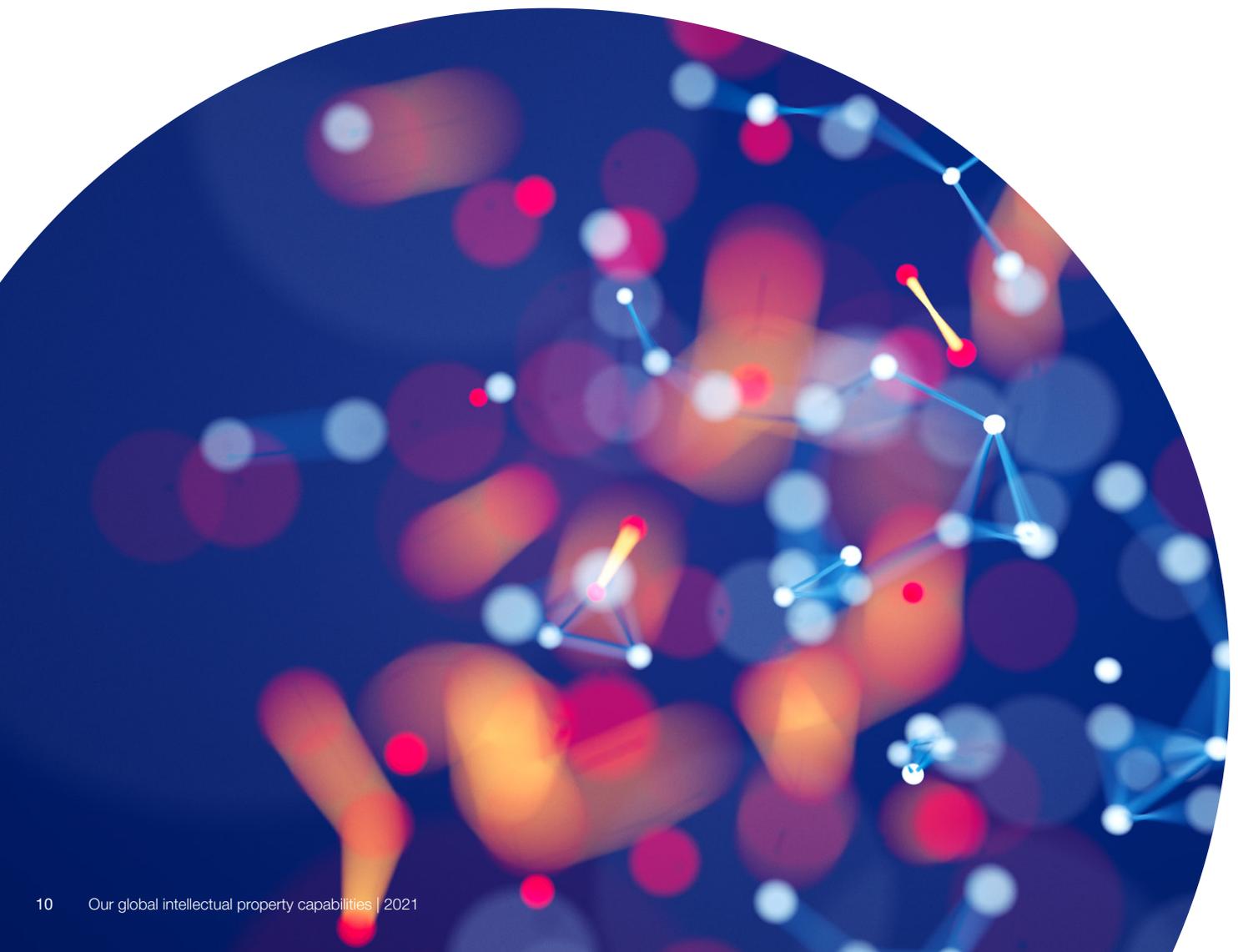
- **Intel**, the chip producer, in litigation relating to its flagship Intel and Intel Inside trade marks (resulting in a number of changes in corporate names and trade names of third parties).
- **The Coca-Cola Company** before the EU's General Court, as well as with brand protection, including trade marks and designs in the UK and EU.
- **Deutsche Telekom/T-Mobile**, the German telecommunications provider, on a trade mark dispute with VOO, a Belgian cable company, which is seeking the invalidation of Deutsche Telekom's magenta colour trade mark, which is an essential element of Deutsche Telekom's brand.
- Three **McDonald's** companies, as well as EMI, Pharrell Williams and Sony, on a claim in relation to the McDonald's "I'm Lovin' It" jingle, song and trade mark.
- **MGM** on their UK and EU trade mark filing, opposition and portfolio management work.
- **Honda** on a trade mark infringement claim in respect of the parallel import of Honda spare parts from outside the European Union, as part of an ongoing campaign in which we are acting to prevent the parallel importation of various Honda products from outside the EU.
- **Sanofi** in litigation against a local pharmaceutical company based on trade mark infringement and unfair competition in Slovakia.
- The owners of the **James Bond** brand on all related UK trade mark work.
- **Acomar Films** on their global trade mark filing programme and on trade mark and designs matters in relation to products such as Bing Bunny and Biteysaurus.
- On the litigation with the **Spanish Government** regarding the use of our client's trade mark "Saab" in an advertisement. We stopped the use of that sign within four days.
- **Unibail**, one of the world's leading real estate groups in proceedings introduced before the General Court of the European Union, concerning the validity of several strategic trade marks, as well as on several high-profile trade mark infringement and validity actions before the French courts.
- **Zentiva**, the largest Czech pharmaceutical company, in an unfair competition claim and trade mark invalidation proceedings in the Czech Republic against Teva Pharmaceuticals Czech Republic in relation to Zentiva's flagship product – Paralen.
- **A global pharmaceutical and healthcare company** in an unfair competition and trade mark infringement litigation in both the Czech Republic and Slovakia against Omega Pharma, in relation to one of the company's best-known dermatology products.
- **A leading Polish bank** on a trademark licence agreement. This was an exceptionally complex case concerning issues of trademark protection, potential infringement of a trademark, and the use of trademarks by different companies within one capital group.

“Allen & Overy is not just an able running mate to world-leading brands but a strategic pacesetter.”

World Trademark Review, WTR100, International 2020

“Allen & Overy needs no introduction in the field of global intellectual property. When it deals with portfolios, it deals with the biggest in the industry – and when it litigates, it does so across borders and in the most important battles.”

World Trademark Review, WTR1000, France 2020



# Design rights

Designs are a practical way to protect creativity and innovation. They are also valuable company assets.

A&O's intellectual property team has significant experience of advising clients on the protection of designs, including decorative patterns, graphic symbols and the shape of products and their packaging.

Our specialists can help you take advantage of some of the benefits offered by design rights over other forms of intellectual property rights, including the speed and simplicity of registration and the relatively low cost in some jurisdictions.

We can file design applications worldwide and take them through to registration, protect against infringement and implement dispute resolution strategies to defend clients' designs around the world.

## Our experience includes advising:

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- **A Premium Fashion Retailer** in an unregistered design dispute relating to clothing.
- **A manufacturing company** in an exceptionally complex, large-scale industrial design case involving very valuable products. The case involved cross-border litigation and technical knowledge.
- **DayMen**, a U.S. consumer goods producer, on the enforcement of their intellectual property rights against an importer and seller of products infringing DayMen's design and patent rights in the Czech Republic.
- **Tribù**, a manufacturer of exclusive designer garden furniture, in various disputes regarding infringement of their chair designs.
- **Etex**, a leading global building materials group, on the protection and enforcement of their design rights on design façade plates, which had been infringed by an Austrian competitor.
- **Honda** on the enforcement of its intellectual property rights against an importer and seller of products infringing Honda's design rights.
- One of the **world's leading manufacturers of knitting needles** on a number of invalidity actions before the EUIPO.
- Some of the **world's leading FMCG, fashion, electronics and luxury goods companies** on design protection strategies and infringement.

“...unparalleled in the field of designs.”

Legal 500, Brand Management UK 2019

# Copyright

Our copyright team works with some of the world's leading creative industries, including TV and film, publishing, software, music and digital, to help protect their valuable intellectual property assets.

We advise on both contentious and non-contentious matters, including:

Drafting and negotiation of copyright licences

Development of online distribution strategies for digital media, such as books, music, film and games

Copyright infringement actions before the national and European courts

The effects of new technologies and trends such as cloud computing

Our experience includes advising:

- **Nintendo**, as their main advisor in France, on a day-to-day basis on the enforcement of all aspects of its anti-piracy policy in France, notably in its efforts to prohibit the sale of devices designed to circumvent the technical measures protecting the Nintendo consoles and infringing their copyright and trade marks.
- **“The Voice”** brand owned by Dutch producer Talpa against Media Evenements, a French company claiming copyright infringement of its logo “The Voices” and substantial damages in the amount of EUR5 million, causing a serious threat to our client's rights on a logo which is used on a worldwide basis for one of the most watched TV programs of the past decade.
- **The Motion Picture Association of America** in their dispute with the hosting provider in respect of copyright infringement of the abovementioned studios. We negotiated an out-of-court settlement with the infringer, who fully complied with our demands.
- **An international client** in important cross-border litigation relating to the payment of copyright levies, including advising on several legal issues which have been or are still being debated before the European Court of Justice.
- **A U.S. software development company** on its acquisition of a Czech developer of data governance and analytic tools from its founders involving a complex transfer of copyright.
- **Flanders Classics**, organiser of several major cycling events, on a copyright matter relating to the unauthorised rebroadcasting of its races.
- **Ballon Media**, a publishing company, on several agreements with copyright owners.
- **TripAdvisor**, in a case opposing its subsidiary, restaurant booking platform La Fourchette to the Michelin Guide for an alleged infringement of copyright and database producer rights as well as unfair competition.

“Its dedicated experts are in their element advising on the IP aspects of major cross-border transactions and representing top brands in trademark litigation.”

World Trademark Review, WTR1000, Slovakia 2020

“The ‘ultra-reactive and available’ team at Allen & Overy LLP is very well known for advising clients drawn from regulated industries on a wide spectrum of non-contentious and contentious IP work.”

Chambers EMEA, Belgium 2020

# Trade secrets/breach of confidence

In acting for leading global companies and states in the most high-value and complex trade secret disputes around the world, we have amassed strong experience in matters ranging from individual employee trade secret theft to mass-scale cyber security attacks.

As part of our strategic approach to protecting our clients' valuable information, we frequently advise on preventative legal and technological measures that can short-circuit exposure to trade secret misuse and cyber threats.

## Our experience includes advising:

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- **A major international hedge fund** in relation to the theft of highly valuable confidential information and trading strategies by a rogue employee. This is a critical case for the client with significant potential losses flowing from the use of its confidential information.
- **RF Micro Devices (now Qorvo)** on enforcing trade secrets against its former employees and the competing companies that they set up. This is believed to be the first parallel enforcement in China and the U.S. for trade secret violations.
- **A highly successful global hedge fund** in long-running breach of confidence/trade secrets proceedings against a group of senior ex-employees who had broken away to form their own fund. The departing employees were believed to have misappropriated trade secrets relating to extremely profitable trading strategies.
- **Bünting** in a dispute concerning the alleged betrayal of business secrets and the alleged use of confidential market data.
- **A telecommunications equipment company** on a major strategic breach of confidence/trade secrets dispute following the breakdown of a joint venture with a major competitor.
- **A UK publisher** on a claim against a former director for misuse of trade secrets, breach of confidence and breach of restrictive covenants.

“It was stellar team performance and we benefited from the pure value contributed,” a source reports, adding: “There were no inefficiencies, it was seamless.”

Chambers, UK 2020



# Transactional IP

A&O has a long track record of advising clients on the acquisition, assignment and transfer of intellectual property rights through various structures, including:



We also advise on manufacturing and distribution agreements, co-marketing and co-promotion agreements in a variety of sectors.

As well as the structuring, drafting and negotiation of licensing and collaboration deals, we assist clients with the analysis of in-licensed IP and the potential for licensors to exploit those rights, as well as on the strategy for, and consequences of, terminating or exiting licensing/collaboration arrangements. We also advise clients on raising funds using royalty streams from licence agreements and on the use of IP as security.

With the increase of M&A deals designed to bring innovation into businesses, protecting your IP is crucial. We work closely with our M&A and antitrust lawyers to provide coordinated advice on the most complex deals and transactions.

## Our experience includes advising:

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- **Asahi** on the IP aspects of one of the world's biggest beer mergers: the acquisition of Peroni, Grolsch and Meantime (the PGM Business) from Anheuser-Busch InBev (ABI) and SABMiller.
- **PAI partners** (PAI), owner of R&R Ice Cream (the world's third largest global manufacturer of ice cream), on its 50/50 joint venture with Nestlé to form a new entity which will be called Froneri.
- **A global retail and investment bank** on the strategic ring-fencing and restructuring of its global intellectual property portfolio, including legal, regulatory and tax advice on the ownership and licensing of the group's intellectual property.
- **CISCO Systems** in relation to its acquisition of Cognitive Security, a Czech research company focused on detection of advanced cyber threats involving assessment of extensive copyright transfer.
- **Wolters Kluwer France** on its projected disposal of its Legal & Regulatory's French trade media assets to ATC, a private B2B media company in France.
- **A pharmaceutical company** on the transfer of some of its marketing authorisations to certain third parties.
- **The Emperador Group** on the acquisition of several Spanish brandy goods from Beam Suntory, which included a complex transaction that had to be done regarding a very important number of IP assets.
- **An international manufacturer** of components on the reorganisation of its global IP portfolio and the set-up of an R&D centre, including the conclusion of an IP assignment and licensing agreements.
- **Celyad**, a leading Belgian biotech, on a licence agreement concerning several of its pharmaceutical cancer products with ONO, for several Asian territories.
- **Kharis Capital** on a master agreement by which Burger King grants Kharis Capital the exclusive right to introduce Burger King restaurants in Belgium and Luxembourg.
- **Vemedia** in relation to the acquisition of Oenobiol from Sanofi.
- **Colfax Corporation** with a complex division and transfer of an existing trade mark portfolio including WIPO and other foreign trade marks in connection with its USD57m acquisition of ČKD Kompresory, based in Prague, Czech Republic, from ČKD Group.

“Its all-star group “benefits from exceptional support provided by the wide full-service international firm”, and has been going from strength to strength of late.”

IAM Patent 1000, UK 2020

# Global intellectual property contacts

## Our global team

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## Global presence

Allen & Overy is an international legal practice with approximately 5,600 people, including some 580 partners, working in more than 40 offices worldwide. A current list of Allen & Overy offices is available at [www.allenoverly.com/global\\_coverage](http://www.allenoverly.com/global_coverage).

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