

J A • K E M P

## TRADE MARKS AND DESIGNS

PATENT ATTORNEYS • TRADE MARK ATTORNEYS



LONDON • PARIS • OXFORD • CAMBRIDGE • MUNICH

# INDEPENDENT THINKING. COLLECTIVE EXCELLENCE.



Your intellectual property assets are of great value to you. To help you to secure, protect and exploit them, you need technical experts who are also creative problem solvers. You need a team of specialists working together to pool their knowledge and resources in support of your business goals.

J A Kemp is a leading UK and European Patent and Trade Mark Attorney firm that combines independent thinking with collective excellence.

To protect and exploit the value of your trade marks and designs you need attorneys who are both experts in the field and responsive, practical and commercial in their approach.

Every member of our trade marks team is a specialist who handles only trade marks and designs work.

Many of our senior professionals have backgrounds in major international law firms and are able to draw on a wealth of commercial experience holding qualifications as Chartered UK Trade Mark Attorney, Solicitor, Irish Trade Mark Attorney and French Trade Mark Attorney and French Avocat. The team has tens of thousands of trade marks under management.

The designs team is made up of patent and trade mark attorneys who have specialist expertise to meet all of your design protection requirements.

The hallmarks of our trade marks and designs work are the individual expertise of our attorneys, our capacity to handle large filing programmes and our total commitment to helping you to achieve your commercial objectives.

*"J A Kemp boasts one of the UK's most highly qualified collections of attorneys."*

Managing  
Intellectual  
Property

## TRADE MARKS

### Trade Mark Searching

Prior to using a new trade mark in a new market, and prior to filing an application to register it, it is essential to ascertain as far as possible that your chosen trade mark is available for these purposes. You can do this by searching to make sure that no one else has registered or is using your chosen trade mark or something similar.

We will advise you on the most appropriate search strategy, with a keen eye on budgetary constraints. We have a wide variety of leading commercial search tools at our disposal. We will advise you on the risks associated with the planned use and registration of your chosen trade mark, providing the information you need to decide whether or not to proceed.

### Trade Mark Filing and Prosecution

With clearance searching completed, you are in a position to progress to filing an application or applications to register the trade mark. Once registration is achieved, you will have a statutory monopoly in it.

We will advise you on the most cost effective filing strategy to adopt on a national, regional or global basis.

We are experts in securing registration of trade marks directly on your behalf with the UK Intellectual Property Office (UKIPO), the European Union Intellectual Property Office (EUIPO) and the World Intellectual Property Organization (WIPO). We understand the intricacies, oddities and pitfalls of registration through each of these routes.

We can access trusted local firms in countries where we have no representation before the national office.

### Trade Mark Related Litigation

You may find yourself in a situation where litigation is required to enforce your trade marks, or you may find yourself on the receiving end of a contentious action by another party.

If you need to engage an attorney to act for you in opposition, revocation or invalidation proceedings before either the UK Intellectual Property Office (UKIPO) or the European Union Intellectual Property Office (EUIPO), you will find that we are expert practitioners who bring a pragmatic, commercial approach to such disputes.

We are also experienced in handling Appellate actions before the Appointed Person, High Court, Court of Appeal and Supreme Court in the UK and before the Boards of Appeal of the EUIPO and the European General Court and the European Court of Justice.

J A Kemp has solicitors and holders of the Trade Mark and Design Litigator Certificate. The firm is well resourced to support you in any type of trade mark related litigation.



## ONLINE BRAND PROTECTION AND DOMAIN NAME DISPUTES

### Domain Name Disputes

Cybersquatting is widespread and increasing. We can assist with domain name disputes in the most cost-effective manner including via the UDRP, Nominet DRS, the various ccTLD procedures and less-conventional dispute procedures like the URS where applicable.

### Anti-phishing and Impersonation

Even the most secure IT system can be infiltrated by something as simple as a spoofed e-mail address. An unauthorised domain name can be used to impersonate staff, associates or third-party suppliers and obtain valuable know-how and account information, as well as to redirect funds and payments to the scammer.

We can help you develop policies to identify phishing scams at early stages, and also can act quickly to disable domain names and online accounts used for these scams. In the past, we have been able to cancel domain names being used to impersonate a UK PLC's chief financial officer only 35 minutes after instruction.

### Website and Social Media Takedowns

All major social media platforms have an internally-regulated procedure for removing infringing content, and there are a number of legal frameworks domestically and overseas that allow for a plan B in the event that the platform's moderators do not comply with valid demands. We have experience dealing with most major platforms in the UK and overseas, as well as using enforcement options to leverage compliance when necessary.

The same frameworks also enable us to remove infringing content from websites without necessarily engaging with the website owner. These strategies can be very useful as stand-alone mechanisms for curtailing offending conduct, and can also provide significant leverage in the context of a wider trade mark dispute.

### Management, Strategy and Portfolio Rationalisation

Bloated domain name portfolios are a sinkhole of time and resource. While it's usually a good idea to explore defensive registrations, it's also important to know where to draw the line. Our dispute experience allows us to advise on lean but effective registration strategies. Our trade marks experience enables us to secure rights quickly in territories where they are a pre-condition to valid domain name registrations. We can therefore advise you on how to make the most of your resource acquisition

### Monitoring

Trade mark monitoring is clearly a must for any brand owner. Domain name monitoring is a less-used but equally important tool as it not only identifies potential cybersquatting and phishing threats before they evolve into a significant problem, but also serves as the most cost-effective way to monitor how third parties might be using your or a similar brand for their own businesses, or to comment on or interfere with yours.

We are able to set up an effective monitoring and reporting program so that you are made aware of new phishing and cybersquatting threats only hours after they arise, but are also constantly up to date on any third parties that might be promoting their businesses online using your or a similar brand.

## DESIGNS

### Design Registration

Registered designs may be used simply to protect a design that has intrinsic commercial value. Sometimes, however, they can play an important part in your wider IP strategy.

They can be used to protect a logo concept that may ultimately form the basis of a trade mark. At the design registration stage its application need not be restricted to a particular class of goods, which can be of great benefit in merchandising.

We register designs with the UK Intellectual Property Office (UKIPO) and the European Union Intellectual Property Office (EUIPO) and file International Design Applications under the Hague Agreement. We can also advise you on tactical and commercial issues such as prior disclosure of a design, ownership of design rights (registered or otherwise) and deferral of design publication.

### Design Related Litigation

If you need to protect your designs against an attack from another party, or challenge the validity of another party's rights, you will require expert advice.

In the UK and Europe, designs are not examined for validity at the point of registration. If required we will provide you with opinions on the validity of particular registered designs and, where appropriate, on the existence of valid unregistered design rights.

We are able to explore in depth whether a particular design has novelty and 'individual character' in the context of the prior art in the relevant field.

We have many years of experience in settling infringement issues out of court. When litigation is unavoidable, we can assist with infringement proceedings before the High Court and the Intellectual Property Enterprise Court (IPEC). We can also handle invalidation proceedings before the UK Intellectual Property Office and the European Union Intellectual Property Office (EUIPO).

### REGISTRABLE TRANSACTIONS

It is important that your ownership rights or other interests in intellectual property rights are properly recorded on national registers.

We have an experienced team of solicitors and paralegals who understand the documentation and formalities peculiar to each country. We can help you to capture and record changes of ownership, licences and mortgages throughout the world.

## WHO OUR CLIENTS ARE

We work for a large variety of clients, from startups, spinouts and SMEs through to some of the largest corporations and most prestigious academic institutions in the world. We also have a network of attorney firms throughout the world who instruct us on behalf of their clients.

### Startups, Spinouts and SMEs

We advise companies on intellectual property issues from early innovation stages through growth, expansion and in many cases acquisition. Many startup and spinout companies rely totally on our intellectual property advice because they do not have any in-house experts.

### Large Corporate Clients

Corporate clients are the backbone of our client base. We are known for our expertise and long experience in handling major filing programmes, sometimes covering every significant market worldwide, for some of the largest commercial organisations in the world. We also have the resources, expertise and systems required to cope with huge numbers of cases for the same client.

### Universities and Technology Transfer

Our client base also includes some of the world's most prestigious universities, as well as technology transfer organisations and spinout companies.

### Overseas Attorney Firms

We value highly our strong relationships with attorney firms throughout the world. Some are firms that we have worked with for decades, handling major caseloads on behalf of their clients across diverse technology areas. Our partners regularly travel overseas and aim to visit attorney firms when they can. We appreciate the importance of personal relationships, not just between firms but also between individual attorneys.

## WHAT WE ARE KNOWN FOR

We commissioned a market research firm to ask 50 of our clients and professional contacts what they thought of J A Kemp. The firm was described as:

*"Highly regarded and respected as a leading player in its field"*

*"Known for quality, reliability, technical excellence and professionalism"*

*"Considered to be responsive, trusted, friendly and approachable"*

*"Known for its particular expertise in complex work"*

*"A firm with a reputation for timeliness and efficiency"*

To find out more about our Trade Marks and Designs Group, please refer to our website.

*"Commentators praise J A Kemp's partners for their 'intelligence, creativity and ingenuity', and are delighted with the consistently high quality of their work."*

Chambers & Partners

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