



Jane Lambert

Year of call: 1977

"She is especially good at advising new businesses."

Chambers & Partners

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Practice Summary

I am a barrister practising intellectual property, technology, media, entertainment and competition law since 1977. I specialise in advising start-ups and other small businesses on protecting and exploiting their investment in branding, design, technology and creativity and representing them before the Patent Court, Intellectual Property Enterprise Court and Intellectual Property List and the hearing officers of the Intellectual Property Office. I have appeared in several important cases and have written or contributed to a number of publications including "Enforcing Intellectual Property Rights". I am an arbitrator and mediator and sit on the WIPO Domain Name Dispute Resolution panels.

Like most other members of the patent bar, I advise patent and trade mark attorneys, solicitors and in-house legal advisers on such questions as:

- Can an invention be patented?
- Has a patent been infringed?
- Can we counterclaim for revocation?
- Can a sign be registered as a trade mark?
- Is this trade mark registration invalid or can it be revoked?
- Has this trade mark been infringed?
- Is this design registration valid?
- Has this registered design been infringed?
- Has this copyright, design right or right in a performance been infringed?

I also advise business owners and managers, venture capital, business angel and other investors, their accountants and other advisers under the Licensed or Public Access Rules on matters that do not require the intervention of an attorney, solicitor or other professional intermediary. Typical matters might be identifying the optimum legal protection for a new intellectual asset or on assessing the strength of a patent or patent portfolio.

I am interested in computing and keep abreast with science and technology. I also love the arts, particularly dance, drama, film, music and painting. I support the Huddersfield Choral Society, Northern Ballet and other dance companies, the Scottish National Trust. I enjoy all sorts of dance, especially ballet (about which I blog in Terpsichore) and classes in Leeds and Manchester. I am often in the audience at the National Media Museum in Bradford and am a frequent visitor to Salts Mill in Saltaire and the Yorkshire Sculpture Park near Wakefield.

Intellectual Property

Jane Lambert advises and represents entrepreneurs, investors and others in contentious and non-contentious matters relating to patents, registered and Community trade marks, registered and registered Community designs, unregistered Community designs, unregistered design right, copyright and related rights, actions for passing off, actions for breach of confidence and other intellectual property matters.

Patents: actions for infringement, groundless threats, declarations of non-infringement and revocation of patents in the Patents Court and Intellectual Property Enterprise Court (“IPEC”) and appeals to the Patents Court from the Comptroller; proceedings before the Comptroller on patentability, entitlement, employee’s compensation, non-infringement, revocation, amendment, compulsory licences and licences of right supplementary protection certificates; proceedings before the Boards of Appeal in the European Patent Office; actions for infringement and revocation of Unitary and other European patents in the Unified Patent Court; advice on patent strategy, patentability, licensing, validity and other transactions relating to patents; and drafting assignments, licences and other agreements and other instruments (cases *Sapey v Trianco Redfyre Ltd* [2002] IpsofactoJ Part 2 Case 1; *Kooltrade Ltd v XTS Ltd* [2001] FSR 344 and *Wragg v Donnelly*);

Trade marks: actions for infringement of registered trade marks and Community trade marks, groundless threats and actions and counterclaims for declarations of invalidity in the Chancery Division, IPEC and Chancery County Courts and appeals to the Chancery Division from the Registrar; opposition, invalidity and revocation proceedings before the Registrar and appeals from examiners; appeals to the Appointed Person; oppositions and invalidity proceedings in OHIM; appeals to Boards of Appeal and actions in General Court; domain name disputes before WIPO, Nominet, Czech Court of Arbitration and other domain name dispute resolution tribunals; advice on whether a mark can be registered, licensing, validity and other transactions relating to trade marks; drafting licences, assignments, franchise agreements and other transactions relating to trade mark (cases *Microsoft Corporation v Ling and Others* [2006] EWHC 1619 and *Strellson AG v Thornton & Ross Ltd*);

Registered Designs and Registered Community Designs: actions for infringement of registered designs and registered Community designs, groundless threats and actions and counterclaims for declarations of invalidity in the Patents Court and IPEC; invalidity proceedings before the Registrar; appeals from the Registrar to the Appointed Person or Patents Court; advice on whether a design can be registered, licensing, validity and other transactions relating to designs; drafting licences, assignments, franchise agreements, domain name transfers and other agreements relating to designs;

Unregistered Community Designs: actions for infringement in the Chancery Division, IPEC and the Chancery County Courts; drafting licences, assignments and other agreements relating to Community designs;

Unregistered Design Right: actions for infringement, groundless threats and applications to the Comptroller to settle terms of licences of right; drafting licences, assignments and other agreements relating to unregistered designs;

Copyright including moral rights: actions for infringement in the Chancery Division, IPEC and Chancery County Courts; proceedings before the Copyright Tribunal; drafting licences, assignments and other agreements relating to copyright (cases *Total Information Processing Systems v Daman* [1992] FSR 171 and *Ibcos Computers Ltd. v Barclays Mercantile Highland Finance Ltd.* [1994] FSR 265):

Rights in performances including moral rights: actions for infringement in the Chancery Division, IPEC and Chancery County Courts; drafting licences, assignments Passing off: actions for passing off in the Chancery Division, IPEC and Chancery County Courts; Breach of Confidence: actions for breach of confidence in the Chancery Division, IPEC and Chancery County Courts; drafting and reviewing confidentiality agreements; Other Intellectual Property Rights: plant varieties, semiconductor topographies, association rights, geographical indications of origin; injurious falsehood; database rights; encryption rights and foreign intellectual property rights.

Technology

Jane Lambert advises and represents parties to: Computer supply disputes: claims for breach of contract or negligence over the supply of hardware, software or services before the Technology and Construction Court or before arbitrators; Software Copyright: claims for copyright infringement or other IP disputes in the Chancery Division or IPEC; Data Protection: claims for compensation for alleged breach of statutory duty in the Chancery Division; proceedings in the Information Tribunal, drafting of privacy codes; Domain Name Disputes: proceedings before the courts or WIPO, Nominet or other tribunals; Electronic Commerce: representing parties to disputes and drafting terms and conditions, website access terms and other contracts; Escrow: source code and private key Contracts: research and development between universities, the NHS and private companies.

Competition

European: claims for damages and enforcement proceedings by Competition and Markets Authority and Commission for infringement of arts 101 and 102 of the Treaty of Functioning of the European Union; Statutory Claims: claims for damages and enforcement proceedings for infringement of Chapters I and II of Competition Act 1988 and proceedings under Enterprise Act 2002; Common Law: claims to restrain covenants in employment contracts; Drafting and reviewing: vertical and horizontal agreements particularly licences and distribution agreements.

Media and Entertainment

Telecommunications: licensing and regulation of broadcasting, narrow casting, telephony and data, end-use agreements; Regulation of investigatory Powers Music: recording, management and distribution agreements and band partnerships; Film and TV: productions and distribution agreements; intellectual property rights. Sports: sponsorship, regulation of sportsmen and women.

Bilateral Investment Treaties

Treaties between HM government and mainly developing countries by which investors can seek compensation for expropriation of their investments (which can include domestic legislation affecting subsistence or enforcement of the investor's intellectual property rights such as plain packaging of tobacco products or patentability) through arbitration proceedings in the International Centre for the Settlement of Investment Disputes ("ICSID") or other forums. Jane Lambert is the first IP lawyer to understand the importance of this developing jurisdiction and wrote "Bilateral Investment Treaties: A Remedy for SME?" (Dec 2013) [2013] EIPR 759. A similar dispute resolution mechanism will be used for disputes between businesses and sovereigns under the proposed transatlantic trade agreement between the USA and EU.

Commercial

Although I now specialize in IP and technology work I was Robert Reid's pupil at 9 Old Square and practised in general chancery at 8 Old Square and Bridge Street Chambers until 1995. I have a good knowledge of charities, commons, company law, constructive, implied and resulting trusts, conveyancing, equitable remedies, fairs and markets, family provision, franchising, landlord and tenant, partnerships, trusts, wills and the like. I have appeared in several reported cases in the Court of Appeal and Chancery Division.

Drafting and reviewing commercial contracts and standard terms and conditions, shareholder agreements, corporate and individual insolvency (Brook v Reed [2012] 1 WLR 419, [2012] 1 BCLC 379, [2011] BPIR 583, [2011] 3 All ER 743, [2012] WLR 419, [2011] BCC 423, [2011] NPC 34, [2011] EWCA Civ 331, [2012] BCLC 379, [2011] 4 Costs LR 622 and Deutsche Bank v Ariff 1991 FT LR 20 Dec).

Mediation

I was trained as a mediator in 2000 by the Chartered Institute of Arbitrators and was accredited in 2002. I specialize in resolving intellectual property and technology disputes and have experience of the following:

- Computer Supply Disputes: whether the equipment or services delivered comply with the contract or specification, whether fees or charges are justified, whether a triggering event to release documents held in escrow has occurred;
- Trade Marks: oppositions, revocations and invalidity proceedings
- Copyright: infringement and licensing

I am a member of the WIPO panel and am listed as an independent mediator by the UK Intellectual Property Office.

International Arbitration

I was trained by the Chartered Institute of Arbitrators and accredited in 1992. I sit on the WIPO arbitration, mediation and domain name dispute resolution panels. Most of my work consists of document only domain name disputes but I have resolved disputes in other areas including succession.

Reported Cases

- Ross v Playboy Enterprises International, Inc [2016] EWHC 1379 (IPEC) (13 June 2016)
 - Daletech Electronics Limited v Jemella Limited BL O/501/14 27 Nov 2014
 - Robert Wilson and Enviromax Ltd BL O/403/15
 - Strellson AG v Thornton & Ross Ltd BL 0-511-12 27 Dec 2012.
 - Twentieth Century Fox Film Corp. and Others v Harris and Others : [2014] Ch 41, [2013] EWHC 159 (Ch), [2013] 2 WLR 1454, [2014] 1 CH 41, [2013] WLR(D) 42, [2014] FSR 7, [2013] EMLR 16
 - Twentieth Century Fox Film Corp. and Others v Harris and Others : [2014] Ch 41, [2013] EWHC 159 (Ch), [2013] 2 WLR 1454, [2014] 1 CH 41, [2013] WLR(D) 42, [2014] FSR 7, [2013] EMLR 16
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- Brook v Reed [2012] 1 WLR 419, [2012] 1 BCLC 379, [2011] BPIR 583, [2011] 3 All ER 743, [2012] WLR 419, [2011] BCC 423, [2011] NPC 34, [2011] EWCA Civ 331, [2012] BCLC 379, [2011] 4 Costs LR 622;
 - Brook v Reed [2012] 1 WLR 419, [2012] 1 BCLC 379, [2011] BPIR 583, [2011] 3 All ER 743, [2012] WLR 419, [2011] BCC 423, [2011] NPC 34, [2011] EWCA Civ 331, [2012] BCLC 379, [2011] 4 Costs LR 622;
 - Microsoft Corporation v Ling and Others [2006] EWHC 1619;
 - Kooltrade Ltd v XTS Ltd [2001] FSR 344;
 - Sapey v Trianco Redfyre Ltd [2002] IpsofactoJ Part 2 Case 1;
 - Ibcos Computers Ltd. v Barclays Mercantile Highland Finance Ltd. [1994] FSR 265.
 - Total Information Processing Systems v Daman [1992] FSR 171
 - Deutsche Bank v Ariff 1991 FT LR 20 Dec
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Books & Articles

Jane Lambert "Enforcing Intellectual Property Rights: A Guide for Businesses and Creative Individuals" Gower 2009

Jane Lambert UNICOM Electronic Commerce on trade marks edited by D. Davis

Jane Lambert, "Computers" Vol 12. Atkin Court Forms 1986

Jane Lambert, "Data Protection" and Electronic Fund Transfers in "Bills of Exchange" Encyclopaedia of Forms and Precedents 1986

Articles

"Bilateral Investment Treaties: A Remedy for SME?" (Dec 2013) [2013] EIPR 759

Merck & Co. v Generics (UK) Ltd. EIPR, August 2004

The Proposed Patents Act 1977 (Amendment) Bill EIPR, December 2003

Intellectual Property Litigation after Woolf, EIPR September 2003

Intellectual Property Litigation after Woolf, EIPR July 2000

Jane Lambert "European Monetary Union: Software Procurement Issues" CLA Bulletin, October 1998

Jane Lambert "Electronic Fund Transfer Systems – The Emerging Legal issues" (1984) 81 LSGaz 3156 14 Nov
