4-5 GRAY'S INN SQUARE clerks@4-5.co.uk +44 (0)20 7404 5252



Jane Lambert

Year of Call: 1977

Practice Summary

I practise as a barrister, mediator and arbitrator in intellectual property and related areas of law. As a barrister, I advise patent and trade mark attorneys, solicitors and public access clients on difficult points of law. I draft complex legal instruments for use in business as well as for dispute resolution. I represent parties in contentious and non-contentious negotiations, mediation, arbitration and litigation before the Patents Court. Intellectual Property Enterprise Court ("IPEC"), the Chancery Division, Intellectual Property Office ("IPO") hearing officers and other tribunals.

I anticipate legal issues before they arise and advise how to avoid or mitigate them. Often, that requires me to draft software development, franchise, agency, distribution or escrow agreements, privacy codes, terms and conditions of business, end-user licences and other instruments. Where disputes cannot be avoided I help clients resolve them as expeditiously and favourably as possible. That may require me to settle pre-action correspondence, statements of case, application notices for injunctions and other interim relief and minutes of order, advise on and review witness statements and experts' reports and appear on interim applications, case management conferences, pre-trial reviews, trials and appeals.

As a mediator and arbitrator, I sit on the World Intellectual Property Organization panel of neutrals and have been listed as a mediator of IP disputes on the IPO website. Most of that work is resolving domain name disputes but I have mediated successfully computer supply, trade mark and copyright disputes and arbitrated a property claim.

I am the author of *Enforcing Intellectual Property Rights* published by Gower in 2009 and have contributed to several other books and journals. I keep the *NIPC Law* and associated blogs. I chair sessions and speak at the Cambridge IP Law Summer School every August. I raise awareness of intellectual property issues and provide initial advice and signposting at the Menai Science Park and Barnsley Business Village.

Patents

Non-Contentious: Advice on patentability, validity and infringement Drafting or reviewing confidentiality agreements, licences and assignments, collaboration and partnership agreements with universities.

Contentious: Advice and representation in *ex parte* and *inter partes* proceedings in the IPO on patentability, entitlement, revocation and declarations of non-infringement. Advice and representation in the Patents Court or IPEC on groundless threats actions, infringement and revocation proceedings and appeals from the IPO to the Patents Court.

Typical Cases:

Wragg v Donnelly BL O/280/10 (9 Aug 2010) (Declarations of non-infringement and revocation on grounds of lack of novelty, obviousness and insufficiency)

Sapey v Trianco Redfyre Ltd. (2 Aug 2001) Pumfrey J claim for infringement and counterclaim for revocation on the grounds of anticipation, obviousness and insufficiency

Kooltrade Ltd v XTS Ltd [2001] FSR 344 groundless threats.

Trade Marks

Non-contentious: Advice on the registrability of signs, validity and infringement of registered marks, geographical indications, collective and certification marks and domain names. Drafting or reviewing trade mark licences and assignments, business format franchise and distribution agreements.

Contentious: Advice and representation in the Trade Marks Registry on oppositions and applications for the revocation and/or invalidation of trade marks. Advice and representation in the Chancery Division or IPEC on groundless threats actions, infringement and revocation proceedings and appeals from the Registry to the Appointed Person or Chancery Division. Drafting complaints and responses in ICANN UDRP, Nominet DRS and other domain name disputes.

Typical Cases:

Strellson AG v Thornton & Ross Ltd BL 0-511-12 27 Dec 2012 (Opposition by the holder of an earlier mark)

Re LASE TM Application, Muhtaseb v Lase Medical Ltd BL O/201/20 31 March 2020 (Opposition by the holder of an earlier mark)

Litecoin Foundation Ltd v Inshallah Ltd and others [2021] EWHC 1998 (Ch) 16 July 2021 Mr John Kimbell QC (Whether a trade mark application is an actionable misrepresentation)

Registered Designs

Non-contentious: Advice on the registrability of designs and the validity and infringement of registrations Drafting or reviewing licences, assignments and distribution agreements.

Contentious: Advice and representation in the Designs Registry in cancellation proceedings. Advice and representation in the Patents Court or IPEC on groundless threats actions, infringement and cancellation proceedings and appeals from the Registry to the Appointed Person or Patents Court.

Copyright

Non-contentious: Advice on subsistence and licensing of economic and moral rights in artistic, dramatic, literary and musical works, broadcasts, films, sound recordings, published editions and other works. Drafting or reviewing software distribution agreements, end-user licences, software development, maintenance and escrow agreements, publishing, music, film and entertainment contracts

Contentious: Advice on infringement, settling statements of case and application notices, attending or opposing applications for injunctions and other interim relief (including search orders, freezing injunctions and blocking orders), case management conferences, pre-trial reviews, trials and inquiries in the Chancery Division or IPEC and appeals from those courts

---

Leading Cases:

Total Information Processing Systems v Daman [1992] FSR 171;

Ibcos Computers Ltd. v Barclays Mercantile Highland Finance Ltd. [1994] FSR 265

Twentieth Century Fox Film Corp. and Others v Newzbin Ltd [2010] EWHC 608 (Ch), [2010] ECC 13, [2010] FSR 21, [2011] Bus LR D49, [2010] EMLR 17, [2010] ECDR 8

Twentieth Century Fox Film Corp. and Others v British Telecommunications Plc (No. 2): [2012] 1 All ER 869, [2012] Bus LR 1525, [2011] EWHC 2714 (Ch)

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; and

---

Rights in Performances

Non-contentious: Advice on subsistence and licensing of economic and moral rights in performances. Drafting or reviewing appearance, broadcasting, recording and sponsorship agreements.

Contentious: As for copyright

Typical Case:

Needham v Stansfield (unreported 1992): Dispute between a well-known artist and former agent over publication of recordings made while the artist was a minor

---

Database Rights

Non-contentious: Advice on creation, maintenance, licensing and protection of databases and lawful extraction and reuse of their contents.

Contentious: As for copyright, claims for database right infringement can be brought against departing employees who have taken business contact lists without their employers' consent or other lawful excuse.

Unregistered Design Rights

Non-contentious: Drafting or reviewing agreements with product designers, manufacturers and importers

Contentious: Representing parties to disputes over royalties and other terms of licences of right in the IPO. Advice and representation in the Chancery Division or IPEC on groundless threats and infringement proceedings and appeals from the IPO to the court,

---

Semiconductor Topographies

Non-contentious: Drafting or reviewing agreements with chip designers, manufacturers and importers.

Contentious: Advice and representation in the Patents Court or IPEC in infringement proceedings

---

Supplementary Unregistered Designs

Non-contentious: Advice on subsistence and licensing. Drafting or reviewing agreements with designers, manufacturers, importers and retailers particularly in the fashion, toys and novelties industries.

Contentious: Advice and representation in the Chancery Division or IPEC in infringement proceedings. Customs seizures at ports and airports

---

Passing off

Contentious: Advice on infringement, settling statements of case and application notices, attending or opposing applications for injunctions and other interim relief (including search orders, freezing injunctions and blocking orders), case management conferences, pre-trial reviews, trials and inquiries in the Chancery Division or IPEC and appeals from those courts

Trade Secrets

Non-contentious: Drafting or reviewing confidentiality agreements or clauses in university collaboration, franchise, software development, distribution and employment contracts.

Contentious: Advice on breaches of confidence and contract and infringement of the Trade Secrets Directive, settling statements of case and application notices, attending or opposing applications for injunctions and other interim relief (including search orders, freezing injunctions and blocking orders), case management conferences, pre-trial reviews, trials and accounts or inquiries in the Chancery Division or IPEC and appeals from those courts

---

Computer Contracts

Non-contentious: Drafting or reviewing software development, maintenance and escrow agreements, turnkey contracts, consultancy, data processing and distribution agreements, website access terms, privacy statements, data processing and software as a service agreements

Contentious: Advice on breach of contract or negligence. Settling statements of case, reviewing and advising on witness statements and experts' reports, attending case management conferences, pre-trial reviews and trials in the Technology and Construction Courts or before arbitrators.

Information Rights

Non-contentious: Advice on the General Data Protection Regulation, Data Protection Act 2018, Freedom of Information Act 2000 and OECD Guidelines, Drafting and reviewing privacy statements.

Contentious: Advising and representing parties to disputes over subject access and other rights under the GDPR and Act, Representing parties to claims against data controllers for breach of information rights.

Typical Case:

Driver v Information Commissioner and another [2021] UKFTT 2017 218 (GRC), [2021] UKFTT 2017 0218 (GRC)

Competition

Non-contentious: Drafting or reviewing knowledge transfer, licensing, distribution, franchise and other agreements for compliance with the Competition Act 1998 and common law.

Contentious: Advice on agreements in restraint of trade, settling statements of case and application notices, attending or opposing applications for injunctions and other interim relief as management conferences, pre-trial reviews, trials and accounts or inquiries in the Chancery Division or IPEC and appeals from those courts

---

Intellectual Property Strategy

Non-contentions: Advising businesses (particularly tech start ups), their investors and professional advisors on the optimum legal protection and exploitation of their investment in branding, design, research and development and creative works, directing them to other experts and assisting them in developing IP strategies and integrating such strategies in their business plans.

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 licensingI 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

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

Books & Articles

Books

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 Find 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

Areas of Expertise

- Commercial
- Professional Discipline And Regulatory
- Sport Media And Entertainment