

## Amanda Michaels



Year called: 1981

Practice areas: IP, Copyright & Design, Trade Marks, Media & Entertainment, Chancery & Commercial

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Mediation & Arbitration: Mediator

*“She’s very approachable, realistic and great at managing client expectations. She’s very easy to work with and clear in her advice.” “Clever, experienced and adept at dealing with clients.” “She’s absolutely brilliant. Her practice is superb and everybody respects her.” Chambers and Partners 2021*

*“A highly knowledgeable trade mark specialist.” Legal 500 2021*

*“She is top in trade mark expertise, and is fantastically responsive and quick off the mark.” Chambers & Partners 2020*

*“She has amazing knowledge of IP and specifically trade marks.” Legal 500 2020*

*“She is intellectually brilliant, always extremely well prepared and in complete mastery of her instructions. She’s very persuasive on her feet and clearly very well respected by the judges, and brilliant with clients.”? Chambers & Partners 2019*

*“a clear leader in the field,” “unflappable before judges” and “deeply knowledgeable particularly on trade mark matters” Who’s Who Legal UK Bar 2018*

## **Profile**

Amanda has a wealth of experience in a broad field of practice, ranging from trade marks and passing off, copyright and designs, breach of confidence and related commercial disputes in the media and entertainment field, to broader contractual and Chancery disputes. She has acted for multinational brand and copyright owners, film, TV and record companies, and collecting societies, as well as for SMEs and individuals in disputes in the music/record industry, films, advertising, television, and publishing, often involving issues of contract or partnership law. She deals with a wide variety of copyright and design disputes, many in the fashion industry, and contractual/property disputes of all kinds.

Amanda is especially well-known as a trade mark specialist, dealing with trade mark and passing off matters at all levels, in UK and Community Courts.

Amanda is a persuasive and confident advocate, highly praised for her practical and commercial approach, for her client care skills and for the clarity of her arguments and written work. She has for many years been recommended by the major independent legal directories as a leading barrister for IP and Media and Entertainment, for instance as ‘something of a guru when it comes to trade mark law’, as ‘client friendly and wonderful on her feet,’ as ‘superb on paperwork and well-liked by all the judges’ and as ‘an absolutely outstanding senior junior with a fantastic capacity for assimilating information. She cuts to the chase and is a real pleasure to work with.’

Amanda is the author with Andrew Norris of ‘A Practical Guide to Trade Mark Law.’ The 5th edition of this popular textbook was published by OUP in March 2014.

Whilst remaining in full-time practice at the Bar, Amanda is a Recorder and has been appointed under s 9 of the Senior Courts Act to sit part-time as a Deputy Enterprise Judge of the Intellectual Property Enterprise Court. Amanda is also an Appointed Person under the Trade Marks Act 1994, hearing appeals from the UKIPO.

Amanda is an experienced mediator of IP, Chancery and wider commercial disputes; she has a high rate of successful outcomes.

## **Directory & Testimonial Quotes**

### **Legal 500 2021**

**Intellectual Property:** *“A highly knowledgeable trade mark specialist.”*

**Media & Entertainment:** *“Very down-to-earth with both excellent technical knowledge and insight into the inner workings of various courts and tribunals.”*

## Chambers and Partners 2021

**Intellectual Property:** *“She is fantastic at trade mark law and is very good at both the technical and legal sides of things. She is a pleasure to work with.” “Her advice is always sensible and commercial.” “She is extremely experienced and has amazing judgement.”*

**Media & Entertainment:** *“She’s very approachable, realistic and great at managing client expectations. She’s very easy to work with and clear in her advice.” “Clever, experienced and adept at dealing with clients.” “She’s absolutely brilliant. Her practice is superb and everybody respects her.”*

## WIPR Influential Women in IP 2020

*Amanda Michaels has been listed as one of “80 of the best and brightest women in the IP industry”*

## Chambers & Partners 2020

**Intellectual Property:** *“She has deep experience and knowledge of trade marks and passing-off claims.”*

**Media & Entertainment:** *“She is very good, particularly in cases involving trade marks.” “She is very easy to work with, down to earth and very straightforward.”*

## Legal 500 2020

**Intellectual Property:** *“She has amazing knowledge of IP and specifically trade marks.”*

**Media & Entertainment:** *“With in-depth knowledge of trade mark law she offers technically adept but also pragmatic advice.”*

## Who’s Who Legal UK Bar 2020

**Intellectual Property:** *“Hard-working and very approachable”*

**Media & Entertainment:** *“ranks highly among peers thanks to her adept handling of complex copyright cases.”*

## Chambers & Partners 2019

**Intellectual Property:** *“She is intellectually brilliant, always extremely well prepared and in complete mastery of her instructions. She’s very persuasive on her feet and clearly very well respected by the judges, and brilliant with clients.”*

**Media & Entertainment:** *“She is extremely knowledgeable, commercial and client-friendly.” “She is very experienced, level-headed and a good advocate.”*

## Legal 500 2019

**Intellectual Property:** *“She is precise, practical, commercial and able to relate to clients and the commercial realities they face.”*

**Media & Entertainment:** *“One of the best for trade mark matters; she brings insight, enthusiasm, and is also great fun to work with.”*

## Chambers & Partners 2018

**Intellectual Property:** *“She is very convincing and clear in her explanations, and what she says carries a great deal of weight.” “She is really knowledgeable and applies a practical and common-sense approach.”*

**Media & Entertainment:** *“Amanda is at the forefront of media-related trade mark and copyright work.” “She’s sensible, practical and good on her feet.”*

## Who’s Who Legal for the UK Bar 2018

**Intellectual Property:** *Leading Junior “extremely client user-friendly”, “unflappable before judges” and “deeply knowledgeable particularly on trade mark matters”*

**Media & Entertainment:** *“Most highly regarded” leading junior. “a clear leader in the field ... technically outstanding, highly commercial and client friendly.”*

#### **Chambers & Partners 2017**

**Intellectual Property:** *“She is an ideal choice for opinion work. Her oral presentation is forthright and persuasive” “She is extremely practical, very commercial, tells it as it is, and is great with clients”*

**Media & Entertainment:** *“She finds solutions that get to the heart of the client’s concerns”*

#### **Legal 500 2017**

**Intellectual Property:** *“She is very pragmatic and is prepared to think outside the box”*

**Media & Entertainment:** *“Fantastic on trade mark matters; she knows all there is to know.”*

#### **World Trade Mark Review 2017**

*“She has a “well-developed international perspective” on trade marks and understands how to run multi-jurisdictional cases so that results in one country benefit proceedings in another. “Her forensic approach works well for the trickiest cases.”*

#### **Legal 500 2016**

**Intellectual Property:** *“A formidable technician with an encyclopaedic knowledge of trade mark law”*

**Media & Entertainment:** *“Super-efficient, clear and very approachable.”*

#### **Chambers & Partners 2015**

**Intellectual Property and Media Entertainment:** *“Considered an oracle with regard to trade mark law, she is one of the most popular senior juniors for brands, media and passing-off cases. Sources speak highly of her clear careful and practical advice”*

#### **Chambers & Partners 2014**

*“A highly rated junior who quite literally wrote the book on trade mark law. She is particularly noted for her clarity of argument and ability to explain complex issues to clients”*

*“One of the leading trade mark barristers in the country. Even if you’re on the other side, you feel convinced by her arguments.”*

#### **Chambers & Partners 2013**

**Intellectual Property:** *Amanda Michaels is “known as something of a guru when it comes to trade mark law, and features in the rankings on the strength of highly enthusiastic feedback from her clients. Commentators say she is an “absolutely outstanding senior junior with a fantastic capacity for assimilating information. She cuts to the chase and is a real pleasure to work with.”*

## **Career**

Amanda read law at the University of Durham. Her interest in IP arose from her post-graduate studies of EU law at the College of Europe in Bruges, funded by Belgian Government scholarships, and then as a trainee in the Legal Department of the EU Commission. She wrote her Master’s thesis on trade mark law.

Amanda’s practice encompasses litigation at all levels and covers almost the full breadth of chambers’

work.

On the IP side, Amanda does a full range of IP and media work, save for patent validity/infringement actions, but she does have experience of disputes relating to patent licences and ownership. For many years she has acted for the collection societies, PPL and PRS. In addition to trials and interim hearings of all kinds, she has acted in many committal applications and has experience of arbitrations and mediation. On the Chancery side, Amanda has experience of a wide range of disputes, particularly of a contractual nature; she regularly acts in Family Provision, probate and proprietary estoppel actions and frequently achieves excellent settlements of such disputes without going to trial.

Since 2007, Amanda has combined her practice with part-time judicial work. She is an Appointed Person, hearing appeals from the UKIPO in trade mark matters. Those decisions can be found at <https://www.gov.uk/search-trade-mark-decisions>. She was appointed as a Recorder in October 2010 and as a Deputy Enterprise Judge of the IPEC in 2015. She has heard a variety of civil cases as well as cases in the Patents County Court and now the IPEC. Her judgments are online at [www.bailii.org](http://www.bailii.org) <<http://www.bailii.org>

Amanda also acts as a mediator in a wide variety of disputes. She is happy to conduct conferences and mediations and read documents in French.

## Cases

Currently acting for:

- a) the Defendant in a trade mark infringement and passing off claim brought by SKY, in which there is a counterclaim challenging various SKY marks;
- b) the Defendants to claims for infringement of trade mark brought by easyGroup;
- c) the author of a book in dispute with his previous employers as to ownership of its copyright;
- d) brand owners in separate proceedings for trade mark infringement and/or passing off arising out of the sale of 'look-alike' products;
- e) a diverse range of clients in relation to trade mark, copyright and/or design issues: a luxury goods conglomerate, a manufacturer of industrial machinery, a jeweller, a cosmetic company, a brewer, an energy company, a food manufacturer/importer, fashion designers/retailers and charities,

## Typical cases:

**Lyle & Scott Ltd v American Eagle Outfitters, Inc [2021] EWHC 90 (Ch) (20 January 2021):** obtaining permission to serve proceedings for breach of contract and passing off upon a US defendant, raising novel points on the Rome II Regulation.

**Brandlogic v Bentley Motors [2020] EWCA Civ 1726 (Ch), [16 December 2020] FSR 15:** trade mark

infringement case raising novel points on the transitional provision of the 1994 Act. Amanda Michaels and Charlotte Blythe were led by Simon Malynicz QC.

**Chanel's Gabrielle BL O/670/19 and O/256/20:** acting for the successful Opponent to Chanel's application to register CHANEL'S GABRIELLE for leather goods, in a case raising questions of indirect confusion by a form of "wrong way round confusion"

**Permanent Secretary, Ministry of Energy, Commerce and Tourism, Republic of Cyprus v. John & Pascal Ltd [2018] EWHC 3226 (Ch):** appeal to the High Court from the IPO's refusal to exercise the discretion to extend time for filing the defence to invalidity proceedings

**Chadwick v Lypiatt Studio Ltd [2018] EWHC 1986 (Ch):** acting for a family company in a successful High Court claim to the copyright in the artistic works of Lynn Chadwick deceased, and to ownership of his unsold sculptures and drawings.

**"Elvis Juice"** BL O/048/18 and O/105/18: appeal of trade mark opposition based upon rights claimed in "Elvis" in relation to beer

**"Americamp"** BL O/376/17: successfully defending an invalidity application.

**"Hunnies"** BL O/363/17: acting for the successful respondent to an appeal in relation to a declaration of invalidity

**Case T-107/16 Airhole Facemasks Inc v OHIM 16 May 2017:** advised on successful appeal to the General Court in a bad faith/agency invalidation

**Trust Capita Ltd v. Capita plc [2016] EWHC 3013 (Ch):** appeal to the High Court from the Company Names Tribunal.

**PPL & PRS v CGK Ltd and others [2016] EWHC 2642 (Ch):** Acting for the successful Claimants in a copyright claim raising issues as to the authorisation of the infringements.

**Acting** for a picture library in relation to copyright issues.

**Acting** for a manufacturer of spare parts defending a design right claim.

**Acting** for a food manufacturer in relation to lookalike products.

**Acting** for the publisher of a series of much-loved children's books in relation to copyright and trade mark issues.

**Acting** for a Defendant to an action for infringement of trade marks by sales from an on-line "mall"

**Acting** for a food manufacturer in relation to an ASA complaint.

**Skyscape Cloud Services v Sky plc [2016] EWHC 1340 (IPEC):** acting for a claimant seeking a declaration of non-infringement of trade mark

**Giraffe & Hobbit trade mark, BL 0/269/16:** acting for the successful opponent in IPO proceedings

**Jura Origin trade mark (Whyte and Mackay Ltd v Origin Wine UK)** [2015] EWHC 1271 (Ch), Arnold J: acting for the successful appellant in opposition proceedings on appeal from the UKIPO – an influential case in relation to the impact of the non-distinctive elements of trade marks.

**“Walk2Walk”**: acting for a charity in successful IPO proceedings. BL O/549/15 – appeal was abandoned.

**Eat Tokyo**: acting for the successful appellant/applicant in BL O/199/15 (TM appeal) and 0/449/15 (remitted opposition)

**JOY trade mark BL O/148/15**: acting for a successful applicant for revocation for non-use.

**Moroccanoil Israel Ltd v Aldi Stores Ltd** [2014] EWHC 1686 (IPEC); [2014] E.T.M.R. 55; [2015] F.S.R.4: acting for a claimant in a passing off case complaining of look-alike products.

**MB Garden Buildings Ltd v Mark Burton Construction Ltd** [2014] EWHC 431 (IPEC): acting for Defendant successfully disputing service

**Acting** for a Defendant in a claim for infringement of design right in agricultural parts.

**Advising** a French cosmetics company on an appeal to the CJEU in a trade mark case.

**Happy Sandwiches trade mark** BL O/181/14: acting for Noble Foods in its successful appeal of a trade mark opposition by McDonald’s.

**Vita trade mark**: BL O/514/13 acting for Dairy Crest in a successful appeal of a trade mark opposition

**Forstater v Python (Monty) Pictures Ltd** (2013) EWHC 1873 and [2014] 1 Costs L.R. 36: acting for the Pythons’ company in a claim brought for an increased royalty share by the producer of the iconic film “Monty Python & the Holy Grail”

**Jersey trade mark**. BL O/172/13: acting for the States of Jersey in its successful opposition to Chanel’s application to register ‘Jersey’ for perfumery

**Acting** for Coca Cola in a trade mark infringement and passing off action recently settled.

**Simmons trade mark**. BL O/468/12: acting for the successful applicant for invalidity of a trade mark, based upon historic goodwill and bad faith. and on the (unsuccessful) appeal by the trade mark proprietor.

**Arevdour v Kuçukçalik** (unrep): Acting for the Defendant in High Court proceedings obtaining the discharge of an interim copyright injunction and disclosure and freezing orders in a claim is for breach of an agency agreement compensation under the Commercial Agents Regulations 1993, and infringement of the artistic copyright in over 400 fabric designs.

**TMLC & Lonsdale v Leofelis**: successfully resisting summary judgment in a claim for breach of a trade mark licence: [2010] EWHC 969 and [2010] EWHC 1938, after the Defendant disputed the UK court’s jurisdiction: [2009] EWHC 3285 (Ch). Also acting for Leofelis in its inquiry for damages against Lonsdale for breach of the same trade mark licence.

An international **WIPO arbitration** (confidential) relating to alleged breach of contract and negligence in respect of the supply of software and digital rights management services.

**HCL v Urban [2009, unrep]**: acting for the successful claimants seeking interim relief and then obtaining summary judgment in a claim for breach of confidence, and infringement of copyright.

**Seatbooker v Southend United Football Club [2008] EWHC 157**: trial of claim for breach of IT supply contract.

**Baker Book House and others v Amue [2008, unrep]**: summary judgment for infringement of literary copyrights on website, followed by a committal application in 2010.

**GMG Radio Holdings Limited v Tokyo Project Limited [2006] F.S.R. 15**: passing off by use of a style of illustration in relation to music CDs and club nights.

**Clark v Clark [2006] F.C.R. 421 [2006] W.T.L.R. 823**: proprietary estoppel.

**Oska's Ltd's trade mark [2005] R.P.C. 20**: appeal raising issues of likelihood of confusion.

**Sony v Ball [2004] EWHC 1984 (Ch)**: contempt application under CPR r32 14

**Reed Executive Plc v Reed Business Information Limited [2004] R.P.C. 40 CA**: trade mark/passing off case including issues of use on websites, in metadata and 'SEO' techniques; and [2005] FSR 3 impact on costs of failure to mediate.

**Arkace v Nolan [2005, unrep]**: successfully defended High Court claim on basis that management and recording agreements made with a minor were unenforceable and in restraint of trade.

**Riddle v United Services Organisation Limited [2004] EWHC 1263 (Ch); (2004) 27(7) I.P.D. 27079**: claim for passing off.

**Miles v ITV (2003, unrep)**: claim for breach of confidence and copyright infringement in relation to children's TV series.

**Charly Acquisitions Limited v Immediate Records Inc [2002] EWCH 254**: ownership of copyright in catalogue of 1960s sound recordings.

**Altecnic v Reliance [2002] R.P.C. 34 CA**: amendment of trade mark application.

**Gabrin v Universal Music [2004] ECDR 4**: infringement of copyright in photograph and subsequent inquiry as to damages.

**Python (Monty) Pictures Ltd v Paragon Entertainment Corp [1998] E.M.L.R. 640**: acting for P(M)P in successful claim to recover rights to film "Life of Brian"

## Membership



Chancery Bar Association

IP Bar Association

ADR Chambers

## **Qualifications and Regulations**

### **Qualifications**

BA (Dunelm) Law

Certificat d'Hautes Études Européennes (Bruges)

MA (d'Hautes Études Européennes) (Bruges)

Called to the Bar Gray's Inn 1981

Appointed Person 2007

Recorder 2010

Deputy Enterprise Judge 2015

### **Regulations**

Amanda is a self-employed, independent barrister whose practice is governed by the Code of Conduct of the Bar of England and Wales. She is registered with the Bar Standards Board of England and Wales (Bar Ref: 16719). She has professional indemnity insurance provided by the Bar Mutual Indemnity Fund (BMIF Ref: 2190/011). Please refer to the BMIF website for full details of the world-wide cover provided, and the BMIF's contact details.

## **Publications**

### **Books**

[A Practical Approach to Trade Mark Law \(5th Edition\)](#) OUP

## **Human Interest**

Amanda is a keen singer and an enthusiastic cook.