

## Gwilym Harbottle



Year called: 1987

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

Email: [ibowie@hogarthchambers.com](mailto:ibowie@hogarthchambers.com)

Mediation & Arbitration: Mediator

***“He is first rate both in terms of his knowledge of the subject matter and in the quality and commerciality of his advice.” Chambers & Partners 2020***

*“He is intelligent, approachable and commercial.” ? Legal 500 2019*

*“He is very thorough, keeps up with the law and likes to think outside the box in terms of what weapons you can use to fight various issues” ? Chambers & Partners 2018*

*“He is intelligent, available and very down-to-earth. He provides high-quality work and is very professional.” Chambers & Partners 2017*

*“He has a good eye for detail and makes clear submissions.” Legal 500 2016*

## Profile

Most of Gwilym Harbottle's practice is in IP and Media and Entertainment. His IP practice covers copyright and related rights (a particular expertise), trade marks and passing off, designs and data protection (including the GDPR). He draws on both his IP and his Chancery/Commercial expertise when acting in Media and Entertainment disputes.

He has advised and represented many of the leading copyright collecting societies and major brand owners, with a particular emphasis on enforcement (including criminal enforcement) and committal applications.

He has extensive experience in High Court and IPEC litigation but has also been instructed in the Copyright Tribunal, as an expert witness on UK copyright law and by trade bodies to advise on proposed and new legislative developments.

He continues to have a significant caseload in the Chancery/Commercial field, with a particular interest in real property law.

He is an editor of Copinger on Copyright (17th edn) published March 2016.

## Directory & Testimonial Quotes

### Chambers & Partners 2020

**Intellectual Property:** *"He is first-rate in his subject matter knowledge and the quality and commerciality of his advice." "He gives confidence that no little wrinkles will be overlooked."*

**Media & Entertainment:** *"He is very client-friendly and always impresses with his attention to detail." "He has a huge brain and really considers all of the points in a case."*

### Chambers & Partners 2019

**Intellectual Property:** *"He gets on top of complex matters quickly, even if they involve specialist sectors. He is a team player and I always feel that he is working with me and my client. I appreciate his candour."*

**Media & Entertainment:** *"He is extremely thorough and has great attention to detail. He is prompt in turning around work, is very approachable, easy to deal with and a confident advocate."*

### Chambers & Partners 2018

**Intellectual Property:** *"He is very thorough, keeps up with the law and likes to think outside the box in terms of what weapons you can use to fight various issues"*

**Media & Entertainment:** *"He's excellent in court with a keen eye for detail." "His grasp of the technicalities of copyright law, particularly when it comes to music publishing, is impressive."*

### Chambers & Partners 2017

**Intellectual Property:** *“He is intelligent, available and very down-to-earth. He provides high-quality work and is very professional.”*

**Media & Entertainment:** *“He is razor-sharp, with an impressive grasp of substantive and highly complex detail.”*

**Chambers & Partners 2016** *“One of the Bar’s most eminent authorities on copyright law ...” “He is very experienced in the field of copyright across the board and provides clear and concise advice”.*

**Intellectual Property:** *“He is very experienced in the field of copyright across the board and provides clear and concise advice”. “An elegant draftsman of pleadings and other documents”.*

**Media & Entertainment:** *“He is very knowledgeable, very dependable and a very effective advocate.” “He really knows his stuff”. “He gives you exactly what you need in a client-focused manner”.*

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

**Intellectual Property:** *“Praised by commentators for his prowess in copyright cases, he undertakes other types of soft IP in addition. He’s an experienced practitioner with 25 years in the field.” “He has a complete command of copyright law and is a go-to person for anything on copyright.”*

**Media & Entertainment:** *“A seasoned hand at record company contract disputes, who is much sought after by the major collecting agencies for contentious copyright disputes.” He is valued for his “very calm and sensible” approach. “He is very experienced in the field of copyright and provides clear and concise advice.”*

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

**Intellectual Property:** *“has an “immense reputation for copyright work,” with one source saying: “What he doesn’t know about copyright isn’t worth knowing.” He is also called upon frequently for instructions concerning design rights and trade marks.”*

**Media and Entertainment:** *“offers valuable input into high-level copyright and collecting society disputes, .... His key strengths include being “extremely bright” and “very good at nailing down complicated academic copyright points.”*

#### **Chambers & Partners 2012**

**Media & Entertainment:** Gwilym “is “terribly clever and always takes an intellectual approach to his work.” He regularly advises and acts for PRS, and was recently involved in a copyright claim by artist Roger Dean, who is best known for designing record covers for prog rock legends like Yes, Asia and Uriah Heep.”

#### **Legal 500 2021**

**Intellectual Property:** *“A well-respected barrister practicing in this specialist area”*

**Media & Entertainment:** *“Bright as a button and methodical, a very capable junior”*

#### **Legal 500 2020**

**Intellectual Property:** *“He is as bright as a button, methodical and has an eye for detail.”*

**Media & Entertainment:** *“He is an intelligent, hardworking and commercial barrister.”*

#### **Legal 500 2019**

**Intellectual Property:** *“He is intelligent, approachable and commercial.”*

**Media & Entertainment:** *“He is client friendly and clever (without being flashy).”*

#### **?Legal 500 2017**

**Intellectual Property:** *?”A hardworking, intelligent and approachable advocate.”*

**Media & Entertainment:** *“He is not only extremely knowledgeable on copyright matters but very good in court.”*

#### **Legal 500 2016**

**Intellectual Property:** *“He has a good eye for detail and makes clear submissions.”*

**Media & Entertainment:** *“Hardworking, intelligent, approachable and reliable.”*

#### **Legal 500 2015**

**Intellectual Property:** *“Very knowledgeable on complex IP issues.”*

**Media and Entertainment:** *“A great communicator who is also practical and efficient.”*

#### **Legal 500 2013**

**Media and Entertainment:** *“user-friendly and thorough.”*

#### **Legal 500 2012**

**Intellectual Property:** *“highly regarded ... ‘very good on matters where there is a criminal element’”*

**Media and Entertainment:** *“The ‘thorough, user-friendly’ Gwilym Harbottle and Amanda Michaels handle trade mark and copyright matters.”*

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

*“Exceptionally smart, while also commercial and practical.”*

Gwilym is regarded in **Who’s Who Legal: Trademarks 2015** for sports and entertainment.

## **Career**

Gwilym Harbottle read Modern History at Oxford before studying Law at City University, London. He was called to the Bar in 1987 and joined 5 New Square in 1992.

## **Talks**

Gwilym has recently spoken on a variety of IP issues including:

- Anton Piller orders, Mareva injunctions and Norwich Pharmacal orders in copyright cases (ALAI Congress, Montreal, 2018)
- GS Media, FilmSpeler and The Pirate Bay (BLACA May 2018)
- Copyright Law and Remedies (WIPO Building Respect for Intellectual Property programme, Kigali January 2017 and Baku December 2017)
- Copyright exceptions including quotation, parody and temporary copying
- Orphan works
- European jurisdiction in copyright cases
- Hyperlinking and copyright infringement
- Blocking injunctions
- Marks with a reputation
- Civil and criminal IP enforcement in the digital environment
- Criminal IP offences

## Cases

### IP and Media/Entertainment

**Response Clothing Ltd v Edinburgh Woollen Mill Ltd [2020] EWHC 148 (IPEC).** Copyright in a fabric design. The first UK case to consider the impact of recent EU case law on what is a “copyright work”. Under appeal.

**Asia Standard Management Services Ltd v Standard International Management LLC [2020] EWHC 28 (Ch).** Trade mark appeal to the High Court on extent to which Hearing Officers need to consider goods and services individually in likelihood of confusion cases.

**Phonographic Performance Ltd v Ellis (t/a Bla Bla Bar) [2018] EWCA Civ 2812.** Important decision on availability of additional damages in committal applications where the breach is also a copyright infringement.

**Bayerische Motoren Werke Aktiengesellschaft v Kellmatt Ltd [2018] EWHC 2090 (IPEC):** liability of printer for manufacture and sale and use by counterfeiter of trade marked labels

**Bayerische Motoren Werke AG v Premier Alloy Wheels (UK) Ltd [2018] EWHC 1713 (Ch):** Anton Piller and related orders against seller of allegedly counterfeit alloy wheels

**BMW v Technosport London Ltd ?[2017] EWCA Civ 779; [2017] E.T.M.R. 32; [2017] F.S.R. 35:** represented successful claimant in claim for trade mark infringement by use by a garage operator of BMW name and logos.

**Oran Pre-Cast v Oranmore Precast Ltd [2016] EWHC 1846 (IPEC):** a trade mark and passing off case. This case also involved breach of contractual issues as to whether the claim had been compromised.

**Phonographic Performance Ltd v Nightclub (London) Ltd [2016] EWHC 892 (Ch):** committal for breach of injunction restraining public playing of sound recordings.

**Hook v Sumner [2015] EWHC 3820 (Ch); [2016] BCC 220:** represented Peter Hook in successful application for permission to bring derivative action arising from a dispute between the members of the band New Order.

**Motivate Publishing FZ LLC v Hello Ltd [2015] EWHC 1554 (Ch):** trade mark licensing and estoppel.

**Band Therapy Ltd v Heavy Truth Music Publishing Ltd [2014] EWHC 3811 (IPEC); [2015] EWHC 1253 (IPEC):** dispute about ownership of rights in compositions.

**AFD Software Limited v. DCML Limited [2016] EWCA Civ 425:** a copyright matter concerning “click wrap” licensing.

**BMW v Coley [2014] EWHC 3053 (IPEC):** declaration that certain activities infringed trade mark injunction.

**Phonographic Performance Ltd v Raine [2014] EWHC 1398(Ch):** stay of infringement proceedings pending reference to Copyright Tribunal.

**Henderson v All Around the World Records Ltd [2013] EWPC 7; [2013] EWPC 19:** rights in performances and costs in the Patents County Court.

**Orion Publishing Group Ltd v Novel Entertainment Ltd [2012] EWHC 1951 (Ch):** audit clauses in publishing agreements.

**R v Woolworths [2007] F.S.R. 19:** successful defence of retailer against trade mark prosecution.

**PPL v Reader [2005] F.S.R. 42:** availability and quantum of damages for infringement of sound recording copyright which was also a contempt of court.

**Bamgboye v Reid [2004] EMLR 61:** successful claim for copyright and performer's rights in rap composition and recording.

**Guild v Eskandar Ltd [2001] F.S.R. 38 (Rimer J); [2003] F.S.R. 3 (CA):** defence of claim for infringement copyright and design right in designer clothing field (succeeded on appeal).

**Thames & Hudson Ltd v Design and Artists Copyright Society Ltd [1995] F.S.R. 15:** relationship between criminal and civil remedies for copyright infringement.

## **Chancery/Commercial**

**Bone v North Essex Partnership NHS Trust [2016] EWCA Civ 45; [2016] IRLR 295:** trade union rights in the workplace.

**Mukerjee v Sen [2012] EWCA Civ 1895:** partnership accounts without a dissolution.

**National Westminster Bank plc v Kapoor [2012] 1 All ER 1201:** equitable assignments and IVAs.

**Hanchett Stamford v Attorney General [2009] Ch. 173** (unincorporated associations).

**Musawi v RE International (UK) Ltd [2008] 1 Lloyd's Rep. 326** (arbitration).

**Secretary of State for the Environment, Transport and the Regions v Baylis (Gloucester) Ltd (2000) 32 E.G. 92:** highways and standard conditions of sale.

## **Membership**

Chancery Bar Association

IP Bar Association

British Literary and Artistic Copyright Association

## **Qualifications and Regulations**

### **Qualifications**

Gwilym Harbottle read Modern History at Oxford before studying Law at City University, London. He was called to the Bar in 1987. He is an accredited mediator through ADR Chambers.

### **Regulation**

Gwilym is a self-employed, independent barrister whose practice is governed by the Code of Conduct of the Bar of England and Wales. He is registered with the Bar Standards Board of England and Wales (Bar Ref: 22468)

He has professional indemnity insurance provided by the Bar Mutual Indemnity Fund (BMIF Ref: 2190/020). Please refer to the BMIF website for full details of the world-wide cover provided, and the BMIF's contact details.

## **Publications**

### **Books**

[Copinger and Skone James on Copyright \(17th Edition, March 2016\)](#)

[Williams, Mortimer & Sunnucks' Executors, Administrators and Probate, 20th ed. \(2013\)](#)

## **Human Interest**

Gwilym's interests include literature, art, photography and walking.