

Jonathan Moss



Year called: 2009

Practice areas: Copyright & Design, Media & Entertainment, Trade Marks, IP, Patents, IT, Privacy

Email: jdavies@hogarthchambers.com

Nominated for IP Junior of the Year (Managing IP) – 2020, 2021 & 2022

Nominated for IP Junior of the Year (Chambers & Partners) – 2021

“Jonathan is exceptional on his feet. He is a confident and measured advocate and an incredibly quick thinker.” Legal 500 2022

He is particularly good in the IPEC: he is right on top of the procedure.” “He is an energetic and up-and-coming junior.” Chambers & Partners 2022

“A commercially pragmatic barrister who has the ability to think outside the box” Legal 500 2021

“He is our go-to person because he is particularly robust in his advice.” Chambers & Partners 2020

“He has a fiercely sharp mind which he wields expertly in court.” Chambers & Partners 2019

“He is very commercial and has an excellent depth of experience.” Chambers & Partners 2017

“He’s a brilliant junior. If you want a pleading done, you know he’ll do a tip-top job out of proportion to his level of call.” Chambers & Partners 2015

Profile

Prior to coming to the Bar, Jonathan gained joint honours in Chemistry and Law at the University of Bristol. He then undertook an LL.M (Distinction) at Georgetown University in Washington DC focusing on US Intellectual Property, Antitrust and Private International Law. During his studies Jonathan was awarded the highest overall mark in Law, as well as prizes for finishing first in Intellectual Property, Private International Law, Advanced Contract and Tort.

After successfully passing the New York Bar exam in 2007 he worked for 2 years as a US Attorney at the US firm Mayer Brown. Whilst there he worked in the Intellectual Property group and spent time seconded to Rentokil Initial PLC and Sega (Europe) Ltd. Whilst on secondment in-house he was exposed to a wide range of general commercial and intellectual property law matters.

Shortly after accepting tenancy at Hogarth, Jonathan spent 5 months with Powell Gilbert LLP where he worked on a number of cases, but primarily on the Apple v HTC smartphone litigation.

Due to his dual US/UK qualification, Jonathan has a significant cross-border practice in matters where there is an overlap between US and UK law. He also specialises in jurisdiction and conflict of laws matters relating to IP. Jonathan has acted as one of the barristers representing the claimants in the phone-hacking litigation against the News of the World and the Mirror Group.

In 2012 Jonathan was awarded the AIPPI UK prize for best young contributor for his work in relation to the harmonisation of design laws. In 2014 he was appointed to the AIPPI UK Council. He is a standing member of AIPPI International’s IP and the Internet Committee as well as the Amicus Committee.

In 2013 Jonathan acted as the UK Rapporteur to the International League on Competition Law, reporting on the crossover between Competition and IP laws.

In 2021 Jonathan was appointed as the most junior member of the Treasury A Panel to advise on IP and Commercial matters, having previously been on the B Panel (2019) and C Panel (2014). His most notable government case was appearing on behalf of the UK government in the CJEU in *Cofemel*.

During the London Olympics Jonathan was selected to advise LOCOG on Intellectual Property and Brand Management matters and was seconded in-house during the Games.

Directory & Testimonial Quotes

Legal 500 2022

Intellectual Property: *“Jonathan is exceptional on his feet. He is a confident and measured advocate and an incredibly quick thinker.”*

Chambers & Partners 2022

Intellectual Property: *“He is particularly good in the IPEC: he is right on top of the procedure.” “He is an energetic and up-and-coming junior.”*

Legal 500 2021

Intellectual Property: *“Very personable and well informed”*

Media and Entertainment: *“A commercially pragmatic barrister who has the ability to think outside the box”*

Chambers & Partners 2020

Intellectual Property: *“He engages well with the subject matter and is keen to look for commercial solutions: he has a good eye for where the heart of the case lies.”*

“He is our go-to person because he is particularly robust in his advice.”

Legal 500 2020

Intellectual Property: *“A thoughtful barrister, he is responsive and easy to work with.”*

Chambers & Partners 2019

Intellectual Property: *?“Exceptional on his feet.”*

“He has a fiercely sharp mind which he wields expertly in court.”

Chambers & Partners 2018

Intellectual Property: *“He is a confident and measured advocate, and an incredibly quick thinker.”*

Chambers & Partners 2017

Intellectual Property: *“He is always very helpful and pragmatic in the advice he gives.”*

“He is very commercial and has an excellent depth of experience.”

Chambers & Partners 2016

Intellectual Property: *“He has been enthusiastic and commercial in his advice, is clearly extremely bright and has strategic vision.”*

“A terrific advocate.”

Chambers & Partners 2015

Intellectual Property: *“He’s a brilliant junior. If you want a pleading done, you know he’ll do a tip-top job out of proportion to his level of call.”*

“Jonathan Moss has a broad practice which includes chancery and commercial contracts work in addition to IP. He is strongly recommended for his command of trade mark and design infringement matters.”

Career

Jonathan specialises in Intellectual Property but his practice encompasses broader aspects of Commercial Law, particularly those with a technical component such as large software disputes. His experience includes patent litigation (UK and EPO), trade marks, passing off, copyright, design right, confidential information,

defamation, privacy and general contractual. He has also been involved in a significant number of *ex parte* search orders and freezing injunctions.

Jonathan regularly appears in the High Court, in the Intellectual Property Enterprise Court, the Court of Appeal and the Trade Mark Registry. In commercial matters Jonathan has appeared in the Mercantile Court and in the Commercial Court. Jonathan has also appeared as sole advocate numerous times in the General Court and the Court of Justice. He is also one of the only advocates to have ever appeared in an oral hearing at the EUIPO.

Since 2016 Jonathan has taught design law at Oxford University on their Diploma in Intellectual Property Law. Previously Jonathan has been a guest lecturer at the University of Strasbourg where he taught UK patent litigation, and also at UCL and Kings College where he taught on their joint LL.M program in IP. He also lectures for CIPA on their Basic Litigation Skills Course and on their Patent Attorney Litigation Course.

Jonathan has been a contributing author to the following books: Law of Remedies (2019, edited by Franz Hoffman), Copinger and Skone James on Copyright (2016), Antitrust in Groceries Sector & Liability Issues in Relation to Corporate Social Responsibility (2015, edited Pierre Kobel) and The Trade Marks Handbook. He has contributed articles to the CIPA Journal and the Journal of Intellectual Property Law and Practice.

He is currently writing a book on Damages and Remedies in Intellectual Property Law.

Jonathan is regularly asked to give talks and seminars on a wide range of IP and international IP matters and has been invited to speak at various conferences throughout the UK as well as international conferences in Sydney, Nuremberg, Hamburg, Milan and Washington DC.

Cases

Notable reported cases that Jonathan has been involved in include the following. Numerous other cases settled on confidential terms.

Jurisdiction

AMS Neve Ltd v Heritage Audio S.L. & Anor. [2016] EWHC 2563 (IPEC), [2018] EWCA Civ 86, (C-172/18) – The leading decision of the Court of Justice on jurisdiction for online trade mark infringement relating to targeting of advertisements and offer to sale made on the internet.

AJA Registers Ltd v AJA Europe Ltd [2020] EWHC 883 – Jurisdiction challenge involving a stay under the Arbitration Act 1996 and the interaction with IP jurisdictional statutes.

Black and Decker v Dvize BV [2017] EWHC 3387 (Ch) – Jurisdiction case in relation to the court's jurisdiction for interim measures and EU trade mark infringement.

Horsham Nutraceuticals Ltd v Manna Pro Products LLC [2019] EWHC 1935 (Ch) – Jurisdiction dispute in relation to declarations of invalidity and counterclaims under the EU Trade Mark Regulation.

Poul Chang Metal Industry Co Ltd v Bailcast Ltd [2018] EWHC 3432 (Ch) – Application of Articles 29 and 30 of the Brussels Recast Regulation to a claim brought under the Community Designs Regulation.

Patents

Rockwool International v Knauf Insulation Limited [2020] EWHC 1068 – High Court appeal in relation to a patent revocation action in relation to mineral wool binders.

Icescape Ltd v Ice-World International BV [2017] EWHC 42 (Pat), [2018] EWCA Civ 2219 – Court of Appeal case involving the validity and infringement of a patent relating to mobile ice rinks. The case was also one of the first to consider the application of the doctrine of equivalents.

Warner-Lambert Co LLC v Generics (UK) Ltd (t/a Mylan) [2015] EWHC 2548 (Pat) – Patent infringement action in relation to the second medical use of the drug pregabalin.

Zircotec IP v TWI [2017] EWHC 1075 (Ch) – Appeal in relation to revoke for lack of novelty a patent relating to a method of coating articles that had a surface made of or containing organic material.

Wirth v Fridgeland – A patent infringement and threats action case with regard to refrigeration mechanisms.

Apple v HTC [2012] EWHC 1789 (Pat) – Patent trial involving four patents owned by Apple that relate to smartphones and touch screen technology.

Datacard v Eagle Technologies [2011] EWHC 244 (Pat) – Patent and trade mark case over the sale of third party printer ink cartridges.

Copyright and Designs

Crypto Open Patent Alliance v Wright [2021] EWHC 3440 – Acting for COPA in relation to worldwide declarations regarding Craig Wright's claims to be Satoshi Nakamoto, the pseudonymous creator of Bitcoin

Cofemel v G-Star Raw CV (C-683/17) – Appeared in the CJEU on behalf of the UK government in a reference from Portugal relating to the interaction between copyright and design protection.

PMS International Group PLC v Magmatic [2016] UKSC 12 – The landmark appeal case in the Supreme Court on Registered Community Designs. Case relates to the iconic ride on Trunki suitcase.

Neptune (Europe) Ltd v Devol Kitchens Ltd [2017] EWHC 2172 (Pat) – Registered and unregistered design right case relating to the design of bespoke kitchens.

Mei Fields Designs Ltd v Saffron Cards and Gifts Ltd [2018] EWHC 1332 (IPEC) – Copyright and breach of contract case relating to greetings cards.

Lucasfilm v Ainsworth [2011] UKSC 39 – The leading copyright case in the Supreme Court on whether or not a Star Wars Stormtrooper outfit was a sculpture. The case also decided that US copyright claims could be heard in the English courts.

Whitby Specialist Vehicles v Yorkshire Specialist Vehicles [2014] EWHC 4242 (Pat) – High Court decision dealing with Community registered and UK unregistered designs, as well as issues of malicious falsehood and threats.

Temple Island v New English Teas [2012] EWPC 1 – Copyright infringement in photographs of the well-known red London bus going over Westminster Bridge.

Trade Marks and Passing Off

DC Comics v Unilever Global IP [2022] EWHC 434 – Acted for DC Comics in a dispute over the Wonder Woman trade mark and goodwill.

Swatch v Apple [2021] EWHC 719 – Acted for Swatch in a case about whether parody could amount to bad faith registration of a trade mark.

Exoro v Under Armour Inc [2021] 1 WLUK 641 – Acted for Under Armour in relation to an appeal about the registration of a logo mark which was similar to the iconic Under Armour sign.

Hasbro v EUIPO T-663/19 – Acted for Hasbro in the leading General Court decision on bad faith and evergreening of trade marks relating to the well-known Monopoly board game trade mark.

Natural Instinct v Natures Menu [2020] EWHC 617 – Acted for the successful claimant in trade mark and passing off dispute in relation to dog food.

Timothy Langdell v (1) IPO (2) Government Legal Department (3) Geoffrey Hobbs QC (unreported) – Instructed by the three Defendants to defend them against a claim to overturn a decision of Geoffrey Hobbs QC sitting as an appointed person. Also instructed on a parallel judicial review claim brought by Mr Langdell against the same defendants.

Hasbro v Kreativni Dogadaji d.o.o. R 1849/2017-2, –

Caspian Pizza Ltd v. Shah & Anor. [2015] EWHC 3567 (IPEC), [2017] EWCA Civ 1874 – A trade mark, passing off and franchise dispute over the franchise known as ‘Caspian Pizza’.

Bhayani v Taylor Bracewell LLP [2016] EWHC 3360 (IPEC) – Breach of contract and passing off action in relation to the ability of a solicitor to own goodwill.

Apple Inc v Arcadia Trading Limited [2017] EWHC 440 (Ch) – A revocation action against Apple’s IWATCH trade mark.

Arsenal Football Club Plc v Reed [2014] EWHC 781 (Ch) – Contempt of court case in relation to breaches of a settlement agreement for trade mark infringement relating to the sale of football merchandise.

Fage UK Ltd v Chobani UK Ltd [2013] EWHC 630 (Ch) – Passing off case in relation to the use of the term ‘Greek Yoghurt’.

Healey Sports Cars Switzerland Ltd v Jensen Cars Ltd (BL 0/488/12) – Revocation of five trade marks for non-use in relation to the historic Jensen-Interceptor car brand.

Software and Breach of Contract

VDocs International v VST Enterprises – Breach of contract case in relation to the provision of software

licences and development.

Noel Starbuck v. Patsystems (UK) Ltd [2017] EWHC 397 (IPEC) – A case relating to issues regarding ownership and infringement of software for use in a financial trading system.

Credit Suisse AG v Aviation Aircraft & Equipment Leasing [2013] EWCA Civ 1169 – Dispute in relation to contractual mechanisms in an aircraft financing agreement and decision on the scope of pleadings in contract matters.

Breach of Confidence and Privacy

Mulsanne Insurance v Marshmallow Financial Services [2022] EWHC 276 – Acted for the defendant in wide ranging claims for breach of confidence and breach of contract in relation to a £40m claim relating to use of an insurance ratings engine.

Max Clifford v Mirror Group Newspapers – Acting as sole Counsel for Max Clifford in a phone-hacking case for misuse of private information and breach of confidence.

Yjbport Ltd v M&A Pharmachem Ltd [2018] EWHC 1654 (Ch) – Breach of confidence case relating to information about the treatment of dysphagia.

Breakthrough Funding Ltd v Nearby Media Ltd [2017] 4 WLUK 317 – Breach of contract, breach of confidence, passing off and trade mark infringement case over the rights to the UK Beer Pong Championship.

Steve Coogan v News Group Newspapers [2011] EWHC 349 (Ch) – Case on the scope of the privilege against self-incrimination as part of the phone-hacking saga involving News of the World. The Supreme Court upheld the first instance decision.

Ex Parte Orders and Procedural Matters

TBD (Owen Holland) v Obcon and others [2020] EWCA Civ 1182 – Acted for the successful defendant in the leading Court of Appeal case relating to the improper use of materials obtained under a search order.

Suh v Ryu [2012] EWPC 20 – The first successful soft IP ex parte freezing injunction in the Patents County Court.

Future Publishing Ltd v Edge Interactive Media Inc [2013] EWHC 339 (Ch) – Decision relating to the ability of the Court to amend a judgement and order after they are handed down under the court's inherent jurisdiction.

Many other cases in which Jonathan was involved settled on confidential terms before or during trial and he has also been involved in proceedings in the UKIPO and at the European Patent Office in Munich.

Membership

Intellectual Property Bar Association

Chancery Bar Association

Competition Law Association

New York State Bar Association

AIPPI

Qualifications and Regulations

Qualifications

BSC (Joint Honours, Chemistry and Law), 2006 Bristol University

LLM (Distinction), 2007 Georgetown University

Called to the Bar, Inner Temple, 2009

New York Bar, 2008

Regulations

Jonathan 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: 68592).

He has professional indemnity insurance provided by the Bar Mutual Indemnity Fund (BMIF Ref: 2190/057). Please refer to the BMIF website for full details of the world-wide cover provided, and the BMIF's contact details.

Human Interest

Jonathan regularly plays hockey and football and also enjoys skiing and squash. He is a competitive collectible card game player and has finished in the top 10 in both National and European championships. Having lived in Washington DC, he has a keen interest in US politics and history.