

Sam Carter



Year called: 2014

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

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Public Access: ia



‘Up & Coming’ – Chambers & Partners 2023 and ranked in Legal 500 2023

“Sam Carter is very pleasant to deal with. He is always very clear and well prepared, in addition to being responsive and able to pick things up quickly.” “Sam has been an exemplary counsel who goes over and above with his responsiveness, time, and dedication to the case. He is always thinking two steps ahead and has consistently outwitted his opponents.” Chambers & Partners 2023

Profile

Sam specialises in intellectual property law. He has experience in the full spectrum of IP rights, as well as in media and entertainment, IT, and privacy/confidentiality matters. He has a particular interest in the music industry, and a growing expertise in that area.

Sam regularly appears as both sole and junior counsel in the High Court, IPEC, UK IPO, and before the Appointed Person, and also has experience in the EU IPO and General Court.

Sam was a scholar of Harris Manchester College, Oxford, where he achieved a double 1st in Law. Before studying law, he gained joint honours in Physics and Philosophy at the University of Bristol. Following completion of the BPTC, Sam worked as a legal assistant at Powell Gilbert LLP, assisting on a variety of patent and other matters. Shortly after joining Hogarth, he spent 6 months on secondment to Dentons, primarily assisting with a patent case relating to control systems for automatic lawn mowers. This experience helps him to quickly grasp new concepts from diverse technical spheres, and to understand what solicitors and clients need from counsel and how best to achieve successful commercial outcomes.

Sam is a contributor to the CIPA Guide to the Patents Act, and to Copinger and Skone James on Copyright.

Sam can also accept public access instructions.

Directory & Testimonial Quotes

Chambers & Partners 2023

Intellectual Property: *“Sam Carter is very pleasant to deal with. He is always very clear and well prepared, in addition to being responsive and able to pick things up quickly.” “Sam has been an exemplary counsel who goes over and above with his responsiveness, time, and dedication to the case. He is always thinking two steps ahead and has consistently outwitted his opponents.”*

Cases

Copyright

Kieran Hebden v Domino Recording Company Limited [2022] EWHC 74 (IPEC) – Dispute concerning royalty payments for digital exploitation of music of the recording artist Four Tet, and reversion/re-assignment of copyright in master recordings. Settled on public terms.

Weiss Technik UK Limited & ors v SJJ System Services Limited & ors [2022] EWHC 2773 (Ch) – High Court copyright, database right, confidential information, breach of contract and conspiracy to cause loss by unlawful means dispute concerning software and large volumes of other information relating to the operation of environmental simulation chambers. Due to the large volume of infringing materials, elements of the claim proceeded by way of trial by samples. Sam acted as junior counsel for the successful Claimants.

Island Records & ors v Live From Abbey Road Limited (2020-2022) – CCMC in High Court copyright dispute relating to ownership of copyright in materials associated with the Live From Abbey Road tv program. Settled.

NCFE v TQUK (2020) – High Court STS dispute concerning alleged infringement of copyright in training qualification specifications. Settled.

Caroline Ukoumunne v University of Birmingham [2020] EWHC 184 (IPEC); [2020] EWHC 2927 (IPEC) – Successful strike out of claim for alleged infringement of copyright, breach of confidence, breach of contract relating to alleged plagiarism of doctoral thesis.

Vocal Star Limited v Phoenix Music Group Ltd (2019) – Copyright infringement dispute relating to karaoke CD album covers. Settled.

Duffy Archive Limited v VR Music Limited (2018-2019) – Copyright and trade mark dispute concerning the David Bowie lightning bolt used on the Aladdin Sane album cover.

First HDTV v Kartina World LLP (2018) – Copyright dispute relating to sale of television decoders.

Victor Lilley v Financial Times Limited [2017] EWHC 1916 (Ch) – Successful strike out of claim for alleged infringement of copyright in newspaper articles.

Victor Lilley v Euromoney Institutional Investor Plc [2017] EWHC 3593 (Ch) – Successful strike out of claim for alleged infringement of copyright in newspaper articles.

Trade marks and passing off

Nasdaq Inc v Finage Ltd & ors (2023-ongoing) – Trade mark and confidential information claim concerning alleged unauthorised redistribution of real-time data relating to the Nasdaq stock exchange.

Equisafety Ltd v Battle, Hayward & Bower Limited [2021] EWHC 3296 (IPEC) – Trade mark and passing off dispute concerning use of the MERCURY mark in relation to equestrian clothing and equipment. Account of profits pending.

Simon Millington v Wolf Designs Ltd (2021-2023) – Trade mark dispute concerning the use of the mark AXIS for automatic watch winders. Settled.

Housing Hand Ltd v Guarantid Ltd & ors (2022 – ongoing) – Trade mark dispute concerning use (by way of keyword advertising) of the mark HOUSING HAND for rent guarantor services.

IBSA Farmaceutici Italia Srl v Med-FX Ltd (2020) – Norwich Pharmacal application in the context of alleged parallel imports of dermal filler devices.

Urbanbubble Ltd v Urban Evolution Property Management Ltd [2022] EWHC 134 (IPEC) – Trade mark and passing off dispute between property management businesses. Sam acted at an early stage for the successful Defendants.

Geneva Laboratories Limited v Queens Cosmetics Limited (2020) – Trade mark dispute concerning allegedly counterfeit BIO-OIL.

Fit Kitchen Limited v Scratch Meals Limited [2020] EWHC 2069 (IPEC) – Trade mark and passing off dispute concerning FIT KITCHEN branded ready meals. Sam acted at an early stage for the successful Claimant.

Dreamboys London Limited v Bargain Travel Bureau Limited (2018-2019) – Trade mark and passing off dispute.

Camelot UK Lotteries Limited v Lottoland Limited (2018) – Trade mark dispute concerning use of the sign EUROMILLIONAIRE in relation to betting on the outcomes of lotteries.

F45 Training Pty Limited v Leo Star Limited (2018) – Franchise dispute including trade mark infringement issues. Settled.

Nicoventures Holdings Limited v The London Vape Company Ltd [2017] EWHC 3328 (Ch) – Appeal to the High Court against a decision of the UK IPO in a trade mark opposition relating to e-cigarettes.

NK Streamline Transport Limited v Wimborne Cars Limited (2017) – Passing off and confidential information dispute between taxi companies. Settled.

Numerous appearances in the UK IPO and before the Appointed Person – notable/recent examples include:

WELLS & CO (2023 – decision pending) – Resisting appeal to the Appointed Person against a decision dismissing an opposition against the mark WELLS & CO for a variety of goods and services.

EVEREST O/0107/23 – Successfully resisted appeal to the Appointed Person against a decision dismissing an opposition against the mark EVEREST for various foodstuffs.

BANDIT O/197/23 – Unsuccessfully resisted appeal to the Appointed Person against an opposition decision refusing registration of the mark BANDIT for safety helmets on bad faith grounds.

HEALTH SPACES O/0354/23 – Successfully resisted trade mark opposition against the mark HEALTH

SPACES for various real-estate related services.

MANGO SKIN O/095/22 – Successfully opposed registration of the mark MANGO SKIN for a variety of cosmetics and other goods.

GRINDSMITH O/863/21 – Partial success for the applicant in multiple consolidated trade mark oppositions and invalidity actions.

AVITA O/164/21 – Successfully resisted appeal to the Appointed Person in consolidated trade mark oppositions.

MISS WORLDCLASS O/672/21 – Successfully opposed registration of the mark MISS WORLDCLASS for various entertainment services on behalf of Miss World Ltd.

INOV-8 TERRAULTRA O/294/21 – Successfully opposed registration of the mark INOV-8 TERRAULTRA for trainers.

LUMIQS T-133/18– Successful appeal to the General Court against a decision of the EUIPO First Board of Appeal following trade mark opposition proceedings.

LITTLE KICKERSS O/826/18 – Successful invalidation of the figurative mark MINI KICKS for sports coaching services.

VIVO O/218/17 – Successful appeal to the Appointed Person on the subject of non-use in the context of trade mark opposition proceedings.

Patents

Digadoc Ltd v ATE (UK) Ltd (2023-ongoing) – Patent dispute relating to methods for attaching plant machinery to trailers.

Ratio Financial Ltd v Cellmas Ltd & ors [2021] EWHC 2777 (IPEC) – Successfully resisted strike out/summary judgment application in a patent, passing off and confidential information dispute concerning methods for producing construction blocks from recycled paper waste. Settled.

Stephens & ors v Mallows O/584/21 – Patent entitlement dispute in the UK IPO.

Mainetti (UK) Limited v Gifts 4 All Occasions Limited (2020) – Norwich Pharmacal application in the context of allegations of patent infringement relating to a children's car seat.

Clearswift Limited v Glasswall (IP) Limited [2018] EWHC 2442 (Pat) – Patent revocation action concerning virus checking software. Sam acted as junior counsel for the successful Defendant.

Positec Power Tools (Europe) Limited v Husqvarna AB (2016-2017) – Patent claim relating to a method for operating an electronic device (such as an automatic lawnmower) within an electronic demarcating system. Experiments were performed by both parties. Sam assisted as a secondee to solicitors for the Claimant. Settled.

Advised pre-action on various other patent matters.

Designs

Sterling Textiles Ltd v All Bedding Components Ltd & ors (2022) – UK registered and unregistered design right claim relating to bed headboard struts.

Taylor's Eye Witness Limited v KN Master Limited (2018) – Unregistered design right, copyright, trade mark and passing off dispute relating to kitchen knives. Settled.

Parisian (UK) Limited v Missi Limited (2017) – Unregistered design right dispute relating to the design of clothing. Settled.

Advised pre-action on various other registered and unregistered design right matters.

Confidential Information

Nasdaq Inc v Finage Ltd & ors (2023-ongoing) – Trade mark and confidential information claim concerning alleged unauthorised redistribution of real-time data relating to the Nasdaq stock exchange.

Weiss Technik UK Limited & ors v SJJ System Services Limited & ors [2022] EWHC 2773 (Ch) – High Court copyright, database right, confidential information, breach of contract and conspiracy to cause loss by unlawful means dispute concerning software and large volumes of other information relating to the operation of environmental simulation chambers. Due to the large volume of infringing materials, elements of the claim proceeded by way of trial by samples. Sam acted as junior counsel for the successful Claimants.

Choudhrie v Choudhrie [2019] EWHC 2066 (Ch) – Junior counsel in application to strike out claim for declaration in relation to extent of duties of confidence owed by wife on separation.

Media & Entertainment

Kieran Hebden v Domino Recording Company Limited [2022] EWHC 74 (IPEC) – Dispute concerning royalty payments for digital exploitation of music of the recording artist Four Tet, and reversion/re-assignment of copyright in master recordings. Settled on public terms.

Sky Italia SRL v Google Ireland Ltd (2021) – Norwich pharmacal application for disclosure of information needed to identify source of leak of an episode of the TV show Gomorrah.

Voltage Holdings LLC v Virgin Media Ltd (2021) – Norwich Pharmacal application for disclosure of IP addresses of illegal downloaders of the film Ava.

Island Records & ors v Live From Abbey Road Limited (2020-2022) – Junior counsel in High Court dispute relating to ownership of copyright in materials associated with the Live From Abbey Road TV program. Settled.

Vocal Star Limited v Phoenix Music Group Ltd (2019) – Copyright infringement dispute relating to karaoke CD album covers. Settled.

Duffy Archive Limited v VR Music Limited (2018-2019) – Copyright and trade mark dispute concerning the David Bowie lightning bolt used on the Aladdin Sane album cover. Settled.

Jessica Carroll v Eye Flight Films Limited (2017-2018) – Dispute relating to infringement of performance rights in a voiceover. Settled.

Advised pre-action on various other media and entertainment matters, including artist-manager disputes, digital royalty disputes, publication of confidential materials relating to high profile individuals, and artist resale rights.

Miscellaneous

Beauty Service Limited v eBay Europe SARL (2016-2018) – Dispute relating to eBay de-listing products on receipt of VeRO notifications. Sam acted for eBay. Settled.

Membership

IP Bar Association

Chancery Bar Association

AIPPI

IPSoc (the society for junior IP practitioners)

Qualifications and Regulations

Qualifications

BA Law, University of Oxford, 2013

BSc Physics and Philosophy, University of Bristol, 2010

BPTC, City Law School, 2014

Regulations

Sam 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: 62430)

He has professional indemnity insurance provided by the Bar Mutual Indemnity Fund (BMIF Ref: 2190/061). Please refer to the BMIF website for full details of the world-wide cover provided, and the BMIF's contact details.

Publications

CIPA Guide to the Patents Act (“the Black Book”), 8th ed. – Contributing editor (ss7-13)

Copinger & Skone James on Copyright. Contributing editor.

Product-by-process claims: clarification from the UK court in *Hospira v Genentech* E.I.P.R. 2015, 37(5), 314-320

Human Interest

Sam enjoys theatre and live music, and also runs a small record label.