

Simon Malynicz KC



Year called: 1997

Ireland: 2021

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

Email: dcourt@hogarthchambers.com

Called to the bar (1997) ENGLAND & WALES, and IRELAND (2021); Silk 2016



‘Leading Silk’ Ranked: Tier 1 – Legal 500 2023 and Chambers & Partners 2023

- **2022** – Winner of KC of the year (IP/media) – Legal 500 awards
- **2021** – Qualified for Bar of Ireland & Membership of the Law Library, Dublin.
- **2020** – Winner of KC of the year (IP/media) – Legal 500 awards
- **2020** – Winner of Senior Counsel of the year (IP) – Managing IP awards
- **2016** – Appointed King’s Counsel
- **2014-2016** – Appointed to A Panel of Attorney General’s Counsel
- **2014** – Winner (IP/IT) Junior of the Year – Chambers Bar Awards

“Simon is probably the best counsel in the UK for trade marks. In addition, he is fantastic with clients in conference, and his advocacy is direct and to the point. He is also able to move cases along to focus on the key points in issue.” Legal 500 2023

“Simon is an innovative and dynamic silk. He is an absolute fountain of knowledge on trade mark law, and is excellent on his feet.” Legal 500 2022

“He is tactically astute, collaborative and an encyclopedia of trade mark law.” Chambers & Partners 2022

“He is right at the top of the tree when it comes to brands. He does brilliant work and is tactically really good.” Chambers & Partners 2022

“He is the go-to for trade mark cases and he is also bright and affable.” Chambers & Partners 2022

“Simon Malynicz KC is one of the most highly regarded silks for contentious trade mark matters, including infringement claims and opposition proceedings. He is esteemed for his practical and tactically-minded counsel, and is experienced in CJEU and Court of Appeal cases.” Chambers & Partners 2022

Profile

Simon has an extensive IP practice, covering trade marks, passing off, copyright, IT/computer software, media/entertainment, collective/certification marks, PDOs and GIs, confidential information and designs. He also handles commercial cases with an intellectual property element. He appears regularly in the High Court, Court of Appeal, and General Court of the EU, as well appearing in or advising on proceedings before the UKIPO and EUIPO.

Please note that Simon is a fully qualified member of the Bar of Ireland and is a member of the Law Library in Dublin. Thus, with full rights of audience before the Courts of an EU Member State, he continues to:

- accept instructions to represent parties before the General Court of the European Union in trade mark appeals from the EUIPO, where he has acted in over 100 such proceedings.
- advise clients on EU law and disputes with a pan-EU element
- advise clients and draft documents in proceedings before the EUIPO

Directory & Testimonial Quotes

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Career

Appointed KC 2016, Called 1997, Inner Temple.

Appointed to A Panel of Attorney-General’s Panel of Counsel in March 2014 (previously on B Panel 2008-13).

Appointed to Attorney-General’s FOI Panel in 2010.

Cases

Trade marks

Sky v SkyKick – the leading case on the bad faith ground of invalidity – after a trial, a reference to the CJEU, several consequential hearings and two CA hearings, the case is now headed to the Supreme Court.

Montres Breguet v Samsung – the most recent word on “trade mark use” & the defences under the E-Commerce Directive in a trial on infringement arising out of Samsung’s smartwatch faces that resembles Swiss watch brands such as Omega, Longines and Tissot.

Halloumi – appeals before the General Court & CJEU on collective marks, certification marks and PDOs.

Nestle v Cadbury (Colour Purple) – the leading case on colour marks, acting for Nestle, invalidated Cadbury’s purple single-colour trade mark.

Cadbury v Nestle (Kit Kat shape) – CJEU and CA judgments on shape marks and acquired distinctive character

Interflora v Marks & Spencer – acted for Interflora in trade mark infringement trial before the High Court resulting in appeals to the CA on the admissibility of survey evidence and reference to the CJEU on the question of infringement on the internet by Google ads.

Intel v CPM – the leading CJEU case on trade mark dilution

L’Oreal v Bellure – acted for the UK government in the leading CJEU case on trade mark free-riding

Zee Entertainment v Zeebox – Court of Appeal case concerning surveys in passing off

Comic Enterprises v Fox (The Glee case) – High Court trial and Court of Appeal case concerning trade mark infringement arising out of the title of the US TV series

Specsavers v Asda – acted for UK government before the CJEU in a reference on the issue of use of a trade mark in a variant form

CIPA (IP Translator) – acted for the UK government in CJEU reference concerning the interpretation of the specification of goods and services, class headings and legal certainty

Budejovicky Budvar v Budweiser [2012] acting for Czech brewer before the Court of Appeal and in the reference to the CJEU that “invented” honest concurrent use” under the new Act.

Copyright

Kogan v Martin – the Court of Appeal applied EU originality approach to claims for joint authorship of the copyright in the script to the Meryl Streep/Hugh Grant movie *Florence Foster Jenkins*

SAS Software – CJEU case on copyright in software and documentation

Promusicae – CJEU case on copyright injunctions against file-sharing on the internet

Copydan – CJEU reference on private copying.

UPC Telekabel Wien – CJEU reference on injunctions against ISPs in copyright infringement cases.

Football Dataco v. Yahoo – CJEU reference on database right and authors own intellectual creation standard.

Football Association Premier League – copyright in football broadcasts, reference to the CJEU and appeal to Court of Appeal

NLA v. Meltwater – Copyright Tribunal and High Court proceedings concerning copyright infringement by online news aggregators. Acted in strike out proceedings.

Deakin v. Cardrax – two week trial before the PCC concerning copyright in greeting cards and joint tortfeasorship.

SGAE, AGEDI, LSG, all references to the ECJ concerning various copyright directives.

PPL v. Attorney-General – Francovich damages case against the government involving copyright exceptions and the Rental Rights Directive.

Patent

- *MMI v. CellXion* [2010-2012] – Two High Court trials and two Court of Appeal hearings re patent for mobile telephone interception equipment
- *Actavis* [2013] CJEU reference on SPCs
- *Unilever v SC Johnson* [2012] PCC trial on shower head technology
- *Universal Engraving v Falctontec* [2012] PCC case involving magnetic technology.
- EPO Case G3/08 (Patentability of computer software.) [2010] Acted for the UK.
- *Monsanto Technology* [2010] – reference to the CJEU on the Biotech Directive, acted for the UK.
- *AHP Manufacturing* [2009] a reference to the CJEU concerning supplementary protection certificates, acted for the UK.

Designs

- *Skruf Snus* [2015] appeal to the General Court from OHIM concerning RCD for a snuff box design
- *Kohler Mira v. Triton* [2010] Community registered design and UKUDR in bathroom products. Interlocutory hearings in Patents Court, with trial due in 2011.
- *Care Monitoring v. Burrell* [2009], a five day Community design right and UKUDR trial in the PCC concerning patient monitoring devices.
- *Fundacion Espanola para la Innovacion de la Artesania ('FEIA')* [2008] the first reference to the CJEU on the Community Designs Regulation, acted for UK.
- *Oakley v. Animal* [2006], Court of Appeal – case concerning the UK's implementation of the Designs Directive.

Information Technology

IT cases include *Artificial Solutions v. Creative Virtual* [2008] a five day trial before Arnold J and *Mass Information Systems v. RBS*, acting for RBS in a contractual dispute with an IT supplier.

FOI work includes acting for the Department of Work and Pensions in *DWP v. Collingbourne* [2010] a two day “trial” (hearing with cross-examination) before the First Tier (Information Rights) concerning trade secrets and the public interest.

Membership

IP Bar Association

CITMA

Bar Pro Bono Unit

Qualifications and Regulations

Sydney, Australia (BA); London (LLB); New School, New York (MA)

Publications

Simon is a co-author of *Gurry on Breach of Confidence*