



Virtuoso Legal

Intellectual Property Specialists

31 Harrogate Road
Leeds, LS7 3PD
England

Tel: +44 (0) 844 800 8871

Fax: (0) 844 800 8872

Web: www.virtuosolegal.com

“Intellectual Property lies at the centre of the modern company's economic success or failure”

Lester Thurow : Economist

Trade marks & Brands

Patents & Inventions

Copyright

Designs

Database rights

Data Protection

Licensing and Franchising

Intellectual Property agreements

New Media Agreements such as directors and authors rights

Transactional Intellectual Property

Principal: Elizabeth M Ward BSc (Hons)
Associate solicitor Kirsten Toff BSc (Hons)
Associate solicitor Deborah Niven LLB (Hons)
Practice Manager Elizabeth Lock BSc (Hons)

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'Name and Shame'

New Court remedy available in Intellectual Property disputes

by Virtuoso Legal
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The English Courts have until recently only had the traditional remedies open to them when resolving intellectual property disputes. These remedies are injunctions to prevent further product infringement, disclosure of this kind of activity, damages or an account of profit. For many Claimants this didn't provide the remedy they really required which was to be able to publish the names of the infringers in order to discourage others.

In the cases of Microsoft Corporation v Jabarkhail (Mohammed Aszal)[HC06C03868] in January 2007 and Microsoft Corporation v (1) Campbell (Robert J) t/a Software Pricebeater (2) R J Campbell Ltd [HC06C03867] in April 2007, Microsoft discovered that businesses were selling products that infringed their trade marks and copyrights. Microsoft obtained judgments in the High Court against the Defendants. In both cases a mandatory injunction order and penal notice was made.

The Intellectual Property Right (IPR) infringers were compelled to publicise in PC Retail Magazine (a monthly publication read by software resellers) that judgment had been entered against them for selling counterfeit and other products that infringed Microsoft's IP rights.

The adverts appeared in the May and June 2007 editions of PC Retail Magazine at the Defendants' expense.

In these two cases, Microsoft relied on art 15 of the Enforcement Directive which was implemented in the UK in England in 2006. The relevant rule can now be seen at paragraph 29.2 of the Practice Direction to Part 63 of the Civil Procedure Rules, which states:

'Where the Court finds that an intellectual property right has been infringed, the Court may, at the request of the applicant, order appropriate measures for the dissemination and publication of the judgment to be taken at the defendant's expense'

This new addition to the CPR effectively means that an IPR infringer may in some circumstances be obliged to 'name and shame' themselves at their own expense.

If an IPR holder wishes the court to grant this type of order, the following minimum requirements should be complied with:-

1.

Specify the publication in which it wishes the infringer to place the advert - usually a trade journal;

2.

Indicate the size of the advert it wishes to be placed; and

3.

Come to Court prepared with information about the cost of the advert, which should not be unreasonable given the circumstances (quantum, scale of dealings) in the case.

In cases where recoverable compensation is likely to be low, businesses can seek to use this remedy in litigation to make clear to the trade that they will not tolerate IP infringement and will take action when it does happen.