



One Firm WorldwideSM



EUROPEAN INTELLECTUAL PROPERTY PRACTICE

Successful businesses achieve competitive advantages through innovation. In this context, the creation and protection of intellectual property assets, which are often the main assets of a business, are vital to obtaining and keeping a strong position in the European market.

Although there is much harmonisation of intellectual property (IP) law throughout Europe, there remain areas of IP law that are not fully harmonised, and even harmonised provisions are often subject to local differences in interpretation. Moreover, the enforcement of intellectual property rights is still a matter for the individual European countries. As a result, IP laws in Europe may yield different outcomes in different countries.

The European IP Practice of Jones Day is particularly strong in litigation, and with more than 25 professionals in six different locations in five European countries, it is well placed to conduct litigation in the most commercially important venues, as well as to advise strategically on litigation, taking into account national nuances in the interpretation of the law. From pan-European border seizures to cross-border or national litigation proceedings, Jones Day can offer our clients the right tool when it comes to enforcing their IP rights in Europe.

Enforcement of intellectual property rights is possible only if the IP has been created effectively. On the prosecution side, Jones Day's European practice is well equipped to assist clients in the creation of the different kinds of IP. The practice has patent attorneys and other practitioners focused on many technical areas, and we benefit from close collaboration between the prosecution and enforcement teams.

FAST FACTS

- More than **25** intellectual property lawyers across **6** locations in **5** countries
- Combines patent attorneys and lawyers
- Full range of litigation and prosecution activities in the key jurisdictions of Germany, the United Kingdom and France
- Further includes practice members admitted in Spain and Italy

The practice provides European clients with an entry point into the Firm's worldwide network of more than 260 IP professionals, enabling European clients to protect their valuable IP assets around the world in the most efficient manner. They can also be assured of advice that takes into account the global nature of their operations. Our lawyers' knowledge and experience span the full range of activities involved in building up a portfolio of rights, commercialising and enforcing these rights and warding off attacks by third parties. Because the team includes both legal practitioners and patent and trademark attorneys, this combination of knowledge and experience is all housed within the Firm. Where necessary, the team also works closely with colleagues from our other practices, such as Antitrust & Competition Law, to ensure that our advice covers all the relevant issues. A special focus on industries like energy, environmental technology, pharmaceuticals, health care, life sciences and automotive helps us to understand better the needs in the respective markets.

The following is a detailed list of our most important services.

PATENTS AND UTILITY MODELS

- Litigation, in particular infringement and revocation proceedings, in the key European jurisdictions, and strategic co-ordination of Europe-wide disputes
- Alternative dispute resolution, e.g., mediation and arbitration
- Advice on settlement agreements, particularly to ensure compliance with antitrust regulations
- Filing and prosecution via the World Intellectual Property Organization (WIPO) and before the European Patent Office (EPO), the German Patent and Trademark Office (GPTO), the UK Intellectual Property Office (UKIPO) and the Dutch Patent Office
- Filing and prosecution of Supplementary Protection Certificates (SPCs) and paediatric extensions of SPCs before national patent offices
- Oppositions and opposition appeal proceedings (EPO, GPTO)
- Utility model cancellation proceedings (GPTO)
- Advising on national law relating to the rights of employee-inventors
- Freedom-to-operate opinions and clearance searches
- Trade show preparation
- Drafting and advising on licensing, collaboration, R&D and other transactional agreements covering technology, particularly in relation to competition law and its implications for compliance and enforceability
- Advising on standard-setting agreements and their anti-trust implications
- Strategic consulting and portfolio management
- Valuation
- Due diligence in the context of transactions
- Obtaining clearance from antitrust agencies for mergers and acquisitions involving the transfer of technology

TRADEMARKS AND RELATED RIGHTS

- Litigation in the key European jurisdictions
- Alternative dispute resolution, e.g., mediation and arbitration
- Filing and prosecution via WIPO and before the Office for Harmonization in the Internal Market (OHIM), the GPTO, the UKIPO, the French Institute for Industrial Property and the Italian Patent and Trademark Office
- Maintenance and enforcement of trademark rights, particularly opposition proceedings against colliding younger applications
- Advice on establishing and using geographical indications and designations of origin
- Cancellation proceedings
- Freedom-to-use opinions and clearance searches
- Trade show preparation
- Drafting and advising on licensing, merchandising, distribution and franchising agreements
- Strategic consulting and portfolio management
- Trade names

- Titles of literary and other works
- Business identifiers
- Valuation
- Due diligence in the context of transactions
- Obtaining clearance from antitrust agencies for mergers and acquisitions involving the transfer of trademarks and related rights
- Advising on parallel imports and trademark exhaustion

DESIGNS

- Filing and prosecution of registered design applications via WIPO and before OHIM, the GPTO and the UKIPO
- Litigation in the key European jurisdictions
- Alternative dispute resolution, e.g., mediation and arbitration
- Enforcement of unregistered European Union design rights and national design rights
- Invalidity proceedings at the national level and before OHIM
- Freedom-to-use opinions and clearance searches
- Trade show preparation
- Drafting and advising on licensing agreements
- Strategic consulting and portfolio management
- Valuation
- Due diligence in the context of transactions
- Obtaining clearance from antitrust agencies for mergers and acquisitions involving transfers of rights in designs

PLANT VARIETY RIGHTS

- Litigation
- Consulting and advice

COPYRIGHT AND RELATED RIGHTS

- Litigation in the key European jurisdictions
- Alternative dispute resolution, e.g., mediation and arbitration
- Software protection
- Database protection
- Drafting and advising on licence agreements
- Publishing agreements, including analysis of the performance of the publisher/author under the agreement
- Freedom-to-use opinions

- Due diligence in the context of transactions
- Obtaining clearance from antitrust agencies for mergers and acquisitions involving transfers of ownership of copy-right and related rights
- Internet monitoring

UNFAIR COMPETITION

- Litigation in the key European jurisdictions
- Alternative dispute resolution, e.g., mediation and arbitration
- Litigation and advice in relation to false claims in advertising
- Litigation and advice in relation to passing off
- Litigation and advice in relation to imitation
- Clearance opinions on marketing material and product packaging
- Advice in relation to comparative advertising

PROTECTION OF CONFIDENTIAL INFORMATION/KNOW-HOW

- Litigation in relation to know-how and trade secrets
- Drafting and advising on secrecy agreements, employment contracts and outsourcing contracts
- Strategic advice with regard to protecting confidential information

DOMAIN NAMES

- Registering domain names
- Countering cybersquatting as well as providing litigation services and advice relating to other forms of domain-name disputes
- UDRP and ADRP proceedings

COMBATING PIRACY

- Pan-European and national-border seizures
- Preliminary measures, including injunctions and seizures
- Strategic advice, particularly in relation to the identification of counterfeits, as well as action plans to combat piracy

PRODUCT REGULATION

- Regulatory approval procedures
- Advising on REACH compliance
- Advising on labelling requirements for regulated products (pharmaceuticals, medical devices, nutraceuticals, cosmetics, plant protection products, fertilisers, etc.)
- Advising on marketing restrictions relating to regulated products

DEFAMATORY PUBLICATIONS

- Countering and removal or takedown of defamatory publications, particularly on the internet

ADDITIONAL INFORMATION

For additional information regarding our European Intellectual Property Practice, please contact your principal Firm representative or one of the lawyers listed in this publication. General email messages may be sent using our “Contact Us” forms, which can be found at www.jonesday.com.

LAWYER CONTACTS

FRANKFURT

49.69.9726.3939

Dr. Dorothée Weber-Bruls
dweber@jonesday.com

MADRID

34.91.520.39.39

Marta Delgado Echevarría
mdelgado@jonesday.com

MUNICH

49.89.20.60.42.200

Dr. Martin Weber
mweber@jonesday.com

LONDON

44.20.7039.5959

Alastair McCulloch
amcculloch@jonesday.com

MILAN

39.02.7645.4001

Stefano Macchi di Cellere
smacchi@jonesday.com

PARIS

33.1.56.59.39.39

Emmanuel Baud
ebaud@jonesday.com

JONES DAY GLOBAL LOCATIONS

ATLANTA

BEIJING

BOSTON

BRUSSELS

CHICAGO

CLEVELAND

COLUMBUS

DALLAS

DUBAI

FRANKFURT

HONG KONG

HOUSTON

IRVINE

LONDON

LOS ANGELES

MADRID

MEXICO CITY

MILAN

MOSCOW

MUNICH

NEW DELHI

NEW YORK

PARIS

PITTSBURGH

RIYADH

SAN DIEGO

SAN FRANCISCO

SHANGHAI

SILICON VALLEY

SINGAPORE

SYDNEY

TAIPEI

TOKYO

WASHINGTON