

Intellectual Property

OVERVIEW

Robertsons regularly act in complex intellectual property cases in conjunction with our Litigation & Dispute Resolution Department, including instances of infringement of copyright, trademarks, registered and unregistered designs, the negotiation and settlement of “cease and desist” undertakings from parties undermining our clients’ rights as well as successful applications for interlocutory relief (often urgent applications) against infringers of those intellectual property rights.

Robertsons’ Intellectual Property Department advises its clients across a broad range of manufacturing and service industries in relation to their industrial and intellectual property needs.

For start-ups and new brands, we work with our clients and correspondent firms throughout the world in establishing strategies to sufficiently protect their trademarks in as cost- effective manner as possible.

We also advise on and assist clients with the registration of patents and designs, as well as establishing and protecting the copyright of their artistic works. In particular, we work with our corporate clients in ensuring that valuable intellectual property created in the course of their business are not subject to third party claims.

We have considerable experience representing manufacturers, head-licensees and distributors in a wide variety of licensing arrangements throughout the region, with particular emphasis on the intellectual property aspects of those arrangements.

We also work together with our Private Equity & Commercial Department to provide due diligence services on the intellectual property implications of acquisitions in such areas as the compliance of IT system licensing in target companies.

In conjunction with our Criminal and Commercial Crime Department, we act in more serious customs and excise cases involving infringing and counterfeit goods.

Our team also acts for clients in asserting and defending intellectual property rights including domain names and in Trade Mark opposition proceedings both in the territory and, in conjunction with our correspondent firms, throughout the world.

- I n t e l l e c t u a l P r o p e r t y C o n t e n t i o u s
- I n t e l l e c t u a l P r o p e r t y N o n - C o n t e n t i o u s

THE TEAM



Andrew Lee
Partner



Lesley Mclean
Partner



Frank Szeto
Partner



Fanny Chan
Partner



Michael Lintern-Smith
Consultant

EXPERIENCE

- Acted for a major distributor of beverage products in Hong Kong in a case brought by the Customs Department of the Hong Kong Government involving dutiable commodities. This case remains the leading case on the Hong Kong Bill of Rights. After this case, it became established law that, whilst the prosecution does not have to prove knowledge in a strict liability offence, it will be a defence for the accused to prove, on a balance of probabilities, that it had an honest and reasonable belief of compliance with the requisite legal requirements.
- Leading a team advising three major banks in Hong Kong on investigations by The Hong Kong Monetary Authority and the Securities and Futures Commission concerning the alleged mis-selling of Lehman Brothers related investment products.
- Leading a team to advise an Insurance Company (a joint venture between 5 renowned financial institutions) to proceed a claim against staff misappropriating funds belonging to the company, which includes the taking out of a mareva injunction order to freeze the assets of the Defendants, and the taking out of Norwich Pharmacal Discovery Orders to proceed with the tracing claim on the misappropriated funds.
- Leading a team to advise a Hong Kong main board listed company in the purchase of a renowned chain of regional coffee shops. Also advised the same company in the sale of the coffee shop chain to a PRC State Company.
- Advising a Hong Kong main board listed company on its joint venture with a western restaurants chain to become the biggest western restaurants chain in Hong Kong (with over 40 restaurants) after the joint venture.
- Advised a main board listed company in the sale of its shares by the major shareholder which led to the making of a general offer to shareholders under The Hong Kong Code on Takeovers and Mergers.
- Leading a team to advise a main board listed company in the acquisition of a company holding landed properties in the PRC which transaction was classified as a major acquisition of the company.
- Leading a team in representing issuers or their sponsors on their listing on the Main Board and Growth Enterprise Market of the Stock Exchange of Hong Kong Limited. Recent successful listings include: - Food Wise Holdings Limited (Stock Code: 1632), Anchorstone Holdings Limited (Stock Code: 1592) and Best Linking Group Holdings Limited (Stock Code: 8617).
- Advising clients in respect of trademark disputes including oppositions and cancellation applications.
- Representing a wide range of organizations, manufactures and retailers in respect of their worldwide trade mark portfolios including handing of trade mark filings.
- Advising clients in respect of co-existing with similar brands and negotiating co-existence agreements.

- ◆ Advising clients in respect of problematic applications including attending trade mark hearings.
- ◆ Handling commercial transactions for the exploitation of intellectual property rights through licensing, distribution and franchising agreements.
- ◆ Providing practical advice to clients to increase the value or performance of their IP portfolio.
- ◆ Bringing contempt of court proceedings against director of debtor company.
- ◆ Assisting in recovery of funds following email fraud and securing proprietary injunction.
- ◆ Stay of court proceedings where conflicting jurisdictions are involved.
- ◆ Assisting shareholders to obtain leave to bring statutory derivative action for remedies against prospective defendants on claims involving breach of fiduciary relationship.
- ◆ Successfully defending USD5million medical negligence claim on behalf of an international medical practice and obtaining Restrictive Applications Order and Restricted Proceedings Order, to restrict further related claims.
- ◆ Assisting client in the dissolution of a partnership and recovery of assets.
- ◆ Assisting administrators secure vacant possession of property and recovery of Estate assets against asserted claim of proprietary estoppel.
- ◆ Enforcement of mediation agreement and advising Executor on claims involving assets located in North America, Hong Kong, China and Singapore.
- ◆ Assisting client on claim for breach of fiduciary duty against a bank's failure to consider the appropriateness of the investments made in conflict with the bank's position vis-à-vis management fees.
- ◆ Assisting executive director on corporate insolvency proceedings asserted by liquidator in excess of USD1billion.
- ◆ Assisting client in setting aside judgment orders of USD44million in value and setting aside related prohibition orders.
- ◆ Acted for well-known Italian and French luxury fashion brands in various opposition, invalidation and revocation matters.
- ◆ Advised an American film production company on its brand protection and multi-jurisdictional disputes.
- ◆ Advised a well-known Swiss luxury watchmaker on its brand protection and acted in various opposition matters.
- ◆ Advised an international safety verification organization on the drafting of its certification regulations and securing certification mark protections.
- ◆ Advised on the protection and branding of non-traditional trade marks for a Japanese beverage company.
- ◆ Managed regional trade mark portfolios for international luxury brands and local jewellery brands.

- Managed an international trade mark portfolio for a well-known electronics/smartphone company and acted in various opposition matters.