
Philip Roberts KC

Barrister

Call 1996 Silk 2018



Scope of Practice

• Copyright • Database Rights • Design Rights (registered and unregistered) • Information Technology • Intellectual Property • Malicious falsehood / trade libel / comparative advertising • Passing Off • Patents • Registered Designs • Trade Marks • Judicial Review

Overview

Phil's practice encompasses all aspects of the law of intellectual property and information technology, with a particular specialism and expertise in the areas of crypto-currencies, e-commerce, internet domain names, artificial intelligence and the commercial exploitation of computer software.

He regularly acts and advises on the intellectual property and commercial aspects of IT disputes. Since 2008 he has been a member of the Experts Review Group of Nominet UK, a panel of senior independent domain name Experts reviewing DRS Decisions and sitting on appeals.

Examples of Recent Cases

Copyright

- **Honeycomb v Dunning**
Acting for the Claimant in a copyright infringement and breach of contract dispute concerning software for workflow management and quality control in the creative media industry.
- Advising an international commercial real estate group in relation to the jurisdictional aspects of claim(s) for infringement of copyright in thousands of photographs

- Advising a photographer in dispute involving copyright, contract and artist's resale right arising out of a photograph sitting by the late Queen Elizabeth II.
- **Football DataCo Ltd & ors v Stan James Plc / Sportradar GmbH / ors:**
Very long running case involving two trials, four appeals and a reference to the CJEU; split into two main parts: (1) Leading reported case on the standard of 'originality' required for copyright subsistence in a database; (2) Landmark reported case concerning database rights and joint tortfeasorship on the internet. First part ended after CJEU ruling, second part settled prior to the hearing of the appeal to the Supreme Court. Reported at [2010] RPC 17, [2011] RPC 9, [2013] FSR 2, [2013] FSR 3 and [2013] FSR 30.
- **Ultrasoft Technologies v Hubcreate Ltd:**
Trial of elaborate technical claims of copyright / database infringement in relation to SQL databases.
- **British Sky Broadcasting Group Plc & ors v Duarte & ors:**
Copyright claim entailing successful strike out of defence/counterclaim alleging serious breaches of competition law against BSkyB. Reported at [2014] FSR 32.
- **Technomed Ltd v Bluecrest Health Screening Ltd:**
Acted up to (but excluding) trial in a case involving copyright and database rights in electrocardiogram analysis algorithms.
- **Dar Al Arkan Real Estate Development Company & anr v Al Refai & ors:**
Successfully resisting the introduction of a copyright claim in a large multi-party commercial action (damages of over \$700m claimed).
- **3i Infotech (Western Europe) Ltd v Royal Bank of Scotland Plc & anr:**
Successful strike out of a complex tripartite copyright/confidentiality claim relating to multi-million pound financial software.
- **E-Testing Consultancy Limited -v- (1) David Rai (2) Jacqueline Denton (3) Tim Straton:**
Acting for the claimant in obtaining an injunction to prevent database right infringement, copyright infringement and removal of confidential information by current and former employees.
- **Charly Aquisitions Ltd -v- (1) Paul Smith (2) Smith & Co Sound and Vision and Same v (1) Warren Goldberg (2) Realman Limited (3) C/F International Inc:**
Acting for defendants in two related actions concerning the validity, under US law, of copyright licences relating to recordings of the Tom Jones Show.
- Acting for the claimant and advising in proceedings against ex-employees for copyright infringement and breach of contract and confidence.
- Acting for the Motion Picture Association of America in an infringement action concerning DVD decryption and copying software.
- Advising and acting for defendants and Part 20 defendants in relation to contractual warranties and indemnities concerning infringement of copyright owned by third parties.
- Advising and acting for software developers whose work has been appropriated and exploited by unauthorised third parties.
- Advising on the impact of The Duration of Copyright and Rights in Performances Regulations 1995 and The Copyright and Related Rights Regulations 1996 on the extent and duration of rights subsisting in old and unpublished copyright works.

- Acting for journalists, photographers and designers in copyright infringement actions against companies who have exploited their work without authorisation.
- Acting for multinational oil company in defence of a breach of confidence action brought in relation to smart card technology.

Database Rights

- **Genius Sports Ltd v Soft Construct (Malta) Ltd:**

Acting for two separate sets of Defendants in a long running and complex database rights infringement case concerning live sports data rights, with a counterclaim for breach of competition law. Several bespoke case management orders obtained:

- 'Massive over-disclosure' regime ordered: [2022] EWHC 2637 (Ch), October 2022 and [2022] EWHC 2903 (Ch), November 2022
- Successfully obtained costs capping order limiting Claimants' projected costs expenditure from £11m to £5m: [2022] EWHC 2308 (Ch), July 2022 and [2022] EWHC 2518 (Ch), September 2022
- Successfully resisted order for costs of strike out application [2022] Costs L.R. 825, May 2022; Alternative service v Hague Convention [2022] EWHC 1620 (Ch), May 2022
- Successfully resisted Claimants' application for joinder of five defendants in a non-participating representative capacity to the pre- and post-Brexit database rights infringement claim: [2021] EWHC 3200 (Ch), Dec 2021

- **Blue Power Group SARL v Eni Norge AS:**

Acting for defendant sued for \$225m in damages for breach of confidence and infringement of database rights relating to the claimants' CNG Tariff Model (a software tool for modelling, simulating, optimising and costing proposed marine gas transportation projects). Successfully applied to strike out the claims and recovered an interim payment on account of costs of £735.5k: [2019] 12 WLUK 74 (6 December 2019)

- **Football DataCo Ltd & ors v Stan James Plc / Sportradar GmbH / ors:**

Very long running case involving two trials, four appeals and a reference to the CJEU; split into two main parts: (1) Leading reported case on the standard of 'originality' required for copyright subsistence in a database; (2) Landmark reported case concerning database rights and joint tortfeasorship on the internet. First part ended after CJEU ruling, second part settled prior to the hearing of the appeal to the Supreme Court. Reported at [2010] RPC 17, [2011] RPC 9, [2013] FSR 2, [2013] FSR 3 and [2013] FSR 30.

- **Ultrasoft Technologies v Hubcreate Ltd:**

Trial of elaborate technical claims of copyright / database infringement in relation to SQL databases.

- **Technomed Ltd v Bluecrest Health Screening Ltd:**

Acted up to (but excluding) trial in a case involving copyright and database rights in electrocardiogram analysis algorithms.

- Acting for the Claimant Yell Limited in a series of database right infringement actions arising out of the unauthorised use and exploitation of Yell.co.uk and Yellow Pages directory data.
- Acting for the defendant in a case concerning alleged database rights in mobile telephone top-up PIN codes: One2One v Rok Communications.
- Acting for the defendant in an action concerning provision of race day data: BHB Enterprises Plc -v- Victor Chandler (International) Ltd.

IT and Telecommunications

- **The Edinburgh Woollen Mill Ltd & ors v PhoenixWales Ltd**

Acting for claimants in a dispute arising out of the appropriation of hundreds of domain names relating to high street retailers (e.g. Jaeger, Austin Reed, Peacocks, Viyella, Pondens, Jacques Vert) whose corporate group had entered administration. Pleaded causes of action: trade mark infringement, passing off, breach of

contract and fiduciary duties

- **Case T-252/13 Skysoft Computersysteme GmbH v OHIM EU:T:2014:163:**
Appeal to the General Court of the EU concerning the significance of the word 'soft' within a trade mark for computer software. The decision of the EUIPO to reject the mark Skysoft due to conflict with B SkyB's prior rights was upheld but the General Court additionally held that 'soft' was a non-distinctive connotation.
- **Ultrasoft Technologies v Hubcreate Ltd:**
Trial of elaborate technical claims of copyright / database infringement in relation to SQL databases and unauthorised access to a production server.
- **Sky Plc & ors v Skykick UK Ltd & ors:**
Trade mark infringement action in the field of cloud computing involving novel points of law. Successfully resisted a pre-trial reference to the CJEU (suggesting that the EU acted unlawfully in restricting the 'own name' defence to natural persons). Reported at [2017] E.T.M.R. 42 and [2018] F.S.R. 2. At trial in 2018 won on the issues of infringement and own name/honest practices; issues of validity stayed pending a preliminary reference to the CJEU of five key points of EU trade mark law (due to be heard in 2019). Reported: [2018] E.T.M.R. 23 and [2018] R.P.C. 5 (trial) and [2018] R.P.C. 12 (reference to CJEU). Opinion of Advocate General Tanchev delivered on 16 October 2019: ~~Case C-371/18 Sky and others EU:C:2019:864~~. Judgment of CJEU expected Spring/Summer 2020.
- **Skyscape Cloud Services Ltd v British Sky Broadcasting Group Plc & ors:**
- Trial of a wide-ranging declaration of non-infringement of B SkyB's key trade marks in the field of 'public sector' cloud computing. Reported [2017] FSR 6.
- **Football DataCo Ltd & ors v Stan James Plc / Sportradar GmbH / ors:**
Concerning the use of football data in online gaming. The case involving two trials, four appeals and a reference to the CJEU; split into two main parts: (1) Leading reported case on the standard of 'originality' required for copyright subsistence in a database; (2) Landmark reported case concerning database rights and joint tortfeasorship on the internet. First part ended after CJEU ruling, second part settled prior to the hearing of the appeal to the Supreme Court. Reported at [2010] RPC 17, [2011] RPC 9, [2013] FSR 2, [2013] FSR 3 and [2013] FSR 30.
- **3i Infotech (Western Europe) Ltd v Royal Bank of Scotland Plc & anr:**
Successful strike out of a complex tripartite copyright/confidentiality claim relating to multi-million pound financial software.
- **Jason Bennison v Nominet UK:**
Setting aside an injunction obtained ex parte against Nominet for suspension of an internet domain name on grounds of non-compliance with Section 12 of the Human Rights Act 1998, and striking out the underlying action.
- **Cartier v Nominet UK:**
Proceedings raising an important point of principle namely the alleged duty of an internet intermediary (domain name registry) to police online IP infringement; profound implications for the operation and regulation of the .UK domain.
- **Michael Toth v Emirates:**
Successful intervention in legally and jurisdictionally complex appeal upholding the autonomy of internet domain name ADR schemes. Reported at [2012] F.S.R. 26.

- **Primus Telecommunications Limited v British Telecommunications Plc:**
Acting for Primus in a dispute with BT in respect of billing for 0800 services under the Network Charge Control Standard Interconnect Agreement.
- **Zone Corporation Ltd v BT Plc:**
Acting for BT Plc in defence of a breach of contract action relating to toll-free telephone number services.
- Acting for an international business process outsourcer in actions concerning payment of state benefits by electronic transfer and provision of client relationship management systems.
- Acting for a company acting to prevent the removal of proprietary software and know-how by ex-employees, involving extensive use of evidence forensically recovered from computer servers and hard drives.
- Acting and advising in a number of contribution proceedings concerning the scope and effect of express and implied contractual intellectual property infringement warranties and indemnities.
- Advising a wide range of clients on contractual repudiation and termination issues relating to defective provision of IT development services.
- Advising e-commerce clients on regulatory compliance of existing Standard Terms and Conditions with e.g. Consumer Protection (Distance Selling Regulations) 2000, The Privacy and Electronic Communications (EC Directive) Regulations 2003 and Data Protection Act 1998.
- **Invisimail Technologies Ltd v RPK New Zealand Ltd [2003] EWHC 2828:**
Acting for the Claimant in a breach of contract action in the Patents Court concerning the assignment of patents relating to encryption technology:
- **MCI Worldcom International v Primus Telecommunications [2004] EWCA Civ 957; [2004] 2 All E.R. (Comm) 833 (Court of Appeal):**
Acting for the Defendant at the appeal of the summary judgment hearing concerning breaches of contract and misrepresentation following Worldcom's Chapter 11 bankruptcy.
- Acting for a major software company in litigation seeking to restrain the transmission of unsolicited spam email.
- Settling complaints for use in the World Intellectual Property Organisation ICANN domain name dispute resolution procedure.

Judicial Review

- **R v Secretary of State for Health ex p British American Tobacco & ors:**
Concerning the interaction between trade marks and public health. High profile public law proceedings challenging the validity of the UK's cigarette 'plain packaging' regulations. Reported at [2016] R.P.C. 22 (trial) and [2017] 3 W.L.R. 225 (Court of Appeal)

Patents

- **Unilin Beheer BV v Berry Floor NV [2004] F.S.R. 14 (PCC); [2004] EWCA (Civ) 1021; [2005] F.S.R. 6 (CA):**
Acting for B&Q plc, a co-defendant in a patent infringement action involving points of construction and priority, in the Patents County Court and subsequently in the Court of Appeal; and in hearing in 2006 concerning interaction between res judicata and the European Patent Convention.

- Acting for a US corporation in arbitration proceedings concerning trans-Atlantic patent and know-how licensing.
- Acting for Defendants in UK satellite proceedings relating to US patent infringement proceedings, resisting and varying an Order for disclosure and examination before an examiner in the UK.
- Acting for a defendant in a patent infringement action in the Patents County Court involving estoppels arising out of previous litigation on the same patent between related parties.

Trade Marks

- **Sky Plc & ors v Skykick UK Ltd & ors:**
Landmark trade mark infringement action, reaching both the CJEU and the UK Supreme Court. Acting for Sky, the Claimants, in a case concerning several key aspects of trade mark law infringement, defences and validity. Eight reported decisions so far.
June 2023: Hearing before the United Kingdom Supreme Court
July 2021: Successfully upheld the findings of infringement in the Court of Appeal and successfully overturned the partial finding of invalidity [2021] RPC 17
July 2020: successfully obtained pan-European trade mark injunction in the High Court [2020] RPC 17
Jan 2020: Judgment of the CJEU in Claimant's favour: [2020] RPC 4
April 2018: High Court reference to CJEU: [2018] RPC 12
Feb 2018: High Court trial Judgment dismissing the Defendants' own name Defence: [2018] RPC 5
- **Dr Craig Wright v Payward Inc:**
Acting for the defendant Kraken, one of the leading cryptocurrency exchanges, in a passing off claim valued by the claimants at "hundreds of billions of pounds". The Claimant Dr Wright claims that he is Satoshi Nakamoto (the 'inventor' of Bitcoin) and therefore owns the goodwill in the name Bitcoin.
- **Thom Browne Inc v Adidas AG:**
Acting for the Claimant, fashion house Thom Browne, against leading sportswear brand Adidas in a trade mark and passing off case concerning the validity of Adidas' 'three stripe' IP rights and whether they extend to the use of four horizontal stripes on clothing.
- **Blackfridge SC Ltd v Tether Operations Limited:**
Acting for the Tether, the company responsible for the USDT, EURT, CNHT and MXNT stablecoins (cryptocurrencies pegged to fiat currency) in a trade mark claim and counterclaim against an Isle of Man company which launched a GBPT stablecoin.
- **KID-SYSTEME GMBH v EUIPO (Case T-354/18):**
Acting for the intervener in an Appeal to the General Court of the EU against a decision of the EUIPO in the field of Wi-Fi and computer software, on eight separate wide-ranging grounds of appeal (intervener's entitlement to file opposition, obligation to state reasons, proof of use, suspension, misuse of powers, likelihood of confusion, right to a fair trial and oral hearings). Successfully resisted all eight grounds of appeal: [2019] E.T.M.R. 42. Appeal to CJEU (Case C-577/19 P) dismissed on 10 October 2019
- **London Taxi Corporation Ltd v Frazer-Nash Research Ltd & Ecotive Ltd:**
Leading authority on 'shape' trade marks and non-use revocation. Reported at [2016] FSR 7 (survey application) and [2016] FSR 20 (trial).
- **Thomas Pink Ltd v Victoria's Secret UK Ltd:**

Factually complex trial and appeal concerning the ambit and penumbra of trade mark monopolies. Reported at [2014] FSR 40.

- **Zee Entertainment Enterprises Ltd v Zeebox Ltd:**
Important points of practice relating to trade mark and passing off survey evidence. Reported at [2014] FSR 10 (ChD application) and on appeal to the Court of Appeal ([2014] FSR 26).
- **JW Spear & Sons Ltd v Zynga Inc:**
The first appeal considered the registrability of a non-standard trade marks (Scrabble tiles and "Cadbury's purple"). The second appeal followed a 14 day trial of a trade mark/passing off claim relating to mobile 'apps'. Reported at [2014] FSR 14 (first appeal) and [2015] FSR 19 (second appeal).
- **R v Secretary of State for Health ex p British American Tobacco & ors:**
Concerning the interaction between trade marks and public health. High profile public law proceedings challenging the validity of the UK's cigarette 'plain packaging' regulations. Reported at [2016] R.P.C. 22 (trial) and [2017] 3 W.L.R. 225 (Court of Appeal)
- **Skyscape Cloud Services Ltd v British Sky Broadcasting Group Plc & ors:**
Trial of a wide-ranging declaration of non-infringement of BSkyB's key trade marks in the field of 'public sector' cloud computing. Reported [2017] FSR 6.
- **Turner Broadcasting Systems Europe Ltd v Boomerang TV SA:**
Resisting a declaration for TM non-infringement brought by substantial US cable TV network 'Boomerang' against a Spanish prior user.
- **Marussia Communications Ireland Ltd v Manor Grand Prix Racing Ltd & anr:**
Successfully obtained £1.75m security [2016] RPC 20 in a summary judgment application for trade mark infringement in relation to chassis and team names in Formula 1 racing.
- **Case T-252/13 Skysoft Computersysteme GmbH v OHIM EU:T:2014:163:**
Appeal in the General Court of the EU, upholding the EUIPO decision to reject the mark Skysoft due to conflict with BSkyB's prior rights.
- **Nvidia Corp v Hardware Labs Performance Systems Inc:**
Action for a declaration of non-infringement in relation to Graphical Processing Units. Strike out application reported at [2017] Bus. L.R. 549; [2017] F.S.R. 28. Acting for the estates of two different famous writers to prevent unauthorised exploitation of their names and works.
- **Camden Lock Market trade mark:**
Assisting Camden Market in overcoming geographical objections to the registration of its trade marks on the UK Register.
- **Ancco, Inc. v Holzer y CIA, S.A. de C.V.:**
Successful EUIPO invalidation of the trade mark ANN TAYLOR obtained by Holzer on grounds of bad faith.
- **US Polo Association v MGNL:**
Preparing and settling interim application to prevent alleged parallel imported and counterfeit branded goods.
- **RE: Pixdene Limited:**
Assisting a family company in seeking to establish and obtain recognition of its historic entitlement to a share of worldwide merchandising revenue derived from the exploitation of the Wombles and Paddington Bear.
- **Cartier v Nominet:**

Proceedings raising an important point of principle: the alleged duty of an internet intermediary (domain name registry) to police online IP infringement; profound implications for the operation and regulation of the .UK domain.

- **Sensormatic Electronics LLC v Anglo Design Holdings Plc:**
Successful hearing and appeal determining three consolidated trade mark oppositions in the field of electronic video security.
- **Acamar Films Ltd v Microsoft Corporation:**
Claim for an injunction and over £10m damages against Microsoft for alleged infringement of the trade mark 'BING'. The trial, which settled part-heard, involved complex arguments relating to the abusive registration and enforcement of trade mark rights.
- **Music Choice Limited -v- Target Brands Inc. [2006] R.P.C. 13:**
Acting for Music Choice in an application to the Trade Marks Registry and subsequent High Court appeal concerning the construction of the newly amended Trade Mark Rules.
- **(1) Partygaming Plc (2) Electraworks Limited (3) Iglobalmedia Marketing UK Limited -v- (1) Eli Dabosh (2) Caviner Limited (3) JD Lucky Skill Limited [2005] EWHC 3090:**
Acting for PartyGaming Plc and its associated companies in an expedited application for interim relief to restrain parties in and outside the UK jurisdiction from deceptive provision of online gaming services.
- **Alliance Française de Londres Limited v Her Majesty's Attorney General [2005] EWHC 3049:**
Acting for Nominet UK, resisting an interim injunction concerning the preservation of a domain name pending the conclusion of a vesting action.
- **Criminal Clothing Limited v. Aytan's Manufacturing (UK) Limited [2005] EWHC 1303:**
Acting for Criminal Clothing in their Trade Mark Registry and subsequent High Court Appeal concerning the CRIMINAL and CRIMINAL DAMAGE trade marks and in ongoing parallel appeal proceedings before the Court of First Instance of the European Communities.
- **Inter Lotto (UK) Ltd v. Camelot Group Plc [2003] EWCA Civ 1132; [2004] 1 WLR 95 (CA); and [2003] EWHC 1256; [2003] 3 All ER 191 (High Court):**
Acting for the claimants at the trial of a preliminary issue relating to the interaction between registered trade mark rights and passing off rights.
- **H Young (Operations) Ltd v. Medici Ltd [2003] EWHC 1589; [2004] FSR 19 (High Court):**
Acting for the claimant at the trial of a trade mark infringement action concerning the correct approach to partial revocation for non-use.
- **Coca-Cola Co v. Aytacli (Contempt: Committal) [2003] EWHC 91; [2003] 26(3) IPD 26016; and in a second action concerning the liability of further defendants raising defences of abuse of process: Coca-Cola Co v. Ketteridge [2003] EWHC 2488; [2004] FSR 29:**
Acting for the claimant at the trial of trade mark infringement and passing off proceedings in relation to a counterfeiting ring, and proceedings resulting in the subsequent committal to prison of one of the defendants for breach of disclosure orders.
- **Wolters Kluwer (UK) Ltd (trading as CCH) - v - Reed Elsevier (UK) Ltd (trading as LEXISNEXIS Butterworths) [2005] EWHC 2053 (Ch):**
Acting for Reed Elsevier, resisting an interim injunction concerning comparative advertising in the field of online seminars for tax professionals.

Commercial Litigation

- Advising a major UK brand in a dispute concerning the interpretation of a settlement agreement (2023)
- **Dar Al Arkan Real Estate Development Company & anr v Al Refai & ors:**
Successfully resisting the introduction of a copyright claim in a large multi-party Commercial Court action (damages of over \$700m claimed).
- Advising and acting in disputes concerning the scope and effect of Letters of Request under the Hague Evidence Convention and the Evidence (Proceedings in Other Jurisdictions) Act 1975

Media and Broadcasting

- Acting for the suppliers of an online media player in a contractual dispute with a major publishing group concerning royalty calculations and the treatment of invalid traffic
- **Zee Entertainment Enterprises Ltd v Zeebox Ltd:**
Action by an Indian TV broadcaster against a UK mobile 'app' developer. Important points of practice relating to trade mark and passing off survey evidence. Reported at [2014] FSR 10 (ChD application) and on appeal to the Court of Appeal ([2014] FSR 26).
- **Sky Plc & ors v Skykick UK Ltd & ors:**
Acting for broadcaster Sky in a trade mark infringement action in the field of cloud computing involving novel points of law. Successfully resisted a pre-trial reference to the CJEU (suggesting that the EU acted unlawfully in restricting the 'own name' defence to natural persons). Reported at [2017] E.T.M.R. 42 and [2018] F.S.R. 2. At trial in 2018 won on the issues of infringement and own name/honest practices; issues of validity stayed pending a preliminary reference to the CJEU of five key points of EU trade mark law (due to be heard in 2019). Reported: [2018] E.T.M.R. 23 and [2018] R.P.C. 5 (trial) and [2018] R.P.C. 12 (reference to CJEU). Opinion of Advocate General Tanchev delivered on 16 October 2019: [Case C-371/18 Sky and others EU:C:2019:864](#). Judgment of CJEU expected Spring/Summer 2020.
- **British Sky Broadcasting Group Plc & ors v Duarte & ors:**
Acting for broadcaster Sky in the successful strike out of defence/counterclaim alleging serious breaches of competition law against BSKYB. Reported at [2014] FSR 32.
- **Skyscape Cloud Services Ltd v British Sky Broadcasting Group Plc & ors:**
Acting for broadcaster Sky in the trial of a wide-ranging declaration of non-infringement of its key trade marks in the field of 'public sector' cloud computing. Reported [2017] FSR 6.
- **Football DataCo Ltd & ors v Stan James Plc / Sportradar GmbH / ors:**
Acting for a media organisation and online gaming sites in a very long running case involving two trials, four appeals and a reference to the CJEU; split into two main parts: (1) Leading reported case on the standard of 'originality' required for copyright subsistence in a database; (2) Landmark reported case concerning database rights and joint tortfeasorship on the internet. First part ended after CJEU ruling, second part settled prior to the hearing of the appeal to the Supreme Court. Reported at [2010] RPC 17, [2011] RPC 9, [2013] FSR 2, [2013] FSR 3 and [2013] FSR 30.
- **Turner Broadcasting Systems Europe Ltd v Boomerang TV SA:**
Resisting a declaration for TM non-infringement brought by substantial US cable TV network 'Boomerang' against a Spanish prior user.

- Acting for the estates of two different famous writers to prevent unauthorised exploitation of their names and works.
- Settling complaints for submission to the Advertising Standards Authority in cases involving comparative advertising and misleading technical claims.
- Advising a major record label on construction and enforcement of recording agreements with significant recording artist.

Interim Remedies

- **US Polo Association v MGNL:**
Preparing and settling interim application to prevent alleged parallel imported and counterfeit branded goods.
- **Jason Bennison v Nominet UK:**
Setting aside an injunction obtained ex parte against Nominet for suspension of an internet domain name on grounds of non-compliance with Section 12 of the Human Rights Act 1998, and striking out the underlying action.
- Advising and acting for Carphone Warehouse in obtaining interim undertakings arising out of the use of its trade mark by a compensation firm
- Obtaining and resisting Anton Pillar search orders, Mareva freezing injunctions, Norwich Pharmacal orders and other High Court interim relief.

What the Directories Say

"Philip is an outstanding advocate who is easy to work with and very good with clients. He knows the commercial context and what the client is trying to get out of the litigation." (Chambers and Partners 2025, Information Technology)

"Phil is an excellent technical lawyer who also understands commercial aims and thinks around problems. His advice is clear and he is always very responsive to the client's timeframe." (Chambers and Partners 2025, Information Technology)

"Phil is a dream to work with. Incredibly strategic, he's someone who sees things before they happen. He is amazing on his feet, and his submissions always hit the mark." (Chambers and Partners 2025, Information Technology)

'Phil is a superb advocate and one of the top KCs. He is simply outstanding in court.' (Legal 500, 2025 IT and Telecoms)

"Philip is perspicacious, sensible and principled. He is always a joy to work with." "Philip is an excellent strategist, extremely effective and persuasive advocate. Our go-to silk for IP disputes." "Phil is an absolute pleasure and dream to work with. He is incredibly strategic and sees things before they happen." "Philip is one of the leading trade mark silks. He adds real value to cases and is very good on his feet." (Chambers and Partners 2025, Intellectual Property)

'Philip is wonderfully perspicacious, principled and sensible. He is a truly trusted advocate with a rare ability to distil complex situations into digestible points, and he is impeccable on his feet.' (Legal 500, 2025 Intellectual Property)

"Philip Roberts KC is on the top of his game as a contentious trade mark barrister. He has a deep knowledge of EU law and has vast experience. He is able to deploy both in a way that allows him give incisive analysis and make good predictions of the outcome. He has a reliable judgment. His written work is articulate, well drafted, insightful and considered."

(Chambers and Partners 2024, Intellectual Property)

"Philip is fantastic for a number of reasons. He is brilliant to work with, incredibly bright and very good at breaking things down for clients to understand. He is very commercial, sees the bigger picture, and his strategy comes from a global holistic view of the cases and issues in mind. He is so approachable and easy to work with." **(Chambers and Partners 2024, Intellectual Property)**

'Phil is an outstanding advocate. Excellent with clients and superb in court. He has an amazing brain and is a top choice for complex disputes.' **(Legal 500, 2024 IT and Telecoms)**

'Philip is an outstanding advocate and certainly one of the top trade mark silks. He is deeply knowledgeable of the law and brilliant in court.' **(Legal 500, 2024 Intellectual Property)**

'Considered and clear advice. Highly impressive advocacy.' **(Legal 500, 2023 Intellectual Property)**

'Considered and clear advice. Highly impressive advocacy.' **(Legal 500, 2023 IT and Telecoms)**

"Philip Roberts KC is a super big-brained and very hard-working advocate." "Philip Roberts understands complex information well. He is fantastic at reading the room and knowing when to push and when to take a step back." **(Chambers and Partners 2023, Intellectual Property)**

"He is always brilliant and sees matters with broader commercial perspective." "A really impressive tactician." "An excellent barrister who understands clients and their needs." **(Chambers and Partners 2020, Intellectual Property)**

"He is very unflappable, deeply knowledgeable of the law and very composed in court." **(Legal 500, 2020 Intellectual Property)**

"He is very good at highly technical work." "Highly recommended in IT and IP-related matters." **(Chambers and Partners 2019, Intellectual Property)**

'An excellent advocate and one of the top trade mark silks, with experience in advising on online infringement issues.' **(Legal 500, 2018 Intellectual Property)**

'He has a fantastic understanding of the digital world, is extremely bright, and comes up with good strategic and commercial advice.' **(IT and Telecoms, Legal 500 2017)**

"He is calm and unflappable under pressure. He has got a phenomenal knowledge of trade mark law and is absolutely fantastic at distilling complicated issues into clear and commercially focused advice." **(Chambers and Partners 2018, New IP Silks)**

"He is technically fantastic and gives spot-on advice." "He is very bright, good on his feet and easy to work with. Clients like his knowledge of IP law and technology." **(Chambers and Partners 2017)**

'He is an excellent and very responsive advocate.' **(IT and Telecoms, Legal 500 2017)**

'An excellent advocate, who is great to work with.' **(Intellectual Property, Legal 500 2017)**

'has a particular focus on rights infringement on the internet and in digital media. He has appeared in many of the most prominent of these copyright and trade mark cases in recent years. "Excellent junior with invaluable experience and knowledge gained from representing leading internet-based companies." "Has a very fast mind and is very good on his feet." (Chambers & Partners 2016, Intellectual Property)

'An accomplished courtroom advocate with sound strategic judgement.' (Legal 500 2015, Intellectual Property)

'An accomplished courtroom advocate.' (Legal 500 2015, IT and Telecoms)

Noted for knowing trade mark law "inside out," he is also well regarded for his work on copyright matters, and for handling cases with a software or internet element. Sources appreciate his ability to relate highly technical issues lucidly. "Very user-friendly, hard-working and someone with good instincts." (Chambers & Partners 2015, Intellectual Property)

Awards



Contact Clerks



Jackie Ginty

First Deputy Senior Clerk

+44 (0)20 7520 4608

jginty@oeclaw.co.uk



Adam Wheeler

Clerk Team Leader

+44 (0)20 7520 4616

awheeler@oeclaw.co.uk

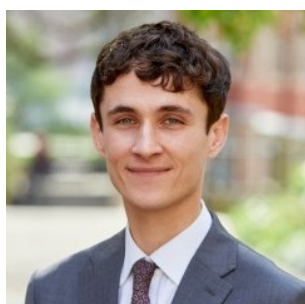


Jordan Foley

Team Leader's Assistant

+44 (0) 20 7520 4613

jfoley@oeclaw.co.uk



Max Tonkinson

Clerk

+44 (0)20 7520 4695

mtonkinson@oeclaw.co.uk