

Joel Smith

Partner
London

Biography

Joel works with clients to protect, commercialize and enforce rights in innovation, whether through their brands, creative works or technology. He focuses his practice upon IP litigation and also IP in the context of global transactions and commercial IP arrangements, with over 25 years of experience across both contentious and non-contentious IP, including heavyweight trial, deal and counselling roles.

As a seasoned IP litigator, he has acted in IP disputes in the IPEC, High Court, Court of Appeal and Privy Council, particularly concerning trade marks, GIs, copyright, designs, database rights, trade secrets and confidential information. He advises clients strategically, with a view to achieving a mutually satisfactory commercial resolution, often without the need for litigation. He focuses upon key industry sectors, particularly FMCG, media, technology, life sciences, agribusiness, financial services, automotive and energy. He also advises upon advertising and allied regulatory issues.

Joel is a leader upon M&A transactions, projects and other major commercial IP arrangements in which IP plays a pivotal role, particularly complex collaborations, research partnerships, licensing and technology transfer. He has significant experience in agri and plant biotech involving plant breeders' rights, patents, royalty-collection schemes and GMOs.

Joel joins from heading the UK IP team in another global law firm, with experience spent in Hong Kong, Milan and Sydney.



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Practices

Trademarks and Brands

Copyright

Designs

Digital Assets and Blockchain

Trade Secrets and Confidential
Know-how

IP Litigation, Arbitration, and
Alternative Dispute Resolution

Marketing and Advertising

IP and Technology Transactions

Communications, Internet, and
Media

Industries

Consumer

Described by *World Trademark Law Review* as "an IP expert at the top his game," *Chambers* recognizes him as a "thoughtful and strategic litigator," while *Legal 500* says he has "an encyclopaedic knowledge of IP and whilst ruthless in litigation matters, is extremely calm, considered and reassuring."

Representative experience

Advising global auto business on proposed EV battery plant in EMEA, including complex technology licensing and development arrangements.

Acting for Edrington and The Macallan over a music collaboration to promote a product.

Acting for tech provider in the aircraft industry over alleged misuse of trade secrets by competitor.

Acting for News UK in a complaint to the Company Names Tribunal over an opportunistic registration of a company name infringing News UK's trade marks.

Acting for Treasury Wine Estates over a enforcement policy for the metaverse and development of NFTs.

Acting for Auroboros, a leading digital fashion house, over a copyright dispute over garments made available by a competitor.

Acting for Limagrain (agribusiness) upon the first appeal to the Tribunal under the statutory scheme under The Plant Variety Rights Act 1997, the first appeal for over 30 years.

Advising KBR upon its \$100m investment and collaboration with Mura, focused upon proprietary, differentiated plastics recycling solutions, including licensing its patented processes.

Acting for the British Society of Plant Breeders over the last 25 years, including a collaboration agreement over crop trials and the development of recommended seed lists.

Acting for Intuit in a cross-border dispute with Expensify, involving defending a claim by Expensify in the UK High Court for passing-off over use of the

Technology and Telecoms

Life Sciences and Health Care

Financial Institutions

Automotive and Mobility

Manufacturing and Industrials

Energy and Natural Resources

Sports, Media and Entertainment

Education and admissions

Education

Conversion Law Course, University of Sydney, 2015

Diploma in Advocacy, Nottingham University, 2000

Diploma in Intellectual Property Law, University of Bristol, 1997

L.P.C., College of Law, Guildford, 1994

B.A./M.A., Gonville & Caius College, Cambridge, 1993

Memberships

Freeman of City of London
Solicitors' Company

Bar admissions and qualifications

Solicitor, England and Wales

Solicitor Advocate, England and Wales

Solicitor, Australia (New South Wales)

"QuickBooks" name.

Acting for Frazer-Nash in trademark infringement and passing off proceedings in the High Court over the shape of the London taxi cab with Geely (London Taxi Company).

Acting for BAT in its strategic R&D collaboration with Organigram, a leading Canadian cannabis licensed producer, to develop next-generation adult cannabis products.

Advising Scott Rudin on the rights from Harper Lee's Estate to "To Kill A Mockingbird" for competing UK/Ireland theatre productions opening in breach of copyright exclusivity.

Acting for The Financial Times in a brand-licensing transaction over partnering with Wilshire to launch a new set of FT-branded indices, metrics, and analytics for investors.

Acting for Itochu on the acquisition of the Paul Smith brand in Japan, including negotiating design access and manufacturing arrangements.

Acting for Sky in complex claim against DSWC over misuse of customer data involving trial in High Court, including search orders, interim injunctions, and freezing injunctions.

Acting for Zeebox on resolving its global dispute with Zee TV over the name of this second screen app and trademark proceedings in the UK, U.S., Australia, and 15 other jurisdictions.

Acting for Genesiscare in a unique collaboration deal with the University of Oxford over cancer treatment and research, with the first MRI Linac scanner installed in the UK.

Awards and rankings

- Gold ranked for the UK and cited for Litigation and transactions, *World Trademark Review 1000, 2023*
- IAM Patent 1000, *IAM, 2023*
- IP Star - Trade Marks, *Managing Intellectual Property*

IP Stars, 2023

- Leading Practitioner - IP, *Legal 500, 2023*
- Ranked – Band 2, *Chambers UK and Chambers Global, 2023*
- IAM Global Leader, *IAM, 2023*
- Recognised Litigation and Transactions, *WTR, 2023*

Latest thinking and events

- News
 - Managing copyright risk in the music industry
- News
 - UK: Online marketplace sales - Umbro's famous 'double diamond' marks not infringed by Dream Pairs' logo on football boots
- Insights and Analysis
 - Copyright and AI: a key moment for rightsholders
- News
 - 'Bottled it': Aldi light-up gin bottle design infringes Marks & Spencer's UK registered design
- News
 - Consumer NFT Guide
- News
 - Lidl v Tesco: UK supermarkets clash over bad faith