

Collaborating  
and working  
with our clients

# About Mathys & Squire

Consistently ranked Tier 1 in *The Legal 500*, Mathys & Squire is one of Europe's most highly regarded intellectual property law firms. Founded in 1910, we have over 100 years of experience in the protection and commercialisation of intellectual property rights, leading the field with insight, innovation and quality.

The firm has more than 60 qualified attorneys, and offices in London, Birmingham, Brighton, Cambridge, Luxembourg, Manchester, Munich, Oxford, Paris and York, as well as a team based in China. We are a full service intellectual property firm with specialists in a wide range of technical fields. Our attorneys and trainees have a mix of scientific degrees extending from chemistry, biochemistry, pharmacology, genetics, microbiology, plant sciences and zoology through to physics, electronics, telecommunications and engineering.

Most of our attorneys hold further degrees and many have PhDs. Some of the team have worked in-house within the IP departments of large international organisations, and by utilising this experience, this enhances our ability to assist in the strategic and active management of IP portfolios.

*"Mathys & Squire LLP's 'absolutely first class team' is 'proactive with advice, but responsive to clients' needs and requirements'. The group is 'very knowledgeable, both from a scientific as well as a business point of view' and 'proactively safeguards clients' interests'."*

**The Legal 500**



## Commercial focus | collaborative approach

**Our clients expect more than just expert advice. Our commercial focus and collaborative approach allows us to really help our clients maximise the value of their intellectual property (IP).**

We work with a range of organisations from startups and SMEs through to public sector bodies, universities and multi-national enterprises, covering the full spectrum of industries.

We build close and longstanding relationships with our clients to establish defensive and offensive IP portfolios that generate commercial value, and we have worked on a number of highly successful university spin-outs and licensing deals.

We take a proactive approach when working with our clients, and advise them on a course of action that is best aligned with their business objectives. Understanding the value of a new invention or brand is as important as understanding the technology and marketing behind it. Clients value our integrity, honesty, collegiate approach and the robust practical advice we give.

We share our clients' ambition, passion and entrepreneurial spirit.

**We empower our teams to go above and beyond what clients expect when it comes to service delivery.**

*“In my experience, Mathys & Squire is one of the leading IP firms in the UK, if not in Europe. The team that my colleagues and I have worked with has an almost visionary approach to the patenting process. Like many other IP firms they bring considerable technical ability, diligence and expertise, but it is their meticulousness, forward thinking, and strategic vision that really makes them stand out from others.”*

**Daval International**

# Specialist service areas - patents

**We are highly skilled in identifying inventions that are eligible for protection and tailoring those rights to best correspond with our clients' current needs and potential future requirements.**



## Portfolio management

An effective portfolio management strategy can be key to successful valuations and acquisitions, and our attorneys can help ensure that your IP is managed to maximise its benefit for your commercial aims.



## Due diligence

We have assisted many companies with due diligence on third party IP (leading to strategic acquisitions and in-licensing). We have also helped guide and defend companies through rounds of due diligence in applications for funding and prior to acquisition.



## Enforcement

We will support you in enforcement of your IP rights, and in particular with regard to third party infringement of your IP. We have extensive experience of opposition and appeal proceedings before the European Patent Office (EPO), both at first instance and appellate level (split roughly equally between offensive and defensive oppositions) as well as in the UK High Court and Intellectual Property Enterprise Court (IPEC).



## Ownership and licensing

We can provide advice on IP agreements, licensing and commercial strategy for collaborations and technology consultancy arrangements, both in the context of prosecution, but also in relation to matters of ownership and entitlement and the background/foreground division of IP. We have experience of advising in IP licence negotiations between SMEs and larger entities, including Tier 1 OEM and automotive customers.





### Legal opinions

We have conducted multi-phase, in-depth freedom to operate analysis on behalf of our clients. Our team regularly provides non-infringement opinions for clients.



### Searching and investigations

We offer a full range of searching and investigation services, including: periodic competitor reviews; periodic collection searches; landscaping and due diligence.



### Strategy

A particular strength of our attorneys is their ability to consider patent prosecution from a multi-dimensional perspective, taking into account factors such as our clients' commercial aims, the idiosyncrasies of European practice, strategies for dealing with possible oppositions, the law on supplementary protection certificates (SPCs), the interplay of patent law with regulatory data protection, and the need to ensure consistency with foreign prosecution or litigation.

*“Some law firms prioritise their bigger clients over smaller ones but ever since I started working with Mathys & Squire in 2003, whether for a large or small company, I’ve found the level of attentiveness and professionalism has always been of the same high standard. The pace of our work is very fast and we have found we can rely on the team at Mathys & Squire to respond to our requests in the time-frame that we need it, with us often receiving responses on the same day.”*

### Molecular Templates

# Specialist service areas - trade marks

**Our trade mark team understands how vital it is to protect your brand from inevitable threats. The effective management of a trade mark portfolio encompasses the delivery of a wide range of services.**



## **Trade mark portfolio management**

As part of our portfolio management service, we will routinely advise on renewals and the use of trade marks, changes to and refreshing of brands, protection overseas, the maintenance of IP policies and the implementation of effective IP management strategies.



## **Trade mark availability searches (including brand availability analysis for new products and services)**

We work with third party search providers to ensure that our clients receive the most reliable and cost effective method of assessing the state of the trade mark register in the country or countries of interest.



## **Dedicated support and reporting**

We will assign the management of your portfolio to a dedicated and experienced paralegal, under the supervision of our qualified trade mark attorneys.

However you like to work, our team will adapt to your needs.

For example, should you require a specific form of reporting or updates, we are happy to accommodate this and provide reports to suit your needs. We can also provide you with access to our records, to assist you in the management and understanding of your trade mark portfolio.



## **Applications, filing and renewal services**

We can file UK, EU and International trade mark applications directly with the UKIPO, EUIPO and WIPO respectively. We work with a network of trusted foreign attorneys, with whom we have longstanding relationships, to file in other countries.



## **Monitoring and watching services**

All trade mark applications located by the watching service would be reviewed by us to screen for those that potentially conflict with your company's trade marks.



**Oppositions (including revocation and invalidity proceedings) and contentious IP proceedings**

We routinely deal with trade mark enforcement matters on behalf of our clients. Our services include sending cease and desist letters, the conduction of settlement negotiations, drafting evidence and the preparation and completion of appropriate agreements or undertakings.

Where a resolution cannot be reached, we pursue proceedings in the IPEC, the High Court, the Court of Appeal, and, in the EU, The General Court of the European Union and The Court of Justice of the European Union.



**Online brand protection and enforcement services**

We are experienced at issuing take-down notices on various social media and/or online auction sites, liaising with Trading Standards, preparing evidence, engaging with customs authorities, handling seizure notices and reviewing and analysing web watch and domain name watch results.

*“The team are pragmatic and knowledgeable, [they] always show great understanding of our organisation and our commercial aims, and we work closely with them to protect our trade marks and brand.”*

**UKFast**





# Specialist service areas - designs

**We have a large and well established designs practice which has helped numerous household names secure strategic protection for their designs internationally.**



## **Using the registered design system to maximise protection for key design aspects**

We work closely with our clients to cover key design aspects of new products and product lines covering, where appropriate, overall shape, texture, and/or surface finish of products. We have particular expertise in obtaining broad design protection for features that pervade product lines. We also have significant experience in obtaining design protection for user interfaces.



## **International expertise**

We have built up a number of significant international design portfolios covering a wide range of jurisdictions, and have therefore acquired an intimate knowledge of the unique variations in local practice. Owing to our expertise in international design protection, we are often instructed by large multinational companies specifically to handle large overseas design filing programmes.



## **Providing you with a dedicated designs paralegal team**

Our dedicated and experienced designs paralegal team enables us to handle design filing and prosecution efficiently and cost effectively in multiple jurisdictions.



## **Integrating design protection into the product development cycle**

We can integrate design protection into the product development cycle to reduce costs and management time associated with seeking design protection. We often provide guidance and/or in-house training to designers so they can provide the drawings we need for design filings without disrupting the product design process.

In particular, we can assist in setting up a workflow in which drawings in a ready-to-file or near ready-to-file state are provided by an organisation's designers, allowing us to file new design applications quickly. We have experience in putting such systems in place with several of our larger clients.

## Specialist service areas - litigation

**Our litigation team is made up of solicitors, patent attorneys and trade mark attorneys, who understand both the complexities of the law and the practical intricacies of the technologies in IP disputes.**

Our litigation team includes experienced patent and trade mark attorneys who already have an in depth understanding of our clients' businesses and objectives, as well as having technical knowledge which underpins their clients' IP portfolios. This is essential to obtaining a successful result in litigation.



### Choice of court

We are skilled at conducting litigation in the High Court, the Intellectual Property Enterprise Court (IPEC), the Court of Appeal and the Court of Justice of the European Union.

Our litigation team has particular expertise in conducting patent and trade mark litigation in the IPEC, where we frequently take advantage of the IPEC's streamlined proceedings, reduced expenses and accessibility for our clients.

We are proud to be regarded by our clients as the first port of call for IPEC litigation, especially in relation to trade marks, designs and copyright, as the vast majority of disputes in these areas are heard in the IPEC.



### Alternative Dispute Resolution (ADR)

We strive to avoid prolonged and costly litigation unless it is in our view the best way for our clients to achieve their objectives and commercial goals. Our expertise in ADR and other informal methods of dispute resolution mean that we have all of the tools and knowhow at our disposal to ensure the best possible result is achieved. Our experience includes conducting informal negotiation, and employing ADR formats such as mediation and arbitration.



### Sound advice

Our litigation team provides sound, decisive advice and will give you an honest, jargon-free assessment of the merits of the case, as well as the best strategies to adopt.





### Multi-jurisdictional litigation

We are sensitive to and fully understand the implications of multi-jurisdictional litigation. Our attorneys use our relationships with trusted attorneys in foreign jurisdictions, where necessary, to ensure the effective conduct of the litigation.

*“Litigation partner, Margaret Arnott is commended for possessing the ‘rare qualities of reasonableness and levelheadedness as a litigator.’”*

**The Legal 500**



### Results driven

We are value and results driven – our team recognise and understand that clients want a commercial result and the aim is not to set legal precedent, but for the infringement to stop and for our client to make a solid return on their investment.





