



Simon Casinader

Senior Associate

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OVERVIEW

Simon Casinader is a senior associate in the firm's London office and had previously worked in the Melbourne office for over seven years. Simon is an intellectual property lawyer with extensive experience in protecting and enforcing intellectual property rights across multiple jurisdictions.

His experience includes developing and enforcing brand protection strategies on matters for trade mark, copyright and design owners, and providing contentious and non-contentious advice in relation to all aspects of intellectual property law.

Simon works with his clients to prosecute, manage and enforce international trade mark and design portfolios and regularly advises on related clearance issues. His broad range of experience includes prosecuting Australian, New Zealand, UK, EU and international trade mark and design applications as well as acting and appearing in contentious trade mark and patent opposition proceedings before IP Australia, IPONZ, the UKIPO and the EUIPO.

Simon has represented clients in legal proceedings concerning patent, trade mark, design and copyright infringement, as well as the misuse of confidential information and trade practices cases before the Federal Court of Australia, Supreme Court of Victoria, Intellectual Property Enterprise Court and High Court of Justice in the UK.

Simon also assists client with a wide range of online conduct matters including the recovery of domain names registered in bad faith, eCommerce disputes and social media issues and he has specific experience in developing, managing and enforcing anti-counterfeiting campaigns and customs programs for clients.

ACHIEVEMENTS

- Recognised as a Rising Star – Australia by *Managing Intellectual Property* IP Stars, 2018

PROFESSIONAL / CIVIC ACTIVITIES

- Law Institute of Victoria member
- Intellectual Property Society of Australia and New Zealand member

- The Chartered Institute of Trade Mark Attorneys member
- K&L Gates INspire member (National LGBTI+ Network)

SPEAKING ENGAGEMENTS

- Simon was the runner up in the 2014 LIV Golden Gavel competition as well as a participant in the IPSANZ Victorian Christmas Moot 2014 and the 2015 Legal Comedy Debate (as part of the Melbourne International Comedy Festival).

EDUCATION

- Graduate Diploma in Legal Practice, College of Law, 2012
- B.S., Monash University, 2011 (*Chemistry*)
- LL.B., Monash University, 2011 (*Honours*)

ADMISSIONS

- Federal Court of Australia
- High Court of Australia
- Supreme Court of Victoria

THOUGHT LEADERSHIP POWERED BY HUB

- 6 January 2021, Battle of the Ballet Shoes: UK Court Finds Infringement of Registered Community Design (*BlogPost*)
- 30 December 2020, Battle of the Bentleys: Bentley Motors Loses Trade Mark Appeal Against Bentley Clothing (*BlogPost*)
- 23 November 2020, Not Such a Friendly Decision for Hugz: A New Development in Passing Off that Could Help Combat Fashion Copy-Cats (*BlogPost*)
- 8 November 2020, Brexit and .EU Domain Names – A Warning for UK Registrants (*BlogPost*)
- 4 November 2020, What an Awful Racket... Acoustic Product Trade Mark Case Provides Opportunity for Brands Being Piggy-Backed to Drive Search Traffic (*BlogPost*)
- 28 October 2020, Putting Position Marks Front and Centre: CJEU Considers Assessment of Position Marks for Services (*BlogPost*)
- 22 October 2020, Louis Vuitton Playing Chess or Checkers? The CJEU Annuls' the Invalidation of Louis Vuitton's EU Trade Mark (*BlogPost*)

- 22 September 2020, Don't Bank-sy on Trade Marks: Banksy Loses EU Trade Mark Due to "Bad Faith" (*BlogPost*)
- 21 September 2020, Reputation and Likelihood of Confusion – It's All a Bit of a Messi... (*BlogPost*)
- 15 September 2020, A Right Royal Rejection: "Royal Butler" Trade Mark Application Denied in the UK (*BlogPost*)
- 12 June 2020, Copyright Protection for Brompton's Folding Bicycle? CJEU Gives Green Light to the Possibility Across Europe (*BlogPost*)
- 4 May 2020, "I Wanna Really Really Really Wanna... Take You to Court." VB Trade Mark Dispute Heads to the Federal Circuit Court in Australia (*BlogPost*)
- 29 April 2020, After the CJEU's Decision Now There is a Final High Court Judgment in the Sky v SkyKick Case (*BlogPost*)
- 26 April 2020, Is it a Bird? Is it a Plane? No, it's an Infringement of a Reputable Mark! (*BlogPost*)
- 31 March 2020, COVID-19: UKIPO Declares "Interrupted Days" to Extend Deadlines (*BlogPost*)
- 17 March 2020, COVID-19: EUIPO Extends All Office Deadlines; CJEU Restricts Operations But Time Limits Unchanged (*BlogPost*)
- 3 February 2020, Cofemel's First UK Outing – The Woolly World of Copyright and Designs (*BlogPost*)
- 1 February 2020, Fashion Law – February 2020 Edition (*Alerts/Updates*)
- 29 January 2020, We have a decision in the Sky v SkyKick case... and the long-awaited CJEU's decision is good news for brand owners! (*BlogPost*)
- 22 January 2020, Brexit: Implications for Your Business and its Relationship With the EU (*Webinar*)
- 19 December 2019, 'High' expectations for Cannabis trade mark 'hash'ed – Is EU trade mark law ready for Cannabis(TM)? (*BlogPost*)
- 13 November 2019, To 3D, or not to 3D, that is the question: Another twist in the Rubik's Cube and its EU trade mark protection (*BlogPost*)
- 21 October 2019, Sky v Skykick AG – is this the end of a claim for "computer software?" (*BlogPost*)
- 16 October 2019, UKIPO knocks undefeated Reds off their perch – The LIVERPOOL trade mark and lessons for brand owners (*BlogPost*)
- 11 September 2019, Trade mark re-filing and bad faith – Go directly to Jail. Do not pass GO, do not collect \$200 (*BlogPost*)
- 20 August 2019, The Claridge's Affair: A win, but at what cost? (*BlogPost*)
- 29 July 2019, The Scotch Whisky Saga: Where Name and Reputation is not enough (*BlogPost*)
- 14 July 2019, Beauty and the Beast – A tale of (trade mark infringement) as old as time (*BlogPost*)

- 20 June 2019, “Three stripes and you’re out!” – The EU General Court rules Adidas’ three stripe trade mark invalid (*BlogPost*)
- 20 June 2019, A figurative mark? A position mark? Or just a trade mark? (*BlogPost*)
- 31 May 2019, Fashion Law - May 2019 Edition (*Alerts/Updates*)
- 13 May 2019, Zara v Zara: The evolving world of “fashion” (*BlogPost*)
- 24 April 2019, Iceland’s trade mark nothing but a puddle (*BlogPost*)
- 27 March 2019, Final Approval given to EU Copyright Directive (*BlogPost*)
- 21 March 2019, Trademark, Design and Copyright Update For Fashion Brands (*Webinar*)
- 13 March 2019, Can the mere registration of company name infringe? In the case of BMW, yes! (*BlogPost*)
- 18 January 2019, Supermac takes a bite out of McDonald’s as it loses the BIG MAC trade mark in the European Union (*BlogPost*)
- 1 October 2018, A No Deal Brexit – how will trade marks and designs look? (*BlogPost*)
- 13 March 2018, Thunder Road toasts success in “Pacific Ale” case again (Stone & Wood’s appeal dismissed) (*BlogPost*)
- 29 September 2016, A dog of a trade mark dispute (*BlogPost*)
- 12 August 2016, IP Australia Announces New Official Fee Structure For Australian Trade Marks (*BlogPost*)
- 6 July 2016, New Balance Unsuccessfully Challenges Trade Mark Infringement Claim in China but Walks Away with a Significantly Reduced Liability (*BlogPost*)
- May 2016, Chinese High Court Decision Confirms the OEM Exception to Trade Mark Infringement for the First Time (*Alerts/Updates*)
- 4 March 2016, Australia: Why Your 'Exclusive' Patent License may not Longer be Exclusive and What to do to fix it (*Alerts/Updates*)
- February 2016, 98 Million Reasons to Think About how you use Your Brand in China – The Risks of not Obtaining Proper IP Protection for Your Business in China (*Alerts/Updates*)
- 18 December 2015, The end for the Dallas Buyers Club Dispute and Speculative Invoicing? Or is it Just the Beginning. (*BlogPost*)

OTHER PUBLICATIONS

- "The Business and Law of Fashion and Retail," International Issues, *Carolina Academic Press*, August 2020
- “Zara vs. Zara,” *Ragtrader*, August 2019
- “Social Sense,” *Ragtrader*, July 2019

- “A 'Spotlight' on copyright,” *Ragtrader*, 1 March 2019
- “Slave, no more,” *Ragtrader*, 1 January 2019
- “Social Butterflies,” *Ragtrader*, 1 October 2018
- “Designed To Last,” *Ragtrader*, 1 September 2018
- “Drawing Parallels,” *Ragtrader*, 1 August 2018
- “Owning your domain,” *Ragtrader*, March 2018
- “Cash for comment,” *Ragtrader*, June 2016
- “The online dilemma,” *Ragtrader*, August 2015
- “Wait, that’s mine!” *Ragtrader*, July 2015

AREAS OF FOCUS

- IP Procurement and Portfolio Management
- IP Litigation

INDUSTRIES

- Consumer Products
- Luxury Products and Fashion
- Sports

EMERGING ISSUES

- Social Media Law

REPRESENTATIVE EXPERIENCE

- Acting for a kitchen and bathroom material retailer and manufacturer in relation to appealing two decisions of the Australian Trade Marks Office to the Federal Court of Australia. [The appeal relates to two CAESARSTONE trade marks filed by Caesarstone being a word trade mark and a device trade mark. The opponent of the trade mark applications is Ceramiche Caesar SpA. Ceramiche Caesar SpA is also seeking to cancel a registered trade mark for CAESARSTONE which is registered to Caesarstone Ltd in classes 35 and 37. Trial took place in April 2017 and judgement was handed down in September 2018 in favour of Caesarstone.]
- Acted for an Australian health and media personality in relation to a trade mark registration. [Sophie Guidolin, also a social media personality, through her corporate entity Inspire By Sophie Guidolin Pty Ltd holds an

Australian trade mark registration for the words "The Bod" for physical health education services. Guidolin contested the use of the word 'B.O.D' by Rachael Finch and Finch Entertainment with respect to a recently launched clothing brand and applied for an urgent interlocutory injunction for trade mark infringement, as well as passing off and/or breach of the Australian Consumer Law on 21 December 2017.]

- Acting for an Australian health food and beverage company to enforce its intellectual property rights throughout the world which has included advising on a trade mark infringement action in Poland relating to an alleged infringement of one of its beverage trade marks.
- Advising fashion company Alexander McQueen in relation to filing a trade mark application for MCQUEEN which was opposed by Metropolitan Services Ltd, the owner of the CHRISTINE MCQUEEN trade mark. Alexander McQueen sought to cancel the CHRISTINE MCQUEEN trade mark for non-use. Alexander McQueen was successful on its appeal to the Federal Court of Australia and it was successful in having the CHRISTINE MCQUEEN trade mark removed for a number of goods and services. K&L Gates was ultimately successful in registering the MCQUEEN trade mark for Alexander McQueen.
- Advising a prominent Australian artist about the use of one of his paintings which was reproduced on a paint tin.
- Advising on major intellectual property litigation regarding alleged misleading and deceptive conduct, passing off and trade mark infringement.
- Acting for clients in various online conduct matters, including recovering domain names registered in bad faith and filing complaints with Google to cease the unauthorised use of registered trade marks as Google AdWords.
- Acting for Seafolly in copyright infringement proceedings in the Federal Court of Australia, including a proceeding Seafolly successfully brought against Fewstone (City Beach) where Seafolly established copyright infringement in two fabric prints and an embroidery design applied to garments.
- Acting for SNF Australia in relation to Patent Oppositions in the Australian Patents Office, and patent invalidity and patent infringement proceedings in the Federal and High Court.
- Advising SNF Australia, an Australian company which manufactures chemicals used in water treatment (particularly mining), in relation to Patent Oppositions in the Australian Patents Office, and patent invalidity and patent infringement proceedings in the Federal and High Court. We have acted on various proceedings involving innovation and standard patents and patents of addition.
- Advising Factory X in relation to a trade mark infringement claim in the Federal Court of Australia brought against CupoNation GmbH. Factory X is the owner of Australian (word) trade mark no. 1168011 BLACK FRIDAY in classes 25 and 35 and also owns other brands such as Lisa Gorman and Black Friday. The Federal Court made orders restraining CupoNation from using the BLACK FRIDAY trade mark. The matter was closely followed by the retail sector in light of the annual BLACK FRIDAY sales event held in the U.S.
- Acting for various prominent Australian and international fashion brands including Seafolly (swimwear brand), Review (vintage inspired women's fashion), Gorman (women's fashion), Factory X (fashion company that owns various labels), Sheike (women's fashion), Arthur Galan (mens and womens fashion), Rebecca

Vallance (Australian women's fashion designer), R. M. Williams (Australian outback clothing), Alexander McQueen (British fashion designer), Anna Thomas (luxury women's label), Bellroy (wallets) and Mister Zimi (women's resortwear) in a variety of IP matters.

- Prosecuting, managing and enforcing international intellectual property portfolios for a range of clients including advising Thomas Pink, Seafolly, R. M. Williams, Smash Enterprises, Landmark Operations Limited, Costa Group, Rathbone Wine Group, and Sullivans Cove Distillery.