



Alaina Newnes

Call 2012



Scope of Practice

• Intellectual Property • Information Technology • Injunctions and Urgent Relief

Overview

Alaina specialises in intellectual property. She has been involved in a number of complex cases working as part of a team in the CAT, High Court and Court of Appeal, as well as advising and appearing in cases as sole counsel. In addition to litigation, she also has experience of international arbitration

Before coming to the bar, Alaina practised as a litigation solicitor in Australia (Blake Dawson Waldron, now Ashurst LLP) and in the UK (Freshfields Bruckhaus Deringer and TSol). She qualified as a barrister and solicitor in Western Australia in 2006.

A few highlights of Alaina's practice in 2023 include:

Wright & Wright International Investments Limited v Payward, Inc; Payward, Ltd; and Payward Ventures, Inc: led by Philip Roberts KC and acting for the Defendants in this claim for passing off in relation to the digital asset "Bitcoin". There have been two judgments concerning various applications made in the Claim: [2023] EWHC 1893 (Ch) and [2023] EWHC 1894 (Ch).

B&Q Limited v Wren Kitchens Limited: led by Emma Himsworth KC and acting for the Claimants in this claim concerning comparative advertising.

Ladbrokes Betting and Gaming Limited & LC International Limited v Blockchain Game Partners, Inc & Gala Labs Limited: led by Emma Himsworth KC and acting for the Claimants in this claim concerning trade mark infringement.

Easygroup Ltd v Premier Inn Hotels Limited: led by Emma Himsworth KC and acting for the Defendants in this trade mark infringement claim.

In addition, Alaina frequently appears in the IPO. A few examples of recent IPO decisions in matters where Alaina has acted as sole Counsel include:

“AFTV” O/0877/23: Opposition proceedings in the IPO concerning the rights in the mark “AFTV”. This involved cross-examination in the Registry.

“TRIFOX” O/0524/23: Opposition and invalidation proceedings in the IPO.

“ARIA” O/0455/23: Opposition proceedings in the IPO.

Examples of Recent Cases

Intellectual Property

With particular experience in trade mark, breach of confidence, copyright and passing off cases, Alaina is also experienced in matters concerning data protection, database rights, design right (registered and unregistered), registered designs and malicious falsehood / trade libel / comparative advertising.

- **Genius Sports Technologies Limited & Ors v Soft Construct (Malta) Limited & Ors**
Acted (led by Philip Roberts KC, Daniel Jowell KC and Conall Patton KC) for the First to Sixth Defendants appearing before Marcus Smith J the CAT and High Court in the database rights infringement claim with defences in competition law. There were a number of substantial interim hearings in relation to the claim (see [2022] EWHC 2637 (Ch), [2022] EWHC 2308 (Ch) and [2021] EWHC 3200 (Ch)).
- **MSG Sports & Entertainment LLC v various**
Sole counsel in two separate successful Norwich Pharmacal applications in the High Court.
- **Case C-461/19P All Star v EUIPO ECLI:EU:C:2019:797**
Acted (with Simon Malynicz QC) for All Star CV in an appeal to the CJEU. The point of law concerned the extent to which the EUIPO can engage in evidence-gathering of its own motion in contested trade mark proceedings.
- **Battat Inc & Anor v Addo Play Limited & Anor IP-2019-000117**
- Acted (with Emma Himsworth QC) for the Defendants in a trade mark infringement and passing off claim in the Intellectual Property and Enterprise Court
- **Faun Trackway Limited v Grassform Plant Hire Limited IP-2019-000148**
Acted (with Phil Roberts QC) for the Claimant in a trade mark infringement and passing off claim in the High Court.
- **Christie, Flooring Yorkshire Limited & Lifestyle Flooring UK Leeds Limited v Headlam Group PLC IP-2019-00142**
Acting as sole counsel for the Defendant in a claim in the Intellectual Property and Enterprise Court by which

the Claimants are seeking declarations that the Claimants have not infringed the Defendant's trade marks or engaged in passing off. The Defendant has brought a counterclaim for trade mark infringement and passing off.

- **Glaxo Wellcome UK Limited (T/A Allen & Hanburys) v Sandoz Limited [2017] EWHC 3196 (Ch)**
Acted (with Simon Malynicz QC) in an application for permission to adduce survey evidence.
- **Glaxo Wellcome UK Limited (T/A Allen & Hanburys) v Sandoz Limited [2017] EWHC 1524**
Represented (with Simon Malynicz QC) the Claimants at a CMC which included an application for permission to rely on expert evidence.
- **Glaxo Wellcome UK Limited (T/A Allen & Hanbury's) & Anor v Sandoz Limited & Anor [2017] EWCA Civ 335**
Acted (with Simon Malynicz QC) for the Appellants in an appeal concerning colour marks and the requirements for graphical representation.
- **Glaxo Wellcome UK Limited (T/A Allen & Hanbury's) & Anor v Sandoz Limited & Anor [2017] EWCA Civ 227**
Acted (with Simon Malynicz QC) for the Appellants in an appeal against the refusal of permission to join two additional parties to this passing off claim.
- **The Royal Mint Limited v The Commonwealth Mint and Philatelic Bureau Limited [2017] EWHC 417 (Ch)**
Acted for the Respondent (Opponent) in an appeal to the High Court against a successful opposition to the registration of the mark "SOVEREIGN".
- **Millen v Karen Millen Fashions Ltd [2017] FSR 7**
Acted (with Charles Graham QC) for the claimant in a claim concerning the proper interpretation of various restrictive covenants in a contract by which the claimant divested her interests in the fashion retail business bearing her name. Alaina also appeared (with Charles Graham QC) in the High Court in relation to a two-day application in this case.
- **Enterprise Holdings, Inc -v- Europcar Group UK Limited & Europcar International SASU [2015] EWHC 17 (Ch)**
Acted (with Geoffrey Hobbs QC and Guy Hollingworth) for the defendants in a claim for trade mark infringement and passing off.
- **British Sky Broadcasting Group Plc & Ors -v- Elizabeth Mary Polding (trading as Eccleston Arms) IP-2015-000121**
Represented BskyB in IPEC at an assessment of costs and damages hearing in respect of the fourth defendant; in relation to an application against the second defendant; and at CMCs. The claim concerns the unauthorised reception and display of Sky TV broadcasts in commercial premises. Judgment has now been given against the fourth defendant.
- **Amazon Europe Holding Technologies SCS -v- (1) Kindle Entertainment Ltd (2) Kindle Entertainment Productions Ltd (3) Kindle Entertainment (Big and Small) Ltd HC13C04185**
Acted for the defendants, the producers of children's television programmes, in IPEC in a claim for trade mark infringement.
- **Technomed Limited -v- Bluecrest Health Screening Ltd IP-2015-000046**
Represented the claimant and conducted the advocacy in respect of a CMC and application in IPEC. The claim concerns IP rights in a database, software and various other materials.

- **Skechers USA Inc II -v- Tesco Stores Limited IP-2015-00020**
Acted for the defendants in a claim in IPEC for design right infringement.
- **Talos Limited -v- Stackhouse Poland Limited & Anor IP-2015-054**
Acted for the Defendants in IPEC, in a claim concerning a dispute over payment of software licence and maintenance fees and involving claims of copyright infringement.
- **Claridge Architects Limited -v- Fulstow Holdings & Ors HC-2014-00506**
Advised and Acted for the claimant in multi-party litigation concerning copyright infringement and quantum meruit claims relating to work done on a large commercial project. Represented the claimant at a mediation of the claim.
- **Syniverse Technologies, LLC -v- Synverse Ltd**
Acted for the claimant in respect of a claim for infringement of Community Trade Marks.
- **JW Spear & Sons Ltd -v- Zynga Inc (word mark)**
Assisted James Mellor QC and Philip Roberts (acting for Zynga Inc) in both the High Court ([2013] EWHC 3348 (Ch)) and Court of Appeal in an action for trade mark infringement.
- **JW Spear & Sons Ltd -v- Zynga Inc (tile mark)**
Assisted Philip Roberts (Led by James Mellor QC) for Zynga Inc in an appeal before the Court of Appeal to which Zynga Inc was the respondent. The appeal was from a summary judgment in favour of the respondent's counterclaim in a trade mark infringement action. The appeal concerned issues including the role of "distinctiveness" in Article 2 of Directive 2008/95/EC.
- **Opposition Proceedings concerning UK Trade Mark Application No 3276473 "JACK'S" (O/288/19)**
Acted for Tesco Stores Limited in successful opposition proceedings in the IPO.
- **Opposition Proceedings concerning UK Trade Mark Application No 3128049 "ROOM SEVEN" (O/055/18)**
Acted for Room Seven BV in successfully defending opposition proceedings in the IPO.
- **An Appeal to the Appointed Person concerning an application for revocation of UK Trade Mark Application No 1399292 "TRAVEL FOX" (O/018/17)**
Acted for the appellant / applicant in an appeal to the Appointed Person.
- **Opposition Proceedings concerning UK Trade Mark Application Nos 3 139 628 and 3 139 625 "CATFUEL" (O/156/17)**
Acted for Caterpillar Inc in opposition proceedings in the IPO.
- **An Appeal to the Appointed Person concerning an opposition to UK Trade Mark Application No 2538478 "HOME MADE" (O/167/14)**
Acted for the Opponent, 151 Products Limited, in an appeal to the Appointed Person.
- **Opposition Proceedings concerning UK Trade Mark Application No 02633062 "SOVEREIGN" (O/108/16)**
Acted for The Commonwealth Mint and Philatelic Bureau Limited in successful opposition proceedings in the IPO.
- **Opposition Proceedings concerning UK Trade Mark Application No 2585906 "BULLDOG CIDER" (O/003/14)**
Acted for CK3 LLC in successful opposition proceedings in the IPO.
- **Opposition Proceedings concerning UK Trade Mark Application No 2635625 "SUPACAT" (O/338/14)**
Acted for Caterpillar Inc in successful opposition proceedings in the IPO.

- **Opposition Proceedings concerning UK Trade Mark Application No 3035812 “ZUBROWKA”**
Acting for Underberg AG in opposition proceedings in the IPO.
- **Opposition Proceedings concerning UK Trade Mark Application No 3052125 “CAT Clean Air Technology” (O/074/16)**
Acted for Caterpillar Inc in successful opposition proceedings in the IPO.
- **Ex parte hearing in relation to the Registrar’s refusal of Application 3069768 “A DOG IS FOR LIFE NOT JUST FOR CHRISTMAS” (O/106/16)**
Acted for the applicant, Dog’s Trust, in a hearing concerning the Registry’s refusal to accept the applicant’s trade mark application on absolute grounds under s 3(1)(b).
- **Office of Harmonisation for the Internal Market**
Acted for a company specialising in the manufacture and marketing of various chemicals in relation to potential trade mark infringement proceedings and the opposition of several Community Trade Marks.
- **Office of Harmonisation for the Internal Market**
Acted for a company specialising in the manufacture and sale of vehicles and related merchandise in opposing registration of a Community Trade Mark.
- Advised a company in respect of a potential claim for breach of confidence in connection with a competitor’s business.
- Advising a premiership football club in relation to trade mark infringement and passing off.
- Acted for a technology company developing a mobile phone apps and advising on issues concerning use of a proposed trade mark.
- Advised a large multi-national parent company in relation to a claim against certain companies for breach of an exclusive distribution agreement.
- Advised a client involved in the research and development of geo-engineering technology in relation to a potential breach of confidence claim.
- Advising in relation to an agency agreement relating to a collective licensing scheme for artistic works.
- Advised the registered proprietor of a number of patent applications in a claim for breach of IP rights concerning an application made to the Technology Strategy Board.
- Advised (with Geoffrey Hobbs QC) in relation to the tax consequences of assignments of unregistered trade marks.
- Advised on IP issues in relation to electronic marketing law and data protection in respect of a proposed marketing campaign.
- Advised in relation to proposed changes to s 52 Copyright, Designs and Patents Act 1988 (industrially exploited artistic designs).

Commercial Litigation

- **Millen v Karen Millen Fashions Ltd [2017] FSR 7**
Acted (with Charles Graham QC) in a claim concerning the proper interpretation of various restrictive covenants in a contract by which the client divested her interests in the fashion retail business bearing her name. Alaina also appeared (with Charles Graham QC) in the High Court in relation to a two-day application

in this case.

- **British Sky Broadcasting Group Plc & Ors -v- Elizabeth Mary Polding (trading as Eccleston Arms) IP-2015-000121**

Represented BskyB in IPEC at an assessment of costs and damages hearing in respect of the fourth defendant; in relation to an application against the second defendant; and at CMCs. The claim concerns the unauthorised reception and display of Sky TV broadcasts in commercial premises. Judgment has now been given against the fourth defendant.

- **Claridge Architects Limited -v- Fulstow Holdings & Ors HC-2104-00506**

Advised the claimant in multi-party litigation concerning, amongst other things, quantum meruit claims relating to work done on a large commercial project. Represented the claimant at a mediation of the claim.

- **Talos Limited -v- Stackhouse Poland Limited & Anor**

Acted for the defendants in a claim concerning a dispute over payment of software licence and maintenance fees.

- **CF Partners (UK) Ltd -v- Barclays Bank Plc & Tricorona**

Assisted Orlando Gledhill who was acting for CF Partners (UK) Ltd (with Tim Lord QC) in circa €80m breach of confidence action in relation to the acquisition of Swedish carbon trader Tricorona by Barclays Bank Plc.

- Assisted Ben Strong QC who was instructed in claims concerning liability in respect of a derivative transaction entered into under an ISDA Master Agreement.
- Advised a large multi-national parent company in relation to a claim against certain companies for breach of an exclusive distribution agreement.
- Advised a client involved in the research and development of geo-engineering technology in relation to a potential breach of confidence claim.
- Advising in relation to an agency agreement relating to a collective licensing scheme for artistic works.

What the Directories Say

"Alaina Newnes has solid knowledge of IP and commercial issues. She comes up with better arguments and better outcomes." (Chambers and Partners 2024)

"Alaina is an excellent and very effective junior. I am leading her in some matters and she has been very impressive." (Chambers and Partners 2024)

"Her style is very responsive, approachable, collaborative and commercial. She is excellent, and good at working through complicated documentations and coming up with summaries and points to note." (Chambers and Partners 2024)

"She is very thorough and meticulous." (Chambers and Partners 2024)

"Alaina Newnes is excellent. She takes time to get to grips with huge issues. She is overall really helpful and impressive" (Chambers and Partners 2023).

"A tenacious advocate with a formidable work ethic" (Legal 500).

Professional Qualifications & Experience

Tutor in contract law, Kings College London [2010 - 2012]

The Treasury Solicitor's Department, Associate [2008-2011]

Admitted as a Solicitor in England & Wales [2010]

Freshfields Bruckhaus Deringer LLP, Associate [2007-2008]

Called to the Bar of Western Australia and Admitted as a Solicitor in Western Australia [2006]

Judicial Assistant to the Honourable Justice Steytler, President of the Court of Appeal of the Supreme Court Western Australia [2004-2006]

Blake Dawson Waldron, Articled Clerk [2004]

Higher Education

University of Oxford: Master's Degree Bachelor of Civil Laws (Distinction) [2006-2007]

University of Western Australia: LLB Law, Politics & History (First) [1999-2004]

Academic Achievements

Merit-based scholarship for post-graduate study, University of Oxford [2006]

Top-ranked graduating student in law, University of Western Australia [2004]

Valedictorian (the student invited by the university to give the valedictory address at the schools of law, business and education graduation ceremony), University of Western Australia [2004]

Representative of the University of Western Australia in the Philip C. Jessup International Moot Court Competition [2003]

Jean Rogerson Studentship for being one of the top-ranking honours entrants, University of Western Australia [2003]

Butterworths Prize for being one of the top-ten students in the penultimate year of law, University of Western Australia [2002]

Allens Robinson Prize for the student who achieves the highest overall average mark in general commercial law units, University of Western Australia [2002]

Deacons Prize for the best student in Corporations Law, University of Western Australia [2002]

Awards



Contact Clerks



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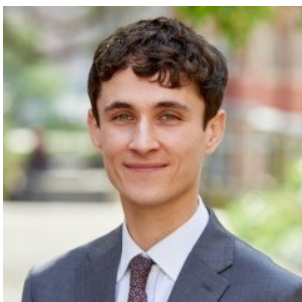


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