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Emma Himsworth KC

Barrister
Call 1993 Silk 2012



Scope of Practice

• Breach of Confidence • Broadcasting • Comparative Advertising • Competition and EU Law • Copyright • Database Rights • Design Rights (registered and unregistered) • Inquiries as to Damages • Intellectual Property • Media • Passing Off • Patents • Privacy • Trade Marks • Arbitration (As Arbitrator)

Overview

Emma Himsworth specialises in all areas of intellectual property law and related aspects of competition and commercial law. Her practice encompasses both court and advisory work. She has a particular interest and expertise in matters involving trade marks and passing off. Emma sits as an Appointed Person, hearing appeals from the UK Registrar of Trade Marks. She also accepts appointments as Arbitrator. She is the current Chair of the Intellectual Property Bar Association.

Recognised as an expert on trade mark law, with a strong work ethic and a user-friendly approach. As well as handling high-end and technically complex trade mark and copyright litigation, she is effective in digital platform infringement claims, invalidation attempts and licensing disputes. She is also instructed in judicial reviews that involve questions of both IP and competition law. She has appeared in a number of high-profile appeals before the General Court of the EU.

Examples of Recent Cases

Trade Marks

- **Quantum Advisory Ltd v. Quantum Actuarial LLP [2023] EWHC 47 (Ch)**
  Acting for Quantum Advisory Ltd in a claim to rectify the trade marks register to substitute its name for that of Quantum Actuarial LLP with respect to a number of trade marks.
- **Puma SE v. Nike Innovate CV [2022] RPC 2**
  Acting for Nike, the respondent, to an appeal against the decision of the Registrar of Trade Marks in which the Opposition to the registration of the word mark FOOTWARE was dismissed. The appeal was refused.
- **Easygroup Ltd v. Empresa Aerea de Servicios y Facilitation Logistica Integral SA - Easyfly SA [2020] ETMR 23**
  Acting for Gie Avions de Transport Régional trading as ATR Aircraft resisting an application by the claimant to join ATR to proceedings for trade mark infringement, passing off and conspiracy on the basis that the Court

had no jurisdiction under the EUTMR and/or to the extent that it did the acts were *de minimis*. Nugee J. accepted the arguments.

- **Case T-215/17 Pear Technologies Ltd v. European Union Intellectual Property Office (EUIPO), Apple Inc. (intervener)**
  Acting for Pear Technologies Inc. in its successful appeal to the General Court of the European Union from a decision of the Fifth Board of Appeal of the EUIPO allowing the Opposition by Apple Inc., in respect of an application for registration of a device of a pear. Judgment was delivered by the General Court on 31 January 2019 (EU:T:2019:45)
- **Omega Flex Ltd v. British Standards Institution [2019] RPC 10**
  Acting for the British Standards Institution in invalidity proceedings before the Registrar on the basis of absolute grounds.
- **JT International SA and Gallaher Limited [2016] ETMR 36 and [2017] ETMR 9 (CA)**
  Acting for JT International SA and Gallaher Limited in a judicial review challenge to the plain packaging legislation for tobacco products in England. That challenge was heard at the same time as that of other tobacco manufacturers including British American Tobacco. The challenges raised a wide range issues under international, EU and domestic law including issues relating to competence and the deprivation of intellectual property. The hearing at first instance took place before Green J: [2016] ETMR 36. The Court of Appeal (Lewison and Beatson LJJ and Sir Stephen Richards) delivered judgment on the Appeal in November 2016 [2017] ETMR 9.
- **Mermeren Kombinat AD v. Fox Marble Holdings plc [2018] FSR 1**
  Acting for Mermeren Kombinat AD in an action for trade mark infringement claim together with a counterclaim for invalidity and revocation under the European Trade Mark Regulation relating to the mark SIVEC for marble.
- **Case T-538/15 Regent University v. European Union Intellectual Property Office (EUIPO)**
  Acting for Regent University in an appeal to the General Court of the European Union from a decision of the EUIPO invalidating the Community trade mark REGENT UNIVERSITY. Judgment was delivered by the General Court on 28 March 2017 (EU:T:2017:226).
- **Interflora Inc v. Marks and Spencer plc [2012] FSR 3 (CJEU); and [2015] FSR 10 (Interflora (CA III))**
  Acting for Marks and Spencer plc in an action for trade mark infringement relating to keyword advertising. An Order for reference to the CJEU was made [2009] RPC 22 and [2010] EWHC 925 (Ch) which resulted in a Judgment of that Court in Case C-323/09 Interflora Inc v. Marks and Spencer plc [2012] FSR 3. The trial of the action took place in April 2013 resulting in a number of Judgments: [2013] EWHC 936 (Ch) (admissibility of evidence); [2013] FSR 33 (main judgment on liability); [2013] EWHC 1484 (Ch) (costs); [2014] FSR 2 (additional judgment on liability and injunctions); and [2014] FSR 3 (injunctions, stay of proceedings). The Court of Appeal delivered judgment on the Appeal in November 2014 [2015] FSR 10 Interflora (CA III) and subsequently on the Form of Order [2014] EWCA Civ 1448. The Court of Appeal allowed the appeal and ordered a re-trial.
- **Interflora Inc v. Marks and Spencer plc [2015] FSR 13**
  Acting for Marks and Spencer plc on an application for interim relief pending the re-trial of the action. The application was dismissed.
- **Interflora Inc v. Marks and Spencer plc [2015] EWHC 675; [2015] EWHC 676 (Ch); [2015] EWHC 2227 (Ch); and [2015] EWHC 2231**
  Acting for Marks and Spencer plc on an application for relief in the context of a breach of a confidentiality order made in relation to material disclosed pursuant to an Island Records v. Tring order.
- **Interflora Inc v. Marks and Spencer plc [2013] 2 All ER 663 (Interflora (CA I)); and [2013] FSR 26 (Interflora (CA II))**
  Acting for Marks and Spencer plc in two appeals to the Court of Appeal relating to the admissibility of evidence from witnesses identified by means of a survey / witness collection exercise.
- **Sports Direct International Plc**
  Acting for Sports Direct International Plc and/or Queensberry Boxing Limited in proceedings in the Court of Appeal (infringement and validity) and the UK IPO (opposition) relating to various trade marks consisting of or including the word Queensberry.
- **Thomas Pink Limited v. Victoria's Secret UK Limited [2014] ETMR 57 and [2014] EWHC 3258 (Ch)**
  Acting for Victoria's Secret UK Limited in an action for trade mark infringement and passing off and counterclaim for invalidity and revocation.
- **Hearst Holdings Inc v. AVELA Inc [2014] ETMR 34 and [2014] ETMR 39**
  Acting for AVELA, Inc and others in an action for trade mark infringement and counterclaim for invalidity

and revocation of trade marks.

- **Cadbury Ltd - Société des Produits Nestlé [Colour Mark] [2012] RPC 18 (Allan James); [2013] ETMR 2 (Birss J); and [2014] ETMR 3 (CA)**
  Acting for Cadbury Ltd in an opposition in the UK IPO by Société des Produits Nestlé relating to the application by Cadbury Ltd for registration of a colour mark: [2012] RPC 18; on the appeal to the High Court [2013] ETMR 2; and on appeal to the Court of Appeal [2014] ETMR 3.
- **Hotel Cipriani Srl v. Fred 250 Ltd (formerly Cipriani (Grosvenor Street) Ltd) [2013] ETMR 18**
  Acting for Giuseppe Cipriani in an application for declaratory relief in relation to whether certain activities were or were not within the scope of an injunction previously granted in respect of the UK.
- **Special Effects Ltd v. (1) L'Oreal SA (2) L'Oreal (UK) Ltd [2007] ETMR 51**
  Instructed to appear on behalf of INTA (International Trade Mark Association) at the hearing of its application for permission to intervene in the Court of Appeal and at the hearing of the appeal in Special Effects Ltd v. (1) L'Oreal SA (2) L'Oreal (UK) Ltd.
- **Case C-421/04 Matratzen Concord AG v. Hukla Germany SA [2006] IP&T 483**
  Instructed by the Treasury Solicitor to assist in the preparation of the Government's observations in a reference to the Court of Justice of the European Union in Case C-421/04 Matratzen Concord AG v. Hukla Germany SA.
- **Quiksilver PTY Ltd v. Charles Robertson (Developments) Ltd [2005] FSR 8**
  Acting for Quiksilver PTY Ltd in a Chancery action for trade mark infringement in the context of the parallel importation of goods.
- **Reed Executive plc v. Reed Business Information Ltd (No 1 and No 2) [2004] RPC 40 (CA); [2005] FSR 3 (CA); [2003] RPC 12; and [2003] EWHC 2772 (Ch)**
  Acting for Reed Executive plc in an action for trade mark infringement and passing off which included the consideration of visible and invisible use of the mark in suit on the Defendants' website. Additionally acting for Reed Executive plc in other related trade mark disputes in the High Court, the UK IPO and the EUIPO.

Comparative Advertising

- **B&Q Limited v. Wren Kitchens Limited**
  Acting on behalf of B&Q in a claim for trade mark infringement in the context of a number of different comparative advertising claims.
- **Clarins SA and Clarins (UK) Limited v. Avon Cosmetics Limited**
  Acting for Clarins SA and Clarins (UK) Limited in an action for trade mark infringement relating to the use by Avon in promotional material of a claim that an Avon product was '5x more effective than Clarins Double Serum' one of Clarins' products. An application for an interim injunction was brought to prevent the ongoing use of the claim in the comparative advertising. Arnold J granted interim injunctive relief and directed an expedited trial.
- **Kingspan Group Plc v. Rockwool Ltd [2011] EWHC 250 (Ch)**
  Acting for Rockwool Limited in an action for malicious falsehood and trade mark infringement relating to comparative advertising of insulation products.
- **O2 Holdings Ltd v. Hutchison 3G Ltd [2007] 2 CMLR 15**
  Acting for Hutchison 3G Ltd in an action for trade mark infringement relating to comparative advertising. The trial of the action gave rise to two judgments [2006] RPC 30 (admissibility of evidence) and [2006] RPC 29 (main judgment on liability). The Court of Appeal subsequently delivered judgment [2007] 2 CMLR 15 and made an Order for Reference to the Court of Justice of the European Union Case C-533/06 O2 Holdings Ltd v. Hutchison 3G Ltd [2008] 3 CMLR 14.

Copyright and Design Right

- **Trappit SA (&Othrs) v. GBT Travel Services UK Limited**
  Acting for Trappit SA in a claim for breach of confidence and copyright infringement in relation to a computer software product.
- **Celebrity Pictures v. B Hannah Ltd [2012] EWPCC 32**
  Acting for Celebrity Pictures Ltd in Celebrity Pictures v. B Hannah Ltd in an action for copyright infringement.
- **Experience Hendrix LLC v. The Times Newspapers Ltd [2010] EWHC 424 (Ch)**
  Acting for The Times Newspapers Ltd in an inquiry as to damages for infringement of copyright.

- Ciccone v. Associated Newspapers Ltd
  Acting for Associated Newspapers Ltd in an inquiry as to damages for breach of privacy/misuse of private information and infringement of copyright.
- Spiralstem Ltd v. Marks & Spencer plc
  Acting for Marks & Spencer plc in an action for infringement of unregistered design right and the subsequent inquiry as to damages.
- Michael Jackson v. Granada Media Group Ltd
  Acting for Granada Media Group Ltd in an action for breach of contract and infringement of copyright.
- HM Stationery Office v. Automobile Association Ltd
  Acting for Automobile Association Ltd in HM Stationery Office v. Automobile Association Ltd (and related actions) in a Chancery action for infringement of copyright which included the consideration of a competition law defence.
- Farmers Build Ltd v. Carier Bulk Materials Handling Ltd [1999] RPC 461 (CA)
  Acting for the Respondent on appeal in Farmers Build Ltd v. Carier Bulk Materials Handling Ltd in an action for infringement of unregistered design right.
- Film and television industry Copyrights Disputes
  Advising members of the film industry in relation to: a variety of copyright disputes including consideration of the question of infringement by communication to the public over the internet and devices and services designed to circumvent technological measures applied to copyright works; and contractual interpretation as to the scope of licence agreements.

Breach of Confidence

- Trappit SA (&Othrs) v. GBT Travel Services UK Limited
  Acting for Trappit SA in a claim for breach of confidence and copyright infringement in relation to a computer software product.
- Ciccone v. Associated Newspapers Ltd
  Acting for Associated Newspapers Ltd in Ciccone v. Associated Newspapers Ltd in an inquiry as to damages for breach of privacy/misuse of private information and infringement of copyright.
- United Pan-Europe Communications NV v. Deutsche Bank AG
  Acting for Deutsche Bank AG in United Pan-Europe Communications NV v. Deutsche Bank AG in an action for breach of fiduciary duty and breach of confidence in the context of a bank/client relationship.
- Optimum Solutions Ltd v. The National Grid Company & Others
  Acting for The National Grid Company plc in Optimum Solutions Ltd v. The National Grid Company plc in an action for breach of contract and confidence in the context of the electricity industry.

Database Rights

- The British Horseracing Board Ltd v. Eurobet UK Ltd
  Acting for Eurobet UK Ltd in an action for infringement of database rights which involved a counterclaim under the Competition Act 1998.

Patents

- Actions Relating to Stents
  Acting for the patentee in Chancery actions relating to stents (see [2000] RPC 631 (CA) and [1999] RPC 47) and angioplasty balloons including a reference by the Court of Appeal to the ECJ arising out of an application for an anti-suit injunction in the United Kingdom where cross-border relief was being sought in the Netherlands.
- Aumac Ltd's Patent [1996] FSR 843
  Acting for the patentee in relation to an appeal arising out of a See v. Scott-Paine order in Aumac Ltd's Patent.

Inquiries as to Damages

- Experience Hendrix LLC v. The Times Newspapers Ltd [2010] EWHC 424 (Ch)
  Acting for The Times Newspapers Ltd in an inquiry as to damages for infringement of copyright.
- Ciccone v. Associated Newspapers Ltd
  Acting for Associated Newspapers Ltd in Ciccone v. Associated Newspapers Ltd in an inquiry as to damages for breach of privacy/misuse of private information and infringement of copyright.

- **Spiralstem Ltd v. Marks & Spencer plc**
  Acting for Marks & Spencer plc in an action for infringement of unregistered design right and the subsequent inquiry as to damages.

Other Notable Cases

- **Virgin Enterprises Limited v. Brightline Holdings LLC [2023] EWHC 2240 (Comm)**
  Acting on behalf of Virgin Enterprises Limited in an action relating to breach of a trade mark licence agreement. The Commercial Court handed down a judgment in favour of Virgin Enterprises Limited.
- **Toth v. Emirates**
  Acting for Emirates in Toth v. Emirates in an action seeking declaratory relief arising in the context of a determination under the Nominet UK dispute resolution service that the registration of emirates.co.uk should be transferred from Mr Toth to Emirates [2011] FSR 39; and on appeal to the High Court [2012] FSR 26 and [2012] EWHC 576 (Pat). The case considered, as a matter of principle, the ability of a party to challenge in the Courts a determination under Nominet UK's dispute resolution service. In addition issues relating to allegations of bias on the part of a member of the panel appointed by Nominet UK were determined.
- **easygroup IP Licensing Ltd v. easyJet Airline Co Ltd**
  Acting for Easyjet Airline Co Ltd in easygroup IP Licensing Ltd v. easyJet Airline Co Ltd in an action relating to a brand licence.
- **World Wide Fund for Nature v. World Wrestling Federation Inc [2003] IP&T 98 (CA) and [2001] IP&T 1320**
  Acting for the World Wrestling Federation in World Wide Fund for Nature v. World Wrestling Federation Inc in a Chancery action which considered whether an agreement between the parties in settlement of intellectual property disputes amounted to a restraint of trade.
- **Mattel Inc v. RSW Group plc [2005] FSR 5**
  Acting for Mattel Inc in Mattel Inc v. RSW Group plc in an appeal from a preliminary finding by a costs judge that it was disproportionate to employ London solicitors in an action for trade mark infringement in relation to counterfeit goods that were the subject of a search and seizure order when the Defendant was based in Manchester.

What the Directories Say

"I really like Emma Himsworth. She has been good to work with. She is decisive and good on her feet." "She undoubtedly knows her law and is a good judge of the merits of the cases she has. I would trust her judgement; she has the ear of the court in a quiet and measured way." "She is very responsive, careful, considerate, strategic, very mindful of costs and very pragmatic. She is very precise." (Chambers & Partners 2026, Intellectual Property)

"Emma is a leader in her field, with a real eye for detail and commercial and pragmatic approaches to issues." (Legal 500 2026, Intellectual Property)

"Emma is brilliantly forensic with devastating, immaculately plotted cross-examination." "Emma is magnificent and has vast knowledge of trade mark law. She is extremely good in court with precise and convincing advocacy where she is never rattled." "Emma is very impressive and user-friendly." (Chambers & Partners 2025, Intellectual Property)

'Emma is a star. She is on top of the detail, client-friendly, collaborative, and a calm and incisive presence in court.' (Legal 500 2025, Intellectual Property)

"Emma Himsworth KC is excellent and approachable. Her advice is clear for the clients. She cuts through complicated issues really easily." (Chambers & Partners 2024, Intellectual Property)

"Emma Himsworth KC is super intelligent. She is very concise in how she approaches her work and very good with the clients. It was an education to work with her. I learnt a lot from how she approached things." (Chambers & Partners 2024, Intellectual Property)

"Emma comes at the dispute from a client perspective and breaks things down very clearly. She is all over the detail and is truly an expert in soft IP. She speaks in a manner that is understandable and resonates well with the client." (Chambers & Partners 2024, Intellectual Property)

"What is good about Emma is that she is commercially inclined, excellent on her feet, a good communicator and a very safe pair of hands." (Chambers & Partners 2024, Intellectual Property)

"Emma is one of the best trade mark barristers. She is very hard-working, straightforward, and always willing to make herself available for queries." (Chambers & Partners 2024, Intellectual Property)

'Emma is a delight to work with – she's very client friendly and a real team player.' (Legal 500 2023, Intellectual Property)

"Emma is incredibly rigorous and very knowledgeable. If she gives a view on something, you know that she will have thought of everything."(Chambers & Partners 2023, Intellectual Property)

"She's very knowledgeable and is always very prepared. If you're against her, you can't assume that she will miss something, because she won't." (Chambers & Partners 2023, Intellectual Property)

"She knows what she wants to achieve and is good at pinpointing what the difficulties of the cases are. She is very calm and very precise, and is therefore very authoritative." (Chambers & Partners 2023, Intellectual Property)

"She is very bright, knows the law inside out and is good at applying it." "She is great with clients and has encyclopaedic knowledge." (Chambers & Partners 2020, Intellectual Property) *' She is one of the very best trade mark experts at the Bar, with an easy style and encyclopaedic knowledge .'* (Legal 500 2020, Intellectual Property)

"She is thorough and thinks around the issues. Her in-depth knowledge of trade mark law makes her a go-to person in the field. Her communications are always clear and reasoned and she is always quick to respond." (Chambers & Partners 2019, Intellectual Property)

'A ferociously hardworking barrister and trade mark law guru.'(Legal 500 2018, Intellectual Property)

"She is patient, hard-working and manages client expectations well." "She is encyclopaedic on trade mark law and you can have absolute confidence in her opinion." (Chambers & Partners 2017, Intellectual Property)

'She has an encyclopaedic knowledge of trade mark law and procedure.' (Legal 500 2016, Intellectual Property)

'Celebrated for her authoritative command of trade mark law and her forceful advocacy. She is currently working on some of the leading trade mark cases of the day, and is also expert on copyright. "Extremely impressive, intelligent, effective and supremely well prepared." "Intellectually rigorous and has an amenable manner."' (Chambers & Partners 2016, Intellectual Property)

'Has a deep understanding of trade mark law, and very much makes herself part of the broader case team.' (Legal 500 2015, Intellectual Property)

"Technically excellent and has impressive knowledge of very recent case law. She's also extremely approachable and responsive." "Always thinking of different angles rather than just a straightforward analysis; she's a very good person to bounce ideas off."' (Chambers & Partners 2015, Intellectual Property)

'Her media practice benefits from her encyclopaedic knowledge of trade mark law.' (Legal 500 2014, Media and Entertainment)

Awards

Legal500 LEADING SILK 2025

2027 Chambers Top Ranked UK Bar One Essex Court

ONE ESSEX COURT

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