
**PROTECTING YOUR INTELLECTUAL
PROPERTY IN SCOTLAND**
A HANDY GUIDE



An introduction

Intellectual Property (IP) is often the most important and valuable asset of a business. IP exists in many forms such as brand names, inventions, manufacturing processes, confidential information and product or industrial designs. Taking steps to identify IP assets and then protecting and enforcing the rights in these is vital to maintain and enhance their value and competitive edge.

Scotland is an independent legal jurisdiction within the UK with its own court system which offers a friendly and efficient venue for IP owners to enforce IP rights and to resolve IP disputes.

Although IP law is in essence the same in Scotland as in the rest of the UK, there are key differences in Court enforcement practices and procedures. There are designated Scottish IP judges and distinct commercially focussed IP court rules.

“They were responsive, commercially savvy and provided a fabulous service.”

Chambers UK

In many cases of IP infringement, Scotland will be the only or the most appropriate jurisdiction in which to take action. However, it can also be the optimum UK forum for ensuring that all IP infringements are identified and stopped. It is important IP owners and their advisers are aware of and consider Scotland as a valuable dispute forum.

Scotland's tactical and commercial Benefits

There are many potential tactical and commercial advantages to enforcing IP rights in Scotland. Some of the main advantages are as follows:

Wider protection

A Scottish court can deal with IP infringement if:

- the infringer is based in Scotland;
- has a place of business in Scotland;
- or the infringing activity is taking place or is threatened to take place in Scotland.

The Scottish Courts can also deal with validity challenges to UK and European registered IP (such as trade marks and patents), regardless of the main business address or domicile of the parties. It is important to note that if the infringer has its registered office in Scotland, any order of the Scottish court has automatic effect throughout the UK and, depending on the nature of IP in question, possibly throughout Europe too.

By way of comparison, an English Court order obtained against a Scottish based infringer will not automatically stop infringing activities in Scotland and will have no legal impact in Scotland or at all without a separate action or registration procedure.

Interim interdict

It can be quicker, easier and less costly to obtain an interim interdict (the Scottish term for an interim injunction) in Scotland than in England. These are key weapons in the fight against IP infringers, often leading to a swift global settlement.

In certain circumstances interim interdicts can be granted without advance notice to the alleged infringer. There is also no requirement to give contractual cross undertakings as a pre-condition for grant of interim interdict or to file detailed witness statements, which can reduce costs.

There is no equivalent to the English pre-action protocols in Scotland and the Scottish courts do not order “speedy trials” as an alternative to an interim interdict.



No automatic disclosure

There is no automatic discovery or disclosure of evidence. The scope of any disclosure is usually narrow, optional and by application. This can offer significant time and cost savings.

Efficient IP case management court rules

There are specific case management rules for all IP court actions raised in the Court of Session. These rules aim to make litigation as swift and as cost efficient as possible. The judge has very wide discretion and powers from an early stage in proceedings (within two weeks after first defences are filed there will be a case management hearing) to quickly focus the real issues in dispute and move the case towards a swift final hearing.

Specialist IP judges and barristers

The Court of Session in Scotland has designated IP judges. These judges have built up broad experience in resolving all forms of IP disputes and they have developed a track record of delivering commercial and common sense rulings. A number of senior and junior IP barristers (Counsel in Scotland) have also developed significant IP experience.

Caveats

Caveats are inexpensive and can be filed in the Scottish Courts to give parties advance notice of interim orders such as interim interdicts being granted against them in Scotland without notice. A registered caveat will give the party's lawyers a short period of notice to appear in court and argue against the interim order being made.

“A great firm which has retained its Scottish focus and is respected by local industry”. “Robert was extremely responsive, very quick, and a pleasure to work with.”

Chambers UK

We recommend that all businesses which have offices or a business presence in Scotland, should maintain appropriate caveats to avoid getting caught out by a surprise interim order. Caveats should be filed where there is any hint of a dispute with a Scottish connection.

Often parties outside of Scotland may have engaged in pre-action correspondence about a dispute and parties are caught out by the grant of an interim interdict, in the absence of a caveat being filed.

Publicity

Taking court action in Scotland generally attracts less publicity than other jurisdictions. This can be advantageous if a party wishes to minimise any press coverage of raising an action and it can operate “under the radar”.

“Robert Buchan and his team are extremely supportive and have a friendly, collaborative way of working with the client. Always considering the commercial interest of the client when giving business relevant legal advice.”

Marion Horwood, Litigation Manager,
PRS for Music Ltd

Surprise element

Taking court action in Scotland may take the infringer by surprise and force them to litigate in a court which is not familiar to them, which may encourage a swifter resolution.

Costs

The cost of issuing a Scottish Action in the Court of Session is approximately £300 no matter the value of the claim and the level of adverse costs exposure are generally around 50% of the other party's costs.



Key contacts



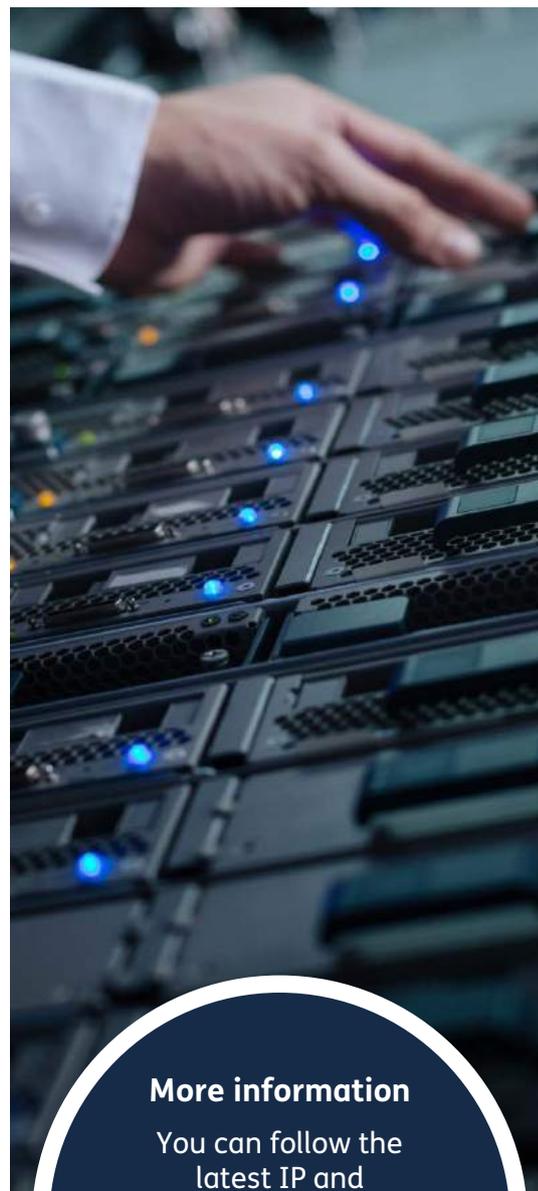
Robert Buchan
PARTNER
+44 (0)131 656 0078
robert.buchan@brodies.com



Andrew McWhirter
SENIOR SOLICITOR
+44 (0)131 656 3711
andrew.mcwhirter@brodies.com



Cara McGlynn
SOLICITOR
+44 (0)131 656 0121
cara.mcglynn@brodies.com



More information

You can follow the latest IP and technology developments on our blog
techblog.brodies.co

“They are exceptionally strong in terms of technical knowledge and the practical application of the law, and they present their advice in a way which is client friendly and easy to understand. Their focus is on resolving disputes, not just fighting, and they avoid escalation where it makes sense to do so.....” Robert gets straight to the heart of the case, he presents commercially focused advice and his dedication to clients is amazing.”

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