



## JOHN COLDHAM

### Partner

UK Head of Brands and Designs

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Speaks: English

Winner: 2019 - Client  
Choice Award 2019

Qualified: 2005 - Solicitor of  
England & Wales

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Primary office: London

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## John Coldham

John Coldham is the UK Head of Brands and Designs. The team is the MIP Designs Firm

of the Year 2020, having also won the award in 2019, and was nominated for the Trademark Contentious Firm of the Year award.

John is a recognised expert in all types of intellectual property (IP) strategy and litigation. He won the Client Choice Award 2019 for Designs, and has been recognised as a 'star lawyer' by the Acritas Stars database each year since 2017. John also has MIP's 'IP Star' status in both trademarks and designs.

Legal 500 has described John as attracting "praise for his 'practical, commercial perspective, innovative solutions to problems, and straightforward advice'", as well as being a "great negotiator" and an "expert in the design field and a go-to person for design disputes". Ranked in the silver tier of the prestigious WTR1000 listing, it says that "John's extreme efficiency and litigation prowess is well recognised". WTR1000 has also described John as achieving "excellent outcomes around trademark and design infringement issues and does so in a way that minimises the costs involved. He is highly practical and does not sit on the fence - he gives you a good steer" and that "John is "rapidly cultivating his reputation as one of the leading design rights experts in Europe".

John's priority is to help clients to maximise the return on their investment in their IP, through strengthening their portfolio and strategically enforcing it against infringers. IP arises through investment in business, whether it is in development of new products or services, new packaging or new marketing approaches and branding. As a result, IP is often what distinguishes one business from another and makes it a success. John advises clients on how this investment can be protected through registered and unregistered rights, and works with them to ensure that infringement of their IP is managed in the most commercially appropriate manner.

John works closely with clients to ensure that they are getting the most out of their investment in their business - be that in the brand, the R&D or the design elements. By taking time to ensure he really understands the commercial importance of different aspects of the business, he helps clients ensure that budgets are used in the most cost-effective way, with a constant eye on the commercial objectives.

Whether the budget is big or small, every client has the same wish - that it is spent effectively and responsibly while obtaining the best possible result. Our team has spent a lot of time considering costs of litigation and we pride ourselves on our accurate and competitive estimates.

John's experience covers cases big and small, from running multi-jurisdiction litigation across multiple rights, to smaller cases in the Intellectual Property Enterprise Court.

Clients from around the world trust John's sensible, considered advice, and praise his commercial nous.

John is also very involved with IP policy, particularly in the area of designs, where he has particular experience. He chairs the Design and Copyright Committee of the Chartered Institute of Trademark Attorneys (CITMA), as well as being an active member of similar committees at MARQUES, IP Federation, and the Chartered Institute of Patent Attorneys (CIPA). John's expertise led to him being invited to become a Fellow of the RSA.

“ A "practical" lawyer who "seeks optimal solutions to issues".

IP STARS 2018 edition, Managing Intellectual Property

"He just knows everything, he can answer any questions that we have about IP. Always available and happy to just to be that person to pick ones brains and pragmatic, commercial advice."

Acritas Stars

"He understands the market, he's very pragmatic, and he's technically brilliant."

Acritas Stars

## Highlights

- Advising Unilever in relation to its emergency injunction against the British National Party was a day that stands out. John obtained instructions at 11 o'clock that the British National Party had released a party political broadcast online that featured a picture of a jar of Marmite in the corner throughout (without permission), and the party was due to air its broadcast on national television the following day. Within a few hours John was in court, having tried to negotiate with the party but not obtaining the necessary assurances. After a detailed hearing involving analysis of a number of discrete issues, the High Court ordered the injunction, which was served shortly afterwards. Press analysis described the case as an example of "best practice".
- Advising Dyson in relation to dispute involving its registered design in its original cylinder vacuum cleaner at the High Court and Court of Appeal. The case is often cited as precedent in other design law cases.
- Acting for Hasbro in a major brands dispute involving the Play-Doh trademark. The case was particularly hard-fought, and this was a highlight not just because it was hugely successful for the client but also because it drew out the best in everyone in the team despite the sometimes extremely long hours!
- Advising JTI on a major multi-jurisdictional patent dispute about electronic cigarette technology.
- Securing a major victory for G-Star Raw in a High Court design right case.

## **Clients**

John works with clients across a number of sectors, from tech start-ups to global manufacturers of fast-moving consumer goods. John acts for clients in consumer electronics, food and drink, retail, high end design, fashion, technology, and the services sector to name just a few.

## **Experience**

John advises clients in relation to a variety of areas from building brands and strengthening portfolios to litigation and from small enforcement issues to complex multi-national disputes. John's particular focus is on designs and brands law.

## **Designs**

- Design law is becoming an increasingly popular way to stop infringers. Registered designs are very cheap to acquire, and even where there is no registration, unregistered rights are often available and can be very successful at court.
- John helps clients understand the choice of rights available, and the advantages and disadvantages of each, and works with them to secure the best portfolio for their needs.
- If clients then experience infringement of their rights, John has significant experience of enforcing designs at every level, from informal resolution through correspondence through to major litigation through the Intellectual Property Enterprise Court, the High Court and Court of Appeal.

## **Brands**

- Brands are often the core of a business, especially if it is consumer facing. Damage to the brand can affect the entire success or failure of a product or the business itself.
- John has worked with numerous clients over the years to ensure that their brands are sufficiently protected both in the UK and overseas, and has advised many of them in relation to enforcement of their rights against infringers, from small-scale copycats to major threats to the brand itself. Many disputes are resolved rapidly and commercially, whereas others require full court proceedings in order to obtain the necessary result. John has significant experience of both these extremes (and many in the middle!).
- John's experience includes working with a number of businesses to build a strong brand portfolio.

- John's litigation experience includes acting for Hasbro in relation to a significant (and successful) trademark infringement action over its Play-Doh trademark, and obtaining an emergency injunction for Unilever's Marmite brand against the British National Party.

## Patents

- Patents require an aptitude for the technical detail and an understanding of what is really important in an invention. John acted for Dyson in relation to a major patent dispute with Samsung, concerning dust separation in a vacuum cleaner, resulting in victory at trial.
- John's other patents cases have covered everything from deep sea drilling equipment to snap-fit flooring to the technology behind ADSL broadband. Clients appreciate John's experience in fighting hard to win a case while always keeping a close eye on the commercial strategy that underpins the issue to ensure the litigation does not lose sight of its original objectives.

## Expertise

Tech

Intellectual Property

Trademarks, Brands & Designs

Intellectual property and disruptive technology

## Career & Recognition

**2020**

May

Acritas Stars 2020

May

Managing Intellectual Property 2020 - IP Stars - Design

May

Managing Intellectual Property 2020 - IP Stars - Trademarks

World Trademark Review 1000

**2019**

World Trademark Review's 2019 - Enforcement and litigation

Acritas Stars 2019

Winner, Client Choice Award 2019

Expert Guides: Rising Stars 2019

**2018**

May

Gowling WLG (UK) LLP, partner

Expert Guides: Rising Stars 2018

Acritas Stars 2018

**2017**

Acritas Stars 2017

**2016**

Gowling WLG (UK) LLP, director

**2014**

Wragge Lawrence Graham & Co, director

**2005**

Qualified, Solicitor of England & Wales

Bristol University, Diploma in Intellectual Property Law and Legal Practice

Wragge & Co LLP, associate

**2003**

Lovells, trainee solicitor

**2002**

Oxford Institute of Legal Practice LPC

**1998**

University of Oxford, Jurisprudence (2:1 BA (Hons))