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**WIPO LIST OF NEUTRALS**

**BIOGRAPHICAL DATA**

Dawn OSBORNE  
McCarthy Denning  
London  
United Kingdom



Nationality: British

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**EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS**

Trent Law School, 1989-90;  
Magdalen College, Oxford University, 1986-89;  
Archbishop Blanch, Liverpool Girls' College, 1979-86.

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**LANGUAGES**

English

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**PRESENT POSITION**

Partner, McCarthy Denning.

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**PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION**

Partner, UK intellectual property firm, Palmer Biggs Legal, 2009-2018;  
Partner Rouse Legal (formerly Willoughby & Partners) 2000-2009;  
Solicitor, Rouse Legal (formerly Willoughby & Partners) 1996-2000;  
Solicitor, Denton Hall, 1992-1996;  
Trainee, Denton Hall, 1990-1992.

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**MEMBERSHIP IN PROFESSIONAL BODIES**

Director of Federation Against Software Theft;  
January 9, 2020

34, chemin des Colombettes, 1211 Geneva 20, Switzerland  
T +41 22 338 82 47 F +41 22 740 37 00 E [arbitrator.neutrals@wipo.int](mailto:arbitrator.neutrals@wipo.int) W [www.wipo.int/amc](http://www.wipo.int/amc)

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Chair of Fast's Legal Action Group FLAG;  
International Trade Marks Association, Currently on Bulletin Committee. When on ADR Committee received award for outstanding contribution and service for the advancement of the organization through a worldwide program of mediation seminars;  
The Law Society.

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### AREAS OF SPECIALIZATION

Intellectual property rights, internet law, on-line trading, cyberspace; entertainment, e-commerce, fashion, jewellery and watches, luxury goods, media and advertising, publishing, information technology and multimedia, merchandising.

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### EXPERIENCE IN INTELLECTUAL PROPERTY

General trade mark, copyright, passing off, design, breach of confidence/privacy litigation and contentious advice for large entertainment, luxury goods, fashion, jewellery, watch, music industry, retail and design software companies;  
Advice and preparation of oppositions/evidence in relation to U.K. trademark registrations and oppositions, and Community Trade Mark oppositions and invalidity actions;  
Advice on creation, registration, protection, duration, use, licensing and merchandising of soft intellectual property rights; Anti-counterfeiting campaigns including trading standards and customs work, i.e., in relation to a major film, literary and artistic works of a famous author, cartoon characters, children's television characters, tattoos, sports and major sporting events involving copyright, trademark and passing-off advice, and many civil infringement actions;  
Training covering all aspects of soft ip and alternative dispute resolution;  
Experienced speaker on intellectual property matters, including internet law and domain names, IP in the fashion industry and Mediation.

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### EXPERIENCE WITH RESPECT TO DOMAIN NAMES

Domain name court litigation including the Pitman case to interlocutory stage and the Prince case;  
Obtaining *ex-parte* injunctions against domain name cyber-squatters;  
Obtaining domain names back for clients;  
Preparing complaints for and dealing with conduct of domain name dispute resolution proceedings;  
Longstanding Panellist and Expert for the WIPO and NAF UDRP, LRO, .xxx, Nominet and .eu Domain Name Dispute resolution proceedings.  
Advising in relation to new TLDs.

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### MAJOR PUBLICATIONS

Major contributor to the UK Chapter of Domain Name Handbook published by Oxford University Press;  
Topical articles in E Commerce Law and Policy and case reports for E Commerce Law Reports;  
Many articles in the field of IP and Internet law including: Article in EIPR covering domain names, the .com and .co.uk registries, the Pitman and Prince cases and advice on registrability of domain names;  
Review of Pitman case in *Entertainment Law Review*; Series of three articles in *NetNames* newsletter covering domain names, including discussion of One in a Million case; Articles in *CIPA Journal* and *Trade Mark World* re Montblanc/Sepia case and contribution to an article about this case in *The Lawyer*; Appearing on TEN training video to discuss the Montblanc/Sepia case and celebrity privacy cases.

Article in *Journal of Intellectual Property Law and Practice* on User Generated Content;  
Article in *In House Counsel* on Keywords.

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## EXPERIENCE IN COURT LITIGATION

Acting successfully for clients in the Court of Appeal;  
Frequent soft IP litigation successes in Intellectual Property Enterprise Court (formally the Patents County Court);  
Advice and litigation relation to the Internet, i.e., advice re new TLDs and domain name infringement and management, on jurisdiction, infringement of rights in content; service provider liability;  
Successfully defending Woolworths against criminal trade mark prosecution for use of a three lions logo on a football shirt;  
Conduct of the Montblanc v. Sepia case, successful at trial for Montblanc in an action for trademark infringement and passing off. Also obtained a judgement that the Montblanc White Star logo was well-known;  
Involved in the Penguin/Puffin trademark passing-off litigation from discovery through to trial. As a result of this litigation, Rouse Legal (formerly Willoughby & Partners) won the Legal Business Award for the best intellectual property information technology firm of the year;  
Successful defence of Impact Executives against action brought by Impact Plus; Successful appear to the Appointed Person to prevent registration of the names of the two premier Irish Political Parties as a trade mark in the UK by a third party; Successful defence of David Van Day from interlocutory application seeking to prevent him using the Bucks Fizz mark;  
Successful cancellation of third party registered designs for Star Trek uniforms for Paramount;  
Involved in the collation of evidence for the Swiss Chalet passing-off case including giving evidence at trial;  
Advice and action preventing parallel imports following recent ECJ case law;  
Advice and litigation relating to new technologies; the taking of names and addresses without license from databases; recolourisation of animation by computer means; major sporting organization taking action to prevent its emblems, posters and trophies being reproduced in a multimedia game;  
Involved in the preparation of Halifax Building Society v. Halifax Insurance Services case to trial;  
Copyright disputes in relation to a wide variety of types of works including work with an international element, i.e., advice to U.K. users of foreign works and giving evidence on UK copyright law for US proceedings;  
Personality rights advice, i.e., to an American producer who wanted to stage a musical about a famous American singer in the United Kingdom;  
Trademarks disputes, i.e., advice to film companies and publishers who find that existing trademarks interfere with their merchandising plans;  
Passing off actions, i.e., on behalf of publishers and film companies who find other using their names or titles for profit;  
Advice in relation to breach of confidence, i.e., where an idea for a book has been stolen or passwords for private systems published on the Internet;  
Litigation over the copyright in the script of a major film;  
Advice as to fair dealing in the context of clips of the Olympics;  
Advice in relation to registration of a famous author's name as a trademark for books and similar advice in relation to registration of famous chess player's initials.

## COMMERCIAL

Film production and financing non contentious work, including examination of chain of title documentation; due diligence of recording and publishing contracts in relation to large scale acquisition of major international record company by another; litigation on behalf of a satellite television company relating to clauses in a transponder lease agreement.

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## TRAINING IN MEDIATION

Accredited Mediator for CI Arb.

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