

Simon Casinader

Partner

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OVERVIEW

Simon Casinader is a partner in the Intellectual Property practice. Before moving to London in 2018, Simon had previously worked in the Melbourne office since qualifying in 2012. Simon is an intellectual property (IP) lawyer with extensive experience in protecting and enforcing intellectual property rights on a global basis across multiple jurisdictions.

Simon's experience includes developing and enforcing global brand protection strategies on matters for trade mark, copyright and design owners, and providing contentious and non-contentious advice in relation to all aspects of intellectual property law. He has acted for a diverse range of international clients across the full spectrum of industries including fashion, luxury goods, retail, consumer products, sports, travel, hotels and leisure, food and beverage, art and design, architecture, media, technology, publishing, financial services and energy.

Simon works with his clients to prosecute, manage and enforce international trade mark and design portfolios and regularly advises on related clearance issues. His broad range of experience includes prosecuting UK, EU, Australian, New Zealand, and international trade mark and design applications as well as acting and appearing in contentious trade mark and patent opposition proceedings before the UKIPO, the EUIPO, IP Australia and IPONZ.

Simon has represented clients in legal proceedings concerning patent, trade mark, design and copyright infringement, passing off, unfair competition as well as the misuse of confidential information and trade practices cases before the High Court and the Intellectual Property Enterprise Court in the UK as well as the Federal Court of Australia and the Supreme Court of Victoria. Additionally, Simon has worked across domestic, regional, and global litigation, enforcement and arbitration matters.

Simon also assists client with a wide range of online conduct matters including the recovery of domain names registered in bad faith, eCommerce disputes and social media issues and he has specific experience in developing, managing and enforcing anti-counterfeiting campaigns and customs programs for clients.

The Legal 500 United Kingdom 2024 says: 'Simon Casinader is a very practical lawyer who works to understand and align with the business needs while providing excellent counsel' and 'Their business-minded approach combined with their experience and expertise is pure gold.'

ACHIEVEMENTS

- Recognised by *The Legal 500 United Kingdom* as a Recommended Lawyer for Intellectual Property: Trade Marks, Copyright and Design in London, 2024-2026
- Recognised as a Rising Star–London by *Managing Intellectual Property* IP Stars, 2022-2024
- Recognised as a Notable Practitioner–London by *Managing Intellectual Property* IP Stars, 2021
- Recognised as a Rising Star–Australia by *Managing Intellectual Property* IP Stars, 2018

PROFESSIONAL / CIVIC ACTIVITIES

- MARQUES - Copyright Team Member
- INTA Data Protection Committee Member
- The Chartered Institute of Trade Mark Attorneys member
- AIPPI member
- Anti-Counterfeiting Group member
- Member of the K&L Gates London office Diversity & Inclusion committee and LGBTQ+ Initiative Lead for the K&L Gates London office

SPEAKING ENGAGEMENTS

- Simon regularly presents at events, conferences and webinars on IP, advertising and consumer law and delivers client training in these areas.
- LawInSport Global Summit 2024 "*Commercialisation of Sport*" (October 2024)
- MARQUES Copyright Team Seminar "*Rights Clearance For Advertising Campaigns*" (March 2022, Barcelona)
- Anti-Counterfeiting Group Webinar "*Perspective of IP Rights Post-Brexit*" (September 2020, online)
- Simon was the runner-up in the 2014 Law Institute of Victoria Golden Gavel competition as well as a participant in the IPSANZ Victorian Christmas Moot 2014 and the 2015 Legal Comedy Debate (as part of the Melbourne International Comedy Festival).

EDUCATION

- Graduate Diploma in Legal Practice, College of Law, 2012
- B.S., Monash University, 2011 *(Chemistry)*
- LL.B., Monash University, 2011 *(Honours)*

ADMISSIONS

- Federal Court of Australia
- High Court of Australia
- Solicitor of the Senior Courts of England and Wales
- Supreme Court of Victoria

THOUGHT LEADERSHIP *POWERED BY HUB*

- 9 November 2026, Redesigning UK Design Law: The UK Government Responds to the Designs Consultation
- 23 April 2026, Artificial Intelligence and Copyright: Where Does the United Kingdom Stand?
- 27 November 2025, UKIPO Set to Increase Fees for the First Time in Years from April 2026
- 25 June 2025, Post-Sale Confusion Relevant to UK Trade Mark Infringement Cases but Supreme Court Overturns Court of Appeal in the Umbro Case
- 28 April 2025, Could This Be the Ai-nswer? A Collective Copyright Licence for Generative AI Training
- 17 March 2025, Make Protecting Your UK and EU Product Packaging and Labels Your New Year's IP Resolution. Part 2: Combatting Dupes and Copycats in the United Kingdom
- February 2025, Fashion Law Update–February 2025
- 22 January 2025, When Life Gives you Lemons….Thatchers Successful as Court of Appeal Finds Aldi Copycat Products Amount to Trade Mark Infringement in the UK
- 17 January 2025, Make Protecting Your UK and EU Product Packaging and Labels Your New Year's IP Resolution. Part 1: Protect Unique Packaging in the EU
- 20 September 2024, UKIPO Issues Guidance on Design Applications for Products Consisting of Multiple Components
- 3 June 2024, No Point Crying Over Spilled "Not Milk" – Distinctiveness Issues For Trade Marks In The Plant-Based Food Industry
- 30 May 2023, UK Supreme Court Judgment Finds Directors May Not be Liable for IP Infringement Without Knowledge of Essential Facts
- 17 April 2024, The UKIPO Updates its Policies to Tackle Ineffective Addresses for Service
- 14 February 2024, The UK Fails to Agree to a Voluntary Code of Practice for Copyright and Gen AI
- 6 February 2024, The Cloudy World of Look-a-Like Products–Aldi Successfully Defends Allegations of Trade Mark Infringement

- 9 January 2024, The Battle of the Bulls: NBA Fail to Invalidate Pizza Texas Bulls Trade Mark Similar to the Chicago Bulls Logo in the United Kingdom
- 16 October 2023, Dior's Foray Into Blockchain: Fashion and Digital Proof of Authenticity
- 7 July 2023, Just Because the Court Can, Doesn't Mean it Will: The Difficulty in Seeking to Avoid an Injunction Following a Finding of Copyright Infringement in the UK
- 5 May 2023, A Lidl Decision With Big Implications–UK High Court Finds That Tesco's Clubcard Logo Infringes Lidl's Logo
- 25 April 2023, Nothing More Than Empty Words: The Difficulty With Registering Slogans as Trademarks in the EU
- 23 December 2022, The Battle of the Supermarkets Vol. 2 – GINgle Bells, GINgle Bells, GIN All the Way
- 21 December 2022 , The ‘Standard' of Use Evidence in the EU – Advertising and Promotion Can be Enough to Show Genuine Use of a Service Without That Service Actually Crossing the Pond
- 19 December 2022, Trade Secrets: An International Perspective on Their Protection and Tips to Mitigate Disclosure Risk
- 12 December 2022, The Battle of the Supermarkets – Evergreening of Trade Marks and Potential Bad Faith
- 7 December 2022, Old Lady Shows Her Youth With Win in Significant Trade Mark Ruling Concerning NFTs
- November 2022, November 2022 Accolades
- 5 October 2022, Keep an Eye on Your Mailbox – Appoint a UK Representative for Trade Marks Filed Through WIPO
- 19 September 2022, Can Dawgs Free-Ride on Bulls – Interpretation of Unfair Advantage for UK Trade Marks
- 31 August 2022, Cadbury's Purple Reign: High Court Allows Cadbury to Register Their Iconic Purple Colouring
- 25 May 2022, Ronaldinho and Henry Marks Step Over Bad Faith Finding
- 7 February 2022, Name and Shame On Instagram – The ASA's New Tactic For Non-Compliant Influencers
- 2 February 2022, Snap! Marks and Spencer Tied Up In a Legal Dispute With Lacoste Over Its Iconic Trade Mark Crocodile Logo
- 8 December 2021, EUIPO 2 : AC Milan 0 – AC Milan Fails to Register Its New Club Crest in the EU
- 14 July 2021, "All Aboard" As Guerlain Departs From the Norm: The General Court of the EU Finds Distinctive Character in Boat Hull Shaped Lipstick Packaging
- 30 April 2021, Trademark Re-filing and Bad Faith – Go Directly to Jail. Do Not Pass GO, Do Not Collect $200 – Part Two: General Court Ruling

- 21 April 2021, British Amateur Gymnastics Association Rolls and Tumbles to Trademark Enforcement Against UK Gymnastics
- 16 March 2021, Riding on Coat-tails, Doesn't Come Free: UK High Court Awards Additional Damages for Oh Polly's Flagrant Infringement of House of CB's Unregistered Design Rights
- 6 January 2021, Battle of the Ballet Shoes: UK Court Finds Infringement of Registered Community Design
- 30 December 2020, Battle of the Bentleys: Bentley Motors Loses Trade Mark Appeal Against Bentley Clothing
- 23 November 2020, Not Such a Friendly Decision for Hugz: A New Development in Passing Off that Could Help Combat Fashion Copy-Cats
- 8 November 2020, Brexit and .EU Domain Names – A Warning for UK Registrants
- 4 November 2020, What an Awful Racket… Acoustic Product Trade Mark Case Provides Opportunity for Brands Being Piggy-Backed to Drive Search Traffic
- 28 October 2020, Putting Position Marks Front and Centre: CJEU Considers Assessment of Position Marks for Services
- 22 October 2020, Louis Vuitton Playing Chess or Checkers? The CJEU Annuls' the Invalidation of Louis Vuitton's EU Trade Mark
- 22 September 2020, Don't Bank-sy on Trade Marks: Banksy Loses EU Trade Mark Due to "Bad Faith"
- 21 September 2020, Reputation and Likelihood of Confusion – It's All a Bit of a Messi…
- 15 September 2020, A Right Royal Rejection: "Royal Butler" Trade Mark Application Denied in the UK
- 12 June 2020, Copyright Protection for Brompton's Folding Bicycle? CJEU Gives Green Light to the Possibility Across Europe
- 4 May 2020, "I Wanna Really Really Really Wanna… Take You to Court." VB Trade Mark Dispute Heads to the Federal Circuit Court in Australia
- 29 April 2020, After the CJEU's Decision Now There is a Final High Court Judgment in the Sky v SkyKick Case
- 26 April 2020, Is it a Bird? Is it a Plane? No, it's an Infringement of a Reputable Mark!
- 31 March 2020, COVID-19: UKIPO Declares “Interrupted Days” to Extend Deadlines
- 17 March 2020, COVID-19: EUIPO Extends All Office Deadlines; CJEU Restricts Operations But Time Limits Unchanged
- 3 February 2020, Cofemel’s First UK Outing – The Wooly World of Copyright and Designs
- 1 February 2020, Fashion Law - February 2020 Edition

- 29 January 2020, We have a decision in the Sky v SkyKick case… and the long-awaited CJEU's decision is good news for brand owners!
- 22 January 2020, Brexit: Implications for Your Business and its Relationship With the EU
- 19 December 2019, 'High' expectations for Cannabis trade mark 'hash'ed – Is EU trade mark law ready for Cannabis(TM)?
- 13 November 2019, To 3D, or not to 3D, that is the question: Another twist in the Rubik's Cube and its EU trade mark protection
- 21 October 2019, Sky v Skykick AG – is this the end of a claim for "computer software?"
- 16 October 2019, UKIPO knocks undefeated Reds off their perch – The LIVERPOOL trade mark and lessons for brand owners
- 11 September 2019, Trade mark re-filing and bad faith – Go directly to Jail. Do not pass GO, do not collect $200
- 20 August 2019, The Claridge's Affair: A win, but at what cost?
- 29 July 2019, The Scotch Whisky Saga: Where Name and Reputation is not enough
- 14 July 2019, Beauty and the Beast – A tale of (trade mark infringement) as old as time
- 20 June 2019, A figurative mark? A position mark? Or just a trade mark?
- 20 June 2019, "Three stripes and you're out!" – The EU General Court rules Adidas' three stripe trade mark invalid
- 31 May 2019, Fashion Law - May 2019 Edition
- 13 May 2019, Zara v Zara: The evolving world of "fashion"
- 24 April 2019, Iceland's trade mark nothing but a puddle
- 27 March 2019, Final Approval given to EU Copyright Directive
- 21 March 2019, Trademark, Design and Copyright Update For Fashion Brands
- 13 March 2019, Can the mere registration of company name infringe? In the case of BMW, yes!
- 18 January 2019, Supermac takes a bite out of McDonald's as it loses the BIG MAC trade mark in the European Union
- 1 October 2018, A No Deal Brexit – how will trade marks and designs look?
- 13 March 2018, Thunder Road toasts success in "Pacific Ale" case again (Stone & Wood's appeal dismissed)
- 29 September 2016, A dog of a trade mark dispute
- 12 August 2016, IP Australia Announces New Official Fee Structure For Australian Trade Marks

- 6 July 2016, New Balance Unsuccessfully Challenges Trade Mark Infringement Claim in China but Walks Away with a Significantly Reduced Liability
- May 2016, Chinese High Court Decision Confirms the OEM Exception to Trade Mark Infringement for the First Time
- 4 March 2016, Australia: Why Your 'Exclusive' Patent License may not Longer be Exclusive and What to do to fix it
- February 2016, 98 Million Reasons to Think About how you use Your Brand in China – The Risks of not Obtaining Proper IP Protection for Your Business in China
- 18 December 2015, The end for the Dallas Buyers Club Dispute and Speculative Invoicing? Or is it Just the Beginning.

OTHER PUBLICATIONS

- "The Business and Law of Fashion and Retail," International Issues, *Carolina Academic Press*, August 2020
- "Zara vs. *Zara*," *Ragtrader*, August 2019
- "Social Sense," *Ragtrader*, July 2019
- "A 'Spotlight' on copyright," *Ragtrader*, 1 March 2019
- "Slave, no more," *Ragtrader*, 1 January 2019
- "Social Butterflies," *Ragtrader*, 1 October 2018
- "Designed To Last," *Ragtrader*, 1 September 2018
- "Drawing Parallels," *Ragtrader*, 1 August 2018
- "Owning your domain," *Ragtrader*, March 2018
- "Cash for comment," *Ragtrader*, June 2016
- "The online dilemma," *Ragtrader*, August 2015
- "Wait, that's mine!" *Ragtrader*, July 2015

NEWS & EVENTS

- 3 August 2026, K&L Gates' Global IP Practice and Lawyers Recognized in *Managing IP's* 2026 "IP Stars" Rankings
- 29 January 2026, *World Trademark Review 1000* Recognizes K&L Gates IP Lawyers as Trademark Leaders in 2026 Edition
- 3 October 2025, K&L Gates' Global IP Practice, Lawyers Earn Rankings in Managing IP's 2025 "IP Stars"

- 25 March 2025, K&L Gates' IP Practice Recognised in *World IP Review*'s 2025 UK Trademark Rankings
- 4 February 2025, *World Trademark Review 1000* Recognizes K&L Gates IP Lawyers as Trademark Leaders in 2025 Edition
- 7 October 2024, K&L Gates' Intellectual Property Practice, Lawyers Recognized in 2024 *Managing IP* Magazine's "IP Stars"
- 2 January 2024, K&L Gates Names Nearly 30 Partners, Government Affairs Advisors Across Firm
- 23 October 2023, K&L Gates' Intellectual Property Practice, Lawyers Recognized in 2023 *Managing IP* Magazine's "IP Stars"
- 6 October 2022, K&L Gates Recognized in 2022 *Managing IP* Magazine's 'IP Stars'
- 3 June 2021, K&L Gates Lawyers Ranked as 2021 'IP Stars' by Managing IP Magazine

AREAS OF FOCUS

- IP Procurement and Portfolio Management
- IP Litigation

INDUSTRIES

- Apparel and Footwear
- Consumer Goods and Services
- Fine Art and Cultural Property
- Food, Beverage, and Agribusiness
- Luxury Products and Fashion
- Media and Entertainment
- Sports
- Technology
- Video Games and Immersive Technology

REPRESENTATIVE EXPERIENCE

- Representing an American athletic footwear and apparel corporation on all design matters in the UK, including advising on design strategy for three of its business units, and managing the design portfolio and enforcement programs for the company - one of the largest of its kind.

- Representing leading consumer brands in anti-counterfeiting and customs enforcement matters, and trade mark, copyright, design, and related proceedings before the UK High Court, Intellectual Property Enterprise Court, UKIPO, EUIPO Boards of Appeal, EU General Court, the Court of Justice of the European Union, and international courts.
- Advising AMAN Group, the leading global resorts and lifestyle company, on the management of its global IP portfolio, IP strategy, and global IP enforcement programs, in addition to various international hotel, restaurant, lifestyle, and product launches, including the highly publicised AMAN New York, JANU Tokyo and AIUa, the SVA Wellness Supplements range, and AMAN Essentials skincare, fragrances, and accessories.
- Advising Luxottica on its UK trademark and design matters, including enforcement and opposition matters relating to the iconic RAY BAN, OAKLEY, AVIATOR, and PERSOL eyewear brands.
- Advising a leading global software company on its international piracy and licence compliance enforcement programs, including enforcement and litigation in the UK, EU, Middle East, Asia, and South America.
- Advising on social media and influencer marketing issues for a range of clients, including drafting and negotiating influencer, brand ambassador, and endorsement agreements and advising on regulatory, policy, and IP issues on platforms such as Instagram, SnapChat, and TikTok.
- Advising Thomas Pink on the worldwide management of its IP rights, including licensing, brand and design protection, portfolio management, enforcement, and commercial projects.
- Acting for a kitchen and bathroom material retailer and manufacturer in relation to appealing two decisions of the Australian Trade Marks Office to the Federal Court of Australia.
- Acted for an Australian health and media personality in relation to trade mark registrations and infringement allegations.
- Acting for an Australian health food and beverage company to enforce its intellectual property rights throughout the world, which has included advising on a trade mark infringement action in Poland relating to an alleged infringement of one of its beverage trade marks.
- Advising fashion company Alexander McQueen in relation to filing a trade mark application for MCQUEEN which was opposed by Metropolitan Services Ltd, the owner of the CHRISTINE MCQUEEN trade mark. Alexander McQueen sought to cancel the CHRISTINE MCQUEEN trade mark for non-use. Alexander McQueen was successful on its appeal to the Federal Court of Australia and it was successful in having the CHRISTINE MCQUEEN trade mark removed for a number of goods and services. K&L Gates was ultimately successful in registering the MCQUEEN trade mark for Alexander McQueen.
- Advising a prominent Australian artist about the use of one of his paintings which was reproduced on a paint tin.
- Advising on major intellectual property litigation regarding alleged misleading and deceptive conduct, passing off, and trade mark infringement.

- Acting for clients in various online conduct matters, including recovering domain names registered in bad faith and filing complaints with Google to cease the unauthorised use of registered trade marks as Google AdWords.
- Advising a manufacturing company on various global trade mark matters.
- Acting for Seafolly in copyright infringement proceedings in the Federal Court of Australia, including a proceeding Seafolly successfully brought against Fewstone (City Beach) where Seafolly established copyright infringement in two fabric prints and an embroidery design applied to garments.
- Acting for SNF Australia in relation to Patent Oppositions in the Australian Patents Office, and patent invalidity and patent infringement proceedings in the Federal and High Court.
- Advising SNF Australia, an Australian company which manufactures chemicals used in water treatment (particularly mining), in relation to Patent Oppositions in the Australian Patents Office, and patent invalidity and patent infringement proceedings in the Federal and High Court. We have acted on various proceedings involving innovation and standard patents and patents of addition.
- Advising Factory X in relation to a trade mark infringement claim in the Federal Court of Australia brought against CupoNation GmbH.
- Acting for an Australian food container company in respect of design and trade mark protection strategies, IP portfolio management, and acting in a Supreme Court proceeding against its former distributor in the UK.