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SUMMARY OF PROFESSIONAL PRACTICE

Chambers of Mark Platts-Mills QC

Called to the Bar: 1978.

Appointed Queen's Counsel: 1996.

Fields of law: Intellectual property law, European Community law, and commercial and public law cases. Many high technology cases, with particular emphasis on computing and information technology, and the internet and electronic communications field; also extensive experience in biotechnology/genetic engineering/recombinant DNA cases. IP work includes patents, trade marks, copyrights, conditional access (decryption) rights, designs (registered and unregistered), database rights, and trade secrets and other confidential information.

Extensive EC law practice both within the intellectual property field and extending outside it to the free movement of goods and services, to EC based pharmaceutical, agrochemical and microbiological regulatory law as well as EC and EC-based national laws on data protection,

telecommunications, information society services (including law governing ISPs) and satellite broadcasting and communications. Telecommunications work includes cases under the Electronic Communications Code (formerly Telecommunications Code) relating to siting of masts and other communications equipment.

Courts and tribunals: Conducts cases in European Tribunals including the [European Court of Justice](#), Luxembourg, the [European Patent Office](#), Munich, Technical Boards of Appeal and Opposition Divisions. Appears in English [appellate](#) and [first instance](#) courts and tribunals, as well as [specialist private tribunals](#). Proceedings undertaken include High Court civil litigation (principally in the Chancery Division), injunctions, search orders (Anton Piller) and computer examination orders, judicial review proceedings in the Administrative Court, proceedings in the UK Intellectual Property Office, European Patent Office and OHIM, and and some specialist criminal cases.

Publications: Author of leading practitioner textbooks: [Russell-Clarke and Howe on Industrial Designs](#), Sweet & Maxwell, (1998 and 2005 Eds), and [Halsbury's Laws Title on Trade Marks](#) (1985, 1995, 2000 Eds), as well as numerous [articles in legal journals, and public lectures and seminars](#).

Education and industry experience: Degree in Engineering (Part I) and Law (Part II) at Cambridge University (Trinity Hall), where awarded the Baker Prize for Engineering; Bar Exams course at College of Law, London (awarded the ver Heyden Foundation Prize for advocacy, and Harmsworth Exhibition and Astbury Law Prize by the Middle Temple); worked as a commercial and systems software programmer for IBM and for a software house and have maintained interest in evolving computer technology.

CONTENTS:

- [EXAMPLE CASES AND FIELDS OF WORK:](#)

- [Satellite television](#)
 - [Music Broadcasting and Sound Recordings](#)
 - [Telecomms \(mobile, fixed line and networks\)](#)
 - [Internet](#)
 - [Software and Information Technology](#)
 - [Data protection](#)
 - [Free movement of goods and services in the European Union - pharmaceutical, agrochemical and other sectors](#)
 - [EC microbiological, foodstuff and plant variety regulatory laws](#)
 - [Biotechnology and recombinant DNA](#)
 - [Medical devices and technology](#)
 - [Defence industries, warheads and explosives](#)
 - [Architecture and structural drawings](#)
 - [CD and DVD replication, printing and packaging](#)
 - [Magazine publishing](#)
 - [Garments, textiles and carpets](#)
 - [Electronic consumer goods](#)
 - [Filtration, sieving and refining](#)
 - [Professional negligence and liability \(IP related\)](#)
 - [COURTS, TRIBUNALS AND JURISDICTIONS](#)
 - [European Court of Justice, Luxembourg:](#)
 - [European Patent Office, Munich:](#)
 - [Court of Appeal and House of Lords:](#)
 - [Overseas jurisdictions](#)
 - [Domestic and arbitral jurisdictions](#)
 - [PUBLICATIONS AND LECTURES:](#)
 - [Major publications:](#)
 - [Other publications and public lectures and seminars \(selection only\):](#)
 - [EDUCATION](#)
 - [PREVIOUS EMPLOYMENT](#)
-

EXAMPLE CASES AND FIELDS OF WORK:

Satellite television

(Underlining indicates name of the client.)

Football Association Premier League Ltd v. QC Leisure and others
Chancery Division (Kitchin J) [2008] EWHC 1411 (Ch); ECJ Case C-403/08. **Conditional access devices (satellite decoder cards) - Rights under section 298 CDA 1988 and the Conditional Access Directive 98/84/EC - Parallel importation of satellite decoder cards of non-UK satellite broadcasters and use in pubs - Free movement of goods and services under EC Treaty - Copyright and creation of transient copies of broadcast works inside decoder boxes - Reference to ECJ.**

FAPL purport to sell broadcasting rights for Premier League football matches on a territorially exclusive basis. The defendants were importers of satellite decoder cards issued by non-UK broadcasters and a number of publicans who used those cards to show foreign satellite broadcasts which include Premier League football matches. FAPL claimed entitlement under section 298 of the Copyright Designs and Patents Act 1988 ("apparatus for unauthorised reception of transmissions") to restrain importation, dealing and possession for commercial purposes of the foreign decoder cards. Section 298 transposes into UK domestic law the Conditional Access Directive 98/84/EC. FAPL also claimed copyright in certain films, artistic works and musical works included in the broadcasts of their matches and alleged that the creation of transient electronic copies of those works inside satellite decoder boxes when used in the UK would infringe their copyright. The defendants contended that section 298 and the Conditional Access Directive provide remedies only for pirate decoder cards and do not apply to parallel imported lawful cards; that enforcement of the rights claimed by FAPL would interfere with the free movement of goods under Articles 28-30 of the EC Treaty and the right to receive cross-border satellite broadcasting services under Article 49; and that FAPL's attempts to divide the common market into exclusive territorial zones and to prevent all competition between their licensees amounted to a breach of competition law under Article 81(1) EC. The trial judge (Kitchin J) has decided

to refer the questions of Community law to the European Court of Justice at Luxembourg, where the written observations have now been filed by the parties and the Member States. [Full Text of Judgment: Questions Referred to the ECJ.](#)

Football Association Premier League Ltd v. QC Leisure and others [2008] EWHC 44 (ch), Barling J, 18 Jan 2008. **Competition law - Division of common market into exclusive territorial zones for broadcasting of Premier League football matches - Parallel importation of satellite decoder cards of non-UK satellite broadcasters and use in pubs in UK - Free movement of goods and services under EC Treaty - Whether restrictions on export of decoder cards imposed by FAPL on licensees contrary to Article 81 EC.**

FAPL purport to sell broadcasting rights for Premier League football matches on a territorially exclusive basis, to different broadcasting organisations in different EC Member States. FAPL imposed contractual restrictions on its licensees requiring them to prevent the export from their territories of satellite decoder cards which gave access to broadcasts carrying FAPL football matches. The defendants were importers of satellite decoder cards issued by non-UK broadcasters and a number of publicans who used those cards to show foreign satellite broadcasts which include Premier League football matches. FAPL sought a strike-out or summary judgment dismissing a defence asserting that FAPL's restrictions breached Article 81(1) of the EC Treaty. Barling J dismissed the application, with the consequence that the pleaded defence went on to be considered on its merits at the trial of the action before Kitchin J (see above). [Full Text of Judgment.](#)

Murphy v. Media Protection Services Ltd [2007] EWHC 3091 (Admin), 21 Dec 2007 (Pumfrey LJ and Stanley Burnton J); and [2008] EWHC 1666 (Admin), 16 July 2008 (Stanley Burnton LJ and Barling J); ECJ Case C-429/08. **Dishonest reception of programmes without paying 'charge applicable to reception' - Criminal offence under section 297 CDPA 1988 - Appeal to High Court on case stated - Reference to ECJ.**

The defendant had purchased a satellite decoder card which gave access to

broadcasts by a Greek satellite channel called Nova. These broadcasts included live broadcasts of Premier League football matches which were simultaneously broadcast by Sky in the United Kingdom. The defendant used the Greek decoder card to show a live broadcast of a match in her pub. Sky's subscription would have been significantly higher than the charge which she paid to a dealer to obtain the Nova card. She was prosecuted and convicted by a magistrate and by Portsmouth Crown Court for dishonestly receiving a programme provided from a place in the United Kingdom without paying the charge applicable to reception of the programme. The High Court on appeal by "case stated" interpreted section 297 as a matter of UK domestic law as covering her acts; but postponed consideration of whether the section as so interpreted is in conflict with European Community law. On 16 July 2008, the Court (reconstituted after the death of Pumfrey LJ as Stanley Burnton LJ and Barling J) accepted that section 297 as interpreted in the previous judgment may conflict the rules of the EC Treaty on the free movement of goods and services and with the Conditional Access Directive (Directive 98/84/EC) and decided to make a reference to the ECJ at Luxembourg. The President of the ECJ has ordered that this case proceed as a joined case with *FAPL v. QC Leisure* (see above), and the written observations were filed with the Court in Luxembourg in February 2009. [Full Text of Judgment](#). [Questions Referred to the ECJ](#).

Pro Sieben Media AG v. Carlton UK Television Ltd [1999] FSR 610, Ct of Appeal. **Copyright in television broadcasts - Fair dealing defences.**

The Court held, reversing the trial judge, that the inclusion in a TV programme on the subject of "chequebook journalism" of a section from a programme on a German TV channel featuring Mandy Allwood (who had become pregnant with 8 foetuses) amounted to fair dealing for the purposes of reporting current events and of criticism or review. First instance judgment reported at [1998] FSR 43.

Music Broadcasting and Sound Recordings

Substantial experience of the enforcement of copyright in sound recordings and musical works by way of Anton Piller (search) Orders. Contractual disputes between creative people (artists, performers etc) and recording and broadcasting companies.

(Underlining indicates name of the client.)

Robin Ray v. *Classic FM PLC* [1998] FSR 622, Ch D (Lightman J).

Copyright - Master catalogue of musical tracks - Consultant - Ownership of copyright - Scope of licence under copyright did not extend to overseas radio stations.

The well known broadcaster and classical music expert Robin Ray compiled a catalogue of many thousands of CD tracks for Classic FM which formed the basis of its broadcast repertoire. Mr Ray compiled the catalogue under a consultancy agreement which was concluded when Classic FM's only contemplated broadcasting activity was its radio station in the UK.

Subsequently, Classic FM licensed its "format" including a playlist based on the catalogue to certain radio stations overseas. The Court rejected arguments that the catalogue was a work of joint authorship and that Mr Ray was acting as an employee rather than a self employed consultant, and held that Classic FM's implied licence under Mr Ray's copyright to use the catalogue compiled by him did not extend to making copies for the use of the overseas stations. Sadly, Mr Ray died not long after the trial, but the proceedings have since been settled on satisfactory terms.

Telecomms (mobile, fixed line and networks)

The convergence of traditional mobile and fixed line telephony with the internet and other networks has led to many new legal issues arising.

Advises on competition and IP issues arising on interconnection between the traditional telephone network and new internet based services such as VOIP (Voice over IP).

Currently conducting cases under the Electronic Communications Code (formerly the Telecommunications Code). This little known and surprising piece of legislation gives telecomms operators, including mobile telephone companies, certain compulsory purchase type powers to retain their masts on land even when their contractual lease or licence has run out or been validly terminated. Displacing these masts in order e. g. to make way for a redevelopment of a site may involve a complex case in which technical expert evidence is deployed to rebut assertions by

mobile operators that siting of a particular mast is essential to maintaining network coverage.

Example cases (underlining indicates the name of the client):

MMI Research Ltd v Cellxion Ltd and ors [2009] EWHC 418 (Pat).
Patent - Interception method for GSM mobile telephones.

A patent for a method of intercepting mobile telephone calls and identifying mobile phones on GSM and other digital cellular networks. Sales and demonstrations to government and law enforcement agencies made before the priority date were held to have been confidential and so not available to attack the validity of the patent. The patent was held to be non-obvious over the published prior art, and infringed by the defendant's system notwithstanding that it used a network "cell reselection offset" parameter to cause target mobiles to reselect to the interception device and not just raw transmitted power. [Full Text of Judgment](#);

Secretary of State for Education and Skills v Frontline Technology Ltd.
[2004] EWHC 1487; further judgment on amendment application
[2005] EWHC 37. **Patent - Radio network technology for student attendance registration.**

A patent action in which the Education Department sought to revoke a patent for a system of radio networking to allow attendance registration in schools. The wide claims of the patent were held invalid in the light of prior art, but a narrower claim more specifically focussed on the specific features of the patentee's radio network system was upheld.

British Telecommunications PLC v. Planet Telecom PLC and 192enquiries.com Ltd (Patten J, 14 March 2002). **Passing off - Directory enquiry services - Premium rate faxback forms - Order to put on disclaimers in form specified by the court.**

The defendants operated an internet directory enquiry service. They sent out large numbers of fax forms which invited recipients to fax back corrections to their directory enquiry details on a premium rate number. BT contended that substantial numbers of recipients would be confused by the forms and fax

them back in the belief that they were in fact correcting the information being given out on BT's 192 directory enquiry service. On an interim injunction hearing, Patten J applied *Sony v Saray* (see above) and ordered the defendants to include a prominent disclaimer of any association with BT in their fax forms.

Cable & Wireless PLC v. British Telecommunications PLC [1998] FSR 383. **Trade marks - Comparative advertising - Telephone tariff comparisons.**

A case concerning comparative advertising of telephone tariffs, in which it was alleged that the defendants had infringed the plaintiffs' trade mark by making misleading comparisons and so had used the mark "contrary to honest practices in industrial and commercial matters" (Trade Marks Act 1994, section 10(6)). The Court refused an interlocutory injunction.

Western Electric Ltd v. Racal-Milgo Ltd [1981] RPC 253. **Patents - Modems - Adaptive equalisation - Data scrambling.**

A patent case concerning adaptive equalisation of analogue telephone lines carrying computer modem signals, and digital scrambling of the signals. Both patents were held invalid on the grounds of insufficiency.

Codex v. Racal-Milgo [1983] RPC 369, Ct of Appeal. **Patent - Modem technology.**

Infringement of a patent relating to the form of signal used in computer modems and the apparatus used to encode those signals.

Internet

Many cases now involve the internet, which raises issues under different aspects of intellectual property law including trade marks and copyright. Regularly advises on the position of ISPs and other entities who host online materials uploaded by others on their position under the special defences under the E-Commerce Directive (Directive 2000/31/EC), as well as jurisdictional issues such as exposure to US law under the Digital

Millennium Copyright Act (DMCA).

Example cases (underlining indicates the name of the client):

Reed Executive PLC v. Reed Business Information Ltd and Reed Elsevier (UK) Ltd. [2004] RPC 767, Ct of Appeal. **Trade marks and the internet - Meta data, search engine optimisation and search keywords - Honest use of own name by company.**

A dispute between the well known high street employment agency business and the well known Reed Elsevier publishing group about the use of the trade mark REED on the internet primarily in recruitment and job advertising contexts. The Court of Appeal (Jacob LJ) gave important guidance on the law of trade mark infringement and the internet, particularly on "invisible" uses of trade marks such as in "metadata" and on the use of competitors' trade marks in search engines and as keywords to trigger advertisements. The appeal was successful in reversing findings of infringement and passing off against Reed Elsevier on all matters on which they appealed.

Reed Executive PLC v. Reed Business Information Ltd and Reed Elsevier (UK) Ltd. (No. 2) [2005] FSR 3 p16, Ct of Appeal. **Costs of appeal - Refusal by party to enter into mediation - Whether 'without prejudice' negotiations may be taken into account.**

The respondent sought to avoid paying the costs of Reed Elsevier's successful appeal because its offer to mediate had been rejected. However, its offer to mediate had been followed by substantial 'without prejudice' negotiations and Reed Elsevier successfully argued that the court could not conclude that its refusal to mediate was unreasonable without going into the substance of the without prejudice negotiations, which the court had no jurisdiction to do.

Software and Information Technology

Deals with intellectual property type disputes in the field of computer programs, software and information technology, which are mainly issues of copyright infringement or database right; also deals with pure contractual IT disputes bringing into play practical experience of having worked in the computer industry.

Example cases (underlining indicates the name of the client):

Nova Productions Ltd v. Bell Fruit Games Ltd [2007] EWCA Civ 219, 14 March 2007; first instance decision [2006] RPC 14 p379; [2006] EMLR

14. Copyright - Video games - Artistic copyright in generated images - Copyright in games software under EC Software Directive - Copying of software by creating program to generate similar outputs - whether capable of infringing.

The claimant created a successful video game called "Pocket Money" based on the game of pool. The defendants produced games also based on the game of pool called respectively 'Jackpot Pool' and 'Trick Shot.' The claimant was held entitled to copyright in artistic works consisting of the screen images or 'frames' generated by its game when played, and in the source code of the games program itself, but the game was held not to be entitled to copyright as a 'dramatic work'. It was held that certain elements of the defendants' games had been derived from Pocket Money, but that these elements were too general to amount to a substantial part of the claimant's copyright works. The Court of Appeal in a decision of wide ranging importance held that it could not be an infringement of copyright in a computer program to observe the program in operation and write a program which produces the same or similar outputs.

Net Online Ltd v. Job Depot Ltd (Pumfrey J, November 1999):

Computer software infringement action concerning internet and Lotus Notes based software for handling and matching CVs and job vacancies. The case was settled in the course of the trial.

Taylor v. Ishida (Pumfrey J, May 1999): **Patent - Automated packaging machinery - Software algorithms.**

Patent infringement action concerning packaging machinery, the movement of whose parts were controlled by algorithms implemented in software. The patent was held valid and infringed.

Ibcos Computers Ltd v. Barclays Mercantile [1994] FSR 275, Jacob J.

Copyright - Computer software - Proving copying - Program structure and substantial part.

Copyright in computer software for agricultural equipment dealers was held to have been infringed by the defendants. The Court expounded the principles applicable to deciding what degree of resemblance amounts to reproduction of a "substantial part" in this context.

Data protection

Advice on data protection issues is assisted by a good understanding of the technicalities of the underlying IT operations. By its nature, data protection work is largely advisory since very few cases actually come to court or the Information Tribunal (formerly Data Protection Tribunal). The case below is one of only a handful of data protection cases which have actually been heard in the High Court and Court of Appeal.

(Underlining indicates name of the client.)

Johnson v. *Medical Defence Union Ltd* [2007] EWCA Civ 262, 28 March 2007; (first instance judgment [2006] EWHC 1649, High Court, Chancery Division, 4 May 2006). **Data protection - Scope of 'processing' - Fairness - Information to be given to data subject.**

The claimant, a surgeon and long standing member of the MDU, was removed from membership without warning under an internal 'risk assessment' procedure, despite the fact that no claims for negligence had been made against him in the course of his career. He applied for and obtained copies of the files relating to this procedure under the Data Protection Act 1998. He brought this action to challenge the fairness of the way the MDU had processed his personal data and their failure to give advance notice to him that his personal data would be used in this procedure. The trial judge (Rimer J) held that the use of information about him in the risk assessment procedure was 'processing' under the Act, and that the MDU was in breach of the Act by failing to notify him that certain data obtained from third parties would be used in considering his case. However, the MDU were held entitled to operate a policy under which they considered simply the existence of allegations or

complaints in assessing risk and did not pay regard to their merits, and it was held that the Act did not entitle a data subject to question the fairness of that commercial policy. The Court of Appeal decided by a majority (Buxton and Longmore LJJ, Arden LJ dissenting) that the relevant step of the risk assessment procedure was not "processing" under the Act since it was performed by human mental processes rather than by machine.

Free movement of goods and services in the European Union - pharmaceutical, agrochemical and other sectors

Regularly advises and conducts cases under the rules developed by the European Court of Justice on the free movement of goods under Articles 28 and 30 (formerly Articles 30 and 36) of the EC Treaty. This work covers the relationship between free movement rules and patents, trade marks and copyrights on the one hand; and with national and EC laws relating to product licences and marketing authorisations on the other hand, including the rules governing "data exclusivity periods".

A major area of advice at present are parallel imports of drugs from the new European Union Accession States of the Czech Republic, Estonia, Latvia, Lithuania, Hungary, Poland, Slovenia, Slovakia, Bulgaria and Romania. Parallel imports of pharmaceutical products from these states are potentially restricted by a special provision in the Act of Accession called the "Specific Mechanism". The Specific Mechanism permits the owner of a patent covering a pharmaceutical product in an existing Member State to prevent parallel imports of his own products from one of these accession States if at the filing date of the patent it would not have been possible to obtain a pharmaceutical product patent in the Accession State concerned. Applying the Specific Mechanism to a particular case therefore involves examining the law of the relevant Accession State at the relevant date. Further issues can arise as to whether a particular patent is for a pharmaceutical product, or, for example, for a delivery mechanism for a drug. The Specific Mechanism also allows enforcement of Supplementary Protection Certificates (SPCs) against parallel imports from these states if an SPC could not have been obtained on the date of application for the SPC in the country of importation. SPCs based on pharmaceutical process patents are also

covered by this rule.

The free movement rules are relevant to many fields apart from pharmaceuticals, including e.g that of satellite decoder cards (see above). The parallel importation of goods from outside the EC single market is covered by different rules which are more restrictive than those applying to trade within the single market.

Example cases (underlining indicates the name of the client):

Merck v. Primecrown Ltd [1997] 1 CMLR 83; [1997] FSR 237; Joined Cases C-267/95 and C-268/95. **EC free movement of goods - Parallel imports of patented pharmaceuticals - Spain and Portugal accession conditions.**

Concerned parallel imports of pharmaceuticals within the EC, in particular from Spain and Portugal. The ECJ decided (reaffirming its earlier case law) that a patent owner who consents to placing products on the market anywhere in the EC, even in a country where patent protection is inadequate, cannot prevent parallel imports into other member states. The ECJ also ruled on the dates of expiry of the transitional articles in the accession arrangements of Spain and Portugal, which restricted parallel imports of pharmaceutical products from those countries for limited periods. The decision of the Patents Court (Jacob J) referring the case to the ECJ is reported at [1995] FSR 909.

R. v. Medicines Control Agency ex parte Smith & Nephew Plc, intervener Primecrown Ltd [1997] 1 CMLR 812, Case C-201/94. **EC Medicines Directive - Free movement of goods - Marketing authorisation for parallel imports.**

Concerned the compatibility with Community law of the grant by the Medicines Control Agency of a product licence for parallel importation of a pharmaceutical from another member state. The ECJ decided that a product licence allowing parallel importation should be granted when the same products in different member states are put on the market by companies under licence from a common licensor, as well as in the case when the companies are corporately linked.

R. v. Medicines Control Agency ex parte Smith & Nephew, intervener Primecrown Ltd [1999] RPC 705. **EC Medicines Directive - Licence suspended by interim injunction - Assessment of damages under the cross-undertaking.**

A claim for damages under a cross undertaking in damages given in return for interim relief which restrained the holder of a parallel import licence from importing and selling a pharmaceutical product pending a ruling from the European Court. The decision of the ECJ (see above) had the consequence that the licence in issue had been validly granted. The Court held that the licence holding company, in whose favour the cross undertaking had been given, could not recover in respect of trading profits lost by an associated company which would have traded under the licence, but could recover reasonable royalty in respect of the exploitation of the licence which would have taken place if the interim relief had not been granted.

R v. MAFF ex parte Monsanto PLC, intervener Clayton Plant Protection Ltd Case C-306/98 (Judgment 3 May 2001). **EC Directive on agrochemical products - Authorisation of generics.**

Judicial review proceedings concerning the validity of the grant under Directive 91/414/EEC of an agrochemical product licence to a generic producer. The ECJ upheld the validity of the grant of the generic licence under the transitional provisions of the Directive. Earlier proceedings in the Queen's Bench Divisional Court concerning interim relief are reported at [1998] 4 All ER 321; [1999] FSR 223; the Divisional Court accepted undertakings proffered by Clayton to keep its sales under the disputed licence below ceiling figures until the case was dealt with by the ECJ.

Bolton Pharmaceutical Co 100 Ltd v. Swinghope Ltd and ors [2006] EWCA Civ 661 (Mummery LJ, Longmore LJ and Lewison J, 26 May 2006). **EC Free Movement of Goods - Pharmaceutical Parallel Imports - Trade Marks - Summary Judgment.**

A pharmaceutical parallel import case, in which summary judgment granted at first instance (when other counsel appeared) was set aside. AstraZeneca had been the original owner of product licences, know-how and trade marks in the UK and Spain relating to a hypertension drug brand named Kalten. Owing to

price differences, a parallel import trade grew up between Spain and the UK. AZ divested itself of the rights to the drug in Spain and the UK to apparently unrelated entities in each country. The Claimant acquired the UK trade mark and other rights and asserted that it now had the right to prevent the importation into the UK of Spanish Kalten, because there no longer any "economic link" between itself the UK trade mark proprietor and the Spanish Kalten product. It successfully applied for summary judgment on this basis against a number of parallel importers of Spanish Kalten. The Court of Appeal set aside the summary judgments because it considered that the facts and circumstances of AZ's divestiture of its rights and its continuing relationship with the entities in the UK and Spain required further investigation, and because of the ECJ's developing jurisprudence on the artificial partitioning of national markets under the second sentence of Article 30 of the EC Treaty. [Full Text of Judgment.](#)

***Miller Brewing Co v Mersey Docks & Harbour Co* [2004] FSR 5. Trade marks - Infringing goods and warehousemen, shippers etc.**

A cargo of infringing parallel imported beer was injuncted while still in bond. In multi-party proceedings involving the importer, a warehouse, shipping agents and shipping company, the court ordered destruction of the beer and determined who was liable for storage and other charges incurred. The claimant successfully resisted indemnifying the shipping agents against the liability they had incurred for warehouse charges.

***Extrude Hone's Patent* [1982] RPC 361. Patent - Compulsory licence - EC rules on free movement of goods.**

Concerned machinery for honing holes inside castings and the like by forcing through abrasive putty under pressure. The court held that the grant of a compulsory licence under a patent on the ground that the market was met by importation from another EC member state did not amount to a quantitative restriction on trade between member states, or a measure having equivalent effect, contrary to Arts 30-36 of the EC Treaty. (NB This decision has since been overruled by subsequent decisions of the ECJ and the House of Lords.)

EC microbiological, foodstuff and plant variety regulatory laws

Example cases (underlining indicates the name of the client):

Seahawk Marine Foods Ltd v. Southampton Port Health Authority [2002] EHLR 306, Ct of Appeal. **EC Regulations on microbiological safety standards for food.**

The Port Health Authority, a designated EC border inspection post, made a decision prohibiting the importation of seafood from Vietnam as a result of conducting microbiological tests on the cargo. The decision was challenged in judicial review proceedings as being contrary to relevant Community law. The Court of Appeal, reversing the decision of Newman J in the Administrative Court, held that the Authority's assessment of the test results and its resulting decision was compatible with Community law. [Headnote](#)

Antonio Muñoz y Cia SA v. Frumar Ltd Case C-253/00 (ECJ Judgment 17 Sept 2002). **EC Regulations on fruit varieties - DNA technology - Direct applicability of Regulations by civil action in member state.**

Action brought by a grape producer to enforce compliance by a competitor with EC Regulations on the common organisation of the market in table grapes. The case involved the application of DNA technology to identifying the genetic composition of the grapes in order to prove that they were in fact of different variety from that claimed by the competitor. The trial judge (Laddie J, [1999] FSR 872) accepted the DNA and other evidence and held that the defendants had breached the regulations by applying the wrong variety names to grapes which they had imported and sold. However, he held that a breach of the Regulations did not give rise to a civil right of action on the part of a competitor such as the plaintiff. The Court of Appeal referred the case to the ECJ, which ruled that such a breach does give rise to a civil right of action in the part of a competing producer such as Muñoz.

Antonio Muñoz y Cia SA v. Frumar Ltd [1999] FSR 872, Ch D (Laddie J). **EC Regulations on grape varieties - Action by competitor against trader using wrong variety name - Variety proved by DNA evidence.**

Case about grape varieties. The Court held on the basis of DNA evidence that

the defendants had used variety names for grapes different from the correct variety name required by EC Regulations on the common organisation of the market. Therefore the defendants had breached the Regulations, but the Court held that breach of the Regulations did not give rise to a right to sue in the civil courts on the part of competing grape producers or traders. The European Court of Justice reversed this finding of law on a preliminary reference made by the Court of Appeal (see above).

SPI PLC v. Southampton Port Health Authority (Queen's Bench Division, Crown Office List, Newman J, 4 April 2000). **EC fishery products Directive - Marking requirements on products imported into the EU.**

Judicial review application concerning the interpretation of the marking requirements on products imported into the European Community under the fishery products Directive 91/493/EEC. The Court indicated its agreement with the respondent's position that markings identifying the establishment of origin of the products must be placed on inner packaging as well as on outer containers.

Biotechnology and recombinant DNA

Example cases (underlining indicates the name of the client):

Genentech's Patent [1989] RPC 147. **Patent - Recombinant DNA technology - Tissue plasminogen activator.**

Concerned the validity of a patent for the production of human tissue plasminogen activator by recombinant DNA technology. The patent was held invalid on the grounds of obviousness and because the claims were too broad. Judgment of the Patents Court at [1987] RPC 553.

Biogen Inc v. Medeva PLC [1997] RPC 1. **House of Lords - Patent - Recombinant DNA technology - Hepatitis B viral antigen.**

Patent relating to the production by recombinant DNA technology of Hepatitis B virus antigens for use in vaccines. The patent was held valid at first instance, but held invalid in the Court of Appeal and the House of Lords. The case

established the principles applicable to the patentability of inventions in the genetic engineering field. (Proceedings in the lower courts reported at [1995] RPC 25).

*Celltech Therapeutics, opponent Eli Lilly Case T400/97, EPO Technical Board of Appeals, 26 May 2000. **Patent - Recombinant DNA technology - hybrid (human/non-human) antibodies.***

A patent concerned with the engineering of hybrid (human/non-human) antibodies. The validity of the patent was challenged on the grounds of prior public disclosure at a lecture and insufficiency. The Board rejected the attacks based on prior public disclosure but greatly restricted the claims on the insufficiency grounds.

*Pertussis antigen/Evans Medical Ltd Case T780/95, European Patent Office Technical Board of Appeals, 11 March 1998. **Patent - Recombinant DNA technology - Pertussis (whooping cough) antigens.***

A biotechnology case concerning the validity of a patent for an antigen of the pertussis bacterium used in whooping cough vaccine. The Board held the patent to be insufficient. Also appeared in the trial on the same patent in the English Patents Court: *Evans Medical Ltd's Patent* [1998] RPC 517.

Hepatitis B virus/Biogen Inc Case T886/91, European Patent Office Technical Board of Appeals, 16 June 1994. Parallel proceedings to those in the House of Lords concerning the same patent: see above.

The *Muñoz* case (see above) also involved the use of DNA technology for the purpose of identifying the grape variety in issue. Grape varieties are clones propagated by cuttings, so the process is analogous to that of indentifying a particular individual in the case of a human or animal.

Auchincloss v. Agricultural and Veterinary Supplies [1999] RPC 397. **Patent - Virucidal product.**

Patent infringement action concerning a virucidal composition for use in

agriculture. Patents Court judgment reported at [1997] RPC 649.

Medical devices and technology

Example cases (underlining indicates the name of the client):

Occlutech GmbH v. AGA Medical Corp March 2009, Mann J. **Patent validity and infringement - Implantable occlusion devices for atrial septal defects - Purposive construction of claims.**

A case concerning occlusion devices for implantation via a catheter in the septum (wall) between the two parts of the atrium.

Xylum Corporation v. Gorog July 1997, Laddie J. **Exclusive licence under patent - Thrombosis diagnostic equipment - Scope of improvements clause - New patent taken out by relative of inventor.**

A case concerning apparatus for measuring the susceptibility of human blood to thrombosis. The defendant inventors had entered into an exclusive licence agreement with the plaintiff licensees. The agreement gave the plaintiff licensees certain rights in respect of improvements to the original invention. The court held that an apparatus patented in the name of the inventors' daughter amounted to an improvement to the original invention falling within the scope of the agreement.

Fairfax (Dental Equipment) Ltd v. SJ Filhol Ltd [1986] RPC 499, Ct of Appeal. **Patent validity and infringement - Dental anchoring device (dentine pin).**

The case concerned a patent for a one piece device which consisted of a dentine pin (a small grub screw for anchoring a filling to the sub-structure of a tooth) connected to a body which fitted into a standard dental drill. In use, the pin would shear off at a narrowed neck when in place in the tooth and the body would be discarded. The alleged infringement was constructed out of two pieces put in use effectively functioned in the same way with a disposable body. The Court of Appeal upheld the first instance decision (of Whitford J) that the patent was valid and infringed.

Defence industries, warheads and explosives

Example cases (underlining indicates the name of the client):

Cintec International Ltd v Parkes (t/a Dell Explosives) [2003] EWHC 2328. **Patent threats action - Water filled devices for dampening effects of explosions - Jurisdiction between Scotland and England - Brussels Convention rules.**

A patent action about methods for protecting people and property against bomb blasts using soft water containing 'inflatables' to absorb the blast. The defendants started proceedings in the Court of Session in Edinburgh making extensive allegations of infringement of patents. They also made threats within England and Wales to the claimant itself and others of patent infringement proceedings. The claimant was held entitled to bring a 'threats' action in the Patents Court in London despite the existence of the Scottish proceedings on the ground that they related to a different, even if related, cause of action. The court held that the patent was not infringed by the claimant's product and the threats were not justified.

Societa Esplosivi Industriali SpA v Ordnance Technologies (UK) Ltd [2004] 1 All E.R. (Comm) 619. **Shaped charge designs for multiple warhead missiles - Commercial dispute under development 'teaming agreements' - Design rights - Trade secrets.**

The parties had been involved in joint projects involving the design and testing of multiple warhead systems including shaped charges for 'bunker busting' cruise missiles. The commercial relationship between the parties broke down and the claimant sought to establish its claimed rights in the designs and to prevent the defendant from making use of the jointly developed designs in contracts with third parties. The claimant was largely successful in its claims. The case involved the court ruling on the correct procedures to be followed when disclosure documents fall within the Official Secrets Act.

Societa Esplosivi Industriali SpA v Ordnance Technologies (UK) Ltd [2007] EWHC 2875 (Ch), Lindsay J. **Shaped charge designs for multiple warhead missiles - Commercial dispute under**

development 'teaming agreements' - Design rights - Trade secrets - Director's liability for tort of company.

A further hearing in the SEI case (above). Lindsay J held that OTL had used the jointly owned designs in carrying out a project for the UK Ministry of Defence and that the sole director of OTL was liable for those acts as a joint tortfeasor. In relation to another project (for Raytheon), he held that the design which was modelled by computer was not identical to the jointly owned design and so did not infringe and further that there was not a sufficient intention to make actual articles to the design to make the computer model an infringing design document under section 226(1)(b) of the CDPA 1988.

Architecture and structural drawings

Example cases (underlining indicates the name of the client):

Cala Homes Ltd v. McAlpine [1995] FSR 818, Laddie J. **Copyright - Architectural drawings of standard house types - Authorship - Infringement.**

A case concerning copyright in architectural drawings for Cala's range of standard house types. The Court held that Cala's employed director who had supervised and directed the creation of the drawings was a joint author together with the outside architects who had actually drawn them under his supervision; hence Cala could sue for infringement when the drawings were later substantially copied by the architects for the use of a competing housebuilder. Further proceedings relating to the inquiry as to damages and account of profits are reported at [1996] FSR 36.

Hill Cannon v. Bunyan Meyer Scott J, April 1991. **Copyright - Architectural drawings - Multistorey car park structural designs**

An action for infringement of architectural copyright in structural designs for multistorey car parks. The action was settled in the course of the trial on terms that the defendants gave undertakings and paid damages.

CD and DVD replication, printing and packaging

Example cases (underlining indicates the name of the client):

Pioneer Electronics v. Warner Music Mfg [1997] RPC 757. **Patent - Infringement by importing product of process - CDs made from mould not 'direct products' of process for making mould.**

The defendants imported and sold compact discs which were alleged to be the direct products of a patented process, so infringing contrary to section 60(1)(c) of the Patents Act 1977. The last step of the process set out in the claim was the production of a stamper for moulding the CDs. The CDs were in turn made by using the stamper. The Court held that the CDs could not be considered to be a "direct" product of the process within section 60(1)(c). Also at first instance at [1995] RPC 487.

Billhöfer Maschinenfabrik GmbH v. TH Dixons [1990] FSR 105, Hoffmann J. **Copyright - Design drawings - Laminating machinery - Eye appeal and substantial part.**

An action for infringement of copyright in design drawings for laminating machinery. The Court held that the defendants had reproduced the plaintiffs' drawings in a brochure, but that they had not reproduced sufficient of the features of shape and appearance of the plaintiffs' machine in their actual machine for it to amount to an infringing reproduction.

Discovision Associates v. Distronics (UK) Ltd (March 1998, Pumfrey J) **Patents - CD mastering and moulding - Control electronics using phase-locked loops - Vacuum vapour deposition process.**

A patent action relating to 6 patents covering different aspects of the technology of making compact discs, including the electronic control systems for laying down the track on the master discs at constant linear velocity, moulding methods for the plastic replica discs, and vapour deposition of metal substrate on the master discs.

Magazine publishing

IPC Media v. Highbury Leisure Publishing [2005] FSR 20 p434.

Copyright - Magazine designs - 'Ideal Home' magazine.

The case concerned the alleged copying of the 'format' (appearance and design) of Ideal Home magazine by a competitor magazine called 'Home'. The court (Laddie J) considered that the features of similarity between the two magazine designs were at too high a level of generality to give rise to an inference of copying, and accepted the defendant's evidence of independent design.

VNU Business Publications v. Ziff Davis [1992] RPC 269. **Copyright - Lists of magazine subscribers - "Seed" names.**

Action concerning copyright in lists of names of magazine subscribers, in which the plaintiffs sought to prove infringement by relying upon "seed" names within their list, i.e. deliberately planted false names. The Court held that the "seed" names must be disclosed to the defendants if their existence is to be relied upon in evidence.

Garments, textiles and carpets

Example cases (underlining indicates the name of the client):

Stoddard Intl Ltd v. Wm Lomas Carpets Ltd [2001] FSR 848, Pumfrey J. **Copyright - Carpet design - Limits of expert evidence.**

The plaintiffs alleged that the defendants had copied their "Chamonix" carpet design by bringing out their own "Georgiana" design of carpet. Although the defendants were aware of the Chamonix design, the designer whom they had employed to create Georgiana gave evidence that he had not been aware of it and the judge accepted his evidence. The judge rejected an alternative allegation that the defendants had caused the designer to infringe by virtue of the instructions which they had given to him.

AL BASSAM Trade Mark [1995] RPC 511. **Trade mark - Head shawls - Ownership as between customer and manufacturer.**

The registration of a trade mark was opposed on the ground that the applicant's overseas customer, and not the applicant, was the true proprietor of the mark. The court held that where a trade mark is in actual use prior to the filing of the application to register the mark, then common law principles should be applied to determine who is the true proprietor. First instance judgment at [1994] RPC 315.

Laura Ashley v. Coloroll Ltd [1987] RPC 1. **Trade mark and passing off - "Tachistoscope" surveys**

A trade mark and passing off action in which the court rejected the plaintiffs' allegations that the defendants' logo was confusingly similar to its own. The main point of interest in the case is the reliance sought to be placed on evidence gathered by use of a "tachistoscope", which had been used to measure consumer perception and confusion by flashing up the defendants' logo on a screen for very short periods of time. The court considered that this evidence was not representative of what would happen in a retail context.

Vax Appliances Ltd v. Hoover PLC [1991] FSR 307; [1990] RPC 656.
Patent - Carpet cleaning machinery.

A patent infringement action concerning a cleaning head for a domestic carpet cleaning machine. The court held the patent valid and infringed.

Electronic consumer goods

(Underlining indicates name of the client.)

Sony v. Saray Electronics [1983] FSR 302. **Passing off/trade mark - Non-authorised dealers required to put disclaimer labels on goods.**

The defendants sold Sony goods to the public but were not authorised dealers. They conducted their business in a way which led some customers to believe that Sony goods sold by them were covered by a manufacturer's guarantee. The Court granted an interlocutory injunction requiring the defendants to put labels on Sony goods indicating that they were not authorised dealers and that

the goods were not covered by a manufacturer's guarantee.

Filtration, sieving and refining

Example cases (underlining indicates the name of the client):

Russell Finex Ltd v Telsonic AG. [2004] RPC 38 p744. **Patent - Ultrasonic particle sieving machinery - Claim construction.**

A declaration of non-infringement was granted to the claimant because its resonator rod could not fall within the claims which required a "circular" rod. Since the patent did not explain why the claim was limited to circular rods, the skilled reader would be unable to decide that the limitation imposed by the express words had not been intended as so the claim could not be construed "purposively" to cover non-circular variants.

Memcor Australia Pty Ltd v Norit Membraan Technologie BV [2003] FSR 43 p779. **Patent County Ct. - Patent validity and infringement - Water filtration membrane technology.**

The patent was held invalid on the grounds of prior publication by the patentee in a report circulated to water board customers in Australia, and also obvious in the light of common general knowledge in the field.

Appeal by Professor D Fray: Cambridge University Technology Appeal Tribunal, 22 June 2007. **Adjudication on intellectual property rights between university and staff - Management of patent rights - Process for electro-deoxidation of titanium and other metals.**

Cambridge University's Technology Appeal Tribunal was established to adjudicate upon disputes regarding the exploitation of intellectual property rights in inventions made by the university's academic staff. In this first decision by the Tribunal, it laid down general guidelines on the conduct of appeals and on the duties of staff members and Cambridge Enterprise towards each other. Prof Fray's appeal was successful in that CE was held not to have co-operated fully with Prof Fray (as required by the University regulations) regarding the termination of a licence arrangement, but Prof Fray's contention

that CE had acted in bad faith was not upheld. [Full Text of Tribunal Decision.](#)

Professional negligence and liability (IP related)

Example cases (underlining indicates the name of the client):

Halifax Building Society v. Urquhart-Dykes & Lord [1997] RPC 55.

Trade mark agents - Professional negligence - Damage

A case concerning alleged professional negligence by trade mark agents who acted for the building society when it came into conflict with an insurance company which had used the trade mark Halifax in the insurance field. The Court held that the trade mark agents had been negligent, but that the plaintiff had not suffered substantial damage as a result of the negligence and awarded nominal damages.

CHC Software Care v. Hopkins & Wood [1993] FSR 241. **Solicitors - Letter sent on behalf of clients to competitors' customers alleging infringement of copyright - Whether solicitors liable to competitor - Whether identities of recipients of letters discloseable by solicitors - Scope of client privilege and disclosure by solicitors in their own defence**

On behalf of a client, a firm of solicitors sent letters to an NHS purchasing body and other potential customers for a software product being sold by the plaintiff making strong allegations that the product infringed their clients' copyright. Following an examination of the software by experts acting for the parties, the allegation of infringement was abandoned. The client being out of the jurisdiction and probably impecunious, the plaintiff sued the firm of solicitors for sending the letter negligently or maliciously. The plaintiff was held entitled to disclosure of the identities of persons to whom the letters had been sent in order for the plaintiff to be able to mitigate the damage done by them. However at trial it was held that in order to succeed in its claim for damages against the solicitors, the plaintiff needed to prove malice rather than mere negligence and it had not done so.

[Back to top](#)

COURTS, TRIBUNALS AND JURISDICTIONS

European Court of Justice, Luxembourg:

Has conducted the following cases in the European Court in which a judgment has been given (case details set out in industry sections above):

- [*Merck v. Primecrown*](#)
- [*R v. MCA ex parte Smith & Nephew*](#)
- [*Muñoz v. Frumar*](#)
- [*Monsanto v. MAFF*](#)

Currently engaged in the following pending cases in the European Court (details of the cases are given above):

- [*FAPL v. QC Leisure and others*](#)
- [*Murphy v. Media Protection Services Ltd*](#)

[Back to top](#)

European Patent Office, Munich:

Regular appearances before Opposition Divisions and Technical Boards of Appeal of the European Patent Office, Munich. Important cases set out above have included:

- [*Celltech*](#)
- [*Pertussis Antigen*](#)
- [*Hepatitis B/Biogen*](#)

[Back to top](#)

Court of Appeal and House of Lords:

Have appeared in the House of Lords in [Biogen](#), the leading case on recombinant DNA patents. Numerous of the cases listed above are in the Court of Appeal.

Overseas jurisdictions

Will undertake cases in overseas jurisdictions with common law legal systems and where intellectual property laws are historically derived from UK laws. Extensive advisory practice for solicitors and patent attorneys from Hong Kong and Singapore.

Domestic and arbitral jurisdictions

Will undertake cases in domestic and arbitral jurisdictions. By their nature, these cases are normally private. However, a publicly reported case in a domestic tribunal has been one conducted in the Cambridge University Technology Appeal Tribunal: [Re Prof Fray](#)

[Back to top](#)

PUBLICATIONS AND LECTURES:

Major publications:

Halsbury's Laws of England Title on *Trade Marks and Trade Names*: 1984 and 1995 editions; jnt. ed. with Mr Justice Jacob; 2000 edition jnt. ed. with James Abrahams.

Russell-Clarke on Industrial Designs, 6th edition, Sweet & Maxwell 1998, sole editor. 7th Ed 2005, *Russell-Clarke and Howe on Industrial Designs* which includes coverage of Community design right and EC harmonised registered designs.

Other publications and public lectures and seminars (selection only):

"Litigating Biotech Patents": CIPA Annual Biotechnology Conference, Nottingham, November 2008. [Outline of lecture \(PDF\)](#)

"Balancing the Rights of Users and Right Holders": IBC International Copyright Conference, Dec 2007. [Text of lecture \(PDF\)](#)

"Protecting Confidential Database Information": IP Rights in Financial Services Conference, June 2007. [Text of lecture \(PDF\)](#)

"The availability of interim injunctions in IP infringement cases": IP Enforcement and Remedies Conference (Lexis-Nexis), October 2006. [Text of lecture \(PDF\)](#)

"Making and selling spare parts: patent, design and trade mark law": CLT Conference on Copying Without Infringing, March 2006. [Text of lecture \(PDF\)](#)

"*Oakley Inc v. Animal Ltd*: Designs create a constitutional mess": [2006] EIPR 192.

Electronic Evidence and Electronic Signatures: Admissibility and Law. Lecture to the Chancery Bar Association, Lincoln's Inn Old Hall, April 2005. [Text of lecture \(PDF\)](#)

"The New European Designs Law": address to The Intellectual Property Lawyers Organisation, Oct 2003.

"Parallel Imports, Exhaustion of Rights, Fortress Europe?" talk to The Intellectual Property Lawyers' Organisation, Dec 1998

"Protection of Industrial Designs under national and EEC law": Lecture to Union des Avocats Européens, Milan 1991

"Copyright, Designs and Patents Bill: Implications for High-Tech Industries": LSSL Lecture, Feb 1988

"Employee Inventions:" Lecture to British-German Jurists' Association, Cologne, 1983

"The *Nungesser* case and patent protection in the Common Market": LSSL Lecture, March 1982

"*Infabrics v Jaytex*: A Pirates' Charter?" [1981] EIPR 270

"Ghost Marks" and the "*NERIT*" trade mark case: [1980] EIPR 372; further note on the case in the Court of Appeal: [1981] EIPR 213

"The Rights of Computer Software Owners": 1980 PCL Law Review

"Protection of Computer Produced Designs:" ESC Conference Dec 1980

"Infringing Goods and the Warehouseman": [1979] EIPR 287

[Back to top](#)

EDUCATION

Winchester College (1968 to 1972): entrance scholarship 1968; A-Levels in Maths (Grade A1), Physics (Grade A1), and Further Maths (Grade A)

Trinity Hall, Cambridge University (1973 to 1977): degree subjects Engineering and Law; BA (Cantab)1977; MA 1979; entrance scholarship to Cambridge 1973; renewed scholarship 1975; Baker Prize for Engineering 1974 (1st on Cambridge University examination list, Engineering Preliminary Exams).

Bar Exams course (1977 to 1978): Everard ver Heyden Foundation Prize 1978 (for Bar Exam course advocacy exercises); Harmsworth Exhibition 1976; Astbury Law Scholarship 1979.

PREVIOUS EMPLOYMENT

Worked as a computer systems engineer and contract programmer for IBM United Kingdom Limited and then for a software house. Total of 24 months professional computer programming experience.

[Back to top](#)