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### **PERSONAL**

Born 2 November 1953

British citizen

Four daughters

### **EDUCATION**

King's College School, Wimbledon 1967-71: 8 O levels and 3 A levels, Imperial College, University of London 1972-5; BSc (Physics) class 2:2 Inns of Court School of Law 1976-7 and 1978-9: Bar Finals class 2:1 fifth in order of merit.

### **PROFESSIONAL APPOINTMENTS**

Called to the Bar 1980 Gray's Inn

Junior Counsel to the Treasury in Patent Matters 1991-6

Queen's Counsel 1996

Accredited mediator 2004

Nominet DRS Expert Panel member 2008-

### **PUBLICATIONS**

*Passing Off Law and Practice* (Butterworths 2<sup>nd</sup> Edition 1995) co-author with John Drysdale.

*Butterworths Patent Litigation* (1995) edited by Gary Ropski, contributing author

*Computer Law* Blackstone Press 3<sup>rd</sup> Edition (1996) edited by Chris Reed, contributing author.

*Intellectual Property and Technology Cases* (Butterworths law report series) consulting editor 1999-date

Many articles in the legal press and papers delivered at professional conferences and seminars.

### **AREAS OF PRACTICE**

Patents, trade marks, passing off, copyright and related rights, registered and unregistered designs, computer disputes, breach of confidence, performers' rights, entertainment and media law, restraint of trade, trade libel, trade descriptions, related areas of European and domestic competition law.

Practice in tribunals and courts at all levels up to the House of Lords and European Courts of Justice and the UK and European Patent Offices.

Mediation within the above areas of law and mediation training.

## NOTABLE CASES SINCE 2000

- Nokia v IPcom* (HC January 2010, settled). Validity of patents relating to GSM and UMTS telecommunications concerned with networking protocols and SMS technology.
- Bayer EP 0 614 984 Opposition* (EPO December 2009). Represented opponent Abbott Laboratories on appeal to TBA arguing issues of sufficiency and added matter on patent for monoclonal human anti-TNF $\alpha$  antibodies.
- Silver Lake* (advisory role May-October 2009) acting for consortium purchasing Skype from Ebay on IP issues arising from ownership and use of proprietary IP telephony technology.
- Synthon v Merz* (HC, [2009] RPC 20). Supplementary Protection Certificate for medicinal product first marketed in EU before efficacy and safety testing required, reference to ECJ pending.
- Napp v Sandoz and ratiopharm* (HC, November 2008, CA March 2009). Validity and infringement of patents relating to controlled release pharmaceutical formulations.
- Schlumberger v Electromagnetic Geoservices AS* (HC, June/July 2008). Validity and amendment of three patents relating to controlled source electromagnetic seabed surveying.
- Dupont v Smurfit* (HC, March 2008). Damages enquiry on patent threats action to determine losses attributable to defendant's threats.
- Qualcomm v Nokia Corporation* (November/December 2007). Essentiality, infringement and validity of patents relating to GSM telecommunications involving analysis of GSM standards.
- Triumph Actuation Systems v Eaton Corporation* (HC, April 2007). Patent infringement, aerospace hydraulic power transfer unit (PTU), added matter, validity, amendment.
- Direct Line v esure* (TM Regy Oct 2006, HC May 2007). Trade mark registration application for mouse on wheels logo opposed on basis of telephone on wheels logo and registrations; similarity of marks, confusion, detriment and unfair advantage.
- Nokia Corporation v InterDigital Inc.* (CA [2006] IP&T 8). Claims for declarations of essentiality of patents under GSM standards justiciable. (HC trial of same proceedings, settled after trial, November 2005-January 2006). Essentiality and validity of patents relating to GSM telecommunications involving analysis of GSM standards.
- Inland Revenue v EDS* (2005-6, settled). Contract dispute arising out of supply of Tax Credits computer system. Nominated as Chambers IT Counsel of the Year 2006 for this case.
- Harrison v Teton Valley Trading Co. Ltd* (CA, [2005] FSR 10). Trade mark registration, bad faith, applicant's state of mind, whether decision to apply would be regarded as bad faith by person adopting proper standards.
- Quiksilver v Charles Robertson (Developments) Ltd* (HC, [2005] FSR 2). Trade marks, parallel imports, consent to importation from outside EU.
- Interlotto v Camelot* (HC, [2004] RPC 8, CA [2004] RPC 9). Conflict between applicant to register and later user of mark claiming passing off. Whether goodwill in use after date of application can be relied on.

*Boehringer Ingelheim v Swingward Ltd (incs Glaxowellcome v Dowelhurst)*  
(continuation of previous case CA 2004, ECJ 2005 (judgment April 2006)).  
Appeal and second reference to ECJ (judgment [2007] IP&T 683).

*Prudential Assurance Co, v Prudential Insurance Co.* (HC [2002] IP&T 781; CA [2004] FSR 25). Agreement to divide use of Prudential name geographically. Community Trade Marks. Scope and enforcement in different European jurisdictions.

*Thomson Licensing SA v PACE Microelectronics* (HC; settled during trial in November 2001). Patents for variety of aspects of MPEG video compression and signal transmission used in digital television transmission and MPEG 2 encoding. 5 patents originally asserted, 3 abandoned. (Acted with Henry Whittle and Brian Nicholson).

*Times Newspapers Ltd v George Weidenfeld & Nicholson Ltd* (HC) [2002] FSR 463. Publishing agreement. Subsidiary agreement for serialisation rights. Termination of publishing agreement and breach of serialisation agreement by failure to deliver rights. Measure of damages.

*Nutrinova (Bayer) v Scanchem Ltd* (Pat.Ct) [2001] FSR 797 and 931. Patent for artificial sweetener. Mfr in China. Infringement. Obviousness of synthetic route.

*Scholes v Magnet plc* [2000] FSR 432 (HC); [2002] FSR 172 (CA). Unregistered design right. Infringement by copying. Whether design original/commonplace.

*Tin Tin Yat Pao v Tin Tin Publications* (Hong King Court of Final Appeal) [2001] IP&T 1109. Passing off. Breach of contract. Licensing of business with goodwill. Whether constitutes assignment of business.

*United Wire v SCS* (HC) [2001] FSR 365; (CA, HL) [2001] 439. Patent infringement. Validity. Whether remanufacturing constitutes repair. Whether appellate court entitled to substitute its own evaluation of the facts.

*Newspaper Licensing Agency v Marks and Spencer plc* (HC, CA, HL) [2002] RPC 225. Newspapers. Scope of copyright in typographical arrangement of published edition. Use of material for internal distribution. Fair comment. Reporting current events.

*Springform Inc v Toy Brokers Pat.Ct.* [2002] FSR 276. Patent infringement. Relief. Accounts of profits. Apportionment of profits between successive infringers. Exclusive licence. Effect on recovery of non-registration of licence.

*Springform Inc v Playhut Inc.* Pat.Ct. [2000] FSR 327. Patent for self erecting sprung structure. Infringement. Validity. Added matter. Insufficiency. Whether change in scope of claim amounts to added matter. Whether claim beyond inventor" technical contribution.

*Mars Inc v Teknowledge Ltd* (HC) [2000]FSR 138. Copyright. Database right. Confidential information. Encrypted computer programs and data contained within coin freed apparatus. Third party right to decompile and reprogram.

*Horne Engineering Ltd. V Reliance Controls plc* (Pat,Ct) [2000] FSR 90. Patent for temperature control valve. Infringement. Validity. Clarity of claims.

*Boehringer Ingelheim v Swingward Ltd (incs Glaxowellcome v Dowelhurst)* (HC and ECJ ) [2000] FSR 529; 2002 [IP&T] 556. Pharmaceuticals. Parallel imports within EU of trade-marked goods. Repackaging. Extent to which permitted Requirement for notice of importation.

*Zino Davidoff SA v A & G Imports Ltd* (HC and ECJ) [2001] IP&T 55; [2002]RPC 403. Cosmetics. Parallel imports from outside EU. Whether permissible. Exhaustion of rights. What constitutes consent of marketing within EU.

## NOTABLE CASES BEFORE 2000

- Home Secretary v Central Television* [1993] EMLR 253 (CA), Ownership of copyright in recording of interview in prison with serial killer and whether broadcasting should be restrained in the public interest.\*
- Lux Traffic Controls v Pike* [1993] RPC 107 (Pat.Ct). What is required for enabling disclosure by way of prior use so as to invalidate a patent.
- Times Warner v Channel Four* [1994] EMLR 1(CA). What constitutes fair dealing for the purposes of criticism and review in a film. The first and authoritative case on this new provision in the 1988 Copyright, Designs and Patents Act.
- Marley Roof Tile's Patent* [1994] RPC 231 (CA). Whether two patents are granted for the same invention.\*
- Ford's Registered Design Applications* [1995] 1 WLR 18 (HL). The meaning of "article" in the Registered Designs Act and the registrability of designs for motor car parts. The scope of the "must fit" and "must match" exceptions from registrability.\*
- IHT Internationale Heiztechnik v Ideal Standard* [1995] FSR 59 (ECJ). There is no exhaustion of rights when a trade mark is transferred voluntarily as part of a business so that it vests in different owners in different EC member states.\*
- Saphena Computing v Allied Collection Agencies* [1995] FSR 616 (Off.Ref.CA). Contract for bespoke software. Whether standard terms incorporated. Whether copyright assigned in equity. Software containing bugs, whether licence to repair. Whether warranty of fitness for purposes survived termination.
- Neutrogena v Golden* [1996] RPC 473 (CVA). The Neutrogena/Neutralia trade mark and passing off action. Whether the names are confusingly similar. What can be relied on as evidence of confusion in such an action.
- Mercury Communications v Mercury Interactive* [1995] FSR 850 (ChD). Trade marks, infringement, scope of registration, scope of exception for bona fide use of own name.
- Island Records v Tring International* [1995] 3 AllER 444 (ChD). The Plaintiff is entitled to discovery after judgment on liability before electing between an inquiry as to damages and an account of profits in IP claim.
- Deutsche Renault v Audi* [1995] FSR 738 (ECJ). Whether test for confusing similarity between trade marks is a matter of national or EC law. Whether contrary to EC law for national law to protect mark which represents a number in the language of another member state.\*
- Jian Tools for Sales Inc. v Roderick Manhatten* [1995] FSR 924 (ChD). Passing off interlocutory injunction, when a foreign business has reputation in UK whether Bisplan Builder descriptive for software for making business plans.
- Barclays Bank v RBS Advanta* [1996] RPC 107 (ChD). Scope of exemption from infringement under section 10(6) Trade Marks Act 1994 for use of mark in relation to the proprietor's own goods.
- Fujitsu's Application* [1997] RPC 610 (CA) (Chd at [1996] RPC 511). Patentability of computer programs.
- Coin Controls v Suzo International* [1997] 3 AllER 45 (ChD). Jurisdiction of English Courts to try actions for infringement of European Patent in force in other European states. See also *Fort Dodge v Akzo* [1998] FSR 222 (CA) and *Boston v Cordis* (CA xx.11.97)

*Henry Brothers v Ministry of Defence* (CA) judgement delivered 6.11.98 ChD at [1997] RPC 693. Patents, Crown use of invention. Whether Crown employee sole or joint inventor. Whether co-inventor can exploit using subcontractor. Whether wrong omitted co-owner can seek revocation.\*

*Raychem's Patent* (CA) judgment delivered 17.12.98; [1998] RPC 31 (ChD). Patents, validity. Technical contribution where claims defined by arbitrarily chosen parameters.

*Sabel v Puma* [1998] RPC 199 (ECJ). Trade Marks Directive. Whether likelihood of association between two trade marks requires likelihood of confusion.

*Loendersloot v Ballantyne* [1998] FSR 544 (ECJ). Trade marks. Parallel imports,. Removal and reapplication of labels without identification marks by parallel trader. Whether infringement or disguised restriction on trade.\*

*PPL v Maitra* [1998] FSR 749 (CA). Appeared as amicus curiae. Appropriate remedy for collecting societies when obtaining judgment in default for infringement of copyright.\*

*Silhouette v Hartlauer* [1998] FSR 729 (ECJ). Exhaustion of rights in trade marks. Whether global or EU exhaustion.\*

*Martin-Smith v Williams* [1998] EMLR 334 (ChD). Entertainment. Management contract construction, extension of term and damages.

*Farmer's Build v Carrier Pollution Control* [1999] RPC 461 (CA). What is a commonplace design for the purposes of unregistered design right.

*Palmaz v Boston Inc.* HC [1999] RPC 47; CA [2000] RPC. Patent for coronary stent. Scope of claim. Reference to EPO practice. Amendment

*GAB Robins Holdings v Specialist Computer Centres* (Off.Ref), trial 6-7-98, judgment 2.99 Failed development of computer system. Responsibilities of developer. Liability for damages for wasted employee time. Damages for loss of use.

*Pro Sieben v Carlton Television* (CA) [1999] FSR 610. Copyright media. Fair dealing in copyright work of television programme for purposes of reporting current events and criticism. What constitutes a sufficient acknowledgement of the author of a work.

*General Motors v Yplon* (ECJ) [1999] IP&T 207. Protection of trade marks having a reputation. Geographical extent of reputation required. Nature of protection.

*Bourns Inc v Raychem Corp.* (follow up to Raychem's patents above). (HC, CA)\* No.1 [1999] FSR 641; No.2 [2000] FSR 841. Taxation of costs. Disclosure of privileged material. Extent of waiver of privilege. Use of material in other proceedings. Grant of injunction to restrain use of privileged material in US litigation.

Note: Cases marked with an asterisk are those in which I appeared as Treasury Counsel