



Michael Silverleaf QC

Called: 1980
Silk: 1996

Practice

Before joining the Bar in 1980, Michael read physics at Imperial College. Since his appointment as Queens Counsel in 1996 he has become one of the leading IP Silks. He has appeared in many leading patent, trade mark and copyright cases and is well known for his technical grasp and IP expertise. He is also well-known for his IT practice, having acted in a number of substantial IT disputes.

In recent years he has acted in cases involving technical areas as diverse as monoclonal antibodies, medical devices, financial trading systems, Formula 1, internet publishing, shipbuilding and mobile telephones, a field of particular technological complexity. His trade mark practice has included both online and offline businesses. His forensic skills are widely admired, particularly in cross-examination.

Michael was accredited as a mediator by ADR Chambers in 2004, since when he has regularly conducted IP mediations. Since becoming accredited, he has mediated disputes in all areas of IP. He has a considerable reputation as an effective facilitator of positive discussions between the parties. Michael is a member of Nominet Independent Expert Dispute Resolution Panel.

Between 1991 and 1996, Michael was Junior Counsel to the Treasury in Patent and related matters advising the government on many IP matters and regularly representing it in tribunals up to the European Court.

What the directories say

"He is fiercely intelligent - you want him on your side." - **Chambers & Partners 2017 (IP)**

"Very tenacious and very effective." - **Chambers & Partners 2017 (IT)**

"There are few if any people who are as authoritative as him." - **Chambers & Partners 2017 (Media & Entertainment)**

"He has a deep understanding of the most arcane aspects of IP law." - **Legal 500 2016 (IP)**

Excellent at identifying the weaknesses in a case.' – **Legal 500 2016 (IT)**

Education and Qualifications

King's College School, Wimbledon
BSc (Physics) class 2:2, Imperial College, University of London
Inns of Court School of Law
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-

Recent & Reported Cases

Napp Pharmaceutical Holdings Ltd v Dr Reddy's Laboratories (UK) Ltd and Sandoz Ltd [2016] EWHC 1517 (Pat)

Expedited patent infringement trial concerning buprenorphine pain relief dermal patches. Patents Court.

Generics (UK) Ltd (t/a Mylan) v Richter Gedeon Vegyeszeti Gyar RT [2016] EWCA Civ 410

Patent infringement and invalidity, dosing regimen for use in emergency contraception. Court of Appeal.

Generics (UK) Limited t/a Mylan v Warner-Lambert Company LLC [2015] EWHC 2548 (Pat)

Patent revocation and infringement action concerning a second medical use patent, which covered the use of pregabalin for the treatment of pain. Pregabalin was known as a treatment for epilepsy and generalised anxiety disorder. Patents Court.

The Sofa Workshop Ltd v Sofaworks Ltd [2015] EWHC 1773 (IPEC)

European Trade Mark infringement and passing off of the mark "Sofa Workshop". Intellectual Property Enterprise Court.

Mattel Inc & Anor v Zynga Inc [2015] EWCA Civ 290

Appeal of the trade mark validity and infringement trial in relation to the SCRABBLE marks. Court of Appeal.

Interflora Inc & Anor v Marks and Spencer Plc [2014] EWCA Civ 1403

Appeal of the action for trade mark infringement of the mark "INTERFLORA" by competitive brand bidding in Google Adwords.

Fresh Trading Limited v Deepend Fresh Recovery Limited & ors [2015] EWHC 52 (Ch)

Claim for declaration of ownership of copyright in the "Dude" logo – the cartoon face with a halo which is used by Innocent Smoothies. High Court.

Nokia v HTC (settled)

patent infringement and validity, mobile telephony.

JW Spear & Sons v Zynga [2013] EWCA Civ 1175; [2013] E.C.C. 34; [2014] E.T.M.R. 5; [2014] F.S.R. 14

Trade mark infringement claim concerning the "tile mark" associated with the popular word game Scrabble. Court of Appeal.

Starbucks v BSKyB [2015] UKSC 31; [2013] EWCA Civ 1465; [2012] EWHC 3074 (Ch)

Trial and appeal of community trade mark infringement claim concerning the television service NOW TV. High Court, Court of Appeal and Supreme Court. Interlocutory application and appeal on meaning of "special grounds" in Trade Marks Regulation [2012] EWHC 3074 (Ch) [2012] EWCA Civ 1201 [2012] EWHC 1842 (Ch).

32Red Ltd v William Hill Gaming (UK) Ltd [2012] E.T.M.R. 14; [2011] E.T.M.R. 21; [2011] R.P.C. 26; [2012] EWCA Civ 19

Trade mark dispute concerning use of "32RED" in online gaming websites. High Court and Court of Appeal and enquiry.

Football Dataco Ltd v Sportradar & ors [2013] EWCA Civ 27

Database right infringement regarding use of information about football matches. Court of Appeal.

Samsung Electronics (UK) Ltd v Apple Inc [2012] EWCA Civ 1339 [2012] EWHC 1882 (Pat) [2012] EWCA Civ 729

Design right case concerning tablet computers. Interlocutory application and trial in High Court and Court of Appeal.

Various claimants v News Group Newspapers [2012] EWHC 397 (Ch)

The voicemail interception litigation arising from the activities of journalists at the News of the World and the investigator, Glenn Mulcaire, which has been going on since 2008.

Newspaper Licensing Agency Ltd v Meltwater Holding BV [2012] Bus. L.R. 53; [2012] R.P.C. 1; [2011] E.C.D.R. 10; [2011] R.P.C. 7

Dispute concerning end users need for licenses to use articles collated by NLA. High Court and Court of Appeal.

Group Lotus Plc v 1Malaysia Racing Team Sdn Bhd [2011] E.T.M.R. 62

Dispute concerning trade mark infringement and alleged breach of licence agreements in relating to the use of the team name "LOTUS" for the Formula 1 racing team. High Court.

Kingspan Group Plc v Rockwool Ltd [2011] EWHC 250 (Ch)

Alleged infringement of registered trade mark, malicious falsehood and declaratory relief concerning insulating boards and panels for use in the construction industry.

Schlumberger Holdings Ltd v Electromagnetic Geoservices AS [2010] R.P.C. 33; [2009] R.P.C. 19

Patent revocation; controlled source electromagnetic sub-surface hydrocarbon surveying; common general knowledge; inventive step; novelty; skilled persons. High Court and Court of Appeal.

Global Coal Ltd v London Commodity Brokers [2010] EWHC 1347 (Ch)

Interpretation of the standard form Product Licensing Agreement and alleged breach by the licensee.

Hudson Bay Apparel Brands LLC v Umbro International Ltd [2010] E.T.M.R. 15

Breach of licence dispute concerning use of images in sports clothes advertising. High Court.

Nokia v IPcom (High Court 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_α 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 [2009] RPC 20

Supplementary Protection Certificate for medicinal product first marketed in EU before efficacy and safety testing required. CJEU reference

Napp v Sandoz and ratiopharm [2009] R.P.C. 18; [2009] R.P.C. 11
Validity and infringement of patents relating to controlled release pharmaceutical formulations. High Court, Court of Appeal.

Dupont v Smurfit [2008] EWHC 1231 (Ch)
Damages enquiry on patent threats action to determine losses attributable to defendant's threats. High Court, Court of Appeal.

Qualcomm v Nokia Corporation [2008] EWHC 329 (Pat)
Essentiality, infringement and validity of patents relating to GSM telecommunications involving analysis of GSM standards. High Court.

Triumph Actuation Systems v Eaton Corporation [2007] EWHC 1367 (Pat)
Patent infringement, aerospace hydraulic power transfer unit (PTU), added matter, validity, amendment. High Court.

Direct Line v esure [2008] R.P.C. 6; [2008] R.P.C. 5
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. IPO, High Court.

Nokia Corporation v InterDigital Inc. [2004] EWHC 2920 (Pat)
Claims for declarations of essentiality of patents under GSM standards justifiable. (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 & Partners IT Counsel of the Year 2006 for this case.

Harrison v Teton Valley Trading Co. Ltd [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. Court of Appeal.

Quiksilver v Charles Robertson (Developments) Ltd [2005] FSR 2
Trade marks, parallel imports, consent to importation from outside EU. High Court.

Interlotto v Camelot [2004] RPC 8; [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. High Court, Court of Appeal.

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. [2002] IP&T 781; [2004] FSR 25).
Agreement to divide use of Prudential name geographically. Community Trade Marks. Scope and enforcement in different European jurisdictions. High Court, Court of Appeal.

Thomson Licensing SA v PACE Microelectronics (High Court settled during trial in November 2001).
Patents or 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.

Times Newspapers Ltd v George Weidenfeld & Nicholson Ltd [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. High Court.

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

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 [2001] FSR 365; [2001] 439.
Patent infringement. Validity. Whether remanufacturing constitutes repair. Whether appellate court entitled to substitute its own evaluation of the facts. High Court, Court of Appeal, House of Lords.

Newspaper Licensing Agency v Marks and Spencer plc [2002] RPC 225.
Newspapers. Scope of copyright in typographical arrangement of published edition. Use of material or internal distribution. Fair comment. Reporting current events. High Court, Court of Appeal, House of Lords.

Springform Inc v Toy Brokers [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. Patents Court.

Springform Inc v Playhut Inc [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's technical contribution. Patents Court.

Mars Inc v Teknowledge Ltd [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. High Court.

Horne Engineering Ltd. V Reliance Controls plc [2000] FSR 90.
Patent for temperature control valve. Infringement. Validity. Clarity of claims. Patents Court.

Boehringer Ingelheim v Swingward Ltd (incs Glaxowellcome v Dowelhurst)[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. High Court, Court of Appeal.

Zino Davidoff SA v A & G Imports Ltd [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. High Court, ECJ.

Publications

Passing Off Law and Practice (Butterworths 2nd Edition 1995) co-author with John Drysdale.

Butterworths Patent Litigation (1995) edited by Gary Ropski, contributing author
Computer Law Blackstone Press 3rd Edition (1996) edited by Chris Reed, contributing author.

Intellectual Property and Technology Cases (Butterworths law report series) consulting editor 1999-2016

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

Memberships

Intellectual Property Bar Association (Secretary, 1992-1997)

Chancery Bar Association

Accredited Mediator (ADR Chambers)