



## Brian Nicholson KC

CEng, DEng(Hon), PhD, BEng(Hons), PgDipLaw, PgDipPLS,  
 FRSA, MIET, MBCS, MIEEE, MACM

**Called:** 2000

**Silk:** 2019

### Practice

Brian was appointed as one of Her Majesty's Counsel learned in the law in 2019 (QC, now KC) after serving 5 years as Standing Counsel for the Comptroller-General of Patents, Designs and Trade Marks (2014-2019). He has represented clients as leading or sole counsel in the United Kingdom's highest courts, including the Supreme Court, the Court of Appeal and the High Court. He has represented the United Kingdom before the Court of Justice of the European Union and appeared in the Supreme Court of Gibraltar.

With a very strong technical background, Brian particularly specialises in cases involving substantial and complex electronic or computing content, but he continues to practice in all areas of intellectual property, including having recently acted in Trade Mark and Design matters before the Supreme Court and the CJEU, pharmaceutical matters before the High Court, Court of Appeal and the CJEU, and confidential information, passing off and copyright matters before the High Court.

Brian has considerable and varied experience in major multi-jurisdictional litigation and is very well acquainted with working in international teams.

### What the directories say

*"Brian Nicholson KC is a highly regarded silk who has particular strength in handling patent and trade mark disputes. He is especially valued by technology clients as he has both commercial awareness and a comprehensive understanding of the technical aspects of his cases. He is particularly noted for his work in telecommunications, where his prior industry experience serves him well.."* **Chambers and Partners 2023 (IT)**

*"Technically very competent and extremely thorough in his approach, he's a good, robust advocate."* **Chambers and Partners 2023 (IT)**

*"Brian Nicholson KC is a razor-sharp and thorough silk recommended for his abilities assisting with hi-tech patent litigation proceedings involving telecommunications companies. His expertise encompasses cases concerning invalidation and infringement actions. His other areas of experience include Community design right disputes and pharmaceutical patent work. Sources highlight his deep knowledge in the field of electronics."* **Chambers and Partners 2023 (IP)**

*Brian Nicholson KC is fantastic. He is great on his feet, hard-working, and really cares about the case."* *"Brian goes over and above the call of duty to ensure a successful outcome."* *"Also known as 'Brain Nicholson', and he is quite a forceful advocate."* **Chambers and Partners 2023 (IP)**

*"He works incredibly hard and is very accommodating of truly demanding clients"* **Legal 500 2023**

*"Top IP silk across both patents and trade marks. Fantastic advocate – thoughtful and committed to the cause."* **Legal 500 2023 (IP)**

*"A barrister of the highest order," he is "terrifically easy to work with, good humoured, hard-working and very bright."* **Chambers and Partners 100 UK Bar**

## Education and appointments

2019	One of Her Majesty's Counsel learned in the law (now King's Counsel)
2014-2019	Standing Counsel for the Comptroller-General of Patents, Designs and Trade Marks
2007	European Engineer (Eur Ing, FEANI)
2006	Chartered Engineer (Engineering Council, UK)
2000	Called to the Bar (the Honourable Society of Lincoln's Inn)
1999-2000	Postgraduate Diploma in Professional Legal Studies (Inns of Court School of Law)
1998-1999	Postgraduate Diploma in Law (City University)
1995-1998	Doctor of Philosophy ' <i>Artificial Intelligence for the Robust Optimisation of Control System Stability</i> ' (University of Bath)
1992-1995	Bachelor of Electrical and Electronic Engineering (with first class honours) (University of Bath)

## Awards

2023	Chambers & Partners: IP/IT Silk of the year
2019	Chancellor's Roll of Honour, University of Bath
2018	Doctor of Engineering ( <i>honoris causa</i> ), University of Bath
2016	Vice-Chancellor's Roll of Honour, University of Bath
2015	Chambers & Partners: IP/IT Junior of the Year
2013	The Chambers 100 – listed in the top 100 UK junior barristers (across all sectors)
2013	Chambers & Partners: <i>nominated</i> as junior IP/IT Barrister of the year
2007	Chambers & Partners: <i>nominated</i> as junior Intellectual Property Barrister of the year
2000	Lincoln's Inn: The Cassel Major Scholarship
1999	Lincoln's Inn: The Sunley Major Scholarship
1999	Lincoln's Inn: Accommodation Scholarship
1998	Lincoln's Inn: Common Professional Examination Award
1998	Lincoln's Inn: Hardwicke Entrance Scholarship
1997	UPEC-97, UMIST: Best Conference Presentation Award
1995-1998	Engineering and Physical Sciences Research Council: Research Scholarship
1995-1998	National Grid Company plc: Collaborative Research Award
1995-1998	University of Bath: Postgraduate Research Scholarship
1995	University of Bath: Graduated in first place in University Department
1995	Institute of Electrical Engineers: Regional Prize Paper Award
1992-1995	THORN EMI Electronics Ltd: University Scholarship

## Selected recent cases

### Supreme Court

***Magmatic Ltd v. PMS International Ltd*** [2016] UKSC 12;  
 [2016] Bus. LR 371; [2016] ECDR 15; [2016] RPC 11  
 Registered Community Designs

***R v. M, R v. C, and R v. T*** [2017] UKSC 58;  
 [2017] 1 WLR 3006; [2017] 2 Cr. App. R 30  
 Criminal offences under the Trade Marks Act

***Virgin Atlantic Airways v Contour & ors***  
 [2013] UKSC 46; [2014] AC 160; [2013] 3 WLR 299; [2013] RPC 29;  
 [2013] EWCA Civ 1723; [2014] RPC 18;  
 [2012] EWHC 2153 (Pat); [2011] F.S.R. 27; [2011] R.P.C. 18; [2011] R.P.C. 8  
 Aircraft seating patents; *res judicata* of national proceedings pending EPO Opposition

**CJEU**

**DOCERAM GmbH v. CeramTec GmbH** (C-395/16) - Registered Community Designs

**Abraxis Bioscience LLC v. Comptroller-General of Patents** (C-443/17) [2017] EWHC 14 (Pat)  
 Patents; Supplementary Protection Certificates; Reference to CJEU

**Court of Appeal**

**Vodafone v. ICom** [2023] EWCA Civ 113  
 Re-opening appeals

**Dr Reddy's Laboratories & others v. Warner-Lambert Company LLC** [2023] EWCA Civ 73  
 Pharmaceutical Patent - Second Medical Use - Inquiry on cross-undertaking in damages

**ICom v. Vodafone** [2021] EWCA Civ 205  
 Telecommunication patent – Crown Use

**Optis v. Apple** [2021] EWCA Civ 1619  
 Telecommunication patent - essentiality

**Appeal to the High Court**

**Republic of Cyprus v. John & Pascalis Limited** [2018] EWHC 3226(Ch)  
 Trade Marks; Halloumi Certification Mark; *functus officio*

**Subsea Intervention v. Comptroller General of Patents** [2015] EWHC 3482(Ch)  
 Patent renewals; lapsed patents; non-payment; restoration.

**Crowley v. United Kingdom Intellectual Property Office** [2014] EWHC 3871(Ch)  
 Patentability

**High Court (first instance)**

**Optis v. Apple – FRAND**  
 Telecommunication patents – FRAND licensing

**Dr Reddy's & Ranbaxy & others v. Warner-Lambert** [2021] EWHC 2182(Ch)  
 Pharmaceutical patent – inquiry on cross-undertaking as to damages – preliminary issue trial

**Facebook Ireland Limited v. Voxer IP LLC** [2021] EWHC 1377(Pat)  
 Computing technology patent – social media

**ICom v. Vodafone** [2020] EWHC 132 (Pat)  
 Telecommunications Patent – validity and infringement

**Claydon Yield-O-Meter Limited v. Mzuri Limtied** [2021] EWHC 1007 (IPEC)  
 Agricultural machinery patents – validity and infringement

**TQ Delta v. ZyXEL** [2019] EWHC  
 ADSL Patents; RAND licensing

**Apple Retail UK Ltd v. Qualcomm (UK) Ltd** [2018] FSR 27;  
 [2018] EWHC 1188 (Pat)  
 Abuse of a dominant position; FRAND; Mobile patents

**Capital Markets Co (UK) Ltd v. Tarver** [2017] EWHC 2885(Ch); [2018] 1 Costs LR 65;  
 [2017] EWHC 2467 (Ch)  
 Breach of fiduciary duty; confidential information; copyright; high value costs

***Clearswift v. Glasswall (IP) Ltd*** [2018] EWHC 2442 (Pat); [2018] EWHC 1946 (Pat)  
 Computer anti-malware software patent

***Garmin (Europe) Ltd v. Koninklijke Philips N.V.*** [2017] EWHC 8165 (Pat)  
 GPS fitness training patents

***Martinez (t/a Prick) v. Prick Me Baby One More Time Ltd (t/a Prick)*** [2018] ETMR 27  
 Passing off

***Varian Medical Systems International AG v. Elekta Ltd*** [2017] EWHC 712 (Pat);  
 [2017] EWHC 55 (Pat); [2016] EWHC 2679 (Pat)  
 Magnetic Resonance Imaging patent

***American Science & Engineering v. Rapiscan Systems Ltd*** [2016] EWHC 756 (Pat);  
 [2016] EWHC 1384 (Pat); [2016] EWHC 289 (Pat)  
 Patents; X-ray systems; 'offering to dispose of'; indemnity costs; admissions

***Unwired Planet International Ltd v. Huawei Technologies Co Ltd*** [2015] EWHC 3366(Pat);  
 [2016] Bus LR 435  
 Mobile telephone patents; FRAND

***Comptroller-General of Patents Designs and Trade Marks v. Intellectual Property Agency***  
 [2016] FSR 22  
 Passing off; trade mark infringement; account of profits

## **Employment and additional experience**

Over the last 30 years, Brian has held a number of different engineering roles in a variety of different companies from SMEs to a PLC and has been a non-executive director of successful start-ups. His significant hands-on engineering experience was recognised by his qualification as a Chartered Engineer in 2006 and as a European Engineer in 2007. Brian has also served as an officer in the Royal Naval Reserve.

## **Memberships**

Brian is a professional member of the Institute of Engineering and Technology, the Institute of Electrical and Electronic Engineers, the British Computer Society, the Association for Computing Machinery, the Chancery Bar Association, and the Intellectual Property Bar Association. In 2006 he was elected as a Fellow of the Royal Institution of Great Britain, and in 2009 was elected as a Fellow of the Royal Society for the encouragement of Arts, Manufactures and Commerce.