



Iain Purvis QC

Called: 1986
Silk: 2006

Practice

Iain was appointed as Queens Counsel in 2006 and is now noted as one of the most in demand and successful established silks at the IP Bar.

He is highly regarded both for his incisive approach to litigation and for his ability to grasp intricate technology with ease. He has a wide-ranging practice which extends from mobile telephony and pharmaceutical patents to musical copyrights and protection of image rights.

Iain is a Deputy High Court Judge, sitting in the Chancery Division including the Patents Court, a Civil Recorder and a Judge of the Intellectual Property Enterprise Court. He is also an Appointed Person, hearing appeals from decisions of the Trade Marks Registry. He is also a qualified mediator and has been involved in a number of arbitrations both as advocate and arbitrator.

Iain's outstanding reputation in his area of law was echoed at the 2014 Chambers and Partners Bar Awards where he was awarded 'IP/IT Silk of the year'.

What the directories say

"A very cerebral lawyer who fights hard and is a real asset." – **Chambers and Partners**

"Exemplary in all senses. He has the ability to zoom back and look at cases from a strategic viewpoint." "His advocacy is seamless, eloquent, and a pure joy to listen to, though less so when you are against him! He is a strategic maestro who knows the case-winning effectiveness of a good story." – **Chambers and Partners**

"Has a calm, balanced approach and is extremely bright." – **Legal 500**

"One of the most sought-after silks at the Intellectual Property Bar, and regarded as an extremely bright and effective barrister who provides adept representation in both High and Supreme Court proceedings. He is well known for his skill in trade mark litigation, and is also recommended for patent disputes involving hi-tech and pharmaceutical companies." –

Chambers and Partners

"His breadth of experience is a clear advantage, as is his keen eye for technical detail and his ability to appreciate wider legal and commercial issues. He offers very clear advice and is extremely thorough." "He is a personable, reflective, incisive and effective advocate who is always part of the team." – **Chambers and Partners**

"He is an incredibly intelligent, thoughtful and tenacious litigator." – **Legal 500**

Education and Qualifications

MA (Cantab) , BCL (Oxon)
1986 Called to the Bar (Inner Temple) 2006 Appointed Queens Counsel 2010 Selected as Appointed Person
2011 Appointed as Civil Recorder
2012 Appointed as Deputy Judge High Court
2013 Appointed Judge of the Intellectual Property Enterprise Court

Recent & Reported Cases

Regeneron Pharmaceuticals v Kymab [2020] UKSC 27

Iain represented the successful appellant, Kymab Limited, in a landmark ruling on the law of sufficiency, the Supreme Court (Lord Briggs giving the leading judgment) overturned by a 4-1 majority the judgment of the Court of Appeal (Kitchin LJ, Arden LJ and Floyd LJ), thereby restoring the decision of the late Henry Carr J that Regeneron's patents were invalid.

Akebia Therapeutics Inc v Fibrogen, Inc & Astellas [2020] EWHC 866 (Pat)

A multi-patent action concerning the use of an enzyme inhibitor to treat anaemia and related conditions. The patents in issue fell into two families – Family A & Family B – and included claims to classes of compounds and to single compounds. Akebia sought revocation of the patents to clear the way for launch of its pharmaceutical product. The grounds for revocation included insufficiency and obviousness. Fibrogen was the patentee and Astellas its exclusive licensee. Astellas counter-sued for infringement, alleging both literal infringement and infringement by equivalents. Arnold LJ, who came down from the Court of Appeal to hear the case at first instance, held that the Family A patents involved inventive step but, to the extent that they covered classes of compounds, were insufficient. The Family B patents were obvious. He further held that certain claims of the Family A patents were infringed on a literal basis, but dismissed the infringement claim based on equivalence to the single compound. There was insufficient threat of infringement of the Family B patents. Permission to appeal has been granted in respect of the findings of invalidity. Points of interest include the Judge's comments on the utility of primers, the instruction and cross examination of expert witnesses, infringement by equivalence and how to assess a threat of infringement based on the likelihood of future 'off label' prescribing

TQ Delta, LLC v ZYXEL Communications Ltd & Anor [2019] EWHC 562

The Claimant, TQ Delta, was the proprietor of two patents relating to Digital Subscriber Line ("DSL") broadband internet technology. EP (UK) 1 453 268 concerned a method for controlling the proportion of transmission bandwidth occupied by overhead data. EP (UK) 1 792 430 was directed at ensuring that DSL lines report detected errors in a consistent manner. TQ Delta asserted that the patents were each essential to various DSL standards, including ADSL2, ADSL2+, and VDSL2+. It commenced infringement proceedings against the Defendants, ZyXEL, in late 2017, seeking relief including declarations as to Reasonable And Non-Discriminatory ("RAND") terms upon which it could be obliged to licence ZyXEL. Following a trial of the technical issues in January and February 2019, Henry Carr J revoked EP 1

729 430 for obviousness but found EP (UK) 1 453 268 to be valid and essential to the standards concerned. The '268 Patent expires in June 2019. Iain appeared for the Defendant

SSH Communications Security Corporation v Sony Mobile Communications AB & Ors [2018] EWCA Civ 2237

Iain appeared for the patentee in this unusual ex parte appeal seeking the setting aside of an order for revocation of a patent under the principle in *Haliburton v. Smith* [2006] EWCA Civ 185.

Jushi Group Co Ltd v OCV Intellectual Capital LLC [2018] EWCA Civ 1416

Iain acted for the Respondent in this appeal from a decision of IPEC upholding the validity of a patent for a range of compositions for making glass fibre. There was no disclosure in the prior art of any individual glass fibre composition falling within the claims, but there was a disclosure of an overlapping range of glass fibre compositions. The Court of Appeal upheld HHJ Hacon's decision that the overlapping range did not deprive the claims of novelty or inventive step applying conventional principles as explained in *Synthon* and *Dr Reddy's*. The judgment contains a discussion of the EPO's 'serious contemplation' test for novelty in the context of overlapping ranges and its compatibility with those principles.

Liqwd Inc and Olaplex LLC v L'Oreal (UK) Ltd & L'Oreal SA [2018] EWHC 1394 (Pat)

Iain successfully acted for Liqwd Inc in a patent infringement claim against L'Oréal in relation to the latter's Smartbound product. The Court held that Liqwd had been successful in establishing that amended claim 11 of its patent (a claim to the use of maleic acid as an active agent to reduce or prevent hair damage by bleaching products) was valid and infringed.

Edwards Lifesciences LLC -v- Boston Scientific Scimed Inc [2018] EWCA Civ 673

Iain appeared for the Appellants in the Court of Appeal, where they upheld the High Court's decision that one of two patents owned by Boston Scientific Scimed Inc. relating to replacement heart valves was invalid, and the other valid and infringed by Edwards Lifesciences companies. In the first instance decision HHJ Hacon found that the first patent (EP'254) was obvious over a prior art document called Thornton, but found that the other patent (EP'766) was valid and partially infringed by Edwards.

Illumina Inc & Others -v- Premaitha Health Plc and Others [2017] EWHC 2930 (PAT)

Iain successfully acted for Illumina in a claim that a non-invasive prenatal diagnosis test offered by Premaitha infringed five related patents and that a gender testing component of an Ariosa Diagnostics product infringed a further patent. This case involved involving three principal patents, two divisionals and two sets of defendants. The patents related to non-invasive prenatal testing (e.g. for gender or disorders such as Down's syndrome), and the case involved next-generation DNA sequencing technologies.

Fisher & Paykel Healthcare Ltd & Anor v ResMed Ltd & Anor [2017] EWHC 2748 (Ch)

Iain acted for the Claimants in this action for a declaration of invalidity and/or non-infringement of three patents, each of which was concerned with features of masks to be used with continuous pressure airway pumps for the treatment of sleep apnea. Shortly before trial the patentee consented to revocation of two of the patents. The trial of the third patent involved consideration of construction and the doctrine of equivalence in the light of the recent *Actavis* judgment in the Supreme Court. Richard Meade QC, sitting as a Deputy High Court judge, held that the patent was invalid for lack of inventive step.

Victoria Plum Ltd (t/a Victoria Plumb) v Victorian Plumbing Ltd & Ors [2016] EWHC 2911 (Ch)

Iain acted for the Claimant in this action for trademark infringement by the defendant's use of its mark as a paid search term on Google in response to searches for the claimant's name but did not object to any other uses by the defendant of its name for advertising and promotion.

The defendant argued that both parties should be entitled to advertise against searches for the other's name under the doctrine of honest concurrent use but made a conditional counterclaim for passing off by the claimant if it was wrong. The court rejected the defendant's primary argument and held that neither party was entitled to bid on the other's name as a paid search term.

Nicocigs Limited v Fontem Holdings Limited [2016] EWHC 2161

Acting for Nicocigs in an revocation/declaration of non-infringement action concerning Fontem's Patent for e-cigarettes. The Patent was held invalid on the grounds of obviousness over two pieces of prior art, anticipation under s2(3) by a 'poisonous' co-pending application (the Patent not being entitled to priority from their common priority document), and added subject matter.

Saab Sea-eye Limited v Atlas Elektronik GmbH [2015] EWHC 3163 (Pat)

Acting for Atlas in a Patents Court trial concerning the alleged infringement and validity of two of their Patents for underwater mine clearance equipment. Validity was attacked on the ground of anticipation and obviousness over various cited prior art and insufficiency. The Patents were held valid (one wholly and the other partially) and infringed.

The case went to the Court of Appeal, Saab Sea-eye Limited v Atlas Elektronik GmbH [2017] EWCA Civ 2175. The Court of Appeal allowed the appeal in relation to the 861 patent, but dismissed it in relation to the 576 patent.

Comic Enterprise Limited v Twentieth Century Fox Corporation [2016] EWCA Civ 41 and [2016] EWCA Civ 455

20th Century Fox appealed against a finding that its well-known GLEE television series infringed a registered series of device marks incorporating the word GLEE owned by a comedy club business on the basis of a likelihood of so-called 'wrong way round confusion'. In the second part of this Appeal, 20th Century Fox asked for a reference to the CJEU on the question of whether the home-grown UK provisions on 'series marks' under s41 of the Trade Marks Act 1994 were compatible with the Trade Marks Directive.

American Science & Engineering Inc v Rapiscan Systems Ltd [2016] EWHC 756 (Pat)

Patents Court trial relating to a claim by AS&E that Rapiscan had infringed one of AS&E's covert X-ray inspection patents. Rapiscan conceded infringement but persisted with its attack on the validity of AS&E's patent.

Cadbury UK Limited v Comptroller-General of Patents, Designs and Trade Marks [2016] EWHC 796 (Ch)

Cadbury appealed against the decision of the IPO to refuse them permission to delete part of a registration for the Cadbury purple house colour. The application was made to remove wording in the registration which covered the use of the purple colour as the 'predominant colour' applied to the visible surface of the packaging of chocolate.

Unwired Planet International Ltd v Huawei Technologies Co Ltd & Ors [2016] EWHC 576 (Pat) Trial C

The third technical Patents Court trial in the mobile telecommunications patent case relating to a "Method for improving handovers between mobile communication systems" and concerned handover between different radio access technologies including GSM (2G), UMTS (3G) and

LTE (4G).

Accord Healthcare Ltd v Astellas Pharma GmbH [2015] EWHC 3676 (Ch)

This case concerned the correct interpretation of Articles 6, 8 and 10 of Directive 2001/83/EC on medicinal products for human use (the “Directive”). Accord applied for marketing authorisations for a generic version of bendamustine, an anti-tumour drug. It sought to take advantage of the Article 10 exemption from the requirement to file results of pre-clinical tests and clinical trials by relying upon an earlier marketing authorisation for bendamustine. To avoid any challenge to its application for a UK marketing authorisation, Accord applied for a declaration from the Court that the Ribomustin MA had been granted in accordance with the Directive and that Ribmoustin could be relied upon as a reference product under Article 10.

Starbucks (HK) Ltd v BSKyB & ors [2015] UKSC 31

Passing off claim in relation to a Hong Kong TV subscription service under the name “NOW TV” that enjoyed a reputation amongst members of the Chinese speaking community in the UK and was accessed and enjoyed for free in the UK via the internet. The Appellants sued for passing off when BSKyB launched their “NOW TV” service in the UK. The key issue was whether the Appellants could establish goodwill in the jurisdiction. The Supreme Court held that BSKyB could not rely on their reputation in the UK as the people using their service were not “customers” within the jurisdiction because they received the services for free.

IPCom v HTC & ors [2015] EWHC 1034 (Pat)

Validity, infringement and essentiality of the Patent (previously upheld as valid and essential to the UMTS Standard by the UK Court of Appeal) following amendment of the Patent in Opposition Proceedings before the EPO. Patents Court. Court of Appeal pending.

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

High Court action concerning the copyright in the “Dude” logo – the cartoon face with a halo which is used by Innocent Smoothies. Deepend sought a declaration that it was the owner of copyright in the Dude (in law or in equity), alternatively that any claim against it for infringement was barred due to acquiescence. The Judge held at trial that Innocent owned the copyright in equity and were thus entitled to an assignment of legal title from Deepend Fresh Recovery Ltd.

ASSIA v British Telecommunications [2014] EWCA Civ 1462; [2013] EWHC 3768 (Pat)

Patent infringement and validity trial relating to management of DSL broadband. Iain acted for the Claimants, ASSIA., in the Patents Court trial at which infringement was established and the Court of Appeal subsequently upheld this decision.

Servier v Apotex Les Laboratoires Servier v Apotex Inc (Rev 1) [2014] UKSC 55 ; [2012] EWCA Civ 593; [2011] R.P.C. 20; [2008] EWHC 3289 (Pat); [2008] EWHC 2563 (Pat); [2009] F.S.R. 3; (2008) 31(6) I.P.D. 31039; [2007] EWHC 1538 (Pat); [2007] EWHC 591 (Pat); [2006] EWHC 2453 (Pat)

This action stemmed from an original application by Servier for an injunction against Apotex relating to Apotex’s sale of perindopril tablets imported from Canada. Iain acted at the trial, the subsequent appeal, the inquiry under the cross-undertaking and most recently appeals and in the Supreme Court.

Compactgtl Ltd v Velocys Plc & Ors [2014] EWHC 2951

Velocys brought an action in the High Court for infringement of two patents relating to structured catalysts for use in the ‘Fischer-Tropsch’ gas-to-liquid conversion process in the petrochemical industry. Compactgtl denied infringement and counterclaimed for revocation. The

patents were held valid and infringed. An amendment to both patents was permitted which corrected an 'obvious error' in the claims. Appeal pending.

ASSIA v British Telecommunications [2013] EWHC 3768 (Pat)

Patent infringement and validity trial relating to management of DSL broadband. Iain acted for the Claimants, ASSIA., in the Patents Court trial at which infringement was established.

Kennametal Inc v Pramet Tools SRO & Anor [2014] EWHC 565 (Pat)

Patent infringement and validity trial relating to inserts for cutting tools. Iain acted for the Defendants, a subsidiary of Sandvik, achieving a finding of non-infringement and invalidity.

Société Des Produits Nestlé SA v Cadbury UK Ltd [2014] EWHC 16 (Ch)

High Court appeal of an earlier decision from the IPO in relation to the trade mark application for the 3 dimensional shape of a KitKat. Reference to the CJEU pending

Boxing Brands Ltd v Sports Direct Int PLC & ors [2013] EWHC 2200

Iain acted for Boxing Brands in this trade mark infringement action concerning the infringement and ownership of the QUEENSBERRY mark used for sporting equipment and clothing. High Court, obtaining both interim and final injunctions

Virgin Atlantic Airways Limited v Contour Aerospace and others [2013] EWCA Civ 1713 [2012] EWHC 2153 (Pat)

Trial and appeal in long running dispute concerning first class seating in aeroplanes. Iain acted for the successful defendants/respondents.

Virgin Atlantic Airways Limited v Contour Aerospace and others [2013] UKSC 46

Iain acted for Zodiac on its appeal to the Supreme Court on the so-called *Unilin point* (that damages remain payable after a UK infringement trial even if the patent is subsequently amended or revoked in the EPO). The case raised a difficult questions of res judicata. The Supreme Court overturned 115 years of authorities in allowing the appeal by the Defendants.

Force India Formula One Team Ltd v 1 Malaysia Racing Team Sdn Bhd [2013] EWCA Civ 780; [2012] EWHC 65 (Pat);

Iain appeared for the successful Defendants/Respondents in this trial and appeal in relation to misuse of confidential information regarding wind tunnels used for development of Formula 1 cars, including the issue of damages.

BSkyB v Microsoft [2013] EWHC 1826

Iain acted for Sky, in its successful claim against Microsoft over the use of SkyDrive for Microsoft's cloud storage solution. The claim was founded on infringement of UK and Community trade and passing off.

Nokia Oyj (Nokia Corp) v ICom GmbH & Co KG [2012] EWCA Civ 567; 2012 WL 1555303 [2011] EWHC 1470 (Pat)

Trial and appeal in relation to standard-essential mobile telephony patents held by ICom. The action continues to establish damages and to set terms of a FRAND licence.

Stichting BDO v BDO Unibank Inc [2013] EWHC 418

Iain acted for the successful defendants, BDO Unibank, in their defence of claim for trade mark infringement by Stichting BDO through their use of the name BDO Remit for financial services.

Generics (UK) Ltd (t/a Mylan) v Novartis AG [2012] EWCA Civ 16263; [2011] EWHC 2403

(Pat)

Patent invalidity claim against pharmaceutical “exelon” used for treating symptoms of Alzheimers. Patents Court and Court of Appeal.

Specsavers v ASDA [2012] E.T.M.R. 17; [2011] FSR 1

Trade Mark and passing off action in relation to an advertising campaign launched by ASDA. Iain appeared both at First Instance and in the Court of Appeal.

Molnlycke Health Care v Brightwake [2012] EWCA Civ 602; [2011] EWHC 376 (Pat)

Patent court trial and Appeal in relation to infringement of patents for wound dressings.

Nokia v Ipcom [2012] EWHC 225 (Pat)

Another patent revocation trial concerning mobile telephone technology

Ate My Heart Inc (AKA Lady GaGa) v Mind Candy Ltd [2011] EWHC 2741 (Ch)

Trade mark infringement concerning a character in an on-line game called “Lady Goo Goo”. Iain appeared for Lady Gaga and successfully obtained an interim injunction.

Generics (UK) Ltd (t/a Mylan) v Novartis AG [2011] EWHC 2403 (Pat)

Patent invalidity claim against pharmaceutical “exelon” used for treating symptoms of Alzheimers. (appeal pending)

Future Publishing Ltd v Edge Interactive Media Inc [2011] E.T.M.R. 50

Passing off, infringement of copyright and trade mark issues regarding logos used for computer games.

Best Buy Co Inc v Worldwide Sales Corp Espana SL [2011] F.S.R. 30; [2010] Bus. L.R. 1761; [2010] E.T.M.R. 54; [2010] F.S.R. 35

Unreasonable threats regarding trade mark infringement “BEST BUY”

Tate & Lyle v Roquette [2011] F.S.R. 3; [2010] F.S.R. 1 Patent Revocation concerning sweetener “maltitol”

EI Du Pont de Nemours v UKIPO [2010] R.P.C. 6; (2010) 11 B.M.L.R. 15; (2010) 33(1) I.P.D. 33002

Extension of SPC under Paediatric Regulation for the drug losartan.

Molnlycke v Wake Forest [2009] EWHC 2204 (Pat); (2009) 32(10) I.P.D. 32072

Patent revocation concerning vacuum wound care products.

Kelly and another v GE Healthcare [2009] EWHC 181 (Pat); [2009] WLR (D) 50

The first successful claim for employee compensation under section 40 of the Patents Act 1977.

Aerotel v Wavecrest [2009] EWCA Civ 408; [2009] Info. T.L.R. 88; (2009) 32(8) I.P.D. 32052; [2009] Bus. L.R. D117

Patent for method of making telephone calls ; obviousness; excluded matter.

Whirlpool v Kenwood [2009] EWCA Civ 753; [2010] E.T.M.R. 7; [2010] R.P.C. 2; [2009] E.T.M.R. 5; [2009] R.P.C. 2

Infringement of “shape mark” for mixer ; detriment and unfair advantage under Article 9(1)(c) of Trade Marks Regulation. Passing off.

***Siemens Schweiz AG v Thorn Security Ltd* [2009] R.P.C. 3; (2009) 32(2) I.P.D. 32008; [2009] Bus L.R. D67; [2008] R.P.C. 4**

Patent action concerning coating for printed circuit boards.

***Scopelight Ltd v Chief Constable of Northumbria* [2010] Q.B. 438; [2010] 2 W.L.R. 1138; [2010] 2 All E.R. 431; [2010] 1 Cr. App. R. 19; [2010] Lloyd's Rep. F.C. 1**

Infringement of copyright

***Hotel Cipriani v Cipriani (Grovesnor Street Limited)* [2010] Bus. L.R. 1465; [2010] R.P.C. 16; [2009] R.P.C. 9; [2009] Bus. L.R. D81**

Trade Mark infringement, bad faith, own name defence, passing off, "famous mark" infringement under s56.

***Honda v Neesam, KJM & others* [2009] 1 W.L.R. 2406; [2009] 3 All E.R. 76; [2009] C.I.L.L. 2645; (2008) 158 N.L.J. 1683; [2008] R.P.C. 32**

Infringement of trade mark; parallel importation; consent

***Fisher v Brooker* [2009] UKHL 41; [2009] 1 W.L.R. 1764; [2009] Bus. L.R. 1334; [2009] 4 All E.R. 789; [2009] F.S.R. 25; [2008] EWCA Civ 287; [2008] Bus. L.R. 1123; [2008] E.M.L.R. 13; [2008] F.S.R. 26; [2007] E.M.L.R. 9; [2007] F.S.R. 12**

Copyright ownership; lapse of time for claim; "A Whiter Shade of Pale".

***Cinpres v. Melea* [2008] R.P.C. 17; [2006] EWHC 2451 (Ch)**

Injection moulding process patent; ownership; allegation that prior judgment obtained by fraud.

***Dearlove (t/a Diddy) v Combs (t/a Sean Puffy Combs, Puffy and P Diddy)* [2008] E.M.L.R. 2**
Action concerning agreement for use of the name "Diddy"

***Almighty Marketing Limited v Milk Link Limited* [2006] RPC 18**

Trade Mark revocation ; non-use ; standard of evidence required

***Tesco Stores Application* [2006] FSR 4**

TM opposition; slogans; intention to use.

***Burden Group Plc v. Ultraframe* [2005] EWCA Civ 867; (2005) 28(9) I.P.D. 28063**

Conservatory components patent; infringement; validity

***Ultraframe v. Fielding (No. 2)* [2005 reported in part 2006 FSR 17]**

Design rights ; ownership ; pleadings ; status of exclusive licence

***Cyprotex Discovery Limited v. University of Sheffield* [2004] RPC 4 (CA) and 44 (Technology and Construction Court)**

Computer programs; ownership of copyright; scope of licence; construction of agreements

***Compass Publishing BV v. Compass Logistics Limited* [2004] RPC 41** Infringement; validity; prior rights under community trade mark.

***IBM v. Websphere* [2004] FSR 39**

Infringement; validity – descriptiveness; malicious falsehood

***Jobserve v. Skillsite* [2004] FSR 36**

Database of cv's; infringement; breach of undertakings to court; contempt.

Ultraframe v. Fielding (No. 1) [2003] RPC 23

Design rights; ownership; director's duties.

Guardian Media Group v Associated Newspapers [2001 CA]

"Metro" trade mark; interim injunction; scope of "Nationwide" Order

Publications

'Working with Technology',
Co-Author Sweet & Maxwell 2001

Memberships

IPBA ChBA