



SLAUGHTER AND MAY

Intellectual Property

“A broad and impressive IP offering with particular strengths in corporate and commercial transactions centring on IP, and heavyweight litigation.”

Chambers UK

Intellectual Property /

Our Intellectual Property group advises clients on all aspects of the creation, exploitation and enforcement of intellectual property rights. Our clients operate in a wide range of sectors including life sciences, biotechnology and healthcare, technology, financial services, telecommunications, media, publishing, sport, consumer goods and retail.

We combine depth of IP expertise with the quality and service of a leading international law firm to advise clients on their most challenging disputes and innovative deals.

We provide our clients with multi-nationals, strategic IP advice, in areas such as:

- **Dispute Resolution** - We represent IP owners in complex patent actions and all forms of dispute relating to trade marks, passing off, copyright, database rights, design rights and breach of confidence claims. We regularly advise on cross-border litigation strategy and are skilled in managing large scale cross-border patent disputes, working with the best lawyers internationally. Our experience encompasses multi-jurisdictional and domestic disputes at every level including in the courts, IP registries and in arbitration. We have lawyers with scientific backgrounds who will get to grips with the relevant legal and technical issues quickly.
- **Unified Patent Court** - We are advising clients on the impact of the forthcoming reforms to patent litigation in Europe with the introduction of the Unitary Patent and the Unified Patent Court system. This includes advising on filing and enforcement strategies as well as on the preparatory actions to be taken before the new system enters into force. We were involved in advising the UK Government on the proposals for the Unified Patent Court and contributed to consultations on its Rules of Procedure.

- **Business critical commercial IP agreements** - An important part of our practice involves advising on patent and trade mark licensing, distribution agreements, sponsorship agreements and franchising deals. We also provide strategic advice in managing and commercialising patent and trade mark portfolios. Our specialist life sciences, biotechnology and healthcare team deals with licensing, collaboration, research and development agreements.
- **Mergers and acquisitions and private equity transactions** - We have a pre-eminent reputation for transactional IP work including advising on mergers and acquisitions, disposals and joint ventures where technology or brands are integral to the transaction, structure or value. This includes advising clients on the assessment of IP portfolios, the creation and enforcement of security interests over intellectual property assets and sophisticated licensing structures.
- **IP related technology issues** - We regularly advise on the IP aspects of complex software licences, technology transfers, development and maintenance agreements and technology sourcings. We help clients understand the IP issues arising from innovations in digital technology in areas including the Internet of Things, Robotics, Artificial Intelligence and 3D Printing. We also advise established financial institutions, global technology and telecoms companies, investors and start-ups on the IP implications of their fintech activities.
- **Competition issues** - we advise on competition issues arising in the IP and technology field. We have played an innovative role in developing competition law defences to patent infringement actions in the UK courts and have considerable experience of advising clients in standards-intensive industries in the developing area of FRAND licensing.

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We were very impressed with their IP capabilities and personnel and think they did an outstanding job.

Chambers UK 2016

They are very good at getting themselves aligned and so the advice is consistent...The quality of the associates is impressive.

Chambers UK, 2015

Slaughter and May is recommended for its transactions, and is also known for its ‘tactically very smart’ approach to IP protection and litigation strategies.

The Legal 500, 2014

The team’s litigation expertise is equally formidable, as is its standalone franchising and licensing capability.

Chambers UK, 2013

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Slaughter and May /

Who we are

Slaughter and May is a leading international law firm recognised throughout the business community for its commercial awareness and commitment to its clients. In essence, the firm is about quality, market wisdom and good judgement, a constant found throughout its 126 year history

Our culture allows us to have an unfailing focus on the importance of client relationships - clients who in their most challenging moments value advice delivered with personality. Each of our lawyers is a multi-specialist rather than a technician, equipped to turn their hand to a broad range of legal matters.

A genuinely global service

We provide a cross-jurisdictional legal service that reflects what 'global' means for our clients. We drive change as much as we keep up with it, help form new strategies as much as we adapt to them, and realise and develop commercial opportunities as well as assess risk.

Our unique approach to being an international law firm gives us the ability to lead unified, hand-picked teams of the best lawyers around the world. Every situation and every transaction is unique and our international model gives us the clarity to see clients' challenges in their full global and local context.

This enables us to offer not only depth of expertise but also breadth of experience and sound commercial judgement. We often produce the unexpected on the most complex of matters in order to deliver success for our clients

- Central to our culture is the priority that we place on the individual needs of our clients
- We are client rather than product focused
- A client team can advise across a range of practice areas so our clients work with lawyers they know

Our IP clients and the IP matters on which we advise are often multi-jurisdictional and increasingly global.

Much of our work involves strategic advice on international IP matters such as strategy in relation to the selection and adoption of global brands, cross-border patent litigation and international franchising agreements.

They invest time to make sure they understand our business goals and objectives. They invariably find solutions to complex issues; nothing seems to faze them. We received total commitment from them.

Chambers Europe, 2016

Recent experience

The following list is intended to give a brief indication of our experience in intellectual property matters:

- Advising **GlaxoSmithKline** on its agreement with Verily Life Sciences LLC (formerly Google Life Sciences), an Alphabet company, to form a joint venture, Galvani Bioelectronics, to enable the research, development and commercialisation of bioelectronic medicines
- Advising **Actelion** on the blockbuster tender offer by Johnson & Johnson to acquire it. This was Johnson & Johnson's "biggest deal in its 130-year history" with IP being one of the key assets
- Acting for **Tottenham Hotspur** in connection with a supply and sponsorship agreement with a leading global sportswear manufacturer, core to which are the licensing arrangements in respect of both parties' globally iconic brands. We are also advising the Club on their commercial partnerships strategy and a range of other sponsorship opportunities
- Successfully acting for **Speciality Fibres and Materials** in High Court and Court of Appeal proceedings involving Smith & Nephew and ConvaTec concerning multiple patents and a range of other IP rights
- Advising on the overall brand protection and licensing strategy for **Waitrose's** global B2B distribution network, including auditing Waitrose's existing licensing models and producing a detailed risk analysis of the key IP, commercial and competition challenges
- Advising **Ambatana** on the licensing of its "Letgo" brand and proprietary technology platform for the distribution of mobile classified advertisements via social media, including on the associated source code escrow arrangements
- Acting for **Dyson Technology Limited** in a legal action relating to a possible breach of confidentiality and proprietary information relating to its development programme to its competitor, Bosch
- Advising on the intellectual property aspects of an innovative project using blockchain technology for **DPactum**
- Advising **GlaxoSmithKline** on its major three-part interconditional transaction with Novartis involving combining their Consumer Healthcare businesses to form a new world-leading Consumer Healthcare business; GSK acquiring Novartis' global Vaccines business (excluding influenza vaccines); and GSK selling its marketed Oncology portfolio and other assets and rights to Novartis
- Advising **Cambridge Silicon Radio** on a transaction involving complex IP licensing with Samsung Electronics for the transfer of CSR's development operations in handset connectivity and location
- Advising **ITV** on its £355 million acquisition of fast growing Netherlands based TV production and distribution company Talpa Media, creator of The Voice and Dating in the Dark, among other programmes

- Advising **Rolls-Royce** on the establishment of a long-term 50:50 joint venture with Hispano-Suiza, relating to aero engines
- Advising **London Resort Company Holdings Limited** on a Development Agreement with BBC Worldwide
- Advising **Star India** on its successful bid for global visual/media and licensing rights to the ICC cricket events
- Advising **Virgin Enterprises Limited** on the licensing of the Virgin name in relation to Virgin Money's IPO and the sale of Virgin Active Gyms
- **Fresenius** in multijurisdictional patent litigation
- **Activa Healthcare** in relation to cross border litigation
- Advising **Reckitt Benckiser** in relation to the demerger of the RB Pharmaceuticals business to form Indivior plc
- Advising **Diageo** on its transaction to acquire a stake in United Spirits, the leading spirits company in India for £2.4 billion
- Advising **Cambridge Silicon Radio** on the recommended cash offer by Qualcomm, which values CSR plc at approximately £1,560 million
- Advising **Premier Foods** on a number of divestments including the sale of its sweet spreads and jellies business under the Hartley's, Robertson's, Frank Cooper, Keiller, Gale's and Sun-Pat brands to the Hain Celestial Group Inc. for a consideration of £200 million
- Advising **Monsoon Accessorize** on their international franchising agreements
- Advising **Marks & Spencer** on their worldwide franchising arrangements
- Advising **INEOS** on a 50/50 joint venture with BASF SE to combine their global business activities in styrene-based copolymers as well as copolymers blends
- Advising **Unilever** on the sale of Sanex to Colgate-Palmolive and the purchase from Colgate-Palmolive of its laundry detergent brands in Colombia
- Advising **Bertelsmann**, the German media group, on the combination with Pearson of their respective trade-book publishing companies Random House and Penguin Group into a newly-created joint venture named Penguin Random House
- Successfully acting for **Vestas Wind Systems** in High Court patent litigation proceedings involving multiple patents
- Advising **YTL Communications**, a leading Malaysian technology and infrastructure company on an agreement for the licensing and development of patented technology and software to build the world's first hybrid broadcast - 4G WiMAX broadband TV and internet content delivery platform
- Acting for **Ladbrokes** in High Court litigation with the British Horseracing Board concerning database rights issues
- Advising **Reed Executive** in relation to trade mark co-existence and internet use and in co-ordination of proceedings in the English courts and various registries
- Advising the **England and Wales Cricket Board** on its major Sponsorship and Kit Supply Agreement with adidas (UK) Limited
- Advising **Arsenal** in relation to sponsorship and image rights agreements and a fifteen year sponsorship agreement with Emirates and on other matters.

Key Contacts /

For further information on any intellectual property related matter, please contact any of the Partners listed below:



Susie Middlemiss

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Susie Middlemiss heads the Intellectual Property practice, and has considerable experience in IP litigation and dispute management in relation to patents, trade marks, copyright, database rights and breach of confidence. Susie also advises on licensing and other commercial agreements and transactions in which IP or technology is a major asset.



Cathy Connolly

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Cathy Connolly advises on all aspects of intellectual property and technology. Her practice includes the protection and exploitation of patents, trade marks, copyright and know-how and she has extensive experience advising on licensing, franchising, technology transfer and the IP and technology aspects of corporate transactions.



Rob Sumroy

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Rob Sumroy is a partner specialising in intellectual property and technology and heads the firm's Technology and Strategic Sourcing practices. Rob also co-heads the firm's Fintech, Cyber and Data groups. His IP practice involves advising on the creation, protection and exploitation of IP rights in a diverse range of sectors, including sport, media, financial services and technology.



David Ives

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David Ives is a partner specialising in intellectual property, technology, strategic sourcing and sport. He advises on all aspects of IP protection and exploitation, with a particular focus on commercial IP work, including global licensing and franchising arrangements and on the IP and technology aspects of corporate transactions.



Duncan Blaikie

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Duncan Blaikie advises clients on intellectual property, technology and strategic sourcing matters. Duncan advises clients on the creation, protection and exploitation of IP rights in a range of sectors, including, life sciences, telecoms, financial services, media, consumer goods and retail. Duncan has experience advising clients on all aspects of IP work, including standalone IP agreements, such as licenses and technology transfers, as well as the IP, know-how and technology aspects of wider commercial transactions.

“The team was efficient in understanding the brief and were strategic in their approach to achieving a positive outcome.”

Chambers UK, 2016

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This material is for general information only and is not intended to provide legal advice.
For further information, please speak to your usual Slaughter and May contact.

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