



SLAUGHTER AND MAY

Intellectual Property

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At the heart of Slaughter and May's Intellectual Property practice is:

- the management and mitigation of risk; and
- a focus on maximising the return from IP assets for the benefit of our clients.

Our IP practice advises on all aspects of the creation, exploitation and enforcement of intellectual property rights. Our clients operate in a wide range of sectors including pharmaceuticals, biotechnology and healthcare, financial services, telecommunications, media, publishing, sport, consumer goods and retail.

We represent brand owners in disputes covering the full spectrum of IP rights. These range from complex patent actions to all forms of dispute relating to trade marks, passing off, copyright, database rights, design rights and breach of confidence claims. We advise on parallel imports and counterfeit goods as well as on trade mark infringement and passing off disputes relating to internet use.

Our experience encompasses multi-jurisdictional and domestic disputes at every level including proceedings in the High Court, Court of Appeal and European Patent Office. We regularly advise on cross-border litigation strategy.

An important part of our practice involves advising on trade mark licensing, distribution agreements, sponsorship agreements and franchising deals. Our specialist pharmaceuticals, biotechnology and healthcare team deals with licensing, collaboration, research and development agreements and provides strategic advice in managing and commercialising patent and trade mark portfolios.

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.

Our Credentials

- “There is no denying that Slaughters has some frighteningly skilled individuals and always does a fantastic job’ declare sources” (Chambers UK, 2009)
- “The input is always of the highest calibre and the [IP] group provides practical high-quality advice’ say sources” (Chambers UK, 2010)
- “[The IP Group] fields a ‘large cadre of bright lawyers who can pick up issues rapidly and provide good advice very swiftly. The service levels are high and they know how to tailor advice to deliver a prompt and quality service,’ commentators say” (Chambers UK, 2009)
- “[The IP Group] is said to be ‘remarkably high-quality, user-friendly and responsive. It gets stuck into the nitty gritty, paying attention to detail and providing a thorough and effective service” (Chambers UK, 2008)
- “Slaughter and May is promoted due to the reputation of its ‘first-class’ standalone IP practice which displays ‘in-depth knowledge” (Legal 500, 2008)

Overview of Slaughter and May

Slaughter and May is a leading international law firm recognised throughout the business community for its commercial awareness and commitment to clients. We have a diverse and extensive international practice advising on the full range of commercial, financing and other matters.

Central to our culture is the priority we place on the individual needs of our clients. We are organised to be client focused rather than product focused. We develop strong working and personal relationships with our clients and take a proactive approach.

Our clients look to us for technical excellence in the law, a capacity for innovative thought and a positive approach. Together, these qualities give us an edge in negotiation, help achieve our client’s commercial objectives and ensure the effective handling of matters. We train our lawyers to be multi-specialists, with a broad skills base, so that they offer not only a depth of legal expertise but also a breadth of experience and sound commercial judgement.

In contentious matters we focus on managing disputes with a view to effective and favourable resolution whether through litigation or alternative dispute resolution.

Our objective is to ensure that we are able to provide our clients with first class and seamless legal advice worldwide. Our approach places quality of advice and a longstanding, in-depth knowledge of the relevant jurisdiction at the heart of our international strategy. We believe that, for our clients, these elements can best be provided by lawyers who are at the top of the profession in their own countries and that these lawyers are to be found in the independent law firms.

By working together, on an integrated team basis, independent lawyers around the world can focus on maintaining and enhancing their practice and serving their clients in a way which is applicable to their jurisdiction whilst at the same time being able to access, and leverage off, a global legal service. Our relationships are not exclusive and allow us to work with the client’s choice of legal advisers.

We believe that our approach allows us to provide a worldwide legal service of the highest standard without disadvantages in terms of quality or culture.

Recent Work

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

- Advising **Unilever** on the sale of its olive oil business including the worldwide licensing of the Bertolli brand and other local brands
- Successfully acting for **Vestas Wind Systems** in High Court patent litigation proceedings involving multiple patents
- Advising a number of clients involved in ongoing patent litigation around the world on the use of antitrust arguments in patent actions. For example, advising **Ericsson** on these issues in relation to its antitrust complaints lodged with the European Commission against Qualcomm
- Advising **GlaxoSmithKline** on its agreement with Pfizer to create a new world-leading HIV company with a broad product portfolio of 11 marketed products and an industry-leading pipeline of 6 innovative and targeted medicines
- Advising **Akzo Nobel** on an agreement to sell its Crown Paints business to Endless LLP and on the disposal of its adhesives and electronic material business to Henkel
- Advising a **major financial institution** regarding an international patent dispute
- Advising **Arsenal** in relation to the strengthening of its commercial relationship with Kroneke Sports Enterprises (KSE), the Arsenal shareholder and leading entertainment group based in the US. Also advising **Arsenal** in relation to an agreement with Colorado Rapids, a sports franchise owned by KSE with the aim of building Arsenal's brand overseas and the launch of an Arsenal Football Academy in the US
- Obtaining an injunction for **Marks & Spencer** for conflict of interest and protection of confidential information in the context of a possible take over
- Advising **Cadbury** on the demerger of its Americas Beverages business to Dr Pepper Snapple Group Inc
- 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 FA Premier League** in relation to the impact of the ECJ and Court of Appeal decisions on important trade mark infringement issues in *Arsenal v Reed*
- Advising **Arsenal** on its intellectual property enforcement and anti-counterfeiting strategy
- Advising the **England and Wales Cricket Board** on its major Sponsorship and Kit Supply Agreement with adidas (UK) Limited
- Advising **Marks & Spencer** on their worldwide franchising arrangements
- Assisting **GlaxoSmithKline** on supply and development agreements for pharmaceutical and consumer healthcare products
- Providing **Symbian** with ongoing strategic and transactional advice on development, licensing and support arrangements with major licensees
- Advising **Arsenal** in relation to sponsorship and image rights agreements, including a fifteen year sponsorship agreement with Emirates and on other matters
- Acting for **EMAP** on various arrangements including the licensing of its "FHM" and "Car" magazine titles and its music video channel
- Advising **BOC Edwards** on the sale of its vacuum and semiconductor business to CCMP Capital for £460 million. The project involved work in relation to a very substantial patent portfolio and sophisticated patent and know-how licensing arrangements. We also advised **BOC Edwards** on the sale of its pharmaceutical systems business
- Acting for **Cadbury Schweppes** on its £58 million disposal of its Monkhill sugar confectionery business (brands including Barratt, Lion, Sharps and Butterkist) to Tangerine Confectionary Limited. The transaction also involved the cross-licensing of brands and manufacturing and distribution arrangements
- Advising **General Electric's** GE Money and Commercial Finance business units on the IP and IT related aspects of their agreement to acquire a business from and sell certain businesses to Banco Santander. We also acted for **General Electric** on its £2.4 billion cash purchase of Smith's Aerospace including a substantial IP portfolio
- Advising **Bertelsmann** on the IP aspects of its sale of BMG Music Publishing Group to Universal Music Group, the music division of Vivendi, for an aggregate purchase price of €1.63 billion
- Advising **Unilever** on the IP aspects of its disposal of the majority of its European Frozen Foods Business to Permira Funds for €1.725 million, involving the sale of the Birds Eye brand and the cross-licensing of rights

Key Contacts

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

Susie Middlemiss



Tel: +44 (0)20 7090 4038

E-mail: susie.middlemiss@slaughterandmay.com

Susie Middlemiss heads the IP practice. Susie began her career in Australia and re-qualified in England in 1988, becoming a partner at Slaughter and May in 2000. Susie 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 is a major asset. Susie has a BSc LLB (with a focus on genetics and biological sciences).

Rob Sumroy



Tel: +44 (0)20 7090 4032

E-mail: rob.sumroy@slaughterandmay.com

Rob Sumroy joined Slaughter and May in 1994 and became a partner in 2003. Rob's practice focuses on non-contentious information technology and intellectual property. In the area of technology, Rob has acted on a number of systems development and integration, outsourcing facilities management and computer services agreements.

Rob also advises on all aspects of data protection and compliance, especially in the area of corporate and commercial transactional and e-commerce.

Cathy Connolly



Tel: +44 (0)20 7090 4020

E-mail: cathy.connolly@slaughterandmay.com

Cathy Connolly joined Slaughter and May in 1993 and became a partner in 2001. Cathy advises on all aspects of intellectual property and information 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 IT aspects of mergers, acquisitions, disposals, joint ventures and flotations.

David Ives



Tel: +44 (0) 20 7090 4266

E-mail: david.ives@slaughterandmay.com

David Ives is a partner specialising in Intellectual Property, Information Technology and Outsourcing. He advises on all aspects of IP protection and exploitation, with a particular focus on commercial IP work, including global licensing and franchising arrangements. He also has considerable experience in major outsourcing and other strategic sourcing projects and on the full range of IT matters, including software licensing, development agreements and the IP and IT aspects of corporate transactions.

One Bunhill Row
London EC1Y 8YY
United Kingdom

Tel: +44 (0)20 7600 1200
Fax: +44 (0)20 7090 5000

