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

Chambers UK 2016
IP disputes are commonly:

• international and

• involve issues outside the scope of patent law, such as competition and contract law.

We have a multidisciplinary team of lawyers who are:

• leaders in their own fields

• skilled in managing large scale international litigation matters in a variety of sectors

• experienced in a range of commercial and contractual disputes and

• focussed on finding innovative solutions.

Patent litigation requires specialist technical expertise but we offer more than that, an altogether broader perspective. We work with the best lawyers internationally, rather than having multiple branch offices. This enables us to establish a team incorporating the top lawyers in each jurisdiction and to have flexibility to work with any firm that our clients choose.

“A broad and impressive IP offering with particular strengths in heavyweight litigation.”

Chambers UK, 2015
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. We have a commitment to delivering top quality legal advice, combined with commercial awareness and a “can do” approach.

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.

We add value by:

- creating innovative solutions to problems
- giving leading edge structural advice and risk analysis
- understanding what may, or may not, be acceptable in the market
- providing first class case management assistance
- ensuring delivery against realistic timetables and milestones.

A genuinely global service

Many of the matters on which we advise have a significant cross-border or multi-national aspect. We frequently give 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.

We provide cross-jurisdictional legal advice that genuinely reflects what ‘global’ means for our clients. We develop extensive and meaningful relationships with market leading firms from around the world, working with them as a single united team.

We work with like-minded experts in their own jurisdictions who have a depth of understanding that cannot be replicated, but can be shared. The level of communication and understanding between firms and with clients runs deep. Between firms we have made long-term investments to help foster connections at all levels, including investing in joint training, know-how and secondment programmes.

Together, we believe that we can offer the most incisive advice available, no matter how complicated the cross-border issue, whilst always providing value for money.
We aim to help our clients avoid disputes by advising them on their dispute resolution procedures and managing the risk of disputes occurring. When disputes do arise, we know clients want them resolved, before they escalate, in a practical and efficient way that protects their immediate and future commercial interests.

We represent IP owners in disputes covering the full spectrum of IP rights. These range from all forms of dispute relating to trade marks, passing off, copyright, database rights, design rights and breach of confidence to complex patent actions.

In dealing with IP disputes we combine specialist IP knowledge with expertise in strategy and excellence in dispute management. Our experience encompasses cross-border and domestic disputes at all levels including opposition and revocation actions in the UK Registry, the EU Intellectual Property Office and the European Patent Office as well as litigation in the Intellectual Property Enterprise Court, High Court and Court of Appeal.

We are ready for the reforms to patent litigation in Europe due to come into force next year with the introduction of the Unitary Patent and the Unified Patent Court system. 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. Our knowledge in this area, combined with our experience in cross-border litigation and the flexibility of working with leading lawyers from across Europe, makes us well-placed to advise clients on enforcement and defence strategy in the new regime.

Our strategic and pragmatic approach includes advising on the full spectrum of relief from interim injunctions or search and seizure orders to the enforcement of awards of damages or account of profit orders. We have specific experience of IP valuation and royalty disputes.

We have extensive experience in handling disputes in other fields, particularly in the corporate and financial sectors. Commonly, disputes will involve a number of different areas of law. We act for a broad spectrum of clients including governments and international organizations. We have an outstanding reputation in domestic and cross-border litigation, domestic and international arbitrations (involving both English and foreign law), regulatory investigations and inquiries work and mediations.

Where appropriate, we support alternative dispute resolution, including CEDR mediations. Similarly we have been involved in arbitrations conducted under the auspices of a number of arbitral bodies including, in particular, the ICC and the LCIA.

Slaughter and May is known for its tactically very smart approach to IP protection and litigation strategies.

The Legal 500, 2014
IP Dispute Resolution experience

Dating back to the House of Lords in the Holly Hobbie case (trade mark trafficking), we have been actively involved in the ever changing landscape of intellectual property disputes. This work has included:

- successfully advising **Speciality Fibres and Materials** one of the leading suppliers of dressings and medical products in High Court and Court of Appeal patent litigation proceedings involving Smith & Nephew and ConvaTec concerning multiple patents, trade marks, copyright and breach of confidence. This was a complex dispute involving 3 separate patents run as a speedy trial. The judgment in favour of our client resulted in a multimillion pound wound dressing product being successfully returned to the market

- successfully acting for **Vestas Wind Systems** in High Court patent litigation proceedings involving multiple patents and competition law issues, including advising on issues of cross border litigation strategy in the context of an international dispute

- acting for **ESI** (an organisation comprising all the electricity supply companies of England and Wales) in significant and complex proceedings concerning breach of confidence and patent infringement and validity, and raising issues of patent valuation and title

- 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 the competition aspects of patent litigation between Ericsson and Samsung in relation to mobile telecommunications and, in other cases, advising Ericsson on the estimation of licensing royalties payable under FRAND commitments, including involvement in English, Dutch and German court proceedings

- advising **Ericsson** in relation to complaints to competition authorities around the world regarding Qualcomm’s alleged anti-competitive conduct in relation to the licensing of its essential patents for 3G mobile technology

- advising a **leading international pharmaceutical company** on a licensing dispute

- advising **Gallagher** in relation to trade mark licence disputes with BAT in the Turkish Republic of Northern Cyprus

- advising a **major financial institution** regarding an international patent dispute relating to software and screen displays

- advising the **International Trademark Association (INTA)** appearing as intervener in proceedings before the Court of Appeal in **Special Effects v. L’Oreal**, the first case of this kind involving an intervention. INTA conferred an award in respect of this work

- successfully defending **Carlton** in relation to a dispute over the ITV brand

- acting for **Reed Executive** in relation to trade mark infringement proceedings raising key issues on trade mark law

- acting for **Ladbrokes** in relation to its dispute with BHB relating to horseracing data

- acting for **Ordnance Survey** in the successful defence of an abuse of dominant position claim brought by Getmapping

- advising **FA Premier League** on IP and brand protection and enforcement strategies

- advising on the enforcement of **The Arsenal Football Club’s** IP rights against third party infringers

- representing **APV** in High Court litigation with Tetrapak in relation to food processing systems.
Other Dispute Resolution experience

We have extensive experience in handling disputes in other fields, particularly in the corporate and financial sectors. Commonly, disputes will involve a number of different areas of law. We act for a broad spectrum of clients including governments and international organizations. We have an outstanding reputation in domestic and cross-border litigation, domestic and international arbitrations (involving both English and foreign law), regulatory investigations and inquiries work and mediations.

Where appropriate, we support alternative dispute resolution, including CEDR mediations. Similarly we have been involved in arbitrations conducted under the auspices of a number of arbitral bodies including, in particular, the ICC and the LCIA.

Recent significant experience includes:

- **advising Marks & Spencer** in obtaining an injunction concerning confidential information precluding Freshfields from acting for a potential bidder for Marks & Spencer shares

- **HM Treasury** on a series of high-profile instructions arising out of the financial crisis, including governmental interventions in Northern Rock and Bradford & Bingley; the administration of certain Icelandic banks and successfully defending judicial review proceedings brought by hedge funds and a large number of former shareholders in Northern Rock

- **British Airways** in relation to the European Commission’s investigation into alleged cartel activity involving a number of airlines and cargo operators active in the provision of air freight services, and in relation to the OFT’s criminal and civil investigations into alleged cartel activity involving passenger fuel surcharges on long-haul flights

- **Cable & Wireless Communications** in defeating substantial claims brought against it by its Caribbean competitor, Digicel, in the High Court. The claims, which included allegations of conspiracy, related to the liberalisation of the telecoms markets in seven Caribbean countries during the period 2002-2006. The case involved a trial spanning a seven month period in the High Court and evidence from 43 witnesses from over 10 different jurisdictions

- **Sempra Metals Limited** in its successful defeat of HMRC’s appeal to the House of Lords in a test case against HMRC in the ACT group litigation (in which we also represented the Deutsche Morgan Grenfell Group (DMG) - see below). The House of Lords upheld the Court of Appeal’s decision in favour of our client that companies such as Sempra should recover compound, rather than simple, interest on amounts paid by way of ACT. The judgment was significant as it remedies a number of perceived defects in the English law on interest and very considerably widens the circumstances in which compound interest can now be claimed

- **Deutsche Morgan Grenfell Group Plc** in its successful appeal to the House of Lords in a test case against HMRC (under the first group litigation order in the Chancery Division) for compensation in relation to ACT paid as a result of a mistake of law. The Government introduced legislation to limit the impact of this landmark decision

- **Nationwide Building Society** in relation to the ongoing high-profile test case commenced by the OFT against eight major current account providers to determine the validity of unarranged overdraft charges
They are very good at getting themselves aligned and so the advice is consistent. The quality of the associates is impressive.

Chambers UK, 2015

- **Gallaher** and obtaining a judgment in its favour, in relation to a US$500 million multi-jurisdictional dispute (including some IP issues) with a former distributor which led to a major four month trial in the Commercial Court. We obtained judgment in our client’s favour, and our client was awarded indemnity costs summarily assessed in a sum of over £6 million.

- **MAN AG** in its claim against Freightliner for damages arising out of false financial statements and representations in the context of MAN’s purchase of ERF. Following the landmark judgment in the English High Court in MAN’s favour, we assisted in obtaining for our client the highest ever award for punitive damages by the State of Oregon (also the highest award for damages in the whole of the US in 2006).

- **a major financial institution** in relation to an urgent injunction to restrain the further dissemination of stolen confidential information.

- **a global food manufacturer** in relation to a possible injunction to restrain HMRC from using information previously provided on a without prejudice basis and subject to express reservation of legal privilege.

- **an insurance intermediary** on an employment-related dispute involving the removal of significant amounts of data from a major competitor.

I was deeply impressed by their ability to make complex matters visible to us and structure them in a way so we could follow them up.

Chambers UK, 2014
For further information on any IP dispute resolution related matter, please contact any of the following:

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The team’s litigation expertise is formidable.  
Chambers UK, 2013