



Mussels on the Menu for Intellectual Property Firm

page 3

## Anyone would think it is the silly season... The Cat Squatter

**Morgan Stanley, the investment bank, successfully obtained an order to transfer the domain name: [mymorganstanleyplatinum.com](http://mymorganstanleyplatinum.com) registered in the name of "Meow Baroness Penelope Cat of Nash DCB" to the bank.**

The bizarre aspect of this case is that the respondent claimed it was a cat (i.e. a domestic pet) based in a barn in Worcestershire. Morgan Stanley claimed that the domain name was confusingly similar to its trade mark and that it had been registered in bad faith. The Respondent claimed that the disputed domain name was being used by one Mr Wood to teach seminars regarding failure by companies to register obvious domain names and took offence to being accused of bad faith!

in bad faith. Two of the more amusing paragraphs of this rather silly case read:

"Respondent maintains that it is a cat, that is, a well-known carnivorous quadruped which has long been domesticated. However, it is equally well-known that the common cat, whose scientific name is *Felis domesticus*, cannot speak or read or write. Thus, a common cat could not have submitted the Response (or even have registered the disputed domain name). Therefore, either Respondent is a different species of cat, such as the one that stars in the motion picture "Cat From Outer Space," or Respondent's assertion regarding its being a cat is incorrect.

If Respondent is in fact a cat from outer space, then it should have so indicated in its reply, in order to avoid unnecessary perplexity by the Panel. Further, it should have explained why a cat from outer space would allow Mr. Woods to use the disputed domain name. In the absence of such an explanation, the Panel must conclude that, if Respondent is a cat from outer space, then it may have something to hide, and this is indicative of bad faith behaviour."

**Darren Olivier**

## Morgan Stanley

The unfortunate Mr Hill, a panellist for ICANN's dispute resolution procedure, found that the alleged cat was not a cat and that the respondent, had nevertheless acted

SPECIAL REPORT:  
BRANDS

pages 4/5

ACROSS  
THE POND

page 6

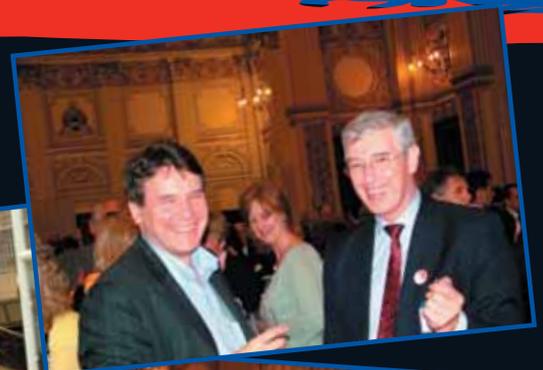
LES Pan-European  
Conference

page 7

Events  
Diary

Forthcoming meetings 2006-07 page 8

Photographs from the  
Pan-European Conference  
on page 7



**Special Edition**  
Brands - how to make them work for you  
see pages 4 and 5



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**Formally, I succeeded Stephen Powell at the close of the LES Britain & Ireland Annual General Meeting at the Pan European Conference. He will be a difficult act to follow. His two year tenure has been marked by quiet efficiency and professionalism, a broad awareness of live issues in**

**Intellectual Property, a light but thorough managerial touch and excellent diplomatic skills, at home and abroad. These qualities have been recognised by LES International where he has been appointed a Vice President. Congratulations Stephen! And thank you for all your support in the past two years. Stephen will remain a source of wise counsel upon which I and Council can draw.**

Inevitably, the most significant event of the summer so far for me was the Pan European Conference in Glasgow.

Though not as well attended as we had hoped, those who came thoroughly enjoyed the meeting, all the way through from the excellent add-on courses to the mock Clan Battle and Gala Ceilidh at

Stirling Castle. This was the culmination of more than two years' work for the organising committee and I was glad to hear regular attendees of LES events compare the plenary content favourably to LES International conferences and compliment us on the quality and variety



of the workshops. The plenary speakers were, indeed, world class, which was a tribute to the efforts, skill and contacts of Fiona Nicolson and Melvyn Ingleson. A major conference such as this is the result of a lot of hard work by many people. Thank you all!

The LES world is not immune from world events. The 2008 Pan European Conference was to have been held in Beirut. The Chair of the Organising Committee, Nabil Salamé, was in Beirut with his wife and two sons when hostilities broke out. I am happy to report that they all managed to get out of Lebanon under the shelling. Let us hope that a permanent peace will enable Beirut to be a conference venue again soon.

One benefit of becoming President is that the task of organising LES B&I London and national meetings passes to the Vice President, in this case the extremely able Nigel Jones. If you have any thoughts or suggestions for future meetings, please drop him a line.

It is often said of organisations that if they try to stand still they are likely to wane. I believe LES B&I needs to evolve during my Presidency and adapt to the ever-changing patterns in the world of work. The question is, how? Stephen pondered the need for a Business Plan in his April diary, and I think we do need to develop one. I sent a questionnaire to all members a year or so ago, but the response rate, at around 5%, may indicate that we need to find a better way to gather your views. I intend to attend as many of the regional meetings as I can over the next two years, to hear first hand what you, the members, want from LES in the future.

**Martin Sandford**

President LES B&I

## IPRinBusiness

- 1. Minister for Science and Innovation warns Intellectual Property pirates (14/07/06)** that the "UK is no longer a safe place for you".
- 2. Public discussion on future patent policy in Europe (12/07/06)** held by DG Internal Market and Services. This was the second step of the public consultation launched in January 2006.
- 3. Vitof Ltd v Antony Altoft (11/07/06).** Altoft, a former director of Vitof Ltd, held the legal title to the copyright in the source code on trust for Vitof Ltd as it was created in contemplation of incorporation and for the benefit of the company.
- 4. Microsoft Corporation v William Ling & ORS (03/07/06).** The defendant's use of materials (whether counterfeit or genuine) in the course of trade without the consent of the claimant were in breach of the Trade Marks Act 1994 s.10(1) and s.10(4)(b).
- 5. Derek Hughes v Neil Paxman (23/06/06)** Court of Appeal upholds decision that comptroller has discretion to order licensing by co-owner of a patent.
- 6. Pfizer v Dainippon Sumitomo Pharma Co Ltd & Sumitomo Chemical Co Ltd (16/06/06).** It had not been shown that England was the more appropriate forum for the trial of issues in the proceedings between parties to a licence agreement.
- 7. European Commission publishes amended proposal for framework programme 7 (15/06/06).** Amended proposal is due to be read by the European Parliament in autumn 2006.
- 8. Ultraframe (UK) Ltd v Eurocell (09/06/06).** Manufacturer awarded damages for lost profit on lost sales, a royalty of 8% on sales of the infringing product and damages for losses caused by price depression and disruption of the market and interest.

Monitored by

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For further details on all of the above please visit:  
<http://www.les-bi.org/>

# Mussels on the Menu for Intellectual Property Firm



## Chairs of Committees and Special Interest Groups

**Green lipped mussels from New Zealand are a favourite dish for Highbury Ltd's company directors based in Hitchin.**

With help from UK Trade & Investment, the intellectual property consultants have won a contract in New Zealand to protect the extraction of potential pharmaceutical ingredients from the tasty shellfish. Highbury Ltd, which assists companies and inventors through the whole process of developing and licensing new products, is celebrating major expansion in Australasia since participating in UKTI's Passport to Export programme.

This International Company is made up of consultants, IP lawyers, licensing executives and patent agents. It helps inventors and companies put together valuations for their IP, prepare them for the AIM market and commercialise inventions via licensing. Highbury also acts as a UK arm for overseas clients.

Highbury Ltd set its sights on Australia and New Zealand after recognising a rich core of talented inventors that had potential to sell outside of their home market.

**Christi Mitchell**, Highbury's IP director and past LES President says:

"We felt there was so much creativity in New Zealand, but people generally in NZ stay with their home market. They sometimes find the prospect of trying to get their inventions overseas daunting. Australia and New Zealand SME's may find that they are too thin on the ground to put someone in place in Europe, so Highbury is able to act as their European gateway.

Within New Zealand and Australia key areas of expertise means biotechnology, healthcare, engineering and nutrition, with an increasing accent on environmental aspects.

The New Zealand market proved so responsive that we quickly set up the subsidiary, Highbury Pacific Ltd in Auckland, to serve this region's clients and to expand over time into Asia where Intellectual Property commercialisation consultancy is increasingly in demand. Highbury Ltd is also working with the Government in China and considers New Zealand to be a natural conduit for this IP.

## Audio Visual Piracy on the Internet

**This subject was the topic of a full two and a half hour session at the Pan European Conference of the Licensing Executives Society held in Glasgow on Friday 23 June 2006.**

The session lived up to its "European" billing with lawyers qualified in four jurisdictions included on the panel.

The first part of the session was introduced by **Paul Golding** the principal of TRG Law who gave the background to European copyright legislation and its interaction with the internet. This proved to be useful grounding for the remainder of the session. Paul illustrated his talk with mention of current topics such as the Arctic Monkeys band and the May 2006 case against sportingstreams.com. Paul ended with a discussion of the impact of Digital Rights Management technology on existing copyright law and likely future trends.

The second speaker was **Jollyon Benn** of the BPI (British Phonographic Industry) who gave an industry prospective. Jollyon's first slide showed that illegal file sharing was on the increase and record sales were decreasing. That slide was, however, the only predictable part of Jollyon's presentation. He gave a forthright analysis of effective illegal downloading on the internet, the record industry's response and plenty of discussion of the current and probable future trends. He used many websites in his presentation to illustrate his discussion including [www.hmv.co.uk](http://www.hmv.co.uk) [www.pro-music.org](http://www.pro-music.org) [www.slyck.com](http://www.slyck.com) [www.megaupload.com](http://www.megaupload.com) [http://news.cnet.co.uk](http://http://news.cnet.co.uk) [www.ricall.com](http://www.ricall.com) [www.mashboxx.com](http://www.mashboxx.com) [www.qtrax.com](http://www.qtrax.com) [www.last.fm](http://www.last.fm) [www.youtube.com](http://www.youtube.com) [www.own-it.org](http://www.own-it.org). Jollyon's exposition was followed by an excellent

co-presentation by **Michel Jolicoeur** of Rachel & Co Spa (also Vice-Chair of the LESI Copyright Licensing Committee) and **Luciano Daffarra**, principal of Daffarra & Partners in Milan, Italy. Michel explained the mechanics of peer-to-peer file sharing on the internet, by discussing the history of file sharing, and the closing of the famous "Napster" service, before moving on to explain decentralised peer-to-peer file sharing and services such as e-Donkey and e-Mule. This was followed by Luciano's presentation, in which he explained the position from a United States and Italian perspective. This included an excellent explanation of the seminal Grokster case in the United States and the ramifications of that case.

Finally **Stefan Schicker**, Rechtsanwalt of Schwarz Kelwing Wicke Westpfahl Munich Germany discussed the position from a German law perspective. He also discussed the steps being taken by one of his own clients based in Switzerland who are assisting German copyright owners in enforcing their rights using the criminal provisions of the German copyright code. Those attending obtained a great insight into the current and future state of audio and visual piracy on the internet as well as the reaction of the law to that piracy. The session was chaired by **Dai Davis** of Nabarro Nathanson and organised by LES UK & Ireland with the support of the LESI Copyright Licensing Committee.

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# SPECIAL REPORT: BRANDS

## How to make the business

**Brands have become some of companies' most valuable assets. With increasingly more companies waking up to that fact, the pressure is on in-house lawyers to find the best protection and enforcement strategies. Darren Olivier of Field Fisher Waterhouse explains.**

Brands have become key components of corporate value. Protecting them is a sophisticated business, particularly across the US and Europe, which are key markets for their exploitation. Brands are unique in their ability to distinguish one company from the next, even in the most competitive of markets. A successful brand will invariably end up becoming the single most important asset on a company's balance sheet because it encourages repeat sales.

For example, the cumulative value of the top 10 brands released by Interbrand in July 2005 is more than £20.5 billion at an average of 34.8% of the market capitalisation for those companies. It is therefore not surprising that we are seeing increasing board level and shareholder attention being paid to all forms of brand protection. The result is that in-house lawyers need to have a sound grasp of all forms of registration and dispute resolution techniques and principles, as well as an intricate understanding of the brand to be effective and also, to save money.

Over the past 10 years we have seen major changes to the way in which brands are managed. Technology has made access to information, including company trade mark records, quick and simple. A single registration covers the entire European Community and with the US and all EU member states now part of the Madrid Protocol, it is possible (though seldom advisable) to cover both the EU and US in a single registration.

However, the paradox is that this apparent simplicity masks the undeniable difficulties of harmonising vastly different trade mark regimes across Europe and using the use-based system of the US, which is itself unique worldwide. Brands have the ability to communicate a single message across different countries yet the law, by nature, does not. This is partly why at least once every six weeks the European Court of Justice (ECJ) is asked to adjudicate on the meaning of the Trade Mark Harmonization Directive. The good part about the constant flux is that a company can derive great benefit, competitive advantages and savings by using its trade marks correctly and employing the proper skills.

### Considered registration is the key

The average cost of litigating a trade mark lawsuit in the US from start to finish through trial is between \$400,000 and \$950,000. Sometimes the cost is more but seldom less. In the UK the cost is similar and although in other parts of Europe it can be less, the fact is that it is expensive and often prohibitively so for most businesses. As a result companies are looking at ways to avoid court action and there are numerous ways to do this. One of these is to invest in proper use of the registration system, preferably before litigation, but also during it.

The benefit of a considered approach to trade mark registrations is that companies can:

- take advantage of the often underestimated deterrent value of a trade mark filing which works as an active deterrent (such as in letter before action) as well as a passive deterrent (such as through the examination procedure or pre in pre clearance searches);
- ring fence opponents and increase negotiating leverage and chances of favourable settlement;
- create opportunities for moving the dispute to a more cost-effective forum, such as the opposition or cancellation forums or to a forum where the language favours you;
- take advantage of the wide goods specifications and ambit of protection which prevails in the EU and in certain circumstances, in the US;
- create opportunities for EU-wide relief which may be possible using a Community trade mark (CTM) right in certain circumstances. This may have the effect of creating doubt in the mind of your adversary as to where you may take action and has obvious cost savings;
- create wider scope for forum shopping when choosing if or where to litigate;
- manage the complexity and speed at which the matter progresses, such as by using opposition proceedings (often in several countries) to delay or speed court action;
- avoid the higher cost and risks of relying on reputation and use to protect the brand which in some countries, like France, can be significant;
- take advantage of the first-to-file principle which underpins the EU trade mark system;
- take advantage of the different speeds at which one can obtain a registration between member states in the EU to outsmart opponents. In Benelux it may be possible to obtain a registration in as little as one day.

The costs involved in registering a trade mark are, in context of the cost of litigating, very small. The average cost of a CTM, for example, is in the region of £2800 (from start to finish, provided all goes relatively smoothly) and provides protection in 25 countries. A typical registration in the US normally attracts a similar fee. Rights in EU member states tend to be less, but obviously the protection is limited geographically.

Companies make clever use of sounds, colours and shapes to communicate brand messages about the experience consumers will enjoy when interacting with them. The communication tools of the brand can be protected as trade marks and also as designs and copyright. Once registered, a trade mark right is indefinite provided it is renewed every 10 years and in the US, also put to use.

Considered methods and strategies from the outset mean that all of the elements of a brand can be protected, that litigation is less likely and that competitors are kept at bay by a legal net of protection that



# of brands work for you

provides for, in most circumstances, injunctive relief, damages and delivery up of infringing products. More often than not, the threat of the remedies available to the trade mark owner is sufficient to deter would-be infringers. Trade mark infringement relief has become a primary tool in preventing new and non-traditional forms of unlawful activity, such as phishing, which is more akin to fraud (see for example *Nasscom v Ajay Sood*, 2005, Delhi High Court).

The trade mark filings figures released by the United States Patent and Trademark Office (USPTO) and the European Community Trade Mark Office (OHIM) in 2005 show that the protection of brands is now more than ever acknowledged by companies as a vital part of any management strategy. If trade mark filings provide a rough guide to investment in brands then it is fair to say that we are at new levels. This is evident in China, the EU and the US whose respective trade mark registries recorded record filings. A total of 588,000 filings were made in China, OHIM (EU's Trade Mark Office) recorded its highest number of filings since its inception in 1994 and the USPTO (US's Trade Mark Office) recorded its highest number of filings since the dot.com crash in 2000/2001.

Bearing in mind the downward trend of the dollar against the euro that is fuelling demand for US exports to the EU, the cheap flights that now make weekend shopping between US and Europe a reality and the ease of buying on the internet, the market for a company's brands between the EU and US is increasing. But then so is the competition. Trade marks will be infringed, copying will prevail and the importance of brand vigilance will be key, not only in a company's home market but also in export markets.

As brand image needs to be consistent, the danger is that a failure to police the brand properly across territories (even in those in which you do not trade) can harm your brand in a home market. We have seen this in particular where a mark starts to fall into the public domain or where there is a risk of it becoming generic in an overseas market.

For a number of years now the courts have grappled with new forms of infringement related to the internet. Is metatag use an infringement? Is domain name hijacking trade mark infringement? When is use on the internet justifiable use in defence of revocation proceedings and when does such use amount to infringement? This has led to a raft of litigation across the EU and in the US, the most recent being pop-up advertising and the use of keywords. Litigation of this sort is pioneering in the sense that the forms of use of the registered trade mark and the business methods are new and so, to some extent companies caught up in this litigation have little choice but to foot the bill and risk of the industry, in determining the new law. However, in almost all cases involving internet use of a trade mark, the litigant with the trade mark right is in the stronger position.

## More security with national rights

The choice for most companies operating in Europe is whether or not to file for a number of national rights or to protect the mark via a CTM. While the CTM system has proved, over the past ten years, to be a valuable and cost-effective way of protecting one's brand over 25 countries, there are still very good reasons to register national rights, no more so than when it comes to litigate their use. In France, for example, there are only two CTM courts, the Tribunal de Grande Instance de Paris and the Cour d'Appel de Paris. This means that if

you litigate using a CTM in France you can only do so in those courts.

We were recently involved in a case where we chose to litigate on a French national right principally because we could use the Court of Nanterre, which has a history of decisions favouring rights owners. Although the CTM has existed for some time, Courts, and even some practitioners, are still more comfortable with national rights when it comes to enforcing them.

## The problem with the CTM route

The benefit of using a CTM is that it is possible to obtain an EU-wide order out of one set of proceedings. By virtue of the CTM Regulation, a CTM court will have jurisdiction for infringements committed anywhere in the EU, provided the CTM court has been chosen following the order of priority set out in the Regulation.

Although the circumstances in which an EU-wide order is given are limited, it places a difficult task on the advisor when he or she is asked to assess the possibility of court action by a CTM rights owner, who in theory may choose to sue their client in any one of the 25 member states if the priority system allows.

Although substantive trade mark law in the EU is harmonised there are still major differences in litigation between member states, which will continue to exist for a long time, notwithstanding the EU Directive on the Enforcement of IP rights.

## Taking to the ring

Ring fencing is also a major tool to a would-be litigant or defendant in a trade mark case.

Consider a US plaintiff with strong rights in the US who takes action against an infringer in the US, both of whom enjoy the US as their home markets. The defendant then embarks on an extensive registration programme outside the US in countries like the EU, Mexico, the Caribbean and Canada, and the plaintiff suddenly finds itself ring-fenced by prior rights. In today's trade environment, this creates an awkward state of affairs and may mean changing company websites and not taking orders from outside of the US. This registration tactic can help create leverage for a favourable settlement.

## Staying on top of competitors

Litigation is big business. The stakes are often high, particularly in the area of brands, which can be the single most important communication tool for a business. The loss of one's brand to a competitor or to the public domain can be catastrophic. On the other hand, having the best advice at your fingertips can set you apart from competitors.

For most companies in the US and EU, it is of paramount importance to choose the right advisor to help you plan strategically, litigate and defend your position. The advisor needs to have a sound grasp of all forms of registration and dispute resolution techniques and principles across both territories, as well as an intricate understanding of the brand to be effective and also to save money. More often than not, considered trade mark application(s) combined with an awareness of how to manage and control major litigation, can make the difference between winning and losing this all important game.

**Darren Olivier** is a partner, at **Field Fisher Waterhouse**.



## United States Federal Circuit Clarifies Scope of Privilege Waiver Opinion of Patent Counsel is Invoked as Defense to Willful Infringement

### Introduction

Defendants accused of willfully infringing a United States patent may avoid liability for willfulness (and its attendant possible exposure to an award of treble damages and attorneys' fees) by introducing evidence showing that they met their affirmative burden of due care to determine whether they were in fact infringing the patentee's patent(s). The U.S. Court of Appeals for the Federal Circuit (the "Federal Circuit") has in recent years rejected prior precedent that had applied a *per se* rule effectively requiring production of a written opinion of outside counsel as a *sine qua non* for refuting an allegation of willfulness, and instead has prescribed that the totality of the circumstances should be considered in determining the reasonable (and hence non-willful) nature (or otherwise) of an accused infringer's response to a charge of infringement. ***Knorr-Bremse Systeme Fuer Nutzfahrzeuge GmbH v. Dana Corp.*, 383 F.3d 1337 (Fed. Cir. 2004).**

In practice, though, many defendants and their counsel continue to view production of and reliance on an attorney's advice (usually in the form of outside counsel's written legal opinion that the patent(s) in suit is/are invalid or not infringed by defendant) as the surest way of establishing a defense to the allegation of willful infringement. However, asserting the defense of reliance on counsel's opinion generally requires a waiver of attorney-client privilege and attorney work-product immunity (if for no other reason than because otherwise-privileged communications from counsel will need to be produced so that the court can determine if it was reasonable for the defendant to rely on such advice).

District courts have given conflicting interpretations on the scope of such waiver of privilege, though. Some district courts have in the past construed the waiver very narrowly, to require production of only the opinion and other communications from opinion counsel. At the opposite extreme, a few courts have held that the waiver extended to all work product and working papers of any counsel, potentially including even intra-lawyer communications among outside counsel that were never communicated to defendant. On May 1, 2006, the Federal Circuit ruled on this issue for the first time, redefining the scope of such waiver in its decision in ***In re EchoStar Communications Corp.***, 2006 WL 1149528 (Fed. Cir. May 1, 2006).

### Discussion of *In Re EchoStar*

#### (1) Attorney-Client Privilege Waiver Extends to Any Communication Concerning The Same Subject Matter

The Federal Circuit held in *In re EchoStar* that when a party defends itself by disclosing an opinion of counsel or other exculpatory attorney-client communication, the party waives the attorney-client privilege for all other communication relating to the same subject matter. *Id.*, at \*3.

In *In re EchoStar*, TiVo accused EchoStar of willfully infringing TiVo's patent to certain digital video recording systems. In response, EchoStar asserted that it had relied on its in-house counsel's advice that it should not be held liable for such infringement. *Id.*, at \*1. TiVo sought extensive discovery of communications and work product of EchoStar's in-house and outside counsel, arguing that reliance on the opinion of counsel effected a broad waiver of privilege. EchoStar sought to limit such discovery, invoking attorney-client and work product privilege in arguing to constrain the scope of material covered by the waiver of privilege.

The Federal Circuit held that the waiver of attorney-client privilege extended to any attorney-client communication concerning the same subject matter, including EchoStar's communication with an

attorney other than the in-house counsel. *Id.*, at \*3. The Federal Circuit noted that this rule was necessary in order to prevent a party from waiving its privilege for favorable advice while asserting its privilege for unfavorable advice. *Id.*, at \*4.

#### (2) Attorney Work-Product Waiver Extends To Documents That Embody Or Discuss Attorney-Client Communication About The Same Subject Matter

The Federal Circuit identified two categories of attorney work product communication that are discoverable:

1. Documents that embody an attorney-client communication concerning the same subject matter of the patent litigation; and
2. Documents that discuss an attorney-client communication about the subject matter of the case but are not themselves communications to or from the client. *Id.*, at \*6-7.

The Federal Circuit next determined that the waiver of work product immunity when a reliance on counsel defense is interposed does not extend to documents analyzing the law, facts, trial strategy, etc., that reflect the attorney's mental impressions but that were not given to the client. *Id.*, at \*6. The court reasoned that work-product waiver should extend only so far as to inform the court of what the accused patent infringer knew or believed (and hence, as to how reasonable his belief was that he had secured a competent exculpatory opinion). *Id.*, at \*7. If an attorney's analysis and legal opinion are never communicated to the client, though, they of necessity cannot have an impact on the client's subjective state of mind and thus are not probative as to whether the client acted with the required reasonableness as to not taking actions that would infringe the patent of another party. Therefore, the court reasoned, such documents should remain beyond the scope of attorney work-product waiver. *Id.*, at \*8.

Finally, the Federal Circuit noted that, if documents describing attorney-client communication contain legal analysis that was never communicated to the client, parties should redact such information in the course of producing other, responsive portions of documents that were provided to the client. *Id.*

### Conclusion

*In re EchoStar* provides increased clarity and predictability as to the scope of attorney-client and work-product privilege waivers that will be effected when an opinion of counsel is invoked as a defense to a charge of willful patent infringement. This Federal Circuit decision assists defendants in predicting the scope of waivers, and stops well short of the absolutist view of waiver under which a few earlier district court opinions would expose all thoughts, communications, and impressions of in-house or outside counsel to discovery, even when they were never communicated to defendant. The case thus helps defendants better weigh the pros and cons of asserting the advice-of-counsel defense in response to a willful infringement charge and lessens the risk and unpredictability of doing so.

**Jeffrey D. Sullivan**

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# LES Pan-European Conference

## Glasgow, Scotland 21-23 June 2006

LES International Officers  
2005-2006

Following a welcome reception buffet dinner on Wednesday evening, the conference was formally opened on Thursday morning by Stephen Powell, President, LES Britain and Ireland. Simone Nuzzi of GE Trading and Licensing then led the first plenary session on successful international licensing strategies, describing a number of recent innovative collaborations by GE. Following a talk by Dr Peter Hyde of Scientific Generics on the exploitation of IP relating to position sensing technology, Imran Khand, a native Scot and the Chief Executive of Picstel Technologies, described how Picstel had grown from a small 2-man outfit to a \$1.5 billion company using licensing, revenue sharing agreements and other deals.

The conference then moved into the parallel workshop phase, including sessions on stem cell technology and legal issues in licensing. There was a further round of parallel workshops after lunch, including sessions on forum shopping and transferring technology from public sector organisations. These sessions were followed by an evening reception at the very impressive Glasgow City Chambers.

The plenary session on Friday morning was led by David Koretz, the 27-year old entrepreneur and CEO of Blue Tie Inc. Mr Koretz described how new business models are emerging rapidly in the field of software, with a seismic shift towards software as a service. He was

followed by a forthright exposition from the President Elect of the European Patent Office, Alison Brimelow CBE, who shared with the audience some of her reflections on current issues facing the IP community. Alexander D. Lewis of consultants Wood Mackenzie then gave an excellent state-of-the-nation description of the global pharmaceutical market.

After coffee and more opportunities for networking, there followed another plenary session on international branding. Creenagh Lodge, the Co-Chairman of the branding consultancy Corporate Edge, gave a fascinating presentation on the branding of Scotland. She was followed by Roy Lewis, the Managing Director of Hebridean Liqueurs, who shared his personal insights into growing a liqueur brand. The session was ended with an entertaining talk by Joe Flynn of Barr Soft Drinks, on the branding of the famous Scottish drink IRN-BRU.

To round off the conference, there was a Gala Dinner on Friday evening in the grand setting of Sterling Castle. All in all, an excellent conference. The quality of the presentations and workshops was high and the Radisson SAS in Glasgow was an excellent venue. Thanks go in particular to Sheena Hunter and her colleagues at Northern Networking for the smooth-running of the conference.

**Duncan Curley,**  
McDermott Will & Emery UK LLP

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"Thanks to Sheena Hunter, Bob Smalles, Christopher Bartlet and Mary Elson for the photographs, a selection of which can be seen on the LES B&I website"



# Events Diary 2006-2007

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For further information please contact regional officers for LES events in Britain and Ireland (see panel on the left of this page or visit the LES B&I website <http://www.les-bi.org/>) and the officers of national societies for overseas events (see LES directory or the LESI website <http://www.lesi.org/>)

**6 Sept 2006**  
**LES North East Region**  
**\*\*\*Book early for this event\*\*\***  
**"Why Invent"**  
Best Practice Suite at  
Fox Hayes LLP  
118 North Street Leeds.  
**Speaker:** Trevor Baylis  
**Email:**  
[deborahniven@foxhayes.co.uk](mailto:deborahniven@foxhayes.co.uk)

**10 - 14 Sept 2006**  
**LES USA and Canada**  
**"CREATE:  
The Magic of Licensing"**  
New York Marriot, Marquis  
New York City, USA  
[www.usa-canada.les.org](http://www.usa-canada.les.org)



**20 Sept 2006**  
**LES London Area**  
**Evening meeting**  
Details TBA  
For further information  
**Email:**  
[cara@glasconf.demon.co.uk](mailto:cara@glasconf.demon.co.uk)

## Moving Company/Changing Address?

Please remember to tell our administrator, **Sheena Hunter**, if you change your office address so that we can continue to send you LES information and **newsxchange**™. Her address is:

**LES Administrative Office, Northern Networking Ltd**  
1 Tennant Avenue, College Milton South, East Kilbride  
Glasgow G74 5NA

Please also remember to change your contact details in the Membership Directory on the LESI website. As a service to our members the editor will print any change of company and location in **newsxchange**™. Please contact **Mary Elson**, [elson.mary@btinternet.com](mailto:elson.mary@btinternet.com)

## Membership

Enquiries should be addressed to **Cara McIlwraith** at the LES Administrative Office:

Tel: +44 (0) 1355 244966 Fax: +44 (0) 1355 249959  
Email: [les@glasconf.demon.co.uk](mailto:les@glasconf.demon.co.uk)

A membership application form may also be found on the LES B&I website: [www.les-bi.org](http://www.les-bi.org)

**25 - 26 October 2006**  
**Institute of Nanotechnology**  
**"Nano and Microtechnologies  
in the Food And Healthfood  
Industries"**  
NH Grand Hotel Krasnopolsky  
Amsterdam, Netherlands  
For further information  
**Email:** [carrie.smith@nano.org.uk](mailto:carrie.smith@nano.org.uk)

**7 - 8 December 2006**  
**The Pan European Intellectual  
Property Summit**  
**"ip in the boardroom,  
ip leadership: a global  
bench mark"**  
Conrad Hotel, Brussels, Belgium  
[www.ipsummit.info](http://www.ipsummit.info)

**13 - 14 December 2006**  
**Institute of Nanotechnology**  
**"Investing in Medical  
Nanotechnologies"**  
Royal Garden Hotel, London  
For further information  
**Email:** [carrie.smith@nano.org.uk](mailto:carrie.smith@nano.org.uk)

**21 - 23 February 2006**  
**LES USA and Canada**  
**"Managing the Evolving Deal"**  
San Francisco, USA  
[www.usa-canada.les.org](http://www.usa-canada.les.org)

## Welcome!

Council has been pleased to welcome the following new members to the Society:  
**Dr Dee Athwal**, UCB Celltech;  
**Mr Simon Barker**, lawyer, Martineau Johnson;  
**Ms Joanna Boag-Thomson**, lawyer, Shepherd & Wedderburn; **Dr Laura Camurri**, Innovation & Enterprise, Queen Mary University of London; **Dr Tim Carter**, Innovation & Enterprise, Queen Mary University of London; **Ms Kate Colleary**, lawyer, O'Donnell Sweeney; **Mr Martin Harvey**, consultant, Korean Partners.com (Strategy & Success); **Dr Peter Hirst**, Innovata;  
**Mrs Jinder Jhuti**, lawyer, Martineau Johnson;  
**Mr Paul Joseph**, lawyer, Freshfields Bruckhaus Deringer; **MS Samantha Livesey**, lawyer, Pannone; **Mr Nigel Slaughter**, consultant, Optimat;  
**Mr John Taylor**, consultant, Optimat;



## Dublin 2007

LES B&I Conference and AGM  
Further details TBA

## newsxchange™

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