



LICENSING EXECUTIVES SOCIETY
BRITAIN AND IRELAND

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The Newsletter of the Licensing Executives Society Britain and Ireland

Issue 137 July 2011

UK - Breach of confidence: no strict liability for breach of confidence in contract

There can be no strict liability for breach of confidence in contract, according to a recent decision of the Court of Appeal ([Vestergaard v Bestnet Europe \[2011\] EWCA Civ 424](#), 20 April 2011).

Strict liability

The defendant Bestnet developed a long-lasting anti-mosquito bed net, NetProtect, using confidential information contained in the claimant Vestergaard's database. The Court of Appeal allowed the appeal against liability for breach of confidence in contract of a further defendant, Mrs Sig, a former employee of Vestergaard who left to join Bestnet on the commercial (as opposed to technical) side. Although Mrs Sig used the information when she placed orders for NetProtect with suppliers, the information had never been imparted to her. The decision in *Seager v Copydex* ([1967] 1 WLR 923) was distinguished on the basis that in that case the defendants were actually using information that had been imparted to them, even though they were doing so unconsciously. There could be no strict liability for breach of confidence in contract, not least because this could result in the grant of an injunction restraining the use of confidential information by a defendant who had never received it.

The Court of Appeal also rejected the argument that a term imposing strict liability was implied in Mrs Sig's employment contract: there was no business reason to imply a term of such harsh extent.

The Court's approach is inapplicable to actions for breach of confidence in equity, since in those cases the defendant would need notice (possibly to be established objectively) that the information was confidential before any obligation of confidence could arise.

Was an injunction justified?

At first instance Mr Justice Arnold held that an injunction may be granted to restrain manufacture or sale of a product *derived* from confidential information where its manufacture represents a continued use of the information having regard to the extent and importance of the information. On the facts, Arnold J refused to grant an injunction restraining the manufacture and sale of nets derived from Vestergaard's confidential information. While the judge acknowledged that the passage of time that elapsed between a defendant's access to confidential information and the application of it to its own products was more relevant to reverse engineering cases (of which the present case was not an example), the factor was nevertheless relevant in the present circumstances since the identities of the three principal additives in the nets could be obtained from public domain sources and suitable proportions of them worked out by trial and error. The grant of an injunction would also be disproportionate to the wrong committed by the defendants.

The Court of Appeal refused to interfere with the exercise of the judge's discretion. It held *obiter* that: (a) the passage of time that had elapsed between the defendants' access to the information and application of it in their own products was a relevant consideration: an independent consultant could have come up with similar products in the time; and (b) proportionality was a mandatory consideration since the implementation of the Enforcement Directive (2004/48, Article 3(2)).

Alex Batteson

Linklaters LLP

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President's Diary



The following text was the President's address to the Annual General Meeting, which was held on 14 July in London.

A month ago, the rooms and foyers of the Park Plaza Hotel in Westminster were bustling with 600 delegates who had gathered from around the world to discuss developments in licensing practice, to network, and to renew friendships. The LES International conference in June was a very significant event in the life of the society. Undertaking the event organisation placed LES B&I at considerable financial risk, and LES B&I's role in the international community of LES societies, and with key industrial firms, could have been enhanced or diminished by the quality of the event.

I am delighted to report that the feedback from delegates has been exceptionally positive with LESI leaders showering compliments on the outstandingly-dedicated organising team and the event that they produced. The quality of the event organisation was widely-commended, with the dinner at the floodlit Royal Courts of Justice being a particular highlight for many delegates. The programme was praised for its practical, industrially-focused content, and financially, the event met its break-even target and should generate a small surplus of the society. Personally, I found the event to be an invigorating example of what LES does, and what I consider to be unique – bringing together colleagues from different industries, professional sectors and countries, to share best practices and to develop personal networks. I thought that the quality of the programme was excellent – as particular highlights, I found Richard Seymour of Seymour Powell, and Sir Robin Saxby, to be inspirational and enlightening speakers.

On behalf of the society, I thank the outstandingly-dedicated team that committed a huge amount of personal time – working many, many evenings and weekends - to arrange an event of this quality: Hayley French, Fiona Nicholson, Sangeeta Puran, Jennifer Pierce, Raja Sengupta, Anita Roberts, Patrick Cantrill, Barry Quest, Dai Davis, Stephen Robertson, Romek Matyszczyk, Conan Chitham and the chair of the organising committee, Anne Lane.

In addition, I would like to thank, on behalf of the society, Jennifer Pierce, Vice-President, and the regional committee groups, who have organised many excellent London and regional meetings over

the past year. These events provide ongoing and local occasions for learning and networking, and are critical in the life of LES B&I.

This AGM marks the resignations from Council of a number of longstanding members: Nigel Jones, Raja Sengupta, Anne Lane, Anita Roberts, Alistair Payne, Belinda Isaacs, Robert Bond, Conan Chitham and Renate Siebrasse. I thank these individuals for their immense dedication to the society over the past years, for their numerous and critical accomplishments on behalf of the society, and for their friendship and good company.

Despite the highly-successful LESI conference, and a programme of industrially-relevant London and regional meetings, the society faces significant challenges. The membership has fallen over the past year, no doubt due in part to the difficult economic climate, and the LES must respond to the challenge that this situation creates.

I believe very strongly that LES has some exceptional strengths that it should look to utilise in order to develop the organisation and to better serve the licensing and business development community. Among these characteristics, it is notable that LES has a very well-established and respected brand, which is particularly strong among senior staff from multinational companies, due to the broad geographic reach of LESI. In addition, the society has access to a very-experienced pool of senior lawyers, patent attorneys, industrialists and university staff; LES also has many supporters inside many firms and universities, who have interacted with LES in different ways in the past.

The potential market for the sharing of best practices and networking opportunities that LES provides is large: IP-based agreements worth billions of pounds are signed each year involving British and Irish firms, and complaints that IP matters are poorly understood are commonplace in many media. LES should be encouraged by this opportunity and act to adjust its products and service offering to meet this need.

LES Council is developing a strategy that will allow LES B&I to respond to these challenges, with the following key themes:

- Deepen the engagement with industrial firms
- Develop LES B&I's offering to current and potential members
- Enhance the LES's offering to experienced licensing and business development staff
- Manage LES B&I effectively and professionally

It has been an honour to be able to take a leading role in LES B&I over the last few years, and I am convinced that the society can respond to the current challenges, build on the success of the recent LES International conference and fulfil the potential of LES in Britain and Ireland.

I thank all of the members of the society who have worked over the past year to develop the society's conferences, events and activities, and I ask for your support for the Council as it takes action over the coming year to develop LES B&I for the future.

Thank You.

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‘Better, Faster, Smarter’ - The 2011 LESI Conference in London

On the south bank of the River Thames, in sight of the iconic Big Ben clock tower of London’s parliament building, more than 500 attendees from around the world gathered in the sparkling new Park Plaza hotel for the 2011 LES International Conference. This was a well-attended, highly successful meeting, hosted by LES Britain & Ireland. Even the weather managed to provide an occasional glimpse of sunshine amongst the inevitable patches of rain. Over a three day period,



Anne Lane and Pearly Queens

from 5-8 June, delegates enjoyed English-themed hospitality and entertainment. This started with a reception at which fish and chips, steak and kidney pie, and shepherd’s pie, accompanied by local ale and Pimm’s fruit cup, were served in the presence of Beefeaters and Pearly Kings and Queens. It ended with a formal farewell ball that included a demonstration of Morris Dancing. Inbetween there was a dinner in the spectacular main hall of the historic Royal Courts of Justice – which houses England’s civil law High Court and the Court of Appeal.

Receptions and dinners of this nature are not merely a sybaritic indulgence; they provide important networking opportunities, and, as one first-time attendee commented, he now has 57 business contacts to follow up.

But the stars of the show were definitely the plenary and workshop presentations. These were themed around the Olympics-inspired slogan of ‘better, faster, smarter’ (hopefully without offending against the LOGPG ambush-marketing regulations that have been put in place for London’s 2012 Games). The conference opened memorably with a presentation from designer and futurologist Richard Seymour who showed slides of amazing projects including the Virgin outer-space tourism shuttle. He said he would have to kill us if he told us too much about his current work. He did however give some free-to-mention information about the philosophy of product design. Chillingly he explained that the future was already beyond our control – it was coming from behind in the hands of our children. He also mentioned that ground-breaking products, such as the Apple iPad, are often aimed at stimulating new customer requirements rather than catering for existing needs. His co-speaker, Richard North from Britain’s most prolific patenting company - Rolls Royce (aero engines) – went on to destroy the self-effacing British myth that the nation no longer makes anything of significance. He detailed the impressive global success of the company and explained how it is much based on locally sourced high-tech design and manufacture. The following ethics session involving Dr Francis Gurry from WIPO and Dan McCurdy from Allied Security Trust was chaired by the former English Court of Appeal Judge (and now university IP professor) Sir Robin Jacob. He pointed out that IP law in difficult ethical areas, such as stem cell and software patenting, was too often developed abstractly by judicial and bureaucratic bodies without adequate assistance from those who are practically involved in the relevant industries. Actually, being known for his acerbic wit, he put it somewhat differently, but again death penalties were imposed on faithful reportage. Cherie Blair, who is an influential Human Rights lawyer and the wife of former British Prime Minister Tony Blair, followed him. She spoke about her charitable Foundation for Women and stressed the important part that can be played in developing countries by modern technology, particularly mobile phones, to help liberate and empower women so that they can achieve personal freedom and safety and take a more broadly based active role in society.

Later plenary sessions were no less inspirational. They followed the Conference theme and explained the challenges of Brand and Sports Licensing, IP for Future Technology, Life Sciences and Climate Change, with keynote speakers of standing all of whom were fascinating and informative, drawn from a range of interesting and well known organisations, including, by way of example, Google and the world-famous Manchester United Football Club.

The workshops covered a wide range of topics and were all well subscribed and lively. Interestingly, many extended beyond traditional LESI areas to encompass issues such as domain name disputes, software patents, and trade mark licensing - showing the extent to which LESI's activities have changed to keep up with developments in modern business and innovation trends.

In accordance with usual practice the Conference was immediately preceded by the International Delegates Meeting, now renamed the International Management and Delegates Meeting in acknowledgement that attendees include both voting delegates, and non-voting Committee Chairs and Observers. Between and amongst the IMDM and the LESI Conference, in acronymous proliferation, there were presentations, meetings and courses for CLP, TTT, LES 100, LES Foundation SBPC, GTIF and YMC. This made for demanding schedules. Undoubtedly, LESI members play hard, but they also work hard and, whereas add-on and accompanying tours still have an important part to play, especially as an aid to networking, they now have to compete with add-on educational events.

Amongst the presentations was a promotion for 'CLP'. This is an educational initiative of LESI and the LES USA/Canada society, now under the control of an independent organisation CLP Inc. The designation Certified Licensing Professional is awarded based on an examination (or up to the end of June 2011 on a Grandfather basis). The organisation also arranges training for those wishing to take the examination. The Certificate is accepted as being important by a growing number of employers. Around 800 certificates have now been issued of which 300 are examination based. See www.licensingcertification.org/.

An LES 100 training course was run before the start of the Conference. The course gives beginners a background in IPR and licensing and it has become common to provide this as a one-day add-on during international meetings. The course is structured around an established template and is presented by teachers who have taken the Train The Trainer (TTT) course. A TTT course was run in London during the Conference.

As part of an initiative to encourage new young membership there is the LES Foundation Graduate Student Business Plan Competition (SBPC). Real life proposals were presented during the IMDM and were assessed by a panel of LES members. The Grand Winner was announced during the Conference – NanoMed (founder Matthew MacEwan) from Washington University-St. Louis with a plan to revolutionize neurological surgical mesh. An LESI \$5000 Global Award was made to a student team from Lund University, Sweden for their company, ShieldHeart which is offering a functioning organ protection device technology platform. See www.lesfoundation.org/competition/index.html.

Also for younger members there is the Young Members Congress – an LESI board initiative and this operated during the Conference to bring together those under 40 with an opportunity to 'speed network', to meet senior LESI members, and to go on a London Pub Crawl.

A further recent LESI board project is the Global Technology Impact Forum and the concurrent Invent for Humanity Technology Transfer Exchange Fair planned for 2012. During the Conference there was a planning meeting and a Workshop on Technology Transfer to Emerging Markets and Developing Countries. LESI is working with partner organisations such as WIPO, WTO etc. Further details can be accessed via the LESI blog at www.lesinews.blogspot.com/.

The IMDM had a record attendance. Almost 200 attendees with accompanying persons and special guests were at the main dinner that was held at the reconstructed Globe Theatre – reached by a pleasant evening boat trip along the Thames. At the dinner the current international president, Alan



Chris Goodwin with an ad hoc Award

Lewis, presented Willy Manfroy, a former international president, with the LESI Gold Medal. A remarkable number of distinguished long serving LES people were present. Chris Goodman a popular former LES Britain & Ireland president and active member of the LESI Education Committee, was an invited special guest and was awarded a ceremonial London Beer Tankard for services to LESI, Education, and Real Ale.

Amongst the usual IMDM business matters, there were touches of controversy over some issues, particularly the web site, and proposed by-law changes and block-voting.

The LESI web site, originally serving only as a source of static information, is now required to act as an interactive portal for a multi-field enhanced searchable membership database, to provide a word- and tag-searchable database of Les Nouvelles articles retrospectively to 1972, to incorporate selective access committee pages with uploadable data facilities, and make available inter-member communication list-servs. The year's spend on this (albeit as a one-off) has reached a six figure sum putting the budget figures temporarily in the red. Some questioned why all of this could not have been achieved more quickly and less expensively. Perhaps applying Richard Seymour's maxim (mentioned above) a team made up of members' 12 year old children might have been more cost effective.



Gold Medallist Willy Manfroy

The (unresolved) block-voting controversy derived from last year's adoption of the LESI tag line (Advancing the Business of Intellectual Property Globally) - which was devised to try to assist prospective members understand what 'licensing executives' do. This had been voted through with a very slim majority against the wishes of some societies, particularly USA/Canada. There are those that think voting must be personal to delegates, whereas others are in favour of whipped national block votes. On a happier note, LES Germany was presented with the 'society-of-the-year' award in recognition of its outstanding growth. At the end of the Meeting, the new slate of board members, to be voted in at the IMDM later this year in San Diego was revealed, headed by: President: James Malackowski (USA/Canada) and President Elect: Kevin Nachtrab (Benelux).

The Conference and Meeting and add-on events were expertly coordinated by a team of dedicated LES Britain & Ireland members, headed by Anne Lane under the watchful eye of treasurer Raja Sangupta, with invaluable help from LES Britain & Ireland president Mark Wilson, and Jenny Pierce, Anita Roberts, Sangeeta Puran, Stephen Robertson, Fiona Nicholson, Patrick Cantrill, Hayley French, Dai Davis, Conan Chitham and Barry Quest. Hayley French worked hard on the programme while busy with her Education Committee commitments, but still found time to advise delegates on London gourmet restaurants. Check the conference web site www.lesi2011.org for photos and presentations. Next year's conference will be down-under in the competent hands of LES ANZ. Simon Rowell from ANZ was seen taking notes, as also was Ken Schoppman from LES USA/Canada, Saskia van Dijk-Struyk and Monique van Schevicoven from Benelux.

This was a difficult event to run and it will be a hard act to follow!

Explanation of terms:

Big Ben is the name of the great bell in the clock tower, although it is commonly incorrectly used to refer to the clock or the tower.

Pearly Kings and Queens are members of a charitable money-raising organisation. On special occasions they wear uniforms decorated with mother-of-pearl buttons (one Queen at the Conference was wearing a dress with 36,000 hand sewn buttons). They are a Cockney (central London working class) tradition.

Beefeaters are ceremonial guards at the Tower of London. They wear a red uniform.

Morris Dancing is a form of English folk dancing that is common throughout the country. It is usually performed outdoors, at spring and summer festivals, by men wearing folk costumes and brandishing sticks or handkerchiefs. Its origin is unclear but it may be derived from Spanish 'Moorish' dancing.

LOGPG = The London Olympic Games and Paralympic Games Act 2006.

Barry Quest

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The Hargreaves Review of IP and Growth

'Not another review of the intellectual property framework' - such was the reaction of a number of members of the LES Laws Committee when the Chair informed us of the announcement of another government-sponsored review of the UK's intellectual property regime. Many of us can remember the effort that was put into responding to the last call for evidence during the Gowers review, undertaken at the behest of the Labour government, five years ago. Apparently, fewer than half of Gowers' recommendations have been implemented, giving justifiable cause for cynicism as to how seriously any new proposals that emerge from the Hargreaves Review will be tackled.

However, the harsh economic climate of 2011 is very different from that which prevailed in 2006 (when Gowers was published), prior to the impact of the credit crunch. The UK is currently experiencing a period of extremely weak economic growth and the coalition government is coming under increasing pressure to show leadership, by taking positive steps to stimulate economic activity. Measures to support growth, especially amongst small and medium-sized enterprises

(SMEs) - often considered to be the engine room of growth as an economy emerges from recession – are under active consideration.

So: it seems likely that at least some of the proposals made by Professor Ian Hargreaves in his Independent Review of IP and Growth (issued on 18 May 2011 and entitled '*Digital Opportunity*', available to download at <http://www.ipo.gov.uk/ipreview-finalreport.pdf>) are likely to receive serious government and parliamentary time. What are Professor Hargreaves' recommendations? There are ten of them – on the face of it, a more manageable figure than the fifty-odd points set forth by Gowers – but some are still likely to prove controversial and difficult.

1. Changes to the IP system should be based on objective, economic evidence – not necessarily on the basis simply of the weight of submissions from special interest groups ('*lobbynomials*'). The UK Intellectual Property Office is already leading the way in this regard, including for example by commissioning specific research to examine the impact of lookalikes in supermarkets on branded products.
2. The UK should '*resolutely pursue*' its international interests in IP (particularly with respect to emerging economies such as China and India); the highest priority at the present time should be towards achieving a unified EU patent court.
3. There are some radical ideas on copyright licensing, including a proposed cross-sectoral Digital Copyright Exchange: a centralised, online mechanism for clearing rights across the creative industries. According to Professor Hargreaves, this would facilitate improved routes to market for creators, a means to record the ownership of rights, clearer understanding of licensing terms and a single point of access to UK collecting societies.
4. Legislation to enable the licensing of orphan works, i.e. works which may be commercially inaccessible for license because the copyright owner cannot be found.
5. Legislation to change the exceptions to copyright infringement. Professor Hargreaves is aiming here at exempting format shifting by individual consumers (e.g. of songs originally purchased on CD), digital library archiving and (more controversially) parody.
6. The ostensible adverse effect of patent 'thickets' on innovation – especially in ICT – is picked up as a theme of the Review, although it is not clear how solid the evidence was in support of this finding. The proposals to address the issue include: cutting backlogs of patent applications by extending work sharing between patent offices and the adjustment of patent renewal fees to encourage patentees to scrutinise whether they should hold on to low value patents. These recommendations appear to be among the more difficult for the UK government to implement, at a practical level.
7. Establish an evidential basis for support for the design industry by means of IP rights.
8. Introduce immediately the enforcement measures against copyright infringement that have been foreshadowed in the Digital Economy Act 2010.
9. Draw up plans to improve the accessibility of the IP system to SMEs, including improving access to lower cost providers of IP legal and commercial advice.

10. Perhaps the least concrete, tenth proposal is to ‘*Give the UK IPO the necessary powers and mandate in law to ensure that it focuses on its central task of ensuring that the UK’s IP system promotes innovation and growth through efficient, contestable markets*’.

There was an all-party parliamentary debate on the Review on Thursday, 7 July. MPs seemed to be well briefed on IP issues generally and on the ideas being put forward by Professor Hargreaves. The Government intends to publish its response to the Review next month (August 2011), according to the Minister for Further Education, Skills and Lifelong Learning (Mr John Hayes) who was responding to the debate. We will hopefully know by the autumn of this year which of the ten recommendations are being taken forward.

Innovate Legal will be hosting two seminars in Central London on the copyright and patent issues raised by the Professor Hargreaves in his Report. Please contact Simon Barnham at Innovate Legal for further details: simonbarnham@innovatelegal.co.uk.

Dr Duncan Curley
Innovate Legal (London)

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UK - Patents: Registration of European patent transfers

A transfer of a European patent application designating the UK should be registered at the European Patent Office (“EPO”). It cannot be registered at the UK Intellectual Property Office (“UKIPO”). Such registration will take effect in the UK as if the transfer were of a UK patent application. However, once the European patent is granted by the EPO, the transfer will need to be registered at the UKIPO (*Lundbeck v Norpharma* [2011] EWHC 907 (Pat), 14 April 2011).

Lundbeck sued Infosint for revocation of its European patent for 5-cbx, an intermediate compound used in the manufacture of Lundbeck’s anti-depressant drug citalopram. Infosint counterclaimed for infringement of the patent by Lundbeck.

The Patents Court found that the patent was invalid and that even if it had been valid, Lundbeck did not infringe it. Nevertheless, the Court went on to consider *obiter* whether Lundbeck had a partial defence to infringement under section 68 Patents Act 1977 (“PA77”).

Failure to register

Section 68 (as amended) provides that where a person becomes the proprietor of a patent by virtue of an assignment (amongst other things) and the patent is subsequently infringed before registration of the assignment, in proceedings for such an infringement the court shall not award him costs or expenses unless:

- (a) the assignment was registered within six months; or
- (b) the court or comptroller is satisfied that it was not practicable to register the assignment before the end of that period and that it was registered as soon as practicable thereafter.

Prior to amendment in April 2006, the section referred to damages and profits rather than costs and expenses.

In 2002, the patent *application* was assigned by Norpharma to Infosint. The assignment was duly registered at the EPO. Later in 2002 following grant of the patent, Infosint instructed its UK patent attorneys to register the assignment at the UKIPO. However, the assignment was not registered at the UKIPO until the infringement proceedings were commenced in May 2010.

Section 68 has no retrospective effect (*Siemens v Thorn [2008] RPC 4*). Thus if the patent had been found valid and infringed, unless and until the assignment was registered at the UKIPO or (b) above applied, Infosint would not have recovered either damages or an account of profits for infringements prior to April 2006, nor its costs and expenses thereafter.

The registration of the assignment of the patent application at the EPO was deemed registration in the UK by virtue of section 78(3)(f) PA77. However, the Court rejected Infosint's argument that the assignment of the *granted* patent was registered under the PA77—and thus for the purposes of section 68—by virtue of the registration at the EPO since section 78(3)(f) did not apply to granted patents.

The Court also rejected Infosint's argument that it had not been practicable to register the assignment within six months and that it had been registered as soon as practicable thereafter. Practicable in the context of section 68 means that the applicant for registration must take all the steps which the reasonable applicant acting on competent advice would take in the circumstances to secure registration (*Molnlycke v Procter & Gamble [1994]*, RPC 49 at 139). In that case an application to register had been made but not acted upon by the Patent Office because of a settled practice of the Office not to register assignments when there were revocation proceedings pending. There was no statutory basis for such a practice. The Court of Appeal held that a competent agent could properly take the view that she had done all she reasonably could in the circumstances to obtain registration. The fact that Infosint's UK attorneys had not succeeded in registering the assignment despite being instructed to do so did not mean that it had not been practicable for *Infosint* to register the assignment. This was further illustrated by the fact that Infosint's Irish patent attorneys had managed to register the assignment there.

Alex Batteson and Alastair Lorimer

Linklaters LLP

LES B&I Meeting News...

Innovation and Commercialisation – better, faster, smarter

Pictures from the LES International Conference which took place from 5th – 8th June 2011:



LES Britain and Ireland President Mark Wilson, welcomes delegates to the conference



Keynote Speaker: Richard Seymour, Founder, Seymourpowell, Product Design Consultancy



Keynote Speaker: Cherie Blair, Founder, Cherie Blair Foundation for Women

“Path to progress-women and technology in developing countries”

“Fastest with the mostest”

The 21st century isn't business as usual. Like the raptors in Jurassic Park, your enemy now attacks from the side as much as he attacks from the front. Richard Seymour is a battle-hardened innovator. He's been involved with the design of the world's first pocket mobile, the world's first cordless kettle and the world's first mass space tourism venture, Virgin Galactic. And now he's looking over the horizon at what waits in store for us in the near and long term future. He likes only some of it. Fastest with the mostest is a masterclass on how to outwit your opponents, whilst hanging on to the value.



*LES (Scotland) invite you to attend...
A Drinks Reception and Comedy Showcase
Wednesday 10th August 2011, Edinburgh*

Enjoy a glass of wine and take in the spectacular views of the city from the Maclay Murray and Spens LLP offices, before experiencing some of the best comedy talent the Edinburgh Fringe Festival has to offer.

Non members are invited to attend this event as guests of a member.

This is a fantastic opportunity for members to network with likeminded professionals in a social environment and for non members to learn more about the benefits of LES membership.



**Further information and registration details will be available
at www.les-bi.org**



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Future Meetings...

LICENSING EXECUTIVES SOCIETY

14th July 2011

LES AGM and London Meeting
Linklaters, London

10th August 2011

LES (Scotland) Drinks Reception
Maclay Murray and Spens LLP, Edinburgh

1st September 2011

LES London Meeting

"Different Patent Strategies for Pharmaceuticals, Diagnostics and Devices: Understanding Why and How to Develop Your Own"

Eversheds, London

This meeting is kindly sponsored by Eversheds

20th October 2011

LES London Meeting

"Valuation; why it matters in IP?"

Navigant, London

October 2011

LES (Scotland) Meeting

Further information will be available shortly

15th November 2011

LES & ITMA Half Day Meeting

Royal College of Surgeons, London

1st December 2011

LES London Meeting

"Hot Topics Affecting Licensing"

Raynolds, Porter & Chamberlain LLP, London

1st December 2011

LES Evening Drinks Party, London

Further information will be available shortly

Please visit www.les-bi.org for further information and registration details

Members...

"Public Engagement, IP and Climate Change"

Do patent owners have too much power over responses to climate change? In April 2011, LES (Scotland) committee member Dr Abbe Brown held an open event exploring this at the Edinburgh International Science Festival - "Who Profits from Climate Change". For more details, see <http://www.sciencefestival.co.uk/whats-on/categories/talk/who-profits-from-climate-change>.

After discussions and the introduction of a case study involving a new wind and wave innovation, the audience were asked to vote (1) would they patent a new technology; and (2) would they make the technology available to all, with all paying what they consider it is worth to them. Despite some strong challenges to the power of IP, the vote was **42 – 6 in favour of patenting** and **37-7 against making it so widely available**.

The event was very well attended and there were stimulating and wide ranging presentations from the panel (from the business, political and youth perspectives) and some robust questioning from the floor. The panel comprised Martin McAdam of Aquamarine Power, Steve Burgess of the Scottish Green Party and Dhanesh Dinush, British Council Climate Champion for Scotland.

There was also display of art by primary pupils from Mile End School, Aberdeen which explored 3 topics: climate change from the perspective of the UNICEF day for Change; renewable technologies; and the evolution of creatures because of climate change. Earlier in the day in a complementary event Dr Brown held an academic expert meeting at the University of Edinburgh, which formed part of Dr Brown's project "Obtaining, protecting and using essential environmental technologies: a holistic analysis" which is funded kindly by the British Academy. For more details, see <http://www.law.ed.ac.uk/essentialtechnologies/>.

The Science Festival event, kindly supported by the SCRIPT Centre at the University of Edinburgh (see <http://www.law.ed.ac.uk/ahrc/>), was a fascinating opportunity to combine academic work with public engagement. We also found out what people really think about the way LES members spend our professional lives - licensing and controlling technologies. It also suggests that they might be surprisingly supportive....

Dr Abbe E. L. Brown
University of Edinburgh
Associate, SCRIPT

Members on the Move...

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BRITAIN AND IRELAND

New Members...

Mr Ross Nicol, Maclay Murray & Spens LLP

Interests include: Biotechnology, Pharmaceutical, computer software

Mr Simon Garrett, BT Plc

Interests include: Internet, Multimedia, Telecommunications

Mrs Sally Curran, AstraZeneca UK

Interests include: Healthcare, Pharmaceutical

Dr Angus Stewart-Liddon, Edinburgh Research & Innovation

Interests include: University, Chemical Polymers, energy

Mr Durham Grigg, JMW Solicitors LLP

Interests include: Aerospace defence, renewable energy, Multimedia

Mr Ludovic Copere, Sony

Interests include: Computer Hardware, Electronics, Internet, Multimedia, telecommunications, computer software

Dr Aleksandra Love, St George's University of London

Interests include: Healthcare, Biotechnology, Pharmaceutical

Mr Roy Fuscone, IP Exploit Limited

Interests include: Aerospace/ defence, Renewable energy, Computer software

Mr Hugh Tebay, SIPARA

Interests include: Healthcare, Multimedia, Consumer goods

LICENSING EXECUTIVES SOCIETY
BRITAIN AND IRELAND

“What’s in a name?”

“Names are everything.” said Oscar Wilde.

Robin Birley would certainly agree with that. His father, having fallen out with him over a little matter of £200,000, left the family’s nightclub empire (including the upmarket *Annabel’s* in London), together with the *Birley* brand, to the entrepreneur Richard Caring. This has prevented Robin Birley from using his surname on his own newly launched nightclub. To add insult to injury, Caring has filed an eleven-class trade mark application for *Birley* – including food and drink services in class 43, which conflicts with Robin Birley’s chain of *Birleys* sandwich shops. Predictably this application is being contested; although Robin Birley’s retaliatory attempts to register *Birley* in class 41 for night club services have been abandoned. For disinterested observers this is an entertaining spat between two interesting personalities. The story even made it to a featured article in the Sunday Times colour supplement (on the 12th June). But it also highlights the fraught problems that can arise from present day trends towards trading in businesses and cashing in on their defining intangible assets. Rather than keeping eponymous companies in the family as long as possible, there is now often an unseemly rush to capitalise on their value – which makes things difficult if a future generation or even the current seller wishes to trade again. It isn’t only celebrities that need to keep careful watch over their names.



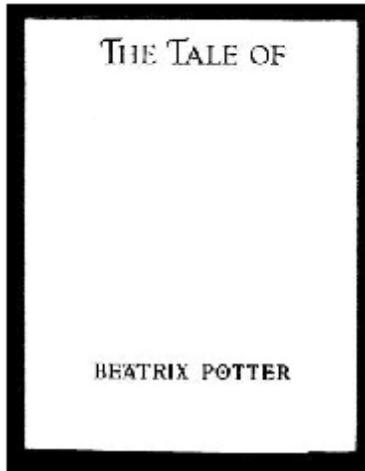
It probably all has something to do with the cult of personality. Andy Warhol opined in the 1960s that ‘Everyone will be famous for 15 minutes’, but that was before Google. It has been suggested that the message should now be ‘Everyone will be anonymous for 15 minutes’. Our indiscretions on Facebook or even in the columns of News Exchange might remain accessible indefinitely. No real merit is required; we can now be ‘famous for being famous’. Information is no longer an aid to an objective; as Marshall MacLuhan observed, the medium is the message - not the content. Names are indeed everything – and they need to be closely guarded.

Elizabeth Emanuel, was famously responsible, with her since-divorced husband, for the design of Princess Diana’s wedding dress. Subsequently she sold her business, together with the registered trade mark for her name (or rather her married name) to the Mancunian owner of the clothing trade mark *Joe Bloggs*. Later (in 2006) she sought to retrieve the right to trade under her own name, and attacked the *Elizabeth Emanuel* registration on the ground that the public, recognising her renown, would be confused into thinking she was involved in trading activities branded with the trade mark. The ECJ disagreed – the sale of her ‘famous’ name was valid. Even famous names can be registered and traded as commodities, as long as they are not in fact used deceptively. Interestingly, Elizabeth Emanuel is back in business using her own name, and has the web site elizabethemanuel.co.uk, although she uses the brand (registered trade mark) *Art of Being*.

Vivienne Westwood beware! As recently reported, she has just fought off another Mancunian, Tony Knight, in the Patents County Court, to establish her right to a monopoly in her ‘iconic’ name. If she now decides to sell up, the registration of her name will be a tradeable commodity. Without proper safeguards, her name could even end up in Mancunian ownership!

A casual romp through trade mark registers reveals many other personal name registrations that could be tradeable. There are footballers, including Lionel Messi, Wayne Rooney and David Beckham. Beckham has multiple registrations including one covering, appropriately, money boxes. In the USA, Sarah Palin has registered her name for services including ‘Information about political elections’ in class 35. In the literary area, J K Rowling is registered, following in the footsteps of

Beatrix Potter who's name, as well as her characters, have been widely registered – doubtless with the objective of extending protection beyond the imminent expiry (in 2013) of copyright in her books. An example is the 'iconic' 3D book template CTM 2802015. Her name lives on as a registered trade mark assuring immortality.



Two issues arise – especially for those with, or intending to have, famous or iconic names. First, if a name is to be sold, it may be desirable to apply some parameters of control or limitation. Perhaps a licence may be better. Second, only slightly tongue in cheek, perhaps family members should execute agreements controlling subsequent disposal of rights in the family name while they are still on good terms - before they fall out, get divorced or die. That might have saved Robin Birley his present angst.

As one of Arthur Miller's characters put it in his play *The Crucible*: "How may I live without my name? I have given you my soul; leave me my name!"

Barry Quest
iPC2



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