

# THREE NEW SQUARE

INTELLECTUAL PROPERTY



TOM  
HINCHLIFFE KC

Year of Call: 1997  
Silk: 2016

## Intellectual Property Silk of the Year 2023 **Legal 500**

*"Thomas Hinchliffe KC is excellent and has become an increasingly impressive figure at the Bar. He has particularly strong case analysis abilities."* **Chambers & Partners 2023**

*"Tom is excellent to work with, very much a team player and someone who is keen to understand the details, to ensure they present the best case possible."* **Legal 500 2023**

### PRACTICE AREA

Tom Hinchliffe practices in all aspects of intellectual property law, including patents, trade marks, passing off, copyright, registered designs and design right and confidential information.

A significant part of Tom's practice relates to hi-tech patent work. He has particular experience in relation to pharmaceutical and biotechnological patents and has been instructed in many of the leading cases in this field in recent years. Another area of Tom's expertise is telecommunication patents, in particular relating to mobile telephones, smartphones and ADSL.

Tom is ranked as a leading silk by Chambers & Partners and Legal 500 for Intellectual Property and Information Technology. Prior to his appointment as a silk, Tom was ranked by Chambers & Partners as the "star individual" at the junior bar for intellectual property and in the top tier of leading juniors by Legal 500.

### EDUCATION

- Brasenose College Oxford (1995 MA, First Class Hons. Chemistry);
- City University (1996, Diploma in Law, Distinction);
- Inns of Court School of Law (1997, top of year, graded Outstanding and Scarman scholar)

### CAREER

- Called to the Bar in 1997, Middle Temple
- Took Silk 2016
- Editor 18<sup>th</sup> and 19<sup>th</sup> Editions of 'Terrell on Patents'. Contributor to the 15<sup>th</sup> and 16<sup>th</sup> Editions

### LEGAL DIRECTORY COMMENTS

#### INTELLECTUAL PROPERTY

Thomas Hinchliffe KC is highlighted for his abilities in handling biotechnology and pharmaceutical patent litigation matters. He has also acted in numerous telecommunications and electronic patent disputes. Sources are quick to highlight his polished advocacy, his incisiveness and his commercial awareness.

- *"Thomas Hinchliffe KC is excellent and has become an increasingly impressive figure at the Bar. He has particularly strong case analysis abilities."*

[Chambers & Partners 2023, Intellectual Property, Band 2](#)

*'Tom is adept at both life sciences and technology cases, making him very versatile. He is very involved in his matters and provides excellent and timely advice, and on his feet, he has a great manner with the bench and is persuasive in his advocacy.'*

[Legal 500 2024, Intellectual Property, Band 2](#)

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Thomas Hinchliffe QC is a renowned IP specialist with significant expertise in high-tech patent cases. [Who's Who Legal UK Bar - Intellectual Property - Silks 2022](#)

Thomas Hinchliffe QC is a go-to silk among peers thanks to his leading reputation in telecoms and data IP. [Who's Who Legal UK Bar Life Sciences Silks 2022](#)

Thomas Hinchliffe QC is a respected silk when it comes to patent litigation matters. Sources say he is "*commercial, approachable, thorough and impressive at identifying the priority points*". [Who's Who Legal Life Sciences - Patent Litigation 2022](#)

"*Smart guy who is easy to work with. Good judgment on which points to run in a case*", client recommendation. "*Frequently recommended among clients and instructing law firms*" [JUVE Patent rankings 2024](#)

**Strengths:** "*Excels in pharma but has also won one of the first SEP cases for the patentee*", "*generally excellent*". Pharma and biotechnology, digital communication. "*Smart guy, easy to work with. Good judgment on points to run*". [JUVE Patent rankings 2023](#)

'Thomas Hinchliffe QC has a litany of patent victories to his name, but is as versatile as they come and adept on any case involving intellectual property.' [World Trade Mark Review, The World's Leading Trademark Professionals 2017](#)

## INFORMATION TECHNOLOGY

"Thomas Hinchliffe KC is an IP and IT expert who has a rising market profile due to his work in high-stakes technology cases, especially those involving telecoms and data transmission."

- "*Extremely clever and really good for highly technical cases.*" [Chambers & Partners 2023, Information Technology, Band 2](#)

"*Tom is excellent to work with, very much a team player and someone who is keen to understand the details, to ensure they present the best case possible.*"

[Legal 500 2024, Information Technology, Band 3](#)

## PATENT CASES

### PHARMACEUTICALS

- *Illumina v MGI* [2021] EWHC 57 (Pat); [2021] EWCA Civ 1924 (DNA sequencing, fluorescent molecules, the collocation principle and chemical molecules)
- *MSD v Wyeth* [2020] EWHC 2636 (Pat); [2021] EWCA Civ 1099 (pneumococcal vaccines, formulations, serotype selection)
- *Accord & Aspire v Allergan* [2019] EWHC 1085 (Pat) (bimatoprost, glaucoma, ocular formulations)
- *Mylan & Synthon v Yeda & Teva* [2017] EWHC 2629 (Copaxone, multiple sclerosis, *Arrow* declarations, anticipation by equivalents)
- *Illumina v Premaitha* [2017] EWHC 2930 (Non-invasive pre-natal diagnosis, Down's Syndrome)
- *Mylan, Teva and Accord v Merck Sharp & Dohme* [2017] EWHC 539 (Pat) (SPC, combination products, art 3(a) & 3(c), HIV anti-virals, Atripla)
- *Merck Sharp & Dohme Corp v Comptroller-General of Patents, Designs and Trade Marks* Case C-567-16; [2017] RPC 2 (SPCs, Medicinal Products Directive, Decentralised procedure, End-of-Procedure notices, Art 3(b), references to the CJEU)

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- Actavis v Eli Lilly [2016] EWHC 1955 (pat) (male erectile dysfunction, tadalafil, formulation)
- Hospira v Cubist [2016] EWHC 1285 (pat) (daptomycin, purification, chromatography)
- Synthon v Teva [2015] EWHC 1395 (Pat) (multiple sclerosis, Copaxone, expert witnesses)
- Novartis v Focus, Actavis and Teva [2016] EWCA Civ 1295; [2015] EWHC 1068 (Pat) (rivastigmine patches, dosing regime)
- Merck v Sigma Case C-539/13; [2015] RPC 30, [2013] R.P.C. 35; [2013] RPC 1 & 2 (SPC, parallel imports, treaty of accession to the EU of Poland; scope of orders for delivery up, Patents County Court, Court of Appeal and CJEU)
- Teva v AstraZeneca [2014] EWHC 2873 (Pat) (combination product for the treatment of asthma, formoterol, budesonide)
- Generics v Yeda [2014] R.P.C. 4; [2012] EWHC (pat) 1848 (multiple sclerosis, Copaxone, Court of Appeal and Patents Court)
- Glenmark & Mylan v Wellcome [2013] EWHC 148 (pat) (anti-malarial drugs, Malarone)
- Omnipharm v Merial [2013] EWCA civ 2; [2012] EWHC (pat) 3393 ("spot-on" formulation of a flea and tick protector for pets, FRONTLINE)
- Generics v Yeda [2013] FSR 13 (Confidential information; Employers' powers and duties; Fiduciary duty; In-house lawyers; Injunctions; Patent attorneys)
- Warner-Lambert v Teva, Phoenix & AAH (interim injunction, atorvastatin)
- Gedeon Richter v Bayer [2011] EWHC 583 (pat); [2012] EWCA 235 (oral contraceptives)
- Scinopharm v Eli Lilly [2009] EWHC 631 (pat) (process for making the cancer drug gemcitabine)
- Generics UK v Daiichi [2009] RPC 23 (ofloxacin, levofloxacin, SPCs on enantiomer products)
- Actavis v Merck [2008] RPC 26 (finasteride, male pattern baldness, second medical use claims, when Court of Appeal can depart from previous decisions)
- Generics UK, Teva & Arrow v Lundbeck [2008] RPC 19 (citalopram, escitalopram, enantiomers)
- Conor Medsystems v Angiotech Pharmaceuticals [2007] RPC 20 & [2006] RPC 28 (Court of Appeal & Patents Court, approach to obviousness, drug eluting cardiovascular stents)
- Mayne Pharma v Debiopharm [2006] FSR 37 (Patents Court, waiver of privilege by service of Notice of Experiments, oxaliplatin)
- Merck & Co., Inc's Patents [2004] FSR 16 & [2003] FSR 24 (Patents Court, Court of Appeal, validity, alendronate, bone resorption agents)
- Pharmacia/Monsanto v Merck [2002] RPC 775 & [2000] RPC 709 (Patents Court & Court of Appeal, patent infringement and validity – Cox II inhibitors, tautomers)

## BIOTECHNOLOGY

- Illumina v MGI [2021] EWHC 57 (Pat); [2021] EWCA Civ 1924 (DNA sequencing, fluorescent molecules, the collocation principle and chemical molecules)
- MSD v Wyeth [2020] EWHC 2636 (Pat); [2021] EWCA Civ 1099 (pneumococcal vaccines, formulations, serotype selection)
- Eli Lilly v Genentech [2017] (IL-17, psoriasis, Ixekizumab, Taltz, jurisdiction to seek declarations of non-infringement of foreign patents)
- Merck v Ono [2015] EWHC 2973 (pat) (anti PD-1 antibodies for treating cancer)
- Teva v Amgen [2013] EWHC 3711 (Pat) (PEGylated G-CSF; Power of the Court to grant declaratory relief concerning a patent over a former proprietor of the patent)
- Hospira v Kennedy Institute [2013] (biosimilar compounds, TNF $\alpha$ , infliximab)
- Janssen v Bayer [2011] (monoclonal antibody, TNF $\alpha$ )
- Kirin-Amgen v HMR/TKT [2003] RPC 31 (recombinant erythropoietin, amendment of a patent, good faith and reasonable skill & knowledge)

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## TELECOMS

- Nokia v Oppo [2022] EWHC 3395 (Pat) (4G LTW mobile technology, ordering RACH preambles)
- Optis Cellular Technology LLC v Apple Inc [2022] EWHC 561 (pat) & [2023] EWCA Civ 758 (4G LTE mobile telephony, uplink control signalling, PUCCH, HARQ and CQI feedback, code multiplexing structures)
- InterDigital v Lenovo [2021] EWHC 2152 (pat) & [2023] EWCA 34 (4G LTE mobile telephony, uplink control signalling, PUCCH, scheduling requests, on/off keying, OOK)
- Conversant v Huawei & ZTE [2020] EWHC 256 (pat) & [2020] EWHC 989 (pat) (FRAND inquiries, patent portfolio licensing, ETSI declarations)
- Philips v Asus & HTC [2019] EWCA Civ 2230 & [2018] EWHC 1732 (pat) (UMTS mobile telephones, HSDPA, power control, dedicated pilot bits)
- Philips v Asus & HTC [2019] EWCA Civ 2230 & [2018] EWHC 1224 (pat) (UMTS mobile telephones, HSDPA, power control, ACK/NACK differential gains)
- Unwired Planet v Samsung [2016] EWHC 94 (pat) (UMTS mobile telephones, measurement reporting; FRAND)
- Philips v Nintendo [2014] EWHC 1959 (Pat) (Nintendo Wii, motion controllers, 3D virtual body modelling)
- Philips v Nintendo [2014] EWHC 3177 (Pat) (patents, post-trial amendments, leaving patent on the register of patent in partially valid state with claims that the Court has found to be invalid)
- Samsung v Apple [2014] EWCA Civ 250 (patents, stays of appeals pending application for a central limitation in the EPO)
- Vringo v ZTE [2014] EWHC 3924 (patents, UMTS mobile telephones, Serving RNC relocation)
- Vringo v ZTE [2013] EWHC 1591 (Pat) (patents, application for determination of a FRAND royalty rate in advance of ant trial on the validity and infringement)
- Samsung v Apple [201] 3 EWHC 467 (Pat) (Patents, UMTS mobile telephones, error coding)
- Research in Motion v Motorola [2010] EWHC 118 (pat) (mobile email)
- Qualcomm v Nokia [2008] EWHC 329 (pat) (Mobile telephones, patents, infringement, validity, essentiality)
- Research in Motion UK Limited v Visto [2008] EWHC 355 (pat) (BlackBerry computers, obviousness, computer software patents)
- Research in Motion UK Limited v Visto [2007] EWHC 900 (Ch) (BlackBerry computers, abuse of process by commencement of proceedings in Italy, dismissal under Art. 28 Brussels Regulation)
- Aerotel Limited v Telco (Summary revocation of a Patent, method of doing business, patentability)
- Research in Motion UK Limited v Inpro Licensing SARL [2007] EWCA Civ 51 & [2006] RPC 20 (Court of Appeal & Patents Court, BlackBerry handheld computers)

## MEDICAL AND MECHANICAL DEVICES

- Alcon v AMO [2022] EWHC 955 (pat) (laser cataract surgery, interaction of the members of a skilled team)
- E. Mishan & Sons, Inc t/a Emson v Hozelock Limited [2020] EWCA Civ 871 & [2019] EWHC 991 (Pat) (Expandable hose pipes, infringement by variants and the *Actavis* questions, making available to the public by demonstration)
- AGA v Occlutech [2014] EWHC 2506 (Pat) & [2013] EWHC 3180 (Pat) (medical devices, vascular septal defect occluders, prior uses, confidentiality of prior use, obviousness and the common general knowledge; application to adduce further evidence after close of evidence)
- Perini v LPC UK and PCMC Italia [2012] RPC 30 (damages inquiry, machines for make wound tissue paper). Also [2009] EWHC 1929 and [2010] EWCA 525 (liability part of same case)
- Datacard v Eagle Technologies [2011] RPC 17 (printer ribbons, RFID tags)

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- Abbott Laboratories Ltd v Medinol Ltd [2010] EWHC 2865 (Pat) (cardiovascular stents)
- Triumph Actuation Systems LLC (formerly Frisby Aerospace LLC) v Aeroquip-Vickers Ltd [2007] EWHC 1367 (Airbus A320, Power Transfer Unit, Hydraulic systems, shuttle valves, Post-grant amendments)
- Conor Medsystems v Angiotech Pharmaceuticals [2007] RPC 20 & [2006] RPC 28 (Court of Appeal & Patents Court, approach to obviousness, drug eluting cardiovascular stents)
- Stanelco v BioProgress (No.1) & (No.2) [2005] RPC 15 & 16 (Patents Court, RF welding, patent entitlement and breach of confidence, application to adduce further evidence after judgment)
- Coflexip v Stolt Comex (No.2) [2004] FSR 7 & 34 (Patents Court & Court of Appeal, sub-sea pipelaying, patent infringement, inquiry as to damages, estoppel as to validity, CPC Art. 33)
- Coflexip v Stolt Comex [2001] RPC 182 (Court of Appeal, subsea pipelaying, infringement, validity, scope of final injunctions)
- Coflexip v Stolt Comex [2003] FSR 41 (Court of Appeal, patent infringement, inquiry as to damages, loss of profit, causation)

## BEFORE THE COURT OF JUSTICE OF THE EUROPEAN UNION

- Merck Sharp & Dohme Corp v Comptroller-General of Patents, Designs and Trade Marks Case C-567-16 (SPCs, Medicinal Products Directive, Decentralised procedure, End-of-Procedure notices, Art 3(b), references to the CJEU)
- Merck v Sigma Case C-539/13; [2015] RPC 30, [2013] R.P.C. 35; [2013] RPC 1 & 2 (SPC, parallel imports, treaty of accession to the EU of Poland; scope of orders for delivery up, Patents County Court, Court of Appeal and CJEU)

## BEFORE THE EUROPEAN PATENT OFFICE

- T812/00 (Thiophenes/Searle et al)

## TRADE MARKS, DESIGNS & COPYRIGHT

- Datacard v Eagle Technologies [2011] RPC 17 (trade mark, printer ribbons)
- Badge Sales v PMS International Group PLC [2006] FSR 1 (High Court, design right, secondary infringement, whether innocent acquisition a bar to interim injunction)
- Fulton v Totes [2004] RPC 301 & [2003] RPC 499 (Patents County Court & Court of Appeal, umbrella cases, design right and registered designs, construction of the statutory definition of a design)
- Euromarket Designs v Peters [2001] FSR 288 (trade marks, use of trade marks on websites, revocation for non-use)
- Scandecor v Scandecor [1999] FSR 26 (passing off/trade marks, ownership of goodwill)
- Round v Redfearn (November 1998) High Court, design right, beer bottles)

## PERSONAL

Regular competitor in triathlons – has represented Great Britain at both World Short and Long Course Triathlon Championship and has been a bronze medallist in his age group at the European Triathlon Championships.

## PROFESSIONAL MEMBERSHIPS

Intellectual Property Bar Association; Chancery Bar Association.