

# THREE NEW SQUARE

INTELLECTUAL PROPERTY



## GUY BURKILL

Year of Call: 1981

Silk: 2002

*“One of the finest legal minds in the country with regard to the law on patents...”*

*Chambers & Partners, 2015*

### PRACTICE AREA

Guy Burkill’s detailed knowledge of patent law (he was a co-editor of the 15th, 16th and 17th editions of “Terrell on the Law of Patents”, the practitioners’ textbook) is coupled with a strong technical background (a first class degree in engineering from Cambridge, taking the “electrical option”).

He engages effectively with expert witnesses, and relishes the challenges of understanding, analysing and explaining complex technology. He has been particularly active in patent cases involving smartphones, computer hardware and software, electronics, and mechanical engineering, and has acted for many leading multinational companies in the fields of telecoms, computer, electronics, chemical, pharmaceutical, aviation, and other industries.

He is experienced in all areas of intellectual property, and also maintains a more diverse practice in copyright, trade marks, confidential information, and other IP. Recent non-patent work has included cases involving copyright in security system firmware, copyright in architect’s plans, misuse of confidential information removed by ex-employees (acting variously for employers and employees), and trade mark use on rebranded parallel imported goods (acting variously for trade mark owners and for alleged infringers).

### PUBLICATIONS

Co-editor of Terrell on the Law of Patents (15th edition, 2000; 16th edition, 2006; 17th edition, 2011).

### EDUCATION

- Entrance scholarship to Winchester College 1970;
- Entrance scholarship to Corpus Christi College, Cambridge 1975.
- First Class Hons MA degree in Engineering (Electrical option), Cambridge University 1978.

### LEGAL DIRECTORY COMMENTS

“Guy is actually the one who truly understands telecoms patents. His soft-speaking style hides powerful cross-examination skills that sneak up on witnesses.”

“He is so technically-minded even compared with other KCs; he really stands out and comes up with good arguments and brings creative angles.” - *CHAMBERS UK, 2022*

“He is just so creative; he knows where to stretch the law and reads the court fantastically well.’

‘If you need someone to work on very complex technology at the highest level it has to be Guy.’ - *CHAMBERS UK, 2018*

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"Celebrated for his white-hot intellect and superior instincts which have been honed by three decades of handling IP litigation at the highest levels" - *CHAMBERS UK, 2016*

"Frighteningly clever, and the automatic top pick for impossibly technical patents". - *Legal 500, 2016*

"One of the finest legal minds in the country with regard to the law on patents, who has played a prominent role in litigating the 'Smartphone Wars' of recent years. Many sources express admiration for his knowledge of computers and electrical engineering. 'Spectacular in front of the judge, he has absolute control over the courtroom.' 'He's very user-friendly and has a superb engineering brain that allows him to give practical advice.'" - *CHAMBERS UK, 2015*

'Extraordinarily clever; very gifted at guiding the judges through the most complex of cases' - *Legal 500, 2015*

"On an electronics case, he's a complete master of the technology." "He's absolutely terrific on his feet." - *Chambers UK, 2014*

**"gets to grips with the most difficult technical subject matter known to man"** - *Legal 500, 2013*

**"The 'unbelievably clever, extremely funny and technically superb' Guy Burkill QC is a favourite for patent cases including complex technology, particularly in the electronics field"** - *Chambers UK, 2010*

**"Not only interested in technology but can explain it in terms that laymen can understand"** - *Chambers UK, 2007*

## PRINCIPAL CASES

House of Lords and Court of Appeal patent including:

- *Sevcon v. Lucas* (House of Lords case on limitation periods in patent actions)
- *Asahi's patent* (House of Lords case on enabling disclosures)
- *Allen & Hanburys Limited v. Generics* (House of Lords case on licences of right; effect of European law on Comptroller's discretion to impose terms)
- *SKF (cimetidine) and American Cyanamid (fenbufen)* (licences of right; royalty rates and terms)
- *Procter & Gamble v. Peaudouce and Mölynlycke v. Procter & Gamble* (both disposable nappies; ambiguity; evidence of obviousness)
- *Pavel v. Sony* (the "Walkman" case, first case in Patents County Court)
- *Hallen v. Brabantia* (corkscrews; technical versus commercial obviousness)
- *Van der Lely v. Rustons* (harrows)
- *Step v. Emson* (atomisers; claim construction - claim integers cannot be entirely ignored)
- *Glaverbel v. British Coal* (furnace repair; principles of construction of patent claims)
- *Hoechst Celanese v. BP* (two actions concerning acetic acid purification, account of profits)
- *Lubrizol v. Exxon* (oil additives: prior use, obviousness, ambiguity, "section 64 defence")
- *Pioneer v. Warner* (compact discs; product-by-process claims)
- *Discovision v. Disctronics* (compact disc mastering)

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- Buehler v. Chronos Richardson (no estoppel arising from previous EPO opposition decisions)
- Asahi v. Macopharma (blood transfusion apparatus; obviousness)
- Amersham Pharmacia v. Amicon (chromatography apparatus; construction of claims)
- Thermos v. Aladdin (registered designs; function of appeal court)
- Dyson v. Hoover (cyclonic vacuum cleaners; post-expiry injunction)
- Agilent v. Waters (chromatography pumps: claim construction and estoppel)
- Glaxo v. Dowelhurst (trade marks, parallel imports: "placing on the market" in EU)
- Smith International v. SPS (drill string equipment: second tier appeals from Patent Office)
- RIM v. Inpro ("BlackBerry" email system; anticipation and obviousness)
- Halliburton v. Smith (computer-aided design of oil drill bits; insufficiency)
- Schlumberger v. EMGS (subsea electromagnetic surveying for hydrocarbons)
- Apple v. HTC (patentability of computer software / computer implemented inventions)
- Nokia v. HTC (stay of first instance injunction pending appeal)
- Samsung v. Apple (parallel proceedings in Court of Appeal and central limitation at EPO)
- Flynn Phama v DrugsRUs (rebranding of products imported from EU)

Appeared before the ECJ (European Court of Justice) sitting as the full court with eleven judges in *Theftford v. Fiamma* (harmonisation of patent law within the EEC).

Numerous High Court and Patents Court matters. Those first instance cases which went no further but which he remembers with particular affection include:

- IBM v. Phoenix (passing off rebuilt memory cards, Eurodefences)
- Philips v. Princo (encoding of position information on otherwise blank recordable CDs)
- Sega v. Codemasters (protection systems in video game consoles to enforce purported licensing obligation)
- Sweeney v. MacMillan (revived copyright in James Joyce's novel "Ulysses": alleged passing off of new edition)
- Texas Instruments v. Hyundai (integrated circuit component layout)
- Thomson v. Pace (DVD and MPEG-2 encoding techniques)
- Qualcomm v. Nokia (power control in mobile phone systems)

Appearances before the EPO (European Patent Office) and Technical Boards of Appeal in Munich in cases involving inter alia tachometers, aspartame crystallisation, oil wellheads, liquefied air distillation, machine tool cutting inserts, refractory articles, 3-D displays, predictive text keyboards, television audience measurement systems, subsea electromagnetic surveying, and banknote security markings.

## EXTRA-LEGAL EXPERIENCE

- During his engineering degree course, Guy Burkill spent four months in industry (involved in the design, assembly, testing and repair of electronic remote signalling and control apparatus with Westinghouse).
- He also designed and built his own microcomputers from scratch (with associated bootstrap firmware and operating software) in the mid/late 1970s before their widespread commercial availability, and later wrote entries for the first European Microcomputer Chess Championship (1978) and first World Microcomputer Chess Championship (1980).

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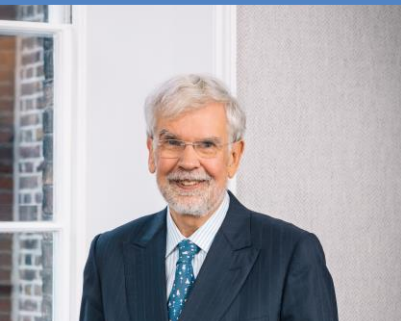
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- He has written software in a variety of computer languages including 6502 and 808x machine code and assembly language, Fortran, Basic, Pascal, and C, and nowadays sometimes programs in C# on the Visual Studio.net platform when time permits.

## LEISURE INTERESTS

Leisure interests include the violin (he performs regularly with the London Phoenix Orchestra, probably London's leading amateur orchestra, and other symphonic and operatic ensembles, and over the years has played at among other venues the Royal Festival Hall, Queen Elizabeth Hall, St. John's Smith Square, and Cadogan Hall), opera, battling with HS2, and trying to mend things.

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