

# THREE NEW SQUARE

INTELLECTUAL PROPERTY



JEREMY HEALD

Year of Call: 2010

*"A calm and considered advocate who is well known for his experience in assisting pharmaceutical clients in patent revocation actions. He is also highlighted for his work in trade mark disputes, including infringement actions."*  
**Chambers and Partners 2018**

## PRACTICE AREA

Jeremy has a broad intellectual property practice, with a particular focus on patents, trade marks and passing off. He is described by clients as a "calm and considered advocate" who provides "solid, well-reasoned and accurate advice."

He has worked for clients from a wide range of industries including pharmaceuticals, biotechnology, medical devices, telecoms, software, automotive, financial services, retail, food, hospitality, clothing, education, music, and entertainment.

He has extensive experience appearing both with and without a leader in proceedings before the High Court and the Intellectual Property Enterprise Court. He has also acted in CJEU, UKIPO and EPO proceedings without a leader.

Jeremy's patent recent cases include *Fujifilm v AbbVie*, which both clarified and developed the law relating to Arrow declarations, and *Hospira v Genentech*, which involved three separate actions in the High Court and Court of Appeal and related proceedings in the EPO.

In trade marks, Jeremy has recently acted in *Sky v SkyKick* and *Nestle v Mondelez*, a CJEU case regarding the need to prove acquired distinctive character throughout the EU.

Jeremy also has extensive advisory experience ranging from general advice on the merits of a claim or defence to detailed advice on specific points in both contentious and non-contentious matters. Examples are given below.

## LEGAL DIRECTORY COMMENTS

*"A calm and considered advocate who is well known for his experience in assisting pharmaceutical clients in patent revocation actions. He is also highlighted for his work in trade mark disputes, including infringement actions. He regularly appears in UKIPO, EPO and Court of Appeal proceedings."*

*"He has a very good grasp of both the technical and the legal issues, and he takes a pragmatic approach to the law."*

*"He is very thorough, extremely bright and hard-working."*

Chambers and Partners 2018

*"His legal analysis is sharp and he provides solid, well-reasoned and accurate advice."*

The Legal 500 UK 2018

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## EDUCATION

- 2008: BSc (Hons), First Class, Mathematics and Physics, University of Durham
- 2009: Graduate Diploma in Law, Nottingham Law School
- 2010: Bar Vocational Course, Nottingham Law School

## CASES

### PATENTS

Jeremy has been instructed as a junior in a number of major patent matters in the High Court and Court of Appeal including:

- *Philips v Asus & HTC* – Jeremy acted for Asus and HTC in successfully defending allegations of infringement of a telecoms patent relating to HSDPA in UMTS on the ground that the patent was invalid for obviousness. Judgment: [2018] EWHC 1732 (Pat)
- *Fujifilm v AbbVie* – Jeremy acted for the AbbVie in this claim for an Arrow declaration relating to biosimilar versions of Humira (adalimumab). The case involved major interim hearings, both at first instance and on appeal, addressing the question of whether such relief is permissible. At trial, Jeremy worked on AbbVie's successful defence of a claim of lack of entitlement to claim priority. Judgments: [2017] EWCA Civ 1, [2017] EWHC 395 (Pat) and [2016] EWHC 425 (Pat).
- *Hospira v Genentech* – In three sets of proceedings Jeremy acted for Hospira in its successful claims for revocation of six patents relating to trastuzumab (Herceptin). Judgments: [2016] EWCA Civ 1185, [2016] EWCA Civ 780; [2015] EWCA Civ 57, [2015] EWHC 1796 (Pat), [2014] EWHC 3248 (Pat), [2014] EWHC 1668 (Pat), [2014] EWHC 1094 (Pat), [2014] EWHC 208 (Ch)
- *Actavis v Lilly* – Jeremy acted for the Lilly in its successful defence of a revocation action relating to its patent for the use of Strattera (atomoxetine) in the treatment of ADHD. Judgment: [2015] EWHC 3294 (Pat).
- *Samsung v Apple* – Jeremy acted for Apple in its successful defence of an infringement/invalidity action relating to the simultaneous transmission of data streams on the same frequency range from a mobile device to a base station. Judgment: [2013] EWHC 468 (Pat)
- *Generics (UK) v Yeda & Teva* – Jeremy acted for the Defendants in their successful defence of a revocation/non-infringement action relating to Copaxone (glatiramer acetate), a drug used in the treatment of multiple sclerosis. Judgments: [2013] EWCA Civ 925 and [2012] EWHC 1848 (Pat)

Jeremy has also appeared without a leader in patent matters in the High Court, the IPEC and the EPO, including:

- Opposition to EP 1 037 926 – Jeremy was instructed in this opposition to a European patent relating to the use of the combination of trastuzumab (Herceptin) and paclitaxel in the treatment of breast cancer. The opposition was successful at both first instance and on appeal to the Technical Board of Appeal.
- Opposition to EP 2 379 108 – In this opposition, Jeremy successfully opposed the grant of a patent relating to methods for purifying immunoglobulins. The Main Request and Auxiliary Requests were rejected on grounds of lack of clarity, insufficiency and extension of protection.
- Opposition to EP 2 398 817 – Jeremy was instructed by an Opponent in this opposition to the grant of a European patent relating to purification processes for daptomycin. The patent was maintained but only on the basis of a main request which was substantially narrower than the claims as granted.
- *Lilly v Sanofi* – Jeremy successfully made the unconditional application to amend the Defendant's patents. This concluded the litigation as the Defendant had acknowledged that the Claimant did not infringe the claims as amended.

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- *Brundle v Perry* – Jeremy acted for a third party in its successful defence of an action for infringement of a patent for a fence bracket. Judgments: [2014] EWHC 475 (IPEC) and [2014] EWHC 979 (IPEC)

## TRADE MARKS AND PASSING OFF

Jeremy recently appeared on behalf of Mondelez in the CJEU in Joined Cases C-84/17 P, C-85/17 P, C-95/17 P *Société des produits Nestlé v Mondelez UK Holdings & Services*. He successfully argued that if a mark lacks distinctive character in part of the Union, even if only a single member state, then it is not registrable as an EU trade mark.

Jeremy has acted as a junior in major trade mark cases including:

- *Sky v SkyKick* – Jeremy acted for Sky in these trade mark infringement/validity proceedings. Sky was successful in a significant number of its arguments but determination of the case now depends on the outcome of a reference to the CJEU. Judgment: [2018] EWHC 155 (Ch)
- *JW Spear v Zynga* – Jeremy was instructed by the Claimants in this trade mark infringement and passing off claim regarding whether the use of the name SCRAMBLE for a game infringed the Claimants' rights in the word SCRABBLE and the shape of the Scrabble tile. Judgments: [2015] EWCA Civ 290, [2013] EWCA Civ 1175, [2013] EWHC 3348 (Ch), [2013] EWHC 1640 (Ch) and [2012] EWHC 3345 (Ch)
- *Stichting BDO v BDO Unibank* – Jeremy acted for the Claimants in this dispute between a network of accountancy firms and a Filipino bank regarding the use of the name BDO. Judgment: [2013] EWHC 418 (Ch)
- *Samuel Smith Old Brewery (Tadcaster) v Philip Lee (t/a Cropton Brewery)* – Jeremy appeared for the Claimant in this infringement action relating to beer trade marks. Judgment: [2011] EWHC 1879

Jeremy also has extensive experience appearing in the Trade Marks Registry and before the Appointed Person. Recent examples include:

- PALLADIUM (O/315/18)
- ANNTAYLOR (BL O/281/17)
- LUXURY HOTELS OF THE WORLD (BL O/150/17)
- GOURMET (BL O/226/17 and O/298/16)
- LIPODERM (BL O/083/16)
- DELOREAN (BL O/317/16 and O/320/15)

## ADVISORY WORK

Examples of specific issues on which Jeremy has advised are given below.

### PATENTS:

- Entitlement to claim priority
- Interpretation, validity and enforcement of licence agreements
- *Arrow/Fujifilm* declarations

### TRADE MARKS AND PASSING OFF:

- Trade mark infringement by search engine operators in light of the CJEU decisions in the Google AdWords cases
- Infringement of a three dimensional trade mark for the design of a car part
- Infringement of a trade mark registered for clothes by the use of a sponsor's logo on team replica clothing
- Conflict between businesses having long-standing use of similar names arising as their markets began to overlap

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## COPYRIGHT

- Licensing, including drafting and disputes
- Comparison of software code bases to establish whether a substantial part of one has been reproduced in the other

## PROCEDURE:

- Choice of forum: the relative merits of bringing a claim in the High Court, the Intellectual Property Enterprise Court, the UKIPO, the EPO or the EUIPO
- Privilege, including the protection of communications with patent and trade mark attorneys
- Orders for letters of request for the examination of witnesses in foreign jurisdictions

## PROFESSIONAL MEMBERSHIPS

Intellectual Property Bar Association, Chancery Bar Association

## PUBLICATIONS

Contributing author to Terrell on the Law of Patents (18th edition, 2016), the leading practitioner textbook on UK patent law

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