

# THREE NEW SQUARE

INTELLECTUAL PROPERTY



TOM  
MITCHESON QC

Year of Call: 1996  
Silk: 2014

## *Appointed Person hearing appeals from the Trade Mark Registry 2016*

## *Standing Counsel to the Comptroller General for Patents, Designs and Trade Marks 2009-2014*

### LEGAL DIRECTORY COMMENTS

Chambers Bar Awards 2018 Silk of the Year IP/IT

IP, IT & Media Silk of the Year – Legal 500 UK Bar Awards 2017

#### LEGAL 500 2020, IP, LEADING SILKS:

'Tom is extremely bright, has an excellent ability to get to the nub of a case and is a skilful advocate, making points clearly and powerfully but with refreshing brevity. He has also carved out a really strong practice in Supreme Court appeals.'

#### CHAMBERS & PARTNERS 2020, IP, BAND 1:

A very popular silk recommended for his calm demeanour, excellent client service and strong cross-examination skills. He is noted for his handling of patent and trade mark litigation, including oppositions and infringement claims, and is active in appellate work at the very cutting edge of the law. He has notable experience acting for life sciences companies in supplementary protection certificate disputes.

Strengths: "A quiet advocate but one the court listens to." "The quality of everything he does is exceptional." "His advocacy is excellent because, no matter the argument, he makes it so clear and easy for the judges that he always stands out."

#### WORLD TRADEMARK REVIEW – TOP TRADEMARK PROFESSIONALS 2017:

"...impresses everyone who crosses his path. "He is good for unusual trademark cases, especially those involving extended passing off and geographical indications.""

### PRACTICE AREA

Tom has experience in all types of contentious intellectual property work including patents, trademarks, copyright, design right, registered designs, passing off and confidential information. He has been involved in a wide variety of interim applications and trials in the High Court, Court of Appeal and the Supreme Court. He also makes regular appearances in the UK Patent Office & Trade Marks Registry, at the European Patent Office (both Opposition Division and Board of Appeal level) and in the Court of Justice of the European Union.

In 2021 he was called to the Irish Bar.

### PRINCIPAL CASES

- FibroGen v Akebia (law of plausibility/undue burden, anemia treatment, CA)
- IPCom v Vodafone (Crown Use, telecoms, CA)
- Illumina v MGI (patents for sequencing by synthesis of human genome)
- Rhodia v Neo (uncertainty insufficiency, catalysts, CA)

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- Actavis v ICOS (obviousness, dosage regime, SC)
- Eli Lilly v Genentech (antibody technology)
- Warner Lambert v Actavis (insufficiency, second medical use, SC)
- Sandoz v Searle (SPC for Markush formula)
- Illumina v Premaittha (Non invasive prenatal testing)
- Actavis Group v Eli Lilly (appropriate test for infringement by equivalents for patent covering pemetrexed/Alimta, CA)
- Warner-Lambert v Actavis (second medical use patent for pain covering Pfizer's Lyrica (pregabalin) product, CA)
- Actavis v Eli Lilly (plausibility of patent for use of drug to treat ADHD)
- Teva v Gilead (reference to CJEU on interpretation of Article 3(a) SPC Regulation)
- GSK v Wyeth (patent concerning GSK's Bexsero vaccine for meningitis B)
- Servier v Apotex (defence of illegality, SC)
- Hospira v Genentech (patents covering trastuzumab/Herceptin, CA)
- Cosmetic Warriors (Lush) v Amazon (trade mark, adwords, search engine, CA)
- Astra Zeneca v Krka (pharmaceutical patent, damages enquiry for esomeprazole/Nexium patent, CA)
- Eli Lilly v HGS (industrial applicability & SPC for antibody against neutrokin-alpha, SC & CJEU)
- Lantana Ltd v Comptroller-General of Patents (patentability, CA)
- Case C-274/11 Spain v Council, CJEU (enhanced cooperation, Unitary Patent) for UK Government
- Cadbury v Nestlé (shape mark for four finger KitKat, High Court, CJEU & General Court)
- Case T 0612/09 EPO TBA Board 3.3.04 (added matter) for Opponent
- Hospira v Novartis (whether injunction following successful trial for patent relating to zoledronate, CA)
- International Stem Cells Corporation (patentability, reference to CJEU in relation to parthenotes) for Comptroller/UK Government
- Eli Lilly & Co v Janssen Alzheimer Immunotherapy (antibody for Alzheimer's disease)
- Case T 0230/08 EPO TBA Board 3.3.04 (antibody patent) for Opponent, Merck Serono
- Schütz v Werit 2 All E.R. 177 (mechanical patent, meaning of making, SC)
- Really Virtual Co Ltd v Comptroller-General of Patents [2013] R.P.C. 3 (patentability)
- Case C-414/11 Daiichi Sankyo (CJ, effect of TRIPs) for UK Government
- Sudarshan v Clariant (pigment polymorph patent)
- Wagner v Earlex (mechanical patent)
- Teva v AstraZeneca (pharmaceutical formulation patent)
- Bayer v Genentech [2013] R.P.C. 28 (patent for antagonists of VEGF)
- Case C-482/09 Budějovický Budvar (CJ, trade mark acquiescence) for UK Government
- Apimed v Comptroller General of Patents (CA, patent for surgical dressings)
- Omnipharm v Merial (patents for flea treatments)
- MedImmune v Novartis [2013] R.P.C. 27 (biotechnology patent)
- Eli Lilly v Neopharma (summary judgment, pharmaceutical patent)
- Warner-Lambert v Teva (interim injunction, pharmaceutical patent)
- Tate & Lyle v Roquette [2011] FSR 3 (chemical patent, CA)
- Medeva's Patents [2012] R.P.C. 26 (SPC, CA & CJ Reference, for Comptroller/UK Government)
- Siemens v Seagate (N. Ireland, patent action, hard disk technology)
- Teva v Merck [2010] FSR 17 (pharmaceutical patent, CA)
- Hospira v Amgen (pharmaceutical patent)
- CoreValve v Edwards [2010] FSR 34 (patent action, heart valve technology, CA)

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## TOM MITCHESON QC

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Silk: 2014

- L'Oreal v eBay [2009] RPC 21 (trademark dispute, CJ Reference)
- GSK v Abbott (contractual & patent dispute)
- Lundbeck v Teva [2009] RPC 13 (House of Lords, scope of sufficiency)
- Sandoz v Napp [2009] RPC 11 (patent action, controlled release formulation)
- GSK v Sanofi (vaccine patent, EPO Opposition & Appeal)
- Leo v Sandoz (interim injunction, patent action)
- Knorr-Bremse v Haldex [2008] FSR 30 (conflict of laws)
- UK Channel Management v E! Entertainment [2008] FSR 5 (survey evidence in trademark dispute)
- Luxim v Ceravision [2007] RPC 33 (patent entitlement dispute)
- Pozzoli v BDMO [2007] FSR 37 (patent action, CA)
- USP v LGH [2006] FSR 6 (damages inquiry in copyright action, CA)
- Mayne v Debiopharm [2006] FSR 37 (patent action - platinum based anti-cancer drug)
- Ultraframe v Eurocell [2005] RPC 7 & 36 (patent & design right, CA)
- GSK v Apotex [2003] FSR 30, [2005] FSR 44 [2007] Ch 71 (damages inquiry on cross undertaking in patent action, CA)
- Agilent v Waters (damages inquiry in patent action)
- Dyson v Strutt (confidential information in employment dispute)
- Mayne v Teva (patent infringement - pharmaceutical formulation)
- NIC's Licence of Right [2005] RPC 1 (design right)
- Sir Robert McAlpine v Alfred McAlpine [2004] RPC 36 (passing off)
- Buchanan v Alba [2004] RPC 34 (improvements clause, HL)
- Rockwater v Coflexip [2004] RPC 46 (patent infringement, CA)
- THQ/JAKKS v World Wildlife Fund [2004] FSR 10 (contractual dispute)
- Arsenal v Reed [2003] RPC 9 & 39 (trademark - ECJ reference & CA)
- Collag v. Merck [2003] FSR 13 (confidential information)
- Coca-Cola v. Mabe (trademark & passing off) [2002] FSR 47
- Apple Computer's Design Application [2002] FSR 8
- 3M v Rennicks Ltd [2000] FSR 727 (stay pending EPO proceedings)
- Magic Ball Trade Mark [2000] RPC 439 (non-use)
- Kimberly-Clark v Procter & Gamble [2000] RPC 422 CA
- Norowzian v Arks [2000] FSR 363 (copyright in Guinness television advert, CA)

## EDUCATION

Baring Foundation Scholarship 1990-1991. Spent 9 months living with Nobel Prize-winner Dr James Watson and working as a research assistant at Cold Spring Harbor Laboratory, Long Island, USA.

Trinity College, Cambridge (1994 MA First Class Hons Natural Sciences).

City University (1994 Diploma in Law CPE - Distinction).

Inns of Court School of Law & Major Scholar, Inner Temple (1996)

## PROFESSIONAL MEMBERSHIPS

Intellectual Property Bar Association; Chancery Bar Association; Bar European Group.

## PUBLICATIONS

Wang P-C, Vancura A, Mitcheson TGM, and Kuret J (1992), "Two genes in *Saccaromyces cerevisiae* Encode a Membrane-Bound Form of Casein Kinase-1", *Molecular Biology of the Cell* 3, 275-286.

Contributor to "Terrell on the Law of Patents" (19th edition 2020).

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