

THE SIR HUGH LADDIE LECTURES



Hugh Laddie



Robin Jacob

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The First Ten Years

Edited by
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PREFACE

Hugh and I were in opposite rooms in Chambers as barristers. We were not infrequently advising opposing sides. But we hardly ever were on opposite sides in the courtroom. Why? Because we thought very alike. If I was advising a client he had a good case, Hugh would be advising the other side that he had a weak one. And vice versa. So, most cases between us settled. Some people called us the terrible twins and often judges mixed us up. Judges sometimes said ‘Yes Mr Laddie’ to me and ‘Yes Mr Jacob’ to him.

Because we thought so alike I am completely confident in saying how much Hugh would have not only enjoyed but appreciated the lectures given in honour of his memory. They are a formidable collection. Serious and perceptive, sometimes funny, and eminently readable they all are. It fell to me to decide who to ask and to do the asking. No one I asked ever said no. All the Hugh Laddie lecturers were first choices. They could each have said no, not least because preparing a big lecture of this sort is a huge pain! We are immensely grateful to all the lecturers for agreeing to suffer and actually going through that pain.

The lectures range over the entire spectrum of IP rights. Some cover all. Between them they give a unique perspective of IP over the last ten years. I like to think there is not a practitioner, at least one who loves his or her job, who would not enjoy and gain from these lectures. They will also gain from reading – or re-reading – Hugh’s own inaugural lecture, which we have included too. It is a rallying call to keep IP rights within rational bounds, given in Hugh’s inimitable style.

It may be of interest to know how we went about preparing the text. In most cases, we used the services of superb shorthand writers to transcribe the lectures from the recordings. I am immensely grateful to Jenny Chandler of Marten Walsh Cherer Ltd for organising this. She was a good friend of Hugh’s and is good friend of mine. Each transcript was sent to the speaker. They were merely invited to approve the text, not to update it – the whole point being that the lectures portray the subject matter as it was at the time when they were given. In some cases, the speakers have provided a postscript. In some cases, none was necessary – or in the case of Michael Fysh’s lecture, remotely possible!

I have the honour to be the Director of Hugh’s creation at UCL Faculty of Laws – the Institute of Brand and Innovation (IBIL). It was created with the objective of being an institute with its own distinctive character, not only

undertaking first-class academic research, but also paying attention to the practical application and problems of intellectual property law and to the interests of practitioners in this field. These dual aims are reflected here. Hugh got leading chambers and law firms to support it. They still do, and we are immensely grateful to all our past, present and future sponsors. Without them the Hugh Laddie lectures could not exist.

Two final words. Reading this book may make some wish they could hear and see the lectures as they were given. They can, in most instances, because we recorded them, and have uploaded them to view at: www.ucl.ac.uk/ibil/events. Lastly, I must thank Dr Lynne Chave who managed the organisation of the material with seemingly effortless skill and the publishers, Intersentia, who took this on and made it all work in much shorter order than is customary amongst publishers.

Robin Jacob
Sir Hugh Laddie Professor of Intellectual Property Law,
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April 2019

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The Rt Hon. Lord Leonard Hoffmann

Honorary Professor of Intellectual Property Law, Queen Mary University of London; Visiting Professor, Faculty of Law, Oxford University.

Lord Hoffmann is one of the most influential English jurists. He served as a Lord of Appeal in Ordinary (Law Lord) from 1995 to 2009, having been a member of the Court of Appeal (1992 to 1995) and a High Court Judge in the Chancery Division (1985 to 1992). He attended the University of Cape Town and then came to England to study law at Queen's College, Oxford, as a Rhodes scholar. Having graduated as Bachelor of Civil Law as Vinerian Scholar, he was elected Fellow of University College, Oxford. He was called to the bar by Gray's Inn in 1964, he became Queen's Counsel in 1977.

Throughout his judicial career, Lord Hoffmann gave judgments that have shaped modern English law in a number of fields from the interpretation of arbitration clauses to the scope of the Convention rights under the Human Rights Act. In the field of intellectual property law, he is perhaps best known for patent decisions including *Improver v Remington* [1990] F.S.R. 181; *Merrell Dow Pharmaceuticals Inc v H N Norton* [1995] UKHL 14, *Biogen Inc v Medeva plc* [1996] UKHL 18; *Kirin-Amgen v Hoechst Marion Roussel* [2004] UKHL 46 and *Synthon BV v Smithkline Beecham plc* [2005] UKHL 59, as well as the copyright judgments: *Designers Guild Ltd v Russell Williams (Textiles) Ltd* [2000] UKHL 38 and *Newspaper Licensing Agency v Marks & Spencer plc* [2001] UKHL 38.

Since retiring from the House of Lords, Lord Hoffmann has been an active arbitrator, having sat in over a hundred arbitral proceedings under the rules of the ICC, the LCIA and ICSID in disputes concerning commercial contracts, property, intellectual property rights, private international law and public international law. He continues to be a non-permanent judge of the Court of Final Appeal of Hong Kong and was awarded the GBM in 2014.

Raimund Lutz

Former Vice-President of the EPO and Former President of the German Federal Patent Court, Munich.

Raimund Lutz has enjoyed a long and distinguished career in intellectual property law, having held senior positions at the German Federal Ministry of Justice, the German Patent Office and the European Patent Office.

Having worked as a judge and public prosecutor in Munich, he joined the Federal Ministry of Justice in 1986 to work in the division for commercial and economic law. He then moved to the German Patent Office in 1989 to head up the Berlin division, and from 1997, he also became the director of the trade mark division at the Office in Munich. Between 2000 and 2005, Lutz served as Deputy Director for intellectual property law at the Federal Ministry of Justice and was appointed President of the German Federal Patent Court (Bundespatentgericht) in 2006.

He joined the European Patent Office in 2011 as Vice-President, Directorate-General for Legal and International Affairs, retiring recently in December 2018. In this role, he oversaw European and international co-operation, patent law and multilateral affairs, legal services, patent information and the European Patent Academy.

The Hon. Mrs. Justice Macken (ret'd)

Retired Judge of the Irish Supreme Court and Former Judge of the European Court of Justice of the European Union (CJEU).

The Hon. Mrs Justice Macken was called to the Irish Bar in 1973 and to the Bar of England and Wales in 1987. Upon completion of her Masters degree at LSE, London, she worked as legal counsel to a firm of patent and trade mark attorneys in Dublin, before commencing practice at the Bar of Ireland, taking silk in 1995. She was appointed a judge of the High Court of Ireland in 1998 and became the first woman judge to be appointed to the European Court of Justice in 1999. She returned to the High Court of Ireland in 2004 and was appointed to the Irish Supreme Court the following year, retiring in 2012.

During her time in judicial office she presided over or was a member of the formation in many seminal cases involving a wide range of legal issue, at European and national level, including in the areas of intellectual property, privacy and data protection, free movement, the environment, regulatory control, telecommunications, the European Arrest Warrant, and in a broad range of constitutional and EU Treaty matters.

The Hon. Mrs Justice Macken has served as Chair of the Irish Centre for European Law at Trinity College, Dublin for several years. While a judge of the CJEU, she was elected on of the 50 most influential persons in the world in the field of intellectual property, and in 2015, she was presented with the Outstanding Individual Achievement in IP Award at the *Managing IP Magazine* Global Awards for her contribution to IP at the CJEU, and in promoting an understanding of the EU court system. She has been conferred with a Doctorate (Hon. C) by Trinity College, Dublin, to mark her contribution to the Law.

Professor Randall R. Rader

Honorary Professor of Law, Tsinghua University, China; Former Chief Judge of the United States Appeals Court for the Federal Circuit.

For over 25 years, Randall Rader has been a leader in the field of intellectual property law. His judicial opinions, his publications and his work teaching patent law globally to students, judges and government officials has left an indelible mark on the field of IP law and the protection of IP rights throughout the world.

Rader was appointed to the US Court of Appeals for the Federal Circuit in 1990, assuming the duties of Chief Circuit Judge in 2010. Prior to this, he served on the United States Claims Court (now the US Court of Federal Claims), having already served as Minority and Majority Chief Counsel to Subcommittees of the US Senate Committee on the Judiciary (including the Subcommittee on Patents, Trademarks and Copyrights) and as Counsel in the House of Representatives for representatives serving on the Interior, Appropriations, and Ways and Means Committees. He received a B.A. in English from Brigham Young University and a J.D. from George Washington University Law School.

Former Chief Judge Rader has received many awards, including the Sedona Lifetime Achievement Award for Intellectual Property Law in 2009, the Distinguished Teaching Awards from George Washington University Law School in 2003 and 2008 and the J. William Fulbright Award for Distinguished Public Service in 2000. He has also co-authored several leading text books including *Cases and Materials on Patent Law* (3rd ed., 2009) and *Patent Law in a Nutshell* (Thomson/West 2007) which has been translated into Chinese and Japanese.

Since leaving the bench in 2014, Rader now focuses on arbitration and mediation, as well as legal consulting and legal education. He was conferred an Honorary Professorship from the School of Law at Tsinghua University in Beijing and has taught IP courses there as well as at leading law schools in Washington, D.C., Seattle, Santa Clara, Bangkok, Seoul, Tokyo, and Munich. He sits on the Board of the International IP Commercialization Council, a global, non-profit organization which promotes an increased understanding of IP amongst innovators, entrepreneurs and investors. He has advised governments on international IP standards and through speaking engagements worldwide, he continues to advocate improvements in innovation policy.

Professor Dr Joachim Bornkamm

Former Judge and President of Chamber at the Bundesgerichtshof, the Federal Supreme Court of Germany; Honorary Professor at the University of Freiburg.

Joachim Bornkamm received his law education at the Universities of Freiburg, Munich, Lausanne and Oxford, receiving his Dr. iur. from the University of Freiburg. After serving as a magistrate at the Amtsgericht (Magistrate's Court) and as a judge at the Landesgericht (Regional Court) in Freiburg, Dr Bornkamm moved to the Copyright Department of the Ministry of Justice in Bonn (1981 to 1983) and then worked as an assistant to the Federal Supreme Court (1985 to 1988). He was appointed to the Court of Appeal at Karlsruhe in 1989, before his

appointment in 1996 as a Federal Judge and member of the Bundesgerichtshof, thereafter becoming the Presiding Judge of the First Civil Chamber (Intellectual Property, Unfair Competition).

Since retiring from the Court in 2014, Dr Bornkamm continues to be involved in IP arbitration and litigation in an advisory role. He is a member of the Advisory Committee on the Appointment of Judges of the Unified European Patent Court, member of the Board of Directors and the Executive Committee of the German Association for the Protection of Intellectual Property (GRUR) and member of the Board of the German-British Lawyers Association.

Dr. Bornkamm has taught intellectual property and competition law for a number of years, receiving an Honorary Professorship at the University of Freiburg in 2000. In 2013, he was awarded an honorary doctorate (Dr. iur. hc) from the University of St. Gallen and was awarded the Lifetime Outstanding Achievement Award in Intellectual Property by *Managing IP Magazine* in 2016. He continues to author publications on intellectual property law, as well as competition and antitrust law, including Köhler/Bornkamm/Feddersen, *Wettbewerbsrecht* (36th ed., 2018), and is co-editor of a number of IP journals including GRUR.

Professor Hugh C. Hansen

Professor of Law and Director, Fordham University School of Law, Intellectual Property Law and Policy Institute Fordham Law School.

Professor Hansen has taught intellectual property law for many years. His focus is on a legal realist understanding of how courts, agencies, congress and the private sector interact with IP law and each other. In the same vein, he founded and directs the Fordham IP Institute and Fordham Conference on Intellectual Property Law and Policy, now in its 27th year, an event which the Director General of the WIPO labelled “the Davos of the IP world.”

After graduation, from Georgetown University Law Center, Professor Hansen clerked for federal judges in the Southern District of New York and Second Circuit. He was also a litigation associate with Dewey Ballantine and an Assistant US Attorney in the criminal division of the Southern District of New York. Since joining Fordham, Professor Hansen has been a visiting professor at Melbourne University and a visiting professorial fellow at Queen Mary University, London. He has also served as lead counsel, consultant or an expert witness in litigation before the USA, UK, German and Polish courts, as well as representing clients in copyright and trade mark matters before DG Competition of the European Commission. He has submitted *amicus curiae* briefs in the US Supreme Court in *Matal v Tam*, 137 S.Ct. 1744 (2017) and *Kirtsaeng v John Wiley & Sons, Inc.*, 568 U.S. 519 (2013).

Professor Hansen is author of *New York Intellectual Property Law* (LexisNexis, 2012) and has edited many other books. He is frequently invited to speak

on IP matters, both at home and abroad, including a US State Department sponsored tour in Japan and Melbourne University sponsored tour of Australia. *Managing IP Magazine* has named Professor Hansen one of the 50 most influential people in IP in the world on multiple occasions and presented him with its Lifetime Achievement Award in 2018. It previously characterised him as an “IP provocateur” and “the ringmaster who pulls together one of the IP world’s must-attend events.” He has also received an award from the Court of Appeals for the Federal Circuit per Chief Judge Michel in recognition of “his contribution to the legal community’s understanding of international intellectual property law.”

Alex Kozinski

Former Chief Judge of the US Court of Appeals for the Ninth Circuit.

Alex Kozinski served as a judge at the United States Court of Appeals for the Ninth Circuit between 1985 and 2017, serving as Chief Judge between 2007 and 2014. He was the youngest federal appeals court judge at the time of his appointment in 1985.

He graduated from UCLA, receiving an A.B. degree in 1972, and received a J.D. degree from UCLA Law School in 1975. Prior to his appointment to the appellate bench, Judge Kozinski clerked for Circuit Judge Anthony M. Kennedy and Chief Justice Warren E. Burger, practiced as an attorney with Forry Golbert Singer & Gelles, then Covington & Burling, was Assistant Counsel in the Office of Counsel to the President, and served as Chief Judge of the United States Claims Court.

Among his notable cases in the field of intellectual property is his dissent in *White v Samsung Electronics America* in which he noted: “Overprotecting intellectual property is as harmful as underprotecting it. Creativity is impossible without a rich public domain. Nothing today, likely nothing since we tamed fire, is genuinely new: Culture, like science and technology, grows by accretion, each new creator building on the works of those who came before. Overprotection stifles the very creative forces it’s supposed to nurture.” Kozinski is also well known for his special ability to lace humour in to his judgments. In *Mattel v MCA Records*, in regard to a lawsuit filed by MCA Records (the record company of pop-group, Aqua), Kozinski wrote in his concluding remarks: “the parties are advised to chill”. He has written extra-judicially too, including the iconic piece: ‘Trademarks Unplugged’ (1993) 68 *N.Y.U.L. Rev.* 960, based on the text of his Boal Memorial Lecture.

The Hon. Dr Annabelle Bennett A.O. S.C.

Former Judge of the Federal Court of Australia

Between 2003 and 2016, Dr Bennett served as a Judge of the Federal Court of Australia sitting on many intellectual property cases at first instance and

on appeal, and as an additional judge of the Supreme Court of the Australian Capital Territory. Prior to her appointment to the Federal Court of Australia, Dr Bennett practised as a Senior Counsel specialising in intellectual property. She has also served as President of the Copyright Tribunal of Australia, Chair of the National Health and Medical Research Council and as a Presidential Member of the Administrative Appeals Tribunal.

In April 2016, Dr Bennett was appointed Chancellor of Bond University, Queensland, having also served as Pro-Chancellor of the Australian National University. She is an Arbitrator of the Court of Arbitration for Sport; Member of Chief Executive Women; and Member of the Advisory Board of the Faculty of Law at The Chinese University of Hong Kong. She is also the Chair of the Australian Nuclear Science and Technology Organisation and Chair of the Advisory Group of Judges to WIPO. She was appointed an Officer of the Order of Australia in 2005 as well as receiving the honorary degree of Doctor of the University by the ANU in 2011 and an honorary Doctor of Laws from the University of New South Wales in 2016.

Dr Bennett completed her BSc (Hons) and PhD in Cell Biology at Sydney University and later obtained her law degree at the University of New South Wales. Her interest in biological sciences has led to membership of the Genetic Manipulation Advisory Committee, the Biotechnology Task Force, the Pharmacy Board of New South Wales and the Eastern Sydney Area Health Service. In addition she has been a member of the Gene Patenting Advisory Committee of the Australian Law Reform Commission; member of the Advisory Group for the Dean of Medicine at The University of Sydney; Trustee of the Centennial Park and Moore Park Trust; Director of the Sydney Children's Hospital Foundation; President of the Australian Academy of Forensic Sciences; President of Chief Executive Women; as well as a member of the Reference Group for the APEC Women Leaders' Network Meeting 2007 and the Head of Delegation to the APEC Women Leaders' Network Meeting 2008 in Peru.

Shira Perlmutter

Chief Policy Officer and Director for International Affairs at the United States Patent and Trademark Office.

In her current role at the USPTO, Shira Perlmutter serves as a policy advisor to the Under Secretary of Commerce for Intellectual Property and oversees the USPTO's domestic and international IP policy activities; legislative engagement, through the Office of Governmental Affairs; education and training, through the Global Intellectual Property Academy (GIPA); global advocacy, through the IP Attaché Program; and economic analysis, through the Office of the Chief Economist.

Ms. Perlmutter received her A.B. from Harvard University and her J.D. from the University of Pennsylvania. She practiced law in New York City, specializing

in copyright and trade mark matters. Before joining the USPTO, she was Executive Vice President for Global Legal Policy at the International Federation of the Phonographic Industry (IFPI). Prior to that, she held the position of Vice President and Associate General Counsel for Intellectual Property Policy at Time Warner. Ms. Perlmutter previously worked at the World Intellectual Property Organization (WIPO) in Geneva as a consultant on the copyright issues involved in electronic commerce. In 1995, she was appointed as the first Associate Register for Policy and International Affairs at the U.S. Copyright Office. Between 1994 and 1995, she served as the copyright consultant to the Clinton Administration's Advisory Council on the National Information Infrastructure.

Ms. Perlmutter is a Research Fellow at the Oxford Intellectual Property Research Centre at Oxford University. From 1990 to 1995, she was a law professor at The Catholic University of America, teaching various IP law courses. She is a co-author of a leading US casebook, *International Intellectual Property Law and Policy* (LexisNexis, 2008) and has published numerous articles on copyright issues.

Michael Fysh Q.C., S.C.

Former Senior Circuit Judge with responsibility for the Patents County Court in England and Wales; Former Chair of the Copyright Tribunal.

Michael Fysh read Natural Sciences (Chemistry) at Oxford before being called to the Bar by the Inner Temple in 1963. He practised as a barrister for 25 years in the field of intellectual property, and was appointed QC in 1989, and later QC in Northern Ireland (1990), SC in Trinidad & Tobago (1990) and SC in Dublin in 1994. He has been called to the Bar in New South Wales and admitted to practise as an advocate in both India and Pakistan.

Michael Fysh became head of the IP chambers at 8 New Square, Lincoln's Inn in 1993. He was appointed a Deputy High Court judge (Chancery Division) in 1999 and was made Senior Circuit Judge having responsibility for the Patents County Court in England and Wales in 2001. He was also a judge of the Technology and Construction Court and a deputy High Court judge. In 2005, Fysh was appointed Chairman of the UK Copyright Tribunal, retiring from both the Bench and the Copyright Tribunal in 2010, although remaining a Deputy Judge until recently.

Michael Fysh has written extensively on IP, contributing articles to both UK and overseas legal journals. He was author of *Russell-Clarke on Registered Designs* (5th Edition) and editor of the Reports of Patent Cases and Fleet Street Reports for over 20 years. He also authored *The Spycatcher Cases*, *The IP Citator* has been editor of *Butterworth's Modern Law of Patents* (2005 and 2010).

Michael Fysh received an Honorary Doctorate in Laws from the University of Wolverhampton in 2007, became a Fellow of the Institute of Intellectual Property Law at the University of Oxford in 2010 and was elected an Honorary Member

of the UK Chartered Institute of Patent Attorneys in 2012. He is currently visiting Professor at the Indian Institute of IP Law, New Delhi. Having gained accreditation as a CEDR mediator, in 2011, Fysh was appointed president of the UK Chapter of GEMME – the international association of judges and retired judges who are concerned with mediation. In 2014, he was invited to join the team drafting the rules of operation of the Patent Mediation and Arbitration Centre under the Agreement for a Unified Patent Court.