



## David Perkins

### Biography

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**David Perkins** has over 40 years of experience in intellectual property, and prior to joining JAMS International focused his practice on multi-jurisdictional patent litigation, as well as trademark and antitrust issues. He has handled oppositions and appeals before the European Patent office in Munich and references to the European Court of Justice (ECJ) in Luxembourg. He has also acted as counsel and arbitrator in numerous arbitrations involving intellectual property rights.

David Perkins has served in major leadership positions in the intellectual property practice area at international law firms. He was a partner at Clifford Chance from 1975–2003 in which he headed its European intellectual property litigation practice and subsequently at Milbank Tweed's London office 2003–2009. He is the author of many publications, articles, and conference papers on various aspects of intellectual property law disputes and is a frequent participant at international intellectual property conferences. He was a member of the UK Government's Intellectual Property Advisory Committee. He is a Council Member of the Intellectual Property Institute; a founding member of the Intellectual Property Lawyers Organizations; a World Intellectual Property Organization (WIPO) arbitrator; and a member of all major intellectual property associations. He is also an instructor for WIPO's annual Arbitration Workshop.

### Areas of Expertise

- Patent infringement; trademark infringement; copyright infringement; registered design infringement
- Trade secret, confidential information litigation
- Disputes concerning agreements involving intellectual property rights
- The European Union competition and TRIPs aspects of disputes involving the above subject matter; Oppositions and Appeals (European Patent Office)
- References to the European Court of Justice in patent and trademark matters; International arbitrations of IPRs
- IT outsourcing

### CONTACT

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### SPECIALTIES

Arbitration;

Competition;

Information Technology;

Intellectual Property;

Mediation;

Sports, Telecoms, Media & Entertainment;

### LOCATION

[London](#)

[New York](#)

*Available Worldwide*

*Named Senior*

*Statesman (patent*

*litigation) Chambers &*

- Telecommunications

*Partners, 2014*

## Experience in Mediation

- Mediation of a potential High Court dispute involving a patent license agreement in the medical devices sector
- Mediation of a multinational trademark dispute - including proceedings in a U.S. District Court, the English High Court, and over 20 international Trademark Offices/Courts - involving two U.S. based multinational corporations
- Mediation of trademark and passing off proceedings in the Patents County Court between a Canadian company and a UK company
- Mediation of trademark and passing off proceedings in the High Court between two UK entities
- Mediation of a dispute involving two arbitrations between U.S. and German entities - one under AAA Rules and the other under ICC rules - resulting from patent litigation in the United States and other jurisdictions
- Mediation of High Court (Patents Court) patent infringement case between a German company and a United Kingdom company
- Trademark dispute between two multinational telecom providers - one from the United Kingdom and the other from Asia Pacific
- Patent license dispute between two U.S. companies and a Danish company - first mediation in London (2008) and second mediation in Geneva (2012)
- Significant involvement in advising on the use of ADR techniques for approaching multi-jurisdictional disputes involving intellectual property rights
- Counsel in numerous mediations involving patents and trademarks

*IAM 1000 The World's Leading Patent Practitioners - Named a "Luminary, 2013 "*

*Chambers Global: The World's Leading Lawyers for Business for Intellectual Property: Patent Litigation (Senior Statesman): UK, 2013*

*Chambers UK - Recommended for Intellectual Property: Patent Litigation, 2013*

*The Legal 500 UK - Recommended for TMT: Intellectual Property, 2012*

*Chambers UK: A Client's Guide to the UK Legal Profession for Intellectual Property: Patent Litigation, 2012*

*PLC Which lawyer? Yearbook - Recommended for Life Sciences: Patent Litigation, 2011*

*PLC Which lawyer? - Recommended for Life Sciences: Patent Litigation, 2012*

*PLC Which lawyer? - Recommended for IP: Patent Litigation, 2012*

*The International Who's Who of Life Sciences Lawyers, 2011*

*The Legal 500 UK for TMT: Intellectual Property, 2011*

## Experience in Arbitration

- Hong Kong International Arbitration Centre (HKIAC), panel member
- Kuala Lumpur Regional Centre for Arbitration (KLRCA), panel member
- WIPO Domain Name Panellist, 1999 to date
- WIPO Arbitrator, 2003 to date
- Sole Arbitrator in an LCIA arbitration relating to a dispute involving patent entitlement/ownership
- Sole Arbitrator in numerous (approx. 150) proceedings under the UDRP, 1999 to date
- Sole Arbitrator in ICC Arbitration in relation to gTLDs-Current
- Sole Arbitrator, Independent Film & Television Alliance (IFTA), 2013
- Sole Arbitrator in WIPO Expedited Arbitration proceedings regarding a patent license between an Asian inventor and a US manufacturer and involving the alleged infringement and validity of US and European patents: 2003-2005
- Instructor at WIPO Workshop for Arbitrators: Geneva, Singapore and Seoul, 2002 to date
- Instructor at meetings of the Singapore Intellectual Property Office (SIPO) and SIAC in association with WIPO, 2009 to 2012
- Instructor at meeting of The Philippines Patent Office in association with WIPO, Manila, 2011
- Instructor at WIPO Workshop on Domain Name Resolution, Geneva, 2002
- Counsel for Hughes Simulation in a non-binding ADR of a patent infringement involving flight simulators
- Counsel in 2 ICC arbitrations currently (2009) in London
- Counsel in 3 potential LCIA arbitrations: 2009

- Counsel in ICC arbitration in the energy sectors: 2007-2008 (New York)
- Counsel in mediation of a multi-jurisdiction patent dispute in the biotech area: 2007 (Paris)
- Counsel in three arbitrations involving intellectual property rights and also in non-IP contractual disputes
- Counsel in multi-jurisdiction trademark dispute involving parties in both Banking and IT industries: 2006 (Zurich)
- Counsel for major international manufacturer of medical/analytical apparatus in mediation of patent infringement proceedings: 2005 (London)
- Counsel for major confectionery manufacturer in mediation of trademark infringement proceedings: 2003
- Counsel for PPG Industries Inc. in three arbitrations with Pilkington plc concerning alleged breach of licence agreement and unauthorised use of trade secrets, confidential information and assisting US counsel in a fourth arbitration between the same parties concerning US Antitrust issues, 1985-1995. The first arbitration in London involved a hearing of over 270 days

## Representative Matters

- Acting for Thetford Corporation in ECJ proceedings involving exercise of national patent rights in a non-discriminatory matter (Articles 30 to 36 Treaty of Rome). [Case C-35/87]
- Representing (as Counsel) the European Federation for the Pharmaceutical Industry (EFPIA) in the ECJ in relation to the single Trademark Requirement [Case T-123/00]
- Acted for Catnic Components in House of Lords case establishing the test for evaluation of patent infringement (the Diplock purposive construction test) still applicable under the new law/EPC Article 69 and Protocol; EPC 2000
- Acted in major cases involving assessment of damages in patent infringement proceedings
- Acted in major trade secret/confidential information arbitration and related subsequent US Anti-Trust arbitration concerning the same technology
- Acted for Lenzing AG in notorious Judicial Review proceedings seeking reinstatement of Lenzing's EP (UK) following revocation of the EP by an EPO Board of Appeal. Applicability of Art. 32 TRIPS
- Advising International Industry Groups and the EC Commission on TRIPs in relation to Competition/Anti-Trust Law issues concerning IPRs
- Appearing as Expert Witness for major companies in U.S. litigation involving patent and trademark issues

## Lexis Cases

- **Copyright: Designs**
  - *Interlego AG v. Tyco Industries Inc.* 1989 1 AC 217 (PC)
  - *Interlego AG v. Alex Folley (VIC) Pty Ltd* 1987 FSR 283
  - *Spesi SA v. Benrose UK Ltd.* 1986 (HL)
  - *Granby Marketing Services Ltd. v. Interlego AG* 1984 RPC 209
  - *O'Neil & Others v. Paramount Pictures Corp.* 1983 (CA)
  - *Apple Computer Inc. v. Sirtel (UK) Ltd.* 1983
  - *Rank Film Distributors & Ors v. Video Information Centre* 1982 AC 380 (HL)
  - *Roban Jig & Tool Co. Ltd. & Anor v. Taylor & Ors* 1979 FSR 130 (CA)
  - *Benchairs v. Chair Centre* 1972 FSR 397; 1974 RPC 429 1973 FSR 123

(CA)

- **Trademarks: Passing off**

- *Dr Karl Thomae .v. Commission* [Case T-123/00] [2002] ECR II-5139
- *Sears Plc. v. Sears, Roebuck & Co.* 1993 RPC 385 (CA)
- *Rowntree MacIntosh Ltd's Trademark Application* (1983), but reported 1993 RPC 217
- *Mars (GB) Ltd. v. Country Petfoods Ltd.* (1987)
- *Mars (GB) Ltd. v. Cadbury Ltd.* 1987 RPC 387
- *Lego System AB v. Lego M Lemelstrich Ltd.* 1983 FSR 155
- *American International Group Inc. v. London American International Corporation Ltd.* 1982 FSR 441

- **Patent**

- *ImClone/Aventis v. Yeda* [2006] EWHC 160 (CH); [2006] EWCA Civ. 1094 and [2007] UK HL 43
- *Nokia Corporation v. InterDigital Technology Corporation* [HC 04C0 1952 and HC 05C0 2026]
- *Danisco v. Novozymes* [HC 10 CO 2358]
- *Lenzing v. Courtaulds* 1997 RPC 245
- *Becton Dickinson v. Greiner* [PAT 03092]
- *Strix v. Otter Controls* 1995 RPC 607
- *Rediffusion Simulation Ltd. v. Link Miles Ltd.* 1992 FSR 195
- *Re Kaken Pharmaceutical Co. Ltd's Patent* 1990 RPC 72
- *Intel Corporation v. General Instrument Corporation* 1990
- *Thetford Corporation v. Fiamma* 1987 FSR 244 (CA) and 1987 3 CMLR 266 (CA) and 1990 1 WLR 1394 (ECJ)
- *Schering Agrochemicals v. ABM Chemicals Ltd.* 1987 RPC 185
- *Pharmacia v. Stuart Ltd.* (1986)
- *Unilever Plc v. Pearce* 1985 FSR 475
- *Schering AG v. Hickson & Welch Ltd.* (1985)
- *The Upjohn Company v. T. Kerfoot & Co. Ltd.* 1985 FSR 1
- *PCUK's Application* 1984 RPC 6
- *Farmos v. Wellcome Foundation* 1984 (CA)
- *Catnic Components v. Hill & Smith Ltd. (Enquiry)* 1983 FSR 512
- *Catnic Components v. C Evans & Co* 1983 FSR 401
- *Hickman v. Andrews* 1983 RPC 147 (CA)
- *Catnic Components Ltd. v. Hill & Smith Ltd.* 1982 RPC 183 (HL)
- *The Boots Co. Ltd's Application* (1981)
- *Mars Incorporated v. PA Management Consultants* (1981)
- *Filmline Corporation v. Rank Film Distributors* (1980)
- *Illinois Tool Works Inc's Patent*: 1975 RPC 98 1975 FSR 37 and 1975 FSR 434
- *Templeborough Rolling Mills Ltd's Application* 1975 RPC 511 (CA)

- **Trade Secrets: Confidential Information**

- 1985-1995 Pilkington Plc: PPG Industries Inc: Three UK Arbitrations
- *Kitechnology BV v. Unicor GmbH* 1994 (CA)

## Publications and Lectures

- Speaker and Panellist: Fordham University School of Law Annual Conferences on Intellectual Property Law & Policy, New York and Cambridge, 1992-2012

- UNION Munich Round Table-"Insufficiency: a new graveyard for patents?", Munich, 24 February 2012
- UNION Autumn ExCo Meeting, Vienna-"The proposed EU Unified Patent Court", 28 October 2011
- Premier Cerle-Brussels IP Summit 2010 Arbitration/Litigation: a Choice Criteria Analysis, 2-3 December 2010
- WIPO/KOWI "Co-Ownership, consequences for breach of contract and dispute resolution - an English law perspective" [David Perkins], Negotiating International R&D and Technology Transfer Agreements - IPRs, Valuation and Dispute Resolution, Brussels, 12 November 2010
- WIPO Mediation and Expedited Arbitration Scheme for Film and Media Related Disputes [David Perkins, Speaker/Panellist] World Intellectual Property Organization, Singapore, 3 December 2009
- Panellist at Prague International Arbitration Forum on Resolution of IP Disputes, 23 October 2009
- "International Arbitration in Multinational IP Disputes" [David Perkins] International Bar Association (IBA) 2009 Conference, Madrid, 8 October 2009
- Panellist at Dusseldorf International Arbitration School, 21-25 September 2009
- "Complex Patent Arbitration" [David Perkins] School of International Arbitration and WIPO London, UK, 24 June 2009
- "Arbitration and Mediation" [David Perkins] Management Forum Successful Patent Litigation in Europe, London, 13-14 October 2008
- "Remedies available in Europe" [David Perkins ] 41st Congress of the International Association for the Protection of Intellectual Property [AIPPI] Boston, USA, 6-11 September 2008
- Instructor Singapore-WIPO Sub-Regional Workshop on Arbitration and Mediation in Intellectual Property (IP) Disputes, Singapore, 19-21 August 2008
- "Patent Litigation in Europe: the ADR alternatives" [David Perkins] University of Siena, The Second Step Securing the Competitive Advantage, Siena, Italy 4 - 6 July 2008
- "Contributory Infringement Overview from the United Kingdom" [David Perkins] UNION Porto Congress, Porto, Portugal, 28-29 May 2008
- "Successful Patent Litigation in the UK and Europe" [David Perkins] Management Forum, London Alternative Dispute Resolution and Mediation, 17 December 2007
- "Litigation vs. Mediation: a strategic multi-faceted approach to the selection of the best methods for management and/or settlement of disputes" [David Perkins] Centre for Law and Biotechnology, University of Siena, Siena, 13-15 July 2007
- "When the domain name is identical or confusingly similar to the Complainant's trademark" [David Perkins] Fifth IDRC International Seminar, Seoul, Korea, 18 May 2007
- "Avoid and Manage Patent Litigation: the ADR alternative" [David Perkins] Stockholm, 25 April 2007
- "Patent Trolls: a pejorative or deserved epithet? Examining the phenomenon from both sides" (David Perkins, Chair) for Informa IBC Legal Conferences, London, 8 December 2006
- "Where to Litigate in Europe and how to get there?-Tactical Considerations

- and Practical Strategies" [David Perkins, Chair] 15th Annual International Patent Litigation Conference, Knightsbridge, London, 21-22 September 2006
- "Litigation vs. Mediation: a Strategic Multi-Faceted Approach to the selection of the best methods for management and/or settlement of disputes" [David Perkins] Centre for Law and Biotechnology University of Siena, 14-16 July 2006
  - "Arbitration under the WIPO Rules" [David Perkins] International Law Association-Arbitrating International Intellectual Property Disputes, Toronto, Canada, 4-8 June 2006
  - "Drafting Dispute Resolution Clauses: Options and Common Pitfalls" [David Perkins] WIPO-SIAC Workshop on Arbitration of Intellectual Property Disputes and on WIPO Domain Name Dispute Resolution, Singapore, 10-12 November 2005
  - "The Uniform Domain Name Policy" [UDRP] [David Perkins] WIPO-SIAC Workshop on Arbitration of Intellectual Property Disputes and on WIPO Domain Name Dispute Resolution, Singapore, 10-12 November 2005
  - "Litigation vs. Mediation: a Strategic Approach to selection of the best methods for management and/or settlement of disputes" [David Perkins] Centre for Law and Biotechnology University of Siena, 10 July 2005
  - "Infringement by direct product of patented process: A view from the United Kingdom" [David Perkins] LESI Workshop 4 Munich, Germany, 12-15 June 2005
  - "International Patent Litigation" [David Perkins] John Marshall Law School, Chicago, November 2004
  - "Hot Topics in Intellectual Property Law: Patents (Europe)" [David Perkins] American Bar Association IPL Conference, Toronto, Canada, June 2004
  - "Experimental use Exemption in Europe : a need for clarification" [David Perkins] Fordham University School of Law-Twelfth Annual Conference International Intellectual Property Law and Policy, New York, April 2004
  - "Forum Shopping in Europe-A United Kingdom Perspective" [David Perkins] AIPLA Spring Meeting, Dallas, Texas, May 2004
  - "Intellectual Property and the Essential Facilities Doctrine" [David Perkins and Jay Simon] Licensing Executive's Society [LES], Paris, France, March 2004
  - "European Community Case Law Update on Exhaustion of Rights and Refusal to License" [David Perkins, Marleen van Kerckhove and Christopher Stothers] Practising Law Institute Ninth Annual Institute for Intellectual Property Law, San Francisco, November 2003
  - "European Union Technology Transfer Block Exemption" [David Perkins and Christopher Stothers] Practising Law Institute Ninth Annual Institute for Intellectual Property Law, San Francisco, November 2003
  - "Arbitration of Disputes involving IPRS" [David Perkins] 17th Annual DuPont IP CLE Seminar Wilmington, October 2003
  - "Patent Litigation in the United Kingdom", (David Perkins, Lecturer), Politecnico di Milano, Italy, February 2003
  - "Business Method Patents in Europe", (David Perkins), Cardozo Law School Symposium, New York, November 2002
  - "Patent Litigation in England and Wales", (David Perkins and Justin Lambert), AIPPI United States 2002 Annual Meeting, Washington DC, October 2002

- "Compulsory Licensing in Europe", (David Perkins), "The Future of TRIPs: Impact of the Doha Public Health Declaration", ICC/APLA Joint Conference, Paris, September 2002
- "International Exhaustion of IPRs" (David Perkins-Lecturer), Verona Intellectual Property Center, Italy, May 2002
- "European Patent Law: Recent Developments in EPO Case Law", (David Perkins, Panelist), Fordham University School of Law Tenth Annual Conference on International Intellectual Property Law & Policy, New York, April 2002
- "The Role of Alternative Dispute Resolution in Patent Disputes, (David Perkins), World Intellectual Property Organisation (WIPO), Geneva, March 2002
- "European Community and Intellectual Exhaustion: Shades of Grey", (David Perkins and Marleen van Kerckhove): Practising Law Institute, San Francisco, November 2001
- "Independent Investigations by the Panel, (David Perkins and Alan Limbury), WIPO Domain Name Panelists Meeting, Geneva, September 2001
- "Third Patent System for Europe? (David Perkins), PricewaterhouseCoopers IPLF (Intellectual Property Leadership Forum), California, February 2001
- "The Latest Developments in EU Licensing Law", (David Perkins and Marleen van Kerckhove): Practising Law Institute, San Francisco, November 2000
- "IP Rights on the Internet", (David Perkins) – Chairman, Euroforum, London, November 2000
- "Exhaustion of Intellectual Property Rights", (David Perkins – Speaker and Lecturer), Transnational Perspective on Intellectual Property Law and Communications Law, (Session 381), The Salzburg Seminar, Salzburg, Austria, August 2000

### **Professional Training: Mediation**

- WIPO Domain Name Dispute Resolution Training Program, April 1998
- WIPO Advanced Mediation Workshop, May 1997
- WIPO Training Program on Mediation in Intellectual Property Disputes, May 1995

### **Professional Training: Arbitration**

- Instructor at WIPO Workshop for Arbitrators, Geneva, 2002-2007
- Instructor at WIPO Workshop on Domain Name Resolution, Geneva, November 2002; Session Leader at WIPO Domain Name Panelist Meeting, Geneva, November 2002; WIPO Domain Name Dispute Resolution Training Program, April 1998
- WIPO Workshop for Arbitrators, November 1996
- Diploma Course in International Commercial Arbitration, The Chartered Institute of Arbitrators, London, from October 1995

### **Honours, Memberships, and Professional Activities**

- The Law Society
- City of London Solicitors Company

- Intellectual Property Lawyers Association
- International Bar Association (IBA)
- Chartered Institute of Patent Agents (Associate Member)
- Institute of Trade Mark Agents (Associate Member)
- European Communities Trade Mark Association (ECTA)
- Council Member, Union of European Practitioners in Industrial Property - (Union, British Group)
- International Association for the Protection of Industrial Property (AIPPI)
- International Trade Mark Association (Foreign Member)
- Panel Member, Singapore International Arbitration Centre
- American Bar Association (ABA), (Foreign Member)
- American Intellectual Property Law Association (AIPLA) (Foreign Member), Anti-Trust and ADR Committees
- Intellectual Property Institute (IPI) (Council Member)
- The Intellectual Property Lawyers' Organization (TIPLA) (Council Member); World Intellectual Property Organization (listed as WIPO Mediator/Arbitrator)
- UK Government's former Intellectual Property Advisory Committee (IPAC) (Member)

## Background and Education

- Partner, Arnold & Porter, London, 2009-2013
- Partner, Milbank Tweed Hadley & McCloy LLP, London, 2003-2009
- Partner, Clifford Chance, 1987-2003
- Partner, Clifford-Turner, 1972-1987
- Associate, Theodore Goddard & Co, 1967-1972
- Qualifying Examination Part II, Law Society of England and Wales, 1969
- LL.B., Newcastle University, 1966