

## PROFESSOR SIR ROBIN JACOB

### **My Qualifications and Career**

1. I am the Hugh Laddie Professor of Intellectual Property Law at University College London.
2. From 1960 to 1963 I read Natural Sciences (mainly physics) at Trinity College, Cambridge. I then read for the Bar and simultaneously took a law degree. I was called to the Bar by Gray's Inn in 1965 and graduated from the London School of Economics (of which I have been a Governor for about 20 years) in 1967.
3. After pupillage (the Bar's name for an apprenticeship) I entered practice as a barrister practising mainly but not exclusively in all forms of intellectual property in 1968. I was in the Chambers of Thomas Blanco White QC and succeeded him as Head of Chambers when he eventually retired in about 1989.
4. In 1976 I was appointed by the Attorney-General as the Junior Counsel to the Treasury in Patent matters. This meant that I handled all the Government's intellectual property cases before the courts. I represented the Patent Office in all court proceedings up to and including the House of Lords as well as the UK Government in IP cases before the European Court of Justice. I was also the principal advisor for all Government departments in relation to intellectual property cases.
5. In 1981 I "took silk," that is to say was appointed a Queen's Counsel. I continued in practice at the Patent Bar acting for private clients. In about 1987 I was elected Chairman of the Patent Bar Association (now more appropriately called the Intellectual Property Bar Association). My practice became quite international: I represented clients before the courts of Hong Kong, Singapore and Australia (I am a Queen's Counsel of New South Wales, Australia) as well as the Competition Authority of the European Commission. I often visited the USA to see clients (my first visit was in 1974). In 1987 I was appointed to hear appeals from the Trade Marks Office against refusals to register trade marks and in 1989 I was appointed

Deputy Chairman of the Copyright Tribunal (both of these were part-time only). I continued in practice meanwhile.

6. In 1993 I was appointed a High Court Judge – a position which roughly corresponds with that of a US Federal District Judge. I sat in the Chancery Division, part of which consists of the Patents Court (judges of that court have particular experience in patents). The Chancery Division deals with a wide variety of commercial and property related matters such as tax, company law, insolvency, trusts, wills, land law and probate. It also deals with many contractual disputes, though very specialised types of contract cases such as insurance or shipping contracts, generally international in nature, are taken by the Commercial Court which forms part of the Queen’s Bench Division.
7. Intellectual Property cases are assigned to the Chancery Division. From the outset of my judicial career, I heard and decided many such cases. I have never counted their number but it must run into several hundreds in all aspects of intellectual property law. A search in the BAILII (British and Irish Legal Information website, [www.bailii.org](http://www.bailii.org) website under the name “Mr Justice Jacob” produces 690 results. These are not all my decisions for the results will include decisions of other courts which refer to my first instance judgments. However most of my first instance judgments will be there. Early ones may be missing because pre-internet ones are not on the BAILII database. A significant proportion of those cases are intellectual property cases.
8. From 1997 to 2001 I was the Supervising Chancery Judge for Birmingham, Bristol and Cardiff which meant I was in charge of Chancery matters in those cities and their associated Circuits and heard the most important cases there. From 1995 until that assignment and thereafter I was the Judge in Charge of the Patents List.
9. In 2003 I was appointed a “Lord Justice of Appeal,” the formal title of a judge of the Court of Appeal of England and Wales. From then until I decided to leave the court to take my present Chair in May 2011 I was in charge of the Intellectual Property List and sat on nearly all IP cases in the Court of Appeal. A BAILII search produces 504 results. Again not all these are my judgments but I estimate that about half are.

10. Apart from intellectual property cases I also heard and decided (or in the Court of Appeal helped decide) a great range of other types of civil dispute including commercial contract disputes, insolvency and company law cases. I estimate that overall about 40% of my judicial work was in intellectual property and the 60% spread over these other types of dispute, mainly of a commercial nature.
11. I should perhaps explain my official titles. Every male High Court Judge is knighted. Lady High Court Judges are made Dames of the British Empire and every Lord or Lady Justice is made a member of the Privy Council (the Sovereign's private council – now largely symbolic but in ancient times in effect the government). The term “Right Honourable” means membership of the Privy Council.
12. In early 2011 the opportunity of my present Chair came up. Although I could have stayed in the Court of Appeal for another 5 years (when I would have reached 75) it struck me that here was an opportunity for a new career and challenges. So, with some reluctance, for I was very happy there, I retired from the Court. Fortunately I continue to sit there from time to time. It is not quite the same as taking “senior status” in the US. Some English retired judges (who, is decided by the Lord Chief Justice) are asked back on a daily ad hoc basis. I do two or three weeks sitting a year, not necessarily in IP cases.
13. I have done many things in the law extra-judicially. In about 1987 I was made a “Bencher” of Gray's Inn, one of the four Inns of Court. The Benchers are the governing body. I was Treasurer of the Inn in 2007 (“Treasurer” was the name given in mediaeval times to the head of an organisation). In 2011 my fellow European Judges elected me President of the Intellectual Property Judges' Association, an association of European patent judges. I am regularly consulted on IP matters by the UK government and the European Commission. In particular I am Chairman of the Advisory Panel to the Preparatory Committee for the Unified Patent Court (the main function of which is to advise on judicial appointments and training), a member of the Preparatory Committee's Expert Panel, and a member of the European Commission's Expert Group on the development and implications of patent law in the field of biotechnology and genetic engineering.

14. I have written extensively on all aspects of Intellectual Property Law as well as other legal subjects. There is rather a lot of this. Attached hereto is a list of most of my publications. It is not complete – I have not been that astute to check which lectures have been published and not.
15. I am also a regular attender and lecturer at conferences. In 2012 for instance I gave a lecture in Singapore (addressing the Asian Patent Attorneys' Association), Oxford University (conference about the Common Law of Intellectual Property), a conference in Zurich for INGRES (an association of Swiss IP lawyers) and Basel (the Hoffmann-La Roche lecture), a conference in Brussels organised by OpenForum Europe, another conference in Oxford concerning the Max Planck study of the European Trade Mark system, a trade mark conference in Nijmegen, Holland at the Radbooud University, the annual meeting of the Association of Law Teachers (of which I am President) in Oxford, the Fordham Annual Intellectual Property Conference, an all-day meeting in Columbia University with co-authors of a book for which I have written a chapter on copyright and parody (published in about July 2013), the Managing Intellectual Property Conference in London (in 2012 the magazine awarded me its lifetime achievement award), a conference in Brussels organised by the European Commission concerning possible amendment of the Directive on the Enforcement of IP Rights, the European Patent Judges' Symposium in Dublin, meetings with the highest court in Shanghai and the Supreme Court of China in Beijing, a meeting about "patent thickets" of the Economic and Scientific Advisory Board (of which I am a member) of the European Patent Office and a joint meeting of European Patent Judges and patent practitioners in Venice.

16. In 2013 I, inter alia:

Attended a meeting of ETSI to present my views on FRAND dispute resolution – essentially saying they should be resolved by expert arbitral panels rather than courts;

Taught at Melbourne University for a week;

Attended the Conference in Alicante held by the Office for the Harmonisation of the Internal Market on the 10<sup>th</sup> anniversary of the European Design Registration system, chairing one of the sessions;

Helped (with 2 Dutch judges and a Dutch practitioner) teach a symposium on patent law in Bucharest;

Co-Taught on the MIPLC international patent law course in Munich with Professor Martin Adelman and Chief Judge Rader of the CAFC;

Attended a major one day conference on the so-called “smart phone” wars and FRAND in Brussels, chairing the Judges’ panel;

Attended a similar conference in Rome, chairing the judges’ session;

Attended the ATRIP (International Association for the Advancement of Teaching and Research in Intellectual Property) conference in Oxford, chairing one of the sessions.

Co-hosted the GSMA IPR Summit meeting in Shanghai associated with the Mobile Asia exhibition;

Spent a week in Djibouti advising the Government about the creation of a special court for its port (the largest in East Africa) and Free Trade Zone, a court to be governed by English Law.

Lectured at the Polytechnico di Milano;

Attended the Judges and Lawyers’ Patent Symposium in Venice organised by EPLAW;

Lectured in Copenhagen on the invitation of the Danish Patent Office.

17. In 2014 I inter alia:

Attended several meetings of the European Commission Biotech and Patents Expert Advisory Panel and also of the European Patent Office Economic and Scientific Advisory Board;

Took part in a debate about the conflict between patent law and competition Law organised by the Commercial Law Society of Dublin;

Attended a major conference about Patents and Telecoms organised and hosted by Qualcomm in San Diego;

Gave a major trade mark lecture at the biannual Symposium of the Federal Patent Court of Germany;

Taught for a week at respectively the Hebrew University of Jerusalem and the Max Planck Institute in Munich;

Attended the Fordham IP Conference (being on several Panels);

Chaired a mock trial about amendment of patent in Milan;  
At the request of a Spanish Judge given a lecture in Madrid on the forthcoming Unified Patent Court of the EU;  
Sat for three weeks in the Court of Appeal;  
Given written expert evidence on a matter in Japan;  
Attended the EU Commission Expert Committee on the working of the Biotech Directive several times;  
Attended several meetings of the European Patent Office's Scientific and Advisory Board  
Organised in association with ETSE, GSMA and George Washington University a major symposium on patents and telecoms in Washington DC;  
Lectured to the Danish Competition Law Society;  
Attended meetings of the European Patent Judges in Tallin and Venice;  
Attended a European Commission unit discussion of Standard Essential Patents and Competition Law in Seville;  
Sat as a Chairman of a panel of judges in a mock-trial at a pharma patent conference in Amsterdam;  
Attended a Trade Mark Symposium at Erasmus University, Rotterdam;  
Gave a keynote talk at the Cravath IP Institute in New York

18. In 2015 I have inter alia:

Attended a major IP conference at the Tokyo University of Science;  
Spent 2 weeks at the University of Auckland as a the Legal Research Foundation Scholar, lecturing and meeting the NZ Judges of the High and Supreme courts.  
Spoke at the Fordham University IP Symposium in Cambridge England;  
Taught at the Munich Intellectual Property Centre;  
Attended Oxford University's 2-day Trade mark Scholar event.  
Attended the Dutch Trade Mark Law Institute in event in Leiden  
Organised with George Washington University Washington DC, ETSI, ITU and GSMA the most important patents and telecoms conference in the world.

Attended several meetings of the European Commission's expert group on the working of the Biotech directive;

Given a lecture on pharma patents at the University of Durham

Chaired the Advisory Panel on the appointment and training of judges of the future European Unitary patent court

Taught at the Munich Intellectual Property Centre

Taught at CEIPI, Strasbourg, prospective candidates for the position of technical judge of the future European

Supervised Nokia's compliance with its FRAND obligations on behalf of the Chinese competition authority, MOFCOM

Sat a few times in the court of Appeal

Conducted a mock trial before the notional new court in Berlin

Attended the IBA conference in Vienna

Attended the Venice patent judge and practitioner conference.

19. I organise symposia on important IP topics at UCL. Thus I have mentioned the patents and telecoms symposium. Others I can mention are a major conference on protection for second and further medical indications sponsored by both a big pharma and a generic company. Jointly with the University of Washington Seattle and the Gates Foundation this will be followed up by another such conference in December 2015. In 2012 UCL also had the first ever conference specifically on the subject of how courts do and should receive expert evidence. There were reports from 9 different European countries, the US (Judge Sharon Prost gave the keynote speech) and experts who had actually given evidence in a number of jurisdictions (and two who had acted as scientific advisor to the court) spoke of their views of the experience. Then there is "Ask the Judges" at which judges from different levels of the trade mark system discuss questions sent in by the audience. In October 2015 the Judges were an ex Judge of the European Court of Justice General Court, a former

Judge of the German Trade mark court, a senior Hearing Officer of the UK Trade Marks Registry and the Senior Appointed Person.

20. I also do expert witness work for proceedings in other countries (the USA, Japan, Canada, Malta, India, the European Trade Mark Office and France). I have appeared as an expert witness on English law in a New York arbitration. I have conducted a number of mediations. I was an ICC appointed panellist for “community objections” to top level domain names and am a panel member of the SIAC, the LCIA and the KLRC. I undertake a certain amount of advisory work provided it is compatible with the other work I do.
21. I have been appointed by the Chinese Competition Authority (MOFCOM) as one of two “Trustees” to monitor the compliance of Nokia of its commitment to MOFCOM not to change its licensing policy under its Standard Essential Patents, a requirement of MOFCOM’s approval of Nokia’s sale of its mobile phone handset business (but not the relevant patents) to Microsoft.
22. Finally I do work as an arbitrator. Two cases have gone to final awards (one in Switzerland and one in Malaysia). Others have settled on the way.





## Books

Sole author "IP and other Things" Hart, 2015

In collaboration with others

- A Guidebook to Intellectual Property (6 editions from 1970 to 2014)
- Kerly's Law of Trade Marks and Trade Names (1972, 1983 and 1986 editions, editor; 2001, 2005 and forthcoming editions, consulting editor)
- Encyclopedia of UK and European Patent Law (from 1977 onwards)
- The White Book (once the Supreme Court Practice, now Civil Procedure) Sweet and Maxwell, editor of sections on intellectual property for many years from 1970 to 1993, Supervisory Editor thereafter.
- Bullen & Leake & Jacob Precedents of Pleadings for many editions author of the various parts concerned with Intellectual Property, currently Consulting Editor
- Atkin's Court Forms. Editor of the sections concerned with Intellectual Property in the 1970s and 1980s

## Articles and Lectures

- Information Problems and the Law, The Information Scientist, March 1972 p.3
- The Protection of Geographical Indications of Origin in the UK, chapter in Protection of Geographic Denominations of Goods and Services, ed. Prof. Herman Cohen Jehoram, Sijthoff & Noordhoff, 1980.
- The Herschel Smith Lecture 1993, [1993] EIPR 312
- Novelty of Use Claims, IIC (1996) Vol 27 170 (also published in German GRUR (1996) Vol 45 p.1091), a paper for the 7th Symposium of European Patent Judges
- The Stephen Stewart Memorial Lecture: Industrial Property – Industry's Enemy? [1997] I.P.Q. 3
- European Patent Procedure, a paper for the 1997 Fordham University Law School IP conference
- When is a trade mark not a trade mark? for the 1997 Fordham University Law School IP Conference
- The Harmonisation of Patent Litigation, a lecture given to the Dutch AIPPI Group in Zeist Holland, March 1997, [1997] I.P.Q. 142
- Some Recent Cases of Significance in the UK, IIC (1997) Vol 28 880 (also published in German, GRUR Int 1/98) a paper for the 8th Symposium of European Patent Judges
- Community Intellectual Property Law in the English Courts, Chap. 15 of European Community Law in the English Courts, ed. Andenas and Jacobs, Clarendon Press, 1998
- Towards a European Civil Procedural Code? The 27th Lord Upjohn Lecture, (1998) The Law Teacher, 125
- The future shape of the judicial system in Europe a paper for the Ninth Symposium of European Patent Judges, Special Edition of the EPO Journal. 1999 p.114
- Objectionable Narrowness of Claim, a "Side Bar" in Principles of Patent Law, Chisum et al., Foundation Press New York, (1999) also published in [1999] EIPR 40 along with subsequent correspondence
- Decisions relating to patents granted by the EPO in Great Britain and Germany, (1999) VPP-Rundbrief 13
- Scope of patents in the UK - is there a doctrine of equivalents? for the AIPPI, Symposium, Helsinki, March 1999, published in Nordiskt Immateriellt Rättsskydd
- Can European Patent Specifications be Safely Shortened?, a paper for the FICPI conference, The Hague July 1999
- International Intellectual Property Litigation in the Next Millennium, The 1999 Deioma lecture, Case Western Reserve University, Cleveland, Ohio, Case Western Reserve Journal of International Law (2000) vol. 32 p.507
- Intellectual Property in the new Millennium The Inaugural Presidential Address of the Shepherd and Wedderburn Centre for Research in Intellectual Property and Technology, Edinburgh, 1999
- The Community Patent or a European Patent Court? Is it time to Chose?, for the 2000 Fordham University Law School IP conference
- Trade Marks and the Olympic Games throughout the Years, Marques Conference: Athens August 2000, [2001] EIPR 1
- In Honour of Rudiger Rogge, Festschrift für Rudiger Rogge zum 65. GRUR, October 2001
- The Onward March of Intellectual Property Rights and Remedies, Chap. 17 of Expanding the Boundaries of Intellectual Property, OUP 2001
- The Grays Inn Reading, June 2002, Gresham College

- Thoughts on Insolvency Practitioners and Expert Witnesses, a paper for the R3 Conference, Malaga, May 2003, *Insolvency Law and Practice* (2003) Vol. 19 143
- My Dad and Gray's Inn, (2002) 114 *Graya* 41
- Law and the Human Genome Project, a paper for the Washington University in St Louis, Missouri, Symposium, 2003, *Perspectives on properties of the Human Genome Project*, ed. F. Scott Kieff, Elsevier/Academic Press, 2003.
- Creating the Community Patent and its Court, an essay in *Intellectual Property in the New Millennium, Essays in Honour of William Cornish*, (2004) Cambridge p.79
- The Perfect Patent Court, an essay in ...".. und sie bewegt sich doch!" *Patent Law on the Move*, a Festschrift for Gert Kolle and Dieter Stauder, Carl Heymanns Verlag (2005) p. 313
- The Globalisation of Copyright, for the 12th Biennial Copyright Law & Practice Symposium, Sydney, November 2005. *Copyright Reporter* (2006) Vol 24 p.10
- Interpretation of Claims and the Doctrine of Equivalents, for the 13th Symposium of European Patent Judges, 2006, Special Edition of the *EPO Journal*, 2007 p.138
- European Patent Litigation: Out of the Impasse? With Prof. Anthony Arnall, [2007] *EIPR* 209
- National Courts and the EPO Litigation System an essay in *Festbeiträge für Rudolf Teschmacher zum 65*, (2008) *GRUR Int* 658
- Monopolist v Antimonopolist: A never ending story: The Burrell lecture 2008
- Recent Patent Cases in England and Wales, for the 14th Symposium of European Patent Judges, Special Edition of the *EPO Journal*, 2009, p.139
- Woolly Lines in Intellectual Property Law, an essay in *Patents and Technological Progress in a Globalized World*, Liber Americiom Joseph Straus, Springer (2009) p. 781
- Experts and Woolf: Have Things Got Better?, an essay in *The Civil Procedure Rules Ten Years On*, ed. Dwyer, OUP (2009)
- Knowledge of the World and the Act of Judging, the Congr s de La Magistrature, Qu bec City, November 2008, *Proceedings of the 2008 Judges' Conference*, p. 129
- The Chapter on Intellectual Property in *The Judicial House of Lords 1876-2009* ed. Blom-Cooper et al., OUP 2009
- Patents and Pharmaceuticals, a paper given in November 2008 at the Presentation of the Directorate-General of Competition's Preliminary Report of the Pharm-sector inquiry, CIPA December 2008 p. 711
- Forward to *The Common Law of Intellectual Property*, a festschrift for David Vaver, Hart (2010)
- "Raising the Bar: a mistaken Chimera?" Chapter in *Concurrence Sant  Publique, Innovation et M dicament L.G.D.J* lextenso editions (2010)
- Be ye ever so High, a paper given to the First St.Petersberg Legal Forum, May 2011.
- James v Kaney - where next? A paper for the Autumn 2011 Expert Witness Institute Journal.
- IP Law: Keep Calm and Carry On, inaugural lecture, *Current Legal Problems*, vol 66 Issue 1 pp. 379-399
- Patent thickets: a paper for the European Patent Office Economic and Scientific Advisory Board meeting *Journal of Intellectual Property Law & Practice* 2013; doi: 10.1093/jiplp/jps213
- Competition Authorities Support Grasshoppers: Competition Law as a Threat to Innovation, *Competition Policy International* Vol. 9 No. 2 p.15

**Fee rates and contractual terms.**

My guideline rate is 9,500 HKD per hour subject to negotiation and depending on the nature of the work, the time which will be required and the general circumstances of the case.

I generally use the Commercial Bar Association's terms (COMBAR). I am content to accept other contractual arrangements subject to review.