

AA THORNTON

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INTELLECTUAL PROPERTY LAW

# Engineering, Electronics, IT & Communications

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It's our people that make the difference

## About us

We are a leading Intellectual Property firm based in London and Munich. Our team of committed and passionate individuals includes patent, trade mark and design attorneys, as well as litigation solicitors, working with clients across a huge range of technologies and commercial fields. We provide the full range of IP services to clients around the world, from prosecution to litigation, in patent law, trade mark, design and copyright law.

Having an excellent understanding of our clients' industries and the challenges they face is key to us delivering commercial, insightful legal advice. Our highly qualified industry teams are made of attorneys and solicitors who work together to share knowledge and experience. We firmly believe *it's our people that make the difference* and that this sets us apart from others. Simply stated, we speak our clients' technical language!

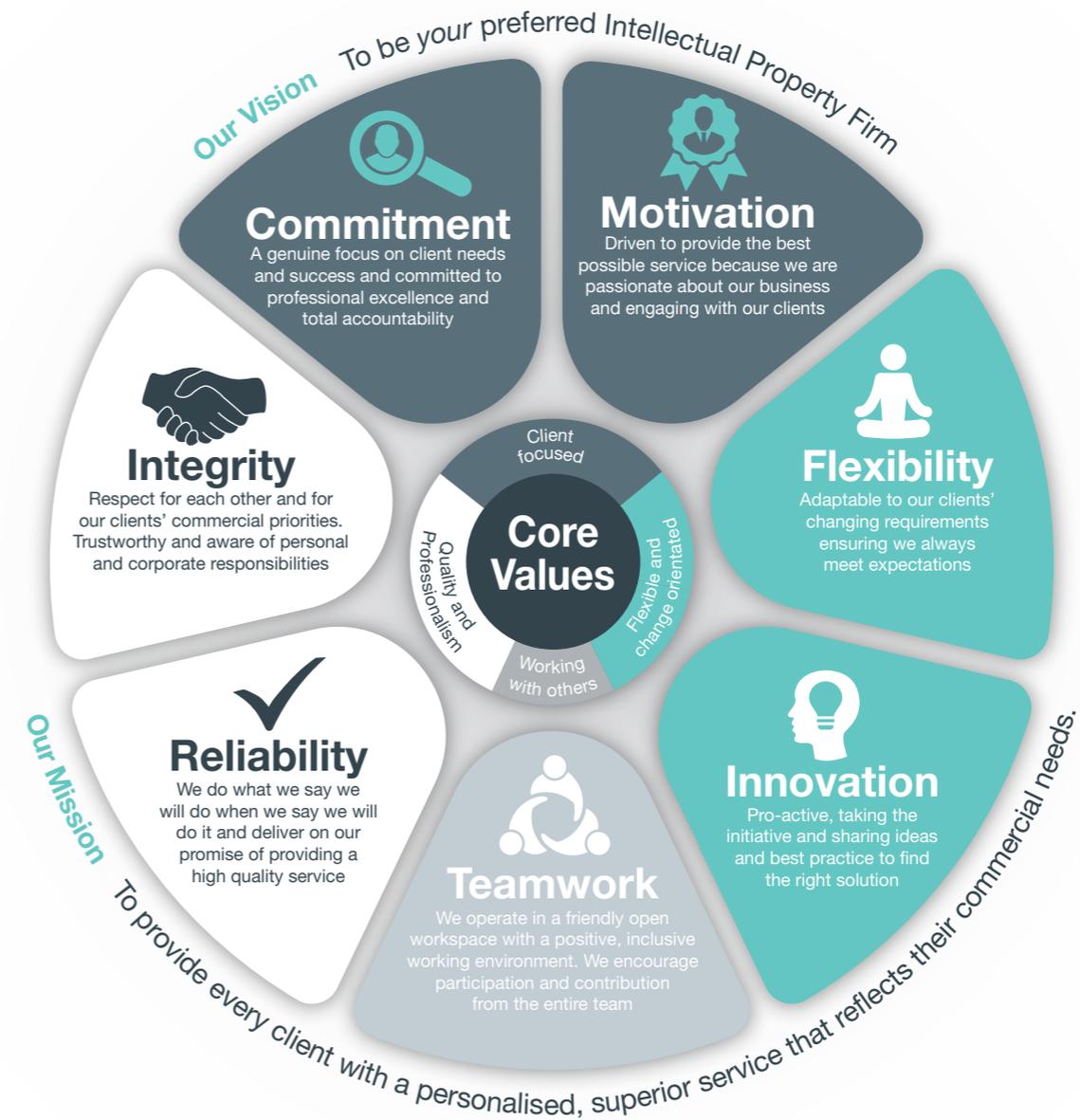
We offer a completely bespoke service at a competitive price. We pride ourselves on our genuine desire to understand the way clients want to work with us, and provide every client with a personalised, superior service that reflects their commercial needs. Our advice is always in-depth, commercial and accessible. We ensure that your inventions, brands and designs are expertly protected and your risks are minimised.

We have a wealth of experience in all aspects of patent law and can advise across a wide and diverse range of *innovations* and technical areas. Whether you are a sole inventor or large corporation, protecting your ideas is vital and we have the leading knowledge to help you. We work seamlessly with legal counsel, R&D, Business Development, Regulatory and Commercial Affairs departments to become an integral part of your team.

Our attorneys and lawyers regularly speak at conferences, and publish articles in leading magazines. We are passionate about innovation and enjoy nothing more than working on new or complex technologies.

Our vision is *"to be your preferred intellectual property firm"*, and we are committed to providing every client with a personalised, superior service that reflects their commercial needs.

## Our values



We are delighted to be involved with IP Inclusive, which is an organisation that promotes diversity and inclusion within the various IP professions. AA Thornton were among the first signatories to the IP Inclusive charter, which is part of our ongoing commitment to improving diversity and inclusion. We take an active lead in IP Inclusive, such as the project to promote careers in IP to schools and universities through the "Careers in Ideas" initiative.

## Our expertise

The firm's Engineering, Electronics, Telecoms & IT patents team enjoys a strong international reputation, and benefits from attorneys with varied professional and academic backgrounds. Our technical expertise encompasses the following areas: aeronautical, electrical, mechanical and chemical engineering, as well as computer systems, software and electronics.

Our UK and European Patent Attorneys have gained in-house experience at [IBM](#), [Canon](#), [British Aerospace Defence Ltd](#) and [Novartis](#), and clients tell us they value our ability to understand issues from their perspective.

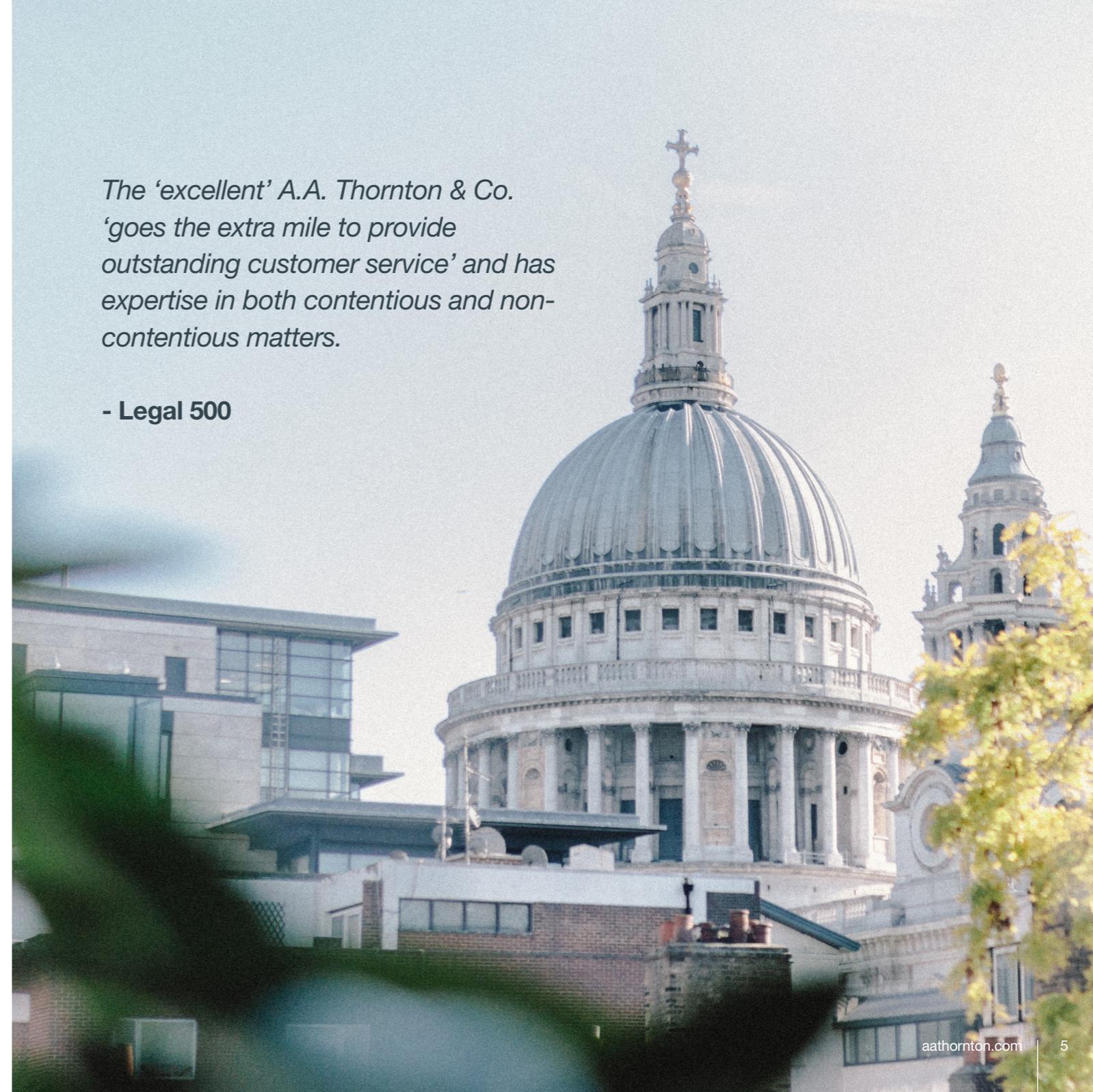
Some of the industry sectors in which we presently work are: IT (including computer systems and software), oil & gas exploration and drilling, gas and fire detection and measurement, consumer electronics and telecommunications.

We have experience in a wealth of technologies including but not limited to:

- aircraft performance and design
- high sensitivity measurement and instrumentation -
- modelling and simulation in complex environments
- vision systems for autonomous vehicles
- electromagnetic sensors
- semiconductors
- electric motors
- medical devices and instruments
- food processing apparatus
- security systems
- communication technologies
- computer-implemented inventions (including addressing European legal challenges)

*The 'excellent' A.A. Thornton & Co. 'goes the extra mile to provide outstanding customer service' and has expertise in both contentious and non-contentious matters.*

**- Legal 500**



## Our key team members



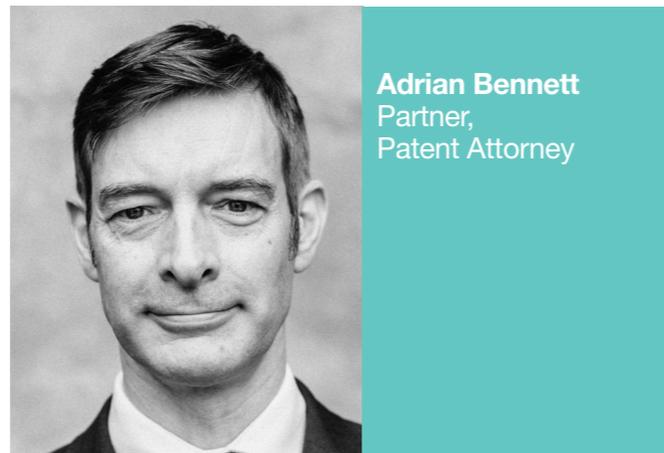
**Mike Jennings**  
Partner,  
Patent Attorney

Mike heads our Electrical Engineering, Electronics, Telecoms & IT patents department. Before joining AA Thornton in 2007, Mike gained many years of experience as an in-house patent attorney for [IBM Corporation](#) as well as experience at other leading IP firms in the UK and Australia.

Mike provides strategic IP advice to a wide range of companies in the fields of computing, electrical engineering, including high sensitivity measurement and instrumentation, and software patentability including modelling and simulation in complex environments, and telecoms and SmartPhone protection strategies. He handles worldwide invention protection, with particular expertise in EPO oppositions and examination and appeal proceedings, and patent prosecution at the UKIPO.

### Mike's clients include:

- IBM Corporation
- Halliburton Energy Services, Inc.
- Spectris plc
- Servomex Group Limited
- Landmark Graphics Corporation
- CK Hutchison Holdings Limited



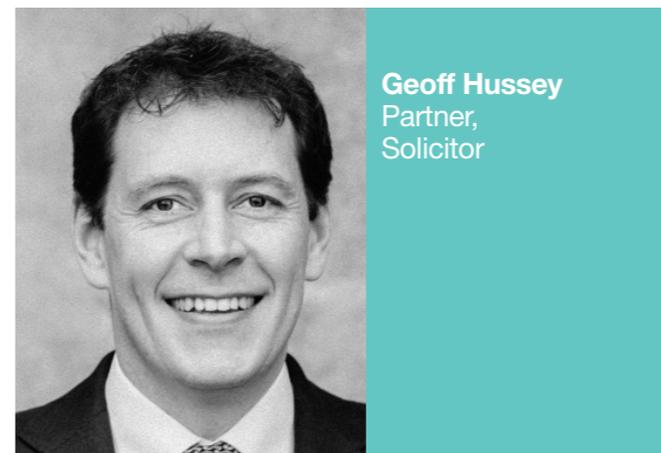
**Adrian Bennett**  
Partner,  
Patent Attorney

Adrian heads our Engineering, Physics and Mechanical devices patents department, and has spent more than 20 years in the patent profession. Adrian also has extensive experience in leading oral proceedings at the EPO and regularly handles these matters, including proceedings before the Examining Division and particularly proceedings before the Opposition Division and Board of Appeal. Other principal areas of work include advising clients in infringement matters, for example by way of Freedom to Operate opinions.

Prior to joining the firm, Adrian worked as an aeronautical engineer with [British Aerospace Defence Ltd](#) for eight years, four of which were spent in the Dynamics Division, and then four in the Military Aircraft Division, and qualified as a pilot.

### Adrian's clients include:

- Bosch
- Halliburton Energy Services, Inc.
- Cipla Limited
- WS Atkins Plc
- DeLaval International AB
- Smiths Group Plc



**Geoff Hussey**  
Partner,  
Solicitor

Geoff Hussey heads our IP litigation and commercial IP department. He acts for a broad range of clients operating across many sectors including electronics, telecoms, medical devices, chemicals, pharmaceuticals, aviation, food & beverages and financial services. Geoff has extensive experience in patent litigation before the UK Patents Court, Court of Appeal, and in EPO patent oppositions. Geoff also regularly handles UK litigation related to trade marks, design rights, passing off, copyright, and breach of contract disputes involving IP. His cases have often included the coordination of parallel proceedings across many jurisdictions in Europe and the US.

### Some of Geoff's notable cases include:

- Acting for [LG](#) in a complex patent dispute relating to blu-ray, DVD and TV technologies against Sony.
- Advising [Nokia](#) in a very large mobile phone patent revocation action against IPCOM; and also representing Nokia in the defence of a case brought by InterDigital in relation to the standard essentiality of 35 Nokia mobile phone patents.



**Nick South**  
Partner,  
Patent Attorney

Nick is a Partner in the firm's Electrical Engineering, Electronics, Telecoms & IT patents department. Nick has over 20 years of experience advising a wide range of clients in patent matters relating to technologies including electromagnetic sensors, semiconductor technology, mobile telecommunications and medical instruments, as well as design registrations and unregistered design rights. He has lectured for the CIPA Patent Administrators course and also writes legal updates on developments in patent law, and has been published in Intellectual Property Magazine.

Before joining the firm, Nick followed his Engineering degree by obtaining a post-graduate certificate in Design, Manufacture and Management, visiting over 100 companies and carrying out projects across a range of manufacturing industries, to gain an insight into different manufacturing practices and commercial issues.

### Nick's clients include:

- Allegro Microsystems LLC
- Nuance Communications, Inc.
- Robert Bosch GmbH
- ZTE Corporation



**Nikesh Patel**  
Partner,  
Patent Attorney

Nikesh is a Partner and UK Chartered and European Patent Attorney in the Electrical Engineering, Electronics, Telecoms & IT patents department and has been practising in the field of intellectual property law for over 15 years.

He directly advises UK and overseas clients on patent matters including identification of patentable subject matter. Nikesh has drafted and prosecuted patent applications in a wide variety of technologies, including computer implemented inventions, in which he has considerable experience in advising on the threshold of patentability in the UK and Europe, and telecommunication inventions relating to 3G and smartphone technology. He also provides strategic advice for SMEs and large multinationals and manages worldwide patent portfolios for his clients.

**Nikesh's clients include:**

- CK Hutchison Holdings Limited
- IBM Corporation
- Landmark Graphics Corporation
- Worldpay Limited
- Secure Meters



**Alex Bone**  
Partner,  
Patent Attorney

Alex is a Partner and UK Chartered and European Patent Attorney in the Engineering, Physics & Mechanical Devices department and has many years of experience, having entered the profession in the year 2000. Alex joined the firm in 2014 following seven years working in-house at [Novartis Pharmaceuticals Ltd](#) where he was responsible for IP support relating to medical delivery devices and packaging projects across the Pharma division. During that time he was also involved in the IP due diligence relating to a number of acquisition and licence deals.

Alex's professional experience covers a broad range of technologies including medical devices and associated formulation technology, oil and gas drilling, food packaging, wind and water turbines, waste treatment and automotive technologies. Alex has considerable experience in advising businesses about IP strategy, including managing freedom to operate risks and the protection of product developments.

**Alex's clients include:**

- Colpac Limited
- Cipla Limited
- Cedo Limited
- Halliburton Energy Services, Inc.
- Bosch



**Dan Byrne**  
Partner,  
Barrister

Dan Byrne is a Partner and Barrister in our IP litigation department who works across the full range of IP rights.

Dan is an experienced litigator in the IP courts and has been involved in a number of cases concerning engineering, electronics, telecoms and IT, most of which have involved complex patents in the highest courts. He acts for a broad range of clients across this sector and has gained insights into the complexities of operating in these spheres, including issues relating to FRAND licensing and standards essential patents. He also has experience of making and substantiating customs notifications in relation to such technologies.

**Some of Dan's notable cases include:**

- Unwired Planet v [Samsung](#) (mobile phones – 2G to 3G handover; part of the wider context of a global FRAND dispute)
- Wobben v [Siemens](#) (method of operating a wind turbine in high winds)



**Simon Spink**  
Partner,  
Solicitor

Simon Spink is a Partner and Solicitor in our IP litigation department. His experience includes acting for clients across a broad range of sectors including electronics, telecoms, diagnostic devices and digital health.

Simon has extensive experience in patent litigation before the UK Patents Court, Court of Appeal, and in the Supreme Court particularly relating to pharmaceuticals and medical devices. His cases have often included the coordination of parallel proceedings across multiple European and Asian jurisdictions and the US. Simon's contentious IP experience also covers design rights, trade marks, passing off, and breach of contract disputes involving IP.

**Some of Simon's notable cases include:**

- Acting for [Philips](#) in a complex patent dispute relating to standardised JPEG image technologies against LG
- Acting for [General Electric](#) in a dispute relating to portable ultrasound equipment against Sonosite, a Delaware based technology company.
- Advising [Qualcomm](#) in a large mobile phone patent action relating to 2G/3G technologies against Nokia.



**Martin Hedges**  
Consulting Attorney,  
Patent Attorney

Martin joined the Mechanical department of AA Thornton in 1993 after completing a BA Honours degree in Engineering Science at Oxford University. He became a Partner of the Firm in 2002 and since 2015 has been actively working as a consultant.

Martin covers a wide range of technological areas including automotive, safety breathing apparatus, pharmaceutical inhalation devices, food processing apparatus, steel manufacture and security systems. Martin's clients range from large multinational corporations to individual inventors. He has experience in patent drafting, filing, prosecution, EPO Oppositions and Appeals, infringement enforcement and defence, and managing worldwide patent assignment projects.

**Martin's clients include:**

- Tyco
- ADT
- BorgWarner
- Bluescope Steel
- Clayton Corporation



**Stuart Greenwood**  
Senior Associate,  
Patent Attorney

Stuart is a European and UK Chartered Patent Attorney in the Engineering, Physics and Mechanical Devices department. Before joining AA Thornton in 2008 to train as a patent attorney, Stuart worked at [Rolls Royce](#) and subsequently [Bentley Motors](#) in the chassis and suspension department, specialising in ride handling analysis and vehicle simulation. Stuart then went on to work for multinational consumer goods company [Reckitt Benckiser](#).

Stuart has extensive experience prosecuting UK, European and overseas patent applications in the fields of petroleum and natural gas exploration, automotive engineering including autonomous driving aids, and medical engineering including medicament dispensing devices.

**Stuart's clients include:**

- Halliburton Energy Services, Inc.
- Bosch
- Cipla Limited
- Colpac Limited
- VWP Waste Processing Ltd
- Run Flat Systems Ltd
- Plus 8 Industries



**Lloyd Palmer**  
Patent Attorney

Lloyd is a European patent Attorney in the Electrical Engineering, Electronics, Telecoms and IT patents department. He advises a broad range of clients on patent matters including on the threshold of patentability for computer-implemented inventions in the UK and Europe.

Lloyd has a background in electronic engineering and undertook postgraduate study in the fields of communications and signal processing. He joined the firm in 2019 following seven years working in-house for [Canon Europe Limited](#) where he gained experience in prosecuting UK and European patent applications on a wide range of technology, including digital imaging in printing and handheld devices, video coding, and wireless technologies.

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“AA Thornton maintains its position among the elite patent practices in the nation, largely based on its frequent successful representation of individuals, academic institutions, SMEs and multinational corporations.”

- Legal 500

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## More about our services and expertise



### Patents

Our patent attorneys have a wealth of experience in all aspects of patent law, and can advise across a wide and diverse range of technical areas.

- Chemistry, Biotechnology & Pharmaceuticals
- Electrical Engineering, Electronics, Telecoms & IT
- Engineering, Physics & Mechanical Devices

Whether you are a sole inventor or large corporation, protecting your ideas is vital. Our European and UK Patent Attorneys can act on your behalf, presenting your case to the UK Intellectual Property Office (UK IPO), the European Patent Office (EPO) and the World Intellectual Property Office (WIPO). Thanks to our network of associates overseas, we can advise on different patent laws and protect or defend you anywhere in the world.



### IP Transactions, Ownership & Licensing

We regularly advise clients in relation to commercialising their IP. When entering into negotiations for contracts involving IP it is important that clients' interests are protected and that the appropriate rights are secured in the transaction.

We have the experience and focus to help guide you through what is a technical legal area to achieve a result that meets your commercial aims for all of your non-contentious IP requirements.

**Our services include:**

- Drafting assignments and licences
- IP contract reviews
- IP due diligence
- IP audits
- Developing IP ownership and licensing structures
- Dispute settlement agreements
- Recording transactions at Intellectual Property Offices



### IP Strategy & Audits

We will work with you to put in place effective strategies for the protection and commercialisation of your IP.

**Our services include:**

- IP audits
- IP due diligence
- IP portfolio management and maintenance advice
- Project reviews to identify potential IP
- Strategy reviews
- IP litigation strategic advice
- Marketplace and competitor surveillance
- Advice on upcoming Unified Patent Court opt-outs
- Parallel imports – advice, reviews, procedures



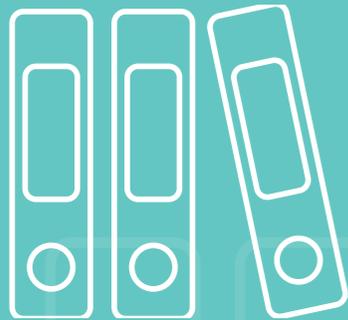
### IP Litigation

Our IP litigation and legal department advises on all aspects of IP law. Our experience and expertise ranges from dealing with small IP disputes (often resolved in negotiation), to hard-fought high-value IP litigation and coordinating parallel actions in other jurisdictions.

Our litigation approach is, where appropriate, for IP solicitors to work closely with our patent or trade mark attorneys to provide a coordinated approach to both enforcement and protection – ensuring the best possible resolution of IP disputes. The strength of our collective technical expertise also ensures that we can understand the necessary complexities involved in each case.

**Our services include:**

- IP portfolio and litigation strategies
- Patent litigation
- Trade mark, copyright and design right litigation
- Arbitration and mediation
- Licensing disputes
- Coordinating with local counsel in parallel actions around the world
- Settlement advice



## Trade Mark, Design & Copyright Portfolio Management

Our patent and trade mark attorneys regularly advise on IP portfolio management, with a focus on alignment with each client's overall corporate objectives and strategy.

We understand the need to review expenditure, IP asset value and portfolio management decisions on a regular basis, and to check alignment with the current business objectives and market conditions. We approach this with a desire to understand your business needs and to provide a solution that achieves your objectives efficiently and cost-effectively.



## IP Due Diligence & Freedom to Operate or Freedom to Use

We have considerable experience advising clients in relation to commercial due diligence activities across the full spectrum of IP rights. Clients value our commercial focus and attention to detail in helping them to evaluate and realise new business opportunities.

**Our services include:**

- IP due diligence for clients seeking to commercialise their own IP
- IP due diligence for clients seeking to acquire third party IP
- Freedom-to-operate or freedom-to-use assessments





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The information in this booklet is general information only and is not intended to constitute legal advice. If you wish to explore protection and associated costs for any of the types of intellectual property discussed, please contact one of our patent, trade mark or design attorneys. December 2019