

# AA THORNTON

INTELLECTUAL PROPERTY LAW

It's our people  
that make the  
difference

Client focused | Collaborative | Professional | Flexible

## Oppositions

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, 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. 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 love brands.* We are passionate about protecting, enforcing and commercialising your trade marks, as well as safeguarding them through dispute avoidance and dispute resolution. We represent clients before the UK IPO, the EU IPO and the WIPO as well as working with an extensive network of established attorneys around the world to provide complete global coverage.

Our team also provides expert advice and services related to design rights, copyright and domain names. We have a wealth of expertise in online enforcement, regularly prosecuting domain name complaints targeted at cyber-squatters. We also have specialist experience in assisting clients with global anti-counterfeiting strategies, even writing the UK section of ‘Anti-Counterfeiting 2018 – A Global Guide’ by the World Trade Mark Review.

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.

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 values



# Our expertise

Across the firm, we have a great deal of experience filing and defending oppositions at the EPO before the Opposition Division and Boards of Appeal, where we enjoy an excellent track record of success. We handle opposition and appeal matters for many of our large corporate clients, who entrust us with high value cases across a wide range of technologies. It is not uncommon for clients to transfer responsibility for opposed patents to us in circumstances where we have not been responsible for prosecuting the underlying application to grant, particularly in cases where the patented invention is of commercial significance.

In the circumstances where an opposed patent is the subject of actual or anticipated parallel litigation proceedings, our patent attorneys work seamlessly alongside our experienced patent litigators (solicitors and barristers) to ensure that our clients' commercial and legal interests are properly safeguarded. In our experience, a collaborative approach works particularly well for patents relating to pharmaceuticals and biopharmaceuticals where cross-jurisdictional disputes are commonplace.

We attribute our ongoing success in opposition and appeal work to a number of factors. First and foremost, we love winning! Our competitive streak drives us to achieve success for our clients and we thrive on “hard-to-win” cases where the stakes are high. We prepare our cases meticulously, leaving nothing to chance, and ensure that our clients' commercial interests are always come first. Our written and oral advocacy skills are second to none and we pride ourselves on offering levels of client service that are unsurpassed in the field.

We are proud to represent the following companies in this area:

- BIAL
- Chevron Phillips Chemical Company LLP
- DeLaval
- Halliburton Energy Services, Inc.
- CIPLA
- LycoRed
- Servomex
- BAE Systems

*“They are really good at oppositions – they are well prepared and bring us up to speed in a clear and helpful way.”*

**Client Testimonial, Chambers & Partners**

## Case study

### Lycopene food colourant patent opposition.

**Teams involved** - Chemistry, Biotechnology & Pharmaceuticals Patent Department

#### The case

Israeli company LycoRed specialise in the research and development of new products and systems based on natural pigments and nutrients, particularly to improve flavour and overall composition and feel in a variety of food applications. LycoRed take protection of their IP seriously and are the owners of a European patent protecting a unique formulation based on the colourant lycopene, used for providing stable red colouring for foods, cosmetics and pharmaceuticals. The stability of the red colouration, particularly under high temperatures such as during cooking of food, is of particular significance. Products containing the invention are widely sold, particularly under the Tomat-O-Red® brand.

The European patent was opposed by multinational BASF, a competitor of LycoRed. A successful opposition could have resulted in a significant reduction in LycoRed's market share. The team at AA Thornton were asked to defend the patent during opposition proceedings at the EPO, owing to our expertise in opposition / appeals.

#### Our input

We successfully defended the patent at the EPO opposition hearing, including maintaining it in completely unamended form. This result was important because it has enabled LycoRed to maintain their position in this market, and has also opened up possibilities for strong licences on favourable terms. Maintaining the patent with unamended claims was essential, because it maintains protection for a number of different, but related, compositions.

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*I would like to say how impressed I was with the way you handled the Opposition case – both the meticulous preparation and your outstanding advocacy skills*

**Dr. Avraham Rutman,  
A.J. Rutman – Patent Attorneys**

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### Case study

DeLaval milking apparatus patent opposition.

**Teams involved** - Mechanical Patent Department

#### The case

DeLaval are specialists in dairy and farming machinery and they are the worldwide leaders in automated milking equipment. Their solutions for dairy farmers make sustainable food production possible, while always focusing on milk quality and the health of the animals involved. DeLaval work with us primarily because of our expertise in handling EPO opposition work. In this case, a DeLaval patent had been opposed by a competitor before the European Patent Office. The patent related to milking apparatus that monitored the wear of exchangeable expendable parts, such as rubber teat cup liners that attach to the teats of a cow. The opponent contested firstly that the patent did not sufficiently disclose how to put the invention in to practice, and secondly that the invention would be obvious to a person skilled in the milking industry. On the face of it, the opponent's arguments were compelling and DeLaval risked losing this important patent.

#### Our input

We used our knowledge and experience of EPO case law and opposition procedure to present a strong defence, and at the opposition hearing the patent was maintained with no amendments. We had convinced the EPO that the patent did indeed disclose the invention in sufficient detail for it to be carried out by a skilled person, and that the invention was not obvious in how it solved the problem of monitoring the wear of exchangeable parts. This was another positive result for our client and another important win which assisted DeLaval in maintaining their strong position over their competitors in the market.

## Meet our heads of department



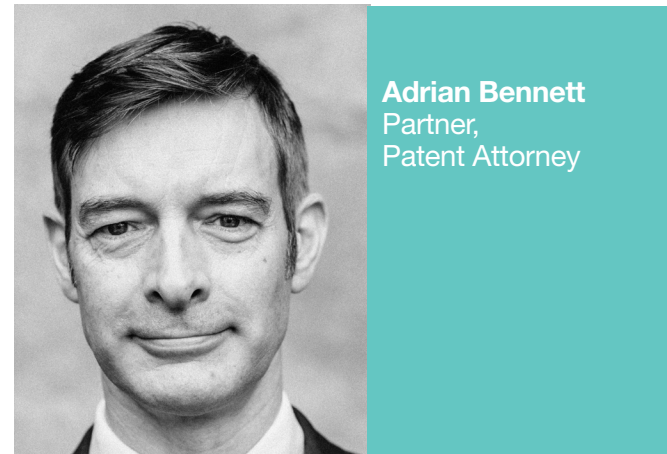
**Craig Turner**  
Partner,  
Patent Attorney

Craig heads our Chemistry, Biotechnology and Pharmaceutical team. He has considerable experience in both EPO patent opposition and appeal work, particularly for pharmaceuticals and medical devices, and in giving freedom to operate advice. He also handles Supplementary Protection Certificates in respect of pharmaceuticals.

Our Chemistry, Biotechnology & Pharmaceuticals team has significant experience in advising on all types of IP issues relevant to the Chemistry, Biotech and Pharma sectors, including patent prosecution, trade mark issues, the interface with regulatory matters, design protection and enforcement, as well as contentious work, including oppositions and litigation. Some of the team have previously worked in-house at [GSK](#) and [Novartis](#).

*"Craig Turner is an absolutely outstanding attorney. He has managed to obtain patent grants in the most difficult (and sometimes hopeless) cases. Craig is an excellent advocate in addition to his more usual, routine patent agent work."*

**Client Testimonial, Legal 500**



**Adrian Bennett**  
Partner,  
Patent Attorney

Adrian heads our Engineering, Physics and Mechanical devices team. His specialist areas of knowledge include fluid mechanics, oil and gas exploration technology, hand-held power tools, engine design, control systems, aerodynamics and aircraft design. Adrian is currently the Chair of the partnership.

Our Engineering, Physics & Mechanical devices team advises across a range of industries including Medical Devices, Automotive, Oil & Gas or Agriculture. Some of the team have previously worked in-house at [Rolls Royce](#), [Bentley Motors](#), [British Aerospace Defence](#), but also [GSK](#) and [Novartis](#).

*"Thanks again (Adrian Bennett) for your brilliant performance today."*  
**DeLaval attorney**



**Mike Jennings**  
Partner,  
Patent Attorney

Mike heads our Electrical Engineering, Electronics, Telecoms & IT team. Mike has vast experience in EPO oppositions and all stages of invention protection, and has an enviable success rate at the EPO Boards of Appeal. His technical expertise is in physics-related technologies including computer-related inventions such as computer simulation and modelling in complex environments. Mike formerly worked in-house at [IBM](#), where he worked across the whole range of IBM's technologies from computer architectures to microelectronics and software. His opposition and appeals work has covered a wide range of electrical technologies.

Our Electrical Engineering, Electronics, Telecoms & IT team includes attorneys with deep knowledge of image processing and communications, electrical engineering and microelectronic systems, computer systems and electronics. The team has considerable experience of advising on patentability in the UK and Europe, including for computer-implemented inventions, as well as both opposing and defending granted patents.

*"Mike Jennings is 'able to solve even the most complex problems with ease'"*  
**Client Testimonial, Legal 500**



**Geoff Hussey**  
Partner,  
Solicitor

Geoff Hussey heads our Litigation team and has extensive experience in patent litigation before the UK Patents Courts and in patent oppositions particularly in relation to pharmaceuticals, medical devices, chemicals and electronics. His contentious practice also covers trade mark and passing off litigation, design right and copyright litigation and disputes involving trade mark licences.

Our Litigation team is friendly and approachable with an open and collaborative working style. 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.

*"Geoff Hussey simplifies everything and makes managing litigation easy for in-house counsel. A strategic, pragmatic and commercially minded lawyer, he knows how to read adversaries and when to apply leverage. Straightforward and easy to work with."*  
**Client Testimonial, Legal 500**



## Case study

Halliburton tilted antenna oppositions and appeals.

**Teams involved** - Electrical Patent Department

### The case

This case relates to a family of high value European patents for inventions that enabled greatly-improved “geosteering” when drilling a borehole for extraction of fluids from a subterranean reservoir. The previous generation of products were unable to maintain a drilling tool within a hydrocarbon-containing layer of a subterranean formation (within the “payzone”) to the oil and gas industry. This technology uses the measurable effects of resistivity on an electromagnetic wave as it propagates through a subterranean rock formation to steer a downhole drilling tool. The inventors proposed using tilted antennae to allow for azimuthally sensitive measurements that identified bed boundaries and helped to avoid undesirable crossing of bed boundaries during drilling.

### Our input

Two original patent applications were transferred to AA Thornton during prosecution from another firm that had not impressed the client. We quickly obtained six European patents with broad claims. Oppositions were then filed by a competitor against four of the European patents. We worked closely with the inventor, in-house IP team and an independent expert to compile evidence and successfully defended two of the patents at first instance oral proceedings (there was no appeal). We succeeded with the other two cases at opposition appeal proceedings in 2019. The applicant was very satisfied with the outcome.

## Case study

Clayton Corporation Aerosol Dispenser Valve patent opposition defence / Germany and the Netherlands Infringement action.

**Teams involved** - Mechanical Patent Department, outside counsel

### The case

US corporation Clayton Corporation specialises in the development and supply of dispensing valves for PU foam dispensing containers, and is one of just two principal players in the market. The other one is Altachem NV. Clayton developed a new dispensing valve which offered significant improvements in preventing the sticking of valves, a well-known, very costly and long-existing problem in the field of PU foam dispensers. Upon grant of the EP Patent, infringement proceedings were instigated in Germany and Netherlands under the patent in partnership with German and Dutch Attorneys, and in response Altachem filed an opposition against the European Patent at the EPO.

### Our input

We played an active role in the infringement proceedings in Germany and the Netherlands. This included taking part in the court hearing before the NL court, and successfully defending the patent at the EPO in the opposition proceedings at oral proceedings which lasted over 12 hours, the patent being maintained in amended form. As a result of the successful defence of the patent at the EPO, Altachem settled the infringement actions in Germany, Netherlands and the US by a settlement agreement which the client was very happy with, removing the uncertainty of the outcome of the litigation, particularly in the US.

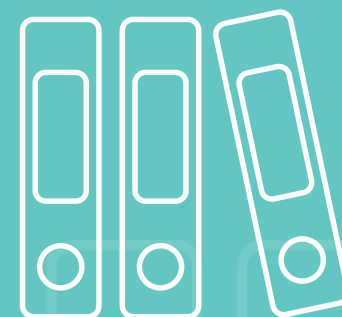
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*‘The team are innovative and creative in their responses on challenging issues in software and telecoms prosecution. They listen to feedback, work to understand the business goals, and then work to create a path to issuance with those elements at the front of their mind. Their success rate and the quality of the claims they obtain is consistently high – an excellent combination.’*

**Client Testimonial, Legal 500**

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## More about our services and expertise



### 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.



### 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 intellectual property (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



## 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 intellectual property (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



Because of our people we are consistently ranked as ‘top tier’ and ‘leading’  
by our peers and clients:

The Legal 500 | Chambers & Partners | WTR 1000 |  
Managing IP Stars | The Financial Times

### Contact us

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**IPINCLUSIVE**

Working for diversity and inclusion in IP

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. February 2021.