



IP/IT Annex

Jon has mediated many disputes, both in the U.K. and overseas, in a wide variety of fields including IP, IT, telecoms, defamation and media. Examples include:

IP (including competition) disputes

a dispute between owners of a 'split' trade mark arising out of a co-existence agreement, with infringement proceedings, and revocation and opposition registry proceedings taking place in several jurisdictions;

a trade mark and passing-off dispute arising out of alleged 'switch selling' in the 'on-sale' drinks sector;

a parallel imports/exhaustion of rights case raising a variety of competition issues;

a dispute concerning the proper method of calculating an account of profits on a trade mark infringement case;

groundless threats actions - patents, design right, trade marks;

patent validity disputes (novelty/inventive step/commercial success);

patent infringement actions;

disputes concerning employee invention claims under section 40 Patents Act 1977;

declarations for non-infringement under section 71 Patents Act 1977;

several disputes in the electronic games sector giving rise to a variety of IP issues involving both High Court and Nominet appeal proceedings, e.g. passing-off, licenses of trade marks, endorsements etc;

a dispute between a software house and a distributor concerning allegations of trade mark infringement and counterfeiting of discs, manuals and certificates of authenticity;

a dispute arising in the FMCG sector raising issues of patent infringement, design right infringement and trade mark infringement;

a passing-off and trade mark dispute involving household name food products;

a dispute concerning the development of an electronics product raising issues of patent infringement and breach of confidence;

a dispute concerning the ownership and commercial exploitation of medical diagnosis software;

a dispute between a software house and a client concerning the ownership in code and artwork for an internet portal;

a dispute concerning joint ownership of copyright and exploitation by one owner;

a dispute concerning the works of a major rock star involving alleged infringement of sound recording copyright, music/literary copyright and performers' rights;

moral rights claims;

disputes arising out of the exploitation rights to major sporting events;

sponsorship agreement disputes;

a dispute in the consumer products field concerning the licensing of manufacturing rights and the assignment/licensing of unregistered and registered design right;

several disputes concerning registered and unregistered U.K. and Community design right in a wide variety of sectors raising issues of ownership, validity, infringement, substantial similarity, commonplace designs, methods or principles of construction, technical function and licences of right;

several breach of confidence cases in a variety of sectors and contexts e.g. breach of NDA's, fiduciary duties, contract etc;

a breach of confidence dispute in which an exercise verifying deletion of allegedly infringing material from a large database was undertaken, alongside the mediation;

several other disputes in which allegations of breach of confidentiality obligations have been raised, particularly in the IT, and creative media and design sectors;

various disputes concerning the development of printed circuit boards;

various disputes concerning database rights, management and sharing;

several trade mark licence and royalty payment disputes;

several other trade mark, passing-off, copyright and design right disputes in a variety of sectors e.g. publishing, franchising, engineering & construction, food & beverages, furniture, technology, IT, motor, film, telecoms etc;

Mediation under Nominet's DRS Rules and disputes arising out of internet protest sites.

IT & telecoms disputes

several disputes arising out of major infrastructure projects;

a dispute arising out of a master licence agreement and its scope following a merger, involving issues of interpretation of numerous terms such as 'licensed users', 'site licences' and 'named user licences';

a number of disputes in the telecoms sector involving network providers and service providers and concerning such issues as 'churn' rates, allegations of 'spinning', the operation of account management software, software development and new product development;

a dispute arising out of a development project for a new telecommunications service;

a dispute concerning satellite broadcasting rights to major sporting events;

disputes arising out of co-location agreements;

dark fibre agreement disputes;

a dispute between an IT consultancy and an insurance company arising out of the design and build of a replacement core computer system, with argument focusing on the scoping proposal, requirements specification, user acceptance procedures as well as functionality, data migration and issues of recoverable loss and damage;

IT outsourcing disputes;

a dispute concerning a software licence and a master software, services and training agreement arising out of a takeover in the financial services sector;

several disputes arising in the financial services and insurance sectors;

a dispute concerning the design, supply and authorisation of computer games for use on various consoles;

a dispute between technology companies over compliance with express/implied specification requirements of several hundred items of computing equipment, their compatibility with other components and their 'epidemic' failure in the market place;

a dispute between an IT company and a financial services business concerning the design and build of an internet site for the processing of financial transactions;

various product development disputes in the electronics and communications sectors;

a dispute concerning an IT component supply and distribution agreement, including the precise scope of a 'life of requirements' provision;

a dispute between a services company and a major retailer arising out of a framework agreement, statement of works and long term support agreement;

a dispute in relation to the functionality of a computerised filing system;

a dispute concerning a large scale e-commerce database project in the auto sector involving issues of appropriate choice of programming language and compatibility;

a dispute concerning the functionality of certain safety critical components of passenger aircraft;

a dispute concerning the amalgamation of databases and the rights that exist in the combined database;

a dispute arising out of the design, installation and operation of a vehicle telematics system;

a dispute concerning the development and implementation of smart card technology;

a dispute arising out of the design, installation and operation of a ticketing/CRM system for a major public venue;

a range of disputes concerning the licensing of software, software drivers, and database servers;

disputes arising out of installation, maintenance and reseller agreements;

scoping, acceptance testing and change control disputes;

various IT systems development and/or integration disputes in the banking, life & pensions, insurance & reinsurance, retail and healthcare sectors;

disputes arising out of event/hospitality management software installation projects;

a variety of disputes between IT suppliers and public authorities;

several software related disputes.

Defamation (and malicious falsehood)

disputes arising out of allegations posted on websites;

disputes arising out of allegations of professional misconduct;

a dispute arising out of a radio broadcast;

a dispute arising out of publication in a newspaper;

a dispute arising out of disciplinary proceedings;

disputes arising out of alleged false statements made in the course of business dealings.

Media, Sports and Gaming

several sports related disputes in a variety of fields including boxing and football e.g. sponsorship and promotion agreements, agency agreements and disputes arising out of the exploitation of rights in major sporting events;

a dispute between a bank and a media agency concerning a long term planning and media buying contract;

a number of disputes concerning the level of activity and publicity generated pursuant to media campaigns;

a dispute arising out of the termination of an agency agreement in the field of radio advertising;

a dispute arising out of a joint venture concerning a TV 'shopping' programme;

a number of disputes arising out of the making of films including in the field of animation;

various disputes arising out of internet related activities e.g. content services agreements, search services agreements, agreements for the sale of internet traffic, advertising (portals, websites and search engines);

online gaming disputes;

publishing disputes.

Jon also regularly acts as a mediator in general commercial disputes and in those arising in various other sectors, for instance:

Engineering/construction, (for example, disputes concerning quality of work and delay, and a dispute concerning the management of, and overspend in relation to the design and build of a food processing plant with change control provisions, alleged extra-contractual variations and issues of ostensible authority being at the core of the controversy);

Banking and insolvency (for example, a dispute involving the operation of a large number of sale and leaseback agreements, a dispute between a liquidator and former directors of an insolvent company and disputes arising out of the valuation/revaluation of funds);

Professional negligence (for example, a dispute concerning the development value of a property, a dispute concerning a number of specialist surveys carried out on a property portfolio, a dispute concerning the flow down of an overage provision in a series of property transactions and various disputes involving insolvency practitioners, tax advisors, surveyors and solicitors);

Miscellaneous (for example, a dispute concerning the constitution of a union, a dispute between executive search consultants in relation to client relationships and commissions, a dispute concerning the management of a regulatory body, a dispute arising out of a public procurement project, a number of boardroom disputes, property disputes, agency disputes and personal injury disputes).