

11-2022

The 14th Annual Sir Hugh Laddie Lecture - Mr. Justice Laddie and His Intellectual Property Cases: Of Millefeuilles and a Fish Called Elvis

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Source Publication:

Intellectual Property Journal, 35(1), 7-35.

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Mr Justice Laddie and his intellectual property cases: of millefeuilles and a fish called Elvis

— David Vaver*

I knew Hugh less well than many of you did. I first encountered him in 1997 in Oxford, when he was a member of the board electing the inaugural chair in intellectual property and information technology law at the University. He was one of two electors associated with the University of Cambridge who came to make sure no-one too clever got elected at Oxford. In that, they certainly succeeded — at least, then.

It would take a doctoral dissertation to do justice to Hugh’s enormous legal contributions, in his 25 years at the bar and 10 years on the bench, across the whole field of IP law. I can touch on just a few.¹ Most are well known to IP lawyers everywhere, so for some this may be a trip down Memory Lane — a good or not-so-good trip, depending on how your case came out.

For me, it was a trip through the judgments of a master craftsman who could succinctly summarize the dispute before him; weigh the conflicting evidence; say what rang true and what did not; state the applicable law, often from first principles

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¹ This paper occasionally also cites cases that follow or approve Laddie J’s judgments. Comprehensiveness has, however, not been attempted: the footnotes and text would have become completely unmanageable.

set in their historical and policy context; and end by saying who won and lost and what to do. IP gives its holders the right to interfere with others' business activities;² so what judges, as the system's ultimate gatekeepers, allow or disallow can seriously affect the public interest and the economy, let alone the parties to a case.³ Given that, one can only marvel at the amazing speed with which Hugh's judgments came down — amazing at least to an academic who spends the morning composing a sentence and the afternoon deleting it.

The trip was also a reminder of how persuasive Hugh's writings remain even where their statutory underpinnings may since have changed. There are limits on what first instance judges can do to develop the law, but Hugh had no qualms in testing them. His success is proved by how much courts and treatise writers here and beyond rely on his decisions. A teaching casebook could easily be constructed on the back of Laddie's Leading IP Cases.

Of course Hugh was not infallible: that's reserved for Supreme Court judges, at least if in the majority. Still Hugh's batting average in appeals and approvals is enviable.

² *Inter Lotto (UK) Ltd v Camelot Group Plc* [2003] EWHC 1256 at [36]-[7], affd [2003] EWCA Civ 1132.

³ Eg on patents: *Ocular Sciences Ltd v Aspect Vision Care Ltd* [1997] RPC 289, 434 (“the validity of the Galley patent affects third parties and once the matter has been raised and evidence put before it the court should deal with the issue even if the parties have no interest in pursuing it themselves”); on trade marks: *Hunt-Wesson Inc's Trade Mark App'n* [1996] RPC 234, 242, taking account of the “public interest in not admitting onto the register invalid marks” in deciding whether new evidence should be admitted in a trade marks appeal; still a “useful” factor to consider despite the rules for admitting such evidence later providing that they applied across the board to all appeals: *Trump International Ltd v DTTM Operations LLC* [2019] EWHC 769, [67](iii) (Henry Carr J).

He wrote with a close eye to his audience. Judgments speak to many constituencies — lawyers, other courts, treatise writers, students, the public — but, as importantly, to the losing party. Hugh did say, in a case on whether trade marks were confusing, that the solution was more “feel than science.”⁴ But judicial feelings require explanation, and not just because appeal judges may tell you off otherwise. The losing party has to know clearly why the judge felt as he or she did. The explanation may need extensive chapter and verse: so that an edited version of one of Hugh’s judgments delivered 8 weeks after the hearing of a case that had run as long, takes up 130 pages and two parts of the law reports.⁵

Nor will the explanation always be welcome. It certainly wasn’t for a claimant Hugh called “amongst the most dishonest of witnesses or litigants I have ever seen.”⁶ That rested on more than a feeling, as Hugh’s judgment demonstrates in spades. Otherwise he rarely said in a page what could be said in a sentence⁷ — not always common in a profession where said spade may appear in a patent as “a digging device comprising a blade member and a platform member for transporting material between locations”.

⁴ *Wagamama Ltd v City Centre Restaurants plc* [1995] FSR 713, 732, approved in *Future Enterprises Pte Ltd v McDonald’s Corp* [2007] SGCA 18 at [7] (Singapore CA).

⁵ *Ocular*, n 3, although the report would have been even longer had parts dealing with the tort of conspiracy and unlawful means been included (see the fuller report in [1996] EWHC Patents 1). The case settled after judgment.

⁶ *Allason v Random House UK Ltd* (unreported), 16 Oct 2001 at [194], leave to appeal refused: *Allason v Random House UK Ltd* [2001] EWCA Civ 2077 at [39] (“hopeless”). The plaintiff later received a suspended sentence for contempt of court for not paying the costs award, which he was still avoiding paying 7 years later: *Random House UK Ltd v Allason* [2008] EWHC 2854 (David Richards J).

⁷ See his decisions on appeals from the Registrar of Trade Marks: eg *PROFITMAKER Trade Mark* [1994] RPC 613; *KUDOS Trade Mark* [1995] RPC 242 (registrable for paper products).

Such qualities are exemplified in a case of Hugh's from 1997. The American Elvis Presley merchandising monopoly had come to England seeking to register ELVIS as a trade mark. The plan was to litigate an unlicensed merchant selling ELVIS memorabilia out of the UK market, as they had done in the US.⁸ But the Americans came too late: the merchant had beaten them to the UK registry with his own ELVIS registration.

Hugh knew that, in the US, film companies often held merchandising rights in their movie characters, and celebrities and their estates often held rights over commercial uses of their name and attributes. In some states, if you want a career as an Elvis impersonator, the Elvis merchandising company will want a cut of your take. So a good part of Hugh's judgment, refusing registration, was devoted to explaining that English law recognized no such rights. Names and attributes were free for the taking or registering for a business if there was no evidence of passing off. The Americans had no monopoly on "Elvis" or "Elvis Presley". As Hugh put it in a much-quoted passage:

"There is nothing akin to copyright in a name. ... Even if Elvis Presley was still alive, he would not be entitled to stop a fan from naming his son, his dog or goldfish, his car or his house 'Elvis' or 'Elvis Presley'".⁹

⁸ *Presley Enterprises Inc v Elvisly Yours Inc* 936 F 2d 889 (6th Cir 1991); D Wall, "Policing Elvis: Intellectual Property Rights, Legal Action and the Shaping of Post-Mortem Celebrity Culture as Contested Space" (2004) 2:3 Ent L Rev 35.

⁹ *Elvis Presley Trade Marks* [1997] RPC 543, 547. Or, one might add, an anti-obesity drug: *JERYL LYNN Registered Trade Mark* [1999] FSR 491 (mumps vaccine). Compare *McCorquodale v*

The Americans fared no better on appeal¹⁰ and flew back to Memphis, mark-less and, no doubt, all shook up.

Hugh had views on what IP should be and do, and what it shouldn't.¹¹ It was as Professor Laddie that he set them out systematically in his inaugural lecture here 15 years ago. For him, competition and free trade were the rule, IP the exception. But IP could be, and often was, a good exception. Products and services might cost more but IP helped clamp down on deceptive trading and helped bring to market what "otherwise would not exist or would take many more years" to reach it.¹²

But exceptions may have their own exceptions, and the title to Hugh's lecture signals what he thought they were for IP: "The Insatiable Appetite for Intellectual Property Rights".

Masterson [2004] FCA 1247 at [60], distinguishing *Elvis* on the facts and refusing registration in Australia of DIANA'S LEGACY IN ROSES for live flowers on opposition by Princess Diana's estate: "The practice of licensing names and likenesses of celebrities, such as the late Princess, is now well recognised in the community."

¹⁰ *Elvis Presley Trade Marks* [1999] RPC 567, 597 (CA). Outside the US no trade mark registration often means no rights. Thus a New Zealander was allowed to register "Elvis" for swings: *Not Your Average Backyard Variety Swing Ltd v Elvis Presley Enterprises* [2009] NZIPOTM 9 ("Elviscare"). The Americans did better in Canada with their registration of GRACELAND, which stopped a Reverend Elvis from using YOUR GRACE LAND there to promote his church and holy roller radio show: *GL SPE LLC v Sheasby* 2021 TMOB 254.

¹¹ See too *Wagamama*, n 4; *Philips Electronics NV v Ingman Ltd* [1998] EWHC Patents 321 at [34].

¹² Hugh Laddie, "The Insatiable Appetite for Intellectual Property Rights", in Sir Robin Jacob, ed., *The Sir Hugh Laddie Lectures: The First Ten Years* (Cambridge, UK: Intersentia, 2019), 9-10 [*Laddie Lectures*]; see also Hugh Laddie, "Patents - what's invention got to do with it?" in David Vaver & Lionel Bently (eds), *Intellectual property in the new millennium: essays in honour of William R Cornish* (CUP, 2004), 91-2, accepted in *Actavis Group PTC EHF v Icos Corp* [2019] RPC 9 (UKSC).

The lecture's sub-headings provided more clues: "Trade Mark Addiction", "Excessive Copyright", "The Gradual Expansion of the Patent Net."¹³ Too much of a good thing can turn bad, and so it was with IP.

Hugh nonetheless always distinguished between what he thought the law should be and what it in fact was. Copyright law might be "over-strong", as he suggested in a 1996 lecture;¹⁴ but when he had to decide whether a TV documentary critical of cheque-book journalism could freely use another channel's footage to make its point, Hugh said his job was to interpret, not supplement, the law: courts had no "general wide discretion ... to refuse to enforce copyright where they believe such refusal to be fair and reasonable."¹⁵ Ironically, the Court of Appeal thought Hugh himself had been over-strong in the protection he had given the copyright holder, and held that the documentary could benefit from a fair dealing exception Hugh had denied it.¹⁶

Four strands to Hugh's thinking are worth noting before we look at further typical examples of his work.

¹³ Hugh ironically contributed to that expansion when arguing that a patent's net should reach the equivalents of a disclosed invention beyond the claims, a view the UK Supreme Court later adopted: *Eli Lilly & Co v Actavis UK Ltd* [2017] UKSC 48 at [56], [71], approving Laddie, "Kirin Amgen — The End of Equivalents in England?" (2009) 40 IIC 3. But Hugh was arguing for what he thought the law was, not necessarily what it should be. He thought UK courts had misread the *European Patent Convention* 2000 and should get back on track.

¹⁴ "Copyright: over-strength, over-regulated, over-rated?" [1996] EIPR 253.

¹⁵ *Pro Sieben Media AG v Carlton UK Television Ltd* [1998] FSR 43, 49.

¹⁶ *Pro Sieben Media AG v Carlton UK Television Ltd* [1999] 1 WLR 605 (CA).

First, he thought there was nothing special about IP statutes that required them to be interpreted differently from other legislation. History and context were of course important but the meaning of common words should not be pressed “far beyond” what “ordinary members of the public” would give them.¹⁷ Judges had sometimes strained IP “with almost evangelical fervour” to catch behaviour they thought little better than theft. Hugh would have none of it,¹⁸ and later courts have sided with him.¹⁹

Second, IP legislation, for all its imperfections, should be looked at, wherever possible, as a whole — as a joined-up scheme that extends different benefits for different activities. Exhausting or not quite qualifying for one kind of benefit gives you no passport to another kind. Hugh emphasized this feature both as an advocate and a judge. He had in the 1980s appeared for the Registrar of Trade Marks to argue successfully against Coca-Cola’s attempts to register its distinctive bottle as a trade mark to get what every trader craves: potentially perpetual protection.²⁰ The bottle wasn’t art (except perhaps to Andy Warhol); it had nothing patentable about it; and the registration for its design, though new in 1925, had expired in 1940. Trade mark law does not rush in where other IP fears to tread.

The *Coca-Cola* case was brought under the old *Trade Marks Act* 1938, but Hugh thought the 1994 Act hadn’t changed things much. A bottle might now technically

¹⁷ *Metix (UK) Ltd v GH Maughan (Plastics) Ltd* [1997] FSR 718, 722, cited with approval in all the courts in *Lucasfilm Ltd v Ainsworth* [2011] UKSC 39, aff’ing [2009] EWCA Civ 1328, aff’ing [2008] EWHC 1878.

¹⁸ *Autospin (Oil Seals) Ltd v Beehive Spinning* [1995] RPC 683, 700.

¹⁹ Eg *Lucasfilm*, n 18.

²⁰ *Coca-Cola Trade Marks* [1986] RPC 421 (HL).

qualify as a trade mark, but only if the public recognised it as such. They didn't in the case before Hugh of a yoghurt bottle: they relied instead on the container's labels and word marks to differentiate the product's source.²¹

Third, Hugh was unafraid to take on precedents he thought were misguided. His greatest provocation was undoubtedly the *Arsenal* case where he thumbed his nose at the European Court of Justice's intrusion on his authority as a national judge to decide the facts of a case. That didn't end well when the Court of Appeal said the European Court hadn't really differed from Hugh on the facts: they had just made an "inevitable" finding of fact that Hugh hadn't.²² How an "inevitable" finding of fact is not a finding of fact must have puzzled Hugh, as it puzzles me.

Hugh's second greatest provocation was the House of Lords' 1975 decision in *American Cyanamid Co v Ethicon Ltd*:²³ that to qualify for a pre-trial injunction, claimants need show only "a serious question to be tried" — i.e., a non-"frivolous or vexatious" case — before one went on to ask, on a balance of convenience, whether the claimant would be hurt more if the suspect weren't stopped than the suspect would be hurt if they were.²⁴ That approach might work for a case like *Cyanamid* itself, on whether a patent for surgical sutures made from some polysyllabic plastic was unobvious and infringed by a different equally polysyllabic

²¹ *Yakult Honsha KK's Trade Mark App'n* [2001] RPC 756, aff'ing the Office (approved in *Bongrain SA's Trade Mark App'n* [2004] EWCA Civ 1690). A registration for the bottle with YAKULT on it, but not for the bottle itself, was later accepted over opposition: *Yakult Honsha KK's Trade Mark App'ns* (IPO, 10 Mar 2004).

²² *Arsenal Football Club Plc v Reed* [2003] EWCA Civ 696, [48].

²³ [1975] RPC 513 (HL).

²⁴ *Ibid*, 541.

plastic. Reams of conflicting evidence and argument occupied a patents judge for 3 hearing days, and 3 Court of Appeal judges for 8 more, merely to decide whether a company that had not even started marketing should have to wait until after the trial to see if it could.

Hugh had no problem with the result²⁵ but he did with the test, which made little sense to him for the vast range of simpler cases. It was both wrong historically and positively unjust and inconvenient if applied generally. Other judges thought so too, but it was left to Hugh to go on the attack, as he did in the *Series 5 Software* case in 1995.²⁶ Judges, he said, were “paying lip service” to *Cyanamid* “while in practice applying different criteria.”²⁷ Claimants should usually show a *prima facie* case rather than one that merely transcended the risible: in short, who is most likely to win. Otherwise getting injunctions becomes too easy. Better allow judges to tell the parties how the case then looked and thus encourage quicker settlements to everyone’s benefit.²⁸ So Hugh re-jigged *Cyanamid’s* criteria to give judges more

²⁵ *Wyeth Holdings Corp v Alparma Ltd* [2003] EWHC 3196 at [18]-[20], [41] (injunction granted to preserve status quo until trial 4-5 months away).

²⁶ *Series 5 Software Ltd v Clarke* [1996] FSR 273 (Ch).

²⁷ *Ibid*, 277.

²⁸ *Ibid*, 287. That didn’t always happen: see *Antec Int’l v SW Chicks (Warren) Ltd* [1997] FSR 278, where Hugh granted an interim injunction to a claimant with “reasonably good prospects” of showing passing-off at trial, but the defendant nevertheless went to trial and still lost before another judge ([1998] EWHC Patents 330).

discretion and flexibility²⁹ and applied that approach in later cases, although usually being wily enough to mutter the magic word “*Cyanamid*” just in case.³⁰

Some thought Hugh’s reformulation “heretical”; others said it usefully reminded judges to do the best they could for the moment rather than running a mini-trial on disputed facts or law.³¹ Academic writers generally agreed with Hugh,³² and the Supreme Court of India also weighed in on his side.³³ In a Privy Council appeal too, the court, through Lord Hoffmann, also read *Cyanamid* along lines that would have given Hugh much satisfaction.³⁴ The *Series 5* case still quietly ticks away, biding its time — until perhaps someone recognizes that it deals better than *Cyanamid* with

²⁹ The case was another employee misconduct case, except the ex-employees had taken off because they weren’t being paid. The employer said they had taken confidential information and were soliciting customers, but Hugh thought the case was thin, and he wasn’t going to make employees starve while their former employer carried on trading without having the money to compensate them if it lost at trial, as seemed likely: *Series 5*, *ibid*, 290.

³⁰ Eg *Barclays Bank plc v RBS Advantage* [1996] RPC 307, 318; *CMI-Centers for Medical Innovation GmbH v Phytopharm plc* [1999] FSR 235, [26], [67].

³¹ Eg *Barnsley Brewery Co Ltd v RBNB* [1997] FSR 462, 472, per Robert Walker J); see too *Mayfair Brassware Ltd v Aqualine Int’l Ltd* [1998] FSR 135, 138 (CA), aff’ing Laddie J’s application of *Series 5* (*ibid*, 136); compare Walker LJ’s comments in *Guardian Media Group plc v Associated Newspapers Ltd* 2000 WL 331035 at[18] (CA).

³² Eg Andrew Burrows QC (ed), *English Private Law*, 2nd ed (OUP, 2013), § 21.04 (by Burrows); Steven Gee QC, *Commercial Injunctions* (2020), *passim*; David Vaver, *Intellectual Property Law: Copyright, Patents, Trade-Marks*, 2nd ed (2011), 630-1.

³³ *SM Dyechem Ltd v Cadbury (India) Ltd* [2000] INSC 303; *Colgate Palmolive (India) Ltd v Hindustan Lever Ltd* [1999] INSC 281; *Gurudas v Rasarangjan* (SC India, Sep 13 2006); *Super Cassettes Industries Ltd v B Myspace Inc* [2011] INDLHC 3597. See also in Canada, *Boehringer Ingelheim (Canada) Ltd v Pharmacia Canada Inc* 2001 CanLII 28351, [36]-[7] (Ontario SC).

³⁴ *National Commercial Bank Jamaica Ltd v Olint Corp Ltd* [2009] UKPC 16, [19]. A bank customer who was running a Ponzi scheme failed to get an interim injunction to prevent the bank from closing his account. The court thought, affirming the trial judge and reversing the appeal court, that the bank would likely win at trial and would meanwhile suffer “irremediable prejudice” if it had to keep servicing such an customer. Jamaican courts now recognize the symbiosis between *Olint* and *Series 5* by often citing both in the same breath: see eg *Rosh Development Ltd v Cayjam Development Ltd* [2017] JMCC Comm 4 at [16].

the factors the current civil procedure rules deem relevant to the overriding objective that cases be dealt with “justly and at proportionate cost”.³⁵

The last strand I’ll mention is the influence on Hugh of a trio of more or less familiar maxims:

(i) *Ubi jus ibi remedium* (“if someone’s got a right, do something about it”).

It sounds better in Latin.

(ii) *Bonos non malos aequitas subvenit* (“in equity, good folk win, bad folk lose”).³⁶ Decisions are easy where these two maxims coincide.

(iii) *Divibus non semper curat lex* (“deep pockets shouldn’t always prevail”).³⁷

This maxim is really a warning. Hugh knew that litigation is often warfare waged by other means,³⁸ but he did not want the law, and by extension its agents, to become “an instrument of oppression”, especially where someone

³⁵ CPR Part 1.1 reads as follows (with emphasis added):

“(1) These Rules are a procedural code with the overriding objective of enabling the court to deal with cases justly and at proportionate cost.

“(2) Dealing with a case justly and at proportionate cost includes, so far as is practicable -

(a) ensuring that the parties are on an equal footing and can participate fully in proceedings, and that parties and witnesses can give their best evidence;

(b) saving expense;

(c) dealing with the case in ways which are proportionate -

(i) to the amount of money involved;

(ii) to the importance of the case;

(iii) to the complexity of the issues; and

(iv) to the financial position of each party;

(d) ensuring that it is dealt with expeditiously and fairly;

(e) allotting to it an appropriate share of the court’s resources, while taking into account the need to allot resources to other cases; and

(f) enforcing compliance with rules, practice directions and orders.”

³⁶ Cf R Young & S Spitz, “SUEM - Spitz’s Ultimate Equitable Maxim: In Equity, Good Guys Should Win and Bad Guys Should Lose” 55 South Carolina L Rev 175 (2003).

³⁷ Cf Eugene Volokh, “Lost Maxims of Equity” (2002) 52 Jo Legal Educ 619: “He who seeks equity must do so with full pockets.”

³⁸ *Ocular*, n 3, at 408, refusing injunction that was “part of a plan” to ensure the defendant’s business “failed to survive”.

“of big standing and deep pocket” is set against someone with less of either.³⁹ That of course doesn’t mean that having no money makes you right, any more than having plenty doesn’t.

Anton Piller Search Orders

The quote about “oppression” comes from a case with which Hugh’s name is inextricably linked.

If we time-travel back to 1969, when Hugh first came to the bar, we find things were not so easy for claimants whose rights were being infringed, including IP owners. They might get what they wanted at an eventual trial, but getting something done beforehand was tough. If they knew someone was infringing but couldn’t find whom, they couldn’t make anyone else who did know tell them the culprit’s name and whereabouts.⁴⁰ If they did track the culprit down and said “stop”, the evidence would often disappear, to the dulcet tones of “Who, me, Guv?”⁴¹ If claimants did get the evidence, they could spend ages in court trying to halt the activity before trial;⁴² but, win or lose, they’d have to repeat the whole

³⁹ *Anton Piller* at first instance (Brightman J), quoted in Hugh Laddie & Martin Dockray, “Piller Problems” (1990) 106 LQR 601, 604; and see *Ocular*, n 3 at 360 (“A claim based even in part on wide and unsupportable claims of confidentiality can be used as an instrument of oppression or harassment against a defendant”); foll’d in eg *Liberty Financial Pty Ltd v Scott* [2005] VSC 26, [8]; *Agility CIS Ltd v White* [2021] FCA 1145 at [14] (Aust); *Donovan Group NZ Ltd v Reid* [2020] NZHC 3367 at [18].

⁴⁰ Changed by *Norwich Pharmacal v Customs & Excise Comm’rs* [1974] AC 133 (HL), Robin Jacob appearing as junior counsel for the successful claimants, seeking from HMRC the names of importers who were infringing the claimant’s patent.

⁴¹ Changed by *Anton Piller KG v Manufacturing Processes Ltd* [1976] RPC 719 (CA).

⁴² Changed by *American Cyanamid Co v Ethicon Ltd* [1975] RPC 513 (HL).

process, and more, to get a permanent injunction and compensation. Meanwhile infringers could hide their money offshore and make any judgment against them worthless.⁴³

All that was changed by a quartet of decisions handed down between 1972 and 1975. The IP bar was responsible for 3 of them. The case names — *Norwich Pharmacal*, *Mareva*, *Anton Piller*, and of course *American Cyanamid* — are as familiar to lawyers as aspirin is to everyone else, and give similar relief. Together they produced a procedural revolution that made life harder for scofflaws and those whose attitude towards doing business legally verged on the cavalier.⁴⁴

Hugh was key to this movement — and this, just 5 years out as a barrister. Film and record companies couldn't figure how to stop what they called "pirates" from illegally copying or selling their goods all over the UK.⁴⁵ Hugh invented a novel and non-obvious solution for them. In 1974 he persuaded four different judges to make orders, in private without notice, that operated much like search warrants, entitling raids on premises where offending stock and incriminating evidence were located.

⁴³ Changed by *Mareva Cia Naviera SA v Int'l Bulk Carriers SA* [1975] 2 Lloyd's Rep 509 (CA), argued by Bernard Rix of the commercial bar. See now *Broad Idea Int'l Ltd v Convoy Collateral Ltd* [2021] UKPC 24 allowing freezing injunctions in aid of foreign causes of action.

⁴⁴ See prior four footnotes. See Gee, *Commercial Injunctions*, n 32; Christopher Heath & Anselm Kamperman Sanders (eds), *Landmark Intellectual Property Cases and Their Legacy* (Kluwer Law Int'l, 2011) treating *Piller* as one of its ten worldwide landmark cases (Alain Strowel & Vicky Hanley, "The Anton Piller Case and Its Legacy: In Search of a Balance in Civil Search", ch 7).

⁴⁵ "No one hearing this accusation [i.e., the invective most often hurled at accused infringers, namely "piracy"] understands intellectual property owners to be saying that infringers are nautical cutthroats with eyepatches and peg legs who board galleons to plunder cargo. ... [This is] nonactionable 'rhetorical hyperbole'": *Mattel Inc v MCA Records Inc* 296 F 3d 894, 908 (9th Cir 2002), per Kozinski J.

The practice started spreading, including in a case passed to Hugh, where a company's trade secrets were being clandestinely hawked around its rivals. The company was a German one called Anton Piller. When a judge wouldn't give Hugh the order he wanted, off he went post-haste to the Court of Appeal and got it there instead. Lord Denning, presiding, recognized that they were doing something "of a kind not known before" — unusual for him — but generously credited Hugh with the innovation.⁴⁶

Piller-pushing and handling *Piller* cases that misfired became handy sidelines for Hugh⁴⁷ and kept coming to him after he had gone to the bench.⁴⁸ The orders are now so familiar that it is easy to forget their extraordinary genesis and trajectory. Hugh had made bricks from the straw of three not particularly promising 19th century precedents he had located — two English, one Irish. Only one had anything to do with IP. The first, from around the time of the birth of the future Queen Victoria, had the House of Lords confirming an order — unlike *Piller*, made on notice and hotly contested — allowing independent valuers to enter the East India Co's

⁴⁶ *Piller*, n 41 at 722.

⁴⁷ *Altext Inc v. Advanced Data Communications Ltd* [1985] 1 WLR 457; *Universal City Studios Inc v Mukhtar & Sons Ltd* [1976] 1 WLR 568; *Vapormatic Co. Ltd. V. Sparex Ltd* [1976] 1 WLR 939; *Ex parte Island Records Ltd* [1978] Ch 122 (CA); *Rank Film Distributors Ltd v Video Information Centre* [1982] AC 380 (HL) *Coopervision (UK) Ltd v Frankland* [1981] Lexis 126; *Burberrys Ltd v Kitson* [1981] Lexis 172; *AB v CDE* [1982] RPC 509; *Booker McConnell PLC v Plascow* [1985] RPC 425 (CA). Compare *Columbia Picture Industries v Robinson* [1987] Ch 38, where Hugh unsuccessfully sought to defend the making and execution of an order he had had no hand in.

⁴⁸ Eg *Re A Company* [2004] All ER (D) 130; *Taylor Made Golf Co Inc v Rata & Rata* [1996] FSR 538 (recalcitrant defendants); *Dendron GmbH v University of California* [2004] EWHC 589 (when seized documents can be used in collateral proceedings); *CMI-Centers for Medical Innovation*, n 30 at [71]-[2] (order discharged for lack of full disclosure).

warehouses in London to assess their rental value, so that St Botolph's church in Aldgate could get tithes from its reluctant parishioner.⁴⁹

The two other straws were from later in the century. They were inspection orders that, like *Piller*, had been granted without notice. One did deal with IP: it allowed Hennessys to enter a warehouse that was thought to contain fake brandy carrying its trade mark.⁵⁰ The other was about unintellectual property, namely wood: it allowed inspection of a ship that was about to depart with a load of timber the claimant said belonged to him.⁵¹ These were pretty thin straws. The reasons in one comprised just a couple of sentences. The other recorded no reasons at all, but at least it had been heard by four, albeit apparently taciturn, judges.

Hugh's genius was to build a *Piller* from these straws, aided by his three maxims. His claimants' undoubted rights needed a remedy. Sure, they had deep pockets but still they were the good folk, especially when compared to the artful dodgers.

Piller-popping made many trials redundant. It was amazing how having one's goods and papers seized and one's assets frozen concentrated the mind. Orders started being granted daily in all sorts of cases, not just IP, and the idea quickly emigrated far and wide.

⁴⁹ *East India Co v Kynaston* (1821) 3 Bli 153, 166 (HL), aff'ing (1819) 3 Swanston 248, 265 (LC). St Botolph was the patron saint of travellers and traders. One might have thought that a trading company with long supply chains might want to stay in his good graces.

⁵⁰ *Hennessy v Bohmans Osborne & Co* [1877] WN 14 (V-C).

⁵¹ *Morris v Howell* (1888) 22 LR Ir 77 (QB).

But there were costs. Deep pockets did start deciding cases; an “exceptional” procedure became routine; and with routine came abuse. Posses turned up at private homes scaring youngsters; some searchers were bullies; others were slack; still others misled defendants about their rights and didn’t give them enough time to contact their lawyer. Judges became annoyed,⁵² causing Hugh to team up with Professor Martin Dockray in 1990 to proclaim that something had gone terribly wrong: a procedure meant to prevent irreparable harm to claimants was causing irreparable harm to their “victims”.⁵³ They recommended reform and, as we know, the result was a Practice Direction in 1994 standardizing the procedure,⁵⁴ followed by legislation and Civil Procedure Rules regularizing what was now called a “search order”. Similar reforms happened elsewhere too, and the procedure is now kept under constant scrutiny to ensure it stays current and non-abusive.⁵⁵

I wish now to look at Hugh’s work in some specific areas.

Trade Marks and Passing-Off

The appearance of the word “Brand” in pride of place in the name of the Institute for Brand and Innovation Law that Hugh founded here indicates the importance he

⁵² See *Columbia*, n 47. Film companies had over-zealously pursued a *Piller* order and ended up having to pay a defendant substantial damages for the mayhem they caused.

⁵³ Laddie & Dockray, n 39 at 603: victims were suffering “shock, anger, confusion, a sense of violation and powerlessness [and] severe ... physical disruption” to their reputation, business, and daily life.

⁵⁴ Practice Direction, *Mareva Injunctions & Anton Piller Orders* [1994] RPC 617.

⁵⁵ Eg *TBD (Owen Holland) Ltd v Simons* [2020] EWCA Civ 1182, adjusting *Piller* practice to account for digital record-keeping and treating search and disclosure orders separately: getting one didn’t necessarily entitle you to the other.

placed on trade marks in enhancing commerce and consumer welfare — but subject to limits on what could be protected and how far.⁵⁶ As the *Coca-Cola* and yoghurt bottle cases indicate,⁵⁷ trade mark law is not a form of IP meta-protection. And yet it has stepped in to prevent parallel imports into the UK⁵⁸ and to become part of the arsenal of rights available to a certain football team, or indeed any sports team, to control the sale of merchandise bearing the team’s insignia and colours even where buyers know they’re not getting “official” gear, or don’t care.⁵⁹ Lord Hoffmann dealt with Hugh’s *contretemps* with the European Court of Justice on such matters in the first Laddie lecture.⁶⁰ He showed how unimpressed Hugh was with the way UK law, mandated by European law, had expanded the protection trade mark owners got in ways that harmed honest competition. We might have expected Hugh to produce a sequel to his Stephen Stewart lecture: “Trade Marks [instead of Copyright]: Over-strength, Over-regulated, Over-rated?”⁶¹

Hugh’s trade mark decisions naturally support honest practices and oppose deceptive or misleading ones where possible.⁶² Thus he was against interfering

⁵⁶ *Wagamama*, n 4.

⁵⁷ *Coca-Cola*, n 20; *Yakult* (2001), n 21.

⁵⁸ *Zino Davidoff SA v A & G Imports Ltd* [1999] RPC 631, on reference [2002] RPC 403 (ECJ), varying Hugh’s views.

⁵⁹ *Arsenal*, n 22.

⁶⁰ L Hoffmann, “The Function of a Trade Mark: Hugh Laddie and the European Court of Justice” in *Laddie Lectures*, n 12 at 19ff. See too the ECJ’s reversal of Laddie J’s view that EC labelling regulations created a private cause of action for affected parties: *Antonio Muniz y Cia SA v Frumar Ltd* [1999] FSR 872, revd [2003] Ch 328 (ECJ).

⁶¹ N 14.

⁶² Hugh comprehensively discussed the interrelation of trade mark registration and passing-off, holding that registration does not prevent claims against the registrant for passing-off: *Inter Lotto*, n 2.

with fair comparative advertising⁶³ but for allowing honest concurrent use before it finally was accepted under the 1994 *Act* as a defence to infringement.⁶⁴ But smart alecks such as those who registered a raft of companies under names such as Virgin, Nike, Armani, Cantona, etc., got short shrift from Hugh, who called them “scammers” and stopped them cold.⁶⁵ An ex-distributor selling “new and improved” baby bottles under a trade mark imitating his former supplier’s mark fared no better.⁶⁶ Nor did newly formed bands who tried to make off with the name of their predecessors.⁶⁷ This, the breakaway members of the heavy metal band SAXON learned when they tried to hijack the name by registering a trade mark that they then tried to use against the band’s remaining members. Hugh invalidated the registration. He said the leavers would be passing off if they performed as SAXON, and their trade mark application had been made in bad faith. The leavers could use another name they had, perhaps more appropriately, performed under: SON OF A BITCH.⁶⁸

Passing off or confusion may of course occur and be stopped even though a later mark differs from an earlier one in look, line of business, or territory.⁶⁹ But Hugh was against enlarging the circle of protection yet further by allowing registrations

⁶³ *Barclays Bank*, n 30.

⁶⁴ *Compass Publishing BV v Compass Logistics Ltd* [2004] EWHC 520 at [87]-[8]; see now *Budejovicky Budvar Narodni Podnik v Anheuser-Busch Inc* [2012] EWCA Civ 880 at [32]ff.

⁶⁵ *Direct Line Group Ltd v Direct Line Estate Agency Ltd* [1997] FSR 374, making an immediate award of substantial costs.

⁶⁶ *Handi-Craft Co v B Free World Ltd* [2005] EWHC 1307, confirmed at trial (2007) EWHC 10 (HHJ Fysh QC), but invalidating the product’s patent for obviousness (affd [2008] EWCA Civ 868).

⁶⁷ *Sutherland v V2 Music* [2002] EWHC 14.

⁶⁸ *Byford v Oliver* [2003] EWHC 295.

⁶⁹ *Associated Newspapers Ltd v Express Newspapers* [2003] EWHC 1322 (*Daily Mail* newspaper stops start-up of rival free *Evening Mail* in London as infringement and passing-off).

that included business beyond what the mark was going genuinely to be used in.⁷⁰ Registering for a category as broad as “computer software” where you were only in telecommunications and didn’t use it outside that business was far too wide for Hugh.⁷¹ Litigation continues to swirl around this issue today, while the trade mark registry becomes ever more crowded.⁷²

A few more cases deserve mention. There is Hugh’s first trade mark case as a judge, where he indicated how he would be deciding cases under the then new *Trade Marks Act 1994* unless told otherwise. A well-heeled US-based restaurant operation had started up a chain of curry houses in London under the name RAJAMAMA, apparently not caring that they might be confused with the WAGAMAMA noodle bar, then still a fledgling but well-known and popular eatery. This insouciance won no plaudits from Hugh, who found for Wagamama both on its trade mark registrations and for passing-off. A good number of Wagamama’s regulars would likely have muddled the two names or businesses, or might well have been turned off if they arrived expecting the vibe of their old haunt and were presented with a menu of vindaloo and chai instead of ramen and a carrot cleanse.⁷³

⁷⁰ *Laddie Lectures*, n 12 at 6-9.

⁷¹ *Mercury Communications Ltd v Mercury Interactive (UK) Ltd* [1995] FSR 850, 864-5, approved in *Thomson Holidays Ltd v Norwegian Cruise Line Ltd* [2002] EWCA Civ 1828, [26]-[9] & *Sky Plc v Skykick UK Ltd* [2020] RPC 4 at [76]ff (Tanchev Adv-Gen); compare *Sky Ltd v Skykick UK Ltd* [2021] EWCA Civ 1121, rev’ing Arnold LJ [2018] EWHC 155, [165], [171], who had applied Hugh’s views to the 1994 Act; *Lidl GB Ltd v Tesco Stores Ltd* [2022] EWHC 1434.

⁷² Eg *Awareness Ltd v Plymouth CC* [2013] RPC 34 at [14]-[6] (Appointed Person, D Alexander QC), approving *Mercury*, *ibid*.

⁷³ *Wagamama*, n 4.

Along similar lines were two variations on *Elvis's* case,⁷⁴ both about passing-off. In one, British racing driver Eddie Irvine complained that a radio station was using a doctored photograph of him on its promotional brochures.⁷⁵ In the other, the BBC complained that T-shirts were being sold carrying pictures of its Teletubby television characters.⁷⁶ Hugh found for Mr Irvine but against the BBC. People seeing the brochures might wrongly think that Mr Irvine was endorsing the radio station,⁷⁷ but people seeing Pinky Winky on a T-shirt wouldn't believe the BBC had started flogging clothing.⁷⁸ They might however believe just that of some celebrity in light of the common practice now of their name or attributes being used to market or endorse all sorts of products; and so when Topshop started selling T-shirts featuring a picture of Rihanna without her consent, the courts stopped it, relying on *Irvine's* case.⁷⁹

Finally, there was the case where Hugh effectively extended common law protection to unregistered geographical indications. Hugh had made clear in an

⁷⁴ Text accompanying n 9ff.

⁷⁵ *Irvine v Talksport Ltd* [2002] EWHC 367, aff'd with increased damages [2003] EWCA Civ 423; foll'd in *Vancouver Community College v Vancouver Career College (Burnaby) Inc* 2017 BCCA 41 at [65].

⁷⁶ *BBC Worldwide v Pally Screen Printing Ltd* [1998] FSR 665, 674.

⁷⁷ Hugh made clear he was not creating an image right or a right of publicity like *Elvis's* in the US: *Irvine* (EWHC), n 75 at [44]-[5]. This view remains good law in England: *Re Global Trade Mark Services Ltd TM App'n*, BL O/264/22 (30 Mar 2022) at [50] — a conservatism that may seem surprising, given the courts' creation of other rights protecting privacy and dignity, their recognition of the principle of unjust enrichment, and the common law's lauded ability to keep up with changing times and commercial custom.

⁷⁸ People might think differently today, given the BBC's increased licensing and character merchandising activities over the last 25 years. These may well have created for the BBC a goodwill that would be harmed if others started marketing products featuring its characters: see *Irvine, ibid* at [49]-[50]; also *Shazam Productions Ltd v Only Fools The Dining Experience Ltd* [2022] EWHC 1379 at [198]ff (IPEC).

⁷⁹ *Fenty v Arcadia Group Brands Ltd* [2015] EWCA Civ 3 at [38]-[40], aff'ing 2013 EWHC 1945.

earlier case that bottling Scotch in bulk and selling it as Welsh whisky was not the greatest idea.⁸⁰ A dispute he heard about “Swiss chocolate” was along similar lines. Cadbury had started a line of chocolate with SWISS CHALET emblazoned on the wrapper, accompanied by a picture of the Matterhorn and, unsurprisingly, a chalet. Unhappy Swiss chocolate makers sued. Hugh’s initial scepticism about their case dissipated as the evidence showed that in England “Swiss chocolate” meant more than chocolate made in Switzerland, although it meant at least that.⁸¹ The term had acquired a following based on where and how the chocolate was made and who made it. While a perspicacious IP judge might not be fooled on their weekly shop,⁸² Hugh accepted that the average chocolate lover’s sweet tooth would overcome their powers of observation and discernment and make them pay that little bit more for something they wrongly thought would be like the Swiss chocolate they had come to crave.⁸³ Yoghurt lovers who have been attracted to imitations of GREEK YOGHURT they thought came from Greece when it didn’t, or vodka connoisseurs who bought VODKAT not knowing its alcohol was a blend rather than pure vodka, have Hugh partly to thank for paving the way for court decisions banning such mislabelling.⁸⁴

⁸⁰ *Matthew Gloag & Son Ltd v Welsh Distillers Ltd* [1998] FSR 718.

⁸¹ Hugh would have known that a US company had failed to register SWISS MISS for chocolate powder mix because it deceptively suggested Swiss origin (*SWISS MISS Trade Mark* [1997] RPC 219, 228-9, affd [1998] RPC 889 (CA)) even though the tests for registrability and passing-off were not identical. Hugh had earlier allowed the late admission of evidence in the SWISS MISS case: *Hunt-Wesson*, n 3.

⁸² *Kimberley-Clark Ltd v Fort Sterling Ltd* [1997] FSR 877, 889.

⁸³ *Chocosuisse Union des Fabricants Suisses de Chocolat v Cadbury Ltd* [1998] RPC 117, affd [1999] RPC 826 (CA), but allowing only the manufacturers, not their association, to sue.

⁸⁴ *Fage UK Ltd v Chobani UK Ltd* [2014] EWCA Civ 5 (GREEK YOGHURT); *Diageo North America Inc v Intercontinental Brands (ICB) Ltd* [2010] EWCA Civ 920 (VODKAT).

Copyright

While at the bar, Hugh was involved in cases as varied as whether an ordinary living-room sofa could qualify as a work of artistic craftsmanship (answer: no, but the miscellany of reasons given amount to little more than “I know a hawk from a handsaw when I see it”);⁸⁵ whether a popular thriller novel may take chunks from a book on history to thread through its plot (answer: no, too much taken);⁸⁶ whether copyright was subject to a common law right of repair (answer: yes, but the idea has not met universal acclaim);⁸⁷ or whether formats of television shows like today’s “Strictly” or “Britain’s Next Top Model” were protectable by copyright (answer: no, more fluid ideas than fixed works).⁸⁸

Hugh had an equally varied diet of cases as a judge.⁸⁹ I’ll mention just four.

The first concerned a home decorating magazine that unsuccessfully sued another for allegedly copying its “look and feel”. Hugh produced a handy primer on how to run or defend a typical copyright infringement case. He warned against protecting mere ideas and common trade elements, or being misled by what he called

⁸⁵ *Geo Hensher Ltd v Restawile (Upholstery) Ltd* [1975] RPC 31 (HL).

⁸⁶ *Ravenscroft v Herbert* [1980] RPC 193 (Brightman J).

⁸⁷ *British Leyland Motor Corp v Armstrong Patents Co Ltd* [1986] UKHL 7; but see *Mars UK Ltd v Teknowledge Ltd* [1999] EWHC 226 (Jacob J).

⁸⁸ *Green v Broadcasting Corp of New Zealand* [1989] UKPC 26; referred to by Hugh in *IPC Media Ltd v Highbury-Leisure Ltd* [2004] EWHC 2985 at [7].

⁸⁹ The copyright legislation was allegedly simplified in 1988 during Hugh’s time at the bar but Hugh thought it had just got longer and messier: see his struggle through the 1988 Act to catch the playing of mod chips on PlayStations (*Sony v Ball* [2004] EWHC 1738, foll’d in *R v Gilham* [2009] EWCA Crim 2293); the mod chips themselves, however, did not breach the Act: *Higgs v R* [2008] EWCA Crim 1324 at [12], [16], [36] per Jacob LJ.

“similarity by excision”: “chipping away and ignoring all the bits which are undoubtedly not copied may result in the creation of an illusion of copying in what is left.”⁹⁰

As important was the question of what was actually supposedly copied. Was it the magazine cover as a single work, or did each of its components also have their own copyrights? Hugh rejected the multiple copyrights idea: the cover was not a “legal *millefeuilles* with layers of different artistic copyrights.”⁹¹ I’m not sure how Hugh would have felt about later developments that let newspaper headlines have copyrights separate from their articles.⁹² But his *millefeuille* image warns against slicing too finely or indiscriminately. If a song comprises layers of copyrights in each phrase and bar, musical composition becomes practically impossible without the risk of one’s being found guilty of subconsciously copying one of the myriads of copyrights in some earlier song.⁹³

I mentioned earlier the case where Hugh decided not to stretch the categories of copyright beyond what they meant in common English. So, for example, “sculpture” for him denoted a three-dimensional piece of art made by an artist. It could include ephemeral work such as sand castles and ice sculptures, but not

⁹⁰ *IPC*, n 88 at [11]; foll’d in *Media 24 Books (Pty) Ltd v Oxford University Press Southern Africa (Pty) Ltd* [2016] ZASCA 119 at [40] (Sth Africa SCA); *Burden v ESR Group (NZ) Ltd* [2016] NZHC 1542, [120]; *Coffey v Warner/Chappell Music Ltd* [2005] EWHC 449 at [9].

⁹¹ *IPC*, *ibid*, [23].

⁹² *Newspaper Licensing Agency Ltd v Meltwater Holding BV* [2011] EWCA Civ 890 at [22]; also *Shazam*, n 78 at [64]ff: separate copyright in Del Boy television character from *Only Fools and Horses*.

⁹³ *Sheeran v Chokri* [2022] EWHC 827 at [27]-[8], [205] (Zacaroli J): no subconscious copying.

manufacturing moulds used to produce ordinary functional items of commerce.⁹⁴ The category's content may also be affected by what the art world would consider as sculpture — a category that may change over time. What Turner thought in the 19th century was art is not what has often won his eponymous prize over recent years. Hugh's views later helped support the view that the stormtrooper helmets in the *Star Wars* film weren't sculptures. There is no toy helmet category for the Turner Prize.⁹⁵

Hugh also had to deal with what counts in law as joint authorship in two niche cases that have affected how collaborations in music, drama, and literature are categorized.⁹⁶ The first involved a designer employed by a home builder who had an independent firm of technical drafters translate his rough drawings and concepts into architectural plans for a line of houses. A rival builder was sued for copying the plans for its own line of houses but said the first builder couldn't sue because the copyright was owned by the drafters who had actually drawn the plans. Hugh disagreed. Authorship was more than pushing a pen or moving a mouse: it lay in "the skill and effort involved in creating, selecting or gathering together the detailed concepts, data or emotions" conveyed by the words or lines represented, not just in the symbols themselves.⁹⁷ If two persons work on these tasks together, they may become joint authors and copyright owners, and both or either can enforce their copyright interest.

⁹⁴ *Metix*, n 17 at 721.

⁹⁵ *Lucasfilm*, n 18.

⁹⁶ *Kogan v Martin* [2019] EWCA Civ 1645 at [38]-[42], [65], relying on both cases noted in this and the following paragraph.

⁹⁷ *Cala Homes (South) Ltd v Alfred McAlpine Homes East Ltd* [1995] FSR 818, 835.

The second case was a similar, yet different, collaboration. A buyer who had ordered a bespoke computer program was sued by its developer for making multiple copies of the software. The buyer said he was a co-author and so just as entitled to copy it as his co-authoring developer was. The buyer clearly had a major hand in the software's development: he said what he wanted and suggested fixes. But Hugh said his involvement wasn't like the building designer's: the buyer wouldn't know how to begin to structure or write a computer program. He was more like an editor or proof-reader: you can tell J.K. Rowling what you'd like in a Harry Potter sequel and check her manuscript for spelling, grammar, and plot coherence, but that doesn't get you on the title page as co-author.⁹⁸

These cases threw up a recurrent issue for Hugh — probably the only thing he would have shared with Michael Gove: experts. Churchill was wont to say there were three types of falsehood: lies, damn lies, and statistics. The jest in fact comes from a saying current around Lincoln's Inn in the latter part of the 19th century and sometimes attributed to Sir George Jessel, that there are three sorts of liar: "the liar simple, the damned liar, and the expert witness."⁹⁹

⁹⁸ *Fylde Microsystems Ltd v Key Radio Systems Ltd* [1998] FSR 449, 459-60.

⁹⁹ WD Gainsford, "Degrees of Falsehood": Notes and Queries (7th Ser. xii, Nov 21 1891), 288: "There used to be a somewhat better version of this saying current in Lincoln's Inn years ago, of a judge who recognized three degrees in liars: the liar simple, the d—d liar, and the expert witness. The point lies in the fact that expert witnesses are allowed to give evidence as to what is their opinion, and hence are out of the reach of an indictment for perjury, which always hangs over the head of the ordinary witness, who can testify to fact only. To whom the saying was attributed I am sorry to say I forget—probably to any one whom it fitted. In those days it probably would have fitted Sir George Jessel."

Hugh ran into the third category early on — not necessarily outright liars, but rather witnesses who acted more as hired guns than objective seekers after truth. Parties of course shop around for the most mellifluous expert to support their case¹⁰⁰ but still the expert is there primarily to help the court. Hugh had no difficulty with the honest expert who was doing their best¹⁰¹ but any expert who hadn't done their homework would not repeat the experience in Hugh's court.¹⁰² Nor would the one who rashly wrote a paper entitled "The Expert Witness: Partisan with a Conscience", likening expert witnesses to a dealer in Three Card Monte, except the mark was the judge. Hugh told him off at length, including the riposte: "If litigation is to be conducted as if it were a game of Three Card Trick, what is wrong with having a couple of aces up your sleeve?"¹⁰³

Hugh had no time for cock-and-bull stories at the best of times¹⁰⁴ but his intolerance with experts who weren't doing their job sometimes got him into

¹⁰⁰ *Electrolux Northern Ltd v Black & Decker* [1996] FSR 595, 615.

¹⁰¹ *Inhale Therapeutic Systems Inc v Quadrant Healthcare plc* [2001] RPC 419, 439 (despite counsel's criticisms, "I had and have no reason to doubt the honesty of any of the witnesses called on either side").

¹⁰² See eg *Autospin*, n 18, 693: "the special respect and weight given to experts' evidence carries with it the responsibility to approach the task seriously. An expert and those who help him prepare his report should not be surprised if the court expresses strong disapproval if that is not done."

¹⁰³ *Cala*, n 97 at 842-3, inspiring an Australian judge (McClellan CJ, NSW) to entitle a conference paper of his "Expert Evidence — Aces Up your Sleeve?" (20 Oct 2006), infolink/lawlink/supreme_court/ll_sc.nsf/vwPrint1/SCO_mcclellan201006. The full passage in *Cala* has been quoted approvingly in Canada: see, eg, *Metropolitan Toronto Condominium Corp. No.1250 v Mastercraft Group Inc* 2010 ONSC 5947 at [134]; *Aherne v Chang* 2011 ONSC 2067 at [29]-[34], quoting from *Cala* at length; *Larouche v Clinique dentaire Bérubé Richard & Associés* 2009 QCCLP 2951 at [55] (Quebec).

¹⁰⁴ Eg *Microsoft Corp v Electro-Wide Ltd* [1997] FSR 580, 594 (defendants' affidavits to counter case of deliberate copying Microsoft software "are not believable": summary judgment for injunction and inquiry on damages).

trouble. A disgruntled claimant, whose patent Hugh had revoked, appealed, saying Hugh had shown bias when questioning their expert on inconsistencies in his evidence and ultimately rejecting it; but the Court of Appeal thought the complainant was just another sore loser and supported Hugh.¹⁰⁵ Hugh's conduct may usefully be contrasted with the judge in Chicago a few years ago, who had been to-and-fro-ing with a defendant charged with income tax fraud who claimed that the tax system was voluntary and he hadn't signed up for it. The judge finally lost his cool and told the defendant: "this is all complete BS [except he did not abbreviate] ... [I]f you keep arguing, I'll kick you out."¹⁰⁶ If Hugh ever harboured such thoughts, he wisely kept them to himself.

Patents

Hugh's patent cases ran the gamut from electronics, genetics, and medical and pharmaceutical patents through to ferry boats, laying underwater cables, tents, motor mowers, gas burners, contact lens, toothbrushes, and coffee sweeteners. Few nooks or crannies do not bear his mark. He provided guidance on Patent Office

¹⁰⁵ *Cairnstores Ltd v AB Håssle* [2002] EWCA Civ 1504, aff'ing [2002] EWHC 309.

¹⁰⁶ Retrial ordered before judge of calmer disposition: *US v Le Bey* 873 F 3d 1015 (7th Cir 2017).

procedure;¹⁰⁷ on what is and isn't patentable;¹⁰⁸ when additions to a patent may be made;¹⁰⁹ how to construe claims and specifications;¹¹⁰ when an invention is anticipated¹¹¹ or obvious;¹¹² what amounts to infringement;¹¹³ when defences such as good faith prior use are available;¹¹⁴ and, more esoterically, whether repairs on a sewer running under the Houses of Parliament should be stopped at the eleventh hour because of a possible patent infringement — unsurprisingly, no, although more because the application came in late rather than that public inconvenience was involved.¹¹⁵

¹⁰⁷ Eg *R (ex p Ash & Lacey Building Products Ltd) v Comptroller-General of Patents etc* [2002] RPC 939 (withdrawal of revocation application subject to Comptroller's discretion). Hugh's reversal of an inventorship decision of the Patent Office for wrongly assessing the evidence, although itself reversed as improperly interfering with the Office's discretion (*Re Ladney* [1996] Lexis Citation 3448, rev'd *Ladney & Hendry's Int'l App'n* [1998] RPC 319 (CA)) was vindicated when the inventor admitted committing perjury before the Office: *Cinpres Gas Injection Ltd v Melea Ltd* [2008] EWCA Civ 9; Gordon Harris, "Justice, at last, in the archetypical patent entitlement dispute" (2008) 3 JIPLP 278.

¹⁰⁸ *Fujitsu Ltd's App'n* [1996] RPC 507, affd [1997] RPC 608 (CA); *Sabaf SpA v MFI Furniture Centres Ltd* [2001] Lexis 1806, affd [2004] UKHL 45.

¹⁰⁹ *Spring Form Inc v Playhut Inc* [2000] FSR 327; *Norling v Eez-Away (UK) Ltd* [1997] EWHC 369.

¹¹⁰ *Coflexip SA v Stolt Comex Seaway MS Ltd* [1999] Lexis 2809 ("substantially" read into claims), affd [2000] EWCA Civ 242; *American Home Products Corp v Novartis Pharmaceuticals UK Ltd* [2000] RPC 547 at [26]ff, revd on other grounds [2001] RPC 8 (CA); *R (ex p Penife Int'l) v Comptroller General of Patents etc* [2004] RPC 737 (consistory clause is not a claim); *Russell Finex Ltd v Telsonic AG* [2004] EWHC 474 at [29]-[30] (unenthusiastic about admitting prosecution history; but see now *Eli Lilly*, n 13 at [88]).

¹¹¹ *Inhale*, n 101; *University of Southampton's App'ns* [2005] RPC 220, 236, revd on other grounds [2006] EWCA Civ 145 (anticipation requires both disclosure and enablement), approved in *Synthon BV v Smithkline Beecham plc* [2005] UKHL 59, [28].

¹¹² See eg *Brugger v Medic-Aid Ltd* [1996] RPC 635; *Hoechst Celanese Corp v BP Chemicals Ltd* [1997] FSR 547; *PCME Ltd v Goyen Controls UK Ltd* [1999] FSR 801, 815-6; *Pfizer Ltd's Patent* [2001] FSR 201, affd *Lilly Icos Llc v Pfizer Ltd* [2002] EWCA Civ 1 (Viagra obvious); *Inhale*, n 101.

¹¹³ Eg, *Merck & Co Inc v Generics (UK) Ltd* [2003] EWHC 2842; *Lacroix Duarib v Kwikfrom (UK) Ltd* [1998] FSR 493, 497 (precedents under 1949 Act irrelevant on 1977 Act).

¹¹⁴ *Lubrizol Corporation v Esso Petroleum Co Ltd* [1992] RPC 281, 295, approved *ibid* (No 2) [1997] RPC 195, 215 (Jacob J), affd [1998] RPC 727, 770 (CA); *Stena Rederi AB v Irish Ferries Ltd* [2002] RPC 50, affd [2003] RPC 668 (CA) (international transport defence).

¹¹⁵ *Chaneline Design Consultants Ltd v Johnston Pipes Ltd* [1996] Lexis 1592.

One key area dealt with how much of an infringer's profits should be handed over to a patent holder.¹¹⁶ The standard story has long been that electing this optional remedy is not usually worth the candle. By the time you've prised the necessary data out of a reluctant defendant and paid accountants to analyse it and come up with a plausible figure, what you recover is often less than what you spent to get it.

Hugh's case in 1999 did not entirely negate that story. The parties had started off £176 million apart. The claimant wanted the full £180 million it said the infringer had made from using a patented process. The infringer said it owed at best £4 million because the process was just one of many inputs into the finished product. Both parties must have been startled when Hugh awarded a figure some 85% below the **infringer's** estimate. Hugh's classic judgment on how to apportion infringing gains has nevertheless rekindled interest in the remedy. His name has come up in a case now before the Canadian Supreme Court where a \$C650 million award is being challenged because of the inclusion of profits from non-infringing activity that the infringer says has doubled what is owed. Whether the Supreme Court will award just 15% of the latter sum remains to be seen, but Hugh's case will undoubtedly figure in its decision.¹¹⁷

¹¹⁶ *Celanese Int'l Corp v BP Chemicals Ltd* [1999] RPC 203; see *Nelson v Rye* [1996] 1 WLR 1378 (limitation statute).

¹¹⁷ See *Nova Chemicals Corp v. Dow Chemical Co* 2020 FCA 141 at [199]-[200] per Woods JA (dissenting) citing *Celanese, ibid*, 221, leave to appeal 2021 CanLII 42376 (SCC).

I have time to deal with just one patent case. I have chosen one that typifies Hugh's thinking and the application of his three maxims. The case dealt with the law of obviousness but it had nothing to do with hi-tech or *recherché* science. It's a case that sends a message of hope to all home inventors: think up something simple and practical, and you can get a patent even if no complex chemistry or electronics are involved.¹¹⁸ But if you do come up with a winner, be ready to take on an industry that may think it has a monopoly on good ideas, even when it hasn't.

Hugh's judgment reads like a film script along the lines of *The Flash of Genius* a few years back, where an inventor took on Detroit for stealing his idea for intermittent windscreen wipers and, after much tribulation, he won.¹¹⁹ Here, an inventor called Mandy Haberman got interested in helping infants with feeding difficulties. She saw training cups being used by toddlers who hadn't graduated yet to drinking from a regular cup, but the training cups all leaked. Ms Haberman hit upon the idea of a cup that had a spout with a slit valve like a nipple or teat. The contents would escape only when the spout was sucked. The cup didn't leak or spill even if it was shaken or turned upside down.

Ms Haberman patented it,¹²⁰ and the Haberman cup was and remains a hit. I leave to your speculation why the male-dominated makers of infant feeders hadn't themselves thought of the idea.

¹¹⁸ Compare the patent for crystallising aspartame that was upheld despite being for "a very simple, or apparently simple, invention": *Daesang Corp v Ajinomoto Co Inc* [2003] EWHC 973 at [1].

¹¹⁹ *Kearns v Chrysler Corp* 32 F 3d 1541 (Fed Cir 1994).

¹²⁰ A European patent was also obtained after a mix-up in the UKIPO caused her application to lose priority: *Haberman v Comptroller of Patents etc* [2004] RPC 414 (Pat Ct; Prescott QC);

Inevitably, the copycats arrived. The main one revelled in the name of Jackel International. When challenged, it said, somewhat patronisingly: what's inventive about sticking a slitted teat into a spout? It's obvious. The patent is invalid.

Ms Haberman sued. The hearing before Hugh took 4 days in early December 1998. Those Four Days didn't go well for the Jackel. It's been said that lone inventors are largely a myth, and if you do find one, it's not because they've made any "conscious effort to invent" but usually because they've botched an experiment.¹²¹ Fortunately, reports of Ms Haberman's mythic existence had reached neither her nor Hugh; for he wrote a judgment in her favour over the Xmas break.¹²² It contained a mini-treatise on the law of obviousness, including a now classic discussion on when a product's commercial success negates obviousness. Hugh said the slit valve was indeed "a very small and simple step" that anyone in the infant feeder industry could have taken; but they hadn't, despite knowing for years that there was water, water everywhere, and hardly a drop to drink. Hugh said the solution "was there under their very noses [but] it took a comparative outsider to see it."¹²³

Haberman v Jackel Int'l Ltd, Case No T0134/06 (EPO Bd Appeal, 27 Sep 2007); Roy Marsh, "Obviousness: what's the problem" (2019) 14 JIPLP 667, 672-3.

¹²¹ Eg, Mark Lemley, "The Myth of the Sole Inventor" 110 Mich L Rev 709, 711 (2012).

¹²² *Haberman v Jackel Int'l Ltd* [1999] FSR 683.

¹²³ *Ibid*, 706.

Quite apart from her counsel's powers of advocacy,¹²⁴ I think Ms Haberman was fortunate to have got Hugh as the judge. Another one could easily have found against her, and such findings are notoriously hard to overturn on appeal. The judge might have been a disciple of Judge Henry Friendly, who once remarked, only half in jest, that any invention he could understand had to be unpatentable.¹²⁵ Patentability often boils down to a value judgment on which minds may differ: is the disclosed advance inventive enough to deserve a patent? Will patent law's policy of rewarding and encouraging inventors be furthered or set back by finding for this one?¹²⁶

Hugh relied on the commercial success of the Haberman cup to tip the balance in favour of unobviousness.¹²⁷ He was usually sceptical about commercial success as such a factor,¹²⁸ and I am too because it's there in virtually every patent case that is litigated: who sues to enforce or invalidate a patent on something that's a flop? Obvious innovations are often hits too.¹²⁹ Commercial success seems patent law's counterpart to the now discredited "rough practical test" first trotted out a century ago in a copyright case where exam papers emanating from this very university had been copied. The judge there said copyright must exist in them because "what is

¹²⁴ Michael Fysh QC (later HHJ Fysh, Patents County Court) and Adrian Speck (later QC) appeared for Ms Haberman.

¹²⁵ David Dorsen, *Henry Friendly, Greatest Judge of his Era* (Harvard UP 2012), 457.

¹²⁶ Citing *Société Technique de Pulverisation STEP v Emson Europe Ltd* [1993] RPC 513, 519 (CA), an obviousness case in which Laddie QC appeared against Jacob QC.

¹²⁷ *Axent Holdings Pty Ltd v Compusign Australia Pty Ltd* [2020] FCA 1373 at [679]-[83].

¹²⁸ *Raychem Corp's Patent* [1998] RPC 31, 66, affd [1999] RPC 497 ("adding a plea of commercial success normally only adds time and expense to the proceedings and serves no useful purpose").

¹²⁹ *Sabaf*, n 108 at 59 (Ch); *Pfizer*, n 112 at 244.

worth copying is prima facie worth protecting.”¹³⁰ The “test” is not just “rough”: it is no test at all. Yet it still manages to cling on in different garb in patent law.

Hugh was, I think, on stronger ground in looking at the industry’s history with infant feeders. Before Ms Haberman came on the scene, no-one seemed to have heard of the KISS principle of design: Keep It Simple, Stupid. Even though leaky cups had been around for ages,¹³¹ earlier attempts at cure seemed inspired by Heath Robinson. The industry was awash in what Hugh called “folklore, perceptions and prejudices”.¹³² Had it been the Stone Age, they would still have been there, chipping rocks.

Conclusion

We have looked at a mere sample of Hugh’s work without touching on his major contributions in so many areas: evidence and procedure,¹³³ managing

¹³⁰ *University of London Press Ltd v. University Tutorial Press Ltd* [1916] 2 Ch 601, 610, discounted in eg *Lambretta Clothing Co Ltd v Teddy Smith (UK) Ltd* [2004] EWCA Civ 886 at [37], per Jacob LJ.

¹³¹ “The fact that decades had passed without the problems being solved points away from obviousness”: *Siegfried Demel v C & H Jefferson* [1999] FSR 204, [50].

¹³² *Haberman*, n 122 at 699.

¹³³ Eg *GEC Alsthom Limited’s Patent* [1996] FSR 451 (costs on discontinuation), approved *Fresenius Kabi Deutschland GMBH v Carefusion Inc* [2011] EWCA Civ 1288 at [5]-[6] & *Brivis Australia Pty Ltd v Seeley Int’l Pty Ltd* [2002] FCA 843 (Aust); *Unilever Plc v Procter & Gamble Co* [1999] FSR 849, affd [1999] EWCA Civ 3027 (“without prejudice” evidence); *Petrolite Holdings Inc v Dynamo Oil Field Chemicals UK Ltd* [1998] FSR 190 (summary revocation of patent); *Connaught Laboratories Inc’s Patent* [1999] FSR 264 (revocation despite claimant’s offer to surrender patent); *Discovision Associates v Discotronics (UK) Ltd* [1999] FSR 196 (patentee cannot discontinue where defendant seeks definite ruling on validity); *Bourns Inc v Raychem Corp (No 2)* [2000] FSR 841, affd *ibid* 850 (CA) (document produced during discovery not released for use in other proceedings).

transnational litigation¹³⁴ and conflicts between domestic and EPO proceedings,¹³⁵ Euro defences,¹³⁶ threats actions,¹³⁷ design rights,¹³⁸ confidential information and employee mobility,¹³⁹ and remedies.¹⁴⁰ Nor have I collected all his *bons mots*, although I do particularly enjoy one from when Hugh was at the bar, which Sir Robin quotes in one of his cases. How does one best go about settling disputes? "Always try to negotiate with your foot on the other man's neck."¹⁴¹ Hugh did have a practical side.

¹³⁴ Eg *Fort Dodge Ltd v Akzo Nobel NV* [1998] FSR 222 (Laddie J & CA); *Sepracor Inc v Hoechst Marion Roussel Ltd* [1999] FSR 746; *Celltech R&D Ltd v Medimmune Inc* [2004] EWHC 1522.

¹³⁵ *Minnesota Mining & Minerals v Rennicks (UK) Ltd* [2000] FSR 727.

¹³⁶ Eg *Philips Electronic NV v Inman Ltd* [1999] FSR 112; *Philips Domestic Appliances & Personal Care BV v Salton Europe Ltd* [2004] EWHC 2092.

¹³⁷ Eg *Brain v Ingledew Brown Bennison & Garrett* [1997] FSR 511.

¹³⁸ Eg *Electronic Techniques (Anglia) Ltd v Critchley Components Ltd* [1997] FSR 401; *Ocular*, n 3 at 421ff; *Ultraframe UK Ltd v Fielding* [2003] RPC 435, varied [2004] RPC 479 (CA); *Bodum (UK) Ltd v Household Articles Ltd* [1998] EWHC Patents 344.

¹³⁹ Eg *Ocular*, n 3; *Polymasc Pharmaceutical plc v Charles* [1999] FSR 711; see also Belinda Gray, "Ocular Sciences: A New Vision for the Doctrine of Breach of Confidence?" (1999) (1999) 23 Melbourne ULR 241. Hugh won an important confidential information case early in his career: *Church of Scientology v Kaufman* [1973] RPC 635 (Ch).

¹⁴⁰ Eg *Ocular*, *ibid* at 395ff (remedies for breach of confidence). Hugh also made the first English John Doe order against unnamed defendants who were trying to peddle stolen prepublication copies of a *Harry Potter* book to newspapers: *Bloomsbury Publishing Plc v Newsgroup Newspapers Ltd* [2003] EWHC 1087, following *Tony Blain Pty Ltd v Splain* [1994] FSR 497 (NZ), although Morritt V-C's judgment confirming the order (*Bloomsbury Publishing Group Ltd v News Group Newspapers Ltd* [2003] 1 WLR 1633) gets all the limelight: see *Cameron v Liverpool Victoria Insce Co Ltd* [2019] UKSC 6 at [10] where Morritt V-C's case is wrongly said to be the "first" to open up the "much wider jurisdiction" to enjoin unnamed defendants: see Isabel Britton, "Two new roles for John Doe" [2004] EIPR 34 & Quentin Cregan, "Roving injunctions and Joe Doe orders against unidentifiable defendants in IP infringement proceedings" 2011 JIPLP 623, 628 rightly crediting Hugh for the innovation.

Compare *Coflexip SA v Stolt Comex Seaway Ltd MS Ltd* [1999] EWHC 258, revd on remedy [2000] EWCA Civ 242 at [61]-[7] (wide injunction normal remedy rather than more tailored injunction); *Cala Homes (South) Ltd v Alfred McAlpine Homes East Ltd (No 2)* [1996] FSR 36, overruled in *Redrow Homes Ltd v Betts Bros plc* [1998] FSR 345 (HL) (additional damages cannot be awarded on top of an account of profits in copyright).

¹⁴¹ *Reed Executive Plc v Reed Business Information Ltd* [2004] EWCA Civ 887 at [45].

I'll sum up by repeating the concluding paragraph to Hugh's inaugural lecture:

“We should be trying to hone the [IP] system so that the greatest rewards and encouragement go to those [people and] industries which need and deserve them most. Where IP rights perform their function of advancing the sciences or arts, they should be encouraged to do so. Where or to the extent that they do not, they have no economic justification and the normal discipline of competition should prevail. The gluttony which has resulted in the growth of completely unnecessary or excessively long IP rights undermines the system itself. As Shakespeare put it: ‘With eager feeding food doth choke the feeder’”.¹⁴²

Indeed so.

¹⁴² *Laddie Lectures*, n 12 at 18.