



## John Hornby

Partner, Solicitor

John is an intellectual property litigator based in J A Kemp's London office. Over many years of practice, John has acted for clients in patent, confidential information (trade secret) and trade mark disputes. He is recommended by *The Legal 500*, where clients comment that he 'is a superbly intelligent patent litigator, with an immense breadth of experience in the pharmaceutical industry. Great litigation skills, as he combines having a chemistry degree with starting his legal career as a barrister.'

John's patent litigation practice has involved disputes between parties in a wide variety of sectors including pharma; biotech; chemical; semi-conductor design and manufacture; satellite communications; and mechanical/electromechanical. That side of his practice has also included substantial involvement in proceedings before overseas courts, including those in Germany, Netherlands, France and Spain.

John has also acted in trade mark disputes ranging from modest UKIPO oppositions to hard-fought High Court passing-off cases.

John has acted before a variety of tribunals, including the High Court (Patents Court and general Chancery); Court of Appeal; IPEC; European Patent Office; UK Intellectual Property Office; and arbitrators, and represented clients in mediations.

John has expertise in drafting IP agreements, whether in settlement or avoidance of litigation or, more generally, IP exploitation (licensing and collaboration).

He practised as a barrister in the early years of his career and was one of the first solicitor advocates. As a consequence, he is able to draft pleadings and appear in Court, as needed, and in many of the cases below, John appeared as a solicitor advocate.

Additionally, John's career has included twenty years at one of the largest City firms (14 as a partner), co-founding an IP boutique firm and acting as an independent consultant. He joined J A Kemp in 2024.

Cases in which John has acted include:

### Patents and Confidential Information

- Astra -v- Byk Gulden: infringement and revocation case before the Patents Court concerning Byk Gulden's proton pump inhibitor used in the treatment of gastro-intestinal complaints.
- Daesang -v- Ajinomoto: revocation case before the Patents Court concerning the process for the manufacture of aspartame, the artificial sweetener.
- Lenzing -v- Courtaulds: infringement and revocation case before the Patents Court, including Judicial Review proceedings, concerning the process used for manufacturing the textile Lyocell.
- Novamedix -v- NDM: infringement and revocation case before the Patents County Court (now the IPEC) concerning a medical device to prevent deep vein thrombosis.

• Novartis -v- AstraZeneca: infringement and revocation case, including an application for an interim injunction, before the Patents Court

### Services & Specialisms

Patents, The Unified Patent Court, Trade Marks & Designs, Freedom to Operate for SMEs, IP Strategy, IP Due Diligence, UPC Litigation & IP Litigation, IP Dispute Resolution, Online Brand Protection and Domain Name Disputes, Patent Oppositions and Appeals

### Location

London

### Education

University of Cambridge, BA Natural Sciences; City University, London, Diploma in Law; Inns of Court School of Law, Bar Vocation Course

### Qualifications

Solicitor (England & Wales); Solicitor Advocate

### Membership of Professional Bodies

AIPPI; GRUR (German Association for the Protection of Intellectual Property); UNION-IP; The Law Society

### Contact

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concerning the MS drug fingolimod.

- Pilkington -v- PPG: one of the largest ever arbitrations in the IP space. It concerned technical information in hardware used for the production of float glass (for making windows, windscreens, etc.).
- SGS Thomson -v- International Rectifier: infringement and revocation case before the Patents Court concerning insulated gate bipolar transistors.
- Strix -v- Otter: infringement and revocation case before the Patents Court concerning thermo-mechanical controls used in kettles and similar products.
- TRW -v- ICO: infringement and revocation case before the Patents Court concerning constellation satellite systems for mobile communications.
- Woodhouse -v- Honda: infringement and revocation case before the Patents Court concerning the lubrication system inside general purpose engines.
- Zuru -v- Koopman: infringement and validity dispute in IPEC concerning Zuru's world renowned and bestselling water balloon toy.
- Parties' names confidential: confidential information and unlawful means conspiracy dispute concerning COVID-19 lateral flow technology.
- Parties' names confidential: instructed to assist in a substantial Swedish law arbitration in which he was due to give expert evidence on English patent law.

#### **EPO Oppositions**

- Exxon Mobil/Statoil concerning the Fischer-Tropsch process.
- Merck Sharp & Dohme/Eli Lilly/GSK concerning specific formulations and types of stress disorder.
- Others for Immunex (Amgen) and Centocor (Janssen).

#### **Trademarks**

- HFC -v- HSBC: passing off case concerning Midland Bank's adoption of the name HSBC in the UK.
- Isotropic Systems -v- Isotropic Networks: registered trade mark and passing off dispute concerning a worldwide satellite communication service.
- Weight Watchers -v- Tesco: registered trademark case concerning Weight Watchers' Points trademark.