

WIPO LIST OF NEUTRALS

BIOGRAPHICAL DATA

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Date of Birth: July 26, 1960

Nationality: British

EDUCATIONAL AND PROFESSIONAL QUALIFICATIONS

City of London Polytechnic, Law Society Finals, London, U.K., 1983;
City of London Polytechnic, (Common Professional Examination), London, U.K., 1982;
BSc, University of Liverpool, (Geology and Industrial Studies), Class 2:1, Liverpool, U.K., 1981.

Admitted as a solicitor, April 1986.

LANGUAGES

English.

PRESENT POSITION

Independent Commercial Mediator, since May 2005.

May 19, 2017

PROFESSIONAL EXPERIENCE BEFORE PRESENT POSITION

Partner, White & Case, London, 1999-April 2005;
Partner, Llewelyn Zeitman, London, 1996-99;
Solicitor, McKenna & Co, London, 1988-96;
In-house counsel, London International Financial Futures & Options Exchange, LIFFE, 1987-88;
Solicitor, Elborne Mitchell, London, 1986-87.

AREAS OF SPECIALIZATION (WHILST IN PRIVATE PRACTICE)

Contentious technology/IT: telecommunications/satellite; defence & aerospace/government contracting; information technology; data protection/privacy; outsourcing; automotive e.g. acting for the claimant in *LuK Leamington Ltd v Whitnash, Commercial Court 2002 1 Lloyd's Rep.6* (a case about the ownership and exploitation of motor transmission technology).

Contentious intellectual property: acting in confidential information/trade secrets, copyright, database right, design right, passing-off and trade mark disputes in a variety of areas e.g. acting for *DaimlerChrysler in DaimlerChrysler AG v Alavi 2001 R.P.C. 42*.

Defamation: acting in a number of corporate and individual defamation actions.

Data protection/technology/e-commerce related advisory work: general advice on transborder data flows; product development e.g. reverse engineering/decompilation/circumvention of technological protection measures; jurisdictional issues arising on the internet.

Litigation, international arbitration and mediation: in a variety of other fields, for instance, general contractual, banking (e.g. constructive trust, guarantee/indemnity claims); M&A (e.g. misrepresentation claims, minority shareholder actions, underwriting agreements); financial services (e.g. disputes between authorised persons and their regulator); commodities, FX and share trading disputes, some involving fraud; international trade (e.g. letters of credit, sale of goods); supply, agency and distribution agreements; publishing; professional negligence; judicial review (e.g. *British Security Industry Association v West Midlands Police Authority, 20 June 2002*); oil & gas (e.g. refining, area of mutual interest 'AMI' agreements); insurance and reinsurance; pensions.

Financial services: advised on regulator and exchange investigations and whilst in-house counsel at LIFFE, had responsibility for disciplinary matters and arbitrations, and advised generally on the regulatory regime set up under the Financial Services Act 1986.

MEMBERSHIP IN PROFESSIONAL BODIES

Past Chair, Mediation Committee of the IBA;
Former Vice-Chair of the American Bar Association's International Mediation Committee;
Member, WIPO's Panel of Neutrals;
Member, CPR's Panel of Distinguished Neutrals;
Member, Court of Appeal Mediation Scheme (CAMS) panel of mediators;
Law Society (and Law Society accredited civil and commercial mediator);

EXPERIENCE IN INTELLECTUAL PROPERTY

Several copyright, trade mark, passing off, design right, database right and trade secrets disputes.
Licensing and outsourcing disputes. Technology related disputes arising out of engineering and IT projects.

MAJOR PUBLICATIONS

Author of the book, 'A Practical Guide to Mediation in Intellectual Property, Technology and Related

Disputes', published by Sweet & Maxwell in October 2006;

"The Resolution of IPR disputes in Asia: Litigation, Arbitration or Mediation?", paper given at Fordham University's Annual Conference on Intellectual Property Law and Policy, April 2006;

"Mediation – the framework in England and Wales", paper given at the IBA's conference in Prague, 25 to 30 September 2005;

"Breaks, Delays, Terminations, LD's and Force Majeure in MoD Contracts", seminar for The Defence Manufacturers Association, (half-day seminar), London 2005;

"European Regulatory Review", BNA's Privacy & Security Law Report, July 2004;

"Sweet talk – Should warring parties be forced to mediate (PDF)", The Lawyer 23 February 2004;

"The Legal and Contractual Protection of Know-How", paper given to Computer Law Association Conference, Munich 2003;

"IP Rights as a Business and Legal Tool", paper given to the European Company Lawyers Association (ECLA) Conference, September 2003;

Intra-Group Transfers", transcript of talk published in BNA Privacy & Security Law Report - July 2003;

"The Protection of Commercial Trade Secrets", European Intellectual Property Review (2003) E.I.P.R. Issue 10;

"Commercial Trade Secrets", The European Intellectual Property Review Conference, London 2002;

"Delay and Termination of Ministry of Defence Contracts", seminar for The Defence Manufacturers Association, (half-day seminar), London 2002;

"The Protection of Know-how", paper given to the Computer Law Association Conference, Paris 2002;

"Secrets, Strategies and Proposals for Reform in the UK", Computer and Telecommunications Law Review, Vol. 8, Issue 8, (2002), CTRLR;

"Internet Relation Litigation in the EU", paper given to the Computer Law Association, Conference Lisbon 2001;

"Consumer Protection in E-commerce-An EU Perspective", paper given to the Computer Law Conference Association – Milan 2000;

"Arbitration Agreements – Avoid the pitfalls", Trading Law and Trading Law Reports, Nov/Dec 1997, Vol. 16, No. 6.

EXPERIENCE IN IP/IT COURT LITIGATION

Has acted on behalf of manufacturers/IT services companies in a variety of sectors but particularly the defence & aerospace, automotive, healthcare and telecommunications/satellite sectors;

Has acted for clients in a number of High Court actions many of which have been reported, e.g. *Daimler Chrysler Ag v. Alavi. 2001, R.P.C. 42.* (a trade mark action) and *LuK Leamington Ltd. v. Whitnash 2002 1 Lloyd's Rep.6* (a dispute concerning the licensing of a large patent portfolio in the field of automated clutch and transmission systems). Has also acted in several commercial matters.

PROFESSIONAL TRAINING IN MEDIATION & ARBITRATION

CEDR Accredited and Registered Mediator;

ADR Group Registered Mediator; Advanced Mediator Training Course;
Attended Workshop for Arbitrators run by the Arbitration and Mediation Center of WIPO;
Member of Chartered Institute of Arbitrators.

EXPERIENCE IN MEDIATION

A CEDR accredited independent commercial mediator and has mediated regularly for many years.

With experience of over 400 mediations, Jon is recognized as one of the top mediators in the UK by the Chambers & Partners and Legal 500 directories, the two leading independently researched legal directories published annually.

Jon set up his own mediation practice in May 2005, after almost twenty years as a solicitor in private practice, the last six as a partner in the disputes group of White & Case in London.

Jon has acted as an expert in mediation and regularly teaches on mediation training programs.

A panel member of the Court of Appeal mediation scheme and past Chair of the Mediation Committee of the International Bar Association.

Former Vice-Chair of the American Bar Association's International Mediation Committee and a member of CPR's Panel of Distinguished Neutrals.

Author of the book, "A Practical Guide to Mediation in Intellectual Property, Technology & Related Disputes" published by Sweet & Maxwell in 2006.

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.

Jon has undertaken some very large (e.g. £billion+) IT/Technology mediations where process design (beyond the standard one day mediation) was a key ingredient.

Examples of mediations undertaken include:

IT/Technology/Telecoms

A two-day mediation concerning a master software licence and services agreement in the financial services field involving a foreign public corporation (c. £70 million).

A mediation in Washington D.C. arising out of a dispute in the insurance sector following a merger and concerning the scope of a licence agreement (c. £15 million).

A mediation over 4 days arising out of the implementation of a CRM system (c. £1.4 billion).

A dispute concerning the failed development of a new telecoms service (c. £500k).

A two day mediation between a public body and a major service provider in relation to an allegedly failing procurement outsourcing project, with the dispute focusing on level of savings achieved and calculation of the share of those savings between the parties (c. £15 million).

A mediation between prime contractor and sub-contractor over additional costs arising from an upgrade of software and hardware project for a major utilities company.

A dispute between technology companies over an 'epidemic' failure of components.

A dispute arising out of the design and manufacture of a vehicle telematics system.

A technology dispute between a foreign public corporation and a major IT supplier (with insurers being separately represented) mediated over two days, the mediation being preceded by one day of meetings with

the parties (individually) and several conference calls during the previous few months (c. £45 million).

A dispute concerning the assessment, provision and cost of additional bandwidth under a master services agreement and the representations and assumptions made around network sizing.

A dispute arising out of the supply of an electronics system to manoeuvre safety critical components within a passenger aircraft (c. £2 million).

A multi-party mediation concerning ownership of certain enhancements made to software in the course of a defence related project and the scope of pre-existing licences in relation to original software.

A dispute in relation to a dark fibre agreement and co-location agreement, and the proper 'rating' of the co-location site.

Numerous licence agreement disputes over scope, usage etc.

A dispute concerning the design and supply of engine control units for racing car engines, raising issues, amongst others, relating to the design and reliability of printed circuit boards.

A telecoms dispute arising out of the acquisition of a third party telecoms company (c. £4million).

A dispute arising out of a software licence and master software, services and training agreement in the financial services sector following a takeover (c. £1.5 million).

A two day mediation concerning a ticketing and CRM system installed at a major football club's ground (c. £2m+).

A two day overseas mediation of a dispute concerning a multinational insurance company arising out of a multi-jurisdictional licensing dispute (c. several £million).

A dispute between a public authority and a technology company concerning the development of smartcard technology for several public sites, the mediation taking place over two days (c. £1million+).

A telecoms dispute concerning the supply of a telecoms service to a business and the transition from copper wire to fibre (c. £400K).

Outsourcing, franchising and leasing disputes

A dispute between a retailer and service provider operating a call centre and warehousing facility concerning service level agreements, charging structures and termination.

A mediation involving a major airport arising out of an outsourcing contract (c. £2.5 million).

A dispute arising from the outsourcing by a manufacturer of aircraft of its IT function for a number of its sites, and the catastrophic failure of a material requirements operating system and data base.

A mediation arising out of the outsourcing of the order fulfillment and customer contact function of a major retail chain.

A two day mediation between a public body and a major service provider in relation to an allegedly failing procurement outsourcing project, with the dispute focusing on level of savings achieved and calculation of the share of those savings between the parties (c. £15 million).

An accounting dispute at the end of a major outsourcing contract involving a public body and concerning profit sharing mechanisms, pensions (Local Government Pension Scheme Rules), allocation of savings, application of central government grants and reasonable endeavors clauses.

A three party mediation between lessor, lessee and a finance company in relation to the leasing of IT equipment, with the precise obligations imposed under the various agreements between the parties in relation to delivery of equipment being the subject of dispute (c. £150K).

A case concerning repairing obligations under a lease of industrial equipment.

A dispute between an international franchisor and one of its franchisees operating in a number of jurisdictions (c. £4 million).

Competition

A mediation of a parallel imports/exhaustion of rights case concerning the importation of new and re-engineered computing equipment into the EU.

A case concerning consent given by a licensee/authorised distributor of a trade mark owner (an economically linked undertaking) for the placing of product by another on the market in the EU.

A case concerning alleged abuse of a dominant position (art. 102 TFEU) and agreements restricting competition (art. 101 TFEU).

A mediation of a parallel imports case concerning quantum only, following summary judgment granting an injunction and an order for disclosure, and prior to an election by the claimant between an account of profits and an enquiry as to damages.

Confidential Information

A multi-party mediation concerning misuse of confidential information, breach of fiduciary obligations and breach of contract (c. £1 million).

A confidential information dispute in the healthcare sector arising out of the departure of minority shareholders/directors.

A three day mediation arising out of a breach of confidence dispute which included an exercise verifying deletion of confidential material from various databases at different locations.

An account of profits claim arising out of the alleged misuse of confidential information concerning a corporate acquisition opportunity.

An alleged conspiracy between a former director and others to misuse/destroy valuable commercial information.

A dispute concerning alleged misuse of a number of design drawings prepared for the concept stage of a major construction project.

A multi-party mediation involving several parties spread over two high court actions concerning the misuse of confidential information, breach of fiduciary obligations and breach of contract (c. £1 million).

Numerous mediations of claims against former directors/employees of businesses, or contractors for misuse of confidential information in a variety of sectors, including engineering, house building, defence, waste management etc.

Patents

A patent entitlement case (Section 37 Patents Act claim originally before the Comptroller and then transferred) in respect of a product used in the construction industry. One party alleged that it designed the invention embodied in a patent granted to the other party, or in the alternative that it was a co-owner. The registered proprietor argued that the party claiming entitlement had not made any inventive contribution.

A claim for compensation under Section 40 Patents Act by a former employee inventor. Whether the patent was of benefit to the proprietor, and its value (to the proprietor) were issues for debate as was the claimant's contribution to the invention so as to consider the 'fair share' (c. £2 million).

Mediation of a patent dispute involving claims of infringement of a UK and US patent with proceedings in

both jurisdictions.

Mediation of a claim seeking a Declaration of non-infringement under Section 71(1) of the Patents Act and also a Declaration pursuant to Section 64 (continuation of use).

A patent infringement action in the medical devices field against numerous defendants. The claim was met with a defence of non-infringement (involving arguments on construction) and a counterclaim for invalidity based on lack of novelty (elements in inventive concept contained in an earlier patent) and also lack of an inventive step (prior art at the time of filing combined with common knowledge suggesting the inventive concept claimed was obvious). There were also arguments over commercial success and what the evidence demonstrated in terms of long felt want as secondary evidence of inventiveness.

Mediation of a groundless threats action.

A patent infringement claim in relation to an article used in the FMCG sector culminating in extensive contractual undertakings being given in return for an agreement not to assert the patent for a specified period of time to enable a sell through period.

A mediation in the financial services field involving an analysis of prior art relevant to each function and concept claimed in the patent said to be infringed.

Several patent licensing disputes e.g. breach of minimum royalty provisions, breach of confidentiality restrictions, exploitation by licensee of 'improvements' to patented articles etc.

A joint venture dispute concerning an assignment of a portfolio of patents, with argument focusing on whether patents omitted from the assignment were relevant to a particular area of technology.

A mediation arising out of EPO Appeal proceedings, (the alleged infringing party attempting to narrow or revoke in its entirety a patent on grounds of lack of novelty and obviousness), infringement proceedings and a claim for a declaration of non-infringement.

An patent dispute between 'household name' competitors in the luxury products market.

A patent infringement/invalidity dispute in the manufacturing sector.

Mediation of a dispute concerning a well known medical product arising out of a deed of assignment of patents and an associated commercialisation agreement, a subsequent broader assignment of associated IP and the impact of expiry of patents on certain revenue sharing arrangements (c. 750k).

Design Right

A dispute between competitors in the luxury goods market concerning community and national registered design rights and unregistered design right.

A mediation of an unregistered design right infringement claim in the fashion sector with discussion focusing on surface decoration/shape & configuration, substantial copying, prior art/common place design features and, in relation to damages, infringing elements and the 'essential ingredient' of the product.

A registered and unregistered design right dispute in the FMCG sector with discussion focusing on the essential or significant features of the registered design with regard to the statement of novelty, prior art and functional exclusions.

A registered and unregistered design right dispute in the travel products sector raising various issues including common place design, and whether a particular design is excluded from protection because it is a method or principle of construction.

A dispute concerning electrical products in which copying of unregistered design right was alleged, raising numerous issues including prior art, commonplace design, features being a method or principle of construction or allowing fit with another product, surface decoration, non-copying.

A claim of infringement of community registered design right raising issues of invalidity for lack of novelty and individual character over prior art, and non-infringement based on differing overall impression.

Trade Marks, passing off and comparative advertising

A trade mark dispute between two household name technology companies arising out of their respective development of sub-brands, with infringement of a CTM and passing off alleged.

A trade mark mediation concerning a significant high street brand and the co-existence of two owners of the same 'split' trade mark, the dispute involving multiple jurisdictions and trade mark revocation, opposition and infringement proceedings in each (c. £2 million).

A multi-jurisdictional trade mark dispute between owners of two iconic brands involving infringement, revocation and invalidity claims brought by each against the other in the UK High Court, OHIM, The General Court of the European Union, the Chinese Trade Mark Office and in over 50 other countries around the world.

A dispute over 'switch selling' of alcoholic beverages giving rise to trade mark infringement and passing off claims.

A dispute between competitors arising out of a comparative advertising campaign raising various issues under the EU Directive on misleading and comparative advertising (2006/114/EC).

A trade mark dispute between a multi-national drinks group and a retailer arising out of a seasonal promotion in which a variety of issues were raised including, in relation to 'detriment' under s10(3), the ASA's CAP code and the Portman Group Code of Practice.

A trade mark licensing dispute between a major chain store and a well-known brand owner over the manner in which various trade marks protected by a number of CTM's were used/developed (c. £5 million).

Mediation of a trade mark infringement action (Sections 10(1), 10(2) and 10(3) TMA 1994), a passing-off action, and opposition and revocation proceedings in the IPO, between a hotel chain and financial institution.

Mediation of a multi-faceted trade mark dispute between media companies including appeals to the High Court against decisions of the trade marks registry refusing in part various applications for figurative marks, invalidity proceedings and infringement proceedings.

Claims between food manufacturers arising out of the packaging/get up of certain food products involving groundless threats, declarations of non-infringement, partial revocation, injunctions and damages/accounts of profits.

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

A trade mark dispute between International publishing houses.

A dispute between a household name international franchisor and one of its franchisees operating in a number of jurisdictions, including issues in relation to the use of various trade marks.

A dispute between a major fashion brand and a food manufacturer concerning the use of the former's trade marks in a competition run as part of an advertising campaign for the launch of a new product.

A trade mark action between a generic manufacturer of a pharmaceutical product and a market leading brand.

A mediation dealing with quantum of damages for trade mark infringement, an area of contention being the recoverability of lost profit on goods commonly sold along side the protected articles (Gerber v Lectra principles).

Several other trade mark infringement, validity and royalty disputes in a variety of sectors e.g. publishing, franchising, engineering & construction, food & beverages, furniture, technology, IT, motor, film, telecoms, fashion etc.

Copyright and Database rights

A multi-party dispute concerning the exploitation of sound recordings and the back catalogue of a major rock star.

A dispute concerning alleged joint ownership of code and artwork for an internet portal.

A database copyright dispute raising numerous issues including the level of intellectual creativity required under the Database Directive (96/9/EC), and various other issues under that Directive and the E-Commerce Directive (2000/31/EC).

A dispute between housebuilders concerning alleged infringement of copyright in house designs raising issues of ownership, level of originality required for copyright works and the extent of reproduction required for infringement.

A claim by a software house against a financial institution for database right and copyright infringement raising various issues in relation to pre-existing software or 'background', and bespoke software or 'foreground', the scope of licences and contracts for development and subsequent support.

An action brought by a software house against an alleged supplier of counterfeit software following various arrests and execution of search and seizure orders.

A claim by a software house against a financial institution for database right and copyright infringement raising various issues in relation to pre-existing software or 'background', and bespoke software or 'foreground', the scope of licences and contracts for development and subsequent support.

A multi-party dispute concerning incorporation of data into a third party database involving claims for delivery-up, injunctions etc.

A dispute concerning alleged misuse of a customer account database.

Film and Entertainment (including gaming)

A dispute arising out of the development, production, distribution and marketing of a series of films in the animation sector (£8 million).

A dispute between a film production company and an advertising agency concerning the making of a film for a major high street chain store (c. £750k).

A dispute between a software house and a gaming TV channel over the running of a gaming platform and revenue sharing arrangements (c. £500k).

A dispute concerning the scope of rights granted by an author to a publisher and whether such rights extended to online exploitation.

A licensing dispute arising out of broadcasts by a number of film channels.

A dispute between a major TV production company and an entertainment company arising out of their collaboration and the development, production and distribution of, and finance for, a series of animated films and their subsequent exploitation.

A dispute between a content provider and a cable network arising out of the launch of a new channel, the central issue being the quality of content and programming.

A dispute arising out of a collaborative development and cross-licence agreement in relation to online interactive gaming.

A dispute arising out of the funding arrangements for a spin-off music label established to exploit a large catalogue of recordings and to acquire further catalogues.

A mediation between a film production company and an entertainment company arising out of the budgeting for and making of a series of short films, the essence of the dispute being a considerable overrun on production costs.

A dispute arising out of an internet advertising agreement.

Sports

A mediation between the governing body of a sport and a PR company concerning sponsorship for tournaments in the UK and overseas (c. 250k).

A dispute between a major football club and a sports agent (c. £500k).

A breach of contract claim arising out of the broadcast of a major sporting event (c. 100k).

A dispute between a professional sportsman and his trainer over the basis of entitlement to remuneration (percentage of net revenue or fixed fee).

A dispute over the promotion of a major sporting event and exploitation of rights granted to various third parties.

A dispute over broadcasting rights the subject of a rights acquisition agreement.

A multi-party mediation following cancellation of a major sporting event and the insolvency of a contracting party.

Domain Names

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

Defamation

Defamation and malicious falsehood claims arising out of a radio broadcast (c. £2 million).

A dispute arising out of publication in print and online of allegations of professional misconduct.

A dispute arising out of comments posted on a website.

A mediation between two competitors in a small market sector arising out of an alleged malicious falsehood.

An unfair dismissal claim brought by a senior employee arising out of alleged protected disclosures, also involving a defamation claim.

A dispute arising out of the publication, in print and online, by a faith based organisation, of an article suggesting that certain beliefs were held by a high profile member of a community.

Miscellaneous

Regularly acting as a mediator in general commercial disputes and in those arising in various other sectors, for instance:

Art and cultural heritage – a claim arising out of a high profile auction concerning its marketing, cataloguing of articles, disputed provenance, etc (c. £5 million).

Banking and insolvency - 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.

Counterfeiting – an action brought by a rights owner following various arrests and execution of search and seizure orders.

Defence & Aerospace – a mediation concerning aircraft leasing and asserted liens (c. £400K).

Engineering/construction - 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.

Healthcare (Regulatory) – disputes concerning marketing authorisations (MHRA), SmPC's and PIL, livery applications (Article 61 notifications, Directive 2001/83/EC); clinical trials; dispute over funding of medical research involving various institutions.

Miscellaneous - 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.

Professional negligence - 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.

EXPERIENCE IN ARBITRATION

Has acted in a number of ICC, LCIA and ad hoc international arbitrations in a variety of fields, including the automotive industry, the oil & gas sector, the banking sector, the defence and aerospace sector and the telecommunications industry;

Has also acted in commodity exchange arbitrations (e.g. under the London Metal Exchange "LME" rules);

Has acted as the "secretariat", running the disciplinary proceedings and arbitration schemes at "LIFFE" (the London International Financial Futures Exchange) arbitrations while in-house counsel.

MEDIATION EXPERIENCE**SUMMARY TABLE**

Type	Administering Institution		Role	
	Name	Number of Mediations	Mediator	Counsel
International Mediations (estimates)	WIPO	2	2	0
	CEDR	20+	18+	2
	ADR Group	30+	30+	0
	Ad hoc	210+	200+	10
Number of cases: sub-total		262+	250+	12
Domestic Mediations (Estimates)	CEDR	32+	30+	2
	ADR Group	16+	15+	1
	City Disputes Panel	1	1	
	Court-annexed	3	3	
	Ad Hoc	154	149	5
Number of cases: sub-total		206+	198+	8
TOTAL		468+	448+	20