

Curriculum Vitae

Name : **Ashley Wentworth Roughton**

Address : 10 The Orchard Telephone : + 44 20 87 42 15 04 (l)
Bedford Park + 44 79 56 53 23 07 (m)
London
W4 1JX

e-mail : ashley@roughton.net skype : roughton.ashley

w³ : ipchambers.eu

Summary :

Graduate chemist and master's level degrees in economics of competition and regulation and biochemistry with a PhD in applied mathematics and engineering. Author of the two standard and top recognised texts in patents and trade marks and with over 28 years litigation experience as well as a strong transactional and pharma practice. Regularly cited as the top Data Protection and a top Intellectual Property lawyer in the UK. Has, save one, never lost a criminal intellectual property or pharma case.

I am called to the Bar of the Republic of Ireland so that I can maintain a Euro practice after Brexit. I have practicing certificates and am insured to practice in England & Wales, Northern Ireland and the Republic of Ireland.

I hold dual UK/US nationality.

More detail :

Working in independent intellectual property practice at the Bar of England and Wales (called October 1992), the Bar of Northern Ireland (called November 2000) and Eire (called July 2017). Periodically licenced to Practice in the Isle of Man. Standing Prosecutor for the Bar Council on disciplinary matters. Visiting Professorial Fellow at the University of London in competition law and intellectual property and member of the departmental exam board. Council Member of AIPPI. Member of the editorial and educational boards for the publication Privacy and Data Protection. Fellow of the Biochemistry Department at Birkbeck, University of London.

I am not now a member of any set of barrister's chambers and practice on my own account when time permits.

Recent Past: see my website ipchambers.eu for up to date information.

The Past

4/2018-10/2019	Private practice at the bar. Standing counsel to Alzheimers Research UK and the British Heart Foundation. Fellow in the Department of Biochemistry, Birkbeck, University of London. Working on IT hosting and IoT contracts, design right and patent cases, fending off data subject access requests and a major storyline (<i>i.e.</i> non textual copying) copyright case.
11/2016 4/2018	Lawyer at Venner Shipley LLP, patent attorneys working principally on cyber fraud, technologies involving the ethernet, the blockchain and bitcoin, regulatory pharma and life sciences (principally Alzheimer's disease and ibandronic acid). I worked as trial advocate on OR air conditioning patent infringement, ethernet multiple data link layer patent, 5(4)(a) trade mark interference and a damages enquiry relating to unlawful threats in a patent case. I advised medical charities on compliance with the Human Medicines

Regulations.

2/2015	11/2016	Senior Consultant at Nabarro LLP, Solicitors with partnership responsibility: life sciences, patents, trade marks and data protection (incl. cyber security). I appeared in the CJEU and G-C very regularly. I worked on a number of “pay for delay” cases before the CMA. Clients included HCA, GSK, ViiV, Teva, all with a mix of issues from wholesale and brokering licencing under the Human Medicines Regulations, dossier titivation, CRO outsourcing and corporate support (IP and pharma) to regulatory data protection and orphan drug issues. Regular attendee at the Euro Pharma Law Conference, Brussels.
9/2014	2/2015	Representing claimant in confidential information and copyright case concerning seismic data exclusivity. Representing the estate of an artist of significant repute in proceedings concerning copyright entitlement. Representing a software developer in proceedings regarding entitlement and copyright ownership. Representing various large institutional clients in data protection. Standing counsel for a large telecommunications and satellite broadcasting organisation. Representing large physical package transit company (as claimant) on passing off and trade mark infringement. Representing large tobacco company (as claimant) on passing off and trade mark infringement.
8/2013	8/2014	Working as external counsel for Pillsbury Winthrop Shaw Pitman LLP (though not as an employee of Pillsbury). Represented insurance company against its bankers for misuse of confidential information and breach of privacy rules (case heard and won). Representing a software and hardware services purchaser in proceedings regarding quality of service in a large scale migration for a large institutional client.
10/2012	8/2013	Working as external counsel for Gowlings (UK) LLP. Prepared for appearance in the Supreme Court on criminal aspects of Broadcasting (now won). Instructed as standing counsel for a large broadcasting organisation. Completed a trial on extended passing off in relation to Greek Yoghurt and a trade mark trial concerning relative grounds and the local nature of the passing off objection. Recently fought and won appeal on landlord and tenant data protection case for large institutional lender.
09/2011	10/2012	Standing counsel for LOCOG and the IOC during the London 2012 Olympic and Paralympic Games. I advised and represented LOCOG in relation to a range of IP, sponsorship, licensing, ambush marketing, anti-counterfeiting, advertising, merchandising and new media issues.

Case load:

Criminal Case load	– 15-20% of my practice year.
Intellectual Property	– 60% of my practice year.
Other	– 10-20 % of my practice year.

Degrees:

B.Sc. (Eng)(Hons)(Lond), 2:1.
Ph.D. (Cantab), pass with minor revision.
Dip.Law. (Westminster), pass.
Bar Finals, competent.
Barrister-at-Law (Northern Ireland).

Barrister-at-Law (King's Inn).

M.Sc (Econ)(City), pass.

B.Sc (Hons)(Mol Sci)(Open), 2:1 (quantum mechanics, peptidomimetic drugs and molecular biology specialisms).

M.Sc (Biochemistry)(Lond), distinction.

Practice summary:

- Advocacy:** I have appeared regularly in the Court of Justice of the European Union (where, following Brexit, I retain rights of audience), the General-Court, the Court of Appeal (both criminal and civil), the High Court (Chancery and Queen's Bench Divisions), the Divisional Court (both civil and criminal), the County Court (both general and patents) the Crown Court, the magistrates' court, the trade marks registry and the patent office. I have also appeared in lengthy criminal cases concerning, breaches of the Human Medicines Regulations (for some reason always in Birmingham – hey ho), counterfeiting and piracy and usually for large institutional defendants.
- Drafting:** In the last 18 months: software licence agreements, patent research and CRO agreements, COVID-19 technology patents and cooperation agreements relating thereto, entitlement proceedings, patent funding agreements relating to peptidomimetics in AD research, conditional patent assignments, gene/drive licencing, multi party processing agreements with overseas element, data licencing agreements relating to clinical trial data, licencing packaging technologies, academic research agreements (private, Horizon 2020, Innovate UK and charities), IP and DP aspects of corporate transactions, with and without SLAs, TK licencing agreements, inter corporate innovation collaboration agreements (with entitlement issues), DPO appointment agreements, co-branding and trade mark licencing agreements, design and copyright licencing agreements. In dispute resolution: settlement agreements and associated Tomlin orders, mediation agreements & mediation settlement agreements and arbitration agreements.
- Intellectual property:** patents (mechanical, chemical and life sci), SPCs, trade marks (both registered and passing off), breach of confidence and restraint of trade, competition generally and also involving either a technical element or intellectual property, copyright (media, entertainment, industrial designs and fashion), licensing of all types, crime (prosecuting and defending section 107 (piracy), 92 (counterfeiting) and 297 (unlawful reception) matters as well as consumer protection matters) and matters with a technical content, registered and un-registered designs, semiconductor topographies, border and customs controls. Intellectual property aspects of European law and competition and the jurisdiction and judgments regulation.
- Data protection:** both criminal and civil (in court and before the Information Commissioner and Information Tribunal), data subject and data controller issues, private investigator and dustbin delving issues (including questions relating to solicitors and insurers instructing private investigators and maintaining fraud or fraud detection databases). I am on the exam board for PDP training's practitioner certificate in Data Protection. Advising the UK government on drafting issues relating to the 2018 Act.
- Other:** Sale of goods and commercial agency questions. Medicines control (both applications for licences and authorisations, licensing and criminal aspects). Computer related crime, computer related contracts and contracts of a complex or technical nature, Computer misuse, cyber security and data protection. I have both prosecuted and defended a variety of computer related criminal actions

brought at the behest of a number of organisations including the CPS, the Business Software Alliance, The Federation Against Software Theft and the Serious Fraud Office. I am a member of the Federation Against Software Theft Legal Advice Group.

Books/Publications:

Current senior editor and contributing author with Trevor Cook of Bird & Bird Solicitors and Philip Johnson of Lexis Nexis Modern Law of Patents. Published 2008 (1st Ed), 2010 (2nd Ed), 2014 (3rd Ed) and 2018 (4th ed).

Current co-author with Christopher Morcom *Q.C.*, and Tom St Quintin on the Modern law of Trade Marks published by Lexis Nexis. Published 1999 (1st Ed), 2005 (2nd Ed), 2008 (3rd Ed), 2013 (4th Ed) and 2016 (5th Ed). Just going into 6th ed.

Current co-author with many others on the patents and competition chapter of the CIPA guide to the Patent Acts published by Sweets 2016.

Current editor of the Green Book (Civil Court Practice) working on intellectual property. Published annually with supplements.

Erstwhile co-author with Guy Tritton on Intellectual Property in Europe relating to jurisdictional matters. Published 2002 by Thompson Sweet & Maxwell, now in a 4th edition - 2014.

Erstwhile author of the sections on Patents, Trade Marks and Copyright and Designs in the Lawyer's Remembrancer published by Butterworths. Now out of print.

Contributing author to "Trade Mark Use" (Chapter 11: "Permitted Infringing use: The Scope of Defences to an Infringement Action") edited by Jeremy Phillips and Ilanah Simon, OUP, published 2005.

Erstwhile contributing author to "Bellamy and Child on European Community Law of Competition" (Chapter 9: Intellectual Property Rights") edited by Peter Roth *Q.C.* and Vivien Rose, published 2007 with supplements.

Papers:

Year in Review: European law. (2002) 36 Int'l Law, pp 855-877.

"OPAP Explained" (2005) 5(4) Privacy & Data Protection, pp 5-7.

"Dirty Work - criminal aspects of bin trawling" (2009) 9(5) Privacy & Data Protection, pp 12 & 13.

"Football in pubs – Court of Justice of the European Union (Grand Chamber), *Football Association Premier League Ltd and Others v QC Leisure and Others (C-403/08)* and *Karen Murphy v Media Protection Services Ltd (C-429/08)*" (2012) 2(3) Queen Mary Journal of Intellectual Property, pp 288-296.

"The New Customs Regulation in border controls concerning counterfeit, pirated and bootleg goods" (2014) 4(2) Queen Mary Journal of Intellectual Property, pp 156-159.

"HGS: where are we now with SPCs" LSIPR Newsletter 10:14, November 2014.

"Google and the 'right to be forgotten' — setting the record straight" (2014) 14(8) Privacy & Data Protection, pp 6 & 7.

"The interplay between CRISPR and the Biotech Directive" LSIPR, March 2016.

"*R v C* in the UK Supreme Court – should parallel importation be criminalized?" (2018) 8(2) Queen Mary Journal of Intellectual Property, pp 156-168.

"iConsent and pesky emails – why 'do nothing' is the sanest approach" (2018) 18(6) Privacy & Data Protection, pp 4-6.

“Cooper: a basis for processing” (2019) 19(4) Privacy & Data Protection, pp 13-15.

“Rudd v. Bridle and another — pleading guidance in data protection cases” (2019) 19(6) Privacy & Data Protection, pp 15-17.

Other:

Cited in the Legal 500 (2003) as having an “impressive reputation.” and mentioned as leading junior and in Chambers & Partners (2003) as a “rising star who has demonstrated skill in numerous summary judgments”.

Cited in Chambers & Partners (2004) as having an “acute analyses of problems relating to criminal IP work for copyright and trademarks”.

Cited in the Legal 500 (2005) as a leading junior and as having had “another busy year”.

Cited in Chambers & Partners (2006) as “Impressive” and “‘stands out from the crowd’ especially when dealing with criminal and counterfeiting matters.’. Also cited as being in the 3rd division of leading juniors.

Cited in Chambers UK (2007) as doing “all aspects of IP law” being in the 3rd division of leading juniors.

Cited in Chambers UK (2008) as “Known for being quick on his feet and “good at responding to requests for advice promptly in a short time and offers ready and detailed knowledge of customs procedures relating to counterfeit goods” being in the 3rd division of leading juniors.

Cited in Chambers & Partners (2010) as “[enjoying full market confidence and] ... an IP heavyweight with undoubted technical knowledge. Roughton's caseload spans civil and criminal IP matters, in addition to data protection litigation.” Also cited as being in the 3rd division of leading juniors.

Cited in Chambers & Partners (2011) “Ashley Roughton has a broad practice that takes in both technically demanding patent work and complex trade mark litigation. He is known for his discreet handling of sensitive issues, and in recent times he has been engaged in a series of disputes relating to design rights of various types.” Still cited as being in the 3rd division of leading juniors. One can but try!

Cited in Chambers & Partners (2012 & 13) “Ashley Roughton has a niche in criminal IP proceedings concerning counterfeiting and piracy, for which he has an all but unmatched record in securing acquittals. He is at home with briefs for cases involving design rights, patents and trade marks. ” Still in the 3rd division of leading juniors!

Cited in Chambers & Partners (2012 & 2013) - top tier in data protection.

Citations : Cited in Chambers & Partners (2014) “Rated highly for his niche expertise in border control, criminal infringement and counterfeiting cases. He is noted for his practical approach and masterful knowledge of his areas of expertise.” and "The best for anything relating to criminal anti-counterfeiting work - precisely who you wouldn't want to see on the other side." "A walking encyclopaedia of case law." - band 2 (wow!).

Hobbies/personal: I used to have many; now it is just triathlon – relentless.