

# EXPERT REVIEW GROUP

**The Expert Review Group (ERG) is concerned with quality control in the Dispute Resolution Service (DRS) Expert decisions. Each fully reasoned decision will be reviewed by a member of the ERG before it is published. The ERG member will review the draft decision and provide feedback to the expert. However, the expert will remain responsible for the decision and will not be required to make any changes to the draft decision that they do not wish to make.**

This helps make sure that decisions are consistent with the DRS Policy and previous decisions. The ERG members are also responsible for forming the panel which hears appeal cases.

## **WHY DOESN'T NOMINET CHECK THE DECISIONS?**

We are neutral in the DRS and do not take a view on decisions. The Experts are independent, so it is better if they are self-regulating. However, in the rare cases where a complaint is received about an Expert or their decision, then we may raise that with the Chair of the Expert Review Group.

## **WHO ARE THE MEMBERS OF THE EXPERT REVIEW GROUP?**

There are five members of the Expert Review Group:

- [Nick Gardner](#)
- [David King](#)
- [Ian Lowe](#)
- [Claire Milne](#)
- [Phillip Roberts](#)

## **NICK GARDNER (CHAIR)**

### **Occupation**

Solicitor: Intellectual Property Consultant

### **Education**

1985 Bachelor of laws degree, University of Nottingham (1st class Honours)

### **Professional**

1988 Admission as a Solicitor of the High Court in England

1994 Partner at Herbert Smith, Solicitors

2012 Independent Consultant

### **Professional Appointments/Memberships**

Solicitor of the Senior Courts of England and Wales



Solicitor Advocate with rights of audience in all civil proceedings.

## **General**

Nick Gardner practised as a lawyer with leading international law firm Herbert Smith LLP in London for over 25 years.

He was a partner in its intellectual property and technology practice for 18 years, latterly with 7 years as world wide head of the intellectual property group. Prior to joining Herbert Smith he obtained a first class honours degree in law from the University of Nottingham. Law was a second career for him having originally studied electrical engineering and then worked for a number of years in the computer business. His legal practice was predominately in the application of law to technology in the electronics, computing, telecommunications and internet areas, mainly but not exclusively in contentious

disputes/litigation. He handled cases in the UK in the Patents Court, Patents County Court, Chancery Division of the High Court, Commercial Court, Data Protection Tribunal and the Court of Appeal.

He also has been extensively involved in proceedings in many other jurisdictions. In addition he had wide ranging arbitration and mediation experience. Amongst the many clients he acted for were such well known names as Amstrad, British Gas, BSkyB, the FIA, Harrods, IBM, Intel, the Motion Picture Association, Nokia, and Unilever.

He is an appointed expert by both Nominet and WIPO in respect of internet domain name disputes. In 2012 he retired from Herbert Smith to pursue a number of other interests including acting as an independent expert and mediator in respect of intellectual property and technology disputes.

## **DAVID KING**

### **Occupation**

Solicitor: Law Society Adjudicator

David is a solicitor (non-practising).

He was admitted in 1975 and spent the next 18 years in private practice before joining The Law Society in 1993. He was a departmental manager between 1994 and 1998 and then became a Senior Advisor in the Clients Relations Office (the predecessor of the Legal Complaints Service) which dealt with complaints about the service provided by solicitors and disputes regarding solicitors' costs under the Remuneration Certificates procedure.

In 2000 David was appointed as an Adjudicator and was responsible for making formal decisions on the outcome of service complaints against solicitors, Remuneration Certificates and conduct and regulatory matters for both the Solicitors' Regulation Authority and the Legal Complaints Service.

David has been a member of Nominet UK's Panel of Experts since its inception in 2001. In 2008 he became a member of Nominet's Expert Review Panel which reviews Experts' first instance decisions before they are published and deals with any appeals against those decisions.

In April 2011 he was appointed a member of a Law Society Appeal Panel which decides the final outcome of applications by solicitors' firms to join one of The Law Society's quality accreditation schemes.

## **IAN LOWE**

### **Occupation**

Solicitor: Intellectual Property and Technology Consultant

### **Education and Qualifications**

- MA (Cantab) Law, Sidney Sussex College, Cambridge
- Admitted as a solicitor 1978

### **Career History**

- 2001 to date - Consultant (formerly Partner), Intellectual Property Group, Nabarro LLP, Solicitors
- 1981 - 2000 Associate and Partner, Berwin Leighton, Solicitors

### **Membership of Professional Bodies**

- European Trade Mark Owners Association (MARQUES)
- Member of the Chartered Institute of Arbitrators
- CEDR Solve Mediator, Centre for Effective Dispute Resolution
- Associate Member Institute of Trade Mark Attorneys
- Intellectual Property Committee of the City of London Law Society
- Intellectual Property Lawyers Association

### **Areas of Specialisation**

Advising on all areas of contentious intellectual property issues, including trade marks, patents, copyright, design right and registered designs, as well as domain name, e commerce and other technology disputes.

### **Litigation Experience**

Wide-ranging litigation experience, acting for both UK and international technology companies, brand owners, retailers and Internet investors.

## **CLAIRE MILNE**

### **Occupation**

Telecoms Consultant

Claire Milne is an experienced independent telecoms policy consultant, active both nationally and internationally. She has worked closely with UK consumer organisations and sat on a number of public bodies. She is involved with the internet as an enthusiastic user, consumer representative, and policy adviser. She has had a continuous close involvement since 1983 with UK telecoms regulation, and has a good general knowledge of relevant topics in many other countries, and especially of the

evolving European scene. She is a Visiting Senior Fellow and Guest Teacher in the Department of Media and Communications at the London School of Economics.

Public bodies she has been involved with include the Essential Services Access Network (ESAN), a voluntary sector umbrella body concerned with the interests of low-income users of energy, water, communications and financial services; ICSTIS (now PhonepayPlus), the self-regulatory body for premium rate telephone information and entertainment services; the Internet Watch Foundation, which operates a hotline and take-down procedure for illegal material online; and the Telephone Helplines Association

(now Helplines Partnership), a registered charity, which exists to provide quality and confidence for callers to helplines in the fields of health, education and social welfare. Helplines are increasingly turning to the internet to enhance their services to users.

Having previously been an independent member of Oftel's expert Numbering Advisory Group, she chaired Oftel's Working Group on the Use of Numbers, which advised Oftel on codifying and where necessary changing users' rights and responsibilities in numbers, including potential trading rights. She continued to work with Ofcom, the successor to Oftel, from 2008 to 2014 chairing the Consumer Forum for Communications.

Trading since 1992 as Antelope Consulting, she works flexibly as an independent expert, team member or project leader. Most of her recent consultancy focuses on policies to promote the availability of phone and internet service in remote areas of developing countries, and their affordability to all income groups.

Claire's university education was in Mathematics (Cambridge) and Statistics (Imperial College). She enjoys languages: her French and Italian remain serviceable, and she plans to revive her rusty Russian and Greek when the opportunity arises. Her children were born in 1984 and 1988. When family commitments allow, she likes to explore interesting places in person.

## **PHILLIP ROBERTS**

Occupation: Barrister: Intellectual Property

### **Summary**

Date of call: 1996

email: [proberts@oeclaw.co.uk](mailto:proberts@oeclaw.co.uk)

Philip Roberts undertakes a wide range of intellectual property matters.

### **Scope of Practice**

His primary areas of practice include the following (in alphabetical order):

- comparative advertising
- copyright disputes
- data protection
- database rights disputes
- design right disputes

- information technology
- intellectual property licensing and franchising
- internet domain name disputes
- malicious falsehood/trade libel
- misuse of confidential information
- passing off
- patents dispute
- registered designs
- trade marks - application, opposition and infringement

## Experience

### Trade Mark/Passing Off

- Acting for Music Choice in an application to the Trade Marks Registry and subsequent High Court appeal concerning the construction of the newly amended Trade Mark Rules: **Music Choice Limited -v- Target Brands Inc.** [2006] R.P.C. 13
- Acting for PartyGaming Plc and its associated companies in an expedited application for interim relief to restrain parties in and outside the UK jurisdiction from deceptive provision of online gaming services: **(1) Partygaming Plc (2) Electraworks Limited (3) Iglobalmedia Marketing UK Limited -v- (1) Eli Dabosh (2) Caviner Limited (3) JD Lucky Skill Limited** [2005] EWHC 3090
- Acting for Reed Elsevier, resisting an interim injunction concerning comparative advertising in the field of online seminars for tax professionals: **Wolters Kluwer (UK) Ltd (trading as CCH) – v - Reed Elsevier (UK) Ltd (trading as LEXISNEXIS Butterworths)** [2005] EWHC 2053 (Ch)
- Acting for Nominet UK, resisting an interim injunction concerning the preservation of a domain name pending the conclusion of a vesting action: **Alliance Française de Londres Limited v Her Majesty's Attorney General** [2005] EWHC 3049
- Acting for Criminal Clothing in their Trade Mark Registry and subsequent High Court Appeal concerning the CRIMINAL and CRIMINAL DAMAGE trade marks: **Criminal Clothing Limited v. Aytan's Manufacturing (UK) Limited** [2005] EWHC 1303 and in ongoing parallel appeal proceedings before the Court of First Instance of the European Communities
- Acting for the defendants in a counterclaim for revocation of a trade mark on grounds of non-use: **Saft Aktiebolag -v- (1) HBL Nife (UK) Limited (2) HBL Nife Power Systems Limited**
- Acting for the claimants at the trial of a preliminary issue relating to the interaction between registered trade mark rights and passing off rights: **Inter Lotto (UK) Ltd v. Camelot Group Plc** [2003] EWCA Civ 1132; [2004] 1 WLR 95 (CA); and [2003] EWHC 1256; [2003] 3 All ER 191 (High Court).

- Acting for the claimant at the trial of a trade mark infringement action concerning the correct approach to partial revocation for non-use: **H Young (Operations) Ltd v. Medici Ltd** [2003] EWHC 1589; [2004] FSR 19 (High Court).
- Acting for the claimant at the trial of trade mark infringement and passing off proceedings in relation to a counterfeiting ring, and proceedings resulting in the subsequent committal to prison of one of the defendants for breach of disclosure orders: **Coca-Cola Co v. Aytacli** (Contempt: Committal) [2003] EWHC 91; [2003] 26(3) IPD 26016; and in a second action concerning the liability of further defendants raising defences of abuse of process: **Coca-Cola Co v Ketteridge** [2003] EWHC 2488; [2004] FSR 29.

### Information Technology/Contract

- Acting for the Defendant setting aside a without notice injunction relating to the sale of pre-pay telephone services: **Tele Wise Limited v Primus Telecommunications Limited**
- Acting for Primus in a dispute with BT in respect of billing for 0800 services under the Network Charge Control Standard Interconnect Agreement: **Primus Telecommunications Limited v British Telecommunications Plc**
- Acting for the Defendant at the appeal of the summary judgment hearing in **MCI Worldcom International v Primus Telecommunications** [2004] EWCA Civ 957; [2004] 2 All E.R. (Comm) 833 (Court of Appeal) concerning breaches of contract and misrepresentation following Worldcom's Chapter 11 bankruptcy.
- Acting for the Claimant in a breach of contract action in the Patents Court concerning the assignment of patents relating to encryption technology: **Invisimail Technologies Ltd v RPK New Zealand Ltd** [2003] EWHC 2828.
- Acting for BT Plc in **Heathmill Multimedia ASP Ltd v British Telecommunications Plc** [2003] EWHC 690, concerning the construction and UCTA 1977 reasonableness of BT's standard terms and conditions.
- Acting for BT Plc in defence of a breach of contract action relating to toll-free telephone number services: **Zone Corporation Ltd v BT Plc**
- Acting for an international business process outsourcer in actions concerning payment of state benefits by electronic transfer and provision of client relationship management systems.
- Acting for a company acting to prevent the removal of proprietary software and know-how by ex-employees, involving extensive use of evidence forensically recovered from computer servers and hard drives.
- Acting for eBay resisting an injunction and disclosure application aimed at preventing its users from re-selling tickets to sporting events: **UEFA v eBay International AG**
- Acting and advising in a number of contribution proceedings concerning the scope and effect of express and implied contractual intellectual property infringement warranties and indemnities.
- Advising a wide range of clients on contractual repudiation and termination issues relating to defective provision of IT development services.

- Advising e-commerce clients on regulatory compliance of existing Standard Terms and Conditions with e.g. Consumer Protection (Distance Selling Regulations) 2000, The Privacy and Electronic Communications (EC Directive) Regulations 2003 and Data Protection Act 1998.
- Acting in commercial disputes with substantial technical and technological content.

## Patents

- Acting for B&Q plc, a co-defendant in a patent infringement action involving points of construction and priority, in the Patents County Court and subsequently in the Court of Appeal: **Unilin Beheer BV v Berry Floor NV** [2004] F.S.R. 14 (PCC); [2004] EWCA (Civ) 1021; [2005] F.S.R. 6 (CA); and in hearing in 2006 concerning interaction *between res judicata* and the European Patent Convention.
- Acting for the Claimant in a breach of contract action in the Patents Court concerning the assignment of patents relating to encryption technology: **Invisimail Technologies Ltd v RPK New Zealand Ltd** [2003] EWHC 2828.
- Acting for a defendant in a patent infringement action in the Patents County Court involving estoppels arising out of previous litigation on the same patent between related parties.
- Acting for Defendants in UK satellite proceedings relating to US patent infringement proceedings, resisting and varying an Order for disclosure and examination before an examiner in the UK.
- Acting for a US corporation in arbitration proceedings concerning trans-Atlantic patent and know-how licensing.

## Copyright/Confidential Information

- Acting for the claimant in obtaining an injunction to prevent database right infringement, copyright infringement and removal of confidential information by current and former employees: **E-Testing Consultancy Limited -v- (1) David Rai (2) Jacqueline Denton (3) Tim Straton**
- Acting for defendants in two related actions concerning the validity, under US law, of copyright licences relating to recordings of the Tom Jones Show: **Charly Aquisitions Ltd -v- (1) Paul Smith (2) Smith & Co Sound and Vision and Same v (1) Warren Goldberg (2) Realman Limited (3) C/F International Inc** [Trial listed June 2006]
- Acting for the Defendants at the trial of a preliminary issue relating to representative actions in the context of a copyright infringement action: **Independiente Ltd v. Music Trading On-Line (HK) Ltd** [2003] EWHC 470.
- Acting for the claimant and advising in proceedings against ex-employees for copyright infringement and breach of contract and confidence.
- Acting for the Motion Picture Association of America in an infringement action concerning DVD decryption and copying software.
- Advising and acting for defendants and Part 20 defendants in relation to contractual warranties and indemnities concerning infringement of copyright owned by third parties.

- Advising and acting for software developers whose work has been appropriated and exploited by unauthorised third parties.
- Advising on the impact of The Duration of Copyright and Rights in Performances Regulations 1995 and The Copyright and Related Rights Regulations 1996 on the extent and duration of rights subsisting in old and unpublished copyright works.
- Acting for journalists, photographers and designers in copyright infringement actions against companies who have exploited their work without authorisation.
- Acting for multinational oil company in defence of a breach of confidence action brought in relation to smart card technology.

### Database Right Infringement

- Acting for the Claimant Yell Limited in a series of database right infringement actions arising out of the unauthorised use and exploitation of Yell.co.uk and Yellow Pages directory data
- Acting for the defendant in an action concerning provision of race day data: **BHB Enterprises Plc v- Victor Chandler (International) Ltd**
- Acting for the defendant in a case concerning alleged database rights in mobile telephone top-up PIN codes: **One2One v Rok Communications**

### General

- Acting for a major software company in litigation seeking to restrain the transmission of unsolicited 'spam' email.
- Advising a major record label on construction and enforcement of recording agreements with significant recording artist.
- Obtaining and resisting Anton Pillar search orders, Mareva freezing injunctions, Norwich Pharmacal orders and other High Court interim relief.
- Advising and acting in disputes concerning the scope and effect of Letters of Request under the Hague Evidence Convention and the Evidence (Proceedings in Other Jurisdictions) Act 1975.
- Settling complaints for use in the World Intellectual Property Organisation ICANN domain name dispute procedure.
- Settling complaints for submission to the Advertising Standards Authority in cases involving comparative advertising and misleading technical claims.