



**Jim McDonnell**

**Legal Director**

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Jim McDonnell has nearly two decades of experience in intellectual property and technology. His work covers all areas of intellectual property, but he has a real focus on patents and technology transactions and disputes.

Jim's core activities include cross-border licensing, research and development collaborations, and IP portfolio sales and acquisitions, in particular across the industrial, consumer/retail and life sciences sectors, as well as acting for both claimants and defendants in all aspects of patent litigation. He also has a good deal of experience in transactions and litigation around brands and design rights. His experience has included global multi-million patent and technology licensing deals and work on leading cases in the formative years of the Intellectual Property Enterprise Court.

As an experienced member of the team, Jim provides mentoring for junior members of the IP team and coordinates sections of patents training across the UK and beyond.

- Intellectual Property and Technology
- Litigation, Arbitration and Investigations
- Trademark and Copyright
- Patent Litigation
- Media, Sport, Gaming and Entertainment

- Industrials
- Life Sciences
- Consumer Goods, Food and Retail
- Media, Sport and Entertainment
- Financial Services

- Advising a multinational consumer goods manufacturer, on the joint development and licensing-in of innovative technology for its global consumer goods manufacturing. This multi-million pound deal included a range of joint research and development and, in new ground for this company, a complex IP commercialization regime.
- Advising Frederic Robinson Brewery, on the acquisition of a global licence for the manufacture and sale of the "Trooper" beer, sponsored by rock legends Iron Maiden.
- Advising BMW, in the successful defence of unfounded patent infringement claims concerning power generation for electric vehicles, including proceedings at the UK Intellectual Property Office and a highly favourable Patent Office opinion.
- Advising a global billion-dollar chemicals company, in the acquisition of patented technology for the production of advanced building materials. The deal included exclusive rights for the construction of an €85m factory, exclusive distribution rights throughout Europe, and options for further factories and distribution rights worldwide.
- Advising Sellafield, on the development, management and licensing of a substantial construction and engineering and software IP portfolio concerning operations at Europe's largest nuclear site in the context of a highly regulated area, and Sellafield's status NDPB

subsidiary.

- Advising Novo Nordisk, in the successful defence of substantial patent infringement claims by major competitor, Regeneron, and counterclaims for patent invalidity, alongside co-defendant Kymab. Amongst other things, Jim took the lead in particular on the aspects of the claim concerning the liability of a customer in allegedly procuring infringements by its supplier, ultimately leading to the claimant discontinuing its claim against Novo Nordisk on the eve of the trial. The invalidity action continued, and ultimately resulted in the patents being held invalid for insufficiency by the UK's Supreme Court in 2020.
- Advising ResMed, in a series of patent infringement and validity disputes with key competitors. Jim worked with a multi-jurisdictional team of specialist patent lawyers, across Europe, Australia and the US on key issues for the analysis of third party patents and the development of strategies for the worldwide launch of ResMed's new respiratory medical devices.
- Advising a leading US medical technology manufacturer, in the successful defence of allegations of patent and copyright infringement, and misuse of trade secrets in respect of a range of market-leading intravenous cannulas. Having first knocked out the validity of the patents in question, we successfully negotiated a very favourable settlement allowing the client to continue unimpeded.
- Advising The Premier League, on its nationwide IP program. Jim manages sections of the team across the UK, in the on-going enforcement of the Premier League's copyright and other IP in its broadcasts of English top-flight football.

## CREDENTIALS

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### Professional Qualifications

- Solicitor of the Senior Courts of England and Wales

### Recognitions

- *Legal 500 UK 2019/2020*: Jim is “engaging, keen to learn about the business, down to earth, good with internal clients and he is clearly very knowledgeable” and “hardworking and dedicated.”

### Education

- University of Sheffield, LLB (Hons)
- Nottingham Law School, LPC

### Memberships

- Associate Member of the Institute of Trade Mark Attorneys