

Katie McConnell

Partner
London

Biography

Katie is a solicitor advocate with extensive experience representing clients in major multi-jurisdictional patent disputes in the telecoms and pharmaceutical sectors. Katie is also recognized - by both clients and counterparties - for her practical and solution oriented approach when drafting and negotiating licensing, settlement, and IP aspects of other commercial agreements.

In the telecoms sector, Katie advises on and coordinates cross-border patent disputes, patent arbitration (including in relation to disputes over the appropriate royalties and terms for licenses of standards essential patents (SEPs)), and issues relating to SEPs and non-essential patents. She has won cases confirming that an SEP could be worked around, striking out an application for ex-UK damages claimed for infringement of a UK SEP (clarifying the law in this hotly contested area), and clarifying the scope of the UK's Crown Use defence to patent infringement.

Katie's has advised on a number of Life Sciences 'firsts', including acting for Merck in the first UK cases challenging the interpretation of European legislation regarding pediatric extensions, and in the first UK case on the interpretation of the Specific Mechanism (ultimately resulting in a favorable ruling from the



Phone

+44 20 7296 5055

Fax

+44 20 7296 2001

Email

katie.mcconnell@hoganlovells.com

Languages

English

Practices

Patents

IP Litigation, Arbitration, and
Alternative Dispute Resolution

IP and Technology Transactions

Complex Contracting

Intellectual Property

Litigation Services

Trade Secrets and Confidential
Know-how

CJEU). Katie has significant experience in the area of SPCs and pediatric extensions.

Key examples of Katie's transactional experience include acting for Novartis on IP aspects of its US\$16bn portfolio transformation transactions with GSK, advising Novartis on IP aspects of its collaboration with Microsoft to leverage artificial intelligence (AI) to transform how medicines are discovered, developed and commercialized, and advising the Kraft and Mondelez Groups on the IP aspects of their demerger as it affected their global coffee business. Katie also advises on other non-contentious and pre-litigation IP matters including selection of suitable candidate patents for assertion in licensing negotiations and patent disputes.

Representative experience

Acting for HTC in its long-running dispute against IPCom, including obtaining a declaration of non-infringement for a workaround to an SEP, and striking out IPCom's claim for damages for non-UK devices

Acting for Merck Sharp and Dohme in first UK case dealing with the interpretation of European legislation regarding the Specific Mechanism for parallel imports.

Representing Vodafone in litigation against IPCom concerning the infringement and validity of alleged SEPs, including successfully invoking both a workaround and the rarely used Crown Use defence.

Acting for Eli Lilly in its dispute with Actavis over Lilly's Alimta cancer treatment in relation to dextrose remission issues.

Acting for HTC in litigation (i) against Philips in relation to alleged SEPs, and (ii) against Nokia in relation to a large number of both alleged SEPs and non essential patents

Industries

Consumer

Technology & Telecoms

Life Sciences and Health Care

Automotive

Energy and Natural Resources

Areas of focus

IP Rights in Transactions

IP Licensing, Commercialization, and Technology Transfer

Strategic Counseling and Portfolio Development

Medical Devices

Pharmaceuticals and Biotechnology

Education and admissions

Education

Diploma in Intellectual Property Law and Practice, University of Bristol, 2006

Postgraduate Diploma in Law, Oxford Institute of Legal Practice, 2002

B.A., University College, Oxford, Jurisprudence, 2001

Memberships

AIPPI

CIPA

Acting for Merck and Du Pont on first UK cases challenging European legislation regarding pediatric extensions to supplementary protection certificates; won extension for Du Pont.

Acting in arbitration proceedings for a major WCDMA infrastructure manufacturer relating to a dispute over licence fees for telecoms SEPs and the applicability of FRAND licence terms.

Advising NYSE-listed AmerisourceBergen Corporation on IP aspects of its US\$6.47 billion acquisition of Walgreens Boots Alliance, Inc.'s Alliance Healthcare wholesale distribution business in Europe

Acting for ZTE in its multi patent cross border litigation with Ericsson in relation to patents said to be essential to 2G/3G telecoms standards.

Advising Novartis on IP aspects of its strategic artificial intelligence and data science collaboration with Microsoft as it founded the Novartis AI Innovation Lab

Acting for a leading manufacturer of innovative smartphones on a number of cross border patent licensing disputes against Ericsson and Nokia with respect to SEPs and NEP phone & computer patents

Acting for Novartis on IP aspects of its acquisition of GSK's oncology products for an aggregate cash consideration of US\$16bn.

Acting in arbitration proceedings for a major communications device manufacturer in relation to a number of potential SEPs and related licence terms.

Advising one of world's leading food and beverage companies on IP aspects of business separation; various joint development arrangements; drafting and negotiating related contractual provisions.

Acting for Qualcomm in its patent action against Nokia in relation to GPRS and EDGE mobile phone technology, and co-ordinating related patent actions

ChIPs (London Chapter Committee Member)

Bar admissions and qualifications

Solicitor - Advocate (Higher Rights - Civil), England and Wales

Court admissions

Senior Courts of England and Wales

Accolades

Hogan Lovells is "absolutely among London's most successful and sought-after patent teams"

IAM Patent 1000, 2020

The stars on the telecoms side are ... Katie McConnell... McConnell is prolific both in litigation and in the drafting and negotiation of IP licensing agreements

IAM Patent 1000, 2020

as an intellectual property litigation team they are quite formidable

Chambers UK 2020

across jurisdictions.

Awards and rankings

- Patent Litigation, Bronze, *IAM Patent 1000*, 2020
- IP Transactions, Recommended, *IAM Patent 1000*, 2020

Latest thinking and events

- Webinar
 - 2020 SEPs and FRAND Year in Review
- Press Releases
 - Infringement of a UK Standard Essential Patent does not justify global damages
- News
 - Infringement of a UK Standard Essential Patent does not justify global damages
- Insights
 - UK Supreme Court hands down eagerly awaited FRAND issues ruling in Unwired Planet
- News
 - COVID-19 IP update: impact on litigation
- News
 - COVID-19 and emergency inventions