



## JIM BOFF

### PARTNER

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Jim Boff is a partner in the firm's U.K. Intellectual Property practice. He focuses primarily on patent prosecution, opposition and portfolio management, and is also experienced in trade mark and licensing matters.

While Jim's technical background is in chemistry and materials science, his workload is of wider scope. He handles a wide array of technologies including ceramics, glasses, polymers, composite materials, alloys, amorphous metals, electroceramics, magnetic materials, photovoltaic devices, energy storage devices, carbon, diamond, graphite, nanomaterials, chemical engineering processes, pharmaceuticals, biotechnology, synthetic organisms, and medical devices such as implantable MEMS devices, adaptive prostheses, sutures and surgical tools. Jim has been an inventor in fields ranging from lithium ion battery electrodes, inorganic fiber compositions, fuel cell components, graphite technology and collectors for current transfer to electrical vehicles.

As a former examiner for the European qualifying examinations for patent attorneys, and as a long-standing member of the Standing Advisory Committee before the European Patent Office (SACEPO), Jim is well versed in all aspects of European Patent Office law and practice.

Jim is a contributor to CIPA Journal and other professional publications, and has been invited to speak to various bodies including, among others, the American Intellectual Property Law Association (AIPLA) and the All China Patent Attorneys Association (ACPAA).

### BACKGROUND

Prior to joining Armstrong Teasdale, Jim was a managing partner at a London-based boutique patent and trade mark firm.

### EDUCATION

- University of Oxford (M.A., 1976)
  - Chemistry
- Imperial College London
  - Postgraduate studies in materials science
- Queen Mary University of London
  - Diploma in Intellectual Property Law

### SERVICES AND INDUSTRIES

Intellectual Property  
Intellectual Property Litigation  
Patent  
Trademark  
Agribusiness and Food  
Consumer Products and Services  
Energy and Utilities  
Health Care and Life Sciences  
Manufacturing and Innovation  
Technology

### ADMISSIONS

U.K. Register of Patent Attorneys  
U.K. Register of Trade Mark Attorneys  
European Patent Office Register of Professional Representatives  
United Kingdom Representative Before the Unified Patent Court

## PROFESSIONAL ACTIVITIES

- American Intellectual Property Law Association (AIPLA) (IP Practice in Europe Committee, Strategic Advisor)
- European Patent Institute (Council member; EPO Finance Committee, Chair; EPPC Chemistry Sub-committee, Chair)
- European Patent Office (Standing Advisory Committee Member)
- International Association for the Protection of Intellectual Property (AIPPI) (Member)
- Chartered Institute of Patent Attorneys (Member; Patents Committee, Former Chair)
- U.K. trademark examinations and European patent attorney examinations (Former examiner)

## CHARITABLE AND CIVIC INVOLVEMENT

- Pinner Association (Member and volunteer)

## ACCOLADES

- Chartered Chemist and Chartered Scientist, Royal Society of Chemistry

# EXPERIENCE

### **IP Due Diligence and Support**

Providing due diligence in IP portfolio acquisitions and disposals (ranging from portfolios in the tens to hundreds of properties), including assisting in documentation and subsequent recordal of changes of ownership. Reviews of IP portfolios for small and large clients to assess fitness to support business aims.

### **Provided Advice to Legislators Regarding Continuing Effect of EU Trade Marks and Designs in the U.K.**

On their request, advised members of the House of Lords on certain defects in the post-Brexit legislation concerning the continuing effect of EU trade marks and designs in the U.K., leading to a government undertaking and insertion of interpretive note in the Parliamentary record.

### **External IP Portfolio Manager for Multinational Company**

Provided external IP management for a \$1 billion+ multinational company for over 10 years, until they opened an internal IP function.

### **Patent Invalidation Program Against Client Competitor**

When a client's competitor commenced an aggressive patent filing program, assessed possibility of challenge for each patent, and where appropriate, filed third-party observations at the European Patent Office resulting in patents not being granted, so minimizing number and cost of oppositions required.

### **Same-Day Patent Filing**

Visited a client to discuss one patent and was shown two products that were ready to ship that day. Persuaded client to hold shipping for one day, and prepared and filed two patent specifications that resulted in granted patents in multiple jurisdictions.

#### **Resort to the Court of Chivalry**

When a client found that their coat of arms was being used as a trademark by a competitor, pointed out to competitor that the Court of Chivalry still existed, resulting in the competitor ceasing use of the coat of arms.

## **THOUGHT LEADERSHIP**

March 27, 2023

**MARCO POLO Decision Confirms Importance of Data Integrity for Owners of U.K. IP**

March 21, 2023

**Europe's Unified Patent Court: Why Are Some Opting Out?**

Law.com

December 5, 2022

**Doors Open for European “Unitary Patent”, but Not Yet for Unified Patent Court**

June 2022

**Letter to the Editor: In praise of disharmony**

CIPA Journal

May 2016

**Patent Prosecution Alley – towards smart work sharing**

CIPA Journal

July 2014

**Is it Roosevelt or Landon? On the usefulness of surveys**

CIPA Journal

February 2014

**Thoughts on the Unitary Patent**

CIPA Journal

December 2006

**Are there limits to growth**

CIPA Journal

2006

**Reasons to be cheerful?**

epi Information, Issue 3