

Patents in Europe 2006

Helping business compete in the global economy

In association with



European
Patent Office

A supplement to *Intellectual Asset Management* magazine
www.iam-magazine.com

iam

The business magazine about maximising IP value

“One of the advantages of *IAM* is that it is high quality and yet still accessible and relevant to the non-specialist chief executives and senior managers who don't know what they don't know about IP. It's an important contribution to the upward IP education of senior managers.”

Ian Harvey
Chairman,
Intellectual Property Institute
& UK government adviser on IP

“*IAM* is an excellent publication for helping with the management of an intellectual property portfolio. There is always one article in each issue, and often more, which is relevant to our current business situation.”

Paul Johnston
Group Trade Mark Counsel
ICI Group Intellectual Property

“As intellectual property achieves greater and greater recognition as a key strategic asset of our business, *IAM* is unique in giving me a really up-to-date overview of developments and thinking in this area.”

Paula Nelson
General Counsel (Intellectual Property),
Vice-President,
Nestlé S.A.



Intellectual property and other types of intellectual asset are now of major importance to companies. *Intellectual Asset Management (IAM)* is the first magazine specifically designed as a single source of IP information for senior decision makers in companies, as well as for investors and analysts.

A combination of news, case studies, interviews, profiles, feature articles and data, *IAM* ensures that its readers are always at the cutting edge of the latest thinking and therefore best placed to make the right decisions about IP.

IAM is designed for:

- **General counsel, IP counsel, patent counsel, trademark counsel**
- **CFOs, CTOs, CIOs, CEOs (or equivalent positions) at IP-owning companies**
- **Lawyers in private practice**
- **Fund managers, brokers, analysts, heads of research at investment banks, venture capitalists**



Subscribers to *IAM* include:
3M; Air Liquide; AT&T; Avaya; BHP Billiton; Bird & Bird; Boeing; Brown University Research Foundation; BTG International; California Institute of Technology; Cargill; Chevron; Cleary Gottlieb Steen & Hamilton; Clifford Chance; Covington & Burling; Danfoss; Dolby Laboratories; Dow Chemical; Ericsson; Fujitsu Siemens Computers; GE; GlaxoSmithKline; Halliburton; Herbert Smith; Howrey; Johnson Matthey; Jones Day; Lockheed Martin; Lucent Technologies; Marsh; Merchant & Gould; Motorola; Nortel Networks; Novozymes; Oracle; QinetiQ; Roche; Smart & Biggar.

For subscription details or to request a free trial, visit the *IAM* website or call us on +44 20 7234 0606 or email us at info@iam-magazine.com

www.iam-magazine.com

Chapters

Facing up to Europe's patent challenges	5
<i>By Joff Wild, Editor, IAM magazine</i>	
Quality at the European Patent Office	10
<i>By Professor Alain Pompidou, President, European Patent Office</i>	
The reform of the European Patent Convention: grant and opposition proceedings	14
<i>By Pascal Moutard, Brevaalex</i>	
The Boards of Appeal at the EPO	18
<i>By Pascal Moutard, Brevaalex</i>	
Filing divisional applications in Europe: a dangerous hobby?	22
<i>By Hans Hutter, Nederlandsch Octrooibureau</i>	
A tale of spiders and torpedoes	27
<i>By Christophe Ronse, ALTIUS Law Firm</i>	
Strategic issues concerning patent litigation in Europe	30
<i>By Tom Carver and Nigel Stoate, Taylor Wessing</i>	
Patent enforcement in Norway	34
<i>By Jens Fredrik C Langfeldt, Zacco Norway AS</i>	
Enforcing patents in Austria	39
<i>By Alexander Cizek, DLA Piper Weiss-Tessbach</i>	
Enforcing patents in Belgium	43
<i>By Christophe Ronse and Paul Maeyaert, ALTIUS Law Firm</i>	
Enforcing patents in the Czech Republic	48
<i>By Lukas Lorenc, Cermák Horejs Myslíl a spol</i>	
Enforcing patents in Denmark	51
<i>By Pernille Thorsboe, Zacco A/S</i>	
Enforcing patents in Finland	55
<i>By Ben Rapinoja and Aura Soininen, Borenius & Kemppinen Ltd</i>	
Enforcing patents in France	59
<i>By Pascal Moutard, Brevaalex</i>	
Enforcing patents in Germany	63
<i>By Bernd Allekotte, Grünecker Kinkeldey Stockmair & Schwanhäusser</i>	
Enforcing patents in Hungary	67
<i>By Dr Gábor Faludi and Dr Gusztáv Bacher, SzecsKay Ügyvédi Iroda – Attorneys at Law</i>	
Enforcing patents in Iceland	72
<i>By Gunnar Örn Harðarson and Ásdís Magnúsdóttir, Árnason Faktor</i>	
Enforcing patents in Ireland	76
<i>By John Whelan and Ciara Cullen, A&L Goodbody</i>	

Chapters Continued

Enforcing patents in Italy <i>By Giovanni Antonio Grippiotti, Società Italiana Brevetti</i>	80
Enforcing patents in the Netherlands <i>By Hans Bottema, Nederlandsch Octrooibureau</i>	83
Enforcing patents in Poland <i>By Katarzyna Karcz and Malgorzata Zielinska-Lazarowicz, Patpol</i>	86
Enforcing patents in the Slovak Republic <i>By Andrea Povazanova, Cermák Horejs Myslíl a spol</i>	91
Enforcing patents in Spain <i>By Miguel Vidal-Quadras and Oriol Ramon Sauri, Amat i Vidal-Quadras Advocats</i>	94
Enforcing patents in Sweden <i>By Helena Östblom, Zacco Sweden</i>	98
Enforcing patents in Switzerland <i>By Michael Stierwald, Braunpat Braun Eder AG</i>	101
Enforcing patents in the UK <i>By Gary Moss, Taylor Wessing</i>	104
Directory	110

Editorial board

Bruce Berman
President, Brody Berman
Associates, New York

Mike Carr
Director of Enterprise Venturing,
BT Exact, UK

Michael Cleare
Executive Director, Columbia
University Enterprises

Bruce Lehman
Chairman of the International
Intellectual Property Institute,
Washington DC

Douglas R Elliott
Founder and CEO,
TEQ Development LLC, Chicago

Morag Macdonald
Head of the International IP Group,
Bird & Bird, London

Marshall Phelps
Corporate Vice President for
Intellectual Property, Microsoft Corp.

Herbert C. Wamsley
Executive Director, Intellectual
Property Owners Association,
Washington DC

Rob Willows
Vice President, Thomson Derwent
Industrial Property Markets Division

Editor

Joff Wild
jwild@iam-magazine.com

Finance Editor

Nigel Page
npage@iam-magazine.com

Deputy Editor (North America)

Victoria Slind-Flor
vslind-flor@iam-magazine.com

Contributing editors

Richard Marsland
rmarsland@iam-magazine.com

Adrian Preston
apreston@iam-magazine.com

Reporter

Liz Rutherford-Johnson
lrutherford@iam-magazine.com

Sub-editor

Carolyn Boyle
cboyle@iam-magazine.com

Design and production

Russell Anderson
randerson@iam-magazine.com

Subscriptions and marketing manager

Alan Mowat
amowat@iam-magazine.com

Circulation manager

Amanda Green

Publisher

Dan Rabey
drabey@iam-magazine.com

Publishing director

Tony Harriss
tharriss@iam-magazine.com

Globe White Page Ltd

New Hibernia House
Winchester Walk
London SE1 9AG
United Kingdom

Tel +44 20 7234 0606

Fax +44 20 7234 0808

Email info@iam-magazine.com

Web www.iam-magazine.com

IAM is published bi-monthly by
Globe White Page Ltd

ISSN 1741-1424

Individual subscription rate
GB£365

Printing and origination by
Pyramid Press, Nottingham, UK

© Globe White Page Ltd

Copyright applies. No photocopying.
For licensed photocopying please
call +44 20 7234 0606

This publication does not
purport to provide investment
advice. The publishers do not
bear the responsibility for any
errors or omissions contained in
the magazine.

Welcome

It is a pleasure to welcome readers to the second edition of *Patents in Europe: Helping business compete in the global economy*.

There are very few patent owners who can afford to ignore the importance of Europe to their businesses. As home to a population of over 500 million, as well as innumerable world-class technology-based companies, the continent is not only a potentially very lucrative market for those from elsewhere in the world, it is also where many of their competitors are to be found. For those actually based there, Europe's markets are the lifeblood that keeps them going. As a consequence, understanding the intricacies of how the patent system operates is essential: get it wrong and valuable resources invested in research and development will end up having been wasted.

But the problem with Europe is that it is made up of a collection of sovereign states – each one with its own patenting rules and ways of deciding disputes. For companies wishing to understand the complicated patent infrastructure on the continent, this is the first lesson: Europe is not one, it is many.

There is a way, however, in which the patenting process can be simplified and that is to use the European Patent Office (EPO) as the starting point for a protection strategy that covers the continent. Established by signatories to the European Patent Convention (EPC) in the 1970s, the EPO acts as a one-stop location for securing granted patents in each of the current 31 member states of the EPC, or in as many as the applicant wishes to nominate.

What the EPO cannot do, though, is to grant a unitary patent that covers all EPC countries. Because what it grants are

essentially national patents, when it comes to enforcement, patent owners have to take a country-by-country approach. Something that can take time, cost a lot of money and provide contradictory results. Efforts to change this situation are ongoing but, at present, show little sign of nearing resolution.

It is with all this in mind that IAM has produced *Patents in Europe 2006*. This special supplement to the magazine has been designed to provide concise information about a host of key issues facing those looking to obtain patent protection in Europe and then, if necessary, to enforce it. At the front end of the publication we have a number of introductory chapters that look in some detail at specific aspects of the European patenting process. These are then followed by a series of country-based contributions in which correspondents answer questions relating to the way in which patents are enforced in their jurisdictions. In this way, the aim is to build a tool that will be of practical use to European patent owners, as well as those from other parts of the world.

To ensure the highest quality, we approached only those firms with acknowledged expertise in European patent law and practice to submit editorial. We are grateful to all contributors for taking the time to do so. Above all, however, we are indebted to officials at the European Patent Office, who not only provided copy and statistics, but also gave much invaluable general help as *Patents in Europe 2006* was conceived and produced.

Joff Wild,
Editor, IAM magazine
www.iam-magazine.com

THE PANEUROPEAN
INTELLECTUAL PROPERTY SUMMIT

▶ BRUSSELS IP 2006

THURSDAY **7** & FRIDAY **8**
DECEMBER 2006

www.ipsummit.info

Day I

IP in the boardroom

Day II

IP leadership: a global benchmark

Supported by



the European Commission



the European Parliament



World Intellectual Property Organization

Moderation

THE WALL STREET JOURNAL
BROOKLYN

Research and production

Premier Cercle

Promotion



Country Focus



IP 2006 special:

How Japan is becoming
an IP powerhouse

Keynote speakers

Viviane Reding

Commissioner for Information Society
EUROPEAN COMMISSION \ BELGIUM

Charlie McCreedy

Commissioner for Internal Market & Services
EUROPEAN COMMISSION \ BELGIUM

Alain Pompidou

President
EUROPEAN PATENT OFFICE \ GERMANY

Christine Lagarde

State Secretary for External Trade
FRENCH GOVERNMENT \ FRANCE

Mary Robinson

Honorary President
OXFAM INTERNATIONAL \ UK

Wubbo de Boer

President
OHIM \ SPAIN

etc.

New features

- 'Meet the EC' platform
- .eu and CTM anniversaries
- IP Magna Carta

CEOs

Alain Lévy

Chairman & Chief Executive Officer
EMI MUSIC \ UK

Ajit Shetty, Dr

Managing Director & Chairman of the Board
JANSSEN PHARMACEUTICA \ BELGIUM

Mario Moretti Polegato

Founder, President of the Board of Directors
GEOX \ ITALY

etc.

Japan representatives

Ryuichi Shitara

Presiding Judge for the IP Division
TOKYO DISTRICT COURT \ JAPAN

Takuma Kiso

Chief Economist
MIZUHO BANK \ JAPAN

Corporate IP leaders

Todd Dickinson

Vice President & Chief Intellectual Property Counsel
GENERAL ELECTRIC \ USA

Kenneth Enborg

Global Process Leader IP
GENERAL MOTORS \ USA

Mats Parup

Head of Corporate Intellectual Property
NOVARTIS \ SWITZERLAND

Marshall Phelps

Corporate Vice President, Intellectual Property
MICROSOFT \ USA

Beatrix de Russé

Executive Vice President,
Intellectual Property & Licensing
THOMSON \ FRANCE

David Simon

Chief Patent Counsel
INTEL \ USA

Koenraad Wuyts, Dr

Chief Intellectual Property Officer
KPN \ NETHERLANDS

etc.

With over 40
case studies
to date

3M

DaimlerChrysler AG

Shell International

F. Hoffmann-La Roche

Nike

Pernod Ricard

Novartis AG

Fujitsu

LVMH

Astrazeneca

Alcatel

Philips

Red Hat

Teva Pharmaceutical

Infineon AG

Syngenta

Pangea 3

British Telecom

Panasonic

etc.

Contacts

For information or registration

→ www.ipsummit.info | ip2006@premiercercle.com

For sponsoring opportunities

→ contact Patrice Cros | pc@premiercercle.com
→ contact Gavin Stewart | gstewart@iam-magazine.com

platinum

THE BOSTON CONSULTING GROUP

Facing up to Europe's patent challenges

The European Patent Office is not only responsible for the delivery of a high-quality patent application and grant process, but also has a central role to play as Europe debates its patent future

By **Joff Wild**, Editor, *IAM* magazine

The European Patent Office (EPO) was established by the contracting states to the European Patent Convention (EPC) back in the 1970s and made its first grants in 1980. In its first few years of existence it was handling an annual workload of approximately 10,000 applications. By the end of 2005, this figure stood at 128,679 a year, a rise of 4% on the 2004 total. Of these applications, 49.5% came from people or organisations based in EPC member states, while 25.4% came from the United States and 16.7% from Japan.

The EPO, which is headquartered in Munich and has satellite offices in Berlin, Vienna and The Hague, is now established, along with the US Patent and Trademark Office and the Japanese Patent Office, as one of the three most important patent offices in the world. Between them, the so-called trilateral authorities handle well over 50% of the world's patent applications.

What makes the EPO unique is the fact that it grants rights that have the potential to cover all contracting states to the EPC (with the accession of Latvia in 2005, there are now 31 of these, with five more extension states also recognising European patents). The EPC allows organisations to take advantage of a single grant procedure by filing an application in one of the three official languages of the EPO – English, French and German – to gain protection that potentially covers an area with a population of close to 500 million people. Not that every European patent covers all 31 member states of the EPC – it is up to the applicant itself to nominate those jurisdictions where it would like its granted patent to apply.

In 2005 the EPO granted 53,300 patents, which means that by the end of that year it had granted a total of 760,700 since it started to operate, equivalent to a figure of 6.3 million national patents.

Over the years, the EPO has established a reputation for the quality of the patents it grants. It is an issue to which the Office continues to pay close attention. With close to 3,500 examiners, expertise across a wide variety of technical areas and access to a database of 56 million patent documents – as well as a library composed of over 55 million facsimile patent documents and non-patent literature – applicants and other interested parties know that every application submitted to the EPO receives close scrutiny.

The opposition and appeals process also ensures that there is the opportunity to address any problems that do occur during the examination stage before embarking upon potentially costly civil litigation in member states' courts. Oppositions must be filed within nine months of a patent being granted and in 2005, 2,960 were filed, meaning an opposition rate of 5.4%. The Boards of Appeal, meanwhile, registered 1,684 new cases during 2005, representing a 9.8% increase on 2004's figure of 1,533; settled appeals in 2005 numbered 1,499, slightly up on the previous year. During 2005, there was also some progress on dealing with the backlog of cases waiting to be heard by the various boards of appeal – by the end of the year, 753 appeals had been pending for over two years, which represented a 9% improvement on 2004's total of 832. Two new boards of appeal were also created. These handle issues relating to chemistry and electricity. There are now 24 boards of appeal in total.

Pendency times, of course, are not a problem limited to the appeals process. They remain a significant challenge for the whole of the Office. Although around 25% of patent grants are now made inside the current target period of 36 months from application, the average time to grant remains high, at 45.3 months (though this does represent an improvement of nearly a month on the 2004 average). Over the medium to long term, it is hoped that the introduction of an enhanced service relating to the delivery of first opinions from examiners to applicants will be help to reduce waiting times.

Designed to enhance the EPO's reputation for quality and to help applicants make earlier, and therefore less expensive, decisions with regards to their patenting strategies, the service aims to provide a first opinion from the examiner on an application within an average of six months from the original submission of the application. In the opinion the examiner outlines his impressions of the strength of the application based on the claims and on the prior art. He can advise that in its current state the application does not look like a potential candidate for grant or, alternatively, that there appear to be few problems. Similarly, the examiner also makes suggestions as to how the application can be altered in order to stand a greater chance of making it through to grant. In providing this service at such an early stage in the application process, the aim is to allow the Office's customers to manage their patenting risks more effectively and so gain greater value from their IP portfolios.

Looking outwards

The EPO does not issue patents that are enforceable across Europe. Instead, an applicant will nominate those countries in which it wants to be protected and, if the application gets the green light, the EPO will effectively grant national patent rights for each of those countries. And while the EPO route makes life easier for applicants and also means that potential patents are subjected to highly rigorous scrutiny, the current system does present major problems; specifically in the areas of cost and litigation, should this arise. It remains the case that getting Europe-wide protection is significantly more expensive than it is to get protection for the whole of the US or Japan; while enforcement of rights is far less certain. Courts in, say, Germany and the UK will often reach completely different decisions in cases that are to all intents and purposes about the same thing.

Applications filed in 2005

			Change in %
Direct European filings	2005	60762	+3.8
	2004	58523	
Euro-PCT applications filed (international phase)	2005	132861	+8.8
	2004	122139	
Total European applications (incl. Euro-PCT international phase)	2005	193623	+7.2
	2004	180662	
Euro-PCT applications entering the regional phase	2005	67917	+4.1
	2004	65252	
European applications (incl. Euro-PCT regional phase)	2005	128679	+4.0
	2004	123775	

At the European level, there is acknowledgement that solutions have to be found to the current problems, especially as a strong patent system is a cornerstone of the Lisbon Agenda, agreed by European leaders back in 2000. The Lisbon Agreement aims to establish Europe as the world's most competitive knowledge-based economy by 2010.

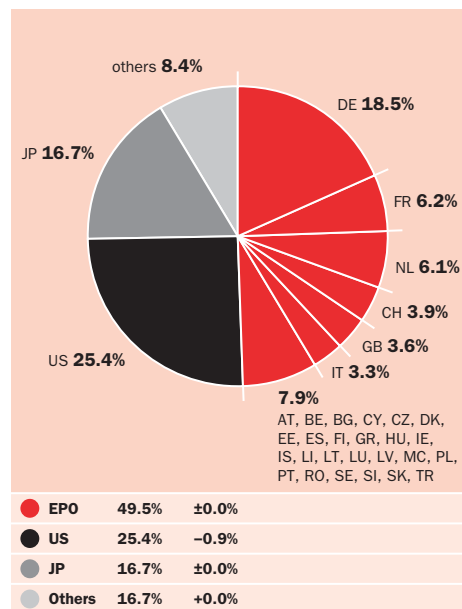
Although EU leaders have consistently stressed their commitment to the development of a unitary patent for the European Union – known as the Community patent – that would be granted by the EPO and would be automatically valid in all member states of the EU, and enforceable under a single set of legal principles, progress towards seeing this come into force has been painfully slow.

By establishing a Community patent, the idea is that patents will be less expensive to obtain and that patentees will have more certainty because the rights they own will be subject to only one set of rules and procedures. However, while there seems to be general consensus that the Community patent is needed, the devil is in the detail. There are a number of issues that still have to be resolved before it can take effect, most of which resolve around language and, to a lesser extent, the nature of the enforcement framework. Although talks are ongoing there seems little prospect of a breakthrough in the short to medium term, as the negotiating parties struggle to design a system that not only makes patenting in Europe less expensive and more certain, but also satisfies those that worry about issues such as translations.

Although the EPO has made clear that it supports the introduction of the Community patent, it is also pragmatic enough to realise that the chances of it actually happening any time soon are remote. That means, of course, that European patentees and applicants are still faced with the disadvantages the current patent

Source: European Patent Office, Annual Report 2005

Applications by residence of applicant in 2005



Source: European Patent Office, Annual Report 2005

infrastructure presents – points that were underlined during a European Commission consultation process on Europe's patent system and its future that started at the beginning of 2006 and culminated in a public hearing in Brussels in July.

The need to harmonise

What became apparent during this consultation process, which saw a total of 2,515 submissions from individuals and various interested organisations, was that while support for the principles behind the Community patent remained strong, those thinking that it was a viable prospect in its current form were almost non-existent.

This was something that was recognised by the Commissioner of the Internal Market Directorate General Charlie McCreedy in a speech he made in Prague in October 2006. "Industry is not enamoured by the compromise reached by the Council in 2003 on the Community patent in terms of the proposed solution in respect of language and the jurisdictional system because they don't achieve the cost reductions and the simplification of the system that industry wants," he said. Instead of the Community patent, therefore, McGreevy hinted that the Commission may throw its weight behind two other initiatives supported by the EPO: the European Patent Litigation Agreement (EPLA) on jurisdiction and the London Agreement (or Protocol) on the language regime. "Before the end of this year," he explained, "I will be proposing that the Commission adopt a communication and action plan aimed at tackling the patent issues all in one approach. In particular, I want to tackle the jurisdictional issue so that we don't have different courts in different countries delivering divergent interpretations on the same patented invention." In a telling final sentence McGreevy stated: "We cannot aspire to being the most competitive economy in the world if we don't find workable solutions to patent application and protection."

Progress on the EPLA

A draft of the EPLA has been agreed by officials from a number of member states of the European Patent Convention, including the UK, Germany, France, Sweden, Switzerland and the Netherlands. This envisages the creation of a European Patent Court that would have exclusive jurisdiction to hear cases concerning actual or threatened infringements of European patents, and actions and counterclaims for the revocation of European patents, as long

as the defendant were domiciled in a contracting state.

In this way, the infringement and validity of European patents would be litigated in the same proceedings, while any decision to revoke a European patent would be applicable in all contracting states to the EPLA. In effect, this would make the European patent a unitary right in those countries that signed up to the Agreement.

In the past, the Internal Market DG had been hostile to the EPLA, regarding it as very much a second best to the Community patent, while at the same time casting doubt on its legality under EU law. However, it seems that minds have been changed. In his public hearing testimony, McCreedy described the EPLA as "a promising route" and is reported to have instructed officials to work on taking the project forward.

Furthermore, McCreedy told a committee meeting of the European Parliament in June that he was determined to ensure that Europe's patent system is reformed. "Businessmen, faced with a 21st-century global economy, scratch their heads in disbelief when they see us stuck in discussions about language regimes and regional distribution of courts. What they want is a cheaper and reliable patent system. That's why I think we should look at all possible routes forward, be they Community or non-Community initiatives."

As a voluntary agreement only those countries that wish to be bound by the EPLA need to sign up, although in practice the endorsement of Germany, the UK and France takes care of Europe's three biggest markets: this will increase certainty for patentees and also reduce the costs of pan-European litigation. An added attraction is that because this is an agreement between contracting states of the EPC, there is no need for any green light from all EU member states or the European Parliament. However, in a vote on 12th October, the European Parliament, while supporting the broad principles behind the EPLA, made clear that it had substantial reservations about the EPLA as currently worded. Although this does not, of itself, preclude the Agreement being ratified, it does make it politically much more difficult.

The Protocol advances

But the EPLA is not the only initiative that looks like moving forward. Also at the July public hearings, EPO chief Alain Pompidou stated that he believed the French government was now ready to ratify the Agreement on the application of Article 65 of

The European Inventor of the Year Awards



Group photo of the winners of the first European Inventor of the Year Awards

On the evening of 3rd May 2006, at the Autoworld Museum in Brussels, over 400 people attended a gala dinner and ceremony to discover the names of the first recipients of the European Inventor of the Year Awards. Hosted by veteran BBC journalist Michael Buerk and jointly organised by the European Patent Office and the European Commission, the Awards were designed to showcase the importance of innovation for Europe's future and to strengthen the continent's position as a dynamic centre for science and R&D in the context of the EU's Lisbon Agenda. Commission Vice-President and Enterprise and Industry Commissioner Günter Verheugen and EPO President Alain Pompidou were both present to honour the winners.

To establish the first set of Award recipients, an international jury chaired by former Dutch Prime Minister Wim Kok nominated inventors from 11 nations. The nominees represented nine countries in Europe, plus Australia and the United States. The list the jury drew up covered inventions from all the fields of technology in which the EPO granted European patents between 1991 and 2000. It granted over 380,000 patents in that period, so in making their choice the



EPO President Alain Pompidou with Commission Vice President Günter Verheugen

jurors drew on the technical expertise of the Office's 3,500 patent examiners.

Awards were made in a total of six categories and were handed to the following inventors:

- **Industry category** – Zbigniew Janowicz and Cornelis Hollenberg, who invented a method for making proteins in *Hansenula* yeast, which is used to produce an affordable vaccine against hepatitis B.

- **SME category** – Stephen Fodor, Michael Pirrung, Leighton Read and Lubert Stryer for their invention of the DNA chip while working for the Dutch company Affymax's US research institute.
- **Universities and research institutions category** – Peter Grünberg, of Germany's Jülich Research Centre, for his discovery of the giant-magnetoresistance effect, or GMR.
- **New EU member states category** – John Starrett, Joanne Bronson, John Martin, Muzammil Mansuri and David Tortolani, whose work – based on research done at the Academy of Sciences of the Czech Republic – resulted in a breakthrough with chemical compounds, called prodrugs of phosphonates.
- **Non-European countries category** – Larry Gold and Craig Tuerk, of NeXstar Pharmaceuticals, Boulder, United States, who found out that nucleic acids can bind a protein to potentially intercept other proteins that cause diseases such as AMD.
- **Lifetime achievement category** – Federico Faggin, an Italian scientist now living in California, who developed the first microprocessor chip, allowing huge volumes of data to be processed and unleashing a revolution in computer technology.

Speaking at the event, Professor Pompidou said that inventors should be "treated like pop stars", while Commissioner Verheugen expressed his hope that one day "the European Inventor of the Year will have the same prestige as the Nobel Prize". The Awards will now be held on an annual basis.

All photographs by Rupert Warren, © European Patent Office

the Convention on the Grant of European Patents (the London Protocol) and predicted that it would do so before the country's May 2007 elections.

Under the Protocol, member states of the EPC which share an official language with the EPO, ie English, French and German, would not require any translation of European patents in one of their official languages. Other countries, meanwhile, would have to choose one of the official languages of the EPO as a "prescribed language", in which European patents would be translated, although they would also retain the right to require translation of the claims in one of their official languages. It is estimated that

should the Protocol come into force, it would cut the cost of translations in Europe by 50%.

A number of countries have ratified the Protocol, but it cannot come into force without the sign-up of France, the UK and Germany. And although the latter two have given it the green light, France has been reluctant up to now, citing concerns about the effect the Protocol would have on the French language and its role in the dissemination of scientific knowledge (in 2001, for example, the European Parliamentary Regional Assembly of the *Francophonie* (French-speaking countries) passed a resolution rejecting the Protocol). A major breakthrough in this regard came at the end of September 2006, when the French

The top filers with the EPO in 2005

Rank	Company	Application for which European grant proceedings were instituted in 2005
1	Philips	4883
2	Siemens	1863
3	Samsung Electronics	1585
4	Matsushita Electric	1390
5	LG Electronics	1152
6	Sony	1117
7	Bosch	1030
8	Microsoft	879
9	Fujitsu	837
10	BASF	778
11	Nokia	688
12	Thomson	577
13	DSM IP Assets	575
14	IBM	573
15	General Electric	567
16	Alcatel	552
17	Seiko Epson	521
18	Bayer	519
19	3M	517
20	Canon	499
21	Hitachi	492
22	Fuji	462
23	L'Oréal	448
24	Delphi Technologies	447
25	NEC	431

Source: European Patent Office, Annual Report 2005

Constitutional Council ruled that the Protocol did not run contrary to the French Constitution, so clearing the way for formal French ratification. If this were now to occur, it would be a major step towards the Protocol coming into force and good news for all companies that patent inventions in Europe.

Obstacles ahead

So for European patentees, the signs are good. But it would be wise to remember that nothing has yet been agreed. And nothing is guaranteed. But with Community patent negotiations looking as if they have stalled, attention has shifted to the Protocol and the EPLA.

Of the two, the Protocol looks to be the most likely to progress quickly as its aim is one that everybody shares – a much cheaper patenting process in Europe. That said, language can be an emotive issue in France and there is no guarantee that, with elections looming, the Protocol will not be seized on as an issue in the run-up to polling day. In addition, even if France does ratify, that does not guarantee the Protocol will come into force, as a minimum of eight EPC member states must accede before it does. So far, this number has not been reached.

But with France on board, it will just be a matter of time for the Protocol. More problematic is the future of the EPLA. Here, there are bigger issues to confront. These include exactly how the new system will function and how much it will cost. More significant, however, is that the anti-software patent lobby has decided that the EPLA is yet another back-door attempt to introduce software patents into Europe and, as a result, is now beginning to organise in opposition to it.

Although McCreedy's Internal Market DG may be getting more relaxed about the desirability and legality of the EPLA, this does not guarantee that other parts of the Commission will be equally sanguine; while strong lobbying could begin to make the whole issue less comfortable for individual member states. Certainly the vote of the European Parliament indicates that many politicians have yet to be fully convinced of the Agreement's merits.

Difficult steps

Because Europe remains a collection of sovereign states, it is always going to be difficult to construct a patent regime on the continent that matches those found in the United States and Japan, and that we will see, in the future, in places such as China and India. Each of these countries has the advantage of operating under a single patent regime that is administered by an office responsible to just one government. Law making and policy discussions will inevitably be easier in such circumstances.

One only has to look at the failed attempt to get the Computer Implemented Inventions Directive approved by the European Parliament, as well as efforts to force countries to implement the Biotechnology Directive (which itself took a decade to get through the Brussels decision-making process) to see the task patent owners face in Europe. All they can do is to educate those that take decisions so that, in time, they realise just how important patents are to the future of Europe's economy.

While uncertainty and delay seem to be the natural state of things in a Europe that often seems to be fonder of grand statements rather than hard-nosed action, what is clear is that the EPO remains committed to ensuring that it not only grants high-quality patents, but also keeps the whole issue of intellectual property and patenting in particular on the political agenda. Ultimately, it is up to rights owners to force the politicians to take their needs seriously. They can be sure, however, that as they attempt to do this they will have a loyal friend in Munich.

Quality at the European Patent Office

Quality is at the heart of the European patent system. The EPO is deeply and very concretely committed to ensuring that it remains so and intends to be the world benchmark for patent quality

By **Professor Alain Pompidou**, President, European Patent Office, Munich

For the European patent system and the European Patent Office (EPO), quality is not an option: it is the heart of its identity, a distinctive characteristic. European patents are granted on the basis of a uniquely thorough search and examination procedure. They offer a degree of legal certainty that is unmatched anywhere in the world. They offer guarantees of this quality that are unparalleled. This commitment to quality originates in the mandate of the EPO, as laid down in the European Patent Convention (EPC), and in the will of European governments and European society. Nevertheless, quality remains a permanent challenge and a concrete objective for the EPO, as reflected in the formal quality management system initiated in 2004.

Quality a defining characteristic

At the recent EU hearing on Patent Policy in Europe, held in Brussels on 12th July 2006, civil society and, in particular, the representatives of large and small and medium enterprises, expressed their strong support for the high quality of the European patent. The desired reduction of cost should not come at the expense of quality, they argued, as the high quality of patents is a major asset for Europe and its knowledge economy. The Commission and the Union's member states also showed that they share this vision of quality as a distinctive feature of the intellectual property system in Europe.

It is the mandate of the EPO to grant high-quality patents. The requirements for patentability set out in the EPC and applied

by the EPO are stringent. The three conditions of novelty, inventive step and technical character are interpreted in the widest sense (EPC, Article 52(1)). This implies extensive search and examination prior to the granting of patents, and requires highly skilled examiners with appropriate initial and continuing training.

Recruitment and training of examiners

Examiner recruitment is a thorough operation. First, the EPO's recruitment procedure is very competitive and demanding, and we benefit from a strong interest from skilled applicants. Second, the EPO provides common training to ensure that all examiners follow, legally and technically, a consistent approach. Particular attention is given thereafter to the individual training needs of examiners, according to both their individual background and their field of work. New technological developments and trends also require us to reassess our training policy and needs continuously.

Documentation

Skilled examiners rely on extensive and high-quality documentation. Since the state of the art considered for the purpose of novelty assessment is held to comprise "everything made available to the public" (EPC, Article 54 (2)), examiners need access to a vast stock of patents and other documents. In this area too, the EPO sets a benchmark: its virtual library for examiners now comprises over 62 million documents. The quality of this documentation is guaranteed by strict monitoring: 4.6 million documents were reviewed in 2005, resulting in 314,000 manual corrections. Espacenet makes this patent literature publicly and freely accessible.

Unlike a number of patent offices



Professor Alain Pompidou
EPO President

*Patent quality
is at the heart
of the EPO's
philosophy*

worldwide (notably the US office), the EPO takes global knowledge in all its forms as the yardstick of inventiveness. This includes traditional knowledge, an area where the EPO has partnerships with many non-European countries. These partnerships aim at incorporating traditional knowledge into the EPO data banks. It also has the side effect of making traditional knowledge available to the public in the English language and thus constitutes a very efficient way to protect and promote it. A database of traditional Chinese medicine, for example, has been integrated in the EPO stock of patent documents, ensuring that techniques derived from traditional Chinese medicine are not patentable in Europe.

Stringent conditions for patentability

The requirement of technical character for patents is also, in my view, another token of the high quality European society expects from its patents, as it helps to make the European knowledge economy a safer and more predictable environment for entrepreneurs. The so-called ethical exclusions from patentability – such as the refusal to grant patents to inventions that are contrary to *ordre public* or morality – also contribute towards making the European patent system one of the most demanding in the world.

Processes

In addition to the quality aspects outlined above – the skills of the examiners, the extent of our documentation and the high standards we apply – the EPO follows meticulously designed procedures that are continuously reviewed and updated. The examination procedure in particular involves a high number of redundancies, which is one of the Office's distinctive features. Examiners, of course, bear the primary responsibility for maintaining high-quality standards. They assess their own work against systematic checklists and the requirements for the justification of their recommendations are high, especially with regards to documentation and compliance with the EPC.

Individual examiners are, therefore, the prime actors in the operational quality control processes. However, any decision on the granting of a patent is checked further by an examining division, with a second examiner, who reviews formal aspects, and a chairman, who checks the substance of the patent application. After this second review, a third check on selected files is carried out by directors. In addition, the Quality Management Directorate is currently

developing a fourth level of quality control, which I shall detail below. Each of these levels of quality checking precedes a decision. Any of them can result in a request for further search and examination.

Practices and procedures are under continual scrutiny, and they are reviewed on the basis of, for example: feedback from the examination process, in particular from the quality control measures; the jurisprudence of the boards of appeal and other developments in the interpretation of patent law; and feedback from users.

With the changing European and global technological environment, patents in sensitive areas require special attention, supplementing our normal procedures. This is the case with biotechnology, business methods that show significant technical character, and computer-implemented inventions. For such sensitive cases, the EPO is assisted by a network of experts who are consulted on a case-by-case basis. Issue management groups have also been set up within the Office. They systematically review every application in their area of concern, providing an additional level of quality control.

Possibilities of review

The first line of defence against low-quality patents is thus provided by the examiners and the grant procedure and processes. The second line consists of the opposition and appeal procedures. The fact that these are not heavily used proves the quality of the first line. Fewer than 7% of patents granted by the Office are challenged in an opposition or appeal proceeding (two-thirds of these contested patents are amended or rejected). Recourse to the third line of defence, revocation proceedings in national court, is very little used, as it should be. At 1%, the litigation rate for the EPO is on par with that of the world's top patent offices.

The transparency of the patent grant procedure and the multiple possibilities for third parties to challenge its outcome are further guarantees of the quality of the European patent. Applications are published from the 19th month of the procedure, which enables third parties to present comments and facilitates public debates on inventions and patentability in the early stages of the patenting process.

Principles of EPO Quality Policy

The objectives of the EPO are to support innovation, competitiveness and economic growth in Europe. Defining what quality means for us therefore entails identifying the

key factors in the fulfilment of these goals. It is on this basis that the four principles of the Quality Policy were specified:

- The first principle of the Quality Policy is legal certainty. A primary goal of the patent system is to provide certainty to inventors, investors and enterprises with regards to the protection and the use of inventions. The task of the EPO is to grant patents and to ensure that the rights granted by the patent are commensurate with the contribution made to technology.
- Service is the second principle. The EPO is at the service of European society. It has to be reliable and flexible on the basis of a balanced understanding of that society's needs and values. The fact that the Office now provides applicants with an early opinion on patentability is a good illustration of its commitment to this principle. Its commitment to reducing the delays in the patenting procedure is another.
- Third, the openness policy of the Office has at least three advantages. The transparency of the patent grant procedure facilitates comments by third parties early in the process (the public file inspection procedure allows anyone to submit comments on an application to the relevant examiner from the 19th month of the process). The indication of what applications have already been filed also provides a powerful tool for economical intelligence, and the publication of patents is a strong catalyst for research and innovation.
- Fourth, the Office strives for continuous improvement, in a permanent commitment to enhance quality, on the basis of our five cardinal virtues: thoroughness, consistency, transparency, fairness and timeliness.

Let me now turn to the details of the EPO's effort to secure and reinforce the high level of quality already attained.

Formal quality management in the EPO

Quality at a given time, and even a history of quality like that of the EPO, is not a guarantee of future quality. On the contrary, the whole point of a quality system is to ensure that quality is sustained with certainty beyond the unavoidable changes of the environment and of the organisation. As this requires continual reassessment and adjustment, there is no other way to secure quality than aiming at constantly raising its level. Therefore, the

principle of continuous improvement is central to our quality policy, which in turn involves ensuring the Office's responsiveness to change.

The environment in which the EPO operates has seen some very obvious changes in recent years. The main new development posing a challenge is the growth in our workload, with nearly 194,000 filings in 2005, amounting to an increase of 148% in 10 years. Other such factors include the emergence of new types of inventions in fields such as biotechnology or telecommunications and IT, the evolving legal background, the ongoing debate on EPO cooperation with national patent offices and changes in the filing behaviour of applicants.

This is why in 2004 I initiated the implementation of a formal Quality Management System, with a natural focus on quality in the examination area (ie, search, examination and opposition), and, as part of the reorganisation of the EPO in 2005, the creation of a Principal Directorate for Quality Management, and the integration of the internal audit department under my direct supervision.

The main added value of a formal quality management system lies in the systematisation of our approach to quality. The role of the European patent system is to provide certainty and predictability for the European economy. Faced with the challenging environment of global innovation, it is only natural that the EPO should endeavour to make the quality of its work certain and predictable, further enhancing the general reputation it already enjoys.

The Office's efforts to formalise its quality system have already borne fruit in a number of significant areas.

Customer satisfaction

The first recent development connected with the reorganisation of the Office is an enhanced attention to the needs and expectations of its users. That service is one of the four principles of the quality policy already indicates the Office's intention to open itself still further to European society.

This service reorientation is reflected in the activities of the new Metric and Standards Directorate, which has taken over the task of redesigning the Users' Satisfaction Survey with a view to exploiting its results more systemically. The incorporation of this unit within the Principal Directorate for Quality Management will ensure that the EPO pays still closer attention to customer satisfaction when assessing the quality of its products

and updating its processes and procedures accordingly.

The handling of complaints has also been integrated into the Office's general quality management system. Complaints received by the Office were invariably taken up by the persons directly concerned; now they are processed and analysed by the department which oversees the quality policy.

The opening of the Office to society is clearly apparent in the work of the Communication Department, which was set up in 2004 to unify and enhance the ways in which the Office presents itself. Significantly improved attendance at press conferences and briefings, wider dissemination of our publications, clarification of our message and image, coordinated communication with the European Commission – these are just some examples of our renewed relations with the press, the public, policymakers, industry and society at large.

Systematising the improvement loop

Another significant part of the quality effort relates to the systematisation and the strengthening of the so-called improvement loop. Throughout the Office, as in the user satisfaction surveys and the processing of complaints, every issue, doubt or suggestion that arises is analysed and integrated into the process of quality enhancement. Thus the Office is able to spot early signs of problematic situations.

An example of the reinforced improvement loop is the creation of an additional level of operational quality control within the technical clusters. Randomly sampled patent applications are to be surveyed and checked against electronic check-lists. This will provide us with statistically relevant information on a continual basis for each technical field on the most common flaws in the patent granting procedure, and will thus allow for immediate targeted actions to be taken for improvement. As these checks will also measure the effectiveness of the actions taken, resources can be applied in a targeted, efficient and economic way.

Internal audit

Another important aspect of the new quality management system is the reinforcement of our internal audit system, which now has a dedicated unit for auditing search and grant products, and which reports directly to me. It is therefore entirely separate from the examining area. Its primary role is to provide confidence in the quality of the Office's

work. This is done by closely scrutinising a limited number of randomly sampled files, which are checked against legal, procedural and technical standards. Moreover, the criticisms and suggestions of the internal audit department are an additional input into the improvement loop described above.

European patent quality system

The EPO acts as a coordinator and an examining authority for the grant of European patents. It does by its nature collaborate with the national patent offices, which eventually grant national patents and also receive a major (though diminishing) share of first filings.

The quality of European patents therefore depends not only on the work of the EPO, but also on the contributions of the national patent offices and their cooperation with the Office. This is why the member states of the EPC wish to implement a European quality system, to provide a foundation for participating offices to achieve continuous improvement to the quality of their products and services, and to enable them to participate in any utilisation of their searches by the Office.

The EPO, with its long experience and strong track record for quality, has drafted a mandate for a working group to make proposals on this matter. This is being done on the basis of the experiences of the EPO and national patent offices, and paying due regard to the need to adapt the proposed quality system to the particular circumstances of a given office.

Conclusion

The quality of the European patent system, complying with the high standards demanded by European society, relies on the EPO's procedures for granting patents and controlling their quality. This is backed by the transparency of the Office's work, its attention to feedback from applicants, and its strengthened quality control and internal auditing.

On this basis, and to continue fulfilling its wider mission to provide certainty for industry in Europe, the EPO intends to remain the world benchmark for quality. In these efforts however, the Office's main asset – and the ultimate assurance of quality – remains the unstinting commitment of its entire staff.

The reform of the European Patent Convention: grant and opposition proceedings

The modifications made to the European Patent Convention in 2000, which are due to come into force by the end of 2007, will have major implications for patentees and applicants

By **Pascal Moutard**, Brevalex, Paris

The economic value of European patents is a matter of growing importance for patentees, in particular in view of the evaluation of companies' intellectual assets.

In order to adapt the European Patent Convention (EPC) more closely to the role of patents in today's economy and to users' needs, the EPC was heavily modified in 2000. The so-called EPC2000 will replace the Convention presently in force by December 2007 at the latest, the exact date depending on the ratification process in the different EPC countries. This article is a review of grant and opposition procedure before the EPO, and also of the most significant amendments which the EPC2000 will introduce.

The EPC2000 has not affected the important principle according to which only grant and opposition procedures are unified before the EPO. National courts of the states designated in the European patent system remain competent for any infringement within their own territorial jurisdiction. Thus the EPC2000 does not establish a single unitary patent. Initiatives such as the Community patent may cause this state of affairs to change in the future. Another possible alternative, although of a different nature, is the European Patent Litigation Agreement (EPLA).

The EPC, and in particular the EPC2000, nevertheless contains some provisions unifying to some extent the rights conferred by a European patent application after publication, and then by a European patent after grant; the authentic text of a patent application or of a patent; the scope of

protection; and the grounds for revocation. In particular, Article 69, which defines the scope of protection of a European patent, is amended to include a special provision requiring that equivalents be taken into account, although no definition is given of what an equivalent is. Most European countries, however, already have a doctrine of equivalents.

Filing, states designation and priority claiming under EPC2000

A general feature of the EPC2000 is that many provisions are harmonised with the Patent Law Treaty (PLT). In particular, the applicant will have the following additional filing possibilities:

- An application in any language, provided a translation into one of the EPO's official languages is filed within three months of the filing of the application.
- A mere reference to a previous application, provided the last one and possibly its translation is filed within two months of the filing of the application.
- A description without claims, provided claims are filed shortly after. However the well-established case law regarding Article 123(2) will still apply under the new Convention and it will be probably very difficult in certain cases to extract a concise claim from a description in which all features are intermingled. In other words, filing a description without claims can lead to situations where there is no clear basis for a concise definition of the invention. This possibility of filing without claims will certainly be useful in some urgent cases but will probably be a source of difficulties for some applicants.

With respect to priority claiming, the EPC2000 is also very liberal. Claiming of priority is possible up to 16 months from the priority claimed or until the filing of a request for early publication. It also gives the applicant the possibility of having its rights re-established with respect to the priority period of 12 months. Re-establishment has to be requested within two months of expiry of the 12 month period. As to the translation of the priority document, it will be requested only if the priority claim is relevant to the determination of patentability. This should result in significant cost savings for the applicant.

The territorial extent of protection remains a strategic tool for the applicant with respect to competitors. As of now, 31 states have joined the EPC, which represents a huge territory and a huge market. Norway will also join the EPC in the near future. According to the EPC2000, all contracting states will be deemed to be designated upon filing in every application. This means that the application will provisionally designate all contracting states. And, regardless of the designated states, any published European application will form part of the state of the art for novelty in view of any latter European application, each application being considered with its relevant filing or priority date. The applicant can still choose (or designate) the states in which protection for the invention is wanted (designated states), normally within six months of the publication of the search report.

The European patent application

The EPC2000 does not change what a European patent application should basically comprise: a description of the invention in terms of structural features and/or method steps and/or technical functions. Advantages, comparative results and examples should also be included, when available.

Explaining the invention in terms of a problem-solution approach with respect to the published prior art is very often a good basis for any future discussion with the EPO on patentability. The EPO examiner could still consider another technical problem, but nevertheless the approach presented by the applicant will be helpful.

Claims, which define what the applicant wants to protect, are very important. Some patent applications are filed with claims which are adequate for another legal system (the US for example), but not for European practice. It is therefore often advisable to

redraft a set of claims based on a prior application before filing in Europe.

Introducing different concise definitions of the invention in the description is also recommended when preparing the application. This, together with broadened dependencies of the dependent claims, will be very helpful and will save time – and the corresponding costs – at any further stage of the examination or opposition procedure.

Preparing the application with these principles in mind gives some potential flexibility in view of the future grant procedure, reduces legal risks and is essential to the value of a future patent.

Concerning substantive patent law, the EPC2000 was signed at a time when the recently withdrawn EC Directive, designed to harmonise the national laws of EU member states on the patentability of computer-related inventions (CRI), was still a possibility. Computer programs as such therefore remain excluded from patentability, although the case law of the EPO today seems quite well established and national decisions regarding patentability of CRIs are increasingly in line with it. This case law and the legal basis in the EPC for CRI will probably remain as they are for a long time.

A legal basis is now included for second therapeutic application, which was formerly a construction of the case law.

The grant procedure

Claims are definitions of the invention and will be the reference when assessing whether any product or process is infringing the patent or not. Claims are therefore essential.

During the grant procedure most of the prosecution work done by the applicant or its European patent attorney (EPA) will concern the claims. The EPC sets out substantive criteria that have to be fulfilled by the claims; these mainly relate to novelty and inventive step. Prosecution work is essential as it determines the value of the patent, not only in judicial but also in economic terms.

The EPO grant procedure first comprises a prior art search. A search report (SR) is drafted and published by the EPO. There is no duty of disclosure, unlike the US practice. However, according to the EPC2000, the EPO may now invite the applicant to provide information on prior art taken into consideration in national or regional patent proceedings. If the applicant fails to reply, the application is deemed to be withdrawn. Is this the beginning of a duty of disclosure at the EPO? The applicant should evaluate

whether any document cited by the EPO should be disclosed in the context of any prosecution abroad, including, of course, in the United States.

If the application as filed contains many independent claims of the same category, and/or very broad claims, the SR will not be very well focused on the invention. Even more problematic is the situation where the claims are too vague or cover non-searchable subject matter. Indeed, in such cases the EPO does not carry out any search: the subsequent stages of the grant procedure are normally based on the SR and a patent cannot be granted if there is no SR. Such a situation is very common with business method applications, but also in other fields; for example, when therapeutical or surgical methods are claimed. In such cases it is strongly recommended that the claims be redrafted before filing in order to claim subject matter not excluded from the search.

Together with the SR, the EPO now issues an opinion on whether the application and the invention meet the requirements of the EPC, the opinion and the SR forming the so-called Extended Search Report (ESR)

A careful consideration of this ESR is essential to evaluate possible future legal risks. At this stage, the applicant can amend the application, which is a good opportunity to prepare for the substantive examination.

Amending the claims during substantive examination is often very delicate work. A typical difficulty arises when the applicant instructs his EPA merely to file a set of claims already granted by another patent office, such as the USPTO. These sets of claims are usually not adapted to EPO practice.

The EPO is very strict with any added subject matter, or any amendment which introduces technical information not contained, at least implicitly, in the application as initially filed. For example, a generalisation of a particular feature very often introduces added subject matter. Certain – but not all – patents granted with added subject matter may be totally revoked in post-grant opposition or by a national court without any possibility for the patentee to overcome an objection of added subject matter. Other patent offices may be more flexible in this respect and sometimes the applicant just instructs the EPA to file another set of claims already granted by another patent office. This is a major risk, as this other set of claims may contain some added subject matter forbidden according to EPO criteria. The mere filing of such a set of claims can be a short-term cost saving, but can also result in huge

losses in the long term.

The EPO has made many efforts to make the whole grant procedure shorter than it used to be. Some periods have been shortened or are no longer extendable, for example the one for responding to the so-called Rule 51(4) Communication. And the fees for further processing are also much higher than in the past. In addition, the EPO still offers applicants the chance to file a request for accelerated examination. This is very efficient, incurs no additional costs and is very helpful to applicants who are interested in a rapid grant, for example because of a licence agreement or a potential litigation, or because they are start-up companies whose investors are not demanding only patent applications, but also granted patents.

Limitation proceedings

The EPC2000 establishes limitation proceedings which did not exist before. The owner of a granted patent will be able to file a request for limitation of its own patent. The Examining Division will examine whether amended claims filed by the owner are a limitation of the granted claims, are clear and comply with Article 123(2)(3) EPC. If not, the patentee will have one opportunity to amend the patent. The request for limitation can be re-filed again at any time. Opposition procedure will take precedence over the limitation procedure: a limitation cannot be filed if opposition proceedings are pending and any limitation procedure will be terminated if an opposition is filed.

Opposition proceedings

Any third party can file an opposition within nine months of the grant of any European patent. It is, of course, a legal risk which has to be taken into account if an economic evaluation of a patent application is performed at a very early stage. The consequences of an opposition can be dramatic, as most oppositions are usually filed after a long grant procedure, and after validation of the patent in several contracting states. In addition, it applies to all contracting states covered by the patent.

The opponent seeks to challenge the patentability of the protected invention. It usually files evidence which was not taken into consideration by the EPO before grant. Noteworthy is the fact that there is no estoppel effect as in the *inter partes* re-examination in the United States. Not citing a document which the opponent could have known about when filing the opposition will not prevent the opponent from using such a

document at a later stage; for example, during any litigation procedure.

The opponent is usually a competitor who feels threatened by the granted patent or someone who has already been directly threatened by the patentee.

For this reason it is preferable for the patentee to wait, as much as possible, for the expiration of the nine-month period after grant before approaching any third party with not only peaceful intentions but also the thought to trigger infringement action. However, this is not always possible, usually for strategic reasons.

In response to an opposition, the patentee has limited opportunities to amend the claims. In addition to being forbidden to add subject matter, the patentee has to deal with another constraint: it cannot extend the scope of the claims. The chances for the patentee to amend the claims are therefore much more limited than during the grant procedure.

An opposition procedure can extend over two or three years. It should be noted that a request for accelerated processing of an opposition is possible when an infringement action is pending before a national court of a contracting state.

The EPC2000 has introduced a legal basis for giving the opposition division the right to examine of its own motion grounds not invoked by the opponent if these could prejudice the maintenance of the patent.

Conclusion

As already explained above, national courts will decide any litigation relating to a European patent. In courts and among judges, awareness of the value of IP assets, and of the necessity to stop any infringement and to award adequate compensation for damages to IP owners, is growing.

The European Union is also aware of the problem of infringement in Europe: see for example Directive 2004/48 on the enforcement of IP rights and Regulation 2003/1383 on customs action against infringing goods, which was extended to patents.

The difficulties of the various procedural steps and the consequences of oversight in dealings before the EPO should therefore be considered very seriously by applicants. Underestimating the consequences of a particular prosecution strategy can have huge consequences, in both legal and economic terms. The EPC2000 offers some flexibility with respect to the former EPC but one should never underestimate the difficulties of the procedure before the EPO.

The Boards of Appeal at the EPO

The Boards of Appeal of the EPO have a vital role to play in the European patenting process

By **Pascal Moutard**, Brevalect, Paris

This article introduces some legal and practical aspects of the appeal procedure before the Boards of Appeal (BoA) of the European Patent Office (EPO).

The BoA have a particular place in the EPO since they are independent: they are bound only by the European Patent Convention (EPC). In addition, they have their own rules of procedure. New Rules of Procedure of the BoA (RPBA) entered into force in 2003. They have led to greater efficiency and shorter appeal proceedings. The EPC2000, which will come into force at the latest in December 2007, does not significantly change the role of the BoA.

Over the last 10 years, the BoA have developed their own procedural rules which are very specific. Some of these are explained below, in particular with respect to the rights of the different parties in the same appeal procedure.

Very different principles apply to examination appeal (*ex parte*) proceedings and opposition appeal (*inter partes*) proceedings.

Decisions subject to appeal

Decisions by the Receiving Section, the Examining Divisions, the Opposition Divisions and the Legal Division at the EPO are subject to appeal. However, opinions by the Search Division on lack of unity, decisions by the President of the EPO and decisions by the BoA themselves are not subject to appeal.

The first main effect of an appeal is suspensive: the appealed decision does not come into force and does not have any legal effect until the BoA issues its decision.

There is no suspensive effect on national procedures; for example, on infringement actions based on a patent subject to appeal. In certain cases, however, a national judge will stay an infringement action until a final decision is issued by the BoA, but there is no obligation to do so, at least not in the United Kingdom, Germany and France.

Persons entitled to appeal

Any party to proceedings adversely affected by a decision may appeal. A party is adversely affected if its requests were not completely satisfied. Such party can be an applicant, a patentee or an opponent. A person having some economic link with a party to the proceedings is not entitled to appeal.

Let us consider the example of an opponent requesting the revocation of a patent in its entirety and the patentee requesting the rejection of the opposition. If the opposition division decides to maintain the patent in an amended form, none of the requests has been completely satisfied. Hence both parties may appeal.

These principles may seem to be obvious. However, a dramatic situation may occur when a patent is assigned to a transferee who has not registered the assignment at the EPO. Only the registered patentee or applicant may file an appeal and a late registration of a transfer does not retroactively validate an appeal.

Any other party to the same proceedings who has not filed an admissible appeal is party to the appeal as of right. However, a party as of right has weaker rights than the appellant filing an appeal, as it can not request "more" than that which it obtained before the first instance and it has no right

to continue an appeal procedure if the sole appellant should withdraw its appeal.

Filing a notice of appeal

A notice of appeal has to be filed within two months of the date of notification of the decision being appealed. It must contain a statement indicating, in particular, the extent to which an amendment or a cancellation of the decision is requested. Within four months after the date of the same notification, written statements specifying in detail the legal or factual reasons why the decision should be set aside have to be filed. A mere reference to previous submissions made during an opposition procedure is usually not considered sufficient.

Another principle is that an appeal should be within the same legal and factual framework as the opposition proceedings or should remain within the same legal and factual framework of the decision made in the first instance.

Incomplete notice of opposition or incomplete grounds of appeal will result in the appeal being considered as inadmissible. The question of admissibility may be raised at any stage of the appeal procedure, even during oral proceedings.

Filing an appeal is a very delicate matter; many decisions reject appeals just because they are inadmissible. Appellants should be aware that filing an appeal is not merely a formal matter, instead the action should be conducted with great care. Once a notice of appeal has been filed, the appellant should not wait until the end of the four-months period to prepare the written statements setting out the grounds for appeal.

The appellant should always consult a European patent attorney to draft the notice of appeal and the written statement: the initial “request” determines the extent of the proceedings

Amendments to granted patents

As a general rule, the EPO proceedings should be conducted expeditiously, in the interests of the public and of the parties. Such rules apply not only to examination and opposition proceedings, but also to the corresponding appeal proceedings.

This means that a patentee who has lost before an opposition division has the right to have rejected requests reconsidered by the BoA, but has no right to file new requests raising issues which the first instance did not look at (the role of an appeal is, in principle, limited to reviewing the appealed decision).

However, the BoA can, at their discretion,

accept amended claims at any stage of the appeal proceedings. They used to admit new requests in appeal proceedings: for example, when they were filed to overcome objections, or when late filings could be justified and when the new requests were *prima facie* admissible. However, the new RPBA specify conditions under which a late filed submission is admissible and these seem to be more restrictive than before.

New requests are refused when their filing is seen as an abuse of procedural rights.

Opposition appeal proceedings

Very delicate situations may occur in the course of opposition appeal proceedings.

In particular, a question was raised whether and to what extent a BoA could depart from the request formulated in the notice of appeal when deciding opposition appeal proceedings to the disadvantage of the appellant.

The Enlarged Board (G 9/92 and G 4/93) concluded that:

1. *If the patentee is sole appellant against an interlocutory decision maintaining his patent in amended form, neither the Board of Appeal nor the non-appealing opponent (as party to the proceedings as of right) can challenge maintenance of the patent as thus amended.*
2. *If the opponent is sole appellant against an interlocutory decision by an opposition division maintaining the patent in amended form, the patentee is primarily restricted in the appeal proceedings to defending the patent as thus maintained.*

If it is the intention of one party to obtain “more” or a “better result” than that which was obtained in the first instance, it should not rely on the fact that the other party has already filed an appeal, it should also file an appeal. In other words, a party as of right does not have the same rights as parties that have filed an admissible appeal. Instead, parties as of right are limited to defending the result obtained in the first instance.

Patentability requirements under examination

The Enlarged BoA has established that only the grounds for opposition already cited at the opposition stage can be considered on appeal. New ones can be introduced only with the consent of the patentee, whose power of veto is applied regardless of the relevance of the new grounds.

In other important decisions (G 1/95 and G 7/95), the Enlarged BoA explained

that “a fresh ground for opposition” means a new legal basis for objecting to maintenance of the patent which was neither raised and substantiated in the notice of opposition nor introduced into the proceedings by the opposition division.

Opposition appeal proceedings are very specific and should be planned with great care. In addition, a party to an opposition appeal procedure will not have the same rights, depending upon its status of appellant or of party as of right.

Examination appeal proceedings

The situation is completely different in examination appeal proceedings: the above principles, applicable to *inter partes* proceedings, do not apply to *ex parte* proceedings.

The Enlarged BoA has ruled that where the examining division refuses an application, the BoA has the power to examine whether the application or the invention to which it related meets the requirements of the EPC. This also holds for requirements the division has not considered in the examination proceedings or regards as fulfilled. In such circumstances, the BoA should, where appropriate, decide either to rule on the case itself or send it back to the examining division. This follows from the fact that an *ex parte* review is not contentious by nature.

Accelerated processing

Parties with a legitimate interest may ask the BoA to deal with their appeals rapidly. The BoA can speed up an appeal as far as the procedural regulations allow.

Requests for accelerated processing must be submitted to the competent BoA either at the beginning of or during proceedings. They should contain reasons for the urgency together with relevant documents; no particular form is required.

By way of example, the following circumstances could justify an appeal being dealt with particularly rapidly:

- Infringement proceedings have been brought or are envisaged.
- Decision of potential licensees of the patent in suit hinges upon the outcome of the appeal proceedings.
- An opposition which is to be given accelerated processing has been made the subject of an appeal.

Appeal proceedings and infringement

An alleged infringer may, subject to specific conditions, intervene in opposition proceedings. Intervention during appeal

proceedings is also admissible. An intervening party can raise any of the grounds for opposition under Article 100 EPC. An intervention is dependent, however, on the extent to which opposition or appeal proceedings are still pending. Should a patentee sue or threaten a third party for infringement before the end of the nine-months period for filing an opposition, the alleged infringer will certainly file an opposition.

What is the influence of such an opposition and of a possible subsequent appeal on the infringement action? The situation differs from state to state. Let us take the example of UK and France.

In UK, the judge usually considers that staying is the preferred option; however, the decisive question is whether staying the procedure would cause any injustice. Several factors are considered, including the delays which are considered a feature of the EPO opposition and subsequent appeal procedures, and the means available to the parties for fighting their case.

In *General Hospital Corporation's European Patent*, a revocation action in the UK was running parallel to opposition proceedings and infringement proceedings in other countries. A stay was granted by the Patent Court because of the injustice to the patentee if the UK proceedings went ahead (the patentee having shown that it could not afford the costs of both proceedings, so being placed in the position of having to surrender the patent if no stay had been granted).

In *Kimberly-Clark v Procter & Gamble*, the judge decided in a similar situation not to stay the infringement action, considering that this would write into the UK proceedings the delays which are a feature of EPO oppositions.

In France there is no provision obliging a French judge to stay the infringement action in such a case. As a general trend, however, the French judge decides to stay the infringement action and to wait for a final decision by the EPO with respect to “a fair administration of justice” (TGI Paris – *Bonzel and Schneider Europe AG v Carbo France* – 18th April 1991; TGI Paris – *Pall Corporation v Flot, Cuno Europe and Cuno Inc* – 16th April 1989).

In some other cases the French judge has not felt that it was necessary to wait for the final decision by the EPO (TGI Paris – *Henlopen Manufacturing Co Inc v Lab Payot, Sofadis, Geka France and Georg Karl Brush GmbH*, 10th July 1991).

Decisions by the Boards of Appeal

The BoA may hand down a final decision in a

case or may send it back to the first instance department which originally issued the appealed decision.

Remittance to the first instance occurs, in particular, when a new piece of prior art is cited in the course of the appeal proceedings, which the BoA decides to take into consideration; or because of a substantial procedural error made by the first instance; or because of substantial amendments made by the appellant.

The first instance department to which the case is remitted is bound by the reasons or findings that support the BoA's decision or that are essential to that decision. The binding effect is only for the case remitted to the first instance, not for any other case and not for any other instance. For example, if a BoA issues a decision cancelling a former decision of an examining division regarding inventive step, an opposition division is not bound by this.

There is, in principle, no binding effect on national procedures. For example, according to the 10th Civil Senate of the German Federal Court of Justice, comments made in the grounds for a decision in an EPO opposition or in a subsequent appeal procedure are considered as expert opinions which must be taken into account, no more and no less.

Enlarged Board of Appeal

The Enlarged BoA is not a third degree of jurisdiction. Its job is to ensure uniform application of the law, or it decides or gives opinions when an important point of law arises.

According to Article 112 EPC, it is responsible for: deciding points of law referred to it by BoA; or for giving opinions on points of law referred to it by the President of the EPO when two BoA have given different decisions on that question.

According to new Article 112a of EPC 2000, the Enlarged BoA will also be responsible for deciding on petitions for review of decisions of the BoA. Such petitions may, in particular, be filed on grounds such as a fundamental violation of the right to be heard or any fundamental procedural defect.

Filing divisional applications in Europe: a dangerous hobby?

The EPO Boards of Appeal have recently considered a series of important issues relating to divisional applications

By **Hans Hutter**, Nederlandsch Octrooibureau, The Hague

In the United States, it is quite common for applicants to file one or more divisional or continuation applications for important technological developments. To that end, patent attorneys sometimes try to draft new claims in a still pending application that may read on products already on the market from competitors and file these claims in such a divisional or continuation application. The parent application of the divisional or continuation application may itself be a divisional or continuation application.

The great advantage is, of course, that one sees the competitor's product and one can seek the proper words from the description or drawings, and try to map a new claim on the existing product. Of course, also in the United States, care should be taken not to extend the subject matter of the application as originally filed. However, the United States Patent and Trademark Office (USPTO) is, in practice, rather flexible.

The European Patent Office allows divisional applications to be filed from a pending patent application, although the concept of continuation applications, whereby the USPTO allows subject matter to be added, is missing in Europe. But by filing one or more divisional applications from a divisional application in a sequence, it seems that some European patent applicants are attempting to copy the United States continuation application practice. However, adding subject matter is not allowed: the European Patent Office (EPO) has always been stricter in its requirements as to extension of subject matter than the USPTO.

In recent decisions of the Boards of Appeal (BoA) of the EPO, very important questions of law as to divisional applications have been referred to the Enlarged Board of Appeal (EBoA). This article discusses and explains these questions. Moreover, some issues not addressed by the BoA's will be addressed.

Questions referred to EBoA in decision T39/03

In decision T39/03, dated 26th August 2005, BoA 3.4.2 decided to refer several questions of law to the EBoA and these questions are now pending as G1/05. Basically, the main question addressed by T39/03 is: "Is a divisional application containing added matter on the date of filing a valid or invalid application and can it be corrected during proceedings before the EPO, even if the parent is not pending anymore?"

BoA 3.4.2 had already dealt with some other issues relating to divisional applications in earlier decisions T720/02 and T797/02. These were issued the same day and have largely the same content.

In T720/02, the BoA was confronted with the following situation. The decision under appeal related to a patent application that itself was a divisional application from an earlier application (the parent application), where the parent application itself was in turn a divisional application from a still earlier application (the grandparent application). The examining division examining the application had decided that the application contained an extension of subject matter as the main claim was missing a feature that had been presented consistently as being essential.

With reference to earlier decision

T1158/01, this BoA concluded that the EPC does allow the filing of a divisional application from an earlier application that itself is a divisional application. However, the issue discussed at length in T720/02 was the time limit for filing a divisional application from another divisional application. The BoA referred to Rule 25(1) EPC which reads as follows: “The applicant may file a divisional application relating to any pending earlier European patent application.”

Afraid of the possibility of filing an almost endless chain of divisional applications, something that would leave the public in great uncertainty as to which potential rights are outstanding, the BoA observed that Rule 25(1) establishes the time period in which all possible divisional applications should be filed (ie, all possible divisional applications from a parent application can be filed only while the parent application is pending). In the Board’s view, it should be evident to the public which other inventions will be claimed by the applicant of the parent application before it is granted. Any other solution would be detrimental to the public interest: “By the mere filing of recurrent cascading divisional applications, to leave the public completely uncertain during most of the life of a patent as to how much of the subject-matter of the original patent application might still be claimed. This would indeed pave the way for potential misuse by applicants of the possibility afforded by the EPC to file divisional applications.”

The BoA even expressly denounced the current US system in this respect: “The obviously unacceptable consequences of the position advocated by the appellant, which in effect would result in the setting up of a system of ‘continuation applications’ of the type explicitly provided for in the US patent law, but for which there is no basis in the [European Patent] Convention.”

Therefore, the BoA decided that, in order for a divisional application of which the parent application is itself a divisional application to meet the requirements of Article 76 and Rule 25(1) EPC, it must be directed to an object that is already claimed in the parent application. In other words, a first divisional must contain in its claims all subject matter that is eventually to be divided from an application.

Interestingly enough, the BoA expressly stated that this view was so obvious that it concerned a referral to the EBoA as unnecessary.

In T39/03, the same BoA supported its earlier views as expressed in T720/02.

However, the essential issue here was related to another legal problem of divisional applications. In T39/03, the decision under appeal related not to a divisional from a divisional application, but to a first generation divisional application. Again, the problem was that the examining division was of the opinion that a feature that was presented in the earlier application as being essential was missing from the divisional claims such that they contained added subject matter. The BoA supported this point of view.

However, the BoA raised the issue that it may well be that this cannot be corrected anymore in proceedings before the EPO since Article 76(1) requires: “A European divisional application must be filed directly with the European Patent Office in Munich or its branch at The Hague. It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed; in so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority.”

The BoA considered Article 76(1) to imply that, if the requirements of Article 76(1) are not met, the divisional application cannot be afforded a filing date and is, therefore, invalid.

In its decision, the BoA devoted much attention to the consequences of this line of reasoning to chains of divisional applications: if in a chain of divisional applications an intermediate application turns out to be invalid due to being filed inclusive of added subject matter, all the divisional applications being filed after this intermediate application and being (in)directly dependent upon this intermediate application should be considered “invalid” too.

Understanding the great legal consequences of this reasoning for many applicants and patent proprietors, the BoA decided to refer the following questions to the EBoA:

1. *Can a divisional application which does not meet the requirements of Article 76(1) EPC because, at its actual filing date, it extends beyond the content of the earlier application, be amended later in order to make it a valid divisional application?*
2. *If the answer to question (1) is yes, is this still possible when the earlier application is no longer pending?*
3. *If the answer to question (2) is yes, are there any further limitations of substance to this possibility beyond those imposed*

by Articles 76(1) and 123(2) EPC? Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?

Note that the last portion of question 3 (“Can the corrected divisional application in particular be directed to aspects of the earlier application not encompassed by those to which the divisional as filed had been directed?”) seems a little strange. If it asks for an express denial of the option to change the original subject matter of the divisional application to subject matter not forming unity of invention with this original subject matter, there seems to be no way of getting a positive answer. There is no way claims in a pending application in Europe can be substituted by a set of claims that are directed at a different invention. Maybe this portion of question 3 is an attempt to smuggle a question relating to chains of divisional applications into the referral, in the sense that it requests the EBoA to give an opinion about whether a first divisional should already claim all subject matter that should be divided out of the parent application (a question that could not expressly be asked since the case at hand was not about a divisional from a divisional application).

Questions referred to EBoA in decision T1409/05

In T1409/05, BoA 3.4.03 found several issues where it had great difficulty in supporting the point of view expressed in earlier decisions such as T720/02 and T39/03.

T1409/05 dealt with a situation where a divisional was filed from a parent application that itself was also a divisional application. So, it could officially raise all issues dealt with by BoA 3.4.2 both in T720/02 and in T39/03. And so it did.

For deciding whether a divisional application contains added subject matter which is not allowed by Article 76(1), T1409/05 refers to still earlier case law. This earlier case law has consistently shown over the years that “content of the application” as referred to in Article 76(1) is to be interpreted as “the total technical information content of the disclosure”, including claims and description. So, its conclusion is that Article 76(1) does not provide any basis for the point of view that a divisional application of a divisional application can be directed only to subject matter already claimed in the

parent application. Any support, even in the description or drawings, in any earlier application is enough.

Moreover, it concluded that public uncertainty as to when subject matter is divided from a pending application (that itself may be a divisional in a chain of divisional applications), possibly resulting in misuse or unfairness, is no legal concept. It even observed that uncertainty is inherent to the patent system where applications remain secret for a period of 18 months after the first priority date!

As to whether a divisional application can be declared invalid due to the application containing added subject matter in view of its parent, as defended in T39/03, this BoA has no doubts whatsoever: “There is no basis in the EPC for the concept of an “invalid” application and it does not seem appropriate to draw legal consequences from the perceived properties of non-existent legal categories. In fact, the terms ‘valid’ or ‘invalid’ do not occur in the EPC.”

So, the conclusion of this BoA is that every pending application should have been accorded a filing date. In its view, the requirements of Article 76(1) are mere requirements for grant (ie, the legal consequence of not meeting the requirements of Article 76(1) is that the application shall not be allowed to proceed to grant). The requirements of Article 76(1) are, thus, similar to requirements such as novelty and inventive step.

So, according to this BoA, a divisional application cannot become simply invalid due to one of its predecessors in a chain of divisional applications being invalid for being filed with claims that contained added matter relative to one or more earlier applications in the chain.

In fact, the legal remedy to all uncertainties as referred to by these earlier BoA decisions seems to be straightforward for this BoA: just check whether any subject matter is “smuggled in” in a divisional application by comparing its content with all earlier applications in the chain as filed: “On this board’s interpretation it would suffice for compliance with Article 76(1) EPC that what is disclosed in the application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed.”

Even though this BoA based its interpretation on well-established case law, it recognised the conflicts with the reasonings of several recent other decisions, and it referred the following questions of law to the EBoA:

1. *In the case of a sequence of applications consisting of a root (originating) application followed by a divisional applications, each divided from its predecessor, is it a necessary and sufficient condition for a divisional application of that sequence to comply with Article 76(1) EPC, second sentence, that anything disclosed in that divisional application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed?*
2. *If the above condition is not sufficient, does said sentence impose the additional requirement*
 - a. *that the subject-matter of the claims of said divisional be nested within the subject-matter of the claims of its predecessors? or*
 - b. *that all the divisional predecessors of said divisional comply with Article 76(1) EPC?*

Question referred to EBoA in decision T1040/04

In the last decision to be discussed here, T1040/04, BoA 3.2.03 had to decide about a case where it had found that a patent opposed in opposition proceedings contained extended subject matter in its description (so, not in its claims). This BoA recognised that this situation could result in similar questions as those referred to the EBoA in T39/03. However, the BoA also recognised that in view of T39/03, the EBoA would most probably not deal with granted patents in opposition proceedings. Therefore, in order to avoid the risk of obtaining a decision of the EBoA that did not deal with this situation, in T1040/04 BoA decided to refer the following question to the EBoA: "Can a patent which has been granted on a divisional application which did not meet the requirements of Article 76(1) EPC because at its actual filing it extended beyond the content of the earlier application, be amended during opposition proceedings in order to overcome the ground of opposition under Article 100(c) EPC and thereby fulfil said requirements?"

Still open issues not referred to EBoA

In the writer's view, in T1409/05, the BoA has missed at least two issues that could have been referred to the EBoA:

- As indicated above, this BoA concluded: "On this board's interpretation it would suffice for compliance with Article 76(1) EPC that what is disclosed in the

application be directly, unambiguously and separately derivable from what is disclosed in each of the preceding applications as filed." However, this is not exactly the same as what is required by Article 76(1), which says: "It may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed." So, Article 76(1) seems to allow a test of extension of subject matter relative only to the direct parent application and not to each earlier application. Of course, a test relative to all earlier applications is much better from a legal point of view (no one can smuggle subject matter into the description of a divisional and then later claim it in a divisional from that divisional anymore), but it would have clarified things if this issue had been referred to the EBoA too.

- In T1409/05, the BoA states that the EPC does not define valid or invalid patent applications. Thus T1409/05 concludes that the requirement of Article 76(1) that the divisional "may be filed only in respect of subject-matter which does not extend beyond the content of the earlier application as filed" cannot result in invalid patent applications. Thus, the BoA concludes that the filing date is the filing date of the parent application.

However, Article 76(1) seems to support another possible interpretation as it also states: "In so far as this provision is complied with, the divisional application shall be deemed to have been filed on the date of filing of the earlier application and shall have the benefit of any right to priority." So, in the writer's view, not meeting the requirement of avoiding extension of subject matter can also result in the observation that the claim of the application of being a divisional application is not granted. Then, the sanction would be that the effective filing date is not the filing date of the parent application but the actual filing date with the EPO. Of course, if correction is allowed during prosecution, this can be corrected (like an improper claim of priority due to extension of subject matter can be corrected during prosecution).

Of course, this interpretation would result in other problems:

1. the parent would become prior art to the application where the parent may provide serious inventive step problems;

2. moreover, this interpretation would introduce similar problems as encountered in the analysis made in T720/02: a divisional application from an earlier divisional application could all of a sudden lose its effective date if the earlier divisional application turns out to contain added matter. This problem can still be present after all divisional applications in a chain of applications have been granted, resulting in great legal uncertainty for patent proprietors.

Thus, bearing all these uncertainties in mind and being unsure about what the EBoA is going to decide, the writer's advice would be the following: if one is considering protecting more than one other invention than the one already claimed in a patent application, either file a separate divisional application per separate invention within the time limit prescribed by Rule 25(1) or file one divisional application with separate sets of independent claims per invention within that time limit.

A tale of spiders and torpedoes

The ECJ's recent decisions in *GAT v LuK* and *Roche v Primus* will make life much harder for patentees seeking to enforce their rights in cases involving more than one European country

By **Christophe Ronse**, ALTIUS Law Firm, Brussels

For reasons inspired by the cost and complication of patent litigation, many patentees have traditionally sought ways to avail themselves of patent protection through cross-border injunctions covering as many countries of the European Union as possible.

In pursuing such endeavours, however, the patentee is restricted by the rule that a defendant established in the European Union should normally be sued before the courts of its country of domicile; this under the general principles on jurisdiction established by the Brussels Convention (now superseded by EC Regulation 44/2001) and the Lugano Convention. Only under certain exceptions can a defendant be sued in another member state of the European Union or the European Economic Area. This particularly raises an issue where the allegedly infringing products are marketed in various European countries by separate legal entities.

Furthermore, as a European patent consists only of a bundle of national patents subject to their respective national rules on enforcement and infringement, there has always been a high degree of uncertainty as to whether and how a national court could judge on the infringement or absence thereof of foreign (parallel) patents. In view of the connection existing between the various national claims, the German, Belgian and, in particular, Dutch courts have shown a certain willingness to assert jurisdiction *vis-à-vis* defendants established in various European Union member states. Applying the so-called spider in the web theory, the Dutch courts have considered themselves competent to

judge on patent infringements committed by defendant companies belonging to the same group or otherwise cooperating in the infringing activities pursuant to a joint plan, when the entity responsible for the implementation thereof is domiciled either in the Netherlands or outside Europe. Other national courts, such as the English courts, have been much more reluctant to grant such pan-European relief.

Conversely, potential infringers have sought ways to prevent patentees from asserting their rights in certain countries by bringing actions for declaration of non-infringement, or so-called torpedo actions, in other countries – such as Belgium or Italy – where courts are allegedly less diligent in furthering patent cases. In doing this, they seek to block the infringement proceedings in the former countries through the application of the rules of *lis pendens* available in the European Union. Although such attempts are based on a doubtful assumption – at least as far as the speed of Belgian proceedings is concerned – and have consistently been rejected (by the Belgian courts, for example), the strategy has to some extent been effective. This is particularly the case in Germany, whose courts have traditionally acknowledged the suspensive effect of non-infringement proceedings in other European countries relating to the same patent and subject matter.

All this may now be changing, however. Following the long-awaited decisions of the European Court of Justice (ECJ) in *GAT v LuK* (case C-4/03) and *Roche v Primus* (case C-539/03) rendered on 13th July 2006, patentees seeking pan-European relief are likely to find it much harder to get. The decisions highlight the inadequacy of the present European rules on international

jurisdiction when it comes to the enforcement of European patents.

Invalidity as a ground for opposing jurisdiction

GAT v LuK concerned a dispute between two German companies active in the automotive industry. The plaintiff sought a declaratory judgment before the Düsseldorf *Landgericht* that it had not infringed the defendant's French patents, which it alleged to be invalid. The lower court accepted jurisdiction, but on appeal the *Oberlandesgericht* decided to seek a preliminary ruling from the ECJ on the interpretation of Article 16(4) of the Brussels Convention (presently Article 22(4) of Regulation 44/2001). This provides for the exclusive jurisdiction of the courts of the country where a patent has been issued in proceedings concerned with the validity of such patents.

In line with the opinion of the Advocate-General, the ECJ gave a broad interpretation to this rule and stated that it applied to all proceedings relating to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection. In short, national courts of member states other than in which the patent has been issued are precluded from assessing the validity of the patent.

Needless to say, even if this limitation does not apply to the infringement claim *per se*, the practical downside of this ruling will probably be that a defendant in pan-European patent proceedings will only have to raise a defence based on the alleged invalidity of the foreign patent(s) at stake to frustrate the efforts of the patentee to obtain a cross-border injunction. Indeed, a national court will be reluctant to allocate a claim on infringement in the presence of a serious invalidity defence and will undoubtedly prefer to stay the proceedings until this matter has been decided upon by the national court having jurisdiction in the matter.

One can thus only conclude that *GAT v LuK* has created a new type of torpedo for alleged patent infringers confronted by cross-border patent claims, provided that they can invoke a validity defence which has sufficient merit.

No more multiple defendants

Even if no invalidity issue is at stake, the ruling of the Court of Justice in the *Roche v Primus* case is likely to render any centralisation of patent infringement proceedings impossible in many other instances.

In this case, two US patentees had

brought infringement proceedings in the Netherlands against the local Roche subsidiary and various other affiliates established in other member states of the European Union. As the defendants objected to the territorial jurisdiction of the Dutch courts *vis-à-vis* the defendants established in other member states of the European Union, the Dutch *Hoge Raad* decided to seek a preliminary ruling from the European Court of Justice on the interpretation of Article 6(1) of the Brussels Convention (presently Article 6(1) of Regulation 44/2001). This provides that a defendant established in another member state of the European Union may also be sued, where he is one of a number of defendants, in the courts of the place where any one of them is domiciled. The provision had previously been interpreted by the ECJ as applying only in those cases where the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings. This interpretation has since been espoused by Regulation 44/2001.

In its ruling, the ECJ held that the requirement for a connection is not met in a situation where patent infringement proceedings based on the same European patent are brought in different European Union member states, involving a number of defendants domiciled in those states, in respect of acts committed in their territory. This is so even if those defendants belong to the same group of companies and may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them. According to the Court, only an identical legal and factual situation can give rise to irreconcilable decisions and it does not suffice that there could be a divergence in the outcome of the dispute.

With regard to pan-European patent infringement, the Court considered that the same situation of fact cannot be inferred, since defendants are different and the alleged infringements are not the same. Neither will the same legal situation arise, as the infringement of a European patent must be assessed in the light of the national law of each country for which it has been granted. The fact that European patents are governed by common rules (particularly when it comes to defining their scope of protection) and that decisions by the various national courts should presumably present a certain degree of harmony was thus held insufficient by the Court to consider that a sufficient connection was present in order to allow

foreign defendants to be sued in another member state of the European Union.

The end of cross-border injunctions?

Even if their wording is not always crystal clear, the joint reading of the above decisions of the ECJ are likely to mean that cross-border enforcement of patent rights in proceedings on the merits will become much more arduous, if not practically impossible, under the present Community rules on jurisdiction. In order to avoid any defence based on the lack of jurisdiction, the patentee will be obliged to sue potential infringers in each separate country where they are established and/or can be proven to have committed infringing acts.

Of course, it will remain possible to claim cross-border relief against a single party which has committed alleged infringements in various European states before the courts of the latter's home state, at least provided this party does not challenge the validity of the foreign patent. Depending upon the provisions of national judicial law, such proceedings could possibly also be extended to include any non-European defendants who cannot avail themselves of the provisions of EC Regulation 44/2001 or the Lugano Convention. However, it is doubtful that such a concurrence of circumstances will frequently arise.

More importantly, patentees might take some comfort from the fact that the ECJ's jurisprudence should not affect the patentee's ability to seek a cross-border injunction on a preliminary basis in application of Article 31 of Regulation 44/2001, respectively Article 24 of the Lugano Convention, which needs to be interpreted separately from the other provisions of these legal instruments. In order to prevail in summary proceedings and obtain provisional measures – according to the present jurisprudence of the ECJ – the patentee must demonstrate the existence of a real connecting link between the subject matter of the measures sought and the territorial jurisdiction of the country of the court before which those measures are sought. This threshold is undoubtedly much lower than that imposed by *Roche v Primus* (identity of the factual and legal situation). Depending on the facts of the case, it will most probably allow patentees to obtain cross-border preliminary relief in certain countries against alleged infringers established in other European countries in respect of infringements committed abroad. It remains to be seen, however, whether the possibility of preliminary relief will be of any

avail to the patentee, as summary proceedings need to be followed up by proceedings on the merits.

The present situation thus remains quite unsatisfactory and severely restrains a patentee's opportunities to seek adequate cross-border relief at an acceptable cost within a reasonable period of time. Undoubtedly, this will further stoke the debate relating to the European Patent Litigation Agreement (EPLA) or the introduction of the Community patent, something that the ECJ may have intended. This process is, however, expected to take several years and the outcome remains uncertain. In the meantime, cross-border patent litigation will remain in turmoil, with only a limited number of options for cross-border litigation remaining available.

Strategic issues concerning patent litigation in Europe

Cross-border patent litigation remains as complex as ever. However, there is some hope that there will be a simpler system in future

By **Tom Carver** and **Nigel Stoate**,
Taylor Wessing, London

In the absence of any European legislation providing specifically for pan-European patent litigation, patent owners have had to think laterally about how to enforce their European patents. Until recently, the Dutch courts used to interpret the Brussels Convention on Jurisdiction and the Enforcement of Judgments in Civil and Commercial Matters as permitting them to grant injunctions in every EU member state in which a patentee held a designation of a European patent, as long as one of the related infringing companies was based in the Netherlands. However, the European Court of Justice (ECJ) ruled in *GAT v LuK* that cases against a group of companies based in different EU member states, each infringing equivalent national designations of European patents, cannot be joined in one action in one country and, in *Roche v Primus*, that courts in one jurisdiction may not entertain proceedings in which the validity of patents registered in other jurisdictions is raised.

Forum shopping

The ECJ's decision means that until the Community patent, the EPLA or the London Agreement becomes a reality, there are still multiple jurisdictions with different procedures and characteristics, and companies need to choose carefully the jurisdiction in which they are most likely to achieve their aim – be it to enforce patent rights or to defend against such enforcement. Clearly, if a patent is held only in one country, or if an infringer is operating only in one country, then there will be no

need to consider in which forum to litigate. However, it is more common that a patentee will hold multiple designations of a European patent and an alleged infringer will be operating in several countries at the same time, and this means that both parties will have a choice of jurisdiction in which to resolve any dispute.

Generally speaking, following the recent clarification of the law in *GAT v LuK*, a patent owner will have to bring separate proceedings in each country where its rights are infringed. It is tactically important to decide where best to bring the proceedings and in what order, because early decisions in one country may set a precedent for later proceedings, particularly if the earlier decision was from a specialist court.

The three countries often regarded as having the most developed patent litigation systems in Europe are the Netherlands, Germany and the UK. Each of these three jurisdictions has a specialised patent court and a range of procedures available to both the patentee and the alleged infringer including injunctions, revocation actions and infringement actions, and each will generally produce a decision in infringement proceedings at first instance within about a year (validity proceedings in Germany will take up to two years). However, the judgments are reached by quite different processes.

The most obvious difference between the common law system in the UK and the civil law systems on the continent is that disclosure is available to parties in the UK. Clearly, disclosure of documents relating either to an allegedly infringing article or to the making of the alleged invention provides useful ammunition to the receiving party, which may (subject to confidentiality and

court rules) be used in other jurisdictions.

The adversarial nature of the UK system is reflected in the preparation of evidence. In the Netherlands and Germany the court appoints an expert to prepare an unexamined report (parties may appoint their own experts but these are generally considered not to be independent and their views are therefore not given much weight), whereas in the UK both parties appoint their own expert and both parties have the opportunity to cross-examine the other party's expert. This enables a very thorough examination of the merits of the case to be conducted by the court.

A further difference between the jurisdictions is the rigour with which experimental evidence is gathered. For example, experimental evidence can be submitted in Germany and the Netherlands, but there is no requirement in these jurisdictions for the experiment to be witnessed by the opponent and therefore the results cannot be given the same weight as in the UK, where experiments which are relied on must be repeated in the presence of representatives of the other side. Additionally, following a recent change to the practice in the UK, the protocol and results of any work-up experiments preceding the actual witnessed experiments must also be disclosed to the other side. This procedure ensures that a party cannot practise an experiment in private and submit only one result to the court: all the practice results need to be disclosed.

Of course, one consequence of the thorough analysis of a patent action conducted by the UK courts is that it will cost more than a case in, say, the Netherlands or Germany. However, this is balanced by the fact that the winning party will normally recover a large proportion of its costs in the UK, but not in Germany or the Netherlands. In Germany, the winning party will recover some of its costs on a fee scale, but this rarely compensates it for the costs actually incurred. The position in the Netherlands is similar to Germany in that only some fixed costs are recoverable, although it remains to be seen whether this will change since EC Directive 2004/84, which seeks to harmonise the position across Europe, came into force in April 2006.

Legal aspects

In theory, the scope of every European patent is interpreted according to the Protocol on the Interpretation of Article 69 of the European Patent Convention. However,

each national court does not necessarily interpret the Protocol, and therefore patents, in the same way. In addition, the quirks of each national system make harmonised interpretation very difficult.

In Germany, courts use a doctrine of equivalents to construe claims and they have a bifurcated system, hearing trials of infringement and validity in separate courts. The combination of an absence of squeeze arguments (caused by the bifurcated system) and a doctrine of equivalents means that it is sometimes easier to obtain a judgment of infringement in Germany than it is in the UK, where infringement and validity are tried together, thus enabling so-called validity/infringement squeeze arguments, and where there is no doctrine of equivalents. The Netherlands sits neatly in the middle using a doctrine of equivalents but hearing issues of validity and infringement together.

Jurisdictions also vary in terms of the procedures for interim injunctions. In the UK a patent is presumed valid and an injunction can be granted within a matter of days based on technical evidence that there is an arguable case that the patent is infringed, and commercial evidence that the balance of convenience is in favour of an injunction. This contrasts with the Netherlands, where there is a full preliminary review of the merits of the case based on expert affidavits and witness statements, and the time from writ to hearing is likely to be about six weeks with a further two weeks until judgment. Likewise, in Germany an interim injunction hearing is almost a mini-trial, which will consider the strength of the patent and the likelihood of infringement as well as the commercial arguments, usually taking between two and four months to obtain a decision.

As for the other jurisdictions in Europe, they all have patent litigation conducted in courts ranging from the very experienced to the comparatively untested. While by no means binding, an earlier judgment from one of the more experienced patent countries is likely to be persuasive.

EPO proceedings

There is one further very important 'jurisdiction' which has not been mentioned and that is the European Patent Office (EPO). The national designations of a European patent are all the result of a single application to the EPO. The application is examined by the EPO and, if deemed to fulfil the criteria, is granted as a bundle of national patents. Once a patent is granted by

the EPO any third party has nine months in which to register an Opposition and attempt to have the patent revoked. Oppositions can last many years but culminate in what is usually a one-day hearing at which the patent can be maintained, amended or revoked on the basis of written submissions and an oral hearing, if requested. If the patent is revoked by the EPO, it is revoked *ab initio* and every national designation is revoked with it. The same applies if the result of the Opposition is an amendment.

EPO proceedings affect national proceedings in different ways. If there is an EPO Opposition on foot against a patent then in Germany it is not possible to commence national revocation proceedings. So the patentee may sue an alleged infringer for infringement and the infringer cannot retaliate with a revocation (at least not in Germany: retaliatory proceedings in the UK, the Netherlands or any other jurisdiction are, however, perfectly possible). At the opposite end of the spectrum the UK courts are unlikely to grant a stay of revocation or infringement proceedings on the basis that there is an Opposition in the EPO (but note that it is possible for a patentee to win in the UK and then for the EPO to revoke a patent, and in such circumstances the infringer will still be required to pay any damages already granted by the UK court). As usual, the Netherlands sits in the middle and will grant a stay of national revocation proceedings on the basis of an EPO Opposition if certain requirements are fulfilled.

RIM v InPro

The recent judgments in the United Kingdom and Germany in the patent litigation in *Research in Motion v InPro Licensing SARL* have highlighted the differences between the jurisdictions and demonstrated the lengths to which parties will forum shop to steal maximum tactical advantage.

Early in 2005 InPro commenced action against T-Mobile in the District Court in Düsseldorf alleging that T-Mobile was infringing its European patent by offering and implementing the BlackBerry system in Germany. RIM intervened in the proceedings in support of T-Mobile, its customer, and retaliated in the usual way by commencing revocation proceedings against the patent. However, RIM was faced with the serious problem that the infringement trial seemed certain to be decided several months in advance of the validity trial, thus leaving a gap of several months during which T-Mobile might be enjoined and not be able to

provide the BlackBerry service.

Clearly, this was not satisfactory and RIM therefore brought proceedings in the UK to revoke the UK designation of the same patent with the aim of obtaining a favourable result in the UK which might be useful in convincing the Düsseldorf court that the infringement proceedings in Germany should be stayed until the validity proceedings had been heard. Infringement hearings in Germany are stayed on the basis of pending validity actions only if there is strong evidence that the revocation is likely to succeed. In the event, the UK action was not necessary because the Federal Patent Court of Germany managed to hear the case in good time and revoked the patent in advance of the infringement hearing.

Future developments in European patent litigation

It may be that forum shopping will soon be reduced in importance. There have been a number of developments (possibly prompted by the ECJ's decision in *GAT v Luk*) which mean that the pipedreams that have been the European Patent Litigation Agreement (EPLA), the Community patent and the London Agreement may one day be realised.

London Agreement

The London Agreement aims to create a cost-effective post-grant translation regime for European patents. The parties to the agreement waive the requirement for translations of European patents to be filed in their national language, meaning that all European patents will be translated into only a few languages.

The chief remaining obstacle to the London Agreement coming into force has been ratification by France, but France's Constitutional Council recently ruled that the Agreement complies with the French constitution and this enables parliament and the president to proceed with the ratification process. If/when it comes into force it should significantly reduce the cost of obtaining European patents, but not the cost of litigating them.

European Patent Litigation Agreement (EPLA)

It is hoped that the EPLA will help reduce the cost of litigation. The European Commission is due to make a formal proposal on patent litigation, centred around the EPLA, before the end of the year. The EPLA is a non-EU treaty which would establish a European Patent Judiciary (EPJ) to create and run a European Patent Court which would hear

litigation concerning infringement and validity of patents granted by the EPO. This will enable European patents to be litigated on a pan-European basis in one court rather than the current system of litigating in each country where the patent is in dispute, which should significantly reduce litigation costs given that there will be only one trial.

Charles McCreevy, European Commissioner for Internal Market and Services, broadly supported the EPLA in a speech he gave on 8th September. However, if the EPLA conflicts with the *acquis communautaire* of the EU then member states would not be free to sign up to the EPLA independently, being reliant on the EU to accede to the agreement on their behalf. The potential conflict is being examined by the European Commission's legal department and in the meantime the European Parliament voted on 12 October to postpone the EU's accession so that 'significant improvements' could be made to it in terms of democratic control, judicial independence and litigation costs. Clearly, if there is no conflict with the *acquis communautaire* then member states would be free to sign up to the EPLA independently.

Community patent

The agenda behind the EU's opposition to the EPLA is that it has its own project in the Community patent. The Community patent will be, as the name implies, an EU patent system created by directive or regulation and regulated and enforced by the European Commission. It was first suggested as long ago as the 1970s but politics, in particular the politics of languages, has always prevented it becoming a reality. This scenario is unlikely to change as there are important issues to resolve which stem from the commitment of the EU to operate in each language of the Community.

The EU ideal would be to translate every Community patent into every language, but given that there are 20 official languages the cost of this would be prohibitive. Accordingly, it has been suggested that Community patents should be published in only a few languages (as is the proposal for European patents under the London Agreement). However, this resolves neither what language a patent should be litigated in, nor the relative weight given to the meaning of translations of the patent claims as opposed to claims in their original language. In addition, if a Community patent were only translated into, say, three languages, then is it right that people can be affected by a third-party right

which they cannot understand? Obviously, the issue of language also applies to the EPLA but can be sidestepped more easily because the EPLA is not required to operate in the language of each EU member state.

Conclusion

As you can see, it has been an interesting year in patent litigation, what with pan-European injunctions being ruled out and litigants becoming ever more sophisticated about forum shopping. It would be good if these jolts to the system encouraged the parties behind the various treaties to finalise their arrangements and create an accessible and effective system of pan-European patent litigation.

Patent enforcement in Norway

Norway has to be factored into any pan-Scandinavian patenting strategy, although the country will probably not become a member of the European Patent Convention until the end of 2007

By **Jens Fredrik C Langfeldt**, Zacco Norway AS, Oslo

Following two referendums, Norway is still not a member of the European Union and membership is currently not on the agenda. Although the Norwegian Patent Act has to a large extent been harmonised with the European Patent Convention (EPC), Norway has still not joined the EPC. This has over the years largely been due to the controversial issue of patent protection for biotechnology inventions, a bar no longer present. The government decided in early 2006 that Norway should join the EPC by no later than the end of 2007, and, after a hearing in 2006, Parliament is likely to decide upon the government proposal before the end of 2006 or very early in 2007.

In order to obtain patent protection in Norway, national filing through Convention or non-Convention application or via the PCT is therefore necessary at present. Designation of Norway via the EPC/European patent is not yet possible.

With its stable and strong economy, wide variety of industries, oil and gas installations, and hydro-electric power, Norway has proved to be a country in which foreign companies wish to obtain patent protection.

Approximately 5,000 to 5,500 patent applications of foreign origin are filed each year, most of them through the PCT system.

Compared with countries belonging to the EPC, Norway is not all that different when it comes to enforcement of patent rights. Notably, marking on products or brochures is not mandatory. Normally, an infringer is initially warned through a warning letter and if an amicable settlement is not

reached, a preliminary injunction or regular infringement suit may be filed.

A court in a patent suit normally has one professional judge and two appointed lay judges, the lay judges being familiar with patent rights and in most cases also with the technical art of the patent at issue. However, lay judges are not mandatory.

An appointed Norwegian lawyer (attorney at law) normally represents the patentee. Further, the patentee or other representative of the patentee, as well as any opposing party or its representative, may also be present in the courtroom. As a lawyer is not expected to be an expert on the invention in question, the patent attorney who processed the patent application will normally assist the lawyer prior to and during court proceedings. Further, the lawyer of the opposing party may be assisted by a patent attorney.

The role of the Oslo District Court

Invalidation suits (which, in many cases, defendants file as a countermeasure) must be dealt with at the Oslo District Court. Both the lawyer representing the defendant and the lawyer representing the plaintiff cross-examine witnesses, as do the professional judge and any appointed lay judges. Preliminary proceedings are based on established facts, such as proof of infringement or harmful prior art. Oral and written evidence from experts is normal.

If the defendant, through a separate suit for invalidation, counteracts a suit for claimed infringement, the invalidation issue will be dealt with first. If the infringement suit has been brought before any court other than the Oslo District Court, both suits are normally then moved to Oslo in order to save time and expenses. A precondition for

requesting consolidation of court proceedings is normally that the plaintiff or the defendant is the same person or legal entity in both cases. Evidence and arguments in writing must be provided at the time a petition for a suit is filed, although further documentation may be filed up to the point at which oral proceedings take place. The opposing party has a right to consider the evidence before the oral proceedings. In the oral proceedings, witnesses may present evidence in support of either claim.

Pre-trial discovery is permitted, provided it can be carried out in a legal manner. A common procedure is to let the plaintiff and defendant agree on a neutral person or entity that will carry out the discovery operation. The alternative is to obtain a court order for discovery prior to the main oral proceedings.

Doctrine of equivalents applied

Courts generally refrain from judging the wording of claims in a restrictive manner. However, if a patent states that the claimed subject matter is technically equivalent to some other solution, and this other solution is proved to be prior art, then the validity of the patent may be in jeopardy. Furthermore, if the patentee during prosecution of a patent application indicates in writing to the Patent Office how the novelty and inventive step of the invention are to be understood, such statement cannot later be reversed in court, in particular if it limits the scope of the invention as claimed. Thus, if claims are narrowed during the prosecution in order to let a patent issue, the patentee cannot later claim a broader interpretation of the granted claims. The basis for claiming equivalence or alternatives is normally found in the patent specification, and if the patentee has not suggested alternatives or equivalents, the court may rely entirely on the specification and drawings when judging the scope of the claims. Consideration must be given to what the patentee in an objective sense intended to protect and arguments are made in that respect.

Some types of patent, for example those relating to biotech, may be harder to enforce in litigation because they often require expert witnesses and also expert lay judges, as the art is complex and difficult to understand. Enforcement in this context is primarily related to the substantial efforts of providing and explaining evidence, and how the prior art and the invention work, all in a manner that the court readily understands. As soon as a court ruling is made,

enforcement is straightforward. In certain cases, infringement of method patents may be difficult to prove, unless it is fairly evident that there is no other way to arrive at the end result. In such case, pre-trial discovery may be required.

Influence of foreign judgments

It seems that the Norwegian courts are not necessarily persuaded by decisions of courts in other countries. Foreign court decisions must be presented merely as facts along with other exhibits, and the court may choose to rely on such an exhibit to some extent or not at all. Further, the outcome of proceedings or even opposition proceedings at patent offices in other countries, and prior art relied upon thereat, in particular prior art not revealed in the Norwegian patent case, may have some bearing on how the court may look at the claims in a Norwegian patent, especially if the claims in such foreign patent are substantially different from, or in particular more restricted than, the claims in the Norwegian patent.

Reasoning given by foreign courts that have handed down decisions in similar cases may be considered by a Norwegian court if a copy of a foreign court ruling is an exhibit, but the court may simply choose not to rely upon it, in particular if witnesses or other statements made in the court proceedings indicate some doubt as to the quality of the reasoning. Also, if arguments other than those in the foreign case are presented in the Norwegian case, the foreign reasoning may be considered irrelevant.

From a tactical point of view, a defendant might seek to delay a case from going to trial, mostly through asking for extensions of the reply term due to, for example, illness of the defendant or his lawyer, presentation of further defence material, additional time to collect evidence or objection to the court selection of lay judges. The plaintiff may counter such tactics if it can be proved that infringement is still ongoing, the plaintiff is suffering substantial economic or market losses as a result thereof, or the additional evidence presented by the defendant does not support supplementary arguments.

Once both the plaintiff and the defendant have had the opportunity to present claims, evidence and counter-arguments, the court will set the date for oral proceedings.

Preliminary injunctions available

Preliminary injunctions are generally available at any district court and a suit for preliminary injunction must be filed with

sufficient evidence. Normally, both parties may have to provide an economic guarantee against damage if it is proved through a subsequent regular suit that the claim for a preliminary injunction was unjustified and has caused substantial damages to one party. A decision made by such preliminary injunction court may be appealed. Normally, however, a conventional infringement suit follows instead.

Approximately one to two years normally elapse between the filing of a suit at first instance (in a city court or district court) and the issue of a ruling. Unless public interests are potentially affected, it is hard to expedite a ruling. However, in district courts outside Oslo, if an invalidation suit does not accompany the infringement suit, the commencement of oral court proceedings may take less time, depending on the court's backlog. Within reasonable time after the suit is filed, a date for oral court proceedings is set. This effectively requires the defendant and the plaintiff to present arguments in writing as efficiently as possible and in good time before the oral court proceedings.

An adverse decision at first instance may be appealed to the High Court. Recent indications are that in order to do this, the alleged damages in question must be above a certain level (a figure of Euros 20,000 has been mentioned in this regard). The defeated party may claim that, for example: the decision at first instance is wrong for particular reasons; important issues have not been considered or have been considered incorrectly by the court; damages awarded are out of step with reality; the court has not fully understood the invention or the prior art cited by the defendant; evidence presented has not been relied upon; or the court processed the suit inappropriately. An appeal will add at least one and a half to two years to the case, depending on the caseload of the court at the time.

High costs

Unfortunately, processing a suit is expensive, even according to Norwegian standards, and seldom costs less than NOK 160,000 (approximately Euros 20,000); figures of NOK 300,000 to NOK 600,000 (Euros 39,000 to Euros 58,000), and even higher, are commonplace.

If a party loses the case entirely, it will normally have to bear the costs of the other party, including prosecution charges, court charges, witness expenses etc, in addition

to any damages awarded by the court.

Further, if the plaintiff is unsuccessful, it may also risk losing its patent rights through an invalidity suit ruling. However, there are cases where the patent is held valid, but the court nonetheless rules no infringement. In cases where the losing party must meet the costs of the winning party, the court is free to reduce the costs if these are considered disproportionate.

Available remedies

The court may prohibit the defendant from working the invention and/or specify a sum to be payable within a set term to cover damages and expenses. As a rule, the profits that the defendant has gained by violating the patent rights must be surrendered. Also, damages may be awarded in an amount to be specified at the discretion of the court and in addition to any claims by the plaintiff.

Many disputes are, however, resolved by the parties without a court ruling, and the judge has an obligation to urge the parties to compromise. If an attempt at compromise fails, a claim for compulsory licence may be made (this is rare in practice), provided the conditions of the Patents Act are met. Either the Oslo District Court or the Norwegian Competition Authority will consider issues relating to a claim for compulsory licence. Alternatively, the patentee may consider offering a licence or cross-licensing in cases where the defendant possesses patent(s) of interest. Another option is to consider a joint venture with the defendant. The attorney of record will normally advise on the available options, which depend on prevailing conditions, the status and reputation of the defendant, and the economic situation of the defendant.

In some cases the Act on Marketing Control (which replaced the old Unfair Competition Act) is applied in addition to, or instead of, a claim for patent infringement, and the Act provides for remedies related to unfair competition. Copyright (unregistered) may under some circumstances be applied. If the dispute relates to an article, a registered design may be useful (EU registered designs are not enforceable in Norway). Finally, the Patents Act provides for the administrative re-examination of an issued patent at the request of the patentee. If the patentee holds a Norwegian patent that is considered to have been infringed, and essential foreign corresponding patents are more restrictive in view of identical or other prior art, the

patentee may be well advised to request re-examination before considering filing suit, in order to avoid the patent being declared invalid in a suit. Although re-examination may lead to the patent having a narrower scope, it will still be easier to enforce.

Much to be gained

In summary, much is to be gained from obtaining a patent in Norway: the Patent Office's substantive examination is professional and all professional patent attorneys have a university degree from a technical university. Although translation of an application into Norwegian is mandatory, processing charges are normally low and allowance of a corresponding EPC application often triggers allowance of the Norwegian application.

Country Q&As

In this section of the publication, contributors from a number of member states of the European Patent Organisation answer the same set of questions based around the enforcement of European patents in their respective jurisdictions.

Enforcing patents in Austria

By **Alexander Cizek**, DLA Piper Weiss-Tessbach, Vienna

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

The European patent holder has several options when seeking to enforce its rights in Austria. It may initiate civil proceedings claiming (preliminary and permanent) injunctive relief, removal and destruction of infringing products, rendering of accounts, payment of compensation and damages, and publication of the verdict concerning the injunction.

In the case of wilful infringement, the patent owner may also instigate criminal proceedings against the infringer or unknown perpetrator and pursue the case as a so-called "private prosecutor". Where infringing products originate from countries outside the European Economic Area and are being imported into Austrian territory, the patent holder may additionally file for a product piracy order and respective border seizure measures through Austrian customs authorities.

Furthermore, the patent holder may file a request with the Austrian Patent Office for a declaratory decision establishing the fact of whether a specific object or process falls within the scope of its patent. Such request needs to be filed prior to an infringement action concerning the same subject matter. The decision of the Patent Office is binding upon the courts.

2. Does your jurisdiction have specialist patent courts?

No. However, as a matter of statutory patent law, the Commercial Court of Vienna (*Handelsgericht Wien*) has exclusive jurisdiction over all civil patent matters. Within this Court, only three departments hear and adjudicate patent infringement

cases. Consequently, the judges staffing these departments are well versed in patent law issues. They sit in panels of three, consisting of two judges and one lay-judge who is usually a patent agent. The competent court for criminal patent matters is the Criminal Court of Vienna (*Landesgericht für Strafsachen Wien*).

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

A witness is regarded as a means of evidence for either party; thus, as a matter of equal fighting chances, either party may interrogate the witness and the law does not formally distinguish between examination and cross-examination. It is usually the judge who examines the witness first, followed by the party representatives who are allowed to ask supplemental questions.

Admissible evidence in civil court proceedings includes witness testimony, expert opinions and expert witness testimony, party testimony, documents, inspection of objects or on-site inspections. Written statements of witnesses are admissible in preliminary proceedings but not in full-scale proceedings. By law, all forms of evidence are given equal weight and are subject to the judge's free evaluation. However, in practice, written documents tend to be the most important form of evidence.

There are no particular restrictions on the use of evidence from experts. The court may appoint an expert to submit a written report on technical aspects of the claim and to answer, in an oral hearing, questions put forward by the judge and the parties. In addition, the parties tend to retain their own experts and file party expert opinions with the court in order to support their case.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is

necessary to demonstrate one or the other?

Infringement and invalidity are not usually dealt with simultaneously. Infringement issues lie within the exclusive jurisdiction of the judiciary whereas issues of invalidity are decided separately by the Patent Office. Where the validity of a patent is contested in infringement proceedings, the court may have to suspend its proceedings until the Patent Office has ruled on the validity issue. This does not apply in preliminary proceedings, however.

No particular level of proof is required in either proceeding. Pursuant to the Austrian Code of Civil Procedure, the court and the Patent Office respectively are required to consider the results of the hearings and evidence proceeding carefully in their deliberations. However, they are free in their decision as to which party has successfully established its case and thus is to prevail under the law.

5. To what extent is pre-trial discovery permitted?

Principally, the taking of evidence is considered the sole prerogative of the state. Therefore, pre-trial discovery is not permitted in Austria. However, on the criminal route the patent holder assumes the position of the (private) prosecutor and thus may file all available criminal pre-trial discovery motions with the investigating judge.

6. To what extent does any doctrine of equivalents apply in an infringement action?

Besides literal infringement, Austrian courts have also recognised infringement under the doctrine of equivalents. As a matter of Austrian case law, infringement under the doctrine of equivalents occurs when, on the priority date of the patent in question, a person skilled in the art, equipped with general technical expertise and knowledge of the state of the art laid down in the patent specification, without an inventive endeavour would infer the modified features as a solution equivalent to those defined in the patent claims. By contrast, the usage of features having the same effect but essentially altering the protected solution idea or contradicting the fundamental idea of the invention would not be considered equivalent under the doctrine.

7. Are there certain types of patent rights that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

There are no patent rights that are more difficult to enforce by virtue of the law;

however, as a matter of fact, the Commercial Court of Vienna does not often get the chance to adjudicate rare patents such as biotech patents.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

As the Commercial Court of Vienna has exclusive jurisdiction in patent infringement issues and consequently no other national court deals with patent infringement cases, there are no other decisions that the Commercial Court of Vienna could consider. However, declaratory decisions by the Patent Office as to whether a specific object or process falls within the scope of a patent, or decisions on the nullity of a patent, are binding upon the court.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Austrian courts are not bound by law to take the reasoning given by foreign courts in similar cases into consideration. However, the panel hearing the case might consider the reasoning given on a discretionary basis.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

The defendant can delay a case by counterclaiming that the plaintiff's patent is partially or completely invalid and thus subject to nullity; issues of invalidity are decided separately by the Austrian Patent Office. Hence, the court has to examine whether the objection is founded and suspend the civil proceedings if it concludes that the invalidity of the patent is likely. The defendant then must file a motion for nullity of the patent with the Patent Office within one month and the court will resume and continue the infringement proceedings only upon issuance of the Patent Office's decision. The plaintiff can only counter this delaying tactic by convincing the court of the validity of its patent and thus preventing the suspension of the infringement proceedings.

The defendant may also file for a negative declaratory decision seeking the Patent Office's finding that its product or process does not infringe the plaintiff's patent. Although not strictly required by statutory law, the first instance court sometimes stays the infringement proceedings as contradicting decisions may give rise to a re-opening of the

proceedings. Again, the plaintiff can only counter this delaying tactic by convincing the court otherwise.

11. How available are preliminary injunctions and how do you get them?

Infringement of patent rights generally entitles a plaintiff to preliminary injunctive relief irrespective of any urgency requirement even prior to the commencement of full-scale proceedings. To this end, the patent holder must present a clear and well-founded case but need not prove danger of recurrence, which is regularly presumed through the present infringement, or irrecoverable loss. Having applied for preliminary injunctive relief prior to filing legal action, the patent holder must commence full-scale proceedings within a certain period of time to be determined by the court.

12. How long does it take to get a decision at first instance? Is it possible to expedite these proceedings?

For a patent infringement action of medium complexity, the average length of a first instance trial is one to two years, provided the proceedings have not been suspended due to an objection of invalidity of the patent. Preceding preliminary proceedings being subject to interlocutory appeal may also delay the full-scale decision. Besides preliminary injunction proceedings, there are no expedited proceedings available in Austrian courts.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The party defeated in the first instance of the full-scale proceedings may file an appeal against the judgment within a period of four weeks based upon one or more of the following grounds: nullity; violation of procedural law; false or incomplete ascertainment of facts; and/or false assessment or misinterpretation of the law. In appeal proceedings, no new facts may be contended and no motions for taking new evidence may be brought forward. The opponent may file a reply to the appeal. Oral hearings can be directed by the court of appeals but are usually rare. In most cases, the court of appeals will decide based upon the written appellate briefs of the parties. The appeal process in patent infringement cases usually takes between six months and one year.

In relation to the first instance preliminary proceedings, the defeated party

may file an appeal within two weeks. The same grounds and formal requirements apply. The appeal process in the preliminary proceedings usually takes between two and four months.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

A court fee is payable upon filing the legal action, the amount depending upon the value of the claim. In patent infringement cases, the fee usually starts at Euros 1,082 and goes up to 1.2% of the value of the claim plus Euros 1,509. Moreover, as a matter of statutory civil procedural rules, the defeated party must reimburse the legal costs of the prevailing party, amounting to 100% in the event of a total defeat and a respective portion thereof in case of partial defeat. Legal costs comprise court fees, attorneys' fees (calculated upon the statutory fee schedule) and possible costs of witnesses, expert witnesses and expert opinions.

15. Who can represent parties in court? Is specialist representation required?

In patent infringement proceedings, an attorney at law must represent the parties. Specialist representation is not required but highly recommended. A patent agent usually assists the attorney at law with regard to technical patent aspects of the litigation.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

The remedies in civil proceedings include (preliminary and permanent) injunctive relief, removal and destruction of infringing items, rendering of accounts, payment of compensation and damages, and publication of the verdict over the injunction. Damages will be awarded if the plaintiff can prove actual loss suffered which was caused by the defendant, and that the defendant acted wilfully or negligently.

The plaintiff may be strictly liable for all damages suffered by the defendant if a preliminary injunction is lifted in subsequent full-scale proceedings for reasons which rendered the preliminary injunction unjustified from the very beginning.

The Austrian legal system does not provide for punitive damages; however, in the case of gross negligence or wilfulness on the part of the infringer, the plaintiff is entitled to double damages, comprising twice the amount of adequate compensation,

without having to prove the amount of the actually incurred loss.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

No. In Austria, the usual alternative dispute resolution schemes such as arbitration and mediation exist, but they are hardly ever used to settle patent disputes. The usual course of action is to send a demand letter for cease and desist to the infringer before bringing legal action. If no out-of-court settlement can be reached, court proceedings are immediately initiated.

18. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

There is no specific cause of action for groundless threats of patent infringement proceedings under Austrian law; however, a respective liability may be considered under general tort rules. Moreover, the civil remedies of the patent holder are subject to a statute of limitation of three years, starting to run from the point at which the patentee first learns of the infringement and the identity of the particular infringer. Also, the Austrian civil procedural laws do not provide for representative legal actions (*Prozessstandschaft*); only the rights holder, ie, the patent owner or the exclusive licensee, may legally pursue a patent infringement in court.

Enforcing patents in Belgium

By **Christophe Ronse** and **Paul Maeyaert**, ALTIUS Law Firm, Brussels

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

There are basically three possible courses of action which are open to a patentee seeking to enforce its rights in Belgium.

The most obvious option is to start proceedings on the merits in order to obtain an injunction and the grant of damages, and any other form of relief available under the Belgian Patent Act of 28th March 1984.

However, proceedings on the merits are often preceded by a so-called descriptive attachment proceeding (*saisie description*), which is a specific *ex parte* procedure aimed at establishing the existence and/or the extent of the infringement, and possibly securing the seizure of any infringing materials.

In urgent matters, the patentee can initiate summary proceedings aimed at the immediate cessation of the patent infringement.

Patent proceedings can be preceded by the sending of a notice letter to the alleged infringer, although this is not required and also is not advisable if *ex parte* proceedings are envisaged.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

Belgium does not (yet) have specialist patent courts. Judges as a rule also have no technical background, although they can seek the assistance of court-appointed judicial experts.

The Belgian Patent Act of 28th March 1984 provides that only the courts of first instance of Brussels, Antwerp, Ghent, Liège and Mons have jurisdiction in patent

matters, which arise under their respective territorial jurisdiction. However, it appears from the latest legislative proposals tabled within the framework of the transposition of the IP Enforcement Directive 2004/48/EC that the Brussels Court of Commerce will be designated as solely competent to deal with patent litigation.

At present, most patent cases are litigated in Brussels and Antwerp.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Belgian civil proceedings are mainly based on written evidence which must be exchanged between the parties together with their written submissions.

Any witness examination must be requested and authorised by the court. We have knowledge of only one recent patent case where a witness examination was ordered. In any case, proof by witnesses can be authorised only in view of proving certain facts or highlighting certain factual or technical issues.

Furthermore, Belgian judicial law does not provide for the possibility of cross-examining witnesses at trial. Questions are directed only by the court (possibly at the request of either party).

On the other hand, parties in patent litigation usually submit written affidavits or declarations from patent attorneys in order to strengthen their case. There are no limitations on the use of such written documents.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

When an infringement action is brought against an alleged infringer, the latter has the right to invoke the possible invalidity of the patent at stake and to file a counterclaim based on one of the grounds of

nullification provided for by the Patent Act. In such cases, both infringement and invalidity will be dealt with simultaneously.

Where the alleged infringer brings separate invalidity proceedings, it can be expected that such proceedings will also be joined to the main infringement proceedings on the basis that they could otherwise lead to contradictory decisions.

In such proceedings both parties are allowed to use all available means of evidence, provided it is in written form or can otherwise be filed with the court. As will be further described below, the descriptive attachment proceedings allow for a very efficient means for the patentee to establish the proof of an infringement.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Belgian judicial law does not recognise any discovery proceedings within the usual meaning of the term. But Article 877 of the Belgian Judicial Code allows a judge to order a party to the suit or a third party to submit a document (or a copy thereof) which contains the evidence of a relevant fact when there are important specific and concurring presumptions that such party possesses this document.

Where insufficient evidence of the existence and/or scope of the infringement is available, a patentee can, before starting any contradictory proceedings, establish the infringement by requesting on an *ex parte* basis the granting of a descriptive attachment (*saisie description*) from the judge. In order to obtain this, the existence of a *prima facie* valid patent must be established (the production of a copy of the patent is normally sufficient) and *prima facie* evidence of infringement must be provided. The request is aimed at the appointment of an expert who is empowered to enter the premises of the alleged infringer or any location where relevant evidence can be found. The judge may also authorise the patentee to be represented during the description operations by its lawyers or other representatives.

The patentee may further request the judge to provide for any adequate accompanying measures, such as allowing the expert to enter the premises as many times as necessary for the carrying out of his task, to obtain access to computers, files, etc. The expert will be required to describe the allegedly infringing processes or products or any materials involved therein,

but may not judge the alleged infringement as such.

In addition to descriptive measures, the judge can also order the person against whom the descriptive measure is sought not to dispose of the infringing goods upon forfeiture of a financial penalty. The judge can further appoint a custodian to seize the infringing goods or revenues derived from infringing activities. Obtaining such measures, however, usually requires the patentee to demonstrate that the requested relief is reasonably justified under the circumstances, having regard to the various interests at stake.

In many cases, the judge will also request that a guarantee be posted before the *saisie description* can be carried out.

Upon granting of the authorisation, the expert will visit the alleged infringer's premises together with a bailiff who will serve the judge's decision. Once he has gathered the required evidence, the expert will draft a sworn report containing a detailed and objective description of the alleged infringements, and will subsequently file this report with the court of first instance and send a copy to the parties. The patentee must initiate proceedings before the competent court of first instance within 30 days of the date of this filing. If this does not happen the report becomes devoid of any legal value.

6. To what extent does any doctrine of equivalents apply in an infringement action?

In the absence of a literal infringement of the patent, it is possible for the patentee to invoke the doctrine of equivalents.

Although there is only very limited case law available, it appears that the function-plus-result approach will probably be applied, ie, that a certain means will be considered to be equivalent to the infringement if it realises the same technical function in the same way and with a similar result.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

One should take into account that technically complex patents such as pharmaceutical patents will as a rule be more difficult to enforce than those patents which can be understood by a layman. A particular effort should therefore be made to translate any technical issues into plain language. In complex matters, the Belgian courts will try to compensate for their lack of technical

expertise by appointing a judicial expert.

In addition, biotechnological patents could give rise to further difficulties in view of the limitations imposed by the Belgian Patent Act. Although the Patent Act has been amended in order to transpose the provisions of the European Biotechnology Directive 98/44/EC, the legislator has added some further limitations including, in particular, a newly worded research exemption which will be discussed below.

For software-related inventions, there is no case law available from which to draw any relevant conclusion as to their enforcement in Belgium.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

Belgian courts are not bound in any way whatsoever by the opinions and decisions of any other (Belgian or foreign) courts that have dealt with similar cases, even if they concern parallel national patents to the patent at stake.

That said, Belgian judges will usually take into account the decisions reached in parallel cases by the more specialised courts of other European countries such as Germany and the Netherlands or, in exceptional circumstances, even the US courts.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Belgian judges are willing to consider the reasoning given by foreign courts, particularly in parallel patent cases; although they will not necessarily agree with the reasoning.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

The possibilities of delaying a case which are open to a defendant will vary depending upon the particular circumstances of each case and the strategy and tactics adopted by the defendant.

Classical means of defence include the contestation of the available evidence of infringement (including starting opposition proceedings against the *saisie description* which the patentee may have obtained, in order to delay the infringement proceedings) or the filing of a counterclaim for the nullification of the patent.

Many defendants also try to exploit the possibilities available under Belgian judicial

law to create obstacles and/or postpone the case. This includes, in particular, the failure to file submissions or to agree on a timetable for the filing of submissions. The plaintiff can, however, counter this by requesting the court to determine a procedural calendar.

11. How available are preliminary injunctions and how do you get them?

It is possible to request the president of the court of first instance to impose a preliminary injunction on a patent infringer within the framework of summary proceedings, pending the outcome of the proceedings on the merits.

In order to succeed, the patentee must meet two conditions:

- It must demonstrate the so-called appearance of rights, ie, that the acts for which a preliminary injunction is sought *prima facie* infringe on its patent. Within this context, the president will, as a rule, assume that the European patent invoked is valid (*foi est due au titre*), having already been the object of an examination by the European Patent Office, unless the defendant can demonstrate that this patent is *prima facie* invalid and should therefore be disregarded.
- The patentee must also demonstrate that its claim is urgent, ie, that it will suffer serious harm or prejudice in the absence of a preliminary injunction and that the proceedings on the merits will not allow it to obtain the necessary relief in a timely fashion. Accordingly, if the urgency has been caused by the patentee's negligence or inaction, its claim will be rejected for lack of urgency.

A decision on whether or not to grant a preliminary injunction will usually be handed down within a couple of weeks or months at the most. It is possible to request preliminary measures on an *ex parte* basis, but only in cases of absolute necessity, ie, if an immediate decision is required in order to safeguard the plaintiff's interests.

Summary proceedings sometimes give rise to the balancing of the parties' interests, particularly if the case is not clear-cut.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

The length of proceedings on the merits depends mainly on the court in question, the complexity of the case and the diligence of the parties.

While there are certain exceptions (such as the proceedings before the French-language Court of First Instance of Brussels, which suffers backlogs of up to three years or more), one can say that it is possible to obtain a judgment in a standard patent case within one or two years. Where the court decides on the appointment of a judicial expert, further delays must be anticipated, as the expert will have to hear the parties, investigate the issues and draft a report which will then be debated before the court.

Considering that the furtherance of the proceedings mainly depends on the parties themselves – the court being mainly reactive to their initiatives – the plaintiff can expedite the case to some extent by acting proactively and diligently in setting deadlines for the exchange of submissions and exhibits, and fixing a hearing date.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The defeated party can appeal any (even interlocutory) judgment before the territorially competent court of appeal (at Brussels, Antwerp, Ghent, Mons or Liège). Where this happens, the whole case is devolved to the court of appeal, which will review it and decide on the claims (raised in appeal or possibly also in counter-appeal).

Proceedings before the court of appeal usually take longer than those at first instance and one should count on a timeframe of about two to three years before a decision is taken on the merits (or sometimes less, depending upon the court involved). Appeals against decisions by the president of the court of first instance in summary proceedings take much less time and are normally dealt with in one year or less, depending upon the circumstances.

The judgment of the court of appeal can be appealed to the Supreme Court (*Court de Cassation*). However, the Supreme Court will not review the facts, but only the legal issues. Such procedures can take two years or more.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

It is very difficult to give an assessment of the cost of patent litigation in Belgium, as the cost of litigation (and patent litigation in particular) will vary to a great extent depending upon the type of the proceedings and the complexity of the case, in addition to some other elements such as the rates applied by the legal counsel

involved, whether or not the court appoints a judicial expert, etc. Any estimate will therefore have to be considered as very approximate, as one usually knows where this kind of undertaking starts but cannot predict how and where it will end.

Based on prior experience, we would say that a case on the merits involving a not too complex patent dispute will cost between Euros 50,000 and Euros 100,000, up to the point where a first instance judgment is rendered (this amount would cover the drafting of summons and arguments, as well as the appearances in court, the preparation of the case, correspondence and follow-up, etc). One should also take into account that the assistance of a specialised patent attorney is required in most cases to help prepare the briefs. The cost of the proceedings can further increase if the court renders only an interlocutory judgment, eg, if a judicial expert is appointed and the proceedings are lengthened as a result.

In addition, one needs to take into account the possibility that certain submissions and exhibits will have to be translated (for the benefit of the client or sometimes at the request of the judge).

Finally, note that (some of the) legal costs could possibly be recovered from the defendant if one can convince the court that such costs are part of the damage incurred by the plaintiff as a result of the patent infringement.

15. Who can represent parties in court? Is specialist representation required?

Litigating parties must be represented by one or more attorneys at law. It is possible for a party to represent itself, but this is almost never done in patent cases and could prove dangerous in view of the complexities of Belgian judicial and substantive laws.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Article 27 of the Belgian Patent Act allows the patentee to prevent any unauthorised third party from: (1) producing, offering, marketing, using or importing or storing with a view to the aforementioned the patented subject matter; (2) in the case of a patented process, applying or offering this process for use in Belgium; and (3) producing, offering, marketing, using or importing or storing with a view to the aforementioned any material directly resulting from a patented process.

In addition, the Patent Act also sanctions

indirect patent infringements, ie, where the defendant knowingly or negligently offers or supplies means relating to an essential feature of the patented invention.

Any such injunction is normally imposed under forfeiture of substantial fines in case of continued infringement and can possibly be combined with publicity measures at the cost of the infringing party.

In addition, the patentee (and any registered licensee) is entitled to seek damages (to be increased with interest at the legal rate of 7%) in order to compensate for the prejudice resulting from the infringement. The same principles apply here as in tort cases, the aggrieved party being entitled to the full reparation of its prejudice caused by the infringement. One should, however, take into account that the Belgian courts have a rather conservative approach in the assessment of damages, eg, taking as a basis the level of royalties usually claimed by the patentee.

Within this context, it is out of the question that punitive damages can be granted, although the amount and level of damages granted seems to be growing.

Finally, if the bad faith of the defendant is established, the court can order the confiscation of the infringing products and the means specifically intended for their manufacture.

It is noteworthy that the experimental use exception has been fundamentally modified following the review of the Belgian Patent Act with regard to the transposition of the Biotechnology Directive. Whereas under the old law, the rights conferred by a patent did not extend to experiments relating to the subject matter of the patented invention, this exception now applies to acts which are performed on and/or with the subject matter of the patented invention, for scientific purposes.

The Belgian legislator has thus completely abandoned the distinction between experiments on the patented subject matter and experiments with the patented subject matter, and provides for the exemption of both types of experiment. As a result, it has become much more difficult to enforce patent rights relating to so-called research tools.

Furthermore, one should take into account that the Belgian Patent Act and the relevant procedural rules will be further amended at the occasion of the transposition of the IP Enforcement Directive. The main anticipated new features are the centralisation of patent cases at the level of the Brussels Court of Commerce and the possibility of obtaining final injunctions on the merits on an expedited basis.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Alternatives to litigation are either arbitration or mediation, but these require the agreement and cooperation of the infringing party and might therefore not always be of relevance.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

Belgium has not yet signed or ratified the London Protocol and has not yet expressed its support for the European Patent Litigation Agreement. Although one can expect that such will eventually happen, it is impossible to make any prediction on the timing thereof. Also, it remains to be seen whether the dispensation of translations provided by the London Protocol will cause any problems at the political level.

19. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

Enforcing patents in the Czech Republic

By **Lukas Lorenc**, Cermák Horejs Myslík a spol, Prague

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

According to Article 35c of Czech Act No 527/1991 Coll on Inventions and Rationalisation Proposals (hereinafter referred to as the Patent Act), a European patent has the same effects as a patent granted by the Czech Patent Office in accordance with the Patent Act. The owner of a European patent therefore has the exclusive right to use the invention, to authorise others to use the invention or to assign the patent to others. According to Article 4 of the new Act 221/2006 Coll on Enforcement of Intellectual Property Rights, in case of infringement of patent rights, the owner of the patent has the right to apply to the court for an order prohibiting the infringement or the impending infringement, and to ask for the consequences of the infringement to be remedied; the owner of the patent may also claim appropriate satisfaction, including monetary recompense. The right to claim the surrender of unjustified enrichment and to claim damages shall not be affected. It is also possible to apply to the court to issue a preliminary injunction against an infringer ordering immediate cessation of the infringement, an option which is a fast and effective measure.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

There are no special patent courts in the Czech Republic. However, according to Article 6 of the Act on Enforcement of IP Rights, the City Court

in Prague shall decide all IP infringement cases – including cases involving patent infringement. As the new regulation on the enforcement of all IP rights became effective only in May 2006, the City Court judges do not yet have high levels of expertise.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Litigation is based on written evidence supported by witness statements. Witnesses may be cross-examined by the other party at trial. There are no restrictions on the use of evidence from experts. IP infringement proceedings are so-called concentrated proceedings, which means that all evidence has to be submitted or at least proposed within the first hearing. The judge has to consider all evidence (including witness statements) proposed by each party in the litigation and give reasons for its rejection.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Courts deal with any infringement of patent rights and its consequences. On the other hand, only the Patent Office decides on revocation (invalidity) of a patent. It is very usual that in case of infringement of patent rights the defendant files a request for revocation of the patent; the court may then suspend infringement proceedings until the Patent Office decides on the revocation request.

To succeed in infringement proceedings the patent owner should submit at least one direct piece of evidence proving the fact that the defendant's activity infringes the patent – for example, any expert opinion comparing the defendant's product with the product protected by the patent.

In invalidation proceedings before the Patent Office, the plaintiff has to prove that:

(a) the invention does not meet the conditions of patentability (novelty, inventive step, industrial application); (b) the invention is not disclosed in the patent so clearly and completely that it can be worked by a person skilled in the art; and (c) the subject matter of the patent extends beyond the content of the invention application as filed, or the subject matter of the patent granted on the divisional application extends beyond the content of the invention application as filed, or that the extent of the protection arising from the patent has been extended. The evidence in invalidity proceedings therefore consists of quoting a number of registered patents, books, dictionaries and prior art in general.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

There is no pre-trial discovery under Czech law. Evidence or documents are discovered before the judge during the hearing.

6. To what extent does any doctrine of equivalents apply in an infringement action?

Czech courts hesitate to apply a doctrine of equivalents in an infringement action based on patent rights. The doctrine of equivalents is applied in infringement actions based on unfair competition provisions of the Czech Commercial Code. The argument based on patent rights is therefore often combined with argument based on unfair competition provisions.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Software-related, biotech and pharmaceutical patents are usually more difficult to enforce than technical patents, because it is more difficult to prove infringement by comparing the solution used by the defendant and the solution protected by the patent. This applies also to patented methods of manufacturing.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

The courts are bound primarily by the wording of the law. After the accession of the Czech Republic to the EU, European law is part of Czech law and must be applied by Czech courts. In general, decisions or opinions of other courts are not binding on the Czech courts, except preliminary rulings

of the ECJ in particular cases and rulings of the Constitutional Court. However, decisions and opinions of other courts (and especially higher courts, ie, high courts and the Supreme Court) in similar cases are very often taken into account when the court has to decide an identical or similar matter. This practice helps courts to establish consistent interpretation and application of the law.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Czech courts generally do not like to consider decisions or reasoning given by foreign courts, except certain rulings of the ECJ (see above). If, however, the foreign legislation is identical or similar to the Czech law and the reasoning of a foreign court is persuasive, it can influence the approach of a Czech court.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

In patent infringement actions, the defendant may file a revocation request with the Patent Office, which may substantially protract the case. If the court decides to suspend the case until the Patent Office rules on the revocation request, the plaintiff's position is difficult. The defendant may also request the court to ask the ECJ for a preliminary ruling in cases where a provision of EU law is applicable. The plaintiff is authorised to object to this request. Long-lasting litigations and trials are a major problem for Czech courts. Preliminary injunctions may be a good solution for the plaintiff until the final decision is issued.

11. How available are preliminary injunctions and how do you get them?

Preliminary injunctions are fast and effective protective measures. The court has to decide on the request for preliminary injunction within seven days of the date of filing. According to the amended Article 75b of the Czech Civil Procedure Code, the plaintiff has to deposit a security in the amount of CZK 50,000 – and in commercial matters (ie, also in cases of patent infringement and unfair competition actions) CZK 100,000 (approximately Euros 3,000) – at the latest on the same day on which it files the request for the issuance of a preliminary injunction with the court. This security serves the purpose of securing compensation for damage or other harm that could be caused by the preliminary injunction if the final decision goes against the plaintiff.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

It takes approximately one to one and a half years to get a decision at first instance. There is scant possibility of expediting the process.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The defeated party in patent infringement proceedings may appeal the first instance decision to the High Court within 15 days of the date of the delivery of the first instance decision. There are two high courts in the Czech Republic: in Prague and in Olomouc. The defeated party may appeal the whole decision or only a part of it. It is not possible to appeal only the reasoning behind the decision. An appeal may be based only on certain circumstances stated in Article 205 (2) of the Civil Procedure Code, for example: the conditions of the proceedings were not met; the decision was issued by a first instance court that was not materially competent; the decision of the first instance court was issued by an excluded judge (assessor) or the first instance court was composed incorrectly; the first instance court did not take account of the facts asserted by the appellant or of the evidence identified by it; or, although the requirements for appeal stated by the Civil Procedure Code were not met, the procedure was affected by another defect that could have caused an incorrect decision on the merits of the case. Appellate proceedings are regulated by Articles 201 to 226 of the Civil Procedure Code.

The appeal process takes one and a half to two years.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

The costs of first instance proceedings depend on the complexity of the matter. It usually takes at least 20 hours of a lawyer's time to take a case through to a first instance decision. The level of cost increases where an expert opinion is drafted and submitted to the court. Court fees may be considerably high, especially if extensive damages are requested.

15. Who can represent parties in court?

According to Article 24 of the Civil Procedure Code, any party may choose a representative to represent it in the proceedings. There is no compulsory representation required

before the first and second instance courts generally. The patent owner may defend its rights personally. Parties may be represented by any individual, by an attorney at law, by a notary public and, except in appeals, also by a patent attorney. Representation by an IP litigation specialist is recommended, however.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

For remedies in case of patent infringement please see the answer to question 1. The remedy called appropriate satisfaction can be considered as equivalent to punitive damages. It is intended to indemnify the aggrieved party for any harm which cannot be calculated by direct damages.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

At the moment there is no alternative to litigation in case of patent infringement. If the parties do not conclude an out-of-court settlement or settlement before the court, only litigation can secure the enforcement of rights.

Enforcing patents in Denmark

By **Pernille Thorsboe**, Zacco A/S, Copenhagen

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

Denmark ratified the European Patent Convention as late as 1st January 1990. Since that date most patent protection in Denmark has been established by way of a European patent designating Denmark. A European patent application that designates Denmark has the same effect in Denmark as a national application filed at the Danish Patent Office from its date of filing. Thus, when a patent is granted it confers the same right on the patent holder as a national patent.

In order to secure provisional protection before grant, the patent applicant must file a translation of the patent claims into Danish. Once a translation has been filed, an applicant has the right to reasonable compensation in cases of infringement from the date when the translated claims are made available to the public. Obviously, filing a translation also serves as a warning to potential infringers.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

A patent holder seeking to enforce its rights in Denmark can file an infringement suit with one of the two Danish high courts, where the case will be tried before three legally qualified judges. Due to the small number of litigation cases in Denmark, we have no specialist patent courts. In order to compensate for the lack of technical expertise in the high courts, the courts nominate neutral expert witnesses, who normally include an experienced patent

attorney and one or more technical experts in the relevant field, preferably university professors.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

The parties put a series of questions in writing to the experts, who may also be asked to conduct or supervise experiments relevant to the case. The experts then present written testimony containing their answers to the questions.

During the final court hearing, the expert witnesses are cross-examined. The experts may not express any opinion of legal character, ie, they may not state whether the patent is infringed or not. The judges then reach a decision, based on the written testimony and the cross-examination of the expert witnesses.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

The validity of the patent-in-suit is not automatically an issue – at least not an issue raised by the court. But the defendant party may, and often does, file a counterclaim for invalidity at the same high court. The counterclaim should be supported by new prior art and/or arguments challenging novelty and inventive step. If an invalidity suit is filed, the proceedings are consolidated, unless the parties agree to a bifurcation. The validity suit proceeds much like the infringement suit, ie, it includes written testimony from expert witnesses and cross-examination, followed by a court decision taken by the judges.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

No formal pre-trial discovery is permitted in Denmark. The parties are able to request

voluntary information from each other, such as samples of an alleged infringing product for further investigation, but they have no obligation to meet any requirements in this respect. Instead, a company that wants to sue an infringer will normally investigate publicly available information, such as the file history of the patent-in-suit and patent databases. A company may also consult experts in the technical field, such as university professors. Where technical experts are consulted prior to a trial, it is important for the company to keep clear some selected experts to act as court – appointed witnesses in the later trial.

6. To what extent does any doctrine of equivalents apply in an infringement action?

The extent of protection conferred by a European patent is determined by the terms of the claims (Article 69 EPC). The Protocol on the Interpretation of Article 69 is an integral part of the Convention, but attempts to harmonise the interpretation of equivalents in the contracting states have been unsuccessful. However, the doctrine of equivalents cited in the Protocol's last sentence is much in harmony with the situation according to Danish case law.

Thus, the protection conferred by the claims in a European patent enforced in Denmark extends beyond the literal wording of the claim to cover, to some extent, products, processes, etc. that are equivalent in structure, technical function, use, etc. The decision is taken on a case-by-case basis on a balanced overall judgment, taking into account all essential steps in a process (if the patent relates to a process) or all essential elements (if the patent relates to a product). The protection must combine fair protection for the patent holder and a reasonable degree of certainty for third parties.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Only a few cases relating to the enforcement of patents within new technical fields, such as biotech or software, have reached the courts, and these have not yet given rise to any diverging trend that would suggest that such patents may be more difficult to enforce.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

During the final hearing of a case in high

court the parties plead their case primarily based on legislation and decisions of Danish courts. However, if the case concerns a European patent, then relevant decisions from European case law will be cited and the evaluation from the European Patent Office of the validity of a patent will be referred to. The decisions and opinions of foreign courts in similar cases would, however, normally have little effect on the final decision in a Danish court.

9. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

It takes two to three years from the start of the proceedings in an infringement case before a decision can be expected from the high court. The parties may request an extension of the time limits set by the court during the preparatory work, and these extensions are widely granted by the court. The plaintiff may object if the defendant abuses this privilege and deliberately delays the case unduly.

10. How available are preliminary injunctions and how do you get them?

It is possible, and in most cases recommended, to seek a preliminary injunction in the city court. The formal request for injunction is filed at the city court where the alleged infringer is resident. The case is tried before one judge, who is unlikely to be familiar with patent cases.

In injunction proceedings, testimonies are allowed from experts consulted by only one of the parties, and both parties will normally support their case with expert testimonies. The final hearing is often very comprehensive, since the parties have a legitimate interest in presenting as many technical details as possible; this is normally allowed by the city court. In an injunction case, a challenge from the defendant on the validity of the patent will, according to present practice, be taken into consideration only if new prior art anticipating the novelty of the invention is presented to the court.

A decision of the city court to grant a preliminary injunction must be confirmed afterwards in a confirmatory action in the high court.

11. How long does it take to get a decision at first instance? Is it possible to expedite this process?

In an injunction case in a city court one can expect a decision within one to six months. The timeframe depends on the

circumstances and the desire of the parties to speed up or delay the case.

In an infringement case in high court a decision may be taken within six to 24 months, depending on the circumstances and the parties' willingness to speed up preparation of the case by, for example, getting a statement from the court-nominated patent expert and technical expert witnesses.

12. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

A decision of the city court to grant or reject a preliminary injunction may be appealed to the high court. In an appeal relating to a preliminary injunction, testimonies from one-sided experts are also allowed. The timeframe for an appeal case, following a preliminary injunction case, depends on the circumstances and the desire of the parties to speed up or delay the case, but it is possible to have an appeal decision within another three to nine months.

An infringement decision from the high court may be appealed to the Supreme Court, from which it may take several years to get a decision.

13. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

The official fee for an injunction case is modest, whereas a larger fee depending on the value of the case must be paid for an infringement case before the high court. In principle, the losing party must pay the winner's legal expenses, but the amount to be paid is set by court by way of an estimate, and this estimate seldom reflects the winner's actual costs. The losing party normally pays the expenses of the expert witnesses.

It should be added that since pre-trial discovery is not possible in Denmark, the costs are smaller than in countries where pre-trial discovery is allowed. However, there are, of course, costs for the preparatory work of a suit, involving both a patent attorney and an attorney at law, and possible expert witnesses. Naturally, the cost varies depending on the technical field, but generally pharmaceutical cases are the most expensive to prepare.

14. Who can represent parties in court? Is specialist representation required?

Only attorneys-at-law can represent the parties in a Danish court. A specialist

representative is not formally required by the court, but the patent attorney plays an important role as adviser and assessor to the attorney at law and the client in technical matters both during the pre-trial preparation of the suit and during the final hearing.

The patent attorney is responsible for drafting the written questions which are the basis for the testimonies presented by the court-nominated experts, and the patent attorney also contributes during the drafting of the pleading documents. Written declarations and testimonies are also often given by a patent attorney, who may be nominated by the court as an expert witness.

15. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

The Danish Patents Act was amended on 1st January 2006 in accordance with Directive 2004/48/EC from the European Union, which enumerates a number of minimum requirements. According to the amended Act, any person who intentionally or negligently infringes an exclusive patent right must pay remuneration for the use and compensation for any damages caused by the infringement. In aggravating circumstances, in particular if the infringement is with intent to gain a significant and obviously unlawful profit, the penalty may increase to imprisonment.

In practice, this means that the patent holder has the right to reasonable compensation for the use of the patented invention, which would frequently be based on a normal licence fee within the relevant field, as well as damages for the unauthorised use. The compensation is based on an estimate made by the court and in this connection it should be noted that compensation is generally very modest in Denmark.

16. Are there any realistic alternatives to litigation in cases relating to patent disputes?

A European patent holder seeking to enforce its patent in Denmark can, in principle, opt for mediation as an alternative to litigation. The chance of solving a conflict through mediation before litigation must be evaluated on a case-by-case basis, taking the subject matter of the patent and the purpose of the litigation into account.

17. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement?

Denmark signed the London Agreement on

the application of Article 65 EPC on 17th October 2000. On 4th June 2003, the Danish Parliament amended the Danish Patents Act in order to implement the London Agreement so that it will be compulsory to translate the claims into Danish, while the description must be available in English. The date of deposit of the instrument of ratification and thus of entry into force of the amendment to the Patents Act will be decided by the competent minister.

dependent on a patent which belongs to another person, may obtain a compulsory licence for use of the protected invention of the latter patent if the former invention represents an essential technical progress of substantial economic importance. The same applies in the case of the non-working of a patent within the EU. These rules have rarely been utilised in practice, but they probably have a preventive effect.

18. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

The European patent holder can strengthen its position by having the patent re-examined by the Patent Office. This system, introduced in 1993, permits administrative re-examination of both Danish and European patents which have been registered in Denmark. The patent holder can amend the claims and description of its patent in order to take newly discovered and relevant prior art into account. This procedure may improve the chances of success in a preliminary injunction suit.

If a European patent application is still pending, it is also possible to speed up the right to enforcement by filing an application for a utility model, preferably with a limited scope, that is tailor-made for an infringement suit. A utility model right can be enforced in the same way as a patent right, provided that the utility model has been examined by the Patent Office. In most cases it is possible to have an examined utility model granted within a few months and then to file a suit for preliminary injunction against an infringer at the city court.

A potential countermove from a defendant sued for infringement is to challenge the validity of the patent in high court or to request administrative re-examination at the Patent Office in order to have the patent invalidated or the scope of protection limited. However, where infringement proceedings are brought before a court prior to a final decision on re-examination, the Patent Office will temporarily shelve the prosecution of the re-examination case pending the decision from the court.

Because the climate for preliminary injunctions is generally favourable in Denmark, we have also seen an increase in the number of non-infringement suits filed by prospective defendants.

Finally, the rules on compulsory licences should be mentioned. These state that the owner of a patent, the use of which is

Enforcing patents in Finland

By **Ben Rapinoja** and **Aura Soininen**,
Borenus & Kempainen Ltd, Helsinki

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

Finland has been a member of the European Patent Convention ever since 1996.

European patents are treated as national patents after they have been granted and have come into effect in Finland. Therefore, the possibilities for European patent holders to enforce their rights in Finland correspond to those of national patent holders. Patent infringement cases can be trialled on a civil or criminal basis, although the former is normally what happens in practice.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

The District Court of Helsinki is the sole competent court of first instance with respect to patent infringement and invalidity matters in Finland. As all court actions in patent cases are handled before the district court of Helsinki, certain judges in one division of the court are specialised in hearing these cases.

The competent court of first instance in patent infringement actions consists of one legally trained judge and two technical experts in the preparatory hearings. The main hearing consists normally of three legally trained judges and two technical experts. Technical experts are appointed by the court and they are regarded not as judges but as assistants of the court. It is to be noted that in the proceedings for patent invalidation, the court shall at its own discretion also request the expert opinion of the Patent Office.

The second instance in patent infringement cases is the Helsinki Court of Appeal and the final instance is the Supreme Court. Neither the court of appeal nor the Supreme Court has technical experts assisting it.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

The preparatory phase of the court action in patent litigation is based on written documentation, while witnesses may be cross-examined in the main hearing. Scientific experts are quite often used as expert witnesses.

All material which illustrates that an infringement has taken place can be considered relevant. The same applies to material proving the claimed invalidity of a patent if the case concerns annulment issues. Written documents, letters, brochures, drawings and photographs or pictures of the product or process in question, findings by the witnesses etc, can be presented to the court. Rules of evidence are applied in accordance with the Civil Procedural Code of Finland.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

It is quite usual in Finland that an infringement action includes two combined proceedings: the patent infringement action of the claimant and the invalidation proceeding against the patent claimed to be infringed, initiated by the defendant. If both infringement and invalidation matters are combined, the court has first to decide the question of invalidity of the patent if the defendant so requests. The infringement proceedings are then stayed until the validity has been finally determined. This carries procedural benefits, because if the patent is

finally declared invalid, no penalty, payment of compensation or other measures may be ordered by the court as no infringement has taken place.

In Finland, the Patents Act does not define the level of proof necessary in order to demonstrate patent infringement or invalidity. Basically the courts may freely consider the evidence on the basis of which they determine what is right in the case. Only with respect to precautionary measures is there a defined standard for the issuance. Thus, the probability of the existence of alleged infringement is assessed by the court in these cases.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Finnish patent law does not permit so-called pre-trial discovery, as it is known to many common law jurisdictions. However, parties may request the court to order certain identified documents or other pieces of evidence to be presented in the court if these are necessary for determining the level of damages, for example.

6. To what extent does any doctrine of equivalents apply in an infringement action?

The basic rule for the interpretation of patents by the Finnish courts is set out in Section 39 of the Finnish Patents Act. According to this, the scope of protection conferred by a patent is determined by the claims and the description may serve as guidance for interpreting them.

Finnish case law, however, is not coherent with regard to the interpretation of the patent claims in accordance with the statute and also to the application of the doctrine of equivalents. Nevertheless, it can be said that while the courts have traditionally based their assessment in patent infringement cases first and foremost on the literal wording of the patent claims, they may also take into consideration the patent description, drawings and prior art when interpreting them. Furthermore, in practice the courts assess the patent claims as a whole, taking into account technical knowledge, intuition, legal tradition and expert opinions. The claims may thus be construed more broadly than their literal interpretation would give rise to.

Irrespective of what has been said above, in their reasoning the Finnish courts have not been keen on referring to the doctrine of equivalents, according to which patent scope also entails such elements which do not

infringe the patent claims literally, but which solve the technical problem in an equivalent manner compared to the elements explicitly mentioned in the patent claims. Instead, they have applied the doctrine indirectly and have considered whether there is only an insubstantial difference between the patented invention and the allegedly infringing product/process, or whether technical solutions are functionally similar.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

With regard to patents granted for computer-related inventions, the Finnish Patent Office has taken the position that it follows the practice of the European Patent Office (EPO) and accepts so-called product claims. However, to our understanding, the enforceability of these patents has not so far been tested in court. When it comes to certain biotech-related inventions, the situation corresponds to that of computer-related inventions: the practice of the Finnish Patent Office is largely consistent with that of the EPO, but the Finnish courts have not so far given decisions on the matter.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

Finnish courts do take the opinions and decisions of other courts into account, but as a general rule they are not bound by them with the exception of the precedents given by the Supreme Court.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Finnish courts are to some extent willing to take into consideration the reasoning given by foreign courts in similar matters, as well as the decisions of the EPO Board of Appeals. They are not bound to do so, however.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

The defendant may delay the court proceedings by requesting extensions for its statements. This kind of delaying tactics may prolong the process for several months. Furthermore, if the defendant challenges the validity of the patent claimed to be infringed, the court will set a certain period of time

during which the defendant must file the invalidity proceedings against the patent. Handling of the invalidity action before the court takes normally from one and a half to two years in the first instance.

11. How available are preliminary injunctions and how do you get them?

A preliminary injunction action may be initiated in Finland in the district court before the main subject matter is pending. In order to succeed with such a claim, there must be a danger that the other party will hinder or undermine the realisation of the patent holder's right by deed, action or negligence or in some other manner, or will essentially decrease its value or significance.

Furthermore, probability of the existence of a valid right is needed, and the granting of the preliminary injunction is tied to an interest balance: the other party must not suffer undue inconvenience in comparison with the benefit to be secured. Preliminary injunctions are sought quite often by patentees, especially in certain fields of industry, but the courts are cautious in awarding them.

In addition to a preliminary injunction potentially awarded prior to the initiation of the main action, it is possible to request the court in the course of the proceedings to grant an interlocutory injunction on use of the patent or to order that certain objects of property be seized for the duration of the proceedings.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

The timeline for the patent cases at the first instance is generally from one and a half to two years, depending on the case. There are no specific provisions for expedited process.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The parties in a patent infringement case are entitled to appeal the decision to the Helsinki Court of Appeal in accordance with the instructions given by the district court. These appeal proceedings last generally from one to two years.

The decisions and judgments of the court of appeal can be further appealed to the third instance, the Supreme Court. In patent proceedings, as in other civil proceedings, permission to appeal has to be given. Permission is granted only if it is important to bring the matter to the

Supreme Court in order to ensure the consistency of jurisdiction in similar cases, or if it is considered otherwise necessary due to an error in the proceedings or otherwise in the case that would ultimately lead to the reversal of the judgment or for some other weighty reason. In practice, permission to appeal is granted in less than one-tenth of all cases. In patent matters, the number is even lower.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

Costs of patent litigation are relatively high in Finland. Parties should take into account that, in addition to attorneys' fees, the work of patent agents and, in most cases, scientific experts (cross-examined as expert witnesses in the main hearing) add to the legal costs of the case. Parties should be prepared for costs varying between Euros 80,000 and Euros 400,000 to get to a first instance decision depending on the case. The costs are dependent on the amount of work needed for the court proceedings (the preparation in writing, oral preparatory hearings and the main hearing). The more writs and pleading papers in the proceedings there are, the higher the costs.

It should be also taken into account that in principle the winning party is entitled to have its legal costs compensated by the losing party.

15. Who can represent parties in court? Is specialist representation required?

The representative of the party in dispute must have a law degree, but no other specialist representation is required under the law. Normally parties are represented by attorneys who are members of the Finnish Bar Association and specialise in patent law and intellectual property litigation.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

In civil cases, the primary remedy for patent infringement in Finland is injunctive relief. Thus, if infringement is confirmed, the court typically forbids the infringer from continuing or repeating the infringing act. Furthermore, the infringer is as a general rule liable for paying reasonable compensation for the exploitation of the invention, which is often determined on the basis of licence analogy. Damages for other injury may also be awarded. These damages may only include

those incurred during the last five years prior to instituting the court proceedings, however. Moreover, if the patent infringement is intentional, the infringer may be liable to a fine. If requested, the court may also order that the infringing products must be altered or destroyed. If the patent infringement case is litigated on a criminal basis, the remedies available include a fine and imprisonment.

Punitive damages are not available in Finland and the reasonable compensation and damages awarded by the courts are typically rather low.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

If the parties so agree, they can settle their case in arbitration or in mediation.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

Finland has signed neither the London Protocol nor the European Patent Litigation Agreement. As of October 2006, no official decisions regarding the signing of the said agreements or the timeline for doing so had been made. Principally, Finland has had a positive approach towards the agreements, but prior to signing them there are still studies to be conducted with respect to the implications of the implementation of the agreements in Finland.

Enforcing patents in France

By **Pascal Moutard**, Brevalex, Paris

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

A European patent holder has exactly the same rights as the owner of a French patent. It is, in particular, entitled to have an infringement seizure carried out, which is a very efficient way of collecting evidence of infringement. After having brought proceedings before the court it may further request a preliminary injunction.

Custom detention is now also available on the basis of a patent. Although probably more difficult to enforce than custom detention of goods infringing trademarks, it can be a useful tool for patentees.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

All litigation on patent matters falls within the jurisdiction of seven first instance courts and of the relevant courts of appeals. However, 70% of the litigation is handled by the courts of Paris and Lyon. In the Paris court, one chamber specialises in IP matters. More than 300 patent infringement cases are filed each year in France and therefore the French courts are used to dealing with complicated IP cases. As a result, a patent owner can expect a high level of competence from French judges. Expertise may be ordered by the judge on technical questions but is not very frequent, except when evaluating damages.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

There is no cross-examination of witnesses. The whole procedure is in writing. In principle, any kind of evidence can be used, but it is very rare for a judge to rely on oral evidence. Experts' reports can be ordered by the judge and both parties have the right to see the report and findings, and to comment on them, just as they can with any other arguments and facts taken into account during the process. The expert report is only one piece of information for the judge and does not bind him. He is entirely free to follow the expert's conclusions or not. Accounting experts are also very frequently designated to evaluate damages. Sometimes experts' reports from foreign jurisdiction are taken into account by the French judge.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

The court which is competent to decide the infringement is also competent to decide validity. It makes the decision on infringement coherent with the analysis of the patent first performed by the judge to decide on the validity. As a general rule, any kind of evidence can be used. However, judges tend to rely on written evidence. In most cases an infringement seizure carried out by a bailiff is decisive for the decision on infringement. In the case of a patent covering a process for the manufacture of a product, the court may, subject to certain conditions, order the defendant to prove that the process used to manufacture an identical product is different from the patented process. It is a reversal of the burden of the proof. As to the validity of the patent, this is very often challenged by the defendant on the basis of written documents.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

There is no discovery process as, for example, in the US. The French Intellectual Property Code (CPI), however, has provisions on conducting an infringement seizure, a procedure which is very often used before a litigation. It allows a patentee to get relevant evidence in respect of the alleged infringement. The investigations may include the detailed description (*saisie descriptive*) – with or without the taking of samples – or the physical seizure of the infringing goods (*saisie réelle*). It is also possible to seize other items, such as the materials and implements used in the production of these goods and the documents relating thereto, to identify the infringers. These measures are taken *ex parte*, without the other party having been heard. Only the president of the court of first instance can order an infringement seizure and only the bailiff assisted by an expert (usually the patent attorney) is entitled to carry it out. It is a very efficient way to prove the infringement. It is possible for the person against whom the seizure is directed to ask the judge to retract or limit the order. Damages can also be claimed if the seizure is misused. With regard to the *saisie réelle* there is a time limit of 15 days as from the date on which the seizure is carried out to bring an action on the merits. If this does not happen, the seizure is void.

6. To what extent does any doctrine of equivalents apply in an infringement action?

Of course it applies. According to well-established French case law, means are equivalent if, despite being in a different form or structure, they have the same technical function to perform a similar result. This technical function has to be new. If it is known from the art then the doctrine of equivalents does not apply. The amended version of Article 69 of the European Patent Convention 2000 requires courts to take due account of equivalents, although it does not give a precise definition of the term.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Regarding CRI (computer-related inventions), there are some reasonable decisions in this field. French judges may apply the exclusion from patentability more strictly than the EPO. The analysis is not yet performed entirely on the basis of the same criteria (in particular, the “further technical effect”) that the now well-established EPO case law applies. I

think that practice will progressively harmonise between the different European countries.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

No French court is bound by any previous decisions on similar cases. But, of course, some principles have become well-established case law and are well observed and applied by judges, particularly in view of the specialisation of the courts, as already mentioned.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Here again French judges are totally free to evaluate or consider any decision or opinion from any other jurisdiction. In particular, when deciding on the validity of a patent they are not even bound by the decisions or opinions of the EPO Boards of Appeal on the same patent, though this does not mean they will not consider them. In addition, application of Article 69 EPC is not yet harmonised across Europe, so certain cases will be decided differently from one jurisdiction to another. This is one of the reasons why professionals are so impatient to have a system like the EPLA.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

If a patentee sues a third party on the basis of a European patent before the end of the opposition period, the assumed infringer will certainly file an opposition and the judge will consider whether it is appropriate to stay the proceedings.

The so-called torpedo strategy seems to be confirmed since the decision of the ECJ in the case *Gasser v Misat* of December 2003. A torpedo action is an action for declaration of non-infringement of a patent. It is filed by a plaintiff who feels threatened by a patentee before the latter files an infringement action. According to European Council Regulation 44/2001 (and the former Brussels Convention), in such a case the jurisdiction of the state where the infringement proceedings are brought has to stay the proceedings until the jurisdiction of the court first seized is established. In the past, it was not uncommon to see plaintiffs first seizing the courts of a country reputed for its slow

proceedings, in particular in patent matters, for declaration of non-infringement of a European patent in other countries. Any infringement action before other courts (seized after the first court) in these other countries was therefore frozen until the court first seized decided on its competency. And since the court first seized was particularly slow, the action before the second courts (the second courts) in other countries, such as France, decided not to stay infringement actions in such circumstances, particularly on the grounds that the action for declaration of non-infringement was filed in bad faith. But the ECJ has confirmed that the second court seized has to stay, regardless of any other consideration.

11. How available are preliminary injunctions and how do you get them?

The owner or the exclusive licensee, upon certain conditions, may request such a preliminary injunction. But proceedings on the merits must first be brought before the court for infringement of a patent and the injunction (or guarantees) is granted only if the proceedings on the merits appear well founded (that is, on the basis of the provided information, the patent is regarded as likely to be valid and the infringement action is likely to be successful) and have been initiated within a short time (usually within six months of when the patentee became aware of the infringing acts). The injunction is provisional and, under penalty of a daily fine, enjoins the defendant from committing the suspected infringing acts. The judge may grant the injunction only when the plaintiff has provided a guarantee to cover possible indemnification of damages suffered by the defendant if the infringement proceedings are subsequently judged to be unfounded. Or he may not grant the preliminary injunction and instead require the defendant to post a guarantee to cover indemnification of the patentee in case it is successful in its infringement action. Of course, the decision can be appealed.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

No accelerated examination of the case is available. The approximate duration of a typical infringement case is between 18 and 30 months in first instance, depending on the complexity of the case. It should be kept in mind that a decision is on both validity and infringement.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The judgment of the first instance court can be appealed within one month of the decision being handed down. The appeal automatically suspends the decision of the first instance court, although this can be declared enforceable notwithstanding appeal. And the decision of the Appeal Court can be appealed before the Supreme Court (Court of Cassation) on points of law only.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

It depends very much on the nature of the case and on its complexity (number of parties involved, need for an expertise, etc). Statistics recently published by the EPO indicate amounts of about Euros 50,000 to Euros 200,000 for a small to medium-scale patent litigation, which seems quite realistic and is confirmed by our experience.

15. Who can represent parties in court? Is specialist representation required?

The parties have to be represented by an attorney at law (*avocat*) before the first instance court and by an *avoué* for procedural matters before the Court of Appeal. Very few attorneys may represent parties before the Supreme Court (Cassation Court). Patent attorneys have no right of audience, although they deal with substantive matters and play an important role in any patent litigation.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Different sanctions may be ordered by the judge and these do not relate only to damages. Usually, the judge also decides to bar the infringer from continuing the infringing acts, under penalty of a fine (which can be quite high). Depending on the case, he may also order destruction or confiscation of the infringing articles. He may even order the confiscation of the means and devices that were used to realise the infringement, or bar the infringer from operating elements such as machines or processes in order to cease the infringement, under penalty of a fine. The solutions available in this regard are numerous. Publication of the judgment in the press (which can be a problem for the

reputation of some firms) is also sometimes ordered, as well as provisional execution of the decision, if needed.

As to damages, there are no punitive damages in France. Damages are intended to compensate the patentee for the harm suffered. They are calculated on the basis of the infringing asset (number and value of articles) and the commercial and technical capacity of the claimant in order to determine whether it could have satisfied the demand of the infringer's clients. For the part of the infringing asset which the plaintiff could have sold, lost profits will be determined, taking into account the profit margin of the plaintiff. For the part of the infringing asset which the plaintiff could not have sold, the damage will be estimated on the basis of a royalty rate (a higher rate than would willingly be agreed on). If the plaintiff does not exploit the invention in France or only imports into France, damages are calculated on the basis of a royalty rate (here again a higher rate than would willingly be agreed on). Directive EC 2004/48 on the enforcement of IP rights opens the possibility of increasing damages if necessary, in particular on the basis of the unfair profits made by the infringer.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Mediation and arbitration are open to patent disputes. The validity of the patent cannot be decided by an arbitrator, but most of the questions raised in a patent dispute can be settled through mediation or decided in the frame of arbitration.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

France is participating in the EPLA project and has signed the London Protocol.

19. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

Very often the plaintiff files additional claims for unfair competition. Combining different IP rights can also be very efficient in some cases, in particular for customs detention. And last, but not least, French judges are increasingly aware of the problem posed by infringement in general and damages awarded tend to be higher than in the past. I again mention Directive EC 2004/48, which opens the possibility of increasing damages if necessary.

Enforcing patents in Germany

By **Bernd Allekotte**, Grünecker Kinkeldey Stockmair & Schwanhäusser, Munich

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

A European patent designating Germany affords the same rights as those conferred by a German patent. The holder of such European patent has, in particular, the following options:

- The right to send out a cease and desist letter.
- The right to apply for a preliminary injunction or a decision on the merits.
- The right to obtain evidence of an infringement (to some extent only, though).
- The right to request border seizure.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

Specialised patent infringement chambers of a few selected district courts handle patent infringement cases. In total, there are 12 such chambers in Germany. The patent infringement chambers of the District Court of Düsseldorf have the highest filing rate among all of them, while those of the district courts in Mannheim, Munich, Hamburg and Frankfurt also hear a very substantial amount of infringement cases. The judges hearing patent infringement matters are trained jurists and do not need to have a technical background. Due to their being exposed to all facets of patent infringement continuously, the German patent infringement chambers are widely held in high esteem by parties and practitioners, and understand even complex and difficult patents and technology. The same is true with respect to the courts of appeal.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Although in any litigation an oral hearing takes place before the court, it appears to be the written briefs – rather than oral arguments – that make the courts come to a decision.

In practice, witnesses will be heard by the court and examined by the parties if crucial and decisive underlying facts of the case are in dispute (eg, if the defendant has a valid defence based on prior use). Experts are heard by the court to provide it with knowledge it does not have, in particular when, say, the technology is extremely difficult to grasp for the court or when the subject which is alleged to be infringing does not fall literally under the plaintiff's patent, but is said to be infringing under the so-called doctrine of equivalents.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

As opposed to other countries, German courts hearing infringement matters exclusively deal with infringement of the patent, ie, they do not have the competence to decide on the validity of a patent. As a consequence, the defendant needs to attack the validity in separate proceedings (which is why the German system is commonly referred to as the dual system), to be initiated at the Federal Patent Court, the European Patent Office or the German Patent and Trademark Office, as the case may be.

Although the defendant may not request that the court hearing an infringement matter invalidate the plaintiff's patent, it may request that the infringement proceedings be stayed until the invalidity proceedings are resolved, ie, until it has been determined whether the patent is valid. As a matter of fact, in almost all cases where a party files a complaint on grounds of patent

infringement, the defendant will respond by initiating invalidity proceedings. However, the infringement courts will honour requests to stay the infringement trial only in cases where there is an overwhelming likelihood that the patent which is allegedly infringed will be invalidated; otherwise, the infringement trial continues to run during the parallel invalidity proceedings. In practice, the defendant may succeed in convincing the infringement court to stay its proceedings if it can present a novelty-destroying prior art document which has not been examined during prosecution. It is only rarely that a *de novo* review of other prior art will lead to a stay of infringement proceedings, in particular when it has already been examined and reviewed during prosecution.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

German law contains no process similar to that of pre-trial discovery. Basically, a plaintiff needs to know all the relevant facts before suing. There are, however, some limited ways to obtain evidence from a defendant. Currently, under a rather recent ruling of the Federal Supreme Court, a plaintiff may request that a device or object that is not readily available to the plaintiff be inspected by an expert appointed by the court. Such a claim will be granted by the courts only if a balancing of interests (ie, a likelihood of infringement on the side of the plaintiff, as opposed to the justified interests of secrecy on the side of the defendant) results in favour of the plaintiff. Moreover, German courts allow for independent proceedings for taking evidence, according to section 485 of the Civil Procedure Code. Please note that the current regime of German laws is under review, as European Directive 2004/48 (Enforcement Directive) will be transposed into national law by the beginning of 2007.

6. To what extent does any doctrine of equivalents apply in an infringement action?

The scope of a patent is defined by the infringement court, which takes into consideration the meaning of the claims. These are interpreted in light of the description and the drawings of the patent.

If the subject matter fulfils all features of the patent literally, this constitutes infringement. However, modifications of the subject matter *vis-à-vis* one or more features of the patent may also be caught under the so-called doctrine of equivalents. According

to well-established German case law, a modification still falls under the scope of a patent if: (1) the modified means have objectively the same effect as the means of the patent; (2) a person skilled in the art was able to find such modified means; and (3) the person skilled in the art would also consider such modified means as a solution of equal quality to what is patented when reading the patent.

In practice, courts appoint experts to assist them in determining whether these requirements are met. Such experts are ultimately appointed by the court, yet the parties are given the opportunity – and are, in fact, invited – to propose experts in the particular technical field of the patent. The appointed expert is asked to submit a written opinion on factual questions that will allow the court to find for or against equivalence.

Once the court receives the opinion, the parties may comment on it in written briefs as well as in a follow-up hearing at which the expert may be ordered to appear to defend his opinion. Depending on the complexity of the issues raised and the time the expert needs to render an opinion, a trial may be delayed significantly, ie, for about a year.

7. Are there certain types of patent right that may be granted by the EPO – for example, biotech computer software-related – that are more difficult to enforce than others?

There are no specific types of patent granted by the EPO that should be regarded as being more difficult to enforce than others.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

German courts are not bound by opinions and decisions of other courts that have dealt with similar cases. Even at the appeal level, one will notice that in particular questions of law different views exist between the courts, but in practice these differences are rather minor.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Although a party may find it worthwhile to introduce a reasoning given by a foreign court in a parallel or similar case in its favour to bolster its position, it should not anticipate that German courts will be overly impressed by this.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

A defendant seeking to delay a case will primarily consider initiating invalidity proceedings against the plaintiff's patent and will try to convince the infringement court to stay proceedings until a decision has been rendered as regards the validity of the patent.

Another means to delay the infringement trial is to persuade the court to appoint and hear an expert. The defendant may succeed if the technology (patent) is difficult to understand and/or the patent is not infringed literally (ie, the subject matter contained modifications *vis-à-vis* the patent claim).

Potential defendants may also consider filing a motion for a negative declaratory judgment in a foreign jurisdiction where courts may render a decision rather slowly, such as Belgium or Italy. If the foreign complaint of the potential defendant is pending before it is sued in Germany, the German courts need to stay the German trial until a decision is rendered by the foreign court. At least until recently, this resulted in severe delays to some German trials. Recently, however, there has been a noticeable decrease in choosing such a strategy. One reason is a legislative change in the applicable European regulation now governing the point of time when a complaint is regarded to be pending for all EU member states equally. Also, in cases where it is obvious that the action of the defendant in the foreign jurisdiction is designed merely to delay German infringement proceedings, courts have held that this may constitute an abuse of procedural means and have heard the case in spite of a parallel foreign trial.

11. How available are preliminary injunctions and how do you get them?

The plaintiff may consider obtaining a preliminary injunction – which is limited to ordering that the defendant cease and desist from committing infringing acts.

Whether trying to obtain a preliminary injunction is an option for the patentee needs to be decided on a case-by-case basis. In practice, it is particularly interesting in less complex cases where the plaintiff can show a clear case of infringement. In any case, should the patentee consider filing a motion for a preliminary injunction, it needs to act very quickly because courts grant preliminary injunctions only if the matter is urgent; this requires the plaintiff to file a motion for a preliminary injunction with

a period of one to two months upon notice of the infringing actions.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

As compared to other jurisdictions, most patent infringement disputes are decided relatively quickly in Germany. As a rule of thumb, the plaintiff may expect the district court to render its decision about one year after the filing date if no expert is appointed and heard by the court.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

Any judgment in a patent infringement matter may be appealed. However, it is rather difficult to introduce new facts during appeal proceedings, ie, facts which were not introduced when the case was heard by the district court. In practice, therefore, appeal proceedings often turn out to be limited to reviewing whether the court of first instance applied the laws correctly. Appeal proceedings may take up to another year as from the date of filing the appeal.

It is only under very narrow circumstances that a further appeal – which goes to the German Federal Supreme Court – will be heard; such appeals are, in any case, limited to a review of questions of law.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

In Germany, the losing party needs to reimburse the winning party for legal fees, consisting of: (1) court fees; (2) attorneys' fees; (3) patent attorneys' fees; and (4) reasonable expenditures. The fees depend on the value in dispute, which is a number in Euros that reflects the plaintiff's interest in the case. In practice, it turns out that a plaintiff should consider being exposed to a minimum of about Euros 40,000 in legal fees if it loses the suit. The cost risk increases in more important cases, but in almost all cases the plaintiff may assess it pretty accurately before suing.

In appeal proceedings, the same principles apply, but the cost risk is roughly 20% higher than in the proceedings before the court of first instance. The cost risk for an invalidity action depends on the specific action initiated.

15. Who can represent parties in court?

In patent infringement matters, the parties

need to be represented by an attorney at law who is admitted to the German Bar. There is no need for the attorney at law to be domiciled at the court hearing the matter; rather, any German attorney at law may represent clients at both the district court and the court of appeals level.

It is quite unusual for an attorney at law representing a client in a patent infringement trial also to have a technical background. In practice, therefore, the litigators are always assisted by patent attorneys who provide them with the technical background required by the specific case.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

The usual remedies sought by the plaintiff include: (1) cease and desist; (2) payment of damages; and (3) rendering of accounts for infringing actions in the past. Damages may be calculated by the plaintiff on the following bases: (1) actual losses of the plaintiff; (2) reasonable licence fee; or (3) profit generated by the defendant.

Due to a recent holding of the German Federal Supreme Court, claiming the profit made by the defendant may often turn out to be the most rewarding method for the plaintiff. Under certain circumstances, the plaintiff may also request that infringing devices be destroyed. If the court finds in favour of the plaintiff, it may enforce the judgment by depositing security (in an amount which is fixed by the court) by way of, for example, a bank guarantee.

17. Are there any realistic alternatives to litigation, in cases relating to patent disputes?

Although alternative dispute resolution techniques such as mediation or arbitration are, in general, available, they do not play an important role.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

Germany has ratified the London Protocol.

19. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

A patentee should always consider filing a request for border seizures to stop infringing devices from entering the country.

Enforcing patents in Hungary

By **Dr Gábor Faludi** and **Dr Gusztáv Bacher**, Szecskey Ügyvédi Iroda – Attorneys at Law, Budapest

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

A European patent is subject to the same conditions as a patent granted by the Hungarian Patent Office (HPO). A European patent is considered granted when the notice is published in the *European Patent Journal*. The patent's effect is subject to the filing of the Hungarian text of the European patent with the HPO within three months of its grant. Should the patent owner fail to file the Hungarian text, the patent shall be regarded as ineffective in the territory of Hungary.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

In patent cases, the Metropolitan Court of Budapest has exclusive jurisdiction, as a court of first instance. A specialised council composed of a three-judge panel, where two of the three professional judges are required to have a technical degree, handles cases. The Metropolitan Court is an assigned higher-level court. The Metropolitan Circuit Court hears appeals against its decisions. Legal revision (exceptional relief) falls within the power of the Supreme Court.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

It is not possible to cross-examine witnesses at trial in the way the question suggests. However, the court hears witnesses and the parties may ask them questions. The court

usually appoints an expert for those fact-finding issues that require special expertise.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Patent cancellation claims shall be initiated before the HPO. If the defendant in the infringement proceedings challenges the validity of the patent (this is a separate proceeding) and the patent cancellation proceedings are pending (either before the HPO or after appeal before the court), the infringement proceedings are suspended. At the request of either party, patent cancellation proceedings shall be conducted expeditiously if patent infringement litigation has been commenced on the basis of the same patent. However, the pending cancellation proceedings may not prevent the court from ordering an interim injunction against the alleged infringer. In the course of the court's review as to whether the interim injunction is necessary for the special protection of the claimant's rights (for the details see section 11), the court shall consider whether the patent has already been cancelled by the non-final decision of the HPO or the court of first instance, or whether a European patent with effect for the territory of the Republic of Hungary has been revoked by the Opposition Division of the European Patent Office (EPO), or whether it has been cancelled in another member state of the EPO in a final or non-binding decision.

There are no specific rules on level of proof in IP matters. With respect to process patents, the Patent Act grants a presumption for the patent holder – pursuant to the TRIPs Agreement – that, pending proof to the contrary, a product shall be deemed to be produced through the patented process if the product is new, or it is highly probable that the product has been manufactured through the patented process, and the patent holder cannot define the applied process, even after

having taken the steps generally expected in the given situation. In particular, it is highly probable that the product has been produced through the patented process if this is the only known process.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Even before the commencement of the litigation, the court may – on request of the interested party – order preliminary fact-finding proceedings if it is likely that the carrying out of such fact finding during the proceedings or at a later time would not be successful or would be more difficult; or would enable the court to finish the proceedings within a reasonable period of time. Further, preliminary fact-finding may be carried out if the holder of the patent has already substantiated the infringement or threat of infringement to a reasonable extent. Preliminary fact-finding may also be ordered in *ex parte* procedures, where any delay is likely to cause irreparable harm or where there is a demonstrable risk of evidence being destroyed. These circumstances will be treated as a case of urgency.

There is no obligation under Hungarian law for a litigant to disclose documents to the other litigant. Discovery proceedings similar to those found in US courts are unknown in Hungary. It should be noted, however, that while there is no general duty of disclosure, the tribunal could order a litigant, at the request of the counterparty, to disclose certain documents, including documents that could be harmful to the disclosing party (notwithstanding the protection of trade secrets). In IP litigation, the burden of proof can be reversed if the plaintiff has substantiated its statements to a reasonable extent. As a result, the opposing party can be ordered to present and allow for review documents and other physical evidence in its possession, and to present bank, financial or commercial information and documents in its possession.

6. To what extent does any doctrine of equivalents apply in an infringement action?

The scope of protection conferred by a patent shall be determined by the claims. The claims shall be interpreted on the basis of the description and the drawings. Patent protection shall cover any product or process in which all the characteristics of the claim are embodied. The terms of the claims shall not be confined to their strict literal wording; neither shall the claims be considered as

mere guidelines for a person skilled in the art to determine the claimed invention. The official reasoning of the Patent Act explains that due to this provision governing the scope of protection, it is not necessary to define the doctrine of equivalents in the Patent Act.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

In principle, there is no difference between the enforcement of different types of patent. The legal preconditions for the granting of patents are in conformity with the EPC.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

While binding case law (precedents) *per se* does not exist in Hungary, the Supreme Court sets guidelines based on principles and also publishes opinions on issues of principle in order to give guidelines to all courts. Such directives and decisions on issues of principle as set forth by the Supreme Court are binding on all courts in Hungary.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Jurisprudence in Hungary does not take into account the decisions rendered by the courts of other countries. Hungarian courts may decide only on the basis of the legislation in force in the Republic in Hungary and the facts of the case revealed by the Hungarian courts. Following Hungary's accession to the European Union, it is no longer possible to apply without reservation the former precedents, according to which a foreign decision, rendered upon similar facts of the case, cannot substantially bind the Hungarian court (formal binding force undoubtedly does not exist), as the decisions rendered by the courts of the member states are based on mandatory harmonised substantive law.

As indicated above under section 4, in the course of evaluating the grounds of an interim injunction, the court may consider whether a European patent has been revoked by the Opposition Division of the EPO or whether it has been cancelled in another member state of the EPO.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

If the patent holder starts an infringement case, the defendant may claim, from the HPO, the revocation of the patent on the basis that the patent is not eligible for protection. Although commencing cancellation proceedings *per se* does not prevent the Metropolitan Court from rendering a preliminary injunction, the court shall also consider whether the patent has already been cancelled by a non-final decision of the HPO.

11. How available are preliminary injunctions and how do you get them?

According to Section 156(1) of the Hungarian Civil Procedure Code, a court may, upon application, issue a preliminary injunction in order to: prevent imminent damage; maintain the *status quo* during a legal dispute; or protect the claimant's rights if it is found that they need special protection. This is the case as long as the burdens imposed by such a measure do not exceed the benefits that may be gained by it. The facts relating to the reasoning of the request for a preliminary injunction must be of a probable nature.

The request for a preliminary injunction in infringement litigation can be filed prior to filing the statement of claim. In court actions instituted on the grounds of alleged infringement of a patent, a preliminary injunction will be considered necessary for the special protection of the claimant's rights if the claimant can prove that the patent is protected and that it is the patent holder or a user which is authorised to institute court proceedings due to an infringement in its own name. Upon weighing the potential benefits and disadvantages of the preliminary injunction, the court shall take into account whether such injunction is manifestly and substantially contrary to public interest or the interests of third parties.

Instead of an injunction, the court may order the defendant to provide appropriate security in lieu of continuing the allegedly infringing acts.

The court shall rule on a preliminary injunction in special proceedings no later than 15 calendar days following the submission of a petition for such measures. The same rules apply to the court of second instance regarding appeals against the decisions of the court of first instance. The preliminary injunction is enforceable even if the defendant files an appeal against such decision. The parties must be heard personally, unless the urgency of the situation makes a hearing impossible. Where any measures are taken *ex parte*, the opposing party shall be given notice when the

decision is executed. Upon being notified of the decision, the affected party may request a hearing and that the decision ordering the provisional measures or the preliminary evidence be modified or revoked.

In a similar way to so-called Mareva injunctions and under the conditions set forth above relating to the preliminary injunction, the patent holder may request the court to order: (1) protective measures under the provisions of the Act on Judicial Enforcement, if it can be substantiated that any subsequent attempts for the recovery of profits made by the infringement or the payment of damages are in jeopardy; and/or (2) the infringer to provide or disclose bank, financial or commercial information and documents for the purposes of ordering such protective measures.

The party requesting the court to grant the preliminary injunction or protective measures may be obliged by the court to provide appropriate security. The security serves as a deposit to satisfy claims for the recovery of financial disadvantages suffered by the opposing party. If the opposing party fails to enforce its claim for recovery within three months of the operative date of the judgment for repealing the measure, the depositor of the security may request the court to release the security. This provision provides compensation for those who suffer from an unfounded request to apply the said measures.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

Section 2 of the Code of Civil Procedure provides that court proceedings must be completed within a reasonable time. However, it often takes years to obtain a judgment, depending upon the workload of the court and the complexity of the matter. It is worth mentioning that the reform of the judicial system – namely the setting up of the Court of Appeals between the second level (county and metropolitan courts) and the Supreme Court – has considerably accelerated the proceedings at the appellate courts.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

In infringement proceedings, an appeal can be filed against a judgment of the Metropolitan Court to the Metropolitan Court of Appeal. Further, the party may request from the Supreme Court, on the basis of violation of law, a judicial review of the

second instance judgment rendered by the Court of Appeal.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

Depending on the complexity of the case, from Euros 1,500 upwards.

15. Who can represent parties in court? Is specialist representation required?

In patent cases, attorneys-at-law or patent attorneys may represent the parties.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Hungarian law has been adapted to the IP Enforcement Directive (2004/48/EC). Claims can be initiated against the infringer of the patent right and some of them (injunction and data provision, as set forth below) may also be initiated against third parties. In the event of infringement, the patent holder may – in accordance with the circumstances of the case – have the following civil law claims against the infringer:

- Establishment of the fact that patent infringement has occurred.
- Cessation of the infringement or threat of infringement and injunction from further infringement or the provision of security (guarantee) by the infringer in case the allegedly infringing behaviour were to continue.
- Provision of data on parties taking part in the manufacture of and trade in goods or performance of services which infringe on the patent, as well as on business relationships established for the use of the infringer.
- Amendments of the infringement – by declaration or in some other appropriate manner – and, if necessary, publication of such amendments by and at the expense of the infringer.
- Recovery of economic profits achieved through infringement.
- In relation to those assets and materials used exclusively or primarily in the infringement, seizure, delivery up thereof to a particular person, recall and definite withdrawal thereof from commercial circulation, or destruction.
- Appropriate measures for the dissemination of the information concerning the decision at the expense of the infringer as decided at the discretion of the court.

- Compensation of damages other than the financial profit achieved by the infringer in case of culpable infringement under the Civil Code.

Further, the court may order the defendant to pay general (estimated) compensation for damages if the extent of damage (usually the lost profit element of the damage) cannot be precisely – even if only in part – calculated. The estimated damages should suffice to provide the injured party with full financial compensation. A sentence on estimated damages constitutes *res judicata*, even if it turns out in the future that the extent of actual damage did not subsequently reach the amount of the estimated damages. If, however, the defendant pays an annuity (a recurring amount) as estimated damages, the reduction thereof or the reduction of the payment period can be claimed in accordance with any substantial changes in the conditions. Hungary does not have the concept of punitive damages. The damages award is meant to provide full repair, ie, to compensate a party from the loss actually suffered.

Some of the claims as listed above can also be enforced against persons other than the infringer. The claim for injunction can be enforced against any party whose service is used in relation to the infringement. Claims to provide information can be enforced against third parties, namely parties to the infringement who are:

- Found in possession of the infringing goods on a commercial scale.
- Found to be using the infringing services on a commercial scale.
- Found to be providing, on a commercial scale, services used in infringing activities.
- Named by the persons referred to above as being involved in the production, manufacture or distribution of the goods or the provision of services.

The information to be provided by either the infringer or the party aiding infringement covers:

- The names and addresses of the producers, manufacturers, distributors, suppliers and other previous holders of the goods or services involved in the infringement, as well as the intended wholesalers and retailers or those actually involved.
- The quantities produced, manufactured, delivered, received or ordered, as well as the price paid or received for the goods or services in question.

Assets, materials and goods can be seized even if they are possessed by an owner other than the infringer if the owner acts in bad faith, ie, it was aware of the infringement or should have been aware of same with proper care.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Settlement by the parties.

Mediation proceedings under a separate Act preceding a lawsuit are possible in patent cases (except for a challenge to a decision of the HPO) as well. If the mediation fails, the parties are free to commence a lawsuit.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

Hungary has not signed up to either the London Protocol or the European Patent Litigation Agreement. The issue of signing is under professional discussion.

Enforcing patents in Iceland

By **Gunnar Örn Harðarson** and **Ásdís Magnúsdóttir**, Árnason Faktor, Reykjavík

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

An important remedy for a patent holder in Iceland is the possibility of having a preliminary injunction against the allegedly infringing act. Such an injunction is granted not by courts but by governmental authorities, somewhat similar to sheriffs. Such actions are relatively swift and one can expect a ruling within a few weeks. An injunction is possible upon proving, or showing that it is plausible, that an act is likely to infringe one's legitimate rights, that the act has already begun or that it is pending, and that the owner's rights will be diminished or harmed substantially if it is forced to wait for a court's decision. The most important condition is that it must be proven that general rules on torts or punishment will not provide for sufficient protection for the rights holder. There is also a comparison of the interests of the rights holder to have the injunction granted with the interests of the alleged infringer to pursue its actions.

If an injunction is granted, a case will immediately follow in the courts in order to confirm the preliminary injunction (must be filed within one week of issuance of the preliminary injunction). The alleged infringement will be dealt with in that same case.

General court proceedings are also possible without any prior injunction measures. The court system in Iceland is made up of two stages: district courts (eight courts in eight jurisdictions around the country) and the Supreme Court. All patent cases, including verification cases following injunctions, are dealt with in the district court of Reykjavík.

Finally, we would like to mention that there are some remedies available under Icelandic customs laws. It is possible, if there is a belief that products infringing intellectual property rights are being imported, to have those products withheld in customs clearance. This is possible upon request from the relevant IP rights holder while it seeks justice before the competent authorities. In these cases, the rights holder must submit an indemnity to cover any financial damage for withheld products which are subsequently found to have been imported legally.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

There are no specialist patent courts in Iceland. Patent cases, like all other cases, are tried before general courts, although cases involving patents are all tried within the same jurisdiction, the district court of Reykjavík.

Only a few patent cases have been tried before Icelandic courts, although it is our opinion that the number is increasing. Expertise among judges is therefore not great. It is possible, however, to call for experts in a certain field to sit as assisting judges in a patent case. These experts do not have to be lawyers but are usually professionals in the relevant technical field. Another option is to appoint outside assessors to give expert assessments regarding certain questions or uncertainties relevant to the case at hand.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Yes, it is possible to cross-examine witnesses. The rule is that the party bringing the witness first asks questions. The opposing party then has an opportunity to cross-examine.

The main rule is that all cases before Icelandic courts go through oral proceedings. Parties present the case and explain the submitted materials and other evidence they have put forward. Evidence in a case can be statements of parties before the court, statements of other witnesses, expert assessments and statements before the court, written materials and other substantial materials.

There are general rules that one must comply with in order to have a court-appointed expert assessor. An expert assessor can answer questions that pertain to, for example, what is a fact in a given case. The role of an expert assessor is, however, limited by the role of the judge - that is, he cannot be used to answer general questions that pertain to interpretation of the law or questions that one only needs general knowledge or education to be able to answer. Those are within the role of the judge in each matter. The judge then decides the evidential value of an expert assessment. In general, though, it is safe to state that expert assessment is usually considered very strong evidence with regard to the questions it covers.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

In an infringement case the defendant can counter-summon the plaintiff claiming invalidity of the patent. When this happens the validity of the patent is dealt with simultaneously with the infringement claim.

Rules on proof are not very well defined in Icelandic law and practice in matters relating to patent infringement and invalidity. This is true mainly due to lack of precedents in courts. The basic rule is that the burden of proof regarding infringement lies on the party alleging the infringement. The judge then decides in accordance with general rules on proof in Iceland whether a fact has been proven or not. There are, however, special rules regarding the burden of proof in an infringement case involving process patents. If the alleged infringer is making the same product as the process patent covers it has the burden of proving that the product is not made with the patented process.

In cases involving invalidity of patents, the party alleging invalidity has the burden of proving that to be the case. Here again it is within the general role of the judge to decide whether the claim has been proven or not.

In addition to the above, we would like to emphasise that Icelandic patent laws have

been amended to comply with the EPC. It remains to be seen how much Icelandic courts will look to court precedents in relation to the Convention.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Pre-trial discovery phase as it is known in the US does not exist in Iceland.

6. To what extent does any doctrine of equivalents apply in an infringement action?

According to Icelandic laws, the scope of the patent is based on the patent claims. The claims are constructed with reference to the description given in the patent. In general, it is also safe to say that courts will to some extent use some kind of doctrine of equivalents in resolving infringement matters. However, again, we have to emphasise lack of court precedents in this regard, so it is difficult to lay down detailed rules in this respect. Courts would, however, look to precedents in other Nordic countries.

Moreover, as Iceland is now a party to the EPC, its courts are bound by the Protocol on interpretation of article 65 of the EPC, although the Protocol is not directly a part of Icelandic laws. It remains to be seen how much courts will refer to the the Protocol in relation to its interpretation of the scope of patent claims.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software related, for example – that are more difficult to enforce than others?

Since 1st November 2004, the patent laws of Iceland have been harmonised with the EPC. Icelandic laws have also been amended to comply with the EU directive on the legal protection of biotechnology inventions. Therefore, there are no provisions in Icelandic laws that would act as an obstacle for enforcement of European patents in this respect. But, again, there is very little case law in the field so it is very difficult to predict the possible outcomes in such cases. Regarding computer software-related inventions the practice by the Icelandic Patent Office up until now has been to follow EPO practice. Consequently one would expect that that would apply also for the courts.

In this respect we would, however, also like to draw attention to recent changes in the patent laws of Iceland to comply with EU Directive 2004/27/EC of 31st March 2004, which changed Directive 2001/83/EC. A

certain limitation was added to the scope of patent protection on 8th March 2005 (Bolar type exception) with regard to research and testing, and other necessary means to allow applications for marketing authorisation of, for example, generics.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

In general, courts look to precedents when deciding cases if the cases in question are similar and there have been no changes in the laws. Precedents of the Supreme Court of Iceland are of particular importance in this respect. District court precedents are of lesser importance.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

In general, Icelandic courts are often willing to consider reasoning and precedents given by courts in the other Nordic countries. This also applies in the field of intellectual property rights. Court decisions from other countries might also be relevant, especially if they are related to the interpretation of international agreements to which Iceland is a party.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

Parties to a court proceeding cannot by themselves, even if they both agree, delay a case. The judge is supposed to deny granting of useless extensions of terms to ensure that the case will be resolved quickly and effectively. This rule prevents parties from delaying a case out of the ordinary, on their own or in agreement with the other party.

11. How available are preliminary injunctions and how do you get them?

Preliminary injunctions are granted by governmental authorities, somewhat similar to sheriffs. Such actions are relatively swift and one can expect a ruling within a few weeks. An injunction is possible upon proving or showing that it is plausible that an act is likely to infringe one's legitimate rights, that the act has already begun or that it is pending and that the owner's rights will be diminished or harmed substantially if it is forced to wait for a court resolution. The most important condition is that it must be proven that general rules on torts or punishment will not provide for sufficient

protection for the rights holder. There is also a comparison of the interests of the rights holder to have the injunction granted with the interests of the alleged infringer to pursue its actions. If an injunction is granted, a case will immediately follow in court in order to confirm the preliminary injunction (this must be filed within one week of issuance of the preliminary injunction). The alleged infringement will be dealt with in that same case.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

It takes about six to 12 months to complete a case at first instance. An expert assessment, however, usually takes up a large chunk of time, if one is requested. Deciding to have an expert assessment therefore usually delays a final decision. There is a special procedure before the courts for cases requiring quick resolution, but this procedure is in general not available in a typical infringement case. An IP-related matter might qualify for this special procedure if the matter revolves around a decision of government authorities.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

An appeal from the district courts in Iceland is possible to the Supreme Court. The criteria for granting an appeal are not very strict but mainly relate to the minimum amount claimed, if the claim involves a certain amount of money. The minimum amount today is around Euros 5,500. An appeal must be lodged within three months of a court's decision in a first instance case. The appeal process takes about six to eight months.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

This is very difficult to estimate. The number of cases has been very limited in the past and they have not been very complex. To give some guidelines we would estimate the cost to be in the range of Euros 30,000 to Euros 50,000 for taking a non-complex patent case through the first instance court.

15. Who can represent parties in court? Is specialist representation required?

Although parties can represent themselves in Icelandic courts, that rarely happens and especially not in complex matters such as

patent cases. To be able to represent others in court one must be an attorney at law authorised to practise before the courts of Iceland. Patent attorneys (patent agents) are not allowed to represent others in court.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Upon proving infringement the remedies available are damages for the injury which the infringement may have caused. Some compensation for the exploitation of the patent is also possible. If the infringement is conducted intentionally the punishment can be a fine or, under aggravated circumstances, imprisonment for up to three months. Other measures may be demanded by the court upon a claim thereon to prevent the abuse of products manufactured in accordance with the patented invention or of any apparatus, tool or other article the use of which would involve patent infringement.

Punitive damages are, however, not available under Icelandic laws.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

It is, of course, possible to solve cases through arbitration in Iceland. That has not been used much in IP-related matters, however, and we would not recommend it as a realistic alternative, due to lack of experience in such cases.

18. Has your jurisdiction signed up to the London Protocol or the European Patent Litigation Agreement? If not how likely, is it that it will do so?

Iceland acceded to the London Agreement on 31st August 2004 when depositing its instruments for EPC membership. In practice, the principles of the London Agreement have actually been followed in Iceland since 1st January 2002. This means that only a translation of claims into Icelandic is required, provided the description is filed in English. If the description of an issued European patent is in German or French, the proprietor can choose to file either an Icelandic or English translation or validation. This rule applies to all European patents validated in Iceland and having an effective filing date after Iceland's accession to the EPC. This is worth special attention as it reduces the cost of validating European patents in Iceland considerably.

19. Are there any other features of the

enforcement system in your jurisdiction that you would like to point out?

We would like to draw special attention to new legislation (Law 53, 13th June 2006), which entered into force on 1st July 2006, concerning obtaining proof in relation to infringement of IP rights, including patents. The law stipulates that following a court order, where a patent holder needs to show that infringement is already likely to have occurred, a search may be conducted by government authorities (sheriffs) to collect evidence - such as products, equipment for production, computer data or other relevant material - of the infringement. This procedure is designed to be relatively swift and it is worth noting that under certain circumstances the judge does not need to advise the alleged infringer of the court proceedings or of the upcoming search.

Enforcing patents in Ireland

By **John Whelan** and **Ciara Cullen**, A&L Goodbody, Dublin

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

The holder of a European patent may bring civil proceedings to enforce its rights in Ireland. Ireland recently transposed into national law the EC Directive on the Enforcement of Intellectual Property Rights, which had the effect of harmonising enforcement procedures throughout the European Union. Thus the holder of a European patent can expect to have similar enforcement remedies available to it in Ireland as in other member states.

In practice, civil proceedings commence after the claimant has issued a letter before action and the allegedly infringing party has been given an opportunity to remedy any damage caused. The onus rests upon the plaintiff rights holder to prove its case, although certain presumptions of ownership and the subsistence of rights in the plaintiff (until the contrary is proved) may apply in certain circumstances.

As a general rule, the patent owner may commence proceedings to enforce its rights in the event that a third party makes, offers for sale, puts on the market, imports or uses a product or process which is the subject matter protected by the patent, without the patent owner's consent. However, patent owners should be aware that there are certain limitations placed on their right to commence court proceedings to enforce their rights under a patent, such as where the allegedly infringing act is done for private or non-commercial purposes and where acts are done for experimental purposes.

2. Does your jurisdiction have specialist patent courts? If not, what level of

expertise can a patent owner expect from the courts?

Ireland does not have specialist patent courts. Choosing the right court is thus a key early consideration for patent owners. In general, patent infringement proceedings will be commenced in the High Court, in either the chancery division or in the relatively new Commercial List, the latter commonly referred to as the Commercial Court.

Although the High Court has general jurisdiction to hear patent claims, the Irish Commercial Court has been conferred with specific jurisdiction over intellectual property disputes both at first instance and on appeal. However, specific permission from the Commercial Court has to be obtained before bringing proceedings before it. There are a number of advantages for parties involved in patent proceedings to make such an application for entry into the Commercial Court. The Commercial Court rules have been designed to provide for strict timeframes and more efficient and less costly trials, important factors in any patent case. In addition, the judges in the general High Court may not have had any significant patent litigation experience, whereas the judges of the Commercial Court are more likely to have been involved in such cases. An application to have the claim heard by the Commercial Court is made by a motion to the court on notice to the other parties to the proceedings at the commencement of proceedings or shortly thereafter. Given its specific jurisdiction for IP disputes, most if not all future patent cases are likely to be brought in the Commercial Court.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Yes, cross-examination of witnesses at trial is possible. The Commercial Court does, however, favour – where possible – the

exchange of written statements based on agreed evidence between the respective parties' experts. The Commercial Court may also require the parties to set out their cases in writing and use the witness statements, sworn under affidavit, as the main evidence of the witnesses. It is a unique feature of the Commercial Court to allow parties to exchange witness statements and expert reports pre-trial, aimed at reducing the length of proceedings.

If a matter is pursued in the chancery division of the High Court, then the more traditional method of oral argument and cross-examination of witness at trial is likely, and the case can therefore probably be expected to progress more slowly.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Yes, infringement and invalidity are usually dealt with simultaneously: any defence mounted to a claim for infringement on grounds that the patent is invalid would generally and logically be coupled with a counterclaim by the defendant for invalidity of the patent.

The burden of proof is on the party alleging infringement of its rights under the patent to demonstrate, on the balance of probabilities (that it is more likely than not), that the patent has been infringed. A defendant may seek to argue, in response to a claim that its actions have infringed the patent owner's rights, that the existing patent is invalid. In that case the defendant bears the burden of proof to show on the balance of probabilities that the patent is invalid.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

There are no specific rules governing pre-trial discovery in relation to patent disputes.

As a general rule, when legal proceedings are issued, the right to obtain discovery arises automatically and both parties are required to provide full discovery of all documents relating to the dispute which are, or have been, in their possession, custody or power, except those documents protected by privilege. Discovery may be effected voluntarily, by agreement between the parties or by order of the court following a successful application by one or other party. As a general rule, discovery will be required in respect of all documents relevant to matters in issue in the proceedings and which are necessary for the fair disposal of the proceedings or to save costs.

6. To what extent does any doctrine of equivalents apply in an infringement action?

The Irish courts have not adopted a doctrine of equivalents in patent proceedings and the doctrine does not as such form part of Irish patent law.

The Irish courts have, on the other hand, endorsed the purposive approach to construction of patent claims in line with the approach under Article 69 of the Protocol to the European Patent Convention. The purposive approach, being narrower than the approach taken when applying the doctrine of equivalents, means that patent claims will be construed by the Irish courts objectively through the eyes of the skilled addressee.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

There are no specific legal rules relating to biotech or computer software-related patents as such which makes them more difficult to enforce in Ireland: the rules governing enforcement of patents are indiscriminate. Practically speaking, however, if the subject matter constitutes newly emerging technology, and the patent rights are complex and require specialised expertise to assist in their enforcement, they may be regarded as more difficult, costly or time consuming to enforce than patents for a more traditional subject matter.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

As a general rule, Irish courts are bound by the doctrine of precedent such that lower courts will be bound by decisions of the superior courts.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

There have been only a limited number of patent cases decided in Ireland; thus, there is a likelihood that particular points of patent law may not have been considered by an Irish court. In the absence of any existing Irish case law on a particular issue, Irish courts may look to the case law of other, particularly common law, jurisdictions for guidance. Historically, Irish courts have demonstrated a preference to follow the decisions of the English courts.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

In the High Court, a defendant may repeatedly miss deadlines in an attempt to delay the court proceedings. However, if the matter has been transferred to the Commercial Court, which for the reasons mentioned above is now likely to be the case for most patent proceedings, such delay tactics, if adopted, are a dangerous strategy for a defendant. In the Commercial Court interim costs orders will be made to penalise late compliance with time limits. If a plaintiff brings any such tactics to the attention of the court it will result in swift and stern measures by the court against the defendant to move the case on.

11. How available are preliminary injunctions and how do you get them?

In the High Court, an application may be made for an interlocutory injunction restraining the defendant from any possible or actual act of infringement. The principles upon which an injunction will be granted are well settled in Ireland and apply to patent cases in the same way they apply to other cases. Basically, the claimant must demonstrate that there is a serious question to be tried and that damages would be an inadequate remedy. The grant of an injunction is a discretionary power and the court will assess whether to exercise that power according to the balance of convenience. The plaintiff is also likely to be required to give an undertaking as to damages (to cover the situation where it is ultimately determined that it should not have obtained the injunction). Injunctions are more common in the High Court in general, as judges in the Commercial Court may be more inclined to grant a speedy and early trial rather than interlocutory injunctive relief.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

The Commercial Court, in operation since January 2004, has been widely acclaimed as a major success with regard to the speed at which it brings matters to trial. The system of rigorous case management which it has employed and its ability to offer early hearing dates have ensured the speedy resolution of disputes – the average time from start to finish of a case at the end of the last legal term was a mere nine weeks, with the allocation of a trial date taking approximately five weeks from institution of proceedings.

This is a marked improvement from the chancery division of the High Court which can take as long as 18 months to hear a case. In either court, however, complex and contested patent cases will still be likely to take longer than the typical commercial or IP dispute.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

An aggrieved party may appeal a decision of the High Court only on a point of law to the Supreme Court. There is no avenue for appeal on a question of fact.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

This is very difficult to answer as there have not been enough patent trials in Ireland to give an informed view.

15. Who can represent parties in court? Is specialist representation required?

Parties are represented by qualified solicitors and barristers – we have a two-tier system as in the United Kingdom, where solicitors prepare the case and barristers argue it before the court at trial. Although specialist representation is not required it is advisable to use a solicitor and barrister with experience in patent disputes, in addition to a patent agent where the technology covered by the patent is complex.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

The remedies typically available on a finding of patent infringement include: order for delivery up or destruction of infringing goods; an injunction preventing further infringement; damages or an account of profits; and costs.

Punitive damages are generally not available in a patent infringement case. Furthermore, an award of damages will not be awarded against an innocent infringer who was genuinely not aware, nor should have been aware, of the existence of the patent.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Recent law reforms have encouraged the use of alternative dispute resolution (ADR) as a means to solve IP-related conflicts. Arbitration and mediation are the most common ADR procedures in Ireland. In

arbitration, the dispute is settled by an impartial expert or arbitrator who issues a binding decision. Mediation, on the other hand, does not involve a binding decision but helps bring both parties towards an amicable resolution.

ADR procedures have the advantage that a greater degree of control is retained by the parties. In addition to the time and cost-effective benefits of ADR, the arbitrator/mediator is usually an expert in the field of the dispute and confidentiality is assured. There are many institutions that offer ADR advice and expertise; however, the WIPO Arbitration and Mediation centre is the best international institution as it focuses on IP and technology-related disputes.

A patent dispute is often centred on specific technical details, such as modifications to mechanical inventions or alterations to chemical entities. As such, it can often be a highly complex matter that involves a qualitative examination of the state of the art, on which the parties simply cannot agree. Thus, unfortunately, litigation may often be the only realistic option available.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

Ireland has not yet acceded to the London Protocol or the EPLA.

19. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

Under the Brussels Regulation, which has now succeeded the Brussels Convention on the Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters 1968, a defendant must be sued in his home state. However, there is an exemption in tort law that allows the defendant to be sued in the country in which the patent infringement takes place. So, for example, an Irish domiciled defendant infringing a French patent may be sued either in France or in Ireland. Although this may lead to a split in proceedings if the defendant challenges the validity of the patent (as validity is a matter for the courts in the country where the patent is registered), where to sue can be an important consideration in multi-jurisdictional disputes. Although not uniquely an Irish point, it means that it is open to a plaintiff to decide on the courts where it is most likely to obtain the fastest and most effective relief.

Enforcing patents in Italy

By **Giovanni Antonio Grippiotti**, Società Italiana Brevetti, Rome

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

Civil and criminal litigation are both available to a patent owner wishing to enforce its rights in Italy. Civil actions are more frequent as judges in civil courts are generally more experienced in patent matters than criminal judges.

An ordinary civil court action may be preceded by a request for a preliminary injunction, which may consist of a request for seizure of the infringing products, an order to stop the infringing activity and an evidence-gathering procedure known as description. Such measures can be required even *ex parte*, ie, without hearing the defendant.

Another option is the seizure of goods suspected of infringing intellectual property rights at customs. This is provided for by a European regulation and the Italian Customs are very proactive in applying it. A seizure means that the importation of the infringing goods is suspended by the Customs Authority on the basis of evidence supplied by the patent holder, which must then bring either a criminal or a civil action, even if in most cases criminal actions are started automatically.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

In 2003 Italy introduced specialised industrial property sections in the courts of Turin, Milan, Venice, Trieste, Genoa, Bologna, Florence, Rome, Naples, Bari, Catania and Palermo. The experience of these courts is increasing due to the fact that they have sole jurisdiction over first instance patent matters. However, quite

often patent litigation is decided on the basis of an assessment rendered by court-appointed counsel, who are more technically experienced than the court itself.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

In principle, it is possible to cross-examine witnesses, but according to the Italian Procedural Code the right to question witnesses lies with the judge only. Each party's attorney must therefore go through the judge to have any questions answered by the witnesses. However, in patent litigation witnesses are rare, while the use of technical briefs is very frequent. These briefs are, of course, drafted by patent counsel.

Usually the judge appoints a technical expert to assist the court. During proceedings a sort of internal technical trial takes place, in which the court-appointed expert exchanges briefs with the parties' patent counsel and renders a concluding assessment which is quite often the basis for the judge's final decision. Patent counsel are subject to no restrictions and may submit any kind of available evidence.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Infringement and invalidity actions can take place simultaneously. It is quite usual for a defendant in a patent infringement action to counterclaim the invalidity of the patent as part of the same proceedings. Likewise, where a declaratory judgment for non-infringement of a patent is sought, the patent holder may counterclaim infringement of the patent.

Each party bears the burden of proving the alleged invalidity or infringement, and may submit any kind of evidence.

5. To what extent is pre-trial discovery

permitted? If it is permitted, how is discovery conducted?

Italy provides for a sort of pre-trial inspection called a description. This is a type of preliminary injunction allowing the plaintiff, upon authorisation by the judge, to inspect the defendant's premises, means or products relating to the infringing activities. The inspection takes place in the presence of the bailiff of the court and *ex parte* experts.

The report of the description, drafted by the bailiff, can be used to obtain another preliminary injunction in the form of a seizure or an inhibitory order, or as evidence in an ordinary court action. Usually these orders are requested *inaudita altera parte* (ie, without hearing the defendant) in order to avoid the risk of the evidence being removed.

During the trial another form of inspection that may be requested is an order for the defendant to produce documents or information concerning the subject matter of the court action. The party requesting this order must show the court that the action is sufficiently grounded. This kind of inspection mostly concerns accounting evidence which may be useful in view of a quantification of damages.

6. To what extent does any doctrine of equivalents apply in an infringement action?

Although the doctrine of equivalents applies in infringement actions in Italy, there is little case law and therefore a finding of equivalence largely depends on the specific circumstances. The criteria adopted by the European Patent Office or by courts in other European Union member states can be proposed where appropriate.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

In principle, the enforcement of patents does not differ depending on their subject matter. However, Italian judges, who normally have no technical background, often have difficulty understanding technical matters, particularly when a case involves sophisticated technical fields such as biotechnology or computer science. Therefore, courts usually appoint technical experts to assist them in the decision-making process.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

Although Italian courts are not bound by the

decisions of other courts, they may be influenced by case law, particularly where several decisions consistently espouse the same opinion. Decisions issued by the Italian Supreme Court (*Corte di Cassazione*) are taken into account, although first and second instance courts have been known to diverge from Supreme Court guidance. Different views among Supreme Court judges are also possible and have resulted in conflicting decisions.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

While Italian courts must take into consideration European Court of Justice decisions, they are not bound by foreign judgments. However, in view of the harmonisation of all basic patent principles throughout Europe, decisions rendered by other European courts in comparable cases can be referred to as case law, and may provide useful arguments, if suitably presented.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

In order to delay proceedings, the defendant may file a separate action seeking a declaration of invalidity of the plaintiff's patent as opposed to counterclaiming in the same proceeding. This action would be filed with the court where the plaintiff has its domicile, which may be a different court.

In such cases, depending on the circumstances, the judge may suspend the infringement proceedings and wait for the decision concerning invalidity. As a countermove, the plaintiff may, depending on the circumstances, request a preliminary injunction in order to anticipate the effects of the final decision or try to concentrate proceedings.

11. How available are preliminary injunctions and how do you get them?

Preliminary injunctions are provided for in Italy. As already explained under point 1, they consist of seizure, an inhibitory order and a description. A preliminary injunction can be obtained in a shorter time than an ordinary court decision and approximately takes two to eight months. This usually depends on whether the judge is able to reach a decision autonomously or needs to appoint a technical expert. In the past, most case law indicated that technical expertise in a preliminary

injunction was inconsistent with the urgency of this kind of provision, but this trend seems to have reversed and technical experts are now quite often involved, particularly in technically sophisticated cases.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

It usually takes two to three years to reach a decision at first instance, depending on the evidence required and on whether a technical expert is appointed.

New rules of procedure were introduced a year ago for proceedings concerning intellectual and industrial property matters, with the aim of reducing their length. Although it is too early to tell whether that aim has been achieved, it is foreseeable that under the new rules courts will be able to issue decisions in one to three years, depending on circumstances.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

Any of the parties involved may file an appeal against the first instance decision before the competent court of appeal, depending on the first instance court's location. The appeal must be filed within 30 days of the serving of the decision by one party on the other or one year from publication of the decision if no serving takes place.

After the decision of the court of appeal, appeals on points of law may be filed with the Supreme Court. First instance decisions are immediately enforceable, even if they have been appealed. However, the court of appeal may suspend the enforcement if a sufficiently persuasive request is submitted.

It normally takes two to three years to reach a decision in appeal proceedings.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

Cost depends on the fees charged by lawyers as well as by patent counsel to the parties and to the court. Any patent litigation is unlikely to cost a party less than Euros 15,000 to 20,000 in preliminary proceedings, and no less than Euros 25,000 to Euros 30,000 through to a decision in ordinary proceedings at the first instance court.

Higher costs are possible, depending on specific circumstances. In complex cases, costs can climb to between Euros 60,000 and Euros 70,000 in preliminary proceedings and

could reach up to Euros 200,000 for the first instance. Higher figures than this are unusual.

The winning party may obtain a sum as recovery of costs incurred, but this will never cover the complete expense. In practice, it is usually possible to recover approximately 35% of the actual costs incurred, while under certain circumstances recoveries in the region of 50% to 60% of costs are possible.

15. Who can represent parties in court? Is specialist representation required?

Only Italian lawyers or foreign lawyers registered with Italian bars are admitted to represent before Italian courts.

Patent attorneys in Italy are not allowed to represent clients before the courts but they can appear as *ex parte* experts. It is advisable to rely on lawyers who specialise in intellectual and industrial property law.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Remedies available in cases of infringement are seizure of the infringing products and of the means related to the infringement activity, inhibitory orders, such as an order to the infringer to immediately stop the infringing activity, publication of the decision, destruction or assignment of infringing goods and damages (the latter only at the end of an ordinary court action).

The burden of proving damages is on the plaintiff, which must also quantify the relevant amount – usually not a simple task. In principle, there are three different criteria for determining damages: loss of profit for the patent holder; income of the infringer; and reasonable royalty. In recent years, it has become quite customary to request the appointment of an expert to help the court assess damages and to rely on an order for the defendant to produce accounting evidence. Italian law does not provide for punitive damages.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

The only alternative to court action is to send a cease and desist letter, which may be effective depending on the circumstances. It should be borne in mind, however, that a cease and desist letter might trigger the recipient to commence an action for invalidity of the patent or file a request for a declaratory judgment.

Enforcing patents in the Netherlands

By **Hans Bottema**, Nederlandsch Octrooibureau, The Hague

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

A holder of a European patent designating the Netherlands can start a court action against unauthorised making, using or selling of the patented product in the Netherlands. Also transit of goods through the Netherlands can be prohibited based on patent infringement.

On 29th April 2006, the EC Enforcement Directive 2004/48/EC should have come into force, but implementation is still pending. As well as changing Article 70 of the Dutch Patents Act of 1995, relating to enforcement, and introducing changes to other intellectual property laws, implementation of the directive will see the Code of Civil Procedure (CVP), which gives the basic framework of enforcement of IP rights, modified as follows:

- To accommodate Article 6 of the directive regarding evidence, a new Article 1019a of the CVP has been drawn up specifying that evidence other than written documents can be ordered to be produced. Violation of confidentiality may be a ground for refusal of the provision.
- Article 7 of the directive on measures for producing evidence is implemented through new Articles 1019b-1019d CVP. The new articles provide for physical seizure of the infringing goods, but also for a descriptive seizure or the taking of samples of infringing goods or documents and tools relating to such goods. This may be ordered in *ex parte* proceedings.
- Article 9 of the directive relating to provisional and precautionary measures

is implemented in new Article 1019e CVP providing for an *ex parte* injunction where there is a chance of irreparable damage to the plaintiff.

- Article 14, relating to legal costs, is implemented in new Article 1019h CVP, which states that the unsuccessful party in a case must bear the other party's reasonable and proportionate costs, instead of the fixed rates formerly prevailing. This may increase the risk for smaller companies exerting their Dutch patent rights against larger companies that are able to afford extensive legal assistance in IP proceedings.
- Article 260 of the old CVP, implementing Article 50 under 6 of the TRIPs agreement, is changed to new Article 1019i CPV although its content remains unchanged. For provisional measures to remain effective, proceedings on the merit should be commenced at the latest within 31 days.

Contributory infringement can be acted against for goods relating to an essential element of the invention, provided that they are both intended and suitable for an infringing use within the Netherlands.

In court proceedings not only injunctions, but also lost profits and damages can be claimed, the latter after the alleged infringer knew or had "reasonable grounds to know" about the infringing nature of its acts (cf Article 45 TRIPs), or in any case after 30 days from the date on which the infringing party is put on notice of the infringing nature of its acts. Serving a writ in which the infringing act is clearly set out serves as a trigger for the 30-day notice period.

Disputes can be adjudicated in summary preliminary injunction proceedings, which may be concluded within the timeframe of two months, or in proceedings on the merits with an accelerated regime, resulting in a verdict in a period just short of a year.

Parties can also agree on alternative dispute resolution to resolve their disputes, such as arbitration under the Rules of the Netherlands Arbitration Institute.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

Patent cases are dealt with exclusively by an expert court (the district court) of first instance and in appeal (the court of appeals) residing in The Hague.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Witnesses are not cross-examined at trial. A court can order a hearing of witnesses at the request of one of the parties or in an interlocutory decision. The court will mainly rely on written evidence.

There are no restrictions on the use of evidence from experts, although certain pieces of information during trial may be labelled confidential and may be accessible only to an independent expert and not directly to the parties.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Infringement and invalidity are dealt with in the same proceedings. The level of proof for infringement is a level of beyond reasonable doubt. For invalidity, lack of novelty or lack of inventive step can be based on public prior use, supported by witness statements in the form of written declarations. Parties to the proceedings or employees of parties to the proceedings may also serve as witnesses.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Pre-trial discovery is not available. In case of alleged infringement of a process claim, Dutch law provides for a reversal of the burden of proof (to the defendant) where: (1) the product directly resulting from the patented process is a novel product; or (2) the plaintiff has made a credible case of infringement and cannot submit more evidence.

6. To what extent does any doctrine of equivalents apply in an infringement action?

In infringement actions the doctrine of equivalents is applied in the sense of the tripartite test of essentially the same means

for performing essentially the same function in essentially the same way, or the insubstantial differences test (in chemical cases). In crowded prior art fields, the courts will adhere to a more literal claim interpretation.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Enforcement of biotech patents and of computer and software-related patents is well provided for. These generally complex cases are often less suitable for dealing with in summary proceedings and may be allowed only in proceedings on the merits.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

High court decisions are authoritative and are followed by the lower courts.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

The Dutch courts do take into account verdicts of foreign courts that have dealt with the equivalent patent, but will form their own opinion based on all facts. Dutch cross-border injunctions based on the spider-in-the-web doctrine may be affected by the recent ECJ decision in *Roche v Primus* that this Dutch cross-border practice is in contravention of the Brussels Convention.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

There are very few options open for the plaintiff or defendant to delay proceedings in the accelerated proceedings (which are almost always used). At the start of the proceedings a time schedule is set for submission of briefs and documents with no extensions.

11. How available are preliminary injunctions and how do you get them?

A preliminary injunction is easily available and the required urgency is almost always presumed.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

Disputes can be adjudicated in summary preliminary injunction proceedings, which may be concluded within the timeframe of

two months or, in proceedings on the merit with an accelerated regime, resulting in a verdict in a period just short of a year.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

Appeals may be filed from decisions of the district court at first instance to the Court of Appeals and from there to the Supreme Court. The latter proceedings can be based only on procedural violations or violation of the law; no factual re-assessment of the case is undertaken. The appeal process before the Court of Appeals and before the Supreme Court may take about one and a half years.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

In first instance, costs of litigation may amount to between Euros 30,000 and Euros 100,000.

15. Who can represent parties in court?

The parties are represented by a lawyer, mostly in combination with a patent attorney who has a right to plead, which is often used to elucidate the technical side of the case. Detention by the customs authorities of goods suspected of infringing an intellectual property right under Council Regulation EC 1383/2003 can be requested in an administrative procedure before the customs authorities without legal representation being required. Within 10 days of a seizure, a period that is extendable by 10 days, legal proceedings requiring representation by a lawyer need to be commenced.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

The injunction is the most popular remedy for infringement. Damages may be awarded and submission of sales figures may be ordered for calculating lost profits. Punitive damages are not available.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Alternatives to litigation are mediation or arbitration.

18. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

When litigating a Dutch patent (either EP/NL or a Dutch national registration patent which has been granted without substantive examination), the patent may be partially invalidated in view of lack of novelty or inventive step. In the 1996 case of *Spiro Research v Flamco*, the High Court ruled that in case of invalidity a new and valid claim may be formulated only when it is clear to the skilled person where the scope of protection shall lie and that a more limited patent is obtained which is not different from the invalidated patent. This differs from the interpretation the European Patent Office gives under Article 123 (2) EPC relating to amendments of a patent application not being allowable in case of extension of subject matter. In *Parteuropa v Fokker*, the Dutch Court of Appeal in early 2005 ruled that in the absence of validity of the main claim no partial validity was allowed as to the remaining sub-claims. This is at variance with the *Spiro Flamco* doctrine. The same ruling may be expected in cases of a voluntary restriction of a Dutch patent by the patentee filing new claims.

19. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

The Netherlands has signed up to both the London Protocol and the Litigation Agreement. The state law changing article 52.1 of the Dutch Patents Act of 1995 was published on 17th January 2006. This now states that European patents designating the Netherlands must be translated into Dutch or English. Where an English translation is submitted, the claims need to be translated into the Dutch language.

Enforcing patents in Poland

By **Katarzyna Karcz** and **Malgorzata Zielinska-Lazarowicz**, Patpol, Warsaw

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

A holder of a European patent in which Poland has been designated, and which is effective in Poland, enjoys basically the same rights as a holder of a patent issued by the Polish Patent Office under the national route. The exclusive rights may be enforced by the patent holder or they may be assigned to third parties.

In cases of infringement, claims may be lodged with a civil court. Namely, the patent holder may lodge a claim demanding that the alleged infringer cease the infringing activities and redress the consequences of infringement, as well as surrender unlawfully obtained profits and compensate for damages. Moreover, at the patent holder's request, the alleged infringer may also be required to publish an appropriate statement in the press and, if the infringement was wilful, to pay an adequate amount of money to a social organisation enhancing inventive activity.

Damages resulting from patent infringement may be claimed after the grant of the patent. However, damages may be collected from a date prior to the grant of the patent, provided that information concerning availability of the Polish translation of the patent claims as filed has been published in the *Bulletin* of the Polish Patent Office (PPO). Such information (which follows filing of the translation of the claims with the PPO) may be published only at the explicit request of the applicant and after the European publication of the application. It should be noted that although the publication of the above information in the *Bulletin* of the PPO is voluntary, it has a

significant effect upon the scope of protection covered by the European patent.

When the alleged infringer has been notified of the claim of infringement, the patent holder may collect damages from the date of notification. The aforesaid makes further infringement wilful. The European patent holder may also claim a preliminary injunction.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

There are no specialist patent courts in Poland. Common civil courts handle patent infringement matters and the judges adjudicating patent infringement, cases have no technical training. Therefore, the court is allowed to appoint independent experts to submit written or oral opinions when specialised knowledge is necessary. In particular, an expert may be asked to compare the invention covered by the patent with the infringing product or other infringing activities of the defendant so that the court can estimate whether the acts of the alleged infringer fall within the scope of the patent protection.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

In civil proceedings regarding patent infringement all and any evidence must be indicated and, if possible, produced by the party relying on the facts which have to be proved. As a rule, the court does not take into consideration any evidence *ex officio*. In a lawsuit between business entities, the plaintiff is obliged to indicate all the relevant evidence in the statement of claim. If this is not done, the right to submit additional evidence during the proceedings before the court is generally lost. The plaintiff is

allowed to submit further evidence during the course of the court proceedings only on condition that the evidence is unlikely to have been known at the moment of bringing the action before the court, or where the evidence relevant to the case occurred after the action had started.

Each party in a lawsuit is entitled to submit written evidence, such as private or official documents or written opinions of private experts (eg, experts who were not appointed by the court). Opinions of private experts are regarded as documents not issued by official bodies.

The situation of an expert appointed by the court is different. The choice of the expert depends first of all on the character and complexity of the matter in hand. The appointed expert may be chosen from among registered Polish patent attorneys or other highly qualified specialists in the relevant field. The court is also entitled to expertise from a research or scientific institute. In patent infringement trials, the expert should aim to explain the technical aspects of the invention.

Cross-examination of witnesses is also permitted.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Infringement and validity cases are dealt with in Poland by different authorities: infringement is handled by common civil courts, while invalidation is the province of the Litigation Division of the Polish Patent Office. The decisions of the Patent Office are subject to appeals to administrative courts. Under some circumstances, the issues regarding a patent's validity may influence the infringement proceedings. If the defendant (alleged infringer) claims invalidity of the patent at issue, the court may suspend the infringement proceedings until the invalidity case is resolved.

The level of proof necessary in infringement cases results from the general rules of civil procedure, which means that a party is generally entitled to request oral examination of witnesses, to appoint experts, to produce documents (private or official) and/or to demonstrate samples, if necessary. All and any evidence should prove the circumstances relevant to the lodged demands.

The evidence allowable in invalidity proceedings is generally comparable to the evidence in infringement proceedings. The party demanding invalidation of a patent is

obliged to prove its legal interest as well as the claimed non-patentability of the invention in question. If it comes to an appeal, the administrative courts examining a decision of the Patent Office issued in an invalidity proceeding will generally base their decision on the evidence collected by the Patent Office. But where there are doubts regarding evidence essential to the case, the court may examine additional evidence (only documents are permissible).

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Where both litigating parties (the patent holder and the alleged infringer) are business entities, the patent holder is obliged to send a cease and desist letter to the alleged infringer before filing the statement of claim with the court. A cease and desist letter (so-called warning letter) is a final invitation to resolve the claim amicably through settlement. A copy of the cease and desist letter along with the alleged infringer's reply should be attached to the statement of claim lodged with the court.

The warning letter shall, in particular, indicate the right of the patent holder to use the invention within the territory of Poland, as well as the allegedly infringing activities. The warning letter is treated as evidence of the plaintiff's goodwill to settle the matter outside court. If discovery of evidence is requested by the infringer to prove the holder's claims, it should be indicated by the patent holder before the trial, on pain of charging the plaintiff with extra procedural fees for the lack of goodwill to settle the dispute amicably.

During the court proceedings the court may summon any person to submit any documents relevant to the proceedings which are in that person's possession, unless the document contains state secrets. If any party refers to trade books, the court may require the surrender of those books to the court.

The adaptation of Polish law to European Directive 2004/48/EC as of 29th April 2004 on the enforcement of intellectual property rights is expected to bring some new discovery options to IP matters.

6. To what extent does any doctrine of equivalents apply in an infringement action?

According to Polish patent law, particular emphasis should be placed on clear and unequivocal wording of patent claims. Such strict interpretation of the patent claims is not compatible with the concept of

interpretation of patent exclusivity set out in the Protocol on interpretation of Article 69 of the European Patent Convention (EPC). Bearing in mind that the EPC is binding in Poland, it should be expected that the practice of the Polish Patent Office and the courts will be consistent with the practice resulting from the EPC.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Enforcement of software patents may be difficult because the Polish Patent Office is reluctant to grant protection to those patents and is frequently inclined to invalidate them. As regards biotech patents, enforcement is usually more complicated because of the specific nature of the subject matter.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

As a rule, courts are not bound by the opinions and decisions of other courts which have handed down decisions in similar cases. The two exceptions are the decisions of the Supreme Court and the Supreme Administrative Court. In practice, opinions and decisions of other courts are frequently taken into consideration by courts when judging similar cases. Coherent and uniform court decisions guarantee certainty and reliability of the law.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

The Polish courts are generally not bound by the reasoning of foreign courts that have tried similar cases. However, they may draw conclusions from foreign courts' judgments when solving similar legal problems that are not precisely regulated by Polish law. The individual character and particular provisions of foreign legal systems, as well as the background of a specific case, have to be taken into account before taking the foreign reasoning into consideration.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

The basic way of delaying a court case is to start litigation proceedings before the Polish Patent Office claiming invalidation of the patent in question. As two separate

authorities hear the two cases, starting invalidation proceedings often causes the suspension of the infringement proceedings until validity is decided. The plaintiff can counter such delaying tactics by, for example, trying to convince the court that the invalidation claim is inappropriate or that it constitutes a misuse of law.

Another way of delaying or even blocking an infringement case in the court is to anticipate the infringement claim by filing a claim requesting a finding that the alleged infringer is exploiting its own rights and consequently is not infringing. If the supposed plaintiff does not file its claim in time, the case charging infringement will be unallowable by statute until the first case is resolved. One way to avoid such a situation is to file a preliminary injunction or the infringement claim as soon as possible (after sending a cease and desist letter first).

11. How available are preliminary injunctions and how do you get them?

A patent holder is entitled to file a request for a preliminary injunction before initiating court proceedings (before lodging a claim to the court), as well as simultaneously with those proceedings. If the request is filed before initiating the court proceedings, the court, upon issuing a decision to grant the preliminary injunction, will appoint a two-week deadline for the filing of the statement of claim.

If the plaintiff misses the deadline, the court will reverse the preliminary injunction. In order to obtain a preliminary injunction, it is necessary to prove the legal interest in requesting the preliminary injunction, justify the grounds for filing the request and indicate the way in which the injunction should take place (eg, seizure of goods in the infringer's warehouse, ban on further sale, etc). The patent holder has to prove its patent rights with an official document and should also prove that the exclusive rights have been infringed.

Preliminary injunctions should not aim to satisfy the claims raised by the plaintiff, but in practice they often lead to a court order in which the alleged infringer is requested to stop its activities under the sanction of compulsory enforcement of the said order.

An important consequence resulting from claiming a preliminary injunction is that if the plaintiff loses the lawsuit or decides to withdraw the court action before the verdict, the alleged infringer is entitled to demand compensation for the damages arising from the preliminary injunction order.

12. How long does it take to get a decision at first instance?

Patent infringement proceedings in Poland can last from approximately three to five years, depending on the complexity of the case, the strategy undertaken by the parties and the number of cases at the court pending examination. However, there is no general rule and in some cases it may take longer to complete the proceedings.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

A decision of the court of first instance is subject to an appeal to the court of second instance. The appeal should be filed with the court that issued the initial judgment within two weeks of the date of delivery of the reasoned court decision to the party.

The court of second instance examines all substantive and procedural issues, the breach of which may have provided grounds for the appeal. It is worth emphasising that the court of appeal judges the case within the limits of appeal and only nullity of the appealed decision is considered *ex officio*. Therefore, broadening the claims or adding new claims once the appeal has been filed is not allowed.

The court of second instance judges the cases on the basis of the evidence collected both in the first instance proceedings and in the appeal proceedings. However, the facts and evidence which were available to the party during the first instance proceedings may not be taken into consideration in the appeal proceedings unless they are specifically relevant to the appeal. It may take a few years before a verdict in the appeal proceedings is issued.

Under some circumstances explicitly provided for by law, a decision of the court of second instance may be subject to a cassation pleading to the Supreme Court. It is an extraordinary legal remedy and may be based only on breach of substantive law involving incorrect interpretation or incorrect application of such law or on breach of procedural provisions, which should have had relevant effect on the result of the case. The appeal should be filed within a fixed term of two months from the date of delivery of the appeal decision.

14. To take a case through to a first instance decision, what level of costs should a party to litigation expect to incur?

It is difficult to anticipate the range of costs

associated with infringement proceedings. The potential costs depend on the complexity of the matter and the value of the object of the litigation. The costs of representation, or the costs connected with entering and handling the court proceedings, as well as the costs of preparing the relevant documents, have to be taken into account. As a rule, the losing party is burdened with the costs of the court proceedings.

15. Who can represent parties in court? Is specialist representation required?

As a rule, the parties in patent infringement cases may be represented in court by professional representatives, ie, lawyers (attorneys or legal counsel) or by patent attorneys. A legal entity may also be represented by an employee.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

A patent holder or any other entitled person (ie, an exclusive licensee entered onto the patent register) whose patent has been infringed may demand cessation of the infringement, redress of its consequences and surrender of unlawfully obtained profits as well as compensation for damages. At the patent holder's request, the patent infringer may also be required to publish an appropriate statement in the press and, if the infringement was wilful, to pay an adequate amount of money to a social organisation supporting inventive activity.

The responsibility for compensation for damages applies only where the infringement was wilful. Compensation for damages includes the actual lost earnings as well as any profits which the patent holder would have achieved if the infringement had not occurred. A readily applicable method of measuring the damages is licence analogy. Thus, lost profits can reside in the possible lost royalties and/or in the decline in sales. It is worth emphasising that the plaintiff has to prove the direct causal relationship between the damage that it has suffered and the infringing activities.

The monetary remedies have more of a compensatory than a punitive character. Furthermore, anyone who appropriates someone else's authorship, misleads another party regarding authorship of an invention or otherwise infringes the rights of the creator to an inventive project shall be liable to a fine, limitation of freedom or imprisonment for a period of up to one year.

A person committing such an act for material or personal profit shall be liable to imprisonment for a period of up to two years.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Alternative means for resolution of patent disputes are available, but not commonly used in Poland (arbitration and mediation).

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is that it will do so?

Poland has signed neither the London Protocol nor the European Patent Litigation Agreement yet.

19. Are there any features of the enforcement system in your jurisdiction that you would like to point out?

The main feature of the patent enforcement proceeding is the so-called rule of evidence preclusion. Pursuant to this rule, it is necessary for the plaintiff to mention in the statement of claim all the statements relevant to the case and attach all evidence to support those statements, under the penalty of being precluded from serving the court with further evidentiary materials after the proceedings have started.

Enforcing patents in the Slovak Republic

By **Andrea Povazanova**, Cermák Horejs Myslil a spol, Bratislava

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

According to Article 63 para 1 of the Slovak Act No 435/2001 Coll on Patents, Supplementary Protection Certificates and on Amendment of Some Acts as Amended (hereinafter referred to as the Patent Act), a European patent shall have the same effects as a patent granted by the Slovak Patent Office. Thus, the owner of a European patent has the exclusive right to use the invention, to authorise others to use the invention, to assign the patent to others or to abandon the patent. In cases of unauthorised interference with the patent rights, the patent owner is entitled to claim that the infringement or jeopardising of its patent right be prohibited and the consequences of infringement removed. The patent owner is also entitled to request that the party that jeopardises or infringes its rights submit data relating to the origin of the product and the circumstances of its placement on the market; and to claim compensation for damage caused, including lost profits and adequate satisfaction, which may be represented by pecuniary compensation. The court may issue a preliminary injunction upon the request of the patent owner.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

There are no special patent courts in the Slovak Republic. However, according to current legislation, three district courts – in Bratislava, Banská Bystrica and Kosice – are entitled to decide cases concerning

intellectual property law, including unfair competition cases, as the courts of first instance. Consequently, the regional courts in Bratislava, Banská Bystrica and Kosice are the courts of second instance. Due to the fact that patent cases are heard by Slovak courts rather rarely, the level of expertise of the judges is average.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Court proceedings in the Slovak Republic are based on written evidence supported by witness statements. Witnesses may be cross-examined by the other party at trial. There are no restrictions concerning the use of evidence from experts. All evidence must be submitted by the relevant party in the court proceedings before the issuing of the court decision.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Courts deal with any infringement of patent rights and its consequences. But only the Slovak Patent Office decides on revocation (invalidity) of a patent. It is very usual that in cases of infringement of patent rights the defendant files a request for revocation of the patent and the court then suspends infringement proceedings until the Patent Office decides on the revocation request.

The patent owner should submit in the infringement proceedings before the court (if appropriate) a sample of the product manufactured by the patent owner and a sample of the product, which is manufactured by the infringing person, including the proof that both products are available in the Slovak market, ie, sale receipts.

In invalidation proceedings before the Patent Office, the plaintiff has to prove that: (a) requirements for granting of a patent have

not been met; (b) the invention is not disclosed and described in the patent so clearly and so fully that it can be carried out by a person skilled in the art; (c) the subject matter of the patent exceeds the specification as filed; (d) the scope of protection following from the patent is too broad; or (e) the owner does not have the right to the patent. Therefore, the evidence in invalidation proceedings is rather specialising consisting of quoting a number of registered patents, books, dictionaries and prior art in general.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

According to the Slovak law, there is no pre-trial discovery. Evidence or documents are discovered within an oral hearing.

6. To what extent does any doctrine of equivalents apply in an infringement action?

Slovak courts have not yet applied a doctrine of equivalents in an infringement action based on patent rights. The doctrine of equivalents has been applied in infringement actions based on unfair competition provisions of the Slovak Commercial Code. In such cases, argument based on patent rights is often combined with unfair competition provisions.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

Software-related, biotech and pharmaceutical patents are usually more difficult to enforce than technical patents due to the difficulty concerning the comparison of the solution used by the defendant and the solution protected by the patent. This applies also to patented methods of manufacturing.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

According to the Slovak Constitution, judges are bound by the Constitution, constitutional acts, international treaties and by national legislation. After the accession of the Slovak Republic to the European Union, European law is applicable in the Slovak Republic as well. Decisions and opinions of other courts are not binding, although they may be taken into account if the court has to decide the same or similar matter.

9. To what extent are courts willing to consider the reasoning given by foreign

courts that have handed down decisions in similar cases?

It is possible to file decisions or reasoning given by foreign courts with Slovak courts. However, these are not binding. Such foreign decisions or reasoning may inspire the Slovak judges in some cases, however.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

In patent infringement actions a defendant may file a revocation request, which may substantially delay a case. If the court decides to suspend the case until the Patent Office issues a decision on the revocation request, the plaintiff's position is difficult. The defendant may also propose to the court to ask the ECJ for a preliminary ruling if EU law is applicable in the matter. The plaintiff may challenge each request of the opposing party and finally the court decides.

11. How available are preliminary injunctions and how do you get them?

It is possible to file with the court a request for preliminary injunction. The court has to decide in commercial matters within 30 days of the date of its filing.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

It takes approximately one to one and a half years to get a decision at first instance. There is no legal possibility of expediting the process.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The defeated party may file an appeal against the first instance's decision within 15 days as of the day of its delivery. In patent infringement proceedings, the appeal should be filed with the regional court in Bratislava, Banská Bystrica or Kosice, according to the local competency. The defeated party may appeal the whole decision or only a part thereof. It is not possible to appeal against the decision's reasoning only. The defeated party has to indicate against which decision the appeal is filed, the extent of the appeal, why the first instance decision or the precedent proceedings were wrong and how the case should be decided. The appeal process takes one and a half to two years.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

The costs of first instance proceedings depend on the complexity of the matter. It usually takes at least 20 hours of lawyers' work to take a case through to a first instance decision. The level of cost increases if any expert opinion is drafted and submitted to the court. Court fees may be considerably high if extensive damages are requested.

15. Who can represent parties in court?

The patent owner may defend its rights in person, but parties may be represented by any individual, attorney at law, notary public and, except for appeals, also by a patent attorney. Generally, there is no compulsory representation before the first and second instance courts, nevertheless a representation by an IP litigation specialist is recommended.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

For a full discussion of this, see the answer to the first question. The remedy called "adequate satisfaction" (see answer to first question above) can be considered as punitive damages. It is intended to indemnify the aggrieved party for any harm that cannot be calculated as damages.

Enforcing patents in Spain

By **Miguel Vidal-Quadras** and **Oriol Ramon Sauri**, Amat i Vidal-Quadras Advocats

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

In the Kingdom of Spain, European patent holders may bring civil court action against any possible infringers of their rights. In exceptional circumstances, if a crime has actually been committed, criminal action may be brought. The administrative courts cannot be petitioned to revoke a patent, as the civil courts are competent for all proceedings related to patents. The Spanish courts also hold exclusive jurisdiction to hear cases related to patent rights granted for Spain. Action may either be brought in the court with jurisdiction in the territory where the defendant is resident or in the competent court in the territory where the infringement had been committed.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

Since September 2004, there have been specific courts that specialise in certain commercial matters, including intellectual property rights and unfair competition. The main courts where most of these kinds of cases are heard are in Barcelona and Madrid. They have increasingly specific knowledge of patents. There is no body of judicial technical experts; neither are judges specialists from a technical point of view or supported by court technical specialists. However, it is normal practice for them to agree to a request by the parties in litigation for an independent expert to be appointed to issue an opinion on the questions the case concerns.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Although it is not normal practice, Spanish procedural laws do allow witnesses, the parties or court-appointed experts to be cross-examined at the request of the parties or the judge, providing the latter deems it appropriate.

Evidence submitted in patent infringement proceedings is initially based on the technical opinions provided by the parties' expert advisers. These are classed as court-recognised experts and must swear on oath to perform their duties objectively and impartially, taking into account everything that might be beneficial or prejudicial to either party. The technical opinions usually include the documents required to prove that an infringement has been committed, such as laboratory analysis or voice, image or data recordings. Experts may attach any exhibits or evidence to their reports that they consider necessary to support their statements. Any relevant documents must be translated into Spanish.

During the hearing, the parties, witnesses and experts are examined and questioned. The judge may intervene when he/she considers it necessary. As the cross-examination is oral and takes place in front of the judge, good preparation is important.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

A common defence in infringement cases tends to involve alleging that the patent is invalid. This often also tends to be useful to show the judge where the invention stands in the state of the art, while also presenting the technical contribution made by it in order to present the defence against the infringement.

Invalidity may be alleged either as an objection, in order to call for the claim to be

dismissed due to the patent being invalid, or else by means of bringing a counter-claim. If this is accepted by the court, the Spanish part of the patent will be declared invalid, and the patent's registration entry in the Spanish Patent and Trademark Office will be cancelled, with the consequent effect for third parties.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

There is a specific procedure in Spain to determine whether an infringement may have been committed called *diligencias de comprobación de hechos*, court inspection proceedings to verify a possible infringement *in situ*. This basically consists of the plaintiff being able to petition the court, when there are signs that an infringement has been committed for which it lacks proof, to appoint one or more experts (normally one technical specialist and one IT specialist) to assist the judge in the *diligencias*. The procedure is carried out at the facilities of the potentially infringing party to find out whether the latter has actually infringed a patent right. If so, the necessary documents are drawn up and a copy is provided to the party that requested the procedure so that it can bring the appropriate patent infringement claim.

Provided there is enough evidence of the infringement, the court may also be petitioned to allow the infringing party to be cross-examined prior to the initiation of an infringement case about its suppliers, customers and distribution channels, as well as the product quantities, sales and the product in the market. A petition may also be made for commercial, customs, accounting and financial documents to be provided in order to prepare the case. This measure is carried out before the party concerned is served notice.

6. To what extent does any doctrine of equivalents apply in an infringement action?

The doctrine of equivalents is starting to be routinely accepted by the courts. The courts (such as the Provincial Court of Barcelona) now even quote landmark judgments such as *Catnic*, *Improver* and *Formstein*. Some judgments have also taken into account the patent's registration background in determining the specific scope of a particular patent right.

It is worth pointing out that the appeal courts currently tend to lean more towards technical issues and to assess judicially the statements made by experts. This did not use to be the case, which gave rise to a

Supreme Court doctrine according to which questions of validity or infringement were technical questions that could not be taken into account in an appeal for annulment by a higher court (cassation).

In recent years, the doctrine of equivalents has been replacing the traditional approach taken by the Supreme Court, based on the essential nature of a patent's elements. This has given rise to the possibility of disregarding the elements of the claim considered secondary by the expert, generally the court-appointed expert.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

There are no past cases from which statistics can be produced. The Spanish courts have not ruled on certain issues that are currently hot topics in some European countries and the United States.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

The Spanish courts and parties in litigation are increasingly referring to judgments laid down by other European courts concerning the infringement or invalidity of the same patent. Background such as this tends to be accepted as a relevant exhibit by the courts. However, the parties must prove to the Spanish court that the facts put before it are the same as those on which the foreign court based its decision.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

The courts indirectly take into account the arguments put forward in foreign decisions in their own judgments, albeit by taking them for their own. This is quite normal practice, as the judgment handed down by the Spanish court is the one that will be submitted to the appeal court. Therefore, just as in any other kind of proceedings, the parties must be aware of the need to allege and prove whether facts may be required to convince the court, without relying on a foreign judgment as being sufficient to win the case in Spain.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

The terms stipulated by Spanish law for the

parties' actions are very strict. Along with their respective initial documents, the parties must provide all the evidence they have available. The courts do not allow documents or experts' opinions to be provided later on if they could have been submitted or announced previously. However, in the past, it was common practice to employ delaying tactics based on procedural rules. Now it is not quite so easy for the defendant to interrupt court proceedings through procedural strategies. Adjournment of a hearing may be petitioned if, for example, witnesses or experts will be unable to attend. However, this always runs the risk that it could harm the party who requests it, if the judge decides to go ahead without cross-examining someone.

11. How available are preliminary injunctions and how do you get them?

Preliminary injunctions may be requested, either before bringing the infringement claim or together with the claim. They must be requested for urgent reasons and there must be *prima facie* justification that an infringement has been committed and that there will be costly consequences for the plaintiff if the injunction is not ordered. The rightholder must also prove that it is making use of the patent or that serious and effective preparations are being made for that purpose. The parties are usually summoned to a hearing. After hearing the arguments the parties put forward, the judge will decide whether or not the injunction should be granted. If it is granted, the defendant may request suspension of it by offering a counter-guarantee.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

Depending on the courts involved and their workload, first instance proceedings normally last between 12 and 18 months. The main circumstances that may hold up a case are bringing a claim against a party resident abroad, needing to provide technical expert evidence, the complexity of certain evidence (such as carrying out trials, analyses and reproductions, or inspections in plants in Spain or abroad) or the number of experts or witnesses and their nationality.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

An appeal is quite normal in patent cases

and there are no special requirements. The party against which the first instance judgment is made merely needs to serve notice that it does not agree with the decision within a term of five days after the ruling and must then submit the reason for its appeal within a 20-day term granted by the court. The appeal court will review the judgment and decide the case having assessed the facts available to the court of first instance and whether its judgment was in accordance with the law. The appeal ruling usually takes one to two years, depending on the court hearing the appeal and its workload, and whether the court decides, exceptionally, to allow evidence that had been denied by the court of first instance.

In exceptional circumstances, an appeal for annulment by a higher court (cassation) may be brought against the appeal court's decision. If the hearing of the appeal is accepted, the Supreme Court will rule on whether to accept the appeal within a term of about two or three years and will lay down its judgment on the annulment within five years. The Supreme Court is currently endeavouring to shorten the time taken to lay down its judgments, so it is refusing to hear many appeals for annulment.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

Although the cost of court proceedings depends on the complexity of the case, it can be estimated at between Euros 30,000 and Euros 100,000 on average.

15. Who can represent parties in court? Is specialist representation required?

The parties are represented in legal proceedings in Spain by their lawyers and formally by a court liaison officer (*procurador* in Spanish). The latter is a legal professional who acts as an intermediary between the court and the party's lawyer. The lawyer does not need to have any specific technical qualifications. However he/she is often a specialist in patent law who is familiar with the subject matter.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Legal actions may be brought to cease and desist from the infringement, seize or destroy the infringing products or machinery and moulds exclusively used for that purpose, prohibit the recommencing of the infringing

actions and pay compensation for damages and losses. Damages and losses are determined by calculating the profits earned by the defendant as a result of the infringement, the profits that the plaintiff has not obtained or the cost of a possible licence. Compensation can also be included for the harm caused to the prestige of the invention if this actually took place and can be proven (eg, inadequate or defective presentation of the product in the market). Spanish law has recently also included the possibility of claiming compensation for moral damages. There is no reference in Spanish law to the possibility of claiming punitive damages in the same sense as US law.

In addition, in Spain, as in other European countries, a claim may be brought against actions that have contributed to the infringement, provided those who contributed to the infringement were aware that the means delivered to the infringing party were to be used to manufacture the infringing products.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

This may happen only if the parties agree to go to arbitration or conciliation, which does not usually take place unless there is a special reason (eg, both parties' needs for discretion and confidentiality regarding the proceedings) or in the case of agreements in which there is an arbitration clause accepted by both parties.

18. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

One should particularly take into account that until 7th October 1992, chemical and pharmaceutical products could not be patented in Spain. For patents filed before this date, which have new products as their subject matter, the holder may ask the courts to consider the benefit of inverting the burden of the proof, placing it on the defendant and presuming, unless otherwise proven, that the patented process is being used.

Enforcing patents in Sweden

By **Helena Östblom**, Zacco Sweden, Stockholm

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

Sweden has been a member of the European Patent Convention since 1978, which means that a significant proportion of the patents that are granted in the country today are European patents. Designating Sweden through a European patent application results in a patent with the same legal status and scope of protection as a national Swedish patent. Enforcing a European patent in Sweden is, from a litigation perspective, therefore, very similar to enforcing a national patent. There are three ways of enforcing a patent in Sweden: through litigation, arbitration or a settlement between the parties.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

The District Court of Stockholm (first instance), The Svea Court of Appeal (second instance) and the Supreme Court (final instance) are exclusive venues for patent proceedings. The courts have technical experts within the different technical fields and these sit as judges in patent cases. A high level of expertise can thus be expected from the courts. In some very specialised fields of technology, for example, advanced biotech, the courts' level of expertise might be limited. In such cases, litigation is likely to be rather time consuming and will demand a significant amount of work and expertise from the parties and the attorneys.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on

written evidence? Are there restrictions on the use of evidence from experts?

At the main hearing it is possible to cross-examine witnesses. It is also possible for the judge to ask the witnesses questions. Written evidence is allowed and is used to a great extent, but written statements of witnesses are in principle not allowed. There are no restrictions on the use of written formal reports from experts and it is common for the experts also to be examined at the trial.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

In some cases, one of the parties may wish to declare a patent invalid during the course of, for example, a trial for infringement. In this respect, it should be noted that invalidity cannot be used as a counterclaim in an infringement trial. If the defendant in an infringement trial wishes to claim invalidity of the patent, a separate writ of summons with a claim for cancellation of the patent has to be filed. The two cases are thereafter in principle handled and decided jointly by the court.

The level of proof to demonstrate that a patent should be declared null is rather high in Sweden and the court demands that the plaintiff be able to prove beyond doubt, through written evidence, that the invention does not meet the conditions of patentability (such as lack of novelty and/or lack of inventive step). Usually this written evidence - such as dictionaries, books and quotations of prior art - is combined with witnesses and formal reports from experts.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

The holder of a patent may request that an infringement investigation be conducted in order to collect evidence of the infringement and the extent of the infringement. A claim

for an investigation is filed at the competent court and is carried out by the enforcement agency. The plaintiff can be present at the investigation but is not allowed to take an active role – it can only respond to questions from the enforcement officers. The plaintiff has to provide security for the possible damages that might be caused to the alleged infringer due to the investigation.

6. To what extent does any doctrine of equivalents apply in an infringement action?

Swedish courts may apply the doctrine of equivalents in patent cases. To what extent and, in particular, how generously this doctrine is used by the courts is difficult to say. There are very few patent cases in Sweden each year and practice is not easy to foresee. In general terms, however, the application of the doctrine of equivalents has in recent years become stricter.

7. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

For international litigators, it may be worthwhile knowing that Swedish courts are not bound by decisions of other Swedish courts, except with regard to the Supreme Court. This court sets precedents that all lower courts in Sweden are bound to follow.

8. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

The only circumstances under which a Swedish court will be bound by a decision of a non-Swedish court are when a case has been referred from Sweden to the European Court of Justice. However, judges in patent cases may be prepared to look at the decisions of foreign courts that have tried similar matters and will also look at decisions from the EPO.

9. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

Parties in litigation may often, for strategic or economic reasons, seek to delay the trial proceeding. There are a number of ways to do this in Sweden; for example, requests for extension of time to respond, late filing of evidence, filing of extensive evidence and arguments and unclear statements tend to delay cases. These are all informal ways of delaying the proceedings. As in many jurisdictions, there are no formal ways of achieving a delay and consequently it

is difficult for a plaintiff to counter delaying tactics.

10. How available are preliminary injunctions and how do you get them?

Preliminary injunctions are a relevant option for many parties, not just for legal purposes but also as an efficient way to persuade a hesitant counterparty to negotiate. In short, the procedure for requesting a preliminary injunction in Sweden can be described as follows. Requests for preliminary injunction can be filed at the time of filing the writ of summons, as well as before the writ of summons or later on in the litigation. If the plaintiff shows that it is probable that an infringement is occurring and that one may reasonably fear that the defendant will, by continuing the infringement, reduce the value of the exclusive right to the patent, the court may impose a prohibition under penalty of fine for the period until the case has been finally decided or another decision has been made. Together with the request for a preliminary injunction, the plaintiff has to file security at the court for the damages that may be caused to the defendant due to the injunction if the court later judges that no infringement has occurred. Before a prohibition is imposed, the defendant has the opportunity to comment on the request for the injunction, unless a delay would involve a risk for further damages to the plaintiff.

11. How long does it take to get a decision at first instance? Is it possible to expedite this process?

Patent proceedings in Sweden are a relatively long process. It takes about one to three years to get a decision in the first instance. In principle, it is not possible to expedite the process (except through a preliminary injunction).

12. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The decision from the district court may be appealed to the Court of Appeal. The decision from the Court of Appeal can be appealed to the Supreme Court only if a leave to appeal is granted. Such a leave to appeal is granted only if the case is considered to set precedent or if it is evident that the lower court has made a judicial mistake. The appeal process to the Court of Appeal usually takes between 12 and 24 months. If a leave to appeal is granted the process will at least take another 12 to 24 months.

13. To take a case through to a first instance decision, what level of cost should a party to litigation expect to incur?

Cost-wise, litigation in Sweden is rather low by international comparison. The costs differ from case to case but one should be prepared for costs of between SEK 1 million and SEK 3 million depending on the case, evidence adduced, witnesses, experts etc. Furthermore, in general, the losing party must pay the winning party's legal costs.

14. Who can represent parties in court? Is specialist representation required?

Compared to many other countries, specialist representation is not required in Swedish courts, although it is still recommended. Attorneys specialising in intellectual property and patent law usually handle court proceedings.

15. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

The remedies available are imprisonment or a fine (in criminal cases), injunction under penalty of fine and damages. Punitive damages are not available, only damages for use of the invention and further damages, for instance market damages or loss of profit. Damages are often quite low in Sweden. The damage for use is calculated as an estimated licence fee. The court may also order infringing goods to be destroyed.

16. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Mediation is an alternative to litigation. Usually, the parties meet and reach a settlement agreement shortly after litigation has been initiated. This causes no procedural problems, as court proceedings may be cancelled at any time if all involved parties concur. Indeed, the courts often encourage parties to reach a settlement out of court, even after litigation has been initiated. In cases where the parties for some reason do not want the publicity that court litigation might provoke, arbitration is an alternative. There are a number of individuals and organisations that specialise in arbitration; most significant is the Stockholm Chamber of Commerce.

17. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement? If not, how likely is it that it will do so?

On 18th May 2006, the Swedish Parliament approved the London Agreement and

amended the Swedish Patents Act in order to implement the London Agreement (compulsory translation of the claims into Swedish, description must be available in English). The date of deposit of the instrument of ratification, and thus of the entry into force of the amendments to the Patents Act, will be decided by the Government.

Enforcing patents in Switzerland

By **Michael Stierwald**, Braunpat Braun Eder AG, Basel

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

In case of an alleged infringement the patent holder may file court actions for the award of an injunction and for the award of damages. Infringement suits can be filed only after the issuance of the patent; the suits can be civil or criminal. Damages may be claimed from the time at which the defendant should have become aware of the content of the patent application, but the action may be introduced only after grant of the patent. Only when the patent infringement has been committed intentionally can criminal proceedings be instituted.

A court may also order the confiscation, sale or destruction of the infringing articles. Declaratory judgment as to non-infringement or as to the validity of a particular patent may be requested by any interested party. The right of suing a given patent infringer is granted to an exclusive licensee but not to non-exclusive licensees.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

There are no special patent courts. Switzerland is a federal state and is divided into 26 cantons. In patent matters, the cantonal procedural laws are applicable and for each canton there is a court designated which receives the civil actions. The level of expertise is very heterogeneous. In principle, commercial courts have a higher level of expertise.

3. Is it possible to cross-examine witnesses

at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

Cross-examination is not possible and proceedings are based on written evidence.

It is up to the court to appoint and question the experts. However, the parties can also appoint their own experts. Such expert opinions may be considered by the court.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

Infringement and invalidity are dealt with at the same court but not simultaneously. All allegations must be substantiated and the level of proof is rather high, based on written evidence or witnesses.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Pre-trial discovery is not permitted in Switzerland. Discovery can, in rare cases, be conducted by the judge.

6. To what extent does any doctrine of equivalents apply in an infringement action?

In Switzerland the patent protection provided is broader than the literal scope of the claim, as demonstrated by case law. Thus a doctrine of equivalents applies to patent cases.

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

No.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

Cantonal courts are independent and therefore not bound by the decisions of other courts. However, the decisions of other

cantonal courts in similar cases may be considered, at the discretion of the court, to a high extent.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

Swiss courts are willing, at the discretion of the court, to consider the reasoning given by foreign courts to a high extent, depending on things such as the country from which a decision is cited and the seniority of the court that handed down the judgment.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

The prolongation of time limits is the only means to delay a case. A judge may suspend the procedure or defer the judgment where the validity of a European patent has been contested and where one of the parties to the dispute gives evidence that opposition may yet be filed with the European Patent Office or that a final decision on the subject of a pending opposition has not been taken.

11. How available are preliminary injunctions and how do you get them?

Precautionary measures are provided by law in the event of infringement. Provisional measures may be ordered to secure evidence, to maintain the actual state of affairs and to enforce disputed rights provisionally. The party requesting such measures at court will have to furnish equitable security. The petitioner must provide *prima facie* evidence that the other party has committed or intends to commit an act contrary to law and that it is threatened by a loss which is not easily repairable, and which can be avoided only by provisional measures. Before a precautionary measure is granted, the opposing party will be heard, but if there is an imminent danger urgent measures may be taken even before hearing the opposing party, provided that it is informed thereof immediately after such measures are taken. If precautionary measures are granted, an infringement action has to be brought within a set term that shall not exceed 30 days.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

Depending on the case, the technical field, expert opinions etc., a decision at first instance can be obtained within one to three

years. Besides consequent adherence to time limits, there is no possibility to expedite this process.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

The Swiss law provides only one possibility for appeal. An appeal can be taken from the cantonal court to the Supreme Court of Switzerland regardless of the values in litigation.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

Depending on the amount in dispute and the complexity of the case – for example, if it requires expert opinions – costs for a first-instance decision are about CHF 50,000 to CHF 1 million, or even more.

15. Who can represent parties in court? Is specialist representation required?

Parties in court may be represented only by attorneys at law admitted to the bar of the corresponding canton. Patent attorneys provide the technical know-how.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

Punitive damages are not available in Switzerland (see also 1, above). Whoever wilfully or by negligence or imprudence unlawfully utilises a patented invention shall be bound to pay damages to the injured party. The prerequisites for the liability for damages are given by the Swiss Code of Obligations (damage, illegality, fault, causal connexion). The injured party has to assess beforehand the amount of damages or the judge may be requested to award damages at his discretion on the basis of the evidence. The judge may also authorise the successful party to publish the decision at the expense of the other party. In criminal cases the infringer may be liable to imprisonment not exceeding one year or to a fine not exceeding CHF 100,000.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

Besides negotiation or arbitration, there are no realistic alternatives to litigation.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent

Litigation Agreement? If not, how likely is it that it will do so?

Switzerland has signed up to the London Protocol and is a member of the sub-group of the Working Party on Litigation to produce a draft agreement.

19. Are there any other features of the enforcement system in your jurisdiction that you would like to point out?

A revision of the Swiss Patent Act is on the way. As well as changes to the cantonal procedural law, the establishment of a federal patent court with specialised judges is also up for discussion.

Enforcing patents in the UK

By **Gary Moss**, Taylor Wessing, London

1. What options are open to a European patent holder, whose rights cover your jurisdiction, when seeking to enforce its rights in your jurisdiction?

The primary option is to commence proceedings for infringement in the appropriate court, as to which see section 2 below.

Normally a patentee will seek by way of relief an injunction restraining further infringements, damages or an account of profits and delivery up of any infringing materials. We discuss these in greater detail in section 16.

However, court proceedings are not the only route available and alternative forms of dispute resolution are discussed in section 17 below.

In addition, under Section 61(3) of the Patents Act 1977 the proprietor of a patent and an alleged infringer may, by agreement, refer to the Comptroller of Patents at the Patent Office the question of whether there is infringement. Note that such reference has to be by agreement of the parties. Where such a reference is made then the Comptroller may award only damages or an account of profits – he does not have power to award an injunction or delivery up. Note also that under Section 61(5) if the Comptroller reaches a conclusion that the question referred would be more properly determined by the court, he may decline to deal with it and thereafter the court would have jurisdiction.

Additionally, under a recently introduced procedure a patent proprietor may request the Comptroller to issue an opinion as to whether a particular act constitutes an infringement of the patent. In these circumstances the consent of the alleged infringer is not required. However, any such opinions are not binding. They were generally thought useful to enable proprietors to obtain opinions from the Comptroller on the

issue of infringement and then use those to put pressure on the alleged infringer.

2. Does your jurisdiction have specialist patent courts? If not, what level of expertise can a patent owner expect from the courts?

The United Kingdom in fact comprises three separate jurisdictions namely: England and Wales; Scotland; and Northern Ireland.

Of these, England and Wales is by far the largest, covering approximately 53 million people out of a total population of 60 million. By far the largest proportion of patent infringement suits are determined in the courts of England and Wales.

England and Wales has three specialist tribunals for the determination of patent disputes. The first is the Patents Court, which is a division of the Chancery Division of the High Court. The High Court is the primary court of first instance in England and Wales for dealing with significant disputes, generally reckoned to be those over £50,000. There are currently two main patents judges, Mr Justice Pumfrey and Mr Justice Kitchin. Prior to their elevation to the bench, both were practitioners at the intellectual property bar and had significant experience in patent matters. In addition, there are a number of Chancery judges who are designated as able to hear patent cases – in practice, they tend to deal with the less technically complex cases.

The second tribunal is the Patents County Court (PCC). The PCC was originally established in 1990 at a time when the county court was generally the court designated for dealing with smaller claims. The concept behind the PCC was to have a more streamlined procedure enabling the hearing of smaller, less complex disputes. It was envisaged as a way of giving SMEs the ability to have their patent disputes determined both speedily and relatively inexpensively. The PCC continues to fulfil

that role although in practice, following the Woolf Reforms of 1998, the streamlined procedure is now available in all courts.

The primary judge of the PCC is His Honour Judge Fysh. Before going to the bench, Judge Fysh was an intellectual property practitioner of many years' standing. Where the workload of the court requires additional judges, deputy judges are recruited from among senior practitioners at the patent bar.

As indicated under section 1 above, it is also possible (by agreement) to have infringement issues determined by the Patent Office, the members of which will be specialists (from both a patent and technical standpoint).

In Scotland, patent actions will normally be determined by the Court of Session. Because of the relatively few number of patent cases which are heard, there is no specialist jurisdiction in Scotland. We are not aware of there having been any patent cases before the courts of Northern Ireland in recent times.

3. Is it possible to cross-examine witnesses at trial? How far are proceedings based on written evidence? Are there restrictions on the use of evidence from experts?

In the majority of cases in the UK oral testimony by witnesses (both lay and expert) remains the norm. However, over the past 15 years or so, in an effort to streamline the process, the English courts have tended to dispense with oral testimony in chief. Instead, witness statements and expert reports are exchanged by the parties in written form some time in advance of the trial (in most major cases there will be two rounds of evidence, in chief and in reply). The witnesses will then confirm the truthfulness of those written statements under oath at the trial. They are then tendered for cross-examination by the opposing party.

The ability to challenge forensically a witness's evidence by means of cross-examination is still regarded as a fundamental aspect of the British legal system. A party will not be allowed to adduce evidence from a witness who has not been tendered for cross-examination unless that party can establish that it does not have the ability to require the witness to attend the court or to be cross-examined in some other way, eg via a video link. This would require the party wishing to rely on the written evidence to show that the witness is too ill to attend, or has died, or cannot be compelled, eg because they are not within the jurisdiction. Even the latter may be

difficult to establish in the case of a witness whose attendance by way of video link or written deposition could be compelled through an overseas court.

There are no restrictions on the use of evidence from experts as such. However, in practice courts will endeavour to limit the number of experts used by each party. Usually the court will seek to limit each side to one expert per technical discipline, although cases involving complex areas of technology can involve a number of disciplines which can lead to each party utilising more than one expert.

As regards experts generally, it should be noted that the courts have stressed that the function of such witnesses is to assist the court and not to act as an advocate for the case of the party from whom they have received instructions. This rule is applied very strictly and the court will take a dim view of an expert who it believes is simply putting forward the best case possible for his or her instructing party.

4. Are infringement and invalidity dealt with simultaneously? What level of proof is necessary to demonstrate one or the other?

In the vast majority of cases infringement and validity are dealt with by the same court at the same time. All of the jurisdictions mentioned under section 2 above have jurisdiction to hear both infringement and validity issues. Under UK law it is not possible to "infringe" an invalid patent and therefore the invalidity of a patent is a complete defence to a charge of infringement.

In all cases the level of proof required is the normal standard, namely balance of probabilities. Note that in the United Kingdom there is no presumption of validity of a granted patent requiring a higher level of proof to establish invalidity, as is the case in the United States. Moreover, the fact that a Patent Office Examiner may have considered a piece of prior art prior to granting the patent will be of no evidential value whatsoever if that prior art is raised again in any invalidity suit.

5. To what extent is pre-trial discovery permitted? If it is permitted, how is discovery conducted?

Pre-trial discovery is a key feature of the United Kingdom legal system. However, in an effort to reduce the costs of litigation over the past few years its general scope has been reduced to a significant extent. This has now been further restricted in patent cases.

Prior to the changes coming about as a result of the civil justice reforms at the

beginning of this decade, the UK rules on discovery obliged each party to disclose any document in its possession, custody or control which was relevant to the matters in issue or which might lead to a chain of enquiry which was relevant to the matter in issue. This made documentary discovery quite wide ranging, although it was never as wide ranging as US discovery.

Under the new procedure a party must now provide "standard disclosure". Standard disclosure requires a party to disclose only:

- The documents on which it relies.
- The documents which:
 1. adversely affect its own case;
 2. adversely affect another party's case; or
 3. support another party's case.
- Documents which it is required to disclose by a relevant practice direction.

It should be noted that the above is considerably more limited than the previous obligations.

These obligations have been further limited in the case of patents in the following manner:

- Where a defendant has produced a product description it is not obliged to provide documents relating to the issue of infringement.
- In the case of validity, neither party is obliged to disclose any documents falling outside a period beginning two years before the priority date of the patent in suit and ending two years after the priority date.
- In relation to allegations of commercial success, instead of providing documentary discovery the party relying on such allegations must serve a schedule setting out the details of the alleged commercial success covering such issues as the product in question, the level of sales, the period of sales etc.

The disclosure process imposes significant obligations on the parties' lawyers. As officers of the court they have an overriding duty to ensure that the court rules are complied with by the party for whom they are acting. That duty outweighs their duties to their client. This includes making searching enquiries to ascertain that all relevant documents required to be disclosed have been disclosed. It also imposes obligations to ensure that items such as product descriptions fully and accurately describe the product in question and are not defective to any material degree.

In addition to the above, it is open to a party to seek disclosure over and above standard discovery. In deciding whether or not to order a specific disclosure order, the court takes into account all the circumstances of the case and in particular the Overriding Objective of the Rules of Civil Procedure which requires the court to deal with cases proportionately, expeditiously and fairly. In practice, this places an obligation on the party seeking specific disclosure to establish to the satisfaction of the court that the standard disclosure is inadequate and that the additional disclosure sought is necessary for the just disposal of the case.

6. To what extent does any doctrine of equivalents apply in an infringement action?

This is an extremely complex issue. In *Kirin-Amgen Inc v Transkaryotic Therapies Inc* [2004] UKHL 46, the House of Lords ruled that under United Kingdom law there is no doctrine of equivalents. Rather the patent claims are to be given a purposive construction having regard to the purpose of the patentee as would be determined on reading the specification as a whole by the person skilled in the art. The claims should not be given a strict literal interpretation; at the same time it is the claims which determine the monopoly and they should not be regarded merely as a guideline.

For a more detailed explanation as to how patent claims are to be construed please see the judgment of Lord Justice Jacob in *Rockwater v Technip France SA & Technip Offshore UK Limited* [2004] RPC 46 (which was generally cited with approval in *Kirin-Amgen*) and in *Mayne Pharma v Pharmacia Italia SPA* [2005] EWCA Civ 137 (which was given after the decision in *Kirin-Amgen*, but took into account the comments of the House of Lords).

7. Are there certain types of patent right that may be granted by the EPO – biotech or computer software-related, for example – that are more difficult to enforce than others?

In general the answer to this question is no. However, it should be noted that there has been very limited judicial pronouncement in the UK regarding computer software-related inventions and the degree to which these may be patentable. There is still uncertainty as to how readily these may be enforced.

8. To what extent are courts willing to consider, or bound by, the opinions and decisions of other courts that have dealt with similar cases?

The United Kingdom courts operate on a basis of precedent in which previous decisions will be binding upon them. This rule relates particularly to decisions given by the higher courts (Court of Appeal or House of Lords). Where there are prior decisions of courts on the same level, the later court might be willing to depart from a previous decision if it is satisfied there are new facts or new arguments which were not considered by that prior tribunal.

9. To what extent are courts willing to consider the reasoning given by foreign courts that have handed down decisions in similar cases?

These will be of significant persuasive effect. The United Kingdom judges have been at the forefront of attempts to harmonise patent law throughout Europe. This necessarily involves giving appropriate consideration and respect to prior decisions of judges in other jurisdictions where they have been considering essentially the same patent and the same alleged infringement while at the same time applying the same law.

10. What options are open to a defendant seeking to delay a case? How can a plaintiff counter delaying tactics?

Generally the abilities for a party to delay a case are very limited. In the recent past the Patents Court has made significant strides in ensuring that patent cases are disposed of reasonably expeditiously. The court is very reluctant to allow a party to delay the disposal of the case once commenced unless there are very good reasons for doing so. It will also not necessarily rubber stamp an agreement between the parties to delay the disposal of the case unless it is satisfied that there are good reasons for doing so.

One tactic which has sometimes been employed is to seek a stay of the litigation proceedings pending the outcome of oppositions in the European Patent Office (EPO). Although the courts have been at pains to stress that there is no hard and fast rule and that each case turns on its own facts, in practice it can be difficult to secure such a stay. This is because of the length of time which oppositions take including appeals – currently the estimate is at least five years. The court is unwilling to allow a patentee's rights to be frozen for that length of time and will be similarly reluctant to require a defendant to have hanging over it an allegation of infringement for that length of time. Where the parties comprise sizeable commercial organisations, the view of the

United Kingdom court is that any perceived prejudice incurred by proceeding with the UK action in the meantime, which usually comes down to a question of wasted expense, can be dealt with by appropriate orders in costs.

Circumstances which may justify a stay are:

- Where the defendant is an individual or small entity and can show that having to spend money fighting the UK action while an opposition is pending will cause it significant prejudice.
- Where the patentee has delayed until well into the opposition period before commencing proceedings despite having known about the alleged infringement.

11. How available are preliminary injunctions and how do you get them?

Theoretically, preliminary injunctions are available where the claimant can show that it will suffer irreparable harm and damage if the defendant's activities are allowed to continue pending the trial. In practice, they have become relatively rare in patent actions, save in cases involving the launch of generic pharmaceuticals. This is because of the timescales for UK patent actions (see section 12 below) and the possibility for even further expedition. In practice, in most instances if a claimant seeks a preliminary injunction they will be met by the response from the court that, rather than arguing over the preliminary injunction, it would be more sensible to have a full trial of all the issues in three to four months.

12. How long does it take to get a decision at first instance? Is it possible to expedite this process?

The Patents Court has made great strides over the past few years in ensuring that patent actions are disposed of expeditiously. The normal timescales for even a reasonably complex patent action are in the region of nine to 12 months from commencement of the action through to trial. Decisions can be expected within four to six weeks thereafter.

Furthermore, the court has been amenable to expedition in appropriate cases where, for example, one of the parties can demonstrate that it has a real need to have a definitive ruling within a relatively short space of time. A timescale of four to six months from commencement of the action to trial is not uncommon.

13. What avenues for appeal are open to the defeated party in a first instance case? What criteria are there for granting an appeal? How long does the appeal process take?

Appeals from both the Patents Court and the Patent County Court are to the Court of Appeal. Appeals from decisions of the Patents Office go first to the Patents Court and then on to the Court of Appeal – this is one of the drawbacks of commencing any infringement litigation in the Patent Office in that one is adding an extra level of appeal.

Appeals from first instance to the Court of Appeal may now be made only with permission. A litigant must seek the permission of the first instance court to appeal. If that is refused then one may apply for permission to the Court of Appeal. If the Court of Appeal, without a hearing, refuses permission to appeal then a request may be made that the decision be reconsidered at a hearing. But if leave is refused at the hearing no further appeal is possible. In theory, appeals can be raised on a point of law or against a finding of fact, but in practice one would struggle to bring an appeal on a finding of fact alone as the Court of Appeal is reluctant to overturn a first instance court decision on fact. This is because the Court of Appeal, unlike the court of first instance, does not have the opportunity to hear the witnesses in person. However, often litigants try to dress up factual issues as points of law by saying that the judge should not have found for the other party on the preponderance of facts.

One interesting feature is that obviousness/inventive step is a mixed question of law and fact of which only the factual element should be determined by the first instance judge. The Court of Appeal has on several occasions cautioned against litigants appealing against decisions on factual issues alone purely in the hope that another tribunal may take another view of those facts. It remains to be seen whether the first instance court will utilise that in order to cut down a party's ability to appeal on those issues.

There may be a further level of appeal to the House of Lords. Again that has to be with the permission of the Court of Appeal or the consent of the House of Lords if permission is refused by the Court of Appeal. In practice, the House of Lords will hear only appeals raising a point of law of public importance.

Appeals from the first instance to the Court of Appeal take approximately 12 months. Appeals to the House of Lords will take a further 12 months.

14. To take a case through to a first instance decision, what level of cost should a party to a litigation expect to incur?

One of the drawbacks of the United Kingdom system is that it is relatively expensive compared with other European systems.

Even in the most relatively simple patent cases, a litigant can expect to pay between £150,000 and £250,000 if the case goes all the way through to trial. For a case of medium complexity those costs would rise to £500,000 to £750,000. Very complex patent trials involving significant technologies would rise into the low millions.

One point which should be noted is that the United Kingdom has the rule that generally the loser pays the successful party's costs. The basis of award means that the actual recovery is usually somewhere between 60% and 80% of the actual costs incurred. However, over the past few years there has grown up a market in after-the-event insurance which enables litigants to insure against that potential liability.

It should also be noted that United Kingdom lawyers are now able to take on litigation on a no win, no fee basis. However the amount of uplift which they are permitted to charge is significantly restricted (depending on the perceived likelihood of success) and cannot in any event be more than 100% of the costs which would have been incurred on a normal charging basis.

15. Who can represent parties in court? Is specialist representation required?

Both solicitors and chartered patent attorneys can represent parties in the Patents County Court and also can act as the advocate at the trial. Barristers can also be instructed, by either the chartered patent attorney or the solicitor, to appear at a Patents County Court trial where specialist cross-examination and advocacy are required. In the Patents Court (part of the High Court) a chartered patent attorney with additional advocacy qualifications can conduct litigation, but will have a right of audience (ie, be allowed to act as advocate) only for cases on appeal from the Patent Office. In all other cases in the Patents Court advocacy and cross-examination may be conducted only by a barrister or a solicitor with a right of audience.

16. What remedies are available for infringement and how are these typically applied? Are punitive damages available and in what circumstances?

The normal remedies are:

- Injunction to restrain further infringements.
- Damages or an account of profits (these are alternatives and the claimant has to

elect which of these remedies he wishes to adopt).

- Delivery up of any infringing materials.
- Costs expended in pursuing the litigation.

Damages can be based on the amount of profits lost by the patentee by reason of the defendant's infringing acts. In order to establish an entitlement to lost profits the claimant has to show that on the balance of probabilities it would have made the infringing sales had the defendant not done so. Where the claimant cannot show this, damages will be based on a national royalty based on the rate a willing licensor would agree with a willing licensee.

A defendant may avoid liability for damages or an account of profits if it can show that at the date of the agreement it was not aware and had no reasonable grounds for supposing that the patent existed. Given the public nature of the Patent Office register it is difficult to succeed in such a defence.

Punitive damages are available only in exceptionally rare circumstances in the UK.

17. Are there any realistic alternatives to litigation in cases relating to patent disputes?

It is open to the parties to adopt alternative forms of dispute resolution, notably arbitration. Arbitrations are not common in the field of intellectual property infringement, mainly because there is no pre-existing agreement between the parties under which the arbitration can be initiated. Nevertheless it is open to the parties to agree to arbitrate once the dispute has arisen.

18. Has your jurisdiction signed up to either the London Protocol or the European Patent Litigation Agreement?

The UK has ratified the London Protocol but the European Patent Litigation Agreement is still being debated.



ALTIUS Law Firm

Avenue du Port 86C B.414
1000 Brussels, Belgium
Tel: +32 2 426 14 14
Fax: +32 2 426 20 30

www.altius.com

Paul Maeyaert

Partner
paul.maeyaert@altius.com

Paul Maeyaert heads the IP practice of ALTIUS. His daily practice focuses on trademark and patent litigation, as well as media & entertainment law. During recent years he has obtained particular experience in assisting clients in cross-border litigation disputes.

He has been a member of the Brussels Bar since 1984 and obtained a law degree magna cum laude at the Free University of Brussels and a master's in European law at the College of Europe.

He is a frequent speaker at IP seminars and regularly publishes articles on IP topics of interest. He is also active in various professional associations, such as AIPPI, INTA, LIDC, Marques and BMM, and is a member of the editorial board of IRDI, a leading Belgian IP journal.



ALTIUS Law Firm

continued

Christophe Ronse

Partner
christophe.ronse@altius.com

Christophe Ronse is a partner with ALTIUS, in charge of the litigation practice. He specialises in patent litigation, particularly in the life sciences sector, and has litigated various important pharmaceutical patent cases before the Belgian courts.

He has been a member of the Brussels Bar since 1988 and obtained a law degree cum laude from the Catholic University of Leuven and a master of laws degree from the University of Illinois at Urbana-Champaign.

He is active in various professional associations such as AIPPI, LES and EPLaw, and presently serves as a board member of the Belgian section of AIPPI. He occasionally speaks and publishes on various legal subjects.

**A&L Goodbody**

International Financial Services Centre
North Wall Quay,
Dublin 1, Ireland
Tel: +353 1 649 2234
Fax: +353 1 649 2649

www.algoodbody.ie

John Whelan

Partner
jwhelan@algoodbody.ie

John Whelan is Head of IP & Technology at A&L Goodbody. John's practice areas include both the contentious and non-contentious aspects of intellectual property, information technology, telecoms and life sciences.

Before joining A&L Goodbody as a partner in 2003, John previously worked with a leading international law firm in London and Hong Kong. His return to Ireland coincided with the subsequent establishment of the Irish Commercial Court in January 2004 and he has been involved in most of the significant IP cases before that court since its inception, including a number of complex and high-profile patent proceedings.

John has spoken at conferences on IP topics in a number of jurisdictions and is recommended as a lawyer of choice for IP and IT matters by a number of international legal publications. John was educated at University College Dublin and holds a law degree (BCL) and a masters in commercial law (LLM).

**A&L Goodbody**

continued

Ciara Cullen

Solicitor
ccullen@algoodbody.ie

Ciara Cullen is a member of the IP & Technology Group at A&L Goodbody. Ciara's areas of specialisation include trademarks, patents, designs and copyright law.

Ciara has experience in a wide range of intellectual property matters dealing with all forms of intellectual property rights covering a range of sectors and technologies. Her contentious experience includes a number of patent, trademark and copyright cases before the Irish High Court and Commercial Court. Her non-contentious experience includes advising on licences, sponsorship agreements, distribution and franchise arrangements and other intellectual property-focused transactions.

Ciara worked in the financial sector for a period before qualifying as a solicitor with A&L Goodbody. She holds a law degree (LLB) from Trinity College Dublin.

**Amat i Vidal-Quadras Advocats**

Pau Casals, 14, 5è
08021 Barcelona, Spain
Tel: +34 93 321 10 53
Fax: +34 93 419 31 47

www.avqadvocats.com

Miguel Vidal-Quadras Trías de Bes

Partner
mvq@avqadvocats.com

Mr Vidal-Quadras is head of the firm's industrial and intellectual property and pharmaceutical law department. A doctor of law, he graduated in 1993 from Universidad de Barcelona. He has been a member of Barcelona Bar Association since 1997. He is a member of the AIPPI and LES. Before joining Amat i Vidal-Quadras he was a lawyer at Bufete Roig Aran (1995-1997), Garrigues-Andersen (2000-2002) and Torrents & Advocats (1997-2000 and 2002-2003). He is the author of various publications on intellectual property and the coordinator of the protection of technology module at ESADE, Universitat Ramon Llull, as well as being a lecturer at the Patent Centre, Universidad de Barcelona, where he also teaches various other courses on industrial property.

His main areas of expertise are litigation, intellectual property, competition, advertising, technology transfer and pharmaceutical law. He speaks Spanish, Catalan, English and French.



Amat i Vidal-Quadras Advocats
continued

Oriol Ramon Sauri

Associate
ors@avqadvocats.com;

Oriol Ramon Sauri graduated in law in 2002 from Universitat Autònoma de Barcelona and also has a master's degree in industrial and intellectual property and competition law from ESADE, Universitat Ramon Llull. He has been a member of the Barcelona Bar Association since 2004 and joined Amat i Vidal-Quadras in the same year. Before joining the firm he was a lawyer at H & C Advocats i Consultors (2001-2003).

His areas of expertise are intellectual property, competition and advertising law. He speaks Spanish, Catalan and English.



Árnason Faktor
Gudridarstig 2-4, IS 113
Reykjavik, Iceland
Tel: +354 540 0200
Fax: +354 540 0201

www.arnasonfaktor.is

Gunnar Örn Harðarson

Founding partner and managing director
goh@arnasonfaktor.is

Gunnar has a BSc in mechanical engineering and is a European patent attorney. After 20 years in the IP field, Gunnar has extensive industry and private practice experience, and has served on various government IP advisory committees. He focuses on drafting and prosecuting mechanical patent applications, opinion work, appeals and litigation support. Gunnar was secretary of the Association of Icelandic Patent Agents from 2000 to 2005, and is a council and board member of the EPI.



Árnason Faktor
continued

Ásdís Magnúsdóttir

Partner
am@arnasonfaktor.is

Ásdís has over seven years' experience in IP matters in private practice as well as at the Icelandic PTO. She graduated from the Law Faculty of the University of Iceland and her final thesis was in the field of patents: "The legal protection of biotechnology inventions." She completed an LLM degree in law, science & technology at Stanford University in California in May 2005.

Ásdís also works on trademark matters, such as the prosecution of trademark registrations, as well as consulting on other intellectual property matters. She is a member of the INTA.

**Borenius & Kempainen Ltd**

Yrjönkatu 13 A,
00120 Helsinki, Finland
Tel: +358 9 615 333
Fax: +358 9 615 33499

www.borenius.com

Ben Rapinoja

Partner
Ben.rapinoja@borenius.com

Ben Rapinoja is a partner in the IP & Technology practice group of Borenius & Kempainen Ltd. His practice is focused on commercial utilisation of intellectual and industrial property rights (especially patents and trademarks), technology-driven transactions and the legal aspects of life sciences and pharmaceuticals. Ben has particular expertise in the fields of patent and IP litigation.

Prior to joining Borenius & Kempainen, Ben worked for the Ministry of Trade and Industry as legal adviser and governmental secretary responsible for legal affairs relating to intellectual property rights, especially patents, trademarks and design rights. He also represented the Finnish government in various expert groups of the EU institutions, the European Patent Organisation and international organisations in the field of intellectual property (WIPO, WTO).

**Borenius & Kempainen Ltd**

continued

Aura Soininen,

Associate
Aura.soininen@borenius.com

Aura Soininen is an associate lawyer at Borenius & Kempainen Ltd. She advises on IP-related matters with a specific focus on patent law, IPR strategies and questions related to the pharmaceutical field and biotechnology. Aura received her master of laws degree in 2002. She also studied biochemistry at the University of Oulu and later in the University of Helsinki, and is currently in the process of completing her doctoral studies (econ) on patents at the Lappeenranta University of Technology, Department of Business Administration. Prior to joining B&K, Aura worked for several years as a researcher at the Helsinki Institute for Information Technology (HIIT). During her employment at HIIT she spent a year and a half at the UC Berkeley, US, where she was a visiting scholar at the School of Information Management and Systems.

**Braunpat Braun Eder AG**

Reussstrasse 22
Postfach
CH-4015 Basel, Switzerland
Tel: +41 61 307 90 30
Fax: +41 61 307 90 39

www.braunpat.ch

Michael Stierwald

Patent specialist
sm@braunpat.ch

Michael Stierwald prosecutes patent and design grant procedures in Switzerland, Europe and internationally. He specialises in biotech and chemistry inventions. In particular, he devotes his attention to IP valuation and strategies in IP.

He holds a PhD in molecular biology from the University of Basel and a master's degree in advanced studies in IP from the Swiss Federal Institute of Technology, Zurich (ETHZ). As well as his native German, he speaks fluent English and French.

**Brevalex**

3 rue du Docteur Lancereaux
75008 Paris, France
Tel: +33 1 53 83 94 00
Fax: +33 1 45 63 83 33

www.brevalex.com

Pascal Moutard

Partner
pascal.moutard@brevalex.com

Pascal Moutard is a French and European patent and trademark attorney, and is also joint manager of Brevalex, an IP law firm with headquarters in Paris and offices in Grenoble and Toulouse. He graduated as an engineer from the Ecole Nationale Supérieure des Mines (Saint Etienne), and also has a doctorate in physics and a master's degree in law (industrial property) from the University of Lille. He is a graduate of the European patent litigation course of the University of Strasbourg.

Mr Moutard was a patent examiner at the European Patent Office for six years and has 14 years' experience as a patent engineer and a patent attorney. He now works for both SMEs and large French, Japanese and US companies, with a focus on physics, electronics, computer-related inventions, semiconductors, nanotechnologies, microelectronics and data processing.

He has wide experience in prosecuting opposition cases before the EPO, but also before foreign offices (mainly US and Japanese, in cooperation with a wide range of associate firms). He has also acquired wide experience in IP litigation cases, mainly in France but also in different European countries in cooperation with local attorneys.

Mr Moutard is a member of the IEAM (Institute for Expertise, Arbitration and Mediation - Paris) for IP matters and an expert of the French committee of the International Chamber of Commerce.

**Cermák Horejs Myslíl a spol,**

Národní 32, 110 00 Praha 1,
Czech Republic
Tel: +420 296 167 111
Fax: +420 224 946 724

www.cermakhorejsmyslil.cz

Lukas Lorenc

Attorney at law
LLorenc@apk.cz

Lukas Lorenc studied at the Faculty of Law at Charles University in Prague, gaining a master's degree in 2000. He joined Cermák Horejs Myslíl a spol as a legal trainee in 2000, and was admitted to the Bar in 2002. His main practice areas are Czech intellectual property, commercial law and litigation. He also has experience in advising on unfair competition issues and on EU regulations and EU law. He speaks Czech, English and German, and also has a working knowledge of Russian.

**Cermák Horejs Myslíl a spol,**

continued

Andrea Povazanová

Attorney at law
APovazanova@apk.cz

Andrea Povazanová completed her studies at the Faculty of Law of Komenský University in Bratislava in 1998. She has participated in expert traineeships with the Constitutional Court in Košice (1997), the Council of Europe in Strasbourg (1999), the International Institute for Public Administration in Paris (1999), and the European Court of Justice in Luxembourg (2002 – 2003). Between 1998 and 2002, she was a legal adviser at the Ministry of Justice of the Slovak Republic. Since 2003, she has been a legal assistant with Cermák Horejs Myslíl a spol. She specialises mainly in industrial property law and the civil law. She speaks Czech, Slovak, English and French.

**DLA Piper Weiss-Tessbach**

Rotenturmstrasse 13
A-1010, Vienna, Austria
Tel: +43 1 531 78 0
Fax: +43 1 533 52 52

www.dlapiper.com

Alexander Cizek

Partner
alexander.cizek@dlapiper.com

Alexander Cizek was admitted to the New York bar in 1996 and to the Austrian bar in 2000. He has been a partner with DLA Piper Weiss-Tessbach since 2001; he heads the IP team of DLA Piper Weiss-Tessbach's Vienna office. He is also responsible for the IP practice in the firm's CEE offices.

Alexander Cizek specialises in all areas of intellectual property law including patents, trademarks, designs, copyrights and unfair competition practices. He advises both national and international clients on IP-related issues and has represented them in licensing and know-how transfer negotiations. He has substantial litigation experience both in court and before the Austrian Patent and Trademark Office. His domestic and foreign patent clients mostly stem from the chemical and mechanical engineering field but also include other industries. Alexander Cizek also advises and represents clients on general commercial legal issues and in transport insurance and shipment law cases.

**Grünecker Kinkeldey Stockmair & Schwanhäusser**

Maximilianstrasse 58,
80538 Munich, Germany
Tel: + 49 89 21 23 50
Fax: + 49 89 22 02 87

www.grunecker.de

Dr Bernd Allekotte

Partner
allekotte@grunecker.de

Dr Bernd Allekotte is an attorney at law at the Munich office of Grünecker Kinkeldey Stockmair & Schwanhäusser. His practice focuses on litigation, in particular patent, trademark and unfair competition cases. He also advises his clients on related licensing matters, with particular emphasis on German and EU antitrust concerns. He has focused on intellectual property law since he first started practising with a New York law firm in 1996. He is admitted to the Bars of New York and Germany.

Dr Allekotte's technical experience encompasses mechanical and electrical technologies, chemistry/pharmaceuticals, biotechnology and telecommunications. He is permanently engaged in a number of litigations involving patent infringement actions in various district courts and courts of appeal in Germany. He continuously deals with aspects of international patent litigation, in that he works out strategies and represents clients to enforce patent portfolios in a number of jurisdictions, as well as advising on strategies to defend clients against patent infringement in several jurisdictions. Dr Allekotte has written several articles and lectures from time to time on aspects of intellectual property law.

**Intellectual Asset Management magazine**

Globe White Page Ltd, New Hibernia House,
Winchester Walk, London SE1 9AG, UK
Tel: +44 20 7234 0606
Fax: +44 20 7234 0808

www.iam-magazine.com

Joff Wild

Editor
jwild@iam-magazine.com

Joff Wild is a journalist who has specialised in covering IP since 1992. He has been editor of a number of IP publications, including Copyright World, Patent World and Managing Intellectual Property. He has also written on IP for a number of other publications including the Times, the Financial Times and the American Lawyer. From 1998 to 2000 he was publisher of all intellectual property products at Euromoney Institutional Investor. He has been editor of IAM since it launched in July 2003.

**Nederlandsch Octrooibureau**

PO Box 29720

NL-2502 LS, The Hague, the Netherlands

Tel: +31 70 331 2500

Fax: +31 70 352 7528

www.octrooibureau.nl**Hans Bottema**

Managing partner

bottema@octrooibureau.nl

Hans Bottema is managing partner of Nederlandsch Octrooibureau in The Hague.

He is a Dutch and European patent attorney and his areas of practice include mechanics, process and packaging technology and physics. Hans works for multinational companies in the offshore and brewing industry, as well as for medium-sized companies in automotive technology.

Hans joined Nederlandsch Octrooibureau in 1995. Prior to this he was a European patent attorney with Procter & Gamble in Brussels, Newcastle and Frankfurt. With P&G he was engaged in prosecution and litigation in the paper product technology area. He started his training as a patent attorney in 1987 with Philips Electronics in Eindhoven in the field of medical systems and electron beam imaging devices. Hans holds an MSc in technical physics from Delft University of Technology at the Faculty of Reactor Physics (1987).

**Nederlandsch Octrooibureau***continued***H J Hutter**

Partner

hutter@octrooibureau.nl

Hans Hutter is a partner of Nederlandsch Octrooibureau in The Hague and heads the electronics section. He is a Dutch and European patent attorney and his areas of practice include computer-implemented inventions, semiconductor technology, lithography machines, telecommunications, optical discs and smart cards. Hans works for a wide variety of national and international companies.

Hans joined Nederlandsch Octrooibureau in 1991. He started his patent career with the Netherlands Industrial Property Office in 1988. Before that, he studied electrical engineering at Twente University (1982). Here he worked as a teacher in computer science. Hans holds a PhD in the history of science and technology from Eindhoven University of Technology (1988).

**Patpol**

02-776 Warsaw,

162J, Nowoursynowska Str, Poland

Tel: +48 22 644 96 57

+48 22 546 91 18

Fax: +48 22 644 44 02

www.patpol.com.pl**Katarzyna Karcz**

Patent Attorney, Partner

katarzyna.karcz@patpol.com.pl

Katarzyna Karcz has an MSc degree in civil engineering from Warsaw University of Technology, as well as a certificate in postgraduate intellectual property studies from Jagellonian University in Kraków. Since 1999, she has been a Polish patent and trademark attorney, and since 2004 a European patent attorney.

Formerly at the Polish Patent Office and now a partner at Patpol, Mrs Karcz's activities focus on the prosecution of mechanical patents. In June 2005, she was appointed as the Head of the Patents and Designs Department at Patpol.

As a member of AIPPI she participates regularly in the work done by this association and is also a frequent attendee of its seminars, forums and congresses.



Patpol

continued

Malgorzata Zielinska-Lazarowicz

Lawyer

malgorzata.lazarowicz@patpol.com.pl

Malgorzata Lazarowicz has a master of law degree from Warsaw University, where she also undertook postgraduate studies in intellectual property law (2003) and in European law (2005). Since 2005, Mrs Lazarowicz has been a trainee patent attorney.

At Patpol, Mrs Lazarowicz's practice focuses on infringement and enforcement of intellectual property rights, including patents, designs, trademark protection, administrative and litigation proceedings, as well as unfair competition and copyrights. She is experienced in drawing up appeals against decisions of the Patent Office issued as part of litigation proceedings (opposition and invalidation proceedings) or when it has refused to grant a patent, drafting cease and desist letters to alleged infringers of exclusive rights, and giving legal opinions on many aspects of Polish intellectual property law to national and foreign clients.



Società Italiana Brevetti

Piazza di Pietra, 38-39

00186 Rome, Italy

Tel: +39 06 69 54 41

Fax: +39 06 69 54 4810/20

www.sib.com

Giovanni Antonio Grippiotti

Partner

giovanni.grippiotti@sib.it

Giovanni Grippiotti is a member of the Rome Bar as well as being an Italian and Community trademark attorney and a Community design attorney.

In over 20 years' practice in association with SIB's Rome office he has covered the full range of IP rights and handled a large number of disputes in a number of IP-related fields, including patents, trademarks, designs and copyrights. His clients are world industry leaders, international companies, universities and research organisations. He is particularly experienced in obtaining preliminary injunctions and seizures in patent disputes.

Mr Grippiotti regularly contributes case comments to specialist journals and he lectures on IP matters. He belongs to INTA, AIPPI, FICPI, ECTA, MARQUES and LES, as well as to the INDICAM Council, the Italian Industrial Property Consultants Institute and the Italian College of Industrial Property Consultants.

He speaks English.



Szecskey Ügyvédi Iroda – Attorneys at Law

H-1055 Budapest,

Kossuth Tér 16-17, Hungary

Tel: +36 1 472 3000

Fax: +36 1 472 3001

www.szecskey.com

Dr Gábor Faludi

Attorney

Gabor.Faludi@Szecskey.com

Dr Gábor Faludi is a Hungarian attorney admitted to the Budapest Bar. Dr Faludi received his JD, summa cum laude, from Eötvös Loránd Faculty of State and Legal Science in 1976. He obtained his PhD through a thesis on copyright licensing agreements. He also attended Columbia University (graduate of the summer programme in American law, 1981).

Dr Faludi is an associate professor of law at Eötvös Loránd University. He is also a board member of the Hungarian Association for the Protection of Industrial Property, and a member of the Copyright Experts Committee, the Council for the Protection of Intellectual Property at the National Patent Office and the Electronic Telecommunication Arbitration Board. Dr Faludi is the author of numerous articles on intellectual property law. He currently specialises in civil, commercial and IP law and litigation. Dr Faludi is fluent in English and German.



Szecskey Ügyvédi Iroda – Attorneys at Law
continued

Dr Gusztáv Bacher

Attorney
Gusztav.Bacher@Szecskey.com

Dr Gusztáv Bacher is a Hungarian attorney admitted to the Budapest Bar. He received his JD, summa cum laude, from Eötvös Loránd Faculty of State and Legal Science in 1998. Dr Bacher lectures at the university in seminars on contract law. He received his master of laws (LLM) degree in international business law from the Central European University in 2001. He worked for three months in the Max Planck Institute for Intellectual Property (Munich) in 2005.

Dr Bacher is a member of the executive committee of the Hungarian group of AIPPI, assistant secretary general of the Ligue Internationale du Droit de la Concurrence (LIDC) and in 2004 was international rapporteur of the LIDC on comparative advertising. He is the author of a number of articles on civil law, IP and e-commerce. Dr Bacher joined Szecskey Ügyvédi Iroda in 1999. He currently specialises in civil, competition, advertising and IP law and litigation. Dr Bacher is fluent in English and German.



Taylor Wessing
Carmelite
50 Victoria Embankment, Blackfriars
London EC4Y 0DX, United Kingdom
Tel: +44 20 7300 7000
Fax: +44 20 7300 7100

www.taylorwessing.com

Gary Moss

Partner
g.moss@taylorwessing.com

Gary is a senior partner in the Intellectual Property Department of leading European law firm Taylor Wessing. He specialises in both contentious and non-contentious issues, with particular emphasis on patents, pharmaceuticals, biotechnology, information technology and technology transfers. Gary has over 25 years' experience practising in these areas and during that time has handled many major patent cases. Gary also has extensive experience in cross-border patent litigation involving both Europe and the United States.



Taylor Wessing
continued

Nigel Stoaite

Partner
n.stoaite@taylorwessing.com

Nigel is a partner in the Intellectual Property Department of Taylor Wessing, specialising in patent litigation and advice, and licensing and technology transfer in the engineering, chemical, pharmaceutical and biotechnology industries.

He graduated from Southampton University with a BEng in mechanical engineering and worked in industry before retraining as a solicitor. In 1995 he joined Taylor Joynson Garrett (which became Taylor Wessing in September 2002). Nigel has also obtained a postgraduate diploma in intellectual property law from Bristol University.

Nigel writes regularly, contributing articles to a number of specialist intellectual property and life sciences publications. He also lectures and speaks regularly at conferences on patent-related matters. He has appeared on television commenting on patent issues, in particular the proposals for the Community patent.



Taylor Wessing
continued

Tom Carver

Solicitor
t.carver@taylorwessing.com

Tom is an associate in the Intellectual Property Department of Taylor Wessing and specialises in patent litigation. Tom has particular experience of acting for clients in the pharmaceutical, medical devices and biotechnology sectors, but has also assisted on cases in a variety of other technology fields.

Tom gained a BSc in genetics from the University of Nottingham and a diploma in intellectual property law and practice from the University of Bristol. He trained as a solicitor at Taylor Wessing, qualifying in March 2005.



Zacco A/S

Hans Bekkevolds Allé 7
DK-2900 Hellerup Denmark
Tel: +45 39 48 80 00
Fax: +45 39 48 80 80

www.zacco.com

Pernille Thorsboe

Partner
pth@zacco.dk

Pernille Thorsboe graduated in 1980 with an MSc in chemical engineering from Denmark's Technical University. Mrs Thorsboe started her career in the patent business immediately and worked from 1982 to 2000 at the Danish Patent Office, from 1988 as head of various chemical divisions and finally as Head of Patents.

During her years at the Patent Office, Mrs Thorsboe had the responsibility of managing and developing Danish patent practice within chemistry, and she has participated in harmonisation work in relation to patents at WIPO, the EPO, the EU and the North. She was the head Danish delegate in the negotiation of the EU Directive on Biotechnological Inventions between 1988 and 1996.

Mrs Thorsboe joined Zacco Denmark as a patent attorney in 2000 and became Head of the Life Science and Chemistry Department in 2004. In Zacco Denmark she works within organic chemistry, food technology and pharmaceuticals, and with patent litigation for the pharmaceutical industry.

Zacco A/S is a Scandinavian company, which has offices in Copenhagen, Aarhus, Oslo, Trondheim, Stockholm, Skellefteå and Malmoe.



Zacco Norway AS

Haakon VII's gate 2, PO Box 2003 Vika,
NO-0125 Oslo, Norway
Tel: +47 22 91 04 00
Fax: +47 22 91 05 00

www.zacco.no

Jens Fredrik C Langfeldt

Senior adviser
jfl@zacco.no

Jens Fredrik C Langfeldt was born in 1942 and graduated in 1970 with a BSc degree from Queens University in Belfast, Department of Applied Science and Technology, Electrical & Electronics Engineering Division. Mr Langfeldt started his career as a patent consultant in 1971 and joined Bryns Patentkontor (now Zacco Norway) in 1985. He has considerable expertise in the area of intellectual property rights, and particularly patent and design rights.

Mr Langfeldt has completed a number of courses in the areas of international patent rights and Norwegian intellectual property rights. He is president of the Association of Norwegian Patent Agents. Further, he is a member of the Norwegian Society of Chartered Engineers, NIR, FICPI, AIPPI, UNION and the Scandinavian Patent Attorney Society. Mr Langfeldt is a partner in Zacco A/S.

Zacco Norway is part of the Scandinavian group of companies Zacco A/S, which has offices in Copenhagen, Aarhus, Oslo, Trondheim, Stockholm, Skellefteå, Gothenburg and Malmoe.



Zacco Sweden AB

Sveavägen 151

Box 23101 SE-104 35, Stockholm, Sweden

Tel: +46 8 729 95 63

Fax: +46 8 31 83 15

www.zaccolegal.com

Helena Östblom

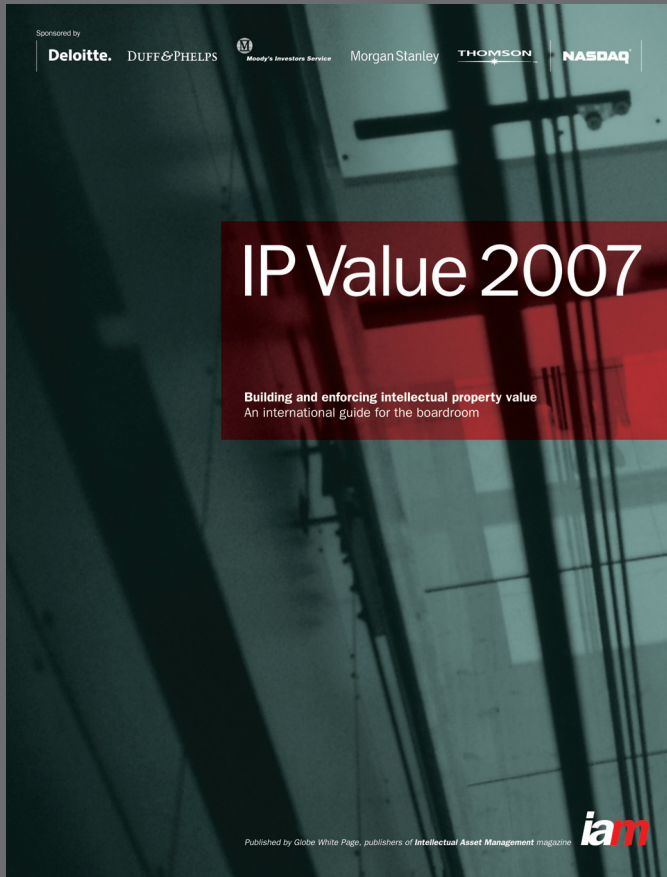
Attorney at law

heo@zacco.se

Helena Östblom has more than 10 years' experience in advising on legal matters relating to commercial law with special expertise in intellectual property law. She specialises in litigation relating to infringement of intellectual property rights such as trademarks, patents, designs and copyrights, as well as litigation regarding matters relating to the Marketing Practices Act. She also advises on other legal matters relating to intellectual property law, marketing law and competition law.

Helena Östblom graduated in 1989 with a master of laws degree from Stockholm University. She has worked as an assistant judge at the District Court of Västervik. Between 1991 and 1998 she was a member of the Swedish Bar Association and worked as a lawyer at Advokatbyrån Frie in Stockholm (merged with Gedda & Ekdahl Advokatbyrå 1997). She joined Zacco Sweden AB in 1999. In addition to her work as an attorney at Zacco Legal, Helena is the secretary of the board of the Swedish Anti Counterfeiting Group (SACG).

Zacco Sweden is part of the Scandinavian group of companies Zacco A/S, which has offices in Copenhagen, Aarhus, Oslo, Trondheim, Stockholm, Skellefteå and Malmö.



Now in its fifth edition,
**IP Value 2007 –
An international guide
for the boardroom**

is firmly established as the indispensable guide for all corporate professionals with an interest in IP – investors, board members, in-house counsel, finance officers and attorneys in private practice.

**Have you
got your
copy?**

Published in partnership with NASDAQ, Deloitte, Morgan Stanley, Moody's, Duff & Phelps, Thomson and over 70 leading law firms worldwide, it provides country-by-country analysis of the latest developments in IP protection in over 50 jurisdictions.

Separate sections by our international distribution partners detail key global IP tax, finance, investment and valuation topics. An extensive US section contains over 15 chapters focusing on a wide range of the latest issues affecting companies' ability to maximise and protect the value of their IP assets.

For more information, or to receive your own copy, please contact Gavin Stewart at gstewart@iam-magazine.com or on **+44 20 7234 0606**.

