

Special Features of Patent Disputes

including Litigation before National Courts

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Overview

Special Features of Patent Disputes

- Parties
 - ▶ Parties often competitors
 - ▶ Parties sometimes engaged in joint developments
- Issues
 - ▶ Technical nature of the issues (advanced technology)
 - ▶ International nature of the dispute
 - ▶ National nature of the jurisdiction of national courts
- Courts and procedure
 - ▶ Specialist courts usually set up by States
 - ▶ Specific ways for bringing evidence

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Parties often competitors (patent infringement actions)

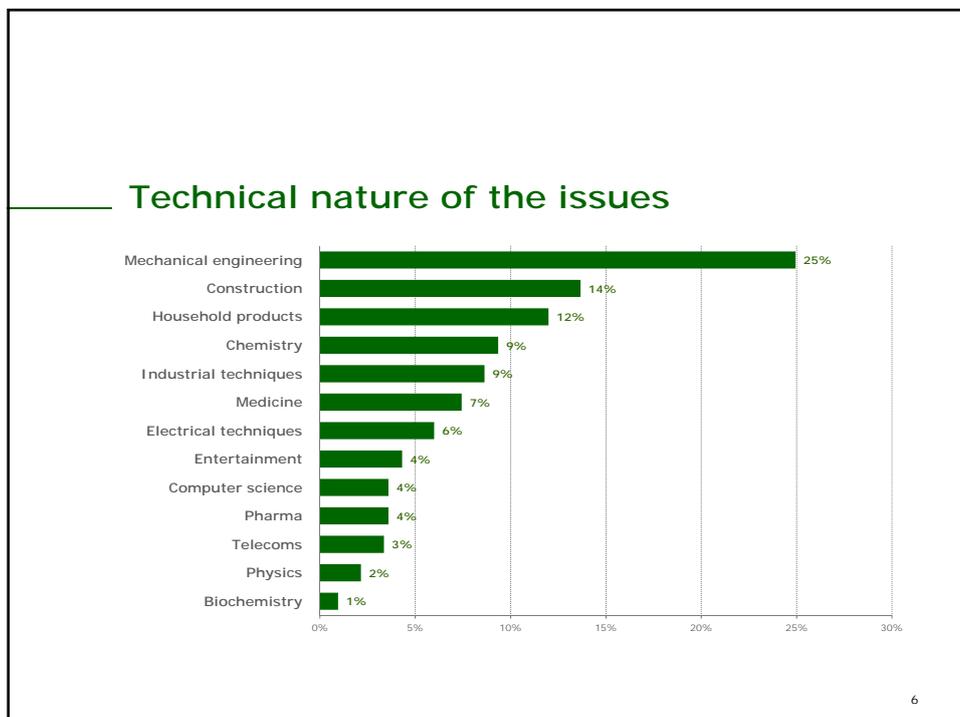
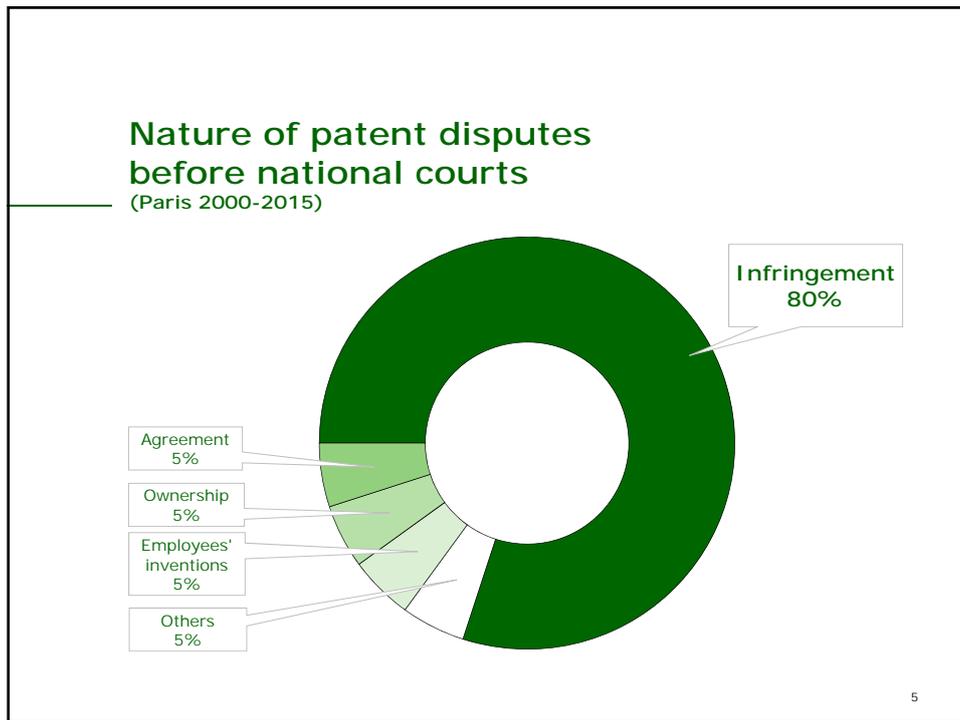
- Big Pharma v. Generics
- Apple v. Samsung
- Boeing v. Airbus
- FRAND disputes
(Fair, Reasonable and Non-Discriminatory royalty rates in the telecoms sector for the Standard Essential Patents)

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Parties sometimes engaged in agreements

- licence agreements
- joint developments

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International disputes, national courts

- Most of the patent disputes are international (the “same” patent is at stake in several countries)
- National courts are generally reluctant to deal with patents of other countries (territoriality of patents)
- Conflicting judgments may be handed down in different jurisdictions

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Conflicting judgments

Novartis v. Johnson & Johnson (contact lenses)



- **The Netherlands: patent valid and infringed**
11 February 2009 *Rechtbank Den Haag*
- **United Kingdom: patent invalid for insufficient disclosure (but meeting the novelty and inventive step requirements)**
10 July 2009 High Court
- **Germany: patent invalid for lack of novelty (but meeting the disclosure requirement)**
10 December 2009 *Bundespatentgericht*
- **France: patent valid and infringed**
27 October 2010 *Cour d'appel de Paris*

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Conflicting judgments

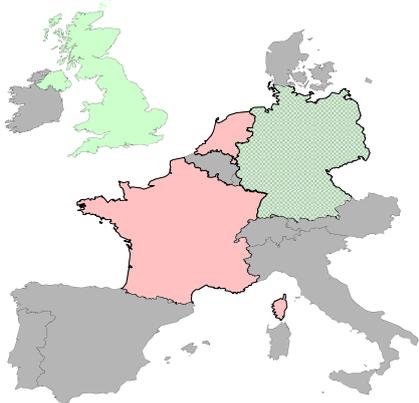
Novartis v. Johnson & Johnson (contact lenses)



Patent held invalid
novel but insufficiently disclosed

Patent held invalid
sufficiently disclosed but not novel

Patent held valid
and infringed



Conflicting judgments

MSD v. generics EP 0 724 444
(dosage regime of finasteride for the treatment of androgenic alopecia)



- **United Kingdom:**
 patent invalid in 1st instance
6 June 2007 High Court
 patent valid and infringed on appeal
21 May 2008 EWCA
- **Germany:** patent invalid
26 June 2008 Bundespatentgericht
- **France:** patent invalid
28 September & 9 November 2010 Tribunal de grande instance Paris, affirmed by the cour d'appel 30 January 2015
- **Spain:** patent invalid
Commercial court and court of appeal Madrid
- **The Netherlands:** patent valid and infringed
23 April 2014 Rechtbank Den Haag
- **Italy:** patent valid in 1st instance and case settled on appeal

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Conflicting judgments

MSD v. generics EP 0 724 444
(dosage regime of finasteride for the treatment of androgenic alopecia)



Patent held invalid

Patent held invalid (1st instance), valid and infringed (appeal)

Patent held valid and infringed (1st instance, no appeal reported)



International disputes, international arbitration

- International patent disputes (the “same” patent at stake in several countries) may be better dealt with by arbitration
- The parties may stipulate which law will be applicable and agree on procedural matters
- See two example cases A14 and A16 quoted on WIPO’s website
<https://www.wipo.int/amc/en/arbitration/case-example.html>

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International disputes, international arbitration (example case A16)

The parties may stipulate that a single law will be applicable for the whole dispute

*"Following litigation in several jurisdictions, two American companies agreed to submit to WIPO Arbitration a dispute related to the alleged infringement of a European patent concerning consumer goods. **The submission agreement provided that the national patent law of a particular European country would apply and that the patent litigation timelines of that country should be followed.**"*

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International disputes, international arbitration (example case A14)

The parties may also stipulate that different laws will be applicable to certain aspects of the dispute

"Following litigation in several jurisdictions regarding the alleged infringement of European and US patents protecting medical devices, a European company and an American company signed a settlement agreement including a WIPO arbitration clause.

The clause provided that infringement claims of US patents should be heard by a sole US arbitrator, and those relating to European patents by a sole European arbitrator. The clause further provided, that the awards issued by the European and US arbitrator could be subject to review through an appeal panel of three arbitrators."

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Specialist patent courts in most countries

- Specialist courts in first instance and on appeal, sometimes with *technically qualified judges*:
 - ▶ France, Germany, Italy, The Netherlands, United Kingdom, Switzerland, Japan, Korea
 - ▶ *Unified Patent Court*
- Specialist courts on appeal:
 - ▶ USA (Court of Appeals for the Federal Circuit)

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Specific ways for bringing evidence

- *Saisie-contrefaçon* or similar procedures of inspection of the alleged infringer's product and facilities available in several countries where no US style discovery exists (France, Italy, Germany, United Kingdom, Unified Patent Court)

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Thank you



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