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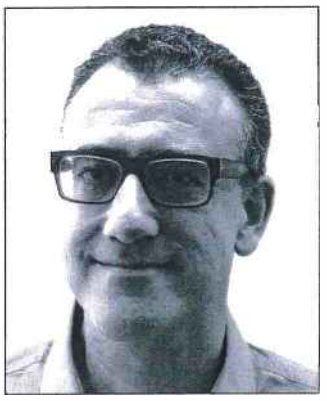

LIAD WHATSTEIN
Liad Whatstein & Co
Israel

COLM AHERN
Elzaburu
Spain

WWL: Are there any recent or imminent changes to patent law that have or will affect your practice?

Isabelle Romet: All patent practitioners will live a major change when the Unified Patent Court (UPC) opens at the end of 2016 or early 2017. This will be a unique experience and a major historical step forward. This revolution already requires intensive work to contribute to the elaboration of the system in order to make it as efficient as possible, assimilate these sets of new rules and test them with judges through mock trials, help our clients, worldwide, to define their future options and strategy.

Regarding French patent law, it was slightly modified by an act of 11 March 2014. The limitation period for acts of infringement was increased from three to five years. Customs measures very similar to those provided by European Regulation (EU) No. 608/2013 are possible against products coming from another European country since 18 April 2015.

Liad Whatstein: Israeli patent practice is characterised by a unique and complex patent term extension system which is based on multiple linkages to the shortest (in period and duration) PTEs/PSCs and to the earliest regulatory approval in recognised countries. The recent Amendment 11 entered in 2014 shortened the list of recognised countries from 21 to seven, but added several other provisions which may likely curtail eligibility for patent term extension. This is the third time the PTE provisions are revised since their inception in 2003. The revisions are mostly driven by generic pressure intended to limit PTE eligibility or duration. The most recent amendment was in fact prompted by a bilateral agreement between Israel and the US which aimed to somewhat mitigate the extensive pro-generic revision which took place in 2007. However, the legislative process eventually yielded, again, legislation which is biased against the innovation industry and likely to generate significant litigation in coming years to clarify some of the more obscure provisions of the novel legislation.

Colm Ahern: Although there are many different opinions as to how quickly the UPC will take off and to what extent rightholders will exercise their right to opt out, it is important to prepare for the more practical aspects of the new system. Many of the issues which currently dominate public debate such as fees and language will in the end only be remembered as teething problems. The new system requires a completely new breed of patent litigator who will feel comfortable appearing before courts in different countries, using different languages and who can adapt to rules that are different to those applying currently in each country. The procedure is largely front loaded which will be quite a challenge for practitioners from common law jurisdictions. Litigators will be required to be familiar with case law from many different European national jurisdictions if they are to survive in the very dynamic start-up phase where many different traditions will be merged. The analysis of scope of protection is still carried out quite differently by judges in London, Düsseldorf and Madrid despite the fact that they have all applied for many years the same rule which will be applied by the UPC. Counsel pleading before a panel of judges of mixed nationality will need to have an appreciation of where each one is coming from when an issue such as infringement hangs in the balance.

At national level, Spain will shortly have a new Patent Act which will replace the very successful 1986 Act, whose passage was one of the requirements for Spain's entry into the EU. It drew heavily on German doctrine and created a high degree of legal certainty, which has been complemented by a body of case law that is in line with best practice in Europe. The proposed new Act is evolutionary and contains no radical departures, but rather introduces improvements in both

prosecution and litigation. Substantive examination will now be obligatory for all patent applications. The anomaly of the local novelty requirement for utility models, which limited prior art to just Spanish disclosures, will be removed. The most significant changes are however procedural. The rules of territorial competence will bring most cases to those cities where specialist patent courts have been created. This has already happened in Barcelona and will probably happen soon in Madrid. Thus the de facto tendency of recent years for cases to be concentrated in these two cities will be accelerated. The new Act is expected to be approved by Parliament sometime in 2015.

WWL: In your jurisdiction, what do you feel are the main features of the court system that impacts the volume and outcome of patent disputes?

Isabelle Romet: Patentees have various good reasons to choose France for a patent infringement case. Saisie-contrefaçon procedure makes it possible to gather quickly and efficiently infringement evidence before starting the proceedings.

Non literal infringement is broader in France than in many other countries, as still recently shown by the decision of the Cour d'appel de Paris of 20 March 2015 finding infringement by equivalents in a case relating to helicopters, in favour of Airbus Helicopters.

The winning rate is reasonable: as far as French designations of European patents are concerned, over the period 2000-2014 and in first instance, patents were held valid in 77 per cent of the cases and about 43 per cent of the patents found valid were found infringed, which means a rate of success of 38 per cent for the patentee. The duration of proceedings in first instance has decreased to 18 months on average and may be shorter when necessary.

Some patentees complain about the low number of preliminary injunctions: this is because French judges do not want to take the risk of granting preliminary injunctions on the basis of a patent which would later be found invalid or not infringed; this approach also protects the patentees from the risk of high damages to be paid to the defendant to compensate for the profits lost due to a preliminary injunction.

Liad Whatstein: In fact, most patent litigation in Israel is conducted at the patent office level. Israel has a pre-grant opposition system – ie, oppositions automatically suspend patent grant. In addition, unlike EPO proceedings for instance, opposition proceedings at the IL PTO are equivalent to full-scale litigation. Among others, the parties submit evidence and written expert opinions and thereafter there are extensive hearings with oral cross-examination of the witnesses and experts. Therefore, opposition proceedings need to be conducted by experienced litigation counsel. On the other hand, the number of patent infringement proceedings that are heard by the courts is quite limited. Preliminary injunctions are available in infringement proceedings if the patentee shows a prima facie case and significant damages are likely as a result of the infringement. Ex parte injunctions and Anton Piller orders may also be available in appropriate circumstances. The approach of the courts is essentially favourable to innovators, whereas at the IL PTO one could arguably detect at times an inclination to judge patents with an overly formalistic or restrictive approach.

Colm Ahern: Spain has currently well over 100 patent cases a year which places it towards the higher end of the scale in Europe, dwarfed however by Germany which has well over a thousand. Surprisingly some of the largest countries in Europe have only around 50.

Spain has an exceptionally efficient if harsh procedural law which is probably the most front-loaded in Europe. All pleading and documentary evidence including expert reports must be filed along with the initial submission to the court, and are precluded thereafter. Although tough on attorneys and clients it does lead to faster, more efficient proceedings which are very cost-effective. Because judges already have practically everything before them in documentary form, trials typically last one or at most two mornings and are usually confined to hearing a strictly limited number of expert witnesses clarify their reports. Judgment on the merits can usually be obtained within 12 to 18 months.

In most cases patent owners can choose where to bring an infringement case, which will normally be in Madrid or Barcelona where high volume has led to very good predictability regarding the outcome. Combined with the speed of the procedure, this has made Spain a very attractive venue for patent litigation.

WWL: Respondents note that competition in the legal marketplace has generally increased. How has your practice evolved over the years to compete in today's market?

Isabelle Romet: It is true that competition has increased in the legal market place with the number of practitioners. Our motto remains excellence based on experience, rigorous work, personal commitment and a true team spirit. To be as efficient as possible, we decided to dedicate ourselves to patent litigation and to organise our team to cover the multiple facets of patent disputes: we became "100 per cent patent litigation".

For this purpose, we have developed a multidisciplinary team, including 12 attorneys-at-law, two scientific consultants (a professor of physics and chemistry and a doctor of pharmacy) and a network of high level scientists to help the attorneys-at-law to elaborate strong technical demonstrations, an economic litigation consultant to assess the financial stakes and calculate damages, a graphic designer to create all types of visual aids in support of our demonstrations and a team of legal translators; we keep on the lookout for cutting-edge technology.

Liad Whatstein: We strongly believe that the edge over the competition is first and foremost gained by the combination of litigation skills and scientific adeptness. Our lawyers have very strong and diversified scientific background. But most importantly, we always attempt to be creative on the scientific side

whether it relates to the development of the patentability narrative or proof of infringement. Our team among others utilises cutting-edge analytical methods, supervised complex experiments for patent litigation and devised novel approaches for global patent litigation. In conjunction of course with a high level of service and responsiveness, we consider that scientific savvy is the most important asset a firm can provide to its clients.

Colm Ahern: Although the technical complexity of patent cases poses challenges, it increases objectivity and predictability. To increase competitive edge it is necessary to concentrate significantly more of the effort and therefore cost for the client in the preparatory phase long before a decision to go to trial is taken. Unexpected weaknesses which are painful and costly when pointed out by a judge or an expert witness can often be foreseen and acted upon earlier. In patent cases this usually means having lawyers who combine legal and technical qualifications and who can get a good appreciation of the complexities at an early stage.

WWL: In an increasingly globalised market, how do you employ a successful network for the benefit of clients engaged in cross-border matters?

Isabelle Romet: Our firm has developed an open network of foreign attorneys-at-law and patent attorneys. We create tailor-made teams in each case considering its legal and technical specificities, as well as the wishes of our clients.

Liad Whatstein: We have been working with numerous law firms in many jurisdictions. We have developed very strong professional and personal relationships with leading professionals in most important jurisdictions. The relationship is candid and honest and is merit based. When a client needs cross-border support we are in a position to offer the right contacts depending on the client's technology, needs and resources. We always find the cooperation with additional firms from diverse jurisdictions to be a fruitful experience and we learn a lot by being exposed to different legal systems.

Colm Ahern: Patent cases which are confined to one country have become the exception rather than the rule. Cross-border litigation poses many challenges and requires an outward-looking approach with litigators who can work well in an international team, have good language skills and an appreciation of different legal systems and more importantly the interfaces between them. Issues such as extraterritoriality, jurisdiction, choice of law, possibility of discovery, use of foreign documents and witnesses all need to be carefully managed. But perhaps the greatest challenge is locating good quality local counsel which can be difficult if one is tied to one global supplier. This is where a large network built up over many decades can be decisive.

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Alex Wilson, partner, has an international practice, acting mainly in multi-jurisdictional IP matters. He regularly advises clients on Europe-wide patent enforcement and defensive strategies and coordinates their implementation. He has experience of arbitrations under International Chamber of Commerce and specific national rules.

Alex's background in the life sciences (BSc, biochemistry) makes him ideally placed to handle matters in the medical devices, biotechnology and pharmaceutical sectors. He also has a wealth of experience in telecommunications and electronics disputes involving standardised and implementation technologies. His fluency in French and German has allowed him to spend time working in leading law firms in Paris and Düsseldorf. He has also practised as a solicitor in Australia and as an examiner at the European Patent Office for a number of years.

He regularly supports and attends proceedings before the German Courts and is a recognised foreign expert in the German system (*Chambers Global*). He has also practised as a solicitor in Australia and as an examiner at the European Patent Office for a number of years. Alex has been a partner at Powell Gilbert since 2007. He is a member of AIPPI, EPLAW, GRUR and VPP. He regularly lectures on intellectual property matters at conferences and is the author of numerous articles on this subject.

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Admitted to the Paris Bar in 1994, Sabine Agé gained experience in the various intellectual property fields (patents, trademarks, designs), before dedicating herself exclusively to patent litigation when she became a partner of Véron & Associés at the creation of the firm in 2001.

Véron & Associés is a law firm of 14 lawyers, assisted by two scientific consultants, an economic litigation consultant, a graphic designer and translators, dealing exclusively with patent litigation for French and international clients.

Sabine handles standard related cases in the multimedia systems and telecommunications fields and has acted on behalf of an international telecommunications manufacturer for the French part of a worldwide cross-border patent litigation. She is also active in cases relating to pharmaceuticals, chemicals and medical instruments, for international and domestic industry-based clients as well as research organisations. She deals with legal issues extending from contractual disputes, patent ownership (and co-ownership) to validity and infringement.

Sabine lectures on patent litigation at the International Centre of Intellectual Property Studies (CEIPI) in Strasbourg and at the universities of Lyon and Montpellier, in addition to her speaking engagements for conferences.

Sabine Agé is an active member of the International Association for the Protection of Intellectual Property (AIPPI) and secretary to the European Patent Lawyers Association (EPLAW). She is also a member of IPO and AIPLA, through Véron & Associés.

Véron & Associés maintains close relationship with top-tier independent law firms in other jurisdictions, which can handle parallel proceedings in multi-jurisdictional cases.

She is co-author of *Saisie-contrefaçon*, published by the leading French publisher Dalloz and edited by Pierre Véron (third edition, 2012).

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Thomas Bouvet obtained an LLM in the USA and is a doctor-at-law. Admitted to the Bar in 1996, he specialised in intellectual property law and dedicates himself exclusively to patent litigation since he became a partner of Véron & Associés, at the creation of the firm in 2001.

Véron & Associés is a law firm of 14 lawyers, two scientific consultants (a professor of physics and chemistry and a doctor of pharmacy), an economic consultant, a graphic designer and translators, dealing exclusively with patent litigation for French and international clients.

Thomas handles patent validity and infringement disputes in most technical fields, notably electronics, telecommunications, media, mechanics, chemistry, pharmaceuticals, medical products and biotechnologies. He advised several pharmaceutical companies and a major French public medical research institute in patent entitlement cases, in actions of compensation for employees' inventions and advises companies setting up appropriate policies in this respect. Thomas handled plant breeder's rights litigation, including before the CPVO. He also handles trade secrets litigation.

Thomas lectures on patent litigation. He is a member of AIPPI (a member of the programme committee and co-chair of the standing committee on biotechnology and plant breeders' rights), GRAPI (currently president), and EPLAW. He is also an administrator of Centre Paul Roubier. The firm is a member of IPO and AIPLA.

Thomas is the author of a doctoral thesis, "The Legal Protection of Vegetal Innovation", and co-author of *Saisie-Contrefaçon*, from leading French publisher Dalloz (third edition, 2012), and *Droit et Pratique des Voies d'Exécution* published in the Dalloz Action series 2013–2014. He contributed to *Global Patent Litigation: How and Where to Win*, published by Bloomberg BNA (2014).

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The practice of Julien Fréneaux, Dipl CEIPI Brevets, DESS, Sciences-Po, comprises advice and litigation in all matters of intellectual property, in particular patent infringement and validity litigation before the French courts, as well as trademark, design and unfair competition matters, licensing, technology transfer agreements and IP-related contracts.

The cases that Julien Fréneaux handles regularly involve coordination with teams of lawyers from other jurisdictions as well as with parallel litigation proceedings in different countries in a complex international litigation framework. He represents international as well as French corporate clients in patent infringement and nullity cases before the various French courts.

Julien Fréneaux has managed many multinational patent conflicts concerning technologies such as medical devices, sports equipments and mechanical engineering. He also handles a number of fashion design infringement cases.

Julien Fréneaux has published a number of articles on various IP topics.

He is admitted to the Paris Bar and heads the Paris office of Bardehle Pagenberg.

Recommendations include *Leaders League*, 2011, the 2015 edition of *Who's Who Legal: Patents* and *MIP (IP Star) France*, since 2014.

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Isabelle Romet is entirely dedicated to patent litigation, as are the 13 other lawyers of the firm. Admitted to the Bar in 1988, she began working with Pierre Véron immediately afterwards. She is a co-founder of the firm Véron & Associés in 2001, with Pierre Véron, Thomas Bouvet and Sabine Agé.

Her practice focuses on patent validity and infringement in most technical areas, especially in complex technological fields and in an international context. A team player, she points out the importance of the firm's scientific consultants who assist the lawyers to build a strong technical reasoning and design the best visual aids with the in-house graphic designer. The economic litigation consultant allows the clients to assess the financial stakes of the case at all stages.

She has handled landmark cases relating to cosmetics, pharmaceuticals, ophthalmology, nanotechnology, diagnosis, genetically modified plants and veterinary products. Her expertise in pharmaceutical patents goes with a focus on supplementary protection certificates. Green technologies are a growing activity. She remains active in mechanics, electricity and electronics.

Convinced by the interest of alternative dispute resolution, she participated in mediations and negotiations that led to major settlements.

She lectures on patent litigation at Sciences Po, Paris, various intellectual property centres (such as Centre Paul Roubier), international conferences and private seminars. She is a member of AIPPI, EPLAW, LES and, through Véron & Associés, IPO and AIPLA. She is a co-author of the book *Saisie-Contrefaçon*, published by leading French publisher Dalloz and edited by Pierre Véron (third edition, 2012).

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PierreVéron is a member of the Paris Bar.

His 14-lawyer firm, with offices in Paris and Lyon, deals solely in patent litigation, with a special emphasis on international cases. Between 2006 and 2015 it was named 7 times French Law Firm of theYear at the Managing Intellectual Property Awards; it obtained the Décideurs Award for the Best Intellectual Property Law Practice in France in 2003, 2007, 2009 and 2014.

PierreVéron is the honorary president of the European Patent Lawyers Association (EPLAW), which he founded in 2001 and of the French association of patent litigators. He has taught European patent litigation at the International Centre of Industrial Property Studies (CEIPI) in Strasbourg. Between 2007 and 2012 he served as an expert with the European Commission for the creation of the Unified Patent Court in Europe. He has then been a member of the drafting committee of the Rules of Procedure of this court. He now serves as an expert in the Expert panel advising the Preparatory Committee of the Unified Patent court.

PierreVéron is the editor of *Saisie-Contrefaçon*, from the leading French publisher Dalloz (third edition, 2012), and *Concise International and European Intellectual Property Law*, published by Kluwer Law International (third edition, 2014). He is also the author of more than 70 other publications on patent litigation.

A former president of an arbitration centre and a former associate of the Chartered Institute of Arbitrators, he has been involved in several arbitration proceedings, either as counsel, arbitrator or chairman of the arbitration panel.

Véron & Associés maintains a statistical study on patent litigation in France. The latest report concerns the years 2000 to 2009, and follows on from a previous study spanning the years 1990 to 1999. Both can be found on the firm's website.

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