EURO LAW CONFERENCE 2016

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Euro Law Course 2016

Workshop on the Invalidation of Patents in various European Countries

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Invalidation of Patents in various European Countries

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<th>Example Case – Facts</th>
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Example Case – Facts

Procedure in UK, NL, IT, FR, BE, ES, SE, DE

Example Case – Results

Outlook – Revocation action before the UPC
EXAMPLE CASE – CALCIPOTRIOL MONOHYDRATE
• LEO Pharmaceuticals (Patentee) owns EP Patent ‘154 directed to Calcipotriol monohydrate
• LEO also owned two (expired) patents directed to Calcipotriol per se (D5) and new formulations/uses including a W/O cream formulation of Calcipotriol (D4).
• After expiry of these earlier patents, Sandoz wanted to market its own ointment and cream products containing Calcipotriol
• Sandoz bought solid anhydrous Calcipotriol from a supplier and put it into its own ointment and cream formulations
• Leo tested these formulations and, to the surprise of Sandoz, found a small amount of monohydrate crystals
• Leo sent a warning letter to Sandoz
THE ARGUMENTS (I)

- Sandoz argued that (a) it did not use Calcipotriol monohydrate and (b) that it just reproduced the teaching of the prior art (D4), since its cream formulation was extremely similar to the one of D4.
- Infringement and nullity lawsuits ensued in UK, NL, DE, IT, SE.
- Sandoz counterclaimed that EP ‘154 is invalid for lack of novelty over D4 and lack of inventive step over D4 or D5 in combination with any of D8-D10, each disclosing stable monohydrates of other vitamin D3 derivatives.
THE ARGUMENTS (II)

• Sandoz’ novelty attack was based on inherent formation of Calcipotriol monohydrate when reproducing the teaching of D4. Evidence was provided by various experimental reports, putting anhydrous Calcipotriol of various manufacturers into the cream formulation of D4 and finding monohydrate after storage at room temperature.

• Leo argued that this Calcipotriol used by Sandoz was not the same Calcipotriol as the one available at the priority date (different impurity profile, method of preparation etc.)

• Sandoz counter-argued that whichever anhydrous Calcipotriol they used, the result was always monohydrate. A de novo synthesis of Calcipotriol according to D5 would involve 22 steps and take a very long time.

• Leo argued that no predictions of monohydrate formation were possible and that anhydrous Calcipotriol had no real stability problem.
OBJECTIVES OF THIS WORKSHOP

• To show you how this lawsuit unfolded or might have unfolded in various important EP countries
• To make you acquainted with the court systems and the key features of invalidation proceedings in NL, UK, IT, FR, ES, SE and DE.
• To inform you about the current state of play in this lawsuit which is still ongoing in one country
• To present and compare the court systems and the results
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TYPES OF ACTION IN WHICH VALIDITY MAY BE CHALLENGED IN THE UK

- Petition for revocation
- Counterclaim in infringement action
- Other opportunities
  - “threats” action
  - declaration of non-infringement
  - disputes concerning government use

Note:

- These types of action apply to both UK patents and European patents (UK)
- Revocation and infringement are decided by the same forum in the UK
• Petition for revocation can be filed at any time after notice of grant has been published in the Patents Journal

• Petition can be filed even after the patent has lapsed or expired

• Petition can be filed even if the patent has been opposed at the EPO
POSSIBLE FORA TO CHALLENGE VALIDITY

- UK Intellectual Property Office (UK-IPO)
- Patents Court (Part of High Court)
- Intellectual Property Enterprise Court (Part of High Court)
  - previously called the Patents County Court
• Essentially a written procedure
• Usually no discovery or cross-examination of witnesses
• Cheapest forum
• Cases typically conducted by UK Patent Attorneys
• Cases decided by a UK-IPO Hearing Officer
• Limited exposure to costs for the losing party
• One judge (selected from a group of experienced patent judges)

• Comprehensive procedure: discovery, experiments, expert witnesses, cross-examination of expert witnesses

• Full legal teams (barristers, solicitors, patent attorneys)

• Fast: Typical time to trial is 9-15 months

• Expensive & significant cost exposure if case lost
INTELLECTUAL PROPERTY ENTERPRISE COURT

• Originally set up to provide a quicker and cheaper alternative to the Patents Court – for cases of moderate commercial value

• Cases can be conducted by Patent Attorneys

• Front-loaded, streamlined procedure – detailed pleadings at the start; more involvement of the Judge to guide the procedure

• No discovery; documentary disclosure at Judge’s discretion

• Evidentiary issues (experiments, survey evidence etc.) require Judge’s approval

• Cap on damages (£ 500K) and cost recovery (£ 50K)
THE CURRENT SITUATION

• UK-IPO a good choice for small companies and straightforward cases

• IPEC well-suited for disputes of lower commercial value, or where costs are to be limited

• Patents Court is the forum of choice for high-value cases and complex cases
• Expert witness evidence very important in UK Patents Court proceedings

• Typically provide evidence to establish things such as: what a person skilled in the art would understand a claimed feature to mean; common general knowledge in the field of the patent at its priority date; experiments show that the teaching of the prior art leads to the invention or the invention cannot be carried out; etc.

• Cases can be won and lost solely on the evidence of an expert
# Invalidation of Patents in various European Countries

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Types of Action in Which Validity May Be Challenged in the NL

- Nullity action claiming invalidity
- Counterclaim in infringement action
- Subclaim in Entitlement proceedings
- In summary proceedings: as defence only

Note:

- For NL patents issued by the Dutch Patent Office there is a different procedure
- Revocation and infringement are decided by the same forum in the same proceedings
• Petition for revocation can be filed at any time after notice of grant has been published in the Patents Journal

• Petition can be filed even after the patent has lapsed or expired

• Petition can be filed even if the patent has been opposed at the EPO
• The District Court of The Hague has exclusive and explicit jurisdiction to resolve patent disputes
APPEALS

Supreme Court

Court of Appeal

District Court of The Hague

Only legal considerations
(1 - 3 years)

Legal considerations and facts
(1 - 2 years)
Accelerated regime: (requested ex parte)
- decision ca. 1 year from filing
- front-loaded (all evidence together with comprehensive and detailed writ)
- dates fixed in advance
- one round of correspondence before hearing

Regular regime:
- decision 1½-2 years from filing
- dates determined as proceedings progress (extensions of terms readily granted)
- two rounds of written submissions before hearing
- possible that Court orders parties to attend an interim session in the Court
Accelerated regime: (requested ex parte)  
- For IP cases only  
- introduced September 1, 2012  
- short deadlines, short documents  
- restricted review  
- appointment of case managing judge, who in consultation with the parties, specifies time frame  

Regular regime:  
- Time frame of more than 2 years is not unusual  
- dates determined as proceedings progress (extension of terms readily granted)  
- full review
• Expert opinions in written form

• Hearing experts is possible (exceptional, not the rule)

• If expert will attend, parties need to announce 4 weeks before hearing

• NL applies the Problem-Solution Approach

• Court takes (Enlarged) Board of Appeal decisions of the EPO into account

• Judges are specialized in IP matters (background in science/technology is not unusual)
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TYPES OF ACTION IN WHICH VALIDITY MAY BE CHALLENGED IN IT

- Nullity action **claiming** invalidity
- Counterclaim in infringement action

Note:

- These types of action apply to both IT patents and European patents validated in Italy.
- Revocation and infringement are decided by the **same** forum.
• Petition for revocation can be filed at any time (before or after grant)
• Petition can be filed even after the patent has lapsed or expired
• Petition can be filed even if the patent has been opposed at the EPO

➢ No administrative invalidation proceedings are available before the Italian Patent Office.
➢ Nullity actions must be started before an Italian national court!
- Lack of jurisdiction
- Violation of the law

- 9 IP specialized courts are established in the main Italian cities (Milan and Turin the most popular/experienced IP courts)
• To be started with a writ of summons in which the following is to be identified:

✓ the counterpart
✓ the IP right to be enforced/revoked and the contested product/s (in infringement proceedings)
✓ evidence and grounds of invalidity/infringement
The judging panel is composed of three legally qualified judges with no technical background.

A Technical Court Expert (CTE) is normally appointed (in 95% of the cases) to assess validity (or infringement).

Only attorneys at law can conduct the hearings!!

...but patent attorneys discuss in writing and in meetings the technical details of the case (validity/infringement); and contribute to the preparation of the legal briefs.
During the CTE-phase it is possible to present new evidence provided that they are related to the questions posed by the Judge.

CTE opinion normally followed by the Judge!!!

.... but parties can challenge CTE's conclusions before the Judge...
Technical briefs are prepared by patent attorneys!

High number of patents/collectiong evidence (tests, inspections, etc.) may lengthen this phase

Choice of CTE important: technical understanding, timing, experience, objective and reasonable person
NULLITY IN THE FIRST INSTANCE LITIGATION

**Nullity action**

- Writ of summons
- Defence brief
- 1st hearing
- 90 dd
- Exchange of legal briefs (6/9 m)
- Court Expert appointed by the Judge (hearing)
- Technical expertise phase (~6 months)
- Discussing Report of Court Expert (hearing)
- Final exchange of legal briefs (6/12 m)
- Decision (~2/2.5 y)

**Nullity as counterclaim in infringement action**

- Writ of summons
- Defence brief with counterclaim
- 1st hearing
- 90 dd
- (similar as in the nullity action)

End of CTE phase
• Normal duration: about 2 years
• New prior art and a further Court Technical Expertise are rarely admitted at this stage
• Further appeal to the Corte di Cassazione (Supreme Court, 3rd instance) only on points of law
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• No administrative invalidation proceedings are available before the French National Institute of Industrial Property (INPI)

• A nullity claim must be filed through judicial action

• The available judicial actions apply equally to FR national patents and FR parts of EP patents

• Voluntary limitation proceedings may be initiated before the INPI, for national FR patents and FR parts of EP patents
POSSIBILITY 1: NULLITY ACTION

- The judicial action is initiated with the nullity claim

- Very rare configuration in France (less than 5% of all patent disputes, when infringement is not counterclaimed)

- Two essential requirements:
  - An interest in taking legal action ("Intérêt à agir") must be demonstrated
  - Statute of limitation (period of prescription): The action must be initiated at the latest 5 years of the date at which the grounds for nullity should have be known (like for any other civil actions)
POSSIBILITY 2: INFRINGEMENT ACTION

- The judicial action is initiated with an infringement claim, in reply to which a nullity counterclaim is filed.

- Usual configuration in France (infringement actions represent more than 80% of all patent disputes).

- Infringement and validity are addressed during the same court proceedings.

- Interest in taking nullity action ("Intérêt à agir") automatically acknowledged with regard to those of the claims on which the infringement action is based.
Cour de Cassation  
*Supreme Court for Civil Matters*

Cour d’appel de Paris  
*Court of Appeal*

Tribunal de Grande Instance de Paris  
*1st instance Court*

*Ratione loci* competence: since October 2009, only one civil court competent with regard to first and second instance patent disputes: Paris
• First instance: Tribunal de Grande Instance de Paris
  ➢ Four panels of three non-technical judges
  ➢ Assessment in fact and in law
  ➢ Duration: 1 ½ – 2 years
  ➢ Technical experts may be used; if so: add 1 – 2 year “expertise”

• Second instance: Cour d’appel de Paris
  ➢ Two panels of three non-technical judges
  ➢ Procedurally similar to the first instance
  ➢ New arguments and pieces of evidence (e.g. new prior art) can be submitted – de novo review
• **Cour de cassation**
  - Remittal in appeal (~ 20-30 % of cases)
  - Assessment in law **only**
  - Non-suspensive, duration: 1 - 2 years

• **Legal costs ( ≠ damages):**
  - average of EUR 15.000 to EUR 300.000 for a first instance decision
  - no administrative fee, but attorney costs

• **Total duration of the litigation:** 3 – 8 years
Outcome of patent cases (*Paris 1\textsuperscript{st} instance court*)

- 40% Patents held invalid
- 27% Patents valid* and infringed
- 33% Patents valid* and not infringed

* Maintained in granted or amended form
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Grounds of Nullity under the Spanish patent law

• In force until March 31, 2017: Spanish patent law of 1986

• Grounds of Nullity (Art. 112 Law 11/1986):
  
  a) the subject-matter of the Spanish patent is not patentable
  b) the Spanish patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art
  c) the subject-matter of the Spanish patent extends beyond the content of the application as filed
  d) the proprietor of the Spanish patent is not entitled
Grounds of Nullity under the Spanish patent law

• The new Spanish patent law (April 1, 2017) provides for the following grounds of nullity (Art. 102(1) Law 24/2015):

  a) the subject-matter of the Spanish patent is not patentable
  b) the Spanish patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art
  c) the subject-matter of the Spanish patent extends beyond the content of the application as filed
  d) the protection conferred by the Spanish patent has been extended
  e) the proprietor of the Spanish patent is not entitled
Who may file a Nullity Complaint in Spain?  

Art. 103(1) Law 24/2015

A nullity complaint ("demanda") may be filed by:

- Any person who considers that he/she has suffered prejudice

Who is this? - Wide attribution to the legitimacy to file a nullity action – exception: Art. 102(1)(e) Law 24/2015
Who may file a Nullity Complaint in Spain?  

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A nullity complaint ("demanda") may be filed by:

- Any person who considers that he/she has suffered prejudice

Who is this? - Wide attribution to the legitimacy to file a nullity action – exception: Art. 102(1)(e) Law 24/2015

AGAINST

- The registered patent proprietor
When should the Nullity Complaint be filed? Art. 103(2) Law 24/2015

It may be filed all along the legal life of the patent and five years after its expiry.
Where should the Nullity Complaint be filed? – Art. 118 Law 24/2015

- **1st Instance**: Juzgado de lo Mercantil (Commercial Court)
- **2nd Instance**: Audiencia Provincial (Provincial Court)
- **3rd Instance**: Tribunal Supremo (Supreme Court)
**Where** should the Nullity Complaint be filed? – Art. 118 Law 24/2015

- **1st Instance:** *Juzgado de lo Mercantil* (Commercial Court)

Place of jurisdiction depends on the seat of patent proprietor
Where should the Nullity Complaint be filed? – Art. 118 Law 24/2015

- 1st Instance: *Juzgado de lo Mercantil* (Commercial Court)

Place of jurisdiction depends on the seat of patent proprietor

If non-Spanish patent proprietor

Place of residence of the „*authorized representative*“ in Spain to act in the name of the patent proprietor
**Where** should the Nullity Complaint be filed? – Art. 118 Law 24/2015

- **1st Instance:** *Juzgado de lo Mercantil* (Commercial Court)

Place of jurisdiction depends on the seat of patent proprietor

- If non-Spanish patent proprietor
  - Place of residence of the authorized representative in Spain
  - Otherwise

It can be chosen freely by the plaintiff
Where should the Nullity Complaint be filed? – Art. 118 Law 24/2015

- **1st Instance:** *Juzgado de lo Mercantil* (Commercial Court)

The new patent law **requires** the existence of specialized patent courts

For the time being, the only patent-specialized commercial courts in Spain are Courts 1, 4 and 5 in Barcelona
Where should the Nullity Complaint be filed? – Art. 118 Law 24/2015

- **1st Instance:** *Juzgado de lo Mercantil* (Commercial Court)

The new patent law **requires** the existence of specialized patent courts.

For the time being, the only patent-specialized commercial courts in Spain are Courts 1, 4 and 5 in Barcelona.

In practice, only Courts 1, 4 and 5 in Barcelona?
How should the Nullity Complaint be filed?

- All proceedings take place in **Spanish** language (including all documentation, reports from experts, hearing of experts/witness...)
- Courts in Spain are formalistic and terms cannot be extended for the parties, so it is important to be prepared in advance
How should the Nullity Complaint be filed?
How should the Nullity Complaint be filed?

Art. 119 Law 24/2015

Nullity (as counterclaim, in the same judicial process, MOST COMMON)
THE FIRST INSTANCE

- As soon as the court declares that an action is admissible, it would serve the statement of claim to the defendant.

- Patent proprietor is notified directly (current practice) to the registered address (important to keep the register updated!), and the proprietor must then respond on the merits within 2 months (expert reports can be submitted later under certain conditions).

- If the registered address does not exist, or the notification could not be performed with all its legal effects, the notification is made through a public announcement.

- The patent proprietor can limit the patent by renouncing to one or more claims or by amending the claims → 2 months for the reply.
Preliminary hearing

- Formal matters
- Parties are invited to explain the issues where both parties disagree
- Determination of suitable evidence (important!)
- Date for trial is set

Trial ("juicio oral")

- Taking of evidence, in particular hearing of the experts (cross-examination!), possibly also witnesses and/or the parties themselves
- Parties‘ lawyers present their conclusions on the debated facts
- No patent attorneys! (unless patent attorneys act as expert witnesses)
- A Power of Attorney shall be ready at the time of filing the writ or response
THE FIRST INSTANCE

- Technical expert reports are **very important**, since judges rely heavily on opinions issued by independent technical experts – appointed by the parties and/or by the court.

- The technical expert must prove that he/she is an expert in the relevant technical field and is cross-examined by the parties’ lawyers at trial.

- The technical expert can be a patent attorney who, however, must be neutral (even if appointed by a party, and not by the court).
The judge or the court may order the Spanish Patent and Trademark Office to issue a (non-binding) written opinion on those particular points where the expert reports submitted by the parties are contradictory (Art. 120(7) Law 24/2015).
THE FIRST INSTANCE

The judge or the court may order the Spanish Patent and Trademark Office to issue a (non-binding) written opinion on those particular points where the expert reports submitted by the parties are contradictory (Art. 120(7) Law 24/2015)

Opposition proceedings at the EPO in principle do not result in the stay of the proceedings before the Spanish courts
THE FIRST INSTANCE

• Judgment within **5 days of trial** (term is usually not met)

• **Overall duration** of first instance very variable (some courts are fast, some extremely slow)

• In **Madrid** it is usually 4 years, whereas in the specialized courts in **Barcelona** it is usually 2 years
• Appeal must be filed to the Provincial Court within 20 days from notification of the first instance decision

• The Provincial Court decides the case on the basis of the evidence submitted to the court of first instance (new evidence accepted only under exceptional circumstances)

• Appeals are normally heard relatively quickly, and a decision would typically be handed down 1.5 years from lodging the appeal
THE THIRRD INSTANCE

• A last appeal can be filed with the Tribunal Supremo (Supreme Court) (rarely done)

• Two different appeals are possible:
  • **Appeal for Cassation** (an appeal denouncing breach of law and/or case law)
  • **Extraordinary appeal** due to breach of procedure
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Overview

Infringement and validity can be addressed in the same court proceeding
  • nullity proceedings are often commenced as a counter-claim to an infringement action
First instance: Patent and Market Court (as of 1.9.2016)
  • Division of Stockholm District Court (Tingsrätt)
Second instance: Patent and Market Appeal Court
Third instance: Swedish Supreme Court
NULLITY PROCEEDINGS IN SWEDEN
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The "Dual Track System" of Patent Litigation
First Instance Proceedings (Deviations possible!)

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<td>Formal Objection of Defendant</td>
<td>1 m</td>
</tr>
<tr>
<td>Full Response of Defendant</td>
<td>4 m</td>
</tr>
<tr>
<td>Further Briefs by the Parties (optional)</td>
<td>12 m</td>
</tr>
<tr>
<td>Preliminary Opinion by the Court</td>
<td>16 m</td>
</tr>
<tr>
<td>Final Briefs by the Parties</td>
<td>18 m</td>
</tr>
<tr>
<td>Oral Hearing with Decision</td>
<td>20 m</td>
</tr>
<tr>
<td>Service of Written Decision</td>
<td>24 m</td>
</tr>
</tbody>
</table>
THE FIRST INSTANCE COURT: BUNDESPATENTGERICHT

Federal Patent Court
BASIC FEATURES OF NULLITY PROCEEDINGS IN GERMANY

The First Instance Decision

![Graph showing the first instance decision trends from 2010 to 2015. The graph compares different outcomes such as total revocation, revoked in part, maintained as granted, and revoked in toto or in part.]

- **Total Revocation**
- **Revoked in Part**
- **Maintained as Granted**
- **Revoked in toto or in part**
Costs of the First Instance

• The losing party must refund a part of the prevailing party's costs and pay the Court fee
• Refundable costs depend on the value of the matter in dispute (value of the patent)
• This value is set by the Court, usually with parties' consent
• Total cost risk: A party’s own costs + refundable fees of winning party + court fees
• Typical range of costs: 20,000 – 150,000 €
Bundesgerichtshof (Karlsruhe)
Federal Court of Justice
The Second Instance Court: Federal Court of Justice
Concept of Nullity (Appeal) Procedure

- Facts should mainly be explored and appraised in first instance
- FCJ should act as a true appeal instance and mainly check correctness of first instance decisions
- FCJ does not normally call in a court expert
- FCJ may (and does) remit the case to the first instance, if further questions of fact or technical questions still need to be resolved
Costs of the Second Instance

- The losing party must refund a part of the prevailing party's costs and pay the Court fees (can be quite substantial)
- Refundable costs and Court fees depend on the value of the matter in dispute (value of the patent)
- This value is set by the Court, usually same value as in the first instance
- Total cost risk: A party’s own costs + refundable fees of winning party + Court fees
- Typical range: 100,000 – 400,000 € for most cases
Invalidation of Patents in various European countries

Example Case – Facts

Procedure in UK, NL, IT, FR, BE, ES, SE, DE

Example Case – Results

Outlook – Revocation action before the UPC
England

• Preliminary Injunction granted by first instance
• Leave for Appeal granted by Court of Appeal with promising brief reasoning
• Appeal rejected and injunction maintained
• Main reasons: Status quo before infringement should be preserved. Patentee had to give cross-undertaking for damages caused by the injunction

Italy

• Preliminary Injunction denied by first instance judge
• Preliminary Injunction granted on appeal by full panel court
England
- Infringement and Validity heard together and affirmed by Floyd J. Patent maintained.
- Appeal dismissed by Jacob LJ.

Italy
- Infringement and validity denied by Court of Turine.
- Appeal allowed and patent revoked. Further appeal pending.

Netherlands
- Patent held valid and infringed by first instance court
- Appeal allowed and patent revoked.
- Further appeal on a point of law dismissed.

Germany
- Federal Patent Court revoked patent for lack of inventive step
- Federal Court of Justice agreed and dismissed the appeal, i.e. patent was revoked by a final decision.

Sweden
- Stockholm Tingsrätt held patent valid and infringed. No appeal.
Germany / Italy / NL

Inventive step denied, since the skilled person was motivated to look for hydrates for various reasons (safety, regulatory, improving stability) and would have found them, following analogous processes as disclosed for very similar vitamin D derivatives (D8-D10) to produce a stable monohydrate.

England / Sweden

UK: D8-D10 not introduced in the proceedings. Judge was not convinced that skilled person would have found monohydrates

NL: 1st instance court opined that these derivatives „differ essentially“ in structure from calcipotriol and a skilled person could therefore not predict whether calcipotriol forms a monohydrate. 2nd instance reversed.

SE: patent was to solve a specific foaming problem of a crystal suspension for which there was no pointer in the prior art.
Invalidation of Patents in various European countries

Example Case – Facts

Procedure in UK, NL, IT, FR, BE, ES, SE, DE

Example Case – Results

Outlook – Revocation action before the UPC
First Instance: Court of First Instance
Second Instance: Court of Appeal

Referral of questions of EU Law to CJEU is possible and encouraged (Art. 21, 38 UPCA)
Art. 33 UPCA

(3) A counterclaim for revocation (...) may be brought in the case of an action for infringement (...). (...) 

[The local or regional division has the discretion either to proceed or to refer the case to the central division.]

(4) [Revocation actions] shall be brought before the central division. If, however, an action for infringement as referred to in Article 32(1)(a) between the same parties relating to the same patent has been brought before a local or a regional division, these actions may only be brought before the same local or regional division.
Art. 7 UPCA

(1) The Court of First Instance shall comprise a central division as well as local and regional divisions.

(2) The central division shall have its seat in Paris, with sections in London and Munich. The cases before the central division shall be distributed in accordance with Annex II, which shall form an integral part of this Agreement.
<table>
<thead>
<tr>
<th>LONDON Section</th>
<th>PARIS Seat</th>
<th>MUNICH Section</th>
</tr>
</thead>
<tbody>
<tr>
<td>President's Office</td>
<td></td>
<td></td>
</tr>
<tr>
<td>(A) Human necessities</td>
<td>(B) Performing operations, transporting</td>
<td>(F) Mechanical engineering, lighting, heating, weapons, blasting</td>
</tr>
<tr>
<td>(C) Chemistry, metallurgy</td>
<td>(D) Textiles, paper</td>
<td></td>
</tr>
<tr>
<td>(E) Fixed constructions</td>
<td>(G) Physics</td>
<td></td>
</tr>
<tr>
<td>(H) Electricity</td>
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</table>
Who will decide? First Instance Answer Level 5 (a)

ANNEX II

EUROPEAN PATENT SPECIFICATION

Date of publication and mention of the grant of the patent: 29.05.2013 Bulletin 2013/22

Application number: 10010432.2

Date of filing: 30.08.2002

Method, tool and device for measuring concentration
Verfahren, Werkzeug und Vorrichtung zur Messung der Konzentration
Procédé, outil et dispositif pour mesurer la concentration

Designated Contracting States: AT BE BG CH CY CZ DE DK EE ES FI FR GB GR IE IT LI LU MC NL PT SE SK TR


Date of publication of application: 08.06.2011 Bulletin 2011/23

Document number(s) of the earlier application(s) in

References cited:

WO-A-01/57510
US-A- 4 545 382

• MORRIS N A ET AL: "AN ELECTROCHEMICAL CAPILLARY FILL DEVICE FOR THE ANALYSIS OF GLUCOSE INCORPORATING GLUCOSE OXIDASE AND RUTHENIUM (III) HEXAMINE AS MEDIATOR" ELECTROANALYSIS, VHC PUBLISHERS, INC, US, vol. 4, no. 1, 1 January
who will decide? first instance answer level 5 (b)

rule 17(3) rop

3. the following shall determine the distribution of actions between the seat of the central division and its sections.
(a) where an action involves a single patent having a single classification, the registry shall allocate the action to the seat or the section of the central division appropriate to the classification of the patent according to annex ii of the agreement. the registry shall assign the action to a panel in accordance with rule 345.3.
(b) where an action involves more than one patent and a majority of the patents have a single classification appropriate to the seat or a single section of the central division according to annex ii of the agreement, the registry shall allocate the action to the seat or that section of the central division. the registry shall assign the action to a panel in accordance with rule 345.3.
(c) where neither paragraph (a) nor (b) applies, especially where
(i) the action involves a single patent having more than one classification or
(ii) where the action involves more than one patent and no majority of the patents have a single classification corresponding to the seat or to one of the sections of the central division,
the registry shall assign the action in accordance with rule 345.3 to the panel at the seat or the section appropriate to the first classification of either the single patent or, where the action involves more than one patent, the patent first listed in the statement of claim, according to annex ii of the agreement. if the presiding judge of the respective panel considers that the reference of the action is appropriate, he shall accept it. if he considers otherwise, he shall instruct the registry to refer the action in accordance with rule 345.3 to the presiding judge of a panel of either the seat or the other section of the central division he considers appropriate, who shall likewise consider whether the re-allocation of the action is appropriate. if that presiding judge considers otherwise, he shall inform the president of the court of first instance, who shall allocate the action to the seat or the section of the central division he considers appropriate. the registry shall assign the action to a panel in accordance with rule 345.3.
Who will decide?

Distribution of actions between the seat of the central division and its sections

- If there is only one IPC - apply Annex II of the Agreement.
- If Multiple IPCs – check whether there is a majority of IPCs.
  - If there is a majority, then apply Annex II to the majority IPC.
  - If there is no majority, then:
    - If there is just one patent, first classification decides.
    - If there are multiple patents, patent first listed in statement of claim decides.
Maximum Territorial Scope of Judgment (Status 09.05.2016)

Yellow: out - not an EU member state
Red: out - does not want to sign or ratify
Orange: no current information
Dark green: will ratify soon
Light green: has ratified
UK: special (at least up to 23.6.2016)
Speed

1\textsuperscript{st} Instance: 2-3 Years

Appeal: 3-4-5 Years

1\textsuperscript{st} Instance: 1 Year

Appeal: 1 Year
Course of Proceedings (all time indications in months and approximately in part)

0
Filing of Action with Grounds

1 m
Preliminary Objections

2 m
Defence to revocation, including application to amend

4 m
Reply to Defence to revocation together with any defence to application to amend

5 m
Rejoinder to Reply

9 m
Interim Conference (optional)

12 m
Oral Hearing

14 m
Decision
<table>
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<tr>
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<th>Amount</th>
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<tbody>
<tr>
<td>Stand alone Revocation Action:</td>
<td>20.000€</td>
</tr>
<tr>
<td>Revocation Action:</td>
<td></td>
</tr>
<tr>
<td>Appeal:</td>
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</tr>
<tr>
<td>Infringement Action with Revocation Counterclaim:</td>
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<tr>
<td>Revocation Counterclaim:</td>
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<td>Value-based fee:</td>
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<tr>
<td>Court Fees</td>
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</tr>
</tbody>
</table>
Art. 69 UPCA

(1) Reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, unless equity requires otherwise, up to a ceiling set in accordance with the Rules of Procedure.

(2) Where a party succeeds only in part or in exceptional circumstances, the Court may order that costs be apportioned equitably or that the parties bear their own costs.

(3) A party should bear any unnecessary costs it has caused the Court or another party.
<table>
<thead>
<tr>
<th>Value of the proceeding</th>
<th>Ceiling for recoverable costs</th>
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<tr>
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<td>Up to 38.000 €</td>
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<td>Up to 200.000 €</td>
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<tr>
<td>More than 50.000.000 €</td>
<td>Up to 2.000.000 €</td>
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