Navigating patent proceedings in Europe and Asia

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#healthcare #intellectualproperty

- European litigation strategy
- European opposition strategy
- Patent proceedings in Asia

Patent Litigation Strategy in Europe

Jurisdictions

- Four key jurisdictions:
  - UK
  - DE
  - NL
  - FR
- Plus EPO Opposition
- Other EPC jurisdictions to be aware of
  - IT
  - ES
  - PT
  - DK

Features of key European Patent Courts

	Specialist IP Court	Law	Bifurcation - infringement & validity	Stay pending Opposition	Protective Letter	Disclosure	XX	Trial length	First instance Decision	Costs
UK	Yes	Common law	No	Rarely	No	Yes – issue specific	Yes	5-6 d	12-15 m	£800k-£1.5m
DE	Yes	Civil Code	Yes	Yes for nullity action	Yes	No	No	0.5 d	10-13 m (Inf. only)	€400k – €500k
NL	Yes	Civil Code	No	Rarely for validity only	Yes	No but search & seizure	Qs from Court	0.5 d	13-15 m	€150k-€250k
FR	Yes	Civil Code	No	No	No	No but *saisie-contrefaçon*	No	0.5 – 1 d	18-24 m	€250k-€500k

UK Patents Court

- Specialist Patents Court with technically qualified Patents Judges
- Doctrine of “clearing the way” for patents in the healthcare sector
- Preliminary injunctions usually granted and remain pending up to final decision – with cross-undertakings in damages
- Disclosure and XX experts
- Trials 5-7d for technical patent
- Loser pays system (~60-70%)
- No appeal as of right – on points of law and real prospect of success

German Patents Court

- Specialist IP Judges
- Bifurcated system – infringement and nullity proceedings separate
- Düsseldorf, Mannheim, Munich & Hamburg
- Protective letters
- Payment into Court for issuing action (relative to value of action)
- Nullity proceedings stayed pending Opposition
- Primarily document/submissions based
- Short trial hearings – 0.5 d

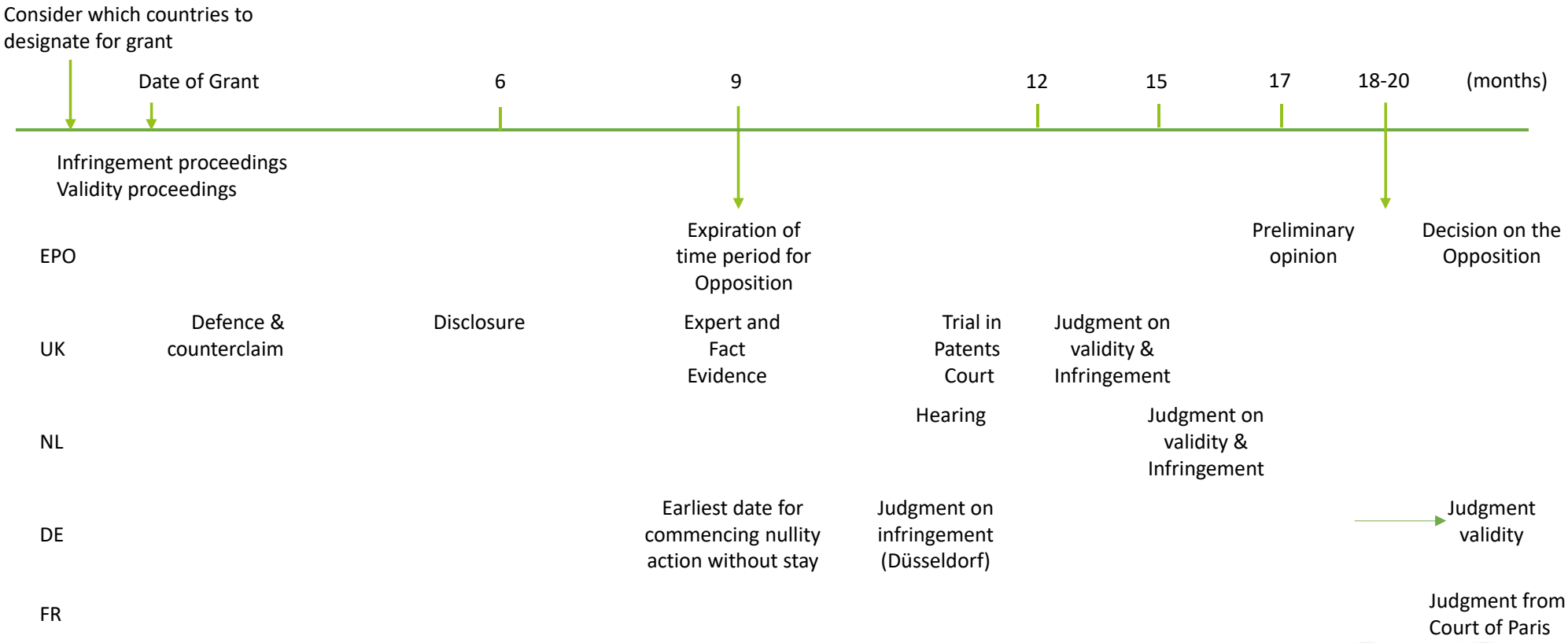
Dutch Patents Court

- Specialist IP Judges
- Patents Court based in The Hague
- Protective Letters
- Powerful seizure orders
- Accelerated proceedings on the merits available
- Primarily document/submissions based
- Short trial hearings 0.5 d
- Judges can ask experts questions at hearing

French Patents Court

- Specialist IP Judges – panel of three
- Based in Paris
- Ability to obtain evidence of infringement - saisie-contrafaçon
- Primarily document/submissions based
- Short trial hearings 0.5-1 d
- Slower than other key jurisdictions

Timeline from grant



Opposition Strategy in Europe and Asia

HGF

- Challenging patents in key healthcare markets
- Post-grant attacks at
  - European Patent Office
  - Japan Patent Office
  - Korean Patent Office
  - Chinese Patent Office

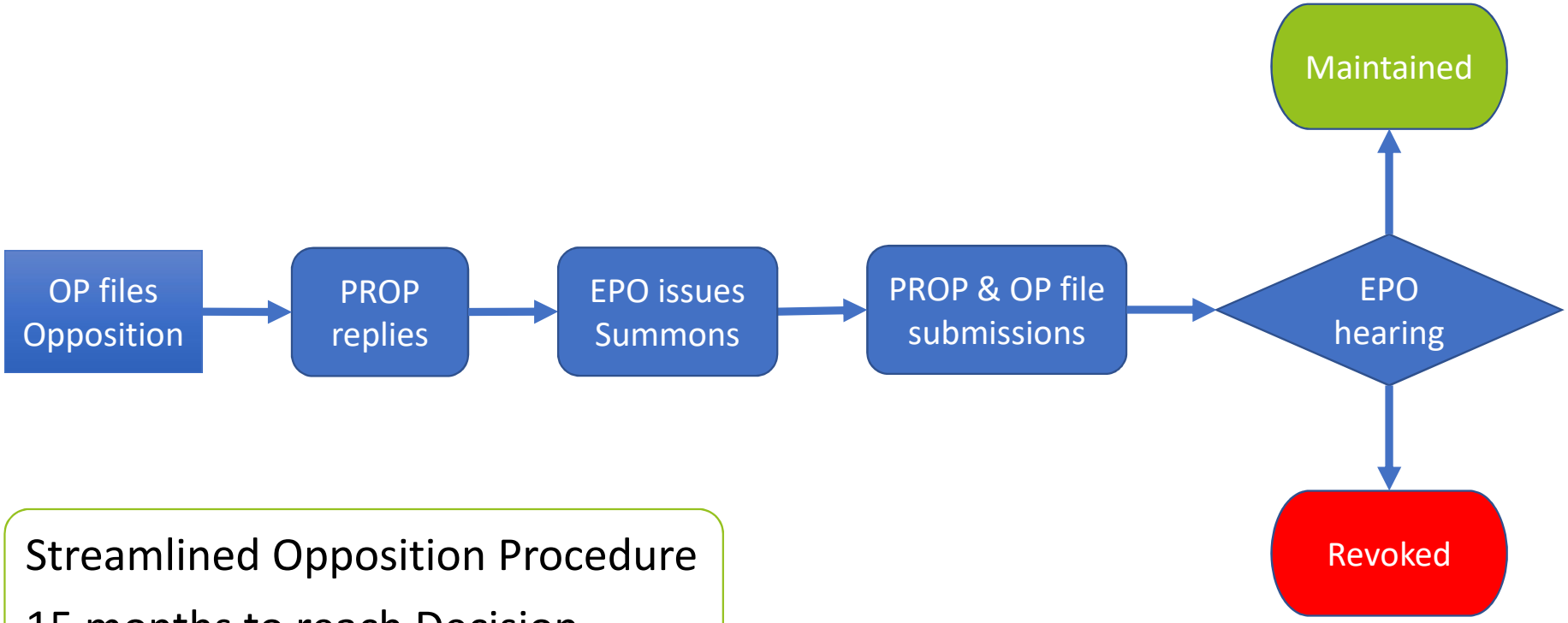
Types of Post-grant Attack

Opposition	Opposition Invalidation	Opposition Invalidation	Invalidation

EPO Opposition Key Points

Deadline	9 months from grant
Who can file?	Any party – can be straw man
Type of proceedings	Inter partes
Hearing	Yes
Appeal?	Both parties can appeal to EPO Boards of Appeal
Grounds	Added matter Novelty, Inventive step Sufficiency of disclosure Exclusions from patentability (not clarity)
Limitations	Can rely on public prior use Can use documents and arguments from Examination

EPO Opposition Procedure

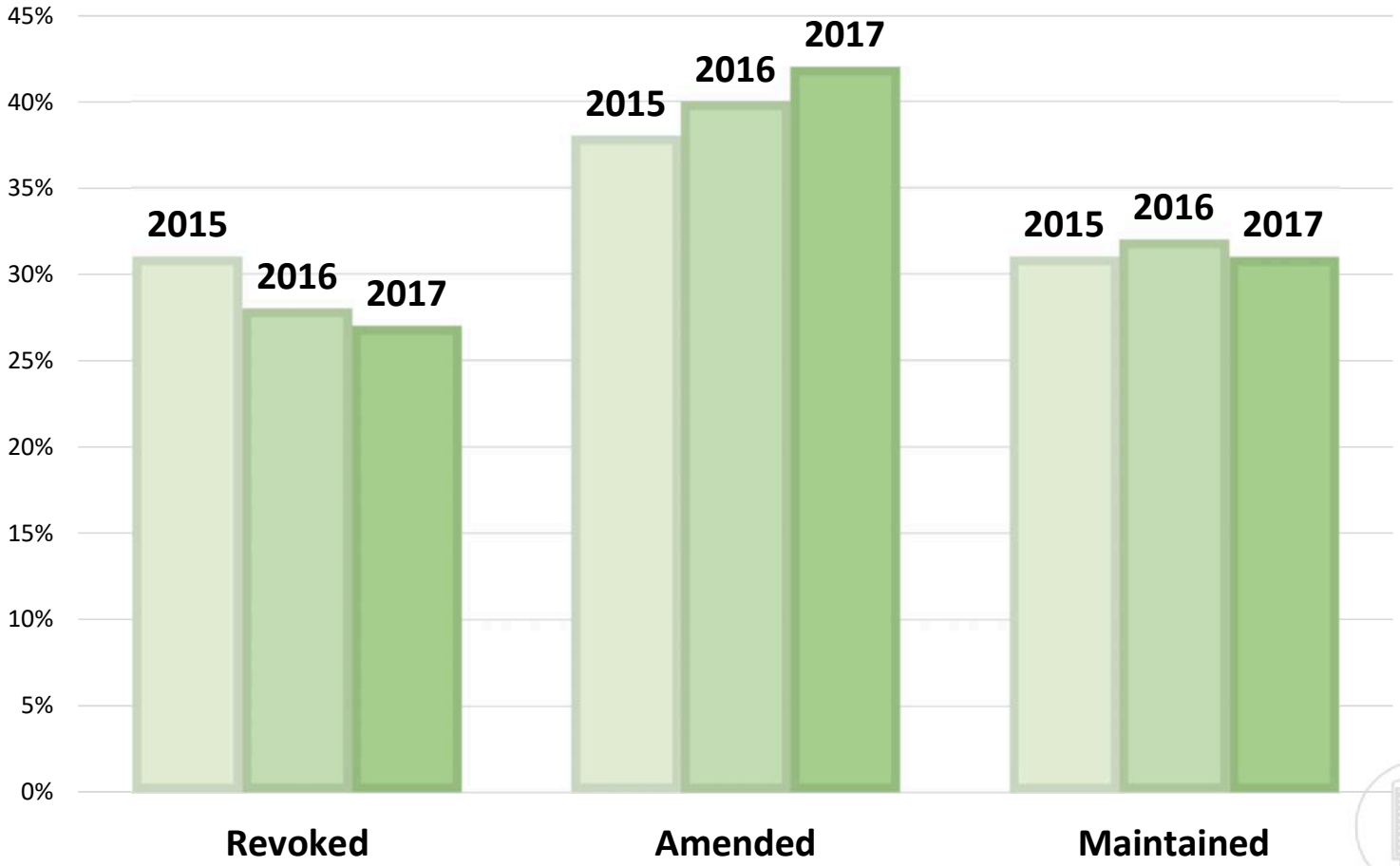


Streamlined Opposition Procedure

15 months to reach Decision

Case is decided in the Hearing!

EPO Opposition Outcomes



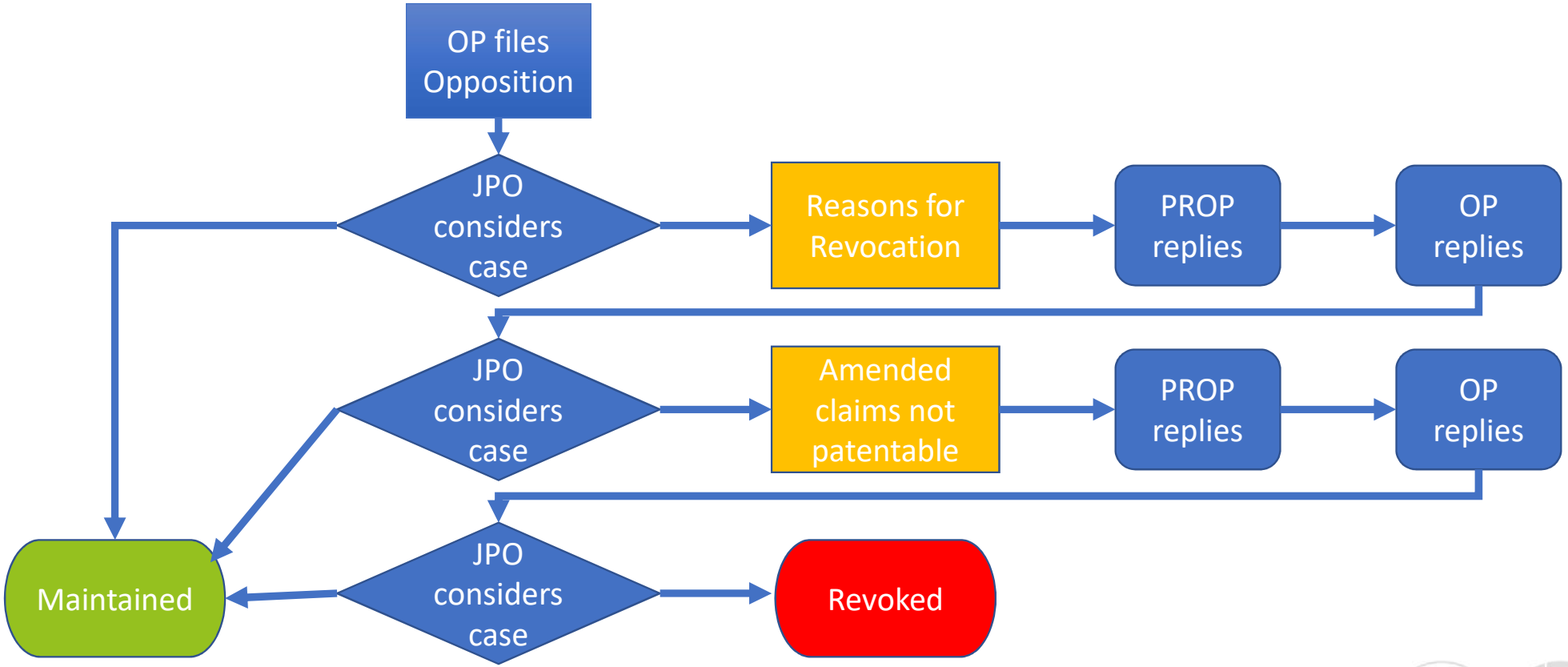
Post-grant attacks in key Asian jurisdictions:

- JPO Proceedings
- KIPO Proceedings
- CNIPA proceedings

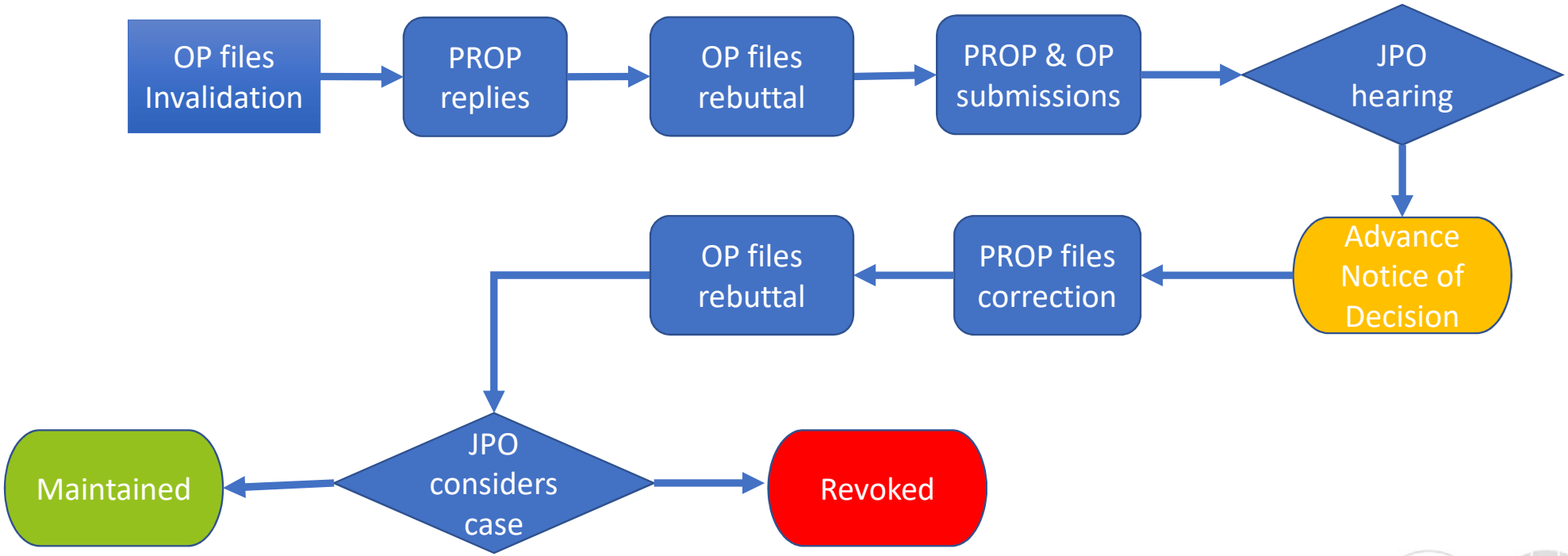
JPO Opposition & Invalidation Key Points

	Opposition	Invalidation
Deadline	6 months from grant	Any time after grant
Who can file?	Any party – can be straw man	Interested parties only
Type of proceedings	Ex parte	Inter partes
Hearing	No	Possible
Appeal?	PROP may Appeal revocation to IP High Court OP cannot Appeal	Both parties can appeal to IP High Court
Grounds	Added matter Novelty, Inventive step Sufficiency of disclosure Exclusions from patentability Clarity	Added matter Novelty, Inventive step Sufficiency of disclosure Exclusions from patentability
Limitations		

JPO Opposition Procedure



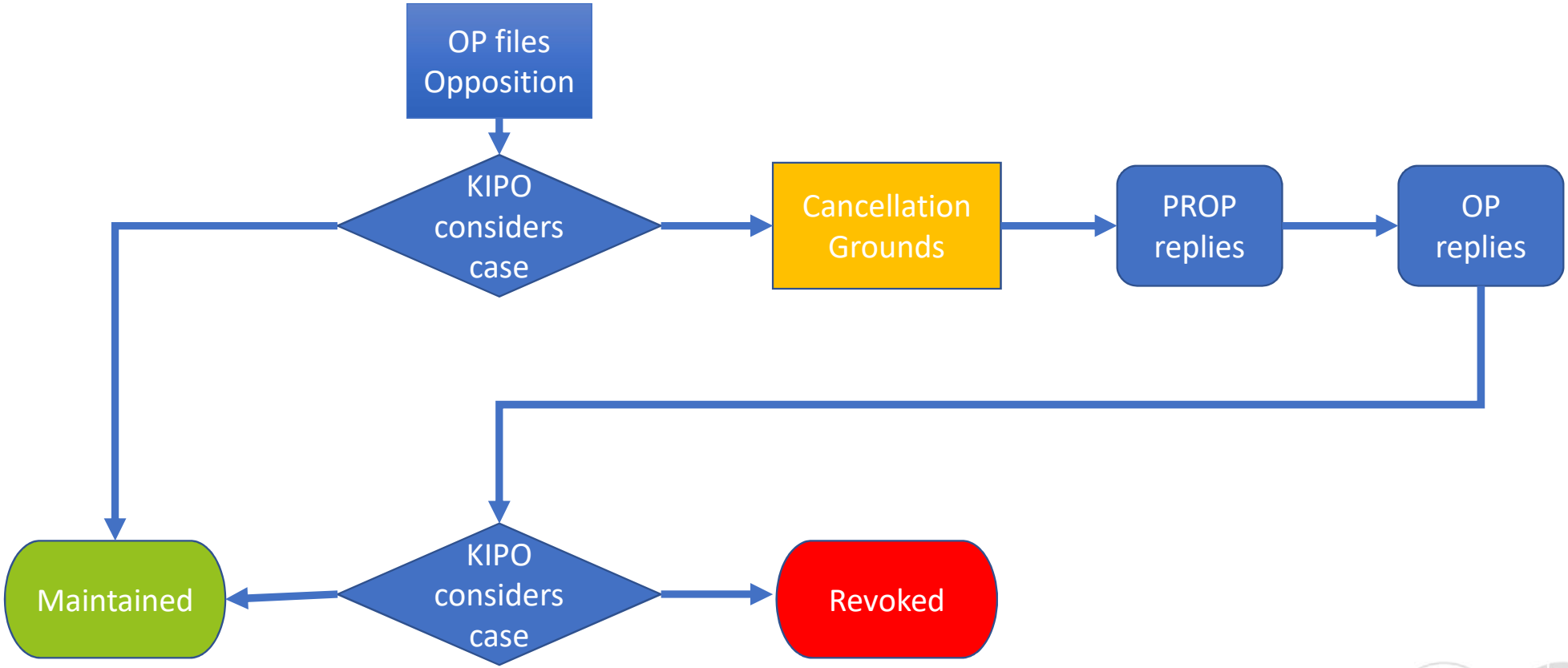
JPO Invalidation Procedure



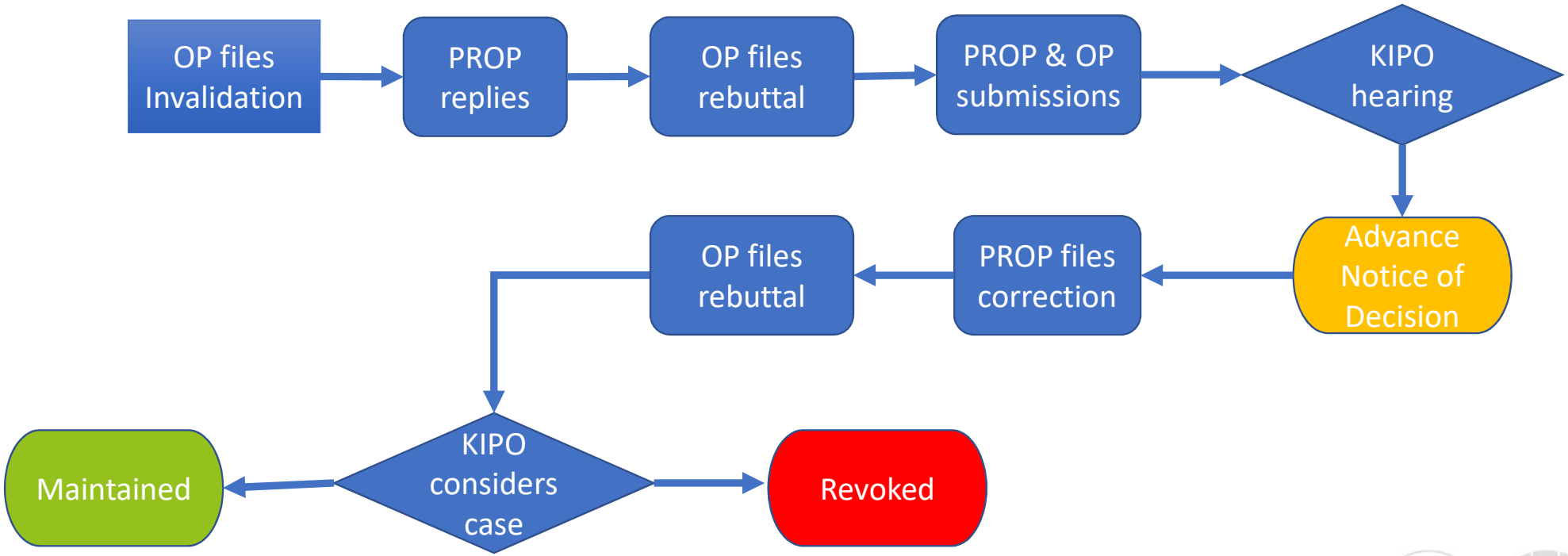
KIPO Opposition & Invalidation Key Points

	Opposition	Invalidation
Deadline	6 months from grant	Any time after grant
Who can file?	Any party – can be straw man	Interested parties only
Type of proceedings	Ex parte	Inter partes
Hearing	No	Possible, at KIPO's discretion
Appeal?	PROP may Appeal revocation to Patent Court OP cannot Appeal	Both parties can appeal to Patent Court
Grounds	Added matter Novelty, Inventive step Sufficiency of disclosure Exclusions from patentability Clarity First to file	Added matter Novelty, Inventive step Sufficiency of disclosure Exclusions from patentability
Limitations	Patentability based on written documents Cannot use documents from Examination alone	

KIPO Opposition Procedure



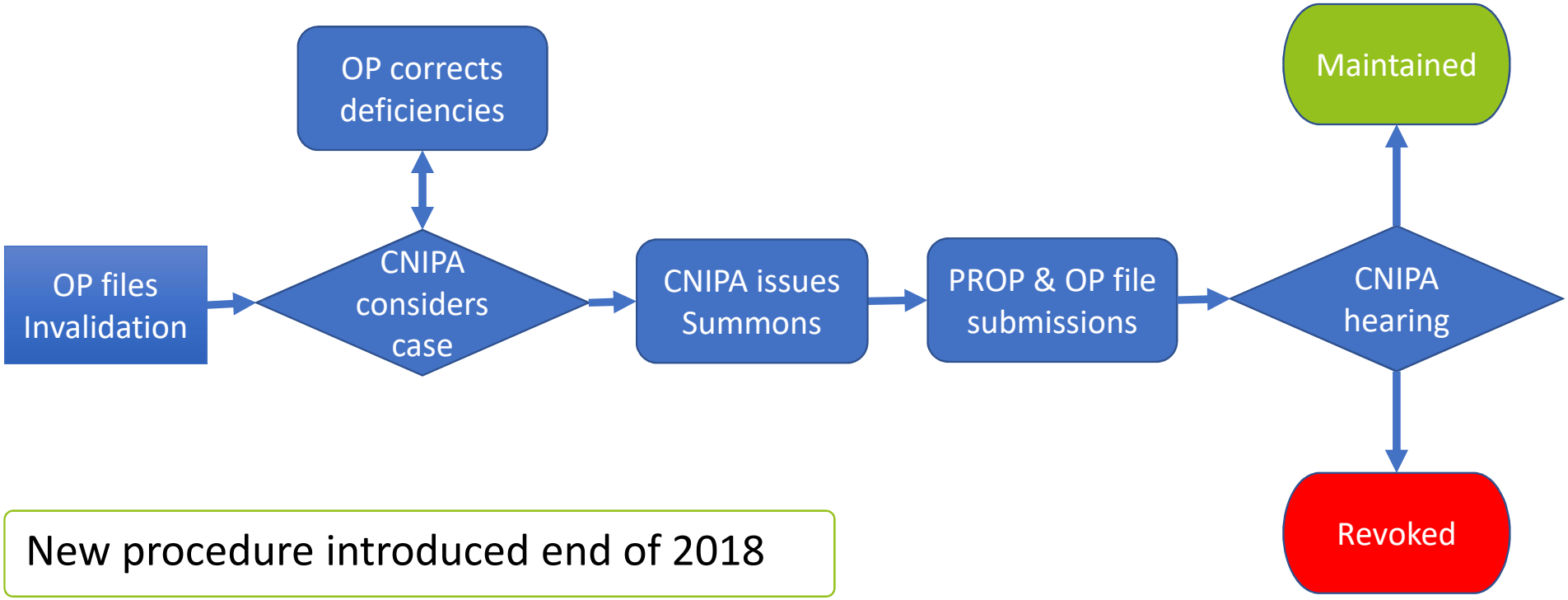
KIPO Invalidation Procedure



CNIPA Invalidation Key Points

	Invalidation
Deadline	Any time after grant
Who can file?	Any party
Type of proceedings	Inter partes
Hearing	Possible, at CNIPA's discretion
Appeal?	Both parties can appeal to Beijing IP Court
Grounds	Added matter Novelty, Inventive step Sufficiency of disclosure Exclusions from patentability Clarity First to file Double patenting
Limitations	

CNIPA Invalidation Procedure



New procedure introduced end of 2018

Conclusions

- Important to ensure all sets of proceedings are coordinated to avoid conflicting positions
- Litigation can be quick and decisive but potentially significant cost exposure
- Oppositions can be cost effective but can be slower but you need to act on grant
- Monitoring competitors' applications is important in crowded fields
- Consider how own applications cover own inventions and might cover competitor products

Thank you

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