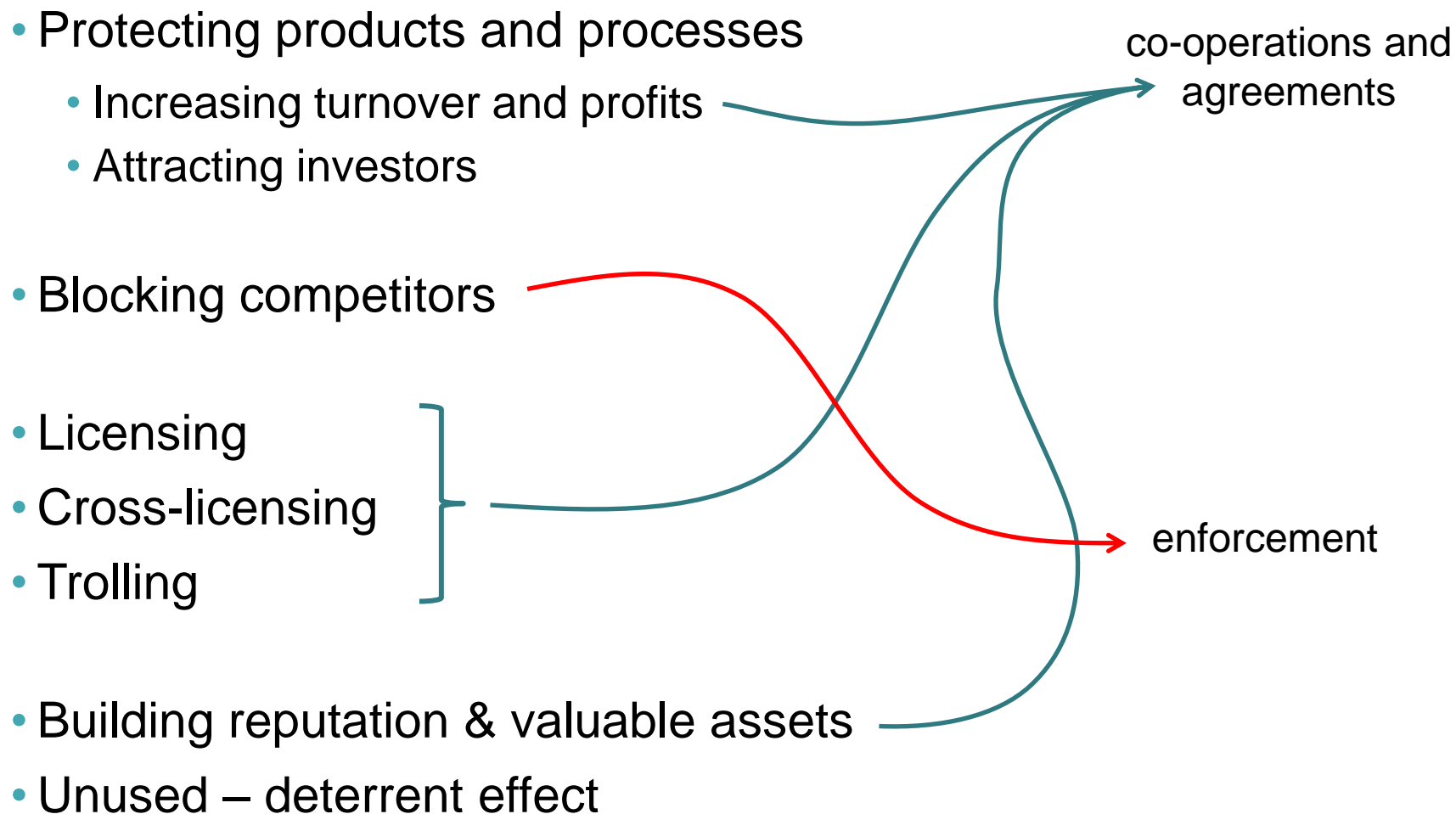


From idea to market – How to protect my IPR?

Dr. Jakob Valvoda
European Patent and
Trademark Attorney
München

08.11.2017

Recall: The use of patents



Outline

The friendly way of enforcement of IP rights

- Extra-judicial co-operation and agreements

Direct enforcement of IP rights

- Warning letter
- Preliminary injunction
- Infringement proceedings

Outline

The friendly way of enforcement of IP rights

- Extra-judicial co-operation and agreements

Direct enforcement of IP rights

- Warning letter
- Preliminary injunction
- Infringement proceedings

Co-operations and agreements

- Build a base for co-operation
 - Offer own technology
 - Search for partners
- Incentives
 - IP rights will protect products/services of both partners
 - Licensor will be remunerated
- Keep in mind:
 - Copying is “usual” practice
 - Make clear: IP right **will be enforced**

License agreements

- Licensable IP rights
 - Patents
 - patent applications
 - granted patents
 - Utility models
 - Designs
 - Trademarks
 - Copyrights (and software)
 - Know-how (?)

License agreements

- Types of licenses
 - Exclusive license
 - Sole
 - Non-exclusive license
- Scope of license (oriented on IP right)
 - Patent license
 - patent claims – licensed technology
 - individual rights conferred by patent
 - Extension to further necessary rights
 - Inclusion of know-how
 - Future improvements?
 - Right to sub-license?

Future development of licensed technology

- Improvements by licensor
- Improvements by licensee
- Joint improvements
 - Ownership and management
 - Rights to use or license
- Rights of first refusal or first option

Outline

The friendly way of enforcement of IP rights

- Extra-judicial co-operation and agreements

Direct enforcement of IP rights

- Warning letter
- Preliminary injunction
- Infringement proceedings

Outline

The friendly way of enforcement of IP rights

- Extra-judicial co-operation and agreements

Direct enforcement of IP rights

- Warning letter
- Preliminary injunction
- Infringement proceedings

Enforcement of IP rights

- What if your competitors don't want to co-operate?
- What if you don't want to co-operate?
 - Blocking competitors
- Enforce your rights using the legal system
 - Although IP rights are granted by the state, it is up to the individual owner to ensure that the rights are not being infringed and if they are, to take appropriate action.
 - Proceeding for infringement of IP rights may be brought by the proprietor of the right or an exclusive licensee.
- In Slovenia: at the Higher Court in Ljubljana

Recall: Patent rights

Extent of protection

- Patented invention as defined in the **claims**
- **Description/drawings are used for interpretation**

Without authorization by patentee, a third party is **prohibited** from

- Product/process: using
- Product/product obtained directly by process: making, offering, selling, importing, stocking
- Supplying essential elements of the invention (indirect use)

Preparatory measures

- Identify infringer
- Gather evidence on infringing product/process
 - Are features of the independent claim realized in infringing product?
- Urgency?
 - Exhibition at a trade fair
 - Particular events, such as Christmas business
- Choose jurisdiction
 - Forum locus delicti
- Escalation levels
 - Warning Letter
 - Judicial actions:
 - Preliminary Injunction and/or
 - Infringement proceedings

Jurisdictions - Europe

- Key jurisdictions: UK, Germany and the Netherlands

- Common features

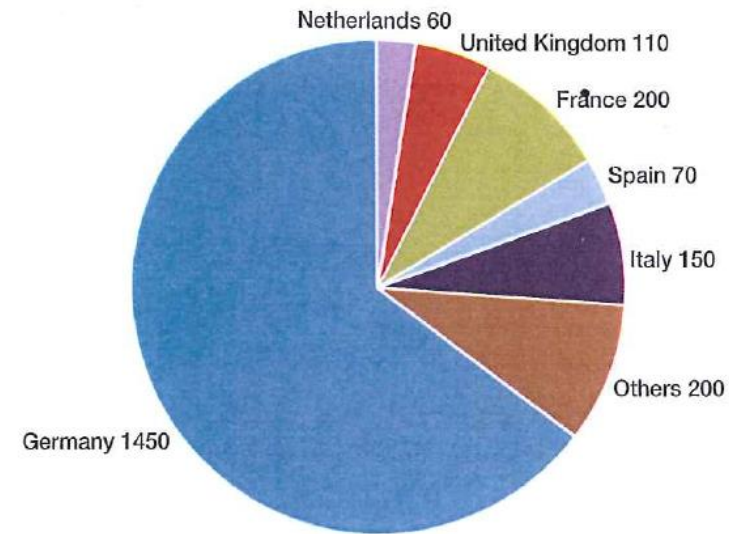
- Types of proceedings available
- Method of commencing proceedings
- Exchange of pleadings/arguments
- Trial and procedural hearings

- No deposition

- No extensive discovery

- No juries

Infringement cases in Europe



>90% of all cases in six countries (2009)

R. K Kuhnen, Unitary patent and Unified Patent Court: the proposed framework, Patents in Europe 2013/2014, p. 18

Key jurisdictions

- UK
 - Patents County Court and Patents Court
- Netherlands
 - specialized exclusive jurisdiction for patents
- Germany
 - By far most patent litigations in Europe are handled in Germany (> 1.500 cases/year)
 - DE represents an important market in Europe
 - Experienced Courts
 - Fast and reliable proceedings
 - Comparably very low costs
 - Bifurcated system: Infringement separate from Invalidity

Criteria for selecting jurisdiction

- Status of **case-law** with respect to scope of protection, infringement and revocation
- Is the competent **court patent-specialized** or a general court without specific technical knowledge?
- Is there a possibility to obtain **preliminary relief** or other provisional measures as seizures and freezing orders?
- Are decisions **directly enforceable**, notwithstanding an appeal?
- What are the **costs of litigation**? Will there be a refund by the party losing the litigation?

Warning Letter

Warning Letter

- Last measure to avoid proceedings
 - Try to arrive at an agreement: typically cease-and-desist letter
- Content
 - Identify infringing product(s)/process(es)
 - Feature analysis
 - Patented invention as defined in the claims
 - Description/drawings are used for interpretation
 - Details on why features are realized in the infringing product/process
 - Cease-and-desist agreement
- Refund of costs by infringer in some jurisdictions

Preliminary Injunction

Preliminary Injunction

- DE: Einstweilige Verfügung
- FR: Action en référé
- NL: Kort geding (summary proceedings to obtain a preliminary injunction)
- BE, ES, IT, DK SE: Provisional injunctive measures
- UK: Search order (Anton Piller) / Freezing order (Mareva)

Preliminary Injunction: Example DE

- Requirements for injunction:
 - Urgency (1...2 months, max. 3 months, court dependent)
 - “Clear” (Literal) Infringement
 - No (serious) doubts as to validity of patent
- Proceedings:
 - Request at District Court in writing
 - Possibly injunction without hearing alleged infringer, neither in writing nor at oral proceedings !! (ex-parte!)
 - Enforcement at e.g. Trade Fair (!)
 - Alternatively hearing of alleged infringer, in the discretion of the court
- Appealable, but 2...3 months delay, off the market...

Preliminary Injunction: Defense in DE

- Filing of a so-called “protective writ” (Schutzschrift)
 - At all possible District Courts (central register)
 - Argumentation on
 - non-infringement and/or
 - invalidity and/or
 - lack of urgency
 - Creating “doubts”
- Will only be used by the court in case an injunction has been requested by patentee

Infringement Proceedings

Infringement Proceedings: Example DE

- Complaint, answer, rebuttal
- Parties exchange written statements and arguments
- Court hearing (9 to 12 months from commencement)
 - Taking of evidence
 - Court appointed expert
 - Trial duration:
 - Germany: 2 to 3 hours to 1 day (1 to 2 days for invalidity)
 - Netherlands, France, Spain: ½ to 2 days
 - UK: 1 to 2 weeks
- Court decision

Financial Compensation: Example DE

- Purely compensatory: No triple damages
- Damages
 - reasonable royalty
 - profits gained
 - profits lost
- Refund of costs by the party loosing the litigation

UPC

UPC: Main principles

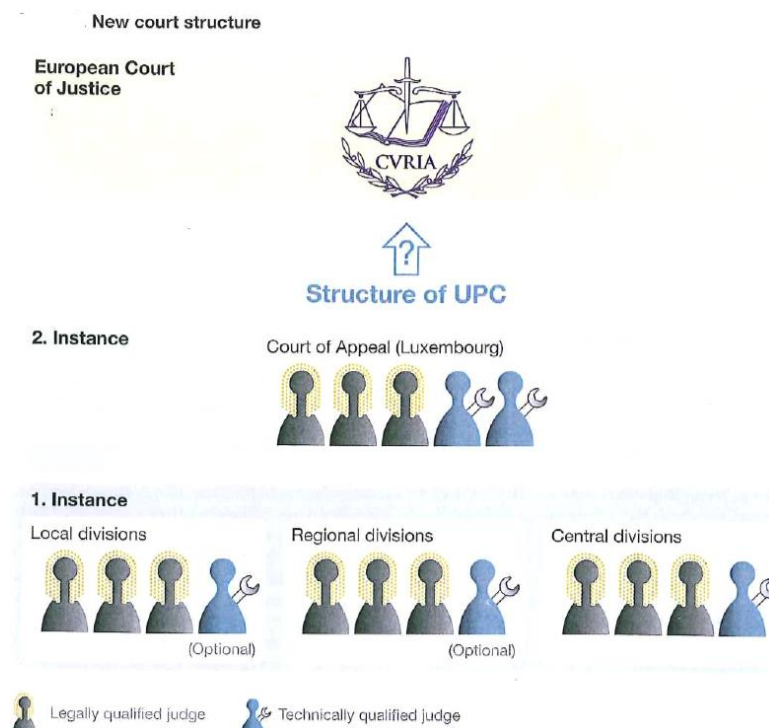
- One patent with unitary effect (UP)
- Examination and grant by EPO
 - Examination, grant and opposition at EPO
 - Appeal to Board of Appeals (as part of EPO)
- Valid and enforceable in all signatory states
- Enforcement through Unitary Patent Court (UPC)
 - Validity, enforceability and cancellation only with unitary effect
- Unitary language regime

The regulation on the language regime

- 3 official languages English, French, German
- Unitary patent can be filed in any language of a signatory state but must be translated in one of the 3 official languages
- Proceedings before UPC in one of the 3 languages

Structure of the Unitary Patent Court

- Central division with 3 seats in Paris, London and Munich
- In contracting Member States:
 - Regional divisions
 - Local divisions
- Court of Appeal in Luxembourg
- Training centre for judges in Budapest
- Patent mediation and arbitration centre in Lisbon and Ljubljana



Present status of implementation

- 2 EU Regulations on the UP and on the language regime have passed the legislative process and have come into force on January 20, 2013
- UPC Agreement is not EU law which can be set into force by legislative act, but instead a multilateral agreement which needs to be ratified by at least 13 EU member states including France, UK and Germany
- Germany and UK still have not ratified, last headstone missing for UP and UPC to become effective
 - UK: Brexit! Future of UPC still unclear
 - Germany: Law on ratification passed the German Parliament; However, complaint at the German Federal Constitutional Court (FCC) will delay ratification

The other way round

Perspective of competitor

- Track IP rights of competitors
- Consider filing oppositions at Patent Offices
 - Last chance for central attack on patents granted by EPO
 - Reasonable costs (compared to revocation proceedings)
- Take protective measures
 - Don't disseminate (too many) details of your products that are irrelevant for customer
 - Infringement difficult to prove
 - Create own IP portfolio
 - Cross-licensing
- If confronted with an infringement claim
 - Consider attacking IP right: Revocation proceedings at national courts

Outline

The friendly way of enforcement of IP rights

- Extra-judicial co-operation and agreements

Direct enforcement of IP rights

- Warning letter
- Preliminary injunction
- Infringement proceedings

Thank you for your kind attention

Dr. Jakob Valvoda

valvoda@boehmert.de

Boehmert & Boehmert

Pettenkoferstr. 22

80336 München

Germany

T +49-89-55 96 80

F +49-89-34 70 10