

GLOBAL PATENT LITIGATION

Author Guide

[A] Aim of the Publication

Global Patent Litigation is a looseleaf which aims to fulfill the increasing need for quality information on the strategy and practical aspects of patent litigation in the major trading countries of the world.

Global Patent Litigation starts with a description of how strategy is formulated in international patent litigation, including the main provisions of the European Patent Convention and the European Patent Office.

Next follow chapters by experienced patent litigators on the laws of their respective jurisdictions. Each chapter describes how a patentee can enforce the patent, highlighting possible pitfalls and remedies and thus enabling you to make an informed decision on where to litigate.

Tables provide a quick overview of proceedings in a particular jurisdiction, together with an estimate of duration and likely costs.

The main features include:

- A description of how to determine strategy in international patent litigation
- A discussion of the main provisions of the European Patent Convention and relevant case law of the European Patent Office
- National contributions from experienced patent litigators describing the main features of patent law and patent litigation in their jurisdiction
- Chapter tables providing a quick overview of the main features of the available proceedings
- Broad international coverage, with easy comparison of national jurisdictions

Global Patent Litigation will be invaluable when: protecting against infringements; preparing proper litigation strategy; estimating costs of litigation; preparing to engage local counsel.

[B] Contact Details

For questions and comments please contact: Anja Kramer
Anja.kramer@wolterskluwer.com

[C] Outline

1. APPLICABLE LAWS

2. ENTITLEMENT

2.1. Compensation

2.2. Derivation

In this section author should discuss in what the law is about e.g. employees who may in certain circumstances be able to claim compensation from their employer for an invention made in the course of the employment.

2.3. Applicant

2.4. Employee

2.5. Education/research

2.6. Teamwork

2.7. Entitlement claims

Focuses on the procedure that needs to be followed to claim entitlement, statute of limitations to claim entitlement etc.

3. SCOPE OF PROTECTION

3.1. Claims, description and drawings

3.2. Patent as granted

3.3. Interpretation of state of the art

As this heading is mentioned in the chapter about scope of protection, the purpose is to explain with a few words how the Court in infringement proceedings interprets prior art that has been discussed by the authority that granted the patent. This may in particular be relevant when the intention of the granting authority is important for determining the scope of protection of the patent. Does the Court follow the interpretation given to the state of the art by the authority granting the patent, or is it also possible that the Court gives its own interpretation to the state of the art?

3.4. Criterion for scope of protection

3.5. Role of prosecution history

3.6. Equivalents

3.7. Non-inventive application of state of the art

3.8. Translations

3.9. National (non-European) patents

4. INFRINGEMENT

4.1. Direct infringement

4.1.1. Products

4.1.2. Processes

4.1.3. Absolute product protection

4.1.4. De minimis

4.1.5. Biological material

4.1.6. Products containing or consisting of genetic information

- 4.2. Indirect (contributory) infringement
- 4.3. Unfair competition
- 4.4. Unjustified threats
- 4.5. Antitrust issues

5. FURTHER DEFENSES TO INFRINGEMENT

- 5.1. Invalidity
- 5.2. Research exemption
- 5.3. Bolar exception
- 5.4. License
- 5.5. Compulsory license

The potential defense of a compulsory license against an infringement claim is discussed.

- 5.6. Private prior use
- 5.7. Exhaustion
- 5.8. Farmer's privilege
- 5.9. Further exceptions to infringement

6. LICENSING

- 6.1. Voluntary license
- 6.2. Compulsory license

The conditions for obtaining a compulsory license are discussed.

7. PATENTS AS PART OF ASSETS

- 7.1. Assignment
- 7.2. Co-ownership
- 7.3. Surrender
- 7.4. Security rights
- 7.5. Attachment

Refers to attachment of a patent as security for a claim for damages (if the court awards damages, the party who attached the patent may be able to sell it and use the proceeds as compensation for damages).

8. PATENT LITIGATION

- 8.1. Plaintiff
 - 8.1.1. Owner
 - 8.1.2. Co-owner
 - 8.1.3. Exclusive licensee
 - 8.1.4. Non-exclusive licensee
 - 8.1.5. Other
- 8.2. Limitation periods
- 8.3. Competent court/Venue
- 8.4. Patent Office

8.1 to 8.4: What is the position of a co-owner in patent litigation? Can each co-owner start an infringement case without permission of the other co-owner? What about the position of an exclusive licensee: can it start an infringement action?

8.5. Provisional measures

8.5.1. Attachment

Refers to attachment as a security for claims: on assets as security for a claim for damages, on evidence.

8.5.1.1. General comments

8.5.1.2. Assets

8.5.1.3. Evidence

8.5.2. Preliminary injunction proceedings

8.5.2.1. Ex parte proceedings

8.5.2.2. Inter partes proceedings

8.6. Evidence

8.6.1. preservation/seizure of evidence

8.6.2. Gathering evidence

8.6.3. Experts

8.6.4. Inspection

8.7. Proceedings on the merit

Please describe in general the steps taken in these proceedings before the Court renders judgment

8.7.1. Infringement proceedings

8.7.2. Invalidity proceedings

8.7.3. Entitlement proceedings

8.7.4. Suspension of proceedings

8.8. Customs seizures

8.9. Remedies

8.9.1. Injunction

8.9.2. Intermediaries

8.9.3. Right to information

8.9.4. Corrective measures (recall, destruction, etc)

8.9.5. Reasonable compensation

8.9.6. Damages

8.9.7. Disclosure of judgment

8.9.8. Order for costs

8.10. Criminal enforcement

8.11. Appeal

8.12. Supreme Court

9. CONCLUSION

10. TABLES

- Court Structure for Patent Litigation in [name of country]
- Preliminary Injunction Proceedings: Ex parte injunctions [compulsory]
- Preliminary Injunction Proceedings: First Instance [compulsory]
- Preliminary Injunction Proceedings: Appeal (Urgent Appeal) [optional]
- Preliminary injunction proceedings: appeal (normal appeal) [compulsory]

- Preliminary injunction proceedings: appeal to Supreme Court [compulsory]
- Proceedings on the merit: first instance [compulsory]
- Proceedings on the merit: first instance (accelerated) [optional]
- Proceedings on the merit: appeal [compulsory]
- Proceedings on the merit: appeal (accelerated) [optional]
- Proceedings on the merit: appeal to Supreme Court [compulsory]
- Relationship between infringement and validity [compulsory]
- Role of experts [compulsory]
- Duration of preliminary injunction proceedings [compulsory]
- Duration of proceedings on the merit (infringement and/or invalidity) [compulsory]
info about accelerated proceedings can be added optionally
- Costs of infringement and invalidity proceedings [compulsory]