

Recent Developments in Patent Case Law: some thoughts for reflection

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Agenda

- The EU framework for implementation and enforcement of IP rights: the Directive 2004/48/EC
- Key provisions, importance and limits
- Before and after the ECJ decisions of 13 July 2006
GAT/LUK and Roche Primus
- Impact of the decisions and relevance of the change in cross-border injunctions in patent infringement cases
- Conclusions

The EU framework and Directive 2004/48/EC 1/2

- Enforcement of IPR primarily governed by national laws – they differ significantly
- European patents granted under the European Patent Convention, but infringement and enforcement of national parts handled by Member States' national courts, applying domestic laws
- A true European IP litigation does not exist, few and rare cross-border cases - Litigation remains costly and time-consuming
- Directive 2004/48: an important milestone for reducing disparities in IP laws and increasing protection across European countries

The EU framework and Directive 2004/48/EC (2/2)

● *The Directive should lead to harmonize . . .*

- Obtaining and preserving evidence
- Right to be informed of origin and distribution channels of infringing goods
- Acknowledgement of provisional, precautionary and corrective measures
- *Limit: not all countries have implemented the Directive*

The ECJ decisions of 13 July 2006 : GAT/LUK and Roche Primus (1/4)

- Background: contentious practice in patent infringement cases
- Cross-border disputes and jurisdiction of national courts: the “*spider in the web*” doctrine
- GAT vs LuK (C-4/03) - analysis
 - role of the question on the patent validity
- Roche vs Primus (C-539/03) - analysis
 - One court can't rule on infringement of several national parts of a European patent
- What will courts do?

The ECJ decisions of 13 July 2006 : GAT/LUK and Roche Primus (2/4)

Impact of ECJ decisions on future practice

- Can we still expect cross-border injunctions?
- Trend to more restrictive judicial decisions
- The basic rule: you must sue somebody for patent infringement at his place of domicile
- The invalidity issue and impact on jurisdiction:
same approach when invalidity is core of dispute as when it's only a part of the defence?

The ECJ decisions of 13 July 2006 : GAT/LUK and Roche Primus (3/4)

- Patentees always looking for cost-containment and consistency of judicial strategies, but...
 - should become more careful when enforcing their IPR internationally;
 - It will probably become harder for in-house counsel to make a serious and reliable risk assessment : need for expert involvement at earlier stage? Any “comfort” from Courts?
- Patentees (and lawyers!) must -more than ever - put themselves in defendant’s shoes to assess probability and extent of invalidity defense

The ECJ decisions of 13 July 2006 : GAT/LUK and Roche Primus (4/4)

- More or less forum shopping ?
- Expect cross-border decisions by one court only when grounds of ECJ decisions GAT/LuK and Roche/primus are met: the exclusive jurisdiction on invalidity of the patent is difficult to affirm
- Could EPLA play a role in helping patentees in their enforcement expectations?

The Draft European Patent Litigation Agreement (EPLA)

- Attempt to create single legal system for enforcing the European patent in all member states of the EPO
- Has proactive approach and advantages
- Opposed by the European Commission (member states would breach EU law by ratifying it), although now Commission might soften its approach, given the need to sort out European patent problems to improve competitiveness (see Commission Communication IP/07/463, on improving patent system in Europe)
- Patentees need a cheaper and more reliable system: to get there, retention of the European patent system and voluntary adoption of EPLA should be encouraged

Conclusions

- Formal approach by EU institutions will hardly lead to business –friendly solutions for protecting patentees interests; however...
- Jurisdiction is a hard issue when it is for the national court to define its role in a cross-border case
- Even if the EPLA is abandoned, concerted and practical solutions must be looked for
- In-house lawyer's role and the importance of understanding the substance of the patent issue from the very beginning
- Your comments?