

UPC Litigation

Key considerations

There are pros and cons of enforcing patents at the UPC. On the positive side, patent litigation will be able to be conducted at a fraction of the cost of taking action in each individual country. Against that must be factored the risk of losing across the EU, and/or even having the patent invalidated, in a single action. There is no single right answer as to whether it is better to litigate in the UPC or in national courts – the answer in any individual case will depend upon the outcome of a multifactorial assessment.

Deciding which option is best for you is key, and is arguably among the most important decisions you'll take during the litigation process. To assist in that decision, you will need impartial advice based on a thorough assessment of what you wish to achieve and the benefits and risks of each option. You will need advisors who:

- Have rights to litigate in the UPC, without which your team would not be able to conduct UPC litigation;
- Are qualified to litigate in the UK, a non-UPC country – so that the strategic option of choosing to initiate proceedings outside the jurisdiction of the UPC can be considered;
- Are also qualified to litigate in Germany, a UPC country - to assess the national enforcement options available in that jurisdiction;
- Can call upon trusted local jurisdictional expertise as required;
- Have no vested interest in the selection of any particular litigation forum, but instead want what's best for you;
- Have a long-established record and experience of successfully litigating patents and winning in EPO proceedings.

HLK is one of a very small number of firms which ticks all these boxes. We have specialist IP lawyers in the UK and Germany, with expertise and real patent litigation credentials. We have patent attorneys with the right to litigate in the UPC, with a proven track record in EPO Oppositions. We have established relationships with specialist litigators in all the countries in which UPC divisions are based; these specialist litigators can be called upon as dictated by the circumstances of a case. We have a unique perspective enabling us to advise you impartially on all the options available to you, and to assist you with whichever option is the best one for you. Details of our experience, expertise and our approach to patent litigation are below, along with profiles of some core members of our UPC litigation team.

Experience and credentials – Why us?

We created HLK in 2019 because we thought there was a better way of offering our clients world-class IP advice. By combining leading European Patent Attorneys Haseltine Lake with leading IP lawyers Kempners, we can offer top-quality IP advice at a price that makes sense.

When the doors of the UPC open in June, doubtless aspects of UPC litigation will differ from current patent litigation in the German or English courts, and from patent actions in the EPO. However, we have no doubt that HLK's Litigation model built on our underlying approach, developed over many years, will apply equally to UPC litigation, enabling us to continue to provide value for money to clients who wish to enforce or defend their patents in the UPC.

HLK UPC Litigation Model

Cost-Benefit Analysis

This is vital in all disputes – and should be repeated throughout.

Case Strengths

Assess the risks, opportunities and success prospects of your case, and keep them under review, so your decision to continue makes business sense.

Whether your case is weak or strong, it is often best to settle and get out quickly on best terms.

Team Size

Appropriately sized teams and no duplication of work – in most circumstances a maximum of one patent attorney litigator and one partner from the litigation team is all that is required to run the case, with an associate from the litigation team and a paralegal / trainee assisting as necessary. We have found that a small team of this size is sufficient to handle most patent disputes. However, we can provide additional expertise and resource should that be necessary.

Expertise

Personal service from a litigation partner and patent attorney litigator actively engaged in your work.

Use technical people on technical cases to provide real expertise along with legal knowledge. If we handled the patent prosecution, we can use the patent attorneys who did the prosecution work, so that litigation and prosecution can be harmonised to maximum effect.

Co-Counsel

Established relationships with trusted litigators in all 14 countries in which the 21 UPC divisions are based. Able to call upon local litigators when required by case circumstances, for example, due to local law or language issues.

Location

With bases throughout the UK and in Munich, we are conveniently located to provide expert client support wherever it is needed and to handle litigation in all the relevant fora.

Litigation strategy

Only fight the issues that matter. Don't devote time to unimportant side issues.

Case Management

Agree an action plan with clear timeframes and responsibility lines, so you know what we are doing, why, and when.

Costs

Value billing and no surprise bills.

Avoid inefficient practices (e.g. "meetings about meetings"), which cost you whilst adding no value.

Recent patent litigation experience (past 5 years only)

Janger v Tesco – we acted for the UK's largest supermarket, Tesco, in defence of a patent infringement action brought by the clothes hanger manufacturer Janger. The dispute concerned a store hanger used nationally by Tesco. At trial, the patent was revoked for lack of inventive step, and permission to appeal was refused by the Court of Appeal.

Prosyscor v Netsweeper – we acted for the successful defendant, Netsweeper, in a patent entitlement action brought by a former employee. The patent claimed a method of preventing specific individual users from accessing websites thereby allowing different users from one IP address different access rights through a single firewall. The initial work was done by

an employee out of hours and on his own equipment. The idea was further developed by Netsweeper and resulted in a patent application. The court held that the initial invention was made in the course of the employee's normal duties – the employee was employed as a software developer, and the scope of his duties was wide enough to encompass work done out of hours and on his own equipment. This dispute was heard in the IPEC.

Technetix v Teleste – we acted for the claimant in an infringement action brought in the Patents Court. The patent claims a means of reducing the effects of intermodulation in cable TV, by blocking low voltage surges which can cause magnetisation of ferrite components in amplifiers etc.

Ansell v Reckitt Benckiser – the multinational healthcare and medical devices group, Ansell, suspected that two major products in the Durex condom range infringed an application for a European Patent for latex free condoms owned by Ansell's US company, Ansell Healthcare Products LLC. After interviewing five English law firms, Ansell appointed us to issue proceedings for patent infringement against Reckitt Benckiser, who were responsible for marketing Durex in the UK. Proceedings for patent infringement were issued in the Patents Court and served on Reckitt Benckiser on the day that the UK patent was granted. We arranged for experimental evidence based upon advanced techniques of electron microscopy and microprobe elemental analysis to be generated at specialist university departments and polymer research organisations. After we had presented a preliminary report of the experimental evidence to Reckitt Benckiser's solicitors, a settlement of the action before trial was achieved with Reckitt Benckiser, who also agreed to withdraw their counterclaim challenge to the validity of Ansell's patent.

AP Racing v Alcon Components – we achieved success in the Court of Appeal for AP Racing (a subsidiary of the world's leading motorsport and performance car brake manufacturer, Freni Brembo) in its claim for patent infringement in respect of a patent protecting its leading "RadiCal" family of calipers. That decision is the leading English law authority on added matter in patent law. We then proceeded to a damages inquiry, and recovered damages of £500,000 for AP Racing – a record level in the IPEC.

Germany – we handle successfully German contentious and non-contentious cases. Recent work highlights include:

- successfully defending against alleged utility model infringement of a multinational company's product packaging.
- successfully enforcing our client's design rights against competitor's use.
- negotiating and drafting complex patent license agreements and NDAs for our clients in the technical and chemistry fields.

Recent EPO Opposition and Appeal experience (past 5 years only)

Life Sciences and Healthcare – we handle a number of high profile, high-value and complex EPO oppositions in the Life Sciences and Healthcare sector. Recent work highlights include:

- acting for MonosolRx in a series of multi-opponent EPO oppositions and appeals relating to their patents covering their pioneering work in the field of thin film drug delivery. HLK successfully defended a number of these patents, often overturning first instance decisions and preliminary opinions.
- successfully defending a patent relating to small molecule pharmaceuticals useful in the treatment of cancer (selective CDK4/6 inhibitors) in EPO opposition proceedings.
- successfully defending at first instance a patent relating to a companion diagnostic used as a frontline test for non-small cell lung cancer (NSCLC) patients in complex multi-party EPO opposition proceedings. We are also handling the defence of four divisional patents in EPO

opposition proceedings at first instance.

- handling the defence of a complex EPO opposition relating to a patent covering gene therapy (CRISPR) for sickle cell disease and β thalassemia.
- handling the defence of an EPO opposition relating to a patent covering small molecule splicing modulators for the treatment of Huntington's Disease.

Chemistry, FMCG and Materials – we handle a large number of EPO oppositions in the Chemistry, FMCG and Materials sectors. Recent work highlights include:

- acting for a multinational flavour and fragrance company with respect to a number of their EPO oppositions and appeals. In recent years we have achieved success in both defending and attacking patents for this company, and in particular with respect to organic synthesis of fragrances and encapsulated fragrance delivery systems.
- acting for a major materials and composites company with respect to a number of their EPO oppositions and appeals. In recent years, we have achieved success in both defending and attacking patents, and in particular with respect to glass fibre technologies used in composites forming wind turbine blades.

Engineering and Mechanical – we handle a large number of EPO oppositions in the Engineering and Mechanical sectors. Recent work highlights include:

- obtaining revocation of a patent for an item of railway equipment, thereby clearing the way for our client to fulfil high value sales.
- obtaining revocation of a patent for a shaving razor held by a well-known razor company.
- successfully defending a patent for our client's playground equipment.
- successfully defending a steel manufacturer's patent for a method of manufacturing steel plate.
- obtaining revocation of a patent for a vaping device.
- successfully defending our client's patent for beverage (e.g. coffee) capsules.
- successfully defending a clothing manufacturer's patent from competitor challenge.

Electronics and Tech – we handle a large number of EPO oppositions in the Electronics and Tech sectors. Recent work highlights include:

- successfully attacking a European patent for a solar cell on behalf of a "Straw person" opponent, leading to revocation of all apparatus claims and significant limitations to the remaining method claims.
- successfully revoking a multinational company's patent for secure boot software in an industrial control system.
- obtaining revocation of a patent for detecting abnormalities in a large-scale industrial process plant.
- obtaining revocation of a competitor patent for a laser guided missile system.
- successfully defending our client's patents for electric shavers against competitor oppositions.
- successfully defending our client's patent for a refrigeration system having a telemetry function.
- successfully defending a printer company's patent for authentication of printer cartridges.

Meet the Core UPC Team



Matthew Howell, Partner: Matthew is a registered representative before the UPC. He joined HLK in 2018 after a period of almost 7 years as a partner at another firm, having qualified as a UK Patent Attorney in 2007, as a European Patent Attorney in 2008, and as a Patent Attorney Litigator in 2014. Matthew specialises in the fields of electronics, computing (including software) and communications, and has undertaken work on behalf of a variety of major international companies operating in these fields, as well as SMEs and major universities. He has extensive experience of hearings before the Examining Divisions, Opposition Divisions and Boards of Appeal of the European Patent Office. As well as his patent drafting and prosecution work, Matthew has also handled contentious issues, helping clients to achieve positive results in a number of IP related disputes.



Greg Ward, Partner: Greg is a registered representative before the UPC. He is a Partner and Patent Attorney at HLK. He is recognised by both clients and colleagues as an expert in the fields of electronics, communications and machine learning. With experience both in private practice and as part of an in-house IP department, during a year-long secondment, Greg has a strong understanding of clients' needs and regularly gives strategic advice on patent prosecution, portfolio management and litigation. In particular, Greg brings a deep level of technical background knowledge to his work in the drafting and prosecution of high-value, standards essential patents (SEPs); his advice and opinions are highly regarded by those working in the field. Greg is dual qualified as a Chartered UK (2015) and European (2014) Patent Attorney. Greg is also a Patent Attorney Litigator (2020), certified to conduct intellectual property litigation in all relevant UK courts.



Joe Lenthall, Partner: Joe is a registered representative before the UPC. He is a leading specialist in EPO opposition proceedings, especially high value, complex and multi-party proceedings in the Life Sciences & Healthcare fields. Joe has strong technical expertise in Chemistry and Life Sciences and, in particular, handles contentious work in the fields of small molecule and gene therapies, drug delivery formulations, diagnostics, FMCG and materials chemistry. Joe also has UK litigation experience and led the successful defence of a patent dispute in the English IP Enterprise court and the subsequent referral to the Court of Appeal. He qualified as a Chartered Patent Attorney in 2010 and a European Patent Attorney in 2011. Joe is also a Patent Attorney Litigator (2017), certified to conduct intellectual property litigation in all relevant UK courts.



James Ward, Partner: James is a registered representative before the UPC. James acts for clients in patent prosecution, opposition and advisory matters across a diverse range of technologies. James regularly attends oral proceedings at the EPO before the first-instance Examining and Opposition Divisions and before the Boards of Appeal. Opposition proceedings form a significant part of his practice, acting both for opponents and patentees. Technologies in which James has acted in opposition proceedings include 3D printers, automated industrial control, software authentication and security, refrigeration systems, weapons systems, razors, railway equipment, sensors for deep-sea fishing gear, firefighter safety equipment, television program guides, television audience measurement systems, injection moulding machines, DVD technologies, fax and e-mail devices, telephone routing and recording systems, intravascular stents, clothing, coffee machines and steel mills. James qualified as a European and UK patent attorney in 2007 and as an Irish patent attorney in 2018. He is also a member of the German chamber of patent attorneys (Mitglied der Patentanwaltskammer) and holds a Diploma in European patent litigation from CEIPI at the University of Strasbourg.



Sandeep Basra, Partner: Sandeep is a Partner in the Chemistry and Life Sciences team at HLK. She advises clients across a broad spectrum of patent matters, from drafting and filing applications, through to European Opposition and Appeals to freedom-to-operate opinions. Sandeep also advises clients on IP matters in Germany including helping companies develop and implement protocols to comply with the Employee Inventors Act in Germany. Before entering the IP profession in 2007, Sandeep was a researcher for many years in the UK, US and Germany. Her research touched on many topics including organic, inorganic, organometallic and medical chemistry. With this background, Sandeep routinely handles a range of technical fields from pharmaceuticals and small molecule chemistry to petrochemicals, polymers and catalysts. Sandeep especially enjoys working as an extension of a R&D department to applying both her technical knowledge and legal expertise.



Jana Crewett, Partner: After graduating in Physics and Environmental Science and gaining research experience in the UK and in Germany in Semiconductor Physics and Optoelectronics, Jana qualified as a German Patent Attorney in 2007 and as a European Patent Attorney in 2009. She has worked for a variety of German and international IP firms and industry patent departments, advising clients on patent prosecution and opposition matters across a wide range of technologies, including mechanical engineering, optoelectronics, microscopy, medical devices, mobile telecommunication, and software. Jana also assists clients in freedom-to-operate, litigation and licensing matters, as well as providing strategic advice for patent portfolio management and product development in view of FTO considerations.

