

Contents

<i>Preface</i>	v
<i>About the authors and editors</i>xxv

Introduction <i>Dieter Stauder</i>	1
---	---

A International Patent Enforcement

1 Comparative Overview and the TRIPS Enforcement

Provisions <i>Christopher Heath</i>	5
I. Introduction	5
II. Enforcement and International Law	7
1. General	7
2. Difficulty of Uniform Rules	8
3. History of TRIPS and Enforcement	10
III. TRIPS – General Principles of Enforcement:	
Arts. 41, 42	11
1. Procedures in General	11
2. Principles Laid Down in Art. 41	11
IV. Rules for Obtaining Evidence: Arts. 43, 50.1(b)	15
1. TRIPS Provisions Arts. 43, 50.1(b)	15
2. Details Under National Laws	17
V. Interim Injunctions: Art. 50	26
1. Provisional Measures to Prevent Infringement, Art. 50	
TRIPS	26
2. The Balance of Probability	27
3. The Balance of Convenience	28
4. Practice in Selected Countries	29
VI. The Main Action	31
1. The United Kingdom	31
2. Germany	32
3. France	34
4. Japan	35
5. The United States	38
6. Intra-European Litigation	39
VII. Final Measures: Arts. 44–48	44
1. Injunctive Relief, Art. 44	44
2. Damages, Arts. 45, 48	44
3. The Right of Information/ <i>Auskunftsanspruch</i> , Art. 47 ..	59
4. Other Remedies, Art. 46	59

VIII. Administrative Measures, Arts. 49,	
51–6060
1. Art. 49 TRIPS60
2. Border Measures, Arts. 51–6060
IX. Criminal Measures, Art. 6164
X. Bibliography65

B Patent Enforcement in Western Europe

2 European Issues of Patent Enforcement <i>Dieter Stauder</i>	
<i>in co-operation with Christopher Heath</i>69
I. Introduction69
1. Interests69
2. Territoriality69
II. The Central Place of Jurisdiction of the Defendant –	
Overcoming the Objection of Nullity of Foreign	
Patents70
1. European Law on Jurisdiction and Enforcement of	
Judgments70
2. The Objection of Nullity of the Foreign Patent71
3. English Case Law72
4. Dutch Case Law72
5. Different Views73
III. Jurisdiction Based on the Plurality of the Defendants –	
The Way to One Single Court?74
1. Dutch Case Law74
2. Legal Basis74
3. Avoiding Irreconcilable Judgments75
IV. Forum Delicti Commissi (Place of Tort)76
V. Provisional Measures77
VI. The “Torpedoes” against the New Case Law77
1. Recent Developments77
2. Automatic Suspension78
3. Court Reactions78
VII. The Co-operation Directive79
VIII. The European Enforcement Directive79
1. Objective80
2. Obtaining Evidence80
3. The <i>Auskunftsanspruch</i>82
4. Interlocutory Injunction and Freezing Order82
5. Final Sanctions83
6. Calculation of Damages83
7. Publication of the Decision84
8. Analysis84

IX. European Projects	84
1. The Situation in the Area of Protection of Invention in Europe	84
2. The Community Patent	85
3. The European Patent – EPLA	85
4. Conclusion	86
3 The Enforcement of Patent Rights in the United Kingdom	
<i>William Cornish and David Llewelyn</i>	87
A. General	87
I. Enforcing Patents	87
II. Development of English Practice	88
B. Common Law Process in the English Conception	91
I. The Accusatorial Inheritance	91
II. Recent Reforms	92
C. Procedural Steps and Their Problems	93
I. Competent Parties and Their Powers	93
II. Transnational Jurisdiction in UK Courts	95
III. Preparation for Trial	99
IV. Pre-action Procedures	99
1. Interim Injunctions	99
2. Securing and Preserving Evidence Before Trial	101
3. Other Pre-Action Procedures	103
D. Commencement of the Action	104
I. Statement and Particulars of Case	104
II. Case Management: Directions	104
III. Disclosure and Evidence	105
IV. Trial	107
V. Appeals	107
E. Remedies for Infringement	107
Conclusion	108
4 The Enforcement of Patent Rights in Germany	
<i>Hans Marshall</i>	109
A. Outline of the System of Civil Procedure Relating to Patent Litigation	109
I. Civil Litigation in General	109
II. Stages of Civil Litigation in Germany	111
III. The Profession	112
B. Problems Related to the Enforcement of Patent Rights	113
I. Competent Parties	113

II. The Competent Court	114
1. Concentration of Local Jurisdiction	114
2. The Brussels and Lugano Conventions and the Regulation (EU) NR 44/2001	114
3. Forum Shopping and the “Italian” or “Belgian” Torpedo	119
III. Preparation for Trial	120
1. Warning Letter	120
2. Preserving Evidence	121
3. Preliminary Injunctions	124
IV. The Trial	126
1. The Role of Lawyers	126
2. Experts	126
3. Role of Judges	127
4. Claim Interpretation	127
5. The Extended Scope of Protection by the Doctrine of Equivalents	129
6. Direct and Indirect Infringement	131
7. Protection in the Case of Process Patents	132
V. Defences	132
1. Distinction Between Nullity and Infringement Cases	132
2. Other Defences	133
VI. Remedies	135
1. Injunctive Relief	135
2. Damages	135
3. Other Measures	138
5 The Enforcement of Patent Rights in France	
<i>Laurence Pelit</i>	139
A. Patent Law in General	139
I. Overview	139
II. Jurisdiction	140
B. Enforcement of Patent Rights in Particular	146
I. Prerequisites for Patent Infringement Action	146
1. Patent in Suit	147
2. Competent Parties	148
3. Enforcement	149
4. Limitations	150
II. Proof of Infringement	151
1. General Means of Proof	151
2. “Saisie-contrefaçon”	152
III. Preliminary Measures	160
IV. The Hearing	161

V. Defences	161
VI. Remedies	165
1. Sanctions for Restoring the Patentee's Monopoly. . . .	165
2. Damages as Compensatory Measures	166
6 The Enforcement of Patent Rights in the Netherlands	
<i>Jan J. Brinkhof</i>	171
A. Introduction	171
B. Brief Outline of the System	171
I. Judges	171
II. Proceedings	172
1. Proceedings on the Merits	173
2. Kort geding	174
3. Patent Attorneys and Patent Lawyers	176
C. Problems Related to Enforcement of Patent Rights	176
I. Competent Parties	176
II. Competent Courts	176
1. National Jurisdiction	176
2. International Jurisdiction	177
III. Preparation for Trial	181
IV. The Trial	182
V. Defences	183
VI. Injunctive Relief	185
VII. Damages	186
D. Final Remarks	186
Literature	187
7 The Enforcement of Patent Rights in Italy <i>Giovanni Casucci</i> .	189
A. The System of Civil Procedure in General	189
I. Introduction	189
II. Structure	189
1. First Instance	190
2. Appeal	190
3. Supreme Court	191
III. Patent Enforcement	191
1. Supra-National Regulations and National Enforcement	191
2. Prevailing Urgent Relief Requests	192
3. The "Presumption of Invalidity" of an Italian Patent .	192
4. Technical Issues	192
IV. Lawyers	193
V. Patent Attorneys	193
B. Enforcement Issues	194
I. Competent Parties	194
II. Competent Court	195

III . Preliminary/Interim Measures	196
1. Descrizione	196
2. Sequestro	197
3. Inibitoria	198
4. Publication	198
5. Requirements	198
IV. The Trial	199
V. Discovery	200
VI. Technical Expertise	201
VII. Post-Expertise Phase	201
VIII. Damages	202
IX. Publication	203
C. Final Remarks	203
8 The Enforcement of Patent Rights in Switzerland	
<i>Fritz Blumer</i>	205
A. System of Civil Procedure	205
I. Civil Litigation in General / in Patent Matters	205
II. The Profession	206
III. Additional Measures for the Enforcement of Patent Rights	206
B. Enforcement of Patent Rights	207
I. Competent Parties	207
1. Plaintiff	207
2. Defendant	208
II. Competent Courts	208
1. Courts Designated to Hear Patent Cases	208
2. Jurisdiction for Infringement Actions Instituted by the Patent Owner	209
3. Jurisdiction for Actions for Negative Declaration	212
III. Preparation for Trial	214
1. Warning Letters	214
2. Interim Injunctions	214
IV. The Trial	217
1. Prerequisites for Proceedings	217
2. Pleadings and Presentation of Evidence	219
3. Role of the Parties, the Judge and the Expert	220
4. Instruction Hearings Held by the Zurich Commercial Court	221
5. Scope of Protection	221
V. Defences	223
1. Invalidity of the Patent in Suit	223
2. Exhaustion of Rights	225

3. Statute of Limitations, Laches	.225
4. Other Defences	.226
VI. Injunctive Relief	.227
VII. Damages	.227

C Patent Enforcement in Eastern Europe

9 The Enforcement of Patent Rights in Poland Janusz Fiolka	.233
A. History	.233
I. Beginnings of Intellectual Property Protection in Poland	.233
B. Brief Outline of the Current System of Intellectual Property Rights	.234
I. General	.234
II. The Constitution and International Agreements	.235
III. Issues that Require Specific Mention	.237
C. Enforcement of Patents	.237
I. Introduction	.237
II. National Jurisdiction and Enforcement of Foreign Judgments	.239
III. Procedures in Commercial Matters	.239
IV. Style of Decisions	.240
V. The Profession	.240
VI. Competent Parties	.241
VII. The Competent Court	.242
1. Jurisdiction Under the Lugano Convention and Issues Related to Double and Transborder Litigation	.242
2. National Jurisdiction	.243
VIII. Preparation for Trial	.243
1. Measures to Preserve Evidence	.243
2. Warning Letters	.244
3. Interim Injunctions	.244
IX. The Trial	.244
1. In General	.244
2. Expert Opinions	.245
X. Proving Infringement	.245
1. Literal Infringement and Infringement by Equivalents in Patent Matters	.245
2. Protection of Process Patents	.246
XI. Defences	.246
1. Non-Infringement	.246
2. Invalidity	.246
3. Time Bar	.246
4. Other Defences	.247

XII. Remedies	247
1. Injunctive Relief	247
2. Claims for Damages and Infringer's Profits	248
3. Penalty Payments	248
4. Reimbursement of Litigation Costs	248
5. Destruction of Infringing Goods	248
6. Apology and Publication of Clarifying Statements	249
XIII. Appeal Procedures Before Civil Courts	249
1. Appeals	249
2. Cassation (<i>kasacía</i>)	250
XIV. Patent Invalidity Procedures Before the Patent Office	250
XV. Administrative (Border) Measures of Patent Enforcement	251
XVI. Conclusion	251
10 The Enforcement of Patent Rights in the Czech Republic	
<i>Ivo Telec</i>	253
A. Brief Outline of the System of Civil Procedure	253
I. General Problems Concerning Industrial Property Rights	253
II. Courts and Jurisdiction	254
III. Publication of Decisions	254
B. Problems Related to the Enforcement of Patent Rights	256
I. Competent Parties and Representatives	256
II. The Competent Court	256
1. First Instance	256
2. On Appeal	256
III. Preparation for Trial	257
1. Warning letters	257
2. Preparation of the Proposal for Interim Injunction or Lawsuit	257
3. Activities of the Court	257
IV. The Trial	260
1. Interim Judgments on Preliminary Questions	260
2. Binding Nature of Decisions by the Industrial Property Office	260
V. Proving Infringement	261
1. Presenting Facts and Evidence	261
2. Taking Evidence	261
3. Types of Evidence	261
VI. Defences	262
VII. Remedies	263
1. Injunctive Relief	263

2. Elimination of Consequences/Destruction of Infringing Goods	263
3. Information as to the Origin of Goods	264
4. Monetary Compensation for Immaterial Losses	264
5. Damages	264
6. Unjust Enrichment	265
7. Ascertainment/Decision in Part	265
8. Publication of Facts or Decision	266
9. Costs of Proceedings	266
Conclusion	267

11 The Enforcement of Patent Rights in Hungary

<i>Zoltán Bércesi</i>	269
Introduction	269
A. Institutions and Specialists in the Field of Patent Law	269
I. General	269
II. The System of Judicial Procedure in Hungary	269
1. Judicial Organisation and Jurisdiction	269
2. Composition of the Courts	270
3. Type of Civil Procedure	270
III. The “Main Players” in the IP Field	271
1. Judges	271
2. Attorneys	271
3. Patent Attorneys	272
4. The Hungarian Patent Office	272
5. Other Experts	273
6. IP Organisations	273
IV. Current Situation and Problems Related to Intellectual Property Rights in Hungary	273
B. The Procedure in Patent-Related Suits	274
I. The Parties	274
1. The Admissible Parties in <i>ex parte</i> Proceedings	274
2. <i>Inter partes</i> Proceedings	274
3. Role of the Prosecutor	275
4. Representation in Court	275
II. Questions of Jurisdiction	276
1. General Remarks	276
2. Jurisdiction in <i>inter partes</i> Proceedings	276
3. Jurisdiction over Unpatented Inventions and Know-How Protection	276
4. <i>Ex parte</i> Proceedings	277
III. Preparation for Trial	277
1. Preparatory Acts	277
2. Interim Measures	278

IV. The Trial	278
1. Role of Courts and Attorneys	278
2. Expert Witnesses	279
V. Proving Infringement	279
VI. Defences	280
1. Request for Invalidation	280
2. Better Rights	280
3. Legitimate Use	280
4. Importation	280
VII. Remedies	280
C. <i>Final Remarks</i>	281

D Patent Enforcement in Asia

12 The Enforcement of Patent Rights in China

<i>Thomas Pattloch</i>	285
A. Introduction: Dual Enforcement and TRIPS Requirements	285
I. Dual Enforcement	285
1. Pros and Cons of Dual Enforcement	285
2. TRIPS Compliance	286
B. Civil Law Enforcement	287
I. General Remarks	287
II. Competent Courts	288
1. Basic People's Courts	288
2. Intermediate People's Courts (IPC)	288
3. Higher People's Courts (HPC)	289
4. Supreme People's Court (SPC)	289
5. Decision Finding, Appeals and Re-trials	290
III. Arbitration	291
IV. Jurisdiction in IP Cases	291
1. Subject Matter Jurisdiction – Patents	292
2. Territorial Jurisdiction	293
3. Jurisdiction in Respect to Interim Injunctions	294
4. Jurisdiction in Actions with Several Defendants / Several Plaintiffs	294
5. Administrative Proceedings	294
V. Procedure in Court	294
1. General	295
2. Preparation	295
3. Pre-trial Hearing	295
4. Court Hearing	295
5. Evidence Examination	296
6. Admission and Verification of Evidence	296
7. Collegial Panel	296

8. Representation	297
9. Licensees/Right to Stand	297
10. Suspension of Lawsuits in Patent Cases	297
VI. Evidence, Burden of Proof, Experts and Protection of Trade Secrets	298
1. Evidence	298
2. Burden of Proof	299
3. Experts	300
4. Protection of Trade Secrets	301
VII. Remedies	302
1. Cease and Desist Orders	303
2. Confiscation and Destruction	303
3. Damages	303
4. Fines	305
5. Public Apology	305
6. Executing a Decision	306
VIII. Preliminary Measures	306
1. Right to Apply	307
2. Procedure	307
3. Evidence	307
4. Undertaking	308
5. No Cross Undertaking	308
6. Swift Decision: 48 Hour Rule/ <i>ex parte</i> Application	308
7. Main Action	309
8. Remedies	309
9. Evidence Preservation	309
IX. Limitation	310
C. Administrative Law Enforcement	310
I. Competent Administrative Authorities	311
II. Procedure in Patent Infringement Cases	311
1. Filing	311
2. Acceptance and Procedure	312
3. Powers of Authorities	312
4. Remedies	313
5. Simplified Procedure Against a Repeated Infringer	313
III. Remedies	313
1. Cease and Desist	313
2. Destruction of Moulds and Tools	314
3. Confiscation	314
4. Fines	314
5. Damages	314
6. Publishing of the Decision	315
D. Criminal Law Enforcement	315

I. Administrative Authorities, Criminal Prosecution and Related Problems	315
II. Basic Principles of Prosecution	316
III. Criminal Enforcement of Patent Rights	317
E. Border Enforcement	318
I. Competent Authorities and Procedures	318
II. Fees, Security Bonds, Bonded Zones and Law Enforcement	319
III. Possible Counter-measures	320
F. Practice of Enforcement	320
13 The Enforcement of Patent Rights in Japan	
<i>Christopher Heath</i>	323
A. Civil Law Enforcement in Japan in General	323
I. Law Enforcement and Legal Consciousness	323
II. Legal System and Enforcement of Laws	324
1. Japan's Import from the West	324
2. Industrial Property Rights	325
3. Statistics	326
III. Basics of Civil Procedure	328
1. In General	328
2. Attorneys and Patent Attorneys	330
3. Judges and Decisions	331
B. Enforcement of Patent Rights in Particular	332
I. Overview	332
II. Jurisdiction	333
1. National Jurisdiction	333
2. International Jurisdiction	334
3. Composition of Courts	336
III. Competent Parties	336
1. The Plaintiff	336
2. Co-Owners of Patents	337
3. Licensees	338
4. The Defendant	338
IV. Preliminary Measures	339
1. Obtaining Evidence	339
2. Preliminary Injunctions	339
V. The Main Action	340
1. Warning Letters	340
2. Procedures in the Main Action	341
3. Obtaining and Introducing Evidence During Trial	342
4. Experts	343
5. Contributory, Direct, and Equivalent Infringement	344

VI. Defences	345
1. Non-Infringement	345
2. Nullity	347
VII. Remedies	350
1. Injunctive Relief	350
2. Damages in General	351
3. Calculation of Damages	351
4. Infringer's Profits	352
5. Ordinary Licensing Fee	353
6. Seizure and Destruction	354
7. Court Costs and Attorneys' Fees	355
8. Customs Procedures	355
14 The Enforcement of Patent Rights in Korea	
<i>Jay (Young-June) Yang</i>	357
A. System of Civil Procedure	357
I. The Court System	357
1. Courts of First Instance	357
2. Courts of Appeal	358
3. The Intellectual Property Tribunal of the Korean Intellectual Property Office	358
4. The Patent Court	359
II. The Legal Profession	360
1. Qualifications for and Roles of Attorneys/Patent Attorneys	360
2. Qualifications for and Roles of Technical Examiners	360
B. Problems Related to the Enforcement of Patent Rights	361
I. Competent Parties	361
1. Standing	361
II. Competent Court	362
III. Preparation for Trial/Pre-Trial Procedures	363
1. Pre-Trial Discovery	363
2. Service	363
3. Preservation of Evidence	364
4. Interim or Preliminary Injunctions	365
5. Warning Letters	367
IV. The Trial	367
1. General Procedures	367
2. Witnesses	367
3. Expert Witnesses	368
4. Court Ordered Document Production	368
5. Affidavit Evidence	369
6. Obtaining Evidence from Abroad	370
7. Presentation at Trial	370
8. Proving Infringement	370

V. General Defences	374
1. Invalidation Action	374
2. Confirmation of Scope	374
VI. Final Remedies	375
1. Financial Compensation/Damages	375
2. Permanent Injunctions	377
3. Destroying Infringing Materials	377
4. Restoration of Goodwill	377
VII. Criminal Action – Procedure in Criminal Courts	377
1. General Procedure	377
2. Summary Offences	378
3. Indictable Offences	379
4. Appeals	379
5. Specifics for Patents	379

E Patent Enforcement in the Americas

15 The Enforcement of Patent Rights in the United States

<i>Timothy Maloney</i>	381
A. Patent Rights	381
I. Requirements for Obtaining Patent Rights	381
1. The Nature of the Patent Application Proceeding	381
2. Patentable Subject Matter	382
3. The Patent Specification	382
4. Novelty and Non-Obviousness	383
5. The Duty of Candor	385
II. Administrative Correction of Patents	385
1. Reissue Proceedings	385
2. Reexamination Proceedings	386
B. The System of Civil Procedure	387
I. The Trial Courts	387
II. The Courts of Appeal	390
III. The Use of Juries	391
C. Patent Infringement Litigation	392
I. Strategic Considerations	393
II. Commencement of the Action	395
1. The Competent Court	395
2. The Competent Parties	396
3. The Pleadings	404
III. The Phase of Discovery	405
1. Matters Discoverable	405
2. Privileges and Immunities	406
3. Discovery Methods	408
IV. Summary Judgments	409

V. Claim Construction Proceedings	409
1. Rules for Interpreting Claims	409
2. Procedures for Interpreting Claims	410
VI. Trial	411
1. General Procedures	411
2. Principal Claims and Defenses	413
3. Remedies	417
VII. Appeal	419
16 The Enforcement of Patent Rights in Argentina	
<i>Mónica Witthaus</i>	421
A. Introduction	421
B. Problems Related to Patent Enforcement	422
I. Standing to Sue	422
1. Regulatory Provisions	422
2. Patent Applications	423
II. Competent Courts	425
III. Interim Relief and Advance Proof	425
1. Importance	425
2. Relief Provided under the Patent Act	426
3. Provisional Measures Provided in TRIPS	434
4. Other Provisional Measures	434
5. Measures of Advance Proof	435
IV. The Judicial Proceedings	436
1. Civil Proceedings	436
2. Criminal Procedures	439
V. Defences	440
1. Pleas Based on the Patent Act and Case Law	440
2. Defence in Criminal Cases	444
3. Formal Defences	445
VI. Damages	445
17 The Enforcement of Patent Rights in Brazil	
<i>Joaquim Eugenio Goulart and Ivan Ahlert</i>	449
A. Brief Outline of the System of Patents and Civil Procedure ..	449
I. Patents	449
II. Civil Procedure	450
III. Patent Nullity and Infringement	451
IV. The Profession	453
B. Problems Related to the Enforcement of Patent Rights ..	454
I. Competent Parties	454
1. Plaintiff	454
2. Defendant	454

II. The Competent Court	454
1. Courts of First Instance	455
2. Courts of Appeal	455
3. Other Courts or Tribunals	455
III. Preparation for Trial	456
1. Warning Letters	456
2. Measures to Preserve Evidence and Preliminary Measures	456
IV. The Trial	458
1. Presenting Evidence and the Importance of Experts ..	458
2. The Role of Lawyers	459
3. The Role of the Judge	459
4. Scope of Patent Protection	460
V. Defences	461
1. Invalidity	461
2. Non-infringement	463
VI. Remedies	463
Case List	465
EU/EPO	465
United Kingdom	466
Germany	467
France	470
Netherlands	473
Italy	474
Switzerland	475
Poland	476
Czech Republic	477
Hungary	478
China	478
Japan	478
Korea	483
United States	484
Argentina	487
Brazil	489