

GET UP, STAND UP! STAND UP FOR YOUR RIGHTS (in Patenting)



Daniel Kraus

Patenting in Life Sciences: A hands on workshop
Centre Loewenberg, Morat, 11-12 June 2012

Prof. Daniel Kraus, (PI)²

11 June 2012

CONTENT

1. International minimum standards
2. Swiss Law as an example
3. Oppositions
4. Other issues: torpedos and patent trolls

1. INTERNATIONAL MINIMUM STANDARDS

The WTO TRIPS Agreement

- lays down certain general principles applicable to all IPR enforcement procedures
- In addition, contains provisions on
 - civil and administrative procedures and remedies, provisional measures;
 - special requirements related to border measures and criminal procedures, which specify, in a certain amount of detail, the procedures and remedies that must be available so that right holders can effectively enforce their rights.

Dispute settlement:

The Agreement makes disputes between WTO Members about the respect of the TRIPS obligations subject to the WTO's dispute settlement procedures.

http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm

1. INTERNATIONAL MINIMUM STANDARDS

WTO TRIPS Agreement

Part III of the agreement sets out the obligations of member governments to provide procedures and remedies under their domestic law to ensure that intellectual property rights can be effectively enforced, by foreign right holders as well as by their own nationals.

Procedures should permit effective action against infringement of intellectual property rights but should be

- fair and equitable
- not unnecessarily complicated or costly, and
- should not entail unreasonable time-limits or unwarranted delays.
- allow for judicial review of final administrative decisions.

There is no obligation to put in place a judicial system distinct from that for the enforcement of laws in general, (nor to give priority to the enforcement of intellectual property rights in the allocation of resources or staff).

http://www.wto.org/english/docs_e/legal_e/ursum_e.htm#nAgreement

1. INTERNATIONAL MINIMUM STANDARDS

WTO TRIPS Agreement

The civil and administrative procedures and remedies include:

- provisions on evidence of proof,
- injunctions,
- damages and other remedies which would include the right of judicial authorities to order the disposal or destruction of infringing goods.

Judicial authorities must also have the authority to order **prompt and effective provisional measures**, in particular where any delay is likely to cause irreparable harm to the right holder, or where evidence is likely to be destroyed.

Further measures:

- at the border for the suspension by customs authorities of release, into domestic circulation, of counterfeit and pirated goods
- criminal procedures and penalties at least in cases of wilful trademark counterfeiting or copyright piracy on a commercial scale. Remedies should include imprisonment and fines sufficient to act as a deterrent.

http://www.wto.org/english/docs_e/legal_e/ursum_e.htm#nAgreement

1. INTERNATIONAL MINIMUM STANDARDS

WTO TRIPS Agreement

Art. 41 -61 TRIPS

http://www.wto.org/english/docs_e/legal_e/27-trips_05_e.htm

2. SWISS LAW AS AN EXAMPLE

Who can be pursued, be it civilly or under criminal law? (art. 66 SPA)

- a) Anyone who uses the patent invention illegally (imitation is considered as use)
- b) Anyone who refuses to notify the authority concerned of the origin and quantity of products in his possession that are unlawfully manufactured or placed on the market, and to name the addressees and disclose the extent of any distribution to commercial and industrial customers;
- c) Anyone who, without the consent of the patent owner or its licensee, removes the sign of the patent on a product or its packaging;
- d) Anyone who encourages someone to undertake one of those acts or who collaborates, favours or facilitates its execution.

2. SWISS LAW AS AN EXAMPLE

General principles and provisions (art. 67-70 SPA)

- Whoever alleges something also has to prove it!
 - Product patents
 - Process patents
- What about trade secrets?
- What happens to the products of the infringement?
- Publication of court decision

2. SWISS LAW AS AN EXAMPLE

Different possible actions (art. 72-75 SPA)

- Injunctive relief (72)
- Damages (73)
- Ascertainment (74)
- Can a licensee go to court? (75)
- The role of provisional measures (77)
 - Even without hearing the infringer (265 CPC)
 - Preventive writ (270 CPC)
 - Descriptions (not limited to processes) (77 SPA)
- Criminal proceedings?(81ff)
 - Violation of patent
 - False information on the source
 - Advantages and backdrops

2. SWISS LAW AS AN EXAMPLE

Competence of the Swiss Federal Patent Court (art. 26 FAPC)

1 The Federal Patent Court shall be exclusively competent for:

- a. validity and infringement disputes and actions for issuing a licence in respect of patents;
- b. ordering preliminary measures prior to the onset of the litisprudence of an action as defined in letter a;
- c. the enforcement of decisions adopted in its exclusive competence.

2 It shall also be competent for other civil actions possessing a factual connection to patents, in particular concerning the right to patents or their assignment. The competence of the Federal Patent Court shall not preclude that of the cantonal courts.

2. SWISS LAW AS AN EXAMPLE

Assistance from the customs administration (art. 86a ff SPA)

- Notification of suspicious goods
- Application for assistance
- Withholding of goods
- Samples or models
- Preservation of manufacturing and trade secrecy
- Destruction of the product?
- Liability guarantee and damages

3. OPPOSITIONS

In Europe: art. 99 EPC

(1)

Within nine months of the publication of the mention of the grant of the European patent in the European Patent Bulletin, any person may give notice to the European Patent Office of opposition to that patent, in accordance with the Implementing Regulations. Notice of opposition shall not be deemed to have been filed until the opposition fee has been paid.

(2)

The opposition shall apply to the European patent in all the Contracting States in which that patent has effect.

(3)

Opponents shall be parties to the opposition proceedings as well as the proprietor of the patent.

3. OPPOSITIONS

In Europe: Grounds for opposition art. 100 EPC

.Opposition may only be filed on the grounds that:

- (a)
the subject-matter of the European patent is not patentable under Articles [52](#) to [57](#);
- (b)
the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c)
the subject-matter of the European patent extends beyond the content of the application as filed, or, if the patent was granted on a divisional application or on a new application filed under [Article 61](#), beyond the content of the earlier application as filed.

3. OPPOSITIONS

In Switzerland

Art. 59c SPA

1 Within nine months from the publication of the entry in the Patent Register, anyone may file opposition to a patent which has been granted by the Institute. Opposition must be filed in writing and must be justified.

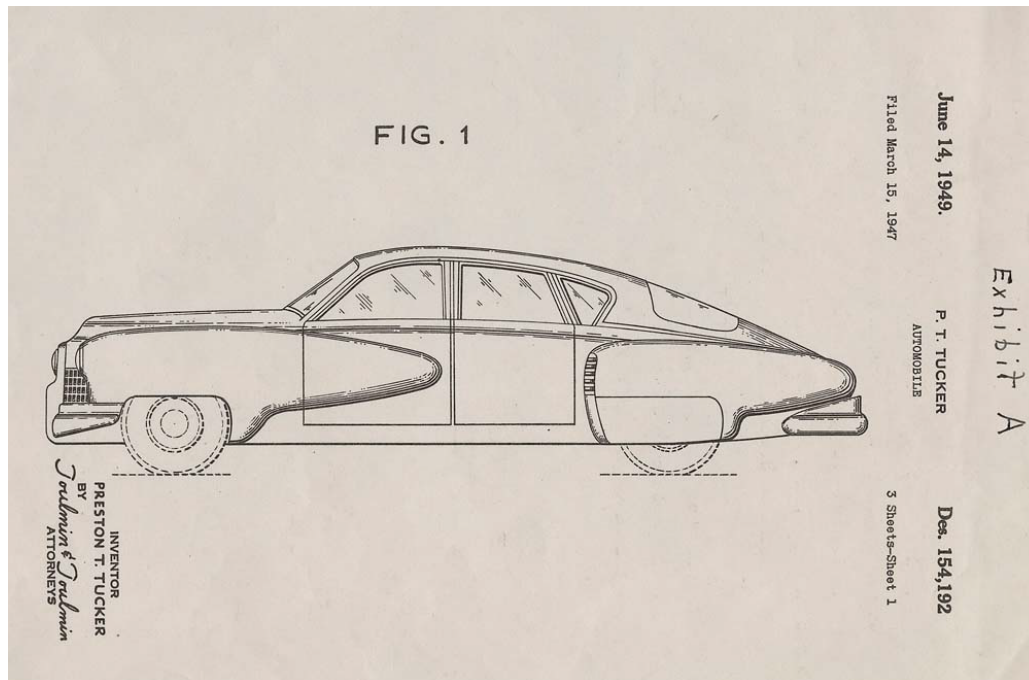
2 Opposition may only be based on the ground that the subject of the patent is not patentable in terms of Articles 1a, 1b and 2.

3 If the Institute finds in favour of the opposition in its entirety or in part, it may revoke the patent or uphold it with a modified scope. The decision regarding an opposition is subject to appeal before the Federal Administrative Court.

4 The Federal Council regulates the details, in particular the procedure.

4. OTHER ISSUES

Torpedos



4. OTHER ISSUES

Patent trolls



<http://www.havetravelfun.com/images/2002/norway/horway402.jpg>

www.tejje.nl

THANK YOU FOR YOUR ATTENTION !



Prof. Daniel Kraus
(PI)²
Avenue du 1er Mars 26
CH-2000 Neuchâtel
daniel.kraus@unine.ch
www.unine.ch/droit

