

An International Guide to Patent Case Management for Judges

24th Annual Berkeley-Stanford Advanced Patent Law Institute
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Eun-Joo Min

Director, WIPO Judicial Institute



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An International Guide to Patent Case Management for Judges

Understanding judicial systems for patent disputes across the globe

[An International Guide to Patent Case Management for Judges](#) is a comprehensive, accessible and practical guide to the different stages of patent litigation. Focused on ten patent heavy jurisdictions, it has applicability around the world and for all actors in the IP ecosystem.

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Patent litigation and the role of the justice system

- Realization of the instrumental purpose of the patent system requires
 - Robust legal framework for patents
 - Fair and effective justice system
- Specificities of patent disputes
 - Complex procedures that address dynamic technological facts
 - Boundaries of innovative activities/patentable subject matter; infringing activities enabled by new technologies; business-altering injunctions or multi-million dollar damages; significant legal costs; uncertain outcome
 - Courts are called upon to calibrate the balance between the public interest in patent enforcement and other public interests, such as fair competition or public health

Interplay of multiple patent proceedings in different fora

- Administrative proceedings and judicial proceedings
- Parallel judicial proceedings in different domestic courts in same country
- Parallel judicial proceedings in national and regional courts
- Parallel judicial proceedings in courts in different countries
- Judicial proceedings and alternative dispute resolution

Access to justice concerns

- Longer and more costly legal proceedings
- High cost is a concern
 - For parties
 - For judicial systems

Ericsson v Apple

Dispute over appropriate licensing rate for Ericsson's 5G-era portfolio

- Ericsson launches actions in:
 - Belgium
 - **Brazil**
 - **Colombia**
 - Germany
 - Netherlands
 - United Kingdom
 - U.S. Federal District Court
 - U.S. International Trade Commission
- Apples responds with actions in:
 - Germany
 - U.S.
 - Patent validity challenges at the USPTO PTAB

Technology products in the global market are enforced by a web of territorial rights, with major patent disputes litigated in multiple jurisdictions



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+ 70 contributors

- **In collaboration with Berkeley**

- **Teams led by:**

- Justice Annabelle Bennett (ret.) (Australia)
- Judge Eduardo Azuma Nishi (Brazil)
- Judge Du Weike and Judge Judge He Juan (China)
- Justice Klaus Grabinski (Germany)
- Justice Madan B. Lokur (ret.) (India)
- Chief Judge Ryuichi Shitara (ret.) (Japan)
- Judge Kyuhong Lee (Republic of Korea)
- Lord Justice Colin Birss (UK)
- Professor Peter S. Menell (US)
- Frédéric Bostedt and Nikolaus Obrovski (Boards of Appeal of the EPO)



An International Guide to Patent Case Management for Judges

- Patent systems and patent institutions, incl. administrative proceedings
- Judicial systems and their specialization
- Patent infringement proceedings and case management
 - Civil law systems: front-loaded proceedings; prioritization of written pleadings submitted before the trial; less frequent appointment of experts
 - Common law systems: evidence is generally presented during trial through party-appointed experts; broad discovery
 - Specialized set of procedural rules or court practice directions or notes that supplement civil procedure rules

An International Guide to Patent Case Management for Judges

- Specialized set of procedural rules or court practice directions or notes that supplement civil procedure rules
 - Govern the conduct of patent cases
 - Judicial assignment procedures and bench composition
 - Key principles of case management applied by the court: early case management, deadlines for parties' contentions, claim construction, use of court-appointed or party-appointed experts, gathering of evidence and extent of discovery, pre-trial motion practice, technology tutorials, alternative dispute resolution
 - Remedies
- Selected topics: SEPs, pharmaceutical patents, compulsory licenses



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Chapter 1 Introduction ▾

Chapter 2 Australia ▾

Chapter 3 Brazil ▾

Chapter 4 China ▾

Chapter 5 Germany ▲

5.1 Overview of the patent system ▾

5.2 Patent institutions and administrative review proceedings ▾

5.3 Judicial institutions ▾

5.4 Patent invalidity proceedings and invalidity grounds ▾

5.5 Patent infringement ▾

5.6 Judicial patent proceedings and case management ▾

5.7 Civil remedies ▾

5.8 Enforcement of judgments ▾

5.9 Appellate review ▾

5.10 Border measures ▾

5.11 Selected topics ▾

Chapter 6 India ▾

Chapter 5 Germany

Authors: Justice Klaus Grabinski, Judge Peter Tochtermann, Thorsten Bausch, Marcus Grosch, Klaus Haft and Julia Nobbe

5.1 Overview of the patent system

5.1.1 Evolution of the patent system

The German Patent Act (“Patentgesetz”) finds its roots in the Reichspatentgesetz of May 25, 1877, which has since undergone numerous revisions and consolidations. The current version is based on the 1981 revision, with the latest significant modification having entered into force in August 2021. In this modification, the right to a permanent injunction, above all, was adapted so as to clarify that, under exceptional circumstances, the claim for injunctive relief may be precluded by the objection of disproportionality.

Since its beginnings, patents have been granted throughout all federal states in Germany by a centralized federal body – first the Imperial Patent Office in Berlin, now the German Patent and Trademark Office (PTO) having its seat in Munich. A major change to the organizational structure of the granting authority was triggered by a landmark decision of the Federal Administrative Court (“Bundesverwaltungsgericht”) in 1959,¹ which found that it was not in line with the fundamental right to judicial review that decisions of the Patent Office could only be appealed to an internal appellate body of the Office. It further held that this appellate body could not be regarded as a court since its decisions were rendered by civil servants not being furnished with the independence and impartiality of a judge. This led to the establishment of the Federal Patent Court (FPC; “Bundespatentgericht”)² in Munich in 1961 after necessary changes to the German Constitution had been made.³

5.1.2 Importance of the European Patent Convention and EU law

Despite the principle of territoriality, which limits the geographical scope of protection of patents to the country of grant, German patent law is continuously and increasingly subject to international – primarily European – influences as part of the European integration. These influences are multifaceted and reach from the granting of patents to their enforcement.

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 - Evolution of the patent system
 - Patent application trends
- Patent institutions and administrative review proceedings
 - Patent institutions
 - Administrative review proceedings
- Judicial institutions
 - Judicial administration structure
 - Specialized intellectual property judiciary
 - Relationship between invalidity and infringement proceedings
 - Judicial education on intellectual property
- Patent invalidity
- Patent infringement
- Claim construction

2. Select jurisdictions

- Chapter 2 Australia
- Chapter 3 Brazil
- Chapter 4 China
- Chapter 5 Germany
- Chapter 6 India
- Chapter 7 Japan
- Chapter 8 Republic of Korea
- Chapter 9 United Kingdom
- Chapter 10 United States of America
- Chapter 11 The Boards of Appeal of the European Patent Office

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- Patent infringement
 - Claim construction
 - Infringement analysis
 - Defenses
- Judicial patent proceedings and case management
 - Key features in patent proceedings

2. Select jurisdictions

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Patent infringement

Claim construction

SHARE



Machine translation

Australia

India

Japan

2.5.1 Claim construction

This section focuses on claim construction in the Federal Court of Australia, given that patent matters are primarily conducted in that jurisdiction.

2.5.1.1 The role of claim construction

The proper construction of a patent is a question of law. The construction of the patent in question is important to most issues in patent disputes and can often be determinative of them. In particular, the proper construction of a patent may:

- indicate the meaning to be attributed to the claim features (integers) for the purposes of determining whether the allegedly infringing product or method, or prior art said to anticipate the claim or render it obvious, possesses those features;
- determine whether the words of the claim meet the requirement for the claim to be

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Judicial patent proceedings and case management

Provisional measures

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3.7.1 Injunction

In Brazilian law, in order to avoid urgent and potentially harmful situations (in many such cases, the main action cannot be filed), injunctive reliefs, regulated by Articles 300–311 of the CPC, are available. In the LPI, this is specifically provided for in Article 209(1), which authorizes the granting of an injunctive relief even before the service of process to the opposing party.

Injunctive relief is granted when there is evidence of the likelihood of the right and the danger of damage or risk to the useful outcome of the case (Article 300 of the CPC). For the granting of interlocutory relief, the judge may, depending on the case, require a security interest or personal guarantee for compensating the damage that the other party may suffer.

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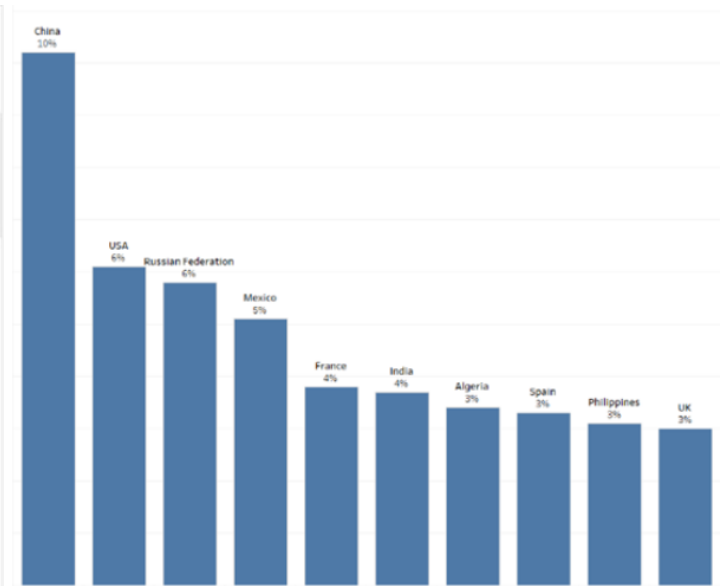
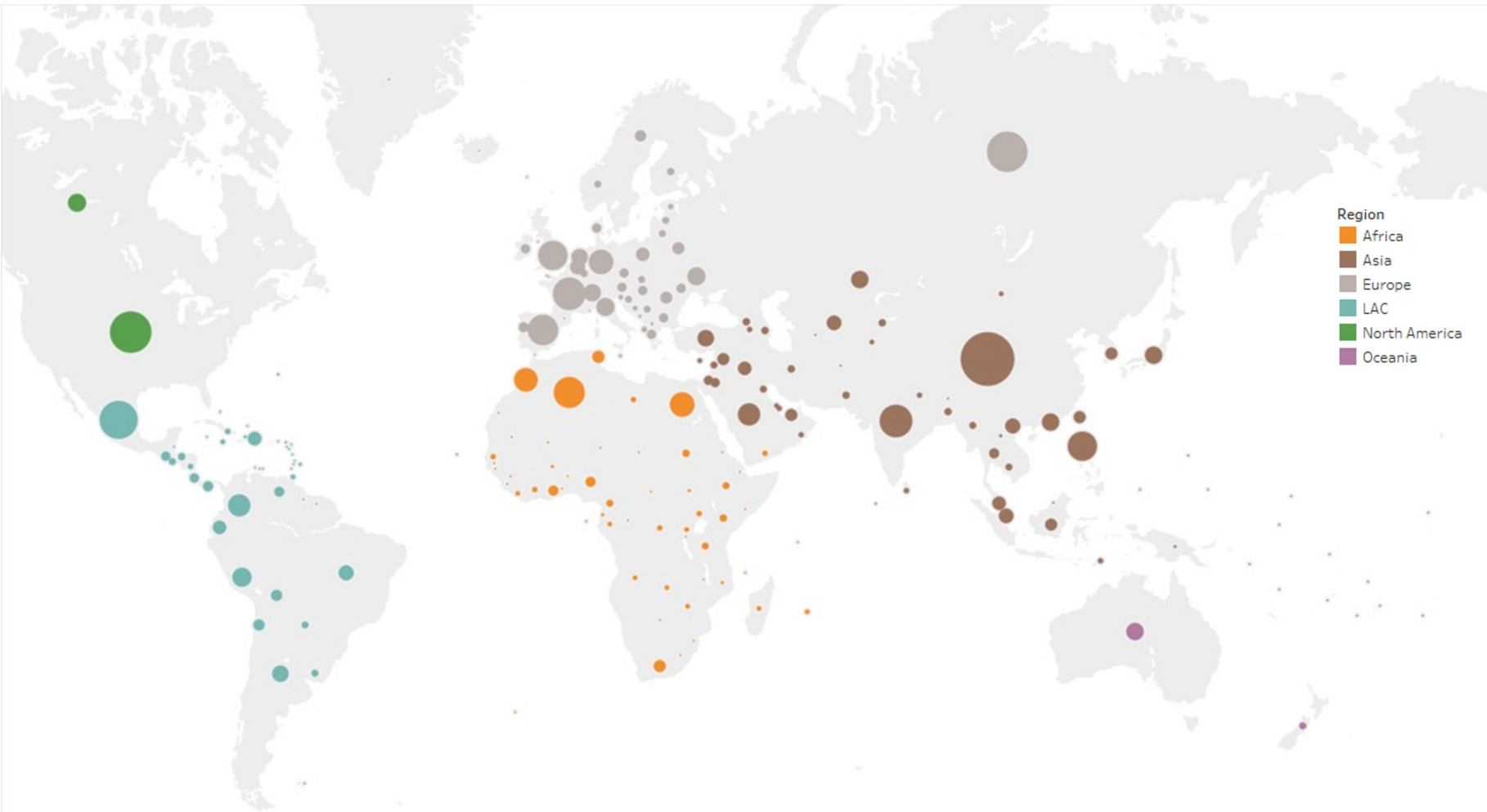
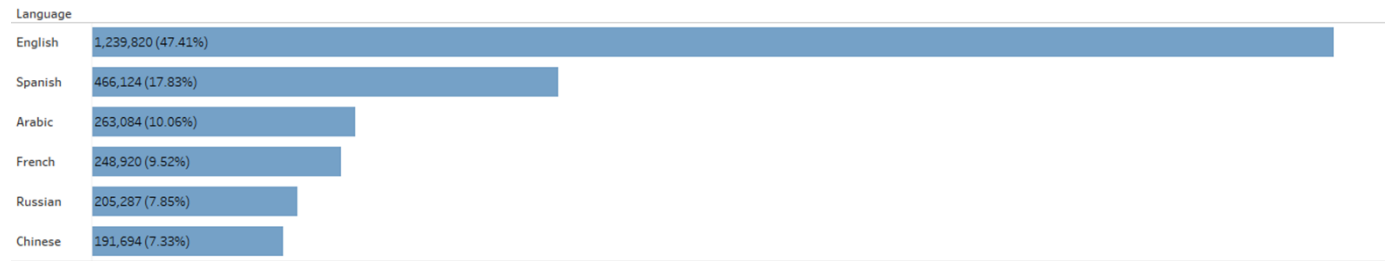
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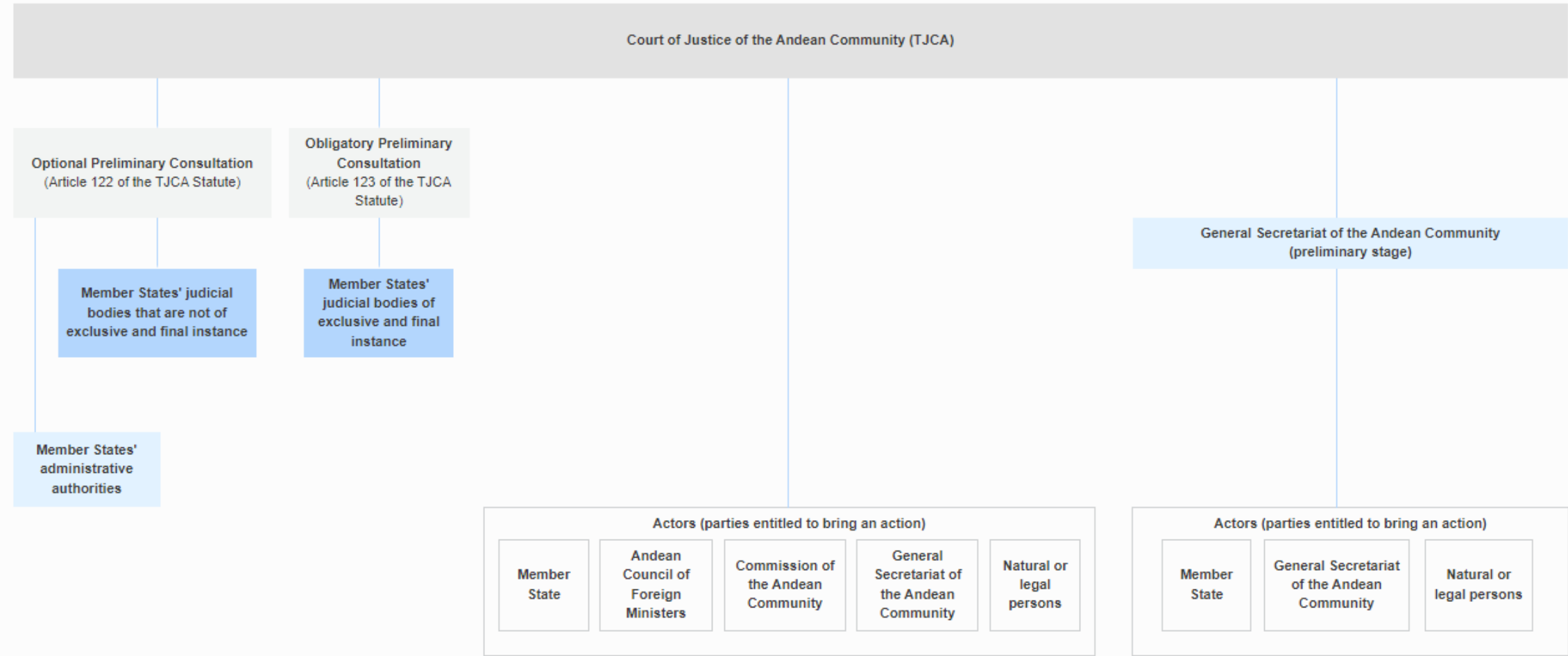
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[Andean Community](#)Total
115 texts[Judicial Administration Structure for IP Disputes](#)

Date of Judgment ^	Issuing Authority	Citation	Subject Matter	WIPO Lex No.
December 15, 2021	Court of Justice of the Andean Community	Interpretación Prejudicial N° 481-IP-2019, Infracción sobre derechos de autor [La obra audiovisual. La obra cinematográfica. La calidad de director y codirector de una obra audiovisual]	Copyright and Related Rights (Neighboring Rights)	CAN114-j
December 15, 2021	Court of Justice of the Andean Community	Interpretación Prejudicial N° 79-IP-2021, Infracción de Derechos de Autor y Derechos Conexos [El derecho patrimonial de comunicación al público de interpretaciones o ejecuciones (derechos conexos)]	Copyright and Related Rights (Neighboring Rights)	CAN003-j
December 7, 2021	Court of Justice of the Andean Community	Interpretación Prejudicial N° 259-IP-2021, Solicitud de medida en frontera solicitada por Toyosa S.A. en relación con la marca TOYOTA	Industrial Property, Trademarks	CAN038-j
December 7, 2021	Court of Justice of the Andean Community	Interpretación Prejudicial N° 567-IP-2019, Cancelación del Certificado de Obtentor de una variedad vegetal [Cancelación del Certificado de Obtentor por la falta de pago de las tasas periódicas para mantener su vigencia. El período de gracia]	Industrial Property, Plant Variety Protection	CAN115-j

Judicial Administration Structure for IP Disputes: Andean Community

Information provided by:

Court of Justice of the Andean Community (TJCA)



Preliminary Ruling

The interpretation of regulations constituting the legal system of the Andean Community in cases where those regulations must be applied or are being challenged in an internal trial.

Action for annulment

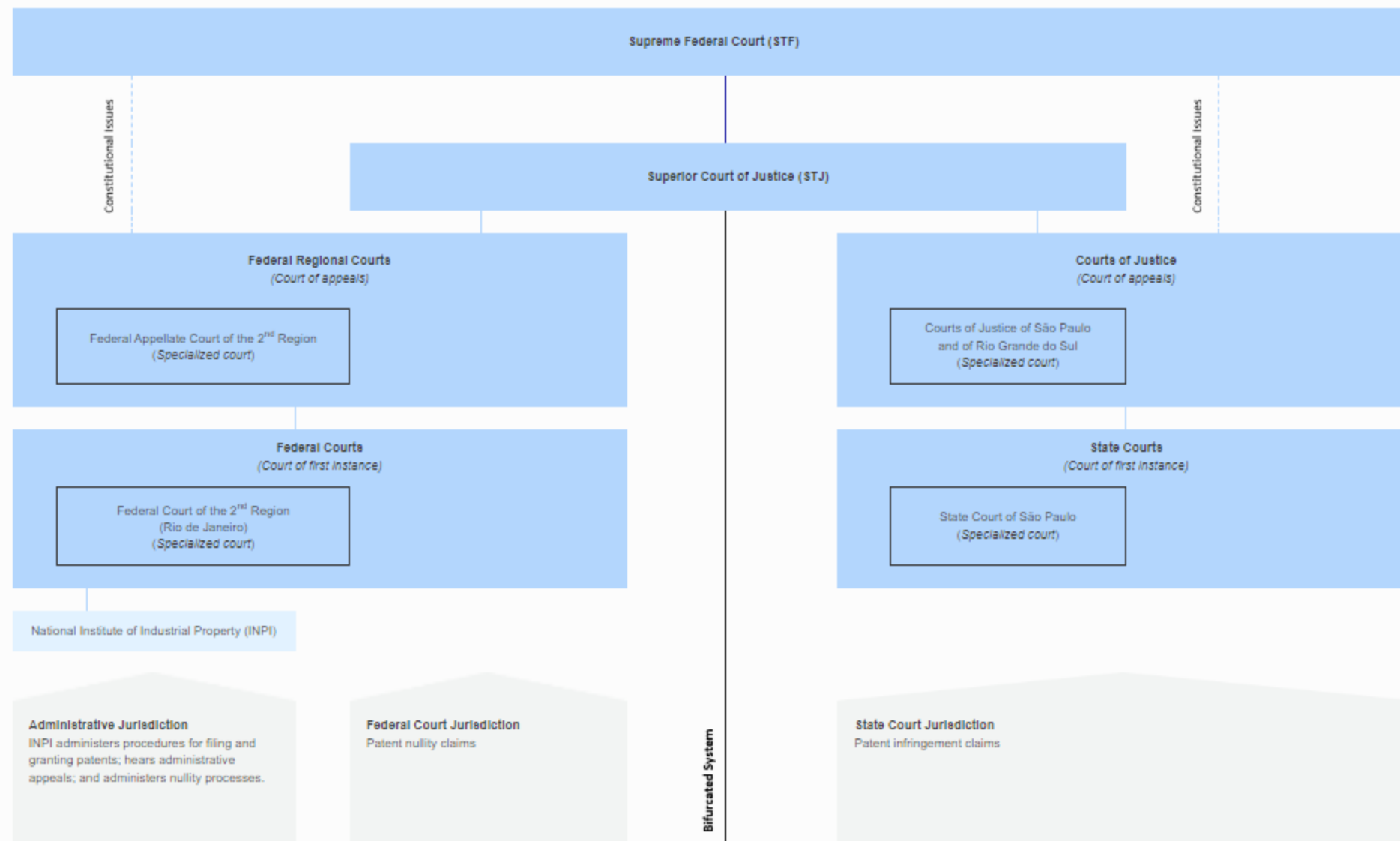
An action for annulment (legality check) can be filed against Decisions of the Andean Council of Foreign Ministers and the Commission of the Andean Community, Resolutions of the General Secretariat or other regulations that are issued or approved in violation of the regulations constituting the legal system of the Andean Community, including through abuse of power.

Infringement Proceedings

Conduct of a Member State considered contrary to the legal system of the Andean Community.

Judicial Administration Structure for Patent Disputes: Brazil

Information provided by:
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WIPO ADR for FRAND Disputes

- WIPO Arbitration and Mediation Center has administered **over 80 WIPO mediation cases** relating to FRAND licensing negotiations
- Examples
 - Mediations between large SEP holders and implementers in Asia and Europe to facilitate the agreement of FRAND licensing terms
 - Requests for WIPO Mediation relating to licensing negotiations between SEP holders and patent pool administrators and implementers in relation to ongoing unsuccessful patent licensing negotiations
 - IP courts in Paris, France and China (WIPO Shanghai Service) have referred ICT patent infringement cases to WIPO Mediation
- Information available: <https://www.wipo.int/amc/en/center/specific-sectors/ict/frand/>

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