

GOMEZ-ACEBO & POMBO

Effectively Enforcing Intellectual
Property Rights Outside the
Americas: Litigation v.
Arbitration v. Mediation

Litigation in Europe

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NATURE OF THE RIGHTS

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1.National rights: Trademarks, patents, utility models, national design rights, copyrights, industrial and commercial secrets

2.Community rights: Community trademarks and Community designs

3.The European Patent: It is not a single right for the entire European territory, but rather a group of national rights for those countries for which the patent has been granted

TERRITORIAL COMPETENCE

- The intellectual property rights may be enforced (Council Regulation (EC) No 44/2001):
 - a) In the place where the defendant has its domicile, regardless of what his nationality is (provided that it is domiciled in a Member State). If the defendant does not have its domicile in a Member State, national provisions would apply;
 - b) Or in the place where the harmful event occurred or may occur
- A person domiciled in a Member State may also be sued, where he is one of a number of defendants, in the courts for the place where any one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings

CROSS BORDER INJUNCTIONS

- Cross border injunctions are in principle possible when the action is filed before the Courts of the Member State where the defendant has its domicile.
Problems:
 - Exclusive jurisdiction of Member States granting intellectual property rights in proceedings concerned with validity of such rights. **ECJ "GAT Case"**
 - Applicable Law: national law governing the intellectual property right.
 - Subsidiaries are not considered as being "the same party". **ECJ "ROCHE Case"**
 - Possible national restrictions on the enforcement of the decisions issued in a different jurisdiction
- As a result, regarding national rights (including the European Patent) cross border injunctions are very difficult to obtain in intellectual property cases

CROSS BORDER INJUNCTIONS (II)

- **Community rights:** may be enforced on a country-by-country basis. Possibility of obtaining relief for the entire Community territory (cross border injunctions) when:
 - a) The defendant has its registered domicile in a Member State and the claim is filed before the Community Court of that Member State;
 - b) The defendant does not have its domicile in a Member State but the plaintiff does and the claim is filed before the Community Court of the Member State corresponding to the plaintiff's domicile
 - c) The claim is filed before the Community Court of Alicante (headquarters of the OAMI)

OVERALL EUROPEAN PERSPECTIVE

1. Not all of the EU Members have specialized Courts for intellectual property cases
2. Germany, the UK, France, the Netherlands, Spain, Italy and Denmark do have specialized Courts, and some of them are highly specialized in patent cases.
3. Some Courts possess a technical background (i.e., Germany)
4. Characteristics of the proceedings will vary very much from one country to another
 - Front loading system v. drips and drabs system
 - Discovery and cross examination
 - Number of sessions for the trial
 - Written phases v. oral phases. Legal terms

TIMING AND COSTS

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	DE	NL	SP	IT	FR	UK	DK
TIME	8 to 12 months	12 months	12 to 18 months	18 to 36 months	16 to 24 months	9 to 18 months	8 to 24 months
SUMMARY PROC	No	Yes, 4 months	No	No	No	Yes, 6 months	Yes*, 4 months
COSTS (€)	30.000 to 300.000	75.000 to 300.000	40.000 to 300.000	30.000 to 250.000	150.000 to 300.000	250.000 to 500.000	30.000 to 300.000

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ISSUES TO BEAR IN MIND BEFORE GOING INTO LITIGATION

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1. Do I need preliminary injunctions?
2. Do I have enough evidence of the infringement?
3. Can the validity of the intellectual property right be challenged by the defendant?
4. Where are the potential infringers domiciled?
5. Do I need to obtain a decision on the merits of the case as soon as possible?

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THE FUTURE OF THE UNITARY PATENT

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1. Project for having a unitary patent
2. Contrary to the European Patent, the Unitary patent will be a single right with effects in all the Member States
3. It will not be a Community right and the different countries will join via international treaties.
4. Enforcement and validity of the unitary patent will be handled by the Unified Patent Courts

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THANK YOU

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