

# **EPLAW**

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European Patent Lawyers Association

## **YEARBOOK**

### **2007 – 2008**

**(Editor : F. de Visscher, Past Secretary to the Association)**

Association européenne d'avocats spécialisés dans le contentieux des brevets d'invention  
Europäische Vereinigung der Patentrechtsanwälte

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Siège : Avenue Louise, 149 (boîte 20) 1050 BRUXELLES - BELGIQUE  
Association sans but lucratif (Loi du 27 juin 1921)

Dear Friends,

Our Association is steadily growing and certainly finding recognition with the Patent Judiciary, the Commission and the EPO. Together with the EPO we have successfully organized the fourth Venice Forum. The initiative to give access to 10 members who were the lucky winner of the draw in the beginning of the year proved a success - all enjoyed the participation. The Forum, for which we organized the program, was again of high quality and ended with a further important Resolution adopted by the Judges. The EPO and EPLAW intend to have a fifth Forum next year.

This year we organized for the first time a Young EPLAW Congress. Although I had to urge you to send your youngsters (and was somewhat nervous whether or not we would attract enough participants) many of you supported us in the end and the Congress (and the social event the evening before) was a great success. We will organize again a Young EPLAW Congress in 2009 and I trust you again will support it. We will keep the price as low as possible and, as last year, make sure that the program is of high educative value.

We remain closely involved in the work of the Commission towards a European Patent Jurisdiction. Our intent is to ensure that the system will be equitable and efficient, but also that the primary role of the specialist patent litigator, who is not only a specialist in patent law but also fully versed in procedural and other related areas of law, remains recognised and maintained.

We live in interesting times where patent law is the subject of heated public debate. I refer for instance to the Report of the Commission in the Pharmaceutical Sector Inquiry. I am very proud that the first debate with respect to this Report, attended by representatives of the Commission and industry, will take place during our 2008 Annual Congress.

Being President of your Association is a great honour but combined with the daily practice you all know too well, a sometimes tough task. I am very grateful that we have a Board whose members are of great help to me. This year, two members will leave the Board: Kevin Mooney, my predecessor who has supported me magnificently in my first year as President, and Peter Heinrich our Treasurer who has done a wonderful job with Swiss precision and who leaves the Association in a healthy financial state.

Of course without your continued support the Association would not have been where we are today. Please continue that support, keep visiting our website, keep coming to our meetings and keep sending your youngsters to Young EPLAW.

I wish you all an excellent Annual Congress and a prosperous 2009.

Your President,  
Willem A. Hoyng

**EPLAW Congress  
2007**

**President's Report**

**16 November 2007**

**Kevin Mooney**

**Simmons & Simmons**

## **President's Report**

- **Guests:**
- **EPLAW'S MAIN OBJECT**
  - “The consistent and cost-effective enforcement of patent rights throughout Europe in one court offering local access to patentees and a simple language regime”

**Simmons & Simmons**

## President's Report

- 2006 was a good year for EPLA
  - July 2006: Brussels meeting reports that users overwhelmingly support EPLA
  - C McCreedy stated on 28 September 2006: “there is a strong call for the improvement of the existing European Patent system... by the successful conclusion of a... EPLA”... BUT... “the Community needs to get involved in EPLA”
  - September 2006 Thessaloniki declaration – now 73 judges support EPLA
  - October 2006 – further AIPPI resolution in Gothenburg in favour of EPLA

## President's Report

- October 2006 – European Parliament urges Commission to co-operate with EPLA BUT – mixed competence?
- November 2006 – Venice II Resolution re Rules of Procedure for EPLA courts

## President's Report

### ■ HOWEVER

- October 2006 – The Guillaume Paper reflected opposition to EPLA from France – followed in early 2007 by Spain, Italy, Portugal, Cyprus and Luxembourg: "Communitise the EPLA"
- January 2007 – Legal Services of European Parliament say EPLA is "mixed competence". Now Parliament Commission and Counsel are unanimous
- Commission stalled until 03 April 2007 when it finally published its Communication to the European Parliament and the Council – recommends "Compromise C"
- June 2007 Germany: Presidency organises Munich Symposium: The arrival of Dr. Fröhlinger
- Content of Munich Symposium is confused – "bifurcation" over lunch

## President's Report

### ■ PORTUGUESE PRESIDENCY:

- 12 July 2007 – Agenda for 4 meetings with national experts
- 10 October – First "Non-Paper": bifurcation on table – UK v Germany
- 30 October – Third Paper (Working Document No 14492/07) – now has UK and broad support for:
  - Central chamber and national/regional chambers
  - Pure validity actions and declarations of non-infringement go to central chamber
  - Counterclaims for invalidity heard locally with full court (German support?)
  - Standard procedures for all courts (based on Venice Resolution)

## President's Report

- One level of appeal on substantive patent issues
- Limited review by ECJ
- Flexible language regime

### ■ VENICE 2007

- Dr. Fröhlinger wins cautious support of Judges for Portuguese proposals: "EPLA IS DEAD"

## President's Report

### ■ FUTURE

- Portuguese report to Competitiveness Council dated 9<sup>th</sup> November:
- Broad agreement on "most" of key features of 14992/07
- Outstanding is issue of bifurcation at first instance and the language of judicial proceedings
- Work must now begin on COMPAT urgently
- Slovenian Presidency: 4 further meetings of experts planned
- French Presidency July 2008

### ■ PROGRESS?

## President's Report

### ■ VENICE 2007 – 02-04 NOVEMBER

- 34 Judges from 15 countries
- 15 Lawyers from 8 countries
- President of EPO
- President of epi

### ■ PROGRAMME

- Mock Trial: Enantiomers and rules for novelty/obviousness/insufficiency
- The clash between EPO post-grant procedures and national litigation
- Debate on Portuguese Proposals

## President's Report

### ■ WEBSITE

- Demonstration at 2.30pm
- Expenditure

### ■ MEMBERSHIP AND FEES

- No change

### ■ BOARD OF DIRECTORS

- President: Willem Hoyng
- Vice President: Mario Franzosi
- Directors to be confirmed:
  - Peter Ulrik-Plesner
  - Gonzalo de Ulloa

## President's Report

- Approval of Minutes of General Assembly of 20 November 2006
- Financial Statement of EPLAW as of 31 December 2006
- Budget for 2008
- Quietus to Board for 2006

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EPLAW Congress  
2007

President's Report

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# **Damages in German Patent Litigation**

presented at the  
EPLAW Congress  
Brussels  
16 November 2007

by

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Dr. Klaus Grabinski  
Presiding Judge at the District Court,  
Düsseldorf, Germany

## **• I Court System in Patent litigation:**

- 1) Infringement Courts**
  - District Court (limited number)
  - Court of Appeal
  - Federal Supreme Court
  
- 2) Invalidation Courts**
  - Federal Patent Court
  - Federal Supreme Court

• **II Two-Step Patent Infringement Proceedings:**

– **Remedies available in first proceeding:**

- cease and desist (injunction)
- supply of information (about origin and routes and amount of delivery)
- rendering account (of the extent of the infringing actions and the profit achieved)
- declaration that the infringer is liable for damages
- destruction of the infringing product

Damages in German Patent Litigation

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– **Remedy available in second proceeding:**

- order to pay damages

Damages in German Patent Litigation

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- **III Entitlement**

- Patent holder
- Exclusive licensee
- Not: Simple licensee
  - Patent holder (or exclusive licensee) can transfer the claim for damages to a simple (sub)licensee.

- **IV Three methods of computing damages:**

- return of profit made by the infringer
- reimbursement of lost profits incurred by the infringed party
- payment of a reasonable royalty (licence analogy)

