

Bird & Bird

United Kingdom

Patent Litigation Q&A

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United Kingdom – Patent Litigation

Where can patent infringement actions be started? Is there a choice of venue?

Patent infringement proceedings may be brought in the Patents Court or the Intellectual Property Enterprise Court (“IPEC”). The IPEC is intended primarily for smaller or simpler cases, where the total legal costs recoverable by a successful party are capped at £60,000 for the final determination of liability, and at £30,000 for enquiries as to damages or accounts of profits. There is a limit of £500,000 on the financial remedies available. Infringement claims may also be brought in the UK Intellectual Property Office (“UKIPO”), but injunctions are not an available remedy there.

Are the judges’ specialists? Do they have technical backgrounds?

In the Patents Court, there are designated judges and deputy judges who have scientific backgrounds. The judge in the IPEC also has a technical background. There are specialist patent judges in the Court of Appeal but currently there is no specialist in the Supreme Court.

How long does it take from starting proceedings to trial?

The aim of the Patents Court and the IPEC is to bring cases to trial within 12 months of commencement, however, due to the large number of cases in the lists it is, at present, often taking longer.

Can a party be compelled to disclose documents before or during the proceedings?

The current disclosure scheme in operation in the Patents Court (which was first introduced in January 2019 as a pilot, but is now a permanent part of the Civil Procedure Rules) requires Initial Disclosure of key/limited documents which are relied on by the disclosing party and are necessary for other parties to understand the case. These must be given with the statements of case.

Before the Case Management Conference, the parties are required to discuss “Extended Disclosure” and jointly complete a Disclosure Review Document setting out the issues, if any, for disclosure and the scope of the searching to be done in relation to each issue, using Models A to E. The court will be proactive in directing which is the appropriate Model and need not accept without question the Model proposed by the parties.

This scheme does not operate in relation to IPEC proceedings. Instead, disclosure is dealt with at the Case Management Conference on an issue-by-issue basis in accordance with the IPEC’s costs-benefit analysis.

Pre-action disclosure is also possible, but is not common.

How are arguments and evidence presented at the trial?

Parties present their arguments by way of oral submissions by their advocates. Experts and witnesses of fact are called to briefly confirm their written evidence after which they are submitted to be cross-examined. Re-examination of the oral evidence given in cross-examination is allowed afterwards.

In the IPEC, the court may determine the claim without a trial if all parties consent. If there is a trial, the Enterprise Judge will determine the amount of time allocated to each party and for cross-examination of any of the witnesses and experts.

How long does the trial generally last and how long is it before a judgment is made available? Are judgments publicly available?

On average, a trial of a single patent in the Patents Court will take four to five days. Trials in the IPEC are limited to two days.

A written judgment is generally handed down by the judge within four to eight weeks after the end of the trial, although it can be longer, at which time it becomes public and may be freely disclosed, subject to any confidentiality order. Judgments with parts redacted may be issued in certain circumstances.

The Royal Courts of Justice currently provide copies of most judgments to the National Archives for publication.

Can a defence of patent invalidity be raised? Are infringement and validity issues heard together?

Invalidity can be raised as a defence to an infringement action and is normally accompanied by a counterclaim for revocation, supported by grounds of invalidity.

Validity and infringement are dealt with in the same proceedings and are not bifurcated.

Are infringement proceedings stayed pending resolution of validity in the national patent office (or, if relevant, the EPO) or another court?

Whether proceedings are stayed is a matter of discretion for the court, depending on whether a stay is in the interests of justice. In *IPCom v HTC* [2013] EWCA Civ 1496, the Court of Appeal was of the view that a stay of the national proceedings pending the outcome of the EPO opposition should be the default option provided that there are no other factors to consider.

The issue of a stay does not arise in practice between the court and the UKIPO since any ongoing revocation proceedings before the UKIPO will normally be transferred to the court following the commencement of an infringement action. Further, a decision in relation to a corresponding patent in another country is not binding on the UK court and so an action in relation to such a patent is not a ground for a stay.

Are preliminary injunctions available? If they are, can they be obtained *ex parte*? Is a bond necessary? Can a potential defendant file protective letters?

Preliminary injunctions are available and are granted if (i) there is a serious issue to be tried; that is to say there is an arguable case, (ii) the “balance of convenience” favours an injunction or, all things considered, is even, and (iii) the claimant gives a cross-undertaking to compensate the defendant in damages if the injunction is wrongly granted.

Preliminary injunctions are unusual in patent cases and are, in practice, restricted to pharmaceutical cases where a defendant proposes to introduce a first generic product and where the claimant can show that there will be irreparable damage because of irreversible price erosion.

Injunctions are only granted on an *ex parte* basis where the claimant can show that the matter is so urgent that the defendant may not be notified or where there is a real concern that the defendant may dispose of evidence. Protective letters are not available in the UK.

Are final injunctions available as of right? Is a bond necessary?

Final injunctions are almost always granted if the claimant is successful at trial but are a matter for the court’s discretion, giving flexibility. Article 3(2) of the Enforcement Directive 2004/48/EC requires the court to refuse to grant an injunction where it would be “disproportionate” to grant one, but the burden to prove this is a heavy one. A bond is not necessary.

What other remedies are usually ordered if a patentee is successful?

Available remedies include the delivery up or destruction of infringing goods, damages/an account of profits (calculated in separate proceedings), appropriate measures for the dissemination and publication of the judgment and an award of costs.

The court also has discretionary power to award declarations. Where validity is not in issue, the Patents Court has granted declarations of non-infringement in respect of the foreign counterparts of a UK European patent.

Would the tribunal consider granting cross-border relief?

In most cases where validity is raised as a counterclaim, there can be no cross-border relief in relation to a European patent because the other countries designated have exclusive jurisdiction over patent validity. As mentioned in answer to the previous question, where validity was not in issue, the court has granted a cross-border declaration of non-infringement (pre-Brexit). (*Actavis Group HF v Eli Lilly and Company* [2012] EWHC 3316 (Pat)).

However, the Supreme Court held in *Unwired Planet v Huawei* [2020] UKSC 37 that the court can settle the terms of a Fair, Reasonable and Non-Discriminatory (FRAND) licence on a global basis where a UK patent is found to have been infringed.

Is there a right of appeal from a first instance judgment? How long between judgment at first instance and hearing the appeal?

A judgment may be appealed if the trial judge or the Court of Appeal considers that the appeal has “a real prospect of success”. It takes between nine and 15 months for the appeal to be heard.

Is an appeal by way of a review or a rehearing? Can new evidence be adduced on appeal?

An appeal is by way of a review. New evidence or material is not allowed on appeal unless it could not, with due diligence, have been found for use at the trial, and even then, it is only allowed when it is likely to have a material effect on the appeal.

What is the cost of a typical infringement action to first instance judgment? If the issues of invalidity and infringement are bifurcated, what is the cost of the invalidity action? Can the winner's costs be recovered from the losing party? How much is the cost of an appeal?

The typical cost of infringement/invalidity action is in the region of £750,000 to £1,250,000 for the Patents Court depending on such matters as the number of patents/claims in dispute, the number and nature of the invalidity attacks, and whether more than one expert is required to give evidence at the trial. Cost budgeting is now required and parties must prepare and exchange costs budgets early in the proceedings (except where the value of the claim is certified to be £10 million or more).

The general rule is that the overall winner can expect to be awarded their costs of the action. The Patents Court adopts an issue-based approach which means that, in practice, a discount will be made for the costs of those issues on which the winner lost. A party in whose favour a costs order is made would normally expect to recover approximately 65–75% of their actual legal costs which are the subject of that order. Where costs budgets have been employed, the winning party is likely to recover at least 80–90% of those costs.

As a result of the nature of the appeal process, the costs of an appeal are normally considerably less than those at first instance. Cost recovery is dealt with in a similar way to that in the Patents Court. If a decision is successfully appealed, it will open up the decision on the costs awarded at first instance.

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