At home in all major UPC divisions & all national patent courts & strategic management of portfolios & multinational litigation & your key to success & that's the UPC with **Bird & Bird**
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The future of patent litigation in Europe: The Unitary Patent Package

The European Patent Office (EPO) and the participating countries are in the final stages of establishing the Unitary Patent and the Unified Patent Court (UPC). This represents the biggest change to patent law in Europe for 40 years: it will create a single approach to patent registration and litigation across 25 European Member States with a combined population of over 400 million. All businesses need to make sure they are prepared for the changes that this will entail.

The introduction of a single system will make establishing patent protection across Europe easier and more effective, facilitating the protection of innovations and inventions. It will also make it possible to challenge patents and to obtain rulings preventing the distribution of goods and the use of patented processes across all the participating Member States. In addition to the existing knowledge and skills that we have developed as Europe’s leading Patent Litigation firm, we have created a specialist UPC team to help our clients to navigate the new landscape effectively and to enable them to continue to handle their and others’ intellectual property strategically in this new environment.

Any company operating in Europe for whom the protection and exploitation of intellectual property is an important concern should take the time to inform themselves about the new Unitary Patent system and develop a tailored patent strategy for Europe. This guide provides an overview of the key aspects of the Unitary Patent system and gives an indication of the options that companies may wish to consider as they prepare for the currently anticipated implementation of the new system in 2018.

Key features of the Unitary Patent system

- Expected to start in 2018; sunrise register expected to open early 2018 subject to the German Constitutional Court accepting an application to look into the lawfulness of the UPC
- A single patent will cover up to 25 participating Member States for approximately the same cost as it currently costs to obtain and maintain protection in 4 countries
- A single judgment will cover all participating Member States
- A single territory for direct and indirect infringement
- Proceedings on the merits will be concluded in around 1 year
- English will be available in all divisions

The UPC will benefit from a pool of experienced patent judges
- The approach of the UPC’s main local divisions is likely to be similar to the approach currently taken by the national courts (i.e. these local divisions will reflect a degree of ‘couleur locale’)
- Preliminary injunctions will be available
- Seizure of evidence will be possible in some circumstances
- Forum shopping options will require careful consideration
- UK expected to be part of the system despite plans for Brexit.
How it will work

Unitary Patent

The Unitary Patent is a single patent that will be effective across all participating Member States within the EU. It will only need to be registered at the EPO and, in contrast to the current system, it will no longer be necessary to obtain national validations in the countries covered by the patent. Patentees will instead be given the option to designate other EPC states in addition to the centrally filed Unitary Patent. The centralised process for filing, examining and granting patents will be available in German, French or English in exactly the same way as European Patents (EPs).

There will be a single renewal fee instead of a fee per country: this will be equivalent to the current renewal fee for an EP designating the UK, Germany, France and The Netherlands. It should be noted that Croatia, Poland and Spain are not currently participating in the Unitary Patent system, although Croatia intends to join at a later date.

Unified Patent Court

The UPC is a supranational court that will cover all participating Member States in one action. The UPC will have jurisdiction over new Unitary Patents, as well as traditional EPs. It will consist of specialised patent judges and will apply its own autonomous substantive and procedural law. Judgments at first instance will be given within approximately 1 year of the start of the action.

The UPC will have a number of Courts of First Instance located in various participating Member States, together with a Court of Appeal based in Luxembourg:

- **Central division**
  - Seated in Paris (electronics), with specialist divisions in London (chemistry, pharmaceuticals, biologics and medical devices) and Munich (mechanical engineering).

- **Local divisions**
  - Seated in individual participating Member States.

- **Regional divisions**
  - Seated in certain Member States where two or more participating Member States group together.

- **The Court of Appeal**
  - Seated in Luxembourg.

Central division

The central division will have exclusive jurisdiction over declarations of non-infringement and revocation actions (other than counterclaims). If a revocation action is pending, the patentee may bring an infringement action in the central division too.

Local and regional divisions

Local and regional divisions will be responsible for infringement actions and counterclaims for revocation. Bifurcation may be possible, but prevailing opinion currently suggests that this will be unlikely. Local divisions in some countries will have 'couleur locale', which is expected to be similar to the current national patent courts.
### Court Structure

#### Court of Appeal
Luxembourg
(Registry)

#### Central Divisions

**Paris**
- Seat & sub registry
- Performing operations, transport
  - Textiles, paper
  - Fixed constructions
  - Physics
  - Electricity

**London**
- Human necessities
- Chemistry, metallurgy

**Munich**
- Mechanical engineering, lighting, heating, weapons and blasting

#### Local & Regional Divisions & Languages

**Local**
- **London** – English
- **Düsseldorf, Munich, Mannheim and Hamburg** – German (English limited rule)
- **Paris** – French and English
- **The Hague** – Dutch and English
- **Brussels** - Dutch, French, German and English
- **Milan** – Italian and English
- **Helsinki** – Finnish, Swedish and English
- **Copenhagen** – Danish and English
- **Dublin** – English
- **Vienna** – German & English
- **Ljubljana** (TBC) - Slovenian and English

**Regional**
- **Nordic-Baltic Division**
  - Sweden, Lithuania, Estonia and Latvia
  - Proposed:
    - Hungary & Croatia
    - Czech Republic and Slovak Republic
    - Romania, Bulgaria, Greece and Cyprus

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#### Notes

*Status still to be confirmed for some of the proposed regional and local divisions.

**Düsseldorf may allow pleadings in German if the language of litigation is English and reserves the right to issue judgments in German.
Forum shopping
A patentee may either bring an infringement action in the local or regional division where infringement occurs or in a jurisdiction where the defendant resides or has a place of business. For non-EU defendants, a patentee may also bring an infringement action at the central division. A defendant cannot transfer an infringement action from a local division to a central division, but they may be able to transfer the action from a regional division.

Bifurcation and other procedural issues
- Bifurcation is highly unlikely to occur as prevailing opinion suggests that judges are against it.
- In a counterclaim for revocation in an infringement action, the local or regional division has four options:
  - Keep both sides of the case
  - Refer the counterclaim to the central division and keep the infringement action
  - Refer the counterclaim to the central division and stay the infringement action
  - Refer the entire case to the central division, provided the parties agree
- An infringement action will be stayed where there is a "high likelihood" of the relevant claims being held invalid (UPC Rules of Procedure Rules 37.4 and 118.2(b)).
- Where there is no stay the judge rapporteur shall endeavour to set a date for the revocation action hearing before the infringement action hearing (Rule 40(b)).

Different patents available under the new system
The Unitary Patent system will give patentees a choice of three routes for obtaining patent protection in Europe:
- Traditional European patent: Selecting this option will mean that the application grants in the traditional fashion as a European patent, validated in the patentee's countries of choice.
- European patent with unitary effect: If the patentee opts into the Unitary Patent system within one month of the publication of the grant in the European Patent Bulletin, it will be granted a Unitary Patent covering all the participating Member States (a so-called "European patent with unitary effect"). The patentee will also have the option of obtaining a traditional European patent for protection in the remaining 13 EPC countries.
- National patents: The patentee could avoid the European/Unitary system altogether and apply for a series of national patents through the national patent offices.

Transitional period and provisions
The transitional provisions within the UPC Agreement provide that the UPC will have non-exclusive jurisdiction over all European patents in participating Member States existing during the 'transitional period'. This transitional period will last for 7 years, although it is likely to be extended by up to another 7 years.

- Art. 83(1)
  - "Actions for infringement or for revocation of an EP may still be brought before a national court."
  - During the transitional period, the UPC will have non-exclusive jurisdiction over actions for infringement or revocation.

- Art. 83(3)
  - "Unless an action has already been brought before the Court, a proprietor of or an applicant for a European patent granted or applied for prior to the end of the transitional period (...) shall have the possibility to opt out from the exclusive competence of the Court (...). The opt-out shall take effect upon its entry into the register."
  - Patentees who can opt-out their existing patents and wish to do so should make sure that their opt-out is registered during the sunrise period, which will start on 1 September 2017. Opt-outs can be filed until one month before the end of the transitional period.

- Art. 83(4)
  - Patentees who wish to withdraw their opt-out (i.e. opting back in) may do so at any time, provided no national proceedings have previously been commenced in relation to the patent.
Impact of Brexit

Since the United Kingdom voted to leave the European Union in the Referendum vote of 23 June 2016, there has been a lot of uncertainty with regard to the future of the UPC. However, during the meeting of the Competitiveness Council of the European Union on 28 November 2016, the UK announced that it is proceeding with the preparations to ratify the UPC Agreement, aimed at bringing the UPC into operation as soon as possible and has largely done so.

Secondary legislation to give the UPC its legal personality in the UK, the UPC (Immunities and Privileges) Order 2017, has been laid before UK Parliament and, once they have passed, the UK will be able to formally ratify the UPC Agreement.

When the UK actually leaves the EU, some additional changes will be required to the Unitary Patent Regulation and additional rules will be needed on jurisdiction and enforcement, to replace the current effect of the Brussels I Regulation with regard to the UK. Those additional rules could for instance be part of the Exit Agreement.

Delay to German ratification

In Germany, delay in the ratification process has been caused by a legal challenge brought by an anonymous individual before the Federal Constitutional Court. As a result Germany has suspended formal ratification of the UPC Agreement until the Constitutional Court has reached a decision in the expedited proceedings relating to the action. Germany also cannot notify its consent to the Protocol on Provisional Application until the Constitutional Court has ruled on the current challenge. This will delay the start of the provisional application phase and thereby the selection, appointment, education and training of judges. As a result there will need to be a time interval of around six months between the German judgment and the doors of the UPC being opened in order to allow the necessary administrative arrangements to be put in place.
Strategic Considerations

Although the new system has not yet entered into effect, patentees can and should start developing a strategy now.

(1) Opt-in or opt-out?

Opting-out

Patentees may want to exclude some patents from UPC jurisdiction by filing an opt-out, which prevents a central attack on validity. There will be a sunrise period before the UPC goes "live" when this can be done. Evaluation of existing portfolios before the sunrise period starts will be required.

- Only available for traditional European patents
- No fee
- Preliminary register (during the sunrise period)
- Be ready to file when the sunrise register opens (currently expected to start early 2018.)
- Final register at the UPC
- Works for the life of the patent
- Excludes UPC jurisdiction completely for that patent
- Not possible if an action is or has been pending before the UPC

Opting back in

Patentees who have opted-out will have the option to withdraw their opt-out (i.e. to opt back in), free of charge.

This will not be possible if an action in a national court has ever been pending, including actions that were finished before the Unitary Patent system came into force.

(2) Portfolio management: potential filing strategies

With all the options for obtaining and litigating patents in Europe, patentees are advised to develop a strategy for the management of their portfolios sooner rather than later to determine the mix of national, European and Unitary patents they want to have. Patentees should consider the following strategic options:

- Same "type" of patent for all inventions: This would be the easiest and most straightforward strategy, however it may not be the most cost effective. Additionally, the default type of patent may not necessarily be ideal for a particular case, considering both the available countries and the strength of the patent.

  To compromise between cost and optimal protection, a patentee might be advised to apply generally for the same type of patent, but permit different types to be selected in particular circumstances.

- National patents: Pursuing a national patent strategy may be appropriate if a patent is only needed in a few jurisdictions in Europe (for example, where a patent is relevant to a product developed for a particular market). This strategy might also be appropriate where a product has been developed for the whole European market, but is too valuable a right to allow for the possibility of central attack.

- European patent with unitary effect: Unitary Patents and non-opted out European patents can be invalidated in a single, central attack; therefore consider using this route for strong patents where there is confidence in their validity and where protection is required across Europe (for example, pharmaceutical compounds).
• **Traditional European patent**: Consider opting-out European patents which cover economically important products, but where the validity of the patents is not so certain. Even if the patent is invalidated in one or two jurisdictions, it may be possible to retain value in others.

• **Consider a combination of parent and divisional patents in different categories**: A patentee could consider having a parent patent with unitary effect (or an opted-in European patent) with a very narrow scope and an opted-out divisional (or divisionals) with wider scope. This ‘double shoot’ strategy may be costly, but it allows a patentee to hedge his bets and may therefore be suitable for key products. In this context, it should be noted that – since 1 April 2014 – the restrictions on filing divisionals at the EPO no longer apply. This will enable a patentee to obtain a Unitary Patent and a traditional European patent for almost the same technology. Patentees should therefore evaluate their pending applications with a view to enhancing future enforcement strategies. To be able to obtain a Unitary Patent, the application still needs to be pending when the Unitary Patent Regulation enters into force. The EPO will probably allow stays of patent grants to allow for this.

• **Consider the cost and speed of obtaining patents**: The EPO can be notoriously slow and costly in comparison to some national patent offices where the procedures are far less burdensome (for example, in Belgium, France, Italy and The Netherlands).

(3) **Licensing issues**

• Licensees may want patentees to opt-out, but their existing licence agreements may contain no such provisions. Licensees who want to prevent a central attack should look at this now and discuss the issue with their licensors.

• Exclusive licensees will have the authority to enforce a patent without consent from the patentee, unless the licence provides otherwise. Patentees should therefore check their existing exclusive licence agreements.

• Non-exclusive licensees will not have this option unless the licence provides otherwise (i.e. unless it confers this right on the licensee), so non-exclusive licensees should also check their licences.

(4) **Language of proceedings**

If you are on the defensive side, the language of an action may be a local language, but this may often be changed to the language of the patent. This should be taken into consideration when choosing the language for a patent application.

• **Local and Regional Divisions may designate**
  – Official languages of the country of the local division
  – Designated official language(s) of the region
  – Designated EPO language(s) they will be able to use – all have at least chosen English

• **Generally the Claimant controls the choice of language for the proceedings.**
### Choice of Court

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<th>Patent Portfolio</th>
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<tr>
<td>Unitary Patent</td>
<td>UPC</td>
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<tr>
<td>Traditional European Patent</td>
<td>UPC or national courts*</td>
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<tr>
<td>Countries that ratify late</td>
<td>National action needed there</td>
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### Susceptibility to central revocation

<table>
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<tr>
<th>Patent holder</th>
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<tbody>
<tr>
<td>Patent owner</td>
<td>File opt out</td>
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<tr>
<td>Third Party</td>
<td>Action at UPC blocks opt out</td>
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### Lis pendens rules

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<tr>
<th>Action Sequence</th>
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<tr>
<td>Seize UPC first</td>
<td>Blocks national courts</td>
</tr>
<tr>
<td>Seize National Court first</td>
<td>Limits UPC</td>
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* During the transitional period of at least seven years.
Costs and fees

The official fees for the Unitary Patent have now been decided; however a final decision on the court fees still needs to be made.

Renewal fees

Unitary Patent renewal fees will be equal to the combined renewal fees of the top 4 countries where a traditional European patent is granted. Over 20 years the sum would be:

- **€35,555** – if the patent is granted in the year of application and based on a top 4 of Germany, the UK, France and the Netherlands.

The only financial disadvantage of a Unitary Patent remains that it cannot be ‘pruned’. In other words, you cannot drop countries of validation one by one over time – the Unitary Patent is ‘all or nothing’.

Other portfolio-related fees:

- **Opt-out fee:** There will be no fee to opt out nor will there be a fee to opt back in.
- **Unitary designation:** There will be no fee for a unitary designation.

Court fees

- Basic infringement actions will cost €11,000, plus a sliding scale value-based fee of €0 - 325,000
- Revocation actions will cost €20,000 (fixed fee)
- Application for provisional measures will cost €11,000 (fixed fee)
- Scale of recoverable costs will range from €38,000 to €2,000,000 (depending on value of proceedings)
- Micro and small enterprises will be entitled to a 40% reduction on all Court Fees (fixed and value-based) which are incurred in the Court of First Instance as well as in the Court of Appeal.

Potential advantages and pitfalls

It is intended that the new Unitary Patent system will sweep away the disadvantages of the present European patent system: a Unitary Patent patentee will only have to pay one renewal fee and translate the text into, at most, one additional language (other than the language of the EPO procedure) for the invention to be granted in the participating Member States. The EPO accepts Google machine translations, as provided by Espacenet, but it is not certain whether this is allowed under the Regulation.

All Unitary Patents will be subject to the exclusive jurisdiction of the UPC and will stand or fall as a whole. In particular:

- an injunction granted by a single court will stop infringements in all participating Member States, granting protection over a consumer base of approximately 400 million;

- a Unitary Patent will remain vulnerable throughout its life to being revoked in an action before a single court – it effectively puts all the patent ‘eggs in one basket’.

Patent litigation: US vs Europe

Historically, the US has been perceived as a highly attractive location for patent litigation for obvious economic and business reasons, given that one patent decision can instantly provide you with access to one of the largest consumer markets in the world.

However, with a new patent system set to cover up to 25 European Member States and a consumer base of over 400 million, the Unitary Patent offers an attractive new alternative for global companies. In addition to covering a larger population base, infringement proceedings will be considerably faster and cheaper than in the US. UPC infringement proceedings are likely to be cheaper than equivalent US proceedings because at the UPC there will be:

1. No or only limited documentary discovery and non-oral discovery
2. No or very limited oral testimony at trial and
3. Shorter hearings. In contrast to the US, there will be no jury trials under the Unitary Patent system (only specialist judges will be responsible for hearing trials at the UPC) and in most cases the losing party will be ordered to pay at least a proportion of the winning party’s legal costs on a scale basis dependant on the value of the case (see above)
4. Full proceedings on the merits in the first instance will be concluded in approximately 1 year.
Summary – what to do now

- **Apply for divisionals**
  - Diversification: ready to grant when the system comes in to operation in 2018

- **File opt-out applications**
  - Be sure you have it right!

- **Portfolio management of patent applications**
  - Monitor progress of participating countries
  - Where will you need national validations?

- **Decide opt-out strategy**
  - Check on true ownership of your patents
  - Get necessary powers of attorney
  - Be ready to file opt-out applications

- **Review agreements**
  - Check on a licensee’s ability to influence decision to opt out/in
  - Check on rights of exclusive licensee to bring proceedings without consent of licensor

- **Be prepared for action**
  - Consider location to file action
  - Claimant: build a file that meets requirements of Rule 13 – 44 – 63
  - Defendant: be ready to file defence in 3 months
  - Prepare evidence; protective letters
  - Have all documents in correct electronic form
  - Document management system ready for upload

- **Proceed to patent grant**
  - Be ready to apply for unitary effect

- **Prepare for first actions at the UPC**
  - Monitor opt out register for opportunities and threats
  - Be ready to file when the system comes in to operation in 2018
Why choose Bird & Bird?

We are deeply involved in all the work around setting up the UPC.

We have taken part in the discussions on drafting the rules, we have contributed to the education of future UPC judges and to national discussions across Europe (from the UK to Slovenia and from Finland to Spain). Therefore not only are we completely familiar with the whole system of rules, but also with the thinking behind it.

We specialise in cross-border work

We have all the experience necessary to set the strategy for a European solution with the addition of the UPC.

We know the judges

It is important to know your tribunal and we will know them as we have litigated patent matters all across Europe, whilst we know how to tailor a strategy to your specific needs based on the options, flexibility and ‘couleur locale’ of the system.
For the past 7 years the IAM Patent 1000 has identified Bird & Bird as the highest ranked firm internationally with more patent experts than any other firm.

**We have vast experience of handling front-loaded cases**
This includes the written advocacy and preparation of the evidence being decisive to the outcome, of running cases with the issues of infringement and nullity in the same procedure and in conducting the oral advocacy at trial.

**As one of the most renowned patent litigation groups in the world...**
...we have strength in depth and can react quickly to all the demands of this new system.

**We are used to working in cross-border teams**
We can mix and match to suit you – in whatever country you find yourself.

**We have the necessary language skills and technical skills**
We have patent attorneys on the team and also patent litigators with technical backgrounds and all with a wide variety of languages at their disposal.
Global reach

With 28 offices globally, we have a presence in all major UPC division jurisdictions and have litigated before many of the UPC’s judges in their national courts. We have one of the largest IP litigation teams in the world, with over 300 multi-lingual IP lawyers and patent attorneys, and we’re trusted counsel to some of the world’s most respected and innovative companies.

We provide bespoke in-depth trainings and workshops on the UP and UPC, not only examining the theoretical aspects, but also and more crucially the practical and commercial steps that businesses should consider taking now in order to enable them to continue to protect their intellectual property in this new environment.

Bird & Bird & our coverage of the UPC divisions

- Participating in the UPC and/or the UP
- Training centre of UPC Judges
- Bird & Bird ▲ UPC Courts
- Likely to be UPC Courts
- ⬤ Court of Appeal

“With the ability to effortlessly cooperate with a cohort of colleagues worldwide, Bird & Bird has the necessary firepower to handle all patent instructions going.”

IAM Patent 1000, 2017
“Market-leading practice with an outstanding litigation arm which takes on many of the leading patent disputes of the day.”

Chambers & Partners, 2018
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“Bird & Bird LLP is ‘the premier patent litigation firm; it has the deepest bench of skilled patent litigators of all the European firms’.”

Legal 500, 2017