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Timings and Procedure in the English Patents Court - a Short Update

Brian Cordery (Bristows) · Monday, August 30th, 2021

As many Kluwer readers will know, the last 18 months have witnessed a changing of the guard within the English Patents Court with long-standing first instance judges Arnold and Birss JJ being promoted to the Court of Appeal and their shoes in the Patents Court being filled by the highly respected patent practitioners, Meade and Mellor JJ.

Almost a year since Meade J was installed as a High Court Judge, this seems as good a time as any to reflect on the way that practices within the English Patents Court have been evolving, particularly with regard to the timetabling and conduct of trials.

Claim Form to Trial - Timing

Back in 2015, Arnold J (as he then was) issued a Practice Statement headlining that the Patents Court would endeavour where possible to bring cases on for trial within 12 months of being issued. This was an ambitious target given that the pleadings phase of a case can take at least three months and bearing in mind that the Court is on vacation for two months over the summer even if the parties and their representatives are not. By and large however, thanks to careful case-management from the Judges, and often extensive co-operation between the parties representatives mindful of the consequences of being unnecessarily obstructive, it has been possible almost to achieve Arnold J's goal. For example, discounting two outliers where the proceedings were stayed for a year, the average time from claim form to trial in the last year was approximately 13 months.

It remains the case that many healthcare companies wishing to sell generic or biosimilar medicines in the UK and the rest of Europe choose to clear the way in the English Patents Court by seeking to revoke or obtain declarations of non-infringement in respect of potentially relevant patents belonging to originators.^[1] There can often be sound strategic reasons for adopting this approach: it may reduce the chances of an interim or preliminary injunction being issued in favour of the patentee in respect of the UK; the challenger may be able to obtain disclosure or undertake litigation experiments to establish part or all of its case and potentially use this evidence elsewhere; and, often most importantly, being among the most respected of European patents courts, a favourable English decision can be influential elsewhere. It is not

uncommon to see English proceedings used as a counter-strike to a favourable EPO opposition division decision and indeed the existence of national proceedings can be used to accelerate and, if necessary, intervene in a TBA Appeal.

Expedition

2021 has witnessed an uptick in the number of applications for expedition of trials made before the English Patents Court. It is not immediately obvious why this has been the case. One possible explanation is that although all English courts managed to keep the disruption caused by coronavirus lockdowns to an absolute minimum, a slight backlog in the trial lists has resulted. It also seems to be the case that the English Patents Court lists remain busy despite the appointment of two new Judges and the existence of a cohort of able Deputy Judges. Overall, the picture emerging is that if a party wishes to have its case brought to trial in under a year, it will need to seek expedition - especially if the trial estimate is greater than 5 days.^[2] However recent experience suggests that if the court lists can accommodate an accelerated trial and if the relevant legal criteria are met, then the Judges are likely to agree to expedition. One example of this is Teva v Novartis (deferasirox) where Teva succeeded in achieving expedition to a trial within approximately 12 months of the issue of the Claim Form. Another example is Teva v Janssen^[3] in which Meade J granted expedition such that the trial would be heard in a similar time frame.^[4]

When addressing whether to accede to an application for expedition, the English Court will apply the guidance given by the Court of Appeal in Geox v Gore^[5] which may be summarised as follows:

1. whether the applicants have shown good reason for expedition;
2. whether expedition would interfere with the good administration of justice;
3. whether expedition would cause prejudice to the party; and
4. whether there are any other special factors.

One potentially special factor which has been considered on several occasions by the English Patents Court is whether it is appropriate to grant expedition to take account of the so-called “injunction gap” in Germany. The injunction gap arises because of the bifurcated system in Germany that results in the infringement and validity of patents being determined separately and because validity proceedings cannot be commenced in Germany until any EPO opposition proceedings have concluded or the window for oppositions has closed without any oppositions having been filed.

On 6 August 2021, Mellor J handed down a decision in the dispute between Abbott and Dexcom^[6] addressing this issue. Both parties had European patents on the devices for monitoring blood sugar levels and Abbott had brought infringement proceedings against Dexcom in Germany. Abbott issued proceedings in the English Patents Court in mid-July 2021 and almost as soon as starting the proceedings, issued an application before the Court seeking a trial in early 2022. One reason for seeking expedition was to attempt to influence a possible injunction gap that could arise in relation to an infringement claim before the German court. The evidence before the Court was that

it was possible that there could be an injunction granted as early as the second half of April 2022. However, as there were oppositions pending at the EPO, no validity challenge could be brought in Germany and any injunction would not be able to be stayed until September 2022 at the absolute earliest (assuming acceleration at the EPO).

After the hearing, Mellor J offered a possible resolution to the issue to the parties whereby both would give an undertaking along the lines that neither would seek or enforce injunctive relief in Germany (or elsewhere in Europe, including the UK) on any EP patent until after validity of that EP (in whatever designation) had been considered and determined by a first instance court. However, this could not be agreed between the parties. Forced therefore to resolve the issue for expedition, the Judge “with some regret” rejected the application for expedition, holding that a desire to schedule a UK action in such a way that the outcome relating to validity is likely to be available and public before the German infringement court decides the matter is a factor to be taken into account but is not a strong factor and cannot justify expedition on its own. As Mellor J put it: *“The UK court is not here to police European patents across Europe which may be perceived to be weak and may ultimately be proved to be invalid.”*

Listing of Trials

Another aspect of Arnold J’s Practice Statement from 2015 is that the parties are expected to start to consider potential trial dates as soon as is reasonably practicable after the service of the proceedings and also to discuss and attempt to agree trial dates with each other when seeking to agree directions for trial. It always struck the author as a bit odd that the parties and their representatives were directed to consider trial dates before the issues in the case were clearly defined and the appropriate trial length could be estimated but in practice, the system appears to have worked well. Applying the Practice Statement, it was common for parties to agree and obtain court approval for the trial listing in the form of a Consent Order well before the first CMC in a case. Doubt was cast upon this practice in early 2021 in a CMC in Sandoz v BMS^[7] and Teva v BMS where Mellor J observed that the practice of listing the trial before the CMC might well be doing things the wrong way round, and lead to parties jumping the queue to get their trial listed whilst others completed their pre-CMC formalities. It also might mean listing a trial before there was a proper appreciation of the scope of the trial. The judge remarked that he had discussed the matter with Meade J and that they were both suspicious of paper applications fixing trial dates that “get slipped through” and that both Judges were inclined to discourage such applications. Following BMS, it was unclear whether the principle of listing trial ahead of the CMC was generally to be discouraged or whether the case was confined to its particular circumstances, which were unusual as it involved two actions being heard together when the originator of the second claim, Teva, had appeared on the scene rather late in the day.

That Mellor J’s observations were not to be taken too generally was confirmed at a listing hearing in Teva v Janssen in August 2021 at which the former sought to list the trial in June 2022, 11 months after the claim form was issued. At the outset of the hearing the Judge stated that his objection in the BMS case was directed to a paper application for the listing of the trial being made when the scope of the trial and in

particular that there was another action to be joined to it, was not fully appreciated. Mellor J confirmed that there was no “blanket ban” on obtaining a trial listing before the CMC and in this case, where the Judge considered that he had sufficient information to assess the likely scope of the trial, acceded to Teva’s request.

Form of Order Hearings - a Reminder

As noted above, the general aim of the English Patents Court is to get cases on for trial within 12 months of the issue of the claim form and that the practice shows that, on average, about 13 months or so is achievable in practice. Following the trial, and unlike the EPO where the decision is rendered on the day or in e.g. the Netherlands when the Court will indicate a date on which the decision will be handed down, in England, following a patent trial, the Judge will invariably reserve his or her decision to be released, initially under strict embargo to the parties and then handed down formally and made public a few days later.^[8] There is no set time for the handing down of judgments in the Patents Court and the Patents Judges usually hand down their decisions within 4-8 weeks. The embargoed judgment arrives as a Word attachment to an email and, in the author’s experience, usually hits his Inbox when he is in a tunnel or (previously) on a plane or in some remote location such as Kent. Following receipt of the judgment there is work to be done both in terms of court procedure and often in off-the-record negotiations between the parties. At a recent hearing in the Alcon v Aspire and Accord^[9] case, Meade J reminded the parties that Paragraph 19.1 of the Patents Court Guide provides that the hearing to determine the Form of Order consequential on judgment should be held within 28 days of the handing down of the judgment. Therefore parties should arrange to list the Form of Order as soon as possible. This not only ensures that the issues including permission to appeal can be determined promptly but is also fair to the Judge whose memory of the trial and the issues will fade as other cases fall for consideration and determination. Parties must also ensure that they obtain an Order effectively stopping the clock on the time limits to apply for permission to appeal.^[10] A draft standard for such a situation is located at Annex F to the Patents Court Guide.

Statements of Agreed Common General Knowledge

As a final point, it perhaps worth mentioning that both new first instance Judges are keen on the parties supplying them with a joint agreed statement of common general knowledge and an agreed list of common general knowledge issues which are in dispute shortly before the trial to help them understand the relevant technical background and to identify issues which are in dispute . It remains to be seen how far this practice will replace the provision of Technical Primers the provision of which had become established practice in the past decade or so but at the present time, the signs are that Technical Primers may no longer be required. Indeed in Sandoz v BMS CMC mentioned above, Mellor J noted: *“Certainly in my experience so far, and the experience of Meade J, is that primers are not entirely optimal, largely because if something is not agreed, it is just left out...What I would like to do is to replace the provisions for a technical primer with a statement of agreed CGK and a list of issues in dispute.”*

Conclusion

Mindful of the competition for global patent litigation which already exists and may perhaps be intensified by the UPC, the judges and practitioners who work within the English Patents Courts continue to strive to make the UK an attractive forum for patent disputes of all kinds. This involves enabling disputes to be determined quickly but not at the expense of fairness or thoroughness. The early signs are that with Meade and Mellor JJ at the helm, the English Patents Court is in good hands and with Arnold and Birss LJ in the Court of Appeal and Lord Kitchin in the Supreme Court, there is considerable strength and experience at all levels.

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