Kluwer Patent Blog

To stay or not to stay – English court of Appeal to review guidelines

Brian Cordery (Bristows) · Tuesday, October 8th, 2013

In 2008, the English Court of Appeal in *Glaxo Group v Genentech* ([2008] EWCA Civ 23) gave general guidance on the Patent's Court discretion to stay legal proceedings on the ground that there are parallel proceedings pending at the European Patent Office concerning the validity of a patent. The "nine step" guidance given by Lord Justice Mummery in that case has been followed in various cases and most recently it was applied by Mr Justice Roth in *IPCom v HTC Europe and others* ([2013] EWHC 2880), the latest battle in protracted litigation concerning a patent used in mobile phones. In applying the Glaxo v Genentech guidance, Mr Justice Roth refused to stay the technical issues of invalidity, essentiality and infringement pending the final outcome of EPO opposition proceedings. Mr Justice Roth announced his decision in June 2013 but his written judgment was not published until 26 September 2013. Interestingly, subsequent to the announcement of his decision regarding a stay of the technical trial and prior to the preparation of his written judgment, the Supreme Court handed down its judgment in *Virgin Atlantic Airways v Zodiac Seats* [2013] UKSC 46 (reported previously on this blog here). In that case, Lord Sumption (with Lords Clarke, Carnwarth and Neuberger and Lady Hale concurring) stated that the Glaxo v Genentech guidelines should be reconsidered. At paragraph 38 Lord Sumption stated:

"*If I had concluded that the defendant was estopped from relying on the revocation or amendment of the patent once the court had adjudged it to be valid, that would have had important implications for the question whether English proceedings should be stayed pending a decision in concurrent opposition proceedings in the EPO. On that footing, it would in my opinion have been essential to stay the English proceedings so that the decision of the EPO would not be rendered nugatory by the operation of the law of res judicata. On that hypothesis, it would have been difficult to defend the guidance given by the Court of Appeal in Glaxo Group Ltd v Genentech Inc [2008] Bus LR 888 to the effect that the English court should normally refuse a stay of its own proceedings if it would be likely to resolve the question of validity significantly earlier. The effect of that guidance is to put more litigants in the impossible situation in which successive decisions of the Court of Appeal placed the parties in this case*".

Lord Sumption continued, "*This is not a suitable occasion, nor is the Supreme Court the appropriate tribunal to review the guidelines, but I think that they should be re-examined by the Patents Court and the Court of Appeal*".

In light of the Supreme Court judgment and given that his decision to refuse a stay was based on the application of the *Glaxo v Genentech* guidelines, Mr Justice Roth granted an application in

writing by HTC for permission to appeal even before handing down of his September judgment, probably to avoid delay with regard to a trial due to commence in early December 2013.

Accordingly, we can expect the result of the Court of Appeal's review of its guidelines very shortly. In the author's view it would be unhelpful for the Court of Appeal to readjust the guidelines too much in favour of staying UK proceedings given the length of time it can take to resolve EPO opposition proceedings. Business needs certainty.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe here.

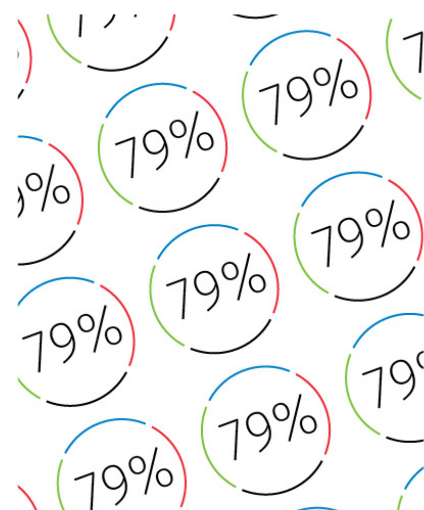
Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.
The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Tuesday, October 8th, 2013 at 2:53 pm and is filed under EPO
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.