Kluwer Patent Blog

Fordham Conference Day 1

Brian Cordery (Bristows) · Friday, April 21st, 2017

The Fordham IP Conference in New York is celebrating its 25th anniversary this year. As the conference heads into its second quarter-century, the programme and faculty are as impressive as ever. It remains a magnet for key opinion leaders from all areas of intellectual property.

Whilst the rain poured down across Manhattan, the conference began with a tribute to the Conference and to its alter ego, Professor Hugh Hansen. Former Dean of Fordham Law School, John Feerick reflected on the genesis of the conference in the early 1990s and the uncertainty of the road that lay ahead. He noted that it was Hugh's personal courage and determination which had led to the success of the Conference.

The first session was a General Counsel Roundtable during which the GCs from Cisco Systems, Viacom, Elsevier and Microsoft outlined the function of the GC and the importance of IP to each of their roles. It was noted that IP is integral to all technology companies and cannot be put into a silo. Moreover if you don't thrive when under pressure, being a GC is not the right role for you. However if you like addressing problems that no-one else has been able to solve for fun, and if you don't mind making left-field suggestions, you may be suited. All the GCs were united in their view that the importance of IP has grown incrementally, the dominance of various rights such as copyright and patents has changed over time and that governments around the world have generally acted with appropriate caution.

When asked about the role of the Courts, it was noted that Judges have always had to react to a changing landscape – particularly in the US but also in Europe. On the whole, they have done well in challenging situations and had to cope with fields of technology which are changing more rapidly than ever before. However, it was noted that the arrival of developments such as railroads, sewerage and electricity in the late 1800s would have changed the lives of ordinary citizens as much or more than modern developments such as the internet. Judges today need to do as they have always done – apply the law to the best of their ability bearing in mind the need to achieve justice and be proportionate.

A final, sobering message was that the relative political stability which has existed for the past 70 years may be under threat and there was a duty on all to be vigilant.

The second session looked at the topic of Brexit and IP. Margot Fröhlinger, the Principal Director of Patent Law and Multilateral Affairs, spoke first. She addressed the state of implementation of the Agreement. 12 have ratified so far but not Germany and the UK. Both however are on track – according to the latest reports. Turning to the impact of Brexit, Margot noted that most

commentators had initially assumed Brexit was the death knell for the UK's participation in the UPC and possibly for the whole project. Over time, these views had softened but it was still a surprise when the UKIPO announced on 28 November 2016 that the UK was going to proceed with ratification. Nevertheless this was seen as very positive news by proponents of the system. Margot considered that the UK's participation could be secured if there was sufficient political will, given the marginal influence of the CJEU in the UPC regime. Moreover in the unlikely event that the UK left the system, arrangements will be put in place to ensure that participants are not prejudiced. Margot felt that the system would be impoverished without the UK judges and practitioners. Panellist Joel Smith thought that there was political will for the UK participation but it was just one of many pieces in a very complicated puzzle. Panellist Trevor Cook wondered if we may end up with the UPC system applying in the UK but not unitary patents. Judge Klaus Grabinski thought that all options remained on the table and Margot Fröhlinger pointed to Denmark's involvement in the Brussels Regulation as a precedent.

The second speaker was Mr Justice Richard Arnold who pointed to the draft "Great Repeal Act" which he noted does almost exactly the opposite of its title – repealing nothing but rather converting EU law into UK law at the moment of departure. The Act will also repeal the European Communities Act and empower government bodies to make necessary adjustments to the law to reflect the discontinuance of the supremacy of EU law. But each of the three main sources of EU law – CJEU case-law, Directives and Regulations would face challenges in conversion. For instance, converting the EU Trade Mark Regulation into UK law is much easier said than done with all sorts of options available. The status of existing CJEU decisions, provisionally to be enshrined as Supreme Court precedents, is clear enough if slightly perplexing but the authority of future decisions is not addressed in the draft Bill. Future CJEU decisions will carry weight in the UK but how much is not clear.

The middle of the day featured sessions on IP in China and on Trade Secrets. For a patent lawyer both were interesting – particularly the notion that trade secrets may have an increasingly important role in many innovators' toolkits.

Later in the afternoon the schedule returned to mainstream patent issues – doctrine of equivalents and file wrapper estoppel. Judge Klaus Grabinski examined the provisions of the EPC 2000 concerning the scope of claims and the German test for determining non-literal infringement. Sir Robin Jacob suggested that the test was far too complicated and needed simplification although Klaus noted that the German test bore strong similarities to the Improver test devised by the English Court. Shimako Kato then mentioned a recent Supreme Court case in Japan involving enantiomers which bore similarities to the pemetrexed case which has been heard by the Supreme Courts in Germany and the UK.

Judge Edgar Brinkman considered the Dutch approach – both literal and non-literal. The Dutch have long adopted file wrapper estoppel even though it is not mentioned in Article 69. They also look at whether the essence of the invention has been taken by the alleged infringer and apply the Function, Way and Result test when considering equivalence. They also adopt the principle that what is disclosed but not claimed is disclaimed. Judge Brinkman finished by posing the question as to how these concepts will be adapted in the UPC. The Q+A considered such matters as disclaimers and numerical ranges.

Heinz Goddard spoke on file wrapper estoppel and felt that the prosecution history did have a role to play. The skilled person at the date of alleged infringement should look at the patent application

as published and compare it to the patent as granted and ask why changes were made. The panel could not quite agree to this proposal but were not against it either.

The final session of the day was on remedies. Mr Justice Colin Birss presented two simple ideas: the legislator makes the law and the judges apply it and second, business needs to plan and therefore certainty is required. But are these assumptions correct? Colin argued that this was not the case – by way of example the approach to the imposition of an injunction when a patent is held valid and infringed differs dramatically between the UK and the US. Further, in situations such as blocking orders and publicity orders, the Judges have had to use their discretion to extend the law to achieve justice. The very complicated issues surrounding FRAND have left a lot for the judges to work out for themselves.

Richard Vary gave a thumb-nail sketch of the small-claims track in the UK IPEC – pointing out the advantages and disadvantages of the current system and some proposals for reform. He believed that the UK rules on generally awarding the successful party its costs should reconsidered. Colin Birss stressed the need for judges to actively case-manage to be proportionate and to help the lawyers manage the expectations of their clients.

Jill Ge spoke on recent positive trends of the Beijing IP Court in awarding damages and costs to successful patentees. In the recent Watch Data case, the Court awarded 49 Million RMB (approximately US$7 Million).

Penny Gilbert closed the day by examining recent developments in Arrow-style declaratory relief – another example of Judge-made law to give parties commercial certainty. Penny sketched out the facts of the FKB v AbbVie litigation in the UK and the finding of Henry Carr J that it was appropriate to grant declarations that a dosage regime for a biosimilar product would have been anticipated or obvious at the priority date of a granted patent in the circumstances. Penny noted that whether declarations will be granted in future cases would depend on the facts and in particular the behaviour of the patentee. It seems that the particular circumstances of the FKB case were influential in the Judge's mind.

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

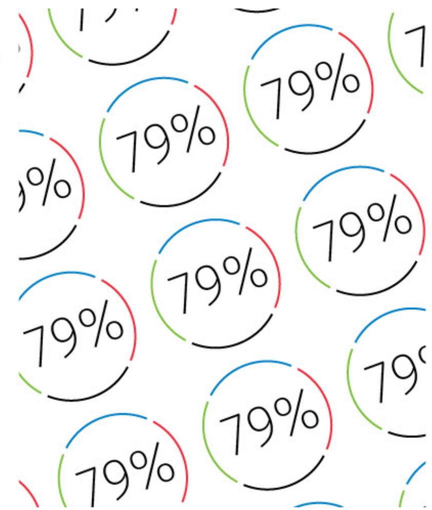
Kluwer IP Law

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 Friday, April 21st, 2017 at 3:59 pm and is filed under Conference, literally fulfil all features of the claim. The purpose of the doctrine is to prevent an infringer from stealing the benefit of an invention by changing minor or insubstantial details while retaining the same functionality. Internationally, the criteria for determining equivalents vary. For example, German courts apply a three-step test known as Schneidmesser's questions. In the UK, the equivalence doctrine was most recently discussed in Eli Lilly v Actavis UK in July 2017. In the US, the function-way-result test is used.">Equivalents, Trade secrets, UPC
You can follow any responses to this entry through the Comments (RSS) feed. Both comments and pings are currently closed.