Year 5, No. 1 - December 2011

# VEREENIGDE NEWS

**International newsletter of VEREENIGDE**

## *Dear Reader,*

*We are living in a world in which economies seem to develop at an increasingly higher pace. When our newletter of December 2009 was issued we were facing the start of a financial crisis. When we issued our subsequent newsletter of June 2010 there were signs that the economy was recovering. Today we are confronted with a debt crisis and we are not sure whether a recession will follow.*

*Despite all these uncertainties, we see that the flow of development and production of new innovative products is vast and steady and in fact proceeds at an ever increasing pace. Indeed, it seems that economic uncertainty has hardly an impact on product innovation on a wider scale. To put it differently, economic setbacks seem to some extent to stimulate product innovation. This in turn provides additional challenges for VEREENIGDE to meet our clients' objectives. We believe that product innovation will continue its growth in the future.*

*In view of this we have decided to open a new office in Leuven, Belgium. By opening up an office in Belgium we will be able to intensify our contacts with existing local clients and also to provide our services to new clients. Moreover, for our clients outside Belgium we can provide direct service at the Patent Office in Belgium. VEREENIGDE's new office in Belgium fits in with our strategy to strengthen our position as a European player in the field of intellectual property.*

*I hope that the topics addressed in this edition of our newsletter will be of interest to you and that they provide you with additional insights into or useful ideas about aspects that, in our perception, have bearing on the present state of IP in the Netherlands and Europe.*

*Last but not least, on behalf of VEREENIGDE, I wish you all a happy New Year!*

*Cees Jansen, Chairman*

*Cees Jansen*

## Contents



Patents • Trademarks • Designs

VEREENIGDE

# Cross-border injunctions in patent proceedings – again?

*by Bart van Wezenbeek*

**Recently, a new chapter was added to the ongoing attempts of the Dutch courts to provide cross-border injunctions in intellectual property cases.**

When a European patent is granted, the patent can be validated in each of the contracting states of the European Patent Convention and then becomes a so-called 'bundle of national patents', providing the same rights as a normal national patent in those countries. With the increase of pan-European patent holders and competitors, it is logical that infringement conflicts often stretch over more than one European country. However, there is no harmonizing system that provides for a single court in which a pan-European injunction can be asked for and issued.

Since the early '90s many discussions have focused on the possibility of a national judge to issue injunctions for infringement in another country, the so-called cross-border injunctions. This practice had originated in the Netherlands and was based on the assumption that according to the Brussels and Lugano Convention - now more or less replaced by Council Regulation EC 44/2001, regulating the jurisdiction and enforcement of judgements in civil matters in Europe -, similar cases may be joined if there is a danger of irreconcilable decisions. However, a drawback here was that the same Council Regulation EC 44/2001 stipulates that questions about the validity of an intellectual property right can only be addressed before the competent national court. This gave rise to many lawsuits on the validity of a patent, so-called torpedos, in countries with a slow judicial system to frustrate a possible infringement suit.

This whole system of cross-border injunctions (and the inherent forum shopping activities) and filing of torpedo lawsuits was effectively halted with the decisions GAT v. LUK (C-4/03) and Primus v. Roche (C-539/03) of the European Court of Justice. However, in cases where validity of the patent is not at issue, the ECJ recognized that cross-border injunctions were still possible (Duijnstee v. Goderbauer (C-288/82)). Further, the Dutch courts have continued to provide cross-border injunctions in preliminary proceedings, stating that the ruling of GAT v. LUK did not apply to those proceedings (e.g. the District Court of The Hague, 21 September 2006; H3 v. Bettacare).

In a recent decision (the District Court of The Hague, 22 December 2010; Solvay v. Honeywell), three separate Honeywell companies from the Netherlands and Belgium were accused of infringing a European patent in several European countries, by trading one and the same product. The court declared that it was competent to decide the matter (also cross-border) for the Dutch Honeywell company on the basis of Art. 2 of the Council Regulation EC 44/2001 *(locus defendi)*. The court also concluded that if the court were not competent in relation to the Belgian Honeywell defendants, the case must be brought before a competent Belgian court, risking a different decision. It was the question if such a situation could lead to irreconcilable decisions as defined in the Council Regulation (e.g. Art. 27(3)).

In order to solve this question, the Dutch court has now asked the European Court of Justice for further explanation by referring the following question:
1) In a situation like the present, where two or more defendants from different states are accused of infringing *the same* national part of a European patent as in force in yet another member state with respect to *the same* product, is there a danger of irreconcilable decisions as meant in Art. 6(1) of the Council Regulation?

Further, the court addressed the problems of cross-border injunctions in preliminary proceedings by referring a second question:
2) Does Art. 22(4) Council Regulation – which states that in cases of validity of IP rights only the national judge is competent - apply in preliminary infringement proceedings if the defendant questions the validity of the patent, considering that in preliminary proceedings no definitive decision on validity is taken?

It seems that the chapter on cross-border injunctions is not yet closed. In the mean time, without further awaiting the decision of the ECJ in the above-mentioned case, and following the Appeal Court in The Hague (15 July 2011, Yellow Pages v Yell), the Dutch court also issued a cross-border injunction on the basis of Samsung's infringement of Apple's European patent (District Court of The Hague, 24 August 2011, Apple v Samsung).

# Vereenigde's seminar in Munich

*by Bettina Hermann and Jennifer Ebner von Eschenbach*

**Vereenigde held a seminar in Munich from 18 to 20 September 2011 focusing on European Patent strategies. The event was hosted by Vereenigde's Munich office in cooperation with Vereenigde's headquarters in The Hague.**

The intention of the seminar was to inform patent practitioners from private practice, universities and industry throughout the world, about the following topics: recent developments before the European Patent Office (EPO); national routes before national patent offices such as the German Patent and Trademark Office (GPTO) as alternatives to the EPO; and the potential future Community Patent. Representing firms from Australia, Canada, China, Germany, Japan, The Netherlands, South-Africa, South-Korea and the USA, the participants formed an international group of high-profile IP professionals. The seminar provided an interesting mixture of presentations from Vereenigde's patent attorneys, Patent Examiners of the EPO and GPTO, an attorney-at-law from the EPO, and representatives from the Business Development and IP departments of food and pharmaceutical industries, respectively.

On the first day of the seminar, Dr. Otto Oudshoorn of Vereenigde provided an overview of the recent changes in the EPC which came into force in April 2010 and, in particular, the time limitations for filing divisional applications, the obligatory response to the search opinion, and various experiences with *'raising the bar'* in relation to inventive step.

Dr. Martin Uhl, a highly experienced Examiner of the EPO, informed the audience about the EPO's perspective on these new regulations. The EPO's intention was to increase the quality of European patents, to accelerate the proceedings and to reduce 'needless' workload in the examination proceedings. Dr. Uhl emphasized that the hurdle for the assessment of inventive step was not greater but that the longstanding regulations for the evaluation of inventive step are now applied more strictly. He indicated that one of the biggest problems regarding inventive step are missing data and stepwise disclosure of the invention. Quite often European patent applications, in particular those based on a U.S. patent application, provide a very general disclosure in the description, which may lack inventive step in view of prior art, and a very detailed disclosure in the examples, which provides for a very limited scope of protection. Therefore, Dr. Uhl recommended a more intensive cooperation of European patent attorneys and foreign associates at an early stage of the proceedings, i.e., when drafting the patent application.
According to Dr. Uhl, the EPO is content with the experiences made with the new regulations of 2010, which indeed accelerated the proceedings and increased the efficiency in examination proceedings.

Dr. Henk van Doren, Manager Corporate IP Department of Royal Friesland Campina N.V., provided an interesting presentation about the company's patent strategy and experiences with the EPO in examination, opposition, and appeal proceedings. Dr. van Doren indicated that the company is very content with the quality of the examination proceedings, as well as that of the post-grant proceedings.

Afterwards, in a roundtable discussion, Dr. Uhl, Dr. van Doren and patent attorneys of Vereenigde, discussed their experiences in proceedings before the EPO with the audience. In general, the EPO's 'clients' were satisfied with the EPO, but they criticized the new regulations, in particular the two year limitation for the filing of divisional applications, and the assessment of inventive step under the EPO slogan *'raising the bar'*.

In the afternoon of the first day, Dr. Stefan Luginbuehl, a lawyer from International Legal Affairs at the EPO, presented the recent news regarding a European Community Patent. Recently, 25 member states of the European Patent Convention (EPC) agreed on a common patent, which would be examined and granted by the EPO, and where post-grant proceedings would also take place before the EPO having immediate effect in all 25 member states. Official languages of the proceedings would be English, French and German in accordance with the EPC. However, it still seems a long way to go until such a first Community patent might be examined.

The first day of the seminar ended with a visit to the EPO, where Ms. Christine Short, Head of Communication of the EPO, provided an interesting insight into the organization and work of the EPO. Finally, Ms. Short led the participants to the EPO's 'Sky Bar', from where they had a great view of Munich's skyline and the Oktoberfest.

The second day of the seminar started with a presentation by Dr. Bettina Hermann and Lutz Keydel of Vereenigde's Munich office regarding national patent systems as an alternative to the EPO, the emphasis being on German proceedings. A summary of this presentation is provided in this newsletter. Dr. Roman Maksymiw, Director of an Examining Division at the GPTO, provided a detailed insight into the organization of the GPTO and the importance of this patent office in Europe. The GPTO, like the EPO, notes increasing patent application figures, in particular in the technical field, e.g., from Siemens, Bosch and other large companies. The examination and grant proceedings before the GPTO and the EPO are similar, and the German patent examiners are highly qualified. In contrast to the EPO, the GPTO also registers trademarks, design models and utility models. These can be interesting IP rights and are further explained in the article by Mr. Keydel and Dr. Hermann in this newsletter.

The official part of the seminar ended with a presentation by Dr. Nadine Kolonko of Sandoz International GmbH, who reported on her experiences in European litigation, which is characterized by differing costs, variances in the experience of courts and thus, differing decisions in patent litigation proceedings in the respective European countries. The seminar offered a good platform to meet colleagues from the IP field, to exchange experiences in the different IP systems, and to increase and improve the international IP network. In addition to the hard work during the hours of the seminar, the group relaxed on an outing to Neuschwanstein, where the famous Bavarian castle of King Ludwig II was visited. Further, the participants enjoyed dinners in typical Bavarian restaurants and, on the last evening of the seminar, attended the well-known Munich Oktoberfest!

The participants enjoyed their stay in Munich and all agreed that a 'Munich seminar' should be offered again in the future.

# Double Dutch: Breeder's exemption in patent law

*by Frits Schut*

**The Dutch government has committed itself to including a breeder's exemption in the Dutch patent law. Political opposition and lobby groups are advocating for a full (UPOV 1978-style) breeder's exemption. At present, the Dutch government is investigating the legitimacy of a limited breeder's exemption (free development but no commercialization) in the light of TRIPs, the EPC, and the EU Biotech Directive.**

## WTO requirement

Innovative plant breeding is thought to be essential in feeding an expanding global population in the face of a drop in available agricultural land and seasonal drought in the years to come. The development of better yielding plant varieties can take a decade and millions of Euros. Plant breeders therefore seek to protect their intellectual property in order to recover the costs of R&D. Members of the WTO must, as a result of the TRIPs agreement, provide for the protection of plant varieties by patents or by an 'effective *sui generis* system' or both. In the United States, Australia and in European countries such as the Netherlands, plants can simultaneously be protected by patent rights and plant variety rights (PVRs). In China, Brazil, and India, plants can only be protected by a PVR.

## Options under UPOV

A total of 70 countries have adopted the PVR system of the International Union for the Protections of New Varieties of Plants (UPOV). Most countries, including the Netherlands, adhere to the Convention's most recent (1991) version, whereas a minority keep adherence to the 1978 Convention. Both versions of the UPOV convention provide for a so-called breeder's exemption, which is mandatory under the 1978 Convention, and optional under the 1991 Convention. The 1991 Convention allows members to ban commercial activities with new varieties developed under the breeder's exemption. This optional narrowing of the exemption was not implemented in the Netherlands' Seeds and Planting Materials Act 2005, and neither is it part of the EU Community Plant Variety Rights (CPVR) regime under Regulation 2100/94/EC, which is effective in the Netherlands.

## 'Leaky' protection

The Dutch 'breeder's exemption' thus stipulates that everyone can freely use protected varieties to develop new varieties, which, in addition to that, can also be freely marketed. It is common practice that breeders use their competitors' varieties to introduce its beneficial traits into their own breeding lines. Under a PVR, it is not the genes and individual phenotypic traits of a plant that are protected, but rather the unique combination of genes expressed as a distinct, uniform, and stable phenotype. It is not the purpose of a PVR to prohibit the recombination of the genetic building blocks present in a protected variety, but to encourage the gene assembling skills of the breeder. This 'leaky' type of protection ensures free access to genetic material, including material which is PVR protected, to the benefit of the plant breeder and the plant breeding process.

## Patents for technology

Although patent law of many jurisdictions has an experimental use exemption (research exemption), patent law does not have a breeder's exception and thus provides improved protection over PVRs. Also, the patent claim may cover all varieties having the novel and inventive feature. With the extension of patent protection to recombinant DNA methods for producing transgenic plants and their resulting products, patents have assumed increased significance. The broader ambit of patent rights is one particular advantage of this form of IP protection, covering, as it does, plants, seeds, and enabling technologies. The patent system is aimed to stimulate technological progress by providing temporary monopolies in specific fields of technology, including plant breeding. TRIPs requires that patent rights issued for a production process, extend to the product directly obtained by that process. Hence, novel and inventive processes in plant breeding confer protection to plants obtained by the method. In addition, plants themselves can be covered by patent claims. The conditions of novelty and inventive step should provide an effective safeguard against mere juxtapositions of plant features available in the public domain.

## German and French breeders

The advent of patents in plant breeding has triggered a public interest for a breeder's exemption in patent law. The patent acts of Germany, France and Switzerland have a limited breeder's exemption in that they allow patented biological material to be used at least for breeding purpose. Hence, German, French and Swiss breeders can continue their work, but they require the patent holder's permission to market new varieties with the patented aspect. This is equivalent to a permissive breeder's exemption allowed under the 1991 UPOV Convention. If the resulting variety does not contain the patented trait, it can be commercialized without the consent of the patent holder. This approach maintains the genetic background in the public domain while observing at least some of the legitimate rights of the patent holder.

## Too easily granted

Certain groups such as the Dutch plant breeders association Plantum-NL and the Dutch public organization Centre for Genetic Resources, the Netherlands (CGN) are critical about the benefit of the patent system in plant breeding. They argue that patents have undesirable effects by allowing for strategic use and monopolistic behavior, that they are associated with high costs of legal assistance, that they create large inequality between parties with different legal capacities, and that they are too easily granted through careless application of the patentability criteria. In general, it is their opinion that patents hinder breeding activities, have a negative impact on innovation, and result in an unwanted concentration of power in the agricultural sector. Hence, they propose to amend patent law and implement an extensive breeder's exemption.

## Food security

Several Dutch political parties have picked up this call for such an extensive breeder's exemption in patent law. Essentially, the argument is that innovation in plant breeding, such as the development of multi-resistance in plants, is cumulative and results from a joint effort of the breeding industry. Apart from the notion that the process would depend on the availability of the widest possible stock of material and 'locking up' genetic resources with patents is a bad thing, it would also be undesirable to grant one party the monopoly rights for all varieties that harbor a certain trait. In particular if such a variety contains traits incorporated by other breeders under breeder's rights. Plant patents would also be in conflict with the fact that plant varieties are unpatentable under European patent law. Lastly, monopolization should be prevented from the perspective of food security, and an extensive breeder's exemption is therefore warranted.

It must be noted, however, that access to breeding material is also restricted by other means than IP protection. For instance, some countries have chosen to exclude certain categories of plant genetic resources from the Multilateral System to be set up under the International Treaty on Plant Genetic Resources for Food and Agriculture (ITPGRFA) which regulates the exchange of germplasm of major crop varieties between member states and the sharing of benefits emanating therefrom. Also, some developing countries have been exercising their rights under the Convention on Biological Diversity (CBD), to regulate access to their genetic resources, and in doing so have restricted the free flow of those resources.

## Devastating consequences

There are a large number of stakeholders with contrasting views on the subject. The plant science industry federation CropLife International, for instance, holds that there is no evidence that patent protection has a negative effect on the development of new and improved germplasm. Breeders in nations without a breeder's exemption in their patent laws, such as the United States, are among the most successful in the world.

CropLife believes that Plantum's view ignores the advancement of plant science and the increasing importance of trait research and is in conflict with TRIPs as it erodes the patent system. Also, it argues that an extensive breeder's exemption would render any patent granted on plants unenforceable and thus useless against competition, and would consequently have a severe chilling effect on innovation. In the face of the current global economic downturn, investment in innovation is already threatened and a further reduction in plant science innovation could have devastating consequences.

### Erosion of the patent system

The Dutch Biotechnology Association NIABA, although in favor of a limited breeder's exemption in patent law, strongly opposes a full breeder's exemption, arguing that this would erode the patent system for reason that biological material would be outlawed. If patented biological material can be used without compensating the inventor who has invested heavily to make his invention, this would create an unjust situation that seriously affects thousands of very innovative small and large biotechnology companies in Europe.

### Equal protection

Pioneer Hybrid, a U.S.-based producer of hybrid seeds for agriculture, asserts that developing new varieties and improving agricultural productivity require that business opportunities outweigh research risks. Without effective IP protection, technology and breeding practices will tend to follow the path of least resistance in respect of the risks and resources employed. After all, breeders must invest in order to incorporate unadapted and exotic germplasm into their breeding programs. Insufficient return on investment will force breeders to use the well-characterized and well-adapted varieties that are already widely used on farms. This reduces the genetic base and narrows diversity in breeding populations and actually puts food and feed security at risk. New genetic technologies and breeding approaches facilitate the use of genetic resources that would otherwise not be used in breeding, or that were hitherto practically unavailable due to their presence in wild species or in exotic or unadapted varieties. This contributes to the use of a broader genetic base in agriculture. An IP environment that effectively promotes the use of well-adapted varieties, and that discourages the use of more exotic germplasm, tends to stimulate the use of an increasingly smaller cadre of existing, well-adapted varieties. Inventors in the area of plant breeding should not be deterred from taking risks, but should be encouraged to take risks and invest resources, and be rewarded with IP protection that is equal to that available to inventors in other fields of endeavor. While proposing to widen the access and benefit sharing provisions under ITPGRFA, Pioneer Hybrid opts for a new provision in the UPOV Convention that renders the breeder's exemption for UPOV-protected material inoperative during an initial period.

### Legal assessment

In September 2011, the Dutch government expressed the ambition to introduce a limited breeder's exemption in the Patent Act. This limited exemption would allow the use of the patented material for breeding purpose, but not the commercialization of the new varieties. This exemption adds to the existing research exemption, which would not permit the development of a novel plant variety. A legal assessment of the possibilities for a limited and for an extensive breeder's exemption in the light of the Biotech Directive, the European Patent Convention, and the TRIPs agreement is now being performed by the government. The results should be available soon. The report of an independent chairman on a public debate about the desirability of the breeder's exemption is expected to be published in the course of 2012. The government is likely to await the view of the European Food Safety Authority (EFSA) with respect to food security, and appears to prefer an internationally supported initiative in compliance with TRIPs, the EPC and the EU Biotech Directive.

# IP protection via national routes – Germany as an example

*by Lutz Keydel and Bettina Hermann*

**The proper IP strategy for a company can differ depending on several company-specific factors, such as the business field of the company, its market performance, competitive position, and - of course - the budget available. Strategies may range from active patent protection, with seeking protection for every single invention, to more passive strategies where only highly relevant developments are protected and others are freely published to establish prior art for competitors. Other strategies include those that are designed to keep most of the company's inventions secret which can be useful with highly developed inventions that are difficult to identify or reverse engineer.**

Within the system of IP protection, inventors have several different options with which to pursue patent protection, for example filing an international application (PCT) or a European application. However, pursuing the national routes in individual European countries is sometimes quite advisable, particularly since several countries provide for the possibility to file utility model applications as an alternative to or in combination with regular patent applications, which utility model applications are examined under different novelty and obviousness standards.

The following provides a short overview of the national protection rights available in several European countries, with a focus on German regulations and requirements. Further, the possibilities for enforcing these rights before national Courts are briefly discussed, again with emphasis on German proceedings.

## National patents in Europe

The national patents available in most European countries comply with the Paris Convention for the Protection of Intellectual Property, which means that many features of the examination proceedings are similar to each other and to the European patent system.

National patents are usually examined protection rights with a 20 year term. Priority can be claimed within 12 months from the first filing, and applications are published after 18 months from the first filing. After the decision to grant a patent, an opposition period follows , e.g., three months in Germany. During that

period, any third party can file an opposition against the patent before the German Patent and Trademark Office (GPTO). After this opposition period, or after an opposition proceeding is settled, nullity actions can be filed with the German Federal Patent Court (GFPC; "Bundespatentgericht").

National German patent examination proceedings have a number of useful features. When a patent application is filed, examination has to be requested. Under German regulations, this request can be postponed up to 7 years from the filing date, giving the applicant time to wait, for instance, for the outcome in proceedings of counterpart applications. In addition, during the substantive examination, the term for filing responses to Office Actions of the GPTO can be extended almost arbitrarily and at no charge. Accordingly, a German patent application can be easily kept 'on hold' with the possibility of 'resurrection' at any time.

In addition, utility models (see below) can be branched off from a pending German patent application, which can coexist, even with an identical scope of protection. In cases where swift action against a possible infringer is desired, branching off utility models provides the applicant with a serious enforcible IP right within a short time that can serve as basis for an infringement action.

Since the examination proceedings before the European Patent Office (EPO) and the GPTO are very similar, and the technical qualification and examination experience of the examiners is of a high standard, the German national route is very attractive to applicants.

The examiners of the GPTO have to complete a 3 year highly sophisticated training program, including legal studies and computer skills. All examiners have an academic degree in natural sciences and at least 5 years of experience working in the relevant industry as basic qualifications. Moreover, many of the examiners have years of experience, which provides for a professional and predictable examination.

Examination procedures before the GPTO are also quite fast. Generally, applicants receive the first office action within 6 - 8 months after filing a request for examination. As a statistical average, 45% of the applications will be granted within 24 - 30 months. Oral communication with the Examiner, in the form of informal interviews or oral proceedings, is encouraged and very often assists in accelerating the proceedings.

## Utility model

In many European countries a utility model can be filed as an alternative or in addition to a regular patent application. This is an unexamined registered protection right, having a protection period of 6 to 10 years, depending on the respective national regulations. Also, depending on the country in question, a patent and utility model can either coexist or the applicant has to choose to pursue one or the other of these IP rights. In Germany, the utility model offers 10 years of protection and is generally registered within 6 to 10 weeks after filing. The priority of a patent or utility model can be claimed. A prior art search can optionally be requested, but is not mandatory, and the results are not taken into account for the registration of the utility model.

In certain countries, utility model regulations provide for a grace period, which means that written or oral disclosures or a prior public use by the applicant or their predecessor in title before the priority or filing date are not taken into account for the assessment of novelty or inventive step (in potential cancellation proceedings, for example). In Germany this grace period is six months, as it is in most other European countries. Thus, branching off a utility model from a patent application (i.e., a national, or EP/PCT application designating Germany) may result in the protection of an invention even if a disclosure of the invention has been made prior to filing.

In addition, prior use and oral disclosure are only relevant prior art under German utility model regulations if they have taken place in Germany.

In some countries, the subject matter of a utility model is limited. In Germany, for instance, methods are excluded from utility model protection.

In view of the foregoing, the utility model is an interesting IP right and can offer an effective fall-back position, e.g., where absolute novelty cannot be met.

## Litigation in European countries

"A patent is fundamentally a right of prohibition. Thus its value must necessarily depend on the degree to which that prohibition is enforceable" (Richard Spenser).

Many European jurisdictions truly follow this statement. Although litigation is possible in all European countries, the level of experience of the courts, proceedings and costs vary. Highly experienced and, therefore, frequently appealed courts are located in the United Kingdom, the Netherlands and Germany.

In general, decisions on infringement and validity are taken by the same court. However, in this respect, Germany's principle of separation forms an often disputed but often quite successful exception. In Germany, the District Court decides on infringement and the GFPC decides on validity of a patent. A further characteristic of the German system is that the GFPC not only has legally trained judges, but also technically trained judges who are are highly experienced former patent examiners. Two thirds of all European cases are litigated before German courts, where 60% of the plaintiffs are foreigners. In 2009, the German courts handled 1,200 infringement cases (NL 50, UK 50, other European countries <10).

The following timeline serves to briefly illustrate the infringement proceedings before the District Courts (typically in Munich or Düsseldorf): The plaintiff has to submit the infringement complaint ('Klageschrift') comprising a complete presentation of the case, which is then served to the defendant. The defendant replies in a statement of defence of non-infringement ('Klageerwiderung') within 2 to 3 months and, after 4 to 8 weeks, an early hearing ('Früher erster Termin') is held before the court. Subsequently, plaintiff and defendant can submit their reply

*"Although litigation is possible in all European countries, the level of experience of the courts, proceedings and costs vary"*

and rejoinder, respectively, within similar time periods. A subsequent oral hearing ('Haupttermin') is held, after which the court informs the parties of its decision in about 2 months. Infringement actions before German infringement courts take, on average, about 9 to 14 months.

As in many other countries, interim relief is granted by German District Courts. A preliminary injunction ('Einstweilige Verfügung') can be obtained against a potential infringer as an ex parte injunction, if the validity of the patent in suit is not in question, and if a clear-cut infringement can be shown. A protection brief ('Schutzschrift') can be filed with the District Courts by the potential infringer in advance, if a preliminary injunction is expected explaining that there is no infringement in fact. However, the protection brief is not necessarily taken into account by the Court and does not necessarily result in oral proceedings prior to the Court taking a decision on the preliminary injunction. Although an appeal can be filed against the preliminary injunction, it does not suspend its enforceability.

The types of remedies in Germany are the same as in other jurisdictions, namely an accounting of infringing activities, as well as recovery of damages based on lost profit, reasonable royalty (license analogy method) or surrender of the profit generated by the infringer. Furthermore, the plaintiff can request that the infringing products be destroyed, recalled or removed from the market.

The cost risk of German infringement and nullity proceedings is based on the principle 'the winner takes it all', wherein the losing party has to refund all costs incurred by the prevailing party. Since the Court fees, attorneys' and patent attorneys' fees are predetermined by statutory provisions and calculated based on the amount in dispute ('Streitwert'), the cost risk is quite predictable. Based on an amount in dispute of € 500,000 to € 5,000,000, the cost risk ranges from about € 75,000 to € 250,000.

# VEREENIGDE welcomes new partners

**As from 1 January 2012, Michiel van Rooij and Marco Molling, practising from respectively the Arnhem and The Hague offices, will have joined the partnership of VEREENIGDE.**

Michiel van Rooij has worked for VEREENIGDE since September 1999, since January 2007 as Senior Associate. He studied semiconductor nanotechnology (1999) at the department of Applied Physics at Delft University of Technology. Michiel has wide experience in drafting and defending patent applications in fields ranging from applied physics and mechanical engineering to information technology.

Marco Molling has worked for VEREENIGDE since July 2000, since January 2008 as Senior Associate. He studied chemical technology (1994) at Eindhoven University of Technology. Marco's expertise lies in the general field of chemical patents, with an emphasis on food technology and process technology. Further, he is particularly interested in the fields where chemistry and other disciplines meet, such as industrial biotechnology and laboratory technology. As a tutor, Marco also assists trainee patent attorneys in their preparation for the Dutch and European qualification examinations.

The partnership wishes its new partners a successful continuation of their careers.

# Again high PCT score for VEREENIGDE

Each year, the British magazine *Managing Intellectual Property* (MIP) conducts a survey of PCT filing firms. The survey results are published in the October edition of MIP. We are proud to announce that with as many as 379 filings, VEREENIGDE is presently in nineteenth position worldwide. This makes our office the third largest PCT filing firm in Europe. For the Netherlands, VEREENIGDE has maintained its number one position.

# *Happy New Year!*



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