

Opposition/Intervention & Litigation: Parallel proceedings at the UK court and the EPO

1. Introduction

1.1 One strategy for a party which anticipates being sued for infringement of a European patent is to launch opposition proceedings at the European Patent Office (within 9 months of grant). Any subsequent attempt by the patent proprietor to litigate under the patent can be met with a request for the court to stay proceedings until the European Patent Office has ruled on the opposition.

1.2 Opposition before the EPO typically takes several years and the unsuccessful party may appeal, which will usually take several more years.

1.3 Hence the strategy outlined above could delay infringement proceedings for some time, as well as preventing other remedies such as grant of an interim injunction.

1.4 The UK court, when faced with a request for a stay, must therefore make a judgement based on a number of factors.

2. Factors affecting the court's decision

2.1 In considering whether to stay the proceedings, the court must balance the inconvenience and expense involved in duplication of proceedings against the inconvenience and expense involved in delaying the proceedings.

2.2 Recent cases¹ have tended to focus on the need for commercial certainty, in particular focussing on the consequences of a lengthy stay and whether this will be detrimental. Hence the context of the request for a stay is a vital consideration in reaching a decision².

¹ See e.g. [Glaxo Group Ltd v Genentech Inc & Anor.](#) [2008] EWCA Civ 23, or [GSK v Sanofi Pasteur](#) [2006] EWHC 2333

² [Glaxo Group Ltd v Genentech Inc & Anor.](#) at paragraph 63

2.3 It is therefore difficult to draw general conclusions from a specific case. Nevertheless, it is becoming clear that the focus is on reaching certainty as quickly as possible, since "business needs to know where it stands"³.

2.4 Hence the primary consideration in staying proceedings seems to be the length of time the respective fora will take to reach a decision:

"If the likelihood is that proceedings in the Patents Court would achieve resolution sooner than the proceedings at the EPO, it would normally be a proper exercise to decline to stay the Patents Court proceedings"⁴.

2.5 Moreover, an assertion by a party that it has good reason for resisting a stay will likely be taken more seriously than an assertion that there is no commercial need for early resolution⁵.

3. Summary

3.1 The UK Court considers that it can reach a decision on validity with greater speed than the EPO and as such is unlikely to grant a stay of proceedings as long as speed is the primary weighting factor in the decision.

3.2 This is so even where the only issue in both sets of proceedings is the validity of the patent; where the UK proceedings additionally involve consideration of infringement (a matter which cannot be decided by the EPO) it would seem even more unlikely that a stay will be granted.

3.3 Given additionally that the UK court has powers not available to the EPO in reaching a decision, such as the ability to cross-examine witnesses, any party opposing a European patent is becoming less likely to be able to defer matters at the UK court until the opposition/appeal has been resolved. Hence, within the UK at least, the prevailing attitude

³ *Ibid*, at paragraph 77

⁴ *Ibid*, at paragraph 84

⁵ *Ibid*, at paragraph 87

of the court is such that the use of oppositions as a tactic to delay national proceedings is not likely to produce the required delay.

3.4 Conversely, a patentee defending an opposition at the EPO may consider instituting infringement proceedings at the UK court in the knowledge that proceedings will likely not be stayed pending the EPO's decision.

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