

Jon Lang Mediation

Patents, including FRAND - mediation examples

a patent entitlement case (section 37 Patents Act) originally before the Comptroller and then transferred, in respect of a product used in the construction industry with one party alleging that it designed the invention embodied in the patent granted to the other party (or in the alternative that it was a co-owner), with the registered proprietor arguing that the party claiming entitlement had not made any inventive contribution;

a claim for compensation under Section 40 Patents Act by a former employee inventor, the benefit of the patent to the proprietor and its value (to the proprietor) being issues in the mediation as was the claimant's contribution to the invention in the context of consideration of the 'fair share';

a dispute concerning a well-known medical product arising out of a deed of assignment of patents and an associated commercialisation agreement, a subsequent broader assignment of associated IP and the impact of expiry of patents on certain revenue sharing arrangements;

a patent dispute involving claims of infringement of a UK and US patent with proceedings in both jurisdictions;

a dispute between two medical technology companies concerning development of, and patent applications in relation to, various diagnostic devices, the dispute concerning ownership of various granted patents, future patents and alleged breaches of various collaboration and development agreements;

a claim seeking a Declaration of non-infringement under Section 71(1) of the Patents Act and also a Declaration pursuant to Section 64 (continuation of use);

a patent infringement action in the medical devices field against numerous defendants, the claim being met with a defence of non-infringement (involving arguments on construction) and a counterclaim for invalidity based on lack of novelty (elements in the inventive concept contained in an earlier patent) and also lack of an inventive step (prior art at the time of filing combined with common knowledge suggesting obviousness), the dispute also involving arguments over commercial success and long felt want as secondary evidence of inventiveness;

a groundless threats action;

a patent infringement claim in relation to an article used in the FMCG sector culminating in extensive contractual undertakings being given in return for an agreement not to assert the patent for a specified period of time to enable a sell through period;

a claim in the financial services sector involving an analysis of prior art relevant to each function and concept claimed in the patent said to be infringed;

a dispute between an academic institution and a pharmaceutical company over a patent licencing agreement and the scope of revenue to be included in the calculation of milestone payments due under the licence agreement at various stages of development of a novel pharmaceutical product e.g. FDA/European Commission approvals for particular indications, level of sales etc;

several patent licensing disputes e.g. breach of minimum royalty provisions, breach of confidentiality restrictions, exploitation by licensee of 'improvements' to patented articles etc;

a joint venture dispute concerning an assignment of a portfolio of patents, with argument focusing on whether patents omitted from the assignment were relevant to a particular area of technology;

a claim arising out of EPO Appeal proceedings, (the alleged infringing party attempting to narrow or revoke in its entirety a patent on grounds of lack of novelty and obviousness), infringement proceedings, including a claim for a declaration of non-infringement;

a patent dispute between 'household name' competitors in the luxury products market;

a patent infringement/invalidity dispute in the manufacturing sector;

a patent infringement action in the on-line payments sector;

a patent entitlement action transferred from the UKIPO to the High Court arising out of a research contract in the avionics sector between an academic institution and a commercial entity, the core issue being whether a particular technology was developed under the research contract, or whether the inventive concept the subject of that technology was based on pre-existing rights of one party (i.e. background IP and therefore excluded from the ownership regime established by the research contract) or was developed alongside, but out-with, the research contract (and therefore also excluded);

FRAND

mediation of a dispute concerning the licencing of a technology standard, claims for liquidated damages met by a FRAND (fair, reasonable and non-discriminatory) defence and an alleged breach of Article 102 (TFEU).

mediation of a FRAND (fair, reasonable and non-discriminatory) licensing dispute between the proprietor of a SEP (Standard Essential Patent) for a technical standard in the electronics field and a manufacturer (implementer of the standard) against the backdrop of litigation in various courts and appellate levels, the core of the dispute being the factors to be taken into account in arriving at a FRAND licence rate and the various approaches to be taken e.g. 'top-down', comparable licences etc;

mediation of a FRAND dispute with discussion focusing on relevance of comparable licences and the methodology for the unpacking of those licences including the removal of particular features peculiar to them to arrive at a unit rate, the discussion also focusing on various factors such as market and market share of the proposed licensee, territory to be covered by the FRAND licence, the application of limitation periods, term, start date etc;

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