The Sedona Conference on Global Aspects of Patent Litigation
The Carton House
County Kildare, Ireland
November 19-20, 2019
AGENDA

Monday, November 18, 2019

6:00 — 8:00 Welcome Reception

Tuesday, November 19, 2019

7:30 — 8:30 Breakfast & Registration

8:30 — 8:45 Welcome and Introductions

(*Goddar, Grzimek, Powers, Rea, Trenton, Waterland, Weinlein*)

8:45 — 10:00 [Panel 1] Patent Infringement Analyses Across Different Jurisdictions

(Appelt, Bencivengo (J), Clark, Earle, Finocchio, Powers)*

This panel will explore the legal frameworks for analyzing patent infringement in the major jurisdictions around the world, which informs strategic and tactical decisions about patent enforcement and defense in multi-jurisdictional disputes.

10:00 — 10:15 Morning Break

10:15 — 11:30 [Panel 2] Cross-Border Discovery Issues for Patent Litigation and Trade Secrets Litigation

(Busey, Cooper, Illston (J), Licks, Mutimear, Rüberg)*

Increasingly, the globalization of technology markets has complicated how businesses and individuals protect and enforce their intellectual property rights. While international laws generally protect rights in patents, copyrights, trade secrets, and trademarks, the enforcement of such rights is complicated by unique requirements of how discovery functions within individual nations. For instance, transnational patent and trade secret litigation in one country often involves parties who require evidence that is within the custody and control of both parties and non-parties located in any number of other countries' jurisdictions. Yet such other states often employ significantly different discovery practices than what may be permitted in the country were litigation is filed and may not allow the parties to, e.g., take depositions or demand specific forms of documentation. These differences are further complicated by the fact that how patents and trade secrets are enforced internationally requires an evaluation of the legal protections afforded such rights on a country-by-country basis. As patent and trade secret enforcement disputes themselves become increasingly international, such that it is no longer uncommon for parties to file multiple actions involving the same underlying intellectual property in myriad jurisdictions across the globe, the complexities of coordinated

cross-border discovery and the implications of how to address related concerns such as protective orders, privacy requirements, and equitable relief may seem overwhelming to many practitioners.

This panel will follow the work of the Sedona Conference's drafting team on this topic, combining the collected wisdom of the Sedona Conference's Working Groups 9, 10 and 12 (addressing best practices in both patent and trade secret litigation), will examine issues arising from this new reality, focusing its guidance on what are the best practices to ensure that the parties to international patent and trade secret litigation can ensure that they receive available discovery from all sources so as to ensure that their claims and defenses are adequately presented to the courts addressing such disputes.

11:30 — 12:45 [Panel 3] Patent Invalidity Court Proceedings in Litigation Across Different Jurisdictions

(Bacher (J), Goddar, Ordo, Park, Watts, Yao)*

The international landscape concerning ways in which defenses in patent litigation can be based on invalidity arguments has become ever more complicated in recent years. There are some countries in which patent validity must be argued in patent litigation procedures in the same case as the infringement action at ordinary civil courts. In other countries, validity must be made the subject of a separate procedure in the civil courts, i.e., in the form of mandatory bifurcation. There are also other countries which have mixed systems in which defendants have the choice of either arguing validity in litigation or in a separate procedure (e.g., utility model cases in Germany). Furthermore, there are some systems where the applicant has a choice between various routes to contest validity (e.g., opposition and invalidation procedures). And a further variation exists in countries like Germany, where, depending on the timing of the litigation, the use of post-grant opposition procedures in litigation may be permissive or even mandatory *before* invalidation procedures can be initiated at specialized courts, like the German Federal Patent Court. This variety of mechanisms to assert patent invalidity has led to a remarkable degree of forum-shopping, particularly in Europe. This panel will lead a discussion on the mechanisms and pros and cons of the various invalidity procedures available around the world.

12:45 — 1:45 Lunch

1:45 — 3:00 [Panel 4] Post-Grant Administrative Invalidity Proceedings Across Different Jurisdictions

(Asamura, Ehlers, Jordan (J), Sterne, Zhu)*

The international legal mechanisms to invalidate patents continue to expand. While some countries require all validity challenges to be conducted in ordinary civil courts, most

countries now have available a variety of administrative procedures or specialized tribunals to address patent validity. These administrative proceedings can have a profound impact on not only patent validity but on the way proceedings flow and are managed in the civil courts. In some systems, such as the U.S.A., patent validity can be challenged administratively within the Patent Office in an *inter partes* review, post-grant review, or *ex parte* reexamination proceeding. Europe offers not only a wide variety of countries and legal systems but there is the concurrent opportunity to be involved in an EPO opposition proceeding. Thus, administrative and specialized tribunal invalidity challenges can take many forms, and the strategy taken during administrative proceedings can be dependent on the options and timing of the civil courts. The variety of non-judicial proceedings can occur in many jurisdictions and each offers its own set of advantages.

3:00 — 4:15 [Panel 5] International Issues in Biopharma Patent Litigation

(Birss (J), Carey, Dave, Hutter, Rea, Sergheraert)*

Biologic and pharmaceutical patent litigation differs from other types of patent litigation in significant ways. Biopharma litigation are frequently the result of statutory provisions for resolving patent disputes that are part of the generic drug or biosimilar approval framework. These provisions create unique substantive and case management issues. Where innovative biologic and pharmaceutical products requiring first-time FDA approvals are involved, other unique legal and case management issues often arise. Biologic and pharmaceutical patent litigations also frequently call on courts to balance the public's interest in encouraging and rewarding the discovery and development of new drugs and biologics against that of making differentiated, life-altering, and/or life-sustaining therapies available to patients who may benefit from them. Topics include small molecules, generic pharmaceuticals, biologics, biosimilars, PTEs, and SPCs.

4:15 — 4:30 Afternoon Break

4:30 — 5:45 [Panel 6] Global Litigation of Standard-Essential Patent (SEP) and Fair, Reasonable, and Non-Discriminatory (FRAND) Issues

(Dagg, Delgado, Geiszler, Grzimek, Kalden (J), Stark)*

This panel will deal with current issues arising in SEP-related litigations across patent jurisdictions. The discussion will focus on the effects of commitments made to license patents on FRAND terms in infringement suits. In multiple jurisdictions, including Europe, the U.S., and China, courts have been called upon to examine the meaning of FRAND and the appropriate methodologies to determine a FRAND rate. For example, U.S., U.K., and German case law has recently addressed the meaning of "non-discrimination" in the FRAND

commitment. In Europe, courts have been applying various approaches to further define the obligations of parties in FRAND license negotiations established by the Court of Justice of the European Union (CJEU) in its 2015 Huawei v. ZTE decision. Disputes across multiple jurisdictions have centered on the availability and adequacy of injunctions, the determination of global FRAND royalties, and the international jurisdiction of courts. The discussion will include developing case law in Asia, as recently Chinese courts have more frequently been involved in international litigations, as well as the increasing relevance of standard-essential patents in new markets for interconnected devices provided by traditional industries ("Internet of Things" applications, "smart cars," etc.). The panel will cover:

- Issues surrounding the availability of injunctive relief in SEP cases
- consequences of FRAND obligations for the traditional concept of damages in patent law;
- approaches to the calculation of FRAND royalties;
- FRAND-specific cross-border procedural issues; and
- how the developing global case law is shaping licensing and litigation strategies of patent owners and implementers.

Wednesday, November 20, 2019

7:00 — 8:00 Breakfast & Registration

8:00 — 9:15 [Panel 7] In-House Roundtable Company Perspectives on Global Patent Litigation

(Vollet, Waterland, Wang)*

This panel will include a range of in-house counsel across different industries and business practices who manage global portfolios of patent litigation. Our dialogue will highlight their diverse perspectives, including their differing goals and concerns about the state of patent litigation across multiple jurisdictions. We'll discuss the critical strategy issues they face and the fundamental considerations that impact their litigation decision-making.

9:15 — 10:30 [Panel 8] Strategic and Tactical Considerations in Selecting Venues for International Patent Litigation

(Aboim, Ebbink, Huang, James, Müller-Stoy, Strowel, Trenton)*

This panel will summarize and compare the procedures and relief available in the principal international patent venues and consider the strategic and tactical considerations informing the choice of various venues, including the location of litigants, the size of the market, the quality of adjudication, the time to trial and final relief, available relief, availability of preliminary relief, the opportunity for defendant initiated litigation (e.g., declarations of non-infringement, non-essentiality, nullity actions, and actions affecting other jurisdictions), the cost of litigation, and recovery of fees. Current trends and advantages and disadvantages of multi-venue litigation will also be discussed. These issues will be addressed from the perspective of different types of plaintiffs and defendants.

10:30 — 10:45 Morning Break

10:45 — 12:00 [Panel 9] Patent Remedies Issues Across Different Jurisdictions

(Buchinski, Illston (J), Michel (J) (ret.), Vo, Whiting, Wiesner)*

This panel will discuss various legal and procedural issues regarding patent injunctions. The focus will be on a comparison of the injunctive approaches of the following jurisdictions: United States, Germany, United Kingdom, and China. The panel will include specialists from each of these jurisdictions to provide an overview of the applicable legal standards and practices for obtaining injunctive relief. The panel will also touch on the issue of the calculation of damages, to the extent the analysis is relevant to practitioners' decision in determining where to bring suit.

12:00 — 1:30 [Panel 10] Judicial Roundtable

(Bacher (J), Bencivengo (J), Birss (J), Charleton (J), Goddar, Jordan (J), Kalden (J))*

Highly experienced judges from important jurisdictions around the world will discuss the different approaches that different courts take for managing patent infringement litigation.

1:30 — 1:35 Closing Statements
(Weinlein)

1:35 — 2:30 Grab and Go Lunch (provided)