

PATENT BOUTIQUE – Our Contentious Practice

Contentious practice forms a significant part of what we do. Our attorneys have represented clients at all levels of opposition and appeal proceedings before the EPO as well as in litigation before the High Court in England.

Prior to co-founding Patent Boutique, Jon Broughton was Head of Contentious Practice at Avidity IP, where he oversaw all contentious patent matters for the firm. His role involved directing the contentious practice business unit, including establishing best working practices, maintaining standards across the firm, training others, managing client relations, and handling specific matters himself. During the course of that position, and subsequently, Jon has been involved in over 65 opposition and appeal matters, leading in approximately 30 cases. Of those cases where he has led through to completion he has a success rate of approximately 75%, with over 85% success when acting for the patentee (generally considered more challenging). Jon has provided written and oral advocacy before opposition divisions, the Technical Board of Appeal, and the Enlarged Board of Appeal in the EPO. He has also run litigation in the English courts together with, and independently of solicitors. On one matter, Jon provided all written and oral advocacy in litigation before the High Court of England and Wales.

Prior to co-founding Patent Boutique, in his previous role at Barker Brettell LLP, Simon Foster handled a large number of European oppositions and appeals across a diverse range of subject matter, from inhalers, wound dressings, and ostomy devices, through to drug formulations and consumer goods. Simon has always relished the demands contentious matters present and has an enviable track record. Before joining Barker Brettell LLP, Simon worked in-house for the generic giant Teva Pharmaceuticals. During this time, as well as handling opposition and appeal matters directly before the European Patent Office, Simon also coordinated a number of multi-jurisdictional litigations, including the Seretide (Advair) German revocation action, which, at the time, was the highest valued patent litigation in German history. As a direct consequence of his experience, Simon has a network of European litigation lawyers with whom he has worked and can recommend which is second to none.

Our contentious practice experience extends to a broad range of technologies (medical devices including stents and inhalers, biotechnology, biopharmaceuticals, consumer goods, pharmaceuticals, nutraceuticals, vaccines, diagnostics including point of care, precision medicine, immunology and antibodies and luggage).

We have also been involved in key cases that have determined the law applied in the EPO (for example the Harvard Oncomouse case, the Enlarged Board of Appeal case on transfer of opposition status and the Technical Board of Appeal case interpreting the need for gene cases to recite the function of the claimed nucleic acid). We are often required to derive novel legal arguments, and to adapt our clients' cases to the law as it stands, and we do so, sometimes, under difficult conditions. We are skilled at creative use of procedural law as well as substantive law to achieve our clients' objectives.

A major part of contentious practice is oral advocacy before a tribunal or judge. Many patent attorneys shy away from opposition and appeal practice because of this (a day or two of oral proceedings in the EPO can be stressful, tiring and highly demanding). Our attorneys thrive on advocacy and welcome the opportunity, and have developed real skill in this area.

We also offer pre-litigation support in the form of freedom to operate opinions and infringement and validity opinion. We can also manage patent office third party observations and UK IPO opinion service requests.

Although we are a new firm, we have already been entrusted with several opposition matters, both by US law firms, and by direct clients. We are currently handling attacks in the fields of inhalers (for a direct client), and biotechnology (for a law firm client), and opposition defences in the fields of precision medicine and proteomics (direct client), isothermal amplification (direct client) and stents (law firm client). We have already completed our first appeal successfully for a major client in the field of point of care diagnostics. In some matters we are representing clients as straw man opponents, and in one case are doing so through a third party filing firm to further obscure the identity of the opponent.

Contentious matters are necessarily time consuming and therefore potentially expensive. We are able to manage the process, and always do so with the client's needs and budget in mind. We will listen to your requirements and try and develop a fee approach that suits you. We are open to ideas.