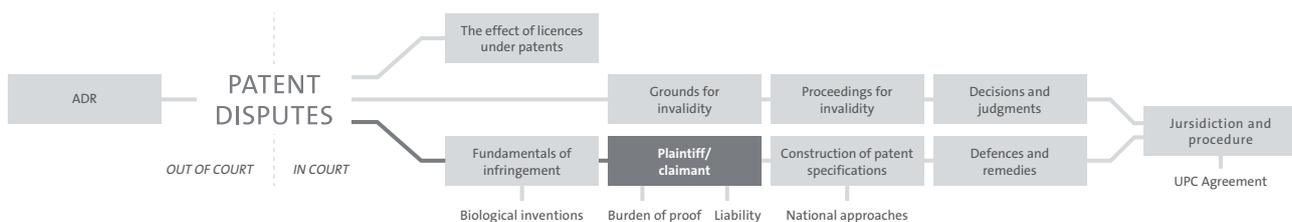


# Plaintiff/claimant

## Essentials



## The patent proprietor as plaintiff/claimant in infringement proceedings

In a patent infringement action and/or any other protective measure, the plaintiff/claimant will normally be the proprietor of the right, i.e. the owner of the patent.

Under national patent laws, normally the person who is registered in the national register as the patent proprietor is considered the proprietor of the patent. In most European Patent Convention (EPC) contracting states, the registered proprietor – even if he is not the legal owner under substantive law, for example due to a transfer of rights which has not (yet) been recorded – may, therefore, file an infringement action and damages claim and/or a request for protective measures or a preliminary injunction.

After the national validation of a European patent, the original patent proprietor may transfer any national part of his European patent to different persons and/or entities. As a consequence, the actual patent proprietor of a European patent may vary from member state to member state. This does not, however, give rise to any problems in the current national court systems, as the proprietor of the respective national part of the European patent is decisive for national infringement proceedings.

Under the national systems, patent proprietors who file an infringement action have, if required, to prove their right to sue. For this purpose, in many EPC contracting states, for example Germany, they may submit an extract and/or certification from the national patent register concerned. This means that, in a number of EPC contracting states, the registration of a patent assignment, including the registration of the assignee as the

### Article 4 of the Enforcement Directive (2004/48/EC of the European Parliament and of the Council of 29 April 2004)

Member States shall recognise as persons entitled to seek application of the measures, procedures and remedies referred to in this chapter:

- the holders of intellectual property rights, in accordance with the provisions of the applicable law;
- all other persons authorised to use those rights, in particular licensees, in so far as permitted by and in accordance with the provisions of the applicable law.

### The registered patent proprietor may enforce a granted patent

The status of the patent proprietor can usually be verified from the national register concerned.

new patent proprietor, is a mandatory condition for the assignee to sue patent infringers if ownership is disputed by the defendant. However, in the UK and Denmark for example, non-registered patent proprietors may also file infringement actions, and the patent registry is not definitive proof of ownership of the patent. In the Netherlands, conversely, a registered patentee would not be able to enforce the patent if it had been transferred and the register had not yet been updated.

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## Co-owners as plaintiff/claimant in infringement proceedings

If a patent is owned by more than one person or entity, under the current national legislation in the European Union, each of the proprietors owns a share of the patent. The co-owners may enter into an agreement as to who has the right to sue.

Generally speaking, the statutory requirements of the co-owners' right to sue are the same throughout Europe. In other words, each co-owner may enforce the patent by himself.

However, the legal requirements and consequences relating to the co-owners' right to sue differ from country to country.

- **In the United Kingdom**, Section 66 of the Patents Act 1977<sup>5</sup> states that any of the co-owners may file a claim in respect of an alleged infringing act, but such a co-owner must make all the other co-owners party to the proceedings as co-defendants. It also states that the non-participating (defending) co-owner(s) are not liable for any costs or expenses arising from the proceedings.
- **In France**, under Article L. 613-29 of the *Code de la propriété intellectuelle* (Intellectual Property Code), any co-owner may sue a third party for patent infringement. However, the co-owner who files an action for infringement must forward a copy of his filed claims to the other co-owners, thereby notifying them of the action he has initiated. The proceedings are stayed until it is shown that such notification has been made.
- **In Germany**, the *Patentgesetz* (German Patent Act) (PatG) does not contain any specific regulation regarding co-ownership. For this reason, Section 1011 of the *Bürgerliches Gesetzbuch* (German Civil Code) (BGB) applies by analogy. In other words, any co-owner may enforce the patent without notification to or the consent or obligatory involvement of the other co-owner(s) in the proceedings.

### Patent co-owners' right to sue

Co-owners may individually file an infringement lawsuit against an alleged infringer.

For an international overview see point 7 of AIPPI summary report of AIPPI, question Q194 ([www.aippi.org](http://www.aippi.org)).

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<sup>5</sup> The EPC and the UK Patents Act 1977 (as amended) apply equally to all parts of the United Kingdom. Jurisdictionally, however, the United Kingdom is divided into three parts: England and Wales, Scotland, and Northern Ireland. Proceedings in the Scottish courts differ markedly from those in the other jurisdictions.

- **In the Netherlands**, according to Article 66 of the Netherlands Patents Act, any co-owner has the right to enforce his patent against an alleged infringer without the consent or notification or obligatory involvement of the co-owner(s). However, the alleged infringer as defendant cannot file a counterclaim for revocation of the patent if not all the co-owners are participating in the proceedings.

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## The licensee as plaintiff/claimant in infringement proceedings

### Licensees as plaintiff/claimant

Most European jurisdictions distinguish between the rights of exclusive and non-exclusive licensees to sue in their own name. Licensees may often intervene in patent litigation procedures.

Patent proprietors may grant a licence to other parties to exploit their patents. When negotiating the terms of the licence, one of the key issues is usually to establish the extent to which the licensee has the right to enforce the patent against third-party infringers. Regulations in the EPC contracting states differ from country to country.

In several EPC contracting states, the status of the licensee can easily be proven by producing a register extract from the respective national patent office. However, not every kind of licence or licensee can be registered in every country.

- **In the United Kingdom**, an exclusive licensee may file an infringement action in his own name. According to Section 67 of the Patents Act 1977, the holder of an exclusive licence has the same rights as the proprietor of the patent with respect to any infringement of the patent committed after the date of the licence. However, where an exclusive licensee files an infringement action, the patentee must be formally joined as a co-defendant in the action, unless the patent proprietor agrees to join the action as a claimant. The patent proprietor is not liable for any costs if he does not take part in the proceedings. Note that if the exclusive licence is not registered, the exclusive licensee will not be entitled to recover the costs of the action, should he win.

Non-exclusive licensees have no statutory right to sue for infringement. So even if the licensor was to grant a contractual right to file an infringement claim, a non-exclusive licensee would be unable to do so in the UK courts. Non-exclusive licensees may rely upon relevant contractual provisions of the licence to compel the patent proprietor to bring infringement proceedings, or to be joined in the proceedings. However, there is no formal entitlement to intervene in the litigation.

- **In France**, Article L. 615-2 of the *Code de la propriété intellectuelle* states that if the licence agreement does not state otherwise, only an exclusive licensee may sue for alleged patent infringement, as long as the exclusive licence is registered in the French (or European) patent register and provided that the owner of the patent does not institute such proceedings, after receiving specific written notice of the licensee's intention to sue.

In France, non-exclusive licensees do not have the right to sue in the event of an alleged infringement. Any licensee, even a non-exclusive or non-registered one, may voluntarily intervene in infringement proceedings which have been initiated by the patent proprietor to claim for damages.

- **In Germany**, the position of the exclusive licensee is close to that of being the patent proprietor. He may file an infringement action and claim injunctive relief and damages, as from the date of grant of the exclusive licence. If the exclusive licence does not cover all possible forms of use of the patent, the licensee's right to sue is limited to its scope. In infringement proceedings, the licensee must also prove that the exclusive licence was validly granted by the registered patentee, e.g. by producing the licence agreement. As an exclusive licensee may only request that the notice of grant of the exclusive licence, (but not the name of the licensee as such), is entered in the registry by the *Deutsches Patent- und Markenamt* (German Patent Office), the submission of a register extract is not considered to be sufficient evidence of proprietorship.

With regard to non-exclusive licensees' rights to sue under German law, a distinction must be made between the different exclusive rights arising under the patent. As claims for injunctive relief and destruction may only be transferred together with the patent, a non-exclusive licensee may not assert such claims in his own name but only in the name of the patentee/licensor. In order to do so, the licensee must (1) be authorised to do so by the patentee/licensor and (2) have an interest in enforcing the patentee/licensor's rights. In contrast, claims for damages, compensation and rendering of account may be asserted by non-exclusive licensees in their own name, provided they can prove that such claims have been assigned to them by the patentee/licensor.

- **In the Netherlands**, under Article 70 of the *Octrooiwet* (Netherlands Patents Act), licensees do not have the right to file a claim for an injunction in their own name. They may, however, request an injunction in infringement proceedings in the name of the patentee, on the basis of a power of attorney granted by the patentee. Licensees may also act as co-plaintiffs alongside the patentee or intervene in infringement proceedings initiated by the patentee in order to obtain direct compensation for damages or be paid a proportional share of the profits by the defendant. The licence has effect vis-à-vis third parties if it is registered (although third parties could also be notified by other means).
- **In Hungary**, only registered licensees (whether exclusive or non-exclusive) may lodge an infringement case on their own behalf. They must first invite the patent proprietor to take appropriate steps against the alleged infringer. They may only lodge an infringement action if the patentee fails to take action within thirty days of the said invitation.

### **The plaintiff/claimant in revocation proceedings**

In most EPC contracting states, anyone may file a revocation (invalidity) action against the proprietor(s) of a granted patent. There is usually no need for a declared commercial interest. In France, however, the plaintiff/claimant in a revocation action must have standing to bring his claim (either because the patent has been asserted against him or because he is a competitor of the patentee, and thus has an interest in clearing the way). In most EPC contracting states (including Germany and Denmark), if the ground for revocation is that the patent was granted to a person not entitled to the invention, only the person claiming to be the true proprietor may seek revocation or amendment of the patent.

### **Plaintiff/claimant in revocation proceedings**

In most EPC contracting states, anyone may file a revocation action against a patent in force, regardless of whether or not they have a proven legal or economic interest.