



Jon Lang Mediation

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Patents – examples of mediations undertaken

A patent entitlement case (Section 37 Patents Act claim originally before the Comptroller and then transferred) in respect of a product used in the construction industry. One party alleged that it designed the invention embodied in a patent granted to the other party, or in the alternative that it was a co-owner. The registered proprietor argued 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. Whether the patent was of benefit to the proprietor, and its value (to the proprietor) were issues for debate as was the claimant's contribution to the invention so as to consider the 'fair share' (c. £2 million).

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

Mediation of 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 was met with a defence of non-infringement (involving arguments on construction) and a counterclaim for invalidity based on lack of novelty (elements in 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 the inventive concept claimed was obvious). There were also arguments over commercial success and what the evidence demonstrated in terms of long felt want as secondary evidence of inventiveness.

Mediation of 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 mediation in the financial services field involving an analysis of prior art relevant to each function and concept claimed in the patent said to be infringed.

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 mediation 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 and a claim for a declaration of non-infringement.

An patent dispute between 'household name' competitors in the luxury products market.

A patent infringement/invalidity dispute in the manufacturing sector.

Mediation of 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 (c. 750k).