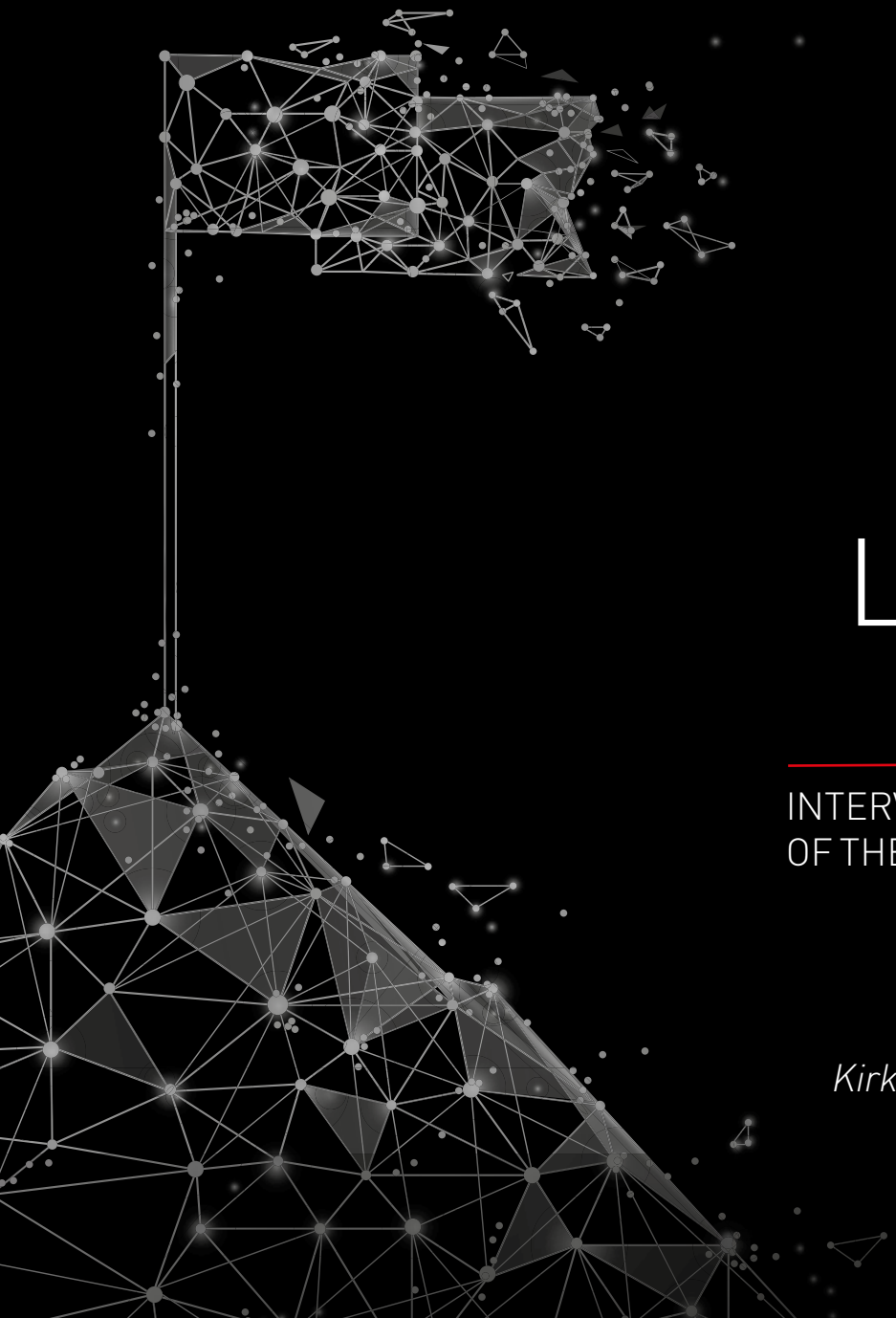
IAM



GLOBAL LEADERS

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INTERVIEWS WITH THE PINNACLE OF THE PATENT LAW PROFESSION

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Biography

A partner at Kirkland & Ellis, Nicola Dagg is one of the world's leading authorities on patent litigation. Her practice spans four areas: strategic life sciences patent and product lifecycle advice, life sciences patent litigation, coordinating global IP enforcement/defence cases and standard essential patent and FRAND disputes. Ms Dagg has served as UK and European/global counsel for numerous strategic IP litigation cases, drawing on over 26 years of legal, life sciences tech and IP experience.

As the United Kingdom starts to diverge from EU practice (eg, the AI-related IP exemption covering copyright and database rights), what action should IP practitioners – and their clients – be taking?

We have not yet seen a significant divergence between EU and UK practice. On the patents side, this is principally due to the United Kingdom still operating as part of the European Patent Convention. Of course, the United Kingdom will not be part of the UPC, so there is a prescient need for strategic advice on patent filing, opt-out and combined UPC/UK litigation strategy.

What led you to a career in IP litigation?

I graduated with a natural sciences degree from the University of Cambridge and I had funding for a PhD secured. I was considering my options and chatted with friends who had done placements at patent departments, so I thought I would give IP law a try. I found that IP law's biggest draw was the opportunity it gave me to work with cutting-edge scientists. I have had to pinch myself on occasion, such as when I was sat in a conference room listening to a Noble Prize winner explain their new invention and being paid to be there. Intellectual property and patent litigation has been an amazing career journey.

How do you expect FRAND issues to develop in the United Kingdom over the coming years?

Global determinations of FRAND licences continue to be a key area of court busyness in the United Kingdom. Global FRAND determination judgments are awaited in InterDigital v Lenovo and Optis v Apple. Up until recently, the UK court was the only court to decide global FRAND without consent of the parties. Now the China courts are doing the same. More complex jurisdictional questions continue to be a feature of UK litigation including in the Nokia v Oppo FRAND litigation, where there are extant global FRAND proceedings before both the English and Chinese courts.

Another area that we expect to see more of is mixed mediation/arbitration or mediation/litigation on FRAND and related disputes. We are also seeing increased government interest in the multi-jurisdictional frameworks, with both the UK and US governments recently calling for submissions on FRAND issues.

What are some of the biggest challenges that clients face in the pharmaceutical and biologics sectors?

The English court continues to carefully analyse plausibility/sufficiency of the patent claims in life sciences patent disputes. Often there is a close squeeze with the inventive step analysis. It is key to find a strategy for the innovator that brings to life the true technical benefit provided by the patent.

Another striking challenge that has come to the forefront recently is the lacking willingness of the English courts to grant preliminary injunctions against generic/biosimilar entrants. This was thrown into stark reality in the recent Novartis v Teva case on the Gilenya medicine. One factor may be the English court's increasing knowledge of UK market dynamics for the medicine in question, and the ability to rely upon detailed economic analyses and sophisticated data on sales and pricing for any sales made pending the trial on the merits that it is more difficult for the patentee to show irreparable harm.

What are the most important steps of an IP monetisation process?

These steps must include mapping the IP rights to the target products or proposed products/systems, heat maps relating to the strength of the IP rights as 'blockers' for such products, gaps in the portfolio relative to product development, objective valuation of the IP rights, and tax and funding frameworks for the monetisation programme.