

ALLEN & OVERY

Intellectual Property

France | 2023



Why Allen & Overy?



Capacity and availability

Composed of three partners, Laëtitia Bénard, David Por and Alexandre Rudoni, one counsel, Charles Tuffreau and eight associates, the established Paris IP practice has both the resources and the capability to provide clients with cutting-edge advice on a wide range of intellectual property issues relating to patents, trademarks and copyright, both contentious and non-contentious. We put a strong focus on partnering on a long term basis with our clients and on providing pragmatic and proactive legal advice to meet with their business expectations.



Sector focus

Our growing team of specialists has developed thorough expertise in dealing with issues that are key in specific sectors. In particular, the team is recognised for its in-depth knowledge of the life sciences, telecoms, high-tech, gaming and entertainment sectors, where we advise many leading international companies on a regular basis. We have thus developed a thorough understating of the the specific range of challenges faced by actors involved in these industries. This sector orientation combined to our unrivaled experience, grants us a competitive edge compared to other law firms.

“Particularly well regarded for its ability in patent disputes, the team also offers knowledge of litigious trade mark and copyright issues.”

Chambers Europe 2022 – France (Intellectual Property)

Clients comment: “They are very nice to work with as well as highly competent and technically minded,” adding: “They have the ability to understand the finer technical details.”

Chambers Europe 2022 – France (Intellectual Property)

“Allen & Overy LLP remains a leading firm for multijurisdictional high-stakes patent litigation, especially in the life sciences and technology sectors.”

Legal 500 EMEA 2022 – France (Intellectual Property: Patent)

“The practice stands out for its prolific preliminary-injunction practice, which has won multiple market first decisions, and its ability to provide seamless litigation guidance across country borders thanks to the firm’s strong international patent set-up.”

Legal 500 EMEA 2021 – France (Intellectual Property: Patent)



A global network

Allen & Overy is one of only a few prominent, full-service firms which have a significant, multinational market presence in the intellectual property field. Our global team comprises more than 90 specialist IP partners and associates in all of the important European IP jurisdictions including the UK, Germany, the Benelux countries, Italy and France, along with a team of experts in New York, Hong Kong, Shanghai and Japan. Most of the cases we act on have a transnational component, which allowed us to gain extensive experience in factoring in the multijurisdictional aspect of our work. As such, our team is uniquely placed to craft litigation strategies that fully take advantage of the possibilities offered by foreign forums or the EPO.

“Strong IP practice providing expertise in various sectors including life sciences and TMT, with further knowledge of the entertainment industry.”

Chambers Europe 2022 – France (Intellectual Property)



An innovative approach

We advise on a wide range of complex cases, working with both national and international clients on high profile and strategic matters. We are one of the few IP teams on the French market which includes qualified European Patent Attorneys and associates with scientific and technical degrees as well as industry experience. This familiarity with the key legal and industry issues allows us to advise clients with confidence in cases involving the most complex technology and to offer to our clients a practical and business oriented approach to understanding and achieving their objectives. We work closely with our clients to meet their business objectives. We pride ourselves on taking an innovative approach to the cases we work on, often advising on high-profile and ground breaking cases, which shape the legal landscape for the world's leading companies. Client feedback praises this approach to handling cases, which clearly differs from that of our competitors.

In Paris the group is known for its involvement in some of the most headline-grabbing and precedent-setting cases in both the life sciences and high-technology sectors.

IAM Patent 1000 2022 – France (Intellectual Property)

Patents

We assist our clients in devising and implementing national and international patent litigation strategies to achieve the right outcome for them, including, in emergencies, the use of preliminary injunctions, infringement seizure orders and customs seizure measures.

We also advise on validity and freedom-to-operate issues. In addition, we have an in-depth understanding of conducting detailed patent portfolio due diligence reviews and audits. Our involvement in numerous ground-breaking precedents has helped to reshape patent laws in France and in Europe, in particular in the pharmaceutical field. In recent years, we have been successfully involved in one of the first cases in France involving antibodies, in which we obtained the full dismissal of the preliminary injunction action brought by the other side against our client. We also obtained a decision granting the highest amount of provisional damages ever awarded in France, EUR13 million, further reduced to above 10 million for procedural reasons – a historic record for France issued on the back of a period of seven years where no preliminary injunction had been granted based on pharmaceutical patent. We have also advised on a case raising for the first time before the French Courts the issue of patentability of dosage regime claims. Furthermore, we have been involved in obtaining the first the first ever decision by the Mannheim court – one of the three most prominent and busiest patent infringement courts in Germany – finding a defendant to have infringed, but refusing to issue an injunction against it because the patented had failed to comply with FRAND obligations.

We have also acted on the vast majority of disputes involving SEPs and FRAND issues in France which have defined the national approach to SEP litigation.

Several members of the team have a technical background and/or significant experience in high-tech and telecom matters, enabling us to be at the forefront of legal issues arising from recent technological developments, such as those involved in standardisation. This familiarity with the key legal and industry issues enables us to offer our clients a practical and informed approach to understanding and achieving their objectives, whether this means developing an effective litigation strategy or negotiating a judicious settlement.

Our expertise in regulatory issues and product liability is complementary to our patent law practice and allows us to fully address our clients' needs in the pharmaceutical field. With the current increasing focus of European regulators on the patents field, our patent team is complemented by our leading anti-trust team. Allen & Overy can draw on this combination of focused legal skills, the ability to keep up to date with patent legislation and our global reach to give our clients access to the best advice when such challenges arise.

A global pharmaceutical and healthcare company

We are assisting and representing a global pharmaceutical and healthcare company in multiple infringement lawsuits brought against numerous major generic companies based on a patent covering one of our client's blockbusters for the treatment of several types of cancer.

We have notably initiated preliminary infringement proceedings that are now pending before the Paris Court of Appeals, as well as proceedings on the merits against several companies to counter the launch at risk of their generic products. These proceedings are of utmost importance for all parties and will have a major impact on the market in France. This case also takes place in a complex international context as proceedings are ongoing in numerous European countries and as it raises complex issues of US law.

MGI

We are advising Chinese companies of the MGI group, the main challenger in the field of genetic sequencing, regarding a dispute against the market leader, Illumina Cambridge. The patents at stake involve extremely complex DNA sequencing technology, including machines, reagents and nucleotides. Despite adverse precedents in other European Jurisdictions, we secured MGI's access to the French market by obtaining the dismissal of Illumina Cambridge's provisional infringement claims before the Juge of the Paris First Instance Court in charge of the proceedings on the merits.

This dispute could shape the market for decades to come, and is a true bet-the-company litigation for our client.

A global pharmaceutical and healthcare company

We continue to be first counsel of choice of a global pharmaceutical and healthcare company for all patent litigation matters in France and are notably representing this company in multiple patent actions before the Paris First Instance Court, the Paris Court of Appeals and the Supreme Court concerning the validity and enforcement against major generic companies of its SPCs relating to the combination of ezetimibe, first compound of its class, and statins, in the field of the treatment of notably hypercholesterolemia. Despite several adverse precedents, we relied on the landmark Gilead decision from the CJEU to obtain a favourable decision on the merits as to the validity of the SPC covering the combination ezetimibe + simvastatin. We also obtained strong provisional reliefs against generic companies that launched at risk (preliminary injunctions, recalls of products, seizures of products and provisional damages), with an unprecedented series of victories in the LS patent field in France at the time.

Some of these proceedings are now before the French Supreme Court, and could lead to a referral before the CJEU on the interpretation of Article 3 of the SPC Regulation, while other proceedings on the merits are still pending before the Paris First Instance Court. These cases are under a lot of scrutiny by the pharmaceutical industry given the key questions they entail.

They concerned one of the major blockbusters of our client such that the stakes in these French patent litigation matters are very high. The related assets have been transferred to Organon who has entrusted us to continue the litigation on their behalf.

A multinational technology company

We are representing a multinational technology company in a patent infringement lawsuit brought by an individual against Android (operating system). It is the third patent case involving this company in France.

In the first case, we managed to obtain the summary dismissal of the plaintiff's claims without full briefing on the merits, thereby setting new standards for the sufficiency of patent infringement claims. The second case involves two patents, one being litigated before the Paris First Instance Court and the other one before the Paris Court of Appeals.

We are also representing the technology company in two infringement actions based on two patents launched against Sonos, a major developer and manufacturer of audio products. In one of the actions, the Paris First Instance Court found the patent valid but not infringed. This decision has been appealed. The other action is still pending before the Paris First Instance Court.

This litigation pertains to a global dispute against the two companies, where various offensive and defensive actions are pending in the US, Germany, The Netherlands, and France.

Trademarks

Our Paris team has extensive experience of trademark contentious and non-contentious matters.

We regularly advise our clients on the most complex trademark issues, such as trademark infringement on the internet, cross-border injunctions or use of the trademark of an original medicine by a generic medicine. We represent our clients before both French and European Union courts.

The expertise we have acquired on related matters, such as custom regulations, internet law and EU law, makes us privileged partners in defining and implementing anti-counterfeiting strategies on a national or international basis. We advise leading companies in the luxury, industrial,

entertainment and pharmaceutical sectors. Our expertise extends to the transactional side. We assist our clients in drafting and reviewing various types of complex trademark agreements. In addition, we regularly review important trademark portfolios and agreements in the context of mergers and acquisitions, in close coordination with the corporate department.

We also provide strategic advice on brand protection and development, use and enforcement strategies, and quality control.

Nintendo

Our work for Nintendo contributes to the global efforts of the current leader in video games in its fight against all kinds of piracy.

Our team recently obtained two landmark decisions in France in 2021 and 2022:

1. One of the highest damages award against a hosting provider

We have obtained the sentencing of the hosting company Dstorage in 2021, which operates 1Fichier.com, a website known globally for hosting infringing copies of video games to a nearly unprecedented amount of damages.

In its decision dated 25 May 2021, which Dstorage has since appealed, the Paris Judiciary Court ruled that this host is liable for failing to remove infringing video games copies from its website and sentenced it to the payment of EUR 935,500 in damages notably for failing to remove trademark infringing content. This decision is highly significant not only for Nintendo but also for the video game industry as a whole.

The decision is under appeal.

2. Landmark ISP injunction in the video game sector in 2022

We have obtained the first blocking injunction against a website making available copies of Nintendo video games. French courts had never been tasked with ordering blocking measures requested by right holders (they are more commonly by collective right societies). The action initiated by Nintendo is therefore unprecedented.

On top of these two court successes, we advise Nintendo on the enforcement of all aspects of its anti-piracy programme in France, notably in its efforts to prohibit the sale of devices designed to circumvent the technical measures protecting the Nintendo consoles. This leads our French team to represent Nintendo in several on-going criminal and civil actions for copyright infringement and circumvention of technological protection measures (TPMs).

Netflix

We are Netflix's French clearance counsel for all of their new titles to be broadcasted in France. We also provide regular trademark and copyright advice on their main titles.

Netflix continues to disrupt the media industry. This US media-services provider and production company's primary business is its subscription-based streaming service which offers online streaming of a library of films and television programs, including those produced in-house.

We are assisting Netflix to clear all of their new titles to be broadcasted in France. Our clearance work requires assessing prior copyrighted works as well as registered rights in France. We have conducted more than 90 clearances for Netflix in a year. Recently, we have assisted in a number of disputes involving the protection of their LA CASA DE PAPEL series

In addition, we have assisted in assisted in a number of disputes, including oppositions and copyright claims in France brought by third parties following the success of their SQUID GAME series.

Fujifilm

We have successfully defended Fujifilm before the Paris Court of Appeals in high profile cross-border trademark and free-riding litigation in relation to the white border square format used in instant photography.

The alleged successors to Polaroid claims to own valid trademark rights on this format and seeks to enforce them against competitors such as Fujifilm. In France, they have sued Fujifilm on the ground of free-riding before the Paris commercial court. The Paris Court of Appeals, in a ruling dated 30 September 2022, dismissed all of Polaroid's claims following Fujifilm's arguments that (i) the borders are imposed by a technical constraint (ii) the notoriety of the format is not demonstrated to the extent that it has become synonymous of "instant film" in general and that the alleged successors are not responsible for its former notoriety, and (iii) there cannot be any free-riding by Fujifilm since there has been no square instant film on the market under the Polaroid brand from 2009 to 2017, while the launch of the criticized Fujifilm product occurred within that timeframe.

It is possibly one of the most interesting trademark/free-riding case of the year where the courts will have to decide whether Polaroid can claim a monopoly on the white border square format

Epic Games

We advise Epic Games, a leading global videogame publisher. Epic Games is one of the most talked about video games company in the world in 2017 and 2018, mostly because of its video game "Fortnite".

This game is currently reported to generate 300 million USD per month and one of the most played video games in the world with more than 40 million players. France is an important market for Epic Games because of its large customer base.

As video games experts, we advise Epic Games on most of their legal matters in France, from IP disputes to transactions and in particular on various copyright related issues. This includes reviewing most of their IP oriented agreements in France, advising them on esports regulations, third party IP claims and anti-piracy. This year again, we have successfully enforced Epic Games' IP rights in Fortnite against several hackers selling "cheats" on Fortnite.

Copyright and designs

Our Paris team has significant expertise in the field of copyright and designs in a wide range of industries.

We offer a great panel of services, from helping to identify, protect and licence copyright and design assets to advising on infringement issues and transactions.

We notably assist leading international companies from the software and entertainment industry in the implementation of their anti-piracy strategy across Europe. This has led us to acquire valuable experience on matters such as digital rights management, technical measures of protection, and the HADOPI regime. Several members of our team have a solid technical background and are thus comfortable with handling the most complex copyright issues.

Furthermore, we often advise international clients from the high-tech and telecoms industry concerning the measures needed to put their goods in line with French copyright legislation, such as payment of the private copying levy.

We also assist and represent actors from the audiovisual and music industry concerning the copyright issues related to the exploitation of their original works in France and abroad. This enabled us to develop valuable experience in reviewing complex audiovisual agreements concerning author rights as well as related rights of performers and producers.

One of the largest video game publishers

One of the largest video game publishers, in all of their matters in France. In particular, we assist them in a commercial and intellectual property litigation initiated by the French consumer association, UFC Que-Choisir before the Paris First Instance Court involving Valve's online Terms and Conditions. The Court issued its decision in September 2019. Valve lodged an appeal before the Paris Court of Appeal. The appeal proceedings are ongoing. This dispute, which received high media coverage (see below) including abroad where similar actions were initiated against Valve, further establishes the reputation of the firm in handling key issues, such as the resale of online video games, affecting the gaming industry.

We also represent Valve in the context of a lawsuit introduced by an e-sport player, one of the first of its kind in France, who was allegedly banned from participating in e-sports competitions sponsored by Valve on the ground that he had fixed a match with other players (see below in press coverage).

We also represented Valve before the French consumer protection administrative authority (DGCCRF) for alleged breach of consumer law. In particular, DGCCRF considered that Valve was not compliant with consumers' right of withdrawal. The DGCCRF fined Valve as well as other major players of the video game industry (Electronic Arts, Blizzard, Ubisoft). This was the first decision rendered on this topic and it forced those majors to amend their practice in this regard. Valve appealed such sanction before administrative courts. The proceedings are on-going.

Riot Games

Riot Games, Inc. is an American video game developer and esports tournament organizer based in West Los Angeles, California. Riot Games gathers millions of viewers in stadium and online to view players compete against each other on the game League of Legends. Riot Games is currently the leading company in esports (i.e. competitive gaming).

We assist Riot Games in relation to the organization of esports events in France, and more generally to comply with the e-sport regulatory framework in France. We are also helping Riot enforcing their IP rights against unlicensed organizers of esports events.

Nikon

Nikon is a Japanese multinational company, which among various activities, owns one of the leading global brand in photography.

We assist Nikon in relation to their customs activities, in particular seizures and customs training, as well as legal actions in relation to counterfeit Nikon products (cameras, lenses, batteries...).

Primark

Primark's business in France is booming globally. We act as their lead IP counsel for this Irish clothing retailer and represent them in their entire trademark and design litigations in France.

We have successfully assisted them in a copyright, design and unfair competition legal action brought by The Kooples before the Paris commercial court in relation to a hand bag.

Focus Entertainment

We are assisting this leading video game publisher with its clearance operations worldwide. Our goal is to ensure that the titles published by it do not infringe any third party trademark rights or copyright and cannot give rise to actions in unfair competition/passing-off claims in Europe and elsewhere. In such cases, our role also involves providing strategies and advice to circumvent or neutralise the associated risks.

We were involved in the high stake operation of Focus Home Interactive's identity change and were asked to clear three potential new company names in EU, UK, US, Canada and Australia. We were also asked to clear a major video game title in France, Germany, UK, USA and Canada.

Our clearance operations comprised a very important multijurisdictional aspect and required significant coordination and analysis efforts to deliver Focus Home Interactive with timely, clear and ready-to-go advice to facilitate the high stakes decisions it has to make.

An American media company

We are advising an American media company in relation to the enforcement of their intellectual property rights over James Bond against book publisher; as well as on general enforcement of their IP rights in France.

Your main contacts in Paris



Laëtitia Bénard

Partner

Tel +33 1 40 06 50 33

Mob +33 6 22 74 75 84

laetitia.benard@allenoverly.com

Laëtitia is a Partner in the Intellectual Property and Litigation department in Paris. She leads the Paris IP practice and is co-head of Allen & Overy's Life Sciences Group worldwide. She has a wealth of expertise in all intellectual property areas including patents, trademarks, copyright and unfair competition issues, both contentious and non-contentious. As a patent litigator, Laëtitia has acted in numerous highprofile international patent disputes, notably for pharmaceutical and high-tech companies, and is recognised for her innovative approach and for breaking new ground. She also advises on regulatory issues and contracts. On the Life Science front, she has unique experience on the French market being able to advise on pharmaceutical regulatory issues and their interplay with intellectual property law: she has been involved in a number of complex, market-leading, high-value patent litigation, which raises issues of concern for the whole pharmaceutical industry.

In the hi-tech sector, Laëtitia has deep experience having acted in most of the French high-profile cases, in particular with respect to SEPs (standard essential patents) relating to key market technology (3G, MP3, DVB-T) and telecom patent disputes.

“Laëtitia Bénard is ‘one of the leaders on the market,’ according to sources. She demonstrates strong experience in contentious patent mandates and nullity actions. Clients report: ‘She is thorough and is a good advocate in court and hearings,’ further adding: ‘She is active and successful!’”

Chambers Europe 2022 – France
(Intellectual Property: Patents)



David Por

Partner

Tel +33 1 40 06 55 46

Mob +33 6 15 21 00 22

david.por@allenoverly.com

David is a Partner in the Intellectual Property and Litigation department of Allen & Overy Paris. He is an experienced litigator specialised in all areas of intellectual property. His practice concentrates primarily on complex and crossborder intellectual property disputes, with a particular focus on patent cases, in which he also advises on validity and freedom to operate issues. David has notably represented leading actors in the patent wars of the high-tech sector, as well as numerous pharmaceutical companies in proceedings against generics. His expertise extends to complex litigation, including unfair competition and private enforcement matters. David has become a specialist of the interplay between intellectual property and competition law, notably in the field of standardised technologies, and is regularly invited to speak at industry conferences on this topic. David is also the author of the French Chapter of the Intellectual Property and Antitrust Review.

David is recognised by the market as one of the leaders in his field and is a frequent speaker on hot topics such as FRAND, the Unified Patent Court, computer-implemented inventions, etc.

“David Por is often acting on behalf of technology and pharmaceutical clients on patent infringement disputes. Client describe him as ‘very strategic and knowledgeable,’ while another interviewee adds: ‘He does what he says he is going to do, which makes it very easy to work with or against him!’”

Chambers Europe 2022 – France
(Intellectual Property: Patents)



Alexandre Rudoni

Partner

Tel +33 1 40 06 50 34

Mob +33 6 15 79 81 16

alexandre.rudoni@allenoverly.com

Alexandre is a Partner in the Intellectual Property and Litigation department of Allen & Overy Paris and the founder and leader of our Parisian Brands team. Alexandre is dedicated to trademark, design and copyright litigious and nonlitigious matters.

He advises companies in the hi-tech, media and entertainment industries.

Alexandre is also viewed as an authority in video gaming law and leads our 'Gaming, Interactive & Entertainment Group' at A&O which promotes our video gaming practice globally and works actively to serve clients in this sector. He assists some of the biggest names in the sector, including Nintendo, Epic Games (publisher of Fortnite, one of the most played games in the world), Valve (the "iTunes" for games), Electronic Arts (the publisher of FIFA games) and Riot Games (world leader in esports) and is regularly invited to speak at gaming conferences across the world.

"Alexandre Rudoni regularly represents high-profile clients in the technology and entertainment sectors in copyright and trade mark litigation matters. 'He always impresses me with his responsiveness and knowledge,' reports one source."

Chambers Europe 2022 – France
(Intellectual Property: Trade Marks & Copyright)

Awards

Ranked Band 1 for Intellectual Property in France

Chambers Global 2009-2022

Ranked in Tier 1 for Intellectual Property in France

Legal 500 EMEA 2009-2022

Ranked Tier 1 for Patent contentious

IP Stars – Rising Stars 2022 – France

Ranked Gold for Litigation

IAM Patent 1000 – France – The World's Leading Patent Professionals 2022

For more information, please contact:

Paris

Allen & Overy LLP
32 rue François 1^{er}
75008
Paris

Tel +33 1 40 06 54 00
Fax +33 1 40 06 54 54

Global presence

Allen & Overy is an international legal practice with approximately 5,800 people, including some 590 partners, working in more than 40 offices worldwide. A current list of Allen & Overy offices is available at www.allenoverly.com/global_coverage.

Allen & Overy means Allen & Overy LLP and/or its affiliated undertakings. Allen & Overy LLP is a limited liability partnership registered in England and Wales with registered number OC306763. Allen & Overy LLP is authorised and regulated by the Solicitors Regulation Authority of England and Wales.

The term partner is used to refer to a member of Allen & Overy LLP or an employee or consultant with equivalent standing and qualifications or an individual with equivalent status in one of Allen & Overy LLP's affiliated undertakings. A list of the members of Allen & Overy LLP and of the non-members who are designated as partners is open to inspection at our registered office at One Bishops Square, London E1 6AD.