



Global Legal Group

The International Comparative Legal Guide to: Patents 2011

A practical cross-border insight into patent work

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1 Patent Enforcement

1.1 How and before what tribunals can a patent be enforced against an infringer?

A patent can be enforced in a U.S. district court or, in some circumstances, at the U.S. International Trade Commission (ITC). Each State has one or more district courts. A district court action is initiated by filing a Complaint in a venue in which the court has personal jurisdiction over the defendant, i.e., in a district where the defendant resides or has sufficient contacts. The Complaint need only contain enough information to provide notice of the alleged infringement. In cases involving damages (which is true for almost all patent cases), either party can request that the case be tried before a jury.

A patent can also be enforced at the ITC when infringing products are being imported into the U.S. and a domestic industry exists for the patented product. An ITC Complaint must set forth detailed facts to support the patent owner's case (which would generally include, for example, detailed claim charts that establish infringement). If the ITC decides to investigate and determines that the imported products infringe, it can issue (i) an Exclusion Order that requires U.S. Customs to preclude entry of the infringing products and/or (ii) a Cease-and-Desist Order to prevent the sale of infringing products that have already been imported. Monetary damages cannot be recovered in an ITC action, and no jury is involved.

1.2 What are the pre-trial procedural stages and how long does it generally take for proceedings to reach trial from commencement?

While the precise stages may differ slightly from court to court, pre-trial stages in district court consist generally of (i) service of the Complaint, identifying the patent(s) at issue, (ii) service of an Answer, together with Affirmative Defences and/or Counterclaims, if applicable, (iii) a meeting between the parties (Rule 26(f) conference) to discuss procedures for conduct of the litigation, (iv) exchange of Initial Disclosures identifying potential witnesses, the type and location of relevant documents, and the basis of any alleged damages, (v) hearing of the Case Management Conference (CMC) before the assigned Judge, and entry thereafter of a Case Management Order providing directions and deadlines for further conduct of the litigation, including Trial and Pre-Trial Conference dates, (vi) fact discovery, including written Interrogatories, Document Requests, and/or Requests for Admission of particular facts, written responses thereto, and depositions of witnesses, (vii)

expert discovery on technical and damages issues (which may occur after or concurrent with fact discovery), including exchange of Expert Reports and depositions of Expert Witnesses, and (viii) submission of pretrial memoranda and, if required by the Judge, joint submission of a Pretrial Order summarising each party's position and identifying proposed trial exhibits and witnesses. Motions for Summary Judgment may be filed where there are no material facts in dispute and the Judge can resolve the issues as matters of law. Also, claim construction is a very important part of a patent infringement suit, and the district court Judge is required to construe the claims as a matter of law (even in a case that will be tried before a jury). Towards this end, many district courts have specialised claim construction proceedings which may include identification of disputed claim terms, exchange of proposed definitions, submission of claim construction briefs, a claim construction hearing before the Judge (a so-called *Markman* hearing), and issuance of a Claim Construction Order. The period from the commencement of proceedings until trial varies depending on complexity of the case and the Judge's caseload, but generally it is from 12 to 24 months.

1.3 Can a defence of patent invalidity be raised and if so how?

Yes. Invalidity may be raised as an affirmative defense and/or as a counterclaim requesting a declaration of invalidity.

1.4 How is the case on each side set out pre-trial? Is any technical evidence produced and if so how?

Speaking generally, each party submits a pretrial memorandum including a brief statement of the nature of the action and the basis for jurisdiction, a brief statement of the facts (the defendant's memorandum only contains counter-statements of fact necessary to reflect any disagreement with the plaintiff's statement), a list of any monetary damages claimed, a list of the names and addresses of all witnesses to be called, a schedule of all exhibits to be offered at trial, and an estimate of the number of days required for trial. If the Judge requires it, the parties must submit a joint Pretrial Order including (i) a statement as to the nature of the action and the basis for jurisdiction, (ii) a comprehensive list of all uncontested facts and the parties' respective statements about facts that are in dispute, (iii) a list of any damages claimed, including a detailed description of each item and statement of the amount claimed, (iv) a statement regarding each legal issue that must be decided and the authorities relied upon, (v) the names and addresses of all witnesses to be called at trial, including a brief statement of the evidence each

witness will provide and a detailed summary of the qualifications of each expert witness, (vi) a schedule of all exhibits to be offered into evidence, including a statement of those agreed to be admissible and the grounds for objection to any not so agreed upon, (vii) any special comments regarding the legal issues or amendments to the pleadings, (viii) an estimate of the number of trial days required, and (ix) a list of each discovery item (e.g., responses to interrogatories or requests for admission) or deposition to be offered into evidence. A Judge may request a technical tutorial, often just prior to a claim construction hearing.

1.5 How are arguments and evidence presented at the trial?

Each party makes an opening statement indicating the evidence he will present to support his case. Each party then presents witnesses for examination and cross-examination by the opponent, and evidentiary exhibits are entered into the record in connection with witnesses who can authenticate and/or testify about them. Patent trials almost always involve expert witnesses, who may testify about technical matters and damages matters, among others. The patent owner usually presents his case first. Each party then makes a closing argument summarising the testimony and evidence supporting his case.

1.6 How long does the trial generally last and how long is it before a judgment is made available?

Trial length varies depending on complexity and upon the particular district court, but most trials last one to two weeks. If the trial is before a jury, the jury will deliberate after the closing statements (for a period of several hours to several days) and then deliver its verdict. If the trial is before a Judge, the Judge may issue a verdict at the conclusion of trial, or he may issue it at a later date (in some cases, following post-trial briefing), the timing of which may vary according to the complexity of the issues.

1.7 Are there specialist judges or hearing officers and if so do they have a technical background?

There are no specialist Judges at the district court level, and thus patent cases are presided over by the same Judges who preside over general civil and criminal matters. A Judge may appoint a Special Master (typically a lawyer having a technical background and/or patent law expertise) to provide recommendations on complex issues. The Judge can also appoint a neutral technical expert. At the appellate level, the Court of Appeals for the Federal Circuit has exclusive jurisdiction over all appeals involving patents, whether the appeal is from a district court litigation, an ITC action, or the denial of a patent by the U.S.P.T.O.

1.8 What interest must a party have to bring (i) infringement (ii) revocation and (iii) declaratory proceedings?

- (i) The claimant must be the owner or co-owner of the patent or the exclusive licensee. If the claimant is a co-owner or exclusive licensee, the other co-owner(s) or the owner generally must be joined.
- (ii) There is no revocation proceeding, *per se*, but a third party can file a request for the U.S.P.T.O. to reexamine a patent when one or more printed publications raise a substantial new question regarding patentability. The third party need not demonstrate any particular commercial or business interest, and indeed depending upon the type of proceeding initiated, may remain anonymous.

- (iii) The claimant in an action for a declaratory judgment of invalidity must demonstrate that there is an actual controversy between the claimant and the patent owner of sufficient immediacy and reality to warrant jurisdiction by the court. For example, an actual controversy exists where a patent owner asserts rights with respect to a party's specific activity, and that party contends that it has the right to engage in the activity.

1.9 Can a party be compelled to provide disclosure of relevant documents or materials to its adversary and if so how?

Yes, speaking generally, each side in a U.S. patent infringement suit is entitled to take broad discovery from its adversary, including among other things through requesting paper and electronic documents and the taking of depositions. Typically such discovery is taken without the direct involvement of the court, but when the parties have a dispute as to the proper scope of discovery, a requesting party may file a motion to compel with a supporting brief explaining why the discovery is necessary and appropriate. The opposing party will generally file a brief in opposition, and the Judge will decide the merits of the motion (with or without a hearing) and, if appropriate, issue an Order requiring disclosure. Decisions involving discovery disputes are sometimes resolved by a Magistrate Judge, who assists the main Judge.

1.10 Can a party be liable for infringement as a secondary (as opposed to primary) infringer? Can a party infringe by supplying part of but not all of the infringing product or process?

Yes. A party can be liable for inducement of infringement if the party's actions induce others to commit infringing acts and the party knew or should have known that such actions would induce actual infringements. A party can be liable for contributory infringement if the party offers to sell, sells, or imports a component of a patented invention that constitutes a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of the patent, and the component is not a staple article or commodity of commerce suitable for substantial noninfringing use. However, no liability for indirect infringement can exist unless direct infringement is shown to exist as a result of the accused party's actions.

1.11 Does the scope of protection of a patent claim extend to non-literal equivalents?

Yes. Even if an accused product does not fall within the literal scope of a claim, infringement may be found under the Doctrine of Equivalents if the accused product or process involves only insubstantial differences from the claimed invention. The scope of infringing equivalents may be limited by, among other things, claim amendments and arguments made during prosecution of the patent application, as well as by the prior art.

1.12 Other than lack of novelty and inventive step, what are the grounds for invalidity of a patent?

Other grounds for invalidity include (i) insufficient disclosure (i.e., lack of enablement, adequate written description, and/or disclosure of the best mode of practicing the invention), (ii) claim indefiniteness, (iii) claiming non-patentable subject matter such as a natural phenomenon, a law of nature (including a mathematical

algorithm or formula not limited to a specific practical application) or an abstract idea, and (iv) errors in inventorship due to deceptive intent. In addition, a patent may be found to be unenforceable due to inequitable conduct before the U.S.P.T.O. (*see* question 1.14 below.)

1.13 Are infringement proceedings stayed pending resolution of validity in another court or the Patent Office?

A stay of proceedings is generally at the discretion of the district court Judge, upon motion by a party. However, when an *inter partes* reexamination is granted by the U.S.P.T.O., the patent owner can obtain a stay of related litigation unless the district court determines that a stay would not serve the interests of justice.

1.14 What other grounds of defence can be raised in addition to non-infringement or invalidity?

Some of the other most common grounds of defence include (1) licence – including a licence granted by a prior owner and an implied licence when a product purchased from a patent owner has no substantial use other than in a patented process, (2) laches - when the patent owner unreasonably delays the enforcement of his patent and the delay results in prejudice (either economic or evidentiary) to the defendant; laches is presumed if enforcement commences more than six years after the patent owner knew or reasonably should have known about the alleged infringement (laches is not a complete defence but instead precludes the patent owner from recovering damages for the period of delay), (3) estoppel - when the patent owner engages in misleading conduct, the defendant relies on the conduct, and the reliance results in prejudice to the defendant (estoppel is a complete defence), and (4) inequitable conduct – which renders a patent unenforceable when it is proved that the patent applicant withheld material information, or made affirmative false statements, with the intent to deceive the U.S.P.T.O. Although not a defence, damages can also be limited when the patent owner (or his licensee) sells products covered by a patent without marking them with the patent number.

1.15 Are (i) preliminary and (ii) final injunctions available and if so on what basis in each case?

Yes. To obtain a preliminary injunction, the patent owner must show (i) a reasonable likelihood of success on the merits (i.e., the patent is infringed and is not invalid or unenforceable), (ii) the patent owner will suffer irreparable harm without an injunction (i.e., harm will occur that cannot be remedied by monetary damages), (iii) the balance of hardships tips in favour of the patent owner, and (iv) the public interest favours grant of the injunction. For a permanent injunction, the patent owner must establish items (ii) – (iv) and also that there is no adequate legal remedy.

1.16 On what basis are damages or an account of profits estimated?

The patent owner can prove actual damages (e.g., lost sales due to the infringement) through financial records and testimony of fact and expert witnesses. In lieu of actual damages, the patent owner is entitled to no less than a reasonable royalty, which is generally viewed as the royalty that would have resulted from a hypothetical negotiation between a willing licensor and a willing licensee prior to the commencement of the infringement. Factors that may be considered include other licences for the patent, royalty rates paid

for licensing similar patents, the profitability of the patented product and its commercial success, the patent owner's policy towards licensing or maintaining exclusivity, and the term of the patent and the licence.

1.17 What other form of relief can be obtained for patent infringement?

If wilful infringement is found, the damages award can be increased up to three times the base amount. When a design patent has been infringed, the infringer can be required to disgorge his profits from the infringement.

1.18 Are declarations available and if so can they address (i) non-infringement and/or (ii) claim coverage over a technical standard or hypothetical activity?

- (i) Yes, provided an actual controversy exists.
- (ii) No, for purely hypothetical activity, since no actual controversy exists. With respect to a technical standard, only if the patent owner has asserted the patent with respect to the technical standard to create an actual controversy.

1.19 After what period is a claim for patent infringement time-barred?

Damages may not be recovered for infringement occurring more than six years before filing a Complaint (or a counterclaim in a declaratory judgment action).

1.20 Is there a right of appeal from a first instance judgment and if so is it a right to contest all aspects of the judgment?

There is a right of appeal from a district court judgment, and generally speaking all aspects of the judgment may be contested. Findings of fact are upheld so long as they are supported by substantial evidence in the record, but legal matters are reviewed *de novo*. An ITC decision can be appealed to the panel of ITC Commissioners, and from there to the Federal Circuit.

1.21 What are the typical costs of proceedings to first instance judgment on (i) infringement and (ii) validity; how much of such costs are recoverable from the losing party?

Infringement and validity are both contested in most litigations. A typical case may cost \$1,500,000 - \$2,000,000 through trial, but a complex case may cost several times that much. Each party must pay its own costs, including its own attorney fees. In exceptional cases, the prevailing party may recover costs and attorney fees from the opposing party. Examples of such situations might include egregious litigation misconduct, a lawsuit filed without a reasonable basis and a lawsuit based upon a patent obtained through fraud on the U.S.P.T.O.

2 Patent Amendment

2.1 Can a patent be amended *ex parte* after grant and if so how?

Non-substantive amendments can be made by filing an *ex parte* request for a Certificate of Correction in the U.S.P.T.O. Substantive

claim amendments can be made during an *ex parte* reexamination or reissue proceeding before the U.S.P.T.O. Reexamination may be granted if one or more printed publications raise a substantial new question of patentability regarding one or more claims, and narrowing amendments can be made to distinguish the claims from the prior art. Reissue can be requested if the patent owner asserts that the patent is inoperative or invalid because the applicant claimed more than or less than he was entitled to. Narrowing or broadening amendments can be made in a reissue, but a broadening reissue must be filed within two years of the patent grant and cannot recapture subject matter that was given up to obtain the patent.

2.2 Can a patent be amended in *inter partes* revocation proceedings?

Yes. In an *inter partes* reexamination proceeding before the U.S.P.T.O., when one or more printed publications have been raised a substantial new question of patentability, narrowing amendments can be made to distinguish over the new prior art.

2.3 Are there any constraints upon the amendments that may be made?

Broadening amendments are not permitted in a reexamination proceeding, or in a reissue proceeding requested more than two years after the patent grant.

2.4 Do reasons for amendment need to be provided and if so is there a duty of good faith?

No specific reasons must be stated. However, when requesting reissue the patent owner must specify the error in the original patent. There is a duty of candour and good faith in all proceedings before the U.S.P.T.O.

3 Licensing

3.1 Are there any laws which limit the terms upon which parties may agree a patent licence?

Patent licences are generally subject to a rule-of-reason analysis to determine whether (i) they impose a restraint that is likely to have anticompetitive effects and (ii) the restraint is not reasonably necessary to achieve pro-competitive benefits that outweigh those anti-competitive effects. Restraints that may be deemed impermissible include fixing the licensee's resale price, tying the grant of a licence under one patent to the licensee's purchase of a licence of another patent or purchase of an unpatented product, or precluding the licensee from licensing, selling, distributing, or using competing technologies.

3.2 Can a patent be the subject of a compulsory licence and if so how are the terms settled and how common is this type of licence?

Speaking generally, compulsory licences exist only with respect to use by the government, or for inventions developed with government funding. In addition, in some instances, especially when the subject matter of the patent relates to an industry standard, the patent owner or its predecessor may have obligated itself to grant licences under fair, reasonable and non-discriminatory terms.

4 Patent Term Extension

4.1 Can the term of a patent be extended and if so (i) on what grounds and (ii) for how long?

Yes. (i) Extensions are permitted due to prosecution delays in the U.S.P.T.O. and, for patents covering products subject to regulatory review (e.g., pharmaceuticals), for delays due to that review. (ii) The U.S.P.T.O. will automatically grant an extension based on the number of days by which certain U.S.P.T.O. tasks (e.g., time to perform initial examination) exceed a target period, minus the number of days of delay caused by the applicant (e.g., requesting an extension of time to file a response). The patentee must request an extension based on regulatory review, and the extension is based on the regulatory review period.

5 Patent Prosecution and Opposition

5.1 Are all types of subject matter patentable and if not what types are excluded?

No. A patent may not be obtained for a natural phenomenon, a law of nature (including a mathematical formula or algorithm) or an abstract idea.

5.2 Is there a duty to the Patent Office to disclose prejudicial prior disclosures or documents?

Yes. There is a duty to disclose all material information that is known to the inventor(s) or anyone substantively involved in the patent prosecution. Information is material if it is not cumulative to information already of record and (a) it establishes, by itself or in combination with other information, a *prima facie* case of unpatentability of a claim, or (b) it refutes or is inconsistent with a position the applicant takes in (i) opposing an argument of unpatentability relied on by the U.S.P.T.O. or (ii) asserting an argument of patentability.

5.3 May the grant of a patent by the Patent Office be opposed by a third party and if so when can this be done?

There is no opposition procedure, either prior to or after grant of a patent. However, a third party can request reexamination of an issued patent if one or more printed publications raise a substantial new question of patentability.

5.4 Is there a right of appeal from a decision of the Patent Office and if so to whom?

Yes. An appeal may be taken to the Court of Appeals for the Federal Circuit. Alternatively, an action may be initiated in the U.S. District Court for the District of Columbia.

5.5 How are disputes over entitlement to priority and ownership of the invention resolved?

Prior to grant, disputes over priority are resolved through an interference proceeding before the U.S.P.T.O. Board of Patent Appeals and Interferences, which is initiated when a Patent Examiner determines that two applications, or an application and a patent, claim the same invention. An applicant may copy claims from an issued patent to provoke an interference, provided the

copying is done within one year of the grant date and the application supports the copied claims. The applicant must advise the U.S.P.T.O. that claims have been copied.

Subsequent to the grant of a patent, the U.S.P.T.O. can correct an inventorship error that occurred without deceptive intent, upon application by all parties, or a court can order correction of inventorship.

5.6 What is the term of a patent?

20 years from the filing date. (For patents applied for before June 8, 1995, the term is the longer of (i) 17 years from the grant date or (ii) 20 years from the filing date.)

6 Border Control Measures

6.1 Is there any mechanism for seizing or preventing the importation of infringing products and if so how quickly are such measures resolved?

A patent owner can ask the International Trade Commission to issue an Exclusion Order, which requires Customs officials to preclude importation of infringing products. Such actions take about 12 months from initiation to a hearing, although there is the possibility to move for preliminary relief, if the conditions similar to those required to obtain a preliminary injunction from a district court can be established (*see* question 1.15 above). If a party, subject to an Exclusion Order, later attempts to import additional infringing products of the type subject to an Exclusion Order, the ITC may issue a Seizure Order to seize the infringing products.

7 Antitrust Law and Inequitable Conduct

7.1 Can antitrust law be deployed to prevent relief for patent infringement being granted?

Yes. Antitrust issues are usually put forth in counterclaims. Typically the defendant must prove (i) the patent owner is enforcing a patent obtained fraudulently (i.e., through inequitable conduct) to perpetuate a scheme to monopolise, (ii) the patent owner is enforcing a patent he knows is invalid (bad faith prosecution), or

(iii) the infringement lawsuit is objectively baseless and the patent owner's subjective motivation is to obstruct the business relationships of a competitor (sham litigation). The related issue of patent misuse can provide an affirmative defence where it can be shown that the patent owner has impermissibly broadened the physical or temporal scope of the patent with anticompetitive effect.

7.2 What limitations are put on patent licensing due to antitrust law?

See question 3.1 above.

8 Current Developments

8.1 What have been the significant developments in relation to patents in the last year?

The U.S. Supreme Court issued a decision overturning the "machine-or-transformation test" as the sole test for determining whether subject matter is patentable. The Court found that test to be a useful tool but not the sole test. The more fundamental issue is whether the claimed invention is directed to an abstract idea. The same decision rejected a categorical exclusion on the patentability of business methods, indicating that there may be some types of business methods that are patentable (but the Court at the same time held the particular business method that it was scrutinising to be unpatentable).

8.2 Are there any significant developments expected in the next year?

The Court of Appeals for the Federal Circuit is expected to issue an *en banc* decision concerning the standard for finding inequitable conduct that renders a patent unenforceable.

8.3 Are there any general practice or enforcement trends that have become apparent in the U.S. over the last year or so?

Cases are more likely to be transferred to a new venue when there is no real connection between the parties and the district where the Complaint is originally filed.

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