

Mathieu de Rooij

IAM says: “*Mathieu de Rooij is a highly sought-after technical adviser with extensive knowledge and experience, particularly in pan-European disputes. He considers all possible avenues to come to a solution, and has a keen ability to make prudent strategic decisions that ultimately benefit his clients’ commercial goals.*”

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Biography

Mathieu de Rooij heads the Barcelona office of BARDEHLE PAGENBERG, after a career as an EPO examiner and partner in private practice in Spain. His practice focuses on oppositions and appeals before the EPO, as well as patent drafting and patent prosecution in the fields of renewable energy, medical devices, metal forming and automotive technology. Mr de Rooij works in many technical areas including mechanical engineering, aerodynamics, electronics and electrical engineering.





You currently work as a partner heading the Barcelona office of BARDEHLE PAGENBERG after a career as an EPO examiner and almost a decade in private practice in Spain. What type of work have you found most rewarding and why?

Even though I enjoyed being an EPO examiner, I have found working in private practice to be much more diverse and rewarding. I have had the privilege and perhaps luck to be able to work for a variety of clients, both in terms of size and industry. I have seen start-ups blossom thanks to a sound IP strategy to which I contributed. My position has also allowed me to help SMEs in patent portfolio management and patent out-licensing programmes, and I have been given the chance to defend and assist multinationals in disputes with major competitors. I have found it most rewarding when going the extra mile has provided my clients with good outcomes in all these scenarios.

You regularly act as a technical expert on the validity and/or infringement of patents in Spanish court proceedings, and in disputes spanning multiple jurisdictions, as well as assisting clients in EPO opposition and appeal cases. What do you see as the biggest differences between these jurisdictions?

The courts and patent offices have different case law, timelines and procedures, but in my experience the most important differences between these jurisdictions stem from the legal and/or technical background of the courts. Of course, one has to have in-depth knowledge of the different case law, procedures and timelines in order to come up with a sound strategy. On top of that, I find it most important to know and adjust to the audience to which I am presenting. Judges and examiners have different personalities and do not always have technical expertise in the specific area in question, nor do they even have the time to study the case in as much depth as the parties and their attorneys. It is thus decisive to take all of these factors into account when deciding how to shape and present arguments. It requires a lot of hands-on experience.

When representing clients across a range of industries – including mechanical engineering, electrical engineering, medical devices, software, IT and computer technology, physics and automotive – how do you stay up to date on developments?

It is definitely challenging to keep up to date with the fast pace of development in different areas of technology. In my experience, it is indeed important to spend time keeping up, not only with legal developments but also with technological developments. I rely mostly on the knowledge of my clients and their engineers and always try to spend the necessary time with them to benefit from their knowledge. One of the beautiful things about being a patent attorney is that one gets an insight into new technological developments that are not yet available to everyone, and one learns on the job.

What will be the most significant trend shaping patent enforcement practices in the future?

We will soon see the birth of the UPC in Europe, the most significant change to the European patent landscape in several decades. It will be very interesting to see how patent owners try to use the UPC to their benefit. Of course, the national courts will continue to play an important role as well, and as of September 2022, far from all UPC signatory states have actually ratified the court. I expect that patent owners will adopt a tailored approach. For some cases, they will use national courts, for others the UPC, and for yet other cases, actions will be launched both in national courts and in the UPC. I also expect SEP patent litigation to be highly influenced by the UPC.

How have you seen the use of analytics and AI evolve and develop in your practice over the past five years?

There is now a variety of tools available specifically for patent searching and drafting, which are important in our everyday practice. In my opinion, for the time being, AI cannot replace the experience and expertise of highly trained experts on both these topics. However, the use of good tools to perform these tasks can create important value for our clients, in terms of both quality and time. And professionals in our sector are well advised to keep up to date with these developments.