

Dear []

I am attaching a copy of the draft Rules of Procedure for the Unified Patent Court ("UPC"). The Drafting Committee, of which I am a member, has been working on the draft Rules for some seven weeks and now wishes to give interested bodies an opportunity to make representations.

As stated in the introductory remarks this is not a complete or final draft but, in our view, sufficiently advanced to consult technical experts. A broad public consultation will follow.

We understand that the UPC may be signed or initialled by Contracting Member States at the end of June and therefore time is limited. We would therefore welcome comments by 23 April to allow the Committee time for consideration before its next meeting and for the public consultation.

At this stage we would most appreciate receiving written comments from representative organisations via one member to facilitate the work of the Committee.

For your assistance the latest public draft of the Agreement creating the UPC can be found at <http://register.consilium.europa.eu/pdf/en/11/st16/st16741.en11.pdf>

Comments should be sent to Kevin Mooney at kevin.mooney@simmons-simmons.com

Yours faithfully

Table of Contents – Overview

Preamble	12
Application and Interpretation of the Rules of Procedure	13
<u>Part 1</u> - Procedures before the Court of First Instance	15
Chapter 1 – Written Procedure	16
Section 1 – Infringement Action	16
Statement of Claim	17
Defendant raises Preliminary Objections	21
Value based Fee for the Infringement Action	23
Statement of Defence, Counterclaim	24
Reply to Defence and Counterclaim, Amending Claims	27
Rejoinder to the Request to Amend Claims	29
Request for Technical Judge	29
Last Steps in Written Procedure	31
Revocation-Counterclaim referred to Central Division	32
Case referred to Central Division	34
Section 2 – Revocation Action	35
Statement for Revocation	36
Defence to Revocation	38
Reply to Request to Amend Claims, Reply to Counterclaim	39
Section 3 – Action for Declaration of Non-Infringement	41
Section 4 – Actions re Art. 15a(4) and 15a(5)	44
Section 5 – Action on Compensation for Licenses of right	45
Section 7 – Actions against Decisions of the EPO	46
Chapter 2 – Interim Procedure	51
Interim Conference	53
Preparation for the Oral Hearing	52
Chapter 3 – Oral Procedure	55
Chapter 4 – Procedure for the Award of Damages and Compensation	60
Section 1 – Application for the Award of Damages	60

Section 2 – Request to Lay Open Books	64
Chapter 5 – Procedure for Cost Order	67
<u>Part 2 – Evidence</u>	69
Chapter 1 – Witnesses and Experts of the Parties	70
Chapter 2 – Courts Experts	74
Chapter 3 – Order to Produce Evidence and to Communicate Information	76
Order to Produce Evidence	76
Order to Communicate Information	77
Chapter 4 – Order to Preserve Evidence and Order for Inspection	78
Order to Preserve Evidence (<i>Saisie</i>)	78
Order for Inspection	85
Chapter 5 – Other Evidence	86
<u>Part 3 – Provisional Measures</u>	88
<u>Part 4 – Procedures before the Court of Appeal</u>	95
Chapter 1 – Written Procedure	97
Section 1 – Statement of Appeal, Statement of Grounds of Appeal	97
Section 2 – Statement of Response	102
Section 3 – Reply to a Statement of Cross-Appeal	103
Chapter 2 – Interim Procedure	104
Chapter 3 – Oral Procedure	105
Chapter 4 – Decisions and Effect of Decisions	105
Chapter 5 – Procedure for Cost Order	106
Chapter 6 – Procedure for Request for Rehearing	106
<u>Part 5 – General Provisions</u>	105
Chapter 1 – General Procedural Provisions	111
Chapter 2 – Service	114
Chapter 3 – Rights and Obligations of Representatives	117
Chapter 4 – Stay of Proceedings	122
Chapter 5 – Time Periods	123

Chapter 6 – Parties to the Proceedings	124
Section 1 – Plurality of Parties	124
Section 2 – Change in Parties	126
Section 3 – Death, Demise or Insolvency of a Party	127
Section 4 – Transfer of Patent	128
Section 5 – Intervention	128
Section 6 – Re-Establishment of Rights	132
Chapter 7 – Miscellaneous Provisions on Languages	133
Chapter 8 – Case Management	136
Chapter 9 – Rules Relating to the Organization of the Court	138
Chapter 10 – Decisions and Orders	141
Chapter 11 – Decision by Default	143
Chapter 12 – Actions Bound to Fail or Manifestly Inadmissible	144
Chapter 13 – Settlement	145
<u>Part 6</u> – Fees and Legal Aid	146
Court Fees	146
Legal Aid	147

Preliminary set of provisions for the Rules of procedure of the Unified Patent Court

Status

1. First draft dated 29 May 2009
 - discussed in expert meetings on 5 June and 19 June 2009
2. Second draft (Part 1, Chapter 1) dated 9 July 2009, Working paper from the Commission Services, Council working document 11813/09
 - discussed in Council Working Party on Intellectual Property (Patents) on 22 July 2009
3. Third draft dated 25 September 2009
 - discussed in expert meeting on 2 October 2009
4. Fourth draft dated 16 October 2009
 - discussed at the 5th European Patent Judges' Forum on 30 and 31 October 2009
5. Fifth draft dated 27 January 2012
 - discussed in expert meeting on 3 February 2012
6. Sixth draft dated 22 February 2012
 - discussed by the Drafting Committee on 25/26 February 2012
7. Seventh draft dated 20 March 2012
 - discussed by the Drafting Committee on 24/25 March 2012
8. Eighth draft dated 30 March 2012
 - For technical consultation

Introductory remarks

The present document contains a preliminary set of provisions for the Rules of Procedure of the Unified Patent Court (hereinafter "UPC" or "Court").

Basic principles of procedural law are already laid down in Part III of the draft Agreement on a UPC (hereinafter "draft Agreement"), for instance proportionality and fairness, case management, right to be heard, publicity, stages of the proceedings etc. The draft Agreement also contains general provisions on languages, parties, representation, means of evidence, experts, and defines the powers of the UPC to order provisional measures (in particular preliminary injunctions), to issue orders to preserve evidence (*saisie-contrefaçon*), corrective measures etc.

However, in several places in the draft Agreement, references are made to "Rules of Procedure" which shall spell out procedural details. This is a tried and tested legal technique: only the basic principles have been included in the draft Agreement, many procedural details being left for secondary legal instruments (rules of procedure, practice directions).

In accordance with Article 22(2) draft Agreement, the Rules of Procedure of the UPC shall be adopted by the Administrative Committee, on the basis of broad consultations with all stakeholders and following an opinion of the European Commission on the compatibility of the Rules of Procedure with Union law. Users of the patent system have however repeatedly requested that preparatory work on the Rules be started at an early stage, in order to enable a better assessment of the functioning of the future Court in practice.

It was envisaged that the Contracting Member States would, immediately after the signature of the Agreement, start the necessary preparations for the ratification of the Agreement to ensure its entry into force without delay. In parallel, the Contracting Member States would set up a Preparatory Committee in charge of preparing the practical arrangements for the early establishment and coming into operation of the Unified Patent Court. The Contracting Member States acknowledge the importance of appropriate Rules of Procedure for the Unified Patent Court and of their uniform application, which are vital to guarantee that the decisions of the Court are of the highest quality and that proceedings are organised in the most efficient and cost effective manner. However signature of the Agreement has been delayed pending agreement among the Contracting Member States on certain issues. This has in turn delayed the setting up of the Preparatory Committee. To avoid further delay in the work on the Rules of Procedure a small Drafting Committee of expert judges and lawyers was appointed to take this work forward.

The present document is not a final draft of the Rules of Procedure. Further work is required in a number of areas, including the procedures and rules for service and legal aid. However the Drafting Committee believes that the present draft is sufficiently advanced that input from industry and other stakeholders would be welcome at this stage.

The aim of the Drafting Committee remains to assist the Preparatory Committee, when appointed, to complete the draft Rules of Procedure within three months of the signature of the Agreement.

Input from stakeholders on the current draft would be welcomed by 23 April 2012 and should be addressed to the chair of the drafting committee at the following address:
kevin.mooney@simmons-simmons.com

Abbreviations & Main sources

EPC	European Patent Convention
EPLA RoP	"Annex I. Procedural law EPJ", prepared by Jan Willems, WPL/SUB 20/01, 27.8.2001
RoP CST	Rules of Procedure of the European Union Civil Service Tribunal
VR2	Second Venice Resolution, Principles relating to the Rules of Procedure of the European Patent Court, 4.11.2006
CJEU Statute	
CFI RoP	

Levels for the various procedural fees have not been included

References to persons in these Rules of procedure may apply to women as well as to men.

Table of contents

APPLICATION AND INTERPRETATION OF THE RULES OF PROCEDURE	12
Rule 1 – Application of the Rules of Procedure	12
Rule 2 – Power of staff of the Registry and a sub-registry to perform functions of the Registry	12
Rule 3 – Lodging of documents.....	12
Rule 4 – Service of orders, decisions and written pleadings	13
Rule 5 – Language of written pleadings and written evidence	13
Rule 6 – Party and party's representative	13
Rule 7 – Powers of the Court	13
PART 1 – PROCEDURES BEFORE THE COURT OF FIRST INSTANCE.....	14
Rule 8 – Stages of the proceedings (<i>inter partes</i> proceedings).....	14
Rule 9 – Settlement	14
CHAPTER 1 – WRITTEN PROCEDURE	15
SECTION 1 – INFRINGEMENT ACTION	15
Rule 10 – Exchange of written pleadings (infringement action).....	15
STATEMENT OF CLAIM.....	16
Rule 11 – Contents of the Statement of claim.....	16
Rule 12 – Language of the Statement of claim	17
Rule 13 – Fee for the infringement action	17
Rule 14 – Examination as to formal requirements of the Statement of claim.....	18
Rule 15 – Recording in the Register (Court of First Instance, infringement action)	18
Rule 16 – Designation of the judge-rapporteur.....	19
PROCEDURE WHEN THE DEFENDANT RAISES A PRELIMINARY OBJECTION	19
Rule 17 – Preliminary objection	19
Rule 18 – Decision or order on a Preliminary objection	20
Rule 19 – Appeal against decision or order on a Preliminary objection	20
VALUE-BASED FEE FOR THE INFRINGEMENT ACTION	21
Rule 20 – Value-based fee for the infringement action	21
Rule 21 – Lodging of the Statement of defence	22
Rule 22 – Contents of the Statement of defence	22
Rule 23 – Counterclaim for revocation.....	22
Rule 24 – Fee for the Counterclaim for revocation	24
Rule 25 – Examination as to formal requirements of the Statement of defence	24
Rule 26 – Further schedule	24
DEFENCE TO THE COUNTERCLAIM FOR REVOCATION AND REPLY TO THE STATEMENT OF THE DEFENCE AND APPLICATION TO AMEND THE CLAIMS.....	25
Rule 28 – Lodging of Defence to the Counterclaim for revocation and Reply to the Statement of defence	25
Rule 29 – Application to amend the claims	25
Rule 29A – Value - based fee for the dispute including the Counterclaim for revocation	27
1. The value of the dispute (including the Counterclaim for revocation) shall be determined by the judge-rapporteur (where the said value is assessed by one or both parties	

to exceed the value of the infringement action by more than €[] by way of an order at the interim conference.	27
2. Where the value of the dispute including the Counterclaim for revocation exceeds the value of the infringement action as agreed or ordered by the judge-rapporteur, the defendant shall pay a value-based fee for the excess in accordance with Part 6 [Rules 500, 2(b) and 501,3]......	27
REJOINDER TO THE APPLICATION TO AMEND THE CLAIMS.....	27
Rule 30 – Lodging of the Rejoinder to the Application to amend the claims and the Reply to the Rejoinder	27
APPLICATION FOR ALLOCATING A TECHNICALLY QUALIFIED JUDGE TO THE PANEL.....	27
Rule 31 – Application by a party for allocating a technically qualified judge	27
Rule 32 – Request by the judge-rapporteur for allocating a technically qualified judge	28
LAST STEPS IN THE WRITTEN PROCEDURE.....	29
Rule 33 – Closure of the written procedure.....	29
Rule 34 – Further exchanges of written pleadings.....	29
Rule 35 – Application of Article 15a(2) of the Agreement	30
COUNTERCLAIM FOR REVOCATION REFERRED TO THE CENTRAL DIVISION UNDER ARTICLE 15a(2)(b) OF THE AGREEMENT	31
Rule 36 – Written procedure when the central division deals with a Counterclaim for revocation.....	31
Rule 37 – Language of the proceedings before the central division	31
Rule 38 – Accelerated proceedings before the central division	32
CASE REFERRED TO THE CENTRAL DIVISION UNDER ARTICLE 15a(2)(c) OF THE AGREEMENT	32
Rule 39 – Written procedure when the central division deals with the case under Article 15a(2)(c) of the Agreement	32
SECTION 2 – REVOCATION ACTION	33
Rule 40 – Action to be directed against the patent proprietor	33
Rule 41 – Exchange of written pleadings (revocation action).....	33
STATEMENT FOR REVOCATION	34
Rule 42 – Contents of the Statement for revocation	34
Rule 43 – Language of the Statement for revocation.....	34
Rule 44 – Fee for the revocation action.....	35
Rule 45 – Recording in the Register (Court of First Instance, revocation action).....	35
DEFENCE TO REVOCATION	36
Rule 50 – Lodging of the Defence to revocation.....	36
Rule 51 – Contents of the Defence to revocation.....	36
Rule 51A – Reply to Defence to revocation	36
Rule 52 – Fee for the Counterclaim for infringement	36
REJOINDER TO THE APPLICATION TO AMEND THE CLAIMS AND DEFENCE TO THE COUNTERCLAIM FOR INFRINGEMENT	37
Rule 56 – Lodging of the Defence to the Counterclaim for infringement.....	37
SECTION 3 – ACTION FOR DECLARATION OF NON-INFRINGEMENT	38
Rule 60 – Declaration of non-infringement	38
Rule 61 – Exchange of written pleadings (action for declaration of non-infringement).....	38
Rule 62 – Contents of the Statement for a declaration of non-infringement	39
Rule 65 – Lodging of the Defence to the Statement for a declaration of non-infringement	39

Rule 66 – Contents of the Defence to the Statement for a declaration of non-infringement	39
Rule 66A – Reply to Defence to the Statement for a declaration of non-infringement and Defence to Counterclaim	40
Rule 67 – Fee for the action for a declaration of non-infringement.....	41
SECTION 5 – ACTION ON COMPENSATION FOR LICENCES ON THE BASIS OF ARTICLE 11 OF REGULATION ---/-- IMPLEMENTING ENHANCED COOPERATION IN THE AREA OF THE CREATION OF UNITARY PATENT PROTECTION	42
SECTION 6 – ACTION AGAINST DECISIONS OF THE EUROPEAN PATENT OFFICE IN CARRYING OUT THE TASKS REFERRED TO IN ARTICLE 12 OF REGULATION ---/-- IMPLEMENTING ENHANCED COOPERATION IN THE AREA OF THE CREATION OF UNITARY PATENT PROTECTION.....	43
Rule 90 – Stages of the proceedings (<i>ex parte</i> proceedings)	43
Rule 93 – Application to annul or alter a decision of the Office.....	44
Rule 94 – Examination as to formal requirements (<i>ex parte</i> proceedings).....	44
Rule 95 – Recording in the Register (<i>ex parte</i> proceedings) and assignment to panel	46
Rule 96 – Interlocutory revision by the European Patent Office	46
Rule 97 – Assignment to panel or to single judge, designation of judge-rapporteur.....	46
Rule 98 – Examination of the Application to annul or alter a decision of the Office	47
Rule 99 – Invitation to the President of the European Patent Office to comment.....	47
CHAPTER 2 – INTERIM PROCEDURE.....	48
Rule 101 – Role of the judge-rapporteur (Case management)	48
Rule 102 – Referral to the panel	48
Rule 103 – Preparation for the interim conference	48
INTERIM CONFERENCE	49
Rule 104 – Aim of the interim conference	49
Rule 105 – Telephone conference and video conference	49
Rule 106 – Recording of the interim conference	50
PREPARATION FOR THE ORAL HEARING.....	50
Rule 108 – Summons to the oral hearing.....	50
Rule 109 – Simultaneous interpretation during oral hearings	50
Rule 110 – Closure of the interim procedure	51
CHAPTER 3 – ORAL PROCEDURE	52
Rule 112 – Role of the presiding judge (Case management).....	52
Rule 113 – Conduct of the oral hearing	52
Rule 114 – Duration of the oral hearing	52
Rule 115 – Adjournment where the Court considers that further evidence is required.....	53
Rule 116 – The oral hearing.....	53
Rule 117 – Absence of a party from the oral hearing.....	53
Rule 118 – Decision on the merits.....	53
CHAPTER 4 – PROCEDURE FOR THE AWARD OF DAMAGES AND COMPENSATION	56
Rule 125 – Separate proceedings for determining the amount of damages ordered.....	56
Rule 126 – Start of proceedings for the award of damages.....	56
SECTION 1 – APPLICATION FOR THE DETERMINATION OF DAMAGES.....	56
Rule 131 – Contents of the Application for the determination of damages.....	56
Rule 132 – Examination as to formal requirements of the Application for the determination of damages	59

Rule 133 – Recording in the Register (Application for the determination of damages) and service.....	59
Rule 133A – Stay of the Application for a determination of damages.....	59
1. The Court may stay the Application for a determination of damages pending any appeal on the merits pursuant to Rule 370 on a reasoned request by the unsuccessful party. The applicant shall be given the opportunity to be heard. If the Court continues the proceedings on the Application it may order the applicant to render a security according to Rule 452..	59
Rule 134 – Reply of the unsuccessful party	59
Rule 135 – Contents of the Defence to the application for the determination of damages ...	60
Rule 135A – Reply to the Defence for the determination of damages.....	60
1. The applicant may within one month lodge a Reply to the Defence for the determination of damages limited to the matters raised in the Defence.....	60
Rule 136 – Further procedure (Application for the determination of damages).....	60
SECTION 2 – REQUEST TO LAY OPEN BOOKS	60
Rule 141 – Contents of the request to lay open books	60
Rule 142 – Defence of the unsuccessful party and Reply to Defence	61
Rule 143 – Decision on the Request to lay open books	61
CHAPTER 5 – PROCEDURE FOR COST ORDER.....	62
Rule 150 – Separate proceedings for cost order.....	62
Rule 151 – Start of proceedings for cost order.....	62
Rule 152 – Compensation for representation costs re decision on the merits.....	62
Rule 153 – Compensation for costs of experts.....	63
Rule 154 – Compensation for costs of witnesses	63
Rule 155 – Compensation for costs of interpreters and translators.....	63
Rule 170 – Means of evidence and means of obtaining evidence.....	64
Rule 171 – Offering of evidence.....	64
Rule 172 – Duty to produce evidence	64
CHAPTER 1 – WITNESSES AND EXPERTS OF THE PARTIES	65
Rule 175 – Written witness statement.....	65
Rule 176 – Application for the hearing of a witness in person	65
Rule 177 – Summoning of witnesses to the oral hearing	65
Rule 179 – Duties of witnesses.....	66
Rule 180 – Reimbursement of expenses of witnesses.....	67
Rule 181 – Experts of the parties.....	67
CHAPTER 2 – COURT EXPERTS	68
Rule 185 – Appointment of a court expert.....	68
Rule 186 – Duties of a court expert	69
Rule 187 –Expert report.....	69
Rule 188 – Hearing of a court expert	69
CHAPTER 3 – ORDER TO PRODUCE EVIDENCE AND TO COMMUNICATE INFORMATION.....	70
ORDER TO PRODUCE EVIDENCE	70
Rule 190 – Order to produce evidence.....	70
ORDER TO COMMUNICATE INFORMATION.....	71
Rule 191 – Application for order to communicate information	71
CHAPTER 4 - ORDER TO PRESERVE EVIDENCE (<i>SAISIE</i>) AND ORDER FOR INSPECTION.....	72

ORDER TO PRESERVE EVIDENCE (<i>Saisie</i>)	72
Rule 192 – Application for preserving evidence	72
Rule 193 – Examination as to formal requirements, recording in the Register, assignment to panel, designation of judge-rapporteur, single judge	73
Rule 194 – Examination of the Application for preserving evidence	74
Rule 195 – Oral hearing	75
Rule 196 – Decision on the Application for preserving evidence	76
Rule 197 – Order to preserve evidence without hearing the defendant	77
Rule 198 – Revocation of an order to preserve evidence	78
ORDER FOR INSPECTION	79
Rule 199 – Order for inspection	79
CHAPTER 5 – OTHER EVIDENCE	80
Rule 201 – Experiments ordered by the Court	80
Rule 202 – Letters rogatory	81
PART 3 – PROVISIONAL MEASURES	82
Rule 205 – Stages of the proceedings (summary proceedings)	82
Rule 206 – Application for provisional measures	82
Rule 207 – Protective letter	83
Rule 208 – Examination as to formal requirements, recording in the Register, assignment to panel, designation of judge-rapporteur, single judge	84
Rule 209 – Examination of the Application for provisional measures	85
Rule 210 – Oral hearing	86
Rule 211 – Decision on the Application for provisional measures	87
Rule 212 – Decision on provisional measures without hearing the defendant	88
Rule 214 – Revocation of provisional measures	88
Rule 251 – Appealable decisions	89
Rule 252 – Application for leave to appeal	89
Rule 253 – Subject-matter of the proceedings before the Court of Appeal	90
Rule 254 – Application for suspensive effect	90
CHAPTER 1 – WRITTEN PROCEDURE	91
SECTION 1 – STATEMENT OF APPEAL, STATEMENT OF GROUNDS OF APPEAL 91	
Rule 260 – Time periods for lodging the Statement of appeal and the Statement of grounds of appeal	91
Rule 261 – Contents of the Statement of appeal	91
Rule 262 – Contents of the Statement of grounds of appeal	92
Rule 263 – Language of the Statement of appeal and of the Statement of grounds of appeal	92
Rule 264 – Fee for the appeal	92
Rule 265 – Examination as to formal requirements of the Statement of appeal	93
Rule 266 – Recording in the Register (Court of Appeal)	93
Rule 267 – Designation of the judge-rapporteur	93
Rule 268 – Translation of file	94
Rule 269 – Preliminary examination of the Statement of grounds of appeal	94
Rule 270 – Challenge to the decision to reject an appeal as inadmissible	95
SECTION 2 – STATEMENT OF RESPONSE	95
Rule 280 – Statement of response	95
Rule 281 – Contents of the Statement of response	95

Rule 282 – Statement of cross-appeal.....	96
SECTION 3 – REPLY TO A STATEMENT OF CROSS-APPEAL	96
Rule 285 – Reply to a statement of cross-appeal.....	96
CHAPTER 2 – INTERIM PROCEDURE [TO BE SIMPLIFIED]	97
CHAPTER 3 – ORAL PROCEDURE [TO BE SIMPLIFIED]	97
CHAPTER 4 – DECISIONS AND EFFECT OF DECISIONS	98
Rule 290 – Decision of the Court of Appeal.....	98
Rule 291 – Referral back.....	98
CHAPTER 5 – PROCEDURE FOR COST ORDER.....	99
CHAPTER 6 – PROCEDURE FOR APPLICATION FOR REHEARING [COURT OF APPEAL ONLY OR FIRST INSTANCE AS WELL?]	99
Rule 295 – Lodging of an Application for rehearing	99
Rule 296 – Contents of the Application for rehearing	99
Rule 297 –Fundamental procedural defects	100
Rule 298 – Obligation to raise objections	100
Rule 299 – Definition of criminal offence	100
Rule 300 – Fee for the rehearing	100
Rule 301 – Suspensive effect.....	101
Rule 302 – Examination as to formal requirements of the Application for rehearing.....	101
Rule 303 – Assignment of Request for rehearing to a panel.....	101
Rule 304 – Examination of the Application for rehearing	102
PART 5 – GENERAL PROVISIONS	103
CHAPTER 1 – GENERAL PROCEDURAL PROVISIONS	103
Rule 340 – Examination by the Registry of its own motion	103
Rule 341 – Date of pleadings	103
Rule 342 – Public access to the Registry	103
Rule 343 – Leave to change claim or amend case	104
Rule 345 – Withdrawal.....	104
CHAPTER 2 – SERVICE [TO BE CONSIDERED SEPARATELY]	106
Rule 350 – Service of the Statement of claim	106
Rule 351 – Service of the Statement of claim by an alternative method or at an alternative place.....	107
Rule 352 – Notice of service and non-service of the Statement of claim	107
Rule 353 – Service of other pleadings	108
Rule 354 – Change of electronic address for service	108
CHAPTER 3 – RIGHTS AND OBLIGATIONS OF REPRESENTATIVES.....	109
Rule 359 – Powers of attorney	109
Rule 360 – Certificate that a representative is authorised to practice before the Court.....	109
Rule 361 – Attorney-client privilege.....	109
Rule 362 – Litigation privilege.....	111
Rule 363 – Privileges, immunities and facilities	111
Rule 364 – Powers of the Court as regards representatives.....	111
Rule 365 – Exclusion from the proceedings.....	112
Rule 366 – Patent attorneys' right of audience	112
Rule 367 – Change of a representative.....	112
CHAPTER 4 – STAY OF PROCEEDINGS	113
Rule 370 – Stay of proceedings	113

Rule 371 – Duration and effects of a stay of proceedings.....	113
Rule 372 – Resumption of proceedings	114
CHAPTER 5 – TIME PERIODS.....	114
Rule 380 – Calculation of periods.....	114
Rule 381 – Extension and shortening of periods	115
CHAPTER 6 – PARTIES TO PROCEEDINGS	115
SECTION 1 – PLURALITY OF PARTIES	115
Rule 390 – Plurality of plaintiffs or patents.....	115
Rule 391 – Plurality of defendants	116
Rule 392 – Court fees in case of plurality of parties	116
SECTION 2 – CHANGE IN PARTIES	117
Rule 395 – Change in parties	117
Rule 396 – Consequences for the proceedings.....	117
SECTION 3 – DEATH, DEMISE OR INSOLVENCY OF A PARTY.....	118
Rule 400 – Death or demise of a party	118
Rule 401 – Insolvency of a party.....	118
SECTION 4 – TRANSFER OF PATENT	119
Rule 402 – Transfer of the patent or patent application during proceedings	119
SECTION 5 – INTERVENTION	119
Rule 405 – Application to intervene	119
Rule 406 – Order on Application to intervene	120
Rule 407 – Statement in intervention	120
Rule 408 – Invitation to intervene	121
Rule 409 – No Appeal against an order on the Application to intervene.....	121
CHAPTER 7 – MISCELLANEOUS PROVISIONS ON LANGUAGES.....	123
Rule 421 – Request by both parties to use of the language in which the patent was granted as language of the proceedings.....	123
Rule 423 – Request by one party to use the language in which the patent was granted as language of the proceedings	124
Rule 424 – Consequences where the language of the proceedings is changed in the course of the proceedings.....	124
CHAPTER 8 – CASE MANAGEMENT (Measures of organisation of procedure)	125
Rule 431 – Responsibility for case management	125
Rule 432 – General principles of case management	125
Rule 433 – Review of case management orders.....	126
Rule 434 – Case management powers	126
Rule 435 – Varying or revoking orders.....	126
Rule 436 – Exercise of managing powers.....	127
Rule 437 – Orders of the Court's own motion.....	127
Rule 439 – Orders made without hearing the parties.....	127
Rule 440 – Connection — Joinder	127
CHAPTER 9 – RULES RELATING TO THE ORGANISATION OF THE COURT.....	127
Rule 441 – Precedence	127
Rule 442 – Dates, times and place of the sittings of the Court.....	128
Rule 443 – Order in which cases are to be dealt with.....	128
Rule 444 – Deliberations.....	129
CHAPTER 10 – DECISIONS AND ORDERS.....	130

Rule 450 – Decisions.....	130
Rule 451 – Orders	130
Rule 452 – Binding effect.....	131
Rule 453 – Rectification of decisions	131
Rule 454 – List of experts	131
CHAPTER 11 – DECISION BY DEFAULT	132
Rule 455 – Decision by default (Court of First Instance).....	132
Rule 456 – *Application to set aside a decision by default.....	132
Rule 457 – Decision by default (Court of Appeal)	133
CHAPTER 12 – ACTIONS BOUND TO FAIL OR MANIFESTLY INADMISSIBLE.....	133
Rule 460 – No need to adjudicate	133
Rule 461 – Action manifestly bound to fail.....	133
Rule 462 – Orders dismissing manifestly inadmissible claims.....	133
CHAPTER 13 – SETTLEMENT	134
Rule 470 – Confirmation by the Court of a settlement.....	134
PART 6 – FEES AND LEGAL AID.....	135
COURT FEES	135
Rule 500 – Court fees.....	135
Rule 501 – Time periods for paying court fees.....	136
Rule 502 – Reimbursement of court fees	136
LEGAL AID.....	136
Rule 505 – Right to legal aid [TO BE CONSIDERED SEPARATELY].....	136
Rule 506 – Extent	136
Rule 507 – Application and procedure.....	137
Rule 508 – Revocation of legal aid.....	137
Rule 509 – Appeal	137
Rule 510 – Liquidation of the costs of the proceedings	137
Rule 511 – Reimbursement of legal aid.....	137

PREAMBLE

The Court shall conduct proceedings in accordance with the Agreement on a Unified Patent Court (“the Agreement”) and these Rules of Procedure. In the event of a conflict between the provisions of the Agreement and those of the Rules of Procedure, the provisions of the Agreement shall prevail.

The Rules of Procedure shall be applied and interpreted in accordance with Articles 22(3), 23(1) and (2) and 32(1) of the Agreement on the basis of the principles of proportionality, flexibility, fairness and equity.

Proportionality shall be ensured by giving due consideration to the nature and complexity of each case [and its importance to the parties].

Flexibility shall be ensured by applying all procedural rules in a flexible and balanced manner with the required level of discretion for the judges to organize the proceedings in the most efficient and cost effective manner.

Fairness and Equity shall be ensured by having regard to the legitimate interests of all parties.

In accordance with these principles, the Court shall apply and interpret the Rules of Procedure in a way which will ensure decisions of the highest quality.

In accordance with these principles, proceedings shall be conducted in a way which will normally allow the final oral hearing on the issues of infringement and validity at first instance to take place within one year whilst recognising that complex cases may require more time and procedural steps and simple cases less time and less procedural steps. Decisions on costs and damages shall take place as soon as practicable thereafter. Case management shall be organised in accordance with these objectives. Parties shall cooperate with the Court and set out their full case as early as possible in the proceedings.

The Court shall endeavour to ensure consistent application and interpretation of these Rules of Procedure by all first instance divisions and the Court of Appeal. Due consideration shall be given to this objective in any decision concerning leave to appeal against procedural orders.

Practice Directions shall lay down further details of the proceedings before the Court. They may not contradict or alter the provisions of the Agreement, the Statute or these Rules of Procedure.

APPLICATION AND INTERPRETATION OF THE RULES OF PROCEDURE

Rule 1 – Application of the Rules of Procedure

1. The Court shall conduct proceedings in accordance with the Agreement on a Unified Patent Court (“the Agreement”) and these Rules of Procedure. In the event of a conflict between the provisions of the Agreement and those of the Rules of Procedure, the provisions of the Agreement shall prevail.

2. Where these Rules provide for the Court to perform any act other than an act exclusively reserved for a panel of the Court, the President of the Court of First Instance or the President of the Court of Appeal, that act may be performed by

- (a) the presiding judge or the judge-rapporteur of the panel to which the case has been assigned,
- (b) a single legally qualified judge where the case has been assigned to a single judge.
- (c) a single judge who has been designated the standing judge pursuant to Rule 194.4.

Relation with draft Agreement: Article 6(7)

Relation with draft Statute: Article 14(3)

Rule 1A – Supplementary Protection Certificate

1. Subject to Rule 1A.2 in these Rules the expression “patent” and “proprietor” shall whenever appropriate include, respectively, a supplementary protection certificate as defined in Article 2(9) of the Agreement and granted in respect of the patent and the proprietor of such certificate.

2. References in these Rules to the language in which the patent was granted shall mean that language and not the language in which a supplementary certificate in respect of the patent was granted.

Rule 2 – Power of staff of the Registry and a sub-registry to perform functions of the Registry

Where these Rules refer to the Registry and provide for the Registry to perform any act that reference shall include the relevant sub-registry and that act may be performed by a member of staff of the Registry or relevant sub-registry.

Rule 3 – Lodging of documents

Written pleadings and other documents shall be lodged at the Registry in electronic form, in accordance with the Practice Directions. Parties shall make use of the official forms available online.

Relation with draft Agreement: Article 25

[In Practice Directions: definition of pleading, details on readable format]

Rule 4 – Service of orders, decisions and written pleadings

The Registry shall serve, in accordance with Part 5, Chapter 2,

- (a) orders and decisions of the Court on the parties,
- (b) written pleadings and other documents of a party on the other party.

Where applicable, the Registry shall inform the parties of the opportunity to reply or to take any other appropriate step in the proceedings and of any time period for so doing.

Rule 5 – Language of written pleadings and written evidence

Written pleadings and other documents shall be lodged in the language of the proceedings, unless the Court or these Rules otherwise provide.

Rule 6 – Party and party's representative

For the purpose of all proceedings in relation to a patent, where a party has nominated a representative and these Rules provide that a party perform any act or that any act be performed upon a party that act shall be performed by or upon the representative for the time being of the party, unless otherwise provided [Rule93.4].

Relation with draft Agreement: Article 28

Rule 7 – Powers of the Court

1. The Court may, at any stage of the proceedings, of its own motion or on reasoned request by a party, order a party to take any step, answer any question or provide any clarification or evidence, within time periods to be specified.
2. The Court may disregard any step, fact, evidence or argument which a party has not submitted in due time.

PART 1 – PROCEDURES BEFORE THE COURT OF FIRST INSTANCE

Rule 8 – Stages of the proceedings (*inter partes* proceedings)

Proceedings before the Court of First Instance shall consist of the following stages:

- (a) a written procedure;
- (b) an interim procedure, which may include an interim conference with the parties;
- (c) an oral procedure, which shall include an oral hearing of the parties and where necessary;
- (d) a procedure for the award of damages;
- (e) procedures for cost orders.

[unless otherwise provided, see Rule 90]

Relation with draft Agreement: Articles 32(1), 41 and 42

Rule 9 – Settlement

1. At any stage of the proceedings, if the Court is of the opinion that the dispute is suitable for a settlement, it may propose that the parties make use of the facilities of the Patent Mediation and Arbitration centre in order to settle or to explore a settlement of the dispute.
2. At the request of the parties and pursuant Rule 470 the Court may by order confirm the terms of any settlement, including a term which obliges the patent owner to limit, surrender or agree to the revocation of a patent or not to assert it against the other party and/or third parties. A patent may not be confirmed valid by way of settlement.
3. No opinion expressed, suggestion made, proposal put forward, concession made or document drawn up for the purposes of settlement may be relied on as evidence by the Court or the parties in proceedings before the Court or any other court.

Relation with draft Agreement: Articles 17(3) and 52

CHAPTER 1 – WRITTEN PROCEDURE

SECTION 1 – INFRINGEMENT ACTION

Rule 10 – Exchange of written pleadings (infringement action)

1. The written procedure shall consist of
 - (a) the lodging of a Statement of claim (by the plaintiff) [Rule 11]
 - (b) the lodging of a Statement of defence (by the defendant) [Rules 21-22] and
 - (c) the lodging of a Reply to defence (by the plaintiff) [Rule 28].
2. The Statement of defence may include a Counterclaim for revocation [Rule 23.1].
3. If a Counterclaim for revocation is lodged, the plaintiff shall lodge a Defence to the counterclaim for revocation [Rule 28] and the defendant may lodge a Reply to the Defence to the Counterclaim [Rule 51.A]. The Defence to the Counterclaim may include an Application to amend the patent [Rule 29].
4. If an Application to amend the patent is lodged, the defendant shall lodge a Rejoinder to the Application to amend the patent [Rule 30].
5. The judge-rapporteur may allow the exchange of further written pleadings, within time periods to be specified [Rule 34].

STATEMENT OF CLAIM

Rule 11 – Contents of the Statement of claim

The plaintiff shall lodge a *Statement of claim with the division chosen by him (Art. 15a of the Agreement) which shall contain

- (a) the names of the plaintiff and of the plaintiff's representative,
- (b) the name of the party against whom the Statement is made (the defendant),
- (c) postal and electronic addresses for service on the plaintiff and the names of the persons authorised to accept service,
- (d) postal and, where available, electronic addresses for service on the defendant and the names of the persons authorised to accept service,
- (di) where the plaintiff is not the proprietor of the patent (or patents) concerned, postal and where available, electronic addresses for service on each proprietor and the names of the persons authorised to accept service, if known, [Article 27(2) and (4) of the Agreement]
- (e) details of the patent (or patents) concerned, including the number (or numbers)
- (f) where applicable, information about any prior or pending proceedings relating to the patent (or patents) concerned before the Court including any action for revocation or a declaration of non-infringement pending before the central division and the date of any such action, the European Patent Office or any other court or authority,
- (g) an indication of the division which shall hear the case [Article 15a(1) or (6) of the Agreement] with an explanation of why that division has competence; where the parties have agreed in accordance with Article 15a(6) of the Agreement, the indication of the division which shall hear the case shall be accompanied by evidence of the defendant's agreement,
- (h) where applicable, an indication that the case shall be heard by a single judge [Article 6(7) of the Agreement], accompanied by evidence of the defendant's agreement,
- (i) the nature of the claim, the order or the remedy sought by the plaintiff,
- (j) an indication of the facts relied on, in particular
 - (i) one or more instances of alleged infringements specifying the date and place of each,
 - (ii) the identification of the patent claims alleged to be infringed,
- (k) the evidence relied on [Rule 170.1], where available [Rule 175], and an indication of any further evidence which will be offered in support,
- (l) the reasons why the facts relied on constitute infringements of the patent claims, including arguments of law and where appropriate an explanation of the proposed claim interpretation,
- (m) an indication of any order the plaintiff will seek at the interim conference [Rule 104(e)]
- (n) where the plaintiff assesses that the value of the infringement action exceeds EUR 1 000 000, an indication of the value.

** For all written pleadings, parties will have to make use of forms available on-line (see Rule 3). Where a Rule lists the contents of pleadings, the sign * recalls that a form will be available to guide parties.*

Rule 12 – Language of the Statement of claim

1. The Statement of claim shall be drawn up
 - (a) in one of the languages of the regional division or local division
 - (i) which the plaintiff has chosen in accordance with Article 15a of the Agreement or
 - (ii) which the parties have agreed to bring the action before in accordance with Article 15a(6) of the Agreement, or
 - (b) in the language in which the patent was granted
 - (i) where the central division shall hear the case in accordance with Article 15a(1) or (6) of the Agreement or
 - (ii) where a Request to use the language in which the patent was granted as language of the proceedings is lodged in accordance with Rules 421 or 423 together with the Statement of claim.

2. The language in which the Statement of claim is drawn up shall be the language of the proceedings, without prejudice to Article 29(3), (4) or (4a) of the Agreement or Rules 18.2 or 421, 422 or 423.

3. The plaintiff may lodge a translation of the Statement of claim in an official language of the State where the defendant has his residence, or principal place of business or, in the absence of residence or principal place of business, place of business and request that the translation be served on the defendant.

Relation with draft Agreement: Article 29

Rule 13 – Fee for the infringement action

1. The plaintiff shall pay the fixed fee for the infringement action [**EUR], in accordance with Part 6.
2. The Statement of claim shall not be deemed to have been lodged until the fixed fee for the infringement action has been paid, unless otherwise provided [Rule 501].

Relation with draft Agreement: Articles 18(3), 43 and 44

*** An tentative level for the various fees is included for illustrative purposes only, without prejudice to the future decision of the Administrative Committee relating to fees under Article 18(3) of the Agreement. See also the examples in Council Document 17120/1/11 REV 1 of 17.11.2011, page 4.*

Rule 14 – Examination as to formal requirements of the Statement of claim

1. The Registry shall as soon as practicable check whether one or more of the patents concerned is the subject of an opt-out pursuant to Article 58(3) of the Agreement. In the event of an opt-out the Registry shall as soon as practicable inform the plaintiff who shall withdraw or amend the Statement of claim as appropriate.
2. In the event that the patent(s) concerned are not the subject of an opt-out the Registry shall, as soon as practicable after the lodging of the Statement of claim, examine whether the requirements of Rules 11(a) to (h), 12 and 13.1 have been complied with.
3. If the plaintiff has not complied with the requirements referred to in paragraph 2, the Registry shall as soon as practicable invite the plaintiff to:
 - (a) correct the deficiencies within 14 days; and
 - (b) where applicable, pay the fee for the infringement action within 14 days.
4. The Registry shall at the same time inform the plaintiff that if the plaintiff fails to correct the deficiencies within the time stated a decision by default may be given, in accordance with Rule 455.
5. If the plaintiff fails to correct the deficiencies or pay the fee the Registry shall inform a judge of the division who may reject the action as inadmissible by a decision by default. He may give the plaintiff an opportunity to be heard beforehand.
6. The plaintiff may make an application to set aside the decision by default in accordance with Rule 456.

Rule 15 – Recording in the Register (Court of First Instance, infringement action)

1. If the requirements referred to in Rule 14.2 have been complied with, the Registry shall as soon as practicable,
 - (a) record the date of receipt of the Statement of claim and attribute a case number to the file,
 - (b) record the file in the Register,
 - (c) inform the plaintiff of the case number of the file and the date of receipt,
2. The President of the Court of First Instance or such judge of a division to whom the President has delegated this task shall assign the case to a panel. Unless otherwise agreed by the panel the most senior judge shall be the presiding judge.
3. The action shall be regarded as pending before the Court as from the date of receipt attributed to the Statement of claim.

Relation with draft Agreement: Articles 8 and 15a

Rule 16 – Designation of the judge-rapporteur

The presiding judge of the panel to which the case has been assigned [Rule 15.2] shall designate one judge of the panel as judge-rapporteur. The presiding judge may designate himself as judge-rapporteur. The Registry shall as soon as practicable notify the plaintiff and defendant of the identity of the judge-rapporteur.

PROCEDURE WHEN THE DEFENDANT RAISES A PRELIMINARY OBJECTION

Rule 17 – Preliminary objection

1. Within one month of service of the Statement of claim, the defendant may lodge a Preliminary objection concerning

- (a) the jurisdiction and competence of the Court,
- (b) the competence of the division indicated by the plaintiff [Rule 11(g)],
- (c) the language of the Statement of claim [Rule 12].

2. A *Preliminary objection shall contain

- (a) particulars in accordance with Rule 22(a) to (c),
- (b) the decision or order sought by the defendant,
- (c) the grounds upon which the Preliminary objection is based,
- (d) where appropriate the facts and evidence relied on.

3. The Preliminary objection shall be drawn up

- (a) in the language of the proceedings [Rule 12.2] or
- (b) in an official language of the Contracting Member State where the defendant has his residence, or principal place of business, or in the absence of residence or principal place of business, place of business.

4. The Registry shall as soon as practicable invite the plaintiff to comment on the Preliminary objection. Where applicable, the plaintiff may of his own motion correct any deficiency [Rule 17.1(b) or (c)], within 14 days of service of notification of the Preliminary objection.

Alternatively the plaintiff may submit written comments within the same period. The judge-rapporteur shall be informed of any correction made or written comments submitted by the plaintiff.

5. The period for lodging the Statement of defence [Rule 21.1] shall not be affected by the lodging of a Preliminary objection, unless the judge-rapporteur decides otherwise.

** An on-line form will be available to guide parties.*

Rule 18 – Decision or order on a Preliminary objection

1. As soon as practicable after the expiry of the period referred to in Rule 17.4, the judge-rapporteur shall decide the Preliminary objection. The judge-rapporteur may give the parties an opportunity to be heard. The decision shall include instructions to the parties and to the Registry concerning the next step in the proceedings.
2. Where the Preliminary objection is to be dealt with in the main proceedings, the judge rapporteur shall inform the parties.

Rule 19 – Appeal against decision or order on a Preliminary objection

1. An appeal against a decision or order under Rule 18 may only be lodged with the permission of the judge-rapporteur or, if permission is refused, with permission of the Court of Appeal. The appeal shall be dealt with as an urgent matter by the Court of Appeal.
2. If an appeal is lodged, proceedings at first instance may be stayed by the judge-rapporteur or the Court of Appeal on a reasoned request by a party.
3. Rule 17.5 shall apply *mutatis mutandis*.

VALUE-BASED FEE FOR THE INFRINGEMENT ACTION

Rule 20 – Value-based fee for the infringement action

1. The value of the infringement action shall be determined by the judge-rapporteur where the value of the dispute is assessed by one or both parties as exceeding EUR [] by way of order at the interim conference.

2. Where the value of the infringement action exceeds EUR [], the plaintiff shall pay a value-based fee for the infringement action, in accordance with Part 6 [Rules 500.2(b) and 501.3].

STATEMENT OF DEFENCE

Rule 21 – Lodging of the Statement of defence

The defendant shall lodge a Statement of defence within three months of service of the Statement of claim. The period may be extended by the judge-rapporteur on a reasoned request by the defendant.

Rule 22 – Contents of the Statement of defence

The *Statement of defence shall contain

- (a) the names of the defendant and of the defendant's representative,
- (b) postal and electronic addresses for service on the defendant and the names of the persons authorised to accept service,
- (c) the case number of the file,
- (d) an indication whether the defendant has lodged a Preliminary objection [Rule 17],
- (e) an indication of the facts relied on, including any challenge to the facts relied on by the plaintiff,
- (f) the evidence relied on [Rule 170.1], where available [Rule 175], and an indication of any further evidence which will be offered in support,
- (g) the reasons why the action shall fail, arguments of law including any assertion that the patent (or patents) concerned is (are) invalid and any argument arising from the provisions of Article 14i of the Agreement and where appropriate any challenge to the plaintiff's proposed claim interpretation.
- (h) an indication of any order the defendant will seek in respect of the infringement action during the interim procedure [Rule 104(e)].
- (i) a statement whether the defendant disputes the plaintiff's assessment of the value of the infringement action and the grounds for such dispute

Rule 23 – Counterclaim for revocation

1. If the Statement of defence includes an assertion that the patent (or patents) alleged to be infringed is (are) invalid the Statement of defence shall include a *Counterclaim for revocation of the patent or patents. The Counterclaim for revocation shall contain:

- (a) an indication of the extent to which revocation of the patent or patents is requested,
- (b) one or more grounds for revocation, which may be supported by arguments of law,
- (c) an indication of the facts relied on,
- (d) the evidence relied on, where available, and an indication of any further evidence which will be offered in support,
- (e) an indication of any order the defendant will seek in respect of the revocation action at the interim conference [Rule 104(e)].
- (f) Where the defendant assesses that the value of the dispute including the Counterclaim exceeds the value of the infringement action by more than EUR [] an assessment of the value of the dispute including the Counterclaim.

The defendant shall state his position, if any, on the options provided for in Article 15a(2)(a), (b) or (c) of the Agreement.

** An on-line will be available to guide parties.*

Rule 24 – Fee for the Counterclaim for revocation

The defendant shall pay the fee for the Counterclaim for revocation [**EUR], in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

Rule 25 – Examination as to formal requirements of the Statement of defence

1. The Registry shall, as soon as practicable after the lodging of the Statement of defence:

- (a) examine whether the requirements of Rule 22(a) to (d) have been complied with
- (b) if the Statement of defence includes a Counterclaim for revocation, examine whether the requirements of Rules 23(a) and (b) and the obligation to pay the fee pursuant to Rule 24 have been complied with.
- (c) if the patentee is not a party to the infringement action serve the Counterclaim for revocation on the patentee in accordance with Rule 11(d)(i).

2. If the Registry considers that the Statement of defence or the Counterclaim for revocation does not comply with any of the requirements referred to in paragraph 1, it shall as soon as practicable invite the defendant to

- (a) correct the deficiencies noted, within 14 days,
- (b) where applicable, pay the fee for the Counterclaim for revocation, within 14 days.

3. The Registry shall at the same time inform the defendant that if the defendant fails to correct the deficiencies or pay the fee within the time stated a decision by default may be given, in accordance with Rule 455.

4. If the defendant fails to correct the deficiencies or to pay the fee for the Counterclaim for revocation, as appropriate, within 14 days, the Registry shall inform the judge-rapporteur who may give a decision by default. He may give the defendant an opportunity to be heard beforehand.

5. The defendant may make an application to set aside the decision by default in accordance with Rule 456.

Rule 26 – Further schedule

As soon as practicable after service of the Statement of defence, the judge-rapporteur shall, after consulting the parties set a date and time for an interim conference (where necessary, Rule 101) and set a date, and one alternative date, for the oral hearing.

*** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.*

DEFENCE TO THE COUNTERCLAIM FOR REVOCATION AND REPLY TO THE STATEMENT OF THE DEFENCE AND APPLICATION TO AMEND THE CLAIMS

Rule 28 – Lodging of Defence to the Counterclaim for revocation and Reply to the Statement of defence

1.(a) Within two months of service of a Statement of defence which includes a Counterclaim for revocation, the plaintiff shall lodge a Defence to the Counterclaim for revocation and may lodge a Reply to the Statement of defence.

(b) Within one month of service of a Statement of defence which does not include a Counterclaim for revocation, the plaintiff may lodge a Reply to the Statement of defence.

(c) The above periods may be extended by the judge-rapporteur on a reasoned request by the plaintiff.

2. The Defence to the Counterclaim for revocation shall contain

(a) an indication of the facts relied on, including any challenge to the facts relied on by the defendant,

(b) the evidence relied on [Rule 170.1], where available [Rule 175], and an indication of any further evidence which will be offered in support,

(c) the reasons why the counterclaim for revocation shall fail, including arguments of law and any argument as to why any sub-claim of the patent (or patents) is independently valid.,

(d) an indication of any order the plaintiff will seek in respect of the revocation action at the interim conference [Rule 104(e)],

(e) the plaintiff's response to the defendant's choice of option, if any, provided for in Article 15a (2)(a), (b) or (c) of the Agreement.

(f) the plaintiff's response to the defendant's assessment of the value of the disputes (including the Counterclaim) pursuant to Rule 23(f).

3. The Reply to the Statement of defence shall be limited to a response to the matters raised in the Statement of Defence in accordance with Rule 22(e) to (i)

Rule 29 – Application to amend the claims

1. The Defence to the Counterclaim for revocation may include a *an Application to amend the claims and/or the specification which shall contain

(a) the proposed amendments of the claims of the patent (or patents) concerned and/or specification, including where appropriate one or more alternative sets of claims (auxiliary requests), in the language in which the patent was granted. Where the language of the proceedings [Rule 12.2] is not the language in which the patent was granted, the plaintiff shall lodge a translation of the proposed amendments in the language of the proceedings,

(b) an explanation as to why the amendments satisfy the requirement of Articles 84 and 123(2) and (3) EPC and why the proposed amended claims are valid.

(c) an indication whether the proposals are conditional or unconditional; the proposed amendments, if conditional, must be reasonable in number in the circumstances of the case.

2. Any subsequent request to amend the claims may only be submitted with the permission of the Court.

** An on-line form will be available to guide parties.*

Rule 29A – Value - based fee for the dispute including the Counterclaim for revocation¹

1. The value of the dispute (including the Counterclaim for revocation) shall be determined by the judge-rapporteur (where the said value is assessed by one or both parties to exceed the value of the infringement action by more than €[]) by way of an order at the interim conference.
2. Where the value of the dispute including the Counterclaim for revocation exceeds the value of the infringement action as agreed or ordered by the judge-rapporteur, the defendant shall pay a value-based fee for the excess in accordance with Part 6 [Rules 500, 2(b) and 501,3].

REJOINDER TO THE APPLICATION TO AMEND THE CLAIMS

Rule 30 – Lodging of the Rejoinder to the Application to amend the claims and the Reply to the Rejoinder

1. Within one month of service of an Application to amend the claims, the defendant shall lodge a *Rejoinder to the Application to amend the claims setting out whether he opposes the Application to amend the claims and, if so, why
 - (a) the proposed amendments are not allowable and
 - (b) the patent cannot be maintained as requested.The period may be extended by the judge-rapporteur on a reasoned request by the defendant.
2. Where appropriate in view of the proposed amendments, the Rejoinder to the Application to amend the claims may contain submissions in accordance with Rule 42(d) to (h).
3. The plaintiff may lodge a Reply to the Rejoinder to the Application to amend the claims within one month. The Reply shall be limited to the matters raised in the Rejoinder.

APPLICATION FOR ALLOCATING A TECHNICALLY QUALIFIED JUDGE TO THE PANEL

Rule 31 – Application by a party for allocating a technically qualified judge

1. Any party to the proceedings may lodge a *an Application for allocating a technically qualified judge to the panel which shall contain an indication of the relevant field of technology.
2. The Application shall be lodged as early as possible in the written procedure. An Application lodged after the closure of the written procedure [Rule 33] shall only be granted if justified in view of changed circumstances, such as new submissions presented by the other party and allowed by the Court.

¹ The drafting committee would welcome views on whether a defendant in an infringement action should pay a value-based fee for a counterclaim in addition to a fixed fee. It is intended that a value-based fee should be paid for an independent revocation action (Rule 57).

CHANGE THE AGREEMENT SO THAT THIS IS DISCRETIONARY.

3. If the requirements of paragraphs 1 and 2 have been complied with, the President of the Court of First Instance shall allocate a technically qualified judge to the panel, after consulting the judge-rapporteur.

Rule 32 – Request by the judge-rapporteur for allocating a technically qualified judge

1. The judge-rapporteur may at any time during the written procedure, after consulting the presiding judge and the parties, request the President of the Court of First Instance to allocate a technically qualified judge to the panel.

2. Where a technically qualified judge is allocated to the panel, the judge-rapporteur may at any time consult the technically qualified judge.

** An on-line form will be available to guide parties.*

LAST STEPS IN THE WRITTEN PROCEDURE

Rule 33 – Closure of the written procedure

Following the exchange of written pleadings in accordance with Rule 10.1 and, where applicable, in accordance with Rule 10.2 to .4, the judge-rapporteur shall

- (a) inform the parties of the date on which he intends to close the written procedure, without prejudice to Rule 34,
- (b) where an interim conference is necessary (Rules 26, 101), confirm the date and the time set for the interim conference [Rule 26.1(a)] or inform the parties that an interim conference will not be held.

Rule 34 – Further exchanges of written pleadings

Without prejudice to the powers of the judge-rapporteur pursuant to Rule 107(2), on a reasoned request by a party lodged before the date on which the judge-rapporteur intends to close the written procedure [Rule 33(a)], the judge-rapporteur may allow the exchange of further written pleadings, within a period to be specified. Where the exchange of further written pleadings is allowed, the written procedure shall be deemed closed upon expiry of the specified period.

Rule 35 – Application of Article 15a(2) of the Agreement

1. As soon as practicable after the closure of the written procedure the panel shall decide by way of order how to proceed, with respect to the application of Article 15a(2) of the Agreement.
2. Where the panel decides to proceed in accordance with Article 15a(2)(a) of the Agreement, the judge-rapporteur shall request the President of the Court of First Instance to allocate to the panel a technically qualified judge if not already allocated pursuant to Rule 31.
3. Where the panel decides to proceed in accordance with Article 15a(2)(b) of the Agreement, the judge-rapporteur shall give consideration to suspending the infringement proceedings where the defendant has demonstrated that there is a high likelihood that the relevant claims of the patent (or patents) will be held to be invalid by the final decision in the revocation procedure.

**COUNTERCLAIM FOR REVOCATION REFERRED TO THE CENTRAL DIVISION UNDER
ARTICLE 15a(2)(b) OF THE AGREEMENT**

Rule 36 – Written procedure when the central division deals with a Counterclaim for revocation

When a Counterclaim for revocation is referred to the central division, it shall be dealt with as follows:

- (a) Rule 15.2 shall apply *mutatis mutandis*: the President of the Court of First Instance shall assign the Counterclaim for revocation to a panel of the central division. The parties may request that the Counterclaim be heard by a single judge;
- (b) Rule 16 shall apply *mutatis mutandis*: the presiding judge of the panel to which the Counterclaim for revocation has been assigned shall designate one judge of the panel as judge-rapporteur;
- (c) Rule 26.1 shall apply *mutatis mutandis*: the judge-rapporteur shall after consulting the parties set a date and a time for the interim conference (where necessary, Rules 26, 101) and set a date, and one alternative date, for the oral hearing.;

Rule 37 – Language of the proceedings before the central division

1. Where the language of the proceedings before the regional division or the local division which referred the Counterclaim for revocation to the central division is not the language in which the patent was granted, the judge-rapporteur may order that the parties lodge, within a period of 21 days, a translation in the language in which the patent was granted of any written pleadings and such other documents lodged during the written procedure as the judge-rapporteur may direct. The period may be extended by the judge-rapporteur on a reasoned request by a party.
2. Where appropriate, the judge-rapporteur may specify in his order that only excerpts of parties' written pleadings and other documents shall be translated.
3. Where the language of the proceedings before the regional division or the local division is the language in which the patent was granted the pleadings served in accordance with Rules 22, 23, 28, 29 and 30 shall stand.

Rule 38 – Accelerated proceedings before the central division

The judge-rapporteur shall endeavour to accelerate proceedings before the central division where

- (a) an Application for provisional measures has been lodged [Rule 206],
- (b) the regional division or the local division has referred the counterclaim for revocation to the central division.

[In Practice Directions: options for reducing the timetable in case of accelerated proceedings]

CASE REFERRED TO THE CENTRAL DIVISION UNDER ARTICLE 15a(2)(c) OF THE AGREEMENT

Rule 39 – Written procedure when the central division deals with the case under Article 15a(2)(c) of the Agreement

When a case is referred to the central division under Article 15a(2)(c) of the Agreement, it shall be dealt with as follows:

- (a) Rule 15.2 shall apply *mutatis mutandis*: the President of the Court of First Instance shall assign the case to a panel of the central division. The parties may request that the case be heard by a single judge;
- (b) Rule 16 shall apply *mutatis mutandis*: the presiding judge of the panel to which the case has been assigned shall designate one judge of the panel as judge-rapporteur;
- (c) dates already set under Rule 26.1 shall be confirmed wherever possible;
- (d) Rule 37 shall apply *mutatis mutandis*: the judge-rapporteur may order that the parties lodge a translation in the language in which the patent was granted of any written pleadings lodged during the written procedure; where appropriate, the judge-rapporteur may specify in his order that only excerpts of parties' written pleadings and other documents shall be translated. Otherwise the pleadings lodged during the written procedure shall stand.

SECTION 2 – REVOCATION ACTION

Rule 40 – Action to be directed against the patent proprietor

Any action for the revocation of a patent has to be directed against the proprietor of the patent.

Relation with draft Agreement: Article 27(5)

Rule 41 – Exchange of written pleadings (revocation action)

1. The written procedure shall consist of
 - (a) the lodging of a Statement for revocation (by the plaintiff) [Rule 42] and
 - (b) the lodging of a Defence to revocation (by the defendant) [Rule 50].
 - (c) the lodging of a Reply to the Defence to revocation by the plaintiff [Rule 51.A]

2. The Defence to revocation may include
 - (a) an Application to amend the claims and
 - (b) a Counterclaim for infringement by the proprietor of the patent or by an exclusive licensee of the proprietor..

3. If an Application to amend the claims is lodged, the plaintiff shall lodge a Rejoinder to the application to amend the claims.

4. If a Counterclaim for infringement is lodged, the plaintiff shall lodge a Defence to the Counterclaim for infringement [Rule 56] and the defendant may lodge a Reply to the Defence to the Counterclaim [Rule 56.3].

5. Rule 10.5 shall apply.

STATEMENT FOR REVOCATION

Rule 42 – Contents of the Statement for revocation

The plaintiff shall lodge a *Statement for revocation at the Registry which shall contain

- (a) particulars in accordance with Rule 11(a) to (f),
- (b) where the parties have agreed to bring the action before a regional division or a local division in accordance with Article 15a(6) of the Agreement, an indication of the division which shall hear the case, accompanied by evidence of the defendant's agreement,
- (c) where applicable, an indication that the case shall be heard by a single judge [Article 6(7) of the Agreement], accompanied by evidence of the defendant's agreement,
- (d) an indication of the extent to which revocation of the patent (or patents) is requested,
- (e) one or more grounds for revocation, which may be supported by arguments of law,
- (f) an indication of the facts relied on,
- (g) the evidence relied on, where available, and an indication of any further evidence which will be offered in support.
- (h) an indication of any order the plaintiff will seek during the interim procedure [Rule 104(e)].
- (i) where the plaintiff assesses that the value of the revocation action exceeds EUR 1,000,000, an indication of the value

Rule 43 – Language of the Statement for revocation

1. Subject to Rule 43.2 the Statement for revocation shall be drawn up in the language in which the patent was granted.
2. Where the parties have agreed to bring the action before a regional division or a local division in accordance with Article 15a(6) of the Agreement, the Statement for revocation shall be drawn up in one of the languages referred to in Rule 12.1(a)(ii) or (b)(ii).
3. Rule 12.2 and .3 shall apply *mutatis mutandis*.

Relation with draft Agreement: Article 29

** An on-line form will be available to guide parties.*

Rule 44 – Fee for the revocation action

The plaintiff shall pay the fee for the revocation action [**EUR], in accordance with Rule 57.2 and Part 6. Rule 13.2. shall apply *mutatis mutandis*.

Relation with draft Agreement: Articles 43, 44

Rule 14 on Examination as to formal requirements of the Statement of claim shall apply *mutatis mutandis*

Rule 45 – Recording in the Register (Court of First Instance, revocation action)

1. Rule 15.1(a) to (c) and .2 shall apply *mutatis mutandis*.

2. The President of the Court of First Instance shall assign the case

(a) to a panel of the central division,

(b) where the parties have agreed that a single judge should hear the case, to a single judge or

(b) where the parties have agreed to bring the action before a local division or a regional division in accordance with Article 15a(6) of the Agreement, to a panel of the regional division or the local division concerned.

Relation with draft Agreement: Articles 8 and 15a

Rule 16 on Designation of judge-rapporteur shall apply
Rules 17, 18 and 19 on Procedure when the defendant raises a Preliminary objection shall apply *mutatis mutandis*

DEFENCE TO REVOCATION

Rule 50 – Lodging of the Defence to revocation

1. The defendant shall lodge a Defence to revocation within three months of service of the Statement for revocation. The period may be extended by the judge-rapporteur on a reasoned request by the defendant.
2. The Defence to revocation may include
 - (a) an Application to amend the claims,
 - (b) a Counterclaim for infringement.

Rule 51 – Contents of the Defence to revocation

1. The *Defence to revocation shall contain the matters referred to in Rule 22(a) to (b) and a statement whether the defendant disputes the plaintiff's assessment of the value of the counterclaim and the grounds for such dispute.
2. Any Application to amend the claims shall contain the matters referred to in Rule 29.1(a) to (c). Rule 29.2 shall apply.
3. Any Counterclaim for infringement shall contain the matters referred to in Rule 11(i) to (n) and where the defendant assesses that the value of the dispute including the Counterclaim for infringement exceeds the value of the revocation action by more than EUR [] an assessment of the value of the dispute including the Counterclaim.

Rule 51A – Reply to Defence to revocation

1. The plaintiff may lodge a Reply to the Defence to revocation within one month. The Reply shall be limited to a response to the matters raised in the Defence to revocation.

Rule 52 – Fee for the Counterclaim for infringement

The defendant shall pay the fee for the Counterclaim for infringement [**EUR], in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

Rule 25 on Examination as to formal requirements of the Statement of defence shall apply *mutatis mutandis*

Rule 26 on Further schedule shall apply *mutatis mutandis*

* An on-line form will be available to guide parties.

** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.

REJOINDER TO THE APPLICATION TO AMEND THE CLAIMS AND DEFENCE TO THE COUNTERCLAIM FOR INFRINGEMENT

Rule 30 on Lodging of the Rejoinder to the Application to amend the claims shall apply *mutatis mutandis*

Rule 56 – Lodging of the Defence to the Counterclaim for infringement

1. Within one month of service of a Counterclaim for infringement, the plaintiff may lodge a Defence to the Counterclaim for infringement. The period may be extended by the judge-rapporteur on a reasoned request by the plaintiff.
2. The Defence to the Counterclaim shall contain the matters referred to in Rule 22(e) to (h) and the plaintiff's response to the defendant's assessment of the value of the dispute (including the Counterclaim) pursuant to Rule 51.3.
3. The defendant shall lodge a Reply to the Defence to the Counterclaim for infringement within one month. The Reply shall be limited to a response to the matters raised in the Defence to the Counterclaim for infringement.

Rules 31 and 32 on Request for allocating a technically qualified judge shall apply where the revocation action is heard by a regional division or a local division
Rule 33 on Closure of the written procedure shall apply *mutatis mutandis*
Rule 34 on Further exchanges of written pleadings shall apply

Rule 57 – Value-based fee for the revocation action

1. The value of the revocation action shall be determined by the judge-rapporteur (where the value of the dispute is assessed by one or both parties as exceeding EUR []) by way of an order at the interim conference.
2. Where the value of the revocation action exceeds EUR [] the plaintiff shall pay a value-based fee for the revocation action in accordance with Part 6 [Rules 500.2(b) and 201.3].

Rule 58 – Value-based fee for the dispute (including the Counterclaim for infringement)

1. The value of the dispute including the Counterclaim for infringement shall be determined by the judge-rapporteur where the said value is assessed by one or both parties to exceed the value of the revocation action by more than EUR [] by way of an order at the interim conference.
2. Where the value of the dispute including the Counterclaim for infringement exceeds the value of the revocation action as agreed or ordered by the judge-rapporteur, the defendant shall pay a value-based fee for the excess in accordance with Part 6 [Rules 500, 2(b) and 501, 3].

SECTION 3 – ACTION FOR DECLARATION OF NON-INFRINGEMENT

Rule 60 – Declaration of non-infringement

A declaration that the performance of a specific act does not, or a proposed act would not, constitute an infringement of a patent may be made by the Court in proceedings between the person doing or proposing to do the act and the patent proprietor, if the patent proprietor has asserted that the act is an infringement, or, if no such assertion has been made by the patent proprietor, if

- (a) that person has applied in writing to the proprietor for a written acknowledgment to the effect of the declaration claimed, and has provided him with full particulars in writing of the act in question and
- (b) the proprietor has refused or failed to give any such acknowledgment within one month.

Rule 61 – Exchange of written pleadings (action for declaration of non-infringement)

1. The written procedure shall consist of

- (a) the lodging of a Statement for a declaration of non-infringement (by the plaintiff) [Rule 62],
- (b) the lodging of a Defence to the Statement for a declaration of non-infringement (by the defendant) [Rules 65-66].
- (c) the lodging of a Reply to the Defence to the Statement for a declaration of non-infringement [Rule 66A].

2. The Defence to the Statement for a declaration of non-infringement may include a Counterclaim for infringement [Rule 66.2].

3. If a Counterclaim for infringement is lodged, the plaintiff shall lodge a Defence to the Counterclaim for infringement [Rule 66A].

4. Rule 10.5 shall apply.

Rule 62 – Contents of the Statement for a declaration of non-infringement

1. The plaintiff shall lodge at the Registry a *Statement for a declaration of non-infringement which shall contain

- (a) particulars in accordance with Rule 11(a) to (f),
- (b) where the parties have agreed to bring the action before a regional division or a local division in accordance with Article 15a(6) of the Agreement, an indication of the division which shall hear the case, accompanied by evidence of the defendant's agreement,
- (c) where applicable, an indication that the case shall be heard by a single judge [Article 6(7) of the Agreement], accompanied by evidence of the defendant's agreement,
- (d) the declaration sought by the plaintiff,
- (e) the reasons why the performance of a specific act does not, or a proposed act would not, constitute an infringement of the patent or patents concerned, including arguments of law including any argument arising from the provisions of Article 14(i) of the Agreement,
- (f) an indication of the facts relied on,
- (g) the evidence relied on, where available, and an indication of any further evidence which will be offered in support.
- (h) an indication of any order the plaintiff will seek at the interim conference [Rule 104(e)]
- (i) where the plaintiff assesses that the value of the declaratory action exceeds EUR 1,000,000, an indication of the value.

Rules 43, 44 and 45 relating to the Statement for revocation shall apply *mutatis mutandis*
Rule 14 on Examination as to formal requirements of the Statement of claim shall apply *mutatis mutandis*

Rules 17, 18 and 19 on Procedure when the defendant raises a Preliminary objection shall apply *mutatis mutandis*

Rule 65 – Lodging of the Defence to the Statement for a declaration of non-infringement

The defendant shall lodge a Defence to the Statement for a declaration of non-infringement within two months of service of the Statement for a declaration of non-infringement. The period may be extended by the judge-rapporteur on a reasoned request by the defendant.

Rule 66 – Contents of the Defence to the Statement for a declaration of non-infringement

1. The Defence to the Statement for a declaration of non-infringement shall contain the matters referred to in Rule 22(a) to (h) and a statement whether the defendant disputes the plaintiff's assessment of the value of the declaratory action and the grounds for such dispute.

2. Where the Defence to the declaration of non-infringement includes a Counterclaim for infringement, it shall contain submissions in accordance with Rule 11(i) to (m).

Rule 66A – Reply to Defence to the Statement for a declaration of non-infringement and Defence to Counterclaim

1. The plaintiff may lodge a Reply to the Defence to the Statement for a declaration of non-infringement and shall lodge a Defence to Counterclaim within one month. The Reply to the Defence shall be limited to a response to the matters raised in the Defence to the Statement for a declaration of non-infringement and the Counterclaim.

** An on-line form will be available to guide parties.*

Rule 67 – Fee for the action for a declaration of non-infringement

The plaintiff shall pay the fee for the action for a declaration of non-infringement [**EUR], in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

Rule 25 on Examination as to formal requirements of the Statement of defence shall apply *mutatis mutandis*

Rule 26 on Further schedule shall apply *mutatis mutandis*

Rules 31 and 32 on Request for allocating a technically qualified judge shall apply where the action is heard by a regional division or a local division

Rule 33 on Closure of the written procedure shall apply *mutatis mutandis*

Rule 34 on Further exchanges of written pleadings shall apply

Rule 68 – Value-based fee for the action for a declaration of non-infringement

1. The value of the action for a declaration of non-infringement shall be determined by the judge-rapporteur where the value of the dispute is assessed by one or both parties as exceeding EUR [] by way of an order at the interim conference.

2. Where the value of the dispute exceeds EUR [] the plaintiff shall pay a value-based fee for the action for a declaration of non-infringement in accordance with Part 6 [Rules 500.2(b) and 501.3].

SECTION 4 – ACTIONS WITHIN ARTICLE 15a(4) AND ARTICLE 15a(5)

Rule 69 – Revocation actions and subsequent infringement actions in a local or regional division (Article 15(a)(4) of the Agreement).

1. Where a plaintiff has lodged a Statement for revocation (Rule 42) before the central division and the defendant subsequently initiates an infringement action in a local or regional division action against the plaintiff in respect of the same patent (or patents) the following procedures shall apply.

2. The Registry shall proceed in accordance with Rules 14 and 15. The Registry shall as soon as practicable notify the President of the Court of First Instance of the co-pending actions.

3. Unless otherwise agreed by the parties the President of the Court of First Instance shall require the panel appointed in the central division to hear the revocation action pursuant to Rule 45.2 to stay all further proceedings pending a decision of the panel hearing the action for infringement pursuant to Article 15a(2) of the Agreement and Rule 35.

Rule 70 – Actions for declarations of non-infringement within Article 15(a)(5)

1. Where a Plaintiff has lodged an action for declaration of non-infringement (Rule 62) before the central division against the patent proprietor or an exclusive licensee of the patent proprietor and the defendant or licensee subsequently initiates an action for infringement in a local or regional division against the plaintiff in respect of the same patent or patents the following procedure shall apply.

2. The Registry shall proceed in accordance with Rule 14 and 15. The Registry shall as soon as practicable notify the President of the Court of First Instance of the co-pending actions and the dates attributed to them.

3. If the date attributed by the Registry to the action for infringement pursuant to Rule 15.1(a) is within three months of the date attributed to the action for declaration of non-infringement the President of the Court of First Instance shall require the panel of the central division to stay all further proceedings in the action for a declaration. If the date attributed by the Registry for infringement pursuant to Rule 15.1(a) is outside the said three months the President of the Court of First Instance shall inform the presiding judge of the panel to which the infringement action has been assigned, or, if the infringement action has not yet been assigned to a panel, inform a judge of the division before which the infringement action has been initiated. The infringement action shall be rejected as inadmissible.

SECTION 5 – ACTION ON COMPENSATION FOR LICENCES ON THE BASIS OF ARTICLE 11 OF REGULATION ---/-- IMPLEMENTING ENHANCED COOPERATION IN THE AREA OF THE CREATION OF UNITARY PATENT PROTECTION

Rule 80 – Compensation for a licence of right

1. The application for appropriate compensation (Article 15(1)(f)) shall contain:
 - (a) Particulars in accordance with Rule 11 (a) to (d)
 - (b) Information on the filing of the statement as referred to in Article 11(1) of the Regulation.
 - (c) The licence agreement referred to in Article 11(2) of the Regulation.
2. Rules 132 to 136 apply mutatis mutandis to the procedure for appropriate compensation.

Relation with draft Agreement: Article 15(1)(f)

[to be developed]

*** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.*

**SECTION 6 – ACTION AGAINST DECISIONS OF THE EUROPEAN PATENT OFFICE
IN CARRYING OUT THE TASKS REFERRED TO IN ARTICLE 12 OF REGULATION
---/-- IMPLEMENTING ENHANCED COOPERATION IN THE AREA OF THE
CREATION OF UNITARY PATENT PROTECTION**

Relation with draft Agreement: Articles 15(1)(g), 27(7) and 38b

Rule 90 – Stages of the proceedings (*ex parte* proceedings)

Where an action is brought against a decision of the European Patent Office in carrying out the tasks referred to in Article 12 of Regulation ---/-- implementing enhanced cooperation in the area of the creation of unitary patent protection (hereinafter "decision of the Office"), proceedings before the Court of First Instance shall consist of

- (a) a written procedure, which shall include a possibility for interlocutory review by the European Patent Office;
- (b) an interim procedure, which may include an interim conference;
- (c) on request by the plaintiff, an oral hearing.

Rule 91 – Suspensive effect

An action against a decision of the Office shall have suspensive effect.

Rule 92 – Grounds for annulling or altering a decision of the Office

An action against a decision of the Office may be brought on grounds of

- (a) infringement of Regulation ---/-- implementing enhanced cooperation in the area of the creation of unitary patent protection or of Regulation ---/-- implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements, or of any rule of law relating to their application,
- (b) infringement of the implementing rules of the European Patent Office for carrying out the tasks referred to in Article 12(1) of Regulation ---/--,
- (c) infringement of an essential procedural requirement,
- (d) misuse of power.

[Article 65 CTMR]

Rule 93 – Application to annul or alter a decision of the Office

1. The plaintiff shall lodge an Application to annul or alter a decision of the Office in the language in which the patent was granted, within two months of service of the decision of the Office.

2. The *Application to annul or alter a decision of the Office shall contain

- (a) the names of the plaintiff and, where applicable, of the plaintiff's representative;
- (b) where the plaintiff is not the proprietor of the European patent or the European patent with unitary effect, evidence that he is adversely affected by the decision of the Office and entitled to start proceedings [Article 27(7) of the Agreement];
- (c) postal and electronic addresses for service on the plaintiff and the names of the persons authorised to accept service;
- (d) a reference to the contested decision of the Office;
- (e) where applicable, information about any prior or pending proceedings relating to the patent concerned before the Court, the European Patent Office or any other court or authority;
- (f) an indication whether the case shall be heard by a single judge;
- (g) the order or the remedy sought by the plaintiff;
- (h) one or more grounds for annulling or altering the contested decision, in accordance with Rule 92;
- (i) the facts, evidence and arguments relied on.

3. The plaintiff shall pay the fee for the action against a decision of the Office, in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

4. Rule 6 shall not apply.

Relation with draft Agreement: Articles 28(6) and 29(5)

Rule 94 – Examination as to formal requirements (*ex parte* proceedings)

1. The Registry shall, as soon as practicable after an Application to annul or alter a decision of the Office has been lodged, examine whether the requirements of Articles 27(7) and 29(5) of the Agreement and Rule 93.1, 2(a) to (d) and 3 have been complied with.

2. If the Registry considers that any of the requirements referred to in paragraph 1 has not been complied with, it shall invite the plaintiff to

- (a) correct the deficiencies noted, within 14 days,
- (b) where applicable, pay the fee for the action against a decision of the Office, within 14 days.

3. The Registry shall at the same time inform the plaintiff that if the plaintiff fails to correct the deficiencies within the time stated a decision by default may be given in accordance with Rule 455.

4. If the plaintiff fails to correct the deficiencies noted or to pay the fee for the action against a decision of the Office, the Registry shall inform the President of the Court of First Instance who may reject the action as inadmissible by a decision by default. He may give the plaintiff an opportunity to be heard beforehand.

5. The plaintiff may make an application to set aside the decision by default in accordance with Rule 456.

Rule 95 – Recording in the Register (*ex parte* proceedings) and assignment to panel

If the requirements referred to in Rule 94.1 have been complied with, the Registry shall as soon as practicable

- (a) record the date of receipt of the Application to annul or alter a decision of the Office and attribute a case number to the file,
- (b) record the file in the Register,
- (c) inform the plaintiff of the case number of the file and the date of receipt and
- (d) forward the Application to the European Patent Office, with an indicating that the Application is admissible.

Rule 96 – Interlocutory revision by the European Patent Office

1. If the European Patent Office considers that the Application to annul or alter a decision of the Office is well founded, it shall within [one] month of the date of receipt of the Application

- (a) rectify the contested decision in accordance with the order or remedy sought by the plaintiff [Rule 93.2(g)] and
- (b) inform the Court that the decision has been rectified.

2. Where the Court is informed by the European Patent Office that the contested decision has been rectified, it shall inform the plaintiff that the case is closed. It may order full or partial reimbursement of the fee for the action against a decision of the Office, in accordance with Part 6.

Rule 97 – Assignment to panel or to single judge, designation of judge-rapporteur

Where the case is not closed in accordance with Rule 96.2, the President of the Court of First Instance shall, as soon as practicable after the expiry of the period referred to in Rule 96.1, assign the case to a panel of the central division in accordance with Rule 15.2 or to a single judge. Rule 16 shall apply.

Rule 98 – Examination of the Application to annul or alter a decision of the Office

1. In the examination of the Application to annul or alter a decision of the Office, the judge-rapporteur may, invite the plaintiff to lodge further written pleadings, within a time period to be specified.
2. Where appropriate, the judge-rapporteur may, after consulting the plaintiff, set a date and time for an interim conference.
3. Rule 33 shall apply *mutatis mutandis*.

Rule 99 – Invitation to the President of the European Patent Office to comment

The judge-rapporteur may, on his own initiative or on request by the President of the European Patent Office, invite the President of the European Patent Office to comment in writing on any question arising in the course of proceedings under this Section. The President shall not become party to the proceedings. The plaintiff shall be entitled to submit his observations on the President's comments.

[Systematically, the following 2 Rules should be placed below in Part 1, Chapter 2 (Interim procedure) and Chapter 3 (Oral procedure). However, for the sake of keeping the Rules on the ex parte procedure clearly distinct from the other (inter partes) procedures before the UPC, they have been included here for easy overview.]

Rule 100 – *Lex specialis* for the interim procedure (*ex parte* procedure)

During the interim procedure, the judge-rapporteur shall invite the plaintiff to indicate whether he wishes that an oral hearing be convened. The judge-rapporteur may convene an oral hearing at his own instance. Rules 112 to 118 shall apply *mutatis mutandis*.

Rule 100a – *Lex specialis* for the oral procedure (*ex parte* procedure)

If an oral hearing is not convened, the panel shall decide in accordance with Rule on <Decision or order of the panel in written proceedings>

CHAPTER 2 – INTERIM PROCEDURE

Rule 101 – Role of the judge-rapporteur (Case management)

1. During the interim procedure, the judge-rapporteur shall make all necessary preparations for the oral hearing. He may in particular, where necessary (Rule 26), hold an interim conference with the parties which may be held on more than one occasion.
2. The judge-rapporteur shall have all authority to ensure a fair, orderly and efficient interim procedure.
3. Without prejudice to the principle of proportionality, the judge-rapporteur shall endeavour to complete the interim procedure within three months.

Relation with draft Agreement: Articles 24 and 32(2)

Rule 102 – Referral to the panel

1. The judge-rapporteur may refer any matter to the panel for decision and the panel may of its own motion review any decision or order of the judge-rapporteur or the conduct of the interim procedure.
2. Any party may request that a decision or order of the judge-rapporteur be referred to the panel for an early review pursuant to Rule 433. Pending review, the decision or order of the judge-rapporteur shall be effective.

Rule 103 – Preparation for the interim conference

Whether or not the judge-rapporteur decides to hold an interim conference, he may order the parties, within time periods to be specified, to

- (a) provide further clarification on specific points,
- (b) answer specific questions,
- (c) produce evidence,
- (d) lodge specific documents including each party's summary of the orders sought at the interim conference.

INTERIM CONFERENCE

Rule 104 – Aim of the interim conference

The interim conference shall enable the judge-rapporteur to

- (a) identify main issues and determine which relevant facts are in dispute,
- (b) where appropriate, clarify the position of the parties as regards those issues and facts,
- (c) establish a schedule for the further progress of the proceedings,
- (d) explore with the parties the possibilities to settle the dispute or to make use of the facilities of the Patent Mediation and Arbitration Centre,
- (e) where appropriate, issue orders regarding production of further pleadings, documents, experts, experiments, inspections, further written evidence, the matters to be the subject of oral evidence and the scope of questions to be put to the witnesses.
- (f) where appropriate, hold preparatory discussions with witnesses and experts with a view to properly preparing for the oral hearing.
- (g) make any other decision or order as he deems necessary for the preparation of the oral hearing including, after consultation with the presiding judge, an order for a separate hearing of witnesses and experts before the panel.
- (h) set a date for any separate hearing pursuant to paragraph (g) of this Rule and confirm the date for the oral hearing.
- (i) decide the value of the particular dispute.

Relation with draft Agreement: Articles 17(3) and 32(2)

Rule 105 – Telephone conference and video conference

1. The interim conference may be held by telephone conference or by video conference.
2. On request by a party and subject to the approval of the judge-rapporteur, the interim conference may be held in Court.

[3. The judge-rapporteur may hold the interim conference in any language mastered by parties' representatives.]

Rule 106 – Recording of the interim conference

1. If the interim conference is held in court it shall be open to the public and shall be [audio / video] recorded, in accordance with the Practice Directions. The recording shall be made publicly available after the hearing, subject to paragraph 3.
2. After hearing the parties, the judge-rapporteur may order that the proceedings of the interim conference or parts thereof shall not be recorded.

Relation with draft Agreement: Articles 25, 26

PREPARATION FOR THE ORAL HEARING

Rule 108 – Summons to the oral hearing

1. The judge-rapporteur shall summon the parties to the oral hearing which shall take place before the panel on the date(s) set under Rule 104(h). At least two months' notice shall be given, unless the parties agree to a shorter time period.

Rule 109 – Simultaneous interpretation during oral hearings

1. At the latest one month before the oral hearing, including any separate hearing of witnesses and experts, a party may lodge an *Application for simultaneous interpretation which shall contain
 - (a) an indication of the language to or from which the party requests simultaneous interpretation during the oral hearing,
 - (b) the reasons for the Request,
 - (c) the field of technology concerned,
 - (d) any other information of relevance for the Request.
2. The judge-rapporteur shall decide whether and to what extent simultaneous interpretation is appropriate and shall, instruct the Registry to make all necessary arrangements for simultaneous interpretation. ART. 6(5) OF THE AGREEMENT SHOULD BE CHANGED TO "MAY" AND INCLUDE A REFERENCE TO THE RULES OF PROCEDURE
3. The judge-rapporteur may decide on his own motion to order simultaneous interpretation and shall instruct the Registry and inform the parties accordingly.
4. A party wishing to engage an interpreter at its own expense shall inform the Registry at the latest two weeks before the oral hearing.

Relation with draft Agreement: Articles 29(4a) and 31(2)

Rule 110 – Closure of the interim procedure

1. As soon as the judge-rapporteur considers that the state of preparation of the file is adequate, he shall inform the presiding judge and the parties that the interim procedure is closed in view of the oral hearing.
2. Where final dates have been set the interim procedure shall be deemed closed on the last date set.
3. The oral procedure shall start on the date following the date on which the interim procedure is closed. The presiding judge shall take over the management of the case.

** An on-line form will be available to guide parties.*

CHAPTER 3 – ORAL PROCEDURE

Rule 112 – Role of the presiding judge (Case management)

The presiding judge shall

- (a) have all authority to ensure fair, orderly and efficient oral procedure and
- (b) ensure that the case is ready for decision on the merits at the end of the oral hearing.

Rule 113 – Conduct of the oral hearing

1. The oral hearing shall be held before the panel and shall be directed by the presiding judge.
2. The oral hearing shall consist of
 - (a) the hearing of the parties' oral submissions,
 - (b) if ordered during the interim procedure, the hearing of witnesses and experts under the control of the presiding judge.
3. The presiding judge and the judges of the panel may put questions to the parties, to the parties' representatives and to any witness or expert.
4. Under the control of the presiding judge, the parties may put questions to the witness. The presiding judge may prohibit any question which is not designed to adduce relevant and admissible evidence.
5. With the consent of the Court a witness may give evidence in a language other than the language of proceedings.

Relation with draft Agreement: Article 33(1)(a)

Rule 114 – Duration of the oral hearing

1. Without prejudice to the application of principle of proportionality, the presiding judge shall endeavour to complete the oral hearing within one day. The presiding judge may set time limits for parties' oral submissions in advance of the oral hearing, in accordance with the Practice Directions.
2. Oral testimony at the oral hearing or at any separate hearing shall be limited to issues identified by the judge-rapporteur or the presiding judge as having to be decided on the basis of oral evidence.
3. The presiding judge may, after consulting the panel, limit a party's oral submissions if the panel is sufficiently informed.

Rule 115 – Adjournment where the Court considers that further evidence is required

In exceptional cases, the Court may, after hearing the parties' oral submissions, decide to adjourn proceedings and call for further evidence.

Rule 116 – The oral hearing

The oral hearing and any separate hearing of witnesses shall be open to the public. The hearing shall be [audio / video] recorded, in accordance with the Practice Directions. Rule 106 shall apply *mutatis mutandis*.

Relation with draft Agreement: Article 26

Rule 117 – Absence of a party from the oral hearing

1. A party which does not wish to be present at the oral hearing shall inform the Registry in good time. Where both parties have informed the Registry that they do not wish to be present at the oral hearing, the Court may decide the case in accordance with Rule <on Decision or order of the panel in written proceedings>. TO BE DEVELOPED
2. The Court shall not be obliged to delay any step in the procedure, including the decision on the merits, by reason only of the absence of a party from the oral hearing.
3. A party absent from the oral hearing shall be treated as relying only on its written case and not wishing to contest any new submission that the other party may be allowed to make at the oral hearing.
4. If due to an exceptional occurrence a party is prevented from attending the oral hearing, it shall immediately inform the Registry. The Court shall decide whether adjournment of the oral hearing is justified.

Rule 118 – Decision on the merits

1. Subject to the following provisions of this Rule, in addition to the orders and measures referred to in Articles 37a, 38, and 39 of the Agreement the Court may, if requested, order the payment of damages and compensation according to Article 41 and 15(1)(d) of the Agreement, subject to separate proceedings for determining the amount of the damages and the compensation (Rules 125-137). The Court may subject any order or measure to a security to be given by the successful party to the unsuccessful party as determined by the Court in accordance with Rule 452.
2. In appropriate cases and at the request of the party liable to the orders and measures provided for in Rule 118.1 the Court may order damages and/or compensation to be paid to the injured party instead of applying the orders and measures if that person acted unintentionally and without

negligence, if execution of the orders and measures in question would cause such person disproportionate harm and if damages and/or compensation to the injured party appears to the Court to be reasonably satisfactory.

3. If a revocation action is pending before the central division, the local or regional division may:

- (a) render its decision on the merits of the infringement claim, including its orders, under the condition subsequent pursuant to Art. 34a(1) of the Agreement that the patent (patents) is (are) not held to be wholly or partially invalid by the final decision in the revocation procedure or any other term or condition, or ,
- (b) suspend the infringement proceedings if it is of the view that there is a high likelihood that the relevant claims of the patent (or patents) will be held to be invalid by the final decision in the revocation procedure.

4. Where, in the decision on the merits of a direct action or a counterclaim for revocation, the patent (or patents) is (are) found to be entirely or partially invalid, the Court shall revoke the patent (patents) entirely or partially according to Art. 38a of the Agreement.

5. Where the Court has made orders in accordance with Rule 118.1 or 118.3(a) above and the decision or order is set aside by the Court of Appeal because the patent (or patents) have been revoked pursuant to Rule 118.4 or the infringement of the patent (patents) is denied, the Court of Appeal shall order the plaintiff upon the request of the defendant to provide the defendant with appropriate damages for any injury caused by the enforcement of the orders.

6. The Court shall decide in principle on the obligation to bear the legal costs in accordance with Art. 42 of the Agreement.

7. The Court shall give the decision on the merits as soon as possible after the closure of the oral hearing. The Court shall endeavour to issue the decision on the merits in writing within six weeks of the oral hearing.

8. In appropriate cases the Court may give its decision immediately after the closure of the oral hearing. The Court may provide its reasons on a subsequent date.

9. The orders of the Court referred to in para. 1 and 3 shall be enforceable on the defendant only after the plaintiff has served the decision on him indicating in writing which part of the orders he intends to enforce.

Relation with draft Agreement: Article 50

Rule 118A - Decision on the merits – ALTERNATIVE VERSION

1. Subject to the following provisions of this Rule, in addition to the orders and measures referred to in Articles 37a, 38, and 39 of the Agreement the Court may, if requested, order the payment of damages and compensation according to Article 41 and 15(1)(d) of the Agreement, subject to separate proceedings for determining the amount of the damages and the compensation (Rules 125-137).
2. In appropriate cases and at the request of the party liable to the orders and measures provided for in Rule 118A.1 the Court may order damages and/or compensation to be paid to the injured party instead of applying the orders and measures if that person acted unintentionally and without negligence, if execution of the orders and measures in question would cause such person disproportionate harm and if damages and/or compensation to the injured party appears to the Court to be reasonably satisfactory.
3. In the case where a revocation action is pending before the central division when the local or regional division gives its decision, the local or regional division may grant or refuse the orders referred to in rule 1 above pending the decision of the central division, on such terms and conditions (including the giving of security and undertakings as to damages) as shall appear to the Court to be just.
4. Where, in the decision on the merits of a direct action or a counterclaim for revocation, the patent (or patents) is (are) found to be entirely or partially invalid, the Court shall revoke the patent (patents) entirely or partially according to Ar. 38a of the Agreement.
5. Where the Court has made orders in accordance with 118A.3 above any party may apply to the local or regional division following judgment of the central division for relief consequential on the judgement of the central division or any terms or conditions imposed under that Rule.
6. The Court shall decide in principle on the obligation to bear the legal costs in accordance with Art. 42 of the Agreement.
7. The decision on the merits of the Court shall be given in writing as soon as possible after the closure of the oral hearing. The Court shall endeavour to issue the decision on the merits in writing within six weeks of the oral hearing. The relief ordered by the Court may include any order requested pursuant to Article 39 of the Agreement.
8. In appropriate cases the Court may give its decision immediately after the closure of the oral hearing. The Court may provide its reasons on a subsequent date.
9. The orders of the Court referred to in para. 1 and 3 shall be enforceable on the defendant only after the plaintiff has served the decision on him indicating in writing which part of the orders he intends to enforce.

CHAPTER 4 – PROCEDURE FOR THE AWARD OF DAMAGES AND COMPENSATION

Relation with draft Agreement: Article 41

Rule 125 – Separate proceedings for determining the amount of damages ordered

1. The determination of the amount of damages ordered for the successful party may be the subject of separate proceedings following the decision on the merits on both infringement and validity. The determination shall include the determination of the amount of compensation, if any, to be awarded as a result of the provisional protection conferred by a published European patent application (Art 15.1(a) of the Agreement, Art. 67 EPC). The expression “damages” used in Chapter 4 shall be deemed to include such compensation.
2. The Court may order an interim award of damages to the successful party in the decision on the merits, subject to any conditions that the Court may order. Such award shall at least cover the expected costs of the procedure for the award of damages and compensation on the side of the successful party.

[VR2]

Rule 126 – Start of proceedings for the award of damages

Where the successful party (hereinafter "the applicant") wishes to have the amount of damages determined, it shall within two months of service of the decision on the merits lodge an Application for the award of damages

SECTION 1 – APPLICATION FOR THE DETERMINATION OF DAMAGES

Rule 131 – Contents of the Application for the determination of damages

1. The *Application for the determination of damages shall contain
 - (a) particulars in accordance with Rule 11(a) to (d),
 - (b) the date of the decision on the merits and the case number of the file,
 - (c) if required a request for an order to lay open books (Rules 141 to 143) in which case the applicant shall provide the matters set out in Rule 141 (b) to (e).
2. After any procedure for the laying open of books is complete, or if that has not been requested, the applicant shall indicate
 - (a) the redress (damages, license fees, profits] requested by him
 - (b) an indication of the facts relied on, in particular calculations concerning lost profits or profits made by the unsuccessful party,

- (c) an indication of the evidence relied on,
- (d) a statement as to whether the decision on the merits is the subject of an appeal
- (e) his assessment of the value of the determination of damages

Rule 131A – Fee for the Application for the determination of damages

1. The applicant shall pay the fee for the determination of damages [EUR] in accordance with Part 6. Rule 13.2 shall apply mutatis mutandis.

Rule 131B – Value-based fee for the determination of damages

Where the value of the determination of damages is assessed by the applicant to exceed [EUR] the applicant shall pay a value-based fee for the determination of damages in accordance with Part 6 [Rules 500.2(b) and 501.3]

** An on-line form will be available to guide parties.*

Rule 132 – Examination as to formal requirements of the Application for the determination of damages

1. The Registry shall, as soon as practicable after the lodging of the Application for the determination of damages, examine whether the requirements of Rules 126 and 131(a) and (b) have been complied with.
2. If the Application for the determination of damages does not comply with the requirements referred to in paragraph 1, the Registry shall invite the applicant to correct the deficiencies noted within a time period to be specified.
3. Rule 14.3 shall apply *mutatis mutandis*.

Rule 133 – Recording in the Register (Application for the determination of damages) and service

If the requirements referred to in Rule 132.1 and Rule 132.2 have been complied with, the Registry shall as soon as practicable,

- (a) attribute a date of receipt to the Application for the determination of damages,
- (b) record the Application in the Register,
- (c) inform the applicant of the date of receipt,
- (d) inform the panel which has given the decision on the merits on infringement that an Application for the determination of damages has been lodged,
- (e) serve the Application upon the unsuccessful party.

Rule 133A – Stay of the Application for a determination of damages

1. The Court may stay the Application for a determination of damages pending any appeal on the merits pursuant to Rule 370 on a reasoned request by the unsuccessful party. The applicant shall be given the opportunity to be heard. If the Court continues the proceedings on the Application it may order the applicant to render a security according to Rule 452.

Rule 134 – Reply of the unsuccessful party

1. If the unsuccessful party accepts the claim made in the Application for the determination of damages, it shall within one month inform the Registry. The judge-rapporteur shall make the order for the determination of damages in accordance with the Application for the determination of damages.
2. If the unsuccessful party contests the claim made in the Application for the determination of damages, it shall within one month of service of the Application for the determination of damages lodge a Defence to the application for the determination of damages.

Rule 135 – Contents of the Defence to the application for the determination of damages

The *Defence to the Application for the determination of damages shall contain

- (a) the names of the unsuccessful party and of that party's representative,
- (b) postal and electronic addresses for service on the unsuccessful party and the names of the persons authorised to accept service,
- (c) the case number attributed to the file,
- (d) the reasons why the Application for the award of damages is contested,
- (e) an indication of the facts relied on,
- (f) an indication of the evidence relied on.

Rule 135A – Reply to the Defence for the determination of damages

1. The applicant may within one month lodge a Reply to the Defence for the determination of damages limited to the matters raised in the Defence.

Rule 136 – Further procedure (Application for the determination of damages)

1. The judge-rapporteur of the panel which has given the decision on the merits may order further exchange of written pleadings, within time periods to be specified.
2. The provisions of Part 1, Chapters 2 (Interim procedure) and 3 (Oral procedure) shall apply *mutatis mutandis* but with such reduced timetable as the judge-rapporteur may order. He shall decide, in principle, on the obligation to bear the legal costs of the proceedings for the determination of damages in accordance with Article 42 of the Agreement.

[with a reduced timetable]

SECTION 2 – REQUEST TO LAY OPEN BOOKS

Rule 141 – Contents of the request to lay open books

If the applicant has made a request pursuant to Rule 131(c), Rules 132 to 133A shall apply *mutatis mutandis*. The Request shall contain

- (a) particulars in accordance with Rule 131.1(a) and (b),
- (b) a description of the information held by the unsuccessful party to which the applicant requests access, in particular accounts, bank documents and any related document concerning the infringement,
- (c) the reasons why the applicant needs access to this information,
- (d) the facts relied on,
- (e) an indication of the evidence offered in support.

* *An on-line form will be available to guide parties.*

Rule 142 – Defence of the unsuccessful party and Reply to Defence

1. If the unsuccessful party accepts the request to lay open books, it shall inform the Registry. The judge-rapporteur shall make the order to lay open books in accordance with the request to lay open books.
2. If the unsuccessful party contests the request to lay open books, it shall within one month of service of the request to lay open books lodge a Defence to the request to lay open books.
3. The applicant may within 14 days lodge a Reply to the Defence to lay open books.

Rule 135 on Contents of the Defence to the application for the award of damages shall apply *mutatis mutandis*

Rule 136 on Further procedure (Application for the award damages) shall apply *mutatis mutandis*

Rule 143 – Decision on the Request to lay open books

1. The Court may
 - (a) order the unsuccessful party to open its books to the applicant within a time period to be specified and subject to such terms as the Court may deem appropriate having regard inter alia to Article 40 of the Agreement,
 - (b) inform the applicant and specify a time period within which the procedure for the award of damages shall be continued.
2. Where the request to lay open books is not allowable, the Court shall inform the applicant and specify a time period within which the procedure for the award of damages shall be continued.

CHAPTER 5 – PROCEDURE FOR COST ORDER

Relation with draft Agreement: Article 42

Rule 150 – Separate proceedings for cost order

1. A cost order shall be the subject of separate proceedings following a decision on the merits and, if applicable, a decision for the award of damages.
2. The Court may order an interim award of costs to the successful party in the decision on the merits or in a decision for the award of damages, subject to any conditions that the Court may decide.

Rule 151 – Start of proceedings for cost order

Where the successful party (hereinafter "the applicant") wishes to seek a cost order, it shall within one month of service of the decision lodge an *Application for a cost order which shall contain

- (a) particulars in accordance with Rule 11(a) to (d),
 - (b) the date of the decision and the case number of the file,
 - (c) a statement as to whether the decision on the merits is the subject of an appeal
 - (d) an indication of the costs for which compensation is requested, which may include recovery of court fees and costs of representation, of witnesses, of experts, and other expenses
 - (e) an explanation as to why these costs are reasonable and proportionate
- The time period may be extended by the judge-rapporteur on a reasoned request by the applicant.

** An on-line form will be available to guide parties.*

Rule 152 – Compensation for representation costs re decision on the merits

1. The successful party shall be entitled to recover reasonable and proportionate costs for representation.
2. To assist the Court in assessing reasonable and proportionate costs for representation the Administrative Committee shall adopt a scale of recoverable costs by reference to the value of the dispute. The scale may be adjusted from time to time.

Rule 153 – Compensation for costs of experts

The compensation for costs of experts shall be based on the rates that are customary in the respective sector, with due regard to the required expertise, the complexity of the issue and the time spent by the expert for the services rendered.

Rule 154 – Compensation for costs of witnesses

Where the Court has ordered the deposit of a sum sufficient to cover the expenses of a witness in accordance with Rule 181, compensation may be requested for payments made by the Registry towards the expenses incurred by a witness.

Rule 155 – Compensation for costs of interpreters and translators

1. The compensation for costs of interpreters shall be the rates that are customary in the country of the division in question, depending on the interpreter's training and professional experience.
2. The compensation for costs of translators shall be the rates that are customary in the country of the division in question, depending on the translator's training and professional experience.

[or based on EUR per page]

Rule 156 – Further procedure

1. The judge-rapporteur may request the applicant to provide written evidence of all costs requested in Rule 151(c). The judge-rapporteur shall allow the unsuccessful party an opportunity to comment in writing on the costs requested including any item of costs that should be apportioned or borne by each party in accordance with Article 42 (1) to (3) of the Agreement.
2. The judge-rapporteur shall decide in writing on the costs to be awarded or apportioned in accordance with Article 42(1) to (3) of the Agreement.
3. The costs shall be paid within the period ordered by the judge-rapporteur.

Rule 157 – Appeal against the cost order

The cost order of the judge rapporteur may be appealed to the Court of Appeal, if the Court of Appeal grants leave to appeal.

PART 2 – EVIDENCE

Relation with draft Agreement: Article 33

Rule 170 – Means of evidence and means of obtaining evidence

1. In proceedings before the Court, the means of evidence shall include in particular the following:

- (a) written evidence, whether printed, hand-written or drawn, in particular documents, written witness statements, plans, drawings, photographs;
- (b) expert reports and reports on experiments carried out for the purpose of the proceedings;
- (c) physical objects, in particular devices, products, embodiments, exhibits, models;
- (d) electronic files and audio / video recordings.

Means of evidence which are not written shall be lodged in accordance with the Practice Directions.

2. Means of obtaining evidence shall include in particular the following:

- (a) hearing of the parties;
- (b) summoning, hearing and questioning of witnesses;
- (c) appointing and hearing of experts;
- (d) ordering a party or a third party to produce evidence;
- (e) ordering inspection of a place or a physical object;
- (f) ordering measures to preserve evidence.

Rule 171 – Offering of evidence

1. A party making a statement of fact that is contested or likely to be contested by the other party shall indicate the means of evidence to prove it. In case of failure to indicate the means of evidence regarding a contested fact, the Court may disregard such statement of fact.

2. A statement of fact that is not contested by any party shall be held to be true as between the parties.

Rule 172 – Duty to produce evidence

1. Evidence available to a party regarding a statement of fact that is contested or contestable by the other party must be produced by the party making that statement of fact.

2. The Court may at any time during the proceedings order a party making a statement of fact to produce evidence that lies in the control of that party. If the party fails to produce the evidence, the Court shall take such failure into account when deciding on the issue in question.

CHAPTER 1 – WITNESSES AND EXPERTS OF THE PARTIES

Rule 175 – Written witness statement

1. A party seeking to offer witness evidence may lodge a written witness statement.
2. A written witness statement shall be signed by the witness and shall include a statement of the witness that he is aware of his obligation to tell the truth and of his liability under applicable national law in the event of any breach of this obligation. The statement shall set out the language in which the witness shall give oral evidence, if necessary.

Rule 176 – Application for the hearing of a witness in person

Where a party seeking to offer witness evidence cannot obtain a written witness statement, it shall make an application for the hearing of a witness in person which shall set out

- (a) the reasons why the witness shall be heard in person and
- (b) the facts which the party expects the witness to confirm.
- (c) the language in which the witness shall give evidence.

Rule 177 – Summoning of witnesses to the oral hearing

1. The Court may order that a witness be heard in person of its own motion or
 - (a) where a written witness statement is challenged by the other party or
 - (b) on an application for the hearing of a witness in person [Rule 176].
2. An order of the Court summoning a witness to the oral hearing shall in particular indicate
 - (a) the name, address and description of the witness,
 - (b) the date and place of the oral hearing,
 - (c) an indication of the facts of the case about which the witness is to be examined,
 - (d) information about the reimbursement of expenses incurred by the witness,
 - (e) information about the sanctions which may be imposed on a defaulting witness (Rule 179).
 - (f) a statement as to whether the witness will be questioned by the Court and the parties

** An on-line form will be available to guide parties.*

Rule 178 – Hearing of witnesses

1. After the identity of the witness has been established and before hearing his evidence, the presiding judge shall ask the witness to make the following declaration:

"I solemnly, sincerely and truly declare and affirm that the evidence I shall give shall be the truth, the whole truth and nothing but the truth."

2. The witness shall give his evidence to the Court.

3. The hearing of a witness who has signed a written witness statement shall begin with the confirmation of the evidence given therein. The witness may elaborate on the evidence contained in his written witness statement.

4. The presiding judge and the judges of the panel may put questions to the witness.

5. Under the control of the presiding judge, the parties may put questions to the witness. The presiding judge may prohibit any question which is not designed to adduce relevant and admissible evidence.

6. The Court may allow a witness to give evidence through electronic means, such as video conference. Paragraphs 1 to 5 shall apply.

Rule 179 – Duties of witnesses

1. Witnesses who have been duly summoned shall obey the summons and attend the oral hearing.

2. Without prejudice to paragraph 3, if a witness who has been duly summoned fails to appear before the Court or refuses to give evidence or to make the declaration referred to in Rule 178.1, the Court may impose upon him a pecuniary sanction not exceeding [**EUR] and may order that a further summons be served at the witness's own expense. The Court may send a Letter Rogatory to the competent national court pursuant to Rule 202.

3. Nobody shall be obliged to sign a written witness statement or to give evidence at an oral hearing if he/she is a spouse, partner equal to a spouse under applicable national law, descendant, sibling or parent of a party. A witness may also refuse to answer questions if answering them would violate a professional privilege or other duty of confidentiality imposed by the national law applicable to the witness or expose him or his spouse, partner equal to a spouse under applicable national law, descendant, sibling or parent to criminal prosecution under applicable national law.

4. The Court may decide to report to the competent authorities of the Contracting Member States whose courts have criminal jurisdiction in case of the giving of false evidence on the part of a witness.

*** Tentative level included for illustrative purposes only,*

Rule 180 – Reimbursement of expenses of witnesses

1. A witness shall be entitled to reimbursement of

- (a) expenses for travelling and stay and
- (b) loss of income caused by his hearing in person.

After the witness has carried out his duties and upon his request, the Registry shall make a payment to the witness towards the expenses incurred.

2. Where a party has lodged an Application for the hearing of a witness in person, the Court shall make the summoning of the witness conditional upon the deposit of a sum sufficient to cover the expenses referred to in paragraph 1.

3. Where the Court orders of its own motion that a witness be heard in person, the funds necessary shall be provided by the Court.

Rule 181 – Experts of the parties

A party may provide any expert evidence that it considers necessary. Rules 175 to 180 shall apply *mutatis mutandis* to experts of the parties.

CHAPTER 2 – COURT EXPERTS

Relation with draft Agreement: Article 36

Rule 185 – Appointment of a court expert

1. Where the Court must resolve a specific technical question in relation to the case, it may appoint a court expert.
2. The parties may make suggestions regarding the identity of the court expert, his technical background and the questions to be put to him.
3. The court expert shall answer only to the Court and shall possess the expertise, independence and impartiality required for being appointed as court expert.
4. The Court shall appoint a court expert by way of order which shall in particular specify
 - (a) the name and address of the expert appointed,
 - (b) a short description of the facts of the case,
 - (c) the evidence submitted by the parties in respect of the technical question
 - (d) the questions put to the expert, with the appropriate level of detail, including where appropriate suggestions relating to any experiments to be carried out,
 - (e) when and under what conditions the expert may receive other relevant information,
 - (f) the time period for the presentation of the expert report,
 - (g) information about the reimbursement of expenses incurred by the expert,
 - (h) information about the sanctions which may be imposed on a defaulting expert.
5. The expert shall receive a copy of the order, together with the documents and other evidence that the Court considers to be necessary for carrying out his task.
6. The expert shall be required upon receipt of the order to confirm in writing that he will present the expert report within the time period specified by the Court.
7. The Court may reduce any fee agreed with the expert by an equitable amount if the expert did not deliver his report within the time period specified by the Court or if the report did not have the quality to be expected of the expert.
8. If an appointed court expert does not present his report within the time period specified or, if extended at the expert's request, the extended period, the Court may appoint another expert in his place. The Court may hold the expert liable for all or part of the costs of appointing and reimbursing another expert.

Rule 186 – Duties of a court expert

1. The court expert shall present an expert report in writing within the time period specified by the Court [Rule 185.4(f)].
2. The court expert shall be under the supervision of the Court and shall inform the Court of his progress in carrying out his task.
3. The court expert shall give expert advice only on questions which have been put to him.

Rule 187 –Expert report

Once the final report of the court expert has been presented to the Court, the Court shall invite the parties to comment on it either in writing or during the oral hearing.

Rule 188 – Hearing of a court expert

Rules 179, 180 and 181 shall apply *mutatis mutandis* to a court expert.

CHAPTER 3 – ORDER TO PRODUCE EVIDENCE AND TO COMMUNICATE INFORMATION

ORDER TO PRODUCE EVIDENCE

Rule 190 – Order to produce evidence

1. Where a party has presented reasonably available evidence sufficient to support its claims and has, in substantiating those claims, specified evidence which lies in the control of the other party or a third party, the Court shall order that party to produce such evidence. For the protection of confidential information the Court may order that the evidence be disclosed to certain named persons only and be subject to appropriate terms of non-disclosure.
2. During the written and interim procedures, a party may request an order to produce evidence
3. The judge-rapporteur shall make such order in the written procedure or in the interim procedure having given the other/third party an opportunity to be heard.
4. An order to produce evidence shall in particular specify
 - (a) under which conditions, in what form and within what time period the evidence shall be produced,
 - (b) any sanction which may be imposed if the evidence is not produced according to the order.
5. Where the Court orders a third party to produce evidence, the interests of that third party shall be duly taken into account.
6. An order to produce evidence shall be subject to the provisions of Rules 179.3, 361 and 362.
7. If a party fails to comply with an order to produce evidence, the Court shall take such failure into account when deciding on the issue in question.

*Relation with draft Agreement: Article 35(1)
[Article 6 (1) Directive 2004/48/EC; Article 43(1) TRIPS]*

ORDER TO COMMUNICATE INFORMATION

Rule 191 – Application for order to communicate information

1. The Court may in response to a reasoned request of a party order the other party or any third party to communicate information in the control of that other party or third party where such information is reasonably necessary for the purpose of advancing that party's case.
2. Rules 190, 3 to 8 shall apply mutatis mutandis.

CHAPTER 4 - ORDER TO PRESERVE EVIDENCE (*SAISIE*) AND ORDER FOR INSPECTION

ORDER TO PRESERVE EVIDENCE (*Saisie*)

Rule 192 – Application for preserving evidence

1. An Application for preserving evidence may be lodged by a party (within the meaning of Article 27 of the Agreement) (hereinafter "the applicant") at the division where the applicant has commenced infringement proceedings on the merits. If the application is lodged before proceedings on the merits have been started it shall be lodged at the division where the applicant intends to start proceedings on the merits.

2. The *Application for preserving evidence shall contain

(a) particulars in accordance with Rule 11(a) to (g),

(b) a clear indication of the measures requested [Rule 196.1], including the exact location of the evidence to be preserved,

(c) the reasons why prompt measures are needed to preserve relevant evidence,

(d) an indication of the facts and evidence relied on in support of the Application.

Where main proceedings on the merits of the case have not yet been started before the Court, the Application shall in addition contain a concise description of the action which will be started before the Court, including an indication of the facts and evidence which will be relied on in support.

3. Where the applicant requests that measures to preserve evidence be ordered without hearing the other party (hereinafter "the defendant"), the Application for preserving evidence shall in addition set out the reasons for not hearing the defendant having regard in particular to Rule 197. The applicant shall be under a duty to disclose any material fact known to it which might influence the court in deciding whether to make an order without hearing the defendant.

4. Where the Application for preserving evidence is lodged after main proceedings on the merits of the case have been started before the Court, the Application shall be drawn up in the language of the proceedings. Where the Application is lodged before main proceedings on the merits of the case have been started before the Court, Rules 12 or 43 shall apply *mutatis mutandis*.

5. The applicant shall pay the fee for the Application for preserving evidence [**EUR 1000], in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 35a
[Article 7 Directive 2004/48/EC; EPLA RoP §154]*

* An on-line form will be available to guide parties.

** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.

Rule 193 – Examination as to formal requirements, recording in the Register, assignment to panel, designation of judge-rapporteur, single judge

1. Where main proceedings on the merits of the case have not yet been started before the Court, the Application for preserving evidence shall be dealt with in accordance with
 - Rule 14.1 and .2: formalities examination by Registry
 - Rule 15.1(a) to (d): date of receipt, recording in the Register, case number, assignment to panel
 - Rule 16: designation only of judge-rapporteur by presiding judge

2. Where main proceedings on the merits of the case have already been started before the Court, an Application for preserving evidence shall immediately be
 - examined by the Registry in accordance with Rule 14
 - forwarded to the panel to which the case has been assigned or to the single judge to whom the case has been assigned [Rule 15.1(d)]

3. The single judge rapporteur or judge deciding on an Application for preserving evidence shall have all necessary powers of the Court.

*Relation with draft Agreement: Article 6(7)
[EPLA RoP §124+127, VR2]*

Rule 194 – Examination of the Application for preserving evidence

1. Without prejudice to the Court's decision on the Application for preserving evidence, the Court shall have the discretion to

(a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an *Objection to the Application for preserving evidence which shall contain

(i) the reasons why the Application shall fail,

(ii) an indication of the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant,

(iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and an indication of the facts and evidence relied on in support,

(b) summon the parties to an oral hearing,

(c) summon the applicant to an oral hearing without the presence of the defendant.

2. In exercising discretion, the Court shall take into account

(a) the urgency of the case,

(b) whether the reasons for not hearing the defendant [Rule 192.3] appear well-founded,

(c) the probability that evidence may be destroyed or otherwise cease to be available. [Rule 197]

3. The presiding judge may decide that he or the judge-rapporteur or other single judge may decide on the Application in accordance with Rules 194 to 198.

4. In cases of extreme urgency the applicant may apply without formality for an order to preserve evidence to a single judge to be designated by the President of the Court of First Instance (or such judge to whom the President of the Court of First Instance has delegated this task) in each division as the “standing judge” (hereinafter referred to as the “standing judge”). The standing judge shall have all the powers of the Court in accordance with Rule 1(b) and shall decide the procedure to be followed on the Application.

[VR2, EPLA RoP §155]

** An on-line form will be available to guide parties.*

Rule 195 – Oral hearing

1. Where the Court decides to summon the parties to an oral hearing, the date for the oral hearing shall be set as soon as possible after the date of receipt of the Application for preserving evidence.
2. The Court shall prepare the oral hearing [*with a reduced time-table*]. Part 2 on Evidence shall be applicable only to the extent determined by the Court.
3. Rules 112 to 117 shall apply *mutatis mutandis*. Where the applicant is absent from the oral hearing without a reasonable excuse, the Court shall reject the Application for preserving evidence.
4. The decision of the Court on the Application for preserving evidence shall be given in writing as soon as possible after the closure of the oral hearing. If the Court deems appropriate, the decision may be given orally to the parties at the end of the oral hearing.

*Relation with draft Agreement: Article 37(2)
[EPLA RoP §131-133, VR2]*

Rule 196 – Decision on the Application for preserving evidence

1. The Court may order the following:

- (a) preserving evidence by detailed description, with or without the taking of samples;
- (b) physical seizure of allegedly infringing goods;
- (c) physical seizure of the materials and implements used in the production and/or distribution of these goods and any related document.

For the protection of confidential information the Court may order that any of the above be disclosed only to certain named persons and subject to appropriate terms of non-disclosure.

2. An order to preserve evidence shall specify that, unless otherwise ordered by the Court, the outcome of the measures to preserve evidence may only be used in the proceedings on the merits of the case.

3. The order to preserve evidence shall be enforceable immediately, unless the Court decides otherwise. The Court may set conditions to the enforceability of the order, specifying in particular

- (a) who may represent the applicant when the measures to preserve evidence are being carried out and under what conditions,
- (b) any security which shall be provided by the applicant.

If necessary, the Court may set penalties applicable to the applicant if these conditions are not observed.

4. The order to preserve evidence shall specify a person who shall carry out the measures referred to in rule 1 and present a written Report on the measures to preserve evidence to the Court, within a time period to be specified.

5. The person referred to in paragraph 4 shall be a professional person or expert, who guarantees expertise, independence and impartiality. Where appropriate and allowed under applicable national law, the person may be a bailiff or assisted by a bailiff. [In no circumstances may an employee or director of the applicant execute the measures.]

6. The Court may order the applicant to provide adequate security for the legal costs and other expenses and compensation for any injury incurred or likely to be incurred by the defendant which the applicant may be liable to bear. The Court shall do so where the order to preserve evidence was made without the defendant having been heard. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee.

7. The order to preserve evidence shall indicate that an appeal may be lodged in accordance with Article 45 of the Agreement.

*Relation with draft Agreement: Article 35a(1)-(3)
[Article 7 Directive 2004/48/EC; EPLA RoP §134+135; VR2]*

Rule 197 – Order to preserve evidence without hearing the defendant

1. The Court may order measures to preserve evidence (Rule 196.1) without the defendant having been heard where any delay is likely to cause irreparable harm to the applicant or where there is a demonstrable risk of evidence being destroyed or otherwise cease to be available..
2. Where measures to preserve evidence are ordered without the defendant having been heard, Rule 195 shall apply *mutatis mutandis* to the oral hearing without the presence of the defendant. In such cases, the defendant shall be given notice, without delay and at the latest immediately after the execution of the measures.
3. Within 10 working days after the execution of the measures, the defendant may request a review of the order to preserve evidence. The *Request for review shall set out
 - (a) the reasons why the order to preserve evidence shall be revoked or modified,
 - (b) the facts and evidence relied on.
4. The Court may order an oral hearing to review the order without delay. Rule 195 shall apply. The Court may modify, revoke or confirm the order. In case the order is modified or revoked the Court may oblige the persons to whom confidential information has been disclosed pursuant to rule 196.1 to keep this information confidential.

*Relation with draft Agreement: Article 37(5)
[Article 7 Directive 2004/48/EC]*

** An on-line form will be available to guide parties.*

Rule 198 – Revocation of an order to preserve evidence

1. The Court shall ensure that an order to preserve evidence is revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days, the applicant does not start proceedings on the merits of the case before the Court.

2. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court may order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures.

*Relation with draft Agreement: Article 37(6) and (7)
[Article 7 Directive 2004/48/EC]*

ORDER FOR INSPECTION

Rule 199 – Order for inspection

1. The Court may, either of its own motion or on a reasoned request by a party, order an inspection of products, devices, methods, premises or local situations *in situ*.

For the protection of confidential information the Court may order that any of the above be disclosed only to certain named persons and subject to appropriate terms of non-disclosure.

2. Rules 192 to 197 shall apply *mutatis mutandis*.

CHAPTER 5 – OTHER EVIDENCE

Rule 201 – Experiments ordered by the Court

1. Without prejudice to the possibility for parties or parties' experts to carry out experiments, the Court may, of its own motion or on a reasoned request by a party, order an experiment to prove a statement of fact for the purpose of proceedings before the Court.
2. A party requesting to be allowed to prove a statement of fact by means of experiments shall lodge a request as soon as practicable in the written procedure or the interim procedure to carry out experiments which shall
 - (a) describe the proposed experiments in detail and the reasons for carrying out the proposed experiments,
 - (b) propose an expert to carry out such experiments,
 - (c) disclose any previous attempts to carry out similar experiments.
3. Other parties to the proceedings shall be invited to comment on the request, including the identity of the expert proposed and the description of the experiments.
4. The party requesting experiments shall initially bear the costs of the experiment.
5. The order of the Court allowing the experiments shall specify the detailed experiments and
 - (a) the name and address of the expert or experts who are to carry out the experiments and draw up the report on the experiments,
 - (b) the time period for carrying out the experiments and, where appropriate, the exact time and place where they are to be carried out,
 - (c) if necessary, other conditions for carrying out the experiments,
 - (d) the time period for presenting the report on the experiments and, where appropriate, directions relating to the contents of the report.
6. Where appropriate, the Court may order that the experiments be carried out in the presence of the parties and their experts.
7. Once the report on the experiments is presented to the Court, it shall invite the parties to comment on it either in writing or during the oral hearing.

Rule 202 – Letters rogatory

1. The Court may, of its own motion or on a reasoned request by a party, issue letters rogatory for the hearing of witnesses by other competent courts or authorities.
2. The Court shall draw up letters rogatory in the language of the competent court or authority or shall attach to such letters a translation into that language.
3. Subject to paragraph 4, the competent court or authority shall apply national law as to the procedures to be followed in executing such requests and, in particular, as to the appropriate measures of compulsion.
4. The Court shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place. It may inform the parties, witnesses and experts concerned.

[Council Regulation No 1206/2001 of 28 May 2001 on co-operation between the courts of the Member States in the taking of evidence in civil or commercial matters]

PART 3 – PROVISIONAL MEASURES

Relation with draft Agreement: Articles 15(1)(b) and 37

Rule 205 – Stages of the proceedings (summary proceedings)

Summary proceedings before the Court of First Instance shall consist of the following stages:

- (a) a written procedure;
- (b) an oral procedure, which may include an oral hearing of the parties or of one of the parties.

Rule 206 – Application for provisional measures

1. An Application for provisional measures may be lodged by a party (hereinafter "the applicant") before main proceedings on the merits of the case have been started before the Court.

2. An *Application for provisional measures shall contain

- (a) particulars in accordance with Rule 11(a) to (g),
- (b) a indication of the provisional measures which are being requested [Rule 211.1],
- (c) the reasons why provisional measures are necessary to prevent an impending infringement, to forbid the continuation of an alleged infringement or to make such continuation subject to the lodging of guarantees,
- (d) an indication of the facts and evidence relied on in support of the Application, including evidence to support the claim that provisional measures are necessary ,
- (e) a concise description of the action which will be started before the Court, including an indication of the facts and evidence which will be relied on in support of the main proceedings on the merits of the case.

3. Where the applicant requests that provisional measures be ordered without hearing the other party (hereinafter "the defendant"), the *Application for provisional measures shall in addition contain

- (a) the reasons for not hearing the defendant having regard in particular to Rule 197,
- (b) information about any prior correspondence between the parties concerning the alleged infringement, and
- (c) the applicant shall be under a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant.

4. Rule 12 shall apply *mutatis mutandis*. The applicant shall pay the fee for the Application for provisional measures [****EUR**], in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

** An on-line form will be available to guide parties.*

** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.*

Rule 207 – Protective letter

1. If a person entitled to start proceedings under Article 27 of the Agreement considers it likely that an Application for provisional measures against him as a defendant may be lodged before the Court in the near future, he may file a Protective letter.

2. The *Protective letter shall be filed with the Registry and shall contain

- (a) the name of the defendant filing the Protective letter and of the defendant's representative,
- (b) the name of the presumed applicant for provisional measures,
- (c) postal and electronic addresses for service on the defendant filing the Protective letter and the names of the persons authorised to accept service,
- (d) postal and, where available, electronic addresses for service on the presumed applicant for provisional measures and the names of the persons authorised to accept service if known,
- (e) where available, the number of the patent (or patents) concerned and, where applicable, information about any prior or pending proceedings referred to in Rule 11(f),
- (f) the statement that the letter is a Protective letter.

The Protective letter may contain

- (g) an indication of the facts relied on, which may include a challenge to the facts expected to be relied on by the presumed applicant and/or, where applicable, any assertion that the patent (or patents) is (are) invalid and the grounds for such assertion
- (h) any available written evidence relied on,
- (i) the arguments of law, including the reasons why any Application for provisional measures should be rejected.

3. The defendant filing the Protective letter shall pay the fee for filing a Protective letter [**EUR], in accordance with Part 6.

4. The Registry shall as soon as practicable examine whether the requirements of paragraphs 2(a) to (f) and 3 have been complied with. If these requirements have been complied with, the Registry shall as soon as practicable,

- (a) record the date of receipt and a number to the Protective letter,
- (b) record the Protective letter in the Register,
- (c) provide details of the Protective letter to all local and regional divisions
- (d) where an Application for provisional measures has already been lodged, inform the panel or the single judge dealing with the Application about the filing of the Protective letter.

5. Where an application for provisional measures is subsequently lodged the Registrar shall as soon as practicable forward a copy of the protective letter to the applicant and to the panel or judge appointed under Rule 208.

6. If no Application for provisional measures has been lodged within six months from the date of receipt of the Protective letter, the Protective letter shall be removed from the Register unless the person who has lodged the Protective letter has prior to the expiry of such period applied for an extension of six months and paid a fee for the extension of [€] in accordance with Part 6.

* An on-line form will be available to guide parties.

*** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.*

[Expenses incurred by filing a Protective letter should only be reimbursable to the defendant under the cost order referred to in Rules 150 and 151 if a Protective letter has been filed before the lodging of the Application for provisional measures and the latter has not been successful – to be developed in Part 1, Chapter 5.]

Language of the protective letter?

Rule 208 – Examination as to formal requirements, recording in the Register, assignment to panel, designation of judge-rapporteur, single judge

1. The Application for provisional measures shall be examined by the Registry in accordance with Rule 14.1 and .2. The Registry shall in addition examine whether any Protective letter relevant for the Application is recorded in the Register.

2. Where main proceedings on the merits of the case have not yet been started before the Court, Rule 15 (date of receipt, recording in the Register, case number, assignment to panel) and Rule 16 (designation of judge-rapporteur by presiding judge) shall apply *mutatis mutandis*. In urgent cases, the presiding judge may decide that he or an experienced judge of the panel, acting as single judge, may decide on the Application in accordance with Rules 209 to 214 *with a reduced time-table*.

3. Where main proceedings on the merits of the case have already been started before the Court, the Application for provisional measures shall immediately be forwarded to the panel to which the case has been assigned or to the single judge [Rule 15.1(d)]. In urgent cases (where the case has not been assigned to a single judge), the presiding judge may decide that he or the judge-rapporteur, acting as single judge, may decide on the Application in accordance with Rules 209 to 214 *with a reduced time-table*.

4. The single judge deciding on the Application for provisional measures shall have all necessary powers of the Court.

Relation with draft Agreement: Article 6(7)

[Article 14(3) draft Statute, EPLA RoP §124+127, VR2]

Rule 209 – Examination of the Application for provisional measures

1. Without prejudice to the Court's decision on the Application for provisional measures, the Court shall have the discretion to
 - (a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an *Objection to the Application for provisional measures which shall contain
 - (i) the reasons why the Application shall fail,
 - (ii) an indication of the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant;
 - (iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and the facts and evidence relied on in support,
 - (b) summon the parties to an oral hearing,
 - (c) summon the applicant to an oral hearing without the presence of the defendant.

2. In exercising discretion, the Court shall in particular take into account
 - (a) whether the patent has been upheld in an opposition procedure before the EPO,
 - (b) the urgency of the case,
 - (c) whether the applicant has requested provisional measures without hearing the defendant and whether the reasons for not hearing the defendant appear well-founded,
 - (d) any Protective letter filed by the defendant; the Court shall in particular consider summoning parties to an oral hearing if a relevant Protective letter has been filed by the defendant.

3. In cases of extreme urgency the standing judge appointed in accordance with Rule 194 may decide immediately on the Application for provisional measures and the procedure to be followed on the Application.

[EPLA RoP §128+129, VR2]

** An on-line form will be available to guide parties.*

Rule 210 – Oral hearing

1. Where the Court decides to summon the parties to an oral hearing, the date for the oral hearing shall be set as soon as possible after the date of receipt of the Application for provisional measures.
2. The Court may order the parties to provide further information, documents and other evidence before or during the oral hearing, including evidence to enable the Court to make its decision in accordance with Rule 211. Part 2 on Evidence shall be applicable only to the extent determined by the Court.
3. Rules 112 to 117 shall apply *mutatis mutandis*. Where the applicant is absent from the oral hearing without a reasonable excuse, the Court shall reject the Application for provisional measures.
4. The decision of the Court on the Application for provisional measures shall be given in writing as soon as possible after the closure of the oral hearing. If the Court deems appropriate, its decision may be given orally to the parties at the end of the oral hearing.

*Relation with draft Agreement: Article 37(4)
[EPLA RoP §130+131, VR2]*

Rule 211 – Decision on the Application for provisional measures

1. The Court may in particular order the following provisional measures:

- (a) injunctions against a defendant;
- (b) the seizure or delivery up of the goods (for the purpose of preservation) suspected of infringing a patent right so as to prevent their entry into or movement within the channels of commerce;
- (c) if an applicant demonstrates circumstances likely to endanger the recovery of damages, a precautionary seizure of the movable and immovable property of the defendant, including the blocking of his bank accounts and other assets.

2. In taking its decision the Court shall be satisfied with a sufficient degree of certainty that the applicant is the right-holder, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent.

3. In taking its decision on the Application for provisional measures, the Court shall have the discretion to weigh up the interests of the parties and in particular take into account the potential harm for any of the parties resulting from ordering or refusing to order provisional measures. The Court shall in particular take into consideration whether either party could be adequately covered by an award of damages.

4. The Court may order the applicant to provide adequate security for any damage, legal costs and other expenses incurred or likely to be incurred by the defendant which the applicant may be liable to bear in the event that the Court revokes the order for provisional measures. The Court shall do so where interim measures are ordered without the defendant having been heard. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee.

5. The decision on provisional measures shall indicate that an appeal may be brought in accordance with Article 45 of the Agreement.

*Relation with draft Agreement: Article 37(2) and (3)
[EPLA RoP §134+135, VR2]*

Rule 212 – Decision on provisional measures without hearing the defendant

1. The Court may only order provisional measures without the defendant having been heard in cases where any delay is likely to cause irreparable harm to the applicant. Rule 211.2 shall apply.
2. Where provisional measures are ordered without the defendant having been heard, Rule 210 shall apply *mutatis mutandis* to the oral hearing without the presence of the defendant. In such cases, the defendant shall be given notice, without delay and at the latest immediately after the execution of the measures.
3. The defendant may request a review in accordance with Rule 197.3 and .4.

Relation with draft Agreement: Article 35a(4) and (5)

Rule 214 – Revocation of provisional measures

1. The Court shall ensure that provisional measures are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 days, the applicant does not start proceedings on the merits of the case before the Court.
2. Where provisional measures are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court shall order the applicant, upon request of the defendant or any third party, to provide the defendant or such third party appropriate compensation for any injury caused by those measures.

PART 4 – PROCEDURES BEFORE THE COURT OF APPEAL

Rule 251 – Appealable decisions

1. An appeal by a party adversely affected may be brought against
 - (a) final decisions of the Court of First Instance,
 - (b) decisions terminating proceedings as regards one of the parties,
 - (c) decisions or orders referred to in Articles 29(4a), 35, 35a, 35b, 37 or 39 of the Agreement.
2. Procedural decisions or orders of the Court of First Instance may be appealed with leave of the Court of First Instance or, if leave is refused, with leave of the Court of Appeal.
3. The Court of Appeal may hear appeals against separate decisions on the merits in infringement proceedings and in validity proceedings together.

Relation with draft Agreement: Article 45(1)

[Examples of final decisions of the Court of First Instance: Rule 118 (decision on the merits), Rule 136 (decision on the award of damages), Rule 150 (decision on costs)]

Rule 252 – Application for leave to appeal

1. A party adversely affected by a decision or order referred to in Rule 251.2 may lodge an Application for leave to appeal to the Court of Appeal within 14 days of service of the decision or order of the Court refusing leave to appeal.
2. The *Application for leave to appeal shall set out
 - (a) the reasons why the appeal should be heard before the final decision of the Court of First Instance is given,
 - (b) where necessary, the facts, evidence and arguments relied on.
3. The President of the Court of Appeal shall assign the Application for leave to appeal to a panel of three of the Court of Appeal which shall decide on the Application.
4. The Court of Appeal may
 - (a) grant leave forthwith if it considers the Application for leave to appeal to be admissible and well founded,
 - (b) reject the Application for leave to appeal if it does not consider the Application to be allowable.

[VR2, CJEU Statute Annex on CST Article 10(3)]

** An on-line form will be available to guide parties.*

Rule 253 – Subject-matter of the proceedings before the Court of Appeal

1. Requests, facts, evidence and arguments submitted by the parties under Rules 261, 262, 281 and 285 shall, subject to paragraph 2, constitute the subject-matter of the proceedings before the Court of Appeal. The Court of Appeal shall consult the file of the proceedings before the Court of First Instance.

2. Requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance may be disregarded by the Court of Appeal. When exercising discretion, the Court shall in particular take into account

- (a) whether a party seeking to lodge new submissions is able to justify that the new submissions were not made during proceedings before the Court of First Instance,
- (b) whether the new submissions are highly relevant for the decision on the appeal,
- (c) the position of the other party regarding the lodging of the new submissions.

*Relation with draft Agreement: Article 45(4)
[VR2, Article 114(2) EPC]*

Rule 254 – Application for suspensive effect

1. A party may lodge an Application for suspensive effect, in accordance with Article 46 of the Agreement.

2. The *Application for suspensive effect shall set out

- (a) the reasons why the lodging of the appeal shall have suspensive effect,
- (b) the facts, evidence and arguments relied on.

3. Rule 252.3 shall apply mutatis mutandis. The Court shall decide the Application without delay.

4. In cases of extreme urgency the applicant may apply without formality for an order for suspensive effect to a single judge to be designated by the President of the Court of Appeal as the standing judge. The standing judge shall have all the powers of the Court of Appeal and shall decide the procedure to be followed on the application.

Relation with draft Agreement: Article 46

** An on-line form will be available to guide parties.*

CHAPTER 1 – WRITTEN PROCEDURE

SECTION 1 – STATEMENT OF APPEAL, STATEMENT OF GROUNDS OF APPEAL

Rule 260 – Time periods for lodging the Statement of appeal and the Statement of grounds of appeal

1. A Statement of appeal shall be lodged by the appellant
 - (a) within one month of service of a decision referred to in Rule 251.1(a) and (b) or
 - (b) within 14 days of service of a decision or order referred to in Rules 251.1(c) and 252.4(a).
2. The Statement of grounds of appeal shall be lodged by the appellant
 - (a) within two months of service of a decision referred to in Rule 251.1(a) and (b) or
 - (b) within two months of service of a decision or order referred to in Rules 251.1(c) and 252.4(a).

*Relation with draft Agreement: Article 45(2)
[EPLA RoP §175]*

3. The periods referred to in Rule 260.2 may be extended by the Court of Appeal on a reasoned request by the appellant.

Rule 261 – Contents of the Statement of appeal

The *Statement of appeal shall contain

- (a) the names of the appellant and of the appellant's representative,
- (b) the names of the respondent and of the respondent's representative,
- (c) postal and electronic addresses for service on the appellant and on the respondent, as well as the names of the persons authorised to accept service,
- (d) the date of the decision or order appealed against and the case number attributed to the file in proceedings before the Court of First Instance,
- (e) the order or remedy sought by the appellant.

[EPLA RoP §177]

** An on-line form will be available to guide parties.*

Rule 262 – Contents of the Statement of grounds of appeal

The *Statement of grounds of appeal shall contain

- (a) an indication of which parts of the decision or order are contested,
- (b) the reasons for setting aside the contested decision or order,
- (c) an indication of the facts and evidence on which the appeal is based in accordance with Rule 253.1 and 2.

[Rule 99 EPC]

Rule 263 – Language of the Statement of appeal and of the Statement of grounds of appeal

1. The Statement of appeal and the Statement of grounds of appeal shall be drawn up
 - (a) without prejudice to Article 30(3) of the Agreement in the language of the proceedings before the Court of First Instance or
 - (b) where the parties have agreed in accordance with Article 30(2) of the Agreement, in the language in which the patent was granted; where the parties have agreed in accordance with Article 30(2) of the Agreement, evidence of the respondent's agreement shall be lodged by the appellant together with the Statement of appeal.

Relationship with draft Agreement: Article 30

Rule 264 – Fee for the appeal

The appellant shall pay the fee for the appeal [****EUR**] or the fee for the interlocutory appeal [****EUR**], in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

[EPC Article 108 and Rule 101.2, EPLA RoP §111+112]

** An on-line form will be available to guide parties.*

Rule 265 – Examination as to formal requirements of the Statement of appeal

1. The Registry shall, as soon as practicable after the lodging of the Statement of appeal, examine whether the requirements of Rules 260.1, 261(a) to (e), 263 and 264 have been complied with.
2. If the appellant has not complied with the requirements referred to in Rules 261(a) to (e), 263 and 264, the Registry shall invite the appellant to:
 - (a) correct the deficiencies within 14 days; and
 - (b) where applicable, pay the fee for the appeal within 14 days.

If the appellant has not met the requirement of Rule 260.1 or if the applicant fails to correct the deficiencies or pay the fee the Registry shall inform the President of the Court of Appeal who shall reject the appeal as inadmissible by a decision by default. He may give the appellant an opportunity to be heard beforehand.

[EPLA RoP §108, 182, VR2, Article 90 EPC]

Rule 266 – Recording in the Register (Court of Appeal)

1. If the Statement of appeal complies with the requirements referred to in Rule 265.1, the Registry shall,
 - (a) record the date of receipt to the Statement of appeal and a case number to the appeal file,
 - (b) record the appeal file in the Register,
 - (c) inform the appellant of the case number and the date of receipt.

[VR2, EPLA RoP §183, 102]

2. The President of the Court of Appeal shall assign the case to a panel. Unless otherwise agreed by the panel the most senior judge shall be the presiding judge.

Rule 267 – Designation of the judge-rapporteur

The presiding judge of the panel to which the case has been assigned shall designate one judge of the panel as judge-rapporteur. The presiding judge may designate himself as the judge-rapporteur. The Registry shall as soon as practicable notify the appellant and respondent of the identity of the judge-rapporteur.

[EPLA RoP §185]

*** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.*

Rule 268 – Translation of file

1. If the language of the proceedings before the Court of Appeal is not the language of the proceedings before the Court of First Instance, the judge-rapporteur may order the appellant to lodge, within a time period to be specified, translations into the language of the proceedings before the Court of Appeal of

- (a) written pleadings and other documents lodged by the parties before the Court of First Instance, as specified by the judge-rapporteur,
- (b) decisions or orders of the Court of First Instance.

2. The time period under paragraph 1 may be extended by the judge-rapporteur on a reasoned request by the appellant.

3. If the appellant fails to lodge the translations under paragraph 1 within the period specified, the Court of Appeal shall reject the appeal as inadmissible. The panel may give the appellant an opportunity to be heard beforehand.

4. The appellant may request that documented costs of translations be taken into account when the Court fixes the amount of costs in accordance with Part 4, Chapter 5.

*Relation with draft Agreement: Article 30(2) and (3)
[EPLA RoP §181(1)(3), IPLA]*

Rule 269 – Preliminary examination of the Statement of grounds of appeal

1. The judge-rapporteur shall examine whether the Statement of grounds of appeal satisfies the requirements of Rule 262.

2. If the Statement of grounds of appeal does not comply with the requirements of Rule 262, the judge-rapporteur shall give the appellant leave to amend the Statement of grounds of appeal within such period as he may decide. If the appellant fails to amend the Statement within such period the Court of Appeal may reject the appeal as inadmissible. The panel may give the appellant an opportunity to be heard beforehand.

3. Grounds of appeal which are not raised in the Statement of grounds of appeal shall not be admissible.

[EPLA RoP §179, 186, Rule 99 EPC, VR2]

Rule 270 – Challenge to the decision to reject an appeal as inadmissible

1. The appellant may challenge a decision to reject the appeal as inadmissible under Rules 260.1, 265.2 or 269.2 within one month of service of the decision, without providing new grounds of appeal.
2. The panel to which the case has been assigned under Rule 266.2 shall decide any challenge under paragraph 1.
3. If a decision to reject an appeal as inadmissible is set aside, the appeal shall take its normal course.

[EPLA RoP §187]

SECTION 2 – STATEMENT OF RESPONSE

Rule 280 – Statement of response

Within three months of service of the Statement of grounds of appeal, any party to proceedings before the Court of First Instance which has not lodged a Statement of appeal may lodge a Statement of response. The period may be extended by the judge-rapporteur on a reasoned request by the respondent.

[VR2, EPLA RoP §189]

Rule 281 – Contents of the Statement of response

1. The *Statement of response shall contain
 - (a) the names of the respondent and the respondent's representative,
 - (b) postal and electronic addresses for service on the respondent and the names of the persons authorised to accept service,
 - (c) the case number of the appeal file,
 - (d) a response to the grounds of appeal.
2. The respondent may support the decision of the Court of First Instance on grounds other than those given in the decision.

[EPLA RoP §192, VR2]

** An on-line form will be available to guide parties.*

Rule 282 – Statement of cross-appeal

1. A party who has not lodged a Statement of appeal within the period referred to in Rule 260.1 may still bring an appeal by way of cross-appeal within the period referred to in Rule 280 if one of the other parties has lodged a Statement of appeal.
2. A *Statement of cross-appeal shall be included in the Statement of response. It shall comply with the requirements of Rules 261 and 262. Rules 265 and 269 shall apply *mutatis mutandis* to the Statement of cross-appeal.
3. A Statement of cross-appeal shall not be admissible in any other way or at any other time.
4. A cross-appeal shall be treated as an appeal as far as the fee for the appeal is concerned. Rule 264 shall apply *mutatis mutandis*.
5. If the Statement of appeal is withdrawn, any Statement of cross-appeal shall be deemed to be withdrawn.

[EPLA RoP §176, VR2]

Rule 26 on Further schedule shall apply <i>mutatis mutandis</i>
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SECTION 3 – REPLY TO A STATEMENT OF CROSS-APPEAL

Rule 285 – Reply to a statement of cross-appeal

Where the Statement of response includes a statement of cross-appeal, the appellant may, within two months of service of the Statement of response, lodge a *Reply to the Statement of cross-appeal which shall contain a response to the grounds of appeal raised in the Statement of cross-appeal. The period may be extended by the judge-rapporteur on a reasoned request by the appellant.

[EPLA RoP §194]

** An on-line form will be available to guide parties.*

CHAPTER 2 – INTERIM PROCEDURE [TO BE SIMPLIFIED]

The following Rules from Part 1, Chapter 2 shall apply *mutatis mutandis* in proceedings before the Court of Appeal:

- Rule 101 on Role of the judge-rapporteur (Case management)
- Rule 102 on Referral to the panel
- Rule 103 on Preparation for the interim conference
- Rule 104 on Aim of the interim conference
- Rule 105 on Telephone conference and video conference
- Rule 106 on Recording of the interim conference
- Rule 107 on Further instruction
- Rule 108 on Summons to the oral hearing
- Rule 109 on Simultaneous interpretation during the oral hearing
- Rule 110 on Closure of the interim procedure in view of the oral hearing

CHAPTER 3 – ORAL PROCEDURE [TO BE SIMPLIFIED]

The following Rules from Part 1, Chapter 3 shall apply *mutatis mutandis* in proceedings before the Court of Appeal:

- Rule 112 on Rule of the presiding judge (Case management)
- Rule 113 on Conduct of the oral hearing
- Rule 114 on Duration of the oral hearing
- Rule 115 on Adjournment where the Court considers that further evidence is required
- Rule 116 on Recording of the oral hearing
- Rule 117 on Absence of the parties from the oral hearing

[To be developed?

Simplified appeal procedures for

- appeals against the award of damages by the Court of First Instance

[- appeals against cost order by the Court of First Instance]]

CHAPTER 4 – DECISIONS AND EFFECT OF DECISIONS

Rule 290 – Decision of the Court of Appeal

1. The decision shall either reject the appeal or set the decision or order aside totally or in part substituting its own decision or order.
2. The Court of Appeal may
 - (a) exercise any power within the competence of the Court of First Instance,
 - (b) refer the case back to the Court of First Instance for further prosecution [Rule 291].

Relation with draft Agreement: Article 50
[EPLA RoP §66+196+197, VR2, EPC Article 111(1)]

Rule 291 – Referral back

1. In exceptional circumstances, the Court of Appeal may refer the case back to the Court of First Instance for decision or for retrial.
2. The decision referring a case back to the Court of First Instance shall specify whether it the same panel whose earlier decision or order is revoked shall deal further with the case or whether another panel shall be appointed by the President of the Court of First Instance.
3. Where a case is referred back to the Court of First Instance, the Court shall be bound by the decision of the Court of Appeal and its *ratio decidendi*.

Relation with draft Agreement: Article 47
[CJEU Statute Article 61, EPLA RoP §198, VR2 (§1, 3rd hyphen)]

CHAPTER 5 – PROCEDURE FOR COST ORDER

*[To be developed on the model of Part 1, Chapter 5.
Will mainly include costs of representation]*

CHAPTER 6 – PROCEDURE FOR APPLICATION FOR REHEARING [COURT OF APPEAL ONLY OR FIRST INSTANCE AS WELL?]

Rule 295 – Lodging of an Application for rehearing

1. An Application for rehearing may be lodged by any party adversely affected by a final decision (hereinafter "the final decision") of the Court of First Instance for which the time for lodging an appeal has expired or of the Court of Appeal (hereinafter "the petitioner").
2. The Application for rehearing shall be lodged at the Court of Appeal within the following periods:
 - (a) where the Application for rehearing is based on the ground of a fundamental procedural defect, within two months of service of the final decision;
 - (b) where the Application for rehearing is based on an act which has been held, by a final court decision, to constitute a criminal offence, within two months of the date on which the criminal offence has been so held
 - (c) but in any event no later than ten years of service of the final decision..

*Relation with draft Agreement: Article 55(2)
[EPLA RoP §175+200+202, Article 112a(4) EPC]*

Rule 296 – Contents of the Application for rehearing

1. The *Application for rehearing shall contain
 - (a) the names of the petitioner and of the petitioner's representative,
 - (b) postal and electronic addresses for service on the petitioner and the names of the persons authorised to accept service and
 - (c) an indication of the decision to be reviewed.
2. The Application for rehearing shall indicate the reasons for setting aside the final decision, as well as the facts and evidence on which the Application is based.

[EPLA RoP §177, Rule 107 EPC]

** An on-line form will be available to guide parties.*

Rule 297 – Fundamental procedural defects

A fundamental procedural defect under Article 55(1) of the Agreement may have occurred, for example, where

- (a) a judge of the Court of Appeal took part in the decision in breach of Article 12 of the Agreement or Article 5 of the Statute,
- (b) a person not appointed as a judge of the Court of Appeal sat on the panel which took the final decision,
- (c) a fundamental violation of Article 49 of the Agreement occurred in the proceedings which have led to the final decision or
- (d) the Court of Appeal decided on the appeal without deciding on a request relevant to that decision.
- (e) a breach has occurred of Article 6 of the European Convention on Human Rights.

[Article 112a(2) EPC and Rule 104 EPC]

Rule 298 – Obligation to raise objections

An Application for rehearing based on the ground of a fundamental procedural defect is only admissible where an objection in respect of the procedural defect was raised during the proceedings before the Court of Appeal and dismissed by the Court, except where such objection could not be raised during the proceedings before the Court of Appeal.

[Rule 106 EPC]

Rule 299 – Definition of criminal offence

A criminal offence shall only be considered to have occurred if it is finally held to be such an offence by a competent court or authority. A conviction is not necessary.

[Rule 105 EPC]

Rule 300 – Fee for the rehearing

The petitioner shall pay the fee for the rehearing [****EUR**], in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

Rule 266(a), (b) and (c) on Recording in the Register (Court of Appeal) shall apply <i>mutatis mutandis</i>
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*** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.*

Rule 301 – Suspensive effect

The lodging of an Application for rehearing shall not have suspensive effect unless the Court of Appeal decides otherwise.

*Relation with draft Agreement: Article 55(2)
[EPLA RoP §201, Article 112a(3) EPC]*

Rule 302 – Examination as to formal requirements of the Application for rehearing

1. The Registry shall, as soon as practicable after the lodging of the Application for rehearing, examine whether the requirements of Rules 295, 296 and 300 have been complied with.
2. If the petitioner has not complied with the requirements referred to in paragraph 1, the Registry shall invite the petitioner to:
 - (a) correct the deficiencies within 14 days; and
 - (b) where applicable, pay the fee for the rehearing within 14 days.

If the petitioner fails to correct the deficiencies or pay the fee the Registry shall inform the President of the Court of Appeal who may reject the Application for rehearing as inadmissible. He may give the petitioner an opportunity to be heard beforehand.

Rule 303 – Assignment of Request for rehearing to a panel

1. Immediately after the Request for rehearing has been recorded in the Register, the Registry shall inform the President of the Court of Appeal that a Request for rehearing has been lodged.
2. The President of the Court of Appeal shall assign the case to a panel consisting of three legally qualified judges, designating one judge as judge-rapporteur. He may order that judges of the Court who participated in taking the decision to be reviewed shall not sit on the panel.

[EPLA RoP §185+203, Rule 108.3 EPC]

Rule 304 – Examination of the Application for rehearing

1. The judge-rapporteur shall examine the Application for rehearing. He may hear the petitioner.
2. If the judge-rapporteur considers that there is no basis for reviewing the decision, he shall reject the Application for rehearing as not allowable.
3. If the judge-rapporteur considers that the Application is allowable he shall refer the Application to the panel for decision.
4. The panel may make:
 - (a) a decision to reject the Application for rehearing as not allowable. Such a decision shall require a unanimous vote of the judges on the panel; it shall not contain any reasons;
 - (b) a decision to allow the Request for rehearing. Such a decision shall set aside the decision under review, in whole or in part, and re-open the proceedings for a new hearing and decision; where proceedings are re-opened, the provisions governing proceedings before the Court of Appeal shall apply.

*Relation with draft Agreement: Article 55(3)
[EPLA RoP §204+207]*

PART 5 – GENERAL PROVISIONS

CHAPTER 1 – GENERAL PROCEDURAL PROVISIONS

Rule 340 – Examination by the Registry of its own motion

1. In any proceedings before the Court, the Registry shall, as soon as practicable in the proceedings, of its own motion, examine whether an opt-out has effect for the patent or patents concerned.
2. Where the Registry notes that two or more actions between the same parties and concerning the same patent or patents are initiated before several divisions, it shall as soon as practicable inform the divisions concerned.

Relation with draft Agreement: Article 58(3) and (4)

Rule 341 – Date of pleadings

All pleadings shall bear a date which shall be the date of receipt of pleadings in electronic form at the Registry.

[VR2, CST RoP Article 34]

Rule 342 – Public access to the Registry

1. Written pleadings and written evidence lodged at the Court and recorded by the Registry shall be available to the public for on-line consultation, unless a party requests that certain information be kept confidential and the Court makes such an order.
2. Any party may lodge a *Request for excluding public access to the file or to parts of the file which shall contain ...

[To be developed]

Relation with draft Agreement: Articles 8, 26 and 40

Relation with draft Statute: Article 19(2)

Rule 343 – Leave to change claim or amend case

1. A party may at any stage of the proceedings apply to the Court for leave to change its claim or to amend its case, including adding a counterclaim. Any such application shall explain why such change or amendment was not included in the original pleading.
2. Leave shall not be granted if, all circumstances considered, the party seeking the amendment cannot satisfy the Court that
 - (a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and
 - (b) the amendment will not unreasonably hinder the other party in the conduct of its case.
3. Leave to limit a claim unconditionally shall always be granted.

[EPLA RoP §8]

Rule 344 – An opportunity to be heard

Where these rules provide that a party or parties shall or may be given an opportunity to be heard before the Court makes an order or takes some action the Court shall or may (as the case may be) request the parties to provide written submissions within a specified period and/or shall or may invite the parties to an oral hearing on a fixed date by the Court.

Rule 345 – Withdrawal

1. As long as there is no final decision in a case, a plaintiff may apply to withdraw his action. The Court shall decide the application after hearing the other party (or parties).
2. In the event of a withdrawal, the Court shall
 - (a) give a decision declaring the proceedings closed,
 - (b) order the case to be removed from the Register and
 - (c) issue a cost order in accordance with Part 1, Chapter 5.

[EPLA RoP §7, CST RoP Article 74]

By contrast, §269 ZPO: Plaintiff may only declare withdrawal (without the approval of the defendant) until the start of the oral proceedings

Rule 346 – Preliminary References to the Court of Justice of the European Union

1. At any stage of the proceedings where a question is raised by a party before the Court which in the opinion of the Court requires the Court of Justice of the European Union (“CJEU”) to give a ruling before the Court can give judgement, the Court of First Instance may and the Court of Appeal shall of its own motion or at the request of a party make an order for a reference to the CJEU for a preliminary ruling.

2. The order of the court shall set out as clearly and succinctly as possible the question on which the Court seeks a preliminary ruling and shall in addition provide the following details:

- (a) the division or the Court of Appeal making the reference;
- (b) the parties;
- (c) a summary of the proceedings including the essential facts;
- (d) an explanation of why a ruling is sought;
- (e) the provisions of European Union law in question;
- (f) a copy of a decision, if any, by the Court on the question.

3. If the Court requests the CJEU to apply its urgent procedure the order shall in addition set out

- (a) the matters of fact and law which establish its urgency, and
- (b) the reasons why an urgent ruling is appropriate.

4. The Registrar shall as soon as practicable forward the order and any request to apply the urgent preliminary procedure to the Registrar of the CJEU.

5. Unless otherwise decided by the Court the proceedings shall be stayed until the CJEU has given a preliminary ruling on the question.

CHAPTER 2 – SERVICE [TO BE CONSIDERED SEPARATELY]

Rule 350 – Service of the Statement of claim

1. The Registry may serve the Statement of claim on the defendant at an electronic address which the defendant has provided for the purpose of the proceedings.

2. Where

(a) the defendant has provided the electronic address of a representative as an address at which the defendant may be served with the Statement of claim or

(b) a representative acting for the defendant has notified the Registry or the plaintiff that he accepts service of the Statement of claim on behalf of the defendant at an electronic address, the Registry may serve the Statement of claim at the electronic address of that representative.

3. Where service by means of electronic communication cannot be effected, the Registry shall serve the Statement of claim on the defendant by

(a) registered letter with advice of delivery, in accordance with the Practice Directions,

(b) fax, in accordance with the Practice Directions, or

(c) any method authorised by the Court under Rule 351.

4. A Statement of claim served in accordance with paragraphs 1, 2 and 3 is deemed to be served on the defendant

(a) where service takes place by means of electronic communication or by fax: on the day where the relevant electronic message was sent or the transmission of the fax was completed (GMT+1);

(b) where service takes place by registered letter with advice of delivery: 10 working days after posting, leaving with, delivering to or collection by the relevant service provider.

Rule 351 – Service of the Statement of claim by an alternative method or at an alternative place

1. Where it appears to the Court that there is a good reason to authorise service by a method or at a place not otherwise permitted by this Chapter, the Court may by way of order permit service by an alternative method or at an alternative place.
2. On a reasoned request, the Court may order that steps already taken to bring the Statement of claim to the attention of the defendant by an alternative method or at an alternative place is good service.
3. An order under this rule shall specify
 - (a) the method or place of service,
 - (b) the date on which the Statement of claim is deemed served and
 - (c) the period for filing the Statement of defence.

Rule 352 – Notice of service and non-service of the Statement of claim

1. The Registry shall inform the plaintiff of the date on which the Statement of claim is deemed served under Rule 350.3.
2. Where the Registry has served the Statement of claim by registered letter with advice of delivery and the Statement of claim is returned to the Registry, the Registry shall inform the plaintiff.
3. Paragraph 2 shall apply *mutatis mutandis* where the Registry has served the Statement of claim by fax and the fax appears not to have been received.

Rule 353 – Service of other pleadings

1. Immediately after written pleadings have been received at the Registry, the Registry shall serve the pleadings on the other party by means of electronic communication, in accordance with the Practice Directions.

2. Where service by means of electronic communication cannot be effected, the Registry shall serve the written pleadings on the party by

(a) registered letter with advice of delivery, in accordance with the Practice Directions,

(b) fax, in accordance with the Practice Directions, or

(c) any method authorised by the Court under Rule 351.

3. Service under paragraph 2(a) shall be effected at the following place:

(a) where the party is a company or other legal person: at its statutory seat, central administration, principal place of business or at any place within the Contracting Member States where the company or other legal person carries on its activities and which has a real connection with the claim;

(b) where the party is an individual: at his usual or last known residence.

[(4) Lex specialis on service on individuals where the plaintiff has reason to believe that the address is not the defendant's current address? (see CPR 6.11(3) and (4))]

Rule 354 – Change of electronic address for service

Where the electronic address for service of a party changes, that party must give notice in writing of the change as soon as it has taken place to the Court and every other party.

Applicable law

Service within the Union (except for DK): Council Regulation (EC) No 1348/2000 of 29 May 2000 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters

Service in Denmark: Agreement between the EU and Denmark of 19 October 2005 on the service of judicial and extrajudicial documents in civil or commercial matters

Service outside the Union: The Hague Convention of 15 November 1965 on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters

CHAPTER 3 – RIGHTS AND OBLIGATIONS OF REPRESENTATIVES

Rule 359 – Powers of attorney

1. A representative who claims to be representing a party shall be accepted as such.
2. The Court may order a representative to produce a written authority if his representative powers are challenged.

[EPLA RoP §26]

Rule 360 – Certificate that a representative is authorised to practice before the Court

1. A representative pursuant to Article 28(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practise before a court of a Contracting Member State. In subsequent cases the representative may refer to the certificate previously lodged.
2. A representative pursuant to Article 28(2) of the Agreement shall lodge at the Registry the European Patent Litigation Certificate as defined by the Administrative Committee or otherwise justify that he has appropriate qualifications to represent a party before the Court. In subsequent cases such representative may refer to the certificate or other evidence of appropriate qualification previously lodged.

[CST RoP Article 35(5); see also CJEU RoP Article 38(5)(a), CFI RoP Article 44(5)(a)]

Rule 361 – Attorney-client privilege

1. Where a client seeks advice from a lawyer he has instructed in a professional capacity, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is permanently privileged from disclosure, whether in court or arbitration proceedings of any nature or in the face of any compulsory information gathering powers of any body.
2. This privilege applies to communications between a client and a lawyer employed by the client and instructed to act in a professional capacity and a client and a patent attorney (including a patent attorney employed by the client) who is instructed in his professional capacity to advise on patent matters;
3. This privilege extends to the work product of the lawyer or patent attorney (including communications between lawyers and/or patent agents employed in the same firm or entity or between lawyers and/or patent agents employed by the same client) and to any record of a privileged communication.

4. This privilege prevents the lawyer and his client from being questioned or examined about the contents or nature of their communications;

5. This privilege may be expressly waived by the client.

Relation to draft Agreement: Article 28(4)

Rule 362 – Litigation privilege

1. Where a client, or a lawyer or patent attorney instructed by a client in a professional capacity, communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings reasonably anticipated or pending before the Court, such communications shall be permanently privileged from disclosure in the same way and to the same extent as provided for in Rule 361.

Relation to draft Agreement: Article 28(4)

Rule 363 – Privileges, immunities and facilities

1. Representatives appearing before the Court or before any judicial authority to which it has addressed letters rogatory [Rule 199] shall enjoy immunity in respect of words spoken or written by them concerning the case or the parties.

2. Representatives shall enjoy the following further privileges and facilities:

(a) papers and documents relating to the proceedings shall be exempt from both search and seizure;

(b) any allegedly infringing product or device relating to the proceedings shall be exempt from both search and seizure when brought to the Court for the purposes of the proceedings.

In the event of a dispute, customs officials or police may seal those papers, documents or allegedly infringing products or devices. They shall then be immediately forwarded to the Court for inspection in the presence of the Registrar and of the person concerned.

3. Representatives shall be entitled to travel in the course of duty without hindrance.

4. The privileges, immunities and facilities specified in paragraphs 1 to 3 are granted exclusively in the interests of the proper conduct of proceedings.

5. The Court may waive the immunity where it considers that the proper conduct of proceedings requires such a waiver.

Relation with draft Agreement: Article 28(4)

[CJEU RoP Article 32, CST RoP Article 30(3)(4)]

Rule 364 – Powers of the Court as regards representatives

As regards representatives who appear before it, the Court shall have the powers normally accorded to courts of law, under the conditions laid down in Rule 365.

[CJEU Statute Article 19(5)]

Rule 365 – Exclusion from the proceedings

1. If the Court considers that the conduct of a party's representative towards the Court, towards any judge of the Court or towards any member of the staff of the Registry is incompatible with the dignity of the Court or with the requirements of the proper administration of justice, or that such representative uses his rights for purposes other than those for which they were granted, it shall so inform the person concerned.

On the same grounds, the Court may at any time, after having given the person concerned an opportunity to be heard, exclude that person from the proceedings by way of order. That order shall have immediate effect.

2. Where a party's representative is excluded from the proceedings, the proceedings shall be suspended for a period fixed by the presiding judge in order to enable the party concerned to appoint another representative.

[CJEU RoP Article 35, CST RoP Article 32]

Rule 366 – Patent attorneys' right of audience

1. For the purposes of Article 28(2a) of the Agreement, the term "patent attorneys" assisting the representative referred to in Art. 28(1) of the Agreement shall mean persons meeting the requirements of Article 134(1) or (3)(a) to (c) of the European Patent Convention.

2. Such patent attorneys shall be allowed to speak at hearings of the Court subject to the representative's responsibility to coordinate the presentation of a party's case.

3. Rules 361 to 365 shall apply *mutatis mutandis*.

Relation with draft Agreement: Article 28(2a)

Rule 367 – Change of a representative

Any change of representative shall take effect from the receipt by the Registry of notification that a new representative shall in future be representing the party concerned. Until the moment where such statement is received, the former representative remains responsible for the conduct of the proceedings and for communications between the Court and the party concerned.

To be developed:

Change of representative in case of death or bankruptcy of a representative:

The Court shall grant the party concerned a period within which it may find a replacement
[EPLA RoP §27]

CHAPTER 4 – STAY OF PROCEEDINGS

Rule 370 – Stay of proceedings

1. The Court may stay proceedings

- (a) where it is seized of a case relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings] before the European Patent Office or a national authority;
- (b) where it is seized of a case relating to a supplementary protection certificate which is also the subject of proceedings before the European Patent Office or before a national court or authority;
- (c) where an appeal is brought before the Court of Appeal against a decision or order of the Court of First Instance
 - (i) disposing of the substantive issues in part only,
 - (ii) disposing of an admissibility issue or a Preliminary objection;
 - (iii) dismissing an application to intervene [Rule 405];
- (d) at the joint request of the parties;
- (e) pursuant to Rule 35
- (f) pursuant to Rule 118
- (g) in particular cases where the proper administration of justice so requires.

[CST RoP Article 71]

Rule 371 – Duration and effects of a stay of proceedings

1. The stay of proceedings shall take effect on the date indicated in the order to stay or, in the absence of such an indication, on the date of that order.
2. Where the order to stay does not fix the length of the stay, it shall end on the date indicated in the order to resume proceedings or, in the absence of such indication, on the date of the order to resume.
3. While proceedings are stayed, time shall cease to run for the purposes of procedural periods. Time shall begin to run afresh for the purposes of procedural periods from the date on which the stay of proceedings comes to an end.

[CST RoP Article 72]

Rule 372 – Resumption of proceedings

Any decision referred to in Rule 371.2 or ordering the resumption of proceedings before the end of the stay shall be made by reasoned order of the judge-rapporteur after hearing the parties. The judge-rapporteur may refer the matter to the panel.

[CST RoP Article 71]

CHAPTER 5 – TIME PERIODS

Rule 380 – Calculation of periods

Any period of time prescribed by the Agreement, the Statute or these Rules of Procedure for the taking of any procedural step shall be laid down in terms of full days, weeks, months or years and shall be reckoned as follows:

- (a) computation shall start on the day following the day on which the relevant event occurred;
- (b) when a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month;
- (c) when a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month;
- (d) when a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred;
- (e) periods of more than 7 days shall include official holidays of the Contracting Member State in which the division concerned or the Court of Appeal is located, Sundays and Saturdays;
- (f) periods shall not be suspended during the judicial vacations.

[RoP CST Article 100, EPC Rule 131]

Rule 381 – Extension and shortening of periods

1. If a period expires on a Saturday, Sunday or official holiday of the Contracting Member State in which the division concerned or the Court of Appeal is located, it shall be extended until the end of the first following working day.
2. Paragraph 1 shall apply *mutatis mutandis* if documents filed in electronic form cannot be received by the Court.
3. On a reasoned request by a party or on its own motion, the Court may shorten a period which has not yet started by way of reasoned order. The order shall specify the shortened period and shall have immediate effect.

CHAPTER 6 – PARTIES TO PROCEEDINGS

SECTION 1 – PLURALITY OF PARTIES

Rule 390 – Plurality of plaintiffs or patents

1. The Court may order that proceedings commenced by a plurality of plaintiffs or in respect of a plurality of patents be heard in separate proceedings.
2. Where the Court orders a separation of proceedings the Court shall decide on the payment of a new court fee (or court fees) in accordance with Part 6.

[EPLA RoP §14]

Rule 391 – Plurality of defendants

1. Proceedings may be started against a plurality of defendants, provided that the claims against them are based on the same patent (or patents) and sufficiently related to justify a common decision.
2. If the Court is of the opinion that the requirement in paragraph 1 is not met, it may separate the proceedings in two or more separate proceedings against different defendants.
3. Where the Court orders a separation of proceedings under paragraph 2, the plaintiffs in the new proceedings shall pay a new court fee in accordance with Part 6, unless the Court decides otherwise.

[EPLA RoP §15]

Rule 392 – Court fees in case of plurality of parties

1. If and as long as a plurality of parties in a case are represented by one and the same representative and take the same position, they shall be regarded as one party as far as the payment of court fees is concerned.

SECTION 2 – CHANGE IN PARTIES

Rule 395 – Change in parties

1. The Court may, on application by a party, order a person to
 - (a) be added as a party,
 - (b) cease to be a party,
 - (c) be substituted for a party.
2. The Court shall invite other parties to the proceedings to comment on the application, as soon as practicable after service of the application.
3. When ordering that a person shall become a party or shall cease to be a party, the Court may make appropriate orders as to payment of court fees and costs as regards such party.

[EPLA RoP §18]

Rule 396 – Consequences for the proceedings

1. Where the Court orders that a party be added, removed or substituted under Rule 395.1, it shall give directions to regulate the consequences as to case management.
2. The Court shall also determine the extent to which a new party is bound by the proceedings as then constituted.

[EPLA RoP §19]

SECTION 3 – DEATH, DEMISE OR INSOLVENCY OF A PARTY

Rule 400 – Death or demise of a party

1. If a party dies or ceases to exist during proceedings, the proceedings shall be stayed until such party is replaced by his successor or successors. The Court may specify a period in this respect.
2. If there are more than two parties to the proceedings, the Court may decide that
 - (a) proceedings between the remaining parties be continued separately and
 - (b) the stay shall only concern the proceedings regarding the party that no longer exists.
3. If the successor or successors of the party that died or ceased to exist does not or do not continue the proceedings of his or their own motion, within a period specified by the Court, any other party may, of its own motion or on an order of the Court, file continuation proceedings against such successor or successors.
4. Continuation proceedings shall be brought before the Court in accordance with Part 1. The Court shall decide whether, and if so, to what extent, the successor or successors will take the position of the defendant who has died or ceased to exist in the main proceedings.
5. The costs of continuation proceedings shall be decided independently from the costs of the main proceedings and solely on the basis of the outcome of the continuation proceedings.

[EPLA RoP §20]

Rule 401 – Insolvency of a party

1. If a defendant becomes insolvent under the national law of his residence or principal place of business or, in the absence of residence or principal place of business, place of business proceedings may be stayed until the competent national authority or person dealing with the insolvency has decided whether to continue the proceedings or not.
2. The plaintiff may withdraw the case against an insolvent defendant in accordance with Rule []. Such withdrawal shall not prejudice the case against other defendants.
3. Any costs order in favour of an insolvent party under Rule [] shall be payable to the competent national authority or person dealing with the insolvency.
4. If proceedings are continued, the effect of a decision of the Court as regards the insolvent party in the case shall be determined by the national law of that party.

[EPLA RoP §21]

SECTION 4 – TRANSFER OF PATENT

Rule 402 – Transfer of the patent or patent application during proceedings

1. If a patent or patent application is transferred, for one or more Contracting Member States, to another proprietor after proceedings have been started before the Court, the Court may authorise the new proprietor to take over the proceedings to the extent that the patent has been transferred to him.
2. If the new proprietor takes over the proceedings, no new court fee shall be payable, even if the new proprietor is represented by a new representative.
3. If the new proprietor chooses not to take over the proceedings, any decision in proceedings that have been recorded in the Register shall be binding upon him.

[EPLA RoP §22]

SECTION 5 – INTERVENTION

Rule 405 – Application to intervene

1. An Application to intervene may be lodged at any stage of the proceedings before the Court of First Instance by any person establishing an interest in the result of a case submitted to the Court (hereinafter "the intervener").
2. An Application to intervene shall be admissible only if it is made in support, in whole or in part, of a claim, order or remedy sought by one of the parties and is made before the closure of the written procedure unless the Court orders otherwise.
3. The intervener shall be represented in accordance with Article 28 of the Agreement.
4. The *Application to intervene shall contain
 - (a) a reference to the case number of the file,
 - (b) the names of the intervener and of the intervener's representative, as well as postal and electronic addresses for service and the names of the persons authorised to accept service,
 - (c) the claim, order or remedy sought by the intervener,
 - (d) a statement of the facts establishing the right to intervene under paragraphs 1 and 2.

[CJEU Statute Article 40, CST RoP Articles 109+110(4), EPLA RoP §§163+164]

[To be developed: provisions on fee, formalities examination, admissibility]

** An on-line form will be available to guide parties.*

Rule 406 – Order on Application to intervene

The judge-rapporteur shall decide on the Application to intervene by way of order. The other parties shall be given an opportunity to be heard beforehand.

[CST RoP Article 109(6)]

Rule 407 – Statement in intervention

1. If an Application to intervene is admissible, the judge-rapporteur or the presiding judge shall
 - (a) inform the parties to proceedings and
 - (b) specify a period within which the intervener may lodge a Statement in intervention.
2. The Registry shall as soon as practicable serve on the intervener any written pleading served by the parties. On a reasoned request by a party the Court may for the protection of confidential information order that a pleading or part of a pleading be disclosed only to certain named persons and subject to appropriate terms of non-disclosure.
3. The *Statement in intervention shall contain
 - (a) a statement as to the issues involving the intervener and one or more of the parties, and their connection to the matters in dispute,
 - (b) the arguments of law,
 - (c) the facts and evidence relied on.
4. The intervener shall be treated as a party, unless otherwise ordered by the Court.
5. The intervener shall not be heard with arguments as to fact or law which are contrary to the pleadings of the main parties (Rule 405.2).

[CST RoP Article 110, EPLA RoP §165]

** An on-line form will be available to guide parties.*

Rule 408 – Invitation to intervene

1. The judge-rapporteur or the presiding judge may, of his own motion or on a reasoned request from a party, invite any person concerned by the outcome of the dispute to inform the Court, within a period to be specified, whether he wishes to intervene in the proceedings.
2. If the person wishes to intervene, he shall present his Statement in intervention within one month of service of the invitation. Rule 405.3 and .4 and Rule 407 shall apply *mutatis mutandis*.

[CST RoP Article 111, EPLA RoP §163]

Rule 409 – No Appeal against an order on the Application to intervene

1. There shall be no right to appeal from an order refusing an Application to intervene.

[CJEU Statute Article 57(2), EPLA RoP §172]

SECTION 6 – RE-ESTABLISHMENT OF RIGHTS

Rule 420 – Re-establishment of rights

1. Where a party has failed to observe a time-limit under these Rules of Procedure or by the Court for a cause which, despite all due care having been taken by the party, was outside his control and the non-observance of this time limit has had the direct consequence of causing the party to lose a right or means of redress, the relevant panel of the Court may upon the request of that party re-establish the right or means of redress.

2. The *Application for Re-establishment of rights shall be lodged with the Registrar for the relevant panel within one month of the removal of the cause for non-observance of the time-limit. Within that time-limit a fee for a Request for Re-establishment of rights fixed under Rule 500 shall be paid.

3. The Application shall

(a) state the grounds on which it is based and shall set out the facts on which it relies,

(b) contain the evidence relied on in the form of affidavits from all persons involved in the non-observance of the time-limit and the persons involved in establishing the precautionary measures of due care taken in order to avoid such cases of non-compliance.

4. The omitted act shall be performed or completed together with Application for Re-establishment within the time-limit mentioned in paragraph 2 of this Rule.

5. There shall be no grant of Re-establishment of rights in respect of the non-observance of the time limit mentioned in paragraphs 2 and 4 of this Rule.

6. The panel shall decide on the Application for Re-establishment of rights by way of order. The other parties shall be given an opportunity to be heard beforehand.

7. There shall be no right to appeal from an order rejecting an Application for Re-establishment of rights.

* An on-line form will be available to guide parties.

CHAPTER 7 – MISCELLANEOUS PROVISIONS ON LANGUAGES

Rule 421 – Request by both parties to use of the language in which the patent was granted as language of the proceedings

[FOR DISCUSSION]

Rule 423 – Request by one party to use the language in which the patent was granted as language of the proceedings

1. If a party wishes to use the language in which the patent was granted as language of the proceedings, in accordance with Article 29(4a) of the Agreement, the party shall include such request in the Statement of Claim, in the case of a plaintiff, or in the Statement of Defence, in the case of a defendant and the pleading shall be lodged with the President of the Court of First Instance together with an *Application for such a change.
2. The President shall invite the other party to indicate, within 10 days, its position on the use of the language in which the patent was granted as language of the proceedings.
3. The President, having consulted the panel of the division, may order that the language in which the patent was granted shall be the language of the proceedings and may make the order conditional on specific translation or interpretation arrangements.

Relation with draft Agreement: Article 29(4a)

* An on-line form will be available to guide parties.

Rule 424 – Consequences where the language of the proceedings is changed in the course of the proceedings

1. An Application under Rule 421.1 or 423.1 shall specify whether existing pleadings and other documents should be translated and at whose cost. If the parties cannot agree the judge-rapporteur or the President of the Court of First Instance, as the case may be, shall decide in accordance with Rule 421.6 or Rule 423.3.

[to be developed, see Rules 37 and 109]

**An on-line form will be available to guide parties.*

CHAPTER 8 – CASE MANAGEMENT (Measures of organisation of procedure)

[Article 24 draft Agreement, CST RoP Part 2, Chapter 3]

Rule 431 – Responsibility for case management

1. During the written procedure and the interim procedure, case management shall be the responsibility of the judge-rapporteur subject to Rules 102 and 433.
2. The judge-rapporteur may refer a proposed order to the panel.
3. After the closure of the interim conference in view of the oral hearing, case management shall be the responsibility of the presiding judge.
4. The Registry shall serve any case management orders on the parties as soon as practicable after the decision of the judge-rapporteur or panel.

[EPLA RoP §33, CST RoP Article 56]

Rule 432 – General principles of case management

Active case management includes

- (a) encouraging the parties to co-operate with each other during the proceedings;
- (b) identifying the issues at an early stage;
- (c) deciding promptly which issues need full investigation and disposing summarily of other issues;
- (d) deciding the order in which issues are to be resolved;
- (e) encouraging the parties to make use of the patent mediation and arbitration centre and facilitating the use of the centre;
- (f) helping the parties to settle the whole or part of the case;
- (g) fixing timetables or otherwise controlling the progress of the case;
- (h) considering whether the likely benefits of taking a particular step justify the cost of taking it;
- (i) dealing with as many aspects of the case as the Court can on the same occasion;
- (j) dealing with the case without the parties needing to attend in person;
- (k) making use of available technical means; and
- (l) giving directions to ensure that the hearing of the case proceeds quickly and efficiently.

[EPLA RoP §36]

Rule 433 – Review of case management orders

1. Case management orders made by the judge-rapporteur or the presiding judge shall be reviewed by the panel, on a reasoned application by a party.
2. An application for the review of a case management order shall be lodged within two weeks of service of the order. The Application shall set out the grounds for review and the evidence, if any, in support of the grounds. The other party shall be given an opportunity to be heard.
3. The party seeking a review shall pay the fee for the review of a case management order, in accordance with Part 6. Rule 13.2 shall apply *mutatis mutandis*.

[EPLA RoP §34]

4. The panel shall as soon as practicable decide the application for review and make any necessary revised case management order.

Rule 434 – Case management powers

Except where the Agreement, the Statute, or these Rules of Procedure provide otherwise, the judge-rapporteur, the presiding judge or the panel may

- (a) extend or shorten the period for compliance with any rule, practice direction or order;
- (b) adjourn or bring forward the interim conference or the oral hearing;
- (c) communicate with the parties to instruct them about wishes or requirements of the Court;
- (d) direct a separate hearing of any issue;
- (e) decide the order in which issues are to be decided;
- (f) exclude an issue from consideration;
- (g) dismiss or decide on a claim after a decision on a preliminary issue makes a decision on further issues irrelevant to the outcome of the case.
- (h) dismiss a pleading summarily if it has no prospect of succeeding,
- (i) consolidate any matter or issue or order them to be heard together,
- (j) make any order pursuant to Rules 103 to 109.

[EPLA RoP §37+43]

Rule 435 – Varying or revoking orders

A power of the Court to make a case management order includes a power to vary or revoke such order.

[EPLA RoP §38]

Rule 436 – Exercise of managing powers

The Court may exercise its case management powers on the application by a party or of its own motion, unless otherwise provided.

[EPLA RoP §39]

Rule 437 – Orders of the Court's own motion

Where the judge-rapporteur or the presiding judge proposes to make an order of his own motion, he may give the parties and any person likely to be affected by the order an opportunity to be heard within a period to be specified.

[EPLA RoP §40]

Rule 439 – Orders made without hearing the parties

1. Subject to Article 34a(2) of the Agreement the Court may make an order of its own motion without hearing the parties.
2. Any order under paragraph 1 shall include information concerning the right to apply to have it set aside, modified or stayed and specify a period for lodging the application.
3. Any party affected by the order may apply to have it set aside, modified or stayed.

[EPLA RoP §42]

Rule 440 – Connection — Joinder

1. In the interests of the proper administration of justice, a presiding judge of the local or regional division where the cases are pending (after consultation with any other relevant presiding judge), the President of the Court of First Instance where the cases are in different divisions or the President of the Court of Appeal where the cases are pending may, at any time, after hearing the parties, order that two or more cases shall, on account of the connection between them, be joined. The cases may subsequently be disjoined.

[CST RoP Article 46]

CHAPTER 9 – RULES RELATING TO THE ORGANISATION OF THE COURT

Rule 441 – Precedence

1. With the exception of the President of the Court of Appeal and the President of the Court of First Instance, the judges shall rank in precedence according to their seniority in office.

2. Where there is equal seniority in office, precedence shall be determined by age.
3. Retiring judges who are reappointed shall retain their former precedence.
4. Unless otherwise agreed by the panel the most senior judge shall be the presiding judge.

[RoP EU CST Rule 5]

Rule 442 – Dates, times and place of the sittings of the Court

1. The dates and times of the sittings of the Court shall be fixed by the President of the Court of Appeal, on a proposal from the Presidium.
2. The Court may choose to hold one or more particular sittings in a place other than that in which it has its seat.

[Article 11 draft Statute] [CST RoP Article 23]

Rule 443 – Order in which cases are to be dealt with

1. The Court shall deal with the cases before it in the order in which they become ready for hearing.
2. The presiding judge of a local or regional division, the President of the Court of First Instance or the President of the Court of Appeal may
 - (a) direct that a particular case be given priority and that time limits provided for in these Rules be shortened;
 - (b) after hearing the parties, in particular with a view to facilitating an amicable settlement of the dispute, either on his own initiative or at the request of one of the parties, defer a case to be dealt with later.

[CST RoP Article 47]

Rule 444 – Deliberations

1. The Court shall deliberate in closed session.
2. The presiding judge shall preside over the deliberations. Only those judges who were present at the oral hearing may take part in the deliberations.
3. Every judge taking part in the deliberations shall state his opinion and the reasons for it. The conclusions reached by the majority of the judges after final discussion shall determine the decision of the Court. Votes shall be cast in reverse order to the order of precedence under Rule 440. Differences of view on the substance, wording or order of questions, or on the interpretation of a vote, shall be settled by decision of the Court. In the event of an equality of votes on any issue the presiding judge shall have a deciding vote.
4. The deliberation of the Court shall take place as soon as possible after the closure of the oral hearing.

[CST RoP Article 27, EPLA RoP §65]

Rule 445 – Composition of panels and assignment of cases

[To be developed]

Relation with draft Statute: Article 14

To be developed

- Decision of the Presidium in case of difficulty in the context of Article 5(5) draft Statute (impartiality or integrity of judges)

CHAPTER 10 – DECISIONS AND ORDERS

Rule 450 – Decisions

1. Any decision shall contain

- (a) the statement that it is a decision of the Court,
- (b) the date of its delivery,
- (c) the names of the presiding judge, the judge-rapporteur and other judges taking part in it,
- (d) the names of the parties and of the parties' representatives,
- (e) an indication of the claim, order or remedy sought by the parties,
- (f) a summary of the facts,
- (g) the grounds for the decision,

2. The order of the Court consequential upon the decision (other than costs) including any order giving immediate effect to an injunction, shall be appended to the decision. The Order shall comply with Rule 451.

[3. The Court shall endeavour to give a decision without dissenting opinion.

4. The decision of the Court of First Instance shall contain a summary of the requests and facts [submitted by the parties and a statement of the facts and arguments on which the Court bases its decision] OR: [sufficient to enable the Court of Appeal to decide the case on appeal if it differs from the conclusions reached by the Court of first instance].

5. Decisions shall be recorded in the Register.

[Article 34(4) draft Statute] [CST RoP Article 79, EPLA RoP §96, CJEU Statute Articles 36+37]

Rule 451 – Orders

1. Every order shall contain

- (a) the statement that it is an order of the judge-rapporteur, of the presiding judge, of a President of the Court or of the Court,
- (b) the date of its adoption,
- (c) the names of any judge taking part in its adoption,
- (d) the names of the parties and of the parties' representatives,
- (e) the operative part of the order.

2. Where, in accordance with these Rules, an order must be reasoned, it shall in addition contain:

- (a) a statement of the forms of order sought by the parties,
- (b) a summary of the facts,
- (c) the grounds for the order.

Rule 452 – Binding effect

Subject to Art. 118.9 decisions and orders of the Court of First Instance shall be enforceable from the date of their delivery and, where ordered, at the date of the rendering of a security. Decisions and orders may be subjected to the rendering of a security by a party (or parties) to the other party (or parties) for legal costs and other expenses and compensation for any damage incurred or likely to be incurred by the other party (or parties) if the decisions and orders are subsequently revoked.

[CST RoP Article 83(1)]

Rule 453 – Rectification of decisions

The Court may, by way of order, of its own motion or on application by a party made within one month of service of the decision to be rectified, after hearing the parties, rectify clerical mistakes, errors in calculation and obvious slips in the decision.

[CST RoP Article 84(1)]

Rule 454 – List of experts

[To be developed: call for candidates, criteria, selection procedure, decision to include on list, maintenance of list, availability, term, termination, exclusion, ...]

Relation with draft Agreement: Article 36(2)

CHAPTER 11 – DECISION BY DEFAULT

Rule 455 – Decision by default (Court of First Instance)

1. If a defendant on whom a Statement of claim has been duly served fails to lodge a Statement of defence or Counterclaim for revocation or if a plaintiff on whom a Counterclaim for revocation has been duly served fails to lodge a Reply to Counterclaim, in any case within the time limit set according to these Rules, the Court of First Instance may give decision by default.

2. A decision by default shall be enforceable. The Court may, however,

(a) grant a stay of enforcement until it has given its decision on any Application under Rule 456, or

(b) make enforcement subject to the provision of security; this security shall be released if no Application is made or if the Application fails.

[CST RoP Article 116(1)(2)(3), EPLA RoP §118]

Rule 456 – *Application to set aside a decision by default

1. The defendant may lodge an Application to set aside to a decision by default within one month of service of the decision by default.

2. The *Application to set aside a decision by default shall comply with the requirements of Rule 22 or Rule 28 as the case may be together with the party's explanation for the default. In addition, it shall mention the date and number of the decision by default. The defendant shall pay a fee for the Application to set aside the decision by default [**EUR].

3. The proceedings shall be conducted in accordance with Part 1.

4. The decision of the Court shall be annexed to the decision by default. A note of the decision on the Application to set aside the decision by default shall be included in any publication of the decision by default.

Relation with draft Statute: Article 36

[CJEU Statute Article 41, EPLA RoP §119, CST RoP Article 116(4)-(6)]

** An on-line form will be available to guide parties.*

*** Tentative level included for illustrative purposes only, without prejudice to the decision of the Administrative Committee under Article 18(3) of the Agreement.*

Rule 457 – Decision by default (Court of Appeal)

1. Rules 455 and 456 shall apply *mutatis mutandis* where a respondent on whom a Statement of appeal and a Statement of the grounds of appeal have been duly served fails to lodge a Statement of response.
2. If the respondent fails to lodge a Statement of response and fails to lodge an Application to set aside pursuant to Rule 456 the Court of Appeal shall consider the merits of the appeal and if the appeal is well-founded it shall give a reasoned decision.

CHAPTER 12 – ACTIONS BOUND TO FAIL OR MANIFESTLY INADMISSIBLE

Rule 460 – No need to adjudicate

If the Court finds that an action has become devoid of purpose and that there is no longer any need to adjudicate on it, it may at any time, of its own motion, after giving the parties an opportunity to be heard, dispose of the action by way of order.

[CST RoP Article 75]

Rule 461 – Action manifestly bound to fail

Where it is clear that the Court has no jurisdiction to take cognisance of an action or of certain of the claims therein or where the action is, in whole or in part, manifestly inadmissible or manifestly lacking any foundation in law, the Court may, after giving the parties an opportunity to be heard give a decision by way of order.

[CST RoP Article 76]

Rule 462 – Orders dismissing manifestly inadmissible claims

1. Orders under Rules 460 and 461 shall be taken by the full panel upon the recommendation of the judge-rapporteur.
2. Where the decision is taken by the Court of First Instance, it is a final decision within the meaning of Rule 251.1(a).

Rule 463 – Absolute bar to proceeding with an action

The Court may at any time, of its own motion, after giving the parties an opportunity to be heard, decide that there exists an absolute bar to proceeding with an action, for example because of the application of the principle of *res judicata*. The Court shall give its decision by way of a reasoned judgement.

[CST RoP Article 77]

CHAPTER 13 – SETTLEMENT

Rule 470 – Confirmation by the Court of a settlement

1. Where the parties have concluded their case by way of settlement, they shall inform the judge-rapporteur. At the request of the parties the panel shall confirm the settlement by decision of the Court (Rule 9.2).
2. At the request by the parties, the decision of the Court shall set out the terms of the settlement pursuant to Rule 9.2. The decision may be enforced as a final decision of the Court.
3. The case shall be removed from the Register.
4. The presiding judge shall give a decision as to costs in accordance with the terms of the settlement or, failing that, at his discretion.

*Relation with draft Agreement: Article 52
[Directive 2008/52/EC, CST RoP Article 69]*

PART 6 – FEES AND LEGAL AID

COURT FEES

Rule 500 – Court fees

1. Court fees provided for in these Rules of Procedure shall be shall be paid to the Court. They shall be levied in accordance with the provisions contained in this Part.

2. The court fees to be paid to the Court shall be as follows:

(a) Fixed fees, in **EUR

Court of First Instance

Fee for infringement action:

Fee for counterclaim for revocation:

Fee for revocation action:

Fee for counterclaim for infringement:

Fee for declaration of non-infringement:

Fee for action against a decision of the European Patent Office:

Fee for application to preserve evidence:

Fee for application for provisional measures:

Fee for application for damages:

Fee for application of re-establishment of rights

Fee for application to prolong the period for a protective letter to be kept on the Register

Court of Appeal

Fee for appeal against final decision:

Fee for appeal against interlocutory order:

Fee for lodging a protective letter:

Fee for rehearing:

(b) Value-based fees in **EUR

Value in dispute in EUR

Fees

Rule 501 – Time periods for paying court fees

1. The fixed fees shall be paid in advance ...
2. Proof of payment shall be provided together with the initial pleading.
3. The value-based fees shall be paid within 10 working days of service of the order determining the value of the dispute in accordance with Rules 20.1, 57.1 and 68.1.
4. Where an Application for legal aid has been lodged in accordance with Rule 507, Rules 13.2, 44, 52, 67, 91, 192, 206, 264 and 300 shall not apply.

[To be further developed]

Relation with draft Agreement: Article 43(2)

Rule 502 – Reimbursement of court fees

[To be developed]

LEGAL AID

Rule 505 – Right to legal aid [TO BE CONSIDERED SEPARATELY]

A natural person is entitled to legal aid where

- (a) it does not have access to the necessary means and
- (b) its claim and/or defence appear to have a reasonable prospect of success after hearing the other party.

Rule 506 – Extent

1. Legal aid comprises
 - (a) a dispensation from court fee;
 - (b) a dispensation from the obligation to advance costs;
 - (c) the appointment of a representative by the Court; a representative can already be appointed to prepare proceedings.
2. Legal aid can be granted completely or partially.
3. Legal aid does not dispense from the obligation to compensate the successful party's costs.

Rule 507 – Application and procedure

1. An Application for legal aid may be lodged before or after proceedings have been started.
2. An applicant for legal aid must present evidence relating to his income and assets and set out his case.
3. The Court shall rule on the Application for legal aid in *[summary proceedings]*. The other party may be heard. The other party shall be heard where the Court envisages dispensing the applicant from providing security for the award of compensation for costs made in favour of that party.
4. For an appeal, a new Application for legal aid must be lodged.

Rule 508 – Revocation of legal aid

The Court shall revoke legal aid where entitlement has elapsed or never existed.

Rule 509 – Appeal

A decision completely or partially refusing or revoking legal aid may be appealed.

Rule 510 – Liquidation of the costs of the proceedings

1. If the party granted legal aid is not successful, the costs of the litigation are liquidated as follows:
 - (a) the representative is appropriately compensated by the Court;
 - (b) the court fees are borne by the Court;
 - (c) advances made by the opposing party are restituted;
 - (d) the party granted legal aid must compensate the successful party's costs.
2. If a party granted legal aid is successful and it does not appear likely that the costs awarded against the other party will be paid, the Court remunerates appropriately the representative who acted for the party that was granted legal aid.

Rule 511 – Reimbursement of legal aid

A party that has been granted legal aid must make repayment as soon as it is in a position to do so.
