

EPLAW Congress

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RULE 14 – LANGUAGE OF PROCEEDINGS

Rule 14 – Language of the Statement of claim

1. Without prejudice to Article 49(3)(4) and (6) of the Agreement and subject to Rule 14.2 the Statement of claim shall be drawn up
 - (a) in the official language or one of the official languages designated as language(s) of proceedings pursuant to Article 49(1) of the Agreement or
 - (b) in one of the languages designated as language(s) of proceedings pursuant to Article 49(2) of the Agreement.
2. Where a Contracting Member State hosting a local division or Contracting Member State sharing a regional division has/have designated two or more languages of proceedings pursuant to Article 49(1) and/or Article 49(2) of the Agreement the Statement of claim shall be drawn up in the language in which the defendant normally conducts its business in its Contracting Member State.
3. Subject to Article 49(5) and Rules 321 to 323 the language of the Statement of claim shall be the language of proceedings and without prejudice to Rule 16.5 the Registry shall return any pleading lodged in a **language** other than the language of the proceedings.

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Choice of Language(s): The current position

- Local divisions (language(s)):
 - Italy (Italian), England and Wales (English), The Netherlands (Dutch and English), France (French), German x 4 (German and English), Belgium (Dutch, French, German and English)
- Suspected Regional Divisions (languages(s)):
 - Romania, Bulgaria, Cyprus, Greece and [Slovenia] (all official languages plus French and English)
 - Denmark, Sweden, Finland, Estonia, Latvia and Lithuania (English only)
 - Hungary, Czech Republic, Slovakia and [Slovenia] (unknown)
- No participation in either a local or regional division:
 - Malta and Luxembourg – results in donation of jurisdiction to the Central Division
- Undecided:
 - Poland (has not yet signed Agreement), Portugal, Austria, Ireland (English) and Scotland (English)

Choice of Language(s): Views

- Article 14(2) as currently drafted is inadequate
- General support for claimant's choice and translation of Statement of Claim if requested plus extension of time
- However some further relaxation may be politically necessary:
 - If purely local infringement; or
 - In a regional division where the local companies forced to use language which is not their native language

AMICUS BRIEF – SUGGESTED RULE 318

1. In cases involving legal questions of general importance the Court of First Instance or the Court of Appeal may invite any person or legal entity concerned by that legal question to file a brief as amicus curiae.
2. The invitation may be posted on the Court's webpage and shall include:
 - (a) the legal question of interest;
 - (b) a time limit for filing; and
 - (c) limits of scope.
3. Rule 313.3 shall apply mutatis mutandis. (representation pursuant to Article 48)
4. The Amicus curiae brief shall contain
 - (a) a reference to the action number of the file;
 - (b) the name of the amicus curiae and of the amicus curiae's representative,
 - (c) comments solely within the admitted scope.
5. Amicus curiae briefs which are not in compliance with Rule 318.4 or filed later than the deadline of Rule 318.2(b) may be disregarded by the Court."

AMICUS BRIEF - Views

- **General consensus against such a rule**
 - **Need to disclose to parties and obtain responses – delay**
 - **Suspicion of allied interests**

BIFURCATION – ARTICLE 33(3)

- 3) A counterclaim for revocation as referred to in Article 32(1)(e) may be brought in the case of an action for infringement as referred to in Article 32(1)(a). The local or regional division concerned shall, after having heard the parties, have the discretion either to:
- a) proceed with both the action for infringement and with the counterclaim for revocation and request the President of the Court of First Instance to allocate from the Pool of Judges in accordance with Article 18(3) a technically qualified judge with qualifications and experience in the field of technology concerned.
 - b) refer the counterclaim for revocation for decision to the central division and suspend or proceed with the action for infringement; or
 - c) with the agreement of the parties, refer the case for decision to the central division.

BIFURCATION – RULES OF PROCEDURE

Rule 37 – Application of Article 33(3) 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 33(3) of the Agreement. The parties shall be given an opportunity to be heard [Rule 264].
2. The panel may by order take an earlier decision if appropriate having considered the parties' pleadings and having given the parties an opportunity to be heard [Rule 264]
3. Where the panel decides to proceed in accordance with Article 33(3)(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 Rules 33 and 34.
4. Where the panel decides to proceed in accordance with Article 33(1)(b) of the Agreement, the panel may stay the infringement proceedings pending a final decision in the revocation procedure and **shall** stay the infringement proceedings where there is a **high likelihood** that the relevant claims of the patent (or patents) will be held to be invalid **on any ground** by the final decision in the revocation procedure.

BIFURCATION – RULES OF PROCEDURE RULE 118

3. If a revocation action is pending before the central division **or an opposition is pending before the European Patent Office**, the local or regional division:
 - a) may render its decision on the merits of the infringement claim, including its orders, under the condition subsequent pursuant to Article 56(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 a final decision of the European Patent Office or under any other term or condition, or
 - b) may stay the infringement proceedings pending a decision in the revocation procedure or a decision of the European Patent Office and **shall** stay the infringement proceedings if it is of the view that there is a **high likelihood** that relevant claims of the patent (or patents) will be held to be invalid **on any ground** by the final decision in the revocation procedure or of the European Patent Office.

BIFURCATION – RELEVANT CONSIDERATIONS? NO 1

1. Whether referring the counterclaim for revocation for decision to the central division is likely to result in a mis-match between the timing of hearings and determinations in the infringement and revocation proceedings;
2. Whether amendments of the patent claims are sought;
3. Whether the patent is technically complex;
4. Whether the parties agree or the referring court decides to stay infringement proceedings pending revocation proceedings; and
5. Whether this case raises novel points of law.”

BIFURCATION – RELEVANT CONSIDERATIONS? NO 2

1. Whether referring the counterclaim for revocation to the central division will involve duplicative consideration of evidence or issues, or other unnecessary or increased costs;
2. Whether amendments to the patent are likely to be sought (in which case infringement and validity should normally be considered together);
3. Whether the patent is technically complex, such that the presence of a technical judge on the panel would be beneficial in relation to both infringement and validity issues and the issues should therefore be heard together;
4. Whether it appears to the Court that the Defendant has pleaded that there is a “squeeze” between validity and infringement;
5. Whether hearing infringement and validity separately would cause the two parts of the case to be heard in different languages;
6. Whether the parties have agreed their preferred approach as to how the case should be managed under Article 33

STAY FOLLOWING BIFURCATION

The “high likelihood” test should be replaced by:

- i. reasonable likelihood and “in this context reasonable likelihood means that the legal challenge against the validity of the patent must be more likely than not to succeed; a predominant likelihood that the patent will be revoked is not required”
- ii. clear possibility
- iii. real possibility
- iv. possibility

BIFURCATION - Views

- General consensus that bifurcation will be limited
- Not necessary to set out discretionary considerations in the Rules of Procedure
- Support for “reasonable likelihood” test rather than the “high likelihood” test
- Stays pending an EPO decision should only be granted if the decision is imminent

PROVISIONAL MEASURES

ARTICLE 62

Provisional and protective measures

- (1) The Court may, by way of order, grant injunctions against an alleged infringer or against an intermediary whose services are used by the alleged infringer, intended to prevent any imminent infringement, to prohibit, on a provisional basis and subject. Where appropriate, to a recurring penalty payment, the continuation of the alleged infringement or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the right holder.
- (2) The Court shall have the discretion to weigh up the interests of the parties and in particular to take in account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.
- (4) The Court may, in respect of the measures referred to in paragraphs 1 and 3, require the applicant to provide any reasonable evidence in order to satisfy itself with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed, or that such infringement is imminent.
- (5) Article 60(5) to (9) shall apply by analogy to the measures referred to in this Article.

PROVISIONAL MEASURES – RULES OF PROCEDURE

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 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;
 - (d) make an interim award of costs.
2. In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, **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.

PROVISIONAL MEASURES – RELEVANT INTERESTS OF PARTIES?

1. In exercising its discretion and taking its decision on the Application for provisional measures, the Court shall, in addition to any matters submitted to it in accordance with Rules 206-210, weigh up the interests of the parties and in particular shall take into account:
 - a) the potential harm for either of the parties resulting from the granting or the refusal of the provisional measures;
 - b) whether damages and/or other monetary compensation would adequately compensate either party for the wrongful granting or refusal of the provisional measures;
 - c) any delay in seeking the provisional measures and whether this was justified, particularly in cases where the respondent/defendant has not been heard; and
 - d) the public interest in the granting of the provisional measures.”

PROVISIONAL MEASURES: VIEWS

- The reference to “validity” in Rule 211.2 should remain
- The discretionary criteria should not be listed in the Rules of Procedure
- The Court of Appeal should have power to grant leave to appeal a procedural order (Rule 220.2)

FINAL INJUNCTIONS – RULES OF PROCEDURE

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 63, 64, 66, 67 and 80 of the Agreement the Court may, if requested, order the payment of damages and compensation according to Article 68 and 32(1)(f) of the Agreement. The amount of the damages and the compensation may be stated in the order or determined in separate proceedings (Rules 125-143). 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 352.
2. In appropriate cases and at the request of the party liable to the orders and measures provided for in paragraph 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 party disproportionate harm and if damages and/or compensation to the injured party appear to the Court to be reasonably satisfactory.

FINAL INJUNCTIONS: VIEWS

- Rule 118.2 should be left as is for the Court of Appeal, if necessary, to construe. (Note possibility of a reference to CJEU).
- In any event Rule 118.2 should be “without prejudice” to Article 63 of the Agreement
- No special rules for NPEs

APPEALS: VIEWS

- The Court of First Instance should deal with “all principle points” raised by the parties

EVIDENCE: VIEWS

Rule 175 – Written witness statement

1. A party seeking to offer witness evidence may lodge a written witness statement
 - The party “shall” lodge a written witness statement or at least a written summary of the evidence to be given by the witness.



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