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Dear Colleagues,

Last year I wrote in this Yearbook about the continuing delay in the implementation of both the Community Patent and the European Patent Litigation Agreement (EPLA) projects. Indeed my President's Report at our 2004 Congress had the title “Frustration”.

Well has there been any progress in the following year? The answer is no but there are some signs that progress may be made so far as the EPLA is concerned. At the Judges' Forum in Venice in October (of which more below) a resolution was passed unanimously by the attending Judges which urged the Commission and Member States (and Switzerland and Turkey) to progress the EPLA project now. We hope this resolution will have the desired affect. We also understand that the Commission may be re-considering its opposition. We also sincerely hope this is the case and we await the outcome of the December 2005 meeting of the Council under the British Presidency with interest.

At our Congress in 2004, you approved the spending of EPLAW funds to set up the first Venice Forum of European Patent Judges. After a lot of work, and with the full co-operation of the European Patent Office, this first meeting took place on 14-16 October. I believe it was a great success. One of the positive outcomes was the resolution referred to above. We shall be presenting a fuller account of the Forum at our 2005 Congress on 02 December in Brussels. At this stage I would like simply to record my personal thanks and admiration to Mario Franzosi whose personal dream is such a permanent Forum.

In December 2005 we shall be celebrating our 5th Anniversary. I think that our organisation under its new acronym, EPLAW, has established itself as the credible voice of Europe's leading patent litigators. I would like to thank my fellow Directors for all their contributions over these years.

I look forward to seeing you all in Brussels for our 5th Anniversary celebration.

Yours sincerely

K.M. Mooney
President
EPLA - Brussels 2004
President's Report

Frustration

EPLA - Brussels 2004

Opportunities for one-stop patent litigation at December 2003.

1. Use the provisions of the Brussels Regulation 44/2001 (Reference in GAT v LUK from Dusseldorf Ct)

2. Optional Protocol to EPC

3. Draft Regulation for a Community Patent and Community Patent Court

EPLA - Brussels 2004
What has happened?

1. A - G Gescheidt's Opinion in GAT v LUK
   - pure infringement actions possible - no change
   - pure invalidity actions not possible - no change
   - infringement action with impure (bad faith) validity defences can proceed
   - infringement action with pure (good faith) validity defences - may or may not proceed
   - How is purity to be tested and by which Court?

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EPLA - Brussels 2004
What has happened?

2. Optional Protocol to EPC (or European Patent Litigation Agreement)
   a. Background - Inter-Governmental Conference on EPO in Paris, June 1999
   c. Where currently stands
      - Last draft Nov. 2003

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EPLA - Brussels 2004
What has happened?

3. Commission Draft Regulation for a Community Patent
   a. Background
      - December 1998 - First Community Patent Convention - not ratified
      - March 2000 - Lisbon Summit proposes new Community Patent System
      - July 2001 - Commission publishes draft Regulation
      - August 2003 - Commission publishes "working agreement" on Community Patent Jurisdiction
      - March 2003 - Council "common political approach"
      - December 2003 - Detailed Proposals for Council Decision on Jurisdictional arrangements

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EPLA - Brussels 2004

- CONTroversy - FOLLOWING THE COMMON POLITICAL APPROACH of March 2003
  - Language of Litigation - The Defendant's language
  - Translation of Claims - All official EU languages
  - Effect of Translated Claims - Time to translate 3 months, 1 year or 2 years
- OTHER CONTroversial FEATURES
  - Centralised First & Second Instance Courts in Strasbourg (after transitional period in 2003)
  - "Technical Court Experts" (non-voting Assistant Rapporteurs) in proceedings

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WHERE IT STANDS NOW
- November 2003 - Failure to agree on time for translations
- March 2004 - Failure to agree on effect of claim translations
- May 2004 - Competitiveness Council announces further failure to agree

WHAT NEXT?
- Attitude of Dutch Presidency unknown
- Attitude of future Commissioner for Choice unknown
- Outcome of meeting of Council, 04 and 05 November 2004?

EPLA - Brussels 2004
Result = Frustration
- Industry's attitude to CPC
  - Cost of Translation
  - Effect of Claim Translations
  - Language of Proceedings
  - Assumed Rapporteurs
- Attitude of AIPPI, EPLA and Judges to CPC
- Commission's attitude to EPLA
  - Pre-emption
- Effect of A-G's Opinion in GAT—LUK on EPLA proposals
Theor.
Mises on art. 5 under 3 (place) and art. 6 under 1 (link between claims).

Preliminary
What is common policy?
Where is the spider and what is spider in ECH?

Court of Appeal of the Hague: You’re a winner.

France is the only country in Europe to adopt the position and is granted an European injunction against all.

The appeal is refused by the ECH.

The case is now pending in the ECH.
Commission

We do not want EPCA but everything will be resolved if everybody would accept (EU patent policy statement)

More balanced view than UK but

Art 56 (1) EPC national law

Can have common rule but not an application to give European Patent Court interpretative power.

Conclusion in irreconcilable judgments:

But Commission

One advantage that companies have is they can increasingly be represented in the whole of the EU.

Rocca v. Primus 0

Other European

Suits are successful on irreconcilable

There's a new decision on the practical

And this case is the most important case

Rocca v. Primus 1 4
French Government

There is connexity if the defendants belong to the same group, sell the same product according to a common policy. In that case there is clear connection between the claims.

Root 1.2 - Print 1.2
But expandible: Craft vs reason 1.2.4.
Cross border injunctions -
the German approach

presented at
the EPLA Congress
Nov. 8 2004, Brussels

by Dr. Klaus Grabinski,
President Judge,
Düsseldorf District Court

I. Legislation

- Brussels Convention
- Council Regulation (EC) No 44/2001 of
  Dec. 22, 2000 (in force since March 1, 2002)
- Lugano Convention

II. General and special
jurisdictions

- Article 2 (1)
  - General Jurisdiction of the Courts of the state where
    the defendant is domiciled or has his seat.
  - Courts have jurisdiction not only on infringements
    that occurred in the respective state but also on
    infringements that were committed in other Member
    states.
- Art. 5 (3)
  • Special jurisdiction of the courts of the place where the patent infringement occurred (or may occur).
  • Courts have jurisdiction only on patent infringements that occurred in the respective Member state.

- Art. 6 (1)
  • Special jurisdiction of the court where one of a number of defendants is domiciled or has his seat (provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings).
  • Court has jurisdiction on a co-defendant who is not domiciled in the respective state if he has committed the infringement in complicity with a defendant domiciled in the forum state.

III. Exclusive jurisdiction

- Art. 22 (4) [Art. 16 (4)]
  - Nullity action
  • Exclusive jurisdiction in validity proceedings of the courts of the Member state in which the registration of the patent has been applied for or - in case of a European patent - for which the European patent has been granted.
- Parallel pending of infringement and nullity proceedings

- a) Parallel pending only in Germany

  - Typical situation in Germany where different courts have jurisdiction on infringement and validity proceedings.
  - In case parallel court proceedings for patent infringement and validity are pending the infringement court can stay the proceedings until the validity proceedings have been finalised.

- Parallel pending of an infringement proceeding in Germany and a nullity proceeding in another EU-member state

  - German infringement courts are more inclined to stay proceedings with regard to a nullity proceeding pending in another EU-member state in order to prevent irreconcilable evaluations of the patent's validity.
  - A party filing an action for a declaration of non-infringement of a patent cannot rely on his interest in a rapid exequatur if he contests this patent with a nullity action and has thereby created the reason for suspension through his own actions (European Court of Appeals, May 27, 2001, B 305/04, 473).

- If there are parallel infringement and validity proceedings pending concerning a German utility model, the infringement court will be more inclined to order a stay because a German utility model has not been examined before granting.

- The infringement court will order a stay only if it is highly probable that the patent is invalid what has to be shown by the defendant because the patent has already been examined in the granting proceedings.

- If there are parallel infringement and validity proceedings pending concerning a German utility model, the infringement court will be more inclined to order a stay because a German utility model has not been examined before granting.
Nullity defence

- Jurisdiction of the court that has jurisdiction pursuant to Art. 2 (1) or 6 (1) is not negated by the fact that the defendant raises the defence of nullity of the patent - admissible according to the applicable foreign law - in the infringement litigation. (Dusseldorf District Court)

IV. The Gat/LuK-case

- Both parties have their corporate residence in Germany.
- They are competitors in the field of automobile technology.
- The plaintiff is bidding for a contract with the German subsidiary of Ford Motor Company concerning an apparatus for damping torsional vibrations.

- The defendant is holder of several patents in this field.
- The defendant alleges that its patents have been infringed by the plaintiff's bid.
- The plaintiff seeks the defendant for declaration of non-infringement.
Düsseldorf District Court (May 31, 2001, JIC 2003, p. 309):
- The international jurisdiction is not negated by the fact that the plaintiff defends itself against the defendant's allegation of an infringement inter alia by pleading nullity of the patents at issue.
- The action is dismissed, since
  - the contested embodiment implements the technical teaching of the patent and
  - the nullity defense is unfounded.

- Reference for preliminary ruling to the ECJ:
  - Does Art. 16 (4) Brussels Convention apply
  - only for ex aequo procedings that are brought to declare the patent invalid or
  - also for inter partes proceedings where the defendant in a patent infringement action or the claimant in a declaratory action for non-infringement pleads that the patent is invalid or null and that there is no patent infringement for that reason
  - irrespective of whether the court seized of the proceedings considers the plea to be substantiated and
  - irrespective of when the plea is raised during the course of the proceedings.
End of Cross Border Injunctions?

Dr. Jochen Pagenberg
Attorney at Law, Munich/Paris

Insanity Defense

Jurisdiction
Brussels Convention
Res. 31/2011

Injunctions against Injunctions abroad?
COUNCIL REGULATION (EC) No 44/2001 of 22 December 2000

Art. 16 Exclusive jurisdiction

Courts shall have exclusive jurisdiction, regardless of domicile:

4. in proceedings concerned with the validity of patents in the courts of the Contracting State in which the deposit or registration has been applied for.
1. Article 6(1) of the Brussels Convention cannot be interpreted as granting jurisdiction in a case where some of a group of defendants have allegedly infringed a Dutch patent and others a UK patent. Such actions relate to two different rights, even if the patents stem from the same basic patent.

2. Any proceeding for infringement must in England be "concerned with" the validity of the patent, i.e. no conclusion of infringement can be reached without the consideration of validity. Therefore English courts should have exclusive jurisdiction over English patents.

Where it is plain that validity of a foreign patent is to be put in issue, the court should take the course of striking out forthwith the relevant claims of infringement of such foreign patent.


High Court of Justice – Coin Controls v. Suzo 29 IIC 804 (1998)
Brussels Convention on Jurisdiction Arts. 2(1), 16(4) - "Flywheel"

If claims asserted on grounds of infringement of a foreign patent are subject to international jurisdiction pursuant to Art. 2(1) Brussels Convention, this jurisdiction is not negated by the fact that the defendant raises the defense of nullity of the patent - admissible according to the applicable foreign law - in the infringement litigation.

Düsseldorf District Court May 31, 2001

Brussels Convention on Jurisdiction Art. 16(4) - "Flywheel"

Request for Preliminary Ruling to the ECJ for the Interpretation of Art. 16 (4) Brussels Convention:
- only for nullity *erga omnes*?
- or also for *inter partes* defense?
("incidental question")

Düsseldorf Court Appeals GRUR Int. 2003,1030

Opinion Attorney General

Where the defense of invalidity is raised in a patent infringement proceeding, only the court mentioned in Art.16 (4) has jurisdiction

Opinion of 16 September 2004 Case C-403

GAT
v. LaK
Consequences for cross-border cases

- **Legal situation like in Germany:**
  separation of infringement and nullity

- **Future practice**
  - **Q:** can the infringement court ignore the invalidity defence for cross-border injunctions?

What will courts do:
- stay of infringement proceedings?
- immediate injunction?
- evaluation of success of nullity suit?
  (present German practice)

What can patentee do:
- separation of national and trans-border cases
- parallel actions from the beginning
Willful Infringement
and Discovery
1. It is not appropriate for the trier of fact to draw an adverse inference with respect to willful infringement when the attorney-client privilege and/or work product privilege is invoked by a defendant in an infringement suit.
2. It is not appropriate to draw an adverse inference with respect to willful infringement when the defendant had not obtained legal advice.
3. The existence of a substantial defense to infringement is not sufficient to defeat liability for willful infringement even if no legal advice has been secured, but instead is to be considered with others as part of the totality of the circumstances.

Knorr-Bremse v. Dana CAFC, September 13, 2004
Questions left open

- must defendant disclose – and thus is it discoverable as part of the relevant facts – whether or not he has obtained legal advice on the question of infringement
- what is the totality test for willfulness
- is availability of legal opinion still a defense
- will this be a waiver of client-attorney privilege
- and if yes: should patentee avoid seeking opinion from his trial counsel?
Amgen v TKT

1. Background

- EPO is a hormone
  - Amgen first established the sequence of amino acids of the gene that codes for EPO. Thrombopoietin was synthesized in mice EPO by recombinant DNA technology using host cells into which “recombinant” DNA is introduced. The host cells (bacterial, yeast or mammalian) replicate and express EPO. Amgen’s preferred cell was a CHO cell (Chinese Hamster Ovary)

- TKT developed a different process whereby EPO is expressed in a human cell by an “endogenous” (naturally occurring) gene (DNA sequence) which is triggered by exogenous DNA inserted upstream of the EPO gene. This could not be done at the priority date of the Amgen patent but was later developed

Amgen v TKT

- The essential difference is that Amgen EPO is made by exogenous DNA coding for EPO in a host cell whereas TKT EPO is made by endogenous DNA in a human cell with some exogenous DNA inserted as a trigger
Amgen v TKT

2. Claims
   - Claim 1 was as follows:
     "A DNA sequence for use in securing expression in a prokaryotic or
      eukaryotic host cell of a polypeptide molecule having at least part of the
      primary structure of a protein encoded by said DNA sequence, said
      polypeptide molecule having the biological property of causing bone marrow cells
      to express production of a polypeptide and key blood cells and in tumours,
      leucocytes, lymphocytes, monocytes or non-tumore, said DNA sequence selected
      from the group consisting of..."
   - Claim 20 was as follows:
     "A polypeptide product of the expression in a eukaryotic host cell of a
      DNA sequence according to any of claims 1, 2, 3, 5, 6 and 7."

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Amgen v TKT

3. The Relevant Law
   - Art 62 EPC:
     "The extent of the protection conferred by a European patent or a
      European patent application shall be determined by the terms of the
      claims. Notwithstanding, the description and drawings shall be used to
      interpret the claims."
   - Protocol on Interpretation of Art 62:
     "Article 62 should not be interpreted in the sense that the extent of the
      protection conferred by a European patent is to be understood as that
      defined by the precise literal meaning of the words used in the claims. The
      description and drawings cannot be involved only for the purpose of
      interpreting an ambiguity found in the claim. Rather, they should be
      interpreted in the sense that the claims are to be understood as the
      literal meaning of the words used in the claims."

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Amgen v TKT

In the description and drawings by a person skilled in the art, the
patents have corresponded. On the contrary, it is to be
interpreted as defining a position between these extremes which
comprises a literal projection for the protection with a reasonable degree of
certainty for third parties.

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Amgen v TKT

1. The issue on infringement
   - The expert evidence was clear: “host” cell meant to the skilled man a cell into which exogenous DNA is inserted to express the desired product.
   - Here TKT do not insert exogenous DNA coding for EPO but use the cells natural DNA but triggered by exogenous DNA.
   - Can “host” be construed to cover what TKT do.

Amgen v TKT

5. English Contract Law - History i
   - A legal document must be construed “literally” i.e. natural and ordinary meaning.
   - No regard to intention of parties.
   - No regard to subsequent events.
   - No regard to pre-contract negotiations.
   - Only if there is a manifest ambiguity can you look at the narrow factual background to the document to resolve the ambiguity.
   - Followed for Patients - EMF v Laser.

Amgen v TKT

6. English Contract Law - History ii
   - “What is the meaning which the document would convey to a reasonable person having all the background knowledge which would have been reasonably available to the parties at the date of the contract” i.e. justice before certainty.
   - Applies even if no ambiguity i.e. even if the words being construed have a clear natural meaning.
Amgen v TKT

7. Hoffman on Protocol
   □ First sentence of Protocol forbids the old English rule of construction i.e. look to specification even only if ambiguity exists.
   □ The document (whether contract or patent) should always be given a "purposive construction" (see Catella v TKT & Smith) i.e. what did the reasonable addressee (skilled man) understand the author to mean when using the words he did have in mind at the time of writing?
   □ Purposive construction does not mean extending the meaning of the words beyond what the skilled man would understand it to be claiming.
   □ There is no doctrine of equivalents - it is not necessary and Art 69 (and the Protocol) forbids going outside the claims.

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Amgen v TKT

8. What about IMPROVER QUESTIONS?
   □ If the claim was whether a feature embodied in an alleged infringement was outside the primary, broad or structural meaning of a descriptive word or phrase in the claim, the variant was not covered within its language as properly interpreted, the court should ask the following three questions:
     □ Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If not?
     □ Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a person skilled in the art? If no, the variant is outside the claim. If yes?
     □ Would the reader skilled in the art necessarily have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention? If yes, the variant is outside the claim.

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Amgen v TKT

9. What about IMPROVER QUESTIONS? II
   □ The principle of purpose construction is universal
   □ The Improver Questions are guidelines which may be of use when considering variants or equivalents - not always useful.
   □ "Not useful in this case"
Amgen v TKT

10. The Result

- The Judge at first instance held that on all the evidence (including the specification) a "cell is not a host unless it is host to exogenous DNA encoding for EPO". The TKT technique was unknown at the relevant time. L. Hoffman agreed

- The Judge held however that this was "liberal" meaning and based on his view of the invention (i.e. EPO itself, however made) he then applied improper Questions to hold that TKT technique was an infringements.

- The Court of Appeal held that the invention was making EPO via a "host" cell, not EPO itself and therefore an infringement.

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Amgen v TKT

- L. Hoffman agreed with Court of Appeal.

- The Judge had correctly construed "host" purposively (the correct principles) and there was no need to seek further "guidance" from the Protocol Questions.

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Come One, Come All: U.S. Discovery Availability For Use In Non-U.S. Proceedings
(Intel Corp. v. Advanced Micro Devices, Inc.,
No. 02-572, 2004 WL 1373133 (US Sup. Ct.))

by Kenneth R. Adamo

In Intel Corp. v. Advanced Micro Devices, Inc., the United States Supreme Court resolved certain questions of access to U.S.-style discovery in aid of non-US proceedings, through the provisions of 28 USC § 1782, Assistance to foreign and international tribunals and to litigants before such tribunals.¹

Section 1782 is the product of U.S. Congressional efforts, over the span of nearly 150 years, to provide federal-court assistance in gathering evidence for use in foreign tribunals, which the Court stated include judicial, administrative and quasi-judicial proceedings.

Respondent Advanced Micro Devices (AMD) had filed an antitrust complaint against petitioner Intel Corporation (Intel) with the Directorate-General for Competition of the Commission of European Communities. In pursuit of that complaint, AMD applied to the United States District Court for the Northern District of California, Intel’s “home court,” invoking Section 1782(a), seeking an order requiring Intel to produce potentially relevant documents. The district court refused; on appeal, the appellate court reversed and remanded the case, instructing the district court to rule on the merits of AMD’s application. Intel petitioned for

¹ Section 1782(a) provides that:

The district court of the district in which a person resides or is found may order him to give his testimony or statement or to produce a document or other thing for use in a proceeding in a foreign or international tribunal, including criminal investigations conducted before formal accusation. The order may be made pursuant to a letter rogatory issued, or request made, by a foreign or international tribunal or upon the application of any interested person .... The order may prescribe the practice and procedure, which may be in whole or part the practice and procedure of the foreign country or the international tribunal, for taking the testimony or statement or producing the document or other thing .... [or may be] the Federal Rules of Civil Procedure.
certiorari, because of differences between several of the U.S. appellate courts on certain legal
issues relating to 1782(a); the Court granted the petition to resolve these differences going to the
authority of a district court to award such discovery.

In principal part, the Court held that:

1. A complainant before the Commission, such as AMD, qualifies as
an “interested person” within § 1782(a);
2. The Commission is a § 1782(a) tribunal when it acts as a first-
instance decision maker;
3. The “proceeding” for which discovery is sought under § 1782(a)
must be in reasonable contemplation but need not be “pending” or “imminent”;
4. Section 1782(a) contains no threshold requirement that evidence
sought from a federal district court would be discoverable under the law
governing the foreign proceeding.

Slip op. at 2, 9.

The Court’s fourth holding is consistent with earlier U.S. appellate precedent that there is
no obligation for a party to exhaust its foreign discovery options before it can seek discovery
under § 1782. In re Malev Hungarian Airlines, 964 F.2d 97, 100 (2d Cir. 1992).

The Court noted, however, that the right to Section 1782(a) discovery is neither mandated
nor automatic:

We caution . . . that § 1782(a) authorizes, but does not require, a federal district
court to provide judicial assistance to foreign or international tribunals or to
“interested person[s]” in proceedings abroad.

Slip op. at 2 (emphasis added).

In remanding the case for the district court’s application of that discretion, the Supreme
Court identified “factors that bear consideration in ruling on a § 1782(a) request”:

(continued...)
First, when the person from whom discovery is sought is a participant in
the foreign proceeding (as Intel is here), the need for § 1782(a) aid generally is
not as apparent as it ordinarily is when evidence is sought from a non-participant
in the matter arising abroad. A foreign tribunal has jurisdiction over those
appearing before it, and can itself order them to produce evidence. App. to Reply
Brief 4a (“When th[e] person [who is to produce the evidence] is a party to the
foreign proceedings, the foreign or international tribunal can exercise its own
jurisdiction to order production of the evidence.” (quoting Decl. of H. Smit in In
re: Application of Ishihara Chemical Co., Ltd., For order to take discovery of
(EDNY, May 18, 2000)). In contrast, nonparticipants in the foreign proceeding
may be outside the foreign tribunal’s jurisdictional reach; hence, their evidence,
available in the United States, may be unobtainable absent § 1782(a) aid. See
App. to Reply Brief 4a.

Second, as the 1964 Senate Report suggests, a court presented with a
§ 1782(a) request may take into account the nature of the foreign tribunal,
the character of the proceedings underway abroad, and the receptivity of the foreign
government or the court or agency abroad to U.S. federal-court judicial assistance.
... Further, the grounds Intel urged for categorical limitations on § 1782(a)’s
scope may be relevant in determining whether a discovery order should be
granted in a particular case. Specifically, a district court could consider whether
the § 1782(a) request conceals an attempt to circumvent foreign proof-gathering
restrictions or other policies of a foreign country or the United States. Also,
unduly intrusive or burdensome requests may be rejected or trimmed. See Bayer,
146 F.3d, at 196 (remanding for district-court consideration of “appropriate
measures, if needed, to protect the confidentiality of materials”); In re Application
of Essex, 101 F.3d 873, 876 (CA2 1996) (affirming limited discovery that is
neither “burdensome [n]or duplicative”).

Slip op. at 20-21. Another possible concern might be that of parity of discovery: the Court
noted, albeit in another context, that information being sought by an interested person could be
conditioned by a district court upon that person’s reciprocal providing of information to the
requesting party, or that the foreign tribunal could place conditions on its acceptance of the
information to maintain whatever measure of parity it concludes is appropriate. Slip op. at 18-
19.

Under § 1782(a), an interested person may seek depositions under F.R. Civ.P. 30(b)(1)
(individual) and 30(b)(6) (corporate representative), and documents under F.R. Civ.P. 34 and 45;
other standard discovery tools (interrogatories, F.R. Civ.P. 33; requests to admit, F.R. Civ.P. 36),
are not clearly provided for by the wording of § 1782(a), but could possibly be available if good
cause were shown to the district court, on general principles.

The Court refused Intel’s request that it use its supervisory powers to adopt rules
governing § 1782(a) discovery, leaving it to case by case development and application of
discretion by the district courts. Slip op. at 21-23.

*Intel/ADM* removes all legal impediments to use of § 1782 grounded in the nature of the
foreign proceedings and the question of foreign discoverability of the information sought. It
does not mandate discovery-as-assistance to foreign litigants, nor does its identification of
“factors that bear consideration” restrict and confine discovery by their strict application. In the
usual case, however, foreign litigants in a matter having a U.S. context would be well advised to
carefully consider making a § 1782(a) application, as should a U.S. party which finds itself haled
into a foreign legal proceeding of either administrative or judicial nature by an other U.S. party.
Congress 2004
Resolution regarding privilege

The European Patent Lawyers Association,

(1) considering that, in most European countries, attorneys-at-law and patent attorneys enjoy professional privilege for the efficient representation and protection of their clients,

(2) considering that the concept of privilege is also acknowledged at Community level,

(3) considering that privilege is desirable in that it ensures total freedom of communication between client and counsel, without which the latter cannot fulfill their roles,

RECOMMENDS that countries which do not recognize privilege adopt legislation granting privilege against compulsory disclosure of legal advice or request for legal advice by or to attorneys-at-law and patent attorneys,

CONSIDERS that the invocation of privilege is a right and that no adverse inference should be drawn from the exercise of this right,

CONSIDERS/RECOMMENDS that wherever counsel enjoy privilege in their own countries, it should be recognized and enforced also by foreign Courts.

Brussels, 8 November 2004,

The Secretary

Fernand de Visscher

The President

Kevin Mooney
The European Patent Lawyers Association (EPLA) the membership of which comprise the lawyers active in patent litigation in Europe with experience in cross border litigation has, during its annual Congress in Brussels on November 8, 2004, discussed the opinion of Advocate General Geelhoed of September 16, 2004 in the case C – 4 / 03 of the European Court of Justice.

Members of EPLA are alarmed by the consequences of a decision of the ECJ following that opinion, because such a decision could severely restrict cross border litigation, forcing an owner of a European patent to enforce his patent separately in all States. This will multiply the costs of patent enforcement.

If such a situation arises, EPLA believes it would be necessary to change Regulation 44/2001 to allow for cross border litigation where the defendant raises the defence of the nullity of the patent.

Brussels, 8 November 2004

The Secretary

The President

Fernand de Visscher

Kevin Mooney
Assemblée générale extraordinaire du 6 juillet 2005
Adoption de nouveaux statuts

TITRE I : DENOMINATION - SIEGE SOCIAL - DUREE.

Article 1er – Dénomination

L’association est dénommée : « EUROPEAN PATENT LAWYERS ASSOCIATION », en abrégé “EPLAW”.

Article 2 – Siège social

Le siège social est établi dans l’arrondissement judiciaire de Bruxelles-Capitale.

Il peut être transféré par décision de l’assemblée générale.

Il est actuellement établi à 1050 Bruxelles, Avenue Louise 149 (boîte 20).

Article 3 – Durée

L’association est constituée pour une durée indéterminée.

TITRE II : OBJET.

Article 4 – Objet social

L’association a pour objet de promouvoir le traitement juste et efficace des litiges de brevets en Europe et de resserrer les liens entre les avocats confirmés dans la pratique judiciaire du droit des brevets en Europe.

Elle peut faire toutes les opérations se rattachant directement ou indirectement à son objet. Elle peut notamment favoriser entre les membres l'échange d'informations ainsi qu'étudier, proposer et promouvoir auprès des autorités toutes les mesures utiles à l'amélioration du traitement des litiges de brevets en Europe, compte tenu de l'expérience de ses membres.
TITRE III : MEMBRES

Article 5 - Nombre de membres

Le nombre de membres effectifs de l'association est illimité. L'association ne peut pas compter moins de trois membres effectifs.

Article 6 - Adhésion aux statuts

La qualité de membre emporte adhésion sans réserves aux présents statuts et au règlement d'ordre intérieur.

Article 7 - Membres effectifs

Les premiers membres effectifs sont les fondateurs de l'association :
- M. Pierre Véron, avocat, domicilié chemin de la Buissière 23 à F-65140 Rillieux la Pape en France;
- M. Winfried Tilman, avocat, domicilié Kennedydamm 17 à D-40476 Düsseldorf, en Allemagne;
- M. Kevin Mooney, solicitor, domicilié 5 Ascott Avenue, Ealing, London W53XL, en Angleterre;
- M. Peter Heinrich, avocat, domicilié Hofstrasse 66 à 8032 Zürich, en Suisse;
- M. Fernand de Visscher, avocat, domicilié à 3080 Tervuren, Karel van Lorreinenlaan 44, en Belgique.

Toute personne qui désire être membre de l'association, doit poser sa candidature par écrit auprès du conseil d'administration. Seront admis, en cette qualité, les avocats, membres d'un barreau ou d'une organisation similaire dans le territoire de l'Espace économique européen et de la Suisse et qui ont une pratique judiciaire confirmée dans le domaine du droit des brevets. La candidature sera soutenue par deux membres de l'association, de préférence établis dans le même pays que le candidat.

Le conseil d'administration statue sur l'admission des nouveaux membres. La décision d'admission ou de refus est prise souverainement et ne doit pas être motivée.

Article 8 - Membres adhérents

L'association comprend en outre une autre catégorie de membres, ci-après dénommés "membres adhérents" qui, sauf le lieu de leur activité professionnelle, doivent satisfaire aux mêmes conditions que les membres effectifs. Les membres adhérents ne disposent pas du droit de vote au sein de l'association mais ont pour le surplus les mêmes droits et obligations que les membres effectifs.

Les membres adhérents sont admis en cette qualité par décision du conseil d'administration.
Article 9 - Membres d’honneur

Sont membres d’honneur, sans devoir répondre aux conditions de l’article 6, toutes personnes admises en cette qualité par décision de l'assemblée générale pour avoir rendu des services éminents à l'association et au droit des brevets. Ils disposent des mêmes droits et obligations que les membres adhérents.

Les membres d’honneur sont dispensés de payer une cotisation. Ils ont pour le surplus les mêmes droits et obligations que les membres effectifs.

Article 10 - Démission - Exclusion

Les membres sont libres de se retirer à tout moment de l'association en adressant par écrit leur décision au conseil d'administration.

Est réputé démissionnaire, le membre qui ne paie pas la cotisation qui lui incombe dans le mois du rappel qui lui est adressé par lettre recommandée.

L’assemblée générale peut exclure un membre effectif en cas de manquement grave à ses obligations dans le cadre de l'association ou en cas d’atteinte par lui à l’honneur et à la réputation de l’association. Elle prononce cette exclusion à la majorité des deux tiers des voix participant au vote. Le membre dont l’exclusion est proposée, doit avoir été convoqué à l’assemblée générale afin de pouvoir présenter sa défense.

Le conseil d'administration peut exclure un membre adhérent pour le même motif et suivant la même procédure.

Article 11 - Absence de droit sur le fond social

Les membres démissionnaires ou exclus ainsi que les héritiers ou ayants droit d’un membre décédé n’ont aucun droit sur le fonds social.

Article 12 - Registre

Le conseil d'administration tient, au siège de l'association, un registre des membres dans lequel sont également consignées sans délai les décisions d’admission, de démission ou d’exclusion des membres.

Ce registre peut être consulté, sans déplacement, par tous les membres.
TITRE IV : RESSOURCES FINANCIERES.

Art. 13 - Ressources financières

Les membres sont tenus de payer une cotisation annuelle, fixée par l'assemblée générale, et qui ne peut dépasser 300 (trois cents) euros.

Lors de leur adhésion, les membres sont tenus de payer la cotisation de l'année en cours. Par la suite, la cotisation est payée dans le mois de l'appel aux cotisations par le trésorier, après l'approbation du budget de l'année concernée par l'assemblée générale.

L'association peut bénéficier d'éventuels dons et subventions qui lui sont accordés.

TITRE V : LE CONSEIL D'ADMINISTRATION.

Art. 14 - Composition

L'association est administrée par un conseil composé de cinq membres au moins, nommés par l'assemblée générale parmi les membres effectifs et en tout temps révocables par elle.

La durée de leur mandat est de trois ans, sans préjudice de la possibilité pour l'assemblée de prévoir un terme plus court. Il prend fin à son terme, à défaut de renouvellement. Les administrateurs ne peuvent pas exercer plus de deux mandats consécutifs.


Les administrateurs agissent collégialement. Ils exercent leurs mandats à titre gratuit.

Art. 15 - Suppléance

L'assemblée générale nomme trois administrateurs suppléants, qui, en commençant par le plus âgé, prennent les places des administrateurs qui cesseront leurs fonctions durant le mandat. Le suppléant achève dans ce cas le mandat de l'administrateur qu'il remplace. Dans l'intervalle, les administrateurs restants forment valablement le conseil.
Article 16 - Organisation

L’assemblée générale choisit parmi les administrateurs élus un président, deux vice-présidents, un secrétaire et un trésorier.

En cas d’empêchement du président, ses fonctions sont assumées par un des vice-présidents ou, à défaut, par le plus âgé des administrateurs présents.

Article 17 - Réunions

Le conseil d’administration se réunit deux fois par an au moins, sur convocation du président quinze jours avant la réunion. Il se réunit également à la demande d’un quart de ses membres.

Tout administrateur qui, sans raison légitime, ne se présente pas à deux réunions consécutives, est réputé démissionnaire.

Article 18 – Décisions du conseil d’administration

Le conseil d’administration ne peut statuer valablement que si la majorité au moins de ses membres est présente. Les administrateurs empêchés peuvent se faire représenter au conseil par un autre administrateur par tout moyen de communication écrite ou dactylographiée. Un administrateur ne peut détenir plus d’une procuration.

Les décisions du conseil d’administration sont prises à la majorité absolue des voix émises par les administrateurs présents ou représentés. En cas de parité des voix, la voix du président ou de son remplaçant est déterminante.

Nonobstant les dispositions du présent article et si tous les administrateurs y consentent, les décisions du conseil d’administration peuvent être prises par écrit (en ce compris par télécopie et par courrier électronique).

Article 19 – Pouvoirs du conseil d’administration

Le conseil d’administration a les pouvoirs les plus étendus pour l’administration et la gestion de l’association ainsi que tous les pouvoirs non expressément attribués à l’assemblée générale par la loi ou les présents statuts.

Il peut notamment, sans que cette énumération soit limitative, faire passer tous actes et contrats, transiger, compromettre, acquérir, échanger, emprunter, accepter et recevoir tous dons, legs, donations, subsides et subventions privées ou publiques, faire ou recevoir tout paiement de sommes ou valeurs, ouvrir tous comptes auprès des établissements de crédit, effectuer sur lesdits comptes toutes opérations et notamment tout retrait de fonds par chèques, ordre de virement ou de transfert ou tout autre mandat de paiement, payer toutes sommes dues par l’association,
renoncer à tous droits contractuels ou réels ainsi qu’à toutes garanties réelles ou personnelles.

**Article 20 – Pouvoirs délégués à un ou plusieurs mandataires**

Le conseil d’administration peut, sous sa responsabilité, conférer tous pouvoirs spéciaux à tout mandataire de son choix, membre ou non du conseil d’administration.

**Article 21 – Pouvoir de représenter l’association**

Les actions judiciaires, tant en demandant qu’en défendant, sont intentées ou soutenues, au nom de l’association, par le conseil d’administration.

Les actes qui engagent l’association, y compris ceux de gestion journalière, sont signés, à moins d’une délégation spéciale du conseil, conjointement par deux administrateurs, lesquels n’auront pas à justifier de leurs pouvoirs à l’égard des tiers.

**Article 22 – Responsabilité des administrateurs**

Les administrateurs ne contractent, en raison de leur fonction, aucune obligation personnelle et ne sont responsables que de l’exécution de leur mandat.

**TITRE VI : L’ASSEMBLEE GENERALE**

**Article 23 – Composition de l’assemblée générale**

L’assemblée générale est composée de tous les membres effectifs. Elle est présidée par le président du conseil d’administration. En son absence, un autre administrateur désigné par ses collègues, à commencer par le vice-président le plus âgé, est désigné président. L’assemblée désigne un secrétaire pour chaque réunion.

Les membres empêchés peuvent se faire représenter par un mandataire qui doit être membre de l’association. Chaque membre ne peut être titulaire que d’une seule procuration.

**Article 24 – Pouvoirs de l’Assemblée générale**

L’assemblée générale est le pouvoir souverain de l’association. Elle possède les pouvoirs qui lui sont expressément reconnus par la loi ou les présents statuts.

Sont notamment réservés à sa compétence :

- les modifications des statuts;
- la nomination et la révocation des administrateurs;
- l'approbation des budgets et des comptes;
- la nomination et la révocation des commissaires et, le cas échéant, la fixation de leur rémunération;
- la décharge à octroyer aux administrateurs et aux commissaires;
- l'exclusion d'un membre effectif;
- l'adoption et la modification du règlement d'ordre intérieur;
- l'autorisation au conseil d'administration de déléguer ses pouvoirs à un tiers;
- la dissolution de l'association;
- l'affectation des biens en cas de dissolution et la détermination des modes de liquidation.

Article 25 – Convocation de l'assemblée générale

L'assemblée générale doit être convoquée par écrit par courrier ordinaire, télécopie ou courrier électronique par le président du conseil d'administration, au moins quinze jours avant la tenue de l'assemblée.

La convocation de l'assemblée générale peut par ailleurs être requise à l'initiative d'un cinquième de ses membres au moins.

Le conseil joint à la convocation un ordre du jour précis et détaillé. Une question non comprise dans l'ordre du jour ne pourra être traitée durant l'assemblée. Toute proposition signée par un nombre de membres au moins égal au vingtième est portée à l'ordre du jour.

Article 26 – Assemblée générale annuelle

L'assemblée générale annuelle ordinaire a lieu le deuxième vendredi du mois de mai à 9 heures 30 dans l'arrondissement judiciaire de Bruxelles-Capitale; elle procède à l'examen des comptes et à la décharge à donner aux administrateurs ainsi qu'à l'approbation du budget de l'année suivante et du rapport d'activité du conseil d'administration. Le conseil d'administration expose à l'assemblée générale les activités de l'association et rend compte de sa gestion de l'année écoulée.

Article 27 – Assemblée générale extraordinaire

L'association peut être réunie en assemblée générale extraordinaire, à tout moment, par décision du conseil d'administration ou à la demande d'un cinquième des membres au moins.

Article 28 – Droit de vote

Tous les membres effectifs et d'honneur ont un droit de vote égal à l'assemblée générale, chacun disposant d'une voix.
Les résolutions sont prises à la majorité simple des voix présentes ou représentées, sauf dans les cas où il en est décidé autrement par la loi ou les présents statuts. En cas de partage des voix, celle du président ou de l'administrateur qui le remplace est prépondérante.

Les membres adhérents ont le droit d'assister à la réunion et d'émettre un avis, sans toutefois pouvoir participer au vote.

**TITRE VII : COMPTES ET BUDGET**

*Article 29 – L'exercice social*

L'exercice social commence le premier janvier pour se terminer le trente et un décembre de chaque année.

*Article 30 – Comptes annuels et budget*

Chaque année, et au plus tard six mois après la date de clôture de l'exercice social, le conseil d'administration arrête et soumet à l'approbation de l'assemblée générale le compte de l'exercice écoulé et le budget de l'exercice suivant.

**TITRE VIII : DISPOSITIONS DIVERSES**

*Article 31 – Registre des procès-verbaux*

Les procès-verbaux des décisions du conseil et de l'assemblée générale sont signés conjointement par deux administrateurs et consignés dans un registre des procès-verbaux, dont les membres et les tiers peuvent prendre connaissance au siège social.

*Article 32 – Règlement d'ordre intérieur*

Un règlement d'ordre intérieur pourra être présenté par le conseil d'administration à l'assemblée générale. Ce règlement éventuel est destiné à fixer les divers points non prévus par les statuts, notamment ceux qui ont trait à l'administration interne de l'association.

*Article 33 - Dissolution*

En cas de dissolution de l'association, l'assemblée générale désignera le ou les liquidateurs, déterminera leurs pouvoirs et indiquera l'affectation à donner à l'actif net de l'avoir social.
Cette affectation devra obligatoirement être faite en faveur d'une institution dont le ou les buts sont analogues à ceux de la présente association.

Article 34 – Droit applicable

Tout ce qui n'est pas explicitement prévu par les présents statuts est réglé par la loi du 27 juin 1921 régissant les associations sans but lucratif, telle que modifiée par la loi du 2 mai 2002. Les présents statuts sont soumis au droit belge.

Article 35 – Arbitrage

Tout litige relatif aux présents statuts, à leur interprétation et à leur application sera tranché au premier et dernier ressort par un arbitre unique, ayant la qualité d'avocat et de membre ou ancien membre d'un conseil de l'ordre d'un barreau belge, désigné et statuant selon le règlement d'arbitrage du CEPANI. Le lieu de l'arbitrage sera Bruxelles.

Ainsi adopté par l'assemblée générale extraordinaire du mercredi 6 juillet 2005 à Londres.

Le secrétaire,

F. de Visscher

Le Président,

K. Mooney
PART I : NAME - REGISTERED OFFICE - DURATION

Article 1 - Name
The association is named “EUROPEAN PATENT LAWYERS ASSOCIATION”, with the acronym “EPLAW”.

Article 2 - Registered Office
The registered office is situated in the legal quarter of the Capital Brussels.
It may be relocated by decision of the general meeting.
It is currently situated at 1050 Brussels, Avenue Louise 149 (box 20).

Article 3 - Duration
The association is constituted for an indefinite term.

PART II : OBJECT

Article 4 - The Association’s Object
The association has as its object the promotion of efficient and fair handling of patent litigation in Europe and the strengthening of ties between well established patent lawyers in Europe.

It can undertake all operations directly or indirectly related to its object. It can, in particular, encourage the exchange of information between its members, as well as study, propose and promote before the authorities all useful measures for the improvement of the handling of patent litigation in Europe, having regard to the experience of its members.

PART III : MEMBERS

Article 5 - Number of members
The number of the association’s current members is unlimited. The association may not have less than three current members.

Article 6 - Subscription to the articles of association
The role of member implies full subscription to these articles of association and the internal order regulation.

Article 7 - Current Members
The current members are the founders of the association:
- Mr Pierre Veron, lawyer, domiciled at chemin de la Buissiere 23, F-65140 Rillieux la Pape, France;
- Mr Winfried Tilman, lawyer, domiciled at Kennedydamm 17, D-40476, Dusseldorf, Germany;
- Mr Kevin Mooney, solicitor, domiciled at 5 Ascott Avenue, Ealing, London, W5 3XL, England;
- Mr Peter Heinrich, lawyer, domiciled at Hofstrasse 66, 8032 Zurich, Switzerland;
- Mr Fernand de Visscher, lawyer, domiciled at 3080 Tervuren, Karel van Lorreinenlaan 44, Belgium.

Any person who wishes to become a member of the association must lodge his written application with the board of directors. Lawyers who are members of a bar association or similar organisation in the European Economic Area and Switzerland and who are well established in patent law practice, shall be admitted as members. The application shall be supported by two members of the association, who are preferably resident in the same country as the candidate.

The board of directors rules on the admission of new members. The decision to admit or reject is taken autonomously and does not need to be reasoned.

**Article 8 – Associate members**

The association includes, in addition, another category of members, hereinafter referred to as “associate members” who, with the exception of the location of their professional activity, have to meet the same conditions as current members. Associate members do not possess voting rights within the association but otherwise have the same rights and obligations as current members.

The associate members are admitted by decision of the board of directors.

**Article 9 – Honorary members**

Honorary members are, without having to fulfil the conditions of article 6, all persons admitted in this role by decision of the general meeting for having provided outstanding services to the association and patent law. They have the same rights and obligations as associate members.

Honorary members are excused from paying a contribution. They have the same rights and obligations as current members.

**Article 10 – Resignation – Exclusion**

Members are free to resign from the association at any moment by giving their decision in writing to the board of directors.

A member who does not pay his contribution in the month during which a reminder was sent to him by registered letter shall be deemed to have resigned.
The general meeting may exclude a current member in the event of a serious breach of his obligations in the framework of the association, or in the event of him damaging the honour and reputation of the association. It pronounces this exclusion by two thirds majority of the votes cast. The member whose exclusion is proposed must have been convened to the general meeting in order to present his defence.

The board of directors may exclude an associate member for the same reason and following the same procedure.

Article 11 – Absence of rights over the association's funds
The members who have resigned or been excluded, as well as the successors or assigns of a deceased member have no rights over the association's funds.

Article 12 – Register
The board of directors holds, at the registered office, a members' register in which members' admission, resignation or exclusion decisions are recorded without delay.

This register may be consulted at the registered office by all members.

PART IV: FINANCIAL RESOURCES

Article 13 – Financial resources
Members must pay an annual contribution, set by the general meeting, which cannot exceed 300 (three hundred) euros.

At the time of joining, members must pay the contribution for the current year. Subsequently, the contribution is paid during the month in which the treasurer calls in contributions, after approval of the budget for the relevant year by the general meeting.

The association may benefit from future gifts and subsidies that are given to it.

PART V: THE BOARD OF DIRECTORS

Article 14 – Composition
The association is run by a board composed of at least five members, appointed by the members' general meeting, who may be dismissed at any time by the latter.

Their mandate is for three years, without prejudice to the general meeting being able to set a shorter term. Failing its renewal, the mandate expires at the end of its term. Directors cannot serve more than two successive mandates.
At least half of the directors' mandates which are running on 08 November 2004 will come to an end at the time of the general meeting to be held in 2005. All other such mandates will come to an end at the time of the general meeting to be held in 2006. Failing directors resigning of their own volition to achieve these changes, the directors who have to resign from office in 2005 shall be randomly chosen.

The directors act as a college. They exercise their mandates on a gratuitous basis.

**Article 15 – Temporary Replacement**
The general meeting appoints three temporary replacement directors, who, starting with the eldest, take the place of the directors who cease their functions during the mandate. The temporary replacement director, in this event, finishes the mandate of the director he replaces. In the interval, the remaining directors validly form the board.

**Article 16 – Organisation**
The general meeting chooses from amongst the elected directors, a chairman, two deputy chairman, a secretary and a treasurer.

In the event of the chairman being temporarily prevented from fulfilling his role, his functions are undertaken by one of the deputy chairmen or, failing which, by the eldest of the directors present.

**Article 17 – Meetings**
The board of directors meets at least twice a year, by convocation of the chairman fifteen days before the meeting. It also meets on the request of one quarter of its members.

Any director who, without legitimate reason, does not attend two consecutive meetings, is deemed to have resigned.

**Article 18 – Decisions of the board of directors**
The board of directors may only validly deliberate if at least the majority of its members are present. Directors who are unable to attend may be represented on the board by another director by any means of written or typed communication. A director may only hold one proxy power.

Decisions of the board of directors are taken by absolute majority of the votes cast by the directors present or otherwise represented. In the event of parity of votes, the chairman or his replacement shall have the casting vote.
Notwithstanding the provisions of this article and if all the directors present so consent, the decisions of the board of directors may be made in writing (including fax and e-mail).

Article 19 - Powers of the board of directors
The board of directors has the most extensive powers necessary for the administration and management of the association as well as all the powers implicitly granted to the general meeting by law or these articles of association.

It can, in particular, without this list being exhaustive, enter into any acts and contracts, settle, compromise, acquire, exchange, borrow, accept and receive any gifts, legacies, donations, private or public grants and subsidies, make or receive any payment of any sum or value, open any account with credit establishments, undertake on the said accounts any operations and, in particular, any withdrawal of funds by cheque, transfer or other payment mandate, pay any sums due by the association, waive any contractual rights or rights in rem as well as any guarantees in rem or personal guarantees.

Article 20 - Powers delegated to one or more representative
The board of directors may, under its own responsibility, confer any special powers to any representative of its choice, whether a member of the board of directors or not.

Article 21 - Power to represent the association
Legal actions, whether as claimant or defendant, are brought or supported, on behalf of the association, by the board of directors.

The acts which bind the association, including those relating to day-to-day management, are signed, barring a special delegation of the board, jointly by two directors, whom shall not have to prove their powers to third parties.

Article 22 - Liability of the directors
The directors do not, by reason of their functions, enter into any personal obligation and are only responsible for the execution of their mandate.

PART VI: THE GENERAL MEETING

Article 23 - Composition of the general meeting
The general meeting is composed of all the current members. It is chaired by the chairman of the board of directors. In his absence, another director chosen by his colleagues, starting with the eldest deputy-chairman, is designated chairman. The general meeting chooses a secretary for each meeting.
Members who are unable to attend may be represented by a proxy who must be a member of the association. Each member can only hold one proxy power.

**Article 24 – Powers of the general meeting**
The general meeting is the sovereign power of the association. It possesses the powers expressly granted to it by law or these articles of association.

In particular, the following fall within its competence:
- amendment of the articles of association;
- appointment and dismissal of directors;
- approval of budgets and accounts;
- appointment and dismissal of auditors and, as the case may be, the setting of their remuneration;
- the discharge to be granted to the directors and auditors;
- the exclusion of a current member;
- the adoption and amendment of an internal order regulation;
- authorisation for the board of directors to delegate its powers to a third party;
- the dissolution of the association;
- the allocation of property in the event of dissolution and the determination of the mode of liquidation.

**Article 25 – Convening of the general meeting**
The general meeting must be convened in writing by normal post, fax or e-mail by the chairman of the board of directors, at least fifteen days before the holding of the meeting.

The convening of the general meeting can, moreover, be requested by at least one fifth of the members.

The board affixes a precise and detailed agenda to the convocation notice. A question which has not been included in the agenda cannot be addressed during the meeting. Any proposal signed by at least a twentieth of the members is included in the agenda.

**Article 26 – Annual general meeting**
The annual ordinary general meeting takes place on the second Friday of the month of May at 9:30am in the legal quarter of the Capital Brussels, and undertakes the inspection of the accounts and the discharge to be granted to the directors as well as the approval of the following year’s budget and the board of directors’ activity report. The board of directors presents the association’s activities and summarises its management for the year passed to the general meeting.
Article 27 – Extraordinary general meeting
The association may meet as an extraordinary general meeting, at any moment, by
decision of the board of directors or on the request of at least one fifth of the members.

Article 28 – Voting rights
All current and honorary members have equal voting rights at the general meeting, each
member holding one vote.

Resolutions are taken by simple majority of the members present or represented,
except where otherwise decided by law or these articles of association. In the event of a
split vote, the chairman or the director standing in for him shall have a casting vote.

Associate members have the right to participate in the meeting and to express their
opinion, without, however, being able to participate in the vote.

PART VII: ACCOUNTS & BUDGET

Article 29 – The financial year
The financial year commences on the first of January and ends on the thirty first of
December each year.

Article 30 – Annual accounts and budget
Each year, and at the latest six months after the closure of the financial year, the board
of directors agree the accounts and submit the accounts for the previous financial year
and the budget for the next financial year to the general meeting for its approval.

PART VIII: MISCELLANEOUS PROVISIONS

Article 31 – Register of meeting minutes
The meeting minutes setting out the decisions of the board and the general meeting are
jointly signed by two directors and recorded in the register of meeting minutes, which
the members and third parties may inspect at the registered office.

Article 32 – Internal order regulation
An internal order regulation may be presented by the board of directors to the general
meeting. This potential regulation is geared towards setting the various points not
provided for by the articles of association, in particular, those which relate to the
internal administration of the association.
**Article 33 – Dissolution**
In the event of the association’s dissolution, the general meeting shall designate the liquidator(s), determine their powers and shall indicate the allocation to be given to the association’s net assets.

This allocation must compulsorily be made in favour of an institution whose object(s) is analogous to this association’s.

**Article 34 – Applicable law**
Anything which is not expressly provided for by these articles of association is covered by the law of 27 June 1921 governing non-profit associations, as modified by the law of 02 May 2002. These articles of association are governed by Belgian law.

**Article 35 – Arbitration**
Any dispute relating to these articles of association, their interpretation and application shall be settled in the first and final instance by a sole arbitrator, being a lawyer and a member or former member of a supervisory council of a Belgian bar association, designated and ruling in accordance with the CEPANI arbitration regulations. The arbitration shall take place in Brussels.

Thus adopted by the extraordinary general meeting of the 06 July 2005 in London.

The secretary                        The Chairman,

F. de Visscher                        K. Mooney
Internal regulation: Policy on Costs

1. Reimbursement of stationary costs (and similar costs)

The members of the Board are allowed to invoice the Association for the following expenses incurred for EPLA: stamps, photocopies and stationary irrespective whether they are internal or external to their firm (preferably internal) as well as courier fees and other reasonable external costs as close as possible to the actual costs; the same rule shall be applicable to ordinary members when in charge of any particular mission for the association following appointment by the Board.

2. Travel and accommodation costs

2.1. Speakers and guests at EPLA meetings

Speakers should normally not be assisted in this respect when they are private practitioners (and speaking is then supposed to enhance their reputation). For other speakers (State paid persons, University professors without private practice etc.), our Association will reimburse the reasonable travel and accommodation (in principle one night) expenses.

This would not apply to a guest invited by the Board and who does not take the floor as a speaker, unless this seems advisable (to be decided by the board member responsible for the invitation).

2.2. Meetings of the Board other than the day before the annual Congress

Each Director will be reimbursed his reasonable expenses for each board meeting subject to the following cumulative conditions:
1) the meeting is not in the town where the Director concerned has his home or professional address,
2) the Director actually participates in the meeting,
3) the meeting is not organised at the same time as another conference at which the Director participates.

The same will apply to external persons when invited to a Board meeting (e.g. a speaker when preparing for our Congress).
2.3. Members of the Association appointed to represent it in international meetings

Any member of the Association who is appointed by the Board to represent the Association at international meetings will be reimbursed his reasonable travel and accommodation costs subject to the three conditions defined sub 2.2.

3. Annual meeting registration fees

The Board members, the speakers and the invited guests are exempt from payment of the registration fee.

Adopted on 6 July 2005 during the Extraordinary General Assembly in London.

The Secretary

The President

F. de Visscher

K. Mooney
Opinion of the European Economic and Social Committee on the 'proposal for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance'  

(2004/C 112/21)

On 30 January 2004, the Council decided to consult the Economic and Social Committee, under Article 95 of the Treaty establishing the European Community, on the above-mentioned proposal.

The European Economic and Social Committee decided to ask the Section for the Single Market, Production and Consumption to carry out the work on the subject.

In view of the urgency of the matter, at its 407th plenary session held on 31 March and 1 April 2004 (meeting of 31 March), the European Economic and Social Committee appointed Mr Retureau as Rapporteur-General and adopted the following opinion by 53 votes in favour, two against and two abstentions.

1. The proposed Council Decisions presented by the Commission

1.1 Presentation of the proposed decision

1.1.1 Two proposals were adopted on the same day. The purpose of the first is to confer jurisdiction on the Court of Justice in disputes relating to the proposed Community patent. The second establishes a Community Patent Court (CPC) attached to the Court of First Instance (CFI) and a patent appeal chamber at the CFI. It also defines the scope ratione materiae, ratione personae and ratione loci of cases brought before the CPC and appeals brought before the CFI regarding disputes relating to Community patents. Finally, it covers any possible appeals to the Court of Justice where there is a serious risk of compromising the homogeneity of law or jurisprudence regarding Community patents.

1.1.2 The European Council held in Lisbon in March 2000 adopted a general programme to increase the competitiveness of the Union's economy in order to turn it into a knowledge-based economy that would be the most competitive in the world. This ambitious programme breaks down into a number of areas, including that of industrial property. In respect of this, the Council relaunched the creation of a system of Community patents in order to mitigate the limitations of the current systems for protecting technological inventions, in order to help stimulate investment in research and development in the European Community.

1.1.3 The Commission, in the introduction to the proposal, recalls the failure of the first attempts to create a Community patent, which began in the early 1970s. The 1973 Munich Convention (European Patent Convention, EPC) was a first step forward, in that it established a system for examining and issuing patents in several states that signed up to the Convention (currently all the countries of the EEA, the Swiss Confederation, Monaco, Liechtenstein and several of the candidate countries), but without modifying the national systems and courts, which retained jurisdiction with regard to validity and to disputes relating to patents issued by the European Patent Office (EPO), as well as for certificates issued by national patent offices.

1.1.4 In an attempt to overcome the limitations of the Munich Convention, a Community Patent Convention was signed in Luxembourg on 15 December 1975 in order to create a unitary title at Community level. This convention, like the Munich Convention, was too limited in scope. It never came into force, as not enough countries ratified it. However, this attempt was followed in 1989 by an agreement on Community patents, which included, among other things, a protocol on disputes regarding validity and infringement of such patents, but these agreements never came into force either.

1.1.5 Consequently, two non-Community systems currently co-exist within the Union and, more widely, the EEA and some other countries: national patents, issued by national patent offices and subject to the domestic courts of the country of issue; and European patents, resulting from the Munich Convention of 1973, which determined the applicable substantive law and allowed for a single patent to be issued in those signatory countries to the convention specified by the applicants, but did not specify the applicable territorial law nor which national courts had jurisdiction.

1.1.6 Thus, for a single dispute relating to a patent issued in several countries, the applicants are obliged to initiate as many sets of proceedings as there are competent national courts, and to do so in as many official languages as are applicable, which constitutes a significant obstacle to exercising intellectual property rights created by the issue of patents in several countries. Indeed, it is possible that each set of proceedings may have a different outcome, depending on the national law of the country in question.
1.1.7 Progress on the Community patent project is both extremely desirable from the point of view of economic interest groups and necessary to the functioning of the Single Market. In order to move things forward, the Commission published a Green Paper on the subject on 25 June 1997 (1). This was followed by consultations, studies and practical proposals.

1.1.8 Following the Lisbon European Council, the Commission presented, on 1 August 2000, a proposal for a regulation of the Council on the Community patent, concerning all the legal and judicial aspects of this single certificate, which would be valid throughout the European Union. The Committee has already expressed its support for the proposal (2).

1.1.9 These patents will be examined and issued by the European Patent Office once the Community has taken the necessary step of signing up to the Munich Convention (3), and thus according to the same substantive law as European patents, which will remain in force alongside the new Community patent once this has been created.

1.1.10 The Community Patent Regulation, presented by the Commission in 2000 (4), was subjected to a lengthy debate in the Council before the revised text was finally published on 4 September 2003, as it raises a number of legal, financial and linguistic questions. The territoriality of industrial property law will in part be called into question for the purposes of the Community patent. However, some national terms of reference will remain in place, provisionally in some cases and permanently in others.

1.1.11 The Council, which has sole jurisdiction in these matters according to the legal basis of the proposals under discussion, has yet to make a final decision. In the meantime, the Commission has based these two proposals on the Council’s common political approach (discussed at the Competitive Policy, Health and Consumer Affairs Council three days later) (5). The first proposal concerns the conferment of jurisdiction on the Court of Justice; the second, the creation of specialised panels, their composition, their statute and their powers, proceedings and appeals brought before them, and the amendment to the statute of the Court of Justice and the CFI that these new panels and powers require.

1.1.12 The aim is to prevent territorial and material fragmentation of litigation concerning the validity of the Community patent and of industrial property rights that arise directly from it, as well as of any supplementary protection certificates associated with that patent, by creating a single Community court that will need to be accessible to natural and legal persons and be operational by 2010 at the latest.

1.2 Proposal for a decision establishing the CPC and concerning appeals before the CFI

1.2.1 The legal basis for the proposal for a decision establishing the CPC and concerning appeals before the CFI is principally to be found in Articles 220, 225, 225a and 245 of the EC Treaty. Other articles of the EC Treaty (6) and the Protocol on the Statute of the Court of Justice (7) are also relevant. The Statutes of the Court and of the CFI will be amended to the extent that is strictly necessary and according to the provisions of the Council’s final decision, after consulting the Court and the political institutions of the Communities, on the proposal of the Court itself or of the Commission.

1.2.2 The Commission proposes the creation of a CPC by 2010 at the latest. It would be based at the headquarters of the CFI and have seven judges, including a President of the Court elected by his peers for a renewable three-year term. The CPC, made up of two chambers with three judges each, will be attached to the CFI, and will hear disputes on infringement and validity of Community patents, in line with the jurisdiction conferred on the Court of Justice. In addition, a specialised panel of three judges will be created at the CFI as a court of appeal against decisions of the CPC. In cases where Community law and case law need to be reconciled, the Court of Justice will be able to act as a court of revision, within strictly defined limits. Judges will be appointed for a renewable six-year term; every three years, three or four judges in turn will be replaced in order to ensure both regular renewal and continuity of the court.

1.2.2.1 Since it covers private disputes, the patent court does not, in principle, affect the validity of Community acts; however, private persons will need to be able to challenge, where appropriate, some of the provisions relating to the validity of patents, but only within the limits of the particular case, without being able to request that a Community act be struck down.

1.2.2.2 Decisions of the Court will also be enforceable against Member States, who have the same status as private persons with regard to patents applied for by a State and to infringement.

(1) OJ C 129 of 27.4.1998.
(2) OJ C 155 of 29.5.2001.
(3) This would mean revising the Munich Convention according to the diplomatic method, which will involve all the signatory states, whether they are members of the Community or not.
(5) Memo from the secretariat of the Council to delegations, Inter-institutional dossier 2000J00177 (CNS), No 7159/03 PI 24 of 7 March 2003.
1.2.3 For the CPC, the appointment of judges, the election of the president, appeals before the CFI and any other provisions specific to the Court, such as the composition, powers and specific procedural provisions of the chambers, which are different or constitute an amendment to the Statute of the Court of Justice and the CFI ought, as far as possible, to be inserted into the Annex to the Statute of the Court relating to judicial panels.

1.2.4 The judges are chosen from a list drawn up by a Consultative Committee. This list must contain twice as many names as there are vacant posts. Appointments are made by the Council acting unanimously. The judges will have to demonstrate a high level of expertise and experience in patent law. The Consultative Committee will be appointed by the Council and be made up of seven members, most of whom will be former judges of the Court of Justice, the CFI or the CPC, and possibly 'lawyers of recognised competence', all of whom will be highly competent and impartial individuals.

1.2.5 Technical experts will assist the judges throughout the handling of a case. They will be selected from the main scientific and technological sectors that are subject to patent applications. There will be no Advocate-General.

1.2.6 The language of proceedings shall be that of the domicile of the defendant or, where his country uses more than one official Community language, an official language chosen by him. However, with the agreement of the Court, the parties may choose any official language as the language of proceedings; in the event of any appeals, these will be heard in the language used at first instance. The parties present and witnesses will, at the hearing, be able to speak in an official language other than the language of proceedings; in this case, translation and interpreting into the language of proceedings will have to be provided.

1.2.7 The losing party can bring an appeal against a decision of the CPC before the specialised appeal panel of the CFI.

1.2.8 Any revision of a final judgement by the Court of Justice will be subject to very strict and restrictive conditions, for reasons of legal certainty; only fundamental new facts or criminal acts that were a decisive factor affecting the decision that became res judicata will constitute grounds for an appeal.

1.2.9 The main provisions for derogation from the current rules of the Court of Justice and of its CFI logically flow from the nature of the litigation and of the parties to the proceedings, and also aim to avoid procedural delays and strengthen the legal certainty of judgements. They should, as far as possible, be included in the future Rules of the Court and affect the Statute, which is an integral part of the Treaties, as little as possible. The main specific provisions planned for the patent court are as follows:

- written and oral proceedings: more streamlined and flexible than the Court of Justice, possible use of ICT; use of ICT, such as video conferencing, is proposed;

- representation: the parties will be able to be assisted by patent agents, chosen from the list of agents approved by the EPO. Legal aid is planned in order to ensure access to justice for all;

- emergency, interim and penalty measures: possible at any stage of the proceedings, even before the hearing; these may include injunctions to act or to abstain from an act, possibly accompanied by penalties, saisté-contrefaçon, evidence protection, and any other emergency or interim measure that flows from the application of Community law on protection of industrial property and of the relevant provisions of the WTO TRIPS agreements included in this decision and other Community acts (1);

- any decisions relating to disputes concerning the Community patent will have the enforcement order appended directly by the relevant judicial panel and will be immediately applicable by the competent authorities of the country or countries in which the decisions are to apply as soon as they are requested to do so by the beneficiary of an interim or final decision; the enforcement procedure will be that of the country receiving the request;

- any request by the applicant for interim measures that would be financially prejudicial to the defendant before the judgement will have to be accompanied by guarantees in case his claims are not upheld;

- the decisions of the CPC will have to be listed in the Community Patent Register;

- only final decisions will be communicated to the Member States.

1.2.10 Each Member State will designate a limited number of national courts to hear disputes relating to the Community patent brought during the transitional period. For the purposes of enforcement in another Member State, the decisions of these courts will be subject to the convention on jurisdiction and the enforcement of judgments, subject to special provisions that may be included in the future Regulation (2).

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Notes:
2 Among the legal instruments already adopted with regard to civil and commercial law with the Committee's approval, Regulation (EC) No 44/2001 of 22 December 2000 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters is worth mentioning, as it appears relevant to the matter in hand.
2. The Committee's comments

2.1 The Committee notes that the proposal is in line with the EC Treaty and with the Protocol on the Court of Justice. The Committee supports the proposal in principle, subject to the following comments.

2.1.1 The CPC will handle disputes between private persons, unlike the disputes usually handled by the Court, and will do so in an area requiring specialised legal and technical knowledge. Given that the CPC is attached to the CFI and consists of two chambers of three first-degree judges and a president, and that a specialised appeal panel of three judges, incorporated within the CFI, is created, the general rules on the operation of courts are upheld. The Committee also supports the appointment of patent experts to assist the Court, rather than commissioners or advocates-general; the Committee believes that this will strengthen the authority and value of judgements.

2.1.2 The creation of a CPC attached to the CFI and of a specialised appeal panel within the CFI of the Court of Justice to handle cases relating to Community patents is necessary and appropriate, given that it relates to a single Community industrial property certificate: the future Community patent. The disadvantage of chambers dedicated exclusively to hearing disputes relating to the Community patent both at first instance and at second instance will be that parties to proceedings will be able to settle their disputes more quickly and efficiently by distinguishing this litigation from more general litigation handled by the CFI. The CFI will operate as an appeal body, and in certain restricted cases the Court of Justice will be able to act as a supreme body able to review previous decisions.

2.1.3 This will offer owners of technological patents and supplementary industrial property certificates all the appropriate procedural guarantees. The procedure will avoid referrals back from the CFI to the CPC, and settlements between parties will be possible before the Court, which will allow matters to be settled more quickly. Matters other than validity and infringement will remain within the jurisdiction of national courts, which is in line with the principle of subsidiarity.

2.1.4 The Committee considers that the ability given to private individuals to mount an indirect challenge to certain Community acts in relation to their private dispute (a technique known in French as exception d'ilégalité, whereby a defence is made on the basis that the law of which the defendant is in breach is itself illegal) concerning the validity of a patent, without giving the CPC the power to strike down the Community acts in question, is justified on the basis of respect for the rights of defendants. However, the Committee considers that it would be appropriate that consequences be drawn from this, for example by the Court of Justice, to which the Commission could make a mandatory referral in cases where the CPC has accepted an exception d'ilégalité defence.

2.1.5 For the transitional period, it is necessary to highlight the risk that the limited number of national courts appointed by each country might produce diverging decisions and case law, particularly as regards the interpretation of Articles 52-57 of the European Patent Convention. It would be appropriate to make provisions for the Court of Justice to be able, where necessary, to intervene subsequently as a revision body, in the limited circumstances that would allow such a procedure.

2.1.6 The Committee would like the proposed CPC, for its part, to give a measured interpretation, in line with the general principles of judicial interpretation, of the conditions of patentability in cases concerning the validity of a certificate, notably with regard to the exclusions clearly stated in Articles 52 et seq. of the EPC. It is concerned about future developments — parallel or divergent — of Community law and of the EPC, in particular with respect to the independence of Community law in relation to any changes that may be made to the EPC's provisions on patentability in the future, and would like the Commission quickly to propose arrangements for examining and issuing Community patents that would guarantee the supremacy of Community industrial property law with respect to possible amendments at the CPC of the conditions of issue and validity of the European patent by the EPO.

2.1.7 The Committee supports the provisions that allow disputes to be resolved quickly, such as the possibility of settlement before the court.

2.1.8 It considers the proposals presented by the Commission relating to the jurisdiction and the specific organisation of the Court for cases relating to Community patents to be well thought through, well-constructed, balanced, and likely to enable disputes to be resolved efficiently.

2.1.9 In the light of this, the Committee finds it all the more regrettable that the Council was unable, on 11 March last year, to make progress on the Regulation on the Community patent; the Committee would once again emphasise the importance of the creation of the Community patent as soon as possible, in order to support the innovation and competitiveness of European businesses, and finds delays for linguistic or other reasons, that are not fundamental in nature but could lead to excessive costs that would negate the advantage of a Community patent, to be unacceptable. All the Member States are parties to the EPC, which has only three official languages of application; there is no reason to adopt more binding and more expensive provisions for a Community patent.
2.1.10 The Committee very much hopes, for the sake of innovation and the creation of skilled jobs in Europe, that the Council will quickly decide in favour of a low cost patent, without excessive procedural costs or requirements that would remove its attraction and effectiveness.

Specific comments

2.2 The CFI already has jurisdiction in disputes relating to industrial property with respect to trademarks and designs, which are managed by the Office for Harmonisation in the Internal Market. It might perhaps have been worth considering the creation of an Industrial Property Court attached to the CFI, with jurisdiction over all existing and future Community property industrial certificates, and a specialised appeal panel within the CFI for these certificates, in order to centralise litigation on industrial property within the Community. However, this question could be looked at in the more distant future, once the patent court has gathered sufficient practical experience — say, after 2013. This possibility of a wider jurisdiction is already open to the CFI's judicial appeals panel. The Committee supports this wholeheartedly.

2.3 The CPA proposed that, in addition to their high level of expertise on the subject of patents, the appointed judges would also have to have a wide knowledge of languages (as there will not be one judge from each country); this provision of the CPA was not retained by the Commission. The Committee regrets this, as parties to proceedings, whether applicants or defendants, should be able not only to be heard but also, as far as possible, to have a chance of being understood in one of the Community languages by at least one of the judges hearing the case, notwithstanding the provision of specialised interpreting for each hearing. All other things being equal, preference should be given to judges who have mastery of several official Community languages.

2.4 If matters relating to the ownership of the certificate remain under national jurisdiction, it must be noted that the matter of rights of salaried or contracted inventors is handled differently in different countries. Out of concern for fairness, and in order to avoid one-sided contracts on patent ownership and the share or compensation paid to inventors, it would be appropriate to seek further harmonisation of laws applicable to the Community patent with regard to the rights of certain categories of inventor in relation to the owner of the certificate. (Generally speaking, patents are applied for by businesses, which retain the ownership rights; it is far less usual for the application to be lodged by the actual inventor, who may, by dint of contract or of national law, receive royalties for the use of his invention, but often has no rights at all.)

2.5 The Committee notes with interest the Commission's declaration that the costs of examining, issuing and maintaining the Community patent will be 50% lower than those for the European patent; nonetheless, regulations on intermediation in Community patents (advisers, patent attorneys) should be introduced in good time to prevent significant distortions in the real cost of obtaining a patent and to ensure that applicants have access to properly qualified service providers. The EPO list of approved intermediaries could be used as a reference, but an indicative or mandatory scale of charges for the various services could be considered. Similarly, the role and fees of national patent or industrial property offices should be taken into consideration, as should the possibility of approving technical translators specialising in patents, always keeping in mind quality and affordability of services.

2.6 The legislative financial statement shows that if the parties are required to bear the costs of the proceedings, the Council, voting on the schedule of fees by qualified majority, will have to take into consideration the need for fair access to justice, and not set amounts that might be a deterrent for individuals or SMEs. In any case, the Committee does not believe that the costs of services to private persons can be covered by these fees alone, taking into consideration the CPC's draft budget and the principle of keeping down the costs of obtaining, keeping and protecting industrial property in comparison with the European patent and the national patents of the most developed non-EU countries. The Committee therefore hopes that the court fees for the first instance and for appeals will remain low, in order to maintain the Community patent's strategic advantage for the competitiveness of businesses, particularly Community SMEs.


The President
of the European Economic and Social Committee
Roger BRIESECH
Opinion of the European Economic and Social Committee on the 'proposal for a Council Decision conferring jurisdiction on the Court of Justice in disputes relating to the Community patent'


(2004/C 112/22)

On 30 January 2004, the Council decided to consult the Economic and Social Committee, under Article 95 of the Treaty establishing the European Community, on the above-mentioned proposal.

The European Economic and Social Committee decided to ask the Section for the Single Market, Production and Consumption to carry out the work on the subject.

In view of the urgency of the matter, at its 407th plenary session held on 31 March and 1 April 2004 (meeting of 31 March), the European Economic and Social Committee appointed Mr Retureau as its rapporteur-general and adopted the following opinion by 56 votes in favour, 1 against and 1 abstentions.

1. The proposed Council Decision presented by the Commission

1.1 The purpose of the proposal is to confer jurisdiction on the Court of Justice in disputes relating to the proposed Community patent.

1.2 The European Council held in Lisbon in March 2000 adopted a general programme to increase the competitiveness of the Union's economy in order to turn it into a knowledge-based economy that would be the most competitive in the world. This ambitious programme breaks down into a number of areas, including that of industrial property. In respect of this, the Council relaunched the creation of a system of Community patents in order to mitigate the limitations of the current systems for protecting technological inventions, in order to help stimulate investment in research and development in the European Community.

1.3 The Council, which has sole jurisdiction in these matters according to the legal basis of the proposals under discussion, has yet to make a final decision. In the meantime, the Commission has based this first proposal, which concerns the conferral of jurisdiction on the Court of Justice, on the Council's common political approach (discussed at the Competitiveness Council on 3 March 2003 and at the Employment, Social Policy, Health and Consumer Affairs Council three days later (1)).

1.4 The aim is to prevent territorial and material fragmentation of litigation concerning the validity of the Community patent and of industrial property rights that arise directly from it, as well as of any supplementary protection certificates associated with that patent, by creating a single Community court that will need to be accessible to natural and legal persons and be operational by 2010 at the latest.

1.5 The legal basis for the proposal to confer jurisdiction on the Court of Justice in disputes relating to the Community patent (2) is Article 229a of the EC Treaty, introduced by the Treaty of Nice. The EC Treaty provides that the Council, on a proposal from the Commission and after consulting the Parliament, can confer jurisdiction on the Court of Justice, within the limits it lays down, to hear disputes relating to Community intellectual property titles. The Council recommends the adoption of these provisions by the Member States. These will then ratify them according to their respective constitutional arrangements.

1.6 The Court's jurisdiction will (if strictly interpreted) cover disputes relating to the infringement and validity of Community patents and supplementary certificates. The nature of admissible actions is set out in the revised proposal for a Council Regulation on the Community patent (3); with respect to infringement, these are actions to stop infringement and actions for the declaration of non-infringement; as well as sanctions in the case of infringement; with respect to validity, these are invalidity actions and counter claims for invalidity. The Court will also have the power to take emergency measures and to order penalty payments that may be necessary in the disputes it will be handling.

1.7 Provision is made for transitional measures for Community patents, which might come into effect before the creation of the CPC in 2010; the designated courts of Member States would have jurisdiction in applying the substantive law of the Munich Convention and relevant Community law to disputes initiated before the creation of the CPC, and would in all cases be required to see through to the end any proceedings that had already been started.

2. General comments

2.1 The Committee notes that the proposal is in line with the EC Treaty and with the Protocol on the Statute of the Court of Justice. The Committee supports the proposal in principle, subject to the following comments.

(3) Memo from the Presidency to the Intellectual Property (Patents) group, text (revised) of proposal 10404/03 P1 53 of 11 June 2003, subsequently revised by the Patents group on 4 September 2003, document number 12219/03.

(1) Memo from the secretariat of the Council to delegations, inter-institutional dossier 2000/0177 (CNS), no 7159/03 PI 24 of 7 March 2003.
2.2 The Committee subscribes to the point of view that a single court with exclusive jurisdiction applying uniform rules and jurisprudence is necessary for the fair application of Community patent law to disputes arising within the Community. Such a solution gives parties to court proceedings the assurances of legal certainty and stability they are entitled to expect. The right to be heard in one's own language is also respected at hearings.

2.3 The Committee considers that the ability given to private individuals to mount an indirect challenge to certain Community acts in relation to their private dispute (a technique known in French as exception d'ilégalité, whereby a defence is made on the basis that the law of which the defendant is in breach is itself illegal) concerning the validity of a patent, without giving the Community Patent Court the power to strike down the Community acts in question, is justified on the basis of respect for the rights of defendants. However, the Committee considers that it would be appropriate that consequences be drawn from this, for example by the Court of Justice, to which the Commission could make a mandatory referral in cases where the CPC has accepted an exception d'ilégalité defence.

2.4 For the transitional period, it is necessary to highlight the risk that the limited number of national courts appointed by each country might produce diverging decisions and case law, particularly as regards the interpretation of Articles 52 to 57 of the European Patent Convention. It might be appropriate to make provisions for the Court of Justice to be able to intervene subsequently as a revision body, in the limited circumstances that would allow such a procedure, in order, where necessary, to harmonise jurisprudence created by the national courts responsible for hearing disputes relating to the Community patent, as it would be unfair if different solutions were reached in similar cases. This could, in particular, relate to the conditions of validity of a certificate issued by the EPO, whose Opposition Division and Board of Appeal are known for their sometimes questionable jurisprudence on conditions of patentability (1), which is not always adhered to by the national courts.

2.5 The supplementary protection certificate (medicines and plant protection products) does not yet exist for the Community patent and will be the subject of a later proposal by the Commission. The Committee considers that it is risky to include in the Court's jurisdiction disputes involving a certificate that has been proposed but whose nature and existence remain uncertain. A different, broader definition of the Court's jurisdiction (for example, Community patents and other Community industrial property certificates) could be considered in order to allow for future developments. The extension of protection or its future application to various fields of patentable inventions will doubtless raise contradictory issues, and one should be cautious about prejudging right now solutions and the nature of certificates which might one day be the subject of decisions by the Community legislator.

2.6 The Committee supports the Court being given the power to adopt interim measures (orders to act or abstain from an act, evidence protection, cease and desist orders) and sanctions, including penalty payments, without which the resolution of disputes would lack effectiveness. For practical reasons, the implementation of the CPC's final or interim enforcement decisions will need to be left to the competent national authorities, who have powers of coercion according to the respective laws. For cases not covered by the conferral of jurisdiction on the Court, national courts remain competent; such cases could include contracts relating to Community patents, or disputes relating to the ownership of such patent. The Committee also supports these solutions, but has a number of specific comments to make about them.

2.7 Finally, the Committee considers the conditions of entry into force of this decision to be logical and necessary, as it requires alterations to national rules on jurisdiction and judicial organisation, about which Member States will have to inform the Commission in advance, as well as the effective and simultaneous creation of the CPC, which will be created by the proposed Council decision commented upon in a separate opinion.

3. Specific comments

3.1 The CFI already has jurisdiction in disputes relating to industrial property with respect to trademarks and designs, which are managed by the Office for Harmonisation in the Internal Market. It might perhaps have been worth considering the creation of an Industrial Property Court attached to the CFI, with jurisdiction over all existing and future Community intellectual property certificates, and a specialised appeal panel within the CFI for these certificates, in order to centralise litigation on industrial property within the Community. However, this question could be looked at in the more distant future, once the patent court has gathered sufficient practical experience — say, after 2013. This possibility of a wider jurisdiction is already open to the CFI's judicial appeals panel. The Committee supports this wholeheartedly.


The President
of the European Economic and Social Committee
Roger BRIESCH

(*) For example, a patent was granted for a genetically modified animal (oncogenic mouse), whereas animal races and species are not patentable.
PRESS RELEASE

2583rd Council Meeting

Competitiveness (Internal Market, Industry and Research)

Brussels, 17 and 18 May 2004

President  Ms Mary HARNEY
An Tánaiste (Deputy Prime Minister) and Minister for Enterprise, Trade and Employment of Ireland
Main results of the Council

Competitiveness and innovation - Better regulation - Council conclusions

REACH - Policy debate on registration, "Day of Care" and the European Chemicals Agency in order to provide political guidance for work ahead.

Community patent - no agreement, due to be referred to the President of the European Council.

Software patentability - political agreement on a common position.

Consumer protection cooperation - confirmation of a draft reading agreement.


Recognition of professional qualifications - political agreement on a common position.

Sales promotions - further examination of the proposal by the Council.

Community Customs Code - political agreement on a common position.
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- The documents whose references are given in the text are available on the Council's Internet site http://ue.eu.int.
- Acts adopted with statements for the Council minutes which may be released to the public are indicated by an asterisk; these statements are available on the above mentioned Council Internet site or may be obtained from the Press Office.

9081/04 (Presse 140)
PARTICIPANTS

The Governments of the Member States and the European Commission were represented as follows:

Belgium:
Ms Patricia CEYSENS
Ms Fientje MOERM
Mr Bernd GENTGES

Flemish Minister for Economic Affairs, Foreign Policy and E-government
Minister for Economic Affairs, Energy, Trade and Scientific Policy
Minister for Education and Training, Culture and Tourism (German-speaking Community)

Czech Republic:
Mr Miroslav SOMOL
Mr Petr KOLAR

Deputy Minister for Industry and Trade
Deputy Minister for Education and Research

Denmark:
Mr Jeppe TRANHOLM MIKKELSEN
Mr Michael DITHMER

Deputy Permanent Representative
State Secretary

Germany:
Mr Jürgen TRITTIN
Mr Georg Wilhelm ADAMOWITSCH
Mr Hansjörg GEIGER
Mr Wolf-Dieter DUDENHAUSEN

Minister for the Environment
State Secretary, Federal Ministry of Economic Affairs and Labour
State Secretary, Federal Ministry of Labour
State Secretary

Estonia:
Mr Meelis ATONEN
Mr Toivo MAIMETS

Minister for Economic Affairs and Communications
Minister for Education and Science

Greece:
Mr Dimitrios SIOUFAS
Mr Christos FOLIAS

Minister for Development
State Secretary for Economic Affairs and Finance

Spain:
Mr Alberto NAVARRO

State Secretary

France:
Mr Patrick DEVEDJIAN
Mr François d’AUBERT
Ms Claudie Haignere

Minister with responsibility for Industry, attached to the Ministre d’Etat, Minister for Economic Affairs, Finance and Industry
Minister with responsibility for Research, attached to the Minister for National Education, Higher Education and Research
Minister with responsibility for European Affairs, attached to the Minister for Foreign Affairs

Ireland:
Mr Michael AHERN

Minister of State at the Department of Enterprise, Trade and Employment (with special responsibility for Trade and Commerce)

Italy:
Mr Antonio MARZANO
Mr Rocco BUTTIGLIONE
Ms Letizia MORATTI

Minister for Production Activities
Minister without portfolio, Minister for Community policies
Minister for Education, the Universities and Research

Cyprus:
Mr Yiorgos LILLIKAS

Minister for Commerce, Industry and Tourism

Latvia:
Mr Juris LUJANS

Minister for Economic Affairs

Lithuania:
Mr Rimantas VAITKUS

Deputy Minister for Education and Science
Mr Nerijus EIDUKEVICIUS
Luxembourg:
Mr Henri GRETHEN

Hungary:
Mr Péter GOTTFRIED

Malta:
Mr Censu GALEA

Netherlands:
Mr Laurens Jan BRINKHORST

Austria:
Mr Martin BARTENSTEIN

Poland:
Mr Krzysztof KRYSTOWSKI
Mr Jaroslaw PIETRAS

Portugal:
Ms Rosário VENTURA
Ms Maria da Graça CARVALHO
Mr Carlos COSTAS NEVES

Slovenia:
Ms Renata VITEZ
Mr Zoran STANČIČ
Mr Matjaž LOGAR

Slovakia:
Mr László POMOTH
Mr Martin FRONC

Finland:
Mr Mauri PEKKARINEN

Sweden:
Ms Lena SOMMESTAD
Ms Ann-Christin NYKVIST
Mr Leif PAGROTSKY

United Kingdom:
Ms Jacqui SMITH

Deputy Minister for the Economy

Minister for Economic Affairs, Minister for Transport

Head of State Secretariat for Integration and External Economic Relations, Ministry of Foreign Affairs

Minister for Competitiveness and Communications

Minister for Economic Affairs

Federal Minister for Economic Affairs and Labour

Under-Secretary of State
State Secretary, Office of the Committee for European Integration

State Secretary for Industry, Trade and Services
Minister for Science and Higher Education
State Secretary for European Affairs

State Secretary for Foreign Economic Relations
State Secretary for Science
State Secretary for the Domestic Market

State Secretary at the Ministry of the Economy
Minister for Education

Minister for Trade and Industry

Minister for the Environment
Minister for Agriculture
Minister for Industry, Employment and Communications

Minister of State for Industry and the Regions and Deputy Minister for Women and Equality

Commission:
Mr Philippe BUSQUIN
Mr Mario MONTI
Mr Erkki LIIKANEN
Mr Jan FIGEL'
Mr Pavel TELIČKA
Mr Frederik BOLKESTEIN
Mr David BYRNE
Ms Margot WALLSTRÖM

Member
Member
Member
Member
Member
Member
Member
Member

9081/04 (Presse 140)
COMMUNITY PATENT

The Council did not reach agreement by unanimity, as required, on the Presidency's compromise proposal for a Council Regulation on the Community patent. Germany, France, Spain and Portugal voted against and Italy abstained. Noting that all conceivable compromise solutions for the only outstanding issue, which concerns the translation of patent claims, had been tried, the Presidency stated its intention to refer this matter to the President of the European Council.

COMMUNITY CUSTOMS CODE - Public deliberation

The Council reached political agreement by a qualified majority, with the Greek, Italian, Maltese, Portuguese and Swedish delegations voting against, on the draft common position on the proposal for a Regulation amending the Council Regulation establishing the Community Customs Code. Once formally adopted, the text will be submitted to the European Parliament for second reading.

The proposal forwarded by the Commission aims to improve security at the external borders, while facilitating trade through simplified procedures and the use of information technology. The main feature of the agreement regards the concept of an Authorised Economic Operator (AEO), the status of which confers benefits in the form of facilitated customs controls relating to safety and security and/or simplifications provided for under customs rules. The status of AEO will be recognised throughout the Community, while the granting of customs simplifications will be left to each Member State to decide on the basis of precise criteria.
Dear President,

By decision of 30 January 2004, the Council, in accordance with Articles 225a and 245 of the EC Treaty, sought the Court of Justice's opinion on a proposal by the Commission for a decision of the Council establishing the Community Patent Court.

I am pleased to send you, in all the official languages, the Court of Justice's opinion on that proposal.

(Complimentary close)

(s.) V. SKOURIS
Opinion

This Opinion of the Court of Justice of the European Communities, given in accordance with Articles 225a EC and 245 EC, deals with the Commission’s proposal of 23 December 2003 for a Council decision establishing the Community Patent Court and concerning appeals before the Court of First Instance (COM(2003) 828 final).

A. General remarks

1. The Court proposes alignment of the wording of the provisions that are common to that proposal and to the Commission’s proposal of 19 November 2003 for a Council decision establishing the European Civil Service Tribunal (COM(2003) 705 final) (“the C.S.T. proposal”), such as Article 1 and Articles 2, 3 and 5 and the third subparagraph of Article 12 of Annex II to this proposal (the “common provisions”).

The Court considers that such an approach ought also to be adopted in the drawing up of future proposals dealing with other judicial panels where there are no overriding reasons to provide otherwise.

Moreover, in this Opinion the Court intends to make the same remarks concerning the provisions of this proposal which form part of the common provisions as it made in its Opinion of 3 February on the C.S.T. proposal, except where there are reasons appertaining to the very nature of the respective judicial panels to adopt a different approach.
2. A fundamental problem with certain of the provisions in the proposal (Articles 5, 6, 10 and 19 of Annex II) concerns the technical manner of their drafting, in that they declare certain provisions of the Statute (or of the Treaty in other articles of the proposal) to be applicable, or they exclude others, only to go on, sometimes in the same article (as is the case in Article 10 of the proposal with regard to Article 40 of the Statute of the Court of Justice), to provide that the Rules of Procedure may derogate from them, or indeed amend or clarify them.

The Court considers that it would be preferable if the text of the proposal set out in a positive and settled manner all the applicable provisions, a drafting technique used, moreover, in the C.S.T. proposal, instead of proceeding by way of making references accepting or rejecting the relevant provisions, with various possible ways of altering them.

3. The Court takes the view that some of the provisions of this proposal may well raise an institutional problem.

The Court considers that the sixth paragraph of Article 225a EC can, theoretically, be interpreted as not only permitting certain provisions of the Statute or of the Treaty not to be applied but also permitting (an "a maiore ad minus" interpretation) them to be amended or clarified.

Nevertheless, there would seem to be a particular problem so far as the second paragraph of Article 14 and Article 22 of the Annex are concerned, inasmuch as those provisions state that no authorisation is required at national level for enforcement of decisions of the Community Patent Court. That involves a significant alteration in the structure of the relationship between the Community legal order and that of the Member States, in that the enforceability of a decision taken by a Community court would have direct effect on the legal relationships in a Member State, whereas all instruments of coercion are to be found at national level, this matter falling within the competence of the Member States, as borne out by Article 256 EC.
The Court considers that it would be preferable to incorporate so far-reaching an amendment in the decision, on the basis of Article 229a EC, conferring on the Court of Justice jurisdiction to rule on disputes concerning the Community patent and, therefore, for that amendment to be adopted by the Member States in accordance with their respective constitutional rules.

B. Specific remarks

4. With regard to Article 4, reference is made in respect of the drafting technicalities to the second general remark above (see paragraph 2 of this Opinion).

So as the reference to Article 243 EC is more particularly concerned, the Court of Justice considers that there is good ground for asking whether it would not be advisable to provide for residual or subsidiary jurisdiction for the national courts in the field of interim measures, all the while ensuring the necessary relation with the exclusive jurisdiction of the Community Patent Court. In fact, the question arises whether the Community Patent Court alone will always be in a position to adopt the interim measures necessary within the periods prescribed.

5. So far as the articles in the proposal concerning Annex II to the Statute of the Court of Justice are concerned, the Court would make the following observations.

6. With regard to the first article, the Court suggests adding an express reference to the decision conferring on the Court of Justice jurisdiction to determine disputes concerning the Community patent.

7. In relation to Articles 2 and 3, which form part of the common provisions and the drafting of which must therefore be aligned with that of the C.S.T. proposal (see paragraph 1, above), the Court refers to paragraphs 9 and 10 of its Opinion on the C.S.T. proposal. In those paragraphs of the C.S.T. proposal, the Court first considered it timely to call the Council’s attention to the fact that it
was possible to provide for an appointment procedure which should include an invitation for applications so as to allow all qualified persons to demonstrate their interest. Second, the Court observed that it would be more appropriate to make it mandatory for the Committee to draw up a list, as provided for. Furthermore, it seemed timely to the Court to clarify the role to be played by that list in the appointment procedure. It might in fact seem logical for the Council to confine its choice to candidates appearing on the list.

The Court suggests, in addition, that the words “on the basis of their competence” used in the second sentence of the first paragraph of Article 2 should be deleted, as is furthermore in keeping with the approach followed in the common provisions.

8. The Court considers that there are grounds for removing the requirement that the Court of First Instance should be consulted, as provided for in the second paragraph of Article 5, given that such a requirement does not appear in the second paragraph of Article 5 of the C.S.T. proposal (the approach followed in the common provisions).

9. As regards Article 7, the Court suggests the following amendments:

- in the first paragraph, deleting the reference to Article 13 of the Statute of the Court of Justice since the qualifications and experience required of the Assistant Rapporteurs mentioned in Article 7, who are in essence technical experts, appear very different from those required of the Assistant Rapporteurs mentioned in that article of the Statute, who must possess the necessary legal qualifications. The content of the second sentence of the second subparagraph of Article 13 of the Statute could be reproduced;

- in the second paragraph, providing that it should be the Community Patent Court and not the Court of Justice that proposes to the Council the appointment of the Assistant Rapporteurs;

- in the third paragraph, providing that, at the request of the formation concerned, the Assistant Rapporteurs may be heard in the deliberations.
10. With regard to Articles 8 (composition of the Chambers and assignment of cases) and 9 (agreement on staff), which form part of the common provisions, their wording ought to be aligned with that of Articles 4 and 6 of the C.S.T. proposal (see also paragraphs 13, 15 and 16 of the Court's Opinion on the C.S.T. proposal).

11. As regards Article 10, while the sixth paragraph of Article 225a EC may, in theory, be interpreted as allowing certain provisions of the Statute to be amended or clarified (see paragraph 3 of this Opinion), the Court nevertheless raises the issue of the drafting technique used (see paragraph 2 of this Opinion).

12. In addition, the Court wishes to raise the question whether the proposal ought not at the very least to lay down some fundamental principles in the sphere of counterclaims, a sphere of great importance in the field of patents, while the details of such claims may be fixed by the Rules of Procedure. It might thus be provided that, in its defence, the defendant may make a counterclaim if the latter relates to the allegations in respect of the subject-matter of the dispute and falling within the jurisdiction of the Community Patent Court.

13. In respect of the excluding of the second paragraph of Article 21 of the Statute of the Court of Justice (requirement that the application is to be accompanied, where appropriate, by the contested measure), as provided for by Article 10 of the Annex, the Court is uncertain whether such exclusion is justified, since the Community Patent Court may find it necessary, inter alia, to rule on the validity of the patent.

14. With regard to Article 40 of the Statute of the Court of Justice, Article 10 of the Annex would seem to entail a drafting problem, in that the second paragraph of Article 10 provides that the Rules of Procedure may derogate from Article 40 of the Statute, whereas the first and third paragraphs of Article 40 have from the start been excluded by the first paragraph of Article 10.
15. However, so far as Article 40 of the Statute of the Court of Justice is concerned, the Court is not persuaded that there is any justification for a generalised exclusion of the right of the Member States and the institutions of the Community to intervene in cases before the Community Patent Court, as provided for by Article 10 of the Annex. The Court wonders whether it would not be more appropriate to confine the right to intervene to certain kinds of proceedings and/or to prescribe conditions for its exercise, since some kinds of proceedings, in particular concerning nullity or a plea of illegality, may be of some public interest.

16. Moreover, the Court proposes the incorporation into this decision of certain principles relating to various technical procedures in the sphere of intervention, such as joinder of a third party or an application by a third party claiming ownership of the subject-matter of the proceedings, to introduce which appears required by the particular characteristics of actions in the field of patents. It could in that manner be provided that:

- anyone who has established that he or she has an interest in the outcome of the dispute may intervene, either in order to support the forms of order sought by one of the parties, or to raise heads of claim against one of the parties relating to claims linked to the subject-matter of the dispute and falling within the jurisdiction of the Community Patent Court;

- every party may request a third-party notice, either in order to make binding on the third party the judgment to be given in the proceedings between the parties, or in order to obtain judgment or an order against the third party, where the claims are related to the subject-matter of the proceedings and fall within the jurisdiction of the Community Patent Court.

17. The Court is not persuaded that there is any justification for excluding Articles 42 (third-party proceedings to contest a judgment) or Article 43 (interpretative judgments) of the Statute of the Court of Justice, as provided for by Article 10 of the Annex. So far as proceedings in which a third party contests a judgment in which it was not heard are concerned, provision could be made for any third party who was neither given leave to intervene nor served with a third-party notice to be able, in circumstances to be settled by the Rules of Procedure, to apply to have a judgment of the
Community Patent Court set aside if it damages that party’s rights. With regard to interpretative judgments, a provision could be added to the effect that, in case of difficulty concerning the meaning or scope of a decision of the Community Patent Court, it is for the latter to interpret it at the request of one of the parties on the conditions laid down by the Rules of Procedure.

18. As regards Article 11, the Court suggests amending the wording of the second paragraph, so that the words “shall be allowed to speak” are replaced by “may be authorised to speak”.

19. With regard to Article 12, the Court insists on making the following remarks:

- in the first paragraph of Article 12, the reference to the sixth paragraph of Article 20 of the Statute of the Court of Justice has to be deleted, for that article consists of five paragraphs only;

- so far as concerns the second paragraph of Article 12, its wording ought to be adjusted to reflect that of the second paragraph of Article 20 of the Statute of the Court of Justice;

- the third paragraph of Article 12 concerns one of the common provisions. The Court must therefore repeat the observation made before in its Opinion on the C.S.T. proposal, viz., that the agreement of the parties is essential if the case is to proceed to judgment without an oral procedure, a rule also laid down in respect of the Court of First Instance (see paragraph 19 of that Opinion);

- the Court considers that it would be better to delete the fourth paragraph of Article 12 concerning the possibility of conducting proceedings, wholly or partly, by electronic means, because that provision appears redundant and it might lend itself to an interpretation a contrario by other Community courts.
20. The Court wonders whether there is any justification for excluding Article 24 of the Statute of the Court of Justice and replacing it with the rule in Article 13 of the Annex, which offers sharply reduced opportunities to order production of evidence. In particular, the question arises whether that provision offers sufficient opportunities in the case of proceedings, especially those relating to nullity or a plea of illegality, likely to be of some public interest.

21. So far as Article 14 of the Annex is concerned, the Court must refer to the general observation made earlier in paragraph 4 above, namely: whether it would not be advisable to provide for residual or subsidiary jurisdiction for the national courts in the field of interim measures, all the while ensuring the necessary relation with the exclusive jurisdiction of the Community Patent Court.

22. The second paragraph of Article 14, on the procedure for seizure of infringing goods, an instrument of some considerable importance in patent law, makes a provision of great novelty in Community law, for the text states that no authorisation is required for the enforcement of those interim measures. As has already been pointed out in paragraph 3 above, the Court considers that it would be better to incorporate an alteration of such magnitude in the decision, based on Article 229a EC, conferring on the Court of Justice jurisdiction to rule on disputes concerning the Community patent, and that it should therefore form the subject-matter of national ratification.

23. Having regard to Article 50(6) of the T.R.I.Ps. agreement, the further question arises:

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ought not Article 14 to fix a time-limit for initiating the main proceedings? ¹

24. The Court considers that the wording of the third paragraph of Article 14 of the proposal ought to be closer to that of Article 50(7) of the T.R.I.Ps Agreement. ² The present wording of this provision poses a problem, for the full significance of the notion of “revoking” in it appears uncertain and it might not cover all the possible situations in question (for example, the situation in which an application concerning the substance of the case is dismissed or in which the period for which an interim measure has been applied for has expired). Furthermore, there arises also the question of which rules govern the conditions to which compensation is subject.

25. Article 17 (revision of a judgment) provides for a significant restriction, in comparison with the ambit of Article 44 of the Statute (namely, in substance, that the new fact should concern a fundamental procedural defect or an act which has been held, by a final judicial decision, to constitute a criminal offence), the basis for which seems not to have been made clear in the statement of reasons for the proposal. The Court therefore questions whether that restriction is justifiable.

26. The Court suggests amending the wording of Article 18 as follows: “The parties may ... conclude their case by way of settlement. They may request that that settlement should be confirmed by a decision ...”

¹ “[P]rovisional measures ... shall, upon request by the defendant, be revoked or otherwise cease to have effect, if proceedings leading to a decision on the merits of the case are not initiated within a reasonable period, to be determined by the judicial authority ordering the measures, where a Member’s law so permits or, in the absence of such a determination, not to exceed 20 working days or 31 calendar days, whichever is longer”.

² “Where the provisional measures are revoked or where they lapse due [sic] to any act or omission by the applicant, or where it is subsequently found that there has no infringement of threat of infringement of an intellectual property right, the judicial authorities shall have the authority to order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by these measures.”
27. With regard to Article 19, one of the common provisions, the Court proposes that its wording should be adjusted in line with that of the corresponding provision of the C.S.T. proposal, namely: Article 8 of Annex I, the drafting technique of which is moreover to be preferred.

28. The Court proposes deleting Article 21, since the object of Article 55 of the Statute of the Court of Justice, viz., information for the Member States, is without relevance in the specific context of the Community Patent Court. That exclusion ought accordingly to be reflected in Article 10 of the Annex.

29. So far as Article 22 is concerned, the Court is intent on making the following remarks:

- as regards the first paragraph, the Court suggests abiding by the terminology used in Article 225a of the Treaty, that is to say, “appeal”, and deleting [in the French version of] the proposal the concepts of “recours” and “pourvoi”.¹ This holds good also for other provisions of the proposal, such as Article 26 of Annex II. In the same paragraph [first line], the word “if” must be replaced by “once”;

- a sentence must be added to the first paragraph, making express provision for interim measures taken by the Community Patent Court to be enforceable;

- with regard to the second paragraph, it is necessary to provide expressly for the wording of the order for enforcement, so as to ensure that the wording is the same in all Member States. The wording of the order must be set out in the text of this proposal. As regards the second sentence of this paragraph, the question arises whether there is any occasion for explaining that decisions of the Community Patent Court are enforceable against Member States, when that already follows from the first paragraph of Article 22;

¹ T.N. These terms, meaning challenge (in this context) and appeal on a point of law, are used in the French, but English uses “appeal” for all of them.
• so far as the third paragraph is concerned, the Court suggests that provision should be made for the detailed rules governing penalties to be laid down in the Rules of Procedure (see also Article 27 of the Statute), in order to allow greater flexibility in the adaptation of the amount to economic reality. If that suggestion should be accepted, the two last sentences of the paragraph could be deleted;

• the Court proposes clarifying (Article 26, second paragraph) that the Community Patent Court may take decisions by which enforcement is suspended as provided for in the fourth paragraph of Article 256 EC;

• the Court considers that the proposal ought to regulate the effect of an appeal on any interim measures taken by the Community Patent Court.

30. With regard to Article 23, the Court proposes adding at the end of the first paragraph the fragment of a sentence: “in conditions to be determined in the Rules of Procedure” and deleting the two last paragraphs of that article.

31. [Does not concern the English text]

32. So far as Article 25 (rules on the use of languages) is concerned, the Court notes that it is clear from Articles 245 and 290 EC, in conjunction with Article 64 of the Statute of the Court, that any amendment of the rules governing language arrangements requires a unanimous decision of the Council. It is therefore important that the decision establishing the Community Patent Court should provide for complete rules governing language arrangements, with the result that it must, for example, include a list of languages of the case.

The Court wonders whether, in certain cases, such as joinder of a third party, application of the rule requiring proceedings to be conducted in the language of the case of the place in which the defendant is domiciled is justified. The Court further wonders whether it would not be appropriate – by analogy with the provisions of the Brussels Convention concerning the jurisdiction of courts in
the place where the harmful event occurred – to provide, in derogation from the rule of the language of the case of the place where the defendant is domiciled, that where the action concerns infringement of a Community patent the applicant may chose as the language of the case the official language (or one of the official languages) of the place where the harmful event took place.

33. So far as Article 26 is concerned, the Court proposes the following amendments:

- in the first sentence of the second paragraph, it would seem preferable to make reference to Article 14 of the Annex and not to Article 243 EC. It appears that the reference to the second paragraph of Article 14 of the Annex has to be replaced with a reference to the second paragraph of Article 13 of the Annex. Likewise, it is suggested that the reference to the fourth paragraph of Article 256 EC should be deleted and replaced with a reference to Article 22 of the Annex (see paragraph 29 above);

- it is suggested that the second sentence of the second paragraph (objection and appeal against judgment on objection) should be moved, so as to become the second paragraph of Article 16;

- since the third paragraph also concerns a decision of a procedural nature, it is proposed that the wording of the fourth paragraph should be adapted as follows: “... an appeal may be brought against other decisions of a procedural nature ...”.

34. Still with regard to Article 26, the Court wonders whether, in the same way as Article 56 of the Statute of the Court of Justice, there is not good ground for adding to the first paragraph that an appeal may also be brought against decisions which dispose of the substantive issues only in part, for example, interlocutory judgments in which it is held that there is an infringement but which provide for the sum of damages to be fixed later, or which dispose of a procedural issue concerning a plea of lack of competence or inadmissibility.
35. Moreover, the Court is in doubt as to the reason for providing in the fourth paragraph of that article that, contrary to the current rules governing appeals, the Rules of Procedure may determine the situations and conditions in which an appeal may be brought against decisions of a procedural nature taken by the Community Patent Court in the course of proceedings. Do not such appeals during proceedings, dividing the procedure into different parts, pose risks to the proper conduct of the proceedings?

36. As regards Article 27 on the limits of appeals, the Court wishes to make the following observations:

- the Court wonders whether the second paragraph of that article, which reproduces the second sentence of the first paragraph of Article 58 of the Statute of the Court of Justice is really necessary, having regard to the fact that that article of the Statute deals with an appeal on points of law only, whereas Article 27 of the proposal deals with a procedure for appeals on fact and law;

- in the third paragraph, the second sentence would seem to be sufficient, so that the first could be deleted.

37. Finally, with regard to Article 61a, the Court considers that providing in a specific article, separate from the general provisions applicable to the Court of First Instance, for the creation of a separate specialist chamber of the Court of First Instance and laying down specific rules on the appointment of the judges of that chamber entails the risk of compromising the structure and integrity of that court. It is the Court's opinion that there is every reason to envisage a more flexible solution consisting, on the one hand, of replacing Article 61a by adding to Article 50 a provision to the effect that a specialist chamber of the Court of First Instance is to hear appeals against decisions of the Community Patent Office and, on the other, of referring in Article 50 to Annex II so far as the procedure to be followed in those appeals is concerned.
SUBJECT: Remaining drafting issues in the Draft Agreement on the establishment of a European patent litigation system (WPL/3/04) and in the Draft Statute of the European Patent Court (WPL/4/04)

DRAWN UP BY: European Patent Office acting on behalf of the Working Party on Litigation

ADDRESSEES: Working Party on Litigation (for opinion)

SUMMARY

The present document refers to a number of technical issues which should be considered in order to finalise the drafts of the Agreement and Statute.
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I. INTRODUCTION

1. The further work on the Draft Agreement on the establishment of a European patent litigation system (WPL/3/04) and the Draft Statute of the European Patent Court (WPL/4/04) concerns various aspects of the law-making process:

   • substantive review of the definitions in Article 1 of the Agreement
   • resolution of the conflict between Article 21a(2) of the Agreement and Article 13(2)(b) of the Statute
   • clarification of terminological issues in the three texts of the Agreement
   • creation of the statistical basis for obtaining the figures needed to apply the proposed distribution key.

2. In addition, a detailed comparison between the EPLA and Directive 2004/48 on the enforcement of intellectual property rights must be carried out in order to ensure that the EPLA is in conformity with the minimum requirements set by the Directive.

II. SUBSTANTIVE ISSUES

3. Article 1 of the Agreement defines the terms “Court of First Instance”, “Court of Appeal”, “European Patent Court” and “Facultative Advisory Council”. It is doubtful whether these definitions have a clarifying effect. These organs of the European Patent Judiciary are set up and defined by Article 3(2) and Article 4 in conjunction with Article 83a. These articles have a central importance as founding provisions. To refer to the organs twice, with a different significance (purely terminological in Article 1; constitutive in Articles 3, 4 and 83a), is undesirable.

4. Moreover, the definition in Article 1(h), unlike those in the other paragraphs, describes the function of the organ concerned, but the description does not correspond to the more precise information in Article 83b.

5. The definitions of terms in Article 1(e) to (h) should therefore be deleted.

6. In Articles 21(3)(b) and 91(1), the Draft Agreement refers to “the number of European patents ... which are the subject of litigation before the European Patent Court”. A new definition is needed to make it clear that the only relevant legal disputes in this connection are those which concern infringement or revocation, or other matters for which the European Patent Court has jurisdiction.
7. The issue of the distribution key for states wishing to accede only to the part of the Agreement concerning the Facultative Advisory Council is settled in Article 83e(1)(c) of the Agreement. However, the question of how to calculate the initial contributions of those states remains open. For states which also accede to the judicative part of the Agreement, the question is resolved in Article 91.

8. The relationship of Article 13(2)(b) of the Statute to Article 21a(2) of the Agreement needs to be clarified. Under Article 13 of the Statute, the fees payable to the court are to be received by the Registrar; under Article 21a of the Agreement, court fees are to be collected by the Regional Divisions.

III. STATISTICS

9. Under Article 90(1), the entry into force of the Agreement depends inter alia on ratification or accession by at least one of the three states in which the highest number of European patents was in force in the year preceding the Diplomatic Conference. The distribution key under Article 21 also refers, in paragraph 3(a), to the number of European patents in force in a state, as does Article 91, dealing with the first distribution key and initial contributions.

10. Unless the figures compiled by the European Patent Office are used, the states themselves will have to keep and continuously update statistical records of the number of European patents in force.

11. So far, only a few states have supplied exact figures for European patents which have become the subject of infringement or revocation proceedings before national courts. For the purpose of applying Articles 21(2)(b) and 91(1) of the Agreement, the relevant data will have to be gathered from the contracting states.

IV. QUESTIONS OF LEGAL TERMINOLOGY

12. Close inspection of the three versions of the Draft Agreement and Statute has revealed a few, mainly translation-related, questions of legal terminology. It is recommended that an editorial committee be set up in advance to finalise the Basic Proposal as far as possible before transmission to a Diplomatic Conference.

V. CONFORMITY WITH DIRECTIVE 2004/48 ON THE ENFORCEMENT OF INTELLECTUAL PROPERTY RIGHTS

14. The Directive aims at harmonising, and in some respect strengthening, civil procedures for enforcing all intellectual property rights. It requires that Member States make available a number of measures, procedures and remedies applying to any infringement of IP rights as provided for by Community law and/or by the national law of the EU Member States, including European patents (Art. 2(1) Directive). Member States are required to bring into force the laws, regulations and administrative provisions to comply with the Directive by 29 April 2006. In many instances, this will only imply that secondary legislation - rules of procedure, regulations on court practice - be adapted or amended to comply with the Directive.

15. The Working Party on Litigation took great care during the preparatory work in the years 1999-2003 to observe the existing Community legal order when drafting the EPLA. Likewise, it should be ensured that the procedural framework of the EPLA - that is, the relevant provisions of the Draft Agreement and Statute, the Rules of Procedure of the European Patent Court and any Practice Directions of the Court - is in conformity with the new Directive.

16. The first review of the Directive indicates that only a few minor changes to the provisions of the Draft Agreement would be necessary in order to ensure conformity with the Directive. A few preliminary remarks can be made at this stage.

17. First of all, the Directive only lays down minimum requirements: the Directive thus applies without prejudice to other means to enforce IP rights which are more favourable to right holders.

It follows that a provision such as Art. 54(2) Draft Agreement - which seems to have no counterpart in the Directive - would not be affected by the Directive: indeed, Art. 54(2) Draft Agreement provides that a patent proprietor may obtain from the European Patent Court an order obliging not only the opposing party but also a third party to produce evidence in his possession. This seems to be more favourable than Art. 6 Directive which only refers to the opposing party.

18. Secondly, the Directive is often markedly longer than the relevant provisions in the Draft Agreement (Part IV "Procedure before the European Patent Court", Arts. 60 to 75). Mostly, the Directive merely spells out what is implicit in the Draft Agreement: for instance,

Under Art. 6(2) Directive, courts must be empowered, in the case of an infringement committed on a commercial scale, to order "the communication of banking, financial or commercial documents under the control of the opposing party". Under Art. 54(1) Draft Agreement, the European Patent Court may order a party to produce "evidence relevant to" a substantiated claim. It is arguable that the Directive only spells out details which may be derived from Art. 54(1) Draft Agreement, and which will be contained in the Rules of Procedure of the European Patent Court.
Art. 8(1)a) to d) Directive lists the various persons who must provide information on the origin and distribution networks of the (infringing) goods, whereas Art. 68 Draft Agreement only refers to “any third party involved in the production and distribution of infringing goods ...”. The detailed list in Art. 8(1)a) to d) Directive is covered by the words “any third person” in Art. 68 Draft Agreement - or, if deemed necessary, the list could be included in the Rules of Procedure of the European Patent Court.

Art. 15 Directive on the “Publication of judicial decisions” provides that “appropriate measures for the dissemination of the information concerning the decision ...” may be ordered by the court, at the expense of the infringer. Art. 65(4) Draft Agreement only provides that “in awarding damages, the European Patent Court may ... order the party infringing the European patent to perform ... certain acts”.

19. It is important to recall at this stage that detailed Rules of Procedure of the European Patent Court will be prepared before entry into force of the EPLA. Some of the more detailed provisions contained in the Directive will be at their right place in these Rules of Procedure. The Directive need not be implemented directly into the Draft Agreement; in most instances, it will be more appropriate that the Rules of Procedure and any Practice Directions ensure compliance with the Directive, so that any future amendment of the Directive can be incorporated in the EPLA framework also.

20. Finally, smaller amendments to the Draft Agreement proper could be contemplated:

Under Art. 4b) Directive, application of the measures, procedures and remedies provided for in the Directive may be sought by any licensee, in so far as permitted by and in accordance with national law. (Art. 51(2) Draft Agreement only refers to exclusive licensees).

The Directive expressly mentions the need to protect the identity of witnesses (Art. 7(5) Directive).

VI. RULES OF PROCEDURE OF THE EUROPEAN PATENT COURT

21. In several places in the current Draft Agreement (WPL/3/04) and Statute (WPL/4/04), references are made to Rules of Procedure of the European Patent Court. In addition, as seen above, Directive 2004/48 contains provisions which should be taken into account when preparing the Rules of Procedure of the European Patent Court.

22. In the years 2000 and 2001, the Working Party on Litigation and the Sub-Group of the Working Party discussed many provisions which will eventually be contained in these Rules of Procedure, but a formal proposal has not yet been prepared. It will be a tremendous and fascinating task to prepare Rules of procedure for a new European court settling disputes between private parties in patent matters, and indeed crucial for ensuring that the new Court adopts the most efficient and fair procedural practices and thus becomes an attractive forum for resolving patent disputes in Europe.
23. In the time - at all events between 3 and 5 years - between any Diplomatic Conference for the adoption of the EPLA and entry into force of the EPLA, an interim committee composed of experts and judges from the participating states will be set up and charged with the preparation of draft Rules of Procedure for the European Patent Court. Eventually, the Rules of Procedure will be adopted at the first meeting of the Administrative Committee of the European Patent Judiciary (Art. 17(2)a) EPLA).
SUBJECT: Comments on the Draft Agreement on the establishment of a European patent litigation system

DRAWN UP BY: Polish delegation

ADDRESSEES: Sub-group of the Working Party on Litigation (for opinion)

This document has been distributed in English only.
Mr. Roland Grossenbacher
Chairman
Administrative Council
EPO
Munich

Dear Mr. Grossenbacher,

With reference to the settlements made during the June meeting of the Working Party on Litigation I present below some comments concerning the solutions foreseen in Draft Agreement on the establishment of a European patent litigation system.

- In accordance with Art.57 (1) of the Draft Agreement, parties to the proceeding in front of the European Patent Court, pay a fee in accordance with decisions made by Administrative Council. The fees supposed to be paid in advance, and the lack of payment of the fee may result in excluding the party from further participation in the proceedings. Regulations of the Draft Agreement as well as the regulations of the Statutes of European Patent Court (called from now the Draft Statutes) do not foresee a possibility of fee exemption within the framework of legal aid institution. There is also no such possibility under the provisions of Art. 21 of the Draft Agreement which stipulates setting an obligatory court fee, on such a level, to keep the balance between the right of access to the Court, and the principle that the European Patent Court supports itself from its own proceeds. Furthermore, the principle of supporting the European Patent Court from its own proceeds can with the lack of clear regulations in the area of total, or partial fee exemptions result in tendency among the members of jury of the European Patent Court to over rigorous stand on this matter. In connection with this and regarding the right to enforce ones rights it seems justified introducing to the Draft Agreement a regulation enabling partial, or total fee exemption of the party.
The contents of Art. 67 also raises certain doubts, when providing for 5 year period for asserting compensation for the party that has known or could have found out about infringement of its rights resulting from its patent. It seems that the five year long period, starting from the date when the party finds out about infringement, is too long considering the pace of technological progress as well as the certainty of economic transactions. This issue should in our opinion be also reconsidered.

Yours sincerely,

[Signature]

DRAWN UP BY: European Patent Office acting on behalf of the sub-group of the Working Party on Litigation

ADDRESSEES: Sub-group of the Working Party on Litigation (for opinion)

SUMMARY

The first part of this document presents the proposed amendments to the draft Agreement on the establishment of a European patent litigation system which are considered necessary following the adoption of Directive 2004/48/EC on the enforcement of intellectual property rights.

The second part gives an overview of the provisions in Directive 2004/48/EC which have not led to changes to the draft Agreement.

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I. PART ONE - PROPOSED AMENDMENTS TO THE DRAFT AGREEMENT FOLLOWING THE ADOPTION OF DIRECTIVE 2004/48/EC

The table below sets out the amendments which are proposed to the draft Agreement:

- the left-hand column refers to the relevant provisions in Directive 2004/48/EC and contains short explanatory remarks;
- the right-hand column contains the proposed new wording (in grey hatching).

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<td>Article 4 Directive 2004/48/EC reads: &quot;Member States shall recognise as persons entitled to seek application of the measures, procedures and remedies referred to in this chapter: (a) the holders of intellectual property rights, in accordance with the provisions of the applicable law; (b) all other persons authorised to use those rights, in particular licensees, in so far as permitted by and in accordance with the provisions of the applicable law;&quot;</td>
<td>(1) The right of a natural or legal person, or any body equivalent to a legal person, to be party to the proceedings shall be determined by the applicable national law. (2) The holder of an exclusive licence under a European patent may initiate litigation before the European Patent Court in the same way as the proprietor of the patent unless the licensing agreement provides otherwise. The holders of other licences may initiate litigation before the Court in so far as permitted by the applicable national law</td>
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It is proposed to align Article 51 draft Agreement on Article 4(b) Directive 2004/48/EC by expressly stating that the right of holders of other licences to initiate litigation before the European Patent Court is dealt with by national law.
### Relevant provisions of Directive 2004/48/EC and explanatory remarks

**Article 6.1** Directive 2004/48/EC reads: "Member States shall ensure that, on application by a party which 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 opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information."

The terms "evidence which lies in the control of the opposing party" seem to allow a broader variety of evidence to be presented than "evidence in the possession of another party". It is therefore proposed to bring Article 54 draft Agreement into line with Directive 2004/48/EC.

### Proposed amendments to the draft Agreement

**Article 54**

**Production of evidence by other or third parties**

(1) Where a party has sufficiently substantiated a claim and specified evidence relevant to such claim which lies in the control of another party, the European Patent Court may order the other party to produce such evidence.

(2) Where a party has sufficiently substantiated a claim and specified evidence relevant to such claim which is likely to be in the possession or control of a third party due to its relationship to another party, the European Patent Court may order that third party to produce such evidence. (...)

**Article 54e**

**Protection of confidential information**

To safeguard a party's or a third party's trade secrets or other confidential information, or to prevent an abuse of evidence, the European Patent Court may order that the use of evidence in proceedings before it be restricted or prohibited or that access to such evidence be restricted to certain persons.

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To safeguard a party's or a third party's trade secrets or other confidential information, or to prevent an abuse of evidence, the European Patent Court may order that the use of evidence in proceedings before it be restricted or prohibited or that access to such evidence be restricted to certain persons. |
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| Article 7.5 Directive 2004/48/EC reads: "Member States may take measures to protect witnesses' identity". | Article 49  
Public proceedings  
Proceedings before the European Patent Court shall be public unless and in so far as the Court decides otherwise for reasons of public order or any other compelling reason, particularly in order to protect witness's identity or the trade secrets of one of the parties or any other interested person. |
| It is proposed that this option be taken up in the draft Agreement. | |
| Article 7.1 Directive 2004/48/EC reads: "Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed." | Article 70  
General  
(1) Where measures are ordered ex parte, the parties affected shall be informed, after the execution of the measures at the latest. A review shall take place upon request of the parties affected with a view to deciding whether the measures shall be modified, revoked or confirmed.  
(4) Where measures are ordered ex parte, the parties affected shall be informed, after the execution of the measures at the latest. A review shall take place upon request of the parties affected with a view to deciding whether the measures shall be modified, revoked or confirmed.  
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(4) Where measures are ordered ex parte, the parties affected shall be informed, after the execution of the measures at the latest. A review shall take place upon request of the parties affected with a view to deciding whether the measures shall be modified, revoked or confirmed. |
| It is proposed to include a similar provision in the draft Agreement. | |
### Relevant provisions of Directive 2004/48/EC and explanatory remarks

Article 7.3 Directive 2004/48/EC reads: "Member States shall ensure that the measures to preserve evidence are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if the applicant does not institute, within a reasonable period, proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer."

It is proposed to align Article 70(5) draft Agreement on Article 7.3 Directive 2004/48/EC and on Article 50(6) TRIPs Agreement.

It is not proposed to include in the draft Agreement the alternative "20 working days" / "31 calendar days": as the European Patent Court will be an international court issuing cross-border orders and as national holidays differ, an alternative would only give rise to complications and matter of additional disputes. By contrast, the rule "31 calendar days" leaves no room for ambiguity or interpretation.

### Proposed amendments to the draft Agreement

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<td>5) Provisional or protective measures shall be revoked or otherwise cease to have effect, upon request of the affected party, if proceedings as to the merits are not instituted before the European Patent Court within a reasonable period to be determined by the Court or, in the absence of such determination, within a period not exceeding 31 calendar days.</td>
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II. PART TWO -

OVERVIEW OF PROVISIONS IN DIRECTIVE 2004/48/EC WHICH HAVE NOT LED TO CHANGES TO THE DRAFT AGREEMENT

1. First of all, it is plain that several provisions in Directive 2004/48/EC do not fit in the draft Agreement:

   - Articles 1 and 2 concerning the subject matter and scope of the Directive;
   - Article 3 which states in broad terms the "General obligation" of the Member States under the Directive;
   - Articles 4(c) and (d) and 5 which concern copyright and related rights;
   - Articles 17, 18 and 19 containing provisions on "codes of conduct" and "administrative cooperation";
   - Articles 20, 21 and 22 on implementation, entry into force and addressees.

2. Secondly, the draft Agreement already contains quite detailed provisions relating to procedural matters and in particular to the "Powers of the European Patent Court" and "Provisional and protective measures" (Chapters II and III of Part IV of the draft Agreement). The table below gives an overview of the provisions in Directive 2004/48/EC which need not be transposed into the draft Agreement because the draft Agreement already contains corresponding provisions – or at least provisions which "cover" the minimum requirements set by the Directive.

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3. In addition, Directive 2004/48/EC contains two "may-clauses" which do not need to be transposed into the draft Agreement: Articles 12 and 16 on alternative measures and other appropriate sanctions.

4. Finally, it must be kept in mind that the Working Party on Litigation and the subgroup have endeavoured since 2002 to include in the draft Agreement only the most fundamental provisions while leaving aside for the time being matters which can be included in future Rules of Procedure of the European Patent Court and in Practice Directions of the Court (see, for instance, WPL/SUB 2/02, page I). Accordingly, a number of provisions of Directive 2004/48/EC should not be implemented into the draft Agreement itself but will be at their right place in future Rules of Procedure and Practice Directions. This will also allow easy adaptation of these Rules of Procedure and Practice Directions in case of future changes to the Directive or further Community legislation in this field.

Below, some examples of provisions from Directive 2004/48/EC which should not be included in the draft Agreement but belong in the future Rules of Procedure and Practice Directions:

- Article 6(1), last sentence, defines the terms "reasonable evidence"; Article 6(2) spells out which documents may be communicated to the court;
- Article 8(2) defines more precisely the information which the court may order an infringer to provide;
- Article 15 provides for publication of judicial decisions at the expense of the infringer.
SUMMARY

The present document contains the draft Agreement on the establishment of a European patent litigation system, as amended in the light of Directive 2004/48/EC on the enforcement of intellectual property rights. The amendments relate to Articles 49, 51, 54, 54a, 70 and 75 of the draft Agreement.

It should be noted that some provisions of the Directive need not be implemented into the draft Agreement but will be at their right place in future Rules of procedure of the European Patent Court and in the Practice Directions of the Court. This approach is in line with the approach adopted so far by the Working Party on Litigation: to retain in the draft Agreement only the most fundamental provisions while leaving aside matters which can be included in Rules of procedure and Practice Directions (see WPL/SUB 2/02, page 1).

A few other changes to the draft Agreement have been made for the purpose of clarification (Articles 1, 21a, 84, 91) and on terminological grounds (Article 43, French text, and Articles 54a and 76, English text).

All amendments to the articles are indicated by means of grey hatching.

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SUMMARY OF CONTENTS OF THE DRAFT EUROPEAN PATENT LITIGATION AGREEMENT

Preamble

Sets out the endeavours of the Contracting States and the goals of the Agreement: improve the enforcement of European patents, enhance legal certainty and promote the uniform application and interpretation of European patent law.

Refers to the legal framework which surrounds the Agreement and from which many provisions are drawn: the EPC 2000, the TRIPs Agreement and Community law (in particular, the Agreement relating to Community patents of 1989, the Brussels and Lugano Conventions, Regulation 44/2001 and the Enforcement Directive).

PART I  GENERAL AND INSTITUTIONAL PROVISIONS

Chapter I  General provisions (Arts. 1 to 9)

Set up a new international organisation, the European Patent Judiciary (EPJ), to settle litigation concerning the infringement and validity of European patents effective in the Contracting States which commit themselves to this new integrated judicial system.

List the organs of the EPJ: the European Patent Court and the Administrative Committee.

Set up the Facultative Advisory Council (FAC).

Lay down the autonomy, legal status, seat, privileges and immunities and liability of the EPJ, as well as the judicial independence of the European Patent Court.

Chapter II  European Patent Court (Arts. 10 to 12)

Comprises the Court of First Instance, the Court of Appeal and the Registry.

The Central Division of the Court of First Instance, the Court of Appeal and the Registry shall be set up at the seat of the EPJ.

A number of Regional Divisions may be set up in the Contracting States by the Administrative Committee, and a sub-registry shall be set up at the location of any Regional Division.

Chapter III  Administrative Committee (Arts. 13 to 19)

Composed of representatives of the Contracting States.
Supervises the European Patent Court, without prejudice to the Court's judicial independence.

Sets up Regional Divisions upon request, appoints judges and the Registrar and exercises legislative and budgetary powers.

**PART II  FINANCIAL PROVISIONS (Arts. 20 to 31)**

Based on the assumption that the EPJ will be financed by its own resources (court fees).

Contributions by the Contracting States are foreseen if the EPJ is unable to balance its budget with its own resources (distribution key taking into account three elements: number of European patents effective in the Contracting States, actual litigation activity, equal distribution of a part of the costs).

Provisions on advances, budget, authorisation for expenditure, accounting period, auditing of accounts.

**PART III  SUBSTANTIVE PATENT LAW, JURISDICTION AND EFFECT OF DECISIONS**

**Chapter I  Substantive patent law (Arts. 32 to 37)**

Definitions of infringing acts and indirect infringement, rules governing limitations on the effects of European patents and reversal of the burden of proof when the subject-matter of the patent is a process for obtaining a new product, provisions concerning prior use.

**Chapter II  Jurisdiction and effect of decisions (Arts. 38 to 44)**

The European Patent Court will deal with European patents effective in one or more of the Contracting States.

It will have jurisdiction in respect of actions for actual or threatened infringement or for a declaration of non-infringement, actions or counterclaims for revocation, and actions for damages or compensation derived from the provisional protection conferred by a published European patent application.

After a 7-year transitional period, the Court will have exclusive jurisdiction to try actions for revocation and actions for infringement where the alleged infringer is domiciled in a Contracting State or where all parties are in agreement; moreover, it will have non exclusive jurisdiction to try actions for infringement where the alleged infringement occurred in a Contracting State even though the alleged infringer is not domiciled in a Contracting State.
Rules of Procedure will regulate the allocation of cases to the Central or a Regional Division of the Court of First Instance, taking account of the Brussels and Lugano Conventions as well as Regulation 44/2001: originary actions for revocation shall be brought before the Central Division; it will be possible to bring actions for infringement before either the Division of the country where the defendant is domiciled or the Division of the country where the alleged infringement occurred.

The application of Community law will be guaranteed by the Court of Justice of the European Communities which on request by the European Patent Court will issue preliminary rulings binding for the latter in so far as its decision takes effect in a Member State of the European Union.

The Contracting States will designate the European Patent Court as their national court for cases concerning the infringement and validity of European patents, so that decisions of the Court will be directly enforceable in all Contracting States without any form of recognition or exequatur.

Chapter III Jurisdiction of national courts (Arts. 45 to 47)

National courts will retain jurisdiction to order provisional and protective measures provided for by their national law and to order provisional seizure of goods as security for any damages, compensation, costs or any other payment resulting from proceedings before the European Patent Court.

PART IV PROCEDURE BEFORE THE EUROPEAN PATENT COURT

Includes a chapter laying down basic procedural principles and two chapters on the powers of the European Patent Court and on provisional and protective measures.

Chapter I General Provisions (Arts. 48 to 59)

Lay down basic procedural provisions concerning case management, publicity, right to be heard, admissibility as a party, oral proceedings, party disposition.

Include a list of means of giving and obtaining evidence and rules on the onus of proof, production of evidence, witnesses, court fees and apportionment of costs (loser pays costs, apportionment when equitable).

Rules of Procedure shall lay down the details of proceedings before the European Patent Court.
Chapter II  Powers of the European Patent Court (Arts. 60 to 69)

The Court’s power to order measures, securities, sanctions and fines as laid down in the Agreement is provided for in a general provision.

Specific powers are defined: the European Patent Court may order
- astreintes, where a party does not comply with an order of the Court
- injunctions, such as orders to desist from infringing acts
- forfeiture, meaning the destruction or disposal of infringing goods, materials or devices
- damages, which may not be punitive but must be adequate to compensate for the injury suffered and restore the injured party to the position he would have been in if no infringement had taken place.

Chapter III  Provisional and protective measures (Arts. 70 to 75)

Finally, the European Patent Court shall have the power to order provisional and protective orders such as inspection of premises and the preservation of evidence ("saisie contrefaçon"), freezing orders and sequestration of allegedly infringing goods.

PART V  PROCEDURAL REMEDIES

Two procedural remedies will be available before the European Patent Court: from decisions of the Court of First Instance an appeal shall lie to the Court of Appeal; as an extraordinary remedy any party may file a petition for review.

Chapter I  Appeal (Arts. 76 to 81)

The appeal is the ordinary procedural remedy with suspensive effect.

As a general rule, only final decisions shall be appealable.

The appeal may only be based on the grounds that the facts alleged by the parties were not correctly established, or that, based on the established facts, the law was not correctly applied.

New facts or evidence may only be taken into consideration by the Court of Appeal in exceptional cases.
Chapter II Review of decision (Arts. 82 and 83)

As a limited judicial review, any party which is adversely affected by a decision against which an appeal is not or no longer possible may file a petition of review by the Court of Appeal.

A petition may only be filed on the grounds that a criminal act may have had an impact on the decision, or that a fundamental procedural defect has occurred in proceedings before the Court of Appeal.

PART Va FACULTATIVE ADVISORY COUNCIL (Arts. 83a to 83f)

The Court of Appeal shall perform the functions of the Facultative Advisory Council (FAC), i.e. deliver non-binding opinions on any point of law concerning European or harmonised national patent law, at the request of a national court or quasi-judicial authority.

Special provisions deal with the law applicable to the FAC and the procedure regarding the delivery of opinions. A reservation system enables the Contracting States to be bound only by Part Va, and thus to participate in FAC-related matters only (financing, voting rights in the Administrative Committee).

PART VI TRANSITIONAL AND FINAL PROVISIONS (Arts. 85 to 99)

Clarify the application of the Agreement to effective European patents and pending patent applications.

Transitional period of seven years, where national courts of the Contracting States will have a parallel jurisdiction to the European Patent Court.

Provisions on signature, ratification, entry into force and revision.
The following abbreviations are used in the left margins:

- **Brussels Convention** - Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, 1968
- **COPAC Statute** - Protocol on the Statute of the Common Appeal Court
- **CPC 1989** - Community Patent Convention, as amended by the Agreement relating to Community patents, 1989
- **EPC** - European Patent Convention as revised on 29 November 2000 (new text of the EPC, Special edition No 4 of the OJ EPO 2001)
- **Lugano Convention** - Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, 1988
- **ProtLit 1989** - Protocol on the settlement of litigation concerning the infringement and validity of Community patents
- **RoP** - Rules of Procedure of the European Patent Court (to be adopted by the Administrative Committee)
- **TRIPs** - Agreement on Trade-Related Aspects of Intellectual Property Rights, 1994
DRAFT AGREEMENT
ON THE ESTABLISHMENT
OF A EUROPEAN PATENT LITIGATION SYSTEM

Preamble

THE CONTRACTING STATES,

CONSIDERING that co-operation among the countries of Europe in the field of patents renders a significant contribution to the legal and economic integration of Europe,

WISHING to promote the uniform application and interpretation of European patent law, to improve the enforcement of European patents and to enhance legal certainty by setting up a European Patent Judiciary to settle litigation concerning the infringement and validity of European patents effective in one or more of the Contracting States,

WISHING additionally to promote the uniform application and interpretation of European patent law as well as of harmonised national patent law by enabling the European Patent Judiciary to deliver non-binding opinions on any point of law concerning European or harmonised national patent law,

DESIRING, for this purpose, to conclude an Agreement on the Establishment of a European Patent Litigation System which constitutes a special agreement within the meaning of Article 149a of the European Patent Convention as revised on 29 November 2000, and within the meaning of Article 19 of the Paris Convention for the Protection of Industrial Property as revised on 14 July 1967,
CONSIDERING that it is essential for this Agreement not to conflict with the Treaty establishing the European Economic Community and that the Court of Justice of the European Communities must be able to ensure the uniformity of the Community legal order,

CONSIDERING that it is also essential for this Agreement to take into account the Agreement on Trade-related Aspects of Intellectual Property Rights, annexed to the Agreement Establishing the World Trade Organization of 15 April 1994,

MINDFUL that the European Patent Judiciary should have an international character and represent equitably the different legal cultures of Europe,

HAVE AGREED AS FOLLOWS
The terms "Court of First Instance", "Court of Appeal", "European Patent Court" and "Facultative Advisory Council" are constitutively defined by Arts. 3(2) and 4 in conjunction with Art. 83a Draft Agreement. The declaratory definitions relating to these bodies in Art. 1 Draft Agreement could be misleading, instead of having a clarifying effect. It is
therefore proposed that these definitions be deleted from Art. 1.

Title of ProtLit 1989

Article 2 System of law for litigation concerning European patents

A system of law, common to the Contracting States, for the settlement of litigation concerning the infringement and validity of European patents is hereby established.

Article 3 European Patent Judiciary

(1) A European Patent Judiciary is hereby set up to settle litigation concerning the infringement and validity of European patents effective in one or more of the Contracting States. The European Patent Judiciary shall have judicial, administrative and financial autonomy.

(2) The organs of the European Patent Judiciary shall be:

(a) the European Patent Court, comprising the Court of First Instance, the Court of Appeal and a Registry

(b) the Administrative Committee.

(3) The European Patent Court shall perform the functions assigned to it by this Agreement.
Art. 23(3) EPC; the Registrar is included because of his important functions in and for the judicial procedure.

Art. 5(1) and (2) EPC

Art. 5(3) EPC

(4) Subject to Article 5, the European Patent Court shall be supervised by the Administrative Committee.

Article 4 Facultative Advisory Council

Within the European Patent Judiciary, a Facultative Advisory Council shall be set up, functioning under the provisions of Part Va of this Agreement.

Article 5 Judicial independence

The European Patent Court, its judges and the Registrar shall enjoy judicial independence. In their decisions, the judges shall not be bound by any instructions and shall comply only with the provisions of this Agreement.

Article 6 Legal status

(1) The European Patent Judiciary shall have legal personality.

(2) In each of the Contracting States, the European Patent Judiciary shall enjoy the most extensive legal capacity accorded to legal persons under the national law of that State; it may in particular acquire or dispose of movable and immovable property and may be a party to legal proceedings.

(3) The European Patent Judiciary shall be represented by the President of the Court of Appeal.
Article 7  Seat

(1) The European Patent Judiciary shall have its seat in ***.

(2) The Court of First Instance shall comprise Regional Divisions located in those Contracting States in which such Divisions are set up in accordance with the Statute.

(3) Any Contracting State shall designate at least one national court which, if the European Patent Court wishes to conduct parts of the proceedings in that State, shall provide the facilities necessary for that purpose.

Article 8  Privileges and immunities

The Protocol on Privileges and Immunities of the European Patent Judiciary, annexed to this Agreement, shall define the conditions under which the employees of the European Patent Judiciary and such other persons specified in that Protocol as take part in the work of the European Patent Judiciary, shall enjoy, in each Contracting State, the privileges and immunities necessary for the performance of their duties.

Article 9  Liability

(1) The contractual liability of the European Patent Judiciary shall be governed by the law applicable to the contract in question.
Although it is conceivable that the courts of the state in which the European Patent Judiciary has its seat will be exclusively competent to deal with claims for damages, sentence 2 of paragraph 2 further underlines the concept of regionalisation. Moreover the liability of the judges from abroad participating in cases before the Regional Division shall be governed by the law of the Contracting State in which the Regional Division is located.

The third sentence has been drafted in the light of § 839(2) German Civil Code (BGB) and the interpretation of this provision by the courts. Such provisions have traditionally been considered a safeguard for judicial independence; in modern legal literature they are regarded as a safeguard for the res judicata effect of judicial decisions.

(2) In matters relating to tort, delict or quasi-delict the liability of the European Patent Judiciary in respect of any damage caused by it or its employees in the performance of their duties shall be governed by the law of [state of seat of European Patent Judiciary]. Where such damage is caused by a Regional Division, the members of a panel of this Regional Division or its employees, the law of the Contracting State in which this Regional Division is located shall apply.

If such damage occurs in connection with a judicial decision terminating proceedings before the European Patent Court, the European Patent Judiciary shall be liable only if this decision involved a criminal breach of duty and there is no legal remedy against it.
CHAPTER II  EUROPEAN PATENT COURT

Article 10  Court of First Instance

(1) The Court of First Instance shall comprise a Central Division set up at the seat of the European Patent Judiciary.

(2) The Administrative Committee shall have the power to set up or discontinue Regional Divisions of the Court of First Instance in accordance with the Statute.

Article 11  Court of Appeal

The Court of Appeal shall be set up at the seat of the European Patent Judiciary.

Article 12  Registry

(1) The Registry shall be set up at the seat of the European Patent Judiciary. It shall be managed by the Registrar and perform the functions assigned to it by the Statute.

(2) A sub-registry shall be set up at the location of any Regional Division.
CHAPTER III ADMINISTRATIVE COMMITTEE

Article 13 Composition

Art. 26(1) EPC
The Administrative Committee shall be composed of the representatives and alternate representatives of the Contracting States. Each Contracting State shall be entitled to appoint one representative and one alternate representative.

Article 14 Chair

Art. 27 EPC
(1) The Administrative Committee shall elect a chairman and a deputy chairman from among the representatives and alternate representatives of the Contracting States. The deputy chairman shall replace the chairman ex officio if the latter is prevented from carrying out his duties.

(2) The chairman and deputy chairman shall hold office for three years. They may be re-elected.

Article 15 Meetings

Art. 29(1) EPC
(1) Meetings of the Administrative Committee shall be convened by its chairman.

Art. 29(2) EPC
(2) The members of the Executive Committee, as established under the Statute, or their substitutes, may take part in the deliberations of the Administrative Committee.

(3) Representatives of any other Contracting State to the European Patent Convention and of States entitled to accede to that Convention shall, on reasoned request, be admitted as observers.
Art. 30(3) EPC  
(4) The Administrative Committee may allow any intergovernmental and international non-governmental organisation to be represented by observers.

Art. 29(3) EPC  
(5) The Administrative Committee shall meet at least once a year. It shall also meet on the initiative of its chairman or at the request of at least three Contracting States or of the Executive Committee.

Art. 31(1) EPC  
Letter (a): aiming at greater flexibility; see Art. 18(2)

Article 16 Languages

The languages used in the deliberations of the Administrative Committee shall be English, French and German.

Article 17 Competence of the Administrative Committee in certain cases

(1) The Administrative Committee shall be competent to amend:

(a) the provisions of the Statute

(b) the time limits laid down in this Agreement or the Statute.

(2) In conformity with this Agreement and the Statute, the Administrative Committee shall be competent to adopt or amend:

(a) the Rules of Procedure of the European Patent Court on a proposal from the Executive Committee, or from a Contracting State after hearing the Executive Committee

(b) its own Rules of Procedure
Art. 34(1) EPC
Some delegations expressed general reservations concerning Art. 18, especially in view of the financial implications of the EPJ; however, delegations are prepared to lift these reservations as soon as there is more clarity in this respect.

(c) the Financial Regulations

(d) the Service Regulations setting out the conditions of employment of judges and other staff of the European Patent Judiciary

(e) the Rules relating to Fees and the amounts of fees to be charged in proceedings before the European Patent Court.

(3) The Administrative Committee shall, in accordance with the Statute, appoint, re-appoint or remove from office, the judges and the Registrar of the European Patent Court.

(4) The Administrative Committee shall also perform any other duties assigned to it by this Agreement or the Statute.

**Article 18 Voting**

(1) The right to vote in the Administrative Committee shall be restricted to the Contracting States. Each Contracting State shall have one vote.

(2) A unanimous vote by the Contracting States represented and voting shall be required for the decisions which the Administrative Committee is empowered to take under Article 17, paragraph 1(a), and Article 86, second sentence.
Art. 35 EPC
UK, DE, DK, PT study whether decisions under Art. 21(2), 22(1) and 91 should require unanimity.

Art. 37(a) and (c) EPC
Second sentence based on suggestions by CH, DE, DK, MC, NL, SE.

Art. 38(a) EPC

(3) A majority of three quarters of the votes of the Contracting States represented and voting shall be required for the decisions which the Administrative Committee is empowered to take under Article 17, paragraphs 1(b) and 2, Article 21, paragraph 2, Article 22, paragraph 1, Article 27, paragraph 2, Article 30, paragraph 4, and Article 91.

(4) Decisions other than those referred to in paragraphs 2 and 3 shall be taken by a simple majority of the Contracting States represented and voting.

(5) Abstentions shall not be considered as votes.

PART II FINANCIAL PROVISIONS

Article 19 Budgetary funding

The budget of the European Patent Judiciary shall be financed from its own resources and, where necessary, from contributions made by the Contracting States. Regional Divisions shall be financed as laid down in Article 21a.

Article 20 Own resources of the European Patent Judiciary

The European Patent Judiciary's own resources shall consist of all its income from court fees and other sources.
It is envisaged that the Contracting States should contribute to the budget of the European Patent Court in order to keep fees at a fair level. Court fees shall not be prohibitive and shall not constitute a serious obstacle for litigation before the Court, thus the provision should leave some flexibility as regards the principle of 100% self-financing of the European Patent Judiciary.

Art. 40(2) EPC

The distribution key now proposed is based on three elements, following suggestions by CH, DE, FI, MC, SE:

(a) number of European patents in force in a Contracting State (theoretical probability of patent litigation);

Article 21 Level of fees, financial contributions from Contracting States

(1) The court fees charged by the European Patent Court shall be fixed at such a level as to ensure a balance between the parties' right to fair access to the European Patent Court and the principle that the European Patent Judiciary's own resources should cover its costs.

(2) If the European Patent Judiciary is unable to balance its budget out of its own resources, the Contracting States shall remit to it financial contributions whose level shall be determined by the Administrative Committee in accordance with the distribution key laid down in paragraphs 3 and 4.

(3) Each Contracting State shall contribute as follows to the amount needed to balance the budget of the European Patent Judiciary:

(a) For x per cent of this amount, the Contracting State shall pay a proportion determined by the ratio of the number of European patents in force in that State to the number of European patents in force in all the Contracting States.
(b) European patents in force in a Contracting State and the subject of litigation before the European Patent Court (actual patent litigation);

(c) equal distribution of part of the costs.

x = 40, y = 20?

The distribution key should be stable for a specified period, but updated regularly.

First distribution key and initial contributions, see Article 91

Covering the cost of Regional Divisions centrally out of the European Patent Judiciary budget would mean that States with small Regional Divisions or none at all would also be indirectly financing other Contracting States’ Regional Divisions through their contributions under Article 21(2). On the other hand, if States setting up a Regional Division were

(b) For x per cent of this amount, the Contracting State shall pay a proportion determined by the ratio of the number of European patents in force in that State and the subject of litigation before the European Patent Court to the number of all European patents which are the subject of litigation before the European Patent Court.

(c) y per cent of this amount shall be borne by the Contracting States in equal parts.

(4) The ratios referred to in paragraph 3(a) and (b) shall be re-calculated every [five] years after the entry into force of this Agreement on the basis of the sum of the figures for the last three years preceding the year in which the re-calculation is to be made.

Article 21a Financing of Regional Divisions

(1) A Regional Division set up by a Contracting State or by a group of Contracting States shall be financed by that State or group of States. However, the salary of the judges in any Regional Division shall be covered by the budget of the European Patent Judiciary. The Administrative Committee shall fix the number of judges of a Regional Division which are to be so financed.
prepared to bear the cost but then claim a reduction in their financial contributions, the other Contracting States would also participate indirectly in the financing of Regional Divisions. It is therefore proposed that a Contracting State setting up a Regional Division staffed and equipped in accordance with its own needs bear all the costs except the judges' salaries. All judges at the European Patent Court should be treated equally, irrespective of the Contracting State in which they work. The Administrative Committee will have to adopt a salary scheme which should take account of the fact that, at least in the initial phase, there might be only a small number of judges working full time, some working part time, and some dealing only with single cases.

A Regional Division's support staff, in particular the registrars, must also be adequately qualified, for example in respect of
language skills, and should therefore be appropriately paid by the Contracting States setting up a Regional Division.

Art. 13(2)(b) Draft Statute provides that the Registrar shall receive the fees payable to the Court. To avoid any discrepancies vis-à-vis Art. 21a Draft Agreement, it is now made clear that the sub-registries collect the fees, which themselves are under the final authority of the Registrar.

As the Regional Division collects the court fees for the European Patent Court, an appropriate portion (z = 50?) of this European Patent Judiciary income should be used to finance the European Patent Judiciary's central institutions and in particular the judges' salaries.

Art. 39(2) EPC 2000

Art. 41(1) EPC

(2) The European Patent Judiciary shall receive a proportion of the court fees collected by the sub-registries of any Regional Division; the proportion, to be fixed by the Administrative Committee, shall not be less than z per cent. Each Contracting State shall communicate to the European Patent Judiciary such information as the Administrative Committee considers necessary to determine the amount of these payments.

Article 22 Advances

(1) Where appropriate, the Contracting States shall grant advances to the European Patent Judiciary on their contributions under Article 21, paragraph 2, the amount to be fixed by the Administrative Committee.
(2) Such advances shall be proportionate to the amounts due from the Contracting State for the accounting period in question.

Article 23  Budget

(1) The budget of the European Patent Judiciary shall be balanced. It shall be drawn up in accordance with the generally accepted accounting principles laid down in the Financial Regulations. If necessary, there may be amending or supplementary budgets.

(2) The budget shall be drawn up in the unit of account fixed in the Financial Regulations.

Article 24  Authorisation for expenditure

(1) The expenditure entered in the budget shall be authorised for the duration of one accounting period unless the Financial Regulations provide otherwise.

(2) In accordance with the Financial Regulations, any appropriations, other than those relating to staff costs, which are unexpended at the end of the accounting period may be carried forward, but not beyond the end of the following accounting period.

(3) Appropriations shall be set out under different headings according to type and purpose of the expenditure, and subdivided, as far as necessary, in accordance with the Financial Regulations.
Article 25 Appropriations for unforeseeable expenditure

Art. 44 EPC

(1) The budget of the European Patent Judiciary may contain appropriations for unforeseeable expenditure.

(2) The employment of these appropriations by the European Patent Judiciary shall be subject to the prior approval of the Administrative Committee.

Article 26 Accounting period

Art. 45 EPC

The accounting period shall commence on 1 January and end on 31 December.

Article 27 Preparation and adoption of the budget

Art. 46 EPC

(1) The Executive Committee shall submit the draft budget of the European Patent Judiciary to the Administrative Committee no later than the date prescribed in the Financial Regulations.

(2) The budget and any amending or supplementary budget shall be adopted by the Administrative Committee.

Article 28 Provisional budget

Art. 47 EPC

(1) If, at the beginning of the accounting period, the budget has not been adopted by the Administrative Committee, expenditures may be effected on a monthly basis per heading or other division of the budget, in accordance with the Financial Regulations, up to one-twelfth of the budget appropriations for the preceding accounting period, provided that the appropriations thus made available to the Executive Committee do not exceed one-twelfth of those provided for in the draft budget.
(2) The Administrative Committee may, subject to the observance of the other provisions laid down in paragraph 1, authorise expenditure in excess of one-twelfth of the appropriations.

(3) The Contracting States shall pay each month, on a provisional basis and in accordance with the amounts referred to in Article 21, any financial contributions needed to ensure the implementation of paragraphs 1 and 2.

Article 29    Budget implementation

(1) The Executive Committee shall implement the budget and any amending or supplementary budget on its own responsibility and within the limits of the allocated appropriations.

(2) Within the budget, the Executive Committee may, in accordance with the Financial Regulations, transfer funds between the various headings or subheadings.

Article 30    Auditing of accounts

(1) The annual financial statements of the European Patent Judiciary shall be examined by independent auditors. The auditors shall be appointed and if necessary dismissed by the Administrative Committee.

(2) The audit, which shall be based on professional auditing standards and shall take place, if necessary, in situ, shall ascertain that the budget has been implemented in a lawful and proper manner and that the financial administration of the European Patent Judiciary has been conducted in accordance with the principles of economy and sound financial management. The auditors shall draw up a report after the end of each accounting period containing a signed audit opinion.
(3) The Executive Committee shall submit to the Administrative Committee the annual financial statements of the European Patent Judiciary and the annual budget implementation statement for the preceding accounting period, together with the auditors' report.

(4) The Administrative Committee shall approve the annual accounts together with the auditors' report and shall discharge the Executive Committee in respect of the implementation of the budget.

Article 31 Financial Regulations

The Financial Regulations shall lay down in particular:

(a) arrangements relating to the establishment and implementation of the budget and for the rendering and auditing of accounts

(b) the method and procedure whereby the payments and contributions provided for in Article 21, paragraph 2, and the advances provided for in Article 22 are to be made available to the European Patent Judiciary by the Contracting States

(c) the rules concerning the responsibilities of authorising and accounting officers and the arrangements for their supervision

(d) the composition of and the duties to be assigned to a Budget and Finance Committee if the Administrative Committee sets one up

(e) the generally accepted accounting principles on which the budget and the annual financial statements are to be based.
Article 32

Substantive patent law to be applied by the European Patent Court

For the purposes of litigation under this Agreement, European patents shall be subject to:

(a) the provisions of this chapter,

(b) those provisions of the European Patent Convention which apply to every European patent and which are consequently deemed to be provisions of this Agreement, and

(c) those provisions of national law which have been enacted by the Contracting States to implement Article 65, Article 67, paragraphs 2 and 3, and Article 70, paragraphs 3 and 4, of the European Patent Convention.

Article 33 Infringing acts

A European patent shall confer on its proprietor the right to prevent any third party not having his consent:

(a) from making, offering, putting on the market or using a product which is the subject-matter of the patent, or importing or stocking the product for these purposes.
(b) from using a process which is the subject-matter of the patent or, when the third party knows, or it is obvious in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent, from offering the process for use.

(c) from offering, putting on the market, using, importing or stocking for these purposes a product obtained directly by a process which is the subject-matter of the patent.

**Article 34 Indirect infringement**

(1) A European patent shall also confer on its proprietor the right to prevent any third party not having his consent from supplying or offering to supply any person, other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or it is obvious in the circumstances, that these means are suitable and intended for putting that invention into effect.

(2) Paragraph 1 shall not apply when the means are staple commercial products, except where the third party induces the person supplied to commit acts prohibited by Article 33.

(3) Persons performing the acts referred to in Article 35(a) to (c) shall not be considered to be parties entitled to exploit the invention within the meaning of paragraph 1.
Article 35 Limitations to the effects of the European patent

The rights conferred by a European patent shall not extend to:

(a) acts done privately and for non-commercial purposes

(b) acts done for experimental purposes relating to the subject-matter of the patented invention

(c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription or acts concerning the medicine so prepared

(d) the use on board vessels of the countries of the Union of Paris for the Protection of Industrial Property, other than the Contracting States, of the patented invention, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of the Contracting States, provided that the invention is used there exclusively for the needs of the vessel

(e) the use of the patented invention in the construction or operation of aircraft or land vehicles of the countries of the Union of Paris for the Protection of Industrial Property, other than the Contracting States, or of accessories of such aircraft or land vehicles, when these temporarily or accidentally enter the territory of the Contracting States
(f) the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944, where these acts concern the aircraft of a State, other than a Contracting State, benefiting from that Article.

Article 36  Reversal of burden of proof

(1) If the subject-matter of a European patent is a process for obtaining a new product, the same product when produced by any other person shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process.

(2) The same shall apply if there is a substantial likelihood that an identical product was made by a patented process for obtaining a product and the proprietor of the patent has been unable despite reasonable efforts to determine the process actually used.

(3) In the adduction of proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and business secrets shall be taken into account.

Article 37  Prior use

Any person who, if a national patent had been granted in respect of an invention, would have had, in a Contracting State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that State, the same rights in respect of a European patent for the same invention.
To the best of delegations' knowledge the provisions of Arts. 38 - 40 as proposed in this draft are compatible with Community Law (Reg. 44/2001) as well as with the Brussels and Lugano Conventions. The sub-group is aware, though, that this question is still under scrutiny by the legal services of the Commission and of several member states.

CHAPTER II JURISDICTION OF THE EUROPEAN PATENT COURT AND EFFECT OF DECISIONS

Article 38 Application of the Brussels and Lugano Conventions

(1) Those Contracting States which are also party to the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, signed in Brussels on 27 September 1968, as amended by the Conventions on the Accession to that Convention of the States acceding to the European Communities, and to the Convention on jurisdiction and the enforcement of judgments in civil and commercial matters, signed in Lugano on 16 September 1988, hereinafter referred to respectively as "the Brussels Convention" and "the Lugano Convention", hereby designate the European Patent Court as their national court within the meaning of those conventions.

(2) For the purposes of applying the Brussels and Lugano Conventions to proceedings governed by this Agreement, the provisions of Title II of those Conventions, applicable to persons domiciled in a Contracting State, shall also apply to persons who do not have a domicile in any Contracting State but have an establishment therein.

(3) In the case of conflict between the provisions of the Brussels or Lugano Conventions and the provisions of this Agreement, the former shall prevail.
Article 39  Application of Regulation 44/2001

(1) Those Contracting States which are also Member States of the European Community and bound by Council Regulation (EC) No 44/2001 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, hereinafter referred to as "Regulation 44/2001", hereby designate the European Patent Court as their national court within the meaning of that Regulation.

(2) Article 38, paragraphs 2 and 3, shall apply mutatis mutandis.

Article 40  Preliminary rulings of the Court of Justice of the European Communities

(1) Those Contracting States which are also Member States of the European Community hereby designate the European Patent Court as their national court for the purposes of Article 234 of the Treaty establishing the European Community.

(2) The preliminary rulings of the Court of Justice of the European Communities shall be binding on the European Patent Court in so far as the latter's decisions take effect in one or more of the Contracting States which are also Member States of the European Community.

Article 41  Jurisdiction in respect of infringement and validity

(1) The Court of First Instance shall have civil jurisdiction in respect of

(a) any action for actual or threatened infringement or for a declaration of non-infringement of a European patent effective in one or more of the Contracting States.
Art. 35 CPC 1989; Art. 34 TRIPs

(b) any action or counterclaim for revocation of a European patent effective in one or more of the Contracting States, and

c) any action for damages or compensation in respect of the protection conferred by a published European patent application in accordance with Article 67 of the European Patent Convention, and

d) any other action concerning a European patent if and to the extent the parties have so agreed.

(2) Any action under paragraph 1 shall be brought before the Central or competent Regional Division in accordance with the Rules of Procedure, which shall take account of the provisions of the Brussels and Lugano Conventions and of Regulation 44/2001. However, any direct action for revocation shall be brought before the Central Division.

(3) The jurisdiction of the Court of First Instance under paragraph 1 shall be exclusive as regards any action for revocation of a European patent with effect for one or more of the Contracting States and for any actions against a defendant domiciled in one of the Contracting States.

(4) The Court of First Instance shall treat the European patent as valid unless its validity is contested by the defendant.

(5) The Court of First Instance shall inform the national patent office of any Contracting State concerned, and the European Patent Office, of the date on which an action or counterclaim for revocation of a European patent was filed.
Article 42 Decisions on validity

(1) Where the validity of a European patent has been contested, the European Patent Court shall

(a) revoke the patent if at least one ground for revocation under Article 138, paragraph 1, of the European Patent Convention prejudices its maintenance; otherwise it shall dismiss the action or counterclaim for revocation

(b) limit the patent by a corresponding amendment of the claims and revoke the patent in part if the grounds for revocation under Article 138, paragraph 1, of the European Patent Convention affect the patent only in part.

(2) Where the European Patent Court, in a final decision, has revoked a European patent for one or more of the Contracting States, it shall send a copy of the decision to the national patent office of any Contracting State concerned and to the European Patent Office.

(3) Where the European Patent Court, in a final decision, has maintained a European patent as amended, paragraph 2 above and Article 65 of the European Patent Convention shall apply mutatis mutandis.
CH, DK, FI and UK would prefer a solution under which decisions revoking a European patent or maintaining it as amended shall take effect in all Contracting States unless the proprietor of the patent satisfies the European Patent Court that the grounds for revocation are not applicable in one or more of those States, in which case the decision shall take effect only in the States where these grounds are applicable.

See Art. 33(1) CPC 1989 and Art. 68 EPC

"Contested" in this context means a defence of invalidity raised by the defendant (assumed infringer) and not a counterclaim for revocation.

See Art. 33(2) CPC 1989

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**Article 43**

**Effect of decisions**

(1) Decisions of the European Patent Court shall be regarded, in any Contracting State, as decisions of a national court of that State.

(2) If revocation of the European patent is not requested for all the Contracting States where it is effective, the proprietor of the patent may request that the effect of the decision be extended to all these States.

(3) The European patent shall be deemed not to have had, from the outset, the effects specified in Articles 33 and 34 to the extent that the patent has been revoked.

(4) If the validity of a European patent has been contested in proceedings initiated by the holder of an exclusive licence under this patent in which the proprietor of the patent did not take part, the decision of the European Patent Court shall only take effect between the parties to those proceedings.

(5) Subject to the national law relating either to claims for damages caused by negligence or lack of good faith on the part of the proprietor of the patent, or to unjust enrichment, the retroactive effect of the revocation of a European patent under paragraph 3 shall not affect any final decision on infringement enforced prior to the revocation of the patent.
Article 44  Jurisdiction of the Court of Appeal

The Court of Appeal shall have exclusive jurisdiction to decide on appeals against decisions of the Court of First Instance and on petitions for review.

CHAPTER III  JURISDICTION OF NATIONAL COURTS

Article 45  Provisional and protective measures

(1) Without prejudice to the jurisdiction of the European Patent Court, the national courts of any Contracting State shall retain jurisdiction to order such provisional or protective measures as are provided for by their national law.

(2) The party who has filed a request for such an order with a national court shall notify the Registry of this fact within 31 calendar days of filing the request if proceedings on the merits are pending before the European Patent Court. If the Registry is not notified in due time, the order by the national court shall cease to have effect from the day after this time limit expires, without prejudice to the right of the party against whom the order was directed to claim damages arising out of that order or its execution.

(3) If no proceedings on the merits are pending before the European Patent Court and if such proceedings are not brought before that Court within 31 calendar days of the date of the order by the national court, or such other period as the national court specifies, the order by the national court shall cease to have effect from the day after this time limit expires, without prejudice to the right of the party against whom the order was directed to claim damages arising out of that order or its execution.
Article 46  Provisional seizure

(1) Without prejudice to the jurisdiction of the European Patent Court, the national courts of any Contracting State shall retain jurisdiction in respect of the provisional seizure of goods as security for any damages, compensation, costs or any other payment resulting from proceedings before the European Patent Court.

(2) Article 45, paragraphs 2 and 3, shall apply mutatis mutandis.
PART IV PROCEDURE BEFORE THE EUROPEAN PATENT COURT

CHAPTER I GENERAL PROVISIONS

Article 48 Case management
The European Patent Court shall actively manage the cases before it in accordance with the Rules of Procedure.

Article 49 Public proceedings
Proceedings before the European Patent Court shall be public unless and in so far as the Court decides otherwise for reasons of public order or any other compelling reason, particularly in order to protect the trade secrets of one of the parties or any other interested person.

Article 50 Right to be heard
Decisions on the merits of the European Patent Court may only be based on grounds or evidence on which the parties have had an opportunity to present their comments.

Article 51 Parties
(1) The right of a natural or legal person, or any body equivalent to a legal person, to be party to the proceedings shall be determined by the applicable national law.

See Art. 116(4) EPC
Art. 7.5 Directive 2004/48/EC reads: "Member States may take measures to protect witnesses' identity". It is proposed that this option be taken up in the draft Agreement. See also suggestions by SK (WPL/SUB 7/05).

See Art. 113(1) EPC and Art. 41(3) TRIPs
Art. 4 Directive 2004/48/EC reads:
"Member States shall recognise as persons entitled to seek application of the measures, procedures and remedies referred to in this chapter:
(a) the holders of intellectual property rights, in accordance with the provisions of the applicable law;
(b) all other persons authorised to use those rights, in particular licensees, in so far as permitted by and in accordance with the provisions of the applicable law;"

It is proposed to align Art. 51 draft Agreement on Art. 4(b) Directive 2004/48/EC by expressly stating that the right of holders of other licences to initiate litigation before the European Patent Court is dealt with by national law. See also suggestions by SK (WPL/SUB 7/05).

(2) The holder of an exclusive licence under a European patent may initiate litigation before the European Patent Court in the same way as the proprietor of the patent unless the licensing agreement provides otherwise. The holders of other licences may initiate litigation before the Court in so far as permitted by the applicable national law.

(3) The Rules of Procedure shall govern
(a) the participation in the proceedings of a plurality of parties and of third parties
(b) changes in the legal identity of parties
(c) the removal of parties from the proceedings, or their inclusion in them, and
(d) cases in which parties go bankrupt or cease to exist.
Article 51a Oral proceedings

Oral proceedings shall take place either at the instance of the European Patent Court if it considers this to be expedient or at the request of any party to the proceedings, in accordance with the Rules of Procedure.

Article 52 Basis for decisions

(1) The European Patent Court shall decide in accordance with the requests submitted by the parties. The Court shall not award more than is requested.

(2) Apart from well-known facts, decisions on the merits may only be based on the grounds, facts and evidence put forward by the parties to the proceedings.

(3) The European Patent Court shall evaluate evidence freely and independently.

Article 53 Evidence

(1) In proceedings before the European Patent Court, the means of giving or obtaining evidence shall include the following:

(a) hearing the parties
(b) requests for information
(c) production of documents
(d) hearing witnesses
(e) opinions by experts
See Art. 43 TRIPS

Art. 6.1 Directive 2004/48/EC reads: "Member States shall ensure that, on application by a party which 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 opposing party, the competent judicial authorities may order that such evidence be presented by the opposing party, subject to the protection of confidential information."

(f) inspection

(g) comparative tests or experiments

(h) sworn statements in writing (affidavits).

(2) The Rules of Procedure shall govern the procedure for taking such evidence.

(3) The onus of proof of any facts shall be on the party relying on such facts, unless the European Patent Court decides otherwise.

(4) The European Patent Court shall be regarded as a competent national court within the meaning of Article 25 of the European Patent Convention.

Article 54 Production of evidence by other or third parties

(1) Where a party has sufficiently substantiated a claim and specified evidence relevant to such claim which lies in the control of another party, the European Patent Court may order the other party to produce such evidence.
The terms "evidence which lies in the control of the opposing party" seem to allow a broader variety of evidence to be presented than "evidence in the possession of another party". It is therefore proposed to bring Art. 54 draft Agreement into line with Directive 2004/48/EC.

Art. 6 Directive 2004/48/EC requires that confidential information be protected during all proceedings where evidence is collected and secured. In the draft Agreement, the protection of confidential information is only dealt with in the Chapter "Provisional and protective measures" (Art. 75). It is proposed that Art. 75 draft Agreement be included amongst the general provisions governing the procedure before the European Patent Court (new Art. 54a).

To be in line with the terminology used in the Draft Agreement, the term "person" has been replaced by the term "party".

(2) Where a party has sufficiently substantiated a claim and specified evidence relevant to such claim which is likely to be in the possession or in the control of a third party due to its relationship to another party, the European Patent Court may order that third party to produce such evidence. The Court shall take due account of the interests of that third party and shall, before making such order, give that party an opportunity to present its interests unless this is incompatible with an effective enforcement of such order.

**Article 54a - Protection of confidential information**

To safeguard a party's or a third party's trade secrets or other confidential information, or to prevent an abuse of evidence, the European Patent Court may order that the use of evidence in proceedings before it be restricted or prohibited or that access to such evidence be restricted to certain persons.
Article 55  Witnesses

(1) In accordance with the Rules of Procedure, the European Patent Court may order that a fine be paid by a witness who,

(a) duly summoned and in the absence of force majeure or any other good cause refuses to appear or does not appear before the Court, or

(b) refuses to answer questions asked by the Court without having a right to do so.

(2) An absent witness shall be given the opportunity to be heard before such order is made.

(3) The fine may not exceed the amount determined in the Rules of Procedure.

Article 56  Statements by parties, witnesses and experts

Any statement made by a party, witness or expert in proceedings before the European Patent Court shall be treated in any Contracting State as if it had been made before a competent national court or authority.

Article 57  Court fees

(1) Parties to proceedings before the European Patent Court shall pay court fees in accordance with the provisions laid down by the Administrative Committee.

(2) Court fees shall be paid in advance. Any party which has not paid a prescribed court fee may be excluded from further participation in the proceedings.
Article 58 Costs

(1) In accordance with the Rules of Procedure, the unsuccessful party shall bear the cost of litigation before the European Patent Court incurred by the other party and the Court.

(2) Where a party succeeds only in part, or where the circumstances are exceptional, the European Patent Court may order that costs be apportioned equitably or that the parties bear their own costs.

(3) Notwithstanding paragraph 2, the European Patent Court may order a party to bear any costs it has unnecessarily caused the Court or another party.

Article 59 Rules of Procedure

The Rules of Procedure shall lay down the details of proceedings before the European Patent Court.

CHAPTER II POWERS OF THE EUROPEAN PATENT COURT

Article 60 General

The European Patent Court may impose such measures, securities, sanctions and fines as are laid down in this Agreement and may make its orders subject to other conditions, in accordance with the Rules of Procedure.

Article 61 Astreinte

(1) The European Patent Court may order any non-compliance with an order of the Court to be sanctioned by an astreinte, payable to the party mentioned in the order, without prejudice to that party's right to claim damages.
(2) An astreinte shall not be payable

(a) before the order is served on the party concerned in accordance with the law governing service

(b) while the party concerned is bankrupt or after it ceases to exist

(3) If the party concerned is permanently or temporarily, totally or partially, unable to comply with the order of the European Patent Court, the Court may, at the party's request and in accordance with the Rules of Procedure, direct that the astreinte

(a) be cancelled,

(b) be temporarily suspended, or

(c) be reduced.

(4) Any cancellation, suspension or reduction shall not apply as long as the party concerned is able to comply with the order.

(5) An astreinte shall not be deducted from any damages awarded.

Article 62 Injunction

The European Patent Court may order a party infringing or threatening to infringe a European patent to cease and desist from any act infringing the patent under Articles 33 or 34.
Article 63 Forfeiture

(1) The European Patent Court may order that goods found to be infringing be destroyed or otherwise disposed of, without compensation of any sort, outside the commercial channels and in such a manner as to prevent any harm to the injured party.

(2) The European Patent Court may also order that materials and devices used mainly to manufacture infringing goods or carry out an infringing process be destroyed or otherwise disposed of, without compensation of any sort, outside the commercial channels and in such a manner as to prevent any harm to the injured party.

(3) Due account shall be taken of the need for proportionality between the seriousness of the infringing act and the remedies ordered, the willingness of the party concerned to convert the materials into a non-infringing state, and the interests of third parties.

Article 64 Damages

(1) The European Patent Court may order the party who knowingly, or with reasonable grounds to know, infringes the European patent, to pay the injured party damages adequate to compensate for the injury suffered.

(2) The European Patent Court shall have the same power in respect of a party who caused or tolerated such infringement, on the basis of his relationship with the party infringing the European patent, while it was in his power to stop it.
(3) Regarding the assessment and awarding of damages, the injured party shall, as far as possible, be restored to the position he would have been in if no infringement had taken place, and the party infringing the European patent shall not benefit from the infringement.

(4) Damages shall not be punitive.

Article 65 Kinds of damages

(1) Damages shall compensate for any loss suffered by the injured party because of any infringing act. They shall include, without necessarily being confined to,

(a) the profits the injured party would have made if no such act had taken place, or

(b) any profits actually made or likely to have been made by the party infringing the European patent.

(2) The European Patent Court may order the party infringing the European patent to lay open his books to the injured party or to such expert as the Court may designate.

(3) If it is impossible or disproportionately difficult or costly to establish the real extent of any damages under paragraph 1, the European Patent Court may freely determine the amount of damages to be awarded, which shall in any event exceed the amount of the customary licence fee.

(4) In awarding damages, the European Patent Court may also order the party infringing the European patent to perform, or refrain from, certain acts.
Article 66  Indemnification of a party

The European Patent Court may order a party, at whose request measures ordered by the Court were enforced, to provide the other party wrongfully enjoined or restrained with adequate compensation for the injury suffered as a result of such enforcement, and to pay his expenses. Article 65 shall apply *mutatis mutandis*.

Article 67  Limitation of right to claim damages

1. The right to claim damages shall expire five years from the date on which the injured person became, or had reasonable grounds to become, aware of the infringing act.

2. Notwithstanding paragraph 1, the right to claim damages shall expire five years after proceedings for damages were terminated without a decision or a settlement.

3. The parties may agree in writing to another period of limitation.

Article 68  Right of information

The European Patent Court may order a party infringing the European patent to inform the injured party of the identity of any third person involved in the production or distribution of infringing goods or in the use of an infringing process, and of their channels of distribution.
This provision ensures that the Court has the power to decide that the decision replaces a necessary declaration a party was ordered to make, or an act a party was ordered to perform, e.g. handing out certain infringing goods.

Art. 50 TRIPs
See also WPL/8/02 as regards review of national decisions by the European Patent Court.

Article 69  Power to replace an act of a party by a decision of the European Patent Court

The European Patent Court may order that its decision is substituted for any declaration or other act by a party in order to comply with certain legal requirements.

CHAPTER III  PROVISIONAL AND PROTECTIVE MEASURES

Article 70  General

(1) The European Patent Court may order such provisional and protective measures as are laid down in this Agreement and may make its orders subject to other conditions, in particular securities, in accordance with the Rules of Procedure.

(2) The European Patent Court shall take due account of the likely outcome of the proceedings as to the merits and the proportionality of the measure requested.

(3) Any such measure may be ordered even inaudita altera parte in case of exceptional urgency or if the measure could not otherwise be implemented effectively.
Art. 7.1 Directive 2004/48/EC reads:
"Where measures to preserve evidence are adopted without the other party having been heard, the parties affected shall be given notice, without delay after the execution of the measures at the latest. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures shall be modified, revoked or confirmed."
It is proposed to include a similar provision in the draft Agreement.

Art. 7.3 Directive 2004/48/EC reads:
"Member States shall ensure that the measures to preserve evidence are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if the applicant does
not institute, within a reasonable period, proceedings leading to a decision on the merits of the case before the competent judicial authority, the period to be determined by the judicial authority ordering the measures where the law of a Member State so permits or, in the absence of such determination, within a period not exceeding 20 working days or 31 calendar days, whichever is the longer."

It is proposed to align Art. 70(5) draft Agreement on Art. 7.3 Directive 2004/48/EC and on Art. 50(6) TRIPs Agreement.

(6) Article 66 shall apply mutatis mutandis.

Article 71 Preliminary injunctions

Where there is an immediate need to protect and safeguard a party's interests, the European Patent Court may, in accordance with the Rules of Procedure, issue a preliminary injunction under Article 62.
This measure concerns what is known as "saisie contrefaçon".

Article 72 Orders for inspection of property

(1) The European Patent Court may order the inspection of premises and the preservation of evidence that is or may be relevant in pending or future proceedings before it.

(2) The order may instruct any person to permit someone specified in the order, or to ensure that someone so described, hereinafter referred to as "the executing person", is permitted, to enter commercial premises in any Contracting State.

(3) In accordance with the terms of the order, the executing person may in respect of any goods, materials or devices described in the order:

(a) inspect the premises

(b) search for such articles

(c) make or obtain a copy, photograph, sample or other record of such articles, and

(d) request any information or article and retain for safe keeping anything described in the order.

Article 73 Freezing orders

The European Patent Court may order a party to refrain

(a) from removing from its jurisdiction any assets located there, or

(b) from dealing in any assets, whether located within its jurisdiction or not.
See Art. 46 TRIPs

Article 74 Sequestration

(1) The European Patent Court may order the sequestration of allegedly infringing goods or of materials or devices used mainly to manufacture allegedly infringing goods or carry out an allegedly infringing process, to prevent them from entering commercial channels.

(2) The order may instruct any person to permit someone specified in the order, or to ensure that someone so described, hereinafter referred to as "the executing person", is permitted, to enter commercial premises in any Contracting State.

(3) In accordance with the terms of the order, the executing person may in respect of any goods, materials or devices described in the order:

   (a) inspect the premises
   (b) search for and remove such articles.

(4) The executing person shall convey and hand over the articles thus removed to the person mentioned in the order, who shall act as sequestrator.

(5) Sequestration may be ordered for the duration of the proceedings as to the merits.

See the proposal for a new Art. 54a Draft Agreement.

Article 75 Other protective orders

deleted.
PART V PROCEDURAL REMEDIES

CHAPTER I APPEAL

Article 76 Appeal

(1) In accordance with this Agreement and the Rules of Procedure, an appeal shall lie to the Court of Appeal from decisions of the Court of First Instance.

(2) An immediate appeal shall lie from

(a) any decision terminating proceedings as regards one of the parties

(b) any decision in which the Court of First Instance has assumed jurisdiction which was unsuccessfully contested

(c) any decision in which a Regional Division has assumed its competence which was unsuccessfully contested, and

(d) any decision ordering provisional or protective measures.

(3) Any other decision shall only be appealable together with the decision terminating proceedings, unless the decision appealed against or the Court of Appeal grants leave to appeal.

(4) Any decision not appealed against earlier shall be appealable together with the decision terminating proceedings.
See Art. 107 EPC

See Art. 108 EPC

Article 77  Persons entitled to appeal

Any party to proceedings adversely affected by a decision may appeal.

Article 78  Time limit and form

(1) Notice of appeal setting out the grounds shall be filed within three months of notification of the decision.

(2) Notwithstanding paragraph 1, notice of appeal may still be filed by way of cross-appeal after an appeal has been filed by another party.

(3) Notice of appeal or cross-appeal shall be filed in accordance with the Rules of Procedure.

Article 79  Grounds for appeal

An appeal may only be based on the grounds

(a) that the facts alleged by the parties were not correctly established, or

(b) that, given the established facts, the law was not correctly applied.

Article 80  New facts or evidence

In exceptional cases, new facts or evidence may be taken into consideration by the Court of Appeal in accordance with the Rules of Procedure.

Such an exceptional case may occur e.g. when facts or evidence are not available at the beginning of the proceedings or when it cannot reasonably be required from the party concerned to provide them.
**Article 81**

**Effect**

(1) An appeal shall have suspensive effect unless the Court of First Instance or the Court of Appeal decides otherwise.

(2) Where a decision not terminating the proceedings is appealed against, the proceedings shall be stayed until the Court of Appeal has taken a decision unless the Court of First Instance or the Court of Appeal decides otherwise.

**CHAPTER II REVIEW OF DECISIONS**

**Article 82**

**Petition for review**

(1) Any party to proceedings before the European Patent Court which is adversely affected by a decision against which an appeal is not or no longer possible may file a petition for review of that decision by the Court of Appeal.

(2) The petition for review may only be filed on the grounds that

(a) a criminal act may have had an impact on the decision, or,

(b) if it concerns a decision of the Court of Appeal, a fundamental procedural defect has occurred in the proceedings.

(3) A petition for review may only be based on paragraph 2(a) if a competent court or authority has finally established that a criminal act occurred; a conviction is not necessary.

(4) The petition for review shall be filed in accordance with the Rules of Procedure.
<table>
<thead>
<tr>
<th>Article 83 Procedure and decision on review</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1) The Court of Appeal shall examine the petition for review in accordance with the Rules of Procedure.</td>
</tr>
<tr>
<td>(2) If the petition for review is admissible and allowable, the Court of Appeal shall set aside the decision under review in whole or in part and shall re-open the proceedings for a new trial and decision.</td>
</tr>
<tr>
<td>(3) If the decision set aside was taken by the Court of First Instance, the Court of Appeal shall remit the case to that Court unless the parties and the Court of Appeal agree that the case should be decided by the Court of Appeal.</td>
</tr>
<tr>
<td>(4) Any person who, in a Contracting State, has in good faith used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the period between the decision under review and the publication of the decision of the Court of Appeal on the petition, may without payment continue such use in the course of his business or for the needs thereof.</td>
</tr>
</tbody>
</table>

See Art. 112a(4) EPC

(5) If based on paragraph 2(b), the petition shall be filed within two months of notification of the decision. If based on paragraph 2(a), the petition shall be filed within two months of the date of the decision establishing the criminal act and in any event no later than five years from notification of the decision of the European Patent Court.

See Art. 112a(5) EPC

(1) The Court of Appeal shall examine the petition for review in accordance with the Rules of Procedure.

(2) If the petition for review is admissible and allowable, the Court of Appeal shall set aside the decision under review in whole or in part and shall re-open the proceedings for a new trial and decision.

(3) If the decision set aside was taken by the Court of First Instance, the Court of Appeal shall remit the case to that Court unless the parties and the Court of Appeal agree that the case should be decided by the Court of Appeal.

See Art. 112a(6) EPC

(4) Any person who, in a Contracting State, has in good faith used or made effective and serious preparations for using an invention which is the subject of a published European patent application or a European patent in the period between the decision under review and the publication of the decision of the Court of Appeal on the petition, may without payment continue such use in the course of his business or for the needs thereof.
NL reservation: compatibility of judicial and advisory function of Court of Appeal

Possibility of requesting opinions restricted to courts or quasi-judicial authorities of EPLA Contracting States.

Art. 149a(1)(b) EPC 2000; no competence to deliver opinions on issues of Community law

The principles enshrined in a number of provisions designed for the judicial function of the European Patent Court must also apply to the delivery of opinions by the FAC, namely provisions on judicial independence, substantive patent law

**PART Va FACULTATIVE ADVISORY COUNCIL**

**Article 83a** Court of Appeal functioning as Facultative Advisory Council

The functions of the Facultative Advisory Council referred to in Article 4 shall be performed by the Court of Appeal.

**Article 83b** Opinions delivered by the Facultative Advisory Council

At the request of a national court or quasi-judicial authority of a Contracting State trying an infringement or revocation action, the Facultative Advisory Council shall deliver an opinion on any point of law referred to it concerning the provisions mentioned in Article 32 or national patent law harmonised with them. The opinion shall not be binding on the referring court or quasi-judicial authority.

**Article 83c** Procedure regarding the delivery of opinions

(1) The following provisions shall apply mutatis mutandis to the procedure before the Facultative Advisory Council:

- Articles 5, 32 to 37 and
provisions on impartiality, composition of the Court of Appeal panel and selection of competent judges according to predetermined criteria ("gesetzlicher Richter"), representation before the FAC, possible membership of both the Court of First Instance and the Court of Appeal

See Art. 14(1) EPC

The right to be heard should primarily be observed in the proceedings before the national court referring the point of law. However, as in the case of preliminary rulings of the European Court Justice, parties could be given a single opportunity to present comments in writing; it would not seem appropriate, though, to hold oral proceedings (which are possible before the ECJ) before the FAC.

Articles 10, 27, 34 to 38 and 40 of the Statute.

(2) The official languages of the Facultative Advisory Council shall be English, French and German.

(3) The language of proceedings shall be that official language of the Facultative Advisory Council in which the request under Article 83b is submitted to it. A Contracting State may prescribe the official language or languages of the Facultative Advisory Council in which its courts or quasi-judicial authorities may submit a request under Article 83b.

(4) The parties to a case which gives rise to a referral under Article 83b may present in writing their arguments and submissions relating to the point of law in question within a period to be specified by the Facultative Advisory Council and in accordance with the Rules of Procedure of the Facultative Advisory Council.
Inserted at the suggestion of the French delegation.

Under Art. 18(3) a three-quarters majority is necessary.

Contracting States participating only under Part Va (FAC) will be bound by the special provisions concerning the FAC and by most institutional, financial, transitional and final provisions except those which relate specifically to judicial aspects of the European Patent Judiciary. Part Va contains provisions which take precedence over the general provisions, in particular with regard to financing the FAC and voting rights.

(5) The reasoned opinion shall be given in writing, in the language of the proceedings, by a majority of the panel of the Facultative Advisory Council.

(6) Proceedings under this Part shall be governed by the Rules of Procedure of the Facultative Advisory Council, to be adopted by the Administrative Committee. Article 18, paragraph 3 shall apply.

**Article 83d Reservations**

(1) Any Contracting State may, at the time of signature or when depositing its instrument of ratification or accession, declare that it is bound by this Agreement only as far as it relates to the Facultative Advisory Council.

(2) Contracting States which have made a declaration under paragraph 1 shall be bound by this Part of the Agreement and, subject to the provisions of this Part, which take precedence, by Articles 1, 3, 4, 6, Article 7, paragraph 1, Articles 8, 9, 11, Article 12, paragraph 1, Articles 13 to 21, Articles 22 to 31, Article 84, and Articles 87 to 99.

(3) Any declaration made under paragraph 1 may be withdrawn at any time by notification to the Government of ***. The withdrawal shall take effect on the first day of the third month after the date of receipt of such a notification.
UK, NL: until further clarity is reached, general reservations as to the provisions governing financial matters.

Financing by the EPO may raise problems as not all EPO member states will be party to the EPLA.

Consideration should be given to the possibility of covering at least some of the FAC's costs by fees to be charged to the parties.

If the income under (a) and (b) did not cover the costs of the FAC's work, the Contracting States would have to pay the difference.

**Article 83e Financing**

(1) The expenses incurred by the European Patent Judiciary with regard to the Facultative Advisory Council shall be covered by:

(a) contributions of the European Patent Organisation if its Administrative Council so decides under Article 149a, paragraph 2(b), in conjunction with Article 35, paragraph 2, of the European Patent Convention;

(b) fees for delivering an opinion if such a fee is provided for in the Rules of Procedure of the Facultative Advisory Council; or

(c) contributions of the Contracting States the amount of which shall be determined by the Administrative Committee; Article 21, paragraphs 3 and 4, shall apply with the proviso that the relevant ratio under Article 21, paragraph 3(b), shall be the ratio of the number of opinions requested by courts or quasi-judicial authorities of the Contracting State to the number of all opinions requested from the Facultative Advisory Council.

(2) Income and expenditure of the European Patent Judiciary relating to the Facultative Advisory Council shall form the subject of estimates in respect of each accounting period and shall be shown in a separate part of the budget of the European Patent Judiciary. This part of the budget shall be balanced in its own right.

(3) Contracting States having made a declaration under Article 83d, paragraph 1, may limit their contributions to the budget of the European Patent Judiciary to the contributions under paragraph 1(c).
**UK, FR:** Voting rights should be attractive enough to encourage participation at least under Part Va (FAC) of the EPLA.

**CH, MC:** Reservations against the extent of voting rights, in particular paragraph (1)(a) and (e).

Decisions on

- (re-)appointment and removal from office of judges of Court of Appeal and the Registrar
- adoption of the Rules of Procedure of the FAC
- financial contributions made in respect of the FAC by Contracting States
- financial matters, in particular the budget of the European Patent Judiciary, and Financial Regulations
- adoption of Service Regulations
- chairperson of and observers to the Administrative Committee

<table>
<thead>
<tr>
<th>Article 83f</th>
<th>Voting rights in the Administrative Committee of Contracting States which have entered a reservation</th>
</tr>
</thead>
<tbody>
<tr>
<td>(1)</td>
<td>Any Contracting State having made a declaration under Article 83d, paragraph 1, shall have the right to vote on decisions being taken by the Administrative Committee</td>
</tr>
<tr>
<td>(a)</td>
<td>under Articles 4, 8, 11, 12 of the Statute if the decision concerns a judge of the Court of Appeal or the Registrar;</td>
</tr>
<tr>
<td>(b)</td>
<td>under Article 83c, paragraph 6;</td>
</tr>
<tr>
<td>(c)</td>
<td>under Article 83e, paragraph 1(c);</td>
</tr>
<tr>
<td>(d)</td>
<td>relating to the adoption of that part of the budget of the European Patent Judiciary concerning the Facultative Advisory Council and decisions under Article 17, paragraph 2(c), Article 21, paragraph 2, Article 22, paragraph 1, Article 27, paragraph 2, and Article 30, paragraph 4, as far as they concern the Facultative Advisory Council;</td>
</tr>
<tr>
<td>(e)</td>
<td>under Article 17, paragraph 2(d);</td>
</tr>
<tr>
<td>(f)</td>
<td>under Articles 14 and 15, paragraphs 3 and 4.</td>
</tr>
</tbody>
</table>
Under the proposed Article 83f, no voting rights for FAC States in the two cases where unanimity is required (see Art. 18(2)).

(2) For decisions under paragraph 1(b) to (f), Article 18, paragraph 3 shall apply mutatis mutandis. The procedure for decisions under paragraph 1(d) shall be governed by the Financial Regulations.
The Agreement shall cover:
- all European patents which are effective when it enters into force,
- all European patents granted in respect of applications filed before the entry into force of the Agreement, and which became effective after that date, and, of course,
- European patents resulting from applications filed on or after its entry into force.

Letter (b) is necessary since the European Patent Court would be competent to decide also on provisional protection of European patent applications.

By adding the word "and", it is made clear that the introductory part refers to both paragraphs in the article.
Article 85  Jurisdiction of national courts during a transitional period

(1) During the first seven calendar years after this Agreement has entered into force, proceedings for infringement or revocation of a European patent may still be initiated before the national court or other competent authority of a Contracting State having jurisdiction under national law which for that purpose shall continue to apply to European patents effective in the Contracting States. This Agreement shall not apply to such proceedings.

(2) Any proceedings pending before a national court at the end of the transitional period shall continue to be subject to the transitional regime.

Article 86  Evaluation

Five years after this Agreement has entered into force, the Administrative Committee shall evaluate the situation and may decide to extend the transitional period under Article 85, paragraph 1. If no decision to that effect is taken, the transitional period shall expire at the end of the seventh calendar year after this Agreement has entered into force.
CHAPTER II  FINAL PROVISIONS

Article 87  Texts supplementing the Agreement

Integral parts of this Agreement shall be:
- the Statute,
- the Protocol on Privileges and Immunities of the European Patent Judiciary,
- the Rules of Procedure once adopted by the Administrative Committee.

Article 88  Signature, ratification

(1) This Agreement shall be open for signature until *** for all Contracting States to the European Patent Convention which participated in the Diplomatic Conference on the Establishment of a European Patent Litigation System.

(2) This Agreement shall be subject to ratification. Instruments of ratification shall be deposited with the Government of ***.

Article 89  Accession

(1) This Agreement shall be open to accession by any Contracting State to the European Patent Convention [and to the European Community].

(2) Instruments of accession shall be deposited with the Government of ***.
Administrative Committee and delegates' voting rights, and for the provisions on financing the European Patent Judiciary. In-depth study may reveal further issues.

Provision necessary because of the inclusion in the EPLA of the rules governing the FAC.

The values for "n" mentioned during the discussion within the Working Party on Litigation in December 2002 were 2, 5 and 6. No decision was taken on this. According to the UK delegation, the cost of setting up the system must be taken into account in this context as it has to be borne by those States whose ratification or accession leads to the entry into force of the Agreement.

Reservation by SE as to the choice of three for the number of States in which the highest number of European patents was in force.

Article 89a  Reservations

A Contracting State may enter no other reservation than that specified in Article 83d.

Article 90  Entry into force

(1) This Agreement shall enter into force [***] months after the deposit of the last instrument of ratification or accession by [n] Contracting States to the European Patent Convention which have not entered a reservation under Article 83d, including at least one of the three States in which the highest number of European patents was in force in the year preceding the year in which the Diplomatic Conference took place.

(2) Any ratification or accession after the entry into force of this Agreement shall take effect on the first day of the third month after the deposit of the instrument of ratification or accession.
The requirements listed in Art. 21(3) and (4) shall also apply to the first distribution key. However, the relevant figures must, of course, be those relating to the situation before entry into force of the EPLA. After five years, Art. 21(4) will apply.

This way of fixing the initial contributions can also apply to FAC States.

The last part of the sentence makes it clear that only cases for which the European Patent Court would have had jurisdiction are to be taken into consideration for the calculation of the contribution (see also Art. 21(3)(b) Draft Agreement).

For States joining the EPLA after its entry into force, participation in the distribution key valid at the time in question should be acceptable, given that the key will be regularly updated. The percentages for all the Contracting States will be recalculated with effect from the date of entry into force of the EPLA in the new State.

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**Article 91  First distribution key, initial contributions**

(1) On the entry into force of this Agreement the Contracting States shall provide initial financial contributions necessary for actually setting up the European Patent Judiciary and in particular the European Patent Court. The level of such contributions shall be determined by the Administrative Committee. Article 21, paragraphs 3 and 4, shall apply, with the proviso that the relevant years shall be the last three years preceding the year of entry into force of this Agreement, and the relevant number of European patents which are the subject of litigation shall be the number of European patents which are the subject of litigation before the national courts and for which the European Patent Court would have had jurisdiction under this agreement.

(2) Initial contributions of States ratifying this Agreement or acceding to it after its entry into force shall be calculated on the basis of the figures for the years relevant to the distribution key valid at the time of their ratification or accession.
Art. 91 also applies to Contracting States participating only in the FAC system; these states too are interested in setting up the European Patent Judiciary and, in particular, the Court of Appeal of the European Patent Court, as this is a prerequisite for the functioning of the FAC.

Article 92

Duration of the Agreement

This Agreement shall be of unlimited duration.

Article 93

Revision

(1) This Agreement may be revised by a Conference of the Contracting States.

(2) The Conference shall be prepared and convened by the Administrative Committee. The Conference shall not be validly constituted unless at least three-quarters of the Contracting States are represented at it. Adoption of the revised text shall require a majority of three-quarters of the Contracting States represented and voting at the Conference. Abstentions shall not be considered as votes.

(3) The revised text shall enter into force when it has been ratified or acceded to by the number of Contracting States specified by the Conference, and at the time specified by that Conference.

(4) Such States as have not ratified or acceded to the revised text of the Agreement at the time of its entry into force shall cease to be parties to this Agreement as from that time.
Art. 174 EPC  

**Art. 174 EPC**  

**Article 94**  

*Denunciation*

Any Contracting State may at any time denounce this Agreement. Denunciation shall be notified to the Government of ***. It shall take effect one year after the date of receipt of such notification.

Art. 175 EPC

**Art. 175 EPC**  

**Article 95**  

*Preservation of acquired rights*

If a State ceases to be party to this Agreement, the Agreement shall continue to apply to any proceedings pending before the European Patent Court at the date on which denunciation takes effect, and to the resulting decisions.

Art. 176 EPC

**Art. 176 EPC**  

**Article 96**  

*Financial rights and obligations of a former Contracting State*

Any State which has ceased to be a party to this Agreement in accordance with Article 93, paragraph 4, or Article 94 shall have the financial contributions paid under Article 21, paragraph 2, or Article 22 refunded to it by the European Patent Judiciary only when the European Patent Judiciary refunds financial contributions paid by other States during the same accounting period, and under the same conditions.

Art. 177 EPC

**Art. 177 EPC**  

**Article 97**  

*Languages of the Agreement*

This Agreement, drawn up in a single original, in the English, French and German languages, shall be deposited in the archives of ***, the three texts being equally authentic.
Article 98  Disputes between Contracting States

(1) Any dispute between Contracting States concerning the interpretation or application of this Agreement which is not settled by negotiation shall be submitted, at the request of one of the States concerned, to the Administrative Committee, which shall endeavour to bring about agreement between the States concerned.

(2) If such agreement is not reached, any one of the States concerned may submit the dispute to the International Court of Justice for a binding decision.

Article 99  Transmission and notifications

(1) The Government of *** shall draw up certified true copies of this Agreement and shall transmit them to the Governments of all signatory or acceding States.

(2) The Government of *** shall notify to the Governments of the States referred to in paragraph 1:

(a) any signature;

(b) the deposit of any instrument of ratification or accession;
Consequence of insertion of Part Va into the Agreement

(c) any reservation or withdrawal of reservation pursuant to Article 83e;

(d) the date of entry into force of this Agreement;

(e) any denunciation under Article 94 and the date on which such denunciation comes into force.

(3) The Government of *** shall register this Agreement with the Secretariat of the United Nations.

IN WITNESS WHEREOF, the Plenipotentiaries authorised thereto, having presented their Full Powers, found to be in good and due form, have signed this Agreement.

Done at *** this *** day of *** two thousand ***
RESOLUTION PASSED BY THE NAMED JUDGES
SPECIALISING IN PATENT LAW AT THE JUDGES’ FORUM
HELD IN SAN SERVOLO, VENICE – OCTOBER 14-16 2005

Having regard to the large number of patents granted by the European Patent Office and in force in European countries (currently estimated at in excess of 700,000); and

Having regard to the necessity to enforce these patents nationally which is unduly expensive for patentees and may result in inconsistent decisions in different countries thereby creating barriers to trade; and

Having regard to the goals of the Lisbon Agenda of the European Community and the failure to date of the Member States of the EU to implement a Community Patent system; and

Having regard to the fact that even if an appropriate Community Patent system were to be implemented now, Community Patents will not be enforceable for many years and European Patents will continue to be granted.

WE

(i) resolve that a practical way for European Patents to be enforced throughout the EU and member countries of the European Patent Convention within a reasonable time and at reasonable cost would be to convene a Diplomatic Conference with a view to implementing proposals broadly along the lines of those of the Working Party for a European Patent Litigation Agreement as soon as practicable; and

(ii) urge that Member States of the EU and Turkey and Switzerland co-operate in such endeavour whether by way of Enhanced Co-operation pursuant to Art II of EC Treaty or otherwise.

Lord Hoffmann, House of Lords, UK
Lord Justice Jacob, Court of Appeal, UK
Dr P Meier-Beck, Federal Court, Germany
Dr K Jürgen Melullis, Federal Court, Germany
Dr K Grabinski, Düsseldorf Regional Court, Germany
Mr E Numann, Supreme Court of the Kingdom of the Netherlands, The Netherlands
Mr R Van Peursem, Court of First Instance, The Hague, The Netherlands
Mr J Brinkhof, Former Vice President of the Court of Appeal, The Hague, The Netherlands
Madame C Vallet, Presiding Judge, Tribunal de Grande Instance, Paris, France
Judge J Feilberg, President of the Maritime and Commercial Court, Denmark
Judge T Norström, District Court of Stockholm, Sweden
Mr B Nilsson, Retired District Court Judge, Sweden
Dr M Tavassi, Supreme Court, Italy
Dr M Scuffi, Supreme Court, Rome, Italy
Ms G Muscolo, High Court, Rome, Italy
Hon Judge I Sancho Gargallo, President of the 15th Section of the Audiencia Provincial de Barcelona, Spain
Hon Judge L Rodriguez Vega, Juzgado Mercantil No. 4 de Barcelona, Spain
Dr D Brändle, Commercial Court of Zurich, Switzerland
Mr F Nyffeler, Bundesrichter, Schweizerisches Bundesgericht, Switzerland
Mr Maurer, Commercial Court of Bern, Switzerland
Dr A Knecht, Commercial Court of Aargau, Switzerland
Prof. Dr Leuenberger, Commercial Court of St Gallen, Switzerland
Mr I Gunes, Judge, Ismir, Turkey
Mr T Alica, Judge, Ankara, Turkey
Community Patent and European Patent Litigation Agreement

Winfried Tilmann

In a recent discussion, in which members of the Court of Justice, of the European Parliament and of the European Commission have taken part, some ideas and arguments have arisen, which I want to take further and to share with the community of those who are interested in a European court system regarding patents, for which two models have been developed: the Draft Community Patent Regulation and the Draft European Patent Litigation Agreement.

1. A stumbling block for the Community Patent: claim translation and the legal effect thereof

1.1 The legitimate aim of the proposed claim translation is to inform possible uninformed users of the patent as early as possible so that they can decide whether to raise an opposition, whether to take a licence or to avoid patent use. This information, of course, is valuable only if it is a good and exact translation.

1.2 On the other hand, providing for claim translations in 19 EG languages, and this within a rather short time period, is a huge burden on industry. Moreover, even if

* Partner, Lovells, Professor at Heidelberg University.
these translations are conducted with diligence, one cannot avoid translation errors. These errors might lead to a larger or to a smaller scope of protection as would be justified by the original version, which raises the question of the legal effect to the wrong translation.

1.3 A patent claim, even if translated correctly, will not give reliable information on the contents and scope of the patent, because, according to Art. 69 EPC, the claim has to be read together with the description (which is not translated).

1.4 Therefore, the claim translation cannot have more than a warning function: the possible user may get alarmed and motivated to look into the original version.

1.5 These arguments lead to the result that the idea of a "binding effect" of the claim translation, even if only for a certain time period, is not well-founded.

(a) Reading and interpreting a patent claim without the (not translated) description is something which would be against Art. 69 EPC and which, therefore, no user or patent attorney or patent lawyer, helping the user, would consider to be a valuable exercise.

(b) Furthermore: Who is going to decide on the "real meaning" of the translation? The European judge in the Community Patent Court (Chamber of the Court of First Instance) will, in many cases, not be able to assess the linguistic aspects of the translation. He will be in the hands of the translator. There are not many translators who have experience in patent cases, especially in countries where patent litigation is just beginning.

(c) It seems that the idea of a "binding effect" of a "claim translation" also has its procedural problems. The judge will have to decide with the help of the translator (different from the translator of the patent claim) whether a certain word in the claim (not regarding the description) has a certain meaning different from the same word in the original language and to establish such different meaning even in a case where a quick look into the description of the original patent would have clarified the matter.

1.6 On the other hand, it must be admitted that many possible users in the enlarged European Community do not speak one of the EPC-languages. Furthermore, it must be taken into account that the patent holders interested only in protection in a certain number of Member States, might not be very diligent in claim translations regarding the other Member States. Also regarding these countries, a claim translation might be so sloppy that it could not even fulfill a warning function.

1.7 How to find a compromise in this situation? One thing all representatives of Member States will agree upon, is that the patent owner can ask for damages or unlawful enrichment (that is: for money) only after having provided the possibly unlawful user with a full translation of the claim and the description so that the user (with the aid of his patent attorney or patent lawyer) can find out whether to take a licence, whether to fight, or whether to change production.

A similar problem is that the patent owner may get an injunction, a cease-and-desist order from the court, giving the user no time or only a short time to change production. This problem could be solved by making such an action, as in the case of damages, dependent from a previous full translation of the patent and giving the user under certain circumstances a time limit to change production. This would have to be decided by the Judge hearing the parties on the cease-and-desist claim.

This measure (full translations necessary for damages and cease-and-desist orders) give to the unknowing user already a certain amount of protection.

1.8 The idea to force the patent owner to translate all claims into all European languages tries to do more: to give to the user already at a very early stage such information as would help him to discover the real content and scope of protection, in order to adjust his production or to use the opposition procedure against the grant of the patent.

(a) These decisions, however, again can be taken only after reading the patent in the original. Otherwise, the economic decision regarding a change of production and the decision to participate in costly procedures of opposition would not be well-founded.

(b) The only help the user needs at that stage is a kind of red warning light which may cause him to take a look into the original.

(c) For this purpose, the so-called abstract of a patent (a shortly worded text of usually about 5 to 20 lines containing an information on the object of the invention, which must, according to Art. 78 (1) (e) EPC be part of every patent application) is fully sufficient. If somebody does not react to that "abstract" and does not start reading the original (with the help of his patent attorney or patent lawyer), it is his own fault. On the other hand, translating such an abstract (instead of 10 to 15 patent claims of a difficult technical character!) is a burden not too heavy for the patentee.

(d) Of course, these abstracts must be as correct and informative as possible. Already under present law, however, it is the duty of the European Patent Office to check whether the abstract really has an informative character. According to Rule 33, the abstract must contain a concise summary of the contents of not more than 150 words describing the invention, the technical field, the technical problem and the decisive solution and the main use, if applicable also the main chemical formula. The content is finally decided by the EPO (Rule 47 (1)).

1.9 Along these lines, a compromise could be found serving the real interest of a possible user/competitor and putting on the shoulders of the patentee/industry only a burden which is reasonable and which they can carry. To ask for more would not serve the interests of the user/competitor in a better way and would put on the patentee/industry an unnecessary burden. It would, frankly speaking, serve the interests only of translation services who are on the winner's side of the Community Patent System anyway.

2. Community Patent versus EPLA

2.1 There exist more than 500,000 European Patents which are not covered by the Community Patent Court System. They will, in infringement procedures, continue to be decided by the national courts if, for these European Patents, there is no "centralized court".

2.2 Whether there is a need for such a centralized court for EP Patents depends to a certain extent upon the success of the Community Patent and the Community Patent Court System. This is so, because it must be assumed that the national courts, in deciding on European Patents, will follow the leading decisions of the Community Patent Court.

2.3 This assumption is not only a factual one, in that the authority of the Community Patent Court will influ-
ence the decisions of national courts deciding on European Patents. The leading role of the Community Patent Court's decisions also will have a legal foundation: Art. 69 EPC and the Protocol thereto give binding rules for the means of interpretation (claims, description, drawings) and for the way of interpreting a European Patent (whether – as in the UK – understood as interpretation or – as on the Continent – understood as granting a scope of protection around a patent claim). Therefore, regarding the same claim and the same accused form, there is only one correct result. Under such circumstances, a court in a non-Community EPC Member State would have (that is the legal theory) to come to the same result as the Community Patent Court.

Therefore, the practice of the Community Patent Court and the practice of the courts of the EPC Member States must legally proceed in an orderly fashion, they must take regard of each others decisions which, considering the authority of the Community Patent Court, will give to it a leading position as it is now attributed to some courts in the major EPC countries.

One possible solution for a harmonized jurisdiction on European Patents, therefore, would be to rely on the leading role of the Community Patent Court in claim interpretation and other legal questions arising in patent litigation.

2.4 If one would ask for "more", it seems to be more doubtful than ever whether the EPLA project is compatible with the obligations of Community Member States.

(a) The European Constitution Treaty, just decided upon, is supposed to be ratified by the end of 2006. At that time, Community Member States have, by this Constitution, under certain conditions, the possibility to make progress regarding certain projects with less than the totality of all Member States. Therefore, at that time, EC Member States interested in a cooperation regarding the court system for a European Patent would be able to do so within the European Community, even if they cannot convince all Member States of the European Community to take part in such a system.

(b) Given this possibility, it may be (already before 2006) a breach of Community law if Member States started such cooperation outside of the Community and remove that matter from the jurisdiction of the European Court of Justice. In order to find that result, it is not necessary to argue with the effects of the Regulation 44/2001 and the existence of the draft or final version of the Community Patent Regulation or other activities the Community has already started in the patent field (Bio Patents, Computer Patents).

(c) Making use of such a possibility (realizing the enhanced cooperation system for EP Patents within the Community) would hand to the European Court System, that is to the Community Patent Court, the jurisdiction also on European Patents.

2.5 It will be easily seen that such a decision could be taken only after the Community Patent Court has started its work and has proved to be a useful venue for deciding big and small patent cases.

(a) It may turn out that the EPC Patent System, in the future, will to a great extent be used by small and medium industry, whereas big industry will tend to use the Community Patent. For small and medium industry, speed and costs are decisive, and it will have to be seen how attractive to these parts of the industry the Community Patent Court System will be.

(b) Furthermore, there are so many European Patents and European Patent litigations that the sheer number would cause a definite problem for the central Community Patent Court.

(c) Therefore, notwithstanding the blocking effect of the possible enhanced cooperation referred to under 2.4, it seems to be excluded for some time to entrust to the Community Patent Court all decisions regarding European Patents in the form of that enhanced cooperation.

2.6 What alternatives exist if it is felt that one should do more for the European Patents than relying on the leading role of the Community Patent Court?

(a) The Community will adhere to the European Patent System, because it uses the European Patent Office for granting Community Patents. There is even the idea to provide for a final role of the European Court of Justice regarding the granting procedure of the European Patent Office. Even if this is not implemented, the Community Patent Court will decide, regarding Community Patents, on the basis of the same rules as the national courts when deciding on European Patents.

(b) There is no legal difficulty in opening the way to questions of interpretation (Art. 234 EC Nice) regarding the scope of protection and other questions, from the national courts to the Community Patent Court or to the European Court of Justice. The European Court of Justice already has decided on interpretation questions on non-Community law, if there exists a parallel question under Community law (decision of Dec. 14, 2000, C-300/98 and C-392/98 – GRUR Int. 2001, 327, nr. 32–40 – Dior, regarding TRIPS). Since the post-grant rules of the European Patent Convention will become Community law after the entry of the Community into the European Patent System, they are such parallel rules to the same rules of the EPC binding national courts regarding an EP-Patent.

2.7 I do not think that for the present moment, there exists a real need for more "centralization" within the European Patent System than to follow the leading role of the Community Patent Court interpretation and to be able to ask questions of interpretation to the European Court of Justice.

Therefore, I do not think that it is necessary to install the Community Patent Court as an appeal court against decisions of the national courts regarding European Patents. This would be a major legal enterprise (using enhanced cooperation) and could (it is said: in France) create constitutional problems. Furthermore, it would be very burdensome for small and medium industry to be forced to go to Luxembourg, even if it were only on the appeal level. This idea should not be considered for the foreseeable future.

3. Result

3.1 The present stumbling block of the Community Patent, the claim translation and its binding effect, can be removed by making a patent action against the possible user of a patent dependent on serving him with full translations (claims, descriptions, drawings) in his own language (which may not be necessary if the user says that he does not need such translations).

The translation requirement after patent grant, in the present draft relating to all claims, should be reduced to the "abstract", because this is fully sufficient for providing a warning function, whereas a translation of the claims...
(without translating the description) does not give substantially better information to the possible user and puts an unnecessary burden on industry.

3.2 The EPLA project would probably constitute a breach of Community law by Community Member States, because the European Constitution Treaty gives to them the possibility to enact among themselves, regarding European Patents, an enhanced cooperation. Furthermore, this project does not seem necessary, because the national courts will follow the leading role of the Community Patent Court and may put to the European Court of Justice or to the Community Patent Court questions (Art. 234 EC) regarding the interpretation of post-grant EPC Rules which will become also Community law rules after the entry of the Community into the European Patent System.
Harmonization of Invalidity- and Scope-of-Protection-Practice
of national courts of EPC-member-states

Paper prepared for the
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by

Prof. Dr. Winfried Tilmann
Düsseldorf
Harmonization of Invalidity- and Scope-of-Protection-Practice
of national courts of EPC-member-states

1. A well known and widely discussed problem in the post-grant practice of national courts of EPC-member-states is the need for harmonizing divergencies of national court practices in EP-patent-infringement cases in the absence of a central court governing and guiding such practices. The Amgen-decision of the House of Lords (see no. 8. a. below) and the Schneidmesser-decision of the German Federal Supreme Court (BGH; see no. 8. a. below) have contributed to narrowing the gap between the most divergent court practices relating to the scope of protection of a European Patent (UK practice, practice in Germany), but a certain gap still exists (see no. 8 below).

2. A less known and rarely discussed problem in the post-grant-practice of national courts of EPC-member-states is the need for harmonizing divergencies of national court practices in EP-patent-validity cases in the absence of a central court governing and guiding such practices.

3. The problems no. 1 and 2 can arise separately, if one action in one court is dealing only with validity, another action in another court (in Germany: the Bundespatentgericht), or the same court later is dealing with infringement. Normally, however, both problems arise jointly, if, in an infringement action, the defendant is asking not only for the rejection of the infringement-claim, but also, or in the first place, for an invalidation of the EP or if he is raising only the defence-argument of nullity.

4. Therefore, both problems are practically connected: The need for harmonizing national court practices is showing itself regarding two aspects of the same procedure (validity, infringement). Hence, it is reasonable and justified to pay attention to the Harmonization of practice not only regarding the infringement side of the case (scope of protection, equivalence; see no. 1), but also regarding the validity side (see no. 2).

5. The EPC provides binding general rules for infringement (scope of protection, art. 69 EPC and Protocol to art. 69 EPC) and for validity (art. 138 lit. a, referring to art. 52 to 57 EPC; art. 54 EPC is dealing with "novelty"; Art. 56 EPC is dealing with "inventive step") excluding the application of national rules (Swiss Fed. Court...
19.08.1991, GRUR Int. 1998, 293/294 ff. - Stapelvorrichtung). These rules are general, because they seem to leave room

a) for the application of the general rule in one specific case which is showing itself if different courts of the same state (e.g.: a first instance and a second instance court) or the courts of two member states decide differently, regarding one specific EP-patent and one specific accused form ("application" problem);

b) for the application of the general rule vis-à-vis a problem common to a certain group or category of cases (problem of "sub-rules" of interpretation or application) regarding such group or category (for examples see No. 8 and 9).

6. "Harmonization" of the application problem (No. 5a) above) means finding the (one) right decision in a specific case by different courts (perhaps in different countries). It should not be called "Harmonization", but "synchronisation" and can be achieved only by a central court in the first or second instance, that is: by organisational means as envisaged

a) by the (old) Community Patent Treaty of 15 December 1975/21 December 1989, not ratified by all EC-member-states, which provided for an appeal-like instrument from the second instance of a national court to a central EC-court dealing only with questions of validity and claim construction/infringement, not with the legal consequences (remedies, damages), which were left for the national courts to decide,

b) by the project of a Community Patent with a central two instance Community Patent Court and

c) by the project of a European Patent Litigation Agreement (EPLA) with a concentration of first instance courts and a central appeal court.

7. Harmonization in the sense of giving guidance on a more abstract level of rules governing court practice for a certain group or category of cases (No. 5b) above) is possible by developing "sub-rules" to a general rule contained in the EPC, such sub-rules governing this group or category of cases and being followed by all national courts of all EPC-member-states. What would be the nature of such "Sub-rules"?
The legal understanding of constant court practice differs from country to country and from one law-school teacher to the other. There is one opinion which regards these "sub-rules" only as a mode of practice, a mode of practice applied by the EPO or by the national courts. Another view on a higher level understands the sub-rules as a mode of practice under the obligation of equal application of equal treatment. The EPO or a court binds itself for the future, once it has established a certain mode of practice. We could speak of self-binding modes of practice. An even more advanced view is known from the US, were the principal of "stare decisis" of high courts comes close to the concept of a "court-developed law". Lower courts may deviate only after the Supreme Court has changed the mode of practice regarding a certain question. An extreme view would regard the mode of practice, strictly speaking, as court-developed law. For our purpose we don't have to decide on this dogmatic question. It is sufficient to agree that the divergent "sub-rules" listed under no. 8 and 9 below would lend themselves to become legal rules adopted by a law-making body.

8. National courts of EPC-member-states apply "sub-rules" (No. 5 b) and 7) regarding interpretation and infringement (art. 69 and Protocol to art. 69 EPC) which are partly different from each other (divergences) despite the fact that all courts agree in principle that there can be, regarding the same patent claim and the same accused form, only one result which is "correct" under the binding rule of Art. 69 EPC and the Protocol (UK: the "Protocol Question(s)"). Examples for these divergences are:

a) The question whether patent protection is confined to an interpretation of the patent claim, read contextually together with the description, (English courts: Kirin-Amgen Inc. v. Hoechst Marion Roussel, 21.10.2004, [2004] UKHL 46; Rockwater v. Techniq France SA et al., 1.4.2004, HC 02 00 440), or whether patent protection is also granted for means equivalent to the means proposed by the patent claim (German courts: 5 decisions of the Federal Supreme Court–BGH–of 12.3.2002: Kunststoffrohnteil, GRUR 2002, 511; Schneidmesser I, GRUR 2002, 515; Schneidmesser II, GRUR 2002, 519; Custudiol I, GRUR 2002, 523; Custudiol II, GRUR 2002, 527; similar situation in France).

b) The question, whether in interpreting an EP-patent the court may take regard of the file-history (practice in NL: Ciba Geigy AG v. Oté Optics,
Hoge Raad, 10. January 1995, NJ 1995, 391) or only in rare cases (practice in UK: Rohm & Haas [2002] F.S.R. 28) or only in order to assess the understanding of a skilled person at the priority date (practice in France and Germany).

c) The question of what is the reference time for the skilled person to assess the scope protection (equivalence). In Germany the courts refer to the priority date, whereas in the UK (General Tire v. Firestone [1972] R.P.C. 451) some decisions refer to the day of publication. In the Netherlands and in France court practice refer to the date of infringement.

d) The question whether, at least under special conditions, the patent covers also a partial infringement (disputed practice in France: French Supreme Court, decision of 28 April 1987 Equipments Automobiles Marshal v. Paul Journée; this practice is followed by no other EPC-member-state).

e) The question whether the claims of a European patent also extend to so-called "dependent inventions", i.e. (1) to an accused form which adds an inventive aspect to the patented technology, or (2) to an accused form which uses inventive means belonging to the same family of means as the (original) means proposed by the patent claim, this family being equivalent to the original means (Germany: for (1) see: German Federal Supreme Court (BGH) decision Spannschraube, GRUR 1999, 909; Bratgeschirr, GRUR 2000, 1005; for (2) see German Federal Supreme Court decision Kabeldurchführung, GRUR 2001, 770; similar situation for (1) in France, but with this exception, there is no such practice in other EPC-member-states).

f) The question, whether patent interpretation and protection in "equivalence-cases" is to be restricted, if the accused form (1) is part of the state of the art, or (2) is a non inventive development over the state of the art (Germany: Formstein-defence in Germany: Federal Supreme Court–BGH–decision Formstein, GRUR 1986, 803; Kabeldurchführung I, GRUR 1987, 454; Switzerland: Swiss Federal Court, decision Polyurethan-Hartschaumplatten, 16.11.1989, GRUR Int. 1991, 312). There is no such practice in other EPC-member-states.
9. National courts have divergent practices and they apply different "sub-rules" (no. 5 b), 7) also regarding the validity aspects of an EP patent infringement case (art. 138 EPC). They also differ in the "Sub-rules" they apply from the practice of the EPO. Examples for such divergences are:

a) Interpretation of the Exclusions of Patentability (art. 52 EPC), for instance (1) of art. 52 (2) (c) EPC (exclusion of programs for computers from patentability) to which art. 138 (1) (a) EPC refers for validity procedures regarding computer-implemented inventions, in the absence of an EU-directive, which failed in the European Parliament in July 2005 or (2) methods of treatment versus second medical use (restrictive practice in the UK compared with that of the EPO: Merck & Co. Inc's Patent [2003] FSR 29; Bristol Myers Squibb v. Baker Norton [2001] R.P.C.).

b) "Sub-rules" concerning novelty (art. 52 (1), art. 54 (1) and (2) EPC) may deal with the following questions:

(1) Is the disclosure of an older document restricted to what it says (i.e. "photographic" notion of disclosure), only including inevitable results (see Busse-Keukenschrijver German Patent Act = BK, 6. Ed. 2003, PatG § 3 note 103, footnote 300; this is the position of the EPO and the practice in most of the EPC-member-states) or does it include all information which the skilled man would "read between the lines" (position in Germany: BK PatG § 3 note 101, footnote 273; the same situation exists in France and in the UK)? In the UK, however, the question is asked, whether carrying out the directions contained in the prior art will "inevitably" result in something being done which would constitute an infringement of the patent (General Tire, see No. 8. c) above).

(2) Does, therefore, an "implicit" disclosure have to be taken into account (EPO: no; see BK PatG § 3 note 103, footnote 301; Germany, France and the UK: yes)?

(3) Does a general term (e.g. vegetable) include specific sub-terms (e.g. edible fruits), but not vice versa (i.e. a specific sub-term does not disclose the more general term), which is the position of the EPO (EPO-guidelines C IV 7.4; BK PatG § 3 note 103, footnote 398)? The practice in Germany (BK footnote 299) and, possibly, in
the UK is wider: The specific sub-term may disclose the general term.

(4) Is a disclosure regarding a greater range of values, in principle, novelty-destroying regarding a smaller frame of values within that range (position in Germany, BGH, GRUR 2000, 591/594 - Inkrustierungsinhibitoren; BK PatG § 3 note 151, 156; ENPDR, 2004, 55/57) or is this not the case, if the smaller frame of values is limited and constitutes a selection under the aspect of a certain, new effect (position of the EPO; T26/85; T279/89; T255/91; T 631/92 and of most of the other EPC-member-states, BK PatG § 3 note 152, footnote 470; for example UK: DuPont's Application [1982] RSR 303)?

(5) Is a process-claim new because of a new effect under similar rules as regarding use-claims (EPO: yes, BK § 3 note 163; Germany: no, BK § 3 note 163)?

c) Sub-rules concerning "inventive step"/"obviousness"

(1) Does the "skilled person" have to be selected from the same technical field (EPO: yes, ENPDR 2004, 84; Germany: not necessarily, ENPDR 2004, 85/87).

(2) Does the examination have to start from the closest prior art (position of the EPO, ENPDR 2004, 69; BK PatG § 4 note 34, footnote 147, see also note 153; the EPO is followed by Austria, ENPDR 2004, 70/71) or is this only a practical first step, and is it necessary to include other documents which are not so close (position in Germany, France and UK: BK PatG § 4 note 34, footnote 148, 150)?

(3) In applying the "could-would-test" (would the skilled person do what he could do?; EPO, ENPDR 2004, 69; followed by Austria, The Netherlands, Sweden; critical: Germany, BGH GRUR 2004, 47/50 - Blasenfreie Gummibahn I, different UK: "Windsurfer Test", ENPDR 2004, 70, 72 – 82) within the framework of an ex-post-analysis, should it be asked whether there was a "reasonable expectation of success" (position of the EPO, BK PatG § 4 note 145;
position in Germany and France: expectation of success not necessary, but the prior art should incite the skilled man to modify the prior art, BK PatG § 4 note 145; position in the UK: Would the skilled person assess the likelihood of success as sufficient to warrant actual trial? John Mansville Corporation's Patent [1967] R.P.C. 479)?

d) Sub-rules concerning

- amendments of the claims after the grant of the patent
- filing of auxiliary requests during litigation
- partial invalidity.

(1) In the Netherlands the Supreme Court (Spiro v. Flamco, Hoge Raad 9. February 1996, NJ 1998, 2) has limited the possibility for amendments to cases where it is clear to the skilled man where the limitation of the protection lies after the amendment and that the supplement was sufficiently obvious for him reading the specification.

(2) The practice of the EPO is more liberal in this respect. An amendment is allowable, if its subject matter is directly and unambiguously disclosed in the application as filed (Art. 123 (2) EPC) and if the scope of protection is not extended (Art. 123 (3) EPC) [Cf. T 339/89 OJ EPO 1991, 545; T 823/96; G 1/93 OJ EPO 1994, 541]. Unlike the Dutch courts, the EPO Boards of Appeal have not established any further requirement.


(4) In the UK, even if the amendment renders the amended claims inventive and novel, the Court retains discretion to refuse amendment based upon the conduct of the patentee (e.g. asserting a patent when the patentee knows it to be invalid can result in a refusal to allow amendment).
10. A Harmonization of the practice of national courts regarding "sub-rules" for invalidation (no. 5 b), 7, 9) is for the following reasons even more urgent than a Harmonization of the practice of national courts regarding the above mentioned infringement sub-rules (no. 5 b), 7, 8).

a) Regarding infringement (no. 5 b), 7, 8), there can be only a conflict (divergence) between certain practices of national courts.

b) Regarding validity, there may not only be divergent practices of national courts, but also divergences of such national court practise as compared with the practice of the EPO (see no. 9). Therefore, there may be a double divergence.

(1) The practice of a national court differs from the practice of other national courts;

(2) The practice of certain national courts differs from the practice of the EPO, whereas the practice of other national courts follows the practice of the EPO. Such a constellation has, from the viewpoint of the patent applicant, a "positive" and a "negative" effect:

(a) Negative effect: Where the EPO rules are "stricter" than the national rules, a patent will not be granted despite "softer" national standards.

(b) Positive effect: The EPO may grant a patent which may not have been granted by a certain member-state and which may be invalidated by the national courts of that member-state in view of identical prior art but under application of different sub-rules, but not invalidated by the courts of other member-states following the practice (the sub-rules) of the EPO.

11. The judicial control intended by the EPC in using national courts refers only to patent granting decision, not to the denial of patent granting. For the denial of patent-granting the EPO has a "monopoly" on the application of Art. 52-57 EPC. This aspect contributes to the impression of a dominant position of the EPO regarding the interpretation and application of Art. 52-57 EPC. The partial judicial control intended by the EPC in giving the national courts of mem-
ber-states the authority to cancel European Patents granted by the EPO certainly includes the authority to correct errors of the EPO in interpreting the rules of the EPC (art. 52-57 EPC). If, however, there is no unanimity of national courts in that some (or even the majority of the) national courts follow the interpretation by the EPO, but others (perhaps a minority) not, there is no clear case of an "error" of the EPO. In such cases, already from a practical point of view, the question arises whether it would be better if the practice of the EPO prevailed.

12. There could be a legal answer to this practical question:

a) For the interpretation of the EPC-rules and the development of sub-rules thereto, the Vienna Convention on the Law of Treaties of 23.5.1969 is relevant. This Convention codifies the general principles of international treaty law. The relevance of the Convention to the EPC has been recognised by the EPO (EPO G 1/83, GRUR Int. 1985, 193/194; G 1/84, GRUR Int. 1986, 123/124; J 8/82, GRUR 1984, 441; BK art. I Int. PatG note 18).

(1) The Vienna Convention calls for a bona fide interpretation of international agreements "in the light of its aims and objectives" (Art. 31 (1)). There shall be taken into account subsequent "agreements" (Art. 31 (3) (a)) and "subsequent practice") Art. 31 (3) (b)), "which establishes the agreement of the parties" regarding the interpretation. These rules are binding for the member states (Germany: Const. Court 31.03.1987, NJW 1987, 2155/2157; Switzerland: BGE 122 II 234 E. 4 c.) and for the Community Institutions (CFI 22.01.1997, T-115/94 - Opel Austria vs. Council, 1997, II-39; ECJ 20.11.2001, C-268/99 - Aldona, EuZW 2002, 120/123 with further references). See Bruchhausen, GRUR Int. 1983, 202/208 ff.; Vossius GRUR 1990, 333/335; Walter, GRUR 1998, 866 ff.

(2) Such a subsequent practice could be assumed to exist where a sub-rule-practice of the EPO is being existent or at least is existent and is followed by a majority of the national courts of EPC-member-states (see no. 11 above).
(3) This would lead to a binding effect of an EPO-practice in case of (2).

b) At least there is, under such circumstances, an obligation to seek a harmonized interpretation of the rules concerning validity. All EPC-member-states have incorporated (by duplication or by way of referral) Art. 138 EPC which itself refers to the patent-granting rules of art. 52 – 57 EPC. In patent literature an obligation is recognised (Benkart/Rogge, EPÜ art. 138 note 7; Swiss Fed. Court 19.08.1991, GRUR Int. 1992, 293/294 f. - Stapelvorrichtung).

   to come to an interpretation in accordance with identical criteria and not with different national legal traditions.

c) The German Federal Supreme Court (BGH) also has recognised such an obligation to harmonize national court practice applying the patent validity rules of the EPC. In the decision "Tollwutvirus" (rabies-virus) of 12 February. 1987 (GRUR 1987, 231/233) it has said:

   The EPO is ... of a different opinion as to the practice, until now, of the Senate and holds, that ... Since the Harmonization of the national and European rules on material patent-law should serve to create a far-reaching unified patent law, one should seek an application which is as far as possible unitary in the national and the international field...

Therefore, the BGH "for reasons of achieving the desired unitary application" has seen an obligation that national practice is put in line with the EPC and with the practice of the EPO.

d) Some national courts have adopted the principle that a decision of the EPO in granting a patent should be regarded as an expert opinion as to how the so-called "skilled person" would understand the patent and include and understand a document of the prior art. (Germany, France, UK, see EPO, European National Patent Decisions Report = ENPDR 2004, 301 ff.).

13. It appears necessary to increase the state of information and awareness of national courts regarding this obligation and the divergences (no. 8 and 9) existing despite this obligation. The national court decisions which apply "sub-rules" differently from those applied by the EPO or by other EPC-member-
states should be brought to the attention of the EPO and of the other national courts. There seems to be an obligation on the side of the EPO, which has the role of an administrative body of the EPC, to provide for such information and transparency.

14. Despite the undeniable obligation at least to harmonize the national practice regarding the EPC patent validity rules (No. 12 b) above) differences in the practice of national courts and between national practices and the EPO practice may continue to exist even after further information according to No. 13. Moreover the process of de-facto-harmonization through a cooperation of national courts and judges may be very slow. Which further action would be possible and advisable to come more rapidly to a higher degree of Harmonization regarding the "sub-rules" for patent interpretation and infringement on the one side and for patent granting and validity on the other side?

15. Harmonization (and "synchronization" see no. 6 above) of national court practice (not necessarily between the court practice and the practice of the EPO) would of course be possible by a central court. However, the prospects of a Central Community Patent Court are due to the language- and translation-problem, presently, dim.

The Venice-Conference of Patent Judges has passed a resolution (Annex) regarding the European Patent Litigation Agreement (EPLA) which has given a new impetus for that project, especially referring to the option of an enhanced cooperation between EU-member states. The non-EU countries interested in EPLA could participate as cooperative partners in such a construction. Even if such central courts would be established, the time until they could decide the first relevant cases seems too long to wait. There is need for a quicker action. Therefore, one should look for alternative means for Harmonization.

16. A second possibility would be to amend Art. 54 and 56 EPC by sub-rules on the problems referred to in no. 9 above and to amend Art. 69 EPC or the Protocol thereto by sub-rules on the problems referred to in no. 8 above. However, changing the EPC is a slow process (ratification).

17. A third alternative would be an EU-Harmonization directive.
a) The European Community has already acted in the field of IP (e.g.: Bio-tech-Directive; Draft Directive on Computer-Implemented Inventions, just rejected by the European Parliament; Enforcement-Directive).

b) Certainly, there is no room for a direct EU-harmonization on the effects of EP-Patents, since binding EPC rules already exist for (1) the interpretation (construction) of patents and the scope of protection and (2) for the granting/revocation of patents. The EU has no authority to give further definitions about what these EPC-rules are going to mean.

c) However, the EU can harmonize national law. Such Harmonization would have an indirect effect on EPC-patents in influencing EPO-practice. To give an example: In the field of Biotech the EU has chosen that way (Biotech Directive) and the EPO is following the rules of the Biotech Directive (Implementing Rules 23b - 23e).

d) It should be explored whether this way (EU directive) seems feasibly regarding our problem. An EU-harmonization would also prepare the way for the practice of EPLA- or Community Patent Courts.

A fourth alternative would be that the Administrative Council of the EPO uses his power to adopt interpretative rules on the questions discussed here.

a) The Vienna Convention (see No. 12 a)) gives preference to "later agreements" (Art. 31 (3) a); Germany: BGH 10.10.2002, NJW 2003, 134/135). This means: If an international agreement (as the EPC) is modified by a later revision-agreement, this later revision-agreement must be regarded as binding on the member states - and not the old agreement.

b) The EPO is applying this rule to implementing or interpreting decisions or rules (Art. 33 (1) (b) EPC) of the Administrative Council (EPO J16/96, Official Journal EPO 1998, 347/353 = GRUR Int. 1998, 708/709). This means: The EPO is considering Administrative Council rules (Art. 33 (1) (b) EPC) on the EPC rules as if they were "later agreements" in the meaning of the Vienna Convention, having binding effect on EPC member states (EPO cif nr. 3.2, referring to Art. 31 (3) a) of the Vienna Convention).

c) Interpreting existing rules by defining sub-rules for a better practice is clearly within the authority of the EPO Administrative Council (Art. 33 (1) b) EPC), since such definitions do not change the existing agreement.
Such Administrative Council decisions or rules, therefore, would fall under the rule of Vienna Convention (referred to in No. 18 a)) and would have to be observed in the spirit of bona fide interpretation (see No. 12 a) (1)).

d) Implementing Rules (Art. 33 (1) (b) EPC) are not confined to procedural question. They may also give a binding interpretation regarding material questions (see Rules 23a, 23b - 23e; Benkard/Schäfers EPÜ Art. 164 note 5).

e) Art. 164 (2) EPC, in the case of a conflict between an implementing rule and a rule of the EPC itself, gives priority to the rule of the EPC. Theoretically, therefore, a national court could maintain its "sub-rule" in the face of a different sub-rule of the Administrative Council. However, a harmonizing sub-rule adopted by a 3/4 majority of the Council (Art. 35 (2) EPC) would carry so much weight, that the "danger" of a later deviation of a national court would, indeed, be only theoretical.

19. The ways of using a EU-Directive or of using the EPC-Implementing Rules for Harmonization of divergent national "sub-rules" seems viable in the first place regarding the sub-rules for the granting and for the revocation (no. 9 above), because these sub-rules regarding EPC-rules concern also the activity of EPO itself, which has a dominant position EPC-rules on in interpreting Art. 52-57 EPC ("monopoly" on negative decisions, see no. 11 above). To a lesser degree, but still, these ways would be open for interpretative rules on the construction of the patent and on infringement, where no divergence with an EPO-Practice can occur (see No. 10 a) and b) above), especially interpreting the new art. 2 of the Protocol to art. 69 EPC (version of 29.11.2000, by which the scope of protection is defined in stating that patent protection must take due regard of equivalents to the (original) elements of the patent claim).

20. Therefore, two possible routes on the path of harmonization could be seen in (1) starting the work on a EU-directive and (2) submitting to the Administrative Council of the EPO a draft resolution regarding open questions of invalidity for which examples have been given in No. 9 above, possibly also regarding the open questions of infringement, for which examples have been given in No. 8 above.
Such proposals already in itself would have an immediate valuable effect in reminding the courts of member-states of their obligation to harmonize their practice and, especially, to avoid divergences between their invalidity-practice and that of the EPO in patent-granting (no.12 above).

21. If these routes would be chosen

- the "sub-rules" on patent-granting and validity should be worked out and drafted by way of a co-operation between the EPO and the leading national judges,

- the "sub-rules" on patent interpretation and on the extent of patent protection should be worked out and drafted by way of a cooperation of the leading national judges.
| N° | EN Form of address | FR Appellation | EN University qualification | FR Titre universitaire | DE Universitätsqualifikation | EN Occupational qualification | FR Titre professionnel | DE Berufserfassung | EN Firm | FR Cabinet | DE Firma | EN Street | FR Rue | DE Straße | EN Post code | FR CP | DE PLZ | EN City | FR Ville | DE Ort | EN Country | FR Pays | DE Land | e-mail | Tél | Phone | Fax |
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| 1  | Maître            | Emmanuel       | Comu                        | Avocat                 | Simon Braun                | Avenue Louise 149 b 20     | 01050                     | BRUXELLES           | BE      | 0.533 17 22     | emmanuel.comu@simonbraun.be |
|    |                   | Ludovic        | De Gryse                    | Avocat                 | Stëbbe                     | rue Henri Wafelserta, 47-51| 01060                     | Bruxelles           | BE      | 0.32 2-543-70 90 | ludovic.degryse@stib.be |
|    |                   | Emmanuel       | Comu                        | Avocat                 | Simon Braun                | Avenue Louise 149 (boîte 23)| 6-1050                    | BRUXELLES           | BE      | 0.32 2-543-70 90 | emmanuel.comu@simonbraun.be |
|    |                   | Paul           | Maysaret                    | Avocat                 | Altius                     | Haveniën 16                | 01080                     | Bruxelles           | BE      | 0.32 2 426 14 14 | paul.maysaret@altius.com |
| 24 | Maître            | Bernand        | Remiche                     | Avocat                 | Van Bunken, Remiche, Droylans & Ferrant | Avenue Hamor 11             | 01180                    | BRUXELLES           | BE      | 0.376 00.50     | bernard.remiche@vmbuenner-law.be |
|    |                   | Christophe     | Ronse                       | Avocat                 | Altius                     | Avenue du Port 16           | 01080                    | BRUXELLES           | BE      | 0.32 2 426 14 14 | christophe.ronse@altius.be |
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|    |                   | Jean-Christophe| Troussel                    | Avocat                 | Linkaters De Bandt         | rue Bréderode 13            | 01000                    | BRUXELLES           | BE      | 0.501 95 15     | jean- christophe.troussel@linkaters.com |
|    |                   | Thierry        | Van Innis                   | Avocat                 | Tervurenlaan 268A         | 01150                     | BRUSSEL           | BE      | 0.7802569      | thierry.vaninnis@altenover.com |
|    |                   | Bernard        | Van Reepinghen              | Avocat                 | Av, Molière 276 bte 13    | 01180                     | BRUSSEL           | BE      | 0.343 47 79     | bernard.vanreepching@linkaters.com |
| 46 | Dr.               | Emmanuel       | Calame                      | Rechtsanwalt           | Lenz & Staeelin, Rechtsanwälte | Bleichergasse 58           | 08027                     | ZURICH            | CH      | 41277034703    | thierry.calame@lenzstaeelin.com |
| 42 | Dr.               | Peter          | Heinrich                    | Rechtsanwalt           | Lenz & Staeelin            | Bleichergasse 58           | 08027                     | ZURICH            | CH      | 41277034703    | peter.heinrich@lenzstaeelin.com |
| 40 | Dr.               | Dr.            | Christian                   | beleitung               | Staeelin & Pedrazzini AG  | Gottliebistrasse 53         | 08023                     | ZURICH            | CH      | 41277034703    | christian.beleitung@staeelin.ch |
| 34 | Mr.               | Michel         | Mulhsain                    | Avocat                 | Junod, Gayet, Mulhsain & Levy | 17 rue Töpfer              | 01208                     | GENEVE           | CH      | 41277034703    | michelmulhsain@ttopfer.ch |
| 32 | Herrschaft        | Jörg            | Müller                      | Rechtsanwalt           | Troller Hitz, Troller & Partner | Münchnergasse 36           | 03011                     | Bern               | CH      | 031 328 36 36   | jorg.mueller@trollerhitz.ch |
|    |                   | Werner         | Steiger                     | Rechtsanwalt           | Hornburger                | Weinbergstrasse 55/58      | 08035                     | Zürich           | CH      | 041 43 222 1000 | werner.steier@hornburger.ch |
|    |                   | Dr.            | Trometer                    | Avocat                 | Lalive & Partners         | 6, rue de l'Althétée       | 01205                     | GENEVE           | CH      | 041 42 319 87 00 | trometer@alive.ch |
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<th>Johan Schröder law firm</th>
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### Spain

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### Finland

| Mr. | Peter Backström | Attorney | Backström & Co | Et. Makasinkatu 4 | 130 | Helsinki | FI | peter.backstrom@backstromco.fi | 00 358 9,6669940 | 00 358 9,66699410 |

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**France**

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|---|---|---|---|---|---|---|---|---|---|---|---|---|---|---|---|---|
| 8 | Jacques | Armengaud | Avocat à la Cour | Armengaud &amp; Guérin | 12, av Victor Hugo | PARIS | 75116 | PARIS | 01 (01) 45 74 08 18 | 01 45 74 78 57 |
| 164 | Olivier | Blancheneau | Avocat | Lovells | 6 Avenue Kléber | PARIS | 75009 | PARIS | 01 (01) 45 74 08 18 | 01 45 74 78 57 |
| 106 | Mrs | Laties | Bénard | Avocat | Allen &amp; Overy | PARIS | 75009 | PARIS | 01 (01) 45 74 08 18 | 01 45 74 78 57 |
| 165 | Serge | Birn | Avocat à la Cour | Birn &amp; Associés | 25, boulevard Malesherbes | PARIS | 75008 | PARIS | 01 55 35 05 35 | 01 55 35 05 36 |
| 166 | Yves | Bizot | Avocat à la Cour | Lamy, Ribeyre &amp; Associés | 40, rue de Bonnel | LYON CÉDEX 03 | 69484 | LYON | 07 68 69 36 36 | 07 68 69 39 49 |
| 168 | Thomas | Bouvet | Avocat | Véron &amp; Associés | Avenue de l'Opéra Louis Jouvet | PARIS | 75009 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 172 | Pierre | Cousin | Avocat à la Cour | Cabinet Cousin, Moatty | 8, rue de l'Odéon | PARIS | 75009 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 173 | Marine | Coutié | Avocat à la Cour | Coutié &amp; Coutié | 28, boulevard Raspail | PARIS | 75009 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 175 | Dominique | Dupuis-Latour | Avocat à la Cour | SEP Pagenberg &amp; Associés | 14, Boulevard Malesherbes | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 176 | Fabienne | Fajenbaum | Avocat à la Cour | Véron &amp; Associés | 156, boulevard Haussmann | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 179 | Julien | Frennaux | Avocat | Bardehle, Pagenberg, Doll, Altenebr, | 14 Boulevard Malesherbes | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 180 | Stéphane | Guérin | Avocat | Amengaud Guérin | 72 avenue de Wagram | PARIS | 75017 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 9 | Christian | Hollet-Larousse | Avocat à la Cour | Cabinet HOLLIER-LAROUSSE | 153, boulevard Haussmann | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 154 | Marine | Karsenty-Ricard | Avocat à la Cour | J.P. KARSENTY &amp; ASSOCIÉS | 70, boulevard de Courcelles | PARIS | 75017 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 155 | Anne | Lakas-Josse | Avocat à la Cour | Gatier, Lakas, Josse, Szepan | 12, rue Lincoln | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 156 | Michelle | Lesage-Catel | Avocat à la Cour | LeGrand, Lesage-Catel | 11, bis rue Portalis | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 157 | Yves | Marchell | Avocat à la Cour | Cabinet Marchell | 54 Bd de Latour Maubourg | PARIS | 75007 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 158 | Dominique | Ménard | Avocat à la Cour | Lovells | 8 avenue Kléber | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |
| 162 | Thierry | Mollet-Vieville | Avocat à la Cour | Duclos, Thome, Mollet-Vieville &amp; partners | 164, n° du Faubourg Saint-Honoré | PARIS | 75008 | PARIS | 01 56 24 08 18 | 01 56 24 08 18 |</p>
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| 205 | Mr.                | Ruprecht       | Hermans| Advocat | NaughtvUith                | Postbus 7113           | Princes Irenestraat 59 | 1007 JC | AMSTERDAM | NL      | 31 20 7171 638 | 31 20 7171 335 |
| 213 | Prof.              | William        | Hoyng  | Advocat | Howrey Simon Arnold & White | Rembrandt Tower 31st floor | Amstelplein 1, (P.O.Box | 1098 HA | AMSTERDAM | NL      | +31 20 592 4411 | +31 20 463 7295 |
| 206 | Mr.                | Gertjan        | Kupers | Advocat | De Brauw Blackstone Westbroek | Tripoli-Burgmarenkamp 309 | 1007 JR | AMSTERDAM | NL      | 31 20 577 16 50 | 31 20 577 16 31 |
| 211 | Ms.                | Chantal        | Morel  | Advocat | Koks Morel Vos & Schaap    | Albert Haasplantsoen 23 | 1077 BM Amsterdam | 1070 AZ | AMSTERDAM | NL      | 31 20 577 35 71 | 31 20 577 35 76 |
| 207 | Mr.                | Bert            | Oosting | Advocat | Lovells                     | Frederikplein 42        | 1017 XN | AMSTERDAM | NL      | +31 (0)20 55 33 763 | +31 (0)20 55 33 791 |
| 209 | Mr.                | Sebastian      | Pinckaers | Advocat | Van Doome                  | Graafsesteenweg 121    | P.O.Box 78252 | 1070 AG | AMSTERDAM | NL      | 31 611 358 559 | 31 20 679589 |
| 210 | Mr.                | Bart            | van den Brook | Advocat | Howrey Simon Arnold & White | Rembrandt Tower 31st floor | Amsteplein 1, (P.O.Box | 1096 HA | AMSTERDAM | NL      | +31 (0)20 5924411 | +31 (0)20 4637296 |
| 211 | Mr.                | Dick            | Van Engelen | Advocat | Veritas Advocaten B.V.      | Graafsesteenweg 32B | 2460, Blok D, Postbus 8234 | 3503 RE | UTRECHT | NL      | +31 30 298 24 60 | +31 30 298 24 61 |
| 221 | Mr.                | Orjan           | Grunden | Advokat | Gozzo Advocat              | P.O.Box 35019         | SE- 400 24 | Göteborg | SE      | gozzo@avocat.se | gozzo@avocat.se |
| 222 | Mr.                | Haakan          | Borgerhall | Advokat | RydinCarsten               | Normalsiorg 14         | SE-111 87 | STOCKHOLM | SE      | 0046.8.463 39 00 | 0046.8.611.48.50 |
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<td><a href="mailto:hakan.borgerhall@rydincarsten.se">hakan.borgerhall@rydincarsten.se</a></td>
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<td><a href="mailto:jonas.westerberg@rydincarsten.se">jonas.westerberg@rydincarsten.se</a></td>
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<td>Burdon</td>
<td>Olswang</td>
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<td>13</td>
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<td>Chandler</td>
<td>Pinsent Curtis Bridle</td>
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**United States**

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<td>Mr.</td>
<td>Mark</td>
<td>Shilito</td>
<td>Exchange House, 5 Appold St, LONDON, EC2A 2HA</td>
<td>00 44 020 737 8000</td>
<td>00 44 020 737 8066</td>
</tr>
<tr>
<td>265</td>
<td>Mr.</td>
<td>Ian</td>
<td>Starr</td>
<td>Broadwalk House, 5 Appold St, LONDON, EC2A 2HA</td>
<td>00 44 207 374 6000</td>
<td>00 44 207 374 0666</td>
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<td>266</td>
<td>Mr.</td>
<td>Paul</td>
<td>Stevens</td>
<td>90 High Holborn, WC1V 6XX, LONDON, WC1V 6XX</td>
<td>00 44 207 067 3308</td>
<td>00 44 207 067 3999</td>
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<td>Andrew</td>
<td>Waugh</td>
<td>Lincoln Inn, LONDON, WC1V 6XX</td>
<td>00 44 207 405 1111</td>
<td>00 44 207 405 7800</td>
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<td>Richard</td>
<td>Willoughby</td>
<td>Citypoint, One Ropemaker Street, ECZY 9HS, London, ECZY 9HS</td>
<td>00 44 (0)20 7065 6652</td>
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<td>Mr.</td>
<td>Ian</td>
<td>Wood</td>
<td>11 Pigm Street, ECAV 6RW, LONDON, ECAY 6RW</td>
<td>00 44 20 7782 88 97</td>
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Mr. Fernand de Visscher
Secretary to EPLAW
c/o Simont Braun
Avenue Louise, 149 (bte 20)
B – 1050 Brussels

Tel. + 32 2 533 17 18
Fax + 32 2 543 70 90
E-mail: fernand.devischer@simontbraun.be

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