

BASICS OF THE PROCEDURE BEFORE THE UPC

COMPETENCE, WRITTEN PROCEDURE,
BIFURCATION

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Main types of actions

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Infringement action	A32.1(a), R12-42
Revocation action	A32.1(d), R43-58
Action for a declaration of non-infringement	A32.1(b), R60-69
Action for provisional measures	A32.1(c), R205-213
Action for compensation for licences	A32.1(h), R80
Action against decisions of the EPO	A32.1(i), R85-96

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Competence of the divisions of the Court

Infringement actions and actions for provisional measures (A33.1)

Infringement actions and actions for **provisional measures**:

- (a) local or regional division where the actual or threatened infringement has occurred or may occur, or
- (b) local or regional division where the defendant has its residence or principal place of business, or in the absence of residence or principal place of business, its place of business

Residence or place of business outside the territory of the CMS

- local or regional division in accordance with (a) or central division

No local or regional division available in the CMS concerned

- central division

Revocation action pending before the central division

- infringement action may be brought before any division in accordance with the above or before the central division (A33.5, R70)

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3

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Competence of the divisions of the Court

Actions for decl. of non-infringement and revocation actions (A33.4)

Actions for **declaration of non-infringement** and **revocation** actions

- central division

Infringement action pending before a local or a regional division

- same local or regional division

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4

Competence of the divisions of the Court

Agreement of the parties (A33.7)

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Parties may agree to bring actions referred to in A.32.1 (a) to (h) before the **division of their choice**, including the central division

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5

Exchange of written pleadings

Infringement action

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	Main claim	Counterclaim	Application to amend the patent	
Plaintiff	Statement of claim			R12, 13
Defendant	Statement of defence (3 months)	Counterclaim for revocation (3 months)		R12, 23, 24, 25
Plaintiff	Reply to the Statement of defence (optionally) (1 month/2 months)	Defence to the Counterclaim for revocation (2 months)	Application to amend the patent (2 months)	R12, 29, 30
Defendant	Rejoinder to the Reply to the Statement of defence (1 month)	Reply to the Defence to the Counterclaim (1 month)	Defence to the Application to amend the patent (1 month)	R12, 29, 32, 51
Plaintiff		Rejoinder to the Reply to the Defence to the Counterclaim (1 month)	Reply to the Defence to the Application to amend the patent (1 month)	R12, 32, 52
Defendant			Rejoinder to such Reply (1 month)	R12, 32
The JR may allow the exchange of further written pleadings				R36

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6

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Contents of the Statement of claim (R13)

The Statement of claim shall contain :

- Names of the parties and of the plaintiff's representative
- Postal and electronic addresses for service
- Evidence to show the plaintiff is entitled to commence proceedings (where applicable)
- Details of the patent concerned
- Information about any prior or pending proceedings (where applicable)
- Indication of the competent division with an explanation of why that division has competence
- Indication that the case shall be heard by a single judge (where applicable)
- Nature of the claim, order or remedy sought

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Contents of the Statement of claim (R13)

- Indication of the facts relied on (in particular one or more instances of alleged infringements)
- Evidence relied on (where applicable) and an indication of any further evidence which will be offered in support
- Reasons why the facts relied on constitute infringements
- Indication of any order the plaintiff will seek during the interim procedure
- Indication of the value of the infringement action (where the plaintiff assesses that it exceeds a certain amount)

(final value of the action will be determined by the JR during the interim procedure; a value-based fee for the infringement action may apply on that basis on top of the fixed fee)

- List of the documents referred to

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Language of the Statement of claim (R14)

(a) One of the languages of the local division or regional division

- which the plaintiff has chosen or
- which the parties have agreed to bring the action before

(b) Language in which the patent was granted

- where the central division shall hear the case or
- where a Request to use the language in which the patent was granted as language of the proceedings is lodged together with the Statement of claim

(c) Official language of the EPO designated by a CMS as the language of proceedings of its local or regional division (?)

Possibility to switch to the language in which the patent was granted:

- application by both parties (A.49.3, R321)
- proposal from the JR (A.49.4, R322)
- application by one party (A.49.5, R323)

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Lodging of documents (R4)

« Written pleadings and other documents shall be lodged at the Registry in electronic form. Parties shall make use of the official forms available on-line. »

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Examination as to formal requirements (R16)

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- Patent subject to an **opt-out** ?
 - In the event of an opt-out the Registry shall as soon as practicable inform the plaintiff who shall withdraw or amend the Statement of claim as appropriate
- **Contents** of the Statement of claim (R13(a) to (j)) ?
- **Language** (R14) ?
- Payment of the fixed **fee** for the infringement action (R15) ?
 - Possibility to correct the deficiencies within 14 days
Otherwise: action may be rejected as inadmissible by a decision by default

Recording of the file and designation of the judge-rapporteur (R17-18)

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- Date of receipt recorded
(action shall be regarded as pending before the CFI as from this date)
- Case number attributed to the file
- File recorded in the register
- Plaintiff informed of the case number and date of receipt
- Case assigned to a panel
- Designation of one legal judge as JR (may be the PJ himself)
- (Service on the defendant)

Service of Statement of claim within the CMS
or by agreement (R270-272)

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- (a) Service at the **electronic address** which the defendant has provided for the purpose of service in the proceedings (may be the address of a representative)
- (b) Where no electronic address has been provided but the defendant has an address for service within the territory of any of the CMS:
- **registered letter** with advice of delivery
 - **fax** or
 - any **alternative method** authorised by the Court (where it appears to the Court that there is a “good reason” to do so)

at the following place:

- **legal person**: statutory seat, central administration or (principal) place of business
- **individual**: by leaving it with him or at his usual or last known address

Service of Statement of claim within the CMS
or by agreement (R270-272)

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A Statement of claim served in accordance with R271 is deemed to be served on the defendant:

- (a) where service takes place by means of **electronic communication** or by **fax**: on the day where the relevant electronic message was sent or the transmission of the fax was completed (GMT + 1)
- (b) where service takes place by **registered letter** with advice of delivery: 10 working days after posting, leaving with, delivering to or collection by the relevant service provider

Service of Statement of claim outside the CMS and in the absence of agreement (R273-274)

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- (a) Any method provided by:
- Regulation (EC) No 1393/2007 (EU except DK)
 - International conventions (eg. The Hague Convention)
 - Service through diplomatic or consular channels
- (b) Any method permitted by the law of the state where service is to be effected

Service of other documents

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Any **order or decision** of the Court shall be served on each of the parties in accordance with R270-274, as the case may be (R276)

As soon as practicable after **written pleadings** have been received at the Registry, the Registry shall serve the pleadings on the other party by means of electronic communication (or, alternatively, by registered letter, fax or any method authorised by the Court) (R278)

Preliminary objection (R19-21)

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

- the jurisdiction and competence of the Court
- the competence of the division indicated by the plaintiff
- the language of the Statement of claim

Within 14 days of service of notification of the Preliminary objection, the **plaintiff** may:

- correct any deficiency
- submit written comments

Decision by the JR as soon as practicable after the expiry of the 14 days

Appeal possible before the CA:

- with the permission of the JR or with the permission of the CA:
- shall be dealt with as an urgent matter by the CA
- first instance proceedings may be stayed

Statement of defence (R23-24)

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- Within 3 months of service of the Statement of claim (R23)
- Contents (R24)
- May contain a counterclaim for revocation – contents (R25)
- Fee for the counterclaim for revocation (R26)
(value-based fee may also apply – R31)
- Examination formal requirements (R27)
 - contents and fee (if applicable)
 - 14 days to correct the deficiencies or decision by default may be given
- Further schedule set by the JR (interim conference, oral hearing) (R28)

Allocation of a technically qualified judge (R33-34)

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On the request of a party:

- Application for allocating a TQJ with indication of the relevant field of technology
- as early as possible in the written procedure

(application lodged after the closure of the written procedure shall only be granted if justified in view of changed circumstances)

- If requirements have been complied with, a TQJ shall be allocated after consultation of the JR

(The drafting committee is of the view that the allocation of a TQJ should be discretionary; this would require an amendment to A8.5)

On the request of the JR:

- Request for allocating a TQJ
- at any time during the written procedure, after consulting the PJ and the parties

Last steps in the written procedure (R35-36)

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Following the exchange of written pleadings, the JR shall

- inform the parties of the date on which he intends to close the written procedure
- confirm the date and the time set for the interim conference (or inform the parties that an interim conference will not be held)

On a reasoned request by a party lodged before the date on which the JR intends to close the written procedure, the JR may allow the exchange of further written pleadings, within a period to be specified

Bifurcation decision (A33.3 and R37)

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If a counterclaim for revocation is brought in the case of an action for infringement, the local or regional division concerned shall, after having heard the parties, have the discretion either to:

- (a) proceed with both the action for infringement and with the counterclaim for revocation and request the President of the CFI to allocate a TQJ with qualifications and experience in the field of technology concerned
- (b) refer the counterclaim for revocation for decision to the central division and suspend or proceed with the action for infringement; or

(where there is a high likelihood that the relevant claims of the patent will be held to be invalid in the revocation procedure, the panel shall stay the infringement proceedings)

- (c) with the agreement of the parties, refer the case for decision to the central division

Counterclaim for revocation referred to the central division under (b) (R38-40)

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- Counterclaim for revocation assigned to a **panel of the central division** (in accordance with annex II)
- Designation of one legally qualified judge as **JR**
- **Further schedule** set by the JR after consulting the parties (interim conference, oral hearing)
- If applicable : JR may order that the parties lodge, within a period of 21 days, a **translation** of documents in the language in which the patent was granted
- **Accelerated proceedings** where:
 - an Application for provisional measures has been lodged, and/or
 - the regional or local division has referred the counterclaim for revocation to the central division

Case referred to the central division under (c) (R41)

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- Case assigned to a **panel of the central division** (in accordance with annex II)
- Designation of one judge as **JR**
- **Further schedule** confirmed (interim conference, oral hearing)
- If applicable : JR may order that the parties lodge a **translation** of documents in the language in which the patent was granted

Exchange of written pleadings

Revocation action

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	Main claim	Counterclaim	Application to amend the patent	
Plaintiff	Statement for revocation			R44, 45
Defendant	Defence to revocation (3 months)	Counterclaim for infringement (3 months)	Application to amend the patent (3 months)	R44, 49
Plaintiff	Reply to the Defence to revocation (1 month)	Defence to the Counterclaim for infringement (1 months)	Defence to the Application to amend the patent (1 month)	R44, 51, 56
Defendant	Rejoinder to the Reply (1 month)	Reply to the Defence to the Counterclaim (1 month)	Reply to the Defence to the Application to amend the patent (1 month)	R44, 52, 56
Plaintiff		Rejoinder to the Reply (1 month)	Rejoinder to such Reply (1 month)	R44, 56
The JR may allow the exchange of further written pleadings				R36 <i>mutatis mutandis</i>

Statement for revocation (R45-48)

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- Contents (R45)
- Language in which the patent was granted (unless parties have agreed to bring the action before a local or a regional division) (R46)
- Fee for the revocation action (R47)
- Examination of formal requirements (R16 *mutatis mutandis*)
- Date of receipt recorded and case number attributed (R48)
- File recorded in the register (R48)
- Plaintiff informed of the case number and date of receipt (R48)
- Case assigned to a panel (R48)
- Designation of the JR (R18 *mutatis mutandis*)
- Preliminary objection (R19-21 *mutatis mutandis*)

Defense to revocation (R49-53)

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- Within 3 months (R49)
- May include (R49):
 - an application to amend the patent
 - a counterclaim for infringement
- Contents (R50)
- Fee for the counterclaim for infringement (R53)
- Examination of the formal requirements (R27 *mutatis mutandis*)
- Further schedule (interim conference, oral hearing) (R28 *mutatis mutandis*)

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Application of R33-36 mutatis mutandis

- Allocation of a TQJ (R33-34 *mutatis mutandis*)
- Closure of the written procedure (R35 *mutatis mutandis*)

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Exchange of written pleadings

Action for a declaration of non-infringement

	Main claim	Counterclaim	
Plaintiff	Statement for a declaration of non-infringement		R61, 62
Defendant	Defence to the Statement for a declaration of non-infringement (2 months)	Counterclaim for infringement (3 months)	R61, 65, 66
Plaintiff	Reply to the Defence to the Statement for a declaration of non-infringement (optional) (1 month)	Defence to the Counterclaim for infringement (1 months)	R61, 67
Defendant	Rejoinder to the Reply (1 month)		R61, 67
The JR may allow the exchange of further written pleadings			R61.4

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Statement for a declaration of non-infringement (R62)

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- Patent proprietor or licensee has asserted that a specific act is an infringement or has refused or failed to give a written acknowledgement to the effect of the declaration claimed (R60)
- Contents (R62)
- Language in which the patent was granted (unless parties have agreed to bring the action before a local or a regional division) (R46 *mutatis mutandis*)
- Fee for the action for a declaration of non-infringement (R68)
- Examination of formal requirements (R16 *mutatis mutandis*)
- Date of receipt recorded and case number attributed (R48 *mutatis mutandis*)
- File recorded in the register (R48 *mutatis mutandis*)
- Plaintiff informed of the case number and date of receipt (R48 *mutatis mutandis*)
- Case assigned to a panel (R48 *mutatis mutandis*)
- Designation of the JR (R18 *mutatis mutandis*)
- Preliminary objection (R19-21 *mutatis mutandis*)

Defense to the Statement for a declaration of non-infringement (R65-69)

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- Within 2 months (R65)
- May include a counterclaim for infringement (R61.2)
- Contents (R66)
- Examination of the formal requirements (R27 *mutatis mutandis*)
- Further schedule (interim conference, oral hearing) (R28 *mutatis mutandis*)

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Application of R33-36 mutatis mutandis

- Allocation of a TQJ (R33-34 *mutatis mutandis*)
- Closure of the written procedure (R35 *mutatis mutandis*)

Philippe Campolini April 22, 2013 31

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Thank you!

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