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EPLC – Discussion in  
Venice

17<sup>th</sup> Draft Rule 286

28 November 2014  
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What is the EPLC?

**European Patent Litigation Certificate**

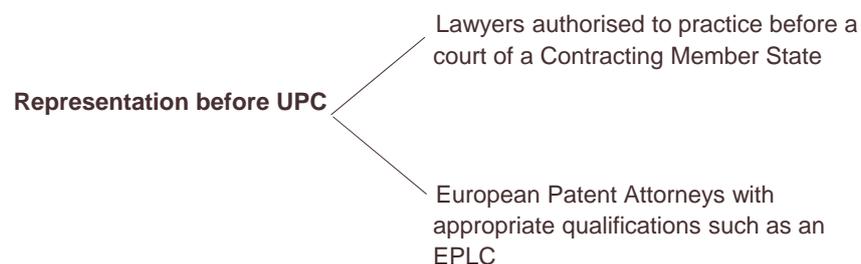
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## Article 48 of the Agreement on a Unified Patent Court provides:

- (1) Parties shall be represented by **lawyers** authorised to practice before a court of a Contracting Member State.
- (2) Parties may alternatively be represented by **European Patent Attorneys** who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who have appropriate qualifications such as a **European Patent Litigation Certificate**.
- (3) The requirements for qualifications pursuant to paragraph 2 shall be established by the Administrative Committee. A list of European Patent Attorneys entitled to represent parties before the Court shall be kept by the Registrar.
- (4) Representatives of the parties may be assisted by patent attorneys, who shall be allowed to speak at hearings of the Court in accordance with the Rules of Procedure.

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## Representation before the UPC



### **NOBODY ELSE**

(no litigants in person – but now 17<sup>th</sup> draft Rule 286?)

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## Rule 286?

1. A representative pursuant to Article 48(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practice before a court of an EU Member State. A lawyer within the meaning of Article 48(1) of the Agreement is a person who is authorised to pursue professional activities under a title referred to in Article 1 of Directive 98/5/EC and by way of exception a person with equivalent legal professional qualifications who, owing to national rules, is permitted to practice in patent infringement and invalidity litigation but not under such title. In subsequent actions the representative may refer to the certificate previously lodged.

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## Article 1 of EC Directive 98/5 EC

### Object, scope and definitions

1. The purpose of this Directive is to facilitate practice of the profession of lawyer on a permanent basis in a self-employed or salaried capacity in a Member State other than that in which the professional qualification was obtained.
2. For the purposes of this directive:
  - a) 'lawyer' means any person who is **a national of a Member State** and who is authorised to pursue his professional activities under one of the following professional titles:

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## Rule 286?

1. A representative pursuant to Article 48(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practice before a court of an EU Member State. A lawyer within the meaning of Article 48(1) of the Agreement is a person who is **a national of a member state** authorised to pursue professional activities under a title referred to in Article 1 of Directive 98/5/EC and by way of exception a person with equivalent legal professional qualifications who, owing to national rules, is permitted to practice in patent infringement and invalidity litigation but not under such title. In subsequent actions the representative may refer to the certificate previously lodged.

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## Progress on EPLC

- The UPC Preparatory Committee has published draft Rules on the EPLC (latest version 13 June 2014 – <http://www.unified-patent-court.org/images/documents/draft-eplc-consultation.pdf> and explanatory memo <http://www.unified-patent-court.org/images/documents/draft-eplc-consultation-memorandum.pdf>)
- Many bodies representing Lawyers and European Patent Attorneys have commented (EPLAW, IPLA, CCBE, DAV, CIPA, EPLIT etc.)
- What are they saying?

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## Everyone Says:

- UPC needs experienced professional representation for:
  - Putting the new procedure into practice
  - Establishing correct precedents (both procedural and legal)
  - Developing a code of professional practice and courtesy towards the UPC and opponents
- Many, quite possibly a majority, of the UPC Judges will be inexperienced in patent cases.
- They will need a clear presentation of the case and all the legal and procedural help they can be given by the representatives.

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## The Lawyers say:

- Under new UPC regime, new case law will need to be established to harmonise national application of both patent and procedural law.
- Developing new case law requires innovative approaches and detailed knowledge of legal issues – it is thus essential for representatives in the UPC to be of the highest quality and well experienced in patent cases.
- Damage done to the UPC at the start by the admittance of under qualified representatives cannot be easily repaired.
- There are enough experienced patent litigation lawyers around Europe (Rule 286!) to provide clients with choice and provide healthy competition.
- It is about ensuring equivalence of qualifications to achieve a well balanced system of representation – it should not be about discrimination and setting different levels for lawyers and patent attorneys.

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### The Patent Attorneys say:

- A higher standard is required of patent attorneys than that of lawyers and this will result in discrimination.
- Important that there is a wide pool of suitably qualified representatives.
- Being prevented from representation in the UPC destroys continuity of representation after the patent prosecution phase.
- The current “grandfathering in” proposal admits all German and many UK and French patent attorneys but few others (a function of the particular courses said to be equivalent to EPLC) – this is unfair, should grandfather in all patent attorneys

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### The Patent Attorneys say in relation to courses:

- Many of the course contents specified in EPLC rule 3 are covered by patent attorney qualifications and would only duplicate knowledge.
- Unfair to confine the EPLC course providers to universities and non-profit organisations – law schools are often private institutions.
- 120 hours for an EPLC course is very long when candidates have already undertaken a lot of training in the course of becoming a patent attorney.
- Litigation skills are important and thus any certificate should be based more on practical experience than academic study.

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## The Judges have already said:

"We, the European Patent Judges named below, approve the attached principles for the Rules of Procedure of the European Patent Court".

### 5. European Patent Counsel

Article 34\* of the draft Statute of the European Court provides that the Registrar of the European Patent Court should maintain a register of European Patent Counsel. **We believe that persons qualified to be registered should be attorneys at law who are fully entitled to represent parties in ordinary civil proceedings in the courts of first instance of the convention states.**

Second Venice Resolution  
San Servolo, 4 November 2006

\*Article 34 eventually became Article 48.

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## Conclusion

- Judges, lawyers and patent attorneys must pull in the same direction to ensure representation before the UPC is experienced and of high calibre.
- Start of the UPC will be gradual so no need for grandfathered admittance to representatives at all.
- The bar for the EPLC should be raised substantially and there is still time to do it. In return lawyers might offer to be subject to an assessment of their actual experience in patent litigation before they are allowed to represent in the UPC. [Article 48 would need some clarification or even revision.]
- EPLAW admits only lawyers of proven patent litigation experience and will discuss internally and with CCBE how to establish a self-certification system - perhaps an acceptable compromise to achieve parity of representation between lawyers (holding EPLAW certification) and patent attorneys (as EPAs with EPLC).

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## The Take Home Message to The Judges

**The UPC will not start up and work well if it has many inexperienced Judges combined with inexperienced representatives.**

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## An analogy: The UK PCC (now IPEC)

At first PCC was a failure – why?

- Inexperienced Judge (Ford) coming from EPO
- Parties with uneven quality of Representatives
  - Some excellent (lawyers and patent attorneys)
  - Some complete beginners (mostly patent attorneys) “having a go”.
  - Litigants in person
- Result: poor case management, many bad decisions and judgments which were almost all overturned on appeal

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## An analogy - The UK PCC (now IPEC)

Now IPEC is a success – why?

- Experienced judges (Fysh, Birss, Hacon)
- Parties now largely represented by lawyers and patent attorneys who know what they are doing
- Result: a trusted and popular Court with plenty of business

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## Judges' Reaction in Venice

My closing submissions:

- Learning from the UK PCC/IPEC analogy, please let us have no “blind leading the partially sighted” in the crucial early days of the UPC.
- Is it time for another Judges Resolution on UPC Representation?
- The Preparatory/Administrative Committee might just listen to that!

Judges' reaction:

- Nothing formal – certainly no resolution – politically too difficult
- BUT understood that the IPJA (Intellectual Property Judges Association) has or will write to the Preparatory Committee expressing concern about current EPLC proposal.

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## What Next

We must all keep up the pressure to improve the position of experienced European patent lawyers and EPLAW members under the EPLC proposals and under Rule 286 – it is not too late but soon could be.

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