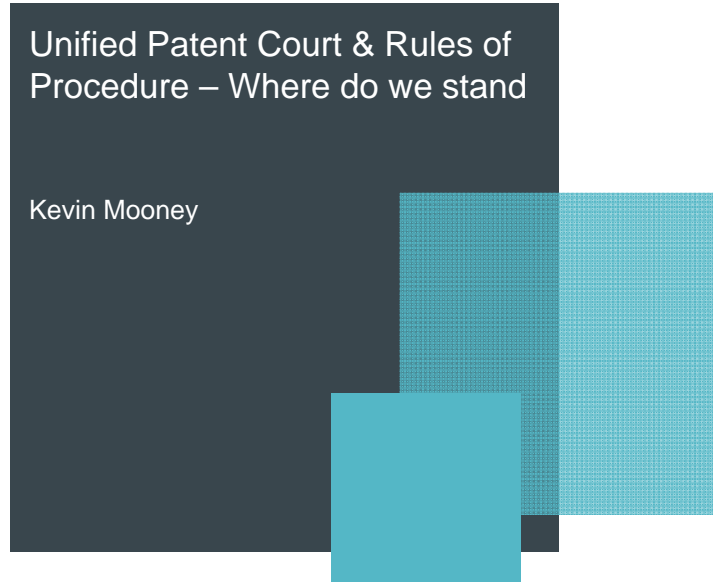


Unified Patent Court & Rules of Procedure – Where do we stand

Kevin Mooney



Unified Patent Court & Rules of Procedure – where do we stand

The Court Rules – State of Play

- 15th Draft submitted for public consultation in June 2013
- Consultation ended 30th September 2013
- 16th draft submitted at end January 2014 and now published on Preparatory Committee website with Digest.
- Berlin 24 & 25 September - Legal Working Group under Johannes Karcher met to consider a new draft with Drafting Committee
- 17th draft for public consultation published on 3rd November with further Digest
- Public consultation in Trier on 26th November

Unified Patent Court & Rules of Procedure – where do we stand

The Court Rules – State of Play

- 26th November – Trier consultation focuses on following:
 - Rule 5 – the opt-out provisions - need for a sunrise provision
 - Rule 14.2 – choice of language of proceedings
 - Rule 118 and 211 – grant of injunctions – how discretionary
 - Rule 220 – procedural appeals
 - Rule 262 – public access to the Register
 - Rule 286 - representation
 - Rule 287 – extent of privilege
 - Rule 85 – appeals from decisions of EPO
 - Rules 170 et seq – evidence
 - Rules 242 et seq – appeals generally
- Further meeting(s) of Legal Working Group and Drafting Committee to finalise rules - 2015

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Unified Patent Court & Rules of Procedure – where do we stand

Choice of Divisions and Language(s): The current position

Local divisions (language(s)):

- Italy (Italian), England and Wales (English), The Netherlands (Dutch and English), France (French), German x 4 (German and English), Belgium (Dutch, French, German and English), Finland (Finnish, Swedish and English), Denmark (Danish and English), Ireland (English)

Suspected Regional Divisions (languages(s)):

- Romania, Bulgaria, Cyprus and Greece (all official languages plus French and English)
- Sweden, Estonia, Latvia and Lithuania (English only)
- Czech Republic and Slovakia (official languages plus English)

No participation in either a local or regional division:

- Malta and Luxembourg – results in donation of jurisdiction to the Central Division (language of grant)

Undecided:

- Poland (has not yet signed Agreement), Portugal, Austria and Scotland (possible local division - English), Slovenia, Hungary.

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Unified Patent Court & Rules of Procedure – where do we stand

Court fees and recoverable costs

- Draft proposal dated January 2014
 - Fixed fees for initiating actions/appeals (to be decided)
 - Additional value-based fee if value of action exceeds €500,000
 - Fixed fees for other procedures eg application to opt-out, saisie, protective letter etc
- Value-based fees on a sliding scale from €500,000 to €30 million
- Alternative proposals for a cap on recoverable costs (for representation)
 - A sliding scale from €500,000 to €30 million value of action = €12,000 to €110,000 max OR
 - A sliding scale from €500,000 to €4 million+ value of action = €200,000 to €1 million
- New draft proposal on costs and cap due after the February 2015 meeting of the Preparatory Committee

Unified Patent Court & Rules of Procedure – where do we stand

Proposed European Patent Litigation Certificate for patent attorneys

- First draft proposal published in June 2014
- First proposal was quite “light”
 - New EPLC course of 120 hours minimum duration OR
 - “Other appropriate qualification”
 - EPA plus bachelors or masters degree in law or
 - EPA plus CEIPI, Hagen, Nottingham Queen Mary, Brumel or Bournemouth certificate or
 - Sole representation in three infringement actions
- Public consultation July 2014 – 80 responses
- Revised draft after February meeting of the Preparatory Committee

Unified Patent Court & Rules of Procedure – where do we stand

Training of Judges

- 1300 “Expressions of interest”
 - Legal 360 (124 “outstanding”)
 - Technical 616 (300 “outstanding”)
- Training centre opened in Budapest 13th March 2014
- Academy of EPO will organise technical legal training to commence for less experienced judges in January 2015
- Proposed that 80 legal judges and 40 technical judges will be trained in 2015
- Formal application process now being prepared

Unified Patent Court & Rules of Procedure – where do we stand

IT System

- Prototype filing and case management system workshops held in London, Paris and Munich (November 27th)
- Prototype is based on Rules 1 to 24
- As of November 1st 1200 users have tested the prototype from 50 countries: to test go to <http://prototype.unified-patent-court.org> – configuration will end on 30 November
- December 2014 to June 2015 – Procurement
- July-December 2015 – testing
- December 2015 – completion

Unified Patent Court & Rules of Procedure – where do we stand

When will it all happen?

- Art. 89 of Agreement
 - 1st January 2014 or
 - 4 months after deposit of the 13th instrument of ratification (including Fr, Ger, UK – Austria, France, Denmark, Belgium and Malta have ratified) or
 - Entry into force of amended Regulation 1215/2012 (the Brussels Regulation)
- “End of 2015 at the earliest” says Preparatory Committee on 18th March 2014
- BUT possible provisional effect pursuant to Art. 25 Vienna Convention or international customary law

Unified Patent Court & Rules of Procedure – where do we stand

Article 83 Agreement – Issues

- Background
 - Article 32 – “exclusive competence”
EXCEPT
 - Article 83(1) – Transitional period of 7 years for national actions “for an action for infringement or for declaration of invalidity”
 - Article 83(3) – Opt-out
- Purist Theory but
- Amendments to Brussels Regulation
 - Recital (5)
 - New Article 71c (applying Articles 29-32 but also Article 35?)

Unified Patent Court & Rules of Procedure – where do we stand

Article 83 Agreement – Issues

- What national “actions” are permitted pursuant to Art 83(1) – declarations of non-infringement? Professor Ohly agrees Art 83(1) is sloppy drafting
- What is the effect of Art 83(1) “actions”?

Will any action in any national court in respect of a non-opted out EP oust the UPC jurisdiction – in all countries? (the “purist approach”)

- irrespective of the parties?
- irrespective of whether concluded or not?
- even if commenced before Agreement comes into effect?
- even if the action is for provisional measures

Professor Tilmann suggests the blocking effect applies only to the territory of the national court in question and only to the particular action between same parties (see Article 29 Brussels Regulation)

- Professor Ohly agrees!

Unified Patent Court & Rules of Procedure – where do we stand

- What is the meaning of opting out from the “exclusive competence” of the UPC pursuant to Art 83(3)? Does this leave a non-exclusive competence? Professors Tilmann and Ohly disagree.
- If a party attempts a parallel UPC action (eg central revocation in response to a national action for infringement), which court will decide the jurisdiction issue – a national court with possible reference to CJEU under Brussels Regulation or UPC?
- Is Article 83 limited to the transitional period for opt-outs or is an opt-out effective for the life of the patent for all designations and SPCs unless withdrawn (the “purist approach”). All seem to agree that the purist approach is correct.
- Does Article 35 of Brussels Regulation (“provisional measures”) continue to apply even if action is commenced in UPC. In principle this applies if UPC is a court of a Contracting Member State for all purposes of the Regulation.

Unified Patent Court & Rules of Procedure – where do we stand

Article 83 Agreement - Issues

- If a national infringement action is commenced pursuant to Art 83(1) or after an opt-out what law is applied by the national court – national law (Interpretive Note of the Preparatory Committee) or Articles 25 to 29 of UPCA? – Professor Ohly says national law. Professor Tilmann disagrees.

Divisional Patents

- Is an opt-out for a mother patent automatically an opt-out for all divisionals? Professor Tilmann says “sometimes” – ie divisionals applied for after an application has been opted out. Majority of the Drafting Committee disagree.

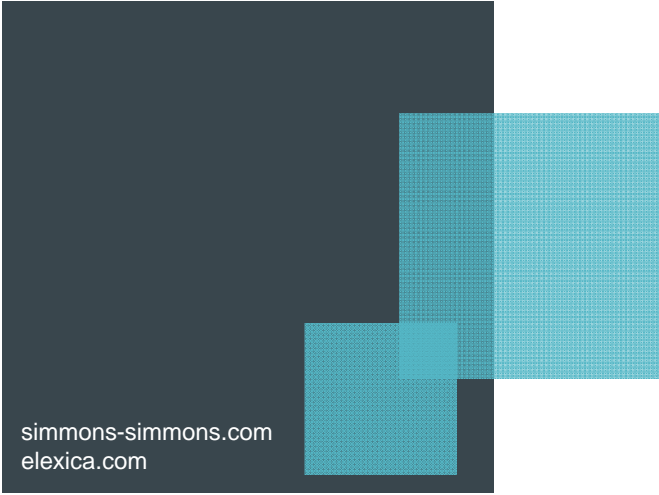
How do we sort all these questions out?

- Further Interpretive Notes OR
- Article 31 of Vienna Convention?

Unified Patent Court & Rules of Procedure – where do we stand

Post-Grant Amendment & UPC proceedings

- Samsung v Apple in UK
 - Central amendment at EPO pursuant Art. 105a EPC following judgment at first instance – not an abuse!
- Rule 30.2 – amendment to be offered with the Defence to Counterclaim and any subsequent amendment only with the permission of the Court
- Oppositions?
 - Rule 118 – a stay of judgement only if a decision of EPO “may be expected to be given rapidly”



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