

Basics of the Procedure Before the Unified Patent Court (UPC)

Part I – Introduction and Basics

19. April 2013

HENGELERMUELLER

Agenda

Introduction and Basics	Benedikt Migdal, Hengeler Mueller, DE
Starting a Claim	Philippe Compolini, Simont Braun, BE
Running and Ending a Claim	Ben Hall, Simmons & Simmons, UK
Strategy	Annsley Ward, Allen & Overy, UK

2

HENGELERMUELLER

Goals and Guiding Principles of the UPC

„AGREEMENT ON A UNIFIED PATENT COURT

THE CONTRACTING MEMBER STATES, (...)

WISHING to improve the enforcement of patents and the defence against unfounded claims and patents which should be revoked and to enhance legal certainty by setting up a Unified Patent Court for litigation relating to the infringement and validity of patents;

CONSIDERING that the Unified Patent Court should be devised to ensure expeditious and high quality decisions, striking a fair balance between the interests of right holders and other parties and taking into account the need for proportionality and flexibility;

CONSIDERING that the Unified Patent Court should be a court common to the Contracting Member States and thus part of their judicial system, with exclusive competence in respect of European patents with unitary effect and European patents granted under the provisions of the EPC; (...)

HAVE AGREED AS FOLLOWS: (...)

3

HENGELERMUELLER

Sources of Law for the UPC

- Union Law
- Agreement on a Unified Patent Court (UPCA)
- Rules of Procedure of the Unified Patent Court (RoP)
 - Currently: 14th draft of a „Preliminary Set of Provisions for the Rules of Procedure of the Unified Patent Court“ (PRoP)
- European Patent Convention (EPC)
 - In particular: Grounds for Revocation
- International Agreements binding all Contracting Member States (CMS)
- National Law
 - The UPCA will become national law in each CMS upon ratification
 - „Genuine“ national law applicable, e.g., with respect to ownership, licenses etc.

4

HENGELERMUELLER

Exclusive Competence of the UPC

- **What type of Patents?** (Art. 3 UPCA)
 - European patents with unitary effect
 - European patents in effect on or granted after the date on which the UPCA enters into force*
 - European patent applications pending or filed after the date on which the UPCA enters into force*
 - SPCs issued for a product protected by a relevant patent*
- **What issues?** (Art. 32 UPCA)
 - Infringement and validity
 - Actions for compensation for licenses, Art. 8 (EU) 1257/2012
 - Actions concerning decisions of the EPO pertaining to Art. 9 (EU) 1257/2012
 - Not: Transfer of title, licenses (unless in defense to an infringement action)

5

HENGELERMUELLER

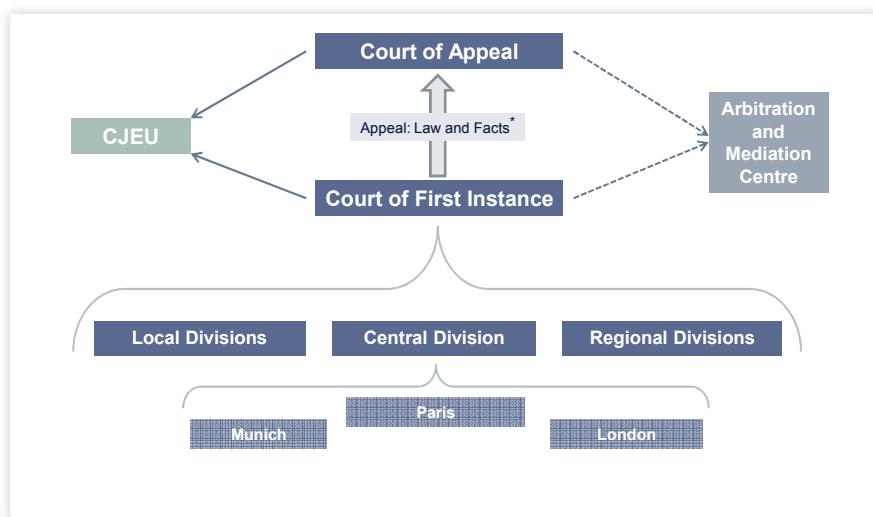
Transitional Regime – Art. 83 UPCA

- Option to “**opt-out from the exclusive competence**” of the UPC during a transitional period of seven* years for
 - EPs granted or applied for within the transitional period
 - SPCs granted for a product protected by an EP
- Option to opt-out is lost once an action has been brought before the UPC
- Opt-out requires notification of the Registry no later than one month before the expiry of the transitional period and takes effect upon its entry into the register.
- Option to “**opt back in**” at any time
- Option to opt-in is lost once an action has been brought before a national court
- Opt-in requires notification of the Registry and takes effect upon its entry into the register

6

HENGELERMUELLER

Court Structure



7

HENGELERMUELLER

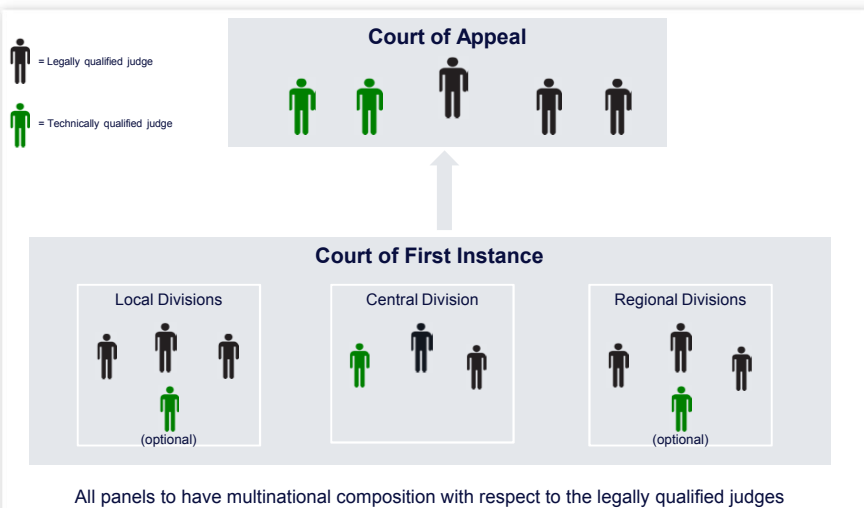
Competence of the Divisions (General Principles)

Local and Regional Divisions	Central Division
<p>What actions?</p> <ul style="list-style-type: none"> • Infringement, incl. related defenses and counterclaims for revocation • Provisional and protective measures and injunctions • Compensation based on published EP applications • Actions relating to the prior use of an invention • Compensation of licenses on the basis of Art. 8 Reg (EU) 1257/2012 <p>Which Division?</p> <ul style="list-style-type: none"> • CMS where infringement occurred, or • CMS where the defendant has its residence or (principal) place of business 	<p>What actions?</p> <ul style="list-style-type: none"> • (Stand-alone) Actions for revocation • Actions for declaration of non-infringement • Actions concerning certain decisions of the EPO • Infringement actions if there is no competent Local or Regional Division or, under certain conditions, if agreed by the parties <p>Which Section?</p> <ul style="list-style-type: none"> • Paris: IPC sections B, D, E, G, H • London: IPC sections A and C • Munich: IPC section F

8

HENGELERMUELLER

Composition of the Courts' Panels



9

HENGELERMUELLER

General Structure of Proceedings (1)

- Proceedings before the UPC generally consist of three distinct, consecutive stages:
 - Written Procedure: exchange of written pleadings
 - Interim Procedure: preparation of the oral hearing
 - Oral Procedure: oral hearing and decision on the merits
- The PRoP follow this threefold structure and set out distinct rules for each stage
- Emphasis on the Written Procedure
- Relatively short oral hearing
- Interim Procedure as a genuinely new tool to ensure efficiency
- The goal is to complete (first instance) proceedings within one year

10

HENGELERMUELLER

General Structure of Proceedings (2)

- **Written Procedure (Rules 12-96 PRoP)**
 - Managed by the judge-rapporteur
 - Generally two written statements per party: SoC, SoD, Reply, Rejoinder
 - Envisaged time-frame: approx. 7 months
- **Interim Procedure (Rules 101-110 PRoP)**
 - Managed by the judge-rapporteur
 - Purpose: preparation of the oral hearing (R 103 PRoP)
 - Optional interim conference (R 104 PRoP)
 - Judge-rapporteur has a wide range competences
 - Key principles: efficiency and flexibility
 - Envisaged time-frame: 3 months

11

HENGELERMUELLER

General Structure of Proceedings (3)

- **Oral Procedure (Rules 111-118 PRoP)**
 - Managed by the presiding judge
 - The oral hearing should be completed within one day and consists of
 - hearing of the parties' oral submissions
 - hearing of witnesses and experts (if ordered during the interim procedure)
 - In advance of the hearing, the presiding judge may set time limits for the submissions
 - During the hearing, the presiding judge may limit a party's oral submission if the panel is sufficiently informed
 - The hearing of witnesses and experts is „under the control of the presiding judge“
 - Testimony is limited to issues identified by the judge-rapporteur or presiding judge
 - Decision on the merits “as soon as possible” after the closure of the oral hearing; envisaged time-frame: 6 weeks

12

HENGELERMUELLER

Thank you!

...and now the details....

13

HENGELER.MUELLER

Contact Details

Benedikt Migdal
Hengeler Mueller
Benrather Straße 18-20
D-40213 Düsseldorf

Telephone: +49 211 8304 198
Telefax: +49 211 8304 7241
Email: benedikt.migdal@hengeler.com

14

HENGELER.MUELLER