

EPLAW

European Patent Lawyers Association

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Ms M. Fröhlinger
By e-mail: Margot.Froehlinger@ec.europa.eu

Amsterdam, 31 March 2008

Dear Ms Fröhlinger,

Thank you very much for your mail of March 25.

We have read with interest the last draft (7728/08 of 19 March 2008) and feel that indeed improvements have been made which better guarantee that, if the new jurisdiction is adopted, a workable system is reached.

We have the following remarks.

General

We remain indeed very concerned about the quality of the local divisions. Your suggestion to have the division without a certain minimum number of cases sitting with two "pool" judges is a good one (despite the language problems which certainly will arise). However, this should preferably not only be the case during a transitory period but as long as a certain number of decided patent-cases per year is not achieved (for instance 20). To express this more clearly, the wording of Art. 58 (3) should be changed to the effect that Member States having less than (20) decided patent cases per year at the entrance into force (Art. 60) should call in 2 judges from the pool unless such State has, for a period of 3 consecutive years, 20 decided patent-cases or more.

It is apparent that this will only guarantee a better quality if the pool of judges consists only of judges with the required experience.

Art. 7

It would be important that the pool judge (if there is one such judge on the panel) is a legal member. The purpose of the multinational panel (quality, consistency) will not be

served in the same way if the panel consists of two legal national judges and a technical judge from the pool.

Art. 13 under 2

However we note that according to art. 13(2) all judges from the divisions qualify for the pool. This will necessarily mean that the experience of the judges in the pool will vary greatly as certain judges from divisions and countries with very few cases have far less experience. It seems much better to make the pool of judges a distinct elected body with a smaller number of judges. Of course it should be possible to be at the same time judge in a division but it should not be an automatic thing. The judges of the pool should be highly experienced patent judges with a proven practical experience born out by the number of patent cases they have been dealing with.

We stress that we cannot support art. 13 under 2 as this clearly will not provide for a system the user wants.

Art. 15. General remark

One general principle should be that it should be avoided as far as possible that one division deals with the infringement action and another division with a revocation action, since this creates the danger of a different interpretation of the patent.

On the other hand, the decentralized system of first instance divisions of the Court is guided by the principle that the patent owner (in many cases SME) should be able to start a litigation action close to the place of infringement and/or close to himself thus avoiding the perhaps long distances to a central court (division), furthermore to avoid an overflow of cases before the central division and using the existing local capacities.

We believe that a practical and fair balance must be struck between these two principles for the different situations which may arise,

If a negative declaratory action is pending before the central division, the balance is clearly in favor of the second principle: The patent owner must be free to select the division where he wants to start his infringement action. The (possible) infringer should not be able to force the hand of the patent owner in quickly (in a torpedo-like way) starting a declaratory action before the central division, which may be far from the place of infringement or from the seat of the patent owner and/or which may be fully occupied with cases having long delays in deciding a new case. Therefore, a negative declaratory action (being just the opposite of an infringement-action) should be stopped in the central division, as soon as an infringement-action has started there or in any national or regional division.

If a revocation action has been started before the central division before an infringement action is started, the balance to be struck between the two principles is less clear. It would not be practical to send the revocation action to the division before which an infringement action is started later, since that division would perhaps decide that the central division is better equipped to handle the revocation action. On the other hand, it would constitute a clear violation of the second principle (free choice of the forum for the patent-owner) if the (possible) infringer, just because he was "the first", could force the patent owner to use the central division and not the national or regional division he would have preferred. The practical and fair solution seems to be for such a case (1) that the revocation action may continue before the central division, (2) that the patent owner may freely choose the division he wants (which may be, but not must be the central division) and (3) that the national or regional division chosen by the patent owner is free to apply

the best procedural solution taking into account the interests of the parties and the peculiarities of the case: continue with the infringement action, stay that action or send it to the central division.

Both principles would clearly demand that, after an infringement action has been started before a national or regional division, a revocation action between the same parties may only be brought before that division and that a negative declaratory action is inadmissible after that point in time.

Art. 15(2)

We suggest after the second sentence to insert the following sentences:

"Such actions may be started only until an infringement action has been started between the same parties and the same patent before a local or regional division. If a revocation action is pending before the central division, an infringement action between the same parties and regarding the same patent may be started there or in a national or regional division, the latter being free to deal with that action, stay it or send it to the central division. If an action for declaration of non-infringement is pending before the central division between the same parties and regarding the same patent, such action shall be terminated by that division without a decision once an infringement action has been started between the same parties and the same patent before a local or regional division."

15 (3)

This article should, accordingly, start with the words "Subject to para (2) ..."

15(5)

In our previous letter we had suggested, as an alternative to the proposed system (wherein the wording "appears to be unfounded" should be preferred), that the local or regional division should deal with the case itself or if it considers the case to be too complicated (to deal with or without a technical judge) send the whole case to the central division. As indicated, such an alternative system would only be acceptable if the patentee, in clear infringement-situations, is not prevented from exercising his rights by way of preliminary injunctions according to the provisions of the Enforcement Directive.

Rules of Procedure

It would be advisable to include a provision which states that any international private law questions will be governed by Rome I and II.

Art. 28 (2)

Since the CPC-system will be part of the court-system of the Community, the ECJ being, under certain conditions, the last instance, the parties should be represented by lawyers qualified under Art. 38 (3) of the Rules of Procedure of the ECJ, as the European Patent Judges have suggested in their 2006 Venice 2 Principles on Rules of Procedure.

Art. 29

Add after "official": "or designated".

A Member State should have the possibility to offer litigators the possibility to litigate in a different language than the official language. In the Netherlands for instance there have been proposals for an English speaking chamber.

Art. 38

We feel that it would be very important for the development and success of a viable European patent system that a dissenting opinion can be expressed if a judge wishes so.

Art. 41

It should be expressly said that a patentee should always be entitled to ask (instead of damages) for the profits of the infringer.

Art. 44

Who is paying for the legal aid?

Art. 46 under 1

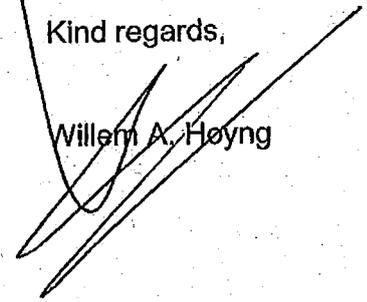
We feel that the normal rule should be that decisions of first instance are immediately enforceable against appropriate security and that in exceptional circumstances the court can refuse such enforceability or the court of appeal can at the request of a party remove such enforceability pending to appeal.

Art. 58

It would be advisable to give the holders of European Patents who hold such patents at the date of the entry into force of the EU patent jurisdiction scheme the possibility (by a declaration to be filed within three months from the entry into force with the Registrar, this declaration to be mentioned in a public registry) to opt out of the EU Patent jurisdiction for a period of 5 years. The effect of such declaration would be that no action under Art. 15 may be started before the Court during that period regarding the patents or patent applications of that holder existing at such date. During that period such patentee should have the possibility to revoke his opt out and to opt in, however only for all the patents or patent-applications covered by his previous opt out.

I realize that the Venice IV meeting is planned on a late date. Unfortunately it will not be possible to change this. I understand that in Brussels you consult with a representation of judges and lawyers who are represented in Venice. I have no problem to send all the EPLAW members an email soliciting their comments and with the agreement of the EPO I am willing to do the same with the Venice judges.

Kind regards,


Willem A. Hoyng