

EPLAW

European Patent Lawyers Association

Association européenne d'avocats spécialisés dans le droit des brevets d'invention
Europäische Vereinigung der im Patentrecht spezialisierten Rechtsanwälte

Suggestions received from members of the EPLAW Board of Directors in addition to the Comments of the EPLAW Board on 20 April, 2012 regarding the current draft of the Rules of Procedure of the Unified Patent Court dated 30 March, 2012 (“the Rules”). Due to time constraints these suggestions were either not resolved or even not discussed on April 20.

Rule 450.4 - Due to time constraints, no conclusion was reached on the question whether the decision shall contain the facts submitted by the parties and a statement of the facts and arguments on which the Court bases its decision only, or whether the Court should elaborate on all pleaded points (in order to facilitate appeal proceedings in case eg the Court of Appeal does not share the reasoning of the Court of first instance for dismissing the claim).

Rules 179 and 196.5 Is it necessary for the participating Member States to incorporate the possibility of sanctions on witnesses who are not appearing and who are not telling the truth in the criminal code or whether such rules should be put into the RoP. A “professional person or expert” under local laws may not have the power to carry out orders by the Court. Either the RoP or the national laws would have to vest such powers in those persons.

Other comments received concern the following issues which the drafting committee may wish to consider but the EPLAW Board of Directors at this stage did not discuss them.

Rule 200 - It is obviously not fair to ask for a fee for rehearing if the rehearing is based on an act of the Court which was held to constitute a criminal offence or if it is based on the fact that the patent was totally revoked in the opposition procedure.

Rule 390 - If there is a possibility to separate procedures the Court should obviously have the right to join procedures (in particular if there are two parallel revocation procedures initiated against the same patent)

There are no rules in connection with enforcement, however Article 56 of the Agreement mentions some enforcement guidelines and does not leave enforcement entirely to the existing EU law.

Rule 391 It should be a requirement that all cases could be brought before the same venue.

Rule 101 There should be a cut-off date for submitting new evidence.

Rule 70 As currently drafted, if the patentee fails to sue for infringement within 3 months of a declaration of non-infringement action being commenced then there is an estoppel from bringing a later infringement claim. This seems potentially open to abuse. Say for example a plaintiff (“infringer”) seeks a declaration of non infringement on a proposed product or process which is not yet being made/used (which is possible in the UK, for example) then there is no basis for the patentee to commence an action for

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infringement within the requisite time period since there is no infringing act. Alternatively, if the "infringer" commences the action more than 3 months before product launch (for example, where a pharmaceutical has received indication of marketing authorisation but is awaiting reimbursement and is not yet being sold) then the patentee may not be able to bring an infringement action in time, depending on what the court decides is an actionable "threat" or act of infringement.

It seems that this time limit is too short. Alternatively (given the need to have all issues dealt with in an action without permitting delay of the proceedings by late filing of issues) that there should be clarity as regards the ability of a patentee to commence infringement proceedings on the basis of a threat of infringement, which would include the filing of a declaration of non-infringement action itself. At present rule 11 (j)(i) requires actual instances of places and dates of infringing acts to be pleaded so doesn't provide for threats of infringement to be actionable.

Rule 69 If an "infringer" challenges validity in the Central Division then any subsequent infringement actions will result in the nullity case being stayed (unless the parties agree otherwise). This seems unfair since it denies the infringer an opportunity to have its defence heard, having commenced the validity action first to try to clear the way. In such circumstances shouldn't the court consolidate both validity and infringement to be heard together either in the CD or in the relevant local/regional division?

It will be necessary to ensure careful recording of opt outs and of infringement / validity cases that are brought in respect of particular patents, and whether oppositions have been commenced at the EPO. Perhaps there should be a requirement that the EPO register itself is updated centrally for such matters.

Rule 9 appears to create privilege to protect opinions, positions etc put forward between parties in settlement negotiations, so that these cannot be relied upon in court. As a general point, this may not be effective to protect such documents being used in other jurisdictions (particularly the US) if not provided for also in the Agreement.

Rule 211 If a balance of convenience test has to be introduced (here or elsewhere, see jj) of the Comments) it also should be taken into account that patents are property rights protected by constitution/under the Human Rights Convention.