DRAFT

Comments of EPLAW

Regarding the Preliminary Set of provisions for the

Rules of procedure of a Unified Patent Court

I. General remarks

1. The European Patent Lawyers Association (EPLAW) is an association of experienced patent lawyers. It has continuously supported the Commission and the Council in their work aiming at a European Patent System adjusted to the needs of the Community, especially regarding a common Patent Court System and the Community Patent.

2. EPLAW welcomes the Working Paper on the draft Rules of Procedure (PI65 COURT 59), first draft 29 May 2009, partially amended 9 July 2009, prepared by the Commission. In its opinion, the draft is largely consistent with the draft Agreement on the European and Community Patent Court (*Agreement*). The draft seems to be clearly structured, written in a concise language and well balanced seen from the viewpoint of the effectiveness of the court as well as from the interests of the plaintiff and the defendant. The draft provides a good basis for the work towards a final version. In particular we welcome the guiding principles which are set out in the Preamble which are consistent with the principles enunciated in the Venice II Resolution.

3. A first general remark as to the substance of the draft concerns the relationship between the central division on the one hand and the national and regional divisions on the other hand. In order to avoid duplication of work, an unnecessary amount of communication and unnecessary delays, each national or regional division should, in the opinion of EPLAW, so far as practicable deal with its own cases. The role of the central division, its Registrar and the President of the First Instance, so far as cases started in the national or regional divisions are commenced should be restricted as provided for in the Agreement and the Statute.

Therefore, the claim should be lodged directly with the national or regional division the plaintiff has chosen, which should be in charge of making decisions regarding the formal requirements, the fees, the competence of the division, the service to the defendant etc. This division should only inform the central division of an action started with it, the outcome of that action and, at the request of the Registrar or President of First Instance, the progress of the case.

4. EPLAW welcomes the changes that have been made to the effect that many functions previously ascribed to the Registrar are now left to the Judge-Rapporteur. Further, as stated above, we believe the Registrar's remaining functions should be carried out by the sub-Registrar (art. 8 (2) Statute) of the national and regional division the plaintiff has chosen.

5. A third general remark concerns the internal structure of the divisions, especially the national and regional divisions. For a Division to be efficient it is necessary that

each division should have its own vice-president (responsible for the operation of that division). The Statute should be amended to provide for this role which could be performed by one of the presiding judges of the panels working in that division. In the central division this role would be performed by the President of the Court of First Instance himself (Art. 10a of the Statute).

Therefore the structure of each national or regional division would be the same: (1) vice-president of the division, (2) presiding judges of the panels, (3) panels, including the Judge-Rapporteur, (4) sub-registrars.

7. A fourth general remark concerns the role of the "Judge-Rapporteur". EPLAW supports the idea to use one of the judges of the panel to prepare the case for the hearing of the full panel. However, the competent body for decisions of substance or regarding major procedural questions is the panel, except in the cases of Art. 6 (7) of the Agreement and Art. 14 (3) of the Statute, i.e. where both parties have asked the case to be decided by a single judge.

EPLAW welcomes the changes that have been made to the RoP to ensure that the role of the Judge-Rapporteur is restricted to preparatory work and assistance to the parties.

8. Regarding time-limits: The court should have the possibility to extend them when it believes that this is appropriate. We suggest the following text: "The court may at a written reasoned request of a party extend time limits if it believes this is appropriate."

9. The draft does not yet include rules on actions for declarations of non-infringement and on actions for revocation (Art. 15 (1) (a1) and (c) of the Agreement).

II. Remarks to specific rules

10. Rules 4 and 9 - Decentralised lodging of the claim

The claim should be lodged directly with the division chosen by the plaintiff (see Nr. 3). This also solves a language problem. The central division may not know the language of the division chosen by the plaintiff.

11. Rule 8 - No official check regarding contents prior to defendant

There should be no ex ante official check regarding the contents of the claim. Critical remarks regarding deficiencies should be left to the defendant as is provided for in Rule 12.

12. Rule 10 - Assignment to a panel by the President of the division

In accordance with the remarks in Nr. 3 and 5 it should be the Vice-President of the division who should assign the case to a panel of his division. In the central division this should be done by the President of the Court of First Instance.

13. **Rules 15, 18, 21, 22 et sequ. - Raising of counterclaim**

EPLAW agrees that the defendant should raise any counterclaim already in his statement of defence. Four months is a reasonable period. In Rule 18 delete "Registrar", put in "the court", same in Rule 21 and 23.

14. Rules 12 – 14 – Initial Objection

We welcome the provisions of these rules which place the onus of objection to jurisdiction etc. on the defendant.

15. **Rules 19 and 24 et seq - Interim procedure**

Not all cases call for an interim procedure. Such a procedure should be optional.

There is the danger that the case gets stuck in the interim procedure (perhaps the Judge-Rapporteur is scrupulous, overworked, sick, slow etc.). The presiding judge should be in a supervisory position. We welcome that a party has the right to ask for a referral to the panel (Rule 26). The interim procedure should also have a tentative time-limit (2 months).

16. **Former Rule 76 - Swearing of witnesses**

This rule needs further study. Certain member-countries do not have swearing of witnesses. What will be the consequences of a witness not telling the truth under oath? Will the penal laws of member countries recognise the oath taken before the court? Should (or could) the swearing be referred to courts of member countries?

17. Former **Rule 79 (2) (b) - Experts proposed by parties**

Include the requirement of "expertise"

17. **Former Rule 84-9 et seq - Provisional and protective measures**

In former Rule 84 replace "Registry" with "the division chosen by the applicant". In former Rule 85 replace the "President of the Court of First Instance" by the "President of the division or, if the applicant chooses the central division, by the President of the Court of First Instance". Former Rule 90 (2): If the applicant is not present, the application should be rejected. If the other party is not present, the court may continue.

18. **Former Rules 98, 99, 103 - Damages, Open books**

The statement of claim for damages should contain the choice of the plaintiff regarding the kind of redress he wants (damage, profits, licence fee). Former Rule 99 (2): The defendant should inform "the court". The same change in former Rule 103.

19. **Former Rule 107 - Leave to appeal interim decisions**

The Court of First Instance may be given that power, but it should be used restrictively, only for interim decisions where the court feels it needs guidance by the Court of Appeal.

20. **Former Rules 110, 111 - Time limit for Appeal and Reasoning**

Former Rule 110 (1): replace "Registrar" by "the Court of Appeal". Former Rule 110 (1)(b) should refer also to Art. 107 (2): Appeal allowed.

Former Rule 111: For the handing in of the reasons (grounds) for the Appeal there should be a separate time-limit: 2 months after filing the Appeal.

21. **Former Rules 114 - 117(1) - No check by Registrar**

These rules should be deleted. The President of the Court of Appeal assigns the case to a panel (former Rule 117 (2)), the presiding judge may appoint a Judge-Rapporteur. On the formal requirements the panel decides - after the opposite side has handed in its answer.

22. **Former Rules 119,120, 121 - Inadmissibility, Notice**

The panel should decide on inadmissibility, not the President and not the Judge-Rapporteur. The decision should be notified by the "Court of Appeal" (instead of Registrar"). No notice in the Official Journal. Such notice is not required for the First Instance. It is a matter of the parties to "go public" (or not).

23. **Former Rule 123 - Time limit for response**

The two-months time limit is to short for complex cases. Three months is better. Extension possible under former Rule 123 (1), sentence 2.

24. **Former Rules 126-129 - Registrar**

Replace "Registrar" by "Court of Appeal".