

# Unitary Patent Unified Patent Court What you need to know

7 September 2013 • Workshop VI • AIPPI Forum/Exco meeting • Helsinki

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## The Panel



**Annsley Ward**  
Lawyer  
Allen & Overy  
IPKat blogger  
London



**Klaus Grabinski**  
Judge Federal  
Court of Justice  
(Bundes-  
gerichtshof)



**Rainer Hilli**  
Lawyer  
Managing partner  
Roschier  
Helsinki

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2

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## On the table today

- 
**17 December 2012**  
**Regulation** 1257/2012 enhanced cooperation creation of unitary patent protection  
[http://www.upc.documents.eu.com/PDFs/2012-12-17\\_Regul\\_1260-2012\\_Enhanced\\_coop\\_Unitary\\_patent\\_translation.pdf](http://www.upc.documents.eu.com/PDFs/2012-12-17_Regul_1260-2012_Enhanced_coop_Unitary_patent_translation.pdf)
- 
**17 December 2012**  
**Regulation** 1260/2012 (translation arrangements)  
[http://www.upc.documents.eu.com/PDFs/2012\\_12\\_17\\_Regul\\_1260\\_2012\\_Enhanced\\_coop\\_Unitary\\_patent\\_translation.pdf](http://www.upc.documents.eu.com/PDFs/2012_12_17_Regul_1260_2012_Enhanced_coop_Unitary_patent_translation.pdf)
- 
**19 February 2013**  
**Agreement** on a Unified Patent Court and draft Statute  
EN [http://www.upc.documents.eu.com/PDFs/2013-02-19\\_Agreement\\_Unified\\_Patent\\_Court\\_JOUE\\_2013-06-20.pdf](http://www.upc.documents.eu.com/PDFs/2013-02-19_Agreement_Unified_Patent_Court_JOUE_2013-06-20.pdf)
- 
**31 May 2013**  
**Draft Rules of procedure** Unified Patent Court (V15)  
[http://www.upc.documents.eu.com/PDFs/2013-05-31\\_Draft\\_15\\_Rules\\_of\\_Procedure\\_UPC.pdf](http://www.upc.documents.eu.com/PDFs/2013-05-31_Draft_15_Rules_of_Procedure_UPC.pdf)

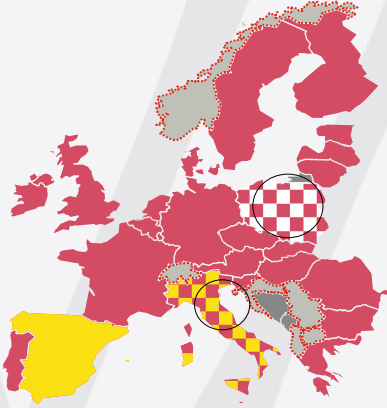
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3

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## A complex situation



**25 UP**  
 (EPO + EU + UP)

**NON UP**  
 (EPO + EU)

**EPO**  
 (NON EU)

**PL**  
 UP NON UPC

**IT**  
 UPC NON UP

(Five different Europes: EU, EPO, UP, UPC)

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4

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## Summary

- United Patent Court: general introduction KG
- Opt out: what you need to know AW
- Will forum shopping become a problem? AW
- Regional Divisions RH
- Language regime RH
- Bifurcation AW

5

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## Summary

- Role of patent attorneys and lawyers RH
- Role of Witnesses and experts RH
- Role of the judge rapporteur? KG
- Judgment deal with all issues? KG
- Injunction for NPE AW
- What will be the role of the ECJ? KG
- How to select judges of the highest quality "*with proven experience in patent litigation*"? KG

6

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## Article 83 Opt out: transitional period

*"(3) Unless an action has already been brought before the Court, a proprietor of or an applicant for a European patent granted or applied for prior to the end of the transitional period under paragraph 1 and, where applicable, paragraph 5, shall have the possibility to **opt out** from the exclusive competence of the Court. To this end they shall notify their opt-out to the Registry by the latest one month before expiry of the transitional period. The opt-out shall take effect upon its entry into the Registry.*

*(4) Unless an action has already been brought before a national court, proprietors of or applicants for European patents who made use of the opt-out in accordance with paragraph 3 shall be entitled to **withdraw their opt-out** at any moment. In this event they shall notify the Registry accordingly. The withdrawal of the opt-out shall take effect upon its entry into the Registry."*

7

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## Article 83 Transitional period: 7 years

01/04/2014  
Entry into operation  
Unified Patent Court  
Agreement
31/03/2021  
End of  
Transitional Period

01/04/2014 - 31/03/2021  
Transitional period: 7 years

- National courts still competent for EP
- European Patent holders may opt out from Unified Patent Court (withdrawal possible)

8

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## Will forum shopping become a problem?




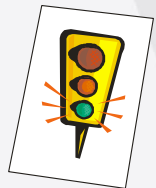
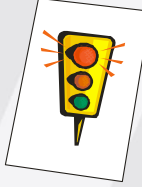
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The illustration shows a woman in a green top and orange skirt standing on a map of Europe. She is holding a magnifying glass over a shelf of various product containers. The map is shaded in grey, and the woman is positioned over the central part of Europe.

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## Article 32 Jurisdiction

- Infringement
- Declaration of non-infringement
- Revocation
- Miscellaneous



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10

The slide features a list of four items under the heading 'Article 32 Jurisdiction'. To the right of the list are three icons: a traffic light with the red light lit, a traffic light with the green light lit, and a large red 'X' over a black 'X'.

## Article 33 The Rules of Forum Shopping

33 (1)

Infringement: (a) place of infringement

33 (2) § 2

Infringement: multi-regional infringement

33 (1)

Infringement: (b) defendant's domicile

33 (1) §3

Infringement non EU defendants: Central Division

33 (7)


Infringement: choice of the parties

## Article 33 (2) 2 Are Regional Divisions still an attractive alternative to Local Division?

*"If an action referred to in Article 32 (1) (a) is pending before a regional division and the infringement has occurred in the territories of three or more regional divisions, the regional division concerned shall, at the request of the defendant, refer the case to the central division."*

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**33 (2) § 2**  
**Infringement: multi-regional infringement**




*If an action referred to in Article 32 (1) (a) is pending before a **regional** division and the infringement has occurred in the territories of **three** or more **regional** divisions, the regional division concerned shall, at the request of the defendant, refer the case to the central division.*

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**Language regime**

- What is the language regime most likely to be adopted by the Local and Regional Divisions?
- Will English become an alternative language to the language of the Member State(s) hosting a Local or Regional Division?

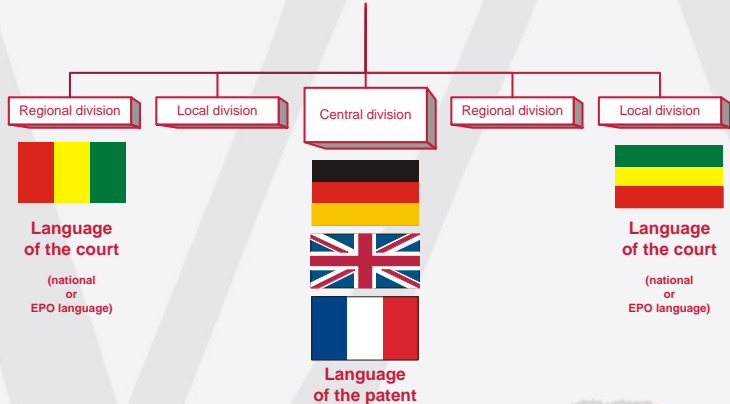
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14

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## Article 49 Language of proceedings: 1<sup>st</sup> instance



The flowchart illustrates the structure of the Unified Patent Court (UPC) at the first instance. It is divided into five divisions: two Regional divisions, one Central division, and two Local divisions. The Central division is associated with the German, UK, and French flags and is labeled 'Language of the patent'. The two Regional divisions are associated with the Italian and Spanish flags and are labeled 'Language of the court (national or EPO language)'. The two Local divisions are also associated with the Italian and Spanish flags and are labeled 'Language of the court (national or EPO language)'.

Regional division

Local division

Central division

Regional division

Local division

Language of the court  
(national or EPO language)

Language of the patent

Language of the court  
(national or EPO language)


Language of the court  
(national or EPO language)

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15

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## Bifurcation or not bifurcation?



Two cartoon figures are shown. The figure on the left is wearing a green hard hat and a white t-shirt that says 'I ❤️ BIFURCATION'. The figure on the right is wearing a judge's wig and a white t-shirt that says 'I DON'T NEED BIFURCATION'. Both figures have their eyes obscured by black bars.

I ❤️ BIFURCATION

I DON'T NEED BIFURCATION

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16



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## Article 33 (3) Concurrence of actions: infringement then revocation

The diagram shows a horizontal timeline from 01/01/2014 to 01/01/2016. A yellow traffic light icon is labeled 'Infringement action' with the date 01/06/2014. A red 'X' icon is labeled 'Counterclaim for revocation' with the date 30/06/2015.

**The local division has the discretion to:**

- ▶ proceed with the infringement proceedings and counterclaim for revocation (with a technically qualified judge);
- ▶ refer the counterclaim for decision to the central division and proceed with the infringement proceedings (bifurcation); or
- ▶ with agreement of parties, refer the case to the central division

17

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## Article 33 (5) Concurrence of actions: revocation then infringement

The diagram shows a horizontal timeline from 01/01/2014 to 01/01/2016. A red 'X' icon is labeled 'Revocation action Central division' with the date 30/06/2014. A yellow traffic light icon is labeled 'Infringement action Local division' with the date 01/09/2015.

**The local division may either**

- ▶ Proceed with the infringement proceedings, or
- ▶ stay the infringement proceedings, or
- ▶ if parties agree, refer the infringement action for decision to the central division

18

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## Article 33 (4) Revocation and non-infringement

The diagram illustrates the structure of the Unified Patent Court, which is divided into five divisions: two Regional divisions, two Local divisions, and one Central division. Below this structure, two icons represent legal actions: a red 'X' for 'Revocation action' and a traffic light for 'Action for a declaration of non-infringement'. A red arrow points from both of these actions towards the Central division box, indicating that both types of actions are heard by the Central division.

Revocation action
Action for a declaration of non-infringement

Regional division
Local division
Central division
Regional division
Local division

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19

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## Article 33 (6) Concurrence of actions non-infringement then infringement

The diagram shows a horizontal timeline from 01/01/2014 to 01/01/2016. A traffic light icon is placed above the timeline at 30/06/2014, with the text 'Action for declaration of non-infringement Central division'. Another traffic light icon is placed above the timeline at 01/09/2015, with the text 'Infringement action Local division'. A red arrow points from the text 'The action for a declaration of non-infringement before the central division shall be stayed once an infringement action is initiated within three months before local division' to the period between the two dates on the timeline.

30/06/2014
01/09/2015

Action for declaration of non-infringement Central division
Infringement action Local division

01/01/2014
01/01/2015
01/01/2016

**The action for a declaration of non-infringement before the central division shall be stayed once an infringement action is initiated within three months before local division**

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20

## Article 48

### What will be the role of patent attorneys and lawyers in the proceedings?

"(1) Parties shall be represented by **lawyers** authorised to practise before a court of a Contracting Member State.

(2) Parties may alternatively be represented by **European Patent Attorneys** who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who have **appropriate qualifications such as a European Patent Litigation Certificate**.

(3) The requirements for qualifications pursuant to paragraph 2 shall be established by the Administrative Committee. A list of European Patent Attorneys entitled to represent parties before the Court shall be kept by the Registrar.

(4) Representatives of the parties may be **assisted by patent attorneys**, who shall be allowed to speak at hearings of the Court in accordance with the Rules of Procedure."

## Article 53

### Role of written statements and oral testimonies of witnesses and experts?

"(1) In proceedings before the Court, the means of giving or obtaining evidence shall include in particular the following:

- (a) hearing the parties;
- (b) requests for information;
- (c) production of documents;
- (d) hearing witnesses;
- (e) opinions by experts;
- (f) inspection;
- (g) comparative tests or experiments;
- (h) sworn statements in writing (affidavits).

(2) The Rules of Procedure shall govern the procedure for taking such evidence. Questioning of witnesses and experts shall be under the control of the Court and be limited to what is necessary."

## **Rule 101 Role of judge-rapporteur (case management)**

*"1. During the interim procedure, the judge-rapporteur shall make all necessary preparations for the oral hearing. He may in particular, where appropriate, and subject to the mandate of the panel, hold an interim conference with the parties which may be held on more than one occasion and may exercise the powers provided for in Rule 334.*

*2. The judge-rapporteur shall have the obligation to ensure a fair, orderly and efficient interim procedure.*

*3. Without prejudice to the principle of proportionality, the judge-rapporteur shall complete the interim procedure within three months of the closure of the written procedure."*

## **Should a judgment deal with all issues or only the issues necessary to decide the case?**

## Injunctions

Are also NPE (non practicing entities) entitled to an injunction if their patent is infringed?

## Article 62 Preliminary injunctions

- "(1) The Court may, by way of order, grant injunctions against an alleged infringer or against an intermediary whose services are used by the alleged infringer, intended to prevent any imminent infringement, to prohibit, on a provisional basis and subject, where appropriate, to a recurring penalty payment, the continuation of the alleged infringement or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the right holder.*
- (2) The Court shall have the **discretion to weigh up the interests of the parties and in particular to take into account the potential harm for either of the parties** resulting from the granting or the refusal of the injunction."*

## Article 63 Permanent injunctions


- "(1) Where a decision is taken finding an infringement of a patent, the Court **may** grant an injunction against the infringer aimed at prohibiting the continuation of the infringement. The Court may also grant such injunction against an intermediary whose services are being used by a third party to infringe a patent.*
- (2) Where appropriate, non-compliance with the injunction referred to in paragraph 1 shall be subject to a recurring penalty payment payable to the Court."*

## Article 21 What will be the role of the European Court of Justice?

*"As a court common to the Contracting Member States and as part of their judicial system, the Court shall cooperate with the Court of Justice of the European Union to ensure the correct application and uniform interpretation of Union law, as any national court, in accordance with Article 267 TFEU in particular. Decisions of the Court of Justice of the European Union shall be binding on the Court."*

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**Article 38**  
**What will be the role of the Court of Justice?**



*“(1) The procedures established by the Court of Justice of the European Union for referrals for preliminary rulings within the European Union shall apply.*

*(2) Whenever the Court of First Instance or the Court of Appeal has decided to refer to the Court of Justice of the European Union a question of interpretation of the Treaty on European Union or of the Treaty on the Functioning of the European Union or a question on the validity or interpretation of acts of the institutions of the European Union, it shall stay its proceedings.”*

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29

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**Article 15**  
**How to select judges of the highest quality  
 “with proven experience in patent litigation”?**

*“(1) The Court shall comprise both legally qualified judges and technically qualified judges. Judges shall ensure the highest standards of competence and shall have proven experience in the field of patent litigation.*

*(2) Legally qualified judges shall possess the qualifications required for appointment to judicial offices in a Contracting Member State.*

*(3) Technically qualified judges shall have a university degree and proven expertise in a field of technology. They shall also have proven knowledge of civil law and procedure relevant in patent litigation.”*

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30

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**Thank you**

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