


The Rules of Procedure of the Unified Patent Court: A view from the Drafting Committee

*C5 13th Forum on Pharma Patent Extensions
London • 26 June 2014*

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Unified Patent Court
Rules of Procedure

The main publicly available documents can be found on
www.upc.documents.eu.com



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Rules of Procedure

Summary

- Drafting process
- Hot topics

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Drafting process: stages 1-5



Christian Vang, Michael Loch, Oleg Gumbel, Robert van Mourik, Erika Marquardt, Alice Pizzard, Keith Hooley, Pierre Véro, Anna Hecul, Daniela Kall, Paul Brugg, Tom Fran, Margit Fritzsche, Peter Griebner, Robin Jouis, Hans Bouwman, (Absentees: Susmit Talal, Sushan Rajagang) Sofiea Savoca

Expert Meeting Judges, Lawyers and Business Representatives on Unified Patent Court in Europe
3 February 2012, Brussels, European Commission, rue de Spa, 2, room Casalis de Digne

2007-2012: EU Commission's Expert group Judges, Lawyers and Business representatives

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Drafting process: stages 6-16



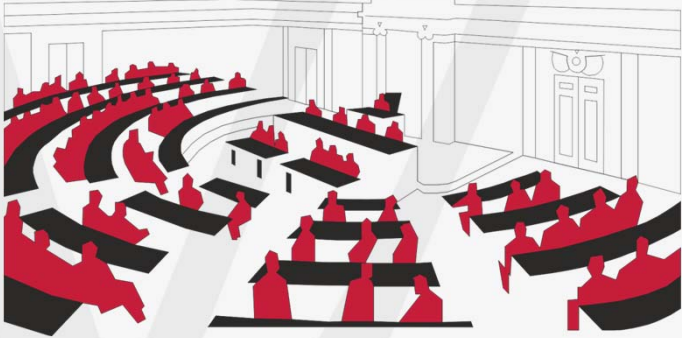
2012-2014: Drafting Committee
Judges and Lawyers

Draft 15 (31 May 2013): 111 comments received



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Drafting process: stages 17 +



Autum 2014: Public hearing

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Drafting process: final approval



2015: Administrative Committee final approval

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Rules of Procedure: hot topics


- Opt-out provisions
- Language of the statement of claim
- Bifurcation
- Decision on provisional measures
- Final decisions (permanent injunctions)
- Leave for procedural appeals

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Opt-out provisions

■ Why?	any reason to pay fees for status quo?	
■ How much?	“administrative level” or more?	
■ Who?	all proprietors	
■ What?	SPC goes with patent	
■ For how long?	life of the patent	
■ Where?	sunrise period EPO, Registry	

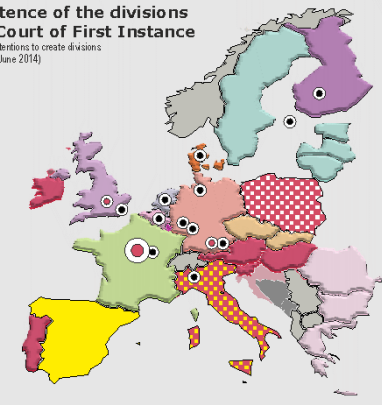
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7 The Court of first instance: competence of the divisions

Competence of the divisions of the Court of First Instance
Based on the intentions to create divisions as proposed in June 2014




	Central Division <small>also competent as "local" for: AT, AU, DE, LU, MT, PL, PT, SI</small>
	Baltic Regional Division <small>(EE, LT, LV, SI)</small>
	Finland
	Denmark
	United Kingdom
	The Netherlands
	Germany (4 divisions)
	Belgium
	CZ-SK Regional Division ? <small>(CZ, SK)</small>
	France
	Eastern Regional Division ? <small>(BG, CY, GR, RO)</small>
	Italy (non BU - JUB)
	Poland (BU - no JUB)
	Spain (no BU - no JUB)
	Croatia (JUB post BU & JUB)

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Rule 14 Language of the statement of claim






1. Without prejudice to Article 49(3)(4) and (6) of the Agreement and subject to Rule 14.2 the Statement of claim shall be drawn up
 - (a) in the official language or one of the official languages designated as language(s) of proceedings pursuant to Article 49(1) of the Agreement or
 - (b) in one of the languages designated as language(s) of proceedings pursuant to Article 49(2) of the Agreement.
2. **Where a Contracting Member State hosting a local division or Contracting Member State sharing a regional division has/have designated two or more languages of proceedings pursuant to Article 49(1) and/or Article 49(2) of the Agreement the Statement of claim shall be drawn up in...???**

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Bifurcation or no bifurcation?



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33 (3) Concurrence of actions: infringement then revocation



01/01/2014 01/06/2014 30/06/2015 01/01/2016

Infringement action Counterclaim for revocation

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

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33 (5) Concurrence of actions: revocation then infringement

01/01/2014 30/06/2014 01/09/2015 01/01/2016

Revocation action
Central division

Infringement action
Local division

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

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33 (4) Revocation and non-infringement

Regional division Local division Central division Regional division Local division

Revocation action

Action for a declaration of non-infringement

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

30/06/2014
Action for declaration of non-infringement
Central division

01/09/2015
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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Rule 37 Bifurcation

1. As soon as practicable after the closure of the written procedure the panel shall decide by way of order how to proceed with respect to the application of Article 33(3) of the Agreement. The parties shall be given an opportunity to be heard [Rule 264].
2. The panel may by order take an earlier decision if appropriate having considered the parties' pleadings and having given the parties an opportunity to be heard [Rule 264]
3. Where the panel decides to proceed in accordance with Article 33(3)(a) of the Agreement, the judge-rapporteur shall request the President of the Court of First Instance to allocate to the panel a technically qualified judge if not already allocated pursuant to Rules 33 and 34.
4. Where the panel decides to proceed in accordance with Article 33(1)(b) of the Agreement, the panel **may** stay the infringement proceedings pending a final decision in the revocation procedure and **shall stay the infringement proceedings where there is a high likelihood** that the relevant claims of the patent (or patents) will be held to be invalid on any ground by the final decision in the revocation procedure.

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Rule 211

**Decision on the
Application for provisional measures**

1. The Court may in particular order the following provisional measures:

- (a) injunctions against a defendant;
- (b) the seizure or delivery up of the goods suspected of infringing a patent right so as to prevent their entry into or movement within the channels of commerce;
- (c) if an applicant demonstrates circumstances likely to endanger the recovery of damages, a precautionary seizure of the movable and immovable property of the defendant, including the blocking of his bank accounts and other assets;
- (d) make an interim award of costs.

2. In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, **that the patent in question is valid** and that his right is being infringed, or that such infringement is imminent.

3. In taking its decision on the Application for provisional measures, the Court shall have the discretion to weigh up the interests of the parties.

Rule 118

Decision on the merits

- Should the judgment of the Court of First Instance deal with all the issues in dispute (e. g. infringement when patent held invalid)?

or

- Should the judgment limit the discussion on the issues relevant in accordance to the decision taken?

Article 73 Agreement

Leave for procedural appeals

(1) An appeal against a **decision** of the Court of First Instance may be brought before the Court of Appeal by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of the notification of the decision.

(2) An appeal against an **order** of the Court of First Instance may be brought before the Court of Appeal by any party which has been unsuccessful, in whole or in part, in its submissions:

...

(ii) where **the Court** grants leave to appeal, within 15 days of the notification of the Court's decision to that effect.

"the Court"

the Court of first instance only? or also the Court of appeal?

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