

The Rules of Procedure of the UPC

# Conduct of the proceedings before the Unified Patent Court

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Draft **Rules of procedure** (382 rules) of the Unified Patent Court  
19 October 2015 - 15 March 2017 (V18)

[https://www.unified-patent-court.org/sites/default/files/upc\\_rules\\_of\\_procedure\\_18th\\_draft\\_15\\_march\\_2017\\_final\\_clear.pdf](https://www.unified-patent-court.org/sites/default/files/upc_rules_of_procedure_18th_draft_15_march_2017_final_clear.pdf)

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## Topics not covered

- Evidence (including order to preserve evidence)
- Injunctions (including preliminary injunctions)
- Rules or procedure (court organisation, jurisdiction)  
Kevin Mooney
- Damages  
separate presentation



## Overview

# The 10 main features of the UPC proceedings

1. One year for a judgment
2. Mainly written proceedings, in electronic form
3. The Registrar: an important person
4. Preformatted proceedings
5. Front-loading system
6. The Judge-rapporteur: a key person
7. One day hearing
8. Hearing of a witness in person exceptional
9. Appeal widely open
10. Court's fees



## The best of both worlds

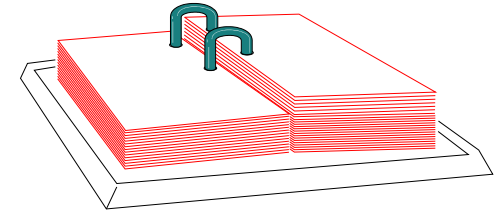


with a hint  
of EPO  
dressing



Feature 1: Time target

## One year for a judgment



*"proceedings shall be conducted in a way which will normally allow the final oral hearing on the issues of infringement and validity at first instance to take place within **one year**"*  
(preamble)



Feature 2

## Written proceedings in electronic form



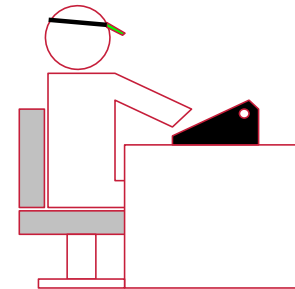
***“ 1. Written pleadings and other documents shall be lodged at the Registry in electronic form. Parties shall make use of the official forms available on-line. The receipt of documents shall be confirmed by the automatic issue of an electronic receipt, which shall indicate the date and local time of receipt. » (Rule 4)***



<https://cms.unified-patent-court.org/login>

Feature 3

## The Registrar: an important person



- Examines, when receiving pleadings, whether the formal requirements have been complied with (may invite parties to correct deficiencies)
- Serves the Statement of claim and all further pleadings upon the parties

NB: the Registry also enters the Applications to opt out in the register





Feature 4

## Preformatted proceedings

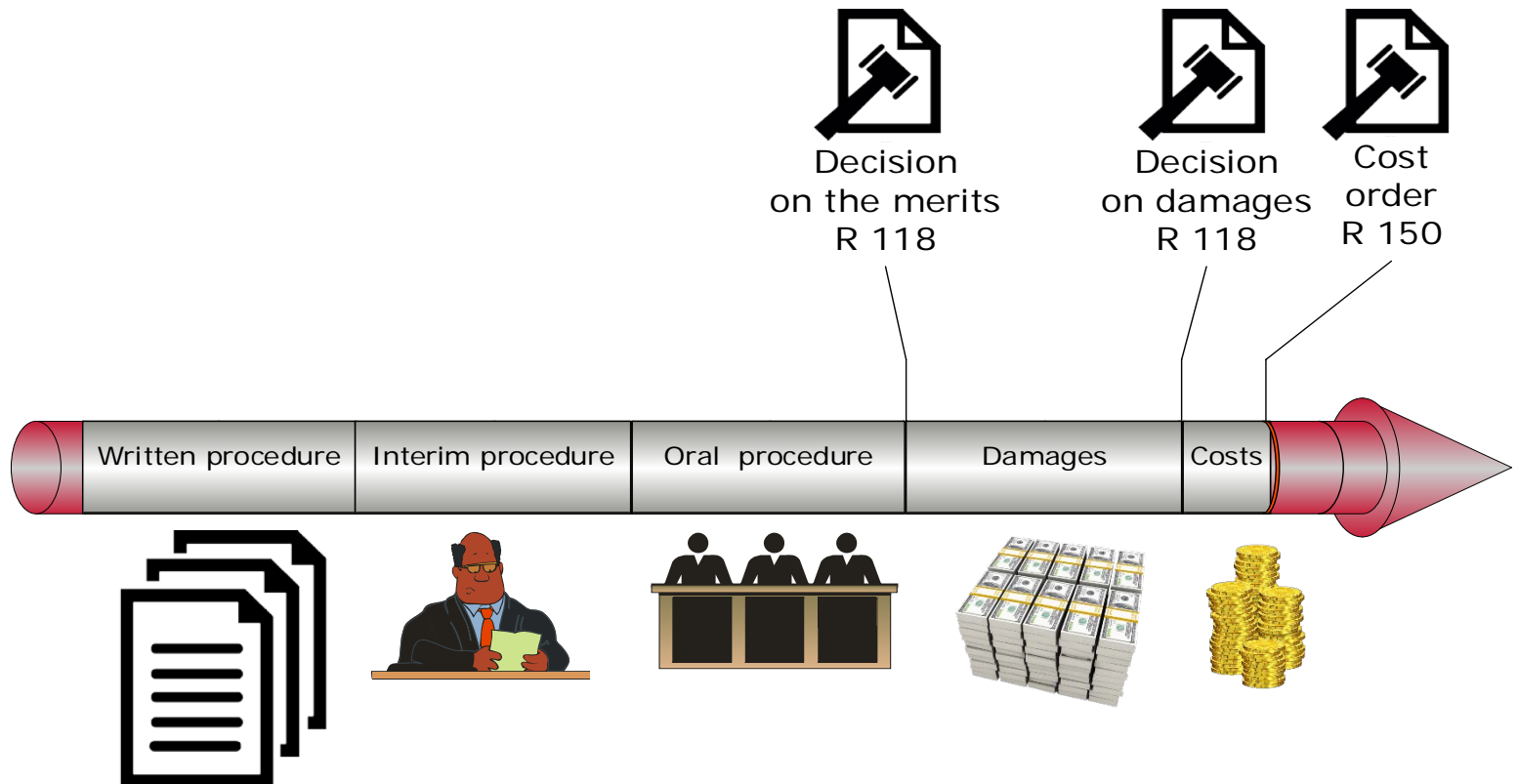
### Rule 8 ROP

- “(a) the written procedure;*
- (b) the interim procedure, which may include an interim conference with the parties;*
- (c) the oral procedure, which shall include an oral hearing of the parties where necessary;*
- (d) the procedure for the award of damages;*
- (e) the procedure for a cost order”*



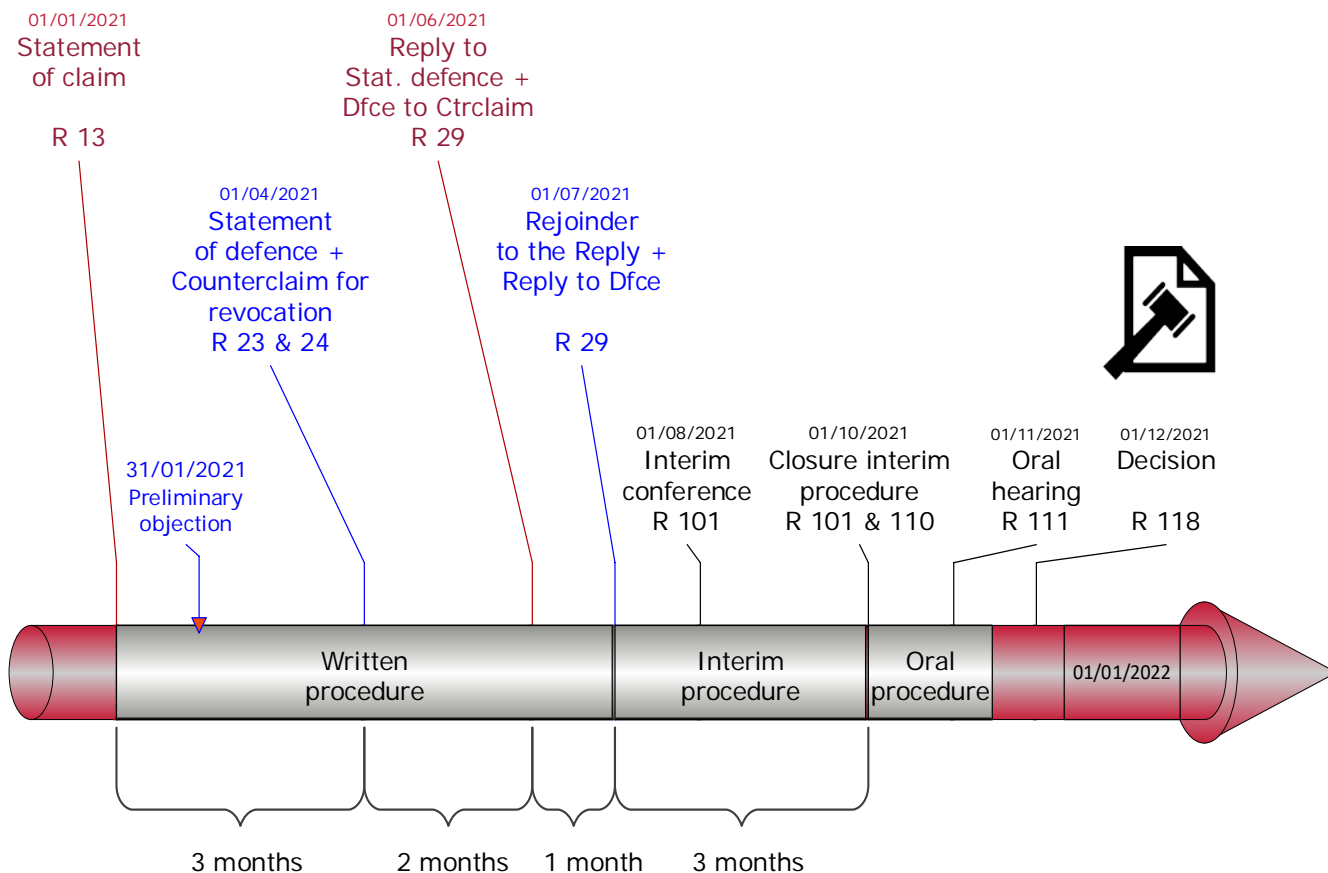
Feature 4

# Preformatted proceedings



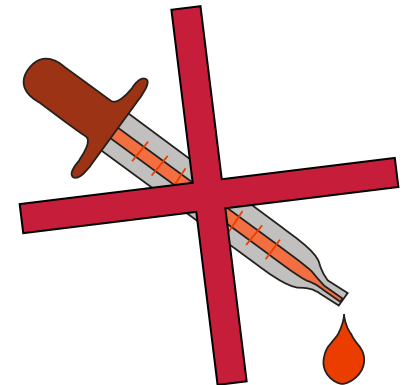
## Feature 4

# Preformatted proceedings: example of infringement action



Feature 5

# Front loading system (not drips and drabs system)



## Preamble and Rule 9 § 2 ROP

*"Parties shall... set out their full case as early as possible in the proceedings"*

*"The Court may disregard any step, fact, evidence or argument which a party has not taken or submitted in accordance with a time limit set by the Court or these Rules."*



Feature 6

# The judge-rapporteur: a key person



Feature 7

## Oral hearing: one day



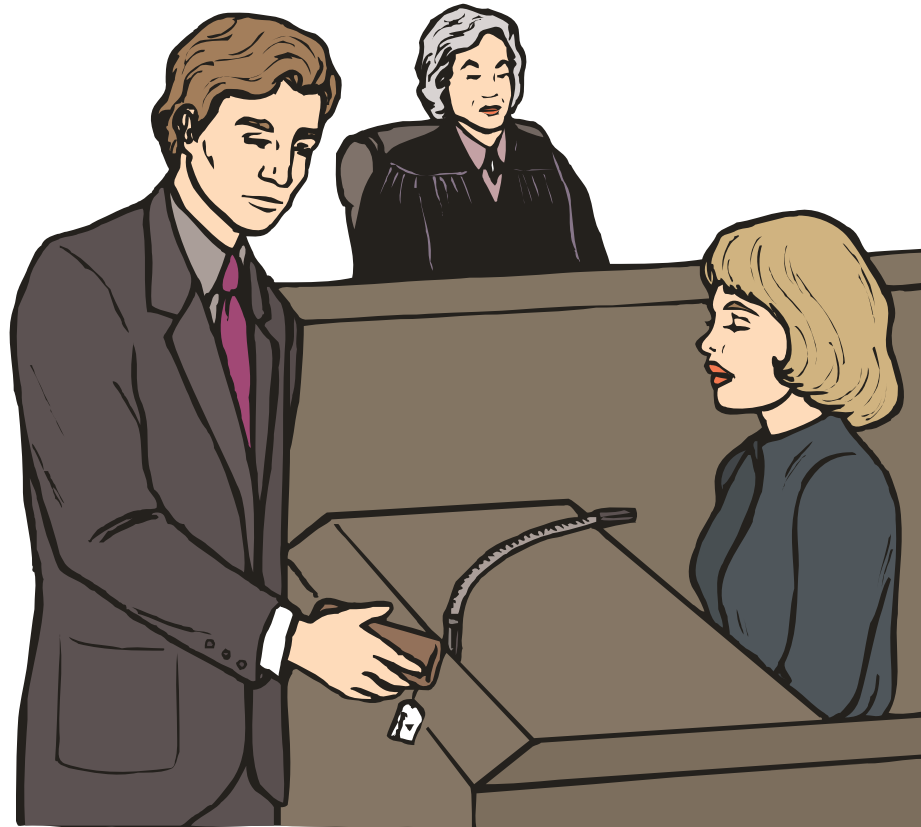
### ***“Rule 113 – Duration of the oral hearing***

- 1. Without prejudice to the principle of proportionality, the presiding judge shall endeavour to complete the oral hearing within **one day**. The presiding judge may set time limits for parties' oral submissions in advance of the oral hearing, in accordance with the Practice Directions.*
- 2. Oral testimony at the oral hearing shall be limited to issues identified by the judge-rapporteur or the presiding judge as having to be decided by oral evidence.*
- 3. The presiding judge may, after consulting the panel, limit a party's oral submissions if the panel is sufficiently informed.”*



Feature 8

# Hearing of a witness in person exceptional



Feature 9  
Rule 220

## Appealable decisions

*"1. An appeal by a party adversely affected may be brought against:*

*a) final decisions of the Court of First Instance;*

*b) decisions terminating proceedings as regards one of the parties;*

*c) Orders referred to in Articles 49(5), 59, 60, 61, 62 or 67\* of the Agreement."*



*\* Language of proceedings, production and preservation of evidence, freezing order, provisional and protective measures, communication of information*



## Feature 10 Costs



*“(1) The budget of the Court shall be financed by the Court's own financial revenues...”*

*“(2) The Court's own financial revenues shall comprise court fees and other revenues.*

*“(3) Court fees shall be fixed by the Administrative Committee. They shall consist of a **fixed fee**, combined with a **value-based fee** above a pre-defined ceiling.”*



(Art. 36 of the Agreement)

## End of the overview

Any questions on this overview, before discussing the written procedure

Overview  
Conduct of the proceedings  
before the Unified Patent Court

### The 10 main features of the UPC proceedings

1. One year for a judgment
2. Mainly written proceedings, in electronic form
3. The Registrar: an important person
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Contents

## Written procedure



- Listed proceedings
- Preformatted exchange of written pleadings
- Predetermined content and use of official forms or the parties submissions (“Statements”)
- Examination by Registry
- Designation of judge-rapporteur
- Service of the Statement of claim
- Further exchanges of pleadings



## Chapter 1 ROP

# Listed proceedings

1. Infringement action (Section 1)
2. Revocation action (Section 2)
3. Action for a declaration of non-infringement (Section 3)
4. Actions pending before the central division and before a local division (Section 4)
5. Action for compensation for a licence of right (Section 5)
6. Actions against decisions of the EPO about unitary patents (Section 6)



## Art. 32 UPCA

# Exclusive competence of the Court

(a) actions for actual or threatened infringements of patents and supplementary protection certificates and related defences, including counterclaims concerning licences;

(b) actions for declarations of non-infringement of patents and supplementary protection certificates;

(c) actions for provisional and protective measures and injunctions;

(d) actions for revocation of patents and for declaration of invalidity of supplementary protection certificates;

(e) counterclaims for revocation of patents and for declaration of invalidity of supplementary protection certificates;

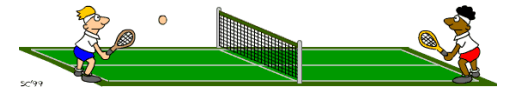
(f) actions for damages or compensation derived from the provisional protection conferred by a published European patent application;

(g) actions relating to the use of the invention prior to the granting of the patent or to the right based on prior use of the invention;

(h) actions for compensation for licences on the basis of Article 8 of Regulation (EU) No 1257/2012; and

(i) actions concerning decisions of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012.





## Rule 12 ROP

# Exchange of written pleadings

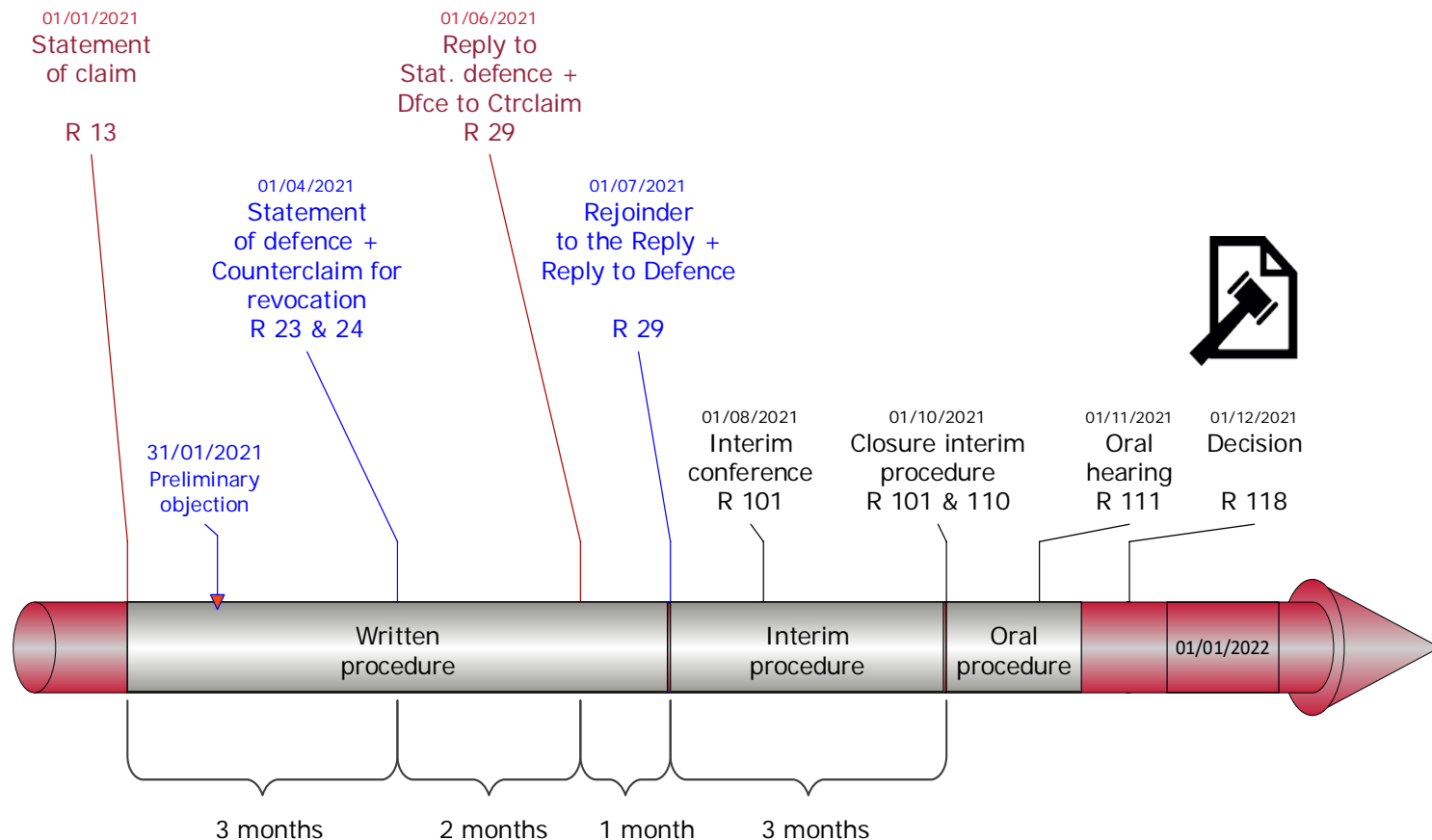
- "1. The written procedure shall consist of:*
- a) the lodging of a Statement of claim (by the claimant) [Rule 13];*
  - b) the lodging of a Statement of defence (by the defendant) [Rules 23 and 24]; and, optionally*
  - c) the lodging of a Reply to the Statement of defence (by the claimant) [Rule 29(b)]; and*
  - d) the lodging of a Rejoinder to the Reply (by the defendant) [Rule 29(c)].*

...

- 5. The judge-rapporteur may allow the exchange of further written pleadings, within time periods to be specified [Rule 36]. "*

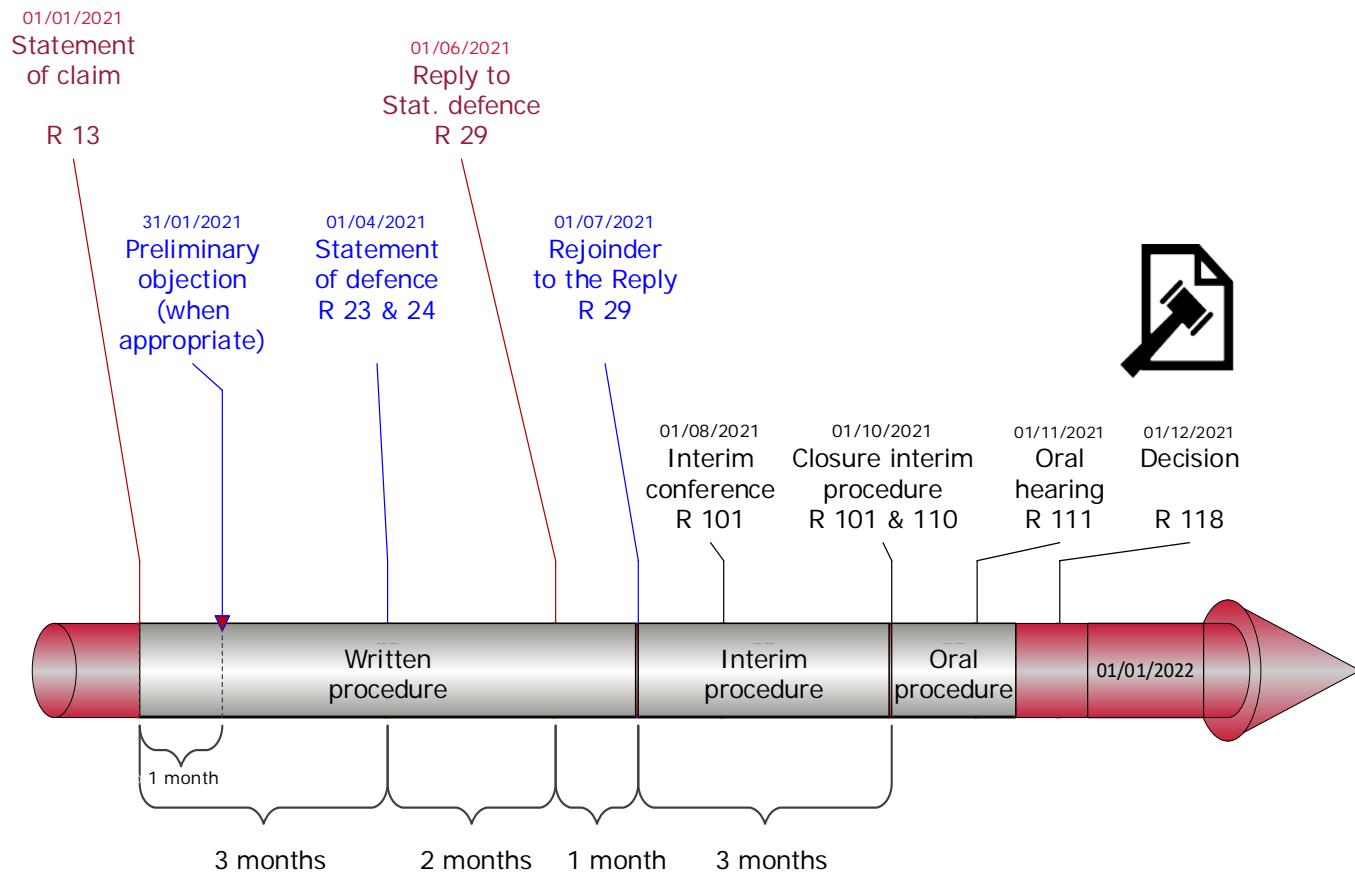


# Preformatted proceedings: example of infringement action



## Timeline

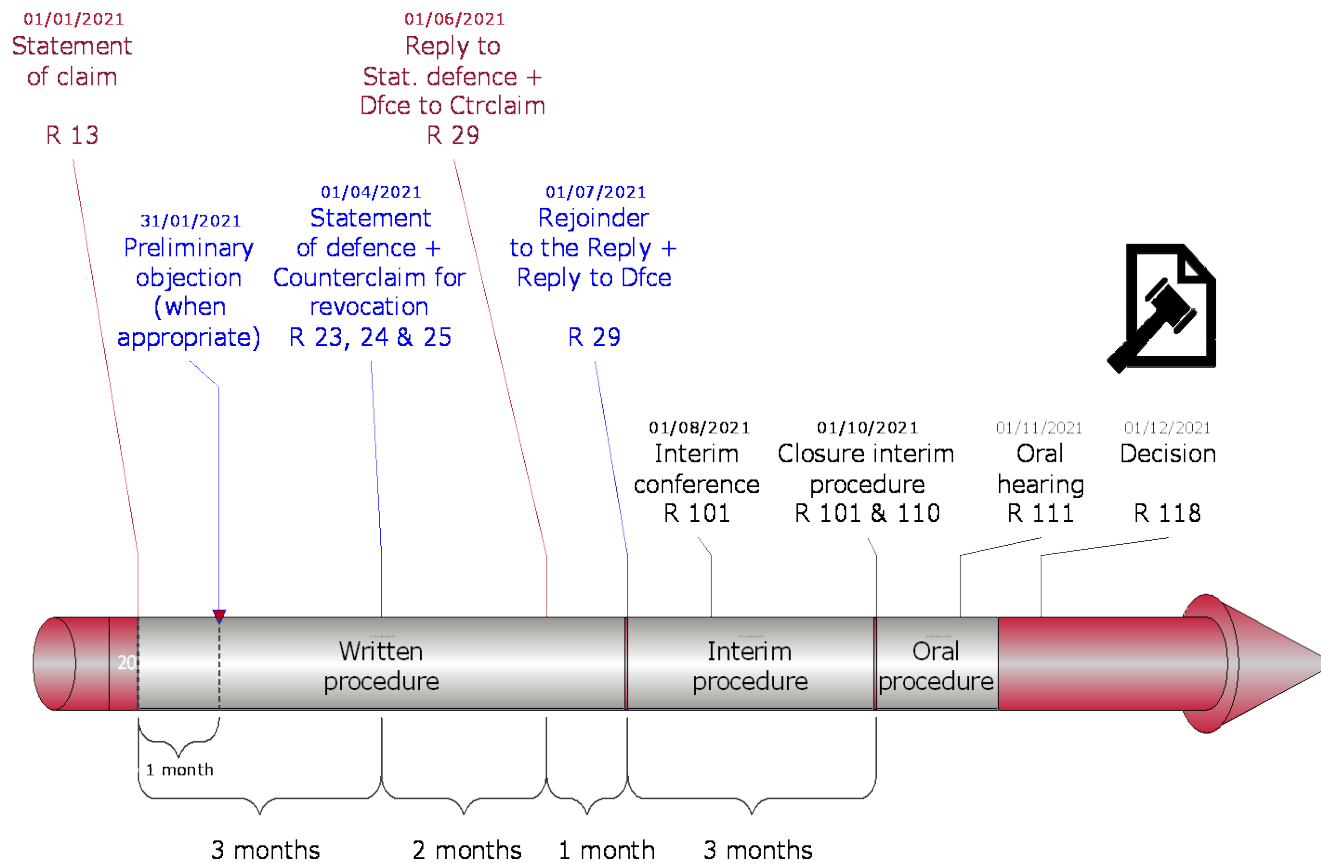
# Infringement proceedings without counterclaim for revocation (R 12)





## Timeline

# Infringement proceedings with counterclaim for revocation (R 12)



## Rule 13 ROP (17 boxes to fill-in)

# Contents of the Statement of claim

- a) the **name of the claimant**, and, where the claimant is a corporate entity, the location of its registered office, and of the claimant's representative;
- b) the **name of the party against whom the Statement is made (the defendant)** and, where the defendant is a corporate entity, the location of its registered office;
- c) postal and electronic **addresses** for service on the **claimant** and the names of the persons authorised to accept service;
- d) **postal** and, where available, electronic **addresses** for service on the defendant and the names of the persons authorised to accept service, if known;
- e) where the claimant is not the proprietor or not the only proprietor of the patent concerned, postal and where available, electronic **addresses for service on the proprietor** and the names and addresses of the persons authorised to accept service, if known;
- f) where the claimant is not the proprietor of the patent concerned, or not the only proprietor, **evidence to show the claimant is entitled to commence proceedings** [Article 47(2) and (3) of the Agreement];
- g) **details of the patent concerned**, including the number;
- h) where applicable, **information about any prior or pending proceedings relating to the patent** (or patents) concerned before the Court including any action for revocation or a declaration of non-infringement pending before the central division and the date of any such action, the European Patent Office or any other court or authority;
- i) an **indication of the division which shall hear the action** [Article 33(1) to (6) of the Agreement] with an explanation of why that division has competence; where the parties have agreed in accordance with Article 33 (7) of the Agreement, the indication of the division which shall hear the action shall be accompanied by evidence of the defendant's agreement;
- j) where applicable, an **indication that the action shall be heard by a single judge** [Article 8(7) of the Agreement], accompanied by evidence of the defendant's agreement;
- k) **the nature of the claim, the order or the remedy sought** by the claimant;
- l) an indication of the **facts relied on**, in particular:
  - i) one or more **instances of alleged infringements** or threatened infringements specifying the date and place of each;
  - ii) the **identification of the patent claims alleged to be infringed**;
- m) the **evidence relied on** [Rule 170.1], where available, and an indication of any further evidence which will be offered in support;
- n) **the reasons why the facts relied on constitute an infringement** of the patent claims, including arguments of law and where appropriate an explanation of the proposed claim interpretation;
- o) an indication of any **order the claimant will seek during the interim procedure** [Rule 104(e)];
- p) where the claimant assesses that the value of the infringement action exceeds [EUR\*\*\*], an **indication of the value**; and
- q) a **list of the documents, including any witness statements, referred to in the Statement of claim**, together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.1.



Art. 49 UPCA, rule 14

## Language of proceedings

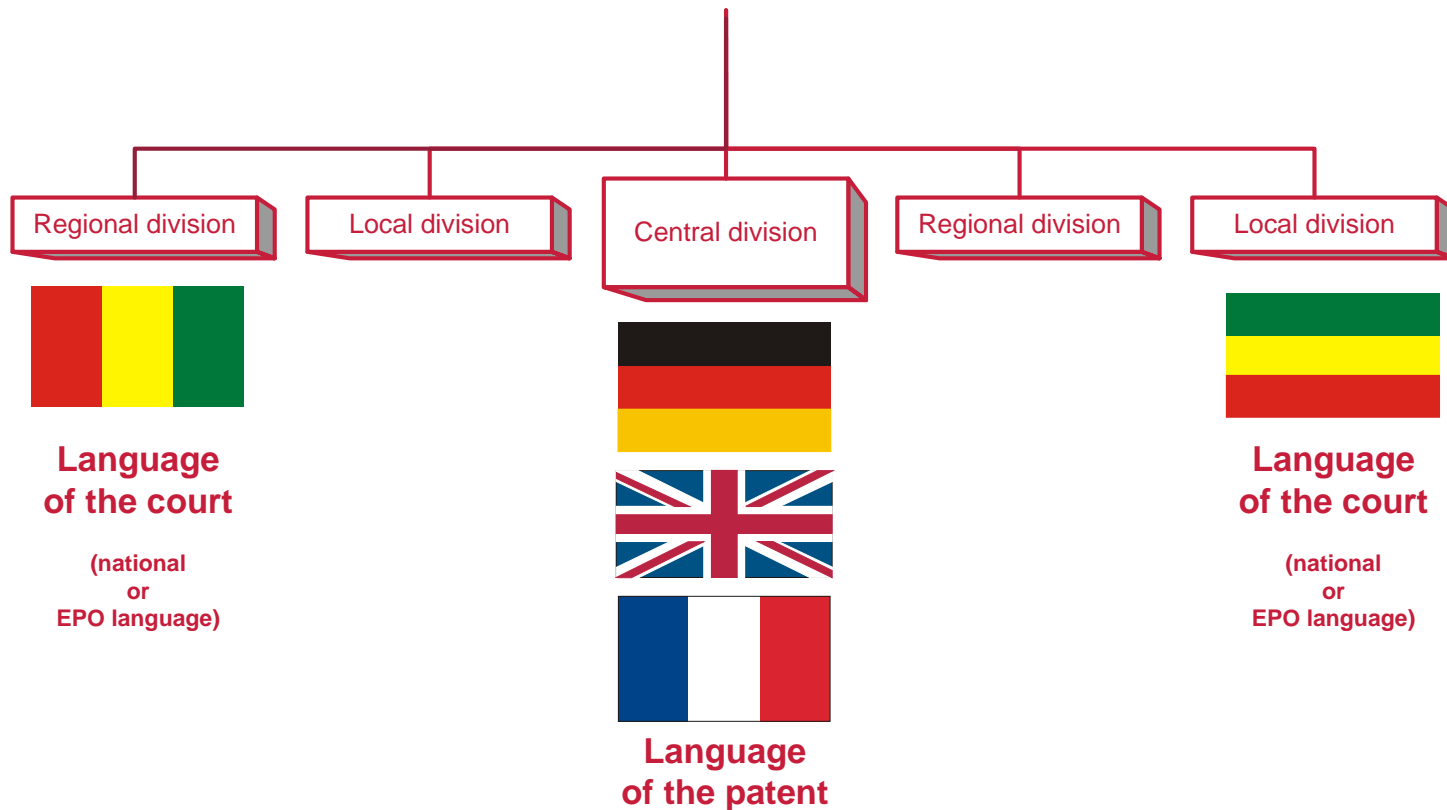
- Choice by the claimant
- Within the limits set out by the Agreement and the Rules





Art. 49 UPCA

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

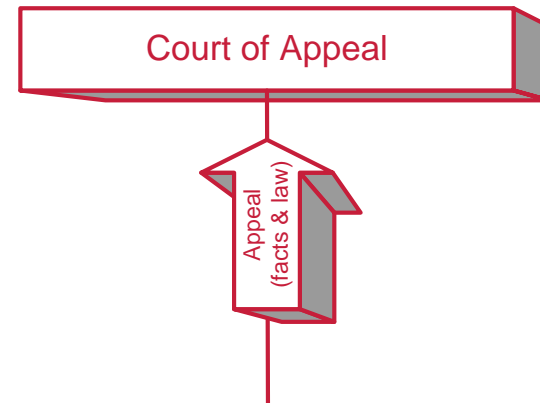


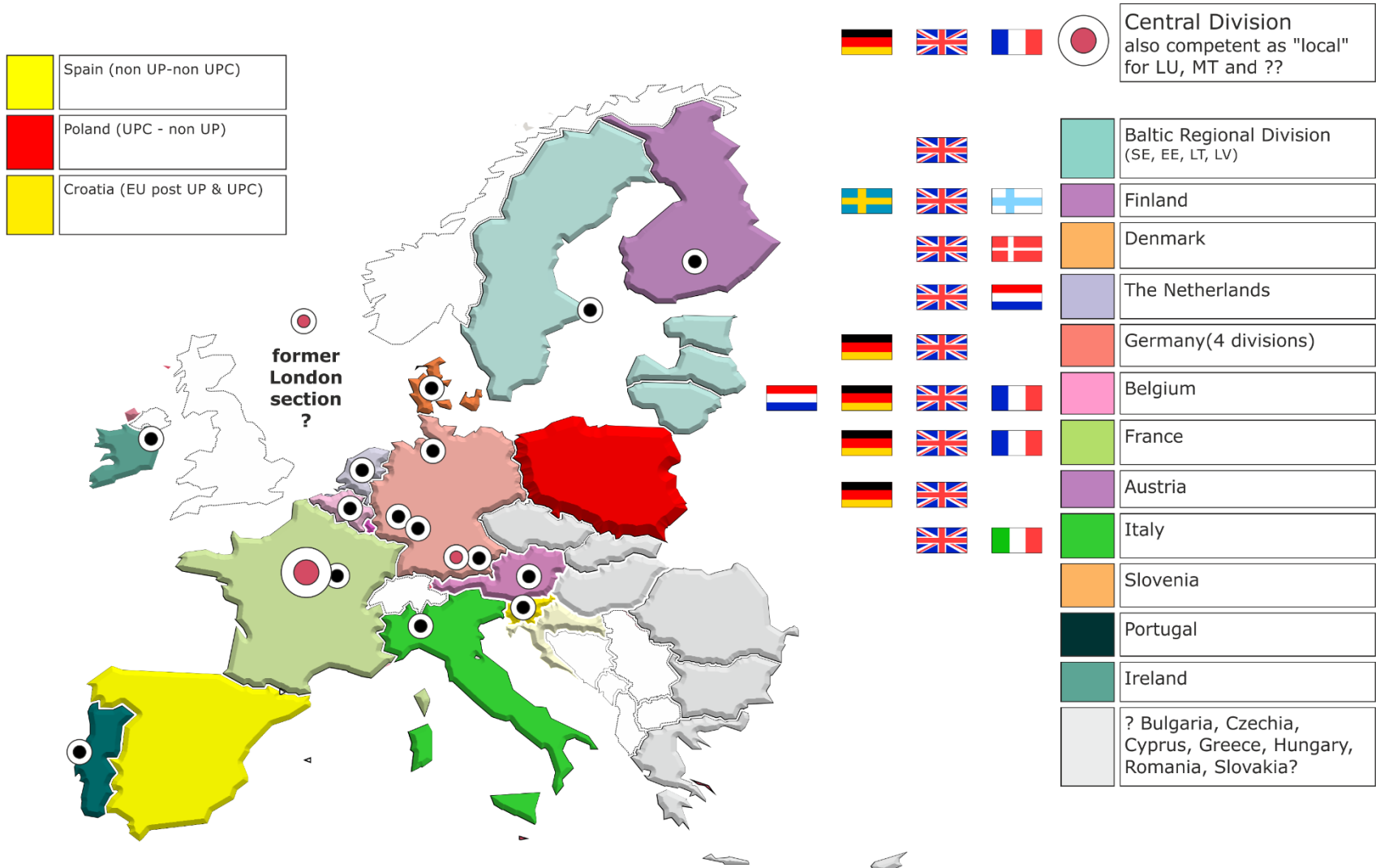
Art. 50 UPCA

# Language of proceedings: appeal



- Language of 1<sup>st</sup> instance
- Language of the patent  
(upon the parties' agreement)
- Language chosen by the court  
and approved by the parties





**Central div. (1 seat + 2 sections), 13 local div., 1 regional div.**

(based on the supposed intentions Feb. 2022, to create divisions)



Rule 262 – Public access to the register

## Confidential information



*“...**written pleadings**, written evidence, decisions and orders lodged at or made by the Court and recorded by the Registry **shall be available to the public, unless a party has requested that certain information be kept confidential and provided specific reasons for such confidentiality.** The Registrar shall ensure that information subject of such a request shall not be made available pending an Application pursuant to paragraph 2 or an appeal pursuant to Rule 220.2. Where a party requests that parts of written pleadings or written evidence shall be kept confidential, he shall also provide copies of the said documents with the relevant parts redacted when making the request.”*



**! This rule could change in the final version!**

Rule 16 ROP

# Examination as to formal requirements by the Registry



*"1. The Registry shall, as soon as practicable after the lodging of the Statement of claim, examine whether the requirements of Rules 13.1 (a) to (k), 2, 14 and 15.1 have been complied with.*

*2. If the claimant has not complied with the requirements referred to in paragraph 2, the Registry shall as soon as practicable invite the claimant to:*

*a) correct the deficiencies within 14 days of service of such notification; ..."*







Rule 17 ROP

# Recording in the register and assignment

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- The Registry records the date of receipt and attribute an action number, records the file in the register and inform the claimant of this
- The Registry assigns the action to a panel (detailed rules for cases brought before central division involving several patents)



Rule 18 ROP

# Designation of the judge-rapporteur

*"The presiding judge of the panel to which the action has been assigned [[Rule 17.2](#)] shall designate one legally qualified judge of the panel as judge-rapporteur.*

*The presiding judge may designate himself as judge-rapporteur.*

*The Registry shall as soon as practicable notify the claimant and defendant of the identity of the judge-rapporteur."*





Rules 270 sqq. ROP

## Service of the Statement of claim

- The service of the Statement of claim is a duty of the Registry (different from civil proceedings in BE, FR, IT, NL where it is a duty of the claimant) Rules 270 sqq.
- Electronic service possible if the defendant has provided an e-mail address for that purpose
- Otherwise, service made according to Regulation (EC) No 1393/2007 of 13 November 2007\* on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (service of documents) or The Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters of 15 November 1965 \*\*



\* <http://data.europa.eu/eli/reg/2007/1393/oj>

\*\* <https://www.hcch.net/en/instruments/conventions/full-text/?cid=17>

Rule 272 ROP

# Notice of service and non-service of the Statement of claim

*" 1. The Registry shall inform the claimant of the date on which the Statement of claim is deemed served under Rule 271.6.*

*2. Where the Registry has served the Statement of claim by registered letter with advice of delivery and the Statement of claim is returned to the Registry for any reason, the Registry shall inform the claimant.*

*3. Paragraph 2 shall apply mutatis mutandis where the Registry has served the Statement of claim by means of electronic communication or fax and the relevant electronic message or fax appears not to have been received."*



Rule 275 ROP

## Service of the Statement of claim by an alternative method

*" 1. Where it appears to the Court on an application by the claimant that there is a good reason to authorise service by a method or at a place not otherwise permitted by this Chapter, the Court may by way of order permit service by an alternative method or at an alternative place.*

*2. On a reasoned request by the claimant, the Court may order that steps already taken to bring the Statement of claim to the attention of the defendant by an alternative method or at an alternative place is good service."*



Rules 19-21 ROP

## Preliminary objection



*"1. **Within one month of service of the Statement of claim**, the defendant may lodge a Preliminary objection concerning:*

*a) the jurisdiction and competence of the Court, including any objection that an opt-out pursuant to Rule 5 applies to the patent that is the subject of the proceedings;*

*b) the competence of the division indicated by the claimant [Rule 13.1(i)];*

*c) the language of the Statement of claim [Rule 14]."*



## Rule 24 ROP

# Contents of the Statement of defence

*“The Statement of defence shall contain:*

- a) the names of the defendant and of the defendant's representative;*
- b) postal and electronic addresses for service on the defendant and the names and addresses of the persons authorised to accept service;*
- c) the action number of the file;*
- d) an indication whether the defendant has lodged a Preliminary objection [Rule 19];*
- e) an indication of the facts relied on, including any challenge to the facts relied on by the claimant;*
- f) the evidence relied on [Rule 170.1], where available, and an indication of any further evidence which will be offered in support;*
- g) the reasons why the action shall fail, arguments of law and any argument arising from the provisions of Article 28 of the Agreement and where appropriate any challenge to the claimant's proposed claim interpretation;*
- h) an indication of any order the defendant will seek in respect of the infringement action during the interim procedure [Rule 104(e)];*
- i) a statement whether the defendant disputes the claimant's assessment of the value of the infringement action and the grounds for such dispute; and*
- j) a list of the documents, including any witness statements, referred to in the Statement of defence together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.1. Rule 13.2 and .3 shall apply mutatis mutandis.”*



## Rule 25 ROP

# Counterclaim for revocation: contents

*"1. If the Statement of defence includes an assertion that the patent alleged to be infringed is invalid the Statement of defence shall include a Counterclaim against the proprietor of the patent for revocation of said patent in accordance with Rule 42. The Counterclaim for revocation shall contain:*

- a) an indication of the extent to which revocation of the patent is requested;*
- b) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the defendant's proposed claim construction;*
- c) an indication of the facts relied on;*
- d) the evidence relied on, where available, and an indication of any further evidence which will be offered in support;*
- e) an indication of any order the defendant will seek during the interim procedure [Rule 104(e)];*
- f) where the defendant assesses that the value of the dispute including the Counterclaim exceeds the value of the infringement action by more than [EUR\*\*\*] an indication of the value of the dispute including the Counterclaim;*
- g) a statement of his position, if any, on the options provided for in Article 33(3) of the Agreement and Rule 37.4;*
- h) a list of the documents, including any witness statements, referred to in the Counterclaim for revocation together with any request that all or part of any such documents need not be translated. Rule 13.2 and .3 shall apply mutatis mutandis; and*
- i) insofar as the proprietor of the patent is not claimant in the infringement proceedings, the information required by Rule 13.1(b) and (d) in respect of said proprietor"*





## Rule 25 ROP

# Counterclaim for revocation: joining in the patent proprietor

*"1. Where the claimant is not the proprietor or not the only proprietor of the patent concerned, the Registry shall as soon as practicable serve a copy of the Counterclaim for revocation on the relevant proprietor in accordance with Rule 13.1(e) and shall supply a copy of each document referred to in paragraph 1(h). Rule 271 shall apply mutatis mutandis.*

***The proprietor in question shall become a party to the revocation proceedings and shall be treated as defendant in all subsequent proceedings.***

*The proprietor shall provide details pursuant to Rule 13.1(e) if not already provided by the claimant."*







Rule 27 ROP

# Examination as to formal requirements by the Registry

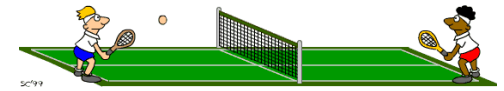


The Registry examines whether the formal requirements have been complied with.

If the Registry considers that the Statement of defence or the Counterclaim for revocation does not comply with any of the requirements referred it invites the defendant to correct the deficiencies noted.



Rule 14 § 4 ROP: *"The Registrar shall return any pleading lodged in a language other than the language of proceedings."*



## Rule 12 ROP

# Exchange of written pleadings

- "1. The written procedure shall consist of:*
- a) the lodging of a Statement of claim (by the claimant) [Rule 13];*
  - b) the lodging of a Statement of defence (by the defendant) [Rules 23 and 24]; and, optionally*
  - c) the lodging of a Reply to the Statement of defence (by the claimant) [Rule 29(b)]; and*
  - d) the lodging of a Rejoinder to the Reply (by the defendant) [Rule 29(c)].*
- ...
- 5. The judge-rapporteur may allow the exchange of further written pleadings, within time periods to be specified [Rule 36]. "**



## End of the written procedure

Any questions before discussing the interim procedure



Contents

# Interim procedure

- The judge-rapporteur
- Interim conference
- Preparation of the oral hearing
- Closure of the interim procedure



# The judge-rapporteur

With thanks to  
Klaus Grabinski



- Designation
  - ▶ by the presiding judge of the panel to which the action has been assigned, Rule 18
- Qualification
  - ▶ legal judge of the panel
  - ▶ presiding judge can designate himself as judge-rapporteur
- Case management
  - ▶ Written procedure, Rule 331.1
  - ▶ Interim procedure, Rule 331.1
  - ▶ Not oral procedure (which is the responsibility of the presiding judge in consultation with the judge-rapporteur, Rule 331.3)
  - ▶ Drafting of the final decision?
  - ▶ Procedure for cost decision, Rule 156.2



# Interim procedure

- Aim
  - ▶ preparation of the oral hearing, Rule 104,
  - ▶ exploring possibilities to settle the dispute
- Case management
  - ▶ Judge-rapporteur is in charge of case management, Rule 101.1, 331.
  - ▶ Judge-rapporteur may refer any matter to the panel, Rule 101.1, 331.2.
  - ▶ Upon request of any party, review of an order of the judge-rapporteur by the panel, Rule 102.2, 333.
- Duration
  - ▶ completion within 3 months, Rule 101.3



## Interim conference

- Interim conference "*where appropriate*", Rule 101.1
  - courtroom conference or
  - telephone or video conference or
  - no interim conference (written procedure only)
- Preparation of the interim conference, Rule 103, by order of the judge-rapporteur to ...
  - provide further clarification on specific topics
  - answer specific questions
  - produce evidence
  - lodge specific documents including summary of orders to be sought at the interim conference.





## Interim conference by videoconference



Letter from Judge Dennis Bailey of Broward County (Florida) to the local Bar association (15/04/2020):

*"It is remarkable how many attorneys appear inappropriately on camera. We've seen many lawyers in casual shirts and blouses, with no concern for ill-grooming, in bedrooms with the master bed in the background, etc. **One male lawyer appeared shirtless and one female attorney appeared still in bed, still under the covers. And putting on a beach cover-up won't cover up you're poolside in a bathing suit.** So, please, if you don't mind, let's treat court hearings as court hearings, whether Zooming or not."*



## Interim conference

- Audio recording (always), Rule 106
- Summons to the oral hearing, Rule 108
- Closure of interim procedure, Rule 110



R 104 ROP

## Preparation of oral hearing

Judge-rapporteur may

- ▶ identify main issues and determine which relevant facts are in dispute
- ▶ clarify the position of the parties as regards those issues
- ▶ explore with the parties the possibilities to settle the dispute or make use of the facilities of the Arbitration Centre
- ▶ issue orders regarding further pleadings and evidence
- ▶ hold preparatory discussions with witnesses and experts
- ▶ make any decision or order as judge-rapporteur deems necessary for the preparation of the oral hearing
- ▶ decide the value of dispute
- ▶ order the parties to submit, in advance of the oral hearing, a preliminary estimate of the legal costs that they will seek to cover



## Decisions and orders of the judge-rapporteur

- preliminary objections, Rule 20
- extension or shortening of time periods for written pleadings, Rule 334 (a)
- other management decisions or orders, Rule 334, like
  - summary dismissal of a claim, if it has no prospect of success, Rule 334 (h)
  - consolidation of any matter or issue or order them to be heard together, Rule 334 (i)
  - allowance of further written statements, Rule 12.5, 36
- request for allocating a technically qualified judge, Rule 34.1, 37.3



## Decisions and orders of the judge-rapporteur

- closure of written procedure, Rule 35 (a)
- necessity of an interim conference
- it is only for the panel to decide over Art. 33 (3) issues  
(when a counterclaim for revocation is brought before a local or regional division, whether
  - ▶ to proceed with both,
  - ▶ to refer the counterclaim to the central division (with or without staying on the infringement) or
  - ▶ to refer the whole case to the central division



Rule 333.2 ROP

# Review of decisions of the judge-rapporteur

- Request for review of case management orders or decisions of the judge-rapporteur by the panel
  - ▶ within 15 days
  - ▶ setting out the ground for review and the evidence
- Decision of the panel can be appealed, Rule 220.2



# Appeal against the decision of the panel to the Court of Appeal

- Together with the appeal against the final decision, Rule 220.2
- Immediate appeal against the decision of the panel, Rule 220.2
  - if leave is granted
  - within 15 days of service of the decision
- Request for a discretionary review to the Court of Appeal
  - if leave is refused
  - within 15 days of service of the decision
  - decision on discretionary review by the standing judge of the Court of Appeal



# Judge Rapporteur

## Example case - infringement

- Claimant is the owner of a EP protecting a tyre sealing preparation.
- The claim provides that the preparation contains
  - ▶ a rubber latex consisting substantially only of natural rubber and
  - ▶ an adhesive resin compatible with the rubber latex.





# Judge Rapporteur

## Example case - infringement

- Claimant sues defendant for infringement of the EP relying on an expert report that the attacked product contains 85 % of natural rubber latex.
- Defendant submits with his defence another expert report that the attacked product contains only 55 % of natural rubber latex.
- Claimant insists that his report is right but also that even on the assumption that defendant's report is correct the product is infringing since 55 % of natural rubber latex is a "*substantial*" amount of the preparation.
- How should the judge-rapporteur deal with the case in the interim conference?



# Judge Rapporteur

## Example case - infringement

What does "*a rubber latex consisting substantially only of natural rubber*" mean?

- ▶ Interpretation of a patent claim from the perspective of an average person skilled in the art at the priority date is a question of law to be decided by the judges.
- ▶ Only general perspective of such a person skilled in the art, like his general abilities, experience is a fact and, therefore, can be the subject-matter of an evidence taking.



# Judge Rapporteur

## Example case - infringement

- How to deal with the diverging pleadings and expert reports on the percentage of natural rubber in the attacked product? This depends on
  - ▶ the interpretation of the patent claim
    - Is 55 % and/or 85 % of natural rubber latex a substantial of the rubber latex?
  - ▶ the cogency of the expert reports
    - Can one or both expert reports be disregarded because the adversary party could show that the underlying test were conducted improperly?
- Depending on the answers the judge-rapporteur may decide that a court expert shall analyse the attacked product with regard to the percentage of natural rubber latex.



# Judge Rapporteur

## Example case

### Counterclaim for revocation

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- Defendant files a counter-claim for revocation.
- He alleges that patent claim 1 is **obvious** having regard to a **US-patent and a Japanese patent application**, both of which have been published before the priority date of the EP. He submits an **expert opinion** that supports his view.
- In his defence to the counter-claim claimant argues that the invention would **not** have been **obvious** for a person skilled in the art since he would have never combined the two patent applications because of their contradictory approach as explained in an **expert opinion** attached to the statement of defence.
- What will the judge-rapporteur do in the interim procedure?



# Judge Rapporteur

## Example case

### Counterclaim for revocation

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- **Disclosure** of a priority art document as well as **the general knowledge and ability of the person skilled in the art** are **questions of fact**.
- **Obviousness**, however, is a **question of law** to be decided by the judges.
- The judge-rapporteur may take the view that the panel will be able to decide on the disclosure of the documents on the basis of the input of the technical judge, pleadings of the parties, the written opinions of the party experts and, possibly, an additional examination of the party experts in the hearing and, therefore, will **not** ask a **court expert** for his opinion.



## End of the interim procedure

Any questions before discussing the oral procedure

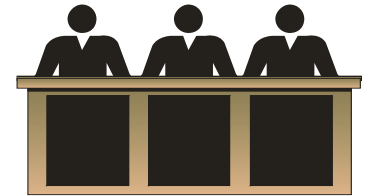


Contents

# Oral Procedure

- Aim
- Role of the presiding judge
- Conduct of the oral hearing
- Decisions on the merits
- Absence of one or both parties
- Interim award of damages





## Aim of the oral procedure

- establishing all facts necessary to make a decision on the merits, cf. Rule 112.2 b); 118
- oral hearing of the parties, Rule 112.2 a)
- completion within one day when possible





## Role of the presiding judge



Case management, conduct of the oral hearing by the presiding judge who

- has all authority to ensure a fair and efficient oral procedure and
- ensures that the action is ready for decision on the merits at the end of the oral hearing, Rule 111.



## Oral hearing: publicity and recording



- Confidentiality issues ?
  - ▶ All the hearing shall be open to public Rule 115
  - ▶ Unless the Court decides to make a confidential hearing (trade secrets exception ?)
- *"The hearing shall be audio recorded. The recording shall be made available to the parties or their representatives at the premises of the Court after the hearing."*



# Structure of the oral hearing



- oral hearing held before the panel
- preliminary introduction by the presiding judge, the judge-rapporteur or any other judge, Rule 112.3
- hearing of the parties' oral submissions
  - judges may put questions, Rule 112.3
  - presiding judge may set time limits for oral submissions, Rule 113.1, 3
- hearing of the witnesses and experts
  - judges and parties may put questions, Rule 112.3
  - limitation to issues identified by the judge-rapporteur or the presiding judge, Rule 113.2
  - separate hearing possible, Rule 113.2



# Duration of the oral hearing



- endeavour to complete within one day, Rule 113.1
- adjournment, when further evidence is required, Rule 114
- In exceptional cases, adjournment of proceedings and call for further evidence possible, Rule 114.



Example cases (continued)

## Conduct of the oral hearing

- The presiding judge or the judge-rapporteur may provide a preliminary introduction with regard to
  - the interpretation of the patent claim (“substantially”)
  - the report of the court expert on the percentage share of natural rubber latex in the attacked product
  - obviousness with regard to the US patent and the Japanese patent application
- Parties’ representatives plead the case.



Example cases (continued)

## Conduct of the oral hearing

- First judges and then party representatives may ask questions to the court expert with regard to his written report.
- Possibly, judges and parties' representatives ask questions to the party experts with regard to the disclosure of the 2 documents.
- Final submissions of parties' representatives.
- Presiding judge sets a date for the issuance of the decision on the merits.
- Closure of oral hearing



# Outstanding question: the judges' robe?



# Outstanding question: the judges' robe?





## End of the oral procedure

Any questions before discussing the judgment



Contents

# The judgment

- Infringement
- Parallel actions pending
- Revocation
- Damages
- Costs



# Decisions on the merits : Infringement

- permanent injunction, art. 63, Rule 118.1
- corrective measures, art. 64, Rule 118.1
  - declaration of infringement
  - recalling/removing the products from the channels of commerce
  - depriving the product of its infringing property/destroying the products
- communication of information, art. 67, Rule 118.1
  - origin and distribution channels of the products or process
  - quantities, price of the products, etc.
- award of damages, art. 68, Rule 118.1
  - amount of damages stated in the order or
  - determined in later proceedings, Rule 118.1, 125 et seqq.
- publication of decisions, art. 80, Rule 118.1



# Decisions on the merits: Parallel revocation action or parallel opposition pending

- Decision on the merits of the infringement claim may be rendered under the condition that the EP is not held to be wholly or partially invalid by a final decision, Rule 118.3 a), or
- Infringement proceedings
  - ▶ may be stayed
  - ▶ shall be stayed when there is a high likelihood of success that the patent is held to be wholly or partially invalid by
    - the final decision in revocation proceedings or
    - of the EPO where such decision may be expected to be given rapidly, Rule 118.3 b).



Art. 65 UPCA, Rule 118.3 ROP

## Decisions on the merits: revocation

*"(2) The Court may revoke a patent, either entirely or partly, only on the grounds referred to in Articles 138(1) and 139(2) of the EPC.*

*(3) Without prejudice to Article 138(3) of the EPC, if the grounds for revocation affect the patent only in part, the patent shall be limited by a corresponding amendment of the claims and revoked in part."*

*"3. Where, in the decision on the merits of a revocation action, the patent is found to be entirely or partially invalid, the Court shall revoke the patent entirely or partially according to Article 65 of the Agreement."*



## Decisions on the merits: costs

- Decision on costs in principle, art. 69, Rule 118.7
  - separate proceedings for cost decision, Rule 150 et seqq.
  - court may order in advance that parties submit a preliminary estimate of the legal costs that they will seek to recover compensation of court fees paid by the successful party, Rule 150.1
- Enforceability and security
  - order of security, Rule 118.9, 352
  - notification of enforceability by successful party, Rule 118.9



## Absence of one or both parties

- Absence of a party from the oral hearing
  - Court is not obliged to delay any step in the procedure, including the decision on the merits, Rule 116.2
  - A party not represented at the oral hearing shall be treated as relying only on its written case, Rule 116.3.
  - Only in exceptional cases, adjournment Rule 116.4
  - No prejudice to the power of the court to give a default decision pursuant to Rule 355-357
  
- Absence of both parties from the oral hearing
  - after information of the Registry
  - the court shall take a decision on the merits
  - on the basis of the pleadings and evidence submitted by the parties and the court expert, if applicable.



## Interim award of damages

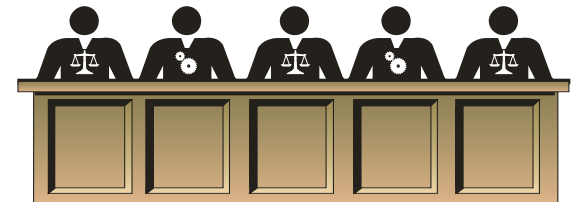
- The Court may order an interim award Rule 119
  - Anticipation of possible final decision
  - The Court may subordinate that to any condition
  - The amount should cover at least:
    - the expected cost (not only the cost already incurred) of the procedure for the future damage,
    - the compensation on the part of the successful party.
  
- Possible Reasons ?
  - Allow an SME to continue with the procedure for the award of damages
  - Reduce the financial exposure of the claimant in case the defendant gets bankrupt
  - Stimulate a possible settlement





## End of the judgment

Any questions before discussing the appeal proceedings



Contents

# Proceedings before the Court of Appeal



- The Court of Appeal
- Appealable decisions
- Subject matter of appeal proceedings
- Referral to the full Court of Appeal
- Decision
- Application for rehearing



Luxembourg

# The Court of Appeal

ECJ



Unified Patent Court  
Court of Appeal



Art. 9.1 UPCA

## The Court of Appeal

*"(1) Any panel of the Court of Appeal shall sit in a multinational composition of five judges. It shall sit in a composition of three legally qualified judges who are nationals of different Contracting Member States and two technically qualified judges with qualifications and experience in the field of technology concerned."*



## Rule 220 ROP

# Appealable decisions

*"1. An appeal by a party adversely affected may be brought against:*

- a) final decisions of the Court of First Instance;*
- b) decisions terminating proceedings as regards one of the parties;*
- c) Orders referred to in Articles 49(5), 59, 60, 61, 62 or 67\* of the Agreement."*

*\* Language of proceedings, production and preservation of evidence, freezing order, provisional and protective measures, communication of information*



## Rule 222 ROP

# Subject-matter of the proceedings before the Court of Appeal

- *“1. Requests, facts, evidence and arguments submitted by the parties under Rules 221, 225, 226, 236 and 238 shall, subject to paragraph 2, constitute the subject-matter of the proceedings before the Court of Appeal. The Court of Appeal shall consult the file of the proceedings before the Court of First Instance...”*



Rule 222 ROP

# Subject-matter of the proceedings before the Court of Appeal

*"2. Requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance may be disregarded by the Court of Appeal..."*



Rule 222 ROP

## Subject-matter of the proceedings before the Court of Appeal

*"When exercising discretion, the Court shall in particular take into account:*

- a) whether a party seeking to lodge new submissions is able to justify that the new submissions could not reasonably have been made during proceedings before the Court of First Instance;*
- b) the relevance of the new submissions for the decision on the appeal;*
- c) the position of the other party regarding the lodging of the new submissions."*





## Rule 238 A ROP

# Referral to the full Court of Appeal

- *"The panel to which the action has been assigned may refer it to the full Court of Appeal if the panel considers, on a proposal from the presiding judge, the case to be of exceptional importance and, in particular, where the decision in the action may affect the consistency and unity of the case law of the Court."*
- The full Court shall comprise the President of the Court of Appeal and not less than 10 (legally and technically qualified) judges of the Court of Appeal
- Similar to *en banc* decisions in the US



Rule 242 ROP

## Decision of the Court of Appeal

*"The Court of Appeal shall either reject the appeal or set the decision or order aside totally or in part substituting its own decision or order, including an order for costs both in respect of the proceedings at first instance and on appeal."*



## Rule 242 ROP

# Decision of the Court of Appeal

*"2. The Court of Appeal may:*

*a) exercise any power within the competence of the Court of First Instance;*

*b) in exceptional circumstances refer the action back to the Court of First Instance for decision or for retrial [Rule 243]. It shall not normally be an exceptional circumstance justifying a referral back that the Court of First Instance failed to decide an issue which it is necessary for the Court of Appeal to decide on appeal."*



Art. 81 UPCA, Rule 245 ROP

## Application for rehearing

*“(1) A request for rehearing after a final decision of the Court may exceptionally be granted by the Court of Appeal in the following circumstances:*

*(a) on discovery of a fact by the party requesting the rehearing, which is of such a nature as to be a decisive factor and which, when the decision was given, was unknown to the party requesting the rehearing; such request may only be granted on the basis of an act which was held, by a final decision of a national court, to constitute a criminal offence; or*

*(b) in the event of a fundamental procedural defect, in particular when a defendant who did not appear before the Court was not served with the document initiating the proceedings or an equivalent document in sufficient time and in such a way as to enable him to arrange for the defence.”*



## End of the appeal

Any questions before drinks



**Pierre Véron**

**Thank you**



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