Europe-wide patent protection and the competence of the Unified Patent Court

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by

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Europe-wide patent protection and
the Unified Patent Court

I. Status quo

1. National patent

– Filing with national patent offices
  • e.g. German Patent and Trade Mark Office (Deutsches Patent- and Markenamt), Intellectual Property Office in UK.

– Protection in state of registration
  • e.g. Germany or UK

– National courts competent to hear actions for infringements and annulment
  • e.g. in Germany the competent regional court for patent infringement cases, the Federal Patent Court for patent annulment cases; in the UK the High Court (Patent Court) or Intellectual Property Enterprise Court (formerly Patents County Court) for patent infringement and annulment cases.
I. Status quo

2. European patent

- **European Patent Convention (EPC) of 5 October 1973**
  - revisions of 17 December 1991 and 29 November 2000
  - currently 38 contracting states

- **Central filing, opposition and appeal procedures at the European Patent Office (EPO)**

- **Language of proceedings**
  - at choice of applicant: German, English or French

- **Protection in EPC contracting states like a national patent:** Articles 2(2) and 64(1) EPC ("bundle patent")

- **Decentralised infringement and nullity proceedings before national courts in the contracting states**
  - as for national patents, cf. slide 2
I. Status quo

- Cross-border infringement proceedings
  - only permissible if the validity of the disputed patent is uncontested.
  - Otherwise only the state for which the patent was issued is competent: Article 22(4) of the Brussels I regulation, see CJEU, 13/7/2006 – C-4/03 – Gat/LUK;
  - partial difference for provisional measures under Article 31 of Brussels I, see CJEU, 12/7/2012 – C-616/10 – Solvay/Honeywell.
II. Unitary patent protection

**Regulation (EU) No 1257/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection**

- **Participating Member States (PMS)**
  - 25 EU Member States, excluding Spain, Italy and Croatia
- **Contents**
  - Reg. 1257/2012 = agreement within the meaning of Art. 142 EPC
  - European patent with unitary effect (EPWEU)
  - Exhaustion
  - EPWEU as an object of property
  - Administration of the EPWEU through the EPO
- **Entry into force and application**
  - Came into force on 20 January 2013
  - Valid from entry into force of the UPC Agreement
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II. Unitary patent protection

**Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements**

- Participating Member States (PMS)
  - as for Regulation (EU) No 1257/2012
- Contents
  - translation arrangements for EPWEU and EP under Article 65 EPC and, where relevant, the London Agreement of 17 October 2000 on the application of Article 65 EPC
  - translation for litigation on infringements
    - respondent’s choice of the language of the PMS at the place of the infringement or of the domicile of the respondent
  - transitional measure
- Entry into force and application
  - as for Regulation (EU) No 1257/2012
III. Unified Patent Court

Agreement on a Unified Patent Court

- International treaty signed on 19 February 2013
- Contracting states
  - 25 EU Member States, excluding Spain, Poland and Croatia
  - open to accession by further EU Member States, but not to “EPC only” states such as Switzerland and Turkey
- Entry into force
  - on 1 January 2014 or
  - on the first day of the fourth month following
    a) ratification by or accession of 13 EU Member States, including Germany, France and the UK, and
      - so far ratified by Austria, Belgium, Denmark, France and Sweden
    b) Amendments to Regulation No 1215/2012 (Brussels I)
      - implemented by Regulation No 542/2014 of 15/5/2014
III. Unified Patent Court

Competence

Resolution of disputes concerning

- European Patents
  - “Bundled patents” (see slide 3)

- European patents with unitary effect
  - in accordance with Article 142 EPC
  - Regulations (EU) 1257/2012 and 1260/2012 of 17/12/2012 (see slides 6 and 7)
III. Unified Patent Court

Patent map of Europe
III. Unified Patent Court

Structure of the court
Europe-wide patent protection and
the Unified Patent Court

III. Unified Patent Court

Competence of the divisions

➤ Specialist competence (types of case)
  – Local or regional division
    • Actions for infringement
    • Counterclaims for invalidity
    • Applications for orders for provisional measures
    • Actions for damages/compensation
  – Central division
    • Actions for invalidity
    • Action to establish non-infringement
III. Unified Patent Court

Territorial competence

Local or regional division of the contracting Member State (CMS)

- of the location of the actual or impending infringement or
- where the respondent is domiciled.

- In a CMS where there is no local division or affiliation to a regional division, cases are heard before the central division.
- If the respondent is not domiciled in a CMS the case for infringement can be heard
  - before the local or regional division of the location of the actual or impending infringement or
  - before the central division.
Europe-wide patent protection and the Unified Patent Court

III. Unified Patent Court

Composition of the divisions

➢ Local and regional divisions
  – 3 legally qualified judges
    • 1 – 2 from the host contracting Member State(s) (HCMS),
      1 – 2 from other CMS
  – 1 technically qualified judge, if
    • a counterclaim for invalidity of the patent is to be heard or
    • one of the parties or the court requests it

➢ Central division
  – 2 legally qualified judges
  – 1 technically qualified judge
III. Unified Patent Court

Language of proceedings

➢ Local and regional divisions
  – Official language of the HCMS
  – A working language of the EPO (German/English/French) at the discretion of the HCMS.
  – Agreement of the parties on the language for patent proceedings with approval by the court.
  – On application by one of the parties a decision on the language of the proceedings is made by the president of the court of first instance.

➢ Central division
  – Language of patent proceedings
III. Unified Patent Court

Possible distribution of divisions and proceedings

Central division:

- Paris, sections in London (human necessities, chemistry, metallurgy) and Munich (mechanical engineering) (language of patent proceedings)

Local divisions:

- Belgium: 1 (German, English, French, Dutch)
- Denmark: 1 (Danish and English)
- Finland: 1 (Finnish, Swedish and English)
- France: 1 (French)
- Germany: 4 (German/English)
- Italy: 1 (Italian)
- Netherlands: 1 (Dutch/English)
- United Kingdom: 2 (English)

Regional divisions

- Sweden/Estonia/Latvia/Lithuania (English only)
- Romania, Bulgaria, Cyprus and Greece (all official languages and French and English)
- Czech Republic and Slovakia (official languages and English)

No membership of a local or regional division:

- Luxembourg and Malta

Undecided:

- Poland, Portugal, Austria, Ireland, Slovenia and Hungary
III. Unified Patent Court

Rules of procedure (17th draft of 31 October 2014)

− Preamble
− Application and interpretation of the rules (R. 1 – 9)

I. Proceedings before the court of first instance (R. 10 – 157)

1. Written proceedings
2. Intermediate proceedings
3. Oral proceedings
4. Proceedings at a higher level (compensation and redress)
5. Proceedings for costs

II. Evidence (R. 158 – 202)

1. Witnesses and expert witnesses for the parties
2. Expert witnesses for the court
3. Submission of evidence
4. Preservation of evidence
5. Further evidence

III. Provisional measures (R. 205 – 213)

IV. Proceedings before the court of appeal (R. 220 – 254)

1. – 3. Written, intermediate and oral proceedings
4. Decisions
5. Reopening proceedings

V. General provisions (R. 260 – 365)

VI. Fees and legal aid (R. 370 – 382)
III. Unified Patent Court

Representation:

a) A lawyer authorised by a court of a CMS.

b) A European patent agent who
   – is authorised under Article 134 to act as a professional representative in proceedings before the EPO and
   – holds the required additional qualification.
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III. Unified Patent Court

Transitional measure

- During a **transitional period of 7 years** from the entry into force of the agreement, actions for infringement or invalidity can still be brought before national courts, Article 83(1).

- Unless an action has already been brought before the court, a proprietor of or applicant for a European patent granted or applied for prior to the end of the transitional period can **opt out** from the exclusive competence of the court, Article 83(3).
III. Unified Patent Court

Preparatory Committee (PC)

– Basis
  • Supplementary declaration by the Member States which concluded the agreement

– Home page
  • http://www.unified-patent-court.org/

– Groups under the PC
  • Legal
  • Financial
  • IT
  • Facilities
  • Human resources and training
IV. Training centre in Budapest

Thank you for your attention!