

15TH DRAFT OF THE RULES OF PROCEDURE OF THE UNIFIED PATENT COURT DATED 31 MAY 2013

Comments from the Council of Bars and Law Societies of Europe (CCBE)

18/10/2013

Introduction:

The Council of Bars and Law Societies of Europe (CCBE) is the representative organisation of around 1 million European lawyers through its member bars and law societies from 31 full member countries, and 11 further associate and observer countries. The CCBE received a draft of the Rules of Procedure for the EU patent court. The CCBE is keen to provide constructive input into the development of the Rules. We attach (a) Comments which follow the numerical sequence of the Rules, and (b) "General Comments" which elaborate in more detail, on a number of points.

We hope our comments are of assistance, and we would appreciate being kept informed of developments. We also welcome the opportunity to meet or to answer any questions that may arise from our comments.

A: Comments which follow the numerical sequence of the Rules

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|----------|---|---|
| 4-12 | | We propose that the index be tidied up. Items and headings missing include: Rule 6, Chapter 2 (before rule 101), Chapter 3 (before rule 111), Chapter 2 – Court experts (before rule 185), Chapter 4 (before heading "Order to preserve evidence (Saisie)" before rule 193), Part 3 (before rule 205), Chapter 1 (before section 1 before rule 224), Section 1 (before rule 273), Chapter 5 (before rule 309), Chapter 6 (before Section 1 before rule 302), Chapter 11 (before rule 355), Chapter 12 (before rule 360). | |
| 12 | PREAMBLE | Final paragraph on page 12. It is noted that proceedings are intended to be completed within about 1 year (more or less). In reviewing the time limits in the Rules we propose that consideration be given to whether this is achievable given the proposed periods of time for each step in the proceedings. | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|----------------|--|---|
| 13 | 1.1 | The rules should reflect the Agreement. This may be significant, for example, in relation to Rule 5. | |
| 13 | 4 | This requires that the official forms be available on line. A provision should be inserted to provide parties with redress should the official forms not be available on line, for whatever reason. | |
| 14 | 5.1 | This provides that the application "shall" be made in respect of each of the contracting member states by the proprietor in question. This appears to permit different proprietors of different designations of European patents to behave differently as to whether or not to opt out. This is a contentious issue. On one reading of Article 83(3) a different application can be made in respect of different contracting member states even when one proprietor owns all the designations. CCBE's position is as set out in general comment 7(c). But in any event, the rules should make it clear what the position is. | |
| 14 | 5.2 (a) | It is suggested that provision of postal or electronic addresses is not required. We propose that paragraph 2 simply specifies that the applicant shall complete the relevant form. | |
| 14 | 5.3 | See general comment 7. | |
| 14 | 5.5 | We propose it is made clear when is an action said to have been "commenced". Compare r.17.3 which talks about when "proceedings are pending before Court". It should be made clear whether the date in r.5.5 is the same as in r.17.3. | |
| 14 | 5.7 | There does not appear to be any basis in the agreement for saying that a party can only opt out once. We propose that this rule be deleted because it is inconsistent with the Agreement. | |
| 14 | 5.9 – Optional | <p>The European Patent Office is not under the control of the CJEU. We therefore make the following comments. If the provision is included it should be amended to take account of these comments:</p> <p>If the EPO fails to do something which it is required to do, it is not clear to CCBE against whom this redress should lie.</p> <p>There needs to be a procedure for rectification of the register e.g. if the EPO transferred a corrupt file with certain details missing could the person who had made an application to the EPO and paid the fee and had it accepted, require the register to be correct? Thus, for example, if a patentee had filed the necessary information in relation to an opt out at the EPO but that information had not been transferred to the Court so that the register of the Court was not accurate, it should be open to the patentee to require the register to be corrected. This might be important, for example, if after the</p> | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|----------------|--|---|
| | | opt out was recorded by the EPO a third party commenced patent proceedings at the UPC. | |
| 15 | Note to Rule 5 | The CCBE consider that (ii) and (iii) are both open to question in the light of Article 83. | |
| 15 | 6 | The need to correct the index to include Rule 6 has been noted above. | |
| 15 | 6.3 | We propose that the rule be amended to make clear the sanction if a party fails to give notice of a change of postal or electronic address. | |
| 15 | 7.1 | Written evidence should be submitted (in original or in copy) in the language in which it was originally given. | "Written pleadings and other documents, including written evidence, shall be lodged in the language of the proceedings, unless the Court or these Rules otherwise provide. Other documents, including written evidence, shall be lodged in their original language, with a translation (in part or of the whole document) in the language of the proceedings"" |
| 15 | 7.2 | The rule should make it clear how and when the accuracy of a translation can be challenged. We propose that it should be clear whether it is done, for example, at the start of the oral proceedings or whether there be a time limit on how late such a challenge can be made. If a challenge is made, the rule should provide a time limit for the person providing the translation to provide a formal testament. | |
| 15 | 8.1 | We propose that it is not necessary for a party to be represented where the party seeks to overturn an ex parte injunction. The urgency should enable the party to take steps (e.g. apply to lift the injunction) before the party identifies and instructs a representative. We propose that consideration is given to the Legal Aid provisions and how quickly it could be granted in such a situation. | |
| 16 | 8.2 | See comments on Rules 290/291 below. It is not clear to the CCBE whether the sanctions available to ensure that representatives behave as they ought to before the Court are enough. | |
| 16 | 9 | It should be made clear whether the defence of privilege applies to Rule 9.1. See Rules 287 to 289. It should be made clear whether there is privilege against self-incrimination, privilege related to national security etc. The rules need to be made clear so that all divisions of the Court will apply a | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-----------------|--|---|
| | | <p>consistent approach.</p> <p>It should be made clear whether the defence of privilege applies to Rule 9.1. See Rules 287 to 289. It should be made clear whether there is privilege against self-incrimination, privilege related to national security etc. The rules need to be made clear so that all divisions of the Court will apply a consistent approach.</p> <p>There should be room to justify and excuse a late submission. To be completely barred from submitting arguments or evidence would be out of proportion. Therefore it would be helpful to give a non-exhaustive list of factors a court should consider before rejecting late filed evidence etc.</p> | |
| 16 | 9.4 | We propose the rule be amended to allow for any time period to be extended in circumstances beyond the control of a party. | |
| 16 | 10 (b) | The interim conference appears to be optional. The rule should make it clear on what basis the option is to be exercised. See also r.101.1. | |
| 16 | 11.1 | It is unclear why the only proposal mentioned which the Court can make is to use the Mediation and Arbitration Centre. We propose that the rule be amended to allow for other formal or informal settlement discussions. | |
| 17 | 11.2 | The Parties may not wish to inform the Court of "the terms of any settlement" but rather ensure that it is kept confidential. We propose that the rule be amended accordingly. The rule should not enable a third party to try to force the parties to disclose the terms to the Court, which may then have to be made public. | |
| 17 | 12.1 | The rules should make it clear whether every assertion made by one party is accepted unless specifically disputed. In other words, does every assertion in a pleading need to be answered? It appears that assertions in evidence must be challenged; see our comments in relation to r.171.2. | |
| 17 | 12.3(b) and (c) | The references should be to Rule 29 not Rule 51/52 (which relate to revocation actions). | Replace "51" and "52" with "29". |
| 17 | 12.4 | We propose that Applications to amend the patent should be published or advertised, bearing in mind that this affects the whole world and not just the parties to the proceedings. A provision should be inserted to require that the EPO be informed so that a note may be entered into the register. | |
| 18 | 13.1(b) and (d) | We propose that a provision is included to deal with the case where either the name or the true name of the Defendant is not known and/or the postal (or electronic address) for service is not known. | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|--------------|---|---|
| 18 | 13.1(h) | We propose that it is only necessary to provide information about any prior or pending proceedings relating to the patent concerned before the Court. It is not necessary to provide information relating to any other proceedings. | Under 13.1(h) Delete ", the European Patent Office or any other authority," |
| 18 | 13.1(l) | We propose this should read "an indication on the facts relied on, including in particular" to make it clear that the list is non-exhaustive? | Insert "including" after "an indication on the facts relied on,". |
| 19 | 13.1 (p) | We propose the rules be amended to make it clear on what basis the value of the infringement action is to be ascertained. This, presumably, affects the fees. We propose the rule be amended to make it clear whether a change in fee is possible if the value is wrong or it becomes clear that it should be changed. It should make it clear whether a claimant who realises they have a claim for £10m instead of £100,000 is required to pay a new fee. | |
| 19 | 14 generally | This rule has been changed significantly since the 14th draft. The previous provisions were preferable. In particular Rule 14(b)(ii) should be reinstated. | |
| 19 | 14.2 | If this provision is to be retained (and we suggest it should not be) although it may be implicit, the rule also needs to state that the choice of language can only be one of the languages of the division in question, and not, for example, Mandarin Chinese. Also, the rules should deal with the case in which there is more than one Defendant and which language can (or must) you use. | |
| 20 | 16.2 | We propose that this rule should be amended to include all of the requirements in Rule 13 (a-q) rather than just (a-j). Otherwise, it appears possible to commence proceedings with fewer, if any, of the details in (k) to (q). | |
| 20 | 16.5 | The rule should be amended to deal with the situation when the Claimant is not given an opportunity to be heard. An opportunity to be heard is currently only optional. We propose amending "He" to "The judge". | |
| 20 | 17.2 | We propose the rule be amended to specify the basis on which the panel "agree", i.e. whether it is by a majority or whether it requires unanimity. The rule should make it clear who is "the most senior judge". Is it simply the oldest by date of birth or the judge appointed first? If the latter, will all the initial appointments be placed in an order of seniority? If so what is the basis of this order? Under r.345, there is a very prescriptive method for the constitution of panels. It seems to be envisaged that they will sit together for one year, but if a case is started even only a month or two after the panel is first convened, and allocation is | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|------|---|---|
| | | <p>effected at the outset of an action as r.17.2 envisages, the one year period when the panel is together will have expired before the case comes to trial (oral hearing). We propose, accordingly, that either r.17.2 or r.345 requires a fundamental re-think. We propose that one possibility is that allocation is required only to a Judge Rapporteur until the entire panel needs to sit – which will often not be until the interim conference, may be some nine months into the action. Hopefully it will be possible to organise panels so that they can hear at least the interim conference and the trial. We also see no reason for panels continually to sit together, but rather that there be greater fluidity which will encourage greater standardisation of practices. If so, r.345 should be heavily amended so that panels are not compelled to sit together for every case for an extended period.</p> <p>As a counterclaim for revocation affects the general public and not just the parties to the dispute it is suggested that it should not be possible for such counterclaims to be heard by a single legally qualified judge even if both parties agree.</p> <p>In r. 345 the basic idea is a panel of three judges, i.e. six eyes. This special idea would be jeopardized if the rules allow changes in the panel for any particular dispute (unless that became necessary e.g. because a judge became unavailable): It is noted that there would be a significant additional workload for a new judge in the panel if he had to make himself familiar with all open files.</p> | |
| 20 | 17.3 | <p>We propose that it should be made clear how this Rule compares with r.5.5 which refers to proceedings being "commenced". If these two dates are intended to be the same then there should be an explicit cross-reference.</p> | |
| 21 | 19.1 | <p>We propose that a reference is included to actions brought in respect of patents which have expired (including due to non-payment of renewal fees); and expiry of a limitation period.</p> | |
| 21 | 19.1 | <p>Given rule 300, we propose that it would be better to define this (and indeed all) time periods in weeks and/or days. Much effort has been wasted in the EPO deciding issues concerning calculation of periods of months in conjunction with dates of deemed service.</p> | |
| 21 | 19.4 | <p>We propose that the rule make it clear at what date must the infringement occur in the "three or more regional divisions"? We propose the rule make it clear whether or not the one month rule of 19.1 applies to 19.4 requests.</p> <p>We also propose that it be made possible to transfer the case to another (competent) local or regional division or to the central division, should the division chosen by the plaintiff according to Art.</p> | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|---|---|
| | | 33 of the agreement either not be competent or is competent but is an inappropriate division to hear the case. | |
| 22 | 20.1 | <p>The reference to Rule 19.4 appears to be wrong. This rule contains no time limit and concerns requests to transfer to central division. We suggest the reference should be to r.19.5.</p> <p>It is not clear where the hearing takes place. We propose there should be general instructions about how and where hearings are conducted. For example, might this be a telephone hearing or would a party (possibly an SME) have to travel across the whole of Europe to get to this hearing?</p> | Replace "19.4" with "19.5". |
| 22 | 22 | We repeat the comment in relation to r.13.1(p) on how an infringement action's value is determined. The rule should make it clear on what basis can the judge rapporteur make the determination and from where the judge gets the information to support the determination. | |
| 23 | 25.1(b) | We propose that "The grounds of revocation" rather than "one or more" would make it clear that all the asserted grounds should be set out. | "The grounds of revocation" rather than "one or more". |
| 23 | 25.1(f) | We repeat the comment in relation to r.22 regarding the assessment of the value of a claim/dispute. | |
| 24 | 25.3 | <p>This rule covers two situations. The first is where only one, but not all, patent proprietors are parties. In this case, we suggest that the rule is satisfactory as drafted, because a counterclaim for revocation is permitted. The second situation, however, is that the action is brought by a licensee (only) under Art 47(5). In this case, no counterclaim is permitted according to Art 47(5). Arguably Art 47(5) then requires a Central Division action against the proprietor. However, if and to the extent that the rule assumes that Art 47(5) does not prescribe such a Central Division action, then at the very least we propose that the rule be divided into two for clarity and to cater for the two very different situations. The rule should prescribe that the defendant should be permitted to join the patentee into the proceedings, and then begin a claim (not counterclaim) against the proprietor for revocation. We suggest that joinder of the patentee must precede the commencement of the revocation action, or else Art 47(5) will surely render the rule ultra vires in the case of licensee actions.</p> | |
| 24 | 26 | In almost every significant patent dispute the party accused of infringement will defend itself by attacking the validity of the patent, even if only to apply a squeeze on the patentee's construction of the claims. Accordingly, we suggest that a defendant who raises a counterclaim for revocation | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|--|---|
| | | of the patent should not be required to pay a fee. | |
| 24 | 27.4 | We repeat the comment in relation to r.16.5. | |
| 25 | 28 | It is noted that given the timings permitted under rules 13 and 29, in order for the written procedure to be guaranteed to be completed before the interim conference, the date to be set for that date must be no less than seven months after commencement of proceedings. The rules should make it clear whether the alternative date be proximate to the date of the oral hearing, or (for example) many months later. | |
| 25 | 29 | | Delete repeated "the" in second line to read "revocation, the proprietor...." |
| 25 | 29(c), (e) | We propose the rule makes it clear that the limitation that the Rejoinder shall be limited to matters raised in the Reply set out in Rule 29(e) applies equally to the Rejoinder under Rule 29(c). | |
| 26 | 30 | We repeat the comment in relation to r.12.4 relating to publication of applications to amend. | |
| 26 | 30.1(a) | We suggest that the reference be to r.14.3 rather than r.14.2. | Replace "14.2" with "14.3". |
| 26 | 31.1 | We propose the rules make it clear the basis on which the value of the dispute will be assessed. | Delete "(" before "where". |
| 28 | 37.1 | If the parties dispute any decision to be taken at this stage (and this may be a hotly disputed issue) then we propose that it would be best decided at the interim conference (the date of which will already be fixed under r.28 very shortly after the close of the written procedure). This will be procedurally more efficient. | |
| 28 | 37.2 | It is noted that this is a new addition to the rules. It presumably caters for the situation where the parties are agreed on a course of action according to their pleadings. If this is the thinking of the Rules Committee, then we propose it should specify that in the event of agreement between the parties, the Court may make an Order under Art 33(3) accordingly. | |
| 28 | 37.4 | We note that the Preamble to the Rules states that 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. Whilst constrained by Art 33(3), we suggest that if the action is stayed, a new provisional date for the oral hearing for the trial is reserved. We question how detailed the enquiry of the Court at this stage to assess the likelihood of invalidity | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|--------------------------------------|-----------------|--|---|
| | | will be. We suggest that this may just increase costs. We propose it should be made clearer that all of the patents must be highly likely to be invalid for a stay to be compulsory. It should be made clear whether the action may continue in part if not all patents are clearly invalid. | |
| 28 | 37.4 | In order to avoid conflict between a final revocation decision and a previous infringement decision, the court should stay the infringement proceedings if there is reasonable suspicion of invalidity. | "shall stay the infringement proceedings where there is a high likelihood reasonable suspicion 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." |
| 28 | 38 (a) | It is questionable whether the parties should be allowed to request that the counterclaim for revocation be heard by a single legally qualified judge. In revocation proceedings technical expertise is required. Not all legally qualified judges will have sufficient technical expertise. The concept of having technical judges could be diluted if one legally trained judge acting alone could revoke a patent. As revocation affects the world at large we suggest that the option for both parties to agree upon this concept should be deleted. The same applies to rule 41 (a). | |
| 29 | 40 | We propose that old r.40(b) should be reinstated to ensure that there is no gap between the infringement trial and the revocation trial. Alternatively, an addition should be made to r.38(d) requiring the oral hearing of the revocation action to be heard as closely as possible to the date of the oral hearing of the infringement action. | |
| Section 2 – Revocation Action | | | |
| 30 | 43 | Where there is more than one proprietor, we propose that the rules should make it clear whether the revocation action has to be directed against all of the proprietors. | |
| 30 | 44.1(c) and (d) | | Add parentheses for consistency with 1(a) and 1(b): "...Defence to revocation (by the claimant) [Rule 51]" and "...Rejoinder to the Reply (by the defendant) [Rule 52]" |
| 30 | 44.2(b): | It appears from r.13.1(f) that where there is more than one proprietor, a counterclaim for infringement can be brought by one of the proprietors alone. This should be clarified. The reference to a counterclaim for infringement by | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|----------------------|---|---|
| | | an exclusive licensee pre-supposes that it has notice of the action and has been added as a party. The former is a contractual matter between patentee and licensee as to what notice is given, but we propose that the rule should specifically permit an exclusive licensee (and possibly any non-exclusive licensee with the right to sue) to become a party, and bring a claim (not counterclaim) against the applicant for revocation. We suggest r.49.2(b) needs amending along the same lines. | |
| 30 | 44.3 | | Change "defendant" to "claimant". |
| 31 | 46.2 | The references are to old draft numbering and need updating. | Change "Rule 14.1(a)(ii), (b)(ii), (c) or (d)" to "Rule 14.1(a), (b) or .2" |
| 31 | 46.3 | This refers to Rule 14.5 which does not exist. | "Rule 14.3 shall apply mutatis mutandis" |
| 32 | 49.2(b) | See our comments in relation to r.44.2(b). | |
| 33 | 56 first note in box | The first part of the note in the box (re rules 33 and 34) pre-supposes that a revocation action can be taken in a local or regional division, whereas it is only possible in the central division (where there is already a technical judge). We suggest this provision is deleted. | Delete provision. |
| 34 | 58.2 | | Change "[Rules 370,2(b\ and ...]" to "[Rules 370.2(b) and ..." |
| 34 | 60.1(a) and (b) | We propose that it should not be permissible to seek a DNI from a licensee and the references to the licensee in both rules should be deleted. | |
| 36 | 67 | This title of rule 67 suggests that it could be possible to file a "Defence to Counterclaim" so that a counterclaim (for patent infringement) would be possible in an action for a declaration of non-infringement. But neither Rule 67, nor other Rules of Procedure, nor the Agreement provide that the defendant to an action for a declaration of non-infringement can raise a counterclaim for infringement. | To add that the defendant to an action for a declaration of non-infringement should be able to raise a counterclaim for infringement. |
| 37 | 70.3 | There is no reason to require a stay. Art 33(5) does not require this (in contrast to Art 33(6)). The fact that the stay may be lifted under r.70.4 is not an answer to this. No stay should be imposed in the first place. We therefore propose this rule should be amended, accordingly, to remove the requirement for a stay. | |
| 38 | 80.1(c) | The reference to requiring the application to contain "the licence agreement" is otiose: Art 8(2) is a contractual licence, and the licence itself will not exist unless terms are agreed. It is when terms are | Delete "The licence". Replace with "All written communications evidencing |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|--|--|
| | | not agreed that an application for compensation will be made. We suggest the words "the licence" be replaced with "All written communications evidencing attempts to reach an". | attempts to reach an". |
| 38 | 85 | We propose the wording should be made more consistent with r.10. Also, it should be made clear whether damages and costs orders are available. As currently drafted the only costs available appear to be the fee (r.91(2)). It should be made clear whether there is any time limit for such actions. | Amend to include "subject to rules 116 and 117" and to add provision for damages and costs orders if applicable. |
| 39 | 88 | It should be made clear, if the application is brought by a person who is not the proprietor, whether the claimant or Registry is required to notify the proprietor. See our comment in relation to r.90. | |
| 40 | 90 | See our comment in relation to r.88. We propose adding a provision requiring the Registry to inform the proprietor of the patent of the application. | 90(d) Change "indicating" to "indication" |
| 41 | 92 | We propose that the President has the power to decide that the action should be assigned to a single judge. This may be preferable in order to allocate Court resources most efficiently. The rule should make clear, where the action is assigned to a single judge, whether that precludes its subsequent referral to a panel under r.102. The interaction between these rules is unclear. Also, the rule should make it clear, if there is a single judge, whether he is automatically the judge-rapporteur. | |
| 42 | 95 | It appears that Rules 95 and 96 relate only to Section 6 (i.e. only relating to actions against decisions of the EPO). We propose that there should therefore be a Rule on interpretation of the Rules including, e.g. whether the Parts, Sections, Chapters or rule headings are to be taken into account. | |
| 42 | 96 | See comment in relation to r.95 above. | "...decide whether this has been a breach of Article 9 and what Order shall be made in accordance with ..." OR "decide the Lex specialis..." |
| 43 | 101 | We propose that amendments are made to make it more clear that Chapter 2 of Part 1 begins at rule 101. It would also be helpful to refer to this chapter in other parts of the rules to make it clear that Chapter 2 contains rules which apply to all types of actions. | Mark in the index "Chapter 2" above rule 101. Refer to Chapter 2 at rule 10(b). |
| 43 | 103 | We propose that, in the absence of an interim conference, the parties should have a say in what further documents/evidence should be produced under rule 103(a)-(d). Arguably the parties should be able to provide information relevant to any | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|--|---|
| | | timetable to be set. | |
| 44 | 104 | We suggest that it is not necessary to determine the "value" of the dispute at this stage. | |
| 44 | 105 | We propose that r.105 should be renamed because it does not merely relate to telephone and video conferences (see r.105.3). | |
| 44 | 105.1 | Any telephone conference or video conference should be recorded. Rule 106 only refers to recording the interim conference when held in court. However, even if an interim conference is held by telephone conference or video conference, a record should be made available so that the parties can verify and, if necessary, refer to what was said in this conference. Any telephone conference or video conference should be recorded. Rule 106 only refers to recording the interim conference when held in court. However, even if an interim conference is held by telephone conference or video conference, a record should be made available so that the parties can verify and, if necessary, refer to what was said in this conference. | |
| 44 | 105.2 | This rule should make it clear if it provides for an alternative to a telephone/video conference. | |
| 44 | 105.3 | In case the parties' representatives have not mastered any common language, the provision should be amended to provide for simultaneous interpretation to be made (see r.109). | |
| 44 | 106 | We propose that if the interim conference is not held in Court, the telephone/video conference should still be made public. | |
| 44 | 108 | We propose that the rule require the Judge-rapporteur to have regard to the parties (and representative's) availabilities? (Compare r.28 which seems to require such consultation.) | Add reference to r.28 and/or r.41(c) before the reference to rule 104(h) |
| 44 | 109 | We propose that this rule should also apply to interim conferences – see r.105. | |
| 46 | 112 | We suggest that a provision is added to make clear how the questioning of witnesses and oral submissions will run. We propose that the Judge and/or parties decide a running order for the hearing. See also r.113. | |
| 47 | 116 | We propose that the parties should have a say in when the oral hearing occurs (in case they are unavailable). Representatives may need to be able to plan attendance at hearings and meet the needs of various clients. We propose that Rules 104(h) and 108 could include a requirement to hear the parties on the | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|-------|--|--|
| | | date of the oral hearing. | |
| 47 | 116.3 | The expression "any new submission" could be understood as allowing the submission of new arguments and exhibits at the oral hearing, i.e. after the closing of the proceeding. But that would be contrary to the principles of a fair trial. | "A party absent from the oral hearing shall be treated as relying only on its written case and not wishing to contest any new submission that the other party may be allowed to make at the oral hearing." |
| 47 | 118 | <p>The effect of 118.3(a) and the relationship with sub-rules 5 and 9 needs clarifying:</p> <p>It is not clear what the effect of r.118.3(a) is. Does it provide for a stay of any remedies pending the outcome of "the revocation procedure", or does it provide that the remedies are ordered but could be revoked if the condition is later unsatisfied? If the latter, if the local/regional division finds infringement and orders a remedy/remedies, but the patent is later revoked by the central division, why should the central division (part of the same Court) not also immediately reverse the orders of the local or regional division (compare sub-rule 5 requiring an application back to the local or regional division).</p> <p>Does r.11.3(b) provide for a stay of the decision and remedies whereas r.118.3(a) provides for a stay of the remedies only?</p> <p>Should not the Claimant have to provide a security bond either in order to obtain orders when validity has not been decided (118.3(a)) or at least to enforce the order (118.9)?</p> <p>The inclusion of the reference to decisions of the EPO in 118.3 implies that the local or regional division may stay proceedings or decisions, or make orders conditional upon decision of the EPO regardless of whether the decision of the EPO is imminent, and regardless of the decision of the UPC itself on validity. This may mean, for example that a patent could be held valid by the UPC (including the Court of Appeal) and the patentee might still not be able to obtain effective relief because of a slow-running EPO action. This is potentially in conflict with Art 33(10) which only contemplates a stay of proceedings when a rapid decision is expected from the EPO. (Compare with r.37.4 which makes no reference to the EPO.) We therefore propose the rule is amended to deal with this inconsistency.</p> <p>We understand that AIPPI has proposed that the standard required for a stay under r.118.3(b) be amended to alter the standard for the mandatory stay. They propose "high likelihood" is changed to "reasonable likelihood" which, in their view means "more likely than not to succeed". We oppose such a change which would make obtaining effective relief even more difficult.</p> | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|-------|--|--|
| | | <p>We also propose the rule is amended to make it clear whether the infringer is entitled to receive his damages back and entitled to further damages to compensate for any injunction complied with. We propose to include a reference to r.352.</p> <p>We propose to reverse the order of 118.3 (a) and (b) and state that if the Court decides not to stay the proceedings, it may instead proceed to render its decision under the conditions or terms described?</p> | |
| 49 | 126 | <p>We propose that the one year deadline can be extended by agreement or with the Court's permission.</p> <p>We would reject the idea of a deadline to request a determination of the amount of damages. This applies all the more since even after one year of a final decision on the merits (including any appeal) all facts may not yet been disclosed. Even a request for an order to lay open books does not allow the plaintiff to calculate damages, if the books are incorrect, incomplete or not self-understanding.</p> <p>The setting of a deadline could deprive the plaintiff of the very essential right to claim damages and we wonder whether such limitation of rights can be justified at all, in particular if only included in the "rules". A deadline of one year furthermore would not fit to any legal stipulations concerning the period of limitation or prescription in the respective national law. The setting of a deadline for such an essential right is not covered by Art. 68 of the agreement and appears arbitrary and unnecessary.</p> <p>It is proposed that time may be extended with the court's permission or by agreement, but that any agreement to extend the deadline beyond 3 years after the final decision would require the court's sanction.</p> | |
| 49 | 131 | <p>If there is no request to lay open books in r.131.1(c), we propose that the r.131.2 matters be dealt with in the same application as that in r.131.1.</p> <p>We propose the rule is amended to make it clear if there is there a time limit to provide the particulars in r.131(2) following the completion of laying open of books. Further, the rule should specify if the time-limit is to be set by the Court in accordance with r.143(1)(b).</p> | <p>Include reference to 143(1)(b) in 131(2) (in order to clarify the time period after laying open of books).</p> |
| 50 | 136 | <p>We propose that the rule be amended to allow the successful party to ask for a stay. We also propose that a stay be requested at any time (contrary to r.137.1).</p> | |
| 51 | 137.1 | <p>We propose that the rule should make it clear when the 2 months run from. Presumably the date from when the matters in r.131.2(a)-(e) are indicated</p> | <p>Change 137.1 to "If the unsuccessful....it shall within two months of receipt of the information in rule 131(2)(a)-</p> |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|---------|--|---|
| | | (i.e. after any procedure for laying open the books). | (e) inform.... the Registry". |
| 52 | 143.3 | The rule states: "the procedure for the award of damages shall be continued". Presumably at this point one returns to r.131.2. We propose this is referenced. | |
| 54 | 150.1 | <p>Article 69 establishes a number of principles – first that reasonable and proportionate legal costs should be recoverable, secondly that where equity requires otherwise this may not be the case. Thirdly, it is accepted that a party may succeed only in part, e.g. it establishes infringement of one claim only, which is of little commercial importance or that only one or two claims are valid. In that case the Court has to apportion the costs equitably which presumably requires that both parties provide information about what they have spent on various aspects of the dispute. Further, a party should not recover unnecessary costs it has caused – but it is unclear whether that determination is made by the Tribunal which determines the question of liability or by the judge-rapporteur during the costs procedure under Chapter 5.</p> <p>Article 69(4) provides for security for costs to be ordered but it is unclear where the rules are which relate to this.</p> <p>We propose the rule be amended accordingly.</p> | <p>At the end of the Rule – the following wording could be added:</p> <p>"In deciding what order (if any) to make about costs, the court will have regard to all of the following circumstances, including:</p> <p>(a) conduct of the parties;</p> <p>(b) whether a party has succeeded on part of its case, even if that party has not been wholly successful;</p> <p>(c) any offer to settle made by either party</p> <p>The conduct of the parties includes:</p> <p>(a) conduct before, as well as during, the proceedings and in particular the extent to which the parties have followed the other Rules of Procedure;</p> <p>(b) whether it was reasonable for a party to raise, pursue or contest a particular allegation or issue;</p> <p>(c) the manner in which a party has pursued or defended its case or a particular allegation or issue; and</p> <p>(d) whether a claimant who has succeed in the claim, in whole or in part, exaggerated its claim.</p> |
| 54 | 150 (2) | <p>The interim costs discretion granted to the Court is not fettered by anything in the rule.</p> <p>We propose the rules sets out a non-exhaustive list of factors that the Court could take into account when ordering interim costs.</p> | <p>"Interim awards shall take into account at least: (i) the financial positions of the parties; (ii) the expected length of time before the successful party is awarded its costs; (iii) the likely amount of the final award; (iv) the successful party's conduct under the factors set out in Rule 150(1) ...</p> |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|--------|-------|--|--|
| Part 2 | | | |
| 56 | 172.1 | <p>The requirement ("must") to produce evidence (implicitly all evidence) in relation to facts which are (or are likely to be) contested goes too far. As drafted, the rule is likely to result in large amounts of evidence being produced unnecessarily. For example, if a party states that its invention was the result of a lengthy research programme, and this is contested, the party making the statement should be able to choose what evidence to produce and not be compelled to produce all evidence (which may include large volumes of documents as well as statements from persons involved in the research). It should be up to a party to decide what evidence it wishes to produce, and sub-rule 2 stating that failure to produce evidence shall be taken into account is adequate.</p> <p>We propose the rules should be amended accordingly.</p> | Delete rule or replace "must" with "may" |
| 56 | 171.2 | <p>Presumably for statements of fact set out in pleadings, this rule works adequately, but seems unnecessary. However, if a statement is made in evidence submitted in the interim phase, the parties may be constrained procedurally as to how they contest this evidence (for example if an expert report contains a statement with which the recipient disagrees, and that party does not have permission to adduce evidence in reply, how it is to rebut the evidence? It might be allowed to challenge the statement at the oral hearing for example by cross-examination, but this might not be permitted either. What is the party to do?</p> <p>Also, how long does the party have to say it disagrees with the fact? Can it leave this until the final oral hearing?</p> <p>We propose that the rule be deleted.</p> | Delete rule. |
| 57 | 175 | The witness statements should indicate whether the witness may have any conflict of interest. | "The written witness statement shall provide information in respect of i) the current or past relationships existing between the witness and the party lodging the written witness statement, and ii) any conflict of interests relating to such witness which may affect its independence". |
| 57 | 175.2 | It is necessary to define the "applicable national law". | adding the following sentence: "The applicable national law is that of the |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|-----------|---|--|
| | | | contracting member state in the territory where the witness is domiciled or that of the contracting member state in the territory where the Central Division of the Court is located". |
| 57 | 176 (c) | Patent proceedings generally require the witness to explain complex issues. The witness should be allowed to testify in its mother tongue. It is not for the applicant for the hearing to decide in which language the witness should give evidence. | amend to "(c) the language in which the witness wishes to give evidence." |
| 57 | 177.2 (g) | See 176 (c) and 178.8 | To be added : "(g) that the witness has the right to stay silent during the hearings and to be assisted by a lawyer" |
| 57 | 178.6 | The use of electronic means must not be achieved by sacrificing quality | To be added : "In case of video conference the witness shall be able to see and hear the Court as well as the questioning person" |
| 58 | 178.7 | See 176 (c) and 178.8 | To be replaced by : "In any case a witness who does not understand or speak the language of the proceedings or who is deaf shall have the right to the assistance of an interpreter" |
| 58 | 178.8 | We believe that article 6§3 ECHR (fundamental freedoms-rights to a fair hearing) may be applicable here due to the fact that according to rule 179.4 the Court may decide to report to the competent authorities of the contracting members having criminal jurisdiction the content of the oral hearing. | To be added : "Every witness shall have the right to the assistance of a lawyer" |
| 58 | 179.2 | There is a risk that a pecuniary sanction for a "no show" might be reimbursed to the witness by its employer if the hearings jeopardize the interest of the company. Accordingly the sanction will not be uniformly effective. | Consider deletion of 179.2 |
| 58 | 179.3 | Rule 179 regards the the power of the Court to oblige witnesses to provide evidence or to make declarations. This rule or power appears to be too strong. In particular, it is necessary to respect article 59 of the Agreement (which prohibits forms of self-incrimination) and article 43 (respect of the freedom of the parties regarding the evidence submitted in the case). There should be no differences between the duty of loyalty due a spouse and the duty of loyalty due to an employer (in order to avoid an employee being required to testify against its employer) | Add the duty of loyalty to an employer as an excuse for a witness to refuse to give evidence. |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|---|--|
| 58 | 180.1 | We propose that the witness' expenses be payable in advance so he/she is able to pay for the travel etc to attend the hearing. | |
| 60 | 185 | We propose that time limits should be included for the Court to appoint a technical expert (sub-rule 1) and for the stages under sub-rule 2. | |
| 61 | 187 | Again, we propose that time limits should be included. | |
| 63 | 192.2 (b) | We suggest that this Rule refer to the "location(s) of the evidence" for the cases where the evidence is likely to be found in different places. | "shall contain a clear indication of the measures requested including the exact locations of the evidence to be preserved" |
| 63 | 192.2 (c) | Article 60 of the Agreement does not provide any condition of urgency or prompt action for a measure to preserve evidence. This condition is not relevant for such measure: for example, a measure for preserving evidence or an inspection may be necessary to evidence the reproduction of a claimed method absent any urgency. | 192.2 Deletion of "prompt" : "c) the reasons why prompt measures are needed to preserve relevant evidence," |
| 63 | 192.3 | Where the applicant requests that measures to preserve evidence be ordered without hearing the other party, the duty to disclose "any fact which might influence the court" which lies on the applicant is too vague and might be extensively disputed. And it exceeds the criteria defined by Article 7 of the 2004/48 Directive (29 April 2004) which allows the possibility of an ex-parte decision "where any delay is likely to cause irreparable harm to the right holder or where there is a demonstrable risk of evidence being destroyed". | "in addition set out the reasons for not hearing the defendant having regard in particular to Rule 197 and in accordance with article 7 of the 2004/48 Directive. |
| 64 | 194.4 | 194 (2) : for the same reason explained in relation with rule 192.2c, it is necessary to delete provision (a) which refers to "the urgency of the action" may not be required. The urgency may be a factor taken into account under 194.2 (b). 194(4) This rule refers to cases of "extreme urgency" in which the applicant may apply without formality for an order to preserve evidence to the standing judge designated in Rule 345 (5) which refers to "urgent actions". | Possible deletion of 194(2a) "In cases of extreme urgency the applicant may apply without formality for an order to preserve evidence to the standing judge designated in accordance with Rule 345.5". |
| 65 | 196.1 | 196.1 : It would help to clarify the wording, especially in relation with paragraph (b) 196.2 : It is unclear why the outcome of measures to preserve evidence should be used only in the proceedings on the merits of the case ? No such limitation is provided for other measures to obtain evidence, for example for orders to produce evidence under Rule 190. | "a) preserving evidence by detailed description of the allegedly infringing product or process, with or without the taking of allegedly infringing goods" 196.2 : "An order to preserve evidence shall specify that, unless otherwise ordered by the Court, the outcome of the measures to preserve |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|------|-------|---|--|
| | | | evidence may only be used in the proceedings relating to the same case on the merits of the case". |
| 66 | 197 | <p>197.2 : We suggests that a paragraph be inserted in Rule 197, after paragraph (2), which provides that the Order for preserving evidence should not be entered on the register until notice has been given to the defendant or, alternatively, until an action on the merits has been started before the Court. This additional paragraph would be consistent with the last sentence of Rule 193 (3) and would ensure that the party against which the measure is to be executed does not become aware of it before it is executed.</p> <p>197.25 : the wording "after the execution of the measures" is too vague. It is unclear at what time it is considered that the measures are fully "executed». We propose the rule is amended to make clear the latest point when the defendant must give notice.</p> | |
| 68 | 201 | This rule seems to permit the Court to order an experiment to be conducted which has not been requested by the parties. In which case the rule should make it clear who will carry it out. For example, does this experiment need to be carried out by a Court expert, or can the Court order a party expert to carry out an experiment? | |
| 70 | 205 | We propose this rule is not needed and should be deleted. It does not seem to add anything. Moreover, if the procedure "shall" consist of "... an oral procedure" it is noted that this is not accurate, as the oral hearing may not occur. | Delete rule |
| 71 | 207.1 | <p>Is any restriction intended by the use of the words "likely" in the first line, and "in the the near future" in the third line? If any restriction is intended, we propose that the rule make it clear how is it to be policed. However, there is no indication that the Registry will refuse to accept a Protective Letter, that these restrictions serve no purpose and we suggest removing all restrictions on filing a Protective letter and leave the fee to be the deterrent.</p> <p>The Rule should make it clear that a Protective Letter may (or may not) be filed on behalf of a number of connected legal persons, and that only one fee (or multiple fees) shall be payable.</p> <p>We propose that the Rule should not be so widely drafted that it allows a generic Protective letter to be filed which might relate to numerous unconnected disputes. The Rules Committee should consider how the Protective letter system may apply to major multi-patent disputes such as occur in the telecoms sector.</p> | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|--|--|---|
| 71 | 207.2(b) | We propose it would be preferable to require that the Protective letter names all information known to the person filing the letter which may enable the Registry to identify a relevant application, such as the patent number and patent proprietor rather than just the presumed applicant. | |
| 71 | 207.4 | We propose to add a new sub-rule informing the defendant that the Protective letter has met the formal requirements (or not, in which case inviting him to remedy the defects) and informing him of the number assigned to the Protective letter. | |
| 73 | 209.2 | | Change "209" to "209.1" |
| 74 | 211.3 | We propose to add a reference to a requirement of urgency of a provisional measure pending the full trial of the main action. | |
| 74 | 212 | <p>We propose that the rules are amended to require that information should be given to the recipient of an ex parte Order for provisional measures in the notice of the provisional measures. This could include the consequences of failing to comply with the Order.</p> <p>The rules should also set out any recourse the recipient and how it should apply to set it aside including any time limits.</p> <p>The rule should also clearly set out what options are available for immediate recourse in urgent cases including whether 24 hour access to the appropriate Court / judge / officer is available.</p> | |
| 75 | 213 | The rule should make it clear that compensation shall be ordered where it has been found that there has been no infringement or threat of infringement because the patent has been found invalid. | |
| 76 | 220.1(c) | Add reference to Art 58 (confidential information) | |
| 76 | 220.2 (and note thereto - definition of Court) | We note that in Art 2(a) – "Court" means the Unified Patent Court created by this Agreement; Art 6(1) – The Court shall comprise a Court of First Instance, a Court of Appeal and a Registry" We propose this definition should be cross-referred to in the rules. | |
| 76 | 220.3 | <p>The rules should make it clear that the normal position is that appeals are heard together unless there is a good reason.</p> <p>We propose this rule deal with the language of the appeal, since r.227 does not do so. It is noted that the Preparatory Committee, on its web-site, states that in the case of conjoined infringement / validity appeals, the language shall be that of the "main" proceedings, that is (in their view) the infringement proceedings. We disagree that the main proceedings are the infringement proceedings. The</p> | Replace "may" with "shall, unless the circumstances do not permit" |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-----------------------|--|---|
| | | presumption should be that the language is the language of the patent, and this should be stated in this rule or in rule 227. | |
| 76 | 221 | We propose this rule should be headed "Application for leave to appeal against costs decisions". | |
| 76 | 222.1 | We propose that r.221 should also be referred to. | |
| 77 | 223.3 | We propose that the reference to the Court should be to the Court of Appeal (Art 74 specifically refers to the Court of Appeal). | |
| 77 | 223.4 | We propose that the rule should provide that that if the request for suspensive effect is granted, the grant should be for a short duration (no more than one month) and that within that period there shall be a further hearing at which all parties may be heard. | |
| 78 | 226(c) | We suggest that the reference to r.221.1 is not appropriate. | |
| 80 | 232.2 | We suggest the panel "shall", not "may" give the party the opportunity to be heard. (Compatibility with Art 56(2)). | |
| 80 | 233.2 | We suggest the panel "shall", not "may" give the party the opportunity to be heard. (Compatibility with Art 56(2)) | |
| 81 | 235.1 | | '...any other party to the proceedings before the Court of First Instance...' |
| 81 | 235.2 | | '...any other party to the proceedings before the Court of First Instance...' |
| 84 | 240 | We propose that r.113.1 and r.113.3 be added to the list of applicable rules. | |
| 85 | 242.2(b) and 243.1(a) | The language of these two provisions is not the same. Is any significance to be read into this? We suggest 242.2(b) adopts the wording of 243.1 and 243.1 is deleted. | |
| 85 | 243.2 & 243.3 | Typographical errors. | "an action" not "a action" in both rules |
| 87 | 248.1 | | '...where such objection could not have been be raised with reasonable diligence during the proceedings...' |
| 87 | 248.2 | | '...where the party with reasonable diligence could have brought an appeal...' |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|--|--|
| 87 | 251 | We propose the rules should be amended to clarify that suspensive effect is possible only pursuant to an application under r.223. | |
| 88 | 252.2 | Suggest the President "shall", not "may" give the party the opportunity to be heard. (Compatibility with Art 56(2)). | |
| 88 | 254.1(a) | We question the requirement "shall not contain any reasons". We suggest the rule be amended to "need not contain any reasons". | |
| 89 | 261 | It is assumed that there is no time after which the pleading is deemed to be received the next working day. If not, the rule should make it clear what time of day marks the boundary of the working day. | |
| 90 | 266.1 | Typographical error. | Delete "of" in last line |
| 91 | 266.5 | We propose that proceedings should always be stayed pending a CJEU decision. | |
| 92 | 271.2 | Typographical error. | Delete "Claimant" before "(a)" |
| 92 | 271 and 272 | There is no obvious requirement for the Registry to serve the Statement of Claim within any particular time. (Compare obligation in relation to other pleadings under r.278.1.) We propose that the rules should provide the Registry to do so. Alternatively, we propose the rule should be re-titled r.278 to refer to "service of pleadings". | |
| 97 | 287 | Rule 287(1) should be amended so that all exchanges between counsel and client (whether confidential or not) are covered by the attorney-client privilege, not just the "confidential communication". 298(6) : The wording "equivalent body in a Contracting Member State" is too vague. | "Where a client seeks advice from a lawyer he has instructed in a professional capacity, whether in connection with proceedings before the Court or otherwise, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is privileged from disclosure, .." Deletion of " equivalent body in a Contracting Member State" |
| 98 | 289.2(a) | How will the Court ensure that papers and documents are exempt from search and seizure? Will this need to be included in the national law of every relevant country? | |
| 98 | 289.5 | We propose there should be an explicit requirement for due process before the Court may effectively remove the amenity of the representative. We propose that the rules should provide for there to be privilege against self-incrimination and | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|---|---|
| | | privilege on grounds of national security. | |
| 99 | 290.1 | It is unclear whether this rule simply achieves a lowest common denominator, i.e. the Court only has the powers which every Court of Law throughout Europe has to discipline and control representatives which appear before it. The rule should make this clear and make clear what these powers are. For example, would the Court have any direct power to jail a representative for contempt of court? | |
| 99 | 290.2 | Given that practitioners before the Court will have been subject to a variety of different codes of conduct, we propose that the code of conduct is developed sooner rather than later and in any event in good time before the entry into force of the UPC Agreement. | |
| 99 | 291 | This allows a representative to be excluded from the proceedings but does not appear to envisage any other sanctions. What if a representative behaves fraudulently or dishonestly? We propose the rule be amended to provide other sanctions. | |
| 99 | 291 | The power of the Court to "exclude (a representative) from the proceedings by way of order" for incompatibility "with the dignity of the Court or with the requirements of the proper administration of justice" is too broadly defined and uncertain. The reasons and the procedure for exclusion should be more precisely defined. | |
| 100 | 297 | Typographical error. | Delete "or" in first line |
| 102 | 300(g) | | Add "or section of the central division" after "division". (Consistency with 301 which refers to sections of the central division.) |
| 106 | 315 | It could be fair to oblige the intervener to pay a fee | |
| 108 | 320.7 | An appeal from an order rejecting an Application for Re-establishment of rights should be possible. We suggest deleting Rule 320 (7). | Deleteion of 320(7) |
| 109 | 321.5(a) | We note that r.14.1(b)(ii) was deleted from the 14th draft. | |
| 109 | 321.5(c) | We note that r.14.1(c) and (d) do not exist. | |
| 112 | 331 | We propose that there should be a general rule giving a power to the President to have responsibility for management of cases to take account of actions which are part of a wider dispute, for example, where multiple actions exist between the same parties or closely related parties (subsidiaries etc). This would be dispute management as opposed to mere case | |

| Page | Rule | Comment | Proposed Rule Amendment (To be read in conjunction with "Comment") |
|-------------|-------------|--|---|
| | | management. See also r.340, however, we propose that the power should not be limited to hearing actions together, but include general scheduling issues and include the possibility of transfers between divisions. | |
| 112 | 333.1 | We propose the reference should be to r.101 not r.102. | |
| 114 | 337 | | Replace "his" with "its" |
| 114 | 340 | We refer to our comments under r.331 above. | |
| 117 | 345.1 | In the interests of ensuring that judges are not "locked" together for extended periods, and bearing in mind that panels are allocated at the start of actions, we propose that judges are not allocated to panel at all, except for the purposes of individual cases. See also the comments in relation to r.17.2. | |

B: General Comments

| | General Remarks & Recommendations |
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| | <p>Rule.14.2 - Language issues</p> <p>First instance language – Regarding rule.14.2, which now gives precedence to the language of the defendant by providing that: “the Statement of Claim shall be drawn up in the language in which the defendant normally conducts its business in its Contracting Member State” we understand that this change arose following a position taken by Belgium where a particular constitutional concern arose with regard to defendants being sued in a non-native language.</p> <p>We understand that Belgian Constitutional Rights, with regard to the use of languages, are confined to criminal proceedings rather than civil proceedings, and this change may therefore need to be revised.</p> |
| | <p>Rule 25.3 - Counterclaim</p> <p>If a patentee becomes a party to a counterclaim in proceedings brought by a licensee this should be made clear. It is proposed that rule 25.3 be revised to reflect that the patentee is now a party to the counterclaim, and secondly, that the counterclaim be formally served on the party.</p> |
| | <p>Fees for revocation actions and damages</p> <p>The CCBE believes that any Court fees should be reasonable.</p> <p>In addition, the CBE notes that rule 26 provides for a fee for the revocation counterclaim, which in part will be value-based. It is also noted that a revocation counterclaim is mandatory when the defence of invalidity is raised (r.25.1). Hence, this is a fee to defend oneself. This does not appear appropriate.</p> <p>The CCBE agrees with the following comments from the Swedish Association for the Protection of Intellectual Property (SFIR):</p> <p>“The provision in Article 36 (3) that Court fees shall consist of a fixed fee, combined with a value-based fee above a pre-defined ceiling applies to counterclaims according to Article 32(1)(e), which represent joined counter actions (that may later be referred to the central division for decision). The value basis and the fees are left to the Administrative Committee to decide with the direction that the level shall be fixed taking into account i.a. the principle of fair access to justice, in particular for i.a. SMEs.</p> <p>A counterclaim for revocation in an infringement action is a defensive action that with regard to the Court fee should in principle be valued from the point of view of the defendant in the infringement action and as a part of the infringement dispute. Thus, the fact that the patent may have importance way beyond the dispute with the defendant and that the validity issue may be very different from the point of view of the patentee should not influence the value on which the fee is based, i.e. the value in the actual dispute. Otherwise, fair access to justice for an SME that the patentee has elected to direct the action against may be seriously hampered by the fact that a fee based on the value of the patent outside the dispute may be prohibitively large. On the contrary, the value limited to the validity issue in the actual dispute will normally at least not exceed the value of the infringement issue. The fee may then also be reliably estimated by the defendant before a counterclaim is raised, which is crucial in particular for SMEs.</p> <p>In view of the need of a uniform fee evaluation within UPC, the Rules of Procedure should explicitly make it clear that the fee should be based on the value of the counterclaim in the infringement dispute and that any additional value of the patent outside the dispute should not be taken into account.</p> <p>Rule 31 provides that the total value of the dispute including the counterclaim should be determined and that the defendant shall pay a value-based fee for the excess of the total value over the value of the infringement action. This implies that the added value of the counterclaim may be less than the value of the infringement action and is in line with the principle mentioned above. It should, however, be made clear in Rule 31.2 that the excess to be paid for is to be calculated in accordance with Rule 31 .1, i.e. the value exceeding the value of the infringement action by more than a specified amount that should be equal to the amount below which only a fixed fee is payable.”</p> |
| | <p>Rule 30.1 a): Amendments</p> <p>The CCBE agrees with the following comments from the SFIR:</p> <p>“Article 65 of the Agreement refers to amendment of the claims whereas Rule 30.1 a) refers to both the claims and/or the specification. This seems to open up for an unlimited re-examination of the patent as a whole. It is therefore important to make clear, as is stated in Article 65, that it is only limitations of</p> |

| | General Remarks & Recommendations |
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| | <p>the patents that shall apply also with respect to the specification. In order to reflect this, Rule 30.1 a) could be changed as is indicated below.</p> <p>This rule does also provide the possibility to submit several auxiliary requests. This could be unnecessary burdensome for the Court and the parties. It should be possible for the Court to limit this possibility in obvious cases. The rule could therefore in this respect be changed as indicated below.</p> <p>1. The Defence to the Counterclaim for revocation may include an *Application by the proprietor of the patent to amend the patent which shall contain</p> <p>(a) the proposed amendments of the claims of the patent concerned and, when necessary to clarify the limitation, also the specification, including where appropriate one or, if reasonable, more alternative sets of claims (auxiliary requests), in the language in which the patent was granted; where the language of the proceedings [Rule 14.2] is not the language in which the patent was granted, the plaintiff shall lodge a translation of the proposed amendments in the language of the proceedings, and where the patent is a European patent with unitary effect in the language of the defendant's domicile if so requested by the defendant".</p> |
| | <p>Former Rule 40 – negative effects of a separation of a counterclaim for revocation from an action for infringement</p> <p>The CCBE shares the views of the SFIR with regard to the negative effects of a separation of a counterclaim for revocation from an action for infringement :</p> <p>"... negative effects of a separation of a counterclaim for revocation from an action for infringement were counteracted by Rule 40 in the 14th draft Rules of Procedure dated 31 January, 2013, which provided for accelerated proceedings before the central division when a counterclaim for revocation had been referred to it. This provision has later been deleted but should be reinstated.</p> <p>The CCBE believes that it is important that the decision on validity is not delayed after the decision on infringement because of the risk that an infringer could be removed from the market under an invalid patent. We recognise that an order for acceleration is meaningless unless the Court is adequately manned to ensure that the panels are manned to deal with the workload in the required times and we therefore advocate that the central division hearing counter claims should be staffed to ensure that they reach a decision at about the same time as the infringement court without the need for special acceleration. This is an issue that needs to be constantly kept under review in accordance with the needs of the local and central division."</p> |
| | <p>Rule 70.3 - Stays of central division "clearing the way" revocation actions</p> <p>If a potential defendant starts a revocation action in the central division, the patentee, may, rather than counterclaim for infringement in the central division, choose to start a separate infringement action in a local or regional division (Art 33(5)). Under proposed r.70.3, the revocation action is then stayed whilst the local/regional division decides what to do – seemingly on the assumption that the defendant to this second action may make a second claim (this time by way of counterclaim) for revocation in the local/regional division. If there is no such counterclaim, then r.70.4 (new to the 15th draft) provides that the stay of the central division action be lifted again. Whilst largely because of the agreement (Art 33(5)), the result is a dilemma for the defendant. Its options are:</p> <p>Counterclaim for revocation in the (second) infringement action – this will result in an overall delay in having validity decided. It also does not guarantee the two elements of the case (infringement and validity) being decided together, since the local/regional division could still bifurcate; or</p> <p>Not counterclaim for revocation and effectively submit to bifurcation, whilst allowing its revocation action to be un-stayed, and hence be decided more promptly.</p> <p>We believe that it would be helpful if the procedure can be modified on application by one of the parties to a panel of the two judge rapporteurs. It should be possible for the revocation action to stand as the counterclaim. The Judge Rapporteur for the infringement and the Judge Rapporteur from the validity court should decide this (or someone else that is positioned to decide), with the possibility of a hearing. Having the revocation action stand as the counterclaim is an option in those circumstances. This procedure would ameliorate the danger that the mandatory procedure is open to abuse by a patentee at the beginning of an infringement procedure.</p> |
| | <p>Opt out issues</p> <p>(a) The CCBE believes that it is not correct for the patentee to be required to pay a fee in order not to use the UPC. Opting out should not be connected with any extra costs for the patentee. The patentee</p> |

| | General Remarks & Recommendations |
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| | <p>should not be "punished" for deciding to use the status quo. As mentioned by the SFIR, there is no justification for requiring the patentee to pay a fee for making use of the possibility to avoid the competence of the Court and becoming a party to proceedings before UPC.</p> <p>(b) The CCBE agrees about the need for a sunrise period as mentioned in the paper from the SFIR</p> <p>"Article 83(3) provides for a transitional regime giving the patentee a right to escape the UPC jurisdiction for the lifetime of a European patent (as opposed to a European patent with unitary effect) with the result that national courts remain competent for infringement and revocation actions. Article 83(4) allows the patentee the possibility to later withdraw the opt-out with the effect that the patent becomes subject to the exclusive jurisdiction of UPC.</p> <p>The transitional regime is a fundamental element in the creation of the necessary confidence in the new European court system. Clear, effective and reliable procedures for opt out are crucial to meet this objective and particularly important initially in view of the impact on all preexisting European patents.</p> <p>Rule 5.9 (within square brackets) provides for a procedure for opting-out as from the coming into effect of the Agreement by lodging an application with EPO after a date to be announced by EPO and before the coming into effect of the Agreement.</p> <p>Such a procedure is indispensable in view of the fact that the initial opt-out of existing European patents may be expected to be massive in number of patent and that an opt-out according to Article 83 (3) shall only take effect upon its entry into the register. Thus, to comply with the Agreement, procedural provisions must secure both the possibility to opt-out as from the Agreement takes effect and the access of third parties to information on the opt-out from the same time.</p> <p>In practice, however, it seems to be impossible to establish the register of UPC sufficiently ahead of the coming into effect of the Agreement to allow for timely handling and registering the opt-out of the expected massive number of patents. In view hereof, Rule 5.9 provides for an appropriate procedure for such registration of initial opt-outs and must be retained."</p> <p>(c) The CCBE understands that the intent of the Agreement is that all designations of a European bundle patent are in the UPC system or are opted out. It is indeed the case that it will not be a truly "unified" Patent Court if it can deal with only some of the designations of a bundle patent within its Member States' jurisdictions. Thus, if ownership of the national designations of a bundle patent are split between two or more proprietors, all proprietors need to agree before a (bundle) patent can be opted out.</p> <p>We are conscious that some people have read "patent" in Rule 5 as referring to an individual national designation and not the entire "bundle". We accordingly suggest that the wording of Rule 5 is amended to clarify this. The ambiguity arises particularly from the final sentence of Rule 5.1 and we propose that this sentence be deleted (or at least the words "each of the" be replaced by "every").</p> |
| | <p>Rule 110 – Preparation for the oral hearing</p> <p>The CCBE agrees with the following comments from SFIR:</p> <p>"Rule 104 provides that the aim of the interim conference is i.a to identify main issues, to determine which relevant facts are in dispute and, where appropriate, to clarify the position of the parties as regards those issues and facts. Rule 110 provides directions for the closure of the interim procedure.</p> <p>The oral hearing is a crucial element in the creation of a common European patent litigation procedure to replace present widely varying national procedures. To achieve the required efficiency of the oral hearing while retaining the necessary predictability and legal security with a highly concentrated oral hearing, a thorough substantive preparation of the oral hearing is indispensable. It is also indispensable in order to create a uniform practice among the divisions of UPC to have clear directions by the Rules of Procedure in this respect.</p> <p>Appropriate means to normally achieve this objective should be established in Rule 110 or a separate Rule under the heading Preparation for the oral hearing. This should include the preparation by the judge-rapporteur of a report summarizing the positions of the parties and clarifying the issues in dispute and also indicating the issues to be dealt with at the oral hearing. However, no indication of a preliminary opinion on any issue should be given, as e.g. is the practice in the Technical Boards of Appeal in EPO."</p> |
| | <p>Separate proceedings for cost orders</p> <p>The CCBE believes that separate proceedings for cost orders should be avoided where possible and should in any case not be obligatory. The CCBE agrees with the following comments from SFIR:</p> |

| | General Remarks & Recommendations |
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| | <p>“According to Rule 150.1, a cost order may be the subject of separate proceedings following a decision on the merits or a decision for the determination of damages.</p> <p>While it is known under some national procedural laws that have no counterpart for UPC, to have procedures for deciding the amounts of costs allowed by the court, which are separated from the court action, it is questionable whether it is needed and desirable to introduce for UPC separate proceedings for deciding the amounts of costs that the court has ordered to be reimbursed in the decision on the merits.</p> <p>Such separate proceedings will add to the costs and delay the final resolution of the dispute, in particular when there is no tradition among representatives of the parties to solve the issue amicably. The assessment of costs and distribution between the parties is best conducted by the court in immediate connection with the trial, when the case is tried on the merits.</p> <p>Both parties should anyhow submit their substantiated claims for legal costs and other expenses at the trial, which will contribute to a fair assessment of reasonable and proportionate costs and any apportionment. This also has the advantage of preventing that a successful party be tempted to overestimate costs in later separate proceedings, where the court typically has less knowledge or understanding of the work in the main proceedings.</p> <p>Experiences in countries like Sweden, where costs are ordered in the decision on the merits, do not indicate that it causes substantial problems to have all cost issues decided after the trial without separate proceedings.</p> <p>Though the cost issues may normally conveniently be decided without a decision on the amounts being postponed, there is no objection to providing that this issue may be the subject of separate proceedings. Such separate proceedings should, however, be avoided when possible and must in any case not be obligatory, as seems to be implied in Rule 151. Therefore, separate proceedings should be decided in the decision on the merits and should only be allowed at the request by both parties or at a reasoned request by one party.</p> <p>Further, Rule 150 should be amended to specify that it is the amount of costs ordered to be reimbursed that may be the subject of separate proceedings. ”</p> |
| | <p>Rule 152: Recovering litigation costs</p> <p>The CCBE agrees with the following comments from the SFIR:</p> <p>“Cap on recoverable litigation costs</p> <p>Article 69(1) provides that legal costs and other expenses are recoverable by the successful party “up to a ceiling set in accordance with the Rules of Procedure”. Thus, the Agreement requires a cap on all recoverable litigation costs, including “other expenses”, but leaves open how the ceiling is to be set.</p> <p>Rule 152.2 provides:</p> <p>“The Administrative Committee shall adopt a scale of recoverable costs which shall set ceilings for such costs by reference to the value of the dispute. The scale may be adjusted from time to time.”</p> <p>Since Rule 152 is restricted to compensation for representation costs, its second paragraph is incoherent with Article 69(1) with regard to the scope of the cap and must be changed in this respect.</p> <p>Further, a cap on recoverable litigation costs represents a fundamental change of the basic principle that the costs of the successful party are born by the unsuccessful party, which rules national patent litigation in Europe with few exceptions. The beneficial effect of a cap on the level of the litigation costs and on the ability of the parties to evaluate the litigation risk requires that the level of the cap is carefully balanced and that legal security and foreseeability is not jeopardized by the cap not being both precisely defined in the Rules of Procedure and stable. From that point of view, it is not acceptable only to provide in the Rules of Procedure a directive to the Administrative Committee to set ceilings by reference to the value of the dispute and to allow the scale adopted to be adjusted from time to time, thereby increasing the uncertainties of litigating before UPC.</p> <p>Costs for unsuccessful counterclaims for revocation</p> <p>Neither the Agreement nor the Rules of Procedure address the issue of compensation for litigation costs related to a counterclaim for revocation in an infringement action in the situation that the patent by the Court is found to be valid but not infringed.</p> <p>In national patent litigation the principles with regard to which of the parties that will be allowed its costs for the validity issue varies from the patentee being regarded as the successful party in the validity issue and allowed its costs for that issue to the defendant in the infringement action being</p> |

| | General Remarks & Recommendations |
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| | <p>regarded as the successful party in the whole case and normally allowed all its costs. The practical experiences of these different principles show that they result in differences in litigation practices and to which extent the validity issue is raised in patent disputes and thereby in speed and efficiency of patent litigation.</p> <p>In view of these differences in national practices and traditions, the Rules of Procedure need to give clear directions on this issue. Since validity issues in infringement actions will have to be raised as counterclaims for revocation, which may later even be referred to and decided separately by the central division, it seems essential that the issue of compensation for costs for the validity issue be judged according to the same principle whether it is raised as a separate revocation action or as a counterclaim. As experiences in Sweden show, this, may also contribute to a reduction of counterclaims that are not really justified.</p> <p>However, with regard to counterclaims for revocation, it must be taken into account that claim interpretation and scope of protection often are decisive for infringement and validity. The defendant may then have as his main request that the infringement claim be denied because the scope of protection in view of the prior art is narrower than argued by the patentee whereas the patent is invalid when interpreted as submitted by the patentee. If the defendant in such a situation is successful on the infringement issue, he should normally also be regarded as the successful party on the validity issue and be allowed all costs."</p> |
| | <p>Rule 152: Recovering litigation costs</p> <p>The CCBE agrees with the following comments from the SFIR:</p> <p>"Cap on recoverable litigation costs</p> <p>Article 69(1) provides that legal costs and other expenses are recoverable by the successful party "up to a ceiling set in accordance with the Rules of Procedure". Thus, the Agreement requires a cap on all recoverable litigation costs, including "other expenses", but leaves open how the ceiling is to be set.</p> <p>Rule 152.2 provides:</p> <p>"The Administrative Committee shall adopt a scale of recoverable costs which shall set ceilings for such costs by reference to the value of the dispute. The scale may be adjusted from time to time."</p> <p>Since Rule 152 is restricted to compensation for representation costs, its second paragraph is incoherent with Article 69(1) with regard to the scope of the cap and must be changed in this respect.</p> <p>Further, a cap on recoverable litigation costs represents a fundamental change of the basic principle that the costs of the successful party are born by the unsuccessful party, which rules national patent litigation in Europe with few exceptions. The beneficial effect of a cap on the level of the litigation costs and on the ability of the parties to evaluate the litigation risk requires that the level of the cap is carefully balanced and that legal security and foreseeability is not jeopardized by the cap not being both precisely defined in the Rules of Procedure and stable. From that point of view, it is not acceptable only to provide in the Rules of Procedure a directive to the Administrative Committee to set ceilings by reference to the value of the dispute and to allow the scale adopted to be adjusted from time to time, thereby increasing the uncertainties of litigating before UPC.</p> <p>Costs for unsuccessful counterclaims for revocation</p> <p>Neither the Agreement nor the Rules of Procedure address the issue of compensation for litigation costs related to a counterclaim for revocation in an infringement action in the situation that the patent by the Court is found to be valid but not infringed.</p> <p>In national patent litigation the principles with regard to which of the parties that will be allowed its costs for the validity issue varies from the patentee being regarded as the successful party in the validity issue and allowed its costs for that issue to the defendant in the infringement action being regarded as the successful party in the whole case and normally allowed all its costs. The practical experiences of these different principles show that they result in differences in litigation practices and to which extent the validity issue is raised in patent disputes and thereby in speed and efficiency of patent litigation.</p> <p>In view of these differences in national practices and traditions, the Rules of Procedure need to give clear directions on this issue. Since validity issues in infringement actions will have to be raised as counterclaims for revocation, which may later even be referred to and decided separately by the central division, it seems essential that the issue of compensation for costs for the validity issue be judged according to the same principle whether it is raised as a separate revocation action or as a counterclaim. As experiences in Sweden show, this, may also contribute to a reduction of counterclaims</p> |

| | General Remarks & Recommendations |
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| | <p>that are not really justified.</p> <p>However, with regard to counterclaims for revocation, it must be taken into account that claim interpretation and scope of protection often are decisive for infringement and validity. The defendant may then have as his main request that the infringement claim be denied because the scope of protection in view of the prior art is narrower than argued by the patentee whereas the patent is invalid when interpreted as submitted by the patentee. If the defendant in such a situation is successful on the infringement issue, he should normally also be regarded as the successful party on the validity issue and be allowed all costs."</p> |
| | <p>Rule 179 - Witnesses</p> <p>Rule 179 regards the the power of the Court to oblige witnesses to provide evidence or to make declarations. This rule or power appears to be too strong. In particular, it is necessary to respect article 59 of the Agreement which prohibits forms of self-incrimination.</p> |
| | <p>Forum shopping / transfers</p> <p>The general principle applied is that that the plaintiff choses the forum in accordance with the Rules of the Brussels Convention. With regard to the benefit of certainty this principle should not normally be challenged.</p> <p>However, although there should always be a presumption that the choice of jurisdiction remains with the plaintiff, there will be cases where it will be unfair that a defendant is stuck in a particular jurisdiction. In certain cases there should be the possibility/a procedure for the defendant to argue that the case should be held in another jurisdiction. The plaintiff should also have the right to say that any change of venue may have a negative implication if there is an injustice to the parties.</p> |
| | <p>Rules 207 and 211.4: Preliminary injunctions</p> <p>The CCBE shares the views of the SFIR:</p> <p>"Protective letters</p> <p>According to Rule 212, the Court may order provisional measures "without the defendant having been heard in cases where any delay is likely to cause irreparable harm to the applicant".</p> <p>Ex parte injunctions may be extremely harmful when unjustified and should be an exceptional remedy in normal situations of alleged infringement that are not of a piracy character. A condition therefore must be not only that irreparable harm to the applicant is likely but also that it can be reliably established that a valid patent is infringed without hearing the defendant.</p> <p>Rule 207 introduces in the unified patent litigation system a safeguard in the form of an elaborate system of protective letters containing non-infringement and invalidity arguments, as known from German patent infringement courts. The purpose of such protective letters is to avoid unjustified ex parte injunctions but the system is burdensome and costly and is of little or no help to, in particular, SMEs. Note: The CCBE is also concerned that the availability of protective letters makes the Court more willing to grant ex parte injunctions and it is important to ensure that the rules on ex parte injunction do not permit the Court to treat a protective letter as a substitute for the parties' submissions.</p> <p>The need for such a system actually reflects that the standard of certainty is being set too low in establishing that a valid patent is infringed. Thus, rather than spreading the system of protective letters to the new system, the conditions for ex parte injunctions should be so strict that the risk for unjustified injunctions without hearing the defendant is insignificant.</p> <p>Security for preliminary injunctions</p> <p>Article 62.1 provides that the Court as a provisional measure "may grant" injunctions and Article 62.(5) provides by reference to Article 60(7) that such measure "may be subject" to the lodging of adequate security.</p> <p>Accordingly, Rule 211.1 provides that the Court "may" provisionally order injunctions and Rule 211.4 that the Court "may order the applicant to provide adequate security for appropriate compensation for any injury likely to be caused to the defendant may be liable to bear in the event that the Court revokes the order for provisional measures".</p> <p>In view of the potentially extremely harmful effects for the defendant of preliminary injunctions, security for these effects must be lodged to retain the balance between the parties and for this reason security shall be required unless in exceptional cases it is unreasonable to require the lodging of security. An explicit direction to this effect should be spelled out in Rule 211.4 in order to avoid an</p> |

| | General Remarks & Recommendations |
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| | <p>unjustified discretionary variation in this respect among divisions which may otherwise be expected in view of the varying traditions and attitudes with regard to preliminary injunctions in national patent litigation.”</p> |
| | <p>Rule 211.3 - Preliminary injunction issues</p> <p>The CCBE believes the urgency of the need for any preliminary measures is a fact that should be taken into account. There should be a specific requirement for urgency and some guidelines on what is urgent.</p> <p>Rule 211.3 should be amended as follows:</p> <p>“In taking its decision on the Application for provisional measures, the Court shall have the discretion to weigh up the interests of the parties and the urgency of the specific case”.</p> |
| | <p>Rules 220 and 221: Procedural appeals</p> <p>The CCBE agrees with the following comments from the SFIR:</p> <p>“A uniform procedure within UPC is fundamental to foreseeability and legal security and the confidence in and therefore to success of the international patent litigation system under the Agreement. While the Rules of Procedure have a crucial role in creating a uniform procedure in the divisions of the first instance and must be detailed enough for that purpose, they must leave essential aspects of the procedure to be established in the practice of the Court.</p> <p>In view of the wide differences in practices and traditions in national patent litigation of today, the Court of Appeal must be given the decisive role in establishing procedural practices within the framework of the Agreement and the Rules of Procedure in order to safeguard the development of uniform such practices within the Court, in particular in an early phase. To that end, procedural appeals are a necessary means.</p> <p>At the same time, procedural appeals must not lead to delays of the actions unless there is a need for a uniform practice to be established by the Court of Appeal. Thus, procedural appeals should require the grant of leave to appeal by the Court, as set out in Article 73 and Rule 220.2.</p> <p>However, for the Court of Appeal to have the decisive role in establishing procedural practices, it must also be able to control the grant of leave. Thus, it cannot be completely left to varying discretion of different divisions of the first instance whether there is in the particular case a need for the Court of Appeal to establish a uniform procedural practice in a certain respect. The reference in Article 73(2) to the Court granting leave does not have to and should not be interpreted to imply that. On the contrary, it is indispensable to establish in the Rules of Procedure an appropriate procedure for the grant of leaves by the Court.</p> <p>In this respect, the 14th draft Rules of Procedure dated 24 May 2012 provided:</p> <p>“Procedural decisions or orders of the Court of First Instance may be appealed with leave of the Court of First Instance or, if leave is refused, with leave of the Court of Appeal.”</p> <p>With regard to decisions or orders on costs, Rule 221.1 now similarly provides:</p> <p>“A party adversely affected by a decision or order referred to in Rule 157 may lodge an Application for leave to appeal to the Court of Appeal within 15 calendar days of service of the decision or order of the Court refusing leave to appeal.”</p> <p>The solution of having first a decision on the leave issue by the division of the first instance and only in case of a refusal a decision on that issue by the Court of Appeal is somewhat burdensome. On the other hand, it is balanced in view of the interest of a rapid leave when found justified by a division and a selective grant of leave by the Court of Appeal when refused by a division. The possibility of recourse against such a refusal may also be seen as a basic right of the adversely affected party.</p> <p>For these reasons, the procedure under Rule 221.1 should be made applicable to procedural decisions or orders in general. The procedure should, however, include that a decision by the division, whether to grant or refuse leave, should only follow on a request for leave to appeal by a party. Further, a decision to refuse leave should be motivated, giving the party and the Court of Appeal a basis for considering the need for a review on appeal.”</p> <p>The CCBE believes that there should not be local rules as the system is to benefit clients rather than practitioners. In this respect, it is essential to avoid national practices being applied. In addition, the Rules should mention that the Court of Appeal should consider whether an appeal is appropriate for the harmony of the system as it is essential to achieve the correct procedures across Europe. This is a</p> |

| | General Remarks & Recommendations |
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| | matter for the Unified Patent Court to decide, but it is clearly an issue.” |
| | <p>Confidentiality</p> <p>Although there are specific provisions in Rules 106, 115, 190 (1), 196 (1), 197 (4), 199 (1) and 262 (2) dealing with confidentiality in specific circumstances, there is no general provision dealing with the confidentiality of one party’s information vis-à-vis the other party or parties, or for the preservation of confidentiality in the determination of damages (Rules 125 to 149) or orders to lay open books (Rules 141 to 143). This is a particularly important issue for defendants, where the details of the accused infringing produce are trade secrets, and in relation to financial information in damages assessments.</p> <p>The CCBE proposes that the issue of confidential information should be covered in a general rule (and the above provisions be replaced by a cross reference to that general rule) providing:</p> <ul style="list-style-type: none"> - Public Access: the court can limit or prevent public access to documents (as per current rule 262 (2) – (6)) or hearings (as per current rules 106 and 115) in order to preserve confidentiality - Compulsory disclosure: the court shall provide appropriately for the protection of confidentiality when it makes an order requiring a party or a third party to produce or give access to documents, other materials or information (see for example Rules 143, 190, 196, 199, 200, 201, 202, etc) - Confidentiality orders: the court may make orders for the protection of confidentiality not only in relation to compulsory disclosure, but also in relation to information provided by a party without an order (for example, a party’s written submissions and annexes and evidence). Such orders may provide that, for the opposing party or parties, only a “confidentiality club” may have access to the information. The members of such a “confidentiality club” would comprise a limited number of named individuals within the opposing party, plus its representative and other named external advisors (legal or technical)(to be , may be required to sign confidentiality undertakings. <p>To avoid uncertainty as to what is confidential, the parties should put information (documents and other “means of evidence” (Rule 170 (1)) that they claim to be confidential in separate confidential annexes.</p> |
| | <p>Rules 9 and 300: Time periods</p> <p>The CCBE shares the views of the SFIR regarding time periods:</p> <p>Calculation</p> <p>Article 73(2) provides that certain orders may be appealed “within 15 calendar days” and specifies that this period shall be calculated from “the notification” of the order.</p> <p>The Rules of Procedure provide a number of time periods in “days” (e.g. Rules 16.2, 27.2, 39.1 and 323.2), “calendar days” (Rules 331.1) or “working days” (Rule 321.3 and 5). Rule 300 specifies in (e) that “day shall mean a calendar day unless expressed as a working day”. Rule 300 further provides in (f) and (g) general directions for the calculation of calendar days and working days, respectively.</p> <p>Some Rules specify from when a time period shall be calculated, as e.g. Rules 19.1 and 23 “of service of the Statement of claim”, Rule 19.5 “of service of notification” and Rules 221.1 and 371.4 “of service of the decision or order”. In general, however, the Rules (e.g. Rules 16.3, 27.2 and 4, 32.3 and 39.1) do not specify from when a time period shall be calculated. There is also no general direction in this respect except the general provisions in Rules 271 and 276 with regard to service of Statements of claim and orders and decisions, respectively.</p> <p>Time periods are in practice crucial elements for the parties and clarity and consistency in this respect have a high practical value. There is no apparent reason why not all time periods shorter than a month should be stated in “days”, meaning “calendar days” according to Rule 300(e), which would avoid the risk of confusion. Anyhow, it must be specified in a clear and consistent way from when time periods shall be calculated, preferably in a general provision.</p> <p>Extensions</p> <p>Rule 9.3 provides that the Court may, subject to paragraph 4, on a reasoned request by a party:</p> <p>(a) extend, even retrospectively, a time period referred to in these Rules or imposed by the Court;</p> <p>Nevertheless, Rules 23, 39.1, 56, 65 and 321.3 and 5 provide that the time period stated there “may be extended by the judge-rapporteur on a reasoned request”, which may be justified as a reminder in situations where the possibility of an extension is particularly relevant. It is, however, unfortunate if confusion is caused by other time periods by mistake being interpreted e contrario not to be extendable. In order to avoid such misunderstandings, said Rues should be amended to refer explicitly</p> |

| | General Remarks & Recommendations |
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| | <p>to Rule 9.3(a)."</p> <p>The CCBE believes that it is essential that it is clear when a deadline expires. If the deadline falls on a day where there is a public holiday in which the Court is closed then the deadline should expire at the next working day. In addition, the CCBE notes that when time runs following service of documents (apart from the Statement of Claim) the rules do not specify when service has taken place.</p> |
| | <p>Proposed Rule 318. Brief of an Amicus Curiae</p> <p>In cases involving legal questions of general importance the Court of First Instance or the Court of Appeal, after consulting the parties to the case, may invite any person or legal entity concerned by that legal question to file a brief as amicus curiae.</p> <p>The invitation may be posted on the Court's webpage and shall include:</p> <p>the legal question of interest;</p> <p>a time limit for filing; and</p> <p>limits of scope.</p> <p>Rule 313.3 shall apply mutatis mutandis.</p> <p>The Amicus curiae brief shall contain</p> <p>a reference to the action number of the file,</p> <p>the names of the amicus curiae and of the amicus curiae's representative,</p> <p>comments solely within the admitted scope.</p> <p>Amicus curiae briefs which are not in compliance with Rule 318.4 or filed later than the deadline of Rule 318.2 (b) may be disregarded by the court.</p> |
| | <p>Foreclosure</p> <p>We appreciate that the contemplated procedural system is intended to be "front loaded" so that all relevant claims, submissions and evidence are not only compiled but also uncovered as soon as possible.</p> <p>In the interest of all parties, the procedural framework should, however, reflect that quite often, first instance proceedings develop in directions that were not anticipated by the parties. The rules on foreclosure ought therefore to provide adequate flexibility.</p> <p>By way of example, too early foreclosure entails a risk of inflation of the body of evidence because neither party dares running the risk of focusing his evidence if it later turns out that e.g. court appointed experts disagree with the party's own assessment of the relevance of particular pieces of the submitted evidence. Too early foreclosure may therefor work counterproductive to the general objective of early concentration of the core claims, submissions and evidence in a case.</p> <p>By further way of example, 3 months may be enough to prepare a first line of written defence. In many cases, however, it requires – in particular if the defendant is an SME - more time to identify and address the evidence that regards the validity of the patent in suit. Too early foreclosure may therefore impede the defendant's ability to duly defend himself.</p> <p>We believe that the rules on foreclosure should motivate the parties to come forward with their claims, submissions and evidence as early as reasonably possible. The structure suggested at present where appeal does generally not suspend the patent proprietor's right to enforce an infringement judgement in itself strongly motivates the defendant to come forward with all relevant claims, submissions and evidence during the 1st instance proceedings. If, however, the defendant wishes to submit new pieces of evidence during appeal proceedings, the defendant should have a reasonable access to do so. One of the means to achieve an adequate balance is to modify rule 222(2)(b) from requiring that the "submissions are highly relevant" to requiring that the "submissions are relevant" for the decision on appeal. This modification conforms to Article 73(4).</p> |

Conclusion

We hope the above comments are of assistance and we are happy to answer any questions that may arise or to provide additional information should this be requested.