

## The Unified Patent Court

*Implementing the Unitary Patent Protection and the Unified Patent Court:  
Current Situation and Future Challenges • Public Policy Exchange  
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**Pierre Véron**

Honorary President EPLAW (European Patent Lawyers Association)  
Member of the Expert Panel group of the Unified Patent Court  
Member of the Drafting Committee of the Rules of Procedure



The Unified Patent Court

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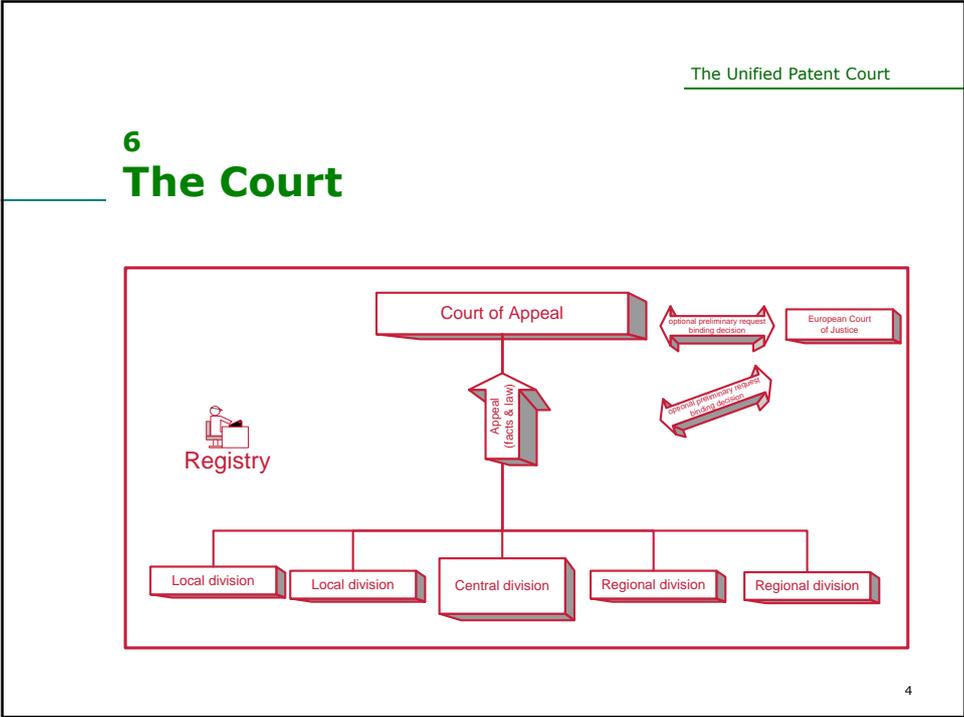
- Court of first instance, court of appeal and registry: assessing their role and functioning
- Defining jurisdiction during the transitional period

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The Unified Patent Court

## Court of First Instance, Court of Appeal and Registry: role and function

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## 7 The Court of first instance

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graph TD; A[Central division] --- B[Regional division]; A --- C[Local division]; A --- D[Central division]; A --- E[Regional division]; A --- F[Local division];
```

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## 7 The Court of first instance: local divisions

(3) A local division shall be set up in a Contracting Member State upon its request.

(4) An additional local division shall be set up in a Contracting Member State upon its request for every 100 patent cases per year.

The number of local divisions in one Contracting Member State shall not exceed 4.

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## 7 The Court of first instance: regional divisions

*"(5) A regional division shall be set up for two or more Contracting Member States, upon their request in accordance with the Statute. Such Contracting Member States shall designate the seat of the division concerned and shall provide the necessary facilities for that purpose. The regional division may hear cases in multiple locations."*



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## 7 The Court of first instance: central division

*"(2) The central division shall have its seat in Paris, with sections in London and Munich. The cases before the central division shall be distributed in accordance with Annex II..."*

*Contracting Member States hosting the central division, its sections or the Court of Appeal shall provide the facilities necessary for that purpose."*



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**Article 7 and Annex II**

## The Court of first instance: central division's seat and sections



**London**

SECTION A — HUMAN NECESSITIES

SECTION C — CHEMISTRY; METALLURGY



**Paris**

PRESIDENT'S OFFICE

SECTION B — PERFORMING OPERATIONS; TRANSPORTING

SECTION D — TEXTILES; PAPER

SECTION E — FIXED CONSTRUCTIONS

SECTION G — PHYSICS

SECTION H — ELECTRICITY



**Munich**

SECTION F — MECHANICAL ENGINEERING; LIGHTING; HEATING; WEAPONS; BLASTING

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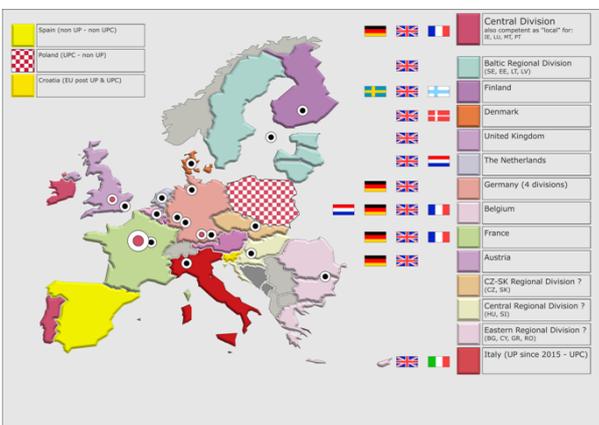
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## The Court of first instance: central, local and regional divisions (based on the intentions to create divisions as supposed early 2018)

Spain (non UP - non UPC)

Poland (UPC - non UP)

Croatia (EU post UP & UPC)



Central Division also competent as "local" for: DE, SE, NL, PT

Baltic Regional Division (SE, EE, LT, LV)

Finland

Denmark

United Kingdom

The Netherlands

Germany (4 divisions)

Belgium

France

Austria

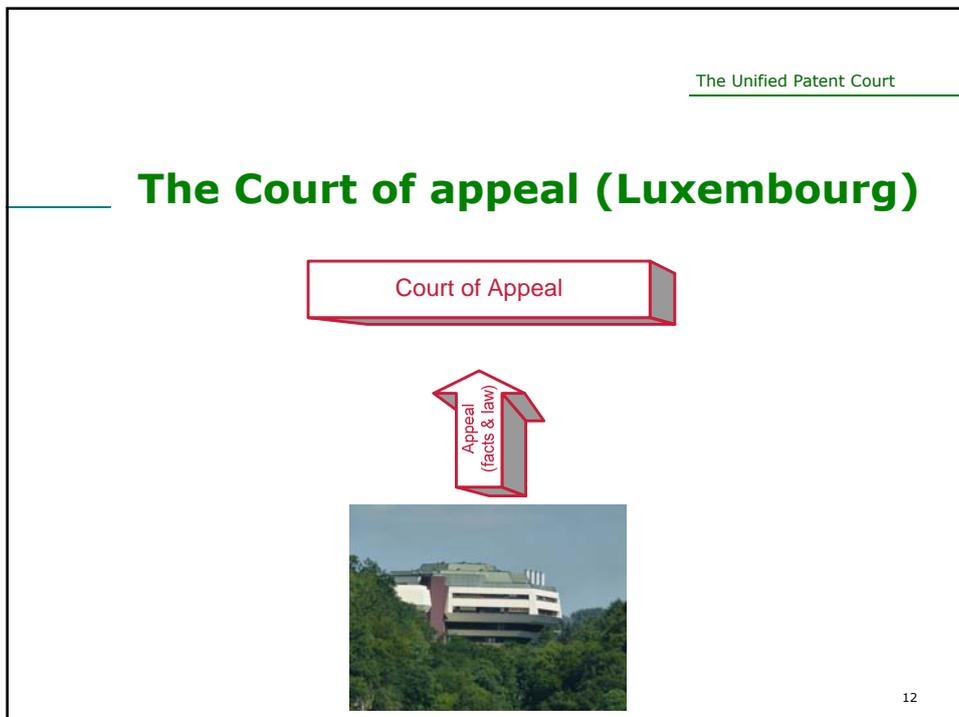
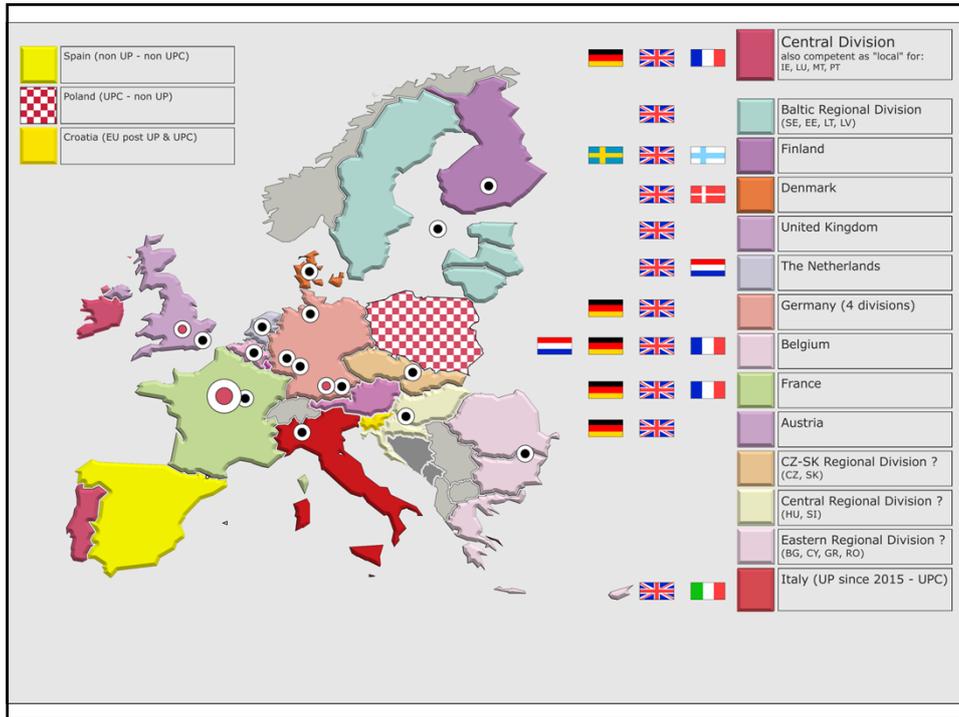
CZ-SK Regional Division ? (CZ, SK)

Central Regional Division ? (HU, SI)

Eastern Regional Division ? (HU, CZ, SK, RO)

Italy (UP since 2015 - UPC)

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## Court of appeal

**Luxembourg**  
Hemicycle  
Kirchberg



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## Court of First Instance



**London**  
Aldgate Tower (City)



**Paris**  
Palais de Justice



**Munich**  
Bundespatentgericht

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## 15 The judges

*"(1) The Court shall comprise both legally qualified judges and technically qualified judges."*

*Judges shall ensure the highest standards of competence and shall have **proven experience in the field of patent litigation**.*

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

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

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## 16 The judges: appointment

*"(1) The **Advisory Committee**\* shall establish a list of the most suitable candidates to be appointed as judges of the Court, in accordance with the Statute.*

*(2) On the basis of this list, the Administrative Committee shall appoint the judges of the Court acting by common accord.*

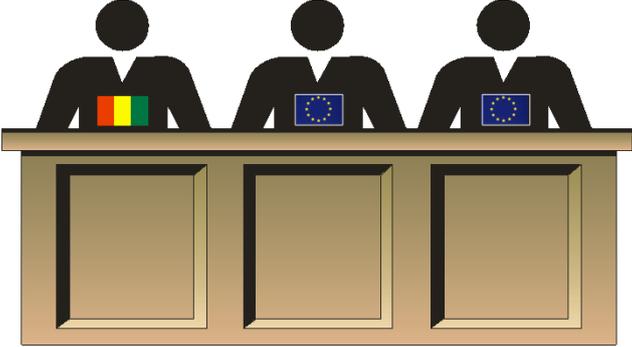
*(3) The implementing provisions for the appointment are set out in the Statute."*

*\* 14 (2) The Advisory Committee shall comprise patent judges and practitioners in patent law and patent litigation with the highest recognised competence.*

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**8 (2)**  
**Panel: 1<sup>st</sup> instance local division**

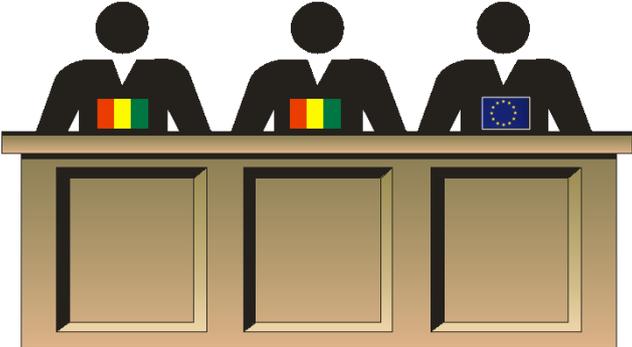


**Member State with < 50 cases**  
**(anti Eastern District Texas provision)**

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**8 (3) & (4)**  
**Panel: 1<sup>st</sup> instance local division**



**Member State with  $\geq 50$  cases**  
**or regional division**

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**8 (5)  
Panel: Additional technical judge**



**when a counterclaim for revocation is brought art. 33 (3) or upon request by one of the parties or on the panel's initiative**

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**8 (6)  
Panel: 1<sup>st</sup> instance central division**



**Tech. judge except for 32 (1) (i) actions concerning EPO decisions on UP**

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# 9 Panel: Court of Appeal

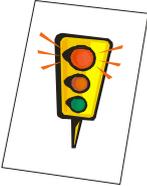


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# 32 Jurisdiction

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



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**33 (1)  
The Rules of Forum Shopping in Europe...**



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**33 (1)  
Infringement: (a) place of infringement**



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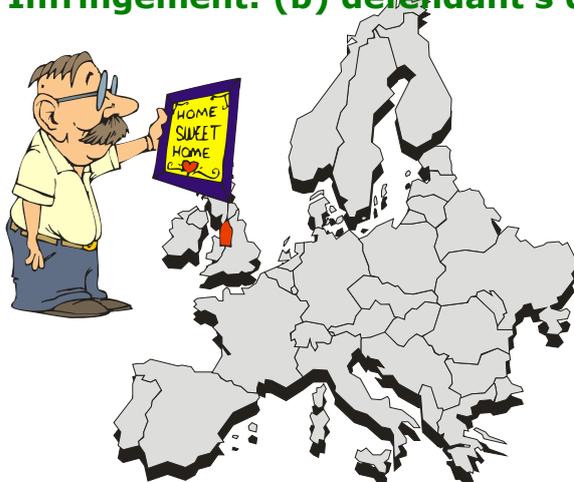
**33 (2) § 2**  
**Infringement: multi-regional infringement**



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

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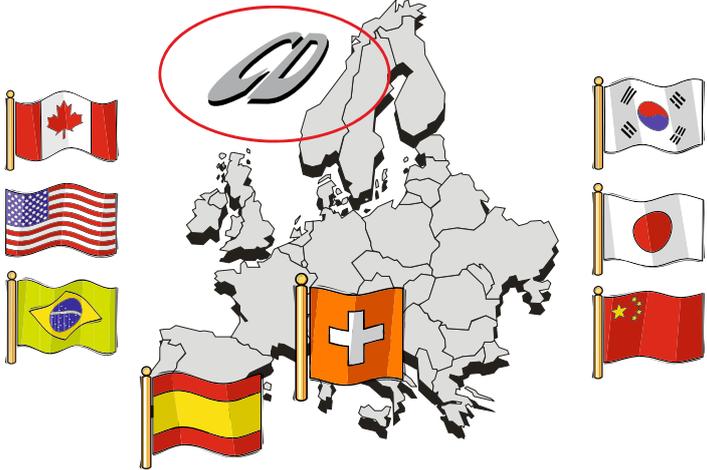
**33 (1)**  
**Infringement: (b) defendant's domicile**



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**33 (1) §3  
Infringement  
non EU defendants: Central Division**

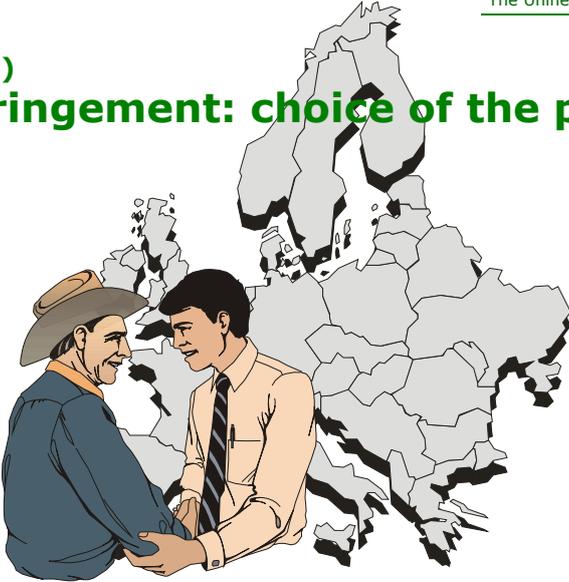


The image shows a map of Europe with several flags of non-EU countries placed around it. On the left side, from top to bottom, are the flags of Canada, the United States, and Brazil. On the right side, from top to bottom, are the flags of South Korea, Japan, and China. In the center of the map, there is a flag of Switzerland. A red circle highlights the letters 'CD' in a grey, stylized font, which is positioned over the northern part of the European map.

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**33 (7)  
Infringement: choice of the parties**



The image shows a map of Europe in the background. In the foreground, two men are shaking hands. The man on the left is wearing a brown hat and a blue jacket, while the man on the right is wearing a light-colored shirt and a dark tie. This illustrates the concept of choice of parties in infringement cases.

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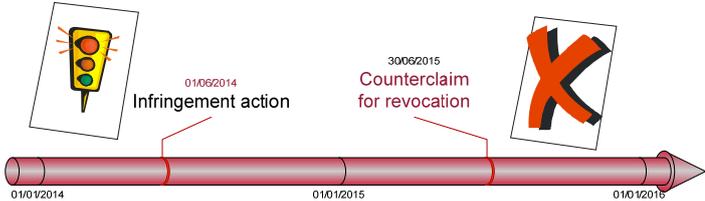
## Bifurcation or not bifurcation?



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



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

Infringement action      Counterclaim for revocation

The local division has the discretion to:

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

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

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

Revocation action  
Central division

Infringement action  
Local division

The local division may either

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

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

Regional division    Local division    Central division    Regional division    Local division

Revocation action

Action for a declaration of non-infringement

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

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

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

**Language of the court**  
(national or EPO language)

**Language of the patent**

**Language of the court**  
(national or EPO language)

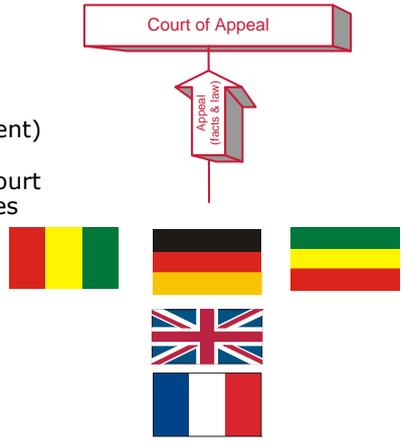
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## 50 Language of proceedings: appeal



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



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## Defining jurisdiction during the transitional period

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**Article 83 UPC Agreement**  
**Transitional period: 7 years**

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

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**Article 83 UPC Agreement**  
**Transitional period**

Two clear-cut situations:

- **Unitary Patent:** exclusive jurisdiction of the Unified Patent Court for all actions listed in Article 32 UPC Agreement
- **Opt-out** of a classical European Patent: UPC has no jurisdiction; only national courts are competent for the entire life (+) of the patent

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## Article 83 UPC Agreement

**Transitional period**

The case of a **classical European patent not opted out** is more complex:

- **concurrent jurisdiction:** UPC has jurisdiction but national courts remain also competent for most actions (not all): the plaintiff chooses (pre-emptive strike)
- ***Lis pendens* and related actions:** difficult problems when both UPC and national courts are seized with actions relating to the same patent: beware lock-in and lock-out situations

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## Articles 32 and 83 UPC Agreement

**Competence of the UPC after the transitional period**

- The Unified Patent Court has **exclusive** jurisdiction for:
  - ▶ actions listed by article 32-1 a) to i) of the Agreement (9 actions: infringement, declaration of non-infringement, provisional and protective measures, revocation, counterclaims for revocation, compensation provisional protection EP applications, use of the invention prior to the granting of the patent, compensation for licences, actions concerning EPO about UP)
  - ▶ for European patents, European patents with unitary effect, European patent applications and SPC
- No other court has jurisdiction
- No agreement between the parties may derogate to this rule (except for arbitration)

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Articles 32 and 83 UPC Agreement

## Transitional period and opt-out

Two exceptions to the UPC's exclusive jurisdiction during the transitional period:

- Concurrent jurisdiction of national courts during the transitional period for European patents
- Opt-out

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Articles 32 and 83 UPC Agreement

## Transitional period: Concurrent jurisdiction

Concurrent jurisdiction of national courts during the 7-year (possibly 14-year) transitional period

Art. 83 (1): national courts remain competent for :

- **certain** actions  
(*"an action for infringement or for revocation of a European patent or an action for infringement or for declaration of invalidity of a supplementary protection certificate issued for a product protected by a European patent"*)  
(actions for declaration of non-infringement, actions for provisional measures and injunctions as well as 5 other types of actions not listed)
- relating to **European patents and SPCs**  
not applicable to European patents with unitary effect, which are in the exclusive jurisdiction of the UPC;  
not applicable to actions relating to patent applications

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## Article 83 UPC Agreement

**Opt-out and withdrawal**

Art. 83 (3 et 4) : the proprietor of a European patent or the applicant for a published application for a European patent as well as a holder of a supplementary protection certificate may **opt out** that patent or application or SPC **from the exclusive competence** of the Unified Patent Court in accordance with Article 83(3) of the Agreement:

- ▶ for all the actions listed in article 32(1)
- ▶ for the European patents and for the EP applications

National courts are then competent

- Opt-out shall be made for all the countries covered by the patent
- The proprietor may also, later, withdraw this opt-out (but he may not opt out again after such withdrawal)
- The opt-out and the withdrawal shall be regarded as effective from the date of entry in the register
- The opt-out is valid for the whole life (+) of the patent (not only for the transitional period) <sup>43</sup>

## Rule 5 §12 ROP

**Opt-out: sunrise period**

*"12. Applications accepted by the Registry before the entry into force of the Agreement shall be treated as entered on the register on the date of entry into force of the Agreement."*



## Articles 32 and 83 UPC Agreement

**Concurrent jurisdiction: scope**

If no opt-out, what about the actions listed in Article 32(1) but not listed in Article 83(1) of the UPC Agreement:

- ▶ (b) actions for declarations of non-infringement of patents and supplementary protection certificate?
- ▶ (c) actions for provisional and protective measures and injunctions?
- ▶ actions relating to European patent application?

Will national courts accept such actions despite the language of article 83 which seems to limit their competence ? (*"an action for infringement or for revocation of a European patent or an action for infringement or for declaration of invalidity of a supplementary protection certificate issued for a product protected by a European patent"*)

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## Article 83 UPC Agreement and Rule 5 § 6 ROP

**Opt-out : lock-in  
(impossible to opt out)**

Opt-out impossible when an action has been brought before the UPC about the patent concerned:

- *"(3) Unless an action has already been brought before the Court, a proprietor ... shall have the possibility to opt out..."*  
*"an action"* means probably *"any type of action"* (not only infringement action or revocation action)
- *6. ... irrespective of whether the action is pending or has been concluded".*

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**Article 83 UPC Agreement and Rule 5 § 8 ROP****Opt-out : lock-out  
(impossible to withdraw the opt-out)**

It is impossible to withdraw the opt-out (with a view to accept the jurisdiction of the UPC) when an action has been brought before a national court about the patent concerned:

*"(4) Unless an action has already been brought before a national court, proprietors ... who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt-out at any moment."*

*"8. ... irrespective of whether the action is pending or has been concluded."*

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**Transitional period:  
applicable law**

- If the national courts follow the UPC's preparatory committee "*interpretative note*", they will apply their national laws, while the UPC will apply the Agreement

<https://www.unified-patent-court.org/news/interpretative-note---consequences-application-article-83-upca>

- As a result, the law applicable to the case will depend on the court seized with the case and the outcome of the case may vary (e.g. Bolar exemption)

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## Transitional period : *Lis pendens*

Article 29, §1 & 3 Regulation No. 1215/2012) :

"1. Without prejudice to Article 31(2), where proceedings involving **the same cause of action** and **between the same parties** are brought in the courts of different Member States, **any court other than the court first seized shall of its own motion stay its proceedings** until such time as the jurisdiction of the court first seized is established.

...

3. Where the jurisdiction of the court first seized is established, any court other than the court first seized shall decline jurisdiction in favour of that court."

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## Transitional period : Related actions

Article 30 Regulation No. 1215/2012 :

"1. Where **related actions** are pending in the courts of different Member States, any court other than the court first seized **may stay** its proceedings.

2. Where the action in the court first seized is pending at first instance, any other court may also, on the application of one of the parties, decline jurisdiction if the court first seized has jurisdiction over the actions in question and its law permits the consolidation thereof.

3. For the purposes of this Article, actions are deemed to be related where they are **so closely connected** that it is expedient to hear and determine them together **to avoid the risk of irreconcilable judgments** resulting from separate proceedings."

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## Regulation (EU) No. 542/2014 of 15 May 2014

Article 71a Regulation (EU) No. 542/2014 of 15 May 2014 amending Regulation (EU) No. 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice

*"1. For the purposes of this Regulation, a court common to several Member States shall be deemed to be a court of a Member State when, pursuant to the instrument establishing it, such a common court exercises jurisdiction in matters falling within the scope of this Regulation.*

*2. For the purposes of this Regulation, each of the following courts shall be a common court:*

- (a) the **Unified Patent Court**; and*
- (b) the **Benelux Court of Justice**"*

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## Regulation (EU) No. 542/2014 of 15 May 2014

Article 71c Regulation (EU) No. 542/2014 of 15 May 2014 amending Regulation (EU) No. 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice

*"1. Articles 29 to 32 shall apply where proceedings are brought in a common court and in a court of a Member State not party to the instrument establishing the common court.*

*2. **Articles 29 to 32 shall apply where, during the transitional period** referred to in Article 83 of the UPC Agreement, proceedings are brought in the Unified Patent Court and in a court of a Member State party to the UPC Agreement."*

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## Transitional period: wrap up

- Unitary Patent: UPC, no opt-out possible
- European Patent:
  - ▶ if opt-out: only national courts (UPC has no jurisdiction whatsoever)
  - ▶ if no opt-out: concurrent jurisdictions; court first seized has jurisdiction
    - ▶ if same cause of action (*lis pendens*) second court seized **must** stay (NB: validity and infringement are different causes of action)
    - ▶ otherwise, related actions, second court seized **may** decide to stay pending resolution of first case

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Pierre Véron

Thank you



[pierre.veron@veron.com](mailto:pierre.veron@veron.com)