

Proceedings before the Unified Patent Court

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

https://www.unified-patent-court.org/sites/default/files/upc_rules_of_procedure_18th_draft_15_march_2017_final_clear.pdf

Trilingual booklet DE/EN/FR comprising Unitary Patent Regulations, Unified Patent Court Agreement, Draft N° 18 Rules of Procedure (19 October 2015)

https://www.veron.com/wp-content/uploads/2015-10-19_Agreement_UPC_DE-EN-FR_and_Rules_Procedure_UPC_DE-EN-FR_Draft_18.pdf

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5. Front-loading system
6. The Judge-rapporteur: a key person
7. One day hearing
8. Hearing of a witness in person exceptional
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Proceedings
before the Unified Patent Court



Relationship EPO/UPC

- Actions concerning decisions of the EPO about European Patent with Unitary Effect (EPUE)
- UPC infringement and revocation proceedings
 - ▶ request for accelerated EPO proceedings R 298
 - ▶ UPC decision on the validity of the patent
 - (a) decision under condition
 - (b) stay of proceedings

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Overview

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The best of both worlds ?

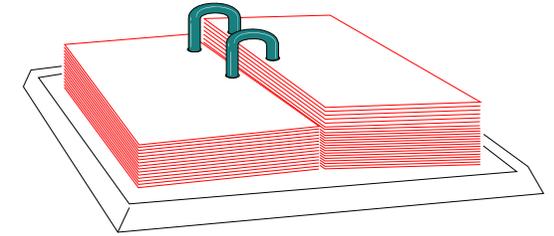


with a hint
of EPO
dressing



Feature 1: Time target

One year for a judgment



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



Feature 2

Written proceedings in electronic form



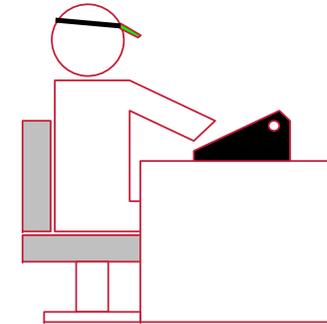
“1. Written pleadings and other documents shall be lodged at the Registry in electronic form. Parties shall make use of the official forms available on-line. The receipt of documents shall be confirmed by the automatic issue of an electronic receipt, which shall indicate the date and local time of receipt.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



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

Feature 3

The Registrar: an important person



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

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



Feature 4

Preformatted proceedings

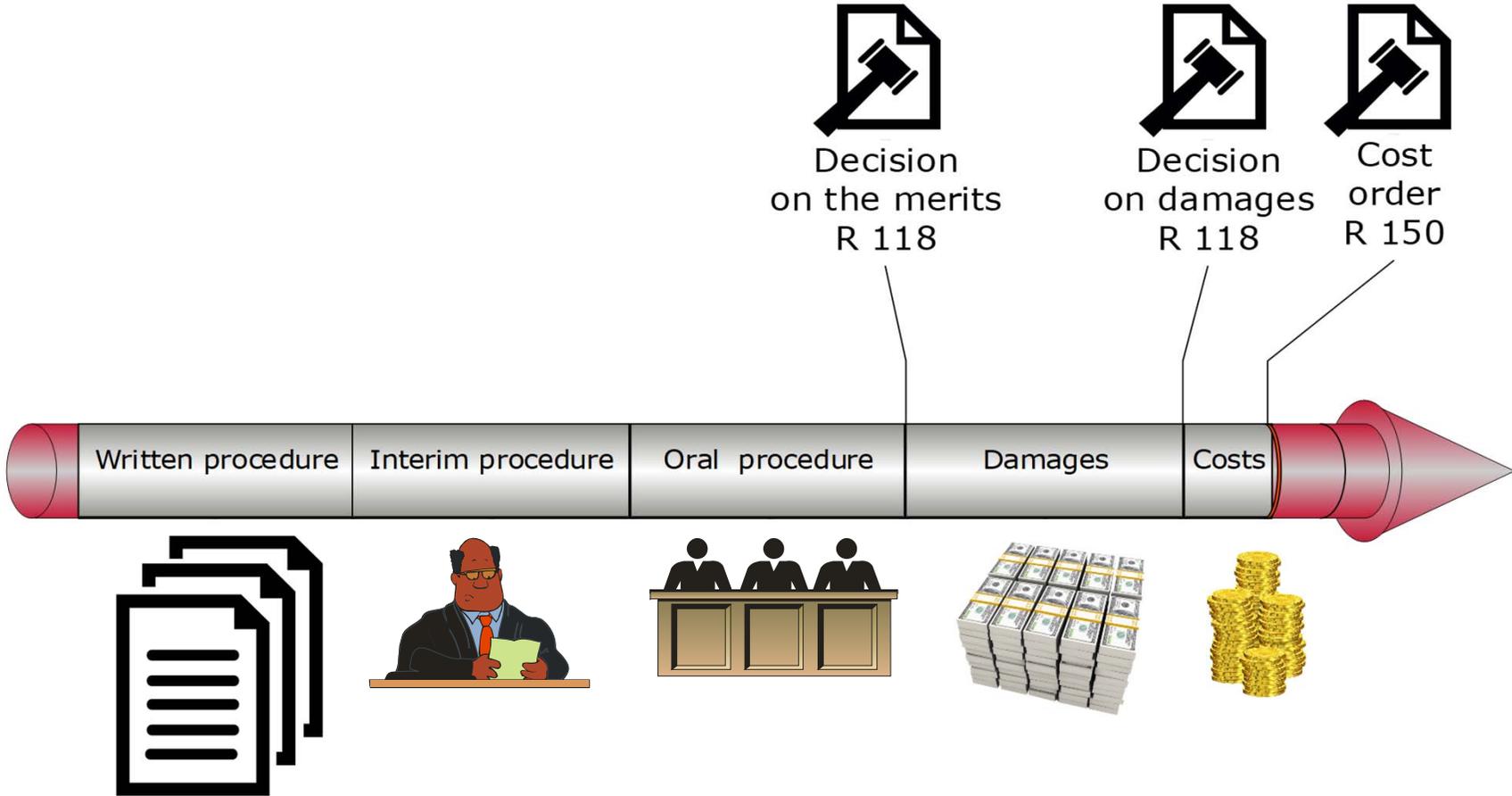
Rule 8 ROP

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



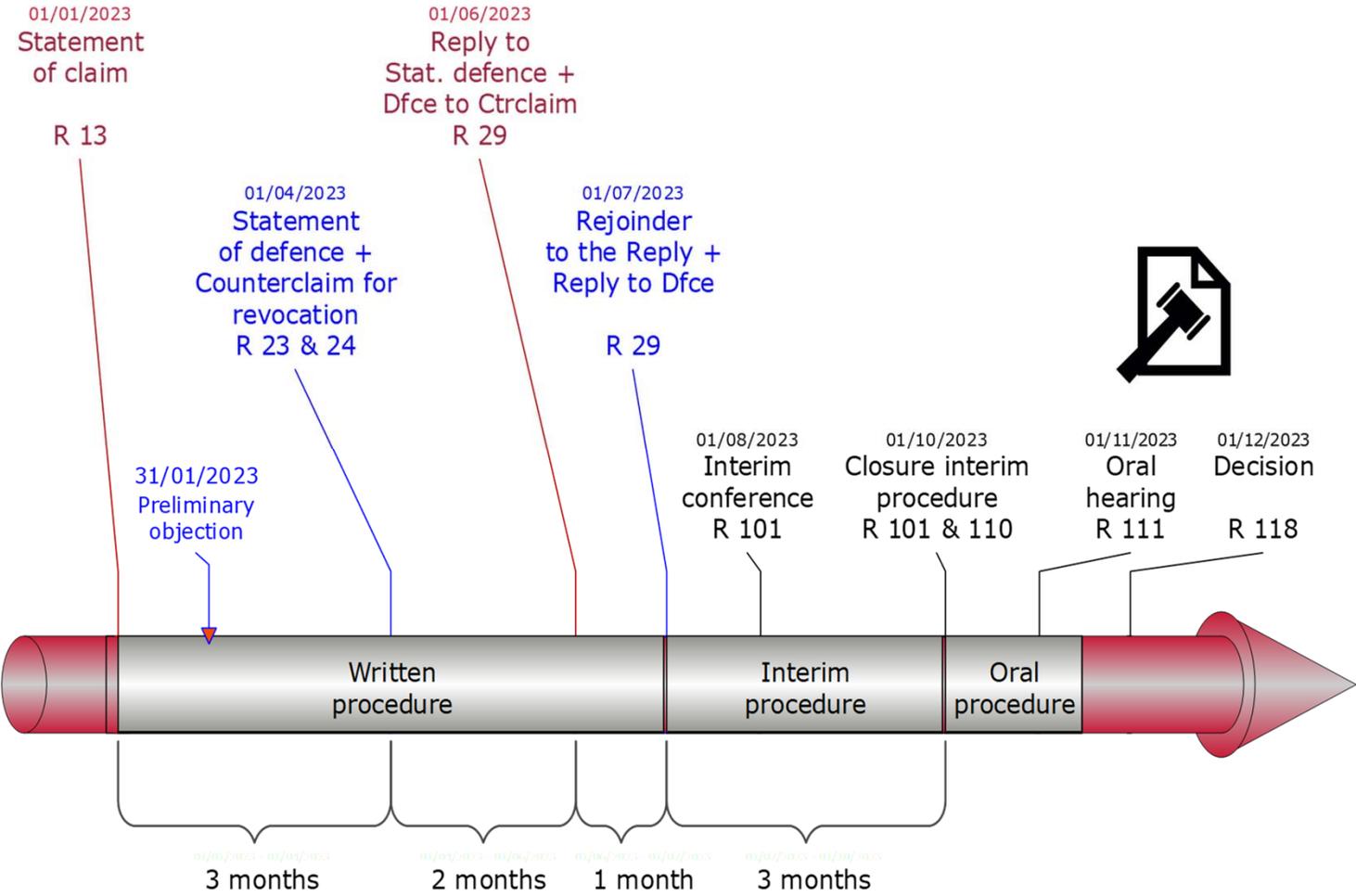
Feature 4

Preformatted proceedings



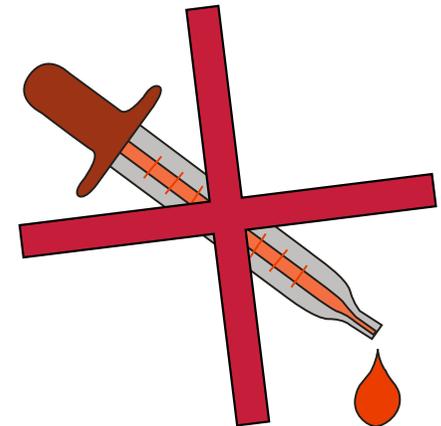
Feature 4

Preformatted proceedings: example of infringement action



Feature 5

Front loading system (not drips and drabs system)



Preamble and Rule 9 § 2 ROP

"Parties shall... set out their full case as early as possible in the proceedings"
"The Court may disregard any step, fact, evidence or argument which a party has not taken or submitted in accordance with a time limit set by the Court or these Rules."



Feature 6

The judge-rapporteur: a key person



Feature 7

Oral hearing: one day



“Rule 113 – Duration of the oral hearing

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



Feature 8

Hearing of a witness in person exceptional



Feature 9
Rule 220

Appealable decisions

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

a) final decisions of the Court of First Instance;

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

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



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

Feature 10
Costs



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

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

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



(Art. 36 of the Agreement)

End of the overview

Any questions on this overview, before discussing the relationship between UPC and EPO

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- Art. 65 UPCA R 118 (2) & (4),



Article 9 Regulation 1257/2012 Unitary Patent

Administrative tasks in the framework of the European Patent Organisation

“1. The participating Member States shall, within the meaning of Article 143 of the EPC, give the EPO the following tasks, to be carried out in accordance with the internal rules of the EPO:

- a) requests for unitary effect*
- b) Register for unitary patent protection*
- c) register statements on licensing referred to in Article 8 by the proprietor of the European patent with unitary effect in international standardisation bodies;*
- d) to publish the translations during the transitional period*
- e) to collect and administer renewal fees for European patents with unitary effect... as well as to distribute part of the collected renewal fees to the participating Member States;*
- f) to administer the compensation scheme for the reimbursement of translation costs referred to in Article 5 of Regulation (EU) No 1260/2012;*
- g) to ensure that a request for unitary effect by a proprietor of a European patent is submitted in the language of the proceedings*
- h) to ensure that the unitary effect is indicated in the Register for unitary patent protection, where a request for unitary effect has been filed”*



Relationship UPC/EPO

UPC powers over decisions of the EPO about Unitary Effect of a European Patent

■ *Article 32 Competence of the Court*

(1) The Court shall have exclusive competence in respect of:

...

(i) actions concerning decisions of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012. ARTICLE 66

■ *Article 36 Powers of the Court concerning decisions of the EPO*

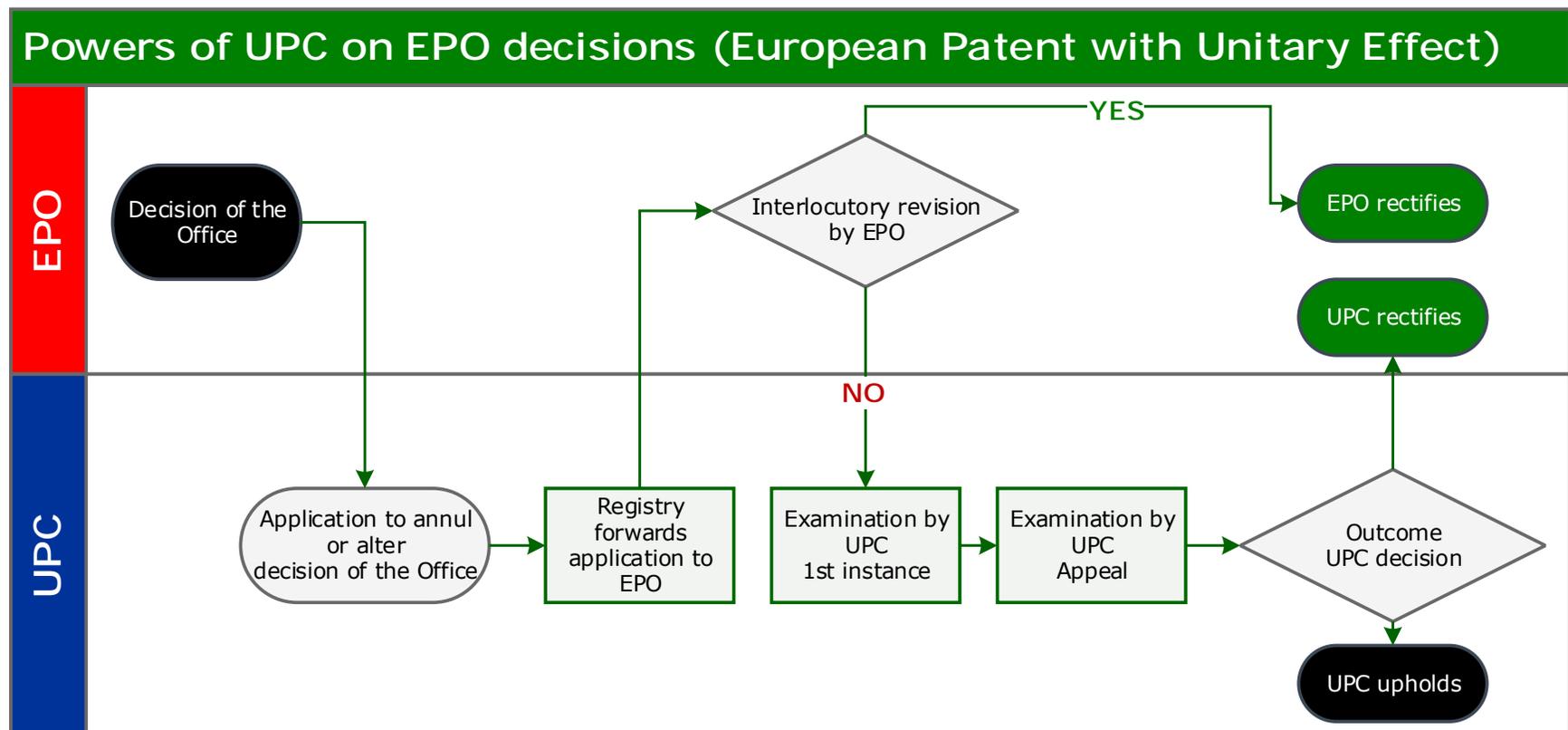
(1) In actions brought under Article 32(1)(i), the Court may exercise any power entrusted on the European Patent Office in accordance with Article 9 of Regulation (EU) No 1257/2012, including the rectification of the Register for unitary patent protection.

(2) In actions brought under Article 32(1)(i) the parties shall, by way of derogation from Article 69, bear their own costs.



Relationship UPC/EPO

Actions before UPC about decisions of the EPO on EPUE ("Unitary Patent")



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Relationship UPC/EPO

During UPC proceedings, request for accelerated proceedings before the EPO



“Rule 298 – Accelerated proceedings before the European Patent Office

The Court may of its own motion or at the request of a party request that opposition proceedings or limitation proceedings (including any subsequent appeal proceedings) before the European Patent Office be accelerated in accordance with the proceedings of the European Patent Office. The Court may stay its proceedings in accordance with Rule 295(a) pending the outcome of such request and any subsequent accelerated proceedings.”



Relationship UPC/EPO

Decision on the validity of the patent (Art 65 UPCA)

- " (1) *The Court shall decide on the validity of a patent on the basis of an action for revocation or a counterclaim for revocation.*
- (2) *The Court may revoke a patent, either entirely or partly, only on the grounds referred to in Articles 138(1) and 139(2) of the EPC.*
- (3) *Without prejudice to Article 138(3) of the EPC, if the grounds for revocation affect the patent only in part, the patent shall be limited by a corresponding amendment of the claims and revoked in part.*
- (4) *To the extent that a patent has been revoked it shall be deemed not to have had, from the outset, the effects specified in Articles 64 and 67 of the EPC.*
- (5) *Where the Court, in a final decision, revokes a patent, either entirely or partly, it shall send a copy of the decision to the European Patent Office and, with respect to a European patent, to the national patent office of any Contracting Member State concerned."*

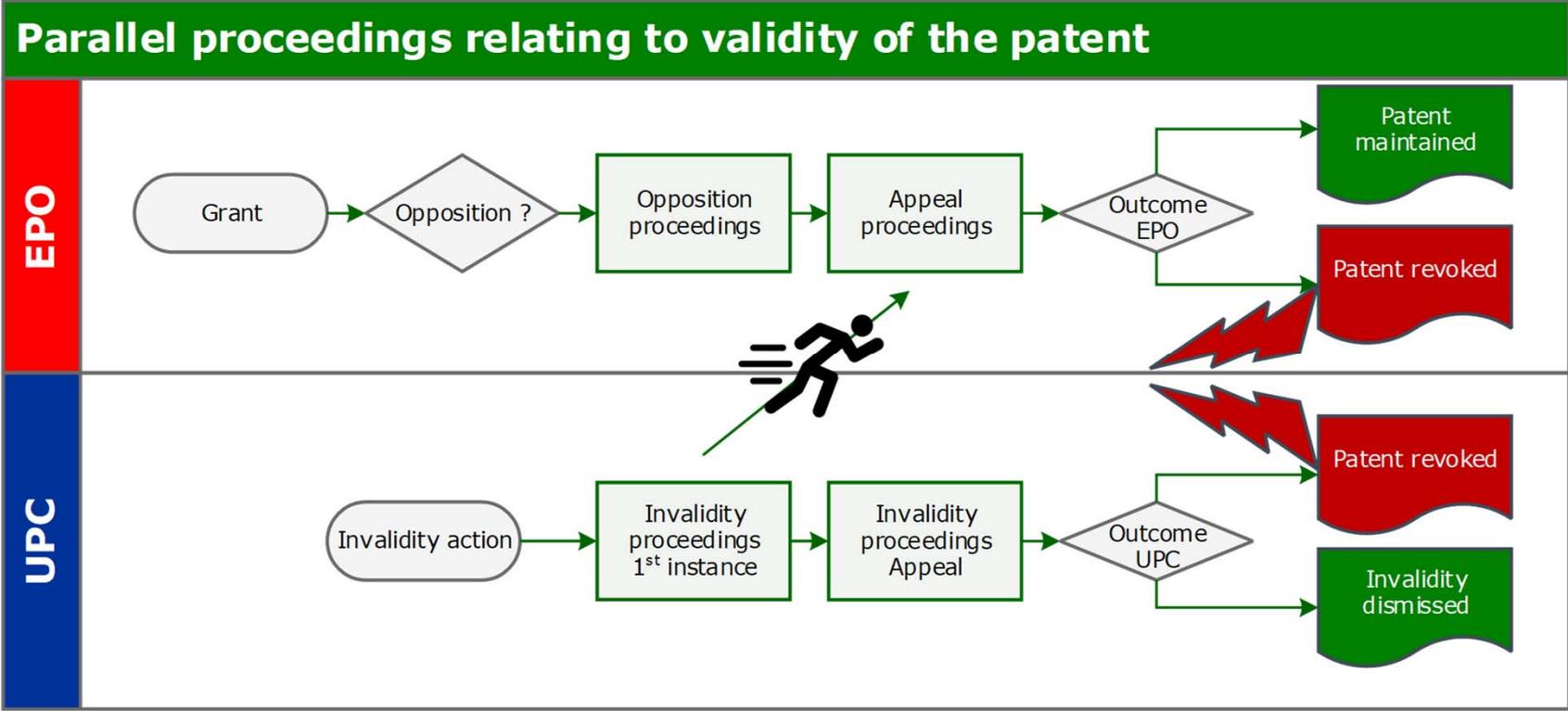


Decisions on the merits: Parallel revocation action or parallel opposition pending

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



Relationship UPC/EPO when parallel proceedings on validity are pending



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Thank you



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