

Responses to the Public Consultation on the Rules of Procedure of the UPC

Digest of Comments Received				
Rule	Source	Comment	Comments WT	Decision of Committee Meeting
Preamble	2 – PAT	<p>This respondent wishes the preamble expressly to recognise that “quality must take precedence over speed”.</p> <p>A similar comment is made by 48 – GRUR which feels that some of the tight deadlines provided for in the Rules, particularly in relation to a defendant seeking to prove invalidity, may be very difficult to achieve.</p> <p>The preamble as it stands seems to provide for adequate flexibility in timing and this is reflected in the current Rule 9.</p>	<p>No change recommended</p> <p>Preamble defines highest quality by proportionality, flexibility, fairness and equity and summarizes in para. 6: decisions of highest quality.</p> <p>As to time-limits:</p> <ol style="list-style-type: none"> 1. Rule 9 gives flexibility. 2. JR may extend time-limits. 3. Length of regular time-limits: to be discussed together with the relevant Rule 	No change required
Rule 1.2	16 – CSO	<p>This respondent believes that the President of the Court of First Instance is given far too many rather menial tasks to undertake and that it would be prudent to provide for a general and express ability for the President to delegate his tasks to another judge.</p> <p>It would be difficult to deal with this on a case-by-case basis and therefore either such a general power of delegation should be included or not.</p>	<p>To be discussed.</p> <p>Proposal: Add a new 1.3:</p> <p>"The President of the Court of First Instance and the President of the Court of Appeal may delegate specific tasks reserved for themselves by these Rules to a judge adjoint (or: assistant judge) acting on their behalf and under their control."</p>	<p>No change required</p> <p>It was agreed that, while the President would inevitably receive assistance in carrying out certain tasks, these should be carried out in the President's name and under the President's responsibility.</p>
Rule 2 and Rule 5	4 – AIPPI	<p>This respondent refers to Article 83(3) of the Agreement which refers to “proprietor or applicant” with regard to patents but</p>	<p>No change recommended:</p> <p>The application for a SPC does not</p>	<p>Small change agreed</p> <p>Rule 2 will be amended to refer to the</p>

		<p>only “holder” with regard to an SPC. The comment is made that it will be important for a company to have the ability to opt-out an <u>application</u> for an SPC and it is suggested that this can be resolved by a new Rule 2.3 as follows:</p> <p>“A holder of an SPC for the purposes of the Agreement shall mean both the holder of a granted SPC and an applicant for such SPC”.</p> <p>This appears to be sensible.</p> <p>Similar comments are made by 10 – CMS, 13 – EPLAW, 25 – TEVA, 21 – PUR.</p>	<p>give any rights to be decided by the UPC and subject to an opt-out, whereas the published application for a European patent gives such rights (Art. 67 EPC).</p> <p>(A Parallel: No opt-out for a patent application not yet published.)</p> <p>Therefore, the wording of Art. 83(3) (“holder”) is correct (see Art. 2 lit. h).</p>	<p>“holder” of an SPC to consistent with the Agreement.</p> <p>No reference to an “applicant” for an SPC is required for the reasons stated by WT.</p>
Rule 2	81 – JD	<p>This respondent points out that Rule 2.1 refers to a supplementary protection certificate as defined in Article 2(h) of the Agreement. It is the view of this respondent that Article 2(h) is wide enough to cover an SPC granted on a national patent and therefore Rule 2.1 should make it clear that “in these rules” a supplementary protection certificate refers to an SPC which has been based only on a European patent or an European patent with unitary effect.</p> <p>Is this really necessary?</p>	<p>No change recommended</p> <p>Rule 2.1 is referring to Art. 2(h) which is referring to the two SPC-Regulations applicable only for national patents or national parts of EP.</p>	No change required
Rule 3	19 – IPO	<p>This respondent suggests a small amendment to Rule 3 to make it clear that where the rules provide for an act to be done by the “Registrar” that act also may be performed by a member of staff of</p>	<p>No change recommended</p> <p>This is already expressly said in Rule 3.</p>	<p>Change agreed</p> <p>It was agreed to add “or Registrar” to Rule 3.</p>

		<p>the Registry or relevant sub-registry.</p> <p>This seems a very sensible suggestion.</p>		
Rule 4	2 – PAT	<p>This respondent suggests that pleadings and other documents should not be required to be filed exclusively in electronic form. It anticipates that such a method will be error prone and burdensome to small and medium sized businesses. Other methods of filing, it is suggested, should be provided for.</p> <p>A similar comment has been made by 36 – ABPI, 6 – KAS (who suggests that documents may be lodged by post or private courier in exceptional cases, for example if the applicant’s computer system is temporarily failing), 48 – GRUR.</p> <p>Hitherto the Rules have been based on an electronic filing system. Do we wish to reconsider this?</p>	<p>Change recommended.</p> <ol style="list-style-type: none"> 1. No general admission of electronic and printed form. Otherwise the electronic file would not work. No change 2. Since all documents must be handed in by a representative electronic means will always be available also in the case of an individual (employee). No change. <p>But</p> <ol style="list-style-type: none"> 3. The RoP should provide help in cases of electronic break-down and in other cases of urgency. <p>Proposal:</p> <p>Add to Rule 4:</p> <p>"The receipt of any electronic entry shall be confirmed by the Registrar. Written pleadings and other documents may be handed in in paper-form to make sure that time-limits are met, especially when the electronic entry of such document is not confirmed by the Registrar, or in cases of extreme urgency. Where the document has been handed in in a printed form, it must be handed in in electronic form within a week</p>	<p>Change agreed</p> <p>It was agreed to amend Rule 4 to:</p> <ul style="list-style-type: none"> provide for an automatic receipt on electronic filing; and permit the alternative methods in Rule 271 where electronic filing cannot be effected, with the electronic copy to follow “as soon as practicable”. <p>A fixed time limit for lodging electronic copies was excluded, as the electronic system might be off-line for longer.</p>

			from the date of entry in a printed form. Otherwise it will be disregarded by the Court."	
Rule 4	5 – KOS	This respondent points to Rule 271.3 which provides for a method of alternative service where electronic communication is not possible. It is suggested that Rule 4 should allow service generally in accordance with Rule 271.3 if for any reason an electronic communication is not available or successful. Again this is worthy of discussion.	No change recommended Taken care of by the above Proposal.	Agreed. Addressed above
Rule 4	91 – FICPI-I	This respondent suggests that Rule 4 should be expressly amended to provide for an automatic electronic receipt.	No change necessary Taken care of by my Proposal above.	Agreed. Addressed above
Rule 5	63 – JIPA	In view of the importance of the opt-out provision this respondent wonders whether it should be expressly provided that an application to opt-out pursuant to Rule 5 should be in electronic form.	No change recommended Taken care of by the above Proposal.	Agreed: no change
Rule 5	4 – AIPPI	According to this respondent, it is unclear whether if a proprietor opts-out a European patent this will automatically extend to any subsequent SPC granted in respect of that patent. This should be clarified if only to avoid a second fee being payable. This, it is suggested, could be clarified either by a new Rule 2.3 or a further sub-rule to Rule 5 as follows: "An opt-out entered in the register in respect of a European patent pursuant to this Rule 5 shall automatically extend to any SPC granted upon the expiry of such	Change recommended SPC should be treated in the same way as EPC-designations: 1. No SPC-opt-out without an opt-out for the patent and for other SPC. 2. Automatic opt-out-effect of a patent-opt-out for a SPC granted later. Proposal:	Changes agreed It was agreed to adopt WT's proposal to treat SPCs in the same manner as EPC designations, i.e.: • No SPC-opt-out without an opt-out for the patent and for other SPC. • Automatic opt-out-effect of a patent-opt-out for a SPC granted later. A carve out from Rule 2 is necessary.

		<p>European patent”.</p> <p>Again this appears sensible, but see the following comments.</p>	<p>Add to Rule 5.1:</p> <p>"Sentences 2 and 3 shall apply also regarding the relation between a European patent and any SPC granted upon the expiry of such European patent or between such SPCs. An opt-out entered in the register in respect of a European patent shall extend to any SPC granted later”.</p> <p>(As to the fee-question, see Rule 5.3 below)</p>	<p>It was also agreed to add provisions to confirm that a patent may be opted-out even after its expiry, and that such an opt-out may be withdrawn. The rules on opt-out of SPCs should also take this into account.</p> <p>Status of divisionals</p> <p>There was a debate as to whether divisionals should be treated as part of the same application to opt-out. Some Committee members considered that an application to opt-out a parent should also require opt-out of any divisionals to avoid the situation of a parent being in the system and a divisional being opted-out. Others considered that such a requirement would be contrary to the Agreement, given that divisionals are separate patents.</p> <p>The issue was considered again by the Committee at its meeting on 14 December 2014. A number of different proposals were debated. However, after further discussion, the Committee concluded that treating divisionals other than as separate patents in Rule 5 for the purpose of opting out would be administratively impracticable as well as politically controversial.</p>
Rule 5	10 – CMS	<p>This respondent raises the situation where the holder of an SPC is not the same entity as the underlying patent proprietor. It suggests a new provision to clarify an opt-out in this situation.</p> <p>A similar comment has been made by</p>	<p>No change recommended</p> <p>Taken care of by the proposed reference to sentences 2 and 3 of Rule 5.1 in the above Proposal.</p>	<p>Addressed above</p>

		<p>14 – EPI, 25 – TEVA .</p> <p>The solution would seem to be to treat each holder of an SPC and the proprietor(s) of the underlying patent as co-proprietors for the purposes of Rule 5, but there is a conflict with the automatic opt-out proposal made by 4 – AIPPI, the proposal of 33 – IP and 36 – ABPI.</p>		
Rule 5	33 – IP	<p>This respondent makes a similar point but specifically queries whether there is a mechanism to ensure that the opt-out will automatically apply to all the national SPCs i.e. how can this be dealt with by the Registry? It further suggests that it should be made clear that no further fee is payable in respect of subsequent granted SPCs.</p> <p>A similar comment is made by 56 – INT.</p>	<p>No change recommended</p> <p>Taken care of by the above Proposal.</p>	Addressed above
Rule 5	36 – ABPI	<p>This respondent makes the different point that where there are different proprietors of SPCs in different contracting member states all based upon the same European patent these proprietors must be able to decide independently whether to opt-out the SPC, assuming that there is provision which will automatically extend an opt-out to later granted SPCs is accepted.</p> <p>A similar comment is made by 68 – LIM.</p>	<p>No change recommended</p> <p>Taken care of by the above Proposal.</p>	Addressed above
Rule 5	25 – TEVA	<p>This respondent supports the note to Rule 5 of the Drafting Committee but would prefer that the substance of the note is</p>	<p>No change recommended</p> <p>The contents of the note is already in</p>	<p>Agreed: no change</p> <p>As explained by WT, the drafting note is</p>

		<p>actually incorporated into Rule 5 for clarity pending a decision of the Court on the issues raised.</p> <p>A similar comment is made by 6 – KAS.</p>	<p>Rule 5:</p> <ol style="list-style-type: none"> 1. Complete ousting: The object of the opt-out is the EP (Rule 5.1 first sentence) 2. Life-time-effect: Ending only with an opt-in (Rule 5.6). (Effect even after lapse of the EP!). 3. Covering all designations: Sentence 3 of Rule 5.1. 	<p>explanatory rather than additional. It is intended to remove it from the final version of the Rules.</p>
Rule 5	81 – JD	<p>This respondent points out that an SPC is a sui generis right and that this applies also to SPCs granted on a European patent with unitary effect as well as to SPCs granted on the basis of a European patent. Therefore there should be an opportunity to opt out SPCs granted on a patent with unitary effect.</p> <p>It was confirmed at the Venice conference that it is unlikely that there will be at least in the short term a regime for granting SPCs centrally with regard to European patents with unitary effect, i.e. companies will have to continue to apply nationally in respect of such rights. It is suggested therefore that Rule 5 should be specifically amended to provide for the opt-out of these SPCs on the same basis as SPCs granted in respect of European patents, i.e. all such SPCs must be opted-out together irrespective of the proprietor.</p>	<p>No change recommended</p> <p>I agree with Kevin's comment: The Commission thinks about that problem (SPC for EPUE) but has until now has come to no result.</p>	<p>Clarification agreed</p> <p>It was reported that a regime for the central grant of SPCs based on European patents with unitary effect is unlikely to be introduced for some foreseeable future. SPCs based on a European patent with unitary effect will therefore be granted on a national basis.</p> <p>It was agreed to add a provision stating that, for the avoidance of doubt, SPCs (whether granted nationally or centrally) based on a European Patent with unitary effect cannot be opted out.</p>

		This needs to be discussed and agreed.		
Rule 5.1	4 – AIPPI	<p>1. This respondent believes that the last sentence of Rule 5.1 is ambiguous and may be interpreted to allow the opt-out to be made only for some national designations. It is suggested that the last sentence be amended so as to read as follows:</p> <p>“The Application shall be made in respect of all the contracting member states for which the European patent is designated”.</p> <p>Sensible but see below comment of 30 – CIPA.</p> <p>2. It is further suggested for the same reason that the word “concerned” in Rule 5.2(b) should be deleted.</p>	<p>1. True, but no change recommended</p> <p>The text of Sentence 3 of Rule 5.1 is not ambiguous. It is saying even more than the sentence proposed by AIPPI: The application must be made by all proprietors (not only by one proprietor of all designations owned by different persons).</p> <p>2. Yes, but strike "in the case of patents" (applies also to applications) and "concerned".</p>	<p>1. Change made</p> <p>In the proposed revision of Rule 5 circulated in advance of the meeting, the proposed re-wording on the final sentence of Rule 5.1 was adopted. The previous sentence makes it clear that all proprietors or applicants must lodge the application.</p> <p>2. Change made</p> <p>In the proposed version of the Rule, “concerned” and “, and in the case of patents the designated Contracting Members States concerned” have been deleted.</p>
Rule 5.1	30 – CIPA	<p>This respondent also believes that Rule 5.1 may need clarification if it is designed to ensure that all designations owned by all proprietors are to be opted-out. However it goes on to comment that, since Article 83(3) of the Agreement provides that “a proprietor...shall have the possibility to opt-out”, the requirement that all designations be opted-out may be inconsistent with this provision.</p> <p>A similar comment is made by 41 – SWED.</p> <p>46 – HGF also believes that Rule 5.1 is</p>	<p>No change recommended.</p> <p>1. Art. 83(3) only allows to exclude the jurisdiction of the UPC regarding an EP</p> <p>- completely (= regarding all claims, all designations, all owners),</p> <p>- erga omnes and</p> <p>- forever (if no opt-in)).</p> <p>Reason: to avoid diverging decisions by the UPC and the</p>	<p>1. No change made</p> <p>As noted by WT, all designations of the patents must be kept together.</p>

		<p>ambiguous and if it is clarified so that all designations must be opted-out then it should be clear that this only requires one fee regardless of ownership.</p>	<p>national courts.</p> <p>2. No change recommended</p> <p>Since the patent is opted out (not the applicant) the fee must be the same where there are more than one patent-owners.</p>	<p>2. Change made</p> <p>An additional sentence has been proposed for Rule 5.3 (now 5.5) to clarify that a single fee is payable.</p>
Rule 5.1	33 – IP	<p>This respondent believes that, since different proprietors may own different designations and since Article 83(3) is not clear that all designations must be opted-out, the Rule should be amended to make it entirely clear that proprietors can act independently as to whether or not a particular designation is opted-out. It understands that this may mean some designations are in and some are out. However the respondent sees a greater mischief in forcing different proprietors to reach agreement on this issue where there is no mechanism for resolving a dispute.</p> <p>A similar comment is made by 36 – ABPI, 6 – KAS .</p>	<p>No change recommended.</p> <p>See previous comment.</p>	<p>No change made</p> <p>See previous comments by WT.</p>
Rule 5.2(a)	4 – AIPPI	<p>It is further suggested that Rule 5 should expressly allow the Application to opt-out to be filed by a representative, in which case Rule 5.2(a) should include reference to the postal and electronic address of the representative.</p> <p>Sensible again but see below the comment of 30 – CIPA as to meaning of “representation”.</p>	<p>Change recommended.</p> <p>The opt-out (and opt-in) must use the Form (asterix). This is enough to prevent any chaos.</p> <p>No obligation to use the expensive lawyer or patent attorney under Art. 48(2).</p> <p>Clarifying Proposal: Add at the end of Rule 5.1: "Rule 8 does not apply for</p>	<p>Change made</p> <p>A new Rule 5.4 has been proposed, based on WT's proposal.</p> <p>It additionally states that – where a party uses a representative – such a representative may include Art 134(1) EPC representatives in addition to Art 48 representatives. This aims to prevent other non-legal ‘representatives’ from being used. (See also 91 – FICPI-I on</p>

			Applications under Rule 5." Include Rule 5 into the bracket of Rule 8.	Rule 5.2(c), below.) Rule 5 is to be added to the exceptions noted in in Rule 8.1, as noted by WT.
Rule 5.2(a)	30 – CIPA	<p>This respondent makes a more general point concerning representatives. It believes that Rule 5 should make it clear that an opt-out or withdrawal may be filed not only by a representative appointed under Article 48 of the Agreement, but also by a European patent attorney appointed pursuant to Article 134(1) of the European Patent Convention. It comments that in the vast majority of cases the proprietor of a patent or application will have appointed a European patent attorney, but will have not appointed a representative for the purposes of litigation under Article 48 of the Agreement.</p> <p>A similar comment is made by 36 – ABPI</p> <p>A similar comment is also made by 50 – ORD who further comments that since an application to opt-out can be made at the application stage it is most convenient that this should be done by such an EPC representative.</p> <p>This may pose a practical problem for the Registry but should be considered. It may also require an amendment to Rule 8.</p>	Yes. See the above Proposal.	See above
Rule 5.2(b)	6 –	This respondent suggests that in the case of an application to opt-out an application for a patent, details should be provided of	Taken care of by the Proposal to	Change to be made

	KAS	<p>the contracting member state <u>to be designated</u>.</p> <p>This seems sensible.</p>	<p>Rule 5.1 re 4 AIPPI</p> <p>Note: Art. 79(1) EPC: All contracting states are designated states initially, but (Art. 79(3) EPC) their number may be reduced. The present wording refers to the status at the time of the opt-out.</p>	<p>If an application has been opted-out, the rules should require that, upon grant, there is a notification of the designations for which the patent is granted.</p>
Rule 5.2(c)	91 – FICPI-I	<p>This respondent suggests that there should be a new Rule 5.2(c) as follows:</p> <p>“(c) where the proprietor has appointed a representative, the name and the postal and electronic address for service of the representative.”</p>	<p>I agree with this proposal</p>	<p>Change made</p> <p>This wording has been adopted in the proposed re-draft.</p>
Rule 5.3	2 – PAT	<p>This respondent believes that the fee for an opt-out should not be prohibitive and should be calculated on the basis of the administrative cost incurred.</p> <p>Similar comments made by 3 – TES, 11 – SCOT, 21 – PUR, 25 – TEVA, 27 – DIG, 31 – LES, 33 – IP, 34 – BLACK, 39 – FUR, 42 – ADIPA, 50 – ORD, 52 – EIP, 8 – BUND, 57 – CNF, 58 – GSK, 59 – QUAL (who also suggest a consideration should be given for discounts where multiple opt-out requests are made by the same proprietor at the same time), 60 – AIPPI-J, 43 – VCI, 75 – FINNCHAM, 80 – CFI, 82 – HAS, 85 – PLUCK, 87 – CDI, 88 – RR, 90 – CSA, 98 – NOK.</p> <p>A similar comment is also made by 99 – IPLA which also suggests (along with other respondents) that the cost of opting-out should be reduced in</p>	<p>Change recommended</p> <p>1. The amount of the fee is a political question.</p> <p>The RoP-draft should not and cannot restrict the room for that decision.</p> <p>2. But clarifying Proposal:</p> <p>Add a second sentence: "The fee shall be the same for all parts of the patent and any SPC granted for it."</p> <p>3. No rebate for multiple patent-opt-outs (but see Nr. 1)</p>	<p>Change made</p> <p>As noted above, a clarifying sentence has been proposed.</p>

		respect of multiple patents.	See above (Nr.3)	
Rule 5.3	3 – TES	<p>This respondent does not believe that the proposed fees for opting out and withdrawing an opt-out fall within article 36(3) of the Agreement. There is no other express basis in the Agreement for charging these fees which are not in respect of proceedings before the Court, rather they are fees which prevent the Court from becoming competent.</p> <p>Similar comments are made by 4 – AIPPI and 13 – EPLAW, 29 – ERIC, 30 – CIPA, 31 – LES, 33 – IP, 34 – BLACK, 41 – SWED, 44 – VAN, 46 – HGF, 54 – DYS, 61 – DIP. 64- FIN who believes that a fixed fee for an opt-out is also contrary to Article 70 of the Agreement, 75 – FINNCHAM, 82 – HAS, 91 – FICPI-I, 94 – SR, 98 – NOK</p>	<p>No change recommended</p> <p>The legal basis for the opt-out-fee is Art. 41(1). The fee is a "detail of the opt-out-procedure".</p>	No change made
Rule 5.4	30 – CIPA	<p>This respondent deplores the fact that an opt-out may delay entry on the Register owing to the inefficiencies in the Registry. It suggests that under this rule the Registrar shall be obliged to enter the opt-out in the Register immediately on receipt. Such entry being conditional on the subsequent satisfaction of Rule 5.3 and subsequent removal in the event of Rule 5.5 applying.</p> <p>Similar comments made by 31 – LES.</p>	<p>No change recommended.</p> <p>The present wording is better (no public servant can react "immediately").</p>	No change made
Rule 5.5	4 – AIPPI	<p>It is further suggested in Rule 5.5 that the first sentence should be amended to read:</p> <p>"In the event that an action has been</p>	I agree with this proposal and with its wording.	Change made

		<p>commenced before the Court in respect of a patent...”</p> <p>A sensible suggestion.</p>		
Rule 5.5	29 – ERIC	<p>This respondent comments that whilst it should not be possible to opt-out or withdraw an opt-out whilst a relevant action is pending, the Rule should make clear that either option will be available if the action has been resolved.</p> <p>Similar comment made by 41 – SWED 77 – AIPPI-F who suggests amending the Rule so that it reads as follows:</p> <p>“unless an action has already been brought and is still pending...”</p> <p>It is suggested that this amendment is necessary to ensure that a patent is not locked-out of the system simply by starting an action and immediately withdrawing it.</p> <p>This seems to be sensible.</p>	<p>No change recommended.</p> <p>The blocking-effect of pending actions has nothing to do with <i>lis pendens</i>.</p> <p>The reason for it is: preventing diverging decisions regarding the same patent on different levels (UPC, national courts).</p> <p>Such differences can arise even after the blocking action has ended: The other court could interpret the claims differently.</p>	<p>Agreed: no change</p> <p>The proposed draft of Rule 5.9 (ex 5.5) implies that once a national action has been commenced no opt-out or withdrawal of an opt-out will be possible, even once the national action has been resolved.</p> <p>This was considered further by the Committee on 14 December 2013. The possibility of allowing an opt-out to be withdrawn once a national action is no longer pending was debated. However, after discussion, it was agreed that Rule 5.9 should not be changed.</p>
Rule 5.5	6 – KAS	<p>1. This respondent points out that Rule 5 as currently drafted does not deal with the situation where an application to withdraw an opt-out is made but there is an existing action before a national court. In such circumstances Article 83(4) does not allow a withdrawal of an opt-out. This should be dealt with.</p> <p>2. Further this respondent believes that the ability to withdraw an opt-out should not revive if at any time a national court</p>	<p>Change recommended</p> <p>1. An already pending national action prevents an opt-in.</p> <p>Proposal:</p> <p>Add to Rule 5.6</p> <p>"unless an action has already been brought before a national court before the entry of the opt-in into the</p>	<p>Change made</p> <p>A new sub-rule has been proposed, based on WT's suggested wording.</p>

		<p>has rendered a decision on the patent in question.</p> <p>This of course is contrary to the comment above of 29 – ERIC.</p>	<p>register."</p> <p>2. This is true and follows from the wording and intention of Art. 83(4). No need to say that in the RoP for the opt-in (and parallel for the opt-out)</p>	
Rule 5.5	91 – FICPI-I	<p>This respondent points out that it is possible for an application for a European patent to be opted-out. However if the applicant subsequently applies for a European patent with unitary effect the opt-out must be ineffective.</p> <p>This seems to be correct.</p> <p>The respondent therefore suggests that Rule 5.5 should be amended so as to read as follows:</p> <p>"5. In the event that (a) a request for unitary effect has been filed with the European Patent Office or (b) an action has been commenced before the Court in respect of a patent(s) and/or an application (or applications) contained in an Application to opt-out prior to the date of the entry of the Application in the Register, the Registrar shall notify the applicant of such request or action as soon as practicable and the application for opt-out shall be ineffective in respect of the patent (or patents) and/or application (or applications) in question."</p>	<p>No change recommended</p> <p>Once the unitary effect is registered, the implementation of Art. 4(2) EPUE-Reg provides that the effect of the EP as national patent evaporates retroactively. Therefore, any registered opt-out is ineffective (because without object), irrespective of whether there was an UPC-action before the opt out (double ineffectiveness) or not.</p>	<p>Change made</p> <p>Where, having opted-out an application for a European patent, the patentee elect for grant of a European patent, the patentee should be required to notify the Registrar of a grant of a European patent with unitary effect.</p> <p>The Committee agreed that there should be <u>no fee</u> to opt-in to the system in this situation.</p>

Rule 5.6	4 AIPPI	– With regard to Rule 5.6 the point is made that a proprietor may withdraw the opt-out in respect of some only of the opted out patents or applications and therefore the Rule should refer to “one or more” not “the”. Similar comment is made by 30 – CIPA, 34 – BLACK, 91 – FICPI-I. This is sensible.	Change recommended Better say: "in respect of any patent (or application) the subject of the opt-out."	Change to be made
Rule 5.6	84 BGMA	– This respondent suggests that 1. a party seeking to withdraw an opt-out should give appropriate notice in addition to paying a fee for doing so. It suggests a notice period of at least six months and preferably one year. This does not seem sensible.	No change recommended Notice-requirement is not in conformity with Art. 83(4)	No change
Rule 5.6	88 RR	– This respondent suggests a higher fee might be charged for an application to withdraw an opt-out.	No change recommended No opt-in fee.	No change
Rule 5.7	5 KOS	– This respondent queries whether the limitation on further opt-out is in conflict with Article 83(3) , which seems to be unrestricted. Similar comments are made by 16 – CSO and 40 – TAL who recommends the deletion of Rule 5.7 as being contrary to the Agreement. A similar comment is made by 110 – CCBE This was discussed and we believe that	No change recommended Rule 5.7 is legally correct. Reason: The right to opt-out is used and exhausted after the first opt-out. The Agreement does not allow for a second opt-out. The opt-in under Art. 83(4) legally is a revocation of the "one-shot-only" opt-out.	Agreed: no change

		a limitation is sensible.		
Rule 5.9	4 – AIPPI	<p>This respondent welcomes the sunrise provision in Rule 5.9 and supports the Note to Rule 5.</p> <p>Similar comments are made by 10 – CMS, 11 – SCOT, 13 – EPLAW, 14 – EPI, 15 – M&S, 19 – IPO, 21 – PUR, 24 – LILLY, 25 – TEVA, 27 – DIG (who strongly suggests a close collaboration with the EPO as soon as possible to ensure a clear and legally robust sunrise regime), 28 – HUN, 29 – ERIC, 30 – CIPA, 31 – LES, 34 – BLACK, 41 – SWED, 42 – ADIPA, 50 – ORD, 52 – EIP, 8 – BUND, 56 – INT, 59 – QUAL, 60 – AIPPI-J, 66 – BIA, 82 – HAS, 85 – PLUCK, 87 – CDI, 88 – RR.</p>	<p>Change recommended</p> <p>The part "shall be treated as entered on the register and effective from the said date of entry into force of the Agreement" is not in conformity with Art. 83(3) and Rule 5.4 requiring an actual (not fictitious) entry into the register of the UPC.</p> <p>Moreover this little cheating is not necessary. The Registrar receives the opt-out in an electronic form which will allow him to enter it immediately into the Register: "one mouse click". There will be no <i>hiatus</i> for squeezing in a UPC-revocation action.</p> <p>Proposal:</p> <p>In Rule 5.9, second sentence: "...all such fees to the Registrar. (delete the rest of the sentence and continue) The Registrar shall enter the Applications received on the Register under the date of entry into force of the Agreement."</p>	<p>Wording revised</p> <p>The proposal for the rule circulated before the Paris meeting incorporated wording based on WT's proposal.</p> <p>The wording should also refer to pending, as well as completed, applications.</p>
Rule 5.9	91 – FICPI-I	<p>This respondent believes that Rule 5.9 is in conflict with Article 83(3) of the Agreement and should be deleted. It believes that the Registry should have the electronic capacity to enter all applications to opt-out on day one.</p>	<p>No change recommended</p> <p>Rule 5.9 will have to be supported by an agreement Select Committee-EPA.</p> <p>Registrar could not handle it on day one.</p> <p>However, the fiction at the end of Rule</p>	<p>See above</p>

			5.9 is not compatible with Art. 83(3) . Necessary is a "real registration". See above.	
Rule 5.9 and 5.2(a)	13 – EPLAW	<p>This respondent points out that if the sunrise provision as drafted is adopted then opt-out applications to the EPO will in many cases be signed by representatives entitled to act only before the EPO, whereas an opt-out application to the Court may only be signed by a representative admitted before the Court.</p> <p>This does need to be considered.</p>	<p>No change recommended</p> <p>See above (Rule 8 should not be applicable).</p>	See above
Rule 5.9	33 – IP	<p>1. This respondent points out that technically Rule 5.9 may be redundant because the Rules of Procedure will only come into force when the Agreement comes into force, and therefore cannot regulate activity before that time. Instead it points out that there should be an amendment to the EPO rules to ensure that applications are processed and transferred in accordance with Rule 5.9.</p> <p>2. Further this respondent points out, quite correctly, that Rule 5.9 has no power to bind the EPO and there is concern as to what remedy a patentee would have if the EPO failed to administer the application to opt-out correctly.</p> <p>3. Instead this respondent suggests a rule requiring the Registry to register applications immediately but with a power to remove if the fee is not paid within a stipulated period, the patentee having been given the chance to remedy the deficiency. This should be</p>	<p>No change recommended</p> <p>1. This will have to be part of the tasks conferred on the EPO under Art. 143 EPC following an agreement between the Select Committee and the EPO.</p> <p>2. The preparation by the EPO is a purely internal service for the future UPC. A remedy will be given only against the action of the UPC (Registrar) registering or not registering the opt out. The EPO will have to transmit also the applications which, under its prognosis, should not be registered. The Registrar will have to decide on such "sick Applications".</p> <p>3. No. Such pre-emptive registering</p>	Blue change made

		<p>accompanied by a provision preventing any revocation action being commenced until 28 days after the coming into force of the Agreement. This one-off arrangement would meet the problem of delays on start up. The respondent sees no reason why such a short, one off delay would prejudice anybody.</p> <p>A similar comment is made by 36 – ABPI in respect of the initial coming into force of the Agreement. However it also makes the following further points.</p> <p>4. The requirement that the opt-out should be entered immediately should be a general requirement subject to removal if the relevant fee is not paid within a stipulated period. Further these should be an express provision where an opt-out and a revocation action are deemed effective on the same day then the opt-out should take precedence.</p> <p>Similar comments are made by 63 – JIPA and 50 – ORD supports the latter point on precedence. 50 – DYS suggests the relevant period should be three months.</p> <p>5. Similar comments are also made by 98 – NOK who proposes a slightly different answer to the problem. It proposes the following amended Rule 5.4:</p> <p>“4. The Registrar shall as soon as practicable enter the application to opt-out in the Register. However the date</p>	<p>would be contrary to Rule 5.3, against all rules for fee-dependent court actions and against legal certainty. And the proposal is not necessary. See comment on Rule 5.9 (4 AIPPI).</p> <p>4. See comments above on Rule 5.9 (33 IP, 4 AIPPI).</p> <p>a) Immediately. Present wording is better. See above (Rule 5.3 – 30 CIPA)</p> <p>b) Removal if no payment: See above (5.9 – 33 IP).</p> <p>c) Precedence of opt-outs:</p> <p>The opt-out effect starts with the entry into the register. The date of arrival of the application is not relevant under Art. 83(3) and Rule 5.4.</p> <p>5. See above</p>	
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		<p>of entry in the Register shall be deemed as the date when the application is received at the Registry except that applications to opt-out received before the Agreement comes into force shall be deemed to have been received and therefore entered on the Register at the moment the Agreement comes into force provided that the fixed fee provided for in Rule 5.3 has been paid on or before that date. Subject to Rule 5.5 the opt-out shall be regarded as effective from the deemed date of entry on the Register and the Court will thereafter have no competence over the patents and applications entered on the Register.”</p>		
Rule 5.9	110 – CCBE	<p>This respondent also points out that the EPO is not under the control of the UPC or the CJEU. It is not clear what remedy the patentee would have if information transferred from the EPO to the Court proves to be incorrect. It suggests that if the sunrise provision is to be retained then there must be a procedure allowing a patentee to correct errors subsequently appearing in the Register.</p>	<p>No change recommended</p> <p>The applicant can enlarge the opt-out-registration (more patents) at any time, if there is no UPC-action coming in between.</p> <p>Reducing the registered opt-out (less patents) needs an opt-in (if no national action comes in between).</p>	No change made
Rule 6	13 – EPLAW	<p>It is suggested that an extra paragraph should be added to this rule to require the Registry to respect the translation requirements of Article 5 et seq. of EU Regulation 1393/2007 when serving decisions and other documents.</p> <p>A similar comment is made by 51 – B&B.</p> <p>This needs considering. Is the</p>	<p>No change recommended</p> <p>The obligation of Art. 4 EPatTranslReg is on the patent owner and subject to the wishes of the defendant (two alternatives) or the Court. Nothing for the Registrar.</p> <p>The defendant and the Court will see to</p>	Agreed: no change

		obligation to be placed on the Registry or the party on whose behalf service is being effected?	their right.	
Rule 7	9 – PHIL	<p>This respondent is most concerned at a potential cost of translating documents into the language of proceedings. It cites experience in the EPO, where if documents are in an EPO language translation is not required. It suggests that Rule 7 should be amended so that for the purpose of the proceedings before the Court a document in one of the three EPO languages should not be required to be translated.</p> <p>This respondent also suggests that irrespective of the local or regional division a defendant should be allowed to defend in any EPO language.</p>	<p>No change recommended</p> <p>This would be contrary to Art. 49. See however the comfort of Rule 13.1 lit q and 13.2 as well as all Rules referring to this twin-provision.</p> <p>Also contrary to Art. 49</p>	Agreed: no change
Rule 7.1	77 – AIPPI-F	<p>This respondent suggests that evidence should be submitted in the original language and translated into the language of proceedings to the extent necessary. Thus they suggest that this rule should read as follows:</p> <p>“...and other documents, including written evidence, shall be lodged in their original language, with a translation in whole or part into the language of proceedings”.</p> <p>A similar comment and drafting recommendation is made by 110 – CCBE</p>	<p>No change recommended</p> <p>See Rule 13.1(q) and 3.</p>	<p>Agreed: no change</p> <p>No change required, for the reasons given by WT.</p>

Rule 7.2	10 CMS –	This respondent would like a general provision to the effect that translation will only be required by the Court where absolutely necessary.	No change recommended Rule 7.1 already is more generous than Art. 49(3) and (4) ("unless the Court provides otherwise").	Agreed: no change
Rule 7.2	110 CCBE –	This respondent suggests that the Rule should make clear how and when the accuracy of a translation is to be challenged.	No change recommended The other party may draw the attention of the Court to any inaccuracy. The Court may notice that itself	Agreed: no change
Rule 8	99 IPLA –	This respondent suggests that there should be a general prohibition on parties or their representatives communicating directly with the Court without prior notice to the other party , unless the communication relates to an ex parte proceeding under these rules.	No change recommended All written communications will be forwarded by the Registrar to the other party. Phone calls cannot be excluded.	Change agreed It was agreed to add a sub-rule to the effect that, unless stated otherwise, there should be no communication with the Court without informing the other parties.
Rule 9	2 – PAT	<p>1. This respondent believes that the current Rules contain a “mishmash of time-limits” from months to working days. It advises time periods expressed only in months and possibly weeks.</p> <p>2. In particular, it regards time limits in terms of “working days” unnecessarily complicated.</p> <p>A similar comment is made by 91 – FICPI-I.</p> <p>“Working days” are stipulated in the Agreement.</p>	<p>Some change recommended</p> <p>1. A total deletion of "Working days" and "calendar days" is not possible</p> <p>"Working days" and "calendar days" are obligatory under Art. 60(8) UPCA (and the referrals to this rule in Art. 61(2) and 62(5) UPCA) based on Art. 7(3) Directive 2004/48 (Enforcement-Directive).</p> <p>(Comment continues with the next respondent)</p>	<p>Change agreed</p> <p>It was noted that the Agreement refers to “working days” and “calendar days” in certain Articles. This could not be changed.</p> <p>However, it was agreed to use “days” (i.e. calendar days, per Rule 300(e)) except where “working days” are specified by the Agreement.</p>

<p>Rule 9 and 300 – Calculation of time periods</p>	<p>4 AIPPI –</p>	<p>This respondent also, correctly, points out that the Rules refer to “days”, “calendar days” and “working days” and says there is “no apparent reason why all time periods should not simply be calculated in calendar days”.</p> <p>Similar comments made by 29 – ERIC, 41 – SWED.</p> <p>All three expressions are used from time-to-time in the Agreement, which has been a complication in drafting the Rules.</p> <p>3. The further suggestion is made that there should be a general provision specifying in a clear and consistent way the point from which time period after the calculated.</p> <p>This point needs careful consideration. Specific provisions have been amended to take care of this.</p> <p>4. The respondent further comments that Rule 9.3 provides generally for the Court to extend time period but that specific rules refer to periods being extended on a reasoned request. It is suggested that these specific references should be deleted leaving Rule 9.3 to apply generally.</p> <p>5. A similar comment is made by 60 – AIPPI-J (representing Japanese lawyers and patent attorneys) who believe that Rule 9.3 should explicitly refer to the need for <u>translations</u> as a reason for</p>	<p>2. But some "working days" should be changed to (calendar) days</p> <p>a) See first Rule 300:</p> <p>"day" is a calendar day.</p> <p>"calendar day" includes official holidays, Saturdays and Sundays: No difficulties with holidays.</p> <p>"working days do not include official holidays of the division, Saturdays and Sundays. This is difficult to handle.</p> <p>b) Therefore, we should restrict "working days" to the obligatory cases. This would mean change from working days to (calendar) days in Rules 197.3, 271.5(b), 321.3 (two times) and 371.4. There it is enough to say "days" (= calendar days).</p> <p>3. Starting point of time-limits: See Rule 300 (a). That rule should, however, be amended in accordance with Rule 131.2 EPO-Implementing Regulation by the following sentence: "In case of a service the relevant event shall be the receipt of the document served."</p> <p>(See comment to Rule 300(a)).</p> <p>4. No change recommended</p> <p>a) Reasoned request: Rule 9 already presently says "of its own motion or</p>	<p>Change agreed</p> <p>It was agreed to remove references to the Judge-Rapporteur's ability to extend deadlines in specific rules, as this is duplicative of the general power in Rule 9.3.</p> <p>The Court's ability to shorten deadlines under Rule 9.3(b) was briefly discussed, and it was agreed that this power was proper.</p> <p>3. At the meeting on 14 December 2013, it was agreed to add “an accordance with Chapter 2” to the end of Rule 300(a) after “In case of a service the relevant event shall be the receipt of the document served” to avoid conflict with the provisions of Rule 271.6(b).</p>
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		<p>extending time limits, 63 – JIPA.</p> <p>A similar comment is made by 70 – LIM-D, who also suggest that extension should have regard to the <u>nature</u> and <u>complexity</u> of the case in question.</p> <p>The same comment is made by 42 – ADIPA.</p>	<p>on a reasoned request".</p> <p>b) Repetition in special cases: Serves information and transparency better than referencing always to Rule 9. And clarifies who (the JR for instance) is granting the extension.</p> <p>5. No change recommended</p> <p>General wording is better than mentioning examples for application (e.g. translations, nature, complexity).</p>	
Rule 9	30 – CIPA	<p>This respondent also deplores the variation in time limits. It suggests that all time limits should simply be expressed in whole calendar months and that there should be a minimum time limit of one month rather than any time limit being expressed in a lesser number of days. It does not believe that a minimum one month period applying throughout would unduly affect the efficiencies of the UPC, but would provide significant procedural simplification.</p> <p>This is in conflict with the Agreement.</p>	<p>No change recommended.</p> <p>See above</p>	Agreed: no change
Rule 9	97 – EGA	<p>This respondent suggests that there should also be a general provision allowing the parties to agree amongst themselves to an extension. It further</p>	<p>No change recommended</p> <p>Time limits must rest under the control</p>	Agreed: no change

		suggests that they may only agree to one extension for a particular activity and that this should be limited to 14 days.	of the Court.	
Rule 9	110 – CCBE	This respondent believes that Rule 9.1 must be made subject to privilege (Rules 287 to 289) and also self incrimination (Rule 179.3).	No change recommended These Rules apply without reference – and Art. 58 (confidentiality)	Agreed: no change
Rule 9.2	93 – FFW	This respondent suggests for clarity that the expression “ in due time ” should be deleted and replaced by “ in accordance with time limits set by the Court or by these rules ”. This seems sensible.	I agree with the proposal.	Change agreed It was agreed to amend Rule 9.2 in line with the proposal.
Rule 9.2	110 – CCBE	This respondent believes that there should be a non-exhaustive list of factors that a court should consider before rejecting late filed evidence. Is this really necessary?	No change recommended There are so many reasons possible that the list would not be indicative for not-listed reasons. The Court will have to consider all circumstances.	Agreed: no change
Rule 9.3	90 – CSA	This respondent also believes that the provision to extend time limits should be a general one, but should be subject to a reasoned request. The Rule should make it clear that periods can only be extended once.	No change recommended There may be reasons for a second extension.	Agreed: no change
Rule 11	31 –	This respondent believes that the Court should be free to propose an alternative	No change recommended	Agreed: no change

	LES	<p>venue for mediation other than the Centre, for example where the action is being heard in a country which has adequate mediation or arbitration facilities locally.</p> <p>A similar comment is made by 57 – CNF.</p>	<p>Under the present wording the Court is free to propose alternatives to the Centre.</p>	<p>It was noted that, other than the Centre, the Court should not recommend specific mediation and arbitration providers. These are commercial operations and there is a potential for abuse/perception of abuse.</p>
Rule 11.2	51 – B&B	<p>This respondent believes that Rule 11.2 in allowing the Court to confirm the terms of any settlement involving a limitation or surrender of a patent is inconsistent with Article 79 of the Agreement which states that a patent cannot be revoked or limited by way of settlement.</p> <p>A similar comment is made by 77 – AIPPI-F, 90 – CSA, 104 – ICC, 105 – AICIPI</p> <p>This respondent also believes that Rule 11 should make it clear that a patent previously revoked cannot be reinstated by way of settlement approved by the Court unless the Court of Appeal has reversed the earlier decision.</p>	<p>No change recommended</p> <p>Rule 11.2 is not inconsistent with Art. 79.</p> <p>1. Art 79 states that a patent may not be revoked or limited by way of settlement. Revocation and limitation are the tasks of the EPO and of the Court.</p> <p>2. Rule 11.2 only allows an obligation to limit, surrender or agree to the revocation of the EP. Art. 105a EPC allows a request by the proprietor that the EP may be revoked or limited. Therefore, the obligation may be executed.</p> <p>3. The parties to a settlement cannot reinstate a patent revoked in the first instance. That is self-understanding and does not need a rule.</p>	<p>Agreed: no change</p> <p>There was a discussion as to whether the parties may “agree to the revocation” of a patent. It was agreed that (as noted by WT), while Article 79 prohibits revocation or limitation by way of settlement, it was within the Court’s power to order such limitation or revocation if agreed as part of a settlement.</p>
Rule 11.2	110 – CCBE	<p>This respondent points out that the parties may not wish to inform the Court of the terms of any settlement but rather keep them confidential. A suggested amendment could be to add after the word “court” in the first line the words “if</p>	<p>I agree with that proposal</p>	<p>Change agreed</p> <p>It was agreed to amend Rule 11.2 in line with the proposal.</p> <p>It was also agreed to amend Rule 11.2</p>

		requested by the parties”.		specifically to refer to confirmation of arbitral awards.
Rule 12.4	110 – CCBE	This respondent suggests that applications to amend the patent should be advertised bearing in mind that this affects the whole world. They suggest that a rule be inserted to require that the EPO be informed so that a note can be entered onto the EPO’s Register. It seems premature and unnecessary to advertise applications to amend rather than amendments which are final.	No change recommended I agree with Kevin's comment	Agreed: no change
Rule 13	104 – ICC	This respondent believes that where the claimant is a corporate entity there should be mention of its structure, its registered office or principle place of business.	No change recommended Not more than Rule 13.1(c). The other party may find out any interesting details about the claimant.	Change agreed It was agreed that the registered office should be given for corporate entities. The same corporate name might refer to companies in more than one country (e.g. “Company Name SA” might exist in both France and Belgium).
Rule 13.1(g)	91 – FICPI-I	1. It is suggested that only the number of the relevant patent need be given. 2. However this respondent also believes that the claimant should file a translation of the patent (or patents) concerned into the language of proceedings where the language of grant is not the language of proceedings. This should be discussed.	No change recommended 1. The Statement of claim must present the details of the patent on which it relies for its arguments. 2. The patent-document will have to be handed in according to Rule 13.1(q) and 2 in the language of the proceedings, if the JR does not waive this requirement (Rule 13.3)	Agreed: no change This was discussed, but it was agreed that no change should be made.
Rule 13.1(h)	14 – EPI	This respondent believes that the duty of disclosure should be limited to related proceedings in the EPO or any other	No change recommended 1. The obligation to inform is limited to	Agreed: no change

		<p>court in the EPC member states. It does not see the immediate relevance of proceedings in non-EPC member states.</p>	<p>the EP concerned.</p> <p>2. Information about proceedings in "any other court or office" (Non-MS EPC-States) is valuable for the Court.</p>	
Rule 13.1(l)	36 – ABPI	<p>This respondent suggests that this rule be amended to read "such details of the facts relied on as are available..." rather than the present word "indication".</p> <p>This seems to be an acceptable amendment.</p>	<p>No change recommended</p> <p>1. The "facts relied on" can only be those "available" for the claimant (otherwise he would not rely on them).</p> <p>2. "Instances" in Rule 13.1 lit. I (i) does not mean only samples but covers facts, e.g. those seen by witnesses.</p>	Agreed: no change
Rule 13.1(q)	8 – BUND	<p>The suggestion is made that the list of documents should also include all witness statements referred to in the Statement of Claim.</p> <p>This seems sensible.</p>	<p>No change recommended</p> <p>1. Rule 170.1(a) distinguishes between "documents" and "written witness statements"</p> <p>2. Rule 171 obliges to indicate the means of evidence.</p> <p>3. Rule 175 allows witness statements.</p> <p>That seems to be enough.</p>	<p>Change agreed</p> <p>It was agreed to add a reference to witness statements to Rule 13.1(q).</p>
Rule 13.2	13 – EPLAW	<p>This rule should be amended to allow the possibility of withholding documents referred to in the Statement of Claim which are the subject of a request pursuant to Rule 13.1(q).</p> <p>This seems to be a sensible suggestion.</p>	<p>No change recommended</p> <p>The original should always be supplied. The "request" under Rule 13.1(q) and 13(3) concerns only the translation.</p>	<p>Change agreed</p> <p>It was agreed to add a reference to requests to withhold confidential information.</p>

Rule 13.3	16 CSO –	<p>This respondent points out, correctly, that the judge-rapporteur has not yet been appointed at this stage of proceedings. The following words could be added to the Rule:</p> <p>“As soon as practicable after his appointment pursuant to Rule 18”.</p>	<p>No change recommended.</p> <p>It is self-understanding that the JR can decide on the request only after he has been designated under Rule 18.</p>	<p>Change made</p> <p>It was agreed that no change was required. However, the proposed change should be made for clarity.</p>
Rule 13.3	91 FICPI-I –	<p>This respondent believes that the statement of claim should not be served on the defendant until the judge-rapporteur has been appointed and has taken a decision on a request not to translate certain documents under Rule 13(1)(q). It believes that this is essential in order that the defendant can properly understand the contents of the statement of claim.</p> <p>This may appear to be sensible but would involve a potentially serious delay in the service of proceedings.</p>	<p>No change recommended</p> <p>The time-order is correct</p> <p>As long as the JR is not designated (Rule 18) (after the examination as to formal requirements and registration, Rules 16, 17 and, by implication of Rule 19.1, the service on the defendant) the request under Rule 13.3 (not to translate) is not decided. The defendant may write that he cannot understand the document. The JR may then decide on Rule 13.3 taking into account what the defendant has said.</p>	<p>Agreed: no change</p>
Rule 14	25 TEVA –	<p>This respondent points out that this rule concerns the language of proceeding but it is not clear whether this extends to Part 1, Chapter 4 (damages) and Part 1 Chapter 5 (costs). It recommends a further sub-rule to Rule 14 clarifying that the language of proceedings shall apply for these procedures as well.</p> <p>This seems to be sensible.</p>	<p>No change recommended</p> <p>The damage-proceedings and the cost-proceedings are proceedings before the JR of the same panel of the same division in the same MS and continue the proceedings on the merit (are adjacent parts of those proceedings). Therefore the language chosen continues to apply.</p>	<p>Agreed: no change</p>

Rule 14	27 – DIG	<p>This respondent believes that the language regime followed in the EPO should be adopted, namely that the Defendant should be entitled to plead in any of the three official EPO languages and to produce documents in any such language without translation. The only translation requirement should be where amendments are offered; these should be offered in the language of grant.</p> <p>Similar comments made by 29 – ERIC.</p>	<p>No change recommended.</p> <p>This would be contrary to Art. 49.</p>	<p>Agreed: no change</p>
Rule 14.2	2 – PAT	<p>It is pointed out that the Agreement provides in principle for three types of language: the language of domicile, an official language of the EPO and finally the language of grant. There is no provision in the Agreement for “the language in which a party usually conducts business” which is neither practicable to discover nor appropriate as a language of proceedings. A further point is that if a local or regional division offers several languages then as a matter of principle the choice must be left to the Claimant.</p> <p>A similar comment is made by 6 – KAS, 48 – GRUR.</p>	<p>Change is recommended</p> <p>Proposal: Deletion of Rule 14.2</p> <p>1. According to information of Belgian expert lawyers Rule 14.2 is not necessary for Belgium. If that is true, the Rule should be deleted.</p> <p>2. If such a rule would seem to be necessary, it would be up to the relevant CMS to define its "official language" applicable for certain categories of cases and to "designate" them according to Art. 49(1).</p> <p>Also under this aspect Rule 14.2 should be deleted.</p>	<p>No agreement: to be considered by Preparatory Committee</p> <p>At the meeting of the Committee in November 2013, there was a discussion of proposals to replace the current Rule 14.2:</p> <ol style="list-style-type: none"> 1. one by which a Contracting Member State might designate additional languages with conditions for their use 2. one drafted by Margot Froehlinger by which use of an additional language would be restricted to cases where the Defendant operates and infringes only at a local level; and 3. a second option similar to (2) based on discussions between Margot Froehlinger and Belgian colleagues. <p>At the meeting on 14 December 2013 alternatives (1) and (2) were discussed further. The Committee was unable to</p>

				decide on one. It was agreed to leave in both alternatives, together with a note for the Preparatory Committee to the effect that a majority favoured the first alternative. However, the whole Committee would prefer a rule to allow the claimant to choose the language of proceedings..
Rule 14.2	3 – TES	This respondent states that the Claimant has to know precisely in which language to file his Statement of Claim. The criterion “language in which the Defendant normally conducts its business” may depend on internal circumstances unknown to the Claimant. Thus the criterion is unclear and inappropriate.	See above.	See above
Rule 14.2	4 – AIPPI	This respondent also feels that “the language in which the Defendant normally conducts his business” will create considerable uncertainty and is not foreseen in the Agreement and therefore should be deleted . Similar comments made by 5 – KOS; 10 – CMS, 13 – EPLAW, 24 – LILLY (who points out the practical difficulty where there are more than one defendant), 25 – TEVA, 27 – DIG (which points out that the Rule is contrary to translation requirements of EU 1393/2007), 29 – ERIC, 31 – LES, 36 – ABPI, 41 – SWED, 46 – HGF, 51 – B&B, 52 – EIP, 8 – BUND, 56 – INT, 64 – FIN, 6 – KAS, 75 – FINNCHAM, 78 – PB, 79 – VERTEX, 80 – CFI, 81 – JD, 85 – PLUCK, 93 – FFW, 110 – CCBE. A similar comment is made by 99 –	See above	See above

		IPLA which also refers to Regulation EC 1393/2007. It suggests Rule 14 should revert to the 14th draft of the Rules adding a cross-reference to the obligations under the Service Regulation.		
Rule 14.2	9 PHIL	– This respondent believes that this rule is completely unnecessary and limits the claimant’s freedom to choose a language of proceedings where a division elects to have multiple languages. The defendant’s interest is met if the Statement of Claim is served with a translation into an official language of the defendant’s residence. Similar comments made by 14 – EPI, 27 – DIG (see above), 82 – HAS.	See above	See above
Rule 14.2	18 STI	– This respondent suggests some minor amendments to ensure that Rule 14.2 only applies to a defendant domiciled in the relevant state. The amended rule is as follows: “Where a Contracting Member State hosting a local division or Contracting Member State sharing a regional division has/have designated two or more languages of proceedings pursuant to Article 49(1) and/or Article 49(2) of the Agreement the Statement of claim against a defendant domiciled in the Contracting State of the seised local or regional division shall be drawn up in the language in which that defendant normally conducts its business in that Contracting Member State.” A similar comment is made by 30 –	See above	See above

		CIPA, 40 – TAL, 50 – ORD, 90 – CSA, 91 – FICPI-I, 105 – AICIPI, 110 – CCBE.		
Rule 14.2	33 – IP	This respondent believes that the current rule is too prescriptive. It believes that if the choice of language is objected to by the defendant then the defendant should simply have an opportunity to apply for the use of another language of the division to be used as the language of proceedings.	See above	See above
Rule 15.2	16 – CSO	This respondent suggests that the Statement of Claim should not be deemed to have been lodged until it is proven payment has been provided pursuant to Rule 371.2.	No change recommended The referral to Rule 371 as a whole covers Rule 371.2 (payment together with the application)	Agreed: no change
Rule 16.1	13 – EPLAW	This respondent suggests that a claimant should alternatively be permitted to withdraw the opt-out rather than withdrawing the Statement of Claim.	No change recommended He may do so. As claimant of the infringement action he will know about the opt-out anyway. Rule 16.1 is more important for revocation actions. There the patent owner may decide to opt-in (no blockade of the opt-in by a UPC-action)	Agreed: no change
Rule 16.3(a)	91 – FICPI-I	This respondent suggests that 14 days to correct deficiencies is too short and recommends “at least one month”.	No change recommended Formal deficiencies may be repaired quickly.	Agreed: no change
Rule 16.5, 27.4, 89, 229.2, 233.2, 252.2 – decisions by default	19 – IPO	This respondent acknowledges that Rule 356 provides a procedure for setting aside a decision by default, but considers that to be inefficient. It recommends that the judge or panel “shall” always provide an opportunity for a party to be heard before such a decision is made rather than	No change recommended 1. The claimant has been informed by the Registrar and has failed to correct (Rule 16.4). 2. A default decision may be set aside	Agreed: no change

		the existing “may” provision in these rules.	(Rule 356). No harm is done.	
Rule 17.2	3 – TES	<p>This respondent believes that there should be clear rules relating to the distribution of cases within the central division. He asks who is responsible for the distribution and what are the criteria to be applied? Whereas Article 7(2) of the Agreement states that the distribution is to be made in accordance with Annex II, this leaves open the basis upon which this distribution is to be made.</p> <p>He asks whether the EPO classification is to be decisive. He further asks what the situation is if an action is based upon a plurality of patents which are differently classified by the EPO such as in the case of computerised mechanical devices.</p> <p>He further asks whether the parties are to be heard on the intended distribution.</p> <p>Do we think that Rule 17.2 is adequate or should there be additional provisions relating to proceedings in the central division?</p> <p>See also this respondent’s comment on Rule 45.</p>	<p>A discussion is needed</p> <p>1. The general question of assignment of cases to a panel of the division chosen (Rule 13.1) should be discussed again. I would propose to leave the President of the CFI out who is an administrative organ and too far away.</p> <p>It should be the presiding judge of the division (appointed by the Presidium) who is already in charge of allocating the judges (Rule 345.1). (If there is only one panel in the division a distribution of cases is superfluous.)</p> <p>It should be added that the distribution shall be according to the action-distribution-scheme (Rule 345.3). That scheme should allow for some flexibility (special expertise of a panel, related subjects). The handling of such flexibility rule cannot be left to the President of the CFI or the Registrar.</p> <p>If my Proposal is accepted, Rule 345.3 (Registrar assigns cases to the panels) should be changed accordingly.</p> <p>2. In the central division the distribution should be made by the presiding judge of each location (Paris, London, Munich) chosen by the claimant. If the claimant has chosen the wrong location, the presiding</p>	<p>Change agreed</p> <p>It was agreed that, in general, the distribution of cases should be decided locally by the presiding judge of the Division.</p> <p>There was an extensive discussion of how cases should be distributed between the sections of the Central Division. It was agreed that the classification of the patent(s) in suit should be taken into account.</p> <p>However, there was a debate as to how cases involving cases that fall within the competence of more than one section of the Central Division should be distributed.</p> <p>It was agreed that:</p> <ul style="list-style-type: none"> For one patent, its classification should determine its allocation by the Registry to a Section according to Annex II of the Agreement. If there is more than one patent, the majority classification should determine its allocation to a Section. <p>Two proposals were advanced as to how to allocate cases where there is no majority classification. Either:</p> <ul style="list-style-type: none"> The President of the CFI or a functionary of the Court should

			<p>judge will refer the case to the competent location. This Proposal avoids bottle-necks in Paris.</p> <p>3. EPO classification indeed decides over the location of the central division (Footnote 15 to Annex II of the Agreement).</p> <p>4. If there are more than one classes applicable to the patent, the gravity of the subject matter should be decisive for the allocation (see my Proposal for the possible referral to another location)</p>	<p>allocate the case to a Section; or</p> <ul style="list-style-type: none"> The case should be referred to the Section appropriate to the classification of the <u>first</u> patent listed. That Section would decide whether it should hear the case. If it considers not, the case would be referred by that Section to another Section considered appropriate. If that Section does not accept the case, the President of the CFI should allocate it. <p>Two drafts reflecting these approaches were considered by the Committee at its meeting on 14 December 2013. After discussion, the second option was agreed.</p>
Rule 17.2 and 345	110 – CCBE	<p>Rule 17.2 proposes that a case is assigned to a panel at a very early stage. However under Rule 345 it is envisaged that a panel will only sit together for one year. Thus, even if a case is started one or two months into the year, it is unlikely that the panel will still exist to hear the trial. This is a fundamental problem and needs to be considered.</p> <p>One possibility is that the appointment of the judge-rapporteur can be made immediately but the appointment of the other members of the panel can be delayed until, say, the interim procedure or even later. This of course would make referrals from the judge-rapporteur to the panel problematic. Either way further consideration is required, according to this</p>	<p>No change recommended</p> <p>Misunderstanding. The yearly allocation under Rule 345.1 does not mean that the panel is necessarily broken up. The same composition may last for years. The only requirement is that the panel which has sat during the oral hearing is the same which decides the case. Changes before the oral hearing are not welcome but legally possible</p>	<p>Agreed: no change</p>

		respondent.		
Rule 18	10 – CMS	This respondent points out that there is no guidance in the Rules as to which judge within a panel should be appointed as the judge-rapporteur. It suggests that if a local division or regional division has two “local” judges then the non-local judge should be primarily considered as the candidate for appointment as judge-rapporteur. This, it is suggested, would promote harmonisation of practise and help to reduce forum shopping.	No change recommended Belongs to Rule 18. No need to limit discretion of the presiding judge of the panel. The "third judge" often may not be the ideal candidate for becoming JR (language)	Agreed: no change
Rule 18	14 – EPI	This respondent points out that Rule 18 requires the judge-rapporteur to be a legal judge whereas the Agreement is silent on this. This respondent believes that a technically qualified judge might be appropriate in certain circumstances , for example in a revocation action where technical questions may be crucial in the interim phase of proceedings. A similar comment is made by 50 – ORD, 6 – KAS, 105 – AICIPI. A similar comment is also made by 90 – CSA who also recommends that the Rule should be amended so that where a technically qualified judge is appointed as judge-rapporteur he can at any time consult with the presiding judge or a legally qualified judge as indicated by the presiding judge.	No change recommended This would be contrary to Art. 19 Statute. Art. 19(5) Statute speaks of a "judge" of the panel. In the case of a technical judge it uses the words "technical judge" . Therefore, the JR must be a legally qualified judge. See above (14 EPI)	Agreed: no change
Rule 18	30 – CIPA	1. In order to avoid a panel placing too much reliance on existing national practices and in order to encourage	No change recommended	Agreed: no change

		<p>harmonisation this respondent recommends that in the case of a local division with two local judges and in the case of a regional division the judge-rapporteur should ordinarily be the non-local judge.</p> <p>2. It also recommends that where a technical judge is appointed, the nationality of the technical judge should also differ from the majority of judges on the panel.</p>	<p>1. See above (10 CMS)</p> <p>2. The Agreement contains no such requirement.</p> <p>The idea of the "foreign judge" is to mix national legal traditions. In the field of technical know-how such national traditions do not exist.</p>	
Rule 18A – preliminary examination of the Statement of Claim	16 – CSO	<p>This respondent believes that a critical step in the procedure should involve a preliminary examination of the Statement of Claim by the judge-rapporteur before it is served on the Defendant. The reason for this is to ensure efficient case management from the beginning and to avoid a muddled or incorrect pleading being carried forward to the further stages of pleading. This respondent believes that such preliminary examination meets the requirements of efficient and cost effective proceedings as required by Article 41(3) of the Agreement. In addition such preliminary examination allows the judge-rapporteur to consider whether Rule 361 and 362 are relevant at an early stage.</p> <p>The suggested new Rule 18A is as follows:</p> <p>“1. Without prejudice to the freedom of the parties to determine the subject matter of, and supporting evidence for their cases, the judge-rapporteur shall</p>	<p>No change recommended</p> <p>The JR will use the interim procedure (Rule 101 ff) to find out whether (a) the action is manifestly bound to fail (Rule 361) or (b) there exists any absolute bar to proceeding with an action (Rule 362). No need to ask him to do this already at this stage of only formal requirements where he has not read the written pleadings.</p>	<p>Agreed: no change</p> <p>It was noted that a preliminary examination of the type proposed by the commentator would delay and complicate the procedure. It was felt that the parties are best placed to judge the issues raised.</p>

		<p>examine whether</p> <p>(a) the Statement of claim satisfies the requirements of Rules 13(k) to (p),</p> <p>(b) the action is manifestly bound to fail (Rule 361);</p> <p>(c) there exists any absolute bar to proceeding with an action (Rule 362).</p> <p>2. If the Statement of claim does not comply with the requirements laid down in Rule 13(k) to (p), the judge-rapporteur shall ensure the possibility for the claimant to amend the Statement of claim within such period as he may decide.</p> <p>3. The judge-rapporteur shall at the same time inform the claimant that if the claimant fails to correct the deficiencies within the time stated a decision by default may be given, in accordance with Rule 355.</p> <p>4. If the claimant fails to correct the deficiencies, thereby effectively preventing the evaluation of the statement of claim, the judge-rapporteur may reject the action as inadmissible by a decision by default.</p> <p>5. The claimant may make an application to set aside the decision by default in accordance with Rule 356.</p> <p>6. The judge-rapporteur shall decide on any request made pursuant to Rule</p>		
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		<p>13.1(q) as soon as practicable.</p> <p>7. The judge-rapporteur may refer any matter of preliminary examination to the panel for decision and the panel may review of its own motion any decision or order of the judge-rapporteur or the conduct of the interim procedure (Rule 102.1).</p> <p>8. The judge-rapporteur shall refer the case to the panel with his recommendation, if it is clear, that the action manifestly inadmissible or manifestly lacking any foundation in law (Rule 361), or an absolute bar exists (Rule 362). The panel, on the proposal of the judge-rapporteur and after giving the parties an opportunity to be heard may give a decision by way of order.”</p> <p>A similar comment is made by 40 – TAL.</p>		
Rule 18.2	16 – CSO	<p>This respondent believes that the presiding judge should only designate himself as judge-rapporteur in rare cases to avoid this judge having too much influence over the case.</p>	<p>No change recommended.</p> <p>The presiding judge will know himself what burden he can carry.</p>	Agreed: no change
Rule 19	64 – FIN	<p>This respondent points out that there is no current rule which specifically sets out the provisions of Article 33(2) of the Agreement (lis alibi pendens).</p> <p>This is a correct comment but the existence of an existing action in another division between the same parties would found an objection pursuant to Rule 19(1)(b). A further</p>	<p>No change recommended</p> <p>I agree with Kevin:</p> <p>The defendant will argue with Rule 19.1(b).</p>	Agreed: no change

		specific provision therefore is not needed.		
Rule 19.1	13 – EPLAW	<p>It is pointed out that the preliminary objection is only available in three instances whereas it also should be available for other fundamental objections. This respondent suggests the following additional paragraph:</p> <p>“(d) other serious issues, such as expiration of the Statute of Limitations or other abuse of right.”</p> <p>A similar comment is made by 51 – B&B</p> <p><i>A similar comment is also made by 99 – IPLA who refers also to allegations of infringement outside the limitation period and expired patent.</i></p> <p>This seems to open up the use of the procedure to an unsatisfactory degree and will create uncertainty and promote tactical opportunism.</p>	<p>No change recommended</p> <p>See above. The points referred to will be raised by the defendant in the Statement of Defence (Rule 23 ff).</p>	Agreed: no change
Rule 19.1(c)	99 – IPLA	<p>This respondent suggests that this should be deleted. It suggests that Rule 14 should be expanded to entitle a local or regional division to reject a statement of claim that is written in a language other than the language of the division, just as Rule 46.3 empowers the Registry of the central division to reject a statement of claim that is not written in the language of proceedings i.e. the language of the</p>	<p>No change recommended</p> <p>Not using the required language (Rule 14) is checked by the Registrar (Rule 16.2) and the JR who is designated prior to the Preliminary objection (Rules 18, 19). Still, both may commit errors. The defendant must be able to raise that point in the Preliminary objection.</p>	Agreed: no change

		patent.		
Rule 19.3	9 PHIL	– Consistent with other comments made by this respondent, it suggests that the defendant should have the right to use any EPO language for a preliminary objection under this rule. It cites the example of a case commenced in Hungary with a Dutch defendant. The Dutch defendant would be forced under this rule to use Dutch for the purposes of a preliminary objection whilst the respondent would be perfectly happy to use English. This should be no problem either for the Court or the claimant, whereas Dutch is likely to be a genuine problem for the claimant and possibly also for the Court.	Change is recommended Rule 19.3(b) allows the defendant raising the preliminary objection to use an official language of his own state . This is contrary to Art. 49 . Note: Art. 4 EPatTranslReg deals only with the translation of the patent. Proposal (following the suggestion of the respondent): If the idea is followed to give a kind of human rights comfort to the defendant, he should be allowed to use one of the three EPO languages . (But only for the preliminary objection). This would, by the way, help the Court understanding the preliminary objection .	Change agreed It was agreed that Rule 19.3 should be amended to permit the use of the language of the patent.
Rule 19.4	12 GOO	– This respondent also believes that there should be greater flexibility in the transfer of proceedings from one division which is arguably inconvenient to a division which has a much closer connection with the subject matter of the action. It cites the example of a German manufacturer that sells its products throughout the EU. The patentee decides to sue that manufacturer in Portugal where only 1% of the allegedly infringing products are on sale. It suggests that in this situation there should be flexible transfer rules which will allow the Court in the interests of justice to consider whether the action would be better heard in a local	No change recommended The internal competence of the divisions regulated by Art. 33.1 cannot be changed considering arguments of convenience or inconvenience. Legal security asks for clear requirements for this internal competence (Rule 19.1(b)). Art. 19(4) is a monstrous child in the law of civil procedure (defendant decides on forum). It must, therefore, be interpreted and applied in a restrictive sense . See below.	Agreed: no change

	<p>German division. It points out that at present Article 33(2), second paragraph, might allow the Defendant to request the transfer of the case to the central division but, again, the central division may not be the most convenient forum.</p> <p>The respondent also believes that the Rules should give some guidance as to the factors to be borne in mind when considering such a transfer.</p> <p>Bearing in mind the above comments this respondent suggests the following detailed amendments:</p> <p>“19.4 If the action has been commenced before a regional or local division the defendant may by a Preliminary objection request a transfer of the action to the central division pursuant to Article 33(2) of the Agreement or to a different division pursuant to Rule 338. The Preliminary objection shall in such a case either contain all facts and evidence supporting the existence of the same infringement in three or more regional divisions or contain all facts and evidence in support of the transferee division being clearly more apt than the division chosen by the claimant.”</p> <p>“332.</p> <p>(a) considering whether the interests of the forum, on balance, suggest that another division is better suited to hear the dispute and addressing that transfer issue with the parties and</p>		
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		<p>division concerned;</p> <p>(b) encouraging the parties to co-operate ...”</p> <p>“338. Where the defendant requests, as a preliminary objection, transfer of the action to another division, the judge-rapporteur shall by way of order grant that request where the defendant is able to show that the transferee division is clearly more apt than the division chosen by the plaintiff. In making that assessment regard shall be had to:</p> <p>(a) language issues including translation costs;</p> <p>(b) the convenience of each venue for the parties and witnesses including travel requirements;</p> <p>(c) the economic centre of the dispute; and</p> <p>(d) any hardship suffered by the claimant by the transfer.”</p> <p>A similar comment requiring an amendment to Rule 19.4 in the case of a non-convenient forum is made by 52 – EIP.</p>		
Rule 19.4	89 – BRIS	<p>This respondent also believes that there ought to be a procedure for the transfer of proceedings from an objectively inappropriate division. It believes that the onus should be on the defendant to</p>	<p>No change recommended</p> <p>No basis in Art. 33.</p>	<p>Agreed: no change</p>

		<p>satisfy a judge-rapporteur that the chosen venue is indeed inappropriate and the decision of the judge-rapporteur should be subject to appeal if necessary.</p> <p>This respondent suggests that the so-called “Spiliada factors” which apply in the UK should be used to determine whether or not a forum is convenient. These criteria are as follows:</p> <ol style="list-style-type: none"> 1. The place where the defendant is mainly based (habitually resident), 2. The place where the infringements mainly took place which in the case of goods in the EU should be the place of manufacturer rather than the place of sale, 3. The place where the claimant is mainly based, and 4. The impact of the language regime in the local division concerned. <p>This respondent also believes that an objection should be possible under Rule 19 based solely upon the language of proceedings rather than an application to change the forum. It suggests criteria for determining the appropriateness of the language chosen by the claimant. It ranks the criteria as follows:</p> <ol style="list-style-type: none"> 1. The language of the patent 2. The working language of the defendant 		
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		<p>3. The working language of the claimant</p> <p>4. The ability of the defendant to work in the language chosen by the claimant</p> <p>5. The ability of the claimant to work in the language requested by the defendant</p> <p>6. The language of the documents likely to be an issue in the proceedings</p> <p>7. The language of the witnesses likely to be involved in proceedings</p> <p>It is suggested that these criteria reflect Article 49(5) of the Agreement.</p> <p>It is further suggested that if on language grounds the defendant requests a change of venue then the above criteria should be considered in addition to the criteria referred to above on change of venue.</p>		
Rule 19.4 (Article 33(2))	55 – MAR	<p>This respondent suggests that in Rule 19.4 the preliminary objection must evidence “concrete and substantial instances” of infringement in the three or more regional divisions.</p> <p>This may well be sensible to avoid blatant forum shopping by the defendant, but the addition of these words may not be justified by Article 33(2) of the Agreement.</p>	<p>A small change is recommended</p> <p>Art. 19.4 is an exception to basic rules of procedural law (change of forum by the defendant) and must be interpreted and applied restrictively.</p> <p>The legal history of this Philips-rule shows that the Rule wants to cover extraordinary big and important cases. If the geographical extent of the use is going to be indicative for such a case, the use must be substantial in all three territories.</p> <p>Proposal: In Rule 19.4 second</p>	<p>Agreed: no change</p> <p>It was not considered necessary to amend the Rule. It was noted that the Court should be allowed to decide when a transfer is merited; a body of jurisprudence would then develop.</p>

			sentence insert "substantial" before the word "infringement".	
Rule 19.6	91 – FICPI-I	<p>This respondent points out that the defendant is likely to lose time in the preparation of his defence pending a decision of the judge-rapporteur and therefore suggests the following amendment:</p> <p>“6. The period for lodging the statement of defence [Rule 23] shall be automatically suspended by the lodging of a preliminary objection until the judge-rapporteur decides otherwise.”</p> <p>This means that Rule 23 should then be expressly made subject to this amended Rule 19.6.</p>	<p>No change recommended</p> <p>The Preliminary objection does not need much time for preparation. The relevant writ will not contain more than two pages.</p>	<p>Agreed: no change</p> <p>It was also noted that Rule 19.4 already permits the Judge-Rapporteur to decide otherwise.</p>
Rule 19.7	90 – CSA	<p>It is suggested by this respondent that if the Defendant does not file a preliminary objection he shall also be treated as having accepted the language used in the statement of claim.</p>	<p>I agree with this suggestion</p> <p>The defendant reserves all his rights if he objects to the language. He may try an agreement with the claimant under Art. 49(3).</p>	<p>Agreed: no change</p> <p>It was true that if the Defendant does not file a preliminary objection he would be treated as having accepted the language used in the statement of claim. However, no change was merited.</p>
Rule 20.1	13 – EPLAW	<p>It is suggested that there should be provision for the judge-rapporteur to refer a decision to the panel.</p> <p>Similar comments are made by 31 – LES.</p> <p>I believe this is covered by Rule 102.</p>	<p>No change recommended</p> <p>Already regulated by Rules 102, 239.1. See for a request to refer Rule 102.2 and Rule 333.1</p> <p>However: Change reference to Rule 19.4 to reference to 19.5 (typo)</p>	<p>Agreed: no change</p>
Rule 22	10 –	<p>This respondent expresses concern that the calculation of value-based fees may be</p>	<p>No change recommended</p>	<p>Change agreed</p>

	CMS	<p>complex and result in different divisions taking different approaches, which in turn could lead to forum shopping. It further points out that since litigation before the Court is likely to be pan-European it fears that claims may be valued at a very high level and that this will act as an obstacle to the effective use of the new system.</p> <p>This is a matter for the politicians but see the alternative proposal for calculation of value added fees made by 33 – IP at the end of this paper.</p>	<p>1. Political question</p> <p>2. I don't see the danger indicated. The parties will more often tend to indicate small values to save money.</p>	<p>This was considered further by the Committee on 14 December 2014. A concern was raised that the parties might (as suggested by WT's second point) indicate artificially low values. It was agreed to amend the rule such that the judge-rapporteur should always formally determine the value, taking into account the parties' assessment.</p> <p>The same change would be made to Rules 31, 57, 58 and 69.</p>
Rule 22	14 – EPI	<p>This respondent believes that reduced fees should apply where the parties agree to have only a single judge in accordance with Article 8(7) of the Agreement.</p> <p>An interesting suggestion, but one for the politicians.</p>	<p>No change recommended</p> <p>It is the same work to be done. There should be no incentive to use single judges, because 3 judges see more than one (quality aspect).</p>	<p>Agreed: no change</p>
Rule 23, 39.1, 56, 65, 321.3 and 321.5	29 – ERIC	<p>It is pointed out that all of these rules allow time periods to be extended by the judge-rapporteur on a reasoned request, and yet there is a general provision in Rule 9.3(a) for extensions. To avoid any misunderstanding that time periods in other rules may <u>not</u> be extended there should be a reference to Rule 9.3(a) in all of the cited rules or</p> <p>the specific provisions should be deleted.</p> <p>A similar comment is made by 41 –</p>	<p>Tentatively: no change recommended</p> <p>1. Rule 9.3 is the general Rule.</p> <p>2. The repetition in Rules 23, 39.1, 56, 65, 321.3 and 321.5 is only a reminder for the purposes of information.</p> <p>3. The proposed reference to Rule 9.3 in these Rules is not capable of "avoiding any misunderstanding that time periods in other rules may not be extended".</p>	<p>Change agreed</p> <p>The references to extension of time limits in individual rules should be removed, as all are covered by the general power in Rule 9.3.</p>

		<p>SWED.</p> <p>See also the similar comment by 4 – AIPPI in connection with Rule 9(3).</p>	<p>4. This could be avoided only, if all time-limits-Rules would contain a reference to Rule 9.3.</p>	
Rule 25.1	13 – EPLAW	<p>Two minor drafting suggestions are made.</p> <p>1. First it is suggested that Rule 25.1 should make it clear that the revocation is “against the patent owner(s) in accordance with Rule 43”.</p> <p>2. Further it is suggested that the counterclaim should include the data required by Rule 13.1 in so far as it relates to the owner(s) if they are not claimant(s) in the infringement proceedings.</p> <p>Both of these minor amendments appear to be sensible.</p>	<p>Change recommended</p> <p>I agree with both suggestions.</p> <p>And "(or patents)" in the third line</p>	<p>Change agreed</p> <p>It was agreed to make the recommended changes.</p>
Rule 25.3	4 – AIPPI	<p>This respondent believes that in the case of an action by a licensee this rule is not consistent with the protection offered by the Brussels Regulation. It recommends that before a patentee becomes a party on service of a counterclaim there must be an application to join the patentee which application must be served on the patentee.</p> <p>Similar comments are made by 25 – TEVA who queries whether this rule is in conformity with Article 47(5) of the Agreement. It suggests a slightly different amendment as follows:</p>	<p>Change recommended</p> <p>I agree with AIPPI</p> <p>According to Art. 47(5) sentence 2 of the Agreement the party must bring "actions against the patent proprietor". It does not say so but seems to imply that this is possible before the local or regional division where the infringement-action is pending (a case forgotten in Art. 33(4) sentence 2).</p> <p>Consequences:</p> <p>1. The defendant must hand in a</p>	<p>Change agreed</p> <p>It was agreed that a suitable change should be made, referring to formal service under Rule 271 or stating that Rule 271 applies <i>mutatis mutandis</i>.</p> <p>In line with WT’s recommendation, text should be added to the effect that the proprietor should be treated as a Defendant in all subsequent proceedings.</p>

		<p>“A defendant who wishes to counterclaim for revocation of the patent shall file an application to join a proprietor(s) in the proceedings. The proprietor(s) shall be deemed to become party to the revocation proceedings upon such</p> <p>A similar amendment is suggested by 51 – B&B.</p> <p>A similar comment is made by 110 – CCBE who points out that the application to join additional proprietors or the proprietor (in the case of a licensee action) must proceed any counterclaim otherwise the revocation counterclaim would be ultra vires under Article 47(5) of the Agreement.</p>	<p>Statement for revocation which shall be served upon the patent proprietor according to Rules 270 ff (as an action starting a revocation claim) and which shall have the contents of Rule 25. Only when this service is completed the proprietor will be party to the infringement counterclaim.</p> <p>2. The sending of a copy of the Counterclaim (present text) or of an application to join (TEVA) is not enough</p> <p>Proposal:</p> <p>"... (or patents) the defendant shall direct a revocation action against the proprietor or the other proprietor(s) before the same panel and shall supply.." <i>(Delete the last sentence)</i>. "The Rules on the claimant as defendant of the revocation counterclaim shall apply also to the patent proprietor(s) as defendant(s) of the revocation action"</p>	
Rule 25.3	10 – CMS	This respondent would also like clarification of the procedure to be followed pursuant to Rule 25.3 and some assurance that this rule is in conformity with Article 47(5) of the Agreement .	See above	See above
Rule 25.3	18 – STI	This respondent also believes that this provision may not be in conformity with Article 47(5) and suggests the following	See above	See above

		<p>amended Rule 25.3:</p> <p>“When the claimant is not the proprietor or not the only proprietor of the patent (or patents) concerned the Registry shall as soon as practicable serve a copy of the Counterclaim for revocation on the relevant proprietor(s) in accordance with Rule 13.1€ and shall supply a copy of each document referred to in paragraph 2. This serving of the copy of the Counterclaim for revocation shall be considered as an official act by which the actions are brought against the patent proprietor as indicated in Article 47(5) of the Agreement and consequently the proprietor(s) in question shall become a party (parties) to the revocation proceedings and shall provide details pursuant to Rule 13.1(e) if not already provided by the claimant.”</p>		
Rule 26	10 – CMS	<p>This respondent believes that it is unjust to demand payment of any fee for a counterclaim for invalidity.</p> <p>A similar comment is made by 33 – IP, 77 – AIPPI-F, 99 – IPLA, 104 – ICC, 108 – AAPI, 110 – CCBE.</p> <p>Again a question for the politicians.</p>	<p>No change recommended</p> <p>A revocation counter-claim is an action on its own (it will survive any withdrawal of the infringement claim) and causes the same amount of work as a revocation action. It is just for convenience reasons that it may be raised before the division which deals with the infringement claim and not before the central division.</p> <p>That it is also a defence makes it not different from a revocation action which also has the purpose to defend the defendant against an infringement action</p>	<p>Change agreed</p> <p>The issue of the fees to be paid when bringing a counterclaim for revocation was considered at the meeting of the Committee on 14 December 2013. After discussion, it was agreed that the counterclaimant should pay the value-based fee for the entire value of the counterclaim, rather than just for the excess over the value of the infringement.</p> <p>Rule 31.2 has been amended. An equivalent change has been made to Rule 58.1.</p> <p>However, the Preparatory Committee</p>

			Consequence: The fee system for the infringement action should apply also for the revocation counter claim: Fixed fee, value based fee.	should be aware of the strength of feeling on the issue of fees for counterclaims.
Rule 26	51 – B&B	This respondent believes that the fee for a counterclaim and the fee for commencing a revocation action should be the same.	Yes See above	See above
Rule 27.2	5 – KOS	This respondent points out that in a number of rules a period of time is triggered by the service of a document (e.g. Rule 23). And that the date of “service” is defined in Rule 271.5 but only in the context of service of a Statement of Claim. He suggests a general rule defining service as the starting point of time period. See also the comment of 4 – AIPPI with respect to Rule 9.	Small change is recommended Rule 300 (a) is such a general rule. That rule should, however, be amended in accordance with Rule 131.2 EPO Implementing Regulation: by the following sentence: "In case of a service the relevant event shall be the receipt of the document served." (See comment to Rule 300(a))	Change agreed It was agreed to amend Rule 300(a) in line with WT’s recommendation. However, further consideration should be given to this in the light of Rule 271.6(b).
Rule 27.2	91 – FICPI-I	Consistent with an earlier comment this respondent suggests that 14 days to correct deficiencies is too short and suggests “at least one month”.	No change recommended See above	Agreed: no change
Rule 29.1	91 – FICPI-I	This respondent suggests that, in addition to the proprietor, the claimant should also be entitled to defend the validity of the patent and suggests that the words “claimant and/or” should be added both to Rules 21.1(a) and 229.1(e). This should be considered.	Change recommended The words "claimant" and "proprietor" are used inconsistently in Rule 29. 1. The claimant (even if it is the licensee) may lodge the Defence to the counterclaim. 2. But the Application to amend the claims must come from the proprietor.	Change agreed It was agreed to amend Rule 29.1(e) as recommended by WT.

			<p>3. Rules 29 and 30 help by using the words "claimant and proprietor"</p> <p>Proposal: 1.</p> <p>Always say "claimant".</p> <p>2. And add a sentence to Rule 29.1(e):</p> <p>"Where the claimant is not the proprietor all references to the claimant regarding amendments of claims shall include the proprietor of the patent."</p>	
Rule 30	5 KOS –	<p>This respondent wonders how an application to amend should be dealt with in the case of joint proprietors. Should there be a provision that in the event of joint proprietors there must be agreement by all proprietors on all amendments.</p>	<p>See Rule 25.3 (as amended)</p> <p>The proposed change makes sure that all proprietors are participating and that all Rules on the claimant as defendant of the revocation counterclaim shall apply also to the patent proprietor(s) as defendant(s) of the revocation action.</p>	No further change required
Rule 30	12 GOO –	<p>This respondent believes that in situations where the same patent is involved in different proceedings any attempt to amend the patent in one proceeding should not be isolated.</p> <p>It therefore suggests the following specific amendments to Rule 30:</p> <p>"1A. Where an application is made under Rule 30.1 and there are other existent proceedings involving the patent in suit the request to amend the patent may only be admitted into the proceedings with the permission of the</p>	<p>No change recommended</p> <p>The problem described can arise only between the central division and the local/regional division's panel. In that case there is the special cooperation-procedure of Rule 70.</p>	<p>Change agreed</p> <p>There was a discussion of the need to avoid inconsistencies arising.</p> <p>It was agreed that if a proprietor applies to amend the patent in one set of proceedings, it should also notify the Court involved in any other proceedings involving the same patent.</p>

		<p>Court.</p> <p>2. Any subsequent request to amend the patent may only be admitted into the proceedings with the permission of the Court.</p> <p>3. Permission under Rules 30.1A and 30.2 shall only be granted in circumstances where parties and non-parties will be given sufficient time to consider the new claims being sought, and allowed an opportunity to amend their pleadings.</p> <p>4. Any application to amend the patent, whether under Rule 30.1 or 30.2, applies to all existing Court proceedings involving the patent in suit and accordingly the judge-rapporteur will liaise with the judges handling any other proceedings involving the patent and the parties to those proceedings before deciding whether to grant permission. If permission is granted to admit the amendment into the proceedings, then the proprietor shall immediately make the same application in any other existent proceedings and those requests shall be admitted without requiring further permission from the Court.”</p> <p>A similar comment is made by 59 – QUAL, 99 – IPLA.</p>		
Rule 30.1(a)	2 – PAT	<p>1. This rule, it is commented, introduces a requirement for a translation of amended claims in a European patent with unitary effect into the language of the Defendant’s</p>	<p>Change is recommended</p> <p>1. The last part of Rule 30.1(a) is incomplete, because it does not cover</p>	<p>Change agreed</p> <p>It was agreed to amend Rule 30 based</p>

		<p>domicile if so requested. It is commented that the purpose of this rule is quite incomprehensible. This respondent acknowledges that translation into the language of proceedings may be appropriate but there should be no need for any further translation.</p> <p>2. It also points out that the language rule is not limited to EU languages and therefore a Chinese defendant may require amendments to be provided in Chinese. The rationale for this is not understood.</p> <p>The Regulation on languages may require this but not perhaps in the case of non-EU domiciled patentees.</p>	<p>both alternatives in Art. 4(1) EPatTranslReg (the first alternative incompletely, the second not at all).</p> <p>2. The translation into the domicile-language must be limited to the languages of the CMS.</p> <p>Proposal:</p> <p>"... defendant's domicile in a contracting member state or in the language of the contracting member state where the infringement is said to have occurred or is threatening."</p>	<p>on WT's proposal.</p>
Rule 30.1(a)	9 PHIL –	<p>1. This respondent does not believe that amendments need to be translated into the language of proceedings.</p> <p>2. Further, in the case of a unitary patent, amendments should not be translated into the language of the defendant's domicile. It points out that the unitary patent language Regulation only requires this for the patent itself, not for proposed amendments that may or may not be allowed.</p>	<p>No change recommended (except that recommended above)</p> <p>1. Translation of the amendment into the language of the proceedings in the case of EP: Art. 49 of the Agreement. Necessary for the decision in that language.</p> <p>2. Translation of the amendment for EPUE: Art. 4(1) EPatTranslReg</p>	<p>Agreed: no change</p>
Rule 30.1(a)	29 ERIC –	<p>There is reference in this rule on amendment to both the "claims of the patent concerns and/or specification". This respondent fears that reference to the specification might open up unlimited re-examination of the patent as a whole. Therefore it recommends that this rule should make it clear that this</p>	<p>Change is recommended</p> <p>Rule 30.1(a) allows amendments of the specification. The objections raised against this are justified.</p> <p>1. At least strike "or": No isolated</p>	<p>Agreed: no change</p> <p>It was noted that it might be necessary to amend the specification to limit the effect of the claims. For example, amending a definition (in the specification) could be used to limit the scope of the claims without amending</p>

		<p>specification may only be amended to reflect limitation of the claims in accordance with Article 65 of the Agreement.</p> <p>A similar comment is made by 41 – SWED, 48 – GRUR.</p> <p>This respondent is also concerned by the word “and/or specification” in this rule and suggests its deletion.</p>	<p>amendment of the specification (without amendment of a claim)</p> <p>2. Better even: Delete "amendments of the specification".</p> <p>a) That is dangerous (extension).</p> <p>b) And it is not necessary: The contents of the decision allowing the amendment of the claim(s) will serve as interpretation to understand the unchanged specification in the light of the amendment.</p>	<p>their wording.</p>
Rule 30.1(a)	60 – AIPPI-J	<p>This respondent points to the need possibly to prepare amendment in two languages other than the language of proceedings and queries whether translation into the language of the defendant's domicile is necessary.</p> <p>This provision was inserted to comply with the Translation Regulation for the unitary patent.</p> <p>However respondent 48 – GRUR queries whether Article 4 of the Translation Regulation requires amended claims to be served translated and in any event only requires a translation into the languages of contracting member states but in addition require a translation into the language of the place of infringement.</p>	<p>No change recommended (except the amendment proposed above)</p> <p>1. Art. 4(1) EPatTranslReg asks only for one (not two) translation(s) (the defendant can choose between two alternatives).</p> <p>2. Art. 4(2) EPatTranslReg provides for a version in the language of the proceedings, if the Court asks for that. That would be nothing different from Rule 30.1(a) (for EP).</p> <p>3. Art. 4(1) EPatTranslReg covers amendments.</p> <p>4. For the proposed amendment to Rule 30.1(a) in order to correspond completely with Art. 4(1) EPatTranslReg: See above</p>	<p>Agreed: no change</p>
Rule 30.1(a)	91 –	<p>This respondent points out that the language of the translation required under</p>	<p>Change recommended</p>	<p>See above</p>

	FICPI-I	<p>Regulation 1260/2012 is not necessarily the language of the defendant's domicile. Therefore the final words of this rule should be amended to read as follows:</p> <p>“and where the patent is a European patent with unitary effect, in the language under Regulation (EU) No. 1260/2012 chosen by the defendant if so requested by the defendant.”</p>	See above Rule 30.1(a) – 2-Pat	
Rule 30.1(b)	2 – PAT	<p>It is not understood why the patentee needs to satisfy the requirement of Article 84 (clarity). This, it is suggested, is inappropriate. The only requirement for the patentee should be that there is proper basis for the amended patent claims (Article 123(2) EPC) and that the scope of protection is not being broadened (Article 123(3) EPC). Clarity under Article 84 EPC is a matter for the Defendant (or a claimant in a revocation action) who is contesting ambiguities brought about by amendment to the claims.</p> <p>A similar comment with regard to the requirement of clarity is also made by 48 – GRUR, 90 – CSA.</p>	<p>Change is recommended</p> <p>Proposal:</p> <p>Delete "and 84".</p> <p>Art. 123(2) and (3) EPC (no extension) do not contain the requirement of "clarity" (Art. 84 EPC) of the amendments, and Art. 138(1) EPC does not mention the requirements of Art. 84 EPC, only the requirements of Art. 83 EPC.</p>	Agreed: no change
Rule 30.1(b)	3 – TES	<p>This respondent also raises the issue as to whether amended claims have to fulfil the requirement of clarity. A question, he comments, which has created numerous divergent decisions of the Boards of Appeal of the EPO. He points to Article 65(2) of the Agreement to the effect that a patent can only be revoked on the grounds of Articles 138(1) and 139(2) EPC.</p>	See above	Agreed: no change

Rule 30.1(b)	63 – JIPA	<p>This respondent points out that amendments to the patent may affect the scope of the claim. Therefore the patentee should, in addition to an explanation as to why the proposed amendments are valid, include an explanation as to why the proposed amended claims are also infringed.</p> <p>This seems to be a sensible amendment.</p>	<p>Change is recommended</p> <p>Proposal:</p> <p>Add to Rule 30.1(b) "and infringed".</p>	<p>Change agreed</p> <p>It was agreed to amend Rule 30.1(b) to add “and infringed” as recommended by WT.</p>
Rule 30.1(c)	2 – PAT	<p>It is suggested that to restrict the patentee in the number of amendments that may be made is not acceptable. This respondent believes that the patentee should be able to put “several alternative lines of defence in the form of auxiliary requests”.</p> <p>The rule allows a “reasonable” number of conditional amendments.</p> <p>The respondent 48 – GRUR and makes a similar comment of that above suggests that the requirement in the Rule that the number of amendments “<u>must</u> be reasonable” should be replaced by “<u>should</u> be reasonable”.</p>	<p>No change recommended</p> <ol style="list-style-type: none"> 1. A curb on the number of conditional proposals for amending a claim is necessary and in line with the international development. 2. The chosen wording (<i>reasonable</i>) is the mildest version possible but recommends itself because a given number would not fit all cases. 3. The "must" must stay, because it allows the Court to reject an unreasonable number. 	<p>Agreed: no change</p>
Rule 30.2	2 – PAT	<p>It is suggested that the patentee should be given a further opportunity to amend after closure of interim proceeding when the full case against the patent may be appreciated.</p> <p>The rule allows for permission to further amend.</p>	<p>No change recommended</p> <p>Kevin's comment is correct.</p>	<p>Agreed: no change</p>

Rule 30.2	21 – PUR	<p>This respondent also believes that amendment may be required after the other side’s case is fully known but should not be made so late in the proceedings as to disrupt preparation for trial. They recommend adopting the same approach as set out in Rule 263 (Leave to change a claim or amend a case). They suggest therefore the following to be added to Rule 30.2:</p> <p>“Such permission shall not be granted if the party seeking amendment cannot satisfy the Court that:</p> <p>(a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and</p> <p>(b) the amendment will not be unreasonably hinder the other party in the conduct of the action.”</p> <p>A similar comment is made by 79 – VERTEX</p> <p>A somewhat different suggestion is made by respondent 108 – AAPI who suggests that Rule 30.2 should be redrafted as follows:</p> <p>“Any subsequent request to amend the patent may be refused by the Court if it is considered to be abusive.”</p>	<p>No change recommended</p> <p>1. Changing patent claims and changing party's claims are different things.</p> <p>2. When deliberating on a permission under Rule 30.2 (subsequent request to amend the patent) the Court will have to consider many aspects, among them</p> <p>a) the state of art appearing in the proceedings</p> <p>b) the course of discussion</p> <p>c) the consequences for the patent</p> <p>and only then</p> <p>d) whether the patent proprietor could have reacted earlier.</p> <p>Generally a foreclosure is more relevant for the defendant raising the counterclaim.</p> <p>No change recommended</p>	<p>Agreed: no change</p>
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			The present wording is more flexible.	
Rule 30.2	3 – TES	<p>This respondent believes that a patentee should be in a position at any time to delete claims without formal consent from the Court and therefore he suggests adding the following sentence to Rule 30.2:</p> <p>“The permission of the Court is not required for the mere deletion of independent or dependent claims”.</p>	<p>Change is recommended</p> <p>1. A deletion of claims under attack by the defendant should be possible without the consent from the Court (German practice, <i>Busse PatG § 82 Footnotes 251, 252</i>)</p> <p>2. A deletion of claims not under attack should be declared to the EPO (Art. 105a EPC) with the consequence of a publication (Art. 105c EPC)</p> <p>Proposal:</p> <p>“The permission of the Court is not required for the mere deletion of independent or dependent claims” the revocation of which is requested (Rule 25,1(a))”</p>	<p>Agreed: no change</p> <p>This proposal was rejected, as in some cases the deletion of claims may affect the interpretation of the remaining claims further up the hierarchy.</p>
Rule 31	4 – AIPPI	<p>This respondent believes that the value of the dispute should not reflect the value of the patent erga omnes. Otherwise, it is pointed out, a small defendant may be in a position of having to pay a significantly larger fee based on the value of the patent for all third parties. If the value is limited to the actual dispute then that value will normal not differ from the value of the infringement issue.</p> <p>A similar comment is made by 41 – SWED, 105 – AICIPI.</p> <p>A similar comment is made by 14 – EPI which suggests that a party</p>	<p>No change recommended</p> <p>1, The revocation destroys the patent erga omnes. Therefore, the value of a revocation action, in Germany, is decided according to the “general value” of the patent (BGH GRUR 2007, 175/176 summing up the court's longstanding practice). As a minimum the value must cover the interest of the defendant to escape a damage claim.</p> <p>2. This reasonable practice should guide also the UPC in determining the values for the revocation counterclaim</p>	<p>Agreed: no change</p>

		<p>counterclaiming or filing a revocation action should only pay a fixed fee. It does not believe a value-based fee is appropriate since the value of the patent may have nothing to do with the value of the issue between the particular parties.</p>	<p>and the revocation action (both cannot be treated differently).</p> <p>3. But the Rules should be silent on this question in order to leave the Court room for developing a sensible practice.</p> <p>Note: If only the interest of the claimant of a revocation action would be relevant, the defendant could easily use a small entity or even an individual person to raise a revocation action (which can be raised by anybody).</p>	
Rule 31	31 – LES	<p>This respondent does not believe that a defendant who challenges validity should have to pay a value added fee for the counterclaim. Such a counterclaim may be the only realistic manner in which a party can defend itself.</p> <p>A similar comment is made by 50 – ORD.</p>	<p>No change recommended</p> <p>See above my comments regarding Rule 26 (10 CMS)</p>	Agreed: no change
Rule 32	2 – PAT	<p>It is commented that this rule requires the Defendant to respond to amendments within one month, and that this is usually not practicable particularly if the amendment is more than merely a combination of existing claims. It is suggested that the time limit must therefore at least be capable of extension.</p> <p>A similar comment is made by 48 – GRUR, 105 – AICIPI.</p> <p>Rule 9 allows an extension of time if</p>	<p>Change recommended</p> <p>I think 2 months should be the general rule (extension possible) here. The amended claim often necessitates another research</p>	<p>Change agreed</p> <p>It was agreed to make 2 months the basic position.</p>

		justified.		
Rule 32.3 and Rule 67.1	14 EPI	– These rules do not provide details of the initiation of the one month period within which the Reply or Rejoinder must be filed. This is a helpful comment.	No change recommended This is adequately taken care of by Rule 300.1 (a) (amended according to my Proposal, see my comments to Rule 27.2: 5 KOS). See there.	Agreed: no change
Rule 33 and 34	10 CMS	– This respondent believes that wherever possible a technical judge should be of a different nationality to the local judges. Consistent with its other comments, it believes that such a provision would be more conducive to harmonisation.	No change recommended See my comments to Rule 18: 30 CIPA	Agreed: no change
Rule 37	7 INTEL	– This respondent comments that Rule 37 provides little guidance as to how the Court should exercise its discretion to bifurcate . This is vitally important because, according to this respondent, bifurcation gives rise to the possibility of the patent being held to be infringed before the Court has had an opportunity to consider validity. This respondent does not believe that injunction should be granted before validity has been tested but in any event if the Rules do permit this it recommends that guidance must be given to ensure that the Court considers the consequences of the potential injunction on the market. With these comments in mind the respondent proposes the following amended Rule 37 (with amendments in bold): “1. As soon as practicable after the closure	No change recommended 1. Art. 33(3) deliberately leaves the choice between the three alternatives to the "discretion" (German text "own discretion" , <i>eigenes Ermessen</i>) of the division (panel) in order to start a practice test which, at a later point of time, may lead to Rules (Art. 41(2) para. 2) which harmonise practices in order to arrive at the best practice found out by this practice test. 2. Rule 37.4 already limits the discretion in obliging the panel to stay where it makes use of alternative b) of Art. 33(3). It must stay , where there is a high likelihood that the patent will be revoked. The RoP cannot limit the discretion further. - By the way: In case of "high likelihood" the panel will often use alternative a).	Change agreed The strength of feeling of a number of the commentators was acknowledged and there was an extensive discussion of procedure under Article 33(3). It was noted that the Court had two discretions under Article 33(3): • Whether to bifurcate proceedings; and • If it was decided to bifurcate, whether to stay the infringement proceedings. It was agreed that the Rules should not fetter the Court's exercise of its general discretion to bifurcate. However, Rule 37.4 in respect of the discretion to stay represents a compromise that was agreed by the

	<p>of the written procedure the panel shall decide by way of order how to proceed with respect to the application of Article 33(3) of the Agreement. The parties shall be given an opportunity to be heard. In making its decision, the panel shall presume, unless the parties have agreed otherwise, that revocation and infringement procedures should be heard by the same division. Further, in considering any submission to the contrary, the panel should consider the following factors, among others:</p> <p>(a) whether referring the counterclaim for revocation for decision to the central divisions is likely to result in a mis-match between the timing of hearings and determinations in the infringement and revocation proceedings;</p> <p>(b) whether referring the counterclaim for revocation to the central division will involve duplicative consideration of evidence or issues, or other unnecessary or increased costs;</p> <p>(c) whether amendments are sought (in which case infringement and validity should normally be considered together);</p> <p>(d) whether the patent is technically complex, such that the presence of a technical judge on the panel would be beneficial in relation to both infringement and validity issues and the issues should therefore be heard</p>	<p>3. It is to be expected that the divisions in Germany will to a large extent use alternative a) of Art. 33(3).</p>	<p>Committee and should be maintained.</p> <p>It was noted that a reasoned decision to bifurcate and to stay or not stay (as the case may be) might encourage procedural appeals. However, after discussion, it was agreed that short reasons should be given for such decisions.</p>
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	<p>together; and</p> <p>(e) whether the parties agree or the referring court decides to stay infringement proceedings pending revocation proceedings.</p> <p>4. In order to avoid inconsistent decisions, in exercising its discretion under Article 33(3)(b) of the Agreement, the panel should presume, absent specific circumstances and unless the parties have agreed otherwise, that revocation issues should be decided at the same time as or in advance of infringement issues. Further, in the event that revocation issues may otherwise be decided before infringement issues, the panel should stay the infringement proceedings pending a final decision in the revocation procedure. Further still, the panel shall stay the infringement proceedings where there is a reasonable likelihood 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.”</p> <p>Similar comments made by 21 – PUR.</p> <p>A similar comment is made by 30 – CIPA which points out that assistance with the decision when to bifurcate would assist all judges. It will assist judges who are not familiar with bifurcation but it will also assist judges in Germany, Austria and Hungary who at the moment are <u>required</u> constitutionally to bifurcate and have</p>		
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		<p>no experience of exercising discretion on this issue. It suggests that the most important factors are: whether the parties are in agreement as to what the Court should do; the value of the case; whether there is a serious question over the construction put forward by the patentee and questioned by the defendant and the strength or otherwise of the invalidity case.</p>		
Rule 37	12 – GOO	<p>This respondent also believes that the Rules should make it clear that there is a presumption that validity and infringement cases will be heard in the same court and a presumption that, if bifurcation occurs, validity issues will be decided prior to infringement issues except in exceptional circumstances or with the consent of the parties. It is suggested that such presumptions will assist the Court in the general exercise of its discretion under Article 33 of the Agreement and these Rules.</p> <p>In addition this respondent suggests that the Court should take into account specific factors in deciding whether or not to bifurcate and that Rule 37.1 should be amended as follows:</p> <p>“1. As soon as practicable after the closure of the written procedure the panel shall decide by way of order how to proceed with respect to the application of Article 33(3) of the Agreement. The parties shall be given an opportunity to be heard. Further, in making its decision, the panel shall consider the following</p>	<p>No change recommended</p> <p>See above</p>	<p>See above</p>

	<p>factors, among others:</p> <p>(a) whether referring the counterclaim for revocation for decision to the central division is likely to result in a mis-match between the timing of hearings and determinations in the infringement and revocation proceedings;</p> <p>(b) whether amendments of the patent claims are sought;</p> <p>(c) whether the patent is technically complex;</p> <p>(d) whether the parties agree or the referring court decides to stay infringement proceedings pending revocation proceedings; and</p> <p>(e) whether this case raises novel points of law.”</p> <p>This respondent also suggests that Rule 37.4 should be amended as follows:</p> <p>“4. In exercising its discretion under Article 33(3) of the Agreement, the panel should presume, in order to avoid inconsistent decisions, unless the parties have agreed otherwise, that:</p> <p>(a) revocation and infringement procedures should be heard by the same division, and revocation issues should be decided at the same time as or in advance of infringement issues;</p>		
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	<p>and</p> <p>(b) where the panel decides to proceed in accordance with Article 33(3)(b) of the Agreement, the panel may stay the infringement proceedings pending a final decision in the revocation procedure, and shall stay the infringement proceedings where there is a reasonable likelihood 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.”</p> <p>A similar comment suggest the presumption in 4(a) above is made by 74 – MICRO, 83 – COAL.</p> <p>Finally this respondent suggests a new Rule 37.5 as follows:</p> <p>“5. Where an application to amend the patent is made and the panel has decided to proceed in accordance with Article 33(3)(b) of the Agreement, infringement proceedings shall be stayed unless:</p> <p>(a) such an amendment is unconditionally applied for; and</p> <p>(b) after the parties are given an opportunity to address the validity of the amended claims, the court determines that there is a high likelihood that the patent as unconditionally amended will be held to be valid by final decision in the revocation proceedings.”</p>		
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Rule 37	33 – IP	<p>This respondent also considers that the judges should have guidance as to how to exercise their discretion with regard to bifurcation and suggests at least the following factors:</p> <p>“(a) whether referring the counterclaim for revocation for decision to the central division is likely to result in an undesirable mismatch between the timing of hearings and determinations in the infringement and revocation proceedings;</p> <p>(b) whether referring the counterclaim for revocation to the central division will involve duplicative consideration of evidence or issues, or other unnecessary or increased costs;</p> <p>(c) whether amendments to the patent are likely to be sought (in which case infringement and validity should normally be considered together);</p> <p>(d) whether the patent is technically complex, such that the presence of a technical judge on the panel would be beneficial in relation to both infringement and validity issues and the issues should therefore be heard together;</p> <p>(e) whether it appears to the Court that the Defendant has pleaded that there is a “squeeze” between validity and infringement;</p> <p>(f) whether hearing infringement and validity separately would cause the two</p>	<p>No change recommended</p> <p>See above</p>	<p>See above</p>
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		<p>parts of the case to be heard in different languages;</p> <p>(g) whether the parties have agreed their preferred approach as to how the case should be managed under Article 33(3)."</p> <p>A similar comment is made by 82 – HAS</p>		
Rule 37	89 – BRIS	<p>This respondent also wishes to lay down detailed criteria to assist the Court in the exercise of its discretion whether to bifurcate. It recommends the following:</p> <p>“1. Whether the defendant consents to bifurcation,</p> <p>2. Whether a technical judge is required for the purposes of the infringement claim according to Rule 33,</p> <p>3. Whether bifurcation would give rise to the possibility of the case proceeding in different languages,</p> <p>4. Whether bifurcating would be likely to give rise to a delay between the division on infringement and the decision on revocation,</p> <p>5. Whether dealing with both infringement and validity together would jeopardise the hearing date in the local or regional division,</p> <p>6. Whether the hearing of both infringement and validity can be accommodated by the local or regional</p>	<p>No change recommended</p> <p>All this and more is subject of the discretion of the Court which the RoP cannot limit.</p>	<p>See above</p>

		<p>division in no more than one day,</p> <p>7. Whether there is any interaction between the case on infringement and the case on validity,</p> <p>8. Whether the claimant in the infringement claim is in the position to provide security in accordance with Rule 452 pending resolution of the revocation counterclaim,</p> <p>9. Whether the defendant would be likely to suffer irreparable harm in the event that orders were made pending resolution of a revocation counterclaim,</p> <p>10. Whether there is a high likelihood or a low likelihood that the relevant claims of the patent would be held invalid,</p> <p>11. The likely impact of bifurcation on the cost of proceedings and the use of the Court's resources.”</p>		
Rule 37.4	86 – MAX	<p>This respondent also believes that the exercise of the option to bifurcate should be assisted by purpose-bound criteria and it suggests a set of both procedural and economic criteria. The procedural criteria are as follows:</p> <p>“1. That, even taking into account the possibility to request a technically qualified judge from the pool of judges, the broader technical expertise still lies with the central division,</p> <p>2. That the validity of the patent depends</p>	<p>No change recommended</p> <p>All this and more is subject of the discretion of the Court which the RoP cannot limit.</p>	<p>Agreed: no change</p> <p>It was agreed that no change should be made to Rule 37.4 dealing with the exercise of the discretion on whether to stay infringement proceedings.</p>

	<p>on an unsettled question of law and it does not seem appropriate to wait for a decision of the Court of Appeal,</p> <p>3. That the validity of the patent is not determinative of the outcome of the infringement action,</p> <p>4. That the technical complexity of the case is sufficiently intelligible for the local panel so that there is no risk that the technically qualified judge will dominate the panel,</p> <p>5. That prior art documents invoked by the defendant are decisive for assessing infringement and the interpretation of the claim and thus need to be considered by the local panel anyway,</p> <p>6. That an objection based on the free state of the art is made alongside a counterclaim and such objection is not prima facie unfounded,</p> <p>7. The potential delaying effect of the referral is serious for one or both parties interests.”</p> <p>The economic criteria quoted are as follows:</p> <p>“1. The interests of the patentee in not prematurely losing its dominant market position,</p> <p>2. Conversely the interests of the infringer in not being unduly impaired from</p>		
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		<p>exercising its right to compete,</p> <p>3. The availability of preliminary measures to sufficiently protect the patentee,</p> <p>4. The availability of sufficient pecuniary measures should the patent finally be declared invalid.”</p> <p>This respondent also suggests that the above criteria might also be relevant in determining whether to stay proceedings in the event that a decision is taken to bifurcate.</p>		
Rule 37.4	4 – AIPPI	<p>This respondent wishes to replace the “high likelihood” test with a “reasonable likelihood” test and would propose to add at the end of this rule the following sentence:</p> <p>“In this context reasonable likelihood means that the legal challenge against the validity of the patent must be more likely than not to succeed; a predominant likelihood that the patent will be revoked is not required”.</p> <p>It is further suggested that where a local division decides to proceed in accordance with Article 33(3)(b) the panel should give reasons for so acting.</p> <p>Similar comments are made by 10 – CMS, 34 – BLACK, 39 – FUR, 42 – ADIPA, 49 – GSMA, 64 – FIN, 66 – BIA, 75 – FINNCHAM, 80 – CFI, 84 – BGMA, 87 – CDI, 90 – CSA, 93 – FFW, 99 –</p>	<p>No change recommended</p> <p>See above</p>	See above

		IPLA.		
Rule 37.4	10 CMS	– This respondent suggests the replacement of the “high likelihood” test with “clear possibility” test.	No change recommended See above	See above
Rule 37.4	53 ARM	– This respondent suggests merely a “possibility” rather than “high likelihood” . It also proposes a similar change to Rule 118.	No change recommended See above	See above
Rule 37.4	15 M&S	– This respondent believes that the “high likelihood” test lacks clarity and is likely to be interpreted in different ways by different courts. It also believes that since a granted patent is generally considered to be prima facie valid the barrier is likely to be too high to be met on most occasions.	No change recommended See above	See above
Rule 37.4	29 ERIC	– This respondent expresses its support for the “high likelihood” test. A similar comment is made by 41 – SWED, 59 – QUAL who believes that the current provisions of Rule 37.4 strike the right balance between interests of legitimate patent holders and the interests of defendants. The committee is urged to maintain this language unchanged. A similar comment is made by this respondent with regard to Rule 118.3. A similar comment is made by 48 – GRUR who also believes that the Rule as drafted is well balanced and flexible and in particular it welcomes the fact that the draft refrains from laying down requirements for the exercise of	Supports present wording	See above

		discretion re bifurcation.		
Rule 37.4	16 – CSO	This respondent believes that the requirement that the panel “shall stay” infringement proceeding if the high likelihood test is met is a restriction on judicial discretion and contrary to Article 33(3)(b) of the Agreement which does not impose any restriction on judicial discretion. This respondent also doubts whether the high likelihood test is objective enough and wonders why the counterclaim would be referred in such a situation if the high likelihood test is met since it is equivalent to saying that invalidity is “acte claire”. This respondent would delete the second part of Rule 37.4 leaving the pure discretion.	No change recommended See above	See above
Rule 37.4	56 – INT	This respondent suggests a “ real possibility ” test, with a corresponding amendment in Rule 118.	No change recommended See above	See above
Rule 37.4	60 – AIPPI-J	This respondent believes it is <u>not</u> sufficiently clear what degree of likelihood is meant by “ high likelihood ”. This should be made clearer .	No change recommended See above	See above
Rule 38	4 – AIPPI	This respondent is concerned at the possibility of an “injunction gap” in bifurcated actions. It refers to the 14 th draft of the Rules which included a Rule 40(b) requiring the central division to accelerate bifurcated revocation claims and requests that this rule should be reinstated. A similar comment is made by 34 – BLACK, 58 – GSK, 64 – FIN, 66 – BIA, 88	No change recommended 1. Accelerate bifurcated revocation claims: Rule 9.3 and Rule 334 (a) allow a shortening of time-limits.	Agreed: no change It was agreed that it would not be practical to provide for automatic acceleration.

		<p>- RR, 94 – SR, 110 – CCBE.</p> <p>This particular rule was deleted from the 14th draft since it was felt that automatic acceleration would create procedural chaos within the central division. There is provision for acceleration in appropriate cases.</p> <p>The respondent also recommends that Rule 38(d) is modified by adding the following words at the end of the rule:</p> <p>“...which shall be at the same time as the oral hearing of the infringement action or as nearly so as is practically possible (ideally no longer than three months)”.</p> <p>A similar comment is made by 33 – IP, 110 – CCBE.</p> <p>Is this practicable?</p>	<p>2. Same or near date of oral hearing: Not practicable</p>	
Rule 38(c)	12 – GOO	<p>This respondent suggests a new Rule 38(c) as follows:</p> <p>“(c) dates already set under Rule 28 shall be confirmed wherever possible; and where that is not possible, the judge-rapporteur shall seek to set a date for the interim conference and oral hearing which is in advance of the date for the interim conference and oral hearing set in the local or regional division dealing with infringement.”</p>	<p>No change recommended</p> <p>The JR must consider speeding up proceedings but only as far as practicable.</p>	<p>Agreed: no change</p>

		A similar comment is made by 86 – MAX		
Rule 38(d)	7 – INTEL	<p>Consistent with its comments in connection with Rule 37 this respondent proposes an amended Rule 38(d) as follows:</p> <p>“Dates already set under Rule 28 shall be confirmed wherever possible; and where that is not possible, the judge-rapporteur shall after consulting the parties seek to set a date and time for the interim conference and oral hearing which is in advance of the date for the interim conference and oral hearing set in the local or regional division dealing with infringement.”</p> <p>A similar comment and suggested amendment is made by 83 – COAL.</p> <p>A similar comment and suggested amendment is made by 99 – IPLA.</p>	<p>No change recommended</p> <p>See above</p>	Agreed: no change
Rule 39	2 – PAT	<p>It is suggested that the period of 21 days is too short for filing a translation of a counterclaim with other pleadings and documents. The period should be at least a month. Consistent with an earlier comment by this respondent it does not believe that time period should be specified in “days” which it believes introduces an additional complication.</p> <p>A similar comment is made by 48 – GRUR. A similar comment is made by 81 – JD who suggests that the minimum period should be two months for</p>	<p>Change recommended</p> <p>The regular time-limit should be 1 month. The whole file must be translated.</p> <p>If 1 month is not sufficient the JR may extend this time-limit. Rule 9.3 and Rule 334 (a) allow for an extension of time-limits.</p>	<p>Change agreed</p> <p>It was agreed to make the time limit 1 month as recommended.</p>

		translations.		
Rule 39.1	91 – FICPI-I	This respondent believes that a period of 21 days for translations is far too short and suggest at least two months.	Change recommended See above Rule 39 – 2-Pat.	See above
Rule 43	5 – KOS	This respondent suggests that there should be clarification that the revocation action is directed against the <u>registered proprietors</u> who may be different from the actual proprietors. This appears to be sensible.	Change recommended But better say that in a general clause . Proposal: Add a new para. 3 to Rule 8: "3. For the purpose of all proceedings in relation to a patent proprietor or patent proprietors the person(s) registered in the Register of the EPO shall be considered as patent proprietor(s)"	Change agreed It was agreed that a clarification should be made.
Rule 44	13 – EPLAW	It is pointed out that Rule 44.3 does not provide for a Reply and Rejoinder with regard to an application to amend the patent in a revocation action whereas these pleadings are provided for if the application to amend is made in an infringement action under Rule 12.4. This suggestion appears to be correct.	Change recommended Proposal: Provide for a Reply and Rejoinder with regard to an application to amend the patent in a revocation action Also: Correct Rule 44.3: claimant (instead of defendant)	Change agreed This had been amended in the revised draft circulated to the Committee.
Rule 45.1, 62.1 and 88.1	3 – TES	This respondent refers to these rules and the requirement that proceedings are to be lodged "at the Registry in accordance with Article 7(2) of the Agreement and Annex II thereto". He questions whether it is intended that there be sub-registries in	No change recommended Rule 3: Registry means also subregistry	Agreed: no change It was noted that there is one central Registry.

		<p>the sections of the central division in Munich and London. If this is the case he feels that this should be made clear.</p>	<p>Note:</p> <p>There should be a subregistry at all three locations of the central division. See my comment 2 on Rule 17.2: 3 TES regarding the presiding judge of two of the three locations (London, Munich)</p>	
Rule 48	8 – BUND	<p>This respondent suggest that the Registrar should notify the EPO of the revocation action.</p> <p>This seems to be sensible.</p>	<p>No change recommended</p> <p>1. That would mean a constant information flow to the EPO regarding revocation cases and revocation counter-claims including their end by settlement or withdrawal. The EPO cannot register a "possibility of revocation".</p> <p>2. Persons interested in the actual situation should look into the Register of the Court where they will see all such actions</p> <p>3. See Art. 65(5): Revocation decisions shall be sent to the EPO.</p>	<p>Change agreed</p> <p>It was agreed that the Registrar should notify the EPO of the revocation action.</p>
Rule 51	2 – PAT	<p>The time limit of one month is too short for a Reply to Defence to revocation.</p> <p>A similar comment is made by 48 – GRUR.</p>	<p>No change recommended</p> <p>The RoP should stick to the 1 month rules in Rules 51 and 52. The time-limits may be extended (Rules 9.3 and 334(a))</p>	<p>Change agreed</p> <p>At the meeting on 14 December 2014, it was agreed to extend this deadline to 2 months (as for Rule 32.1).</p>
Rule 60	10 – CMS	<p>This respondent believes that a licensee should not be entitled to give an acknowledgement of non-infringement.</p>	<p>No change recommended</p> <p>1. If the licensee (entitled to sue)</p>	<p>Agreed: no change</p>

		<p>Such acknowledgement should only be given by the proprietor and, similarly, the resulting action for a declaration of non-infringement should only be directed against the patent proprietor.</p> <p>A similar comment is made by 56 – INT, 110 – CCBE.</p> <p>This suggestion may place licensees with authority to sue in a difficult position.</p>	<p>acknowledges non-infringement, this does not bind the patent proprietor; he may still sue the person.</p> <p>2. If the licensee does not acknowledge or does not answer, this does not give rise to a right to start a declaratory action against the patent proprietor</p>	
Rule 62	16 – CSO	<p>This respondent suggests that a claimant for a declaration of non-infringement should also provide with the Statement for a declaration evidence that Rule 60 has been complied with.</p> <p>A similar comment is made by 40 – TAL who further comments that unless this is done the requirements of Rule 60.1(a) and (b) are meaningless as there is no other sanction for a failure to comply with.</p> <p>This seems a sensible suggestion.</p>	<p>Change recommended</p> <p>Rule 60 requires a certain behaviour of the patent proprietor or licensee</p> <p>Proposal: Add to Rule 62.1(a): "and details regarding the requirements of Rule 60."</p>	<p>Change agreed</p> <p>It was agreed that Rule 62 should be amended to require a statement confirming that the requirements of Rule 60 have been complied with.</p>
Rule 70.3	4 – AIPPI	<p>This respondent is against mandatory stay; a stay should always be discretionary unless explicitly required by the Agreement e.g. Article 33(6).</p> <p>Specifically, this respondent does not agree with a stay pursuant to Rule 70.3.</p> <p>Similar comments made by 10 – CMS, 82 – HAS.</p>	<p>No change recommended</p> <p>The Rule concerns the situation "revocation action and subsequent infringement action" and provides that the President CFI requires the panel of the central division to stay its proceedings and to await the decision of the infringement-panel how to proceed with a revocation counter-</p>	<p>See below</p>

		<p>The Committee considered this carefully and considered that a stay was necessary to avoid potentially three months of duplicate proceedings as between the central division and the infringement division.</p>	<p>claim.</p> <p>I agree with Kevin's comment: It should be a mandatory stay.</p> <p>But see recommended changes below regarding Rule 70.3 and 4.</p>	
Rule 70.3	9 – PHIL	<p>This respondent is also against a mandatory stay pursuant to this rule. It points out that there is no such provision in the Agreement and that under the European Convention on Human Rights and the TRIPs Agreement the parties in a revocation procedure are entitled to a hearing without unnecessary delay. It points out that the mandatory stay can be abused and that the only sufficient reason to stay a revocation action is if a counterclaim for revocation in the infringement action is filed.</p> <p>A similar comment is made by 14 – EPI, 19 – IPO, 27 – DIG, 31 – LES, 30 – CIPA, 33 – IP (who believe that the mandatory stay is arguably ultra vires since there is no basis for it in Article 33(5), in contrast to Article 33(6)). A similar comment is made by 34 – BLACK, 35 – P&G, 40 – TAL, 84 – BGMA, 110 – CCBE.</p> <p>A similar comment is made by 99 – IPLA who suggests that an amended Rule 70.3 (and 70.4) would read as follows:</p> <p>“3. Unless otherwise agreed by the</p>	<p>No change recommended</p> <p>I agree with Kevin's comment.</p> <p>But see recommended changes below regarding Rule 70.3 and 4.</p>	See below

		<p>parties, where the claimant who has lodged a statement for revocation lodges a counterclaim for revocation in the infringement action referred to in Rule 70.1, the president of the Court of First Instance shall require the panel appointed in the central division to hear the revocation action pursuant to Rule 48.2 to stay all further proceedings the revocation action pending a decision of the panel hearing the action for infringement pursuant to Article 33(3) of the Agreement and Rule 37.”</p> <p>Again, we have discussed this in Committee and decided that a stay is the more preferable way to proceed.</p>	<p>No change recommended</p> <p>The present solution leaves the matter with the Judges – and not the President CFI who has an administrative function.</p>	
Rule 70.3	27 – DIG	<p>This respondent is also against a mandatory stay.</p> <p>Alternatively, if there is to be a stay it should only come into effect if all claimants in the subsequent infringement action file a counterclaim for revocation in the relevant local or regional division.</p> <p>This respondent also points to the possibility that the claimants in the revocation action may not be identical to the defendants in the subsequent infringement action. If this situation arises there should be provision for all validity proceedings to be consolidated in the central division.</p> <p>Similar comments are made by 29 –</p>	<p>Change recommended</p> <ol style="list-style-type: none"> 1. Rule 70(3) assumes that the claimant of the revocation action (central division): (1) will be a defendant in an infringement action at a local or regional division and (2) raises a revocation counterclaim there. 2. Requirement (1) is regulated in Rule 70.1. 3. Requirement (2) is a possibility only (see Rule 70.2 at the end: "any counterclaim" and beginning of Rule 60.4). <p>Proposal:</p>	<p>Change agreed</p> <p>The Committee considered further what should happen in the situation where a revocation action had been brought in the Central Division and a subsequent infringement action is brought in the local or regional division.</p> <p>After discussion, it was agreed that:</p> <ul style="list-style-type: none"> • There should <u>not</u> be a mandatory stay on starting infringement proceedings; • <u>But</u> if/when a counterclaim for revocation is brought by the Defendant, there will be a stay.

		<p>ERIC.</p> <p>This is certainly worth consideration as the patentee may tactically deliberately add further defendants to the infringement action.</p>	<p>Rule 70.3 should begin as follows: "Where such a counterclaim is raised by the claimant of the revocation action and unless ..."</p> <p>4. Where the defendant in the infringement action is not identical with the claimant in the revocation action, Rule 70 does not apply (see Rule 70.1). The central division continues The local or regional division decides on Art. 33.3 (Rule 37).</p>	<p>This gives some protection to the Defendant who initiated the counterclaim for revocation.</p> <p>It was agreed that this revised provision would only apply where there is identity of the parties in the two proceedings.</p>
Rule 70.3	6 – KAS	<p>This respondent also believes that a mandatory stay is not justified by Article 33(5) of the Agreement.</p> <p>It suggests that Rule 70.3 should be amended so that, subject to the agreement of the parties to the contrary, the President of the Court of First Instance shall have a duty to expedite the revocation action at the central division so that validity is determined as soon as possible.</p> <p>This respondent does not deal with whether the defendant in the infringement proceeding also has the right to counterclaim for invalidity and if so whether such counterclaim should be stayed to avoid duplication and wasted costs.</p>	<p>No change recommended</p> <p>The present text has the advantage of flexibility and of protecting the parties and the Court against having two identical cases.</p> <p>But see recommended changes below regarding Rule 70.4.</p>	<p>Agreed: no change</p>
Rule 70.4	13 – EPLAW	<p>The comment is made that the period for a claimant in a revocation action subsequently to "repeat" his claim via a counterclaim in an infringement action before a local division is too long. It would be preferable if Rule 70.4 obliged</p>	<p>Change recommended</p> <p>1. Under Rules 23 and 25 the defendant must raise the revocation</p>	<p>Agreed: no change</p> <p>WT's proposals were discussed further at the meeting on 14 December 2013. The Committee considered that it might cause procedural confusion if the time</p>

		<p>the Defendant in the infringement action to file his counterclaim within, say, one month after service of the Statement of Claim. This would then allow the stay of the revocation action to be lifted earlier if no such counterclaim is in fact filed.</p> <p>A similar comment and suggestion is made by 51 – B&B.</p> <p>This is a useful suggestion which may avoid undue delay. But what if the parties are not the same?</p>	<p>counter-claim within three months.</p> <p>2. Given the fact that he has already raised a revocation-action, it will not be difficult for him the raise the counter-claim earlier.</p> <p>3. Two months seems reasonable. If he has not met this time-limit, the central division should go ahead with the revocation case.</p> <p>Proposal (including 34 BLACK below):</p> <p>Insert in Rule 70.4 after "Rule 70.1": within two months after the service of the Statement of Claim or expressly waives such right ...</p> <p>Kevin: If the defendants are not the same as the claimant(s) of the revocation action Rule 70 does not apply (see Rule 70.1).</p>	<p>limits for the counterclaim and the defence are different.</p>
Rule 70.4	34 – BLACK	<p>An alternative suggestion is made by this respondent in the following suggested amendment to Rule 70.4:</p> <p>“Where the claimant, who has lodged a Statement for revocation, does not lodge, or otherwise waives the right to file a Counterclaim for revocation in the infringement action referred in Rule 70.1, the judge-rapporteur in the infringement action shall, as soon as practicable and no later than five working days after receiving the written submission of the claimant that he waives his right to file a counterclaim for revocation, notify the President of</p>	<p>See my Proposal above: Waiving is included</p> <p>No need to specify asap for the JR's information to the President CFI.</p>	<p>See above</p>

		<p>the Court of the First Instance and the stay referred to in Rule 70.3 shall be immediately lifted.”</p> <p>A similar comment and drafting suggestion is made by 49 – GSMA.</p>		
Rule 80.1(c)	110 – CCBE	<p>This respondent suggests the deletion of the reference to “the licence agreement”. At this stage there will be no licence agreement and it suggests the following wording:</p> <p>“all written communications evidence in attempts to reach an agreement.”</p>	<p>No change recommended</p> <p>Misunderstanding. The action based on Art. 31(1) (h) is for the compensation for licenses on the basis of Art. 8 EPUE-Reg.</p>	Agreed: no change
Rules 85 to 96	30 – CIPA	<p>This respondent points out that particular timing difficulties are likely to arise where an appeal from the decision of the EPO is an appeal arising from the refusal of the EPO to grant unitary effect.</p> <p>It points out that recital 80 of the Regulation states that a request for unitary effect must be filed within one month of grant. If the EPO refuses such request then the current rules on appeal are likely to result in considerable delay.</p> <p>This may inevitably mean that the patentee will be forced to seek to validate the patent in participating member states, but again there are specific time limits imposed by each state for validation, so that if the appeal is refused the opportunity for validation in some states may have been lost. Although Rule 86 states that an action against the decision of the office shall have suspensive effect, it is unlikely that this would suspend specific time</p>	<p>Change recommended</p> <p>1. If the EPO refuses an application for unitary effect, the appeal has suspensive effect (Rule 86) meaning that the EPO can still register the application under Rule 91 (rectification) or be ordered by the Court (a Rule on its decision is missing, Rule 118 does not cover that) to do so. = Positive outcome, no problem</p> <p>2. If the EPO does not rectify and the Courts rejects the appeal, the applicant may appeal to the CoA which can order the EPO to register = Positive outcome, no problem.</p> <p>3. If the applicant does not appeal to the CoA or if the CoA rejects the appeal, the EP does not get a unitary effect = Negative outcome, problem</p>	<p>Change agreed</p> <p>It was agreed that a “streamlined” procedure should be adopted. It was doubted that the Court could suspend national time limits.</p> <p>The parties should be the patentee and the EPO.</p>

		<p>limits for validation in EPC member states.</p> <p>Accordingly what is proposed is a very streamlined procedure for appeal on this particular issue. One suggestion is requiring the applicant to copy the appeal immediately to the EPO and generally requiring a decision on the appeal within one month.</p> <p>This needs consideration.</p>	<p>4. Problem: The applicant would have to hand in a translation (in states where this is still required) within 3 months after grant (Art. 65 EPC) and to pay the first renewal fee before the year after the grant starts (Art. 141(1), 86(2) EPC; 2 months favour of Art. 141(2) EPC). These time-limits may have run out (they are not automatically stayed; a reinstatement will fail)</p> <p>Solution: Since the UPC is a court common to all participating member states it should be able to order a stay of the time limits regulated in the national laws executing Art. 65 and 141, (Art. 65 EPC expressly allows for a "longer period"; Art. 141(1) only bars requiring earlier fees).</p> <p>Proposal: Add to Rule 86: "Where the action concerns a decision of the EPO not to register an application for unitary effect, the Court may, on a request by the claimant, stay any time-limit set by the national laws of the participating member states for handing in a translation (Art. 65 EPC) and for the payment of renewal fees (Art. 141(1) EPC as long as there is no final decision on the action."</p> <p>Alternative: The "quick procedure" proposed by CIPA for this special case, but not only for the CoA, also for the CFI..</p>	
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Rule 87	91 – FICPI-I	This respondent suggests that in each of paragraphs (a), (b) and (c) the words “ infringement of ” should be replaced by “ non-compliance with ”.	No change recommended Non-compliance with a binding rule is an infringement.	Agreed: no change
Rule 88	110 – CCBE	It is suggested that if the application is brought by a person who is not the proprietor then either the claimant or the Registry is required to notify the proprietor (possibly pursuant to Rule 90). The question then arises whether the proprietor must or may join the proceedings.	No change recommended If the claimant is not the proprietor, he must prove an own damage (Rule 88.2(b)). He may ask the proprietor to join..	Agreed: no change
Rule 88.2(b)	91 – FICPI-I	Since the application under this rule might relate to a decision of the EPO not to register the patent as a European patent with unitary effect it is suggested to delete the words “with unitary effect”.	No change recommended Present text clarifies this.	Agreed: no change
Rule 88.5	2 – PAT	It is suggested that this rule which removes the requirement for formal representation pursuant to Rule 8 goes too far. It is suggested that the representation rules of the EPC should apply . A similar comment is made by 48 – GRUR.	No change recommended The derogation of Rule 8 only means that the claimant must not use an UPCA-representative . He may use such a representative or a normal European Patent attorney . And he may also go on his own (maximum human rights protection).	Agreed: no change
Rule 88.5	6 – KAS	This respondent makes a different point. There is nothing in Article 48(7) and Rule 88 which prevents a party from being represented if he so wishes. This respondent believes that Rule 88 should indicate that if a party does wish to be represented then he may do so but only by a representative as defined in Article	No change recommended See above (not only UPCA-representatives)	Agreed: no change

		48 of the Agreement.		
Rule 91.1	63 – JIPA	It is suggested by this respondent that the period of one month is too short and may well lead to the EPO rejecting applications to annul as a matter of course, whereas if given more time the likelihood is that more contested decisions would be rectified.	No change recommended Rule 91 is designed for obvious errors of the EPO . The short time-limit allows the Court to go ahead quickly if the EPO does not rectify.	Agreed: no change
Rule 94	8 – BUND	This respondent feels that the President of the EPO should not only have a right to comment but a right to become a party to the proceedings, which is forbidden apparently by this rule.	No change recommended Party is the EPO. The President gets the right to comment, but should not become a party because he is acting for the EPO.	Agreed: no change
Rule 96	48 – GRUR	This rule impliedly gives the panel a discretion not to convene an oral hearing . This is opposed by this respondent who points to the fact that in the EPO an appellant has an unconditional right to an oral hearing (Article 116 EPC).	Change recommended 1. The Human Rights Charter does not require an oral hearing. Rules 115/116 EPC are not applicable. 2. However Rule 96 needs amendment because there are no rules on the oral hearing and the decisions of the Court. Proposal: Add before the only sentence: "1. Rules 110.3, 111, 115 and 118.7 and 8 shall apply to the oral hearing and to the decision of the Court. 2. (as the present text)"	Change agreed It was agreed to amend Rule 96.

Rule 101.3	24 – LILLY	<p>This respondent believes that this rule is too prescriptive in requiring that the judge-rapporteur “shall complete the interim procedure within three months...” it suggests rather a provision that the judge-rapporteur “shall endeavour to complete...”</p> <p>A similar comment is made by 33 – IP, 36 – ABPI.</p> <p>This seems to be acceptable.</p>	<p>Change recommended</p> <p>Proposal:</p> <p>“... the judge rapporteur shall endeavour to complete ...</p>	<p>Agreed: no change</p> <p>It was agreed that no change to this rule was required.</p>
Rule 103	13 – EPLAW	<p>It is suggested that the list of matters that may be ordered by the judge-rapporteur for the interim conference should be non-exhaustive in keeping with the concept of active case management.</p> <p>This seems to be a sensible suggestion.</p>	<p>Change recommended</p> <p>Proposal:</p> <p>“to be specified, to especially ...</p>	<p>Change agreed</p> <p>It was agreed to add the words “in particular” to Rule 103 to make it clear that (a) to (d) is a non-exhaustive list.</p>
Rule 105-106	5 – KOS	<p>This respondent queries whether holding the interim conference by telephone complies with Article 45 of the Agreement.</p>	<p>No change recommended</p> <p>Art. 45, in using the word “proceedings”, is referring to the “oral procedure ” in Art 52(1) which is distinguished there from the interim procedure (<i>an interim procedure and an oral procedure</i>). Therefore, Art. 45 does not relate to the interim procedure. It may be held by telephone.</p>	<p>Agreed: no change</p>
Rule 105.1 and 106	91 – FICPI-I	<p>It is suggested that the following words be added to the end of Rule 105.1 “and shall be audio/video recorded”.</p> <p>A similar comment is made by 110 –</p>	<p>Change recommended</p> <p>Audio-recording: yes. Video-recording: no</p>	<p>Change agreed</p> <p>It was agreed that audio-recording should be provided for.</p>

		<p>CCBE</p> <p>This seems to be sensible.</p> <p>It is also suggested that irrespective of how the interim conference is held the judge-rapporteur shall be required to take minutes and the minutes of the interim conference should be available on the Register subject to the confidentiality provision.</p>	<p>Should be part of the changes to Rules 106 and 115 recommended</p> <p>See below Rule 106 and 115 – 16-CSO</p>	<p>It was also agreed that Rules 105 and 106 should be aligned with each other and Rule 115.</p>
Rule 105.3	8 – BUND	<p>The respondent believes it should be clear that the parties consent to the use of the language in question.</p>	<p>No change recommended</p> <p>This is implied in "mastered" which can be ascertained by the JR only by asking the representative.</p>	<p>Change agreed</p> <p>It was agreed to re-phrase Rule 105.3 as "...any language <u>agreed</u> by the parties' representatives".</p>
Rule 105.3	91 – FICPI-I	<p>It is pointed out that the word "mastered" may be ambiguous and also there is no provision as to who decides whether or not a particular language is "mastered". It is suggested that the Rule should simply read "in any language agreed by the parties' representatives."</p> <p>This seems to be sensible.</p>	<p>No change recommended</p> <p>The JR should not need agreement where the representatives clearly master the language.</p>	<p>Change agreed</p> <p>See above.</p>
Rule 105, 178 and 264	28 – HUN	<p>This respondent points to Article 44 of the Agreement which encourages the Court to make the best use of electronic procedures including video conferencing in accordance with the Rules of Procedure. It therefore recommends that these rules should be amended so as to require the use of electronic procedures wherever</p>	<p>No change recommended</p> <p>"Best use" (Art. 44) does not require to use. "wherever practical" gives no security either that it is used.</p>	<p>Agreed: no change</p>

		<p>practical.</p> <p>A similar comment is made by 40 – TAL.</p>		
Rule 106 and 115	5 – KOS	<p>This respondent comments that recording and making publically available a transcript of proceedings may be forbidden by the Judicature Act in Germany.</p>	<p>This is international law.</p> <p>But Human Rights must be respected.</p> <p>See below</p>	See below
Rule 106 and 115	16 – CSO	<p>This respondent points out that these two rules are not consistent and that a better balance is achieved in Rule 115. It therefore recommends amending Rule 106 to bring it into line with Rule 115.</p> <p>60 – AIPPI-J this respondent also believes that the confidentiality provisions should be brought into line and prefers Rule 115.</p>	<p>Changes to Rules 106 and 115 recommended</p> <p>1. Art. 44 (Electronic procedures) only intends to facilitate the communication between the Court and the parties. It does not require or even deal with the recording of interim conferences or oral procedures.</p> <p>It does not either deal with the right of third parties to get to know the contents of the electronic communication.</p> <p>Rules 4 and 105.1 are implementing Art. 44.</p> <p>2. Art. 45 only requires that the oral hearing shall be "public". It does not require or even deal with recording and the right to use the recordings.</p> <p>3. Under the new RoP of the ECJ (OJ L 265/1 of 29.9.2012) the hearings are recorded. Under Art. 83 of these Rules "<i>the President may, on a duly substantiated request, authorise a party ((or (government</i></p>	<p>Change agreed</p> <p>As noted above, it was agreed to amend Rule 106 to bring it into line with Rule 115.</p> <p>It was also agreed that access should be available to recordings to the parties or their representatives on the Court's premises. However, there should be no need to submit a reasoned request.</p>

			<p><i>representatives)) who has participated in the written or oral part of the proceedings to listen, on the Court's premises, to the soundtrack of the hearing in the language used by the speaker during that hearing.</i></p> <p>4. We should follow that example.</p> <p>Proposal:</p> <p>a) The rules in Rule 106 and 115 (interim conference, oral hearing) should be the same</p> <p>b) Both shall be open to the public (interim conference only if held in the Court)</p> <p>c) There shall be only sound track recording (helpful for judges repeating oral statements), no video recording (danger: representatives speaking to the world public)</p> <p>d) As to the right to listen to sound track: Rule as before the ECJ.</p> <p>Reason: The oral proceedings should be safeguarded against window dressing.</p> <p>Note: The public access to the Register (including pleadings, evidence, decisions and orders) is regulated very liberally in Rule 262 (see there).</p>	
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Rule 106 and 115	21 PUR –	This respondent recommends that these rules should entitle parties to arrange for a transcript to be prepared of proceedings.	No change recommended See above. Sound track listening allowed for the parties (representatives only).	Change agreed A final Order recording the decision should be provided for. It was also noted that parties are free to take notes or to arrange for a private transcript to be made.
Rule 106	14 EPI –	This respondent believes that where the interim conference is held by multimedia or telephone there should be an express provision that it be recorded and the recording made publically available in line with a conference held in open court. Similar comments made by 31 – LES.	No change along these lines recommended See above	See 16 – CSO above
Rule 106	110 CCBE –	It is suggested that this rule should apply (i.e. publically available recording) irrespective of the manner of holding the interim conference pursuant to Rule 105. This seems to be sensible.	No change recommended See above 16 CSO	See 16 – CSO above
Rule 108	39 FUR –	This respondent believes it is important that so far as practicable the date of the oral hearing should be set by agreement between the parties and not dictated by the Court. Only if agreement turns out to be impossible should a date be given with reasonable notice. Similar comment is made by 42 – ADIPA, 70 – LIM-D.	No change recommended We should not regulate normal practice. The Court (JR) will set a date and will react if a party or its representative advances good reasons. He may use the phone before but should not be obliged to do that. There is the two-month comfort of sentence 3.	Agreed: no change
Rule 109.2	91 FICPI-I –	In order for a party wishing to engage and interpret to comply with Rule 109.4 it is suggested that Rule 109.2 shall require	No change recommended We should not set time-limits where	Change agreed It was agreed that there should <u>not</u> be

		<p>the judge-rapporteur to decide on simultaneous interpretation “at the latest three weeks before the oral hearing”.</p> <p>This seems to be sensible.</p>	<p>there is no sanction. The JR needs flexibility.</p>	<p>time limit for deciding on an interpreter.</p> <p><u>However</u>, where such an interpreter is appointed, the JR should be able to order the parties/a party to pay in advance (in default of which, the interpreter would not be provided). It was agreed that this should be covered by a general rule on such pre-payments.</p>
Rule 110	20 – APEB	<p>This group is unclear as to the consequence of the closure of the interim procedure. They suggest a provision that after closure neither party can file new pleadings or evidence without the prior leave of the Court.</p>	<p>No change recommended</p> <p>No further written pleadings allowed, except with the leave of the Court. Follows from Rule 110.2: The “final dates” are those for handing in written pleadings.</p>	<p>Agreed: no change</p>
Rule 111 and 112	20 – APEB	<p>This group considers that the Rules as to the conduct of the oral hearing are unclear and that there should be either an express sequence of events set out in the Rule or, pursuant to Rule 111, the presiding judge should inform the parties in advance how the particular oral hearing will be conducted.</p> <p>This latter suggestion is worthy of consideration and could be used to meet the next point made by 24 – LILLY re witness hearings.</p> <p>A similar comment is made by 33 – IP, 110 – CCBE.</p> <p>A similar comment is made by 41 – SWED who goes further to suggest that in preparation for the oral hearing the judge-rapporteur shall prepare a written</p>	<p>No change recommended</p> <p>1. The order of the oral hearing follows Rule 112.2: The oral hearing begins with hearing of the parties’ oral submissions. These begin with the reading out of the claims of the action and the defence. After the submissions potentially a witness hearing.</p> <p>2. This order does not preclude but also not prescribe introductory remarks by the presiding judge as to the order of the day and as to the main questions the panel sees. The Court needs flexibility in this respect. We should not regulate normal practice.</p>	<p>Agreed: no change</p>

		summary of the positions of the parties, the issues in dispute and the issues to be dealt with at the oral hearing. However the EPO practice of expressing preliminary opinions should not be followed.	No obligation (but of course permission) to provide parties with written information of any kind before the oral hearing. Leave that to the handling of the Court who knows how to handle these things. We don't write teaching manuals for beginners!	
Rule 111 to 115	24 – LILLY	This respondent points out, correctly, that there are no specific rules directed towards the conduct of a separate witness hearing. This is correct and we should discuss what if any specific rule may be required. See the above suggestion.	No change recommended The separate witness hearing may be ordered by the JR after consultation with the presiding judge (Rule 104(g) and (h)). It will follow the order of Rule 112.3 and 4 . This is self-understanding and does not need written rules.	Agreed: no change
Rule 112.4	33 – IP	This respondent queries the meaning of “admissible” evidence , and also under what law that issue is to be decided.	No change recommended Evidence is not admissible (= question is not allowed), if it has not been proposed as a matter for questioning the witness before the closure of the relevant time limits or the “final dates” mentioned in Rule 110.2.	Agreed: no change
Rule 112.5	91 – FICPI-I	It is suggested that the following words should be added to this rule: “Provided that, where necessary, simultaneous interpretation between these languages has been arranged.”		Agreed: no change It was agreed that change is not needed, as translation is implicit.
Rule 116 and 117	20 – APEB	This group point out that a party may decide not to be personally present in court but to be represented by its counsel	Change recommended	Change agreed It was agreed to change “present” to

		<p>and that this should not involve any adverse consequence. Therefore it suggests adding the word “or represented” in Rule 116.1, 116.3 and 117.</p> <p>This seems sensible.</p>	<p>Proposal:</p> <p>a) Change Rule 116.2: "absence of a party's representative or the absence of a party under Rules 88.5 and 378.5"</p> <p>b) Change Rule 116.3: In case of such an absence the respective party shall ...</p>	<p>“represented”. Accordingly a party would be present where its representative attends, in accordance with Rule 8.</p>
Rule 116.3	108 – AAPI	<p>This respondent believes that this rule should be deleted since it implies that new submissions may be admitted at the oral proceeding and therefore this is unfair on a party who is absent and unable to comment on these new submissions. It therefore suggests deleting Rule 116.3 or allowing the absent party to file a post-hearing brief.</p> <p>It is difficult to prohibit a court from allowing new submissions to be made during an oral hearing even if one of the parties is absent. There will always be a dispute as to what is or what is not a new submission.</p>	<p>No change recommended</p> <p>New submissions in the oral hearing are restricted (Rule 110). The Court will adjourn the hearing, if the danger of unfair treatment of the absent party arises.</p>	<p>Agreed: no change</p>
Rule 118	11 – GOO	<p>This respondent suggests to add additional provisions to Rule 118 as follows:</p> <p>“1A. In taking its decision on whether to issue a permanent injunction, the Court shall have the discretion to weigh up the interests of the parties and in particular to take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction, as well as the</p>	<p>No change recommended</p> <p>1. Art. 63(1) of the Agreement and Art. 11 of Directive 2004/48 (Enforcement Directive) are saying "may". Therefore, the Court has discretion.</p> <p>2. How to use that discretion is generally defined in Art. 3(1) and (2) of the Enforcement Directive.</p>	<p>See below</p>

		<p>interests of third parties.”</p> <p>“10. Where the Court of First Instance grants a permanent injunction, that order shall not become enforceable until fifteen working days after the order is made, subject to Rule 223.”</p>	<p>a) Therefore the "measure" (here: permanent Injunction) "<i>shall be fair and equitable and shall not be unnecessarily complicated or costly ...</i>" (Art. 3(1)) <u>and</u></p> <p>b) that measure "<i>shall also be effective, proportionate and dissuasive and shall be applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide for safeguards against their abuse</i>" (Art. 3(2))</p> <p>3. In addition Art. 12 of the Enforcement Directive allows for a special exception (see Rule 118.2).</p> <p>This is the material law to be applied by the Court. It is not for the RoP to change or re-write this law.</p> <p>4. Regarding provisional and protective measures see Art. 62(2).</p>	
Rule 118.1	13 – EPLAW	<p>It is suggested that security should always be given to the Court for the benefit of the other party rather than to the party itself. A similar suggestion is made with respect of Rule 352.</p> <p>A similar comment is made by 40 – TAL.</p>	<p>No change recommended</p> <p>According to Art. 9(6) Enforcement Directive the security is "intended to ensure compensation for any prejudice suffered by the defendant ...</p> <p>Therefore, the security must be given to the defendant (only this will "ensure" him).</p> <p>The Court should not be used as depot for such securities (danger of</p>	Agreed: no change

			loss).	
Rule 118.1	39 – FUR	This respondent suggests that the Court should <u>always</u> order security where a decision on infringement has been given before a decision has been made in the validity proceedings.	<p>No change recommended</p> <p>1. Art. 9(6) of the Enforcement Directive prescribes for provisional injunctions that the Court "may make" that injunction "subject to the lodging by the applicant of adequate security ..."</p> <p>2. A non-final decision by the Court (still subject to Appeal) must respect this rule for provisional injunctions because the situation is comparable..</p> <p>3. Therefore, the Court may (and not "must") order a security. The Court will in most cases do that. But the RoP should not and cannot alter the Directive.</p>	Agreed: no change
Rule 118.2	4 – AIPPI	<p>This respondent believes that the wording in this rule needs improvement and that it should be made clear whether the three conditions are cumulative or alternates. It assumes that they are cumulative and believes that this is not satisfactory. The Court should have more freedom in granting alternative relief to injunctive relief and recommends that the conditions should expressly be made alternates.</p> <p>Similar comments made by 10 – CMS, 21 – PUR, 34 – BLACK, 49 – GSMA (which suggests that the three conditions should be expressed to be alternatives by the insertion of the word “or” and that this would ensure a practical and balance interpretation of</p>	<p>No change recommended</p> <p>I agree with Kevin's comment</p> <p>1. Art. 12 Enforcement Directive (with its cumulative requirements) should not be altered by the RoP.</p> <p>2. Parallel to Art. 12, the general rules of Art. 3(1) and (2) of the Enforcement Directive are applicable and allow for alternative relief to injunctions.</p> <p>3. The RoP should not interfere with the application of these general</p>	Change agreed

		<p>the Enforcement Directive pending a final decision (by the CJEU?) as to its true meaning), 52 – EIP, 60 – AIPPI-J, 89 – BRIS.</p> <p>This rule 118.2 reproduces the relevant provision of the Enforcement Directive. The Committee has debated whether the conditions are cumulative or alternates and the decision was taken simply to repeat the wording of the Directive so as to enable the Court in due course to interpret the provision.</p>	<p>rules by the Court.</p>	<p>incorrect. Rule 118.2 is an extension to Rule 118.1, not a restriction upon it.</p> <p>It was agreed to clarify Rule 118 by:</p> <ul style="list-style-type: none"> • In Rule 118.1, striking out “<i>Subject to the following provisions of this Rule</i>”; and • Adding at the start of Rule 118.2, “<i>Without prejudice to the discretion provided for in Articles 63 and 64</i>”.
Rule 118.2	24 – LILLY	<p>This respondent believes that the requirements of Rule 118.2 are cumulative and satisfactory and, as a general matter, it opposes introducing eBay type principles into the Rules.</p> <p>A similar comment in favour of the cumulative construction is made by 77 – AIPPI-F. (Curiously this is contrary to the response of 4 – AIPPI above) and 108 – AAPI</p> <p>A similar comment has been made by 36 – ABPI with regard to eBay principles.</p>	<p>Correct</p> <p>See above</p>	<p>See above</p>
Rule 118.2	7 – INTEL	<p>This respondent believes that the provision of a remedy as an alternate to injunctive relief is sensible in some cases. However, it regards the wording of this rule as vague. The grant of such alternate relief should not depend on whether the person acted “unintentionally and</p>	<p>No change recommended</p> <p>See above</p>	<p>See above</p>

		<p>without negligence”.</p> <p>Similar comments made by 31 – LES, 33 – IP, 98 – NOK.</p> <p>As noted, the language of this rule is taken from the Enforcement Directive.</p>		
Rule 118.2	83 – COAL	<p>This respondent believes that Rule 118.2 should be amended as follows:</p> <p>“In exercising its discretion and taking its decision on whether to issue a permanent injunction, the Court shall weigh up the interests of the parties and in particular take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction, whether damages and/or compensation to the injured party would be reasonably satisfactory, and the public interest.”</p>	<p>No change recommended</p> <p>Enforcement-Directive wording should be used</p>	Agreed: no change
Rule 118.2	13 – EPLAW	<p>It is suggested that the wording “unintentionally and without negligence” is inconsistent with the wording of “Regulation 1260/1212 which is “acted without reasonable grounds for knowing”.</p> <p>This will be checked.</p>	<p>Not correct</p> <p>The wording of Rule 118.2 exactly repeats the English wording of Art. 12 Enforcement Directive.</p>	Agreed: no change
Rule 118.2	58 – GSK	<p>This respondent believes that “innocence” should never be a reason not to grant an injunction.</p>	<p>No change recommended</p> <p>See above</p>	Agreed: no change

Rule 118.2	86 MAX	<p>– This respondent points to the general discretion provided for in the grant of permanent injunction in Article 63(1) of the Agreement. It suggests that a balance of competing interests should involve the following criteria:</p> <p>“1. The relationship, in terms of size and economic importance, of the patent invention to the overall product of which it is about,</p> <p>2. The objective of the plaintiff in seeking the injunction, i.e. preventing unlawful competition or merely encouraging a pecuniary settlement,</p> <p>3. Whether the legitimate interests of the patentee can be more adequately protected by monetary compensation,</p> <p>4. Balance of hardship,</p> <p>5. The effects of the injunction on consumer interests.”</p> <p>This respondent also believe that Article 112 can be misinterpreted as being only applicable in cases of innocent conduct. It suggests that the Rules should indicate that the provisions of Directive 204/48 are not cumulative.</p>	<p>No change recommended</p> <p>No Ebay-rules in the UPCA</p>	<p>Agreed: no change</p>
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Rule 118.3	4 AIPPI –	<p>Consistent with its remarks on Rule 37.4, this respondent also recommends that the “high likelihood” requirement under 118.3(b) should be replaced by a “reasonable likelihood” test.</p> <p>A similar comment is made by 34 – BLACK who also repeats the definition of “reasonable likelihood” that it suggests for the purposes of Rule 37. A similar comment is made by 39 – FUR, 49 – GSMA.</p> <p>The respondent 98 – NOK suggests that the tests should be not “high likelihood” but rather “on the balance of probabilities”.</p>	<p>No change recommended</p> <p>See above my comments to Rule 37/37.4</p> <p>The score:</p> <p>a) for keeping "high likelihood": 29 ERIC, 41 SWED, 59 QUAL, 48 GRUR, 16 CSO</p> <p>b) for change: 7 and 56 INTEL, 4 AIPPI, 10 CMS, 53 ARM, 15 M&S, 16 CSO, 60 AIPPI-J</p> <p>For the full extent of the Rules protecting the defendant: See my comment on Rule 118.3 re: 12 GOO below.</p>	Agreed: no change
Rule 118.3	10 CMS –	<p>It is suggested that the opening line of this rule should be amplified to make the context clearer:</p> <p>“If in proceedings for infringement a revocation action is pending...”</p> <p>This is helpful.</p> <p>This respondent also suggests replacing the “high likelihood” with “clear possibility” consistent with its comment on Rule 37.4.</p>	<p>Change recommended</p> <p>Say "If while proceedings against infringement are pending before a local or regional division a revocation is pending ..."</p> <p>Note: This rule must cover two cases (1) bifurcation cases and (2) cases under Rule 70 where a revocation case has started before the central division and the patent proprietor later starts an infringement action before a local or regional division (with or without a revocation counterclaim raised). Therefore it had to be formulated in a general way.</p>	Change agreed

Rule 118.3	12 GOO –	<p>This respondent suggests a different formulation of Rule 118.3 as follows:</p> <p>“3. If a revocation action is pending before the central division or if an opposition is pending before the European Patent Office, the local or regional division shall:</p> <p>(a) render any decision on the merits of the infringement claim, including its orders, under the condition precedent that the patent (patents) is (are) not held to be wholly or partially invalid by the final decision in the revocation procedure or a final decision of the European Patent Office or under any other term or condition, or,</p> <p>(b) suspend the infringement proceedings pending a final decision in the revocation procedure or a final decision of the European Patent Office.”</p> <p>A similar comment is made by 15 – M&S which believes that no decision on infringement should be enforceable prior to a first instance decision on validity. A similar comment is made by 31 – LES, 42 – ADIPA, 87 – CDI.</p>	<p>No change recommended</p> <ol style="list-style-type: none"> 1. The EPO opposition result is covered by the present wording in a) and b). 2. Condition subsequent (<i>auflösende Bedingung</i>) (in a)) is correct (not: precedent) 3. No change of "may stay/shall stay" in b) (compromise solution). 4. The defendant is fully protected by <ol style="list-style-type: none"> a) security (Rule 118.1) b) condition subsequent (Rule 118.3(a)) and "come back" (Rule 118.5) c) damage claim (Rules 118.5, 354.4) d) possible gradual enforcement (Rule 118.9) e) immediate appeal (Rule 220.1(a)) and application for the standing judge (Rules 223, 345.8) 	<p>Agreed: no change</p>
Rule 118.3(b)	4 AIPPI –	<p>This respondent believes that all reference to EPO decisions should be deleted from the sub-rule. If that is not done and the “high likelihood test is passed then there may be a mandatory stay pending an EPO decision for some years. This is unacceptable and contrary to Article 33(10) of the Agreement.</p>	<p>No change recommended</p> <ol style="list-style-type: none"> 1. If the EPO opposition has a "high likelihood" of success the Court should not go ahead with the infringement action. 2. Art. 33(10) permits stay "when a rapid decision may be expected from 	<p>Change agreed</p> <p>The Committee discussed these points. It considered that, where there is a high likelihood of the patent being held invalid, proceedings should be stayed.</p> <p>It was agreed to reflect Article 33(10) in Rule 118(3)(b) that “...<i>decision of the</i></p>

		<p>Similar comments made by 10 – CMS, 21 – PUR, 33 – IP.</p> <p>Respondent 98 – NOK also believes reference to EPO decision should be deleted having regard to the over-arching provision in Rule 295.</p> <p>A similar comment is made by 110 – CCBE which also believes that a stay pending a decision of the EPO should only occur where the decision is imminent. Otherwise there is a conflict with Article 33(10).</p>	<p>the EPO". This rule applies irrespective of the prospective outcome and does not stand in the way of an obligation to stay in case of "high likelihood" of success of the opposition.</p> <p>No change recommended</p> <p>The Court will respect Art. 33(10)</p>	<p><i>European Patent Office <u>where such decision of the European Patent Office may be expected to be given rapidly and shall stay...</u></i></p>
Rule 118.3(b)	33 – IP	<p>This respondent sees no need for this provision given the general provision for stays under Rule 295. However if the intention is that the Court will only stay its <u>decision</u> rather than the oral procedure then this should be made perfectly clear and the rule should read:</p> <p>"may stay the rendering of its decision in the infringement proceedings..."</p>	<p>No change recommended</p> <p>Legally there is no such thing as "stay" of a "rendering of decisions" but only a stay of the infringement proceedings which come to a provisional end not permitting a decision on the merits.</p>	<p>Agreed: no change</p>
Rule 118.3(b)	63 – JIPA	<p>This respondent believes that it would be preferable to have a simple rule that the local or regional division shall simply stay its decision in the infringement proceedings pending an outstanding decision in the revocation proceedings.</p>	<p>No change recommended</p> <p>This would be unfair, especially if the revocation action is clearly unfounded or even frivolous. The present wording is better.</p>	<p>Agreed: no change</p>
Rule 118.6	29 – ERIC	<p>1. This respondent believes that decisions on liability to bear costs should be expressed to be appealable</p>	<p>1. No change recommended</p> <p>Indeed, this is already covered by</p>	<p>1. Agreed: no change</p>

		<p>to ensure consistency in all divisions.</p> <p>A similar comment is made by 41 – SWED.</p> <p>I believe this is already covered by Rule 220.1(a).</p> <p>2. This respondent also recommends that the parties should present a statement of their costs prior to the decision in the main proceedings to avoid costs later being inflated. It also believes wherever <u>possible</u> the decision on the merits should deal with all cost issues and that separate proceedings pursuant to Rule 150 should be the exception.</p> <p>A similar comment is made by 64 – FIN</p> <p>3. This respondent would also like greater clarity in the Rule on responsibility for costs where both parties have succeeded to some extent. For example if a patent is found to be valid but not infringed a decision needs to be taken in principle whether the defendant is entitled to the costs of the whole action or whether the claimant is entitled to the costs of the unsuccessful counterclaim. These issues of principle, <u>at least</u>, should be decided by the panel in the main proceedings.</p> <p>To be discussed.</p>	<p>Rule 220.1(a).</p> <p>2. No change recommended</p> <p>Experience shows that parties seldom agree on the amount of costs (1) to be accepted as to their real amount and (2) to be borne by the losing party applying Art. 69(1) and Rule 152.1.</p> <p>It would not be wise to burden the proceedings on the merit and the whole panel with the task to decide these details.</p> <p>3. No change necessary</p> <p>The infringement proceedings and the proceedings on a revocation counterclaim are two proceedings. The cost-decision "in principle" will address separately both proceedings. No need to regulate.</p>	<p>2. Change agreed</p> <p>The Committee considered that the provision of an estimate of costs before judgment is given is helpful to avoid ex post facto inflation of costs. It was agreed to add wording to the effect that <i>"In advance of the decision, the parties shall provide a preliminary estimate of the legal costs that they intend to recover."</i></p> <p>3. Agreed: no change</p> <p>Where there is a partial success, Rule 118.6 permits the Court to apportion costs (as set out in Article 69(2)).</p>
Rule 118.7 and Rule 350	21 – PUR	<p>This respondent recommends that these rules should be amended to make it clear that the Court should give a reasoned decision in relation to all matters in dispute between the parties to avoid a risk</p>	<p>No change recommended</p> <p>1. The Court must give reasons only on what is necessary to arrive at its</p>	<p>Changes agreed</p> <p>The Committee discussed to what extent reasons should be given by the</p>

		<p>that following an appeal it will be necessary for the Court of Appeal to remit the case back to the Court of First Instance. It further points out that a reasoned decision on merits of all matters in dispute would enable a fairer decision on how costs are to be apportioned.</p> <p>A similar comment is made by 24 – LILLY.</p> <p>A similar comment is made by 30 – CIPA who refer to a case T2427/09 of the EPO. In this case the Appeal Board observed as follows:</p> <p>“It is useful to point out that if the opposition division had examined all grants of opposition raised instead of only one of them, the Board could have given a final decision on the case instead of remitting it. Even if the assessment of novelty and inventive step in principle requires a specific claim wording the opposition division could in the present case no doubt have expressed a sufficiently detailed opinion so as to render a referral unnecessary.”</p> <p>This respondent also points to the fact that judgments of the High Court in the UK are frequently given in complex cases within the six week period although this period is not mandatory.</p>	<p>decision.</p> <p>No hypothetical treatment of arguments which, in its view, are not relevant.</p> <p>That would be against the principle to act "in the most efficient and cost effective manner" (Art. 41(3) of the Agreement; Preamble of the RoP, para. 4).</p> <p>It would be "work in vain" for the decisions which are not appealed (in Germany a majority of cases).</p> <p>2. The Court of Appeal has not the role of the Appeal Court in London. The subject matter for the UPC-CoA is not only the first instance decision and its "findings" but the whole content of the file. This CoA has to digest all "requests, facts, evidence and arguments" submitted by the parties in the first instance (Rule 222.1). And it has to make up his mind independently of the arguments of the CFI.</p>	<p>CFI.</p> <p>It was observed that, particularly where the CFI hears evidence from witnesses, it should address the findings of fact. To fail to do so would make it hard for the Court of Appeal to deal with any appeal.</p> <p>However, it was noted that it might be more economical for the CFI to give only short decisions. Requiring the CFI to give reasons on all “principle issues” might be insufficiently clear.</p> <p>At the meeting on 14 December 2014, a proposal from CF was discussed.</p> <p>It was agreed that the EPO’s practice of very limited decisions requiring referral back should not be emulated by the Court. It was considered that, where the CFI is in a position to decide issues and matters of fact (other than those strictly necessary for its decision) that might otherwise be raised on appeal, it should consider the desirability of doing so in the interests of efficiency.</p> <p>To reflect this, the Committee agreed to add Rule 118.7(b), “The Court shall give reasons for its decision” and to add at Rule 242.3 that “It shall not normally be an exceptional circumstance justifying a referral back that the Court of First Instance failed to decide an issue which it is necessary for the Court of Appeal to decide on appeal.”</p>
Rule 118.9	14 –	It is suggested that the orders referred to in this rule should be limited to paragraphs	Change recommended	Change agreed

	EPI	1 and 3(a). This seems a sensible suggestion.	Say " paragraphs 1, 2 and 3 (a)... "	
Rule 118.9	110 – CCBE	This respondent believes that there should be express reference in this rule to Rule 352 i.e. orders for security to compensate the defendant in the event that they are found wholly or partially invalid.	Change recommended Rule 352 applies to every Rule providing for a security. However other Rules reference to Rule 352 also (see Rule 136)	Change agreed
Rule 118.10 – NEW	7 – INTEL	This respondent suggests a new provision to avoid injunctions being enforced inappropriately. In particular it believes that a defendant should have a reasonable time in order to comply with a court's order before becoming subject to sanction. It proposes a new rule as follows: "118.10 Subject always to Rule 223 where the Court of First Instance grants a permanent injunction an order shall not be enforceable until at least 15 working days after the date of the order of such later date as the Court deems reasonable." A similar comment and proposed amendment is made by 83 – COAL	No change recommended The losing party must make early preparations. It will have drawn consequences from the oral hearing. See the full protection of the defendant listed above Rule 118.3 re: 12 GOO	Agreed: no change
Rule 119	77 – AIPPI-F	This respondent believes that this rule mixes up two separate issues i.e. an interim award of damages and an interim award of costs to cover the cost of the separate damages procedure. It suggests that the second sentence should be	No change recommended 1. Interim award of costs is regulated in Rule 150.2 2. The idea is to help the successful party to finance the damage	Agreed: no change

		<p>amended so to read:</p> <p>“The Court may also make an interim award of costs to cover the expected cost of the procedure for the award of damages and compensation on the part of the successful party.”</p> <p>This should be considered.</p>	<p>proceedings.</p>	
Rule 125	13 – EPLAW	<p>It is suggested that the definition of “damages” is new. It is further suggested that Article 68 of the Agreement (award damages) does not correspond to Article 13 of Directive 2004/48/EC (Enforcement Directive).</p>	<p>No change recommended</p> <p>Art. 68 is binding and must be interpreted in the light of Art. 13 Enforcement Directive. Nothing what the Rules can do here to change that.</p>	<p>Agreed: no change</p>
Rule 126	91 – FICPI-I	<p>This respondent suggests a small amendment to Rule 126 to bring it into line with Rule 131.1(c). The suggestion is to replace the word “including” in the final line with the word “which may include”.</p>	<p>Change recommended</p> <p>I agree with that proposal</p>	<p>Change agreed</p>
Rule 126	110 – CCBE	<p>This respondent suggests that a deadline to request a determination of damages is in principle wrong and is not covered by Article 68 of the Agreement. In any event the one year appears to be arbitrary and there should be no objection to the time being extended either by agreement or with the consent of the Court.</p>	<p>No change recommended</p> <p>If the same JR and the same panel should decide, there must be an adequate time-limit. One year is adequate.</p> <p>Art. 9 applies (extension)</p>	<p>Agreed: no change</p> <p>It was agreed that one year is an adequate compromise, enabling the same panel to hear the damages proceedings.</p>
Rule 131(2)(a)	91 – FICPI-I	<p>This respondent suggests that the words in brackets are not entirely comprehensive and it would be preferable simply to refer to “(damages or compensation)”.</p>	<p>No change recommended</p> <p>The three words "damages, licence fee, profits" are abbreviations of the three types of damages in Art. 68.</p>	<p>Agreed: no change</p>

Rule 133	10 CMS	– This respondent believes that this rule is circular in effect. The point of the proceedings is to determine the amount of damages and yet in order to commence these proceedings a value-based fee must be paid based upon some determination of what the amount of damages may be. The respondent asks for clarification as to how this will work in practice.	No change recommended The amount of the damage asked for shall be the value of the proceedings for the determination of damages. Rule 133 uses the usual wording. In this case it could be said in a simpler way. But no change necessary	Change agreed It was agreed that Rule 133 should make it clearer that the fee is based on the value of the damages claimed, in order to deter extravagant claims.
Rule 133	90 CSA	– This respondent believes that a value-based fee for the determination of damages is improper particularly having regard to the payment of a value based fee for the original infringement proceeding. A fixed fee, it is suggested, is more appropriate.	No change recommended The damage proceedings are a separate procedure. The fee is a deterrent against scrupulous claims for damages. The claimant risks to bear part of the costs.	Agreed: no change See above
Rule 133	91 FICPI-I	– This respondent also believes that a value-based fee is not appropriate when such a fee has already been paid in the infringement proceedings.	No change recommended See above	Agreed: no change See above
Rule 133	105 AICIPI	– This respondent believes that a value-based fee for the determination of damages is also improper having regard to the fee paid for the original infringement proceedings. A fixed fee, it is suggested, is more appropriate.	No change recommended See above	Agreed: no change See above
Rule 136	110 CCBE	– It is suggested that either party should be entitled to ask for a stay of the determination of damages.	No change recommended If the applicant himself asks for a stay, the Court will certainly grant it.	Agreed: no change See above

Rule 137.2	110 – CCBE	It is proposed that the two months period should run from receipt of the Rule 131.2 information and therefore proposes the insertion of the following words: “ within two months of receipt of the information pursuant to Rule 131.2(a) to (e)...the Registry ”	Change recommended Proposal "Within two months of service of the Application for the determination of damages or, if there was a procedure for laying open of books, within two months of service of the indication according to Rule 131.2 lodge a Defence ..."	Change agreed
Rule 139	108 – AAPI	This respondent believes that the defendant, as is the case with other proceedings, should have the right to lodge a Rejoinder to the Reply. Therefore the title to this rule should be amended and there should be express reference to a Rejoinder and the fact that it should be limited to matters raised in the Reply . This seems to be correct.	Change recommended I agree with Kevin's comment.	Change agreed
Rule 141 and 143	84 – BGMA	This respondent believes that it is necessary for the Court to be able to order confidentiality restrictions in respect of the contents of account and that if sufficient audited schedules need only be provided.	No change recommended Rule 143 refers to Art. 58 (confidentiality) and Rule 190.1 (access only for certain persons)	Change agreed
Rule 142	108 – AAPI	This respondent suggests the same amendment be made as in its comment on Rule 139.	Change recommended Same change as suggested regarding Rule 139	Change agreed
Rule 143.1(b)	110 – CCBE	It is suggested that there should be a reference back to the provision of information pursuant to Rule 131.2.	Change recommended I agree with Kevin's comment.	Change agreed

		This appears to be sensible.		
Rules 150-155 Costs Orders	4 - AIPPI	<p>This respondent believes that assessment of costs is best conducted by the Court immediately following the trial on the merits and should be so decided without being postponed to later separate proceedings. It also suggests that both parties be required to submit their claims for legal costs following the trial on the merits but before the judgment so that claims for costs will not be influenced by the result. It is suggested that a rule similar to Rule 119 (interim award of damages) could be inserted as an alternative to separate proceedings.</p> <p>See earlier assessment by 29 – ERIC and a similar comment made by 10 – CMS, 41 – SWED, 75 – FINNCHAM, 80 – CFI.</p> <p>A similar point is made by 98 – NOK who suggests that Rule 151 should be amended to read as follows:</p> <p>“Where a party wishes to seek a cost order, it shall prior to the oral hearing lodge a *Schedule of Costs which shall contain an indication of the costs for which compensation is requested, including:</p> <p>(a) court fees</p>	<p>No change recommended</p> <p>See comment 2 on 118.6 re 29 ERIC</p> <p>No change recommended</p> <p>Better to have the costs decided later.</p>	<p>Change agreed</p> <p>See amendments to Rule 118.6.</p>

		<p>(b) costs of representation,</p> <p>(c) expenses or fees of witnesses and experts, and other expenses, and</p> <p>(d) estimates of any costs of the oral hearing which have not yet been incurred</p> <p>2) Where following service of the decision the successful party (hereinafter “the applicant”) wishes to seek a cost order, it shall within one month of service of the decision lodge an *Application for a cost order which shall contain</p> <p>(a) particulars in accordance with Rule 13.1(a) to (d),</p> <p>(b) the date of the decision and the action number of the file,</p> <p>(c) a statement as to whether the decision on the merits is the subject of an appeal, if known, at the date of the Application, and</p> <p>(d) the Schedule of Costs lodged under Rule 151(1), updated with costs of the oral hearing.”</p>		
Rule 150	110 – CCBE	<p>This respondent suggests that the basic principle for determining recoverable costs should be set out and therefore it suggests at the end of Rule 150.1 that the following should be added:</p> <p>“In deciding what order (if any) to make</p>	<p>No change recommended</p> <p>The definition of Art. 69 says "reasonable and proportionate costs". The "conduct" is not included.</p>	<p>Agreed: no change</p> <p>It was noted that 110 – CCBE’s proposals reflected the English Civil Procedure Rules. It was agreed that no change was required, as issues of the kinds identified could be dealt with by</p>

		<p>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 claim, in whole or in part, exaggerated its claim.”</p>		<p>the Court's discretion.</p>
Rule 150	33 – IP	<p>This respondent believes that it should be made clear whether or not court fees (as distinct from court costs) are recoverable costs.</p> <p>This is clear from Rule 151(d).</p>	<p>No change recommended</p> <p>I agree with Kevin's comment: Clear from Rule 151(d)</p>	<p>Agreed: no change</p>

Rule 150.1	41 – SWED	This respondent strongly believes that court costs referred to in this rule should not be passed onto the unsuccessful party but should be borne by the court as a facility for the performance of its duties and covered by court fees.	No change recommended This argument may be relevant for other civil proceedings – not for patent cases.	Agreed: no change
Rule 150.2	110 – CCBE	This respondent also suggests that the factors to be taken into account when ordering an interim award of costs should be set out at the end of the rule as follows: “2. 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)...”	No change recommended The definition of Art. 69 says "reasonable and proportionate costs". The " conduct " is not included .	Agreed: no change
Rule 151	16 – CSO	It is suggested that the reference in this rule to “successful” party is inappropriate in that in a more complicated action both parties may have been successful to some extent and may wish to seek costs. It is suggested that the order simply referred to a “party”.	No change recommended It is the word used in Art. 69(1) of the Agreement and applicable also in cases of mixed success.	Agreed: no change

Rule 152 to 155	29 – ERIC	<p>This respondent points out that Article 69(1) of the Agreement refers to “reasonable and proportionate legal cost and other expenses”. The word “other expenses” has been omitted from Rule 152 and instead certain detailed expenses are dealt with in Rules 135 to 155. However this respondent believes there may well be other expenses which are reasonable and proportionate and should be provided for and therefore Rule 152 should be amended to refer to “other expenses”.</p> <p>A similar comment is made by 41 – SWED who also comments that any cap on the recovery of costs pursuant to Rule 152.2 should normally allow all reasonable and proportionate costs to be recovered. This will avoid the difficulties that exist in the US. This respondent also recommends that rather than one single cap there should be a range of ceilings depending upon the value of the dispute.</p>	<p>No change recommended</p> <p>See Rule 151(d) "and other expenses".</p> <p>The "costs" in Rule 152 refer also to these "other expenses".</p> <p>This is a matter for the "cap".</p>	<p>Agreed: no change</p> <p>As noted by WT, Rule 151(d) refers to “other expenses”.</p>
Rule 152.2	78 – PB	<p>This respondent would like it to be made clear that compensation for representation would also cover the cost of a patent</p>	<p>No change recommended</p> <p>The use of an assisting patent</p>	<p>Agreed: no change</p>

		attorney assisting pursuant to Article 48(4) of the Agreement.	attorney may not be reasonable and proportionate under Rule 152.1 and Art. 69(1).	
Rule 153	67 – MUN	This rule refers to “ customary ” rates for the cost of experts. This respondent wonders whether the Court should maintain a schedule of customary rates .	No change recommended This is something for later practice of the Court. No prescription necessary.	Agreed: no change
Rule 158 – NEW	12 – GOO	This respondent refers to Article 69(4) which quite generally allows the Court to order security for the legal costs and other expenses . In the Rules as currently drafted there are specific provisions in relation to provisional measures but this respondent believes that a more general rule would be appropriate and suggests the following new Rule 158: “ The Court may order the claimant to provide adequate security for the legal costs and other expenses incurred or likely to be incurred by the defendant and which the claimant may be liable to bear. The Court shall do so where in the court's opinion there is a risk that the claimant would not be able to meet the defendant's legal costs and other expenses were he to lose. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee. ” A similar comment is made by 103 – BDI	No change recommended Art. 69(4) is a general rule and it is "self-executing". It does not need repetition as in the proposed first sentence. The proposed second sentence is the requirement clearly intended by Art. 69(4). And the third sentence is self-understanding. Note: 1. The ECJ has forbidden such securities against Union-citizens. 2. There are many bilateral treaties containing a mutual waiver of securities. 3. Therefore, Art. 69(4) is difficult to handle and should not be emphasised by a Rule giving the impression that this is the normal way to proceed. 4. If the need for a Rule is felt, it must be together with the Preliminary objection See Appendix: New Rule – Security	Change agreed The proposal of 12 – GOO for a rule on providing security from costs was discussed. It was agreed that the Chairman should draft a proposed general discretionary power to order security for costs, to be added towards the end of the RoP. This should require a reasoned application and contain appropriate safeguards, including the right to be heard.

			for costs.	
Rule 171 and 172	13 – EPLAW	It is suggested that these rules deviate from Article 6.3 of the Enforcement Directive.	No change recommended Art. 6 Enforcement Directive has no para.3. Rules 171 and 172 are based on Art. 53 of the Agreement which does not contradict the Directive.	Agreed: no change
Rule 171	13 – EPLAW	This respondent queries the meaning of “not specifically contested”. It asks whether a statement, for example, that “all the facts are contested unless expressly admitted” is sufficient.	It is not admitted. The wording “specifically” is designed to exclude that.	Agreed: no change
Rule 171	107 – APP	This respondent suggests that Section 138 of the German code of civil procedure should be incorporated into the Rules at this point. According to this respondent the relevant provisions are as follows: “1. The parties are to make their declarations as to facts and circumstances fully and completely and are obliged to tell the truth. 2. Each party is to react in substance to the facts alleged by the other party. 3. Facts that are not expressly disputed are deemed to have been acknowledged unless the intention to dispute them is evident from declarations made by the relevant party. 4. A party may declare its lack of	No change recommended An obligation of that kind is without sanction in the UPC-proceedings. The sanction everybody knows is penal law.	Change agreed It was agreed to add a new Rule 171.3 based on the wording of Article 48(6), i.e.: “Representatives of the parties shall be obliged not to misrepresent cases or facts before the Court either knowingly or with good reason to know” (i.e. intentionally or negligently).

		knowledge only where this concerns facts relating to actions not taken by the party itself nor within its knowledge.”		
Rule 171.1	21 – PUR	This respondent believes that in many cases it will be difficult to assess whether a statement of fact is “ likely to be contested ” and may result in unnecessary pleadings. It is suggested therefore that these words be deleted.	No change recommended The idea is that the party making that statement should not wait for the other party contesting it and hope this other party will forget to do that “specifically”.. Rule 171.1 is the basis for the JR's asking for an indication of the means of evidence in the interim procedure.	Agreed: no change
Rule 172	4 – AIPPI	This respondent recommends a revised rule which reads as follows: “ The parties shall make their declarations as to the truth or falsity of facts and circumstances fully and completely and are obliged to tell the truth ”. A similar amendment is proposed by 78 – PB who comments that this is in accordance with Section 138(1) German code of civil procedure. This revision is expressly contested as irrelevant by another respondent, 51 – B&B.	No change recommended An obligation of that kind is without sanction in the UPC-proceedings. The sanction everybody knows is penal law.	See above
Rule 172.1	110 – CCBE	This respondent believes that the requirement (use of “must”) to produce fact evidence goes too far and may result in an unnecessary amount of evidence being produced. It is suggested that “must”	No change recommended Rule 171.1 (“must”) is the basis for the JR's asking for an indication of the means of evidence in the interim	Agreed: no change

		should be replaced with “may”.	procedure.	
Rule 175	13 – EPLAW	<p>It is suggested that “applicable national law” is unclear and there should instead be reference to the law of the domicile of the person. It is further pointed out that certain local bar rules will prevent representatives from having direct contact with witnesses but there may be exceptions in an international context. Should this rule explicitly allow contact and if so should it limit the extent of contact?</p> <p>A similar comment is made by 51 – B&B, 77 – AIPPI-F with regard to “applicable national law”. This respondent suggests adding the following sentence:</p> <p>“The applicable national law is that of the contracting member state of the territory in which the witness’s domiciled or the law of the contracting member state where the central division of the Court is located”.</p> <p>Respondent 99 – IPLA also points to the uncertainty of the expression “applicable national law”. It also suggests that witness statements should be executed in accordance with a specified member state in order to avoid any ambiguity as to the relevant member state for the purposes of a breach. The Rules of Procedure need not stipulate, it is suggested, how the relevant law is chosen simply that the witness statement expressly states that the witness statement is sworn in</p>	<p>No change recommended</p> <p>Penal law has its own rules on applicable law.</p> <p>The RoP do not contain Bar-rules and should not try to harmonise them.</p> <p>No change recommended</p> <p>We must leave that for the rules of penal law.</p>	<p>Agreed: no change</p> <p>It was noted that this had been drafted in a deliberately open manner to accommodate national law and practice. It was noted that some countries at least (e.g. Germany) provide for penalties for perjury before international courts.</p> <p>No change was required.</p>

		<p>accordance with the laws of that state.</p> <p>A similar comment is made by 104 – ICC who also recommends that applicable national law shall be the law where the witness is domiciled.</p> <p>A similar comment is made by 110 – CCBE.</p>		
Rule 175	14 – EPI	<p>This respondent believes that there should be a requirement for a written witness statement, i.e. replace “may” with “shall” or at least a written summary of what the witness proposes to give evidence to.</p> <p>Similar comments made by 24 – LILLY, 33 – IP, 36 – ABPI, 6 – KAS.</p>	<p>Change recommended</p> <p>1. "may" should stay: The anglo-saxon written witness statement has its dangers (formulation by lawyer or patent attorney; hesitation of the witness to withdraw a written assertion when testifying in the oral hearing). On the continent the prudent rule (not always kept) is: hands off a witness once his testimony is offered to the court.</p> <p>But:</p> <p>Since there is no obligation to lodge a written witness statement, the wording of Rule 176 is too narrow (Application only if the witness statement cannot be obtained).</p> <p>Proposal: Rule 176 should begin as follows:</p> <p>"A party seeking to offer oral witness evidence shall make an Application ..."</p>	<p>Change agreed</p> <p>After discussion, it was agreed that “<i>or a written summary of the evidence to be given</i>” should be added to the end of Rule 175.1; “may” should be replaced with “shall”, so the party may provide either a statement or a summary.</p>

Rule 175	110 – CCBE	<p>This respondent suggests that there should be additional provision concerning any conflict of interest and suggests a possible Rule 175.3 as follows:</p> <p>“The written witness statement shall provide information in respect of (i) the current or past relationship existing between the witness and the party lodging the written witness statement, and (ii) any conflict of interest relating to such witness which may affect its independence.”</p>	<p>Change recommended</p> <p>Proposal:</p> <p>“The written witness statement shall contain information regarding</p> <p>(i) the current or past relationship existing between the witness and the party offering the written witness statement,</p> <p>(ii) any fact relating to a possible conflict of interest and</p> <p>(iii) whether the witness has drafted the statement himself or, if not, with the help of which other person.”</p>	<p>Change agreed</p> <p>It was agreed to add a Rule 175.3 based on points (i) and (ii) of WT’s proposal.</p>
Rule 175.2	24 – LILLY	<p>This respondent believes that a witness statement should always contain a statement that the witness is willing to be cross-examined if so ordered by the Court. This, it is claimed, will provide a safeguard against over-partial evidence.</p> <p>A similar comment made by 33 – IP, 36 – ABPI. A similar comment is made by 58 – GSK who goes further to suggest that a witness should assume that he will be cross-examined.</p>	<p>No change recommended</p> <p>Cross examination is not depending on the "willingness" of the witness.</p>	<p>Agreed: no change</p>
Rule 177.1	33 – IP	<p>This respondent believes that this rule should be amended so that, if the Court refuses to order that the witness be heard when challenged pursuant to Rule 177.1(a), that order should be subject to appeal.</p>	<p>No change recommended</p> <p>According to Rule 220 only with leave of the Court.</p>	<p>Note added to Rule 220.2</p> <p>This was discussed further at the meeting on 14 December, when the Committee considered procedural appeals. It was agreed to add a note to Rule 220.2 reflecting the lack of</p>

		A similar comment is made by 36 – ABPI.		agreement on the meaning of “Court” in Article 73(2)(b)(ii).
Rule 177.2	40 – TAL	This respondent believes that the order of a court summoning a witness should include , in addition to the listed items, a statement as to the duties of a witness as set out in Rule 179. This seems sensible.	Change recommended Proposal: "2. The Court shall in its order inform the witness about his duties and rights as a witness under Rules 178.1 and 179."	Change agreed It was agreed to amend the rule in line with WT's proposal.
Rule 177.2	91 – FICPI-I	This respondent suggests a further paragraph (g) as follows: “(g) the language of proceedings and the possibility of arranging simultaneous translation between the language of proceedings and the language of the witness.”	Change recommended I agree with this proposal.	Change agreed It was agreed to amend the rule in line with the proposal.
Rule 178, 185, 201 and 202	42 – ADIPA	All of these rules refer to an action by the Court “of its own motion”. This respondent believes that the ability of the Court to act of its own motion is contrary to the adversarial system and these actions should only be taken by the Court if there is specific agreement of the party.	No change recommended Art. 43 calls for "active management". Art. 56(2) allows court orders under the condition that the parties have got the opportunity to be heard. Art. 57 (court experts) and 62 (provisional and protective measures) allow court orders without request of a party.	Agreed: no change
Rule 178.1	5 – KOS	This respondent, as a trained scientist, would be reluctant to declare that his scientific conclusions are “the truth” . He suggests to add some words to the former declaration along the follow lines: “and the opinions expressed in my	No change recommended The Rule relates only to statements of fact, not to opinions.	Agreed: no change

		evidence are my own”.		
Rule 178.1	77 – AIPPI-F	This respondent believes that this rule should be supplemented so that the witness is also obliged to declare the following: “I am aware of my obligation to tell the truth and of my liability under the applicable national law in the event of any breach of this obligation.”	No change recommended This is what the presiding judge will tell the witness before he is heard.	Agreed: no change
Rule 178.1	16 – CSO	This respondent believes that it is very important that after taking the oath but before giving evidence the witness should be asked about his relationship to the parties or any other relevant interest in the outcome of the case.	Change recommended Proposal: Insert after the formula of the solemn declaration: “He shall ask the witness about his relationship to the parties or any other relevant interest in the outcome of the case and shall inform him on his duties and rights under Rule 179.”	Dealt with above
Rule 178.7	81 – JD	This respondent believes that this rule should set out the arrangements for interpretation and the responsibility for its cost.	No change recommended These will be provided for by the JR in the interim phase.	Agreed: no change This is dealt with in earlier rules.
Rule 179.3	13 – EPLAW	This rule, it is pointed out, also referred to “ applicable national law ”. It is again suggested that this may be unclear and that it might be preferable to refer expressly to the law of the relevant domicile .	No change recommended There may be different national laws to be applied: domicile, place of registration. The Court will know.	Agreed: no change

Rule 179.3	16 CSO	– It is suggested that the content of this rule should be included as part of the order of the Court summoning a witness to give evidence so that the witness has prior knowledge of his rights.	Change recommended See above my Proposal to Rule 177.2 re 40 TAL	See above This will now be incorporated into the witness summons.
Rule 181	57 CNF	– It is suggested that where a party appoints an expert the summons of the expert witness to the oral hearing should, in addition to the matters set out in Rule 179, contain the following: “1. An expert witness has an overriding duty to assist the Court impartially on matters relevant to his or her area of expertise. 2. This duty overrides any duty to a party to the proceeding including the party retaining the expert witness. An expert is to be independent and objective and is not an advocate for a party.”	Change recommended This is taken care of by my Proposal 177.2 re 40 TAL and reference there to Rule 178.1, referenced in Rule 181 second sentence	Change agreed It was agreed to: • Add text based on 57 – CNF’s proposal to Rule 179; and • Add text based on paragraph 1 and the second sentence of paragraph 2 (i.e. the relevant text) to Rule 186 on court-appointed experts.
Rule 181	60 AIPPI-J	– This respondent believes that there should not be a restriction on the ability of a party to produce the evidence it deems necessary.	No change recommended The "ability of the parties to produce expert evidence" is guaranteed by Art. 57(1) of the Agreement. But it follows from Art. 53(2) that the Court may limit witness and expert testimony " to what is necessary ".	Agreed: no change
Rule 185	10 CMS	– This respondent wishes to have an additional provision giving the parties the right to object to a proposed expert. A similar comment is made by 33 – IP.	No change recommended Already taken care of by Art. 57(3) of the Agreement with reference to Art. 7(4) of the Statute.	Change agreed It was agreed that Rule 185 should be amended to give the parties a right to be heard on the expertise etc. of the court

				expert.
Rule 185	30 – CIPA	This respondent believes that this rule should be amended to allow a party to object to the appointment of a court expert on the grounds of a conflict of interest.	No change recommended See above	See above
Rule 185	33 – IP	This respondent believes that the Rule should make clear who is responsible initially for paying a court appointed expert and whether or not such a fee can be recovered pursuant to Rule 150. Perhaps an express reference to Rule 185 should be added to Rule 150.	Change recommended 1. Insert a new sentence in Rule 185.7: " The Court shall agree with the expert on a fee covering his written expert report and his participation in the oral hearing. The Court may reduce this fee by an equitable amount ... " 2. Insert in Rule 150.1 a reference to Rule " 185.7 ". Note regarding travel expenses: Rule 150.1 refers to Rule 188. Rule 188 refers to 180.1 (thereby covering travel expenses of the Court's expert, Rule 185.4(g)). No change needed	Change agreed It was agreed to amend Rule 185 in line with WT's proposal. The Court should also be required to notify the parties of the expense of the expert and who should bear it, with reasons. This should be covered as part of the general rule on costs as discussed above.
Rule 185.2	97 – EGA	This respondent believes that it is not satisfactory for parties to be able to suggest experts , whose attitudes to the issues may be well known. Instead it suggests that the parties should limit their suggestions to appropriate qualifications.	No change recommended The parties usually have a better knowledge regarding possible court's experts and regarding possible conflicts of interest.	Agreed: no change The Committee agreed that the parties are best placed to propose experts (and to object to the other party's proposals).

Rule 185.3	97 EGA –	<p>This respondent points out that the court expert must be independent but there is nothing in the current rules which requires a proposed expert to disclose any links to any of the parties prior to his appointment. It is suggested that Rule 185.3 should be amended to have this as a prior requirement.</p> <p>See also the comment on Rule 175 re witnesses.</p>	<p>No change recommended</p> <p>Rule 185.3 (independence and impartiality of the expert) must be observed by the Court.</p>	<p>See above</p>
Rule 185.4(c)	2 – PAT	<p>It is suggested that the use of court experts should not be restricted to technical issues. In particular it is suggested that the Court may wish to appoint a court expert to advise on technical legal issues e.g. the proper construction of a contract in accordance with the proper law of that contract.</p> <p>This is a permissible area for expert evidence. Should the word “technical” in this rule be deleted?</p>	<p>Change to be considered</p> <ol style="list-style-type: none"> 1. <i>lura novit curia.</i> 2. Art. 57(1) ("expertise for specific aspects of the case") does allow for a court expert on other than technical issues. 3. Rule 181 covers only a part of what Art. 57(1) allows, the most often used part. Why should it cover all parts of Art. 57(1)? 4. But if we want to be perfect, we could say "a specific technical or other question". That would cover legal questions and economic questions (expert for the amount of damage) 	<p>Change agreed</p> <p>It was agreed to adopt WT's proposed wording of "a <i>specific technical or other question</i>":</p> <p>Rule 185.1, .2, and .4(c) should be amended to refer to "<i>...technical or other...</i>".</p> <p>However, the Registry's list of experts should be restricted to <u>technical</u> experts. Rule 185.9 should be amended accordingly.</p>
Rule 186.6	14 EPI –	<p>This respondent suggests adding the words "under the control of the presiding judge" at the end of this rule.</p> <p>A similar comment has been made by 6</p>	<p>No change recommended</p> <ol style="list-style-type: none"> 1. It follows from Rule 185.7 that the Court will control the time period. 2. In most cases the control will be 	<p>Agreed: no change</p>

		<p>– KAS.</p> <p>This seems to be acceptable.</p>	<p>exercised by the JR.</p>	
Rule 190.1	97 – EGA	<p>This respondent suggests replacing the word “specify” with “indicated” as it is likely in many cases that the relevant party will not have such specific evidence.</p>	<p>No change recommended</p> <p>"specified evidence" is designed to exclude assumed evidence.</p>	<p>Agreed: no change</p>
Rule 191	25 – TEVA	<p>This respondent points out</p> <ol style="list-style-type: none"> 1. that Rule 191 extends beyond the more specific provisions of Article 67 2. and lacks any provision for maintaining confidentiality in respect of any part of the information that is communicated. <p>A similar comment is made by 51 – B&B, 43 – VCI.</p> <p>This comment is correct but a broader requirement to communicate information for the purposes of proceedings can be justified. It would however be sensible to reproduce (by cross-reference) the confidentiality provisions of Rule 190 for the purposes also of Rule 191.</p>	<p>Change recommended</p> <ol style="list-style-type: none"> 1. In Rule 191.1 (there is no 191.2) the last half sentence "or such other information ..." must be deleted, because it exceeds the legal basis in Art. 67 of the Agreement, in Art. 8 Enforcement Directive and in Art. 47 TRIPs. It is <i>ultra vires</i> of the RoP to go beyond the restrictions of these legal bases. 2. New second sentence in Rule 191: "Rule 190.5 and 6 and Rule 196 second sentence shall apply <i>mutatis mutandis</i>." 	<p>Change agreed</p> <p>In line with WT’s proposal 2, it was agreed to add a provision (or a cross-reference to a general provision) about confidentiality to address 25 - TEVA’s second point.</p>
Rule 192 to 199	20 – APEB	<p>This group, representing French practitioners, recommend a number of amendments to the saisie provisions in these rules in order to make them workable. The suggestions are as follows:</p> <ol style="list-style-type: none"> 1. In Rule 192.2(b) it is suggested that “exact” be deleted as the location of 	<p>Change recommended</p> <p>Proposals:</p>	<p>Changes agreed</p>

		<p>evidence is not always known and the following words should be inserted: “where it is suspected that the evidence to be preserved is located”.</p> <p>A similar comment is made by 33 – IP, 36 – ABPI, 104 – ICC.</p> <p>2. In Rule 192.2(c) the plaintive must indicate reasons why “prompt measures” are needed to preserve relevant evidence. This group points out that urgency should not be one of the conditions for the grant of a saisie. No such urgency condition exists in Directive 2004/48/EC.</p> <p>A similar comment is made by 77 – AIPPI-F, 104 – ICC</p> <p>3. Rule 192.2(d) requires the applicant to indicate the evidence relied on in support of the application. It is claimed that this requirement is unlikely to be satisfied in most cases i.e. where it is impossible to collect evidence without actually entering the premises. It is suggested that the Rule should read: “the facts and, if reasonably available, evidence relied on”. This amendment echoes Article 60 of the Agreement.</p> <p>A similar comment is made by 77 – AIPPI-F</p> <p>4. This group points out that Rules 194 to 197 in normal cases will require an inter-partes hearing. This group believe that this will be contrary to the interests of</p>	<p>1. Add in Rule 192.2(b): “where it is known or with good reasons suspected.”</p> <p>2. In Rule 192.2(c): “the reasons why the proposed measures are needed ...”</p> <p>Note:</p> <p>According to Rule 194.2(a) "urgency" is one of the aspects the Court shall take into account. But this does not exclude a measure without "urgency".</p> <p>3. I agree with the proposed new wording.</p>	<p>1. It was agreed to amend the rule in line with the spirit WT’s proposal.</p> <p>2. It was agreed to replace “prompt” with “proposed”, as suggested.</p> <p>3. It was agreed to add “if available” to Rule 192.2(d).</p>
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		<p>preservation of evidence as it is currently operated in several European countries. The Rules should be amended so that the overriding principle is that the Defendant shall <u>not</u> be heard unless the Court deems it necessary.</p> <p>A similar comment is made by 6 – KAS, 104 – ICC.</p> <p>This rather drastic proposal needs discussion.</p>	<p>4. No change recommended</p> <p>This would be against Art. 60.5. Ex parte only "if necessary"</p>	<p>4. Agreed: no change.</p>
Rule 192 to 199	33 – IP	<p>Evidence obtained pursuant to a saisie is often used for the purposes of other proceedings. This respondent believes that such a system should not be perpetuated and that there should be a general provision preventing any evidence obtained by compulsion in proceedings being used in any other court for any other proceedings.</p>	<p>No change recommended</p> <p>The RoP deliberately do not restrict the use of matter acquired by the measures in other proceedings, except where confidentiality is ordered.</p>	<p>Agreed: no change</p> <p>It was noted that Rule 196.2 restricts use of evidence obtained via a saisie.</p>
Rule 192.1	107 – APP	<p>This respondent queries whether an application for preserving evidence can be made to a division which is not the place where the evidence is located. She points to the situation under Article 7 of the Enforcement Directive where such orders have been made in the past and comments that it may be more appropriate for such orders to be limited to the territory of the relevant division.</p>	<p>No change recommended</p> <p>The competent division must stay in charge.</p>	<p>Agreed: no change</p> <p>It was noted the divisions are part of a single, unified court.</p>
Rule 192.3	25 – TEVA	<p>It is suggested that the obligation of disclosure in this rule should extend not only to any material fact but also to any relevant document.</p>	<p>No change recommended</p> <p>"Material fact" is a broad term. The term relates to facts irrespective of whether they are shown in a document</p>	<p>Agreed: no change</p>

		<p>A similar comment is made by 51 – B&B.</p> <p>This seems to be an acceptable amendment.</p>	<p>or not.</p>	
Rule 192.3	108 – AAPI	<p>This respondent believes that the obligation to disclose material facts which <u>might</u> influence the Court is too vague and burdensome. It recommends that the second sentence be deleted.</p>	<p>No change recommended</p> <p>The formulation is wide to give room for any fact which may influence the Court.</p>	<p>Agreed: no change</p>
Rule 194.1	104 – ICC	<p>Consistent with its view that an application for preserving evidence should almost always be ex parte this respondent believes that the discretion in the Court to inform the defendant about the application is not appropriate and does not derive either from Article 60 of the Agreement or Article 7 of the Enforcement Directive.</p> <p>This respondent therefore recommends that only options (c) and (d) of draft Rule 194.1 should remain and Rule 194.2 should be deleted.</p>	<p>No change recommended</p> <p>These are the facts important for the order of the Court.</p>	<p>Agreed: no change</p>
Rule 194.2(a)	108 – AAPI	<p>Consistent with the comment with regard to Rule 192.2(c) to the effect that “prompt measures” are irrelevant this respondent suggests that this rule requiring the Court to take account of the “urgency of the action” should be deleted as irrelevant.</p>	<p>No change recommended</p> <p>Urgency is no requirement, but an element to be considered by the Court in framing its order.</p>	<p>Agreed: no change</p> <p>The Committee reiterated WT’s point that urgency is a factor, but not a prerequisite.</p>
Rule 195	6 – KAS	<p>This respondent believes that where the Court has decided to summon the other party to an oral hearing it should not do so unless the applicant has earlier been</p>	<p>No change recommended</p> <p>No sufficient reason to "protect" the applicant in that situation (as in the</p>	<p>Agreed: no change</p>

		informed and has the opportunity to withdraw his application.	case of an application for provisional measures without hearing the defendant, Rule 209.4: the surprise action may be repeated later on better grounds).	
Rule 196	13 – EPLAW	1. It is suggested that this rule should specifically allow seizure of digital media and also the copying of digital files. 2. It is also suggested that there should be power to order the Defendant to provide passwords and other access to digital files. A similar comment is made by 51 – B&B.	No change recommended 1. It is not important for patent cases. 2. Possible legal barriers in Union law	Change agreed It was agreed to: • Amend Rule 196.1 to state “ <i>may order, in particular, the following:</i> ” • Add a new Rule 196.1(d) to the effect of “preservation of digital media and data and the disclosure of any passwords necessary to access them”.
Rule 196	14 – EPI	It is suggested there should be an express provision stating that the Court may refuse an order for preserving evidence.	No change recommended This is self-understanding	Agreed: no change
Rule 196.1	77 – AIPPI-F	This group suggests a new Rule 196.1(d) to cover the “physical seizure of documents relating to any of the above”. This seems to be a sensible suggestion.	Change recommended I agree with Kevin's comment.	Agreed: no change This was discussed, but the Committee decided that a further rule was unnecessary.
Rule 196.1(a)	108 – AAPI	This respondent suggests redrafting this so as to read: “Preserving evidence by detailed description of the allegedly infringing goods or process, with or without the taking of samples of the allegedly	Change recommended I agree with this proposal.	Agreed: no change The committee considered that the existing Rule 196.1(a) and (b) are already sufficiently clear, and that this proposal would be too restrictive.

		infringing goods.”		
Rule 196.2	104 ICC	– This respondent queries the meaning of “the proceedings on the merits of the case”. 1. It queries whether this would cover the possibility of suing on patents other than those the subject of the original application if evidence is discovered of these further infringements. 2. This respondent also believes that there is no reason why evidence could not be used in other proceedings and therefore it suggests deleting Rule 196.2.	bv 1. Only with the permission of the Court. 2. The Rule is reasonable to protect the defendant.	Agreed: no change
Rule 196.3(a)	6 KAS	– This respondent believes that it should be made clear that the applicant may be represented by a representative as defined in Article 48 of the Agreement.	No change recommended Representation is meant within the meaning of Art. 48 (Rule 8).	Agreed: no change After a discussion of the appropriate representative and the need to avoid “fishing” or inappropriate disclosure of information, the Committee agreed that no change was required.
Rule 196.4	25 TEVA	– It is suggested that in this rule there should be a reference to any obligations of confidence imposed by the Court pursuant to Rule 196.1. A similar comment is made by 51 – B&B.	No change recommended Already covered by Rule 196.1 second sentence.	Agreed: no change
Rule 196.4	104 ICC	– This respondent suggests that the person identified in this rule may also be assisted by other technically skilled person if approved by the Court.	No change recommended This does not need regulation	Agreed: no change

Rule 196.6	104 – ICC	This respondent believes that a requirement to grant security where an order is made ex parte goes beyond Article 60 of the Agreement and should be deleted.	No change recommended Art. 60(7) expressly allows an order for lodging a security	Agreed: no change
Rule 197	13 – EPLAW	It is suggested that the period for requesting a review, namely 10 working days, is too short particularly if an order is made to preserve evidence in another country. A period of 30 working days is suggested. A similar comment is made by 25 – TEVA who also suggests a period of 30 days. A similar suggestion is made by 51 – B&B.	Change recommended A time-limit of 30 days is better (legal protection). However note the requirement of an action on the merits (as prescribed by Art. 62(5) referring to Art. 60(8)). Both time-limits run side by side.	Change agreed It was agreed that a limit of 30 [calendar] days should be adopted. After discussion on 14 December 2014, the Committee agreed that this would not come into conflict with the time limits in Rule 198.1, which run in parallel.
Rule 197.2	77 – AIPPI-F	This respondent recommends deleting the words “without delay and at the latest immediately after the time of execution of the measures” and inserting instead the following: “...either before or at the time of the execution of the measures” In addition this respondent recommends that a fresh paragraph be inserted into Rule 197 to the effect that the order for preserving evidence should not be entered on the Register until notice has been given to the defendant. This is consistent with Rule 192.3. Similar comments and suggested amendment are made by 108 – AAPI	No change recommended The measure may be executed without giving the defendant a notice (surprise at a store house).	Agreed: no change It was agreed that the original wording of “...without delay and at the latest immediately after the execution of the measures” should be retained.

Rule 197.3	63 – JIPA	It is pointed out by this Japanese respondent that the period of 10 working days is extremely short for an overseas defendant. It proposes that if a review is requested within such period the information required in Rule 197.3(a) and (b) can be provided later.	<p>Change recommended</p> <p>See above</p> <p>Proposal:</p> <p>Start Rule 197.4 as follows</p> <p>"The Court shall proceed according to Rule 264. Rule 195 shall apply..."</p> <p>Reason: This gives the Court more flexibility. Oral hearing is just one alternative.</p>	<p>See above</p> <p>The increase to 30 days addresses this concern.</p>
Rule 198.1	2 – PAT	It is suggested that the time limits are unnecessarily complicated and that an appropriate time limit would be one month.	<p>No change recommended</p> <p>I agree with Kevin's comment.</p>	Agreed: no change
Rule 198.1	77 – AIPPI-F	It is suggested by this respondent that to be consistent with Article 60(8) of the Agreement the time period should run not from the date of the order but from the date of execution of the measures.	<p>No change recommended</p> <p>A clear starting date is needed (legal security). The date of execution may be insecure (first attempts, more than one day)</p>	Agreed: no change
Rule 198.2 and Rule 213.2	13 – EPLAW	It is pointed out that these rules are not consistent. In the former the Court "may" order compensation whereas in the latter the Court "shall" order compensation. Both rules are based upon Article 60(9) of the Agreement.	<p>Change recommended</p> <p>It should be "may" in Rule 213.2.</p>	<p>Change agreed</p> <p>The Committee noted that this comment was correct. It should be "may" in both cases.</p>

		This appears to be correct. Article 60(9) in the Agreement provides that the Court “may” order compensation.		
Rule 201	110 – CCBE	This rule permits the Court of its own motion to order the carrying out of an experiment. If it exercises this right it is suggested that the Rule should at the very least provide in a general way for directions as to how, when and by whom the experiment is to be conducted and also at whose initial cost.	No change recommended This is self-understanding.	Agreed: no change It was noted that this would be dealt by the general rule on costs, discussed above.
Rules 205 to 213	16 – CSO	This respondent feels that there should be some general provision applying to Part 3 (Provisional Measures) which requires all procedural rule steps to be taken as a matter of urgency and in priority to other proceedings. This should be discussed.	No change recommended "Urgency" is not required by Art. 62 of the Agreement, by Art. 9 Enforcement Directive and Art. 50 TRIPS (Art. 50(2): only for <i>ex-parte</i> -orders) This does not exclude the Court taking account of urgency or lack of urgency (see Rule 194.2(a), 209.2(b), 211.1(c))	Agreed: no change
Rule 206	7 – INTEL	This respondent believe that unless there are exceptional circumstances justifying a different approach the default position should always be that any successful applicant for provisional measures must provide appropriate security and the applicant for provisional measures must always give the respondent/defendant full notice of the hearing so that the application can be properly contested. With these comments in mind this	No change recommended	Agreed: no change The Committee considered that Rule 206 is adequate as it stands.

		<p>respondent has suggested the following amended Rules 206.6 and 206.7:</p> <p>[...]</p> <p>6. Unless there are exceptional circumstances justifying a different approach, the applicant for provisional measures must give the defendant adequate notice of the hearing so that the application can be properly defended.</p> <p>7. Where a provisional measure is applied for without the defendant being given notice, any decision or order of the Court should fully record the Court's reasoning, the evidence and arguments relied upon, and the amount of security that must be provided before any measures can be enforced."</p>	<p>1. Security: Rule 211.4: "may", but "must" if ex parte. Is an adequate solution.</p> <p>2. The order containing provisional measures is served on the defendant together with the application and its reasons. That should be sufficient to answer.</p>	
Rule 207	33 – IP	<p>This respondent does not support the protective letter system and instead suggests that the hurdle to grant ex parte relief should be set at a very high level indeed so as to exclude all cases except counterfeiting and piracy and similar cases involving likely dishonesty. If a matter is urgent there is no reason why notice should not be given via electronic or telephonic means.</p> <p>A similar comment is made by 41 –</p>	<p>No change recommended</p> <p>The defendant is better protected, if the Court knows his arguments. This does not mean that the thresholds for ex-parte-orders are lowered because there exists the possibility of a protective letter which the defendant has not used in a given case..</p>	Agreed: no change

		SWED.		
Rule 207.1	110 – CCBE	<p>1. It is suggested that the Rule should make clear that a protective letter may be filed on behalf of a group of related companies but that only one fee is payable.</p> <p>2. This respondent also queries how the protective letter system would operate given the multi-patent disputes such as occur in the telecoms sector. They asked that the Rules Committee consider this carefully.</p>	<p>Change recommended</p> <p>1. Change in Rule 207.2(a) into "defendant(s)" and Rule 207.2(b) into "applicant(s)"</p> <p>2. Add to Rule 207.2: "If there are more than one patent the protective letter shall be filed in the languages of all patents."</p> <p>3. Change Rule 207.3 into "defendant(s)". This will make sure one fee for one letter (even if more than one applicant, defendant, patent).</p>	<p>Changes agreed</p> <p>1. It was agreed to amend Rule 207.2(a) and (b) as proposed by WT.</p> <p>2. It was agreed to amend Rule 207.2 to refer to "<i>...in the language(s) of the patent(s)...</i>".</p> <p>3. It was agreed to amend Rules 207.3 as proposed by WT.</p>
Rule 207.2	10 – CMS	<p>This respondent believes that there should be an obligation to provide the information in Rule 207.1(g) to (i) to the extent that such information is available.</p> <p>It is difficult to see how this obligation could be enforced.</p>	<p>No change recommended</p> <p>It is up to the person entitled to the protective letter to defend himself as well as he feels need to.</p>	<p>Agreed: no change</p>
Rule 207.2	78 – PB	<p>This respondent believes that a protective letter may be filed in the language of the defendant's domicile as well as the language of the patent.</p>	<p>No change recommended</p> <p>This may result in many language letters. Also: the Court must understand the letter which is made sure if the language of the patent is to be used.</p>	<p>Agreed: no change</p>
Rule 207.2(b)	110 – CCBE	<p>It is proposed that the protective letter should contain all relevant information known to the applicant which may assist in the identification of an application for</p>	<p>No change recommended</p> <p>Taken care of by Rule 207.2(d) and (e).</p>	<p>Agreed: no change</p>

		provisional measures such as the patent number and proprietor and/or licensee.		
Rule 207.4	110 – CCBE	It is suggested that a simple provision be inserted into the Rules confirming that the protective letter has met formal requirements and informing the applicant of the number assigned. This seems to be sensible.	No change recommended The protective letter is just registered. No check on formalities after the receipt. Only at the time when a preliminary measure is called for, the letter will be looked at. It is the responsibility of the applicant to draft the protective letter in a formally correct way. See asterix (Form-sheet)	Agreed: no change
Rule 210.4	91 – FICPI-I	It is suggested that the following word should be added at the end of this rule: “but shall be given as soon as practicable thereafter in writing.”	No change recommended Sentence one says so. Oral decision only in addition.	Change agreed It was agreed to add wording to the effect of the proposal to clarify that, if an ex tempore oral decision is given, a written decision will still be provided.
Rule 211	7 – INTEL	This respondent believes that this rule provides too little guidance on how to exercise discretion to grant provisional relief . It is concerned that different local and/or regional courts will adopt divergent approaches. To promote consistency therefore and to reduce forum shopping and to discourage market-distorting practices this respondent recommends additional guidance should be given as to when injunctions should be granted. With the above comments in mind this respondent proposes the following amended Rule 211 (again with suggested amendments in bold):	No change recommended The RoP cannot and should not attempt to change or modify the standards set by Art. 62. I agree with Kevin's comment.	Change agreed It was agreed to reword Rule 211.3 to incorporate text based on Article 62(2), and the following was agreed: <i>“...the Court shall in the exercise of its discretion weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.”</i> It was also agreed that the Court should have regard to unreasonable delay.

	<p>“[]</p> <p>2. In taking its decision the Court may require the applicant to provide reasonable evidence and shall be satisfied with a high degree of certainty, that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent.</p> <p>3. In exercising its discretion and taking its decision on the Application for provisional measures, the Court shall, in addition to any matters submitted to it in accordance with Rules 206-210, weigh up the interests of the parties and in particular shall take into account:</p> <p>(a) the potential harm for either of the parties resulting from the granting or the refusal of the provisional measures;</p> <p>(b) whether damages and/or other monetary compensation would adequately compensate either party for the wrongful granting or refusal of the provisional measures;</p> <p>(c) any delay in seeking the provisional measures and whether this was justified, particularly in cases where the respondent/defendant has not been heard; and</p> <p>(d) the public interest in the granting of the provisional measures.”</p> <p>Similar comments made by 31 – LES,</p>	<p>1. The wording of Rule 211.2 corresponds exactly to the wording of Art. 62(4) ("sufficient degree of certainty")</p> <p>2. Rule 211.2 is an abbreviated version of Art. 62(2) which has to be applied by the Court:</p> <p>a) weigh up the interests of the parties</p> <p>b) in particular take into account the potential harm for either of the parties from the granting or the refusal of the injunction.</p>	
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		<p>30 – CIPA, 60 – AIPPI-J, 66 – BIA, 83 – COAL.</p> <p>These suggested amendments do <u>not</u> accord with Articles 62(2) and (4) in certain respects.</p>		
Rule 211.2	49 – GSMA	<p>This respondent formulates guidance in a similar way as follows with suggested amendments:</p> <p>“2. In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent. In this context sufficient degree of certainty means that evidence presented to the Court must be more likely than not to be persuasive.</p> <p>3. In taking its decision on the Application for provisional measures, the Court shall have the discretion to weigh up the interests of the parties. In the exercise of such discretion the Court shall take into consideration in particular if:</p> <p>(i) either party, or general public interest, would suffer irreparable or disproportionate harm as a result on such decision and/or</p> <p>(ii) damages and/or compensation to the applicant would appear to the Court to be a reasonable and achievable</p>	<p>No change recommended</p> <p>See above</p>	See above

		remedy.”		
Rule 211	25 – TEVA	<p>This respondent also believes there should be a general requirement of urgency for the grant of provisional measures.</p> <p>A similar comment is made by 34 – BLACK, 84 – BGMA, 97 – EGA, 99 – IPLA, 110 – CCBE</p> <p>A similar comment on a requirement for urgency is made by 86 – MAX which points out that although neither the Agreement nor Directive 2004/48 requires urgency as a requirement for granting a preliminary injunction such a requirement would not in fact be contrary to those provision and in fact ought to be the Rule.</p>	<p>No change recommended</p> <p>See above</p>	See above
Rule 211.1(b)	4 – AIPPI	<p>This respondent believes that a recall of allegedly infringing goods should not be granted as a provisional measure as it may cause disproportionate damage. An injunction to restrain future sales is sufficient.</p> <p>A similar comment is made by 93 – FFW</p>	<p>No change recommended</p> <p>Rule 211.1 does not allow a "recall of goods delivered to third persons". In conformity with Art. 62(3) of the Agreement and of Art. 9(1)(b) of the Enforcement Directive it allows "seizure" or "delivery up" of products" so as to prevent their entry into the market, or movement, within the channels of commerce".</p>	Agreed: no change
Rule 211.2 and 211.3	4 – AIPPI	<p>This respondent also wishes to reformulate these sub-rules as follows:</p> <p>“2. In taking its decision the Court shall be satisfied with a high degree of certainty that the Applicant is entitled to commence proceedings pursuant to</p>	<p>No change recommended</p> <p>See above.</p> <p>I agree with Kevin's comment.</p>	<p>Agreed: no change</p> <p>See above.</p>

		<p>Article 47, that the patent in question is not obviously invalid and that his right is being infringed, or that such infringement is imminent.</p> <p>3. In taking its decision on the Application for provisional measures, the Court shall weigh up the interests of the parties and in particular take into account the potential for harm for either of the parties resulting from the granting or refusal of the injunction as well as the public interest.”</p> <p>Similar comments made by 11 – SCOT, 15 – M&S.</p> <p>Again, the existing provisions of Article 211 have been taken from Article 62(2) and (4) of the Agreement.</p>		
Rule 211.2 and 211.3	12 – GOO	<p>This respondent also has a slightly different reformulation of these rules as follows:</p> <p>“2. In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a high degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent.</p> <p>3. 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 in particular to take into account the potential harm</p>	<p>No change recommended</p> <p>See above</p> <p>I agree with Kevin's comment</p>	<p>Agreed: no change</p> <p>See above.</p>

		<p>for either of the parties resulting from the granting or the refusal of the injunction, as well as the interests of third parties.”</p> <p>A similar comment is made by 34 – BLACK.</p> <p>Same comment as above.</p> <p>This conflicts with the wording of the Agreement.</p>		
Rule 211.2	10 – CMS	<p>This respondent suggests replacing “sufficient degree of certainty” with “an appropriate degree of certainty”.</p> <p>As above.</p>	<p>No change recommended</p> <p>See above</p> <p>I agree with Kevin's comment</p>	Agreed: no change
Rule 211.2	24 – LILLY	<p>This respondent points out, quite correctly, that the requirement to show that the patent in question is valid is not expressly included either within Article 62 of the Agreement or Article 9(3) of EC Directive 2004/48/EC and recommends that given the concern with the words “sufficient degree of uncertainty” the reference to validity should be removed.</p> <p>A similar comment is made by 58 – GSK</p> <p>This comment is correct in that there is no such express reference to validity but it was inserted for clarity on the basis that it is not possible to infringe an invalid patent.</p>	<p>No change recommended</p> <p>I agree with Kevin's comment</p>	Agreed: no change

Rule 211.2	13 – EPLAW	<p>This respondent makes a similar comment to those above in that it suggests, given the different traditions in the member states, the Rule should provide a non-exhaustive list of criteria to be considered when weighing the interests of the parties.</p> <p>Similar comments made by 21 – PUR who refers to likely unquantifiable loss by the patentee as a relevant factor and also the failure of a potential infringer to clear patent rights out of the way by way of a revocation action.</p> <p>A similar comment relating to the failure to revoke the patent in issue is made by 24 – LILLY, 36 – ABPI.</p> <p>A similar comment referring to different traditions in member states is made by 82 – HAS.</p>	<p>No change recommended</p> <p>Art. 62 defines the standards for using the Court's discretion exhaustively.</p> <p>The validity issue has to be taken into account legally by the Court in deciding on any order.</p>	
Rule 211.3	59 – QUAL	<p>This respondent believes that the current draft of this rule is entirely satisfactory. It believes that adding rules to limit access to judicial remedies on the basis of the fears of a particular class of patentees runs a risk of excluding meritorious patentees by the same provisions.</p>	Respondent support present text.	See above
Rule 211.4	41 – SWED	<p>This respondent believes that the potential for damage by the grant of preliminary injunctions is such that the Court should always order security and therefore it recommends replacing “may” with “shall”.</p>	<p>No change recommended</p> <p>See above</p>	<p>Agreed: no change</p> <p>See above.</p>
Rule 211.4	24 –	<p>This respondent believes that it may take some time to organise appropriate security</p>	No change recommended	Agreed: no change

	LILLY	and therefore if it is felt correct to grant an interim injunction that injunction should take effect immediately but lapse or be discharged if security is not given within a reasonable time determined by the Court.	<p>1. Security must be given in advance as a matter of principle.</p> <p>2. An exception may be granted by the standing judge in cases of extreme urgency (Rule 209.3).</p>	See above.
Rule 211.4	84 – BGMA	This respondent believes that appropriate compensation should also be paid to third parties such as public health funders who can incur considerable losses if provisional relief is improperly granted. This requires the Court to take into account the interests of third parties and/or the public interest pursuant to Rule 211.3.	<p>No change recommended</p> <p>In a civil procedure only the interests of the parties are at stake. Different in penal or administrative procedures.</p>	<p>Agreed: no change</p> <p>See above.</p>
Rule 212	12 – GOO	<p>This respondent wishes to reformulate this rule as follows:</p> <p>“1. The Court may only order provisional measures without the defendant having been heard in cases where giving the defendant advance notice would create the risk of additional and irreparable harm to the applicant. Rule 197 shall apply mutatis mutandis.</p> <p>A similar comment is made by 30 – CIPA who believes that the current rule is too lax and that ex parte measures would only need to be granted in “wholly exceptional cases”.</p>	<p>No change recommended</p> <p>Art. 62(5) is referring to Art. 60(5). Rule 212.1 and Rule 197 to which Rule 212.1 is referring use the wording of that provision.</p> <p>These standards of the Agreement are binding for the RoP.</p>	<p>Agreed: no change</p> <p>See above.</p>
Rule 212.2	110 – CCBE	1. This respondent suggests that in the notice of provisional measures in the event of an ex parte order additional information should be provided covering the consequences of failing to comply	<p>No change recommended</p> <p>1. The information is on the provisional measures. This will include the order with which the defendant had to comply</p>	<p>Agreed: no change</p> <p>See above.</p>

		with the order and also 2. setting out the defendant's right to request a review and the relevant time limit .	when they were taken. 2. Taken care of by Rule 212.3 and referrals there.	
Rule 212.3	13 – EPLAW	This rule cross-refers to Rule 197.3 which provides for a period of 10 days. Consistent with its earlier comment, this respondent believes this period is too short.	Change recommended See my Proposal to Rule 197.3	See above This has been increased to 30 days as recommended by WT.
Rule 212.3	30 – CIPA	This respondent believes that it should be made clear in this rule that in the event of a “review” the burden on the claimant should be to justify the grant of provisional measures at a full re-hearing and not upon the defendant to justify discharge of such measures.	No change recommended The burden of stating facts and the burden proof do not change in the different procedures. They follow from the material norm on which the relevant argument is based.	Agreed: no change It was agreed that no change was required.
Rule 213	13 – EPLAW	The comment is made that proceedings on the merits should only be necessary if the application for provisional measures was not contested pursuant to Rule 212. Therefore it suggests that the deadline for filing proceedings should expire only after the deadline set in Rule 212.3 which, as suggested above, should be extended.	No change recommended The requirement of an action on the merits (as prescribed by Art. 62(5) referring to Art. 60(8) and the time-limit of Rule 212.1 referring to Rule 197.3 for the request to review the order are two different things . See my comment on Rule 197 .	Agreed: no change As noted by WT, these relate to two different things.
Rule 213.2	16 – CSO	This respondent also believes that the order for compensation should be discretionary rather than mandatory.	Change recommended We should say " may ". See above to Rule 198.2 and Rule 213.2	Change agreed It was agreed to change the wording to “may” as recommended by WT.

<p>Rule 220.2</p>	<p>4 – AIPPI</p>	<p>The respondent refers to the apparent disagreement as to the meaning of “Court” in Article 73(2)(b)(ii) of the Agreement. However, for this respondent the meaning of the word is clear and sufficiently defined by Article 6(1) of the Agreement. The Court comprises both Court of First Instance and the Court of Appeal and so either may grant leave for appeal against a procedural decision pursuant to Rule 220.2. In the view of this respondent clarification is not required. However the respondent believes that a procedure for seeking leave from the Court of Appeal to appeal such a procedural order should be provided for and therefore it recommends that such procedure be brought within Rule 221 explicitly.</p> <p>Similar comments made by 7 – INTEL, 10 – CMS, 11 – SCOT, 12 – GOO, 14 – EPI, 15 – M&S, 19 – IPO, 21 – PUR, 24 – LILLY, 25 – TEVA, 28 – HUN, 29 – ERIC (who suggests further that the procedure under Rule 221 should apply to all procedural appeals and further there should be express provision for the expedition of procedural appeals), 31 – LES, 30 – CIPA, 33 – IP, 35 – P&G, 36 – ABPI, 40 – TAL, 49 – GSMA, 52 – EIP, 56 – INT, 58 – GSK, 59 – QUAL, 63 – JIPA, 74 – MICRO, 79 – VERTEX, 82 – HAS, 83 – COAL, 85 – PLUCK, 88 – RR, 91 – FICPI-I, 93 – FFW, 99 – IPLA, 110 – CCBE.</p> <p>A similar comment is also made by 41 – SWED who points to the last paragraph of the preamble and the reference to the Court of Appeal’s role in ensuring</p>	<p>Change recommended</p> <p>1. We should stick with the "compromise" found to repeat verbatim Art. 73(2)(b).</p> <p>The reason for this compromise is that the RoP cannot change the Agreement. Therefore the interpretation of Art. 73(2)(b) decides the question.</p> <p>2. The repetition of Art. 73(2)(b) must, however, be done completely. The present text</p> <p>a) forgets Art. 73(2)(b)(i) and</p> <p>b) says "decisions or orders" instead of "orders" (See below 220.2 re 28 HUN).</p> <p>Proposal for Rule 220.2</p> <p>"2. Other orders than those referred to in Rule 220.1 shall be subject to appeal together with the appeal against the decision, or, where the Court grants leave to appeal, within 15 days of the notification of the Court's decision to that effect."</p> <p>Note:</p> <p>1. Obviously all respondents proposing amendments to Rule 220 have the bifurcation issue in mind.</p>	<p>Note added to Rule 220.2</p> <p>The Committee was unable to agree on the meaning of “Court” in Article 73(2)(b)(ii), and whether or not leave could be granted by the Court of Appeal if refused by the CFI. This would be a matter for the Court of Appeal to determine.</p> <p>It was noted by some Committee members that procedural orders are capable of creating real injustice. Allowing leave to be granted only by the CFI would risk the Court of Appeal being denied the ability to exercise oversight.</p> <p>Other members of the Committee noted (1) that such oversight remained with the Court of Appeal deciding on the appeal over the final decision, (2) that Art. 73(2)(b)(ii) does not give any indication as to a double decision on leave to appeal (CFI, CoA) and (3) that giving a right to a double application for leave to appeal the manifold procedural orders would seriously hamper the speedy procedure of the CFI.</p> <p>The Committee agreed to add a note to Rule 220.2 to reflect its disagreement. KM will propose drafting so that procedure exists if the Court of Appeal decides that Art. 73(2)(b)(ii) is to be interpreted as to permit it also to grant leave to appeal.</p>
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		<p>that procedural orders are consistent across all divisions.</p>	<p>They should consider:</p> <ol style="list-style-type: none"> 1. They open the possible appeal with leave of the CoA to all procedural orders. 2. The divisions not likely to use bifurcation (e.g. London) and desiring that the other divisions should follow their example can grant leave for an appeal against any Art. 33(3)-order they take. Whether the CoA will limit the discretion of these other divisions will have to be seen. <p>2. Regarding a necessary change in Rule 220.1(c), see below Rule 220.2 re 28 HUN</p>	
Rule 220.2	43 VCI	<p>– This respondent supports the view the Court of First Instance only may give leave.</p> <p>A similar comment is made by 48 – GRUR.</p>	See above	See above
Rule 220.2	28 HUN	<p>– This respondent refers to the fact that Article 73(1) refers only to “a decision” and Article 73(2) refers to “an order”. Rule 220.2 refers both to “decisions” and “orders” and is therefore inconsistent with Article 73.</p> <p>Is this difference significant? Note the provisions of Rules 350 and 351.</p>	<p>Change recommended</p> <p>Art. 73 distinguishes, in para. 1 and 2, between decisions and orders (as Rules 350, 351 do).</p> <p>Rule 220.1(c) is not compatible with Art. 73(2)(a) (which it is trying to repeat) in using the words "decisions or orders" (instead of "orders"):</p> <p>Proposal:</p>	<p>Change agreed</p> <p>It was agreed to change to Rule in line with WT's proposals on use of “orders” and “decisions”.</p>

			<p>Delete the words "decisions or" in Rule 220.1(c).</p> <p>See above my Proposal for a reworded Rule 220.2 following <i>verbatim</i> Art. 73.</p>	
Rule 220.3	41 – SWED	<p>This respondent believes that it is essential for the Court of Appeal to hear appeals on infringement and validity issues together and therefore it suggests that this rule should be amended to state that such issues “shall” be considered together if requested by either party.</p> <p>A similar comment and suggested amendment is made by 90 – CSA</p>	<p>No change recommended</p> <p>The Court must have flexibility to decide from case to case.</p>	Agreed: no change
Rule 220.3	110 – CCBE	<p>This respondent suggests that it should be made clear that the normal position is that appeals shall be heard together unless there is a good reason.</p>	<p>No change recommended</p> <p>Hearing together may not be possible (different readiness for deciding)</p>	Agreed: no change
Part 4 Rule 220-243	1 – PDL	<p>It is pointed out, quite correctly, that the present draft of the Rules does not provide for the possibility to refer cases to the full Court of Appeal (Article 21(2) of the Statute).</p> <p>I agree that we should repair this omission.</p> <p>This response also raises the following detailed questions:</p> <ol style="list-style-type: none"> Does each panel of the Court of Appeal have the ability to refer to the full court? Is the full court obliged to accept 	<p>No change recommended</p> <ol style="list-style-type: none"> Art. 21(2) and 35(4) Statute are "self- executing". They do not need a repetition in the RoP to be operable. The RoP would have nothing material to add to Art. 21(2) and 35(3) Statute: <p>As to 1: Answered in Art. 21(2): The presiding judge of a panel of the CoA may refer the case.</p> <p>As to 2: Answered in Art. 21(2): The</p>	<p>Change agreed</p> <p>It was agreed to add provisions to set out the process for referrals to, the composition and appointment of the full Court of Appeal (CoA).</p> <p>It was agreed that:</p> <ul style="list-style-type: none"> the decision to refer a matter to the full court following a proposal by the presiding judge should be taken by the panel; the full CoA should consist of 10 (legal and technical judges), plus the

		<p>such a reference?</p> <p>3. Can the parties request a referral to the full court and if so is the panel obliged to decide such a request?</p> <p>4. Can the referral involve specific question or is it a referral of the full case and, if the former, so can the full court transfer a case back to the panel having decided a specific question?</p> <p>5. Should there be a provision for amicus briefs in the event of a referral to the full court?</p> <p>Reference is made to Article 35(3) of the Statute which sets out how decisions of the full Court of Appeal are to be taken. It is not clear to this respondent whether this Article requires a $\frac{3}{4}$ majority of the full court or a normal majority with a $\frac{3}{4}$ quorum of the full court. A question is also raised whether the full court comprises technically qualified judges as well as legally qualified judges.</p> <p>All of the above points are worthy of discussion by the Committee.</p>	<p>full Court must decide whether it is competent because it is a "case of exceptional importance and in particular when the decision may affect the unity and consistency of the case law of the Court". If this is not the case, the full Court does not accept the case.</p> <p>As to 3: Answered in Art. 21(2): No request of a party is provided for. The presiding judge acts ex officio.</p> <p>As to 4: Answered in Art. 21(2): The case is referred, not the question.</p> <p>As to 5: Depends from the <i>amicus curiae</i>-rule to be devised. Probably no difference to cases before other units of the CoA</p> <p>As to this question: Answered by Art. 35(3) Statute: "at least 3/4 of the judges comprising the full court". The "full court" (German "<i>Plenum</i>"; French: "<i>assemblée plénière</i>") consists of all judges of the CoA.</p>	<p>President of the CoA;</p> <ul style="list-style-type: none"> the judges should be appointed from the judges of the CoA by the President and the two CoA judges who sit in the Presidium; decisions should be taken by $\frac{3}{4}$ of the full CoA as required by Art 35(3) of the Statute. <p>A new Rule 238A has been added.</p>
Rule 221	4 – AIPPI	<p>This respondent recommends that 15 days for submitting reasons why an appeal should be heard is too short and not required by Article 73. It recommends a further additional period of 15 days for submitting reasons.</p>	<p>No change recommended</p> <p>A cost question, already argued before the JR, is not difficult to address. A short time-limit is adequate.</p>	<p>Agreed: no change</p>

Rule 222	10 CMS –	This respondent wishes the wording of this rule to be strengthened to the effect that new submissions will normally be disregarded . Otherwise it feels there is a significant risk of a re-trial . The discretion should expressly be stated to only be exercised in exceptional circumstances.	<p>Change recommended</p> <p>1. To the role of the CoA (different from the role of the London Appeal Court), see my comment on Rule 118.7 and Rule 350 re 21 PUR, above: The CoA must contemplate the whole file (facts, arguments), because the CFI will be dealing only with the facts and arguments necessary for its decision.</p> <p>2. Therefore, there will be a limited "re-trial", limited because of Rule 222.2.</p> <p>But WT-Proposal to delete Rule 222.2(b) as being superfluous:</p> <p>a) From a legal standpoint there should be no difference between "relevant" and "highly relevant". Relevant means: It can influence the decision of the Court. Either it does or it does not.</p> <p>b) If the new submission is not relevant it must be disregarded by the Court anyway – not because it is late but because it is not relevant.</p>	<p>Small change made</p> <p>It was agreed to amend Rule 222.2(b) to refer to “the relevance of the new submissions...”.</p>
Rule 222	21 PUR –	This respondent also wishes to avoid a re-trial with new facts and evidence and suggests that in addition to the requirements of Rule 222.2(a) to (c) being met the Court should also consider that it is in the interests of justice for new evidence etc. to be admitted .	<p>No change recommended</p> <p>If relevant new submissions fulfil the requirements of (a) and (c) it is in the interest of justice to admit them.</p>	<p>Agreed: no change</p>

Rule 222	33 – IP	<p>This respondent also believes that there should be a clearer presumption against new facts and evidence being introduced at the appellate stage and suggests that the Rule is amended to read as follows:</p> <p>“2. Requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance shall be disregarded by the Court of Appeal unless the party seeking to lodge new submissions is able to justify that the new submissions could not reasonably have been made during proceedings before the Court of First Instance. The Court may also take into account –</p> <p>(a) whether the new submissions are highly relevant for the decision on the appeal,</p> <p>(b) the position of the other party regarding the lodging of the new submissions.”</p>	<p>No change recommended</p> <p>The proposal is materially identical with Rule 222.2. Item (a) repeats the present (b) which should be deleted. See above.</p>	See above
Rule 222	48 – GRUR	<p>This respondent believes that Rule 222 is well balanced and would reject any effort to raise the threshold for new statements of fact etc.</p>	Respondent supports the present text.	See above
Rule 222	42 – ADIPA	<p>This respondent takes a different view from most others and suggests that new submissions etc. should be allowed where relevant for the decision on the appeal.</p>	<p>No change recommended</p> <p>See Art. 73(4) of the Agreement</p>	Agreed: no change

		A similar comment is made by 6 – KAS.		
Rule 223.3 and 223.5	12 – GOO	<p>This respondent suggests the following amendment:</p> <p>“3. Rule 221.3 shall apply <i>mutatis mutandis</i>. The Court of Appeal shall decide on the Application without delay. When deciding on the Application for suspensive effect relating to an injunction, the Court of Appeal shall in particular take into account whether the Court of First Instance has duly exercised its discretion under Rules 118.1A and 118.2.”</p> <p>“5. Applying for suspensive effect shall, until the Court decides the application, have suspensive effect.”</p>	<p>No change recommended</p> <p>1. The issue of the respondent is taken care of in cases of "extreme urgency" by Rule 223.4 (standing judge)</p> <p>2. If the case is not so urgent, the application for suspensive effect will be handled by the single judge (Rule 223.3 first sentence referring to Rule 221.3) who will decide "without delay" (Rule 223.3 second sentence)</p>	Agreed: no change
Rule 223.3	90 – CSA	<p>This respondent also believes that there should be suspensive effect of a decision on the merits in infringement proceeding if it is “likely” that the relevant claim will be held to be invalid on any ground by a final decision in an invalidity proceeding, either already pending or not.</p>	<p>No change recommended</p> <p>This is a general provision for all appeals.</p> <p>The standard for Bifurcation cannot be different from Rule 118.3</p>	Agreed: no change
Rule 223.4	84 – BGMA	<p>This respondent believes that all parties should be allowed to be heard on an application for suspensive effect.</p>	<p>No change recommended</p> <p>The application will of course be served on the other party which may explain its view. There may be the urgent cases of Rule 223.4 where the Court will decide before hearing the other party or hearing the other party informally (phone, email). No need to</p>	Agreed: no change

			regulate.	
Rule 223.5 – NEW	7 – INTEL	<p>This respondent also suggests a new rule as follows:</p> <p>“223.5 Applying for suspensive effect shall until the Court decides the application have suspensive effect”.</p> <p>A similar comment is made by 49 – GSMA.</p>	<p>No change recommended</p> <p>See above</p>	Agreed: no change
Rule 225	12 – GOO	<p>Referring to Article 74(3) of the Agreement this respondent believes that there should be greater flexibility for expediting Court of Appeal decisions particularly where a party is appealing some interim or procedural order and the main proceedings are to continue pursuant to Article 74(3).</p> <p>With this in mind this respondent proposes the following amendment:</p> <p>“The *Statement of appeal shall contain</p> <p>(a) the name of the appellant and of the appellant’s representative, []</p> <p>(f) any request by the appellant for the case to be expedited along with reasons in support thereof.”</p> <p>“236.</p> <p>1. The *Statement of response shall contain</p> <p>(a) the names of the respondent and the</p>	<p>No change recommended</p> <p>Respondent seeks expedition of appeals in cases where the procedure before the CFI is going on during the appeal (Art. 74(3)).</p> <p>1. This is to a certain extent taken care of by the possibility of applying for a suspensive effect (see above for that speedy procedure). If the appeal against the order is really important, the CoA will grant that effect.</p> <p>2. There is no such thing as a high-speed-track in the procedures of the CoA.</p>	Agreed: no change

		<p>respondent's representative, [...]</p> <p>(e) any request by the respondent for the case to be expedited along with reasons in support thereof.”</p> <p>“239.</p> <p>3. Where either party has sought expedition, the judge-rapporteur shall determine that application and, if expedition is granted, amend the periods specified in Rules 224 to 238.”</p>		
Rules 232.2 and 233.2	110 – CCBE	<p>It is suggested that in both these rules the word “may” should be replaced by “shall” in order to be compatible with Article 56(2) of the Agreement.</p>	<p>Change recommended</p> <p>Proposal:</p> <p>Change the last sentence of Rules 232.2 and 233.2 from "may" into "shall".</p>	<p>Change agreed</p> <p>It was agreed to change these rules as proposed by WT.</p>
Rule 239.2	5 – KOS	<p>It is suggested by this respondent that there should not be a delay of two months where the appeal concern provisional measures.</p> <p>This appears to be sensible.</p>	<p>Change recommended</p> <p>Proposal:</p> <p>Rule 239.2 second sentence should start with the following words: "Except for appeals against the orders mentioned in Rule 220.1(c) and 220.2, at least ..."</p>	<p>Change agreed</p> <p>It was agreed to amend the Rule as recommended by WT.</p>
Rule 248.1	21 – PUR	<p>This respondent believes that the test is too strict and recommends the addition of the word “reasonably” so that the relevant portion of the Rule reads: “except where such objection could not have reasonably been raised...”</p>	<p>No change necessary</p> <p>"Reasonably" is a limit to vague.</p>	<p>Agreed: no change</p>

Rule 252	36 ABPI	– This respondent points out that there is a missing step namely recording the application in the Register after examination. This appears to be correct.	No change recommended See Rule 253.1	Agreed: no change
Rule 252.2	110 CCBE	– This respondent again suggests that “may” should be replaced with “shall” to ensure compatibility with Article 56(2) of the Agreement.	Change recommended Proposal: Change the last sentence of Rule 252.2 from “may” into “shall” .	Change agreed It was agreed to change the rule as proposed by WT.
Rule 254.1(a)	110 CCBE	– This respondent suggests that the words “shall not contain any reasons” be replaced by the words “need not contain any reasons” .	No change recommended Need for a clear rule. No arguments on grounds for rehearing.	Change agreed It was agreed to reword this as “It need not contain reasons”. The Committee considered that the Court should have discretion to add reasons (e.g. to deter unmerited/frivolous applications).
Rule 260.2	99 IPLA	– It is suggested that the obligation on the Registry to notify divisions of actions concerning the same patent should not be limited to the same party but should extend to all cases involving the same patent . Defendants in such actions may well have an interest in applying under Rule 340 for such cases to be joined and heard together, but they need some means of finding out about the existence of other cases.	No change recommended If there are different parties the arguments and the infringement objects may be different. Need to keep this Rule clear-cut.	Change agreed It was considered that it would be helpful for different divisions to be aware of actions concerning the same patent, even if different parties are involved. It was agreed to amend Rule 260.2 accordingly.
Rule 261	91 FICPI-I	– Consistent with an earlier comment on Rule 4 this respondent suggests that there should be express provision for an automatic electronic receipt to be	Change to be discussed with the IT-preparatory group . If feasible, such an automatic receipt would be welcome	Change proposed A change has been made to Rule 4 to provide for an automatic receipt.

		issued.		
Rule 261	110 – CCBE	This respondent assumes that there is no time during a day after which a pleading or other document is deemed to be received on the next working day. If this is not correct, it believes that the Rule should make clear what time marks the boundary of the working day.	Change recommended Application of GMT+ 1.	Change agreed It was agreed that the time should be the time of place of receipt.
Rule 262	12 – GOO	Minor amendments to this rule are suggested as follows: “Without prejudice to Rule 207.6 written pleadings, written evidence including exhibits, the dates set for oral hearings, decisions and orders made by the Court shall be available promptly to the public for on-line consultation, unless a party requests that certain information be kept confidential and the Court makes such an order.”	Only typo to be corrected. Otherwise no change recommended 1. "Exhibits" are included in "evidence" 2. "Dates set for oral hearing" are <i>per se</i> part of the Register (part of an "order"). 3. "lodged at" is a typo. "made by" is correct 4. "promptly" is superfluous.	Small change made It was agreed to add "...or made by..." to Rule 262.1 in line with WT's third comment.
Rule 262	13 – EPLAW	1.It is suggested that public accessibility to the register should not occur prior to the delivery of the relevant documents upon the relevant party and also prior to any application pursuant to Rule 262.2. 2.It is further suggested that there should be a time limit for an application pursuant to Rule 262.2.	No change necessary 1. A party will ask for confidentiality only regarding contents of its own submissions , not that of the other party. 2. No time-limit in the Agreement.	Change agreed It was agreed that there should be a 14 day delay before making written pleadings and evidence available online. This would give parties other than the lodging party time to make any application for confidentiality.
Rule 262 and 313	59 – QUAL	This respondent points out that it is regularly required as a third party to consent to its highly confidential information being disclosed to a court. It believes that these rules do not	We need a discussion on public access WT-Proposal:	See above

		<p>adequately protect the interests of third parties and that third parties should be allowed to intervene where confidentiality obligations are being considered by the Court.</p> <p>This may be difficult to achieve. The onus probably should be on the party seeking a confidentiality order to ensure that it is satisfactory to its suppliers and to represent the suppliers' views or other third-party views before the Court.</p>	<p>1. Any party of the proceedings may ask that the contents of a specified extra submission or specified document shall be transmitted by the Registrar to the "confidential part of the register". It shall not be available to the public without an application (see 2). But it will be available to the other parties of the case</p> <p>2. If another person (not party to the case) wants access to a part of that register, it should apply to the Court. The JR will decide whether the item in the "confidential part of the register" shall be made public, because there is no reasonable interest (anymore) in keeping it confidential.</p>	
Rule 263	12 – GOO	<p>Further minor amendments have been suggested to this rule as follows:</p> <p>"1. A party may at any stage of the proceedings apply to the Court for leave to amend its case, including adding a counterclaim. Any such application shall explain why such change or amendment was not included in the original pleading.</p> <p>[...]</p> <p>3. Leave to limit a case unconditionally shall always be granted."</p>	<p>No change recommended</p> <p>No deletion of (2) (if that is suggested)</p> <p>No: That para. refers to the unconditional limitation of the claims of the action = partial withdrawal of the action.</p>	<p>Change agreed</p> <p>It was agreed to permit the Court to reconsider fees already paid in light of an amendment.</p>
Rule 263	36 – ABPI	<p>This respondent suggests that since a change of claim or an amendment to the case may have cost consequences that there should be provision for the Court when granting leave to also make a costs</p>	<p>No change recommended</p> <p>The cost order is part of the decision on the merits, Rule 118.6.</p>	<p>Agreed: no change</p>

		order.		
Rule 263	99 – IPLA	This respondent suggests that the Court should have the power to make a costs decision resulting from an amendment to a party's case.	No change recommended 1. No additional court fee 2. Parties's costs are taken care of in the cost-procedure.	Agreed: no change
Rule 264	91 – FICPI-I	This rule provides for the possibility of a hearing to take place by telephone or videoconference. In view of this it is suggested that Rules 105 and 106 should apply mutatis mutandis. This seems sensible.	Change recommended Proposal: Add to Rule 264: Rules 105 and 106 should apply mutatis mutandis. But see suggested changes there.	Change agreed It was agreed to amend the Rule as recommended by WT.
Rule 266	91 – FICPI-I	It is proposed to replace the word “order” in paragraphs 3, 4 and 5 with the word “request”. This appears to be correct.	Change recommended I agree with Kevin's comment. Also delete "of" in the last line of Rule 266.1	Change agreed It was agreed to amend the Rule as recommended by WT.
Rule 266.5	4 – AIPPI	This respondent suggests deletion of the words “unless otherwise decided by the Court” since proceedings must be stayed on making a reference to the CJEU in order to be consistent with Union law.	No change recommended 1. Art. 267 TFEU does not order a stay. 2. Normally, the Court will stay, because the reference of the question to the ECJ must be necessary for deciding the case. 3. Exceptions: There may be certain protective measures necessary, or parts of the case do not depend on the answer of the ECJ.	Agreed: no change

Rule 266.5	44 VAN –	<p>1. This respondent believes that where a ruling of the CJEU is sought the Court must stay the proceeding and therefore the wording “unless otherwise decided by the Court” should be deleted.</p> <p>2. This respondent also points to the recent decision of the CJEU in case C-414/11 to the effect that all substantive law issues arising under the TRIPs Agreement are within the exclusive competent of the European Union pursuant to Article 3(1)(e) TFEU.</p>	<p>No change recommended</p> <p>1. Proposed deletion: See above</p> <p>2. Important decision. Consequences</p> <p>a) All TRIPs-Rules are subject to Art. 267 TEUF (referral)</p> <p>b) No subjective rights for individuals out of TRIPs (practice of the ECJ).</p> <p>But no consequences for the RoP.</p>	<p>Agreed: no change</p>
Rule 270.3	99 IPLA –	<p>1. This respondent suggests that this rule should be amended to read as follows:</p> <p>“For the purpose of Rules 270 to 275 the term statement of claim shall, where appropriate, mean all originating proceedings as referred to in Article 32 of the Agreement”</p> <p>2. This seems to be sensible and a similar amendment should also probably be made in Rule 14 (language of proceedings).</p>	<p>Change recommended</p> <p>1. Proposal:</p> <p>Change Rule 270.3 as follows</p> <p>“For the purpose of Rules 270 to 275 the term statement of claim shall mean all claims starting actions as referred to in Article 32(1) of the Agreement”</p> <p>2. No change in Rule 14 (dealing with infringement actions). But all Rules on other actions refer to Rule 14.</p>	<p>Change agreed</p> <p>It was agreed to amend the Rule in line with the recommendation by WT.</p>
Rule 271	9 PHIL –	<p>This respondent believes that this rule is not in conformity with Regulation number 1393/2007 (service of documents). It suggests that if the Statement of Claim is not in a language understood by the recipient or a language of his residence then a translation into one</p>	<p>No change recommended</p> <p>Rule 271 is part of Section 1 "Service between the Contracting Member States or by Agreement"</p> <p>The UPC is for the CMS a national</p>	<p>Change agreed</p> <p>It was noted that if a Defendant cannot understand a statement of claim, he is entitled to a translation under the Service Regulation. The CJEU has</p>

		<p>such language should be provided.</p> <p>See also the comment of 13 – EPLAW with respect to Rule 6.</p>	<p>court Art. 1(2), 21 of the Agreement). In this contractual relationship Regulation number 1393/2007 (service of documents) is not applicable.</p> <p>(See discussion with the Commission, Annex II.2 and my comments there)</p>	<p>provided guidance on what is sufficient.</p> <p>It was agreed that the Rule should allow for a translation to be provided of the Statement of claim and the information under Rule 13.1(a) to (p) following a request in accordance with the Service Regulation. Time should be suspended while the translation is provided.</p>
Rule 271.2	14 EPI –	<p>It is pointed out that the ability to serve proceedings upon professional representatives pursuant to Article 134 EPC may not work since the current EPO practice is not to update information on representatives after the end of the opposition period or finalisation of opposition proceedings.</p> <p>This needs to be discussed.</p>	<p>This should be clarified by and discussed with Eskil Waage.</p>	<p>Change agreed</p> <p>This was discussed with Eskil Waage.</p> <p>The Committee agreed to amend Rule 271.3 (ex 271.2) to refer to appointed representatives as listed in the registers of the patent offices of Contracting Member states (which may be more up to date).</p>
Rule 271.2(b)	6 KAS –	<p>It should be stated expressly that the “representative” in this rule is a representative within the meaning of Article 48 of the Agreement.</p>	<p>No change recommended</p> <p>This follows from Rule 8.</p>	<p>Agreed: no change</p>
Rule 271.4(c)	5 KOS –	<p>This respondent queries the position if the prosecuting patent attorney law firm ceases to exist.</p>	<p>This should be clarified by and discussed with Eskil Waage.</p>	<p>See above</p>
Rule 271.5	30 CIPA –	<p>It is suggested that reference to GMT +1 could create confusion as it does not allow for daylight-saving changes. It is preferable to refer to a specific time at a specific location as the deadline for service e.g. 4pm in Paris (as the site of the central division).</p>	<p>No change recommended</p> <p>GMT+1 is clear (internationally known)</p> <p>No stop at 4 for electronic or fax transmittal. The day has 24 hours.</p>	<p>See note to Rule 261 (110 – CCBE)</p>

Rule 271.5(a)	43 VCI	– It is suggested that the qualification: “unless it has failed to reach the addressee” should also apply to this paragraph as to (b).	No change recommended 1. Regarding fax see Rule 272.2 2. Regarding electronic messages: “sent” means successfully sent. If message is electronically refused, it is not “sent”.	Agreed: no change
Rule 271.5(b)	16 CSO	– This respondent says that the Rules generally do not deal with a wide variety of possible failures to effect service. I think it is impossible to address each possibility. It is for this reason that we have Rule 275.	No change recommended I agree with Kevin's comment.	Agreed: no change
Rule 272	105 AICIPI	– It is pointed out that the provisions of Rule 272.2 should apply equally when service by electronic means has failed for some reason.	No change recommended See Rule 271.5(a) – 43- VCI, above	Agreed: no change
Rule 272.3	90 CSA	– This respondent suggests that this rule should also contain a reference to failure of electronic service.	No change recommended See above	Agreed: no change
Rule 273	90 CSA	– This respondent suggests that this rule, in line with the heading of section 2, should be limited to service outside the contracting member states and should not apply to defendants who have simply not provided an electronic address for service. This seems to be correct.	No change recommended If the defendant has his seat outside the contracting member states 1. he may have given an electronic address 2. he may be served within the contracting member states because he has an address for service there under Rules 270 and 271.	Agreed: no change

			<p>These cases must be excluded from Section 2. Also the alternative methods of Section 3.</p> <p>Only if there is no exclusion of this kind the question arises how to service outside the contracting member states.</p> <p>Therefore, Rule 270.1 should stay as it is.</p>	
Rule 274.1(iii)	13 – EPLAW	<p>Is it suggested that it is unclear whether the reference to “the Registry” means the Registry established at the seat of the Appeal Court (Article 10) or a sub-registry. Clarification, it is suggested, is desirable.</p> <p>It seems clear pursuant to Rule 3 that this expression will include any relevant sub-registry.</p>	<p>Change is suggested</p> <p>1. Registry would mean Luxemburg (not so strong with diplomatic channels).</p> <p>2. Better application of Rule 3: Would open the state where the division (with its sub-registry) is located (Kevin's suggestion).</p> <p>Proposal:</p> <p>Change: "in which the relevant Registry (Rule 3) is situated".</p>	<p>Change agreed</p> <p>It was agreed to amend the Rule in line with WT's proposal.</p>
Rule 278.1	16 – CSO	<p>This respondent suggest an amended rule as follows:</p> <p>“As soon as practicable after written pleadings have been received at the Registry, the Registry shall serve the pleadings and any other document lodged with the pleadings on the other party by means of electronic communication, except if the pleading contains a request for ex parte proceedings or an application for an order that certain</p>	<p>Change recommended</p> <p>The proposal deals with three different things</p> <p>a) ex parte,</p> <p>b) exclusion from public access,</p> <p>c) restriction to certain persons.</p> <p>Only in case a) the other side should</p>	<p>Change agreed</p> <p>It was agreed to amend the Rule in line with WT's proposal.</p>

		information should be excluded from public access or restricted to certain named person.”	not get the document. Case b) is a matter for Rule 262 (see my comments there). Case c) is part of Rule 196.1 second sentence (to which Rule other Rules refer). Proposal: "except pleadings containing a request for ex parte proceedings."	
Rule 286	13 – EPLAW	1. The reference to “ Swedish Patent Attorneys ” is queried. 2. It further suggests that the definition of “lawyer” has been harmonised according to Directive 98/5 EC. A similar comment is made by 40 – TAL, 85 – PLUCK.	Change recommended 1. The " Swedish hybrid " is a special case: (1) "Jurist" (law degree) (2) authorisation (3) authorisation accepted by a national court. Part (3) is missing in the present text. It would bring the "hybrid" close to Art. 48(1). Proposal: ... State which authorisation is accepted by the courts of that state." 2. Reference to Directive 98/5 EC is advisable , since it is EU law (I agree with Kevin) Proposal: Rule 286.1: ... lawyer within the meaning of Art. 1 of Directive 98/5/EC	Change agreed This Rule and the comments raised were considered carefully by the Committee. A number of proposals were debated to address the concerns raised about the specific mention of jurists authorised by the Swedish Patent Attorneys Board, and of other patent attorneys’ ability to act before the Court. After discussion, it was agreed to remove the specific mention of Swedish jurists and to add a reference to Article 1 of Directive 98/5/EC. A note would be added to the Rule that the issue remains to be dealt with.

Rule 286	6 KAS –	<p>1. This respondent believes that the reference to Sweden be deleted. There should not be the possibility of a non-lawyer becoming a representative.</p> <p>2. It is further suggested that the administrative committee should maintain a list of all representatives pursuant to Article 48 and that all that is required before the Court is a reference to that list.</p> <p>A similar comment is made by 90 – CSA.</p>	<p>No change recommended</p> <p>1. Sweden: See above</p> <p>2. List: See Rule 286.2, last sentence. Not necessary to tell the Register where to find the certificate previously lodged.</p>	See above
Rule 286	14 EPI –	<p>1. This respondent believe that the reference to Sweden is exceptional and that the expression “or equivalent body in a contracting member state” is vague and should be deleted.</p> <p>2. The respondent also refers to EU Directive 98/5 as establishing all relevant qualifications.</p> <p>Similar comments made by 20 – APEB, 108 – AAPI.</p> <p>Using EU Directive 98/5 as part of the definition is a very helpful suggestion but we still have to deal with the Swedish problem.</p>	<p>No change recommended</p> <p>See above</p>	See above
Rule 286	15 M&S –	<p>This respondent, a firm of UK patent attorneys, believes that all European patent attorneys should be authorised to practice before all court of the unitary patent system in view of the requirements for registration as European patent</p>	<p>No change recommended</p> <p>This would be contrary to Art. 48(1) (lawyer) and 2 (certain European patent attorneys)</p>	See above

		<p>attorneys. This, it is claimed, is a consistent qualification. At the very least, it is proposed, “Patent Attorney Litigators” should be so authorised.</p> <p>No definition is offered for the term “Patent Attorney Litigators”.</p>		
Rule 286	17 – UKPAT	<p>This paper from eight firms of UK patent attorneys makes a number of points in connection with the rules for representation.</p> <p>1. First it believes that many UK qualified patent attorneys (qualification is determined by national examination) would also qualify as “lawyers” within Article 48 of the Agreement since these UK registered patent attorneys hold an IPLC (Intellectual Property Litigation Certificate) or a HCLC (Higher Courts Litigation Certificate) both of which entitle such patent attorneys to represent clients in UK courts. Thus, according to this group, Rule 286 should make it clear that patent attorneys holding the above additional qualifications in the UK and in other countries would qualify as representatives within Article 48(1).</p> <p>2. The group also deplore the reference to the Swedish Patent Attorneys Board as well as the reference to “law degree (juris)” which will simply create uncertainty as to the meaning of “lawyer”.</p> <p>Therefore this group propose the following amended Rule 286.1:</p> <p>“A representative pursuant to Article</p>	<p>No change recommended</p> <p>1. They are no "lawyers" (Directive)</p> <p>2. See above</p>	See above

	<p>48(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practice before a court of contracting member states issued by a body authorised by that member state to issue such certificates. In subsequent actions the representative may refer to the certificate previously lodged.”</p> <p>3. It is pointed out that in the UK the body authorised to issue relevant certificates are IPReg for registered patent attorneys, the Solicitors Regulatory Authority or the Bar Standards Board for respectively solicitors and barristers.</p> <p>If the proposal to refer to Directive 98/5 is adopted then this attempt to qualify as a “lawyer” fails.</p> <p>4. This group then considers representation pursuant to Article 48(2). This applies to European patent attorneys satisfying Article 134 of the EPC and who have a European Patent Litigation Certificate or other appropriate qualification. The group believes that the European Patent Litigation Certificate will not be available before the coming into force of the Agreement and therefore it is important that other “appropriate qualifications” should be clarified in advance of the Agreement coming into force so that suitably qualified EPAs are entitled to act as representatives. They recommend that the following courses should satisfy this requirement: the CEIPI diploma in European patent litigation, the Haagen course, the Nottingham Law</p>	<p>3. See Art. 1(3) of the Directive 95/5. That is covered by the proposed reference to Art. 1 Directive</p> <p>4. That is the field of competence of another sub-committee of the</p>	
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		<p>School course or equivalent in other countries. The Administrative Committee should collect a definitive list of such qualifications.</p> <p>5. In addition to the above taught courses this group also believes that other EPAs which have sufficient practical experience of conducting proceedings before the EPO should also be entitled to qualify pursuant to Article 48(2) and they suggest that an EPA who has conducted at least five opposition proceedings at the EPO should be suitably qualified.</p> <p>In the light of the above they suggest an amended Rule 286.2 as follows:</p> <p>“A representative pursuant to Article 48(2) of the Agreement shall lodge at the Registry the European Patent Litigation Certificate issued by a body providing training and examination according to a syllabus defined by the Administrative Committee or evidence that he has appropriate qualifications as defined by the Administrative Committee to represent a party before the Court. In subsequent actions the representative may refer to the certificate or other evidence previously lodged”.</p> <p>A similar comment is made by 23 – W&R.</p>	<p>Preparatory Committee.</p> <p>5. See above</p>	
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Rule 286	30 – CIPA	<p>This respondent, which represents all Registered Patent Attorneys (RPAs) in the UK, has submitted similar representations to those set out above, i.e. with a view to qualifying RPAs with a litigation certificate in the UK as “lawyers” within the meaning of Article 48(1) of the Agreement. Whilst they welcome the reference to Sweden as widening the definition of lawyers for the purposes of the Rule they believe that it may have an adverse affect on UK RPAs in that they are excluded by the lack of a specific to them in the definition of “lawyer”. Therefore this respondent has proposed the following alternative definitions of Rule 286.1:</p> <p>“1. “Lawyers” in Article 48(1) of the Agreement shall mean persons belonging to a group on the list at Schedule 1 to this Rule. A representative pursuant to Article 48(1) of the Agreement shall lodge at the Registry a certificate that he is such a</p>	<p>No change recommended</p> <p>See above</p> <p>Directive 95/5 Art. 1</p>	See above

	<p>person (and) is authorised to practise before a court of a Contracting Member State. In subsequent actions the representative may refer to the certificate previously lodged.</p> <p>Schedule 1</p> <p><u>Sweden</u></p> <p>Persons possessing a law degree (jurist) who are authorised by the Swedish Patent Attorneys Board or the Swedish Bar Association.</p> <p><u>United Kingdom</u></p> <p>Solicitors, Barristers and Registered Patent Attorneys regulated by the Legal Services Board.”</p> <p>The respondent suggests that the above schedule should be supplemented in the case of each contracting member state.</p> <p>An alternative proposal for the definition of lawyer in Rule 286.1 is as follows:</p> <p>“1. A representative pursuant to Article 48(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practise before a court of a Contracting Member State. A list of bodies authorised to issue such certificates shall be maintained by the Administrative Committee and made publicly available. In actions the representative may refer to the</p>		
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	<p>certificate previously lodged.</p> <p>1A. Lawyers within the meaning of Article 48(1) of the Agreement are also persons possessing a law degree (jurist) who are authorised by a body contained in a list of bodies maintained by the Administrative Committee and made publicly available. They shall lodge a certificate evidencing such authorisation. In actions the representative may refer to the certificate previously lodged.”</p> <p>Again, both of the above proposals fail if reference to Directive 98/5 is adopted.</p> <p>It is suggested by the respondent that initially the Preparatory Committee should prepare a list of all bodies that can issue certificates throughout the member states. In addition to the above proposal of qualifying as a representative for the purposes of Article 48(1) of the Agreement, this respondent also proposes that UK RPAs who have suitable litigation experience should be grandfathered into Article 48(2). Such suitable experience, it is alleged, would include all UK national litigation certificates, a law degree at bachelor's or master's level or extensive experience of EPO opposition and appeal proceedings. It is suggested that such grandfathering should be permanent or (less preferably) could be time limited to allow for completion of the approved European Patent Litigation Certificate, which is not likely to be available when the Court</p>		
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		<p>becomes operative.</p> <p>A similar comment is by made 57 – CNF.</p> <p>Similar comments are made and amended Rule 286.1 proposed by 73 – FICPI-UK</p>		
Rule 286 and Article 48(1)	57 – CNF	<p>This respondent points out that the word “court” in this rule and in Article 48 is not defined and are therefore asks whether the expression is apt to cover not only ordinary civil courts but also specialist courts such as the German Federal Patent Court. This difficulty will probably be overcome if the suggestion to include a reference in Rule 286 to EU Directive 98/5 is taken up.</p>	<p>Art. 48(1) means a general court.</p> <p>Additionally: Art. 1 Directive 95/5</p>	Agreed: no change
Rule 287	17 – UKPAT	<p>The UK group of patent attorneys also criticise Rule 287 and in particular Rule 287(6) because certain patent attorneys (including UK registered patent attorneys) fall into the categories both of lawyers (for the reasons explained above) and also “patent attorneys”. Also they again deplore the reference to the Swedish Patent Attorney Board or equivalent. According to the group the expression “patent attorney” as used in Article 40A is really intended to cover non-qualified patent attorneys as opposed to patent attorneys who are qualified to represent either under Article 48(1) or 48(2). With all this in mind they suggest the following amended Rule 287:</p> <p>“1. Where a client seeks advice from a person entitled to represent him before</p>	<p>Change recommended</p> <p>Proposal WT:</p> <p>Rule 287.6: "The expression lawyer" shall mean a lawyer according to Art. 1 of Directive 95/5 EC who is professionally instructed to give advice."</p> <p>Change consequential to Proposal to Rule 286.1</p>	<p>Change agreed</p> <p>It was agreed to amend the Rule in line with WT’s proposal.</p>

	<p>the Court under Article 48(1) or (2) of the Agreement (the Representative) in a professional capacity whether in connection with proceedings before the Court or otherwise....before the centre.</p> <p>2. This privilege applies also to communications between a client and the Representative employed by a client who is instructed in a professional capacity to advise on patent matters.</p> <p>3. This privilege applies also to communications between a representative and a patent attorney assisting the representative according to Article 48(4) of the Agreement. This privilege extends to the work product of the representative (including communications between representatives employed in the same firm or entity or between representatives employed by the same client (and to any record of a privilege communication).</p> <p>5. This privilege prevents the representative and his client from being questioned or examined about the contents or nature of their communication.</p> <p>6. This privilege may be expressly waived by the client.</p> <p>7. The expression “patent attorney” shall include any person who is not entitled to be a representative but is entered on either an official national</p>		
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		<p>register in the contracting member state in which he practices as being entitled to give legal advice on the prosecution or enforcement of patents or the list kept by the European Patent Office pursuant to Article 134(1) of the European Patent Convention.”</p>		
Rule 287	21 – PUR	<p>This respondent recommends that, in the interest of certainty, these rules should clarify that they apply to advice regardless of where given and regardless of the jurisdictional qualification of the lawyer or patent attorney.</p> <p>A similar comment is made by 60 – AIPPI-J who suggest the addition of the following words:</p> <p>“These rules shall apply to advice no matter where it was given and regardless of the jurisdiction or the qualification of the lawyer or patent attorney.”</p> <p>A similar comment is made by 63 – JIPA.</p> <p>It is believed that the current drafting is wide enough to cover these points but further express wording could be added.</p>	<p>No change recommended</p> <p>The Rule refers to persons not to the place where they give advice.</p> <p>I agree with Kevin's comment.</p>	<p>Agreed: no change</p>
Rule 287	43 – VCI	<p>It is suggested that the provisions of Rule 287 should be expressed to be independent of representation before the UPC.</p> <p>Again this is probably not necessary</p>	<p>No change recommended</p> <p>This is meant. See Rule 287.1-3.</p>	<p>Agreed: no change</p>

		given the current drafting.		
Rule 287	6 KAS	– It is suggested that the definition of “patent attorney” should refer in addition to Article 134(3) EPC. This appears to be correct.	Change recommended Just say Art. 134 EPC.	Change agreed It was agreed to refer to Art 134.
Rule 287 and 288	90 CSA	– This respondent suggests for the avoidance of any doubt that the word “a representative” should be expressly inserted wherever “a lawyer” is mentioned in these two rules and that Rule 287.6 should define “representative” as a representative appointed pursuant to Article 48(1) or (2) of the Agreement. These clauses have been drafted so as not to be <u>limited</u> to representatives but it is not clear whether there is any benefit in expressly including the word representative. To be discussed.	Change recommended See Proposal above on Rule 287 – 17 - UKPAT	See above
Rule 290.1	110 CCBE	– This respondent believes that the powers of the Court as regards representatives should be spelt out.	No change recommended The Court can inform the person or exclude him (Rule 291). It can inform the competent Bar of the state-attorney in criminal cases.	Agreed: no change
Rule 290.2	91 FICPI-I	– This respondent points out that the current rules do not provide for the handling of any breach of the code of conduct or enforcement. Should we attempt to introduce such rules?	No change recommended See above.	Agreed: no change

Rule 290.2	110 – CCBE	<p>This respondent points out that practitioners in the various contracting member states will be subject to a variety of different codes of conduct. If there is to be one code of conduct then it is important that it is drafted in advance of the coming into force of the Agreement. It is suggested that this matter be referred to the Preparatory Committee as a matter of urgency. In particular the sanctions available under Rule 291 should be established.</p>	<p>No change recommended</p> <p>No attempt should be made to establish a UPCA code of conduct. No power for that under the Agreement. If the Court believes that there is an improper conduct, it should refer the case to the competent Bar or Authority. It may apply Rule 291.</p>	<p>Agreed: no change</p>
Rule 290(a)	33 – IP	<p>This respondent is concerned to avoid stays wherever possible and in particular where a stay is ordered pending the outcome of EPO proceedings. It recommends in this rule there should be express reference that a stay will only be granted where there is expectation of an <u>imminent</u> decision of the EPO and it refers to Article 33(10) of the Agreement to support this.</p>	<p>No change recommended</p> <p>The Court has discretion ("may") and will use it as the case may be.</p>	<p>Agreed: no change</p>
Rule 292	28 – HUN	<p>It is pointed out that the definition of "patent attorney" is made by reference to Rule 287.6 or 287.7. These rules provide for privilege to patent attorneys <u>wherever they practise</u>. This has the unforeseen consequence that rights of audience are given to patent attorneys wherever they practise which was not intended. It is suggested therefore that the definition of patent attorney in Rule 292 should expressly be limited to those practising within contracting member states.</p> <p>This seems to be correct and a sensible suggestion.</p>	<p>Change recommended</p> <p>Proposal:</p> <p>"shall mean a person domiciled in a Contracting Member State who is ..."</p>	<p>Change agreed</p> <p>It was agreed to add "...shall mean a person practising in a Contracting Member State who is ..."</p>

Rule 292	90 – CSA	<p>This respondent believes that in addition to the reference to Article 48(1) in this rule there should be express reference to Article 48(2).</p> <p>This seems to be correct.</p>	<p>No change recommended</p> <p>A proven patent attorney under Art. 48(2) does not need an assisting pa. Art. 38(4) is meaning a pa assisting a lawyer under Art. 48(1), see the speaking right under Art. 48(4).</p>	<p>Change agreed</p> <p>It was agreed to add a reference to Article 48(2).</p>
Rule 292.2	96 – PC	<p>This respondent wishes to delete the word “at the discretion of the Court and” from this rule.</p> <p>Article 48(4) allows patent attorneys to speak at hearings of the Court “in accordance with the Rules of Procedure”</p>	<p>No change recommended</p> <p>Art. 48(4) refers to the RoP. The Court should have the discretion to limit the pleading-time for the assisting pa.</p>	<p>Agreed: no change</p>
Rule 293	31 – LES	<p>This respondent believes there should be a general provision allowing a party’s representative to withdraw from representation whether or not a new representative is appointed. It points out that representation is a matter of contract between the party and its representative as well as a matter involving ethics and regulation. Where the contract is breached (non-payment of fees) or regulation requires a representative to cease to act, the representative should be allowed to cease to act regardless of the appointment of a new representative.</p>	<p>No change recommended</p> <p>The Rule deals with the relation of the Court to the representative and is the consequence of Rule 8: The Court cannot communicate with the party directly.</p> <p>No problem for the representative who has ended his contractual relationship with the client: He will send to him all documents from the Court but will tell him that he will not act for him before the Court advising on the possibility of a default judgment.</p>	<p>Agreed: no change</p> <p>It was agreed that the representative would need to remain responsible until the Court is notified of a new representative.</p>
Rule 295	4 – AIPPI	<p>This respondent believes that where there is reference to a stay pending a decision of the EPO there should be specific reference to the expectation of “a rapid decision” in accordance with Article</p>	<p>No change recommended</p> <p>See above.</p>	<p>Change agreed</p> <p>It was agreed to amend THE Rule to reflect Article 33(10).</p>

		33(10) of the Agreement. Similar comments are made by 21 – PUR, 89 – BRIS, 97 – EGA.		
Rule 295	13 – EPLAW	It is suggested that this rule should be non-exhaustive .	No change recommended See Rule 295(k)	Agreed: no change
Rule 295	33 – IP	This respondent is concerned to avoid stays wherever possible and in particular where a stay is ordered pending the outcome of EPO proceedings. It recommends in this rule there should be express reference that a stay will only be granted where there is expectation of an <u>imminent</u> decision of the EPO and it refers to Article 33(10) of the Agreement to support this.	No change recommended The present text (including Rule 295(k)) gives the necessary flexibility for the Court.	Agreed: no change
Rule 295(a)	46 – HGF	This respondent suggests that guidelines should be set out as to when the Court should exercise its discretion to stay proceedings pending a decision of the EPO . It points out that practice in this respect is divergent amongst national patent courts. A similar comment is made by 84 – BGMA who suggests that a stay of proceedings should only be granted where an EPO decision is likely to be made sooner than that of the UPC.	No change recommended See above	Agreed: no change
Rules 300-301	2 – PAT	1. Consistent with other comments made, this respondent believes that the calculation of time limits is unduly complicated and not consistent with the corresponding provisions of the EPC	Change recommended 1. Reduce the instances where the expression " working days " are used to the obligatory cases (Enforcement	Change agreed See notes to Rule 9, 2 – PAT.

		<p>(Rules 131-134 Implementing Regulations EPC).</p> <p>2. In particular this respondent refers to Rule 300(a) which should be re-defined in accordance with Rule 131(2) EPC and that rules in case of a dislocation in electronic notification should be formulated analogously to Rule 134(2) EPC.</p> <p>3. The distinction between calendar days and working days should be entirely abandoned and time limits expressed in days should be dispensed with altogether.</p> <p>A similar comment and recommendation is made by 93 – FFW</p> <p>Once again the use of “days” and “working days” is in the Agreement.</p>	<p>Directive) and say "days" instead.. See above. This reduces the holiday-problem.</p> <p>2. Add to Rule 300(a) (from Rule 131.2 EPC):</p> <p>", in case of a service the relevant event shall be the receipt of the service."</p> <p>3. See above 1.</p>	
	48 – GRUR	<p>This respondent believes that the provisions of the EPC regulation are preferable in certain respects. In particular, it points to the triggering of a set period in Rule 300(a), which should be re-defined in line with Rule 131(2) EPC, and suggests that there should be a rule drafted analogous to Rule 134(2) EPC to take account of impaired electronic transmission.</p>	<p>No change recommended</p> <p>See above</p> <p>See above</p>	Agreed: no change
Rule 300	14 – EPI	<p>The suggestion is made that, in view of the many special holidays involved in different contracting member states, that the Registry should publish a list of all official holidays which are applicable to the work of court.</p>	<p>No change recommended</p> <p>Will apply only to the few cases where "working days" apply. The relevant division will know the holidays of its state/region.</p>	Agreed: no change

Rule 301	8 BUND –	It is suggested that the Registry should publish a list of all relevant holidays .	See above	See above
Rule 301	5 KOS –	This respondent also suggests adding a section similar to Rule 134(2) EPC .	See above	See above
Rule 301	90 CSA –	This respondent points out that Rule 301.1 should in principle apply to documents filed in electronic form and therefore Rule 301.2 is an additional provision if for any reason the electronic system fails on a <u>working day</u> . This seems to be correct.	I agree with this interpretation. No change recommended	Agreed: no change required
Rule 301.1	78 – PB	This respondent believes that official holiday of the contracting member state should include an official holiday of part of that contracting member state. This is particularly relevant, it is stated, for Germany.	No change recommended It must be an official holiday of the Contracting Member State. This means: for the whole state.	Agreed: no change
Rule 305.2	91 – FICPI-I	This respondent believes that parties (as distinct from the Registrar) should not be allowed to undertake a task “as soon as practicable” and therefore suggests that the wording in this rule be amended to read “within a time period to be specified”.	Change recommended Proposal: Change Rule 305.2 at the end: “..within a time-limit to be set by the Court”	Agreed: no change “..., as soon as practicable after service of the application” refers to the Court’s invitation to the other parties to comment, not to the time limit for the parties to respond.
Rule 310	16 CSO –	This respondent asks what happens if a party does not have a successor or if the other party does not apply to have the successor added to or substituted for the original party. A similar comment is made by 40 –	Change recommended Proposal: Add to Rule 310.3:	Agreed: no change It was noted that in law, there is always a successor in title (even if simply the state, e.g. in cases of intestacy).

		TAL.	"Where the party has no successor, the Court shall close the file"	
Rule 310	78 – PB	This respondent believes there should be an additional provision to the effect that if proceedings are commenced in the name of a party who is already dead those proceedings shall be inadmissible.	No change necessary This is self-understanding. There is no action, if there is no claimant.	Agreed: no change
Rules 313-317	14 – EPI	It is suggested that an intervener may have a substantial interest in the outcome of a case and therefore a substantial influence such that an intervention should only be admissible if an intervention fee is paid . Rule 370 should be appropriately amended.	No change recommended The intervener is only treated as a party (Rule 315.4), he is no party .	Agreed: no change
Rule 314	12 – GOO	This respondent believes there may well be occasions where a party may wish to intervene. It cites the example of a German manufacturer if its UK distributor is sued only in the UK. It suggests that intervention is not a step to be taken lightly given that the intervener will be bound by the decision. Accordingly it suggests that the threshold should be set at a low level together with safeguards to ensure that the application to intervene does not delay the action. Specifically therefore this respondent recommends the following amendment to Rule 314 and 317: "The judge-rapporteur shall decide within one month of the Application on the admissibility of the Application to intervene	No change recommended The proposed time-limit would not serve a useful purpose . The intervener may apply for intervention at any stage of proceedings (Rule313.1)	Agreed: no change

		by way of order. The other parties shall be given an opportunity to be heard beforehand.”		
Rule 315.3	13 – EPLAW	It is suggested that the Statement in intervention should contain all relevant information corresponding to Rule 13.	No change recommended The information according to Rule 313.4 seems sufficient.	Agreed: no change
Rule 317	31 – LES	This respondent does not understand why there can be no appeal from a decision refusing an order to intervene. A similar comment is made by 12 – GOO, 26, AFDEL, 84 – BGMA.	No change recommended Reason: The intervener is no party.	Agreed: no change
Rule 317	91 – FICPI-I	This respondent wishes this rule to be deleted as there should always be the possibility of an appeal.	No change recommended See above	See above
Rule 318 – NEW AMICUS Briefs	3 – TES	This respondent support the possibility of filing amicus briefs. He suggests that a suitable, flexible model can be found in the Rules of Procedure of the enlarged Board of Appeal of the EPO, namely Article 10.	Discussion over "amicus curiae" (am) is needed. 1. The ECJ does not allow <i>am</i> . 2. For persons with "legal interest" the intervention is open (Rule 313). 3. On the other side an <i>am</i> can provide valuable information or arguments. 4. However, the Court receives electronically (Rule 4). He would experience in bio-, IT and computer-technology cases thousands of <i>am</i> briefs – organised by interest groups who believe that mass is an argument. 5. Therefore, if an <i>am</i>-provision is	Agreed: no change The Committee considered the possibility of amicus curiae provisions. However, there was very little support for the proposal, particularly bearing in mind the problems identified by WT.

			<p>wanted, there must be a barrier, a shield against such flooding.</p> <p>6. Of the three variants below the Google-variant is in my view the best to start with. If this test goes well, the Administrative Committee could enlarge the rule at a later point of time.</p>	
Rule 318 – NEW AMICUS Briefs	4 – AIPPI	<p>This respondent is in principle in favour of the introduction of such a new rule provided that care is taken to avoid misuse with the result that the Court is overburdened with lengthy paper in many cases.</p> <p>Similar comments made by 19 – IPO, 21 – PUR, 24 – LILLY (which believes that it may be appropriate to limit such briefs to proceedings before the Court of Appeal), 33 – IP (who also believe that such briefs should be limited to the Court of Appeal).</p> <p>The respondent 99 – IPLA also support an amicus brief procedure provided that it will only apply where the Court invites such briefs and the Rules should provide that the parties must be given an opportunity to comment on the matters raised.</p>	I prefer the Google-variant, below	Agreed: no change
Rule 318 – NEW AMICUS Brief	7 – INTEL	<p>This respondent comments that patent litigation may well affect different industry sectors in different ways. Therefore it is often the case that individual litigants would not always reflect wider views and interests that might be affected by a given case. It points out that Rules 313 and 316</p>	I prefer the Google-variant, below	Agreed: no change

	<p>provide for intervention in proceedings, but that these provisions are too narrow in that they only apply to entities that are directly affected by the outcome of the case in question. It believes that the Court would benefit from the views of indirectly interested parties and therefore the Rules ought to provide formally for the provision of amicus briefs. It points out that such briefs are a staple of the litigation procedure in the US and are frequently invited by the US Court of Appeals for the Federal Circuit.</p> <p>This respondent suggests a new rule 318 as follows:</p> <p>“Subject to Rules 318(2)-(5) below, in cases involving legal questions of general importance, the Court of Appeal may invite any person or legal entity to file a brief as amicus curiae addressing particular legal questions, except that no such brief may be filed by a person or entity that is a party in the case or an affiliate of a party in the case.</p> <p>2. An invitation under Rule 318.1 may be posted on the webpage of the Court of Appeal and shall include:</p> <p>(a) the legal questions of interest;</p> <p>(b) a time limit for filing; and</p> <p>(c) appropriate limits of scope.</p> <p>3. In cases before the Court of Appeal in which an invitation pursuant to Rule 318(1) has not been issued, a person or</p>		
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	<p>legal entity concerned by that legal question who is not a party or an affiliate of a party may file a motion for leave to file a brief as amicus curiae. The motion shall state with particularity:</p> <ul style="list-style-type: none">(a) the identity of any proposed amici curiae;(b) the legal question or questions the amicus curiae proposes to address;(c) the interest of the amici curiae in the legal question or questions;(d) how the proposed amicus brief will assist the Court in its disposition of the case. <p>A motion for leave to file an amicus brief by a governmental authority should be granted unless the participation of that governmental authority is clearly unwarranted. The Court may rule on all motions under this Rule without explaining the reasoning for its decisions. Rulings on motions made under this subsection are final and not subject to appeal.</p> <p>4. An amicus curiae brief filed under this Rule shall contain:</p> <ul style="list-style-type: none">(a) a reference to the action number of the file;(b) the names of the amicus curiae and		
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		<p>of the amicus curiae’s representative;</p> <p>(c) a footnote appended to the first paragraph of the brief affirming that no person other than those identified in subsection (b) contributed to the preparation or filing of the amicus curiae brief;</p> <p>(d) arguments limited to the scope of the questions addressed by the invitation of the Court of Appeals described in Rule 318(1), or admitted by an order granting a motion for leave to file described in Rule 318(3).</p> <p>5. With respect to any brief or motion filed under this Rule, Rule 313.3 shall apply mutatis mutandis.</p> <p>6. 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>		
318 – NEW AMICUS Briefs	12 – GOO	<p>This respondent has formulated a different rule for the admission of Amicus briefs as follows:</p> <p>“1. Within one month of the statement of appeal being registered pursuant to Rule 230, any person (an amicus curiae) may seek permission from the Court of Appeal to submit written observations.</p> <p>2. In determining whether to permit such observations to be filed, the Court of Appeal will consider whether the appeal raises issues which are more</p>	If an <i>am</i> -rule is wanted, I would prefer this Rule.	Agreed: no change

		<p>liable than usual to affect non-parties and whether the amicus curiae is in a position to provide information, argument or a perspective to the court that is different from that presented by the parties. Such determination shall be made within one month of the permission being sought.</p> <p>3. If permission is granted, the observations must be provided within the time period specified by the Court of Appeal on granting permission and in any case no later than two weeks after the date set for the grounds of appeal being submitted.</p> <p>4. In exceptional cases the Court of Appeal may ask the amicus curiae to appear at the oral hearing.</p> <p>5. By submitting such observations and/or appearing before the court, the amicus curiae does not become a party.”</p>		
Rule 318 – NEW AMICUS Briefs	13 – EPLAW	<p>This respondent suggests a further alternative rule as follows:</p> <p>“1. In cases involving legal questions of general importance [<i>the Court of First Instance or</i>] the Court of Appeal may invite any person or legal entity concerned by that legal question to file a brief as amicus curiae.</p> <p>2. The invitation may be posted on the Court’s webpage and shall include:</p>	I prefer the Google-variant, above.	Agreed: no change

		<p>(a) the legal question of interest;</p> <p>(b) a time limit for filing; and</p> <p>(c) limits of scope.</p> <p>3. Rule 313.3 shall apply mutatis mutandis.</p> <p>4. The Amicus curiae brief shall contain</p> <p>(a) a reference to the action number of the file;</p> <p>(b) the name of the amicus curiae and of the amicus curiae's representative,</p> <p>(c) 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>A similar comment is made by 25 – TEVA which supports this EPLAW draft rule save that it should expressly apply to both the Court of First Instance and the Court of Appeal. The same comment is made by 51 – B&B.</p> <p>A contrary view is express by 24 – LILLY and 33 – IP (see above).</p>		
Rule 320	2 – PAT	1. It is commented that the three month absolute time limit is not acceptable.	Change recommended	Agreed: no change
			1. In Rule 320.1 change from "one month/three month" to " three	The Committee discussed WT's

		<p>2. It is also suggested that it is unacceptable that there should be no means of legal redress in the event of a rejection of an application for re-establishment given the extremely complex deadlines provided for in the Rules of Procedure.</p> <p>Similar comments are made by 48 – GRUR, 77 – AIPPI-F makes a similar comment with regard to the possibility of an appeal is made.</p>	<p>months/one year"</p> <p>Reason: Better protection.</p> <p>2. In Rule 320.7 change: no appeal also against granting decisions)</p> <p>a) Rejecting-decision: With the proposed extended time-limits in Rule 320.1 the party has had all chances under human rights. There must not be another instance.</p> <p>b) Granting decision: New trial. There should be no appeal for the other side.</p> <p>Proposal: Add to "Reestablishment of rights": "or from an order granting such Reestablishment."</p>	<p>proposal.</p> <p>It was agreed that a final deadline is necessary, and that the one month/three month" timings allow sufficient time to correct a missed deadline.</p> <p>However, Rule 320.7 would be amended to add: "or from an order granting Re-establishment of rights".</p>
Rule 320.7	91 – FICPI-I	<p>This respondent believes that this sub-rule should be deleted as there should always be a possibility of an appeal.</p> <p>A similar deletion is suggested by 110 – CCBE</p>	<p>Change recommended</p> <p>See Rule 320-2-PAT above</p>	See above
Rule 320.7	108 – AAPI	<p>This respondent believes that an order rejecting an application for reestablishment of right should be the subject of a possible appeal and suggests deleting this provision.</p>	<p>Change recommended</p> <p>See Rule 320-2-PATabove</p>	See above
Rule 321	8 – BUND	<p>It is suggested that an application by both parties to use the language of the patent should be made as soon as practicable during the written procedure to avoid unnecessary delay.</p>	<p>Change recommended</p> <p>The agreement according to Art. 49(3) should ideally be reached by the parties before the case starts. The latest point of time for the Application</p>	Agreed: no change

			<p>should be the Statement of Defence.</p> <p>Reason: Avoidance of duplication of work, translations. Therefore the "hurry" in Rule 321.3 (10 days).</p> <p>Proposal</p> <p>1. Rule 14.2(new):</p> <p>"2. Where the parties have agreed to use the language in which the patent was granted as language of the proceedings in accordance with Article 49(3), the Statement of claim shall contain an Application to that effect (Rule 321). A later Application may only be handed in together with the Statement of defence (Rule 23)."</p> <p>2. Combine Rule 321.1 and 2 into Rule 321.3 (renumbering of Rule necessary):</p> <p>"3. Where an Application to use the language in which the patent was granted as language of the proceedings (Article 49(3) of the Agreement) has been handed in (Rule 14.1(c)), the panel shall ... "</p>	
Rule 321	14 – EPI	This rule appears to allow the transfer of proceedings not only to the central division but also to "another division" in the event that a request by the parties to use the language of grant is refused. However, this respondent points out that Article 49(3) only allows such a transfer to the	<p>Change recommended</p> <p>Delete the reference to "another division"</p>	<p>Change agreed</p> <p>It was agreed to delete the reference to "another division".</p>

		central division. A similar comment is made by 6 – KAS. This appears to be correct.		
Rule 321.3, 321.5 and 323.2	81 – JD	This respondent believes that in each case the period of ten days is too short and should be one month .	No change recommended 10 days is not much, but the procedure must be speedy. Extension possible.	Agreed: no change
Rule 323.3	20 – APEB	This group believes that the president of the Court of First Instance should not order proceedings in the language of grant unless he has agreement of the panel and not merely having consulted the panel.	No change recommended Contrary to Art. 49(5) ("heard")	Agreed: no change
Rule 334(h)	78 – PB	This respondent believes that there should be no power, as part of case management, to dismiss a pleading summarily . This, it is alleged, is not part of case management. It is also not clear whether such a ruling is appealable. A similar comment is made by 108 – AAPI both in relation to Rule 334(h) and (f). It also doubts whether there is power to appeal and believes that there should be.	No change recommended There may be cases where a rejection by summary judgement is appropriate. Appeal possible.	Agreed: no change It was noted that the right to be heard is guaranteed by the Rules. As noted by WT, summary judgment may be appropriate and appeal is available.
Rule 338 – NEW: transfer of proceedings	7 – INTEL	This respondent points out that Article 33 of the Agreement gives a claimant a wide choice of potential jurisdictions. Its experience in the United States is that some patentees will use this freedom to obtain a potentially unfair advantage. A claimant may deliberately choose a forum that is inconvenient for the	No change recommended Contrary to Art. 33 of the Agreement. Rule 340 (Joinder) already is in the "grey zone" of incompatibility. It should be reduced to the power of the panels (excluding the President of the CFI).	Agreed: no change This proposal was discussed. The Committee agreed that no change should be made. It was noted that a power to transfer raised political questions.

	<p>Defendant.</p> <p>It acknowledges that the extent of forum shopping is yet unknown but it recommends that the Court should have a general right to transfer proceedings where the original court is not convenient. It believes that such a provision would be consistent with Article 33 of the Agreement and entirely consistent with Article 43 of the Agreement which provides that the Court shall actively manage cases and that the Rules of Procedure will guarantee that decisions are of the highest quality and that proceedings are organised in the most efficient and cost effective manner.</p> <p>With all of the above comments in mind the following new rule 338 is suggested:</p> <p>“At the request of either party and after having heard the other party and the competent panel, the President of the Court of First Instance may in the interests of justice and taking into account all relevant circumstances including the position of the parties as well as language issues and other connecting factors refer a case from one local or regional division being competent under Article 33(1)(a) of the Agreement to any other local or regional division being competent under Article 33(1) or 33(2) if the President believes such transfer will contribute significantly to the efficiency and cost effectiveness of the proceedings”.</p>	<p>See there.</p>	
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		<p>Other respondents have suggested such a general power. If it is to be introduced then there must be an efficient procedure for ensuring that any such transfer of proceedings occur in a timely fashion. See also the proposal of 12-GOO to amend Rule 19.4.</p>		
Rule 340 – Connection	4 – AIPPI	<p>This respondent believes that the power under this rule should be extended to cover all aspects of the case management of different actions if the circumstances require this.</p>	<p>No change recommended</p> <p>See above</p>	<p>Agreed: no change</p>
Rule 340	12 – GOO	<p>This respondent as a general matter believes that there should be much tighter provisions for the consolidation of proceedings in different divisions which concern the same patent(s) and/or the same product(s). It points to the possibility of separate proceedings being commenced in different divisions against a manufacturer and important and distributors of the same product or proceeding under separate patent in different divisions but all relating to the same product (e.g. a mobile telephone). It is therefore suggesting changes to ensure that the Court is aware of the connection between these proceedings and that the consolidation is handled efficiently.</p> <p>Therefore this respondent suggests amendment to a number of separate rules all in connection with consolidation as follows:</p> <p>“13(h) where applicable, information about any prior or pending proceedings between</p>	<p>Change recommended</p> <p>The proposed changes of the text should be reduced to the same patent.</p> <p>See my Proposal for Rule 340 below.</p>	<p>See below</p>

	<p>the same or related parties, or relating to the patent (or patents) or divisional patents of the patent (or patents) concerned before the Court including any action for revocation or a declaration of non-infringement pending before the central division and the date of any such action, the European Patent Office or any other court or authority,”</p> <p>“24(h) an indication of any order the defendant will seek, including an order for consolidation with another action, in respect of the infringement action during the interim procedure [Rule 104(e)].”</p> <p>“104(e) where appropriate, issue orders regarding consolidation of proceedings, production of further pleadings, documents, experts (including court experts), experiments, inspections, further written evidence, the matters to be the subject of oral evidence and the scope of questions to be put to the witnesses.”</p> <p>“260.2 Where the Registry notes that two or more actions between the same parties and/or concerning the same patent or patents are initiated before several divisions, it shall as soon as practicable inform the divisions concerned.”</p> <p>“302.3 The Court may order that parallel infringement or revocation proceedings relating to the same patent (or patents) or relating to the same product or process, either before the same local or regional division or the central division or the Court of Appeal be heard together where it is in the interests of justice to do</p>		
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		so.”		
Rule 340	13 – EPLAW	It is commented that the word “disjoined” has been deleted from this rule whereas it may be critical in certain cases to ensure that cases are disjoined and this power should appear expressly in the Rules.	<p>Change recommended</p> <p>Rule 340 is not compatible with Art. 33 of the Agreement insofar as it gives the Presidents of the CFI and the CoA powers to join cases.</p> <p>The Presidents are administrative organs which cannot interfere with the independence of judges.</p> <p>The construction of the Rule must be different: The panels must agree to join the cases.</p> <p>Proposal:</p> <p>"1. Where two cases regarding the same patent and the same parties are pending before two panels of the same division or where two cases regarding the same patent and the same parties are pending before panels of different divisions both panels may agree that one of these cases may be transferred to the other panel.</p> <p>2. Where two cases regarding the same patent and the same parties are pending before different panels of the Court of Appeal, both panels may agree that one of these cases may be transferred to the other panel.</p> <p>3. Joint cases may be disjoined, if</p>	<p>Change agreed</p> <p>It was agreed to amend the Rule in line with WT’s proposal, but to permit joinder even if different parties are involved.</p>

			both panels agree."	
Rule 343.2(b)	91 – FICPI-I	<p>This respondent believes that the parties should also have the opportunity to accelerate or delay proceedings since the Court may not always know the background to the action and/or the status of settlement negotiations. They therefore suggest that Rule 343.2 be amended to read as follows:</p> <p>"The presiding judge of a local or regional division, the president of the Court of First Instance or the president of the Court of Appeal may, of its own motion or on application by a party, after hearing the parties..."</p>	<p>Change recommended</p> <p>Proposal:</p> <p>Change the beginning of Rule 343.2 as follows</p> <p>"2. The presiding judge of a local or regional division for a case pending before it, the President of the Court of First Instance for a case pending before the central division or the President of the Court of Appeals for a case pending before the Court of Appeal may of its own motion or on application by a party, after hearing the parties ..."</p> <p>Reason: The Presidents should not interfere with the local or regional divisions panels. FICPI-proposal incorporated.</p>	<p>Change agreed</p> <p>It was agreed to amend the rule in line with WT's proposal.</p>
Rule 345	99 – IPLA	<p>This respondent points out that there is a prescriptive period of one year for panels to sit together. However this will not work if panels are allocated to cases as early as is envisaged in Rule 17.2. One possibility is to only appoint a judge-rapporteur under 17.2 and leave the appointment of the panel until the conclusion of the interim conference. If this were done it would not be possible for issues to be referred to the panel during the interim procedure.</p> <p>In any event it seems the Rule 345</p>	<p>No change recommended</p> <p>Misunderstanding, as explained above Rule 17.2 -110 CCBE. No break-up of the panel after one year. Re-appointment normal. Change of judges not allowed between oral hearing and decision.</p>	<p>Change agreed</p> <p>Rule 345.1 and .2 were discussed.</p> <p>It was agreed that Rule 345.1 as drafted was too prescriptive and administratively complex. It was agreed that the 1-year period for the appointment to panels and the last two sentences of Rule 345.1 should be deleted.</p>

		needs to be reconsidered.		
Rule 345.1	110 – CCBE	This respondent suggests that judges are not locked together in a panel for a period of time but rather allocated to review decisions on as needed basis. The panel may be then formed at a much later time and with greater flexibility. A similar comment is made by this respondent in connection with Rule 17.2.	No change recommended See above	See above
Rule 346	13 – EPLAW	1. It is pointed out that this rule does not specify the consequences of a judge being removed pursuant to Article 7(4). It suggests that this requires further consideration. A similar comment is made by 51 – B&B.	No change recommended 1. Removal of a judge (Rule 346.1): See Art. 10 Statute 2. Objection to a judge participating (Rule 346,4): See Art. 7.4 Statute. Consequences: Rule 346.5.	Agreed: no change
Rule 352	87 – CDI	This respondent believes that security should always be provided where a decision to bifurcate has been taken and the counterclaim for invalidity has not yet been decided.	No change recommended See Rule 118.1.	Agreed: no change
Rule 354	13 – EPLAW	It is proposed that where there is a final decision in which a patent has been limited or revoked or there has been a decision against the EPO in carrying out the tasks referred to in Regulation 1257/2012 the decision should be automatically sent to the EPO for all necessary steps to be taken regarding the data recorded in respect of that patent. A similar comment is made by 40 –	No change recommended 1. Total or partial revocation: See Art. 65.5: Information of the EPO. 2. Decision against the EPO: The EPO does not need to be informed, because it was a party of the proceedings.	Agreed: no change However, it was agreed to amend Rule 354.4 in line with a suggestion of WT such that an order/decision shall cease to be enforceable following subsequent revocation of the patent.

		TAL.		
Rule 354.1	12 – GOO	It is suggested that this rule should be made expressly subject to new provision 118.10 suggested above. A similar comment is made by 83 – COAL. See the suggested amendment to Rule 118.10 made by 7 – INTEL above.	No change recommended See above (no new Rule 118.10)	Agreed: no change
Rule 355	2 – PAT	It is suggested that this rule wrongly extends the possibility for decisions by default beyond those set out in Article 37 of the Statute. Again this respondent points to the many time limits provided for in the Rules of Procedure and believes that a decision by default should be restricted to cases where a party by his action makes it known that he has no serious intention to defend himself. A similar comment is made by 48-GRUR. This formulation is too restrictive.	No change recommended 1. Art. 37 Statute does not exclude other cases where default decisions may be used, it is non-exclusive. 2. The Rules on other default-decisions than those under Art. 37 Statute are covered by Art. 41(1) and (3) of the Agreement. The underlying reason in these cases is: The party wants the Court to decide in its favour but does not cooperate. 3. The only other sanction for orders would be a penalty under Art. 82(4) and Rule 354.5. This would not be appropriate, if a party acts against its own interest in these cases. 4. In the case of non-observance of a time-limit there would be no other sanction available.	Agreed: no change It was agreed that no change should be made, for the reasons given by WT.
Rule 362	16 – CSO	This respondent believes that this rule creating as it does absolute barriers to proceedings should not be expressed to be non-exhaustive and that all the grounds	Change recommended 1. Rule 362 is not exclusive ("for	Change made It was agreed to amend the Rule as

		<p>for such a barrier should be spelt out. It suggests the following amended rule:</p> <p>“The Court may at any time, on the application of a party or of its own motion, after giving the parties an opportunity to be heard, decide that there exists an absolute bar to proceeding with an action, because of</p> <p>(a) another action between the same parties for the same right under the same factual grounds is already in progress in front of the same division or another, or the judgement adopted in respect of the case has already become definitive (res judicata);</p> <p>(b) the Court has no jurisdiction to take cognisance of an action;</p> <p>(c) the party has already hadn’t legal capacity to sue when the action is brought (Article 46 of the Agreement).”</p>	<p>example”). No change</p> <p>2. Respondent mixes cases Rules 361 and 362. No change</p> <p>But Proposal:</p> <p>Delete the last sentence (Rule 363.2 mentions Rule 362).</p>	<p>proposed by WT.</p>
<p>Rule 364 – NEW</p>	<p>12 – GOO</p>	<p>This respondent believes that the Rules should incorporate the UK Rule in <i>Henderson v Henderson</i> to ensure that claimants bring all claims forward in a concerted manner. The suggested new Rule 364 is as follows:</p> <p>“Absent exceptional circumstances, the Court will not permit the same parties to litigate in a second action matter which could and should have formed part of a first action between the parties, or could and should be added to the first action if it has not been determined. This rule aims to avoid a</p>	<p>No change recommended</p> <p>1. The idea is that the claimant should sue out of all patents he has.</p> <p>2. On the first glance this idea looks good because it avoids a step-by-step-attack calculated to draw the defendant into an endless battle</p> <p>3. However, there are draw-backs to this rule:</p> <p>a) It would force the multi-patent-</p>	<p>Agreed: no change</p> <p>12 – GOO’s proposal was discussed.</p> <p>It was observed that, in the UK, while the Rule in <i>Henderson v Henderson</i> is very rarely invoked, parties have it in mind. However, the Committee noted the concerns raised in WT’s point 3. The experience in Germany was that its similar rule (§ 145 PatG) was a burdening of cases with multiple patents.</p>

		<p>multiplicity of proceedings between parties where essentially the same subject matter is in issue in each action.”</p>	<p>owner to sue on all possibly relevant patents, in ETSI-patent-cases: thousands.</p> <p>b) It would force the patent-owner to include patents into the action which might trigger revocation actions – and the Court must deal with them or bifurcate.</p> <p>4. A rule to that effect in German patent law (§ 145 PatG) is criticized because of these and other draw-backs (<i>Ohl</i>, GRUR 1968, 169/171). The rule has the following wording:</p> <p>"Where an infringement action is raised, a further infringement action relating to the same or similar act but based on another patent may be raised against the defendant only if the claimant was, without negligence on his side, not able to base the first action on this patent."</p> <p>5. A better reaction to a frivolous step-by-step-actions is under the present text to burden the claimants with all costs (Art. 69(3) of the Agreement).</p> <p>6. Therefore: No change</p>	<p>The proposal was not adopted.</p>
Rule 365.4	8 – BUND	<p>This respondent queries whether it is appropriate in the context of a settlement that the judge-rapporteur should have a discretion as to costs. It points out that costs are likely to have been taken into account in the overall settlement terms.</p>	<p>No change recommended</p> <p>1. If covered by the settlement: First alternative of Rule 365.4</p> <p>2. If not covered: No need for a full cost proceeding. Discretion is a good</p>	<p>Agreed: no change</p>

			<p>solution. Appeal under Rule 221 only with leave of the CoA and only for misuse of discretion.</p>	
Rule 370.7	14 EPI –	<p>This respondent also believes that Rule 320.7 should be deleted and an appropriate amendment made to Rule 220.1(c).</p>	<p>Belongs to Rule 320.7 saying: no appeal against no-re-establishment-decision</p> <p>See comments and Proposal there.</p>	<p>See Rule 320.7</p>
Rule 375 to 382	8 BUND –	<p>This respondent suggests that this should be a specific rule requiring an applicant for legal aid to indicate any material improvement in his economic circumstances and that a failure to do so will result in the withdrawal of legal aid.</p>	<p>No change recommended</p> <p>Such an obligation would be without sanction.</p> <p>The other side normally comes up with information about the aided person having won in the lottery.</p>	<p>Agreed: no change</p>
Rule 376	10 CMS –	<p>This respondent is concerned that a patent proprietor could grant an exclusive licence to an individual in order to obtain legal aid which would not otherwise be available, such as to a non-practising entity. To avoid this abuse the respondent suggests that, pursuant to the Rule 378 application, the applicant must disclose details of all persons having an interest in the patent in question.</p> <p>A similar comment is made by 56 – INT.</p>	<p>Change recommended</p> <p>1. No change as proposed. What would be the sanction of any lack of such information?</p> <p>If the other side detects such tricks, legal aid may be withdrawn.</p> <p>2. But Proposal: Change Rule 380.1:</p> <p>Insert after "Rule 377.1(a)" "was based on an incorrect indication according to Rule 378.2(f) and/or (g) or alters..."</p>	<p>Change agreed</p> <p>It was agreed to amend Rule 380 in line with WT's proposal.</p>
Rule 377.1(b)	90 CSA –	<p>This respondent suggests that the requirement of "reasonable prospect of success" should expressly require a preliminary opinion by a person who would</p>	<p>No change recommended</p> <p>Rule 378.5: Rule 8 (representation)</p>	<p>Agreed: no change</p>

		qualify as a representative under either Article 48(1) or (2).	does not apply.	
Rule 379.4	90 – CSA	It is not clear to this respondent why the other party needs to be consulted on an application for legal aid. It is pointed out that this will simply invite comment as to the prospects of success and therefore will drag the judge-rapporteur at an inappropriate stage into considering the merits of the case.	No change recommended The other party may know that the conditions of Rule 377.1(a) (economic situation) are not met.	Agreed: no change
New Rule – Third Parties	31 – LES	This respondent believes that the Rules should additionally deal with the procedure for joining a third party (for example a supplier). At present the Rules do not seem to lay down any procedure for this.	No change recommended Intervention (Rules 313-320), including Rule 316 (invitation to intervene) should be sufficient.	Change agreed It was agreed to amend Rule 316 to address 31 – LES’s proposal.
New Rule – Added Value Calculation	33 – IP	Whilst it is no part of the Drafting Committee’s role to recommend how fees are to be calculated, this respondent has made an interesting suggestion which it might be helpful to record. It suggests that the value added fee should not be calculated according to the German model as this is highly deplored even by German users, and means that the heavier litigation is extremely expensive. What this respondent suggests is that there should be a fixed fee payable upon the initiation of proceedings and thereafter a flexible fee calculated in accordance with the time involved in the oral hearing. This, it is suggested, would compensate the Court for the resources required for longer hearings and would also act as a deterrent to the parties taking more time than is	No change recommended 1. The fee has to be paid in advance (Art. 70(2)) . 2. It might not come to an oral hearing. 3. The time for the oral hearing might depend on long speeches of lawyers or patent attorneys who do not come to the point of the matter (or want to raise the value of the case by filibustering) or on the inability of the presiding judge to effectively guide through the matter.	Agreed: no change

		<p>strictly necessary.</p> <p>The respondent 48 – GRUR is in favour of the approach currently taken in the draft rules and expressly does not agree with the possibility to determine court fees on the basis of the time spent in court. In its view this will be a clear contradiction of Article 36(3).</p>		
New Rule – Security for costs	36 – ABPI	<p>This respondent points out that the current draft does not appear to contain any rule implementing Article 69(4) of the Agreement.</p> <p>This seems to be correct and an appropriate rule should be drafted, but at what stage of the procedure should this be dealt with?</p>	<p>No change recommended</p> <p>This refers to securities for costs (Art. 69(4)).</p> <p>See above to Rule 158 NEW re 12 GOO</p> <p>Art. 69(4) is such a general rule and it is "self-executing". It does not need repetition.</p> <p>Note:</p> <ol style="list-style-type: none"> 1. The ECJ has forbidden such securities against Union-citizens. 2. There are many bilateral treaties between member states and third countries (including States of the USA) containing a mutual waiver of securities. 3. Therefore, Art. 69(4) is difficult to handle and should not be emphasised by a Rule giving the impression that this is the normal way to proceed. 4. If the need for a Rule is felt, it must 	<p>Change agreed</p> <p>It was agreed that a rule on security for costs should be added. It was noted that it is possible to order security against EU citizens, provided it is applied without discrimination, as it would be here (i.e. not differentiating citizens of one member state from those of other member states).</p>

			be together with the Preliminary objection.	
New Rule – Groundless threat	46 – HGF	This respondent believes that the Rules should contain rules relating to groundless threats such as exist in the UK. It also points to an equivalent remedy in the Community Design Regulations. Groundless threats are a creature of UK law. The reference to the “Community Designs Regulations” appears to be to the UK’s implementing regulation; groundless threats are not dealt with in the EU Designs Regulation itself.	No change recommended. A damage claim for groundless threats is a matter of material law – nothing for the RoP.	Agreed: no change
New Rule – Post Oral Procedure Pleadings	108 – AAPI	This respondent believes that there should be a new rule which allows the parties if faced with new submissions or facts during the oral procedure to file post-hearing pleadings dealing with such new matters.	No change recommended The Court may adjourn the oral hearing. This is better than post-oral-hearing-writs and no new oral hearing.	Agreed: no change