

Amendments to the text of the UPC draft Rules of Procedure approved by the Preparatory Committee on 15 March 2017

Amendment 0

Abbreviations

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~~**Regulation (EC) No 1206/2001:** Regulation (EC) No 1206/2001 of the Council of 28 May 2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters (OJ L 174, 27.6.2001, p. 1) including any subsequent amendments~~

Regulation (EU) 2020/1783: Regulation (EU) 2020/1783 of the European Parliament and of the Council of 25 November 2020 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters (taking of evidence) (recast), OJ L 405, 2.12.2020, p. 1

...

~~**Regulation (EC) No 1393/2007:** Regulation (EC) No 1393/2007 of the European Parliament and of the Council of 13 November 2007 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (service of documents), and repealing Council Regulation (EC) No 1348/2000 (OJ L 324, 10.12.2007, p. 79) including any subsequent amendments~~

Regulation (EU) 2020/1784: Regulation (EU) 2020/1784 1783 of the European Parliament and of the Council of 25 November 2020 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (service of documents) (recast), OJ L 405, 2.12.2020 ; p. 40

...

Explanation

Regulation (EC) No 1206/2001 has been replaced by Regulation (EU) 2020/1784.
Regulation (EC) No 1393/2007 has been replaced by Regulation (EU) 2020/1783.

As a result, and in the light of the discussions with the European 262 all references to the abovementioned regulations has been removed from the wording of the respective rules (R.173, 270, 271, 274). Furthermore, the regulations should be replaced in the abbreviations section accordingly.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 0a

Rule 3 – Power of staff of the Registry and a sub-registry to perform functions of the Registry

Where these Rules refer to the Registry or Registrar and provide ~~for the Registry~~ to perform any act that reference shall include – where applicable – the Deputy-Registrar and the relevant sub-registry and that act may be performed by the Registrar, the Deputy-Registrar or by a member of staff of the Registry or sub-registry of the relevant division.

Explanation

The deletion clarifies in the light of the exchange with the European Commission that Rule 3 applies also in situations in which the Rules of Procedure provide that the Registrar (not the Registry) performs an act.

Amendment 1

Rule 4 – Lodging of documents

1. Written pleadings and other documents shall be signed and lodged at the Registry or relevant sub-registry in electronic form. Parties shall make use of the official forms available online. The receipt of documents shall be confirmed by the automatic issue of an electronic receipt, which shall indicate the date and local time of receipt.

2. Where it is not possible to lodge a document electronically for anythe reason that the electronic case management system of the Court has ceased to function a party may lodge a document in hard-copy form at the Registry or a sub-registry. An electronic copy of the document shall be lodged as soon as practicable thereafter.

Relation with Agreement: Article 44

Explanation

Rule 4.1

The Case Management System (CMS) of the UPC requires written pleadings to be signed electronically. The proposed amendment clarifies this.

Rule 4.2

The amendment clarifies that a document can only be lodged in hard copy form in case the CMS was out of function.

Amendment 2

Rule 5 – Lodging of an Application to opt out and withdrawal of an opt-out

1. The proprietor of a European patent (including a European patent that has expired) or the applicant for a published application for a European patent (hereinafter in this Rule 5 an “application”) who wishes to opt out that patent or application from the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall lodge an Application (hereinafter in this Rule 5 an “Application to opt out”) with the Registry.

(a) Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out. Where the person lodging an Application to opt out is not recorded as the proprietor or applicant in the registers referred to in Rule 8.5(a) and (b), respectively, the person shall lodge a declaration pursuant to paragraph 3(e).

(b) The Application to opt out shall be made in respect of all of the ~~Contracting Member States~~ for which the European patent has been granted or which have been designated in the application.

...

3. The Application to opt out shall contain:

(a) the name of each proprietor or applicant for the European patent or application and of the holder of any supplementary protection certificate based on the European patent in question, and all relevant postal and, where applicable, electronic addresses;

(b) the name and postal address and electronic address of

(i) the representative appointed by the applicant or the proprietor in accordance with Article 48 of the Agreement or

(ii) any other person lodging the Application to opt out on behalf of the proprietor or the applicant and the mandate for lodging the Application to opt out;

(c) details of the patent and/or application including the EP publication number;

(d) ...

4. Rule 8 shall not apply to Applications to opt out and to Applications to withdraw made pursuant to this Rule 5. ~~Where a representative is appointed, such a representative may include professional representatives and legal practitioners as defined in Article 134 EPC in addition to those referred to in Article 48 of the Agreement.~~

5. The Registrar shall as soon as practicable enter the Application to opt out in the register. Subject to paragraph 6, the opt-out which meets the requirements laid down in this Rule shall

be regarded as effective from the date of entry in the register. If the requirements recorded in the register are missing or incorrect, a correction may be lodged with the Registry. The date of entry of the correction shall be noted in the register. The opt-out shall be effective from the date of correction.

...

7. A proprietor of a patent or an application the subject of an opt-out pursuant to this Rule may lodge an Application to withdraw in respect of the patent or application, but not in respect of different Contracting Member States for which the European patent has been granted or which have been designated in the application. The Application to withdraw shall contain the particulars in accordance with paragraph 3. The Registrar shall as soon as practicable enter the Application to withdraw in the register and the withdrawal shall be regarded as effective from the date of entry in the register. Paragraphs 1(a) and 5 shall apply *mutatis mutandis*.

...

Explanation

Rule 5.1(b) and Rule 5.7

Currently Rule 5.1(b) provides that the "Application to opt out shall be made in respect of all of the Contracting Member States for which the European patent has been granted or which have been designated in the application." This wording is inconsistent with the indivisibility of the application to opt out. It implies that the UPC solely has jurisdiction over UPCA Contracting Member States, which is not the case. Therefore the words "Contracting Member" have to be deleted in Rule 5.1(b). The same amendment has to be made in the context of Rule 5.7 as the withdrawal simply mirrors the opt-out.

Rule 5.3(c)

The amendment clarifies which number i.e. the EP publication number but not the numbers for local designations is to be cited in the application to opt out.

Rule 5.4

The first sentence of paragraph 4 specifies that the requirement of representation – otherwise mandatory for proceedings before UPC under Rule 8 – does not apply to the Applications to opt-out and withdraw made pursuant to rule 5. Right holders can make the declaration themselves or they may choose anyone to do it for them like e.g.

in the case of a company. Therefor a reference to representatives under Article 134 EPC seems misleading.

General: The dotted line (...) has been included for the purpose of presentation only and indicates wording of a paragraph in which no changes have been made.

Amendment 3

Rule 5 A – Application to remove an unauthorised application to opt out or unauthorised withdrawal of an opt-out

1. Without prejudice to the lodging of an Application to opt out or withdraw an opt-out in accordance with Rule 5, the proprietor of a European patent or the applicant for a published application for a European patent or holder of a supplementary protection certificate in relation to which an Application to opt out or withdraw the opt-out is entered in the register may lodge an Application to remove the entry of an unauthorised Application to opt out or withdrawal of the opt-out from the Registry setting out the reasons.

2. The Registrar shall mark the status of the Application to opt out or withdraw the opt-out entered in the register as subject to an Application for removal. The Registrar shall decide on the Application for removal as soon as practicable. If the final decision is to remove the Application to opt out or withdrawal of an opt-out the Registrar shall delete it in the register.

3. The decision on the Application for removal may be subject to an Application for review to the President of the Court of Appeal. The Application for review shall be lodged with the Registrar in one of the official languages of the European Patent Office, within one month of the notification of the challenged decision setting out the request, facts, evidence and arguments. If the Application for review is allowable, the President of the Court of Appeal shall order the Registrar to remove the opt-out or the withdrawal of the opt-out.

Explanation

This new rule determines how the Court has to deal with an unauthorized application to opt out or an unauthorized withdrawal of an opt-out. In this case, the proprietor or applicant or holder may lodge an Application to remove the entry of an unauthorised Application to opt out or withdrawal of the opt-out from the Registry setting out the reasons. In the event of an Application for removal the Registrar shall ensure that the status of the patent or application or supplementary protection certificate indicated in the register as opted out or opt-out withdrawn shall be marked as subject to an Application for removal. The Registrar shall decide the Application for removal as soon as practicable. The decision of the Registrar may be reviewed by an Application for review to the President of the Court of Appeal.

Amendment 4

Rule 13 – Contents of the Statement of claim

1. The claimant shall lodge a Statement of claim with the division chosen by him [Article 33 of the Agreement] which shall contain:

...

(q) a list of the documents, including any witness statements, referred to in the Statement of claim, together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.~~24~~ or Rule 262A.

...

Explanation

It is appropriate to add “or Rule 262A” at the end of this sub-rule. Rule 262A is a new Rule. It deals with the Application to the Court for an order that certain information contained in the pleadings of a party be restricted. Such request should be part of the Statement of claim.

With the new wording of Rule 262 the right reference is no longer Rule 262.1 but Rule 262.2.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 5

Rule 17 – Recording in the register and assignment (Court of First Instance, infringement action)

1. If the requirements referred to in Rule 16.2 or 16.3 have been complied with, the Registry shall as soon as practicable:

(a) record the date of receipt of the Statement of claim and attribute an action number to the file;

(b) record the file in the register; and

(c) inform the claimant of the action number of the file and the date of receipt.

...

Explanation

Rule 17.4 states that the action shall be regarded as having commenced before the Court as from the date of receipt attributed to the Statement of claim. This rule shall not only apply, when the claimant has complied with the requirements referred to in Rule 16.2 but also when he has corrected the formal deficiencies or has paid the fees for the infringement action in accordance with Rule 16.3. This means that the action becomes pending upon filing even if the fee has not been paid at the time of lodging of the claim but only within the period specified in Rule 16.3.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 6

Rule 24 – Contents of the Statement of defence

The Statement of defence shall contain:

...

(j) a list of the documents, including any witness statements, referred to in the Statement of defence together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.2~~4~~ or Rule 262A. Rule 13.2 and .3 shall apply *mutatis mutandis*.

Explanation

It is appropriate to add “or Rule 262A” at the end of this sub-rule. Rule 262A is to be inserted into the Rules of Procedure as a new provision. It deals with the Application to the Court for an order that certain information contained in the pleadings of a party be restricted.

With the new wording of Rule 262 the right reference is no longer Rule 262.1 but Rule 262.2.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 7

Rule 25 – Counterclaim for revocation

1. If the Statement of defence includes an assertion that the patent alleged to be infringed is invalid the Statement of defence shall include a Counterclaim against the proprietor of the patent for revocation of said patent in accordance with Rule 42. The Counterclaim for revocation shall contain:

...

(g) a list of the documents, including any witness statements, referred to in the Counterclaim for revocation together with any request that all or part of any such documents need not be translated and/or any request pursuant to Rule 262.2~~1~~ or Rule 262A. Rule 13.2 and .3 shall apply *mutatis mutandis*; and

...

Explanation

The defendant may also refer in a counterclaim to secrets that should not be disclosed to the public or where disclosure to the claimant should be restricted. Therefore, it is appropriate to add “and/or any request pursuant to Rule 262.1 or Rule 262A” at the end of this sub-rule. New Rule 262A deals with the Application to the Court for an order that certain information contained in the pleadings of a party be restricted.

With the new wording of Rule 262 the right reference is no longer Rule 262.1 but Rule 262.2.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 8

Rule 27 – Examination as to formal requirements of the Statement of defence and Counterclaim for revocation

1. The Registry shall, as soon as practicable after the lodging of the Statement of defence:

(a) examine whether the requirements of Rule 24(a) to (d) have been complied with; and

(b) if the Statement of defence includes a Counterclaim for revocation, examine whether the requirements of Rule 25.1(g) and (h), and the obligation to pay the fee pursuant to Rule 26 has been complied with.

2. If the Registry considers that the Statement of defence or the Counterclaim for revocation does not comply with any of the requirements referred to in paragraph 1, it shall as soon as practicable invite the defendant to:

(a) correct the deficiencies noted, within 14 days of service of such notification; and

(b) where applicable, pay the fee for the Counterclaim for revocation, within said 14 days.

3. The Registry shall at the same time inform the defendant that if the defendant fails to correct the deficiencies or pay the fee within the time stated, a decision by default may be given, in accordance with Rule 355.

4. If the defendant fails to correct the deficiencies or to pay the fee for the Counterclaim for revocation, as appropriate, within said 14 days, the Registry shall inform the judge-rapporteur who may give a decision by default. He may give the defendant an opportunity to be heard beforehand.

Explanation

The Counterclaim for revocation forms part of the statement of defence; nonetheless the Counterclaim functions like a complaint in a separate action. For this reason, it seems appropriate that the Registry should carry out some formal checks with regard to that action similar to a separate statement of claim. Therefore, the Registry shall not only check if the fees have been paid but also if the requirements laid down in Rule 25.1(g) and (h) have been complied with. If the defendant fails to comply with one of these requirements there is the possibility to give a judgment by default in accordance

to Rule 27.3 and 27.4 to avoid a delay of the proceeding. Further formal checks are not necessary in regard to the Counterclaim because the basic formalities, e.g. the parties' names, postal and electronic address for service on the parties, patent number, are already checked when the Statement of claim (Rule 16) and the Statement of defence (Rules 24, 27 (a)) are examined.

Amendment 9

Rule 29A – Contents of the Defence to the Counterclaim

The Defence to the Counterclaim for revocation shall contain:

...

(f) a list of the documents, including any witness statements, referred to in the Defence to the Counterclaim together with any request that all or part of any such document shall not be translated and/or any request pursuant to Rule 262.~~24~~ or Rule 262A. Rule 13.2 and .3 shall apply *mutatis mutandis*.

Explanation

It is appropriate to add “or Rule 262A” at the end of this sub-rule. New Rule 262A deals with the Application to the Court for an order that certain information contained in the pleadings of a party be restricted.

With the new wording of Rule 262 the right reference is no longer Rule 262.1 but Rule 262.2.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 10

Rule 44 – Contents of the Statement for revocation

The claimant shall, subject to point (b), lodge a Statement for revocation at the Registry in accordance with Article 7(2) of the Agreement and Annex II thereto. The Statement for revocation shall contain:

...

(h) an indication of any order the claimant will seek during the interim procedure [Rule 104(e)];

and

(i) a list of the documents, including any witness statements, referred to in the Statement for revocation together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.2~~1~~ and Rule 262A. Rule 13.2 and .3 shall apply *mutatis mutandis*.

Explanation

It is appropriate to add “or Rule 262A” at the end of this sub-rule. New Rule 262A deals with the Application to the Court for an order that certain information contained in the pleadings of a party be restricted. In addition, a formatting error in sub-rule (i) is corrected.

With the new wording of Rule 262 the right reference is no longer Rule 262.1 but Rule 262.2.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 11

Rule 50 – Contents of the Defence to revocation and Counterclaim for infringement

1. The Defence to revocation shall contain the matters referred to in Rule 24(a) to (c).
Rule 29A(a) to (d) and (f) ~~to (g)~~ shall apply *mutatis mutandis*.

...

Explanation

Rule 50.1 refers, inter alia., to Rule 29A(g) which does not exist in the current version of the Rules of Procedure. Former Rule 29A(g) is now regulated in Rule 29A(f). Therefore, the reference to Rule 29A(g) has to be deleted.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 12

Rule 63 – Contents of the Statement for a declaration of non-infringement

The claimant shall, subject to point (b), lodge at the Registry in accordance with Article 33(4), Article 7(2) of the Agreement and Annex II thereto, a Statement for a declaration of non-infringement which shall contain:

...

(j) a list of the documents, including any witness statements, referred to in the Statement for a declaration together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.2~~4~~ or Rule 262A. Rule 13.2 and .3 shall apply *mutatis mutandis*.

Explanation

It is appropriate to add “or Rule 262A” at the end of this sub-rule. New Rule 262A deals with the Application to the Court for an order that certain information contained in the pleadings of a party be restricted.

With the new wording of Rule 262 the right reference is no longer Rule 262.1 but Rule 262.2.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 12a

Rule 76 – Actions for declaration of non-infringement within Article 33(6) of the Agreement

...

3. If the date attributed by the Registry to the action for infringement pursuant to Rule 17.1(a) is within three months of the date attributed to the action for declaration of non-infringement the panel of the central division shall stay all further proceedings in the action for a declaration. If the date attributed to the action for infringement is outside the said three month period there shall be no stay but the presiding judges of the central division and the local or regional division concerned shall consult to agree on the future progress of proceedings including the possibility of a stay of one action pursuant to Rule 295(~~f~~k).

...

Explanation

The change concerns an obvious drafting error.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 13

Rule 88 – Application to annul or alter a decision of the Office

1. The claimant shall lodge an Application at the Registry, in accordance with Article 7(2) of the Agreement and Annex II thereto, to annul or alter a decision of the Office in the language in which the patent was granted, within two months of service of the decision of the Office.

2. The Application to annul or alter a decision of the Office shall contain:

...

(j) a list of the documents, including any witness statements, referred to in the Application together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.~~1~~ or Rule 262A. Rule 13.2 and 3 shall apply *mutatis mutandis*.

...

Explanation

It is appropriate to add “or Rule 262A” at the end of this sub-rule. New Rule 262A deals with the Application to the Court for an order that certain information contained in the pleadings of a party be restricted.

With the new wording of Rule 262 the right reference is no longer Rule 262.1 but Rule 262.2.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 14

Rule 104 – Aim of the interim conference

The interim conference shall enable the judge-rapporteur to:

- (a) identify main issues and determine which relevant facts are in dispute;
- (b) where appropriate, clarify the position of the parties as regards those issues and facts;
- (c) establish a schedule for the further progress of the proceedings;
- (d) explore with the parties the possibilities to settle the dispute or to make use of the facilities of the Centre;
- (e) where appropriate, issue orders regarding 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;
- (f) where appropriate, but only in the presence of the parties, hold preparatory discussions with witnesses and experts with a view to properly preparing for the oral hearing;
- (g) make any other decision or order as he deems necessary for the preparation of the oral hearing including, after consultation with the presiding judge, an order for a separate hearing of witnesses and experts before the panel;
- (h) set a date for any separate hearing pursuant to point (g) of this Rule, ~~and~~ confirm the date for the oral hearing and order, where appropriate, after consultation with the presiding judge and the parties that the oral hearing or a separate hearing of witnesses and experts be wholly or partly by video conference in accordance with Rule 112.3;
- (i) decide the value of the action in accordance with Rule 370.6;
- (j) decide the value of the proceeding for the purpose of applying the scale of ceilings for recoverable costs (Rule 152.3);
- (k) order the parties to submit, in advance of the decision at the oral hearing, a preliminary estimate of the legal costs that they will seek to recover.

Relation with Agreement: Article 52(2)

Explanation

The proposed addition in Rule 112.3 creates the legal basis for the Court to conduct the oral hearing or parts thereof by videoconference in appropriate cases. The proposed addition in Rule 104(h) is to be understood as a supplement to this amendment. It shall be also an aim of the interim conference to discuss with the parties if the oral hearing or a separate hearing of witnesses and experts shall be held wholly or partly by video conference.

Amendment 15

Rule 112 – Conduct of the oral hearing

1. The oral hearing shall be held before the panel and shall be under the control of the presiding judge.

2. The oral hearing shall consist of:

(a) the hearing of the parties' oral submissions;

(b) ~~if ordered during the interim procedure,~~ the hearing of witnesses and experts under the control of the presiding judge.

3. The Court may decide to:

(a) allow a party, representative or accompanying person, to attend the oral hearing by videoconference,

(b) hear a party, witnesses or expert through electronic means, such as video conference or

(c) hold the oral hearing by videoconference if all parties agree or the Court considers it appropriate to do so due to exceptional circumstances.

In all cases, the oral hearing shall be transmitted simultaneously in picture and sound to the court room.

43. The presiding judge and the judges of the panel may provide a preliminary introduction to the action and put questions to the parties, to the parties' representatives and to any witness or expert.

54. Under the control of the presiding judge, the parties may put questions to the witness or expert. The presiding judge may prohibit any question which is not designed to adduce admissible evidence.

65. With the consent of the Court a witness may give evidence in a language other than the language of proceedings.

Relation with Agreement: Articles 52(3) and 53(1)

Explanation

The use of videoconferencing technology has gained importance during the COVID-19 pandemic and its associated restrictions. This also applies to court proceedings.

The current version of the Rules of Procedure only allow for the participation by video conference or other electronic means in specific circumstances. This applies to the interim hearing (Rule 105.1), to the examination of witnesses (Rule 178.6) and to enable a fair hearing (Rule 264) but there is no general rule for the main hearing. The proposed addition in Rule 112.3(a) and (b) enables the Court to also allow the parties, representatives, accompanying persons, witnesses and experts to participate in the oral hearing by videoconference. The proposed addition in Rule 112.3 (c) enables the Court, in addition, to conduct the whole oral hearing by videoconference if all parties agree or the Court considers it appropriate to do so in exceptional cases. Such exceptional circumstances could be, for example, travel restrictions or disproportionality (long journey for short and simple oral proceedings). Rule 112.3 Sentence 2 ensures that the principle of publicity is respected. As the proposed amendment to Rule 112 also applies to witnesses and experts the specific rule in Rule 178.6 seems superfluous and can be deleted.

Amendment 16

Rule 136 – Stay of the Application for a determination of damages

The Court may stay the Application for a determination of damages pending any appeal on the merits pursuant to Rule 295(gh) on a reasoned request by the unsuccessful party. The applicant shall be given the opportunity to be heard. If the Court continues the proceedings on the Application it may order the applicant to render a security according to Rule 352.

Explanation

The change concerns an obvious drafting error.

Amendment 17

Rules 173, 202, 150, 179 and 289

Rule 173 – Judicial Cooperation ~~between the courts of the Member States~~ in the taking of evidence

For the judicial cooperation in the taking of evidence ~~in the European Union~~, the Court shall apply any method provided by:

1. The Regulation (EU) No 2020/1783 / ~~the Regulation (EC) No 1206/2004~~, where it applies ~~shall apply~~;

2. The Hague Convention of 18 March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters, where it applies, or any other applicable convention or agreement; or

3. to the extent that there is no such convention or agreement in force, national law on the procedures to be followed for the judicial cooperation in the taking of evidence.

Rule 202 – Letters rogatory

deleted.

1. The Court may, of its own motion, but only after hearing the parties, or on a reasoned request by a party, issue letters rogatory for the production of documents or the hearing of witnesses or experts by other competent courts or authorities outside the European Union. Rule 180 shall apply.

2. The Court shall draw up letters rogatory in the language of the competent court or authority or shall attach to such letters a translation into that language.

3. Subject to paragraph 4, the competent court or authority shall apply national law as to the procedures to be followed in executing such requests and, in particular, as to the appropriate measures of compulsion.

4. The Court shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place. It may inform the parties, witnesses and experts concerned.

Rule 150 – Separate proceedings for cost decision

1. A cost decision may be the subject of separate proceedings following a decision on the merits and, if applicable, a decision for the determination of damages. The cost decision shall cover costs incurred in the proceedings by the Court such as costs for simultaneous interpretation and

costs incurred pursuant to Rules [173](#), 180.1, 185.7, 188, ~~and 201 and 202~~ and, subject to the Rules 152 to 156, the costs of the successful party including Court fees paid by that party [Rule 151(d)]. Costs for interpretation and translation which is necessary for the judges of the Court in order to conduct the case in the language of proceedings are borne solely by the Court.

...

Rule 179 – Duties of witnesses

1. Witnesses who have been duly summoned shall obey the summons and attend the oral hearing.

2. Without prejudice to paragraph 3, if a witness who has been duly summoned fails to appear before the Court or refuses to give evidence or to make the declaration referred to in Rule 178.1, the Court may impose upon him a pecuniary sanction not exceeding EUR50.000 and may order that a further summons be served at the witness's own expense. ~~The Court may send a letter rogatory to the competent national court pursuant to Rule 202.~~

...

Rule 289 – Privileges, immunities and facilities

1. Representatives appearing before the Court ~~or before any judicial authority to which it has addressed letters rogatory [Rule 202]~~ shall enjoy immunity in respect of words spoken or written by them concerning the action or the parties.

...

Explanation

The proposed Rule 173 aligns the taking of evidence by legal requests (“letters rogatory”) in another State (i.e. in other EU Member States or any other third State outside the EU) in one provision without making fundamental changes in substance. The proposed structure is based in part on the wording of Rule 274 on service of documents to enhance consistency of wording. Consequently, Rule 202 on letters rogatory which is covered by the instruments referred to in the proposed Rule 173 should be deleted.

According to the proposed Rule 173, evidence shall be taken as provided for in the regulation on the taking evidence (EU) No 2020/1783 or any applicable bilateral or

multilateral convention or agreement (numbers 1 and 2) and, where no such instruments apply, the national law of the state where the requesting court is located (number 3).

With regard to the applicable EU law (number 1), the proposed amendment provides a necessary update. Regulation (EC) No 1206/2001 is repealed and replaced by Regulation (EU) 2020/1783 as of 1 July 2022. As a result, and also in the light of the discussion with the European Commission, the reference to Regulation (EC) No 1206/2001 was deleted. The new Regulation (EU) 2020/1783 aims to improve and simplify judicial cooperation within the European Union. Articles 5 to 22 of the new EU regulation contain the provisions for the transmission and execution of requests. Article 19 regulates the direct taking of evidence in another EU Member State. Article 20 provides for taking of evidence by videoconferencing or other distance communications technology. The model forms for requests for the taking of evidence under the applicable EU regulation on the taking of evidence are available on the European e-Justice Portal (https://e-justice.europa.eu/76/EN/taking_of_evidence).

With regard to the taking of evidence outside the EU (number 2), The Hague Convention of 18 March 1970 on the Taking of Evidence Abroad in Civil or Commercial Matters (The Hague Evidence Convention) should be named explicitly as it is the most important international convention in this context. There are currently 64 Contracting Parties to this Convention, including Australia, China, the UK and the US (<https://www.hcch.net/en/instruments/conventions/status-table/?cid=82>). Model forms for letters of request under The Hague Evidence Convention are available for download in different languages on the website of The Hague Conference on Private International Law (<https://www.hcch.net/en/publications-and-studies/details4/?pid=6557&dtid=65>). The website also offers a „Guide to Good Practice on the Use of Video-Link under the Evidence Convention“ (<https://www.hcch.net/en/publications-and-studies/details4/?pid=7063&dtid=65>).

National law (number 3) shall be applied by a UPC division in case of judicial cooperation with a national court of the same State where the UPC division is located (the EU Evidence Regulation applies only to cross border scenarios) or where the requested court is a court of a third State not bound by any agreement or convention.

The applicable instrument provides for the transmission of the necessary information to the Court (see Article 14 paragraph 5 and Form I in Annex I of the new Evidence Regulation (EU) 2020/1783, Article 7 of The Hague Evidence Convention and

number 14 of the model forms for letters of request under The Hague Evidence Convention). The content of Rule 202 paragraph 4 becomes superfluous.

The reference to Rule 180 contained in the previous Rule 202 is not necessary. Rule 180 on the reimbursement of the expenses of a witness applies in all proceedings before the UPC including such expenses incurred by way of judicial cooperation. The applicable instruments in turn contain provisions for the reimbursement of such taxes or costs (see Article 22 of the new Evidence Regulation (EU) 2020/1783; Article 14 of The Hague Evidence Convention).

In consequence of the proposed repeal of Rule 202, Rule 150 paragraph 1 (separate proceedings for cost decision) should now refer to Rule 173 instead of Rule 202.

The references to Rule 202 in Rule 179 paragraph 2 (duties of witnesses) and Rule 289 paragraph 1 (privileges, immunities and facilities) should also be deleted, because privileges and duties of witnesses appearing before the foreign court are governed by the applicable convention or agreement respectively the relevant national law (see Article 11 of The Hague Evidence Convention) and not the UPC Rules of Procedure.

Amendment 18

Rule 178 – Hearing of witnesses

1. After the identity of the witness has been established and before hearing his evidence, the presiding judge shall ask the witness to make the following declaration:

"I solemnly, sincerely and truly declare and affirm that the evidence I shall give shall be the truth, the whole truth and nothing but the truth."

2. The witness shall give his evidence to the Court.

3. The hearing of a witness who has signed a written witness statement shall begin with the confirmation of the evidence given therein. The witness may elaborate on the evidence contained in his written witness statement.

4. The presiding judge and the judges of the panel may put questions to the witness.

5. Under the control of the presiding judge, the parties may put questions to the witness. The presiding judge may prohibit any question which is not designed to adduce admissible evidence.

~~6. The Court may allow a witness to give evidence through electronic means, such as video conference. Paragraphs 1 to 5 and 7 shall apply.~~

~~67.~~ With the consent of the Court a witness may give evidence in a language other than the language of proceedings.

Explanation

As the proposed amendment to Rule 112 also applies to witnesses and experts (see proposed Rule 112.3(b)) the specific rule for witnesses in Rule 178.6 becomes superfluous and can be deleted.

Amendment 19

Rule 194 – Examination of the Application for preserving evidence

1. The Court shall have the discretion - including where the Application is made pursuant to Rule 192.3 - to:

(a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an Objection to the Application for preserving evidence which shall contain:

(i) the reasons why the Application shall fail;

(ii) the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant;

(iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and an indication of the facts and evidence relied on in support;

(b) summon the parties to an oral hearing;

(c) summon the applicant to an oral hearing without the presence of the defendant;

(d) decide the Application without having heard the defendant.

...

4. In cases of extreme urgency the standing judge appointed in accordance with Rule 345.5 applicant may decide immediately apply without formality on for an Application order to preserve evidence to the standing judge designated in accordance with Rule 345.5. The standing judge shall decide and the procedure to be followed on the Application, which may include a subsequent written Application

...

Explanation

Rule 194.1

The amendment clarifies that the Court may hear the defendant also in ex parte proceedings. In such a case the applicant has the right to withdraw the Application according to paragraph 5 of the provision.

Rule 194.4

Rule 194.4 regulates how to deal with cases when a party files an Application for preserving evidence. The situation is comparable to the situation regulated in Rule 209.3 which deals with the Application for provisional measures. In both scenarios there might be cases that are extremely urgent. Therefore, both cases should be treated equally regarding the procedure to be followed for these Applications. To avoid interpretation difficulties this is clarified by the use of the wording contained in Rule 209.3.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 20

Rule 207 – Protective letter

...

3. The Protective letter may contain:

(a) an indication of the facts relied on, which may include a challenge to the facts expected to be relied on by the presumed applicant and/or, where applicable, any assertion that the patent is invalid and the grounds for such assertion;

(b) any available written evidence relied on;

(c) the arguments of law, including the reasons why any Application for provisional measures should be rejected.

4. The defendant or defendants filing the Protective letter shall pay the fee for filing a Protective letter, in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

5. The Registry shall as soon as practicable examine whether the requirements of paragraphs 2(a) to (f) and 3-4 have been complied with. If these requirements have been complied with, the Registry shall as soon as practicable:

(a) record the date of receipt and assign a number to the Protective letter;

(b) subject to paragraph 7, record the Protective letter in the register;

(c) provide details of the Protective letter to all divisions; and

(d) where an Application for provisional measures has already been lodged, inform the panel or the single judge dealing with the Application about the filing of the Protective letter.

6. If the defendant has not complied with the requirements of paragraph 2 the Registry shall as soon as practicable invite the defendant to:

(a) correct the deficiencies within 14 days of service of such notification; and

(b) where applicable, pay the fee referred to in paragraph 34.

...

Explanation

The respective references in Rule 207.5 and .6 relate to the requirement of paying the fee for filing a Protective letter, which is governed by Rule 207.4.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 21

Rule 209 – Examination of the Application for provisional measures

1. Without prejudice to the Court's decision on the Application for provisional measures, the Court shall have the discretion – including where the Application is made pursuant to Rule 206.3 – to:

(a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an Objection to the Application for provisional measures which shall contain:

(i) the reasons why the Application shall fail;

(ii) the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant; and

(iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and the facts and evidence relied on in support;

(b) summon the parties to an oral hearing;

(c) summon the applicant to an oral hearing without the presence of the defendant.

...

Explanation

The amendment clarifies that the Court may hear the defendant also in ex parte proceedings. In such a case the applicant has the right to withdraw the Application according to paragraph 4 of the provision.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 22

Rule 223 – Application for suspensive effect

1. A party may lodge an Application for suspensive effect, in accordance with Article 74 of the Agreement.
2. The Application for suspensive effect shall set out:
 - (a) the reasons why the lodging of the appeal shall have suspensive effect;
 - (b) the facts, evidence and arguments relied on.
3. The Court of Appeal shall decide the Application without delay.
4. In cases of extreme urgency the applicant may apply at any time without formality for an order for suspensive effect to the standing judge [Rule 345.5 and .8]. The standing judge shall have all the powers of the Court of Appeal and shall decide the procedure to be followed on the application, which may include a subsequent written Application.
5. There shall be no suspensive effect for an appeal of an order pursuant to Rule 220.2, [Rule 220.3](#) or [221.3](#).

Explanation

Rule 223.5 provides that there shall be no suspensive effect for an appeal pursuant to Rule 220.2 (procedural appeal with leave of CFI). It is appropriate that this should also apply to Rule 220.3 (discretionary review) and Rule 221.3 (costs appeal).

Amendment 23

Rule 238A – Decision to refer

...

2. The presiding judge of the panel shall request ~~that~~ the President of the Court of Appeal and the two judges of the Court of Appeal who are members of the Presidium to appoint the judges of the Court of Appeal to the full Court. The appointees shall be the President of the Court of Appeal and not less than ten (legally and technically qualified) judges of the Court of Appeal to represent the initial two panels of the Court of Appeal. In the event that the Court of Appeal shall have more than two panels the appointees to the full Court shall increase by five judges (legally and technically qualified), for each additional panel.

...

Explanation

The change corrects a drafting error.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 24

Rule 262 – Public access to the register

1. Without prejudice to Articles 58 and 60(1) of the Agreement and subject to Rules 190.1, 194.5, 196.1, 197.4, 199.1, 207.7, 209.4, 315.2 and 365.2, and following, where applicable, redaction of personal data within the meaning of Regulation (EU) 2016/679 and confidential information according to paragraph 2

(a) decisions and orders made by the Court shall be published.

(b) -written pleadings and, written evidence, decisions and orders lodged at or made by the Court and recorded by the Registry shall be available to the public upon reasoned request to the Registry; following, where applicable, anonymisation of personal data within the meaning of Regulation (EU) 2016/679. by the registry, The decision is taken by the judge-rapporteur after consulting the parties.

1a.2. unless a party may has requested that certain information of written pleadings or evidence be kept confidential and provided specific reasons for such confidentiality. To this end content of the register is made publicly available upon request according to paragraph 1 (b) only 14 days after it has been available to all recipients. The Registrar shall ensure that beyond this time period information subject of ~~such~~ a request for confidentiality shall not be made available pending an Application pursuant to paragraph 32 or an appeal pursuant to Rule 220.2. ~~When~~ a party lodges a requests that parts of written pleadings or ~~written~~ evidence shall be kept confidential, he shall also provide copies of the said documents with the relevant parts redacted when making the request.

32. A member of the public may lodge an Application with the Court for an order that any information excluded from public access pursuant to paragraph 24a may be made available to the applicant.

43. The Application shall contain:

(a) details of the information alleged to be confidential, so far as possible;

(b) the grounds upon which the applicant believes the reasons for confidentiality should not be accepted; and

(c) the purpose for which the information is needed.

54. The Court shall invite written comments from the parties prior to making any order.

65. The Court shall allow the Application unless legitimate reasons given by the party concerned for the confidentiality of the information outweigh the interest of the applicant to access such information.

76. The Registrar shall as soon as practicable take all such steps with regard to access to the register as may be necessary to give effect to an order of the Court under this Rule.

Relation with Agreement: Articles 10, 45, 58 and 60(1)

Relation with Statute: Article 24(2)

Explanation

When granting access to the UPC Register by the public the need for confidentiality has to be taken into consideration. The considerations are twofold: Documents may contain personal data protected by the General Data Protection Regulation (EU) 2016/679 (GDPR). Also, any other information like business or trade secrets which a party has a legitimate interest to be kept confidential must be withheld from public knowledge.

Protection of personal data (paragraph 1)

The Agreement on a Unified Patent Court lays down that the register kept by the Registry shall be public subject to conditions set out in the UPCA and the Rules of Procedure (Art. 10 (1) UPCA). Apart from the information of the public by way of publication of a collection of important UPC decisions this implies, in principle, that the public should be able to inspect the content of the register. On the other hand, the UPC is also bound by the rules of GDPR for which specific guidelines will lead the practical implementation by the UPC. Personal data of the parties and third parties must be protected when granting the public access to documents.

The GDPR applies not only to administrative but also to judicial activities of Courts. The UPC as a common Court of Member States is subject to the same obligations under Union law as any national Court, Articles 1 (2), 20, 24 (1) a UPCA. The GDPR-Guidelines apply this approach to the UPC including when it is acting in its judicial capacity.

Lawful processing requires under Article 6 (1) e GDPR that it is necessary for the performance of a task carried out in the public interest. In addition, according to Article 5 GDPR the processing shall be limited to what is necessary in relation to the purposes for which they are processed ('data minimisation'). The (online) publication of all personal data contained in case documents would not seem to be in line with these obligations.

While it is true that there is a general public interest in making the UPC register public, it is also true that the publication of personal data of the parties and third parties which enjoy a high level of protection does not seem mandatory under the UPC Agreement to achieve that aim. Against that background, the Court should not grant access to all documents to the public without taking precautions for the protection of the personal data of (third) parties.

To address this problem, personal data should be redacted before documents are made available to the public. The previously used term "anonymisation" within the

meaning of the GDPR is too strict and means that the information can no longer be traced back to an individual. In our case only the public shall not be able to take notice of the protected personal information. That does not apply to the Court in its official function which must be able to construe the information. Therefore, the term “anonymization” has been replaced by the term “redaction” which means that the information is rendered invisible to the public.

The proposed amendments distinguish between decisions and orders on the one hand and written pleadings and evidence on the other hand.

Decisions and orders - paragraph 1 (a)

Decisions and orders made by the Court shall be published. Their publication on the website is automatic. When preparing a decision or order the Court will – to the extent necessary – need to establish a redacted version for publication satisfying the requirements of the GDPR and confidentiality requests under paragraph 2.

Written pleadings and evidence - paragraph 1 (b)

Written pleadings and evidence of a specific case shall also be available to the public on a reasoned request to be decided by the judge-rapporteur. The CMS is configured in a way that the public can take note of the existence of documents and orders but not their contents. To see the contents of such documents an application procedure will be necessary. The requested information would be provided after the data check and, where applicable, the redaction of personal information.

Likewise, parts of the content classified as confidential information would be redacted in the documents to the public.

The UPC would with this approach follow the example practiced by the General Court (GC) and the Court of Justice of the EU (CJEU). Both courts have recognized that they are bound by the GDPR not only in their administrative, but also in their judicial activities. This follows from Art. 2 GDPR which does not exempt judicial activities from its scope of application. For this purpose, the courts are empowered to render a party concerned in the case anonymous either upon application by a party or of its own motion (cf. Art 95 RoP CJEU; Art. 66 RoP GC).

Request for confidentiality (paragraph 2)

The wording clarifies that a request for confidentiality is linked exclusively to the written pleadings and evidence. In the decisions and orders the Court out of its own motion will take confidentiality requests into consideration for the published version as specified in the chapeau of paragraph 1.

Another amendment in paragraph 2 is designed to make the procedure to claim confidentiality of submitted material practical. In order to allow the parties concerned to make a request for confidentiality the Registry shall not make content of the Register

available to the public until 14 days after all the recipients took note. This delay seems appropriate for both parties to decide if a request to withhold parts of the information from the public must be made. If a confidentiality request is pending the information will not be made public until a decision of the Court pursuant to paragraph 3 allows the Registry to do so.

Non-written evidence (paragraph 1 and 2)

Finally, non-written evidence should not be exempt from availability to the public. The word “written” should be deleted in paragraphs 1 and 2.

Amendment 25

Rule 262A – Protection of Confidential Information

1. Without prejudice to Article 60(1) of the Agreement and Rules 190.1, 194.5, 196.1, 197.4, 199.1, 207.7, 209.4, 315.2 and 365.2 a party may make an Application to the Court for an order that certain information contained in its pleadings or the collection and use of evidence in proceedings may be restricted or prohibited or that access to such information or evidence be restricted to specific persons.

2. The Application shall contain the grounds upon which the applicant believes the information or evidence in question should be restricted in accordance with Article 58 of the Agreement.

3. The Application shall be made at the same time as lodging a document containing the information or evidence and shall provide a copy of the unredacted relevant document and, if applicable, a copy of the redacted document.

4. The Court shall invite written comments from the representatives of the other parties prior to making any order.

5. The Court may allow the Application considering in particular whether the grounds relied upon by the applicant for the order significantly outweigh the interest of the other party to have full access to the information and evidence in question.

6. The number of persons referred to in paragraph 1 shall be no greater than necessary in order to ensure compliance with the right of the parties to the legal proceedings to an effective remedy and to a fair trial, and shall include, at least, one natural person from each party and the respective lawyers or other representatives of those parties to the legal proceedings.

7. The Registrar shall as soon as practicable take all such steps with regard to access to the evidence as may be necessary to give effect to the order of the Court under this Rule.

Relation with Agreement: Article 58

Explanation

Whilst Rule 262 lays down the general principle of availability of written pleadings, evidence, decisions and orders to the public and sets out the conditions for restriction of certain information from public knowledge, the new Rule 262A deals with the question of granting confidentiality of such information or the collection and use of evidence vis-à-vis the other party. Restricting information from the knowledge of the other party affects its right to a fair hearing, which is, inter alia, enshrined in Art. 76(2)

UPCA, Art. 47(2) of the Charter of Fundamental Rights of the European Union and Art. 6(1) of the European Convention on Human Rights. As a consequence, such restriction of information by Court order has to be limited to exceptional cases.

Paragraph 5 requires accordingly that the grounds for the confidentiality order significantly outweigh the interest of the other party to have unrestricted access. In line with Article 9 of the Directive (EU) 2016/943 of 8 June 2016 on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure, paragraph 6 provides that information may not entirely remain undisclosed to the other party of the lawsuit; at least the representative and one natural person named by that party shall be provided with the confidential information.

While the unredacted version is initially served for comments on the representative of the other party who, according to paragraph 6, will in any case have access to the confidential information, the redacted version will under paragraph 6 be provided by the Registrar to the other party with access restricted by court order and in such a cases also for the public access under Rule 262.

Amendment 26

Rules 270, 271, 272, 274, 275, 278

CHAPTER 2 – SERVICE

SECTION 1 – SERVICE WITHIN THE CONTRACTING MEMBER STATES

Rule 270 – Scope of this Section

1. For service of the Statement of claim within the Contracting Member States the law of the European Union on the service of documents in civil and commercial matters [Regulation (EU) 2020/1784 / Regulation (EC) No 1393/2007] and the rules set out in this Section, in particular Rule 271.2 and the Regulation (EC) No 1393/2007 shall apply.
2. For the purpose of Rules 270 to 275 the term Statement of claim shall, where appropriate, mean all originating pleadings in actions referred to in Article 32(1) of the Agreement.

Rule 271 – Service of the Statement of claim

~~1. For service within the Contracting Member States, the Registry may serve the Statement of claim on the defendant at an electronic address which the defendant has provided for the purpose of service in the proceedings, provided that the service is effected using appropriately high technical standards guaranteeing~~

- ~~(a) the identity of the sender;~~
- ~~(b) the safe transmission; and~~
- ~~(c) the possibility for the addressee to take notice of the documents.~~

~~A list of secure identification and transmission standards is contained in Annex I of the Rules of Procedure.~~

~~12. The Registry may shall, under the conditions of paragraph 1(a) to (c), serve the Statement of claim by electronic means if the conditions referred to in Article 19 of the Regulation (EU) 2020/1784 are met where:~~

- ~~(a) on the defendant at an electronic address which the defendant has provided for the purpose of service in the proceedings; or~~
- ~~(b) on a representative of the defendant if the defendant has provided the electronic address of a representative pursuant to Rule 8.1 as an address at which the defendant may be served with the Statement of claim; or~~

~~(c) on a representative of the defendant pursuant to Rule 8.1 if the representative has notified the Registry or the claimant that he accepts service of the Statement of claim on behalf of the defendant at an electronic address.~~

~~5~~

~~at the electronic address of that representative.~~

2. Where a representative pursuant to Rule 8.1 accepts service on behalf of a party defendant service may be effected within the closed electronic system of the UPC Case Management System (CMS).

3. For the purpose of serving a Statement for revocation [Rule 44] or of serving a Statement for declaration of non-infringement [Rule 63], reference to representative under paragraph 2(~~ba~~) or (~~cb~~) shall additionally include professional representatives and legal practitioners as defined in Article 134 EPC who are recorded as the appointed representative for the patent, the subject of the proceedings, in the Register for unitary patent protection [Regulation (EU) No 1257/2012, Article 2(e)] or in the national patent register [Rule 8.5(a)].

4. Where service by ~~means of~~ electronic ~~meanse~~communication cannot be effected, the Registry shall serve the Statement of claim on the defendant by:

(a) any other method foreseen by the law of the European Union EU law on the service of documents in civil and commercial matters [Regulation (EU) 2020/1784 / Regulation (EC) No 1393/2007] in the Regulation (EC) No 1393/2007, in particular by registered letter ~~according to Article 14 of that regulation~~ with acknowledgement of receipt or equivalent advice of delivery [Article 18 Regulation (EU) 2020/1784]; or

~~(b) fax provided that the requirements of paragraph 1(a) to (c) are observed; or~~

~~(eb)~~ where service in accordance with paragraphs 4(a) ~~and 4(b)~~ could not be effected any method permitted by the law of the Member State of the European Union where service is to be effected or authorised by the Court under Rule 275.

5. Service under this Section~~paragraph 4(a)~~ shall be effected at the following place:

(a) where the defendant is a company or other legal person, at its statutory seat, central administration or principal place of business within the Contracting Member States or at any place within the Contracting Member States where the company or other legal person has a permanent or temporary place of business;

(b) where the defendant is an individual, ~~at~~ at his usual or last known residence within the Contracting Member States; or

(c) for the purpose of serving a Statement for revocation [Rule 44] or of serving a Statement for a declaration of non-infringement [Rule 63], at the place of business of a professional representative or legal practitioner as defined in Article 134 EPC who is recorded as the appointed representative for the patent, the subject of the proceedings, in the Register for unitary patent protection [Regulation (EU) No 1257/2012, Article 2(e)] or of the patent office of a Contracting Member State.

6. Subject to Rule 272.2 and .3, a Statement of claim served in accordance with paragraphs 1 to 5 is deemed to be served on the defendant:

(a) where service takes place by means of electronic communication ~~or by fax~~, on the day when the relevant electronic message was sent ~~or the transmission of the fax was completed~~ (GMT+1); ~~or~~

(b) where service takes place by registered letter with acknowledgement of receipt or equivalent with advice of delivery such letter shall be deemed to be served on the addressee on the tenth day following posting unless it has failed to reach the addressee, has in fact reached

him on a later date or the acknowledgement of receipt or equivalent advice of delivery has not been returned. Such service shall, except where paragraph 87 applies, be deemed effective even if acceptance of the letter has been refused.

7. The Registry shall advise the defendant that he may refuse to accept a Statement of Claim if it is not written or not accompanied by a translation into a language that he understands or that is an official language of the place where service is to be effected, by enclosing with the document to be served form L in Annex I of Regulation (EU) 2020/1784.

8. Where the defendant is entitled to refuse service according to Article 8 of the Regulation (EC) No 1393/2007 and where he has notified the refusal to the Registry within one two weeks of the attempted service together with an indication of the language(s) he understands, the Registry shall inform the claimant. The claimant shall provide to the Registry translations of at least the Statement of claim and the information required in Rule 13.1(a) to (p) in a language provided for by paragraph 7 Article 8(1)(a) or (b) of the Regulation (EC) No 1393/2007. For the determination of the date of service Articles 8(3) and 9 of the Regulation (EC) No 1393/2007 shall apply. When serving the Statement of claim the defendant shall be informed of these rights.

Rule 272 – Notice of service and non-service of the Statement of claim

1. The Registry shall inform the claimant of the date on which the Statement of claim is deemed served under Rule 271.6.

2. Where the Registry has served the Statement of claim by registered letter with acknowledgement of receipt or equivalent advice of delivery and the Statement of claim is returned to the Registry for any reason, the Registry shall inform the claimant.

3. Paragraph 2 shall apply *mutatis mutandis* where the Registry has served the Statement of claim by means of electronic communication or fax and the relevant electronic message or fax appears not to have been received.

SECTION 2 – SERVICE OUTSIDE THE CONTRACTING MEMBER STATES

...

Rule 274 – Service outside the Contracting Member States

1. Where a Statement of claim is to be served outside the Contracting Member States, it may shall be so served by the Registry

(a) by any method provided by:

(i) The law of the European Union on the service of documents in civil and commercial matters [Regulation (EU) 2020/1784 / Regulation (EC) No 1393/2007] in EU law the Regulation (EC) No 1393/2007 where it applies; respecting the rights of the recipient granted by the Regulation;

(ii) The Hague Service Convention or any other applicable convention or agreement where it applies; or

(iii) to the extent that there is no such convention or agreement in force, either by service through diplomatic or consular channels from the Contracting Member State in which the sub-registry of the relevant division is established;

(b) where service in accordance with paragraph 1(a) could not be effected by any method permitted by the law of the state where service is to be effected or as authorised by the Court under Rule 275.

2. No Statement of claim may be served under this Rule 274 in a manner which is contrary to the law of the state where service is effected.

3. The Registry shall inform the claimant of the date on which the Statement of claim is deemed served under paragraph 1.

4. The Registry shall inform the claimant if for any reason service pursuant to paragraph 1 cannot be effected.

SECTION 3 – SERVICE BY AN ALTERNATIVE METHOD

Rule 275 – Service of the Statement of claim by an alternative method or at an alternative place

1. Where ~~service in accordance with Section 1 or 2 could not be effected it appears to~~ the Court on an application by the claimant that there is a good reason to authorise service by a method or at a place not otherwise permitted by this Chapter, the Court may by way of order permit service by an alternative method or at an alternative place.

2. On a reasoned request by the claimant, the Court may order that steps already taken to bring the Statement of claim to the attention of the defendant by an alternative method or at an alternative place is good service.

3. An order under this rule shall specify:

(a) the method or place of service;

(b) the date on which the Statement of claim is deemed served; and

(c) the period for filing the Statement of defence.

4. No order for alternative service under this Rule shall be made permitting service in a manner that is contrary to the law of the state where service is to be effected.

SECTION 4 – SERVICE OF ORDERS, DECISIONS AND WRITTEN PLEADINGS

...

Rule 278 – Service of written pleadings and other documents

1. 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 an ex parte proceeding.

2. Where service by means of electronic communication cannot be effected, the Registry shall serve the written pleadings on the party by:

(a) registered letter with acknowledgement of receipt or equivalent~~vice of delivery~~; or

~~(b) fax; or~~

(b) any method authorised by the Court under Rule 275.

3. Service under paragraph 2(a) shall be effected at the following place:

(a) where the party is a company or other legal person: at its statutory seat, central administration, principal place of business or at any place within the Contracting Member States where the company or other legal person has a place of business;

(b) where the party is an individual: at his usual or last known residence within the Contracting Member States.

4. Rule 271.6 and 272 shall apply *mutatis mutandis*.

5. Where a party is represented pursuant to Rule 8.1, the pleadings and other documents referred to in paragraph 1 shall be served on that representative. Paragraph 2 shall apply *mutatis mutandis*.

Explanation

A revision of Part 5, Chapter 2 on the service of documents is necessary to align the Rules of Procedure with new EU-law in this area. The Regulation (EU) 2020/1784 of 25 November 2020 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (recast) replaces Regulation (EC) No 1393/2007 which was the point of reference at the time when the draft Rules of Procedure had been prepared. As a result, and also in the light of the discussion with the European Commission, the reference to Regulation (EC) No 1393/2007 was deleted. The current service regulation in particular contains provisions on the secure electronic service and therefor makes specific rules for the UPC superfluous which so far had been included in Rule 271.

Rule 270

Rule 270 should clearly define its scope of application, hence its applicability for service of the Statement of claim within the Contracting Member States. At the same token these rules are also made applicable to cases in which service must be effected in the same state in which the division of the UPC which is serving a document is

located. The wording should further reflect the relationship between applicable EU-Law and the provisions set forth in this Section 1 of Chapter 2. As a general rule the law of the European Union on the service of documents in civil and commercial matters [the Regulation (EU) 2020/1784] shall apply to the service of the statement of claim within the Contracting Member States, however taking into account the simplifications made by Section 1. According to Article 29 paragraph 2 of the Regulation (EU) 2020/1784 the EU Member States are free to conclude agreements to expedite or further simplify the transmission of documents, which are compatible with the Regulation.

The Rule makes a general reference to the law of the European Union on the service of documents in order to be flexible to future changes of the applicable Regulations. Regulation (EU) 2020/1784 has entered into force and will be applicable as from 1 July 2022. From that date the Regulation (EC) No 1393/2007 is in principle repealed; some provisions will remain applicable for some time (cf. Articles 36, 37 Regulation (EU) 2020/1784).

Finally, with respect to service by the UPC, in the light of the exchange with the European Commission, it is clarified in Rule 270.1 that Rule 271.2 on the service within the closed Case Management System of the UPC is *lex specialis* to the Regulation (EU) 2020/1784.

Rule 271

Rule 271.1 (new)

The requirements which a secure system must meet to be used for service are no longer defined by the Rules of Procedure but are now included in EU law referred to in Rule 271.1.

Regulation (EU) 2020/1784 sets forth the conditions under which service of judicial documents may be effected directly on a person by electronic means. According to Rule 271.1(a) electronic service directly on the defendant is explicitly allowed, as provided for in Article 19.1 of the Regulation (EU) 2020/1784. This includes two options: Service can be effected using a qualified electronic registered delivery services if the defendant has consented to it (Article 19 (1), (a)). Such secure systems need to meet the standards contained in Regulation (EU) No 910/2014. The document served electronically must use a trust service provider established by the EU or an electronic identification scheme notified by a Member State (Article 2 (1) Regulation (EU) No 910/2014). A list of systems is published by the Commission under Article 9 (2) Regulation (EU) No 910/2014. The requirements for electronic signatures are contained in Articles 25 et sqq. of Regulation (EU) No 910/2014. A list of possible systems will not be drawn up by the Registrar as formerly provided for by the Rules of Procedure but established according to Union law. A second possibility in Article 19

(1) (b) Regulation (EU) 2020/1748 provides for service by simple email where the addressee has consented to it and he confirms receipt of the document with an acknowledgement of receipt, including the date of receipt.

Rule 271.1(b) – (c) continues to provide for the possibility to serve a document at the representative of a party.

Rule 271.2 new

This provision being *lex specialis* to Regulation (EU) 2020/1784 has been included to clarify that service on a representative may be effected within the closed system of the Court's CMS. Each representative within the CMS has an account in which documents directed to the representative can be viewed and downloaded. According to Article 2 (2) of Regulation No 910/2014 said regulation does not apply to services that are used exclusively within closed systems resulting from national law or from agreements between a defined set of participants.

The basis for this service is Article 29 para 2 of regulation (EU) 1784/2022; it works in the same manner as service is effected by the European Court of Justice in its internal system.

Furthermore, it was clarified that if the representative of any party – not only the defendant's representative – accepts service on behalf of the party the service may be affected within the UPC's CMS.

Rule 271.4

In Rule 271.4 (a) a reference to further ways of service contained in EU-law other than electronic service is made. One possibility is mentioned explicitly, postal service by registered letter with acknowledgement of receipt or equivalent. There are also further possibilities such as using receiving agencies in other EU Member States, diplomatic service or direct service (Articles 8 et sqq., 17, 20 Regulation (EU) 2020/1784).

Rule 271.6

Given the technical development service via fax seems no longer appropriate (see also Rules 271.6, 272 and 278).

Rule 271.7 (new)

The obligation of the Registry to advise the recipient of its rights granted by the applicable EU-Law shall be mentioned explicitly. The Registry shall make use of the forms provided by the applicable law of the European Union on the service of documents [Regulation (EU) 2020/1784] as far as relevant.

Rule 271.8

The wording has to be adjusted with regard of the introduction of Rule 271.7 (new).

Rule 274

Section 2 applies to the service of a Statement of claim outside the Contracting Member States, this includes EU Member States and non-EU Member States.

R. 274.1 (a)(i)

Service of a Statement of claim outside the Contracting Member States but within a EU-Member State may be provided by any method allowed by the applicable law of the European Union on the service of documents in civil and commercial matters [Regulation (EU) 2020/1784]. The use of the closed electronic system of the UPC Case Management System (CMS) shall also be available.

Rule 275

New wording shall avoid any doubts about the relationship of Section 1 and 2 with Section 3. Service by an alternative method or at an alternative place may, according to Rule 275, only be ordered if service by any method set forth in Section 1 or 2 could not be effected. This understanding is reflected by Rule 271.4(b) and Rule 274.1 (b).

General

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 27

Rule 285 – Powers of attorney

1. A representative who claims to be representing a party shall be accepted as such provided however the Court may order a representative to produce a written authority if his representative powers are challenged.

2. In the event of a successful challenge to a representative's authority pursuant to paragraph 1 the Court may make an order pursuant to Rule 291.

Explanation

The court must have the power to exclude a representative from the proceedings following a successful challenge to his authority.

Amendment 28

Rule 292 – Patent attorneys’ right of audience

1. For the purposes of Article 48(4) of the Agreement, the term "patent attorneys" assisting a representative referred to in Article 48(1) and/or (2) of the Agreement shall mean persons meeting the requirements of Rule 287.6(b) or .7 and practising in a Contracting Member State.

2. Such patent attorneys shall be allowed to speak at hearings of the Court at the discretion of the Court and subject to the representative’s responsibility to coordinate the presentation of a party’s case.

3. Rules [285 and](#) 287 to 291 shall apply *mutatis mutandis*.

Relation with Agreement: Article 48(4)

Explanation

Rule 292 concerns Patent Attorneys who are not representing a party before the UPC but assisting a party’s representative. The amendment allows the Court to order the assisting Patent Attorney to produce a corresponding mandate.

Amendment 28a

Rule 294 – Removal from the register of representatives

An Application to remove a representative's name, being a representative qualified pursuant to Article 48(1) of the Agreement, from the register of representatives may be made:

(a) by the representative himself in the event he retires or for any other reason ceases to satisfy the requirements of Rule 286;

(b) by a representative on behalf of a listed representative who has died.

Explanation

The newly created rule provides a basis for removing a lawyer's name from the listed representatives. There is no need for a corresponding rule for patent attorneys. The Rules on the European Patent Litigation Certificate and Other Appropriate Qualifications Pursuant to Article 48(2) of the Agreement on a Unified Patent Court (EPLC) include a provision dealing with this issue (Rule 16).

Amendment 29

Rule 295 – Stay of proceedings

The Court may stay proceedings:

(a) where it is seized of an action relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings) before the European Patent Office or a national authority where a decision in such proceedings may be expected to be given rapidly;

(b) where it is seized of an action relating to a supplementary protection certificate which is also the subject of proceedings before a national court or authority;

(c) where an appeal is brought before the Court of Appeal against a decision or order of the Court of First Instance:

(i) disposing of the substantive issues in part only;

(ii) disposing of an admissibility issue or a Preliminary objection;

(d) at the joint request of the parties;

(e) pursuant to Rule 37;

(f) pursuant to Rules 75 and 76;

(g) pursuant to Rule 118;

(h) pursuant to Rule 136;

(i) pursuant to Rule 266;

(j) pursuant to Rules 310 and 311;

(k) pursuant to Rule 346;

~~(k)~~ to give effect to Union law, in particular the provisions of Regulation (EU) No 1215/2012 and the Lugano Convention;

~~(m)~~ in any other case where the proper administration of justice so requires.

Explanation

The amendment in (f) concerns an obvious drafting error. The insertion of (k) is a consequence of the proposed redraft of Rule 346.

Amendment 30

Rule 345 – Composition of panels and assignment of actions

1. The President of the Court of First Instance or a judge to whom he has delegated this task in a division, the seat of the central division or one of its sections shall allocate the judges to the panels of the local and regional divisions, the seat of the central division and its sections.
2. The allocation shall be in conformity with Article 8 of the Agreement.
3. The actions pending in the division, the seat of the central division or one of its sections shall be assigned to the panels by the Registrar following an action-distribution-scheme established by the presiding judge of each local or regional division, the seat of the central division and its sections (being the judge appointed by the Presidium as the presiding judge) for the duration of one calendar year, preferably distributing the actions according to the date of receipt of the actions at the division or section.
4. Each panel may delegate to one ~~o~~for more judges of the panel:
 - (a) the function of acting as a single judge; or
 - (b) the function of acting for the panel in the procedures of Part 1 Chapter 4 (Procedure for the Determination of Damages and Compensation, including the procedure for the laying open of books) and Chapter 5 (Procedure for Cost Decisions). These functions may be delegated to the judge-rapporteur who has prepared the action for the oral hearing.

...

Explanation

The amendment corrects an obvious error.

The dotted line (...) has been included for the purpose of presentation only and indicates wording in which no changes have been made.

Amendment 31

Rule 346 – Application of Article 7 of the Statute

~~1. If a party objects to a judge taking part in proceedings pursuant to Article 7(4) of the Statute, the presiding judge of the local or regional division to which the judge is allocated or, if the action is pending before the seat of the central division or one of its sections, the respective presiding judge shall, after hearing the judge concerned, decide whether the objection is admissible having regard to Article 7(2) of the Statute.~~

~~2. If the objection is admissible, the respective presiding judge shall refer the action to the Presidium which shall hear the judge concerned and shall decide whether the objection shall stand or not.~~

~~3. Paragraphs 1 and 2 shall apply to a judge of the Court of Appeal. The presiding judge of the panel shall perform the functions attributed to the presiding judge of the division, the seat of the central division or one of its sections in these paragraphs.~~

1. A party who believes to have reason to object to a judge taking part in proceedings pursuant to Article 7(4) of the Statute shall as soon as is reasonably practicable in the circumstances notify the President of the Court of First Instance or the President of the Court of Appeal wherever the case is pending that it objects to the judge taking part in the proceedings.

2. ~~2.~~ Any failure to notify an objection as soon as is reasonably practicable shall amount to a waiver of such objection.

3. The President concerned shall, after hearing the judge involved, decide whether the objection is valid pursuant to Article 7(2) and (4) of the Statute and considering the circumstances.

4. In case of any difficulty within the meaning of Article 7(5) of the Statute the President concerned shall refer the matter to the Presidium.

5. If it is decided that the objection is valid the judge concerned shall be replaced on the panel of judges allocated to the case concerned.

6. The panel assigned to the proceedings may decide to continue with the proceedings or to stay the proceedings pending the final decision of the President concerned or the Presidium. The President concerned or the Presidium may give instructions in the final decision as to the future conduct of the proceedings.

Relation with Statute: Article 7

Explanation

The changes of this Rule bring it into line with the corresponding provisions of Article 7 of the Statute of the Unified Patent Court. A more detailed procedure to follow in such cases is provided. Paragraph 2 prevents a party from raising objections at a late stage of the proceedings on tactical grounds even though the reasons for objecting to the impartiality of a judge are already known to that party. In order to provide flexibility, paragraph 6 enables the panel to decide whether to continue with the proceedings or stay them, pending the decision of the President or Presidium, respectively. This flexibility ensures that the proceedings can continue when the party is unlikely to succeed with its objections.

Amendment 31a

Rule 355 – Decision by default (Court of First Instance)

1. Upon request a decision by default may be given against a party where:

(a) the Rules of Procedure so provide if a party fails to take a step within the time limit foreseen in these Rules or set by the Court; or

(b) without prejudice to Rules 116 and 117, the party which was duly summoned fails to appear at an oral hearing.

2. A decision by default against the defendant of the claim or counterclaim may only be given where the facts put forward by the claimant justify the remedy sought and the procedural conduct of the defendant does not preclude to give such decision.

3. A decision by default against the defendant of the claim or counterclaim may only be given where the time limits for the defence to the claim or counterclaim have expired and thus, it is established that the service of the claim or counterclaim was effected in sufficient time to enable the defendant to enter a defence.-

4. A decision by default shall be enforceable. The Court may, however:

(a) grant a stay of enforcement until it has given its decision on any Application under Rule 356; or

(b) make enforcement subject to the provision of security; this security shall be released if no Application is made or if the Application fails.

Explanation

Rule 355.2

In the light of the discussions with the European Commission it is clarified that not every failure to take a step within the time limit foreseen in these Rules or set by the Court results in a decision by default. Since such default judgments have far reaching consequences on the right of the defence of the defaulting party, it is clarified that pursuant to this provision such decisions by default can only be given with due consideration to the overall procedural conduct of the defendant in that specific case. Unless there is evidence that the failure was only a mere oversight and happened accidentally a decision by default can be given.

Rule 355.3

In the light of the discussion with the European Commission it is clarified that the defendant of the claim or counterclaim has sufficient time to enter a defence since the given time limits of 355.3 start to run with the effective service (Rule 23, 29 and 67).

Amendment 32

Rule 370 – Court fees

...

3. In addition to the fixed fee a value-based fee shall be paid in accordance with Section II (value-based fees) of the table of fees for those actions at the Court of First Instance set out in paragraph 2, which exceed a value of 500,000 EUR.

...

5. For the following procedures at the Court of Appeal a fixed fee and, where applicable, a value based fee shall be paid in accordance with Section IV. of the table of fees:

(a) Appeal pursuant to Rule 220.1 (a) and (b) [Rule 228],

(b) Interlocutory appeal pursuant to Rule 220.1(c), or appeal with leave of the Court of First Instance pursuant to Rule 220.2 or allowance by the Court of Appeal pursuant to Rule 220.2 Rule 220.4 or appeal of a cost decision with leave of the Court of Appeal pursuant to Rule 221.4 [Rule 228],

(c) Application for leave to appeal against cost decision pursuant to Rule 221 [Rule 228],

(d) Request for discretionary review pursuant to Rule 220.3 [Rule 228],

(e) Application for re-establishment of rights [Rule 320.2],

(f) Application to review a case management order pursuant to Rule 220.2 [R. 333.3],

(g) Application to set aside decision by default pursuant to Rule 357 [Rule 356.2],

(h) Application for rehearing pursuant to Rule 245.2 [Rule 250].

...

Explanation

Rule 370.3

The grouping of digits in “500 000 EUR” has to be marked by a comma.

Rule 370.5

The Rules of Procedure provide for a fee for all appeals listed in Rule 220.1(a) to (c). Although there is no extra fee for an appeal (concerning all other orders) pursuant to Rule 220.2 after a request for discretionary review has been granted by the Court of Appeal, the Rules of Procedure foresee a fee for the discretionary review itself in Rule 370.5(d). Therefore, it is justified to also levy a fee on an appeal (concerning all other orders) pursuant to Rule 220.2, for which leave has been granted by the Court of First Instance or allowed by the Court of Appeal. In the table of fees, it is made clear that the applicant only has to pay the fee pursuant to Rule 370.5(d) if the appeal is not allowed. Otherwise the Applicant has to pay the (higher) fee pursuant to new Rule 370.5(b).

In the same vein, it is appropriate to levy a fee on an appeal against a cost decision for which leave has been granted by the Court of Appeal pursuant to Rule 221.4 as the Rules of Procedure foresee a fee for the application for leave itself in Rule 370.5(c). In the table of fees, it is made clear that the applicant only has to pay the fee pursuant to Rule 370.5(c) if the appeal is not allowed. Otherwise the Applicant has to pay the (higher) fee pursuant to new Rule 370.5(b).

In paragraph 5 (c) the full stop and the hyphen after the word “Rule” must be deleted.

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Amendment 33

Rules 379 and 381

Rule 379 – Examination and decision

1. The Registry shall examine the formal admissibility of the application for legal aid and the conditions regarding the financial situation of the applicant pursuant to Rules 377.1(a), .2 and 377A.
2. If the requirements referred to in Rules 377.1(a), .2, 377A, 378 and 378A have not been met, the applicant shall, as soon as practicable, be invited to correct the deficiencies within 14 days.
3. If the requirements referred to in Rules 377.1(a), .2, 377A, 378 and 378A have been met, or, the applicant fails to correct a deficiency, the decision on such application shall be taken, by way of order, by the judge-rapporteur or, where the application is lodged before the action has been brought, by the standing judge.
4. Before making a decision on an application for legal aid, the Court shall invite the other party to submit written observations unless it is already apparent from the information submitted that the conditions referred to in Rule 377.1(b) have not been met. Documents regarding the economic and financial situation of the applicant shall be made accessible to the other party only where the applicant has consented or the applicant's refusal of consent is unreasonable or in the view of the Court the other party has a right to information on the economic or financial situation of the applicant.
5. An order refusing legal aid shall state the reasons on which it is based.
6. An order granting legal aid may provide for:
 - (a) an exemption, wholly or partly, from Court fees;
 - (b) an interim amount to be paid to enable the applicant and/or the representative of the applicant to meet any request of the judge-rapporteur or standing judge prior to making a final order;
 - (c) an amount to be paid to the representative of the applicant or a limit which the representative's disbursements and fees may not exceed;
 - (d) a contribution to be made by the applicant to the costs referred to in Rule 376.1(c).
7. Legal aid may be granted only for the period from receipt of the application with the Court.
8. Where the legal aid covers, in whole or in part, the costs of legal assistance and representation the order granting legal aid shall designate the representative of the applicant.
9. On a request by the designated representative, the Court may order that an amount shall be paid by way of advance.
10. Where requested by the applicant in accordance with Rule 378.2(h), the Court shall decide on the suspension of any time limit.

Rule 381 – Appeal

1. An order wholly or partly refusing or withdrawing legal aid may be appealed to the Court of Appeal. The appeal shall be filed with the Court of Appeal within a period of one month after receiving the order- and satisfy The Court of Appeal may grant legal aid for the conduct of the appeal pursuant to the provisions of Rules 377 to 379. The President of the Court of Appeal shall appoint a panel which shall decide on the appeal having heard the applicant.

2. An application for legal aid to appeal a decision of the Court of First Instance shall be filed with the Court of Appeals and shall satisfy the provisions of Rules 377 to 379. The Application for legal aid to bring an appeal against a decision of the Court of First Instance shall be filed within the time limit provided for the appeal as specified in Rule 224 and should, where possible, be accompanied by the appeal itself. The Application shall be assigned according to Rule 345.8.

Explanation

Rule 379

The amendment in Rule 379.3 clarifies the procedure to follow where an applicant does not correct a deficiency at the invitation by the Registry under paragraph 2 of that Rule.

In such a case no decision by default is applied which is reserved for decisions on the patent itself. Instead the Court follows the procedure laid down in Rule 379.3 and examines the request for legal aid. If the applicant indeed has failed to correct a deficiency within the time limit set out in Rule 379.2 with regard to a relevant point, the requirements for legal aid are not met and the application will be rejected by the judge.

Rule 381

In Rule 381 the addition in para 1 clarifies the procedure to follow in case of an appeal against the order of the Court of First Instance refusing or withdrawing legal aid stating which body within the Court of Appeal shall decide on an appeal. The applicant has to be heard before taking the decision. Since Rule 220 which is tailored for an *inter partes* appeal in patent proceedings does not apply for the appeal against a decision on legal aid by the Court of First Instance an explicit rule for the procedure had been missing.

The amendment seeks clarification that legal aid, in fact, is available in two scenarios.

The first scenario addressed in Rule 381.1 concerns an appeal where the first instance decision refused to grant legal aid. Also, the wording had been misleading. In this scenario there is no “legal aid for legal aid”. However, if legal aid is granted by the Court of Appeal it covers also these costs in accordance with Rule 376.1(b).

Rule 381.2 deals with legal aid for an appeal against a decision of the Court of First Instance and clarifies that according to Rule 375.2 and Rule 378.4 it is possible to apply for legal aid in order to appeal a decision of the Court of First instance. Since a new application has to be filed (Rule 378.4) this application has to meet requirements of Rules 377 to 379 which is clarified in the first sentence of Rule 381.2. Furthermore, since Rule 224 applies only to the appeal against the decision of the Court of First instance itself, Rule 381.2 clarifies in the second sentence that the application for legal aid has to be filed where possible within the same time limit than the appeal itself. According to Rule 381.3 Rule 345.8 is applicable in order to determine the judge (standing judge if no appeal was filed so far, judge-rapporteur if the appeal was filed before or at the same time) dealing with the application for legal aid.