Institut der beim Europäischen Patentamt zugelassenen Vertreter

Institute of Professional Representatives before the European Patent Office

Institut des mandataires agréés près l'Office européen des brevets

Subject: The European and European Union Patents Court (EEUPC)

By: *epi*

To: European Commission, EU ES Presidency, EU BE Presidency

Summary: We believe that the draft Agreement on the Court, as further specified by the "Main Features of the European and EU Patents Court" of the Council Conclusions adopted on 4 December 2009 (17229/09, 7 December 2009), can provide significant benefits for European enterprise. We appreciate that significant compromises must be made if the proposal is going to be accepted and the Agreement ratified. However we would like to make submissions on certain features of the draft.

Documents: Council Working Document 7928/09, 23 March 2009
Council Note 17229/09, 7 December 2009

Date: 21.06.2010

***epi* Position**

Draft Agreement EEUPC: 7928/09, 23.03.2009; 17229/09, 07.12.2009

Articles 14a to 14e and Article 38a

1. Articles 14c to 14e deal with the infringement of EPC bundle patents and set out specifically what infringes and what does not infringe. Article 14a brings in the EU Patent but refers to the EU Patent Council Regulation for that purpose. Article 38a deals with the revocation of patents but Article 38a(2) refers to two separate instruments, the EEUPC Agreement for European bundle patents and the Regulation for the EU Patent. As the EU patent is only one branch in a European bundle patent, the present draft of the Agreement would require the courts to review two different instruments to determine the provisions for the same text. Including the requirements in two different instruments risks discrepancies, with no benefit. We suggest that there be in the agreement a unified set of provisions for both bundle patents and EU Patents and that the provisions for infringement and revocation of EU Patents be removed from the draft EU Patent Regulation and put in the present agreement The courts would then only have to consult the present Agreement to determine the law in respect of all patents being litigated.

Articles 14c to 14f – and accessory liability

2. We suggest that the draft Agreement include a provision dealing with accessory liability, to the exclusion of any national law. Accessory liability is the legal principle under which a person (an accessory) other than the person who actually commits the act of infringement can be held liable for the infringement, for example where the accessory procures or participates in the act of infringement.

Article 14e, limitations of the effects of the European patent

3. This is not precisely as recited in Article 9/1 of the draft EU Patent Regulation and there is no reference to Government Use or Community Exhaustion.

Article 14f, right based on prior use of the invention

4. This is not precisely as recited in Article 12 of the draft EU Patent Regulation. There is no reference to entitlement, c.f. Article 5 of the draft EU Patent Regulation.

Article 15(a)(1) – jurisdiction of the divisions, and consolidating actions

5. Problems are seen in the operation of Art. 15a(b) in certain circumstances. It is assumed that if there are two defendants of different domicile, the first defendant would determine the division. However if separate actions are initiated on the same day against two defendants of different domicile, it is desirable to have a procedure for consolidating the actions and determining which division should hear the consolidated action.

Article 15(a)(2)(b), split jurisdiction

6. Though we are unhappy with the proposal as a matter of principle, we agree that it is acceptable as a political compromise.

Article 15a(2)(b)(ii), referring a counterclaim to the central division

7. We suggest that if the counterclaim is referred to the central division, the infringement action should be stayed until the counterclaim had been determined.

Articles 15(a)(4) and 15(a)(5), counterclaims

8. According to the present provision, if a revocation action or an action for a declaration of non-infringement is pending before the central division, any later infringement claim can be initiated in a local or regional division, though the local or regional division can refer it to the central division (Article 15a(2)(b)) or the parties can agree to refer the case to the central division (Article 15a(2)(c)). We suggest that if a case is pending before the central division, any counterclaim (which would normally be for infringement) should be dealt with by the central division, to avoid the expense and extreme inconvenience of a transfer to another division.

Article 29(4) – use of the language of the proceedings

9. There seem to be alternative proposals. We suggest that the use of the language of the proceedings should be at the request of one of the parties, i.e. that the parties need not agree provided that the division so decides.

Article 34, burden of proof, removal of the word "new" from paragraph 1

10. We suggest that the Article should be brought strictly into accordance with TRIPs, by re-inserting the word “new” into paragraph 1.

Article 37a(1), injunctions

11. We agree that the injunction should not be obligatory.

Article 58a, ratification

12. Although the draft Agreement may permit ratification by fewer than all the EU member states, we would prefer that in the end all member states should ratify.

General Comments

13. It is desirable that there should be a statement that the court is a national court of each of the contracting states, for enforceability in EU member states and Lugano Convention states that have not ratified the EEUPC Agreement and to justify referrals to the ECJ.