

- Subject:** Representation before the European and European Union Patents Court (EEUPC)
- By:** *epi*
- To:** *epi* Board Members, National IP Associations in the EPC Member States
- Summary:** A unified European Patents Court has been proposed. As part of the proposal, European Patent Attorneys who have an appropriate qualification can represent in court, as well as lawyers. The Court will be a technical court with new procedures. European Patent Attorneys have technical qualifications, are highly experienced in patent matters, are regulated by a code of professional conduct, and will have training in the new procedures. The adoption of European Patent Attorneys as representatives will have significant cost benefits and provide effective litigation.
- Documents:** Article 28, Council Working Document 7928/09, 23 March 2009
Council Note 17229/09, 7 December 2009
- Date:** 23.06.2010

The Institute of Professional Representatives before the European Patent Office („*epi*“) came into existence pursuant to the European Patent Convention (EPC) upon provisions adopted by the Administrative Council of the European Patent Organization. The Institute being an international non-governmental public law corporation has its own by-laws and code of professional conduct. At present, the Institute which represents the first all-European patent profession comprises about 9600 members from 37 European countries, both from industry and free profession.

The governing body of the Institute is the *epi* Council which comprises registered European Patent Attorneys from all the states contracting to the European Patent Convention. The senior body within the Council is the Board which comprises a Presidium.

The work of *epi* is mainly the function of thirteen specially elected Committees essential to the representative role *epi* fills with the EPO, the World Intellectual Property Organisation (WIPO), the European Commission and various national institutes and associations.

Advocacy paper

Article 28, Representation - Draft Agreement EEUPC, 7928/09, 23.03.2009

Introduction

1. Article 28 paragraphs (1) to (3) of the draft Agreement on the European and Community Patents Court and Statute, Council Working Document 7928/09, 23 March 2009, read as follows:

Article 28

Representation

(1) Parties shall be represented by lawyers authorized to practise before a court of a Contracting State.

(2) Parties may alternatively be represented by European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the European Patent Convention and who have appropriate qualification such as a European Union Patent Litigation Certificate.

(2a) Representatives of the parties may be assisted by patent attorneys who shall be allowed to speak at hearings of the Court in accordance with the Rules of Procedure.

(3) The requirements for qualifications pursuant to paragraph 2 shall be established by the Mixed Committee on the basis of a proposal from the Commission of the European Communities. A list of European Patent Attorneys entitled to represent parties before the Court shall be kept by the Registrar.

2. *epi*, which represents European Patent Attorneys (EPA's) and to which all EPA's must belong, has carefully considered Article 28. Paragraph (2) enables the parties to be represented solely by a suitably qualified EPA, should the parties wish to make such a choice. *epi* believes that this provides for effective, convenient and inexpensive litigation, particularly for small and medium-sized enterprises.

The proposed unified European Patents Court (now known as the European and EU Patents Court, or EEUPC)

3. The EEUPC will not be a court above national courts but instead will be a separate court for handling patent litigation of European Patents, with its own procedural law which will be different from the procedural law applicable in any of the EU member states. Whether or not a technical judge is appointed to the panel in question, the planned court will have a strong technical character in addition to the specialisation in patent law – patents are technical documents. The Court will thus be a specialised court with two characteristics distinguishing it from other courts: the technical character of the legal disputes and the reliance on a body of law formed by the European Patent Convention (EPC) and the future EU Patent Regulation (EUPR).

Advantages of representation by EPA's

4. The numbers of those representing the parties in a patent action would be reduced with significant cost-benefit. It would be possible to run an action with a single representative rather than with an attorney-at-law¹ or "lawyer" (as defined in the agreement) and a patent attorney. The EPA can be the person who already represents the party in drafting and prosecuting patent applications and will know and understand the party's technology, and will probably also be acquainted with what has been done before in the field and what competitors are doing. The EPA will have had a number of years training and practice in patent law and unlike lawyers will have a qualification such as the European Union Patent Litigation Certificate which is specific to

practice in the unified European Patents Court. The client can choose whether to be represented by an EPA or a lawyer or a team.

Cost-benefit advantage of representation by EPA's

5. The cost-benefit advantage of sole representation by an EPA is mentioned a number of times in the Final Report "Economic Cost-Benefit Analysis of a Unified and Integrated European Patent Litigation System" prepared by the Institute for Innovation Research of the Ludwig-Maximilians-Universität, 26 February 2009. On page 6 middle paragraph, is stated "A particularly promising measure is to admit representation by specialized European Patent Attorneys". On page 20, last paragraph, is stated "For the purpose of this report, it is noteworthy that the Presidency proposal includes various measures that attempt to allow for relatively low litigation costs. Among these are provisions for case management (Article 24) and the representation of parties by European Patent Attorneys who have specialized in patent litigation (Article 28)". This is referred to again at (v) in the middle of page 21, and in the middle of page 50, when discussing representation by specialized and experienced EPA's; it is stated that allowing for more competition among representatives is a suitable measure to limit the cost of litigation.

6. With the expected cost effectiveness of the system combined with the bigger market impact of litigation cases, smaller sized businesses will be attracted to patent litigation and lead to an increase in the demand for patent litigation. Direct representation by EPA's could avoid any shortage of litigators.

Quality of representation by EPA's

7. Article 28(2) of the draft Agreement requires the EPA's to have appropriate qualification such as a European Union Patent Litigation Certificate. Such a qualification will guarantee quality representation before the EEUPC. As this is a specialized court based on its own law and procedures, the absence of right of representation in a national court should not disadvantage an EPA. No lawyer is at present familiar with the procedural law before the unified European Patents Court. EPA's will have to familiarize themselves with this new European patent litigation procedural law in the same way as lawyers should do so, the difference being that the EPA's will have to satisfy the requirement for the European Union Patent Litigation Certificate or a like qualification and that lawyers will not be obliged to do so.

8. It is in the parties' interest that disputes involving patents are carried out by suitably qualified and properly trained professionals who can guide the client through all aspects of patent disputes. All lawyers will be allowed to represent, even those who are only knowledgeable in say family law and labour law, without any additional patents court certificate, so the cadre of lawyers will include many who have no knowledge whatsoever of technology, patent law or of the procedural law of the unified EEUPC. While a lawyer's education in the field of law is general and broad, it is not specific to the field of intellectual property or more specifically to the field of patents, which is highly specialised. Lawyers usually do not have a technical background and do not have any training in or familiarity with the procedures of the new EEUPC, with the EPC or with the future EUPR. The EPC and the future EUPR do not form part of any national law. Although litigation before the EEUPC will relate to and raise many complex and specific questions of law, the necessary experience, knowledge and expertise to deal with them will not be held by most lawyers, especially if the lawyers come from a state with little or no tradition in the patent field.

Specific expertise of EPA's

9. It goes without saying that most EPA's also act as national patent attorneys in the 37 EPC Contracting States, i.e. the European Patent Organisation which has always been a forerunner of European integration.

10. EPA's are trained to defend or attack the validity of patents. Analysis of the scope of protection of patents and the doctrine of equivalents are part of EPA's everyday practice, as well

as formulating or considering arguments against the enforcement of a patent, rules concerning the exhaustion of a patent, and classic defence arguments. In litigation work EPA's have to provide the lawyers with the necessary arguments on both validity and infringement. EPA's will often have attended court and will also have acquired additional qualifications relating for example to competition law, and may have been involved in negotiating and drafting intellectual property agreements, including settlements and licensing agreements.

11. Further, EPA's not only represent in examination and grant proceedings before the EPO, but also in opposition and appeal proceedings relating to the validity of granted patent before the Opposition Divisions and the Boards of Appeal of the EPO.

12. It must be stressed that within the European Patent Organisation the Boards of Appeal are an autonomous authority, comprising a Presidium (a Vice President of the EPO acts as chairman) and various Chambers hearing the individual cases. These Chambers when dealing with appeals from a decision of an Opposition Division have a variable composition of – depending on the nature of the case - two or three technically qualified members and one or two legally qualified members, which is appropriate as normally technical aspects of the case play the more dominant role.

13. In other words, already today EPA's are considered competent to represent parties before a European authority whose Chambers act according to common Rules of Procedure, hear witnesses and experts, like any other civil court, and conduct the proceedings in any of the three official languages. The Boards of Appeal moreover have an international composition from a pool of independent judges, also technical judges that cannot be removed from office; thus, they form a unique court-like pan-European institution, a sort of first instance Unified European Patent Court, when it comes to ruling on the validity of European and future EU patents.

14. Thus, if EPA's can represent before the EEUPC, a party can have a sole representative who has a good technical background relevant to the dispute, good knowledge of the European Patent Convention (EPC) and of the EU Patent Regulation (EUPR), if the EUPR is in force, and also of the Rules of Procedure of the EEUPC, and will also have general knowledge and practice in patent litigation.

Disciplinary procedures for EPA's

15. Article 11 of the “Regulation on the establishment of an Institute of professional representatives before the European Patent Office (European Patent Institute, *epi*) and the “Regulation on discipline for professional representatives” prescribe rules of professional conduct for EPA's. The “Additional Rules of procedure of the Disciplinary Committee” govern a Disciplinary Committee of the *epi* and the procedures of the Committee. It is possible that additional special rules of professional conduct may be proposed for EPA representatives before the EEUPC. The rules of professional conduct and the disciplinary procedures for lawyers vary considerably throughout the EU Member States.

¹ *In English the term "lawyer" can have a very broad meaning and can encompass patent attorneys in certain circumstances; for this reason, we use the term "attorney-at-law" to mean those that are qualified to practice in general law. In England the attorneys-at-law are barristers or solicitors.*