

Report of the By-Laws Committee (BLC)

P. Moutard (FR), Chair

Several topics were discussed on the occasion of a BLC meeting held in Munich on March 20, 2015. These topics are discussed in this report. We also discuss other issues, in particular those resulting from the recent Barcelona Council meeting.

Participants to the BLC meeting of March 20 were: Guenther Schmalz, Paolo Gerli, Michael Thesen, Dieter Speiser, Sylvain Le Vaguérèse, Pascal Moutard, Vernessa Pröll (**epi** Secretariat), Amparo Campos (**epi** Secretariat).

1. Terms of reference of the Harmonisation Committee: this committee has proposed a change of its terms of reference. There are still discussions as to the need for such amendments.

2. epi 4.2.2.2.: the title "European Patent Attorney" is missing in several national languages.

Paolo Gerli is still trying to collect all missing translations, in order to present a proposition to the Köln Council meeting.

3. The amendments to the By Laws were on the agenda of the Barcelona Council meeting. It is reminded that, due to a tight schedule, this topic has been deleted from the agenda of the Milano Council meeting.

These amendments were all adopted by the Council in Barcelona.

3.1. The meeting of March 20 was an opportunity to review one more time the proposed amendments, shortly before the Barcelona Council meeting.

We refer to **epi** information 4/2014 for a complete presentation of these amendments.

3.2. However, 2 differences with respect to this former presentation have to be noted:

a) Concerning Art. 3.1 and Art. 13 BL: it was proposed by the BLC to maintain a reference to A 17 of the EQE regulation in art. 3.1 and to delete it from Art. 13.1.

As already explained in the **epi** information 4/2014, the EQE regulation refers clearly and explicitly to the President of the **epi**: see Art. 2(1)a, 2(1)(c)i, 2(1)(c)(ii), 4(1)(a), (b), so that it was impossible to keep a reference to these articles in Art. 3.1 of the By-Laws.

Concerning the EQE fee, the situation is different, since the EQE regulation is not so clear in this respect: Art. 17 just states that the "Institute" is consulted. The Institute is represented by its President, which was the motivation for deleting the reference to article 17 from Art. 3.1 of the By-Laws. However the powers defined in Art. 3.1 belong to the retained powers of the Council and, furthermore, the question of the EQE fee can be a "political" issue.

The former proposition was therefore amended, so that the reference to article 17 is not deleted from Art.

3.1 of the By Laws and, in Art. 13.1, references are made to Art. 2(1) and 4(1) of the EQE Regulation.

b) Concerning Art. 18.2 and 18.3 BL:

We had expressed some doubts as to the meaning of the expression "vote, actively or passively" (Art. 18.2, 3rd §), see **epi** information 4/2014.

The "passive vote", resp. the "active vote" concerns the possibility of being elected, resp. of voting.

Some amendments to the English wording ("right of voting, actively or passively") will be examined, which will not change the scope of this article.

3.3. The orthography of all 3 versions (DE, FR, GB) of the By-Laws has been checked, in particular the use of capital letters in the French version.

4. Code of Conduct (see Supplement to OJ EPO 1/2014, 117–122): Art. 7(e) refers to A. 5b, whereas it should refer to 5a, second sentence.

The Chair of PCC was informed of this minor problem, but this committee is considering further amendments to the CoC, so that all amendments should be discussed together.

5. epi 5.1.5, epi 4.2.4., epi 5.4.3, epi 5.3 and 3.3.1: Minor formal amendments or adaptations of translations of these decisions have been discussed.

6. Other issues – Future work

- During the Barcelona Council meeting, the Presidium and the Council were reminded of A. 35 and A. 48 of the By-Laws concerning the deadline for filing documents in view of a Council meeting and the limitations applicable to motions concerning items added to the agenda in accordance with Article 37 BL or based on additional documents as referred to in Article 35 BL.
- Amendments to sections 4, 5 and 6 of the collection of decisions are currently being considered. Most of these amendments are formal ones and do not need to be decided by Council.
- The following issues form part of the future work:
 - Should A.73 BL be amended or even deleted?
 - Possible amendment of A. 15.4.b) BL will also be examined.
 - During the Barcelona Council meeting, the Internal Auditors have proposed amendments to art. 16.3 BL. A joint meeting of the BLC and of the Internal Auditors will be organized.
- The BLC has been informed that general remarks were made by an external auditor, who is of the opinion that the whole collection of decisions should be simplified. Although the BLC generally agrees with the need for a simplification of the collection of decisions, absent any concrete indication about redundant or useless provisions, it is difficult to deal with such comments. It

was suggested that this external auditor should contact the Internal Auditors or the By-Laws Committee or the Secretary General.

- In A. 18 BL, the expressions “full members”/“substitute members” (of the commissions) are misleading.

These expressions are also used in connection with the Council Members (see BL, Art. 2.3 for example). Possible other expressions (in Art. 18) have to be considered.

Report of the Litigation Committee (LitCom)

A. Casalonga (FR), Chair

I. Appropriate qualifications and certificate for representation by European patent attorneys (EPLC)

Discussions about this question are continuing within the legal group in charge within the Preparatory Committee.

At present it seems that only a few changes are considered.

A few non-profit organisations authorized to grant the Certificate would be added, for instance, the Academy of European Law (ERA) in Trier and the European Patent Academy of the EPO.

The transitory period in Rule 12 for a request to be entered on the list would be cut down from three years to one year.

Rule 12(2) – possibility to be entered on the list if one has represented a party in patent infringement actions on his own – has not been changed. The **epi** had stressed that this rule is too limited since in many countries patent attorneys are not allowed to represent on their own in infringement cases. It should suffice to have assisted a lawyer.

This seems to be under discussion within the legal group. In case however that mere assistance of a lawyer would be accepted, the required number of infringement actions may need to be increased.

II. Representation by EPAs from non-EU Countries

At the public hearing on the RoP in Trier on 26 November 2014 it was noted that the wording of Rule 286(1) would enable non-EU lawyers to represent parties before the UPC. Thus, a limitation based on nationality has been introduced for lawyers.

Art 1(2)(a) of Directive 98/5/EC contains an inherent limitation on who can be a lawyer. The person must be a national of a Member State. However, Rule 286(1) RoP states “by way of exception”, which means that the definition of the Directive no longer applies. For this reason, a phrase like “having the nationality of a Member State” should be inserted.

At the hearing, some members of the drafting advisory group remarked that there should be a similar limitation on nationality for EPAs.

It was decided by the **epi** Council (C78) that LitCom would prepare a paper stating that representation should not be restricted to EPAs from EU Member States. Arguments for this position are that a lawyer’s title is per definition granted by national law, whereas the qualification as EPA is based on the EPC and thus concerns a unified profession. Art 48(2) UPCA does not include any limitation on nationality. It merely refers to EPAs who are entitled to act as professional representatives before the EPO pursuant to Art 134 EPC and who have appropriate qualifications such as a EPLC.

The LitCom prepared this paper but, after discussion, decided to wait before submitting the paper. In fact, the Preparatory Committee appears to be in line with the **epi**’s opinion. This is reflected by the wording of Rule 286 in the 18th draft of Rules of Procedure before the UPC, recently issued, which is satisfactory in regard of this question.

III. Consultation on Court Fees and Recoverable Costs

The present consultation document on the Rules on Court fees and recoverable costs, which also includes a table of the proposed fees and ceilings for recoverable costs, differs from the previous draft in that for some procedures and actions only a fixed fee and no value-based fee is required, for instance, for a revocation action and counterclaim for revocation.

Two alternatives are proposed in the document. Alternative 1 foresees reimbursements of fees in case of a single judge (R. 370(6)(a)), withdrawal (R. 370(6)(b)) or settlement (R. 370(6)(c)). Alternative 2 contains an exemption of value-based fees for certain legal persons, such as SMEs. Alternative 1 benefits the system by encouraging certain behaviour, while Alternative 2 supports SMEs.

After discussion, The LitCom considered that these two alternatives should be combined.