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Editorial

J. Gowshall · J. Kaden · E. Liesegang · T. Schuffenecker

The primary purpose of the *epi* is to represent European Patent Attorneys in their function as representatives before the European Patent Office. As such, the activities of the *epi* tend to be confined to prosecution of European Patent Applications and Oppositions to European Patents. Strictly speaking the fate of a European Patent, after it has passed out of the jurisdiction of the European Patent Office, is not relevant to members of *epi* in their role as representatives before the European Patent Office, although it will be in their dual role as National Patent Attorneys.

However, such a division must, of necessity, be artificial. The fate of a European Patent after passing out of the jurisdiction of the European Patent Office is often to be litigated or negotiated. The terms and outcomes of such litigation and negotiation are, necessarily, dictated by the Patent itself. Because the form of the Patent itself is, in turn, dictated by the prosecution process before the European Patent Office, it is essential to have in mind the potential procedures and events likely to affect the

European Patent after grant in order for prosecution to take place properly.

As such, post-grant procedures both nationally and regionally must be an important part of the knowledge of the European Patent Attorney, in order to allow the European Patent Attorney to carry out his job effectively when representing an applicant before the European Patent Office.

One of the most important aspects of the post-grant procedure is litigation in Europe. Unlike prosecution before the European Patent Office, litigation in Europe depends very much upon the individual state in which litigation takes place and is, therefore, a much more complex issue. The present edition of *epi* Information touches upon this subject, focusing upon litigation in a number of the states which are party to the EPC. Whilst not intended to be a comprehensive review of such procedures, it is hoped that the articles in this edition will aid readers in understanding some of the issues associated with litigation in Europe and encourage readers to investigate these matters further.

Nächster Redaktionsschluss für epi Information

Redaktionsschluss für die nächste Ausgabe der *epi* Information ist der **7. November 2003**. Die Dokumente, die veröffentlicht werden sollen, müssen bis zum diesem Datum im Sekretariat eingegangen sein.

Next deadline for epi Information

Our deadline for the next issue of *epi* Information is **7 November 2003**. Documents for publication should have reached the Secretariat by this date.

Prochaine date limite pour epi Information

La date limite de remise des documents pour le prochain numéro de *epi* Information est le **7 novembre 2003**. Les textes destinés à la publication devront être reçus par le Secrétariat avant cette date.

epi-Herbsttutorium 2003

Das *epi* bietet ein Herbsttutorium zur Vorbereitung auf die Europäische Eignungsprüfung (EEP) 2004 an.

Im diesem Tutorium (Anmeldung bis spätestens 10. Oktober 2003) werden die Aufgaben C und D angeboten. Dieser Termin ist für alle Kandidaten gedacht, auch für diejenigen, die ein Tutorium für die 2003 nicht bestandenen Prüfungsaufgaben wünschen.

Die Daten für das Tutorium sind wie folgt:

Anmeldung:	10.10.2003
Angebotene Prüfungsunterlagen:	C und D, 2001 und 2002
Versand der Prüfungsaufgaben bis:	27.10.2003
Eingang der Antworten bis:	19.12.2003
Kommentare bis:	23.01.2004
Besprechung:	Februar 2004

Im Sinne eines reibungslosen Ablaufes der Tutorien werden die Kandidaten gebeten, sich an die angegebenen Fristen zu halten.

Kandidaten werden gebeten, sich spätestens bis zum 10. Oktober 2003 durch Rücksendung des auf den Seiten 68 und 69 abgedruckten, ausgefüllten Anmeldeformulars an das *epi*-Sekretariat (Fax Nr. +49 89 202 15 48) anzumelden.

Für weitere Auskünfte wenden Sie sich bitte an das *epi*-Sekretariat (Tel. +49 89 201 70 80).

epi tutorials 2003 – autumn term

The *epi* offers an autumn term for candidates wishing to prepare for the European qualifying examination (EQE) in the year 2004.

The autumn term (enrolment deadline 10 October 2003) comprises papers C and D and is aimed at all candidates including those who wish to have tutorials for those papers which they failed in the 2003 EQE.

The tutorial will run according to the following timetable:

Enrolment:	10.10.2003
Papers offered:	C and D, 2001 and 2002
Papers sent by:	27.10.2003
C and D, scripts in by:	19.12.2003
C and D, comments by:	23.01.2004
Meeting:	February 2004

Candidates are reminded to be ready to stick to the indicated deadlines to allow a smooth progressing of the course.

Candidates should enrol by 10 October 2003 at the latest, by filling in and sending the form printed on pages 68 and 69 to the *epi* Secretariat (Fax No. +49 89 202 15 48).

For further information, please contact the *epi* Secretariat (Tel. +49 89 201 70 80).

Tutorat epi 2003 – Session d'automne

L'*epi* propose une session d'automne aux candidats qui souhaitent se présenter à l'examen européen de qualification (EEQ) en 2004.

La session d'automne (date limite d'inscription: 10 octobre 2003) comprend les épreuves C et D et s'adresse à tous les candidats y compris ceux qui souhaitent un tutorat pour les épreuves auxquelles ils ont échoué en 2003.

Le tutorat se déroulera selon le calendrier suivant:

Inscription :	10.10.2003
Epreuves proposées:	C et D 2001et 2002
Envoi des épreuves le:	27.10.2003
Envoi des réponses le:	19.12.2003
Commentaires retournés le :	23.01.2004
Réunion :	février 2004

Il est demandé aux candidats respecter les dates indiquées afin d'assurer le bon déroulement du cours.

Les candidats sont invités à s'inscrire au plus tard le 10 octobre 2003, en renvoyant le formulaire d'inscription imprimé pages 68 et 69 au Secrétariat de l'*epi* (Fax no. +49 89 202 15 48). Pour tous renseignements, prière de s'adresser au Secrétariat de l'*epi* (Tel. +49 89 201 70 80).

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Patent Litigation in Germany

M. Wirtz* (DE) and R. Liesegang** (DE)

A German patent grants its proprietor the exclusive right to make use of the patent and to exclude third parties therefrom. Consequently the proprietor may enforce a claim to stop an infringing action. The proprietor can in addition claim for injunction as well as for rendering of account, compensation of damages, surrendering and destroying of the infringing products. Every valid patent may be enforced, notwithstanding the fact that the patent is subject to an objection concerning the validity by a third party. However, such rights can not be based on a patent application, although an application grants a right for remuneration.¹ The infringer acts wilfully after the patent has been granted and is liable for compensation of damages, when the applicant has already drawn the infringer's attention to the patent application.

1. Patent Infringement

The scope of protection of a German patent is defined in Art. 14 PatG (Patentgesetz = German Patent Act). Regarding European patents a corresponding provision is laid down in Art. 69 EPC, which reads as follows:

„The extent of protection conferred by a European patent or a European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.“

Thus the extent of protection of a patent is not limited to the strict wording of the claims, but includes modifications of the patented invention as well, which may be held by an expert skilled in the field of the invention as equivalent to the invention according to the wording of the patent claims. Such interpretation of the scope of a patent is laid down in the protocol to Art. 69 EPC, which

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¹ Art. 33 PatG (German Patent Act).

also applies to the interpretation of the scope of German patents,² and reading as follows:

„Art. 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated.

On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.“

Before filing a lawsuit it is important to determine, if (1) the patent is infringed according to the textual or literal wording of the claims (*wörtliche* oder *wortsinnmäßige Verletzung*), or (2) the invention is used in an equivalent manner (*äquivalente Verletzung*), as the defense of the potential infringer may often be based on the allegation that the attacked product or method is not covered by the scope of the patent claims. The respective Court in charge shall compare the patent claims to the attacked embodiment feature by feature with those of the patent claim in order to establish, whether or not the patent claim covers the attacked embodiment literally or in an equivalent manner.

1.1. Textual Infringement (*Wörtliche Verletzung*)

The patent is undoubtedly infringed if the attacked product incorporates all features of the claim identically with the strict claim wording (textual infringement).

1.2. Literal Infringement (*Wortsinnmäßige Verletzung*)

In cases in which the product or method/process makes use of all features of the claim in principle, however without exact literal coincidence of the used expressions, the wording of the claims have to be interpreted. Any claim interpretation starts from the wording of the claims in consideration of the description and the drawings, if any. The patent writes „its own dictionary“, which means that the terms and expressions used in a claim are decisive for the interpretation of the patent, irrespective of the fact, whether or not such expressions coincide with those as used in respective common technical language or mentioned in dictionaries.

Further a patent is to be interpreted with a view to the function of the invention. The interpretation must not contradict to the normal function or idea of the patented invention.³ It is important that the attacked product or

method/process makes use of the features of the patent claim in their technical meaning. However, any interpretation by the owner himself as given during official prosecution before the Patent Office are generally no legitimate means of interpreting the patent, as this may not be deduced from Art. 14 PatG⁴. In contrast thereto statements of the owner in course of opposition or revocation proceedings (*Einspruchs- oder Nichtigkeitsverfahren*) may be accepted as means for interpreting the patent.⁵

1.3. Equivalent Infringement

In cases where the infringing product or method is not completely covered by the wording of the patent claims, equivalent infringement is referred to. Then, a generic feature has to be formulated in the proprietor's petition which covers both, the specific feature of the patent claim and the corresponding feature of the infringing product or method. In this respect the scope of protection of a patent is extended to the very close variations of the patented invention. The test of the competent Court in charge will be whether,

„the skilled person based on his expert knowledge could solve the problem on which the invention is based equally effectively on the basis of considerations which are tied to the meaning of the claims, i.e. to the invention described therein, with the modified means inserted into the disputed embodiment“.⁶

Even in cases in which a claim feature was totally omitted from an infringing product the Federal Supreme Court (BGH) has decided that such omission would not lead out of the infringement if the omitted feature was not an „essential“ feature for realizing the inventive concept, e.g. a feature well known in the art, a redundant feature or a side feature not influencing the effect achieved by the invention.⁷

According to this judgement the Court has to check, whether (1) the alleged product has the same function as the patent invention and (2) the modification was obvious to the expert without any inventive considerations.

The Federal Supreme Court recently extended its rulings concerning equivalent infringement in the „Custodil“ and „Schneidmesser“ judgements.⁸ According to these judgements the Infringement Court has now to answer in addition to the questions 1) and 2) as mentioned above a third question, namely

3) Are the considerations of the skilled person in line with the technical idea as protected by the patent claims such that the skilled person would

Batteriekastenschnur; BGH GRUR 1994, S.597 (599) – Zerlegevorrichtungen für Baumstämme.

4 BGH GRUR 2002, S.511 – Kunststoffrohrteil.

5 BGH GRUR 1998, 895 – Regenbecken; for details: Kühnen/Geschke, Die Durchsetzung von Patenten in der Praxis, 2002, paras. 9 – 26.

6 BGH GRUR 1988, 896 – Ionenanalyse; also BGH GRUR 1987, 279 – Formstein; BGH GRUR 1989, 903 – Batteriekastenschnur; BGH GRUR 2002, 511 – Kunststoffrohrteil.

7 BGH GRUR 1999, 977 (981) – Räumschild.

8 BGH GRUR 2002, 527 (531) – Custodil II; GRUR 2002, 524 (526) – Custodil I; GRUR 2002, 519 (523) – Schneidmesser II.

2 BGH (Federal Supreme Court), Gewerblicher Rechtsschutz und Urheberrecht, (in the following: GRUR), 1989, 903 (904) – Batteriekastenschnur; BGH GRUR 1994, 597 (599) – Zerlegevorrichtung für Baumstämme.

3 For details: Protocol to Art. 69 EPC of October 5, 1973; the respective provisions also apply for the interpretation of the scope of protection of a German patent according to Art. 14 PatG; BGH GRUR 1989, 903 (904) –

consider the modifications as equivalent to the technical idea of the patent?

According to this third question the Infringement Court has to check, if equivalent infringement is at stake, or should the wording of the patent claims be regarded as conclusive.⁹ This is particularly important in cases where the patent claims contain regions for physical values outside of which the corresponding value of the attacked product is located.

In case of an equivalent infringement the potential infringer can raise an additional means of defense, namely the so-called *Formstein*-objection¹⁰. According to this objection, the patent is deemed not to be infringed if the infringing modification is not novel as compared with the prior art which is relevant for the respective patent.

Thus, where possible, the patent proprietor should try to base his petition on both, firstly on literal infringement and secondly on equivalent infringement. German Civil Courts¹¹ are generally open to assess the wording of a patent in a broad sense, so that often, although the case is not clear having regard to the wording of the claims, the infringer is sentenced without touching the field of an equivalent infringement.

2. Warning Letter, and the problem of the „Italian Torpedo“

2.1 If the proprietor is of the opinion that his patent is infringed either according to its wording (textually or literally) or in an equivalent manner, he has to decide whether the infringer should be approached either by a warning letter or a letter questioning the grounds of unauthorized use to the infringer (*Berechtigungsanfrage*) before filing an action with a Court.

According to German Civil Procedure Law¹² the patent proprietor runs cost risk, if the infringer upon filing an infringement action by the proprietor immediately acknowledges the infringement. In case the patent proprietor did not approach the infringer before filing the action and the infringer immediately acknowledges the rights of the proprietor, the patent proprietor has to bear the costs of the proceeding. These costs include the Court fees, the costs of the infringer's attorneys and the costs of the proprietor's attorneys, following the principle „the looser pays“.¹³ Thus under German practice in the past a patent proprietor approached the infringer before

starting a legal proceeding by sending a warning letter or a *Berechtigungsanfrage*, the latter in cases where the infringement is not that sure, in order to clear the situation.

2.2. However, the patent proprietor who approaches the infringing party before initiating a Court proceeding runs the risk that the infringer starts an *Italian Torpedo*. Such a defense has recently become common practice in Europe in cases with international aspects, particularly in cases which fall under the European Directive 44/2001¹⁴. To start an *Italian Torpedo* means that the alleged infringer threatened by a patent proprietor starts an action for a declaration of non-infringement with the identical parties and the same subject matter of litigation at a Court in a European country, where Court proceedings are known to be rather lengthy, e.g. in Italy.¹⁵ Thus, a quick infringement proceeding and decision will be prevented according to Art. 27 (1) European Directive 44/2001. The Court, where an infringement proceeding has later been started by the patent proprietor is prevented from deciding the case and obliged to set aside the proceeding as long as the „Torpedo Court“ has not decided about its competence in this matter. In contrast to German Law this European Directive applies also in case of a „conflict“ between an action for a non-infringement and an infringement claim.¹⁶

However, in order to rely on the *Torpedo* and to prevent the patent owner from executing his patent effectively and quickly, the *Torpedo* has to meet several preconditions. For instance the action for a negative declaration has to have a clear relationship to the territory of the subject member state, such as the import or export of a product in that country is affected, otherwise the lawsuit is obviously inadmissible and does not prevent a later patent infringement proceeding in Germany.¹⁷

2.3. Thus, before filing a claim with a German Court the patent proprietor should decide if it is likely that the infringer starts a *Torpedo* or not. In the latter case the proprietor should approach the infringer via a warning letter in order to exclude the costs risk of an immediate acknowledgement of the infringer. Otherwise he should first of all start an action at a German Court and send the warning letter later. In case the infringer immediately acknowledges the proprietor's claim within the deadline set forth in the warning letter, the proprietor may withdraw the action. In case of a *Torpedo* the proprietor may be prevented to enforce his patent in Germany against this particular infringer for at least up to seven years.

9 For details: Bopp/Jeep, Mitt. 2003, 293ff; Reimann/Köhler, GRUR 2003, 931ff.; Bergen-Babienecz /Hinrichs/ Jung/ Kolb, GRUR 2003, 438ff.

10 The name *Formstein* generates from the Federal Supreme Court's decision *Formstein*, BGH GRUR 1986, 803 – Formstein; for details Kühnen/Geschke, para. 50/51 and see down 3.4.1.

11 For instance the Regional Courts of Düsseldorf and Munich.

12 Art. 93 Zivilprozeßordnung – ZPO (German Code of Civil Procedure).

13 According to German practice the parties are represented by both, a patent attorney and a „normal“ lawyer. As a rule under German law only lawyers are allowed to represent a party in the Court proceeding, however in case of a patent infringement proceeding the patent proprietor may be represented by both a patent attorney and a lawyer (Art. 143 (5) PatG). Then in case of a patent infringement proceeding the losing party has to bear the costs of both attorneys. These costs are calculated according to the *Bundesrechtsanwaltsordnung* – BRAGO (Federal Legal Attorney's Fees) and depend on the concrete value in dispute of the proceeding.

14 Verordnung (EG) Nr. 44/2001 des Rates vom 22.12.2000 über die gerichtliche Zuständigkeit und die Anerkennung und Vollstreckung von Entscheidungen in Zivil- und Handelssachen.

15 Such a proceeding is often filed with a Belgian and Italian Court, so called Belgian or Italian Torpedo.

16 European Court of Justice Neue Juristische Wochenschrift (NJW) 1995, 1983 – Taty, NJW 1989, 665 (666) – Gubisch Maschinenfabrik ./. Palumbo; BGH NJW 1995, 1758.

17 For details concerning the Torpedo, see Goddar/Tönhardt, Konfliktlösung durch Patentlizenzverträge, Mitteilung der deutschen Patentanwälte (Mitt.), 2002, p.337 (340).

3. Procedural Aspects of German Infringement Proceedings

3.1 Competence of Courts

The German Civil Courts are generally competent for any patent infringement which takes place in Germany. According to Art. 143 (1) PatG the Federal States (*Bundesländer*) are entitled to determine a specific Court as being the sole Patent Infringement Court in their territory. For instance, North-Rhine-Westfalia has chosen the regional Court of Düsseldorf, Bavaria the Court of Munich, Lower Saxony the Court of Braunschweig and Baden-Württemberg the Court of Mannheim as its competent infringement Court.

Which Court to choose by a patent proprietor in case of an infringement? Under German law that specific Court is competent in whose area the infringement took place or where the seat of the infringer is situated. As a rule there are no difficulties in obtaining an offer concerning the infringing product (such offer being an infringing action) in a region where the preferred patent infringement Court is situated. As such an offer illustrates a patent infringement, the plaintiff, therefore, has the opportunity in many cases to request his complaint to be discussed at the Court of his preference.¹⁸

According to European Order 44/2001, Art. 2 (1) not only the infringement of a national German patent may be claimed but also the infringement of foreign patents, particularly the foreign part of an European patent, if the proprietor has chosen the Court, which is competent at the seat of the infringer. Thus, cross-boarder injunctions may be claimed also under German practice. However, the German Judges are then forced to apply the respective foreign law in question.¹⁹ However, in case another Court but the one at the seat of the infringer is chosen, it is difficult to extend the infringement claim also on foreign patents.²⁰

3.2. Collecting and Presenting the Facts

As the proprietor is expected by the Court to verify an infringement by evidence, he will have to consider thoroughly whether the infringer makes unauthorised use of his patent by manufacturing, offering, selling, leasing, importing and exporting as well as using the claimed subject matter of the patent.

The patent proprietor has to prove facts concerning at least one of the uses mentioned above. Thus he has the burden of proof as a rule. In case of an infringement of a

method there is an exemption of this rule, if the product, which has been produced by using that method, is new. According to Art. 139 (3) PatG there is a prima facie evidence that the product, which is similar to the „new“ product, was manufactured by that proceeding. The potential infringer is requested to prove the contrary, i.e. that the product was not produced by using that method.

However, the collection of such evidence may not lead to an unfair exploitation of the infringer's trade secrets. Thus, as a rule it is the proprietor's burden not only to collect the details of the infringement case, but also to ensure that in case the infringer denies the infringements as such, the proprietor must ensure that he is also able to prove the details of the infringement.

Until recently, collection of evidence at the premises of the infringer or at the location of unauthorized use by a client of the infringer, for example by inspection and dismantling of an infringing machine or of an infringing method, was not permitted in view of the infringer's interest worthy of protection for his trade secrets. Thus a so-called „proof of investigation“ as practiced in other countries such as France and the U.K. was not possible according to case law in Germany,²¹ although Art. 809 BGB²² regulates a right for inspection. In order to be allowed to inspect, the patent proprietor has to give full details, that an infringement is not only possible but most likely. Considering that the proprietor may not be allowed to inspect the alleged infringing product and otherwise may not be able to set forth the details of the infringement, this is often more than difficult.

The German Supreme Court recently overruled the rather restrictive German practice regarding inspection. In the decision „Faxkarte“²³ the Court laid down details and certain rules for applying Art. 809 BGB in a more liberal manner. In the light of the regulation of Art. 50 TRIPS – Agreement.²⁴ Whereas the decision „Faxkarte“ explicitly concerned a copyright infringement case, its findings are held applicable to patent and other intellectual property infringement cases as well²⁵. It is now necessary to balance the different interests of the concerned parties and particularly the interests of the potential infringer in their trade secrets and on the other hand the interest of the proprietor in enforcing his rights. The concrete case „Faxkarte“ referred to a possible infringement of computer software. The infringer was a former employee of the plaintiff and the software subject to the proceeding was to a certain extent similar to the proprietor's software. The Court held that these facts were sufficient to establish the „likeness“ of an infringement. Generally precondition of such a claim for inspection still is that the plaintiff gives full details that an infringement is „likely“.

21 For instance BGH GRUR 1985, 512 – Druckbalken; OLG Düsseldorf GRUR 1983, 745 – Geheimhaltungsinteresse und Besichtigungsanspruch II; KG GRUR-RR 2001, 118 – Besichtigungsanspruch.

22 BGB – Bürgerliches Gesetzbuch – German Civil Code.

23 BGH GRUR 2002, 1046 – Faxkarte.

24 BGH GRUR 2002, 1046 (1048) – Faxkarte.

25 For details, Tilman/Schreibauer GRUR 2002, 1015 – 1022; König, Mitteilungen der deutschen Patentanwälte 2002, 457.

18 Most of the patent infringement cases are situated at the Regional Court of Düsseldorf, which is held as one of the most skilled patent infringement courts in Germany. The patent infringement courts have set up a specialized chamber which are practically exclusively concerned with disputes in the area of legal protection of industrial property, in particular patent infringement cases. They are occupied with three judges who have acquired an often amazing empathy and understanding of technical facts of all kinds on the basis of their continuous occupation with technical questions. In the predominant number of cases the Court therefore neither consults a „neutral“ expert, as e.g. in France, not relies on „experts“ chosen by the parties involved, like in the United Kingdom but rather relies on their own technical experience as well as skills of the attorneys involved.

19 For details: Kühnen/Geschke, Die Durchsetzung von Patenten in der Praxis, paras.87 – 99; Osterrieth, Patentrecht, 1999, pp.142 – 144; Grabinski, GRUR Int. 2001, 2000.

20 LG Düsseldorf, GRUR Int. 1999, 455 – Schussfadengreifer.

3.3. *The Lawsuit before the Regional Court*

The plaintiff has to give full details that his patent is infringed. Thus he has first of all to state that he is the proprietor of the patent and, therefore, is authorized and allowed to enforce the rights of the patent,²⁶ and that the patent has been granted and is enforceable and valid. Further, the plaintiff has to give full evidence that the patent is infringed by submitting facts and evidence that the invention of the patent is used either according to the textual or literal wording of the patent claim or equivalently.

3.4. *Means of Defence*

The potential patent infringer has basically two main options of defense, namely:

- 1) to deny the infringement and/or
- 2) to attack the validity of the patent in question,

at the side of the „normal“ means of defence, such as limitation of claims, forfeiture and so on²⁷. If possible the infringer may of course deny the facts of the case and particularly that the accused product or method/process has nothing to do with the proprietor's patent. In case the proprietor is not able or hindered to prove that the patent is infringed his claim will be rejected.

3.4.1 *No Infringement*

The infringer first of all argues that the patent is not infringed as he does not make use of it. As the patent claims are open to interpretation, the infringer may also argue that his product or method does not use the patented invention, i. e. that his product or method is not covered by the patent claims and that the claim interpretation of the proprietor is false or not correct, e.g. by contradicting the normal function and/or the idea of the patent.²⁸

In case the patent proprietor is of the opinion that his patent is infringed in an equivalent manner, the infringer may particularly argue that the infringing „modification“ is totally within the technique known before the application of the patent (cited art).²⁹ Thus the infringement defendant can assert that his product does not represent any patentable invention as compared to the prior art cited against the allegedly infringed patent. However, the defendant has to consider that it will not be sufficient if only a part of the claim features is covered by the prior art, but not the product as such.³⁰

3.4.2 *No Validity*

Apart from the defence based on the lack of scope of protection of the patent claim, the infringer may claim that the patent in suit is not valid. However, according to German law the Civil Courts judging on infringement are not competent to decide on the validity of a patent. The competent Court for deciding on validity is the *Federal*

Patent Court located in Munich and closely linked to the German Patent and Trademark Office.

Thus, in infringement proceedings before the Civil Court the defense of invalidity of the patent is not admitted.

This is the most important difference between German and for instance patent infringement proceedings in France and the U.K. However, if the defendant is of the opinion that the patent is not valid he may file an invalidation or „nullity“ action with the Federal Patent Court.

The defendant is allowed to refer to his parallel validity action and to introduce arguments of the invalidation action into the infringement proceeding before the Civil Court. However, even in case the infringement Court is convinced based on the arguments submitted by the defendant that the subject patent is not valid, the Court is not allowed to declare the patent as invalid and, therefore not enforceable against the infringer. The Court, however, on request of the defendant may stay the infringement proceedings until the Federal Patent Court has decided on the invalidation action, but shall decide in favour of suspension only in cases, in which the Court is convinced of invalidity of the patent.

3.5. *Decision and Appeal*

In case that the Civil Court does not set aside the infringement proceedings based on an invalidation action the Court decides the case by either allowing or disallowing the action based on the arguments. At the same time the Court decides on the costs of the proceeding.

As a rule the defeating party has to bear the costs of the proceeding, i. e. the court fees and the „refundable fees“ of their own and the adverse side's attorneys. The refundable costs are dependent on „the value in dispute“ as defined in the legal fees to be charged according to the „Bundesrechtsanwaltsgebührenordnung“ (BRAGO).

If facts of the proceeding are doubtful the Court will call for evidence, such as witnesses, a technical expert and so on.

An appeal to the Court of Appeal occurs against the judgements of the patent infringement chambers. Under the new regulation of the Civil Procedure Code such an appeal is more or less possible on the points of law. New matters of fact may be brought up only such a submission was not possible during the first instance for the respective party. Thus the plaintiff has to prepare the lawsuit very carefully in order to be enabled to submit everything to the Court which may be of any importance already in the first instance. A request for revision of the decision of the Court of Appeal is as a rule only possible when such request is allowed by the Court of Appeal and if a legal question of general interest is at stake.

Normally the patent infringement chambers at the Regional Courts decide the case within a period of one year, sometimes even faster. Thus under German practice the patent proprietor may rather quickly enforce his

26 For instance by submitting a written consent of the registered owner of the patent.

27 For details, Kühnen/Geschke, paras. 271 – 335

28 For details, see above 1.1. – 1.3.

29 So called *Formstein-Einwand*; BGH GRUR 1986, 803 – Formstein.

30 Kühnen/Geschke, paras 50/51.

rights, which is one of the advantages of the German Patent Infringement proceeding.

4. The Invalidation Action

Invalidation actions concerning patents are handled by the *Federal Patent Court*. The respective Senates of the Court are sitting with 5 judges, two of them having legal background and three of them being former Patent Office examiners, that is engineers, physicians or chemists.

The competence of the technically skilled judges at the Federal Patent Court ensures that a very skilled Court with excellent technical background is involved in the proceedings. Therefore, technical experts normally are not invited by the Courts to render opinions in patent infringement and validity proceedings. This saves costs and, at the same time, provides quick progress of the proceedings. Thus, as a rule, the parties involved can expect to get a Patent Court decision in the first instance within less than one year from the filing of an invalidity action.

Appeals against the decisions of the Senates of the Federal Patent Court are transferred to the Federal Supreme Court. As a rule, the Federal Supreme Court relies upon a technical expert proposed by the Court to the parties involved and in the final oral hearing „cross-examination“ of said expert before the Supreme Court forms a central part of the proceeding.

5. The role of the Federal Supreme Court

In the past infringement and invalidation actions merged as a rule again at the *Federal Supreme Court*. As already mentioned an appeal against the decision of the Federal Patent Court goes immediately to the Federal Supreme Court, whereas in an infringement action an appeal goes first to the Court of Appeal and to the Federal Supreme Court only in the third instance under the following restrictions:

Against the decision of the Court of Appeal a request for revision that is an appeal on the points of law (*Revision*), is possible at the Federal Supreme Court.

After all, in spite of the separation of the infringement and the invalidation proceeding in the first and second instances a consistent practice of judging was guaranteed in the final stage of infringement and validity disputes.

However, this well balanced system of coexistence of the infringement and invalidation actions changed with the admendment of the law of civil procedure in 2002. Under the new regulation an appeal on the point of law in normal court proceedings, and thus also in infringement proceedings, is nowadays only possible when the appeal was allowed by the Court of Appeal and if the legal point of the case is of general interest. Under the new regulation it may be that the infringer will be condemned legally valid based on a patent infringement action by the Court of Appeal without a further appeal

being possible, whereas in the parallel invalidation proceeding the Federal Supreme Court decides later-on that the infringed patent of the infringement proceeding is not valid. In case of such inconsistent decisions the defendant still has the possibility to set aside the final and conclusive decision of the court of appeal by initiating a proceeding for restitution against this decision based on the finding of the Federal Supreme Court, declaring the subject patent for not enforceable.³¹ This particular problem proceeding was obviously overseen by the legislator when preparing the above mentioned amendment. One proposal to overcome this problem would be that the legislator would correct the respective regulations and would introduce a special regulation concerning the appeal on the points of law against the decisions of the Courts of Appeal in patent infringement cases, which allows a general right to appeal. Another option would be to set aside the traditional separation of the patent infringement and invalidation proceeding and to establish just one Court for patent infringement and invalidation action, for instance with the Federal Patent Court. However, this latter option is not likely to be adopted in Germany in view of the advantages of the former system, namely quick proceedings of high quality at low costs.

6. Preliminary Injunction

Under certain conditions it is possible to file an application for preliminary injunction also in patent matters under German law. Upon such an injunction the infringer may be preliminarily forbidden to manufacture, offer, sell, lease, import, export or otherwise use the patent claims. On this application the court normally decides within a couple of days, sometimes also within hours, if the claims subject to the application are well founded and allows the injunction without making an oral hearing necessary.

A precondition for achieving such a preliminary injunction would be that the facts and the infringement as such are clear. The time factor is also an important element: normally the patent proprietor has to file an application for a preliminary injunction within four weeks to three months, calculating from the first knowledge of the infringement.³² The proprietor has to make clear that the infringement is credible. The Court does not have to be totally convinced that the alleged product is an infringement of the patent. This finding is part of the normal Court proceeding.

Upon service of the preliminary injunction the infringer is allowed to lodge an opposition against the decision, claiming that his product or method/process does not infringe the subject patent. The preliminary injunction will be revoked by a normal judgement, if an infringement is not proven and also if the time requirement is not

31 BPatG GRUR 1982, 852; LG Düsseldorf GRUR 1987, 628 – Restitutionsklage; For details: Kühnen/Geschke, paras. 366 – 368.

32 For details: v.Falck Mitteilungen der deutschen Patentanwälte 2002, p. 429; Mes § 139 paras. 71 – 78; Kühnen/Geschke, paras. 349 – 364.

met. In case the injunction is revoked the proprietor is liable for damages.

7. Utility Model Infringement

An infringement case may also be based on a utility model (Gebrauchsmuster). In Germany, a utility model can exist parallel to a patent. Therefore in case a patent does not (yet) exist a respective claim can also be based on the parallel utility model.

If a utility model is infringed, the proprietor can assert the same claims against the infringer as for the infringement of a patent, i. e. injunction and compensation of damages and additionally rendering of account, surrendering or destroying of the infringing products may be claimed by the proprietor. The infringement action functions exactly the same as a patent infringement action. However, the utility model is a registered protective right, which has not been examined to the merits. Thus the risks for a utility model proprietor to start infringement proceedings are more severe than those for a patent proprietor, especially, if a preliminary injunction is applied for, where the Court often decides without an oral hearing, and thus hearing the infringer's argument. The utility model proprietor should therefore start a search prior to an action or a complaint. Such a search is being conducted e.g. by the German Patent and Trademark Office for a comparatively low fee.

The infringer threatened or attacked by a utility model infringement dispute, other than a patent, can request to declare the utility model as invalid in the Court proceedings. Additionally, he can file a utility model cancellation complaint with the German Patent and Trademark Office., where in the second and last instance a specific Senate at the Federal Patent Court finally judges on the validity.

The standard of inventive step requested for a utility model is lower than that for a patent. If the proprietor has at his disposal, as already mentioned, a patent not yet finally examined or an opposed patent not yet finally assessed, whether it will be granted in Germany or

Europe, he can branch-off a utility model from such a patent, and after two or three months he as a protective right „capable of complaint“.

After all, a German utility model, particularly in cases of a patent dispute, can be most useful for its proprietor, who sees his rights infringed.

8. Summary

Patent (and Utility Model) infringement and invalidation proceedings in Germany provide as a rule high quality judgement at low costs and in short time, often within less than one year. Recently, the burden for the proprietor to bring up evidence for infringement of a patent has been alleviated by the judgement „Faxkarte“. Now it should be easier for the proprietor to enforce his rights by first of all inspecting the alleged infringing product or method/process which will be allowed from now on if there is a strong likelihood that the attacked product infringes the patent.

However, in the past, the system of having separated proceedings in infringement and invalidation matters could lead to the result that on the one hand the patent survives an attack of invalidation by too narrow interpretation of the prior art by the Patent Court and, on the other hand the scope of a claim is interpreted too broad by the Civil Court which would lead to unbalanced judgements.

This nowadays is more critical due to the fact that the Civil Court as a rule will not wait for an invalidation judgement of the Patent Court. As an appeal to the Federal Supreme Court may not be admitted in many cases in the patent infringement proceedings, the likelihood of contradictory and nevertheless legally binding decisions arising from the infringement and the invalidation proceedings will be more likely as, other than in the past, the separated proceedings in many cases no longer necessarily merge at the Federal Supreme Court. Thus, the German legislator is expected by the interested circles, particularly the patent proprietors, to remedy such unsatisfying situations.

epi Information 1/2004 – Themed edition

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A New Open University Program „European Industrial Property Law“ at the Fernuniversität Hagen

U. Dreiss* (DE)

1. The training of Patent Attorneys

The training of Patent Attorneys in Germany rests on three columns. The first one is technical competence in all matters related to patents. Therefore, before starting the professional training, a candidate must have completed studies in science or engineering at a scientific university. Professional training as a candidate begins with a 26 months internship at a Patent Attorney's office or the Patent Department in industry (provided, it is under the supervision of a Patent assessor, where candidates learn on-the-job the basic skills to write patent applications from scratch and to prosecute them to become valid and reliable assets of its proprietor. The second column is the law relating to all types of industrial property rights, the most important ones being patents and trademarks, which also is taught during the first period.

The third column is general law, covering selected topics of substantive civil and procedural law, like the law of trade, economics, competition, civil and administrative procedure, etc. It surrounds the industrial property law. These general law studies should give more insight and understanding of the more general legal concepts, which are generic to their application to special topics of industrial property protection. These general law studies are carried out as 2-year-distant-university course at the FernUniversität Hagen („Hagen I“). They end with an exam, which practically coincides in time with the end of the 26-months training period mentioned above. This is followed by a 2-months-internship at the German Patent and Trademark Office and a 6-months-internship at the Federal Patent Court (Bundespatentgericht). The last step is the Patent assessor examination, the prerequisite to enter the free profession and thus to become a Patentanwalt (Patent Attorney).

2. The concept of the new European industrial property law program Program „Hagen II“

Despite the intense education outlined above and further in addition to the European Qualifying Examination, which as a practical necessity all German Patent Attorneys should have made, some of them may become more active in areas in which they feel that their knowledge is not sufficient. This depends on the particular circumstances of the individual's profile of

professional activity, like the clientel (smaller or larger enterprises) or the type of Law Firm (small or large) they are working in. Patent Attorneys might find themselves in a position in which they need additional know-how on an academic level.

This has led the Patentanwaltskammer to establish another program in cooperation with the Fernuniversität Hagen (Hagen II) as part of a continuing professional education. It addresses Patent Attorneys who already had some years of practise and want to improve their legal competence with an emphasis on foreign law.

a) Foreign patent litigation procedure

Analysing what is required, we note that substantive patent law, at least in Europe, has been harmonized to a great extent. The prerequisites of patentability are the same under the European Patent Convention and the Patent Laws of the Member States. The procedure before the European Patent Office is comparable to the procedures before the examining national patent offices. They carry out a search and make a statement as to non-obviousness or obviousness based on the search results. The patentee will argue against what he thinks not to be well-founded. At the end, in most cases, there may be a patent with an amended set of claims and description.

In contrast, there has not yet been any harmonization of national patent litigation procedure. Even if the present efforts to establish a Community Patent, including a new litigation system, are successful, national patent litigation will still be the decisive one for the foreseeable future. The experience gathered in practising it, at least to some extent, also will shape the developing European System.

If an enterprise starts a litigation or is threatened to be sued, Patent Attorneys – whether in free practise or in industry – are usually the first ones turned to for advice. Mostly, they have accompanied the client already for a considerable time and have established the level of communication and mutual reliance necessary to discuss legal risks, tactics and strategy, give a technical analysis of the product or process presumed to be infringing, and – on the defendant's side – alternative proposals such as seek a license or develop technical alternatives. Clients must be informed of what information they are expected to contribute, e. g. searching for documents, technical and „political“ discussions. This needs time, motivation, and experience. At least, clients must be given a realistic estimation of costs.

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To give such advice is especially difficult, if the procedural law of foreign legal systems are involved. However, it *is* involved in almost every case. We note that the national laws of patent litigation procedure differ to a much larger extent than the substantive industrial property laws ever differed, since the procedures are much more rooted in long lasting different traditions.

Thus, in shaping our ideas, we wanted to include in our new program the procedural law of infringement and invalidity litigation of the United Kingdom, France, and Germany. The latter one, of course, would be on an advanced level, since its basics are presumed to be known at least by German students.

b) Procedure under the EPC, the Community Trademark and the Community Design Regulation

Having in mind the litigation procedure under the proposed European litigation system and what predecessors it is most likely to follow, it appears that the procedural practice as developed in the past 25 years at the European Patent Office and before the Boards of Appeal in particular, will play an important role.

A wide range of procedural law under the European Patent Convention has grown and meanwhile has gained its own profile taking into account the laws of the member states (sometimes even based on Roman law which everybody can accept, since we all have roots there). What politically even is more important, the EPC procedural law already *is* accepted by the practitioners of the member states. Thus, we wanted to include in the courses to be established the procedural law as applied by the Boards of Appeal, including the Enlarged Board of Appeal, of the EPO. In particular, the part of Community patent litigation governing the validity of patents, should be similar to the opposition procedure at the EPO. At least to me, this would make sense.

The same applies to the Community Trademark Litigation procedure and, just recently established, to the procedure under the Community Design Regulation. These latter systems have the peculiarity in common that the remedy against decisions of the Office is a suit against the Office for Harmonization of the Internal Market before the European Court of 1st Instance, the same court, which will have added to it, the Community Patent Court exclusively competent to deal with Community Patent infringement and validity litigation. This led us to include European procedural and constitutional law as well into the new program.

c) Comparative Law and the Conflict of Laws

To establish a more general basis we included an introduction into comparative law and an introduction in the Law of Conflict Laws. This seemed especially appropriate with a look on Council Regulation (EC) No. 44/2001 of 22.12.2000 on jurisdiction, recognition and enforcement of judgements in civil and commercial matters.

2. The curriculum

Putting these ideas together, the curriculum, as it now stands, includes the following modules:

1. Semester
 - Module 1: Introduction into comparative law
 - Module 2: Introduction to the law of conflict of laws
 - Module 3: Introduction into European constitutional law
2. Semester
 - Module 4: Patent infringement and invalidation procedure in Germany
 - Module 5: Patent infringement and invalidation procedure in the United Kingdom
 - Module 6: Patent infringement and invalidation procedure in France
3. Semester
 - Module 7: Procedural law under the European Patent Convention
 - Module 8: Procedural law under the Community Trademark Regulation and the Community Design Regulation
 - Module 9: European and international civil procedural law (Reg. No. 44/2001 etc.)
4. Semester
 - Module 10: International industrial property protection (Paris Convention, TRIPS, Madrid Agreement & Protocol, Hague Agreement, etc.)
 - Module 11: Substantive Law of the European Community Design Regulation and related maximal laws

This program presently is in the process of being accredited for granting the academic degree of a „Master of Law“ by the FernUniversität Hagen.

3. When, who?

Initially financed by the Patentanwaltsskammer, these studies will be financed by tuition fees of the students. They will be € 2.000 per semester for members of the Kammer, € 2.500 for non-members. We will start with a maximum of about 30 participants in October this year. The studies will be open to European Patent Attorneys, German Patent Attorneys, and Attorneys of other member states of the European Community with a comparable education (Belgium, Finland, France, Italy, Luxemburg, Netherlands, Austria, Portugal, Spain, United Kingdom).

The preparation of the materials for the start is in its final phase. We were successful in recruiting well experienced and reputed experts in all the related fields as authors for the written materials, which are the heart of

such a program. Applications will be considered on a „first come first served“ basis.

This open/distant university courses will be conducted by sending out materials for study, having the students writing tests and sending them in for correction. It further will include periods of presence with introduction, review, and lectures relating to particular topics, and examinations relating to the modules, the workload

is estimated to be 600 hours per semester. Some students, however, may need less because he or she is they are already familiar with some of the topics. Nevertheless, it is an ambitious program, which needs a high level of energy and motivation. It is our contribution to a long-term perspective of our profession and the evolving European civil procedure.

Developments in English patent litigation

R. Davis (GB)*

The UK is a good place to litigate your patent!

Not just an eye-catching first line, but due to the reforms occurring in the last few years hopefully becoming a reality. The UK has always been perceived as having a line-up of good quality specialist judges and advocates. The criticism usually voiced is that the UK's adversarial system (as opposed to the more Continental inquisitorial system) increases the expense of litigation, a topic to which I shall return later.

First, however, a quick summary of the way the system fits together. The UK patent litigation profession is spilt into three groups of professionals: patent attorneys, solicitors and barristers. The split between the latter two is relatively unknown in civil law jurisdictions and so a brief explanation may help.

Both solicitors and barristers are qualified lawyers that is to say that they have a legal degree (or equivalent) and a vocational qualification. It is at this vocational stage (a one year full-time course) that the profession splits: solicitors go to ‚law school‘ and barristers to ‚bar school‘. The vocational training concentrates on their slightly different roles. After training both must complete an apprenticeship style placement in a law firm (solicitors) or set of Chambers (barristers).

Although somewhat of a simplification, solicitors are the first port of call and are the generalists of the profession. Barristers are the specialists. Compared to the medical profession, solicitors are the general practitioners (family doctors), barristers are the consultants. In the context of a piece of litigation, solicitors will be responsible for the day to day conduct of a case such as the client and witness relations. The barrister will concentrate on the presentation of the case to the court: by way of both written and oral advocacy. As a related role, barristers also produce legal opinions, both prior to or during litigation on the strategies to be adopted and the prospects of success.

Traditionally, the UK has operated a tiered profession and this has led to overly complex rules concerning the acceptance of instructions and rights of audience before

the courts. The basic situation is simple: solicitors can accept instructions from anyone; barristers must be briefed by a ‚professional client‘. On the other hand, barristers have rights of audience before all the courts, solicitors generally do not (although these can occasionally be obtained).

However, this basic situation is misleading and to understand what actually happens in practice some explanation is first necessary about the court structure. There are two first instance patent courts in England: the Patents Court (a division of the High Court) and the Patents County Court. The Patents Court hears the more complex and higher value cases whereas the Patents County Court hears the simpler or lower value cases. The Claimant decides which court to use although in exceptional circumstances cases can be transferred between the courts. Both Courts have specialist and experienced judges. An appeal from either court lies to the Court of Appeal. Finally, questions of public importance may subsequently be appealed to the highest court, the House of Lords.

So back to the acceptance of instructions. As previously stated, Barristers generally only accept instructions from a professional clients. For *all* ‚non-contentious‘ work (which includes litigation before the actual issue of proceedings) barristers can, and frequently do, accept instructions from in-house legal or patent departments and both UK and European Patent Attorneys. However, once litigation has started they can only accept instructions from solicitors or those patent attorneys with ‚litigators rights‘. This includes all UK Patent Attorneys if the case is in the Patents County Court but only those with an additional Litigator's Certificate (only held by 50 attorneys) if the case is to be fought in the Patents Court.

Both Courts are good places to litigate your patent. The judges are very specialised. All are scientifically qualified and have previous experience as practising IP barristers. In the event of appeal, a specialist judge will generally sit in the appeal court (currently Mr Justice Jacob who has just been promoted). Although proceed-

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ings are generally Claimant led, the judges now have increasing case management powers which can be exercised in writing although in the more usual case a hearing will be held.

The principal aspect, perhaps, that distinguishes the UK system from some of those in mainland Europe is that litigation is 'party' driven rather than Court driven. Note that I say party driven rather than claimant driven. It is up to the parties to decide how to progress their cases and agree between themselves or apply to the Court accordingly. If the parties co-operate, then the system can work cheaply and efficiently. However, where the parties refuse to cooperate but instead descend into procedural game-playing costs can mount rapidly. Although the recent reforms go some way to preventing this, the Court is not in a position to run the litigation and although it has increased case management powers, it is not always effective in using these in practice.

Litigation in the UK commences with exchange of pleadings between the parties. Traditionally, these are very brief, certainly far less particularised than those used in the European Patent Office. To this extent, the UK Patents Court lags behind the reforms made to the non-specialist system. Once pleadings have closed, the case is listed for a so-called case management conference, normally one hour in length and before one of the specialist judges. At this time, the Court will generally set the timetable to trial. The starting point for the timetable is a fixed set of directions issued by the Patents Court which the Court will customise for the case in hand. As previously stated, these may be agreed between the parties but in default of agreement the Court will hear limited arguments from the parties.

One feature of the UK system is that the parties are generally required to give disclosure of all relevant documents. This places a large burden on the parties who are obliged to carry out a search to locate such documents often at considerable expense. The oppressiveness of this obligation has now been recognised by the Courts leading to the limitation of disclosure in a patent action to the period \pm 2 years from the priority date. Moreover, in smaller scale limitation, disclosure is often dispensed with completely unless requested on reasoned grounds by one of the parties.

At around the same time as disclosure, both parties will generally clarify their case by further pleadings often in the form of responding to questions posed by the other party. As previously mentioned the patent courts are likely soon to insist upon more detailed initial pleadings and so the importance of this phase is likely to diminish.

Primary evidence, both of fact and expert opinion will be prepared by both sides and exchanged before trial. At present, the UK courts have held that, since the addressee of a patent is the man skilled in the art, expert evidence is required in order to construe the specification and claims (but not to interpret them, which is a matter of law). Some first instance judges have already

expressed the view that such expert evidence is not always essential and it must only be a matter of time before the Courts are no longer so strict upon insisting on it. This is another area where the law is in a process of change. (A further impetus for change may come from the introduction of the new Community Design law where the added expense of obligatory expert evidence is even less attractive.)

Finally, the case will proceed to trial, in front of a single judge. The period from issue of proceedings to trial will typically be about one year although in cases of urgency the case can come to trial very much quicker. The length of trials range from about 2 days for a simple patent (covering *both* infringement and validity) to a week for a more complex patent. In exceptional cases, for example very complex or valuable patents the trial may take a matter of weeks although it is far to say that there are probably less than 2 or 3 of such trials each year.

So why do the UK patent courts have such a bad press? The reasons are perhaps historical, but it is hoped that this article goes some way to redressing the conception that the UK courts are slow and expensive. Having said that, it is essential to keep a close eye on costs. So how does one do this? First, if one insists on using a 'Rolls Royce' treatment, then one will pay accordingly. For a medium value infringement on a patent of average complexity it is not necessary to instruct an large international law firm and top 'silks' (senior barristers of 20+ years experience). If one does, one will pay accordingly. Many UK firms of patent attorneys are familiar with litigating before the UK Courts and there is a strong range of experienced litigators at the 'junior' bar. (The term 'junior' bar is a misnomer encompassing those who have not yet been appointed as a silk, a rank which will perhaps soon be confined to legal historians) Moreover, barristers' rules of instruction permit them to give pre-litigation advice directly to European Patent attorneys who may be surprised how favourable rates undercut those of the specialist solicitors) or indeed compare to their own rates!

In summary:

- Adversarial system requires the instruction of experienced litigators.
- Recent introduction and continued growth of cost saving measures.
- Trial by expert, scientifically qualified judges, usually in under one year.
- Careful use of manpower can result in cost effective litigation.
- In some cases, litigation can be run by a team of patent attorney and barrister
- The flexible procedures of the system are of significant use in difficult cases (but can add complexity to simple cases if the parties will not agree).

Patent Attorneys' Rights in the British Courts

E. Lyndon-Stanford (GB)

British patent attorneys (which title in this context is synonymous with patent agents) have two different rights of representation in the British Courts, and I briefly discuss each of them.

The Patents County Court

County Courts have existed for a long time in England and Wales. They were hierarchally parallel to the High Court, though they had lower status. Patent and registered design actions could be heard only in the High Court. The Patents County Court was set up in 1990 under the Copyright, Designs and Patents Act 1988, fundamentally to provide a much cheaper and fairer way of litigating patents and designs. The Patents County Court was like the other County Courts, but its jurisdiction was extended to (and limited to) patents and designs and ancillary or contingent matters. Any registered British patent agent has the right to conduct litigation (i. e. act as a solicitor) and the right of audience (i. e. act like a barrister) in the Patents County Court. There was also the intention to set up a new streamlined procedure which would considerably reduce costs and significantly speed up actions.

Initially, the Patents County Court was very effective. Cases were reported where patent attorneys represented on each side and the costs were about one tenth of the costs of High Court actions and thus comparable to costs on the continent of Europe. Unfortunately, procedures then began to resemble High Court procedures and, to a certain extent, the judge was too conscientious in following the rules and too correct in not forcing parties to cut out expense and save money. As one would expect, solicitors preferred to act in the High Court because that was the Court to which they were accustomed. At the same time, the Patents Court (the High Court) speeded up and somewhat reduced costs. Patent attorneys took fright. It was fine if there was a patent attorney on the other side, but if the other side was represented by a solicitor and a barrister and the patent attorney lost, his client would be faced with paying two-thirds of the costs of the other side, which could be huge. Early in 1999, a patent judge in the High Court remarked „many solicitors behave as though they were playing a war game for itself“. The overall effect was that the Patents County Court lost much of its work.

However, things have changed. A new judge, his Honour Michael Fysh, has been appointed, and he has been actively encouraging patent attorneys to appear him. He also will not go along with time-wasting procedures and is determined to see his Court successful in attracting design cases and low value patent cases. There is now a revival of the Patents County Court.

The High Court and Patent Agent Litigators

In 1990, the government was anxious to introduce more competition into the legal field in order to obtain better services and lower prices. The Courts and Legal Services Act 1990 was passed, and section 17 of the Act states a general objective of making provision for new or better ways of providing legal services and a wider choice of persons providing them, while maintaining the proper and efficient administration of justice.

Under the Act, CIPA on 25th November 1999 was designated an authorised body for granting CIPA Fellows (i. e. full members of CIPA) the right to conduct litigation in the High Court and in the Court of Appeal, in relation to any intellectual property litigation, which includes patents, designs, technical information and trade marks, and also ancillary matters. Such patent attorneys can do in the Courts exactly what solicitors can do, though only in relation to I.P. litigation. They can formally represent clients and are responsible for filing all documents. They cannot however speak in open court, and like solicitors (unless the solicitors have special rights) must brief barristers to speak.

CIPA Fellows with such rights have the formal title „patent agent litigators.“ Patent agent litigators must subject themselves to special rules of conduct and to a special disciplinary procedure, and must undergo a minimum of six hours per year of continuing professional development (i. e. training, whether by attending lectures or giving lectures or even attending committee meetings) on subjects associated with litigation. Except for a transitional period of four years (nearly over now), all those to whom the rights are granted must take a special LLM (master of laws) course in advanced litigation. Also, they must have been a registered patent attorney for three years and have had a minimum of six months experience under the supervision of a person who has the right to conduct litigation (who may be a patent agent litigator or a solicitor).

We have a very detailed regulation for the LLM course, which includes a precise syllabus for civil litigation procedure. The syllabus extends to 8½ pages. In summary, the patent agent litigator must know about general law topics such as the English legal system, the effect of European law, the Brussels and Lugano Conventions on civil jurisdiction, and enforcement, criminal liability and contract law. The patent agent litigator must know about civil litigation procedure, in detail.

The LLM course comprises a skills base and a knowledge base. The skills base requires practical exercises and a skills assessment, and is taught on six extended weekends over a two-year period. The rest of the course is private study and distance learning. At the end, there is

an assessment and a degree is awarded. The first LLM course has now completed its first year, and is being run by the Nottingham Law School, which is part of Nottingham-Trent University.

So far, in the transitional period, 56 Fellows of CIPA have been granted patent agent litigator rights, which is a significant proportion of all British registered patent agents (1486 at present). We expect the number of patent agent litigators to increase considerably. The patent agent litigator right is seen as a useful professional qualification, even if the person does not intend to litigate – it can assist in obtaining a new job and can also reassure clients. More importantly, it enables the patent attorney to advise his client properly in relation to prospective litigation, and, if his firm is set up to support such litigation, conduct the litigation himself.

I am aware of three cases that have already been filed by patent agent litigators in the High Court. None have yet reached a substantive hearing (and, due to the high cost, about 90% of High Court patent cases are settled before the hearing).

Patent Attorneys Representing in the English Courts

There are a number of advantages in patent agents being able to represent in the Courts, and I list:

- the team required is one or two persons, not three, reducing costs;

- the case is conducted by a technically qualified person who will have a deep understanding of the technology concerned, giving rise to better presentation of argument and hence better decisions;

- a patent attorney will concentrate on the technological heart of the matter and spend less time on legalistic aspects, reducing time and hence cost;

- the patent attorney expects to have an on-going relationship with his client and will have a good commercial motive for keeping his charges as reasonable as possible, reducing cost;

- the patent attorney can keep all stages of the proceedings under his own control, reducing time and cost.

In the end, it should be the client that decides whether he wishes to be represented by a patent attorney or by a solicitor. Few patent attorneys will be able to equal the ability of the best IP solicitors in handling a case, but nonetheless the patent attorneys will have the advantages I note above, and they certainly will be cheaper. I can finish by quoting a remark made to me by the first Patents County Court judge (not verbatim as my recall is not that good) when I asked how patent attorneys performed in his Court – „not as well as the most experienced IP solicitors but much better than the general run of solicitors“.

Patent Infringement Litigation in France Comparison with the situation in Germany*

P. Véron** (FR)

Even if they are both stemming from the Roman-German tradition, the French judicial system and the German one reveal a number of differences, which could surprise a German practitioner who would have the opportunity of following a patent infringement litigation in France.

An introduction of the main litigation actors (1.) is useful before studying these differences in details (2.).

1. The litigation actors

The French judicial system is very different from the German one as regards patents (1.1); the role of the *conseils en propriété industrielle* (French patent attor-

neys) and of the *Patentanwälte* (German patent attorneys) is therefore slightly different (1.2); it is the same concerning specialised lawyers (1.3).

1.1. The French courts having jurisdiction in patent litigation

- **The courts of general jurisdiction deal with patent infringement and validity at the same time.**

The main difference between the French and German judicial systems as regards patents lies undoubtedly in the fact that in France the same courts deal with patent validity and infringement at the same time.

France in fact has no counterpart of the „*Bundespatentgericht*“, i.e. a court specialised in the examination of patent validity.

Moreover no opposition procedure exists against the grant of a French patent.

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The validity of a patent can be disputed by initiating a claim for revocation before a court of general jurisdiction only.

The courts of general jurisdiction deal with the patent litigation from the beginning to the end.

The same court thus deals with the claim for infringement and the possible counterclaim¹ for patent revocation raised by the defendant, which avoids a slowing down of the proceedings, since the court should never stay its proceedings for waiting a decision upon the validity.

Moreover the practitioners consider that a court better appreciate the scope of the patent and therefore the infringement issues, when it could itself evaluate the inventive contribution of the patent in comparison with the technical prior art by dealing with its validity.

In practice the claims in chief for patent revocation are very rare (less than 5 % in comparison with the claims in chief for infringement).

The patent validity is most often disputed within the framework of an infringement litigation.

The argument of patent invalidity is besides very often invoked:

- the patent validity is disputed in at least the half of the infringement litigations,
- the patent is revoked in about 25 % of the cases when a judgment on the merits is handed down.

It should be mentioned that if the plaintiff withdraws his request for revocation of the patent (for example after a settlement agreement), the court cannot continue the proceedings *ex officio*, because only the parties set up the subject matter of the litigation.

Finally it should be noted that since 1968 the judgment revoking a patent has an *erga omnes* impact (in the past the judgment had an *inter partes* impact only, so that the patentee could invoke his patent against other alleged infringers).

• 10 specialised courts in all the France

The jurisdiction as regards patents is however reserved to only 10 „*Tribunaux de Grande Instance*“ (first instance courts) for all the France as well as to „*Cours d'Appel*“ (second instance courts), within the territorial jurisdiction of which they fall, and to the „*Cour de Cassation*“ (supreme court of appeal).

Actually the specialisation is even more advanced: about 170 new cases per year, i.e. about 60 % of the patent cases in France are submitted to the *Tribunal de Grande Instance* in Paris.

¹ There is a theoretical important difference between a counterclaim for revocation and a defence for revocation based on their respective purpose. A counterclaim for revocation constitutes a claim of the defendant and results, when it is admitted, in the revocation of the patent. The defence for revocation is only a defence means and results only in the dismissal of the claim for infringement, the revocation of the patent being there only an obstacle to the admittance of the claim for infringement: the patent is not declared revoked. In practice, however, the defendant in the action for infringement generally lodges a counterclaim for revocation, which, if it is admitted, leads to the revocation of the patent.

On the contrary 7 of the 10 courts having exclusive jurisdiction as regards patents deal with less than 15 cases per year.

This high concentration of the cases enables the judges to acquire a good experience in this field, even if they have no technical formation since they are judges „of general jurisdiction“, who dedicate themselves to patent law not exclusively and who besides hear other types of cases.

In the *Tribunal de Grande Instance* in Paris, which has more than 30 chambers in total, the third one is specialised in industrial and literary and artistic property: it thus hears all the patent, trademark and design cases but also the copyright infringement cases (numerous in France because of the rule of „unity of art“ which enables to protect the unfilled ornamental designs by the copyright) and the cases of publisher and film production agreements.

The third chamber of the Tribunal itself is composed of 3 „sections“ (sections) of each 3 judges: in Paris there are so 9 specialised judges in first instance.

At the *Cour d'Appel* the fourth chamber is specialised in intellectual property litigation: it is composed of 2 sections of 3 judges (called „*conseillers à la Cour*“), i.e. 6 specialised judges.

About 20 % of the cases judged in first instance are subjected to appeal.

The *Cour d'Appel* in Paris hears about 40 patent cases each year.

• The claims for unfair competition related to claims for infringement

The patentee sometimes invokes unfair competition acts, which are distinct from the infringement but which are related thereto (as an example the reproduction of the product's appearance or package or the hiring away of employees).

Under the ordinary rules of French procedure these claims would fall within the jurisdiction of the commercial courts composed of elected tradesmen and not of professional judges.

In order to avoid that the patentee has to institute two claims at the same time against the same defendant before two distinct courts, Article L. 615-19 of the French Intellectual Property Code grants the exclusive jurisdiction to the 10 specialised courts to deal with the claims involving a patent infringement and a related question of unfair competition.

In this way the exclusive jurisdiction of the 10 specialised courts is respected and the patentee has the advantage of having to institute a single claim to obtain compensation of his whole damage.

1.2. The role of the *conseils en propriété industrielle*

The patent attorneys were called in France *conseils en brevet d'invention*. In 1990 they became *conseils en propriété industrielle*: now the profession includes also the jurists specialised in trademark and design law.

The role of the *conseils en propriété industrielle* during a patent litigation however remains the same.

Contrary to the German system, where the *Patentanwälte* can alone represent the parties in revocation cases, the *conseils en propriété industrielle* are not entitled to represent the parties even in revocation cases, since courts of general jurisdiction deal with all the litigation points as regards patents and the „*avocats*“ (in first instance), the „*avoués*“ (counsels only before the *Cour d'Appel*) and the *avocats aux conseils* (before the *Cour de Cassation*) have the monopoly of representation before these courts.

However they play an essential role of collaboration with the lawyer throughout the course of the case: the *conseil en propriété industrielle* often plays in fact a binding role between the client and the lawyer and often proves to be a precious source of technical arguments during the communication of „*conclusions*“ (written pleadings).

Of course more or less different modes of collaboration exist.

Some lawyers prefer that the *conseils en propriété industrielle* prepare the draft written pleadings; others prefer to study the technique during meetings with the *conseil en propriété industrielle* and draw up themselves the written pleadings.

The *conseils en propriété industrielle* attend the hearing with the client beside the lawyer; but they speak very rarely.

1.3. The specialised lawyers

Most of the patent litigations are dealt with by very specialised lawyers: only 10 to 20 French law firms deal routinely with this type of cases (most of them in Paris and 5 or 6 in the provinces).

An official mention of specialisation exists: „*avocat spécialisé en propriété intellectuelle*“ (lawyer specialised in intellectual property); it is an indication but not an absolute guarantee of competence in the particular field of patents (about 200 lawyers in France enjoy this mention of specialisation); not all the specialised lawyers indicate their specialisation on their letter head; it is thus better to be well informed before choosing a French lawyer for a patent case.

Most of the lawyers regularly practicing industrial property litigation (patents, trademarks and designs) are members of A.A.P.I. (Industrial Property Lawyers Association) founded in 1993 on the initiative of Paul Mathély which now has about 60 members.

2. The litigation course

The claims for infringement constitute the main part of the cases filed before the French courts: the claims for non infringement are very rare and the rest of the cases (agreements, claims for property, invention of employees) constitutes only about 20 % of the cases in first instance.

Therefore the litigation course will be studied more particularly.

The litigation course can be split up into three stages: preparation (2.1), judgment in first instance (2.2), appeal (2.3).

2.1. Institution and instruction of the case

In France all the infringement cases approximately follow the same course to the judgment: after a search and seizure (2.1.1) the patentee has to submit the case before the court (2.1.2); the patentee can consider a request for preliminary injunction at this stage (2.1.3); afterwards the parties communicate their argumentation in the written pleadings (2.1.4); the patentee has here to prove the infringement (2.1.5).

2.1.1. The search and seizure

In the high majority of the cases a claim for infringement instituted in France is preceded by a search and seizure, which enables² to obtain the elements to prove the infringement rapidly and efficiently.

Article L.615-5 of the French Intellectual Property Code in fact sets forth a search and seizure procedure in the favour of the patentee, which actually is neither an actual seizure, despite its name, nor a preliminary injunction: the search and seizure is an evidentiary method.

The patentee's lawyer should file a request before the President of the *Tribunal de Grande Instance* of the infringement location to obtain the authorisation to carry out a search and seizure.

It is a procedure carried out in the absence of the defendant: the alleged infringer will be informed thereof only at the moment the search and seizure is carried out.

The President is not entitled to refuse the authorisation if a patent in force is submitted to him: by virtue of law he is obliged to accept the request for authorisation.

The single power of the President is to determine the extent of the search and seizure: in fact he has the choice to authorize a description only, whereas he was requested for an authorization of actual seizure.

The search and seizure is carried out by a „*huissier de justice*“ (bailiff), who enjoys an intermediate status between the one of a civil servant and the one of a liberal professional.

The bailiff is chosen by the plaintiff; the day of the search and seizure he can come with a „*homme de l'art*“ (person skilled in the art) (in general the *conseil en propriété industrielle* of the patentee), a police officer, or any person whose technical skills can be useful.

² The principle is that the action for infringement is brought by the owner of the patent only.

Under French law, the simple licensee is not entitled to bring an action and the exclusive licensee can do it only if the licence agreement sets it forth and after an unfruitful formal demand of the patentee.

Any licensee can however intervene in the proceedings, once the action is initiated, to obtain compensation for its own damage.

The German mechanism of the *Prozeßstandschaft* does not exist in France, where on the contrary it is not possible to initiate an action on behalf of third party (an old adage says: „*Nul ne plaide par procureur*“).

These persons can enter into the premises of the alleged infringer, research the allegedly infringing product, device or process, describe it, be supplied with a few exemplars thereof, and make copy of technical, accounting and financial documents relating to the infringement, even if they are confidential.

The alleged infringer can dispute the validity of the search and seizure only after it was carried out, by criticizing the authorisation grant or the conditions under which the search and seizure was carried out.

The plaintiff has to serve a writ of summons on the alleged infringer within two weeks after the search and seizure was carried out; should he fails to do so, the actual search and seizure will be declared invalid (the description part of the minutes remaining valid).

2.1.2. Submission of a case to the court

To commence proceedings the plaintiff makes a bailiff serve a writ of summons on the opponent party.

The writ of summons is an act, which means the proceedings commencement, and includes the plaintiff's claims, which can generally be formulated relatively summarily.

In the case a search and seizure is carried out, the writ of summons has to be served within two weeks after the search and seizure; should he fails to do so, the actual search and seizure will be declared invalid (the description part of the minutes remaining valid).

However a case is not submitted to the court by the service of the writ of summons: for this purpose, once the writ of summons is served, afterwards the plaintiff has to register it in the cause list before the court office (the technical terms are „*placer l'affaire*“, „*mettre l'affaire au rôle*“, or „*enrôler l'affaire*“).

It should be noticed that it is not necessary to prove that the defendant actually received the writ of summons to register the case in the cause list before the court office.

Notably in the case the defendant is domiciled abroad, as an example in Germany, the writ of summons is duly served at the moment that a French bailiff delivered it to the attorney general of the court referred to.

Of course the court could not judge upon the case as long as it will not be proved that the defendant is actually aware of the writ of summons.

However it is possible to submit a case to the court without having the proof that the defendant is aware of the writ of summons.

This mechanism gives the defendant a certain control over the time as regards the submission of the case to the court, because he has a time limit of 4 months to file the writ of summons with the court office.

In this way he can postpone the submission of the case up to 4 months at his own convenience to enable possible negotiations.

He can also proceed with it rapidly and register the writ of summons in the cause list immediately after it was served³.

And finally it should be noted that in France no rule requires the owner of several patents to „concentrate“ his actions for infringement in one instance, even if they deal with the same product and the same defendant.

2.1.3. The preliminary injunction

Once the claim for infringement is submitted to the court, the plaintiff can request the President of the court, who adjudicates in a preliminary proceedings, to order the defendant to cease the allegedly infringing acts until the judgment is handed down.

For this purpose, firstly, the claim on the merits should be initiated and secondly within a short time limit from the day the patentee has been made aware of the facts on which the claim is founded.

Under case law, a „short time limit“ means about 6 months.

The claim on the merits should also seem to be serious.

The claim on the merits is deemed to be serious if the validity of the patent is not doubtful in light of the argumentation put forward by the defendant, and if the allegedly infringing acts seem to be materially established.

The President of the Court can subject the injunction to the deposition of a bond by the plaintiff (but it is not a usual practice).

On the contrary he can authorise the continuation of the allegedly infringing acts in consideration of the deposition of a bond by the defendant aimed at ensuring the compensation of the patentee in case the infringement is acknowledged (this is also not a usual practice).

Because of the strictness of the legal conditions and the case law practice, the orders of preliminary injunction remain rare (less than 5 each year undoubtedly for all the France in comparison with the 300 to 500 new cases on the merits).

³ This enables to minimize the risk that the opponent party initiates a „torpedo“ action, i. e. an action for non-infringement in a country, which acceded to the Brussels Convention on jurisdiction, and which is known for the long time it takes to hand down a judgment.

Once such an action is initiated, the defendant can in fact oppose a *lis pendens* defence to the patentee, who would submit an action for infringement before another court: the defendant can in fact rely on the fact that the foreign court seized was the first seized and by virtue of Article 21 of the Brussels Convention the second seized court should stay its proceedings.

The fact that, in the French system, the plaintiff himself seizes the court enables him to minimise the risk that a „torpedo“ action is initiated, whereas the German mechanism (in which the court is deemed to be seized only when the defendant has actually received the claim registered in the court office) gives him less control and does not protect him from such an operation.

Besides, to avoid these differences, the Regulation (EC) 44/2001 of December 22, 2000, which will replace the Brussels Convention as from March 1st, 2002, sets forth a new system.

Under Article 30 of this Regulation the court is deemed to be seized:

- as soon as the writ of summons is delivered to the court, provided that the plaintiff does not neglect to fulfil the required steps to notify or serve the writ to the defendant afterwards,
- or as soon as the authority in charge with the service or the notification of the act to the defendant will have received the writ of summons, provided that the plaintiff does not neglect to fulfil the required steps to deliver the writ to the court afterwards.

Therefore the court is deemed to be seized as soon as the writ of summons is delivered to the court or the bailiff.

This solution will reduce to nothing the period, which can at present time pass between the fulfilment by the plaintiff of the steps required to seize the court, and the actual seizure of the court, which will sensibly reduce the possibilities for the defendant to initiate a „torpedo“ action.

In practice it can be considered only with a very solid file (opposition rejected by the E.P.O., patent already declared as valid in another country, flagrant infringement).

2.1.4. The communication of written pleadings

The length of the patent litigation before the French courts is at least 18 months in first instance for a rather simple patent case; if the case is complex this period can reach 30 months.

The saturation of the French courts and the mechanism of written pleadings communication contribute for a large part to this length.

In fact no legal text limits the number of successive written pleadings communications, nor requires to raise all the legal grounds simultaneously.

In practice three or four written pleadings are communicated.

The Judge managing the case, who controls the course of the case, sets the time limits to file the written pleadings and orders the closing when the case seems to him ready to be heard.

The time limits to file the written pleadings are set by the Judge managing the case as a function of several factors, the case's complexity notably: but the patent cases are not generally considered as the simplest ones.

The time limits to file a set of written pleadings is three to five months generally.

2.1.5. The evidence of infringement

The burden of proof is incumbent on the plaintiff for infringement.

In French law the infringing acts can be proved by any means.

The evidence by testimony can thus be used but it is very rare in practice.

In any case the witnesses are exceptionally questioned at the hearing: their testimonies are usually recorded in writing then submitted to the court as exhibit.

The plaintiff has above all at his disposal an effective tool, the search and seizure procedure.

The seized products or devices can be subjected to an adversarial analysis ordered by the Court on the request of a party when the infringement does not result from their examination.

A translation into French of any submitted exhibit written in a foreign language should be supplied with in order that this exhibit can be taken into account, even if the judges and the parties know the language of the exhibit.

Finally as regards patents relating to process for the production of a product the patentee can obtain the reversal of the burden of proof.

The patentee can in fact request the Court to order the defendant to prove that the process he uses to obtain an identical product is different from the patented process.

This option, introduced in French law in 1996, however seems to have been implemented only in one judgment until today⁴.

2.2. The judgment

The Court in its judgment, generally handed down a few weeks after the hearing (2.2.1) can order an expert report (2.2.2); after the result of the expert report the final decision is handed down; it can be accompanied with a provisional enforcement (2.2.3) and includes almost always provisions about the litigation costs (2.2.4).

2.2.1. The hearing

The course of a French hearing is rather different from the one of a German hearing.

A detail will surprise the German practitioners: in many courts, notably in the provinces, all the cases are arranged at the same hour (as an example at 9 a.m. or 2 p.m.) and the examination order of the cases is set only at the beginning of the hearing; the court often prefers to „evacuate“ the simplest cases and finish with the most difficult ones, like the patent cases.

It is so possible, notably in the provinces, to be convoked at 2 p.m. and to wait until 4 p.m. for the case to be heard...

A second difference is that the court has no obligation of searching to bring about an agreement between the parties before hearing the case.

Another more substantial difference with Germany is that the French judges are not aware of the case's exhibits before the hearing.

In fact until now no text of the French Code of Civil Procedure sets forth that the exhibits should be filed before the court before the hearing.

In general the judges were not able to study the patent in issue.

This has obviously consequences over the hearing course, which is very different from the one of a German hearing.

The judges can not in fact lead the hearing by questioning the lawyers.

For this reason the lawyers advocate systematically in order to supply the Court with a first clarification on the case: the advocacies can so take 30 minutes for each party for the very simple cases up to 2 or 3 hours for the more complex ones.

In some exceptional cases the case can extend over two hearings (morning and afternoon), even over two days.

On the contrary the examination of witnesses or experts is exceptional: their possible testimonies are almost always recorded in writing and submitted as exhibits.

⁴ Tribunal de Grande Instance in Paris, third Chamber, first Section, February 28, 2001, *Revue du Droit de la Propriété Intellectuelle*, 2001, No. 123, p.45

2.2.2. The expert report

Rarely in France an expert report is ordered on the merits of the dispute.

It is generally ordered to check a fact disputed by the parties.

It can be the case during a discussion on the sufficiency of description or on the factual aspects of the infringement.

An expert report is on the contrary never ordered, as it can be in Italy, in a very general way, on the validity or the infringement.

As regards damages calculation, resorting to an expert report is on the contrary almost systematic.

In fact France does not know the procedure of handing over the accounts, which exists in Germany.

And if the search and seizure enables to make copy of accountant documents, the patentee rarely obtains by this procedure all the information needed to determine his damage.

The documents, which enable to assess the damage, are therefore not available otherwise than via an expert report.

The expert should preferably be registered in the list of the judicial experts before the *Cour d'Appel* within the territorial jurisdiction of the court.

The I.N.P.I. (French National Institute for Industrial Property) or another state institution should be previously consulted on the choice of the expert, and the decision upon the expert's appointment should mention this consultation.

2.2.3. The provisional enforcement

The provisional enforcement of a judgment means that the party, which wins its case, can have this judgment enforce against the opponent party, even if the latter lodges an appeal.

Again on this point the French and German approaches are different.

In Germany the provisional enforcement is a right, but exception is subject to the deposition of a bond.

In France the provisional enforcement is not a right; it is granted only on the request of a party and if the circumstances justify it, the deposition of a bond being rarely required.

2.2.4. The litigation costs

In France the litigation costs are composed of the lawyer's fees, on the one hand, and of various costs, on the other hand, which, in the practice, include essentially the fees of the bailiff, the *avoué* and the expert, that are set according to a rate or a scale.

The involvement of the court is entirely free.

In the past the lawyers were used to ask a lump sum for their fees.

Today, most of the time, the lawyers' fees are calculated according to a rate per hour, multiplied by the number of hours spent on the file's study.

Success fees are sometimes also agreed, albeit it is very uncommon in patent cases: in this case, if the client wins, he will pay his lawyer a part of the sums granted by the court.

However it can only constitute complementary fees, never their major part.

The litigation costs are at the charge of the loser, unless the court considers that it would be inequitable.

The actual „litigation costs“ become practically symbolic since the official rate has not been revaluated for more than 40 years.

In first instance they reach 200 to 300 € (increased by the bailiff's costs for the search and seizure reaching 1,500 to 3,000 €).

In appeal the litigation costs are in the region of 3,000 to 5,000 €.

The loser can also be ordered to pay a part of the lawyer's fees of the opponent party.

However the amount of these orders always remains much below the actual amount of the lawyer's fees (the average granted sum is about 3,000 €, whereas studies on the litigation costs in France show that the costs for a dispute vary between 35,000 and 300,000 €).

All this makes that the financial risks run by the parties are less high in France than in Germany, which less dissuades the plaintiffs from initiating a proceedings without carefully examining the success chances previously.

2.3. After the judgment

As regards patents, the judgment in first instance is generally appealable (2.3.1); the appeal judgment is always appealable before the *Cour de Cassation* (2.3.2).

2.3.1. The appeal

Like in Germany the appeal procedure in France constitutes a full re-hearing *de novo* of the case as to the facts and to the points of law.

If the same lawyers are entitled to represent the parties in first instance and before the *Cour d'Appel*, it is however compulsory to retain an *avoué* who is in fact a specialised professional, he alone entitled to file the written pleadings in the name of the parties before the *Cour d'Appel*.

The *avoué's* role is however minor in the patent cases: it is limited in the facts to hand over to the *Cour* the written pleadings prepared by the lawyer, who should also represent the parties.

In France the higher instance judgment is called „*arrêt*“.

An appeal proceedings takes in average 2 or 3 years.

The judgment handed down by the *Cour d'Appel* can be appealable before the *Cour de Cassation*.

2.3.2. The appeal before the *Cour de Cassation*

Like the *Bundesgerichtshof* the French *Cour de Cassation* practices a review of the judgment of the *Cour d'Appel* remitted to it as to the points of law only.

However it should be noticed that no expert is appointed during an appeal procedure before the *Cour de Cassation*, whereas the appointment of an expert is almost systematic before the *Bundesgerichtshof* in the revocation cases coming directly from the *Bundespatentgericht*.

Before the *Cour de Cassation* only an entitled lawyer, called „*Avocat au Conseil d'Etat et à la Cour de Cassation*“ (they are also called „*Avocats aux Conseils*“), can represent a party; these lawyers can not represent the parties before the *Tribunaux de Grande Instance* and the *Cours d'Appel*.

For all the France about 100 *avocats aux conseils* exist but only a few of them are used to patent cases.

A proceedings before the *Cour de Cassation* takes around 2 years.

It should be noted that the *Cour de Cassation* dismisses about 85 % of the appeals submitted to it; this means that only 15 % of the judgments handed down by the *Cours d'Appel* are quashed.

3. Conclusion

The patent infringement litigation will essentially surprise the German practitioners by the fact that the same judicial court deal with validity and infringement at the same time.

This combination is not only technical: it probably entails a different approach of the infringement, insofar as the judges who decide upon the infringement themselves would delimit the essential contribution of the patent during the discussion on validity.

As far as evidence is concerned, the French system is probably better than the German one, because it sets forth the search and seizure procedure, an effective, rapid and economical tool for the patentees.

The German practitioners will be sometimes surprised by the rhythm of the litigation course which results from the overworking of the French courts.

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Le Contentieux de la Contrefaçon de Brevet en France

A. Casalonga* (FR)

I. Les Actes de Contrefaçon

L'Action en Contrefaçon est définie aux Articles L.613-3 et L.613-4 du Code de la Propriété Intellectuelle (C.P.I.).

L'importation, la fabrication de produits brevetés, en France, de même que l'offre de produits brevetés, la mise dans le commerce ou l'utilisation de tels produits en France, sont constitutives de contrefaçon directe.

Il en est de même pour l'utilisation d'un procédé breveté, ainsi que pour l'offre, à des tiers et en connaissance de cause, d'un procédé breveté. De plus, l'offre, la mise dans le commerce et l'importation, en France, d'un produit fabriqué à l'étranger selon un procédé breveté, sont aussi constitutives de contrefaçon.

Est également une contrefaçon indirecte, la livraison ou l'offre de livraison, en France, à des tiers non autorisés, de moyens en vue de réaliser ou obtenir l'invention brevetée, lorsque ces moyens spécifiques se rapportent à un élément essentiel de l'invention et qu'il est évident qu'ils permettent de réaliser ou obtenir l'invention. Mais, dans ce cas, la preuve de la connaissance de l'acte délictuel devra être rapportée.

Conformément à l'Article L.615-1 du C.P.I., le contrefacteur peut être poursuivi sans signification préalable dès lors qu'il s'agit d'importation ou de production en France de produits brevetés, de fabrication en France selon un procédé breveté, ou bien d'importation en France de produits fabriqués à l'étranger selon un procédé breveté.

Au contraire, il est nécessaire d'informer de l'existence du brevet le présumé contrefacteur qui ne fait que vendre, utiliser ou mettre sur le marché les produits contrefaits, ou qui fournit les moyens permettant la fabrication de produits contrefaits. Ce n'est qu'à partir de la réception de cette information que la poursuite de ces actes pourra être qualifiée de contrefaçon.

II. Les Actions fondées sur une demande de brevet ou sur un brevet délivré

L'action peut être engagée sur la base d'une demande de brevet français ou européen.

Si la demande de brevet français n'est pas publiée, une copie certifiée de la demande doit être envoyée au présumé contrefacteur dont seule la poursuite des acti-

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vités peut être qualifiée de contrefaçon. Cette procédure est inutile pour une demande de brevet français publiée ou un brevet français délivré.

S'il s'agit d'une demande de brevet européen désignant la France mais rédigée en une langue étrangère, l'action ne pourra être engagée qu'après la publication de la demande de brevet et de la traduction des revendications, en français.

S'il s'agit d'un brevet européen délivré désignant la France rédigé en une langue étrangère, la traduction complète du titre, en français, doit être publiée par l'Institut National de la Propriété Industrielle (I.N.P.I.). Cependant, l'action peut être engagée dès la publication de la délivrance du brevet, la preuve de la publication de la traduction pouvant être fournie ultérieurement.

III. La Preuve de la Contrefaçon. La Saisie Contrefaçon

La saisie-contrefaçon est le moyen généralement utilisé en France pour obtenir la preuve de la contrefaçon. Cette procédure est ordonnée par le juge, sur requête du titulaire du brevet, dès lors que le brevet a été déposé ou délivré, qu'il est toujours en vigueur et que le demandeur a des droits sur le titre. Il s'agit d'une procédure *ex-parte*, exécutée sans aucune signification préalable au contrefacteur présumé.

La loi prévoit que le breveté peut, sur simple requête adressée au juge, être autorisé, par ordonnance, à faire établir un constat d'huissier aux termes duquel il apportera la preuve de la contrefaçon. L'huissier peut se faire assister d'un expert qui, en pratique, est le Conseil en propriété industrielle du titulaire du brevet.

La saisie-contrefaçon peut être pratiquée sur le lieu même de production de la contrefaçon présumée et l'huissier procède, conformément à l'ordonnance, soit à la description du produit ou du procédé présumé contrefait, soit à la saisie d'un certain nombre d'exemplaires de ces mêmes produits, accompagnée d'une description et de photographies s'il y a lieu.

L'huissier est généralement assisté du Conseil en propriété industrielle du breveté, ainsi que d'un commissaire de police et de tout autre personne habilitée le cas échéant (photographe...)

L'huissier établit un procès-verbal dans lequel figurent toutes les preuves matérielles (photographies, photocopies, notices des produits ou procédés contrefaits...). Une copie du procès-verbal sur la base duquel sera exercée l'action en contrefaçon est laissée à la partie ayant fait l'objet de la saisie.

IV. L'Assignment

À peine de nullité, une assignation en contrefaçon doit être présentée devant le tribunal de grande instance compétent dans les quatorze jours suivant la saisie contrefaçon, à l'encontre d'au moins un des présumés contrefacteurs.

L'assignation fait sommairement état des arguments du demandeur, établissant par exemple les caractéristiques essentielles de l'invention brevetée et les ressemblances observées avec le produit contrefait, tel que le procès-verbal de saisie-contrefaçon l'a démontré.

L'assignation doit contenir la liste exacte et complète des revendications présumées contrefaites qui sont invoquées, et en outre, indiquer les motifs de l'action ainsi que les demandes de cessation de la contrefaçon et de réparation des dommages subis.

V. La Compétence juridictionnelle

Les règles de compétence juridictionnelle applicables sont définies au Nouveau Code de Procédure Civile (N.C.P.C), même si l'on observe une tendance à appliquer les règles définies par la Directive qui a remplacé la Convention de Bruxelles. Conformément aux dispositions du NCPC, l'action doit être portée devant l'un des dix tribunaux compétents en matière de brevets, et situés notamment dans les principales villes françaises.

Le Tribunal compétent sera celui dans le ressort duquel est situé le domicile du présumé contrefacteur (le défendeur), ou bien celui du lieu où la saisie-contrefaçon a été effectuée (où l'infraction a été constatée). Si le présumé contrefacteur n'a pas d'activité (siège social) en France, l'action devra être portée devant le tribunal de grande instance de Paris, ou bien devant le tribunal dans le ressort duquel la saisie contrefaçon a été effectuée.

VI. Les Mesures provisoires

Dès lors que la saisie a rapporté la preuve de la contrefaçon, et après la délivrance de l'assignation mettant en œuvre l'action en contrefaçon, le breveté peut en outre demander au Président du tribunal de grande instance d'ordonner immédiatement la cessation de la contrefaçon.

Deux conditions doivent avoir été remplies :

- L'action en contrefaçon doit avoir été engagée à bref délai, soit, au plus tard quelques mois (en général six mois) après que le breveté a eu connaissance de la contrefaçon.
- L'action engagée doit se fonder sur des motifs réels et sérieux. Cela signifie que la contrefaçon devra apparaître de manière indubitable et qu'il ne pourra être opposé aucune antériorité sérieuse.

La mesure provisoire ordonnée par le Président du Tribunal intervient environ quatre mois après avoir été demandée par le titulaire du brevet, et est susceptible de recours.

VII. L'Echange de Conclusions

Dès lors que le défendeur a été assigné, il dispose d'un délai pour présenter ses conclusions par écrit. Pour sa défense, il peut d'une part, contester les faits qui lui sont reprochés et notamment la contrefaçon, et d'autre part

contester, par une demande reconventionnelle en nullité, la validité du brevet.

Les conclusions se présentent sous la forme d'un document, (généralement de 10 à 20 pages) dans lequel le défendeur conteste la contrefaçon et/ou la validité du brevet (défaut de nouveauté ou d'activité inventive, insuffisance de description de l'invention, ou tout autre motif de nullité prévu par la loi française ou la Convention sur le Brevet Européen).

Le défendeur bénéficie d'un délai de 4 à 6 mois à compter de la réception de l'assignation pour présenter ses conclusions.

Le demandeur peut ensuite présenter des arguments contradictoires, démontrant par exemple que l'invention demeure brevetable malgré les arguments développés par la partie adverse.

D'autres échanges de conclusions peuvent intervenir entre les parties. Bien qu'il soit possible d'introduire de nouveaux arguments à l'occasion de ces échanges, il est naturellement préférable de maintenir la même stratégie durant toute la procédure. Les dernières conclusions doivent prendre la forme de conclusions récapitulatives qui permettent aux magistrats de disposer de toute l'argumentation de chaque partie sous la forme d'un document unique.

VIII. La Nomination d'un Expert

Les tribunaux ne sont pas tenus de se faire assister d'un expert. Cependant, dans certains cas, les parties préféreront solliciter du tribunal la nomination d'un technicien chargé d'une expertise. Cela peut s'avérer nécessaire lorsqu'il s'agit d'un brevet portant sur une invention dans le domaine de la chimie, pour laquelle les produits argués de contrefaçon nécessitent un certain nombre d'analyses et de tests de comparaison.

Si le Tribunal décide de nommer un expert, il lui soumet un certain nombre de questions. L'expert organise plusieurs réunions avec les parties concernées, au cours desquelles elles pourront exposer leurs arguments. Selon le degré de difficulté rencontrée, l'expertise peut se dérouler sur une, parfois deux années.

À l'issue de son expertise, l'expert rédige un rapport dans lequel il apporte des réponses aux questions posées par le Tribunal. Les parties ont ensuite l'opportunité de discuter le rapport de l'expert dans le cadre de conclusions adressées au tribunal.

IX. L'Audience et les Plaidoiries

Après un certain nombre d'échanges de conclusions (généralement 3 à 5) le juge de la mise en état décide de clôturer le dossier et fixe une date limite pour procéder au dépôt la mise en état de conclusions finales, de même qu'une date d'audience. Celle-ci se déroule généralement un à deux ans après l'assignation, sauf si un expert est nommé, auquel cas le délai peut être prolongé d'un ou deux ans.

L'audience doit être minutieusement préparée, et la plaidoirie de l'avocat devra se fonder sur les conclusions. Cependant, il arrive que les avocats s'écartent légèrement de l'argumentation développée dans les conclusions. Il est donc nécessaire de se préparer à cette éventualité.

La plaidoirie de chacun des avocats représentant les parties dure 1 à 3 heures. Le demandeur intervient en premier, le défendeur ayant ainsi l'opportunité de répondre aux arguments du demandeur.

Généralement, l'audience se déroule sur une demi-journée, voire deux si l'affaire le requiert.

À l'issue de l'audience, les avocats remettent aux juges du Tribunal un dossier de plaidoirie complet et détaillé, reprenant l'ensemble des faits et des arguments développés au cours de la procédure écrite et de la plaidoirie. La décision du tribunal intervient généralement dans les trois mois qui suivent l'audience.

X. Le Jugement du Tribunal

Lorsque la décision de première instance est rendue en faveur du demandeur, le juge ordonne généralement la nomination d'un expert chargé de calculer le montant des dommages. Le juge peut ordonner simultanément le paiement d'une provision.

Dans la plupart des cas, la décision du tribunal ordonne l'interdiction immédiate de la poursuite de la contrefaçon. Dans ce cas, le présumé contrefacteur doit cesser de vendre ou fabriquer les produits argués de contrefaçon, y compris durant la procédure d'Appel si celle-ci est mise en œuvre.

XI. La Procédure d'Appel

Cette procédure est similaire à la celle de première instance, et dure généralement aussi longtemps.

En conséquence, les parties s'échangent par conclusions leurs arguments par écrit. Durant la procédure d'appel, les parties peuvent ne pas se limiter aux arguments avancés en première instance, mais apporter de nouveaux arguments et fonder leur argumentation sur de nouvelles antériorités.

L'audience en appel intervient environ deux ans après la décision de première instance et présente les mêmes caractéristiques que celle-ci.

Lorsque le demandeur obtient gain de cause, la Cour d'Appel rend une ordonnance afin de faire cesser la contrefaçon définitivement.

La Décision prononcée, le défendeur ne peut plus poursuivre les actes de contrefaçon qui lui ont été reprochés, à peine de dommages élevés.

La Cour peut en outre, d'une part, ordonner la destruction ou la remise au titulaire des produits contrefaits, et d'autre part, autoriser la publication d'extraits de sa décision dans divers journaux et publications.

Enfin, si la Cour l'Appel a confirmé la Décision de première instance, il n'y a pas lieu de faire intervenir l'expert qui a déjà déterminé le montant des dommages.

Si, au contraire, la décision rendue en Appel a infirmé celle de première Instance alors que le défendeur avait été débouté de sa demande, la cour devra nommer un expert à cet effet.

Conformément aux dispositions du Code de procédure civile, l'Arrêt rendu et le montant des dommages s'y rapportant sont limités à la contrefaçon constatée en France.

Les Décisions qui étendent leurs effets au-delà du territoire national ne peuvent être envisagées que dans le cadre des dispositions de la Directive remplaçant la Convention de Bruxelles.

XII. La Réparation du dommage du fait de la Contrefaçon en France

Le montant des dommages doit correspondre au préjudice subi par le demandeur.

Si le titulaire du brevet réalise la fabrication du produit breveté en France ou utilise le procédé breveté sur le territoire national, il pourra prétendre à recouvrer les gains manqués sur les ventes perdues.

Ces gains manqués sont généralement calculés en tenant compte du nombre de produits contrefaits vendus ou fabriqués par le contrefacteur et de la marge habituellement réalisée par le titulaire sur le produit breveté. Si le produit breveté constitue uniquement une partie d'un ensemble, le tribunal devra déterminer si l'ensemble incluant la partie brevetée doit être considéré, ou non, comme un tout commercial. Le montant des dommages sera calculé en proportion. Le tribunal devra de même prendre en considération les capacités (industrielles et d'implantation sur le marché...) du titulaire du brevet par rapport à celles du contrefacteur, pour déterminer si le breveté aurait été en mesure de fabriquer ou vendre le produit en question dans les mêmes proportions que le contrefacteur.

Si le titulaire du brevet n'exploite pas l'invention en France (par exemple, ne fait qu'importer les produits brevetés) les dommages alloués seront calculés sur la base du taux habituel d'une redevance de licence, selon le domaine technique considéré.

Si le titulaire du brevet a concédé une licence en France et que le breveté et le licencié ont engagé conjointement une procédure unique, ils peuvent chacun obtenir la réparation de leur préjudice respectif. Le breveté sera, dans ce cas, fondé à recevoir des dommages-intérêts correspondant à une indemnité de redevance, et le licencié le sera au titre des gains manqués.

Le montant des dommages-intérêts est déterminé par un expert, nommé en première instance ou en Appel, selon le degré de juridiction qui a prononcé la contrefaçon. Celui-ci est autorisé à examiner les comptes des parties.

Lorsque l'expert a estimé un montant pour réparer les dommages, il rédige un rapport dans lequel il expose ses conclusions à la juridiction qui l'a nommé. Cette juridiction, Tribunal de Grande Instance ou Cour d'Appel,

entend alors les arguments des parties concernant le montant des dommages-intérêts et les différentes réparations, qui lui sont exposés, d'abord par écrit sous forme de conclusions, puis oralement au cours d'une audience de plaidoirie.

Si le montant des dommages est déterminé par le TGI (1^{ère} instance), les parties peuvent interjeter appel afin de faire reconsidérer ce montant, ce qui reporte d'autant la fin de la procédure.

Dans tous les cas, le montant des dommages-intérêts finalement déterminé fait l'objet d'une réévaluation tenant compte de l'inflation qui s'est produite depuis le début de la procédure.

XIII. Les Frais de Procédure

Le tribunal accorde généralement à la partie ayant obtenu gain de cause, une somme forfaitaire qui dépasse rarement 20 000 €, en réparation des frais du procès.

Le défendeur qui obtient gain de cause ne reçoit généralement aucune compensation supplémentaire, même lorsque le tribunal déclare le brevet nul ou écarte la contrefaçon.

XIV. La Cassation

Les arrêts rendus par la Cour d'Appel sont susceptibles d'un pourvoi en Cassation. La Cour de Cassation ne se prononce que sur des points de droit concernant l'arrêt attaqué. La procédure n'est pas suspensive, de sorte que le contrefacteur ne peut poursuivre les actes de contrefaçon dès lors que la Cour d'Appel a reconnu l'existence de la contrefaçon et la validité du brevet.

Devant la Cour de Cassation, les parties font état de leurs arguments essentiellement par écrit et l'Arrêt de la Cour de Cassation intervient après une à deux années.

Si l'arrêt de la Cour de Cassation confirme la décision rendue en appel, il est mis fin à la procédure.

Dans le cas contraire, la Cour de Cassation „casse“ l'arrêt de la Cour d'Appel, et l'affaire est renvoyée en appel devant une autre Cour d'Appel. Les parties devront à nouveau présenter leurs arguments par conclusions et lors d'une nouvelle audience devant la Cour d'Appel de renvoi. La procédure est la même que celle suivie précédemment en appel. Cependant, la Cour d'Appel de renvoi suit généralement les conclusions de l'Arrêt de Cassation.

Très rarement, il se peut que la Cour d'Appel de renvoi rende une décision similaire à celle initialement rendue en appel. Dans ce cas, sa décision est à nouveau susceptible d'un pourvoi en cassation, mais cette fois par la cour de Cassation composée de cinq Juges (au lieu de trois) dont la décision finale devra être impérativement confirmée par une nouvelle et dernière Cour d'Appel de renvoi.

Tritura Fori*

P. Gendraud** (FR)

Le praticien Européen connaît bien les particularités et les avantages de la procédure française de saisie-contrefaçon¹.

Cependant, il ignore en général de nombreuses autres caractéristiques tout aussi intéressantes du droit français de la procédure, telles que *l'expertise*², et il peut être surpris lorsqu'au détour d'un litige, en France, il se trouve attiré par l'adversaire dans ce dédale.

Pourtant les règles sont simples, saines et surtout équitables.

Le présent article a pour vocation de donner un fil conducteur d'Ariane au plaideur et à ses représentants ou assistants, en France, qui se seraient égarés dans une telle procédure.

1 – Sur l'introduction de l'expertise :

Une expertise peut être demandée par l'une des Parties à tout instant du litige.

Encore faut-il trouver un intérêt à une telle demande, et que le juge suive la Partie demanderesse dans sa demande.

Selon l'article 232 du Nouveau Code de Procédure Civile (NCPC), le juge peut commettre toute personne de son choix „ pour l'éclairer par des constatations, par une consultation ou par une expertise sur une question de fait qui requiert les lumières d'un technicien. ”

La Partie adverse peut toutefois s'opposer à cette nomination, si elle n'en voit pas l'intérêt, et ce d'autant plus que la gestion du temps dans un litige peut être cruciale.

In limine litis, une expertise pourra ainsi être demandée pour trier dans les documents saisis, ceux qui présentent un intérêt pour la solution du litige et que l'on doit remettre au saisissant, alors même que confidentiels, et ceux qui ne présentent pas d'intérêt et que l'on doit alors écarter.

Au cours du litige, une expertise pourra ainsi être demandée pour déterminer par exemple la composition d'un produit saisi, la structure ou le fonctionnement d'un composant complexe.

En fin du litige, une expertise comptable pourra être demandée pour évaluer la masse contrefaisante et déterminer le montant des dommages et intérêt à allouer à la

Partie lésée pour réparer le préjudice causé par la contrefaçon.

Une telle expertise peut même être ordonnée avant tout litige, en vertu de l'article 145 du NCPC, comme une „ *mesure d'instruction in futurum* ”, s'il existe un motif légitime de conserver ou d'établir avant tout procès une preuve dont pourrait dépendre la solution d'un litige éventuel. Le juge peut ordonner une telle mesure d'instruction, à la demande du breveté, par requête ou en référé.

2 – Sur le choix de l'expert :

Le juge peut désigner comme expert „ toute personne de son choix ”.

Il peut désigner un ou plusieurs experts ; il en choisit généralement un seul dans une liste d'experts. Ces listes sont constituées par ressort de Cour d'Appel, et contiennent des rubriques par spécialités techniques.

Une liste nationale existe, qui regroupe tous les experts agréés par la Cour de Cassation.

Mais ne figurent sur cette liste que les experts ayant une ancienneté d'inscription sur une liste de Cour d'Appel supérieure à trois ans, et souvent plus proche de dix ans.

L'expert inscrit sur une telle liste a prêté serment de remplir sa mission „ avec conscience, objectivité et impartialité ”.

L'expert non inscrit sur une telle liste devra prêter serment avant de remplir sa mission.

L'expert peut être récusé pour les mêmes motifs que le juge, notamment pour défaut d'impartialité, par exemple s'il connaît une des Parties.

Ainsi, un expert ne saurait être le salarié ou le conseil d'une des Parties.³

Au motif indiscutable de l'application à la procédure de l'article 6-1 de la Convention européenne des droits de l'homme, on a jugé récemment en matière de logiciel que ne pouvait être „ l'expert ” une personne non indépendante d'une partie requérante à la mesure⁴.

La doctrine est unanime quant au respect de ce principe, et la jurisprudence aussi.

* „ Les us et coutume du prétoire ”, Balzac, Le Colonel Chabert, selon les mots de Me Derville, Avoué.

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1 Droit d'auteur : L.332-1 et articles suivants du Code de la propriété intellectuelle ; Logiciel et bases de données : L.332-4 ; Dessins et modèles : L.521-1 ; Brevets : L.615-5 ; Obtentions végétales : L.623-27 ; Marques : L.716-7.

2 Nouveau Code de Procédure Civile (NCPC), articles 232 et suivants.

3 Voir ainsi une main-levée de saisie de logiciel en ce que la décision sur requête autorisait à tort la désignation d'un salarié du saisissant comme expert et au visa là encore de la Convention Européenne des Droits de l'Homme : TGI Lyon, Ord. réf., 16 déc. 2002, Iris Inspection Machines et autres c/ MSC. Cela passait avant pour permis quand l'ordonnance le permettait ou ne l'interdisait pas. Ainsi, voir une décision plus ancienne pour la régularité d'une saisie en matière de brevets en la présence d'un salarié du requérant et également d'un conseil en propriété industrielle du même requérant : CA Lyon, 8^{ème} Ch. civ., 3 septembre 2002, Affaire BioMérieux c/ BioRadPasteur.

4 Cass. civ. 1^{ère}, 6 juill. 2000 : PIBD 2001, 714, III, 87 ; Juris-Data n° 002826 ; Com. com. électr., Oct. 2000, comm n° 98, Christophe Caron, pour une saisie de logiciel. *Adde*, déjà, Cass. civ. 1^{ère}, 2 déc. 1997 : JCP E 1998, I, p.803, observations de Vivant et Le Stanc.

Ainsi, dans une décision de la Cour d'Appel de Toulouse, en date du 17 avril 2003, relative à une expertise ayant pour objet le tri de documents saisis lors d'une saisie-contrefaçon, il a été jugé : „ *Il est de principe en droit interne qu'un expert, surtout lorsqu'il est désigné par le juge, est un professionnel dont l'impartialité et l'indépendance à l'égard des parties ne doivent pas être mises en doute ce qui (...) ne saurait être le cas s'il a par ailleurs d'une manière ou d'une autre conseillé ou assisté l'une d'entre elles. Il reste à cet égard à vérifier si la nature de la mission des deux conseils en propriété industrielle impose qu'elle soit confiée à un ou des experts présentant les garanties ci-dessus rappelées* ”.

La sanction du défaut d'impartialité est lourde ; en l'espèce, la saisie a été annulée.

Une particularité du droit des brevets est la consultation préalable et obligatoire en cette matière par le juge d'un des organismes prévus par la loi (par exemple l'INPI), avant toute désignation d'un expert dans cette matière.

L'organisme consulté suggère en général plusieurs experts compétents, mais le juge *in fine* peut désigner un autre expert de son choix, le nom de l'expert pouvant même lui être suggéré par les Parties s'accordant sur ce seul point.

La décision de justice devra indiquer que cette consultation a bien été effectuée.

La sanction du défaut de consultation est également lourde ; la désignation de l'expert est annulée et si l'expertise est achevée et le rapport déjà rendu, l'expertise sera aussi annulée et toute la procédure devra être reprise.

Les Parties veilleront donc à la bonne désignation et au bon choix de l'expert, dans leur intérêt bien compris.

3 – Sur le déroulement de l'expertise :

La décision qui désigne l'expert précise sa mission et le délai qui lui est accordé pour remplir cette mission.

La mission de l'expert ne peut porter que sur des questions de fait, et non sur des questions de droit. Une décision de justice qui donnerait à l'expert le soin de répondre à des questions de droit serait réformée ou cassée par les instances supérieures, Cour d'Appel ou Cour de Cassation.

L'expert ne peut avoir pour mission de concilier les Parties ; toutefois, celles-ci peuvent se concilier pendant la procédure d'expertise, et souvent elles le font.

L'expert doit remplir sa mission, toute sa mission, rien que sa mission.

Il doit remplir personnellement sa mission, et ne peut pas la confier à un employé ou entièrement à un autre expert.

Il peut cependant se faire assister d'un autre expert dans une spécialité qui n'est pas la sienne, et pour une partie seulement de la mission.

Une expertise est en général une phase assez longue du procès, typiquement plusieurs mois, quelquefois plusieurs années. La moyenne semble être de six mois en matière de brevets.

L'expert doit respecter pendant toute la procédure d'expertise les principes directeurs du procès, et en particulier le principe du contradictoire.

Toutes les pièces qui sont examinées par l'expert sont soumises à la contradiction des Parties.

Et la sanction est également lourde pour le non respect du contradictoire ; c'est toujours la nullité de la procédure.

Avant de commencer sa mission, la Partie demanderesse aura consigné une certaine somme fixée par le juge dans sa décision initiale.

Le Greffe prévient l'expert que la somme a bien été consignée par la Partie demanderesse, la saisine de l'expert est ainsi confirmée et la phase d'expertise proprement dite peut alors commencer.

L'expert ne reçoit aucune somme directement des Parties. Si des frais doivent être supportés pour le bon déroulement de l'expertise, c'est l'expert qui les supportera, mais ces frais lui seront remboursés sur mémoire.

L'expert pourra ainsi faire effectuer des analyses par un laboratoire d'Etat ou un laboratoire Universitaire ; il devra toutefois conserver la conduite des opérations au travers d'un protocole élaboré contradictoirement avec les Parties et dont il sera garant.

Les frais d'analyses seront réglés par l'expert au laboratoire ; et l'expert aura pris soin de faire consigner une somme complémentaire si ces analyses n'étaient pas prévues à l'origine ou si la provision initiale est dépassée.

4 – Sur l'achèvement de l'expertise :

L'expertise s'achève à la remise du rapport d'expertise.

Et le rapport original est adressé au juge qui a commis l'expert, les Parties reçoivent seulement une copie du rapport.

Toutefois, dans certains cas, l'expert aura pris soin d'établir un pré-rapport, qu'il aura soumis aux Parties pour purger le contradictoire et recueillir des Parties leurs observations écrites sous forme de dires.

Le juge n'est pas tenu de suivre les conclusions du rapport d'expertise, et garde son pouvoir souverain d'appréciation.

Avec le rapport définitif, l'expert adresse au juge un mémoire d'évaluation de sa rémunération et de ses débours.

Sur la base de ce mémoire, le juge rend une ordonnance de taxation, suivant généralement l'évaluation de l'expert.

Mais les Parties peuvent contester cette évaluation, par un recours spécifique.

A défaut d'un tel recours, l'expert reçoit le montant ainsi taxé du service de la Régie du Tribunal.

Ainsi, l'expert n'est pas réglé par l'une des Parties, ce qui pourrait porter atteinte à son impartialité, mais par le Tribunal au moyen des sommes consignées.

Et cette somme consignée, qui a été avancée par la Partie demanderesse, est récupérée par elle si elle triomphe au litige.

5 – En conclusion :

Voici bien une procédure originale du droit français.

Cette procédure est connue de plusieurs Etats de droit latin. Il en est ainsi de l'Italie, et de la Belgique.

D'autres Etats européens semblent préférer le panachage des juges, c'est à dire un mélange de juristes et de techniciens au sein même de l'entité judiciaire, ou une instance judiciaire ne comprenant que des juges purement techniciens. Il en est ainsi de la République Fédérale d'Allemagne et de la Suède.

Dans des matières complexes, telles que des litiges de brevets, le juge technicien peut alors s'emparer du fond du litige car lui seul le comprend et le juge juriste dépossédé ne s'intéresse plus alors qu'au respect des conditions formelles.

Au Royaume-Uni et aux Etats-Unis, les Avocats vont rechercher auprès de personnalités désignées alors comme „*expert witnesses*” des consultations non contradictoires, qu'ils fournissent au juge pour appuyer leurs thèses.

Les Parties qui disposent de moyens importants font alors pencher la balance de la justice vers leur thèse,

soutenue par de nombreux rapports qui manquent quelque peu d'objectivité.

Si les Parties disposent de moyens équivalents, elles produisent alors chacune un ou des rapports qui sont en complète contradiction l'un avec l'autre.

„*Felix qui potuit rerum cognoscere causas*”⁵.

Un étude complète sur le rôle et la fonction des experts dans de nombreux Etats du monde a été faite par l'A.I.P.P.I., lors du Congrès de Rio de Janeiro, Brésil en 1998, étude à laquelle le lecteur pourra utilement se reporter⁶.

Dans les futurs Tribunaux des Brevets Communautaires, le choix devra être fait entre ces trois visions du déroulement d'un litige à consonance technique, à savoir une expertise judiciaire, un panachage ou des expertises privées.

Ils devront toutefois respecter le principe fondamental „*Toute personne a droit à un procès équitable*”, sans lequel il n'y a pas de justice.

Dans leur grande sagesse, nos législateurs trancheront sur la meilleure procédure à mettre en place pour nos futures institutions.

Espérons pour nous tous que ce sera la meilleure.

Representation in Patent Infringement Proceedings before Centralised Courts

W. Holzer (AT)

The Institute of Professional Representatives before the European Patent Office (*epi*) comprises all European patent attorneys active in industry or in the free profession, currently about 7400, who are registered on the list of professional representatives maintained by the European Patent Office. The members of the Institute are entitled to represent parties before the European Patent Office not only in application and grant proceedings, but also in opposition and appeal proceedings, i.e. in proceedings involving the validity of the patent, which take place after the European patent has become a bundle of national patents. Most European patent attorneys are also national patent attorneys in the member states of the European Patent Convention.

In principle several functions are possible which patent attorneys can or could fulfil in patent infringement proceedings before civil courts.

- a) The patent attorney can be the sole representative of a party and conduct litigation proceedings;
- b) The patent attorney can act as an assistant to his party who accompanies an attorney at law during the whole proceedings, i.e. the written procedure and court hearings, taking of evidence and so forth, and who is allowed to address the court, i.e. enjoys a right of audience;
- c) The patent attorney can be an expert witness;

d) The patent attorney can act as a private or court appointed expert;

e) The patent attorney can become a „lay judge” skilled in the art, i.e. „technical judge” in a court panel.

Except for the last function, patent attorneys could fulfil all of the other functions also in infringement proceedings before criminal courts. The following text, however, will refer to civil law proceedings.

The most important aspects in connection with infringement proceedings naturally are items a) and b) and perhaps also e) above, because these roles of patent attorneys must also be addressed in the context of the envisaged new pan-European patent court systems, be it a court of the European Patent Judiciary (EPLA) for a certain number of EPC member states or a centralised Community Patent Court.

If we consider the present situation in the member states of the EPC, we find totally different national provisions concerning representation by patent attorneys before civil courts. It is sufficient to mention that the provisions range from no representation powers before courts at all, via the right to act as an assistant to the

⁵ „Heureux celui qui a pu pénétrer le fond des choses”, premier vers d'un passage célèbre des Géorgiques.

⁶ Groups reports Q 136 : The role and function of experts in patent disputes.

party, to the possibility to act before courts alone, for example in the UK, where a Patents County Court has been set up before which patent attorneys can represent alone in infringement proceedings. In the UK moreover, a patent litigator's certificate has been introduced for patent agents (CIPA Fellows, i. e. full members of CIPA).

In litigation before the national civil courts representation by an attorney at law is normally mandatory, for historical reasons related to the basics of civil law, although patent attorneys play a or „the“ major role in these proceedings. Many of our colleagues consider it unjust that patent attorneys cannot represent parties before courts on their own and look for a change.

It is therefore a demand of the patent professionals in Europe, in particular also of the members of the Institute of Professional Representatives before the European Patent Office (*epi*), to secure adequate representation rights in any proceedings before the new pan-European courts, and this in all instances. This is the more relevant, because it is envisaged that before these courts infringement and invalidity issues will be taken together in order to expedite the proceedings.

We are quite aware of the fact that for the possibility of representing alone, as mentioned under a) above, a price will have to be paid by European patent attorneys in the form of an acquired additional qualification. Any such qualification, for example in the form of a patent litigator's certificate, would encompass knowledge of the relevant European national and international laws governing patent infringement, procedural laws, civil laws, the Brussels and Lugano Conventions, contract laws etc. Academic training courses could be offered for example by universities. We realise that all this requires time and effort. However, now would be the right time to start the exercise, and many of our colleagues are quite prepared to accept the challenge. As a first step, the CEIPI and the *epi* are now organising a Course on Patent Litigation in Europe, albeit, due to organisational restraints for a very limited number of participants. The aim is to enable European patent attorneys to acquire a deepened knowledge of patent litigation procedures in Europe and of future centralised proceedings, as well as of related rules of procedure, in order to better advise their clients on the enforcement and defence of European patents. This would for example also enable them to take tricky infringement issues, such as concerning equivalents, already into account when prosecuting applications before the EPO. Such courses in the framework of continued education for European patent attorneys could hopefully be offered in the future to a greater number of participants by a centralised European training institution, which is now under discussion.

If European patent attorneys are competent to deal on their own with, for example, opposition and appeal proceedings before the EPO, whose Boards of Appeal are considered autonomous judicial authorities, or with national invalidity proceedings, European patent attorneys should also be competent to act before the future centralised courts in patent matters. It is encouraging that in the framework of the draft EPLA so far at least the

right of audience has been accorded to European patent attorneys, and that further representation activities are not excluded.

A Realistic Model

Simply as a functioning model of today I will present the current situation in Austria, which is not unfavourable to the rights of patent attorneys in court proceedings and trials.

Patent infringement can be prosecuted according to Austrian Criminal Law and Austrian Civil Law. Civil Law patent infringement actions, including actions for preliminary injunctions, for the whole of Austria are brought before the Economic Court Vienna („Handelsgericht Wien“), which is a central court of first instance. Criminal proceedings are dealt with by the Regional Court Vienna („Landesgericht für Strafsachen Wien“), also for the whole of Austria.

Actions in patent or inventor's disputes between employers and employees are dealt with by Labour and Social Courts. The situation regarding the involvement of patent attorneys before these courts, with one exception, is similar to that before the Economic Court.

Nullity proceedings against patents as well as petitions for a declaration of infringement or non-infringement, on the other hand, are dealt with exclusively by the Nullity Department of the Austrian Patent Office in the first instance, and by the Supreme Patents and Trademarks Senate in the second instance. It is of interest that the latter is a court-like judicial authority with a panel of five, of which the president is always a judge and which by the Court of First Instance in Luxembourg is accepted as a court. Thus, should this authority involve the Court of First Instance with a preliminary decision, an Austrian patent attorney, who can represent alone before this second instance authority in Austria, would even be entitled to represent alone before the European Court of First Instance.

Decision Taking Bodies

The Economic Court Vienna decides „without taking heed of the sum in dispute“ in panels composed of two professional judges and one so-called lay judge „skilled in the art“ („fachkundiger Laienrichter“) who normally is an experienced patent attorney. In other words, these court panels avail themselves of „technical judges“. The same panels also decide on petitions for preliminary injunctions.

It is obvious that the involvement of a patent attorney acting as a lay judge „skilled in the art“ first of all has the benefit that this technical judge can be chosen according to the particular technical field in question (physics, mechanics, biology...), and secondly, that the necessary competence is applied to the case, because the patent attorney is well versed both in technical and patent law matters, due to the training of patent attorneys, which in Austria comprises a wide spectrum of laws (e.g. patent

law, trademarks law, design law, unfair competition law, civil law with particular emphasis on procedural law, criminal law, international law etc). In Austria the lay judge system at the Economic Court was established in 1896 already. The explanatory notes to the Patents Act 1984 confirm: „A patent litigation proceedings as a rule beyond (mere) legal knowledge requires technical, chemical and the like knowledge which cannot be expected from a professional judge, however can be expected from a lay judge skilled in the art“.

The lay judge is appointed by the Minister of Justice (upon a nomination by the Chamber of Commerce, after consultation with the Austrian Chamber of Patent Attorneys) for a term of three years (with a possible reappointment up to twelve years). This lay judge in performing his duties is independent and has all obligations and rights of a professional judge, i. e. impartiality and independence. Lay judges like professional judges can be refused and expelled.

It must be stressed that the lay judge does not act as an expert, he is not an „expert judge“, but a technically versed judge, i. e. „technical judge“, meaning that he does not contribute an expertise that is included in the trial verdict, but discusses the technical merits of the case with his solely legally trained colleagues, in acting as a sort of technical interpreter between the parties (and their patent attorneys) and the legal judges of the panel.

Also in appeal proceedings the Patents Appeal Court, i. e. the High Regional Court („Oberlandesgericht Wien“), avails itself of a lay judge in cases in which apart from purely formal legal questions also technical substance as well as so-called mixed questions of a legal and technical nature, such as „equivalence“, are decisive. It goes without saying that in patent infringement cases often legal and technical questions are interwoven and cannot be separated. For example, for resolving „equivalence“ technical considerations are required, such as an assessment of prior art and of the technical contents and scope of the claims.

The Proceedings

In any proceedings in Austria, the parties are represented by an attorney at law, who as a rule has no technical training and habitually acts together with a patent attorney, because pursuant to Art. 16 (2) of the Austrian Patent Attorneys Act, patent attorneys have the right to assist their party in a court proceedings pertaining to inventive matters and to speak, should the party so demand, which is always the case, i. e. they enjoy the right of audience and will argue the technical merits of the case before the court.

The attorneys at law who are formally handling the case are as a rule provided by the patent attorneys with expertises which will form the essential part of the complaint/defense brief. In any patent infringement action the patent is at test, because the action more often than not turns into a sort of „re-examination“ of the patent and its scope. Many actions will end up with

counter-claims of invalidity or inapplicability of the patent.

Counter-Claims and Preliminary Questions

In any proceedings, the defendant can bring forward counter claims of invalidity and non-effectiveness of the patent. Art. 156 Austrian Patents Act stipulates that the „validity or effectiveness of a patent, on which the infringement action is based, can be decided on by the court as a preliminary question autonomously (inter partes), e.g. questions of prior users rights, with the exception that“ if a judgement depends on whether the patent is invalid (Art. 48 Patents Act) the court has to interrupt the proceedings, unless the invalidity is not obviously to be denied“. For this assessment the presence of a patent attorney lay judge in the panel is of essence. If invalidity is claimed, the defendant has to evidence, within one month from the receipt of the interrupting decision, that his patent attorney has filed a nullity action with the Patent Office or an opposition with the EPO, or that a nullity proceedings or opposition is already pending between the parties or that the defendant has joined a (pending) nullity action (between other parties) as an intervenient.

The Court Appointed Expert

Usually an (independent) expertise is requested by one of the parties and, unless the case is clear and ready for the decision, an expert is appointed by the Court, after hearing the parties about the possible person in question. This court appointed expert normally is an Austrian patent attorney. The expert is given a time of typically 6-8 weeks to render his written expertise. To this end, the expert studies the court file and examines the state of the affairs, e.g. at the premises of the alleged infringer, to which he invites the representatives (attorneys at law and patent attorneys) of both parties. A protocol is drafted and forwarded to the parties for comment. The expert may also avail himself of sub-experts, if necessary, such as technical analysis institutions. In order for the expert to commence his work, a certain sum is fixed by the court which must be advanced by the party having petitioned the expertise. The court may also on its own account appoint an expert and require both parties to advance fees. The court appointed expert can be refused for the same reasons as judges can be refused.

The expert's task is to ascertain the facts of the dispute on the basis of his knowledge (art) and to draw conclusions which however may not involve legal questions. Thus, the expert does not conclude that the patent is infringed, he merely assesses whether the features of the claim are met by the allegedly infringing subject matter. After rendering his expertise and debit note, the expert in a further hearing, if so requested by the parties, has to explain his expertise and is cross-examined by the representatives of the parties. The expert may be ordered to draft an additional expertise, or the court can order a

second expertise or a super-expertise, which however is rare.

The Court Certified Expert

As concerns the court appointed expert or any private expert, Austrian patent attorneys and other experts according to an amendment of the General Law on Experts (1998) have the possibility to become „Generally Sworn and Court – Certified Experts in Patent Matters“. This, for example, is an additional qualification that must be acquired. A list of these experts is maintained by the President of the Economic Court Vienna. The expert, who is required to conclude an indemnity insurance, is liable for a wrong expertise pursuant to the General Civil Code. There is a reversal of proof, because in the event of a wrong expertise, the expert has to prove that he is not encumbered. In order to be entered on the list the patent attorney must take an examination before a panel composed of judges and a patent attorney. The certifying examination comprises e.g. knowledge of all relevant laws and of the technique of rendering expertises as well as of the fees to be charged by the expert pursuant to a special Fees Law. The expert initially is entered on the list for five years, which term can be extended by ten years.

Preliminary Injunctions

Art. 147(1) Patents Act states that preliminary injunctions can be obtained, which is necessary in order to rapidly secure a cessation in order to stop the infringer. This is in particular true in a country where the main infringement proceedings are interrupted in case of a separate invalidity counter-proceedings, i. e. pending the outcome of a nullity proceedings before the Austrian Patent Office or an opposition proceedings before the EPO. The court, however, can lift (rescind) an injunction in case of reasons of consideration, if the defendant deposits an adequate security. Unlike in Germany it is quite common in Austria for the court to grant a pre-

liminary injunction if the case merits it, and indeed many litigations are terminated with the preliminary injunction proceedings, which means a rapid procedure.

Temporary injunctions pursuant to the Austrian Patents Act also fall exclusively within the competence of the Commercial Court Vienna. Although the defendant also in this proceedings can bring forward counter-claims, such as invalidity claims, in the preliminary injunction proceedings only such counter-claims are taken into consideration which are based on readily assessable means of evidence („parate Bescheinigungsmittel“). It is therefore difficult in a preliminary injunction proceedings in Austria to come up with an invalidity argument, unless invalidity is clear cut and the court panel with the help of the patent attorney lay judge can come to a short term decision on this point. The court due to the urgency of the case will not appoint an expert to assess the infringement/nullity question. The registration of the patent, e.g. European patent, is rather rated as a prima-facie evidence for the validity thereof, because novelty and inventive activity had been examined by the Patent Office (naturally on the prior art available to the Patent Office in the grant procedure).

Any appeal in a preliminary injunction action is dealt with by the High Regional Court Vienna („Oberlandesgericht Wien“) in panels composed of three judges of whom, if necessary, as mentioned before, one is a patent attorney acting as a lay judge. As already stated, in the appeal no new evidence is allowed. Therefore, the proceedings last for a few months only.

The contribution patent attorneys can make to infringement proceedings due to their competence, intimate relationship with clients and thorough knowledge of the patent particularities guarantee a more in-depth evaluation of the technical merits of the cases, thereby increasing legal certainty. This should be an important argument in favour of granting adequate representation rights to European patent attorneys in the future centralised European courts.

Disziplinarorgane und Ausschüsse
Disciplinary bodies and Committees · Organes de discipline et Commissions

Disziplinarrat (epi)	Disciplinary Committee (epi)	Commission de discipline (epi)
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Disziplinarausschuss (EPA/epi) epi-Mitglieder	Disciplinary Board (EPO/epi) epi Members	Conseil de discipline (OEB/epi) Membres de l'epi
CH – C.-A. Wavre DE – W. Dabringhaus	FR – M. Santarelli	GB – J. Boff
Beschwerdekammer in Disziplinarangelegenheiten (EPA/epi) epi-Mitglieder	Disciplinary Board of Appeal (EPO/epi) epi Members	Chambre de recours en matière disciplinaire (OEB/epi) Membres de l'epi
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epi-Finanzen	epi Finances	Finances de l'epi
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Geschäftsordnung	By-Laws	Règlement intérieur
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Europäische Patentpraxis	European Patent Practice	Pratique du brevet européen
AT – M. Beer AT – G. Widtmann BE – P. Jacques BE – J. van Malderen CH – W. Bernhardt CH – E. Irniger CY – C. Theodoulou DE – G. Schmitt-Nilson DE – F. Teufel DK – P. J. Indahl DK – P. Stahr	ES – E. Armijo ES – L. A. Duran FI – E. Grew FI – A. Weckman FR – A. Casalonga* FR – J. Bauvir GB – P. Denerley** GB – I. Muir GR – D. Oekonomidis IE – P. Shortt IE – C. Lane (Substitute) IT – E. de Carli	IT – A. Josif LU – Bruce Dearling NL – W. Hoogstraten NL – L. J. Steenbeek NL – R. Jorritsma (Substitute) PT – P. Alves Moreira PT – N. Cruz SE – A. Bornegård SE – M. Holmberg TR – A. Deris TR – O. Mutlu TR – S. Coral (Substitute)
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