

European Patent with Unitary Effect and Unified Patent Court

20th Annual Conference on Intellectual Property Law & Policy at
Fordham IP Law Institute

April, 12th 2012, New York

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I. European Patent

1) European Patent

- prosecution before the EPO
- after grant: protection in the individual Contracting States (CS) designated by the applicant like a bundle of national patents
- Example: European Patent (EP) with protection in
 - DE, NL, UK, ES and CH

2) European Patent with unitary effect

- prosecution before the EPO
- after grant: protection in the Member States (MS) of the EU participating in Enhanced Cooperation (all MS, except of ES and IT) and the individual Contracting States designated by the applicant
- Example: EP with protection in
 - all MS of the EU except of ES and IT (“unitary effect”)
 - ES
 - CH

II. Patent Court

1) **European Patent – current**

- **national courts, no cross-border but parallel jurisdictions, exception in preliminary injunction proceedings? cf. Opinion of Advocate General Cruz Villalón, 22 March 2012, C-616/10 – Solvay/Honeywell**
- **Example: EP with protection in**
 - DE - national court in DE
 - UK – national court in UK
 - ES – national court in ES
 - CH – national court in CH

2) **European Patent and European Patent with unitary effect – future**

- **Unified Patent Court**
- **Example: European Patent and European Patent with protection in**
 - designated MS of EU (classical EP) or all participating MS of EU (EP with UE): Unitary Patent Court (if not opt out for classical EP during a transitional period)
 - ES – national court in ES
 - CH – national court in CH

III. Legislation - Patent

- **Draft Regulation**
 - Union law, subject to referrals to the ECJ
- **implementing enhanced cooperation**
 - 25 out of 27 MS (not ES and IT)
 - actions brought by ES (C-274/11) and IT (C-295/11) before ECJ aiming at annulling Council Decision (2011/167/EU) authorising enhanced cooperation
- **in the area of the creation of unitary patent protection**
 - **European Patent with unitary Effect (EP with UE)**
 - **Provisions on**
 - Prior rights (Art. 5)
 - Rights to prevent direct and indirect use of the invention (Art. 6 + 7)
 - Limitation (Art. 8)
 - Exhaustion (Art. 9)
 - EPUE as object of property (Art. 10 + 11)
 - Institutional and financial matters (Art. 12 – 17)

III. Legislation - Court

- **Draft Agreement on a Unified Patent Court and Draft Statute**
 - Agreement between **25 Member States**, but **open to accession by any Member State of the EU**
 - UPC will be a **court common to the Contracting Member States (MS)** and thus part of their judicial system
 - **UPC must request preliminary rulings from the ECJ** in accordance with Art. 267 TFEU
 - **Omissions of the UPC to request preliminary rulings from the ECJ are directly attributable to the Contracting Member States and infringement proceedings are available**

IV. Unified Patent Court

- **Structure and competence of the UPC**
 - **Court of First Instance (CoFI)**
 - **Local Divisions (LD)**
 - action for patent infringement
 - counterclaim for revocation
 - action for provisional injunctions, etc.
 - **Regional Divisions (RD)**
 - competence like LD
 - **Central Division (CD)**
 - action for revocation
 - **Court of Appeal (CoA)**
 - **Registry**

IV. Unified Patent Court

- **Jurisdiction of the divisions of the UPC**
 - **Actions for infringement** shall be brought to
 - the LD or RD hosted by the MS **where the actual or threatened infringement occurred or**
 - the LD or RD by the MS where **the defendant** or, in case of multiple defendants, one of the defendants has his **residence or principal place of business.**
 - In case the MS has no LD and does not participate in a RD actions shall be brought to the CD.
 - In case the defendant does not have his residence or principal place of business in a contracting MS only the first rule (place of infringement) applies.

IV. Unified Patent Court

- **Composition of panels**
 - **Local/Regional Divisions**
 - **3 legally qualified judges** out of which either
 - 2 judges are nationals from the hosting MS and
 - 1 judge is from a Pool of Judgesor
 - 1 judge is a national from the hosting MS and
 - 2 judges are from the Pool of Judgesdepending on whether
 - more than 50 patent cases per annum have been commenced before the LD/RD
 - **1 technically qualified judge** provided
 - a counter-claim for revocation has been raised
 - upon request of one of the parties
 - upon request of the panel

IV. Unified Patent Court

- **Composition of panels**
 - **Central Division**
 - **2 legally qualified judges**
 - **1 technically qualified judge**

IV. Unified Patent Court

- **Language**
 - **Local/Regional Division**
 - **Official EU language of the MS hosting the LD/RD**
 - MS may designate one or more of the official EPO languages
 - Parties may agree on the language of the patent subject to approval of the panel
 - At the request of one of the parties and after having heard the other the President of the CoFI may decide on the use of the language of the patent.
 - **Central Division**
 - **Language of the patent**

IV. Unified Patent Court

- **Proceedings before a Division of the CoFI**
 - **Written Procedure**
 - **Interim Procedure**
 - for which one of the judges of the panel (Judge Rapporteur) is responsible
 - **Oral Procedure**
 - **Duration of Proceedings before a Division of the CoFI shall be no longer than 1 year.**

IV. Unified Patent Court

- **Unitary/Bifurcated Proceedings**
 - **In patent infringement proceedings**
 - **in which a counterclaim for revocation has been brought**
 - **and after having heard the parties**
 - **the LD or RD has the discretion to**
 - **proceed with the infringement action and with the counterclaim for revocation or**
 - **refer the counterclaim for decision to the CD and suspend or proceed with the infringement proceedings or**
 - **with agreement of the parties, refer the case for decision to the CD.**

IV. Unified Patent Court

- **Powers of the Court**
 - **Order to produce evidence**
 - **Order to preserve evidence and to inspect property**
 - **Freezing orders**
 - **Provisional or protective measures**
 - **provisional injunctions**
 - **Permanent injunctions**
 - **Corrective measures**
 - **recall, removal, destruction, etc.**
 - **Decision on the validity of a patent**
 - **Order of the communication of information**
 - **Award of damages**
 - **Legal costs**
 - **Court fees**

IV. Unified Patent Court

- **Representation**
 - **Lawyer** authorized to practise before a court of a contracting MS
 - **European Patent Attorney**
 - who has appropriate qualifications such as a European Patent Litigation Certificate
- **Transitional period**
 - **During a transitional period of 7 years** after the date of entry into force of the Agreement proceedings for infringement may still be initiated before the national courts
 - Holders of European patents or patent applications granted or applied for prior to the end of the transitional period can **opt out**.
 - After a consultation the Administrative Committee may decide **to prolong the transitional period by up to 7 years**.