

Standing Committee on

Unitary Patent / Unified Patent Court

2015



Date: 31st July 2015

REPORT **Standing Committee on**

Unitary Patent / Unified Patent Court

Chair: Alan JOHNSON

Responsible Reporter: Ari Laakkonen

1) Report on the activities of the Standing Committee during the reporting period

The Committee identified the issues relating to the introduction of the UPC which caused it the most concern. Two issues connected with the transitional provisions (Article 83 UPC Agreement) were unanimously considered to be of critical importance. The first related to the circumstances when the UPC and national courts will have competence to determine disputes; whilst the second related to the law applicable when national courts have competence. In both cases, the concern is the lack of clarity in arrangements and consequent legal uncertainty for users. The Committee then prepared papers which have been submitted to the Bureau, with the intention that these be sent to the UPC Preparatory Committee to urge it to take effective steps to increase certainty. In the case of the second paper, this would also be sent to national authorities in UPC Contracting States.

The Committee has also considered the relationship between the UPC and the EPO. Decisions of the EPO in Opposition proceedings generally take many years, as compared with the expectation that UPC cases will be decided in not much more than one year. UPC proceedings will rarely be stayed pending EPO opposition proceedings (only if a rapid decision is expected from the EPO). Therefore, the EPO could potentially overrule UPC decisions by its own subsequent decision. In particular, the UPC could find a patent valid and infringed, but the EPO could later revoke (or materially limit) the patent. In those circumstances, it is unclear what the effect would be as regards damages and costs paid in UPC proceedings, or whether it might be appropriate for the UPC to award injunctions, damages and costs on some conditional basis such that the defendant could be compensated if the EPO later revoked or materially limited the patent. The Committee could not reach any consensus on the right approach in such situations, whilst recognising that clarity would be beneficial. In order to inform the debate, the Committee proposed that a paper explaining the issue should be sent to national groups, and has submitted such a paper to the Bureau. This paper includes a questionnaire for national groups as to whether the equivalent problem arises in their jurisdiction (overlaps in jurisdiction between courts and national/regional granting authorities) and if so, how the overlap is dealt with and/or its consequences.

2) Key issues/developments relevant to the Terms of Reference of the Standing Committee (arising during the reporting period or coming up)

The Committee has identified three issues/developments during the reporting period:

1. Amendments to the Rules of Procedure. The latest changes have been proposed following a public consultation and hearing in Trier, Germany in November 2014. Although the Committee did not propose making any submissions on the draft Rules prior to the Trier hearing, various members of the Committee attended on behalf of national groups and in other capacities.
2. Proposals for unitary patent fees. The issue of fees is of immense significance to users, and will

greatly influence the popularity of the unitary patent. However, the subject is in large part a matter of political negotiation between individual states in their capacity as members of the European Patent Organisation sitting on the relevant Administrative Committee. Hence the Committee did not recommend, (and continues not to recommend) any contribution to the debate.

3. A public consultation on Court fees, running from 8 May to 31 July 2015. The Committee considered making submissions, but considered that reaching consensus would be difficult. However, it considered that a valuable contribution could be made to the debate by organising a survey of national groups relating to the court fees globally. It has therefore prepared such a survey and proposes that the results be consolidated and shared with the Preparatory Committee. Although these results will not be available until about October 2015, it is understood that the debate on Court fees will continue into early 2016, and hence can be considered by the Preparatory Committee as part of its final decision.

- 3) Any recommendation for AIPPI involvement/action (describe what involvement/action is recommended and why, by whom and relevant time frames)
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As outlined above, it is proposed to provide the Article 83 papers to the Preparatory Committee and relevant national authorities. This should be done (by the Chair of the Committee on behalf of the Committee or by the Bureau) as soon as possible.

The results of the fees survey should be consolidated and sent to the Preparatory Committee (by the Chair of the Committee on behalf of the Committee or by the Bureau) in October 2015.

Following analysis of the survey on the overlaps in jurisdiction between courts and national/regional granting authorities, the Committee will consider how this might be used and whether results might be submitted (with or without a recommendation) to the Preparatory Committee and/or candidate judges of the UPC. The timing of this would be in the first part of 2016. Again this would be by the Chair of the Committee on behalf of the Committee or by the Bureau.

- 4) Plan for the activities of the Standing Committee for the next reporting period highlighting any priorities
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In addition to the work outlined at 3 above, the Committee proposes to consider at least two matters:

1. The issue of enforcement of UPC decisions. Enforcement relies upon national procedures and authorities. It is proposed that this work be considered in conjunction with the Enforcement Committee
2. The issue of protection of confidential information submitted within UPC proceedings. Some such information may be produced by compulsion as well as voluntarily, and among the issues arising under this heading are the availability and effectiveness of protective orders and the circumstances under which orders protecting confidentiality may be varied or lifted following third party intervention.

Names and Functions of Committee Members

Chair	Alan JOHNSON	United Kingdom
Co Chair(s)	Thierry CALAME	Switzerland
Secretary	Annsley WARD	United Kingdom
Members	Christof AUGENSTEIN	Germany
	Hélène CORRET	France
	Thomas CUCHE	France
	Jacqueline DASPIT	United States
	Gualtiero DRAGOTTI	Italy
	Andrés ESTEVA	Mexico
	Kim FINNILÄ	Finland
	Michael FRÖHLICH	Germany
	Örjan GRUNDÉN	Sweden
	Lori-Ann Johnson	United States
	Kaoru KURODA	Japan
	Jochen PAGENBERG	Germany
	Diego PALLINI GERVASI	Italy
	John B. PEGRAM	United States
	Sebastian PINCKAERS	Netherlands
Peter-Ulrik PLESNER	Denmark	
Cornelis SCHÜLLER	United Kingdom	
Thierry SUEUR	France	
József TÁLAS	Hungary	
Mark VAN GARDINGEN	Netherlands	