

Report Q162

Community Patent Regulation

1) Names and Functions of Committee Members

Chairman	Peter-Ulrik PLESNER	Denmark
Co-Chairman	Luc SANTARELLI	France
Secretary	Enrique ARMIJO	Spain
Members	Geoffrey BAYLISS	United Kingdom
	Nanno LENZ	Germany
	Anna FERREIRA DA SILVA	Portugal
	Takashi ISHIDA	Japan
	Gerald J. MOSSIGHOFF	United States of America
	Luigi Carlo UBERTAZZI	Italy
Responsible Reporter	Jochen BÜHLING	Germany

2) History

The special committee was established to study and prepare an opinion paper expressing the views of AIPPI national and regional groups of the European Commission Proposal for a Community Patent Regulation.

The special committee has prepared a report of 10 June 2002 for the Lisbon EXCO meeting, a report of 30 October 2003 for the Lucerne EXCO meeting, a report of 1 June 2004 to the Geneva Congress, a report of June 2005 for the Berlin EXCO and a report of July 2006 for the Gothenburg Congress and a report of August 2007 for the Singapore EXCO meeting.

Neither the EXCO meetings nor the Congress have passed any resolution in relation to the Community Patent.

3) Development since the Singapore ExCo meeting

Since our last report, the Presidency of the EU has issued several working documents concerning a draft agreement on the European Union Patent Judiciary. The latest draft is the draft of 30 June 2008, document number 11270/08.

In accordance with these proposals the European Union Patent Court will be established by the EU, covering all Member States. The court shall have exclusive jurisdiction over EPO patents and future Community Patents. The details in this proposal are dealt with in Q 165.

On 23 May 2008 the Presidency issued a working document concerning a revised proposal for a Council Regulation on the Community patent, document no. 9465/08.

It is the intention that the European Community will join the EPC convention. This will enable the European community from being included in the convention system as a territory for which a uniform patent can be granted. The pre-grant stage of the Community Patent will thus be governed by the EPC convention. The proposed regulation contains substantive regulation of the Community Patent. This is necessary because such a substantive regulation is not covered by the EPC convention.

The proposal intends to solve three issues which have been up for discussion in the later years:

- 1) The language regime
- 2) Distribution of fees
- 3) The jurisdictional system.

Re 1:

In accordance with the proposal an application for Community Patent can be filed directly with the EPO or via the national patent offices of a Member State. An application can, of course, be filed in one of three EPO languages, i.e. in English, German or French. It should, however, be possible for applicants from Member States who do not have a language in common with one of the EPO languages to file an application in the working language of the national patent office, when this is an official language of the EU. When the applicant files in a non-EPO language he/she shall designate one of the official EPO-languages as the language of the proceedings. The costs in relation to translation shall be covered by the system.

Articles 24b and 24c contain the following provisions:

“Article 24b

Translations for the provision of patent information

- 1) Translations of the patent specifications and claims into all official Community languages shall be made available upon publication of the patent application for the provision of patent information.
- 2) These translations will be carried out on demand by a specialized central service based upon a machine translation program. Such program will involve electronic dictionaries with technical vocabulary linked to the international patent classification system.
- 3) The translations referred to in this Article shall be for the provision of information and shall have no legal effect.”

“Article 24c

Translation in case of a dispute

In the case of a dispute relating to a Community patent, the patent proprietor, at his own expense,

- a) shall provide, at the request of an alleged infringer, a full translation of the patent into an official language of the State in which the alleged infringement took place or in which the alleged infringer is domiciled;
- b) shall provide, at the request of the Court in the course of legal proceedings, a full translation into the language of proceedings.”

One of the main issues to be discussed in the future is this proposal to use machine translations which, however, shall have no legal effect. Some Member States have reservations against this proposal. There can be raised several questions in relation to the proposal:

How trustworthy are these machine translations?

Is it acceptable that translations of the full translation of the specifications and claims have no legal effect?

Should it be a requirement that at least the claims are translated into all official languages in such a manner that it has legal effect?

Should it be a requirement that both the specification and the claims are translated at least into English with legal effect?

Does a translation produced in litigation have legal effect?

Re 2:

In accordance with the proposal the renewal fees for community patents will be payable to the EPO which will keep not more than 50% to cover its costs. The remaining amount will be distributed among the national patent offices of the Member States in accordance with a distribution key.

The proposal does not contain any rule about distribution of the remaining 50%. This is, of course, a highly political question in respect of which different EU Member States will have different opinions.

Re 3:

The Community Patent Court shall have exclusive jurisdiction concerning community patents on all matters mentioned in the agreement. Some specific patent questions are still to be dealt with by national courts.

Disputes between employees and employers about employees' inventions, and disputes concerning better rights to an invention shall in accordance with the proposal's articles 4 and 5 be dealt with by the national courts.

This jurisdiction will thus cover questions about validity, infringement and preliminary relief. The latest draft contains both the Draft Agreement on the European Union Patent Court, the draft statute of the European Union Patent Court and the list of issues to be included in the Rules of Procedure.

In accordance with the proposal a new court system shall be established. The system shall have the court of first instance and the court of appeal. The court of first instance shall comprise of a central division as well as local and/or regional divisions. The panel of the court of first instance shall have a multinational composition. It shall as a main rule sit in a composition of three judges, two judges from the territory of the local division and one judge appointed from a central pool of judges.

The language of the court shall be the language of the local division. The language of proceedings at the central division shall be the language in which the patent concerned was granted.

The agreement on the European Union Patent Judiciary raises a certain amount of principal issues, for example:

- 1) Is it to be preferred that both infringement and invalidity shall be dealt by the same court or shall it be possible to refer the invalidity issue to the central chamber (so-called bifurcation)?
- 2) Should it be possible to use the national courts for cases between two entities of the same country concerning issues only involving that country?

Future development:

In the past month the Presidency has, as mentioned, issued several proposals, and it has been very difficult for anybody not involved in the project on a daily basis to follow the development.

The French Presidency has scheduled seven meetings in the working committee during the second half of 2008. The draft of 30 June 2008 has been discussed at a working committee meeting 24 and 25 July 2008. France has not put the proposals on the agenda of priority subjects. The subjects are, however, expected to be on the agenda of the Council's meeting in November 2008.

4) Future work for the Special Committee

The special Committee does not propose a resolution on the proposed community patent regulation for the Boston Congress because the development is moving very quickly. The Special Committee Q 162 will continue to follow the developments and report to the Bureau and the next EX-Co Meeting.

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