

## **Preliminary set of provisions for the Rules of procedure of the Unified Patent Court**

### **Status**

1. First draft dated 29 May 2009
  - discussed in expert meetings on 5 June and 19 June 2009
2. Second draft (Part 1, Chapter 1) dated 9 July 2009, Working paper from the Commission Services, Council working document 11813/09
  - discussed in Council Working Party on Intellectual Property (Patents) on 22 July 2009
3. Third draft dated 25 September 2009
  - discussed in expert meeting on 2 October 2009
4. Fourth draft dated 16 October 2009
  - discussed at the 5<sup>th</sup> European Patent Judges' Forum on 30 and 31 October 2009
5. Fifth draft dated 27 January 2012
  - discussed in expert meeting on 3 February 2012
6. Sixth draft dated 22 February 2012
  - discussed by the Drafting Committee on 25/26 February 2012
7. Seventh draft dated 20 March 2012
  - discussed by the Drafting Committee on 24/25 March 2012
8. Eighth draft dated 30 March 2012
  - For technical consultation
9. Ninth draft dated 24 May 2012
10. Tenth draft dated 16 October 2012
11. Eleventh draft dated 07 November 2012
  - Discussed by Drafting Committee on 09 and 10 November 2012
12. Twelfth draft dated 29 November
  - For public consultation

### **Introductory remarks**

The present document contains a preliminary set of provisions for the Rules of Procedure of the Unified Patent Court (hereinafter "UPC" or "Court").

Basic principles of procedural law are already laid down in Part III of the draft Agreement on a UPC (hereinafter "draft Agreement"), for instance proportionality and fairness, case management, right to be heard, publicity, stages of the proceedings etc. The draft Agreement also contains general provisions on languages, parties, representation, means of evidence, experts, and defines the powers of the UPC to order provisional measures (in particular preliminary injunctions), to issue orders to preserve evidence (*saisie-contrefaçon*), corrective measures etc.

However, in several places in the draft Agreement, references are made to "Rules of Procedure" which shall spell out procedural details. This is a tried and tested legal technique: only the basic principles have been included in the draft Agreement, many procedural details being left for secondary legal instruments (rules of procedure, practice directions).

In accordance with Article 22(2) draft Agreement, the Rules of Procedure of the UPC shall be adopted by the Administrative Committee, on the basis of broad consultations with all stakeholders and following an opinion of the European Commission on the compatibility of the Rules of Procedure with Union law. Users of the patent system have however repeatedly requested that preparatory work on the Rules be started at an early stage, in order to enable a better assessment of the functioning of the future Court in practice.

It was envisaged that the Contracting Member States would, immediately after the signature of the Agreement, start the necessary preparations for the ratification of the Agreement to ensure its entry into force without delay. In parallel, the Contracting Member States would set up a Preparatory Committee in charge of preparing the practical arrangements for the early establishment and coming into operation of the Unified Patent Court. The Contracting Member States acknowledge the importance of appropriate Rules of Procedure for the Unified Patent Court and of their uniform application, which are vital to guarantee that the decisions of the Court are of the highest quality and that proceedings are organised in the most efficient and cost effective manner. However signature of the Agreement has been delayed pending agreement among the Contracting Member States on certain issues. This has in turn delayed the setting up of the Preparatory Committee. To avoid further delay in the work on the Rules of Procedure a small Drafting Committee of expert judges and lawyers was appointed to take this work forward.

The eighth draft prepared by the Drafting Committee was the subject of wide technical consultation with professional and industry bodies. A list of respondents who commented on that draft is set out below.

The Drafting Committee believes that this twelfth draft is suitable for a wider public consultation.

The aim of the Drafting Committee remains to assist the Preparatory Committee, when appointed, to complete the draft Rules of Procedure within three months of the signature of the Agreement.

Comments on the Eighth Draft of the Rules of Procedure were received from

Joachim Feldges  
BDI  
EGA  
Marina Tavassi  
Gabiella Muscolo  
IP – Federation  
Dr. Peter Guntz  
ICC – France  
Confindustria

Modiano & Partners  
Association des Praticiens Européens des Brevets  
Association of Intellectual Property Law Firms in Sweden  
Intellectual Property Lawyers Association (UK)  
Research in Motion  
The Danish Association of the Pharmaceutical Industry  
Association des Avocats de Propriété Industrielle  
Dutch/Belgian Respondents I  
Dutch/Belgian Respondents II

Interpat & EFPIA	European Patent Lawyers Association I
CCBE	European Patent Lawyers Association II
EPA Expert Group	Licensing Executives Society (Britain & Ireland)
Thomas Bopp	epi
TEVA	GSMA
Watson/Arrow	Confederation of Swedish Enterprise
EPI – Preliminary Comments	

**Abbreviations & Main sources**

EPC	European Patent Convention
EPLA RoP	"Annex I. Procedural law EPJ", prepared by Jan Willems, WPL/SUB 20/01, 27.8.2001
RoP CST	Rules of Procedure of the European Union Civil Service Tribunal
VR2	Second Venice Resolution, Principles relating to the Rules of Procedure of the European Patent Court, 4.11.2006
CJEU Statute	
CFI RoP	

*Levels for the various procedural fees have not been included*  
*References to persons in these Rules of procedure may apply to women as well as to men.*

## CHAPTER 3 – RIGHTS AND OBLIGATIONS OF REPRESENTATIVES

### Rule 359 – Powers of attorney

1. A representative who claims to be representing a party shall be accepted as such provided however the Court may order a representative to produce a written authority if his representative powers are challenged.

*[EPLA RoP §26]*

### Rule 360 – Certificate that a representative is authorised to practice before the Court

1. A representative pursuant to Article 28(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practise before a court of a Contracting Member State. In subsequent cases the representative may refer to the certificate previously lodged.

2. A representative pursuant to Article 28(2) of the Agreement shall lodge at the Registry the European Patent Litigation Certificate as defined by the Administrative Committee or otherwise justify that he has appropriate qualifications to represent a party before the Court. In subsequent cases such representative may refer to the certificate or other evidence of appropriate qualification previously lodged.

*[CST RoP Article 35(5); see also CJEU RoP Article 38(5)(a), CFI RoP Article 44(5)(a)]*

### Rule 361 – Attorney-client privilege

1. Where a client seeks advice from a lawyer he has instructed in a professional capacity, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is permanently privileged from disclosure, whether in court or arbitration proceedings of any nature or in the face of any compulsory information gathering powers of any body.

2. This privilege applies to communications between a client and a lawyer employed by the client and instructed to act in a professional capacity and a client and a patent attorney or agent (including a patent attorney or agent employed by the client) who is instructed in his professional capacity to advise on patent matters;

3. This privilege extends to the work product of the lawyer or patent attorney or agent (including communications between lawyers and/or patent attorneys or agents employed in the same firm or entity or between lawyers and/or patent attorneys or agents employed by the same client) and to any record of a privileged communication.

4. This privilege prevents the lawyer or patent attorney or agent and his client from being questioned or examined about the contents or nature of their communications;
5. This privilege may be expressly waived by the client.
6. The expressions “patent attorney” and “patent agent” shall bear the meanings given to them by the law of the contracting state to the Agreement in which the individual practises.

*Relation to draft Agreement: Article 28(4)*

### **Rule 362 – Litigation privilege**

1. Where a client, or a lawyer or patent attorney or agent instructed by a client in a professional capacity, communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings reasonably anticipated or pending before the Court, such communications shall be permanently privileged from disclosure in the same way and to the same extent as provided for in Rule 361.
2. Rule 361.6 shall apply *mutatis mutandis*.

*Relation to draft Agreement: Article 28(4)*

### **Rule 363 – Privileges, immunities and facilities**

1. Representatives appearing before the Court or before any judicial authority to which it has addressed letters rogatory [Rule 199] shall enjoy immunity in respect of words spoken or written by them concerning the case or the parties.
2. Representatives shall enjoy the following further privileges and facilities:
  - (a) papers and documents relating to the proceedings shall be exempt from both search and seizure;
  - (b) any allegedly infringing product or device relating to the proceedings shall be exempt from both search and seizure when brought to the Court for the purposes of the proceedings. In the event of a dispute, customs officials or police may seal those papers, documents or allegedly infringing products or devices. They shall then be immediately forwarded to the Court for inspection in the presence of the Registrar and of the person concerned.
3. Representatives shall be entitled to travel in the course of duty without hindrance.
4. The privileges, immunities and facilities specified in paragraphs 1 to 3 are granted exclusively in the interests of the proper conduct of proceedings.
5. The Court may waive the immunity where it considers that a representative is guilty of conduct which is contrary to the proper conduct of proceedings.

*Relation with draft Agreement: Article 28  
[CJEU RoP Article 32, CST RoP Article 30(3)(4)]*

### **Rule 364 – Powers of the Court as regards representatives**

As regards representatives who appear before it, the Court shall have the powers normally accorded to courts of law, under the conditions laid down in Rule 365.

*[CJEU Statute Article 19(5)]*

### **Rule 365 – Exclusion from the proceedings**

1. If the Court considers that the conduct of a party's representative towards the Court, towards any judge of the Court or towards any member of the staff of the Registry is incompatible with the dignity of the Court or with the requirements of the proper administration of justice, or that such representative uses his rights for purposes other than those for which they were granted, it shall so inform the person concerned.

On the same grounds, the Court may at any time, after having given the person concerned an opportunity to be heard, exclude that person from the proceedings by way of order. That order shall have immediate effect.

2. Where a party's representative is excluded from the proceedings, the proceedings shall be suspended for a period fixed by the presiding judge in order to enable the party concerned to appoint another representative.

*[CJEU RoP Article 35, CST RoP Article 32]*

### **Rule 366 – Patent attorneys' right of audience**

1. For the purposes of Article 28(3a) of the Agreement, the term "patent attorneys" assisting a representative referred to in Art. 28(1) of the Agreement shall mean persons meeting the requirements of Article 134(1) or (3)(a) to (c) of the European Patent Convention or the professional requirements of the Contracting Member State of the Agreement in which the individual practises.

2. Such patent attorneys shall be allowed to speak at hearings of the Court at the discretion of the Court and subject to the representative's responsibility to coordinate the presentation of a party's case.

3. Rules 361 to 365 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 28(3a)*

### **Rule 367 – Change of a representative**

Any change of representative shall take effect from the receipt by the Registry of notification that a new representative shall in future be representing the party concerned. Until the moment where such statement is received, the former representative remains responsible for the conduct of the proceedings and for communications between the Court and the party concerned.

## **CHAPTER 2 – COURT EXPERTS**

*Relation with draft Agreement: Article 34b*

### **Rule 185 – Appointment of a court expert**

1. Where the Court must resolve a specific technical question in relation to the case, it may of its own motion (and after hearing the parties) appoint a court expert.
2. The parties may make suggestions regarding the identity of the court expert, his technical background and the questions to be put to him.
3. The court expert shall be responsible to the Court and shall possess the expertise, independence and impartiality required for being appointed as court expert.
4. The Court shall appoint a court expert by way of order which shall in particular specify
  - (a) the name and address of the expert appointed,
  - (b) a short description of the facts of the case,
  - (c) the evidence submitted by the parties in respect of the technical question
  - (d) the questions put to the expert, with the appropriate level of detail, including where appropriate suggestions relating to any experiments to be carried out,
  - (e) when and under what conditions the expert may receive other relevant information,
  - (f) the time period for the presentation of the expert report,
  - (g) information about the reimbursement of expenses incurred by the expert,
  - (h) information about the sanctions which may be imposed on a defaulting expert.
5. The expert shall receive a copy of the order, together with the documents and other evidence that the Court considers to be necessary for carrying out his task.
6. The expert shall be required upon receipt of the order to confirm in writing that he will present the expert report within the time period specified by the Court.
7. The Court may reduce any fee agreed with the expert by an equitable amount if the expert did not deliver his report within the time period specified by the Court or if the report did not have the quality to be expected of the expert.
8. If an appointed court expert does not present his report within the time period specified or, if extended at the expert's request, the extended period, the Court may appoint another expert in his place. The Court may hold the expert liable for all or part of the costs of appointing and reimbursing another expert.
9. The Registry shall maintain an indicative list of experts.



**Rule 186 – Duties of a court expert**

1. The court expert shall present an expert report in writing within the time period specified by the Court [Rule 185.4(f)].
2. The court expert shall be under the supervision of the Court and shall inform the Court of his progress in carrying out his task.
3. The court expert shall give expert advice only on questions which have been put to him.
4. The court expert will not communicate with one party without the other party being present or without the consent of the other party.
5. The court expert will not communicate the contents of his report to third parties.
6. The court expert shall attend the oral hearing and shall be open to questions from the Court and the parties.

**Rule 187 –Expert report**

Once the final report of the court expert has been presented to the Court, the Court shall invite the parties to comment on it either in writing or during the oral hearing.

**Rule 188 – Hearing of a court expert**

Rules 178 to 180 shall apply *mutatis mutandis* to a court expert.