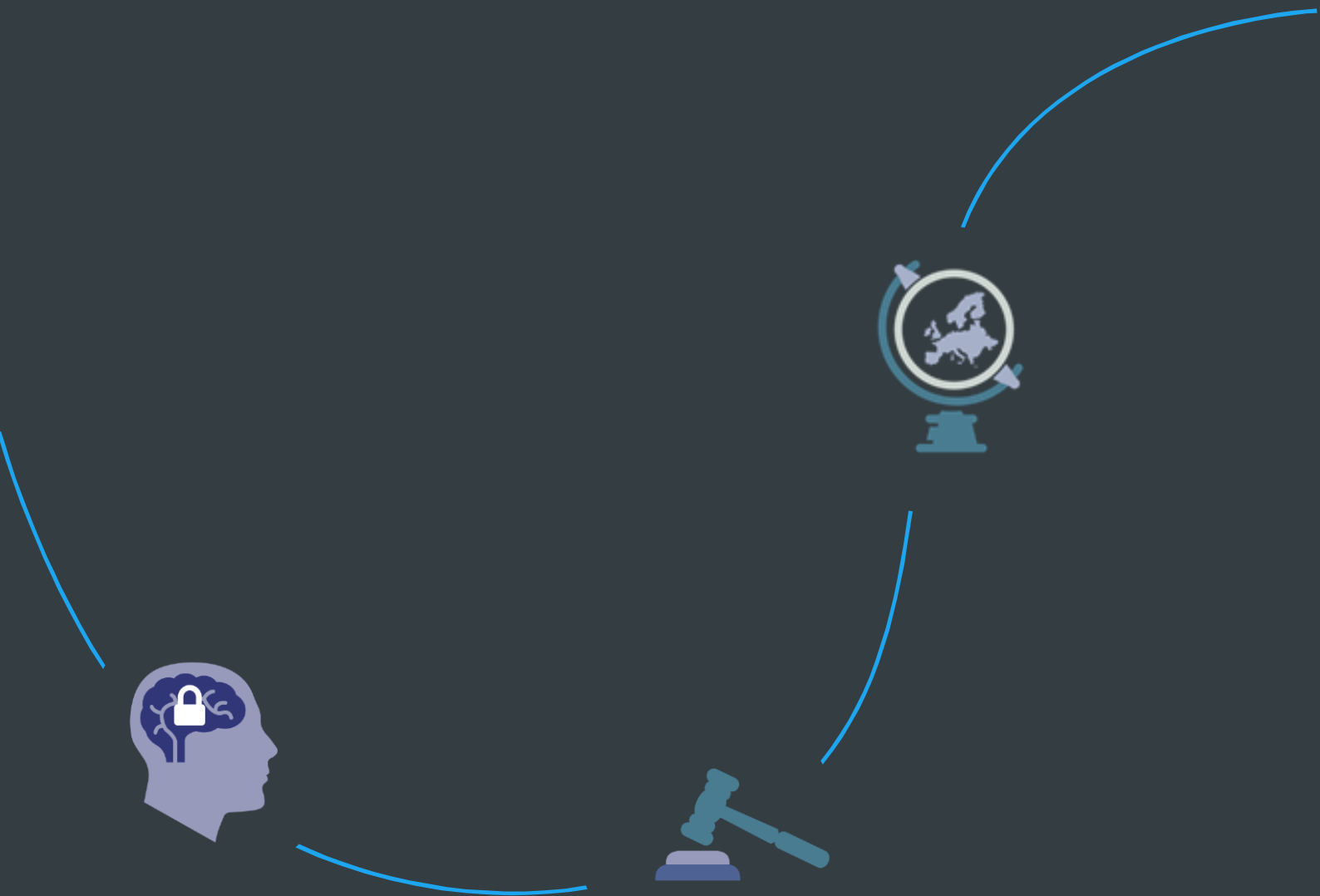
Bird & Bird

The UPC: European Patent Litigation Certificate

Bird & Bird comments on the draft rules on the European Patent Litigation Certificate



June 2014

MEMORANDUM

To:	Unified Patent Court
From:	Dr. Michael Alt *et al.*
Date:	25 July 2014
Subject:	**Comments on the draft rules on the European Patent Litigation Certificate and other appropriate qualifications pursuant to Art. 48(2) of the Agreement on a Unified Patent Court in the context of the public consultation process**

The following comments are made on behalf of

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I.
Background

(1)

Art. 48(1) and (2) of the Agreement on a Unified Patent Court stipulate that parties shall be represented by lawyers authorised to practise before a court of a contracting state and that parties may alternatively be represented by European patent attorneys (EPA) who are entitled to act as professional representatives before the European Patent Office pursuant to Art. 134 of the European Patent Convention (EPC) and who have appropriate qualifications such as a European patent litigation certificate (EPLC).

In other words, all lawyers authorised to represent their clients before a court of a contracting member state may appear before the court, irrespective of their practice and experience. On the other hand, European patent attorneys may only represent clients if they have additional qualifications.

(2)

According to the CCBE lawyers' statistics 2012 (http://www.ccbe.eu/fileadmin/user_upload/NTCdocument/2012_table_of_lawyer1_1356088494.pdf), there were in total 590,887 lawyers in the participating member states of the Unified Patent Court. It might well be that the number of lawyers entitled to appear before courts might be somewhat lower, but it is safe to assume that the number of lawyers who may represent clients before the UPC according to Art. 58(1) is at least higher than 400,000 lawyers. Most of these lawyers have no professional experience in intellectual property, let alone in patent law. Usually, patent law is not even the subject of mandatory courses in university or in law school.

(3)

As of January 2013, there were 10,427 professional representatives (EPAs), entitled to represent clients before the European Patent Office. EPAs deal with patent matters on a day-by-day basis. The representation before the EPO is not restricted to technical matters. Instead, EPAs can represent parties also before the Legal Board of Appeal as well as before the Enlarged Board of Appeal. In this context, EPAs deal for example with issues such as: (i) suspicion of partiality, (ii) suspicion of violation of e.g. the right to be heard, (iii) admissibility of interventions, (iv) transfers of oppositions, reformatio in peius,

(v) admissibility of oppositions filed on behalf of a third party, and the like (all examples relate to cases that were decided by the Enlarged Board of Appeal).

Moreover, EPAs are also often involved in infringement proceedings related to patents which are the subject of EPO oppositions/appeals. Thus, EPAs are used to not only consider the validity of patents but also the infringement of patents. In some jurisdictions national patent attorneys are also to be heard by the court handling infringement cases (for German patent attorneys § 4 of the Patentanwaltsordnung).

(4)

Although the UPC will have to apply various sources of law, the main source of law is the agreement on the Unitary Patent Court as well as the rules of procedure. Both are new to lawyers and EPAs and therefore both lawyers and EPAs will have to familiarize themselves with the convention and the new regulations.

(5)

Against this background, care must be taken that the rules on representation in Art. 48(1) and (2) of the Agreement on a Unified Patent Court truly reflect the factual and educational background of the representatives and are not shaded by lobbying efforts of any professional association. In order to bring the legal framework of representation in line with the factual background, namely the fact that EPAs deal with patents in various kinds of proceedings, including patent validity and infringement proceedings, on a daily basis, whereas only a minority of the lawyers will typically ever handle a patent case, it is appropriate and correct not to not overload the curriculum for the European patent litigation certificate and to consider at least additional national qualifications as an "appropriate qualification" in the sense of Art. 48(2) of the Agreement on the Unitary Patent Court.

II.

Consequences of the draft rules on the EPLC and other appropriate qualifications pursuant to Art. 48(2) of the Agreement on a Unified Patent Court

(1)

Against the above factual background, the minimum duration of the course of 120 hours stipulated in Rule 4(1) of the Draft Rules seems appropriate for those EPAs who do not have any further national qualification.

(2)

All national qualifications which allow a national patent attorney to represent clients before a national court at least in nullity proceedings should be considered as appropriate qualification for a European patent attorney pursuant to Art. 48(2). This includes by way of example the qualification of a German patent attorney.

To this end, a new paragraph (2) should be included into Rule 11:

> *"(2) European patent attorneys having passed a national patent attorney examination and are entitled to represent clients at least in revocation actions before the court of a contracting Member state shall be deemed to have appropriate qualifications pursuant to Art. 48(2) of the Agreement on a Unified Patent Court and may apply for registration on the list of entitled representatives."*

(3)

At least the courses of the FernUniversität Hagen and the Nottingham Law School in the open list according to Rule 12(a) of the Draft Rules are indeed to be considered as an appropriate qualification for a European patent attorney.

By way of example the two years course *"Law for Patent Attorneys"* of the *FernUniversität in Hagen* teaches inter alia civil law, commercial law, company law, European Community law (including e.g. enforcement directives), antitrust and competition law, public law, procedural law, and licensing law.

Also the Nottingham Law school course contains a significant amount of relevant legal teaching.

Against the above discussed background, it is not appropriate that these qualifications are considered appropriate only during a transitional period. Instead, these qualifications should

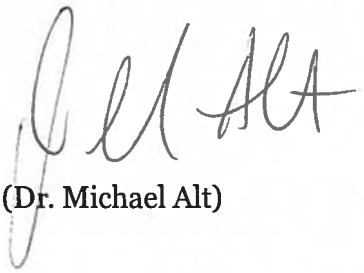
be included into Rule 11 of the Draft Rules. The new section (3) could read as follows (the other courses in the current draft rule 12(a) are not included since we do not know the respective curriculum):

> *"(3) The successful completion of one of the following courses shall also be deemed as appropriate qualifications for a European patent attorney pursuant to Art. 48(2) of the Agreement on a Unified Patent Court, so that the European patent attorney having completed one of these courses may apply for registration on the list of entitled representatives.*
>
> *i) FernUniversität in Hagen, course "Law for Patent Attorneys";*
>
> *ii) Nottingham Law School, course "Intellectual Property Litigation and Advocacy";*
>
> *iii) [...]"*

(4)

It is not appropriate to limit Rule 12(b) in that only those patent infringement actions are considered "another qualification" in which the European patent attorney has represented a party on his own without the assistance of a lawyer admitted to the relevant court. In fact, this rule is almost irrelevant, since in most countries, someone who can represent on his own in infringement cases is in fact a lawyer. Instead, it should be considered an equivalent qualification if an EPA was involved in infringement proceedings, including the hearing, and was involved or was representing in the revocation action or the counter-claim for invalidity of the patent being the subject matter of the infringement proceedings. To this end, it is proposed to include a sub-paragraph (c) into Rule 12 reading as follows:

> *"(c) was involved in at least three patent infringement actions and in the hearing in these cases and was involved in the parallel revocation action or the counter-claim for invalidity of the patent being the subject matter of the infringement action, wherein the infringement action, the counter-claim for revocation or the parallel revocation action were initiated before a national court of a contracting member state within the 5 years preceding the application for registration."*



Munich, 25 July 2014 (Dr. Michael Alt)