

80A/P 31.12

06.10.14

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Gesendet: Mittwoch, 3. Dezember 2014 15:26
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Cc: Ernst, Christoph
Betreff: Flash Anhörung EPG-Verfahrensordnung 26.11. in Trier
Anlagen: 2014-11-26 Anwesenheitsliste Anhörung Verfahrensordnung Trier_ERA.pdf; PM_UPC Hearing_D.PDF; LTO 2014-12-02 EU-Patentgericht, Experten beraten über Verfahrensordnung.pdf; IPKat 2014-12-01 zu AH in Trier, aktualisierte comments.docx; Foss 2014-11-26 ERA hearing.docx; DSC_0066.JPG; DSC_0067.JPG

Lieber Herr Weis,

Ich möchte Ihnen kurz von der mündlichen Anhörung zum Entwurf der Verfahrensordnung für das Einheitliche Patentgericht berichten, die am 26.11. in Trier in den Räumen der ERA stattgefunden hat. Um das Ergebnis vorweg zu nehmen: Es hat alles ganz außerordentlich gut geklappt, alle waren hoch zu frieden sowohl die Teilnehmer der Anhörung als auch die Kolleginnen und Kollegen auf dem Podium, die BMJV als Organisatoren der Veranstaltung geradezu mit Blume überhäuft haben. Gut angekommen ist auch, dass die Veranstaltung in drei Sprachen ausgerichtet wurde, die ich vom Vorsitz auch alle benutzt habe: [REDACTED]

[REDACTED] waren geradezu überschwänglich und meinten, ich solle doch unbedingt der Präsident des Gerichts werden. Das ist natürlich alles übertrieben, zeigt aber wie derartige Gesten aufgenommen werden.

Eingeladen hatten wir über 70 Organisationen und erfahrene Richter, insgesamt rund 220 Personen. Die Teilnehmerzahl lag schließlich bei ca. 80, was sich als gute Größe erwies (repräsentativ und gleichzeitig noch handelbar). Zusätzlich hatten wir einen Livestream auf der Webseite der ERA in 3 Sprachen geschaltet, der auch mit fast 400 Besuchern so stark frequentiert war, dass der Server zwischenzeitlich kurzzeitig überlastet war. Gestöhnt haben die Teilnehmer über die komplizierte Anreise nach Trier, aber das war dann bald vergessen und dient im Übrigen bereits ein wenig der Vorbereitung für die späteren Berufungsverfahren in Luxemburg. Das Podium war besetzt mit Vertretern der Rechtsgruppe und der Experten-Gruppe, insgesamt mit mir 14 Personen. Eine kurze Ansprache erfolgte durch den Vorsitz des Vorbereitenden Ausschusses Herrn van Beukering, der durch einen Hinweis auf die Stellungnahme des Generalanwaltes des EuGH vom 18.11., in der dieser dem Gerichtshof mit deutlicher Sprache empfiehlt, die spanischen Klagen gegen die Patentverordnungen 1257 und 1260/2012 abzuweisen, eine positive Note für den Auftakt beisteuerte (Frau Kemper macht zur Stellungnahme des GA noch eine Ministervorlage).

In der Sache hatten wir vier „hot issues“ in einem ersten Teil vorgestellt und etwas umfangreicher eingeführt: 1) Opt-out für Europäische Bündelpatente (Regel 5), 2) Verfahrenssprache (Regel 14), 3) Unterlassungsverfügungen und Ermessen des Gerichts (Regel 118) sowie 4) Rechtsmittel gegen prozessleitende Verfügungen (Regel 220).

Hervorzuheben ist aus meiner Sicht:

- Gelungen ist es, die von uns ins Spiel gebrachte flexible Sprachenlösung in Regel 14(2)c des Entwurfs so zu festigen, dass wir zuversichtlich sein können, sie über die Runden zu bringen. Wir haben bei der Anhörung [REDACTED] sehr aktive Unterstützung aus den Reihen der deutschen Richterschaft [REDACTED] und den deutschen Verbänden GRUR, PAK, BDI, VPP, BRAK, DAV bekommen. Hinzu kam auch einige Unterstützung aus dem Ausland (CEIPI, Dutch Industry) [REDACTED]. Im Ergebnis scheint damit der Weg für unsere flexible Sprachenlösung frei.

In der Sache geht es bei diesem Punkt um folgendes: MS können für „ihre“ Lokalkammern neben ihrer Landessprache eine oder mehrere EPA-Amtssprachen als Verfahrenssprache bestimmen (Artikel 49 Abs. und 2 ÜEP).

Regel 14(2)c lässt statt eines alles oder nichts Prinzips für die zusätzliche Sprache (Englisch) eine schrittweise Einführung nach Wahl des betreffenden MS zu. Möglich wäre danach, Englisch zunächst für Schriftsätze und oder die mündliche Verhandlung zuzulassen. Das Urteil wäre dann immer noch auf Deutsch. Auf diese Weise kann den sprachlichen Fähigkeiten der Richter und auch den Grundsätzen des Beklagtenschutzes Rechnung getragen werden. Bei den Gegnern dieser Regel scheint mir der – sächfremde – Gedanke im Vordergrund zu stehen, die Attraktivität der DE-Kammern zu behindern.

- Bei dem Thema Unterlassungsverfügungen (Regel 118) zeichnet sich eine Akzeptanz unseres Ansatzes ab, wonach das vom Übereinkommen in Artikel 63 vorgesehene Ermessen des Gerichts eng auszulegen ist. Im Regelfall wird das Gericht dem Antrag auf eine Unterlassungsverfügung stattgeben, wenn es eine Verletzung des Patents festgestellt hat. Dieser Ansatz trägt dem in Artikel 25 ÜEP niedergelegten Kern des Patentrechts Rechnung, anderen die Benutzung der Erfindung ohne Zustimmung zu untersagen. Im Ausnahmefall kann das Gericht allerdings von einer Unterlassungsverfügung absehen. Wann ein solcher Ausnahmefall vorliegt, soll der Rechtsprechung des Gerichts überlassen bleiben. Insbesondere US Unternehmen aus der sog. „Industry Coalition“ - in Trier vertreten durch Microsoft und Google - werben für eine konkretisierende Ausgestaltung des Ausnahmetatbestands, wenngleich zwischenzeitlich auch bereits mit deutlich abgeschwächten Positionen (Klarstellung, dass bei völliger Unverhältnismäßigkeit keine Unterlassungsverfügung ergeht). Häufig diskutierter Fall ist ein IKT-Produkt mit tausenden von Patenten und einer Verletzung nur eines untergeordneten geschützten Features bei gleichzeitig hohem Schaden im Verbotsfall.

In einem zweiten Teil haben wir von Ihrer Anregung Gebrauch gemacht und auch hier Themenkomplexe angeboten, zu denen sich die Teilnehmer mit ihren Anliegen an passender Stelle zu Wort melden konnten. Das hat dazu geführt, dass die Beiträge sehr geordnet und unaufgeregt dargebracht wurden. Nochmal vielen Dank für diesen Hinweis, der sich sehr bewährt hat. Hier wurden diskutiert:

- Rechtmittel gegen Entscheidungen des EPA im Bereich der Eintragung und Verwaltung des Einheitlichen Patentschutzes (Regeln 85 ff.)
- Beweisrecht (Regeln 170 ff.)
- Berufung (Regel 220 ff.)
- Vertretung vor dem Einheitlichen Patentgericht (Regeln 286 ff.).

In einem dritten Teil konnten die Teilnehmer dann ihre verbleibenden Anmerkungen loswerden. Auf diese Weise ist es gelungen alle Anmerkungen der Nutzer zum gesamten Entwurf zu erschöpfen. Es war ein bisschen meine Sorge, dass wir es zeitlich nicht schaffen, alles abzuarbeiten, aber diese Sorgen waren im Ergebnis unbegründet.

Einen großen Anteil am Erfolg der Veranstaltung hat Frau Makoski, die ich hier ausdrücklich erwähnen möchte und welche mit beeindruckender Präzision, Ausdauer und „Entschluss zum Torschuss“ (wie man im Fußball sagen würde) Inhalt und Ablauf der Veranstaltung durchdacht und konzipiert hat. Es hat alles gepasst. Sehr hilfreich war auch, dass Frau Maßenberg bereits ab Anfang November zur Verfügung stand und bei der Umsetzung des Konzepts und dem Kontakt mit der ERA tatkräftig unterstützen konnte.

Bleibt noch nachzutragen, dass unser Haus die Veranstaltung auch finanziell gut unterstützt hat, sowohl was die Ausstattung für die Veranstaltung selber mit rd. 20.000 € angeht (Anhörung, Dolmetscher, Mittagessen) als auch mit 1000 € für ein Dinner am Vorabend für alle Podiumsteilnehmer aus den Arbeitsgruppen, was für die positive Grundstimmung nicht zu unterschätzen ist. Da wir unter extremem Zeitdruck gearbeitet haben, war das Verständnis für die Bedeutung unseres Vorhabens sehr hilfreich, um noch alles rechtzeitig einzutüten.

Beigefügt habe ich die Teilnehmerliste sowie einige Veröffentlichungen zur Veranstaltung und 2 Fotos aus dem Veranstaltungssaal.

Im neuen Jahr wird es dann wieder ein oder zwei Treffen beider Gruppen (Rechtsgruppe und Experten) in Berlin geben, wo wir über die aus der Anhörung aufgenommenen Stellungnahmen und Anregungen beraten müssen, mit dem Ziel, eine überarbeitete Endfassung des Entwurfs zu erstellen, die wir dann voraussichtlich im Frühjahr dem Prep Com zur Beratung und Beschlussfassung vorlegen können.

Nachdem der große Brocken der Anhörung jetzt erstmal abgehakt ist, tritt die Thematik des nationalen Gesetzgebungsverfahrens wieder mehr in den Vordergrund. Die Haushaltsanmeldung für 2016 liegt derzeit in überarbeiteter Form noch bei ZB1. Sobald wir das OK von dort haben, werden wir Ihnen die Endfassung des Zahlenwerks für unsere Haushaltsmeldung vorlegen und müssen dann die vom Haushalt gebilligte Fassung in den Finanzteils der Entwurfsfassung für das Zustimmungsgesetz einbauen, was aber kein großer Akt sein dürfte. Überdenken sollten wir m.E. nochmal, wie wir mit den Gesetzgebungsverfahren jetzt weiter vorgehen; dazu werde ich meine Gedanken mit Herrn Ernst diskutieren und wir kommen dann ggf. auch auf Sie zu.




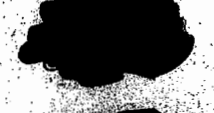




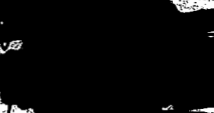









Beste Grüße

Johannes Karcher

**Europäische Rechtsakademie Trier
Academy of European Law Trier
Académie de Droit Européen de Trèves**


**Einheitliches Patentgericht - Anhörung zur Verfahrensordnung
Unified Patent Court - Oral Hearing on the Rules of Procedure
Juridiction Unifiée du Brevet - L'audition sur le règlement de procédure**

Surname	Name	Organization	Country	Signature
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Pors	Wouter	LESI Bird & Bird LLP	NL	
Powell	Timothy	AIPPI Potter Clarkson LLP	UK	
Price	Richard	IPLA Winston & Strawn London LLP	UK	

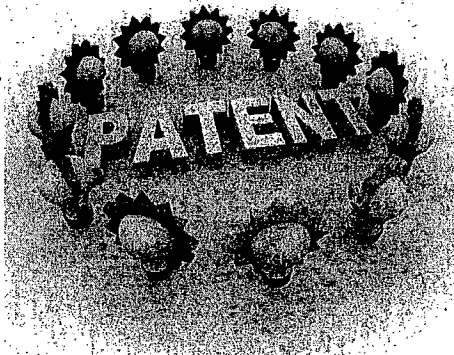
Surname	Name	Organization	Country	Signature
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Auf dem Weg zum Europäischen Patentgericht: Anhörung zur Verfahrensordnung

In der Europäischen Rechtsakademie fand am 26. November die öffentliche Anhörung zur Verfahrensordnung für das Einheitliche Patentgericht statt. Zu der vom Vorbereitenden Ausschuss organisierten Anhörung kamen rund 100 juristische Experten nach Trier, um spezifische Punkte im vorgelegten 17. Entwurf der Verfahrensordnung anzusprechen. Die Anhörung konnte auch online über einen Webstream live verfolgt werden.

Mit der Schaffung des Einheitlichen Patentgerichts wird ein einheitlicher europäischer Patentrechtsschutz in Europa geschaffen. Das Gericht wird die Zuständigkeit für Europäische Patente mit einheitlicher Wirkung haben.



Der Tätigkeit des Gerichts wird eine neu erarbeitete Verfahrensordnung zu Grunde liegen. Die Anhörung zum 17. Entwurf der Verfahrensordnung bot Vertreterinnen und Vertretern europäischer und nationaler Institutionen und Verbände sowie Richtern die Gelegenheit, ihre Anliegen vorzutragen. Dabei wurde von den Interessenvertretern insbesondere die Möglichkeit des Opt-outs für Antragsteller von Europäischen Patenten von der Zuständigkeit des Einheitlichen Patentgerichts kommentiert. Darüber hinaus wurde das Sprachenregime des neuen Patentgerichts (Deutsch, Englisch und Französisch) sowie dessen Ermessensspielraum bei einstweiligen Verfügungen gegen Patentverletzungen und bei der Anordnung der Zahlung von Schadensersatz angesprochen. Kommentare befassten sich auch mit Beweisregeln, Klagen gegen Entscheidungen des Europäischen Patentamts, Beschwerdeverfahren und die Vertretung vor dem Gericht.

Es wird erwartet, dass das Einheitliche Patentgericht Anfang 2016 seine Arbeit aufnimmt.

Weitere Informationen können Sie auch [dieser Pressemitteilung](#) des Bundesministeriums der Justiz und für Verbraucherschutz entnehmen.

<http://www.lto.de/recht/nachrichten/n/eu-patentgericht-verfahrensordnung-anhoerung-trier/>

EU-Patentgericht: Experten beraten über Verfahrensordnung

26.11.2014

Die Patenrechtswelt schaut am Mittwoch nach Trier. Vertreter von über 70 Organisationen treffen sich, um über die Verfahrensordnung des EU-Patentgerichts zu beraten. Ab 2016 soll das Gericht Entscheidungen mit unmittelbarer Wirkung für fast alle EU-Staaten treffen.

Die Europäische Union bekommt ein einheitliches Patentgericht. Im Februar 2013 hatten nach jahrelangen Verhandlungen 25 Mitgliedstaaten sich auf einen besseren Schutz von innovativen Erfindungen geeinigt. Teil des Abkommens ist die Errichtung eines einheitlichen Patentgerichts, dessen Zentralkammer in Paris sitzen soll mit Abteilungen in London und München. Daneben haben die deutschen Lokalkammern ihren Sitz in Hamburg, Mannheim und Düsseldorf. Offen ist noch die genaue Ausgestaltung der Verfahrensordnung.

Zu ebendieser sollen am Mittwoch in der Europäischen Rechtsakademie in Trier rund 100 Experten angehört werden. Nach Angaben des Bundesministeriums der Justiz und für Verbraucherschutz (BMJV) sind unter ihnen Vertreter der betroffenen Industrie- und Berufsverbände und der Patentrichterschaft. Über 70 Organisationen aus dem Gebiet der EU, aber auch aus patentaktiven Ländern außerhalb Europas sind eingeladen. Die Veranstaltung wird auf der Webseite der Europäischen Rechtsakademie als Webcast übertragen.

Bundesjustizminister Heiko Maas (SPD) hat hohe Erwartungen an das Expertentreffen: Es solle "den entscheidenden Input für die endgültige Fassung" bringen. "Erstmals wird es eine europäische Prozessordnung geben, die die unterschiedlichen Rechtstraditionen der EU-Mitgliedstaaten zusammenführt – ein Meilenstein für die Rechtsentwicklung in der EU", so der Minister.

Grundlage der Anhörung wird ein von einer Expertengruppe ausgearbeiteter Entwurf der Verfahrensordnung sein, welchen die Rechtsgruppe des Vorbereitenden Ausschusses zur Errichtung des einheitlichen Patentgerichts unter dem Vorsitz von Johannes Karcher vom BMJV überarbeitet hat.

una/LTO-Redaktion

Zitiervorschlag für diesen Artikel:

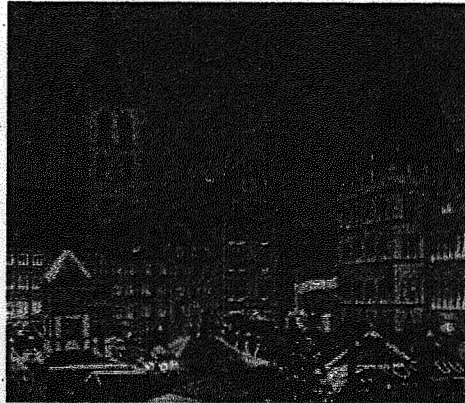
EU-Patentgericht: Experten beraten über Verfahrensordnung. In: Legal Tribune ONLINE, 26.11.2014, http://www.lto.de/persistent/a_id/13918/ (abgerufen am 02.12.2014)

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Stand: 02.12.2014, 19:37

Monday, 1 December 2014

Those new European patent litigation rules: a report on the Oral Hearing on the 17th draft



This Kat is grateful to Dr Stephan Dorn (a lawyer with Hogan Lovells Int. LLP, Düsseldorf, Germany, who works with Dr Andreas von Falck in that firm's Patent Litigation Department). As he reminds us (as if we could forget), Europe is preparing for a major change in its patent litigation system, this being the European Patent with Unitary Effect and the Unified Patent Court. Last week, Stephan attended, as a representative of the DAV (Deutscher Anwaltverein, the German Lawyers Association), the Oral Hearing on the 17th Draft of the Rules of Procedure for the Unified Patent Court in Trier, Germany (right). He has kindly prepared the following report on the main issues discussed there for the special interest and attention of readers of this weblog:

Unified Patent Court: Oral Hearing on the Draft Rules of Procedure

On 26 November the final Oral Hearing on the Draft Rules of Procedure for the Unified Patent Court took place at the ERA Congress Center in Trier, Germany.



*Dry subjects like patent rules
benefit from lubrication*

Before we focus on the main issues that have been vividly discussed among the panel and the participants, here's just one short remark on the conference venue. We think that all the participants got their first clue as to the trouble arising from choosing nearby Luxembourg as the residence for the UPC Court of Appeal. Though both Luxembourg and nearby Trier are placed in the middle of Europe and could be reasonably called also the centre of the Agreement on the Unified Patent Court (UPCA) territory,

many representatives attending the hearing could tell from their very time-consuming journeys to Trier that there might be problems ahead. We assume that, even in the starting phase of the new UPCA System, appealing the decisions of the Court will be more the rule than the exception. Thus, all users of the new Court system, in particular the lawyers planning to represent their clients before the UPC, should make themselves familiar with a new - we do not want to call it epic - dimension of Court travelling. However, at the end all representatives made it to the conference centre in time and could use the journey for sampling at least occasionally the pleasures of the Moselle valley, one of Europe's oldest wine-growing regions.

The panel consisted of nearly the whole legal group of the Preparatory Committee (chaired by Johannes Karcher, Federal Ministry of Justice (**BMJV**), Germany) accompanied by the so-called Expert Group (chaired by Kevin Mooney) responsible for the drafting of the Rules of Procedure from the very beginning of the work in 2011. The main topics of the hearing were four rules of the 17th draft of the UPC Rules of Procedure (see the explanatory note to the 17th draft here and the trilingual 16th draft there), namely Rule 5 (Opt-Out), Rule 14.2 c (additional languages in the proceedings before the UPC); Rule 118.1 (Injunctions), and Rule 220 (appeals, in particular procedural appeals).

As regards the new draft of Rule 5, the contribution of the participants mainly concerned the complexity of the Opt-Out procedure. The new Rule 5 provides for an application of an Opt-Out before the agreement enters into force. The rationale behind this provision is that all patent proprietors should have the possibility to opt out without running the risk of being stopped from doing so just because a third party commences a proceeding before the Court beforehand and triggers the permanent bar for changing the jurisdiction as provided for in Art. 83(3) UPCA. Because neither the Court nor the registry exists before the UPCA enters into force, there is the factual problem that there is no authority that could receive any application for Opting-Out before that day.

Considering the time required to deal with an application and Art. 83(3) Sentence 3 UPCA, according to which the Opt-Out takes effect with the day of the entry into the register, many patent proprietors worried about whether they will be able to effectively opt-out all their patents in time without being forced into the UPC System. Against this background the expert group had the wheeze of involving the EPO in the Opting-Out procedure. The EPO shall initially and before the UPCA enters into force collect all applications and then refer them (en bloc) to the registry of the UPC afterwards (sunrise period). All applications shall then be considered as effective with the date of the entry into force of the UPCA.



*There are times when sunrise makes
a person just want to opt out ...*

The participants mainly welcomed the new Rule 5 even though many criticized it in that some details are not yet covered, i.e. the question of the payment process of the Opt-Out fee when the application is lodged with the EPO. Most participants argued that the EPO should be responsible for collecting the opt-out fee in the sunrise period.

Many participants considered, in particular, legal certainty regarding the day of the effectiveness of the Opt-Out as desirable and suggested taking the day of the application instead of the day of the entry into the register. This idea was rejected by the panel, referring to the clear wording of Art. 83(3) UPCA. A second concern regarded whether the Court registry will be capable of dealing with the expected flood of Opt-Out applications and whether the processing of the Opt-Out application would not be in better keeping with the EPO instead of the Registry of the Court. Some participants objected that the Opt-Out was too complicated and nearly impossible to use for large patent portfolios due to high costs and shortcomings in practicability.

The second main issue and certainly the most hotly discussed one was Rule 14 on the language regime before the Court, in particular Rule 14.2(c) providing for a possible partial use only of an additional language designated as additional language of the proceeding by the Contracting Member State (CMS) according to Art. 49(2) UPCA. Rule 14.2(c) reads:

[(c). Where a designation of an additional language under Article 49(2) for a regional division or for one or more local division(s) hosted in a Member State so indicates, parties may use the additional language:

(i) for a Preliminary objection [Rule 19] and/or(ii) for written pleadings and other documents, including written evidence [Rule 7], and/or for oral hearings].

The angular brackets indicate that the expert group drafting the RoPs had not yet reached agreement whether this additional rule should be included into the RoP. The rationale behind this rule is flexibility in opening the somewhat rigid language regime of Art. 49 UPCA. Many of the participants commented negatively on the additional rule, in particular the participants from the Netherlands and UK. That was not surprising, because both the Netherlands and UK fancy their chances to get a more attractive jurisdiction for patent litigation if they could offer their English-only language regime without Germany being able to catch up with the needs of the international English-speaking users of the new UPC system. And thus, less surprising, they argued that including Rule 14.2(c) would complicate the whole proceedings, cause problems regarding legal certainty, increase costs as in particular cases more translations would be needed.

However, a large group - definitely not a minority - of participants, mainly from Germany, supported the inclusion of Rule 14.2(c). They argued that it would be one-sided and unfair and against Art. 42(2) and 43(3) sentence 2 UPCA to give to the claimant -- and only to the claimant -- a right to determine a language which is not the official language of the CMS hosting the division (home language) to be the language of the proceedings binding all other participants including the Court. The interests of the defendant and the language skills of the division must be taken into consideration and must be respected.

They saw it as a step further towards the use of English that Rule 14.2(c) allows the CMS concerned to admit English to a limited degree as an additional language: English thus may be used without forcing that language upon the other party and on the Court, because the home language remained the language of the proceedings. Rule 14.2(c) was seen as a compromise recommendable at least for the initial period of the UPC. The CMS concerned may withdraw its designation after some time. Then, under Rule 14.2(a), English may be determined by the claimant as the language of the proceedings with binding effect for all other participants and the Court. It was also argued that the administrative Committee may change Rule 14.2(c) at a later point of time under Art. 41(2) UPCA. Further, the German judges attending the hearing supported the inclusion of Rule 14.2(c). Facing the existing language skills of the very experienced German judges they strongly recommended to allow a mixed language regime according to Rule 14.2(c) in order to maintain the high quality of the judgments of the German divisions. Dr Grabinski, Member of the Legal Expert Group, emphasised that no CMS was obliged

to implement Rule 14.2(c). Each CMS will remain free to find its best practice language regime.

Before the break the hearing was about the new draft of Rule 118.1 and the deletion of Rule 118.2. The new version of Rule 118 reads now:

Rule 118 - Decision on the merits¹. In addition to the orders and measures and without prejudice to the discretion of the Court referred to in Articles 63, 64, 67 and 80 of the Agreement the Court may, if requested, order the payment of damages or compensation according to Articles 68 and 32(1)(f) of the Agreement. The amount of the damages or the compensation may be stated in the order or determined in separate proceedings [Rules 125-143].

A former version of Rule 118.1 had worried in particular the IT industry because it was interpreted as providing for automatic injunctions if a patent infringement was found. The new version of Rule 118.1 emphasizes the discretion of the Court in granting injunctions and is thus closer to the wording of Art. 63 UPCA. The new version met with general agreement by the participants although many of the participants urged the panel to include a more or less restrictive guideline for exercising the discretion granted to the Court. The panel emphasized in particular with regard to the Opinion of the Advocate General in Case C-170/13 Huawei v ZTE [noted by the IPKat [here](#)] that stopping the patent infringement was the core element of the patent right and any restrictive construction of the Rule must be well founded. In general, the limitation of injunctive relief was an option only in very exceptional circumstances, according to the panel. Furthermore, the panel referred to the experience of the judges in exercising their discretion and that there was no need to develop a detailed scheme limiting or the discretion of the Court. Paul van Beukering, the chairman of the UPC Preparatory Committee, added, with regard to the comments given by the Legal and Drafting Groups allowing for not granting injunctions only in exceptional cases, that the RoPs were still in development and that the approval by all CMS that was still needed before the final version of the RoPs would finally be adopted.

The last big issue on this day was the new version of Rule 220.2 providing for a discretionary review of procedural orders. The problem with procedural appeals is due to the unclear wording of Art. 73(2)(b)(ii) UPCA. Art. 73 UPCA makes a distinction between privileged orders admissible for appeal within 15 days, and unprivileged orders that are generally not admissible for appeal unless "the Court" grants leave to appeal. It is not clear, whether "the Court" means the Court of the first Instance, the Court of Appeal or both. The new Rule 220.2 provides for a compromise allowing for a so called "discretionary review" of unprivileged procedural orders if the first instance panel does not grant leave to appeal.. In a first stage of these review proceedings the standing judge decides whether to allow the request for discretionary review. In a second step, a panel of the Court of Appeal reviews the procedural order. Most participants agreed with the new draft. In particular the attending judges called the rule well drafted. After the coffee break the panel opened the hearing for an open discussion. There was debate on Rules 85 et. seq on the Action against decisions of the EPO. The participants saw a conflict with the time for validating the patent in some CMS (regularly within three months after granting of the EP by the EPO). The Court must decide very quickly those actions in order to maintain the possibility for validating the EP in the relevant CMS if the entry into the register for unitary protection was finally refused by the EPO and the Court. The participants urged the CMS to extend the time limit for validation in their national laws before the entry into force of the UPCA.

All in all, the 17th draft of the Rules of Procedure seemed to find broad acceptance among the participants. Although a few issues remained open, the 17th draft is a major step towards the new Court system. The broad acceptance makes it very likely that

all CMS will give their approval to a final version of the RoPs based on the 17th draft after few remaining drafting point have been sorted out..

Thanks so much, Stephan. Readers who were there, and those who weren't, may wish to add their comments to this helpful report.

Posted by Jeremy at 8:15:00 pm



Labels: 17th Draft Rules, European unitary patent, Oral Hearing, Unified Patent Court Agreement

5 comments:

Anonymous said...

Although I'm not sure who Johannes Karcher is, I'm pretty sure that the Federal Ministry of Justice (BMJV), Germany is Heiko Maas (you may easily check this via the link of the BMJV provided in the article).

Tuesday, 2 December 2014 08:10:00 GMT

Dr. Stephan Dorn said...

Thank you for your comment, anonymous.

You are correct, that Heiko Maas is the German Federal Minister of Justice. I did not allege anything else. Johannes Karcher works for the German Federal Ministry of Justice and is the leader of the Legal Group of the UPC Preparatory Committee preparing the legal framework for the UPC.

Kind regards

Tuesday, 2 December 2014 09:17:00 GMT

Anonymous said...

As the article correctly states, Johannes Karcher is from the Federal Ministry of Justice. He is not the Minister though

Tuesday, 2 December 2014 09:20:00 GMT

Dr. Stephan Dorn said...

A number of questions have reached me via email on my Article about the Trier Hearing, especially on the response of the audience on Rule 14.2(c) (compromise regarding the additional languages of the proceedings under Art. 49(2) UPCA).

Actually a clear majority of the participants which commented on this topic did support Rule 14.2(c). That compromise proposal was unanimously welcomed not only by German industry (BDI), practitioners (BRÄK, DAV, VPP, Chamber of Patent Attorneys), by GRUR and by the three presiding judges participating) but also from CEIPI and from the Dutch Confederation of Netherlands Industry and Employers (known as VNO-NCW) which welcomed it as a step forward.

Also on the bench, among the members of the Drafting Committee for the Rules a clear majority (4:2) spoke in favor of Rule 14.2(c): Judge Sir Colin Briss, Judge Dr Grabinski, Conseiller Honoraire à la Cour de Cassation Alice Pézard and Prof. Tilmann expressed themselves in support of that proposal.

Tuesday, 2 December 2014 15:46:00 GMT

Antonio Pizzoli said...

During the hearing I mentioned the lack of any rule on minutes of the hearings.

According to Mr. Kaercher the audio recordings will take the place of the minutes.

However, the recordings will not be available to the public (Rules 106 and 115), so I am wondering whether these rules could lead to a lack of transparency, considering e.g. that minutes of the EPO hearings are always drawn up and published on the EPO website.

Curiously, the UPC hearing has been videorecorded and made available on the ERA website "for the sake of maximum transparency".

Tuesday, 2 December 2014 16:21:00 GMT

<http://www.fosspatents.com/2014/11/near-automatic-injunctions-raise.html>

FOSS Patents

This blog covers software patent news and issues with a particular focus on wireless, mobile devices (smartphones, tablet computers).

Wednesday, November 26, 2014

Near-automatic injunctions raise concerns at hearing on rules for European patent court

A hearing was held today at the Academy of European Law in Trier, Germany, on the rules of procedure for Europe's future Unified Patent Court (UPC), as I mentioned last week when I commented (not too positively, to be honest) on the latest draft rules. I followed it over the Web. To put it this way, the hearing went very well for those advocating a more *eBay v. MercExchange*-like standard, and there *is* a reasonable chance of improvement when more EU member states take and state their official positions in the months ahead.

The last part of the hearing before the lunch break was all about access to injunctive relief and the related judicial discretion. Dr. Johannes Karcher, a former judge at the Federal Patent Court of Germany and now an official at the Federal Ministry of Justice as well as the chairman of the legal group of the UPC Preparatory Committee, explained that judges would, in principle, enjoy discretion with respect to injunctions, but the question was the extent of such discretion. And he was clear that discretion should "only be exercised under exceptional circumstances."

As at least one other speaker did after him, Mr. Karcher argued that last week's opinion by Advocate General Wathelet in a *Huawei v. ZTE* standard-essential patent case affirmed that access to injunctions is a cornerstone of the patent system. It's true that AG Wathelet stated that seeking an injunction cannot, in and of itself, constitute abusive conduct. That was apparently also the European Commission's conclusion when it settled the Samsung FRAND investigation. By AG Wathelet's standard, there is no way the Commission could have fined Samsung for what it had done because Apple had taken none of the steps the AG considers necessary for a defendant to take in order to be considered a seriously willing licensee. Neither had Apple made a formal counterproposal on FRAND terms nor had Apple requested a FRAND determination (rate-setting decision) by a court of law or an arbitration panel. While the AG didn't state an opinion on ZTE's 50-euro-per-patent licensing offer, it was clear between the lines that Huawei's pursuit of injunctive relief was also above board, though ZTE could, if the court adopted the AG's recommendation (as it does most of the time), simply trigger a rate-setting proceeding in order to avoid a sales ban. The AG's opinion is a win for SEP holders in the sense that not only their own conduct but also the way the defendant behaves is part of the equation. I had advocated for a long time the proposal that only the SEP owner's FRAND compliance should matter, but I recognize that the Federal Trade Commission, the Department of Justice, the European Commission and now AG Wathelet all determined that an implementer of an industry standard must also demonstrate good faith conduct and I accept that this is now a requirement around the globe.

But the question in connection with the rules of procedure for the UPC is not whether an injunction request per se constitutes anticompetitive conduct no matter what the alleged infringer does or does not do. The outcome of *Huawei v. ZTE*, barring a surprise, is *not* going to be an injunction (because ZTE is too smart to let that happen). By contrast, the latest draft rules of procedure for the UPC were accompanied by an explanatory document, which drew criticism from multiple intervenors at today's hearing, that said injunctive relief would be denied only under "very exceptional circumstances." The way I see it, those draft rules of procedure are reconcilable with the AG's *Huawei* opinion only if one takes a particular passage out of context and twists and turns it, but not if one asks the question of whether the AG endorsed the notion of injunctive relief being available almost 100% of the time.

The first intervenor was a spokeswoman for the UPC Industry Coalition on whose open letters I've previously reported. She noted in the introductory part of her intervention that some of the key members of this broadbased coalition are actually embroiled in (particularly smartphone-related) litigation against each other, which means the group is interested in a balanced regime as opposed to being exclusively on the side of right holders or alleged infringers.

Unfortunately there was a technical problem with the official webstream during that intervention (and not only then). Therefore I missed parts of the intervention, but I still heard when she said that the group is in favor of a more flexible and balanced standard. It appeared to me that the UPC Industry Coalition's concerns relating to the 17th draft rules of procedure are pretty much the same as mine.

Some of the intervenors also pointed out the problem with bifurcation (cases in which a validity determination could come down after an injunction is granted and enforced). A Dutch association said that there was a diversity of positions among its members and there may be a need to make adjustments after a few years with respect to such issues as bifurcation.

Those concerns and some closely-related ones were also voiced by various other intervenors, including, among others, a representative of the GSMA wireless industry association and a representative of a French software industry association with 350 member companies, most of them small and medium-sized companies.

A French judge (who was sitting in the audience and not on the panel along with those judges serving on or advising the Preparatory Committee) complained that there was a risk of a framework that would exceedingly restrict judicial discretion. Not long after her intervention, Paul van Beukering, a Dutch ministry official who is the chairman of the Preparatory Committee, stressed that this process was still at the drafting stage and that a very important part of the process would begin only after more EU member states have been able to comment, which would happen only after the hearing. It appeared to me that Mr. van Beukering wanted to pacify the numerous and vocal critics of the latest draft by suggesting that there was still room for improvement.

Several members of the Preparatory Committee's legal and expert groups defended the current draft and called on critics to "have confidence in the court." The judges on the panel were clearly interested in preserving a maximum of discretion, but I think a balance must be struck (and is not struck by the 17th draft rules) between judicial discretion on the one hand and reasonable assurances to industry (including companies of all sizes) on the other hand. I frankly can't see how a statement in the explanatory document that says injunctions would be denied

only "under very exceptional circumstances" serves either purpose. It's bad news for discretion as much as it is for businesses.

Also, I can't see why an *eBay*-like standard would place a painful restriction on judicial discretion. Judges at U.S. district courts and the Federal Circuit actually enjoy tremendous discretion thanks to *eBay*.

I would like to highlight a very good idea that Judge Dr. Klaus Grabinski from the Federal Court of Justice of Germany (who also serves on the UPC Preparatory Committee) mentioned in his response to criticism of the latest draft. While I don't think this idea is sufficient to address the concern over disproportionate injunctions, it is a useful one and would be worth being mentioned in a future draft of the rules of procedure. Judge Dr. Grabinski noted that if there is concern over the commercial impact of injunctive relief affecting a highly multifunctional mobile device only because of an infringement of a minor feature, it would be possible to order an injunction but to simultaneously stay it for a significant period of time in order to allow the defendant to implement a workaround. Such transitional periods have been discussed in the U.S. on many occasions and even the U.S. International Trade Commission, whose remedy is purely injunctive (import bans), has in some cases (such as an *Apple v. HTC* dispute) granted grace periods to make modifications. The mere fact that Judge Dr. Grabinski discussed this possibility in public and believes it is reconcilable even with the current draft rules of procedure (in conjunction with the related international agreements and treaties) is good news, especially since it comes from a high-ranking judge from a country in which injunctive relief is a near-automatic remedy for patent infringement. But unless the rules of procedure are improved, there's a risk that this will just remain a nice idea but that the court's practice, at least in cases brought before a local German division, will give patentees (even those who can only claim rights to minor features) excessive leverage.

Those who promote balance and reasonableness will have to work hard and smart on the lobbying front to achieve their stated goals, but they should take encouragement from today's hearing (though the challenges were also noticeable).