

European Patent Institute | Bayerstrasse 83 | 80335 Munich | Germany

Mr Paul van Beukering,
Chair of the Preparatory Committee

Alexander Ramsay
Vice-chair of the Preparatory Committee

July 12, 2013

Re: Representation by European Patent Attorneys

Dear Sirs,

With reference to your email communication of 27th March 2013, I note with enthusiasm the progress being made towards the establishment of the new Unified Patent Court and I congratulate you both on your respective appointments.

As your note makes clear, there is much work to be done and assistance from many sides will be essential if the outcome is to be a success. I have therefore taken the liberty of already mandating the Litigation Committee of the **epi** to look into issues surrounding the new qualifications for our members – the European Patent Litigation Certificate (EPLC) or its equivalent. You will find enclosed the resulting proposals of the **epi** concerning these important matters.


We understand that it is still early days and that the Preparatory Committee may not yet have formulated its own position. Nevertheless, this is an area where considerable lead-time is required. Courses are already underway that hope to become EPLC accredited and prospective students are keen to know what they should be doing now in order to be eligible to represent once the new system comes into force.

In addition, many European Patent Attorneys having already an extensive experience of patent litigation before the national courts are also keen to have the confirmation that their

present experience will allow them to represent before the UPC, as soon as it comes into force.

From a practical side, I would like to propose and offer our assistance on the project team that is to be tasked with establishing the “Rules on the qualifications, including the litigation certificate for European Patent Attorneys”.

Best regards/Mit freundlichen Grüßen/Sincères salutations



Antonius Tangena

Ausschuss für Streitregelung
Litigation Committee
Commission Procédure Judiciaire

July 2013

REPRESENTATION BEFORE THE UPC BY EUROPEAN PATENT ATTORNEYS
COMMENTS BY THE EUROPEAN PATENT INSTITUTE (epi)

1. Article 48 of the UPC Agreement states:

(1) Parties shall be represented by lawyers authorised to practise before a court of a Contracting Member State.

(2) Parties may alternatively be represented by European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who have appropriate qualifications such as a European Patent Litigation Certificate.

(3) The requirements for qualifications pursuant to paragraph 2 shall be established by the Administrative Committee. A list of European Patent Attorneys entitled to represent parties before the Court shall be kept by the Registrar.

2. The UPC Agreement therefore clearly foresees representation of the parties either by a lawyer or by a European Patent Attorney having an appropriate qualification and being mentioned on a special list held at the Registry.

3. It must be recognised that EPAs as defined in Article 48(2) will be able to provide highly efficient representation before the UPC partly because they have a deep and practical knowledge of the EPC and partly because they will know and understand the technology and will be able to argue the technical aspects of the litigation before the technically qualified judges of the panels. EPAs are also familiar with conducting multi-lingual written and oral proceedings before the EPO.

Such representation will benefit the system which will run more efficiently and will benefit parties.

4. In order that representation of the parties before the UPC, as foreseen by the Agreement, could be guaranteed as from the entry into force of the Agreement, it appears necessary that European Patent Attorneys be entered on the list before entry into force of the UPC if they are able to afford evidence of their existing qualifications and experience corresponding to the stated « appropriate qualifications ».

5. The European Patent Litigation Certificate, mentioned in Article 48(2) as an example of appropriate qualification, will not exist before entry into force of the UPC Agreement and could not therefore be required from those European Patent Attorneys who already fulfil the “appropriate qualifications”.

6. After entry into force of the UPC Agreement however, European Patent Attorneys wishing to enter the list of representatives before the UPC should have the possibility, either to rely on precisely defined “appropriate qualifications”, for example acquired in their capacity as a national patent attorney in an EPC member State or to justify having obtained the European Patent Litigation Certificate.

The **epi** would like to present here some suggestions to the Preparatory Committee relating to the above stated « appropriate qualifications » (I) and to the « *European Patent Litigation Certificate* » (II).

I. The appropriate qualifications

7. A European Patent Attorney (EPA) is a person entitled to act as professional representative in all proceedings established by the EPC, whose name appears on a list maintained for this purpose by the European Patent Office according to Article 134 EPC.

8. EPAs are formally qualified to carry out contentious patent work and develop extensive experience of oral advocacy during opposition and appeal proceedings at the EPO.

9. The stated « appropriate qualifications » should demonstrate for an EPA additional abilities commensurate with their expected duties and going beyond the European qualification examination which EPAs are required to pass. They should, in particular, reflect the necessary and desirable skills and knowledge for representation before the UPC.

10. Many EPAs have already an extensive experience acquired as patent attorney in their respective EPC member state, going beyond representation before the Patent Office and should therefore be recognised as appropriately qualified on the day the UPC comes into force.

11. Examples of EPAs that are deemed appropriately qualified should include:

- a) EPAs already qualified to represent before a court in patent matters in an EPC member state and able to afford evidence of an effective experience of representation before such court.
- b) EPAs that have successfully completed, before entry into force of the UPC Agreement, one of the courses in patent litigation given by CEIPI, Nottingham and Hagen.
- c) EPAs with a Bachelor level law degree from a university of an EPC member state.
- d) EPAs demonstrating extensive practical experience of the conduct of patent litigation in an EPC member state, for example by assisting an authorized representative or a judge before national courts in at least five patent litigation cases and/or having commensurate practical experience of the conduct of opposition procedure before the EPO and the Boards of Appeal.
- e) EPAs who are qualified as attorney-at-law in an EPC member state.

II. The European Patent Litigation Certificate

12. There presently exist throughout Europe a wide and varied patchwork of legal skills, qualifications and rights of different national patent attorneys, regulated according to local rules and by-laws.

13. The present requirements for qualification as European Patent Attorney (EPA) do not specifically require knowledge of general principles of law, related IP rights, infringement, or procedural law.

14. Some national patent attorney qualifications do require knowledge of legal principles and procedure, whereas others do not. Some national patent attorneys have certain rights of audience and representation before their national courts, whereas others have none.

15. It would be desirable for the European Patent Litigation Certificate to take into account these differences in background of the different EPAs across the various EPC member states, to both avoid the need for individuals to spend time duplicating experience or qualifications, and also to ensure that the European Patent Litigation Certificate is awarded to individuals who meet the necessary threshold.

16. The **epi** proposes a modular system for acquiring qualification whereby an individual may qualify for the individual modules by a number of different routes in order to be awarded the European Patent Litigation Certificate.

17. A number of courses related to patent litigation are currently available (CEIPI, Hagen, Nottingham, etc). Each of these courses must be free to offer its own curriculum for awarding the European Patent Litigation Certificate although entry on the List should depend on meeting the agreed minimum requirements.

The **epi** suggests that the basic structure of the minimum requirements would comprise two modules:

18. **Core Module:** The core module is designed to bridge the gap between EQE training and an advanced national patent attorney training. It could comprise the following:

- a) Basic knowledge of the legal principles of civil law, covering common law and continental law,
- b) Basic knowledge of the “Brussels” EU Regulation and various EU Directives in the IP area (particularly the Directive on Enforcement), EU competition law, International IP law (including the Trips agreement and the Hague Convention on recognition and enforcement of foreign judgements in civil and commercial matters), the European Human Rights Convention,
- c) Main principles of contract law, IP ownership and company law.
- d) Organisation and IP related important case law of the European Court of Justice and the Court of First Instance, including preliminary ruling procedure.
- e) Patent infringement and validity, covering claim analysis, Article 69 EPC, literal/non-literal infringement, contributory infringement, exhaustion, defences against infringement, main case law of the UPC with an emphasis on providing practical strategic advice.

19. EPAs having national qualifications that meet these requirements would not normally be required to repeat the core module.

20. Candidates completing the core module should be in a position to advise their clients in relation to the strengths and weaknesses of their case with respect to possible proceedings before the UPC both from a legal perspective and from an analytical perspective.

21. **Litigation Module:** This module is directed specifically to procedures before the UPC. It shall require completion of the core module or other equivalent competence as prerequisite.

22. It could cover:

- a) The Unified Patent Court Agreement and Statute as well as the Rules of Procedure;
- b) Pre-suit protocols and filing suit;
- c) Determining jurisdiction, forum shopping;
- d) Obtaining evidence, seizure procedure (“Saisie”), discovery procedure, other means;
- e) Actions for Declaration of Non-Infringement, Invalidity, defence and counterclaims;
- f) Infringement Actions;
- g) Drafting of briefs, formal and substantial requirements, case management;
- h) Rights and obligations of Representatives including conduct toward other Representatives, toward the Judges, experts of the Court and witnesses during the procedure;
- i) Use of experts, experiments and witnesses;
- j) Enforcement of orders;
- k) Arbitration and Mediation;
- l) Sanctions and civil liability;
- m) Interlocutory injunctions;
- n) Practical Case Studies and mock trials;

23. The litigation module would be expected to require between 100 and 150 hours of course participation. It should conclude with an examination.

For the Litigation Committee
Axel CASALONGA
Chairman