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Third Proposal for an EPLP.

5

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(Explanatory notes in italics.)

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Terms of reference and history.

95 *On 24 and 25 June 1999 an Intergovernmental Conference of the member states of*
the European Patent Organisation (EPO) was held in Paris. In view of the need to
improve the enforceability and legal certainty of European patents by establishing a
jurisdictional system ensuring uniform interpretation of the European patent, it was
100 *recommended that the Organisation's member states take whatever measures they*
consider necessary to study the restriction to a minimum of the number of courts
dealing with patent litigation.

The Conference also mandated a Working Party on Litigation (WPL) chaired jointly
by Germany, Luxembourg and Switzerland to:

- 105
- study under what conditions the principle of arbitration in litigation relating to*
validity and infringement might be acknowledged by the Organisation's member
states
 - consider how a common entity can be established and financed to which national*
110 *jurisdictions can refer aspects of litigation relating to validity and infringement with*
a view to obtaining an opinion
 - present a draft optional protocol to the European Patent Convention (EPC) which*
would commit its signatory states to an integrated judicial system, including uniform
rules of procedure and a common court of appeal.

115 *The report containing the WPL's proposals was to be submitted to the governments*
of the Organisation's member states and the EPC Revision Conference before 1 July
2000.

120 *At its first meeting in Lucerne on 14 and 15 September 1999, the WPL, among other*
things, mandated the chair to draw up, for the next WPL meeting at the end of
January 2000, a discussion paper which should set out the basic contents of an
optional protocol, including the main court and procedural rules for a European
patent court of first and second instance as well as the necessary provisions of
125 *substantive law. There was a clear preference for the European patent court of first*
instance to have some form of local presence.

On 8 December 1999 a draft of this discussion paper was discussed in Berne with a
number of experienced patent judges from some EPC member states in presence of
130 *representatives of the countries forming the co-chair.*

From 25 till 27 January 2000 the discussion paper was discussed at a second
plenary session of the WPL. A group of six to eight delegations was basically in
favour of the proposals in the paper, which were also strongly supported by UNICE
135 *and the epi. A group of around four delegations accepted the idea of a European*
patent court of second instance, but wanted first-instance jurisdiction to remain with
national courts.

¹ As at 1 January 2000: all members of the European Union plus Cyprus, Liechtenstein, Monaco and Switzerland. Turkey has joined the EPO in the course of that year.

Protocol.

140 *The WPL requested the chair to develop the model of a European patent court of first and second instance. In response to this, the discussion paper was reworked and further elaborated.*

145 *In May 2000 the WPL published the document “The First Steps Towards an Optional Protocol Under the European Patent Convention on the Settlement of Litigation Concerning European patents” (WPL 9/99 Rev. 1), containing a summary of the ideas about the structure of a European patent litigation system as developed at that moment by the working party.*

150 *This structure paper mentioned that the mandate of the Intergovernmental Conference to the WPL was to draw up an optional protocol on the settlement of litigation concerning European patents (EPLP: European Patent Litigation Protocol), which all EPC contracting states can sign or accede to if they so wish (EPLP states).*

155 *It further stated that for reasons of time, given the complex and fundamental issues to be discussed and decided, that structure paper could not be expected to present a full and finalised protocol. Nevertheless it was possible to outline the protocol's structure and give a reasonably detailed description of its contents.*

160 *The EPLP should contain all the necessary rules on the establishment and functioning of a European patent court of first and second instance, ruling on disputes relating to both the validity and infringement of European patents. According to this structure paper The EPLP should be based as far as possible on existing texts and provisions, in particular*

- *the EPC and its implementing regulations*
- *the 1989 Community Patent Convention (CPC)*
- 165 - *the 1989 Protocol on the settlement of litigation concerning the infringement and validity of Community patents (CPC Protocol on Litigation) and associated protocols (Protocol on Privileges and Immunities, Statute of the Common Appeal Court (COPAC Statute)*
- *the Brussels and Lugano Conventions*
- 170 - *the 1994 Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS)*
- *national law of EPC contracting states.*

175 *To this list has to be added now the Regulation 44/2001 of the Council of the European Union, on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, incorporating de facto the Brussels Convention on these subjects.*

180 *The structure paper pointed out that, although it would be possible to set up a European judiciary outside the European Patent Convention, it would be best to do so under the aegis of this convention.*

185 *Furthermore it pointed out the necessity of safeguarding the priority of the European Union (E.U.) legal system for E.U. member countries without hampering the other signatory states to the protocol and that careful consideration was due to the relation with the Brussels and Lugano Conventions.*

Important was that the structure paper mentioned a number of core elements of the coming protocol:

Protocol.

- 190 1. *The creation of a European Patent Judiciary (EPJ), comprising a common court of first instance, a common second-instance court and a Registry.*
2. *The EPJ should deal jointly with both infringement and validity of European patents, including sanctions and injunctive relief.*
- 195 3. *The jurisdiction of the EPJ should in principle be exclusive.*
4. *The applicable substantive law should be found as much as possible in the EPC, but it was pointed out that it would be necessary to introduce some rules of harmonised law into the EPLP.*
- 200 5. *Decisions revoking the European patent wholly or in part should take effect erga omnes in all EPLP countries, whereas decisions on infringement would only take effect inter partes. Enforcement will have to be carried out by the national authorities.*
- 205 6. *The main features of the organisation of the EPJ (including the number and qualifications of the judges) will have to be described in the EPLP, but the practical organisation of the work will best left to the courts themselves. The common first-instance court must have a local presence.*
- 210 7. *The main principles of procedural law must be set out in the EPLP, but the more detailed rules of procedure and the practical organisation of the proceedings will have to be laid down in separate court rules.*

215 *This structure paper was widely published, both on the internet and in a number of main reviews of patent law throughout Europe. It was put before the Intergovernmental Conference that was held in London in October 2000. On the basis of this structure paper the Intergovernmental Conference gave the working party a further mandate, this time a mandate to produce before the end of 2001 a protocol in treaty language on the basis of the ideas developed in this “Principal elements” paper. The working party created thereto a subgroup, comprising those*

220 *countries who were willing to take an active role in the development of such a protocol.*

² EIPR, GRUR Int., IIC, Journal of World Intellectual Property, Bijblad bij de Industriële Eigendom, Bilaga Patent Eye.

³ “1. The Intergovernmental Conference takes note of the documents WPL/9/99 Rev.1 (Principle elements of an optional protocol on the settlement of litigation concerning European patents) and WPL 10/00 (Proposals regarding the “common entity” to be studied by the Working Party on Litigation under the mandate issued by the Paris Intergovernmental Conference on 24 and 25 June 1999), together with the minutes of the Luxembourg meeting of the Working Party on Litigation (WPL/15/00).

2. The Intergovernmental Conference mandates the existing Working Party on Litigation to submit to the governments of the member states of the European Patent Organisation, no later than the end of 2001 and in treaty language, an optional agreement on the settlement of litigation concerning European patents, including a separate part concerning a common entity, it being understood that the member states of the European Patent Organisation shall be free to join only the part on the common entity. The work will be taken forward on the basis of the documents in point 1 and shall take into consideration the relationship to a community patent system.

3. (...)”

Protocol.

225 *First a proposal for an index of a protocol was published on the bulletin board of the subgroup on the internet on 30 October 2000 and delegations were asked for their comments upon the proposed structure of the text. Taking into account the comments received a first text proposal was drafted and sent to the members of the subgroup on 3 February 2001.*

230 *In this first proposal a structure for the organisation of a European judiciary in two instances with a common registry was sketched. The administrative top of the organisation was to be an Administrative Committee, composed of delegations of the governments of the member states. Under this administrative top there was suggested an Executive Committee, comprising not civil servants but magistrates of the judiciary, i.e. the Presidents of the courts of first and second instance and the Registrar. Furthermore it was foreseen that each court should have its own presidium. The court of first instance was envisaged as one court, although having regional divisions. Furthermore there were formulated 46 questions, to be discussed in the subgroup and to be answered by the delegations, in order to enable a more detailed drafting.*

240 *The subgroup convened from 4 to 6 April 2001 at the Hague to discuss this document titled "First Proposal for an EPLP" (WPL/SUB/5/01 and WPL/SUB/5/01 Add.1).*

245 *During this meeting also was discussed a parallel proposal of the German delegation. In this parallel proposal the German delegation no longer proposed that the proceedings in first instance should remain national and that only in second instance there should be a supranational European court. Instead they proposed to have the proceedings in first instance decided by European patent courts of first instance, using a common European procedural law. Nonetheless they proposed that a limited number of national courts should be acting as European courts of first instance.*

250 *Moreover there was a hearing in Munich of national experts on procedural law on 14 and 15 May 2001 where technical matters were discussed, mainly in the field of the gathering of evidence.*

255 *As a result of the discussions in the Hague and in Munich a second proposal was drafted and sent to the delegations on 21 May 2001, titled "Second Proposal for an EPLP" (WPL/SUB/13/01 and WPL/SUB/18/01).*

260 *The main structure of the judiciary as an organisation was left unchanged. The main changes were in regard of the structure of the court of first instance and its regional divisions. A structure was proposed in which the EPC1 should have a central division but that every member state or group of member states could request the creation of a Regional Division. These regional divisions would have as permanent members experienced national judges. Cases should be allocated with regional divisions according to the rules of the conventions of Brussels and Lugano and of EU Regulation 44/2001.*

270 *A regional division would characterise a case it received as either a case of only regional importance or a case of international importance.*

Protocol.

275 *A case would be of only regional importance if all parties were domiciled in the same member state and only infringement and validity in that same member state were at stake. Cases of only regional importance could be dealt with by a panel consisting of three national judges and in the national language. For cases of international importance this panel would have to be extended by two judges of another nationality and the proposal suggested that the language of the patent would have to serve as language of the proceedings.*

280 *The subgroup of the Working Party on Litigation convened at the Hague from 11 to 13 July 2001 to discuss this second proposal.*

285 *It turned out that ideas of the delegations had further developed and that there now was a broad majority in favour of dealing with all cases in the same way, i.e. by an internationally composed panel.*

290 *That idea is now worked out in detail in this Third Proposal. After plenary discussion by the subgroup in München on 3 to 5 December 2001, this document can be presented by the subgroup to the Working Party on Litigation.*

PART I.

295

Preamble

The Contracting States,

300

Desiring to enhance the harmonization of patent law within Europe, especially as regards European patents;

Desiring a simplification of jurisdiction in cases concerning the validity and/or infringement or possible infringement of European patents and therefore to establish a common supranational jurisdiction between a number of states, respecting and taking into account the system of law of the European Union,

305

Desiring to enhance the potential dissemination of views about European patent law among the different national courts and therefore wanting to create an advisory council which can provide non binding opinions on European patent law to those national courts that wish to receive such opinions;

310

Desiring to those ends to conclude a Protocol to the European Patent Convention, being this Protocol a separate treaty within the meaning of Art. 19 of the Convention for the Protection of Industrial Property, signed in Paris on 20 March 1883 and last revised on 14 July 1967,

Realizing that such a judiciary should be of international composition with an equitable representation of the different legal cultures existing in Europe;

315

Conscious of the necessity to enable the members of that judiciary to become fluent in the official languages of the European Patent Organisation;

Have agreed on the following provisions, taking into account that some contracting states have only agreed to the provisions of Part IV. of this Protocol:

320

Chapter I.1 General and institutional provisions

Article 1 Definitions.

EPC	the Convention on the grant of European patents concluded at Munich on 5 October 1973
EPC1	the European Patent Court of First Instance
EPC2	the European Patent Appeals Court
the Organisation	the European Patent Organisation as established by the EPC
the Office	the European Patent Office
CPC	Convention for the European Patent for the Common Market concluded at Luxembourg on 15 December 1975 and the Agreement relating to Community Patents concluded at Luxembourg on 15 December 1989.
Brussels and Lugano Conventions:	the Conventions on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters signed in Brussels on 27 September 1968 and in Lugano on 16 September 1988.
Jurisdiction Regulation	the EU regulation on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters of 22 December 2000 no. 44/2001
Facultative Advisory	the Facultative Advisory Council as established by Part IV.

Protocol.

Council	Article 164 of this protocol.
EPJ	the European Patent Judiciary as established by this protocol.
EPJ-states	contracting states that have acceded to Chapter I.1, Part III. and V of this protocol
Facultative Advisory Council-states	contracting states that have acceded to Part IV. of this protocol.
European patents	patents granted according to the EPC, not being European community patents.

If the EU were to become a member of the EPC, a community patent could be regarded as a European patent. To avoid conflicting regulations, it has to be made clear that this protocol and its judiciary will have no jurisdiction over community patents.

Of course this provision should have to be revised if the EU would decide to access not only to the EPC but also to this protocol.

Court	any of the European Patent Courts as established by this protocol, comprising the members of the court dealing with an individual case, be it the whole panel or the rapporteur.
Panel	a number of judges of EPC1 or EPC2, being designated to sit and decide on a certain case
Legal judge	a judge of the EPJ who is appointed as a legally qualified judge
Technical judge	a judge of the EPJ who is appointed as a technically qualified judge

Use in this protocol of the words “he” and/or “his” are to be taken as indicating equally the words “she” and “her” respectively.

325

Article 2 System of law established

A system of law, common to the EPJ-states, for the adjudication of proceedings concerning the validity and/or infringement of European patents is hereby established.

330

See Art. 1 EPC.

Article 3 European Patent Judiciary established

1. A European Patent Judiciary for the EPJ states is established by this protocol.
2. It shall have judicial, administrative and financial autonomy.

335

See Art. 4 EPC. In due time the EPJ will have to be incorporated into the European Patent Organisation as a separate organ of the Organisation. As long as some EPC member states are not also member states to the protocol, it seems simpler to keep it distinct from the Organisation.

340

Article 4 Legal status and Immunity.

The Protocol on Privileges and Immunities of European Patent Judiciary shall define the conditions under which the European Patent Judiciary, its judges, the members

Protocol.

345 of the Administrative Committee, the officials and other servants of the European
Patent Judiciary and such other persons specified in that Protocol as take part in the
work of the European Patent Judiciary shall enjoy, in the territory of each EPJ State,
the privileges and immunities necessary for the performance of their duties

350 *See art. 4 Protocol On The Settlement Of Litigation of the CPC. A similar protocol
will have to be drawn up for the EPJ. This can however wait till more is known
about the future of this protocol.*

Article 5 Task of the EPJ

The function of the EPJ will be the adjudication of litigation concerning the validity
and/or infringement of European patents, if and in so far as EPJ-states are designated
in such European patents.

Article 6 Seats

360 The EPJ, the European Patent Court of First Instance (EPC1), the European Patent
Appeals Court (EPC2), its Registry and the Facultative Advisory Council shall have
their seat at ...

365 *The seat will have to be determined by the common accord of the
governments of the EPJ-states, see Art. 2 Protocol on litigation CPC. The only
requirement to be kept in mind is that it should be a place with good and frequent
aeroplane connections with the rest of Europe, as the courts and its judges will have
to travel frequently. It is of the utmost importance to make it attractive for
370 experienced patent judges to take part in the EPJ because the success of the whole
system is dependent on the confidence the users of the system can have in the quality
of the judges concerned. Therefore the accessibility of the seat of the courts is more
than just a political question; it is of overriding importance for the success of the
EPLP.*

375

PART II. HARMONISING PROVISIONS

Chapter II.1 Substantive Patent Law

380 *See WPL 9/99 par. 3.3 1). Although the substantive law established in
the CPC is implemented in most member states, it seems advisable to re-enact it in
this protocol because of the possible future accession of states that were not member
states of the CPC.*

385 *Originally the proposal contained also an article about exhaustion with the text:
“The rights conferred by a European patent shall not extend to acts concerning a
product covered by that patent if these acts are done within the territory of a EPJ
state after that product has been put on the market by the patent proprietor or with
his consent in that EPJ state.*

390 *If the EPJ state is a European Union member state the same shall apply if that
product has been put on the market by the patent proprietor or with his consent
within the territory of the European Economic Community unless there are
legitimate grounds for the proprietor to oppose further commercialisation of the
product.”*

Protocol.

395 *At the request of a majority of delegations it was however deleted at the meeting of
the subgroup at the Hague in July 2001 because these delegations were of the
opinion that this protocol was not the right place for such an article.*

Article 7 Infringing acts

400 A European patent shall confer on its proprietor the right to prevent all third parties
not having his consent:

- (a) from making, offering, putting on the market or using a product which is the
subject-matter of the patent, or importing or stocking the product for these purposes;
(b) from using a process which is the subject-matter of the patent or, when the
third party knows, or it is obvious in the circumstances, that the use of the process is
405 prohibited without the consent of the proprietor of the patent, from offering the
process for use within the territories of the EPJ states;
(c) from offering, putting on the market, using, or importing or stocking for these
purposes the product obtained directly by a process which is the subject-matter of
the patent.

410

See Art. 25 CPC

Article 8 Indirect infringement

415 1. A European patent shall also confer on its proprietor the right to prevent all third
parties not having his consent from supplying or offering to supply within the
territories of the EPJ states a person, other than a party entitled to exploit the
patented invention, with means, relating to an essential element of that invention, for
putting it into effect therein, when the third party knows, or it is obvious in the
circumstances, that these means are suitable and intended for putting that invention
420 into effect.

2. Paragraph 1 shall not apply when the means are staple commercial products,
except when the third party induces the person supplied to commit act prohibited by
Article 7

425 3. Persons performing the acts referred to in Article 9 (a) to (c) shall not be
considered to be parties entitled to exploit the invention within the meaning of
paragraph 1.

See Art. 26 CPC.

Article 9 Exceptions from scope of protection

430 The rights conferred by a European patent shall not extend to:

- (a) acts done privately and for non-commercial purposes;
(b) acts done for experimental purposes relating to the subject-matter of the patented
invention;
435 (c) the extemporaneous preparation for individual cases in a pharmacy of a
medicine in accordance with a medical prescription nor acts concerning the
medicine so prepared;
(d) the use on board vessels of the countries of the Union of Paris for the Protection
of Industrial Property, other than the EPJ states, of the patented invention, in the
440 body of the vessel, in the machinery, tackle, gear and other accessories, when such
vessels temporarily or accidentally enter the waters of the EPJ states, provided that
the invention is used there exclusively for the needs of the vessel;

Protocol.

445 (e) the use of the patented invention in the construction or operation of aircraft or
land vehicles of countries of the Union of Paris for the Protection of Industrial
Property, other than the EPJ states, or of accessories of such aircraft or land vehicles,
when these temporarily or accidentally enter the territory of the EPJ states;
(f) the acts specified in Article 27 of the Convention on International Civil Aviation
of 7 December 1944, where these acts concern the aircraft of a state, other than the
EPJ states, benefiting from the provisions of that Article.

450 *See Art. 27 CPC*

Article 10 Provisional protection after publication.

455 Compensation reasonable in the circumstances may be claimed from a third party
who, in the period between the date of publication of a European patent application
in which EPJ states are designated and the date of publication of the mention of the
grant of the resulting European patent, has made any use of the invention which,
after that period, would be prohibited by virtue of the European patent.

460 *See Art. 32 CPC.*

Article 11 Reversal burden of proof

465 1. If the subject matter of a European patent is a process for obtaining a new product,
the same product when produced by any other person shall, in the absence of proof
to the contrary, be deemed to have been obtained by the patented process.

2. In the adduction of proof to the contrary, the legitimate interests of the defendant
in protecting his manufacturing and business secrets shall be taken into account.

470 *See Art. 35 CPC.*

Article 12 Prior use

475 1. Any person who, if a national patent had been granted in respect of an invention,
would have had, in one of the EPJ states, a right based on prior use of that invention
or a right of personal possession of that invention, shall enjoy, in that state, the same
rights in respect of a European patent for the same invention.

480 2. The rights conferred by a European patent shall not extend to acts concerning a
product covered by that patent which are done within the territory of the state
concerned after that product has been put on the market in that state by the person
referred to in paragraph 1, in so far as the national law of that state makes provision
to the same effect in respect of national patents.

See Art. 37 CPC.

485 *Another solution could be to harmonise the rights of the prior user substantially by
implementing an article like article 12 of the Commissions Proposal for a Council
Regulation on the community patent [Com(2000) 412 final] stating:*

490 *“1. A community patent may not be invoked against a person who, in
good faith and for business purposes, had used the invention in the Community or
had made effective and serious preparations for such use before the filing date or,
where priority has been claimed, the priority date of the application on the basis of
which the patent is granted (hereinafter referred to as “the prior user”); the prior*

Protocol.

user shall have the right, for business purposes, to continue the use in question or to use the invention as planned during the preparations.

495 2. *The right of the prior user may not be transferred either during the users lifetime or following his death other than with the user's undertaking or that part of the undertaking in which the use or the preparations for use took place."*

500 *For the time being it seems however better to keep to the text as proposed, as this text is the one already implemented in member states, while the fate of the other proposal is not yet known.*

Article 13 Position of licensees.

505 1. *Exclusive licensees under a European patent will be competent to start litigation on matters of infringement and damages before the European Patent Judiciary to the same extent as a patentee.*

 2. *An exclusive licensee in the sense of this provision is a licensee that is, on the basis of a contract with the patentee or with a licensee authorised to conclude such a contract, solely competent to exercise the powers of the patentee for a certain territory and/or time.*

510 3. *If in proceedings conducted by a licensee, in which proceedings the patentee is not taking part, the validity of the patent in suit is attacked, a decision in this respect will, failing an agreement between the parties otherwise, only have effect between the parties in those proceedings.*

515 *The legal position of licensees and exclusive licensees as regards proceedings for infringement and damages is different throughout Europe, without at first glance compelling reasons.*

It might be thought desirable to harmonise this possible minor matter as well.

520 *For instance by granting exclusive licensees the right to sue for both injunctions against and damages for infringement within the scope of their licenses. If a defendant were to invoke as a defence the invalidity of the patent, a decision in that respect would only be valid inter partes.*

525 *Another solution would be to make it obligatory for either the alleged infringer or the licensee to join the patentee to the proceedings as soon as the validity of the patent is made an issue but that would cause considerable delay and procedural complications. Of course the patentee who wishes to do so could always intervene like every other third party whose interests are at stake, on the basis of the practice directions in that respect (see § 17 of the Rules of Procedure). During the*
530 *meeting of the subgroup at The Hague in April 2001, there was broad support for the proposition to harmonise the position of the exclusive licensees in this respect.*

535 *During the meeting of the subgroup in July 2001 the paragraph regulating the position of non-exclusive licensees was taken out. That paragraph was worded: "Other licensees will be able to sue alleged infringers for damages but not for an injunction unless expressly authorised by the patentee."*

Article 14 Limitation of actions for damages.

540 1. *The right to damages, caused by infringement of a European patent, will expire if these damages have not been claimed from the defendant or his predecessor in right in court or in a registered letter within five years after the date on which the patentee*

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or licensee entitled to such damages should reasonably have been aware of the act constituting the infringement.

545 2. If a registered letter claiming damages is not followed by either payment of the damages or a new registered letter, the right to the damages will expire five years after the date of sending of the last registered letter.

3. If proceedings in which damages are claimed end without a decision or a settlement in this regard the right to the damages will expire five years after the ending of the proceedings.”

550

At the hearing of national experts on procedural law there was a nearly unanimous wish to introduce a harmonised limitation in time for actions for damages.

This can in principle be done in two ways:

either the right to damages itself lapses (loss of the right)

555 *or the right to sue for damages lapses (either only before the EPJ or also before the national courts) (loss of the action).*

The difference is that in the second option damages once paid (e.g. because the infringer was not aware of the limitation) are not recoverable in court and a claim for damages could still be deducted from other amounts due.

560

This proposal opts for the first possibility as giving the least possibilities for future difficulties and uncertainties.

Chapter II.2 Relationship to international law.

565

Section II.2.1 Relationship to art. 25 EPC

Article 15 re art. 25 EPC.

570 The EPJ states hereby designate EPC1 and EPC2 as national courts in the sense of art. 25 EPC.

During the meeting of the subgroup in April 2001 in the Hague, some delegations expressed the wish that the EPJ courts should have the possibility of asking the advice of the EPO, especially as regards the reformulation of the claims of a patent.

575 *That is not easily to be accomplished because the member states that accept the EPLP, being only a part of the member states to the EPC, cannot of course change the obligations of the Office or the contents of the EPC.*

This provision opens nevertheless, within the existing framework of the EPC, the possibility for the EPJ courts to ask for a technical opinion in the sense of art. 25 EPC. It has to be left to the Office and to the way the request for an opinion is worded, whether these opinions of the Office will be of help in reformulating claims.

580

(In this respect there should also be an important role for the technical judges: coming from the Boards of Appeal of different patent offices and from national validity courts, they will have the necessary experience in the formulation of patent claims.)

585

Section II.2.2 Relationship to EU law.

Article 16 re art. 234 EEC

590 1. Those EPJ-states that are members of the European Union hereby designate, for litigation concerning European patents, EPC1 and EPC2 as national courts,

Protocol.

respectively court or tribunal of a member state, against whose decisions there is no judicial remedy under national law, in the sense of Art. 234 of the Treaty establishing the European Community.

595 2. The preliminary rulings of the European Court of Justice will be binding for EPC1 and EPC2 as far as their decisions are given for the territory of EU member states.

600 *Thus the European Patent Courts can put preliminary questions to the Court of Justice in Luxembourg if questions of European community law do arise. Of course these questions could only be asked (and the answers be taken into account) for the territories of the EPLP-states that are also member states to the EU.*

605 *The second paragraph is added in response to a remark of the representative of the European Commission during the meeting of the working party in July 2001, that it was not clear whether the supremacy of EU law for EU member states was sufficiently safeguarded.*

610 *Art. 234 last sentence of the EC treaty comprises for EPC2 – because it is characterised here as a national tribunal against whose decisions there is no judicial remedy - not only a possibility to ask preliminary questions but also an obligation to do so.*

Section II.2.3 Relationship to Brussels and Lugano Treaties

Article 17 re art.2 and art. 16 Brussels and Lugano

615 1. Those EPJ-states that are contracting parties to the Brussels and Lugano Conventions, hereby designate, for litigation concerning the validity of European patents, EPC1 and EPC2 as their national courts in the sense of Art.2 and Art. 16 (4) of those conventions.

620 2. If and to the extent the provisions of those conventions and the provisions of this Protocol may conflict, the latter shall take precedence.

625 *Other than in the first proposal, the application of the articles 21, 22 and 23 of the Brussels and Lugano Conventions is not excluded. This because of a greater harmonisation with Regulation 44/2001, that does not give very broad possibilities for deviation. Moreover it is probably not really necessary: as jurisprudence in Belgium and Italy seems to be developing now, the torpedo problem seems to be solved in another way.*

630 **Section II.2.4 Relationship to EU Council Regulation EC Nr. 44/2001 of 22 December 2000 (Jurisdiction regulation)**

Article 18 re art. 22 Reg. 44/2001

635 Those EPJ-states that are members of the EU, hereby designate, for litigation concerning the validity of European patents, EPC1 and EPC2 as national courts in the sense of Art. 22 (3) and (4) of the EU Regulation on jurisdiction and the recognition of judgments in civil and commercial matters.

⁴ (ex Art. 177)

⁵ As “torpedo actions” are known proceedings regarding a European patent, e.g. a declaration of non-infringement for all designated countries, that are started in a jurisdiction that is expected to be slow. The envisaged effect of such an action is that other, faster, jurisdictions will be blocked in dealing with proceedings concerning the same patent and/or the same alleged infringement.

Protocol.

640 *Art. 22 of the Regulation is Art. 16 of the Brussels convention. This provision prevents any conflict between the Regulation and this protocol by making EPC1 and EPC2 national courts in the sense of this Regulation without the need to speculate whether this Protocol, as an annex to the existing EPC, is to be considered as a convention to which the member states “are” parties in the sense of Art. 71 of this Regulation.*

645 *Nevertheless it would appear necessary to consult the European Commission on their views on this matter, to avoid any possible future differences of opinion.*

Section II.2.5 Relationship to EU Regulation EG Nr. 1348/2000 (Regulation on service of documents)

Article 19 re Reg. 1348/2000

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655 1. Those EPJ-states that are members of the EU, hereby designate, for litigation concerning the validity of European patents, EPC1 and EPC2 as national courts in the sense of the Regulation on the service in the member states of the European Union of judicial and extra judicial documents in civil or commercial matters (Regulation EG Nr. 1348/2000, L 160/37).

660 2. Accordingly, summonses, communications and other documents from these courts shall be sent directly to the party concerned and shall not be considered as documents sent from one member state to another member state.

As this Regulation did not take into consideration the possibility of supra-national courts, a provision has to be given to avoid uncertainty.

Chapter II.3 Relationship to national law

Article 20 Jurisdiction national courts as regards interlocutory and protective measures

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670 1. In cases in which the EPJ otherwise has exclusive jurisdiction, the national courts in the EPJ states shall nevertheless remain competent for claims for interlocutory measures and measures to protect or conserve possible evidence.

675 2. A party who has applied for such an interlocutory or protective order from a national court shall within 31 calendar days notify the rapporteur if proceedings on the merits are pending before an EPJ court, regarding the same European patent and/or the same alleged infringement. Failing this notification within 31 calendar days, the order of the national court will cease to have effect from the day after this time limit has passed, without prejudice to the right of the party against whom the order was directed to claim damages, caused by that order and/or its execution.

680 3. If no proceedings as to the merits are pending before the EPJ and if such proceedings are not brought before the EPJ within 31 calendar days after the date of the order of the national court, or such other term as the national court stipulates, the interlocutory or protective order of the national court will cease to have effect from the day after this time limit has passed, without prejudice to the right of the party against whom the order was directed to claim damages, caused by that order and/or its execution.

685 *See also Art. 24 Brussels and Lugano Treaties. The time limit within which proceedings to the merits have to be instigated is derived from by Art. 50 (6)*

Protocol.

690 *TRIPS. No reference is made however to working days as mentioned in that TRIPS article, because not all countries in Europe have the same working days and the same public holidays. Because of legal certainty in these cases with possible cross border effect, that term is avoided.*

695 *In many cases there has to be some time available to gather evidence or to consult experts. If that seems appropriate the national court can fix another term, as also allowed by TRIPS. (Nor the Brussels and Lugano conventions nor the EU Regulation 44/2001 specify any term in this respect, so there is no danger of conflict here.)*

Article 21 Jurisdiction of national courts as regards provisional seizure

700 1. In cases in which the EPJ otherwise has exclusive jurisdiction, the national courts in the EPJ states shall nevertheless remain competent for claims for provisional seizure of goods, fit to provide security for damages or other claims for money connected with a dispute regarding a European patent, a European patent application or an alleged infringement thereof.

705 2. A party who has applied for such an order from a national court shall within 31 calendar days notify the rapporteur if proceedings on the merits are pending before an EPJ court, regarding the same European patent and/or the same alleged infringement.

710 3. Failing this notification within 31 calendar days, the order of the national court will cease to have effect from the day after this time limit has passed, without prejudice to the right of the party against whom the order was directed to claim damages, caused by that order and/or its execution.

715 4. If no proceedings as to the merits are pending before the EPJ and if such proceedings are not brought before the EPJ within 31 calendar days after the date of the order of the national court, or such other term as the national court stipulates, the interlocutory or protective order of the national court will cease to have effect from the day after this time limit has passed, without prejudice to the right of the party against whom the order was directed to claim damages, caused by that order and/or its execution.

Article 22 No cross border effect.

720 Decisions by a national court of a EPJ state as meant in Article 20 or Article 21 will have effect only in that EPJ state .

Article 23 Registration of notifications.

725 The registry will enter the notifications mentioned in Article 20 and Article 21 in the register of cases, mentioned in § 108 of the Rules of Procedure..

PART III. EUROPEAN PATENT JUDICIARY

730 *As regards the organisational aspect of the matter, a possible approach would be a model with one court, having two divisions (a trial division and an appeals division), in which judges would be appointed to one of the divisions but would ex officio also be a member of the other division. (Of course judges could never sit on appeal on a case they had been involved with in the first instance.) This is the Canadian model.*

735 *The Australian model goes even a step further: their Federal Court does have first instance and appellate jurisdiction but does not even have two different divisions.*

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A model like this seems attractive in view of the restricted human resources available.

740 *However at the meetings of the subgroup in The Hague in April and July 2001 there was a clear preference for a system with two separate courts. Nevertheless this possibility is still mentioned here, not only because it shows to the working party that this possibility was taken into account by the subgroup but also because it might get new relevance now that the Common Approach of the Internal Market Council of the EU of 31 March 2001 seems to favour a court structure for the envisaged*
745 *community patent wherein both first and second instance will be decided by judges belonging to only one court: the Court of First Instance in Luxembourg. (The judicial panels according to art. 220 and art. 225 a of the Nice Treaty are part of the Court of First Instance.)*

750 *If a model is used having two separate courts of first and second instance, a scheme of common management and administration has to be devised. In this, each court should be able to manage its own business as much as possible. The more so because the structure of the court of first instance will turn out to be much more complicated than that of the court of second instance. Nevertheless a*
755 *coordinating body should be created because a number of matters should be decided uniformly for both courts, and also because the Registry will be serving both courts*

Because it is not known in what direction future developments, also on other European fronts, will be going, it is not expressly proposed that judges of one court should ex officio always be also judges of the other court; that could cause complications in the future if merging with other judicial structures would have to be considered.

760 *To avoid possible misunderstandings it was however expressly stipulated that judges can be a member of both courts at the same time. In this way it could be left to praxis to appoint judges in both courts as long as that seems*
765 *necessary and/or desirable (a certain variation between working in first and in second instance can in my view enhance the quality of judicial work).*

There were however some strong reservations as regards the desirability of judges being members of both courts at the same time.

770 *Nevertheless (taking into account the relatively small number of experienced patent judges in Europe) it does seem unavoidable, in any case for a transitory period. But also in the longer run, it does for instance seem advisable that technical judges be appointed as members of both courts as their expertise will be very much in demand and relatively scarce. It seems rather a pity to reserve a number of the few judges*
775 *available – and probably the most experienced of them at that – for an appellate court that will have little work at first and in any case always will have less work than the court of first instance.*

Moreover there are other strong arguments in favour of judges more or less freely rotating between the work in first instance and appellate work. Therefore, although certainly unusual for Europeans it should nevertheless be considered very seriously whether we could not learn something to or great advantage from other legal
780 *cultures. Certainly it would be more convincing to the users of the appellate court if the judges working there would also have experience in first instance jurisdiction. Also it would avoid a mentality of competition between the first and second*
785 *instance: the “us-and-them” mentality. A further advantage would be that all judges would have the same status.*

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790 *Because of the strong reservations with some delegations and to give all parties concerned more time to consider this matter, the provision about judges being members of both courts is for the time being moved to the transitory provisions: see Article 182 In that way it is left to the praxis to decide whether and for how long this possibility will have to be used.*

795 *It seems worthwhile to go into the question whether art. 6-1 of the Convention of human rights poses problems in this respect. That same issue has to be examined as regards the question whether it would be possible to have members of the Boards of Appeal of the Office functioning part of their time as judges on the EPJ (see Article 68 and its explanatory note)*

800 *Taking into consideration the huge advantages of being able to use the scarce human resources as broadly as possible and the other advantages mentioned before, we should only renounce the possible dual membership and the enlisting of members of the Boards of Appeal if art. 6-1 of the Convention on Human Rights poses a problem here.*

805 *Administrative Committee*

An Administrative Committee, connected with the national governments of the EPJ states, should govern the EPJ from an organisational point of view. The initial suggestion to make the members of the Administrative Council of the EPO ex officio members of the Administrative Committee met with widespread doubts in the subgroup. It was generally felt to be better to leave it to the member states to appoint the members of the Administrative Committee and, therefore, leave it to the states to decide whether they wanted to have the same persons in both organs.

815 *It was however broadly supported to create the possibility for member states of the EPO who where not (yet) EPJ states to attend the meetings of the Administrative Committee in an observer quality.*

820 *For matters concerning the Facultative Advisory Council the Administrative Committee will have to be extended by representatives of FAC states that are not EPJ states.*

825 *It has been suggested that the European Patent Judiciary should not be governed by a political body but by judges. Certainly care should be taken that the independence of the courts and the judges is beyond question. It seems however not feasible to create a new court structure without any connections to the governments of the contracting states: that would mean the creation of a powerful body at a supranational level without any checks and balances and without any responsibility towards democratically elected governments. That would also mean that nobody would be politically responsible for future developments or the lack thereof e.g. as regards the productivity. On the other hand: as is proven in most countries, where the government has the ultimate say in*

⁶ See the Ferrantelli and Santangelo judgment, 7 August 1996, Reports of Judgments and Decisions 1996-III, p.951 et seq., § 58).

Protocol.

835 *organisational and financial matters of the judiciary, it is perfectly possible to have a governing body without endangering the independence of the judiciary.*

The tasks of the Administrative Committee would comprise:

- *the administrative supervision of the EPJ organisation*
- *appointments and re-appointments of judges on a proposal of the*
840 *(enlarged) Executive Committee*
- *the determination of the yearly budgets of the EPJ, the courts and the registry*
- *laying down, on proposal of the Executive Committee, of practice directions of the courts and of the regulations of the registry*
- 845 - *decreeing, on a proposal of the Executive Committee, of the courts fees*
- *controlling financial reports of the Executive Committee and discharging the Executive Committee*

850 *It is important to note that the Administrative Committee of the EPJ should not be able to affect the independence of the courts or the judges. An important point in this respect is that the (re)appointment of the judges and their possible removal from office is not a discretionary power of the Administrative Committee but will only take place on a proposal of the enlarged Executive Committee.*

855

Executive Committee

860 *While the Administrative Committee is an purely administrative and political body, the Executive Committee is a judicial body, in the sense that it is manned by officers of the courts and the registry: the Executive Committee would comprise both presidents and the Registrar.*

Its tasks would comprise:

- *coordination of the management of the courts and the registry and managing the internal organisation as far as common matters are concerned;*
- 865 - *drafting (in an enlarged composition) proposals for appointments of judges*
- *consolidating budgets of the courts and registry into a common EPJ budget and proposal of that budget to Administrative Committee*
- *drafting of proposals to the Administrative Committee for practice*
870 *directions*
- *drafting of proposals to the Administrative Committee for fees*
- *reporting yearly to Administrative Committee on the finances of EPJ.*

875 *As regards the appointment of judges a form of consultation of the court concerned should be devised before the Executive Committee drafts its proposal to the Administrative Committee. To avoid fears about the Executive Committee becoming a kind of “old boys circuit”, only appointing as judges people belonging to a certain class, the wish was stressed in the July 2001 meeting of the subgroup that the proposals for appointment of judges should have a broader basis than just the Executive Committee. Therefore in this third text proposal proposals*
880 *for appointment of judges will have to be made by an enlarged Executive Committee,*

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to wit the Executive Committee plus the (other) members of the presidium(s) of the court(s) concerned.

885

Presidium.

The next level in the organisational structure is the presidium of each court. A comparable organ for the Registry seems superfluous.

890

The Presidium comprises in any case the president of the court and two members to be elected by the members of the court. That seems sufficient for EPC2 but for EPC1, with its more complicated structure, a more extended gremium seems necessary.

895

When the proposal is followed as regards the structure of EPC1, it is proposed that the presiding judges of the Regional Divisions, indicated as divisional presidents of EPC1, are also members of the Presidium of EPC1.

Structure of EPC1.

900

As regards EPC1 there would first of all have to be a Central Division, at the seat of the court. Such a Central Division is indispensable to enable the court to become a real court and for its members to function really as a team.

905

Furthermore it seems necessary for the acceptance of the court that there is a central instance of the court visibly present somewhere.

This Central Division could be staffed by legal judges permanently domiciled there (for instance judges who are not at the same time judges in a national court) and by judges from the different Regional Divisions of EPC1, to be delegated on a rotational basis.

910

A strong and understandable wish of interested circles and of a number of delegations is the creation not only of a Central Division but also of Regional Divisions of EPC1. (The term "division" is used henceforward instead of the formerly used term "chamber" to accentuate that they are functionally a part of the central EPC1 court)

915

In the model as it was developed during the meeting of the subgroup at the Hague in April 2001 broad support seemed to have developed for a structural model for EPC1 that used on the one hand the experience and expertise of the existing national courts and on the other hand safeguarded that this experience would be able to spread to other judges and guarantees a development of international harmonisation while it would prevent that extensive damage could be done to an European patent by a not experienced national court.

920

In that model cases should be assigned to Regional Divisions according to the rules of the conventions of Brussels and Lugano, resp. EU Regulation 44/2001.

925

Subsequently the cases should be labelled by the competent division as being either of only national importance or as international cases. Cases of only national importance should be dealt with in the national language by a panel consisting of only national judges, acting as judges of EPC1. For international cases such a panel

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930 *would be extended by two legal judges of other nationalities and would be dealt with
in the language of the patent.*

*This model was worked out in the second text proposal. During the meeting of the
subgroup in July 2001 it turned out however that strong support had developed for
the idea to treat all cases in the same way and to solve the language problem along
935 the lines laid down in the Protocol on Cost Reduction. That idea is now laid down in
this third text proposal.*

Characteristics of the model now proposed:

*The basis of the court will be a Central Division of EPC1 somewhere in Europe.
940 Furthermore every country or group of countries, provided they are able to staff
such a Division, can request the creation of a Regional Division of this EPC1, with
territorial jurisdiction for those countries on the basis of the rules of the EU
Regulation 44/2001, resp. the Brussels and Lugano Conventions.*

*The request to create a Regional Division will have to specify a national court where
945 the Regional Division would be seated and would have to name at least two judges,
to be appointed as permanent members of the Regional Division, having each dealt
with in total at least 10 patent cases during the last three years. That would on the
one hand make sure that relevant local patent experience is used and maintained
and on the other hand prevent the creation of Regional Divisions dealing with
950 European patents that clearly are not equipped to do so. The requirement for
staffing a Regional Division has been lowered to such an extent that it should be
possible for every member state to have at least two judges complying with the
requirements at the end of the period of time that no doubt will pass between the
signing of the protocol and its getting into force. If member states do have more
955 experienced patent judges at their disposal and if they expect a lot of cases to be
dealt with at this regional division, they can of course propose a greater number of
judges than the minimally required number of two.*

*Member states will be able to pool with other member states and request the
creation of a Regional Division for their combined territories. They could wish to do
960 so if they do not wish to have specialised judges or because of other reasons, for
instance the enhancing of regional cooperation.*

*Moreover member states could simply decide not to participate in Regional
Divisions at all but have all cases for their territories handled by the Central
Division of EPC1.*

*965 Some member states would probably wish to create more than one regional division
because of the amount of patent litigation taking place there. Although this wish
seems to meet resistance in the framework of the creation of a European Community
patent, where the European Commission (according to informal oral information)
970 seems to take the view that there should be a maximum of one regional division of
the European Intellectual Property Court to be created, nevertheless this possibility
is opened by this third text proposal.*

*If a state or a regional division has had more than 100 cases concerning European
patents a year for the last three years, the creation of a further regional division can
975 be requested. To avoid preponderance of certain legal cultures above others
however a maximum of three regional divisions per member state was suggested and
is implemented in this proposal.*

*To ensure the quality of the jurisdiction of a regional division it does seem desirable
to require the same minimal standards of experience as described above.*

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980

As to the allocation of cases, the basic idea behind the proposal is that cases will be assigned to a Regional Division that has territorial jurisdiction but that that assignment will be final without endless disputes about territorial jurisdiction.

985

Questions to be resolved:

1. the composition of the panels of the Regional Divisions

2. the route of assigning cases to the divisions

3. the language regime.

4. conserving the rights of the plaintiff to choose between the forum of the defendant and the forum of the infringement.

990

Ad 1: composition of the panels of the Regional Divisions.

995

There was clear preponderance of the idea that all cases should be treated in the same manner and that this should be done by internationally composed panels.

If the rapporteur should preferably be local that then means that the chairman should come from elsewhere. That did not seem to cause any problems with the delegations in the subgroup and they preferred this solution to either having the

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function of chairman and rapporteur combined in one person or to have a rapporteur that would not take part in the decision about the case but would step back as soon as the case was ready for oral proceedings and leave the decision in the case to a fresh panel.

1005

The composition of a panel should be done in such a way as to exclude any discretionary power of some authority, so as to safeguard the German constitutional principle of the "Gesetzlicher Richter".

Of course the composition of internationally composed panels is not a simple matter, even if one would abstain from the language matter. It is nevertheless not impossible as is shown by an example of a model for such a procedure in Annex IV. Of course other ways should be possible. The only purpose of Annex IV. is to show that we are not dealing with a problem that cannot be solved.

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Ad 2: Assignment of cases to the divisions.

1015

Two possible options were discussed:

I. either all cases are brought before the Central Division and allocated by that Division to the competent (Regional) Division

II. or a case is brought by the plaintiff directly before the division that has, in his opinion, territorial jurisdiction and that division has to decide over its jurisdiction and possibly to refer the case to another division.

1020

Whatever solution is chosen, it should be a solution in which there is no place for extensive debates just on the territorial jurisdiction of a certain division of EPCI: the energy of the parties and the court should go into the debate about the real dispute between the parties and not in squabbles about territorial jurisdiction.

1025

Therefore the decision which division is to handle the case should be taken just on the basis of the facts mentioned in the statement of claim, without debate and

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1030 *without a separate appeal, just on the basis of the (widely accepted) rules as
incorporated in EU Regulation 44/2001 and the Brussels and Lugano Conventions.
If the facts mentioned in the statement of claim should turn out to be fabricated so as
to manipulate the assignment of the case, there could be a sanction of costs to be
awarded to the defendant that is forced to litigate before the “wrong” division in
first instance and there could be redress in the appeal phase too.*

1035 *Therefore the decision of the Central Division in the first option or that of a
Regional Division in the second option should be final and binding, both on the
parties and on the division designated for the case.*

*That taken into consideration text proposal 2 originally opted for a central filing of
new cases because of the following reasons:*

1040 *1. It facilitates the central administration of cases and therefore*

*2. The check whether associated proceedings about the same patent are perhaps
already pending (which is important for two reasons:*

A. to prevent double litigation and

1045 *B. to enable the consolidated treatment of connected proceedings as
meant in art. 28-2 of Regulation 44/2001, resp. art. 22-2 of the Brussels and Lugano
Conventions;*

*3. It facilitates the homogeneous application of the rules about jurisdiction, which
will need harmonisation because it seems only right to maintain the choice of forum
given to the plaintiff by artt. 5 and 6 of Regulation 44/2001 and the conventions of
Brussels and Lugano, see infra;*

1050 *4. It will probably be more acceptable for a Regional Division to be bound by a
decision about its jurisdiction if that decision comes from a central instance,
composed of different nationalities, than when it comes from a Regional Division
which could be suspected of trying to send difficult cases away, especially if that
Regional Division should comprise only national judges.*

1055 *5. It will be easier to implement one uniform way of filing procedures and to check
the formalities thereof,*

*6. It can alleviate fears of one Regional Division that another Regional Division is
taking too much or too little jurisdiction;*

1060 *7. It creates a uniform way of filing cases and does not make it necessary to have
some cases filed at a central level and others at a regional level.*

1065 *A possible setback in this option could however be that it would take longer to get a
case before the competent division. (That setback could be reduced however by
setting a strict time limit: there is no reason why the Central Division should not be
able to allocate a new case within e.g. seven working days. A possible sanction here
could be an obligation of the EPJ to retribute the court fee if the time limit on this
point is not respected.)*

⁷ An appeal could be possible together with the appeal against the final decision at first instance.

⁸ Every deviation of the formal rules of Regulation 44/2001 enlarges the risk that the protocol will be decided to be in conflict with the AETR-jurisprudence of the Court of Justice.

⁹ This disadvantage could possibly be taken care of if, in the second option, a Regional Division, that is of the opinion that another Division is competent, should send the case not to that other Regional Division but to the Central Division and have that Central Division decide what Division should handle the case.

A third option in this case could be that, in all cases where a Regional Division has decided it has no territorial competence, the case automatically should fall to the Central Division and remain there.

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1070 *However as a result of the hearing of national experts on procedural law the
proposal ultimately shifted to a regional filing of new cases.
The idea as worded now is that a new case can be filed everywhere: at the central
registry or at any sub registry, whereby the statement of claim will have to state
1075 what (regional) division in the opinion of the plaintiff will have to deal with the case
and on the basis of what legal provision that division should get the case.*

*The receiving registry will check whether the statement of claim complies with the
formal requirements.*

1080 *If not it will request the counsel of the plaintiff to remedy the defects.
If yes it will register and date stamp the claim and send it to the (sub)registry of the
indicated division.*

1085 *That division will classify the case both as regards financial importance (with
consequences for the court fee to be paid and the costs to be paid by the losing party
to the winning party) and as regards the technical field involved.*

*If the indicated division feels it has been indicated erroneously and the
case should go to another division, it will send the case to the President of EPCI
who will decide the issue for that instance.*

1090 *As soon as the court fee has been paid a panel will be composed. This should be
done according to a schedule that ensures the international composition of the
panel, the presence of judges on the panel that all understand the language of the
1095 proceedings but does not leave any room for discretionary powers, so as to
safeguard the principle of the “gesetzlicher Richter” that is of importance especially
for Germany.*

As mentioned earlier a possible example of such a schedule is attached as Annex IV.

1100 *In any case it seems recommendable that there should be a central register of cases
that is easily (electronically) accessible for all divisions of the court. It should be
possible to mention in this register for every case to what division it is allocated and
on the basis of which rule. (domicile of defendant, place of infringement, choice of
all parties, etc.)*

1105 *Moreover there should be a register of judges, where is registered in what cases
judges have been appointed as rapporteur, as chairman or as technical judge.*

ad 4: the language regime.

1110 *The basic idea as laid down in the EPC, to which treaty this protocol forms an
annex, is that a patent should be dealt with in its authentic text and in the language
in which it is granted. That system has proven itself to be quite workable, also before
the Opposition Divisions and the Boards of Appeal of the Office, and has not met
with serious problems during the past twenty years.*

*Therefore that idea should also in principle be applied in the EPJ, in any case for
the Central Divisions.*

1115 *For the regional divisions however it was felt to be the better solution to have only
one language of proceedings in each regional division and to determine that*

Protocol.

language more or less according to the lines set out in the Protocol on Cost Reduction.

1120

Because the Protocol on Cost Reduction aims to avoid translation of an already present text, its setting is however a little different from the language problem in proceedings where it is necessary to choose a language for proceedings still to come. See further for this problem and a proposed solution on page 64.

1125

Nevertheless, apart from the question what is to be the official language of the proceedings, another language could be used in certain proceedings if and as long as the court and all the parties do agree. That could for instance open up the possibility to deal in Swedish with a case before the Swedish regional division in which only Swedish parties were involved. As soon as not all parties and/or not all members of the panel do agree with the use of another language the proceedings will have to switch to the official procedural language for that division, in the case of Sweden probably English.

1130

1135

Probably that moment will come when the oral proceedings have to take place because it will hardly be possible to have panels comprising two foreign judges who understand the local language. At that moment the documents and pleadings will have to be translated, at least part of them. It could however also be envisaged that in certain cases the foreign judge would decide to comply with simultaneous translation by a court interpreter.

1140

It is proposed here that, if translation is necessary, translation into the language of the proceedings will be necessary of all those documents that the court wants to have translated. (If any party wants to translate more it will of course be free to do so.) It is further proposed in the Rules of Procedure (§ 13) that the court will decide who has to translate the required documents produced by the parties and who is to pay for the translation.

1145

The documents not produced by any of the parties (e.g. protocol of hearings of witnesses, reports of a court appointed expert, protocols of sessions) should be translated by the court services and be paid for by the EPJ (thereby compensating a little those countries that do not have an official language of the EPC as a national language).

1150

ad 5: Choice of plaintiff between domicile of defendant and place of infringement.

1155

To avoid as much as possible conflicts with the contents of EU Regulation 44/2001 and the Brussels and Lugano conventions, we should realise that the plaintiff has at present a right of choice of forum on the basis of art. 5-3 of the Regulation, resp. the Conventions. It is in the interest of harmonisation not to take away that right of the plaintiff. For the same reason the choice given to the plaintiff by art. 6 of the Regulation and the conventions should be respected, as well as the right of the parties to choose their common forum (art. 23/2 Regulation 44/2001 and art. 17/18 Conventions of Brussels and Lugano).

1160

This could be easily realised: the rules of procedure will foresee in the obligation of the plaintiff to use a certain form when filing a case. That form could easily contain a box in which the plaintiff should state what division he wants the case decided and

1165

Protocol.

on the basis of what provision that division does, in his view, have territorial competence.

1170 *As regards proceedings for revocation of a patent neither the Regulation nor the*
conventions give the plaintiff any choice. It could be imagined to assign proceedings
for revocation that are not brought by way of counterclaim and that concern only
1175 *one state to the Regional Division for that state. Taking into account how relatively*
seldom it will occur that revocation proceedings are filed outside an infringement
dispute and taking into account the fear of industry for revocations by a “national”
court it seems better however to assign all cases for revocation of the patent – other
than brought by way of counterclaim – to the Central Division. As EPC1 is
designated as a national court in the sense of art.22-4 Regulation resp. art. 16-4 f
the Conventions, there is no formal conflict with these provisions.
1180 *Although it seems the better solution to bring unconnected revocation actions before*
the Central Division, it does not seem strictly necessary: wherever the case will be
decided, it will be decided by an internationally composed panel. Although,
weighing both alternatives, this proposal opts for adjudication of these unconnected
revocation actions by the Central Division, much importance should be given here
1185 *to the ideas of the users of the system.*

To avoid any misunderstandings: in those cases where there is no competent
Regional Division and the case is handled by the Central Division, the Rules of
Procedure will contain the rule – already present in the first proposal – that the
1190 *sessions of the Central Division will be held in the country of domicile of the (main)*
defendant. So those countries who are not requesting the creation of a Regional
Division do not have to fear that they put their nationals at a disadvantage in that
these nationals should have to travel abroad for their litigation: also these
defendants will be able to do their oral proceedings etc. “at home”.

1195

Structure EPC2

As regards EPC2, this court would not have Regional Divisions; all its
judges therefore would belong to the Central, and only, Division. As it is not clear
1200 *how much work the EPC2 will have, it seems not a good idea to oblige all members*
of EPC2 to be domiciled at the seat of the court: the judges of EPC2 should be able
to go on functioning on other courts, national courts and/or divisions of EPC1.
Nevertheless it seems that at last the President of EPC2 should be domiciled at the
seat of the court

1205

Chapter III.1 General provisions

Section III.1.1 Organizational aspects

1210 **Article 24 Organs of the EPJ**

The European Patent Judiciary will comprise:

- an Administrative Committee
- an Executive Committee
- the European Patent Court of First Instance (EPC1)
- 1215 - the European Patent Appeals Court (EPC2)
- a Registry.

Protocol.

Article 25 Legal personality of the EPJ

1220 The EPJ, EPC1 and EPC2 will have legal personality in the broadest sense in all EPJ states. The EPJ will be represented by the President of EPC2 and the Registrar together, unless the Administrative Committee has empowered one of them to bind the EPJ on certain subject matters. The courts will be represented by their respective presidents.

1225 **Article 26 National courts designated.**

1. Every EPJ-state will designate at least one of its national courts to provide the EPJ with facilities in case a EPJ court wishes to conduct parts of proceedings in that state.

1230 2. The registry of the designated national courts will function as regional sub registries of the EPJ.

3. The designated courts at the time of signing of this protocol will be mentioned in Annex III. to this protocol.

1235 4. Any change in this designation will be communicated by the Ministry of Justice of the EPJ state concerned to the Registry of the EPJ, stating the date from which the change will take effect. This communication will have to be done at least three months before the change is taking effect.

1240 *It is felt that there should be sub registries also in countries that do not have a Regional Division of EPC1; the Registry is not a part of EPJ1 but of the EPJ as such and there should be possibilities for filing documents in every member state.*

Section III.1.2 Financial Provisions.

1245 *Up till now little or no attention was paid to the financing of the EPJ. As the text for a protocol is approaching a more final form, this subject matter cannot longer be neglected.*

WPL 9/99, the basis of the prolonged mandate of the working party, as put before the Intergovernmental Conference of October 2000 in London states:

1250 *“The expenditure of the European patent Court should be fully covered by the court’s own resources, i.e. court fees, and by financial contributions from the EPLP states (see art. 10 CPC Protocol on Litigation). In the long term however, the court should cover its expenditures by its own resources exclusively.”*

As the protocol on litigation is an accessory to the EPC, it seems best to follow the financial provisions of the EPC as far as possible.

1255 **Article 27 Sources of income.**

The expenditure of the EPJ shall be covered by its own resources and where necessary by contributions made by the EPJ states.

1260 *See art. 37 EPC.*

Article 28 Own resources.

The own resources of the EPJ shall be the court fees levied according to Article 44 juncto Article 130 and also all receipts, whatever their nature.

1265

Protocol.

See art. 38 EPC.

Article 29 Accounting period.

1270

The accounting period of the EPJ shall commence on 1 January and shall end on 31 December.

See art. 45 EPC.

Article 30 Financial regulations.

1275

Financial Regulations shall be drawn up by the Administrative Committee and shall in particular establish:

(a) the procedure relating to the establishment and implementation of the budget and for the rendering and auditing of accounts;

1280

(b) the method and procedure whereby the payments and contributions provided for in Article 32 and the advances provided for in Article 33 are to be made available to the EPJ by the EPJ states;

(c) the rules concerning the responsibilities of accounting and paying officers and the arrangements for their supervision;

1285

(d) the composition of and the duties to be assigned to a Budget and Finance Committee if this should be set up by the Administrative Committee.

See art. 50 EPC.

Article 31 Preparation and adoption of the budget.

1290

1. The Executive Committee shall lay the draft budget for the EPJ before the Administrative Committee not later than the date prescribed in the Financial Regulations.

2. The budget and any amending or supplementary budget shall be adopted by the Administrative Committee.

1295

See art. 46 EPC.

Article 32 Special contributions of EPJ states.

1300

1. The court fees of the EPC1 and EPC2 shall be fixed at such a level as to ensure that the revenue in respect thereof is sufficient for the budget of the EPJ to be balanced.

2. However if the EPJ is unable to balance its budget for a certain accounting period the EPJ states shall remit to the EPJ special financial contributions, the amount of which shall be determined by the Administrative Committee for the accounting period in question.

1305

3. These special financial contributions shall be determined in respect of any EPJ state on the basis of the granted European patents during the last but one year and the two years preceding that year in which that EPJ state was designated in the ratio to all EPJ-state designations in those years.

1310

Article 20 of the CPC contained a fixed scale for the distribution of the costs:

Belgium 5,25 %

Denmark 5,20 %

1315

Germany 20,40 %

Protocol.

Greece 4,40 %
Spain 6,30 %
France 12,80 %
Ireland 3,45 %
Italy 7,00 %
Luxemburg 3,00 %
Netherlands 11,80 %
Portugal 3,50 %
United Kingdom 16,90 %

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1325

This scale however not only applied to costs but also to the distribution of the benefits from applications. Therefore it is probably not automatically applicable to a situation where only costs are dealt with.

1330

In this proposal the suggestion is made to take the mean ratio of designations as the determining factor: it is felt that the rate in which a member state is designated in European patents is a fair measure of the "risk" it brings for proceedings regarding patents, be it for infringement or for validity. To avoid a too large influence of accidental fluctuations, there is suggested a mean of three years. To enable the Administrative Committee to have the figures at its disposal the last year is left out and calculations start at the last year but one.

1335

Article 33 Advances.

1. At the request of the Executive Committee the EPJ states shall make advances to the EPJ, on account of their contributions, within the limit of the amount fixed by the Administrative Committee.

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2. Such advances shall be apportioned in proportion to the amounts due by the EPJ states for the accounting period in question.

See art. 41 EPC.

1345

Article 34 Budget.

1. Income and expenditure of the EPJ, its courts and its registry shall form the subject of estimates in respect of each accounting period and shall be shown in the budget of the EPJ. 2. If necessary there may be amending or supplementary budgets. 3. The budget shall be balanced as between expenditure and income and shall be drawn up in Euro's.

1350

See art. 42 EPC.

1355

Article 35 Provisional budget.

1. If, at the beginning of the accounting period, the budget has not been adopted by the Administrative Committee, expenditures may be effected on a monthly basis per heading or other division of the budget, according to the provisions of the Financial Regulations, up to one-twelfth of the budget appropriations for the preceding accounting period, provided that the appropriations thus made available to the Executive Committee shall not exceed one-twelfth of those provided for in the draft budget.

1360

2. The Administrative Committee may, subject to the observance of the other provisions laid down in paragraph one, authorise expenditure in excess of one-twelfth of the appropriations.

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Protocol.

3. The EPJ states shall pay each month, on a provisional basis and in accordance with the amounts fixed according to Article 33 any special financial contributions necessary to ensure implementation of the paragraphs (1) and (2) above.

1370 *See art. 47 EPC.*

Article 36 Authorisation for expenditure.

1375 1. The expenditure entered in the budget shall be authorised for the duration of one accounting period, unless any provision to the contrary are contained in the Financial Regulations.

2. Subject to the conditions to be laid down in the Financial Regulations, any appropriations, other than those relating to staff costs, which are unexpended at the end of the accounting period may be carried forward, but not beyond the end of the following accounting period.

1380 3. Appropriations shall be set out under different headings according to type and purpose of the expenditure and subdivided, as far as necessary, in accordance with the Financial Regulations.

Article 37 Budget implementation.

1385 1. The President of EPC2, the President of EPC1 and the Registrar shall implement the budget and any amending or supplementary budget on his own responsibility and within the limits of the allocated appropriations.

1390 2. Within the budget, the Executive Committee may, subject to the limitations laid down in the Financial Regulations, transfer funds as between the various headings or subheadings.

See art. 48 EPC.

Article 38 Auditing.

1395 1. The income and expenditure account and a balance sheet of the EPJ, the Courts and the Registry shall be examined by auditors whose independence is beyond doubt, appointed and if necessary dismissed by the Administrative Committee.

1400 2. The audit, which shall be based on vouchers and shall take place, if necessary, in situ, shall ascertain that all income has been received and all expenditures effected in a lawful and proper manner and that the financial management is sound. The auditors shall draw up a report after the end of each accounting period.

1405 3. The Executive Committee shall annually submit to the Administrative Committee the accounts of the preceding accounting period and a balance sheet showing the assets and liabilities of the EPJ, the Courts and the registry, together with the report of the auditors.

1410 4. The Administrative Committee shall approve the annual accounts together with the report of the auditors and shall discharge the Executive Committee, the President of EPC2, the President of EPC1 and the Registrar in respect of the implementation of the budget.

See art. 49 EPC

Section III.1.3 Administrative Committee

1415 **Article 39 Composition and voting rights**

Protocol.

1. The Administrative Committee will be the highest administrative organ of the EPJ and it will be formed by the representatives and alternate representatives of the EPJ states. It will abstain from influencing the jurisprudence and/or the independency of the courts and its judges.

1420 2. Every EPJ state will have the right to appoint one representative and one alternate representative.

3. Every EPJ state will have one vote.

4. Representatives of member states to the European Patent Convention, not being EPJ states, will on their request be admitted as observers.

1425 *See the general introduction at the head of this part and see art. 26 EPC.*

Article 40 Chair

1430 1. The Administrative Committee shall elect a Chairman and Deputy Chairman from among the representatives and alternate representatives of the EPJ states.

2. The Deputy Chairman shall ex officio replace the chairman in the event of his being prevented to attend to his duties.

3. The duration of the terms of office of the Chairman and the Deputy Chairman shall be three years. The terms of office shall be renewable.

1435 *See art. 27 EPC.*

Article 41 Meetings

1440 1. Meetings of the Administrative Committee shall be convened by its chairman.

2. The members of the Executive Committee or their representatives shall be invited and will have the right to be present and, without having voting rights, to take part in the deliberations.

1445 3. Meetings shall take place at least once a year. The Committee shall also convene on the initiative of the Chairman or if at least three member states or the Executive Committee request a meeting.

4. Deliberations shall be based on an agenda and shall be held according to the practice directions of the Administrative Committee.

1450 5. The provisional agenda shall contain any question whose inclusion is requested by any member state in accordance with the practice directions of the Administrative Committee.

6. The practice directions may allow the attendance of other observers than mentioned in Article 39 at some or all meetings of the Administrative Committee.

1455 *See Art. 29 and 30 EPC.*

Article 42 Practice directions.

The Administrative Committee shall adopt its own practice directions.

Article 43 Languages.

1460 1. The languages in use in the deliberations of and communications from the Administrative Committee shall be English, French and/or German.

2. Documents submitted to the Administrative Committee and the minutes of its deliberations shall be drawn up in one of the three languages mentioned in paragraph 1 unless the Administrative Committee or the practice directions determine otherwise.

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Protocol.

See Art. 31 EPC, but the possibility is created to diverge from this rule and, for instance, to use for certain ends or certain documents only one language. Furthermore it would seem sufficient if the papers are drawn up in just one of the official languages.

The term “and/or” is meant to make clear that all three languages can be used but that no translation can be required in the two other languages

Article 44 Tasks

1. The Administrative Committee will:

- determine the annual budget of the EPJ, the Courts and the Registry;
- determine a separate statute on service regulations the remuneration of the judges, both of those functioning full time and those functioning part of their time in the EPJ, of the Registrar and of the different classes of personnel working for the EPJ;
- execute the surveillance and control of the financial annual report of the Executive Committee and the discharge of the Executive Committee in this respect;
- appoint assessors to the Courts;

and, on a proposal of the enlarged Executive Committee:

- appoint and reappoint the judges and the registrar of the courts
- determine the practice directions of EPC1 and EPC2 and the regulations of the Registry as mentioned in Article 55 ;
- set the fees to be levied by the courts of the EPJ.

2. Furthermore the Administrative Committee shall on a request of a EPJ state or a group of EPJ states, complying with the requirements of this protocol, create a Regional Division of EPC1 and appoint and designate as far as necessary the first judges of that Division.

3. Finally it will perform other tasks assigned or left to it in this protocol or its implementing regulations.

The financing of the whole project has up till now hardly been discussed. As regards the salaries of the judges there will have to be fixed a salary in the relevant statute. That would solve the problem for those judges that are full time working for the EPJ.

What to do however about judges that are working part of their time for the EPJ and part of their time for their national court. A possible solution could be that such judges are paid their normal national salaries by the national governments as long as they are working at “home”. Only for the days that they are sitting elsewhere, on other divisions, would they be paid a daily salary according to the protocol instead of their normal national salary.

Article 45 Quorum and required majority

1. Valid decisions by the Administrative Committee can be taken when more than three quarters of all possible votes are present.

2. Decisions on fees and on financial contributions from member states to the EPJ must be taken unanimously, other decisions will be taken with a majority of two thirds of the possible valid votes present.

Protocol.

1515 *The combination of these two requirements make sure that any decision
is supported by at least more than 50% of the total of possible votes: $76\% \times 66\% = 50,2\%$.*

Section III.1.4 Executive Committee

1520

Article 46 Composition

1. The Executive Committee will be formed by the President of EPC2, the President of EPC1 and the Registrar, or their substitutes.

1525

2. Members of the presidium of each court can partake in the deliberations of the EC without having voting rights.

The EC should be a small and flexibly operating body. To bring in extra expertise and to avoid the idea of a too closed shop, it is suggested to give members of a presidium the right to attend if they wish to do so. If members of a presidium are regularly present it could facilitate them functioning as a representative of "their" president when he is unable to attend a meeting in person.

1530

Article 47 Quorum and majority voting

1. Valid decisions can be taken only when all three members are present or represented.

1535

2. Decisions will be taken by a majority of votes.

With a three member committee it should not cause any problems for all three to be present, at least by their substitutes. It would be possible to stipulate that two members who are in agreement could take a decision, as they form the majority anyhow but it does not seem a good idea as the discussion aspect is missed and a discussion could turn the opinion of one of the members.

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Article 48 Tasks

The tasks of the Executive Committee are:

1545

- conducting the management of the courts and of the Registry in so far as this protocol or the Executive Committee itself does not delegate this management to the Presidium of the court concerned and/or to the Registrar;

- drawing up proposals to the Administrative Committee, having heard the Presidium of the court(s) concerned, concerning the number of judges, the fees of the courts and practice directions for the courts;

1550

- drawing up of proposals, in accordance with the provisions of Article 49 , for the appointment or non reappointment of judges;

- the issuing of rules for the Registry as mentioned in Section III.1.5Article 55 ;

1555

- the consolidation of the budget proposals of EPC2, EPC1 and the Registry and the presentation of this budget to the Administrative Committee;

- the issuing of an annual report and an annual financial report to the Administrative Committee.

1560

Article 49 Proposals for appointment of judges.

1. When drawing up a proposal for appointment of judges or of the Registrar, the Executive Committee will be extended with the members of the Presidium of the Court(s) concerned.

Protocol.

1565 2. A proposal for a judicial appointment or the appointment of a Registrar will, if possible contain a minimum of one candidate for every vacancy and preferably more than one.

1570 *During the meeting of the subgroup in July 2001 the wish was expressed to have a larger number of people involved in the drafting of proposals for appointments of judges. Because it was considered to involve an unbalance to involve here the national governments (who, in their role of members of the Administrative Committee, also decide on the proposals) in the drafting of the proposals, the solution was chosen to involve the members of the whole presidium. The presidium will on the one hand be in the best position to judge whether a certain candidate fulfils the requirements and will also be able to function in the setting of the court and on the other hand have an interest in avoiding appointments that are solely politically motivated. Also there was expressed the wish that a plurality of candidates should be mentioned. This is now formulated in the text, be it in a somewhat cautious way. We should not underestimate the risk of mentioning a plurality of candidates: some people will not apply for a function if there exists the risk that this application will be published while they are not on an “eligible” place. The provisions of Article 47 need not to be changed: the Presidium can only take decisions when the “normal” members are all three present but otherwise the decision can be taken by simple majority.*

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Article 50 Practice directions.

The Executive Committee will set up its own practice directions.

Article 51 Delegation of tasks

1590 The Executive Committee can delegate certain tasks to one of its members or to one or more judges of the courts, for such a time and under such conditions as it sees fit.

1595 *Especially as the management of the courts and the registry include many tasks that do not need the constant attention and cooperation of three high ranking members, it should be possible to delegate certain tasks. It is felt that the Executive Committee itself could best decide what and when to delegate. Such a delegation could also be feasible if the Executive Committee in its extended form and therefore including one or both presidiums, would become too large. (If there is a regional division in every member state the Presidium of EPC1, comprising all the divisional presidents, could become large indeed.)*

1600

Article 52 Languages.

Article 43 is applicable to the meetings of the EC.

1605 **Section III.1.5 Registry**

Article 53 Central registry and sub registries

1610 The Registry will comprise a Central Registry at the seat of the EPJ and regional sub registries, having their seats at the registries of the national courts as mentioned in Article 26 .

Much of the work of the Registry will be done at the Central Registry, at the seat of the courts. Nevertheless there should be a sub registry in every EPJ

Protocol.

1615 *state able to provide people with the necessary forms, give them information and*
receive applications and other documents to be filed. The sub registries will also
play an important role in organisational matters if the rapporteur or the whole
panel want to sit in that particular country. Moreover the sub registries could do a
lot of the practical work in the cases that are assigned to the Regional Divisions of
1620 *EPC1. Preferably these sub registries will be at the seat of these Regional Divisions*
but that is up to the member states.

Article 54 Function

1. The tasks of the Registry will be:

- 1625 - to provide administrative and secretarial assistance to both courts, including
the provision of clerks to act as recorders during sessions;
- to send communications of the courts to the parties and third persons;
- to keep a register of cases brought and pending before the courts;
- to keep a register of European patent counsel registered with the courts;
- to receive the fees payable to the courts and administer the courts' funds;
- 1630 - to manage the buildings and other material assets of the EPJ,
- to keep and safeguard the files of the cases pending or having ended before the
courts.

2. The registers of the Registry will be electronically accessible for the sub-
registries, the courts and its divisions.

1635

Article 55 Regulations and rules.

1. The Registry will work according to regulations set up by the Administrative
Committee on the proposal of the Executive Committee.

1640 2. The regulations will regulate the division of work between the central and
regional sub-registries in cases allocated to Regional Divisions of EPC1.

3. The regulations can leave certain subjects to be regulated in more detail in rules,
to be made by the Executive Committee on a proposal of the Registrar.

1645 *The main organisation should be set up by the Executive and*
Administrative Committees but details could be left to the people on the spot, who
should be able to react in a flexible way to all kinds of practical needs.

Article 56 Appointment of Registrar.

1650 1. The registrar will be appointed by the Administrative Committee on a joint
proposal of the Presidents of EPC1 and EPC2 and the members of the Presidiums of
those courts, containing at least one and if possible more candidates.

2. His term of office will be six years, after which term he will be reappointed unless
he does not want to be reappointed or there is a joint opinion of the presidents of
EPC1 and EPC2 that reappointment should not be considered.

1655 3. He can be removed from office by the Administrative Committee if both
presidents of EPC1 and EPC2, having heard their presidiums, put a proposal for his
removal before the Administrative Committee. In the event of the removal from
office of the Registrar the Administrative Committee will take such intermediary
measures are necessary until a new Registrar is appointed.

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It would also be possible to have the registrar appointed (and
dismissed) by the courts or their presidents. In that case he would be just a salaried
employee of the courts like every other. That would weaken his position in the

Protocol.

1665 *Executive Committee where he should have a position more or less comparable with
both presidents as in possible conflicts between these presidents he should have a
decisive voice. On the other hand if the registrar is clearly not functioning or cannot
function together with both his two presidents he should go and it should be possible
to get rid of him. The voice of the other judges should however be heard in the form
of a consultation of the presidiums. Otherwise the position of the presidents would
1670 be too strong in this respect.*

Article 57 Immunity of the Registrar.

1675 1. The Registrar shall be immune from legal proceedings. After he has ceased to
hold office, he shall continue to enjoy immunity in respect of acts performed by him
in his official capacity.
2. The EPC2, sitting in plenary session, may waive the immunity.
3. Where immunity has been waived and criminal proceedings are instituted against
a registrar or former registrar, he shall be tried, in any of the Member States, only by
the national court of highest instance.

1680 *See also Article 66 for a corresponding article about the judges of the courts.*

Article 58 Tasks of the Registrar.

The registrar will be responsible for:

1685 - the appointment and dismissal of employees of the central registry
- the further management of the registry, in as far as the Executive Committee
has not drawn this management to itself, and the coordination of the work with the
sub registries;
- the budgeting of the registry
1690 - the keeping of the registers prescribed by or under this protocol.
in general the due and efficient discharge of the tasks of the Registry.

Chapter III.2 the Courts.

Section III.2.1 The Courts in general

Article 59 Two courts

1700 The EPJ shall have two courts: the European Patent Court of First Instance (EPC1)
and the European Patent Appeals Court (EPC2).

Article 60 The Presidents.

1. The President of each court and his substitute will be elected by the judges of each
court for a term of three years from among the legal judges of that court.
2. The President can be re-elected once.
1705 3. He will be presiding the court and its Presidium.
4. If the votes in the Presidium should be tied, his will be the casting vote.

1710 *As in most international courts the Presidency is left to the choice of
the judges and is made rotational. That prevents too much political influence from
the governments on the courts and thereby enhances the independence of the courts.*

*It seems necessary to have a legal judge as president but there is of
course no reason to restrict the voting rights to the legal judges: although it could
be argued that many technical judges will be functioning only sporadically and*

Protocol.

1715 *therefore will not be able to know their colleagues well enough, that does not seem*
decisive as that could also be true for some legal judges. Moreover it is felt that a
judge who feels he does not know enough of the candidates will simply abstain from
voting. As the number of the Presidium, especially that of EPC1, will not necessarily
1720 *be an odd number, there should be a rule for cases where the votes should tie. In*
that case the President in this proposal will have the casting vote. Another option
could be to stipulate that in such a case the proposal would be deemed to be
rejected.

See also Article 181 for the first appointments.

Article 61 Presidium

- 1725 1. Each court shall have a presidium, consisting of its president, its divisional
presidents and two members, elected by the judges of the court.
2. The elected members of a presidium will be elected for a period of four years and
can be re-elected once.
3. One of the first elected members, to be designated by the drawing of lots, shall be
1730 elected for a period of two years.

The term of office of 4 years is of course rather arbitrary. The main
purpose of a term here should be to prevent the changes in the presidency being in
sync with those in the presidium. By avoiding such a synchronisation loss of
1735 *experience in the presidium should be kept to a minimum.*

Article 62 Tasks

1. The tasks of a Presidium will be:
- to assist the President of the court in his tasks and more especially: the yearly
1740 budget of the court and
- to assist in the work of the Executive Committee to unify this budget with
those of the other court and that of the Registry,
- to present its opinion to the Executive committee about possible proposals for
the courts' practice directions.
1745 - to advise the Executive Committee on the opinion of the court concerned as
regards appointments of judges to that court;
- to conduct the management of the court in so far as delegated to it by this
protocol or the Executive Committee, more especially the internal organisation of
1750 the court, especially timetables and rosters; the Presidium can delegate the daily
management wholly or in part to the President or, in so far as it concerns the
management of a Regional Division of EPC1, to the Divisional president of that
Regional Division.
2. The presidium of EPC1 shall moreover have to coordinate the work of the
different divisions of EPC1.

Section III.2.2 The Judges

Article 63 Legal and technical judges.

1760 EPC2 and EPC1 shall consist of a number of legal judges and a number of technical
judges.

See also Article 78 and Article 103 as regards the number of judges.

Protocol.

Article 64 Appointing authority

- 1765 1. The judges will be appointed by the Administrative Committee on a proposal from the Executive Committee, having heard Presidium of the court or courts concerned about the opinion of the members of those courts according to the practice directions of the courts..
- 1770 2. Apart from the first appointments as meant in Article 181 or from reappointments, the Executive Committee will for every vacancy publicly invite applications in the Official Journal of the EPO and such other ways as determined by its own practice directions.

See Article 181 for the first appointments.

- 1775 *It is not usual in all states that vacancies for judicial offices are publicly announced. It is felt however that nowadays the procedure for appointing judges should be as open and transparent as possible.*

Article 65 Term of office

- 1780 The judges will be appointed for a term of six years, save that half of the first judges appointed, to be determined by the drawing of lots, will have a first term of office of three years.

1785 *The ideal situation would be to have the judges appointed for life, as is the case in all or most European states. To avoid problems of uncertainty regarding future work load and/or problems when member states would be leaving the EPLP, the example of most international courts is followed, where judges have a term of office of a number of years.*

Article 66 Immunity of the judges.

- 1790 1. The judges shall be immune from legal proceedings. After they have ceased to hold office, they shall continue to enjoy immunity in respect of acts performed by them in their official capacity, including words spoken or written.
- 1795 2. The court of which they are a member, sitting in plenary session, may waive the immunity.
3. In case a judge is a member of both the EPC1 and the EPC2, the waiver proceedings will fall to the EPC2.
- 1800 4. Where immunity has been waived and criminal proceedings are instituted against a judge or a former judge, he shall be tried, in any of the Member States, only by the national court of highest instance.

See art. 3 Statute of the European Court of Justice.

1805 *The former article about an equitable distribution of nationalities and legal cultures (“The Administrative Committee and the Executive Committee will, without endangering the standard of quality and experience of the judiciary, ensure an equitable representation of the nationalities and legal cultures of the EPJ-states among the judges of the courts.”)*

- 1810 *was removed because some delegations did fear that this could give the impression that member states should have a right to a certain minimum of judges of their nationality appointed. In stead the Preamble to the EPLP now contains the sentence: “Realizing that such a judiciary should be of international composition with an equitable representation of the different legal cultures existing in Europe”.*

Protocol.

1815 **Article 67 Reappointment as a rule.**

1. Judges whose term of office has expired will be reappointed unless the Executive Committee proposes not to reappoint them, in which case the Administrative Committee will be free to reappoint such a judge or not.

1820 2. The Protocol on Privileges and Immunities of European Patent Judiciary shall give rules for a redundancy payment scheme for judges who are not reappointed and would not have full time employment as judges in their national court or otherwise.

1825 *Given the necessity of specialization of the judges of the European Patent Court, it would be a waste of human resources not to reappoint a judge who has been dealing with patent law for the past six years. On the other hand there should be some possibility to get rid of a judge who did not come up to expectations without cumbersome dismissal proceedings by simply not reappointing him. To avoid a judge from not being reappointed just because he is not popular with his colleagues, the final decision NOT to reappoint should rest with the Administrative Committee . To avoid preponderance of political influence the Administrative*

1830 *Committee should however have to reappoint a judge if his colleagues do think him fit to function. Therefore a decision not to reappoint a certain judge should always have to have its basis in a proposal of the Executive Committee .*

1835 *Some redundancy payment scheme seems necessary, especially for judges working full time for EPJ and especially if they had to move their domicile because of their appointment. Otherwise it could be very unattractive to participate as a judge in EPJ. Of course these redundancy payments would only be required for judges not having full time employment and only during a certain maximum time. The full time employment should not necessarily be at the same remuneration level as that of the*

1840 *EPJ but should be at the level of the national courts.*

Article 68 Requirements for office.

1845 Any person, having the nationality of one of the member states to the European Patent Convention and being in good command of at least one of the official languages of the EPC, may be appointed a judge of the court who

- a. is or has been a judge in one of the EPC-states and has sufficient experience in patent law
- b. is or has been a member of a Board of Appeal of the Office or a national Patent Office of one of the EPJ-states and has sufficient experience in patent law
- 1850 c. has otherwise, in the view of the Executive Committee, enough experience in patent and in procedural law to be able to perform the function of a judge of the court.

1855 *The European Patent Court will primarily have to consist of national judges experienced in patent law. The legal members of the Boards of Appeal can be considered as such.*

The Boards of Appeal, both of the Office and of the national patent offices, could be the best source for technical judges. The technical judges employed there have of course also the necessary experience in patent law.

1860 *Finally it should be possible to appoint as judges people who are not a judge in their own country but would doubtless qualify for that function if they would choose to do so (e.g. professors of patent law or experienced patent counsel, wishing to leave their practice and to opt for the bench) This provision also opens*

Protocol.

1865 *implicitly the possibility of appointing judges who – while being nationals of an EPC state - are not nationals of one of the EPJ states. This could not only make extra human resources available but could also be an important factor to spread the idea of the EPJ in non-EPJ states.*

1870 *Although at the moment it does not seem feasible to require knowledge, at least passively, of all three official languages – as is the case for the members of the Boards of Appeal of the Office – nevertheless there seems no point in having judges who do not have a good command of at least one of those languages: the language of the proceedings will nearly always be one of those languages.*

1875 *Some delegations have expressed reservations about appointing members of the Boards of Appeal of the Office as legal or technical judges, because they fear for their lack of impartiality. It is felt that only then the courts should have to do without the experience and expertise of these judges if art. 6-1 of the European Convention on Human Rights should raise problems in this respect. This convention does not*
1880 *seem to cause any problems in this respect. Delegations who feel otherwise are invited to present a legal foundation for this fear.*

Article 69 Assessors

- 1885 1. Any person who has insufficient experience in patent law but otherwise complies with the criteria set forth in Article 68 can be appointed as an assessor to the court.
2. Article 65 is applicable to assessors, be it that his appointment as an assessor will terminate automatically on the date that his appointment as a judge of the EPJ will come into effect.
- 1890 3. An assessor can be appointed as a supernumerary member of a panel sitting on a case before the court. He will partake in discussions and can assist the judge-rapporteur. He will have no vote as regards the decision in the case and he will not divulge the discussions during the deliberations in which he has taken part.

Article 70 Appointment of assessors.

- 1895 1. Assessors can be appointed by the Administrative Committee on the proposal of a member state.
2. A member state proposing an assessor for appointment will endeavour to give this assessor before and after his appointment as much training in patent litigation at a national court as possible.

1900 *See the paper WPL 9/99 p. 16:*

1905 *”Problems could arise if any of the states find that they are unable to provide judges with sufficient experience of patent law. The system must provide for some way of training in such cases. One possibility could be that such a state would appoint a judge as an “assessor” to the common courts. An assessor will be partaking in sessions and deliberations of the European courts as an extra member of the panel, having only an advisory vote. Also he could assist the rapporteur. The country nominating a judge as an assessor would have to enable him to acquire as much experience as possible in dealing with patent cases before national courts.*

1910 *After this training period, he could be appointed as a full EPJ judge.”*

The question must be answered who should decide whether a certain person (does not qualify as a judge but) could qualify as an assessor. The best option seems to be to have the assessors appointed by the Administrative Committee on a proposal of

Protocol.

1915 *the national governments. The question whether a certain assessor will be appointed as a full judge remains subject to the assessment of the Executive Committee who has to propose him for appointment as a judge. Also the moment of appointment as a judge is left to the Executive Committee, that clearly can be before the term of office of an assessor has been completed: an assessor that is assigned often to a panel will need far less than six years to gather the necessary experience.*

1920

Article 71 Legal judges and technical judges.

1. Judges will be appointed as legal judges or as technical judges.
2. Technical judges will be appointed as competent for cases concerning such technical categories as the Administrative Committee decides.
- 1925 3. The decision in which a judge is appointed will state for legal judges the court(s) he is appointed on and for technical judges the technical categories he is appointed for. The term of office and the seniority of a judge will be calculated from that date.

1930 *It seems a good idea to mention in the appointment decision for which field a technical judge will be competent. That prevents chemists having to decide upon electronic cases, in which case their technical background would not bring very much. On the other hand over-specialization should be prevented by keeping the technical fields broad enough.*

1935 *Too large a degree of specialization would tempt the technical judge to start acting as a technical expert instead of as a judge. The function of a technical judge would definitely not be to act as an expert but – apart of course from partaking in the decision – to translate technical matters to his colleagues and to point out possible technical pitfalls.*

1940 *The definition of the technical fields is however best left to the Administrative Committee: it is hard to foresee now what categories of technique will be important and which not.*

Article 72 Seniority.

- 1945 1. Judges shall rank in precedence according to their seniority in office in the court concerned.
2. Where there is equal seniority in office, precedence shall be determined by age.
3. Judges who are reappointed shall retain their former precedence.

1950 *See art. 6 Rules of Procedure of the European Court of Justice.*

Article 73 Incompatibility of other functions.

1955 *Judges of the EPJ will, apart from being a member of a national or European court, a national patent office or the Office, not hold any other gainful occupation unless authorised by the Executive Committee. Neither will they occupy any political or administrative office.*

1960 *See Art. 3 Protocol on the Statute of the Common Appeal Court. It is left possible however that judges function at the same time at both their national court and one or both of the European Patent Courts. In deviation of the first proposal the authorisation is shifted from the Administrative Committee to the Executive Committee. It has more to do with judicial independency than with administrative problems, so the Administrative Committee is less well equipped to deal with this matter than is the Executive Committee.*

Protocol.

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Article 74 Oath

Before taking up his office each judge shall, in open court, take an oath to perform his duties impartially and conscientiously.

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See Art. 3 Protocol on the Statute of the Common Appeal Court .This COPAC protocol also mentions the preserving of the secrecy of the deliberations: that however seems hardly reconcilable with the possibility of dissenting and concurring opinions as opened by Article 153 .

1975

Article 75 End of office

1. Apart from expiration of the time limit for which he is appointed or from death, the office of a judge ends when he resigns, on the last day of the month in which he reaches his 70th birthday or when he is deprived of his office.

2. The retirement age can be changed by decision of the Administrative Committee but such a change will only affect judges first appointed after that decision.

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See Art. 4 Protocol on the Statute of the Common Appeal Court. The proposed retirement age is rather arbitrary. Some countries do not know a formal retirement age, others fix retirement at 70 or 65. Also in view of the scarceness of human resources 70 seems to be a reasonable compromise. Nevertheless it is possible that opinions in society change on this subject and in that case it should be possible to alter the retirement age, without however endangering the legal position of judges who have accepted an appointment in the expectation to be able to function till a certain age.

1985

1990

Article 76 Deprivation of office

1. A judge may be deprived of his office if, in the opinion of a three quarters majority of his court, he no longer fulfils the requisite conditions or meets the obligations arising from his office.

1995

2. The initiative in respect of proceedings to that end, further to be detailed in the practice directions of the courts, shall lie with the Executive Committee and the Administrative Committee will be notified of any decision of a court to deprive a judge of his office.

3. In case of a decision depriving a judge of his office, a vacancy shall arise on the bench upon the notification of this decision to the Administrative Committee.

2000

See Art 5 Protocol on the Statute of the Common Appeal Court. It does not seem the ideal solution to have colleagues deciding about the deprivation of office. There seems however no authority in existence with enough impartiality towards the judiciary on the one hand and enough know how about the behaviour of certain judges on the other hand. As deprivation of office is thought of as an ultimum remedium, necessary in case a judge cannot even be maintained until his next (non)reappointment, this inherent flaw seems unavoidable.

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2010

Article 77 Replacement appointments

A judge who is to replace a member of a court whose term of office has not expired shall be appointed for a full term of six years, regardless of the remaining term of office of his predecessor.

Protocol.

2015 *See Art 6 Protocol On The Statute Of The Common Appeal Court,*
regulating this matter differently. However, in a court with as many members as the
EPJ will probably need, there will hardly be a problem of disturbance of the
rotational reappointment schedule. On the other hand it could be difficult to find a
judge willing to accept an appointment for a relatively short term, especially if that
appointment would possibly necessitate moving his domicile.

2020

Section III.2.3 The European Patent Court of First Instance.

2025 *See the general explanatory notes on page 17 as regards the matter of*
the Regional Divisions of the court of first instance. This provisional text is based
on the ideas as developed during the meeting of the subgroup at The Hague in July
2001 as further discussed in the general explanatory notes on page 17.

Subsection 2.3.1 Organisation, Central and Regional Divisions.

2030 **Article 78 Number of judges.**

The number of legal and technical judges to be appointed on EPC1 shall be determined by the Administrative Committee. The Executive Committee may make proposals on this subject.

2035 *It is nearly impossible to make anything better than an educated guess how many judges will be needed.*

2040 *If we assume that 800 cases per year will be brought before the EPC1 and if we assume that a case will cost a rapporteur on average 8 days to handle a case and that it will cost the other judges on average 2.5 days (including a day travelling) then we will need (taking into account 10% loss of time because of illness etc. and 220 working days per year) 52 judges. Two thirds of these will be lawyers. therefore a probable requirement of 35 experienced lawyers does not seem exaggerated. See also the note at Article 103 for the second instance.*

2045 **Article 79 Central and Regional Divisions.**

EPC1 shall comprise a Central Division and may comprise one or more Regional Divisions.

2050 **Article 80 Central Division**

There will be a Central Division at the seat of EPC1.

Article 81 Regional Divisions.

2055 1. Every EPJ state or group of EPJ states can request, in accordance with this protocol, the creation of at least one Regional Division of EPC1 for their territory or territories.

2060 2. The request for the creation of a regional division is to be directed to the Administrative Committee and will have to state the seat of a national court that will be the seat of the Regional Division and the names of at least two judges of that court, experienced in patent law, who can be appointed – in as far as that is not already done – as legal judges of EPC1 and can be assigned as permanent members to the Regional Division to be created.

3. It will moreover state the registry of what court is instructed to act as sub registry of EPJ and will name the person responsible for the work of the sub registry.

Protocol.

2065 4. Judges will be deemed to be experienced in patent law in the sense of this article if they have actively taken part in at least a total of 10 patent cases concerning European patents in the course of the last three years.

2070 5. The request for the creation of a Regional Division will be accompanied by written statements of the judges concerned, stating that they comply with this requirement and that they are willing to accept an appointment as legal judge of EPC1 and a designation as permanent member of the Regional Division requested.

2075 6. A copy of the request shall be sent by the requesting state or states to the Executive Committee with the request to propose the judges concerned for appointment as judges of EPC1 if such appointment has not already been made. The Executive Committee will make such a proposal unless there is clear evidence that a judge concerned does not comply with the requirements of paragraph 4 of this article.

2080 *As the world of patent law is relatively small and most participants know each other more or less, it seems sufficient to require a statement of the judge concerned that he has dealt with the required number of cases. The required minimal experience is rather low but enough to warrant a certain knowledge of patent law. On the other hand it will be possible for any country to train the necessary number of judges in the time between the signing of the protocol and the coming into force. Because the right of proposal lies with the Executive Committee there has to be a*

2085 *synchronisation with that body. That is realised here by the obligation of the requesting state to send at the same time a request for a proposal of the judges concerned (if they are not already members of EPC1) for appointment. To avoid the risk that the right to a Regional Division could be made fictitious, the discretion of the Executive Committee is confined here.*

2090

Article 82 Further regional division.

2095 1. If, during three successive years, the courts, or a Regional Division, in a EPJ state or a group of EPJ states have dealt with more than 100 cases concerning European patents a year, the Administrative Committee shall on request of such a state or group of states create a further Regional Division of EPJ1 for that state or group of states, to a maximum of three Regional Divisions for any member state.

2100 2. Article 81 will be analogously applicable to such a request for a further Regional Division, that will moreover have to state the number of patent cases as meant in paragraph 1 of this article during each of the past three years. Moreover this request will have to state the territorial jurisdiction of the Regional Divisions in that state or group of states.

2105 *One could imagine that the territories of several regional divisions could be overlapping but that does not seem to be advisable as it would create a further possible source of dispute about the question whether this protocol deviated from EU Regulation 44/2001.*

Article 83 Number of judges.

2110 1. The decision to create a Regional Division will specify the number of legal judges who will be permanently designated to that chamber.

2. The Presidium of EPC1 can change this number, in case of a diminution below the original number however only with the assent of the Administrative Committee.

Protocol.

2115 *If a division needs more judges, it can be left to the presidium to allocate the available judges, the total number of whom is decided upon by the Administrative Committee. It seems however desirable to have a decision of the presidium to diminish a certain division below the number originally fixed by the Administrative Committee checked by that Administrative Committee.*

2120 **Article 84 Discontinuance of a regional division.**

1. The Administrative Committee, having heard the Presidium of EPC1, may decide unanimously to discontinue a Regional Division of EPC1.
2. The decision to discontinue a Regional Division will state after which date no new cases will be assigned to the Regional Division concerned and at which date the
2125 Regional Division will cease to exist.
3. From this latter date on the judges designated as permanent members to the Regional Division concerned will be designated as members of the Central Division and cases still pending before the Regional Division concerned will be transferred, without a change in the appointed panel, to the Central Division.

2130 *Although it is not very probable that a Regional Division, once created, will become superfluous, nevertheless for the sake of completeness there should be a possibility to discontinue regional divisions for which there is no need.*

2135 **Article 85 Publication of decisions regarding regional divisions.**

The Registrar will publish decisions of the Administrative Committee to create or to discontinue Regional Divisions in the Official Journal of the Office and in such further ways as ordered in these decisions.

2140 *It seems essential that the public, and especially the patent bar, knows where Regional Divisions are created or discontinued and what is their territorial competence.*

Article 86 Designation of judges.

- 2145 1. The Presidium of EPC1 can designate legal judges as permanent members of a Regional Division. The designation will only be perfect after it has been accepted by the judge concerned.
2. A judge who, notwithstanding his request, is not designated to a certain Regional Division, can apply for redress to the Executive Committee, who will decide after
2150 having heard the judge and a representative of the Presidium of EPC1.
3. Permanently assigned to the Central Division are all technical judges and those legal judges that are not permanently assigned to a Regional Division.
4. Judges can be assigned as a permanent member to only one division but shall be ex officio temporary member of all other divisions.

2155 *Although it should be superfluous in a normally functioning court, this provision makes sure that a judge cannot be assigned as a permanent member to a certain regional division without his consent: such an assignment would imply that he had to sit on a lot of cases in that Division and it would not do, for instance, to assign a
2160 member of the Regional Division at Stockholm to the Division at Zurich, without his consent. A legal judge not accepting an assignment to a Regional Division would automatically be a permanent member of the Central Division and could be employed everywhere. Some kind of redress of designation decisions of the*

Protocol.

2165 *Presidium of EPC1 is provided for but it should be realised that in the Executive*
Committee the President of EPC1, also presiding the Presidium of EPC1, has one of
the votes. Therefore probably only very unreasonable decisions of EPC1 will be set
aside: it will need unanimity of the two other members of the Executive Committee.
2170 *Nevertheless that seems at first sight preferable to having the Administrative*
Committee decide such a matter, directly influencing the allocation of a certain
judge and, therefore, possibly his impartiality.

Article 87 Divisional presidents.

- 2175 1. The Presidium of EPC1 will, having heard the permanent members of that
Regional Division, appoint one of the members of the Regional Division to preside
that division and his substitute.
2. This member will have the title of divisional president of EPC1 and will ex officio
be a member of the Presidium of EPC1 except when that presidium has to deliberate
and decide about the re-appointment or cancellation of the appointment of this
divisional president.
- 2180 3. An appointment as divisional president or his substitute will take place for a term
of six years, barring an earlier cancellation of this appointment by unanimous
decision of the presidium of EPC1 or earlier retirement. Reappointment will be
possible.
- 2185 4. His substitute will be referred to as acting divisional president of EPC1 and will
ex officio represent him in case he is not able to fulfil his duties.

Article 88 Function of divisional president.

2190 The divisional president of EPC1 will perform the functions of the president of
EPC1 as far as it concerns the Regional Division he is presiding and the cases
pending before that division.

*For the day to day business the Divisional President will be acting as the President
of a court.*

2195

Article 89 Attribution of cases.

- 2200 Cases will, on the basis of the provisions given in the Rules of Procedure, be dealt
with by a Division of EPC1 (further: the competent division) on the basis of the facts
stated in the statement of claim and according to the following rules and taking into
account that for the application of this article, where it refers to the Brussels and
Lugano Conventions resp. the EU Regulation 44/2001, the territory of the Central
Division will be formed by all EPJ states:
- if the claim is solely for the revocation of one or more parts of a European
patent or a declaration of right in that respect: by the Central Division;
 - 2205 - if the plaintiff has rightly requested the adjudication by the Central Division or
a certain Regional Division on the basis of art. 5 (3), art 6, art. 23 or art. 24 of the
Jurisdiction Regulation and/or the articles 5 (3), 6, 17 or 18 of the Conventions of
Brussels and Lugano: by the Division requested;
 - otherwise by the Regional Division in whose territory the (main) defendant is
2210 domiciled;
 - if there is no such Regional Division: by the Central Division.

Article 90 Attribution by President of EPC1 in case of dispute.

Protocol.

2215 1. If the Division to which a case is attributed finds that it is not the competent
division on the basis of the facts stated in the statement of claim, it will send the case
to the President of EPC1, who will attribute the case to a division according to the
rules laid down in Article 89 .

2. His decision in this respect will be binding upon that division and, for the first
instance, upon the parties.

2220 3. The attribution decision of the President of EPC1 can be challenged in appeal
according to the Rules of Procedure. If EPC2 finds that the attribution decision has
been wrong it has discretion to order a retrial of the case or not.

Article 91 Consequences of incorrectly or misleadingly stated facts.

2225 If the competent Division finds that the facts in the statement of claim, on the basis
of which the case was assigned, have been stated incorrectly or misleadingly, the
Division can, after having heard him on this subject, order the plaintiff to pay those
costs of the defendant(s) caused by that miss-assignment of the case, irrespective of
the outcome of the case.

2230 *As EPC1 is one undivided court, although having regional divisions, this is in
principle not a matter of jurisdiction but rather one of distribution of work.
Therefore it is dealt with at this place and not in the subsection dealing with
jurisdiction.*

2235 *It can be imagined that, even when the allocation decision of the President of EPC1
has been wrong, it will not often be a reason for a retrial. Nevertheless there should
be such a possibility as an ultimum remedium if the President of EPC1 should
constantly refuse to take into account the decisions of EPC2 about e.g. the
2240 application of the articles 5 and 6 of the Jurisdiction Regulation and the
Conventions of Brussels and Lugano.*

2245 *On the other hand, as the allocation decision has to be taken quickly and just on the
basis of the facts stated in the statement of claim, there has to be a possibility to
bring the extra costs, caused by a wrong assignment decision because of a
misstatement of the facts, to the account of the plaintiff. The question on which
moment the allocation decision should be open to appeal (immediately or only
together with the final decision in first instance) is delegated to the rules of
procedure. On the one hand abuse of the appeal proceedings to gain time should be
avoided and on the other hand there probably should be a possibility of redress if it
2250 would be really important (however that will probably only be in very few cases: all
Regional Divisions will be sitting in an international composition, so the question of
allocation of a case with a certain division will probably only be a matter of costs).
The best solution seems to be to postpone appeals on this subject matter to the
appeal against the final decision but to enable parties to get leave to appeal earlier
2255 from either EPC1 or EPC2. To leave the detailed regulation to the rules of
procedure ensures the desirable flexibility to adapt these rules to the needs of the
practice.*

Article 92 Sub-registry.

2260 The practice directions of EPC1 can determine that and in how far a case, attributed
to a Regional Division will be administrated and registered at the sub-registry in the
country of the seat of that Regional Division.

Article 93 Rotation of legal judges

Protocol.

- 2265 1. Legal judges of the Regional Divisions can be assigned to the Central Division for a period of at least six months.
- 2270 2. The schedule of rotation will be determined by the Presidium of EPC1, having heard the judges of the Regional Divisions concerned and the national courts they belong to, at least a year before the schedule coming into effect. Short term alterations in this schedule because of unforeseen circumstances can only be adopted with the consent of the judges and the national courts concerned.

2275 *Otherwise than in the first proposal the rotation of the judges is not proposed as obligatory any more but it is left to the discussion between the judges, the national courts and EPC1. It is trusted that the importance of the communication between the Central Division and the Regional to maintain EPC1 as a coherent organisation will be realised by all parties concerned.*

2280 *The schedule of rotation seems also to be a subject for discussion among the interested parties concerned. It is predictable that deviations from the fixed schedule will prove necessary because of e.g. illness etc. In that case it would not be reasonable to force such short term changes on people or organizations who are not prepared to accept them.*

2285 **Article 94 Residence**

1. The legal judges that are permanent members of a Regional Division will reside at the seat of that Division if they are not exempted from this obligation by the Executive Committee .
- 2290 2. Legal judges that are designated as permanent members of the Central Division will only be obliged to reside at the seat of that Division if the decision in which they are appointed so states and the Executive Committee has not exempted them from this obligation.

2295 **Article 95 Technical judges**

Technical judges will not have to take residence at the seat of the court.

Article 96 Panels.

- 2300 1. Divisions of EPC1 will sit (apart from cases of clear non admissibility) in panels comprising an odd number of judges, among whom one technical judge.
2. One of the members of the panel will be appointed as chairman and at least one member will be appointed as rapporteur.

2305 *It has been suggested to open the possibility of having a case decided by a single judge if the parties so wish. Although this certainly could be efficient it could also be detrimental to the harmonisation process. Therefore this suggestion has not been implemented in this proposal. Nevertheless the suggestion is mentioned here for consideration by the delegations. In principle panels will be composed of three members, two lawyers and a technical judge. Nevertheless the possibility is left open to sit in other, larger, panels if the court sees fit.*

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Article 97 Composition of panels

- 2315 1. The chairman and, if there is only one rapporteur, the rapporteur must be a legal judge. 2. The chairman of the panel can, in any stage of the proceedings, appoint another member as co-rapporteur if the nature of the case so requires according to his opinion and/or that of the first rapporteur or if the parties so request. After having

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consulted the President of the competent Division the chairman can also appoint another member of the panel as rapporteur.

3. If a provisional hearing of witnesses has already taken place on the basis of § 136 of the Rules of Procedure, the judge(s) having heard the witnesses shall be appointed on the panel as far as possible with regard to an efficient distribution of cases.

4. Without prejudice to the former two paragraphs of this article, each division of EPC1 shall compose the panels according to the rules, set up by the Presidium, that ensure the exclusion of discretion in the composition of the panels.

If cases are clearly non admissible there should be a possibility of dealing without the appointment of a panel because it would be a waste of time and money to first have to appoint a complete panel and to have this panel to convene and decide. It is suggested in § 113 and § 114 of the Rules of Procedure to have the Registry checking for cases of clear inadmissibility but giving the party concerned a direct appeal to the full panel.

It was already stated, for obvious reasons, in the paper WPL 9/99 that the chairman should be a lawyer. As regards the rapporteur also being a lawyer, that proposal is based on the very legal tasks the rapporteur will have to perform according to this proposal. Especially in the instruction phase of the proceedings, there will be a heavy responsibility of the rapporteur. That is a result of the need to have the case in principle ready for decision at the end of the oral proceedings. That means that evidence will have to be gathered before the oral proceedings. See for a further elaboration of these ideas the Rules of Procedure Section 1.7. Thus the rapporteur should be a lawyer. It should however remain possible to appoint more than one rapporteur: in some cases it would be undoubtedly advisable to have a technical judge as co-rapporteur. The proposed text of this article leaves that possibility open. Furthermore it gives the chairman the possibility to change the rapporteur if that would seem advisable in certain cases.

Formerly, when a situation was envisaged in which there would be cases of only regional importance, that would be dealt with by panels composed of only national judges, it was stated that each division of the court should compose the panels according to its own rules. The idea behind this provision was that there are important national differences as regards the allocation of certain cases to certain judges, varying from a total freedom of e.g. the president to allocate cases according to existing workload and special experience of certain judges, to fixed schemes, exactly stating what cases will be going to which judges and even who will be their substitute if such judges should not be available.

When Regional Divisions would be operating locally, there would be no compelling reason not to leave room for these local differences. Now that it was decided that all cases will be dealt with by internationally composed panels of judges, there is little room for varying rules for the composition of the panels: all divisions will have to draw from the same pool of judges. Therefore there has to be a central registration of which judges have been used recently on what cases and whose turn it is now to be put on a panel. To respect the principle of the "gesetzlicher Richter" that is very important for Germany, it is stipulated that these rules should exclude any possibility of discretion. It will have to be examined in detail how such rules could be formulated. Just to show a possible solution, there can be found in Annex a schedule along which the composition of the panels could be done. It requires not only a register of cases but also a register of technical judges, mentioning their

technical field and what official languages they command and a register of legal judges, stating to what division they belong and what languages they command.

Subsection 2.3.2 Jurisdiction

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Article 98 Exclusive jurisdiction on validity

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Without prejudice to proceedings before the national or European patent offices regarding limitation of European patents, EPC1 will have exclusive jurisdiction to decide at first instance, for the territories of the EPJ-states, cases concerning the validity of European patents in which one or more EPJ-states are designated, comprising cases in which a declaration of right is asked in that respect.

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It could be questioned whether a claim for a declaration of right, that a certain patent is not valid, is a decision as mentioned in Art. 16 (4) of the Brussels and Lugano conventions. Although this seems at least questionable and although giving the EPJ an exclusive jurisdiction in this respect might be seen by judges of non-EPLP states as non binding on them, it seems nevertheless worthwhile to make sure that it is understood that in the view of the EPLP states these cases should be brought before the EPJ.

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It is made clear in this text that limitation proceedings before the national patent offices in those member states who have such proceedings and limitation proceedings before the European patent office according to the revised text of EPC will not be affected by this protocol.

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*A matter that not has been discussed so far is whether national limitation proceedings before national **courts** will have to remain there (the difference with partial revocation can be very small) or that such proceedings should also be created before the EPJ. Such very technical proceedings are perhaps better left to technical bodies, but if that would be the reason for not giving jurisdiction to the EPJ in this respect, the question could be put why national courts should have jurisdiction in this regard. Complications could arise if national limitation proceedings before a national court would coincide with revocation proceedings before the EPJ. On the other hand: the same kind of complications could be expected in case of revocation proceedings before patent offices. Perhaps the best solution would be to leave limitation proceedings untouched, regardless whether they are brought before a patent office or before a national court and just to stipulate that the patentee has to inform the EPJ of any pending limitation proceedings in any proceedings before the EPJ in which he might be involved. It could then be left to the EPJ to gather further information and/or to stay its proceedings or not.*

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Article 99 National limitation procedures.

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1. Without prejudice to the right of the patentee to defend his patent before the EPJ only in a restricted form, in those member states where limitation proceedings regarding European patents are possible before the national courts, the national courts will retain that jurisdiction.
2. In all cases where national limitation proceedings are pending and the patentee is a party to proceedings before the EPJ, the patentee is obliged to inform the court about these limitation proceedings.

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Article 100 Exclusive jurisdiction re infringers domiciled in EPJ state

Protocol.

EPC1 will moreover have exclusive jurisdiction to decide at first instance, cases concerning the infringement or possible infringement of a European patent (comprising cases concerning the provisional protection afforded by a European patent application under article 67 EPC). in which one or more EPJ-states are designated as far as those states are concerned, if the alleged infringer is domiciled within an EPJ-state.

Article 101 Jurisdiction re infringers domiciled elsewhere.

EPC1 will also have jurisdiction to decide such cases at first instance if the alleged infringer is not domiciled within an EPJ-state.

In cases where the alleged infringer is domiciled in a non-EPJ state it will not be possible to assert exclusive jurisdiction for the court, because that would mean taking away the normal competence of his national court. That would contravene the provisions of EU Regulation 44/2001, of the Brussels and Lugano conventions and probably of all national laws.

Article 102 Jurisdiction if parties agree.

1. EPC1 will moreover have exclusive jurisdiction to decide at first instance, cases concerning the infringement or possible infringement of a European patent (including cases concerning the provisional protection afforded by a European patent application under Article 67 EPC) in which one or more EPJ-states are designated as far as those states are concerned, if all parties have expressly agreed in writing to bring the case before the EPJ.

2. Such an agreement may also extend to cases as mentioned in paragraph 1 concerning designated states that are non EPJ states or national patents, directly connected with the European patent in dispute as long as that European patent is object of the proceedings.

3. An agreement to bring the case before the EPJ can only create jurisdiction if the agreement is concluded after the dispute has arisen.

There is no reason to refuse a case in which both parties expressly wish the case decided by the EPJ. (See also e.g. Art. 23 of EU Regulation 44/2001 and Art. 17 Brussels and Lugano Conventions). It does not seem necessary to give the EPJ the discretion to refuse jurisdiction because of a forum non conveniens rule: as long as it is required that the litigation is about a European patent in which one or more EPJ states are designated, there will always be sufficient relation with the legal sphere of the EPJ.

It could also be imagined to add a counterpart to Art. 18 of the Brussels and Lugano Treaties, creating jurisdiction in all cases in which the defendant does not raise an objection in his first statement. That is at this moment not part of this proposal because it could seem too "imperialistic" to non-EPJ states. On the other hand there seems to be no good reason to forbid parties to make an infringement of a national parallel patent or a European patent in non EPJ states part of their dispute as long as a European patent for one or more EPJ states is also in dispute. It seems wise however to limit this possibility to agreements concluded

after the dispute has arisen. This to prevent such a clause becoming “standard” in e.g. license agreements.

2465 **Section III.2.4** **The European Patent Appeals Court**

Subsection 2.4.1 Organisation.

Article 103 Number of judges.

2470 The number of legal and technical judges to be appointed on EPC2 shall be determined by the Administrative Committee. The Executive Committee may make proposals on this subject.

2475 *See the note at Article 78. If we assume that 50% of the cases will be appealed and that of these 50% will be settled before the oral hearing then we could assume that 400 cases will cost the rapporteur two days and that 200 cases will cost the rapporteur another 3 days and the two other judges each 2.5 day (including travelling time). Taking into account 10% loss because of illness etc. and 220 working days per year, we would need about 12 judges, of whom 8 lawyers. Again it*
2480 *is not more than an educated guess.*

Article 104 Composition of panels

- 2485 1. EPC2 will decide cases in panels, to be composed by the President of EPC2 or his substitute, consisting of five judges of whom at least one will be a technical judge and at least three will be legal judges.
2. The chairman and – in cases where there is only one rapporteur - the rapporteur will have to be a legal judge.
- 2490 3. The chairman of the panel can appoint another member as co-rapporteur if the nature of the case does so require according to his opinion and/or that of the rapporteur or if the parties so request. After having consulted the President of EPC2 the chairman can also appoint another member of the panel as rapporteur.
4. The Presidium of EPC2 will constitute the rules according to which the panels will be composed and that ensure the exclusion of discretion in the composition of the panels.

2495 *This proposal mentions panels of five judges because that was discussed at an earlier stage. Nevertheless it could be reconsidered whether it should not be panels of three judges with the option to extending it to five if the case was of a complex character according to either the President or one of the members of the 3-panel.*
2500 *Comments of the delegations are invited on this subject.*

The formulation of this article leaves open the possibility of appointing more than one technical judge to a certain panel. It can however be doubted whether that will occur often as the work of the Court of Appeal will mainly consist of legal matters.

2505 *It is not expressly repeated that assessors can be appointed as supernumerary members of a panel because that is stated quite generally in Article 69.*

¹⁰ License agreements themselves are outside the jurisdiction of the EPJ. Use of an invention after the ending of a license agreement could however be regarded as a simple infringement and then the jurisdiction clause could take effect.

Subsection 2.4.2 Jurisdiction

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Article 105 Exclusive jurisdiction on appeal and revision

1. EPC2 will have exclusive jurisdiction to decide on appeal decisions taken by EPC1.

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2. It will also have exclusive jurisdiction to decide on revision decisions taken by EPC1 or EPC2.

The first sentence does seem self explanatory if not superfluous. As regards revision it would also be possible to have the revision decided by the court that did give the decision under revision. It seems better however to concentrate these, probably relatively few, cases at one court.

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Chapter III.3 Powers of the courts.

Section III.3.1 General

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Article 106 General provision

EPC1 and EPC2 will have the power to impose measures, sanctions and fines as laid down in this protocol.

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Article 107 Security

When the court makes an order, it may :

- (a) make it subject to conditions, including a condition to pay a sum of money into court or to give such securities as specified by the court order; and
- (b) specify the consequences of failure to comply with such order or a condition.

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Section III.3.2 Injunctions

Article 108 Order to desist from infringement

The courts shall have the authority to order a defendant to desist from an infringement, and inter alia to prevent the entry into the channels of commerce in the EPLP-states of imported goods that involve infringement of a European patent.

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See Art. 44 TRIPS.

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Section III.3.3 Damages in case of infringement

Article 109 Damages

1. In the event of a proven infringement, which has taken place when the infringer knew or had reasonable grounds to know that there was an infringement, the courts can order the infringer to pay the plaintiff reasonable damages sufficient to compensate for the injury he has suffered. The courts have the same power as regards a party that has caused or tolerated this infringement on the basis of his relationship with the infringer while it was in his power to stop it.

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2. The basic principles underlying the assessment and awarding of damages are that the plaintiff will be put, as far as possible, in the same financial and economical

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Protocol.

position as if the infringement had not taken place and that the infringer should not profit from his infringement.

3. Damages should however be a compensation and should not have a punitive character. 4. 4. Damages that were not reasonably foreseeable at the time of the infringement will only bear on the infringer if there are strong reasons of equity for computing those damages to the risk of the infringer.

At the request of a number of delegations there is incorporated a “European” article about damages, although it could be imagined to leave it to the courts to develop this matter in a harmonising way. The criterion of “knowingly or with reasonable grounds to know” stems from Art. 45 (1) TRIPS.

The last sentence of the first paragraph aims at companies using men of straw or subsidiary but could also apply to wholesalers or retailers over which the defendant has the power to stop them from selling the infringing goods.

The second paragraph aims at making sure that damages will not only be a reasonable substitute for license fees; because such a system would de facto mean a general compulsory license, anyway up to the moment the patentee gets a first injunction with an astreinte from the court. At the meeting of the subgroup in the Hague in April 2001, it was stressed by a number of delegations that it should be expressed as one of the underlying principles of damage assessment that an infringer should not profit from his infringement, without the damages becoming punitive of character. This proposal tries to express that principle.

Article 110 Kinds of damages

1. Damages may consist in a recovery of the losses suffered by the plaintiff (including but not necessarily confined to the profits he would have made if no infringement had taken place) or in a transfer to the plaintiff of the profits or estimated profits made by the infringer.

2. The plaintiff will only have to choose between these two possibilities after the amount of both has been ascertained. The courts will have the power to order the infringer to lay open his books to the plaintiff or to such an expert as the court may decide.

3. Damages may also be otherwise assessed by the court in such a way that the requirement of Article 109 (second paragraph) is met if proof of the real damages is impossible or disproportionately difficult or costly, e.g. by an equitable estimation of the amount, which should however always surpass the amount of a possible license fee.

4. Damages may not only comprise the payment of money but may also comprise orders to the defendant to perform or to refrain from certain acts.

5. Damages may also include costs for expert assistance reasonably made by the party concerned.

See art 45 TRIPS. The appropriate attorneys fees mentioned in 45 TRIPS are dealt with in a separate provision on the costs of proceedings.

Article 111 Indemnification of the defendant.

The courts shall have the authority to order a party at whose request measures were taken and who has abused enforcement procedures to provide a party wrongfully enjoined or restrained adequate compensation for the injury suffered because of such abuse and to pay his expenses.

Article 110 will be analogously applicable.

Section III.3.4 **Other measures in case of infringement.**

2610 ***Article 112 Forfeiture of infringing goods etc.***

1. The courts shall have the authority to order that goods that they have found to be infringing be, without compensation of any sort, destroyed or otherwise disposed of outside the channels of commerce in such a manner as to avoid any harm to the plaintiff.

2615 2. The courts shall also have the authority to order that materials and implements, the predominant use of which has been in the creation of infringing goods or to performing of an infringing process be, without compensation of any sort, destroyed or otherwise disposed of outside the channels of commerce in such a manner as to avoid any harm to the plaintiff.

2620 3. In considering such requests the need for proportionality between the seriousness of the infringement and the remedies ordered, the willingness of the defendant to change the materials into a non infringing state as well as the interests of third parties will be taken into account.

2625 *See Art. 46 TRIPS. Added is in the second paragraph the goods used to perform an infringing process.*

Article 113 Sequestration of allegedly infringing goods.

2630 1. To prevent the entry into the channels of commerce in EPJ states, the courts will have the power to order the sequestration of allegedly infringing goods, or materials and implements, the predominant use of which has been in the creation of infringing goods or to performing of an infringing process, for the duration of the infringement proceedings and/or the proceedings for forfeiture of these goods as meant in Article 112 .

2635 2. Such an order may direct any person to permit any person described in the order, or secure that any person so described (further: “the executing person”) is permitted:
(a) to enter premises, not being a private home, in any EPJ state, and
(b) while on the premises, to take in accordance with the terms of the order any of the following steps, specified in that order of the court:

2640 3. Those steps are-
(a) to carry out a search for or inspection of anything described in the order, and
(b) to take away of have taken away any goods as described in the order and to have them transported to and handed over to the person mentioned in the order who will act as sequestrator.

2645 4. An order under this section is to have effect subject to such conditions as are specified in the order, e.g. that the party applying for the order may not be present himself at the execution of the order.

2650 5. If proceedings are not pending before the court at the moment the order is given, the order shall cease to have effect – and the applicant will be liable for damages caused by its enforcement – if such proceedings are not brought before the court within 31 calendar days after the date of the order or within such a reasonable time limit as fixed by the court when issuing the order.

2655 6. The rules of procedure and the practice directions can detail the requirements for a request as mentioned in this article and the modalities under which such orders will or can be granted.

Protocol.

As a complementary of the powers of the courts to order the forfeiture of infringing goods but also to implement TRIPS (art. 50) it is necessary that goods that are alleged to be infringing can be sequestered and kept out of circulation.

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See also the explanatory notes at Article 119 .

Article 114 Information in case of infringement.

The courts shall have the authority to order the infringer to inform the plaintiff of the identity of third persons involved in the production and distribution of the infringing goods or services or the use of an infringing process and of their channels of distribution.

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See art 47 TRIPS, again the infringing process is added here. This provision enables the patentee to get informed about the persons “upstream” of the infringer, so as to enable him to stop the infringement at the source. It also enables him to get informed about the persons “downstream” of the infringer, so as to enable him to check whether the infringer has recalled all infringing products if so ordered or to verify the amount of his damages.

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Section III.3.5 Powers as regards parties

Article 115 Conclusions drawn from behaviour of a party.

In cases in which a party to proceedings voluntarily and without good reason refuses access to information, or otherwise does not provide necessary information within a reasonable period, or significantly impedes a procedure relating to an enforcement action, the courts have the authority to make preliminary and final determinations, affirmative or negative, on the basis of the information presented to them, including the complaint or the allegation presented by the party adversely affected by the act or mission in question, subject to the parties having an opportunity to be heard on the allegations or evidence.

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Art. 43 (2) TRIPS The placement of this article is somewhat arbitrary: it could be imagined to place it in the section about evidence in the rules of procedure.

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Article 116 Payment into court as security for costs.

1. The court may order a party to pay a sum of money into court if that party has, without good reason, failed to comply with a rule, practice direction or a procedural request of the court.

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2. When exercising this power the court must have regard to:

(a) the amount in dispute; and

(b) the costs which the parties have incurred or which they may incur.

3. Where a party pays money into court following such an order, the money shall be security for any sum payable by that party to any other party in the proceedings.

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See par. 3.1 of the English Civil Rules of Procedure.

Section III.3.6 Powers as regards evidence.

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Article 117 Production of evidence.

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2710 1. The courts shall have the authority, where a party has presented reasonably available evidence to support its claims and has specified articles or documents (in printed or in digital form), relevant to substantiation of its claims, which lie in the control of the opposing party, to order that such latter evidence be produced by that opposing party, subject in appropriate cases to a protective order as defined in Article 120 .

2715 2. The court shall have the authority to order a third party to produce articles or documents as mentioned in the first paragraph, taking into due account the interests of that third party, if it appears probable that that third party is in possession of this evidence due to its relationship to the opposing party mentioned before. The third party will be given an opportunity to present its interests as soon as is compatible with an effective application of such an order or possible order.

2720 *See Art. 43 (1) TRIPS. It is felt that in exceptional circumstances the court should also have the power to order third parties to provide evidence that is essential to a certain dispute. Especially if such a third party has certain evidence at its disposal because of its relationship to one of the parties, be it e.g. as a licensee or as a customer. This could e.g. be of great importance in the case of software source codes if the opposing party is not domiciled within an EPJ state but one or more of his customers are domiciled there; in that case the evidence of possible infringement is within reach of the courts. See § 70 Rules of Procedure for an implementation of this provision. A third party will have to be heard but not necessarily before the order is issued.*

2730 *It could be imagined to adapt the text of this article thus that also evidence in the possession of police or customs authorities should be made available to the court. This seems however not without problems as possible conflicts could arise between an order of the court to produce such evidence and the desire of the authorities concerned to keep the evidence at their own disposal.*

2735 **Article 118 Freezing orders.**

The courts shall have the authority to grant an order

- restraining a party from removing from their jurisdiction assets located there; or
- restraining a party from dealing with any assets whether located within the jurisdiction or not.

2740 *See Rule 25.1 of the English Civil Procedure Rules, enacting the so called Mareva-injunctions.*

2745 **Article 119 Orders for inspection etc. of property (Saisie contrefaçon)**

1. The courts shall have the authority to make, on the request of a person who is, or appears to the court likely to be, a party to proceedings in the court, an order for the purpose of inspection and securing the preservation of evidence that is or may be relevant in those proceedings.

2750 2. Such an order may direct any person to permit any person described in the order, or secure that any person so described (further: “the executing person”) is permitted:
(a) to enter premises, not being a private home, in any EPJ state, and
(b) while on the premises, to take in accordance with the terms of the order any of the following steps, specified in that order of the court:

3. Those steps are-

2755 (a) to carry out a search for or inspection of anything described in the order, and

Protocol.

(b) to make or obtain a copy, photograph, sample or other record of anything so described.

4. The order may also direct the person concerned:

(a) to provide the executing person, or secure that the executing person is provided, with any information or article described in the order, and

(b) to allow the executing person, or secure that the executing person is allowed, to retain for safe keeping anything described in the order.

5. An order under this section is to have effect subject to such conditions as are specified in the order, e.g. that the party applying for the order may not be present himself at the execution of the order.

6. If proceedings are not pending before the court at the moment the order is given, the order shall cease to have effect – and the applicant will be liable for damages caused by its enforcement – if such proceedings are not brought before the court within 31 calendar days after the date of the order or within such a reasonable time limit as fixed by the court when issuing the order.

7. The practice directions can detail the requirements for a request as mentioned in this article and the modalities under which such orders will or can be granted.

It is generally felt that some measure like the French saisie contrefaçon would be very useful on a European level. Paragraph 7 of the recent English Civil Procedure Act 1997 seems to give a somewhat more detailed regulation than the only article, L.615-5, of the French Code de Propriété Industrielle. It seems better to restrict this possibility however to premises not being private homes so as to avoid possible constitutional objections in member states. According to oral information in France the saisie is in practice never granted for execution in private homes.

The practice directions should give further details about these orders. See also Subsection 2.2.6. of the Rules of Procedure on on page 132.

As an equivalent of the French “huissier” or German “Gerichtsvollzieher” is not known in all European countries, it seems a better idea to have this order executed, by a European patent counsel, not being the counsel of the applicant, to be paid by the applicant, as it is done in England by a solicitor. In this proposal he is called “the executing person”. In general it might be desirable that the requesting party himself is not present at the search of the premises of his opponent. His legal representative and/or patent attorney should however always have access, subject to a possible restriction on their freedom to divulge certain matters to the applying party as meant in the next article.

If no proceedings are pending at the date the order is requested or given, these proceedings should start in short term. A term of 15 days as required by French law after a saisie contrefaçon seems a little short in case of European proceedings with possible language barriers and necessary translations of the report of the search. On the other hand legal certainty requires that this period be not too long. Proposed is a term of 31 calendar days as in art. 50-6 TRIPS.

Subsection 3.6.2 Protection of confidential information.

¹¹ It could however be an idea to fix or maximize the hourly fee for this executing party in the Practice Directions or otherwise, so that the parties know what they let themselves in for when they want to use this saisie.

Protocol.

Article 120 Protective orders.

- 2805 1. In order to maintain commercial secrets or other confidential information of a party or a third person or in order to prevent an abuse of evidence, the court may, ex officio or on the request of an interested person, make an order restricting or prohibiting the use of certain evidence to the proceedings before it and/or that the cognisance of that evidence will be restricted to certain persons.
- 2810 2. All evidence will be open to inspection to European patent counsel representing the parties but the courts shall have the power to enjoin counsel and people assisting him from communicating certain evidence to their clients and/or other persons.
3. Orders according to this article will be sanctioned by an astreinte, to be determined in the order and of sufficient deterrence, payable to the other party, without prejudice to his claim for damages.
- 2815 4. The court may make later orders to amend such an order or to revoke it wholly or in part.

See Art. 42 last sentence TRIPS.

2820 *In patent infringement cases it does happen, especially with method claims for making known products in a novel way, that the party accused of infringement denies having used the patented process and states that he has used his own process, that he however has not patented because it would betray his secrets without a reasonable possibility of detecting infringement or simply because he has preferred confidentiality as the only means of protection. In such cases the evidence will concentrate on the process used by the alleged infringer, who then is between a rock and a hard place: if it is proved that he uses another process, he will win the proceedings but lose his commercial secret. Therefore the possibility of a protective order, as known for instance in the USA and in the UK, should be established. The idea behind it is that evidence can be brought and examined by the opposing counsel and/or his experts but is not necessarily disclosed to the opposing party.*

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Subsection 3.6.3 Witnesses

Article 121 Witnesses.

- 2835 1. Without prejudice to the possibility to ask national courts to hear certain witnesses, the courts shall have the power to order a witness who, duly summoned, without good cause refuses to appear before the court or, having appeared, refuses to answer to certain questions, to pay an appropriate fine, not exceeding an amount to be determined in the practice directions.
- 2840 2. This fine will have to be paid into court. At the end of the proceedings the court will distribute the received fines evenly among the parties concerned.

The problem is of course, to whom is the fine going to be paid? It could not be the court itself because that would give the court a financial interest in the question whether a fine should be paid or not. A reasonable solution could be to have the fine paid into court and at the end of the proceedings be divided among all the parties. All parties will have been inconvenienced by the non appearance of the witness. That is however not of main importance: the main idea is not to compensate the parties but to deter an unwilling witness from not complying with his civic duty of giving evidence.

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Article 122 Hearing by national courts

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1. The courts may order that a witness or expert be heard by the judicial authority of his place of permanent residence.

2855 2. The order shall be sent for implementation to the competent judicial authority by letters rogatory under conditions laid down in the practice directions. The documents drawn up in compliance with the letters rogatory shall be returned to the court under the same conditions.

3. The court shall defray the expenses, without prejudice to the right to charge them to the parties or to one of them.

2860 4. The court can order the party who wants to hear the witness to pay an amount in court as security for the costs to be defrayed by the court and may stipulate that the letters rogatory shall only be sent to the national court concerned after the receipt of this amount.

2865 *See Art. 20 Protocol On The Statute Of The Common Appeal Court. The national court should not have to worry where the money for the costs of the hearing and for the witness is going to come from. On the other hand there is no reason why these costs in the end should not be paid by the party who is losing the proceedings or who has unnecessarily called the witness.*

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Article 123 Perjury.

1. Any EPJ state shall treat any violation of an oath or other procedural requirement of truthfulness by a witness, a party or an expert in the same manner as if the offence had been committed before one of its courts with jurisdiction in civil proceedings. At the instance of the court, the member state concerned shall prosecute the offender before its competent court.

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2. Prosecution shall only take place in one state at a time and shall not (longer) take place after there has been a judicial decision about the complaint in one of the EPJ states.

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See Art. 21 Protocol On The Statute Of The Common Appeal Court Added is here that also a party, violating a duty of truthfulness, can be prosecuted. There seems to be no valid reason to allow perjury by a party.

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Section III.3.7 Astreinte

The European Patent Courts do not have their own police force, let alone their own jails. Measures such as contempt of court and the like therefore seem hardly feasible. Nevertheless the courts need means to provide their decisions with teeth. Because of this and because enforcement of amounts of money is possible in every jurisdiction, the adoption is proposed of the Benelux idea of an astreinte, payable to the plaintiff without diminishing his claims for damages. In practice this has proven to be a useful instrument as its height can be very deterring to further infringement. As to the question who would be the beneficiary of the astreinte, it is proposed that the payment has to be made to the other party as in the Benelux countries. The only alternative to paying to the plaintiff would be to make the European Patent Organisation the beneficiary. That would on the one hand create a possible impression of partiality of the courts, being linked to this organization and

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¹² On an application of a party in the proceedings the court may order the other party to pay to the former a certain amount of money if the principal order of the court – not being the payment of money – is not complied with, without prejudice to the right to damages.

Protocol.

2900 *on the other hand raise questions of efficiency as in that case the EPO would have to be the watchdog to be on guard against further infringements. That does not necessarily seem the most efficient solution. In most cases the patentee will be much more on the alert for further infringements.*

The few next articles reflect the Benelux provisions and practices on astreintes.

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Article 124 General provision

The courts will have the power to order a defendant to pay an astreinte to the plaintiff, without prejudice to his claims for damages, for each future infringement and/or infringing article and/or infringing act contravening an injunction or other order and/or every period of time that such an infringement continues.

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So the astreinte cannot only be forfeited in case of an infringement but also in case of violation of e.g. an order as mentioned in Article 110 .

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Article 125 Modalities

1. The courts will also have the power to decide that a defendant should forfeit an astreinte if he does not perform an act ordered by the court, other than the payment of a sum of money, or for each day he does not do so.

2. The courts will be able to decide that the astreinte should only be payable after a certain period of time after the decision. They will also have the power to decide that the astreinte will not be forfeited above a certain maximum amount or below a certain minimum amount.

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This provision applies to cases in which the court makes orders, other than relating directly to infringement, e.g. orders to freeze certain assets or to produce certain documents.

2925

Article 126 Service of (a translation of) the decision

1. Astreintes will not be forfeited before the plaintiff has caused the decision providing therefore to be served on the defendant according to the national law of his country of domicile, together with a translation in an official language of that country.

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2. The court can nevertheless in extremely urgent cases order that such a translation may be served on the defendant at a later time, set by the court, provided that the defendant is given notice about the contents of the decision in that language otherwise.

2935

There should be no doubt at all from which date onwards the astreinte is due. The serving of the decision on the defendant seems the best way to make sure of that date.

2940

In extremely urgent cases however the plaintiff should be able to make the defendant aware in the defendant's language of the contents of the decision of the court and not have to wait first for an authentic translation of the decision.

2945

Article 127 Cancelling of astreinte, bankruptcy, death.

1. The court which has ordered an astreinte can, at the request of the defendant, cancel the astreinte, suspend it for a period of time or reduce its amount in the case of a permanent or temporary, total or partial impossibility of the defendant to

Protocol.

2950 comply with the injunction. 2. Cancellation, suspension or reduction of the astreinte shall not relate to the period of time before the impossibility arose.

3. Astreintes will not be forfeited during the bankruptcy of a defendant. National law of a defendant's country of domicile will determine the fate of astreintes forfeited before a bankruptcy.

2955 4. Astreintes will not be forfeited after the death of a natural person. Astreintes already forfeited before his death will however remain due.

2960 *The ratio of an astreinte is to compel the defendant to comply with an order of the court. It does not make sense to forfeit an astreinte during a period of time when the defendant is not able to comply with the order of the court or his debts are not going to be paid by him but will be the burden of his creditors. In case a defendant goes bankrupt after having forfeited astreintes, his national law will have to decide whether these astreintes will be admitted as debts in his bankruptcy proceedings.*

2965 **Chapter III.4 Proceedings.**

Article 128 Nature of proceedings

2970 1. The court shall decide according to the law upon the facts put in evidence by the parties. Apart from generally well known facts the court will take account of facts not put in evidence only if it suspects abuse of procedure.

2. It shall apply the law as laid down in EPC, in this protocol and, as far as applicable, in the national laws of the EPJ-states concerned. If these sources of law should differ, they will take precedence in that order.

2975 3. The court may also apply provisions of law not cited by the parties.

This provision makes sure that the court will, according to its discretion, only take into account facts of its own motion in very exceptional circumstances. There is of course no reason to prevent the court taking into account general knowledge: Paris is the capital of France and water freezes at 0 degrees Celsius.

2980 *On the other hand the court should be free to apply the right legal provisions, even in cases where the parties have not cited them or have based themselves on wrong legal provisions.*

Article 129 Proceedings public.

2985 1. Proceedings before the court shall be public unless and in so far as the court decides otherwise for consideration of public order or the necessary protection of trade secrets of a party or another interested person.

2. Decisions in this respect of EPC1 shall only be subject to appeal together with the appeal against the final decision in first instance.

2990 *In this text the public character is not limited to oral proceedings, including hearings with the parties and the hearings of witnesses. There seems to be no valid reason for such a limitation, as it will often be a matter of coincidence whether certain facts come to light in the written pleadings or in oral discussion and/or hearings. This means of course that every member of the public should have the possibility of inspection of the pleadings in the file. To avoid unnecessary delays this decision should only be appealable together with other decisions.*

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Protocol.

Article 130 Court fees.

- 3000 1. Parties conducting proceedings before the Courts shall be required to pay court
fees according to the rules fixed by the Administrative Committee according to
Article 44 .
2. These rules can require different fees for different steps in the proceedings in as
far as these steps are requested by a party.
- 3005 3. European patent counsel will be personally liable for the court fees due as a result
of actions taken by them in proceedings before the Courts.
4. A party not having paid the court fee for a next step in the proceedings will not be
able to participate in that step.

3010 *The second and fourth parts of this article open the possibility of differentiated fees
for different proceedings. It is not clear why all proceedings should cost the same
fee: proceedings with oral hearings are more costly than those without and
proceedings with extensive hearings of witnesses are far more costly than those
without. Nevertheless proceedings should not become costlier for a party because*

3015 *the court wants to hear witnesses or only the court wants to have an oral hearing.*

*The third part of this article is not as draconian as it seems: counsel will take care
to demand advances from their clients. On the other hand this provision makes it
unnecessary for the Registry to try to collect fees all over Europe.*

3020

Subsection 4.1.2 Language(s) of the proceedings.

*During the meeting of the subgroup of the Working Party in July 2001 it was
decided to follow for the language regime as closely as possible the ideas underlying
the Protocol on Article 65 of the EPC, Article 1 of which protocol reads, in the text
as signed in London on 17 October 2000:*

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*“1. Any State party to this Agreement having an official language in
common with one of the official languages of the European Patent Office shall
dispense with translation requirements admitted provided for in Article 65
paragraph 1 of the European Patent Convention.*

3030

*2. Any State party to this Agreement having no official language in common with
one of the official languages of the European Patent Office shall dispense with the
translation requirements under Article 65 paragraph 1 of the European Patent
Convention, if the European patent has been granted in the official language of the
European Patent Office prescribed by that State, or translated into that language
and supplied under the conditions provided for in Article 65 paragraph 1 of the
European Patent Convention.*

3035

3. (...)

4. (...)”

3040

*However, in this EPLP we are not dealing with waiving translations (and thereby
accepting a language already chosen by the applicant for a patent) but we are
dealing with actively designating a language. A strictly logical application of the
idea underlying the Protocol on art. 65 EPC would be that Regional Divisions in
member states that have an official language of the EPC as national language,
would have to accept that the language of the patent would be the language of
proceedings.*

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¹³ Document No. WPR/6/00/Add.1

Protocol.

3050 However, that was not the idea prevailing at the meeting of the subgroup in July 2001. Rather the idea was that every Regional Division would only have to be fluent in only one language, being the language they are most comfortable with.

3055 For member states that have one official language as a national language that is not particular problem: there the language of the proceedings simply will have to be that official/national language.

3055 For member states without an official language of the EPC as a national language the solution is also simple: these member states will have to designate one of the official languages of the EPC as the language of proceedings before their Regional Division.

3060 However there could be a problem with member states (or groups of member states wanting to have a common Regional Division) If for instance the Benelux countries would want to have a common Regional Division that group of states would have both the official languages French and German as national languages. Furthermore it would seem probable that the Netherlands, if not acting as a member of a group, would opt for English.

3065 In the same way Switzerland has both German and French as an official language. It could be problematical, internally, to favour one of these languages.

3070 There could be several solutions to this problem: one of the national/official languages, all common languages or all official languages of the EPC. As soon as one opens up the possibility of more than one possible language there arises the problem of the choice between these languages: has the choice to be made by the plaintiff, by the defendant, by both parties in agreement or by the court?

3075 The most simple solution would be to oblige member states to make a choice between the several national languages that are also official languages of the EPC. In such a case a relatively simple article could be sufficient as for instance:

3080 “1. Unless the parties and the Court agree otherwise, the language of the proceedings before the Courts will be:

I. for proceedings in appeal: that official language of the EPC that was the official language of the proceedings in first instance;

II. for proceedings in first instance:

3085 A. before the Central Division: the official language of the EPC in which the European patent or application has been granted or files;

B. before a Regional Division:

i. having its seat in a member state that has one of the official languages of the EPC as national language: that official language.

3090 ii. having its seat in a member state that has either more than one or none of the official languages of the EPC as national language: that official language of the EPC that that member state shall designate as such and shall communicate to the Registry.

2. The term member state in this article comprises a group of member states that has requested the creation a common Regional Division for that group.

3095 3. As long as both parties agree the court can allow the use of another language than the official language of the proceedings to be used during the

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proceedings or certain parts of them. Nevertheless the decision will always be given in the official language of the proceedings.

3100 *4. The Rules of Procedure shall give rules for the translation of the file, or part of it, in case a non official language of the proceedings has been used during part of the proceedings.”*

3105 *That solution however could pose internal political problems for these member states because the other languages could feel discriminated against. Moreover it could be an obstacle for member states to require a common Regional Division.*

So another solution was looked for.

3110 *Although the optimal solution would be to have both parties agree on the language of the proceedings, that can for practical reasons not be taken as the main rule: if parties are in conflict it will be hard to achieve agreement on such matters, especially if not reaching an agreement means delay in the proceedings.*

3115 *Another option could be to allow states to designate more than one of the EPC languages and to allow parties to use every designated EPC language: that would mean the use of more languages in one and the same proceedings. It would not necessarily have to pose a problem for the Regional Division concerned, because it will have considered this when deciding to accept more than one language. It could however pose a problem in appeal because also in second instance there would have to be judges who would understand both languages. Furthermore it hardly seems advisable to allow the use of different languages in sometimes very complicated and technical proceedings as patent proceeding: that would be an unnecessary further source of possible misunderstandings.*

3120

3125 *The solution proposed here is aiming at the utmost flexibility while at the same time taking into account the (emotional) problems that the language issue can bring. The proposal differentiates between language of the proceedings and so called “designated languages”. In a nutshell the proposal requires that every Regional Division designates at least one (but possibly more) of the official languages of the EPC as languages to be used before that division. (If an official language of the EPC is at the same time a national language in (part of) the territory of the Division, then that language will have to be at least one of the designated languages for that (part of) the territory. Thus it is left to the Divisions to choose as many languages as they see fit, provided that the local national/official language of a possible defendant in their territory can function as language of the proceedings: if there is only one designated language that has to be the national/official language.*

3130

3135

As to the decision which of the designated languages is to be the language of proceedings if there are more designated languages, the main rule is that it should be that national/official language that is used (most frequently used) at the domicile of the defendant.

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As always, this flexibility has to be paid for by a somewhat complicated regulation. If that price should be considered too high to pay, than one could revert at a text like suggested above.

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Article 131 Language of proceeding in appeal.

Protocol.

Unless the parties and the Court agree otherwise, the language of the proceedings before EPC2 will be that official language of the EPC that was the official language of the proceedings in first instance.

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Article 132 Language of proceedings in first instance.

1. Without prejudice to paragraphs 4 and 5 of this article regarding the temporary use of other languages, the language of the proceedings before EPC1 will be one of the official languages of the EPC.

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2. Unless the parties and the Court agree otherwise, the language of the proceedings before the Central Division will be the official language of the EPC in which the European patent or application has been granted or filed.

3. Unless the parties and the Court agree otherwise, the language of the proceedings before a Regional Division will be the language indicated by Article 133 . and Article 134 .

3160

4. As long as both parties agree the court can allow the use of another language than the official language of the proceedings to be used during the proceedings or certain parts of them. Nevertheless the decision will always be given in the official language of the proceedings.

3165

5. The Rules of Procedure shall give rules for the translation of the file, or part of it, in case a non official language of the proceedings has been used during part of the proceedings.

Article 133 Designated languages for Regional Divisions.

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1. Every Regional Division shall designate, at least, one of the official languages of the EPC as designated language for its territory or for every part of its territory and advise the Registry of this designation or these designations and of any change in them.

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2. A change in designation will only have effect for proceedings started before the Division more than three months after the publication of this changed designation by the Registry in the Official Journal of the Office.

3. In case one of the official languages of the EPC is also a national language in a member state (part of) whose territory is falling in the territory of a Regional Division, that language will have to be (one of) the designated language(s) for that territory.

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Article 134 Language of proceedings before Regional Divisions.

1. The language of the proceedings before a Regional Division will be the designated language that is also the national language for that part of the Divisions territory where the defendant is domiciled.

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2. If none of the designated languages is a national language at the domicile of the defendant, then the language of the proceedings will be the designated language for that part of the territory. If there are more designated languages for that part of the territory the plaintiff can choose between these languages.

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3. If there are more designated languages that are also national languages for the part of the Divisions territory where the defendant is domiciled, then the plaintiff will have to choose as language of the proceedings that language that is most common at the domicile of the defendant. If the defendant objects to the language chosen by the plaintiff the chairman of the panel will immediately rule what designated language is to be used from that objection onwards.

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4. If there are more defendants than the language of the proceedings will be the language that would have been applicable for the majority of them. If there is no such majority than the language of the proceedings will be that language that would have been applicable for the defendant first mentioned in the statement of claim.

3200 5. If a Regional Division is competent on the basis of art 5 (4) resp. 5(3) of the Jurisdiction Regulation resp. of the Conventions of Brussels and Lugano then “domicile of the defendant” in the paragraphs above should be read as “the place were the harmful event occurred or may occur”.

3205 6. If the parties agree in writing on a designated language before the start of the proceedings, then that agreement will take precedence over the rules above.

Article 135 Amendments.

Proposed amendments to a European patent must be drafted in the language in which the patent has been granted.

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See Rule 1 (2) of the EPC.

Article 136 Documents in evidence.

3215 Documents to be used for purposes of evidence before the Courts, and particularly publications, may be filed in any language. The Courts may, however, require that a translation be filed, within a given time limit, in the language of the proceedings.

See Rule 1 (3) EPC.

3220 **Article 137 Language during oral proceedings.**

1. Any party to oral proceedings before the Courts may, in lieu of the official language of the proceedings use one of the official languages of the EPJ states on condition that he makes provision for interpreting into the language of the proceedings.

3225 2. If a member of the panel wishes to use another official language of the EPC than the official language of the proceedings, he will notify the Registry in due time, at the latest two weeks before the date of the oral proceedings. The Registrar will make provision for interpreting into the language of the proceedings.

3230 3. The costs of interpretation meant in this article will not be part of the costs as meant in Article 159 .

See Rule 2 (1), which however was adopted only in a modified form.

3235 *It is felt that the costs caused by one of he parties or one of the judges not being fluent in the language of the proceedings should not have to be born by the (other) parties. So a party wanting to speak another language will have to provide its own simultaneous interpreter. If something is lost in the translation that is his own risk. Therefore it does not seem necessary to limit this facility to the other official languages of the EPC.*

3240 *If one of the judges wants to use another language, the costs of the interpreter will have to be born by the organisation. On the other hand every judge should be fluent in at least one of the official languages of the EPC, so this facility should be restricted to the official languages of the EPC. (In most cases he judges will at least understand some of it (even if he wants to use another language actively), so the risk of something getting lost in the translation will be smaller.*

3245

Article 138 Parties.

1. The competence of a person or a collectivity of persons to act as a party in proceedings before the court is regulated by his national law.

3250 2. The Rules of Procedure will give rules for cases where a plurality of parties are taking part in the proceedings, for changes in the identity of parties, for removal or addition of parties from proceedings and for cases in which parties cease to exist or go bankrupt.

3255 *It does seem clear that legal persons will be able to act as a party in proceedings. In some countries certain collectivities of persons do act as such and are able to be a party in proceedings without having legal personality (e.g. the “Offene Handelsgesellschaft” in Germany and the “vennootschap onder firma” in the Netherlands). There seems to be no good reason to refuse a locus standi to such a group of persons having party status under its national laws.*

3260 *Compulsory legal representation.*

It is felt that a system in which parties could handle their own proceedings would unnecessarily burden the new system and would moreover not be fair to the parties.

3265 *The new court will have to apply a newly designed procedural law. Apart from problems of language and different legal cultures, that will be difficult enough without having to deal with parties who do not understand procedural matters. In creating a new procedural system, much will depend not only on the contents of the procedural rules but also on the way they will be applied: a new legal culture will have to develop. That is difficult enough with professional legal representatives but would be impossible if the court had to deal with litigants in person, many of whom would be taking part in legal proceedings once in a lifetime.*

3270 *It would not only be a problem for the courts but also would be unfair to those parties themselves: parties who only incidentally appear before the courts would be at a disadvantage compared to companies that are litigating frequently and therefore know all the possibilities and impossibilities of the game.*

3275 *As compulsory legal representation is the standard in most European countries, especially in patent infringement cases, it is felt that the same standard should without difficulty be applicable in the new supranational courts. The more so because the European Court of Human Rights has decided that art. 6 ECHR obliges the member states to the Rome convention to provide legal aid for those proceedings that a party generally is not able to conduct itself, even if formally there is no compulsory legal representation. Patent cases certainly fall into the category of cases that a party is not able to conduct himself. Where on the one hand the only possibility to conduct a case in person clearly is held not to be sufficient to*

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¹⁴ ECHR 9 October 1979, Airey vs. Ireland, Publ. ECHR Series A, vol. 32 (1980) pp. 11-16:

“The [Irish] Government contend that the applicant does enjoy access to the [Irish] High Court since she is free to go before that court without the assistance of a lawyer. The Convention is intended to guarantee not rights that are theoretical or illusory but rights that are practical and effective. This is particularly so of the right of access to the courts in view of the prominent place held in a democratic society by the right to a fair trial ... it is not realistic, in the Courts opinion, to suppose that, in litigation of this nature, the applicant could effectively conduct her own case, despite the assistance which, it was stressed by the Government, the judge affords to parties acting in person. ... The court concludes...that the possibility to appear in person before the High Court does not provide the applicant with an effective right of access. ... There has accordingly been a breach of Article 6 sec. 1 [guaranteeing all civil litigants a fair hearing].”

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safeguard the principle of free access to the court and on the other hand the Governments of the member states are obliged to provide legal aid for those parties who are not able to conduct their case themselves, the arguments in favour of compulsory legal representation seem to have the most weight.

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Article 139 European patent counsel.

1. Parties must be represented before the court by a lawyer registered by the Registrar as a European patent counsel.

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2. The Registrar shall register as a European patent counsel any lawyer who is entitled to practise and represent parties in normal civil proceedings before a civil court of an EPJ- state and who applies in writing for such registration, according to the rules given in the Rules of Procedure.

3. The Administrative Committee can levy an annual contribution in the costs of administration for the maintenance of the registration.

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Article 140 Obligation of truthfulness.

European patent counsel shall have an obligation to the courts not to knowingly (or with good reason to know) misrepresent cases or facts before the courts.

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See Art. 12 Protocol on the Statute of the Common Appeal Court.

Article 141 Technical adviser

The representing patent counsel may be assisted by a technical adviser who is a professional representative whose name appears on the list maintained by the Office and who is entitled to act before the Office. The technical adviser will be allowed to speak at hearings of the court under the conditions laid down in the practice directions.

3310

Although litigation is not the day to day routine of most patent attorneys, their technical assistance cannot be missed in patent proceedings, be it on validity or on infringement. They should therefore not only be able to accompany the European patent counsel but also have the right to address the courts. The legal responsibility of course remains that of the European patent counsel as the official representative of the party.

3315

In theory it could be possible to allow not only European patent attorneys the right to address the courts but to allow that right to all patent attorneys. As the cases before the EPJ however will deal always with European patents and moreover the European patent attorneys form one coherent body with their own organisation and their own disciplinary supervision, it was preferred to restrict this possibility to only European patent attorneys.

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Article 142 Rights of representatives

European patent counsel and technical advisers shall, when they appear before the court, enjoy the rights and immunities necessary for the independent exercise of their duties, under conditions laid down in the practice directions.

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Article 143 Powers as regards representatives

1. As regards European patent counsel and technical advisers who appear before it, the court shall have the powers normally accorded to courts of law, under conditions laid down in the practice directions.

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2. In particular they will have the power to report the counsel and/or adviser to his professional organisation in the event of misbehaviour.

3340 *It does not seem necessary at this moment to create a separate disciplinary body for European patent counsel and European patent attorneys. All European patent counsel will be member of their national bar organisations and for European patent attorneys there exists the disciplinary regime of the EPI.*

Article 144 Further details in Rules of Procedure.

3345 The Rules of Procedure will further regulate the registration of European patent counsel and their functioning before the courts.

Article 145 Delegation of tasks

3350 Without prejudice to the principle of collegiate decision-making, the courts and their panels can delegate certain functions to one or more of their members for such time and under such conditions as the court or the panel sees fit.

3355 *It may turn out to be practical that not every step in proceedings has to be performed by all members of a panel, so here the possibility of delegation of tasks is opened. Nevertheless the first part of the sentence should make it clear – as far as that would be necessary – that judgements should be reached collegially and of course cannot be delegated to one member of the panel.*

3360 *A major field of application could be the field of the gathering of evidence. It will in principle be the whole panel that will be deciding about evidence issues but it could be practical to delegate certain tasks to the rapporteur and/or the technical judge.*

Article 146 Case managing task

3365 The courts have an obligation actively to manage the cases before them. The Rules of Procedure will further detail this obligation and the power necessary for its fulfilment.

Article 147 Evidence.

3370 The Rules of Procedure shall give rules about the onus of proof and the gathering of evidence, including expert evidence.

Article 148 Decisions by majority.

The decisions of the court shall be taken by majority of the panel.

Article 149 Reasoned decisions in writing.

3375 They shall be reasoned and be given in writing and be available, at least to the parties, without undue delay.

Article 150 Language of the decision.

3380 Without prejudice to the possibility of translation into other languages, the authentic text of the decision shall be given in the official language of the proceedings.

3385 *It is held important that the language during proceedings in both instances should be the same. Thus, also in those cases in which the court and the parties have agreed for practical reasons to use another language, nevertheless it should be ensured that the decision is available in the language of the proceedings.*

Protocol.

Article 151 Publication of decisions. Copyright.

1. The Registry will send a copy of every final decision to the European Patent Office to enable publication in its Official Journal.
- 3390 2. The Executive Committee can decide to publish in an official periodical of the EPJ all or some decisions of EPC1 or the EPJ2 if the Administrative Committee agrees to the publication of such a periodical.
3. The Executive Committee can publish all or certain decisions of the EPJ1 or the EPJ2 on the internet.
- 3395 4. There will be no copyright on decisions of the EPJ.

Article 152 Right to be heard.

1. Decisions on the merits of the case shall be based only on evidence and arguments in respect of which parties have had the opportunity of being heard.
- 3400 2. A party who, although duly summoned, is not present at oral proceedings will, without prejudice to the discretion of the Court to give this party another opportunity of expressing itself, be considered to have had the opportunity to be heard about the arguments presented there.

3405 *See Art. 41 (3) TRIPS. Added is that the decisions shall only be taken on arguments that the parties were offered the opportunity of being heard; it is a generally accepted judicial principle that judgments should not contain surprise-reasons out of the blue that were not discussed with them or by them during the case. A party*

3410 *who does not appear at oral proceedings runs voluntarily the risk that his opponent will come up with a new argument that convinces the court or that in the course of the discussion with that opponent a new view on the case develops. In case there turns out to be a valid reason of force majeure why the party could not attend, the Court has the discretion to provide relief.*

Article 153 Dissenting opinions

3415 Any member of the panel deciding the case will be allowed to express his opinion separately in the decision, be it a concurring or a dissenting opinion.

3420 *There are a lot of things to be said in favour of dissenting opinions and there are things to be said against them. It is felt that for a new court developing a harmonised jurisprudence for patent law in Europe, the advantages outweigh the disadvantages. It seems important for the development of jurisprudence that diverging thoughts get the attention they deserve, so that in future disputes parties can help to develop thoughts further. It could however be considered, for instance*

3425 *from a point of view of efficiency, to restrict these dissenting opinions to decisions in second instance or to final decisions.*

Article 154 Appeal.

- 3430 1. As far as no expressly stated otherwise in this protocol, all decisions of EPC1 will be subject to an appeal on EPC2, at the latest when the final decision in the case is given.
2. From decisions in which the EPJ has assumed jurisdiction over a case and from interlocutory injunctions an immediate appeal will always be possible.
- 3435 3. The Rules of Procedure shall give further detailed rules about the moment the different kinds of decisions are subject to appeal and the way in which appeals shall be filed and dealt with.

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Article 155 Effect of appeal.

- 3440 1. If a decision is appealed the effect of the decision will be suspended and, if it is not a final decision, the proceedings at first instance will be stayed until the decision of EPC2 is given.
- 3445 2. However both EPC1 and EPC2 can, on request of a party or of its own motion, decide that an appeal against that decision will not have suspensive effect. The court giving that decision can make its effect dependent from the putting up of securities by a party or from other conditions it thinks fit.
3. If both courts have given contradictory decisions in this respect, the decision of EPC2 prevails.

3450 *Although in general it seems best in case of an appeal to wait for the decision of the second instance, there nevertheless are cases where efficient proceedings require that the appeal shall not have a suspensive effect. Especially interlocutory injunctions would hardly be effective if they could be blocked by just appealing. Therefore there is given a general power to the court to decide that a decision shall not have a suspensive effect. The court of appeal can correct this decision and set it aside if the judges of EPC2 feel that it should not have been taken (which is not necessarily be connected with their expectation about the outcome of the appeal but could also be founded upon a balance of possible inconveniences).*

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Article 156 Nature of appeal proceedings

- 3460 1. The appeal proceedings will not be a new trial of the case but will give a decision on the grounds of appeal formulated by the appellant.
- 3465 2. EPC2 will only decide, on the basis of the detailed grounds of appeal of the appellant or appellants, whether EPC1 has correctly established the facts alleged by the parties at first instance and whether it has correctly applied the law to these facts.
3. New facts and/or evidence will only in exceptional cases be admitted on appeal proceedings, e.g. when facts or evidence were not available at the time of the proceedings at first instance or when it could not have reasonable been required from the party concerned to provide them.

3470 *The appeal proceedings will not try again the case as such but will only deal with the concrete objections of the appellant(s) against the decision in first instance. That does not mean that the appellant cannot contest the assessment of facts by the first instance, but he will have to formulate a clear objection in that respect, after which the second instance will deal with it and will have to decide whether the assessment of EPC1 was right. The appellant will however have problems if he wants to introduce new facts or wants to take another legal position than at first instance: this will only exceptionally be allowed.*

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Article 157 Revision.

- 3480 1. Revision of a decision of EPC1 or EPC2, from which appeal is not or not any more possible, by EPC2, can be requested by a party adversely affected by that decision but only on the ground of either a criminal offence that may have influenced the decision or – if it concerns a decision of EPC2 – the violation of a fundamental procedural principle of law.
- 3485 2. Revision on the basis of a criminal offence may only be requested if that criminal offence is established in a final judicial judgment.

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3. The Rules of Procedure will further detail the revision proceedings and the time limits concerned.

3490 *Revision is to be seen as an extraordinary legal remedy. What fundamental*
procedural principle of law is fundamental enough can be left to the court or could
possibly be detailed in some measure in the Rules of Procedure.
If revision is requested on the basis of a criminal offence, it is suggested that that
3495 *should only be possible if the criminal offence was established by a (final) judicial*
decision. That on the one hand could give a date as a starting point for a time limit
and on the other hand would prevent evidence-problems of a criminal nature: a
patent court should not have to deal with laws of criminal evidence. (Not to speak of
the problems if they would come to another conclusion about the existence of a
3500 *certain offence than the court in the state concerned: a party could be condemned*
and be acquitted at the same time).
There was one suggestion to leave the revision with the court that has given the
decision under revision, such because of reasons of efficiency. That argument does
not seem to outweigh the argument of greater specialisation and a more consequent
3505 *development of jurisprudence if all the (few) cases of revision go to EPC2.*

Article 158 Effect of decisions

1. Decisions of the court will in all EPJ-states be regarded as decisions of a national court of that state.

3510 2. Decisions revoking a European patent wholly or in part shall take effect in all EPJ-states designated in that patent for which the revocation has been claimed and awarded.

3515 *The effect of EPJ decisions about validity should take effect EPLP-wide, as was discussed in the working party in an earlier stage. nevertheless we still have to deal with a bundle-patent and with the basic principle of civil proceedings that the parties determine the extent of their dispute. So the party claiming the revocation of the patent will have to specify whether he wants the patent revoked in all designated (EPJ) states or only in one or more of them. It could e.g. be imagined that a defendant in his counterclaim restricts his claim for revocation to just the country*
3520 *where the Regional Division is sitting, so as to avoid the case becoming an “international” one and thereby becoming more costly to litigate.*

Article 159 Loser pays costs

3525 1. A party who is ruled against shall be convicted to pay the costs incurred by his opponent(s) and/or the court according to the rules given in the Rules of Procedure. If both parties are ruled against in part the court can divide the costs in an equitable way.

3530 2. Left aside the outcome of a case, the court can always decide that certain costs, as unnecessarily made, will be left with the party that made them.

Article 160 Rules of Procedure.

1. The Rules of Procedure as contained in Annex I. of this Protocol, will further regulate proceedings before the courts.

3535 2. The Rules of Procedure can be changed by the Administrative Committee on a proposal of the Executive Committee.

PART IV. FACULTATIVE ADVISORY COUNCIL

Article 161 Definitions

3540 Article 1 of this protocol will also be applicable to this part of the protocol.

Article 162 Further definitions:

Legal member: a legal judge of EPC2, functioning as a member of the FAC.

3545 Technical member: a technical judge of EPC2, functioning as a member of the FAC

As some states will only be adhering to this part of the protocol it does seem advisable to have the definitions expressly incorporated in this part. Furthermore there have to be other definitions for the members of the FAC, who in this capacity are not acting as judges.

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Article 163 Applicable provisions.

3555 Article 6 and Chapter II.1 of this protocol will also be applicable to this part of the protocol.

As was mentioned by the French delegation during the meeting in July 2001 not only the definitions of art. 1 but also the provisions about substantial law could be declared applicable.

3560

Article 164 Establishment.

There is established a Facultative Advisory Council.

3565

Article 165 Task.

The task of the Facultative Advisory Council is to advise, on a non obligatory basis, national courts of the member states who have acceded to Part IV. of this protocol on questions of European patent law that those national courts think relevant for the decision of cases before them.

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Cosmetically it would be nicer to place this article in part I, for instance after Article 4 , but that would create the difficulty that Facultative Advisory Council states would have to accede also to part I, which they probably would not like in so far as they have principal objections to the creation of a system of law as mentioned in Article 2 .

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Article 166 Administrative Committee

1. The Administrative Committee will be the highest administrative organ of the FAC and it will be formed by the representatives and alternate representatives of the FAC states. It will abstain from influencing the opinions of the FAC or the independence of its members.

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2. Every FAC state will have the right to appoint one representative and one alternate representative.

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3. Every FAC state will have one vote.

4. Representatives of member states to the European Patent Convention, not being FAC states, will on their request be admitted as observers.

Protocol.

5. Article 39 , Article 40 , Article 41 , Article 42 , Article 43 and Article 45 will be applicable analogously.

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Theoretically it would be possible for EPJ states to appoint other representatives on the Administrative Committee of the EPJ and of that of the FAC. The expectation however is that the Administrative Committee of the FAC will be that of the EPJ, extended with the representatives of those states that have only acceded to Part IV of the Protocol.

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Article 167 Tasks Administrative Committee

The Administrative Committee will:

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- determine the annual budget of the FAC;
- determine the remuneration of the members, both of those functioning full time and those functioning part of their time in the FAC,
- survey and control the financial annual report of the Presidium of the FAC and the discharge of the Presidium in this respect;
- determine on a proposal of the Presidium the Rules of Procedure and the practice directions the FAC;

3605

Finally it will perform other tasks assigned to it in this protocol or its implementing regulations.

Article 168 Composition

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1. The Facultative Advisory Council shall be formed by EPC2.
2. It shall have a presidium, being the presidium of EPC2.

Article 169 Task of the Presidium.

The tasks of the Presidium of the FAC are:

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- conducting the management of the FAC;
- drawing up proposals to the Administrative Committee concerning the rules of procedure and practice directions for the FAC;
- issuing rules for the Registry as mentioned in Article 55 ;
- budgeting the FAC and presenting this budget to the Administrative Committee;

3620

- issuing an annual report and an annual financial report to the Administrative Committee.

Article 170 Delegation of tasks

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The Presidium can delegate certain tasks to one of its members or to one or more judges of the courts, for such a time and under such conditions as it sees fit.

Article 171 Basis of the opinions.

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The Facultative Advisory Council will base its opinion in a specific case on the facts as stated or assumed by the referring national court and not take or evaluate evidence by itself.

See WPL/10/00 e sub 4. It seems useful to explicitly state that the Facultative Advisory Council will not be hearing witnesses and/or experts. That would make the proceedings before the Facultative Advisory Council unnecessary complex and costly in time and money. Unnecessarily because there is no need to harmonise fact finding but only to harmonise the application of European patent law.

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3640 **Article 172 Optional character**

1. It is understood that the national courts will under no circumstances be obliged to refer a question to the Facultative Advisory Council.

2. It is also understood that the national courts will not be bound by the contents of the opinions delivered by the Facultative Advisory Council.

3645 3. Every FAC state will determine what weight is to be attached to the opinions of the Facultative Advisory Council and what will be its role in national proceedings in that state.

Article 173 Financing.

3650 The FAC states will endeavour to attain that the costs of the asking of an opinion of the FAC by a national court will not have to be born by the litigating parties, such without prejudice to the costs caused by the parties themselves addressing the FAC or asking to be heard by the FAC.

3655 *This matter has to be studied in more detail: WPL/10/00 e states on page 6 that the referrals to the Facultative Advisory Council would be free of charge and that the costs would be born by the European patent Organisation. Such a rule could only be established here if all member states to EPC would be signing the EPLP, at least the part on the Facultative Advisory Council. As that does not seem to be the case, the*

3660 *EPLP could only provide the statement that the Facultative Advisory Council would request the EPO for financial support. It is then further up to the Administrative Council of the European Patent Organisation to decide whether and in how far to allow subventions to the FAC on the basis of Art. 149a of the revised EPC.*

3665 *The only other way to prevent parties paying for referrals would be just to state that there would be no costs for the parties concerned and that the costs of a referral should be born by the referring court or its government. As no concrete proposals regarding the costs of the FAC have come forward, for the moment there is only this “statement of intent” of the FAC states.*

3670 **Article 174 Language.**

Article 14 EPC and Rules 1, 2 and 5 of the Implementing Regulations of EPC will apply to proceedings before the Facultative Advisory Council.

Article 175 Opinions

3675 1. The opinion shall be reasoned and shall be given in writing and shall be sent to the requesting court without undue delay.

2. Any member of the panel deciding the case will be allowed to express his opinion separately in the decision, be it a concurring or a dissenting opinion.

3680 *See the note at Article 153 for concurring and dissenting opinions in judgements of the EPC. Where the FAC does not give decisions but only opinions, it is still more important for the requesting court and for the public in general to see whether there are other ways of seeing the law on a certain point.*

3685 **Article 176 Publication of opinions. Copyright.**

1. The Registry will send a copy of every opinion to the European Patent Office to enable publication in its Official Journal.

2. The Presidium can publish all or certain opinions on the internet.

3. There will be no copyright on opinions of the FAC..

Protocol.

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See Article 151 .

Article 177 Proceedings

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Proceedings before the Facultative Advisory Council are governed by the rules of procedure as laid down in Annex II. to this Protocol and will in any case comprise a possibility for the parties concerned in the case to present directly or indirectly to the Facultative Advisory Council in writing their opinion on the question referred to the Facultative Advisory Council.

3700

It is important that parties have the opportunity to present their views on the referred questions. It will however probably be best and administratively least cumbersome to delegate the collecting of these party opinions to the referring court and to have these courts send in the party opinions together with the referred questions. Therefore this provision mentions the words “directly or indirectly”, indirectly being the case when the national court invites the parties to send in their written views to that court, which court will include these views in the file to be sent to the FAC.

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See § 2 Rules of Procedure FAC..

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Article 178 Change of Rules of procedure.

Annex II. can be changed by decision of the Administrative Committee on a proposal of the presidium of the Facultative Advisory Council.

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PART V. TRANSITIONAL AND FINAL PROVISIONS

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In theory it would be possible to give the EPJ exclusive jurisdiction for all litigation about European patents from the day the EPLP comes into force. That would possibly drown the new court in a flood of new cases. It seems wise to dam this flood and give the EPJ the opportunity to adjust itself.

Different schemes (or combinations of them) are possible, for instance to restrict the jurisdiction to patents granted after the date of coming into force of the EPLP or to start with certain fields of technology and add each year a new field of technology.

3725

As up till now no specific proposals have been suggested, this proposal gives a possible set of criteria for the entering into force and for the start of the jurisdiction of the courts. These items clearly need discussion.

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The entry into force of Part IV has been made dependent of the entry into force of Parts I, II and III because before that there will be no EPC2 to play the role of FAC.

Article 179 Entry into force

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Part I. , Part II. and Part III. of this protocol will enter into force in all EPJ states after at least 5 member states, together representing (according to the figures of the year 2000) at least applications for a European patent, will have ratified this protocol.

Part IV. of this protocol will enter into force in all Facultative Advisory Council-states after at last 5 member states have ratified this protocol and part I, II and II of this protocol have entered into force.

Protocol.

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The importance of a member state as regards patent litigation can be estimated according to the number of patents it is designated in (as regards the risk that infringements on its territory will give rise to proceedings) and/or according to the numbers of patents/applications that are originating there (as regards the risk that a patent will give rise to nullity proceedings).

3745

According to the annual report of the Office over the year 2000 there were a total number of 100.692 European patent applications filed and Euro-PCT applications entering the regional phase, while a total of 27.523 European patents were granted. Distribution by country of origin and by designation was as follows:

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Protocol.

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State	Patents		Applications	
	<i>Origin</i>	<i>Designations</i>	<i>Origin</i>	<i>Designations</i>
	<i>Number</i>	<i>%</i>	<i>Number</i>	<i>%</i>
<i>Japan, USA and other non member states</i>	13987	50,82%	50932	50,58%
<i>Germany</i>	5395	19,60%	20.104	19,97%
<i>France</i>	2110	7,67%	6791	6,74%
United Kingdom	1377	5,00%	4359	4,33%
Switzerland	1006	3,66%	3561	3,54%
Netherlands	938	3,41%	4435	4,40%
Italy	912	3,31%	3199	3,18%
Sweden	549	1,99%	2305	2,29%
Belgium	295	1,07%	1.111	1,10%
Finland	264	0,96%	1223	1,21%
Austria	212	0,77%	809	0,80%
Denmark	203	0,74%	714	0,71%
Spain	125	0,45%	525	0,52%
Ireland	39	0,14%	212	0,21%
Liechtenstein	38	0,14%	154	0,15%
Luxemburg	34	0,12%	147	0,15%
Portugal	14	0,05	22	0,02%
Monaco	8	0,03%	15	0,01%
Greece	5	0,02%	45	0,04%
Turkey	3	0,01%	20	0,02%

Protocol.

State	Patents		Applications	
	<i>Origin</i>	<i>Designations</i>	<i>Origin</i>	<i>Designations</i>
	<i>Number</i>	<i>%</i>	<i>Number</i>	<i>%</i>
Cyprus	9	0,03%	9	0,01%
Totals:	27523	104,94%	100.692	99,98%

3755 *This table is sorted on the number of patents granted originating from the various*
states. If the table is however sorted according to the number of designations, there
are only minor differences in the order of the table. So it does not seem to be very
important whether the one criterion is used or the other. That being said, it seems
that a number of e.g. 4000 patents granted or 16000 applications filed could be
3760 *taken into consideration. A number like that would on the one hand make sure that*
not one country on itself could stop the protocol while on the other hand at least a
number of major players in the field would have to be on board.

Article 180 Start jurisdiction

3765 This protocol shall apply to all European patents, granted after 1 January 2000 or
such other date as decided upon by the Administrative Committees of the EPJ and
the FAC before the relevant parts of this protocol enter into force.

Article 181 First appointments

- 3770 1. For the first time the judges will be appointed by the Administrative Committee
on a proposal of the governments of the EPJ-states.
- 3775 2. The first appointed judges will take the oath meant in Article 74 in a public
meeting of the Administrative Committee.
- 3780 3. The Administrative Committee of the EPJ will also appoint from among these
judges a provisional committee and its chairman, in which all EPJ states will be
represented. The provisional committee will speedily organise the election of the
first presidents of the courts and their substitutes and of the first elected members of
the Presidium of the courts. Until these elections have taken place, the provisional
committee will fulfil the functions of the Executive Committee and of the
Presidiums.
- 3785 4. The first judges appointed shall include at least one legal judge or (during a
transitional period of 5 years after this protocol came into force) assessor and one
technical judge from every EPJ-state for each of the courts.
5. Before the first Registrar shall be appointed according to Article 56, the
Administrative Committee will appoint a Registrar at interim who will fulfil the
duties of the Registrar until the first Registrar is appointed and has taken up his
function.

¹⁵ Unclear is where this rather large rounding off error has come from. It does however not seem relevant for the purpose of this table.

Protocol.

Although the nationality of the individual judges should not be overemphasized, the EPJ should as a whole be a really European body.

3790 *Therefore this provision (paragraph 4) ensures that at least one national judge is appointed from every state.*

3795 *It could be argued that it does not make much sense to have at last two technical judges from every country at the start, as the number of technical fields is at least five. Nevertheless it is felt that a minimum participation of every member state is necessary to give the court a good start and for a fruitful exchange of ideas. That should not be too big an obstacle for member states as they all have their national patent offices as a reservoir to draw from.*

Article 182 Membership of both courts.

3800 1. During the first seven calendar years after this protocol has entered into force, judges can be member of both courts at the same time.

2. Five years after this protocol has entered into force, the EPJ states will evaluate the situation and decide whether, and if so: for what period of time, this transitory provision has to be continued.

3805 3. If no decision in that respect is taken before the end of the seven years period as mentioned in the first paragraph, this transitory provision will cease to take effect at the end of the seventh calendar year. Judges whose term of office is ending afterwards and who wish to be reappointed will have to indicate to the Executive Committee whether they want to be reappointed as judge of EPC2 or of EPC1.

3810 *The first two text proposals contained the provision that judges could be a member of both courts at the same time. (Of course not in the same cases.)*

3815 *Because of reservations with some delegations this provision is moved to the transitory rules. The time limit mentioned here is the same as that in Article 183, so as to make it not more complicated than strictly necessary. See also the attached note about art. 6-1 of the Convention on Human Rights.*

3820 *The proposal contains, as a further transitional measure, to have for a certain time the European and the national routes parallel to each other and to give the plaintiff in infringement cases the choice. If the plaintiff chooses the national route it will have to be the court of the domicile of the defendant, thus no forum shopping. On such a case the EPLP would not be applicable, neither in first nor in second instance and decisions would only have effect in the country concerned (also in case of a counterclaim for revocation).*

3825 *Proceedings for revocation (other than by way of counterclaim) and proceedings for declarations of non-infringement should always go to the European Patent Court.*

3830 *Such a transitional system would not only give the EPJ time to get accustomed to its task but also provides a safety valve just in case the EPJ would have to get rid of starting problems. If cases before the EPJ would take too long, the users of the system could fall back onto the national systems. Moreover it could set at ease countries who are unwilling to give up their national system without knowing exactly what they are getting in its place and countries who fear that regional presence would still be in want. That fear might be reduced after the European court has been functioning some time or, on the other hand, it could be that a*

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Protocol.

majority of member states would prefer to change this transitional rule into a definitive set-up.

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For a schematic overview of the effect of this transitory rule see the following table:

Protocol.

<i>Infringement proceedings regarding EPC-patent.</i>	<i>Competence of EPJ?</i>	<i>Other courts competent?</i>	
<i>1 defendant in EPJ state</i>	<i>Yes, domicile of defendant</i>	<i>Yes, if plaintiff opts for national court of defendant.</i>	<i>On basis of transitory rule!</i>
<i>1 defendant in non EPJ state</i>	<i>Yes, place of infringement</i>	<i>Yes, the national court in the non-EPJ-state.</i>	<i>On basis of “external” law: Regulation 44/2001; Conventions of Brussels and Lugano.</i>
<i>More defendants in same EPJ state</i>	<i>Yes, domicile of defendants</i>	<i>Yes, if the plaintiff opts for the national court of these defendants.</i>	<i>On basis of transitory rule!</i>
<i>More defendants in same non EPJ state</i>	<i>Yes, place of infringement.</i>	<i>Yes, the national court in the non-EPJ state.</i>	<i>On basis of “external” law.</i>
<i>More defendants in different EPJ states</i>	<i>Yes, domicile of defendants</i>	<i>No. If the plaintiff should want that he has to split up the proceedings</i>	
<i>More defendants in different non EPJ states</i>	<i>Yes, place of infringement.</i>	<i>Yes, courts of the states where the defendants are domiciled or, if art. 6 Regulation 44/2001 is</i>	<i>On basis of “external” law.</i>

Protocol.

		<i>applicable: one of those courts.</i>	
<i>More defendants, partly in EPJ partly outside EPJ</i>	<i>Yes, partly because of domicile of defendant, in all cases because of place of infringement.</i>	<i>The court in the non- EPJ state if art. 6 of Regulation 44/2001 is applicable.</i>	<i>On basis of “external”</i>

The cases where there is no other court competent, neither with the proposed rule nor without it, is dark grey.

3845 *The cases where there would be an alternative competence on the basis of the proposed transitory rule are coloured a lighter grey.*

In all other cases, left white, there will be an alternative competence anyhow.

Article 183 Transitory provision for parallel systems.

3850 During the first seven calendar years after this protocol has entered into force, a plaintiff wishing to bring infringement proceedings will, in deviation of Part III. Subsection 2.3.2, have the possibility to bring those infringement proceedings not before EPC1 but before the national court of the defendant.

3855 In that case this protocol will not be applicable to such proceedings neither at first instance nor in further instances and neither for the infringement proceedings nor for possible counterclaims raised in those proceedings.

Contrary to the original proposal it is, with a view to optimal harmonisation with Regulation 44/2001, no longer proposed to exclude the applicability of article 6 of the Brussels and Lugano Conventions and of the Regulation 44/2001.

3860 *More or less the same effect can be reached by the provision that this option for the plaintiff exists only concerning cases in which all defendants are domiciled in the same state.*

Article 184 Only effect in chosen country.

3865 Decisions of the national courts in these cases, also decisions taken on counterclaims for revocation of the European patent, will have effect only in the member state of that court.

Article 185 Evaluation.

3870 1. Five years after this protocol has entered into force, the EPJ states will evaluate the situation and decide whether, and if so: for what period of time, this transitory provision has to be continued.

3875 2. If no decision in that respect is taken before the end of the seven years period as mentioned in the first paragraph of Article 183, this transitory provision will cease to take effect at the end of the seventh calendar year. Cases pending before national courts on that moment will continue to be decided according to this provision.

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ANNEX I. PROCEDURAL LAW EPJ.

Chapter 1.Proceedings in general

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Section 1.1. General provisions.

§ 1 Time limits.

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As far as not stipulated otherwise the time limits set for the performance of certain acts can be extended by the court or the rapporteur on a written reasoned request of the party concerned, after the other party has been given, if allowed by the need for efficient despatch of the proceedings, the opportunity of being heard.

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A general power to apply time limits in a flexible way. Some time limits are regulated more strictly. E.g. the time limit for filing a statement of defence can only be extended once. See § 116 .

§ 2 Place of filing documents.

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1. Documents can be filed at the central registry or at any sub registry, as long as it is clearly indicated for which Court and/or Division they are destined.
2. The receiving sub registry shall forward the documents received immediately to the Court and/or Division for which the documents are destined.
3. If no destination is clearly mentioned in the heading of the document, the receiving sub registry will return it to the sender.

§ 3 Copies of documents filed

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1. The registry can require paper copies of any document filed in sufficient numbers as detailed in the practice directions.
2. The date and time of any document filed by hand or by post will be the date and time stamped thereupon by the receiving registry or sub registry. In the case of documents filed by fax or by electronic post, the date and time of receipt shall be the local time of receipt on the receiving apparatus at the place of the receiving registry or sub registry.

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This article opens the possibility of filing documents one hour later in GMT countries than in other countries but that is to be accepted in view of the required simplicity and certainty of the system.

This will become of even greater importance if Eastern European countries from earlier time zones will be joining the European Patent Organisation.

§ 4 Regulation of filing of claims and documents.

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The practice directions may regulate the filing of documents and e.g. prescribe certain forms to be used and the number of copies to be filed.

§ 5 Electronic filing

3925 Filing of documents can - according to the provisions given in the practice directions
- be done by hand, by post, by fax or through electronic means, as long as the date of
receipt by the Registry can be ascertained. The practice directions will regulate the
dating of electronic files.

§ 6 Notification of the parties

- 3930 1. Notification of parties and sending of communications and/or documents in a case
to parties and/or summonses or invitations for witnesses, experts or other persons to
appear before the court or to be present, shall be done by the registry by registered
mail with confirmation of receipt.
- 3935 2. The registry may according to the practice directions in certain cases perform
notifications through legal service of the documents concerned in the way judicial
documents are served in the country of domicile of the person to be served.
3. If a person refuses to receive a document or a notification from the registry, he
will be deemed to have received it and to have taken notice of it on the third day
after such refusal.
- 3940 4. The onus of proof of the refusal rests on the Registry.

3945 *The normal way of communicating with the parties and of summoning them for
conferences, oral proceedings, etc. shall be registered letter with notification of
receipt. In certain cases, e.g. where a party or a witness refuses to accept a
communication or a summons it may be advisable to serve such a document in the
way people are used to and which may give more opportunity for ascertaining the
reasons why the post is not able to get a receipt for a certain document. That can
facilitate the proof required in paragraph 4 in those cases where it cannot be proven
by postal documents. At the same time this provision makes it impossible for a
3950 person to block proceedings just by refusing to accept a judicial document.*

§ 7 Withdrawal of a claim.

- 3955 1. As long as there is no final decision in a case, a plaintiff or appellant can always
withdraw his claim or his appeal, without prejudice to counterclaims or cross
appeals filed previously.
2. In the event of such a withdrawal the court will give a decision, declaring the
proceedings closed and ordering the withdrawing party to pay the costs of the
proceedings incurred by the other party or parties, calculated according to the table
as mentioned in § 99 .
- 3960 3. Withdrawal of an appeal by all appellants makes the decision under appeal
irrevocable. If not all appellants withdraw their appeal, the effect of the decision
under appeal against all parties will be determined by the outcome of the remaining
appeal(s).

3965 *See WPLP 9/99 Annex 1, Rules of Procedure: Points to be decided sub 8).*
*It has been suggested that this possibility for a plaintiff could open the doors to
abuse of the procedural system. Normally a realistic system of cost orders should
prevent any abuse. On the other hand: why should, for instance, a patentee who felt
he had settled an infringement matter with his opponent, be forbidden to bring the
case again if the settlement turned out not to be adhered to? Other circumstances in
3970 which a withdrawn case should be able to be revived are easily imaginable.*

§ 8 Change or amendment of claim.

1. A plaintiff can at any stage of the proceedings ask for permission of the court to change his claim or claims or to amend his case.
2. This permission will not be granted if, all circumstances considered, the requested change or amendment would result in a totally fresh case, would be in clear contradiction to the plaintiff's previous case or would or unreasonably hinder the defendant in other ways in his defence.
3. Limitation of a claim will always be possible, subject to the analogous application of § 7 .

To prevent abuse of proceedings, fishing expeditions or other rash proceedings, causing costs for the other party or parties, the plaintiff should decide exactly what his case is before starting it. Nevertheless the necessary flexibility should be conserved for cases where the defence of the defendant necessitates the plaintiff to change his claims. (In most cases this will be a limitation of the claims). It should however be prevented that the case becomes a totally "fresh" case; that would make any degree of case management illusory.

§ 9 Possible stay of proceedings

The court can, at its discretion, stay proceedings before it if opposition proceedings are pending before the European Patent Office at first or second instance, if proceedings for revocation are in an advanced stage pending before a national court or for reasons of efficacy.

In some states it is not possible to start revocation proceedings if an opposition before the Office is still pending or still could be started. It is felt that it would not do to adopt such a system in the European courts because of the amount of time involved in these proceedings before the Office, that would seriously hinder (other) adversaries of the patent to put the matter before the courts. Taking into account the long time opposition and appeal proceedings before the Office usually take up it should not be made compulsory for the Courts to stay proceedings but it should be left to their discretion.

§ 10 Place of sessions.

1. If, at first instance, in proceedings that are allocated to the Central Division of EPC1 the defendant, or the main defendant, is domiciled in an EPJ-state, the first conference or any other session of the Court shall in principle be held in that state and the Court or the rapporteur will request the authorities of the national court as mentioned in Article 26 of the Protocol to provide the necessary facilities.
2. In cases allocated to a Regional Division of EPC1 the first conference or any other session of the Court will be held at the seat of that Division unless the Division or the rapporteur and the parties agree on another place.
3. At second instance the first conference or any other session of the Court will be held at the seat of EPC2, unless the parties and the Court or the rapporteur agree on another location.

The main rule is that all sessions of court of first instance will take place at the domicile of the defendant and that the sessions in second instance will take place at the seat of the court. With Regional Divisions that normally is the seat of that

4020 *division because the normal rule is that the Regional Division of the domicile of the*
defendant is the competent division. An exception would be if a certain Regional
Division was chosen by the plaintiff as the forum delicti. In that case the main rule
would be that sessions would take place at the seat of that Division; otherwise this
choice would hardly be of any use.

4025 *Nevertheless the court and the parties always can agree on another place for the*
sessions.

§ 11 Protocols of sessions.

1. Sessions of the court, other than deliberations of the panel, will be attended by a
clerk of the court, acting as recorder, provided for by the Registry or the sub-registry
serving the Division, who has command of the language of the proceedings or the
4030 other language allowed by the Court.

2. Without prejudice to the possibility of the court to have the session recorded audio
visually, the recorder will make a protocol in writing of personal particulars of the
people present and of the essentials of the events taking place at the session.

3. The recorder will follow the instructions of the court in this regard and will
4035 moreover follow the instructions as laid down in the practice directions.

4. In case of a hearing of witnesses or experts the protocol will contain the summary
as meant in § 84 .

5. The protocol will be signed by the recorder and by the judge presiding over the
session immediately after the session is closed.

4040 6. The protocol will prove that at the session happened what is related in the
protocol, without prejudice to proof to the contrary.

It is not envisaged that the protocol of the sessions should be a complete recording
of all that has been said. That would lead to very long protocols. For the relatively
4045 *seldom cases where parties or the court would want to know what exactly and*
literally has been said, audio and/or video recordings can be made.

Nevertheless what is recorded in the protocol will be regarded as established facts
as long as the contrary is not proven: that is ultimately the goal of such a protocol.

4050 ***§ 12 Copies of protocols.***

1. The Registry will send copies of the protocol to each of the appearing European
patent counsel, immediately after the sessions concerned.

2. The recorder and the presiding judge who have signed the protocol can amend
clear errors in the protocol either of their own motion or if pointed out to the by one
4055 of the European patent counsel within two weeks after the protocol was sent to them.

Clear errors must be amendable. Otherwise the contents of the protocol can only be
attacked by way of counterevidence.

§ 13 Translations during proceedings.

4060 1. If the court has allowed the use of another language than the official language of
the proceedings and the case reverts to the use of the official language of the
proceedings, the court will determine what documents have to be translated.

2. If the switch to the official language of the proceedings is a result of a request by
the court, the translations will be done under responsibility of the Registry and will
4065 be paid for by the court

3. If the switch to the official language of the proceedings is requested by a party the court will decide which party has to take care of what translations and which party has to pay for those translations. Translations of documents not produced by the parties but by the court will be translated on the basis of paragraph 2 of this provision.

4. The court may consider the translation costs, paid for by a party, in the framework of Article 159 of the Protocol.

See the explanatory notes about the language regime on page 25.

Section 1.2. Parties

§ 14 Plurality of plaintiffs

1. Proceedings can be instigated by a plurality of plaintiffs, provided that they take the same position and are represented by the same legal representative.

2. If the court is of the opinion that this requirement is not met it can separate the proceedings in two or more separate proceedings against different defendants.

3. Unless the Court decides otherwise the plaintiffs in the new proceedings will have to pay a new court fee.

§ 15 Plurality of defendants

1. Proceedings can be instigated against a plurality of defendants, provided that the claims against them are sufficiently related to justify a common decision.

2. If the court is of the opinion that this requirement is not met it can separate the proceedings in two or more separate proceedings against different defendants.

3. Unless the Court decides otherwise the plaintiffs in the new proceedings will have to pay a new court fee.

In many cases there are perfectly good reasons to have a plurality of plaintiffs and/or a plurality of defendants. If the Court however is of the opinion that the requirements are not met it is not obliged to declare proceedings, in which much money, time and energy already can be spent, non admissible. Instead it can just split of part of the proceedings and turn this part into a proceedings of its own right. Normally it is the plaintiff who decides to act together with other plaintiffs or to proceed against a plurality of defendants. In case the plaintiff has been too optimistic, there is no reason to punish the defendants with a new court fee. On the other hand there is no reason why the plaintiff should not pay the same court fees he should have paid if he had started proceedings in the right way.

§ 16 Court fees in case of plurality.

1. If and as long as a plurality of parties in a case are represented by one and the same European patent counsel and take the same positions they will be regarded as one party as far as the payment of court fees is concerned.

2. If an originally justified plurality of parties ceases, whether because some of the parties instruct another European patent counsel to represent them, because they start to defend different positions or because the proceedings are separated by the court into two or more separate proceedings, a separate court fee will be payable by the

parties leaving the collectivity or the original proceedings, unless the court decides otherwise.

4115 3. The court can in appropriate cases order that the supplementary fee has to be paid by all parties concerned together.

4120 *Other than the previous §, which regards cases in which the proceedings were started by or against a plurality without due justification, § 16 looks at cases where originally the justification for a plurality was there but it ceases to exist in the course of the proceedings, for instance because of the basis of the defence of one or more defendants.*

4125 *The last sentence of this paragraph looks at cases where for instance some of the parties start to defend a diverging point of view on a point that before not was discussed at all, without it being possible to say that some parties “left the collectivity”.*

§ 17 Third parties and change in parties.

4130 1. The court may, on the application of either an existing party or a person who wishes to become a party, order a person to be added as a new party, to cease to be a party or to be substituted for an existing party.

2. When deciding that a person shall become a party or shall cease to be a party the court may make appropriate orders as to payment of court fees and other matters of costs as regards such party or parties.

4135 *There are three aspects under which third parties can become involved in proceedings between two parties:*

1. *a third party wants to support one of the parties*
2. *a third party wants to defend his own interests in a case*
3. *the defendant (main defendant or defendant against a counterclaim) is of the opinion that, if he loses, a third party will have to indemnify him.*

4140 *Most continental systems give quite detailed regulations about these situations, thereby making a distinction between these situations.. See e.g. artt. 66, 325-338 and 555 of the French Nouveau Code de Procédure Civile and §§ 64 –77 of the German Zivilprozessordnung. The English Civil Procedure Rules seem to prefer a more general regulation of third parties taking part in the battle: see Parts 19 and 20 of the Civil Procedure Rules and the Practice Directions pertaining to these rules.*

4145 *It is felt that this more flexible approach should be followed in this proposal, not least because intervention of third parties in patent cases is rather exceptional. Therefore a rather general rule is formulated here and some more details are given in the chapter on special proceedings at first instance, that could be declared to be also applicable in appeal proceedings.*

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§ 18 Application and decision.

4155 1. An application as meant in § 17 must be made through a European patent counsel, using a form as prescribed by the practice directions.

2. The Court shall decide the issue with the utmost expedition, after having given the other party or parties the opportunity to give their views on the application, within three weeks after a copy of the application was sent to them by the Registry, or within such other time limit as set by the Court.

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Of course an application to change parties in whatever way regards the other party or parties, as they will be confronted with other, more or fewer opponents, possibly of poorer financial power and/or putting them in a poorer position as to evidence. Therefore the Court should hear them about their views. Nevertheless this could be done quite informally by letter. In how far the discussion is to go on is left to the court.

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§ 19 Consequences for proceedings.

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1. In all cases where the court shall order the adding of a party, the removal of a party or the substitution of a party it shall give directions to regulate the consequences as to case management.
2. It shall also determine the extent to which the new party is bound by the proceedings as then constituted.

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§ 20 Death or demise of a party.

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1. If a party dies or ceases to exist during proceedings, the proceedings will be stayed until such party is replaced by his successor or successors.
2. The court can fix a time limit in this respect.
3. If there are more than two parties to the proceedings, the court can rule that proceedings between the remaining parties be continued separately and that the stay will only concern the proceedings regarding the party that no longer exists.
4. If the successor(s) of the party that ceased to exist does or do not continue the proceedings of his or their own motion, within a time limit set by the court, any other party may, of its own motion or on an order of the Court, file continuation proceedings against such successor(s).
5. Continuation proceedings will be brought before the court in the normal way. In continuation proceedings the court will decide whether and if so to what extent the defendants will take the position of the party that ceased to exist in the main proceedings.
6. The costs of continuation proceedings will be decided independently from the costs in the main proceedings and solely on the basis of the outcome of the continuation proceedings.

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In the simplest case of proceedings between only two parties A and B where B dies, the court will stay the proceedings as soon as this is pointed out to the Court. The Court will fix a time limit and party A will invite the successors of party B to continue the proceedings in place of party B. If the successors of party B do that, the problem is solved with a minimum loss of time and costs.

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If the successors of party B refuse to take over the proceedings (perhaps because they deny that they are the successors of party B or because not all successors are of the same mind), then party A will start another set of proceedings against them: the so called continuation proceedings. The sole subject of these proceedings would be the question whether the defendant(s) is/are the successors in law of the deceased party and, if so, to have them set in the place of the deceased party in the main proceedings.

§ 21 *Insolvency of a party.*

1. If a defendant to proceedings becomes insolvent according to the national law of his state of domicile, the plaintiff may withdraw the case against this defendant on the basis of § 7 .

2. The costs mentioned in that article will be payable to the competent national authority or person dealing with this bankruptcy. Such withdrawal will not prejudice the case against the other defendants.

3. In other cases the proceedings between the insolvent party and his opponent(s) will be stayed ex officio until the competent national authorities dealing with this bankruptcy have decided whether to continue the proceedings or not.

4. If proceedings are continued the effect of a decision of the court as regards the insolvent party in the case will be determined by the national law of the bankrupt party.

As matters of insolvency are dealt with very differently in member states, it seems best to separate the insolvency and its consequences as much as possible from proceedings before the supranational courts. On the other hand such proceedings should not be hindered or delayed more than strictly necessary.

§ 22 *Transfer of the patent during proceedings.*

1. If a patent is transferred, for all or for certain designated states, to another proprietor after proceedings have been filed, the new proprietor will be allowed by the court to take over the proceedings to the extent that the patent has been transferred to him.

2. If the new owner takes over the proceedings no new court fee will be levied, even if the new owner is represented by a new European patent counsel.

3. If he chooses not to do so any decision in proceedings that have been registered in the register as mentioned in § 108 can nevertheless be held against him.

The new owner of a transferred patent can take over the position in pending proceedings of the former patentee. If he chooses not to do so although the proceedings were to be known to him by consulting the Register of cases at the Registry, then he has to accept the outcome of the proceedings. (Which could be bad if the former patentee would file an application to be removed as a party.) The alternative would be to allow the new patent proprietor to block pending proceedings by simply doing nothing.

Section 1.3. Counsel

§ 23 *European patent counsel.*

1. Parties must be represented before the court by a lawyer registered by the Registrar as a European patent counsel according to Article 139 of the Protocol.

2. The Registrar shall register as a European patent counsel any lawyer who is entitled to practise and represent parties in normal civil proceedings before a civil court of an EPJ- state and who applies in writing for such registration, thereby stating an address in an EPJ-state at which he practices.

3. The practice directions can prescribe a certain form for these applications.

4255 *See the explanatory note before Article 139 of the Protocol about the necessity of compulsory legal representation and about the requirements for European patent counsel.*

4260 *The idea of an annual financial contribution should be considered in order to keep the register of patent counsel up to date. To prevent it being set too high, which could prevent counsel from maintaining their registration, it is stated that it should be a contribution in the costs of administration.*

§ 24 De-registration.

4265 1. If a European patent counsel ceases to comply with the requirements set out in Article 139, the Registrar will, ex officio or at the request of the European patent counsel or a third party, remove the name of the European patent counsel from the register.

4270 2. Unless the Registrar is acting on the request of the European patent counsel, he will give the European patent counsel or his successors in law the opportunity of being heard and inform him or them about his decision.

§ 25 Redress

4275 1. If the Registrar refuses to register an applicant or has removed the name of a European patent counsel the applicant or the European patent counsel concerned can ask EPC2 for redress.

2. A panel of EPC2, appointed for that purpose by its President, will discuss the case in camera with the Registrar and the applicant for redress. EPC2 can order the Registrar to register the applicant for redress.

4280 *Some kind of redress should be possible against decisions of the Registrar not to register (any longer) an European patent counsel. It is however felt that this should not be a full blown appeal case but rather a short informal discussion of the case, resulting in a confirmation of the decision of the Registrar or an order to the Registrar to register the applicant.*

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§ 26 Powers of attorney.

1. Every European patent counsel who claims to be representing a certain party will be believed upon his word in that respect.

4290 2. The court can however order a European patent counsel to produce a written authority if his representative powers are challenged by the party concerned or if another party to the proceedings has established reasonable doubt as regards those representative powers.

4295 *Here exist two possibilities: either an attorney stating that he is representing a certain client is believed upon his word until challenged by that client, or every attorney has to file in every case a power of attorney. The latter system seems at first glance to give the most legal certainty but at closer inspection that is not the case. Apart from the problems arising if errors are made in the written powers of attorney (e.g. typing errors or forgetting that a certain affiliate company has recently changed its name) and the consequences thereof, the question*

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about the legitimacy of the representation is just shifted to the question of the powers of the person(s) signing the power of attorney.

§ 27 Death or bankruptcy of a legal representative

- 4305 1. If a European patent counsel dies or becomes insolvent while proceedings before the EPJ are pending in which he is representing one or more of the parties, the court will grant the party or parties concerned a term within which that party or parties may engage another European patent counsel.
- 4310 2. If after the completion of that term no other European patent counsel has taken the representation of that party or parties in hand, the proceedings will continue as if the party or parties concerned have rested their case and are asking for a decision on the basis of the documents already filed.

§ 28 Change of a legal representative.

- 4315 1. Change of a representing European patent counsel only takes effect from the moment another European patent counsel has stated in writing to the Registry that he will in future be representing the party concerned.
- 4320 2. Until that moment the formerly appointed European patent counsel remains responsible for the conduct of the proceedings and for communications between the court and the party concerned.

Contact between the court and a party should continue even in the event of problems between a party and its European patent counsel.

4325 **Section 1.4. Panels and judges**

§ 29 Appointment of panels

- 4330 As soon as possible the President of a court before which a case is brought will appoint a panel of judges in accordance with Article 97 and Article 104 and the rules created according to those provisions, designating one of its members as chairman and at least one other member as rapporteur.

See the explanatory note under Article 104 .

4335 ***§ 30 Assessors***

If there are assessors appointed to the court, the President will take care that an assessor is appointed as supernumerary member of a panel as often as is feasible with regard to an efficient functioning of the court and its panels.

- 4340 *If a system of training is envisaged it should be used. To minimise the risk of assessors not being appointed because of the extra work involved, it seems worthwhile to emphasize this.*

¹⁶ The President as meant in this § is for a Regional Division the Divisional president chairing that Regional Division, because of Part III. Subsection 2.3.1 Article 88 EPLP.

§ 31 Excusal and challenge.

- 4345 1. No judge may take part in the disposal of any case in which he has previously taken part as adviser or has acted for one of the parties, or in which he has been called upon to pronounce as a member of another court or tribunal, of a commission of inquiry or in any other capacity.
2. If, for some special reason, any judge considers that he should not sit in a particular case, he shall so inform the President of his court.
- 4350 3. If, for some special reason, the President of a court considers that any particular judge should not sit in a particular case, he shall notify him accordingly.
4. A judge may be objected to, in the ways prescribed by the practice directions, by any party for one of the reasons mentioned in the first paragraph or if reasonably suspected of partiality.
- 4355 5. A party may not apply for a change in the composition of the court or one of its panels on the grounds of either the nationality of a judge or the absence from the court or the panel of a judge of any nationality.
6. Any difficulty arising as to the application of this article shall be settled according to the practice directions by the decision of a panel of the court on which the
- 4360 disputed judge is not sitting.

4365 *See Art 11 Protocol on the Statute of the Common Appeal Court. In the third paragraph is introduced the notion that a suspicion of partiality should be reasonable, so as to provide the panels deciding on objections with a criterion for their decision. Further details as regards the form in which and the time limit within which objections can be raised should be dealt with in the practice directions.*

§ 32 Changes in the panel.

- 4370 1. If a member of a panel dies, becomes unable to perform his duties because of illness, retires, is excused or successfully challenged, the President of the court will appoint a judge to replace him, taking into account the rules for the appointment of panels according to Article 97 and Article 104 .
2. If a change in a panel occurs after oral proceedings have taken place, any party can request that new oral proceedings will be held.

4375 *In case the term “taking into account the rules for the appointment of panels (...)” would be thought a little vague one could for instance have a look at the example of such rules as given in Annex IV. If a rapporteur from Regional Division X would fall ill, the President of the competent Division should take the next judge of that Division whose turn it would be to become rapporteur and he should take over as rapporteur. In case the chairman or the technical judge would fall ill he would in the same way take the next judge then in line on the list concerned.*

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Section 1.5. Case management

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§ 33 Case managing task

1. During the written and the instruction stages of the proceedings case management will primarily be the responsibility of the rapporteur.
2. After the closure of the debate as mentioned in § 57 it will primarily be the
- 4390 responsibility of the chairman.

§ 34 Revision of case management decisions.

1. Case management decisions taken by the rapporteur or the chairman can on request of a party be revised by the full panel, that will hear the other party or parties concerned.

2. A request for revision of a case management decision should be filed within two weeks after the decision has been sent to the party concerned.

3. The practise regulations may stipulate that a fee will be payable for such a request.

§ 35 Consequences of revision.

1. If a request for revision of a case management decision is opposed by another party and the request is not granted or not wholly granted, the panel may give an order that the requesting party will have to pay reasonable costs made by the opposing party.

2. Decisions about costs in this respect shall be appealable together with the final decision in the case or after the case has been withdrawn.

§ 36 Active management.

Active case management includes:

- (a) encouraging the parties to co-operate with each other in the conduct of the proceedings;
- (b) identifying the issues at an early stage;
- (c) deciding promptly which issues need full investigation and trial and accordingly disposing summarily of the others;
- (d) deciding the order in which issues are to be resolved;
- (e) encouraging the parties to use an alternative dispute resolution procedure if the court considers that appropriate and facilitating the use of such procedure;
- (f) helping the parties to settle the whole or part of the case;
- (g) fixing timetables or otherwise controlling the progress of the case;
- (h) considering whether the likely benefits of taking a particular step justify the cost of taking it;
- (i) dealing with as many aspects of the case as the court can on the same occasion;
- (j) dealing with the case without the parties needing to attend in person;
- (k) making use of technology; and
- (l) giving directions to ensure that the trial of a case proceeds quickly and efficiently

See pars. 1.4 and 3.1 of the English Civil Procedure Rules. It seems clear that the speedy and just dealing with cases before the court can only be accomplished if the courts have the power (and the duty) to manage the cases. Experience teaches that cases tend to slow down if left to the parties themselves. Although that may seem their own problem, in reality it is not. Cases in the list of the court tend to slow down the functioning of the court and to increase the workload of the registry. Again: if a case comes up again after a long time, the judge (anyway the judge rapporteur) will have to study the case again, thereby losing precious time and energy. That time and energy could and should have been used for other cases

Rules of Procedure EPJ.

4440 *of other parties. Therefore it is felt that, once a case is brought before the court, it is no longer the sole responsibility of the parties to bring it to an end but also that of the court.*

Case management will be the prime responsibility of the rapporteur till the closure of the debate and, after that, that of the chairman.

§ 37 Managing powers.

4445 Except where the Protocol, these Rules of Procedure or the practice directions expressly provide otherwise, the court may –

- (a) extend or shorten the time for compliance with any rule, practice direction or court order (even if an application for extension is made after the time for compliance has expired);
- 4450 (b) adjourn or bring forward a hearing;
- (c) require a party or a party's legal representative to attend the court;
- (d) hold a hearing and receive evidence by telephone or by using any other method of direct oral communication;
- (e) direct that part of any proceedings (such as a counterclaim) be dealt with as
4455 separate proceedings;
- (f) stay the whole or part of any proceedings or judgment either generally or until a specified date or event;
- (g) consolidate proceedings;
- (h) try two or more claims on the same occasion;
- 4460 (i) direct a separate trial of any issue;
- (j) decide the order in which issues are to be tried;
- (k) exclude an issue from consideration;
- (l) dismiss or give judgment on a claim after a decision on a preliminary issue makes a decision on further issues irrelevant to the outcome of the case;

§ 38 Varying or revoking orders

1. A power of the court to make a managing order includes a power to vary or revoke such order.

2. Applications for variation or revocation of an order of EPC1 shall be allocated to
4470 the Division of the court that has made the order.

§ 39 Exercise of managing powers

4475 Except where a rule or some other enactment provides otherwise, the court may exercise its management powers on the application of a party or possible party or of its own motion.

§ 40 Own initiative of the court

Where the court proposes to make an order of its own motion –

- 4480 (a) it may give any person likely to be affected by the order an opportunity to make representations; and
- (b) where it does so it must specify the time by and the manner in which such representations must be made.

§ 41 Hearing of the parties

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Where the court proposes –

- (a) to make an order of its own motion; and
- (b) to hold a hearing to decide whether to make the order, it must give each party likely to be affected by the order at least 3 days' notice of the hearing.

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§ 42 No hearing of the parties

1. The court may make an order of its own motion, without hearing the parties or giving them an opportunity to make representations.

2. Where the court has made an order under paragraph 1:

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- (a) a party affected by the order may apply to have it set aside, varied or stayed ;
and

- (b) the order must contain a statement of the right to make such an application.

3. An application under the former paragraph must be made :

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- (a) within such period as may be specified by the court; or
- (b) if the court does not specify a period, not more than two weeks after the date on which the order was served on the party making the application.

See pars. 3.3. of the English Civil Rules of Procedure. The first sentence of § 39 speaks for clearness' sake expressly of managing powers, so as to distinguish from other powers of the courts mentioned in this protocol.

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§ 43 Tasks of the judge rapporteur

The rapporteur:

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- shall make a preliminary study of the case
- may communicate with the parties to instruct them about wishes or requirements of the court;
- will organise and conduct the first conference with the parties and any hearings taking place before him;
- will manage the cases allocated to him until the closure of the debate;
- will endeavour to have the instruction of the case completed as far as possible;
- 4515 - will declare the debate closed when the case is fit for oral proceedings or for decision
- will hear witnesses and experts if both parties so desire.

Section 1.6. Stages of proceedings

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§ 44 Three parts.

Proceedings before the court shall include a written part and can include an instruction part (starting with a first conference) and/or an oral part.

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Subsection 1.6.1. Written part

§ 45 Contents of written part.

- 4530 1. The written part shall consist in the exchange of the written documents as specified in these Rules of Procedure for the first instance in Chapter 2 and for the second instance in Chapter 3 and those other documents that are allowed by the Court or the rapporteur.
2. The Court or its rapporteur can allow the parties to exchange, within time limits set by the Court or the rapporteur, more written statements if it thinks fit.
- 4535 3. The Court or its rapporteur can require the parties to answer certain questions in writing, without prejudice to the application of § 70 or § 71 , within a time limit set by the court or the rapporteur.

See Art. 13 Protocol on the Statute of the Common Appeal Court

4540 *The idea is to enable the court or the rapporteur to have the debate complete. The position of the parties should be clear all along the line. As regards clarity: besides the matter of the clarification of the positions taken by the parties, there is of course the matter of evidence. That is taken care of in subsequent subsections. Just to make sure that the provisions given there are not superseded by the provisions given here, there is incorporated a short reference to the provisions about evidence.*

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Subsection 1.6.2. Instruction part

§ 46 Contents of instruction part.

4550 The instruction part shall consist of a conference of the parties with the judge-rapporteur, of such other exchanges or measures as the rapporteur thinks necessary and, if appropriate, the taking of evidence in whatever form.

§ 47 Dates of non availability of the parties.

4555 Preferably when forwarding a copy of the last written document filed during the written part, the registry will under the supervision and responsibility of the rapporteur direct the parties to state, within a time limit set by the rapporteur, the dates (within a period of time mentioned in that direction) on which they would have difficulty in attending a first conference with the rapporteur.

4560 **§ 48 Summons for first conference.**

1. After receiving the response of the parties, or at the latest after the expiration of the time limit set for that response, the rapporteur will fix a date, time and place for a first conference with the parties.
- 4565 2. The registry will communicate the date, time and place for the first conference to the parties, (unless both parties agree on a shorter term) at least thirty days in advance.
3. If all parties and the rapporteur however agree, the first conference can be held by telephone or by video conference. In that case audio- resp. video recordings will be made of the conference, which will be sent to the parties. The practice directions can include rules about the costs of these recordings and copies.
- 4570 4. The rapporteur can allow one or more parties to participate in a conference held in court by way of video conference. The costs of that video-participation, as further detailed in the practice directions, will be paid by the party applying for it.

4575 *That the first conference should in principle be held in the country of the defendant*
is one of the consequences of the principle of maximal possible local presence for
EPCI. See also § 10 above. Nevertheless room should be given for development of
4580 *modern communication techniques, especially if one of the participants is domiciled*
in another continent and it would be foreseeable that during the first conference not
much is going to happen other than e.g. setting a time schedule for the proceedings.

§ 49 Rapporteur conducts first conference

The rapporteur will conduct the conference and will have all authority to ensure a
fair, orderly and efficient conduct of the conference and the proceedings

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§ 50 Further clarification during or before first conference.

1. The rapporteur can indicate points on which the court needs further clarification,
to be provided during or before the first conference.
2. The rapporteur can request the parties to file during or before the first conference
certain documents or answers to certain questions.

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§ 51 Possible settlement.

1. If the rapporteur is of the opinion that the case could be suitable for a settlement
or for alternative dispute resolution, he will communicate such to the parties.
2. Parties will always have to be prepared to discuss the possibilities of a settlement
during the conference and have instructed and mandated their representatives at the
conference to that end.

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A conference like the first conference is in principle a very suitable instrument to
4600 *research the possibilities of a settlement. It would however be causing much extra*
costs if the parties would be appearing at the conference and state that they were not
instructed to deal with settlement negotiations. This paragraph tries to prevent that
risk as much as possible. Certainly parties are in no way obliged to settle but the
4605 *effect of this paragraph will be that they simply state that they do not want a*
settlement and do not hide behind the smokescreen of saying that they are not
instructed to negotiate settlement. That at least should prevent unnecessary
adjournments of the conference.

§ 52 Aim of first conference

The purpose of the first conference is to identify and if necessary clarify the main
issues in the case and the position of the parties as regards those issues, to fix a
further time schedule for the proceedings and to examine the possibilities of an
amicable settlement between the parties.

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See also § 54 .

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§ 53 Possible continuation of first conference.

If the rapporteur thinks fit he can adjourn the first conference and fix a place, date
and time for its continuation.

4620 **§ 54 Further instruction.**

1. During the instruction phase of the proceedings the rapporteur will endeavour to ensure that the evidence is as complete as necessary for the efficient conduct of oral proceedings, in order that these will so far as possible lead to a final decision in the case.

4625 2. To that end the rapporteur can allow parties to hear witnesses (§ 73), can appoint an expert (§ 87), can order experiments (§ 94), can order the production of documents (§ 70) or request certain documents (§ 71) or order a local inspection.
3. The rapporteur will fix the dates and time limits for these events as soon as possible.

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§ 55 Hearing of witnesses.

1. If the rapporteur has given a party leave to hear witnesses, he will organise the hearing.

4635 2. The witnesses will according to the provisions of Subsection 1.7.3. and the practice directions. Therefore the hearing will be by the full panel unless both parties request the hearing by the rapporteur only or the panel delegates the hearing to the rapporteur.

4640 *So, although the rapporteur can give a party the necessary leave to hear witnesses, the hearing itself is not necessarily done by him. The main rule is applicable here: the hearing of witnesses is done by the whole panel, unless all parties request that it is done by the rapporteur or the panel delegates it to him. This main rule is expressly repeated here to prevent any misunderstandings.*

§ 56 Date for oral proceedings.

4645 1. If one or more of the parties have requested oral proceedings, the rapporteur will endeavour to ascertain the dates on which the parties would have difficulty in attending oral proceedings in the period of time in which those oral proceedings will probably be fixed.

4650 2. If possible the rapporteur will, after consultation of the other members of the panel, the date, time and place for the oral proceedings.

§ 57 Closure of the debate.

1. As soon as the rapporteur decides that the instruction phase is completed, he will send a communication to the parties, declaring the written debate closed.

4655 2. He will report the closure of the debate to the chairman of the panel, who will take over the management of the case.

The closure of the debate is a clear point in time after which it is impossible for the parties to continue the debate until the debate is reopened, for instance at the oral hearing.

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Subsection 1.6.3. Oral proceedings

§ 58 Deliberation

4665 If none of the parties has requested oral proceedings, the chairman of the panel will initiate and organise the deliberation among the members of the panel and ensure a speedy decision.

§ 59 Fixing date for oral proceedings.

4670 If any party has requested oral proceedings before the closure of the debate, or if one of the members of the panel desires such oral proceedings, the chairman will, taking into account as far as possible the statements of the parties as mentioned in § 56 fix a date and place for the oral proceedings, unless this was already accomplished by the rapporteur.

§ 60 Possible preliminary discussion.

4675 Every member of the panel can require a meeting of the panel for a preliminary discussion prior to the oral proceedings or to discuss the desirability of oral proceedings.

§ 61 On request or ex officio

4680 1. Oral proceedings will be held when one of the parties or the court so requires.
2. A request for oral proceedings by a party will be honoured when it is filed before the closure of the debate.

4685 *In principle the parties have a right to an oral hearing. To avoid situations in which the court has already come to a decision and only then gets a request for an oral hearing, a time limit has to be set for the request for oral proceedings. The closure of the debate seems to be the best moment: when the chairman gets the case to manage he should know whether to organise oral proceedings or to first organise a consultation of the panel. After that moment it is in the discretion of the court to grant a request for oral proceedings or not.*

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§ 62 Contents of oral proceedings

4695 1. The oral proceedings shall consist, after the reopening of the debate by the chairman, of the hearing of the parties, who can be given leave to address the court, and their representatives and/or technical advisers.
2. The Court can stop the pleadings of a party, its representative or its technical adviser if it is of the opinion that it is sufficiently informed.
3. If the court thinks fit it can decide to hear witnesses or further witnesses and/or experts during the oral proceedings.
4700 4. The panel can communicate to the parties, before or during the oral proceedings, a provisional opinion. The panel will in no way be bound by this provisional opinion.

4705 *The first part of this paragraph ensures the right of the parties to plead their case. The second part will hardly ever be applied but gives the possibility to stop filibustering. Without this sentence the chairman would nevertheless have that possibility under § 63 , but this measure is of so far reaching effect that it should be left to the panel as a whole.*

Rules of Procedure EPJ.

4710 *In many cases the necessary evidence will be complete before the oral pleadings start. In exceptional cases however it should be possible for the court to hear extra witnesses and/or to hear the experts about the reports filed by them.*

§ 63 Directions

- 4715 1. The oral proceedings will be presided over by the chairman of the panel.
2. He shall have all authority necessary for the fair, orderly and efficient conduct of the proceedings.
3. The oral proceedings are public unless the panel decides otherwise.
4720 4. The court shall endeavour to ensure that the case is ready for decision at the end of the oral proceedings and the chairman shall announce the date on which the decision shall without prejudice to the possibility of an adjournment, be given in writing.
5. Any party can request that the decision will be pronounced at a public session of the Court.

The last sentence ensures the public character of the decisions given by the courts.

4725 **§ 64 Parties not present at oral proceedings.**

The court shall not be obliged to delay any step in the proceedings, including its decision, by reason only of the absence from the oral proceedings of any party, who shall then be treated as relying only on its written case and not wishing to contradict any new statements of fact that may have been made and allowed at the oral
4730 proceedings.

Oral proceedings are a time- and money consuming affair. It should not be possible for one of the parties to obstruct the course of the proceedings by just not turning up at the proceedings. If there is a good reason for the absence of a party, there is of course the discretionary power of the court to remedy that absence.

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§ 65 Deliberation.

1. The chairman shall preside over the deliberations of the panel.
2. The practice directions can give rules about the order of voting.

§ 66 Decisions

- 4740 1. The decision of the court shall be given in writing as soon as possible after the closing of the debate.
2. If no decision is sent to the parties within three months after the end of the oral proceedings, any party can request new oral proceedings.

4745 *This article could not only act as a certain incentive to the panel to have its decision ready within a reasonable time but also serves a substantial goal: cases not decided within this time limit probably are not easy. Also some arguments could have been clouded over by time. In both cases there should be a possibility for refreshing the minds of the judges and/or to give further arguments.*

4750

Section 1.7. Evidence

Rules of Procedure EPJ.

Evidence is an important but difficult matter, not only in terms of legal theory but also from a practical point of view.

4755 *It is an accepted principle that a party who states a fact on which he is relying normally has to prove that fact if it is disputed.*

4760 *In a system where a party is obliged to collect all possible evidence before the proceedings do start, so as to be in a position to prove his points if necessary, a lot of unnecessary work and costs is wasted (especially in case of evidence by witnesses and/or experts) because it will normally turn out that only part of the facts are disputed and are in need of proof.*

4765 *On the other hand there are the systems where first a debate between the parties takes place, whereupon the judge decides which points are both relevant and not proven and who has to prove them. That involves a judicial decision, involving: a) time and b) normally implicitly or explicitly, the decision about the onus of proof, i.e. the decision that if the party in question does not succeed in proving the point in question, that point will be decided against him.*

4770 *In the European patent courts normally a case should be ripe for decision after the oral proceedings. That means that normally there should not be first an interim decision of the court about (the onus of) proof and evidence but if possible immediately a decision about the dispute itself.*

4775 *That would point in the direction of delegating the decision about the question which party is going to have to bring witnesses etc. to the judge rapporteur, in order to have the case ready at the time of the oral proceedings, also from a point of view of evidence. It could however be difficult to delegate this decision about the onus of proof to the judge rapporteur as unus iudex. Especially because the question who has the onus of proof can be de facto decisive for the outcome of the whole proceedings.*

4780 *On the other hand: in the majority of cases there can be hardly any dispute about the question which party has to prove a certain point. In those cases it would be a waste of time and energy to have the whole panel forcibly deciding about that point.*

In the following proposal a compromise has been sought.

4785 *The main rule should be that any party, relying on a stated fact, should offer proof of that fact. Such at the latest as soon as such a statement is contested or, when a party should reasonably have expected such a contestation, at the time of making the statement for the first time. The courts are free to disregard any statement of fact of which no proof is offered.*

4790 *The offer of proof should specify what kind of proof the party is willing to bring: written evidence, witness evidence, expert evidence, inspection by the court, etc. Moreover the party concerned should, unless there are clear reasons for not being able to do so, specify what evidence of that kind he wants to bring (especially: names of witnesses).*

4795 *Written evidence generally is not much of a problem: written evidence consumes relatively small amounts of money, time and energy. Therefore written evidence (including the aforementioned affidavits of witnesses) should be filed as soon as reasonably to be expected from a party. (See above) Furthermore the court*

4800 *should always have the possibility of requesting certain documents.*

Rules of Procedure EPJ.

4805 *The only problem with written evidence is the matter of disclosure, formerly also called discovery. This proposal does not propose anything like the disclosure/discovery as it is known in the UK (see Civil Procedure Rules part 31) or other common law countries as it seems generally to be thought too cumbersome and too costly. Nevertheless it seems generally to be felt among practitioners that there should be a possibility to force a party to bring into the proceedings certain documents whose existence is known but that are in the possession of the other party. Therefore a system is proposed, in which the court may, on the request of a party, order the other party to bring certain documents into the proceedings and/or allow inspection of the (original) documents. To avoid confusion the term 'disclosure' is not used. Instead the proposal uses the term 'production of documents'.*

4815 *As witnesses are the most time- and cost consuming kind of evidence, in principle all evidence by witnesses should be produced in the form of written affidavits.*

4820 *A hearing of the witness in person takes only place if there was no possibility to get an affidavit (e.g. because the witness refused) or if the contents of the affidavit are contested by the other party or when one or more members of the judicial panel want to hear the witness in person.*

Witnesses will only be heard in person after leave has been given by the court and only on points formulated by the court.

The court can give its leave in two forms:

4825 *either through a decision of the rapporteur,*

or through a decision of the full panel.

If the rapporteur refuses the leave to hear one or more witnesses, redress can be sought by the interested party with the full panel.

4830 *This system means that in a plurality of cases the rapporteur can have the case ready for decision at the time of the oral proceedings, as normally it will be known what evidence there is (or is not) available about the relevant disputed points.*

4835 *The question about who has to give leave to bring witnesses has to be distinguished from the question who is going to hear the witnesses and who is mainly formulating the questions.*

4840 *In my view it should be left to the court to decide in every individual case whether the witnesses will be heard by the full panel or by one of its members, possibly the rapporteur or the technical judge. Nevertheless the hearing by the full panel is the main rule. However if both parties request that the hearing (of one or of more witnesses) should be done by only one judge (be it the rapporteur or the technical judge) than it is hard to see why their wish should not be followed: after all it will be the parties that are going to have to pay for the costs of gathering the whole panel together.*

4845 *Moreover: if the panel does not want to use its right to hear all witnesses themselves, it can delegate the hearing (again: for one or for more witnesses) to one or more of its members. As it is foreseeable that in many cases the panel will want to avoid unnecessary travelling and will be tempted to delegate the hearing of witnesses, it seems a good idea to require that audio recordings will always be made and that video recordings can be ordered by the court. It should also be possible*

4850 *that one or two of the members of the panel take part in the hearing of witnesses by*

way of video-conferencing. (That would put upon the EPLP-states the burden to have the facilities for video conferencing at the disposal of the European patent courts in at least one court building)

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With evidence in general there should furthermore be some regulation to protect confidential knowledge in the form of a protective order.

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Subsection 1.7.1. General provisions

§ 67 Consequence of not contesting.

A statement of fact which is not or not duly motivated contested by the other party shall, without prejudice to Article, be held between the parties to be true.

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§ 68 Offer of proof.

1. Every party, making a statement of fact he knows or has good reason to know that the other party is or will be contesting, has to state in which way he is willing and able to prove it. In case of default of such an offer of evidence the court can, according to its discretion, disregard such a statement of fact.

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2. Unless the court gives a reasoned decision to the contrary, the onus of proof of facts is on the party who is relying on these facts.

Exceptionally there could be such a difference in accessibility of certain evidence that justice and efficiency both require the shifting of the onus of proof. This should however be an exception for which the court should give reasons.

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Subsection 1.7.2. Written evidence.

§ 69 Written evidence.

Written evidence available to a party regarding a statement of fact that is contested or should reasonably be expected to be contested should be produced as soon as possible by attaching it to a statement in the proceedings or filed separately on the request of the court or the rapporteur.

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A party should attach written evidence that he has in his possession and should know is relevant. If he omits to do so, he can only file the evidence at the request of the court: there is in this system no place for other documents to be filed during proceedings as those expressly stated in these rules of procedure.

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§ 70 Orders for production of documents.

1. If a party makes it reasonably plausible to the court that one or more certain documents, to be individualized to the requirements of the court, that are relevant to the case, are in the possession of the other party, the court may order this other party to produce the document or documents in the proceedings.

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2. Requests for such an order will be addressed to the Court but will be send to the rapporteur.

Rules of Procedure EPJ.

3. If the rapporteur does not succeed in reaching a speedy agreement between the parties on this issue, he will arrange for the panel to give its decision as speedily as possible.

4900 4. The court can specify under which conditions, in what form, in what way and within what time limit the production will have to take place and what sanction will be incurred if production does not take place according to the order.

4905 5. The court may also order a third party to produce evidence as mentioned in the first paragraph, taking into due account the interests of that third party, if it is made probable that that third party is in possession of this evidence due to its relationship to the opposing party mentioned before.

4910 6. The court may order that the originals of the documents will have to be filed at the Registry and in that case will state to whom these documents will be open for inspection. The court may give further rules regarding filing, keeping and inspection of original documents and/or copies in the practice directions.

As regards the position of third parties, see the explanation at Article, of which article this article is an implementation. (Article 117 however is formulated more generally and covers also other kinds of evidence than documents.)

4915 *It is envisaged that in many cases an experienced rapporteur will be able to settle the matter between parties. If he does not succeed he should sent the arguments of both parties to the other members of the panel, who then will decide after such consultation with each other as they think fit.*

§ 71 Request of the court for documents

4920 Without prejudice to § 69 and § 70 , the court or the rapporteur can at any time during the proceedings request a party to file a certain document or affidavit. In case a party should not comply with such a request the court shall draw those conclusions its thinks fit.

4925 *In contrast with the former article, that deals with an application of a party, this article provides for the situation that the court itself feels it needs certain documents or written proof. In that case there seems no need for astreintes etc. but the sanction of the court drawing certain conclusions seems to be sufficient. See also Article 115 .*

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Subsection 1.7.3. Witnesses.

§ 72 Witness statements normally by way of affidavit.

4935 1. A party that wants to offer witness evidence, shall normally provide the court with an affidavit, signed by the witness, containing the witnesses statement.

2. The affidavit will contain the statement that the witness is conscious about the fact that a misrepresentation of facts in the affidavit can be regarded by national courts as a criminal offence.

4940 3. If there is produced nor an affidavit nor an explanation why it was not feasible to produce an affidavit, the court may disregard the offer of evidence by this or the witness(es) concerned.

Rules of Procedure EPJ.

§ 73 Witnesses only heard after leave.

- 4945 1. Witnesses can be heard only after the court or the rapporteur has decided in writing to give leave for such a hearing.
2. Without prejudice to the provisional measure as mentioned in Subsection 2.2.3. off these Rules of Procedure, leave will only be given if the facts about which the witness can be heard are relevant to reach a decision in the case and:
- 4950 - an affidavit by that witness is challenged by a party or
- no affidavit could be obtained from that witness or
- one or more members of the panel do wish to hear the witness in person.
3. Such a leave shall formulate the facts to be proven by the hearing of the witnesses.
4. It will name, or at least indicate, the witness or witnesses to be heard. The leave will only extend to the witnesses named or indicated.

4955 *Normally the court will know the names of possible witnesses because of the obligation of the parties to offer proof as laid down in § 68 .*

§ 74 Evidence to the contrary.

- 4960 1. If a party has brought witnesses in evidence, the other party or parties will as of right have leave to bring witnesses by way of rebuttal. Their hearing shall not extend beyond the subject matter covered in the main hearing of witnesses.
2. The party wanting to hear witnesses by way of rebuttal shall so state at the end of the main hearing of witnesses, stating the number of witnesses he is planning to hear
- 4965 and if possible, their identity.
3. The rapporteur or the court can limit the number of witnesses to be heard by way of rebuttal.
4. The rapporteur or the court shall, in consultation with the parties, fix a place, date and time for the hearing of witnesses by way of rebuttal.

4970 *Equality of arms requires that, when one of the parties have had the opportunity to bring evidence through the hearing of witnesses, the other party must have the opportunity to bring evidence to the contrary, be it substantially or by way of attacking the credibility of the other witnesses. Because much depends on what has happened in the case at hand it is not possible to give very detailed rules about this hearing by way of rebuttal. Nevertheless some general rules are given to avoid the abuse as a means of delaying the proceedings. At the end of the hearing of the witnesses of a party, the other party should be able to make up its mind whether it wants to hear witnesses from its own side and, if yes, how many and what witnesses.*

4975 *The rulings in the individual cases should be left to the court.*

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§ 75 Witnesses in principle heard by full panel.

1. Witnesses will be heard before the full panel unless:
- either all parties request that the hearing shall take place before the rapporteur,
- or the panel decides to delegate the hearing to one or more of its members.
- 4985 2. Article 121 of the Protocol is applicable both on hearings by the full panel or by designated members of a panel.

§ 76 Summoning of witnesses.

- 4990 1. Witnesses will have to be summoned by the party calling them according to the rules of the practice directions.
2. The witnesses to be heard on a certain date will have to be announced to the court and the other party or parties according to the rules given by the practice directions.

4995 *The court and the other party should know beforehand which witnesses will really be coming forward at a certain date in order to be able to prepare for their hearing.*

§ 77 Leave given or refused by the rapporteur.

- 5000 1. If the rapporteur has given leave to hear one or more witnesses, that does not imply that the onus of proof is on the party that has offered to bring the witness and is allowed to do so.
2. If the rapporteur has refused to give leave to hear one or more witnesses, any party can request revision of that decision by the full panel on the basis of § 34 and § 35 .

5005 *Normally a decision to give a party leave to hear witnesses means that the onus of proof is on that party (and that he will loose if he does not succeed in bringing that proof). This paragraph makes clear that a leave given by the rapporteur does not have such consequences.*

5010 *If the rapporteur refuses leave to hear witnesses, there is a possibility of revision of that decision by the full panel. On the other hand: if the rapporteur has given leave that means that in principle the whole panel will have to convene to hear the witnesses, even if they have doubts about the necessity of such a hearing. that however does not seem to be a big problem: in such a case the panel can always delegate the hearing of the witnesses to the rapporteur himself.*

5015 **§ 78 Hearing by the judge.**

- 5020 1. Witnesses will be heard in front of the court or the rapporteur in the presence of the representatives of the parties and in the presence of a recorder as mentioned in § 11 , who will take care of the minutes of the session and the summary as mentioned in § 84 .
2. Witnesses will be heard by the judge, in case of § 77 the rapporteur and in other cases the judge presiding over the session or one of his colleagues.
3. After the hearing by the judge, the European patent counsel of the party bringing the witness and, after him, the European patent counsel of the other party or parties will be allowed to put questions to the witness regarding the probandum and/or circumstances directly concerning the credibility of the witness.
5025 4. The judge can decide on another order of questioning, including an order in which one of the counsel starts the questioning.

5030 *As a rule it seems best that the court should start the questioning. Not only is it known best to the court on which point it feels further evidence is necessary and on which points further clarification would be useful, but also it starts the questioning of a witness in a neutral way. Nevertheless there are certainly cases in which the more productive way would be to have the questioning started by, for instance, the counsel who has brought the witness and probably knows best what the witness*

5035 *should be able to make a statement about. This provision, while setting the main rule, provides for the necessary flexibility.*

§ 79 Exemption of witnesses.

1. Everybody who is summoned as a witness has the obligation to appear in court at the place, date and time stated in the summons.
- 5040 2. Nonetheless nobody will be obliged to deposit a witness statement if he is a party, a spouse or a companion in life of a party, a descendant or a parent of a party.
- 5045 3. Moreover a witness can refuse to answer questions if answering them would violate a professional secret recognised as such by his national law or if answering them would expose the witness or his spouse, companion in life, descendant or parent to criminal prosecution in his country of domicile or in one of the EPLP states.

Helping in the due course of justice is a civilian duty, therefore in principle everybody requested to appear as a witness in court should be obliged to do so. Nevertheless there are sometimes good reasons for a person to act as a witness in a certain case in general or to answer specific questions in public. There has to be distinguished between the obligation to appear in court and the obligation to answer questions. The obligation to appear in court is formulated absolutely. Only if the witness to be is appearing in court can the court form a good opinion about the obligation to answer questions.

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§ 80 Allowability of questions.

1. The judge will decide whether or not a certain question is allowed and has to be answered by the witness.
2. He will take into account all circumstances of the case, including a possible partiality of a witness.
- 5060 3. A party can require that the refusal of the judge to allow a certain question will be recorded in the minutes of the session.

Normally witnesses should not have to put up with aggressive cross examination. To keep the questioning as neutral as possible it is preferred to have the witness primarily examined by the rapporteur or the court. Parties can ask supplementary questions. The last paragraph but one of this article opens however the possibility of cross examination (without mentioning it) in case of clearly partial witnesses. If a judge refuses a question to be put to a witness, that involves a judicial decision that may have consequences for the outcome of a case. Therefore it should be possible to have this decision put down in the minutes of the hearing, so that it can form a ground of appeal later on.

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§ 81 Hearing by video link or other means.

- 5075 1. The court can allow a witness to give evidence by video link or other means, provided the interests of the parties are taken care of in that their representatives can hear all the statements of the witness and the questions put to the witness and they can speak directly to the witness when putting questions.
2. Further regulations can be given by the practice directions.

5080 3. Witnesses giving evidence in this manner to the court or the rapporteur will be deemed to give evidence in front of the court or the rapporteur and all provisions about witnesses are applicable.

§ 82 Languages.

5085 1. A witness will be heard in one of the official languages of the court or in his own language.
2. In case a witness is heard in his own language, not being an official language of the court, the party bringing the witness will have to provide a certified interpreter for interpretation into and from that language into and from the language of the
5090 proceedings.
3. The protocol of the statement of the witness will however be drafted in the language that is used as language of the proceedings.
4. The costs of that interpreter will have to be paid by the party bringing the witness but the court can, and if the witness is not decided to be called frivolously normally
5095 will, take these costs into account when deciding about the costs as mentioned in § 100 .

§ 83 Hearing under oath, consequences of perjury.

5100 1. A witness will be heard after he has sworn, according to the customs of his country and/or religion or after he has solemnly promised, to tell the truth and not to conceal any part of the truth.
2. A refusal of a witness to take an oath or to make the solemn promise will be regarded as a refusal to answer questions as meant in Article 121 of the Protocol.
3. If a witness should be suspected of perjury, the court or the rapporteur can report
5105 such a witness to the authorities of his state of residence or nationality who will deal with this report on the basis of Article 123 , without prejudice to the possibilities of the parties to sue such a witness for damages.

§ 84 Summary of essentials.

5110 1. During or immediately after the hearing of a witness the judge will dictate a summary of the essentials of the statement of the witness.
2. After the hearing this summary shall be read out to the witness in the language in which he has made his statement.
3. The witness will state whether this summary contains the essentials of his
5115 statement and, if present, will sign the summary.
4. If the witness does not make the aforementioned statement and/or is not able or refuses to sign, the judge will have recorded in the minutes of the session a refusal (and the reason given for it) or the non ability of the witness to sign the summary and/or to make the statement aforementioned.
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§ 85 Recordings

1. Audio recordings will be made of the questions put and the answers given during the hearing of a witness.
2. If the judge does think it advisable a video recording will be made of the hearing
5125 of a witness.

3. The recordings will be kept at the central registry and will destroyed on the order of the chairman of the panel that has decided the case after the judgment in the case has become irreversible. If the chairman is no longer available the order will be given by the President of the court concerned.

5130 4. Any party to the proceedings can request a transcription of an audio recording at his own expense. These costs will not be taken into account when the court has to take the decision as mentioned in § 100 .

5. The practice directions will regulate the applications for transcriptions and the costs thereof.

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§ 86 Indemnification of witnesses.

1. Witnesses will be indemnified by the party calling them for the costs of travelling, stay and loss of income, caused by their hearing.

2. The practice directions can give standards in this respect.

5140 3. The amount awarded to a witness shall be stated in the protocol of the session.

4. The judge will if necessary thereto make an order, providing the witness with an enforceable title against the party concerned.

Subsection 1.7.4. Experts and experiments.

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In technical proceedings as patent cases often are, the technical evidence of experts and experiments can be very important.

It is possible to leave it to the parties to produce expert evidence. The advantage of that solution is that it mostly will be quick as parties will keep the expert under pressure to deliver his report in time. The big disadvantage is of course that a party will tend to choose an expert he thinks will confirm his point of view. Moreover a party will, in a system where there is no obligatory discovery, not file in court expert evidence that he received but that turns out to be contrary to his standpoint.

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So the court, getting expert evidence from the parties will

5155 *a) never know how many expert reports were acquired by that party before he got one that was favourable for him and*

b) tend to get contradictory expert evidence from both parties, leaving the court as uncertain as it was before the expert evidence was produced.

Therefore it is felt that this way can only function in a system where there is cross examination, as the experts will then know that they are going to be cross examined in open court by counsel assisted by equivalent expertise on the other side and therefore will be more cautious in writing biased reports.

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The other solution, preferred here, is that the court itself appoints experts, of course after consulting the parties about the person of the expert to be appointed and about the questions to be put to him. That way of appointing experts avoids the disadvantages pointed out before. A possible disadvantage of this option to be aware of however, is the time factor. In some countries experience seems to learn that court appointed experts tend to take longer to produce results. Experience in other countries however teaches us that this is not an unavoidable phenomenon: much depends on the case management by the court. Differences in that respect lead to not unimportant differences even between courts in the same country. It is felt that in a system with a very active case management as is envisaged in this protocol this possible disadvantage could easily be prevented from occurring.

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5175 *Envisaged here is a system in which the rapporteur (or the panel) will discuss with*
the parties the desirability of expert evidence. Parties can make suggestions about
the identity, necessary technical background and number of the expert(s) and about
the questions being put to them. After having heard the parties – but not necessarily
5180 *following (both) their opinions, the judge will informally contact the contemplated*
expert and discuss with him whether he thinks he is competent to answer the
questions, an estimate of the necessary period of time and the probable costs. If
these informal answers are satisfactory the judge will make an order, appointing the
5185 *expert, stating the questions to be answered and stipulating the date before which*
the expert will have to produce his report. The expert will have formally to accept
his appointment, using a form set up in the practice directions, also confirming the
date before which he undertakes to send in his report. That form can also ask for an
estimation of the costs involved. It will be the responsibility of the rapporteur to
guard over the time limit set and to remind the expert if necessary.

5190 **§ 87 Experts**

1. Without prejudice to the possibility for the parties to produce expert evidence, the court (be it the rapporteur or the whole panel) can at any time during the proceedings appoint one or more experts to advise it about certain technical aspects or of the case or to answer certain questions about the case.
- 5195 2. Hereafter “expert” will also comprise a plurality of experts.

Although little is expected from expert evidence produced by the parties, it should be clear that they are free to produce any affidavit they choose.

5200 **§ 88 Discussion with the parties**

1. The court shall discuss its wish to appoint an expert with the parties, preferably during the first conference as mentioned in § 46 .
2. Parties will be able to make suggestions about the identity and the number of the experts required, about the necessary technical background and/ or about the
- 5205 questions to be put to the expert(s).

§ 89 Contact with the expert

1. After the parties have had the opportunity to make their suggestions and to discuss them with the court, the court shall informally ascertain itself of the availability and willingness of the proposed expert to accept an appointment as such and discuss the probable time and costs involved with the proposed expert.
2. Thereupon the court shall make an order, appointing the expert, stating the questions to be answered or the matter to be discussed, and the latest date before which the expert will have to have sent in his report.
- 5215 3. The court can also order one or more of the parties to pay a certain amount into court, as a security for the probable costs of the expert (including a possible translation of the report into the language of the proceedings) and can stipulate that the expert does not need to start his work before the registry has informed him that the ordered payment into court has been made.
4. If the party concerned does not
- 5220 comply in time with its obligation to pay this amount into court, the court will draw such conclusions from that behaviour as it thinks fit.

Rules of Procedure EPJ.

5. The order will require the expert to accept his appointment before a date mentioned in the order, using a form set out in the practice directions and confirming the date the report will be send in.

5225 6. If the expert has not accepted his appointment in time the court can appoint another expert in his place.

§ 90 Language.

5230 In case the expert is probably not going to report in the language of he proceedings, the court can order provisions for the translation of the report and the costs of that translation.

§ 91 Views of the parties.

5235 1. Before sending in his final report the expert will have to give opportunity to the parties to present their views on the matter at hand.

2. He shall take care not to communicate with any of the parties without informing the other parties and sending them copies of all communications.

3. His report shall show that these requirements have been met.

5240 *Often parties in a dispute will be very well informed about the matter in discussion; their participation in the work of the expert can enhance the quality of his report. Moreover: if parties are troubled about certain points, it is better to give them the opportunity to voice their concerns to the expert and enabling him to deal with these points in his report then only to have the parties criticise the report of the expert afterwards.*

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§ 92 Comments of the parties.

After the report of the expert has been filed with the court, the court shall give parties the opportunity to comment upon the report, be it in writing or during the oral part of the proceedings.

5250 *It would not do to prevent parties commenting upon the opinion of the expert but on the other hand, if oral proceedings are to follow (as in most patent cases will be the case) there is often no need for a special phase in the written proceedings, casing unnecessary delay. Parties will have all opportunity to comment during their oral pleadings before the court. If the court prefers that it could under its case managing powers also require the parties to file their comments in writing before the oral proceedings.*

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§ 93 Alternative expert.

5260 If the expert who has accepted his appointment does not file his report in time, the court shall be able to appoint another expert in his place, without prejudice as to the liability of the first expert for costs being made without avail.

§ 94 Experiments

5265 1. The court (be it the rapporteur or the whole panel) can allow a party to prove its statements by means of experiments.

Rules of Procedure EPJ.

2. The party requesting to be allowed experiments will have to describe the proposed experiments in a detailed protocol (also proposing one or more experts who could carry out the experiment), on which protocol and proposal the other party may comment.

5270 3. The experiments will have to be carried out in the presence of the parties, their experts or their representatives.

4. If the court allows the experiments it will appoint the person or persons who will have to perform the experiments and to report about them.

5275 5. The court shall order the party requesting the experiments to pay into court an amount decided upon by the court after consultation of the expert(s) who will be performing the experiments. This amount will function as a security for the payment of the costs of the expert(s) concerned.

5280 6. The performing expert(s) will perform the experiments within the time limit mentioned in the decision of the court and shall relate his or their experiments in a written protocol, sent to the court within 6 weeks after the experiments having taken place.

7. § 90 , § 92 and § 93 will be analogously applicable.

§ 95 Local inspection.

5285 1. The court (be it the rapporteur or the whole panel) can decide to inspect products, devices, methods or local situations in situ.

2. The date and time for such an inspection will be determined by the court after consultation of the parties.

5290 3. The court can decide to have copies from documents made, photographs taken, samples or specimens taken and/or audio graphic or video graphic registrations made.

5295 4. Of every local inspection minutes will be made by a member of the Registry, acting as recorder, stating the essentials of the inspection and to be signed by the minute writer and the chairman or, if the inspection is made by the rapporteur, by the rapporteur.

Section 1.8. Decisions.

§ 96 Signing of decisions.

Decisions shall be signed by all members of the panel.

5300

§ 97 Final decisions.

A final decision is every decision by which the court ends a dispute or part of it by deciding in its tenor on a matter in dispute between the parties.

5305 *This definition is given with regard to the next article about the appealability of decisions.*

§ 98 Appealable decisions.

1. Final decisions will be open to appeal immediately after they have been given.

Rules of Procedure EPJ.

5310 2. Furthermore decisions on a request for a provisional measure and decisions about the jurisdiction of the EPC1 will be open to appeal immediately after they have been given.

5315 3. Unless laid down otherwise in the Protocol or in these Rules of Procedure, other decisions will only be open to appeal together with the appeal against the final decision unless there has been given leave for an earlier appeal, be it in the decision itself, be it by EPC2.

5320 4. If a decision has been subjected to an earlier appeal, there will be no possibility for a new appeal when the final decision has been given, neither as a principal appeal nor as a cross appeal.

5325 *In principle every decision of EPC1 should be open to a check in second instance. However it should be avoided that appeals are abused as a means of slowing down proceedings. Therefore in principle every decision that is not a final decision should only be appealable together with the final decision. EPC1 or EPC2 however should have the possibility to give leave for earlier appeals, e.g. in instances of great principle value. On the other hand only one appeal should be possible, so in case of a leave for an earlier appeal the party will have to make up his mind: or to appeal immediately or to wait for the final decision. The last option could be elected e.g. in cases where a party trusts that he will win the case in the final decision,*

5330 *notwithstanding an unfavourable interim decision on a certain point.*

Section 1.9. Costs

§ 99 Classification as regards costs.

5335 1. As soon as a case is brought before the court, the registry will determine the financial importance of the case and classify it according to a table set up by the Administrative Committee on a proposal of the Executive Committee after having heard a representation of the European Patent Counsel.

5340 2. The court fee due by the parties and the settlement of costs in the final decision of the court in the case will be determined according to this classification.

5345 3. If a party concerned does not agree with the assessment or the classification by the registry, he can put the matter before a panel of the court designated to deal with these decisions.

5345 4. The classification can be altered by the court on the basis of information becoming available during the proceedings as long as a final decision in that instance is not taken in the case.

Costs play a role in two aspects: as regards the court fee to be paid by the parties and as regards the costs the losing party has to reimburse to the winning party.

5350 *To deal with both aspects every case should be classified according to a table representing its financial importance. This classification can be used to determine the court fee. It can also be used to determine the amount of costs to be reimbursed to the winner for each point, the number of points being dependent from the activities during the proceedings. In that way a correlation can be realized*

5355 *between the costs to be reimbursed and the activities of a party during the proceedings and their financial importance. The consequence of that system is that the amount to be reimbursed will not be exactly the amount spent by the winning*

party but it is felt that that divergence should be accepted in view of the fact that this system makes redundant a special debate about the amount of costs.

5360 *The coupling of court fees and cost reimbursement to the same table ascertains that the parties do not have much interest in stating the financial importance of a case too low: they would thereby save on court fees but would have to pay for that by getting a smaller reimbursement when they win (as nearly every party is certain at the beginning that he will!).*

5365

§ 100 Loser pays costs

1. Without prejudice to the power of the courts to leave costs unnecessarily made with the party or parties that made those costs, a party who is ruled against shall be convicted to pay the costs incurred by his opponent(s) according to the table as mentioned in § 99 .

5370

2. If both parties are ruled against in part, the court can divide the costs between them as it sees fit.

§ 101 Amount

1. The amount of the costs to be paid will be decided by the court in its decision.
2. In decisions not ending the case the court can leave the question of the costs open till a later decision.

5375

Chapter 2.Proceedings at first instance

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Section 2.1. Normal proceedings at first instance

§ 102 Start of proceedings at first instance.

Proceedings are started by the plaintiff's European patent counsel filing a statement of claim, using a form to be determined in the practice directions.

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§ 103 Sending in of statement of claim.

A statement of claim can be filed with the Central Registry or with any regional sub registry. Filing can be done by post, by fax or by electronic means, subject to the regulations of the practice directions in that respect.

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§ 104 Assignment of case to competent division.

Regardless of where the case has been filed, it will be assigned to and dealt with by the Division of EPC1 that is competent according to the rules of Article 89 .

5395

§ 105 Requirements

1. A statement of claim shall in any case state::

- The name and address of the European patent counsel representing the plaintiff;
- The name and place of domicile of the plaintiff and, if appropriate, the representative capacity in which he is suing;

5400

Rules of Procedure EPJ.

- The name and address of the defendant or defendants and, if known, the European patent counsel representing him or them and, if appropriate, the representative capacity in which the defendant is being sued;
 - 5405 - The publication number, application number, title, filing date, date of publication of grant and international classification of the European patent(s) concerned;
 - A concise statement of the nature of the claim and a concise but precise description of the remedy or remedies the plaintiff is claiming;
 - 5410 - An estimation of the financial importance of the claim in Euros
 - A concise statement of the facts on which the plaintiff is relying and, if known, which of these facts are disputed by the defendant(s);
 - In case of infringement proceedings: the claims of the European patent the plaintiff considers to be infringed and at least one example of every infringement specifying the date and place of infringement.
 - 5415
2. The practice directions can further detail the requirements a statement of claim has to meet.

5420 *The statement of claim should in principle contain the whole case of the plaintiff, enable the registry to classify the case as regards court fees, enable the court to decide about its jurisdiction and make it clear to the defendant what he is up against. As regards the financial importance of the claim it seems best to require this in euros, being the most used currency in Europe and thereby avoiding disputes about currencies and their rates between plaintiffs and defendants from different*

5425 *countries.*

§ 106 Statement of the competent Division.

Furthermore the statement of claim will state which Division will have to deal with the case and the legal basis for its competence.

5430 *This provision is meant on the one hand to respect the right of choice of forum the plaintiff has in certain cases according to the provisions of Regulation 44/2001 and the Brussels and Lugano Conventions and on the other hand to ensure that the statement of the plaintiff can easily be checked.*

§ 107 Language.

5435 The statement of claim has to be couched in the procedural language of the Division mentioned in § 106 , unless it is filed at the sub registry serving that Division and the Divisional President has provisionally given leave for the use of another language according to Article 131 of the Protocol, in which case a copy of the leave

5440 of the Divisional President will have to be attached to the statement of claim.

5445 *As every Regional Division has its own procedural language (one of the three official languages of the EPC) and the plaintiff has to indicate the division that will be competent to deal with the case, it will be clear to him in which language he has to draft his statement of claim. It is however imaginable that if the case has to be dealt with in a country not having as its official language one of the three languages of the EPC and if all parties are nationals of that member state, that the parties (and the court) will want to use the possibility given by Article 131 of the Protocol. The plaintiff then will have to get the authorisation of the President of that Division to*

5450 *file in another, i.e. the local, language. Of course that is only possible if the statement of claim is filed at the sub registry of that division: a registry in Portugal would otherwise not be able to deal with a statement of claim in a case that should be dealt with in the Regional Division in Sweden.*

5455 **§ 108 Registry registers and date stamps.**

1. The Registry where the statement of claim is filed will check whether the form complies with the requirements mentioned in § 105 sub 1 to 4. If this should not be the case the Registry will require the European patent counsel who has filed the claim to complete the statement of claim.

5460 2. The receiving registry will book the case with its number and date of receipt in a register of cases, that will be kept according to the regulations in the practice directions in that respect.

3. Every claim form that complies with the requirements mentioned in § 105 will be given a date of receipt that shall be stamped upon the claim form if on paper.

5465 4. The case will be regarded as pending before the court from that date onwards.

5. Furthermore the case shall get a number according to the regulation in the practice directions in that respect.

4. The registry will notify the European patent counsel who filed the statement of claim of the case number and the date of receipt awarded to the case.

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During the hearing of national experts on procedural law there was no unanimity whether proceedings should be regarded as pending from the day the statement of claim reaches the Registry of the EPJ or from the date on which it has been received by the defendant. The first solution has the advantage that it is easy to establish, which enhances legal certainty in general, the second solution has the advantage that no proceedings can be pending without the defendant knowing about them, which enhances his legal certainty in particular.

5475 *This proposal opts for the date of receipt by the Registry, also because it is in accordance with Article 30 of the Jurisdiction Regulation of the EU, which says:*

5480 *“For the purposes of this Section, a court shall be deemed to be seized:*

1. at the time when the document instituting the proceedings or an equivalent document is lodged with the court, provided that the plaintiff has not subsequently failed to take the steps he was required to take to have service effected on the defendant, or

5485 *2. if the document has to be served before being lodged with the court, at the time when it is received by the authority responsible for service, provided that the plaintiff has not subsequently failed to take the steps he was required to take to have the document lodged with the court.”*

5490 **§ 109 Assignment of cases.**

The (sub)registry where the case is filed will subsequently send the case to Divisional President of the Division to which it should be assigned according to the statement of claim.

5495 **§ 110 Possible re-allocation.**

1. If the Divisional President of that Division is of the opinion that the case should be assigned to another Division, he will send the case to the President of EPC1 and notify the filing European patent counsel.

5500 2. The President of EPC1 will, if the statement of claim is couched in a language that is not one of the official languages of the EPC, request the European patent counsel of the plaintiff to file a translation of the statement of claim into that official language of the EPC he thinks fit, and will assign the case to a Division, applying the rules of Article 89 of the Protocol.

5505 3. The assignment decision of the President will be binding both to the Division concerned and to the parties and can be challenged in appeal but, unless allowed otherwise by either EPC1 or EPC2, only together with the appeal against the final decision in first instance.

4. If EPC2 finds that the assignment decision has been wrong it has discretion to order a retrial of the case or not.

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If the statement of claim would be drafted in a local language, not being one of the official languages of the EPC, but the Divisional President would be of the opinion that the case should be dealt with by another Division, then it could be difficult for the President of EPC1 to form an opinion on that question if he was not able to read the statement of claim. Therefore he has the power to require a translation in that official language that probably will be the language of the proceedings. This will in practice hardly happen however because a plaintiff needs the preliminary leave of the Divisional President to draft a statement of claim in a local language (see § 107) and it will hardly happen that that Divisional President will give that leave if he feels that the case should not be brought to his Division. Nevertheless it cannot be ruled out: the request for leave to draft in a local language could give an incomplete picture of the case or the person of the Divisional President could change.

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As to the possibility of appeal the main rule is that an appeal will only be possible together with the appeal against the final decision in first instance. In case there seems to be a real interest in an earlier appeal, the plaintiff can ask either EPC1 or EPC2 itself for leave to appeal. (Or EPC1 can give this leave of its own motion). It should be kept in mind that the question of assignment of the case already has been decided by two experienced judges: the Divisional President and the President of EPC1, so normally the interest in an appeal on this matter of subsidiary importance should be small indeed.

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§ 111 Court fees.

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1. Immediately after the classification as mentioned in § 99 the registry will inform the plaintiff of the court fee due and the time limit within which the fee has to be paid.

2. The registry will point out that the case will not be further prosecuted as long as the fee is not paid and what increased amount will be due if the fee is not paid within the time limit mentioned.

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3. If the European patent counsel of the plaintiff has a current account with the registry with a sufficient balance, the registry will mention that the fee is debited on that account and that the fee is regarded as paid on the day of receipt of the statement of claim or the statement of appeal.

5545 **§ 112 Striking out a case.**

1. If the court fee mentioned in § 111 is not paid within the time limit mentioned in the first paragraph of § 111 the President of EPC1 can decide to strike out the case, without prejudice to this fee being due
2. If a case is struck out on the basis of the first paragraph, that case will be
- 5550 considered to be no longer pending before the court.
3. A decision to strike out a case will be notified to the Registry and to the European patent counsel having filed the case and will be recorded in the register of cases.
4. A decision to strike out a case is a final decision in the sense of § 97 and § 98 .

5555 *If a court fee is not paid in time § 111 leaves open the possibility for a provision in the Practice Directions that the fee can still be paid later, possibly at a supplementary fee. If that possibility is not used, then ultimately the Court will have to have some possibility to get rid of a case that was filed but never followed up. That possibility is given by § 112 .*

5560 *A decision to strike out a case is qualified as a final decision to make sure that immediate appeal will be possible. This means that the plaintiff can have the decision checked by EPC2. It does not mean, of course, that an instance would be lost for the parties: if the EPC2 should revoke the decision, it will – on the basis of § 198 - sent the case back to the first instance were it will take its normal course. (Of course the plaintiff could also, more simple, opt just to restart proceedings afresh. That would be cheaper. Such a restart will however not always be possible, e.g. when a time limit has passed.)*

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§ 113 Appointment of panel.

5570 Immediately after the case has been booked in the register of cases, the court fee has been paid, and the case is assigned to a Division, the President of the Division will, unless the case is clearly not admissible, appoint a panel to sit on the case.

See Annex IV. for an example of how this could be done.

5575 **§ 114 Clear non admissibility**

1. If the case is judged clearly not admissible as mentioned in § 113 , the Registry will communicate that decision immediately in writing to the plaintiff's European patent counsel or, if there is no European patent counsel indicated, to the plaintiff himself.
- 5580 2. The plaintiff will be able to challenge this decision through his European patent counsel within a time limit mentioned in that decision but at least two weeks.
3. In case of such a challenge being received in time, a panel as mentioned in § 113 will be appointed and the case will be immediately decided in this respect by the appointed panel in full, deciding only on the documents available in the case and
- 5585 without a further hearing .
4. The decision of the panel in this respect can be appealed to EPC2.
5. If EPC1 or EPC2 decides that the case was admissible, it shall get the filing date it should have had if it was not at first held clearly inadmissible.

5590 ***§ 115 Sending to the defendant by registry under responsibility of the rapporteur.***

1. If a panel is appointed and the case is not decided to be clearly not admissible, the Registry will, under the responsibility of the rapporteur, send a copy of the statement of claim and its possible accessories to the defendant at his address mentioned in the statement of claim.

5595 2. The registry will accompany this communication by a copy of the text of § 116 and § 117 in German, English and French and by a specimen of the form mentioned in that article.

3. It will furthermore state what court fee will be due by the defendant according to the classification of the case at that moment.

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§ 116 Defendant to reply within 3 months.

1. A defendant will have to file a statement of defence within three months after the sending of the communication as mentioned in article § 115

5605 2. This time limit can once be extended by the rapporteur on a written and reasoned request by the defendant.

The statement of intended defence, to be filed within one month, is abolished in this proposal after the national experts on procedural law were in a large majority of the opinion that it could be missed, also because it hardly ever happens that a patent case goes undefended.

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§ 117 Requirements

A statement of defence shall in any case state:

- the name and place of domicile of the defendant (where appropriate stating in which representative capacity he is defending the case) and the name and address of the European patent counsel representing him;
- the number of the case;
- the name of the plaintiff;
- which of the allegations of the plaintiff he denies, stating his reasons for doing so and, if he intends to put forward a different version of events, stating his own version of the events

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§ 118 Judgment by default

If no statement of defence is received in time by the court the court will, by judgment by default, grant the petition of the plaintiff as far as this does not seem to contravene the law or the public order.

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If the defendant does not take the trouble to contradict the claims of the plaintiff there is no good reason why the court should not grant those claims. Of course unless these contravene clearly the public order or if the facts stated by the plaintiff clearly are not sufficient, if true, to justify the claims.

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§ 119 Objection to default judgment

1. A judgment by default will be enforceable, notwithstanding the possibility of the defendant to object to this judgement within one month after he has gotten

- 5635 knowledge about its contents, and at the latest one month after the start of its enforcement.
2. Objection shall take place by filing a claim for objection in which the original plaintiff will be mentioned as respondent.
- 5640 3. The statement of claim for objection shall, apart from the requirements of § 105 , mention the decision by default with its date and number. A copy of this decision shall be attached to the statement of claim for objection.
4. The proceedings following a statement claim for objection shall further be the same as normal proceedings. The court fee paid by the original plaintiff will be deducted from the court fee he is due as a defendant in the objection proceedings. 5.
- 5645 This provision cannot give occasion to any refund of court fees.

§ 120 Possibility of counterclaim.

- 5650 1. A defendant who wishes to file a counterclaim against the original plaintiff will be able to do so but only as part of his statement of defence, which then will be called statement of defence and counterclaim.
2. In case the original defendant has filed a claim for objection as meant in § 119 , the counterclaim will have to be filed together with the statement of claim for objection.
- 5655 3. The counterclaim has to comply with the same requirements as an original claim.

§ 121 Sending of answer to plaintiff

5660 The registry will, under the responsibility of the rapporteur, send a communication containing a copy of the statement of defence or the statement of defence and counterclaim to the European patent counsel of the plaintiff.

§ 122 If counterclaim answer to that by plaintiff within 3 months.

- 5665 1. If the defendant has filed a statement of defence and counterclaim the plaintiff will have the possibility to respond to the counterclaim by filing a statement of defence against counterclaim within three months after the sending of the communication as mentioned in § 121 .
2. This time limit can once be extended by the rapporteur on a written and reasoned request by the plaintiff.
- 5670 3. The statement of defence against a counterclaim has to comply with the same requirements as a statement of defence against an original claim.

§ 123 Rapporteur sends answer counterclaim to defendant.

5675 The registry will, under the responsibility of the rapporteur, send a communication containing a copy of the statement of defence against the counterclaim to the European patent counsel of the defendant.

Section 2.2. Interlocutory orders

5680 *This section first deals with a number of general provisions, then continues with the most important kind of interlocutory orders (the interlocutory injunction) and finally gives some rules for a number of other provisional measures.*

Subsection 2.2.1. General provisions.

5685 ***§ 124 Application for provisional measure.***

1. In all cases where there is need for an immediate provisional measure the party in need of such a measure can file an application through his European patent counsel.

5690 2. These applications have to be addressed to the President of the court or one of its Regional Divisions and have to be filed at the registry or sub registry in the territory of that Division.

3. The President can allow a European patent counsel to file an application by telephone or other electronic device, providing a written application, using a form to be determined by the practice directions, will be filed within a time limit to be determined by the President.

5695

§ 125 Competent Division

1. If proceedings as to the merits are already pending before EPC1, any application for provisional measures connected to that case shall be brought before the Division where the case is pending.

5700 2. If no proceedings as to the merits are pending before EPC1 an application for provisional measures can be brought before the President of EPC1 or before the President of a Regional Division to which the case should be assigned on the basis of the rules of Article 89 of the Protocol.

5705 3. Furthermore an application can be brought before the President of the Regional Division in whose territory the required provisional measure should be effected. If proceedings as to the merits are already pending before another division of EPC1 a copy of the application and of the decision shall be sent to the (sub)registry serving that division.

5710 4. If a President of a Division considers that the application should not have been brought before him, he will dismiss the application on this ground.

§ 126 Requirements

5715 1. The application for a provisional measure will have to comply with the requirements mentioned in § 105 and will furthermore make clear why there is a need for a provisional measure.

2. The practice directions will determine what court fee is due by the parties in case of an application for a provisional measure.

§ 127 Appointment of unus iudex.

5720 1. Immediately after the receipt of the written or oral application the President will, unless he wants to deal with the application himself, appoint an experienced member of the court as unus iudex to decide upon the application.

5725 2. If there is already pending a case before the Division about the same dispute the requested provision is dealing with, the iudex will be one of the members of the panel sitting on that case, unless the application involves a decision about the merits

of the case (e.g. an application for an interlocutory injunction), in which case the iudex will not be one of the members of the panel sitting on the case.

3. The iudex will handle the case management of the application and will have all the authority necessary to ensure a fair, orderly and efficient conduct of the proceedings.

The term “iudex” is used here because of lack of a better title. The use of a separate title envisages to stress that the provisional measures are not a part of the normal proceedings. Furthermore it should express that the normal rules (about evidence etc.) do not apply and that no judicial decision in the strict sense is given. This title could be substituted for any better one.

If it concerns provisional measures as e.g. conservation of evidence, protection of secret knowledge etc. the application can probably be best dealt with by the rapporteur. On the other hand if it concerns an application for an interlocutory injunction it will have to be a judge not being part of the normal panel, in order to avoid a conflict with article 6 (1) of the Convention on Human Rights: the judge dealing with the interlocutory injunction will have to form a provisional opinion as regards the merits of the case and would be open to doubts about his impartiality when it came to deciding the main proceedings.

Subsection 2.2.2. Interlocutory injunctions.

Application.

1. The application for an interlocutory injunction will have to comply with the general requirements for an application for a provisional measure and will be moreover be non admissible unless it demonstrates that the applicant has acted speedily after the need for an interlocutory injunction became clear, taking into account reasonable delay for the collection of proof and/or the ascertaining of the identity of his opponent.

2. The applicant will in any case be deemed to have acted speedily if he has filed the application within a period of six months after the applicant knows or should have known the need for a provisional measure.

As an application for an interlocutory injunction puts especially the defendant under extra stress (the plaintiff can take as long as he wants preparing the case) such an application needs an extra justification. That justification is that there is an urgent need for a measure being taken. One of the factors in deciding whether there is such an urgency is the plaintiffs own behaviour: if he dawdles too long, there is apparently no urgency. On the other hand in complicated cases there should be enough time to gather evidence and expert advice. So it is difficult to state a fixed term within which a plaintiff should act and that is best left to the Courts.

Nevertheless there is a clear need for a minimum term within which the plaintiff knows that he will not be told he was too late. That minimum term is set at six months as that seems to reflect the feeling in the hearing of national experts on procedural law. It could be envisaged to make this minimum term shorter but we should keep in mind that we are dealing with international cases, in which both the communication between counsel and client and the gathering of evidence could take extra time.

5775 **§ 128 Setting of date for statement of defence.**

The iudex will immediately read the application and fix a date before which a statement of defence will have to be filed with the Central Registry.

§ 129 Request for inability dates for hearing.

- 5780 1. Under responsibility of the iudex, the registry will send a communication to the defendant, sending him a copy of the application, informing him (unless the urgency of the application does not allow for any delay to this end) of the date before which a statement of defence will have to be filed and requesting him to state before a certain date those dates on which he would probably not be able to attend an oral hearing.
- 5785 2. The registry shall send a copy of this communication to the European patent counsel of the applicant and will request also the applicant to state before that same date the dates on which he would not be able to attend an oral hearing.
- 5790 3. If the urgency of the application so requires, the consultation of the parties about a possible date for an oral hearing can also be done by telephone or by other means of communication.
3. The communication to the parties shall also state the amount of the court fee due by each of them and the date before which this fee will have to be paid on penalty of non admissibility of the application or the defence
- 5795 4. If the European patent counsel of either party has a current account with the registry with a sufficient balance, the registry will mention that the fee is debited on that account and the date on which the fee is regarded as paid.

5800 *Normally there should be a possibility for the defendant to counter the written statement of claim of the applicant with a written statement of defence before the oral hearing. Nevertheless there should be a possibility to concentrate the whole trial of the application at the oral hearing in exceptionally urgent cases: if a plaintiff hears that a defendant is going to exhibit an infringing product at an important trade fair next week, there simply is not enough time for an exchange of written pleadings. In such a case the registry should simply check with both parties what date would be*

5805 *available (or at least least cumbersome) for an oral hearing.*

§ 130 Setting of date and place for oral hearing

5810 As soon as both parties have stated the dates on which they would probably not be able to attend oral proceedings or at the latest after the expiration of the time limit set, the iudex will determine a date, time and place for an oral hearing, taking into account the statements of the parties as much as possible without endangering a prompt decision of the case.

§ 131 Instruction

- 5815 1. The iudex will be able to request both parties for certain affidavits, other documents and/or other evidence before or during the oral hearing.
2. The iudex will not be bound by normal rules of evidence.

§ 132 Oral hearing

- 5820 1. During the oral hearing both parties will be able to present their views within the time limits set by the iudex if necessary.
2. If one of the parties is not present the iudex shall nevertheless continue the proceedings after having ascertained that the missing party was duly summoned.
- 5825 3. The iudex will discuss the case with the parties and endeavour to see whether a settlement can be reached that would make the requested provision superfluous. If such a settlement is reached it will be written down in the minutes of the hearing. An extract of these minutes, signed by the iudex, will have the same effect as a decision of the court.

5830 *If parties do reach an agreement it can be allowed the same effect as a decision of the court on the merits: it should not only be judicial first aid but determine the legal position of the parties, also as to the merits.*

§ 133 Closure of debate.

- 5835 1. After the discussion the iudex will, unless the oral hearing is adjourned, declare the debate closed and will announce when his decision will be given to the parties in writing.
2. If he thinks fit the iudex may also announce what the decision is going to be.

§ 134 Decision

- 5840 1. The decision will be reasoned and be signed by the iudex.
2. When deciding about the allowability of the requested interlocutory injunction the iudex will take into account primarily the probable outcome of the main proceedings and, in as far as that is insufficient, also the balance of convenience between the
- 5845 parties and the question whether one of the parties would suffer irreparable damage in case the requested provisional measure would be given or refused.
3. The decision will be provisionally enforceable in spite of a possible appeal unless the iudex or EPC2 decides otherwise.
4. The iudex or EPC2 can set conditions to the enforceability of the decision.
- 5850 5. The iudex shall also give a decision about costs.

§ 135 Proceedings as to the merits to follow.

If a provisional measure is ordered and if no proceedings as to the merits are pending before the court, the iudex shall also determine a period of time within

5855 which the applicant will have to have brought such proceedings under penalty of lapsing of the provisional measures ordered.

See also Art. 50 (6) TRIPS.

5860 **Subsection 2.2.3. Provisional order to hear witnesses**

§ 136 Application for provisional hearing.

At any time a party or a possible party in proceedings or possible proceeding before the EPC1 can, through its European patent counsel and using a form prescribed by the practice directions, apply for a provisional hearing of witnesses.

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§ 137 Competent division.

The application can be filed everywhere and has to be addressed to the President of:

I. if proceedings as to the merits are already pending: the Division dealing with the main proceedings.

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II. If no proceedings as to the merits are yet pending:

A. if the probable future defendant is not known: either the Central Division or the Regional Division is whose territory most of the proposed witnesses are domiciled;

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B. if the probable future defendant is known: either the Regional Division in whose territory the probable future defendant (or the majority of them) is/are domiciled, or the Regional Division in whose territory most of the proposed witnesses are domiciled.

§ 138 Contents of application.

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1. The application for a provisional hearing of witnesses will have to comply with the same requirements as a statement of claim, with the understanding that instead of the name and domicile of the defendant it can state the reasons why the defendant is unknown.

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2. Furthermore it will have to state what facts the applicant wants to be proven and the names and addresses of the witnesses he wants to bring.

3. Finally it will state whether main proceedings are already pending before EPC1 and, if so, before which Division and under which number the case is pending. If main proceedings are already pending the application will only be allowable if the applicant makes it probable that the normal course of the proceedings cannot be awaited without the evidence becoming unavailable.

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§ 139 Hearing of the other party.

The President will, immediately after the application has been registered and the court fee according to the practice regulations has been paid, instruct the Registry to send a copy of the application to the other party, if known, with the request to raise through its European patent counsel its objections – if any – against the granting of the application within a time limit set by the President.

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It is important that the other party is heard about the application before a decision is taken: not only will it involve costs for the other party if he wants to attend the hearing of the witnesses, as he probably will, but also because a provisional hearing could be abused to acquire knowledge about commercial secrets or other confidential information.

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§ 140 Decision.

1. If the President decides to grant the application he will appoint a judge rapporteur, or, if the circumstances of the case seem to justify that, a whole panel.
2. If main proceedings are already pending, a panel will be composed of the same judges that form the panel in the main proceedings.
3. The President can his decision to such conditions and/or restrictions (including protective orders) as he thinks fit, taking into consideration the particular circumstances of the case.

5910

§ 141 Hearing.

1. The Registry will under responsibility of the rapporteur inquire with the parties at what dates in a certain period they would have difficulties in attending the hearing.
2. After receipt of the answers of the parties or after the time limit set for these answers, the rapporteur or the panel will determine a date, place and time for the hearing of the witness or witnesses concerned.

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§ 142 Applicable provisions.

§ 74 to § 76 and § 78 to § 86 will be analogously applicable.

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§ 143 Evidential value.

If the other party has been present at the provisional hearing, the evidential value of the witness statements will be the same as if it were given in the course of the main proceedings.

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Subsection 2.2.4. Sequestration of goods.

§ 144 Sequestration of allegedly infringing goods.

Without prejudice to the competences of the national courts as mentioned in Article 20 and Article 21 the President of EPC1 or one of its divisions can, on the request of a patentee, order the sequestration of allegedly infringing goods or materials and implements, the predominant use of which has been in the creation of infringing goods or to performing of an infringing process, that are present on premises within the territories of the EPJ states so as to prevent these goods coming into circulation in one or more member states designated in his European patent.

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§ 145 Request for sequestration.

The request for sequestration has to comply with the requirements of § 105 and moreover state:

- the location of the premises where the goods are to be found.
- the name and address of the person who is willing to act as executing person;
- the name and address of the person who is willing to act as sequestrator and the conditions that will apply to the contract of sequestration.

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§ 146 Agreement of executing person and sequestrator.

5950 The request for sequestration has to be accompanied by signed statements of the
executing person and the sequestrator, that they are willing to act as such.

§ 147 Conditions set by the court.

5955 The court can in its order subject the leave for sequestration to such conditions as it
sees fit, e.g. regarding a security to be put up by the requesting party for possible
damages to be suffered by the requested party or regarding insurance of the goods to
be sequestrated.

Subsection 2.2.5. Putting up of securities for costs or for possible damages

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§ 148 Securities for damages in case of provisional enforceability.

1. The Court can always, be it on the request of a party or of its own motion, make
the enforceability of any order subject to the putting up of such security by the party
wanting to enforce the order as it thinks fit.
- 5965 2. In the same way the court can order that an order will not be enforceable as long
as the other party puts up a security as described in the order of the court.
3. An order to put up securities shall always express the amount of the security
required in Euro's.
- 5970 4. The security can be in cash or in the form of a bank guarantee of a bank within the
territories of an EPJ state.
5. The order for securities can always be amended or changed by the Court, either on
the request of a party or of its own motion.

§ 149 Security for costs.

- 5975 1. The Court can always, be it on the request of a party or of its own motion, order a
party not domiciled in an EPJ state to put up securities for the costs of the
proceedings possibly due to another party or to the Court.
2. Paragraphs 3 to 5 of § 148 will be analogously applicable.

§ 150 Security in cash.

- 5980 1. If the security is in cash, the amount has to be paid to the Registry in the way and
within the time prescribed in the order of the court.
2. The amount of the security shall be augmented with interest from the date it was
received by the Registry until the date it is paid back to the party to which it has to
5985 be paid according to an order of the Court and calculated according to a percentage
determined by the practice directions.
3. Any party can apply for an order of the Court to refund or to forward the amount
of the security to it, stating the grounds on which the application is based and using a
form prescribed by the practice directions.

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§ 151 Security in form of bank guarantee.

If the security has to be in the form of a bank guarantee the order of the court shall
specify the terms and conditions the bank guarantee has to comply with.

5995 **§ 152 Disputes about forfeiture of security.**

1. Any dispute between parties or between the Registry and a party about the question whether a security is forfeited shall be filed as and considered as applications for clarification as meant in § 173 .

6000 2. When the Registry wants to have a dispute with a party about security for costs decided upon, Article 139 of the Protocol is not applicable to it.

Subsection 2.2.6. As to evidence

§ 153 Application for inspection (“Saisie”)

6005 1. A person who wants the court to make an order for inspection as mentioned in Article 119 has to file through his European patent counsel an application to the court, using a form to be determined in the practice directions.

2. The practice directions will further detail the requirements an application for inspection has to meet.

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§ 154 Contents of application

1. An application for inspection shall in any case state:

- The name and address of the European patent counsel representing the applicant;

6015 - The name and place of domicile of the applicant;

- The name and address of the (probable future) defendant or defendants and, if known, the European patent counsel representing him or them and, if appropriate, the representative capacity in which the defendant is being sued;

6020 - The publication number, application number, title, filing date, date of publication of grant and international classification of the European patent(s) concerned;

- A concise statement of the nature of the claim pending or going to be brought before the court and a concise but precise description of the remedy or remedies the plaintiff is claiming or going to claim;

6025 - An estimation of the financial importance of the claim in Euros

- A concise statement of the facts on which the plaintiff is relying and, if known, which of these facts are disputed by the defendant(s);

- The claims of the European patent the plaintiff considers to be infringed and at least one example of every infringement specifying the date and place of infringement.

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- The address of the property on which the inspection is requested;

- A concise description of the matters of which inspection is requested;

- If the property is not that of the defendant, the name, address and, if known, the name and address of the European patent counsel of this third party;

6035 - the name and address of the European patent counsel or European patent attorney who is going to conduct the inspection as executing person and who is not a member of the same firm as the European patent counsel of the applicant or the defendant;

- a description of the steps the applicant wishes the court to direct the conducting European patent counsel to take.

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Rules of Procedure EPJ.

2. The application will have to accompanied by a signed statement of the proposed executing person that he is willing to act as such and promises to equitably guard the interests of both parties.

6045 3. If the defendant is unknown the application will have to be couched in the language in which the patent is granted or the patent application has been filed.

§ 155 Auditum et alteram partem?

6050 1. The court can order the hearing of the other party or its European patent counsel before deciding on the application if this can be done without prejudicing the outcome of the inspection.

2. The court, ordering the hearing of the European patent counsel of the defendant, may order this European patent counsel not to communicate his being heard or the existence of the application to the defendant or to third parties.

§ 156 Discovery/disclosure

6055 1. A person who wants the court to make an order for production of evidence as mentioned in Article 117 of the Protocol has to file through his European patent counsel an application to the court, using a form to be determined in the practice directions.

6060 2. The practice directions will further detail the requirements an application for inspection has to meet.

3. If the defendant is unknown the application will have to be couched in the language in which the patent is granted or the patent application has been filed.

Section 2.3. Other special proceedings in first instance.

Subsection 2.3.1. On admissibility

§ 157 Grounds for defence of non admissibility

6070 1. The only ground for a defence of non admissibility is that the EPJ does not have jurisdiction over the case.

2. The defence as such is only admissible if it is reasoned and mentions the legal provisions on which it is based.

6075 *As we are dealing with one court of first instance and one court of second instance, the statement by a party that the wrong division of EPC1 is dealing with the case, is not to be considered as a defence of non admissibility. Any dispute about what division is to deal with the case is only a matter of efficiency. That matter is regulated in Article 89 juncto § 106 and § 108 to § 110. Thus the only dispute about admissibility can be the dispute about the question whether the EPJ has jurisdiction at all.*

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§ 158 Time limit for defence.

6085 1. The defence of non admissibility can only be filed before or together with the statement of defence. It shall always be in a separate document.

Rules of Procedure EPJ.

2. The time limit for the filing of a statement of defence will not be affected by the filing of a prior defence of non admissibility.

6090 *It is a matter of clear efficiency that the question whether the EPJ has jurisdiction should be decided right at the beginning of the debate and not only after already much time and energy have been invested. Therefore this defence should be raised at the very beginning. Just to prevent it being overlooked and to simplify its administrative processing, it is stipulated that it has to be put in a separate written pleading. To prevent it being used as a delaying tactic it is further stipulated that*
6095 *nevertheless the statement of defence should be filed at the normal time.*

§ 159 Sending to other parties

6100 If a defence of non admissibility is filed, either prior to the statement of defence or together with it, the Registry under the responsibility of the rapporteur will send it to the other party or other parties immediately with a request to reply to it within four weeks or such other time limit as set by the rapporteur.

6105 *As this defence on the one hand goes to the heart of the proceedings before EPCI and on the other hand normally should not form a complicated issue (as the rules of competence of the EPJ are quite strict formulated) there is every reason to speed up the decision on this defence as much as possible. Four weeks should be enough for the plaintiff to explain why in his view there is competence with EPCI as he has to have answered this question before he started proceedings.*

§ 160 Immediate consideration

6110 If a defence of non admissibility is raised it will be considered immediately by the panel and a decision will be given within six weeks after the reply of the other parties has been received or the time limit for that reply has passed.

6115 *Again: as it should not be a very complicated issue and it is decisive for the question whether proceedings are to go on, it should be decided speedily.*

§ 161 Decision

6120 The decision shall be given in writing and shall be reasoned. It will be sent immediately to all parties.

§ 162 Appealable without stay.

- 6125
1. The decision on the defence of non admissibility will be immediately appealable.
 2. The appeal will have to be filed either within four weeks after the decision has been sent to the party concerned or together with the appeal against the final decision in the case.
 3. An appeal from a decision on the defence of non admissibility will only stay the main proceedings in first instance if EPC2 so decides on a request of a party..

6130 *It does make little sense to complete proceedings in first instance if there is a serious risk that the admissibility of the proceedings before the EPJ will be denied by the*

6135 *second instance. Therefore, otherwise than with disputes about the question which
division is the competent one (which is of rather secondary importance) here an
immediate appeal from decisions about admissibility will have to be possible.
On the other hand also here an abuse as a means to gain time should be prevented.
Therefore the appeal proceedings will be possible but will not stay the proceedings
in the first instance, unless EPC2 decides otherwise.*

6140 **Subsection 2.3.2. Addition, removal or substitution of parties.**

§ 163 Application for adding a party

- 6145 1. An application for adding a party to the proceedings can be filed by any party or
by a person wanting to become a party.
2. The application should be filed through a European patent counsel, using a form
to be determined by the practice directions.

§ 164 Requirements

An application for adding a party shall in any case state::

- 6150 - The name and place of domicile of the applicant and the name and address of
the European patent counsel representing him;
- The name and address of the (other) parties in the proceedings and, if known,
the European patent counsel representing them;
- In case the applicant is not the party to be added: the name and address of the
party to be added;
6155 - The case number of the proceedings concerned;
- The capacity in which the applicant wants the new party to participate in the
proceedings;
- A concise statement of the grounds upon which the application is based;

6160 ***§ 165 Grounds.***

The grounds of the application should state that and why it is desirable to add the
new party so that the court can resolve all the matters in dispute in the proceedings;
or that there is an issue involving the new party and an existing party which is
connected to the matters in dispute in the proceedings, and it is desirable to add the
6165 new party so that the court can resolve that issue.

§ 166 Adding of a party or separate proceedings.

6170 Instead of ordering a party to be added to the proceedings, the court can also order
that separate proceedings should be instigated against this new party and that that
new proceedings shall be treated jointly with the existing proceedings.

§ 167 Application for removal of a party.

- 6175 1. An application for removing a party from the proceedings can be filed by any
party.
2. The application should be filed through an European patent counsel, using a form
to be determined by the practice directions.

§ 168 Requirements

An application for removal of a party shall in any case state:

- 6180 - the name and place of domicile of the applicant and the name and address of the European patent counsel representing him;
- the name and address of the other parties in the proceedings and, if known, the European patent counsel representing them;
- the case number of the proceedings concerned;
- 6185 - the name and address of the party to be removed and of the European patent counsel representing him;
- a concise statement of the grounds upon which the application is based;

§ 169 Grounds.

6190 The grounds of the application should state that and why it is not desirable it is not desirable that person being a party to the proceedings, e.g. that its interest or liability has passed on or that its presence in the proceedings unnecessarily complicate or slow down the proceedings.

§ 170 Removal of a party to separate proceedings.

6195 When removing a party from proceedings, the court can also order that the proceedings concerning this party will continue as separate proceedings and the court can order these separate proceedings to be treated jointly with the existing proceedings if that enhances the efficiency of the resolving of a dispute.

6200

§ 171 Application for substitution of a party

An application for a substitution of a party with one or more other persons, shall be regarded as a combined application for adding a party and removing a party.

§ 172 Appeal from a decision to add, remove or substitute a party.

- 6205 1. Decisions of the court to add, remove or substitute a party will be treated as final decisions.
- 2. They will be open to immediate appeal during a period of 3 months after the date the decision is sent to the party concerned by registered mail with confirmation of receipt.
- 6210 3. The filing of an appeal does not stay the main proceedings.
- 4. As long as the decision on appeal has not decided otherwise a party added to the proceedings or a party removed from the proceedings will both be treated as a party to the proceedings.
- 6215 5. The decision on appeal shall state from what date onwards, not necessarily being the date of the decision under appeal, it will have effect and will give a decision about court fees and other costs.

Subsection 2.3.3. As to the exact scope of earlier decisions

6220

§ 173 Application for clarification.

- 6225 1. If the court has given an order comprising an astreinte to be forfeited by a party and there is a dispute between the parties about whether the astreinte has been forfeited or not, any of the parties can through its European patent counsel ask for a decision in that respect, using a form to be determined in the practice directions.
- 6230 2. The application will have to be directed to the Division that has dealt with the former proceedings and the language regime will be that of those former proceedings.
- 6230 3. The panel appointed to decide on this application will be as far as possible comprising the same judges that have formed the panel that has given the decision to be clarified.

§ 174 Simplified proceedings.

6235 The panel shall be able to decide that the clarifying decision will be given immediately after the written part of the proceedings and without an instruction phase and/or without oral proceedings.

Chapter 3. Proceedings on appeal

6240 **Section 3.1. General provisions.**

§ 175 Filing of an appeal.

- 6245 1. An appeal can be filed by filing a statement of appeal, using a form to be determined in the practice directions, within 3 months after the date the decision at first instance is sent to the party concerned by registered mail with confirmation of receipt.
- 6250 2. A statement of appeal can be filed with the Central Registry or with any Regional sub registry. Filing can be done by post, by fax or by electronic means, subject to the regulations of the practice directions in that respect.

§ 176 Term for cross-appeal

- 6255 1. A party who has not appealed from a decision may still file an appeal by way of cross-appeal after the time limit mentioned in § 175 but only if one of the other parties has filed an appeal.
- 6260 2. A cross-appeal should be filed as part of the statement of response in the main appeal proceedings (which then will be called statement of response and cross-appeal) and will not be admissible in any other way or at any other time.
- 6260 3. A statement of cross-appeal should meet the same requirements as a statement of appeal.
- 6260 4. As regards court fees a cross-appeal will be treated as a normal appeal.

§ 177 Requirements.

A statement of appeal shall in any case state:

- 6265 - The name and place of domicile of the appellant and, if appropriate, the representative capacity in which he is a party to the suit;
- The name and address of the European patent counsel representing him;

Rules of Procedure EPJ.

- The name and address of the respondent or respondents and, if known, the European patent counsel representing him or them and, if appropriate, the representative capacity in which the respondent is a party to the suit;
- 6270 - The publication number, application number, title, filing date, date of publication of grant and international classification of the European patent(s) concerned;
- The date and case number of the decision appealed, of which a copy in the language of the patent should be attached, and the estimation of the financial importance of the claim in Euros of the case at first instance;
- 6275 - The grounds of appeal as detailed in § 179

§ 178 New party in appeal.

6280 In case the grounds for such an application have come into being after the closure of the debate at first instance, the statement of appeal may comprise an application to add the appellant as a party to the proceedings or to substitute him for another party.

§ 179 Grounds of appeal.

- 6285 1. The grounds of appeal are numbered statements, stating exactly against which parts of the decision and/or reasoning the appellant opposes and the reasons why.
2. Grounds of appeal not mentioned in the statement of appeal will later on not be allowed into the proceedings.
- 6290 3. If no sufficiently clear formulated grounds of appeal are contained in the statement of appeal, the appeal will be inadmissible, without prejudice to the being due of the appeal fee.

6295 *A party who disagrees with a decision and wants to attack that decision in appeal should know why he disagrees with that decision and be able to formulate concrete grounds on which the decision should be set aside. The appeal should not be used just “to keep the case open”.*

§ 180 File in first instance.

6300 Together with the statement of appeal the appellant will have to file the complete file of the proceedings in first instance.

§ 181 File in first instance in other language.

- 6305 1. If and in as far as the proceedings in first instance have not been conducted in the language of the patent, the appellant will have to file, within a time limit fixed by the panel, translations of the statement of claim, the statement of defence and any further procedural statements filed by the parties and of decisions of EPC1 not being the final decision.
2. The Court can moreover require the filing, within a time limit fixed by the panel, of translations in the language of the patent of such evidence as it thinks fit.
- 6310 3. The appellant can request the documented costs of translation to be taken into account when the court decides about the costs of the proceedings as meant in Article 159 of the Protocol.

§ 182 Consequences of lacking translations.

- 6315 1. If the appellant does not file or does not file in time the requested translation of evidence, the court may leave aside such evidence.
2. If the appellant does not file or does not file in time translation of other required or requested parts of the file in first instance, the court may declare the appeal not admissible.

6320 **§ 183 Registry registers and date stamps.**

1. The Registry where the statement of appeal is filed will check whether the form complies with the requirements mentioned in § 177 .
2. If this should not be the case the Registry will require the European patent counsel who has filed the appeal to complete the statement of appeal. Missing grounds of
6325 appeal however cannot be submitted after the time limit of the appeal has lapsed.
3. Every appeal form that complies with the requirements mentioned in the preceding paragraph will be given a date of receipt that shall be stamped upon the appeal form if on paper.
4. The case shall keep the number it was accorded in the first instance, followed by
6330 the Roman numeral II.
5. If the statement of appeal is filed with a sub registry this sub registry will immediately refer it to the central registry.
6. The central registry will book the appeal with its number and date of receipt in the register of cases, referred to in § 108 .

6335

§ 184 Court fees.

1. Immediately after the receipt of the appeal the central registry will inform the appellant of the court fee due and the time limit within which the fee has to be paid.
2. The registry will point out that the appeal will not be further prosecuted as long as
6340 the fee is not paid and what increased amount will be due if the fee is not paid within the tie limit mentioned.
3. If the European patent counsel of the appellant has a current account with the registry with a sufficient balance, the registry will mention that the fee is debited on that account and that the fee is regarded as paid on the day of receipt of the
6345 statement of appeal.

§ 185 Appointment of panel.

1. Immediately after the appeal has been booked in the register of cases and the court fee has been paid, the President of EPC2 or his delegate will appoint a panel to sit on
6350 the case.
2. The panel will consist of five judges of whom at least one judge will be a technical judge.
3. One of the legal members of the panel will be appointed as rapporteur.

6355 **§ 186 Formal check for admissibility.**

Immediately after his appointment the rapporteur will check whether the statement of appeal contains grounds of appeal or has to be judged clearly inadmissible because of lack of grounds.

6360 *The admissibility check on appeal is not done by the Registry but by the rapporteur because on appeal it seems less likely that cases of clear inadmissibility will occur as the case has been already discussed in extenso, while on the other hand the checking of the grounds of appeal is a legal judgment, better not left to the registry.*

6365 ***§ 187 Clear non admissibility***

1. If the appeal is judged clearly not admissible by the rapporteur as mentioned in § 186 , the Registry will communicate that decision immediately in writing to the appellants European patent counsel, sending a copy of the communication to the other members of the panel.

6370 2. The appellant will be able to challenge this decision without providing new grounds of appeal within a time limit mentioned in that decision but at least two weeks.

3. In case of such a challenge being received in time, the appointed panel in full will immediately decide this aspect of the case without a further hearing.

6375 4. If the decision is set aside the appeal will take its normal course.

§ 188 Sending to the respondent by registry under responsibility of the rapporteur.

If a panel is appointed and the case is not decided to be clearly not admissible, the Registry will, under the responsibility of the rapporteur, send a copy of the statement of appeal and its possible accessories to the respondent at the address of the European patent counsel representing him at the time of the decision under appeal.

6380

§ 189 Statement of response within 2 months.

1. The respondent who wishes to contest an appeal will have to file a statement of response within two months after the date of the registered mail with confirmation of receipt by which the registry has sent him a copy of the statement of appeal.

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2. The statement of response has to be filed through a European patent counsel, using a form prescribed for that purpose by the Executive Committee.

3. This time limit can once be extended by the rapporteur on a written and reasoned request by the respondent.

6390

§ 190 Judgment by default

If no statement of response is received in time by the court the court will, by judgment by default, grant the petition of the appellant as far as this does not seem to contravene the law or the public order and as far as this seems justified by the grounds of appeal.

6395

§ 191 Objection to default judgment

1. A judgment by default will be enforceable, notwithstanding the possibility of the respondent to object to this judgement within one month after he has gotten knowledge about its contents, and at the latest one month after the start of its enforcement.

6400

2. Objection shall take place by filing a claim for objection on appeal, in which the original appellant will be mentioned as respondent.

6405

§ 192 Requirements

A statement of response shall in any case state:

- the name and address of the respondent (where appropriate stating in which representative capacity he is a party to the suit) and the name and address of the European patent counsel representing him;
- the number of the case;
- the name of the appellant;
- his response to each of the numbered grounds of appeal.

6410

§ 193 Sending of response to appellant.

The registry will, under the responsibility of the rapporteur, send a communication containing a copy of the statement of response or the statement of response and cross-appeal to the European patent counsel of the appellant.

6415

§ 194 If cross-appeal response to that by appellant within 2 months.

1. If the respondent has filed a statement of response and cross-appeal the appellant will have the possibility to respond to the cross-appeal by filing a statement of response against cross-appeal within two months after the sending of the communication as mentioned in § 193 .

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2. This time limit can once be extended by the rapporteur on a written and reasoned request by the appellant.

6425

§ 195 Rapporteur sends response to cross-appeal to respondent.

The registry will, under the responsibility of the rapporteur, send a communication containing a copy of the statement of response against the cross-appeal to the European patent counsel of the respondent.

6430

Otherwise the general provisions are of course also applicable to the appeal proceedings. Therefore no special paragraphs about the first conference, evidence and/or the oral proceedings are necessary.

6435

Subsection 3.1.1. Decision and effect of decision

§ 196 Confirmation or revocation of decision under appeal.

The decision of EPC2 shall either confirm the decision under appeal or revoke it totally or in part.

6440

§ 197 Confirmation.

If the decision under appeal is confirmed it shall become res judicata between the parties from the date of the decision in first instance.

6445

§ 198 Referral back or final decision

1. If a decision of EPC1 is revoked, wholly or in part, EPC2 shall either decide the case itself or sent it back to the first instance.

6450

2. EPC2 shall decide the case itself:

- if the revoked decision was exclusively a final decision (with the exception of the case meant in § 112)or

- if all parties have requested that EPC2 shall decide the case itself.

3. Other cases shall be sent back to the first instance.

6455

4. The decision sending a case back to the first instance shall specify the Division of EPC1 that will deal further with the case, be it the same Division whose earlier decision as revoked or another Division.

5. The first instance shall be bound by the decision of EPC2 and its ratio decidendi

6460

Subsection 3.1.2. Special proceedings on appeal

§ 199 Analogous application of some special proceedings at first instance..

Subsection 2.2.1. , Subsection 2.2.4. , Subsection 2.2.5. , Subsection 2.2.6. , Subsection 2.3.2. (with the exception of § 172) and Subsection 2.3.3. will be of analogous applicability , but only in as far as there is an immediate connection with a case pending before EPC2 in appeal.

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Chapter 4.Proceedings on revision

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§ 200 Time limits

A request for revision has to be filed within six months after the date of the judgment irrevocably establishing the criminal offence or – if the request for revision is based on the violation of a fundamental procedural rule – within three months after the date of the decision of EPC2 of which revision is requested.

6475

A party wishing to have a decision set aside because of discovery of a criminal offence, e.g. perjury of an essential witness, will have to be attentive to these matters. It would be possible to have the time limit coupled to the moment the petitioner becomes aware of the offence but it is felt that that option would conflict too much with the interests of third parties who have to be able to be sure of their position at some point in time.

6480

§ 201 Effect on enforceability

The filing of a request for revision will not stay the enforcement of the decision under revision unless the appointed panel decides otherwise.

6485

§ 202 Request

Requests for revision have to be addressed to EPC2 and have to be filed by a European patent counsel representing the petitioner, using a form to be determined in the practice directions.

6490

§ 203 Appointment of panel

After the receipt of a request for revision a panel will be appointed consisting of three legal judges, one of which will be appointed rapporteur.

6495

§ 204 First check of the petition.

1. The panel will examine the request for revision and its accompanying documents.
2. If the panel is unanimously of the opinion that there is no basis for a further prosecution of the case, the panel will strike the case out in a further unmotivated decision.
3. Otherwise the panel will be extended to five legal judges.

6500

A first check on admissibility is built in, in which a panel of only three judges examine the request for revision. If they unanimously agree that there is nothing in it at all, they are able to block it without a motivation. Thus it is prevented that EPC2 is flooded with applications without any chance on success, only filed to keep a case going in court, for instance because of negotiations.

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§ 205 Sending of petition to other party to the decision.

If a panel is appointed and the case is not decided to be clearly not admissible and the case is also not struck out on the basis of § 204 , the Registry will, under the responsibility of the rapporteur, send a copy of the request for revision and its possible accessories to the respondent at the address of the European patent counsel representing him at the time of the decision under revision.

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§ 206 Analogous application of some special proceedings at first instance.

Subsection 2.2.1. , Subsection 2.2.4. , Subsection 2.2.5. , Subsection 2.2.6. , Subsection 2.3.2. (with the exception of § 172) and Subsection 2.3.3. will be of analogous applicability , but only in as far as there is an immediate connection with a case pending before EPC2 in revision.

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§ 207 Decision and effect of decision

1. Unless the request for revision is rejected, the court will revoke the decision under revision in whole or in part and will decide the case anew.
2. A decision on revision will not prejudice the position of third parties and the right acquired by them in good faith before the decision on revision.

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ANNEX II. PROCEDURAL RULES FAC.

§ 1 Request for opinion.

- 6535 1. Any national court of a FAC state that is in charge of proceedings concerning the validity and/or the infringement of European patents can seek an opinion of the FAC, taking into account Article 172 and Article 173 of the Protocol.
2. The request for an opinion shall be in writing and shall be drafted in the language determined according to Article 174 of the Protocol.
3. It shall be sent to the Registry at the seat of the FAC.
- 6540 4. The request shall state all relevant facts of the case before the requesting court causing the request and especially:
- the names, addresses and domiciles of the parties and their representatives in the national proceedings;
- the names of the national judges concerned or having been concerned with the case;
- 6545 the publication number, application number, title, filing date, date of publication of grant and international classification of the European patent(s) concerned;
- a concise statement of the nature of the case and the claims of the parties;
- a concise statement of the facts as established by the national court.
5. The request shall be accompanied by copies of all relevant documents.
- 6550 6. The request shall formulate exactly the question or questions of law about which the requesting court solicits the opinion of the FAC.

§ 2 Comments and opinions of the parties.

- 6555 The request shall be accompanied by the written comments and/or opinions of all parties concerned in the national proceedings or by the statement of the requesting court that parties have been invited to send their comments and/or opinions about the question(s) as put before the FAC but have not used their right to submit such comments and/or opinions.

§ 3 Composition of panel.

- 6560 1. As soon as a request according to § 1 of these Rules is received by the Registry, the Registry will send it to the President of the FAC.
2. The President of the FAC will compose a panel comprising five legal members, unless the nature of the question put before the FAC in his opinion makes it desirable to have one or two technical members on the panel.
- 6565 3. One of the members of the panel will be appointed as chairman of the panel and at least one of the members will be appointed rapporteur.

§ 4 Provisional report.

- 6570 1. The rapporteur will examine the file. He will ask the requesting court for further documents and/or other information if that in his opinion is advisable.
2. The rapporteur will draft a provisional report and send that to the other members of the panel.
3. The Registry will inform the requesting court and the parties that the provisional examination has been concluded.

Rules of Procedure FAC.

§ 5 Changed or redrafted questions.

- 6575 1. If, after the filing of the request for an opinion the requesting court wants to change or redraft its question(s) or if the FAC is of the opinion that a question is not unambiguous and can be understood in another way than the parties seem to have done when drafting their comments, the FAC will invite the parties to file a supplementary opinion.
2. A copy of this request will be sent to the requesting court.

§ 6 Request for oral hearing by parties.

- 6580 1. As long as the Registry has not sent the communication as meant in § 4 (3) any party can file a reasoned request for an oral hearing by the FAC.
2. The FAC will only allow such a hearing if it is of the opinion that this will probably be of major importance for the forming of its opinion.
- 6585 3. Any party will only be heard at the oral hearing after it has paid the fee according to the practice directions of the FAC.

§ 7 Consultation.

1. Immediately after the receipt of the provisional report the chairman of the panel will instigate consultation between the members of the panel.
- 6590 2. The consultation can be oral and/or in writing. Oral consultation can take place in person and/or by telecommunication.

§ 8 Opinion.

The opinion shall be signed by all members of the panel.

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ANNEX III. LIST OF DESIGNATED NATIONAL COURTS.

Belgium:

Cyprus:

6600 Denmark:

Finland:

France:

Germany:

Greece:

6605 Ireland:

Italy:

Liechtenstein:

Luxemburg:

Monaco:

6610 Netherlands:

Portugal:

Spain:

Sweden:

Switzerland.:

6615 Turkey:

United Kingdom:

ANNEX IV. POSSIBLE SCHEDULE FOR THE COMPOSITION OF PANELS.

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It should be stressed that this schedule is meant just as an example to show that it should be possible to create a workable scheme according to which internationally composed panels can be put together with the exclusion of any discretionary power. As long as there are electronic registers of cases and judges panels can be composed for different divisions by their different presidents (or registrars, as there is no judicial or discretionary decision involved).

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Required registers.

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This example supposes that there are a number of registers, electronically accessible for all divisions:

- a register of cases, mentioning the case number, the competent Division, the field of technique involved, and the names and functions of the judges.
- a register of legal judges for every Division, mentioning these judges in alphabetical order and stating which of the official languages of the EPC they do speak.
- a long list of all the legal judges of EPC1, mentioning the judges again in an alphabetical order and stating which official language they speak and what is their nationality.
- an alphabetical list of technical judges for each field of technique, stating which languages they speak.

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Rules for composition of panels:

1. The rapporteur will be that legal judge of the competent Division whose turn it is in alphabetical order on the list of judges of that Division (assuming of course that all judges designated as permanent members to a division will speak all the designated languages for that Division, there is no need to make a special requirement here).

6645

2. The Chairman will be that legal judge:

1. whose turn it is in alphabetical order on the long list of all legal judges of EPC1,
2. who has according to the Register knowledge of the language of proceedings and
3. does not have the same nationality as the rapporteur.

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3. The technical judge will be that technical judge whose turn it is in alphabetical order on the list of technical judges competent for that field of technique in which the case at hand is classified.

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A hypothetical example worked out in detail:

To visualize how such a scheme would work out, assume a somewhat representative number of 35 cases of which 10 are to go to a hypothetical Regional Division in Düsseldorf, 5 are to go to a hypothetical Regional Division in München, 6 are to go to a hypothetical Regional Division in London, 5 to a hypothetical Regional Division for the Benelux in the Hague, and 3 cases go to hypothetical Regional Divisions in Stockholm and Zurich and to the Central Division.

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Lets assume in the order as mentioned in the fictitious register of cases (the other columns will be explained further on):

Annex IV.

6670 *Register of cases.*

Nr.	Division	Technical Field	Language of proc.	Rapporteur	Technical judge	Chairman
1	Düsseldorf	Electr.	G	Braun DE	E1	Andersen DK
2	München	Physics	G	Mannesmann DE	Ph1	Brandt CH
3	London	Chem	E		C1	
4	Stockholm	Chem	E		C2	
5	Central	Mech.	E		M1	
6	Düsseldorf	Mech	G		M2	
7	den Haag	Chem	E		C3	
8	München	Electr.	G		E2	
9	Zürich	Physics	G		Ph2	
10	London	Mech.	E		M3	
11	den Haag	Electr.	E		E3	
12	Düsseldorf	Chem	G		C4	
13	Central	Chem.	F		C5	
14	Düsseldorf	Mech.	G		M4	
15	London	Chem.	E		C1	
16	Stockholm	Mech.	E		M5	
17	Düsseldorf	Mech.	G		M1	
18	London	Chem.	E		C2	
19	München	Electr.	G		E4	
20	Düsseldorf	Phys.	G		Ph3	
21	den Haag	Mech.	E		M2	
22	London	Chem.	E		C3	
23	Düsseldorf	Chem.	G		C4	
24	Stockholm	Mech.	E		M3	
25	Zürich	Electr.	E		E5	
26	Central	Phys.	E		Ph4	
27	München	Chem.	G		C5	
28	Düsseldorf	Chem.	G		C1	
29	Düsseldorf	Mech.	G		M4	
30	den Haag	Phys.	E		Ph5	
31	München	Elctr.	G		E1	
32	Zürich	Chem.	F		C2	
33	London	Chem.	E		C3	
34	den Haag	Mech.	E		M5	
35	Düsseldorf	Chem.	G		C4	

Further every Division has, as mentioned above, its own alphabetical list of its permanent legal judges.

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For instance let us assume that these lists, with of course totally fictitious names and numbers) could look like this:

Annex IV.

Register of legal judges, alphabetically per division.

6680

Central	Stockholm (Scandinavia)	den Haag (Benelux)	London (UK)	Düsseldorf (North Germany)	München (South Germany)	Zürich (Switzer land and Liechten stein)
Brinkman NL	Andersen DK	Brunel LU	Brown UK	Braun DE	Mannesmann DE	Gall CH
Shaw UK	Nillson SE	Jansen NL	Jones UK	Fessel DE	Schuhmacher DE	Kirchne r CH
Becker DE	Olafsson FI	Piters BE	Smith UK	Hart DE	Steiner DE	Tell CH
Brandt CH		Vries NL		Kaufmann DE		
				Meier DE		
				Müller DE		
				Vogel DE		
				Zimmermann DE		

Furthermore, as also mentioned above, there has to be a

Alphabetical long list of all legal judges of EPCI, with nationalities and languages:

6685

<u>Name</u>	<u>nat.</u>	<u>Langua ges</u>	<u>Division</u>	<u>Appointments</u>			
				Rapporteur		Chairman	
Andersen DK	DK	E, G	Stockholm			c1	
Becker DE	DE	G	Central				
Brandt CH	CH	E,F,G	Central			c2	
Braun DE	DE	G	Düsseldorf	r1			
Brinkman NL	NL	E,F,G	Central				
Brown UK	UK	E	London				
Brunel LU	LU	E, F, G	den Haag				
Fessel DE	DE	G	Düsseldorf				
Gall CH	CH	E,F,G	Zürich				
Hart DE	DE	E,G	Düsseldorf				
Jansen NL	NL	E,F,G	den Haag				
Jones UK	UK	E	London				
Kaufmann DE	DE	E,G	Düsseldorf				
Kirchner CH	CH	E, F, G	Zürich				
Mannesmann DE	DE	G	München	r2			
Meier DE	DE	E,G	Düsseldorf				
Müller DE	DE	E,G	Düsseldorf				
Nillson SE	SE	E,G	Stockholm				
Olafsson FI	FI	E,F	Stockholm				
Piters BE	BE	E,F,G	den Haag				
Schuhmacher DE	DE	G	München				
Shaw UK	UK	E, G	Central				
Smith UK	UK	E	London				
Steiner DE	DE	E, G	München				

Annex IV.

Tell CH	CH	E,F,G	Zürich						
Vogel DE	DE	F,G	Düsseldorf						
Vries NL	NL	E,F,G	den Haag						
Zimmerman	DE	G	Düsseldorf						

6690 Appointment of the technical judges does not pose a particular problem: for every field of technique (e.g. physics, electronics, chemistry and mechanics) there has to be made an alphabetical list of the technical judges available for that field of technique and which languages they understand.

6695 According to the rules mentioned above, for every case in a certain field of technique the technical judge whose turn it is, is appointed if he understands the language of the proceedings. In this example they are simply represented by letters and numbers: Mx for the technical judges for mechanics, Cx for the technical judges for chemistry, Ex for the technical judges for electronics and Phx for the technical judges for physics.

Now let us see how the appointment of the legal judges could go:

6700 Case nr. 1 is going to Düsseldorf. Rapporteur therefore will be the first legal judge on the alphabetical list of Düsseldorf: judge Braun DE. His name is entered in the register of cases and in the judges register he gets a “r1” behind his name, meaning that he has been appointed rapporteur in case number 1.

6705 As chairman will have to be appointed the first name on the long list of judges: Andersen DK. He does have the language of the proceedings (G) and he does not have the same nationality as the rapporteur. Behind his name in the judges register is mentioned “c1”, meaning he was appointed chairman in case nr. 1.

6710 The second case is, according to the rules about the competent divisions, going to München. So the rapporteur will be the first judge on the alphabetical list for that Division: judge Mannesmann DE.

6715 As chairman it would be the turn of the German judge Becker DE but he would have the same nationality as the rapporteur so the next judge on the list is taken who has the language of the proceedings: judge Brandt from Switzerland.

6720 The third case is going to London, so the rapporteur will be Brown UK. As chairman it would (still) be the turn of judge Becker DE, but he does not have the English language of the proceedings. Nor does judge Braun DE. So judge Brinkman NL will be appointed as chairman.

6725 Case number 4 goes to Stockholm and the hypothetical language of the proceedings there will be English. So the rapporteur will be Andersen DK. The chairman will be Brown UK, the first non-Danish judge on the list who has English.

Case number 5 is for the Central Division with English as language of the proceedings. Therefore the rapporteur will be Brinkman NL and the chairman judge Brunel LU.

6730 Case 6 is for Düsseldorf. Rapporteur Fessel DE and chairman Gall CH (Becker DE and Braun DE having the same nationality as the rapporteur).

Annex IV.

Case 7 goes to the Hague: rapporteur Brunel LU and chairman Hart DE.

Case 8 goes to München: rapporteur Schuhmacher DE and chairman Kirchner CH.

6735 If we fill in the register of cases and the register of judges further the result would look like this:

Register of cases.

Nr.	Division	Technical Field	Language of proc.	Rapporteur	Technical judge	Chairman
1	Düsseldorf	Electr.	G	Braun DE	E1	Andersen DK
2	München	Physics	G	Mannesmann DE	Ph1	Brandt CH
3	London	Chem	E	Brown UK	C1	Brinkman NL
4	Stockholm	Chem	E	Andersen DK	C2	Brown UK
5	Central	Mech.	E	Brinkman NL	M1	Brunel LU
6	Düsseldorf	Mech	G	Fessel DE	M2	Gall CH
7	den Haag	Chem	E	Brunel LU	C3	Hart DE
8	München	Electr.	G	Schuhmacher DE	E2	Jansen NL
9	Zürich	Physics	G	Gall CH	Ph2	Becker DE
10	London	Mech.	E	Jones UK	M3	Kaufmann DE
11	den Haag	Electr.	E	Jansen NL	E3	Jones UK
12	Düsseldorf	Chem	G	Hart DE	C4	Kirchner CH
13	Central	Chem.	F	Shaw UK	C5	Olafsson FI
14	Düsseldorf	Mech.	G	Kaufmann DE	M4	Nilsson SE
15	London	Chem.	E	Smith UK	C1	Meier DE
16	Stockholm	Mech.	E	Nilsson SE	M5	Müller DE
17	Düsseldorf	Mech.	G	Meier DE	M1	Piters BE
18	London	Chem.	E	Brown UK	C2	Steiner DE
19	München	Electr.	G	Steiner DE	E4	Shaw UK
20	Düsseldorf	Phys.	G	Müller DE	Ph3	Tell CH
21	den Haag	Mech.	E	Piters BE	M2	Smith UK
22	London	Chem.	E	Jones UK	C3	Vries NL
23	Düsseldorf	Chem.	G	Vogel DE	C4	Andersen DK
24	Stockholm	Mech.	E	Olafsson FI	M3	Brandt CH
25	Zürich	Electr.	E	Kirchner CH	E5	Brinkman NL
26	Central	Phys.	E	Brandt CH	Ph4	Brown UK
27	München	Chem.	G	Mannesmann DE	C5	Brunel LU
28	Düsseldorf	Chem.	G	Zimmermann DE	C1	Gall CH
29	Düsseldorf	Mech.	G	Braun DE	M4	Jansen NL
30	den Haag	Phys.	E	Vries NL	Ph5	Hart DE
31	München	Elctr.	G	Schuhmacher DE	E1	Kirchner CH
32	Zürich	Chem.	F	Tell CH	C2	Vogel DE
33	London	Chem.	E	Smith UK	C3	Kaufmann DE
34	den Haag	Mech.	E	Brunel LU	M5	Jones UK
35	Düsseldorf	Chem.	G	Fessel DE	C4	Nilsson SE

6740

Alphabetical long list of all legal judges of EPC1, with nationalities and languages:

Annex IV.

Name	nat	Languages	Division	Appointments							
				Rapporteur			Chairman				
Andersen DK	DK	E, G	Stockholm	r4				c1	c23		
Becker DE	DE	G	Central					c9			
Brandt CH	CH	E,F,G	Central	r26				c2	c24		
Braun DE	DE	G	Düsseldorf	r1	r29						
Brinkman NL	NL	E,F,G	Central	r5				c3	c25		
Brown UK	UK	E	London	r3	r18			c4	c26		
Brunel LU	LU	E, F, G	den Haag	r7	r34			c5	c27		
Fessel DE	DE	G	Düsseldorf	r6	r35						
Gall CH	CH	E,F,G	Zürich	r9				c6	c28		
Hart DE	DE	E,G	Düsseldorf	r12				c7	c30		
Jansen NL	NL	E,F,G	den Haag	r11				c8	c29		
Jones UK	UK	E	London	r10	r22			c11	c34		
Kaufmann DE	DE	E,G	Düsseldorf	r14				c10	c33		
Kirchner CH	CH	E, F, G	Zürich	r25				c12	c31		
Mannesmann DE	DE	G	München	r2	r27						
Meier DE	DE	E,G	Düsseldorf	r17				c15			
Müller DE	DE	E,G	Düsseldorf	r20				c16			
Nillson SE	SE	E,G	Stockholm	r16				c14	c35		
Olafsson FI	FI	E,F	Stockholm	r24				c13			
Piters BE	BE	E,F,G	den Haag	r21				c17			
Schuhmacher DE	DE	G	München	r31							
Shaw UK	UK	E, G	Central	r13				c19			
Smith UK	UK	E	London	r15	r33			c21			
Steiner DE	DE	E, G	München	r19				c18			
Tell CH	CH	E,F,G	Zürich	r32				c20			
Vogel DE	DE	F,G	Düsseldorf	r23				c32			
Vries NL	NL	E,F,G	den Haag	r30				c22			
Zimmerman	DE	G	Düsseldorf	r28							

6745

Of course the whole scheme could be much simpler if we would do away with the requirement that all judges on the panel should understand the language of the proceedings. That however would make it necessary to have simultaneous interpretation during the consultations and discussions of the panels. That seems not advisable as much of a discussion can get lost or misunderstood if an intermediary is necessary.

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Nevertheless it goes without saying that it is difficult for a judge to function on a European level if he only understands one of the official languages.

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Finally: for EPC2 a similar scheme could be devised, although probably here the nationality requirement could be reduced to the rule that the 3 or 4 legal judges should come from at least two different countries.

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