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First Proposal for an EPLP.

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(Explanatory notes in italics.)

	PART I. GENERAL AND INSTITUTIONAL PROVISIONS.....	3
10	PART II. HARMONISING PROVISIONS.....	5
	CHAPTER I.2 SUBSTANTIVE PATENT LAW.....	5
	CHAPTER I.3 RELATIONSHIP TO OTHER INTERNATIONAL LAW.....	7
	<i>Section I.3. 1 Relationship to EU law.....</i>	7
	<i>Section I.3. 2 Relationship to Brussels and Lugano Treaties</i>	7
15	<i>Section I.3. 3 Relationship to EU Council Regulation EC Nr. 44/2001 of 22 December 2000</i> <i>(“Brussels” regulation).....</i>	7
	<i>Section I.3. 4 Relationship to EU Regulation EG Nr. 1348/2000 (Regulation on service of</i> <i>documents).....</i>	8
	<i>Section I.3. 5 Relationship to national law.....</i>	8
20	PART III. EUROPEAN PATENT JUDICIARY.....	9
	GENERAL PROVISIONS	14
	CHAPTER I.4 REGISTRY	17
	CHAPTER I.5 THE COURTS.	18
	<i>Section I.5. 2 The Courts in general.....</i>	18
25	<i>Section I.5. 3 The Judges.....</i>	19
	<i>Section I.5. 4 The European Patent Court of First Instance.</i>	23
	<i>Section I.5. 5 The European Patent Appeals Court.....</i>	26
	CHAPTER I.6 POWERS OF THE COURTS.	26
30	<i>Section I.6. 1 General.....</i>	26
	<i>Section I.6. 2 Injunction.....</i>	26
	<i>Section I.6. 3 Damages in case of infringement.....</i>	27
	<i>Section I.6. 4 Other measures in case of infringement.</i>	27
	<i>Section I.6. 5 Powers as regards parties</i>	28
	<i>Section I.6. 6 Powers as regards evidence.</i>	28
35	<i>Section I.6. 7 Astreinte.....</i>	31
	CHAPTER I.7 PROCEDURAL LAW.	33
	<i>Section I.7. 1 Proceedings in general.....</i>	33
	<i>Section I.7. 2 Stages of proceedings</i>	43
	<i>Section I.7. 3 Evidence.....</i>	47
40	<i>Section I.7. 4 Decisions.....</i>	54
	<i>Section I.7. 5 Costs</i>	57
	<i>Section I.7. 6 Proceedings at first instance.....</i>	57
	<i>Section I.7. 7 Special proceedings at first instance</i>	61
	<i>Section I.7. 8 Proceedings on appeal</i>	66
45	<i>Section I.7. 9 Proceedings on revision</i>	70

Protocol.

PART IV. FACULTATIVE ADVISORY COUNCIL.....71
PART V. TRANSITIONAL AND FINAL PROVISIONS.....73

Protocol.

Part I. GENERAL AND INSTITUTIONAL PROVISIONS

Preamble

5 The Contracting States,
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
10 jurisdiction between a number of states, respecting and taking into account the system of law of the European Union,
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;
15 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,
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:
20

Subsection I. 1. 1. 1 General provisions

Article I.1.1.1.1. 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 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 Council	the Facultative Advisory Council as established by Article I.7.9.1.13 of this protocol.
EPJ	the European Patent Judiciary as established by this protocol.
EPJ-states	contracting states that have acceded to Subsection I. 1. 1. 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.

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
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Protocol.

	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
Practice directions	directions set up by the Executive Committee to regulate practical matters arising in the course of proceedings.

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

5 **Article I.1.1.1.2. 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.

See Art. 1 EPC.

10 **Article I.1.1.1.3. European Patent Judiciary established**

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

15 *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.*

Article I.1.1.1.4. Immunity.

20 **Article I.1.1.1.5. Task of the EPJ**

The function of the EPJ will be the adjudication of litigation concerning the validity and/or infringement of European patents, not being Community Patents, if and in so far as EPJ-states are designated in such European patents.

25 **Article I.1.1.1.6. Seats**

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 ...

30 *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 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*
35 *importance for the success of the EPLP.*

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Part II. HARMONISING PROVISIONS

Chapter I.2 Substantive Patent Law

5 *See WPL 9/99 pat. 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.*

Article I.2.1.1.2. Infringing acts

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

- 10 (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 prohibited without the consent of the proprietor
- 15 (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.

See Art. 25 CPC

Article I.2.1.1.3. Indirect infringement

20 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 into effect.

25 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 I.2.1.1.2

Persons performing the acts referred to in Article I.2.1.1.4 (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.

30

Article I.2.1.1.4. Exceptions from scope of protection

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

- (a) acts done privately and for non-commercial purposes;
- 35 (b) acts done for experimental purposes relating to the subject-matter of the patented invention;
- (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 body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the
- 40 waters of the EPJ states, provided that the invention is used there exclusively for the needs of the vessel;
- (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
- 45 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.

Protocol.

See Art. 27 CPC

Article I.2.1.1.5. Exhaustion

5 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.

10 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.

15 *See Art. 28 CPC and Art. 10 of the Proposal for a Council Regulation on the Community Patent [COM (2000) 412 final]. This text respects the Swiss principle of national exhaustion on the one hand and the EU principle of community exhaustion on the other hand.*

Article I.2.1.1.6. Provisional protection after publication

20 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.

See Art. 32 CPC.

Article I.2.1.1.7. Reversal burden of proof

25 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.

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.

30 *See Art. 35 CPC.*

Article I.2.1.1.8. Prior use

35 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.

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 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.

40 *See Art. 37 CPC.*

Article I.2.1.1.9. Position of licensees.

45 *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.

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.

Protocol.

5 *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 Article I.7.1.2.5).*

Chapter I.3 Relationship to other international law.

Section I.3. 1 Relationship to EU law.

Article I.3.1.1.1.

10 Those EPJ-states that are members of the European Union hereby designate, for litigation concerning European patents, EPC1 and EPC2 as national courts, 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 (ex Art. 177) of the Treaty establishing the European Community

15 *Thus the European Patent Courts can put preliminary questions to the Court of Justice in Luxembourg if questions of European community law should 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.*

Section I.3. 2 Relationship to Brussels and Lugano Treaties

Article I.3.2.1.1.

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.

25 Articles 21, 22 and 23 of these conventions are not applicable to cases for which the EPJ has jurisdiction.

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

Section I.3. 3 Relationship to EU Council Regulation EC Nr. 44/2001 of 22 December 2000 (“Brussels” regulation)

Article I.3.3.1.1.

35 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.

40 *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.*

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

Protocol.

Section I.3. 4 Relationship to EU Regulation EG Nr. 1348/2000 (Regulation on service of documents)

Article I.3.4.1.1.

5 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).

10 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

Relationship to Hague Convention International Conference on IPR?

Section I.3. 5 Relationship to national law

Article I.3.5.1.1. Jurisdiction national courts as regards interlocutory and protective measures

15 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.

20 A party who has applied for such an interlocutory or protective order from a national court shall within four weeks 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 four weeks, the order of the national court will cease to have effect, 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.

25 If no proceedings as to the merits are pending before the EPJ and if such proceedings are not brought before the EPJ within six weeks after the date of the order of the national court, or such shorter term as the national court stipulates, the interlocutory or protective order of the national court will cease to have effect, 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.

30 *See also Art. 24 Brussels and Lugano Treaties. The time limit within which proceedings to the merits have to be instigated is longer than the term mentioned by Art. 50 (6) TRIPS. That longer time limit however seems justified and necessary because of the complicated nature of many patent cases.*

35 *In many cases there has to be some time available to gather evidence or to consult experts. If it seems to be a simple matter the national court can fix a shorter term.*

Article I.3.5.1.2. Jurisdiction of national courts as regards provisional seizure

40 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.

45 A party who has applied for such an order from a national court shall within four weeks 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 four weeks, the order of the national court will cease to have effect, 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.

If no proceedings as to the merits are pending before the EPJ and if such proceedings are not brought before the EPJ within six weeks after the date of the order of the national court, or such shorter term as

Protocol.

the national court stipulates, the interlocutory or protective order of the national court will cease to have effect, 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 I.3.5.1.3.

- 5 The registry will enter the notifications mentioned in Article I.3.5.1.1 and Article I.3.5.1.2 in the register of cases, mentioned in Article I.7.6.2.3.

Part III. EUROPEAN PATENT JUDICIARY

10 *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 (Canadian Federal Court Act (to be downloaded from*

15 *<http://canada.justice.gc.ca/FTP/EN/Laws/Title/F/Index.html>). The Australian model (Federal Court of Australia Act 1976, downloadable from http://www.fedcourt.gov.au/pracproc/practice_fcact.html) goes even a step further: their Federal Court does have first instance and appellate jurisdiction but does not even have two different divisions.*

20 *A model like this seems attractive in view of the restricted human resources available and also for other reasons:*

25 *On the one hand it would be quite clear to which division a certain judge would belong. On the other hand there would be no problem in 'borrowing' a judge from one division by another division if that would be useful, for instance with a view to certain specialisms of judges and/or the workload of the two divisions. Also it would not be necessary to divide the technical judges over the two courts, thereby diluting available technical knowledge.*

30 *The same result could to a large extent be reached with a model in which two separate courts exist but the judges from one court were to be also honorary judges of the other court. That variant is on the one hand more cumbersome from an organisational point of view (possibly the reason why the Australians and Canadians did not opt for that possibility) but on the other hand could facilitate the integration with a future European court for community patents and/or other future judicial structures.*

35 *As few reactions have been received to the first proposal for an index of this protocol it is not sure what model is preferred by most delegations, that of two separate courts or that of one court with two divisions. In this draft a model will be used with two separate courts for two reasons. First this model is probably in future easier to integrate with other structures because it is the most traditional model. Secondly it is the most complicated structure and it would be easier to change later to a more simple model than it would be to start with a simple model and to have to change to a more complicated*

40 *model.*

45 *If a model is used having two separate courts of first and second instance, a scheme of management and administration has to be devised. In this, each court should be able to manage its own business as much as possible. On the other hand a 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.

50 *To avoid possible misunderstandings it is however expressly stipulated that judges can be a member of both courts at the same time. In this way it can be left to praxis to appoint judges in both courts as long as that seems 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). It does seem advisable*

Protocol.

that technical judges be appointed as members of both courts as their expertise will be very much in demand.

5 As regards EPC1 there would first of all have to be a Central Chamber, at the seat of the court. Such a Central Chamber would seem indispensable to enable the court to become a real court and for its members to function really as a team. Furthermore it seems necessary for the acceptance of the court that there is a court visibly present somewhere.

10 This Central Chamber could be manned 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 chambers of EPC1, to be delegated on a rotational basis for, e.g., six months. (See also Subsection I. 5. 4. 2)

15 The task of the Central Chamber of EPC1 would be to deal with those cases in which the defendant is not domiciled within a member state of the EPLP (although not exclusively) and with proceedings for interlocutory injunctions. Furthermore it could of course also provide members for panels where the rapporteur is from a regional chamber. Finally oral hearings, which are not to be held somewhere else in Europe, could take place at the Central Chamber.

20 A strong and understandable wish of interested circles and of a number of delegations is the creation not only of a central chamber but also of regional chambers of EPC1.

Although this wish is very understandable, it causes big organisational problems and therefore perhaps should be re-evaluated. In any case it should be made clearer what exactly is meant by regional chambers.

25 It should be stressed that these regional chambers cannot just be local national courts, acting as chambers of the European Patent Court of First Instance for that would introduce the national courts as such in the system. Taking into account their divergence in experience and quality that would be a reason for industry not to use the system. Therefore this should be avoided.

30 The regional chambers are either to be just a reservoir for manpower and local knowledge for EPC1 and not to sit as such on cases or – if they have to sit on cases - they have to be units composed of judges of different nationalities.

That being said there are in principle two alternative ways to devise these regional chambers:

35 A. Regional chambers only consisting of judges also functioning as members of national courts; only providing EPC with men on the spot.

B. Regional chambers as deciding bodies in regions where is enough work.

ad A:

40 In this option the regional chambers cannot be anything else than organisational units, not as such sitting on cases. It can of course have advantages for the court to have its own people on the spot in all member states.

45 These regional chambers would consist in this option in principle of the national judges of the national courts who would be functioning both as national judges AND (part time) as European judges. (Again: these regional chambers would not be the panels sitting on certain cases)

50 It should be avoided that the Central Chamber and the Regional Chambers are total strangers to each other. On the contrary: there should be as much exchange of ideas as possible. Therefore if this option should be followed, it is suggested that the Central Chamber should not only comprise judges who are committed to this Chamber on a permanent basis but also judges of the regional chambers, who thereto should be rotating between the Regional Chambers and the Central Chamber. Every national legal judge willing to be appointed as a judge of the European Patent Court should therefore realize that he will be assigned some time to a foreign domicile for some six months. Six months does seem a minimum term for a meaningful functioning of a judge who first has to get accustomed to new surroundings etc. Six months also seem to be a period that can be acceptable for someone to be away from home if (and only if) the future seat of the court is at a place that can be easily reached from

Protocol.

everywhere in Europe so that it at least remains possible to spend the weekends at home. Otherwise these judges could be confronted with possible matrimonial and other family problems, which risk would prohibit them from taking part in this court.

5 Therefore it has to be stressed again that it is of vital importance for the success of the system that the seat of the court is at a place that can easily be reached. (It could be said that not all places where international institutions are seated comply with that requirement.)

10 In this way there would be a twofold exchange of ideas between the Central Chamber and the Regional Chambers: on the one hand members of the Central Chamber would be functioning on panels together with members of the Regional Chambers and on the other hand members of Regional Chambers would be taking part in the work of the Central Chamber for a period of at least six months and would afterwards be able to report at home about the way the Central Chamber is functioning.

15 Technical judges on the other hand would be partaking in the work of the court on a less frequent basis, because they would only be appointed on a panel when their specific technical field was concerned. It seems therefore not necessary to require from them a taking up of residence at the seat of the court. It also does not seem worthwhile to have them rotating to the central seat of the court for a certain time.

20 Advantage of this option:

a regional chamber in every member state, able to provide the court with “men on the spot” and better coordination with regional sub registries; could be easier in case the court or the rapporteur would want to organise hearing in a certain member state.

25 Disadvantage:

complicated organisational structure; necessity of rotation of judges between central and regional chambers.

ad B:

30 In this alternative it would be left to the court itself to set up regional chambers in those regions (not necessarily coinciding with states) where there would be enough work to keep such a chamber employed. This would mean creating a kind of “sub-courts”, having their own seats, judges and other personnel. This could re-introduce forum-shopping, unless the central chamber would be totally free to assign cases to a certain regional chamber or not. Furthermore it could create discrepancies in jurisprudence, creating a larger need for appeals to unify this jurisprudence.

35 Advantage of this option:

simpler organisation, better local presence as the court would have a tangible presence locally in the form of its own seat etc., lesser need for rotation of judges.

40 Disadvantage:

possible divergence of jurisprudence (to be unified on the level of EPC2) and a risk of re-introduction of forum shopping, lesser involvement and commitment of “national” judges of EPC1.

The provisional text proposal is based on option A but option B could be an acceptable alternative.

45 The regional chamber in this option A would be a geographical/organisational unit, providing EPC1 with local know-how and local facilities. Local contacts with the bar and the users of the system for such units however would seem difficult to realise. As EPC1 will not only be sitting at its own seat but frequently in the state where the defendant is domiciled, it will be of great importance for EPC1 to have men and women “on the spot” in every contracting state.

50 In my view the rapporteur for a particular case should come from the regional chamber where the (main) defendant is domiciled or from an adjacent regional chamber. I would however prefer not to state that in formal rules but leave it to the court. Otherwise serious problems of overloading of certain regional chambers could arise, which problems could be solved easier if there is no strict rule from where the rapporteur has to be coming. Also I do feel we should not overemphasise the importance of the nationality of the members of the court. The preference for a rapporteur from the country of the defendant would not be motivated by the idea that it would be

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Protocol.

preferable for the defendant to have his “own” judge on the panel but only by the idea that it would be practical to have someone on the spot at the place where the oral hearings probably will take place. Therefore there would be no need to “compensate” the plaintiff by also appointing a judge from his country in the panel.

5

As regards EPC2, this court would not have regional chambers; all its judges therefore would belong to the central chamber. That raises the question, where those judges would have to live: at the seat of the court or could they also remain at home? The latter option would be better to attract judges for this court but could endanger its becoming a real team

10

An Administrative Committee, formed *ex officio* by the members of the Administrative Council of the European Patent Organisation, should govern the EPJ from an organisational point of view. Voting should however be limited to those states that are members of the EPLP (except for voting about matters concerning the Facultative Advisory Council (‘common entity’).

15

It would also be possible to create a whole new body but the set-up suggested here has the dual advantage of being easier to integrate into the structure of the European Patent Organisation if that should be desired in future and also keeping those states involved that at the moment see no possibility of really joining the EPLP. If certain states became members of the EPLP in a later stage, there would be no necessity to appoint new representatives to the Administrative Committee and new member states would automatically be aware of everything that had been going on before. Creating a body with new (other?) national representatives would cause extra bureaucracy and provide extra possibilities for misunderstandings.

20

It should be noted that the Administrative Committee and the Administrative Council of the European Patent Organisation would consist of the same persons but remain two separate legal entities: thus no problem can arise as regards the competence of the Administrative Council and/or the role of the President of the European Patent Office etc. Although the members of the Administrative Council should be identical to the members of the Administrative Committee, it would not do to just make the Administrative Committee into a function of the Administrative Council because some rules should not be applicable automatically.

25

It has been said 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. On the other hand: as is proven in most countries, where the government has the ultimate say in organisational and financial matters of the judiciary, it is perfectly possible to have a governing body without endangering the independence of the judiciary.

30

35

40

Making the Administrative Council and the Administrative Committee of the EPJ congruous does not have to affect the independence of the courts or the judges, as feared by some delegates. It is important in this respect to note 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 Executive Committee.

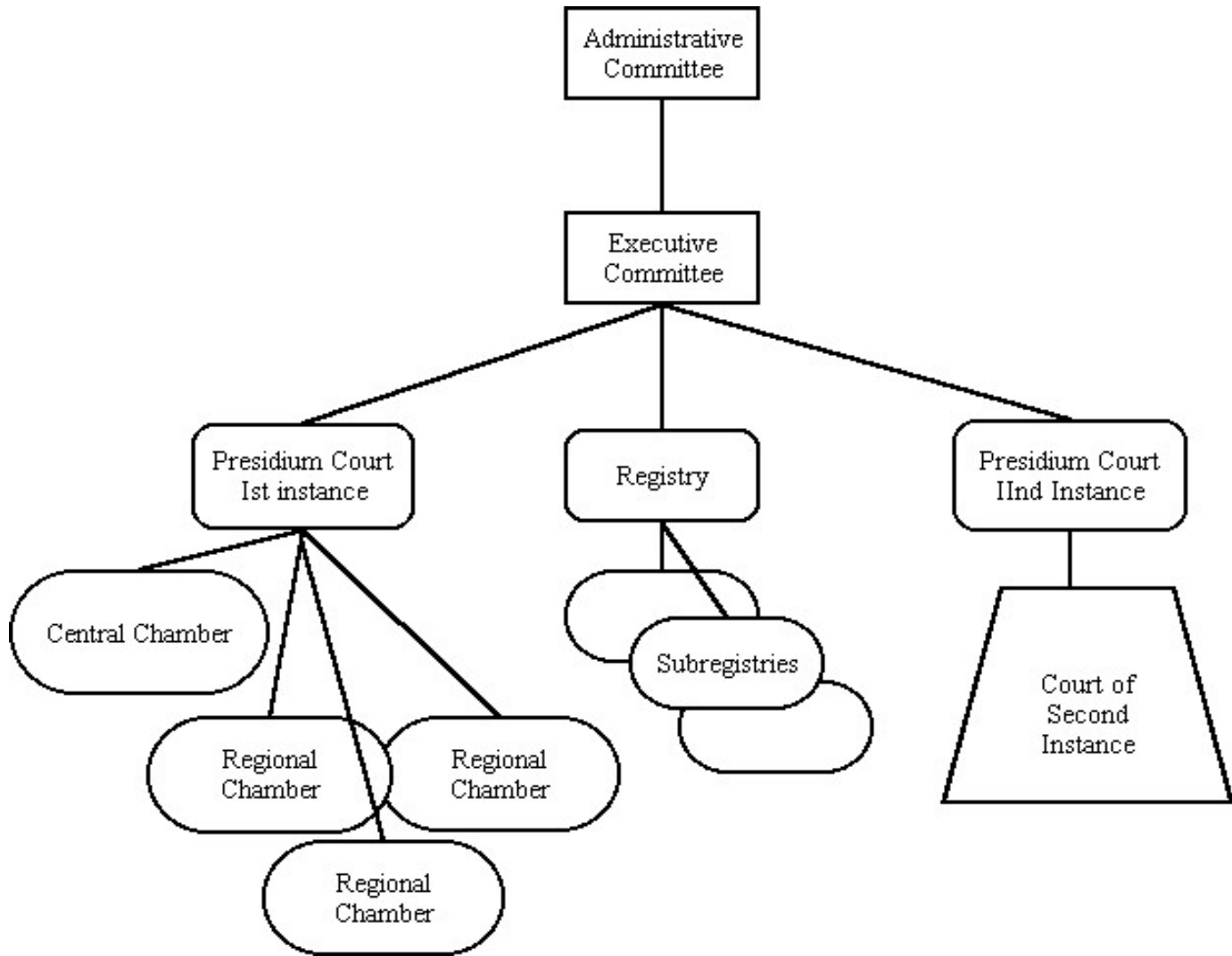
45

A possible model would be that each court would have its own presidium, comprising the president of that court and two elected members.

50

Graphically it could look like this:

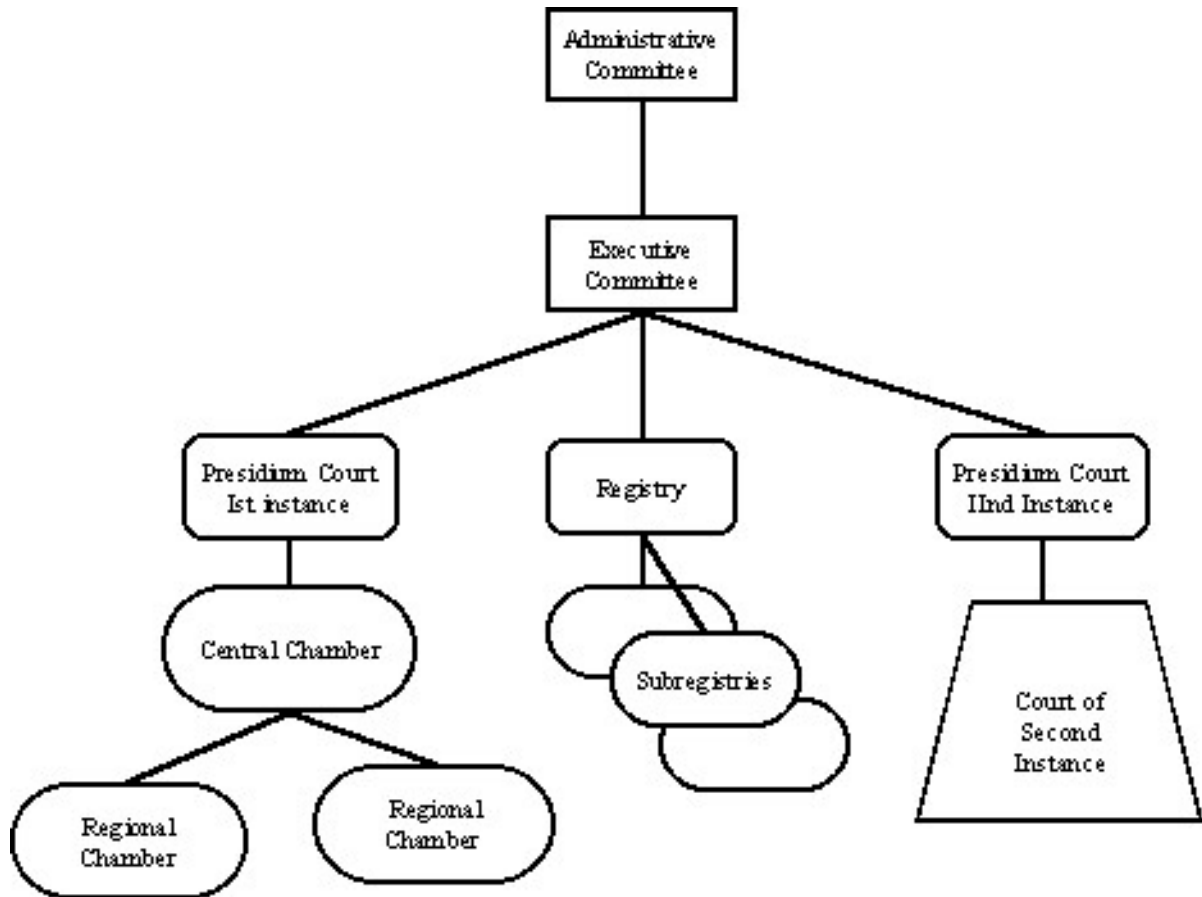
Protocol.



Or, if option B regarding the regional chambers would be preferred:

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Protocol.



5 *Each presidium would have to draft its own budget and propose that to the Executive Committee. The Executive Committee would comprise both presidents and the Registrar. It would have to unify these budgets with that of the registry into one EPJ-budget and present that to the Administrative Committee.*

10 *As regards the appointment of judges a form of consultation of the court concerned could be imagined before the Executive Committee drafts its proposal to the Administrative Committee.*

General provisions

Subsection I. 3. 5. 2 Organisational aspects

15

Article I.3.5.2.1. Organs of the EPJ

The European Patent Judiciary will comprise:

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

Protocol.

Article I.3.5.2.2. Legal personality of the EPJ

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, the courts will be represented by their respective presidents.

5

Article I.3.5.2.3. National courts designated.

Every EPJ-state will designate one of its national courts of first instance to form the basis for the Regional Chambers of EPC1 and the regional sub registries.

10 *This only if option A is followed. In case option B would be preferred, this article would have to be reformulated. But also in that event a national court should be available in each EPLP state to provide facilities for hearings of EPC1 in that state.*

Subsection I. 3. 5. 3 Administrative Committee

Article I.3.5.3.1. Composition and voting rights

The Administrative Committee will be formed by the representatives of the members of the Administrative Council of the European Patent Organisation, who will ex officio be members of the Administrative Committee. Voting rights regarding EPJ matters will be limited to the EPJ-states. Every member state having voting rights will have one vote.

20

See the general introduction at the head of this part.

Article I.3.5.3.2. Chair

25 When and if the chairman of the Administrative Council is not a representative of a member state of the EPLP, the representatives of such member states will elect a chairman of the Administrative Committee from among themselves. If the chair of the Administrative Council moves to a member state of the EPLP, that chairman will ex officio take over the chair of the Administrative Committee.

Article I.3.5.3.3. Meetings

30 Meetings of the Administrative Committee shall be convened by its chairman.
The members of the Executive Committee or their representatives will have the right to be present and to take part in the deliberations.
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.
35 Deliberations shall be based on an agenda and shall be held according to the practice directions of the Administrative Committee, to be established by the Administrative Committee itself.
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.
The practice directions may allow the attendance of observers at some or all meetings of the
40 Administrative Committee.

See Art. 29 and 30 EPC.

Article I.3.5.3.4. Languages.

45 The languages in use in the deliberations of and communications from the Administrative Committee shall be English, French and German.
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.

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.

5

Article I.3.5.3.5. Tasks

The Administrative Committee will:

- determine 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, according to a separate statute on service regulations.
- and, on a proposal of the Executive Committee:
- appoint and reappoint the judges and the registrar of the courts
 - determine on a proposal of the Executive Committee the practice directions of EPC1 and EPC2 and the regulations of the Registry as mentioned in Article I.4.1.1.3;
- 15
- set the fees to be levied by the courts of the EPJ;
 - surveillance and control of the financial annual report of the Executive Committee and the discharge of the Executive Committee in this respect.

Article I.3.5.3.6. Quorum and required majority

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

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

25 *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: $76\% \times 66\% = 50,2\%$.*

Subsection I. 3. 5. 4 Executive Committee

Article I.3.5.4.1. Composition

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

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

35

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.

40

Article I.3.5.4.2. Quorum and majority voting

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

Decisions will be taken by a majority of votes.

45 *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.*

Protocol.

Article I.3.5.4.3. Tasks

The tasks of the Executive Committee are:

- the management of the courts and of the Registry.
- drawing up proposals to the Administrative Committee concerning the number of judges, appointment of judges, fees and practice directions.
- the issuing of rules for the Registry as mentioned in Article I.4.1.1.3;
- 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.

Article I.3.5.4.4. Delegation of tasks

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.

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.

Article I.3.5.4.5. Languages.

Article I.3.5.3.4 is applicable to the meetings of the EC.

Chapter I.4 Registry

Article I.4.1.1.1. Central and regional registries

The Registry will comprise a Central Registry at the seat of the EPJ and regional registries, having their seats at the registries of the national courts as mentioned in Article I.3.5.2.3.

The bulk 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 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.

Article I.4.1.1.2. Function

The tasks of the Registry will be:

- to provide administrative and secretarial assistance to both courts;
- 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;
- to manage the buildings and other material assets of the EPJ

Protocol.

Article I.4.1.1.3. Regulations and rules.

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

5

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.

10

Article I.4.1.1.4. Appointment of Registrar.

The registrar will be appointed by the Administrative Committee on a joint proposal of the Presidents of EPC1 and EPC2.

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

15

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 as necessary until a new Registrar is appointed.

20

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 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 be too strong in this respect.

25

Article I.4.1.1.5. Tasks of the Registrar.

30

The registrar will be responsible for:

- the management of the registry and the sub registries;
- the appointment and dismissal of employees of the central registry
- the budgeting of the registry
- the keeping of the registers prescribed by or under this protocol.

35

Chapter I.5 the Courts.

Section I.5. 2 The Courts in general

Article I.5.2.1.1. Two courts

40

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

Article I.5.2.1.2. The Presidents.

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. The Presidents can be re-elected once.

45

The first Presidents of the courts will be appointed by the Administrative Committee .

Protocol.

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.

5 *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 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.*

10 **Article I.5.2.1.3. Presidium**

Each court shall have a presidium, consisting of its president and two members, elected by the judges of the court. The members of the presidium of EPC1 will ex officio be members of the Central Chamber of that court.

15 The elected members of a presidium will be elected for a period of four years and can be re-elected once. One of the first elected members, to be designated by the drawing of lots, shall be elected for a period of two years.

If option B is preferred as regards the regional chambers, one could imagine a presidium composed of or comprising also the (vice?) presidents of the regional chambers.

20 *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 experience in the presidium should be kept to a minimum.*

Article I.5.2.1.4. Tasks

The tasks of a Presidium will be:

- 25 - to assist the President of the court in his tasks and more especially: the yearly 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,
- 30 - the internal organisation of the court, especially timetables and rosters;
- to make proposals to the Executive committee for the courts' practice directions.

Of course further tasks could be envisaged, for instance – if option B would be preferred regarding the regional chambers – the coordination of the different chambers of the court.

35 **Section I.5. 3 The Judges**

Article I.5.3.1.1.

EPC2 and EPC1 shall consist of a number of legal judges and a number of technical judges. Judges can be member of both courts at the same time.

40

Article I.5.3.1.2. Appointing authority

The judges will be appointed by the Administrative Committee on a proposal from the Executive Committee. The first judges will be appointed by the Administrative Committee on a proposal of the governments of the EPJ-states.

45

Protocol.

Article I.5.3.1.3. Term of office

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.

5 *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.*

10 **Article I.5.3.1.4. Immunity.**

Article I.5.3.1.5. Distribution among nationalities

The Administrative Committee and the Executive Committee will ensure an equitable representation of the nationalities and legal cultures of the EPJ-states among the judges of the courts.

15 At least one judge of every national court, referred to in Article I.3.5.2.3, will be appointed as judge of EPC1 or (during a transitional period of 5 years after this protocol came into force) assessor, of the court.

20 *Although the nationality of the judges should not be overemphasized (and therefore no requirement in that respect is made as regards EPC2), it is necessary that every Regional Chamber should be manned and every national court designated to form the basis of the regional chambers and sub registries should have a relationship with the court. Therefore this provision ensures that at least one national judge is appointed from every state. If option B would be preferred as regards the regional chambers, then the last sentence of this article could be deleted.*

25 **Article I.5.3.1.6. Reappointment as a rule.**

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.

30 The number of legal and technical judges of both courts of the EPJ will be determined by the Administrative Committee, having heard the Executive Committee. The first judges appointed shall include at least one legal judge and one technical judge from every EPJ-state for each of the courts.

35 *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 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 .*

40 *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. Therefore it is suggested that every court should at least have one technical member from each state. 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.*

45 **Article I.5.3.1.7. Requirements for office.**

50 Any person may be appointed a judge of the court who

Protocol.

- a. is or has been a judge in one of the EPJ-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.
- 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.

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.

10 *The Boards of Appeal, both of the Office and of the national patent offices, could be the best source of technical judges.*

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 implicitly the possibility of appointing judges who are not nationals of one of the EPJ states, which could not only make extra human resources available but could also be an important factor to spread the idea of the EPJ.

Article I.5.3.1.8. Assessors

20 Any person who has insufficient experience in patent law but otherwise complies with the criteria set forth in Article I.5.3.1.7 can be appointed as an assessor to the court.

Article I.5.3.1.3 is applicable to assessors.

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.

25 *See the paper WPL 9/99 p. 16: "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. After this training period, he could be appointed as a full EPJ judge."*

30 *Left open for the moment is the question who should decide whether a certain person does not qualify as a judge but could qualify as an assessor. Also left open is the question whether the appointment of an assessor should also take place only on a proposal of the Executive Committee. Nevertheless these are matters to be thought about. One option would be to have the assessors appointed on a proposal of the national governments as they seem to be in relatively the best position to assess the experience of a candidate in patent law matters. 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.*

Article I.5.3.1.9. Legal judges and technical judges.

45 Judges will be appointed as legal judges or as technical judges. Technical judges will be appointed as competent for chemical, physical, mechanical, electro technical and/or software cases.

50 *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 by restricting the number of categories to four or five over-specialization is prevented. 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.*

Protocol.

Article I.5.3.1.10. Incompatibility of other functions.

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 Administrative Committee . Neither will they occupy any political or administrative office.

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.

Article I.5.3.1.11. Oath

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

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 I.7.4.1.5.

Article I.5.3.1.12. End of office

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

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.

Article I.5.3.1.13. Deprivation of office

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.

The initiative in respect of proceedings to that end, further to be detailed in the practice directions, 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.

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.

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 in case a judge cannot even be maintained until his next (non)reappointment, this inherent flaw seems unavoidable.

Article I.5.3.1.14. 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.

See Art 6 PCAC, 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

Protocol.

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.

5 **Section I.5. 4 The European Patent Court of First Instance.**

See the general explanatory notes on page 10 as regards the matter of the regional chambers of the court of first instance. This provision text is based on option A and should be revised totally if option B would be preferred.

10

Subsection I. 5. 4. 2 Central and Regional Chambers

Article I.5.4.2.1.

EPC1 shall comprise a Central Chamber and Regional Chambers.

15

Article I.5.4.2.2. Regional Chambers in every state

There will be a Regional Chamber of EPC1 in every EPJ-state, consisting of those legal judges of the national courts of first instance as mentioned in Article I.3.5.2.3 who are appointed as judges of EPC1 while remaining judges of their national court.

20

As mentioned before, this provision could be made less compulsory and the court could decide where a regional chamber would be created.

Article I.5.4.2.3. Central Chamber

25 There will be a Central Chamber at the seat of EPC2, consisting of those legal judges that are permanently or temporarily assigned to the Central Chamber.

The number of the legal judges of the Central Chamber will be determined by the Presidium of the EPC1.

Article I.5.4.2.4. Rotation of legal judges

30

Legal judges of the Regional Chambers will by rotation be assigned to the Central Chamber for a period of at least six months.

The schedule of rotation will be determined by the Presidium of EPC1, having heard the judges of the regional chambers 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.

35

The schedule of rotation seems to be a subject for discussion among the interested parties concerned. On the other hand a possible veto of the national courts should be avoided as these courts are mostly short of manpower and could be tempted to block an absence of a judge for at least six months. 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. In the unlikely case of a national judge sabotaging his rotation by constantly refusing, this could be a ground for not reappointing him, as the communication between the Central Chamber and the Regional Chambers does seem of the utmost importance to maintain EPC1 as a coherent organisation.

45

Protocol.

Article I.5.4.2.5. Residence

5 The legal judges of the Central Chamber will (in case of temporarily assigned judges: for the time of their assignment) reside at the seat of the court if they are not exempted from this obligation by the Executive Committee .

The (temporary) housing of rotating legal judges will make some claim upon the financial means of the courts. Nevertheless it seems an important aspect of the cohesion of the court and important enough to justify some extra costs..

Article I.5.4.2.6. Technical judges

10 Technical judges will ex officio be part of the Central Chamber but will not have to take residence at the seat of the court.

Article I.5.4.2.7. Composition of panels

15 EPC1 will (barring cases of clear non admissibility) decide cases in panels consisting of two legal judges and one technical judge.

The chairman and, if there is only one rapporteur, the rapporteur must be a legal judge. The President of the court can appoint another member as co-rapporteur if the nature of the case so requires.

20 *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 Article I.7.6.2.5 and Article I.7.6.2.6 to have the Registry checking for cases of clear inadmissibility but giving the party concerned a direct appeal to the full panel.*

25 *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, who will also be hearing witnesses. 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 Section I.7. 3. Thus the rapporteur should be a lawyer. It should however remain possible to appoint more than one rapporteur: in some cases it would be advisable to have a technical judge as co-rapporteur. The proposed text of this article leaves that possibility open.*

30

Subsection I. 5. 4. 3 Jurisdiction

Article I.5.4.3.1. Exclusive jurisdiction on validity

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.

40

45 *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.*

Protocol.

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.

5 *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*
10 *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*
15 *involved. It could then be left to the EPJ to gather further information and/or to stay its proceedings or not.*

Article I.5.4.3.2. Exclusive jurisdiction re infringers domiciled in EPJ state

20 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 I.5.4.3.3. Jurisdiction re infringers domiciled elsewhere.

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

30 *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 the Brussels and Lugano conventions and probably of all national laws.*

Article I.5.4.3.4. Jurisdiction if parties agree.

35 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.

40 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.

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

45 *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. 17 Brussels and Lugano Conventions).*

50 *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*

Protocol.

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.

Section I.5. 5 The European Patent Appeals Court

Subsection I. 5. 5. 1 Jurisdiction

5

Article I.5.5.1.1. Exclusive jurisdiction on appeal and revision

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

10

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.

Article I.5.5.1.2. Composition of panels

15 EPC2 will decide cases in panels consisting of five judges of whom at least one will be a technical judge and at least three will be legal judges. The chairman and – in cases where there is only one rapporteur - the rapporteur will have to be a legal judge. The President of the court can appoint another member as co-rapporteur if the nature of the case does so require.

20

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.

It is not expressly repeated that assessors can be appointed as supernumerary members of a panel because that is stated quite generally in Article I.5.3.1.8.

25

Chapter I.6 Powers of the courts.

Section I.6. 1 General

Article I.6.1.1.1. General provision

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

Article I.6.1.1.2. Security

When the court makes an order, it may :

- 35 (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.

Section I.6. 2 Injunction

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Protocol.

Article I.6.2.1.1. 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.

5 *See Art. 44 TRIPS.*

Section I.6. 3 Damages in case of infringement

Article I.6.3.1.1. Damages

10 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 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.

15 Compensation means that the plaintiff will be put in the same financial position as if the infringement had not taken place.

20 *A the request of a number of delegations there is incorporated a “European” article about damages, although in my view it could be left 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.

25 *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.*

Article I.6.3.1.2. Kinds of damages

30 Damages may consist in a recovery of the profits or estimated profits made by the infringer or be otherwise assessed by the court in such a way that the requirement of Article I.6.3.1.1 (second paragraph) is met.

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.

35 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 I.6.3.1.3. Indemnification of the defendant.

40 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.

Section I.6. 4 Other measures in case of infringement.

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Protocol.

Article I.6.4.1.1. Forfeiture of infringing goods etc.

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.

5 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.

10 In considering such requests the need for proportionality between the seriousness of the infringement and the remedies ordered as well as the interests of third parties will be taken into account.

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

Article I.6.4.1.2. Information in case of infringement.

15 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.

20 *See art 47 TRIPS, again the infringing process is added here.*

Section I.6. 5 Powers as regards parties

Article I.6.5.1.1. Conclusions drawn from behaviour of a party.

25 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
30 by the act or mission in question, subject to the parties having an opportunity to be heard on the allegations or evidence.

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

35

Article I.6.5.1.2. Payment into court as security for costs.

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.

When exercising this power the court must have regard to :

40 (a) the amount in dispute; and

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

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.

45 *See para. 3.1 of the English Civil Rules of Procedure.*

Section I.6. 6 Powers as regards evidence.

Protocol.

Article I.6.6.1.1. Production of evidence..

The courts shall have the authority, where a party has presented reasonably available evidence to support its claims and has specified evidence, relevant to substantiation of its claims, which lies in the control of the opposing party, to order that such latter evidence be produced by the opposing party, subject in appropriate cases to a protective order as defined in Article I.6.6.2.1.

The court shall have the authority to 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 appears probable that that third party is in possession of this evidence due to its relationship to the opposing party mentioned before.

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 Article I.7.3.3.2 for an implementation of this provision.

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.

Article I.6.6.1.2. Freezing orders.

The courts shall have the authority to grant an order

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

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

Article I.6.6.1.3. Orders for inspection etc. of property (Saisie contrefaçon)

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.

Such an order may direct any person to permit any person described in the order, or secure that any person so described 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:

Those steps are-

- (a) to carry out a search for or inspection of anything described in the order, and
- (b) to make or obtain a copy, photograph, sample or other record of anything so described.

The order may also direct the person concerned:

- (a) to provide any person described in the order, or secure that any person so described is provided, with any information or article described in the order, and
- (b) to allow any person described in the order, or secure that any person so described is allowed, to retain for safe keeping anything described in the order.

An order under this section is to have effect subject to such conditions as are specified in the order. 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 21 days after the start of the enforcement of the order.

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.

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

5 (www.hmso.gov.uk/acts/acts1997/1997012.htm) 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.

10 The practice directions should give further details about these orders. See also Subsection I. 7. 7. 7 of this protocol. 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.

15 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 21 days, but this is of course rather arbitrary. It could be imagined to count this term not from the date of execution but from the, easier to prove, date of the order. In that case however it should be considered to make the term longer, as it may take some time for the order to reach the party concerned (postal service is not always and everywhere fast) but it can also take time to instruct the person who has to perform the search, while it should also be possible to adapt the execution to his time schedule.

Subsection I. 6. 6. 2 Protection of commercial secrets etc.

Article I.6.6.2.1. Protective orders.

30 In order to maintain commercial secrets 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. All evidence will be open to inspection to European patent counsel representing the parties but the courts shall have the power to enjoin counsel from communicating certain evidence to their clients and/or other persons.

35 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. The court may make later orders to amend such an order or to revoke it wholly or in part.

40 See Art. 42 last sentence TRIPS.

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. See also Subsection I. 7. 7. 7 of this protocol.

Protocol.

Subsection I. 6. 6. 3 Witnesses

Article I.6.6.3.1. Witnesses.

Without prejudice to the possibility to ask national courts to hear certain witnesses, the courts shall
5 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 €.....

This fine will have to be paid into court. At the end of the proceedings the court will distribute the
10 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
15 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.*

Article I.6.6.3.3. Hearing by national courts

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

The order shall be sent for implementation to the competent judicial authority by letters rogatory under
20 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.

The court shall defray the expenses, without prejudice to the right to charge them to the parties or to
one of them. The court can order the party who wants to hear the witness to pay an amount in court as
25 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.

*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.
30 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.*

Article I.6.6.3.4. Perjury.

Any EPJ state shall treat any violation of an oath or other procedural requirement of truthfulness by a
witness or 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
35 prosecute the offender before its competent court. 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.

See Art. 21 Protocol On The Statute Of The Common Appeal Court

Section I.6. 7 Astreinte

*The European Patent Courts do not have their own police force, let alone their own jails.
45 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*

Protocol.

*astreinte*¹, 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 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*.

Article I.6.7.1.2. 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 that injunction or other order.

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 I.6.3.1.2.

Article I.6.7.1.3. Modalities

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.

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.

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.

Article I.6.7.1.4. Service of (a translation of) the decision

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 and in an official language of that country.

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.

Article I.6.7.1.5. Cancelling of *astreinte*, bankruptcy, death.

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

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.

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

¹ 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.

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.

5

Chapter I.7 Procedural law.

Section I.7. 1 Proceedings in general

10

Subsection I. 7. 1. 1 General provisions.

Article I.7.1.1.1. Nature of proceedings

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

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.

20 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.

25 *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 I.7.1.1.2. Proceedings public.

30 Proceedings before the court shall be public unless the court decides otherwise for consideration of public order or the necessary protection of trade secrets of a party or another interested person. Decisions in this respect shall not be subject to a separate appeal.

35 *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.*

Article I.7.1.1.3. Language.

40 Unless otherwise agreed between the parties and the court, the official language of the European Patent Office in which the European patent or application has been granted or filed shall be used as the language of the proceedings before the court. Article 14 (4) and (5) of EPC and Rules 1 and 2 of the Implementing Regulations to EPC are applicable to proceedings before the court.

45

See Art. 14 EPC, Rules 1 and 2 EPC and Art. 10 CPC.

Protocol.

Article 1.7.1.1.4. Time limits.

5 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.

Article 1.7.1.1.5. Filing of claims and documents.

10 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.

Article 1.7.1.1.6. Electronic filing

15 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.

Article 1.7.1.1.7. Copies of documents filed

Documents can be filed at the central registry or at any sub-registry.
The registry can require paper copies of any document filed in sufficient numbers as detailed in the practice directions.
20 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.

25 *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.*

Article 1.7.1.1.8. Notification of the parties

30 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 central registry by registered mail with confirmation of receipt.
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
35 domicile of the person to be served.
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.

40 *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.*

Article 1.7.1.1.9. Withdrawal of a claim.

45 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.

Protocol.

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 Article I.7.5.1.1.

5 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).

See WPLP 9/99 Annex 1, Rules of Procedure: Points to be decided sub 8).

10 *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 which a withdrawn case should be able to be revived are easily imaginable.*

Article I.7.1.1.10. Change or amendment of claim.

15 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. 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 unreasonably hinder the defendant in other ways in his defence. Limitation of a claim will always be possible, subject to the analogous application of Article
20 I.7.1.1.9.

Article I.7.1.1.11. 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 a advanced
25 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
30 would seriously hinder (other) adversaries of the patent to put the matter before the courts..*

Subsection I. 7. 1. 2 Parties

Article I.7.1.2.1. Parties.

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.

40 *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.*

Article I.7.1.2.2. Plurality of plaintiffs

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

Protocol.

Article I.7.1.2.3. Plurality of defendants

Proceedings can be instigated against a plurality of defendants, provided that the claims against them are sufficiently related to justify a common decision.

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

Article I.7.1.2.4. Court fees in case of plurality.

If and as long as a plurality of parties in a case are represented by one and the same European patent counsel they will be regarded as one party as far as the payment of court fees is concerned.

If a plurality of parties ceases, whether because some of the parties instruct another European patent counsel to represent them 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.

Article I.7.1.2.5. Third parties and change in parties.

The court may, either on its own initiative or 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.

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.

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.*

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.

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.

Article I.7.1.2.6. Consequences for proceedings.

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. It shall also determine the extent to which the new party is bound by the proceedings as then constituted.

Article I.7.1.2.7. Death or demise of a party.

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. The court can fix a time limit in this respect. If there are more than two parties to the proceedings, the court can rule that proceedings between the remaining parties

Protocol.

be continued separately and that the stay will only concern the proceedings regarding the party that no longer exists.

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, the courts may permit to file continuation proceedings against such successor(s). 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.

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.

Article I.7.1.2.8. Insolvency of a party.

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 Article I.7.1.1.9. 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.

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. 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.

Article I.7.1.2.9. Transfer of the patent during proceedings.

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. 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.

If he chooses not to do so any decision in proceedings that have been registered in the register as mentioned in Article I.7.6.2.3 can nevertheless be held against him.

Subsection I. 7. 1. 3 Counsel

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.

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.

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.

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.

Protocol.

Article I.7.1.3.2. European patent counsel.

Parties must be represented before the court by a lawyer registered by the Registrar as a European patent counsel. 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. The practice directions can prescribe a certain form for these applications. The Administrative Committee can levy an annual contribution in the costs of administration for the maintenance of the registration.

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.

Article I.7.1.3.3. 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.

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

Article I.7.1.3.4. De-registration.

If a European patent counsel ceases to comply with the requirements set out in Article I.7.1.3.2 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. 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.

Article I.7.1.3.5. Redress

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. 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.

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.

Article I.7.1.3.6. Powers of attorney.

Every European patent counsel who claims to be representing a certain party will be believed upon his word in that respect. 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.

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

Protocol.

changed its name) and the consequences thereof, the question about the legitimacy of the representation is just shifted to the question of the powers of the person(s) signing the power of attorney.

5 **Article I.7.1.3.7. Disavowal**

A party should under certain conditions have the possibility to deny that an attorney is representing him or to claim that an attorney has exceeded his powers of representation. This matter remains further to be elaborated.

Article I.7.1.3.8. Death or bankruptcy of a legal representative

10 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. 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
15 their case and are asking for a decision on the basis of the documents already filed.

Article I.7.1.3.9. Change of a legal representative.

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. Until that moment the formerly appointed European patent counsel remains
20 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.
25

Article I.7.1.3.10. 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 or by a technical adviser who is an authorised patent representative in a EPJ-state.
30 The technical adviser will be allowed to speak at hearings of the court under the conditions laid down in the practice directions.

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.
35

Article I.7.1.3.11. Rights of representatives

40 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.

Article I.7.1.3.12. Powers as regards representatives

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

Protocol.

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.

5 **Subsection I. 7. 1. 4 Panels and judges**

Article I.7.1.4.1. Appointment of panels

As soon as possible the President of a court before which a case is brought will appoint a panel of judges according to Article I.5.4.2.7 and Article I.5.5.1.2., designating one of its members as chairman and at least one other member as rapporteur. The presidium can set schedules or rules in this respect.

15 *Although in Germany it is thought necessary to determine well beforehand which judges will determine what cases (the system of the “gesetzlicher Richter”), the system proposed here is that the court itself, more especially its president as the person who is responsible for the management of a court, will determine the composition of the individual panels. Most countries have experience with this system and it is not seen as a threat to the independence and impartiality of the judges. Theoretically it should be possible that a President of a court could appoint certain judges, whose general views on certain matters could be known, on cases that are politically or ethically sensitive. This however does not seem to occur in practice, probably because judicial instinct is working properly within the judiciary. Moreover the possibility of excusal and challenge as mentioned in Article I.7.1.4.3 allows the parties and/or the judges to correct what they might consider inappropriate. The practical advantages are self evident: this system provides the utmost flexibility, especially necessary in a situation in which workload and availability of human resources are hard to predict. At first the workload will be mainly on EPC1 and only in a later stage will reach EPC2 but the workload between both courts could remain very different, without the possibility to predict this division of workload exactly. That also makes a flexible apportionment of judges and cases imperative. It should moreover be kept in mind that not only the workload of the EPJ could play a role but – as a large part of the judges will go on functioning as national judges – also the workload in different national courts. Moreover the experience and special knowledge of certain judges can be used in an optimal way if the composition of the panel can be tailored to the case in hand.*

Article I.7.1.4.2. Assessors

If there are assessors appointed to the court, the President will take care that an assessors 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.

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.

Article I.7.1.4.3. Excusal and challenge.

40 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.

45 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. 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.

A judge may be objected to, according to the practice directions, by any party for one of the reasons mentioned in the first paragraph or if reasonably suspected of partiality.

50 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.

Protocol.

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 disputed judge is not sitting.

5 *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.*

10 **Article I.7.1.4.4. Changes in the panel.**

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. If a change in a panel occurs after oral proceedings have taken place, any party can request that new oral proceedings will be held.

15 **Article I.7.1.4.5. Delegation of tasks**

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.

20 *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.*

Subsection I. 7. 1. 5 Case management

25

Article I.7.1.5.1. Case managing task

The courts have an obligation actively to manage the cases before them. During the written and the instruction stages of the proceedings case management will primarily be the responsibility of the rapporteur. After the closure of the debate as mentioned in Article I.7.2.3.12 it will primarily be the responsibility of the chairman.

30

Article I.7.1.5.2. Active management.

Active case management includes:

- 35 (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
40 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;
45 (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

Protocol.

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 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. See Article I.7.1.5.1 and Article I.7.2.3.12.

Article I.7.1.5.3. Managing powers.

Except where this protocol 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);
- (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 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;
- (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;

Article I.7.1.5.4. Varying or revoking orders

A power of the court to make a managing order includes a power to vary or revoke such order.

Article I.7.1.5.5. Exercise of managing powers

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.

Article I.7.1.5.6. Own initiative of the court

Where the court proposes to make an order of its own motion –

- (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.

Article I.7.1.5.7. Hearing of the parties

Where the court proposes –

- (a) to make an order of its own motion; and

Protocol.

(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.

Article I.7.1.5.8. No hearing of the parties

5 The court may make an order of its own motion, without hearing the parties or giving them an opportunity to make representations.

Where the court has made an order under paragraph 1:

(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.

10 An application under the former paragraph must be made :

(a) within such period as may be specified by the court; or

(b) if the court does not specify a period, not more than 7 days after the date on which the order was served on the party making the application.

15 *See pars. 3.3. of the English Civil Rules of Procedure. The first sentence of Article I.7.1.5.5 speaks for clearness' sake expressly of managing powers, so as to distinguish from other powers of the courts mentioned in this protocol.*

Article I.7.1.5.9. Tasks of the judge rapporteur

20 The rapporteur:

- 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;

25 - 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;

- will declare the debate closed when the case is fit for oral proceedings or for decision.

Section I.7. 2 Stages of proceedings

30 *Article I.7.2.1.1. 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.

Subsection I. 7. 2. 2 Written part

35

Article I.7.2.2.1. Contents of written part.

The written part shall consist in the exchange of the written documents as specified for the first instance in Section I.7. 6 and Section I.7. 7 and for the second instance in Section I.7. 8

40 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. The court or its rapporteur can require the parties to answer certain questions in writing, without prejudice to the application of Article I.7.3.3.2 or Article I.7.3.3.3, within a time limit set by the court or the rapporteur.

See Art. 13 Protocol on the Statute of the Common Appeal Court

45 *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*

Protocol.

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.

5 **Subsection I. 7. 2. 3 Instruction part**

Article I.7.2.3.1. Contents of instruction part.

10 The instruction part shall consist of a conference of the parties with the judge-rapporteur and, if appropriate, the taking of evidence, be it in written or electronic form or by the hearing of parties, witnesses, and/or experts.

Article I.7.2.3.2. Dates of non availability of the parties.

15 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.

Article I.7.2.3.3. Rapporteur conducts first conference

20 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

Article I.7.2.3.4. Summons for first conference.

25 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.
If at first instance proceedings the defendant, or the main defendant, is domiciled in an EPJ-state, the first conference shall in principle be held in that state and the rapporteur will request the authorities of the national court as mentioned in Article I.3.5.2.3 to provide the necessary facilities.
At second instance the first conference will be held at the seat of EPC2, unless the parties and the rapporteur agree on another location.
30 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.
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.
35 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.

40 *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 EPC1. Nevertheless room should be given for development of 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.*

Article I.7.2.3.5. Further clarification during or before first conference.

45 The rapporteur can indicate points on which the court needs further clarification, to be provided during or before the first conference.

Protocol.

The rapporteur can request the parties to file during or before the first conference certain documents or answers to certain questions.

Article I.7.2.3.6. Possible settlement.

- 5 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 and request them to be prepared to discuss these possibilities during the conference.

Article I.7.2.3.7. Aim of first conference

- 10 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.
See also Article I.7.2.3.9.

Article I.7.2.3.8. Possible continuation of first conference.

- 15 If the rapporteur thinks fit he can adjourn the first conference and fix a place, date and time for its continuation.

Article I.7.2.3.9. Further instruction.

- 20 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.
To that end the rapporteur can allow parties to hear witnesses (Article I.7.3.4.1), can appoint an expert (Article I.7.3.5.2), can order experiments (Article I.7.3.5.9), can order the production of documents (Article I.7.3.3.2) or request certain documents (Article I.7.3.3.3) or order a local inspection. The
25 rapporteur will fix the dates and time limits for these events as soon as possible.

Article I.7.2.3.10. Hearing of witnesses.

- 30 If the rapporteur has given a party leave to hear witnesses he will organise the hearing. The witnesses will usually be heard by the rapporteur according to the provisions of Subsection I. 7. 3. 4 and the practice directions.

Article I.7.2.3.11. Date for oral proceedings.

- 35 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.

Article I.7.2.3.12. Closure of the debate.

- 40 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.
He will report the closure of the debate to the chairman of the panel, who will take over the management of the case.

Protocol.

Subsection I. 7. 2. 4 Deliberations if no oral proceedings requested.

Article I.7.2.4.1. Deliberation

If none of the parties has requested oral proceedings, the chairman will initiate and organise the deliberation among the members of the panel and ensure a speedy decision.

5

Subsection I. 7. 2. 5 Oral proceedings

Article I.7.2.5.1. Fixing date for oral proceedings.

10 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 Article I.7.2.3.11. fix a date and place for the oral proceedings, unless this was already accomplished by the rapporteur.

Article I.7.2.5.2. Possible preliminary discussion.

15 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.

Article I.7.2.5.3. On request or ex officio

Oral proceedings will be held when one of the parties or the court so requires.

A request for oral proceedings will be honoured when it is filed before the closure of the debate.

20

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.

25

Article I.7.2.5.4. Contents of oral proceedings

30 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. If the court thinks fit it can decide to hear further witnesses and/or experts during the oral proceedings.

Normally the necessary evidence should 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.

35

Article I.7.2.5.5. Directions

The oral proceedings will be presided over by the chairman of the panel.

He shall have all authority necessary for the fair, orderly and efficient conduct of the proceedings.

40

The oral proceedings are public unless the panel decides otherwise.

The court shall endeavour to ensure that the case is ready for decision at the end of the oral proceedings.

Article I.7.2.5.6. Parties not present at oral proceedings.

45 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

Protocol.

on its written case and not wishing to contradict any new statements of fact that may have been made and allowed at the oral proceedings.

As soon as the courts feels it is sufficiently informed the chairman shall declare the debate closed and shall end the oral proceedings. He shall announce the probable date of the decision.

5

Article I.7.2.5.7. Deliberation.

The chairman shall preside over the deliberations of the panel.

The practice directions can give rules about the order of voting.

Article I.7.2.5.8. Decisions

10 The decision of the court shall be given in writing as soon as possible after the closing of the debate. 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.

15 *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.*

Section I.7. 3 Evidence

20 *Evidence is an important but difficult matter, not only in terms of legal theory but also from a practical point of view.*

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.

25 *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.*

30 *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.*

35 *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.*

40 *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.*

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.

45 *In the following proposal a compromise has been sought by creating the possibility to detach the question about the bringing of evidence from that of the onus of proof.*

The idea is that witnesses, being the most time- and cost consuming kind of evidence, will only be heard 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:

50 *either through a decision of the rapporteur, in which case the costs for hearing the witness will not be deemed to have been made unnecessarily but there is no decision about the onus of*

Protocol.

proof, i.e. if a party does not succeed in proving his point in this way, the court is still free in its decision about the outcome of the case and the full panel could later on come to the conclusion that the point was not that relevant after all.

5 *or through a decision of the full panel, in which case this decision comprises also a decision about the onus of proof and the point will be decided against the party who had to bring witnesses.*

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.

10 *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.*

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. 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 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)

Written evidence on the other hand is much less a problem: written evidence consumes relatively small amounts of money, time and energy. Therefore written evidence should be filed as soon as reasonably to be expected from a party. I.e. as soon as 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. Furthermore the court should always have the possibility of requesting certain documents.

25 *The only problem here 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'.*

With evidence in general there should furthermore be some regulation to protect confidential knowledge in the form of a protective order.

40

Subsection I. 7. 3. 2 General provisions

Article I.7.3.2.1. Consequence of not contesting.

45 A statement of fact which is not or not duly motivated contested by the other party shall, without prejudice to Article I.7.1.1.1, be held between the parties to be true.

Article I.7.3.2.2. Offer of proof.

50 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.

Protocol.

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.

5 *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.*

Subsection I. 7. 3. 3 Written evidence.

Article I.7.3.3.1. Written evidence.

10 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.

15 *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.*

Article I.7.3.3.2. Orders for production of documents.

20 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. 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.

25 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. 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
30 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 I.6.6.1.1, of which article this article is an implementation. (Article I.6.6.1.1 however is formulated more generally and covers also other kinds of evidence than documents.)

35

Article I.7.3.3.3. Request of the court for documents

Without prejudice to Article I.7.3.3.1 and Article I.7.3.3.2, 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
40 comply with such a request the court shall draw those conclusions its thinks fit.

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 I.6.5.1.1.

45

Subsection I. 7. 3. 4 Witnesses.

Protocol.

Article I.7.3.4.1. Witnesses only heard after leave.

Witnesses can be heard only after the court or the rapporteur has decided in writing to give leave for such a hearing.

5 Such a leave shall formulate the facts to be proven by the hearing of the witnesses. It can allow the bringing of witnesses to prove the points in question generally but as a rule will mention the witnesses to be heard.

Leave can also be given by way of provisional measure as mentioned in **Error! Reference source not found.** under the circumstances mentioned in that provision.

10 *Normally the court will know the names of possible witnesses because of the obligation of the parties to offer proof as laid down in Article I.7.3.2.2.*

Article I.7.3.4.2. Summoning of witnesses.

Witnesses will have to be summoned by the party calling them according to the rules of the practice directions.

15 They will have to be announced to the court and the other party or parties according to the rules given by the practice directions.

20 *Also in case the witnesses allowed are mentioned in the leave, the court and the other party should know beforehand which witnesses will really be coming forward in order to be able to prepare for their hearing.*

Article I.7.3.4.3. Leave given by the rapporteur.

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.

25 In case the leave is given by the rapporteur the witness can be heard by the rapporteur, by the rapporteur accompanied by the technical judge or by the full panel. Article I.6.6.3.1 is applicable on hearings by the rapporteur.

Article I.7.3.4.4. Leave given by the court.

30 If the court has given leave to hear one or more witnesses, that does imply that the onus of proof is on the party that has offered to bring the witness and is allowed to do so.

In case the leave is given by the court the witness will be heard by the full panel unless this task is by way of exception delegated to one of the members of the panel.

Article I.6.6.3.1 is applicable both on hearings by the full panel or by designated members of a panel.

Article I.7.3.4.5. Hearing by the judge.

35 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 member of the Registry who will take care of the minutes of the session and the summary as mentioned in Article I.7.3.4.9. Witnesses will be heard by the judge, in case of Article I.7.3.4.3 the rapporteur and in other cases the judge presiding over the session or one of his colleagues.

40 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.

45 The judge will decide whether or not a certain question is allowed and has to be answered by the witness. He will take into account all circumstances of the case, including a possible partiality of a witness. A party can require that the refusal of the judge to allow a certain question will be recorded in the minutes of the session.

Protocol.

5 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 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.

Article I.7.3.4.6. Hearing by video link or other means.

10 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. Further regulations can be given by the practice directions.

15 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.

Article I.7.3.4.7. Languages.

A witness will be heard in one of the official languages of the court or in his own language.

20 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 proceedings. 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 will, take these costs into account when deciding about the costs as mentioned in Article I.7.5.1.2.

25

Article I.7.3.4.8. Hearing under oath, consequences of perjury.

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.

30 If a witness should be suspected of perjury, the court or the rapporteur can report such a witness to the authorities of his state of residence or nationality who will deal with this report on the basis of Article I.6.6.3.4, without prejudice to the possibilities of the parties to sue such a witness for damages..

Article I.7.3.4.9. Summary of essentials.

35 During or immediately after the hearing of a witness the judge will dictate a summary of the essentials of the statement of the witness. After the hearing this summary shall be read out to the witness. The witness will state whether this summary contains the essentials of his statement and, if present, will sign the summary. 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

40 aforementioned.

Article I.7.3.4.10. Recordings

Audio recordings will be made of the questions put and the answers given during the hearing of a witness.

45 If the judge does think it advisable a video recording will be made of the hearing of a witness. 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.

Protocol.

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 Article I.7.5.1.2.

The practice directions will regulate the applications for transcriptions and the costs thereof.

5

A question to be answered is whether parties have a right to a copy of the audio (and/or video) registrations and whether they are allowed to make their own recordings.

Article I.7.3.4.11. Indemnification of witnesses.

10 Witnesses will be indemnified by the party calling them for the costs of travelling, stay and loss of income, caused by their hearing.

The practice directions can give standards in this respect. The judge will if necessary thereto make an order, providing the witness with an enforceable title against that party.

15 Subsection I. 7. 3. 5 Experts and experiments.

In technical proceedings as patent cases often are, the technical evidence of experts and experiments can be very important.

20 *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.*

So the court, getting expert evidence from the parties will

25 *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.

30 *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.*

35 *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*
40 *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.*

45 *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 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*
50 *satisfactory the judge will make an order, appointing the 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.*

Protocol.

Article I.7.3.5.2. Experts

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. 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.

Article I.7.3.5.3. Discussion with the parties

The court shall discuss its wish to appoint an expert with the parties, preferably during the first conference as mentioned in Article I.7.2.3.1. 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 questions to be put to the expert(s).

Article I.7.3.5.4. Contact with the expert

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.

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.

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. If the party concerned does not 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.

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 sent in. If the expert has not accepted his appointment in time the court can appoint another expert in his place.

Article I.7.3.5.5. Language.

In case the expert is probably not going to report in the language of the proceedings, the court can order provisions for the translation of the report and the costs of that translation.

Article I.7.3.5.6. Views of the parties.

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. His report shall show that this requirement has been met.

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 than only to have the parties criticise the report of the expert afterwards.

Protocol.

Article I.7.3.5.7. 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.

5 *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, causing 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.*

Article I.7.3.5.8. Alternative expert.

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.

15

Article I.7.3.5.9. Experiments

The court (be it the rapporteur or the whole panel) can allow a party to prove its statements by means of experiments.

20 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.

The experiments will have to be carried out in the presence of the parties, their experts or their representatives.

25 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. 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.

30 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.

Article I.7.3.5.5, Article I.7.3.5.7 and Article I.7.3.5.8 will be analogously applicable.

Article I.7.3.5.10. Local inspection.

35 The court (be it the rapporteur or the whole panel) can decide to inspect products, devices, methods or local situations in situ. The date and time for such an inspection will be determined by the court after consultation of the parties.

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.

40 Of every local inspection minutes will be made by a member of the Registry, 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 I.7. 4 Decisions.

45

Article I.7.4.1.1. - Decisions by majority.

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

Protocol.

Article I.7.4.1.2. Reasoned decisions in writing.

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

5 ***Article I.7.4.1.3. Publication of decisions. Copyright.***

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

10 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.

The Executive Committee can publish all or certain decisions of the EPJ1 or the EPJ2 on the internet. There will be no copyright on decisions of the EPJ.

Article I.7.4.1.4. Right to be heard.

15 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. A party who, although duly summoned, is not present at oral proceedings will be considered to have had the opportunity to be heard about the arguments presented there.

20 *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 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..*

Article I.7.4.1.5. Dissenting opinions

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.

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

Article I.7.4.1.6. Kinds of decisions.

40 Decisions can be provisional, interim or final decisions. Every decision should state expressly what kind of decision it is.

The character of a decision is of importance for the moment it is subject to appeal. As it can be sometimes difficult to ascertain the character of a decision it is preferred to have the decision itself stating what kind of decision it is.

45

Article I.7.4.1.7. Signing of decisions.

Decisions shall be signed by all members of the panel.

Protocol.

Article I.7.4.1.8. Provisional decisions.

A provisional decision is a decision on provisional measures required by one of the parties , such as preliminary injunctions, the granting of leave to perform a saisie or ordering the production of certain documents.

5

Article I.7.4.1.9. Interim decisions.

An interim decision is a decision in which the court allows a party to bring witnesses or perform experiments or in which the court appoints one or more experts to advise the court on certain technical questions.

10

Article I.7.4.1.10. 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.

15

Article I.7.4.1.11. Appealable decisions.

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.

20

Final decisions will be open to appeal immediately after they have been given. Unless laid down otherwise in this protocol, 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. 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.

25

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, notwithstanding an unfavourable interim decision on a certain point.

30

Article I.7.4.1.12. Effect of appeal.

35

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.

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.

40

If both courts have given contradictory decisions in this respect, the decision of EPC2 prevails.

Article I.7.4.1.13. Effect of decisions

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

45

Decisions revoking a European patent wholly or in part shall take effect in all EPJ-states designated in that patent.

Protocol.

Section I.7. 5 Costs

Article I.7.5.1.1. Classification as regards costs.

5 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. 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.

10 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.

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.

15 *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.*

20 *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 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.*

25 *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!).*

Article I.7.5.1.2. Loser pays costs

30 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 Article I.7.5.1.1. If both parties are ruled against in part, the court can divide the costs between them as it sees fit.

Article I.7.5.1.3. Amount

35 The amount of the costs to be paid will be decided by the court in its decision. In decisions not ending the case the court can leave the question of the costs open till a later decision.

Article I.7.5.1.4. Unnecessary costs

40 Leaving 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.

Section I.7. 6 Proceedings at first instance

Subsection I. 7. 6. 1 Start of proceedings

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Article I.7.6.1.1. Start of proceedings at first instance.

Proceedings are started by the plaintiffs European patent counsel filing a statement of claim, using a form to be determined in the practice directions.

Subsection I. 7. 6. 2 Written proceedings

5 *Article I.7.6.2.1. 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.

10 *Article I.7.6.2.2. Requirements*

A statement of claim shall in any case state::

1. The name and address of the European patent counsel representing the plaintiff;
2. The name and place of domicile of the plaintiff and, if appropriate, the representative capacity in which he is suing;
- 15 3. 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;
4. The publication number, application number, title, filing date, date of publication of grant and international classification of the European patent(s) concerned;
- 20 5. A concise statement of the nature of the claim and a concise but precise description of the remedy or remedies the plaintiff is claiming;
6. An estimation of the financial importance of the claim in Euros
7. 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);
- 25 8. 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.

The practice directions can further detail the requirements a statement of claim has to meet.

30 *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*
35 *countries.*

Article I.7.6.2.3. Registry registers and date stamps.

The Registry where the statement of claim is filed will check whether the form complies with the requirements mentioned in Article I.7.6.2.2 sub 1 to 4. If this should not be the case the Registry will
40 require the European patent counsel who has filed the claim to complete the statement of claim. Every claim form that complies with the requirements mentioned in the preceding paragraph will be given a date of receipt that shall be stamped upon the claim form if on paper. Furthermore the case shall get a number according to the regulation in the practice directions in that respect.
45 If the statement of claim is filed with a sub registry this sub registry will immediately refer it to the central registry.
The central 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.

Protocol.

Article I.7.6.2.4. Court fees.

Immediately after the classification as mentioned in Article I.7.5.1.1 the registry will inform the plaintiff of the court fee due and the time limit within which the fee has to be paid. 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.

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.

Article I.7.6.2.5. Appointment of panel.

Immediately after the case has been booked in the register of cases and the court fee has been paid, the President of EPC1 or his delegate will, unless the case is clearly not admissible, appoint a panel to sit on the case. The panel will consist of two legal judges and one technical judge.

Article I.7.6.2.6. Clear non admissibility

If the case is judged clearly not admissible as mentioned in Article I.7.6.2.5, the Registry will communicate that decision immediately in writing to the plaintiffs European patent counsel or, if there is no European patent counsel indicated, to the plaintiff himself.

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. In case of such a challenge being received in time, a panel as mentioned in Article I.7.6.2.5 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 without a further hearing. The decision of the panel in this respect can be appealed to EPC2. 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.

Article I.7.6.2.7. Sending to the defendant 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 claim and its possible accessories to the defendant at his address mentioned in the statement of claim, The registry will accompany this communication by a copy of the text of Article I.7.6.2.8 in German, English and French and by a specimen of the form mentioned in that article. It will furthermore state what court fee will be due by the defendant according to the classification of the case at that moment.

Article I.7.6.2.8. Statement of intended defence within 1 month.

The defendant who wishes to contest a claim brought against him before the court will have to communicate that wish to the court through a European patent counsel, using a form prescribed for that purpose by the Executive Committee. This form will have to be filed with the Central Registry or any regional sub registry within one month after the sending of the communication as mentioned in Article I.7.6.2.7. It will not be regarded as being filed until the court fee due by the defendant has been paid.

If the European patent counsel of the defendant 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 intended defence.

It is felt that the plaintiff and the court should know as soon as possible whether a full blown case is on its way or whether the case will be handled by default. Therefore a statement of intended defence is required. As to the time limit, that is of course rather arbitrary as any time limit. The idea behind the limit of one month is that that is short enough to comply with the requirement of certainty but also

Protocol.

long enough not only to comply with postal problems in certain parts of Europe but also to provide a defendant with enough time to get a provisional opinion of a European patent counsel and/or a European patent attorney about the merits of his case.

5 **Article I.7.6.2.9. Judgment by default**

If no statement of intended 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.

10 *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.*

15 **Article I.7.6.2.10. Objection to default judgment**

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 knowledge about its contents, and at the latest one month after the start of its enforcement.

20 Objection shall take place by filing a claim for objection in which the original plaintiff will be mentioned as respondent. The statement of claim for objection shall, apart from the requirements of Article I.7.6.2.2, 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.

25 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. This provision cannot give occasion to any refund of court fees.

Article I.7.6.2.11. Defendant to reply within 3 months.

30 A defendant who has in time sent in a statement of intended defence will have to file a statement of defence within three months after the sending of the communication as mentioned in article Article I.7.6.2.8.

This time limit can once be extended by the rapporteur on a written and reasoned request by the defendant.

35 If no statement of defence is received in time Article I.7.6.2.9 will be applicable. Objection proceedings will not be possible but the normal rules about appeal will apply.

Article I.7.6.2.12. Requirements

A statement of defence shall in any case state::

- 40
- 1) .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;
 - 2) the number of the case;
 - 3) the name of the plaintiff;
 - 45 4) 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

Protocol.

Article I.7.6.2.13. Possibility of counterclaim.

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.

5

Article I.7.6.2.14. Sending of answer to plaintiff

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.

10

Article I.7.6.2.15. If counterclaim answer to that by plaintiff within 3 months.

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 Article I.7.6.2.14.

15

This time limit can once be extended by the rapporteur on a written and reasoned request by the plaintiff.

The counterclaim has to comply with the same requirements as an original claim.

Article I.7.6.2.16. Rapporteur sends answer counterclaim to defendant.

20

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 I.7. 7 Special proceedings at first instance

Subsection I. 7. 7. 1 On admissibility

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Subsection I. 7. 7. 2 Interlocutory orders

Article I.7.7.2.1. Application for interlocutory injunction.

30

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.

These applications have to be filed at the central registry and have to be addressed to the President of the court.

35

The President can allow an 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.

Article I.7.7.2.2. Requirements

40

The application for a provisional measure will have to comply with the requirements mentioned in Article I.7.6.2.2 and will furthermore make clear why there is a need for an instantaneous provisional measure.

The application will be non admissible unless it demonstrates that the applicant has acted immediately after the need for a provisional measure became clear, taking into account reasonable delay for the collection of proof and/or the ascertaining of the identity of his opponent. This delay will under no circumstance surpass a period of six months after the applicant knows or should have known the need for a provisional measure.

Protocol.

The practice directions will determine what court fee is due by the parties in case of an application for a provisional measure.

Article I.7.7.2.3. Appointment of unus iudex.

5 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.

If there is already pending a case before the court about the same dispute the requested provision is dealing with, the iudex will not be one of the members of the panel sitting on that case.

10 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.

15 *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 but only judicial first aid. This title could be substituted for any better one.*

Article I.7.7.2.4. Setting of date for statement of defence.

20 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.

Article I.7.7.2.5. Request for inability dates for hearing.

25 Under responsibility of the iudex, the registry will send a communication to the defendant, sending him a copy of the application, informing him 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.

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.

30 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

35 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.

Article I.7.7.2.6. Setting of date and place for oral hearing

40 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.

Article I.7.7.2.7. Instruction

45 The iudex will be able to request both parties for certain affidavits, other documents and/or other evidence before or during the oral hearing.

The iudex will not be bound by normal rules of evidence.

Protocol.

Article I.7.7.2.8. Oral hearing

During the oral hearing both parties will be able to present their views within the time limits set by the iudex if necessary.

If one of the parties is not present the iudex shall nevertheless continue the proceedings after having ensured himself that the missing party was duly summoned.

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.

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.

Article I.7.7.2.9. Closure of debate.

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. If he thinks fit the iudex may also announce what the decision is going to be.

Article I.7.7.2.10. Decision

The decision will be reasoned and be signed by the iudex. It will be provisionally enforceable in spite of a possible appeal unless EPC2 decides otherwise. The iudex or EPC2 can set conditions to the enforceability of the decision.

The iudex shall also give a decision about costs.

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 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.

Subsection I. 7. 7. 3 Provisional order to hear witnesses

There should be a possibility to request leave to hear witnesses if there is a danger that they will not be available (any more) at a later date, although perhaps no proceedings are yet pending.

Subsection I. 7. 7. 4 Sequestration of goods.

Subsection I. 7. 7. 5 Addition, removal or substitution of parties.

Article I.7.7.5.1. Application for adding a party

An application for adding a party to the proceedings can be filed by any party or by a person wanting to become a party. The application should be filed through an European patent counsel, using a form to be determined by the practice directions.

Article I.7.7.5.2. Requirements

An application for adding a party shall in any case state::

1. The name and place of domicile of the applicant and the name and address of the European patent counsel representing him;

Protocol.

2. The name and address of the (other) parties in the proceedings and, if known, the European patent counsel representing them;
3. In case the applicant is not the party to be added: the name and address of the party to be added;
4. The case number of the proceedings concerned;
5. the capacity in which the applicant wants the new party to participate in the proceedings;
6. A concise statement of the grounds upon which the application is based;

Article I.7.7.5.3. 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 new party so that the court can resolve that issue.

Article I.7.7.5.4. Adding of a party or separate proceedings.

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.

Article I.7.7.5.5. Application for removal of a party.

An application for removing a party from the proceedings can be filed by any party. The application should be filed through an European patent counsel, using a form to be determined by the practice directions.

Article I.7.7.5.6. Requirements

An application for removal of a party shall in any case state:

1. the name and place of domicile of the applicant and the name and address of the European patent counsel representing him;
2. the name and address of the other parties in the proceedings and, if known, the European patent counsel representing them;
3. the case number of the proceedings concerned;
4. the name and address of the party to be removed and of the European patent counsel representing him;
5. a concise statement of the grounds upon which the application is based;

Article I.7.7.5.7. Grounds.

The grounds of the application should state that and why 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.

Article I.7.7.5.8. Removal of a party to separate proceedings.

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.

Protocol.

Article I.7.7.5.9. 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.

5 *Article I.7.7.5.10. Appeal from a decision to add, remove or substitute a party.*

Decisions of the court to add, remove or substitute a party will be treated as final decisions. 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.

The filing of an appeal does not stay the main proceedings.

10 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.

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 I. 7. 7. 6 Putting up of securities for possible damages

15

Subsection I. 7. 7. 7 As to evidence

20 *Article I.7.7.7.1. Application for inspection (“Saisie”)*

A person who wants the court to make an order for inspection as mentioned in Article I.6.6.1.3 has to file through his European patent counsel an application to the court, using a form to be determined in the practice directions.

The practice directions will further detail the requirements an application for inspection has to meet.

25

Article I.7.7.7.2. Contents of application

An application for inspection shall in any case state:

1. The name and address of the European patent counsel representing the applicant;
2. The name and place of domicile of the applicant;
- 30 3. 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;
4. The publication number, application number, title, filing date, date of publication of grant and international classification of the European patent(s) concerned;
- 35 5. 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;
6. An estimation of the financial importance of the claim in Euros
7. A concise statement of the facts on which the plaintiff is relying and, if known, which
- 40 of these facts are disputed by the defendant(s);
8. 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.
9. The address of the property on which the inspection is requested;
10. A concise description of the matters of which inspection is requested;
- 45 11. 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;
12. the name and address of the European patent counsel who is going to conduct the inspection and who is not a member of the same firm as the European patent counsel of the applicant or the defendant;

Protocol.

13. a description of the steps the applicant wishes the court to direct the conducting European patent counsel to take.

*Article I.7.7.7.3. **Auditum et alteram partem?***

- 5 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. 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.

10

*Article I.7.7.7.4. **Discovery/disclosure***

- A person who wants the court to make an order for disclosure as mentioned in Article I.6.6.1.1 has to file through his European patent counsel an application to the court, using a form to be determined in the practice directions.
- 15 The practice directions will further detail the requirements an application for inspection has to meet. Article I.7.7.7.3 will be analogously applicable.

*Article I.7.7.7.5. **Protection of evidence***

20 **Subsection I. 7. 7. 8 As to the exact scope of earlier decisions**

*Article I.7.7.8.1. **Application for clarification.***

- 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.
- 25 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.

*Article I.7.7.8.2. **Simplified proceedings.***

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.

Section I.7. 8 Proceedings on appeal

35

Subsection I. 7. 8. 1 General provisions.

*Article I.7.8.1.1. **Filing of an appeal.***

- 40 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.

Protocol.

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.

5 **Article I.7.8.1.2. Term for cross-appeal**

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 Article I.7.8.1.1 but only if one of the other parties has filed an appeal.

10 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.

A statement of cross-appeal should meet the same requirements as a statement of appeal.

As regards court fees a cross-appeal will be treated as a normal appeal.

15 **Article I.7.8.1.3. Requirements.**

A statement of appeal shall in any case state:

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;

20 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;

The publication number, application number, title, filing date, date of publication of grant and international classification of the European patent(s) concerned;

25 The date and case number of the decision appealed, of which a copy should be attached, and the estimation of the financial importance of the claim in Euros of the case at first instance;

The grounds of appeal as detailed in Article I.7.8.1.6

Article I.7.8.1.4.

30 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.

Article I.7.8.1.5. Nature of appeal proceedings

The appeal proceedings will not be a new trial of the case.

35 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.

40 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 reasonably been required from the party concerned to provide them.

Article I.7.8.1.6. Grounds of appeal.

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.

45 Grounds of appeal not mentioned in the statement of appeal will later on not be allowed into the proceedings.

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.

Protocol.

Article I.7.8.1.7. Registry registers and date stamps.

The Registry where the statement of appeal is filed will check whether the form complies with the requirements mentioned in Article I.7.8.1.3. 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 appeal however cannot be submitted after the time limit of the appeal has lapsed.

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. The case shall keep the number it was accorded in the first instance, followed by the Roman numeral II.

If the statement of appeal is filed with a sub registry this sub registry will immediately refer it to the central registry.

The central registry will book the appeal with its number and date of receipt in the register of cases, referred to in Article I.7.6.2.3

Article I.7.8.1.8. Court fees.

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. The registry will point out that the appeal 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.

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 statement of appeal.

Article I.7.8.1.9. Appointment of panel.

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 the case. The panel will consist of five judges of whom at least one judge will be a technical judge. One of the legal members of the panel will be appointed as rapporteur.

Article I.7.8.1.10. 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.

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.

Article I.7.8.1.11. Clear non admissibility

If the appeal is judged clearly not admissible by the rapporteur as mentioned in Article I.7.8.1.10, 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.

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. 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.

If the decision is set aside the appeal will take its normal course.

Protocol.

Article I.7.8.1.12. Sending to the respondent by registry under responsibility of the rapporteur.

5 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.

Article I.7.8.1.13. Statement of response within 2 months.

10 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. The statement of response has to be filed through a European patent counsel, using a form prescribed for that purpose by the Executive Committee.

Article I.7.8.1.14.

15 This time limit can once be extended by the rapporteur on a written and reasoned request by the respondent.

Article I.7.8.1.15. Judgment by default

20 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.

Article I.7.8.1.16. Objection to default judgment

25 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.
Objection shall take place by filing a claim for objection on appeal, in which the original appellant will be mentioned as respondent.

Article I.7.8.1.17. Requirements

30 A statement of response shall in any case state:
the name and address of the defendant (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;
35 the number of the case;
the name of the appellant;
his response to each of the numbered grounds of appeal.

Article I.7.8.1.18. Sending of response to appellant.

40 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.

Article I.7.8.1.19. If cross-appeal response to that by appellant within 2 months.

45 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 Article I.7.8.1.18

Protocol.

This time limit can once be extended by the rapporteur on a written and reasoned request by the appellant.

Article I.7.8.1.20. Rapporteur sends response to cross-appeal to respondent.

5 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.

Article I.7.8.1.21. First conference

10 *Article I.7.8.1.22. Oral proceedings.*

Article I.7.8.1.23. Decision and effect of decision

Article I.7.8.1.24. Referral back or final decision

15 **Subsection I. 7. 8. 2 Special proceedings on appeal**

Article I.7.8.2.1. Adding, removing or substituting a party.

Subsection I. 7. 7. 5 will be of analogous applicability with the exception of Article I.7.7.5.10.

20 **Section I.7. 9 Proceedings on revision**

Article I.7.9.1.1. General provisions

Revision of a decision of EPC1 or EPC2 from which appeal is not or not any more possible, 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 rule.

Revision on the basis of a criminal offence may only be requested if that criminal offence is established in a final judicial judgment.

30 *Article I.7.9.1.2. 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.

35 *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.*

40

Protocol.

Article I.7.9.1.3. 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.

Article I.7.9.1.4. Request

- 5 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.

Article I.7.9.1.5. Court fees.

Article I.7.9.1.6. Appointment of panel

- 10 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.

Article I.7.9.1.7. First check of the petition.

- 15 The panel will examine the request for revision and its accompanying documents.
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.
Otherwise the panel will be extended to five legal judges.

Article I.7.9.1.8. Sending of petition to other party to the decision.

20

Article I.7.9.1.9. Instruction

Article I.7.9.1.10. Oral proceedings

- 25 ***Article I.7.9.1.11. Decision and effect of decision***

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.

A decision on revision will not prejudice the position of third parties and the right acquired by them before the decision on revision.

30

Part IV. FACULTATIVE ADVISORY COUNCIL

Article I.7.9.1.12. Definitions

Article I.1.1.1.1 of this protocol will also be applicable to this part of the protocol.

- 35 *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.*

Article I.7.9.1.13.

There is established a Facultative Advisory Council.

- 40 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.

Protocol.

Cosmetically it would be nicer to place this article in part I, for instance after Article I.1.1.1.5, 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 I.1.1.1.2.

5

Article I.7.9.1.14. Administrative Committee

The Administrative Committee will be formed by the representatives of the members of the Administrative Council of the European Patent Organisation, who will ex officio be members of the Administrative Committee. Voting rights will be limited to the Facultative Advisory Council-states. Every member state having voting rights will have one vote. Articles Article I.3.5.3.2, Article I.3.5.3.3, Article I.3.5.3.4, Article I.3.5.3.6 will be applicable analogously.

10

Article I.7.9.1.15. Composition

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

15

Article I.7.9.1.16. Task

The task of the Facultative Advisory Council is to provide national courts on their request with opinions, in specific cases, on questions of law concerning the interpretation of the European Patent Convention or concerning the validity or infringement of a European patent. 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.

20

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.

25

Article I.7.9.1.17. Optional character

It is understood that the national courts will under no circumstances be obliged to refer a question to the Facultative Advisory Council. It is also understood that the national courts will not be bound by the contents of the opinions delivered by the Facultative Advisory Council. 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.

30

35

Article I.7.9.1.18. Financing.

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 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.

40

45

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.

Protocol.

Article I.7.9.1.19. Language.

Article 14 EPC and Rule 6 of the Implementing Regulations of EPC will apply to proceedings before the Facultative Advisory Council.

5

Article I.7.9.1.20. Proceedings

Proceedings before the Facultative Advisory Council are governed by the procedural law as laid down in Annex ... to this Protocol and will in any case comprise a possibility for the parties concerned in the case to present to the Facultative Advisory Council in writing their opinion on the question referred to the Facultative Advisory Council.

10

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.

15

Article I.7.9.1.21.

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

20

Part V. TRANSITIONAL AND FINAL PROVISIONS

20

Article I.7.9.1.22. Entry into force

Part I, Part II and Part III of this protocol will enter into force in all EPJ states after
Part IV of this protocol will enter into force in all Facultative Advisory Council-states after

25

Article I.7.9.1.23. First appointments

For the first time the judges will be appointed by the Administrative Committee on a proposal of the governments of the EPJ-states.

Before the first Registrar shall be appointed according to 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.

30

Article I.7.9.1.24. Start jurisdiction

This protocol shall apply to all European patents / to all European patents applied for after / to all European patents granted after

35

No specific proposals have been put forward up till now. It could also be imagined to leave it to the Administrative Committee to determine the date from which on granted patents would be subject to the jurisdiction of the courts.

40

Article I.7.9.1.25. Transitory provision for parallel systems.

During the first seven calendar years after this protocol has entered into force, a plaintiff wishing to bring infringement proceedings will, in deviation of Subsection I. 5. 4. 3, have the possibility to bring those infringement proceedings not before EPC1 but before the national court of the defendant.

Protocol.

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.

5 If the case concerns defendants domiciled in different member states the plaintiff will, in deviation from article 6 (1) of the Brussels and Lugano Treaties and of Art. 6 of the Jurisdiction Regulation, have to sue every defendant before the national court of every defendant.

As a provision like this contains a deviation from the Jurisdiction Regulation, the EU will have to give its consent.

Article I.7.9.1.26. Only effect in chosen country.

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 I.7.9.1.27. Evaluation.

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. 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. Cases pending before national courts on that moment will continue to be decided according to this provision.

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.

I would like to propose, as a start for the discussion, 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).

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

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

Protocol.

INDEX:

A

admissibility.....	24, 59, 61, 62, 68
appeal.....	21, 22, 26, 31, 38, 41, 43, 65
cross appeal.....	67, 69, 70
grounds of.....	67, 68, 69
statement of appeal.....	59, 66, 67, 68, 69
assessors.....	20, 21, 26, 40
astreinte.....	31

B

bankruptcy of a party.....	37
----------------------------	----

C

case management.....	36, 41, 42, 52, 62
central chamber.....	10, 11, 12
chairman of the panel.....	15, 24, 26, 40, 41, 42, 45, 46, 47, 51, 54
chamber	
central.....	10, 11, 12
regional.....	10, 11, 12, 13, 19, 20, 23
closure of debate.....	41, 42, 43, 45, 46, 67
Community Patent Convention.....	3, 4, 5, 6, 33
concurring decisions.....	22, 55
contempt of court.....	31
continuation proceedings.....	37
copyright.....	55
costs.....	24, 27, 28, 31, 35, 36, 37, 38, 44, 47, 51, 52, 53, 54, 57, 63, 65, 72
unnecessary.....	57
counsel.....	39, 40, 60
counterclaim.....	36, 42, 61, 74
cross appeal.....	34, 56

D

damages.....	6, 8, 9, 27, 29, 30, 32, 51, 65
decisions ...	6, 7, 16, 20, 21, 22, 24, 26, 31, 32, 33, 34, 35, 36, 37, 38, 39, 41, 42, 43, 45, 46, 47, 48, 49, 51, 52, 54, 55, 56, 57, 59, 60, 62, 63, 65, 66, 67, 68, 69, 70, 71, 73, 74
default.....	48, 59, 60, 69
delegation.....	17, 41, 47, 48, 59, 68, 73
disclosure.....	48, 66
discovery.....	48, 52, 66, 70
dissenting opinions.....	22, 55

E

EEX.....	3, 7, 8, 24, 25, 74
electronic filing.....	34
European patent	3, 4, 5, 6, 7, 8, 17, 20, 21, 24, 25, 26, 27, 30, 33, 35, 36, 37, 38, 39, 40, 47, 48, 50, 52, 54, 55, 56, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71, 72, 74
European patent attorney.....	40, 60
European patent counsel	17, 30, 36, 37, 38, 39, 40, 50, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71

Protocol.

European Patent Office.....	3, 12, 21, 22, 33, 35, 39, 55
EVEX.....	3, 7, 8, 24, 25, 74
evidence.....	8, 24, 28, 29, 30, 33, 42, 43, 44, 45, 46, 47, 48, 49, 51, 52, 53, 55, 62, 65, 66, 67, 72
disclosure.....	48, 66
discovery.....	48, 52, 66, 70
experiments.....	45, 52, 54, 56
experts.....	8, 21, 27, 30, 31, 34, 44, 45, 46, 47, 52, 53, 54, 56, 72
onus of proof.....	47, 48, 49, 50
witnesses	
hearing by video link.....	51
ex officio.....	9, 12, 15, 19, 24, 30, 36, 37, 38, 42, 43, 46, 72
excusal and challenge.....	40
Executive Committee.....	4, 12, 14, 15, 16, 17, 18, 19, 20, 21, 22, 24, 55, 57, 59, 69
expert evidence.....	52, 53
F	
fax.....	34, 58, 67
fees.....	16, 17, 27, 36, 37, 57, 58, 59, 60, 62, 65, 67, 68, 71
fine.....	26, 31
first conference.....	43, 44, 45, 53, 70
forfeiture.....	28
G	
gesetzlicher Richter.....	40
I	
incompatibilities.....	22
infringement.....	3, 4, 5, 6, 8, 25, 26, 27, 28, 29, 30, 32, 35, 37, 39, 58, 65, 72, 73, 74
injunction.....	6, 10, 26, 27, 29, 32, 56, 61
provisional.....	47, 50, 56, 61, 62, 63
inspection.....	29, 30, 33, 38, 45, 48, 49, 54, 65, 66
J	
judge rapporteur....	3, 8, 10, 11, 17, 21, 24, 26, 34, 40, 41, 42, 43, 44, 45, 46, 47, 48, 49, 50, 51, 52, 53, 54, 59, 60, 61, 68, 69, 70, 71
judges	
deprivation of office.....	22
legal judges.....	4, 10, 18, 19, 20, 21, 23, 24, 26, 59, 71
residence of.....	11, 24, 31, 51
rotation of.....	11, 23
technical judges.....	4, 9, 10, 11, 19, 20, 21, 24, 26, 48, 50, 59, 68
jurisdiction.....	3, 7, 8, 9, 24, 25, 26, 29, 31, 58, 73, 74
convened.....	25
exclusive.....	8, 24, 25, 26, 74
L	
language.....	15, 16, 17, 30, 32, 33, 37, 51, 53, 73
limitation of a patent.....	24, 25, 33, 35
N	
national courts.....	3, 7, 8, 9, 10, 15, 17, 20, 21, 22, 23, 25, 31, 35, 40, 44, 56, 71, 72, 73, 74
national patents.....	6, 20, 21, 25

Protocol.

notification of parties	34
O	
oath	22, 31, 51
objection to default	60, 69
onus of proof.....	47, 48, 49, 50
oral proceedings.....	24, 33, 34, 41, 43, 45, 46, 47, 48, 54, 55, 62, 66, 70, 71
orders 8, 26, 27, 28, 29, 30, 31, 32, 33, 35, 36, 38, 41, 42, 43, 45, 47, 48, 49, 50, 51, 52, 53, 54, 60, 61, 63, 64, 65, 66, 69	
freezing orders	29
interlocutory orders.....	61
order for disclosure	48, 66
order for inspection.....	29, 30, 33, 38, 45, 48, 49, 54, 65, 66
order for production of documents	45, 48, 49
protective order.....	8, 9, 29, 30, 48
P	
panel.... 3, 4, 10, 11, 12, 17, 21, 24, 26, 38, 40, 41, 45, 46, 47, 48, 50, 51, 52, 53, 54, 55, 57, 59, 62, 66, 68, 69, 71	
party	
death of a party	37
patent attorney	39, 40, 60
payment into court	28, 53, 54
perjury.....	31, 51, 70
plurality of parties.....	35, 36
power of attorney.....	38
practice directions .4, 7, 15, 16, 17, 19, 22, 29, 30, 31, 34, 38, 39, 40, 41, 42, 44, 45, 47, 49, 50, 51, 52, 53, 58, 61, 62, 63, 64, 65, 66, 67, 71	
presidium of the court.....	12, 14, 16, 18, 19, 23, 40, 72, 73
Q	
quorum.....	16
R	
referral	70, 72
regional chambers.....	10, 11, 12, 13, 19, 20, 23
register of cases.....	9, 17, 58, 59, 68
registry	
subregistry.....	11, 15, 17, 18, 20, 58, 59, 67, 68
representation.....	20, 37, 39, 57
European patent counsel .17, 30, 36, 37, 38, 39, 40, 50, 58, 59, 60, 61, 62, 63, 64, 65, 66, 67, 68, 69, 70, 71	
representative.....	12, 15, 16, 35, 36, 37, 38, 39, 42, 46, 50, 51, 54, 58, 60, 65, 67, 69, 72
respondent.....	60, 67, 69, 70
revision	26, 70, 71
S	
saisie contrefaçon.....	29, 30, 56, 65
schedule of rotation.....	23
seat of the courts	4, 10, 11, 12, 17, 23, 24, 44
settlement.....	35, 45, 57, 63
statement of appeal	59, 66, 67, 68, 69
statement of claim.....	58, 59, 60

Protocol.

statement of response.....	67, 69, 70
stay of proceedings	25, 35, 37, 42, 52, 65, 71
summons	8, 34, 44

T

time limit.....	8, 22, 34, 36, 37, 41, 43, 44, 45, 46, 47, 49, 52, 54, 59, 60, 61, 62, 63, 67, 68, 69, 70
transfer of a patent	37
TRIPS	8, 27, 28, 29, 30, 55, 63

V

validity	3, 4, 7, 8, 24, 39, 72
----------------	------------------------

W

witness	24, 31, 33, 34, 44, 45, 46, 47, 48, 49, 50, 51, 52, 56, 63, 70, 72
hearing of witness by video link.....	51