

Bird & Bird

# A Guide to the UPC and the UP

Helping you navigate the practice  
and procedure of the Unified Patent  
Court and the Unitary Patent

*Extract of chapters 10 & 11*

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# Preface

Welcome to *Bird & Bird's Guide to the UPC and the UP*. This Guide is written with a view to guiding the patent practitioner through both the process for obtaining a Unitary patent and the procedure for litigating European and Unitary patents before the Unified Patent Court. Drawing on the knowledge and experience that Bird & Bird's patent litigators and patent attorneys have acquired over many years of litigation practice in their own national jurisdictions, we have done our best to explain how we think this new system will work. However, since this book has been written before the Court has opened its doors, it necessarily represents our personal views as to how the Court is likely to handle the numerous contentious issues that will need to be decided by it. We therefore intend to update this book on a regular basis as the law and practice of the Court develops.

Rather like the story of the Court itself, this Guide has been something of a start-stop-start project. It was kicked off in London in 2014 following which a group of us civil and common law practitioners enthusiastically started working on the first draft. The Brexit referendum in 2016 was the first set-back, followed by two German Constitutional complaints made in 2017 and 2020. The United Kingdom, having initially indicated that it would remain a party, eventually withdrew from the Unified Patent Court Agreement. The Agreement then survived both of the Constitutional complaints and Germany has now ratified it to bring the Court (along with the Unitary patent), at long last, into being.

As a project, the writing of this Guide has been very much a collective effort over the years on the part of numerous current and ex-Birds. Particularly mention should go to Domien Op de Beeck (Belgium), Jirí Malý (Czechia), Mikko Nurmisto (Finland), Yves Bizollon, Laurent Labatte and Anne-Charlotte Le Bihan (France), Dr. Claus Becker, Dr. Annika Lückermann, Dr. Matthias Meyer and Dr. Daniel Misch (Germany), Giovanni Galimberti and Evelina Marchesoni (Italy), Armand Killan and Marc van Wijngaarden (Netherlands), Piotr Dynowski (Poland), Toby Bond, Trevor Cook, Christopher de Mauny, Henry Elliott, Zoe Fuller, Neil Jenkins, Jennifer Jones, Morag Macdonald, Tom Snaith, William Warne and Robert Williams (United Kingdom). Especial thanks should go to Wouter Pors (Netherlands) for his guidance and for sharing his insights and expertise, to Dr. Michael Alt (Germany) for contributing Chapter 2 and to Marianne Abrahams in our marketing department for turning this project into a reality. Thanks also to ex-colleagues Fleur de Chenevix-Trench, Jonathan Edwards and Audrey Horton and most particularly to Bruno Vandermeulen: it would not have been possible without their support and enthusiasm.

Finally, I should mention that every attempt has been made to ensure that this Guide is up to date as of 31 May 2023, but there will inevitably be errors and omissions for which I take responsibility. Given the nature of the Unitary Patent Package project and the purpose of this Guide, I would welcome it if readers would bring any comments or indeed constructive criticism to my attention at [katharine.stephens@twobirds.com](mailto:katharine.stephens@twobirds.com).

**Katharine Stephens**

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# Chapter 10

Infringement of Unitary  
Patents (and European  
Patents Subject to the Court) –  
Substantive Law

# Introduction

**10-01** This chapter deals in turn with both aspects of the substantive law of infringement: first, the acts which the proprietor of a patent has the right to prevent as well as the exceptions to and limitations on those rights and second, the determination of whether an alleged infringing product or process falls within the scope of a patent claim i.e., claim construction and scope of protection.

## Rights, Limitations and Exceptions

**10-02** The rights conferred on proprietors of Unitary patents and European patents subject to the Court's jurisdiction, along with various limitations on those rights, are set out in arts 25 to 28 UPCA:

- Art.25 UPCA provides the right of the proprietor to prevent any third party from direct use of the invention ("direct infringement");
- Art.26 UPCA provides for the right of the proprietor to prevent any third party from supplying means that are essential for putting the invention into effect ("indirect/contributory infringement");
- Art.27 UPCA sets out the limitations on the protection provided by the patent, outlining the acts that do not constitute direct infringement; and
- Art.28 UPCA sets out the exception to patent infringement of personal prior use (i.e. prior use that was not made public but rather kept confidential and therefore attracts a limited exception to infringement).

**10-03** The rights provided under arts 25 and 26 UPCA are also subject to an exhaustion of rights principle, which will apply in the case of products covered by the relevant patent which are placed on the market in the EU (or the rest of the EEA) by, or with the consent of the patent proprietor, unless there are legitimate grounds for the proprietor to oppose further commercialisation of the product. Although expressed in similar language in each case, the legal basis for this principle depends on whether the patent in question is a Unitary patent or European patent subject to the Court's jurisdiction:

- Art.6 Unitary Patent Regulation provides for where there is an exhaustion of rights in the case of a Unitary patent; and
- Art.29 UPCA provides for where there is an exhaustion of rights in the case of a European patent.

**10-04** The infringing acts identified in arts 25 and 26 UPCA, many of the defences to infringement in art.27 UPCA and the exhaustion of rights principle in art.29 UPCA/art.6 Unitary Patent Regulation follow closely arts 29 to 32 of the CPC,<sup>1</sup> and will therefore be familiar to practitioners in European countries which have adopted the infringing provisions of the CPC as part of their national law. While the interpretation of CPC derived provisions has not always been uniform, some degree of consistency has been achieved by national courts treating the decisions of other national courts as a useful source of guidance.

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<sup>1</sup> Which became arts 25 to 28 in the revised CPC of 1989 (89/695/EEC), OJ No. L 401 30.12.1989 p.1.

- 10-05** The Court will have to decide the extent to which it will apply the existing national case law when establishing its own case law regarding infringement. It is submitted that this need not be limited to the case law of Contracting Member States when the courts of another European jurisdiction have also considered the same issue in relation to the same provision. This is especially so where such case law has engaged in comparative legal analysis. Where some form of consensus has been reached by national courts on a particular issue, it would be reasonable to assume that the Court will take this into account when reaching its own decisions. When faced with conflicting national decisions, it will be left to the Court to choose its own path.
- 10-06** While much of arts 25 to 29 UPCA derives from the CPC, the UPCA also provides a number of defences and exceptions to infringement which were not included in the CPC and have been implemented to a varying extent in the national laws. These include the defences to infringement under art.27(c), (d) and (i) to (l) UPCA and the provision regarding rights to continue prior use of an invention contained in art.28 UPCA.
- 10-07** It should also be noted that, while arts 25 to 29 UPCA provide a framework for the Court to determine whether a Unitary patent or European patent subject to the Court's jurisdiction has been infringed, there will be certain situations in which the Court will also need to fall back on national law principles when considering issues relating to infringement. For example, the UPCA does not define the circumstances in which the Court will be entitled to find a party jointly liable for infringement, e.g. as a joint tortfeasor alongside another party.<sup>2</sup>

## Direct Infringement under art.25 UPCA

- 10-08** Art.25 UPCA provides the general rule that any third party may be prevented from directly infringing by using, etc the invention/subject matter of a patent. "Patent" is defined as a "European patent and/or a European patent with unitary effect".<sup>3</sup>
- 10-09** Art.25 UPCA outlines the different acts which amount to direct infringement in subparagraphs (a) to (c). The wording of art.25(a) to (c) UPCA derives from art.29(a) to (c) CPC but also has basis in art.28(1) TRIPS Agreement.<sup>4</sup> In summary:
- Art.25(a) relates to products;
  - Art.25(b) relates to processes; and
  - Art.25(c) relates to products obtained directly by a patented process.

### Art.25(a) UPCA - Products

- 10-10** Under art.25(a) UPCA, it is an infringement to make, offer, place on the market or use a product which is the subject matter of the patent, or import or store the product for those purposes. Thus, this provision relates to infringement of patent claims for products and defines the acts in relation to those products that are prohibited (making, offering, placing on the market, using, and importing or storing for one or more of those purposes). There is no requirement of knowledge on the part of the infringer under art.25(a) UPCA (i.e., the infringer does not need to know that its act constitutes an infringement and does not need to have knowledge that the patent exists).<sup>5</sup>

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<sup>2</sup> See chapter 7 (Applicable Law) paragraphs 7-67 to 7-75.

<sup>3</sup> art.2(g) UPCA.

<sup>4</sup> Which the Court must take into account by virtue of art.24(1)(d) UPCA, see chapter 7 (Applicable Law) paragraphs 7-59 to 7-61.

<sup>5</sup> Although note that a defendant's knowledge as to infringement will become relevant when the Court comes to assess any financial compensation due in relation to the infringement, see chapter 15 (Remedies) paragraphs 15-54 to 15-58.

**10-11** The meanings of the terms “make” and “offer” have been the topic of some debate in the courts of a number of Contracting Member States when considering whether an act infringes a national or European patent. Precisely how these terms will be interpreted by the Court remains to be seen but the Court may draw guidance from the following principles arising from national case law.

## *Make*

**10-12** German courts have considered the interpretation of “make” on a number of occasions and concluded that it should be construed in a broad sense, including each element of the whole production process from the beginning to the finished product, such that it is not necessary that the entire product has been produced by one person. However, purely preparatory acts preceding the manufacture (e.g. drafting technical drawings) were not considered to qualify as “making”.<sup>6</sup>

**10-13** Modifications or substantial repairs of a patented product have also been classified by the German courts as a (re-)manufacturing of a product and so exclusively reserved for the patentee.<sup>7</sup> This, however, only applies if the modification or repair changes the identity of the original product in a way that makes it such that the product can be considered as a new product, and this has to be assessed on a case-by-case basis. As a guideline, a German court will assume that the patent is infringed if the repair work leads to the renewal of parts which are usually not replaced/repaired during the lifetime of the patented product, or in which the essential characteristic of the invention is realised.<sup>8</sup>

**10-14** The UK Supreme Court has also considered the meaning of the word “makes”. After considering the relevant decisions of the German courts, the UK Supreme Court concluded that “makes” should be read in a practical way and in context and is not a term of art such that it would inevitably be a matter of fact and degree in many cases whether an activity involved “making” an article or fell short of it. The court indicated that it may sometimes be useful to consider whether the alleged infringer is repairing rather than making the article, although this should not be allowed to obscure the central issue of whether the alleged infringer “makes” the patented article.<sup>9</sup>

## *Offer*

**10-15** The “offer” must be an offer within the territory of the Contracting Member States in relation to infringing products. Therefore the Court is likely to consider an offer made by a retailer outside the territory, but which targets customers within it, as falling within the scope of this section. Note however that the relevant act under this ground is the offer itself, irrespective of whether the offer results in an actual sale. The ultimate location in which the infringing product will be supplied as a result of the offer does not matter, e.g. an offer made in Germany to supply infringing products in the United States would still fall within the scope of art.25(a) UPCA. When considering the equivalent UK law provision (“offering for disposal”) the UK court, referring to the wording of art.29(a) CPC (from which art.25(a) UPCA derives) concluded that it extended beyond specific offers for sale and also covered offering in pre-contractual negotiations or an advertisement. The court did however conclude that, in order to be an infringement, the offer must relate to a supply which would take place during the lifetime of the patent. The contents of a website are likely to constitute an offer within the territory of the Contracting Member

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<sup>6</sup> *Mülltonne* GRUR 1951, 452, German Federal Supreme Court; *Kleiderbügel* GRUR 1995, 338, 341, German Federal Supreme Court; *Rundfunkübertragungssystem* GRUR 1987, 626, German Federal Supreme Court; *Simvastatin* GRUR 2007, 221, German Federal Supreme Court.

<sup>7</sup> *Rheinmetall-Borsig-Urteil I* GRUR 1956, 265, German Federal Supreme Court; *Flügelradzähler* GRUR 2004, 758, German Federal Supreme Court; *Laufkranz* GRUR 2006, 837, German Federal Supreme Court; *Palettenbehälter II* GRUR 2012, 1118, German Federal Supreme Court; *Pipettensystem* GRUR 2007, 769, German Federal Supreme Court.

<sup>8</sup> *Palettenbehälter II* GRUR 2012, 1118, BGH.

<sup>9</sup> *Schutz (UK) Ltd v Werit UK Ltd* [2013] UKSC 16.

States if the website specifically targets customers within Contracting Member States with an offer to supply the infringing product.

### *Placing on the Market*

**10-16** Transferring physical possession of a product within a Contracting Member State in the course of commerce will clearly be “placing on the market”. The term is however capable of broader interpretation<sup>10</sup> and the Court will need to establish its own case law to define the scope of the acts which constitute placing on the market under art.25(a) UPCA.

### *Use*

**10-17** Use of a product will typically be preceded by another act prohibited by art.25(a) UPCA, such as an offer and/or a placing on the market of the product. Prohibiting the use of an infringing product may however have particular utility where the patentee wishes to prevent the activities of an end user of the product, who may not themselves have made, imported, offered or placed that product on the market.

### *Importing for the Purposes of Making, Offering, Using or Placing that Product on the Market*

**10-18** While there may be circumstances in which a defendant is successfully able to argue that the importation was not for one of these purposes, in reality such cases will be few and far between. One issue the Court may need to consider is which entity is responsible for the importation, especially in cases where it is a commercial carrier who physically transports the product into the relevant Contracting Member States. The entity responsible for the importation may not necessarily be the entity which contracts with the carrier and the Court may need to consider ownership of the legal title to the product at the point of physical transfer in order to decide who is responsible for the importation.<sup>11</sup>

### *Storing for the Purposes of Making, Offering, Using or Placing that Product on the Market*

**10-19** The term “storing” in art.25(a) UPCA differs slightly from the equivalent provision in art.29(a) CPC which refers to “stocking”. On its face the term “storing” would appear to be broader than “stocking”, as the latter is more closely linked to the onwards commercial supply of the product to a third party. However the requirement that the storing is for the purposes of making, offering, using or placing that product on the market suggests that in practice the effect of any distinction between “storing” and “stocking” may be relatively small.

## **Art.25(b) UPCA - Processes**

**10-20** Under art.25(b) UPCA, it is an infringement to: (i) use a process which is the subject matter of the patent; or (ii) offer the process for use, where the infringer knows or should have known that the use of the process is prohibited.

### *Use a Process*

**10-21** A process claim is infringed by any person who carries out all of the steps set out in the claim, either on its own or as part of a longer and more complex process.

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<sup>10</sup> For example in the context of EU product safety legislation, “placing on the market” is considered to cover any “offer or an agreement (written or verbal) between two or more legal or natural persons for the transfer of ownership, possession or any other property right concerning the product in question”, see section 2.3 of Commission Notice – The ‘Blue Guide’ on the implementation of EU products rules 2022 (OJ No. C 247 29.06.2022 p.1).

<sup>11</sup> See for example the discussion by the UK House of Lords (as it was then) in *Sabaf v Meneghetti* [2005] UKHL 45 at [34] to [45].

**10-22** To infringe, the process must be used within the jurisdiction of the Court and that means within the territory of the Contracting Member States. It presumably follows that infringement can occur when different process steps are carried out in different Contracting Member States, but that there will be no infringement under this limb of art.25(b) UPCA where some steps are carried out outside the territory of the Contracting Member States.<sup>12</sup>

### *Offer the Process for Use*

**10-23** Infringement typically occurs in this situation where a party markets its ability to carry out the process for others. In order to amount to infringement, the process being so offered must include all of the steps in the claims of the patent in question.

**10-24** However, to infringe under this head there is also a knowledge requirement, which can be satisfied in two ways. Either the alleged infringer must be shown to have known that the process infringes the patent in question, or alternatively, that it “should have known” that this was the case.<sup>13</sup> This would appear to require either: (i) actual knowledge that the offered use would involve applying the inventive concept and that the inventive concept is protected by the patent in suit; or (ii) demonstrating there are other circumstances which would have led a reasonable third party to be aware that the process infringed the patent. It is expected that drawing the patent to the attention of the alleged infringer in relation to the process will provide a strong basis for arguing it had actual knowledge of infringement.

**10-25** In addition, the offer, which must be made within the territory of the Contracting Member States, must be for use of the process within the territory of the Contracting Member States in which the patent has effect.<sup>14</sup> This requirement means that the scope of protection is narrower than that of the equivalent provision relating to offers of products in art.25(a) UPCA, which only requires the offer to be made in the Contracting Member States, but does not require the supply which would result from the offer to take place in the Contracting Member States. The difference in requirements between offers of products and processes is the result of a diplomatic compromise reached during the Luxembourg Conference of 1975 between those member states who advocated the same protection and the same conditions as for the offer of a product (Germany, Belgium and France) and those who did not want the offer of a patented process to be prohibited at all (notably the United Kingdom and The Netherlands).<sup>15</sup> Again, the extent of the Court’s jurisdiction means that use of the process does not have to be limited to a particular Contracting Member State. Thus, the Court’s jurisdiction gives the owner of a process patent far more opportunity to assert infringement of a patent than is the case under the national patent systems.

## **Art.25(c) UPCA – Products Obtained Directly by a Patented Process**

**10-26** Art.25(c) UPCA covers the product of a patented process. Under art.25(c) UPCA, it is an infringement to offer, place on the market, use, or import or store for those purposes a product that is obtained directly by a process which is the subject matter of the patent. The language of art.25(c) UPCA derives from art.29(c) CPC, but also has basis in art.64(2) EPC, which requires the protection conferred by a European patent for a process to extend to products directly obtained by such process. This type of direct infringement is generally invoked in situations where a patent only claims a process, the process is carried out outside the jurisdiction of the relevant court, and products arising from the process are then imported into the relevant

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<sup>12</sup> Although a Claimant may be able to rely on indirect infringement under art.26(1) UPCA, see paragraphs [10-28](#) to [10-43](#).

<sup>13</sup> art.29(b) CPC differs slightly here as it uses the term “obvious in the circumstances” rather than “should have known”. It is not clear whether the use of “should have known” in art.25(b) UPCA is intended to reflect a difference in substance from art.29(b) CPC. Art.26(1) UPCA also contains an equivalent difference from art.30(1) CPC in the context of the knowledge requirement for indirect infringement.

<sup>14</sup> Belgian Constitutional Court, 28 September 2017, decision no. 105/2017, docket no. 6363, *P21 Ltd. v Europlasma*.

<sup>15</sup> “Records of the Luxembourg Conference on the Community patent 1975” (Luxembourg, Office for Official Publications of the European Communities, 1982), p.234 referred to in *P21 Ltd. v Europlasma* (see previous footnote).

jurisdiction. It is worth noting however that art.55(1) UPCA may assist claimants where the process is for obtaining a new product, as it creates a presumption that an identical product in the hands of an infringer was obtained by the patented process.<sup>16</sup>

**10-27** The question of whether a product is the direct (as opposed to indirect) product of a process has been the subject of some dispute in a number of national courts. The word “directly” in art.25(c) UPCA has its origin in German law where the equivalent word “unmittelbar” had been in s.6(2) German Patent Act since 1891. The meaning of this term has been considered on numerous occasions by the German courts, which have decided that a product obtained “directly” from a process is the product with which the process ends. The German courts have further concluded that such a product does not cease to be a product obtained directly from the process if it is subject to further processing, so long as such processing does not cause it to lose its identity, and that a loss of identity does not occur where the product retains its “essential characteristics”.<sup>17</sup> The UK Court of Appeal has also adopted this “loss of identity” test, and commented (after reviewing authorities from the Netherlands, Switzerland, Denmark and Austria) that it appears to represent the test generally adopted under European law.<sup>18</sup> Whether further processing results in a loss of identity will of course depend on the particular circumstances of the case.

## Indirect Infringement under art.26 UPCA

**10-28** Art.26(1) UPCA allows a proprietor to prevent the indirect use of a patented invention. Typical scenarios where indirect infringement arises include situations where parts of a device are offered for sale or are supplied which can be combined with other parts of the device which together make up the patented product. Further, indirect infringement may occur if a device which can be used to carry out a patented method is offered for sale or is supplied.

**10-29** The wording of art.26(1) UPCA derives from art.30(1) CPC. Although the CPC has never come into force, many European countries have included provisions in their national patent laws that are identical or at least similar to art.30 CPC. Typical examples are the corresponding legal provisions in Germany, the UK, the Netherlands and France: in Germany, a provision for indirect infringement was introduced in s.10 German Patent Act in 1981; in the UK, indirect infringement was incorporated in s.60(2) Patents Act 1977; in France, art.L613-4(1) French Intellectual Property Code from 1992 sets out the requirements for indirect infringement; and in the Netherlands, art.73 Dutch Patent Act 1995 refers to indirect infringement.

**10-30** The main elements required to establish indirect infringement under art.26(1) UPCA are that the defendant has:

- Supplied or offered to supply (within the Contracting Member States in which the patent has effect) any person other than a party entitled to exploit the patented invention;
- Means relating to an essential element of the invention for putting the invention into effect within the Contracting Member States in which the patent has effect;
- Where the defendant knew (or should have known) that the means were suitable and intended for putting the invention into effect.

### *Supply or Offer to Supply*

**10-31** The reference to supply or offering to supply in art.26(1) UPCA differs from the equivalent language in art.25(a) to (c) UPCA, which variously refer to “offering” and “placing on the market”.

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<sup>16</sup> See chapter 17 (Evidence) paragraph 17-09.

<sup>17</sup> *Ossal*, (1909) 42 RGZ 357 at 358 (Reichsgericht), *Bindermittel* (174), (1916) PMZ 135 (Supreme Court) and *Unmittelbares Verfahrenerzeugnis* (2U148/76), [1979] GRUR 743 (Düsseldorf Oberlandesgericht, 15 September 1977).

<sup>18</sup> *Pioneer Electronics Capital Inc. v Warner Music Manufacturing Europe GmbH* [1997] RPC 757.

It is not clear to what extent (if any) this difference in language represents in scope between the acts covered by art.25(a) to (c) and art.26(1) UPCA. However, in the end it is unlikely that the Court will wish to take this type of fine distinction in language into account.

### *Any Person Other Than a Party Entitled to Exploit the Patented Invention*

**10-32** Art.26(3) UPCA clarifies that a person with a defence to infringement under art.27(a) to (e) should not be considered a “party entitled to exploit the patented invention” for the purposes of art.26(1) UPCA. This provision is intended to prevent the situation where a defendant could avoid indirect infringing under art.26(1) UPCA by arguing that it had supplied or offered the means to a third party who had a defence to infringement, e.g. because that third party had a licence under the patent.

### *Means Relating to an Essential Element*

**10-33** National courts have taken divergent views as to the test for establishing whether means relate to an essential element of an invention. The issue here is that the means have to be essential to the invention which is the subject of the patent as opposed to means essential to any of the claims of the patent. This gives rise to the possibility of alternative interpretations of what is meant by the invention. German and UK courts have adopted a test whereby the means must contribute to implementing the technical teaching of the invention, but do not require that the relevant feature serves to distinguish the subject matter of the claim from the prior art i.e. the feature need not be novel in its own right.<sup>19</sup> This differs from the approach taken by the Dutch Supreme Court, which has held that the means must relate to the element of the patent which distinguishes it from the state of the art.<sup>20</sup> When considering the German and Dutch approaches, the UK court considered the German approach to be more closely aligned with the apparent purpose of art.30(1) CPC, and also consistent with decisions taken by the French and Belgian courts.<sup>21</sup>

**10-34** The term “means” covers physical and non-physical items. For example, a “means” can be a physical product such as liquid or gaseous product,<sup>22</sup> or a non-physical product such as a piece of software.<sup>23</sup> This broad interpretation seems logical since there are numerous inventions in which individual features of the claim can be non-physical, such as a means for controlling a device, or a process implemented as software.

### *Knowledge*

**10-35** Art.26(1) UPCA requires that the defendant knew, or should have known, that the means were suitable and intended for putting the invention into effect. Thus art.26(1) UPCA provides two possible ways in which a claimant can show that the defendant satisfied the knowledge requirement either by demonstrating that (i) the defendant had actual knowledge; or (ii) that the defendant should have known. The equivalent language in the CPC referred to the second type of knowledge being attributable to the defendant where it was “obvious in the circumstances”. It is not clear whether the use of “should have known” in the place of “obvious in the circumstances” in the UPCA is intended to reflect a substantive difference between the two provisions, although the former will clearly be a consequence of the latter.

<sup>19</sup> *Flügelradzähler (Impeller Flow Meter)* (X ZR 48/03), 4 May 2004, Bundesgerichtshof; *Pipetten System (Pipette System)* (X ZR 38/06), 27 June 2007, Bundesgerichtshof and *Nestec S.A. v Dualit Ltd* [2013] EWHC 923, at [168] to [176].

<sup>20</sup> *Sara Lee v Integro* (C02/227HR), Dutch Supreme Court.

<sup>21</sup> *Nestec S.A. v Dualit Ltd* [2013] EWHC 923, at [174] to [175].

<sup>22</sup> See for example *Luftheizgerät*, GRUR 2001, 228, 231, German Federal Supreme Court.

<sup>23</sup> See for example *Fräsverfahren*, GRUR 2013, 713, German Federal Supreme Court and *Menashe Business Mercantile Ltd v William Hill Organisation Ltd* [2002] EWCA Civ 1702, albeit in *Menashe* the software was supplied to users by the defendant on an optical disk.

- 10-36** The required knowledge is likely to be inferred where the defendant has provided specific instructions on how to use the means, for example in manuals or insertions, in a manner which would directly infringe the patent.<sup>24</sup> The situation will be more complex however when the defendant supplies instructions which refer to some other (non-infringing) way to use the means, as the Court will need to consider whether the defendant could still have the requisite knowledge notwithstanding the content of the instructions.<sup>25</sup>
- 10-37** Note the difference in wording between what the knowledge has to be under art.26(1) UPCA compared with that for infringement by offering a process under art.25(b) UPCA. Here there does not need to be any knowledge as regards the patent and the knowledge only needs to be as regards the invention covered by the patent. Thus to establish that the defendant has the requisite knowledge, it is not necessary for the claimant to show that the defendant knew about the existence of the patent in question by, for example, having drawn it to their attention.
- 10-38** A number of questions have also been raised by national courts when considering the subject of knowledge, regarding whether the means were “suitable and intended for putting that invention into effect”.
- 10-39** Firstly, national courts have been asked to decide who must or ought to have the relevant knowledge that there is an intention to put the invention into effect, i.e. does it need to be the defendant who intends that the means will be used to put the invention into effect, or is it sufficient for the defendant to know that the direct customer and/or the ultimate user intends to put the invention into effect? The approach taken to this issue in various European jurisdictions was surveyed by the UK Court of Appeal in *Grimme v Scott*.<sup>26</sup> The Court of Appeal concluded that the required intention was to put the invention into effect and that the question was what the defendant knew or ought to have known about the intention of the person who was in a position to put the invention into effect—the person at the end of the supply chain. The Court of Appeal found support for this approach in a number of leading German authorities.<sup>27</sup>
- 10-40** Further, national courts have also been asked to consider: (i) when the intention of putting the invention into effect must be formed, i.e. must it be a settled intention at the time of the supply (or offer) of the means, or can it be an intention formed later; and (ii) whether the intention needs to be held by a specific third party, or whether it is sufficient that there is a possibility that at least some end users could intend to put the invention into effect? In answer to these questions the UK court has identified the following principles, which it believes to be consistent with the leading German decisions and also reflects the position adopted in French, Italian and Spanish law:<sup>28</sup>
- It is enough if the supplier knows (or it is obvious to a reasonable person in the circumstances) that some ultimate users will intend to use or adapt the “means” so as to infringe;
  - There is no requirement that the intention of the individual ultimate user must be known to the defendant at the moment of the alleged infringement; and
  - Whilst it is the intention of the ultimate user which matters, a future intention of a future ultimate user is enough if that is what one would expect in all the circumstances.

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<sup>24</sup> See for example *Antriebsscheibenaufzug*, GRUR 2005, 848, 851, BGH.

<sup>25</sup> See for example the discussion in *Actavis v Eli Lilly & Company* [2016] EWHC 234 (Pat).

<sup>26</sup> *Grimme Landmaschinenfabrik GmbH & Co KG v Scott* [2010] EWCA Civ 1110.

<sup>27</sup> *Deckenheizung* [BGH X ZR 153/03], 13 June 2006; *Haubenstretchautomat* [BGH X ZR 173/02], 9 January 2007; and *Pipettensystem* [BGH X ZR 38/06], 27 February 2007.

<sup>28</sup> *Actavis v Eli Lilly & Company* [2016] EWHC 234 (Pat) at [27] to [32].

## *Territorial Limitations*

**10-41** Art.26(1) UPCA contains two territorial requirements. The first requirement is that the supply or offer to supply must be within the territory of the Contracting Member States in which the patent has effect. The second requirement is that the means supplied or offered are suitable and intended for putting the invention into effect in the territory of the Contracting Member States in which the patent has effect. The second territorial requirement arises from the use of the term “putting into effect therein”.<sup>29</sup> Compared to the national laws where the supply or offer of supply and the intended use must generally take place in the respective national territory, art.26 UPCA provides for a broader territorial scope of application since the territory covers all Contracting Member States where the patent has effect – a much wider geographical area. Therefore, under the UPCA, the supply or offer of supply may occur in one Contracting Member State and the intended use in another Contracting Member State. This will allow claimants to catch a wider range of indirect infringements and may provide a motivation to obtain Unitary patents or keep European patents opted into the jurisdiction of the Court or, indeed, to withdraw an opt-out over a European patent for the purposes of enforcement.

## *Staple Commercial Products*

**10-42** Art.26(2) UPCA contains a limitation such that it will not be considered indirect infringement under art.26(1) UPCA to supply or offer means which are staple commercial products. In general terms “staple commercial products” are stocked products in daily use like nails, screws and standard electrical components which are universally applicable. However, the term is not defined in the UPCA and whether means constitute “staple commercial products” will need to be decided by the Court on a case by case basis, taking into account the circumstances in the relevant field of commerce.

**10-43** The exception in art.26(2) UPCA does not apply where the defendant induces the person supplied to perform acts of direct infringement under art.25 UPCA. The exception only refers to the “person supplied” and requires that person to be induced to perform acts under art.25 UPCA. On its face, this language appears to exclude the situation where the defendant offers to supply a staple commercial product and encourages the person to which the offer is made to put the invention into effect, although this is not entirely clear and may require further clarification by the Court should the situation arise.

# Defences to Actions under arts 25 and 26 UPCA

## *Limitations of the Effects of a Patent under art.27 UPCA*

**10-44** Art.27 UPCA provides a number of defences to infringement by identifying certain acts to which the rights conferred by arts 25 and 26 UPCA do not extend. Many of these defences derive from art.31 CPC and will therefore be familiar to practitioners in those European countries which have adopted the CPC as part of their national law. The exceptions to infringement provided by art.27 UPCA will need to be interpreted by the Court in a manner which is consistent with art.30 TRIPS Agreement,<sup>30</sup> which provides:

“Members may provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.”

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<sup>29</sup> See the explanation by Aldous LJ in *Menashe Business Mercantile Ltd v William Hill Organisation Ltd* [2002] EWCA Civ 1702 at [25], in the context of art.30(1) CPC from which the language of art.26(1) UPCA is derived.

<sup>30</sup> art.24(1)(d) UPCA.

### *Art.27(a) UPCA - Non-commercial Use*

**10-45** The rights provided under arts 25 to 26 UPCA are not infringed by acts which are done privately and for non-commercial purposes. However, if done for a dual purpose, one of which was commercial, this exemption does not apply.<sup>31</sup> Supplying a product or process to an end user may also constitute infringement (either direct or indirect), notwithstanding that the end user is able to benefit from the defence under art.27(a) UPCA.

### *Art.27(b) UPCA - Experimental Use*

**10-46** Art.27(b) UPCA exempts from infringement acts which are done for experimental purposes relating to the subject matter of the patented invention. To benefit from this exemption the acts must therefore: (i) be experimental in nature; and (ii) relate to the subject matter of the patented invention. When applying the national equivalent of art.27(b) UPCA, a number of national courts have been asked to consider whether acts were done for an experimental purpose or for some other purpose. The UK Court of Appeal has suggested that acts done in order to demonstrate to a third party that a product works, or to collect information to submit to a third party (e.g. regulatory bodies) that the product works as intended, would not be done for “experimental purposes”.<sup>32</sup> The Court of Appeal concluded however that acts would not be automatically disqualified as being for experimental purposes if they had an ultimately commercial aim. The German Federal Supreme Court has also reached a similar conclusion, holding that acts can be for an experimental purpose even if:

“they are at the same time undertaken with the additional, or even overwhelming, motivation of using the results of the tests to prepare for commercial exploitation.”<sup>33</sup>

National courts have disagreed in the past as to whether the experimental use exception should apply to clinical trials conducted in order to gain regulatory approval for a medicinal product. This should not however be an issue which the Court is called upon to decide as art.27(d) UPCA provides a separate defence in relation to conducting the tests necessary for seeking a marketing authorisation, the so called “Bolar” exemption.<sup>34</sup>

**10-47** Art.27(b) UPCA also only applies where the experimental use relates to “the subject matter of the patented invention”. National courts have found the CPC equivalent of this requirement<sup>35</sup> to have a limiting effect on the defence.<sup>36</sup> For example, using a patented product as part of the equipment for an experiment will not fall within the exemption if the experiment is aimed at investigating something other than the “subject matter of the patented invention”.

### *Art.27(c) UPCA - Breeding and Plant Varieties*

**10-48** Art.27(c) UPCA provides that the rights conferred by arts 25 to 26 UPCA are not infringed by a third party's use of biological material for the purposes of: (i) breeding animals or plants; (ii) discovering plant varieties; or (iii) developing other plant varieties. This exception was not provided in the CPC and will be new to practitioners in a number of Contracting Member States. There are also further exemptions relating to use of an invention for agricultural purposes in art.27(i) and (j) UPCA.<sup>37</sup>

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<sup>31</sup> See for example *Smith, Kline & French v Evans Medical* [1989] 1 FSR 513.

<sup>32</sup> *Monsanto Co v Stauffer Chemical Co* [1985] RPC 515, at p.542.

<sup>33</sup> *Klinische Versuche II* Case X ZR 68/94, German Federal Supreme Court, aka Clinical Trials II.

<sup>34</sup> See paragraphs [10-49](#) to [10-52](#).

<sup>35</sup> art.31(b) CPC.

<sup>36</sup> *Smith Kline & French Laboratories Ltd v Evans Medical Ltd* [1989] FSR 513 and *Klinische Versuche I* (X ZR 99/92), German Federal Patent Court.

<sup>37</sup> See paragraphs [10-57](#) to [10-60](#).

### *Art.27(d) UPCA - Tests and Studies for Marketing Authorisation Applications for Medicinal Products*

- 10-49** Art.27(d) UPCA incorporates the limitations provided by art.13(6) Directive 2001/82/EC on the Community code relating to veterinary medicinal products<sup>38</sup> and art.10(6) Directive 2001/83/EC on the Community code relating to medicinal products for human use.<sup>39</sup>
- 10-50** These Directives require Member States to make provision in their national law such that conducting the necessary studies and trials (and the consequential practical requirements) to demonstrate that a medicinal product is a generic of a reference medicinal product, or a biological medicinal product is similar to a reference biological product<sup>40</sup> is not considered to infringe patent rights or SPCs for medicinal products. This is often referred to as the “Bolar” exemption following the name of the similar legislative provision in the US.
- 10-51** The purpose of these limitations is to allow parties who wish to market generic or biosimilar versions of patented medicinal products to conduct the necessary tests and studies in order to obtain regulatory approval so as to be able to put the product on the market as soon as the relevant patent or SPC expires. The limitation only extends to trials carried out for the purposes of obtaining marketing authorisation in the EU and does not extend to trials for obtaining regulatory approval elsewhere.
- 10-52** Art.27(d) UPCA only provides a defence to infringement in relation to patent rights covering the reference medicinal product, and not a more general defence covering any patent rights which could be infringed in the course of a medical trial. The exemption is also specifically limited to clinical trials for generics and biosimilars. It does not provide a broader exemption (such as has been implemented in Germany, France and Italy) for trials relating to innovative medicinal products where the patentee has not already obtained regulatory approval in the EU. However, particularly in the case of biosimilars, such clinical trials may fall within the experimental use exemption in art.27(b) UPCA.

### *Art.27(e) UPCA - Preparation of a Medicine by a Pharmacy*

- 10-53** Art.27(e) UPCA is derived from art.31(b) CPC and provides an exemption from patent infringement for the preparation of medicaments by pharmacies when dispensing to individuals in response to a prescription. This is a limited exemption that protects dispensing pharmacists from infringing a patent when they put together a specific prescription for a patient, where in combining a set of ingredients they might otherwise infringe a patent. It is unlikely to be relevant to modern pharmacy practice where the vast majority of products are provided in pre-packaged form to pharmacists.

### *Art.27(f) to (h) UPCA - Vessels, Aircraft and Land Vehicles from Outside Contracting Member States in which the Patent has Effect*

- 10-54** Art.27(f) and (g) UPCA provide exemptions for the use of patented inventions in vessels, aircraft, land vehicles or other means of transport of countries, other than those Contracting Member States in which the patent has effect, of the International Union for the Protection of Industrial Property (Paris Union) or members of the World Trade Organisation, when these temporarily or accidentally enter the waters or territories of a Contracting Member State in which the patent does have effect. More specifically, art.27(f) UPCA exempts such use of patented inventions on board vessels and in the body, machinery, tackle, gear, and other accessories of the vessel,

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<sup>38</sup> Directive 2001/82/EC of the European Parliament and of the Council of 6 November 2001 on the Community code relating to veterinary medicinal products (OJ No. L 311, 28.11.2001, p. 1).

<sup>39</sup> Directive 2001/83/EC of the European Parliament and of the Council of 6 November 2001 on the Community code relating to medicinal products for human use (OJ No. L 311, 28.11.2001, p. 67).

<sup>40</sup> As specified in art.13(1) to (5) of Directive 2001/82/EC and art.10(1) to (6) of Directive 2001/83/EC.

provided that the invention is used exclusively for the needs of the vessel. Art.27(g) UPCA exempts such use of patented inventions in the construction or operation of or in accessories for aircraft, land vehicles, or other means of transport. The exceptions only apply where the entry into the waters or territories of the Contracting Member States in which the patent has effect is temporary or accidental. These terms are not defined in the UPCA but originate in art.5ter Paris Convention for the Protection of Industrial Property. When considering the national equivalent to art.27(f) UPCA, the UK Court of Appeal concluded that “temporary” should be construed as “transient” or “for a limited period of time” and could not depend on something as indefinite and imprecise as the frequency of entry.<sup>41</sup>

- 10-55** There is a similar limitation in art.27(h) UPCA in relation to aircraft, which refers to a limitation agreed in the Convention on International Civil Aviation of 7 December 1944.<sup>42</sup> Contracting states to this Convention have agreed, and this is now reflected in art.27(h) UPCA, not to seize, detain, make any direct claims against, or otherwise interfere with, the owner or operator of aircraft from other contracting states entering its territory or that transit across its territory, with or without landings, based on the construction, mechanism, parts, accessories or operation of the aircraft infringing any patent of the contracting state. This also applies to the storage of spare parts and spare equipment for the aircraft and the right to use and install the same in the repair of the aircraft. Note that this limitation does not cover sales or distribution of such patented parts or equipment within the contracting state entered by the aircraft or commercial exports from the contracting state.
- 10-56** The effect of art.27(h) UPCA is that patent infringement claims founded on the acts set out in art.27 of the Chicago Convention can only be brought in relation to aircraft which are registered in one of the Contracting Member States in which the patent has effect, i.e. aircraft registered in other jurisdictions will benefit from a full defence to infringement.

### *Art.27(i) to (j) UPCA - Farmers' Rights*

- 10-57** Art.27(i) to (j) UPCA protect farmers' ability to reuse their harvested seed for sowing (art.27(ii)) and to breed livestock (art.27(j)) as part of their overall agricultural activities.
- 10-58** Art.27(i) UPCA allows a farmer to use the product of his harvest (i.e. harvested seeds) for propagation or multiplication on the farmer's own farm, provided the crop in question was originally grown from seed sold to the farmer by, or with the consent of, the patent proprietor for agricultural use. The exception provided by art.27(i) UPCA has its origins in art.11(1) Directive 98/44/EC on the legal protection of biotechnological inventions (the “Biotech Directive”).<sup>43</sup>
- 10-59** The extent and conditions for use under art.27(i) UPCA are specified as corresponding to art.14 Regulation (EC) No 2100/94 on Community plant variety rights, which limits the right to certain plant species and excludes hybrid and synthetic seed varieties.<sup>44</sup> Art.27(i) UPCA is therefore limited to those plant varieties listed in art.14(2) Regulation (EC) No 2100/94 and, in order to benefit from the exception to infringement, farmers<sup>45</sup> are required to pay an equitable remuneration to the right holder under art.14(3) Regulation (EC) No 2100/94.
- 10-60** Art.27(j) UPCA derives from art.11(2) Biotech Directive and allows a farmer to use protected livestock for an agricultural purpose, provided that the original breeding stock or other reproductive material was supplied to the farmer by or with the consent of the patent

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<sup>41</sup> *Stena Rederi AB v Irish Ferries Ltd* [2003] EWCA Civ 66.

<sup>42</sup> International Civil Aviation Organization (ICAO), 'Chicago Convention', Document 7300/9 (9<sup>th</sup> edition, 2006).

<sup>43</sup> Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions (OJ No. L 213, 30.7.1998, p.13 to 21).

<sup>44</sup> Council Regulation (EC) No 2100/94 of 27 July 1994 on Community plant variety rights (OJ No. L 227, 1.9.1994, p.1).

<sup>45</sup> Other than “small farmers” as defined in art.14(3) Regulation (EC) No 2100/94.

proprietor and provided that he does so for his own agricultural purposes and does not supply the breeding stock or reproductive material commercially to others.

### *Art.27(k) UPCA - Decompilation and Interoperability of Computer Programs*

**10-61** Art.27(k) UPCA provides that the rights conferred by a patent shall not extend to:

“the acts and the use of the obtained information as allowed under Articles 5 and 6 of the Directive 2009/24/EC, in particular by its provisions on decompilation and interoperability.”

**10-62** Art.5 Directive 2009/24/EC (the “Software Directive”)<sup>46</sup> provides three exceptions to the acts which are said to be the exclusive right of the holder of copyright in a computer programme under art.4 of the Software Directive. Art.27(k) UPCA does not make it clear whether all three exceptions provide the basis for some form of defence to patent infringement, or just some of them. The reference to arts 5 and 6 of the Software Directive is qualified by “in particular by its provisions on decompilation and interoperability”. As neither acts under art.5(1) or art.5(2) relate to decompilation or interoperability,<sup>47</sup> it is not clear whether these acts are intended to form the basis of a defence to patent infringement under art.27(k) UPCA.

**10-63** Art.5(3) of the Software Directive provides that:

“The person having a right to use a copy of a computer program shall be entitled, without the authorisation of the rightholder, to observe, study or test the functioning of the program in order to determine the ideas and principles which underlie any element of the program if he does so while performing any of the acts of loading, displaying, running, transmitting or storing the program which he is entitled to do.”

**10-64** This exception to copyright infringement under art.5(3) is not expressly described in the Software Directive as relating to “decompilation or interoperability”, but comes closer to these concepts than arts 5(1) and 5(2). The acts identified in art.5(3) must therefore be included within the scope of art.27(k) UPCA, if its reference to art.5 of the Software Directive is to have any effect. However, exactly how the exception under art.5(3) should be applied as a defence to patent infringement is unclear. For example, the exception in art.5(3) applies to a “person having a right to use a copy of a computer program”. It is not clear why such a person would be in need of a defence to patent infringement resulting from the use of that software, as their use of the invention would already be with the proprietor’s consent.

**10-65** Art.6 of the Software Directive provides that reproduction of the code and translation of its form shall not constitute an infringement of copyright where those acts are “indispensable to obtain the information necessary to achieve the interoperability of an independently created computer”. This exception is made subject to a number of restrictions, set out in art.6(1)(a) to (b) and art.6(2)(a) to (c). In the context of copyright protection, the intention behind this exception is to prevent the copyright owner’s monopoly from allowing them to prevent others making software which is interoperable with their own. However the rationale for extending this exception into the domain of patent law is, again, unclear. It is also unclear how the exception should be applied in a patent infringement context. For example, one of the conditions on the application of the exception in the copyright context is that the:

“acts are performed by a licensee or by another person having a right to use a copy of the program, or on their behalf by a person authorised to do so”.<sup>48</sup>

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<sup>46</sup> Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs (OJ No. L 111, 5.5.2009, p.16).

<sup>47</sup> art.5(1) relates to acts necessary for the use of a computer program for its intended purpose. Art.5(2) relates to the making of a back-up copy of a program.

<sup>48</sup> Art.6(1)(a) Software Directive.

It is not clear why such a person might need a defence to patent infringement, at least to the extent that any such infringement arose from the use of software.

### *Art.27(l) UPCA - Acts Permitted by the Biotech Directive*

**10-66** Art.27(l) UPCA provides a defence to a claim of infringement based on the acts permitted by art.10 Biotech Directive. Despite some difference in wording, these acts are in substance those already provided for by art.27(i) and (j) UPCA,<sup>49</sup> and it is not clear what (if anything) art.27(l) UPCA adds over and above those provisions.

### **Prior Use Exception under art.28 UPCA**

**10-67** Art.28 UPCA provides an exception to patent infringement based on personal prior use, or a right of personal possession, of the invention.

**10-68** While countries in the EU and the rest of the EPC contracting states have opted for a “first-to-file” patent system, this may entail some drawbacks where the invention to be covered by a patent is already being used or held by a third party before the filing of that patent. In order to avoid such unfair consequences, many countries have exemptions from patent infringement in circumstances where someone has been doing something, or possesses something, that falls within the scope of a patent, before the priority date of the patent but which, for whatever reason, has not become public and therefore does not invalidate the patent. This then gives some limited protection to such a private prior user or owner who themselves did not file for a patent.

**10-69** It is clear that this exemption only applies in the Contracting Member State where the prior use has occurred or where the personal possession occurs. Thus, this exemption may well be limited to a single country. The wording of art.28 UPCA also makes it clear that the circumstances in which the right of prior use or possession will exist depend on the national laws of the Contracting Member State in which the right is claimed.<sup>50</sup> This clearly allows the possibility of the same fact pattern giving rise to different results in different Contracting Member States.<sup>51</sup>

**10-70** The prior use exemption is, of course, an exception to the rights of a patent holder and therefore the onus of proof of prior use falls on the party seeking to rely on the exemption. Thus, in order to rely on this exemption, the prior user will need to produce evidence demonstrating the prior use. The party seeking to rely on the exemption will also need to be able to demonstrate prior use or possession of the invention prior to the date of the patent in question, or its priority date, if earlier.

### **Exhaustion of Rights under art.29 UPCA**

**10-71** The principle of the exhaustion of patent rights, as has been developed under EU competition law, is applicable to patents within the jurisdiction of the Court. The principle is expressed in art.29 UPCA for European patents which are subject to the Court’s jurisdiction and in art.6 Unitary Patent Regulation for Unitary patents. Once a patented article has been placed on the EU market, with the consent of the proprietor of the patent, that proprietor may no longer assert its rights under the patent against that product. There is an exception to this where the proprietor has legitimate grounds for objecting to the further commercialisation of the product. The Court will however need to develop its own jurisprudence on this aspect of the exception as

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<sup>49</sup> See paragraphs 10-57 to 10-60.

<sup>50</sup> The FAQ on the Court’s website specifically notes that prior user rights will, pursuant to art.28. UPCA, be governed by national law, see <https://www.unified-patent-court.org/faq/sources-law-and-substantive-patent-law-0> [Accessed 14 April 2023].

<sup>51</sup> r.24 RoP requires that the SoD for an infringement action should contain “any argument arising from the provisions of Article 28 of the Agreement”.

currently, no directly applicable case law exists in the CJEU in the context of patents.<sup>52</sup> The CJEU has previously rejected attempts<sup>53</sup> to establish that particular factual circumstances give rise to an exception to the exhaustion principle it established in *Centrafarm v Sterling*.<sup>54</sup>

### *A Product Placed on the Market in the EU*

- 10-72** Art.29 UPCA refers rights conferred by a European patent not extending to a product that has been placed on the market in the “European Union”.
- 10-73** This gives rise to the following questions: does this exhaustion of rights occur where a product has been placed onto the market of one of the Contracting Member States and that product was imported from: (i) a Contracting Member State where there is no relevant patent protection; or (ii) one of the Member States which have not signed or ratified the UPCA?
- 10-74** With regard to the first situation (i), it is likely that the Court will rely on CJEU case law which considers that patent protection in the country of export where the product was already on the market is not required for patent exhaustion to occur in the country of importation.<sup>55</sup> As regards the second situation (ii), whether or not a country (e.g. Spain) is party to the UPCA is probably irrelevant with regard to application of art.29 UPCA, since art.29 only requires that the product be placed on the market in the EU with no reference to the UPCA.
- 10-75** A further question arises where the product is first put onto the market with the consent of the patent proprietor in an EEA country such as Norway. Art.29 UPCA only refers to putting products onto the EU market although art.8 EEA Agreement extends the application of the principle of exhaustion of patent rights to the EEA countries. A strict reading of art.29 UPCA would suggest that it does not apply to products put onto the market in an EEA country. However, a strict reading of art.29 UPCA would cut across the intention of art.8 EEA Agreement. Indeed, if this strict wording is adopted by the Court, this would result in an unusual consequence: patent exhaustion would have a narrower effect before the Court than before national courts dealing with national patents and European patents with no unitary effect. Therefore it seems unlikely that the Court will adopt this narrow reading of art.29 UPCA.

### *Requirement of Patent Holder’s Consent*

- 10-76** The CJEU has ruled that in order for patent exhaustion to take place, the patentee must have authorised, or at least implied its consent with regards to the supply of the relevant product onto the market in question. A clear example of the patentee giving consent is where the sale of the product is carried out by the patentee and/or by the patentee’s licensee.<sup>56</sup>
- 10-77** CJEU case law has identified various situations where the proprietor’s consent has not been given.<sup>57</sup> For example, when:
- The patentee is forced to grant compulsory licenses;<sup>58</sup> or

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<sup>52</sup> There are however a significant number of cases that have dealt with the issue of legitimate grounds for objecting to the further commercialisation of a product in the context of European trade mark law, but it is not clear if or how this case law could be directly applied in the context of patents. See *Bristol-Myers Squibb v Paranova*, (C-427/93, C-429/93 and C-436/93) [1996] ECR I-03457, [1997] 1 CMLR 1151, [1997] FSR 102 and *Zino Davidoff SA v A & G Imports Ltd* (C-414/99), *Levi Strauss & Co. & Anor v Tesco Stores Ltd & Anor* (C-415/99) and *Levi Strauss & Co. & Anor v Costco Wholesale UK Ltd* (C-416/99) [2001] ECR I-08691.

<sup>53</sup> See *Merck v Stephar* (C-187/80) [1981] E.C.R. 2063; [1981] 3 CMLR. 463 and *Merck v Primecrown* Cases C-267/95 and C-268/95 [1996] ECR I-06285.

<sup>54</sup> *Centrafarm v Sterling*, (C-15/74) [1974] ECR. 01147; [1974] 2 CMLR 480.

<sup>55</sup> *Merck & Co Inc v Stephar BV and Petrus Stephanus Exler* (C-187/80) [1981] ECR I-02063.

<sup>56</sup> *Centrafarm BV and Adriaan de Peijper v Sterling Drug* (C-15/74) [1974] ECR I-01147.

<sup>57</sup> The issue of consent has also been considered by the CJEU in the context of exhaustion of trade mark rights. See *Levi Strauss & Co. & Anor v Tesco Stores Ltd & Anor* (C-415/99) and *Van Doren + Q GmbH v Lifestyle Sports + Sportswear* (C-244/00) [2003] ECR I-3051.

<sup>58</sup> *Pharmon v Hoechst* (C-19/84) [1985] ECR 2281.

- A national law provides for sales to be enforced, obliging the patentee to keep supplying the product.<sup>59</sup>

## Competition Law Based Defences

- 10-78** In addition to the defences to infringement set out in arts 27 to 29 UPCA, defendants to infringement proceedings may attempt to raise arguments based on competition law in response to a claimant's case on infringement. Art.42(2) UPCA specifically states that the Court must ensure that the rules, procedures and remedies are used in a fair and equitable manner, and do not distort competition and indeed the first recital to the UPCA refers to cooperation between Member States of the European Union in the field of patents as contributing significantly to the creation of a system ensuring competition in the internal market is not distorted. Art.24(1)(a) UPCA also specifically identifies EU law as a source of law upon which the Court must base its decisions.
- 10-79** It is clear then that competition law under arts 101 and 102 TFEU have some role to play in the Court's decision making, although it should be noted that there is no express reference to competition law issues in the list of actions for which the Court has exclusive competence in art.32(1) UPCA, and art.32(2) UPCA states that national courts remain competent for actions relating to patents which do not come within the exclusive competence of the Court.
- 10-80** In practical terms the most likely way in which competition law issues will arise is an allegation by a defendant that asserting the patent against them is some form of abuse of a dominant position under art.102 TFEU.<sup>60</sup> Such an allegation is generally considered as an issue relating to the relief which should be granted by the court, rather than providing a defence to infringement per se. In particular, objections made by defendants under competition law in patent infringement proceedings generally relate to a request by the patentee for some form of injunctive relief, rather than any request for financial compensation.<sup>61</sup>
- 10-81** There may however be circumstances in which a defendant wishes to raise broader competition law issues and assertion of the patent only forms part of a wider set of actions which are said to be an abuse of a dominant position. The extent to which the Court will be willing to engage with broader competition law arguments remains to be seen.

## Infringement Prior to Grant

- 10-82** Art.32(1)(f) UPCA provides the Court with competence in relation to "actions for damages or compensation derived from the provisional protection conferred by a published European patent application". This provision reflects arts 67(1) and (2) EPC which provide that, from the date of its publication, a European patent application provisionally confers on the applicant at least the right to claim compensation reasonable in the circumstances from an unauthorised user of the invention. Beyond this minimum level of protection art.67(2) EPC leaves it open for EPC contracting states to decide for themselves any additional rights conferred by a European patent application and the circumstances in which those rights may be exercised. This is subject to a requirement that the protection which attaches to the publication of the European patent application may not be less than that which would result from publication of an unexamined national patent application.<sup>62</sup> The result of this discretion has been a diversity of different approaches to the protection conferred by a European patent application between EPC

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<sup>59</sup> *Merck & Co. Inc., Merck Sharp & Dohme Ltd and Merck Sharp & Dohme International Services BV v Primecrown Ltd, Ketan Himatlal Mehta, Bharat Himatlal Mehta and Necessity Supplies Ltd and Beecham Group Plc v Europharm of Worthing Ltd* (C-267/95 and C-268/95) [1996] ECR I-06285.

<sup>60</sup> The mere existence and assertions of a patent does not of itself give the patentee a dominant position or indeed amount to an abuse. See *Huawei Technologies Co Ltd v ZTE Corporation* (C-170/13) ECLI:EU:C:2015:477 at [46].

<sup>61</sup> See further chapter 15 (Remedies) paragraphs 15-13 to 15-17.

<sup>62</sup> Art.67(3) EPC does however allow EPC contracting states to impose certain translation requirements which may not necessarily apply to national patent applications.

Contracting States.<sup>63</sup> In the UK, for example, it is possible to obtain damages covering the period between publication of an application for a European patent and the grant of that patent, but proceedings to obtain such damages may only be started after the patent has been granted. This differs significantly from Italy where, in addition to damages, it is also possible to obtain orders for description and seizure of articles infringing the patent application and anything used in the making thereof based on the publication of the application alone, i.e. prior to the grant of the patent. The position in France is somewhere between, as French law allows the possibility of seizure of the articles infringing the patent application, but the court hearing the infringement action will stay proceedings until the patent is granted.

**10-83** Two important questions for those wishing to enforce the provisional protection conferred by a European patent application before the Court will be: (i) will the Court permit proceedings to be issued prior to the grant of a Unitary or European patent; and (ii) if yes, which types of proceedings and which categories of relief will be available?

**10-84** In relation to the first question, art.32(1)(g) UPCA provides that:

“the Court shall have exclusive competence in respect of ... actions relating to the use of the invention prior to the granting of the patent...”.

This appears to be a clear indication that the Court will have competence to hear actions based on the rights conferred by a published European patent application prior to its grant.

**10-85** In relation to the second question, the UPCA does not provide any specific guidance as to which types of action can be issued prior to the grant of a European patent application, or the categories of relief which the Court will be able to grant. One possible interpretation is that the general reference in art.32(1)(g) UPCA to “actions relating to the use of the invention prior to the granting of the patent” allows the Court to hear all possible actions relating to infringement of a European patent application which are otherwise provided by the UPCA in relation to granted patents. This would include applications for provisional measures, standard infringement actions and applications for an order to preserve evidence (saisie) or inspection issued prior to an infringement action.

**10-86** However, the Court may be hesitant to grant provisional measures (such as a provisional injunction) where a patent has not yet been granted and the full scope of protection conferred by the claims is not yet known. It may be less hesitant in granting such measures if the EPO has issued a notice of intention to grant the patent such that the scope of the granted claims is known and formal grant will occur imminently. The Court may also be more receptive to applications for orders to preserve evidence made prior to the grant of the patent and one option would be for the Court to grant such applications but then to stay any subsequent infringement proceedings until the patent has been granted, i.e. following an approach similar to that which is currently adopted in France.

**10-87** One other issue that the Court will need to address, should it be asked for relief in relation to a European patent application, is does it have jurisdiction over that patent application? As the opt-out provisions in art.83(3) UPCA refer to “a proprietor of or an applicant for a European patent” the answer is presumably yes, unless an opt-out has been filed and not withdrawn before the commencement of proceedings. However, it should be noted that following grant the patentee will need to choose whether to seek unitary effect for the patent or whether to maintain the patent as a European patent. If the decision is taken to maintain the patent as a European patent, having sought relief in relation to the application will preclude the proprietor from later opting the granted patent out of the jurisdiction of the Court.<sup>64</sup>

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<sup>63</sup> The approach taken by each EPC contracting state to provisional protection under art.67(2) EPC has been helpfully recorded on the EPO website, available at <http://www.epo.org/law-practice/legal-texts/html/natlaw/en/iiia/index.htm> [Accessed 14 April 2023]. The approach taken to translation requirements imposed under art.67(3) EPC has also been recorded on the EPO website, available at <http://www.epo.org/law-practice/legal-texts/html/natlaw/en/iiib/index.htm> [Accessed 14 April 2023].

<sup>64</sup> art.83(3) UPCA.

# Infringement Analysis

## Claim Construction and the Scope of Protection

**10-88** Art.69 EPC and the Protocol to art.69 EPC contain the rules of construction of the claims of a European patent and are incorporated into the laws applied by the Court by way of art.24(1)(c) UPCA. The Protocol to art.69 EPC states:

### “Article 1

#### General principles

Article 69 should not be interpreted as meaning that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving an ambiguity found in the claims. Nor should it be taken to mean that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patent proprietor has contemplated. On the contrary, it is to be interpreted as defining a position between these extremes which combines a fair protection for the patent proprietor with a reasonable degree of legal certainty for third parties.

### Article 2

#### Equivalents

For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.”

**10-89** Under the Protocol to Art.69 EPC the extent of protection conferred by a patent is determined by its claims but the wording of the claims must be read through the eyes of the skilled man in the art, by reference to the description and the figures. In some cases, the description may expressly define the meaning of a particular word or phrase used in the claim. The description and figures may also be used to resolve any ambiguity that might exist in the claims. The Protocol to art.69 EPC requires that claims should be interpreted in the context of the description and the figures and not as if they stand alone.

**10-90** Beyond the general framework provided by art.69 EPC and the Protocol, national courts have each developed their own detailed guidance on claim interpretation, often having historical roots in their own national practice prior to adoption of the EPC. Given the diversity of approaches presented by national law, this may be an area where the Court decides it is appropriate to start afresh and develop a body of substantive law on claim interpretation based solely on its own interpretation of art.69 EPC and the Protocol.

## Equivalence

**10-91** The current national laws of Contracting Member States all recognise that there is a penumbra of some sort around the literal reading of a patent claim to afford somewhat broader scope of protection than that which a strict reading of the words of the claim would provide. This follows from the Protocol to art.69 EPC and in particular art.2 of the Protocol which provides that:

“For the purpose of determining the extent of protection conferred by a European patent, due account shall be taken of any element which is equivalent to an element specified in the claims.”

**10-92** National courts have taken a variety of approaches to give effect to this provision and a key issue has been establishing the circumstances in which an element present in an alleged infringement can be considered “equivalent” to an element specified in the claims of a patent. The difficulty in defining such criteria is perhaps not surprising given the significant public policy

tension created by, on the one hand trying to provide a patentee with protection against competitors who make an immaterial variation to the patentee's invention and, on the other, providing certainty to third parties as to the boundaries of the patentee's legitimate monopoly.

- 10-93** National courts in Germany, France, Italy, Spain and the Netherlands all provide a degree of protection for infringement by way of an element which falls outside the meaning of a claim feature, but is considered by the national court to be "equivalent" to that feature, i.e. a "non-literal infringement". However, until very recently, courts in the UK had taken a different approach and provided protection for equivalents based solely on the court's approach to claim construction. In particular the UK courts would consider when construing the claim whether the skilled person in the art would, at the priority date, have understood the patentee to have intended for the claim element to extend to cover the alleged infringement. Most of the time these different approaches lead to the same outcome, but in certain specific circumstances there had been a real difference in application, leading to diverging infringement/non-infringement decisions in different jurisdictions.<sup>65</sup>
- 10-94** The UK court's sole focus on claim construction to protect equivalents was brought to an end by the decision of the UK Supreme Court in *Actavis v Eli Lilly*.<sup>66</sup> The UK Supreme Court held that an item which did not infringe a claim as a matter of normal interpretation may nonetheless infringe because it varies from the invention in a way which is immaterial, and the UK Supreme Court then provided guidance as to the circumstances in which a variation will be considered "immaterial". In reaching its decision the UK Supreme Court also summarised the approaches adopted by a number of other EPC contracting states.<sup>67</sup>
- 10-95** The Court will of course have to pick its own course in order to implement a uniform approach to infringement. Given that the differences between the UK and other EPC contracting states appear to have recently narrowed, it may be less of a challenge for the Court to identify common principles in existing national approaches than had previously been the case.
- 10-96** In determining whether there is infringement by way of equivalence, it has become traditional to formulate three questions. The UK Supreme Court has reformulated these questions for the UK and these now are:<sup>68</sup>
- Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e., the inventive concept revealed by the patent?
  - Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?
  - Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?
- 10-97** Meanwhile the questions that the German courts apply are:<sup>69</sup>
- Whether the variant solves the problem underlying the invention with modified but objectively equivalent means?

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<sup>65</sup> Perhaps the best known, are the *Epilady v Remington* cases in the 1990s. Courts in Austria, France and the UK held that the patent was not infringed whereas the courts in Belgium, Germany, Italy and the Netherlands held that infringement took place. See Mejer M and Pottelsberghe de la Potterie B "Economic Incongruities in the European Patent System", ECARES Université Liber de Bruxelles available at [https://ideas.repec.org/p/eca/wpaper/2009\\_003.html](https://ideas.repec.org/p/eca/wpaper/2009_003.html) [Accessed 14 April 2023].

<sup>66</sup> *Actavis UK Limited v Eli Lilly* [2017] UKSC 48.

<sup>67</sup> *Actavis UK Limited v Eli Lilly* [2017] UKSC 48 at [44] to [52].

<sup>68</sup> *Actavis UK Limited v Eli Lilly* [2017] UKSC 48 at [66].

<sup>69</sup> *Schneidmesser I*, Case No X ZR 168/00 at [30].

- Would it be recognised by the person skilled in the relevant art?
- Would that person focus[sing] on the essential meaning of the technical teaching protected in the patent regard the variant as being equivalent to the solution offered by the invention?

**10-98** There are similarities between these three questions but also some potentially significant differences and the Court is going to have to reconcile these at a fairly early stage.

## File Wrapper Estoppel

**10-99** An issue often closely related to protection of equivalents is the ability of a party to rely on statements made by the patentee during the patent's prosecution as evidence relating to the scope of protection of a claim, commonly known as "prosecution history estoppel" or "file wrapper estoppel". National courts have again taken a variety of different approaches to this issue. For example, the German Federal Patent Court (Bundesgerichtshof) has held that:

"it is permissible ... to use statements made by the applicant [and the examiner] during the grant procedure as an indication of how the person skilled in the art understands the subject matter of the patent"

but "such indications cannot be readily used as the sole basis for construction".<sup>70</sup> The Dutch Supreme Court has also held that:

"a court will only be justified in using clarifying information from the public part of the granting file, when it holds that even after the average person skilled in the art has considered the description and the drawings, it is still open to question how the contents of the claims must be interpreted".<sup>71</sup>

These approaches are often contrasted with the approach of French courts which are said to be more ready to refer to the prosecution history to settle issues of claim interpretation. Despite historical reluctance to consider the prosecution history, courts in the UK have recently moved closer to the German and Dutch approaches by discouraging, but not forbidding entirely, reference to the prosecution file when considering questions of claim interpretation.<sup>72</sup> In particular, the UK Supreme Court has recently outlined the two circumstances in which it believes it would be permissible to refer to the prosecution file:

"(i) the point at issue is truly unclear if one confines oneself to the specification and claims of the patent, and the contents of the file unambiguously resolve the point; or (ii) it would be contrary to the public interest for the contents of the file to be ignored."

**10-100** As with equivalents, it will again be interesting to see how the Court will address this issue when it first arises, especially given the recent move by the UK courts towards the German and Dutch approach.

<sup>70</sup> *Eli Lilly v Actavis Group PTC*, Case No X ZR 29/15.

<sup>71</sup> *Ciba-Geigy AG v Oté Optics BV* (1995) 28 IIC 748.

<sup>72</sup> *Actavis UK Limited v Eli Lilly* [2017] UKSC 48 at [87].



# Chapter 11

Overview of Procedure and  
General Procedural Provisions

# Introduction

- 11-01** The Court performs the functions assigned to it by the UPCA<sup>1</sup> and the UPCA Statute.<sup>2</sup> Details of the proceedings before the Court are laid down in the RoP which must comply with the UPCA.<sup>3</sup> The RoP attempt to bring together the best practice and procedure from the Contracting Member States; but whilst national systems can be examined to see how specific procedures are used, the Court will develop its own practice following the RoP.
- 11-02** A summary of the Court's procedure is included in this chapter and then the following chapters describe the written, interim and oral procedure.<sup>4</sup> This chapter also describes the principles which guide the Court and a number of general procedural provisions mostly found in part 5 RoP, namely: the language regime; service; the calculation of time periods and what happens if time periods are missed; and finally, when and how an action can be terminated without a hearing or when it might be stayed.

## General Principles

- 11-03** The UPCA contains a number of high-level principles concerning the duties of the Court. The Court must deal with litigation in ways which are proportionate, fair and equitable.<sup>5</sup> All procedures must be organised in a flexible and balanced manner.<sup>6</sup>
- 11-04** The RoP also guarantee these principles – they are repeated in the preamble to the RoP. The decisions of the Court must be of the highest quality and proceedings must be organised in the most efficient and cost effective manner. The RoP also aim to ensure a fair balance between the legitimate interests of all parties and provide for the required level of discretion of judges without impairing the predictability of proceedings for the parties.<sup>7</sup>

## Proportionality

- 11-05** The Court should deal with litigation in a way that is proportionate to its nature, importance and complexity.<sup>8</sup> The principle of proportionality stems from EU law and is given primacy in the UPCA. This general principle was developed through the case law of the CJEU<sup>9</sup> and has now been recognised in the TEU. Art.5(4) TEU states that under the principle of proportionality, the content and form of an EU action shall not exceed what is necessary to achieve the objectives of the TEU and the TFEU. Consequently, a court may not impose obligations except to the extent to which they are strictly necessary to attain the purpose of the measure. There must be a reasonable relationship between the end and the means.

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<sup>1</sup> art.6(2) UPCA.

<sup>2</sup> The UPCA Statute sets out the details of the organisation and functioning of the Court and is annexed to the UPCA. The UPCA states that the Statute shall guarantee that the functioning of the Court is organised in the most efficient and cost-effective manner and shall ensure equitable access to justice (art.40 UPCA).

<sup>3</sup> art.41(1) UPCA.

<sup>4</sup> chapters 12, 13 and 14 respectively.

<sup>5</sup> art.42 UPCA.

<sup>6</sup> art.52(1) UPCA.

<sup>7</sup> art.41(3) UPCA.

<sup>8</sup> art.42(1) UPCA. See also para.3 preamble to the RoP.

<sup>9</sup> *Fédération Charbonnière de Belgique v High Authority of the European Coal and Steel Community* (C-8/55) ECLI:EU:C:1956:7; *Internationale Handelsgesellschaft mbH v Einfuhr- und Vorratsstelle für Getreide und Futtermittel* (C-11/70) [1970] ECR I-1125; and *R v. Minister of Agriculture, Fisheries and Food and Secretary of State for Health, ex parte: Fedesa and others* (C-331/88) [1990] ECR I-4023.

**11-06** As regards the enforcement of intellectual property rights, the principle of proportionality is included in both the TRIPs Agreement and the Enforcement Directive.<sup>10</sup> The CJEU has considered the issue of proportionality in relation to the granting of injunctions in a number of cases. It has stated that injunctions must be effective, proportionate, dissuasive and must not create barriers to legitimate trade or be excessively costly. In relation to infringements on online marketplaces, for example, the CJEU stated that national courts could grant injunctions to prevent infringements of intellectual property rights and contrasted this remedy with the suggestion that there might be active monitoring of customers' data in order to prevent any future infringement of intellectual property rights via the provider's website. It considered the latter to be incompatible with the Enforcement Directive as not being fair and proportionate.<sup>11</sup>

## Fairness and Equity

**11-07** The Court must ensure that the rules, procedures and remedies provided for in the UPCA are used in a fair and equitable manner and do not distort competition.<sup>12</sup> The preamble to the RoP clarifies that fairness and equity shall be ensured by having regard to the legitimate interests of all parties.<sup>13</sup>

**11-08** This principle of fairness derives from the rule of law, and in simple terms means the law should apply equally to all. The principle of a fair trial (procedural fairness) is crucial in any legal system based on the rule of law. Procedural fairness includes several aspects: publicity, the right to be heard, and the right to have affairs handled impartially, fairly and within a reasonable time.

**11-09** At the EU level, the right to fair trial is recognised in art.6 European Convention on Human Rights<sup>14</sup> (ECHR) and art.47 Charter of Fundamental Rights in the EU.<sup>15</sup> According to art.6 ECHR, everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law. Judgment shall be pronounced publicly but the press and public may be excluded from all or part of the trial in the interests of morals, public order or national security in a democratic society. The EU respects the fundamental rights guaranteed in the ECHR, as stated in art.6(2) TEU.

## Public Access

**11-10** Public access is a vital component of procedural fairness; the UPCA provides that proceedings before the Court are open to the public<sup>16</sup> and the RoP reinforces this by stating that (1) decisions and orders made by the Court shall be published and (2) written pleadings and evidence lodged at the Court and recorded on the Registry shall be available to the public on a reasoned request, the decision to be taken by the judge-rapporteur after consulting the parties. That said, a party may request that certain information in written pleadings or evidence be kept confidential. To enable such requests, the RoP provide for a delay of 14 days before it is made available to the public. A party making such a request is obliged to provide a redacted version of the document the unredacted version of which is to be kept confidential. Even so, it is still open to a member of the public to make an application for an order that any information excluded from public access be made available to the applicant.<sup>17</sup> The final version of the RoP also now provide the parties with the means to protect their confidential information by making

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<sup>10</sup> art.3(2) Enforcement Directive. See chapter 15 (Remedies) particularly, paragraphs 15-07 to 15-12 in relation to the interpretation of this requirement in relation to permanent injunctions.

<sup>11</sup> *L'Oréal SA v eBay International AG* (C-324/09) [2011] ECR I-06011 at [139] and [144].

<sup>12</sup> art.42(2) UPCA.

<sup>13</sup> para.5 preamble to the RoP.

<sup>14</sup> Available at [www.echr.coe.int/Documents/Convention\\_ENG.pdf](http://www.echr.coe.int/Documents/Convention_ENG.pdf) [Accessed 13 April 2023].

<sup>15</sup> Charter of Fundamental Rights of the European Union (OJ No. C 202, 7.6.2016, p.389).

<sup>16</sup> art.45 UPCA.

<sup>17</sup> r.262 RoP.

an application to the Court for an order that access to their confidential information contained in written pleadings or evidence be restricted to specific persons.<sup>18</sup>

## Right to be Heard

**11-11** The right to be heard is a general principle of EU law recognised by the CJEU. The CJEU first recognised the principle in *Alvis*,<sup>19</sup> and nowadays it is part of the Charter of Fundamental Rights in the EU.<sup>20</sup> This includes the right of every person to be heard before any measure is taken which would affect that person.

**11-12** In the Court, the right to be heard is guaranteed by the written procedure, interim procedure and oral hearing. Decisions on the merits may only be based on grounds, facts and evidence, which were submitted by the parties or introduced into the procedure by an order of the Court and on which the parties have had an opportunity to present their comments.<sup>21</sup> Within proceedings, the parties are on many occasions given an opportunity to be heard before the Court makes an order or takes some action, in which case the Court shall or may (depending on the specific rule) request the parties to provide written submissions within a specified period and will invite the parties to an oral hearing on a date fixed by the Court. The Court may also order that a hearing takes place by telephone or video conference to enable access to the Court.<sup>22</sup>

## Impartial Tribunal

**11-13** The Court shall evaluate evidence freely and independently.<sup>23</sup>

## Legal Certainty

**11-14** The principle of fairness also provides that fairness is ensured by having regard to the legitimate interests of all parties. This calls for the principle of legal certainty which again is one of the general principles of EU law, recognised by the CJEU. The general idea behind the principle is that the law must be certain, i.e. clear and precise, and its legal implications must be foreseeable. The concept of legal certainty in EU law has various sub-concepts: predictability and legitimate expectations of parties are regarded as the most important of these.<sup>24</sup> To that end, the UPCA provides that decisions of the Court are decided in accordance with the requests of the parties; the Court must not award more than is requested.<sup>25</sup>

## Case Management and Flexibility

**11-15** The case management procedure aims to guarantee efficient proceedings. The Court will actively manage the cases before it in accordance with the RoP without impairing the freedom of the parties to determine the subject-matter of, and the supporting evidence for, their case.<sup>26</sup> According to the preamble to the RoP, parties should cooperate with the Court and set out their full case as early as possible in the proceedings.<sup>27</sup>

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<sup>18</sup> See r.262A RoP and also explanation in Chapter 12 (Written Procedure), paragraphs 12-47 to 12-49.

<sup>19</sup> *Maurice Alvis v Council of the European Economic Community* (C-32/62) ECLI:EU:C:1963:15 [55].

<sup>20</sup> art.41 Charter of Fundamental Rights of the European Union.

<sup>21</sup> art.76(2) UPCA.

<sup>22</sup> r.264 RoP.

<sup>23</sup> art.76(3) UPCA.

<sup>24</sup> para.5 preamble to the RoP.

<sup>25</sup> art.76(1) UPCA.

<sup>26</sup> art.43 UPCA.

<sup>27</sup> para.7 preamble to the RoP.

**11-16** Case management has a close connection to the principle of flexibility. All procedures are to be organised in a flexible and balanced manner.<sup>28</sup> The preamble to the RoP states that flexibility shall be ensured by applying all procedural rules in a flexible and balanced manner with the required level of discretion for the judges to organise the proceedings in the most efficient and cost effective manner.<sup>29</sup>

## Overview of Procedure

**11-17** Most inter partes proceedings before the Court consist of five stages.<sup>30</sup> These stages are shown in figure [11-1](#) and are as follows:

- a written procedure;<sup>31</sup>
- an interim procedure;<sup>32</sup>
- an oral procedure which includes an oral hearing (unless the parties have agreed and the Court has dispensed with the oral hearing);<sup>33</sup>
- a procedure for the award of damages;<sup>34</sup> and
- a procedure for cost decision.<sup>35</sup>

## Organisation of the RoP

**11-18** The RoP have been drafted to be as simple to navigate as possible. There are six parts as follows:

- **Part 1 – Procedures before the Court of First Instance.** This is further broken down into six chapters. Chapters 1 to 5 set out the procedure for the five stages referred to in paragraph [11-17](#) and shown in figure [11-1](#) and chapter 6 describes the procedure for security for costs. Chapter 1, which describes the written procedure, is itself broken down into six sections each of which deals with a different type of action.
- **Part 2 – Evidence.** There are five chapters to part 2. Chapters 1 and 2 set out the procedure for witnesses and experts, including Court experts. Chapters 3, 4 and 5 set out the procedures for applying for orders to produce evidence and communicate information, to preserve evidence and for inspection and for freezing assets and for experiments.
- **Part 3 – Procedure for provisional measures.**
- **Part 4 – Procedures before the Court of Appeal.** This is broken down into five chapters, the first four dealing with the written, interim and oral procedures and decisions. Chapter 5 sets out the procedure for an application for a rehearing.
- **Part 5 – General provisions.** There are 13 chapters in part 5. They deal with all the necessary procedural rules which do not sit within the other parts of the RoP and include service and time periods, case management and the rights and obligations of representatives. Many of these procedures are described in this chapter.
- **Part 6 – Fees and legal aid.**

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<sup>28</sup> art.52 UPCA.

<sup>29</sup> para.4 preamble to the RoP. This is further elaborated on in r.332 RoP which sets out the general principles of active case management. See chapter 13 (Interim Procedure).

<sup>30</sup> r.10 RoP.

<sup>31</sup> See chapter 12.

<sup>32</sup> See chapter 13.

<sup>33</sup> See chapter 14.

<sup>34</sup> See chapter 15.

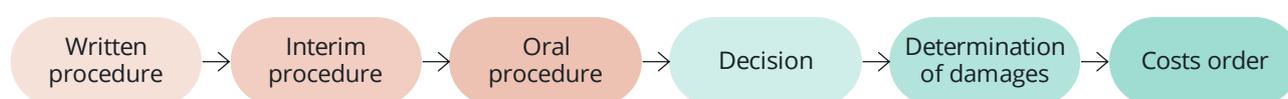
<sup>35</sup> See chapter 20.

**11-19** The RoP have been the subject of very broad consultation and an opinion had to be sought from the European Commission on their compatibility with EU law before finally being adopted by the Administrative Committee.<sup>36</sup> In the event of any conflict between the RoP and the provisions of the UPCA and the UPCA Statute, the latter will prevail.<sup>37</sup>

## Case Management System

**11-20** Cases are managed through an electronic case management system, which serves as the core collaboration platform for performing the tasks of the Court. It is a single platform and data repository, through which documents are filed and cases managed. The case management system is accessible to users through the Court's website at <https://secure.unified-patent-court.org/login>. Users must have their identity authenticated before being able to use the case management system.

### Figure 11-1: The Procedural Stages Before the Court



## Pre-action Procedures

### *Letters Before Action*

**11-21** There is no mandatory pre-action procedure in the UPCA or the RoP. The claimant, therefore, will not face specific costs sanctions if it fails to warn the defendant that proceedings are about to be issued.<sup>38</sup> However, the Court has a wide discretion when considering what costs to award the successful party and if equity requires, can alter the general rule that the loser pays the winner's costs.<sup>39</sup> One of the factors it can take into account is the procedural behaviour of the parties. Thus where a claimant brings an action without prior notice and the defendant surrenders immediately, the Court will probably refuse to award any costs to the claimant. The Court may also, if it considers the matter exceptional, deny or reduce the reimbursement of Court fees.<sup>40</sup>

**11-22** A patentee should also bear in mind that alleged infringers, unless they receive a translation of the Unitary patent in a language they understand, may not know or may not have reasonable grounds to know that their acts are infringing and this will be taken into consideration by the Court when assessing a claim for damages.<sup>41</sup> Clearly, this is a presumption which may be overturned by appropriate evidence from the patentee, such as putting the alleged infringer on notice by sending a copy of the patent and the necessary translation.<sup>42</sup>

<sup>36</sup> As required by art.41(2) UPCA.

<sup>37</sup> art.41(1) UPCA and r.1(1) RoP.

<sup>38</sup> Note that in relation to standard essential patents (SEPs) i.e. those patents where an irrevocable undertaking to grant a licence on FRAND terms has been given to a standards setting body, bringing a claim for infringement which includes a claim for an injunction without prior notice will necessarily be an abuse of a dominant position, even if the SEP has already been used by the alleged infringer. See *Huawei Technologies Co. Ltd v ZTE Corp. & anr.* (C-170/13) ECLI:EU:C:2015:477 at [61].

<sup>39</sup> art.69 UPCA. See chapter 20 (Court Fees and Recoverable Costs).

<sup>40</sup> r.370(9)(b) and (e) RoP. Procedural behaviour is specifically mentioned as one of the factors the Court must consider in relation to the reimbursement of fees.

<sup>41</sup> art.4(4) Translation Regulation refers in particular to where the alleged infringer is an SME, natural person, a non-profit organisation, a university or a public research organisation.

<sup>42</sup> art.4(4) Translation Regulation provides that the alleged infringer may request that the translation is provided in an official language either of the Member State in which the alleged infringement took place or the Member State in which the alleged infringer is domiciled.

**11-23** Prior to sending a letter before action that does anything more than notify the recipient of the patent, patentees should check whether there is any relevant national legislation on actions for unjustified threats of patent infringement which might inform whether and if so how the patentee should notify the recipient. The letter before action could be a basis for an independent action before a national court for an injunction and damages if national rules are not followed.

### *Preliminary Injunctions, Saisies and Freezing Orders*

**11-24** Where there is an urgent need to prevent a threatened infringement or to stop the continuation of an alleged infringement, the UPCA and RoP provide that the patentee may apply for various provisional measures including injunctions, seizure of goods and blocking bank accounts.<sup>43</sup> Such an application may be made ex parte in particular where any delay is likely to cause irreparable harm or where there is a risk of evidence being destroyed. A party may also apply for an order to preserve evidence (a saisie)<sup>44</sup> or a freezing order if it believes that a defendant is about to remove assets from the jurisdiction of the Court.<sup>45</sup> Again, in both cases such applications may be made ex parte where any delay is likely to cause irreparable harm or where there is a risk of evidence being destroyed or assets removed.<sup>46</sup>

### *Protective Letters*

**11-25** Anyone who is concerned that they may be sued for patent infringement should consider filing a protective letter<sup>47</sup> at the Registry if there is a likelihood that the patentee might apply ex parte for either provisional measures (e.g., an injunction) or a saisie. A protective letter sets out the response to any such application that might be made by the patentee. For example, the letter might set out why the patent is not infringed or why it is invalid.

**11-26** The content of the protective letter is specified as one of the factors that the Court must consider in exercising its discretion on how to proceed in an application for a provisional injunction.<sup>48</sup> Such letters are particularly useful to defendants in ex parte applications as the defendant's submissions can be seen by the judge. In many jurisdictions where protective letters are common, the effect of the protective letter is that the judge will then order an oral hearing to take place. This is also contemplated in the RoP.<sup>49</sup>

## Written Procedure

**11-27** The written procedure for an action on the merits is set out in part 1 RoP. The Court has exclusive competence over the actions listed in art.32(1)(a) to (i) UPCA, namely:

- Infringement actions including counterclaims for revocation;<sup>50</sup>
- Revocation actions;
- Declarations of non-infringement (DNI);
- Actions for compensation for licences of right under art.8(1) Unitary Patent Regulation; and

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<sup>43</sup> art.62 UPCA and part 3 RoP. See also chapter 16 (Provisional and Protective Measures).

<sup>44</sup> art.60 UPCA and part 2, ch.4 RoP. See also chapter 18 (Orders to Produce Evidence Including "Saisies").

<sup>45</sup> art.61 UPCA and r.200 RoP.

<sup>46</sup> rr.197 and 212 RoP.

<sup>47</sup> r.207 RoP.

<sup>48</sup> r.209(2)(d) RoP.

<sup>49</sup> See chapter 16 (Provisional and Protective Measures) paragraphs 16-73 to 16-89.

<sup>50</sup> Actions for infringement and declarations of non-infringement relate to both patents and SPCs, and the reference to revocation actions includes invalidity actions over SPCs.

- Action against a decision of the EPO in carrying out the tasks referred to in art.9 Unitary Patent Regulation.<sup>51</sup>

- 11-28** There are some differences in phases and timelines of these actions. However, in general, the written procedure consists of the exchange of written pleadings comprising a SoC,<sup>52</sup> SoD, and optionally also a reply to the SoD and a rejoinder to the reply. Detailed timelines for an infringement action, an action for a DNI and a revocation action are set out in the Annex to this chapter.
- 11-29** Cases are front-loaded with the parties expected to lodge detailed SoC and SoD containing all the evidence relied upon, where available, and an indication of any further evidence which will be offered in support.<sup>53</sup> A claimant will need to consider carefully what evidence should be produced with the SoC and what can be presented later through, for example, statements from witnesses and expert reports. A discussion of the strategic considerations involved can be found in chapter 17 (Evidence).<sup>54</sup> A claimant must also consider in which division to file its SoC, that is if it has a choice,<sup>55</sup> the language in which it will file its SoC<sup>56</sup> and what, if any, translations it will need to lodge with the Registry in order for the SoC to be served. The SoC is lodged at the Registry or sub-registry in electronic form<sup>57</sup> and the necessary fee has to be paid.<sup>58</sup>
- 11-30** The Registry is responsible for serving the SoC on the defendant, but before doing so, will examine it for formal requirements and will notify the claimant of any points of non-compliance with the requirements of the RoP and allow the deficiencies to be corrected.<sup>59</sup> The Registry records the action in the register and assigns it to a panel.<sup>60</sup> A judge-rapporteur, one of the legally qualified judges on the panel, is then designated to the case.<sup>61</sup> The judge-rapporteur is responsible for case management during the written and interim procedures and the role is thus a very important one.<sup>62</sup>
- 11-31** Following service, a defendant has three months to file a SoD in an infringement action,<sup>63</sup> two months in a revocation action (which may also include an application to amend the patent)<sup>64</sup> and two months in an action for a DNI.<sup>65</sup> The defendant, like the claimant, must include the evidence relied upon, where available, in the SoD. The defendant can also, within one month, lodge a preliminary objection by which it can challenge the jurisdiction and competence of the Court or the division indicated by the claimant, or the language of the claimant's statement or application,<sup>66</sup> but this does not stay or delay its other deadlines.

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<sup>51</sup> The tasks set out in art.9 Unitary Patent Regulation include (among others) administering requests for unitary effect by proprietors of European patents, setting up and maintaining a register for Unitary patents within the EPO's patent register, receiving and registering statements on licensing and publishing translations under the Translation Regulation. See chapter 2 (Patent Applications and Securing Grant of the Unitary Patent) paragraphs 2-81 to 2-117 for details of actions against decisions of the EPO.

<sup>52</sup> SoC is used in this chapter in the same way as in r.270(2) RoP to refer to all originating pleadings in actions that fall under the exclusive competence of the Court.

<sup>53</sup> For example, see r.13(1)(m) RoP, but the wording is common to all the rules listing the necessary contents of the various written pleadings.

<sup>54</sup> See paragraphs 17-35 to 17-40.

<sup>55</sup> See chapter 6 (Jurisdiction, Competence and Forum Shopping), in particular the section on the competence of the divisions starting at paragraph 6-41.

<sup>56</sup> See paragraphs [11-107](#) to [11-130](#) in relations to language requirements.

<sup>57</sup> r.4 RoP.

<sup>58</sup> See chapter 20 (Court Fees and Recoverable Costs) paragraphs 20-06 to 20-36 for the calculation of Court fees.

<sup>59</sup> r.16 RoP.

<sup>60</sup> r.17 RoP.

<sup>61</sup> r.18 RoP.

<sup>62</sup> r.331(1) RoP.

<sup>63</sup> r.23 RoP. See the Annex to this chapter for the timeline for an infringement action.

<sup>64</sup> rr.49 and 50 RoP. See the Annex to this chapter for the timeline for a revocation action.

<sup>65</sup> r.67 RoP. See the Annex to this chapter for the timeline for a DNI action.

<sup>66</sup> rr.19, 47, 48 and 63 RoP.

- 11-32** Either party may, in supporting their claims, specify that evidence lies in the control of the other party and can, either during the written procedure or in the interim procedure, apply for an order that the other party produce that evidence or communicate information.<sup>67</sup>
- 11-33** After further exchanges of written pleadings (the timeline of which differ according to the type of action), the judge-rapporteur will inform the parties of the date on which he intends to close the written procedure.<sup>68</sup> The procedure should have taken between five and nine months from lodging the SoC to this point, depending on the type of action.
- 11-34** Either before or, more usually, as soon as practicable following the closure of the written procedure, the panel will decide how to proceed under art.33(3) UPCA, that is, where a counterclaim for revocation has been made in an infringement action. The options for the panel are to:
- Proceed with both actions (in which case the judge-rapporteur is obliged to request the allocation to the panel of a technically qualified judge)<sup>69</sup>;
  - Refer the counterclaim for revocation to the central division and either suspend or proceed with the infringement action (the bifurcation option); or
  - With the agreement of the parties, refer the whole case to the central division.
- 11-35** Where the decision is made by the local or regional division to bifurcate the action (the second of the above three options), the panel must stay the infringement proceedings where there is a high likelihood that the relevant claims of the patent will be held invalid in the revocation proceedings.<sup>70</sup> If, having decided to bifurcate, the panel proceeds with the infringement proceedings, the judge-rapporteur must liaise with the central division and the revocation proceedings will be accelerated.<sup>71</sup> In this way, it is hoped to minimise what is referred to as the injunction gap (i.e. the time following an infringement decision before a decision is made on the patent's validity).

## Interim Procedure

- 11-36** The written procedure is followed by an interim procedure that may, where appropriate, include an interim hearing with the parties<sup>72</sup> held by the judge-rapporteur. The interim conference is held remotely by telephone or video conference where possible<sup>73</sup> but, if not, it can also be held in person at the Court.<sup>74</sup>
- 11-37** The interim procedure is a key part of the process for preparing the case for the oral hearing. During the interim procedure the judge-rapporteur will complete all necessary preparations for the oral hearing, such as identifying the main issues, determining the relevant facts in dispute and establishing a schedule for the further progress of the proceedings including confirming the date for the oral hearing. The judge-rapporteur may also issue orders regarding production of further pleadings and evidence and will decide the value of the action for the purpose of

<sup>67</sup> rr.190 and 191 RoP. Other means of obtaining evidence include orders to freeze assets, experiments and letters of request (rr.200, 201 and 173 RoP).

<sup>68</sup> r.35 RoP.

<sup>69</sup> r.37(3) RoP.

<sup>70</sup> r.37(4) RoP.

<sup>71</sup> rr.37(5) and 40(b) RoP. Rr.75 and 76 RoP set out the procedure for where an infringement action is commenced in a local division after either a revocation action or a DNI is already before the central division (arts 33(5) and (6) UPCA).

<sup>72</sup> art.52(2) UPCA. See chapter 13 (Interim Procedure) for further detail.

<sup>73</sup> r.105(1) RoP.

<sup>74</sup> r.105(2) RoP.

setting fees and the ceiling for recoverable costs.<sup>75</sup> The judge-rapporteur is also responsible, during the interim procedure, for exploring the possibility of a settlement with the parties.<sup>76</sup>

**11-38** As a general rule, the interim procedure should be completed within three months.<sup>77</sup>

## Oral Procedure

**11-39** The interim procedure is closed when the judge-rapporteur considers the preparation of the case to be adequate. The oral procedure starts immediately afterwards.<sup>78</sup> The judge-rapporteur hands over responsibility for case management to the presiding judge, who must ensure that the action is ready for a decision on the merits at the end of the oral procedure.<sup>79</sup>

**11-40** The oral hearing is held before the panel and it is at this stage that the parties have an opportunity to explain their arguments through oral submissions.<sup>80</sup> However, it is possible, with the agreement of the parties, for the Court to dispense with the oral hearing.<sup>81</sup>

**11-41** As proceedings are front-loaded with great weight placed on the written procedure, the substantive oral hearing is relatively short and should generally be completed within one day.<sup>82</sup> If ordered during the interim procedure, witnesses and experts may be heard at the oral hearing and questioned by the panel and the parties.<sup>83</sup>

**11-42** The Court should give a written and reasoned decision on merits within six weeks after the oral hearing.<sup>84</sup>

## Subsequent Procedures

**11-43** The determination of the amount of damages<sup>85</sup> and/or an award of costs<sup>86</sup> may be the subject of separate proceedings following the decision on the merits, if they have not been determined as part of the substantive proceedings.

**11-44** Final first instance decisions may be appealed to the Court of Appeal as a matter of course.<sup>87</sup> The stages in the appeal proceedings are the same as in the first instance but the time periods for written pleadings differ.

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<sup>75</sup> r.104 RoP.

<sup>76</sup> art.52(2) UPCA.

<sup>77</sup> r.101(1) RoP.

<sup>78</sup> r.110 RoP.

<sup>79</sup> r.111(b) RoP.

<sup>80</sup> art.52(3) UPCA.

<sup>81</sup> art.52(3) UPCA.

<sup>82</sup> r.113 RoP.

<sup>83</sup> r.112 RoP.

<sup>84</sup> r.118(6) RoP.

<sup>85</sup> rr.125 to 140 RoP. See chapter 15 (Remedies) for further information on the procedure for claiming damages and compensation.

<sup>86</sup> rr.150 to 157 RoP. See chapter 20 (Court Fees and Recoverable Costs) paragraphs 20-91 to 20-110 for further information on the procedure for claiming costs.

<sup>87</sup> r.220(1) RoP. See chapter 22 (Procedure before the Court of Appeal).

# Procedural Rules Relating to Parties

## Who Can Start Proceedings?

**11-45** The definition of who has the legal capacity to commence proceedings is very broad. Any natural or legal person, or any body equivalent to a legal person entitled to initiate proceedings in accordance with its national law, has the capacity to be a party to proceedings before the Court.<sup>88</sup>

## *Infringement and Infringement-related Actions*

- 11-46** A patent proprietor is entitled to bring actions before the Court.<sup>89</sup> Its licensees are also entitled to do so, as follows, but the patent proprietor is entitled to join any such action:
- An exclusive licensee is entitled to bring an action before the Court provided that the patent proprietor is given notice and the licensing agreement does not provide otherwise;
  - A non-exclusive licensee is entitled to bring an action before the Court provided that it is expressly permitted to do so by the licensing agreement and then it must still give prior notice to the patent proprietor.<sup>90</sup>
- 11-47** A patentee of a Unitary patent who is a would-be claimant must ensure that its name is on the register kept by the EPO for Unitary patent protection before commencing proceedings, since the person shown in the register is treated as the patent proprietor.<sup>91</sup> In relation to European patents, the same strict rules does not apply; there is merely a rebuttable presumption that the person shown in the national patent register is entitled to be registered as the proprietor.<sup>92</sup> The proprietor is in fact the person entitled to be registered as such under the law of each Contracting Member State in which the European patent has been validated, whether or not such person is recorded in the register of patents maintained in such Contracting Member State. Therefore, provided that it can show that it is entitled to be so registered under the laws of the relevant Contracting Member States, a proprietor of a European patent and would-be claimant can commence proceedings for infringement of a European patent before the Court irrespective of what is shown in the national patent registers.

## *Co-owners*

- 11-48** The issue of co-ownership or joint ownership of a Unitary or European patent is not addressed in the UPCA and is a matter of national law. In relation to a Unitary patent, the relevant national law that governs the patent as an object of property will govern the issues of co-ownership.<sup>93</sup> In relation to European patents, the law is that of the Contracting Member State in which it is granted.
- 11-49** The effect of co-ownership is that each of the proprietors owns a share of the patent. Although the law in relation to co-ownership is not harmonised across the EU, generally speaking, one co-owner may enforce the patent without the other co-owners' consent.

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<sup>88</sup> art.46 UPCA.

<sup>89</sup> art.47(1) RoP.

<sup>90</sup> arts 47(2) and (3) UPCA.

<sup>91</sup> r.8(4) RoP and r.15 Unitary Patent Rules.

<sup>92</sup> r.8(5)(a) and (c) RoP.

<sup>93</sup> art.7 Unitary Patent Regulation. See chapter 3 (Transactions with Unitary Patents and European Patents Subject of the Court) paragraphs 3-02 to 3-17.

However, the legal requirements and consequences of doing so differ between Contracting Member States.<sup>94</sup>

### *Revocation Actions*

**11-50** Any natural or legal person, or anybody entitled to bring actions in accordance with that body's national law may bring a revocation action provided such person "is concerned by [the] patent".<sup>95</sup> It is unclear whether a general public interest will be sufficient or whether a specific legal or commercial interest has to be shown. The latter is not necessary, for example, in Germany or the EPO, where a person wishing to remain anonymous can apply to revoke or oppose the grant of a patent through a strawman, i.e; a company set up for the sole purpose of conducting litigation.

## Who is the Defendant?

### *Infringement Actions*

**11-51** The defendant is, in broad terms, the person who commits the acts of direct and indirect infringement in arts 25 and 26 UPCA. Art.32(1) UPCA provides that the Court has exclusive jurisdiction over such actions and the claimant may claim an injunction (including a provisional injunction) and damages (including compensation from the date of publication of the patent application).

**11-52** The definition of infringing acts is very wide<sup>96</sup> and, therefore, a number of different defendants may be involved in what might be thought of as a single instance of infringement, for example, the manufacture of a product is one act of direct infringement, whilst the keeping of the product is another and the supply is another. Each defendant is responsible for their own act of infringement although the claimant can bring an action against one or all of them provided that the action relates to the same alleged infringement.<sup>97</sup> Double recovery of damages for any act of infringement is not permitted. If it were otherwise, damages would be more than compensatory.<sup>98</sup>

**11-53** Where two or more defendants act together, they may be liable as joint tortfeasors, that is they are both (or all) jointly liable for the act of infringement and therefore the damage caused to the claimant. The question of whether there is joint tortfeasorship is answered by national law,<sup>99</sup> although generally some form of common design, as opposed to mere facilitation, must exist between the defendants.

**11-54** In some instances, third parties may be caught up in the infringing act, for example, intermediaries whose services are being used by the infringer to transport or store goods or offer them over the Internet. In such cases, the claimant may be able to claim an injunction against the intermediaries<sup>100</sup> but they may be sheltered from any claim to damages under arts 68(1) and (4) UPCA as they may lack the necessary knowledge that the act was one of infringement.

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<sup>94</sup> See the responses to AIPPI study on "The Impact of Co-Ownership of Intellectual Property Rights on their Exploitation" Q194 available at <https://www.aippi.fr/upload/Singapour%202007%20Q193%20194%20195/sr194english.pdf> [Accessed 13 April 2023].

<sup>95</sup> art.47(6) UPCA.

<sup>96</sup> See [chapter 10](#) (Infringement of Unitary Patents (and European Patents Subject to the Court) – Substantive Law).

<sup>97</sup> art.33(1)(b) UPCA.

<sup>98</sup> See chapter 15 (Remedies) paragraphs 15-42 to 15-59 on the calculation of damages.

<sup>99</sup> See chapter 7 (Applicable Law) paragraph 7-74.

<sup>100</sup> For a discussion of injunctions granted against intermediaries, see chapter 15 (Remedies) paragraphs 15-23 to 15-26.

## Actions for Revocation

- 11-55** A revocation action must be directed against the patent proprietor.<sup>101</sup> As explained in paragraph 11-47, for Unitary patents, this will be the person shown in the register for Unitary patent protection kept by the EPO. Therefore, in relation to a Unitary patent, the statement for revocation must be served on the registered proprietor<sup>102</sup> or the Registry will reject it when examining the formalities.<sup>103</sup> In relation to an action for revocation of a European patent, the person shown in the national patent register for each Contracting Member State as the proprietor is treated as such for both revocation actions and actions for DNIs. If no such person is registered in a national patent register, the last person recorded in the European patent register kept by the EPO is to be regarded as the proprietor.<sup>104</sup>
- 11-56** If the action for revocation has been served on a registered proprietor but that person is not entitled to be the registered proprietor<sup>105</sup> (for example if a patent has been transferred but the transfer has not yet been registered) the (former) proprietor shall as soon as practicable after service of the statement for revocation apply to the Court to be substituted by the person entitled to be the registered proprietor.<sup>106</sup> Accordingly, the claimant is relieved from the duty of finding out whether the person recorded in the register is in fact entitled to be the registered proprietor of the European patent. However, this could still lead to a number of practical difficulties. It is quite common, for one reason or another, for patent proprietors not to register changes in title. If title has passed from a company which is afterwards dissolved, but whose name remains on the register, there would be no legal entity on whom to serve the decision for revocation and no one to apply to the Court to substitute the actual owner of the patent. Restoring a company for this purpose would hardly be sensible. Similarly, the patent may have passed through a number of hands following an assignment from the person registered so the registered proprietor may have no knowledge of who owns the patent, in which case, the registered proprietor may simply apply to be removed from both the register and the action as it would have no interest in the action.
- 11-57** It remains to be seen in practice whether any burden will devolve upon the claimant to review the ownership of the patent and, if the register is not correct and the current owner can be found or is otherwise known to the claimant, include information on the present owner of the patent in the statement for revocation. In relation to a European patent, since the presumption that the person registered as the proprietor is the proprietor is rebuttable, the claimant would be able to direct the statement of revocation to the current owner of the patent.

## Multiple Parties or Patents – the Court’s Powers

- 11-58** Although proceedings may be commenced by more than one claimant or in respect of more than one patent, the Court may order that these be heard in separate proceedings.<sup>107</sup> Proceedings may also be started against more than one defendant if the Court has competence in respect of all of them.<sup>108</sup> Again, the Court may order separate proceedings against the

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<sup>101</sup> r.42(1) RoP. The validity of a patent cannot be contested in an action for infringement brought by the holder of a licence where the patent proprietor does not take part in the proceedings. Therefore the defendant to an infringement action brought by a licensee must bring any counterclaim for revocation of the patent against the patentee (art.47(5) UPCA).

<sup>102</sup> r.8(4) RoP.

<sup>103</sup> r.47 RoP.

<sup>104</sup> r.8(6) RoP.

<sup>105</sup> r.8(5)(a) RoP provides that in relation to the proprietor of a European patent, the person entitled to be registered as the proprietor under the law of each Contracting Member State in which such European patent has been validated shall be treated as the proprietor, whether or not such person is recorded as such.

<sup>106</sup> r.42(2) RoP.

<sup>107</sup> r.302(1) RoP.

<sup>108</sup> r.303(1) RoP. Note that an action may only be brought against multiple defendants where there is a commercial relationship between them and where the action relates to the same infringement (art.33(1)(b) UPCA).

different defendants.<sup>109</sup> Additional Court fees may be payable if separate proceedings are ordered.<sup>110</sup>

**11-59** The Court also has the power to consolidate proceedings. The Court can order that parallel infringement and revocation actions relating to the same patent or patents and before the same local or regional division or the central division or the Court of Appeal be heard together when it is in the interests of justice to do so.<sup>111</sup>

## Change in Parties

**11-60** Parties may need to be added, removed or substituted during the course of proceedings and the RoP makes provision for this. Although the RoP is silent as to when these changes can be made, it is likely that a change to the parties can be made at any stage of the proceedings on application to the Court.

**11-61** An application is made by a party requesting that the Court make an order to change a party to the proceedings.<sup>112</sup> The change is not made until the Court has invited the other parties to the proceedings to comment on the application.<sup>113</sup> When the order is made, the Court will also make appropriate orders as to the payment of fees and costs.<sup>114</sup> It will also give directions to regulate the consequences as to case management and determine the extent to which the new party is bound by the proceedings as then constituted.<sup>115</sup>

**11-62** A party may cease to exist or become insolvent during the course of proceedings. Although the RoP provide for these circumstances, the present rules lack detail as to the precise procedure to be followed.

## Death or Demise of a Party

**11-63** If a party dies or ceases to exist (e.g. a company is wound up) during the course of proceedings, the proceedings will be stayed until the party has been replaced by its successor.<sup>116</sup> However, if there are more than two parties to the proceedings, the Court may decide that:

- The proceedings between the remaining parties are continued separately; and
- The stay will only concern the proceedings relating to the party that no longer exists.<sup>117</sup>

**11-64** An obvious question is who notifies the Court of such an event? If a party is not represented, the Court or the other party may not be aware that a party has either died or ceased to exist and may continue with the proceedings as if nothing had happened. The RoP state that if the successor of the party that died or ceased to exist does not continue the proceedings of its own motion within a period specified by the Court, any other party can apply to have the successor added or substituted as a party.<sup>118</sup> However, this does not fully address the potential issues. For example, the RoP may be in conflict with the national law of the deceased person or dissolved company which governs the right to bring or defend proceedings. For example, in the case of a deceased natural person, the right may pass under a will or the laws of intestacy. Further, there may be issues such as whether a natural person should become a party to proceedings of which they were not aware.

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<sup>109</sup> r.303(2) RoP.

<sup>110</sup> rr.302(2) and 303(3) RoP.

<sup>111</sup> r.302(3) RoP.

<sup>112</sup> r.305(1) RoP.

<sup>113</sup> r.305(2) RoP.

<sup>114</sup> r.305(3) RoP.

<sup>115</sup> r.306 RoP.

<sup>116</sup> r.310(1) RoP.

<sup>117</sup> r.310(2) RoP. See paragraphs [11-163](#) to [11-165](#) in relation to the stay of proceedings.

<sup>118</sup> r.310(3) RoP.

**11-65** The Court must decide who can be added or substituted as a party and will make orders to the conduct of proceedings in accordance with rr.305 and 306 RoP.<sup>119</sup> Following an application, the Court will invite the other parties to the proceedings to comment before making a decision. The Court will also make orders for Court fees, costs and directions and determine the extent to which a new party is bound by the proceedings.

### *Insolvency of a Party*

**11-66** If a party is declared insolvent under an applicable law, the Court will stay the proceedings for up to three months until the competent national authority or person dealing with the insolvency has decided whether or not to continue with the proceedings.<sup>120</sup> Where they decide not to continue with the proceedings, the Court may decide, following a reasoned request by the other party, that the proceedings should be continued in accordance with the applicable national insolvency law.<sup>121</sup> Again, there is no provision in the RoP as to who is responsible for notifying the Court.

**11-67** Proceedings may also be stayed at the request of a temporary administrator who has been appointed before a party is declared insolvent.<sup>122</sup>

**11-68** The claimant will have the choice of withdrawing an action against an insolvent defendant or continuing it. Similarly, a defendant can withdraw a counterclaim for revocation against an insolvent claimant or continue with the proceedings. A condition of withdrawal is that it does not prejudice the action against the other parties.<sup>123</sup>

**11-69** If proceedings are continued, the effect of the decision of the Court with respect to the insolvent party is determined by the law applicable to the insolvency proceedings.<sup>124</sup>

### *Transfer of Patent During Proceedings*

**11-70** A new proprietor of the patent or patent application in suit can be added or substituted as a party. The addition or substitution is only made to the extent that the patent and the claims in the proceedings have been assigned to the new proprietor.<sup>125</sup> Where a new proprietor takes over the proceedings, no new Court fee is payable even where the new proprietor is represented by a new representative.<sup>126</sup>

**11-71** The existing party, the assignee or the other parties to the proceedings may seek the Court's authorisation for the new proprietor to be added or substituted as a party.<sup>127</sup> However, the RoP does not discuss the requirements of such an application and what information is required by the Court.

**11-72** If the new proprietor does not wish to take over the proceedings, any decision in the proceedings that has been recorded in the register will be still be binding on the new proprietor.<sup>128</sup>

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<sup>119</sup> See paragraphs [11-60](#) and [11-61](#).

<sup>120</sup> r.311(1) RoP.

<sup>121</sup> r.311(1) RoP.

<sup>122</sup> r.311(2) RoP. See paragraphs [11-163](#) to [11-165](#) in relation to the stay of proceedings.

<sup>123</sup> r.311(3) RoP. Withdrawal of proceedings is discussed in further detail in paragraphs [11-156](#) to [11-158](#).

<sup>124</sup> r.311(4) RoP.

<sup>125</sup> r.312(1) RoP.

<sup>126</sup> r.312(2) RoP.

<sup>127</sup> r.312(1) RoP.

<sup>128</sup> r.312(3) RoP.

## Intervention

**11-73** Third parties may intervene in proceedings by way of three mechanisms: an application to intervene, an invitation to intervene and forced intervention.<sup>129</sup> It is important to note that there is no appeal against an order refusing an application to intervene.<sup>130</sup>

### *Application to Intervene*

**11-74** An application to intervene can be made at any stage in the proceedings before the Court of First Instance or the Court of Appeal by a person, the intervener, who establishes that they have “a legal interest in the result of an action submitted to the Court”.<sup>131</sup> If the application is successful, the intervener is treated as a party unless otherwise ordered by the Court.<sup>132</sup>

**11-75** The application will only be admissible if it is made in support, in whole or in part, of a claim, order or remedy sought by one of the parties, and is made before the closure of the written proceedings unless the Court of First Instance or the Court of Appeal orders otherwise. It must contain:<sup>133</sup>

- A reference to the action number of the file;
- The names of the intervener, its representative and postal and electronic addresses for service and the names of the person authorised to accept service;<sup>134</sup>
- The claim, order or remedy sought; and
- A statement of facts establishing the right to intervene.

**11-76** The admissibility of the application to intervene is decided by the judge-rapporteur by way of an order, but the existing parties to the proceedings will be given an opportunity to be heard beforehand.<sup>135</sup> Where the application is admissible, the judge-rapporteur or the presiding judge will inform the parties to the proceedings and specify the period within which the intervener may lodge a so-called statement in intervention.<sup>136</sup>

**11-77** The statement in intervention must contain the following:<sup>137</sup>

- A statement as to the issues involving the intervener and one or more of the parties and their connection to matters in dispute;
- Arguments of law; and
- Facts and evidence relied on.

**11-78** The Registry will provide the intervener with any written pleadings served by the parties, although public versions will already be available to the intervener through the case management system. The RoP contains provisions to protect confidential information disclosed in the pleadings. Specifically, the Court may make an order for the protection of confidential

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<sup>129</sup> rr.313 to 316A RoP.

<sup>130</sup> r.317 RoP.

<sup>131</sup> r.313(1) RoP.

<sup>132</sup> r.315(4) RoP.

<sup>133</sup> rr.313(2) and 313(4) RoP.

<sup>134</sup> r.313(3) RoP. Representation is governed by art.48 UPCA. See chapter 23 (Legal Representation, Privilege and Code of Conduct) paragraphs 23-01 to 23-13.

<sup>135</sup> r.314 RoP.

<sup>136</sup> r.315(1) RoP.

<sup>137</sup> r.315(4) RoP.

information such that the pleading or part of it may only be disclosed to certain named persons subject to appropriate non-disclosure terms following a request from a party.<sup>138</sup>

### *Invitation to Intervene*

- 11-79** The judge-rapporteur or presiding judge may of their own motion after hearing the parties, or on a reasoned request from a party, invite any person concerned with the outcome of the dispute to inform the Court within a period to be specified whether they wish to intervene in the proceedings.<sup>139</sup>
- 11-80** If the relevant person wishes to intervene, an application to intervene must be lodged within one month of service of the invitation. Such an intervener will be bound by the decision in the action<sup>140</sup> and must be represented in accordance with art.48 UPCA.<sup>141</sup>
- 11-81** The application following an invitation to intervene must contain the same information as that in the standard application to intervene.<sup>142</sup>
- 11-82** As with a standard application to intervene, the admissibility is decided by the judge-rapporteur, the existing parties having a right to be heard beforehand.<sup>143</sup> Where the application is admissible, the existing parties are informed and the intervener given a period within which to lodge a statement in intervention.<sup>144</sup>
- 11-83** Where a third party has been invited by the Court to intervene, but contends that it should not be bound by a decision in the action, it must lodge a statement to that effect within one month of service of the invitation. If no statement is lodged in the given period, the third party will be bound by the decision as between itself and the other party to the action and shall not be entitled to argue that the decision was wrong or that the inviting party did not properly conduct the proceedings leading to the decision.<sup>145</sup>

### *Forced Intervention*

- 11-84** A third party may also be forced to intervene on the order of the Court following an application of a party.<sup>146</sup> In such a case, the party making the application must state that it contends that the third party should be bound by the decision in the action even though that person refuses to intervene and must include the reasons for this contention.<sup>147</sup>

## Lodging and Service of Documents

### Lodging of Documents

- 11-85** The parties are required to lodge written pleadings and other documents at the Registry or relevant sub-registry in electronic form, making use of the official forms available on the Court's online case management system. The receipt of documents is confirmed by the automatic issue of an electronic receipt indicating the date and local time of receipt.<sup>148</sup> All pleadings (and

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<sup>138</sup> r.315(2) RoP.

<sup>139</sup> r.316(1) RoP.

<sup>140</sup> r.316(2) RoP.

<sup>141</sup> r.313(3) RoP. See chapter 23 (Legal Representation, Privilege and Code of Conduct) paragraphs 23-01 to 23-13 for information on legal representation.

<sup>142</sup> r.316(2) referring to rr.313(2) and 313(4) RoP. See paragraph [11-75](#).

<sup>143</sup> rr.316(2) and 314 RoP.

<sup>144</sup> rr.316(2) and 315(1) RoP. See paragraph [11-77](#).

<sup>145</sup> r.316A(2) RoP.

<sup>146</sup> r.316A RoP.

<sup>147</sup> r.316A(1) RoP.

<sup>148</sup> r.4(1) RoP.

documents lodged with pleadings) are marked by the Registry with the local time and date of their receipt at the Registry.<sup>149</sup>

- 11-86** Only where it is not possible to lodge a document electronically may a party lodge the document in hard-copy form. Even then, a party is expected to lodge an electronic copy of the document as soon as practicable thereafter.<sup>150</sup>
- 11-87** Where a party has to pay a fee when lodging an action or when filing a request or claim in a pending action, the action or request shall not be deemed to have been lodged until the fee has been paid.<sup>151</sup> There are a very few exceptions to this rule, namely urgent applications, and cases where an order for legal aid has been made.<sup>152</sup>
- 11-88** Provided the Registry finds nothing wrong with the formal requirements of a pleading, it will record the date of receipt of the pleading in the register. In relation to pleadings initiating actions, this date is regarded as the date on which an action is commenced.<sup>153</sup>

## Service by the Registry

- 11-89** The Registry is responsible for service of orders and decisions of the Court on the parties and of written pleadings and other documents of a party on the other party. The Registry must also supply parties with copies of documents lodged with pleadings and written evidence.<sup>154</sup>

## Service of a SoC in a Contracting Member State

### *Means and Methods of Service*

- 11-90** Electronic communication has been chosen as the primary method for service of proceedings in the Court. If the conditions in art.19 Service Regulation are met,<sup>155</sup> the Registry may serve the SoC on the defendant at an electronic address which the defendant has provided for the purpose;<sup>156</sup> on a representative<sup>157</sup> if the defendant has provided an electronic address to the Registry; or if a representative has notified the Registry or the claimant of this option.<sup>158</sup>
- 11-91** Where a representative accepts service on behalf of a party, service may be effected within the Case Management System.<sup>159</sup>
- 11-92** Where service cannot be effected by electronic means, the Registry shall use any other method foreseen in the Service Regulation, although serving the SoC by registered letter as described in art.18 Service Regulation is mentioned in particular.<sup>160</sup>
- 11-93** The primary form of serving documents under the Service Regulation is service in accordance with the law of the addressee's Member State, or by a particular method requested by the

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<sup>149</sup> r.261 RoP.

<sup>150</sup> r.4(2) RoP.

<sup>151</sup> r.15(2) RoP. This is consistent with art.70 UPCA which provides that Court fees shall be paid in advance unless the RoP provide otherwise.

<sup>152</sup> rr.371(3) and (5) RoP.

<sup>153</sup> rr.17(1) and (4) RoP.

<sup>154</sup> rr.6(1) and (2) RoP.

<sup>155</sup> These conditions can be summarised as the addressee giving express consent to the use of electronic means for service.

<sup>156</sup> r.271(1)(a) RoP.

<sup>157</sup> Either a representative according to art.48 UPCA or, for the purpose of serving a statement for revocation (r.44 RoP) or a statement for a DNI (r.63 RoP), a representative includes professional representatives and legal practitioners as defined in art.134 EPC who are recorded as the appointed representatives for the patent in the European Patent Register kept by the EPO or in the national patent register (rr.271(3) and 271(5)(c) RoP).

<sup>158</sup> r.271(1) RoP.

<sup>159</sup> r.271(2) RoP.

<sup>160</sup> According to art.18 Service Regulation "The service of judicial documents may be effected directly by postal services on persons present in another Member State by registered letter with acknowledgement of receipt or equivalent."

transmitting agency.<sup>161</sup> Other methods described in the Service Regulation are service by diplomatic or consular agents<sup>162</sup> and direct service through the judicial officers, officials or other competent persons of the addressee's Member State.<sup>163</sup>

**11-94** A further service method is provided as a last resort<sup>164</sup> provided that it is not contrary to the law of the state where service is to be effected.<sup>165</sup> If, on application by the claimant to the Court, there is a good reason to authorise service by a method or at a place not otherwise permitted by the RoP, the Court may by way of order permit service by an alternative method or at an alternative place.<sup>166</sup> On a reasoned request by the claimant, the Court may order that steps already taken to bring the SoC to the attention of the defendant by an alternative method or at an alternative place is good service.<sup>167</sup> In both of these circumstances, the Court order must specify the following:<sup>168</sup>

- The method or place of service; or
- The date on which the SoC is deemed served; and
- The period for filing the SoD.

### *Place of Service*

**11-95** The defendant may be served with a SoC at the following places:<sup>169</sup>

- In the case of a company or other legal person, its statutory seat, central administration or principal place of business within the Contracting Member States or at any place within the Contracting Member States where it has a permanent or temporary<sup>170</sup> place of business;
- In the case of individuals (i.e. natural persons), where the person usually resides or where he was last known to reside within the Contracting Member States.<sup>171</sup>

### *Date of Service*

**11-96** The RoP provide for the deemed date of service, where service has been effected in accordance with the RoP. This states that if service is effected by electronic communication, service shall be deemed to take place on the day when the relevant electronic communication was sent<sup>172</sup> and if service takes place by registered letter with acknowledgment of receipt (or equivalent), on the tenth day following posting – unless it in fact (i) fails to reach the addressee, (ii) reaches the addressee on a later date or (iii) the advice of delivery is not returned.<sup>173</sup> Unless the defendant is entitled to refuse service under art.12 Service Regulation<sup>174</sup> and notified the Registry within one week of this refusal, service is deemed effective even if acceptance of the letter is refused.<sup>175</sup>

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<sup>161</sup> art.11 Service Regulation.

<sup>162</sup> art.17 Service Regulation.

<sup>163</sup> art.20(1) Service Regulation.

<sup>164</sup> rr.271(4)(b) and 275 RoP.

<sup>165</sup> r.275(4) RoP.

<sup>166</sup> r.275(1) RoP.

<sup>167</sup> r.275(2) RoP.

<sup>168</sup> r.275(3) RoP.

<sup>169</sup> r.271(5) RoP.

<sup>170</sup> The inclusion of a temporary place of business was added in order to enable service at trade fairs.

<sup>171</sup> r.271(5)(b) RoP.

<sup>172</sup> r.271(6)(a) RoP.

<sup>173</sup> r.271(6)(b) RoP.

<sup>174</sup> See paragraph [11-97](#).

<sup>175</sup> rr.271(6)(b) and 271(7) RoP.

## *Translations of Documents for Service*

- 11-97** Proceedings before the Court may potentially take place in a large number of languages.<sup>176</sup> A defendant based in the EU is entitled to refuse to accept service under art.12 Service Regulation if the relevant document is not written in or accompanied by a translation into either:<sup>177</sup>
- A language which the addressee understands; or
  - The official language of the Member State addressed or, if there are several official languages in that Member State, one of the official languages.
- 11-98** A defendant shall be informed of these rights when the SoC is served.<sup>178</sup> Where a defendant is entitled to refuse service and has notified the refusal to the Registry within two weeks of the attempted service together with an indication of the language it understands, the Registry will inform the claimant who must then provide the Registry with the requisite translations of at least the SoC.<sup>179</sup> In this way, service can be remedied and the date of service of the SoC will be the date on which the appropriate translation is served.<sup>180</sup> However, where according to the law of a Member State a document has to be served within a particular period, the date to be taken into account with respect to the claimant will be the date of the service of the initial document, as determined by the law of that Member State.<sup>181</sup>

## *Service of a SoC outside the Contracting Member States*

- 11-99** Electronic communication is also the primary means of service outside the territory of the Contracting Member States.<sup>182</sup> It is only when the defendant has not provided an electronic address or cannot be served within the territory of the Contracting Member States that service under r.274 RoP is necessary.
- 11-100** According to r.274 RoP, service outside the Contracting Member States can be performed (provided that the manner of service is not contrary to the law of the state where the service is effected) by any method provided by:
- The Service Regulation (applicable to defendants domiciled in the EU);<sup>183</sup>
  - The Hague Service Convention;<sup>184</sup>
  - Any other applicable convention or agreement where it applies;
  - If no such convention or agreement applies, either through diplomatic or consular channels; or
  - Any method permitted by the law of the state where service is to be effected.
- 11-101** The usefulness of this provision outside the EU is likely to depend upon whether the competent authorities in the states where service is to be effected recognise the request coming from the Court under their respective national laws. The Court is a court common to the Contracting Member States<sup>185</sup> and, in relation to the matters set out in art.32(1) UPCA, jurisdiction of the

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<sup>176</sup> See paragraphs [11-107](#) to [11-133](#) for details on the language regime before the Court.

<sup>177</sup> arts 9 and 12 Service Regulation.

<sup>178</sup> r.271(7) RoP.

<sup>179</sup> r.271(8) RoP. The information must include that set out in r.13(1)(a) to (p) RoP as required by r.271(7) RoP.

<sup>180</sup> art.12(5) Service Regulation.

<sup>181</sup> arts 12(5) and 13 Service Regulation.

<sup>182</sup> rr.273 and 274 RoP.

<sup>183</sup> See paragraphs [11-90](#) to [11-98](#).

<sup>184</sup> Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters (concluded 15 November 1965), available at: <https://www.hcch.net/en/instruments/conventions/full-text/?cid=17> [Accessed 13 April 2023].

<sup>185</sup> art.1 para.2 UPCA and art.71a(1) Brussels I Regulation.

national courts has been transferred to the Court. Therefore, there is a reasonable presumption that, in relation to the 1965 Hague Service Convention (which many Contracting Member States have signed),<sup>186</sup> where the Court requests assistance in the service of documents, it should be recognised by the other signatories. Should these methods for serving the SoC prove unsuccessful, the RoP authorises the Court to permit service by alternative means as set out in r.275 RoP.<sup>187</sup>

## Service of Other Written Pleadings

**11-102** The Registry shall serve other pleadings on the other party by means of electronic communication as soon as practicable, unless the pleadings contain a request for an ex parte proceeding.<sup>188</sup> Where service by electronic communication cannot be performed, the secondary options are service by:<sup>189</sup>

- Registered letter with acknowledgment of receipt (or equivalent); or
- Any method authorised by the Court under r.275 RoP (service by an alternative method).<sup>190</sup>

**11-103** Alternatively, other pleadings may be served on a party's representative.<sup>191</sup> The rules on when service is deemed to have taken place applicable to a SoC also apply to other pleadings.<sup>192</sup>

## Service of Orders and Decisions

**11-104** The rules applying to service of the SoC also apply to the service of orders and decisions.<sup>193</sup>

**11-105** Decisions by default<sup>194</sup> resulting from failure of the defendant to lodge a defence to a statement of revocation or failure to lodge a defence to a statement for a DNI within the set time limit may be served on the defendant at the place of business of the professional representative or legal practitioner as defined by art.134 EPC who is recorded as the appointed representative in the register for the unitary patent protection at the EPO or in the national patent register.<sup>195</sup>

## Change of Electronic Address for Service

**11-106** Where a party changes its electronic address for service, that party must give notice in writing of the change as soon as it has taken place, both to the Registry and every other party.

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<sup>186</sup> A full list can be found here: <https://www.hcch.net/en/instruments/conventions/status-table/?cid=17> [Accessed 13 April 2023]

<sup>187</sup> See paragraph [11-94](#).

<sup>188</sup> r.278(1) RoP.

<sup>189</sup> r.278(2) RoP.

<sup>190</sup> See paragraph [11-94](#).

<sup>191</sup> r.278(5) RoP.

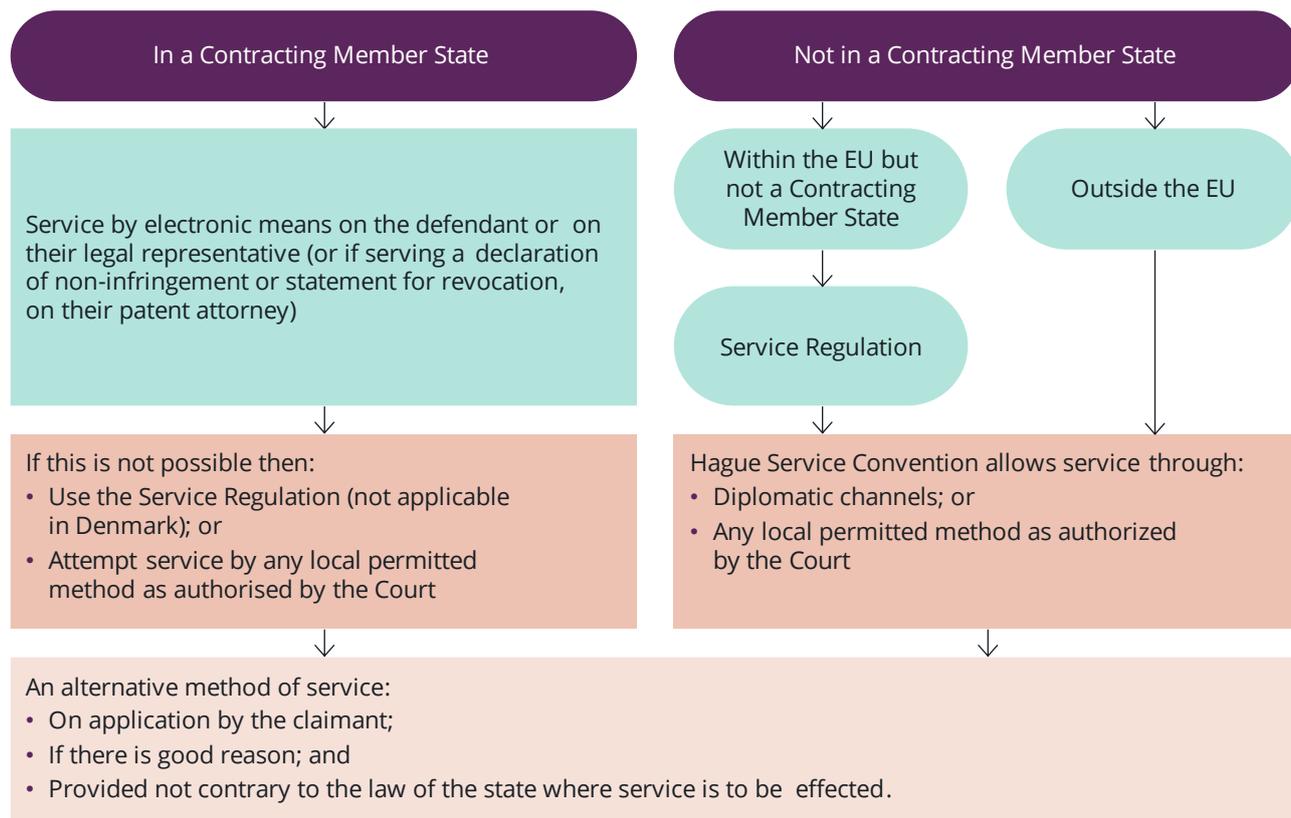
<sup>192</sup> r.278(4) RoP. See paragraph [11-96](#).

<sup>193</sup> r.276(1) RoP. See paragraphs [11-90](#) to [11-101](#).

<sup>194</sup> Pursuant to r.355 RoP. See paragraphs [11-141](#) to [11-152](#).

<sup>195</sup> r.276(2) RoP.

Figure 11-2: Service Options



## Language Regime, Translations and Interpretation

### Language of Proceedings in the Local and Regional Divisions

**11-107** The language of proceedings will be an official language of the Contracting Member State hosting the relevant division or an official language designated by the Contracting Member States sharing a regional division in which the action is commenced. In the event that a Contracting Member State setting up a local division has, or Contracting Member States sharing a regional division have, more than one official language, they may designate only one or several of those languages as the official language of the proceedings.<sup>196</sup> In addition to or instead of their official languages, Contracting Member States may designate one or more official EPO languages (French, German or English) as the language of proceedings of their local or regional division.<sup>197</sup>

**11-108** For example, Belgium has three official national languages (Dutch, French and German) and has designated all three languages as languages of proceedings in its local division in Brussels, together with English (as an additional EPO language). Proceedings in the local division in Brussels may therefore be conducted in one of these four languages. Finland has also designated both its official languages (Finnish and Swedish) and an additional EPO language (English) as the languages of proceedings in its local division in Helsinki. The Nordic-Baltic division (Sweden, Estonia, Latvia, and Lithuania) has chosen not to designate any of their official languages as languages of proceedings in their regional division which is to be set up in Stockholm. Proceedings in the Nordic-Baltic division will be conducted solely in English. Table 11-1 sets out the languages used by each division of the Court of First Instance. At the time of

<sup>196</sup> art.49(1) UPCA.

<sup>197</sup> art.49(2) UPCA.

writing, Germany, Italy and France are yet to nominate any language other than their official language.

**Table 11-1: Languages of Proceedings at the Court of First Instance**

Contracting Member State	Division	Languages
Austria	Vienna	German and English
Belgium	Brussels	Dutch, French, English* and German
Bulgaria	Central	English, French, German
Denmark	Copenhagen	Danish and English
Estonia	NORDIC-BALTIC	English
Finland	Helsinki	Finnish, Swedish and English
France	Paris	Central division: English, French, German Local division: French, English*
Germany	Düsseldorf, Mannheim, Hamburg and Munich	Central division in Munich: English, French, German Local divisions: German, English*
Italy	Milan	Italian
Latvia	NORDIC-BALTIC	English
Lithuania	NORDIC-BALTIC	English
Luxembourg	Central	English, French, German
Malta	Central	English, French, German
Netherlands	The Hague	English and Dutch
Portugal	Lisbon	Portuguese and English
Slovenia	Ljubljana	Slovenian and English
Sweden	NORDIC-BALTIC	English

\*Adopting the English limited rule see paragraphs [11-116](#) to [11-118](#).

**11-109** In general, the claimant may choose the language of the proceedings from the languages provided for litigation by the local or regional division addressed. The claimant's choice of language of proceedings is indicated simply by using the language in the SoC, or other document by which litigation before the Court is initiated.

**11-110** All written pleadings and other documents (including written evidence) must be lodged in the language of the proceedings unless otherwise provided by the Court or RoP.<sup>198</sup> Where a local or regional division has designated more than one language as the languages of proceedings, the language to be used in proceedings will be decided by the claimant subject to the small local operator rule<sup>199</sup> and the use, in certain circumstances, of the language of the patent.<sup>200</sup> The defendant can file a preliminary objection based on the SoC not being in the required language,<sup>201</sup> but otherwise has no choice as to language unless it can be agreed with the claimant.<sup>202</sup> The Registrar will maintain a list of designated languages and the rules applying in each division.<sup>203</sup> The list will be made publicly available online. Pleadings lodged in the wrong language will be returned by the Registrar.<sup>204</sup>

**11-111** The privilege of the claimant to choose the language is limited by the following rules.

### *Small Local Operator Rule*

**11-112** R.14(2)(b) RoP is intended to protect small locally operating defendants. If a defendant is sued in its home division and the case could not be brought before any other local or regional division (i.e. infringement is limited to that division under art.33(1)(a) UPCA),<sup>205</sup> the proceedings must be conducted in the official language of the Contracting Member State.

**11-113** In circumstances where a Contracting Member State has designated several official regional languages, the proceedings shall be conducted in the official language of the region in which the defendant has its domicile or principal place of business. Where there are two or more such defendants whose domicile or principal places of business have different regional languages, the claimant may choose the language from the regional languages in question. Similarly, where a Contracting Member State has several official languages (for the whole state) and its designation so indicates, proceedings shall be conducted in the defendant's official language, and where there is more than one language, the choice devolves to the claimant.

**11-114** It should be noted that the small local operator rule does not take into account situations where, like in the Nordic-Baltic division, Contracting Member States have designated only one of the EPO languages, English, as the language of proceedings.

**11-115** In addition, the protection of a small operator does not apply if the infringement extends beyond the geographical territory covered by the defendant's home division. In such case, the defendant may be sued in any of the languages designated by the division where proceedings are initiated.

### *English Limited Rule*

**11-116** A further limitation is the "English limited" rule adopted by the local divisions in Belgium, Germany and France.<sup>206</sup> This provides that a local or regional division may adopt a rule indicating to what extent the judges may use the official national language instead of English in

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<sup>198</sup> r.7(1) RoP. For example, r.13(1)(q) RoP provides that a claimant may make a request that all or part of the documents referred to in the SoC need not be translated.

<sup>199</sup> See paragraphs [11-112](#) to [11-115](#).

<sup>200</sup> See paragraph [11-122](#).

<sup>201</sup> See chapter 12 (Written Procedure) paragraphs 12-04 to 12-28 for the procedure for a preliminary objection.

<sup>202</sup> art.49(3) UPCA. See paragraphs [11-123](#) to [11-125](#).

<sup>203</sup> r.14(3) RoP.

<sup>204</sup> r.14(4) RoP. This rule was criticized at the Trier oral hearing. It was argued by Pierre Véron from the Expert Group that the decision as regards "death and life" of a pleading should be the decision of a judge.

<sup>205</sup> Under art.33(1)(a) UPCA, infringement proceedings and counterclaims for revocation (amongst other things) are brought before the local division hosted by the Contracting Member State where the actual or threatened infringement has occurred, or may occur, or the regional division in which that Contracting Member State participates.

<sup>206</sup> r.14(2)(c) RoP.

the proceedings.<sup>207</sup> The aim of the provision is to assist the judges. The judge-rapporteur may order, in the interest of the judges, that the designated official national language is used in oral proceedings and/or to provide that the Court may make any order and deliver any decision in the official national language designated as a language of the proceedings.

**11-117** Where the English limited rule is applied, each order and decision should be accompanied with a certified translation into English for the purpose of enforcement.

**11-118** The purpose of the English limited rule has been to make it easier for the divisions to designate English as a language of proceedings in addition to their official national language. It remains to be seen whether the rule will be a temporary solution only to be abandoned later.

## Language of Proceedings in the Central Division

**11-119** At the central division, the language of proceedings will be the language of the patent.<sup>208</sup> This means that the language of proceedings will be English, French or German in accordance with the language of the patent regardless of whether the proceedings take place in Paris or Munich. It follows that the statement for revocation has to be in the language of the patent<sup>209</sup> as does the statement for a DNI<sup>210</sup> if filed in the central division.

**11-120** Where the counterclaim for revocation is referred to the central division and the language of the proceedings before the referring local or regional division is not the language of the patent, the judge-rapporteur may order the parties to lodge, within a period of one month, a translation in the language of the patent of any written pleadings and such documents lodged during the written procedure as directed by the judge-rapporteur.<sup>211</sup> The judge-rapporteur may, where appropriate, also specify that only excerpts of parties' written pleadings and other documents are to be translated.<sup>212</sup>

**11-121** If an infringement action is brought in the central division, a defendant having its residence, principal place of business or place of business in a Member State may, under certain circumstances, have the right to obtain a translation of relevant documents into the language of the Member State of residence, principal place of business or, in the absence of either, place of business with such translation costs being covered by the claimant.<sup>213</sup> Those circumstances are:<sup>214</sup>

- Where the defendant has its residence, principal place of business or place of business outside the territory of the Contracting Member States (although within the EU);<sup>215</sup>
- Where the Contracting Member State in which the infringement took place or the defendant has its residence, principal place of business or place of business does not host a local division or participate in a regional division;<sup>216</sup>
- The language of the proceedings is not an official language of the Member State where the defendant has its residence, principal place of business or place of business; and

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<sup>207</sup> r.14(1)(c) RoP refers to art.49(3) UPCA which in turn refers to the official languages of the EPO. In practice, of the three languages, only English has been designated as a language of the proceedings under this provision. Hence, the name "English limited rule" has been applied.

<sup>208</sup> art.49(6) UPCA.

<sup>209</sup> r.45(1) RoP.

<sup>210</sup> r.64 RoP.

<sup>211</sup> r.39(1) RoP.

<sup>212</sup> r.39(2) RoP.

<sup>213</sup> See the FAQ on the Court's website available at: <https://www.unified-patent-court.org/faq/languages-0> [Accessed 13 April 2023].

<sup>214</sup> art.51(3) UPCA.

<sup>215</sup> art.33(1) para.3 UPCA.

<sup>216</sup> art.33(1) para.4 UPCA.

- The defendant does not have proper knowledge of the language of the proceedings.

## Using the Language of the Patent

**11-122** As noted above, proceedings in the central division are always in the language of the patent. However, under certain conditions, the language in which the patent was granted may also be used as the language of proceedings before the local or regional division, even if that language is not a designated language of the division.

### *Agreement Between the Parties*

**11-123** The parties may agree on the use of the language of the patent.<sup>217</sup> This is, however, subject to approval by the panel. An application has to be lodged by the parties and will be decided by the panel as soon as practicable.<sup>218</sup>

**11-124** The application to use the language of the patent may be made at any time during the written procedure.<sup>219</sup> However, the application must specify whether existing pleadings and other documents should be translated and at whose cost. If the parties cannot agree such details, the judge-rapporteur or the President of the Court of First Instance, as the case may be, will decide the issue.<sup>220</sup>

**11-125** If the panel does not approve the application, the parties may request that the case be referred to the central division.<sup>221</sup>

### *Of the Court's Own Motion*

**11-126** The judge-rapporteur may propose using the language of the patent at any time during the written procedure and the interim procedure, either of his or her own motion or at the request of a party. The change of the language of the proceedings is subject to agreement by the parties and the panel. The panel will make its decision on the grounds of convenience and fairness.<sup>222</sup>

### *At the Request of a Party*

**11-127** One of the parties may make an application to use the language of the patent as the language of proceedings. Such an application is to be included in the SoC or in the SoD. After having heard the other parties and the panel, the decision on the language is made by the President of the Court of First Instance on grounds of fairness and taking into account all relevant circumstances, in particular the position of the defendant. The President may make the order conditional on specific arrangements for translations and interpretation.<sup>223</sup>

**11-128** When the language of the proceedings is changed in the course of the proceedings by the application of one or both of the parties, it should be specified in the application whether existing pleadings and other documents should be translated and at whose cost. If the parties cannot agree, the judge-rapporteur will decide the issue having consulted the panel.<sup>224</sup>

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<sup>217</sup> art.49(3) UPCA.

<sup>218</sup> r.321 RoP.

<sup>219</sup> r.321(1) RoP.

<sup>220</sup> r.324 RoP.

<sup>221</sup> art.49(3) UPCA.

<sup>222</sup> art.49(4) UPCA and r.322 RoP.

<sup>223</sup> art.49(5) UPCA and r.323 RoP.

<sup>224</sup> r.324 RoP.

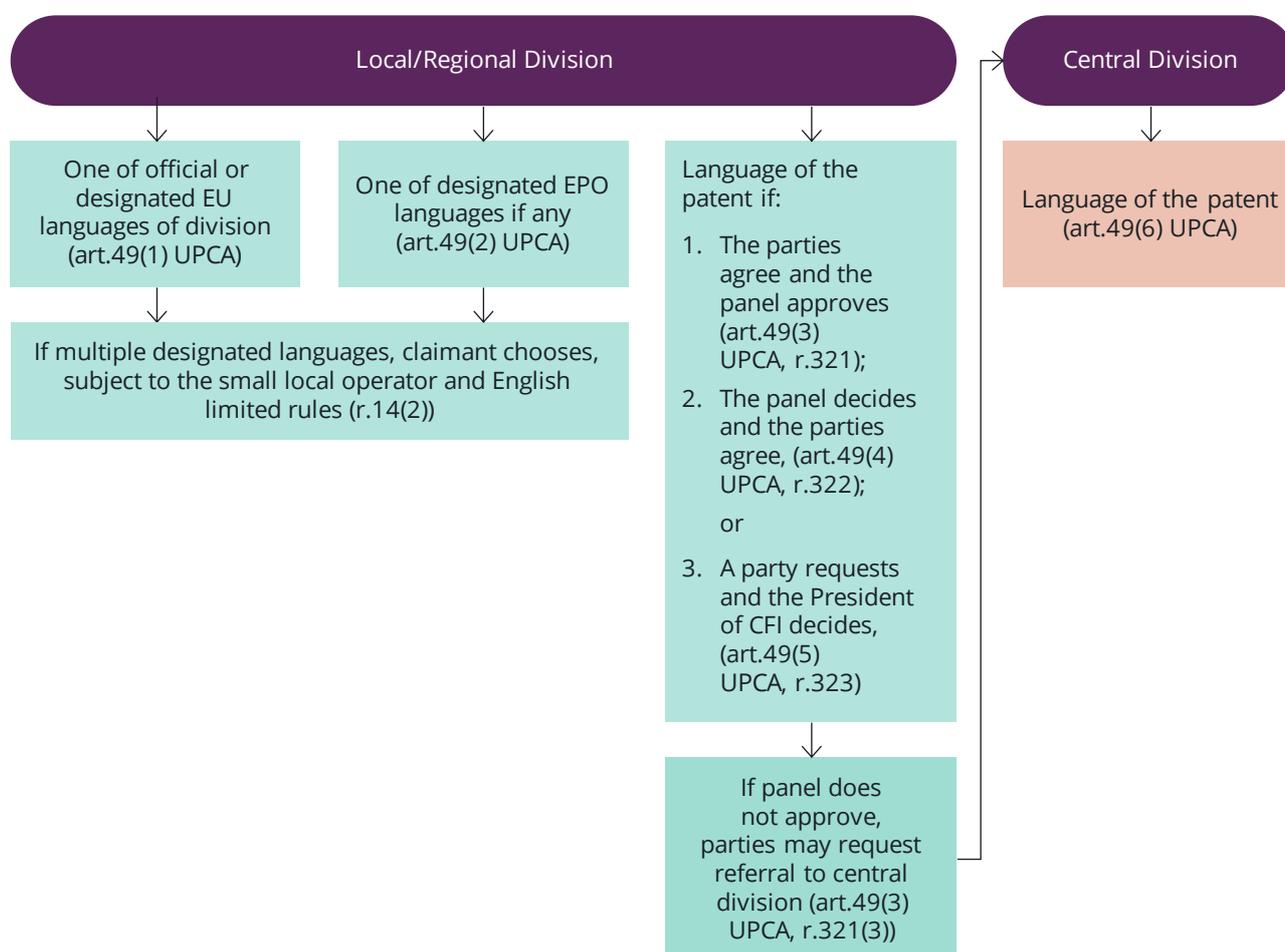
## Applications to Amend a Patent

**11-129** Where a defence to a counterclaim for revocation includes an application to amend the patent, the proposed amendments (claims and/or specification and auxiliary requests) must be in the language of the patent as granted. Where the language of the proceedings is different from the patent as granted, the proprietor must lodge a translation of the proposed amendments into the language of the proceedings. In addition, and if requested by the defendant, where the patent is a Unitary patent, a translation must also be lodged in the language of the defendant's domicile (if in a Member State) or of the place of the alleged infringement or threatened infringement in a Contracting Member State.<sup>225</sup>

## Protective Letters

**11-130** Protective letters are filed with the registry in the language of the patent.<sup>226</sup>

**Figure 11-3: The Language of Proceedings at the Court of First Instance**



<sup>225</sup> r.30(1)(a) RoP.

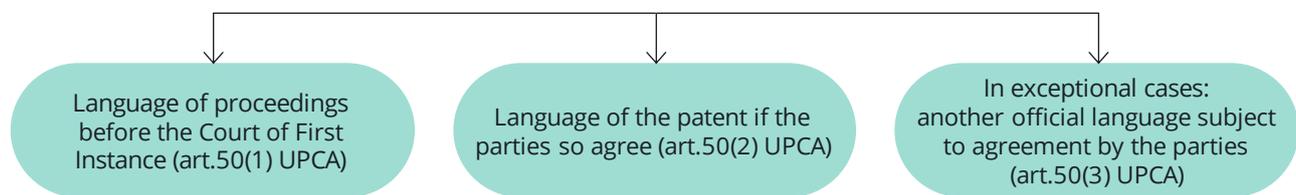
<sup>226</sup> r.207(2)

## Language of Proceedings at the Court of Appeal

**11-131** At the Court of Appeal, the language of proceedings will be the language of proceedings before the Court of First Instance<sup>227</sup> or, if the parties so agree, the language of the patent.<sup>228</sup> Evidence of the respondent's agreement on using the language of the patent should be lodged by the appellant together with the statement of appeal.<sup>229</sup> The panel cannot refuse to use the language of the patent. In exceptional cases, it is possible for the Court of Appeal to decide on another language of a Contracting Member State as the language of proceedings. This is, however, subject to agreement by the parties.<sup>230</sup>

**11-132** Given the potential opportunities to select a language at first instance, on the face of it, there would seem to be few occasions in practice where the language of the proceedings is likely to change on appeal. One possible example may be where the parties wished to use the language in which the patent was granted but the judicial panel of the local division of the Court of First Instance in which the proceedings were first heard did not agree and the parties had not requested that the proceedings be transferred to the central division.<sup>231</sup>

### Figure 11-4: Language of Proceedings at the Court of Appeal



**11-133** If the language of the proceedings before the Court of Appeal is other than the language of the proceedings before the Court of First Instance, the judge-rapporteur may order the appellant to lodge translations of documents into the language of the proceedings before the Court of Appeal. These documents may include written pleadings and other documents, as specified by the judge-rapporteur, and decisions or orders of the Court of First Instance. The appeal will be rejected by the judge-rapporteur by a decision by default if the respondent fails to lodge said translations within the time period specified.<sup>232</sup>

## Translations of Documents

**11-134** In principle, all documents need to be translated into the language of proceedings. This follows from r.7(1) RoP which states that written pleadings and other documents are to be lodged in the language of the proceedings unless otherwise provided. The costs of translation are to be borne by the party submitting the document. A formal certification by the translator as to the accuracy of such translation is not necessary unless the accuracy is challenged by a party or such certification is ordered by the Court or required by the RoP.<sup>233</sup> However, the UPCA provides that any panel of the Court of First Instance and the Court of Appeal may, to the extent deemed appropriate, dispense with translation requirements.<sup>234</sup> Exactly how much flexibility will be granted by the Court is yet to be established.

<sup>227</sup> art.50(1) UPCA and r.227(1)(a) RoP.

<sup>228</sup> art.50(2) UPCA.

<sup>229</sup> r.227(1)(b) RoP.

<sup>230</sup> art.50(3) UPCA.

<sup>231</sup> art.49(3) UPCA.

<sup>232</sup> r.232 RoP.

<sup>233</sup> r.7(2) RoP.

<sup>234</sup> art.51(1) UPCA.

**11-135** The claimant may in the SoC request that some or all of the documents listed in the SoC, including any witness statements referred to, need not be translated.<sup>235</sup> The judge-rapporteur will decide the issue as soon as practicable after their designation.<sup>236</sup> Similar provisions relate to the documents listed in the SoD<sup>237</sup> and in other pleadings.<sup>238</sup> In addition to these provisions, other rules deal with translations of specific documents and in specific circumstances.<sup>239</sup>

## Interim Hearings

**11-136** The judge-rapporteur may hold the interim conference in any language agreed by the parties' representatives.<sup>240</sup>

## Interpretation at Oral Hearings

**11-137** At least one month before the oral hearing, including any separate hearing of witnesses and experts, a party may lodge a request for simultaneous interpretation. The request must contain:<sup>241</sup>

- An indication of the language to or from which the party requests simultaneous interpretation during the oral hearing;
- Reasons for the request;
- The field of technology concerned; and
- Any other information of relevance to the request.

**11-138** Following the request, the judge-rapporteur will decide whether and to what extent simultaneous interpretation is appropriate and will instruct the Registry to make the necessary arrangements.<sup>242</sup> In the event that the judge-rapporteur refuses to order simultaneous interpretation, the parties may request arrangements to be made, so far as practically possible, for simultaneous interpretation at their cost.<sup>243</sup> The judge-rapporteur is also free to decide on his or her own motion to order simultaneous interpretation and will instruct the Registry and inform the parties accordingly.<sup>244</sup>

**11-139** A party wishing to engage an interpreter at its own expense must inform the Registry two weeks before the oral hearing at the latest.<sup>245</sup>

**11-140** A witness may give evidence in any language and is not restricted to the language of the proceedings, provided the consent of the Court has been obtained.<sup>246</sup>

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<sup>235</sup> r.13(1)(q) RoP.

<sup>236</sup> r.13(3) RoP.

<sup>237</sup> r.24(j) RoP.

<sup>238</sup> r.29A(g) RoP.

<sup>239</sup> For example, the rules on translations of documents when an infringement action is brought in the central division (art.51(3) UPCA). See paragraph [11-121](#).

<sup>240</sup> r.105(3) RoP.

<sup>241</sup> r.109(1) RoP.

<sup>242</sup> r.109(2) RoP.

<sup>243</sup> r.109(2) RoP.

<sup>244</sup> r.109(3) RoP.

<sup>245</sup> r.109(4) RoP.

<sup>246</sup> r.112(5) RoP.

# Time Periods and Decisions by Default

## Calculating Time Periods

**11-141** Time periods prescribed by the UPCA, the UPCA Statute and the RoP are calculated according to r.300(a) to (h) RoP. It is vitally important that the parties are aware of the relevant deadlines in the proceedings and comply with them in order to avoid a decision in default.<sup>247</sup> The rules are computed as follows:

- Computation starts on the day following the day on which the relevant event occurred. In the case of service of a document, the relevant event will be the receipt of that document.
- When a period is expressed as one year or a certain number of years, it will expire in the relevant subsequent year in the same month and on the same day as the month and day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period will expire on the last day of that month.
- When a period is expressed as one month or a certain number of months, it will expire in the relevant subsequent month on the same day as the day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period will expire on the last day of that month.
- When a period is expressed as one week or a certain number of weeks, it will expire in the relevant subsequent week on the same day as the day on which the said event occurred.
- Day shall mean a calendar day unless expressed as a working day.
- Calendar days include official holidays of the Contracting Member State in which the division or the seat of the central division or its section concerned or the Court of Appeal is located, including Saturdays and Sundays.
- Working days shall not include Saturdays, Sundays and official holidays of the Contracting Member State in which the division or seat of the central division or its section concerned or the Court of Appeal is located.
- Periods shall not be suspended during judicial vacations.

**11-142** Where a period expires on a Saturday, Sunday or official holiday of the Contracting Member State in which the division or the seat of the central division or its section concerned or the Court of Appeal is located, it shall be extended until the end of the first following working day.<sup>248</sup> This automatic extension also applies if documents filed in electronic form cannot be received by the Court.<sup>249</sup>

**11-143** As a worked example: the SoC for an infringement action is served (i.e. received by the Defendant)<sup>250</sup> on Friday 9 June 2023. The Defendant has one month<sup>251</sup> to lodge a preliminary objection, if it wishes to do so. Computation of this time period starts on the day following the day on which the relevant event occurred.<sup>252</sup> “Day” means calendar day unless expressed as a working day,<sup>253</sup> therefore computation of this time period starts on Saturday 10 June 2023. As the period is one month, it expires in the subsequent month, i.e. July, on the same day as the day on which the event occurred. Therefore it expires on Monday 10 July 2023. The Defendant

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<sup>247</sup> See paragraphs [11-144](#) to [11-151](#).

<sup>248</sup> r.301(1) RoP.

<sup>249</sup> r.301(2) RoP.

<sup>250</sup> r.300(a) RoP and Part 5 Chapter 2 RoP.

<sup>251</sup> r.19(1) RoP.

<sup>252</sup> r.300(a) RoP.

<sup>253</sup> r.300(e) RoP.

also has three months to lodge its SoD<sup>254</sup> and the same period to lodge a counterclaim for revocation, if it wishes to do so<sup>255</sup> (both irrespective of whether a preliminary objection is lodged unless the judge-rapporteur decides otherwise).<sup>256</sup> The computation of this time period starts on the same date, i.e. Saturday 10 June 2023, and expires on Sunday 10 September 2023. The period is not suspended during the judicial vacation.<sup>257</sup> As the period expires on a Sunday, it is automatically extended to Monday 11 September 2023, or if that is not a working day in the relevant Contracting Member State, the next working day in that Contracting Member State.<sup>258</sup>

## Decisions by Default

### *Court of First Instance*

**11-144** Upon request, a decision by default may be given against a party where the RoP so provide if a party fails to take a step within the time limit foreseen by the RoP or by the Court.<sup>259</sup> The wording appears to limit decisions being made by default to those circumstances where the RoP so provide. For example:

- Where a claimant fails to comply with a request made by the Registry to correct the deficiencies in its SoC;<sup>260</sup>
- Where a defendant fails to comply with a request made by the Registry to correct the deficiencies in its SoD;<sup>261</sup>
- Where a party fails to provide security for costs when ordered to do so;<sup>262</sup> or
- Where an order, for example to produce evidence, is made against a party by the judge-rapporteur during the interim procedure.<sup>263</sup>

**11-145** Further, although the RoP do not specify that a decision can be given where a party fails to file a defence, the UPCA Statute<sup>264</sup> contains such a provision and r.355(3) RoP states that a decision by default against a defendant of the claim or counterclaim may only be given where the time limits for the defence to the claim or counterclaim have expired. Further, the judge-rapporteur is given such a wide discretion under r.103 RoP (see last bullet point in paragraph [11-144](#) above) that it could be used to cover a wide number of instances where a party fails to comply with an order of the Court.

**11-146** A decision by default may not be entered unless the Court is satisfied that either:<sup>265</sup>

- The SoC was served by a method prescribed by the internal law of the state addressed for the service of documents in domestic actions upon persons who are within its territory; or
- The SoC was actually served on the defendant in accordance with the RoP.<sup>266</sup>

**11-147** Furthermore, the facts put forward by the claimant must justify the remedy sought.<sup>267</sup>

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<sup>254</sup> r.23 RoP.

<sup>255</sup> r.25 RoP.

<sup>256</sup> r.19(6) RoP.

<sup>257</sup> r.300(h) RoP.

<sup>258</sup> r.301(1) RoP.

<sup>259</sup> r.355(1)(a) RoP.

<sup>260</sup> rr.16(4) and (5) RoP.

<sup>261</sup> rr.27(3) and (4) RoP.

<sup>262</sup> rr.158(4) and (5) RoP.

<sup>263</sup> rr.103(1) and (2) RoP.

<sup>264</sup> art.37(1) UPCA Statute. The terms of the UPCA and the UPCA Statute prevail where there is a conflict with the RoP (r.1(1) RoP).

<sup>265</sup> r.277 RoP.

<sup>266</sup> Specifically part 5, chapter 2. See paragraphs [11-90](#) to [11-101](#).

<sup>267</sup> r.355(2) RoP.

**11-148** A decision by default is in principle enforceable immediately, but the Court may grant a stay of the enforcement until it has considered and given its decision on any application to set aside a decision by default or make enforcement subject to the provision of security (the security being released if there is no application against the decision by default or if such application fails).<sup>268</sup>

**11-149** Any application to set aside a decision by default must be lodged within one month of the service of the decision.<sup>269</sup> The application must contain the party's explanation for the default. It must also mention the date and number of the decision by default and must be accompanied by the prescribed fee.<sup>270</sup> Where the decision by default relates to a party failing to take a step within the time limit foreseen by the RoP or by the Court, the application must be accompanied by the step the party failed to take.<sup>271</sup>

**11-150** The application will be allowed if these criteria are met unless a party has been put on notice in an earlier decision that a further decision by default is final. If the application is allowed, a note of allowance must be included in any publication of the decision by default.<sup>272</sup>

### *Court of Appeal*

**11-151** The procedure set out above also applies mutatis mutandis in the Court of Appeal. In particular, where a respondent on whom a statement of appeal and a statement of grounds of appeal have been duly served fails to lodge a statement of response or where a party fails to file a reply to a statement of cross-appeal or translations ordered by the judge-rapporteur, the Court of Appeal can make a decision by default.<sup>273</sup> When considering whether to give a decision by default, the Court of Appeal may consider the merits of the appeal.<sup>274</sup>

### **Re-establishment of Rights**

**11-152** If a party has failed to observe a time limit set out in the RoP or by the Court where the cause was outside the control of that party despite taking all due care and the non-observance has had the direct consequence of causing that party to lose a right or means of redress, the relevant panel of the Court may re-establish the right or means of redress following a request from that party.<sup>275</sup>

**11-153** The application for re-establishment of rights must be lodged (subject to the payment of a fee) with the Registry within one month of the removal of the cause for non-observance of the time limit and within six months of the non-observed time limit in any event.<sup>276</sup> The application must:<sup>277</sup>

- State the grounds on which it is based and set out the facts on which the relevant party relies; and
- Contain the evidence relied on in the form of affidavits from all people involved in the non-observance of the time limit and the people involved in establishing the precautionary measures of due care taken in order to avoid such cases of non-compliance.

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<sup>268</sup> r.355(4) RoP.

<sup>269</sup> r.356(1) RoP.

<sup>270</sup> rr.356(2) and 370 RoP. The fee prescribed under the Table of Court Fees of 8 July 2023 is €1,000.

<sup>271</sup> r.356(2) RoP.

<sup>272</sup> r.356(3) RoP.

<sup>273</sup> r.357(1) RoP. Similarly, where an applicant fails to comply with the formalities examined by the Registry following the lodging of the statement of appeal (rr.229(3) and (4) RoP).

<sup>274</sup> r.357(2) RoP.

<sup>275</sup> r.320(1) RoP.

<sup>276</sup> r.320(2) RoP.

<sup>277</sup> r.320(3) RoP.

**11-154** The omitted act must be performed or completed together with the application for re-establishment within the time limits set out above.<sup>278</sup> Where the applicant fails to meet these time limits, there shall be no grant of re-establishment of rights.<sup>279</sup>

**11-155** An application for re-establishment of rights is decided by way of an order from the Court, but the other parties to the proceedings will have an opportunity to be heard beforehand.<sup>280</sup> There is no right to appeal from an order rejecting such an application or from an order granting re-establishment of rights.<sup>281</sup>

## Other Reasons for Terminating Proceedings Without a Hearing

### Withdrawing a Case

**11-156** The claimant may apply to withdraw its action at any time provided there is no final decision in the action.<sup>282</sup> The Court will decide the application after hearing the other party before making a decision. The application to withdraw will not be permitted if the other party has a legitimate interest in the action being decided by the Court.<sup>283</sup>

**11-157** In the event that withdrawal is permitted, the Court must:<sup>284</sup>

- Give a decision declaring the proceedings closed;
- Order the decision to be entered on the register; and
- Issue a costs decision.

**11-158** The withdrawal of the action by the claimant does not affect any counterclaim in the action. However, the Court may refer any counterclaim for revocation to the central division of the Court.<sup>285</sup>

## Actions Bound to Fail or Manifestly Inadmissible

### *No Need to Adjudicate*

**11-159** If the Court finds that an action has become devoid of purpose and there is no longer any reason to adjudicate on it, it may at any time dispose of the action by way of an order on the application of a party or by its own motion after giving the parties an opportunity to be heard.<sup>286</sup> This is essentially equivalent to art.113 Rules of Procedure of the General Court of the EU.<sup>287</sup>

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<sup>278</sup> r.320(4) RoP.

<sup>279</sup> r.320(5), RoP.

<sup>280</sup> r.320(6) RoP.

<sup>281</sup> r.320(7) RoP.

<sup>282</sup> r.265(1) RoP.

<sup>283</sup> r.265(1) RoP.

<sup>284</sup> r.265(2) RoP.

<sup>285</sup> r.265(2) RoP.

<sup>286</sup> r.360 RoP.

<sup>287</sup> Rules of Procedure of the General Court (OJ No. L 105, 23.4.2015, p.1 to 66.) available at [http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32015Q0423\(01\)&from=EN](http://eur-lex.europa.eu/legal-content/EN/TXT/PDF/?uri=CELEX:32015Q0423(01)&from=EN) [Accessed 5 April 2023]. These have been amended in 2023 – see [https://eur-lex.europa.eu/legal-content/en/TXT/PDF/?uri=CELEX:32023Q0214\(01\)](https://eur-lex.europa.eu/legal-content/en/TXT/PDF/?uri=CELEX:32023Q0214(01)) although no change has been made to art 113 [Accessed 5 April 2023].

## *No Jurisdiction or Action Manifestly Bound to Fail*

**11-160** Where it is clear that the Court has no jurisdiction to adjudicate on an action or of certain claims within it or where the action or defence is, in whole or part, manifestly inadmissible or manifestly lacking any foundation in law, the Court may, after giving the parties an opportunity to be heard, give a decision by way of an order.<sup>288</sup>

## *Absolute Bar to Proceedings in an Action*

**11-161** The Court may at any time, on the application of a party or of its own motion, decide that there is an absolute bar to proceeding with an action after giving the parties an opportunity to be heard, for example, because of the application of the principle of *res judicata*.<sup>289</sup>

**11-162** Orders in respect of these categories are made by the panel on the recommendation of the judge-rapporteur. Where the decision is taken by the Court of First Instance, it may be appealed.

## Stay of Proceedings

**11-163** Generally speaking, the regime in the UPCA and RoP sets out an aggressive timeframe for dealing with patent cases. That being said, the RoP provide for a number of opportunities to order a stay of proceedings. These grounds are bundled together into r.295(a) to (l) RoP which provides that the Court may stay proceedings in the following circumstances:

- Where the Court is seized of an action and the patent in suit has been challenged in opposition or limitation proceedings (including subsequent appeal proceedings) before the EPO or a national authority, and a decision is expected rapidly;<sup>290</sup>
- Where the Court is seized of an action relating to an SPC which is also the subject of proceedings before a national court or authority;<sup>291</sup>
- Where an appeal is brought before the Court of Appeal against a decision or order of the Court of First Instance (i) disposing of the substantive issues in part only; or (ii) disposing of an admissibility issue or a preliminary objection;<sup>292</sup>
- At the joint request of the parties;<sup>293</sup>
- Where, in an infringement action, a defendant counterclaims for revocation and the panel of the local or regional division decides to bifurcate the proceedings, referring the revocation action to the central division;<sup>294</sup>
- Where a revocation action or DNI action before the central division is followed by an infringement action;<sup>295</sup>

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<sup>288</sup> r.361 RoP.

<sup>289</sup> r.362 RoP.

<sup>290</sup> r.295(a) RoP. For a discussion of stays of proceedings pending oppositions at the EPO, see paragraphs [11-163](#) to [11-165](#).

<sup>291</sup> r.295(b) RoP.

<sup>292</sup> r.295(c) RoP. This rule is couched in different terms to r.223 RoP relating to applications for suspensive effect. Despite this, it would appear sensible to follow the procedure set out in r.223 RoP. See chapter 21 (Procedure before the Court of Appeal) paragraphs 21-21 to 21-31.

<sup>293</sup> r.295(d) RoP.

<sup>294</sup> r.295(e) RoP referring to r.37 RoP which sets out the procedure to be applied with respect to art.33(3) UPCA. See chapter 6 (Jurisdiction, Competence and Forum Shopping) paragraphs 6-85 to 6-90.

<sup>295</sup> r.295(f) RoP refers to rr.75 and 76 RoP which set out the procedures to follow under arts 33(5) and (6) UPCA respectively. See chapter 6 (Jurisdiction, Competence and Forum Shopping) paragraphs 6-91 and 6-94.

- Following oral proceedings in an infringement action where there is either an opposition before the EPO or a revocation action before the central division;<sup>296</sup>
- Where, pending any appeal on the merits, an application for a determination of damages has been made;<sup>297</sup>
- Where a preliminary reference is made to the CJEU;<sup>298</sup>
- If a party dies or ceases to exist during proceedings;<sup>299</sup>
- In case of insolvency of a party to the proceedings;<sup>300</sup>
- If a part objects to a judge taking part in the proceedings in accordance with art.7 UPCA Statute;<sup>301</sup>
- To give effect to EU law, in particular the provisions of the Brussel I Regulation and the Lugano Convention;<sup>302</sup> and
- In any other case where the proper administration of justice so requires.<sup>303</sup> This is a catch-all ground and would appear to include the granting of stays to facilitate settlement.<sup>304</sup>

**11-164** If proceedings before the Court are stayed, the stay shall take effect on the date indicated in the order to stay or, in the absence of such an indication, on the date of that order. The Court shall stipulate what effect the stay will have on any existing orders.<sup>305</sup> Where the order to stay does not fix the length of the stay, it shall end on the date indicated in the order to resume proceedings or, in the absence of such indication, on the date of any order to resume proceedings.<sup>306</sup> Any decision ordering such a resumption of proceedings before the end of the stay is made by order of the judge-rapporteur after hearing the parties.<sup>307</sup> The judge-rapporteur may refer the matter to the panel.

**11-165** While proceedings are stayed, time ceases to run for the purposes of procedural periods.<sup>308</sup> Time begins to run afresh from the date on which the stay is lifted.

## Stays Pending Opposition and Limitation Proceedings before the EPO

**11-166** There will, inevitably, be cases arising where, during the pendency of opposition or limitation proceedings before the EPO, proceedings either for infringement (including counterclaims for revocation) or revocation actions are commenced before the Court.<sup>309</sup> A party is obliged to inform the Court of any such proceedings before the EPO, and of any request for accelerated processing before the EPO. The reason for this is that the Court may stay its proceedings awaiting the outcome of EPO opposition proceedings when a rapid decision from the EPO can be expected.<sup>310</sup> This principle is set out further in r.295 RoP, which contains two subsections dedicated to the relationship between Court and EPO proceedings. Firstly, r.295(a) RoP, which

<sup>296</sup> r.295(g) RoP referring to r.118 RoP. For stays pending proceedings before the EPO see paragraphs [11-166](#) to [11-168](#).

<sup>297</sup> r.295(h) referring to r.136 RoP. See chapter 15 (Remedies) paragraphs 15-60 and 15-61.

<sup>298</sup> r.295(i) referring to rr.266(1) and (5) RoP. See chapter 14 (Oral Procedure) paragraphs 14-43.

<sup>299</sup> r.295(j) referring to r.310 RoP. See paragraphs [11-63](#) to [11-65](#).

<sup>300</sup> r.295(j) referring to rr.311(1) and (2) RoP. See paragraphs [11-66](#) to [11-69](#).

<sup>301</sup> r.295(k) referring to r.346 RoP.

<sup>302</sup> r.295(l) RoP. For example in situations where there is *lis pendens* or there are related actions.

<sup>303</sup> r.295(m) RoP.

<sup>304</sup> r.11 RoP.

<sup>305</sup> r.296(1) RoP.

<sup>306</sup> r.296(2) RoP.

<sup>307</sup> r.297 RoP.

<sup>308</sup> r.296(3) RoP.

<sup>309</sup> Unlike in some Contracting Member States, such as Germany, the outcome of EPO proceedings does not have to be awaited before commencing revocation proceedings before the Court.

<sup>310</sup> art.33(10) UPCA.

states that the Court may stay proceedings where it is seized of an action relating to a patent which is also the subject of opposition or limitation proceedings including subsequent appeal proceedings before the EPO (or a national authority), where a decision in such proceedings may be expected to be given rapidly.<sup>311</sup> This provision would apply to the possibility of staying both infringement and revocation proceedings before the Court. Secondly, r.295(g) RoP refers to r.118 RoP which specifically relates to the possibility of staying infringement proceedings during the oral procedure. In essence r.118(2) RoP states that a local or regional division may:

- Render a decision under a condition subsequent that the patent is not held wholly or partially invalid;<sup>312</sup> or
- Stay the infringement proceedings pending a decision of the EPO and shall stay them if there is a high likelihood that the patent will be held invalid and that decision will be given rapidly.<sup>313</sup>

**11-167** It is hoped that the Court will not stay its proceedings (except in exceptional circumstances) and that the quality and persuasive authority of their judgments will convince the EPO not to deviate from the Court's decisions. In the generally undesirable situation that the revocation proceedings are stayed in favour of the EPO and the infringement proceedings carried forward, it is useful to remember that pending a final decision on validity, the defendant in infringement proceedings is offered considerably more protection under the Court regime than before certain national courts. The additional protection may include:

- The Court may render its decision on the merits of the infringement claim, including its orders, on the basis of a condition subsequent pursuant to art.56(1) UPCA that the patent is not held to be wholly or partially invalid by the final decision in the revocation procedure or a final decision of the EPO;<sup>314</sup>
- The enforcement of a decision or order may be subject to the provision of security;<sup>315</sup> and
- Where an enforceable decision or order of the Court is subsequently varied or revoked, the Court may order the party which has enforced such decision or order to compensate the defendant for the injury caused by the enforcement.<sup>316</sup>

**11-168** For further information on revocation proceedings before the Court see chapter 9 (Revocation (Nullity) of Unitary Patents (and European Patents Subject to the Court) – Substantive Law).

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<sup>311</sup> Similarly, this provision provides for a possible stay where there are opposition or limitation proceedings pending before a national authority, i.e. a national patent office.

<sup>312</sup> r.118(2)(a) RoP. Where the Court has made such order, any party may apply to the local or regional division within 2 months following a final decision of the Court or the EPO as the case may be on the validity of the patent for orders consequential on such final decision (r.118(4) RoP). See chapter 14 (Oral Procedure) paragraphs 14-50 to 14-64, and figure 14-1.

<sup>313</sup> r.118(2)(b) RoP. R.118(2) RoP also provides for a possible conditional decision or a stay pending a decision in revocation proceedings between the same parties before the central division.

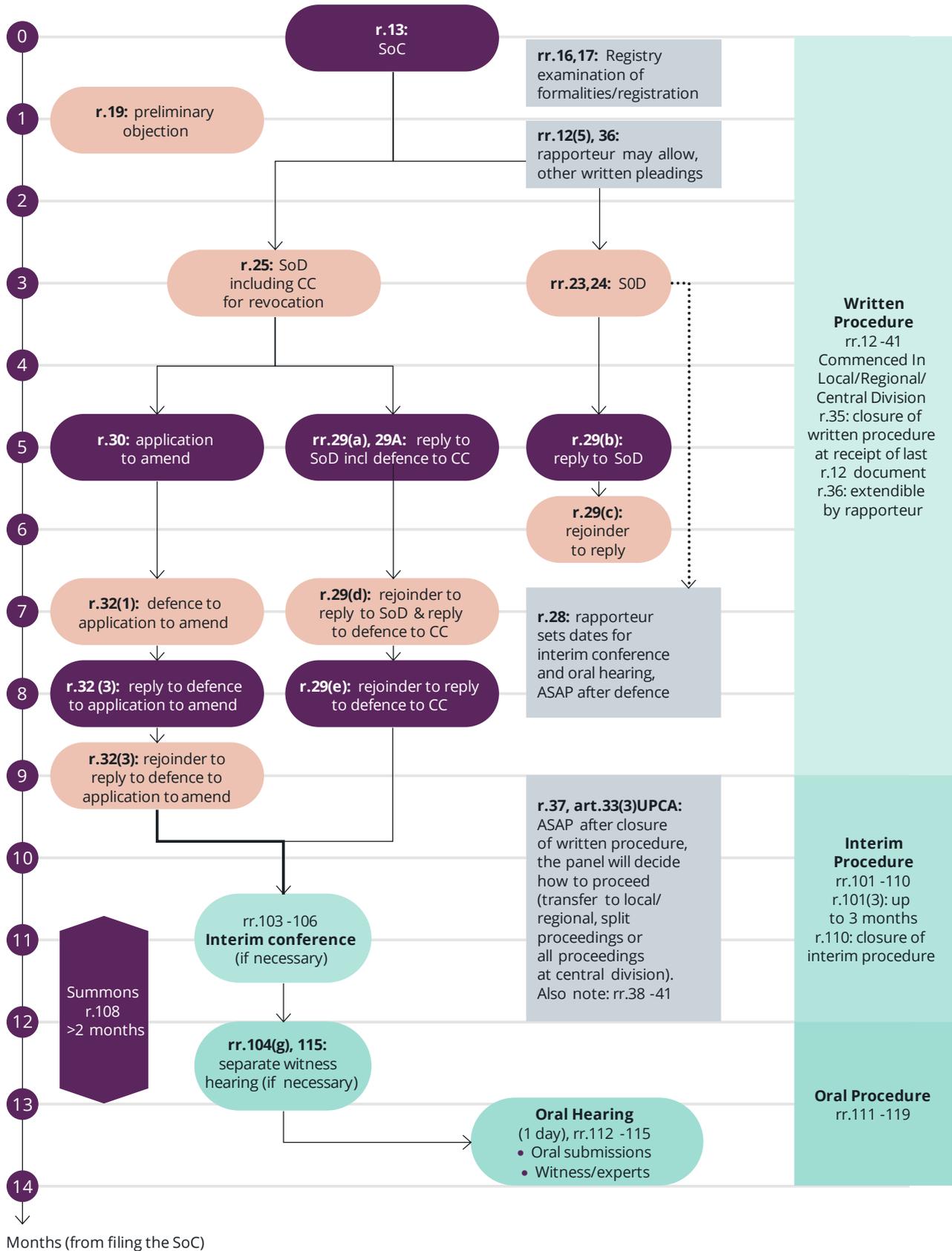
<sup>314</sup> r.118(2)(a) RoP.

<sup>315</sup> art.82(2) UPCA and r.118(8) RoP. See chapter 19 (Enforcement) paragraphs 19-46 to 19-64.

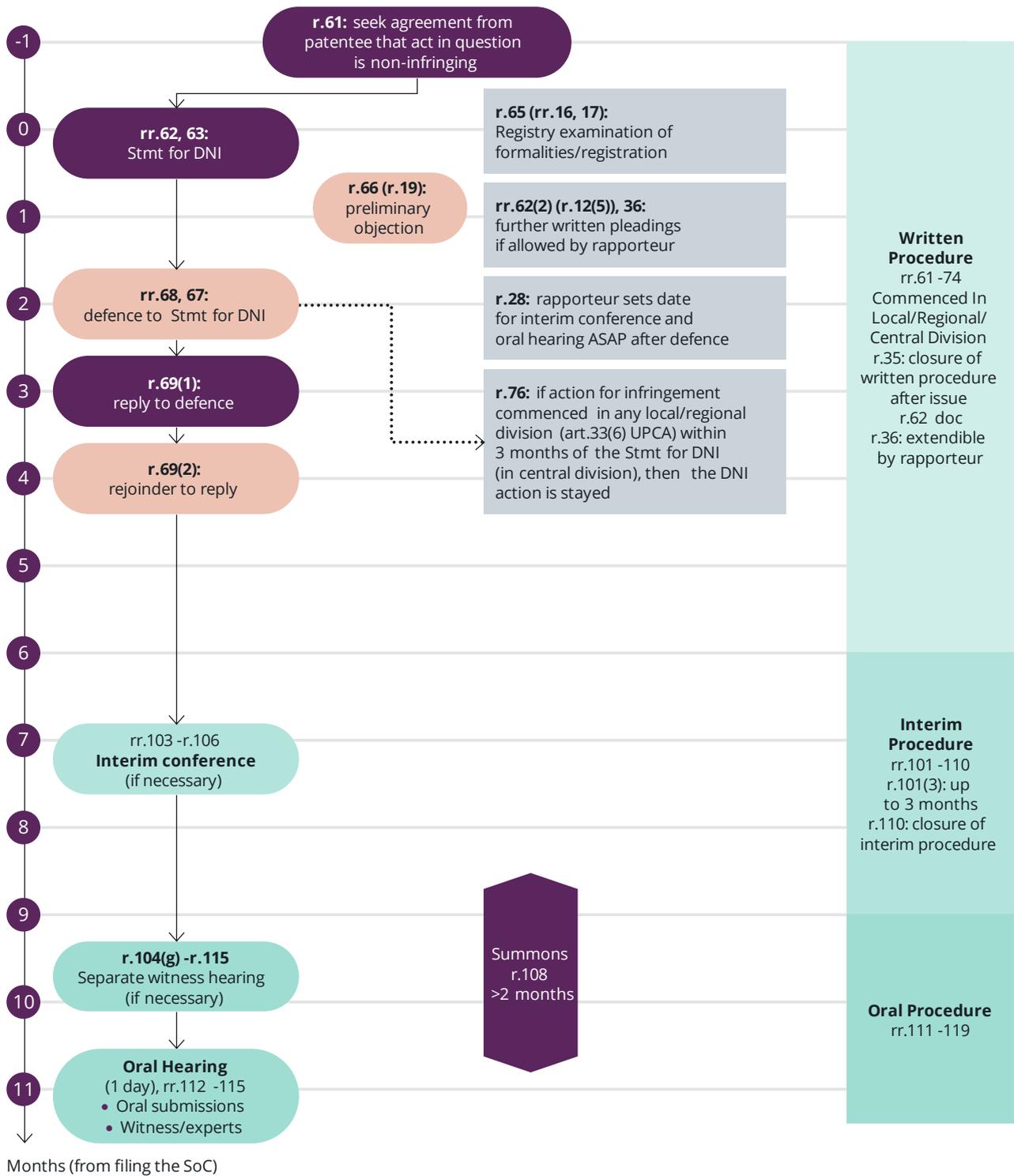
<sup>316</sup> r.354(2) RoP. See also chapter 19 (Enforcement) paragraphs 19-65 to 19-71.

# ANNEX

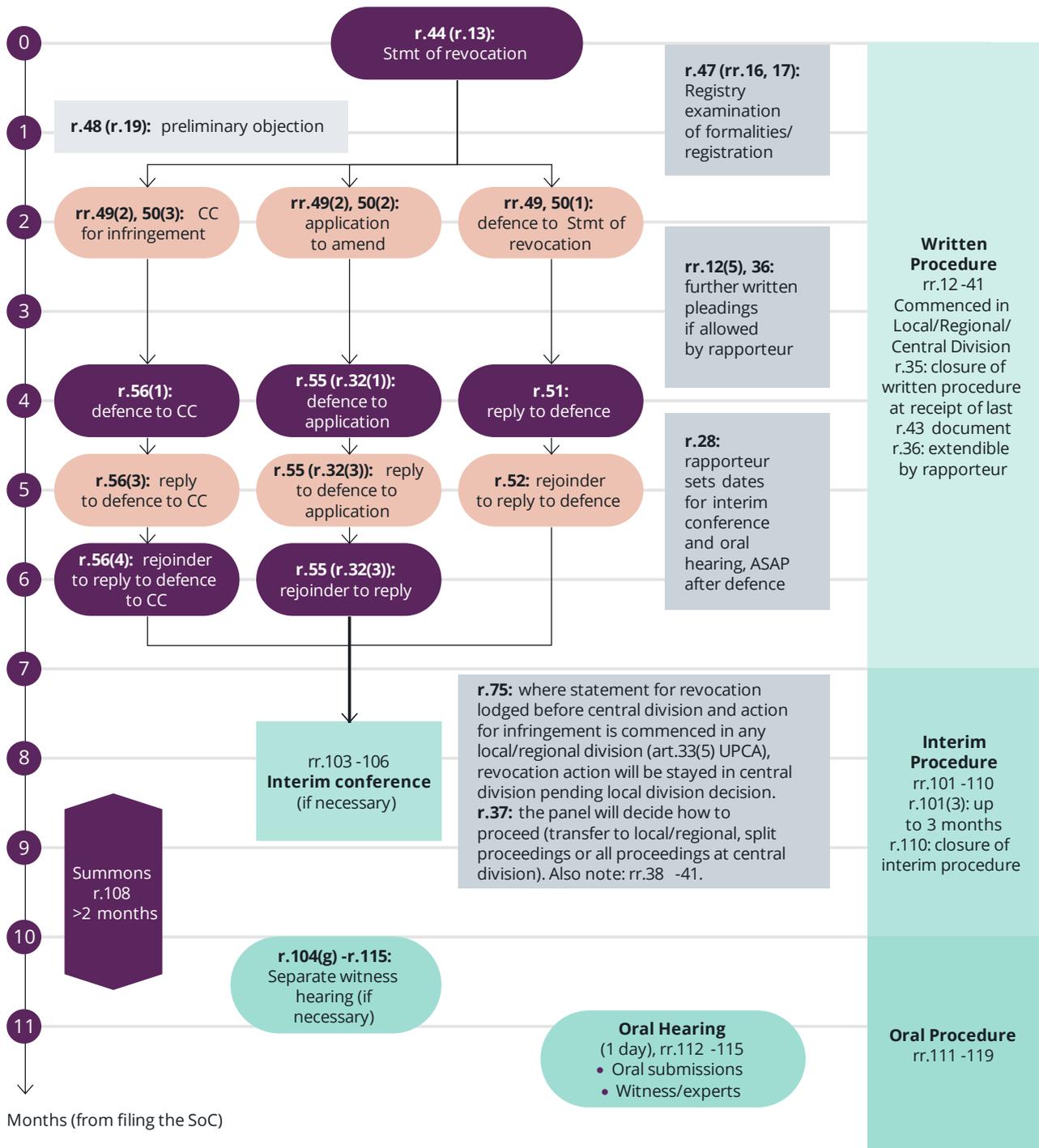
## Full Timeline of an Infringement Action



# Full Timeline of a Declaration of Non-Infringement



# Full Timeline of a Revocation Action



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