EPLIT
EUROPEAN PATENT LITIGATORS ASSOCIATION

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To the Preparatory Committee
of the Unified Patent Court

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Comments on

Draft Decision of the Administrative Committee on Rules on the European Patent Litigation Certificate (EPLC) Other Appropriate Qualifications Pursuant to Article 48(2) of the Agreement on a Unified Patent Court

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EPLIT, the **European Patent Litigators Association,** was founded almost a year ago in view of the fact that the UPCA appropriately provides for representation of parties by European Patent Attorneys having an appropriate qualification in patent litigation. Thus it is one of the main objectives of this newly established association to promote the participation of European Patent Attorneys in proceedings before the UPC.

Representation of parties by attorneys specialized in patent litigation seems essential for reaching the goal of user-friendly, fair and cost-efficient patent litigation in Europe. Since patents are IP rights granted to protect technical inventions, patent litigation almost always has a technical dimension in addition to a legal dimension. European Patent Attorneys, who must have a suitable qualification such as a university degree in science or technology, a three-year training in the European patent profession, under the supervision of an appropriately qualified individual, and then pass a difficult exam covering both technical and legal aspects, are in EPLIT's view natural candidates of professionals who should be admitted to represent parties before the UPC.

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I. Introduction

EPLIT welcomes the Preparatory Committee's consultation on the above subject and wishes to make some comments that are designed to assist the Preparatory Committee in its task.

EPLIT considers that the Rules relating to representation should be drawn up with the objectives of the UPC itself in mind. In particular, it is an objective of the UPC to provide a system that will be also accessible for SMEs, academic institutions and individuals. In order for this objective to be met, it is necessary, *inter alia*, for the cost of representation to be kept as low as possible. This can only be achieved if competition with respect to representation is open and not limited to certain restricted professional groups, which in turn is achieved if suitably-qualified European Patent Attorneys (EPAs) too – and not only lawyers - are allowed to represent clients on their own before the UPC. Only if the client has a choice, he is in a position to select that professional (or team of professionals) that suits his needs best.

EPLIT therefore welcomes the proposals in the Preparatory Committee's draft, which make it possible for many EPAs to represent clients before the UPC.

II. Accredited Courses (Rules 3 to 10)

1. EPLIT agrees setting up accredited courses by the Administrative Committee for gaining a Litigation Certificate. This will ensure that licenced EPAs will provide high

quality representation before the UPC. These will allow stakeholders to choose between a lawyer and a suitably qualified European Patent Attorney or use both as joint representatives. Only this possibility of a choice and the resulting competition will ensure affordability of patent litigation in the UPC also for SMEs, academic institutions and individuals.

Accordingly, for EPAs who have no additional qualification EPLIT considers the content and the duration of the proposed course to gain a European Patent Litigation Certificate to be appropriate.

EPLIT does not, however, see a need to limit the institutions that can be accredited to give courses for gaining the Litigation Certificate to non-profit and academic organizations only. Provided that the quality of the courses given is guaranteed, there is no reason to doubt that also for-profit and non-academic institutions can provide appropriate education and training.

III. Other Appropriate Qualifications

As the vast majority of EPAs is already educated and examined in the relevant subject matters (cf points a) to e) of the proposed Curriculum) to the extent they are additionally qualified at national level, EPLIT considers that the provisions for "other qualifications" should be clarified to ensure that all EPAs who already have suitable national qualifications for representing clients in litigation, either alone or in a team with lawyers, are able to represent clients before the UPC.

a. Rule 11

1. EPLIT welcomes the proposals for Rule 11 as a starting point. However, Art 48(2) UPCA broadly allows for representation by EPAs having appropriate qualifications (the Litigation Certificate is only mentioned as an example). Nonetheless, Rule 11 of the current draft reduces "appropriate qualifications" to a law degree. This was obviously not intended by the Contracting Members States otherwise Art 48(2) UPCA would have said so.

   Accordingly, EPLIT considers that the other qualifications mentioned as appropriate during a transitional period in Rule 12 should be considered eligible on a permanent basis for rightly implementing Art 48(2) UPCA.

2. Additionally, it is not clear what constitutes "an equivalent state exam in law of a Member State of the EU".

   For instance, in the UK, Germany, Austria, Hungary, Czech Republic, Poland, Italy France, Netherlands, Spain, etc, in order to become a national Patent Attorney, it is necessary to take examinations that are specified by a relevant national authority and could be fairly considered as "state exams". These examinations cover both patent law and general law.

   EPAs who have obtained such a national qualification, in our view, show that they have additional qualifications that enable them to represent clients before the UPC.

3. Such recognition of national qualifications seems only just and equitable in view of Article 48(1) UPCA, which is governed by the principle of subsidiarity with respect to "lawyers".

   Additionally, it is still not clear whether EPAs with an additional national qualification that entitles them to represent clients before at least some national courts (such as the Intellectual Property Enterprise Court in the UK or the *Bundespatentgericht* in Germany) will fall under Article 48(1) UPCA as "lawyers authorised to practice before a court of a Contracting Member State". On the basis of the 15th draft of the Rules of Procedure they — rightly — did. However, the definition of "lawyer" in Rule 286 was fundamentally changed in the 16th draft of the RoP and presently — wrongly — refers to titles (!) listed in a Directive referring to the freedom to provide legal services under specific titles. However, although not listed in Directive 98/5/EC, for example Registered UK patent attorneys are clearly referred to as "lawyers" at national level (ie in the Legal Services Act) - this should be reflected in the final definition of Rule 286 of the RoP. Thus, in our view the interaction of the current consultation with the final consultation of the RoP later this year should be kept in mind.

4. For qualifying as a national Patent Attorney it is necessary in the vast majority of EPC Member States to pass an examination on general national and EU law, procedural law, enforcement law, etc and particularly on patent infringement and validity. These examinations already test candidates' ability to deal with the complex situations which occur in infringement actions and provide a client with advice on, and possibly with representation or assistance in, such situations.

5. It can therefore be seen that in many Member States, there are European patent attorneys who are also qualified to practise as patent attorneys in that state because they have been examined by a state institution in subjects which are relevant to proceedings that are equivalent to proceedings before the UPC.

   EPLIT considers that any such examined national patent attorney who is also a European patent attorney should be able to represent clients before the UPC. Rule 11 should be clarified to reflect this.

   EPLIT therefore proposes to add the following **Rule 11a**:

   "European Patent Attorneys being additionally qualified as national patent attorney according to the relevant educational standard in a Member State of the European Patent Convention provided that such examination covers also knowledge of private and procedural law required to conduct patent litigation shall be deemed to have appropriate qualifications pursuant to Article 48(2) of the Agreement and may apply for registration on the list of entitled representatives."

   Without such an addition existing litigation rights of many national patent attorneys would unjustifiably be deprived of them.

b. Rule 12

1. EPLIT also welcomes the provisions of Rule 12 but questions - as indicated above - why these are provided as transitional provisions. The courses that are mentioned in part (a) will continue to run and, since they already provide the training

necessary to show that an EPA is qualified to represent before the UPC, it cannot be seen why they will not do so in the future. It is therefore EPLIT's view that these provisions should not be transitional.

2. EPLIT also considers that the present Rule is discriminatory in a number of ways.

In particular, the Rule seems to discriminate between member states. The only courses mentioned are ones that are held in the UK, France or Germany and so will predominantly be taken by UK, French or German candidates. EPLIT considers that it will be necessary to add to the list suitable courses that are held in other member states. It is assumed that the "[…]" at the end of part (a) is intended to indicate that other courses can be added and EPLIT welcomes this.

However, the Rule is discriminatory in other ways. All of the courses listed were set up relatively recently. The CEIPI litigation course and the Nottingham litigation course are very recent. The CEIPI Patent Diploma and the Hagen course are somewhat older and, of the three UK courses, only the QM course has been in existence for any length of time. Thus, the list discriminates against people who were not able to take those courses because they qualified as examined national patent attorneys before the courses were set up.

As explained above, in many Member States, it is possible to become a national patent attorney, qualified by examination, without having to pass any of the listed courses. Thus, the Rule in its present form discriminates against older attorneys who qualified before the courses were set up. This is both unfair and rather

strange as many of those older attorneys will – due to their experience – be more likely to be able to represent effectively before the UPC.

There is also discrimination between those patent attorneys who are able to take the courses and those who are not. For instance, the CEIPI and Nottingham Litigation courses are only able to accommodate a limited number of candidates for each course. It would not have been possible for either course to be taken by all interested EPAs before the UPC comes into operation. Also, the courses are costly and require residential study. Many EPAs, especially in the more recent EPC member states, cannot afford the cost or the time. Even for the other courses, it is not necessary for a candidate to take these courses to qualify as a national patent attorney. For instance, the QM, Bournemouth and Brunel courses are provided as alternatives to the intermediate examinations referred to above. Many employers do not want to spend the time and money for candidates to go on these courses and therefore train their candidates to take the examinations. Thus, the Rule discriminates against those EPAs who have carried out sufficient training and have passed suitable examinations without going on any of the mentioned courses.

This discrimination could be avoided by allowing anyone who has passed an examination set by a national authority, which leads to a qualification which can (also) be obtained by successfully following one of the specified courses to represent clients before the UPC (cf. above).

3. The Rule also does not allow for representation by EPAs who have shown in other ways that they are capable of representing clients before the UPC. For instance, in the UK, anyone taking and passing the Nottingham course can request IPReg to

issue him or her with a certificate entitling him or her to represent clients before the UK Courts. However, there are a number of UK EPAs who have been awarded such a certificate but who did not take the Nottingham course.

EPLIT considers that at least such persons, who have qualified to represent before a relevant national court in other ways, should also be entitled to represent before the UPC.

4. The Rule also does not consider EPAs who have extensive litigation experience.

The restriction in Rule 12b according to which only representation of a party "without the assistance of a lawyer" is to be considered for gaining experience is absurd.

Due to current national restrictions in most of the Member States EPAs are not entitled to represent parties on their own. Thus, EPAs practicing in a specific Member State (eg Germany, France, UK, etc) would be discriminated against EPAs practicing in another Member State (eg Sweden). However, as the legal and technical knowledge of patent attorneys is usually indispensable to the parties throughout Europe, patent attorneys usually work in teams with another representative (where required). Nevertheless, actions, replies, writs, etc. are very often drafted to a major extent by patent attorneys. The same applies to oral advocacy in many Member States.

Accordingly, EPLIT fails to understand why such experienced patent attorneys should not be admitted for representation before the UPC, as the UPCA – to the

benefit of the users - aims to overcome outdated restrictions with regard to representation by qualified attorneys. Thus, in our view the restriction to only consider sole representation in a number of infringement cases contravenes the rationale that underlies Article 48(2) of the Agreement, ie fair and affordable access to justice.

The peculiarity of this provision becomes particularly clear in connection with English solicitors, which (currently) fall under Art 48(1) UPCA: Basically no English solicitor would satisfy this provision as even the most experienced solicitors (have to) conduct litigation together with a barrister, ie not "without the assistance of a lawyer admitted to the relevant court".

Accordingly, we strongly oppose this – in our view – discriminatory restriction.

4. Additionally, the Draft is completely silent with respect to other litigation experiences, such as having provided opinions on validity and infringement on behalf of a court or even decided cases as a judge.

Accordingly, EPLIT proposes to amended Rule 12 (b) and add the following sub-sections (c) and (d) to **Rule 12**:

"or,

(b) having represented a party together with other legal practitioners in at least three patent infringement actions, initiated before a national court of a Contracting Member State within the five years preceding the application for registration, or

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(c) having acted as (technical) judge in at least three patent infringement actions, initiated before a national court of a Contracting Member State within the five years preceding the application for registration, or

(d) having acted as an expert appointed by court in at least three patent infringement actions, initiated before a national court of a Contracting Member State within the five years preceding the application for registration.

EPLIT would be pleased to discuss the contents of this submission with the Preparatory Committee.

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President

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