



FÉDÉRATION INTERNATIONALE DES CONSEILS
EN PROPRIÉTÉ INTELLECTUELLE

INTERNATIONAL FEDERATION OF
INTELLECTUAL PROPERTY ATTORNEYS

INTERNATIONALE FÖDERATION
VON PATENTANWÄLTEN

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Mr. Paul van Beukering,

Via email: secretariat@unified-patent-court.org

Chair of the Preparatory Committee

Unified Patent Court Preparatory Committee

RE \ \ European Patent Litigation Certificate draft proposal and public consultation

Dear Mr. van Beukering,

In the name of FICPI, Fédération Internationale des Conseils en Propriété Intellectuelle, I respectfully submit the attached comments, which constitute our Federation's contribution to the draft proposal and public consultation relevant to the European Patent Litigation Certificate.

Yours sincerely,

Julian Crump
Secretary General of FICPI

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25 July 2014

**FICPI comments on:
“Draft Rules on the European Patent Litigation Certificate”**

FICPI, the International Federation of Intellectual Property Attorneys, broadly representative of the free profession throughout the world, expresses its thanks to the invitation of the Preparatory Committee of the Unified Patent Court to provide input on the above-mentioned consultation.

Introduction

FICPI, being a Federation having more than 5000 members, most of them being European patent attorneys, often with experience in patent litigation, warmly welcomes the present consultation and recognizes the efforts of the Preparatory Committee to involve all the interested parties in the process of drafting the implementing regulation of the Agreement on a Unified Patent Court.

In order to improve the transparency of said process and due to its importance, FICPI encourages the Preparatory Committee to continue with holding public consultations (hopefully with a timeframe much longer than six weeks) and reiterates its suggestion to publish on the website of the UPC the membership lists of all Committees and Sub-committees, as well as an integral copy of all contributions received in all past, present and future consultations, not only a digest thereof.

As a matter of fact, FICPI appreciated the digest published after the consultation on the 15th draft of the Rules of Procedure, which digest could have been very useful for understanding in detail the process of the revision leading to the 16th draft, if also the contributions cited in the digest had been made available on the UPC website.

At any rate, FICPI confirms again to be ready to cooperate with the Preparatory Committee and the future Advisory Committee for the success of the Unified Patent Court.

Main issue

FICPI believes that in general the draft rules proposed by the Preparatory Committee are suitable for creating a balanced system for the provision and the recognition of the additional qualifications mentioned in Art. 48(2) of the Agreement.

However, current Rule 12 does not allow most European Patent Attorneys already having gained significant experience in patent litigation to become representatives before the UPC. FICPI considers this exclusion unjustified, especially considering that having experiences and/or in-depth knowledge in patent litigation is an important criteria for the qualification of eligible judges for the UPC. It is thus suggested to encompass in the provisions of Rule 12 also European Patent Attorneys having experiences and/or in-depth knowledge in patent litigation.

In particular, FICPI remarks that European Patent Attorneys, according to their studies, examinations and/or experiences in patent litigation, have different levels of additional qualifications, listed here in order of decreasing importance:

1. acting as a judge or assisting a judge in patent litigation;
2. acting for the parties in patent litigation;
3. passing courses focused on patent litigation, such as from the Nottingham Law School or the Centre d'Études International de la Propriété Intellectuel (CEIPI);
4. passing a qualification examination to become registered national patent attorney;
5. passing courses mainly aimed to become national patent attorney, such as those offered at Hagen 1, CEIPI, Queen Mary College London, Brunel University, Bournemouth University and others (see below).

In this respect, FICPI further observes that in most European countries (e.g. Germany, France, United Kingdom, Italy, Spain, Netherlands, Hungary, etc.) the state examination to become a registered patent attorney already comprises written and oral questions to verify the knowledge of laws, rules of procedure and case laws needed to act for parties in patent litigation. Thus, the current limitation of Rule 12(b) excluding those who have represented parties with the assistance of lawyers appears unnecessary and unwarranted.

Moreover, since the Preparatory Committee already recognized the additional qualifications under levels 3 and 5 as appropriate at least in the transitional period, there is no reason to exclude from Rule 12 the qualifications of levels 1, 2 and 4, which certainly involve a higher level of experiences and/or in-depth knowledge in patent litigation than level 5.

In fact, it would be quite paradoxical to exclude European Patent Attorneys who have not attended a course of level 5 but have instead passed the state examination certifying the knowledge of the contents of the same course and/or have already significant experiences and/or in-depth knowledge in patent litigation. In particular, the exclusion of European Patent Attorneys having experiences in patent infringement litigation because they have assisted judges in the analyses of substantial questions of patent validity and infringement, or even have acted as lay judges or technical judges, seems to be unintentional and contrary to the aim of Rule 12.

It must also be emphasized that the national qualifications enable nationally qualified patent attorneys to become eligible to represent or assist parties in patent litigation (and to enjoy full attorney/client privilege!) or to serve as a judge or court expert in patent infringement proceedings or other patent (IP) related court or court-like proceedings.

Furthermore, in line with Rule 11, any such state examination in a Member State of the European Union should be deemed to be an appropriate qualification.

Thus, in order to avoid or at least reduce any discrimination among European Patent Attorneys having already obtained appropriate qualifications, it is proposed to amend Rule 12 as follows:

Rule 12

Other qualifications during a transitional period

[...]

or(b) having ~~represented~~ acted for a party on his own without the assistance of a lawyer admitted to the relevant 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,

or

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

or

(d) having passed a qualification examination to become registered patent attorney of a Member State, provided that such examination covers also knowledge of private and procedural law, required to conduct patent litigation.

Other issues

FICPI observes that there is no reason to exclude from accreditation the educational bodies of Member States of the European Union which are not (yet) Contracting Members States, so that the following amendments are proposed:

Rule 2 - European Patent Litigation Course

The Certificate may be issued by universities and other non-profit educational bodies of higher education in a ~~Contracting~~ Member State [...]

Rule 6

Accreditation requirement

Universities and other non-profit educational bodies of higher education of a ~~Contracting~~ Member State may offer the Course subject to accreditation by the Administrative Committee.

Moreover, since the languages of the Unified Patent Court are not limited to the languages of the European Patent Office, in order to avoid discriminations by language among European Patent Attorneys entitled to represent parties or among educational bodies entitled to grant the Certificate, the following amendments are hereby suggested:

Rule 7

Request for accreditation

The request for accreditation of the Course shall be filed with the Unified Patent Court in one of the official languages of a ~~Contracting Member State~~ the European Patent Office and shall contain: [...]

Rule 14

Request for recognition of other appropriate qualifications



(1) Requests for recognition of other appropriate qualifications shall be filed with the Unified Patent Court in one of the official languages of a Contracting Member State ~~the European Patent Office~~. [...]

Rule 18

Formalities of the petition for review

The petition for review shall be filed in writing with the Registrar in one of the official languages of a Contracting Member State ~~the European Patent Office~~ [...]

It is also observed that in Europe several courses have a curriculum comparable to one or more courses listed in Rule 12(a). For example, the following courses appear to be entitled to be listed in Rule 12(a):

1. "Corso di preparazione per Consulenti in Brevetti" (<http://www.convey.it/2013/07/14-corso-di-preparazione-per-consulenti-in-brevetti/lang/it/>) - Convey (Italy)
2. "Corso di Proprietà Industriale – Brevetti" (<http://www.energia.polimi.it/didattica/brevetti/>) - Politecnico di Milano (Italy);
3. "Beroepsopleiding Octrooigemachtigden" (<http://www.ru.nl/cpo/sbo/opleiding/tweejarige/>) - Stichting Beroepsopleiding Octrooigemachtigden (Netherlands)

IMPORTANT NOTE:

The views set forth in this paper have been provisionally approved by the Bureau of FICPI and are subject to final approval by the Executive Committee (ExCo). The content of the paper may therefore change following review by the ExCo.

The International Federation of Intellectual Property Attorneys (FICPI) is the global representative body for intellectual property attorneys in private practice. FICPI's opinions are based on its members' experiences with a great diversity of clients having a wide range of different levels of knowledge, experience and business needs of the IP system.

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The Australian Federation of Intellectual Property Attorneys, FICPI Canada, Association of Danish Intellectual Property Attorneys (ADIPA), Suomen Patenttiasiamiesyhdistys ry, Association de Conseils en Propriété Industrielle (ACPI), Patentanwaltskammer, Collegio Italiano dei Consulenti in Proprietà Industriale, Japanese Association of FICPI, Norske Patentingeniørers Forening (NPF), Associação Portuguesa dos Consultores em Propriedade Industrial (ACPI), F.I.C.P.I South Africa, the International Federation of Intellectual Property Attorneys – Swedish Association, Verband Schweizerischer Patent und Markenanwälte (VSP) and the British Association of the International Federation of Intellectual Property Attorneys are members of FICPI.

FICPI has national sections in Argentina, Austria, Belgium, Brazil, Chile, China, Colombia, Czech Republic, Greece, Hungary, India, Ireland, Israel, Mexico, Netherlands, New Zealand, Peru, Singapore, South Korea, Spain and the United States of America, and individual members in a further 49 countries.

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