

Preparatory Committee of the Unified Patent Court
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Public consultation on the draft Rules of on the European Patent Litigation Certificate.

The Ordine dei Consulenti in Proprietà Industriale, which is the institute of Italian Industrial property attorneys (see www.Ordine-Brevetti.it), warmly welcomes the invitation of the Preparatory Committee to submit comments to the draft Rules on the European Patent Litigation Certificate (hereinafter the “Rules”).

We highly appreciate the work of the legal team in charge of this subject and we would like to offer our comments, to possibly improve it.

We definitely share the aim of providing for clear rules relating to the “additional qualification” required for European Patent Attorneys (EPAs) to be authorized as representatives under Art 48(2) UPCA as timely as possible. These Rules will in fact allow having a qualified body of representatives under Art 48(2) UPCA ready in advance of the entry into operation of the UPC itself and this will in turn timely allow the possible users of the new system to have wide choice of qualified representatives to consult with, already in preparation of the entry into force of the system and immediately thereafter. We consider this an important element supporting the smooth entry into effect of the UPCA and its proper functioning already at “day one”. For these reasons we encourage the Preparatory Committee to issue a next (definitive) draft of the Rules as soon as feasible after closing of the public consultation, after having taken the results of it into adequate consideration.

Our observations on the current draft of the Rules focus mainly on R 12, i.e. other qualifications during a transitional period.

- I) **In relation to R 12a**, we observe that it lists, in addition to currently available “litigation courses” (e.g. “CEIPI” and “Nottingham”) also more general courses on patent law and practice. In line with the intention announced in the Explanatory Memorandum, we would like to recommend adding the following two courses, that are regularly held in Italy, that are specific to patent attorneys and, as you can see, have syllabus, duration and other features comparable to the courses already listed:

- “Corso di Proprietà Industriale – Brevetti” organized by Politecnico di Milano. More info at: <http://www.energia.polimi.it/didattica/brevetti/>.
- . “Corso di preparazione per Consulenti in Brevetti” organized by Convey. More info at <http://www.convey.it/2013/07/14-corso-di-preparazione-per-consulenti-in-brevetti/lang/it/>

We are confident you will accept our request but are of course available to further support the case, if needed, with any additional information and evidence you may need.

II) In relation to Rule 12b, we strongly recommend to abandon what in our view appears to be a highly formalistic approach introduced with the current version of R12b (..having “represented” ...) and revert to a more realistic, and pragmatic “having acted”.., i.e. we suggest amending the first part of the Rule as follows (while leaving its second part as in the current version): “R 12 b) **Having acted for a party** in at least three...”

In our view, what matters here is the practical experience acquired in **operating** in a given patent infringement court matter, which according to the rules themselves has to be adequately supported. In addition, we all know that virtually all over Europe “representation in Court” is reserved to limited groups of legally qualified professionals, which therefore by mere definition excludes EPAs unless they (exceptionally) are also qualified lawyers. Indeed, we believe that the theoretical preparation that must be acquired before an EPA can act for a party in patent infringement Court matters, and the activity performed/experience by such EPAs in acting for a party in such Court matters, are the body of the “appropriate qualifications” that are required under Art. 48(2) UPCA. Just as an example, typically in a patent case in Italy, the EPA (officially appointed in the Court proceeding as Consulente Tecnico di Parte or CTP), generally acts in close cooperation with the representing lawyer, in most phases of the proceedings. In addition, the EPA has full and direct responsibility in a specific part of the proceedings (Consulenza Tecnica d’Ufficio or CTU) where issues of patent law are addressed; in this phase, the EPA discusses with the client, prepares briefs to the court on patent law matters, and has direct control of the proceedings for the party she/he is representing. Such an exchange of briefs and motions as well as any oral discussions between the EPAs of the parties are carried under the control and responsibility of the Court appointed Expert (Consulente Tecnico d’Ufficio, normally an EPA herself/himself) who will in the end close this part of the Court procedure and prepare a conclusive opinion on all the patent law matters for the Judge (see below for additional details).

For all these reasons we request R 12b to be amended as reported above.

III) Additionally, we would like to recommend adding a new paragraph (**R 12c**) to include, among the activities acknowledged as leading to the registration of an EPA in the list of Art. 48(3), also the one performed by an EPA when he/she is appointed by a Judge to assist him/her in Court proceedings relating to patent infringement (and validity as well). For example, as outlined in part already above, in Italy, the Court appointed EPA (Consulente Tecnico d'Ufficio) receives briefs and motions from the CTP of the parties, directs them to issues that need clarification and ultimately prepares a motivated opinion on all the patent matters entrusted to him/her by the Judge, such opinion dealing with all the substantive aspects of the interference of a given product or process with the valid scope of protection afforded by the patent. As already mentioned, the EPA who acts as Court appointed expert (CTU) has control and responsibility of the proceedings in this phase of the trial.

We strongly believe that also this role in national patent infringement actions represents an appropriate qualification according to Art. 48(2) UPCA and Rule 12, which should therefore be acknowledged in a separate paragraph (or even integrated in the proposed R 12b, as reported above).

The wording of new R 12c could be “ **Having assisted a Judge in at least...**” (same as currently proposed R 12b), while in case an integrated version of R12b is preferred, a possible wording could in our view be “ **having acted for a party or assisted a Judge ...**”

IV) **On R 2 et seq,** we wonder if limiting to “non-profit” entities is indeed necessary given the strict vigilance on syllabus, teaching and examination process that should occur under the control of the Advisory panel/Committee and ultimately Preparatory/Administrative Committee.

V) We wonder whether it would be preferable to refer to “EPC Contracting States” in **Rule 11.**

With many thanks for your attention.

Yours Sincerely,

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(Council members and chairs of the UPC expert group, Ordine Consulenti Proprietà Industriale)

Luciano Bosotti
(President, Ordine dei Consulenti in Proprietà Industriale)