

SICPI POSITION AS REGARDS THE PROPOSED RULES ON THE EUROPEAN PATENT LITIGATION CERTIFICATE
PUBLISHED ON JUNE 13, 2014

SICPI is willing to comment, in particular, Rule 11 and 12 of the Proposal.

RULE 11

In the opinion of SICPI Rule 11 in the present formulation may be acceptable but requires to be managed taking into account that different situations exist in the Contracting Member States as regards qualification as Patent Attorneys.

Such a situation is apparent by considering the table “The Patent Profession in the EPC Contracting States” annexed hereto.

As a matter of fact in some Country the Intellectual Property Code is a LAW CODE that relates not only to patent validity matter but also to infringement matter, as for instance to enforcement and damage recovery actions, and to Rules of Procedure in actions regarding Patents.

In summary SICPI believes that Rule 11 may be acceptable but requires an application that takes into account the real meaning of the term LAW DIPLOMAS in different Countries with different LAW CODES and different STATE EXAM.

RULE 12

Comma b)

In the opinion of SICPI the amendments made in the draft dated June 13, 2014 seem NOT acceptable.

In many Countries a Patent Attorney is not allowed to represent Clients in Infringement Actions on his own.

Moreover, situations exist in some Country where a Technical Expertise in validity and Infringement Actions is directly managed by Patent Attorneys representing the Parties or officially assisting the Judge.

As a matter of fact this kind of situations is typical where a Technical Judge does not exist and the Technical Expertise is part of the Legal Action.

In the above situations Patent Attorneys manage Technical and Procedural matters, being appointed to represent the parties in the Expertise, but do not formally represent the parties before the Court.

In addition in the above situations Patent Attorneys officially assist the Judge being appointed by the Judge.

The amended formulation of comma b) does not take into account the above situations, therefore SICPI believes that the grandfather clause of comma b) needs a reformulation directed to:

- remove the amendments made in the new draft; and
- take into account the situations where Patent Attorneys are representing or assisting the parties or the Judge.