

# Claim amendment in a future Unified Patent Litigation System

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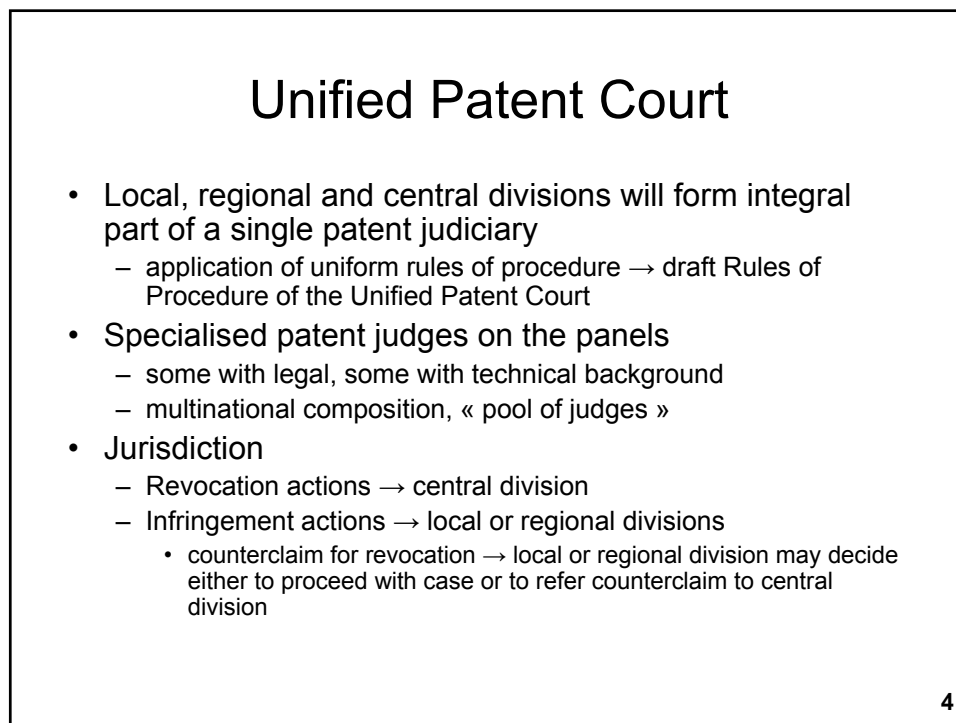
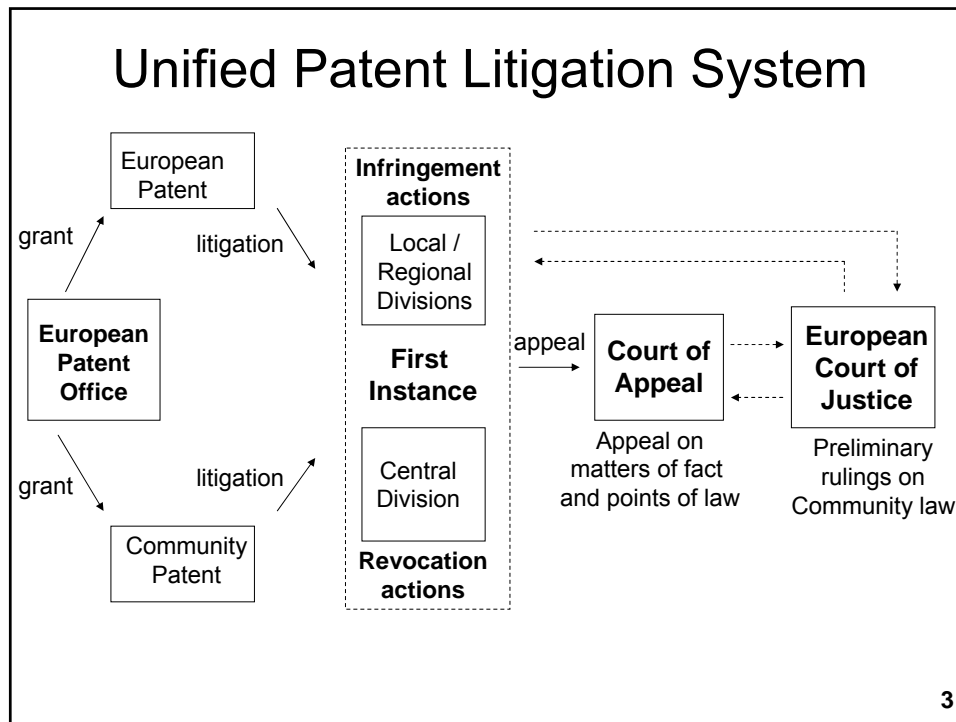
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## Unified Patent Litigation System State of play

- Draft Agreement on the European and Community Patents Court and draft Statute, March 2009
  - mixed agreement under Article 300 EC Treaty
  - open to EU Member States and EPC Contracting States
- **Commission** adopts Recommendation to the Council to open negotiations for the adoption of the draft Agreement, March 2009
- **Council** requests the opinion of the **European Court of Justice** regarding the compatibility of the draft Agreement with the EC Treaty, June 2009

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## Amendment of claims in proceedings before the Unified Patent Court

### Article 38a draft Agreement

§2 - The Court may revoke a patent, either entirely or **partly**, only on the grounds referred to in Article 138(1) EPC or Article 28(1) Community Patent Regulation

§3 - Without prejudice to Article 138(3) EPC, if the grounds for revocation affect the patent only in part, the patent shall be **limited by a corresponding amendment of the claims** and revoked in part

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## Draft Rules of Procedure

- Work in progress -

- Many references in the draft Agreement to the Rules of Procedure
- While waiting for the opinion of the European Court of Justice, work on a preliminary set of provisions for the Rules of Procedure has started
- Eventually, a Mixed Committee will **adopt** the Rules of Procedure, on a proposal from the Commission
  - proposal to be drawn up on the basis of broad consultations with users and opinion of the Unified Patent Court
- Preliminary set of provisions discussed with experts and EU Member States in June-July 2009

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## Draft Rules of Procedure

### Work in progress

- Part 1 – Procedure before the Court of First Instance
  - infringement actions, counterclaims for revocation, direct revocation actions, actions for declaration for non-infringement
  - written, interim and oral phases
- Part 2 – Evidence
- Part 3 – Provisional and protective measures
- Part 4 – Procedure for the award of damages
- Part 5 – Procedure before the Court of Appeal
- Part 6 – General provisions
  - case management, representation, stay of proceedings, time periods, parties to proceedings, intervention, ...

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## Amendment of claims

### Draft Rules of Procedure

- Requests for amendments by the patent proprietor only admissible as reactions to the other party's attacks
  - party disposition
  - possibility to file request for limitation at the EPO
  - no amendment by the Court of its own motion
- When validity is challenged, the patent proprietor will have one possibility as of right to request amendments, at the outset of the proceedings
  - further possibilities at the discretion of the juge-rapporteur or presiding judge, on reasoned request
  - coupled with strict limitations on other party's possibility to raise new challenges to validity

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## Amendment of claims

### Infringement action, Court of First Instance

#### 1. Written phase

- statement of claim (lodged by plaintiff)
- statement of defence (lodged by defendant, 4 months)
- juge-rapporteur may allow further exchanges of written pleadings

#### 2. Interim phase

- preparation for the oral hearing
- where appropriate, the juge-rapporteur may set a date for « final written submissions in preparation for the oral hearing »

#### 3. Oral hearing and decision

- under the control of the presiding judge
- questioning of parties, witnesses, experts

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## Amendment of claims

### Infringement action & counterclaim for revocation

#### 1. Written phase

- statement of claim (lodged by plaintiff)
- statement of defence incl. counterclaim for revocation (lodged by defendant, 4 months)
- reply to the counterclaim for revocation which may include a **proposal to amend** (lodged by plaintiff, 2 months)
- rejoinder to the proposal to amend (lodged by defendant, 2 months)
- juge-rapporteur may allow further exchanges of written pleadings

#### 2. Interim phase

- ... « final written submissions in preparation for the oral hearing »

#### 3. Oral hearing and decision

...

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## Amendment of claims

### Direct revocation action

#### 1. Written phase

- statement for invalidity (lodged by plaintiff)
- defence to invalidity (lodged by defendant)
  - may include a **proposal to amend**
  - may include a counterclaim for infringement
- reply to proposal to amend or counterclaim for infringement (lodged by plaintiff)
- rejoinder (lodged by defendant)
- juge-rapporteur may allow further exchanges of written pleadings

#### 2. Interim phase

- ... « final written submissions in preparation for the oral hearing »

#### 3. Oral hearing and decision

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## Future practice and case law

- Stay of proceedings when limitation requested at the EPO?
  - « the Court may stay ... when a rapid decision may be expected ... »
- Main and auxiliary requests
  - reasonable in number, interlocutory decision?
- Criteria for exercising discretion regarding admissibility of late-filed requests for amendments
- ...

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## Future practice and case law

### Criteria for exercising discretion

- « The Rules of Procedure must be detailed and specific enough to ensure a consistent procedural practice in the different divisions of the Court of First Instance » (Örjan Grundén)
  - without unnecessarily binding the judges
- Statutory list of criteria ?
  - time when request for amendment is lodged, reasons for delay / excuses, relevance / appropriateness, complexity, position of other parties, proportionality / fairness, abuse of procedure

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Thank you for your attention

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