



The Unitary Patent and UPC is coming soon...?



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Margot Fröhlinger





Judge Marie Courboulay





Judge Dr. Klaus Grabinski



Judge Richard Hacon



Law and rules

- UPC Agreement
- UPC Rules of Procedure (18th draft)
- Rules on Court Fees and Recoverable Costs
- Regulation (EU) No 1257/2012 implementing enhanced cooperation
- Regulation (EU) No 1260/2012 ditto - with regard to the applicable translation arrangements
- Rules relating to Unitary Patent Protection
- Rules relating to Fees for Unitary Patent Protection
- The Budgetary and Financial Rules



Article 6

1. Transitional measures

1. During a transitional period starting on the date of application of this Regulation a request for unitary effect as referred to in Article 9 of Regulation (EU) No 1257/2012 shall be submitted together with the following:

- (a) where the language of the proceedings is French or German, a full translation of the specification of the European patent into English; or
- (b) where the language of the proceedings is English, a full translation of the specification of the European patent into **any other** official language of the Union.



Rule 6 Requirements of the request for unitary effect

(1) The request for unitary effect shall be filed with the European Patent Office no later than **one month** after publication of the mention of grant of the European patent in the European Patent Bulletin.



Rule 7 Examination of the request by the European Patent Office

(1) If the requirements under Rule 5, paragraph 2, are met and the request for unitary effect complies with Rule 6, the European Patent Office shall register the unitary effect in the Register for unitary patent protection and communicate the date of this registration to the requester.

(2) If the requirements under Rule 5, paragraph 2, are not met or the request for unitary effect does not comply with Rule 6, paragraph 1, the European Patent Office shall reject the request.

(3) If the requirements under Rule 5, paragraph 2, are met and the request for unitary effect complies with Rule 6, paragraph 1, but fails to comply with the requirements of Rule 6, paragraph 2, the European Patent Office shall invite the requester to correct the deficiencies noted within **a non-extendable period of one month**. If the deficiencies are not corrected in due time, the European Patent Office shall reject the request.



Rule 13 Payment of renewal fees for European patents with unitary effect

(4) A renewal fee in respect of a European patent with unitary effect falling due under paragraph 2 within three months of the notification of the communication referred to in Rule 7(1) may still be paid within that period without the additional fee referred to in paragraph 3.

(5) A renewal fee for a European patent with unitary effect which would have fallen due under paragraph 2 in **the period starting on the date of publication of the mention of the grant of the European patent in the European Patent Bulletin up to and including the date of the notification of the communication referred to in Rule 7(1)** shall be due on that latter date. This fee may still be paid within three months of that latter date without the additional fee referred to in paragraph 3.



ARTICLE 26

Right to prevent the indirect use of the invention

(1) A patent shall confer on its proprietor the right to prevent any third party not having the proprietor's consent from supplying or offering to supply, **within the territory of the Contracting Member States** in which that patent has effect, any person other than a party entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or should have known, that those means are suitable and intended for putting that invention into effect.



ARTICLE 75

Decision on appeal and referral back

(1) If an appeal pursuant to Article 73 is well-founded, the Court of Appeal shall revoke the decision of the Court of First Instance and give a final decision. The Court of Appeal may **in exceptional cases** and in accordance with the Rules of Procedure refer the case back to the Court of First Instance for decision.



Rule 207 – Protective letter

1. If a person entitled to start proceedings under Article 47 of the Agreement considers it likely that an Application for provisional measures against him as a defendant may be lodged before the Court in the near future, he may file a **Protective letter**.



Rule 192 – Application for preserving evidence

1. An Application for **preserving evidence** may be lodged by a party (within the meaning of Article 47 of the Agreement) (hereinafter "the applicant") at the division where the applicant has commenced infringement proceedings on the merits. If the application is lodged before proceedings on the merits have been started it shall be lodged at the division where the applicant intends to start proceedings on the merits.



Article 33

(3) A counterclaim for revocation as referred to in Article 32(1)(e) may be brought in the case of an action for infringement as referred to in Article 32(1)(a). The local or regional division concerned shall, after having heard the parties, have the discretion either to:

- (a) proceed with both the action for infringement and with the counterclaim for revocation and request the President of the Court of First Instance to allocate from the Pool of Judges in accordance with Article 18(3) a technically qualified judge with qualifications and experience in the field of technology concerned.
- (b) refer the counterclaim for revocation for decision to the central division and suspend or proceed with the action for infringement; or
- (c) with the agreement of the parties, refer the case for decision to the central division.



- Only reasonable and proportionate legal costs and other expenses incurred by the successful party may be recovered from the unsuccessful party.
- Equity may also serve as a self-standing ground for rendering the general rule inapplicable.
- In case of partial success or in exceptional circumstances, the Court may order the parties to bear their own costs, or apply a different apportionment of cost, based on equity.
- Unnecessary costs caused to the Court or the other party shall be borne by the party incurring them



Value of the proceeding Ceiling for recoverable costs

Up to and including 250.000 €	Up to 38.000 €
Up to and including 500.000 €	Up to 56.000 €
Up to and including 1.000.000 €	Up to 112.000 €
Up to and including 2.000.000 €	Up to 200.000 €
Up to and including 4.000.000 €	Up to 400.000 €
Up to and including 8.000.000 €	Up to 600.000 €
Up to and including 16.000.000 €	Up to 800.000 €
Up to and including 30.000.000 €	Up to 1.200.000 €
Up to and including 50.000.000 €	Up to 1.500.000 €
More than 50.000.000 €	Up to 2.000.000 €



Rule 101 – Role of the judge-rapporteur (Case management)

1. During the interim procedure, the judge-rapporteur shall make all necessary preparations for the oral hearing. He may in particular, where appropriate, and subject to the mandate of the panel, hold **an interim conference** with the parties which may be held on more than one occasion and may exercise the powers provided for in Rule 334.
2. The judge-rapporteur shall have the obligation to ensure a fair, orderly and efficient interim procedure.
3. Without prejudice to the principle of proportionality, the judge-rapporteur shall complete the interim procedure within three months of the closure of the written procedure.



ARTICLE 52

Written, interim and oral procedures

- (1) The proceedings before the Court shall consist of a written, an interim and an oral procedure, in accordance with the Rules of Procedure. All procedures shall be organized in a flexible and balanced manner.
- (2) In the interim procedure, after the written procedure and if appropriate, the judge acting as Rapporteur, subject to a mandate of the full panel, shall be responsible for convening an interim hearing. That judge shall in particular explore with the parties the possibility for a settlement, including through mediation, and/or arbitration, by using the facilities of the Centre referred to in Article 35.



Rule 113 – Duration of the oral hearing

1. Without prejudice to the application of the principle of proportionality, the presiding judge shall endeavour to complete the oral hearing within one day. The presiding judge may set time limits for parties' oral submissions in advance of the oral hearing.



Article 53

(2) The Rules of Procedure shall govern the procedure for taking such evidence. Questioning of witnesses and experts shall be under the control of the Court and be limited to what is necessary.



Article 8

(7) Notwithstanding paragraphs 1 to 6 and in accordance with the Rules of Procedure, parties may agree to have their case heard by a single legally qualified judge.

9. Reimbursements of fixed and value-based fees

(a) If the action is heard by a single judge (Rule 345.6.) the party liable for the Court fees will be reimbursed by 25%.