

Judge Grabinski: 'Involvement UK is very positive for Unified Patent Court and Unitary Patent'

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There is a lot of enthusiasm among German patent judges, in particular but not only the younger ones, for the Unitary Patent system and the Unified Patent Court, according to Dr. Klaus Grabinski, Judge of the Federal Court of Justice of Karlsruhe in Germany. In an interview with Kluwer IP Law he welcomed the news that the UK will ratify the UPC Agreement. He hopes the German ratification, which is indispensable for the start of the UP system, will not be delayed by the upcoming elections in his country.

Were you pleasantly surprised to hear the UK will stay in the UP system and ratify the UPC Agreement?

'After the Brexit referendum in UK on 23 June 2016 there was a lot of uncertainty about the consequences for the UPC and UP project. From a legal point of view, it soon became clear that the UK is not only entitled to ratify the UPC Agreement as long as it is a Member State of the European Union but will also be able to remain a Contracting State of the UPC Agreement after Brexit will have come into effect if respective arrangements are set out in the Withdrawal Agreement under Article 50 Lisbon Treaty.

However, it was not clear at all whether the UK government would be prepared to go down this path. Therefore, also a so called "plan B" was discussed, which essentially meant an option to have the UPC and the UP project without UK in case UK would not show any interest to join in due term. After the confirmation of the UK government of 28 November 2016 that it will proceed with its preparations to ratify the UPC Agreement the situation has been clarified to a large extent. This recent development is very welcome.'

Do you feel the UP system could have survived without the UK?

'My preference has always been to have the UK on board of the UPC and UP project. The UK government contributed to the setting up of the UPC system, in particular with regard to the IT system and the electronic case management system. UK judges and lawyers played an important role in the drafting of the UPC Agreement, the Rules of Procedure and other rules that will govern the UPC system. And, of course, it will make the UPC more attractive to stakeholders if its decisions will also cover the UK market.'

Is there much enthusiasm among your German colleagues for the new court?

'The answer to your questions depends on what you consider to be "my German colleagues". When you give it a narrow interpretation meaning only German patent judges my feeling is that there is a lot of enthusiasm, in particular but not only among younger patent judges. When your understanding of the term is a broader one meaning it covers also German IP lawyers and patent attorneys you will find enthusiasm but also scepticism depending on whom you ask. In particular, some lawyers or patent attorneys that have mainly SMEs as clients consider the UPC ceilings of recoverable costs to be too high.'

Does the fact the UK judges may now be UPC judges strengthen the position of the court?

'UK patent judges are well known for their competence in dealing with IP cases in general and patent cases in particular. Judges from the Continent can learn a lot from their experience but this is no one way street. It will go both ways in order to ensure a consistent and reliable application of material and procedural law. Having UK judges on UPC panels will certainly strengthen the position of the UPC.'

What issues do you see in the EU Regulations setting up the UP system and in the UPCA that will have to be taken care of so the UK as a future non EU member can stay in?

'This is a rather complex matter and will have to be explored more in detail when negotiations under Article 50 Lisbon Agreement will have been triggered by a respective notification of the UK. One issue will certainly be an amendment of the UPC Agreement which currently provides that the UPC is a court common to the Contracting Member States. However, such an amendment would not necessarily need a revision of the UPC Agreement but could be implemented by the Administrative Committee in order to bring the Agreement into line with a future Withdrawal Agreement as part of Union law.

Another problem that will have to be addressed is the issue of jurisdiction and enforcement since the Brussels I Regulation will not be applicable on UK when it won't be an EU Member State any more. And also Unitary Protection will have to be extended to the UK under Art. 142 European Patent Convention since Regulation (EU) No 1257/2012 will no longer have effect with regard to the UK territory.'

Is it a problem that the location of one of the branches of the Central Division is in London, once the UK will no longer be an EU member?

'No, this will be one of the easiest issues to be dealt with. The London section of the Central Division may remain in London when UK will remain a Contracting State of the UPC Agreement. There is no legal requirement that it has to be located on EU territory.'

According to the Opinion of Brick Court Chambers, the UK - if it wants to stay in the UP system will have to submit to EU law in its entirety as regards proceedings before the UPC. It would also need to sign up to an appropriate jurisdiction and enforcement regime (such as the Lugano Convention). Prof Dr Ansgar Ohly of the Ludwig-Maximilians-Universität of Munich disagrees and thinks such an agreement is not necessary (please see this post on the Kluwer Patent Blog). What is your view?

'The primacy of EU law, the obligation to request preliminary ruling from the CJEU and the liability for damage caused by infringement of EU law are all obligations under the UPC Agreement. On this background it is not clear to me why there should be a need for a further agreement involving the EU to confirm all of this. However, as I already mentioned the issue of jurisdiction and enforcement have to be addressed since the Brussels I Regulation will no longer be applicable on UK once it has left the EU.'



Apart from UK ratification, the ratification by Germany is also indispensable for the start of the UP system. What can you tell about the ratification procedure in your country?

'The ratification of UPC Agreement by Germany requires a law that has to be approved by the Bundestag and the Bundesrat and is signed by the German President. A respective draft law of the Federal government has been published on 27 May 2016. The Bundesrat decided that it will not raise objections. The draft law is now pending

before the Bundestag where parliamentary readings could take place early next year. Time, however, might run short since there will be parliamentary elections in the autumn of 2017 in Germany which could cause delay, but we will see.'

When do you expect the UP system to launch?

'This will not only depend on the preparatory work that has already been finished to a large extent but also on the further development on the political level which makes it difficult to answer that question. With this reservation I would expect the system to fly sometime between autumn of 2017 and summer of 2018.'

Dr. Klaus Grabinski is one of the speakers at the **Unitary Patent Package Conference, 9 and 10 February 2017 in Amsterdam**.

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