

UPC Quiz for Kluwer 2016

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Question 1 (local / regional divisions)

Which of the following lists does not contain a single country that has announced it will host a local division or be part of a regional division:

- A. Denmark, Estonia, Luxembourg
- B. Austria, Ireland, Portugal
- C. Czech Republic, Luxembourg, Portugal
- D. Denmark, Estonia, Latvia, Luxembourg
- E. Austria, Czech Republic, Latvia, Portugal

C: Based on the latest information available.

Question 2 (forum shopping)

A company has its residence and principal place of business in Turkey, but sells products online in Lithuania that infringe the claimant's unitary patent. Where can the claimant bring proceedings for unitary patent infringement:

- A. Nordic-Baltic regional division or the central division
- B. The Lithuanian local division only
- C. The central division only
- D. The Lithuanian local division or the Nordic-Baltic regional division
- E. The Nordic-Baltic regional division only

A: Lithuania is part of the Nordic-Baltic regional division and therefore has no local division. The action may be brought in the Nordic-Baltic regional division or the central division since the Defendant's residence and principal place of business is outside of the territory of the contracting member states (Article 33(1)).

Question 3 (forum shopping)

Where can a company seeking to revoke a European patent (which has not been opted out) commence an action within the first seven years of the UPC's commencement:

- A. Central division only
- B. National courts in each designated state only
- C. Local or regional divisions of each designated state only
- D. A and C
- E. A and B

E: The transitional provisions permit the action to be brought in either the national courts or the central division of the UPC (Article 83(1)).

Question 4 (jurisdiction)

If a company commences infringement proceedings in a local division and the defendant believes that the local division does not have jurisdiction to hear the claim, the defendant should:

- A. Commence an action for a declaration of non-infringement in a division which has jurisdiction within 3 months of the claim being served

- B. File a preliminary objection within one month of the claim being served
- C. Make an application at the interim conference for the claim to be transferred to a division which has jurisdiction
- D. Include an application in the defence for the claim to be transferred to a division which has jurisdiction

B: This is the correct action (Rule 19.1).

Question 5 (languages)

Which of the following are expected to be the designated languages of the Belgian local division:

- A. Dutch, French and English
- B. French and English
- C. Dutch and French
- D. Dutch, French, German and English

D: Belgium is expected to designate all four languages.

Question 6 (languages)

A claimant is intending to bring an action to revoke a unitary patent written in German in the Paris central division and is anticipating a counterclaim for infringement by the defendant in the Dutch local division. Assuming proceedings are not joined, what are the expected possible languages of the separate proceedings in the absence of any agreement between the parties (or request by a party) to the contrary:

- A. Local: Dutch and English; Central: German
- B. Local: Dutch; Central: French
- C. Local: Dutch, English and German; Central: German
- D. Local: Dutch and English; Central: French and German
- E. Local: Dutch and German; Central: English, French and German

A: The Dutch local division's expected designated languages are Dutch and English. It could also hold proceedings in the language of the patent (German) but only with the agreement of the parties or at the request of one of the parties which is approved by the court. The language of the Central Division is the language of the patent (Article 49(6)).

Question 7 (opting out)

After commencement of the UPC, company A opts out its European patent. A wishes to withdraw its opt out. Which of the following reflects the correct position:

- A. A can withdraw its opt out at any time
- B. A can withdraw its opt out only if no proceedings in respect of a matter over which the Court also has jurisdiction have already been brought before a national court
- C. A can only withdraw its opt out within 2 years of the opt out application being noted on the register
- D. A cannot withdraw its opt out until the expiry of the transitional provisions

B: Article 83(4) states that "unless an action has already been brought before a national court, proprietors..... shall be entitled to withdraw their opt out at any moment". Rule 5.9 appears to indicate that it is only national actions brought after the commencement of the UPC which matter for the

purposes of the opt-out withdrawal (see in particular the language “in a matter over which the Court also has jurisdiction”) although it is unclear whether this is the case or whether a withdrawal would be prevented in respect of any proceedings which have been brought at any time in a national court even before commencement of the UPC.

Question 8 (opting out)

Who must file an application to opt out of the jurisdiction of the UPC where a patent has joint proprietors:

- A. All of the proprietors, irrespective of whether they appear on the register
- B. A majority of the registered proprietors
- C. All of the registered proprietors
- D. Any proprietor with the written consent of all other proprietors
- E. None of the above

A: Rule 5.1(a) states that all proprietors shall lodge the Application to opt out and rule 8.5(a) states that all proprietors are treated as such for the purposes of the rules irrespective of whether they are recorded on the register, subject to certain exceptions.

Question 9 (protective letters)

Which of the following statements about protective letters is true:

- A. A protective letter is removed from the register after four months unless an extension is applied for and a renewal fee is paid.
- B. A protective letter is not publically available on the register until it has been forwarded to the applicant for provisional measures.
- C. The court may take into account any protective letter on the register when exercising its discretion whether to inform the defendant about an application for provisional measures.
- D. A defendant lodging a protective letter is under a duty to disclose any material fact known to it that might influence the court in deciding whether to make an order without hearing the defendant.

B. A should be six months (Rule 207.9), C is not optional (rule 209.2(d)) and D applies to the applicant not the defendant (Rule 206.4).

Question 10 (provisional measures)

Which of the following is not available prior to the commencement of infringement proceedings:

- A. Preliminary injunction
- B. Seizure or delivery up of goods
- C. Freezing of the Defendant’s bank account and other assets
- D. Order to preserve evidence (saisie)
- E. Order for a party to produce specific documents

E: Rule 211.1 permits A-C. Rule 192 permits D. An order to produce evidence is available during the written and interim procedures (Rule 190.2).

Question 11 (saisies)

In order to avoid the revocation of a saisie that has been granted by the court, the applicant must commence proceedings within:

- A. The longer of 20 working days or 31 calendar days
- B. The longer of 20 working days or 31 calendar days if reasonable evidence of infringement is found
- C. The shorter of 20 working days or 31 calendar days
- D. The shorter of 20 working days or 31 calendar days if reasonable evidence of infringement is found

A: Rule 198.1 states that the applicant must commence proceedings within the longer of those two time periods.

Question 12 (lodging a claim)

When lodging a statement of claim, which of the following procedures is the standard procedure that the claimant is required to follow:

- A. A copy must be lodged with the Registry electronically and served upon the defendant by post and, if the defendant's electronic address for service is known, on the defendant electronically
- B. A copy must be lodged with the Registry electronically only
- C. A hard copy must be lodged with the Registry and served upon the Defendant by post
- D. A hard copy must be lodged with the Registry only
- E. The Claimant may choose to lodge a copy with the Registry either electronically or in hard copy

B: The only requirement for lodging documents is that they be lodged at the Registry in electronic form (rule 4).

Question 13 (revocation claims)

Company A applied for a European patent and designated three states on grant. In the 1st state A is shown as the registered proprietor on the national register. In the 2nd state, A assigned the patent to company B, but B has not updated the national register to reflect its proprietorship. In the 3rd state, company C is an exclusive licensee. Which of A to C must be named as a defendant on a statement for revocation to revoke the patent:

- A. A
- B. A and B
- C. A, B and C
- D. A and C

A: The registered proprietor shall be treated as the proprietor for the purpose of rule 42 (revocation actions) according to Rule 8.6. Revocation actions need only be directed against the proprietor, not licensees (Rule 42.1). A registered proprietor who is no longer the proprietor under Rule 8.5 is required to apply to the court for substitution of the Rule 8.5 proprietor under Rule 305.1(c) (Rule 42.2).

Question 14 (licensees)

Which of the following statements regarding the standing of an exclusive licensee to sue for infringement is correct:

- A. Unless the licensing agreement provides otherwise, it is entitled to sue
- B. It is not entitled to sue unless the patent proprietor is given prior notice and insofar as expressly permitted by the license agreement
- C. It is entitled to sue provided the patent proprietor is given prior notice

- D. Unless the licensing agreement provides otherwise, it is entitled to sue provided the patent proprietor is given prior notice

D: Under Article 47.2 an exclusive licensee is entitled to sue provided it has given prior notice to the proprietor and it is not prohibited from doing so by the licence agreement.

Question 15 (court fees)

When issuing an infringement action in the UPC, how is the fee paid:

- A. A fixed fee and value based fee are paid when the claim is lodged according to the value of the claim as determined by the claimant
- B. A fixed fee and value based fee are paid when the claim is lodged according to the value of the claim as determined by the claimant, with any additional value-based fee or rebate paid within 10 days of the service of the order determining the value of the claim during the interim procedure
- C. A fixed fee is paid when the claim is lodged and a value-based fee is paid within 10 days of the service of the order determining the value of the claim during the interim procedure
- D. A value based fee is paid when the claim is lodged according to the value of the claim as determined by the claimant and no fixed fee is payable

(Before 30 June 2016) C: The fixed fee must be paid when the claim is lodged (Rule 371.1). The value based fee is determined by the court during the interim procedure (Rule 22.1) and must be paid within 10 days of the service of the order determining the value of the claim (Rule 371.4)).

(On or after 30 June 2016) B: The fixed fee must be paid when the claim is lodged (Rule 371.1). The value based fee is paid according to the claimant's assessment of the value when the claim is lodged. In the event that a higher value is determined by the judge-rapporteur at the interim procedure, the remaining fees due must be paid within 10 days of service of the order determining the value of the claim. Where the value is lower, the Court will reimburse the overpaid fees. (Rule 371(4)).

Question 16 (court fees)

A claimant issues proceedings seeking revocation of two patents and a declaration of non-infringement in respect of each patent. What is the total fixed fee payable, assuming the claimant is not a small or micro enterprise:

- A. €20,000
- B. €22,000
- C. €31,000
- D. €44,000
- E. €62,000

C: The fee is €20,000 for the revocation action and €11,000 for the declaration of non-infringement – giving a total of €31,000. The number of patents is not relevant (rule 370.7).

Question 17 (interim conference)

Which of these is not a stated aim of the interim conference:

- A. Hold preparatory discussions with witnesses and experts
- B. Explore with the parties the possibilities to settle the dispute
- C. Issue a preliminary opinion on the merits of the case
- D. Decide the value of the dispute

E. Order the parties to submit a preliminary estimate of the legal costs they will seek to recover

C: The aims of the interim conference are set out in rule 104(a) to (j).

Question 18 (evidence)

As regards the provision of evidence, a party is required to:

- A. Produce evidence available to it to prove any fact that is contested or is likely to be contested
- B. Produce all evidence available to it that either supports or adversely affects its case
- C. Produce all evidence available to it that adversely affect its case
- D. Only indicate the means of evidence to prove any fact that is contested or is likely to be contested

A: Rule 172.1. B and C are incorrect and D is true save that it is not the only requirement, i.e. it must also produce evidence in respect of a fact which is contested / likely to be contested if it is available.

Question 19 (judges)

Which of these best reflects the composition of the central division judicial panel (subject to very limited exceptions):

- A. Two legally qualified judges and one technically qualified judge from any contracting member states
- B. Two legally qualified judges and one technically qualified judge all from different contracting member states
- C. Two legally qualified judges from different contracting member states and one technically qualified judge from any contracting member state
- D. Two legally qualified judges from the same contracting member state and one technically qualified judge who must be from a different contracting member state

C: The two legally qualified judges must be from different contracting member states, although that requirement does not apply to the technically qualified judge (Article 8(6)).

Question 20 (costs)

A claimant is successful in a claim, which was valued at €40m, and is awarded that sum by way of damages. It paid the court fee of €261,000, incurred representation costs of €2m, expert costs of €50,000 and interpreter costs of €20,000. The maximum total costs which the claimant could recover are:

- A. €1,500,000
- B. €1,831,000
- C. €1,875,000
- D. €2,206,000
- E. €2,288,750

D: The ceiling for recovery of costs of representation for a claim valued at between €30m and €50m is €1.5m, but this can be raised by the court by up to 25% (to €1.875m) if the proceedings are particularly complex or involve multiple languages, having regard to the financial capabilities of the parties (Rule 152.2 and Articles 1 and 2 of the decision of the Administrative Committee of the UPC on the scale of recoverable cost ceilings). Court fees/expert costs/interpreter costs can be recovered in addition to representation costs (Rule 151(d)).

Question 21 (appeals)

Which of the following decisions / orders is not appealable:

- A. A decision following a request by one of the parties for proceedings to be heard in the language of the patent
- B. A decision on a preliminary objection
- C. An order to preserve evidence and to inspect premises
- D. A preliminary injunction
- E. All of the above are appealable

E: Rule 21 allows appeals against B; Rule 220.1(c) allows appeals against A, C and D. Rule 220.2 is unclear but seems to suggest that any order/decision is appealable (potentially leave may be required).