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Fordham Conference 2015 – Unitary Patent and UPC – the Task Force and Judicial View

Daniel Byrne (Bristows) · Wednesday, April 8th, 2015

A View from the Task Force and the Judiciary

The topic of injunctions under the UPCA was raised by **Johannes Karcher** (Head of the Task Force, EU Patent and Unified Patent Court, Germany) with particular focus on the discretion of the Court by a rule specifying the Court ‘may’ provisionally grant an injunction (an interim injunction) and the Court’s weighing of interests of the parties compared with the situation when the Court has found infringement and normally has to grant an injunction and only has a narrow margin of discretion.

The question of whether there is a gap introduced by the possibility of a decision at first instance by the Local/Regional Division on infringement and the decision of the Central Division on validity. The safeguards are said to include the discretion to include infringement and validity in the same proceedings and that there is the possibility of a reasoned decision on bifurcation, a discretionary review and a stay of the infringement proceedings. He referred to the Industry Coalition Scenario (see YouTube clip) and expressed the view that there are things to be wary of, but there are sufficient tools in the toolbox to allow a flexible response.

Rt Hon. Sir Robin Jacob (UCL) did not think there would be much bifurcation because a reason must be given and most judges are not going to say they cannot do both parts of the proceedings. Also, it does not happen at the outset, it only happens once the defence is submitted and it is to be done at the request of the Claimant (who is unlikely to request it and show a sign of weakness). It might however happen in weaker parts of the system. Of course, if revocation proceedings are brought in advance in another court then the infringement proceedings are stayed without discretion.

Hon. Mr Justice Colin Birss (Chancery Division, High Court) identified a polarising tension between Germany and ‘everybody else’. He said it was important to recognise that this is not a jurisdiction in which things are always done the same way. The concern comes from the uncertainty in the system at this stage, but there must be the freedom for it to develop. His personal opinion is that there will not be much bifurcation, but thinks that it will happen a bit.

Annabelle Bennett (Federal Court of Australia) asked whether a cross-undertaking as to damages is one safeguard in relation to an interim injunction. It is said to be available but also discretionary. Robin Jacob noted that in the UK third parties can benefit from such an undertaking

and the Ministry of Health has taken some action in relation to that. He is uncertain if that is available in the UPC as the rules are not clear on that.

When asked about training of judges, **Robin Jacob** mentioned that there is an assumption that experience can be gained by training. He also noted that no member of the EPO can be a UPC judge and low pay might be an issue, coining the phrase ‘pay peanuts; get monkeys’. **Johannes Karcher** was of the view that the judges will be adequately experienced in part as a result of the pool from which they are drawn and that the litigation will centre there. **Robin Jacob** disagreed with that and said that if people have a rotten case they will take it to a rotten judge. **Mr Justice Birss** suggested that it was an important part of the process that judges must travel although he was not sure how this would be implemented. It was noted that part-time judges who are also practising lawyers need an exception to be granted to be appointed.

Robin Jacob foresees that the Central Division dealing with validity might become a realistic alternative to opposition proceedings at the EPO and therefore might be a very busy court.

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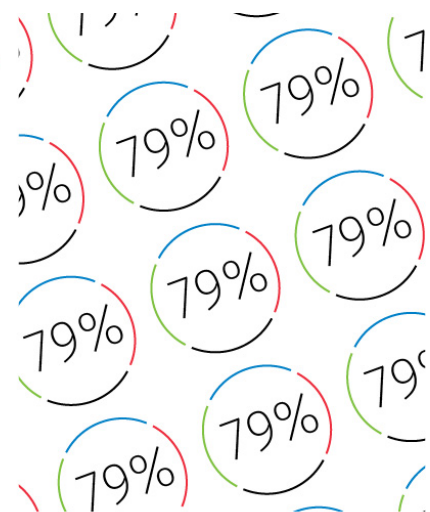
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