Kluwer Patent Blog

‘Unified Patent Court will create a new category of European litigation experts’

Kluwer Patent blogger · Tuesday, April 12th, 2016

In ten to fifteen years, the current differences between European patent attorneys (EPAs), lawyers and patent litigators will have diminished and a there will be a new category of professionals, who are experts in litigation at the Unified Patent Court (UPC) .

This is the expectation of Koen Bijvank, president of the European Patent Litigators Association (EPLIT), which held its 3d annual meeting on 11 April 2016 in Amsterdam. Many EPAs will be qualified to conduct litigation at the UPC under the grandfather provisions, concerning a period of one year after the entry into force of the UPC Agreement, in which a number of national qualifications and previous courses will be recognized as conferring the right to represent before the UPC. Still, there is broad consensus that these qualifications nor the future European Patent Litigation Certificate (EPLC) are enough to become a successful litigator at the UPC: additional training and gaining experience will be indispensable.


Koen Bijvank

In a panel discussion, Beat Weibel of Siemens said that EPAs are trained mostly for the administrative procedures at the European Patent Office. ‘In a court, you need other skills. EPAs can learn, but at the moment they are not the best qualified persons to litigate at the UPC.’ On the other hand, EPAs may have more inside information of a case, which is a big advantage if a company is sued for infringement at the UPC and is to provide for amended claims within two months, as is the case in the very swift UPC procedure. Weibel: ‘In such cases, you’ll probably need a team with both an EPA from inside or outside the client and an experienced European Patent litigator.’

Some UK patent attorneys in the audience, having national litigation rights, and the moderator of the panel Micaela Modiano pushed back to Beat’s views. They agreed that the minimum training needed to qualify may not provide an EPA the right set of skills, but EPAs may have acquired those skills in another way.

Thorsten Bausch of Hoffmann Eitle discussed the choice businesses will have in the future between an EPO opposition procedure versus a UPC revocation action. Some differences: the EPO opposition fee is 785 euro, an appeal case 1880 euro. The UPC fees for revocation and appeal are far higher: 20.000 euro each. The EPO procedure takes up to three years and another three to five for the appeal, a UPC procedure is much faster: one year, and another year for the appeal.

As Thorsten Bausch explained: if you are within the nine months opposition period, if the budget is limited, if you can afford waiting for a decision, if you want to invalidate patents in non-UPC countries, if a patent possibly suffers from an added matter problem or even an inescapable trap problem, if your prior art clearly anticipates the invention, if you can clearly show obviousness using the EPO problem solution approach, if you want to use a straw man, these are all reasons to choose for the EPO opposition procedure.

However, you should choose the UPC if you have missed the opposition period, if your budget is sufficient, if you have a good case and may hope for success and remuneration for your costs, if you need a quick decision, if the patent is invalid for extension of the scope of protection after grant, lack of entitlement or lack of novelty over an earlier filed but unpublished national application, if the patent doesn't suffer from added matter problems or if you cannot clearly show obviousness using the EPO's problem solution approach, but have other good obviousness arguments.

You can also use both procedures, according to Bausch: if you MUST win and costs play no big role, if you have found new and pertinent prior art document that you can no longer introduce into the pending proceeding, if you want to apply pressure on the patentee and force him to come up with his arguments and claim amendments as soon as possible, or to recover part of your costs if you have already almost won EPO opposition proceedings.

Bausch and others pointed out that, as the EPO Boards of Appeal and the UPC will both apply the provisions of the EPC, it will be interesting to see how they influence each other.

During the EPLIT meeting in sunny Amsterdam, many speakers stressed the moment to start preparing for the UP system is now. Decisions need to be made about applying or not applying for unitary effect, for instance. In case of co-ownership of a patent, it is important to realize that Unitary Patents are subject to the national law of the owner who is listed first in the European Patent Register. If a patent is licensed, there are many consequences as well.

Another big issue: opting out or not opting out patents of the UPC. Apart from the strategic choices businesses will have to make, this can be quite complicated as all owners of a patent have to agree on using or not using the UPC. Leythem Wall of Finnegan Europe remarked that although opting out of the UPC will be free of charge, costs will have to be incurred in making sure the opt-out is carried out correctly.

Many attendants showed concern about the IT system of the UPC, which doesn't provide any safeguards against illicitly opting out patents. Anyone can do that, without owners being aware of this. 'The system shouldn't have an open door,' one attendant said. Another proposed to use the EPO identity cards for authentification of opt-out requests.

Eileen Tottle of the UPC Preparatory Committee, who has been closely involved in the

development of the IT system, said the Committee is aware the opt-out system and security in general of the IT system is a broad concern of the industry. ‘We have to make sure to get the security issues to be addressed.’

EPLIT announced it will hold a UPC mock trial on 14 October 2016 in London at the official UPC division. The case will be the famous Epilady case, which was litigated at the January mock trial of EPLIT in Munich as well, but this time there will be two UK judges, among others: Colin Birss and Henry Carr. Of course, the big question – apart from the way the new judges handle all the procedural steps of the case – is whether the outcome of the London trial will be the same as in Munich.

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This entry was posted on Tuesday, April 12th, 2016 at 5:19 pm and is filed under EPC, European Union, Unitary Patent, UPC
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