Kluwer Patent Blog

Sunny beaches or the dark forests

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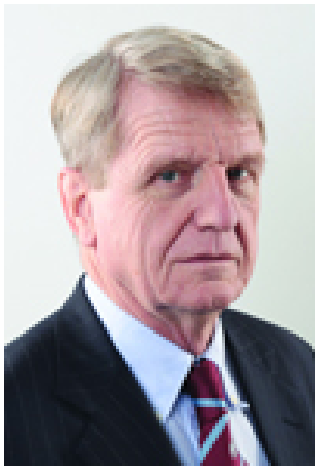
‘The patent community lives today after many dark years in the sunrise period in which owners of patents have to decide if after June 1st, they want to be on the sunny beaches of the UPC or prefer to live another 7 or 14 years in the dark forests of national patent litigation.’ Those were the opening words of the valedictory address of Prof. Willem Hoyng last month at Tilburg University in the Netherlands.

In his address Hoyng, co-founder and former president of the European Patent Lawyers Association (EPLAW) and member of the drafting committee of the Rules of Procedure and chairman of the Advisory Committee of the UPC, among others, discussed many topics concerning the new European patent system, the outcome of a long process which started decades ago, he pointed out:



‘In September 1948, the French Senator Henry Longchambon proposed to the Council of Europe the creation of a European Patent System. His ideas led to the European Patent Project. The original idea was not only to have a central European grant system (as we know nowadays) but also to have a European enforcement system. However, it proved impossible to reach consensus and it was decided to continue only with what has now become the European Patent Office.’

So far, 17 member states have joined the Unitary Patent system, but Hoyng thinks that will not be the end of it: ‘Only Poland, Croatia and Spain have until now decided not to join but I have good hope that in the future certainly Spain will join. I have sympathy for Spain with respect to the fact that many of their fellow Europeans do not seem to realize the importance of the Spanish language in the world. However, I think and hope that the fact that in a Local Division in Madrid (and in

appeal of such cases) Spanish can be used as a language of proceedings and the fact that it is certainly of long-term economic interest for an important country like Spain to participate, will eventually make Spain join.'

He even thinks that in theory that are no obstacles for the UK to return in the system: 'Quite frankly, after the Opinion of the European Court of Justice with respect to the UPCA [Opinion 1/09 0f 8 March 2011, ed], I do not see a problem with non-EU countries that are members of the European Patent Convention adopting the (present) text of the UPC Agreement since by signing they accept (in the broadest sense) the primacy of EU law.'

> If one simply looks at the number of decisions of national supreme courts with respect to only procedural issues and realizing the different national views on the same treaty provisions of material patent law, one realizes that we can expect very interesting times.'

In Tilburg, Hoyng talked about several procedural and material points of law – the competence of the UPC, applicable law, cross-border jurisdiction, saisie contrefaçon, PI proceedings – which are likely to arise in the upcoming period: 'If one simply looks at the number of decisions of national supreme courts with respect to only procedural issues and realizing the different national views on the same treaty provisions of material patent law, one realizes that we can expect very interesting times.'

The same applies to the Rules of Procedure, he said: 'If one sees how many decisions there have been of the Supreme Court in countries which have a Code of Civil Proceedings with respect to the interpretation of the different articles of such Codes it is clear that we are at the start of a body of procedural law to be established by the Court of Appeal of the UPC (and in some instances the ECJ). (…)

In many places the Rules give much discretion to the court and/or the reporting judge. It will also be clear that judges of so many different backgrounds may have very different views about how to use discretion and/or fill in the gaps. It is hoped that with training sessions the UPC judges have been convinced to forget about the national customs and try to look at the Rules of Procedure with fresh eyes and not try to read their own national rules into them as much as possible.'

> Hoyng 'never believed in the necessity and the advantages of Technical Judges' and said it 'has caused some serious problems with respect to the credibility of the UPC'

In his address, Hoyng made clear he 'never believed in the necessity and the advantages of Technical Judges' and said it 'has caused some serious problems with respect to the credibility of the UPC. Although part-time Legal Judges cannot at the same time engage in any other occupation (except for being a national judge), this rule does not apply to part-time Technical Judges.'

However, there is no reason to stay away from the UPC, according to Hoyng: 'The question is why a patent owner would want to opt out its European patents from a system that is created to make enforcement of a patent more efficient. It seems to be a reaction of a typical conservative lawyer (who does not like changes) rather than a well-reasoned decision.'

After criticizing some decisions of the ECJ in earlier parts of his address, Hoyng finished his address with harsh words for the Dutch legal system, including the Supreme Court. ‘The Rules of Procedure [of the UPC, ed.] have been very much inspired by the Dutch so-called abbreviated procedure for patent cases. In recent years unfortunately the Court (in First Instance) in the Hague has taken much more time for its judgements so that decisions within a year became an illusion. (…)

I have the impression that this is also linked to the fact that there is a consistent lack of manpower in the IP chamber of the Court of First Instance. This seems to be a general problem with the Dutch judiciary. (…) No recognition of specialization, insufficient support, too long working hours, an enormous bureaucracy (the so-called Raad voor de Rechtspraak) and salaries which are too low. A rich country like the Netherlands is simply unwilling to spend sufficient money on its judiciary. My conclusion of comparing Dutch national patent proceedings with the UPC is simple. A case in the Dutch Local Division would clearly have my preference.’

The full address of Professor Willem Hoyng is available here.

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