

Kluwer Patent Blog

‘Unfortunate’ that rules for judges Unified Patent Court came so late

Kluwer Patent blogger · Monday, May 29th, 2023

It is unfortunate that the Unified Patent Court hired technical judges without explaining sooner what consequences that would have for their main jobs. Patent litigator [Christof Augenstein](#) has said this in an interview with Kluwer IP Law.

Augenstein argued: ‘As there are only very few countries with technically qualified judges, it was absolutely clear that the vast majority of technically qualified judges – who are appointed part time and will only be remunerated on an hourly basis – would work in parallel in private practice or in the industry. Then, it was also very clear that the independence of the UPC must be ensured as it must be avoided that anyone could doubt the independence of any judge at the UPC as these technical judges also act in the interest of parties or even competitors to the court cases.’



In what way will be checked whether a judge can do a case and/or if there are possible conflicts of interest? There will be a green, yellow, red light distinction I understand?

‘According to Article 6(1) of the Code of Conduct for Judges, judges shall conduct a reasonable investigation to determine any reasons for non-participation in the proceedings when they are asked to join a panel. If a case is pending at the central division this will be early on as a technical judge is always a member of the panel at the central division.

At local or regional divisions, the point in time is rather later. According to Rule 33 of the Rules of Procedure of the Unified Patent Court, a judge may be allocated to a panel already during the written procedure. But I guess that most of the time the technical judge will be requested by the respective local or regional division when they have decided that they will not only decide the infringement case, but also the (counter-)claim for revocation of the patent. According to Rule 37 Rules of Procedure this is after the written procedure is terminated.

Article 6 of the Code of Conduct requires from the judges to “make reasonable inquiries to identify any reason for not taking part in the proceedings”. They are then required to report the result of this investigation to the President of the court, who is responsible for the appointment of the judges.

The “traffic light principle” is from a presentation by Dr Klaus Grabinski, President of the Court of Appeal of the UPC. According to this presentation he used that picture to illustrate how these results should be dealt with. A “red” light means that there is a conflict according to the technical judge. Another judge is to be assigned to the case.

A “yellow” light means that there might be some issues that need a more thorough analysis. Such questions are to be discussed within the Presidium. If the Presidium considers such issues as not endangering the independence, the President will inform the parties, so they can themselves check whether they agree with the Presidium’s assessment. A “green” light would mean that he/she sees no reasons which would question the independence.’

Apparently national law will be applied for the conflict check. Is that fair?

‘Since there are no binding international regulations for the examination of the independence of technical judges before the UPC, it will probably be necessary to fall back on the respective national regulations. There is simply nothing else the judge could refer to. However, the Code of Conduct gives some rather detailed regulations with respect to what could be seen as a conflict. It seems for instance clear that for technical judges working in private practice, the clients and cases of the whole firm need to be taken into account. There is no distinction between cases in particular countries or offices. Thus, technical judges working in international firms will be more likely to be blocked as technical judges in smaller entities.

Ultimately, these rules will be interpreted by the UPC, as it will also be the UPC deciding about the independence of the judges. As there is no case law yet, it is more or less unavoidable that there are differences in detail. Thus, there will often be some room for parties to argue that the Presidium’s decision of appointing a judge might be wrong.

I think it is fair, because there is no alternative. You can see that the Code of Conduct tries to anticipate many of the situations but can of course not foresee the future. What else could the technical judges use for their assessment?’

Do you support the strictness of the proposed code, according to which UPC judges cannot advise a client if the instruction could potentially become a UPC case? Apparently ‘some UPC judges were outraged that their judicial role would no longer be compatible with their work as a lawyer’.

‘I think the UPC cannot risk any doubt as to the independence of the judges. So yes, any suspicion that judges might have a personal advantage must be avoided. The global reputation of this new court is at stake. To me, there should be no room for compromise. Especially in the early days, when many will not be familiar with the new system of the UPC, this independence is incredibly important to create a good reputation.



On the other hand, I also see why the technical judges are disappointed. The whole system was designed for part time judges from the very beginning. These issues were well known, so that there would have been ample of time to communicate the rules from the very beginning. It is really

unfortunate that the UPC first hired technical judges and only explained afterwards what consequences that would have for their main jobs.’

It is speculated some technical judges may withdraw out of concern the court work will hinder their other legal activities. Is resigning the only option?

‘Well, the technical judges can stay in the pool of judges and decide on a case-by-case basis if they are able to accept a case. Of course, this might lead to delays as many might decline their appointment after the necessary checks.’

Do you know of any technical judges with plans to resign?

‘I have no information about that. Rather the opposite. Dutch technical judge András Kupecz is reported to have resigned from his partner position at Pinsent Masons to better focus on his part-time position as technical judge at the UPC ([source](#)). My impression is that many of the technical judges will make up their mind in the coming days.’

In reaction to a post of yours on LinkedIn three weeks ago, Prof. Tilman Müller wrote he expects several (...) part time judges to resign. “This will then trigger the delicate legal question whether they and their firms are still barred from representing clients at the UPC for a cooling off period as they had already been appointed in the first place and got some insider information during the judges training sessions which already took place.” Does Müller have a point?

Personally, I don’t think Prof. Tilman Müller-Stoy has a point here. Even if the part-time judges have been given an insight, I don’t see why it should prevent them from advising clients. The “inside information” the judges have received has nothing to do with actual cases, if anything they have received insights into procedural rules or the like for the UPC in training. I don’t see the connection to cases that are not even pending.’

In his valedictory address last month, Prof. Willem Hoyng said he “never believed in the necessity and the advantages of Technical Judges”. He thinks it “has caused some serious problems with respect to the credibility of the UPC.” Do you agree?

‘Well, I think that there is an advantage in having technical judges in court, in particular for the legal judges. I know from discussions and presentations from legal judges in the patent field that they often wish to have someone with technical expertise they could contact without the parties knowing it. They can test ideas and views internally, so that the panel has a better feel of how to approach legal questions such as infringement or inventive step.’

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please [subscribe here](#).

Kluwer IP Law

The **2022 Future Ready Lawyer survey** showed that 79% of lawyers think that the importance of legal technology will increase for next year. With Kluwer IP Law you can navigate the increasingly global practice of IP law with specialized, local and cross-border information and

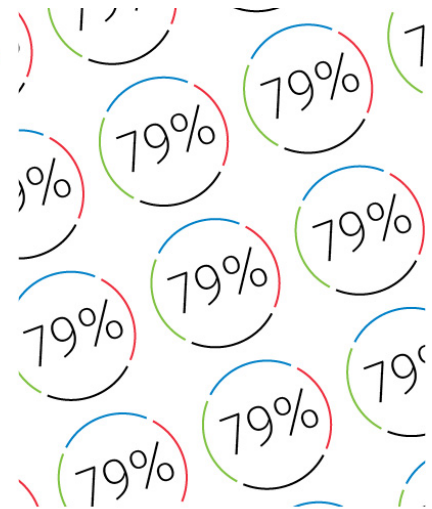
tools from every preferred location. Are you, as an IP professional, ready for the future?

Learn how **Kluwer IP Law** can support you.

79% of the lawyers think that the importance of legal technology will increase for next year.

Drive change with Kluwer IP Law.

The master resource for Intellectual Property rights and registration.



2022 SURVEY REPORT
The Wolters Kluwer Future Ready Lawyer
Leading change

This entry was posted on Monday, May 29th, 2023 at 2:04 pm and is filed under [European Union, Unitary Patent, UPC](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. You can leave a response, or [trackback](#) from your own site.