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UPC: brief thoughts from a French “UPC Representative”

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Here we are (at last), the UPC has opened its doors to claimants. Attorneys-at-Law before national Courts, like European patent attorneys, can now bear the new title of “UCP Representative” and thus exercise a new function of representative before UPC. This raises a number of questions for them.

Like my colleagues, I have been consulted on the topic of possible actions before UPC for month now, sometimes recommending to go, sometimes not. In most cases, however, I have essentially questioned my clients’ real interest in using the system. Here are a few thoughts resulting from this exercise.

Observation no. 1: the most important is to keep clients’ interests at the forefront of our mind. Not always easy for us, when you consider that the first among us to use the system will set precedent and, perhaps, go down in history in the blink of an eye. But, having forgotten this essentially egotistical bias, we must also remember that a litigator likes to win, but, above all, hates to lose. It’s not so much the thirst to win that should guide us in our task as the detestation of losing. In this case, the system is still in its infancy, which is why we must remain restrained in our advice, always guided by this hatred of defeat, which, in the final analysis, is and remains the best compass for working effectively in the interests of our clients.

Observation no. 2: the system offers numerous possibilities for litigation strategies. Particularly with regard to the territory covered. For example, it seems conceivable to carry out a *saisie-contrefaçon* in France for infringement acts committed in another territory, particularly if there is a contributory infringement (i.e., supply of means). More generally, it is reasonable to assume that many litigations begin with *saisie-contrefaçon* before extending to the whole territory, with possible preliminary injunctions in between.

Observation no. 3: collaboration between representatives of different nationalities and qualifications should, in principle, be on an unprecedented scale and, at the end, very fruitful. This is of course due to the territories where the actions will be carried out, but also either because of the legal instruments used (*saisie-contrefaçon* or preliminary injunctions are often linked to certain countries without it being necessary to name them) or because of the technical fields (i.e., due to the technical specialization of certain patent attorneys).

Observation no. 4: UPC is the result of pan-European efforts, in which we find here and there traces of one system or another. This also implies potentially dangerous consequences, which is likely to give rise to a number of difficulties: what about cases in which the UPCA’s provisions

diverge from those of the national laws in question? Let's take the example of article 25 of the UPCA: export does not constitute an act of infringement. This is also the case in German national law for instance (Sec. 10 of the *Patentgesetz*). On the contrary, in France, export constitutes an act of infringement (art. L. 613-3 of the French Intellectual Property Code). Which law should prevail in this case for acts committed in France? The UPCA regulation should certainly prevail, by virtue of the direct applicability of European regulations. However, the scope of such applicability is uncertain. Should the UPCA regulation apply only to unitary patents, or also to non-unitary European patents and national patents? In principle, as surprising and even shocking as it may seem, national titles should not be affected. Articles 24, 25, 26 and 29 of the UPCA refer to a "patent", which is defined in Article 2(g) as a European patent or a unitary effect. On the other hand, the national patent, which is referred to in article 29, is distinguished and the Agreement is not intended to apply to it. However, in both cases, we are the owners of an invention, in other words, the right of ownership of the invention remains identical, even if the title recognizing this right is different. Is this not a breach of the principle of equal treatment under European law (article 21 of the Charter of Fundamental Rights of the European Union and article 2 of the Treaty on European Union)? For sure, we'll have some complicated discussions here, such as: what about export to a country outside the Agreement (i.e., UK), in this case does export nevertheless constitute an act of infringement under French law or not? Does it depends on the type (EP/ unitary EP or FR) of patent you invoke, or not?

Observation no. 5: last but not least, should we prefer to be claimant or defendant? At first glance, this may seem a strange question, because, as litigators, we don't really choose, however, we can't help but wonder. It seems to me that everything depends on the claim. I won't propose any risk that seems too great for the time being, preferring to stick to classic litigation strategies ("à la française" with first a *saisie-contrefaçon* and then an action on the merits). Because I prefer security for my clients. Of course, this doesn't depend solely on me, and urgency may call for riskier procedures such as preliminary injunctions (that are very exciting in btw.); but I would only favor them if they appeared to be the only solution. The truth is, as it is often the case before the Courts, it might seem easier to defend a case, at least for the start of a new Court (more especially for this one in fact). Admittedly, the system requires (welcome) speed. That said, let's not forget that this system is still subject to numerous controversies which could easily justify an appeal to the European Union Court of Justice (see, for instance, here, one of the most interesting Miguel Montañá's posts). In other words, there is little doubt that the first defenses will soon see the emergence of this type of appeal to the EUCJ. Nor is this to be regretted, as it should strengthen the legitimacy of the system as a whole.

In conclusion, beyond these few thoughts, it seems clear that while the opening of the UPC will only become truly "historic" with the hindsight that only time can offer, there can be little doubt that, along with the unitary patent, UPC already constitutes a new tool offering a number of litigation strategies to its users to enforce their rights, which we can only welcome.

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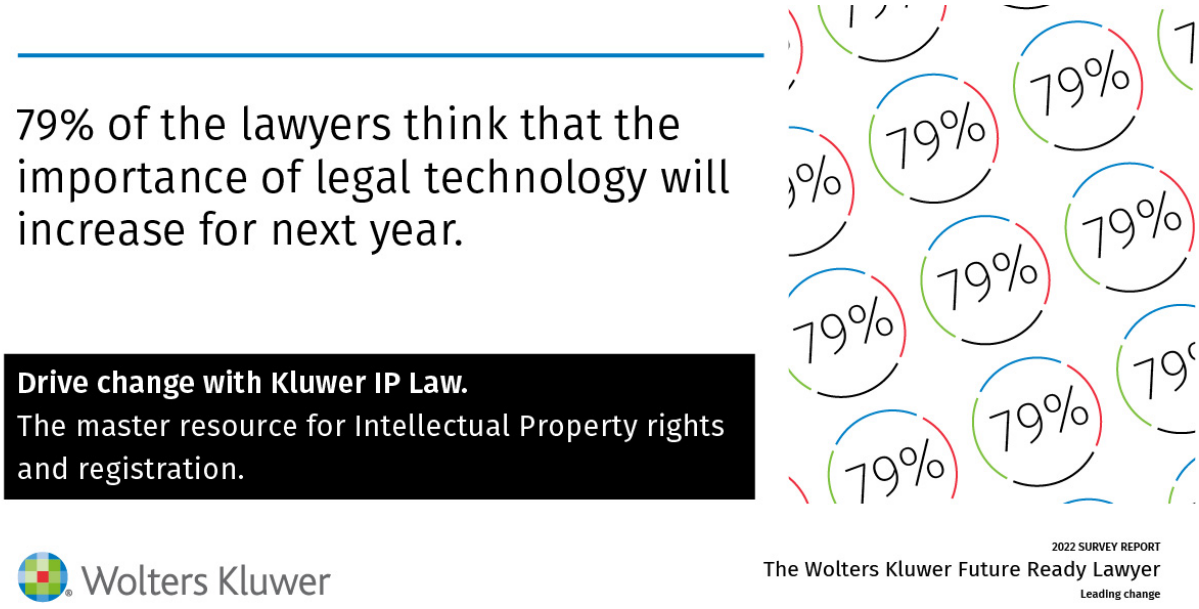

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