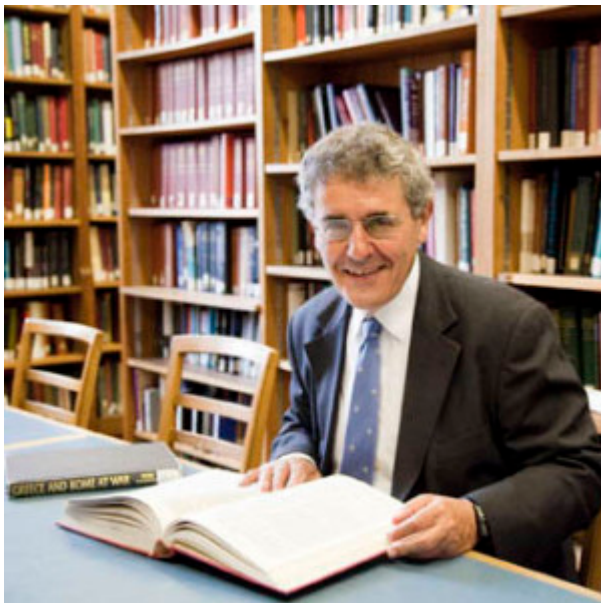


Kluwer Patent Blog

Unified Patent Court: ‘Conflicting decisions aren’t something of the past’

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The EPO has **recently announced** it will ‘accelerate its processing of parallel opposition proceedings if it is informed by the Unified Patent Court or a national court or competent authority of a contracting state that an infringement or revocation action relating to a European patent or a Unitary Patent has been instituted before it.’ It has been described as an effort to streamline patent cases within Europe, but it will not change much in practice, according to Sir Robin Jacob, former patent judge, one of the architects of the UPC, director of the Institute of Brand and Innovation Law of University College London and, last month, chairman of the UCL seminar ‘EPO and UPC: Friends or Foes?’



Sir Robin Jacob

In a zoom interview with Kluwer IP Law, Sir Robin points out that in practice the EPO can’t speed things up. ‘The European Patent Convention sets some time limits which are extendable, but not reducible. If you look at the overall time a European Patent Office opposition procedure takes, including an appeal you are looking at something of the order of four years. That is despite the fact they don’t have much sending back now. They’ve controlled that well. It took a lot of time to get rid of ping-pong and their times are coming down – but we’re still looking at the order of four years. It may be less, it may be three, but neither are anywhere short enough for a court to wait.’

The messy system of (inter)national courts and boards making conflicting decisions isn’t something of the past, according to Sir Robin: ‘The UPC has jurisdiction over the patent on the day of grant. So anybody who thinks they might be affected by this patent and wants an answer can go the court then. They can’t get a complete answer because it is possible the patent will be upheld in one or more non-UPC countries. You’ve got the United Kingdom, Switzerland, Spain, Norway, Turkey. So you’ve got a bunch, though even between them they are nowhere near economically as significant as the UPC territories.’

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And no patent case is fought all over the world, he says. ‘Parties fight in some countries, and then they settle or one side gives up. So suppose the UPC knocks the patent out. Will the parties proceed with carrying on in the EPO? Will the EPO be likely to disagree with the Patent Court? Very unlikely. It’s not like European countries now, with different evidence going in different jurisdictions. So I think if people get knocked out in the UPC, for the most they’ll give up.’

It could be a good strategic reason for parties not to choose the EPO opposition procedure, but go for a revocation action at the UPC instead, according to Sir Robin. ‘An EPO opposition is much cheaper, but much less certain and very slow, even though it’s been speeded up. The UPC would be much more expensive, but that’s warranted and it is still peanuts if it is a big patent case. And it’s not quite so easy to say that it is much more expensive. If you’ve got a strong case to knock down the patent, it may be you’ve got more pressure on the defending patentee, because they have to pay their own costs and those of the other side. It’s a ‘loser pays’ system.’

And if the patent is upheld in the UPC?

‘Then there’s the interesting question what happens if the EPO knocks it out or cuts down the scope. That’s a difficult question in any legal system. It’s true now. A patent can be upheld in one action and then fail in another action by another party, even in the same country. There has been a case in England where the patent was upheld and the court ordered damages. Before these were paid, the patent was revoked in other proceedings and the Supreme Court ruled no damages were payable. It might have been different if they had actually been paid.’

I have known some cases where the EPO narrowed the patent down compared with the national court. My last case as a barrister was in 1993. It concerned a patent on testing for hepatitis C. The UK patent office granted the patent. The patentees sued on the day of grant, had a trial within one year and the appeal within the next year. Three years later, the EPO cut the scope of the claims down. So those things happen and are going to happen always. It’s not a new problem at all.

National courts will be inclined to listen to what UPC says. But there may be cases where it hasn’t said anything – for example there might be a different piece of prior art that wasn’t considered. It might have been an obscure piece of prior art which wasn’t brought into the UPC proceedings, but a very good piece of prior art.’

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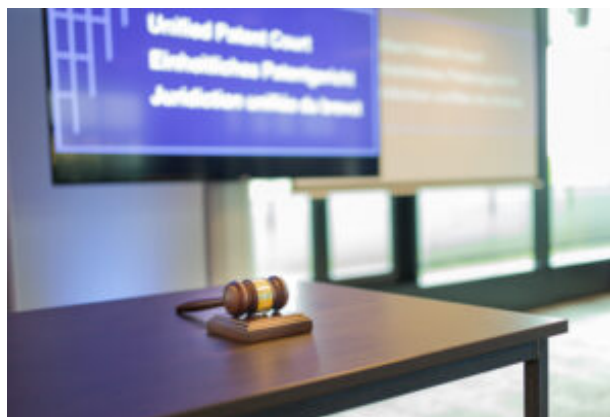
Sir Robin Jacob is not impressed with complaints about the quality of EPO patents, like they have been voiced among others by the [Industry Patent Quality Charter](#).

‘I call patent offices a coarse filter, like a net with big holes. So quite a lot gets through the net. And that’s inherent in every patent office, not just the EPO. And the reason it’s inherent is obvious. There’s only one person involved, the patentee. Patent office examiners are under quite a lot of pressure, timewise, and all they can do is take a broad view. The opposition division, of course, looks at it much more closely once it goes into opposition.’

It's not like a land dispute, where it's very clear what the conflict is about. The patent system is a probabilistic thing. Patents are valid or not valid depending on obviousness. That's a rather woolly expression, even though the EPO mistakenly tries to produce rules about it, or about 'sufficiency of description'. You can talk about these amorphous terms until you're blue in the face.'

For the topic of patent quality, Sir Robin refers to 'Raising the Bar: A mistaken Chimera?', a chapter he wrote in 2010 in *Concurrence Santé Publique, Innovation et Médicament*. A quote: 'So what is to be done about bad patents? The answer is not to worry about most of them. Most patents do not matter commercially so "raising the bar" for all patents, besides being impossible, would be a largely wasted exercise if it could be done. (...) The system should concentrate on the relatively few patents which do matter. Which these are is for the market to decide. What is needed is a better system to enable a party potentially affected by a particular bad patent to get rid of it. (...) What is needed is the creation of a European patent court staffed by judges who understand the system and particularly who recognise that a patent granted by the Office is no more than a patent which has passed the coarse filter of the Patent Office. There should be no strong presumption of validity. The court must be able to work fast, and particularly to respond with speed to applications for revocation when that matters commercially.'

It would take another 13 years before the UPC finally saw the light of day, including the speedy procedures and expert judges Sir Robin favoured. 'This is a very good system, I think. I hope. I was there when it was designed. The only thing I'm a bit worried about that it's going to be too strictly front-loaded. It's very expensive to get the case right from the outset. And it's maybe a bit too hard on defendants because they don't have very long time for filing their statement of defence and other documents. The court ought, in appropriate cases, to give them more time. Not too much at one go, because all lawyers do things at the last minute. So it's a question of when you fix the last minute.'



If you look at what's going on at the UPC this first period, are there things you're concerned about?

'I'm hearing one or two first instance decisions haven't been very satisfactory. I think fundamentally the biggest problem though, is the IT system, which is really inflexible. It's a very severe problem, the trouble is it was overdesigned. It's trying to imagine the litigation system as a series of steps. You have to fill up a form for the first step and then the next one and the next one. And it sets the times and so on. It's not how real litigation systems work, they're much more flexible. All sorts of things happen. I'm told that originally you could only have one plaintiff. And that if you're filling up a document and you want to go back and review it you can't. That's ridiculous. The judges are deeply unhappy, is what I'm hearing, it's driving them crazy.'

"I'm told that originally you could only have one plaintiff. And that if you're filling up a document and you want to go back and review it you can't. That's ridiculous. The judges are deeply unhappy, is what I'm hearing, it's driving them crazy"

When I was involved in the UPC's creation, I wasn't concerned about this. I said: just go out and see what IT court systems are being used in California, New York, Australia and do a deal with one of them. You'd have to do an upgrade of such system for the UPC, but that wouldn't be too much of an issue. Why have they tried to reinvent the wheel?'

You were closely involved in the creation of the court and now, due to the Brexit, you're on the sideline. What's that like?

'Very sad. Very sad. I'm still keeping contact with all my friends on the court, and I support it. I think one day UK may rejoin. I understand that technically speaking it is possible for the UK just to re-sign. No negotiations are needed. We can just do it.'

But how? The UK is not an EU member anymore.

'You don't have to be an EU member. You have to accept the jurisdiction of the European Court of Justice in case where a point of European law arises. But there aren't many points of EU law in patent cases. Sometimes there are competition law defences, and there are points on the Enforcement Directive, which was basically copied from English law, so there's nothing in it which is difficult as far as the Brits are concerned. The Directive took all the best bits of English procedural law.'

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