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# How to Avoid Banana Skins on the Path towards a more Unified Patent System

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There are now three interesting developments, albeit in quite different areas, which have in common the effort to avoid stepping on banana skins on the path towards a more unified patent system.

The first one, published last week, was a decision by the Court of Appeal (CoA) itself, which took the opportunity to clarify that a three member panel consisting only of legally qualified judges neither contravenes Art 9(1) UPCA nor violates Art 6 of the European Human Rights Convention (EHRC).

Why was this an issue? Because Art. 9(1) UPCA reads as follows:

> Any panel of the Court of Appeal shall sit in a multinational composition of five judges. It shall sit in a composition of three legally qualified judges who are nationals of different Contracting Member States and two technically qualified judges with qualifications and experience in the field of technology concerned. Those technically qualified judges shall be assigned to the panel by the President of the Court of Appeal from the pool of judges in accordance with Article 18 UPCA.

If you are just a humble patent attorney like yours truly, you might think that this Article could hardly have been drafted more clearly. Is it not evident that this provision requires that the CoA must decide its cases in a multinational composition of **five** judges, among which must be three legally qualified judges (LQJ) and two technically qualified judges (TCQ)?

How naive have I been. Read the judgment, dear readers. It's illuminating.

In fact, the CoA's judgment is almost a paradigm case of "purposive construction" of a seemingly clear statute. The CoA derives from the last clause of Art 9(1) that there is a sort of (core?) panel of three LQJs to which the President of the CoA assigns (may assign?) two TQJs.

> "The fact that technically qualified judges are assigned from the pool of judges, on the basis of their qualifications and experience in the field of technology concerned, confirms that they are not appointed permanently to the Court of Appeal and as such

> not part of the panel, until assigned to one on a case-by-case basis."

The very first clause, which in my humble opinion would have suggested the opposite, i.e. that the panel must contain five members, was not really discussed by the CoA, which instead placed a lot of emphasis on the field of technology *concerned*. It is certainly true that there are cases of a purely legal nature, which are as such not "concerned" with a field of technology. Adopting a narrow reading of Art 9(1) UPCA, the President of the CoA would then have to assign TQJs from an "unconcerned" field, which may be a bit awkward.

The CoA referred to several further provisions in the Statute and the Rules of Procedure from which it can be taken that the CoA can also sit *en banc*, i.e. decide an important case "by the full court", and that it may delegate certain tasks to a single judge. Well and good, but none of these provisions mention a three-member panel either.

I remain a bit concerned whether a three-member panel consisting of LQJs was really the composition intended by the drafters of the UPCA for purely legal questions. If so, they could have done a better job to clarify their intentions. Conversely, the interpretation reached by the CoA certainly is a pragmatic one, helps to economize on the UPC's resources, enables faster decisions, and above all, ensures that the CoA's previous decisions rendered in a three-member composition do not suddenly become illegal. Thus, a first banana peel was certainly avoided.

On the merits, the CoA decision dealt with the question whether, when and under which circumstances the public is allowed access to the written pleadings of the parties in a UPC case. The court's second headnote provides the general principles:

> When a request to make written pleadings and evidence available to a member of the public is made pursuant to R.262.1(b) RoP, the interests of a member of the public of getting access to the written pleadings and evidence must be weighed against the interests mentioned in Art. 45 UPCA. These interests include the protection of confidential information and personal data ('the interest of one of the parties or other affected persons') but are not limited thereto. The general interest of justice and public order also have to be taken into account. The general interest of justice includes the protection of the integrity of proceedings.

What the court means by “integrity of proceedings” seems to be mainly a situation where a **pending** case is openly discussed in the public domain in a way which may, in the worst case, influence the court:

> The protection of the integrity of proceedings ensures that the parties are able to bring forward their arguments and evidence and that this is decided upon by the Court in an impartial and independent manner, without influence and interference from external parties in the public domain. The interest of integrity of proceedings usually only plays a role during the course of the proceedings.

After a case has concluded, either by a decision or by settlement, however, the general interest of the public in free file inspection will usually prevail. And even during a pending case, third parties may obtain access to the written pleadings if they have a direct interest in the subject-matter of the proceedings, such as the validity of a patent that they are also concerned with as a competitor or licensee. Similarly, access may be granted where a party in the case is accused of infringing a patent by a product which is the same or similar to a product (to be) brought on the market by the third party. In such a case, the Court may, however, impose certain conditions on granting access, such as the obligation for that member of the public to keep the written pleadings and evidence he was given access to confidential as long as the proceedings are pending.

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The second banana skin was placed on the floor by Technical Board of Appeal (TBA) 3.2.01 in case T 439/22, where the TBA announced that it would refer legal questions of claim interpretation to the Enlarged Board of Appeal, in particular whether it is permissible to interpret a (seemingly) clear term in the claim by using the description. While reliance on the description for claim interpretation is pretty standard for any infringement court, and in fact mandated by Art 69 EPC, the case law by various TBAs of the EPO has been much less clear, and it seems that TBA 3.2.01 thinks that a clarification by the Enlarged Board of Appeal will therefore be necessary.

The TBA has not yet issued its decision. It plans to do so by June 2024, so let’s not spend too much time on this developing story now. I only hope that the EPO avoids the banana peel for a harmonized patent law by coming to a view on claim interpretation that is consistent with the clear and unanimous (as far as I can tell) view of the judges of the UPC, namely that interpretation is always necessary and that the description of the patent is the primary source to use.

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The third banana skin on the UPC’s path currently seems to lie in Ireland. The Irish government has now postponed the referendum to amend the constitution and allow transfer of (part of) its judicial sovereignty from Irish courts to the UPC, which was originally planned for June 7th. Thus, Ireland will not join the UPCA for a while.

In this article the Irish Times explicitly expressed the view that it is better to avoid a banana skin and allow voters to be properly briefed about the UPC than to risk another “resounding defeat” as recently happened with referendums on care and family. The journal mentioned a few factors – a lack of preparation, confused messaging, a lacklustre campaign – that might have been repeated in June, if the referendum had not been postponed.

As such, the Irish government's decision to postpone deftly clears another banana skin from the UPC's path, albeit just by kicking it down the road.

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