

**UNIFORM INTERPRETATION OF EUROPEAN PATENT LAW
WITH A SPECIAL VIEW ON THE CREATION OF
A COMMON PATENT COURT**

A study on judicial measures supporting
the uniform interpretation of patent law
in Europe

**EENVORMIGE UITLEG VAN EUROPEES OCTROOIRECHT IN
VERBAND MET DE OPRICHTING VAN EEN
GEMEENSCHAPPELIJK OCTROOIGERECHT**

Een studie naar de mogelijkheden
om de eenvormige uitleg van octrooirecht in Europa te bevorderen

(met een samenvatting in het Nederlands)

Proefschrift

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ABBREVIATIONS AND ACRONYMS

AC	Administrative Council of the European Patent Organisation
A.C.	Appeal Case
a.d.	anno domini
ADR	Alternative Dispute Resolution
Agreement relating to Community Patents	Protocol on a possible modification of the conditions of entry into force of the Agreement relating to Community patents
AIPLA	American Intellectual Property Law Association <www.aipla.org>
AIPPI	International Association for the Protection of Intellectual Property <www.aippi.org>
ALI	The American Law Institute <www.ali.org>
Art./Arts.	Article / Articles
AT	Country code for: Austria
BE	Country code for: Belgium
BGE	Bundesgerichtsentscheid: Decision of the Swiss Federal Supreme Court
Brussels Convention	EEC - Convention on Jurisdiction and the Enforcement of Judgements in Civil and Commercial Matters of 27 September 1968
BNA	Bureau of National Affairs (USA)
CCPR	International Covenant on Civil and Political Rights of 16 December 1966
CEIPI	Centre d'études internationales de la propriété industrielle <www.ceipi.edu>
CH	Country code for: Switzerland (Confoederatio Helvetica)
COPAC	Common Appeal Court of the Community Patent Convention
CP Protocol on Litigation	Protocol on the Settlement of Litigation Concerning the Infringement and Validity of Community Patents
CP Green Paper	Green Paper on the Community patent and the patent system in Europe of 24.6.1997, COM(97) 314 final
CP Regulation proposal	Proposal for a Council Regulation on the Community patent of 1.8.2000, COM(2000) 412 final
CP Court jurisdiction	Proposal for a Council Decision conferring jurisdiction on the Court of Justice in disputes relating to the Community patent of 23.12.2003, COM(2003) 827 final
CP Court proposal	Proposal for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance of 23.12.2003, COM(2003) 828 final
CPC	Community Patent Convention
DE	Country code for: Germany (Deutschland)
draft HJC	Preliminary Draft for a Hague Jurisdiction Convention
draft EPLA	Draft Agreement on the establishment of a European patent litigation system (WPL/10/05)
draft Statute	Draft Statute of the European Patent Court (WPL/SUB 8/05)
e.g.	exempli gratia: for instance
EC	European Community

EC Treaty	Treaty establishing the European Community
EEC	European Economic Community
ECtHR	European Court of Human Rights < www.echr.coe.int/echr/ >
ECHR	Convention for the Protection of Human Rights and Fundamental Freedom of 4.11.1950
ECJ	European Court of Justice < curia.europa.eu/ >
ECJ Court of First Instance	The Court of First Instance of the European Communities
EFTA	European Free Trade Association < www.efta.int/ >
ed.	Editor / edition
eds.	Editors
Enforcement Directive	Directive of the European Parliament and of the Council No. 48/2004 on the enforcement of intellectual property rights of 29.4.2004
EPC	Convention on the grant of European patents (European Patent Convention) of 5.10.1973, last revised on 29.11.2000
epi	European Patent Institute – Institute of Professional Representatives before the European Patent Office < www.patentepi.com >
EPJ	European Patent Judiciary
EPLA	European Patent Litigation Agreement
EPLAW	European Patent Lawyers Association < www.eplaw.org/ >
EPLP	European Patent Litigation Protocol (initial terminology for the EPLA)
EPO	European Patent Office < www.epo.org/ >
ES	Country code for: Spain (España)
ETH	Eidgenössische Technische Hochschule: Swiss Federal Institute of Technology
et al.	et alii: and others
et seq.	et sequens: and following
EU	European Union < europa.eu/ >
EU Council	Council of the European Union
EU Treaty	Treaty on European Union
European Patent Convention	See EPC
EWCA civ	England and Wales Court of Appeal (Civil Division)
EWHC	High Court of England and Wales
Fed. Cir.	US Court of Appeals for the Federal Circuit
fig.	figure
FR	France
HCC	The Hague Convention on Choice of Court Agreements of 30.6.2005
HJC	Hague Jurisdiction Convention; Project of the Hague Conference on Private International Law for a world-wide agreement on

	Jurisdiction and Foreign Judgments in Civil and Commercial matters
IBA	International Bar Association <www.ibanet.org>
ibid.	ibidem: on the same book or in the same decision
id.	idem: the same author
i.e.	id est: that is or that is to say
ILA	The International Law Association <www.ila-hq.org>
Inf./Info	Information
INPI	Institut national de la propriété industrielle: French national institute of industrial property
IP	Intellectual property
IPR	Intellectual property rights
IT	Country code for: Italy
LI	Country code for: Liechtenstein
LU	Country code for: Luxembourg
Lugano Convention	EC-EFTA Convention on Jurisdiction and the Enforcements of Judgments in Civil and Commercial Matters of 16.9.1988
MEP	Member of the European Parliament
n.	Footnote
N	Note
N.D. Ill.	US District Court Northern District of Illinois
New York Convention	UN Convention on the Recognition and Enforcement of Foreign Arbitral Awards of 10.6.1958
NL	The Netherlands
No.	Number
Paris Convention	Paris Convention for the Protection of Industrial Property of 20.3.1883
CH-LI Patent Protection Treaty	Vertrag zwischen der Schweizerischen Eidgenossenschaft und dem Fürstentum Liechtenstein über den Schutz der Erfindungspatente (Patentschutzvertrag) of 22.12.1978
PCT	Patent Cooperation Treaty of 19.6.1970
Reg 44/LC	Regulation 44/2001, Lugano Convention
Regulation 44/2001	Council Regulation (EC) No. 44/2001, on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters of 22.12.2000.
Rep.	Reports
Rome II proposal	Proposal for a Regulation of the European Parliament and Council on the law applicable to non-contractual obligations, ("Rome II") of 22.7.2003, COM(2003) 427 final, 2003/0168 (COD)
Rome II Regulation	European Parliament and Council Regulation (EC) No. 864/2007, of the on the law applicable to non-contractual obligations ("Rome II") of 11.7.2007.
SCP	WIPO Standing Committee on the Law of Patents
Sec.	Section
Ser.	Serie
Strasbourg Convention	Convention on the Unification of Certain Points of Substantive Law on Patens for Invention of 27.11.1963
Statute of the ECJ	Protocol on the statute of the Court of Justice

SUB	WPL sub-group
Treaty of Lisbon	Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community of 13.12.2007
TRIPs Agreement	Agreement on Trade-Related Aspects of Intellectual Property Rights, including Trade in Counterfeit Goods of 5.4.1994
UNCITRAL Arbitration Rules	UNCITRAL Arbitration Rules, adopted by the UN General Assembly Rules on 15.12.1976
Vienna Convention	Vienna Convention on the Law of Treaties of 25.3.1969
VPP	Vereinigung von Fachleuten auf dem Gebiet des gewerblichen Rechtsschutzes < www.vpp-patent.de >
UK	Country code for: United Kingdom
UN	United Nations
US	Country code for: United States
USA	United States of America
vol. / vols.	Volume(s)
WIPO	World Intellectual Property Organisation < www.wipo.int/portal/index.html.en >
WPL	Working Party on Litigation as mandated by the EPC contracting states
WTO	World Trade Organisation < www.wto.org >

ABBREVIATIONS AND ACRONYMS OF BOOKS, DOCUMENTS AND PERIODICALS

AIPLA Q.J.	AIPLA Quarterly Journal (USA)
AJIL	American Journal of International Law (USA)
AJP	Aktuelle Juristische Praxis (CH)
All E.R.	All England Law Reports (UK)
AM.J.COMP.L.	The American Journal of Comparative Law (USA)
CA/ ...	Document of the Administrative Council of the European Patent Organisation
CA/PL ...	Document of the Committee on Patent Law of the European Patent Organisation
CASE W. RES. J. INT'L LAW	Case Western Reserve Journal of International Law (USA)
C.L.J.	Cambridge Law Journal (UK)
CML REV.	Common Market Law Review (NL)
ECR	European Court Reports (EU)
E.L.J.	European Law Journal (IT/FR/UK)
E.L.R.	European Law Reporter (LU/CH)
E.L.REV.	European Law Review (UK)
EIPR	European Intellectual Property Review (UK)
EuZ	Zeitschrift für Europarecht (CH)
EUZW	Europäische Zeitschrift für Wirtschaftsrecht (DE)
F.2d	Federal Reporter (2 nd Series; USA)
F. Supp.	Federal Reporter, Supplement (USA)
F.S.R.	Fleet Street Reports (UK)
GRUR	Gewerblicher Rechtsschutz und Urheberrecht (DE)
GRUR INT.	Gewerblicher Rechtsschutz und Urheberrecht Internationaler Teil (DE)
H.L. Cas.	Clark's House of Lords Cases 1847-1866 (UK)
HARV.INT'L.L.J.	Harvard International Law Journal (USA)
HARV.L.R.	Harvard Law Review (USA)
ICQL	International and Comparative Law Quarterly (UK)
IIC	International Review of Industrial Property and Copyright Law (DE)
I.L.Pr.	International Litigation Procedure (UK)
ICIP-ING.CONS.	L'Ingenieur Conseil - Intellectual Property (BE)
IPQ	Intellectual Property Quarterly (UK)
IPRax	Praxis des Internationalen Privat- und Verfahrensrechts (DE)
J.D.I.	Journal du Droit International (FR)
JIPLP	Journal of Intellectual Property Law & Practice (UK)
JWIP	The Journal of World Intellectual Property (CH/UK)
JZ	Juristen-Zeitung (DE)
LQR	The Law Quarterly Review (UK)
MICH. J. INT'L. L.	Michigan Journal of International Law (USA)
Mitt.	Mitteilungen der deutschen Patentanwälte (DE)
Mitt. CH	Mitteilungen der Schweizergruppe der Internationalen Vereinigung für Gewerblichen Rechtsschutz (CH)
NJ	Nederlandse Jurisprudentie (NL)
NJW	Neue Juristische Wochenschrift (DE)

ÖBI	Österreichische Blätter für gewerblichen Rechtsschutz und Urheberrecht (AT)
O.J. EPO	Official Journal of the European Patent Office (EPO)
O.J. EC	Official Journal of the European Community (EU)
P.I.P.D.	Propriété Industrielle Bulletin Documentaire (FR)
p.i.	Propriétés intellectuelles (FR)
propr. industr.	Propriété industrielle (FR)
RABELSZ	Rabels Zeitschrift für ausländisches und internationales Privatrecht (DE)
R.D.P.I.	Revue du Droit de la Propriété Intellectuelle (FR)
RIW	Recht der Internationalen Wirtschaft (DE)
RPC	Reports on Patent, Design and Trademark cases (UK)
SJZ	Schweizerische Juristenzeitung (CH)
SMI	Schweizerische Mitteilungen über Immaterialgüterrecht (CH)
sic!	Zeitschrift für Immaterialgüter-, Informations- und Wettbewerbsrecht (CH)
SZIER	Schweizerische Zeitschrift für Internationales und Europäisches Recht (CH)
TEX.INTELL.PROP.L.J.	Texas Intellectually Property Law Journal (USA)
TIBTECH	Trends in Biotechnology (UK)
U.Pa.L.Rev.	University of Pennsylvania Law Review (USA)
U.S.P.Q.	United States Patent Law Quarterly (USA)
VA.J.INT'L.L.	Virginia Journal of International Law (USA)
VAND.J.TRANSNAT'L.L.	Vanderbilt Journal of Transitional Law (USA)
VPP-Rundbrief	Rundbrief der Vereinigung von Fachleuten auf dem Gebiet des gewerblichen Rechtsschutzes (DE)
WASH.U.J.L. & POL'Y.	Washington University Journal of Law & Policy (USA)
WIPO/ACE/...	Document of the WIPO Advisory Committee on Enforcement
WPL/.../..	Document of the Working Party on Litigation (European Patent Organisation)
WPL/SUB .../..	Document of the Sub-group of the Working Party on Litigation (European Patent Organisation)
WIPR	World Intellectual Property Report (USA/UK)
Y.B.E.L.	Yearbook of European Law (UK)
ZBJV	Zeitschrift des Bernischen Juristenvereins (CH)
ZEuP	Zeitschrift für europäisches Privatrecht (DE)
ZEuS	Zeitschrift für europarechtliche Studien (DE)
ZfRV	Zeitschrift für Rechtsvergleichung (AT)
ZRP	Zeitschrift für Rechtspolitik (DE)
ZSR	Zeitschrift für schweizerisches Recht (CH)
ZZP	Zeitschrift für Zivilprozess (DE)
ZZPInt	Zeitschrift für Zivilprozess International (DE)

INTRODUCTORY NOTE

There are three instruments which exist at the European level dealing with the jurisdiction, recognition and enforcement of judgments in civil and commercial matters:

- The Council Regulation (EC) No. 44/2001, on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters of 22.12.2000 (Regulation 44/2001; Reg 44),
- The EEC - Convention on Jurisdiction and the Enforcement of Judgements in Civil and Commercial Matters of 27 September 1968 (Brussels-Convention), and
- The EC-EFTA Convention on Jurisdiction and the Enforcements of Judgments in Civil and Commercial Matters of 16.9.1988 (Lugano-Convention; LC).

On 1 July 2007, the agreement between the European Community and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters of 20.9.2005 entered into force. The Brussels Convention, which had only been binding and applicable between the EU member states and Denmark since Regulation 44/2001 was entered into force, was thereby replaced by this agreement. Under this agreement, the provisions of Regulation 44/2001, which are of importance for this thesis, became likewise applicable to the territory of Denmark. Consequently, the definition of Regulation 44/2001 as used in the thesis includes Denmark in its scope of applicability as well.

In order to avoid lengthy references to the relevant sources highlighted in the footnotes, the bibliography includes a list of all abbreviations of the articles or books quoted more than once in the thesis.

The present work takes into account developments until 1 May 2008.

CHAPTER ONE: GENERAL INTRODUCTION

The European Patent Convention (EPC)¹ is a regionally limited international treaty² concluded and ratified by several European states. It established the European Patent Organisation³ and a system of law, common to the EPC contracting states, for the granting of patents for invention⁴, including both substantive and procedural law⁵. This system co-exists with the national patent systems of the EPC contracting states. The European Patent Organisation has the task of granting patents based on this legal system⁶. The EPC contracting states have thus transferred the sovereign right to examine a patent application and to grant a patent with effect for their territory to the European Patent Organisation. However, they remained responsible for the enforcement of those patent rights. The European Patent Office (EPO), as organ of the European Patent Organisation, carries out the task⁷ to grant these so-called "European patents", if the legal requirements of the EPC are met.

Article 2 (2) EPC provides that the European patent should, in each of the contracting states for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that state, unless otherwise provided by the EPC. Furthermore, Article 64 (1) EPC makes it clear that a European patent must confer on its holder in each of the contracting states in respect of which it is granted, the same rights as would be conferred by a national patent granted in that state. As a consequence of this construction the European patent is qualified as a so-called "bundle patent", a bundle of European patents with the effects of a national patent. The fact, however, that the European patent is granted based upon the patentability requirements as determined in the EPC, and that the patent's scope is defined and that it is revoked by European law also makes it clear that it is not correct to simply speak of a "bundle of national patents"⁸, as it is often done.

¹ Convention on the Grant of European Patents of 5 October 1973, available at <www.epo.org>.

² Cf. *Ballreich/Haertel*, 334; Opinion of the ECJ relating to the WTO Agreement, 1995 GRUR INT., 239-250, 250.

³ Cf. Art. 4(1) EPC.

⁴ Cf. Art. 1 EPC.

⁵ Cf. *Waage*, N 1-8; *Ballreich/Haertel*, 334.

⁶ Cf. Art. 4(3) EPC.

⁷ Cf. Art. 4(3) EPC.

⁸ Cf. *Haertel/Kolle*, 12; *Beier*, MGK 1, N 9; *Stauder*, *Vom*, 44; *Hölder*, *Grenzüberschreitende*, 26.

The "bundle" approach has the consequence that European patents and the related law are assessed by the EPO - Examining Divisions, Opposition Divisions, the EPO Boards of Appeal and the EPO Enlarged Board of Appeal - and by a great number of national judges and members of other authorities who are bound by national case law and are part of the national judicial system⁹.

Another consequence is that the patent holder must initiate several parallel infringement actions, based on the same European patent and directed against the same alleged infringer before the national courts in the states where the infringing acts have taken place.

In the case of the revocation of a European patent alleged infringers or competitors must file revocation actions in all the states for which the European patent was granted once the 9-months time limit for filing an opposition before the EPO¹⁰ has expired or the opposition proceedings are concluded with a rejection of the opposition.

This situation gives rise to many difficulties for the parties and has several undesirable effects which weaken the patent system in Europe:

- First, it is costly for the patent holder and the alleged infringer who must not only hire local lawyers, patent attorneys and experts, and pay court fees in all states where litigation is initiated, but also divert resources to the unsettling business of litigation in several jurisdictions. This is particularly problematic for small- and medium-sized enterprises. But it is also unsatisfactory for the EPC contracting states and their often highly subsidised court systems since several judges must deal, independently of each other, with infringement and/or nullity actions involving the same European patent and the same parties.

⁹ Cf. *Brinkhof, Change*, 104.

¹⁰ Once a patent is granted any person - with the exception of the patent holder - may give notice to the EPO of opposition to the granted patent within 9 months (cf. Art. 99-105 EPC). The opposition may basically only be filed on the grounds that

- the subject matter of the European patent is not patentable,
- the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art, or
- the subject matter of the patent extends beyond the content of the application as filed.

The opposition proceedings end by a decision of the responsible EPO Opposition Division to either maintain the patent, to partly revoke it or to fully revoke it. A decision of the Opposition Division can be appealed to the EPO Boards of Appeal.

- Second, patent holders must often make crucial business decisions relating to licensing, investments, production and marketing of patented products on the basis of complicated assessments regarding the likely outcome of a number of cases dealt with in various jurisdictions.

- Third, the differences among the national patent litigation systems lead to *forum shopping* which can end in injustice, as shown later.

- Fourth, the EPO and the national authorities interpret the EPC and their corresponding national patent law in a diverging way. This leads to legal uncertainty which not only affects the parties involved but also competitors and the public at large particularly since a patent is granted in order to exclude others from using an invention in the market and in the territory for which the patent is granted. Patent litigation experts and judges started to talk about this unsatisfactory situation at the end of the eighties and became fully aware of the implications in the beginning of the nineties when the "Epilady" case became public¹¹. In this case, on the same European patent, courts of five EPC contracting states decided that the patent was infringed whereas courts of four EPC contracting states ruled otherwise, namely that the patent was not infringed.

The crucial question in this regard is: do we have to accept this situation of diverging interpretations since the EPO grants a "bundle patent", or is there actually a duty for a uniform interpretation of the law that serves as the legal basis for European patents, i.e. the EPC and the corresponding national patent laws that implemented the EPC into national law?

The fact that the European patent is a "bundle patent" suggests that the different parts of the patent can have a separate destiny. Some could be revoked, others limited¹². The extent of protection of the different parts of the European patent could consequently vary due to diverging claims. Hence, it could very well be that European patents are interpreted in a different way. The question should therefore rather be whether diverging

¹¹ *Improver Corp. et al. vs. Raymond Industries Ltd. et al.*, cf. 1990 IIC, 561-571; 572-580; 580-585; 586-589; 589-591; 857-859; 860-868; 1992 IIC, 391-394; 394-397; 1993 IIC, 388-390; 803-804; 832-838; 838-845. Also cf. Marshall Hans, Patent Infringement Suit: The EPILADY Case and Issues at Stake, Enforcement of Intellectual Property Rights and Patent Litigation, *EPOscript* vol. 6, Munich 2002, 368-428.

¹² Cf. Hölder, *Grenzüberschreitende*, 83.

interpretations of the law with regard to the corresponding parts of a European patent should be accepted because of the bundle approach.

The answer lies in the legal qualification of the EPC. As an international treaty, it is binding law that is applicable in more than one state and serves a certain legal purpose. Such law is commonly qualified as international "uniform law"¹³.

The fact that the EPC and corresponding national patent law implementing the EPC is "uniform law"¹⁴ (or better "European patent law") requires that it is construed in an international spirit¹⁵ based on its *ratio* and with a view to create cross-border legal uniformity¹⁶. It must, therefore, be interpreted correctly and in a uniform way by all authorities who are dealing with European patents¹⁷. A common European patent court which would ensure a unitary interpretation of the European patent law is missing. Certainly this does not mean that the authorities would be liberated from the obligation to reach a harmonised result and that they are totally free in their decision-making process. They are forced to a legal comparative interpretation by taking each other's legal understanding and case law into practical consideration in order to reach this goal¹⁸. This is particularly important if they deal with the extent of protection¹⁹ (Article 69 EPC) and the revocation grounds (Article 138 EPC), as well as thereof related patentability criteria²⁰ (Articles 52-57 EPC) of a European patent. For example, in the United Kingdom, Sec. 130 (7) Patents Act 1977 obliges (*inter alia*) the judges to construe certain provisions of the act "as nearly as practicable" in a "European" way. That is to say they have to bear in mind that these provisions have the same effect as corresponding provisions of the EPC in other contracting states²¹.

¹³ Cf. *Kropholler, Internationales*, 1; *Linhart*, 3-5; *Walter H.P., Auslegung*, 866.

¹⁴ Cf. *Allen/Gielen*, 220.

¹⁵ Cf. *Kropholler, Internationales*, 240.

¹⁶ Cf. *Walter H.P., Auslegung*, 866; *Hölder, Grenzüberschreitende*, 88; 138. Cf. also Decision of the Swiss Federal Supreme Court of February 28, 2007 (4C.403/2005) and 2007 sic! 641-644.

¹⁷ Cf. *Haertel/Stauder*, 88; *Brinkhof, HvJ*, 320; *Kur, A Farewell*, 850; *Ullrich, National*, 15-16; *Rogge, Revocation*, 223.

¹⁸ Cf. *Haertel Kurt, Die Harmonisierungswirkung des Europäischen Patentrechts*, 1981 GRUR INT., 479-490, 490; *Kropholler, Internationales*, 280-281.

¹⁹ Cf. *Steinacker*, 24; *Hölder, Grenzüberschreitende*, 140; *Tilman/Jacob*.

²⁰ See Art. 138(1)(a) EPC. Cf. also *Steinacker Gisbert in: Grabrucker*, 890; *Girardet*, 36-37; *Nuss Albert, Aspects of the patentability of broad patent claims under the EPC*, Special edition No. 2 of the 2001 O.J. EPO, 66-81; *Pumfrey Nicholas, Patent protection of broad claims*, Special edition No. 2 of the 2001 O.J. EPO, 82-93.

²¹ Cf. *Paterson*, N 1-84; *Kolle/Stauder, Symposia*, 956; *Bruchhausen, Interpretation*, 736.

One might wonder, therefore, why many national authorities remained hesitant to analyse each other's decisions and pursue a uniform interpretation. Neither the lack of respect among the judges²² nor the knowledge that unified substantive patent law had to be interpreted²³ seemed to be the problem. It turned out that the majority of the judicature had the basic understanding that it had to fulfil its tasks by a strict *national* interpretation of European and adapted national patent law.

The judges justified this approach on a more or less unlimited principle of territoriality based on the bundle approach of a European patent given by the legislature²⁴. The main reason, however, appears to be not least of a rather political nature since it seems to be generally accepted that even a strict understanding of the principle of territoriality, as very much inherent in patent law, would allow the consideration of "foreign" law and consequently other judgments, as well when interpreting its "own" patent law²⁵. But there is also a certain tradition that the courts in civil law countries feel more bound to their "own" law and less to achieving uniformity of the law, whereas the courts in common law countries take a more universal look at the law²⁶.

There are indications and grounds in the structure of the EPC that seem to support the view of the rather reluctant judges:

- First, Article 64 (1) EPC provides that a European patent has to confer on its patent holder, in each of the EPC contracting states for which it is granted, the same rights as would be conferred by a national patent granted in that state once it has been granted. In addition, any infringement of a European patent is dealt with by national law (Art. 64 (3) EPC).
- Second, in many national patent laws, the question of patentability intentionally differs from the wording of the EPC²⁷.

²² Cf. *Jacob, Decisions*, 13.

²³ Cf. Beier Friedrich-Karl in: *Kolle/Stauder, 1st Symposium*, 828-829.

²⁴ Also cf. *Brinkhof, Desirability*, 226.

²⁵ Cf. *Vischer, IPR*, 679.

²⁶ Cf. *Kropholler, Internationales*, 130.

²⁷ Cf. *Gall*, 141.

- Third, essential questions of patent law (such as sanctions, the lapse of the patent, the transfer or licensing of the patent) have not been addressed in a uniform manner by the EPC contracting states²⁸.
- Fourth, the fathers of the EPC did not provide for a possibility²⁹ of the national courts to request to the EPO Enlarged Board of Appeal an opinion with regard to questions of law in order to promote uniform application of law³⁰.
- Fifth, there is no clear provision in the EPC that decisions of the EPO are paramount and binding on courts and authorities in the contracting states, or at least have to be taken into consideration by them³¹. There are also no rules which would make it clear that a court of a contracting state has to take due account of the decisions of the courts of the other contracting states when interpreting the EPC or the corresponding national patent law implementing the EPC³².
- Sixth, whereas the member states of the EC decided to have a common court ensuring a unitary interpretation and development of case law with regard to Community patents³³, it was decided by the EPC contracting states that the interpretation of European patents should be left to national jurisdiction.
- Seventh, the Protocol on the Interpretation of Article 69 EPC is intentionally flexible. The protocol basically aims at a unitary interpretation³⁴, but in the end only outlines the extent

²⁸ Cf. *Walter H.P., Auslegung*, 869; *Stauder, Significance*, 794; *Bruchhausen, Ausgleichsansprüche*, 707-709; also cf. criticism raised by French experts in regards to the first draft for a CPC because of its lack of unification of the legal sanctions in: *Stauder, Future*, 176.

²⁹ Article 25 EPC, however, provides for the possibility to the national courts trying an infringement or revocation action to request a technical opinion of the EPO Examining division concerning the European patent which is subject of the action.

³⁰ Cf. Arts. 22 and 112 EPC.

³¹ Cf. *Bruchhausen, Interpretation*, 736; *Steinacker*, 18-20; *Schachenmann*, 510.

³² Such a rule would not be unusual, cf. *Linhart*, 211. Art. 1 Protocol No. 2 Lugano Convention on the uniform interpretation of the convention for example provides that the courts of each contracting state have to, when applying and interpreting the provisions of the convention, pay due account to the principles laid down by any relevant decisions delivered by courts of the other contracting states concerning provisions of the convention.

³³ Cf. §1 D.I. Aims and development.

³⁴ Cf. *Stauder Dieter in: Singer/Stauder, 3rd edition*, Art. 69, N 3 to N 4; *Kühnen Thomas in: Schulte*, §14, N 15; *Scharen Uwe in: Benkard, EPÜ*, Art. 69, N 1.

of protection³⁵. The revised version of the EPC, the "EPC 2000", did not change anything in this regard³⁶.

There were, however, some national courts and other authorities - supported by doctrine - that argued that they were given greater "flexibility"³⁷ by the EPC, and shared the view that their decisions were elements of the European patent system and that they were, thus, required to consider and examine the decisions of the EPO and the courts of other EPC contracting states³⁸ in order to apply the European patent law in a uniform way.

Following grounds indicate that a pro-European interpretation was actually desired by the states upon signature the EPC:

- First, a large part of national patent laws have been unified with European and Community law³⁹ (so-called "cold harmonisation"⁴⁰) in order to achieve legal uniformity.

- Second, the preamble of the EPC is clearly intended to inspire a stronger cooperation among the contracting states in respect of the protection of inventions, and that such protection may be obtained in those states by the establishment of certain standard rules governing patents so granted⁴¹.

- Third, Article 2 (2) EPC provides that the European patent must, in each of the contracting states for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that state, unless otherwise provided by the

³⁵ Cf. *Armitage, Interpretation*, 812-815; *König, Probleme*, 303-304; Tilmann Winfried/Dagg Nicola, EU-Patentrechtsharmonisierung I: Schutzzumfang, 2000 GRUR, 459-468, 459; *Brändle, Interpretation*, 876-877, 882; *Jacob, Decisions*, 15; *Treichel*, 85-86; *Wadlow*, N 5-16; *O'Sullivan*, 661; also cf. *Stauder, History*, 327.

³⁶ Cf. *Blind Sonia, Révision de la Convention sur le brevet européen: résultats de la Conférence diplomatique du 20 au 29 novembre 2000*, Munich, 2000 sic!, 54-59, 56; Blumer Fritz, *Schweizerisches Patenterteilungsverfahren, Schweizerisches und europäisches Patentrecht*, Bertschinger Christoph/Münch Peter/Geiser Thomas (eds.), Basel et al. 2002, §14 Schutzbereich des Patents, N 14.22; *Stauder Dieter in: Singer/Stauder, 3^d edition*, Art. 69, N EPC 2000.

³⁷ Cf. *Bruchhausen, Interpretation*, 736; *Jacob, Decisions*, 14; *Walter H.P., Auslegung*, 869; *König, Probleme*, 302.

³⁸ Cf. *Brändle, Interpretation*, 878; *Walter H.P., Auslegung*, 869-870; *Steinacker*, 20; *Girardet*, 30; *Jacob, Decisions*, 15; *Davies, Gillian*, 46; also cf. already *Gall*, 140; *Armitage, Interpretation*, 817.

³⁹ Cf. *Haertel, Harmonisation*; *Gall*, 141; *Beier, MGK 1*, N 23; this could, however, also be used as an argument contra since there are still many differences from all the national patent laws to the EPC. For an overview cf. *Krasser, MGK 22*.

⁴⁰ Cf. *Ballreich/Haertel*, 336.

⁴¹ Cf. *Brinkhof, Desirability*, 227; *Grabinski, Determination*, 866; *Stauder Dieter in: Singer/Stauder, 3^d edition*, Preamble, N 4; *Ullmann Eike/Grabinski Klaus in: Benkard, EPU, Präambel*, N 3.

EPC. The final part of this provision makes it clear that the effect of the European patent is mainly determined by the EPC, as it results in a highly autonomous European system of law governing European patents⁴².

- Fourth, the preparatory works of the EPC⁴³ and especially of Article 69 EPC⁴⁴ indicate that unity of law was intended.

- Fifth, the uniform determination of the extent of protection is safeguarded if a patent is amended during opposition proceedings which seem to imply that the national courts should stick to the same approach⁴⁵.

All these indications support the view that the European patent system is build up on the necessity of a uniform interpretation of the relevant provisions before and after grant. Nevertheless, ambiguity cannot be denied and arguably there is only a limited conviction among the EPC contracting states to aim for a true unification of jurisdiction, and accept the necessary abdication of sovereignty in modelling their respective economic policies⁴⁶.

In addition to these political obstacles a further psychological and cultural, nonetheless an important aspect has influenced this reluctance towards a "Europeanised" interpretation: The strong differences in legal cultures⁴⁷ and approaches toward the interpretation of law between the common and the continental law systems⁴⁸ have provoked reservations between the judges from the two systems⁴⁹. In farming oriented states, there is a saying for this situation: "*Was der Bauer nicht kennt, das frisst er nicht*" (A farmer does not eat something he does not know).

All in all, it is not really a surprise, therefore, that until not so long ago many patent judges seemed to treat the interpretation of the European patent (law) as a national rather than an international "affair".

⁴² Cf. Stauder Dieter in: *Singer/Stauder*, 3rd edition, Art. 2 N 8.

⁴³ Cf. *Haertel/Stauder*, 88; *Hölder*, *Grenzüberschreitende*, 136.

⁴⁴ Cf. *Grabinski*, *Determination*, 866; cf. also *Pagenberg/Köster*.

⁴⁵ Cf. *Grabinski*, *Determination*, 867.

⁴⁶ Cf. also *Brinkhof*, *Wish List*, 408 with regard to patent law as a tool of economic policy.

⁴⁷ Cf. *Stauder/Llewelyn*.

⁴⁸ Cf. *Walter H.P.*, *Auslegung*, 866-867.

⁴⁹ Cf. *Haertel/Stauder*, 86.

But it should also be considered that there are always national principles and policies, as well as subjective perceptions which could influence a judge in his or her decision-making process⁵⁰, not least with regard to rules where the different legal traditions⁵¹, as well as highly economic and political aspects of patent law appear. There is consequently also a certain reluctance of courts to indirectly attack the national policy of another state by providing a different interpretation of the law when judging the question of infringement of a "foreign" part of the European patent⁵² even if they feel that their interpretation is in fact "European" and therefore beyond national understandings. Respecting the independence and equality of the other courts and states consequently also provokes hesitations on the way to reach a uniform interpretation of unitary law. As a consequence, a judgment of a court from another state, the EPO Boards of Appeal or the EPO Enlarged Board of Appeal was many times hardly, or very reluctantly taken into consideration and reflect upon, if at all⁵³. The "Epilady" case was the trigger for a change in this situation.

However, up to today the courts could not agree on a common line with regard to all legal questions. Diverging decisions did not remain an isolated incident of the past. The opposite is the case as very recent decisions show⁵⁴, although there are many examples where courts clearly recognised the need for a uniform interpretation⁵⁵, and obviously even adjusted their methods of interpretation and legal practice⁵⁶.

⁵⁰ Cf. *Walter H.P., Auslegung*, 866; *König, Probleme*, 298; 302-303.

⁵¹ Cf. Stauder Dieter in: *Singer/Stauder, 3rd edition*, Art. 69 N 17.

⁵² Also cf. §3 C.VI.2. Policy making by applying foreign law and the problem of recognition; also cf. *Brändle, Interpretation*, 881; *Grabinski, Determination*, 872.

⁵³ Cf. *Jacob, Decisions*, 13; cf. also *Brinkhof, European patent*, 33-4.

⁵⁴ Cf. for example, *Angiotech Pharmaceuticals v Conor Medsystems Inc/Conor Medsystems Inc v Angiotech Pharmaceuticals* reported by Burgers Peter/Gerritzen Frits, "Stent wars" divide Europe, May 2007 Patent World, 19-20; *Document Security Systems v European Central Bank* (2007) where the English courts ([2008] EWCA Civ 192) together with French courts have reached different decisions on the validity of a European patent than their German and Dutch colleagues, cf. *Fröhlinger*, 81 and <ipgeek.blogspot.com/>, Europe's patent demise, 24 March 2008; *Pozzoli v BDMO SA* (2007 EWCA Civ 588) reported by Judge Jacob, EPLA or bust? IPKat, <ipkitten.blogspot.com/>, 29 June 2007 where English and French courts revoked the patent, whereas the German court took the view that it was valid and infringed, (cf. also Macdonald-Brown Charters/Ashby Sara, Obviousness – is *Windsurfing* sunk? 2007 CIPA, 380-382); "Pipe clamp", Special edition No. 2 of the 2003 O.J. EPO, 76 - 139, where 8 courts in 3 states dealt with the matter: 4 courts held that the patent was infringed and 4 courts held that the patent was not infringed; *Muller v Hilti* ("Tension Screw"; *Spannschraube*; 1999 GRUR, 909-914; 2000 P.I.B.D. III, 305; 2002 IIC, 746-749), where German courts decided that the European patent was not infringed, whereas Swiss and French courts decided otherwise (cf. also *Fröhlinger*, 81-82). But there are also different approaches between the EPO and the courts of the EPC contracting states, cf. Howes Adrian, Disaster Pending? EPO vs. English Court of Appeal on Excluded Subject Matter, 08/07 WIPR, 25-26.

⁵⁵ Cf. *Paterson*, N 1-61 to N 1-69.

⁵⁶ Cf. *Pagenberg, Conclusion*, 253.

The following work elaborates and examines different possibilities of how a common interpretation of the harmonised substantive patent law in Europe could be reached with structural measures. Quite obviously, one such measure could be the creation of a common patent court. The thesis will consequently quite extensively deal with past and current efforts for the creation of a patent court for Europe. However, as the creation of such a court is politically a very difficult task, it will also be explored whether the goal of a unified interpretation can also be reached by alternative measures or by a combination thereof.

CHAPTER TWO: PAST ATTEMPTS TO ACHIEVE A UNIFIED INTERPRETATION

The Convention for the European Patent for the Common Market (Community Patent Convention; CPC) including the creation of a Community patent court is the only project attempting to achieve a uniform interpretation of European patent law which has been concluded. Although the implementation of the convention is no longer under discussion, it is important to highlight its elements that allow for a common interpretation.

§1 THE CONVENTION FOR THE EUROPEAN PATENT FOR THE COMMON MARKET (COMMUNITY PATENT CONVENTION; CPC)

A. The 1975 CPC

I. The first steps towards a common patent

The main motivation of the EC to create a unitary patent was the establishment of the EEC Treaty⁵⁷ of Rome that entered into force on 1 January 1958 for six states⁵⁸, and the important new factor that came into being with it: the creation of a common European market⁵⁹.

Patents with an effect limited to the territory of the granting state are a barrier in trade and are therefore an obstacle in a market where goods would circulate freely without any customs borders⁶⁰. These limited territorial effects of national patents could have been overcome with the creation of a unitary patent and the abolition of national patents.

⁵⁷ Since the Treaty on European Union entered into force on November 1, 1993 "the EEC Treaty" has been renamed "the EC Treaty".

⁵⁸ Belgium, Germany, France, Italy, Luxembourg and the Netherlands.

⁵⁹ Cf. *Parke, Davis and Co. v Probel, Reese, Beintema-Interpharm and Centrafarm*, ECJ February 29, 1968 (case 24/67); *Haertel, MGK 1*, N 36; *Krieger, Luxembourg Convention*, 149-150; *Leith, Judicial Roles*, 52; *Dybdahl*, N 26.

The EC derives its competence for the creation of the Community patent from Art. 308 (ex Art. 235) EC Treaty, see opinion 1/94 of the ECJ of November 15, 1994 - Competence of the Community to conclude international agreements concerning services and the protection of intellectual property - Article 228(6) of the EC Treaty, and *Sadlonova*, 158-164.

⁶⁰ Cf. *Haertel, MGK 1*, N 36; *Beier, MGK 1*, N 13; *Singer, Patentsystem*, 17; *Krieger Albrecht, Das Gemeinschaftspatent – ein essential des europäischen Binnenmarkts*, Festschrift für Ulrich Everling, Band I, Baden-Baden 1995, 701-717, 706; *Scordamaglia, I*, 335; *Koch/Stauder*, 1; *Cornish/Llewelyn, IP*, N 3-24 and N 1-50; *Paterson*, N 1-40.

The goal of creating a common patent law, which for example the Council of Europe wanted to reach⁶¹, or of preventing a situation where an applicant for a patent had to carry out double the work or more to receive a patent in Europe⁶² and where the respective problems and, in particular, costs could have been avoided⁶³ were consequently only secondary reasons for the attempts for a common patent. These were the motivation factors which in the end led to the EPC⁶⁴.

As long ago as 1959 the European Commission therefore initiated negotiations for an "EEC patent" among the EEC member states⁶⁵. In 1964, the first efforts to establish a patent for the Common Market were, however, halted. The main reasons were insuperable views on whether such a convention should be open for accession by non-EEC member states⁶⁶ and whether the unitary patent should be available to applicants located outside of the EEC⁶⁷.

Not least these controversial discussions on limiting the access to a common patent motivated the USA⁶⁸ to initiate the creation of a worldwide treaty that would simplify the patent granting procedure and that would be open for accession by all states that are members of the Paris Convention. The relevant negotiations were concluded in just four years with the signature of the PCT in 1970⁶⁹. The preparation work for a PCT was again the reason why the negotiations for a "European" patent were resumed.

II. The continuation of work in Europe

It was the French Government which saw the danger of an extensive increase in patent applications from the US under the PCT. It therefore initiated the resumption of work for a Community patent. However, the break in negotiations within the EEC was also used by EFTA. It worked on a proposal for a centralised procedure up to the grant of a patent

⁶¹ See *Beier, Stand und Aussichten*, 146; *Haertel/Kolle*, 5.

⁶² See *Beier, Stand und Aussichten*, 146.

⁶³ See *Burnside*, 285; cf. *Groves/Martino/Miskin/Richards*, 16; 19.

⁶⁴ Cf. *Straus, Beitrag*, 809.

⁶⁵ Cf. *Schneider*, 30.

⁶⁶ See *Haertel, Entwürfe*, 95; *Haertel, MGK 1*, N 41, *Beier, Stand und Aussichten*, 145-146; *Singer, Patentsystem*, 17.

⁶⁷ See *Haertel, MGK 1*, 42; *Beier, Stand und Aussichten*, 146, *Bossung, Return*, 288.

⁶⁸ Cf. *Haertel, Entwürfe*, 97; *Schneider*, 41.

⁶⁹ Available at <www.wipo.int/portal/index.html.en>; for a historical overview, see *The first Twenty-five years of Patent Cooperation Treaty (PCT), 1970-1995*, WIPO 1995, 7-19.

which would have overcome the existing patchwork of widely differing industrial property legislation and practice⁷⁰. Most importantly, the agreement should have also been open to accession for European states outside of the EEC⁷¹.

The idea was taken over by the French Government in its initiative. It suggested to the EC Council that the project should be divided into two different conventions building on each other⁷². The first one should have regulated the patent granting procedure and the creation of a European patent office that would have examined and granted the patents⁷³. This suggestion was aimed at preventing the duplication of work⁷⁴. At the same time, legal certainty would have been ensured by coordinating the national patent laws, and access to patent protection in foreign states would have been simplified⁷⁵.

A patent which would have been granted on the basis of this procedure would have been a so-called "bundle patent", i.e. a bundle of European patents with the effects of national patents granted for these states⁷⁶. Sovereignty would have been fully respected and seemed therefore acceptable to the non-EEC states. And this is where the second convention among the EEC member states would have come in.

It would have basically restored the territorial unity that was lost in the granting of the European patents⁷⁷ and would have created a European patent for the Common Market⁷⁸. This patent would have been more autonomous and would have been governed by a separate and common system of law⁷⁹.

The EC Council considered the French proposal and invited several countries to take part in the negotiations for the purpose of drawing up a European convention for the grant of patents. The negotiations were held within the framework of an Intergovernmental

⁷⁰ CA/147/02, 1.

⁷¹ See *Haertel*, *MGK 1*, N 49.

⁷² Cf. *Haertel*, *Entwürfe*, 95; *Haertel/Kolle*, 9; *Scordamaglia*, *I*, 335.

⁷³ See Mathély Paul, *Le droit Européen des brevets d'invention*, Préface par van Benthem, J.B., Paris 1978, 11; *Haertel*, *MGK 1*, N 52.

⁷⁴ Cf. *Koch/Stauder*, 10.

⁷⁵ Cf. *Dybdahl*, N 8.

⁷⁶ See *Haertel*, *MGK 1*, N 52; *Beier*, *Stand und Aussichten*, 147.

⁷⁷ Cf. *Beier*, *Stand und Aussichten*, 147; *Haertel/Kolle*, 12.

⁷⁸ Cf. *Krieger*, *Luxemburger Vertragswerk*, 105.

⁷⁹ See *Haertel*, *Entwürfe*, 100; *Beier*, *MGK 1*, N 16; *Singer*, *Patentsystem*, 19-20; *Tritton*, N 2-205; *Scordamaglia*, *I*, 335. Also see Preamble of the Convention for the European patent for the Common Market of 1975, O.J. EC, L 17, 26 January 1976, 1.

Conference with six meetings from 1969 to 1972⁸⁰, which led to the first Diplomatic Conference in Munich in 1973.

At that conference the first convention, formally deemed "The Convention on the Grant of European Patents" (European Patent Convention; EPC), was concluded and signed by 14 states⁸¹. Included in the EPC was a part on special agreements⁸². This part mainly aimed at the agreement among the EEC states on a unitary patent which was expected to be realised soon after⁸³ and would have worked as an interface between the two European agreements⁸⁴. However, the enlargement of the EEC from six to nine member states⁸⁵ caused a delay in the planned establishment of a community patent agreement. The necessary Intergovernmental Conference could therefore not be convened in Luxembourg before 17 November 1975.

The negotiations were difficult. However, at the end an agreement was reached and the conference basically ended as successfully as the first conference, that is with the signature of the Convention for the European patent for the Common Market⁸⁶ (Community Patent Convention; CPC 1975) among the EEC member states⁸⁷ on 15 December 1975.

The compromises reached, however, severely watered down the basic concept of creating a truly unitary, autonomous patent that would have ensured free trade in a common market⁸⁸.

At the beginning it was planned that both⁸⁹, the EPC and the CPC 1975 would enter into

⁸⁰ For an overview of the conclusions of the conference cf. Conclusions of the Luxembourg Intergovernmental Conference on the Establishment of a European Patent Organisation, Information, 1972 IIC, 369-373.

⁸¹ These states were: Belgium, Denmark, France, Germany, Greece, Ireland, Italy, Liechtenstein, Luxembourg, Netherlands, Norway, Sweden, Switzerland and the United Kingdom. Austria and Monaco added their signature later on. For the results of the conference, cf. Haertel Kurt, The Munich Diplomatic Conference on European Patent Law, 1973 IIC, 271-280; Braendli Paul, Munich Diplomatic Conference for the Setting up of a European System for the Grant of Patents, 1973 IIC, 402-418.

⁸² Part IX of the EPC.

⁸³ Cf. Schennen Detlef in: *Singer/Stauder*, 4. Auflage, Vor Artikel 142, N 1.

⁸⁴ See Joos Ulrich in: *Benkard, EPÜ*, Vor Art. 142, N 1.

⁸⁵ Denmark, Ireland and UK acceded to the EEC 1 January 1973.

⁸⁶ O.J. EC, L 17, 26 January 1976, 1.

⁸⁷ For the results of the conference, cf. *DE Bericht, Luxemburger Konferenz 1975; Savignon*.

⁸⁸ Cf. *Beier, MGK 1*, N 19.

force at the same time⁹⁰. But the CPC 1975 did not enter into force despite the compromises reached and the declaration made at the Luxembourg conference that the EEC member states seek the ratification of the CPC 1975 as soon as possible.

The main reason was that all EEC member states needed to ratify the CPC 1975 in order to achieve a true Community patent having effect in the entire territory of the EEC⁹¹. This hurdle turned out to be too high to clear.

It was mainly the new EEC member states, Denmark and Ireland, that had problems ratifying the agreement: the Danish Government could not achieve the necessary five-sixths majority in its parliament which was needed to ratify an international agreement, and in Ireland there were fears that the CPC 1975 might be declared unconstitutional⁹² because of its excessively loose links with the EC Treaty⁹³.

In the meantime, the EPC became feasible and entered into force on 7 October 1977 for Belgium, France, Germany, Luxembourg, the Netherlands, Switzerland and the United Kingdom. The first European patent application was submitted for approval as early as 1 June 1978⁹⁴. As of 1 January 2008, 34 states have acceded to the EPC⁹⁵.

⁸⁹ The EPC and the CPC are both international agreements (cf. Opinion of the ECJ relating to the WTO Agreement, 1995 GRUR INT., 239-250, 250; *Waage*, N 1-8; *Bossung, Return*, 303).

⁹⁰ Cf. *Savignon*, 92; *Kolle*, CP, 615.

⁹¹ Cf. Art. 98 CPC 1975.

⁹² During the preparatory work for the CPC 1975, the Irish delegation had pointed out that the points linking the CPC to the EEC Treaty of Rome would have to be made more specific to be in accordance with the Irish Constitution, cf. *Savignon*, 100.

⁹³ Cf. *Krieger, Luxembourg Convention*, 145-146; *Haertel, Luxemburger Konferenz*, 294; *Scordamaglia, I*, 336. The ECJ made it clear in 1994 (see opinion 1/94 of November 15, 1994 - Competence of the Community to conclude international agreements concerning services and the protection of intellectual property - Article 228(6) of the EC Treaty) that the EC may use Art. 308 (ex Art. 235) EC Treaty as the basis for creating new rights in the intellectual property field superimposed on national rights.

⁹⁴ Cf. van Benthem J.B., *Der Start des Europäischen Patentamts, seine Planung und Entwicklung*, 1978 GRUR INT., 427-430, 428.

⁹⁵ All member states of the European Union, plus Croatia, Iceland, Liechtenstein, Monaco, Norway, Switzerland and Turkey. Albania, the Former Yugoslav Republic of Macedonia and Serbia are states that recognize European patents (so-called "extension states"). San Marino and the Former Yugoslav Republic of Macedonia are invited to accede to the EPC; also cf. Luginbühl Stefan, *Vier Neue Mitglieder in der Europäischen Patentorganisation*, 2002 sic!, 459-460; *id.*, *Verwaltungsratspräsident aus der Schweiz wiedergewählt*, 2002 sic!, 876; *id.* *Beitritt Polens zum Europäischen Patentübereinkommen*, 2004 sic!, 371.

III. The new attempt to achieve a CPC

Germany, which successfully organized the Munich Conference, wanted to tackle the problem of entry into force and spearheaded a new initiative to advance the CPC 1975. This led to the decision of the Council of the Internal Market to convene a second Intergovernmental Conference regarding the CPC in 1985⁹⁶.

Since the 1975 conference Greece had acceded to the EC, and Spain and Portugal were supposed to accede shortly⁹⁷. The accession of these states was regarded as an opportunity to revise the clause of entry into force as in the CPC 1975⁹⁸: it was suggested that the seven states which had meanwhile ratified the CPC 1975⁹⁹ could have moved forward without the other five states¹⁰⁰. This would consequently have led to a Community patent which would have only covered a limited area of the EEC territory. However, it was not only the lack of progress on the ratification issue which brought the EEC member states together for a second time.

At the Luxembourg Conference in 1975 the resolution was also passed to possibly conclude a litigation protocol - at the latest ten years - after the signature of the CPC 1975. The preparatory work of the relevant working party of the interim committee - that was delegated immediately after the first conference - was concluded to a great extent. Consequently, there was justified hope that the draft protocols elaborated could be signed at the new conference¹⁰¹. The adoption of the protocols would have established a "Community Patent Appeal Court" (COPAC)¹⁰².

B. The Intergovernmental Conference of 1985

The outcome of the second Intergovernmental Conference, also held in Luxembourg, did not bring the expected results: the proposal for a "*Europe à deux vitesses*" did not find any

⁹⁶ Cf. *Haertel, Luxemburger Konferenz*, 293-294.

⁹⁷ Spain and Portugal acceded to the EEC 1 January 1986.

⁹⁸ See Art. 98 CPC 1975.

⁹⁹ Belgium, France, Germany, Italy, Luxembourg, the Netherlands and the United Kingdom ratified the CPC 1975, cf. *Haertel/Kolle*, 11.

¹⁰⁰ Cf. *Haertel, Luxemburger Konferenz*, 294; *Scordamaglia, I*, 336; *Krieger, Luxembourg Convention*, 146.

¹⁰¹ Cf. *Haertel, Luxemburger Konferenz*, 294; *Stauder, Vereinbarung*, 302-303; *Scordamaglia, I*, 336.

¹⁰² Cf. *Stauder, Vereinbarung*, 302; *Wadlow*, N 4-46.

agreement¹⁰³, and the signature of the texts submitted to the conference which would have been implemented into the CPC 1975 was consequently not possible¹⁰⁴. After long negotiations the states did at least agree to initial the final documents¹⁰⁵.

The major cause of problems were two additional issues which arose during the negotiations:

- First, France newly initiated discussions on the translation requirements, a subject which had already resulted in extensive discussion at the first conference in 1975.
- Second, there was no agreement on the financial aspects and especially on the scale of distribution of the renewal fees for a Community patent among the EEC member states.

The conference thus decided to charge the relevant interim committee that had already prepared the drafts for the implementation of the CPC 1975 to tackle these problems¹⁰⁶. The committee, however, immediately moved this delicate issue from the technical to the political level¹⁰⁷ and requested a political decision¹⁰⁸.

For the next three years the issues were transferred from the Internal Market Council to the Permanent Representatives Committee (COREPER) to the interim committee and back. An agreement that satisfied all EEC member states was not reached, however¹⁰⁹.

Moreover, the deadlock regarding the question of entry into force became even more rigid¹¹⁰. This was due to the ongoing struggle among the states about the future seat of the tentatively re-named "Common Appeal Court of the Community Patent Convention"

¹⁰³ Also critical of the approach of a "two-speed Europe in the EC", *Scordamaglia, II*, 473-474 and *Cornish/Llewelyn, IP*, N 3-28.

¹⁰⁴ Cf. *Haertel, Luxemburger Konferenz*, 297; *Scordamaglia, I*, 337.

¹⁰⁵ Convention for the European patent for the Common Market of 1985 and Implementing Regulations; Protocol on the Settlement of Litigation Concerning the Infringement and Validity of Community Patents (CPC Litigation Protocol); Protocol on Privileges and Immunities of the Common Appeal Court; Protocol on the Statute of the Common Appeal Court; Protocol on a possible modification of the conditions of entry into force of the Agreement relating to Community patents.

¹⁰⁶ Cf. *Haertel, Luxemburger Konferenz*, 296; 298; *Scordamaglia, I*, 337.

¹⁰⁷ The Chairman of the Interim Committee (very soon after the Luxembourg Conference) submitted a report to the Council in the name of the committee that the negotiations at "expert level" were complete and that it was now up to the politicians to come to a decision (cf. *Krieger, Luxembourg Convention*, 147).

¹⁰⁸ Cf. *Krieger, Luxembourg Convention*, 147.

¹⁰⁹ Cf. *DE Bericht, Luxemburger Konferenz 1989*, 174.

¹¹⁰ See *Scordamaglia, I*, 338.

(COPAC)¹¹¹. Luxembourg, France, Italy, Spain and the United Kingdom all applied for the seat. However, some of them simply showed interest as negotiating tactics¹¹², because of the simultaneous ongoing negotiations regarding a Community trade mark and the seat of the respective trade mark office¹¹³.

C. The Intergovernmental Conferences of 1989 and 1991

In the second half of 1989, the French EEC Presidency made another attempt to achieve an agreement on the question of the entry into force of the revised CPC 1975 and its implementing regulations.

This attempt was mainly launched because an EEC summit (that was held shortly before the second Luxembourg Conference in 1985) came to certain conclusions concerning the completion of the common market by 31 December 1991¹¹⁴.

The new French initiative was fruitful and the Internal Market Council agreed to check the situation again if, by 31 December 1991, not all member states had ratified the CPC as revised in 1985. Additionally, the Council decided to convene a third Intergovernmental Conference and mandated the conference to reach an agreement on the issues that could not be resolved at the previous conference¹¹⁵.

The third Intergovernmental Conference was held from 11 to 15 December 1989, once again in Luxembourg. As for the translation requirements and the scale of distribution of the renewal fees, an agreement was reached¹¹⁶ which also seemed capable of entering into force. However, the problems with regard to the ratification issue remained¹¹⁷.

¹¹¹ The terminology was changed from "Community Patent Appeal Court" to "Common Patent Appeal Court". The acronym "COPAC", however, was kept (cf. *Koch/Stauder*, 5; *Foglia*, 970).

¹¹² Cf. *Haertel, Luxemburger Konferenz*, 297.

¹¹³ Cf. *Scordamaglia*, I, 338; *DE Bericht, Luxemburger Konferenz 1989*, 174.

¹¹⁴ Cf. Decision of the Council of September 9, 1989, Doc. 8651/89 and resolution of the European Parliament of 1.1.1986, Doc. 4325/86.

¹¹⁵ Cf. *DE Bericht, Luxemburger Konferenz 1989*, 174.

¹¹⁶ Cf. *Haertel/Kolle*, 11; *DE Bericht, Luxemburger Konferenz 1989*, 176; 178.

¹¹⁷ The German delegation seemed to underestimate that problem, cf. *DE Bericht, Luxemburger Konferenz 1989*, 178.

The negotiations resulted in another protocol declaration based on a French proposal: if the newly revised CPC was not in force by the end of 1991, a further conference of the EEC member states would be convened which would be empowered to amend unanimously the number of states which have to ratify the CPC if it were to come into force¹¹⁸. This would have again led to a Community patent without Community-wide effects¹¹⁹.

All twelve EEC member states signed the CPC 1989¹²⁰. However, since none of the member states ratified it until the end of 1991, the Portuguese EEC Presidency convened a fourth Intergovernmental Conference. The conference once again failed to settle this problem¹²¹.

D. Uniformity of interpretation and the Common Appeal Court of the Community Patent Convention (COPAC)

I. Aims and development

In regard to past attempts to harmonise the interpretation of case law in a structural manner, endeavours to create the COPAC and its background deserve special mention, not least as it was also declared a revolutionary idea¹²².

A Community patent court was not provided for in the first proposals for a CPC, after it had become clear in the first discussions initiated by *Haertel* that the proposal for a common European patent court did not get the necessary political support¹²³.

It was therefore only suggested that the revocation procedure be centralised in a two-instance procedure before the EPO with the possibility to appeal questions of law to the

¹¹⁸ See *Burnside*, 286.

¹¹⁹ Cf. *Straus*, *Present state*, N 11.

¹²⁰ Cf. O.J. EC, L 401, 30 December 1989, 1-52.

¹²¹ For the results of the conference, cf. Bericht der deutschen Delegation, Die Lissabonner Konferenz über das Gemeinschaftspatent 1992, 1992 GRUR INT., 638-642; *Burnside*, 288; *Krieger*, *When will the CP arrive?*, 862.

¹²² Cf. *Scordamaglia*, *Perspectives*, 105.

¹²³ Cf. *Stauder*, *History*, 317-318.

ECJ as a final instance¹²⁴. This would have been the first time that the ECJ had acted as an appeal body¹²⁵.

Infringement proceedings would have remained under the authority of the EEC member states and their national courts. This proposal was, however, questioned from the beginning¹²⁶. On the one hand, the United Kingdom pleaded that infringement and revocation be treated by the same instance¹²⁷. On the other hand, it wondered how contradictory decisions as to the scope of protection could be avoided by the national infringement courts¹²⁸.

Nevertheless, it was decided at the Intergovernmental Conference in 1975 that national judges should have exclusive jurisdiction¹²⁹ to deal with patent infringements¹³⁰ and that the EPO should have the proposed authority¹³¹. The ECJ would have had jurisdiction to give preliminary rulings in Community patent disputes before national courts¹³².

The concerns of the United Kingdom were taken into account with three regulations in the CPC 1975:

- First, national courts could stay the infringement proceedings if an action for revocation of the Community patent was filed with the EPO¹³³.
- Second, to ensure a uniform interpretation of claims, an article was implemented into the CPC which made it possible for a national court to request an opinion of the EPO concerning the extent of protection conferred by the Community patent in relation to the

¹²⁴ Cf. *Haertel, Entwürfe*, 101; *Stauder, Future*, 175.

¹²⁵ Cf. *Brändel*, 295.

¹²⁶ Cf. *Beier, Stand und Aussichten*, 150-151.

¹²⁷ Cf. *Schäfers, Anmerkungen*, 825; *Schneider*, 76.

¹²⁸ Cf. *Wadlow*, N 4-17.

¹²⁹ For the problems that had to be solved in regard to jurisdiction, cf. *Savignon*, 98-99; *Stauder, Anwendung*, 517-519.

¹³⁰ Arts. 68-72 CPC 1975; for details see *DE Bericht, Luxemburger Konferenz 1975*, 222-224 and *Stauder, Anwendung*, 517-518.

¹³¹ Art. 76 CPC 1975 makes it clear that the national courts dealing with an action relating to a Community Patent shall treat the patent as valid.

¹³² Art. 73 CPC 1975.

¹³³ Art. 77 CPC 1975; cf. *Stauder, Auf dem Weg*, 174.

infringement that occurred¹³⁴. An obligation for the EPO to express its opinion was only provided for if the court stayed the infringement proceedings¹³⁵.

- Third, Article 90(1) CPC 1975 gave each EEC member state the ability to declare that it reserved the right to allow its national courts to have jurisdiction in infringement and revocation and to deal with both infringement and validity questions if the parties so agreed. A national court would, however, have been bound by a prior decision of the EPO - as long as the facts were identical - and would have been limited to revoking the patent on the grounds for revocation specified in the CPC. In addition, the territorial effect of the revocation decision would have been limited to the state where the court was located.

Criticism against these regulations was not long coming. The procedure involving the request for an opinion was classed as inefficient, and it was questioned whether the harmonisation effect could have been reached at all since the EPO was lacking the necessary experience in patent infringement proceedings¹³⁶. Furthermore, the limited territorial effect of the revocation decision taken by a national court would have destroyed the unitary quality of the Community patent¹³⁷.

In addition to the provisions in the CPC, the Intergovernmental Conference passed two resolutions addressing the concerns of the United Kingdom¹³⁸.

In the first, the EEC member states agreed to take the necessary measures to establish specialised national infringement courts by way of the centralisation of first-instance jurisdiction on their territory. The goal was to ensure harmonised high-quality decisions rendered by the different national courts¹³⁹.

¹³⁴ Art. 78 CPC 1975; cf. *DE Bericht, Luxemburger Konferenz 1975*, 227; *Savignon*, 100.

¹³⁵ Art. 78(1) CPC 1975.

¹³⁶ Cf. *Stauder, Future*, 182-183.

¹³⁷ Cf. *Stauder, Future*, 180.

¹³⁸ Cf. *Stauder, Auf dem Weg*, 173; *DE Bericht, Luxemburger Konferenz 1975*, 226-227; *Schneider*, 76.

¹³⁹ This concept was built into the mandate of the Intergovernmental Conference of the EPC contracting states in Paris, June 24/25, 1999: Considering the necessity to increase the effectiveness and legal certainty of the protection conferred by the European patent it was recommended that the contracting states take whatever measures each considers necessary to study the restriction to a minimum of the number of courts dealing with patent litigation, which in some states could mean three or less (cf. 1999 O.J. EPO, 548).

The second resolution was aimed at an agreement to be possibly incorporated by a litigation protocol which should have been concluded, at the latest, ten years after the signature of the CPC 1975¹⁴⁰. As mentioned in the resolution itself, the EEC member states adopted this resolution because they were conscious of the problem of dealing effectively with actions relating to Community patents and of the problems arising from the separation of jurisdiction in respect of infringement and validity of Community patents. Therefore, it was also decided to create special arrangements for litigation of Community patents which would have superseded the reservations made under Article 90(1) CPC 1975¹⁴¹. All these decisions taken in 1975 were clearly aimed at achieving a uniform interpretation of the law.

After the Conference, a working group was charged with the relevant work in regard to the second resolution. From the start, the working group was discussing the creation of a common court that would have decided upon appealed decisions rendered by the national infringement courts¹⁴².

The following led to this fact: guided by the second resolution, the group took the view that matters of infringement and validity were to be judged by the same instance, consequently also by the national courts. However, the effect should have been simply *inter partes*. As a consequence, a common court of appeal had to ensure a centralized and common practice at the appellate level¹⁴³.

Other proposals followed in regard to the jurisdiction of the national courts of first instance¹⁴⁴ but the achievement of the COPAC was never challenged. The respective proposals submitted to the conference included a draft Protocol on the Settlement of Litigation Concerning the Infringement and Validity of Community Patents, a draft Protocol on Privileges and Immunities of the Common Appeal Court and a draft Protocol on the Statute of the Common Appeal Court. Most of the suggested provisions of these protocols

¹⁴⁰ Also cf. *Pakuscher, Nichtigkeit*, 313.

¹⁴¹ Art. 90(5) CPC 1975.

¹⁴² Cf. *Stauder, Auf dem Weg*, 175; *Stauder, Vereinbarung*, 302; *Wadlow*, N 4-41.

¹⁴³ Cf. *Haardt*, 334; already in the proposal on an Agreement on European Patent Law in 1962 a common appeal court was recommended (Art. 4).

¹⁴⁴ Cf. *Haardt*, 334-336.

were accepted by a large margin and approved at the Intergovernmental Conference in 1989¹⁴⁵.

II. Jurisdiction

The Community patent litigation agreement of 1989 would have created a complicated and rather artificial litigation system. It included both a Community and a national track.

At the national level it was agreed that national courts in a limited number listed in the annex of the CPC would act as specialised "Community Patent Courts" of first and second instance(s)¹⁴⁶. Several states, however, designated all their courts with jurisdiction at the national level to have jurisdiction for the Community¹⁴⁷.

The Community Patent Courts would have had exclusive jurisdiction in regard to infringement, as well as in regard to counterclaims for revocation relating to Community patents¹⁴⁸. In contrast to the approach taken at the CPC 1975¹⁴⁹, a patent found invalid by a Community Patent Court would have been revoked throughout the EEC territory¹⁵⁰.

In the third instance, a national court would have decided upon appeals as to questions of law¹⁵¹.

On the Community track there would have been the EPO Revocation Division at the first level, exclusively deciding upon requests for the limitation of and applications for the revocation of Community patents¹⁵². The COPAC would have had exclusive jurisdiction *inter alia* in regard to validity and revocation of a Community patent¹⁵³. This would have been the link between the national and the Community track. Consequently, if a decision of a Community Patent Court of second instance was in appeal in respect of one of these

¹⁴⁵ Cf. *DE Bericht, Luxemburger Konferenz 1989; Schäfers, Gemeinsame*, 290.

¹⁴⁶ Art. 1(1) and (2) CP Litigation Protocol.

¹⁴⁷ Germany and France, for example, listed all their courts with jurisdiction in patent disputes (nine for Germany in each instance and ten in each instance for France).

¹⁴⁸ Arts. 15 and 21 CP Litigation Protocol.

¹⁴⁹ See Art. 90 CPC 1975.

¹⁵⁰ Art. 20 CP Litigation Protocol in relation to Art. 33 CPC 1989.

¹⁵¹ Art. 29 CP Litigation Protocol.

¹⁵² Art. 8(1) CPC 1989.

¹⁵³ Art. 22(b) CP Litigation Protocol with reference to Art. 15(2) CPC Litigation Protocol and another reference to Art. 56(1) CPC 1989.

points, the court would have had to stay its proceedings and refer them to the COPAC for judgment.

The decision rendered by the COPAC would have been binding for the Community Patent Courts as well as for the national court of third instance, based on the exclusive jurisdiction of the COPAC¹⁵⁴. However, the COPAC would also have acted as a second instance on the Community track¹⁵⁵, thus replacing the Revocation Boards provided for in the CPC 1975.

Uniformity of interpretation in regard to validity and infringement as regulated in the CPC and the EPC should have been guaranteed by this construction¹⁵⁶. Additionally, a uniform interpretation should have been guaranteed¹⁵⁷ through the jurisdiction of the COPAC to render preliminary rulings¹⁵⁸ with respect to matters that lay outside of its exclusive jurisdiction, as well as with respect to the validity and infringement of provisions enacted in the implementation of the CPC, as long as they were not national provisions¹⁵⁹.

As mentioned above, this jurisdiction with regard to preliminary rulings was still envisaged for the ECJ in the CPC 1975¹⁶⁰. The procedure and the conditions would have been identical to those prescribed in Article 234 EC Treaty¹⁶¹.

The ECJ would have been given authorisation to hand down preliminary rulings by way of interpreting the provisions concerning jurisdiction and procedures in Community-related actions other than those covered by the CP Protocol on Litigation and those provisions of the Protocol which lay down rules of jurisdiction applicable in Community patent-related actions brought before national courts¹⁶².

The suggested system looked as follows:

¹⁵⁴ Art. 27 CP Litigation Protocol; cf. *Foglia*, 975; 977; *Wadlow*, N 4-60.

¹⁵⁵ Art. 28 CP Litigation Protocol.

¹⁵⁶ Cf. *Bruchhausen, Institutions*, 684; *Scordamaglia, II*, 461; *Kolle, CP*, 617.

¹⁵⁷ Cf. Art. 30 CP Litigation Protocol.

¹⁵⁸ Cf. *Stauder, Vereinbarung*, 309; *Scordamaglia, II*, 464.

¹⁵⁹ This would cover e.g. the Implementing Regulations and the Financial Regulations.

¹⁶⁰ Cf. Art. 73 CPC 1975; *Stauder, Vereinbarung*, 309; *Bruchhausen, Institutions*, 684; *Scordamaglia, II*, 467.

¹⁶¹ Ex Art. 177 EC Treaty. Since the Treaty of Amsterdam entered into force on May 1, 1999 there has been a new numbering system; cf. *Le Tallec, La Cour*, 232; *Scordamaglia, II*, 464; *Foglia*, 979; *Schneider*, 107.

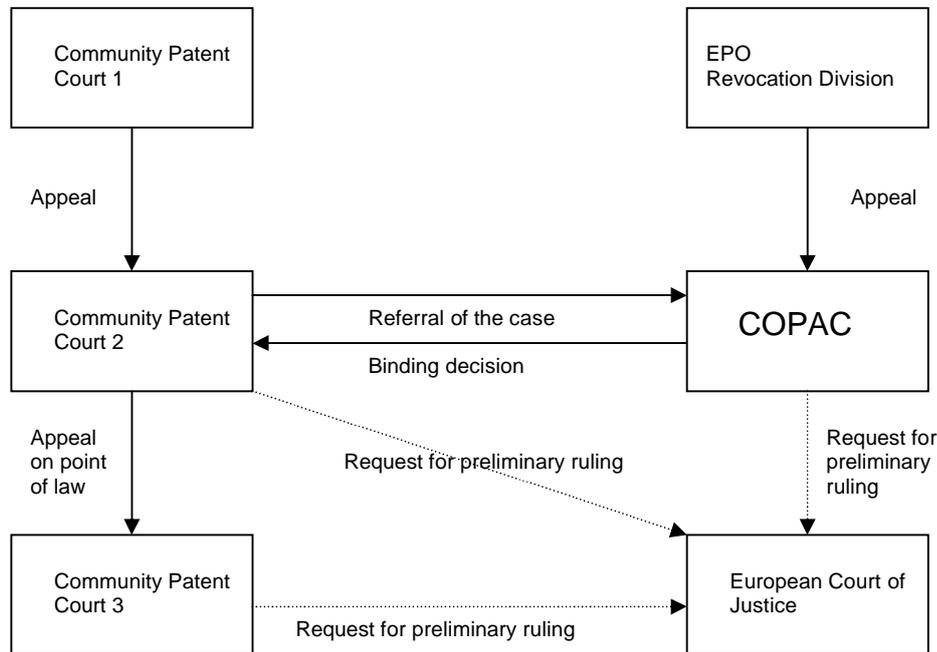
¹⁶² Art. 3 Agreement relating to Community Patents; cf. *Foglia*, 979; *Wadlow*, N 4-45.

National level

- Infringement actions
- Counterclaims for revocation

Community level

- Request for revocation



Based on a figure by Kalle, CP, 624.

The authority of the COPAC was partly praised for its involvement as a specialised instance at an early stage in the process and for reducing the workload of the ECJ¹⁶³. Partly, however, the split of authority with the ECJ was also deemed complicated, with an unknown practical result¹⁶⁴. This sharing of power was also criticised for compounding the ECJ's predicament¹⁶⁵.

III. Organisation

The COPAC was designed to be a new Community institution¹⁶⁶ in the form of an autonomous international organisation¹⁶⁷, having legal personality¹⁶⁸ with its own seat¹⁶⁹ and budget¹⁷⁰.

¹⁶³ Cf. *Stauder, Vereinbarung*, 309.

¹⁶⁴ Cf. *Koopmans*, 20.

¹⁶⁵ Cf. *Rasmussen*, 1081.

¹⁶⁶ Cf. *Wadlow*, N 4-41.

¹⁶⁷ Cf. *Schäfers, Gemeinsame* for aspects of international and constitutional law in regard to the organisation of COPAC.

¹⁶⁸ Arts. 1 and 3 CP Litigation Protocol.

¹⁶⁹ Cf. *Wadlow*, N 4-42.

The initial concept of establishing the COPAC within either the EPO or the ECJ failed. In regard to the EPO it was seen as problematic that not all EPC contracting states were also EEC member states and that the court would not have been sufficiently independent from the administrative structure. Concerning the ECJ, it was expected that it would be "jurisdictionally" overloaded if the COPAC had become part of it¹⁷¹.

The court would have been managed by its president. An Administrative Committee, composed of the representatives of the contracting states, would have basically acted as a supervisory board¹⁷² and would have determined the salaries, allowances and pensions of the President and judges of the COPAC. Additionally, it would have laid down the Staff Regulations¹⁷³ and would have approved the Rules of Procedure established by the COPAC¹⁷⁴.

The COPAC would have certainly had a Registry¹⁷⁵, and the judges appointed would have had to possess experience in patent law¹⁷⁶.

E. The reasons for the failure of the CPC

Up until today only seven EC member states have ratified the CPC 1989. Among them is also Denmark¹⁷⁷, which cleared the hurdle of the five-sixths majority in its parliament and deposited its instruments of ratification in Brussels on 7 May 1993¹⁷⁸. The question is why the CPC has not entered into force.

In 1975, industry and the EEC member states were still going in the same direction. Particular interests of both sides, however, brought a compromise agreement into being in 1989 which, as early as 1975, had started to lose a great part of its vision of creating a

¹⁷⁰ Art. 10 CP Litigation Protocol.

¹⁷¹ Cf. *Le Tallec, La Cour*, 232; *Foglia*, 977-978.

¹⁷² Art. 9 CP Litigation Protocol.

¹⁷³ Art. 11 CP Litigation Protocol.

¹⁷⁴ Art. 12 CP Litigation Protocol.

¹⁷⁵ Art. 5 CP Litigation Protocol.

¹⁷⁶ Art. 6 CP Litigation Protocol.

¹⁷⁷ The others are: France, Germany, Greece, Luxembourg, the Netherlands and the United Kingdom.

¹⁷⁸ Cf. *Krieger, When will the CP arrive?*, 863.

Community patent system that abolished the obstacles of free trade and that ensured the creation of a high-quality patent with a unitary and autonomous character¹⁷⁹:

- First, there were the "economic clauses", which were praised after the difficult negotiations surrounding them as "the miracle of Luxembourg". They included the exhaustion of Community patent rights, contractual licensing, licences of right, and compulsory licences¹⁸⁰.

Other problematic points included "switching" from the Community patent to the European patent, the related so-called "optional solution", the concessions in regard to the jurisdiction of national courts, and the translation requirements of the patent¹⁸¹.

These concessions led to a Community patent that was, in the end, attractive neither for the aims of the Internal Market nor for the users.

I. "Switching" from the Community patent to the European patent and the "optional solution"

Article 30(6) CPC 1989 provided that the patent holder may, instead of the Community patent, obtain a European patent for the contracting states for which he has filed translations in due time. He could therefore "switch" from a Community to a European patent if he notified his intentions to the EPO within a period of two months.

This possibility was primarily introduced to avert the harsh legal consequence of the revocation of the Community patent if the applicant could not (or did not want to) file the necessary translations into all Community languages in due time¹⁸².

The "optional solution" went in a very similar direction. This solution, which is the right to choose between a Community patent and a European patent, was very much demanded by the industrial sector. Basically, it was introduced for a transitional period of time as a

¹⁷⁹ Cf. *Beier*, *MGK 1*, N 19.

¹⁸⁰ Arts. 28, 42, 45 to 47; 76, 77 and 83 CPC 1989, cf. *Savignon*, 96; *DE Bericht, Luxemburger Konferenz 1975*, 208-215, *Krieger, Luxemburger Vertragswerk*, 110-117; *Koch/Stauder*, 3-4.

¹⁸¹ See *Beier*, *MGK 1*, N 19.

¹⁸² Cf. *Stauder, Switching*, 984.

tool to test and experience whether the Community patent really was more economical than a European patent¹⁸³. However, this tool became, in fact, unlimited¹⁸⁴ in the CPC 1989 and therefore ultimately turned into a strategic patent exploitation tool.

The desire of industry to choose between patent protection with different kinds of territorial effects makes it possible to split off the EU territory into desired geographical regions of patent protection¹⁸⁵. The patent can therefore be exploited strategically the way the holder thinks best, with certain limitations, however¹⁸⁶.

Aside from the existing antitrust and competition jurisdiction in and among¹⁸⁷ the EC member states, it was the ECJ¹⁸⁸ which specified these limits mainly from the interpretation of Article 30 EC Treaty¹⁸⁹ in regard to the principle of the free movement of goods within the Common Market¹⁹⁰. The ECJ introduced the regional exhaustion of patent rights¹⁹¹, which was codified in the CPC in the "economic clauses", and clarified the

¹⁸³ Cf. *Krieger, When will the CP arrive?*, 858.

¹⁸⁴ It was decided that a possible decision of the EC Council to cancel the right to choose between a European and a Community patent could only be taken unanimously instead of with a qualified majority (cf. Art. 86(4) and (5) CPC 1975 and Art 81(4) and (5) CPC 1989). Also cf. *Stauder, Switching*, 985; *Koch/Stauder*, 13.

¹⁸⁵ Cf. Ullrich Hanns, *Patentschutz im europäischen Binnenmarkt*, 1991 GRUR INT., 1-13, 11; *Groves/Martino/Miskin/Richards*, 6.

¹⁸⁶ Cf. Schwarze Jürgen, *Die Vereinheitlichung der Patente in der Europäischen Gemeinschaft*, 1996 RIW, 272-280, 276; *Abbott/Cottier/Gurry*, 673; *Brown*, 276; Ebenroth Carsten/Hübschle Wolfgang, *Gewerbliche Schutzrechte und Marktaufteilung im Binnenmarkt der Europäischen Union*, Heidelberg 1994, N 140.

¹⁸⁷ E.g. EC member states have restricted their policy on patent licensing agreements under Regulation (EC) No. 240/96 of 31 January 1996 on the application of Article 85(3) of the EC Treaty to certain categories of technology transfer agreements, O.J. EC, L 31, 9 February 1996, 2; for an extensive overview see *Tritton*, N 8-027 to N 8-033.

¹⁸⁸ Cf. *Tritton*, N 7-006 to N 7-036; *Laddie, I.P. Rights*, 404-405.

¹⁸⁹ Ex Art. 36 EC Treaty; also cf. Cohen Jehoram Herman, *Harmonising Intellectual Property Law Within the European Community*, 1992 IIC, 622-629.

¹⁹⁰ Also cf. Fennelly Nial, *Rules and exceptions: Freedom of movement and intellectual property rights in the European Union*, *International Intellectual Property Law & Policy*, vol. 5, Chapter 33, Hansen Hugh (ed.), Fordham University School of Law, 2003.

¹⁹¹ That is to say that patents in other EU countries cannot be used to prevent importation, sale or use of such a product if once it had been put on the market somewhere within the EU by a patentee or with the patentee's consent, cf. *Centrafarm BV v Sterling Drug Inc*, ECJ October 31, 1974 (case 15/74); *Merck & Co. Inc. v Stephar BV and Petrus Stephanus Exler*, ECJ July 14, 1981 (case 187/80); *Pharmon BV v Hoechst AG*, ECJ July 9, 1985 (case 19/84); *Allen and Hanburys Ltd v Generics (UK) Ltd*, ECJ March 3, 1988 (case 434/85); *Straus, Present State*, N 6. In regard to the special situation of Spain, which was granted a transitional period of three years after accession to the EC to accept product patent protection for new pharmaceutical products: *Merck & Co Inc and others v. Primecrown Ltd and others* (case C-267/95) and *Beecham Group plc v Europharm of Worthing Ltd.* (case C-268/95) ECJ December 5, 1996. Cf. in this regard also *Sadlonova*, 144-149.

grant of compulsory licences by an EC member state¹⁹² and the conditions under which an intellectual property licensing agreement violates the EC Treaty¹⁹³.

The double- or even triple-track policy¹⁹⁴, however, does not promote the completion of the Common Market without any territorial borders for intellectual property rights¹⁹⁵. If the establishment of a common market is to be pursued seriously, the multiple-track approach should be abolished¹⁹⁶. Otherwise, neither the creation of an additional patent instrument¹⁹⁷ nor the transfer of competence to the EC will effectively address the shortcomings of the current situation in Europe. A similar observation applies with regard to a Community patent that would only be valid in a limited number of EC member states¹⁹⁸.

II. The jurisdictional arrangements

The negotiations for a CPC soon brought to light the fact that the EEC member states had limited interest in giving up their sovereignty rights in relation to jurisdiction:

- First, Articles 77 and 78 CPC 1975 make it clear that it was mandatory for the national court neither to stay its infringement proceedings if the EPO was considering validity nor to address the EPO to seek an opinion in regard to the extent of protection conferred by the Community patent in relation to the alleged infringement.

¹⁹² Cf. *Commission of the European Communities v United Kingdom of Great Britain and Northern Ireland*, ECJ February 18, 1992, 1992 ECR, 829. Nevertheless, the EC member states still have wide autonomy with respect to compulsory licensing policy (cf. *Martinez*, 771. A transfer of authority to the EC occurred with regard to certain categories of technology transfer agreements (Regulation (EC) No. 240/96 of 31 January 1996 on the application of Article 85(3) of the EC Treaty to certain categories of technology transfer agreements) and with regard to public health problems in third countries allowing companies to produce copies of patented medicines under licence for export to "countries in need" without sufficient capacity to produce them (Regulation (EC) No. 816/2006 of 17 May 2006 on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems)).

¹⁹³ Cf. *Snell*, 178 with reference to *L.C. Nungesser KG and Kurt Eisele v Commission of the European Communities*, ECJ June 8, 1982 (case 258/78). In particular Art. 81 EC Treaty prohibits restrictive licensing agreements affecting intra-Community trade.

¹⁹⁴ If national patents continue to co-exist with a European and a Community patent, one could speak of a triple-track policy (cf. the discussions between van Benthem J.B., *Das europäische Patentsystem muss durch ein nationales System ergänzt werden*, 1993 GRUR INT., 593-595 and van Nispen Constant, *Macht das europäische Patentsystem nationale Patentsysteme überflüssig?*, 1993 GRUR, 591-592).

¹⁹⁵ Cf. *Laddie, I.P. Rights*, 405; *Stauder, Switching*, 986; *Krieger, When will the CP arrive?*, 857; *Martinez*, 768-773.

¹⁹⁶ Cf. *Willems, Blueprint*, 5-6; *Laddie, I.P. Rights*, 408; *Krieger, When will the CP arrive?*, 857-858; *Haas P.*, 199; *Brown*.

¹⁹⁷ Cf. *Stauder, Switching*, 986.

¹⁹⁸ Cf. also *Straus, Present State*, N 11.

- Second, both Article 90 CPC 1975 and the possibility of making a reservation concerning the jurisdiction of national courts to revoke a patent in infringement cases could have had the same aim¹⁹⁹.

- Third, the limited territorial effect of a revocation decision rendered by a national court made it clear that other states did not accept any intrusion on their sovereignty, and most of all not by a national court of another state.

Bearing this situation in mind, the system of jurisdiction concluded at the Intergovernmental Conference in 1989, including the COPAC, has to be classed as a major step forward. However, the approach that "Community Patent Courts" of first and second instance would have been composed of national courts able to revoke Community patents for the entire territory of the EEC provoked major concerns among the stakeholders:

- First, this was seen as too great a risk²⁰⁰, since not all EC member states provide for courts with judges experienced in patent law²⁰¹, or not in the large number designated by some EC member states to act as Community Patent Courts²⁰².

- Second, it was considered a potential source of legal uncertainty by the users²⁰³, due to the fact that *forum shopping* would have been possible to a great extent among the different Community Patent Courts²⁰⁴.

- Third, a Community Patent Court hearing an infringement action in relation to a Community patent would have basically had to stay the proceedings if the validity of the Community patent in suit was already *lis pendens* before another court or before the COPAC. The same would have been the case where opposition proceedings were

¹⁹⁹ Cf. *Beier, MGK 1*, N 19. There are, however, two arguments that in fact suggest otherwise: on the one hand, it was decided that these reservations would cease as soon as the agreement on litigation was applicable. On the other hand, it was the declared aim of the Intergovernmental Conference of 1975 to solve problems arising from a separation of jurisdiction in respect of infringement and validity.

²⁰⁰ Cf. *Martinez, 779-780, Tilmann, Zukunft*, 1079; *Willems, Harmonisation*, 196.

²⁰¹ Cf. *Schade, Streitregelungssystem*, 837.

²⁰² Cf. *Messerli*, 138; *Sedemund-Treiber, Strukturen*, 121; *Schade, Streitregelungssystem*, 837; *Schade, Protocol*, 182.

²⁰³ Cf. *Söderholm*, 2.

²⁰⁴ Cf. *Young/Birss*.

ongoing or an application for revocation²⁰⁵ or limitation²⁰⁶ had been filed with the EPO²⁰⁷. This situation was classed as too lengthy and costly, and risky in terms of possible blockage of effective enforcement²⁰⁸.

However, criticism was also voiced over the approach that a Community Patent Court of second instance would have had to stay its infringement and revocation proceedings concerning a Community patent and refer them to the COPAC for judgment.

This procedure was classed by users as being complicated and time-consuming²⁰⁹ and also risky, as there would have been no further possibility of appealing COPAC's decision²¹⁰. It was also seen as a threat to the desired uniformity of European patent law if national courts had lost their power to decide important matters of law relating to Community patents whilst retaining competence in regard to European and national patents²¹¹. In this context it is important to mention that the EEC states have never been willing to give up jurisdiction in regard to European and national patents. Added to this are concerns regarding the language regime²¹².

Stakeholders therefore feared that the Community patent jurisdiction system would not provide them with effective protection²¹³ enabling them rapidly to compel infringers to cease their infringement and ensure that the Community patent would be interpreted in a uniform manner in the entire area of the EEC²¹⁴.

III. The language provisions

The discussion on translations has always been highly controversial and had first become a landmark in the compromise of the CPC 1975. Users and the then nine EC member states agreed that only the claims had to be translated into the official languages of the EC

²⁰⁵ Cf. *Paterson*, N 14-19.

²⁰⁶ Cf. *Paterson*, N 14-18.

²⁰⁷ See Art. 34(1) CP Litigation Protocol.

²⁰⁸ Cf. *Stohr*, 9; *Kolle/Stauder*, 2nd Symposium, 361; *Young/Birss*, 363; *Schade*, Protocol, 182; *Schneider*, 114; CP Green Paper, 10, 11.

²⁰⁹ Cf. *Stauder*, Weg, 468; *Schade*, Streitregelungssystem, 837; *Schneider*, 115.

²¹⁰ Cf. *Kolle/Stauder*, 3. Symposium, 513.

²¹¹ Cf. *Kolle/Stauder*, 2nd Symposium, 362.

²¹² Cf. *Kolle/Stauder*, 3. Symposium, 513.

²¹³ Cf. also *Schneider*, 112.

²¹⁴ Cf. *Haardt*, 340.

member states²¹⁵. A translation of the full patent specification was basically not required²¹⁶. Although provision was made for reservations - each state could request a full translation into one of its official languages, a certain flexibility still existed²¹⁷. This flexibility, as required by industry, was, however, successfully attacked by a French proposal in 1985, resulting in Articles 29 and 30 CPC 1989.

A translation of the entire patent specification would have had to be filed within a certain time limit. If the filing had not been made in due time, the Community patent would have been deemed void *ab initio* and would have turned back into a "bundle patent"²¹⁸.

Enormous costs²¹⁹ for obtaining unitary protection would have resulted, and the interest of users therefore began to falter²²⁰.

In fact, the translation-related costs for a Community patent would not have been different from a European patent since Article 65 EPC also provides that each contracting state can demand a translation of the European patent into its language if the patent as granted, amended or limited is not available in that official language. At least 28 of the EPC contracting states have made use of that possibility²²¹.

The great difference between the language regime for the European patent and that for the Community patent is, however, that when validating a European patent the applicant may choose in how many EPC contracting states he wishes to pay for protection, whereas the Community patent is a unitary patent which must be translated into all the languages of the EU member states. In practical terms, this fact should not be underestimated.

²¹⁵ See Art. 33 CPC 1975.

²¹⁶ Cf. van Benthem J.B., *The Solution of the Language Problem in the European Patent Conventions*, 1975 IIC, 1-10, 9/10; *Singer, Patentsystem*, 127-128.

²¹⁷ See Art. 88 CPC 1975 and *Haertel, Luxemburger Konferenz*, 299.

²¹⁸ Cf. Art. 30(6) CPC 1989; Cf. *Bossung, Unionpatent*, 19.

²¹⁹ It was estimated that an average translation of a patent of 20 pages cost € 1 280 (see report of the Working Party on Cost Reduction, WPR/7/00 Rev. 1, 43). The translations of a Community patent into all 21 EU languages would consequently cost well over € 20 000; also cf. Neukom John U., *What Price the Community Patent?*, 1992 EIPR, 111-112; *Leardini*, 326; cf. also *Straus, Present State*, N 12-13.

²²⁰ Cf. *v. Benthem*, 438; *Groves/Martino/Miskin/Richards*, 42; *Krieger, When will the CP arrive?*, 866; also cf. *Singer, Patentsystem*, 127. A representative of industry once stated bluntly that the "CPC" with such translation requirements would in fact be a "Capital Punishment Convention" (cf. *Kolle, Europe*, 47).

²²¹ Cf. National law relating to the EPC, European Patent Office, 13th edition, Munich 2006, 95.

The aim must be to create a patent that is cheaper or at least not more expensive than today's solutions if a Community patent was to be accepted by users.

This will get more difficult²²², however, with the optional "Agreement on the application of Article 65 of the Convention on the Grant of European Patents"²²³ (so-called "London Agreement")²²⁴. The agreement entered into force on 1 May 2008 and will reduce the translation-related costs by up to 50% for a European patent²²⁵, due to the fact that its contracting states commit themselves to dispensing, in full or in part, with the filing of translations of European patents in their national languages²²⁶.

The entry into force of the London Agreement shows that a further step in European integration may also be achieved outside of the EU structures if necessary and with a concentration on working languages²²⁷, while maintaining legal certainty. The argument that there is public interest in commerce and technology in regard to translations seems for many states only a pretext, since it is a fact that in most states hardly any translations are ever consulted²²⁸. The primary concerns regarding the translation requirements are cultural and political, but economic as well, since many patent attorneys provide the requested translations²²⁹. The London Agreement will consequently not make it easier to agree on the Community patent. It seems clear that further integration, coupled with the

²²² Cf. *Ullrich, National*, 14.

²²³ Cf. 2001 O.J. EPO, 549-619 and <www.epo.org/patents/law/legislative-initiatives/london-agreement.html>. The agreement was quite obviously signed at the Intergovernmental Conference of the EPC contracting states held in London on 16 and 17 October 2000, cf. *Addor/Luginbühl*; cf. Luginbühl Stefan, Übereinkommen über die Anwendung des Artikels 65 des Übereinkommens über die Erteilung Europäischer Patente, 2001 sic!, 696; Messerli Peter, Neue Entwicklungen im europäischen Patentsystem, Neueste Entwicklungen im europäischen und internationalen Immaterialgüterrecht, 5. St. Galler Immaterialgüterrechtsforum 2001, Baudenbacher Carl/Simon Jürg (eds.), Basel et al. 2002, 183-195, 190-191.

²²⁴ Contracting states are currently Croatia, Denmark, France, Germany, Iceland, Latvia, Liechtenstein, Luxembourg, Monaco, the Netherlands, Slovenia, Sweden, Switzerland and the United Kingdom.

²²⁵ Cf. *Addor/Luginbühl*, 27; 730-731; N 3; Yayon-Dauvet Audrey/Gougé Emmanuel, Approval of the London Protocol: French issues concerning the language system for European patents, *WIPR* 09/01, 17/18.

²²⁶ Holders of European patents no longer have to submit a translation of the patent specification if the patent is granted for contracting states sharing an official language with the EPO (English, French or German, cf. Art. 1(1) London Agreement). In contracting states where this is not the case, only a translation of the claims into the respective official national language has to be filed. A translation of the description will no longer have to be filed if the patent has been granted in the official language of the EPO prescribed by that state, or translated into that language (cf. Art. 1(2) and (3) London Agreement).

²²⁷ Different opinion *Remien, Illusion*, 283.

²²⁸ Cf. *Bossung, Return*, 305.

²²⁹ Cf. *Bossung, Return*, 305; there were, however, different patent attorney federations which strongly supported the signature of the London Agreement and the waiver of translation requirements.

creation of an Internal Market, will make it necessary for the EC to reduce its working languages²³⁰.

IV. Conclusion

The main reason for the lack of success of the CPC has to be seen in the changing situation over the period that negotiations for a CPC were unfolding.

In 1975 the EC member states were still working on an empty platform. In 1985, however, a well-functioning EPC existed. It was also from that point on that users started to state clearly what they expected from a CPC: a Community patent (system) that was at least as effective as the existing European patent (system)²³¹.

It was therefore the success of the EPC²³² which increased the pressure on the EC member states to find solutions that ensured a better and cheaper way to obtain patent protection - which included the necessary legal certainty in the EC member states - than with the available European and national patents²³³. The solutions in 1985 and 1989 did not, however, bring about the desired system.

The combination of the particular interests of the EC member states and their unwillingness to give up sovereignty rights with regard to civil jurisdiction, and the ensuing lack of interest on the part of users, ultimately led to a breakdown. The goal of forming a common market with a unitary patent, as well as the necessary logic for a successful project, faded away.

The lack of success of the CPC has been seen as the insufficient will of the EC for political, sovereignty²³⁴, legal and cultural reasons, on the one hand, and the hesitation of

²³⁰ Also cf. *Cornish/Llewelyn, IP*, N 3-29.

²³¹ Cf. *Haertel, Luxemburger Konferenz*, 300; *Jacob, Future*, 118.

²³² By 1985 (just seven and a half years after the first European patent was granted) already more than 400 000 European patent applications had been filed and more than 150 000 European patents had been granted.

²³³ Also cf. *v. Benthem*, 438; 439; Hucko Elmar, *Das Gemeinschaftspatent, Patentschutz in Europa – Quo vadis?*, 18. Juli 2003, München, Forum Institut für Management, 22-30, 22; *Kolle, Europe*, 55.

²³⁴ Also cf. *Junge*, 827.

industry²³⁵, for economic reasons, to commit itself to a Community patent system aimed at the real establishment of a common Internal Market, on the other hand. Until now, EC member states at large seem not to be ready to give up their control of patent fees, or of enforcement and functioning in this competition-related issue²³⁶. This underlines the fact that politics related to the economy and business, and as a consequence patent law, belong to the heart of national politics²³⁷.

It was already being debated, as early as 1975, whether a Community patent would be attractive at all if there were a permanent option to choose between European patents and the Community patent²³⁸. The answer should be an emphatic "yes" in the view of the author. This implies, however, that a patent system including also a Community patent would be more efficient than the currently existing European patent system. This could only be achieved if the EC member states were ready to give up more of their national sovereignty.

There would be no reason to apply for a Community patent if there were a European "bundle patent" available that was more economical, more interesting and at the same time provided better legal certainty. However, as long as only half-hearted attempts are made in the direction of an undivided market, there hardly seems good reason to let a CPC enter into force or even give up the double- or triple-track policy in the European patent system in regard to the territory of the EC. It would rather be a step backwards instead of the completion of a European patent system. European and national patents would disappear from the territory of the EC, being replaced by a Community patent system that is worse than today's system.

F. Could the CPC still enter into force?

It is very unlikely that the CPC as last negotiated in 1989 will enter into force²³⁹. This is underlined by the fact that the EU has meanwhile grown to 27 states, whereas the CPC

²³⁵ Also cf. Stauder Dieter, Substantive Law Aspects of the Community Patent – Translation Requirements, Switching, and the European or Community Patent Option, 1991 IIC, 979-986, 985-986.

²³⁶ Cf. *Martinez*, 773.

²³⁷ Also cf. *Junge*, 827.

²³⁸ See *Stauder, Future*, 183.

²³⁹ See the attempts of the European Commission to achieve the Community patent by way of an EC Regulation at §8. Cf. also *Blumer, Jurisdiction*, 336.

has only been negotiated among 12 states. Since it is an international agreement and the CPC was not directly part of the accession agreements with the new states²⁴⁰, re-negotiations with these states with subsequent ratification in all CPC contracting states would be necessary²⁴¹. Re-negotiations would, however, also be necessary among the 12 states that signed the CPC 1989 to adapt it to the revised EPC²⁴². It is therefore no surprise that, for example, the United Kingdom has in the meantime removed as redundant the provisions in the Patents Act 2004 which related to the CPC.

Additionally, the European Commission reacted to the lack of progress in regard to the CPC, not least because it took the view that the CPC had already fallen behind the changing requirements and European integration²⁴³. It thus took an initiative to create a Community patent through a regulation enacted by the EC Treaty²⁴⁴ which would, in contrast to the CPC as an international agreement, be subject to control and amendment by normal Community legal process²⁴⁵.

G. Conclusion in regard to uniformity of interpretation and avoiding multiple litigation

The CPC would have been governed by a common system of law²⁴⁶. There is no doubt that the law and its interpretation would have been unified to a great extent with a view to Community patents.

²⁴⁰ It is argued that, in the case of the 4th EU accession round, Austria, Finland and Sweden have committed themselves in Art. 4 of the Act concerning the conditions of accession and the adjustments to the Treaties on which the European Union is founded to accede to all of the conventions that have been concluded by the former member states of the EU. The CPC is one of these conventions, although it has not yet entered into force, but was signed by all former member states of the EU (see *Krieger, When will the CP arrive?*, 871). With regard to the 5th EU accession round, cf. *Sadlonova*, 91-95.

²⁴¹ Cf. *Leardini*, 325.

²⁴² It would, for example, be necessary to adapt the CPC 1989 to the newly implemented limitation and revocation procedure (see Art. 105a-105c EPC); also cf. *Paterson*, N 14-19A. For an overview of the new procedure cf. Luginbuehl Stefan, *Limitation and Revocation in the European Patent Convention - Outlines of the New Procedure*, 2001 IIC, 607-625.

²⁴³ Cf. The First action Plan for Innovation in Europe of 20.11.1996, COM(1996) 589 final, 4.

²⁴⁴ Cf. CP Regulation Proposal, 6; also cf. *Bossung, Return; Armitage, Policy and Kolle, CP*, 617-618.

²⁴⁵ Cf. *Bossung, Return*, 304; *Armitage, Policy*, 556.

²⁴⁶ Community patents would be subject only to the provisions of the CPC 1989 and those provisions of the EPC which are binding upon every European patent and which are consequently deemed to be provisions of the CPC (see Art. 2(3) CPC 1989).

However, national courts acting as Community Patent Courts would have decided on infringements and revocations of Community patents. Clearly, therefore, national judges with their respective legal views and cultural background would have construed the law, which would have led to different interpretations and which could have been unified only at second instance with the COPAC.

In addition, various states designated too many national courts that would have acted as Community courts. This fact, along with the consequent lack of specialisation, would have underscored the dangers of disunity²⁴⁷ and *forum shopping*.

The CPC also only contains a limited number of provisions in the form of substantive law complementary to the EPC, governing, in particular, infringement²⁴⁸ and validity of Community patents²⁴⁹. A further harmonisation of law would have thus been necessary to avoid there again being a nationally coloured interpretation of Community patent cases²⁵⁰. This was, however, blocked by the EC member states²⁵¹. The CPC, for example, does not provide any regulations in regard to sanctions²⁵², damages²⁵³, the taking of evidence, or the issuance of preliminary injunctions²⁵⁴, all of which vary in Europe²⁵⁵.

What should be asked is whether the CPC 1989, in cooperation with the COPAC, would have led to a harmonisation of law and ensured uniformity of interpretation in the EC as such.

²⁴⁷ Cf. *Sedemund-Treiber, Strukturen*, 122.

²⁴⁸ Cf. *Stauder, Significance*, 793.

²⁴⁹ Cf. *Paterson*, N 14-26.

²⁵⁰ Cf. *Schade, Streitregelungssystem*, 831; *Tilmann, Harmonisierung*; *Ryberg; Schäfers, Anmerkungen*, 828.

²⁵¹ Cf. *Kolle/Stauder, 3. Symposium*, 513.

²⁵² The only provision in the CPC with a sanction character is the permission given to all Community Patent Courts to issue orders prohibiting the defendant from proceeding with the acts which infringed, or would infringe, the patent (see Art. 35(1) CP Litigation Protocol).

²⁵³ Cf. *Stauder Dieter, Einheitliche Anknüpfung der Verletzungssanktionen im Gemeinschaftspatentübereinkommen*, 1983 GRUR Int., 586-590, 590; *Kolle/Stauder, 3. Symposium*, 513; *Scordamaglia, II*, 467.

²⁵⁴ Cf. *O'Sullivan*, 661-662; *Scordamaglia, II*, 472; also see Art. 36(3) CP Litigation Protocol.

²⁵⁵ Cf. *European Patent Litigation Handbook*, Reid Brian C. (ed.), London 1999; Patent enforcement in Selected Countries, *Festschrift für Dieter Stauder*, 2000 IIC 627-770; but also *Bruchhausen, Ausgleichsansprüche*; statement of Canivet Guy in: *Michalland*, 9; *v. Meibom/Pitz, Cross-border Injunctions*, 473-476; *Treichel*, 85. This diversity will continue to exist even after the Enforcement Directive is implemented by all the EU member states, albeit to a lesser extent (cf. §6 D.II.3. Uniform law concerning patent litigation).

The main argument against this idea is the "optional solution", i.e. the right to choose between a Community patent and a European patent.

Although the national law was greatly harmonised²⁵⁶, mainly because of the EPC and the CPC²⁵⁷, it is a fact that there were and still are differences in national patent laws amongst the EU member states, and the European patent law is interpreted differently by the individual national courts²⁵⁸. The COPAC would not have had any jurisdiction in regard to European or national patents, but it certainly would have had some influence on the jurisprudence of the national courts, as do the EPO Boards of Appeal or courts of other states, not least as there probably would have been cooperation among the patent judges, as this has become a reality in the last few years²⁵⁹. This would have led to a certain unitary interpretation of law but disunity could probably not have been fully avoided.

Furthermore, multiple litigation would not have disappeared: the Community patent itself would have normally, but not always, been litigated before one court. However, again the "optional solution", and the fact that not all EPC contracting states are members of the EC, would have still given rise to multiple litigation in regard to European patents.

²⁵⁶ Cf. *Stauder, Vom*, 45.

²⁵⁷ Cf. *Krasser, MGK 22*, N 1-3; *Haertel, Harmonisation*, 729-730. The Strasbourg Convention obviously only played a minor role in regard to the alignment of national patent laws (cf. *Haertel/Stauder*, 88). The fact that patents were granted for the territory of an EPC contracting state not only by national offices but also by a European office led to an alignment of the requirements for and effects of national patents with those of the European patents (see *Haertel, Harmonisation*, 731).

²⁵⁸ Cf. Chapter one: General introduction.

²⁵⁹ Cf. *Walter H.P., Auslegung; Rogge, Zuständigkeit*, 645-648; *Leith, Judicial Roles*, 56; *Jacob, Decisions*, 13-15; *Brinkhof, Revocation; Karet, UK and EPO* but also decision *Merrell Dow Pharmaceutical Inc. v H.N. Norton & Co. Ltd*, 1996 RPC, 76.

CHAPTER THREE: ALTERNATIVE ATTEMPTS TO ACHIEVE A UNIFIED INTERPRETATION AND POSSIBLE SOLUTIONS TO THE PROBLEMS RELATED TO THEM

§2 SPECIALISED NATIONAL PATENT COURTS

A. Introduction

It is obvious that a uniform application of European patent law is better ensured if there is a limited number of specialised courts at the national level which deal with the matter²⁶⁰.

Specialised courts are courts established by law²⁶¹ having jurisdiction in certain predetermined legal fields.

Such courts aim to reduce the caseload of the common civil courts²⁶² and to relieve general judges of the duty to render decisions in an area of law with which they are unfamiliar because they are hardly ever confronted with it²⁶³. Specialised courts should therefore basically provide for more efficient proceedings - not least since there is a tendency for not only judges to become highly experienced in a certain field of law, but also lawyers - culminating in a more predictable outcome²⁶⁴ and high-quality decisions in special fields of law²⁶⁵. Legal certainty could consequently be improved²⁶⁶. This again ensures the greater confidence of users in the system²⁶⁷.

It was recognised early on that specialised courts may lead to quicker and more effective²⁶⁸, simpler²⁶⁹ and, in the end, cheaper²⁷⁰ proceedings²⁷¹. It is therefore no

²⁶⁰ Cf. also *Kropholler, Internationales*, 135-137, *Linhart*, 272-274.

²⁶¹ Cf. Art. 6(1) ECHR.

²⁶² Cf. *IBA, Survey*, 26.

²⁶³ Cf. *Boval, Spécialisation*, 52.

²⁶⁴ Cf. *IBA, Survey*, 25.

²⁶⁵ Cf. *Haefliger/Schürmann*, 158; *Stauder, Verletzungsverfahren*, 140.

²⁶⁶ Cf. *Brack*, 4; *Brunner, Verwertung*, 22; *Boval, Spécialisation*, 52.

²⁶⁷ Cf. *Vogel/Spühler*, §3, N 62.

²⁶⁸ Cf. *IBA, Survey*, 26.

²⁶⁹ Cf. for example *Kölz Alfred* in: *Kommentar zur Bundesverfassung der Schweizerischen Eidgenossenschaft* vom 29. Mai 1874, Basel et al. 1987, Art. 58, N 71; *Müller, Garantie*, 257; cf. also *McMichael v UK*, ECtHR February 24, 1995, A-307B, § 80.

²⁷⁰ Cf. *Winter*, 222; *Brack*, 15.

²⁷¹ Cf. also the conclusions drawn by the chair in the second session of the WIPO Advisory Committee on Enforcement, WIPO/ACE/2/13, N 8.

surprise that the call for specialised courts in intellectual property, and especially patent law, was made early on.

The International Bar Association (IBA) qualifies²⁷² a court specialised in IP²⁷³ as a

"...permanently organised body with independent judicial powers defined by law, consisting of one or more judges who sit to adjudicate disputes and administer justice in the IP field".

This definition can be transferred *mutatis mutandis* to courts specialised in patent litigation.

"Commercial courts", for example, clearly fall under the definition of specialised courts since they solely deal with disputes related to business and commerce. The same can be said with regard to "commercial chambers" of general civil courts, dealing exclusively with business matters. It is also possible that certain jurisdictional parts of a commercial court will be transferred to another new court in order to create further specialisation.

Specialised courts should not be confused with a specialised division or chamber within a common civil court or so-called "docket management", where cases involving a special matter are assigned to certain judges in a general court in order to create some specialisation²⁷⁴.

Specialised divisions or chambers are in most cases permanent institutions. However, depending on the volume of cases they could also function for limited time periods, after which the resources involved (courtrooms, clerks and judges) would merge back into the general patterns for administration of justice²⁷⁵. A simple *ad hoc* and arbitrary functioning of the court with a limited competence in time, in territoriality and in subject matter²⁷⁶ would, however, be classed as unconstitutional²⁷⁷ in many states and be against the ECHR²⁷⁸. Such a court would no longer fulfil the basic human right that a court must be

²⁷² See *IBA, Survey*, 4-5.

²⁷³ The survey distinguishes between the terms "court" and "tribunals". This distinction seems, however, not to include any differences in the content.

²⁷⁴ Cf. *Sherwood*, 506.

²⁷⁵ Cf. *Sherwood*, 507.

²⁷⁶ Cf. *Altherr*, 27.

²⁷⁷ Cf. e.g. Art. 30(1) Swiss Constitution; Art. 101(1) German Constitution.

²⁷⁸ Art. 6(1) ECHR requires that a court must be established by law. A court established *ad hoc*, i.e. courts only established to decide a particular case or courts that are composed in an extraordinary form are

established by law in order to guarantee the independence of the court and the principle of equal treatment, and to exclude possible judicial manipulation and arbitrariness²⁷⁹.

I. Potential risks of specialised courts

Specialised courts could certainly also have disadvantages. The IBA listed them in its international survey of specialised intellectual property courts and tribunals as follows²⁸⁰:

- the costs of maintaining the courts may be high,
- there could be a lack of local presence and the court could therefore become inaccessible for parties since a specialised court normally also leads to an increased territorial jurisdiction, again leading to higher costs because of longer travel distances,
- the isolation of the court²⁸¹ carries the risk that its jurisprudence may move away from the development of the general law and jurisprudence,
- there could be a loss of a generalists' overview and consequently a lack of fresh and new perspectives of the judges to the problems - "you can't see the wood for the trees",
- the overlap with other areas of law - i.e. if the judge specialist in one certain area of law also has to answer legal questions from other areas, such as contract law -. For such cases it is suggested that a generalist judge should try the whole case, rather than a specialised judge, who might be tempted to develop inappropriate general principles of law,
- lawyers appearing regularly before the specialised court could become well acquainted with the court's specialities and could have an advantage over lawyers who do not appear regularly in front of the court, and
- a certain possible tendency to informality in proceedings.

II. Dealing with those risks

It seems that there are responses to quite a few of those risks and potential dangers:

therefore not allowed (*Villiger*, N 414; *Haefliger/Schürmann*, 158; also cf. *Lithgow and others v UK*, ECtHR July 8, 1986, Series A No. 102, § 201). Cf. also Art. 47(2) Charter of Fundamental Rights of the European Union.

²⁷⁹ Cf. *Müller, Garantie*, 255-258.

²⁸⁰ Cf. *IBA, Survey*, 27-28.

²⁸¹ Cf. also *Boval, Remarques*, 167-168.

- First, the potential risk that a specialised court moves away from the developments of general law and jurisprudence or the lack of new ideas of specialised judges could be reduced by giving the judges the opportunity for continuing training in general areas of law. This could be achieved by providing the court with the necessary scope of jurisdiction in terms of subject matter in order to make it possible for the judges to keep in touch with general developments. Instead of a generalist judge being left alone to deal with non-specific issues, it should rather be the other way round: a specialised judge should regularly be provided with the opportunity to apply general law. The subject matter in the jurisdiction of a patent court should therefore include general fields of law, for example, licensing agreements and agreements to assign a patent right, but also distribution contracts and agency agreements, or damages and compensation.

Additionally, judges could regularly be trained in general law - with which they must in any case be familiar before they can specialise - in order to stay up to date with recent developments and trends.

- Second, with regard to the risk of the increasing costs of maintaining the court, it seems that in fact the entire litigation costs could increase with a specialised court.

On the one hand, the legislator could see fit to determine the court fees at levels (or close at such levels) which would ensure that the court is self-financing, not least if mainly companies would be litigating before the specialised court and the parties should therefore not only be capable of paying more but also be ready to do so if the quality of proceedings and judgments is clearly improved. However, it is clear that court fees must not be prohibitive and constitute a serious obstacle to litigation.

On the other hand, lawyers (and possibly the patent attorneys) should be better qualified and would consequently be more expensive. Experience shows that it is a very difficult task to limit the costs for party representatives and other experts supporting a party. The creation of greater competition among them could be helpful in this regard.

It goes without saying that legal aid will have to be provided if a party is unable to pay the litigation costs²⁸². In addition, consideration should also be given to providing litigation support for SMEs, as in many states companies are not entitled to legal aid.

- Third, the lack of local presence could indeed be a problem with regard to the general human right of fair access to justice²⁸³. Today this problem should, however, not be as severe as it was perhaps one hundred years ago.

Travelling and communication have become much easier and, depending on the legal field in question, mainly there are companies involved for which the travel problem does not seem very great. However, if indeed access to justice was in jeopardy, one solution could be for the court to try the case over videoconference. If the immediacy principle could not be fully guaranteed by such a conference, the court could travel to a location nearer the parties or the defendant.

- Fourth, the potential risk of lawyers appearing regularly before the court having an advantage over other lawyers could also constitute a risk before a generalist court. This is, in particular, the case if there are only a limited number of lawyers active in certain fields of law or in a certain area of a court's jurisdiction. It will consequently be up to the court to guarantee a fair trial for both parties and indeed to counter the risk of making the proceedings informal. In any case, the necessary remedies would have to ensure that the lower instances adhere to the legal procedure and that any breach of (procedural) law be corrected.

III. Demand for specialised patent courts

Patent litigation is, without doubt, a relatively rare occurrence in practice and is, at the same time, highly technical and very complex. The reason for that situation lies, on the one hand, in the fact that patents give control over new products and processes which may prove to be crucial in the advancement of an industry²⁸⁴ and which are consequently

²⁸² Cf. also Art. 47(3) Charter of Fundamental Rights of the European Union.

²⁸³ Art. 6(1) ECHR; Art. 47(2) Charter of Fundamental Rights of the European Union.

²⁸⁴ Cf. *Cornish/Llewelyn, Enforcement*, 87; 88. *Centrafarm BV v Sterling Drug Inc*, ECJ October 31, 1974, (case 15/74).

complicated to express in legal terms. On the other hand, only a limited number of granted European patents ever become part of litigation.

Owing to the major economic importance of patents it is no surprise that, in many countries, the demand for specialised civil courts with judges having extensive knowledge of patent law was voiced in the last century almost at the same time as the request for national patent regulations²⁸⁵.

At the European level it took much longer for such calls to be made. The efforts to create a Community patent proved to be the basis for the first such approach²⁸⁶.

As mentioned earlier, the EC member states agreed to take the necessary measures to establish specialised national infringement courts in regard to Community patents at the Intergovernmental Conference in 1975. This would have been achieved by way of centralisation of the first-instance jurisdiction on their territory. The resolution was limited to the infringement courts, as the revocation of Community patents would have been centralised in a two-instance procedure before the EPO²⁸⁷.

In the CPC 1989 it was agreed that national courts in a limited number listed in the annex would act as "Community Patent Courts" of first and second instance²⁸⁸. Several states, however, designated all their courts - obviously for political and federalist reasons - to have jurisdiction at the national level²⁸⁹. With regard to second-instance litigation, the COPAC should have ensured a uniform interpretation²⁹⁰.

²⁸⁵ E.g. in France, patent matters are heard in first instance by the higher level district courts since the 1844 Patents Act has been in force (cf. *Brüning-Petit, Enforcement*, 142); in England patent actions were, as early as 1876, tried before a specialised division of the High Court (cf. *Cornish/Llewelyn, Enforcement*, 88); in Germany the request for specialised infringement courts was voiced at the end of the last century (cf. *Stauder, Rechtszug*, N 38); in Switzerland it was during the first revision of the patent act in 1907 that the establishment of a specialised industrial property court was discussed for the first time (cf. *David*, 4, n. 6 with reference to Guyer/Weiss, 3/1906 SJZ, 33, 46, 58, 109 and 146).

²⁸⁶ Cf. §1 D.I. Aims and development; cf. also *Bossung, Grundfrage*, 64.

²⁸⁷ Cf. §1 D.I. Aims and development.

²⁸⁸ Art. 1(1) and (2) CP Litigation Protocol.

²⁸⁹ Germany and France listed all their specialised courts (nine in each instance for Germany and ten for France in each instance).

²⁹⁰ Cf. §1 D.II. Jurisdiction.

In regard to European patents, it took even longer for concentration on the courts to be called for²⁹¹. The reason for this late call has to be seen in the fact that jurisdiction for proceedings concerning the infringement and revocation of European patents lies in the authority of the EPC contracting states²⁹². Consequently, there was basically no common patent litigation policy in existence among these states. This has changed, however.

At the Intergovernmental Conference of Paris on June 24/25, 1999, the government representatives declared that they wanted to increase the effectiveness and legal certainty of the protection conferred by European patents²⁹³. Improving the enforcement of patent rights in Europe was, therefore, classed as an important step in strengthening the European patent system and was seen as a strong deterrent to the heavy competition posed by Asia and the USA.

There are, however, more reasons which provoked the call for a specialised patent court at the European level.

On the one hand, it should be kept in mind that justice can only be guaranteed if the courts correctly apply the law. This could obviously not be ensured all over Europe, however.

On the other hand, the small number of cases and the (technical) complexity²⁹⁴ of patent law, as well as the often high value in dispute²⁹⁵ - and therefore well-paid job²⁹⁶ - created highly specialised lawyers who almost exclusively plead patent cases²⁹⁷. Additionally, lawyers are in general accompanied by patent attorneys specialised in the technical field concerned. Consequently, a specialisation of the courts and judges interested in the matter seems necessary, not least because judges should have the same level of legal knowledge as the lawyers who appear in front of them. British judges, in particular, argue

²⁹¹ Cf. *Stauder, Verletzungsverfahren*, 140.

²⁹² Cf. Art. 64(3) EPC. This fact is also underlined by Article 64(1) EPC, which makes it clear that a European patent confers on its proprietor, in each contracting state in respect to which it is granted, the same rights as would be conferred by a national patent granted in that state.

²⁹³ Cf. 1999 O.J. EPO, 548.

²⁹⁴ Cf. *Ryberg*, 909.

²⁹⁵ Cf. *Stauder, Verletzungsverfahren*, 140.

²⁹⁶ Cf. *Laddie, de Ranitz*, 528.

²⁹⁷ Cf. *Brinkhof, Enforcement*, 172; *Stauder, Verletzungsverfahren*, 141; *Brüning-Petit, Enforcement*, 140.

that the judges should even have a background in science in order to quickly understand the technical questions²⁹⁸.

This brought the EPC contracting states *inter alia* to the conclusion that a consolidation of courts should be envisaged in all contracting states. Within the framework of the revision of the European patent system, an appropriate recommendation was therefore agreed upon.

The governments of the EPC contracting states stated in Paris that they would take whatever measures each considered necessary to study the restriction to a minimum – which in some states could mean three or less – of the number of courts dealing with patent litigation²⁹⁹.

The following overview of the jurisdictional organisation in France, Germany, the Netherlands and the United Kingdom, however, shows that a certain - *de facto* -³⁰⁰ concentration had already been achieved³⁰¹ before the Intergovernmental Conference.

These states were chosen in the overview, as most patent cases are litigated before courts of these states³⁰². Switzerland, which also appears in the overview, will serve as an example to illustrate how difficult it can be to create a specialised court in a state with a strong federalist structure.

In any case, it should be noted that there is no international treaty in existence (such as the TRIPs Agreement³⁰³) that would make the creation of specialised courts obligatory, nor has such a treaty been proposed.

²⁹⁸ Cf. Judge Fysh, Judge leads push for specialised IP courts, IBA Daily News, Tuesday, September 27, 2005, <www.iflr.com>, 3.

²⁹⁹ 1999 O.J. EPO, 548.

³⁰⁰ Cf. Beier Friedrich-Karl in: *Kolle/Stauder, 1st Symposium*, 829.

³⁰¹ Cf. also *Brinkhof, Change*, 104.

³⁰² Cf. WPL/4/03. The countries dealing with most patent cases are a mirror of those countries for which most European patents are granted: France, Germany and the UK (cf. tables showing the volume of patent litigation in the EU member states, Council of the EU, Doc. 12786/02 and Working Document from the Presidency, Towards an Enhanced Patent Litigation System and a Community Patent - How to Take Discussions Further (Doc. 11622/07), available at <www.epo.org/topics/news/2007/20070725.html>).

³⁰³ Cf. in particular Art. 41(5) TRIPs Agreement; *Gervais*, N 2.375; *Dreier*, 261; *Heath*, 14. The lack of some basic obligations in the TRIPs Agreement as to how to organise jurisdiction led to concerns regarding the effectiveness of IPR enforcement (cf. *Stahelin*, 179-180).

B. France

I. Courts of first instance

In France, it was recognised early on that patents should be dealt with by specialised courts³⁰⁴.

It was decided not to create specialised patent courts but instead to give ten *tribunaux de grande instance* (district courts)³⁰⁵ exclusive jurisdiction for actions on infringement and revocation of patents. To establish a certain specialisation of the judges in patent litigation, patent cases have always been allocated to the same division of the appropriate district court. It was thought that all the ten courts would be provided with the necessary experience by this manner of organisation.

However, as mentioned earlier, patent cases are relatively rare compared to many other cases in commercial law. In addition, there is a great concentration of business at the French capital. Consequently, it was the *tribunal de grande instance* in Paris and its 3rd Chamber³⁰⁶ which evolved as the most experienced French patent litigation court³⁰⁷. This concentration and specialisation turned out to be problematic, as it led to a vicious circle.

The other district courts in France and their respective judges could not achieve the necessary experience and, in some cases, obviously even lost their skills due to the fact that more and more cases were adjudicated by the district court of Paris³⁰⁸, which again became even better qualified. The lack of experienced district courts went so far that plaintiffs obviously tried to ground jurisdiction in Paris by a fake order of delivery to the

³⁰⁴ Cf. Act of July, 5, 1844; *Brüning-Petit, Enforcement*, 142; *Lenoir/Banchereau*, N 4-01, *Treichel*, 101.

³⁰⁵ Cf. Art. L615-17 to L615-19 French Intellectual Property Code ("*Code de la propriété Intellectuelle*"). The courts ("*Tribunaux de grande instance*") with jurisdiction in patent litigation are located in Bordeaux, Lille, Limoges, Lyon, Marseille, Nancy, Paris, Rennes, Strasbourg and Toulouse (cf. Art. R312-1 and R312-2 French Judicial System Code ("*Code de l'organisation judiciaire*"), as well as Art. L631-1 French Intellectual Property Code). Since 1 January 2006 the district courts in Limoges, Nancy and Rennes no longer have jurisdiction to deal with the infringement and revocation of patents (cf. décret No. 2005-1756 du 30 décembre 2005; *INPI, Litiges*, 67). France designated all these ten courts as "Community Patent Courts" of first instance in the CPC 1989 (cf. §1 D.II Jurisdiction)

³⁰⁶ Cf. *Lang*, 324.

³⁰⁷ Cf. Canivet Guy in: *Michalland*, 15; *Véron, Patent Infringement*, 388; *Triet/Michel*, 103.

³⁰⁸ In order to establish jurisdiction with the district court in Paris, it is common practice first to conduct a "*saisie contrefaçon*" - an order for inspection of premises and the preservation of evidence - at a department store in Paris in order to create the necessary territorial connection between the patent infringement and the French capital.

capital, a move that was rejected by the court³⁰⁹. It was decided, therefore, to concentrate jurisdiction further and reduce the number of district courts with jurisdiction in patent disputes to seven³¹⁰.

Besides the above-mentioned lack of experience of certain district courts, there are additionally complaints that there is a lack of technical knowledge in the courts³¹¹ and that there are difficulties in effectively enforcing decisions³¹². The main reasons for the complaints with regard to the costs seem, however, to lie in the system of fixing them independently of the value in dispute, which makes "small" cases quite expensive³¹³.

Today, between fifty and sixty percent of all patent cases in France are litigated in Paris³¹⁴. Delays in decision-making have therefore become a problem³¹⁵. Proceedings from the date of the writ of summons to the oral hearing last, in general, about two years³¹⁶ although it seems not uncommon for proceedings to last up to three years in first instance³¹⁷.

The call for specialised patent courts³¹⁸ or court divisions³¹⁹ has therefore become more prevalent again.

In general, the jurisdiction of first-instance courts for infringement is basically established at the place of tort or at the domicile or seat of the defendant³²⁰, as also provided for by

³⁰⁹ Cf. *Codexim v Supra*, Tribunal de grande instance de Paris (District Court of Paris), January 11, 1991, 1991 P.I.B.D. III, 373-374.

³¹⁰ Since 1 January 2006 the district courts in Limoges, Nancy and Rennes no longer have jurisdiction to deal with the infringement and revocation of patents (cf. décret No. 2005-1756 du 30 décembre 2005; *INPI, Litiges*, 67).

³¹¹ Cf. *INPI, Litiges*, 65-67.

³¹² Cf. *Martin*, 10; 16-17.

³¹³ Cf. Vièl Christof, *Kosten eines Patentverletzungsprozesses und Berechnung des Schadensersatzes in Frankreich*, Mitt. 2002, 412-414, 413.

³¹⁴ Cf. *INPI, Litiges*, 67. Cf. also Boval Bruno in: *Michalland*, 14; *Treichel*, n. 514; *Brüning-Petit, Enforcement*, 140 and n. 15 with a reference to Véron Pierre, *Le contentieux des brevets d'invention, Etude statistique sur 1990-1996 pour la Fédération Nationale des Entreprises (FNDE)-ASPI*, November 1997. In the 1970s more than 90% of the patent cases were decided by the competent court in Paris (cf. *Stauder, Verletzungsverfahren*, 91).

³¹⁵ Cf. *Belfort*, 78-81; *Martin*, 10-13; Statement of Boval Bruno in: *Michalland*, 14; *Brüning-Petit, Enforcement*, 142; Véron Pierre in: *Bodoni*, 33.

³¹⁶ Cf. *Michel*, 36; *Triet/Michel*, 112.

³¹⁷ Cf. *INPI, Litiges*, 60.

³¹⁸ Cf. *Michalland*, 14; *Martin*, 23; *Belfort*, 87.

³¹⁹ Cf. *INPI, Litiges*, 107-108.

³²⁰ Cf. *Lang*, 324.

Regulation 44/2001 and the Lugano Convention. Regarding preliminary measures, it is the president of the *tribunal de grande instance* who has the appropriate authority³²¹. The case on the merits is heard by a panel of three legal judges³²². There are no technical judges involved³²³. The parties must be represented and assisted by a lawyer³²⁴. Patent attorneys are not allowed to represent parties but they take part in the proceedings and may speak to the court³²⁵.

II. Courts of further instance

The decisions of the district courts can be appealed to the courts of appeal (*Cour d'appel*) having jurisdiction over the district court³²⁶. It is therefore no surprise that most cases at the appeals level are heard by the (4th Chamber of the) *Cour d'appel* in Paris³²⁷. The *Cour d'appel* has jurisdiction in regard to facts and law³²⁸.

Final appeal on questions of law to the highest civil court of France is possible. This court is called *Cour de cassation*. As in a traditional third instance³²⁹, the *Cour de cassation* may only decide legal questions and simply quash (casser) judgments³³⁰. Furthermore, since the infringement of a patent is regarded as a question of fact and not of law in France, the court is only, to a very limited extent, competent to adjudicate infringement cases³³¹. It will elaborate general legal principles concerning the interpretation of claims, indirect infringement or partial nullity, but it will not apply them to the case in point, for example. That will be up to the court of appeal once it quashes the judgment.

³²¹ Cf. Art. L615-3 French Intellectual Property Code ; also cf. *Treichel*, 113-114; *Brüning-Petit, Enforcement*, 160-161; Schmidt-Szalewski Joanna, Die Entwicklung des französischen Patentrechts in den Jahren 1997-1998, 1999 GRUR INT., 848-852, 852.

³²² Cf. *Michel*, 36.

³²³ Cf. *Triet/Michel*, 103.

³²⁴ Cf. *Triet/Michel*, 103.

³²⁵ Cf. *Véron, Patent Infringement*, 390.

³²⁶ Cf. Art. R631-1 French Intellectual Property Act.

³²⁷ Cf. *Triet/Michel*, 103.

³²⁸ Cf. *Lenoir/Banchereau*, N 4-10.

³²⁹ Cf. *Le Tallec, Subject-matter*, 359.

³³⁰ Cf. *Casalonga, Le contentieux*, 91.

³³¹ Cf. *Le Tallec, Subject-matter*, 358; *Treichel*, 104-105; *Lenoir/Banchereau*, N 4-11.

If the court of appeal insists on the quashed judgment and the decision is again appealed, the *Cour de cassation* renders a final judgment which the court of appeal has to finally put into practice. These cases are, however, very rare³³².

C. Germany

I. Courts of first instance³³³

1. Introduction

The patent revocation authority in civil court proceedings lies exclusively³³⁴ with the *Bundespatentgericht* (Federal Patent Court).

The establishment of this court in Munich in 1961 had previously necessitated an amendment to the German Constitution (*Grundgesetz*)³³⁵. Article 96(1) German Constitution therefore provides the state with the authority to create a court specialised in intellectual property. The *Bundespatentgericht* is the only special court that has been established on the basis of this provision³³⁶.

The reason for the efforts to create the *Bundespatentgericht* was a decision of the *Bundesverwaltungsgericht* (Federal Administrative Court) which classed the results in proceedings before the German Patent and Trade Mark Office as administrative acts and not as civil acts. Such acts would therefore have required an independent judicial control which obviously did not exist. The implementation of this decision on the basis of the existing jurisdictional structures would have led, however, to complicated legal action entailing possibly five instances³³⁷. The legislator therefore decided to create a specialised

³³² Cf. *Casalonga, Le contentieux*, 91.

³³³ For a graphic overview cf. *Adolphsen, Europäisches*, N 140.

³³⁴ Cf. § 65(1) German Patent Act.

³³⁵ Cf. Krieger Albrecht, *Das Bundespatentgericht als „Bundesgericht für Angelegenheiten des gewerblichen Rechtsschutzes“* (Artikel 96 Grundgesetz), 1977 GRUR, 343-350, 345-350; *Rogge, Zuständigkeit*, 642; Schwendy Klaus in: *Busse, §65, N 6; Krasser, Patentrecht*, 109.

³³⁶ Cf. *Schulte, §65, N 6*.

³³⁷ Cf. *Rogge, Zuständigkeit*, 642-643; Krasser Rudolf, *Patentrecht, 50 Jahre Bundesgerichtshof, Festgabe aus der Wissenschaft*, Canaris Claus-Wilhelm/Heldrich Andreas/Hopt Klaus J./Roxin Claus/Schmidt Karsten/Widmaier Gunter (eds.), vol. II. *Handels- und Wirtschaftsrecht Europäisches und Internationales Recht*, Heldrich Andreas/Hopt Klaus J. (eds.), München 2000, 647-675, 648-649; *Stauder, Rechtszug*, N 69; *Pitz, Entwicklung*, 234-235; Schwendy Klaus in: *Busse, §65, N 5; Schneider*, 146-147.

patent court. The court was created by a transfer of the boards of appeal and the so-called *Nichtigkeitssenate* ("nullity senates"³³⁸) into an independent judicial body³³⁹.

In contrast to infringement proceedings, technical judges sit on the panel³⁴⁰ and patent attorneys may represent parties³⁴¹ in the proceedings of the *Bundespatentgericht*. As regards infringement proceedings, there are no specialised patent courts in Germany³⁴². Basically, more than 120 *Landgerichte* (district courts) have jurisdiction in regard to preliminary injunctions³⁴³ and exclusive jurisdiction in regard to infringement proceedings without financial limit to the claims³⁴⁴. The right of the *Länder* (states) to concentrate jurisdiction on certain courts was, however, used to a great extent³⁴⁵ and reduced the number of courts having jurisdiction in patent infringement cases to twelve³⁴⁶.

An extensive use of the *forum shopping* possibilities³⁴⁷ led to four *Landgerichte*³⁴⁸ developing considerable experience in patent infringement cases³⁴⁹, and they deal with at least four-fifths of the infringement cases in Germany³⁵⁰. These courts have also set up specialised chambers³⁵¹ which are almost exclusively concerned with disputes in the area of the legal protection of patents³⁵².

³³⁸ Divisions for rendering revocation decisions.

³³⁹ Cf. *Stauder, Rechtszug*, N 70; *Rogge, Zuständigkeit*, 643. Cf. also the critical remarks by *Schneider*, 147. In regard to the position of the Federal Patent Court in the German court organisation structure, cf. Mes Peter, *Der Anspruch auf das Patent – ein Rechtsschutzanspruch?*, 2001 GRUR, 584-588.

³⁴⁰ Cf. *Schneider*, 136; 149.

³⁴¹ Cf. Dreiss Uwe, *Zehn Gründe für eine Vertretungsbefugnis der Patentanwälte in Europa vor einem künftigen Europäischen Patentgericht*, 2000 Mitt., 475-479, 475; von Rospatt Peter, *German Patent Litigation*, Düsseldorf 2002, 19.

³⁴² Cf. *Marshall*, 110.

³⁴³ Cf. § 937(1) German Civil Procedure Act.

³⁴⁴ Cf. § 143(1) German Patent Act.

³⁴⁵ Cf. § 143(2) German Patent Act; Rogge Rüdiger/Grabinski Klaus in: *Benkard, PatG*, §143, N 15; *Vossius/Hepworth*, N 5-05; *Stauder, Verletzungsverfahren*, 17; *Wirtz/Liesegang*, 73.

³⁴⁶ Cf. *Krasser, Patentrecht*, 110; *Landfermann, Entwicklung*, 342.

³⁴⁷ Cf. *Schade, Regelung*, 105; *v. Meibom/Kreye*, 39; also cf. §3 *Forum shopping* related to patent litigation in Europe.

³⁴⁸ In order to establish jurisdiction within one of the four courts, parties often indirectly agree to the jurisdiction, i.e. the jurisdiction as designated by the plaintiff is not challenged by the defendant. Sometimes plaintiffs also "provoke" jurisdiction of one of the four courts by claiming a potential patent infringement act on the territory within which one of the four courts has jurisdiction: the plaintiff acts as potential buyer of the allegedly patent-infringing product and requests a brochure of the product from the infringer (cf. also *Wirtz/Liesegang*, 73).

³⁴⁹ Düsseldorf, Hamburg, Mannheim and Munich I.

³⁵⁰ Cf. *Stauder, Weg*, 477; *Marshall*, 114; *Loth*, 52; *Pitz, Aspects*, 22.

³⁵¹ Hamburg has not set up specialised chambers.

³⁵² Cf. *Schneider*, 136; *Wirtz/Liesegang*, 73.

The infringement courts usually render a judgment within nine to twelve months³⁵³. Not least this experience and the speed of proceedings led to the fact that more than 50% of all patent infringement cases in Europe are heard by German courts³⁵⁴.

2. Split proceedings ("bifurcation")

For historical and, not least, federalist reasons³⁵⁵ the German patent court system is characterised by its split proceedings (or "bifurcation"). That is to say, there is a clear division between infringement and revocation action in regard to European and national patents³⁵⁶.

A defendant can consequently not call the validity of a patent into question in infringement proceedings but rather has to initiate separate revocation proceedings³⁵⁷. The only possible defence grounded on lack of patentability that may be put forward in an infringement case is that the variant which the plaintiff contends falls within the scope of protection of his patent forms part of the state of the art³⁵⁸.

The separation of revocation and infringement was introduced as early as 1877 with the entry into force of the German Patent Act³⁵⁹. The grant of the patent was classed as the will of the patent office, and it therefore seemed impossible that a district court - with its possible lack of knowledge of patents - could decide on its invalidity³⁶⁰.

However, there are quite a number of advantages to infringement and revocation being dealt with by the same authority.

³⁵³ Cf. *v. Meibom/Kreye*, 39. The "*Bundespatentgericht*" may render a judgment in 1.5 years (cf. *v. Meibom/Kreye*, 40).

³⁵⁴ Cf. WPL/SUB 4/03 + Add. 1; Council of the EU, document of October 7, 2002, No. 12786/02; Working Document from the Presidency, Towards an Enhanced Patent Litigation System and a Community Patent - How to Take Discussions Further (Doc. 11622/07), available at <www.epo.org/focus/news/2007/20070725.html>; *Frankfurter Allgemeine Zeitung*, Patentstreit oft vor deutschen Gerichten, 13. Oktober 1999, W1; also cf. *Rau*, 242; *Stauder*, *Verletzungsverfahren*, 17-18.

³⁵⁵ Also cf. *Pakuscher*, *Nichtigkeit*, 314-316.

³⁵⁶ For a graphic overview of the proceedings, cf. *Loth*, 48.

³⁵⁷ Cf. *Klink*, 499; *Schneider*, 133.

³⁵⁸ Cf. Decision of the *Bundesgerichtshof*, April 29, 1986 (X ZR 28/85 (BPatG), *Formstein*; 1987 O.J. EPO, 551-557.

³⁵⁹ Cf. *Pakuscher*, *Reform*, 371; *Pitz*, *Entwicklung*, 231; *Sedemund-Treiber*, *Technischer Richter*, 1005.

³⁶⁰ Cf. *Ströbele*, 69-70; *Schneider*, 132.

On the one hand, infringement proceedings never have to be stayed if the question of nullity has been raised. Proceedings usually become more economical³⁶¹ and more efficient and can therefore be simplified³⁶². The patent can be examined by the court in its entirety³⁶³.

On the other hand, patent infringement and patent validity are very closely related³⁶⁴ and the judge dealing with nullity often has to decide on the same issue as the judge dealing with the infringement. This is, for example, the case with regard to the determination of the extent of protection of the patent³⁶⁵. The judge dealing with nullity could have to decide on equivalence³⁶⁶ when defining the scope of a priority right, whereas the judge dealing with the infringement could have to decide on it when deciding on the alleged infringement. Consequently, contradictory decisions cannot entirely be avoided and legal certainty be fully assured³⁶⁷.

Today, the majority of German experts seem to support the adoption of a possible future European system whereby infringement and revocation are dealt with by the same instance³⁶⁸, despite the constitutional problems that might arise³⁶⁹. This is not least underlined by the fact that Germany and German industry are supporting the

³⁶¹ Cf. Pakuscher, *Nichtigkeit*, 314; Stauder, *Verletzungsverfahren*, 144.

³⁶² Cf. Stauder, *Auf dem Weg*, 178; Brinkhof, *Change*, 106; Schade, *Regelung*, 104-105.

³⁶³ Cf. Stauder, *Auf dem Weg*, 178.

³⁶⁴ Cf. Brinkhof, *Change*, 104.

³⁶⁵ Cf. Pakuscher, *Reform*, 374.

³⁶⁶ There is no clear definition of equivalence in the EPC. Jurisprudence therefore differs in Europe. The WIPO Draft Substantive Patent Law Treaty defines the term equivalence as follows (Art. 11(4)(b) SCP/10/2, September 30, 2003):

"For the purpose of determining the scope of protection conferred by the patent, due account shall be taken [, in accordance with the Regulations,] of elements which are equivalent to the elements expressed in the claims.

And the Draft Regulations under the Substantive Patent Law Treaty (R. 13(5) SCP/10/3, September 30, 2003): For the purposes of Article 11(4)(b), an element ("the equivalent element") shall generally be considered as being equivalent to an element as expressed in a claim ("the claimed element") if, at the time of an alleged infringement:

*(i) the difference between the claimed element and the equivalent element is not substantial and the equivalent element produces substantially the same result as the claimed element; and
(ii) a person skilled in the art had no reason to assume that the equivalent element had been excluded from the claimed invention".*

³⁶⁷ Cf. Sedemund-Treiber, *Strukturen*, 123; Vleck, 348.

³⁶⁸ Cf. already in the early days Pakuscher, *Nichtigkeit*, 313-316; but also cf. Fährdrich/Ibbeken, 623; Schäfers, *Anmerkungen*, 825; Sedemund-Treiber, *Strukturen*, 122-123; Schade, *Regelung*, 102, 108-110; Pagenberg, *First Instance*, 495; Dreiss/Keussen, 893-894; Stauder, *Verletzungsverfahren*, 145-149; Klink, 500; Rau Manfred in: *Grabrucker*, 891; Gesthuysen, 335; also cf. Willems, *Blueprint*, 11. For a different opinion, cf. Tilmann, *Patentschutzsystem*; Tilmann/v. Falck, 585; v. Falck Andreas in: *Grabrucker*, 891-892.

³⁶⁹ Cf. Schade, *Regelung*, 110.

implementation of the European Patent Litigation Agreement³⁷⁰, where infringement and revocation would be dealt with together before the European Patent Court.

Most European states have a system where the revocation and infringement of patents are dealt with before the same courts³⁷¹.

3. The call for a specialised German patent court with jurisdiction in infringement and revocation

Before the Second World War there had been intensive discussions in Germany concerning the creation of a special patent jurisdiction with jurisdiction in infringement and revocation actions³⁷². The discussions were resumed after the War. However, historical reasons, the establishment of the *Bundespategericht*, and the factual concentration of infringement litigation silenced the voices that requested a specialised patent jurisdiction in the discussions³⁷³.

It was argued that infringement cases were considered to be closely connected with general civil law. The creation of a special patent infringement jurisdiction was therefore seen as a potential risk in terms of the division of further areas of civil-law litigation by way of the creation of special courts³⁷⁴.

Additionally, it is commonly agreed that technical knowledge is necessary when deciding on the question of patentability, novelty and state of the art, so technically knowledgeable judges should sit on the panel³⁷⁵. It was suggested in the discussion that the presence of technical judges (as they act in the revocation court³⁷⁶) goes against the principle of

³⁷⁰ Cf. §7 The European Patent Court based on the proposal of the Working Party on Litigation of the European Patent Organisation.

³⁷¹ However, Austria and Portugal, for example, and some new EPC contracting states such as Bulgaria, the Czech Republic, Poland, Romania and Slovakia, also have a split of authority with regard to the infringement and revocation of patents.

³⁷² Cf. *Stauder, Rechtszug*, N 38 to N 58; *Sedemund-Treiber, Technischer Richter*, 1006; *Bossung, Grundfrage*, 61; *Schade, Regelung*, 110.

³⁷³ Cf. *Sedemund-Treiber, Technischer Richter*, 1006-1007.

³⁷⁴ Cf. *Bossung, Grundfrage*, 64.

³⁷⁵ Cf. *Ströbele*, 50-51; *Blakeney*, 98.

³⁷⁶ Cf. The senates sit with 5 judges, two with a legal background and three with a technical background (cf. *Wirtz/Liesegang*, 75).

professional judges, and consequently they should not be participating in infringement proceedings³⁷⁷. These arguments do not seem very convincing these days, however.

On the one hand, special courts already exist for different areas of law in several European countries³⁷⁸. On the other hand, there are also highly technical questions to be answered in infringement cases³⁷⁹. In addition, experts who are non-lawyers already sit in different commercial courts all over Europe³⁸⁰ - not least in Germany³⁸¹ - partly with jurisdiction in patent infringement cases³⁸², and the experience has been a positive one³⁸³.

Nevertheless, it should be noted that legal judges can also develop the necessary technical "feel" and reach conclusions that convince not only lawyers but also patent attorneys or other persons skilled in the technical field concerned³⁸⁴. The infringement courts of Germany, for example, and their success have made this a fact.

II. Courts of further instance

A decision rendered by a *Landgericht* in infringement proceedings may be appealed to the *Oberlandesgericht* (higher district court). This court has competence to review facts and law³⁸⁵. Since the revision of the German Civil Procedure Act which entered into force in 2002, the appellant must state in detail why the examination of the legal grounds or the establishment of facts by the court of first instance was not correct³⁸⁶. The *Oberlandesgericht* is therefore in general³⁸⁷ bound by the facts as established by the court of first instance³⁸⁸.

³⁷⁷ Cf. *Ströbele*, 43; *Bossung, Grundfrage*, 63.

³⁷⁸ Specialised courts exist mainly in commercial areas of law and in areas of law profoundly affected by social policy, such as labour law and laws governing tenancy.

³⁷⁹ Cf. *Brack*, 23; 27-28; *Pakuscher, Reform*, 374; *Bossung, Grundfrage*, 61.

³⁸⁰ Cf. *Sedemund-Treiber, Technischer Richter*, 1010; *Altherr*, 5-6.

³⁸¹ See § 105 (1) Court Constitution Law (*Gerichtsverfassungsgesetz*) which provides that two lay judges sit together with a member of the district court on the bench in a commercial chamber.

³⁸² E.g. in Switzerland.

³⁸³ Cf. *Brunner, Verwertung, Vogel; Nyffeler*, 112.

³⁸⁴ Cf. also *Stauder, Aspekte*, 623.

³⁸⁵ Cf. *Vossius/Hepworth*, N 5-07; *Loth*, 54-55; *v. Meibom/Kreye*, 39.

³⁸⁶ Cf. *Osterrieth*, 521-522.

³⁸⁷ Cf. *Osterrieth*, 524 with regard to the preconditions for evidence being taken by the court of second instance.

³⁸⁸ Cf. § 529(1) 1 German Civil Procedure Act; *Osterrieth*, 523-524.

If the value in dispute is lower than € 600, an appeal is only possible if it was accepted by the *Oberlandesgericht* and if the legal point is either of general interest, or if it helps in the development of the law, or if it safeguards common case law³⁸⁹. The appeal court therefore comes close to the position of a supreme court in such cases.

About one third of the decisions of the *Landgerichte* are appealed³⁹⁰.

The judgment of the *Oberlandesgericht*, like a decision of the *Bundespatentgericht*, may be appealed to the *Bundesgerichtshof* (Federal Supreme Court) in Karlsruhe³⁹¹. That is where the separated paths of infringement and revocation again merge. The leave required of the *Oberlandesgericht* in infringement cases may, however, lead to the situation where a stay of proceedings is refused and the *Bundesgerichtshof* later revokes the patent. In this case a revision of the infringement proceedings may be initiated³⁹².

The *Bundesgerichtshof* may basically only decide on legal questions³⁹³. However, with regard to decisions of the *Bundespatentgericht* the court may exceptionally also decide on facts³⁹⁴.

D. The Netherlands

I. Courts of first instance

Since the amendment to the Dutch Patent Act in 1987³⁹⁵ it is - the President of -³⁹⁶ The Hague *Arrondissementrechtbank* (district court) that has exclusive jurisdiction in infringement and revocation proceedings in respect of European patents in the Netherlands³⁹⁷. Before the revision it was all 19 district courts that had jurisdiction in

³⁸⁹ Cf. § 511(3) German Civil Procedure Act; *Osterrieth*, 521; *Wirtz/Liesegang*, 75.

³⁹⁰ Cf. *Schneider*, 143.

³⁹¹ Cf. *Loth*, 55.

³⁹² Cf. *Wirtz/Liesegang*, 75.

³⁹³ Cf. Rogge Rüdiger/Grabinski Klaus in: *Benkard, PatG*, vor § 100, N 1 to N 8; Keukenschrijver Alfred in: *Busse*, §100, N 3 to N 11; *Vossius/Hepworth*, N 5-09 to N 5-11; *Schneider*, 153.

³⁹⁴ Cf. Rogge Rüdiger in: *Benkard, PatG*, § 110; *Landfermann, Entwicklung*, 342; *Schneider*, 153.

³⁹⁵ Cf. *Brinkhof, Revocation*, 229; *v. Nispen*, N 7-12; *Brinkhof/Schutjens*, 8.

³⁹⁶ Cf. *Brinkhof, Kort Geding*, 500.

³⁹⁷ Cf. Sec. 54 Dutch Patent Act of 1910 and Sec. 80 Dutch Patent Act of 1995.

infringement proceedings and The Hague *Arrondissementrechtbank* which had exclusive jurisdiction in nullity cases³⁹⁸.

As with any concentration of jurisdiction, it was carried out, on the one hand, because it was expected that the results would be professionalised³⁹⁹. This aim was successfully reached: today, the patent chamber of The Hague *Arrondissementrechtbank* consists of specialised judges with considerable patent expertise⁴⁰⁰.

On the other hand, the view was taken that the law would be interpreted in a more uniform way. Additionally, as mentioned earlier, the CPC requested a limited number of "Community Patent Courts", which motivated the legislature to limit jurisdiction at a national level⁴⁰¹.

The *Arrondissementrechtbank* of The Hague became famous for its broad interpretation of the Brussels and Lugano Conventions⁴⁰². It basically exercised jurisdiction in regard to the infringement of a European patent granted not only for the Netherlands but also for other European and non-European countries, and issues injunctions - not least in the *kort geding* procedure, a kind of summary proceedings⁴⁰³ - with effect in other states⁴⁰⁴.

II. Courts of further instance

A decision of the District Court of The Hague may be appealed to the *Gerechtshof Den Haag* (Court of Appeals of The Hague)⁴⁰⁵. It has jurisdiction in regard to facts and law⁴⁰⁶.

The *Hoge Raad* (Dutch Supreme Court) acting as third instance ensures the unitary interpretation of law and therefore acts as a classic quash instance. Consequently, it does not review facts⁴⁰⁷. The Dutch Supreme Court is also located in The Hague.

³⁹⁸ Cf. *Brinkhof, Enforcement*, 171.

³⁹⁹ Cf. *Brinkhof, Enforcement*, 171.

⁴⁰⁰ Cf. *Oosting*, 45.

⁴⁰¹ Cf. *v. Nispen*, N 7-12.

⁴⁰² Cf. *Brinkhof, Measures*.

⁴⁰³ Cf. §3 B.V.1. The *kort geding* procedure.

⁴⁰⁴ Cf. §3 C.VI.1. Cross-border injunctions.

⁴⁰⁵ Cf. *Brinkhof, Revocation*, 229.

⁴⁰⁶ Cf. *v. Nispen*, N 7-14.

⁴⁰⁷ Cf. *Allen/Gielen*, 220.

E. Switzerland

I. Courts of first instance

1. Introduction

The Swiss Constitution grants the "cantons" authority over court organisation and proceedings⁴⁰⁸. The Swiss Patent Act obliges the cantons to designate one court to receive civil cases regarding patents. The duty of the cantons to designate one instance was already in the patent law of 1888. The purpose of this decision was to simplify the stages of appeal and - as, for example, in France or Germany - to direct the cases to a limited number of courts to let them gain the necessary expertise in patent litigation.

Four cantons established commercial courts⁴⁰⁹ which have *inter alia* the authority to handle cases dealing with industrial property rights⁴¹⁰. This is where most of the patent cases are dealt with⁴¹¹. All other cantons designated their higher cantonal courts to handle intellectual property cases on their territory⁴¹². The consequence of this is that in Switzerland no specialised patent court exists. Instead, there are 26 courts having jurisdiction in patent cases, all applying their own rules of procedure.

To remedy this state of affairs, the national government initiated a project to harmonize civil procedure by creating one national civil procedure act⁴¹³. This legislation, which will very probably not enter into force before 2010, would apply to all civil courts at the cantonal level.

The courts in first instance have - among other things - exclusive jurisdiction in infringement and revocation proceedings and jurisdiction for preliminary injunctions⁴¹⁴.

⁴⁰⁸ Cf. Art. 122(2) Swiss Constitution.

⁴⁰⁹ Aargau, Berne, St. Gallen and Zurich.

⁴¹⁰ Cf. von Büren Roland/Marbach Eugen, *Immaterialgüter- und Wettbewerbsrecht*, Bern 2002, N 821; Brunner Eugen, *Der Patentverletzungsprozess*, 1994 SMI, 101-129, 112; *Auf der Maur*, 48; *Monsch/Bolli*, N 10-09.

⁴¹¹ Cf. §2 E.I.1. The efforts to create a *Bundespatentgericht*.

⁴¹² Cf. *Troller, IGR II*, 1037.

⁴¹³ For an overview, cf. Sutter-Somm Thomas, *Der Vorentwurf zur Schweizerischen Zivilprozessordnung*, 2002 ZSR, vol. 121, 545-580.

⁴¹⁴ Cf. Art. 76(1) Swiss Patent Act in connection with Arts. 26, 72, 73, 77 Swiss Patent Act.

For the Principality of Liechtenstein it is the *Fürstliches Obergericht* (higher principality court) that has jurisdiction⁴¹⁵ in civil cases regarding patents. This is important to note, as Switzerland and Liechtenstein form a united patent territory⁴¹⁶: quite ironically a common territory that is established between two non-EU member states.

As in France, the strategy of gaining expertise through concentration has only been successful to a certain extent in Switzerland:

- First, there are simply too few patent cases in the country for 26 courts to get the experience needed in patent law and patent litigation⁴¹⁷. There are about 30 cases dealing with European patents heard in Swiss courts each year⁴¹⁸.

The fact that not all courts have sufficient experience in patent litigation even led to the reproach that Switzerland would breach the TRIPs Agreement duties concerning the enforcement of patent rights⁴¹⁹. The *Bundesgericht* (Federal Supreme Court), however, concluded that the obligations of the TRIPs Agreement are guaranteed in Switzerland although certain courts would have little experience in patent litigation⁴²⁰. It therefore left it up to the legislator to take any necessary steps possible.

- Second, provisional and protective measures are not included in the exclusive jurisdiction. Consequently, more than 100 courts have jurisdiction over those important aspects in almost every patent case⁴²¹. These courts also basically have to decide whether there are possible reasons for the main claim of the so-called *fumus boni iuris*⁴²² to exist⁴²³. The result is that, although requests for provisional and protective measures

⁴¹⁵ Cf. Art. 1(1) Act of Liechtenstein on the CH-LI Patent Protection Treaty.

⁴¹⁶ Cf. Art. 1 CH-LI Patent Protection Treaty. A national patent or a European patent can therefore only be granted, transferred or revoked for both states together (Art. 4 CH-LI Patent Protection Treaty).

⁴¹⁷ Cf. also *Stauder, Aspekte*, 623.

⁴¹⁸ Cf. WPL/SUB 4/03, 5. Even this small number was questioned, cf. *Brändle, Patentgericht*, 301.

⁴¹⁹ Cf. *Brändle, Patentgericht*, 303.

⁴²⁰ Cf. Decision of the Swiss Federal Supreme Court of October 4, 2004 (BGE 131 III 76), and 2005 sic!, 408-412.

⁴²¹ Cf. *David*, 15. For the Principality of Liechtenstein it is the *Fürstliches Landgericht* (principality court) which has jurisdiction for provisional and protective measures until the case is pending before the *Fürstliches Obergericht* (Art. 1(2) Act of Liechtenstein on the CH-LI Patent Protection Treaty).

⁴²² That is to say, the plaintiff only has to prove that he is entitled to enforce the right and that there are good reasons to believe that the right is indeed being infringed by the defendant.

⁴²³ Cf. *Vogel/Spühler*, §12, N 211.

are checked in a summary proceeding, the court still has to delve into the substance of the case and the meaning of the law - a very difficult task if one is not familiar with patent law.

That is why demands for a *Bundespatentgericht* (Federal Patent Court) have been in evidence for a long time.

2. The efforts to create a *Bundespatentgericht*

a) History

The corporate sector was already demanding a specialised patent court in the mid-1940s⁴²⁴ because it was felt that too many judges had difficulty understanding patent issues and consequently rendered many poor judgments. The cause of this situation was not only the Patent Act itself valid at that time - which only obliged the cantons to designate one court of jurisdiction - but also the fact that the cantons each interpreted the provision a little differently.

Some cantons interpreted it as meaning that they could designate whatever court they wished, including the first-instance courts. Others created special courts, only composed of non-professional lay judges, which unsurprisingly did not improve the results⁴²⁵. At the other end of the spectrum were the designated commercial courts which included real technicians in the judiciary. Thus, it was mostly in the cantons which established commercial courts that it became possible to create a specialised patent judiciary.

The consolidation of authority and the establishment of a certain specialisation were not achieved throughout the country⁴²⁶ and demands for a specialised court increased. A short time after the beginning of the discussion on the creation of a national patent court, it became clear that the constitutional authority of the cantons in civil proceedings was a major hurdle to creating such a court. It was clear for both experts and the government

⁴²⁴ Cf. *Brack*, 11-14; *Hasenböhler*, 81; *David*, 4. In fact, the creation of a specialised patent court was already discussed at the beginning of the last century, cf. *David*, 4, n. 6 with reference to Guyer/Weiss, 3/1906 SJZ, 33, 46, 58, 109 und 146.

⁴²⁵ Cf. *Brack*, 16.

⁴²⁶ Cf. Explanatory notes of the revision act of the Swiss Patent Act of April 25, 1950 (Botschaft des Bundesrats an die Bundesversammlung über die Revision des Bundesgesetzes betreffend Erfindungspatente vom 25. April 1950, Bundesblatt 1950 I 85).

that only a revision of the constitution would provide the state with the necessary authority in respect of infringement. However, the situation for revocations was heavily contested. It was argued that granting a patent was an act of state. Certain experts were of the opinion that, consequently, the state should also have jurisdiction to revoke a patent. Either a new federal patent revocation court or a separate chamber for patents in the *Bundesgericht* could therefore have been created without revising the constitution⁴²⁷.

The Department of Justice was, however, not convinced of any of those approaches. It basically argued that the revocation of a patent concerned proceedings relating to private rights, as do infringements of patents⁴²⁸. In the end, enthusiasm for a patent court was dampened not only by the Department of Justice but also by negative opinions from the private sector⁴²⁹.

In a side-step the major Swiss industry association nevertheless pleaded with the government, asking whether or not a special chamber of the *Bundesgericht* with technicians in the second instance could be created, and whether it should have jurisdiction over issues relating to law and facts⁴³⁰. The latter question was raised because the *Bundesgericht* had interpreted the relevant provision on its jurisdiction to deal with the various aspects of a case in a very limited way.

A group of experts designated by the government decided from the beginning to ignore proposals that could be construed as unconstitutional, such as technicians sitting on the panel⁴³¹. The final - rather poor - result was a revision of the statute of the *Bundesgericht*,

⁴²⁷ Cf. *Winter*, 217; *Kambli W.*, Die Verfassungsmässigkeit eines schweizerischen Patentnichtigkeitsgerichtes, 1945 Mitt. CH, 244, 251; *Giacometti Z.*, Die Verfassungsmässigkeit eines eidgenössischen Patentgerichtshofes, 1945 Mitt. CH, 256, 271 and Ergänzungsgutachten, 1947 Mitt. CH, 134.

⁴²⁸ Cf. Eidgenössischer Patentgerichtshof, Bemerkungen des Eidgenössischen Justiz- und Polizeidepartments zum Gutachten Prof. Dr. Z. Giacometti, 1947 Mitt. CH, 123, 133; Bemerkungen der Justizabteilung zum Ergänzungsgutachten Giacometti über die Schaffung eines Patentgerichtshofes, 1947 Mitt. CH, 169.

⁴²⁹ *Pointet*, 74.

⁴³⁰ Cf. Explanatory notes of the revision act of the Swiss Patent Act of April 25, 1950 (Botschaft des Bundesrats an die Bundesversammlung über die Revision des Bundesgesetzes betreffend Erfindungspatente vom 25. April 1950, Bundesblatt 1950 I 18).

⁴³¹ Cf. Complementary Explanatory notes of the revision act of the Swiss Patent Act of December 28, 1951 (Ergänzungsbotschaft des Bundesrats an die Bundesversammlung über die Revision des Bundesgesetzes betreffend Erfindungspatente vom 28. Dezember 1951, Bundesblatt 1952 I 20); also cf. *Stieger Werner*, Das schweizerische Patenterteilungsverfahren – Rückblick und Vorschau, Kernprobleme des Patentrechts, Festschrift zum einhundertjährigen Bestehen eines eidgenössischen Patentgesetzes, *Rehbinder Manfred/Larese Wolfgang*(eds.), Bern 1988, 91, 95.

making it possible for the court to check facts in appeal proceedings which were provided for in the first instance⁴³². It also became possible for the *Bundesgericht* to execute inspections and appoint experts⁴³³.

The Federal Supreme Court, however, stayed within the restrictive practice⁴³⁴ of a third instance. It argued that the new provision would only provide the authority to check a technical situation in a case where completion or correction of the proceedings of the court of first instance was necessary⁴³⁵.

The *Bundesgericht* therefore only checks facts necessary for a legal judgment when the findings of the court of first instance are in serious doubt⁴³⁶, such as when the fact-finding is unclear, incomplete, contradictory, or where there has been a legal misconception by the first instance (or the expert). Serious doubts could also arise when technical questions are not correctly addressed⁴³⁷.

The court based this restricted practice on the argument that, as highest court, its jurisdiction to deal with the aspects of a case is limited to federal law and its constitutional task of ensuring a uniform interpretation⁴³⁸.

This approach makes proceedings more efficient⁴³⁹, but it also leads to a situation where there is only one instance that extensively checks questions of fact and law. The practice of the Federal Supreme Court was criticized⁴⁴⁰, but remained unchanged. The provision is consequently proving to be a very limited substitute for a specialised court⁴⁴¹. It is therefore not a surprise that it was not transferred to the new Federal Supreme Court Act

⁴³² Cf. Art. 67 Statute of the Federal Supreme Court (Bundesgesetz über die Organisation der Bundesrechtspflege). On 1 January 2007 the statute of the court was replaced by the Federal Supreme Court Act (*Bundesgerichtsgesetz*).

⁴³³ Also cf. *Poudret*, 613-614; *Pointet*, 76-77.

⁴³⁴ Cf. *Zürcher*, N 19.85; *David*, 202; Münch Peter, *Prozessieren vor Bundesgericht*, Bertschinger Christoph/Münch Peter/Geiser Thomas (eds.), 2nd edition, Basel et al. 1998, N 4.69.

⁴³⁵ Cf. e.g. Decision of the Federal Supreme Court of May 11, 1994 (BGE 120 II 315).

⁴³⁶ Cf. e.g. Decision of the Federal Supreme Court of July 18, 1983, (BGE 109 II 174) and of November 24, 1959 (BGE 85 II 512; 514-515).

⁴³⁷ Cf. Decision of the Federal Supreme Court of January 29, 1963 (BGE 89 II 156; 163); also cf. Decision of the Federal Supreme Court of January 31, 2002 (4C.2319/2001), 2002 sic! 534 -536.

⁴³⁸ Cf. *Poudret*, 606-607; Walter Hans Peter, *Die Tatsachenüberprüfung durch das Bundesgericht im Patentprozess*, 1993 SMI, 9-26, 9, 20; *Vogel/Spühler*, §13, N 107.

⁴³⁹ Cf. *Monsch/Bolli*, N 10-12.

⁴⁴⁰ Cf. *Blum/Pedrazzini*, Art. 76, N 6; *Troller*, *IGR II*, 1048-1050; *Hasenböhler*, 87-91; *Brunner*, *Patentnichtigkeit*, 28; *Pedrazzini*, 169; *David*, 203.

⁴⁴¹ Cf. *Troller*, *IGR II*, 1048; *Pedrazzini*, 169.

which replaced the statute of the court on 1 January 2007.

The problems which have existed in Switzerland for more than 100 years in relation to patent litigation are still unresolved. As mentioned earlier, courts that do not deal with patent cases often have problems and the *Bundesgericht* was not prepared to become a full appeal instance.

b) State of affairs and the latest proposals

Today, the majority of the patent cases in Switzerland are dealt with before the four commercial courts⁴⁴² of Aarau, Berne, St. Gallen⁴⁴³ and Zurich⁴⁴⁴. The quality of their decisions has generally been acknowledged⁴⁴⁵. The problems therefore lie in the cantons that do not provide (or have not set up) commercial courts⁴⁴⁶.

About 40% of all patent cases and requests for preliminary injunctions are still handled by the highest cantonal courts⁴⁴⁷. These courts obviously have to rely, to a great extent, on expert opinions because of their lack of experience and patent law knowledge⁴⁴⁸.

Efforts to create a common European patent litigation system and the revision of the Swiss Constitution⁴⁴⁹ rekindled calls⁴⁵⁰ for a *Bundespatentgericht* - especially in the spring of 2002⁴⁵¹. Other alternatives which have been proposed in the discussions concerning a specialised patent court are:

- creating a national intellectual property court (for all IPRs),

⁴⁴² Cf. *Addor/Bühler/Girsberger/Luginbühl*, 292.

⁴⁴³ Cf. *Altherr*, with regard to the commercial court of St. Gallen in general.

⁴⁴⁴ Cf. *Brändle, Patentgericht*, 303.

⁴⁴⁵ Cf. Nyffeler Franz in: *Bircher/Thouvenin*, 651; *Monsch/Bolli*, N 10-10; *Stieger, Strategies*, 553.

⁴⁴⁶ Cf. *Addor*, 329.

⁴⁴⁷ Cf. Heinrich Peter in: *Hilti*, 288.

⁴⁴⁸ Cf. Lutz Martin in: *Bircher/Thouvenin*, 650.

⁴⁴⁹ Cf. Art. 122(2) Swiss Constitution after Judicial Reform (Bundesbeschluss über die Reform der Justiz vom 8. Oktober 1999) and in particular Art. 191a(3) Swiss Constitution after Judicial Reform (Bundesbeschluss über die Reform der Justiz vom 8. Oktober 1999); also cf. *Meier*, 313. Art. 191a Swiss Constitution entered into force on 1 April 2003 (cf. Bundesbeschluss über das teilweise Inkrafttreten der Justizreform vom 12. März 2000, vom 24. September 2002).

⁴⁵⁰ *Hilti, Blumer, Patentverletzung*, N 17.8; *Luginbuehl*, 267; Heinrich Peter, Kommentar zum Schweizerischen Patentgesetz und den entsprechenden Bestimmungen des Europäischen Patentübereinkommens, Zürich 1998, N 76.35.

⁴⁵¹ Cf. Fachtagung: Ein Eidgenössisches Patentgericht erster Instanz, Rüschlikon, 30 April 2002.

- establishing a Swiss commercial court with exclusive jurisdiction for all commercial litigation within the entire territory of Switzerland⁴⁵², or
- extending the territorial jurisdiction of the four existing commercial courts to all cantons⁴⁵³.

There are various arguments against all of these proposals:

- First, the creation of a national IP or commercial court, while interesting, is currently needed less than a civil court specialised in other areas such as family law. In addition, many of the courts dealing with IP cases have indicated that they do not have problems with intellectual property as such; rather, they are unwilling to give up jurisdiction in areas of IPRs beyond patent law - not least because IP has become an important issue in many courts. The cantons and government also fear that an IP court could be additionally empowered with jurisdiction in areas only related to IP law, such as company, competition or antitrust law.
- Second, providing the four commercial courts with "extraterritorial" capacities is difficult from a federalist point of view⁴⁵⁴: In Switzerland it is difficult enough for a canton to transfer authority to the state, but it seems even more difficult to transfer authority to or share it with another canton.

Preparatory discussions therefore focused on the creation of a *Bundespatentgericht*⁴⁵⁵.

At the end of 2007⁴⁵⁶, the Swiss government published a proposal for a Federal Patent Court Act⁴⁵⁷. The proposal includes the following cornerstones:

The *Bundespatentgericht* would be acting as first-instance court in patent issues. The

⁴⁵² Cf. Mathis Berger, Fachtagung: Ein Eidgenössisches Patentgericht erster Instanz, Rüschlikon, 30 April 2002.

⁴⁵³ Cf. Nyffeler, 112 and *id.* in: Bircher/Thouvenin, 651.

⁴⁵⁴ Cf. Addor, 329.

⁴⁵⁵ Cf. Addor/Bühler/Girsberger/Luginbühl, 291.

⁴⁵⁶ In 2004 there was, however, already discussion of just implementing a basic article regarding the creation of a Federal Patent Court into the revised Swiss Patent Act.

⁴⁵⁷ Proposal for a Federal Patent Court Act incl. explanatory notes of December 7, 2007 (Botschaft zum Patentgerichtsgesetz vom 7. Dezember 2007, available at <www.ige.ch/D/jurinfo/documents/j10062d.pdf>).

court would be located at the *Bundesverwaltungsgericht* (Federal Administrative Court), but hearings could also be held at other locations. The court would have exclusive jurisdiction for all actions related to patent litigation where Switzerland is the competent forum state. The future national civil procedure act would also be applicable before the patent court. The court would be composed of technically and legally qualified judges. They must have sufficient experience in patent law in order to be appointed.

It will be interesting to see how things develop and whether the time is now ripe for the creation of a specialised patent litigation court in Switzerland. The initial consultation process on the subject produced a positive result.

II. Courts of further instance

Since there is only one court with jurisdiction in patent cases at the cantonal level, judgments of the first-instance courts can only be appealed before the *Bundesgericht* in Lausanne regardless of the value in dispute⁴⁵⁸. The *Bundesgericht* also acts as appeal instance for decisions in patent cases rendered by the civil courts of the Principality of Liechtenstein⁴⁵⁹.

F. United Kingdom

In regard to patent litigation in the United Kingdom, most cases are adjudicated in England and Wales. The courts of Scotland, Northern Ireland and the Isle of Man hardly ever decide on patent cases⁴⁶⁰. The court system of England and Wales will therefore be the main focus.

⁴⁵⁸ Cf. Art. 76(2) Swiss Patent Act and Art. 74(2)(b) Federal Supreme Court Act (*Bundesgerichtsgesetz*). The reason for abolishing the requirement for a minimum value in dispute is the perceived special importance of maintaining unified judicial practice in an area of the law containing many inherent complexities (cf. *Monsch/Bolli*, N 10-11; *Blum/Pedrazzini*, Art. 76, N 5). An important aspect is also that there is only one instance available at the cantonal level. The limited jurisdiction of the highest national court to check facts established by the first instance still makes a full appeal impossible, however.

⁴⁵⁹ See Art. 11 CH-LI Patent Protection Treaty.

⁴⁶⁰ Cf. *Cornish/Llewelyn, Enforcement*, 88; *Campbell*, N 1-03; *Arnold, Courts*, 477; *Stauder, Significance*, 803.

I. Courts of first instance

The specialised "Patents Court" and the "Patents County Court", both located in London, act as courts of first instance for infringement and revocation actions.

Additionally, the UK Intellectual Property Office - in fact, the "Comptroller" - may act as an infringement and revocation instance by way of party prorogation⁴⁶¹. The Comptroller has a discretionary power to decline to deal with the reference to him if he thinks that the question referred to him would be more properly determined by the court⁴⁶².

It was, furthermore, decided to introduce a new regulation into the Patents Act 1977 by the Patents Act 2004⁴⁶³ which, since October 2005, makes it possible for anyone post-grant to ask the Comptroller to issue an opinion as to whether a particular act does or would infringe a patent, or whether a certain patent is valid, i.e. whether the invention in question is now patentable because it does not seem novel, or seems obvious in light of the prior art⁴⁶⁴. The opinions are, however, non-binding "for any purposes" but they could support the courts in finding the correct rulings⁴⁶⁵. First experiences show that the opinions are issued quickly⁴⁶⁶, and that they can indeed be useful⁴⁶⁷. However, some opinions obviously contained reservations and therefore provoked immediate criticism concerning their use as a foundation for negotiations or as assistance in Alternative Dispute Resolution (ADR)⁴⁶⁸.

The Patents Court, on the one hand, is part of the Chancery Division of the High Court⁴⁶⁹, which is the superior court of first instance⁴⁷⁰. Patent actions have been heard before the High Court since 1602⁴⁷¹ and before the Patents Court as its sub-division since 1950. A specialised authority in patent litigation has therefore been a reality for a long time in

⁴⁶¹ Cf. *Cornish/Llewelyn, IP*, N 6-23; *Lambert, After Woolf Revisited*, 406.

⁴⁶² Section 61(5) Patents Act 1977. Cf. also §3 C.III. *Forum non conveniens* and anti-suit injunctions.

⁴⁶³ Section 74A Patents Act 1977. The UK Patents Act 2004 was passed by the House of Lords on July 19, 2004 and received royal assent on July 22, 2004, cf. UK patent reform bill passed, News, 25 July 2004, <www.legalmediagroup.com>.

⁴⁶⁴ Cf. *Jones/Grabienski/Marriott/McCall*, 204.

⁴⁶⁵ Cf. *Phillips, Pouring*, 229; 230; *Poore*, 23-24.

⁴⁶⁶ Cf. *Roberts*, 526.

⁴⁶⁷ Cf. *Poore*, 29.

⁴⁶⁸ Cf. Linde Emilia, Non-Binding Opinions on Validity and Infringement, 03/06 WIPR, 32-33, 33.

⁴⁶⁹ Cf. *Harriss*, 3.

⁴⁷⁰ Cf. *Lambert, After Woolf*, 427.

⁴⁷¹ Cf. *Darcy v Allen*, 1 WPC, 1 (1602).

England and Wales⁴⁷². Most cases are heard by judges who have both a legal (even IP) and a scientific qualification⁴⁷³, which makes for a court whose judges have a wealth of knowledge in patent issues. The Patents Court has *inter alia* jurisdiction in infringement and validity issues relating to European and national patents, as well as in issues regarding breach of contract⁴⁷⁴.

The Patents County Court, on the other hand, is part of a network of regional courts. It was created in 1994 and replaced the Edmonton County Court, which was established in 1990⁴⁷⁵ by a designation to this effect by the Lord Chancellor⁴⁷⁶. In contrast to the other county courts, it has jurisdiction throughout England and Wales, as does the High Court⁴⁷⁷, and there is no financial limit on the claims on which it can decide⁴⁷⁸.

The Patents County Court was not established to complete the concentration process of the court organisation in England and Wales that was initiated a long time ago, as one might think. The court was mainly established to tackle the high litigation costs in the United Kingdom - attributed to the length of the trials and the use of teams of lawyers and patent attorneys on each side - and to provide small- and medium-sized enterprises with more favourable proceedings⁴⁷⁹. In short, a fairer⁴⁸⁰ and better access to justice should have been ensured⁴⁸¹.

It was the intention to reduce costs by creating less complicated proceedings that were less time-consuming⁴⁸². Different measures were taken, such as allowing registered patent attorneys to appear as representatives in the Patents County Court⁴⁸³, and designing its procedures to make them speedier and more informal⁴⁸⁴. Following the Woolf reforms to

⁴⁷² Cf. *Campbell*, N 1-09; *Cornish/Llewelyn, Enforcement*, 88; 89.

⁴⁷³ Cf. *Arnold, Courts*, 482.

⁴⁷⁴ Cf. *Campbell*, N 1-09.

⁴⁷⁵ Cf. *Lambert, After Woolf Revisited*, 408.

⁴⁷⁶ It was the Copyright, Patents and Designs Act 1988, Part VI, Secs. 287-292 which empowered the Lord Chancellor to designate one or more county courts as patents county courts.

⁴⁷⁷ Cf. *Hands*, 92.

⁴⁷⁸ Cf. *Nott*, 5; *Harriss*, 3.

⁴⁷⁹ Cf. *Ford*, 236; *Nott*, 4; *Campbell*, N 1-09; *Gowers Review*, N 6.29.

⁴⁸⁰ Cf. *Lyndon-Stanford, Patent Attorney*, 81.

⁴⁸¹ Cf. *Lubbock*, 389.

⁴⁸² Cf. *Nott*, 3; *Lubbock*, 389; *Hands*, 92.

⁴⁸³ Cf. *Blakeney*, 97; 100; *Lyndon-Stanford, English*, 236; *Harriss*, 7.

⁴⁸⁴ Cf. *Adams*, 499; *Ford*, 237-238.

the civil law system in 1999, all courts in England and Wales in the meantime work to the same rules of procedure.

Its goals were, to a great extent, not achieved⁴⁸⁵ although the Patents County Court was provided with basic concurrent jurisdiction over the Patents Court, making it sometimes difficult to choose the correct forum⁴⁸⁶.

Solicitors⁴⁸⁷ preferred to act in the High Court because it was the court to which they were accustomed⁴⁸⁸. In the end, most work remained in the High Court⁴⁸⁹.

Costs of patent litigation in the United Kingdom remained at a very high level⁴⁹⁰, if not the highest in Europe⁴⁹¹, and the Patents County Court did not render decisions faster than the Patents Court⁴⁹² - not least because the latter became more efficient as soon as it felt the competition from the county court⁴⁹³. The fact that the Patents County Court is as costly as the High Court seems mainly to be due to the fact that there is no limit on the damages that can be claimed. The cases are therefore mostly⁴⁹⁴ as substantive and complex as in the Patents Court. Consequently, parties spend as much on big litigation teams - including solicitors, barristers and patent attorneys⁴⁹⁵ - due to the common law based procedure⁴⁹⁶. These teams again use all possible practical steps, such as expensive discovery proceedings⁴⁹⁷ or time-consuming experts called by both parties⁴⁹⁸

⁴⁸⁵ Cf. *Lubbock*, 389.

⁴⁸⁶ Cf. Campbell Mark, UK Patent Litigation: High Court or County Court?, 06/04 WIPR, 12-13.

⁴⁸⁷ "Solicitors" are qualified lawyers and are responsible for the day-to-day conduct of a case, such as client and witness relations. By contrast, "barristers" are the specialists and concentrate on the presentation of the case to the court (cf. *Davis*, 79).

⁴⁸⁸ Cf. *Lyndon-Stanford, Patent Attorney*, 81.

⁴⁸⁹ The Patents County Court obviously deals with only about one-sixth of the patent actions filed (cf. overview in *Lyndon-Stanford, English*, 239)

⁴⁹⁰ Cf. *Lyndon-Stanford, English*, 239; *Laddie, de Ranitz*, 528.

⁴⁹¹ See Assessment of the impact of the European patent litigation agreement (EPLA) on litigation of European patents, EPO acting as secretariat of the Working Party on Litigation, February 2006, available at <www.epo.org/patents/law/legislative-initiatives/epla/assessment.html>. Also cf. *Lambert, After Woolf*, 427; *Lubbock*, 389.

⁴⁹² Cf. *Cornish/Llewelyn, Enforcement*, 89.

⁴⁹³ Cf. *Lyndon-Stanford, English*, 238.

⁴⁹⁴ Also cf. *Arnold, Courts*, 478.

⁴⁹⁵ It seems to be not unusual for 15 persons on one party's side to participate in a court procedure (cf. Moss Stephen, A law unto himself, 2005 CIPA Journal, 452).

⁴⁹⁶ Cf. *Cornish/Llewelyn, Enforcement*, 91; *Barron, Experience II*, 147; also cf. *Lambert, After Woolf Revisited*, 418.

⁴⁹⁷ Cf. *Nott*, 5; *Stauder, Verletzungsverfahren*, 81-82.

⁴⁹⁸ Cf. *Cooke*, 48.

and technical experiments⁴⁹⁹, to succeed. It was thus wondered whether the court should not be given the power to make directions regarding the number of professional representatives at trial for which a party could recover costs⁵⁰⁰. The high costs are such a problem that it was wondered whether the common law procedure was TRIPs Agreement compliant⁵⁰¹ and was recommended to promote compulsory arbitration⁵⁰².

Costs, speed, and legal certainty of patent litigation⁵⁰³, all points which are not regulated by the TRIPs Agreement⁵⁰⁴, consequently remained an issue in the United Kingdom.

It was therefore decided to reform the applicable rules of procedure for the High Court⁵⁰⁵ - the Civil Procedure Rules, the Practice Direction and the Patents Court Guide⁵⁰⁶ are all applicable for both the Patents County Courts and the Patents Court⁵⁰⁷. Parties are now encouraged to use ADR⁵⁰⁸, and judges are forced to a strict case management. In appropriate cases, the court will invite the parties to consider whether their dispute or particular issues in it could be resolved through ADR⁵⁰⁹. This can go as far as the court applying cost sanctions where a party refuses to consider a suggestion by the court to attempt mediation⁵¹⁰. This also motivated the UK Intellectual Property Office to launch mediation services⁵¹¹.

As an additional measure, the so-called "streamlining procedure", a simplified procedure

⁴⁹⁹ Cf. *Harms*, 490.

⁵⁰⁰ Cf. *Thornham*, 20.

⁵⁰¹ Cf. *Harms*, 489; *Cornish/Llewelyn, Enforcement*, 108.

⁵⁰² Cf. *Kingston; Nurton*.

⁵⁰³ Cf. *Lambert, After Woolf Revisited*, 413.

⁵⁰⁴ Cf. *Cottier/Tran*, 635.

⁵⁰⁵ Cf. Pumfrey Nicholas, *Royaume-Uni, Le contentieux de la propriété industrielle en Europe*, Colloque Cour d'appel de Paris, Paris, 29 janvier 1999, Paris 1999, 25; 27 – 30; *Lambert, After Woolf; Lubbock; Cook*, 306; *Leith, Revision*, 252; *Lyndon-Stanford, English*, 238 and especially Lord Woolf, *The Additional Responsibilities of the Judiciary in the New Millenium*, The Clifford Chance Millenium Lectures, The Coming Together of the Common Law and the Civil Law, Markesins Basil S. (ed.), Oxford et al. 2000, 133-151. For an overview also cf. Andrews Neil, *A New Civil Procedural Code for England: Party-Control "Going, Going, Going"*, 1999 ZZPInt, 3-25; Kofmel Ehrenzeller Sabine, *Grundlegende Reform des englischen Zivilprozessrechts: eine Übersicht über die Civil Procedure Rules 1998*, 1999 AJP, 1125-1130; Zuckerman Adrian A.S., *The Woolf Report on Access to Justice – An Overview*, 1997 ZZPInt, 31-42.

⁵⁰⁶ Available at <www.hmcourts-service.gov.uk/>.

⁵⁰⁷ Cf. For an overview, cf. *Lambert, After Woolf Revisited*, 413-418.

⁵⁰⁸ In this regard cf. also *Gowers Review*, Recommendation 43.

⁵⁰⁹ Cf. *Vitoria*, 399.

⁵¹⁰ Cf. *Vitoria*, 399.

⁵¹¹ See <www.ipo.gov.uk/patent/p-manage/p-useenforce/p-useenforce-dispute/p-useenforce-dispute-mediation/p-useenforce-dispute-mediation-ourmediation.htm>; cf. also §5 Arbitration, Mediation and other instruments of Alternative Dispute Resolution.

which basically limits the total duration of the trial, was introduced in 2003. The procedure is geared towards a one-day trial with generally no disclosure, no presentation of experiments and a limited cross-examination, as well as a limited exchange of documents⁵¹². The court will order a streamlined procedure by agreement or, in the absence of agreement, where the application of the overriding objective makes such a procedure appropriate. Of particular importance in that regard are proportionality, the financial position of the parties, the degree of complexity, and the importance of the case⁵¹³.

It was estimated that the "streamlining procedure" could shorten the average patent case by three to six months and save perhaps around 20-40% of the costs⁵¹⁴.

It seems that only a few parties have chosen a streamlined procedure in the first years of its introduction⁵¹⁵. It is therefore no surprise that judges have increased the pressure to make use of this procedure, not least as they meanwhile tend to agree on requests to "streamline" cases despite strong objections from the other party⁵¹⁶.

There are, however, voices that cry that too liberal an application of this kind of procedure would bring to an end the more evidence-related aspects of the United Kingdom's patent procedure which set it apart from the rest of Europe. It is therefore also argued that the "streamlining procedure" is inappropriate for actions concerning a technically difficult field, for example requiring experimental evidence and/or a large number of findings of fact for their determination⁵¹⁷.

The latest measure which was introduced to increase the pressure on the litigators and to provide smaller companies with a tool to raise their chances for a friendly settlement without litigation⁵¹⁸ was - as mentioned earlier - to enable the UK Intellectual Property

⁵¹² Cf. *Moore*, 114-115; *Laddie, de Ranitz*, 529; Laddie Hugh in: *Dagg/Brook*, 705; *Klink*, 504; *Thornham*, 19.

⁵¹³ Cf. *Moore*, 116; cf. also decision of the Court of Appeal, 2007 EWCA Civ 51, and Whitehead Brian/Jackson Stuart/Kempner Richard, How to save money in English litigation, <www.managingip.com>, May 2007, 43-46, 45.

⁵¹⁴ Cf. Objections overruled, September 2005 Patent World, 6.

⁵¹⁵ Cf. *Moore*, 117.

⁵¹⁶ Cf. Objections overruled, September 2005 Patent World, 6; Ball Jonathan, Green light, October 2005 Patent World, 11; *Thornham*, 19-20.

⁵¹⁷ Cf. *Moore*, 115.

⁵¹⁸ Cf. UK pushes ahead with patent opinions, *Managing Intellectual Property News*, 4 July 2005, <www.managingip.com>.

Office to provide an independent non-binding opinion on patent validity or infringement to settle disputes over patent rights⁵¹⁹.

The test of whether costs could be lowered and trials speeded up, and consequently whether the access of smaller businesses to justice has improved, is still being closely monitored⁵²⁰.

Although it is expensive to litigate in England and Wales, the high quality of the decisions and the thoroughness of its courts are widely acknowledged⁵²¹. The British litigation system is thus often described as being a "Rolls Royce" system: thorough procedures and high-quality judges and advisers, but high costs⁵²².

II. Courts of further instance

Appeals on decisions rendered by either the Patents Court or the Patents County Court are restricted, since leave is required. If leave is refused, a petition can be presented to the Court of Appeal, where a single Lord Justice will decide whether the permission to appeal is granted⁵²³.

If an important question of the law must be addressed, the House of Lords in its judicial capacity⁵²⁴ can be contacted by way of a further appeal. This appeal again requires leave from either the Court of Appeal, or more commonly the House of Lords itself.

G. Reasons for success of the German patent litigation system

It is no secret that most companies would first pick Germany as the best jurisdiction for patent litigation⁵²⁵. As mentioned above, more than half of all patent disputes in Europe

⁵¹⁹ Cf. the critical words on the opinion procedure by *Jones/Grabienski/Marriott/McCall*, 204; *Phillips, Pouring*, 229-230; *Jacob, Creating*, 82; Barker David, *Tilting the playing field*, September 2004 Patent World, 22; Mitchell, *Golden opportunity...missed?* September 2004 Patent World, 23-25, 24-25. However, there are also positive voices, cf. *Roberts; Poore*.

⁵²⁰ Cf. *Gowers Review*, Recommendation 54; also cf. *Merck & Co Inc. v Generics (UK) Ltd*, 2003 EWHC 2842 (Pat) of November, 27, 2003, N 82 to N 93; *Thornham*, 18-19.

⁵²¹ Cf. *Kempner*, 50; *Davis*, 79; 80; *Stauder/Llewelyn*, 55.

⁵²² Cf. *Jones/Grabienski/Marriott/McCall*, 205.

⁵²³ Cf. *Cornish/Llewelyn, Enforcement*, 107.

⁵²⁴ Cf. *Jacob, Decisions*, 13.

are dealt with before German courts, and this tendency is increasing. The reason for this phenomenon is commonly explained as a combination of efficiency⁵²⁶, relatively low costs,⁵²⁷ and quality of decisions⁵²⁸. However, German courts are also chosen because they seem to "take a commercially realistic approach to patents"⁵²⁹.

What is a surprise at first glance is that these courts can work at this level of efficiency and consequently at such low costs, although split proceedings seem to complicate things⁵³⁰ and slow down proceedings⁵³¹. A closer look at the system offers an explanation:

- First, the work executed by the *Bundespatentgericht* (Federal Patent Court) as revocation instance also has to be done in courts that have a unified system. The procedure can consequently also slow down in a unified system if questions of nullity are raised⁵³².
- Second, court experts are appointed through a very tedious and selective system⁵³³.
- Third, a stay of infringement proceedings due to an ongoing revocation procedure or opposition procedure is handled very reluctantly⁵³⁴. This again leads to the conclusion that a high-level decision may be rendered despite the judge's possibly limited technical knowledge.

⁵²⁵ Cf. *Bodoni*, 31.

⁵²⁶ Cf. *Stauder, Verletzungsverfahren*, 52-53; *Pagenberg, First Instance*, 497; Bühling Jochen in: *Dagg/Brook*, 704.

⁵²⁷ Cf. *Lyndon-Stanford, English*, 239; v. *Raden*, 435.

⁵²⁸ Cf. *Brinkhof, Schlichtung*, 602; *Wirtz/Liesegang*, 75; *Meier-Beck, Damages*, 113.

⁵²⁹ Cf. Harris Gordon D., Patent litigation - a costly business?, *CIPA Journal*, January 2004, 12-14, at 14. It is argued that the many different ways of securing facts and of exploring them with the court, in conjunction with specialist judges who are not greatly influenced by the reasoning of the granting authority, leads to more patent revocations in the UK (cf. *Thornham*, 18).

⁵³⁰ Cf. Yorke in: *Bodoni*, 32.

⁵³¹ Cf. *Stauder, Verletzungsverfahren*, 53; *Kroher*, 236.

⁵³² Cf. *Stauder, Verletzungsverfahren*, 145.

⁵³³ Cf. Neuhaus Winfried, *Der Sachverständige im deutschen Patentverletzungsprozess*, 1987 GRUR INT., 483-486, 483 and 486; in the UK court experts are used more actively. As regard the appointment of experts before the *Bundesgerichtshof* cf. *Wirtz/Liesegang*, 75.

⁵³⁴ The court will only stay the proceedings if there is an overwhelming probability that the patent will be declared invalid (cf. Decision of the *Bundesgerichtshof*, November 11, 1986 (X ZR 56/85 (BPatG)), "Transportfahrzeug", 1987 GRUR, 284-285; also cf. Decision of the *Bundesgerichtshof*, October 8, 1957 (I ZR 164/56 (OLG Hamburg)), "Tonfilmwand", 1958 GRUR, 75-77); *Brinkhof/Schutjens*, 11; *Marshall*, 132; *Stauder, Verletzungsverfahren*, 146; *Tilmann, Patentschutzsystem*, 328; *Treichel*, 108; *Meier-Beck, Damages*, 114; the court is unlikely to stay proceedings where no new prior art is presented by the defendant, cf. Bühling Jochen in: *Dagg/Brook*, 703; cf. however also *Pagenberg, First instance*, 495.

However, the general high quality of European and German patents also supports this phenomenon. This conclusion can be drawn from the typically limited number of revocation proceedings in Europe, and an even fewer number of revocation decisions in relation to the number of patents granted⁵³⁵. On the other hand, quite a few patents are already declared invalid in the opposition and appeal procedures before the EPO. The risk of a revocation decision after the infringement court has already rendered its decision is consequently reduced, as the revocation judge basically tends to follow the EPO's decision if an EPO Opposition Division or an EPO Board of Appeal decided that an invention met the requirements of patentability⁵³⁶. However, the *Bundespatentgericht* has made it clear that it may also decide differently⁵³⁷. The risk⁵³⁸ that patents could be revoked after the infringement decision is rendered is therefore still quite high in Germany⁵³⁹. This again leads to legal uncertainty.

H. Conclusion

This overview clearly shows that a certain concentration of jurisdiction had been already occurring within many important European patent litigation states even before the recommendation of the Intergovernmental Conference of 1999 to restrict the number of courts having jurisdiction with regard to patent disputes⁵⁴⁰. It is therefore not really a surprise that the recommendation was not repeated at the subsequent Intergovernmental Conference of London on 16 and 17 October 2000⁵⁴¹.

The Netherlands and the United Kingdom decided to create specialised patent courts with exclusive jurisdiction.

⁵³⁵ Cf. *Brinkhof, Revocation*, 233; also cf. *Price/Thornham*, 21.

⁵³⁶ Cf. *Brinkhof/Schutjens*, 24-25; *Rogge, Revocation*, 223; *Jacob, Decisions*, 15-16; *Karet, UK and EPO*; cf. however, *Laddie, de Ranitz*, 531 where it is made clear that close to 60% of the (pharmaceutical) patents in suit before UK courts are revoked.

⁵³⁷ Cf. Decision of the *Bundesgerichtshof*, October, 8, 1992 (3 Ni 50/91); November, 24, 1993 (3 Ni 41/92) both reported by *Rogge, Revocation*, 222.

⁵³⁸ Cf. *Stauder, Verletzungsverfahren*, 146.

⁵³⁹ About 30% of the European patents valid in Germany are at least partly revoked (Cf. *Rogge, Revocation*, 219).

⁵⁴⁰ Cf. also *Boval, Remarques*.

⁵⁴¹ Cf. Provisional mandate and conclusions of the second Intergovernmental Conference on reform of the EPO, London, 16-17 October 2000. The mandate was never published.

In France, Germany and Switzerland a certain specialisation was able to be reached by the plaintiff taking full advantage of the provisions regulating territorial jurisdiction. In these states there is a large concentration of cases by way of *forum shopping*. Consequently, the question as to whether an extensive admission of *forum shopping* could be the solution to the current problems of diverging patent jurisprudence and of undesirable multiple patent litigation should be explored.

§3 FORUM SHOPPING RELATED TO PATENT LITIGATION IN EUROPE

A. Introduction

Forum shopping may generally be defined as legitimately choosing a jurisdiction from amongst available legal systems⁵⁴². The author does not share the view of some parts of the doctrine⁵⁴³ that choosing a court from a clearly unavailable jurisdiction is also part of *forum shopping*⁵⁴⁴. One may only shop for what is available for sale.

Forum shopping at the international level presupposes that, based on international or national law, at least two states, or two courts located in different states, have international or territorial jurisdiction. It is practised very extensively in a more essentially global business world with cross-border cases. The actual circumstances for *forum shopping* lie in the lack of uniformity throughout the legal systems⁵⁴⁵.

In Europe - and in contrast to the US⁵⁴⁶ - *forum shopping* is typically practised at the international level on the basis of the existing jurisdiction agreements. However, as mentioned above⁵⁴⁷, in patent litigation *forum shopping* is also practised in many states at the national level alone. The reason for this lies in the fact that, unlike in other fields of law, patent cases are rare and quality, along with the experience of the courts, varies greatly.

In many European states *forum shopping* is in fact encouraged by liberal jurisdictional regulations⁵⁴⁸. Switzerland, for example, just revised Article 109 of its international private law act⁵⁴⁹, which will make it possible from 1 July 2008 for the plaintiff in an international dispute to choose from no fewer than four jurisdictions in the case of a patent infringement:

- the domicile of the defendant,
- the place where the act that caused injury occurred (*forum delicti commissi*),
- the place where the injury arose (*forum delicti*), or,

in the case of a dispute arising out of the operations of a branch in Switzerland,

⁵⁴² Cf. *ILA, Leuven/London principles*, N 1; *Kropholler, FS*, 165.

⁵⁴³ Cf. *Dasser*, 263; *Wadlow*, N 5-158.

⁵⁴⁴ Cf. also *Schack*, N 221.

⁵⁴⁵ Cf. *Bell, Forum Shopping*, N 2.07.

⁵⁴⁶ Cf. Markey Howard T. in: *Kolle/Stauder*, 3. *Symposium*, 513.

⁵⁴⁷ Cf. §2 Specialised national patent courts.

⁵⁴⁸ Cf. *Ferrari*, 354.

⁵⁴⁹ Cf. in this regard also *Stieger, Unklares*, 75-76.

- the court at the seat of the branch.

Such a broad choice of different jurisdictions has already been available with regard to national disputes⁵⁵⁰ since 1 January 2001.

I. Relevant provisions in regard to cross-border *forum shopping*

Article 64(3) EPC provides that any infringement of a European patent shall be dealt with by national law. In Europe, jurisdiction among the different states and courts is regulated by Regulation 44/2001 and by the Lugano Convention (Reg 44/LC). The earlier Brussels Convention was in fact transferred to Regulation 44/2001 and was also in the meantime replaced by a special agreement as regards Denmark⁵⁵¹, which entered into force on 1 July 2007⁵⁵².

The most important provisions in Regulation 44/2001 and the Lugano Convention concerning *forum shopping* in European patent litigation are the general rules of Article 2 (domicile of the defendant) and the special jurisdiction of Article 5(3) (place where the harmful event occurred, place of tort).

In practice, the freedom to choose the court is usually the choice between various jurisdictions for matters relating to tort because of the different places of patent infringements. The ECJ made clear in *Handelskwekerij G.J. Bier v Mines de Potasse d'Alsace*⁵⁵³ that the terminology in Article 5(3) "place where the harmful event occurred" includes the place where the damage took place (*forum delicti*), as well as the place of the damage-causing effect (*forum delicti commissi*).

In contrast to the provision of Article 5 Reg 44/LC, which determines the international and territorial jurisdiction, Article 2 only regulates the international jurisdiction⁵⁵⁴. That is to say,

⁵⁵⁰ Cf. Article 25 Swiss Jurisdiction Act in Civil Matters (*Gerichtsstandsgesetz*).

⁵⁵¹ Council decision on the signing, on behalf of the Community, of the Agreement between the European Community and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters of 20.9.2005 and the agreement referred to (2005 O.J. EU, L 299, 61).

⁵⁵² See 2007 O.J. EU, L 94, 70.

⁵⁵³ *Handelskwekerij G.J. Bier v Mines de Potasse d'Alsace*, ECJ November 30, 1976 (case 21/76); also cf. *Shevill and others v Presse Alliance*, ECJ March 7, 1995 (Rec. 1995, PI-415; case C-68/93) and *Marinari v Lloyds Bank*, ECJ September 19, 1995 (case C-364/93).

⁵⁵⁴ Cf. *Kropholler, Europäisches Zivilprozessrecht*, vor Art. 2, N 3; *Walter G., Zivilprozessrecht*, 181; *Mäder*, 112.

it simply regulates which state has jurisdiction but not which court in that state from a territorial point of view. It is therefore up to the national law of each state to determine not only the substantial but also the territorial jurisdiction of its courts if reference is made to the domicile of the defendant.

Of further importance in regard to European patent litigation and *forum shopping* are Articles 27 and 30 Regulation 44/2001, i.e. Article 21 Lugano Convention concerning *lis pendens*, as well as Article 31 Regulation 44/2001 and Article 24 Lugano Convention concerning provisional and protective measures.

Also to be mentioned is Article 6(1) (joinder of multiple defendants) Reg 44/LC, which gained some fame with the so-called "spider in the web" doctrine, as will be shown below. This provision allows that a person domiciled in a state - in which Regulation 44/2001 or the Lugano Convention is applicable - may also be sued - where said person is one of a number of defendants - in the courts wherein any of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgments resulting from separate proceedings.

That is to say, at least one of the defendants must be domiciled in a state to which the jurisdiction provision of Article 6 Reg 44/LC is applicable⁵⁵⁵. It is therefore not applicable if jurisdiction over the other defendants may only be based on one of the other provisions of Reg 44/LC, such as Article 5(3)⁵⁵⁶. Furthermore, there must be a qualified connection between the various actions of the same plaintiff against the different defendants⁵⁵⁷.

Like Article 5(3) Reg 44/LC, Article 6 also determines the territorial and not only the international jurisdiction⁵⁵⁸.

This overview makes it clear that, depending on the circumstances of the case, it is possible to choose from amongst a great variety of available *fora*. *Forum shopping* is a

⁵⁵⁵ Cf. *Meier-Beck, Issues*, 507.

⁵⁵⁶ Cf. *Wadlow*, N 2-61.

⁵⁵⁷ Cf. Art. 6(1) Regulation 44/2001 which codified the common view and ECJ jurisprudence of *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst & Co.*, ECJ September 29, 1988 (case 189/87) in regard to Art. 6(1) Brussels and Lugano Convention, cf. *Stauder, Anwendung*, 476; *Kropholler, Europäisches Zivilprozessrecht*, Art. 6, N 8 to N 11; *Neuhaus*, 265; *Jandoli*, 785; *Hölder, Grenzüberschreitende*, 53-54.

⁵⁵⁸ Cf. *Schlosser, EU-Zivilprozessrecht*, Art. 2 EuGVVO, N 2; *Kropholler, Europäisches Zivilprozessrecht*, Art. 6, N 5; *Loth*, 53.

reality in Europe, and there are also many voices which support the broadest possible choice of jurisdictions.

Lawyers and judges, for example, repeatedly state that it is in the legitimate interest of a party to choose a court that is fast, cheap and competent⁵⁵⁹. Consequently, *forum shopping* is nothing evil, but rather a "masterpiece of European civil procedure"⁵⁶⁰, and actually something good⁵⁶¹.

However, there are also critics. In Switzerland for example, where, as mentioned earlier, the *forum shopping* possibilities with regard to national cases were expanded not so long ago, the jurisdiction of the court at the domicile of the plaintiff was very heavily blamed for being too extensive⁵⁶². It was argued that the plaintiff is given too much priority over the defendant, which is unjustifiable, not least since the revised Swiss Constitution⁵⁶³ classes the right of the defendant to be judged at his domicile as a fundamental right⁵⁶⁴.

Already these critics make it clear that *forum shopping* may also have an undesired effect, as it puts one party over the other. *Forum shopping* can consequently also jeopardise the balance between the interests of the parties. Not least the CPC therefore aimed to avoid *forum shopping*⁵⁶⁵.

What is behind these fundamentally diverging views?

B. Reasons for *forum shopping*

It is a common view that the result of a case may depend to a great extent on the court rendering the judgment⁵⁶⁶.

⁵⁵⁹ Cf. Schade, *Streitregelungssystem*, 837; Tilmann, *Gemeinschaftspatent*, 385.

⁵⁶⁰ See Vivant, 26.

⁵⁶¹ Cf. Notes, 1682-1683; Schade, *Streitregelungssystem*, 837.

⁵⁶² Cf. Kurth Christoph/Bernet Martin in: *Gerichtsstandsgesetz*, Kellerhals Franz/von Werdt Nicolas/Güngerich Andreas (eds.), Bern 2001, Art. 25, N 5.

⁵⁶³ Cf. Art. 30(2) Swiss Constitution.

⁵⁶⁴ Cf. Frank Richard, *Das Gerichtsstandsgesetz – ein Schritt vorwärts*, 2001 SJZ, 4.

⁵⁶⁵ Cf. Krieger, *Luxemburger Vertragswerk*, 108; Singer, *Patentsystem*, 148.

⁵⁶⁶ Cf. Siehr, *Forum Shopping*, 126-130; Dasser, 256.

Some of the reasons for *forum shopping* are based on general grounds and some on grounds specific to patent litigation. However, they all aim to best suit the commercial objectives and interests⁵⁶⁷ of the party choosing the court, sometimes leaving aside fairness⁵⁶⁸. Some lawyers, for example, wonder where one will be able to inflict the maximum economic damage on the infringer⁵⁶⁹.

It is part of the civil procedural system that the forum is chosen by the plaintiff if it has not been chosen by party agreement. At the same time, the principle of equal footing demands that both (possible) parties are treated alike⁵⁷⁰. *Forum shopping* should consequently not only be a matter for the potential plaintiff⁵⁷¹.

In fact, it is also a matter for the likely defendants, since they quite often sue in a forum otherwise available to the plaintiff, particularly for declaratory or similar relief⁵⁷². However, the nationally regulated preconditions for such relief are narrower in many states.

Therefore, the different interests involved have to be analysed quickly by both potential parties in order to avoid a possibly "better" forum being lost to the opponent. In the end, it may result in a situation also described as *forum running*, "race to the court house", *forum grabbing*, or "race of jurisdiction"⁵⁷³.

The patent business has developed into a multibillion-Euro business with high damages in dispute. It is consequently not a surprise that patent litigation has for the past 25 years become faster, more complicated and more expensive and involves a greater risk⁵⁷⁴.

Forum shopping related to patent litigation therefore became an important strategic element and tool⁵⁷⁵ and evolved from the "favourite indoor sport of international lawyers"⁵⁷⁶

⁵⁶⁷ Cf. Jegher, 33; Laddie, *I.P. Rights*, 406; v. Meibom/Pitz, *Cross-Border Injunctions*, 477; Peberdy, 23; Siehr, *Forum Shopping*, 141; Ferrari, 353; Vleck, 332; Jenkins, 28.

⁵⁶⁸ Cf. Bell, *Forum Shopping*, N, 2.03.

⁵⁶⁹ Cf. Barlow Mike in: Dagg/Brook, 703.

⁵⁷⁰ Also cf. Proposal for a Council Regulation of 14.7.1999 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, COM(1999) 348 final; 1.

⁵⁷¹ Cf. Bell, *Negative*, 674.

⁵⁷² Cf. ILA, *Leuven/London principles*, N 7; Jacob, *Harmonisation*, 148; Bell, *Negative*, 686; Notes, 1680; Kur, *Hague*, 179.

⁵⁷³ Cf. Jegher, 34; Dasser, 255; Kur, *Sackgasse*, 911; v.Meibom/Pitz, *Cross-Border*, 31; Herzog, 381.

⁵⁷⁴ Cf. Barron, *Experience I*, 79.

⁵⁷⁵ Cf. Bell, *Negative*, 675; Stieger, *Strategies*, 552-555; Peberdy, 22; Young/Birss, 364; Lupoi, 149; Hendrick/van Woortman/Flynn, 17.

⁵⁷⁶ Cf. Lowenfeld, 314.

to be part of a lawyer's duty⁵⁷⁷. This is particularly the case with regard to disputes relating to European patents, which are usually obtained for a number of states⁵⁷⁸ and which are regularly also infringed in several states at once⁵⁷⁹.

"Where is one most likely to win?"⁵⁸⁰ is one of the most fundamental questions the plaintiff or representative has to ask before he files the action. However, depending on the economic objectives to be attained by the party, considerations concerning the choice of court become much broader and more complicated. Every single step is often reflected upon from a multi-jurisdictional angle⁵⁸¹.

In regard to patent litigation there are a number of reasons which often have an impact on the choice of forum.

I. Familiarity with the legal system

In many cases the plaintiffs will try to choose the court where they have their seat or where they are domiciled, simply because they are familiar with the legal culture and the legal system⁵⁸². Language, venue but also the culture in general often have a greater influence on a party's choice than possibly expected.

II. Speed of the courts and quality of judgments

The speed of the court not only varies from state to state but also among the courts in the same state. Important factors concerning speed are the form of the proceedings, the court's experience in patent litigation⁵⁸³ and its case management.

The more familiar a court is with patent litigation, the more efficiently it renders decisions. Inexperienced courts often have to delegate their actual task to technical experts, and

⁵⁷⁷ Cf. *Siehr, Forum Shopping*, 141; *Schack*, N 223; *Notes*, 1690; *Neuhaus*, 269; *Halberstam*, 243; *Pitz, Aspects*, 22; *Geimer*, N 1096; *Ferrari*, 374-375; *Bell, Forum Shopping*, N 2.05; *Ebbink, Fire-Side*, 257.

⁵⁷⁸ Cf. *Hendrick/van Woortman/Flynn*, 17.

⁵⁷⁹ Cf. *Ebbink, Fire-Side*, 255.

⁵⁸⁰ Cf. *Adams*, 499; *Jacob, Harmonisation*, 147; *Ebbink, Pan-European*, 27; *Stieger, Strategies*; 552; *Geimer*, N 1096 to N 1097; *Barron, Experience I*, 80.

⁵⁸¹ Cf. *Barron, Experience II*, 146.

⁵⁸² Cf. also *Fawcett/Torremans*, 198; *Bell, Forum Shopping*, N 2.03; *Ebbink, Fire-Side*, 257.

⁵⁸³ Cf. *Peberdy*, 24.

even the designation of these experts often seems very difficult for inexperienced judges. There is consequently great potential for the defendant or alleged infringer to delay the case, quite often with the support of a court that is not very motivated to decide the case. There are cases known where patent holders could not exploit the market on their own because of an entire decade of litigation⁵⁸⁴. The speed of the judgment-making process consequently often has an impact on the quality of the decision.

Depending on the strength of the case and the patent in dispute, one would therefore want to choose a court which does not have a great knowledge of patent law and patent litigation⁵⁸⁵, which renders judgments less quickly⁵⁸⁶, or *vice versa*. The principle that "speed is of paramount importance in patent litigation"⁵⁸⁷ is consequently only sound, if the plaintiff is in a strong position on the merits (if the principle is not limited to the choice of a certain court). All patent litigators must therefore clearly analyse what the value of the patent is⁵⁸⁸ before they choose the court.

III. *Lis pendens* rules

Courts are also chosen because of the different existing rules defining *lis pendens*, i.e. the point of time when a court is seised. *Lis pendens* rules have *inter alia* the aim of avoiding a situation where two or more courts deal with an action relating to the same dispute between the same parties. The following overview and analysis will make it clear that the problems related to the existing *lis pendens* rules are in fact identified, that solutions are on the table, and that there are clear intentions to solve these ongoing issues.

1. The European rules

Under Article 27 Regulation 44/2001, i.e. Article 21 Lugano Convention, the court second seised has of its own motion to stay its proceedings until such time as the jurisdiction of the court first seised is established.

⁵⁸⁴ Cf. *Kingston*, 155.

⁵⁸⁵ Cf. *Willems, First instance*, 396; *Laddie, de Ranitz*, 531.

⁵⁸⁶ Cf. *Willems, First instance*, 398; §3 B.III.3. The problem of "torpedoes".

⁵⁸⁷ Cf. Paulissen in: *Bodoni*, 31.

⁵⁸⁸ Cf. *Peberdy*, 22; *Kropholler, FS*, 165; *Nott*, 5; *Musmann/v.d.Osten*, 99; *Tilmann/v. Falck*, 584, 585.

This rule basically ensures that the jurisdiction of the court first seised is not ignored. It consequently avoids parallel litigation and the possibility of inconsistent judgments within the territory where Regulation 44/2001 or the Lugano Convention applies⁵⁸⁹. However, costs can also be saved as only one court deals with the matter. Furthermore, it is guaranteed that a court deals with the matter and therefore dodges so-called "negative competence conflicts"⁵⁹⁰.

The court second seised has, however, only the duty to stay its proceedings where the different proceedings involve the same cause of action⁵⁹¹ between the same parties and if they are brought in courts of different states in which Regulation 44/2001 or the Lugano Convention is applicable⁵⁹².

For a long time it was unclear whether actions on the merits concerning *different* parts of a European patent fall within the definition of the "same cause of action" or whether the actions had to refer to the *same* parts. The ECJ has meanwhile provided the answer to that question.

In *Roche Nederland BV v Primus*⁵⁹³ it held that there can be no divergences between the decisions given by courts in respect of an infringement of a European patent with regard to the part taking effect on their territory. The infringement of the different parts of a European patent has to be examined in the light of the relevant national law in force in each of the states for which it has been granted. Therefore, different legal situations are at stake. A court would consequently only have to stay proceedings on the basis of Article 27 Regulation 44/2001 if, for example, an action on the merits and an action for a declaration of non-infringement with regard to the same part of a European patent is due before another court located in a state in which Regulation 44/2001 is applicable. This point is of special interest with regard to the so-called "torpedo actions"⁵⁹⁴.

Another open question was whether a stay of proceedings should be decided

⁵⁸⁹ Cf. for example *Dumez France v Hessische Landesbank*, ECJ January 11, 1990 (case C-220/88).

⁵⁹⁰ Cf. *Kropholler, Europäisches Zivilprozessrecht*, Art. 27, N 22.

⁵⁹¹ For a definition cf. *Tatry v Maciej Rataj*, ECJ December 6, 1994 (case C-406/92) at §3 B.III.3.a)aa) The reaction of the "abused" courts, and §3 B.III.3.a)bb) The reaction of the courts that were "passed over"; for an overview, cf. *Herzog*, 387-389.

⁵⁹² Cf. also *Grabinski, Angst*, 463.

⁵⁹³ *Roche Nederland BV v Primus*, ECJ July 13, 2006 (case C-539/03).

⁵⁹⁴ Cf. §3 B.III.3. The problem of "torpedoes".

independently of whether the infringement or the nullity action regarding the same part of the European patent was brought first⁵⁹⁵. This question was relevant, as it was legal practice in many European states - before the decision of the ECJ in *GAT v LuK*⁵⁹⁶ - that a court dealing with the infringement of a foreign patent or of a foreign part of a European patent also decided its validity with effect *inter partes* if the nullity question was brought up incidentally.

The ECJ made clear in this decision that Article 16(4) Brussels Convention (Art. 22(4) Regulation 44/2001) is to be interpreted as meaning that the rule of exclusive jurisdiction laid down therein concerns all proceedings related to the registration or validity of a patent, irrespective of whether the issue is raised by way of an action or a plea in objection⁵⁹⁷. The infringement court can consequently not even incidentally decide on the validity of a foreign patent. This case law has, in the meantime, also been implemented in the revised⁵⁹⁸ Lugano Convention. What is not definite, however, is whether it has to stay the proceedings or whether the proceedings will have to be transferred to the territory of the state where the patent takes effect as soon as the invalidity issue is raised⁵⁹⁹.

⁵⁹⁵ Cf. *Stauder, Verletzungsverbote*, 321; *Kieninger*, 281; *Adams*, 499; *Mäder*, 107-109; *Kropholler, Europäisches Zivilprozessrecht*, Art. 27, N 10.

⁵⁹⁶ *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, ECJ July 13, 2006 (case C-4/03).

⁵⁹⁷ See in this regard also the proposal of the European Max-Planck Group for Conflict of Laws in Intellectual Property (*CLIP proposal*) where it is suggested that Article 22(4) Regulation 44/2001 should be amended to make it clear that a judgment involving validity would not go beyond having merely an *inter partes* effect.

⁵⁹⁸ Art. 22(4) revised Lugano Convention: "*The following courts shall have exclusive jurisdiction, regardless of domicile:...*

in proceedings concerned with the registration or validity of patents, trade marks, designs, or other similar rights required to be deposited or registered, irrespective of whether the issue is raised by way of an action or as a defence, the courts of the State bound by this Convention in which the deposit or registration has been applied for, has taken place or is under the terms of a Community instrument or an international convention deemed to have taken place.

Without prejudice to the jurisdiction of the European Patent Office under the Convention on the grant of European patents, signed at Munich on 5 October 1973, the courts of each State bound by this Convention shall have exclusive jurisdiction, regardless of domicile, in proceedings concerned with the registration or validity of any European patent granted for that State irrespective of whether the issue is raised by way of an action or as a defence." The revised text of the Lugano Convention is available at

<www.ofj.admin.ch/bj/en/home/themen/wirtschaft/internationales_privatrecht/lugano_uebereinkommen/0.html>, (see also Proposal for a Council Decision concerning the signing of the Convention between the EC and the Republic of Iceland, the Kingdom of Norway, the Swiss Confederation, and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, COM(2007) 387 final). It is expected that the revised convention will enter into force in 2009. Cf. also Herren Jürg, *Revidiertes Lugano-Übereinkommen vor der Unterzeichnung*, 2007 sic!, 497-498.

⁵⁹⁹ Cf. in this regard also §3 C.VI.1.b)bb)aaa)i) Analysis.

Before the ECJ rendered its ruling in *Roche Nederland BV v Primus*⁶⁰⁰ it was also in dispute whether an infringement action and an action for a declaration of non-infringement which are pending in different states of Reg 44/LC with regard to different parts of a European patent are at least *related actions*, as they do not involve the same cause of action within the meaning of Article 27 Regulation 44/2001, i.e. Article 21 Lugano and Brussels Convention⁶⁰¹.

An example may illustrate the situation. A Belgian holder of a European patent takes the view that the Dutch part of his European patent is infringed by a person domiciled in the Netherlands and sues the person at the District Court in The Hague. However, the alleged infringer files an action for declaration of non-infringement of the Belgian part of the European patent in Belgium before the patent holder can file the infringement action in the Netherlands. Does the Dutch court have to stay its proceedings in such a case?

The background for this discussion is Article 28(1) Regulation 44/2001 (Article 22(1) Lugano Convention), which provides for the consequences of Article 27 Regulation 44/2001 (Article 21 Lugano Convention) if *related actions* are simultaneously pending in the courts of different contracting states. However, in contrast to Article 27 Regulation 44/2001 (Article 21 Lugano Convention) the court second seised is free to decide whether it would like to stay its proceedings. In our example, it would consequently be up to the Dutch court to decide whether it wants to wait for the Belgian judgment in order to be able to take it into account when deciding on the Dutch part of the European patent.

The ECJ, however, took the view that, because of the “bundle” approach of a European patent, the decisions on the different parts could not be classed as contradictory since a different legal situation would be involved. It follows that actions on different parts of a European patent cannot be related. Therefore, the court second seised has no possibility to stay its proceedings in the above-mentioned example.

The argument of the ECJ is, however, very questionable, as European patent law is uniform law which has to be construed in a unitary manner⁶⁰².

⁶⁰⁰ *Roche Nederland BV v Primus*, ECJ July 13, 2006 (case C-539/03).

⁶⁰¹ Cf. *Kropholler, Europäisches Zivilprozessrecht*, Art. 27, N 11; *Otte*, 443.

⁶⁰² Cf. also *Hess/Pfeiffer/Schlosser*, N 833.

While the precise point of *lis pendens* was not regulated in the Brussels and Lugano Conventions and was left to national law⁶⁰³, it is now included in Article 30 Regulation 44/2001. This provision has also been implemented into the revised Lugano Convention⁶⁰⁴.

The national rules looked as follows: On the basis of the unclear wording in the Lugano Convention, and the earlier Brussels Convention, some states have decided that the date of filing the claim in the court determines whether there are grounds for *lis pendens*, while others decided that a claim is validly pending as soon as the defendant is properly informed. The latter legislators obviously considered that a defendant in an action for which leave to serve was sought *ex parte* could have been placed at a comparative disadvantage, as he could not have had notice of such matters at that stage⁶⁰⁵. Other states again regard a court as seised of a matter where notification is required before filing, as soon as the documents are delivered to the person or authority responsible for service⁶⁰⁶.

The EC went for the middle way in Regulation 44/2001 trying to reconcile the various procedural systems⁶⁰⁷:

The precise point of time of *lis pendens* is in general when the document instituting the proceedings or an equivalent document is lodged with the court⁶⁰⁸. It is, however, under

⁶⁰³ ECJ declared in *Zelger v Salinitri*, June 7, 1984 (case 129/83) that Art. 21 of the Brussels Convention must be interpreted as meaning that the court first seised is the one before which the requirements for proceedings to become definitely pending are first fulfilled, such requirements to be determined in accordance with the national law of each of the courts concerned; also cf. *Lupoi*, 162-167; *Herzog*, 385.

⁶⁰⁴ Cf. Art. 30 revised Lugano Convention, cf. Proposal for a Council Decision concerning the signing of the Convention between the EC and the Republic of Iceland, the Kingdom of Norway, the Swiss Confederation, and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, COM(2007) 387 final, and

<www.ofj.admin.ch/bj/en/home/themen/wirtschaft/internationales_privatrecht/lugano_uebereinkommen/0.html>

⁶⁰⁵ Cf. *Kaye*, 87 with reference to *Agrafx Public Relations Ltd v United Scottish Society Incorporated*, 1995 I.L.Pr., 753.

⁶⁰⁶ Cf. *Nygh/Pocar*, 87.

⁶⁰⁷ Cf. Proposal for a Council Regulation of 14.7.1999 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, COM(1999), 348 final, 20.

⁶⁰⁸ In the Discussion Draft No. 4, April 18, 2003 of the Principles and Rules of Transnational Civil Procedure of ALI/UNIDROIT, it was suggested that the exact time of *lis pendens* is "the time a claim is first asserted", which provides for the same approach (cf. Principle 28.2). This proposal was, however, generalised in the final version: "*The time of lodging of the complaint with the court determines compliance with statutes of limitation, lis pendens, and other requirements of timeliness*" (cf. Principle 10.2 ALI/UNIDROIT, *Principles Civil Procedure*).

the resolutive condition that the plaintiff has subsequently managed to take the necessary steps required to have service effected on the defendant. The responsibility for the claim therefore lies in the hands of the plaintiff⁶⁰⁹. However, if the plaintiff has first to file with the defendant due to national law, the action is deemed to be seised at the time when the document is received by the authority responsible for service, provided that the plaintiff has not subsequently failed to take the steps he was required to take to have the document lodged with the court.

The rule in Regulation 44/2001 is a good solution since it avoids the defendant being notified of an action which will possibly never become active, and his therefore being caused unjustified fear.

This uniformity in Europe should basically be in the interest of users, not least since it is creating further legal certainty. *Forum shopping* would consequently be neutralized to a certain extent⁶¹⁰. However, as the determination of the relevant moment of *lis pendens* still depends on various legal systems if and in so far as the applicable procedural law decides the necessary prerequisites for the document instituting the proceedings or for lodging with the court, as well as deciding which authority serves in a given legal system as the authority responsible for service, it is still not fully ensured that all applicants are on an equal footing⁶¹¹.

2. The approach in the draft Hague Jurisdiction Convention

The *lis pendens* rules in Regulation 44/2001 differ slightly from the one in the former draft of the Hague Conference on Private International Law project for a worldwide agreement on jurisdiction and foreign judgments in civil and commercial matters (Hague Jurisdiction Convention; HJC).

The project was put on ice, not least because of the difficulties of reaching an agreement with regard to intellectual property rights. Nevertheless, it is interesting to have a closer look at the latest proposals.

⁶⁰⁹ In the proposal for a unified European Code of Civil Procedure it was suggested that the court basically issues a writ whose date of issue is the basis for *lis pendens* (cf. Article 2.2.2.1, *Judiciary Law*).

⁶¹⁰ Cf. §3 B.III.3. The problem of "torpedoes".

⁶¹¹ Cf. *Hess/Pfeiffer/Schlosser*, N 476.

On the one hand, Article 21(1) draft HJC requests a stay of proceedings of the second court seised when "the same parties" are engaged in proceedings in courts of different contracting states and when such proceedings are based on the "same cause of action, irrespective of the relief sought" (*eadem res*), if the court first seised has jurisdiction and is expected to render a judgment capable of being recognised under the HJC in the state of the court second seised, unless the latter has exclusive jurisdiction.

In regard to the requirement of *eadem res*, the draft is more precise than the corresponding provisions in Regulation 44/2001 or the Lugano Convention⁶¹².

With a view to the exact point of time of *lis pendens*, paragraph 5 of Article 21 draft HJC, on the other hand, provides that a court shall be deemed to be seised when the document instituting the proceedings or an equivalent document is lodged with the court; or if such document has to be served before being lodged with the court, when it is received by the authority responsible for service or served on the defendant.

This solution obviously leaves more room for a particular national regulation. Unlike the solution in Regulation 44/2001, the time of serving the document on the defendant could, for example, be the relevant point of time of *lis pendens*. The decrease in national differences in the area of Regulation 44/2001 would therefore be negated if it was not ensured that these instruments prevail over the HJC. *Forum shopping*, which would obviously have been restricted at the European level, would become more attractive again⁶¹³.

3. The problem of "torpedoes"

As mentioned earlier, it could be of interest for a potential defendant to attack the potential plaintiff before he is sued, in order to assume the typically more favourable role of plaintiff. He would therefore sue the potential plaintiff before the plaintiff can sue him. The court second seised by the potential plaintiff would, as a consequence of Article 27(1)

⁶¹² Cf. also *Walter G., lis pendens*, 141-142.

⁶¹³ Cf. also *Walter G., lis pendens*, 138.

Regulation 44/2001 and Article 21(1) Lugano Convention, have the duty to stay its proceedings until the jurisdiction of the court first seised is established.

Such surprising attacks were not rarely executed by potential patent infringers and became famous as so-called "torpedo actions": In several European countries it is possible to start an action for declaration of non-infringement of a patent. If such an action relating to a foreign patent is heard before a judge in a judicial system which is not particularly quick⁶¹⁴ or which is known for a particularly narrow interpretation of the extent of protection of a patent⁶¹⁵, it may block the other, faster or more liberal jurisdiction from dealing with proceedings concerning the same patent and/or the same alleged infringement.

Such actions are possible because an action seeking substantive relief has no preference over a declaratory action⁶¹⁶, as it is the general aim to ensure equal treatment of both potential parties and provide them with the same opportunities to file an action⁶¹⁷. Once the court seised in negative declaration proceedings has assumed jurisdiction, due to the mandatory provision of Article 27(2) Regulation 44/2001, i.e. Article 21(2) Lugano Convention, the court seised in infringement proceedings must decline its jurisdiction for the entire case⁶¹⁸.

The term "torpedo action" is based on the "Italian torpedo", a name given by *Franzosi*, who addressed this problem for the first time⁶¹⁹ when Italian courts came to unintentional fame for being especially slow in patent litigation.

However, Belgian, Italian and other courts with the reputation of being slow have started to reject such actions⁶²⁰.

⁶¹⁴ Cf. also *Hartley, Abuse*, 78.

⁶¹⁵ Cf. *Tilmann/v. Falck*, 585.

⁶¹⁶ Cf. *Tatry v Maciej Rataj*, ECJ December 6, 1994 (case C-406/92).

⁶¹⁷ Cf. *Kropholler, Europäisches Zivilprozessrecht*, Art. 27, N 10.

⁶¹⁸ Cf. *Hess/Pfeiffer/Schlosser*, N 809.

⁶¹⁹ See *Franzosi, Torpedo*.

⁶²⁰ Cf. Pitz Johann, *Torpedos unter Beschuss*, 2001 GRUR INT., 32-37; *id. Forum blocking*; *Stauder, Weg*, 475; *Otte*, 441-442.

a) *The approaches of the national courts to solving the problem*

aa) *The reaction of the "abused" courts*

On the one hand, it was argued by courts in Belgium that the jurisdiction at the place of tort⁶²¹ is not applicable with regard to actions for declarations of non-infringement with cross-border effect in cases where the patent-protected good has not yet been put on the market and therefore where the plaintiff is seeking a declaration of the non-existence of a harmful event⁶²².

Other Belgian courts took the view that the questions of patent validity and infringement are so closely connected to each other that only the courts located in the state where the patent takes effect could decide on the infringement of the patent concerned. The same must be the case if the question of non-infringement is at stake⁶²³. The courts obviously share the view of the British courts grounded in the famous jurisprudence of *Coin Controls Ltd v Suzo International (UK) Ltd*.⁶²⁴

Courts in Belgium further declined jurisdiction with the conclusion that Article 5(3) Brussels Convention was not applicable if the court had to declare that a party has not yet caused any damage in a certain state⁶²⁵. It is uncertain whether Regulation 44/2001 will change the views of the Belgian courts in that regard, as Article 5(3) now explicitly covers injunctions with regard to torts that may occur⁶²⁶.

Courts in Italy decided, on the other hand, that actions for non-infringement are not actions where damages are requested⁶²⁷ but rather where the plaintiff tries to prove that he has not infringed a patent⁶²⁸. Consequently, he would implicitly declare that no infringement

⁶²¹ Art. 5(3) Reg 44/LC.

⁶²² Cf. *Storor*, 224.

⁶²³ Decision of the *Rechtbank van eerste aanleg te Brussel* (District Court of Brussels) of May 12, 2000, 2001 GRUR INT., 170 with critical remarks of *Véron, Bruxelles*, 826 and *Treichel Pierre*, 2001 GRUR INT., 176; Decision of the *Rechtbank van eerste aanleg te Brussel* of April 7, 2003, reported by *de Jong*, 79.

⁶²⁴ Cf. §3 C.VI.1.b)bb) Jurisdiction to decide about a foreign patent or a foreign part of a European patent.

⁶²⁵ Decision of the *Rechtbank van eerste aanleg te Brussel* (District Court of Brussels) of May 12, 2000, 2001 GRUR INT., 173.

⁶²⁶ Also cf. *de Jong*, 76.

⁶²⁷ Cf. *Kropholler, Europäisches Zivilprozessrecht*, Art. 5, N 78.

⁶²⁸ Decision of *La Corte Suprema di Cassazione* (Supreme Court) of December 19, 2003, 2005 GRUR INT., 264-268 with comments of Wurmnest Wolfgang; cf. also Barraclough Emma, Supreme Court sinks Italian torpedo, Legal Media Group, News, 3 May 2004, <www.legalmediagroup.com>; v. Falck Andreas/Leitzen

has occurred and that he is not liable. In other words, because the plaintiff is trying to show - with a declaratory judgment action - that he has not infringed a patent, he is in fact denying that a tort has been committed.

This approach seems, however, to go against the *Tatry v Maciej Rataj* decision of the ECJ⁶²⁹. The Italian courts obviously take the view that an infringement action and an action for declaration of non-infringement have different objects. If this were the case, the patent infringement proceedings would no longer have to be stayed if an action for a declaration of non-infringement with regard to the same part of a European patent were filed later. The ECJ, however, held in *Tatry v Maciej Rataj* that

"the 'object of the action' for the purposes of Article 21 means the end the action has in view. The question accordingly arises whether two actions have the same object when the first seeks a declaration that the plaintiff is not liable for damage as claimed by the defendants, while the second, commenced subsequently by those defendants, seeks on the contrary to have the plaintiff in the first action held liable for causing loss and ordered to pay damages.

As to liability, the second action has the same object as the first, since the issue of liability is central to both actions. The fact that the plaintiff's pleadings are couched in negative terms in the first action whereas in the second action they are couched in positive terms by the defendant, who has become plaintiff, does not make the object of the dispute different.

As to damages, the pleas in the second action are the natural consequence of those relating to the finding of liability and thus do not alter the principal object of the action. Furthermore, the fact that a party seeks a declaration that he is not liable for loss implies that he disputes any obligation to pay damages."

It is therefore questionable whether this Italian jurisprudence would be upheld by the ECJ.

Other courts in Belgium again rejected their jurisdiction over cross-border claims of non-infringement on the basis of Article 6(1) Brussels Convention⁶³⁰, possibly making reference to the Dutch "spider in the web doctrine". This jurisprudence has, however, meanwhile been rejected by the ECJ in *Roche Nederland BV v Primus*⁶³¹.

Mario, Abschied vom Torpedo auf Raten?, 2005 Mitt., 534-536. Cf. also *v. Nispen*, N 7-26 where it seems that Dutch courts also took the same point of view.

⁶²⁹ Cf. *Tatry v Maciej Rataj*, ECJ December 6, 1994 (case C-406/92). See also the decision of the Swiss Federal Supreme Court of September 26, 1997 (BGE 123 III 414).

⁶³⁰ Cf. *Storor Susan*, Brussels Court of Appeal Curtails Belgian Torpedo Tactics, April 2001 Patent World, 9-10.

⁶³¹ Cf. §3 C.VI.1.b)aa) Development and current situation with regard to Article 6(1) Reg 44/LC.

Last but not least, it was also stated by different courts that it is an abuse of legal rights if the sole purpose of the claim is to try to impede for an undefined period the jurisdiction of courts of other states where the patent is valid while awaiting the decision of the court in question⁶³².

bb) The reaction of the courts that were "passed over"

The *Tribunal de grande instance de Paris*, for example, argued that an action for infringement, on the one hand, and the action for a declaration of non-infringement, on the other hand, with regard to different parts of the European patent did not involve the same cause of action, as required under Article 21 Brussels and Lugano Convention to stay the proceedings⁶³³. German courts obviously followed this argumentation⁶³⁴.

In contrast to the Italian courts, it was not argued that the two actions would have different objectives. However, when arguing that different parts of a European patent would be different rights and would consequently not involve the same cause of action, the fact that the courts actually have to interpret uniform law was ignored. This again seemed to go against the ECJ's decision in *Tatry v Maciej Rataj*, where it was declared that the same cause of action exists if the *rights* and the question of infringement are *identical*, as well as the crucial points to be adjudicated⁶³⁵. However, as mentioned earlier, the ECJ in *Roche Nederland BV v Primus*⁶³⁶ took the view that a European patent continues to be governed by the national law of each of the EPC contracting states for which it has been granted and therefore does not involve the same cause of action if different parts of the European patent are at stake⁶³⁷.

This in fact also has the consequence that a torpedo can be fired in each of the states where the European patent takes effect.

⁶³² Cf. *Storor* (cf. also critical remarks of Véron, *Bruxelles*, 826 in regard to that decision); Véron, *Italian Torpedoes*, 229 and his critics at 230; Kroher, 241; Grabinski, *Angst*, 466.

⁶³³ Decision of the *Tribunal de grande instance de Paris* (District Court of Paris), April 28, 2000, 2001 GRUR INT., 173, with remarks by Treichel Pierre. Supporting this view: Véron, *Italian Torpedoes*, 229; Kropholler, *Europäisches Zivilprozessrecht*, Art. 27, N 10-11; O'Sullivan, 657; Otte, 441-442; Wadlow, N 8-29.

⁶³⁴ Decision of the *Oberlandesgericht of Düsseldorf* of June 29, 2000, reported by Grabinski, *Bedeutung*, 209-210; cf. also Pitz, *Forum blocking*, 24; Kroher, 241.

⁶³⁵ Cf. Otte, 442-443.

⁶³⁶ *Roche Nederland BV v Primus*, ECJ July 13, 2006 (case C-539/03).

⁶³⁷ Cf. also Grabinski, *Bedeutung*, 209-210.

Less successful was a countermeasure of a German court⁶³⁸ against a "torpedo action", arguing that the court first seised for negative declaratory judgment in Belgium had no jurisdiction, not least since the plaintiff of this declaratory action tried to delay proceedings.

The ECJ held in that regard

"...that Article 21 of the Brussels Convention must be interpreted as meaning that it cannot be derogated from where, in general, the duration of proceedings before the courts of the Contracting State in which the court first seised is established is excessively long"⁶³⁹.

This jurisprudence has the consequence that the slowest proceedings could actually be extended to the entire area of European jurisdiction⁶⁴⁰.

Acceptance of the German jurisprudence would obviously go in the direction of an *anti-suit injunction*⁶⁴¹ - an approach the British courts took to avoid blocking strategies.

However, the ECJ took the view that any such injunction runs counter to the principle of mutual trust and undermines the goals of the Brussels Convention⁶⁴². The jurisprudence of the ECJ therefore leaves only limited room to tackle "torpedo actions" and depends on the "goodwill" of the court first seised to limit its own jurisdiction and to render a fast decision on the question of its own jurisdiction.

It is therefore no surprise that *Hess/Pfeiffer/Schlosser* recommend in their report on the application of Regulation 44/2001 in the EU member states that the problem of torpedo actions should be tackled⁶⁴³.

⁶³⁸ Cf. Decision of the *Landgericht Düsseldorf* of December 19, 2002, reported by *Grabinski, Angst*, 467; also cf. *Pitz, Time*, 18. The *Oberlandesgericht Düsseldorf* already argued in 1999 that all the courts of the Brussels contracting states are treated the same. It could thus not automatically be declared that initiating *lis pendens* at a slow court is an abuse of legal rights, cf. *Pitz, Forum blocking*, 23; of the same opinion: *Véron, Italian Torpedoes*, 230.

⁶³⁹ *Erich Gasser GmbH v MISAT Srl.*, ECJ December 9, 2003 (case C-116/02).

⁶⁴⁰ Cf. *Hartley, Abuse*, 77.

⁶⁴¹ Cf. also *Ho*, 704-705 and §3 C.II.2. Anti-suit injunctions.

⁶⁴² *Gregory Paul Turner v Felix Fareed Ismail Grovit, Harada Ltd. and Changepoint SA*, ECJ April 27, 2004, (case C-159/02), §3 C. II. 2. Anti-suit injunctions.

⁶⁴³ Cf. *Hess/Pfeiffer/Schlosser*, N 851; N 919 and their general critical remarks in N 804 to N 818.

b) Alternative solution

aa) Provisional measures

On the basis of Article 31 Regulation 44/2001, i.e. Article 24 of the Lugano Convention, an application may be made to the courts of a state - in which one of the two instruments is applicable - for such provisional, including protective, measures as may be available under the law of the state, even if, under the applicable instrument, the courts of another state - in which one of the two instruments is applicable - have jurisdiction as to the substance of the matter. This was also confirmed by the ECJ in *Van Uden Maritime BV v Deco-Line*⁶⁴⁴. It is thus a common view that such relief is still possible once a "torpedo action" has been filed⁶⁴⁵.

Courts are meanwhile ready to grant more and more provisional injunctions in such circumstances⁶⁴⁶, which makes abusive actions less attractive⁶⁴⁷.

bb) "Inactivity action"

To tackle the "torpedo problem", it was also suggested that a so-called "inactivity action" be introduced against slow courts⁶⁴⁸.

This approach does not seem very promising, as Article 6(1) EHRC⁶⁴⁹ already today provides that, in civil rights disputes, everyone is entitled to a fair and public hearing within a reasonable time by a tribunal.

The European Court of Human Rights developed some criteria which are to be fulfilled by each national civil jurisdiction in order to meet the standards of a reasonable length of

⁶⁴⁴ *Van Uden Maritime BV, trading as Van Uden Africa Line v Kommanditgesellschaft in Firma Deco-Line and Another*, ECJ November 17, 1998 (case C-391/95).

⁶⁴⁵ Cf. *Grabinski, Bedeutung*, 211; *Wadlow*, N 8-30; *Leitzen*, 1015.

⁶⁴⁶ Cf. also §3 C.VI.1.d) Cross-border injunctions based on Article 31 Regulation 44/2001 and on Article 24 Lugano Convention.

⁶⁴⁷ Cf. *Ebbink, Fire-Side*, 258.

⁶⁴⁸ Cf. *Schade, Regelung*, 105.

⁶⁴⁹ Cf. also Art. 47(2) Charter of Fundamental Rights of the European Union.

proceedings⁶⁵⁰:

- First, the legislator has the duty to organise the judicial system in such a way that its courts may hear cases within a reasonable time⁶⁵¹.

- Second, the courts must provide for an active case management. To ensure this kind of management, the court responsible could, for example, order a planning conference early in the proceedings, which the parties and/or their lawyers must attend⁶⁵². It should take decisions which simplify or expedite the proceedings⁶⁵³, such as set a time limit for an expert to submit the opinion, and the court must ensure that the expert called adheres to that limit⁶⁵⁴. However, only delays attributable to the state may justify a finding of failure to comply with the "reasonable time" requirement⁶⁵⁵. The parties' conduct in the proceedings must therefore cause no delays and make an active case management possible⁶⁵⁶. A court may, for example, not be held responsible if a party is unexcusedly absent at oral proceedings⁶⁵⁷, and the assessment of a trial's reasonable speed can also depend on the health of a party⁶⁵⁸. However, a chronic overload of a court system cannot justify an excessive length of proceedings⁶⁵⁹.

- Third, the more complex the facts and the legal questions to be decided, the more time a court may take to render the decision⁶⁶⁰.

- Fourth, the greater the importance of what is at stake for a party in the litigation, the greater the right to a speedy trial⁶⁶¹.

⁶⁵⁰ Cf. Müller, *Grundrechte*, 506-508.

⁶⁵¹ Cf. *Süssmann v Germany*, ECtHR September 16, 1996, Rep. 1996-IV 1158, N 55.

⁶⁵² Cf. Rule 18.2, *ALI/UNIDROIT, Principles Civil Procedure*.

⁶⁵³ Cf. Rule 18.3.4 and 18.4 *ALI/UNIDROIT, Principles Civil Procedure*.

⁶⁵⁴ Cf. *Scopelliti v Italy*, ECtHR November 23, 1993, Ser. A No. 278, N 23.

⁶⁵⁵ Cf. *Ciricosta and Viola v Italy*, ECtHR December 4, 1995, Ser. A No. 337-A, N 28 and also *Foley v United Kingdom*, ECtHR October 22, 2002, Application No. 39197/98, N 38 to N 39.

⁶⁵⁶ Cf. *Academy Trading Ltd and others v Greece*, ECtHR April 4, 2000, Application No. 30342/96, N 49.

⁶⁵⁷ Cf. *Proszak v Poland*, ECtHR December 16, 1997, Rep. 1997-VIII 2765, N 40.

⁶⁵⁸ Cf. *Leigh*, 651.

⁶⁵⁹ Cf. e.g. *Probstmeier v Germany*, ECtHR July 1, 1997, Rep. 1997-IV 1123, N 64.

⁶⁶⁰ Cf. *Maczynski v Poland*, ECtHR January 15, 2002, Application No. 43779/98, N 33; *Pammel v Germany*, ECtHR July 1, 1997, Rep. 1997-IV 1096, N 63; *Phocas v France*, ECtHR April 23, 1996, Rep. 1996-II 546, N 71.

⁶⁶¹ Cf. *Gast and Popp v Germany*, ECtHR February 25, 2000, Rep. 2000-II, N 70; *Phocas v France*, ECtHR April 23, 1996, Rep. 1996-II 546, N 71.

These criteria set out by the European Court of Human Rights are very balanced. A national or even pan-European "inactivity action" that goes beyond these principles therefore seems difficult to achieve. Nevertheless, there is a certain sympathy for this proposal, as the effects of a conviction of a state by the European Court of Human Rights are obviously limited⁶⁶².

cc) Deadline for rendering a decision

A similar direction is taken by the suggestion to implement into Regulation 44/2001 a rule which makes it clear that if the court first seised does not decide on its jurisdiction in a certain time - for example, six months - then the court second seised can resume its procedure⁶⁶³.

Concerns with regard to the "inactivity action" would also apply to this proposal. In addition, the court first seised could still immediately accept jurisdiction and later, when deciding on the substance, delay proceedings.

dd) The approach in the draft Hague Jurisdiction Convention

The implementation of the Hague Jurisdiction Convention⁶⁶⁴ and its precedence over Regulation 44/2001 and the Lugano Conventions would have achieved an immediate change with regard to "torpedo actions".

Article 21(6) of the draft HJC provides that if in the action before the court first seised the plaintiff seeks a determination that it has no obligation to the defendant, and if an action seeking substantive relief is brought in the court second seised, *inter alia* the court first seised shall suspend the proceedings at the request of a party if the court second seised is expected to render a decision capable of being recognised under the HJC. This approach

⁶⁶² Italy, for example, was convicted several hundred times by the European Court of Human Rights because of its slow proceedings (cf. Grothe Helmut, Zwei Einschränkungen des Prioritätsprinzips im europäischen Zuständigkeitsrecht: ausschliessliche Gerichtsstände und Prozessverschleppung, 2004 IPRax, 205-212, 211).

⁶⁶³ Cf. Wittwer Alexander, EuGH-Rechtsprechung zum Zivilprozessrecht 2003/2004, ZEuP 2005, 891; McGuire, *Forum Shopping*, 92-93.

⁶⁶⁴ Cf. §7 C.I. Introduction.

of giving precedence to an action on the merits is partly requested at the European level too⁶⁶⁵.

IV. Provisional and protective measures

Provisional and protective measures are very important tools in protecting a party from further patent infringement, and in securing evidence. The TRIPs Agreement only regulates provisional and protective measures very generally⁶⁶⁶, and the Enforcement Directive provides for only a minimum of harmonisation⁶⁶⁷. There is consequently a wide variety of measures with different effects available in Europe, although the full implementation of the Enforcement Directive in the EU member states will bring some relief.

Litigators analyse quite extensively what kind of measures should be requested, and if and when such measures should be requested⁶⁶⁸. For example, French courts may allow an extensive order for inspection of premises and the preservation of evidence (*saisie contrefaçon*)⁶⁶⁹, and English courts may order a party to refrain from removing any assets from its jurisdiction ("freezing orders", which are often combined with "search orders"). Depending on the interests of the plaintiff, it may therefore be of great importance to provide jurisdiction with a French court. It could also be the totally opposite case, however, and one has to react before the other party requests a possible *saisie contrefaçon*.

Owing to its introduction in Articles 6 and 7 of the Enforcement Directive, the two measures will also be available in other countries in the future; however, there will be differences in the various countries, and consequently *forum shopping* will, to a certain extent, remain attractive to litigators.

However, the procedural effects and practice concerning provisional measures (still) vary extensively in Europe as well. Whereas in Great Britain comparatively short periods of

⁶⁶⁵ Cf. *Fähndrich/Ibbeken*, 622; 625; *Pagenberg, First Instance*, 496; *Schade, Protocol*, 180; *Tilmann/v. Falck*, 586.

⁶⁶⁶ Cf. Art. 50 TRIPs Agreement.

⁶⁶⁷ With regard to measures for preserving evidence cf. Article 7 Enforcement Directive.

⁶⁶⁸ Cf. *Hendrick/van Woortman/Flynn*, 18.

⁶⁶⁹ Cf. e.g., Pierre Véron, *Saisie contrefaçon*, 2^e édition, Dalloz, Paris 2005; *Lenoir/Banchereau*, 4-24 to 4-26; *Treichel*, 163-212; *Le Stanc/Petit*, 353.

delay will result in the denial of an interlocutory injunction, Holland is said to be more relaxed⁶⁷⁰. German courts, on the other hand, are often criticised for being too reluctant in injunctive relief⁶⁷¹. The implementation of the Enforcement Directive will bring some uniformity in this regard as well.

In any case, Article 31 Regulation 44/2001, i.e. Article 24 Lugano Convention, substantially facilitates *forum shopping*⁶⁷², as a plaintiff is able to seek provisional or protective relief in any of the states in which Regulation 44/2001 or the Lugano Convention is applicable, regardless of whether the court concerned has jurisdiction as to the substance of the matter.

V. Procedural differences and court practices

The TRIPs Agreement only regulates some basics in regard to procedural aspects of the enforcement of IPRs⁶⁷³. As discussed earlier, the Enforcement Directive will lead to an additional basic alignment of procedure and remedies, although procedural law and practice is, to a large extent, still a purely national affair. It is therefore no surprise that there are still significant differences in procedural law in general between states in Europe⁶⁷⁴.

This fact certainly also has an influence on the achievement of a uniform interpretation of substantive law⁶⁷⁵. The procedural specialities available in a jurisdiction are an important reason for *forum shopping*⁶⁷⁶.

⁶⁷⁰ See Jacob, *Millennium*, 512.

⁶⁷¹ Cf. Pitz, *Forum blocking*, 24; Klink, 497; but also König, *Probleme*, 298. It seems, however, that the practice has changed, cf. Pitz, *Time*, 16-18.

⁶⁷² Cf. *Franzosi/De Sanctis*, 93.

⁶⁷³ Cf. Art. 41 et seq. TRIPs Agreement.

⁶⁷⁴ Cf. Casalonga Axel, Proposal for a New Judicial Organization in Patent Matters in Europe, Commemorative Book of 60th Birthday of Patent Attorney, Myung-Shin Kim – Present and Future of Intellectual Property, The Korea Industrial Property Law Association, 2004, 1-21, 3; Vandermeulen, 30. Cf. also §6 D. Harmonisation of court proceedings and substantive patent law.

⁶⁷⁵ Cf. Brinkhof, Kort Geding, 499; Willems, *First instance*, 396; Geller, 129-130, König, *Probleme*, 302; Tilmann, *Gemeinschaftszivilrecht*, 804; Chisum, 614 and Röhm Enzyme, decision of the *Rechtbank van eerste aanleg te Brussel* (District Court of Brussels) of 12 May 2000, 2001 GRUR INT., 170-173, 172. Cf. §6 D. Harmonisation of court proceedings and substantive patent law.

⁶⁷⁶ Cf. König, *Probleme*, 297; v. Meibom/Pitz, *Cross-Border Injunctions*, 477; Stieger, *Strategies*, 554; Klink, 494-504; Fawcett/Torremans, 198-199; also cf. Siehr, *Forum Shopping*, 128.

For example, plaintiffs choose a court because the relevant jurisdiction provides for special remedies⁶⁷⁷, legal aid⁶⁷⁸, a certain language of proceedings⁶⁷⁹, or because English documents are accepted by the court without translation⁶⁸⁰, or because there are special rulings on evidence and the onus of proof⁶⁸¹.

However, there are many more reasons why a certain jurisdiction is chosen on the basis of the applicable procedural law⁶⁸²:

On the one hand, the common law system, for example, provides for cross-examination and the possibility to call one's own experts⁶⁸³. French practice, on the other hand, provides for the so-called *action abusive*⁶⁸⁴: a claim or counterclaim for damages in cases of an abusive filing of an action⁶⁸⁵. The Netherlands again, as will be seen below, have the *kort geding* procedure⁶⁸⁶ and, as seen above, Germany⁶⁸⁷ and Austria both have "split proceedings". Both jurisdictions are also famous for having paper-based proceedings⁶⁸⁸.

However, the courts' practices are also very important. Some courts in the EPC contracting states are known for their active case management, whereas others are known for their rather slow handling of cases. Still others are famous for rendering cross-border judgments more extensively than others. The ECJ has, however, meanwhile strongly limited the possibility of rendering such judgments, as will be shown below⁶⁸⁹.

Some *fora* are known to stay proceedings more liberally if an opposition procedure before the EPO is pending⁶⁹⁰, or are known to encourage or insist upon alternative forms of

⁶⁷⁷ Cf. *ILA Leuven/London principles*, N 11; *Peberdy*, 24

⁶⁷⁸ Cf. *Jacob, Harmonisation*, 148.

⁶⁷⁹ Cf. *Price/Thornham*, 20.

⁶⁸⁰ Cf. Brinkhof Jan in: *Dagg/Brook*, 704.

⁶⁸¹ Cf. *Pitz, Aspects*, 22.

⁶⁸² Cf. also *Halberstam*, 243.

⁶⁸³ Cf. *Cornish/Llewelyn*, 634; *Campbell*, N 1-51; *Jacob, Harmonisation*, 148; *Cohen*, 379; *Vandermeulen*, 31.

⁶⁸⁴ Also cf. the similar approach in Article 48 TRIPs Agreement and Article 66 draft EPLA: "Indemnification of a party".

⁶⁸⁵ Cf. *Stauder, Verletzungsverfahren*, 98-99; *Treichel*, 206-208.

⁶⁸⁶ Cf. Brinkhof Jan in: *Dagg/Brook*, 704.

⁶⁸⁷ Cf. §2 C.I.1. Split proceedings ("bifurcation").

⁶⁸⁸ Cf. David Barron, *Beyond the Borders Litigation in Europe*, LES 2003, Winter Meeting, Salt Lake City, 12-14 February 2003.

⁶⁸⁹ Cf. §3 C.VI.1. Cross-border injunctions.

⁶⁹⁰ Cf. Walter Hans Peter, *The Stay of Infringement or Revocation Proceedings Pending Opposition or Revocation Proceedings before Another Court or Authority under Swiss Law*, 1989 IIC, 281-287, 285; *Cook*,

dispute resolution⁶⁹¹. Still others push more for a friendly settlement, whereas yet others prefer to decide the case immediately. Furthermore, there is also no common practice when an injunction⁶⁹² is granted.

All of these court practices are well-known to litigators, and courts are especially chosen because of that.

1. The *kort geding* procedure

a) Introduction

As the Dutch *kort geding* procedure came to possibly unintentional fame in European patent litigation, it needs to be described separately.

The *kort geding* is a procedure in its own right, a type of quasi-principal proceedings⁶⁹³, being faster⁶⁹⁴, more efficient and less expensive than normal proceedings⁶⁹⁵. It is a summary procedure⁶⁹⁶. However, it is also less thorough than a full procedure and there are more uncertainties concerning the veracity of the facts presented⁶⁹⁷.

The special feature of this procedure was that a regular principal procedure⁶⁹⁸ deciding the provisional situation did not necessarily follow⁶⁹⁹, such as is typically requested to qualify a procedure as one based on provisional or protective measures⁷⁰⁰. It was, therefore, in dispute whether this procedure comes under the heading of provisional relief as defined in Article 31 Regulation 44/2001⁷⁰¹, i.e. Article 24 of the Lugano and Brussels Conventions.

305, 309-310; Brinkhof Jan, *The Stay of Infringement Proceedings in the Netherlands*, 1989 IIC, 288-295; *Vandermeulen*, 32; *Barron, Experience II*, 143-144; Rogge Rüdiger, *Zur Aussetzung in Patentverletzungsprozessen*, 1996 GRUR INT., 386-390.

⁶⁹¹ Cf. *Peberdy*, 24-25; *Jacob, Harmonisation*, 143-145.

⁶⁹² Cf. *Barron, Experience II*, 143.

⁶⁹³ Cf. *Brinkhof, Zu weit?*, 490 who speaks of a "hybrid" between ordinary proceedings and proceedings for provisional and protective measures.

⁶⁹⁴ Cf. *v. Nispen*, N 7-77 who speaks of "speedy trial procedure".

⁶⁹⁵ Cf. *Bertrams*, 626.

⁶⁹⁶ Cf. *Stauder, Aspekte*, 625.

⁶⁹⁷ See *Brinkhof, Kort Geding*, 501.

⁶⁹⁸ Cf. *Bertrams*, 627.

⁶⁹⁹ Cf. *Perret, Territorialité*, 131.

⁷⁰⁰ Cf. *Kessedjian*, N 2; Meier Isaak, *Zuständigkeit im Immaterialgüter- und Wettbewerbsrecht nach Gerichtsstandsgesetz*, 2001 sic!, 377-386, 382; *Vogel/Spühler*, §61, N 190; *Franzosi, Weltweite*, 301.

⁷⁰¹ Cf. *Wadlow*, N 8-37; *Franzosi, Weltweite*, 301.

This question was of special importance, as a different classification would have made it impossible for Dutch courts to go ahead once *lis alibi pendens* was established at a different court⁷⁰². It should, however, be noted that this is the only relevance of the *kort geding* to these provisions, as the Dutch courts usually derive their international (and territorial) jurisdiction from Articles 2, 5(3) and 6 Reg 44/LC and not from Article 31 Regulation 44/2001, i.e. Article 24 of the Lugano Convention⁷⁰³.

Whereas Dutch courts affirmed that another existing procedure would not hinder the Dutch courts from dealing with the same matter in a *kort geding* procedure⁷⁰⁴, it was unclear whether the ECJ shared this view. In *Hermès International v FHT Marketing Choice BV*⁷⁰⁵ the ECJ decided that the *kort geding* procedure meets the definition of a provisional measure as provided for in Article 50 TRIPs Agreement⁷⁰⁶.

It was, however, still unclear whether it also fulfilled the requirements of a provisional measure as provided for in Regulation 44/2001 and the Lugano Convention. This was later confirmed by the ECJ in *Mietz v Intership Yachting*⁷⁰⁷.

In 2002, Article 260 of the Dutch Code of Civil Procedure was nevertheless amended in order to ensure that the procedure is fully in line with the TRIPs Agreement. The provision, which was again revised and replaced by Article 1019i Dutch Code of Civil Procedure on 1 May 2007, now states that the judge granting provisional measures sets a "reasonable time/term" for initiating proceedings on the merits within six months. In the Netherlands the *kort geding* procedure is used in less than half of all patent cases.

⁷⁰² Cf. §3 B.III.1. The European rules.

⁷⁰³ Cf. *Cohen*, 382; *Wadlow*, N 1-34.

⁷⁰⁴ Cf. *Brinkhof, Measures*, 362; *Bertrams*, 628.

⁷⁰⁵ *Hermès International (a partnership limited by shares) v FHT Marketing Choice BV*, ECJ June 16, 1998 (case C-53/96).

⁷⁰⁶ The *kort geding* procedure should also qualify as a provisional measure within the meaning of Article 51(1) TRIPs Agreement, cf. *Brinkhof Jan* in panel discussion/question and answer session: Patent Issues Concerning Enforcement and TRIPs, *International Intellectual Property Law & Policy*, vol. 5, Chapter 7, Hansen Hugh (ed.), Fordham University School of Law, 2003, N 7-2.

⁷⁰⁷ *Hans-Hermann Mietz v Intership Yachting Sneek BV*, ECJ April 29, 1999 (case C-99/96).

Alongside the *kort geding* procedure there are two more proceedings open to a party in the case of patent infringement in the Netherlands: regular proceedings on the merits or, alternatively, accelerated proceedings on the merits⁷⁰⁸.

b) Outline of the procedure

In a typical *kort geding* action, the patent holder requests the competent Hague District Court to prohibit the defendant from infringing the patent and, if a prohibition is issued, requests that the President also order the defendant to pay a sum of money as a penalty payment (*dwangsom*) for every infringement of the prohibition⁷⁰⁹. It is the parties who determine the scope of the dispute, as they do in normal proceedings⁷¹⁰.

The court session is simplified, as well as informal⁷¹¹, and is characterised by the two parties appearing before the court to orally explain their written claims, submitted in advance. In a *kort geding* procedure, the judge may hear witnesses or ask for expert opinion. This seldom happens, however.

The court session normally lasts half a day, and the decision is rendered in writing one or two weeks later⁷¹². The procedure lasts about 2 to 3 months in all⁷¹³.

The judgment may be appealed but, because an appeal has no suspensive effect, it remains enforceable⁷¹⁴. The judge usually sets the winner a time limit of 6 months in which to file an action on the merits. The judge dealing with the proceedings on the merits is not bound by the decision of the *kort geding*⁷¹⁵.

If the case is complicated⁷¹⁶ - for example, if questions of private international law have to be answered and different laws have to be applied, or the case involves a great financial

⁷⁰⁸ Cf. *Allen/Gielen*, 225.

⁷⁰⁹ See *Brinkhof, Kort Geding*, 500.

⁷¹⁰ Cf. *Brinkhof, Kort Geding*, 500.

⁷¹¹ Cf. *Brinkhof, Enforcement*, 174.

⁷¹² See *Brinkhof, Kort Geding*, 500-501.

⁷¹³ Cf. *Brinkhof, Enforcement*, 175.

⁷¹⁴ Cf. *Gauci*, 362.

⁷¹⁵ See *Brinkhof, Kort Geding*, 500.

⁷¹⁶ Cf. also *Stauder, Cross-Border*, 502.

interest⁷¹⁷, or a procedure on the merits is required⁷¹⁸ - a *kort geding* is basically excluded. However, the court could also take into consideration the fact that, in particular, defendants located abroad are often "overtaken" by *kort geding* proceedings and feel themselves to be in a disadvantaged position in relation to the plaintiff, who could prepare the case in very great detail⁷¹⁹. The plaintiff therefore has to expressly indicate why it would, in such cases, irrespectively like to initiate a *kort geding* procedure and why it does not require accelerated proceedings on the merits⁷²⁰.

Accelerated proceedings could, however, also be of interest to a party if it prefers the court to look into the matter fully but, at the same time, still requests a speedy trial⁷²¹. Accelerated proceedings may therefore be a good alternative to the *kort geding* procedure. They are also very efficient and usually lead to a decision in about 10 months after the commencement of the proceedings⁷²².

A party wishing to enter accelerated patent proceedings must petition the court for permission to do so⁷²³. If the *Arrondissementrechtbank Den Haag* (District Court of The Hague) grants the request for accelerated proceedings, it issues an order which specifies the exact deadlines of the necessary documents to be filed by both parties. The hearing in the proceedings is limited to approximately 4 hours: 2 hours for each party to present the case and for rebuttal⁷²⁴.

A decision in accelerated proceedings on the merits is generally directly enforceable, notwithstanding an appeal⁷²⁵.

⁷¹⁷ Cf. *Hoffmann-La Roche AG v Organion Technika B.V. and others*, *Gerechtshof Den Haag* (Court of Appeals of The Hague), September 12, 1996, 1997 Mitt., 34-39, 35.

⁷¹⁸ Cf. *Brinkhof, Enforcement*, 175.

⁷¹⁹ Cf. *Brinkhof, Enforcement*, 175; *Brinkhof, de Ranitz*, 142; also cf. von Meibom Wolfgang/Pitz Johann, Cross-border Jurisdiction in Europe from a German Perspective, May/June 1998 Patent World, 28-31, 29.

⁷²⁰ Cf. Gielen Charles, Patent Procedural Matters: Extended Preliminary Relief Proceedings, 08/01 WIPR, 10-11; but also cf. *Hoffmann-La Roche AG v Organion Technika B.V. and others*, *Gerechtshof Den Haag* (Court of Appeals of The Hague), September 12, 1996, 1997 Mitt., 34-39, 35.

⁷²¹ Cf. *Freshfields Bruckhaus Deringer*, 65.

⁷²² Cf. *Oosting*, 45.

⁷²³ Cf. *Allen/Gielen*, 226.

⁷²⁴ Cf. *Oosting*, 45.

⁷²⁵ Cf. *Freshfields Bruckhaus Deringer*, 65.

VI. Damages

The levels of damages (still) vary in Europe⁷²⁶ and attract the litigators⁷²⁷.

Whereas US courts are often chosen at the international level because of the potentially exorbitant damages that could be paid⁷²⁸, the situation is a little more moderate in Europe. The TRIPs Agreement and the Enforcement Directive brought and will bring some harmonisation but left room for national specialities⁷²⁹.

Article 45(1) TRIPs Agreement provides that the judicial authorities shall have the authority to order the infringer to pay the right holder damages adequate to compensate for the injury the right holder has suffered because of an infringement of that person's IPR by an infringer who knowingly, or with reasonable grounds to know, engaged in infringing activity. This provision was copied to Article 13(1) Enforcement Directive.

The judicial authorities shall, on the basis of Article 45(2) TRIPs Agreement, also have the authority to order the infringer to pay the right holder expenses, which may include appropriate attorney's fees. In appropriate cases, members may authorise the judicial authorities to order recovery of profits and/or payment of pre-established damages even where the infringer did not knowingly, or with reasonable grounds to know, engage in infringing activity. Whereas the first part was taken over - with a possible reservation on the ground of equity - into Article 14 of the Enforcement Directive, the second part of this provision was implemented into paragraph 2 of Article 13.

In France, for example, it is possible that a patent holder's lost profits could be awarded⁷³⁰, but the infringer's profits cannot be claimed as damages⁷³¹. This will have to be changed in the future⁷³² as Article 13(1)(a) Enforcement Directive states that the judicial authorities

⁷²⁶ Cf. *Jacob, Harmonisation*, 147; *Musmann/v.d.Osten*, 99; *Bell, Forum Shopping*, N 2.29.

⁷²⁷ Cf. *Luginbuehl*, 263; also cf. the different contributions on the national situation in: *European Patent Litigation Handbook*, Reid Brian C. (ed.), London 1999.

⁷²⁸ Cf. *Siehr, Forum Shopping*, 126-127; *Geller*, 129; *Bell, Forum Shopping*, N 2.20 to N 2.22.

⁷²⁹ Cf. also *Liedl*, 119.

⁷³⁰ Cf. *Brüning-Petit, Enforcement*, 167-170; *Treichel*, 267-276.

⁷³¹ Cf. *Le Stanc/Petit*, 355.

⁷³² Cf. *Brüning-Petit, Directive*, 350-351; cf. also Schmidt-Szalewski, *La détermination des conséquences civiles de la contrefaçon selon le projet de loi de lutte contre la contrefaçon*, 2007 novembre propr. industr., 9-13, 10-11.

shall take into account all appropriate aspects, such as the negative economic consequences, including lost profits, when setting the damages.

As an alternative to (a), the judicial authorities may, in appropriate cases, set the damages as a lump sum on the basis of elements such as the least amount of royalties or fees which would have been due if the infringer had requested authorisation to use the intellectual property right in question.

In Germany⁷³³ the infringed patent holder could choose from either damages or reimbursement of lost profits. The same seemed to be the case for the United Kingdom⁷³⁴. What effect the first alternative of Article 13(1) Enforcement Directive will have on this practice is unclear⁷³⁵, although it is expected that there will be no revolutionary changes⁷³⁶.

Included in the regulation was, furthermore, the Dutch regulation that the patent holder may ask for damages coupled with the profits the defendant has derived from the infringement if he requests compensation⁷³⁷.

It is interesting that in the future, when setting the damages, the courts may also take into account elements other than economic factors, such as the moral prejudice caused to the right holder by the infringement - a point which was highly controversial in the European doctrine⁷³⁸. Even more interesting, however, will be to see what kind of moral prejudice and what extent will be taken into account by the national courts⁷³⁹ in patent cases, as this is typically a copyright-related issue.

Multiple damages with a "punishment" effect⁷⁴⁰ are unknown in all of these legal areas, although increasingly suggested by IP specialists⁷⁴¹. The proposal in the draft

⁷³³ Cf. *Marshall*, 668.

⁷³⁴ Cf. *Cornish/Llewelyn, IP*, N 2-43; *Wadlow*, N 5-23; *Tilmann, Konstruktionsfragen*, 371.

⁷³⁵ Cf. *Kur, Enforcement Directive*, 828.

⁷³⁶ Cf. *Tilmann, Konstruktionsfragen*, 368-371; 375; *Huniar*, 98.

⁷³⁷ Cf. *Brinkhof, Enforcement*, 186; *v. Nispen*, N 7-92.

⁷³⁸ Cf. *Harte-Bavendamm*, 804.

⁷³⁹ Cf. Brodie Alexandra, Member States Adopt Directive On Enforcement of IP Rights, 06/04 WIPR, 7; *Kur, Enforcement Directive*, 828.

⁷⁴⁰ Cf. *Meier-Beck, Damages*, 122.

⁷⁴¹ Cf. *Harte-Bavendamm*, 803-804; Dreier Thomas, "Kompensation und Prävention", 2002, 614.

Enforcement Directive⁷⁴² to award double royalties or fees⁷⁴³ which would have been due if the infringer had requested authorisation to use the IPR in question did not therefore seem convincing. This proposal ended in a simple award which the judicial authorities may take into account in appropriate cases and as an alternative to Article 13(1)(a) Enforcement Directive⁷⁴⁴. EU member states are, however, free to provide a higher level of protection for IPRs⁷⁴⁵.

VII. Interpretation of European patent law and other substantive law

As mentioned earlier, contradictory interpretations of European patent law are particularly the case in regard to Article 69 EPC, that is to say as regards the extent of protection conferred by a patent, and especially the treatment of equivalents⁷⁴⁶, the significance of prior statements and the file history⁷⁴⁷. As a consequence, there is a variety of jurisprudences concerning the infringement of a European patent⁷⁴⁸. Depending on the interpretation, this also leads to jurisdiction that is more or less pro-patent⁷⁴⁹.

Consequently, the plaintiff would rather choose a court that provides for a wide interpretation of the extent of protection⁷⁵⁰, whereas the potential defendant would rather try to generate jurisdiction in another court.

Courts are also chosen, however, according to choice of law rules and the law they must apply on the basis of these rules⁷⁵¹, a point which is also held by the European Commission to possibly provoke a distortion of competition⁷⁵². *Forum shopping* consequently also leads to a situation in which many plaintiffs take control of substantive law⁷⁵³ to a certain degree. The entry into force of the EC Regulation on the law applicable

⁷⁴² Cf. Article 17 Damages, Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final.

⁷⁴³ Cf. *Kur*, *Enforcement Directive*, 829-830.

⁷⁴⁴ Article 13(1)(b) Enforcement Directive.

⁷⁴⁵ Cf. Article 16 Enforcement Directive and *Huniar*, 99.

⁷⁴⁶ Cf. *Hölders*, *Grenzüberschreitende*, 91-135; cf. also with regard to a definition of equivalence n. 366.

⁷⁴⁷ Cf. *Pagenberg/Köster*, 9; *Peberdy*, 23.

⁷⁴⁸ Cf. *Fawcett/Torremans*, 199-200.

⁷⁴⁹ Cf. *Young/Birss*, 364; Markey Howard T. in: *Kolle/Stauder*, 3. *Symposium*, 513.

⁷⁵⁰ Cf. *Willems*, *First instance*, 394.

⁷⁵¹ Cf. *McGuire*, *Forum Shopping*, 83; *Fawcett/Torremans*, 200; *Hölder*, *Grenzüberschreitende*, 5; also cf. Rome II proposal, 3 and §3 C.V. Inconsistency of choice of law rules and the problem of applying law taking effect abroad.

⁷⁵² Cf. Rome II proposal, 7.

⁷⁵³ Cf. *Notes*, 1678; *Kropholler*, FS, 171; *Bell*, *Forum Shopping*, N 2.58.

to non-contractual obligations (Rome II Regulation) and its harmonising effect will change this situation⁷⁵⁴.

VIII. Costs

Patent litigation costs are different from court to court in Europe. Court fees alone in patent cases can vary from 50 Euros to a couple of million Euros in European civil courts.

It is no secret that proceedings in the United Kingdom can be very expensive⁷⁵⁵ whereas, for example, in Sweden they are extremely cheap⁷⁵⁶. The cost factor may therefore play an important role in choosing a court⁷⁵⁷, and any litigator may ask himself whether he would like to hold down costs or whether he would rather drive the opponent to the table and sue in a high-cost jurisdiction⁷⁵⁸.

Another important factor in that regard is the question of where the party can recover the costs and fees⁷⁵⁹. Whereas, for example, in France⁷⁶⁰ and the Netherlands⁷⁶¹ the courts only award a limited amount of the actual fees charged by lawyers and patent attorneys, Germany⁷⁶² and the United Kingdom⁷⁶³ are more generous⁷⁶⁴.

However, the Enforcement Directive implies that the courts will also have the authority to order the infringer to pay the right holder appropriate attorney's fees. Practice in Europe should therefore be harmonised to a greater extent once the Enforcement Directive has been implemented in all EU member states. It will be interesting to see what approach the courts will take to the determination of fees for lawyers and patent attorneys.

⁷⁵⁴ Cf. §3 C.V.1. The situation in Europe concerning choice of law rules.

⁷⁵⁵ Cf. *Adams*, 499. See also Assessment of the impact of the European patent litigation agreement (EPLA) on litigation of European patents, EPO acting as secretariat of the Working Party on Litigation, February 2006, 10 and Annex 1, available at <www.epo.org/patents/law/legislative-initiatives/epla/assessment.html>.

⁷⁵⁶ In 2003 the fees were € 50 in first instance and no fee in second instance, cf. Workload and cost of the European Patent Judiciary, WPL/4/03, 9.

⁷⁵⁷ Cf. *Lubbock*, 389; *Dasser*, 258; *Kempner*, *Ferrari*, 354; *Kropholler*, *FS*, 165; *Musmann/v.d.Osten*, 99; *v. Meibom/Pitz*, *Cross-Border Injunctions*, 477.

⁷⁵⁸ See *Pitz*, *Aspects*, 23.

⁷⁵⁹ Cf. *Vandermeulen*, 34-35.

⁷⁶⁰ Cf. *Treichel*, 275-276; *Véron*, *Patent Infringement*, 401.

⁷⁶¹ Cf. *Brinkhof*, *Enforcement*, 186.

⁷⁶² Cf. *Treichel*, 288-289; *Marshall*, 137.

⁷⁶³ Cf. *Cooke*, 49.

⁷⁶⁴ Cf. *Hendrick/van Woortman/Flynn*, 20-21.

C. Possible and real problems related to cross-border *forum shopping*

I. Limited number of experienced courts and abuse of the situation

The designation of too many courts having territorial jurisdiction in comparison to the number of cases has led to a situation in many EPC contracting states where only a limited number of courts have acquired experience. It led to a concentration of proceedings before these courts, while the other courts failed to gain any experience in patent litigation even though they kept jurisdiction in the matter.

As a consequence, on the one hand experienced courts must be prepared to deal with a greater workload if efficacy is to be upheld and delays avoided.

On the other hand, as mentioned earlier, less experienced courts are chosen because of their lack of knowledge of patent litigation⁷⁶⁵. The effect on speed and quality has already been explored in that respect. It is even possible that threats of procedural action such as negative declaratory actions are used by potential infringers as tools in cross-border patent litigation. Such an approach may place his opponent's title in doubt, make his financial position uncertain and impair the course of his business as much as a threatened illegal act⁷⁶⁶. Counter-strategies must therefore be sought by the opposing party.

Already this makes it clear that the abuse of legal rights not only causes problems for the defendant but is also an unnecessary burden for the courts⁷⁶⁷. However, it also seems to go against the basic understanding of morality and justice.

The moral concept of law and justice reflects a prevailing belief that, in so far as the law has unavoidable elements of chance, parties should not be able to manipulate these elements for their own advantage⁷⁶⁸. It should also be emphasised that what may be an advantage for one party is in most cases a disadvantage for the other party and may consequently call into question the correct balance of their positions in the proceedings.

⁷⁶⁵ Cf. *Jacob, Harmonisation*, 148; *Luginbuehl*, 259.

⁷⁶⁶ Cf. *Bell, Negative*, 681 with reference to Zamir and Woolf, *The Declaratory Judgment* (2nd ed. 1993), 168.

⁷⁶⁷ Cf. *Pitz, Forum blocking*, 25.

⁷⁶⁸ Cf. *Notes*, 1687.

II. High litigation costs

It can be problematic if the place of litigation chosen is very expensive. It is, for example, a well-known fact that large companies try to involve smaller enterprises in large cases to get rid of unwanted competition and basically force them into licensing agreements or even let them run into bankruptcy. As *Judge Laddie* held: "[it is a fact] that sometimes one party may want the costs to be large so as to drain or deter its opponent. In such cases, costs can become an instrument of war"⁷⁶⁹.

This issue was particularly apparent in the margins of so-called "patent trolls", which became a problem especially in the US. "Patent trolls" are patent holders (often financial investors who buy patents cheaply from bankrupt companies) who do not manufacture the patented product or supply the patented device but basically only use these rights to threaten companies with legal action.

In many legislations a party may also ask the court to impose on their opponent the requirement to post a bond for a large part of the costs which may be awarded against them. With this tool it is possible that large firms can prevent litigation from getting under way⁷⁷⁰. The revised UK Patents Act thus, for example, provides that the scope of proceedings be extended to infringements and declarations of non-infringement and groundless threats when the court is assessing the costs, where it must have regard to all relevant circumstances, including the financial position of the parties⁷⁷¹.

III. *Forum non conveniens* and anti-suit injunctions

1. *Forum non conveniens*

The *forum non conveniens* doctrine allows a court on its own motion to decline jurisdiction it might otherwise possess⁷⁷² because it thinks that it is seriously inconvenient⁷⁷³ or

⁷⁶⁹ *Merck & Co Inc and Generics (UK) Ltd*, 2003 EWHC 2842 (Pat), Case No. HC C02266. Patent licensing negotiations are also often conducted in the shadow of a looming threat of patent enforcement through legal procedure, cf. McCormack Brian, Threat in the shadows, The role of enforcement in licensing negotiations, April 2004 Patent World, 19-21.

⁷⁷⁰ Cf. Kingston William, Making Patents Useful to Small Firms, 2004 IPQ, 369-378, 371; also cf. *Bell, Forum Shopping*, N 2.03.

⁷⁷¹ Cf. revised Section 106 UK Patents Act and *Jones/Grabienski/Marriott/McCall*, 204.

⁷⁷² Cf. *Nygh/Pocar*, 88.

inappropriate⁷⁷⁴ and that another available court⁷⁷⁵ may be more convenient or clearly more appropriate to deal with the case⁷⁷⁶. To decide, it has to take into account private and public interest factors⁷⁷⁷ such as the potential conveniences of the parties⁷⁷⁸, the location and availability of evidence and the state of any related proceedings in other jurisdictions⁷⁷⁹.

The *forum non conveniens* doctrine therefore allows the taking of jurisdiction to be tailored on a case by case basis, having regard to concerns of sovereignty, appropriateness and convenience in an approach focussed essentially on the achievement of justice in the specific case rather than an abstract justice applicable to all cases⁷⁸⁰. It can therefore prevent extensive *forum shopping*⁷⁸¹.

This doctrine is well known in the Anglo-Saxon jurisdiction area⁷⁸² but it actually has its origins in the Scottish civilian system⁷⁸³.

The ECJ, however, clearly held in *Owusu v Jackson and others*⁷⁸⁴ that the *forum non conveniens* doctrine is not compatible with the Brussels Convention, even in relation to courts in non-EU member states⁷⁸⁵. In fact the states negotiating the Brussels Conventions already took the view, after some discussions on the subject matter, that there should be no exception on the basis of the *forum non conveniens* doctrine.

⁷⁷³ Cf. *Geimer*, N 1073.

⁷⁷⁴ Cf. *McClellan/Morris*, 117; *Fawcett/Torremans*, 268; *Bucher/Bonomi*, § 5, N 177.

⁷⁷⁵ Cf. *Fawcett/Torremans*, 268-269

⁷⁷⁶ Cf. *Blum C.*, 67-74; *Walter G.*, *Zivilprozessrecht*, 106; *Dasser*, 263.

⁷⁷⁷ Cf. *Geimer*, N 1073; *Blum C.*, 75.

⁷⁷⁸ Cf. *Bradley*, 579-580.

⁷⁷⁹ Cf. *Austin*, N 17.

⁷⁸⁰ See *Gardella/Radicati di Brozolo*, 621.

⁷⁸¹ Cf. *Fawcett/Torremans*, 267.

⁷⁸² Cf. *Bucher/Bonomi*, § 5, N 177; for the US doctrine cf. *Blumer, Jurisdiction*, 358-360; for the differences between the UK, Australia and the USA cf. Nygh Peter, *Forum Non Conveniens and Lis Alibi Pendens: the Australian Experience, Private law in the international arena – From national conflict rules towards harmonisation and unification*, Liber Amicorum Kurt Siehr, Basedow Jürgen/Meier Isaak/Schnyder Anton K./Einhorn Talia/Girsberger Daniel (eds.), Zürich et al. 2000, 511-526.

⁷⁸³ Cf. *Blum C.*, 39-46; *McClellan/Morris*, 117; *ILA, Leuven/London principles*, N 21.

⁷⁸⁴ Cf. *Owusu v Jackson and others*, ECJ March 1, 2005 (case C-281/02); cf. also Rauscher Thomas/Fehre Alexander, *Das Ende des forum non conveniens unter dem EuGVÜ und der Brüsseler I-VO?*, 2006 ZEuP, 459-475.

⁷⁸⁵ Cf. critical remarks of Fentiman Richard, *Civil jurisdiction and third states, Owusu and after*, 2006 CML Rev, 705-734 and *Tritton*, N 14-005 to N 14-006.

The main reason for this decision was that the right to choose between several courts - given deliberately to the plaintiff - should not be weakened by the application of the doctrine of *forum non conveniens*⁷⁸⁶. Furthermore, it is classed as a threat to the harmony of the system⁷⁸⁷.

However, in certain cases it could be as useful for a court - as representative of the state - as it is for the parties to choose whether it should decide on the case. It may not be apparent why parties should be able to choose a court - not least for sometimes questionable reasons - whereas the courts are obliged always to deal with a case and have no choice at all⁷⁸⁸.

It is important to note, however, that *forum non conveniens* may lead to some legal uncertainty in regard to the jurisdiction order and the choice of law. It has also been criticised as being applied in a discriminating manner, in that US courts decline jurisdiction in cases involving non-US parties whereas they have accepted jurisdiction in similar cases if the parties originated in the US⁷⁸⁹.

The fears of possible negative competence conflicts as expressed in some expert views⁷⁹⁰ are, however, hardly a ground for damning the doctrine, since it is a common view that the court may only decline jurisdiction on the basis of the *forum non conveniens* doctrine if the jurisdiction of another court is basically grounded⁷⁹¹.

The United Kingdom and Ireland accepted the civil law-based view that the *forum non conveniens* doctrine should be excluded in the Brussels and Lugano Conventions area⁷⁹², and this should not have changed with the transfer of the Brussels Convention to Regulation 44/2001. However, the doctrine still applies for courts of different parts of the United Kingdom or Ireland⁷⁹³.

⁷⁸⁶ Cf. *Schlosser, Report*, N 76 and N 78; *Bell, Negative*, 675, 691.

⁷⁸⁷ Cf. *Gardella/Radicati di Brozolo*, 621.

⁷⁸⁸ Also cf. §3 E.II. Possible solution to the problems related to cross-border *forum shopping* and, in particular, §3 E.II.2. Detailed check of a court's own jurisdiction.

⁷⁸⁹ Cf. *Geimer*, N 1092; *Walter G., Kampf*.

⁷⁹⁰ Cf. *Kropholler, Europäisches Zivilprozessrecht*, vor Art. 2, N 20; *Walter G., Fight*.

⁷⁹¹ Cf. *McClellan/Morris*; 119-122; *Fawcett/Torremans*, 268; *Bucher/Bonomi*, § 5, N 177; *Geimer*, N 1073.

⁷⁹² Cf. *Schlosser, Report*, N 78; *Kaye*, 81; N 109; *Cohen*, 380 and among others *Airbus Industrie GIE v Patel*, 1998 All E.R., 257.

⁷⁹³ Cf. *Kaye*, 81; *McClellan/Morris*, 124; *Fawcett/Torremans*, 186.

2. Anti-suit injunctions

Also classed as a probable motive for *forum shopping* are the so-called "anti-suit injunctions", another instrument from the Anglo-Saxon legal community.

This injunction is an order that forbids a party to file or pursue an action in another court⁷⁹⁴ if the court takes the view that it serves "the ends of justice"⁷⁹⁵. Anti-suit injunctions were actually introduced and used as a weapon of the different jurisdictional branches in the United Kingdom for their predominance⁷⁹⁶.

In order to render such an injunction in England, the courts require that the plaintiff proves that there is basically a sufficient connection with an English forum and that the foreign proceedings are vexatious or oppressive⁷⁹⁷.

It is doubtless a very powerful remedy available for dealing with a jurisdictional dispute⁷⁹⁸.

Continental courts and doctrines have declared this approach an indirect interference with the foreign court's exercise of its own jurisdiction⁷⁹⁹ and a possible threat to their sovereignty⁸⁰⁰. Some critics also take the view that this instrument puts legal certainty⁸⁰¹ and predictability⁸⁰² in jeopardy. Others are of the opinion that the lack of discretionary powers by the courts in that regard and the equal treatment of each court and guarantee of judicial sovereignty in the area of the states in which Regulation 44/2001 or the Lugano Convention is applicable does not allow such injunctions⁸⁰³. Furthermore, it is argued that

⁷⁹⁴ Cf. Hartley Trevor, *Antisuit Injunctions and the Brussels Jurisdiction and Judgment Convention*, 2000 ICQL, 166-171, 168; *Véron, Bruxelles*, 822; *ILA, Leuven/London principles*, N 23; *Halberstam*, 238; *Schmidt*, 493; also cf. *Mansel*, 336.

⁷⁹⁵ Cf. *Smith*, 805; *Dutta/Heinze*, 439.

⁷⁹⁶ Cf. *Siehr, Forum Shopping*, 136.

⁷⁹⁷ Cf. *Ho*, 704-706; *Tritton*, N 14-104; another ground for a court intervention could be that the defendant is acting unconscionably, that is to say that the applicant has an equitable right not to be sued in the foreign court which is somehow overlapping with "vexatious and oppressive" foreign proceedings, cf. *Ambrose*, 404.

⁷⁹⁸ Cf. *Ambrose*, 401.

⁷⁹⁹ Cf. *ILA, Leuven/London principles*, N 23; *Mansel*, 336-337; *Mäder*, 140.

⁸⁰⁰ Cf. *Mansel*, 336 with reference to the decision of the "Oberlandesgericht" of Düsseldorf of January 10, 1996, *EuZW* 1996, 351-352; cf. also *Ho*, 701-702; *Ambrose*, 408, *Wadlow*, N 8-70.

⁸⁰¹ Cf. Schroeder Hans-Patrick, *Anti-suit injunctions unvereinbar mit dem EuGVÜ*, 2004 *EuZW*, 468-471, 471; Krause Jan, *Turner/Grovit - Der EuGH erklärt Prozessführungsverbote für unvereinbar mit dem EuGVÜ*, 2004 *RIW*, 533-541, 535; Thiele Christian, *Antisuit injunctions und europäische Gemeinschaft*, 2002 *IPRax*, 383-386, 386.

⁸⁰² Cf. *Dutta/Heinze*, 458.

⁸⁰³ Cf. *Mansel*, 337; *Kropholler, Europäisches Zivilprozessrecht*, Art. 27, N 20; *Wadlow*, N 8-69.

such an order infringes Article 6 ECHR and the right of access to a court⁸⁰⁴. All this would lead to these injunctions not being enforceable in the area in which Regulation 44/2001 or the Lugano Convention is applicable⁸⁰⁵.

A counterargument mentioned is that anti-suit injunctions enjoin the litigant *in personam*⁸⁰⁶ - not the court, as the term indicates - and that it is not a case of dictating to a foreign court⁸⁰⁷, leading to an infringement of international law and another state's sovereignty⁸⁰⁸.

Some sympathy can indeed be found for these kinds of injunctions. It is, for example, a fact that the enforcement court in a state - in which Regulation 44/2001 or the Lugano Convention is applicable - would also have to accept that a court - in which the same instruments are applicable - regards itself as properly seised, although the defendant could be of a differing opinion. This follows from Article 35(2) Regulation 44/2001, i.e. Article 28(4) Lugano Convention, which provides that the court or authority "*shall be bound by the findings of facts on which the court of origin based its jurisdiction*".

The enforcement court would basically have to recognize the judgment even if it held a different opinion of the jurisdiction taken by the court rendering the judgment⁸⁰⁹. Basically the only possibility of interfering would be if recognition was against public policy⁸¹⁰, as was in fact also argued with regard to the order of anti-suit injunctions⁸¹¹. This hurdle is very high, however.

Consequently, the only difference from an anti-suit injunction in that case is that it is not directly spoken out by the court rendering the judgment to be recognised. The "indirect"

⁸⁰⁴ Cf. *Briggs*, n. 17.

⁸⁰⁵ Cf. *Tritton*, N 14-104; *Karet, Suit, Mäder*, 140.

⁸⁰⁶ Cf. *Ho*, 701; *Wadlow*, N 8-50.

⁸⁰⁷ Cf. *McClellan/Morris*, 128 with reference *inter alia* to *Love v Baker* (1665); *Karet, Suit*, 80; *Wadlow*, N 8-74; *Gardella/Radicati di Brozolo*, 624; cf. also the assault of Judge Hobhouse in *Turner v Grovit and others*, 2002 All. E.R., 960 where he is suggesting that the order was directed at the court rather than at the respondent, cf. in that regard also *Briggs*, 438; *Ho*, 702; *Ambrose*, 407.

⁸⁰⁸ Cf. *Smith*, 805.

⁸⁰⁹ Cf. *Overseas Union Insurance Ltd. and others v New Hampshire Insurance company*, ECJ June 27, 1991 (case C-351/89).

⁸¹⁰ Cf. §3 C.VI.2. Policy-making by applying law taking effect abroad and the problem of recognition.

⁸¹¹ Cf. *Mäder*, 141; *Mansel*, 337.

interference of anti-suit injunctions with the foreign proceedings becomes direct interference by way of interpreting a jurisdiction provision⁸¹².

The ECJ made clear in *Turner v Grovit and others*⁸¹³ that the Brussels Convention is to be interpreted as precluding the grant of anti-suit injunctions even where the defendant is acting in bad faith with a view to frustrating the existing proceedings⁸¹⁴. It concluded that the Brussels Convention would be necessarily based on the trust which contracting states accord to one another's legal systems and judicial institutions. A prohibition imposed by a court, backed by a penalty, restraining a party from commencing or continuing proceedings before a foreign court would undermine the latter court's jurisdiction to determine the dispute and would therefore have to be seen as constituting interference with the jurisdiction of the foreign court which, as such, would be incompatible with the system of the Convention⁸¹⁵.

Hartley rightly wondered whether this strict interpretation would still follow the primary purpose of transnational litigation to do justice between the parties or to rather ensure good relations between nations and constitutive elements of a federation⁸¹⁶.

In any case, anti-suit injunctions should no longer be a reason for *forum shopping* in Europe with regard to litigation concerning European patents.

Before the ECJ's judgment, anti-suit injunctions were already unsuccessfully tried in, for example, Germany⁸¹⁷, France⁸¹⁸ or the Netherlands⁸¹⁹. It is interesting that they were also requested in the United Kingdom by English companies "threatened" with a *kort geding* procedure in the Netherlands. However, in this case they were unsuccessful even in the

⁸¹² Cf. in that regard also *Wadlow*, N 8-74 to N 8-76.

⁸¹³ *Turner v Grovit and others*, ECJ April 27, 2004 (case C-159/02).

⁸¹⁴ It was expected that the ECJ could accept anti-suit injunctions within the narrow ground that it is legitimate for a court to restrain the pursuit of foreign proceedings where this amounts to an abuse of its own process, cf. *Ambrose*, 416-418. It, however, declared that any kind of *anti-suit injunction* is an interference with a foreign court's jurisdiction, which is contrary to the convention's inherent principle of mutual trust.

⁸¹⁵ Cf. also *Ambrose*, 409.

⁸¹⁶ Cf. *Hartley, Abuse*, 81.

⁸¹⁷ Cf. *Grabinski, Bedeutung*, 211.

⁸¹⁸ Cf. *Véron, Bruxelles*, 823.

⁸¹⁹ Cf. *Willems, Report*, 877.

United Kingdom, though common law courts generally reacted by granting such injunctions to prevent perceived *forum shopping*⁸²⁰.

IV. Inefficiency

Critics of *forum shopping* also claim that it is inefficient because it tends to result in litigation far from the "natural" forum⁸²¹, that is to say away from the domicile of the defendant, and that resources are expended on patent litigation, instead of meaningful inventive activity to design around the patent⁸²². It creates unnecessary expenses as litigants pursue the most favourable, rather than the simplest or closest, *forum*.

In regard to European patent litigation this seems only partly to be true, but it is a fact that most cases are dealt with before German courts and in many cases the jurisdiction is either based on the place of tort or the place of branch or agency.

There is no denying the fact that a certain amount of inefficiency is evident if both parties have to travel a long way and prepare a case before a foreign court. However, this can be outweighed by courts that provide for an active case management and that are faster and cheaper and hand down better judgments.

In addition, it seems clear that bringing the same or related actions in several jurisdictions simultaneously may lead to wasted time, money and judicial resources in at least one of the competing *fora*⁸²³.

V. Inconsistency of choice of law rules and the problem of applying law taking effect abroad

1. The situation in Europe concerning choice of law rules

As mentioned earlier, an important reason for executing *forum shopping* is the applicable law in a case, as it may determine the result of the proceedings⁸²⁴.

⁸²⁰ Cf. *Ho*, 698-699; *ILA, Leuven/London principles*, N 23.

⁸²¹ Cf. *Notes*, 1691; *Ferrari*, 374.

⁸²² Cf. *Haas P.*, 198.

⁸²³ Cf. *Lupoi*, 149-150.

If the claim is brought before a court in the state where the patent infringement is committed, it is normally the law of the state within whose territory the protection is claimed that is applicable⁸²⁵.

More unclear is the situation where a court has to decide upon a foreign right - for example a foreign patent right or a foreign part of a European patent⁸²⁶ - as the existing international conventions leave that question open⁸²⁷. Currently, there are no exclusive choice of law rules in place for infringement proceedings⁸²⁸.

This will change, however, at the beginning of 2009 when the courts of the EU member states will have to apply the EC Regulation on the law applicable to non-contractual obligations (Rome II Regulation)⁸²⁹. Until that time it will thus be the national legislature or the court which decides the most appropriate applicable law⁸³⁰.

In patent infringement cases, it is typically either the law for whose territory the right has been granted that is applicable (*lex loci protectionis*) or the law where the tort occurred (*lex loci delicti*)⁸³¹, or even the law of the court having jurisdiction (*lex fori*).

Some EPC contracting states provide for the option of choosing the law most favourable to the defendant⁸³². However, it could also be that the *lex fori* is applied to the issue of damages⁸³³, whereas the *lex loci delicti* is applied to the issue of whether or not an injunction should be granted⁸³⁴.

⁸²⁴ Cf. *Walter G., Kampf, O'Sullivan*, 660; *Vivant*, 28; *Brinkhof, Zu weit?*, 494; *Bertrams*, 634.

⁸²⁵ Cf. *Ulmer*, N 16.

⁸²⁶ Also cf. §3 C.VI. Undermining the authority of a state.

⁸²⁷ Art. 64(3) EPC, for example, only stipulates that any infringement of a European patent shall be dealt with by national law.

⁸²⁸ Cf. *Pertegás-Sender, Enforcement*, N 5.87; *O'Sullivan*, 660.

⁸²⁹ Art. 32 Rome II Regulation.

⁸³⁰ Cf. *Arnold, Cross-Border*, 399; *Tilmann, Gemeinschaftszivilrecht*, 804; but cf. already *Ulmer*, N 16.

⁸³¹ Cf. *Ulmer*, N 18; *Troller, IGR I*, 135; *Vischer, Patent*, 364; *v. Meibom/Pitz, Cross-Border Injunctions*, 472; *Lipstein*, 298; *Hamburg Group*, 21; *Bär*, 126; *Pertegás-Sender, Enforcement*, N 5.21 to N 5.24.

⁸³² Cf. also Rome II proposal, 11.

⁸³³ Cf. *Remien, European*, 65.

⁸³⁴ Cf. *O'Sullivan*, 660.

Sometimes courts even apply their own law because the foreign law consists of regulations that do not exist in the state where the court is located⁸³⁵. Others decline jurisdiction on the basis of the *forum non conveniens* doctrine, since they think that only a court in the country whose law is the governing law can be the appropriate place to litigate on grounds of practicality - and possibly justice⁸³⁶. As mentioned earlier, this should no longer be possible in the EU after the ECJ's decision in *Owusu v Jackson and others*⁸³⁷.

The decisions of the different courts on the applicable law are therefore more or less predictable, but again may vary from court to court or state to state. The entry into force of the Rome II Regulation will consequently provide for greater legal certainty.

In regard to the applicable substantive law concerning the infringement of a patent, the majority of European states opted – on the basis of the principle of territoriality - for a *lex loci protectionis* approach⁸³⁸.

This is also the approach the European Union chose in the Rome II Regulation, and it is also not least generally shared by experts⁸³⁹: Article 8(1) Rome II Regulation provides that the law applicable to a non-contractual obligation arising from an infringement of an intellectual property right shall be the law of the country for which protection is claimed.

The *lex loci protectionis* will consequently extend to all non-contractual obligations arising from an infringement of an intellectual property right, although it is unclear whether the national treatment clause of the WIPO Conventions and of the TRIPs Agreement rule in favour of the law of the country for which protection is claimed⁸⁴⁰.

⁸³⁵ The Düsseldorf District Court applied German law in assessing damages on the basis that the application of English law would involve discovery proceedings not available in Germany (cf. *Landgericht Düsseldorf*, January 16, 1996, docket 405/95; *O'Sullivan*, 664); also cf. *Mousseron/Raynard/Véron*, 905-906.

⁸³⁶ Cf. *Fentiman*, *Foreign law*, 275.

⁸³⁷ Cf. §3 C.III.1. *Forum non conveniens*.

⁸³⁸ Cf. *Pertegás-Sender*, *Enforcement*, N 5.91; N 5.109.

⁸³⁹ Cf. *MPI Proposal*, 322; *ALI, IP jurisdiction project*, § 301(1)(a); *Drexl*, 156-158; cf. also *Fentiman*, *Choice of law*, 148; Leible Stefan/Lehmann Matthias, Die neue EG-Verordnung über das auf ausservertragliche Schuldverhältnisse anzuwendende Recht ("Rom II"), 2007 RIW, 721-725, 731 and Wagner Gerhard, Die neue Rom II-Verordnung, 2008 IPRax, 1-17, 9-10.

⁸⁴⁰ Cf. *Drexl*, 156.

It will also not be possible to derogate from the applicable law by a party agreement (Article 8(1) Rome II Regulation). The parties will consequently not be able to choose a different law with regard to the determination of damages.

The explanatory rules to the proposal for the Rome II Regulation hold that such a greater freedom of will would not be appropriate with regard to intellectual property⁸⁴¹. However, it could have been useful to provide the parties with such a right to choose.

Swiss private international law, for example, provides that the parties could always agree, after the infringement of the IPR occurred, that the *lex fori* applies with regard to the determination of damages⁸⁴².

It is difficult to understand why such freedom of choice with regard to patent infringements would be less appropriate than in any other tort. In addition to this, the principle of territoriality is secondary due to the fact that patents are, to a great extent, based on uniform law.

From a legal perspective, it seems to be a common view that the question of the applicable law with a view to claims on the infringement of a patent has to be separated from the same question with regard to the claims that follow from this infringement.

The majority of experts and courts agree that the decision as to the applicable law is based on the *causa* and not on the relationship to the state that granted the patent⁸⁴³. A court having jurisdiction could consequently also apply and rule on a foreign part of a European patent or foreign (patent) law⁸⁴⁴, and on damages based on a different applicable law.

The importance of this issue will decline, however, as the rules on damages have in the meantime been harmonised to a certain extent by the Enforcement Directive⁸⁴⁵.

⁸⁴¹ Cf. Rome II proposal, 22.

⁸⁴² Art. 110(2) Swiss private international law act.

⁸⁴³ Cf. *Troller*, *IGR I*, 138; *Ulmer*, N 18.

⁸⁴⁴ Cf. however, *Lipstein*.

⁸⁴⁵ Cf. §3 B.VI. Damages.

The second paragraph of Article 8 Rome II Regulation makes it clear that in the case of an infringement of a future Community patent, the law applicable would be, for any question that is not governed by the Community Patent Regulation, the law of the country in which the act of infringement was committed. Cases where national law would be applicable should, however, be very limited.

2. Applying law taking effect in another state

The consequence of the *lex loci protectionis* approach is that courts apply patent law and case law⁸⁴⁶ which take effect in a state where the potentially infringed patent takes effect. In any case, it is not an easy task to understand and apply foreign substantive law and practice⁸⁴⁷, depending upon economic and social policies.

Usually⁸⁴⁸, foreign law is regarded as fact⁸⁴⁹, and it is up to the party declaring it to prove this law⁸⁵⁰ and to explain it to the court⁸⁵¹, including the reproduction of the typical legal reasoning employed in the country of the law in question⁸⁵². In the end, however, it will be up to the court to finally ascertain and apply it⁸⁵³ or apply its own law if it cannot explore the foreign law⁸⁵⁴.

There is a certain risk that this will be done in an incorrect and inappropriate way. Consequently, it seems surprising that in many European states, such as France, Germany, the Netherlands⁸⁵⁵ or Switzerland⁸⁵⁶, it is not possible - or only possible to a limited extent - to appeal the case if the decision is based on foreign law. It was suggested, therefore, that a new kind of preliminary reference procedure be implemented

⁸⁴⁶ Cf. Hölder, *Grenzüberschreitende*, 90-91.

⁸⁴⁷ Cf. Vischer, *IPR*, 672; cf. however, *Pertegas-Sender, Enforcement*, N 2.31 to N 2.32.

⁸⁴⁸ Cf. An important exception is Germany, where even foreign law seems to be treated as a question of law and not of fact (cf. Adolphsen, *Europäisches*, N 255; Trautmann, 284-286; Hartley, *Pleading*, 273). However, the distinction seems to be of only limited practical importance (Hartley, *Pleading*, 272).

⁸⁴⁹ Very instructive Hartley, *Pleading*; cf. also Bell, *Forum Shopping*, N 2.46 to N 2.47.

⁸⁵⁰ Cf. O'Sullivan, 662; O'Brien John, *The Proof of Foreign Law, Conflict of Laws*, 2nd edition, London et al. 1999, 146-149; Vischer, *IPR*, 672; Trautmann, 300.

⁸⁵¹ Cf. Chisum, 614; also cf. Jandoli, 792.

⁸⁵² Cf. Fentiman, *Foreign law*, 279.

⁸⁵³ Cf. König, *Probleme*, 299; Fauvarque-Cosson, 129, 130; Heldrich, 244; Fentiman, *Foreign law*, 277; Adolphsen, *Europäisches*, N 256; N 261.

⁸⁵⁴ Cf. Fauvarque-Cosson, 129; König, *Probleme*, 300.

⁸⁵⁵ Cf. Flessner Axel, *Diskriminierung von grenzübergreifenden Rechtsverhältnissen im europäischen Zivilprozess*, 2006 ZEuP, 737-741, 738.

⁸⁵⁶ Article 96 Federal Supreme Court Act (*Bundesgerichtsgesetz*).

where the court seised with the case asks an equivalent court of the state whose law governs the case for the content of the law⁸⁵⁷.

With regard to the application of foreign substantive patent law where a patent infringement is concerned, two cases should be distinguished:

- First, there is the possibility of an infringement of one or several national patents based on law which does not correspond with the EPC, for example a Chinese, Japanese or US patent.

Due to the *lex loci protectionis* approach it could be the case that a court has to decide on the scope of all the claims in each patent the patent owner alleges is being infringed, in order to decide the issue of infringement⁸⁵⁸. The court will consequently have to take into account all of the different principles of interpretation, as well as the particularities of procedural and evidence law in each of the countries within the protected territory⁸⁵⁹ in order to decide the scope of sometimes more than 250 claims. This is even more difficult as, in each case, the scope of the claims will have to be construed in the light of the technical content of the relevant patent specifications, taking into account the description and any drawings⁸⁶⁰, all of which may be different and which would often depend on obtaining expert opinions⁸⁶¹ in a variety of languages.

The task is not much easier if the *lex fori* has to be applied as procedural law and, for example, common law tradition collides with continental civil law culture⁸⁶², or *vice versa*. Whereas the common law approach is more practice-driven, the civilian approach is rather theory-driven⁸⁶³.

⁸⁵⁷ Cf. *Remien, European*, 78-79.

⁸⁵⁸ See Laddie Hugh, *The Interaction between The Hague Convention and patent rights*, *International Intellectual Property Law & Policy*, Vol. 7, Chapter 93, Hansen Hugh (ed.), Fordham University School of Law, 2002, N 9.

⁸⁵⁹ Cf. *Hoffmann-La Roche AG v Organion Technika B.V. and others*, *Gerechtshof Den Haag* (Court of Appeals of The Hague), September 12, 1996, 1997 *Mitt.* 34.

⁸⁶⁰ Cf. *Stauder, Verletzungsverbote*, 320.

⁸⁶¹ Cf. also *Heldrich*, 247-252.

⁸⁶² Cf. *Klink*, 494; cf. also *Kerameus*, 183-184, with regard to the different treatment of facts in civil and common law proceedings.

⁸⁶³ Cf. *Hartley, Conflict of laws*, 814.

Nevertheless, there are many courts that have been applying foreign law on grounds of *lex loci protectionis* routinely in cross-border infringement cases⁸⁶⁴, a situation which was simply inconceivable not so long ago as it seemed out of the question that judges would apply foreign patent law properly⁸⁶⁵, fairly and effectively⁸⁶⁶.

- Second, there is the case of a European patent which has to be judged by a court.

The above-mentioned process of applying "foreign" patent law is the same where several parts of a European patent are involved. The only difference is that, to a great extent, uniform law will be applied. It will consequently be sufficient to determine the scope of one part of the European patent if the claims have not been changed in the meantime. The court will therefore basically do the same job as if it only had to decide about the part of the European patent taking effect in the state where it is located.

Nevertheless, it will remain a challenging task, as the judge will have to take into account all the relevant national practices relative to the matter at issue with regard to the different parts to be examined, in order to establish a European-spirited interpretation⁸⁶⁷. However, it should become easier, the more a common interpretation is developed by the different authorities applying European patent law. What should be clear is that it would not be correct if the court simply applied national case law and practice with regard to European patent law to all parts of the European patent⁸⁶⁸.

Everything that would go beyond the interpretation of European patent law based on the *lex loci protectionis*, such as possibly the law on damages, would, however, again make it necessary for different national law - applicable in the relevant parts of the European patent - to be construed and applied.

The fact that courts have applied foreign law or even uniform European patent law by deciding about foreign patents or parts of a European patent is partly criticised, as it may

⁸⁶⁴ Cf. *Wadlow*, N 1-21. Cf. also *Pertegás-Sender, Enforcement*, N 2.30.

⁸⁶⁵ Cf. *Blum/Pedrazzini*, Art. 75, N 6.

⁸⁶⁶ Cf. also *Fentiman, Foreign law*, 276.

⁸⁶⁷ Cf. *Hölder, Grenzüberschreitende*, 138.

⁸⁶⁸ Cf. *Stauder, Verletzungsverbote*, 320; *Grabinski, Determination*, 874.

undermine the authority of a state that was actually granting the right in question⁸⁶⁹, or that was transferring this competence to an international organisation, such as the European Patent Organisation.

VI. Undermining the authority of a state

The problem of the applicable law is directly connected to the question of the territoriality of patent law⁸⁷⁰ and, as mentioned above, indirectly to the question of interference in state authority⁸⁷¹. On the basis of a strict territorial view of IPRs grounded on the system of privileges⁸⁷² - exclusive rights, and especially patent rights, court-ordered injunctions with effect abroad were classed as interference in national sovereignty⁸⁷³, legal tradition⁸⁷⁴ and international law⁸⁷⁵.

Aside from these rather political reasons⁸⁷⁶ the opinion, from a substantive point of view, meanwhile prevailing in Europe⁸⁷⁷ seems to be that the principle of territoriality⁸⁷⁸ only affects the question of the limits of substantive patent law and not the question of the place

⁸⁶⁹ Cf. also the doctrine of "Act of state" which precludes courts from sitting in judgment on the acts of government of another (cf. *Duke of Brunswick v King of Hanover* (1848) 2 H.L. Cas., 1).

⁸⁷⁰ Cf. Art 4bis Paris Convention; in regard to the territoriality of patent law in general cf. *Troller, IGR I*, 134-139; Stauder Dieter, *Patentverletzung im grenzüberschreitenden Wirtschaftsverkehr*, Max-Planck-Institut für ausländisches und internationales Patent-, Urheber- und Wettbewerbsrecht, Schriftenreihe zum gewerblichen Rechtsschutz, Band 32, Köln et al. 1975, 6-44; *Perret, Territorialité*, 125-126; *Hamburg Group*, 21-23; *Geller, Bradley, Chisum; D'Amato/Long*, 373-374.

⁸⁷¹ Cf. *Austin*, N 30-35; *Vischer, Patent*, 367; *Berman*, 317; *Fentiman, Choice of law*, 142.

⁸⁷² The privileges were classed as an act of state based on public law, which could not be applied by a foreign judge, cf. *Troller, IGR I*, 16-24; *Bär*, 137; from today's perspective IPRs are rights to stop others from engaging in certain acts (cf. *Cornish/Llewelyn, IP*, N 1-04). They are based on legislation and basically do not differ from the other absolute private laws (cf. *Vischer, IPR*, 672); cf., however, *Lipstein*.

⁸⁷³ Cf. *Stauder, Cross-Border*, 497-498; *Bertrams*, 623; *Neuhaus*, 259; *Baeumer*, 807; *Stauder/Kur*, 152.

⁸⁷⁴ Cf. *Ebbink, Pan-European*, 25.

⁸⁷⁵ Cf. *Brinkhof, Measures*, 361.

⁸⁷⁶ Cf. *Vischer, Patent*, 367; *Cornish/Llewelyn, IP*, N 1-30; *Baeumer*, 807.

⁸⁷⁷ For the US cf. the highly illustrative case *VODA v Cordis Corp.*, (Fed. Cir., No. 05-1238) and the dissenting opinion of Judge Newman where it was decided that a district court cannot exercise jurisdiction over foreign patent claims. The decision was not least based on the principle that the US should avoid an unreasonable interference with the sovereign authority of other nations and that jurisdiction over foreign patents could disrupt foreign procedures.

⁸⁷⁸ The "principle of territoriality" states that there is protection in the state for which the protection has been granted. A "foreign" patent is therefore not recognised and does not have the same protection effects as a "domestic" patent.

The definition that a patent may only be effective in or for the state where the patent was granted is inexact, since the right to prevent somebody from using a patented invention in the state where the patent is effective also binds people living outside that state (cf. *Blum Rudolf E./Pedrazzini Mario M.*, *Das schweizerische Patentrecht*, Band I, 2. Auflage, Bern 1975, Art. I, N 54; *Troller, IGR I*, 134-139).

where the claims, or the infringement, may be decided⁸⁷⁹. A possible interference in national sovereignty⁸⁸⁰ therefore mainly depends on the jurisdiction of the foreign court, the applicable law and the recognition of the judgment based on that jurisdiction and law.

Whereas the choice of law rules still differ in Europe, as mentioned above, the state - possibly the place of the court - with the authority to judge a case in Europe is, to a great extent, exclusively determined by Regulation 44/2001 and the Lugano Convention⁸⁸¹. The court having jurisdiction based on Article 2 Reg 44/LC, that is to say at the domicile of the defendant, is typically dealing with an infringement concerning several patents or a European patent taking effect in several states and hence often applying different laws and legal views⁸⁸² - so-called "cross-border litigation"⁸⁸³.

The courts in the United Kingdom stayed outside these developments and have consistently refused to decide on infringements of IPRs occurring abroad⁸⁸⁴, not least for the above-mentioned political reasons⁸⁸⁵ and possibly also with the expectation that foreign courts would refrain from interfering with their own policy⁸⁸⁶.

However, whereas German and French courts were open to this movement⁸⁸⁷, the Dutch courts followed a very liberal approach⁸⁸⁸.

⁸⁷⁹ Cf. *Vischer, IPR*, 672; *Neuhaus*, 261; *Stauder, Cross-Border*, 498; *Mousseron/Raynard/Véron*, 888-890; cf. however, *Lipstein*.

⁸⁸⁰ Cf. *D'Amato/Long*, 376.

⁸⁸¹ Cf. *Perret, Territorialité*, 125.

⁸⁸² Cf. *Jansen/Michaels* extensively concerning the interpretation of foreign law; also cf. *König, Probleme*, 300.

⁸⁸³ Cf. *Bukow*, 59.

⁸⁸⁴ Cf. *Cornish*, 287-289 and e.g. *Molnlycke AB v Proctor & Gamble*, 1992 WLR 1112, 1117-1118; it follows logically that English courts also remained reluctant to render anti-suit injunctions in cases where the necessary connection with England had not been established, cf. *Ho*, 704, 720. Nevertheless, it is in dispute whether the British courts are more open vis-à-vis cross-border jurisdiction over an infringement in respect of an unregistered IP right, cf. *Arnolds, Cross-Border*, 415; Joseph Paul, *The rise and fall of cross-border jurisdiction and remedies in IP disputes*, 2006 *JIPL*, 850-857, 852.

⁸⁸⁵ Cf. also *Véron, Bruxelles*, 818; but also *Laddie, de Ranitz*, 530 and *Fentiman, Foreign law*, 286.

⁸⁸⁶ Judges in the UK were critical of the idea that a Dutch court should grant an injunction in relation to the UK, cf. *Fawcett/Torremans*, 221, 227.

⁸⁸⁷ Cf. *Guidicelli*, 66-76; *v.Meibom/Pitz, Limitations*, 593; *Ebbink, Pan-European*, 25; *v. Rospatt P.; Grabinski, Determination*, 855-856; *Perret, Territorialité*, 129-130; *Véron, Bruxelles*, 829.

⁸⁸⁸ Cf. *v.Meibom/Pitz, Limitations*, 593.

1. Cross-border injunctions

In the Netherlands in the late 1980s, everything slowly started off with a trade mark case⁸⁸⁹. The Dutch Supreme Court upheld the interlocutory decision to apply an injunction to all Benelux territories in the case of infringement of a Benelux trademark in all three states⁸⁹⁰.

After that judgment, cross-border injunctions were also handed down more and more in patent cases⁸⁹¹. The exercise of jurisdiction over actions concerning foreign patents⁸⁹² - that is to say especially on foreign parts of a European patent⁸⁹³ - was thenceforth put into practice. Dutch courts imposed extraterritorial injunctions based on Articles 2, 5(3), 6(1) and 24 Brussels and Lugano Conventions.

The reason for that lay in the fact that patent disputes were increasingly considered in a global market⁸⁹⁴ and context⁸⁹⁵ because of the rapid expansion of international trade supported by respective agreements⁸⁹⁶. Consequently, there was an increase in the demand for concentrated jurisdiction in cases of international patent infringement. However, the Dutch courts also wanted to avoid controversial decisions regarding the infringement of a European patent in different states⁸⁹⁷, thus providing a more effective patent protection in Europe⁸⁹⁸.

They were correctly of the opinion that it was much more efficient and less costly⁸⁹⁹ to have one judge exercise jurisdiction in regard to the infringement of a European patent granted not only for the Netherlands but also for other European and non-European countries.

⁸⁸⁹ Cf. *Bertrams*, 619; *Grabinski, Bedeutung*, 199; *Franzosi/De Sanctis*, 80; *König, Probleme*, 306.

⁸⁹⁰ *Interlas v Lincoln, Hoge Raad* (Supreme Court), November 24, 1989, 1992 NJ, 404; also cf. *de Wit*, 228.

⁸⁹¹ Cf. *Bertrams*, 620-623; *de Wit*, 229; *Franzosi/De Sanctis*, 78; *Brinkhof, de Ranitz*, 142; *v. Engelen*, 24.

⁸⁹² See *Lundstedt*, 127.

⁸⁹³ Cf. *O'Sullivan*, 654.

⁸⁹⁴ Cf. Kur Annette, *A New Framework for Intellectual Property Rights – Horizontal Issues*, 2004 IIC, 1-12, 7.

⁸⁹⁵ Cf. *Peberdy*, 22; *Bertrams*, 632.

⁸⁹⁶ Cf. *Franzosi/De Sanctis*, 69-70; 73-74; *Boval, Remarques*, 157; *Mousseron/Raynard/Véron*, 884.

⁸⁹⁷ Cf. *Brinkhof, Measures*, 360; *Ebbink, Pan-European*, 24.

⁸⁹⁸ Cf. *Ebbink, Fire-Side*, 257.

⁸⁹⁹ Cf. *Brinkhof, Zu weit?*, 496; *de Wit*, 225; *Mäder*, 128.

This approach severely diminished the principle of territoriality⁹⁰⁰, although it is also a logical consequence due to the fact that European patent law has to be construed uniformly. Before that change in practice, cross-border injunctions were not of that great importance⁹⁰¹, although it became clear that the entry into force of the Brussels and Lugano Conventions changed the way European patents are litigated⁹⁰².

The Dutch practical offensive did not, however, proceed without criticism⁹⁰³, not least because it again provoked *forum shopping*⁹⁰⁴ as other courts in other states remained hesitant.

a) Cross-border injunctions based on Article 5(3) Reg 44/LC

Dutch courts partly rendered cross-border judgments (also in *kort geding*) based on their jurisdiction within Article 5(3) Brussels and Lugano Conventions⁹⁰⁵; that is to say judgments on foreign patents and foreign parts of a European patent based on the jurisdiction of the *locus delicti*⁹⁰⁶.

This was criticized as being contradictory to the ECJ's view on a restrictive application of any special jurisdiction forum⁹⁰⁷. It was argued that the basic principle of *forum rei* also required the judge deciding on any other jurisdictional grounds to use his powers with the appropriate restrictiveness. Therefore, the judge of the *forum delicti* is only permitted to issue a decision simply with respect to actions that have taken place within his state territory⁹⁰⁸. This argument was supported by the corresponding regulation of Article 17(2) CP Protocol on Litigation.

⁹⁰⁰ Cf. *Franzosi/De Sanctis*, 69; *Jandoli*, 783.

⁹⁰¹ Cf. *Brinkhof, Measures*, 360; *Grabinski, Bedeutung*, 199.

⁹⁰² Cf. *Lundstedt*, 124; with great farsightedness already in 1976 *Stauder, Anwendung*.

⁹⁰³ Cf. *Gauci*, 361; *Ebbink, Pan-European*, 24.

⁹⁰⁴ Cf. *Brinkhof, Zu weit?*, 496; *Bertrams*, 634; Hoyng Willem in: *Michalland*, 10; *Ebbink, Pan-European*, 27; *v. Engelen*, 24; *Mousseron/Raynard/Véron*, n. 54; *Brinkhof, de Ranitz*, 143; *Tilmann/v. Falck*, 584; *Ryberg*, 912.

⁹⁰⁵ Cf. *Evans Medical Limited v Chiron Corporation et al.* (reported by *v. Nispen, Litigation*, N 7-26).

⁹⁰⁶ Cf. *de Wit*, 226.

⁹⁰⁷ *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst & Co.*, ECJ September 29, 1988 (case 189/87).

⁹⁰⁸ Cf. *Bertrams*, 625; cf. also *O'Sullivan*, 656.

This view may in fact lead to a situation where the alleged infringer possibly has to defend himself under a multitude of legal systems, including a high risk of unpredictable outcomes⁹⁰⁹.

Nevertheless, it seems that the ECJ indirectly followed this view⁹¹⁰ and rendered its famous decision *Shevill and others v Presse Alliance*⁹¹¹, in which it basically made clear that courts having jurisdiction based on Article 5(3) Brussels and Lugano Conventions solely have jurisdiction to rule in respect of the damage caused in the state of the court seised.

The doctrine almost unanimously took the view that this decision of the ECJ was applicable to all prohibitory injunctions, and not only to the question of damages⁹¹². This has been codified when transferring the Brussels Convention to Regulation 44/2001⁹¹³.

The Court of Appeals of The Hague also argued that the application of Article 5(3) Brussels and Lugano Conventions is only justified in the case of a close connection between the place where the damaging act has occurred and the court of that place. A requested declaration of non-infringement of a European patent, not only with regard to the Dutch part but also with regard to the other countries designated in the European patent, could therefore not be granted on the basis of Article 5(3) Reg 44/LC⁹¹⁴. Cross-border injunctions would thus be excluded⁹¹⁵.

The basic rationale behind this ruling is to avoid *forum shopping* and the basic respect of the *forum rei*⁹¹⁶. The principle of territoriality with regard to IPRs, therefore, seems to be no reason for this ruling⁹¹⁷. Consequently, the jurisdiction of the court at the place of tort

⁹⁰⁹ Cf. also *Hess/Pfeiffer/Schlösser*, N 214.

⁹¹⁰ Cf. *Brinkhof, Zu weit?*, 491.

⁹¹¹ *Shevill and others v Presse Alliance*, ECJ March 7, 1995 (Rec. 1995, PI-415; case C-68/93).

⁹¹² Cf. *Schlösser, EU-Zivilprozessrecht*, Art. 5 EuGVVO, N 16; *Lundstedt*, 145-148; *Brinkhof, Zu weit?*, 491; *Stauder, Verletzungsverbote*, 321; *v. Engelen*, 26; *Véron, Bruxelles*, 820; Kühnen Tomas in: *Schulte*, §139, N 184; *Pertegás-Sender, Enforcement*, N 3.79 to N 3.81; *Mäder*, 122.

⁹¹³ Art. 5(3) Regulation 44/2001 provides that a person domiciled in an EU member state may, in another EU member state, be sued in matters relating to tort, delict or quasi-delict, in the courts for the place where the harmful event occurred or may occur. See also *Walter G., Zivilprozessrecht*, 203.

⁹¹⁴ Cf. *v. Nispen, Litigation*, N 7-26.

⁹¹⁵ Cf. also *Tilmann/v. Falck*, 582 with reference to *Evans v Chiron*; Cf. *Brinkhof, Zu weit?*, 496; *Stieger, Unklares*, 68; *Blumer, Patentverletzung*, N 17.26.

⁹¹⁶ Cf. §3 D. Forum shopping and the ECJ.

⁹¹⁷ Cf. however, *Mäder*, 118.

may not extend beyond the borders of the country and cover all infringements in cases of cross-border patent infringement based on a single act⁹¹⁸. This certainly only applies if the place of tort is not also the place of domicile of the defendant. The court would consequently not have to apply foreign patent law.

This view is underlined by the decision *Marinari v Lloyds Bank and Another*⁹¹⁹, in which the ECJ held that the choice available to the plaintiff cannot be extended beyond the particular circumstances which justify it, since otherwise the general principle laid down in the first paragraph of Article 2 Brussels Convention⁹²⁰ would be negated, with the result that - in cases other than those expressly provided for - jurisdiction would be attributed to the courts of the plaintiff's domicile⁹²¹.

b) Cross-border injunctions based on Articles 6(1) and 2 Reg 44/LC

Article 6(1) Reg 44/LC deals with the jurisdiction in case of a joinder of multiple defendants and Article 2 Reg 44/LC deals with the jurisdiction at the place of the defendant⁹²². The Brussels Conventions included the identical provisions.

aa) Development and current situation with regard to Article 6(1) Reg 44/LC

The crucial and highly controversial question surrounding Article 6(1) was whether it provides for jurisdiction in a court of one potential infringer of a European patent if other infringers of the same patent - but different parts - are located in different places⁹²³.

On the basis of the argument that harmonised substantive law is applicable in parallel rights⁹²⁴, Dutch courts regularly affirmed this if the necessary connecting factor existed

⁹¹⁸ Along the same lines, Swiss Federal Supreme Court, Decision of October 23, 2006 (BGE 132 III 778); cf. also *Grabinski, Bedeutung*, 204-205; Schennen Detlef/Stauder Dieter in: *Singer/Stauder*, 3rd edition, Art. 64 N 30; Véron, *Bruxelles*, 826.

⁹¹⁹ *Marinari v Lloyds Bank*, ECJ September 19, 1995 (case C-364/93).

⁹²⁰ Art. 2(1) Brussels Convention: "*Subject to the provisions of this Convention, persons domiciled in a Contracting State shall, whatever their nationality, be sued in the courts of that State*".

⁹²¹ Cf. also *Stauder, Anwendung*, 474.

⁹²² Cf. §3 A.I. Relevant provisions in regard to cross-border *forum shopping*.

⁹²³ The majority of legal views were of the opinion that it is not necessary for all of the defendants to be domiciled in a state in which Regulation 44/2001 or the Lugano Convention is applicable in order for this provision to apply (cf. *Hölder, Grenzüberschreitende*, 52.)

between the different claims of the plaintiff against the different infringers in the case of the same infringement acts by the different defendants⁹²⁵.

This view was criticised not only in the Netherlands itself by Dutch multinational companies⁹²⁶ and by *Brinkhof*, at that time Judge at the Court of Appeals of The Hague, but also by others.

- First, it was wondered whether this affirmation is in line with the bundle approach of the European patent, giving each part of the patent its own legal destiny on which each of the EPC contracting states would ultimately make a decision based on its own authority, and therefore giving no right to a foreign court to impose its doctrines and views⁹²⁷. The aim of Article 6(1) Brussels Convention was to avoid irreconcilable decisions, but the bundle approach and the independent existence of the differing parts of the European patent would not call for such decisions⁹²⁸.

Furthermore, it was argued that a unified procedure would be necessary if the aim of a harmonised result was to be reached⁹²⁹.

- Second, it was questioned whether the basic principle provided for in Article 2 Brussels Convention, and especially by the jurisprudence of the ECJ, that generally the courts at the domicile of the defendant have jurisdiction, would support such a broad view as that of the Dutch courts⁹³⁰.

It was therefore concluded that, bearing these principles in mind, a more qualified criterion would be needed to provide jurisdiction based on Article 6(1) Brussels Convention. A simple connection by virtue of the same patents and infringement acts consequently seems not sufficient⁹³¹ to fulfil the qualified standards of the ECJ⁹³² in regard to the

⁹²⁴ Cf. *Bertrams*, 621-622; *v. Meibom/Pitz, Cross-Border Injunctions*, 471; *Mäder*, 127.

⁹²⁵ Cf. *de Wit*, 227; *Brinkhof, Zu weit?*, 492; *Ebbink, Pan-European*, 24.

⁹²⁶ Cf. *Ebbink, Pan-European*, 25; *v. Engelen*, 24.

⁹²⁷ Cf. also *v. Meibom/Pitz, Cross-Border Injunctions*, 473; *Grabinski, Determination*, 874.

⁹²⁸ Cf. *Brinkhof, Enforcement*, 178-179; *Brinkhof, de Ranitz*, 143; *O'Sullivan*, 657; *Karet, Suit*, 79 and also cf. *Cornish*, 289; *König, Probleme*, 302, 305.

⁹²⁹ Cf. *v. Meibom/Pitz, Cross-Border Injunctions*, 473-476. Cf. also §6 D. Harmonisation of court proceedings and substantive patent law.

⁹³⁰ Cf. *Brinkhof, Zu weit?*, 492.

⁹³¹ Cf. *Brinkhof, Zu weit?*, 496; also cf. *Neuhaus*, 267.

connection between the various actions brought by the same plaintiff against different defendants.

A qualified connection must be of such a kind that it is expedient to determine the actions together in order to avoid the risk of irreconcilable judgments resulting from separate proceedings⁹³³. It was therefore concluded that there must be a circumscribed connection between the defendants, such as the liability of each defendant⁹³⁴, and a main role in the potential infringement on the part of the defendant domiciled at the place where the action is brought, to provide a jurisdiction in such a case⁹³⁵.

Brinkhof generated critics of his own in the *Expandable Grafts Partnership v Boston Scientific* decision⁹³⁶, which resulted in the famous "spider in the web" doctrine⁹³⁷, ending in a self-imposed, more restricted jurisdiction for the Dutch courts⁹³⁸.

The doctrine provides that the defendants must form part of one and the same group of companies and that only the court where the head of a group of defendants is domiciled grounds the necessary close ties between the seised court and the action and consequently ensures a higher degree of legal certainty⁹³⁹.

In other words, jurisdiction for all defendants - which belong to the same group of companies - is only approved if the domicile of the main administration - head office - which has leading operational functions - control - in relation to the subject and/or initiates the relevant policy plans of the company is in the Netherlands, and if the alleged infringing acts of the various defendants are the same or virtually the same⁹⁴⁰.

On the basis of this decision, multiple jurisdiction and *forum shopping* could consequently be reduced⁹⁴¹ but not avoided.

⁹³² Cf. *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst & Co.*, ECJ September 29, 1988 (case 189/87).

⁹³³ Cf. also Art. 28(3) Regulation 44/2001.

⁹³⁴ Cf. Stauder Dieter in: *v. Rospatt P.*, 508.

⁹³⁵ Cf. Brinkhof Jan in: *v. Rospatt P.*, 508.

⁹³⁶ *Expandable Grafts Partnership v Boston Scientific BV*, 1999 F.S.R., 352.

⁹³⁷ Cf. §3 D. Forum shopping and the ECJ.

⁹³⁸ Cf. *Pertegás-Sender, Cross-Border*, 3.

⁹³⁹ Cf. *Brinkhof, Enforcement*, 179.

⁹⁴⁰ Cf. *Ebbink, Pan-European*, 26; *Meier-Beck, Fragen*, 379; *Grabinski, Bedeutung*, 207.

⁹⁴¹ Cf. *Ebbink, Pan-European*, 26; *Brinkhof, Enforcement*, 179.

This decision was partly supported⁹⁴² and partly criticised.

The view was taken that "control" over the subject as a criterion of, basically, criminal or liability law has a stronger connection to tort than to the domicile⁹⁴³. However, the connection of tort to Article 6 Brussels Convention seems indeed not unproblematic⁹⁴⁴ from a dogmatic point of view.

Additionally, it was argued that the court goes beyond the standards set by the ECJ⁹⁴⁵ since it does not much care about "convenient" ties between the actions but requires "the closest" ties between *action* and *court*⁹⁴⁶.

It seems, however, that the court did care about the connection between the actions and just added the supplementary criterion of a connection between the court and the actions in order to realise the *ratio legis* as provided for by the ECJ. That is to say, jurisdiction should only exceptionally depart from the forum of the defendant⁹⁴⁷, i.e. if there is a certain connection with a certain place which makes it more suitable that the court of that place decides. In addition, supporters of a broad interpretation of Article 6(1) Brussels Convention argued that the defendant in a patent infringement case is regularly a legal person who does not need special protection. Additionally, it was explained that even if the defendant litigated before the "natural" forum, he would need a representative because of the complexity of the matter in dispute. Consequently, the interest of the average defendant in a patent dispute could not be compared with a private individual who is highly interested in defending himself before a familiar court⁹⁴⁸.

The opponents of the Dutch doctrine also criticised the fact that, from a political view, it is problematic that the case has to be moved to a court outside Europe if the company in control has its seat there⁹⁴⁹. In such a case the Dutch courts seem to take the view that on

⁹⁴² Cf. *Grabinski, Bedeutung*, 207; *Gauci; v.Meibom/Pitz, Limitations*.

⁹⁴³ Cf. *Meier-Beck, Fragen*, 380.

⁹⁴⁴ Cf. *Meier-Beck, Issues*, 507.

⁹⁴⁵ Cf. *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst & Co.*, ECJ September 29, 1988 (case 189/87).

⁹⁴⁶ Cf. *Ebbink, Pan-European*, 26; *Mäder*, 130-131.

⁹⁴⁷ Cf. also *Hölder, Gerichtsstand*, 209.

⁹⁴⁸ Cf. *Hölder, Gerichtsstand*, 215.

⁹⁴⁹ Cf. *Grabinski, Bedeutung*, 207.

the basis of Dutch private international law they may at least review the facts of alleged infringement committed in the Netherlands by the foreign "spider in the web"⁹⁵⁰.

Another point made by the critics was that it is national law that defines the "company in leading operational control". Consequently, there would be different approaches, which again would lead to conflicts of jurisdiction⁹⁵¹. In addition, it was argued that finding out where this company is located could be problematic for the plaintiff⁹⁵².

These arguments might be true but do not prove a great deal, as similar problems exist in many other fields of trade law.

In addition, it was again questioned whether conflicting results in national judgments regarding the infringement - and invalidity - of different parts of the same European patent are indeed irreconcilable⁹⁵³. This again leads back to the very basic issue of whether one follows the final aim of uniformity of jurisprudence - in case the different parts of the European patent at stake are congruent - and efficient proceedings or the strict bundle approach of the European patent with a territorial limitation⁹⁵⁴.

In any case, the judgment was confirmed in the Netherlands and the jurisdiction seemed established⁹⁵⁵.

Nevertheless, the critics obviously motivated the Dutch Supreme Court to consult the ECJ to find out whether the "spider-in-the-web" doctrine may be applied for the interpretation of the co-defendant rule in international litigation⁹⁵⁶.

The ECJ decided in its famous judgment *Roche Nederland BV v Primus*⁹⁵⁷ that Article 6(1) Brussels Convention

⁹⁵⁰ Cf. Véron, *Bruxelles*, 821 with reference to the unpublished decision *Scimed v Medtronic* of the *Arrondissementrechtbank Den Haag* (District Court of the Hague).

⁹⁵¹ Cf. *Ebbink*, *Pan-European*, 26; *Pertegás-Sender*, *Cross-Border*, 3; *Mäder*, 130.

⁹⁵² Cf. *Pertegás-Sender*, *Cross-Border*, 4.

⁹⁵³ Cf. Lindgreen Nicolai/Knudsen Louise, *Danish High Court Rejects Pan-European Injunctions in Patent Cases*, 2004 EIPR, 182-184.

⁹⁵⁴ Cf. *Hölder*, *Gerichtsstand*, 210-215.

⁹⁵⁵ See *v. Engelen*, 24.

⁹⁵⁶ Cf. Gielen Charles/Bosscher Doeko, *Spider-in-the-web doctrine to be tested*, February 2004 *Patent World*, 6; *id.* 02/04 *WIPR*, 10; *Franzosi/Tilmann*, 55-57.

⁹⁵⁷ *Roche Nederland BV v Primus*, ECJ July 13, 2006 (case C-539/03).

"must be interpreted as meaning that it does not apply in European patent infringement proceedings involving a number of companies established in various contracting states in respect of acts committed in one or more of those states even where those companies, which belong to the same group, may have acted in an identical or similar manner in accordance with a common policy elaborated by one of them".

It took the view that in order that decisions may be regarded as contradictory it is not sufficient that there be a divergence in the outcome of the dispute, but that divergence must also arise in the context of the same situation of law and fact.

However, the factual situation would not be the same, as the defendants, involving a number of companies established in various contracting states, and the infringements they are accused of, committed in different contracting states, would be diverging. Furthermore, because of the bundle approach of a European patent the decisions on the different parts could not be classed as contradictory, as a different legal situation would be involved. Therefore, even if the defendant companies, which belong to the same group, had acted in an identical or similar manner in accordance with a common policy elaborated by one of them, so that the factual situation would be the same, the legal situation would still vary.

Contradictory decisions would therefore not be possible and thus Article 6(1) Brussels Convention not be applicable in such cases.

Cross-border injunctions based on this provision will consequently in general not be possible any more.

It is unclear if this does not apply where several defendant companies, which belong to the same group, infringe the same part of a European patent by one connected action⁹⁵⁸. Such actions could, for example, be taken into consideration if one company exports infringing goods and the other company imports the same goods. However, these cases would of course be rare.

⁹⁵⁸ Cf. *Stauder, Anwendung*, 476; Moussa Olivier/Véron Pierre in: *Cottier/Véron*, Regulation 44/2001, Art. 6, N 2.

In the meantime the European Max-Planck Group for Conflict of Laws in Intellectual Property (CLIP), composed of highly qualified experts, made a proposal⁹⁵⁹ for the amendment of Article 6(1) Regulation 44/2001 and the implementation of the "spider in the web" doctrine in a special provision. This proposal is also supported by *Hess/Pfeiffer/Schlosser* in their report on the application of Regulation 44/2001 in the EU member states⁹⁶⁰.

The ECJ's jurisprudence obviously has the effect that companies now refrain from litigating in the Netherlands⁹⁶¹.

bb) Jurisdiction to decide about a foreign patent or a foreign part of a European patent

As mentioned above, another but not less important question regarding the application of Articles 2 and 6(1) Brussels Convention was whether a court has jurisdiction to decide about the infringement of a foreign patent or a foreign part of a European patent⁹⁶². Dutch, French and German courts have regularly dealt with the infringement of foreign patents.

Following the argumentation concerning the lack of discretionary powers of the courts in states in which the Brussels Convention - and now Regulation 44/2001, or the Lugano Convention - are applicable to the doctrine of *forum non conveniens*, it seems impossible that a court that is contacted could refuse to hear foreign patent infringement cases.

Nevertheless, UK courts remained very reluctant in regard to cross-border judgments.

An important aspect in regard to the British refusal was the so-called "Moçambique rule"⁹⁶³, according to which certain actions having a foreign element were to be categorised as local actions and therefore excluded from UK jurisdiction⁹⁶⁴.

⁹⁵⁹ Cf. *CLIP proposal*.

⁹⁶⁰ Cf. *Hess/Pfeiffer/Schlosser*, N 852; N 920.

⁹⁶¹ Cf. Hendrick in: *Bodoni*, 33.

⁹⁶² Cf. *Stauder, Anwendung*, 513; *Neuhaus*, 261.

⁹⁶³ This rule was established by the House of Lords in *British South Africa v Companhia do Moçambique*, A.C. 1893, 602.

⁹⁶⁴ Cf. *Bragiel*, 135; *Kieninger*, 284; also cf. *Perret, Territorialité*, 141-142.

In addition, it was the so-called "double actionability" rule of private international law which hindered the UK courts from deciding on foreign patents⁹⁶⁵. This rule stipulates that acts done abroad were a tort, and actionable in the United Kingdom as such, only if they were actionable as a tort according to British law, as well as actionable according to the law of the foreign state where they were done⁹⁶⁶.

In *Pearce v Ove Arup Partnership Ltd*⁹⁶⁷ - actually a copyright case - the UK Court of Appeal accepted a reversal of this view by the first instance in regard to infringements where the Lugano and Brussels Conventions apply⁹⁶⁸:

On the one hand, it was ruled that the "Moçambique rule" was an anachronism with regard to signatories of the Brussels and Lugano Conventions and did not apply.

On the other hand, it was decided that the "double actionability" rule was only a starting point and could be departed from in appropriate cases to enable the plaintiff to rely on the law of the foreign territory to establish an infringement of his rights⁹⁶⁹.

UK courts could therefore basically try actions in respect of infringement of IPRs abroad if jurisdiction is given on the basis of the Brussels Convention⁹⁷⁰.

This jurisprudence was, however, considerably watered down in regard to patents and other registered rights⁹⁷¹ in *Coin Controls Ltd v Suzo International (UK) Ltd.*⁹⁷². It was agreed that the Brussels and Lugano Conventions superseded the "Moçambique rule", however, with regard to patents⁹⁷³, subject to the effect of Articles 16(4) and 19 Brussels Convention⁹⁷⁴.

⁹⁶⁵ Cf. Floyd Christopher/Purvis Iain, Can an English Court Restrain Infringement of a Foreign Patent?, 1995 EIPR, 110-115; *Cornish*, 287; *Kieninger*, 285-286.

⁹⁶⁶ Cf. also *O'Sullivan*, 656; *Arnold, Cross-Border*, 421; *Bragiel*, 135-136 and 144-146.

⁹⁶⁷ *Pearce v Ove Arup Partnership Ltd*, 1999 All E.R., 769.

⁹⁶⁸ This rule should also apply with regard to Regulation 44/2001.

⁹⁶⁹ Cf. *Bragiel*, 136; *Cornish/Llewelyn, IP*, N 2-72 to 2-73; *Arnold, Cross-Border*, 421-422.

⁹⁷⁰ Cf. *Haas P.*, 194.

⁹⁷¹ Cf. *Bragiel*, 136-137 and cf. already in 1996 *Cornish*, 288-289.

⁹⁷² *Coin Controls Ltd v Suzo International (UK) Ltd.*, 1997 F.S.R., 660.

⁹⁷³ Cf. in this regard also n. 884.

⁹⁷⁴ *Coin Controls Ltd v Suzo International (UK) Ltd.*, 1997 F.S.R., 674-675.

Article 16(4)⁹⁷⁵ Brussels Convention provides *inter alia* that in proceedings concerned with the validity of patents, the courts of the contracting state in which the deposit or registration has taken place shall have exclusive jurisdiction. Depending on the case, the infringement court will stay proceedings and wait for the results of the nullity proceedings if a counterclaim for revocation is mounted⁹⁷⁶.

Until the ECJ decided the opposite in *GAT v LuK*⁹⁷⁷, many courts in the states in which Regulation 44/2001 – and before that the Brussels Convention - or the Lugano Convention is applicable⁹⁷⁸ took the view that the incidentally mounted question of invalidity in an infringement case does not fall under the exclusivity of the courts where registered, as provided for in Article 22(4) Regulation 44/2001, i.e. Article 16(4) Lugano and Brussels Conventions.

Article 19 Brussels and Lugano Conventions, i.e. Article 25 Regulation 44/2001, provides that where a court of a contracting state is seised of a claim which is principally concerned with a matter such as the validity of a patent, it shall declare of its own motion that it has no jurisdiction.

Judge Laddie held, in contradiction to many continental courts, that since one cannot infringe an invalid patent⁹⁷⁹, a patent infringement action in which validity was an issue was always "principally concerned"⁹⁸⁰ with validity. Hence, he rendered the decision that, by the combined effect of Articles 16(4) and 19 of the Brussels Convention, the courts in the country where the patent was registered always has exclusive jurisdiction, including the infringement part, even if the validity is questioned by *exceptio*⁹⁸¹.

⁹⁷⁵ The same rule in Regulation 44/2001: Art. 22(4).

⁹⁷⁶ Cf. *Kieninger*, 281; *Mousseron/Raynard/Véron*, 904.

⁹⁷⁷ *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, ECJ July 13, 2006 (case C-4/03).

⁹⁷⁸ Cf. for example *Treichel*, 39-40; *v.Meibom/Pitz, Limitations*, 601; *Leitzen*, 1011; *Vischer, Patent*, 375. Cf. also *Franzosi/Tilmann*, 57.

⁹⁷⁹ Cf. *Karet, Suit*, 79; cf. also *Jacob, Harmonisation*, 148.

⁹⁸⁰ Also cf. *Fawcett/Torremans*, 203 and *Mousseron/Raynard/Véron*, 901-903 in regard to the term "principally concerned".

⁹⁸¹ Cf. *Arnolds, Cross-Border*, 411 with reference to *Coin Controls Ltd v Suzo International (UK) Ltd.*, 1997 F.S.R., 675-679; *Fawcett J.*, 142; *Barbosa*, 740; *Bragiel*, 150; *Fawcett/Torremans*, 210-211.

Since nullity is brought up in most infringement cases, the court having jurisdiction based on Article 2 Reg 44/LC would essentially always have to waive jurisdiction⁹⁸². The more open policy was consequently overturned to a great extent⁹⁸³.

The critics did not wait long. It was argued that this view is incompatible with the language used in Article 19 of the Brussels Convention since "principally concerned" could only mean by way of claim and not by way of exception⁹⁸⁴.

This is obviously a technical point of view, whereas the courts in the United Kingdom construed the term from a practical point of view. That is to say that "principally" would mean that no conclusion on infringement could be reached without consideration of the validity of the patent⁹⁸⁵.

This jurisprudence actually moves the defendant to the special position of being able to engage in *forum shopping* by just raising the question of validity if he does not agree with the forum in the United Kingdom⁹⁸⁶. Another problem arising out of this jurisprudence is that it opens the possibility of jurisdiction being destroyed at any time, presumably with retroactive effect, if the defendant is allowed to plead invalidity at a later stage in the action. The danger for legal uncertainty and possible abuse seems obvious⁹⁸⁷.

This situation is very unsatisfactory from the viewpoint of the plaintiff, and it was argued that this might be a reason not to commence such proceedings in British courts⁹⁸⁸.

However, Dutch courts also responded to the UK approach: the Court of Appeals of The Hague took a slightly different view on that question⁹⁸⁹ and declared that jurisdiction must be decided on the basis of the claim stated in the summons. In principle, the court has to stay the infringement proceedings until the foreign court has pronounced judgment in the

⁹⁸² Cf. also *Bragiel*, 154; *Stauder, Cross-Border*, 500; also cf. *Blum/Pedrazzini*, Art. 75, N 6.

⁹⁸³ Also cf. *Perret, Territorialité*, 136-137.

⁹⁸⁴ Cf. *Stauder, Anwendung*, 511; *Kieninger*, 288; *Fawcett J.*, 143; *Véron, Bruxelles*, 818; *Pertegás-Sender, Enforcement*, N 4.54; cf. also already *Vischer, Patent*, 375.

⁹⁸⁵ Cf. *Karet, Suit*, 79.

⁹⁸⁶ Cf. *Cohen*, 382; *Karet, Suit*, 80-81; *Tilmann/v. Falck*, 585.

⁹⁸⁷ Cf. *Wadlow*, N 3-91; *Fawcett J.*, 143; *Bragiel*, 154.

⁹⁸⁸ Cf. *Cohen*, 382.

⁹⁸⁹ Cf. also *Tritton*, N 14-068 to N 14-069, which shows a full range of options the courts have in this situation.

nullity issue if the court takes the view that the challenge to validity is likely to succeed⁹⁹⁰. It argued that the strict approach followed in the United Kingdom would increase the risk of contradictory decisions, as well as cost, and cause delay⁹⁹¹.

In *Fort Dodge Animal Health Ltd v Akzo Nobel NV*⁹⁹² the problem was brought up again.

Fort Dodge Animal Health Ltd filed a revocation action before a court in the United Kingdom, and *Akzo Nobel* filed an infringement action before a Dutch court. *Fort Dodge Animal Health Ltd* pleaded in the English proceedings that English courts have exclusive jurisdiction because infringement litigation of a United Kingdom part of a European patent principally concerns validity of that patent. It also requested an *anti-suit injunction* in regard to the possibility of the Dutch court trying the infringement of the United Kingdom part of the European patent⁹⁹³. The request for the injunction was denied and the decision appealed. The Court of Appeal expressly affirmed the decision of *Coin Controls Ltd v Suizo International (UK) Ltd*. in regard to Article 16(4) in combination with Article 19 Brussels Convention, but it also concluded that the matter is not *acte clair*⁹⁹⁴.

Users had to wait until the *GAT v LuK* case⁹⁹⁵ before the ECJ could deal with this question.

aaa) The ECJ's judgment *GAT v LuK*

The ECJ held in *GAT v LuK*⁹⁹⁶ that Article 19 Brussels Convention would not confer jurisdiction but merely required the court seised to examine whether it had jurisdiction and in certain cases to declare that it has none. The British jurisprudence was therefore

⁹⁹⁰ *Expandable Grafts Partnership v Boston Scientific BV*, 1999 F.S.R. 352; cf. *Brinkhof, Enforcement*, 180; *Fawcett J.*, 144; *Bragiel*, 156; *Haas P.*, 197.

⁹⁹¹ Cf. *Karet, Suit*, 81.

⁹⁹² *Fort Dodge Animal Health Ltd v Akzo Nobel NV*, 1998 F.S.R., 222.

⁹⁹³ See *v.Meibom/Pitz, Limitations*, 601.

⁹⁹⁴ Cf. also *Véron, Bruxelles*, 822; *Barbosa*, 741; *Fawcett J.*, 146; for an overview cf. *Wadlow*, N 3-151; but also cf. *Franzosi, Stay*, 155-156.

⁹⁹⁵ *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, ECJ July 13, 2006 (case C-4/03).

⁹⁹⁶ *Gesellschaft für Antriebstechnik mbH & Co. KG v Lamellen und Kupplungsbau Beteiligungs KG*, ECJ July 13, 2006 (case C-4/03).

rejected. A court having jurisdiction based on Article 2 Brussels Convention may therefore decide on the infringement of a foreign patent and a foreign part of a European patent.

However, as mentioned above, the ECJ rejected the jurisprudence that the infringement court would also have jurisdiction to decide incidentally on the nullity of the foreign patent.

It took the view

"that the exclusive jurisdiction provided for by Article 16(4) Brussels Convention should apply whatever the form of proceedings in which the issue of a patent's validity is raised, be it by way of an action or a plea in objection, at the time the case is brought or at a later stage in the proceedings."

It argued that the binding nature of the rule laid down in Article 16(4) Brussels Convention would be undermined if an infringement court could incidentally decide on the validity of a patent. In addition, a broader jurisprudence of the patent infringement court would have the effect of multiplying the heads of jurisdiction and would be liable to undermine the predictability of the rules of jurisdiction laid down by the Brussels Convention, and consequently would undermine the principle of legal certainty, as well as multiply the risk of conflicting decisions which the Brussels Convention seeks specifically to avoid. Furthermore, it would lead to distortions due to the fact that, in some contracting states, the question of validity raised as a preliminary question would have an *inter partes* effect whereas in other it would have an *erga omnes* effect⁹⁹⁷.

i) Analysis

This jurisprudence makes it clear that the infringement courts in the states where Regulation 44/2001 applies have jurisdiction regarding the infringement of a foreign patent or a foreign part of a European patent and consequently can apply patent law taking effect

⁹⁹⁷ It should be noted that in most EPC contracting states the effect of the decision on the validity raised incidentally is *inter partes* and has no *res judicata* effect. The effect in the UK would be different, as the ruling has a broader *res judicata* effect in subsequent proceedings (so-called "issue estoppel"; cf. Barnett Peter, The Prevention of abusive cross-border re-litigation, 2002 ICQL, 949-951). Parties can therefore be precluded in certain circumstances from re-litigating matters previously decided as incidental questions (cf. Dogauchi Masato/Hartley Trevor C., Preliminary Draft Convention on Exclusive Choice of Court Agreements, Draft report, Hague Conference on Private International Law, Enforcement of Judgments, Prel. Doc. No. 26, December 2004, N 56).

in another state. However, they have no authority to decide on the validity of foreign patents or of a foreign part of a European patent⁹⁹⁸.

This has the consequence that there will be an increase in multiple patent litigation. This is in contrast to the ECJ's argument that a broader jurisprudence would multiply the heads of jurisdiction. Patent disputes will consequently become more expensive and there is a risk of contradictory decisions, as two different courts will have to deal with the same dispute if a foreign patent or a foreign part of a European patent are involved.

This risk could only be limited if the plaintiff sues the potential patent infringer before the courts of the state in which the patent has effect. This would not, however, help in Germany, for example, where the nullity and infringement of a patent are dealt with before different courts.

In addition, it is no secret that a judgment from an internationally respected court on the other side may be a basis for the settlement of similar infringements in other countries⁹⁹⁹. The ECJ's decision will therefore motivate plaintiffs to first sue the potential defendant more frequently before an experienced and well-known German court in order to use its decision to settle further potential patent infringements involving other parts of a European patent.

One of the crucial issues left unanswered by the ECJ is what the court dealing with the infringement would have to do if the defendant raised the question of the validity of a foreign patent as a defence.

The views within the legal doctrine differ. The Commercial Court of Zurich has dealt with the issue. It rendered an interim judgment¹⁰⁰⁰ concerning an infringement of two Community trade marks after the validity issue was raised. Bearing in mind the *GAT v LuK* judgment¹⁰⁰¹, it decided to stay its proceedings in order to provide the defendant with the

⁹⁹⁸ Cf. also *Adolphsen, Renationalisierung*, 17.

⁹⁹⁹ Cf. *Pitz, Aspects*, 23.

¹⁰⁰⁰ "Gültigkeit einer Gemeinschaftsmarke", sic! 2006, 854-855; GRUR Int. 2007, 258.

¹⁰⁰¹ The contracting states of the Lugano Convention are not bound by the judgments of the ECJ. However, Art. 1 Protocol No. 2 to the Lugano Convention on the uniform interpretation of the Convention provides that the courts of each contracting state, when applying and interpreting the provisions of the Convention, had to

possibility of filing a revocation action with the competent court. If the action were not filed in the period determined by the court, it would continue with the proceedings and the invalidity question would be disregarded.

Several authors share the court's view that such a decision would be covered by the ECJ's judgment¹⁰⁰². Article 16(4) Lugano Convention (Art. 22(4) Regulation 44/2001) would not require the infringement jurisdiction to be transferred to the court dealing with validity in such a case.

The view of other authors goes along similar lines, arguing that since a granted patent must be held valid until it is nullified, the infringement proceedings should continue unless the title is blatantly invalid¹⁰⁰³.

However, other authors feel¹⁰⁰⁴ that the decision of the ECJ is clear: Article 16(4) Lugano Convention would confer exclusive jurisdiction over all proceedings related to the validity of a foreign patent, irrespective of how the validity issue is raised. Therefore, infringement proceedings will have to be transferred to the territory of the state where the patent takes effect as soon as the invalidity issue is raised.

Hess/Pfeiffer/Schlosser therefore suggest amending Article 22(4) Regulation 44/2001 in order to ensure that the courts have a clear legal basis on which to execute the approach as exemplified by the Commercial Court of Zurich¹⁰⁰⁵.

Another important outstanding issue, particularly with regard to the possible abuse of proceedings, is whether there is a time limit within which the defendant has to raise the invalidity defence and whether and to what extent the nullity claim has to be substantiated in order to avoid transfer or staying of the proceedings at a very late stage. The generally applicable principle of fair proceedings should, however, set certain time limits within which the defence could be raised.

pay due account to the principles laid down by relevant decisions delivered by the courts of the other contracting states concerning provisions of this Convention.

¹⁰⁰² Cf. for example *Adolphsen, Renationalisierung*, 19; *Kur, A Farewell*, 852.

¹⁰⁰³ Cf. *Moussa Olivier/Véron Pierre*, in: *Cottier/Véron*, Regulation 44/2001, Art. 22(2), N 2.

¹⁰⁰⁴ Cf. for example *Brinkhof, HvJ*, 320; *Warner Steven/Middlemiss Susie*, 2006 EIPR, 580-585, 584; *Bukow* 69-70.

¹⁰⁰⁵ Cf. *Hess/Pfeiffer/Schlosser*, N 925.

c) *Cross-border injunctions rendered in a kort geding procedure*

As mentioned earlier the Dutch *kort geding* proceedings are a special kind of summary proceedings and have been looked upon, mainly by the Anglo-Saxon legal community, with considerable scepticism¹⁰⁰⁶, not least because they were also applied in cross-border cases¹⁰⁰⁷.

Meanwhile, the Dutch courts seemed to have become more careful with regard to cross-border jurisdiction in *kort geding*¹⁰⁰⁸. This tendency should continue after the latest decisions of the ECJ with regard to cross-border jurisdiction.

The more limited approach could avoid a situation where a state in which Regulation 44/2001 or the Lugano Convention is applicable had to decide whether the recognition of a decision based on the *kort geding* procedure could be refused on the basis of the fact that it would be against public policy, as it was obviously discussed. However, even with a cross-border effect¹⁰⁰⁹ it seems that it would not be sufficient to refuse recognition¹⁰¹⁰, as a narrow international public policy has to be taken into account within the framework of Regulation 44/2001 or the Lugano Convention¹⁰¹¹. In any case, a judge will think twice before granting injunctive relief when the defendant argues invalidity of the patent¹⁰¹², and he will not grant it if there is a serious, non-negligible chance that the patent will be revoked before the EPO or in national revocation actions¹⁰¹³.

¹⁰⁰⁶ Cf. *Gauci*; *Jacob*, *Harmonisation*, 148; *v.Meibom/Pitz*, *Cross-Border*, 29; *Brinkhof*, *Zu weit?*, 489; *v.Meibom/Pitz*, *Limitations*, 597.

¹⁰⁰⁷ Cf. *Bertrams*, 629-630; *Gauci*, 362; *Stauder*, *Cross-Border*, 503. Cf. also *Schlosser*, *EU-Zivilprozessrecht*, Art. 31 EuGVVO, N 32, with regard to the enforcement of a measure rendered in a *kort geding* procedure.

¹⁰⁰⁸ Cf. *Brinkhof*, *Enforcement*, 180.

¹⁰⁰⁹ Cf. also *de Wit*, 232.

¹⁰¹⁰ Cf. *Mäder*, 137-138.

¹⁰¹¹ Cf. *Mousseron/Raynard/Véron*, 898-899; *Bertrams*, 630 who report that the *Cour d'appel de Paris* (Courts of appeal of Paris) did not refuse recognition, on the grounds of contradiction with French public policy, of a Dutch judgment rendered in a *kort geding* procedure.

¹⁰¹² Cf. *Brinkhof*, *Enforcement*, 180.

¹⁰¹³ See *Oosting*, 45.

d) *Cross-border injunctions based on Article 31 Regulation 44/2001 and on Article 24 Lugano Convention*

Article 31 Regulation 44/2001 and Article 24 Lugano Convention provide that application may be made to the courts of a state, in which the instruments are applicable, for such provisional, including protective, measures as may be available under the law of that state, even if, under the instruments, the courts of another instrument state have jurisdiction as to the substance of the matter.

It is made clear that this regulation points back to national law as regards the possibility of a court rendering a provisional and protective measure, and gives it a free hand¹⁰¹⁴.

With regard to these provisions it was also discussed whether measures based on them can have a cross-border effect¹⁰¹⁵ or whether their effect is territorially restricted. The ECJ has not yet decided on this question.

The court, however, indirectly limited the territorial effect with the *Bernard Denilauler v SNC Couchet Frères* decision¹⁰¹⁶ it rendered more than 25 years ago. It held that the recognition and the enforcement of judicial decisions are not fulfilled in the case of provisional or protective measures which are ordered or authorised by a court without the party against whom they are directed having been summoned to appear and which are to be enforced without prior service on that party. Such measures rendered outside of principal proceedings would thus regularly not have to be recognised and enforced abroad, as the affected party is regularly not heard in proceedings for provisional and protective measures in order to keep an effect of surprise¹⁰¹⁷.

The Court of Appeals of The Hague decided in the earlier mentioned case *Expandable Grafts Partnership v Boston Scientific*¹⁰¹⁸ that the *Bernard Denilauler v SNC Couchet Frères* judgment of the ECJ limited the territorial effect of *any* measure offered by Article 24 Brussels and Lugano Convention and declared that they can be operative only within

¹⁰¹⁴ Cf. *Jenard, Report*, 42; *Brinkhof, Measures*, 362; *Kropholler, Europäisches Zivilprozessrecht*, Art. 31 N 1; *Walter G., Zivilprozessrecht*, 509.

¹⁰¹⁵ Cf. *Jacob, Harmonisation*, 149-150; *Brinkhof, Zu weit?*, 489.

¹⁰¹⁶ *Bernard Denilauler v SNC Couchet Frères*, ECJ Mai 21, 1980 (case 125/79).

¹⁰¹⁷ Cf. *Schlosser, EU-Zivilprozessrecht*, Art. 32 EuGVVO, N 6; *Kropholler, Europäisches Zivilprozessrecht*, Art. 31, N 24; *ibid.* Art. 32, N 22; *Treichel*, 67-68.

¹⁰¹⁸ *Expandable Grafts Partnership v Boston Scientific BV*, 1999 F.S.R. 352.

the territory of the states of the court¹⁰¹⁹. This was because the ECJ, in that decision, also held that the courts of the place - or, in any event, of the contracting state - where the assets subject to the measures sought are located are those best able to assess the circumstances which may lead to the grant or refusal of the measures sought or to the laying down of procedures and conditions which the plaintiff must observe in order to guarantee the provisional and protective character of the measures authorised¹⁰²⁰.

In March 2005 the *Arrondissementrechtbank Den Haag* (District Court of The Hague) in *Engrow v ECM Beheer* granted a provisional cross-border injunction, given the fact that the Dutch part of the European patent was undoubtedly valid and that there were no essential differences between the various parts of the patent and that the plaintiff had demonstrated that infringing products were also offered for sale in a number of foreign countries¹⁰²¹.

Also interesting to note with regard to cross-border interim injunctions is that a Belgian court issued such an injunction based on Article 31 Regulation 44/2001 against two non-European companies which had infringed a patent at an international fair held in Brussels¹⁰²².

2. Policy-making by applying law taking effect abroad and the problem of recognition

Procedural law serves to form public opinion of fair justice and to safeguard *Rechtsfriede* (literally, "legal peace")¹⁰²³. By nature, judges try to apply the procedural law in such a way as to ensure that substantive law is implemented to the greatest extent possible¹⁰²⁴.

As mentioned earlier, courts should apply patent law taking effect abroad by including the different economic and social policies¹⁰²⁵, not least in the process of developing a uniform

¹⁰¹⁹ Cf. however *Mäder*, 136-137.

¹⁰²⁰ Cf. also *Van Uden Maritime BV, trading as Van Uden Africa Line v Kommanditgesellschaft in Firma Deco-Line and Another*, ECJ, November 17, 1998 (case C-391/95).

¹⁰²¹ Case reported by Koenraad Hidde, Still waiting..., February 2006 Patent World, 26-27, 26.

¹⁰²² Cf. de Jong Philippe, Patent infringements at international fairs - cross-border enforcement through Belgian summary proceedings, 2005 JIPLP, 13-15.

¹⁰²³ Cf. *Habscheid*, 5-6.

¹⁰²⁴ See *Brinkhof, Kort Geding*, 499; but also Decision of the Swiss Federal Supreme Court of March 2, 1987 (BGE 113 IA 309).

¹⁰²⁵ See *Chisum*, 612.

interpretation with regard to European patent law. Its interpretation of (patent) law¹⁰²⁶ taking effect abroad will thus influence another state. Having jurisdiction consequently also means being able to make policy¹⁰²⁷.

This becomes even more manifest if novel or controversial questions of foreign law are involved¹⁰²⁸. Owing to the considerable influence a patent system has on the promotion of a country's economic growth, there is a certain risk that a court will give a broader or less broad interpretation of the scope of the patent claims, depending on the patent holder¹⁰²⁹. If a foreign court has jurisdiction, it could consequently also make competition policy from outside. This seems to be one reason why the courts in the United Kingdom have always been reluctant to hear cross-border patent cases¹⁰³⁰ and the courts in the Netherlands started to step back in their policy of rendering cross-border injunctions.

The policy-making process is thus - to a certain extent - undermined if the parties choose a (foreign) court which construes the law in the way they would like,¹⁰³¹ or because of certain procedural specialities. In the end, it results in implications for a state's authority and sovereignty¹⁰³².

These implications become most evident if a state follows a broad jurisdiction policy, as in the US, for example. The so-called "doing business" jurisdiction provides many US courts with the possibility of accepting jurisdiction based on the carrying-out of commercial or other activities by the defendant. The general nature of this connection makes it possible to bring a suit against the defendant even when the claim has no specific relationship to

¹⁰²⁶ Cf. thoroughly *Jansen/Michaels*, 18, 21-23, 30-34, 39-44; but also *Cornish*, 288-289; *Geller*, 127; *Stauder, Cross-Border*, 502; *König, Probleme*, 306; also cf. critics of the Dutch courts in regard to cross-border injunctions, *Brinkhof, Zu weit?*, 495; *Brinkhof, de Ranitz*, 145 but also *Grabinski, Determination*, 874 who pleads that it should not be allowed to apply its own practice to foreign patents.

¹⁰²⁷ Cf. *Chisum*, 610 as well as *Ortman v Stanray Corp.*, 371 F.2d 154, 152 U.S.P.Q. (BNA) 163 (7th Cir. 1967) and *Packard Instrument Co. v Beckman Instruments, Inc.*, 346 F. Supp. 408, 175 U.S.P.Q. (BNA) 282 (N.D. Ill. 1972).

¹⁰²⁸ Cf. *Fentiman, Foreign law*, 277; *Adolphsen, Europäisches*, N 263.

¹⁰²⁹ Cf. Hoffmann Leonard, *The role of policy in intellectual property litigation*, *International Intellectual Property Law & Policy*, vol. 5, Chapter 35, Hansen Hugh (ed.), Fordham University School of Law, 2003, N 35-2 to N 35-6.

¹⁰³⁰ Cf. also *Véron, Bruxelles*, 818; *Haas P.*, 195; cf. however, *Laddie, de Ranitz*, 530.

¹⁰³¹ Cf. *Laddie, de Ranitz*, 530; cf. however *Bradley*, 577-579.

¹⁰³² Cf. also *Grabinski, Determination*, 874.

the activity by the defendant in the state of the court seised¹⁰³³. It is therefore quite easy to ground jurisdiction in the US.

The implications for Europe are limited, however, since the US courts often deny jurisdiction on the basis of the *forum non conveniens* doctrine as long as the plaintiff is not a US citizen or company and the case mainly occurred outside the USA¹⁰³⁴. Additionally, decisions based on the "doing business" jurisdiction are not recognised and consequently not enforced by European states since, from a fundamental point of view, they judge this ground to be exorbitant.

A crucial aspect of jurisdiction is therefore the recognition of the judgment. A possible negative or unwanted influence can be blocked if the judgment does not have to be recognised and enforced. Basically, there is no duty for a state to recognise a foreign judgment on its own territory. This Roman-law-based principle (*extra territorium ius dicenti impune non paretur*) certainly only applies as long as there is no international - or national - instrument which obliges it to do so.

Bearing in mind the aim to strengthen legal protection, and to provide free movement of judgments, Regulation 44/2001 and the Lugano Convention not only regulate jurisdiction but also the recognition and enforcement of each other's judgments. Decisions rendered by courts on the basis of one of the common jurisdiction rules consequently have to be basically recognised by the other contracting states of the instruments without any special recognition proceedings (*ipso iure* recognition)¹⁰³⁵.

It is therefore important that the court recognising the judgment is not allowed to check whether its law was applied from its legal viewpoint¹⁰³⁶. This follows from the fact that the effect of a decision by a state in which Regulation 44/2001 or the Lugano Convention is applicable is as if a court of the home state has rendered it¹⁰³⁷, which is certainly also one of the basic ideas of the recognition and enforcement agreements.

¹⁰³³ Cf. Nygh/Pocar, 77; Gottwald, 231.

¹⁰³⁴ Cf. critics of Walter G., Kampf and Schütze, 1036-1037.

¹⁰³⁵ Cf. Walter G., *Zivilprozessrecht*, 435-436; Kropholler, *Europäisches Zivilprozessrecht*, vor Art. 33, N 2.

¹⁰³⁶ Cf. Art. 36 Regulation 44/2001, i.e. Art. 34(3) Lugano Convention.

¹⁰³⁷ Cf. also Kropholler, *Europäisches Zivilprozessrecht*, vor Art. 33, N 9.

A refusal of recognition among the states in which Regulation 44/2001 or the Lugano Convention is applicable may only be based on one of the grounds listed in Articles 34 and 35 Regulation 44/2001, i.e. Articles 27 and 28 of the Lugano Convention. There are two important grounds for refusal of recognition:

- First, if a decision rendered is based on jurisdiction exclusively given to another court as, for example, grounded in Article 22(4) Regulation 44/2001, i.e. Article 16(4) Lugano Convention.

Under these provisions and as mentioned earlier, actions in regard to the registration or validity of patents must be dealt with exclusively before the courts where the registration or deposit has taken place. On the basis of the ECJ's decision in *GAT v Luk*¹⁰³⁸ it is therefore possible to refuse recognition of an infringement judgment rendered by a court of a state in which Regulation 44/2001 or the Lugano Convention is applicable if it decided the incidentally mounted question of the validity of a foreign patent or a foreign part of a European patent.

- Second, recognition may be refused if it would be contrary to public policy in the state in which recognition is sought.

This ground for refusal of recognition is, however, applicable only in extreme cases¹⁰³⁹.

Judgments do not only have to be recognised *eo ipso*, but basically also have to be enforced without any complicated exequatur proceedings. Regulation 44/2001 and the Lugano Convention basically do not allow the examination of whether the court correctly applied the jurisdiction rules¹⁰⁴⁰. The judgment rendered in a foreign state - possibly applying the law of the recognising state - is therefore treated as a decision rendered by a court in the latter state.

¹⁰³⁸ Cf. §3 C.VI.1.b)bb)aaa)i) Analysis.

¹⁰³⁹ Cf. *Jenard, Report*, 42-43; among others *Horst Ludwig Martin Hoffmann v Adelheid Krieg*, ECJ February 4, 1988 (case 145/86) and *Régie nationale des usines Renault SA v Maxicar SpA and Orazio Formento*, ECJ May 11, 2000 (case C-38/98).

¹⁰⁴⁰ For the US cf. *Halberstam*, 240-242; 244.

D. *Forum shopping* and the ECJ¹⁰⁴¹

I. The ECJ's position

In *Handelskwekerij G.J. Bier v Mines de Potasse d' Alsace*¹⁰⁴² the ECJ held that the rule of special jurisdiction in the Brussels Convention, the choice of which is a matter for the plaintiff, is based on the existence of a particularly close connecting factor between the dispute and courts other than those of the state of the defendant's domicile which justifies the attribution of jurisdiction to those courts for reasons relating to the sound administration of justice and the efficacious conduct of proceedings.

Taking into account the close connection between the component parts of every sort of liability, the meaning of the expression "place where the harmful event occurred" in Article 5(3) Brussels Convention would have to be interpreted flexibly and would consequently include the place where the damage has taken place (*forum delicti*), as well as the place of the damage-causing effect (*forum delicti commissi*).

In *Effer SpA v Hans-Joachim Kantner*¹⁰⁴³ the ECJ still pointed out that the Brussels Convention provides a collection of rules which are designed *inter alia*

"...in the interests of legal certainty and for the benefit of the parties, [to] confer jurisdiction upon the national court territorially best qualified to determine a dispute."

However, in *Shevill and others v Presse Alliance*¹⁰⁴⁴ it made clear, as mentioned earlier, that the courts in the place where the damage arises are most appropriate to decide upon the harm done to the victims' reputation within their judicial districts and to determine the extent of damages. Therefore, a court of a state in which the Brussels Convention is applicable is only capable of deciding on the damages that occurred in that state.

¹⁰⁴¹ The judgments of the ECJ are not binding on the EFTA states participating in the Lugano Convention, see n. 1001.

¹⁰⁴² *Handelskwekerij G.J. Bier v Mines de Potasse d' Alsace*, ECJ November 30, 1976 (case 21/76); also cf. *Shevill and others v Presse Alliance*, ECJ March 7, 1995 (Rec. 1995, PI-415; case C-68/93) and *Marinari v Lloyds Bank*, ECJ September 19, 1995 (case C-364/93).

¹⁰⁴³ *Effer SpA v Hans-Joachim Kantner*, ECJ March 4, 1982 (case 38/81).

¹⁰⁴⁴ *Shevill and others v Presse Alliance*, ECJ March 7, 1995. (Rec. 1995, PI-415; case C-68/93).

The adoption of such a criterion precludes the occurrence of concurrent litigation in different *fora*, since the compensation for each of them is restricted to the damage arising within their respective judicial districts¹⁰⁴⁵. This jurisdiction makes *forum shopping* clearly less attractive¹⁰⁴⁶.

The restriction of *forum shopping* was continued by the ECJ when interpreting Article 6(1) Brussels Convention (joinder of multiple defendants)¹⁰⁴⁷.

In *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst & Co.*¹⁰⁴⁸ the ECJ made it clear that derogations, based on Article 6(1) Brussels Convention, from the principle that the courts of the state in which the defendant is domiciled are to have jurisdiction must be construed in such a way that there is no possibility of the very existence of that principle being called in question, in particular by allowing a plaintiff to make a claim against a number of defendants with the sole purpose of ousting the jurisdiction of the courts of the state where one of those defendants is domiciled. For Article 6(1) Brussels Convention to apply, there must exist between the various actions brought by the same plaintiff against different defendants a connection of such a kind that it is expedient to hear and determine the actions together to avoid the risk of irreconcilable judgments resulting from separate proceedings.

This case law was later codified in Article 6(1) Regulation 44/2001.

This restrictive view of Article 6(1) Brussels Convention was further increased in the above-mentioned decision *Roche Nederland BV v Primus*¹⁰⁴⁹ where the ECJ decided that the provision is not applicable if a plaintiff would like to sue a number of defendants domiciled in those states where the different parts of a European patent take effect in respect of acts committed in their territory. It held that it would give the defendant a wide choice, thereby encouraging the practice of *forum shopping* which the Brussels Convention would seek to avoid if it accepted the applicability of the provision to this case.

¹⁰⁴⁵ See *Straus, Glimmer*, 411.

¹⁰⁴⁶ Cf. *Mousseron/Raynard/Véron*, 893; *Kropholler, Europäisches Zivilprozessrecht*, Art. 5, N 75; *de Wit*, 226; *Stauder/Kur*, 155. Cf. also the critical remarks in *Hess/Pfeiffer/Schlosser*, N 212-214.

¹⁰⁴⁷ Cf. *Guidicelli*, 30-31; *Wadlow*, N 2-62; *Straus, Glimmer*, 412; also cf. *Brinkhof, de Ranitz*, 143.

¹⁰⁴⁸ *Athanasios Kalfelis v Bankhaus Schröder, Münchmeyer, Hengst & Co.*, ECJ September 29, 1988 (case 189/87).

¹⁰⁴⁹ Cf. §3 C.VI.1.b)aa) Development and current situation with regard to Article 6(1) Reg 44/LC.

A qualified connecting factor is also required by the ECJ with regard to the jurisdiction of provisional measures (Art. 24 Brussels Convention, i.e. Art. 31 Regulation 44/2001). In *Van Uden Maritime BV v Deco-Line*¹⁰⁵⁰ the court held that, on a proper construction,

"the granting of provisional or protective measures on the basis of Article 24 of the Brussels Convention is conditional on, inter alia, the existence of a real connecting link between the subject-matter of the measures sought and the territorial jurisdiction of the contracting state of the court before which those measures are sought. A measure ordering interim payment of a contractual consideration does not constitute a provisional measure within the meaning of Article 24 of the Brussels Convention unless,

- first, repayment to the defendant of the sum awarded is guaranteed if the plaintiff is unsuccessful as regards the substance of his claim, and

- second, the measure sought relates only to specific assets of the defendant located or to be located within the confines of the territorial jurisdiction of the court to which application is made."

The ECJ obviously tries to avoid a "provisional measure shopping and running"¹⁰⁵¹ in the area in which the Brussels Convention is applicable. The transfer of the Brussels Convention to Regulation 44/2001 did not change these views.

The limitation of the national courts with regard to cross-border jurisdiction as provided in *Gasser v MISAT*¹⁰⁵², *Turner v Grovit and others*¹⁰⁵³, and *GAT v Luk*¹⁰⁵⁴ by the ECJ has an additional restricting impact on *forum shopping*.

II. Conclusion of the ECJ jurisprudence

The ECJ takes a restrictive position in regard to *forum shopping*¹⁰⁵⁵. It made clear in its judgments that the special jurisdiction of the Brussels Convention - Regulation 44/2001 - has to be interpreted restrictively and to be applied under qualified conditions. It thereby

¹⁰⁵⁰ *Van Uden Maritime BV, trading as Van Uden Africa Line v Kommanditgesellschaft in Firma Deco-Line and Another*, ECJ November 17, 1998 (case C-391/95).

¹⁰⁵¹ Cf. *Walter/Walther*, 14.

¹⁰⁵² *Erich Gasser GmbH v MISAT Srl.*, ECJ December 9, 2003 (case C-116/02).

¹⁰⁵³ *Turner v Grovit and others*, ECJ April 27, 2004 (case C-159/02).

¹⁰⁵⁴ *GAT Gesellschaft für Antriebstechnik v LuK Lamellen und Kupplungsbau Beteiligungs GmbH & Co. KG*, ECJ July 13, 2006 (case C-4/03).

¹⁰⁵⁵ Cf. *Straus, Glimmer*, 410.

has to ensure that the defendant may basically benefit from the protection rules as provided for in the Convention.

In addition, the judgments as regards the limitation of the cross-border jurisdiction of national courts also stipulate that the ECJ basically does not accept the interference of national courts in the jurisdiction of other national courts, and thus in the sovereignty of another state. This view is based on the declared mutual trust in the administration of justice in the European Union¹⁰⁵⁶.

This policy decision seems to be surprising in a Europe where boundaries are disappearing more and more, and where such interaction could, in fact, support the creation of a unified legal area in the common market. However, the ECJ seems to feel that progressively narrowing down the national courts' judicial capacities is a better measure for working towards the creation of an area of freedom, security and justice and, in relation to this, guaranteeing the proper functioning of the internal market¹⁰⁵⁷.

The less the cross-border authority of the national courts, the greater the desire and necessity to create a unified civil judicial system including a common court and harmonised civil proceedings.

The limitation of national jurisdiction will therefore continue in that regard, as the court seems to share the opinion of Advocate General Philippe Léger in *Roche et al. v Primus* that the current system of fragmentation of jurisdiction with regard to infringement disputes concerning European patents could only be solved in the context of the negotiations for an EPLA or a Community patent¹⁰⁵⁸.

In any case, this kind of jurisprudence will intensify the necessity for a common patent court.

¹⁰⁵⁶ Cf. also Regulation 44/2001, recital 16.

¹⁰⁵⁷ Cf. Art. 61(c) EC Treaty 65 EC Treaty. Cf. also recital 1 of Regulation 44/2001.

¹⁰⁵⁸ Cf. Opinion of 8 December 2005 in *Roche Nederland BV v Primus et al.*, ECJ July 13, 2006 (case C-539/03), N 140 to N 143.

E. Conclusions concerning cross-border *forum shopping* in Europe

I. General

It is undisputed that a certain competition among different courts having jurisdiction may be good¹⁰⁵⁹ and may lead to specialisation¹⁰⁶⁰ - an important aspect, not least in patent litigation. The consequence is higher quality of speed¹⁰⁶¹, costs and decisions¹⁰⁶². It does not seem exaggerated to say that, in that sense, the entire European patent system could benefit in the end. However, there are mainly constitutional and democratic reservations to be noted with regard to boundless *forum shopping* in an environment of growing internationalisation in patent litigation:

- First, *forum shopping* leads not only to specialisation but also to a lack of experience on the part of certain courts if too many courts are designated to have jurisdiction in relation to the number of cases occurring. Legal certainty and trust in the system therefore suffers.

- Second, a major general problem of *forum shopping* is that it may make jurisdiction inconsistent¹⁰⁶³ and highlights a situation where judicial decisions are not the inevitable product of logical and neutral¹⁰⁶⁴ process, but rather a function of social forces¹⁰⁶⁵. The choice of a court based on its practice may therefore create a negative popular perception of the equity of the legal system¹⁰⁶⁶ and, instead of accepting fate, *forum shoppers* appear to "cheat" by predicting which forum is likely to provide the desired relief before selecting it¹⁰⁶⁷.

- Third, *forum shopping* may lead to a situation in which plaintiffs may take control of substantive (patent) law by choosing courts which construe the law in the desired way. In combination with cross-border injunctions, this may lead to the possible imposition of a

¹⁰⁵⁹ Cf. *Willems, First instance*, 394; *Bodoni*, 31; *Ebbink, Fire-Side*, 258.

¹⁰⁶⁰ Cf. *Schade, Streitregelungssystem*, 837; *Jenkins*, 28.

¹⁰⁶¹ Cf. *Tilmann, Gemeinschaftspatent*, 385.

¹⁰⁶² Cf. Report of the House of Lords Select Committee on the European Communities: A European Community Patent (1986); App. 3, para. 12 quoted in: *Wadlow*, N 5-153 and §2 Specialised national courts.

¹⁰⁶³ Cf. *Ferrari*, 374 with reference to Hart, *The Concept of Law*, Oxford 1961, 155.

¹⁰⁶⁴ Cf. *Laddie, de Ranitz*, 530.

¹⁰⁶⁵ Cf. *Notes*, 1686.

¹⁰⁶⁶ See *Notes*, 1684 and cf. *Ferrari*, 374.

¹⁰⁶⁷ Cf. *Notes*, 1688; also cf. Report of the House of Lords Select Committee on the European Communities: A European Community Patent (1986); App. 3, para. 12 quoted in: *Wadlow*, N 5-153.

national view on another state on a certain point of law at issue¹⁰⁶⁸.

- Fourth, it is a fact that the plaintiff is in a better position in regard to *forum shopping*¹⁰⁶⁹.

It cannot be denied that the principles of a fair procedure and an equal footing imply that the chances for both parties to enforce their rights¹⁰⁷⁰ are the same and that the same number of courts providing justice is offered to both sides¹⁰⁷¹. From a legal policy perspective¹⁰⁷², however, balanced chances should not end with the possibility of providing both potential parties with the same right, and equal terms, to race to the court that then renders a decision that fulfils the expectations of the plaintiff¹⁰⁷³. They should also imply that both parties have a right to a well-balanced judgment¹⁰⁷⁴ and legal certainty after the court has been chosen.

It is the basic view in the Roman-law-influenced states that justice has to be found at the domicile of the defendant: *actor sequitur forum rei*¹⁰⁷⁵. The advantage of the plaintiff being able to choose whether and when he would like to attack the defendant provides the defendant with the possibility of at least being able to go to the court at his domicile¹⁰⁷⁶, that is to say theoretically the court he knows best, his so-called natural forum.

The defendant is typically in a weaker position¹⁰⁷⁷, not least also because courts in general cannot render *anti-suit injunctions* possibly to protect the defendant. This view is, furthermore, underlined by the fact that the possible pre-emptive strike of a potential defendant with declaratory relief is more limited in many states, as mentioned earlier, and in the end the chances are unequal for both sides in that regard¹⁰⁷⁸.

However, a balanced legal approach also makes it necessary for the right holder to have a

¹⁰⁶⁸ It could, however, also provoke a deeper consideration of the foreign judgment and contribute to further uniformity of European patent law, cf. §6 E. Cross-border injunctions.

¹⁰⁶⁹ Cf. also *Tilmann, Gemeinschaftspatent*, 385.

¹⁰⁷⁰ Cf. *Habscheid*, 17.

¹⁰⁷¹ Cf. *Kropholler, FS*, 166-167.

¹⁰⁷² Cf. *Kropholler, FS*, 169.

¹⁰⁷³ Cf. also *Stohr*, 6.

¹⁰⁷⁴ Cf. also *Habscheid*, 17.

¹⁰⁷⁵ Cf. e.g. *Gardella/Radicati di Brozolo*, 613.

¹⁰⁷⁶ Cf. *Walter G., Kampf; Kropholler, FS*, 168.

¹⁰⁷⁷ Cf. *Franzosi, Stay*, 158; *Lundstedt*, 142.

¹⁰⁷⁸ Cf. *Kropholler, FS*, 168.

court available where he may legitimately enforce his right in a way that provides for legal certainty. It often happens in practice that a small company infringes a patent and literally disappears before the patent holder can react with court orders; or it simply challenges validity in order to force the big company to conclude a "friendly" settlement¹⁰⁷⁹. Larger companies tend to have greater exposure and, merely because the patent holder is financially strong, that does not mean that he should be procedurally in a weaker position than the defendant¹⁰⁸⁰. A defendant may therefore need as much protection from a plaintiff¹⁰⁸¹ as a plaintiff does from a defendant, and sometimes mutual protection is even necessary for both of them. The ECJ, nevertheless, decided that protection of an injured party was not an objective of Article 5(3) Brussels Convention¹⁰⁸².

Furthermore, defendants are often big international holding companies having their seat chosen on the basis of a tax analysis. To appear in front of a court "abroad" therefore seems of no great importance, as is the case for many enterprises that are active in several European states. Neither does a party have the right to request that its mother tongue becomes the language of proceedings in front of a foreign court. This fact also questions the approach of the ECJ that a court of a state in which the Brussels Convention (Regulation 44/2001) is applicable is only capable of deciding on the damages that occurred in that state (so-called "Shevill doctrine"¹⁰⁸³) and not on the entire damage caused, if the damage is caused by such a company¹⁰⁸⁴.

- Fifth, the ECJ clearly held what in fact the object of the Brussels Convention is:

The determination of the court which has jurisdiction in disputes relating to civil and commercial matters in relations between the contracting states and the facilitation of the enforcement of judgments¹⁰⁸⁵.

It also held that

¹⁰⁷⁹ Cf. Phillips Jeremy, How to enforce rights in the new Europe, managing IP, March 2004, 66-70, 68.

¹⁰⁸⁰ Cf. also *Harms*, 487.

¹⁰⁸¹ Cf. *Lundstedt*, 149; *Franzosi*, *Stay*, 158.

¹⁰⁸² Cf. *Lundstedt*, 142.

¹⁰⁸³ Cf. §3 C.VI.1.a) Cross-border injunctions based on Article 5(3) Reg 44/LC.

¹⁰⁸⁴ Cf. also criticisms by *Stauder/Kur*, 155-156.

¹⁰⁸⁵ *Hagen v Zeehaghe*, ECJ Judgment of the Court (First Chamber) December 12, 1989 (case 365/88); also cf. *Duijnste v Goderbauer*, ECJ November 15, 1983 (case 288/82).

"...It is also common ground that the Convention [thereby] seeks to ensure legal certainty by allowing individuals to foresee with sufficient certainty which court will have jurisdiction"¹⁰⁸⁶.

This view is also applicable to Regulation 44/2001. However, one can hardly say that this should make it possible to choose a court because it has no experience (in patent law), because it may block another court from dealing with the case¹⁰⁸⁷, or because it pays higher damages. Additionally, the threat or the use of a special forum as a "blackmailing" tool by a possible infringer and other such improper attempts at *forum shopping* cannot be part of a legal instrument.

All of this makes it clear that a balanced approach to the problem is necessary: *ius est ars boni et aequi*.

II. Possible solution to the problems related to cross-border *forum shopping*

1. Limitation of the number of courts

A first step towards a balanced solution and the assurance of legal certainty would be to limit the number of courts having jurisdiction in Europe - if necessary - and to adjust the necessary procedures to provide for the right speed. A very important aspect in that regard would be to set the number of courts in relation to the number of cases occurring. It is, however, not an easy task to determine this exact ratio, not least with regard to patent litigation.

The Commercial Court of Zurich could, however, be a good reference point, since it decides a rather small number of patent cases but still has a good international reputation. Between 1998 and 2000 just over seven patent cases - including requests for preliminary measures - were initiated each year¹⁰⁸⁸.

A limitation of the number of courts would, however, also lead to the parties involved having to travel further. One could therefore argue that access to justice and the protection

¹⁰⁸⁶ *Erich Gasser GmbH v MISAT Srl.*, ECJ December 9, 2003 (case C-116/02).

¹⁰⁸⁷ Cf. *Pitz, Forum blocking*, 24.

¹⁰⁸⁸ Cf. Heinrich Peter in: *Hilti*, 288.

of the defendant, allowing him to be sued at the place of domicile or seat, is not guaranteed any more. Solutions to this risk have already been shown above¹⁰⁸⁹.

2. Detailed check of a court's own jurisdiction

In addition to the above, consideration could be given to amending Regulation 44/2001 and implementing a limited *forum non conveniens* doctrine: the national courts could be given the authority, in pending cross-border cases, to consider more carefully, on their own motion or on request, whether they are the most suitable to decide the case, taking into account the situation and the interests of the parties and (very importantly) the factor connecting the case to the specific court¹⁰⁹⁰.

The reflections of the court may be very detailed and include thoughts concerning not only the appropriate access of the parties to the court but also the financial burden¹⁰⁹¹, efficiency with regard to access to evidence, the applicable law and possibly the accuracy of applying foreign law¹⁰⁹², the different practice on damages, etc. The courts should also prevent the defendant from trying to move the case to a court that seems less affected by the claim¹⁰⁹³ and exercise caution so that the defendant is not put at an advantage, possibly seeking to avoid his obligations. In addition, the court seised should also take into account whether the alternative court is likely to render its judgments within a reasonable time¹⁰⁹⁴. A balanced approach would make it necessary for the court to be able to refuse a request by a party to refer the case to a particular court¹⁰⁹⁵.

These reflections should, however, not only be a matter for the court first seised but possibly also for a court second seised. Communication among the courts on these questions would therefore be a necessity. A simple declaration by one of the courts that the foreign proceedings are vexatious or oppressive would not be sufficient to protect its

¹⁰⁸⁹ Cf. §2 A.II. Dealing with those risks.

¹⁰⁹⁰ Also cf. *Lundstedt*, 149-150; *Lowenfeld*, 321.

¹⁰⁹¹ In *Turner v Grovit and others*, 2002 All E.R., 960, an anti-suit injunction was rendered by British courts because the foreign action was brought in bad faith, not for the purpose of obtaining relief, intended to wear down the other party financially only, cf. *Ho*, 705; *Ambrose*, 405.

¹⁰⁹² Cf. also *Fentiman*, *Foreign law*, 280-287.

¹⁰⁹³ See *Halberstam*, 243.

¹⁰⁹⁴ Cf. also principle 4.3(f) *ILA, Leuven/London principles* and principle 2.6 *ALI/UNIDROIT, Principles Civil Procedure*.

¹⁰⁹⁵ Cf. also *McGuire, Forum Shopping*, 90.

own jurisdiction, possibly in the interests of the plaintiff¹⁰⁹⁶. Such an *anti-suit injunction* would not be permitted under Regulation 44/2001¹⁰⁹⁷.

The legal expression "equity"¹⁰⁹⁸ might be quite a close description of this situation.

The adoption of such minimal discretion of the courts¹⁰⁹⁹ in an environment of increasing international litigation must not, however, lead to greater lack of predictability¹¹⁰⁰ and legal certainty than today, as generally provided for by Regulation 44/2001 with respect to jurisdiction¹¹⁰¹. This also makes it clear that a court would have no discretion concerning its jurisdiction if it has *exclusive* jurisdiction based on Regulation 44/2001. In addition, a court could not deny jurisdiction if the parties chose the court on the basis of a choice of court agreement or if both parties wish the court to deal with the case even after it presented its considerations as to whether it is the most suitable to decide the case.

A court must be and is allowed to construe jurisdiction provisions¹¹⁰² as it does in regard to substantive law. In every case, a court must reflect upon the values the legislator wants to protect when interpreting a provision. Every court moves in a general legal framework which is protecting basic (procedural) rights of the parties. This framework surrounds all other laws and treaties and has to be observed by the courts in every single case. Justice is neglected if at all times a simple systematic approach prevails over all other basic objective considerations and reasonableness¹¹⁰³.

¹⁰⁹⁶ Cf. *Briggs*, 441-442.

¹⁰⁹⁷ Cf. §3 C.III.2. Anti-suit injunctions. Cf. however, *Schmidt*, 497-498 who pleads for a transnational application of anti-suit injunctions in order to strengthen the competitiveness of the European judicial system, and not least to limit *forum shopping*.

¹⁰⁹⁸ "Justice administered according to fairness as contrasted with the strictly formulated rules of common law" (Black's Law Dictionary, 6th edition, St. Paul 1990).

¹⁰⁹⁹ Cf. The need for such discretion of the courts in international litigation is also reflected in the Principles of Transnational Civil Procedure, where it is recommended that the court second seised should decline or suspend jurisdiction when the dispute is previously pending in another court competent to exercise jurisdiction, "unless it appears that the dispute will not be fairly, effectively, and expeditiously resolved in that forum (cf. 2.6 ALI/UNIDROIT, *Principles Civil Procedure*).

¹¹⁰⁰ Cf. Regulation 44/2001, recital 11.

¹¹⁰¹ Cf. *v.Meibom/Pitz, Limitations*, 600.

¹¹⁰² Cf. also *Schmidt*, 494.

¹¹⁰³ Cf. also *Hartley, Conflict of laws*, 820; 827-828.

In certain cases it will therefore also be necessary for the court to breach the principle that the issue of jurisdiction must be decided without an analysis of the merits¹¹⁰⁴, to be able to judge whether it was only contacted by the plaintiff possibly to harass or oppress the defendant¹¹⁰⁵ or for any other unjustified reason.

If all circumstances point to a more appropriate forum which better ensures the right of access to justice¹¹⁰⁶, the plaintiff will typically fail to justify the chosen forum¹¹⁰⁷. Such an approach would also seem to take better into account the obligation of Article 41(2) TRIPs Agreement to guarantee fair and equitable procedures¹¹⁰⁸.

Mutual trust in each other's legal system as requested by the EU and EFTA member states and the ECJ also includes trust in the courts to decide on an abuse of process and where the chances for a fair trial and for justice can be achieved best with regard to a particular case. In addition, the necessity for communication among the courts involved would further improve good relations among the states and their courts and increase understanding of each other's legal system.

3. Danger of negative competence conflicts?

Providing a court with discretionary powers concerning its jurisdiction implies a certain danger of possible negative competence conflicts. They could, as suggested above, easily be prevented if the court where the action is filed cooperates and communicates with the other court that might have jurisdiction over the matter.

Cooperation among the courts and the possible transfer of the case from one court to another in a state already exist in many states¹¹⁰⁹ if the different stages of a case are dealt with before several national courts or the same case is dealt with from a criminal and civil

¹¹⁰⁴ Cf. *Gardella/Radicati di Brozolo*, 627 with reference to *Martin Peters Bauunternehmung GmbH v Zuid Nederlandse Aannemers Vereniging*, ECJ March 22, 1983 (case 34/82).

¹¹⁰⁵ Cf. also *Blum C.*, 77; *Ho*, 704.

¹¹⁰⁶ Cf. also *Walther*, 420.

¹¹⁰⁷ Cf. also *Blum C.*, 79.

¹¹⁰⁸ Cf. *Straus, Fair*, 810-811.

¹¹⁰⁹ Cf. *McGuire, Forum Shopping*, 84.

point of view. Regulation 2201/2003, which concerns judgments in matrimonial matters¹¹¹⁰, may in fact serve as a prominent example of a *European* reference system between courts of different states.

On the basis of Article 15(2) of the Regulation, a case can be transferred "cross-border" to a court better placed to hear the case where it is in the best interests of the child and if further requirements are met.

Deepened international judicial cooperation in the area of jurisdiction could certainly only be successful if it is ensured that jurisdiction is always examined at the beginning of the procedure, if the necessary balance of trust and respect among the courts with equal concerns¹¹¹¹ could be established, and if the courts would be willing to treat such cases with the necessary efficiency. This would certainly also imply that a court contacted by another court could refuse to accept the jurisdictional proposal made by the first court if it did not share the view of being more suitable to deal with the case. The other court would then be bound by this decision. There would be no risk of conflicting decisions and no interference in the sovereignty of another state. This was one of the major reasons why the possibility of referring a case from one court to another in cross-border litigation was not implemented into Regulation 44/2001¹¹¹².

A contra-argument that could be put forward with regard to this proposed system could be that the proceedings might become slower and more expensive. This seems to be unfounded, however, since the jurisdiction question is often an issue anyway, not least in patent litigation.

4. Principles of judicial cooperation between courts

The reference to another court should be based on simple principles. They must ensure not only the necessary (legal) certainty and predictability, but also transparency¹¹¹³.

¹¹¹⁰ Council Regulation (EC) No. 2201/2003 of 27.11.2003 on the jurisdiction, recognition and enforcement of judgments in matrimonial matters and in matters of parental responsibility, repealing Regulation (EC) No. 1347/2000.

¹¹¹¹ Cf. also *Ho*, 717-720.

¹¹¹² Cf. *McGuire*, *Forum Shopping*, 84.

¹¹¹³ Cf. Regulation 44/2001, recital 11.

The so-called "Leuven/London Principles on Declining and Referring Jurisdiction in Civil and Commercial Matters"¹¹¹⁴ of the Committee on International Civil and Commercial Litigation of the International Law Association (ILA) seem a promising way forward and highlight ways that could be used for a common European "jurisdiction communication" instrument.

The principles were basically created to tackle the problems in regard to *forum shopping*, jurisdiction clauses, *lis pendens*, *forum non conveniens* and anti-suit injunctions, and were designed to be capable of direct application within national legal systems. The principles are predicated on an enhanced degree of cooperation between the courts, but they are nevertheless "party-driven", that is to say the court may basically only act on a respective application at the outset of the proceedings.

Where the court communicates directly with the alternative court on its own motion, it has to give reasonable notice to the parties of its intention to do so, and hear the parties on the information to be sought¹¹¹⁵. The court would consequently regularly have to limit the proceedings to this preliminary question.

The alternative court will remain free to decide whether it has jurisdiction. If it decides that it has not, the first court seised may lift any suspension of its own proceedings and possibly resume jurisdiction over the merits¹¹¹⁶. However, if the contacted court agrees, the court first seised transmits the file and proceedings continue before the new court.

5. Conclusion

Mainly civil-law countries are very reluctant in regard to any kind of implementation of a practice along the lines of *forum non conveniens* doctrine. However, the proposed solution seems to be the most promising way that all the arguments concerning the use and abuse of *forum shopping*, as well as the possibly necessary protection of the weaker party, may be taken into consideration and a fair and balanced decision rendered which is in the interests of the parties and results in justice.

¹¹¹⁴ Cf. *ILA, Leuven/London principles*.

¹¹¹⁵ See principle 5.2 *ILA, Leuven/London principles*.

¹¹¹⁶ See principle 5.8 *ILA, Leuven/London principles*.

The approach would consequently be a combination of the principles of certainty, predictability and neutrality as praised by civilian legal systems¹¹¹⁷, and the *forum non conveniens* doctrine grounded in common law. In the end, the basic right of access to justice could be improved¹¹¹⁸.

As mentioned above, the implementation of this approach would require an amendment of Regulation 44/2001 – as well as the Lugano Convention, as the instruments currently leave basically no room for any discretionary powers for the courts¹¹¹⁹, and as they actually even *require* actions in regard to patents to be entertained in certain courts of the contracting states if jurisdiction is given on the basis of a provision of these instruments, and thus leave no choice to the courts¹¹²⁰.

The author is well aware that the fact that an amendment of the instruments is necessary makes it very difficult to implement the proposal.

However, the suggestion of providing the court seised with the ability to refuse to apply international private law based on the *lex fori* rule and to apply the international private law of the state, providing for a stronger jurisdiction based on the case¹¹²¹, or even its own law¹¹²², in order to reach a more balanced result, seems no less problematic.

§4 CONCLUSION IN REGARD TO THE UNIFICATION OF INTERPRETATION AND AVOIDING MULTIPLE LITIGATION BY WAY OF SPECIALISED NATIONAL COURTS AND FORUM SHOPPING

The overview made it clear that *forum shopping* is not bad *per se*¹¹²³ or a "deadly sin", as it was also considered to be¹¹²⁴. The effectiveness and legal certainty of the protection

¹¹¹⁷ Cf. *Gardella/Radicati di Brozolo*, 612; 615.

¹¹¹⁸ Cf. also *Walther*, 422.

¹¹¹⁹ Cf. *Bertrams*, 624; *Wadlow*, N 2-48; *McClellan/Morris*, 123; *de Wit*, 226; *Bucher/Bonomi*, § 5, N 179; *Jacob, Millennium*, 510; *Geimer*, N 1094b; *Haas. P.*, 198; *Stauder/Kur*, 162.; *Lowenfeld*, 318.

¹¹²⁰ Cf. *Wadlow*, N 3-02; *Lundstedt*, 103; *Gardella/Radicati di Brozolo*, 615.

¹¹²¹ Cf. *Siehr, Forum Shopping*, 140 with reference to Eckstein, Die Frage des anzuwendenden Kollisionsrechts, 1934 *RabelZ*, 121-147 and Makarov, Das Problem des anzuwendenden Kollisionsrechts, 1944 *Zeitschrift für vergleichende Rechtswissenschaft (ZVglRWiss)* 230, 233 – 235.

¹¹²² Cf. *Blum/Pedrazzini*, Art. 75, N 6.

¹¹²³ Also cf. *Ferrari*, 374; *Kur, Sackgasse*, 911; *Wadlow*, N 5-149; *Pagenberg, First instance*, 489; *Schade, Regelung*, 105; *Lupoi*, 153.

¹¹²⁴ Cf. *Bell, Forum Shopping*, N 2.05.

conferred by the European patent can be increased at the national level by allowing extensive *forum shopping* and its effect on the creation of specialised courts, and especially specialised judges.

Even then, however, there will always be courts with no or hardly any experience in patent law or patent litigation if too many courts are designated to have jurisdiction in relation to the number of cases occurring. Furthermore, *forum shopping* has a great variety of undesired side-effects, particularly when substantive and procedural law diverges within the courts having jurisdiction¹¹²⁵.

Most of these problems could be avoided at the national level, e.g. in England and Wales, Sweden and in the Netherlands, with one or two courts having territorial jurisdiction. The number of courts having jurisdiction must therefore be in a healthy relation to the number of cases occurring, to ensure good quality. Due to the limited number of patent cases in Europe, there is consequently a clear necessity for a concentration at the national level. One should also keep in mind, however, that even if jurisdiction was concentrated on one court in a state, that court would still be inexperienced if a patent case was initiated in that country only every other year.

However, even the best organisational environment is insufficient if no experienced patent judges are available¹¹²⁶. It takes a certain amount of time and a certain number of cases before one becomes acquainted with this very technical field of law¹¹²⁷. Gaining experience in patent litigation not only also depends on national procedure and the need for the judges to deal with the case in depth¹¹²⁸. Some of the courts tried to solve the problem by always appointing the same judges to their patent cases - so-called "docket management". However, even with this measure the number of patent cases must occur regularly enough to allow judges to gain experience. This applies to both legally qualified

¹¹²⁵ Cf. also the indication of one delegation in the second session of the WIPO Advisory Committee on Enforcement that the creation of specialised intellectual property courts could under certain circumstances ensure a more effective enforcement than a simple concentration of cases, cf. conclusions by the chair, WIPO/ACE/2/13, N 8.

¹¹²⁶ Cf. also *Stauder, Weg*, 479.

¹¹²⁷ Cf. *Brinkhof, Enforcement*, 172; *Belfort*, 78.

¹¹²⁸ Cf. *Stauder, Aspekte*, 623-624.

judges as well as possibly technically qualified judges involved in the case. If a judge tries a patent case only every couple of years, he or she will unavoidably have difficulties¹¹²⁹.

Another general problem with regard to experienced patent judges seems to be that there are quite a number of courts that have problems in the recruitment of judges interested¹¹³⁰ in patent cases¹¹³¹. It will therefore be necessary to make more public the fact that patent law and patent litigation want to attract more judges to that area of law. In addition, it will be important to create incentives, such as promoting the interesting nature of a position at the interface of law and technology, or the introduction of a higher salary level for judges specialised in patent law, with good prospects for promotion.

At the European level, however, none of the national systems has proved to be sufficient. Neither the creation of specialised courts nor specialisation by way of concentration has been able to ensure a uniform interpretation of European patent law or avoid multiple litigation.

Dutch courts hoped to avoid controversial decisions and multiple litigation¹¹³² regarding European patent infringement cases in a first step with cross-border injunctions, by a wide interpretation of the jurisdiction provisions of the Brussels Convention. Other states did not follow their views, however, and in part did not appreciate their interference in the authority based on the "bundle patent" approach¹¹³³. They applied the rules on jurisdiction differently and, in the case of the United Kingdom, even strictly avoided any cross-border injunctions, underlining the situation for multiple litigation on exactly parallel rights and laws¹¹³⁴, which led to legal uncertainty¹¹³⁵ while international differences in the interpretation of patent law remained unmitigated¹¹³⁶. Parties therefore also partly looked for ways of preventing possible cross-border injunctions¹¹³⁷. However, the ECJ has, in any case, put an end to cross-border jurisdiction to a great extent with its latest decisions.

¹¹²⁹ Cf. *Ryberg*, 910.

¹¹³⁰ Cf. also *Stauder, Aspekte*, 623.

¹¹³¹ Cf. *Brinkhof, Enforcement*, 172.

¹¹³² Also cf. *Stauder, Verletzungsverbote*, 320.

¹¹³³ Cf. *Stauder, Verletzungsverbote*, 319; 320.

¹¹³⁴ Cf. *Jacob, Millennium*, 512.

¹¹³⁵ Cf. *Jacob, Harmonisation*, 148; *Straus, Glimmer*; 418; *Pertegás-Sender, Cross-Border*, 10; *Haas P.*, 199.

¹¹³⁶ Also cf. Leith Philip/Chandler Adrian, *Perspectives on Intellectual Property: Harmonisation of Intellectual Property in Europe: A Case Study of Patent Procedure*, Sweet and Maxwell, London 1998, 166.

¹¹³⁷ Cf. *Franzosi, Torpedo*, 385.

The easiest solution to the different problems would be the creation of a specialised court at the European level with the necessary jurisdiction and its own procedure, ensuring speedy and legally founded judgments.

This was also the result of the discussions in the Working Party on Litigation as mandated by the Intergovernmental conferences of the EPC contracting states. A common European patent court would also be a great step forward in avoiding the negative impact of international *forum shopping*¹¹³⁸ and would help in clearing cultural hurdles.

Such a court with its procedural rules would, politically and legally speaking, be the most extensive approach and, from a sovereignty point of view¹¹³⁹, burdened with problems. Furthermore, users will have to be convinced of the compromise proposal as negotiated by the states¹¹⁴⁰.

It should therefore first be examined whether a combination of specialisation in first instance, including cooperation rules, and some other measure could possibly lead to the same outcome of a European patent court once the possible impact of Alternative Dispute Resolution on European patent litigation has been examined.

¹¹³⁸ Cf. also the conclusion of Sweden, Switzerland, UK at the second meeting of the WPL, WPL/6/00, N 16; N 63; N 137; *Laddie, de Ranitz*, 530.

¹¹³⁹ Cf. *Bossung, Grundfrage*, 81-144.

¹¹⁴⁰ See *Willems, First instance*, 395.

§5 ARBITRATION, MEDIATION AND OTHER INSTRUMENTS OF ALTERNATIVE DISPUTE RESOLUTION

A. General

Alternative Dispute Resolution (ADR) offers many different kinds of models for solving a conflict outside of the ordinary state structures of jurisdiction¹¹⁴¹. Although - or possibly because - there are no provisions on ADR in the TRIPs Agreement, it has gained increased popularity in the past decades, and even the Working Party on Litigation dealt with arbitration.

Arbitration is, next to mediation, one of the most famous models for alternatively solving a dispute¹¹⁴².

B. Arbitration

I. Introduction

Part of the mandate given to the Working Party on Litigation by the Intergovernmental conference of the EPC contracting states in Paris - under the heading of "harmonising European patent litigation" - included the task of studying under what conditions the principle of arbitration in litigation relating to validity and infringement might be acknowledged by the contracting states¹¹⁴³.

At the subsequent Intergovernmental conference of London on 16 and 17 October 2000, the conference considered that arbitration on patent litigation - including validity and infringement of patents as well as compensation - should be made more widely available. In addition, it recommended that the EPC contracting states render it possible, if necessary, for a court of arbitration to examine the validity of a patent in the event of

¹¹⁴¹ Cf. *Brown-Berset*, 343.

¹¹⁴² Some experts, however, define ADR only as models where the parties are guided to a result but which do not end in a judgment (cf. *Huber*, 104). Arbitration would thus not be part of ADR. This approach was also taken by the European Commission in its Green Paper on alternative dispute resolution in civil and commercial law of 19.4.2002, COM(2002) 196 final, N 2.

¹¹⁴³ Cf. 1999 O.J. EPO, 548.

infringement of that patent, and to accept this arbitration under the following conditions:

- Arbitration decisions would have an *inter partes* effect, it being understood that member states may give a broader effect to arbitration decisions,
- international conventions shall remain unaffected,
- arbitration should remain optional, and
- arbitration bodies should be chosen by the parties¹¹⁴⁴.

In the following, it will be studied whether arbitration in general, and, in particular under the recommended circumstances, could not only further promote harmonised conditions for arbitration among the EPC contracting states¹¹⁴⁵ but also support the unification of jurisprudence with regard to European patent law and avoid multiple litigation. However, first, arbitration will be defined and its significance in patent disputes will be explored.

II. Definition of arbitration

Arbitration could be generally defined as a procedure held before an appointed arbitrator or arbitration panel based on an agreement of the parties - instead of going to court - to render a final judgment¹¹⁴⁶. A fundamental distinction between this and state-run litigation is that arbitration is voluntary¹¹⁴⁷ and can therefore never be started until the parties agree by separate agreement - submission to arbitration - or by a clause in a contract¹¹⁴⁸.

¹¹⁴⁴ Cf. Provisional mandate and conclusions of the second Intergovernmental Conference on reform of the EPO, London, 16-17 October 2000. The mandate was, however, never published. Cf. also WPL/9/00 Add. 1 Rev. 2.

¹¹⁴⁵ The UNCITRAL Model Law on International Commercial Arbitration, adopted by UNCITRAL on 21 June 1985, was implemented into the national law of several EPC contracting states or served as a model for their international arbitration law (cf. Sanders, The making of the Convention, Enforcing Arbitration Awards under the New York Convention: Experience and Prospects, Colloquium held in the Trusteeship Council Chamber of the United Nations Headquarters, New York on 10 June 1998; Huber, 88-89; Gulliksson, 297). The Netherlands and Switzerland, for example, chose an autonomous approach (cf. Tschanz, 12).

¹¹⁴⁶ Cf. Phillips, *Enforce*, 68; Walter G., *Zivilprozessrecht*, 531; Schäfer E., 112; Niblett, Huber, 108.

¹¹⁴⁷ Cf. Kingston, 154; Geimer, N 3783. International sports associations, however, often provide for mandatory arbitration.

¹¹⁴⁸ Cf. Briner, *Arbitrability*, 1.2; Nixon, 484.

The possibility of rejecting arbitration derives¹¹⁴⁹ from the fundamental right of access to court¹¹⁵⁰. Therefore, the recognition of an arbitral decision could be refused if it is based on a clause included in a contract which was transferred to a third party who ultimately did not accept arbitration¹¹⁵¹.

Arbitration is a private jurisdiction. As part of jurisdiction, it must respect common procedural principles for a fair trial¹¹⁵², such as the right to be heard,¹¹⁵³ or a correct composition of the panel¹¹⁵⁴. As it is a private jurisdiction, it is up to the state to decide how it would like to deal with it, i.e. which subject matters could possibly be decided by arbitration, what the conditions are for an arbitration agreement, and possible recognition and enforcement of the arbitral decision - so-called "award", etc.¹¹⁵⁵

Arbitration can be divided into domestic and international arbitration.

In international arbitration, parties have their domicile or habitual residence in different states. It is therefore used in cross-border commerce.

In practice, arbitration traditionally appears in an institutional and an *ad hoc* form.

Whereas institutional arbitration is administered by a permanent arbitral body using predetermined rules¹¹⁵⁶, it will be up to the arbitrators themselves to administer the case in *ad hoc* arbitration¹¹⁵⁷. The procedure before *ad hoc* arbitration is determined by the parties in the arbitration agreement¹¹⁵⁸.

¹¹⁴⁹ Cf. *Delvolvé*, 18; *Villiger*, N 439.

¹¹⁵⁰ Cf. Art. 6 EHCR.

¹¹⁵¹ Cf. *Delvolvé*, 18-19.

¹¹⁵² Cf. *Villiger*, N 439.

¹¹⁵³ Cf. Art. V(1)(b) New York Convention.

¹¹⁵⁴ Cf. Art. V(1)(d) New York Convention

¹¹⁵⁵ Cf. *Walter G.*, *Zivilprozessrecht*, 531-532.

¹¹⁵⁶ Many of those rules are based on the UNCITRAL Arbitration Rules (cf. *Blessing*, 2).

¹¹⁵⁷ Cf. *Auf der Maur*, 53; *Walter G.*, *Zivilprozessrecht*, 536; *Schäfer E.*, 115-116; *Hochstrasser/Vogt*, 102.

¹¹⁵⁸ In many cases the parties choose the UNCITRAL Arbitration Rules, which constitute an *ad hoc* arbitration system.

The rules of procedure among the institutions resemble each other increasingly. However, the way they are applied may still differ substantially according to the seat of arbitration, i.e. if it is seated in a common law or continental law state¹¹⁵⁹.

Due to the increasing significance of global trade, in the 1970s international arbitration evolved into a very important alternative to court litigation in commercial matters¹¹⁶⁰. It has, in fact, developed into a lucrative branch of industry, and states all around the world court the potential parties with attractive and standardised arbitration laws providing for practical procedures¹¹⁶¹.

Meanwhile around two hundred¹¹⁶² international arbitration associations or special arbitration departments - mainly in chambers of commerce - have been established world-wide, including some of them specialised in certain areas of law¹¹⁶³. The most important arbitration institution is the "International Court of Arbitration" of the International Chamber of Commerce (ICC). In 2006, 593 requests for arbitration were filed with the ICC arbitration court. The amount in dispute exceeded one million US \$ in 55.5% of the new cases. 293 awards were rendered¹¹⁶⁴.

The only institution that deals, in particular, with intellectual property disputes is the WIPO Arbitration and Mediation Center¹¹⁶⁵. Like most existing permanent arbitral bodies¹¹⁶⁶, the Center has developed special applicable rules of procedure and offers a list of arbitrators and special facilities.

¹¹⁵⁹ Cf. *Tschanz*, 12-13.

¹¹⁶⁰ Cf. *Lionnet*, 603; *Briner, Reflections*, 137.

¹¹⁶¹ Cf. *Tschanz*, 12.

¹¹⁶² Cf. *Blessing*, 1.

¹¹⁶³ Cf. <www.interarbitration.net/institutions/index.asp?id=inst>.

¹¹⁶⁴ Cf. <www.iccwbo.org/court/arbitration/id11088/index.html>.

¹¹⁶⁵ Cf. <www.wipo.int/sme/en/ip_business/ip_dispute/arbitration.htm>. Cf. also *Witzenzellner*.

¹¹⁶⁶ Cf. *Walter G., Zivilprozessrecht*, 536.

III. Reasons for and against arbitration in general

1. Advantages

The reasons and promises that attract many parties to arbitration are generally listed as follows¹¹⁶⁷:

a) Arbitration is "neutral"

Arbitration is flexible and neutral with regard to the nationality of arbitrators, applicable law, venue, language and representation. All these factors are open to party agreement. It is therefore quite common, and even to be recommended, to include clear rules in the agreement on all important terms of the arbitration¹¹⁶⁸.

This wide party autonomy also makes it possible for the parties to choose autonomous commercial law such as *lex mercatoria*¹¹⁶⁹ as applicable law¹¹⁷⁰, although this has been criticised as it would give arbitrators too much discretion and arbitrary decisions might follow¹¹⁷¹. This is of particular importance as the role trade usages and general principles of law play in arbitration cannot be ignored¹¹⁷².

The wide party autonomy also provides the opportunity to avoid judges having an affinity to one party due to cultural, legal and linguistic identity. Parties could consequently feel more comfortable in the proceedings, in which both have equal rights¹¹⁷³, neither having an advantage with a possibly more familiar court system and local proceedings.

¹¹⁶⁷ Cf. WIPO Arbitration and Mediation Center, <www.wipo.int/amc/en/arbitration/why-is-arb.html>; International Chamber of Commerce, International Court of Arbitration, <www.iccwbo.org/>; Nixon, 484-485; Schäfer E., 112-114; 118; Phillips, Enforce, 68; Lionnet, 603-604; König, Konfliktlösung, 361; Niblett; Briner, Philosophy, 9; Witzenzellner, 147; Véron, ADR, Tschanz, 14; Huber, 89-90; Gulliksson, 298-299.

¹¹⁶⁸ Cf. Bowler, Cost.

¹¹⁶⁹ Cf. Smit, Choice of Law in Arbitration. For an overview cf. De Ly, 262-266. However, *lex mercatoria* plays a less important role in arbitration practice than possibly expected (cf. Dasser Felix, Lex Mercatoria - Critical Comments on a Tricky Topic, Jusletter 6. Januar 2003, <www.jusletter.ch>).

¹¹⁷⁰ With regard to the difficulties in choosing the applicable law in an arbitration agreement cf. Abbott/Cottier/Gurry, 1738-1739; concerning the problems of applying autonomous commercial law and private law in arbitration cf. Sonnenberger Hans Jürgen, "... an Gesetz und Recht gebunden...", IPR und private Rechtsetzung vor dem Richter, Grenzüberschreitungen, Beiträge zum Internationalen Verfahrensrecht und zur Schiedsgerichtsbarkeit, Festschrift für Peter Schlosser zum 70. Geburtstag, Bachmann Birgit/Breidenbach Stephan/Coester-Waltjen Dagmar/Hess Burkhard/Nelle Andreas/Wolf Christian (eds.), Tübingen 2005, 921-937, 925-937 and Smit, Choice of Law in Arbitration.

¹¹⁷¹ Cf. De Ly, 301.

¹¹⁷² Cf. De Ly, 266; 288.

¹¹⁷³ Cf. Schweyer, 156.

The opportunity to opt for a deciding body which is fully neutral - not necessarily independent, though - is seen as one of the greatest advantages over ordinary jurisdiction.

However, the proceedings also seem easier and more comfortable for the parties if they can choose and even have an influence on them. The level of acceptance of the judgment could therefore improve.

One could argue that the parties could also choose a court of a state having no connection with the parties, based on a choice of court agreement as provided for in Article 23 Regulation 44/2001 and Article 17 Lugano Convention, if neutrality is a problem. However, most courts would deny jurisdiction if there is no connection with the proceedings and the state of the chosen forum¹¹⁷⁴.

This situation could change in the future with the new Hague Convention on Choice of Court Agreements (HCC), which will be applicable to international cases¹¹⁷⁵ in civil or commercial matters.

The opportunity for the parties to select the venue and applicable law in arbitration also makes it possible to avoid lengthy debates on issues of jurisdiction.

b) Freedom of choice concerning arbitrators

In arbitration, the parties themselves appoint the arbitrator(s) and are not committed to predetermined schedules and judges, as is the case in ordinary civil proceedings. Confidence in the decision of the jurisdiction could consequently improve.

c) Highly specialised bodies and fewer language problems

Arbitrations can be highly specialised. Since the parties themselves choose the arbitrators, they have the possibility of designating highly qualified people in the legal, business and technical sectors concerned. This gives the parties the opportunity to select arbitrators who are bilingual, or even multilingual.

¹¹⁷⁴ Cf. *Lionnet*, 605.

¹¹⁷⁵ Based on the HCC a case is international unless the parties reside in the same contracting state, and the relationship of the parties and all other elements relevant to the dispute, regardless of the location of the chosen court, are connected only with that state (cf. Art. 1(2) HCC).

Translations and interpretation costs could therefore be avoided or reduced if the arbitrators are chosen wisely. In addition, these language abilities will also be important for an arbitrator in understanding the case and in formulating his own ideas and opinions, and possibly in convincing the other arbitrators of his stance on the issues¹¹⁷⁶.

d) Confidentiality

Since arbitration is a private system, it is also up to the parties to decide how much publicity they want to give to their case¹¹⁷⁷.

Generally, arbitration is confidential, i.e. the existence of the arbitration, the proceedings and the result are not made public. Often parties also agree mutually to maintain absolute secrecy.

Confidentiality has the great advantage of keeping delicate business information secret. This is very important, not least with regard to patent disputes¹¹⁷⁸. The lack of confidentiality in litigation is consequently also used to threaten potential infringers with the divulgence of the details of court proceedings¹¹⁷⁹.

The confidentiality of arbitration ends when ordinary courts become involved¹¹⁸⁰. This could particularly be the case when authorities have to be contacted to enforce the arbitral award¹¹⁸¹.

e) Preserving business relationships

Another great benefit of arbitration often mentioned is that it helps to preserve ongoing or future business relationships¹¹⁸². The preservation of business relationships seems to be

¹¹⁷⁶ Cf. *Weigand*, 1094.

¹¹⁷⁷ Cf. *Lew, V. Confidentiality*.

¹¹⁷⁸ Cf. *De Ly*, 83.

¹¹⁷⁹ Cf. *Bowler, Confidentiality*.

¹¹⁸⁰ Cf. *Lew, V. Confidentiality*. This was probably also the reason for one of the rare publications of a patent arbitration result in the *LG. Philips LCD's v Chunghwa Picture Tubes* case. Several internet news stations reported that an arbitration panel in New York ruled on 24 July 2006 for Philips in a dispute over rights on side-mounting technology patents. This technology is used by almost all LCD manufacturers to improve the view. The arbitration was, however, counterfiled after LG. Philips LCD initially sued Taiwan-based Chungwha Picture Tubes. Later, LG. Philips also filed a patent infringement suit in California.

¹¹⁸¹ Cf. also *Véron, ADR*, 3.

¹¹⁸² Cf. *Schweyer*, 155-156; *Bowler*, UK Arbitration; *Stieger, Konfliktvermeidung*, 32.

much harder to achieve if a party is dragged before an ordinary court. In fact, most parties consider court action against them as a declaration of war, potentially destroying any existing and future cooperation with the opposing party¹¹⁸³.

Arbitration, by contrast, is often classed as negotiations held in an open-minded spirit among like-minded people. Parties obviously feel they are moving in a less conflict-soaked atmosphere¹¹⁸⁴, which ultimately makes it possible to safeguard the necessary trust among them.

Safeguarding business ties in the patent business is particularly important with regard to licensing agreements. Such contract-based relationships can be developed over many years. Destroying them can thus have far-reaching consequences for a company's market share and business policies.

With regard to long term-relationships, arbitration has the additional advantage that the same arbitrators can be contacted in the case of several disputes that arise out of the same contract¹¹⁸⁵. Proceedings could consequently be conducted more speedily and more efficiently, as the arbitrators are already familiar with the case.

f) Speed and efficiency

Arbitration is supposed to be faster and less expensive than litigation in courts¹¹⁸⁶. Appeals are limited - if they exist at all - and the parties may set up proceedings which make a quick and efficient handling of the case possible.

g) Enforceability

Arbitral awards are, in most cases, final and quite easy to enforce.

¹¹⁸³ Cf. Véron, *ADR*, 3.

¹¹⁸⁴ Cf. Schweyer, 156.

¹¹⁸⁵ Cf. Niblett, *Advantages of arbitration*.

¹¹⁸⁶ Cf. De Ly, 83.

The recognition and enforcement of foreign arbitral awards is, in most (European) states, guaranteed by the United Nations Convention on the Recognition and Enforcement of Foreign Arbitral Awards of 10 June 1958 - the so-called "New York Convention"¹¹⁸⁷. In addition, there are quite a number of bilateral agreements concerning the recognition and enforcement of arbitral awards among European states¹¹⁸⁸. These agreements have precedence over the New York Convention¹¹⁸⁹.

Neither Regulation 44/2001¹¹⁹⁰ nor the Lugano Convention¹¹⁹¹ is applicable in arbitration, including the recognition and enforcement of arbitral awards¹¹⁹². In fact, the broad acceptance of the New York Convention made it unnecessary to expand Regulation 44/2001 or the Lugano Convention in that regard¹¹⁹³.

Based on the New York Convention, each contracting state recognises arbitral awards as binding¹¹⁹⁴, and recognition and enforcement of the award can only be refused - excluding a "*revision au fond*" - ¹¹⁹⁵ to a limited extent, if the necessary formalities are fulfilled¹¹⁹⁶.

¹¹⁸⁷ All EU member states and EPC contracting states (with the exception of Liechtenstein) are party to the New York Convention.

¹¹⁸⁸ Cf. *Mäder*, 160, for example for Switzerland.

¹¹⁸⁹ Art. VII(1) New York Convention.

¹¹⁹⁰ Art. 1(2)(d) Regulation 44/2001.

¹¹⁹¹ Art. 1(4) Lugano Convention.

¹¹⁹² Cf. *Jenard, Report*, 13; *Schlosser, Report*, N 65; cf. also decision of the ECJ *Marc Rich & Co AG v Societa Italiana Impianti p.a.*, ECJ July 25, 1991 (case 190/89).

¹¹⁹³ Cf. *Schlosser, Report*, N 61.

¹¹⁹⁴ Cf. Art. III New York Convention.

¹¹⁹⁵ Cf. Art. V New York Convention:

"1. Recognition and enforcement of the award may be refused, at the request of the party against whom it is invoked, only if that party furnishes (to the competent authority where the recognition and enforcement is sought) proof that:

- a) The parties to the agreement referred to in article II were, under the law applicable to them, under some incapacity, or the said agreement is not valid under the law to which the parties have subjected it or, failing any indication thereof, under the law of the country where the award was made; or
- b) The party against whom the award is invoked was not given proper notice of the appointment of the arbitrator or of the arbitration proceedings or was otherwise unable to present his case; or
- c) The award deals with a difference not contemplated by or not falling within the terms of the submission to arbitration, or it contains decisions on matters beyond the scope of the submission to arbitration, provided that, if the decisions on matters submitted to arbitration can be separated from those not so submitted, that part of the award which contains decisions on matters submitted to arbitration may be recognised and enforced; or
- d) The composition of the arbitral authority or the arbitral procedure was not in accordance with the agreement of the parties, or, failing such agreement, was not in accordance with the law of the country where the arbitration took place; or
- e) The award has not yet become binding on the parties, or has been set aside or suspended by a competent authority of the country in which, or under the law of which, that award was made.

2. Recognition and enforcement of an arbitral award may also be refused if the competent authority in the country where recognition and enforcement is sought finds that:

- a) The subject-matter of the difference is not capable of settlement by arbitration under the law of that

The cross-border recognition and enforcement of arbitral awards other than among European states is consequently, in many cases, easier than in the case of judgments rendered by common national authorities.

2. Disadvantages

As in all proceedings, there are also disadvantages in arbitration. The following are regularly addressed:

a) *Not as expedient*

Arbitrations are not as expedient or as cost-effective as often thought.

Some experts and parties take the view that arbitration is in fact slower than ordinary court proceedings¹¹⁹⁷. This is due to the fact that proceedings are very much in the hands of the parties. Since an appeal against the award is not regularly possible, the parties have the tendency to extensively prolong the case, including disclosure and cross-examination of witnesses¹¹⁹⁸. At the same time, the arbitrator's power in respect of strict case management and possible sanctions is usually¹¹⁹⁹ limited¹²⁰⁰, although efforts are taken in certain arbitral institutions to improve the powers of the arbitration in that regard¹²⁰¹. Additionally, arbitrators are only human. If the case is complicated, it could even take time for an experienced arbitrator to completely understand the facts of the case¹²⁰².

There are also often delays when parties have to decide upon arbitrator(s)¹²⁰³ or when they do not pay the requested costs in advance¹²⁰⁴. Delays also occur if the parties opt for

country; or

b) *The recognition or enforcement of the award would be contrary to the public policy of that country.*"

¹¹⁹⁶ Cf. Art. IV New York Convention.

¹¹⁹⁷ For example, in the LG. Philips LCD's v Chunghwa Picture Tubes arbitration it took two years for an award to be rendered by an arbitration panel in New York.

¹¹⁹⁸ Cf. *Bowler*, Cost.

¹¹⁹⁹ In certain arbitrations the parties agree that exactly the same amount of time is given to both parties to present their case (so called "chess clock arbitration"). On the basis of such a procedure, the parties themselves decide the parts of the proceedings to which they want to give emphasis (cf. *Briner, Reflections*, 143-144).

¹²⁰⁰ Cf. *Phillips, Enforce*, 68; *Lionnet*, 604; *König, Konfliktlösung*, 352.

¹²⁰¹ Cf. *Briner, Reflections*, 140.

¹²⁰² Cf. *Tschanz*, 24.

¹²⁰³ Cf. *Schäfer E.*, 118.

¹²⁰⁴ Cf. *Briner, Reflections*, 138-139.

a panel of arbitrators instead of one single person to arbitrate, in the pursuit of greater organisational efforts¹²⁰⁵.

Arbitration is thus usually only faster if it is compared with a case before state-run jurisdiction with three tiers¹²⁰⁶.

b) Not very cost-effective

Ad hoc arbitration is usually cheaper than institutional arbitration¹²⁰⁷. However, in any case, it can be expensive¹²⁰⁸, or at least more expensive than regular court proceedings¹²⁰⁹.

This is especially the case when compared to a situation in ordinary court proceedings where the parties reach a friendly settlement at a very early stage of proceedings when the court fees are usually very limited¹²¹⁰. Lawyers and arbitrators all request fees, and there are no subsidies paid by the state, as is the case with most European civil court systems.

The problem of cost actually went as far as parties claiming an abuse of the law if a party makes use of the agreed arbitration in cases where only limited claims are at stake¹²¹¹. Additionally, introducing legal aid for arbitration if access to justice would otherwise be denied has also been considered¹²¹².

In order to increase cost predictability and transparency, several arbitral institutions have also started to offer on-line cost calculators¹²¹³, making it possible for anyone interested in arbitration to get information as to what the proceedings could approximately cost. Nevertheless, costs are difficult to predict and very much depend on the behaviour of the parties, i.e. their positions, reactions, objections, number of witnesses examined, etc.¹²¹⁴

¹²⁰⁵ Cf. *Briner, Reflections*, 138.

¹²⁰⁶ Cf. *Schäfer E.*, 118; *König, Konfliktlösung*, 361.

¹²⁰⁷ Cf. *Nixon*, 486.

¹²⁰⁸ Cf. *Nixon*, 486; *Storme*, 965.

¹²⁰⁹ Cf. *Lionnet*, 604; *Gulliksson*, 298; cf. also *Schäfer E.*, 118.

¹²¹⁰ Cf. *Gulliksson*, 298.

¹²¹¹ Cf. *Storme*, 958.

¹²¹² Cf. *Storme*, 961-962.

¹²¹³ Cf. for example <www.iccwbo.org/> or <www.swissarbitration.ch/costs.php>.

¹²¹⁴ Cf. *Tschanz*, 16.

aa) Fast-track arbitration as a possible way to tackle high costs

It is well known that many companies are disappointed with the results of arbitration these days, as their cases are not settled as fast or as cheaply as expected¹²¹⁵.

In order to tackle the problems of speed and cost, the WIPO Arbitration and Mediation Center - like others¹²¹⁶ - started to offer "expedited arbitration". It is one type of summary proceedings, and it is carried out in a shortened time frame with condensed hearings and shortened time limits and, consequently, at reduced cost. On the basis of this procedure it has already been possible for the Center to issue a final award six weeks after the proceedings started.

This procedure should only be promising if the case is relatively simple¹²¹⁷. Patent cases, however, often involve complicated technical questions. It is therefore rather debatable whether the parties could agree on such fast-track arbitration in patent disputes and, even if they did agree, whether they would not change their minds once the tight timetable has been presented by the arbitrators¹²¹⁸.

c) Lack of arbitrator autonomy

Parties consider the freedom to appoint "their" arbitrator to be a quintessential aspect of arbitration¹²¹⁹. Although it is a precondition in any legal procedure - even in arbitration - that the judges are impartial and independent¹²²⁰, there is a certain danger that party-appointed arbitrators may act as representatives¹²²¹. This risk exists not least because arbitrators are often well paid,¹²²² and therefore there is the imminent desire to be re-appointed for future cases¹²²³.

¹²¹⁵ Cf. *Tschanz*, 15.

¹²¹⁶ Cf. Geisinger Elliott, *The Expedited Procedure under the Swiss Rules of International Arbitration*, Jusletter 12. Juli 2004, <www.jusletter.ch>.

¹²¹⁷ Cf. Also the critics of *Tschanz*, 28.

¹²¹⁸ Cf. *Briner, Reflections*, 142.

¹²¹⁹ Cf. *Peter*, 4; *Smit*, II. Composition of the Tribunal; *Weigand*, 1081.

¹²²⁰ Many arbitration rules therefore provide that, if the authority has to appoint the arbitrator, it must choose an independent and impartial arbitrator of a nationality other than the nationalities of the parties (cf. for example Art. 6(4) UNCITRAL Arbitration Rules).

¹²²¹ Cf. *Lionnet*, 604.

¹²²² The salaries of arbitrators seem, however, to be decreasing (cf. *Storme*, 965; *Peter*, 9).

¹²²³ Cf. also *König, Konfliktlösung*, 361.

In fact, it is not uncommon for arbitrators to be threatened with proceedings and claims against them personally if they do not act in a particular manner¹²²⁴. Laws in some states therefore provide that an arbitration agreement is invalid if it gives one of the parties thereto a privileged position with regard to the appointment of the arbitrator(s)¹²²⁵.

The fight against arbitrators' lack of autonomy seems, however, to be gaining momentum. The International Bar Association, for example, has meanwhile adopted guidelines in order to ensure the impartiality of arbitrators¹²²⁶.

A party should, however, keep in mind that an arbitrator who is simply sticking to his party's initial position is not likely to carry weight with the other members of the panel anyway. Good relations with the other possible arbitrators, having considerable flexibility and common sense, and offering creative solutions all seem to be much more important factors in being a successful arbitrator¹²²⁷. Arbitrators should be service providers with a global perspective and an open mind in order properly to fulfil their duties¹²²⁸.

d) Bad-quality awards and "wrongly" chosen arbitrators

The fact that arbitration developed into a multimillion-Euro business attracted many people to becoming arbitrators, some even without the required experience. In many states, the qualifications needed to become an arbitrator are minimal or do not exist at all¹²²⁹.

This is surprising when one considers that arbitration in fact replaces ordinary jurisdiction¹²³⁰. However, bearing in mind that arbitration is a private jurisdiction voluntarily chosen by the parties, and that one of the advantages of arbitration is that the parties have the right to choose their arbitrators, it is understandable that the state does not interfere in this regard.

¹²²⁴ Cf. Griffith Gavan, Possible issues for an annex to the UNCITRAL Model Law, Enforcing Arbitration Awards under the New York Convention: Experience and Prospects, Colloquium held in the Trusteeship Council Chamber of the United Nations Headquarters, New York on 10 June 1998.

¹²²⁵ Cf. for example Art. 1678(1) Belgian Civil Procedure Act.

¹²²⁶ Cf. "IBA Guidelines on Conflicts of Interest in International Arbitration", available at <www.ibanet.org/images/downloads/guidelines%20text.pdf>.

¹²²⁷ Cf. *Lew*, III. Selection of Arbitrators; *Smit*, II. Composition of the Tribunal.

¹²²⁸ Cf. *Weigand*, 1092; 1095.

¹²²⁹ Cf. *Weigand*, 1083.

¹²³⁰ Cf. *Weigand*, 1083.

Historically, as most private institutional arbitration rules only required very limited qualifications for becoming an arbitrator¹²³¹, parties naturally selected arbitrators who did not have the necessary particular knowledge¹²³² or time available, leading to delays in the proceedings¹²³³ or even to awards of low quality¹²³⁴: "*L'arbitrage vaut ce qui vaut l'arbitre*" is therefore a popular quote with regard to the usefulness of arbitration¹²³⁵.

Many arbitration institutions obviously feared that arbitration could lose the public's trust, and they started to offer lists of experienced arbitrators and even introduced quality controls¹²³⁶ in order to ensure the requested service. There is, however, always the risk that one could appoint the wrong arbitrator, not least if the lists provided include hundreds of names of potential candidates. The effects of choosing the wrong arbitrator can be profound¹²³⁷, since regularly only a narrow range of awards is subject to appeal, as mentioned above.

e) Unsatisfactory proceedings and unpredictable results

User-friendly and practical procedures ensuring justice for the parties are important factors¹²³⁸ in making arbitration a real alternative to ordinary jurisdiction. However, some experts argue that the extensively party-run proceedings of arbitration involve some danger that the parties will not deal with it in the optimal way¹²³⁹. Others say that some rules of arbitration are too formal and are therefore not far from regular litigation anyway¹²⁴⁰.

¹²³¹ Cf. *Weigand*, 1084.

¹²³² Cf. *Briner, Philosophy*, 9.

¹²³³ Cf. *Schäfer E.*, 118.

¹²³⁴ Cf. WPL/9/00, 3. It seems that some arbitral awards included orders to pay more than 100 million US \$ damages and included explanations of only four pages (cf. *Tschanz*, 18).

¹²³⁵ Cf. *Weigand*, n. 5.

¹²³⁶ Cf. for example Wehrli Daniel, Management of the Proceedings and Quality Control under the Swiss Rules, Jusletter 12. Juli 2004, <www.jusletter.ch>.

¹²³⁷ Cf. *König, Konfliktlösung*, 361; *Huber*, 90.

¹²³⁸ Cf. AIPPI resolution on Question 106, Possibility of arbitration of intellectual property disputes between private parties.

¹²³⁹ Cf. *Schäfer E.*, 118.

¹²⁴⁰ Cf. *Phillips, Enforce*, 68; *Peter*, 9.

Another problem of arbitration is that the awards are very difficult to predict. It seems that certain arbitrators interpret the law in their own way and decide upon justice based on their personal feelings¹²⁴¹.

f) Appeal procedures

Quite a number of the losing parties do not accept the arbitration decision. Awards are consequently often subject to nullity or appeal to the courts¹²⁴² on the basis of national law applicable at the place of arbitration or at the place of recognition and enforcement of the award¹²⁴³.

In particular, the extensive use of Article V(1)(e) New York Convention seems to provoke delays and complaints, since it provides that the recognition and enforcement of an arbitration award can be refused if it has been set aside or suspended by a competent authority of the country in which, or under the law of which, that award was made¹²⁴⁴.

IV. Arbitration and patent rights

1. General

Arbitration seems to be excluded as a reasonable option if a party has no interest in settling the dispute and is not cooperative. In addition, it is difficult to reach an arbitration agreement if several parties are involved in the dispute¹²⁴⁵ and if an arbitration clause has not already been implemented into a contract beforehand. Furthermore, it could be problematic if fast injunctive relief is necessary, since such arbitral awards usually have to be transferred into enforceable judgments first¹²⁴⁶.

¹²⁴¹ Cf. *Tschanz*, 17.

¹²⁴² Cf. critics by *Briner*, *Philosophy*, 9.

¹²⁴³ Cf. *Schäfer E.*, 113; *Phillips*, *Enforce*, 68; *König*, *Konfliktlösung*, 361; *Schweyer*, 156; *Hochstrasser/Vogt*, 107.

¹²⁴⁴ Cf. Paulsson Jan, Awards set aside at the place of arbitration, Enforcing Arbitration Awards under the New York Convention: Experience and Prospects, Colloquium held in the Trusteeship Council Chamber of the United Nations Headquarters, New York on 10 June 1998.

¹²⁴⁵ Cf. *Gulliksson*, 298.

¹²⁴⁶ Cf. *Bowler*, *Remedies*; *Hochstrasser/Vogt*, 107; *König*, *Konfliktlösung*, 356-357.

However, there are several good reasons why arbitration could be taken into consideration in a patent dispute:

- First, arbitration makes it possible to choose as arbitrators highly qualified technicians and lawyers with a good deal of experience in patent law and patent litigation¹²⁴⁷. Expert evidence would, in many cases, not be necessary any more¹²⁴⁸.

Arbitration could therefore be a real alternative to ordinary courts where only jurisdictions with limited experience are available¹²⁴⁹.

- Second, the arbitration panel could also be constituted internationally, which could be of special interest in cross-border patent litigation¹²⁵⁰.

- Third, arbitrators are rather reluctant to deal with legal questions that are in dispute among courts and with doctrine, as well as to develop the law¹²⁵¹. Quite often they also have to decide on cases that have to deal with matters where legal principles or common jurisprudence have not yet been fully developed¹²⁵². Arbitrators could consequently follow a more pragmatic approach in certain cases without the far-reaching legal consequences of a court's decision¹²⁵³.

- Fourth, patent arbitration could be cheaper than litigation¹²⁵⁴. This seems to be the case particularly within the common law system. This was one of the reasons why it was suggested that the United Kingdom introduce compulsory arbitration in patent disputes¹²⁵⁵.

However, arbitration would in most cases be more expensive than court litigation¹²⁵⁶, at least if ordinary patent jurisdiction can be limited to one instance. The main reason is that the court does not depend as much on the goodwill of the parties for strict case

¹²⁴⁷ Cf. *Perret, Arbitrabilité*, 240; *Véron, ADR*, 4; *Bowler, Cost*; *Wittenzellner*, 153.

¹²⁴⁸ Cf. *König, Konfliktlösung*, 356.

¹²⁴⁹ Cf., however, the new Hague Convention on Choice of Court Agreements, §7 C.I. Introduction.

¹²⁵⁰ Cf. *König, Konfliktlösung*, 361; *Smit*, XI. Conclusions.

¹²⁵¹ Cf. *König, Konfliktlösung*, 361.

¹²⁵² Cf. *Niblett, Advantages of Arbitration*.

¹²⁵³ Cf. *Niblett, Advantages of Arbitration*.

¹²⁵⁴ Cf. *Bowler, Cost*.

¹²⁵⁵ Cf. *Kingston*, 155, and §6 F. Compulsory arbitration.

¹²⁵⁶ Cf. *Véron, ADR*, 10-11; *Bowler, Cost*.

management and a predetermined number of hearings¹²⁵⁷. Fast-track arbitration would only be helpful in a limited number of cases¹²⁵⁸.

- Fifth, patent disputes often involve discussions on trade secrets and confidential information on licensing agreements, customer lists, etc.¹²⁵⁹. The confidentiality of arbitrations therefore offers a safeguard to the parties in terms of avoiding public disclosure¹²⁶⁰ and protecting their reputation¹²⁶¹.

2. Confidentiality problems of patent arbitration and the limited scope in Europe

Confidentiality is also a highly praised advantage of patent arbitration¹²⁶².

By contrast, arbitration should be avoided if publicity is in fact desired. This could be the case, for example, if other competitors are to be discouraged from a potential patent right infringement¹²⁶³.

Publicity could also have a commercial effect. In the USA, the patent dispute over the BlackBerry e-mail device¹²⁶⁴ - and the wide press coverage - made the tool famous all over the world. Additionally, it can put parties under pressure to reach an agreement. In the BlackBerry case, there was obviously the danger that the US economy would have suffered great damage if the service had to be shutdown¹²⁶⁵.

However, publicity can also ruin the commercial position of the other party¹²⁶⁶. It can therefore greatly improve a party's position in a patent case.

¹²⁵⁷ Cf. Véron, *ADR*, 10-11; cf. also Briner, *Reflections*, 141-142.

¹²⁵⁸ Cf. §5 B.III.2.b)aa) Fast-track arbitration as a possible way to tackle high costs.

¹²⁵⁹ Cf. Lew, V. Confidentiality; Niblett, *Advantages of Arbitration*.

¹²⁶⁰ Cf. Nixon, 485;

¹²⁶¹ Cf. Bowler, *Cost*.

¹²⁶² Cf. Véron, *ADR*, 1.1.

¹²⁶³ Cf. Nixon, 485.

¹²⁶⁴ Cf. Véron Pierre/Véron Margerie, *The Internet: A Fourth Procedural Dimension For Patent Infringement Litigation*, *Festschrift für Jochen Pagenberg zum 65. Geburtstag*, Beier Dietrich/Brüning-Petit Laurence/Heath Christopher (eds.), Köln et al. 2006, 363-273, 366-368.

¹²⁶⁵ Cf. Bodoni Stéphanie, *RIM and NTP settle BlackBerry dispute*, *Weekly News* 7 March 2006, <www.managingip.com>.

¹²⁶⁶ Cf. Véron, *ADR*, 3.

In addition, publicity can influence third parties. A dispute arising out of a licensing agreement on a patent right could easily have a direct impact on other existing licensing contracts¹²⁶⁷. Other licensees could get to know that a patent was declared invalid in an arbitration award, for instance.

Confidentiality could therefore seem problematic, not least from the view of the general public. Competition could be blocked by a patent right which was unlawfully granted. One could argue that an arbitration award does not block anyone from filing a revocation action with regard to a patent that seems to be invalid. However, although arbitration awards are legally binding decisions from private jurisdictions, the public has, in general, no information on the patent arbitration and ultimately no access to the awards.

Consequently, it is not possible for other competitors to get information on whether the patent was possibly wrongfully granted, beyond the information published with the grant of the patent.

The extent of the impact of patent awards on the public is, in fact, in dispute. It is argued that patent rights are freely disposable on the part of the right holder. He could, for example, revoke his patent on his own motion. Consequently, a court of arbitration should also be able to decide about these rights *in extensis*¹²⁶⁸. This view can be supported from a very abstract perspective.

However, the fact that arbitration awards are generally confidential and that the revocation of a patent may have a considerable impact on public interest - as in the example of the BlackBerry tool¹²⁶⁹ - seems to support a solution whereby revocation is excluded from the scope of arbitration.

In fact, most states opted for such an approach and simply do not allow arbitration to cover the patent revocation issue¹²⁷⁰. These states consequently excluded this matter from the scope of arbitration, or limited it, and refuse to recognise and enforce such awards in international arbitration on the basis of possible bilateral agreements or on the basis of

¹²⁶⁷ Cf. Lew, V. Confidentiality.

¹²⁶⁸ Cf. Blum Rudolf E./Pedrazzini Mario M., Das schweizerische Patentrecht, Band II, 2. Auflage, Bern 1975, Art. 26, N 31; Troller, IGR II, 1052; David, 27.

¹²⁶⁹ See, however, Blum/Pedrazzini, Art. 76, N 4.

¹²⁷⁰ Cf. WPL/8/99; WPL/9/00.

Article V(2) New York Convention. The national patent register would consequently have remained unchanged if a patent revocation award had been presented¹²⁷¹.

The principal reasons for this approach are policy¹²⁷², the lack of disposal of such rights¹²⁷³, the assurance of a certain uniformity of jurisprudence¹²⁷⁴, and the effect of patent rights on third parties¹²⁷⁵. The argument that the revocation of a patent has an *erga omnes* effect has also been put forward against the arbitration of patent validity¹²⁷⁶. This argument does not seem very convincing, however.

The question of validity can, in ordinary patent infringement litigation, be raised in many countries by way of exception or as an incidental matter¹²⁷⁷. The effect of the incidental ruling on validity would only be *inter partes* in most jurisdictions and would therefore not be binding for the public in general¹²⁷⁸.

However, even an *inter partes* revocation award could have an impact on the public as a whole: in order to decide on the infringement of a licensing contract, for instance, the arbitration would have to determine the scope of protection of the patent claims. This interpretation could consequently also influence other competitors and the public and would not only be a matter of interest to the parties. The greater interest of the public in patent rights seems to be supported by the fact that patent infringements are subject to a criminal penalty in most states.

Exceptions to a restricted approach to patent invalidity questions being raised during arbitration exist in such countries as Belgium¹²⁷⁹ and Switzerland,¹²⁸⁰ which accept that a court of arbitration deals fully with the validity of *national* patents¹²⁸¹. They consequently also recognise and enforce patent revocation awards and provide them with an *erga*

¹²⁷¹ Cf. *Vischer, IPR*, 676.

¹²⁷² Cf. *Niblett, Public Policy, Briner, Arbitrability*, 1.9.2.; *Lenoir/Banchereau*, N 4-14.

¹²⁷³ Cf. *Poudret/Besson*, N 354; *Perret, Arbitrabilité*, 234.

¹²⁷⁴ Cf. *Perret, Arbitrabilité*, 240.

¹²⁷⁵ Cf. *Briner, Arbitrability*, 1.10.2.

¹²⁷⁶ Cf. *Poudret/Besson*, N 354; *Perret, Arbitrabilité*, 231.

¹²⁷⁷ This is, however, no longer possible if the validity question is raised in an infringement case including a foreign patent, cf. §3 C.VI.b)bb)aaa) The ECJ's judgment *GAT v LuK*.

¹²⁷⁸ Cf. *Perret, Arbitrabilité*, 231.

¹²⁷⁹ Cf. *WPL/8/99*, 71.

¹²⁸⁰ Cf. *WPL/13/99; Briner, Arbitrability*, 2.2.1; 2.2.2.

¹²⁸¹ The same applies to a European patent with effect in the respective state.

*omnes effect*¹²⁸². The recommendation of the London Intergovernmental conference that states may give a broader effect than *inter partes* to arbitration awards was actually formulated in this way because the working party did not want to restrict the generous policy of these two states.

What is unclear is whether international arbitrations in these states may also decide on *foreign* patents or foreign parts of a European patent. Some parts of legal doctrine suggest that this question has to be answered on the basis of *lex causae* and therefore depends on the law applicable to the patent in question¹²⁸³. For example, if Dutch law does not allow patent revocation arbitration¹²⁸⁴, international arbitration with a seat in Belgium would be excluded from dealing with the invalidity of a Dutch patent or of a Dutch part of a European patent.

In Belgium and Switzerland, patent awards are also hardly ever published and alterations made in the patent register on the basis of a revocation decision¹²⁸⁵.

3. Effects of the recommendations of the Intergovernmental conference of the EPC contracting states

The recommendation of the Intergovernmental conference of the EPC contracting states to render it possible, if necessary, for an arbitration body to examine the validity of a patent in the event of arbitration on the infringement seems to deny the interest of the general public. It is, however, a fact that arbitration on IP rights - including patents - is little used all over Europe¹²⁸⁶. This is surprising, since most states in Europe actually accept arbitration with regard to patent infringements¹²⁸⁷.

¹²⁸² Cf. *Perret, Arbitrabilité*, 232-233; In Belgium, it seems that there is a certain reluctance to provide the award with such an effect, although the law would support it, cf. WPL/8/99, 71.

¹²⁸³ Cf. *Perret, Arbitrabilité*, 237; cf. also *Vischer, IPR*, 676, who sees the main reason for an arbitration with a seat in Switzerland not dealing with the validity of a foreign patent as the possible lack of enforcement of the award.

¹²⁸⁴ In the Netherlands, patent revocation is exclusively dealt with before ordinary courts; arbitration can, however, incidentally decide upon validity (*Mäder*, 166; *Poudret/Besson*, N 359; *Briner, Arbitrability*, 1.10.3.1)

¹²⁸⁵ Cf. WPL/13/99, 2; WPL/8/99, 72-73.

¹²⁸⁶ Cf. WPL/9/00, 3.

¹²⁸⁷ Cf. WPL/9/00, 3.

In fact, states - correctly - do not seem to have problems with arbitration as long as their own law and order are not endangered¹²⁸⁸. Since patent arbitration has only limited significance, the EPC contracting states could also accept that private jurisdictions decide on patent infringement matters, and now possibly even on revocation issues. Additionally, one should also bear in mind that only a small number of granted patents have a great impact on the daily life of the population.

Another important factor which could have supported the decision possibly to accept a broader scope of patent arbitration by most EPC contracting states is the strict anti-competition rules of the EU, including far-reaching sanctions. There is consequently a safety net¹²⁸⁹ available at the Community level if parties agree on contracts which may affect trade between EU member states and which have as their object or effect the prevention, restriction or distortion of competition within the common market¹²⁹⁰.

However, probably the most important factor which made it possible for the Intergovernmental conference to agree was that the effect of patent revocation awards would be limited to the parties involved, and thus the exclusive authority to decide on the patent revocation with effect *erga omnes* remained with the state authorities, and that no state was bound by this approach. Law and order would therefore not seem to be at stake¹²⁹¹.

The possibility of arbitrations to render patent revocation awards with effect *inter partes* would no longer make it a possible duty for the arbitrations to stay proceedings¹²⁹² until the court responsible decided on the validity of the patent if it was called into question by a party. As mentioned above, this was particularly important if the parties wanted to increase the possibility of enforcing the arbitral award.

Another and more frequent way out of this situation was that the parties agreed that the patent right would be surrendered if it were revoked by the arbitration¹²⁹³. This could be

¹²⁸⁸ Cf. *Geimer*, N 3781.

¹²⁸⁹ Cf. also *Nixon*, 486.

¹²⁹⁰ Cf. Art. 81 EC Treaty.

¹²⁹¹ Cf. also *Schweyer*, 156.

¹²⁹² Cf. *Schweyer*, 156.

¹²⁹³ Cf. *Bowler*, Remedies.

implemented in most states by an appropriate declaration of the patent holder before the competent national authority.

If the recommended approach of the Intergovernmental conference was transferred into national law, it could therefore provide new incentives to arbitrate patent disputes.

V. Conclusion

Arbitration is not as perfect an option as is sometimes expected¹²⁹⁴, but it has the ability to satisfy the needs of commerce in a way that ordinary court litigation could only do to a limited extent. If the advantages and disadvantages of arbitration for commerce and the public as a whole are weighed up, the advantages prevail.

From a general point of view, arbitration has not least the benefit that it relieves courts of their burden of work¹²⁹⁵. It therefore contributes to fewer delays in justice. This could be particularly important for national courts with little or no experience in patent law and patent litigation.

Arbitration could theoretically also support the unification of jurisprudence¹²⁹⁶. The possibility to choose internationally constituted panels and lawyers from different parts of the world would certainly contribute to a harmonisation of legal practice. The major reason why there are limited chances that this will indeed happen is, again, the confidentiality of arbitration and the limited number of patent cases.

It would also seem more than questionable whether the extension of authority of arbitration as recommended by the Intergovernmental conference would increase the number of patent arbitrations. A higher number of arbitrations in patent disputes could be justified by the possibility of letting arbitration decide on several parts of a European patent. Arbitration could thus help avoid multiple litigations on the same subject matter that arise before several courts¹²⁹⁷. The costs and complications of multiple litigations with different

¹²⁹⁴ Cf. *Tschanz*, 22.

¹²⁹⁵ Cf. *Lionnet*, 607-608; *Christophersen*, 343.

¹²⁹⁶ Cf. also *Smit*, Choice of Law in Arbitration.

¹²⁹⁷ Cf. also AIPPI resolution on Question 106, Possibility of arbitration of intellectual property disputes between private parties.

proceedings¹²⁹⁸ could be reduced, the risk of contradictory decisions could be limited, and legal certainty could be increased¹²⁹⁹.

However, even if the Intergovernmental conference recommendation were implemented, the fact that a decision by arbitration could only decide on patent validity if it is mounted incidentally in an infringement dispute limits the attractiveness of patent arbitration. Additionally, the limited experiences made with regard to patent arbitration in Switzerland, traditionally known for its high number of arbitration cases, giving patent awards the broadest possible effect, seem to speak against the more frequent use of patent arbitration¹³⁰⁰.

C. Mediation

Mediation may be described as a way to consensually¹³⁰¹ solve conflicts between parties by using a person acting as a neutral¹³⁰² intermediary, or a so-called "mediator"¹³⁰³. Unlike in arbitration, "neutrality" does not mean that the mediator is systematically closer to one party. He is neutral with regard to the result¹³⁰⁴.

Mediation is a non-binding and voluntary procedure, initiated¹³⁰⁵ and controlled by the parties, thus making it possible for parties to stop the procedure whenever they feel that their interests can no longer be met.

In contrast to arbitration, it is non-confrontational and not directed to a judgment which becomes *res iudicata*. The aim is to create a dialogue between the parties with the help of the mediator in order to increase the understanding of each other's position and to reach a result where all the parties involved win¹³⁰⁶. Consequently, mediation is not directed to

¹²⁹⁸ Cf. *Bodoni*, 35.

¹²⁹⁹ Cf. Müller in: *Bodoni*, 35; *Wittenzellner*, 147.

¹³⁰⁰ Cf. WPL/13/99, 2.

¹³⁰¹ Cf. *Baltzer-Bader*, 641.

¹³⁰² Cf. *Stieger, Konfliktvermeidung*, 42-43; *Christophersen*, 344; *Brown-Berset*, 341.

¹³⁰³ Cf. *Phillips, Enforce*, 69; WIPO Arbitration and Mediation Center, <www.wipo.int/amc/en/mediation/what-mediation.html>; *Brown-Berset*, 323.

¹³⁰⁴ Cf. *Brown-Berset*, 347.

¹³⁰⁵ Cf. *Christophersen*, 344.

¹³⁰⁶ Cf. *Stieger, Konfliktvermeidung*, 41; *König, Konfliktlösung*, 349; *Baltzer-Bader*, 642; *Christophersen*, 343; *Vitoria*, 398.

finding justice but rather to supporting the parties by identifying their needs¹³⁰⁷ and finding optimal solutions which satisfy these interests¹³⁰⁸.

The mediator is neither a decision-maker nor a suggestion-maker for a possible agreement¹³⁰⁹, as is usually the case in ordinary court proceedings in reaching a friendly settlement¹³¹⁰. However, it seems clear that the mediator is in a unique position¹³¹¹.

The mediator is reduced to a facilitator position, guiding the proceedings, filtering the needs and interests of the parties involved¹³¹² and creating an atmosphere of constructive communication¹³¹³ without having influence on the matter in dispute¹³¹⁴. The aspect of the mediator's qualifications is therefore of the utmost importance¹³¹⁵.

In patent litigation, where technical and legal questions are at stake, it could even be useful to have a team of mediators¹³¹⁶. However, this would not be necessary if a mediator with a technical and legal background, such as a retired English patent judge, were acting as mediator.

As in arbitration, mediation is split into *ad hoc* and institutional mediation¹³¹⁷. It is also confidential¹³¹⁸, and it is up to the parties to decide how much information they want to provide externally¹³¹⁹. If publicity is requested, it could therefore be the wrong model to choose¹³²⁰.

¹³⁰⁷ Cf. *Vitoria*, 401.

¹³⁰⁸ Cf. *Baltzer-Bader*, 642; *Brown-Berset*, 331.

¹³⁰⁹ Cf. *Baltzer-Bader*, 641; *Brown-Berset*, 341, 347; cf. however, *Stieger, Konfliktvermeidung*, 42.

¹³¹⁰ Cf. Brändle Dieter, *Der Weg zum Vergleich im Patentprozess*, Festschrift für Rüdiger Rogge zum 65. Geburtstag, 2001 GRUR, 880-883, 882.

¹³¹¹ Cf. *Brown-Berset*, 353-357 with regard to the different possible tasks of a mediator. In July 2004, the European Commission organised the launch of a Code of Conduct for Mediators. The code sets out a number of principles to which individual mediators can voluntarily decide to commit, under their own responsibility. It can be downloaded from <www.ec.europa.eu/civiljustice/adr/adr_ec_code_conduct_en.pdf>.

¹³¹² Cf. *Stauder, Mediation*, 359.

¹³¹³ Cf. *Christophersen*, 344.

¹³¹⁴ Cf. *Baltzer-Bader*, 642.

¹³¹⁵ Cf. also *Weigand*, 1083; *Baltzer-Bader*, 642; *Christophersen*, 348.

¹³¹⁶ Cf. *Stauder, Mediation*, 358.

¹³¹⁷ Cf. *Brown-Berset*, 336.

¹³¹⁸ Cf. *Christophersen*, 345; *Stauder, Mediation*, 352.

¹³¹⁹ Cf. *Brown-Berset*, 350.

¹³²⁰ Cf. above §5 B.IV.2. Confidentiality problems of patent arbitration and the limited scope in Europe; *Brown-Berset*, 335.

All this makes it clear that mediation can be even more useful than arbitration in safeguarding business relationships between parties and also in ensuring a higher degree of acceptance of the results by the parties involved¹³²¹. However, mediation can also help if no settlement, such as a licensing agreement or a supply contract,¹³²² can be reached since the parties have elaborated the case so as to enable them possibly to see their strengths and weaknesses¹³²³, and to prepare grounds for subsequent arbitration or court proceedings¹³²⁴. Judicial resources could thus be more efficiently used.

In France and in the United Kingdom, mediation can be suggested by the courts¹³²⁵ and, in the United Kingdom, courts can even order sanctions if ADR is unreasonably refused by a party¹³²⁶. It seems that this approach has had a very positive effect on the number of pre-trial settlements in the United Kingdom¹³²⁷. The European Commission also suggested including a rule which provides for legal aid to be available for extra-judicial proceedings in certain circumstances in its proposal for a Directive on legal aid¹³²⁸. This would have consequently helped less well-off people to enjoy access to alternative dispute resolution. However, the proposal was deleted during the legislative procedure¹³²⁹.

Mediation techniques can also be of service in arbitration¹³³⁰ or in ordinary litigation in the course of endeavours to reach a friendly agreement.

The general weakness of mediation is that it is only useful if the parties are ready to involve themselves, and capable of involving themselves, in a dialogue in order to reach a

¹³²¹ Cf. *Brown-Berset*, 324; 333; *Baltzer-Bader*, 645.

¹³²² Cf. *Vitoria*, 398.

¹³²³ Cf. *Phillips*, *Enforce*, 69.

¹³²⁴ Cf. WIPO Arbitration and Mediation Center, <www.wipo.int/amc/en/mediation/what-mediatio.html> on the definition of mediation.

¹³²⁵ Cf. *Brown-Berset*, 337-338.

¹³²⁶ Cf. *Brown-Berset*, 338-339; *Vitoria*, 399; cf. also §2 F.I Courts of first instance.

¹³²⁷ Cf. *Stauder/Llewelyn*, 54.

¹³²⁸ Cf. Art. 16 of the proposal of the European Commission for a Directive on legal aid which provides that legal aid shall be granted in cases where disputes are settled via extra-judicial procedures, if the law makes provision for such procedures or if the parties to the dispute are ordered by the court to have recourse to them (cf. Proposal for a Council Directive of 18.1.2002 to improve access to justice in cross-border disputes by establishing minimum common rules relating to legal aid and other financial aspects of civil proceedings, COM(2002) 13 final).

¹³²⁹ Council Directive 2003/8/EC of 27 January 2003 to improve access to justice in cross-border disputes by establishing minimum common rules relating to legal aid for such disputes.

¹³³⁰ Cf. *König*, *Konfliktlösung*, 349.

self-elaborated result, and if both their interests can be satisfied to a certain extent. In pure counterfeiting and piracy cases, mediation should therefore be regularly excluded¹³³¹.

D. Other models of Alternative Dispute Resolution

The desire to resolve conflicts in an amicable and non-judicial way does not stop with mediation. A great variety of other alternative proceedings have been developed. Just to mention a few:

I. *Schiedsgutachten*

The *Schiedsgutachten* - expert determination - is a binding opinion given by a third party on a specific factual or legal question¹³³². This model of alternative dispute resolution is therefore much closer to arbitration than to mediation.

The person giving the expert determination has the same function as the arbitrator: he is providing jurisprudence¹³³³. The difference lies in the effect of the result: the arbitral award and the expert determination in general replace a court decision if, by party agreement, the effect of the determination is not limited to a recommendation to the parties. The *Schiedsgutachten* is, however, a decision which cannot become *res iudicata*. It has the status of a contract and the parties are bound by what has been decided¹³³⁴.

In contrast to some expert opinions, the *Schiedsgutachten* is binding in a following arbitration or court procedure¹³³⁵ - if the effect was not limited by the parties. The deciding body would only check whether it was established under correct circumstances and would have to render a judgment based upon the finding in the opinion if it is not manifestly incorrect¹³³⁶.

¹³³¹ Cf. WIPO Arbitration and Mediation Center, Frequently asked question, For which disputes is mediation appropriate and what are its advantages?, <www.wipo.int/amc/en/mediation/guide/index.html>; Stauder, *Mediation*, 356.

¹³³² Cf. Tschanz, 53; Huber, 101; Stieger, *Konfliktvermeidung*, 48-49.

¹³³³ Cf. Tschanz, 54.

¹³³⁴ Cf. Huber, 101.

¹³³⁵ Cf. Stieger, *Konfliktvermeidung*, 49; Huber, 103.

¹³³⁶ Cf. Tschanz, 58; Huber, 104.

The *Schiedsgutachten* would consequently pre-determine a certain point of the dispute, such as the extent of protection of a patent. Whether it could also deal with the question of patent infringement seems to be a point of debate. Particularly unclear is whether an ordinary court dealing with the case later should be bound by the expert determination on the infringement¹³³⁷.

The WIPO Arbitration and Mediation Center has in the meantime also started to offer expert determination services¹³³⁸.

II. Mediation Arbitration ("med-arb")

As the term "med-arb" suggests, the parties first try to reach an agreement by mediation and, if they are unsuccessful, the "mediator" mutates into an "arbitrator" and renders an award¹³³⁹.

In the mediation phase, the parties are typically questioned separately. The information given to the mediator can only be communicated to the other party if the party heard agrees¹³⁴⁰. If the parties cannot find common ground for an agreement, the proceedings will typically continue in an arbitral form¹³⁴¹.

Many models of "med-arb" are practised, and it could also happen that the facilitator changes back and forth between mediation and arbitration¹³⁴². The procedure can therefore be similar to conciliation in ordinary court proceedings, where the judge typically tries to reach a friendly agreement before deciding the case¹³⁴³.

One of the most common models of "med-arb" combines mediation with last-offer arbitration - known as "medaloo". On the basis of that model, the mediator must collect a last best offer of the parties and then, if the mediation phase is concluded unsuccessfully,

¹³³⁷ Cf. *Stieger, Konfliktvermeidung*, 49.

¹³³⁸ Cf. <www.wipo.int/amc/en/expert-determination/>.

¹³³⁹ Cf. *Telford*, 1; *Brown-Berset*, 346; *Huber*, 106; *Stieger, Konfliktvermeidung*, 47.

¹³⁴⁰ Cf. *Huber*, 106.

¹³⁴¹ Cf. *Huber*, 106.

¹³⁴² Cf. *Telford*, 2; 14-15.

¹³⁴³ Sometimes "mediation" is used interchangeably with "conciliation", cf. *Brown-Berset*, 330.

must choose one of them¹³⁴⁴. "Med-arb" has become increasingly popular in the US and Canada for settling disputes¹³⁴⁵. Some critics question whether the mediator can act as arbitrator in an unproblematic way¹³⁴⁶. Others point to the possible abuse of the process if a med-arbiter threatens to move quickly to arbitration¹³⁴⁷.

III. "Minitrial"

A "minitrial" is characterised by a committee consisting of a neutral third party and one company manager of each party. The managers start to negotiate in order to reach an agreement¹³⁴⁸ with the help of a mediator as soon as the parties have concluded the presentation of their positions.

The "minitrial" appears in practice in wide variations and is offered by several arbitration institutions¹³⁴⁹.

It seems that the first "minitrial" developed out of a lengthy and costly patent dispute in the US. It could thus be particularly useful as an alternative to ordinary proceedings in major patent disputes among big companies¹³⁵⁰.

E. Conclusion

The principal benefit of mediation and other non-adversarial models of ADR is that parties try to find solutions that satisfy their interests. A situation where a party loses everything can therefore generally be avoided¹³⁵¹, i.e. that a decision on an infringement or revocation of a patent is rendered.

¹³⁴⁴ Cf. Telford, 14; Stieger, *Konfliktvermeidung*, 47-48; Huber, 107.

¹³⁴⁵ Cf. Telford, 1.

¹³⁴⁶ Cf. Schäfer E., 112.

¹³⁴⁷ Cf. Telford, 3-4.

¹³⁴⁸ Cf. Stieger, *Konfliktvermeidung*, 46; Schäfer E., 112.

¹³⁴⁹ Cf. for example the "minitrial" of the Netherlands Arbitration Institute, <www.nai-nl.org/english/>.

¹³⁵⁰ Cf. Stieger, *Konfliktvermeidung*, 46.

¹³⁵¹ Cf. Christophersen, 347.

ADR has the benefits of a confidential procedure. Mediation is particularly flexible, can be cost-efficient¹³⁵², and shorter than ordinary litigation if a solution can be found¹³⁵³. This has been illustrated in disputes involving numerous parties and several jurisdictions¹³⁵⁴.

ADR has, without a doubt, an important role in dispute settlement as it includes methods that are often better suited to the nature of the disputes involved. It enables the parties to meet each other and to exchange information in a more neutral environment, helping to put aside misunderstandings and potential prejudices¹³⁵⁵. It is therefore, not least, very popular in commercial disputes¹³⁵⁶.

The European Commission has submitted a proposal for a Directive on certain aspects of mediation in civil and commercial matters¹³⁵⁷ in order to promote the use of mediation.

With regard to patent disputes, the mediation services offered by WIPO and the UK Intellectual Property Office¹³⁵⁸ are of special importance. However, although many experts predict an increase in ADR and, in particular, mediation, it seems that it will continue to play a marginal role in patent litigation.

There are several reasons against a wide use of ADR in patent litigation¹³⁵⁹:

- warning letters,
- an often necessary and hasty reaction by the patent holder with preliminary court measures in order to stop a potential infringement,
- patent law is a field where difficult business, legal and technical questions have to be answered and often includes specific problems, such as nullity questions, which are only

¹³⁵² Cf. *Stauder, Mediation*, 356-357.

¹³⁵³ Cf. *Brown-Berset*, 324; *Christophersen*, 347; *Vitoria*, 398.

¹³⁵⁴ Cf. *Vitoria*, 398.

¹³⁵⁵ Cf. *Vitoria*, 405.

¹³⁵⁶ Cf. *Baltzer-Bader*, 642.

¹³⁵⁷ Proposal for a Regulation of the European Parliament and of the Council of 22.10.2004 on certain aspects of mediation in civil and commercial matters, COM(2004) 718 final. However, until now the European Parliament and the Commission have not been able to agree on a common text.

¹³⁵⁸ Cf. <www.ipo.gov.uk/patent/p-manage/p-useenforce/p-useenforce-dispute/p-useenforce-dispute-mediation/p-useenforce-dispute-mediation-ourmediation.htm>.

¹³⁵⁹ Cf. *Stauder, Mediation*, 352-355; 358-361.

accessible to ADR to a limited extent.

Consequently, ADR will not significantly lessen the number of multiple patent cases. Furthermore, it will not support the unification of legal practice. The general characteristics of confidentiality, the probability of a continuingly limited number of ADR proceedings in patent disputes, and the fact that, in many varieties of ADR, there are no final judgments on the case are all reasons against it.

§6 COMBINATION OF CONCENTRATION OF LITIGATION AT THE NATIONAL LEVEL AND OTHER MEASURES

The possible alternatives for achieving a uniform interpretation of European patent law will be listed in ascending order from the least to the greatest intervention in the national sovereignty of an EPC contracting state. Arbitration, mediation and other instruments of Alternative Dispute Resolution have already been dealt with in a separate chapter, as their impact on sovereignty varies according to the instrument in question.

A. Judicial cooperation

I. Cooperation among judges

1. Introduction

The potential lack of a spirited European interpretation of European patent law by the national courts was realised early on¹³⁶⁰. When the first European patents started to be litigated¹³⁶¹, efforts were consequently made to assist the courts in the development of a uniform European patent doctrine¹³⁶².

A first proposal included the publication of judgments of national courts relating to European patents¹³⁶³, and the creation of comprehensive bibliographies¹³⁶⁴. This suggestion was quite obviously aimed at a broad consultation of "foreign" judgments and legal views by national judges. The EPO immediately accepted the request to expand the already executed publication of decisions of the EPO Boards of Appeal¹³⁶⁵ to judgments of national authorities dealing with European patents.

Another approach which should have avoided discord and which should have paved the way for the uniform development of a common European jurisdiction was the creation of

¹³⁶⁰ Cf. Haertel Kurt/Singer Romuald, *Two Years of the European Patent Office and European Patent Law*, 1981 IIC, 277-308, 305; *Singer, Patentsystem*, 186; *Kolle/Stauder, Symposia*, 955.

¹³⁶¹ Cf. *Kolle/Stauder, Symposia*, 955.

¹³⁶² Cf. Stauder Dieter in: *Singer/Stauder, 3rd edition*, Art. 69, N 6; *Beier, Cooperation*, 711.

¹³⁶³ Cf. *Haertel/Stauder*, 91.

¹³⁶⁴ Cf. *Straus, Information*, 760.

¹³⁶⁵ Cf. *Straus, Information*, 759.

judges' symposia¹³⁶⁶. The main goal of the conferences was to bring judges closer together and make them more sensitive to national legal views. The efforts were initially only partly successful, however. At the end of the millennium, *Judge Jacob* came to the conclusion that, until the beginning of the 1990s, judges of courts across Europe paid only little attention to the activities of judges in other countries¹³⁶⁷.

The reason for the change in the behaviour of judges was the growing number of multiple litigations with diverging results. A possible factor might have also been the extensive *forum shopping* that was being practised and that was leading to sometimes unsatisfactory results¹³⁶⁸. However, a crucial factor was the growing development of cross-border injunctions¹³⁶⁹ resulting from the increasing internationalisation of patent litigation and the following sudden intervention of "foreign" courts in a home court's jurisdiction. The statement of *Judge Jacob* that courts started to look at each other's judgments¹³⁷⁰ - or rather *had* to start to look at each other's decisions - was therefore no coincidence¹³⁷¹.

This general development upgraded the patent judges' symposia and made them into a very important forum for discussion¹³⁷² - not least with regard to cross-border jurisdiction itself - and for an exchange of views among interested users of European patent law.

2. The Patent Judges' Symposia¹³⁷³ and their impact on a uniform interpretation

As predicted by *Judge Bruchhausen* at the first patent judges' symposium, it took circumspection and perseverance for the interpretation of the EPC and national law therein to be tackled¹³⁷⁴ and for prejudices amongst the judges to be diminished. Today, one may

¹³⁶⁶ Cf. *Kolle/Stauder, Symposia*, 955; *Gall*, 139.

¹³⁶⁷ Cf. *Jacob, Decisions*, 13.

¹³⁶⁸ Cf. §3 E.I. General.

¹³⁶⁹ Cf. §3 C.VI.1. Cross-border injunctions.

¹³⁷⁰ Cf. also *Moore*, 115.

¹³⁷¹ Cf. US courts also seem to take foreign law and legal practice into consideration more frequently when deciding domestic intellectual property cases, cf. Lee Edward, *The New Canon: Using or Misusing Foreign Law to Decide Domestic Intellectual Property Claims*, 2005 HARV.INT'L.L.J., 1-65.

¹³⁷² Cf. *Brinkhof, European patent*, 33-4

¹³⁷³ For an overview cf. *Kolle/Stauder, Symposia*; and in more detail speeches, articles, discussions and reports of the thirteen symposia meanwhile held, in: Special edition 2 of the 2007 O.J. EPO, Special edition of the 2005 O.J. EPO; Special edition No. 2 of the 2003 O.J. EPO; Special edition No. 2 of the 2001 O.J. EPO; Special edition of the 1999 O.J. EPO; 1997 IIC, 785; 1996 IIC, 151; 1993 IIC, 689; 1991 IIC 843; 1989 IIC, 271; 1987 IIC, 579; 1985 IIC, 283 and 1983 IIC, 707.

¹³⁷⁴ Cf. *Bruchhausen, Interpretation*, 734.

say that the principal goal of the colloquia was reached¹³⁷⁵: the patent judges became acquainted and started to speak with each other¹³⁷⁶.

The European patent judges came closer together,¹³⁷⁷ and further judges' symposia on the interpretation of IPRs came into being¹³⁷⁸. The judges became aware that the same patent could be scrutinised by a court in another country, and that the same legal issue would have to be decided by other national courts¹³⁷⁹. The judges, as well as the members of the EPO Boards of Appeal¹³⁸⁰, took note more often of each other's decisions¹³⁸¹ and views, but also procedures¹³⁸². The extensive discussions in regard to cross-border injunctions¹³⁸³, as well as patentability and the extent of protection¹³⁸⁴, prove this to be true.

These discussions certainly contribute to the unification process. They often crystallise one or two prevailing views, allowing each judge to decide which one will best suit¹³⁸⁵. This reduction of reasonable solutions leads to more uniform approaches to the problem and, in the end, more harmonised solutions. This trend will continue, not least as cross-border injunctions have meanwhile become almost impossible¹³⁸⁶, and the concentration and influence of the courts of the major EPC contracting states dealing with a large number of cases will increase.

It should be stressed again, however, that although the symposia obviously improved legal certainty¹³⁸⁷, as well as the quality of the judges' work and judgments¹³⁸⁸, and a trend

¹³⁷⁵ Cf. *Kolle/Stauder, Symposia*, 959; *Jacob, Harmonisation*, 145.

¹³⁷⁶ Cf. *Beier, Cooperation*, 712.

¹³⁷⁷ Cf. *Jacob, Decisions*, 13.

¹³⁷⁸ Cf. e.g. the yearly conference of patent judges with lawyers specialising in patent litigation of the European Patent Lawyers Association, <www.eplaw.org/> or the symposia of the trade mark judges and symposia organised by the German Academy of Judges, <www.deutsche-richterakademie.com/>.

¹³⁷⁹ Cf. *Rogge, Revocation*, 224; *Willems, Blueprint*, 8.

¹³⁸⁰ Cf. *Kolle/Stauder, Symposia*, 956.

¹³⁸¹ Cf. *Brändle, Interpretation*, 878; *Brinkhof, Desirability*, 228; *Jacob, Decisions*, 14; cf. however, *Brinkhof, Schlichtung*, 601.

¹³⁸² Cf. *Stauder, Aspekte*, 621.

¹³⁸³ §3 C.VI.1. Cross-border injunctions.

¹³⁸⁴ Cf., for example, the summary of discussion by *Kolle/Stauder, Symposia*, 956-958; also cf. *Stauder, Weg*, 472.

¹³⁸⁵ Cf. *Willems, Harmonisation*, 200.

¹³⁸⁶ Cf. §3 C.VI.1.b) Cross-border injunctions based on Articles 6(1) and 2 Reg 44/LC.

¹³⁸⁷ Cf. *Brinkhof, Desirability*, 226.

¹³⁸⁸ Cf. *Brinkhof, Cross-border*, 521.

towards a unified application of patent law could be recognised¹³⁸⁹, it was not sufficient wholly to prevent contradictory interpretation¹³⁹⁰. Differences in interpretation will therefore remain, although a court might render a judgment in a consciously European way¹³⁹¹.

This follows from the fact that, at a certain point, judges make up their minds as to one or the other legal position and doctrine and then render a judgment. They will do this because they believe that they are interpreting the law in a correct way and that they have already possibly moved close enough to one or the other legal position¹³⁹². This is not least underlined by the fact that British judges have to interpret¹³⁹³ certain provisions of the UK Patents Act "as nearly as practicable" in a "European" way. However, the provision still does not guarantee that they will not render judgments differing from other European courts on the same subject matter.

3. Exchanges between national judges, as well as between national judges and members of the EPO Boards of Appeal

In the draft statute for a European Patent Court, as will be discussed at a later stage, it is suggested that persons with insufficient experience of patent law may be appointed as "assessors" to the court. These persons may partake in deliberations but have no voting right¹³⁹⁴.

In regard to judicial cooperation, it seems worth considering if such an assessor system could be created by way of exchanges of patent judges between the national courts, as well as between the courts and the EPO Boards of Appeal¹³⁹⁵. Such exchanges could provide for the necessary specialisation of the judges and further improve the uniformity of interpretation.

¹³⁸⁹ Cf. already *Gall*, 139.

¹³⁹⁰ Cf. e.g. *Kolle/Stauder, Symposia*, 956-959; *Paterson*, N 1-57 to N 1-83.

¹³⁹¹ Cf. *Wadlow*, N 5-15.

¹³⁹² Cf. *Pagenberg, Conclusion*, 281.

¹³⁹³ See UK, Sec. 130 (7) Patents Act 1977.

¹³⁹⁴ Cf. §7 B.II.2.f) "Assessor".

¹³⁹⁵ Also cf. Lettström Richard, *Need for Harmonisation of European Patent Law*, 1997 *Mitt.*, 337-339, 339; *Messerli*, 140.

The system could look something like this: the "assessors" would take part in the proceedings as visiting experts, fully involved in the procedure and the discussions among the judges. They would have no voting right but could have influence on the judgment by their involvement in the deliberation of the judges.

It would be necessary for the "foreign non-voting judge" to stay with the court for a certain length of time to make it possible for him to get to know the different system and certainly the other judges. The direct exchange of views and traditions on the case would raise judicial cooperation from the examination of each other's judgments and discussions in rather theoretically oriented colloquia to a more practical level. A successful project seems possible, however, only if an environment of no prejudices and a well-respected exchange of views can be provided for. Consequently, open-mindedness would be needed by all of the judges and the members of the EPO Boards of Appeal involved. The ministries and courts responsible would likewise have to be ready to accept the possible "foreign" influence on "its" law.

To reach the goal of a uniform interpretation it would be necessary for possibly all EPC contracting states or at least the ones with the most patent litigation to take part in such a system.

If, for some states, possible sovereignty conflicts seem too great for such an approach, it might also be possible to involve legal experts who can give insight into the different approaches to patentability and extent of protection across frontier barriers¹³⁹⁶. However, experts are not judges or "assessors", and the court would again feel freer to follow its own practices even though the expert is possibly reporting on different approaches to the problem.

In any case, it seems rather questionable whether all the courts would be ready for the involvement of foreign judges and, even if they were, whether they would be ready to possibly change their traditionally, legally and politically influenced views.

The EPO actually already proved it has such an open mind by appointing external

¹³⁹⁶ Cf. *Grabinski, Determination*, 870.

technically qualified members of national courts and authorities to act on its Boards of Appeal¹³⁹⁷. Since the year 2000, the involvement of technically qualified members in the Technical Boards of Appeal has, however, significantly decreased and is today no longer practiced.

On the one hand, the involvement of external experts seems to have provoked difficult organisational problems. On the other hand, the EPO argued that it had gained the necessary technical knowledge since its establishment in 1978, and that external support was therefore no longer necessary.

The involvement of national technicians was obviously not aimed at achieving uniformity.

This also seems reasonable to a certain extent, since the technical aspects of patent law only provide for a limited potential for uniformity of legal practice. Consequently, the greater involvement of legally qualified external members, accompanied by harmonisation, seems more important.

Whereas this practice was only in place in the EPO Boards of Appeal at the beginning¹³⁹⁸, it is still reality in the EPO Enlarged Board of Appeal¹³⁹⁹. The possible result would be quite open. Experience with the EPO Enlarged Board of Appeal showed, however, that although external members¹⁴⁰⁰ such as national patent judges¹⁴⁰¹ were included, different applications of the law in the EPC contracting states could not be avoided.

In any case, to increase the degree of uniformity in the interpretation of European patent law, it would be necessary for judges to be regularly involved in EPO Board of Appeal proceedings with respect to legal questions related to patentability and the scope of protection¹⁴⁰², as well as questions of broader legal significance¹⁴⁰³, and for them also to be represented on the bench in sufficient numbers¹⁴⁰⁴.

¹³⁹⁷ Cf. Joos Ulrich in: *Benkard, EPÜ*, Art. 160, N 4.

¹³⁹⁸ Cf. Joos Ulrich in: *Benkard, EPÜ*, Art. 160, N 3.

¹³⁹⁹ Cf. §6 C.II.2. Unification by constituting the EPO Enlarged Board of Appeal from national judges.

¹⁴⁰⁰ Cf. Art. 160(2) EPC, which was transferred to Art. 11(5) in the revised EPC.

¹⁴⁰¹ Cf. Joos Ulrich in: *Benkard, EPÜ*, Art. 160, N 5; *Paterson*, N 4-190A.

¹⁴⁰² Cf. also CA/84/97, N 41.

¹⁴⁰³ Cf. also §6 C.II.2. Unification by constituting the EPO Enlarged Board of Appeal from national judges.

¹⁴⁰⁴ Cf. *Willems, Blueprint*, 8-9.

To enhance the unification process it would, furthermore, be interesting to publish dissenting opinions¹⁴⁰⁵. It would allow for people not involved in the case to reflect further on certain points of law and to draw their conclusions with regard to unification, based on these reflections.

Such opinions may be published today on the basis of Article 12a of the Rules of procedure of the EPO Enlarged Board of Appeal¹⁴⁰⁶ if the majority of members of the Board agree and if it is in connection with an "important point of law"¹⁴⁰⁷.

II. Academic analysis: the role of universities and practitioners

Another very important element of judicial cooperation in regard to a uniform interpretation of uniform law involves universities and practitioners¹⁴⁰⁸.

Universities and specialised academic institutes often take the lead with regard to projects related to uniform law and other projects which aim at international understanding. They can approach problems very pragmatically, possibly leaving politics and legal traditions behind.

Teachers, students and researchers often contribute to harmonisation by the recognition of diverging interpretations of uniform law and the elaboration of possible solutions. However, their critical minds also consider points and bring to light contradictions in laws, treaties and agreements which representatives of governments did not or could no longer see because of their lack of access to the subject matter or because, understandably, they simply lack the specialised knowledge which is of such great importance, not least with regard to patent law and patent litigation.

However, they also discover as yet unregulated areas which would in fact require the creation of new legal acts¹⁴⁰⁹. Furthermore, they act as "mediator" where the proposals for a legal act or negotiations therefor are in a deadlock or moving in the wrong direction.

¹⁴⁰⁵ Cf. *Leith, Judicial Roles*, 68.

¹⁴⁰⁶ Cf. 2003 O.J. EPO, 83-88, 88.

¹⁴⁰⁷ Cf. Art. 112 EPC.

¹⁴⁰⁸ Also cf. *Schade, Streitregelungssystem*, 833.

¹⁴⁰⁹ Cf. *Remien, Illusion*, 282-283.

As an example of an open and ambitious discussion let us consider the approaches of the American Law Institute and the Max Planck Institute for Intellectual Property, Competition and Tax Law in Munich, as well as the Max Planck Institute for Comparative and International Private Law in Hamburg, which took a new initiative at the private level to approach a solution to problems concerning jurisdiction and the choice of law in intellectual property at the global level¹⁴¹⁰.

The success of the Hague Conference on Private International Law and UNIDROIT with regard to different projects shows that judicial cooperation among legal scientific institutes and governmental institutions can be very fruitful¹⁴¹¹. The adopted final acts of UNIDROIT could possibly also be chosen by parties as applicable law in choice of court agreements or serve as a non-binding model law¹⁴¹² for states¹⁴¹³.

Such private projects could also serve as commonly accepted principles and contribute to the harmonisation of interpretation if the courts apply them in international disputes when interpreting law. One such model of law could also, for example, be the recently adopted ALI/UNIDROIT Principles of Transnational Civil Procedure¹⁴¹⁴.

Just as important as universities, in terms of acting as critical observers, are lawyers and other practitioners.

Practitioners have contributed to transparency and the publicising of the contents of, not least, patent-related judgments¹⁴¹⁵ and have provided important information and discussion with regard to the harmonisation process¹⁴¹⁶.

¹⁴¹⁰ Cf. *ALI, IP jurisdiction project*, and the proposal and reaction of the relevant Working group of the Max Planck Institute for Intellectual Property, Competition, and Tax Law, Munich, *MPI proposal*; Kur Annette, *Jurisdiction and Enforcement of Foreign Judgments - The General Structure of the MPI Proposal*, *ibid.*, 21-34.

¹⁴¹¹ Cf. *Pirrung*, 793.

¹⁴¹² In fact such law could develop into "soft law". "Soft law" is a term used in international law and describes a variety of non-legally binding instruments used in contemporary international relations by states and international organisations, cf. Boyle Alan, *Soft law in international law-making*, *International Law*, 2nd edition, Evans Malcolm D. (ed.), Oxford et al. 2006, 141-158, 142.

¹⁴¹³ Cf. also the UNCITRAL Model Law on International Commercial Arbitration, which led to a certain amount of harmonisation in arbitration legislation.

¹⁴¹⁴ Cf. *ALI/UNIDROIT, Principles Civil Procedure*.

¹⁴¹⁵ Cf. *Schade, Streitregelungssystem*, 833.

It is therefore very important not only that the current discussion fora for users, researchers and also judges and policy-makers remain available, but also that such fruitful instruments are further strengthened. There is hardly any instrument as global and international - as well as fast and relatively cheap - as the internet. Chat fora or special internet sites which allow discussions and the exchange of views on harmonisation and on creating uniformity¹⁴¹⁷ provide a good and easy opportunity aside from existing specific intellectual property journals, symposia, colloquia and other fora for discussion.

III. Conclusions with regard to unification of the interpretation of European patent law by way of judicial cooperation

Cooperation amongst judges by means of common symposia helps them become aware that they are part of a common judicial network which supports the goal of achieving a uniform interpretation of European patent law. It motivates judges and members of the EPO Boards of Appeal to take each other's judgments into consideration¹⁴¹⁸, to compare the different laws and practices¹⁴¹⁹, and to follow up their thoughts on the basis of that reflection.

It seems that there is, however, still a problem in obtaining reliable and comprehensive information on case law from foreign courts¹⁴²⁰. Judges are not often informed about each other's decisions on the same subject matter¹⁴²¹.

One of the obvious reasons for this lack of information seems to be that judgments are frequently not available, or at least not in the languages of the judges. Furthermore, there are often unspoken procedural assumptions involved in a judgment which are hardly comprehensible for a judge not used to that specific system¹⁴²². Additionally, judges are

¹⁴¹⁶ Cf., for example, the book "Interpretation of Patents in Europe, Application of Article 69 EPC", Pagenberg Jochen/Cornish William (eds.), Köln et al. 2006.

¹⁴¹⁷ Cf. also *Jacob, Future*, 120.

¹⁴¹⁸ Cf. *Brändle, Interpretation*, 878; *Brinkhof, Cross-border*, 521; *Schachenmann*, 513.

¹⁴¹⁹ Cf. *Walter H.P., Auslegung*, 869-870; *Steinacker*, 20; *Girardet*, 30; *Jacob, Decisions*, 15; *Davies, Gillian*, 46; also cf. already *Gall*, 140; *Armitage, Interpretation*, 817.

¹⁴²⁰ Cf. *Brinkhof, Change*, 104; *Davies, Gillian*, 58-60; *Steinacker*, 16-17; Messerli Peter in: *Grabrucker*, 890; *Tilmann, Invalidity harmonisation*, 71.

¹⁴²¹ Cf. *Brinkhof, Schlichtung*, 601.

¹⁴²² Cf. *Jacob, Future*, 118.

frequently unfamiliar with the numeration of national articles and sections, which makes it much more difficult for them to understand the decision, and references made in the judgments often give no indication of the content of the judgment referred to¹⁴²³.

Nevertheless, it is arguably also a question of the attitude and interest of each judge responsible, as well as a question of the time available to search for the necessary information.

In any case, it should be stressed that the positive effects of such cooperation very much depend on the willingness of the judges to involve themselves in discussions and revise their views accordingly. This also fosters the possibility of involving foreign judges in the decision-making process. It could prove to be a very helpful way towards the establishment of common jurisprudence, but it will be necessary for the other judges to be ready to change their positions.

The European Union also initiated a programme in 2002 - for the period until 2006 - to promote judicial cooperation in civil matters, *inter alia* aiming at ensuring legal certainty and improving access to justice, mutual recognition of judicial decisions, promoting the necessary approximation of legislation, improving mutual knowledge of the EU member states' legal and judicial systems, as well as improving information to the public on access to justice and judicial cooperation¹⁴²⁴.

Legal science has contributed, and will always have to contribute, to a uniform interpretation of patent law. Teachers, students, lawyers and patent attorneys will have to continue to critically observe and consider court judgments, as well as legislation projects in the future. They are as important as the legislature and judiciary to the development of the law, and they often inspire necessary discussions in a more culturally and politically open environment.

¹⁴²³ Cf. *Jacob, Future*, 120.

¹⁴²⁴ Cf. Council Regulation (EC) No. 743/2002 of 25.04.2002 establishing a general Community framework of activities to facilitate the implementation of judicial cooperation in civil matters.

The continuing internationalisation of students, as well as exchange and cooperation programmes¹⁴²⁵ between universities and specialised institutes, will also bring students and their different views on a certain subject matter closer together. With such programmes students have the opportunity to hear a variety of views on certain issues and can develop their own ideas, based on wider knowledge. This can be very fruitful in understanding different approaches and for the creation of a uniform interpretation of harmonised law.

It is also clear, however, that academic contributions have their limits and that true harmonisation would not be possible without the necessary political support.

B. Creation of "best practices" and common rules of interpretation

As mentioned earlier, simple judicial cooperation and discussions alone cannot entirely avoid contradictory interpretations of European patent law¹⁴²⁶. An important step forward could be the creation of optional "best practices", model law or common rules on interpretation¹⁴²⁷, as neither the rather unsubstantiated TRIPs Agreement nor the Vienna Convention - in particular its Articles 31 to 33¹⁴²⁸ - is very helpful in this regard. Obviously there is a true lack of uniform rules of interpretation throughout Europe¹⁴²⁹ that could have prevented differences.

A suggestion made for such an optional rule was that a court has to take a foreign precedent on the same subject matter into serious consideration¹⁴³⁰ and adopt it if it is unable to provide for a more unitary European-spirited interpretation¹⁴³¹. This would be the case if the precedent followed a purely national approach and seemed not to be in line

¹⁴²⁵ For example, CEIPI (Strasbourg, FR), Magister Lucentinus at the University of Alicante (ES), MAS in Intellectual Property (ETH Zurich, CH), Queen Mary IP Research Institute (London, UK), and the Munich Intellectual Property Law Center (DE) together form the European Intellectual Property Institute Network (EIPIN) and cooperate with each other.

¹⁴²⁶ Cf. also *Steinacker*, 16.

¹⁴²⁷ Cf. *Brinkhof*, *Äquivalente*, 436; *Brändle*, *Interpretation*, 882; *Gilles*, 20.

¹⁴²⁸ Cf. *Bruchhausen*, *Interpretation*, 739-745; *Walter H.P.*, *Auslegung*, 867-868; *Paterson*, N 1-58 to N 1-59.

¹⁴²⁹ Cf. *Brändle*, *Interpretation*, 882.

¹⁴³⁰ Cf. *Brinkhof*, *Äquivalente*, 437; *Brinkhof*, *Desirability*, 228; *Brändle*, *Interpretation*, 878; *Steinacker*, 16.

¹⁴³¹ Cf. *Walter H.P.*, *Auslegung*, 870; also cf. *Kropholler*, *Internationales*, 281-283; *Merrell Dow Pharmaceuticals Inc. and Anr. v H.N. Norton & Co. Ltd.*, 1996 RPC, 76-93, 82 and *Grabinski*, *Determination*, 869.

with the international character of the EPC¹⁴³². The court has, however, always to move within the framework of the *ratio* of the text¹⁴³³, as provided for by Article 31 Vienna Convention¹⁴³⁴. If a common European legal practice has already been elaborated by other national authorities, the court should very clearly consider whether it wants to disrupt international uniformity with a diverging judgment¹⁴³⁵. Such a decision should only be rendered if the practice is in fact unjustifiable.

Whether all courts are ready for that step on their own motion seems questionable, however¹⁴³⁶. The suggestion would require strong self-discipline and international responsibility on the part of the judges to ensure a certain amount of success. This might not be easy for courts, given that this might involve a departure from certain principles of their own civil¹⁴³⁷, procedural or even constitutional law¹⁴³⁸. Additionally, there will be linguistic problems¹⁴³⁹ and the open question as to whether all decisions of relevance to the EPC will be communicated by the national courts¹⁴⁴⁰. Furthermore, national courts would have the authority to decide by themselves how they have to and want to interpret European patent law¹⁴⁴¹, and there will be courts persisting with their own national interpretations¹⁴⁴², not least in the political framework set by the EPC.

Another approach discussed is that the Administrative Council of the EPO implement interpretative rules into the EPC Implementing Regulations in order to unify the interpretation of law¹⁴⁴³. The advantage of the above proposal would be that such regulations would be binding on judges and would have to be applied by them.

¹⁴³² Cf. *Walter H.P., Auslegung*, 870.

¹⁴³³ Cf. *Grabinski, Determination*, 868.

¹⁴³⁴ Cf. *Cottier/Germann*, 55.

¹⁴³⁵ Cf. *Brinkhof, Äquivalente*, 437; *Walter H.P., Auslegung*, 870 with reference to Grossfeld Bernhard, *Kernfragen der Rechtsvergleichung*, Tübingen 1996, 111.

¹⁴³⁶ Cf. e.g. *Brändle, Interpretation*, 881; 882; *Grabinski, Determination*, 872-874.

¹⁴³⁷ Cf. also e.g. *Jacob, Decisions*, 15-16.

¹⁴³⁸ Cf. *Kolle/Stauder, 1st Symposium*, 821.

¹⁴³⁹ Cf. *Grabinski, Determination*, 869.

¹⁴⁴⁰ Cf. also Messerli Peter in: *Grabrucker*, 890; *Davies, Gillian*, 58-60.

¹⁴⁴¹ Cf. *König, Probleme*, 303.

¹⁴⁴² Cf. *Brinkhof, Desirability*, 228.

¹⁴⁴³ Cf. *Tilmann, Invalidity harmonisation*, 72-74.

However, apart from the question of whether all EPC contracting states or at least the necessary qualified majority¹⁴⁴⁴ really desire such rules, it seems questionable whether the rules could be formulated in a way that would again exclude diverging interpretations.

A similar idea would be to make the Guidelines for Examination in the EPO¹⁴⁴⁵ binding on national courts.

The EPO, for example, established a quality management system¹⁴⁴⁶ in order to ensure the greatest possible uniform interpretation of the EPC and its related rules. This system includes an operational quality control procedure where the quality of the substantive examination is checked, as well as if there is a deviation from EPO practice.

A similar authority would also be necessary if the EPC contracting states wanted to take a uniform interpretation seriously in regard to European patents. Reasonably, such a uniformity-ensuring body, checking whether the national courts are acting within the framework of these guidelines, would clearly go in the direction of a common court.

The establishment of such a body¹⁴⁴⁷ would be a major step for some EPC contracting states, transferring a great deal of sovereignty and evoking the question of the creation of a full court. It would therefore be better if the judges applying the law themselves could agree on a common formula on how to interpret the law¹⁴⁴⁸. A proposal with regard to a "European Formula for the Scope of Patent Claims" is, for example, on the table for discussion¹⁴⁴⁹.

C. Bodies giving opinions on European patent law

I. Introduction

Regarding the harmonisation of European patent litigation, the Paris Intergovernmental conference of the EPC contracting states also mandated the Working Party on Litigation

¹⁴⁴⁴ See Art. 35(2) EPC in conjunction with Art. 33(1)(b) EPC.

¹⁴⁴⁵ Available at <www.epo.org/patents/law/legal-texts/guidelines.html>.

¹⁴⁴⁶ Cf. CA/88/05.

¹⁴⁴⁷ Also cf. *Brinkhof, Desirability*, 229.

¹⁴⁴⁸ Cf. also the discussions in *Tilmann/Jacob*.

¹⁴⁴⁹ Cf. *Pagenberg, Conclusion*, 285-286.

(WPL) to define the terms under which a common entity - so-called "Facultative Advisory Council" - could be established and financed, to which national jurisdictions can refer with a view to obtaining advice regarding that part of any litigation relating to validity and infringement¹⁴⁵⁰.

The idea for opinion statements by an independent body is not new with regard to reaching the aim of a unitary interpretation of patent law. Within Article 78(1) CPC 1975 it was suggested that the EPO must express an opinion on the extent of protection conferred by the patent when a national court which has jurisdiction to determine the extent of protection by the Community patent in relation to the alleged infringement stayed the infringement proceedings¹⁴⁵¹.

This proposal was, however, criticised on the one hand as dangerous in terms of causing substantial delays. On the other hand, it was seen as problematic, since the question of the extent of protection includes factual and legal considerations with which, typically, the courts rather than the patent offices are familiar¹⁴⁵². Furthermore, it was argued that there is the potential for twice the work, since the court filing the request must first determine the infringement situation at least on a preliminary basis in order properly to fulfil its obligations to transmit extracts from the files¹⁴⁵³. The proposal did not appear in later versions of the CPC¹⁴⁵⁴.

A referral system with regard to legal questions was, however, included in the EPC:

Article 22(1)(a) and (b) EPC provide the EPO Enlarged Board of Appeal with the authority to decide on points of law referred to it by the EPO Boards of Appeal or the President of the EPO. In the latter case it is, however, necessary for two EPO Boards of Appeal to have given different decisions on the referred question¹⁴⁵⁵. Article 112(1) EPC stipulates that opinions of the EPO Enlarged Board of Appeal *inter alia* serve to ensure uniform application of the law.

¹⁴⁵⁰ Cf. 1999 O.J. EPO, 548.

¹⁴⁵¹ Cf. §1 D.I. Aims and development.

¹⁴⁵² Cf. *Stauder, Future*, 182-183; cf. also *Steinacker*, 18.

¹⁴⁵³ Cf. *Stauder, Future*, 183.

¹⁴⁵⁴ Also cf. *Kolle, Expert*, 633.

¹⁴⁵⁵ Cf. G 3/95, 1996 O.J. EPO, 169-180 where it was decided that the referral by the President of the EPO was inadmissible because there were no conflicting decisions.

1. Key aspects with regard to a uniform interpretation

The key aspects with a view to reaching the goal of a unitary interpretation seem to be whether the referral is mandatory or not and whether or not the opinion of the authority with the task of safeguarding a unitary interpretation is binding.

A mandatory referral actually has the effect that the referring body has basically no substantive authority to decide on the referred question of law.

The CPC 1989 may serve as an example of where national courts acting as "Community patent courts" had to mandatory refer to the COPAC questions where the COPAC had exclusive jurisdiction, whereas it was optional for cases where the jurisdiction was not exclusive¹⁴⁵⁶.

A logical consequence of a mandatory referral is the binding effect of the opinion on the referring body.

It also follows that an *optional* request for an opinion formally splits the authority in cases where the opinion would be binding on that body¹⁴⁵⁷. An optional approach also makes a uniform interpretation more difficult since a referral is not always made in cases where it actually should have been made in order to reach this goal. It should, however, be made clear that, even with a system of mandatory referral, the courts do not always fulfil their duties.

The body having the competence to give opinions could therefore also be provided with the authority to take a question into consideration on its own motion. It could thus immediately act to contribute to further uniformity by giving guidelines if an important question is involved.

Once a request has been filed, the effect of the given opinion will have an influence on the final judgment.

¹⁴⁵⁶ Cf. §1 D.II. Jurisdiction.

¹⁴⁵⁷ Cf. also *Snell*, 188.

If the opinion is binding, the substantive authority and the right to interpret the law are in fact transferred to the referral body. If it is not binding, one could again speak of a divided authority since the body filing the request must, on the basis of the generally accepted principle of the right to be heard¹⁴⁵⁸, provide reasons why it did not follow the opinion in its decision¹⁴⁵⁹ and why it possibly filed for another opinion with a different body.

Nevertheless, a non-binding opinion puts the destiny of the unitary interpretation of law fully in the hands of the referring bodies¹⁴⁶⁰.

II. The EPO Enlarged Board of Appeal

As mentioned above, a referral to the EPO Enlarged Board of Appeal may be made by the EPO Boards of Appeal or the President of the EPO.

The possibility of referral by the President has its basis in French law, where the *Conseil d'État* gives opinions on governmental requests¹⁴⁶¹.

The lack of an option for referral on the part of the national courts and other authorities, as well as the absence of a legal basis whereby the national courts are obliged to consider a decision of the Boards of Appeal or the EPO Enlarged Board of Appeal as binding, again called into question whether the opinion procedure was serving the development of a common legal practice beyond the EPO¹⁴⁶², as concluded by certain authors¹⁴⁶³.

In 2006, the British Court of Appeal, however, took the unprecedented step of recommending to the EPO that the EPO Enlarged Board of Appeal consider a series of questions relating to the patentability of software, as it felt that the decisions of the EPO

¹⁴⁵⁸ Cf. e.g. Art. 6 ECHR and *Georgiadis v Greece*, ECtHR January 24 and April 25, 1997, Rep. 1997-III 949, N 41-43; *Gustafson v Sweden*, ECtHR February 21, and May 27, 1997, Rep. 1997-IV 1149, N 47; *Ruiz Torija v Spain*, ECtHR June 24 and November 23, 1994, Ser. A No. 303-A, N 29; as well as Art. 113 EPC.

¹⁴⁵⁹ Also cf. *Waage*, N 2-40 to N 2-42.

¹⁴⁶⁰ This was e.g. the case with regard to the CPC 1975 opinion procedure where it was made clear in Article 78(3) that the opinion given by the EPO does not bind the national courts.

¹⁴⁶¹ Cf. *Singer, Development*, 706.

¹⁴⁶² Also cf. Günzel Brigitte in: *Benkard, EPÜ*, Art. 112, N 2; *Paterson*, N 4-175 to N 4-180.

¹⁴⁶³ Cf. *Gori/Löden*, Art. 22 N 3.

Boards of Appeal were mutually contradictory¹⁴⁶⁴. The EPO did not share the court's view that there were contradictions in its case law and did not make any referral to the EPO Enlarged Board of Appeal.

It was agreed that the referral by an EPO Board of Appeal is in general optional, that is to say the Board has the authority itself to decide if it considers an opinion of the EPO Enlarged Board of Appeal necessary in the ongoing appeal¹⁴⁶⁵ to ensure uniform application of the law¹⁴⁶⁶. Parties involved in proceedings before the EPO have no right to a referral¹⁴⁶⁷.

The optional approach seems appropriate, as the EPO Enlarged Board of Appeal was not created as a third-instance (quasi-judicial) body within the EPO¹⁴⁶⁸. It is part of the second instance that comprises the EPO Boards of Appeal¹⁴⁶⁹. Nevertheless, one could also use the term "quasi-optional," or rather "quasi-mandatory", referral, as it is seen as a duty¹⁴⁷⁰ to refer to the EPO Enlarged Board of Appeal as soon as a fundamental question of the EPC is at issue.

In contrast to a referral by the President of the EPO, the answer is binding if a Board decides to refer the appeal in question¹⁴⁷¹. The EPC consequently uses the term "decision" for the given opinion whereas, in the case of a referral by the President of the EPO, it speaks of an "opinion". The reason for the differentiation is because no particular pending case is brought before the EPO Enlarged Board of Appeal by the President where there are two conflicting decisions of the Boards of Appeal¹⁴⁷².

¹⁴⁶⁴ Cf. Court of Appeal seeks EPO direction on software patents, *Managing Intellectual Property News*, 1 October 2006, <www.managingip.com>.

¹⁴⁶⁵ Cf. Günzel Brigitte in: *Benkard, EPÜ*, Art. 112, N 4.

¹⁴⁶⁶ Cf. Art. 112(1)(a) EPC.

¹⁴⁶⁷ Cf. *Leith, Judicial Roles*, 57.

¹⁴⁶⁸ Cf. *Singer, Development*, 700; *Gori/Löden*, Art. 22, N 1; Beier Friedrich-Karl, *The Remedies of the Patent Applicant and His Competitors in Comparison – Balance or Imbalance? A Comparative Law Study*, 1989 IIC, 407-438, 433-434; Pignatelli Alessandra in: *Benkard, EPÜ*, Art. 22, N 1.

¹⁴⁶⁹ Cf. *Waage*, N 1-39.

¹⁴⁷⁰ Cf. *Singer, Patentsystem*, 84.

¹⁴⁷¹ Cf. Art. 112(3) EPC; an *obiter dictum* in the decision of the EPO Enlarged Board of Appeal is not binding on the referring EPO Board of Appeal, cf. Joos Ulrich in: *Singer/Stauder, 3rd edition*, Art. 112, N 37; *Singer, Development*, 705.

¹⁴⁷² Cf. *Paterson*, N 4-187; Ulrich Joos in: *Singer/Stauder, 3rd edition*, Art. 112, N 31.

Article 21 of the Rules of Procedure of the Boards of Appeal¹⁴⁷³ provides that if a Board considers it necessary to deviate from an interpretation or explanation of the EPC contained in an earlier opinion or decision of the EPO Enlarged Board of Appeal, the question has to be referred to the EPO Enlarged Board of Appeal.

This construction seems necessary, as the EPO Enlarged Board of Appeal has no right to give a decision on its own motion¹⁴⁷⁴ and interfere with ongoing proceedings. Furthermore, the provision ensures that a referral made by the President of the EPO also indirectly has a binding effect¹⁴⁷⁵ on the EPO Boards of Appeal, even though the President is basically free to follow the opinion¹⁴⁷⁶.

By the end of 2007 the EPO Enlarged Board of Appeal had given 75 opinions or decisions¹⁴⁷⁷.

In this role it helped to clarify unresolved legal issues, served the development of the law, and ultimately increased legal certainty. It could not, however, replace the missing third instance¹⁴⁷⁸. As mentioned earlier, however, the aim had not been to create an EPO "Supreme Court" with the EPO Enlarged Board of Appeal.

1. The EPO Enlarged Board of Appeal as a referral body for national authorities

As mentioned above, national authorities have no possibility of referral to the EPO Enlarged Board of Appeal for a binding opinion on the interpretation of the EPC. Consideration could, however, be given to changing this situation.

In order to create the necessary distance from the EPO it would be necessary, in this case, for the EPO Enlarged Board of Appeal to be extracted from the EPO and established as an independent body¹⁴⁷⁹. The opinions of such a body could certainly have a positive effect in terms of furthering uniformity, although it would again be up to the courts to

¹⁴⁷³ Cf. 2007 O.J. EPO, 536-547.

¹⁴⁷⁴ Cf. *Singer, Development*, 702.

¹⁴⁷⁵ Cf. Joos Ulrich in: *Singer/Stauder*, 3rd edition, Art. 112, N 39.

¹⁴⁷⁶ Cf. *Singer, Development*, 706.

¹⁴⁷⁷ Cf. <www.european-patent-office.org/dg3/g_dec/index.htm>.

¹⁴⁷⁸ Cf. *Singer, Development*, 713.

¹⁴⁷⁹ Cf. *Leith, Revision*, 250-251.

decide if they wanted to refer a case. A referral could, however, be a more interesting option for the courts if more national judges originating from countries with different legal traditions were to be part of the referral body.

2. Unification by constituting the EPO Enlarged Board of Appeal from national judges

Judge Jacob proposed that the EPO Enlarged Board of Appeal could be composed of a significant number of experienced national judges, as well as members of the EPO Boards of Appeal as technical members, in order to provide for further harmonisation and uniformity of jurisprudence¹⁴⁸⁰.

To reach this goal there would be a change in the composition of the EPO Enlarged Board of Appeal, which consists of five legally qualified and two technically qualified members¹⁴⁸¹, all of them typically members of the EPO Boards of Appeal¹⁴⁸². At the same time, all the major traditions in European patent law would have to be represented on the board. On the basis of the following considerations, however, further steps would have to follow the initial step as suggested by *Judge Jacob*¹⁴⁸³:

- First, the EPO Enlarged Board of Appeal is only rarely contacted¹⁴⁸⁴, and then often in the context of procedural matters¹⁴⁸⁵ which are of no great interest to European patent judges in relation to a unified European patent practice.

It is thus unclear whether a consistent jurisprudence of substantive patent law may be established and maintained just by adding legally trained judges from national courts to the board. This problematic situation is made even worse if the members of the EPO Enlarged Board of Appeal are not consistently the same¹⁴⁸⁶. To ensure legal certainty and a certain continuity, it would therefore be important for the members of the EPO Enlarged Board of

¹⁴⁸⁰ Cf. *Jacob, Proposal*, 224.

¹⁴⁸¹ Cf. Art. 22(2) EPC.

¹⁴⁸² Cf. §6 A.I.3. Exchanges between national judges, as well as between national judges and members of the EPO Boards of Appeal.

¹⁴⁸³ Cf. also *Leith, Revision*, 253-254, who proposes that the functions and expertise of the Boards of Appeal be transferred to national courts.

¹⁴⁸⁴ Cf. *Willems, Blueprint*, 9.

¹⁴⁸⁵ Cf. *Leith, Judicial Roles*, 57-58; 63.

¹⁴⁸⁶ Cf. *Willems, Blueprint*, 8; *Leith, Judicial Roles*, 63.

Appeal not to change too frequently, at least in terms of the majority of the members¹⁴⁸⁷.

- Second, although the major traditions in European patent law would be presented and judges with a very high judicial standing would be sitting, it seems questionable whether all national courts would feel wholly bound by the decision rendered.

This could be emphasised if the court does not feel it is represented by having a member from its own state on the EPO Enlarged Board of Appeal. The question as to who would be a member will therefore be difficult to answer¹⁴⁸⁸. A system with "assessors"¹⁴⁸⁹ could, however, in this case help prevent such a situation and allow states with judges having hardly any patent litigation experience to be involved in the development of a uniform legal practice. At the same time, a situation can be avoided where the EPO Enlarged Board of Appeal becomes a language school or a place to train its knowledge of law and litigation, both endangering the quality of the decisions and opinions¹⁴⁹⁰.

In the meantime, the EPO is trying to involve national patent judges in decisions and opinions of the EPO Enlarged Board of Appeal more frequently, to further strengthen the cooperation between the EPO and national courts in order to promote the acceptance of the EPO Enlarged Board of Appeal¹⁴⁹¹ and with a view to increasing harmony of interpretation¹⁴⁹².

3. The EPO Enlarged Board of Appeal as basis for a European patent court of appeal

Judge Jacob clearly stated that his proposal could be the start of the creation of a European patent court of appeal¹⁴⁹³.

¹⁴⁸⁷ Cf. also CA/84/97, N 38.

¹⁴⁸⁸ Cf. *Jacob, Harmonisation*, 145.

¹⁴⁸⁹ Cf. in this regard §7 B.II.2.f) "Assessor".

¹⁴⁹⁰ Cf. also *Leith, Judicial Roles*, 63; CA/84/97, N 39.

¹⁴⁹¹ Cf. CA/84/97, N 37. See also new Art. 11(5) EPC which created a permanent legal basis for appointing external legally qualified members of the Enlarged Board of Appeal.

¹⁴⁹² Cf. *Davies, Gillian*, 60; *Messerli*, 128; Joos Ulrich in: *Singer/Stauder, 3rd edition*, Article 112, N 8.

¹⁴⁹³ Cf. *Jacob, Proposal*, 225; *Jacob, Harmonisation*, 145.

The EPO Enlarged Board of Appeal could indeed be the basis for such a court. It seems clear, however, that quite a number of changes in the organisation, as well as in the procedure, would be necessary to create such a court in reality.

The board would not only have to be clearly separated from the EPO, but it would also have to be transferred into a European civil court which would also have to deal with patent infringements. This would make a revision of the EPC necessary.

A more promising approach seems therefore to be the way of a separate optional agreement with the possibility of each contracting state deciding by itself whether it would like to join or not, bearing in mind the difficulties of changing the EPC in such a significant way with, in the meantime, 34 contracting states.

III. The Facultative Advisory Council

1. History and background

Even before the WPL became active with regard to the creation of a Facultative Advisory Council - or "common entity" as the body was initially called, different ideas were in the air concerning the creation of opinion bodies tackling the problems related to the harmonised interpretation of European patent law by national authorities.

For example, it was suggested that the ECJ - on the basis of an international agreement - be provided with the authority to ensure a uniform interpretation in the case of discrepancies between national courts by way of referral proceedings¹⁴⁹⁴.

Another idea was to create a European patent court, acting as a referral body with regard to questions concerning the interpretation of the EPC¹⁴⁹⁵. It would have been an *ad hoc* body, meeting whenever a question was filed, and composed of judges from the national supreme courts. To achieve a higher degree of unification, the EPO Enlarged Board of Appeal would have been integrated into the court one way or the other¹⁴⁹⁶.

¹⁴⁹⁴ Cf. König, *Probleme*, 304.

¹⁴⁹⁵ Cf. Brinkhof, *Desirability*, 229.

¹⁴⁹⁶ Cf. Brinkhof, *Desirability*, 229.

When the WPL started its endeavour to create a "Facultative Advisory Council" (FAC), it was open to any approach based on its rather wide mandate. The creation of such an entity was to have given each EPC contracting state the possibility to take a bigger step in the direction of a uniform interpretation of European patent law than with a purely national concentration of the courts if it was not, or could not have been, ready to accept a common European patent court.

As independent national courts and other authorities outside the EPO system would refer to the common entity, the system of preliminary rulings of the COPAC and the ECJ was to have served as an example for the creation of the FAC. From the beginning, it seemed to be clear that this body was to be created within the framework of the European Patent Organisation, bearing in mind the limited competence of the EC in the field of patent law, such as with regard to biotechnological inventions¹⁴⁹⁷ or, in the meantime, the enforcement of IP rights¹⁴⁹⁸. The possible pragmatic approach - at least for the member states of the EU - of giving the ECJ the authority to act as FAC was therefore not discussed.

It seemed clear that the EU member states wanted a clear distinction between their competences and the competences of the Community. This is underlined by the decision of the Diplomatic conference on the revision of the EPC in 2000 to provide the FAC with no authority to deliver opinions on issues of Community law¹⁴⁹⁹.

To ensure a more uniform interpretation of the EPC provisions¹⁵⁰⁰, as well as to reduce the organisational and financial outlay of the FAC¹⁵⁰¹, the WPL very early in its existence decided that the appeal instance envisaged in the EPLA should in principle be identical to the *common entity*¹⁵⁰².

Some delegations also took the view at the beginning of the discussions that a referral of a national court in regard to questions of the validity and infringement of European patents

¹⁴⁹⁷ Cf. Directive 98/44/EC of the European Parliament and the Council of 6.7.1998 on the legal protection of biotechnological inventions, O.J. EC 1998, No. L 213/13.

¹⁴⁹⁸ Enforcement Directive; see also §6 D.II.3. Uniform law concerning patent litigation.

¹⁴⁹⁹ Cf. Art. 149a(1)(b) EPC.

¹⁵⁰⁰ Cf. WPL/1/00, 1.

¹⁵⁰¹ Cf. WPL/10/00, 3.

¹⁵⁰² See WPL/6/99, N 4.

should be obligatory and binding in order to promote uniformity of the law¹⁵⁰³. The question therefore arose as to whether or not the FAC would in this case become some sort of substitute for a common court¹⁵⁰⁴. Industry took the view that the court and the FAC should be two elements of one system, both promoting the unified interpretation and application of European patent law and complementing each other¹⁵⁰⁵.

Nevertheless, the majority of delegations interested in an FAC already stated at the first meeting of the WPL that only a purely optional referral by the national authorities to the FAC could be acceptable. The majority of delegations also took the view that the opinions of such an instance should not have a binding effect on national proceedings, and that it should only give an expert opinion¹⁵⁰⁶.

On the one hand, it was therefore clear from a very early stage that many EPC contracting states were not interested in a solution which reduced their sovereignty.

On the other hand, the states aiming for the creation of a common European patent court did not want an FAC that was becoming too attractive. They were afraid that too many states would opt for a *common entity* solution, in the end endangering the establishment of a common European patent court because of a lack of sufficient countries joining.

The second Intergovernmental conference of London¹⁵⁰⁷ took note of these basic cornerstones with regard to the *common entity*. It mandated the WPL to submit an EPLA to the governments, including a separate part concerning a *common entity*, it being understood that contracting states should be free to join only that part on the *common entity*¹⁵⁰⁸.

This made it clear that the FAC could basically not become reality before the EPLA entered into force and consequently before the European Patent Court was established.

¹⁵⁰³ Cf. WPL/6/00, N 177-209.

¹⁵⁰⁴ Cf. WPL/6/00, N 182.

¹⁵⁰⁵ Cf. WPL/6/00, N 183.

¹⁵⁰⁶ Cf. WPL/1/00, 1 and WPL/6/99, N 4.

¹⁵⁰⁷ Cf. §7 A.II. The second phase.

¹⁵⁰⁸ Cf. WPL/14/00 Rev. 1; the final conclusions and the mandate of the Conference have never been published.

The newly created legal basis for an FAC in Article 149a EPC¹⁵⁰⁹, which clearly distinguishes between an agreement establishing a European patent court and an agreement establishing a *common entity*, should consequently have been amended before or at the Diplomatic conference on the revision of the EPC.

However, the clear differentiation between the FAC and the European Patent Court has the benefit that there would be a clear legal basis for an agreement only on a *common entity* if the EPLA did not materialise. For this case, paragraph 2 of Article 149a EPC even authorises the Administrative Council of the European Patent Organisation to decide that the EPO shall provide the *common entity* with the necessary staff, premises and equipment and that the expenses incurred by such an entity shall be borne fully or in part by the Organisation.

In fact, before the London Intergovernmental conference it was vigorously debated whether the *common entity* should be regulated in a separate agreement. In the end the majority agreed that the consolidation of the *common entity* under international law in the EPLA would make it easier to bring the two instruments into line with each other, as long as the freedom of the contracting states to accept the FAC was not restricted and, as a consequence, their sovereignty affected in an undesired way.

As mandated by the London conference, the FAC is now integrated in Part Va of the draft EPLA. Additionally, it is suggested that any EPLA contracting state may, at the time of signature or when depositing its instrument of ratification or accession, declare that it is bound by the EPLA only as far as it relates to the FAC¹⁵¹⁰. Vigorously contested are still the financial obligations and the voting rights of the states acceding only to the part of the EPLA on the Facultative Advisory Council¹⁵¹¹.

2. Proposed principal regulations of the Facultative Advisory Council

The Facultative Advisory Council would be set up within the European Patent Judiciary¹⁵¹².

¹⁵⁰⁹ Cf. also §7 B.I. The legal basis for the European Patent Litigation Agreement in the EPC.

¹⁵¹⁰ Art. 83d(1) draft EPLA.

¹⁵¹¹ Art. 83e and 83f draft EPLA.

¹⁵¹² Art. 4 draft EPLA; cf. §7 B.II.1. European Patent Judiciary.

The functions of the FAC would be performed by the second instance of the European Patent Court, the Court of Appeal¹⁵¹³. It would thus not be a separate organ of the judiciary¹⁵¹⁴.

The FAC would deliver a non-binding opinion on any point of law referred to it concerning the substantive law to be applied by the European Patent Court¹⁵¹⁵ or national law harmonised therewith, but not Community law¹⁵¹⁶. The possibility of requesting opinions would be restricted to courts and quasi-judicial authorities¹⁵¹⁷ of an EPLA contracting state and would have to be related to ongoing proceedings before such a national jurisdictional body¹⁵¹⁸.

On the one hand, abstract questions of law would thus be excluded from being referred to the FAC for an opinion. On the other hand, the parties would have no independent right to request an opinion.

Once a referral is made, the parties would have a single opportunity to present in writing their arguments and submissions relating to the point of law in question¹⁵¹⁹. This limited opportunity for the parties to present their arguments was introduced in order to keep the proceedings simple and fast and because it was felt that the right to be heard should, in particular, be observed in the ongoing national proceedings.

A request could only be filed in one or more of the three official languages of the FAC - English, French and German - as prescribed by the contracting state of the judicial body referring the question¹⁵²⁰.

¹⁵¹³ Art. 83a draft EPLA.

¹⁵¹⁴ §7 B.II.1.a) Organs of the European Patent Judiciary.

¹⁵¹⁵ See Art. 32 draft EPLA. This includes the provisions of the EPC and the provisions of national law which have been enacted by the contracting states to implement Articles 65, 67(2) and (3), 70(3) and (4) EPC, as well as the provisions on substantive law as implemented into the EPLA, such as those on infringing acts, indirect infringement or prior use.

¹⁵¹⁶ See Art. 83b draft EPLA.

¹⁵¹⁷ In Austria, for example, it is the Patent Office that has exclusive competence to revoke a patent. It would thus be possible for the Austrian Patent Office to request an opinion from the FAC if Austria joined the FAC part of the EPLA.

¹⁵¹⁸ Art. 83b draft EPLA.

¹⁵¹⁹ Art. 83c(4) draft EPLA. The proceedings concerning a preliminary ruling before the ECJ also include one single opportunity for the parties to present their comments.

¹⁵²⁰ Art. 83c(2) and (3) draft EPLA

The opinion would be given in writing by a majority of the panel of the FAC¹⁵²¹. It would certainly have to give reasons for its opinion. The detailed proceedings before the FAC would be regulated in its own rules of procedure¹⁵²².

The provisions with regard to the European Patent Court on substantive patent law, judicial independence, the impartiality of judges, composition - of the Court of Appeal - and selection of competent judges according to predetermined criteria, representation and possible membership of both instances would be applicable to procedures before the FAC *mutatis mutandis*¹⁵²³.

This overview already shows that the rules for the FAC are rather extensive. It may be wondered whether the once-discussed alternative proposal¹⁵²⁴ simply to provide the Court of Appeal with the power, on a request of a national judicial authority, to establish opinions on law would have not been a much simpler solution by which possibly to reach the initial goal of a contribution to harmonisation of jurisprudence¹⁵²⁵.

3. Can the Facultative Advisory Council unify the interpretation?

The following arguments in favour of a possible positive effect on harmonisation and uniformity were stated:

- First, the suggestion of combining the FAC with the second instance of the European Patent Court has the advantage that the FAC would enjoy a higher authority, which could lead to greater use by the national authorities¹⁵²⁶. This could be underscored by the fact that the opinions would be given by highly qualified judges, both legally and technically, from all EPC contracting states, as well as by its independence from the EPO¹⁵²⁷.

- Second, national authorities would not only request opinions on questions of law but on questions concerning infringement or the legal validity of European and national

¹⁵²¹ Art. 83c(5) draft EPLA.

¹⁵²² Art. 83c(6) draft EPLA.

¹⁵²³ Art. 83c(1) draft EPLA.

¹⁵²⁴ Cf. WPL/6/02.

¹⁵²⁵ Cf. also *Schneider*, 273.

¹⁵²⁶ Cf. WPL/10/00, 3.

¹⁵²⁷ Cf. WPL/10/00, 4.

patents¹⁵²⁸.

- Third, the approach that the opinions of the FAC have no binding effect on the requesting authority broadens the range of questions that could be submitted¹⁵²⁹.

- Fourth, the optional non-binding approach would also allow participation in the FAC by states which have constitutional and/or other legal or political problems with the full solution, and consequently provide for the greatest possible degree of acceptance¹⁵³⁰. The level of acceptance of the voluntary referral procedure would further increase if the referral was free of charge to a great extent¹⁵³¹.

However, the impact which the FAC will have on the unification of interpretation of European patent law is unclear, not least because only a limited number of the EPC contracting states showed a possible interest in an FAC. This situation could change once a date is set for a Diplomatic conference for the adoption of the EPLA.

The decision of these states possibly interested in the FAC to make the referral by national authorities optional and its opinion not binding greatly weakened the goal of a uniform interpretation. This in fact raises the question as to whether the aim of a unitary interpretation could be better reached by giving a wider range of possible questions to be submitted – as now suggested, or rather by a limitation of the substantive field with a mandatory referral and a binding effect of the opinion on the referring authority.

Time will answer this question, but there are several reasons that seem to indicate the latter approach would be more likely to succeed.

On the one hand, the Roman-law principle of *iura novit curia* is strongly anchored in most jurisdictions. Sovereignty reasons, but also the conviction that the national court knows its own law, or what it thinks is its own law, better - most of all concerning the policy parts of

¹⁵²⁸ Cf. WPL/10/00, 2.

¹⁵²⁹ Cf. WPL/6/00, N 178.

¹⁵³⁰ Cf. WPL/10/00, 5.

¹⁵³¹ Cf. WPL/10/00, 7.

patent law in relation to patentability (Articles 52 to 57 EPC) and the extent of protection (Article 69 EPC)¹⁵³² - are all reasons against a referral by a court to achieve uniformity¹⁵³³.

On the other hand, the courts could easily interpret the government's decision in favour of an optional non-binding approach as one that limits unification of interpretation to parts of patent law where economic policy does not play an important role. The argument that the national authorities will be attracted to request opinions, in particular relating to Articles 52 to 57 EPC, as well as to Article 69 EPC, including the Protocol on its interpretation¹⁵³⁴, because of the high-ranking and culturally mixed membership of the FAC delivering decisions of outstanding quality¹⁵³⁵, therefore seems questionable. By contrast, it could make a court rather reluctant to request an opinion regarding the interpretation of European patent law since it would have to search for very good arguments possibly to overrule the opinion¹⁵³⁶ if it is not happy with the effect of the decision on the national approach.

It could, however, be interesting for lower-level courts if they actually would like a change in policy which the higher court did not accept in earlier cases¹⁵³⁷. Such "rebellious acts" should, however, be rather limited.

It therefore seems quite unclear whether a referral free of charge would in fact be attractive enough for a court to refer such delicate questions. However, sufficient motivation also seems problematic in regard to less delicate questions, as, for example, experience with technical opinions of the EPO shows.

a) The EPO's experience with technical opinions

Article 25 EPC provides for the possibility of the national courts trying an infringement or revocation action to request a technical opinion of the EPO Examining Division concerning the European patent that is the subject of the action.

¹⁵³² For a good example, see: *Tilmann/Jacob*.

¹⁵³³ Cf. also *Linhart*, 167.

¹⁵³⁴ Cf. WPL/10/00, 2.

¹⁵³⁵ Cf. WPL/10/00, 5.

¹⁵³⁶ Also cf. Brunner Eugen, *Der Gerichtsexperte im Patentprozess aus der Sicht des Richters, insbesondere das Verhältnis Richter und Sachverständiger im Prozess*, 1985 SMI, 171-178, 175-176.

¹⁵³⁷ Cf. *Snell*, 197.

The technical knowledge of the EPO is well known¹⁵³⁸. However, despite

- the relatively low fixed fee - currently €3 185¹⁵³⁹ per opinion - and the rule

- that the Examining Division must decline to make any specific statement on whether a patent is valid or on whether it has been infringed, or to give any opinion on the extent of protection¹⁵⁴⁰, and

- that the Examining Division must clearly concentrate on the technical aspects,

it came to light that the EPO is hardly ever asked to act as a technical court expert subject to the relevant national procedural rules¹⁵⁴¹.

The efforts of the EPO to make a referral more popular have all ultimately failed¹⁵⁴².

A reason for this hesitation could be that the EPO was rather reluctant to execute the request for an opinion where an opposition procedure was still pending¹⁵⁴³, slowing down the procedure¹⁵⁴⁴. This can, to a certain extent, be used as a plausible explanation for this situation. It should be noted, however, that it took many years for the first request for an opinion even to be filed¹⁵⁴⁵.

A major reason could also be seen in the fact that many courts only rarely seek recourse to experts, not least since they are often able to manage without technical experts¹⁵⁴⁶.

Another reason could be that courts think that the EPO is too far removed from "practice," living in an ivory tower, as it were: a presumption that might only be true to a certain extent, as it is for any administrative public authority.

¹⁵³⁸ Cf. Singer Margarete/Stauder Dieter in: *Singer/Stauder, 4. Auflage*, Art. 25, N 1.

¹⁵³⁹ See EPO Schedule of fees and expenses, applicable as from 13 December 2007.

¹⁵⁴⁰ Cf. *Guidelines for Examination in the EPO*, Part E, Chapter XII, 2.

¹⁵⁴¹ Cf. *Kolle, Expert*, 635.

¹⁵⁴² Cf. *Kolle/Stauder, Symposia*, 958.

¹⁵⁴³ Cf. *Willems, Report*, 878.

¹⁵⁴⁴ Cf. Gauye Wolhändler Fabienne/Stauder Dieter/Joos Ulrich/Kolle Gert, Record of Proceedings and Conclusions, Eighth Symposium of European Patent Judges, 1997 IIC, 914-923, 921-922.

¹⁵⁴⁵ Cf. also *Kolle, Expert*, 633-634.

¹⁵⁴⁶ Cf. *Kolle, Expert*, 634; cf. however e.g., *Brunner, Patentnichtigkeit*, 25 and *Pedrazzini*, 169, who plead that use should normally be made of expert opinions in patent cases.

Additionally, a request to the EPO for an opinion could also involve psychological factors to some extent. On the one hand, certain courts could feel that dealing with an external authority might lead to a complicated and troublesome procedure¹⁵⁴⁷, or they might even wrongly feel embarrassed¹⁵⁴⁸ for asking the EPO for an opinion, not wanting to convey the impression that they have insufficient knowledge in the patent field. Or maybe it is just not known to all courts, especially if they hardly ever deal with patent cases, that they could ask the EPO for a technical opinion. Moreover, depending on the parties and the pecuniary interests of the representatives and advisors involved, it could also be of no advantage for the EPO to be contacted. The parties would consequently not draw the attention of the court to that option.

On the other hand, with regard to a technical question, if a court asks the body that actually granted the patent in question, or was even involved in opposition proceedings, this could raise questions concerning the independence of the court¹⁵⁴⁹.

However, a major reason would again probably be that the courts fear possible interference in their freedom to render their own independent ruling, as it is often impossible to draw a clear dividing line between the technical and legal aspects of the issues at stake¹⁵⁵⁰.

An external influence on sovereignty could possibly be more readily acceptable to a state and a court if its "own" judges were involved in the body and in the formation of the opinion¹⁵⁵¹. This is suggested with regard to the FAC.

It therefore seems surprising that, despite this fact, many states that are interested in an FAC seem still to insist on a non-binding effect of the opinion. This underlines once more the lack of will to support unification wholeheartedly. This analysis increases scepticism about a successful mission of the FAC even more.

¹⁵⁴⁷ Cf. *Kolle, Expert*, 635.

¹⁵⁴⁸ Cf. also *Pedrazzini*, 166.

¹⁵⁴⁹ Cf. *Kolle, Expert*, 635.

¹⁵⁵⁰ Cf. *Pedrazzini*, 163; *Brunner, Verwertung*, 25; *Kolle, Expert*, 638.

¹⁵⁵¹ Cf. *Brinkhof, Desirability*, 229.

The function of the FAC thus seems rather political in having the ability to give the opportunity still to be part of the newly created litigation system to the states that are not (yet) able to accept the European Patent Court as their "own" court¹⁵⁵².

IV. Conclusion with regard to unification of interpretation amongst bodies giving opinions on law

An international referral body helps to unify the interpretation of law to a substantial degree only if as many contracting states as possible accept such a body and the national authorities actually refer to it.

In fact, a sufficient number of referrals would be necessary to allow the body to develop abstract principles applicable in all cases based on its opinions "on the facts"¹⁵⁵³.

Furthermore, the national authorities should at least feel obliged to accept the referral body's views to a certain extent as well.

The most promising results are achieved, therefore, if the referral is mandatory and the opinion is binding.

One disadvantage of an obligatory referral is that it possibly slows down proceedings if the referring instance has to stay its proceedings during the opinion-making process¹⁵⁵⁴. Long delays can be avoided, however, if clear and binding deadlines within which the opinion has to be drawn up are determined. If a mandatory referral is unacceptable the opinions of the referral body should at least be binding. The effect would be, however, that the courts could be very reluctant to refer questions of law to an independent body that would have an influence on national policy.

A model that is based on pure will and exerts no pressure on the national authorities seems to be a rather weak option in regard to unification of interpretation. Uniformity could only be reached in this case if the current major litigation courts clearly involve themselves in reference proceedings, and if they are ready to accept possible policy changes by the opinions given. Experience and history have taught us, however, that most courts are not ready for that step if their own governments have not clearly signalled that they accept

¹⁵⁵² Cf. *Luginbuehl*, 264.

¹⁵⁵³ Cf. also *Snell*, 190.

¹⁵⁵⁴ Cf. also *Stauder, Future*, 182.

such outside interference. Constituting a body with prominent experts from countries accepting that body could increase the motivation for a referral.

D. Harmonisation of court proceedings and substantive patent law

I. Introduction

It seems indisputable that procedural law has an influence on the exercise of rights and the interpretation of substantive (patent) law¹⁵⁵⁵. It is therefore no surprise that the Paris Convention already requested seizure measures with regard to trade marks to ensure that nationals of other contracting states use appropriate legal remedies to effectively repress these acts¹⁵⁵⁶.

More detailed procedural rules were introduced in the TRIPs Agreement. In fact, the TRIPs Agreement may have been the very first international instrument to regulate domestic IPR-related procedures in such detail¹⁵⁵⁷.

However, as mentioned earlier, most of the measures in the TRIPs Agreement - which include substantive and procedural rules¹⁵⁵⁸ - only prescribe minimum obligations¹⁵⁵⁹ in order to smooth over major policy agreements¹⁵⁶⁰. It is, furthermore, up to each national jurisdictional system to enforce these obligations¹⁵⁶¹. Harmonisation was therefore - at least in terms of its enforcement part - not aimed directly at bringing in line procedural law, as in the Paris Convention, but rather at providing effective and appropriate means for the enforcement of trade-related IPRs¹⁵⁶² and to ensure that enforcement procedures are applied in such a manner as to avoid the creation of barriers to legitimate trade and to provide safeguards against their abuse¹⁵⁶³.

It seems that even these minimum obligations cannot always be fulfilled.

¹⁵⁵⁵ Cf. *Messerli*, 142; *Brinkhof, Kort Geding*, 499; *Willems, First instance*, 396; *Geller*, 129-130; *König, Probleme*, 302; *Tilmann, Gemeinschaftspatent*, 887-888; *Chisum*, 614.

¹⁵⁵⁶ Cf. Art. 9 to 10^{ter} Paris Convention.

¹⁵⁵⁷ Cf. *Cottier*, 410; *Otten/Wager*, 403.

¹⁵⁵⁸ Cf. *Ryberg*, 905-906.

¹⁵⁵⁹ Cf. *Dreier*, 249; *Cottier/Germann*, 84; *Woolridge*, 240; *Cottier/Tran*, 635, 636; *Brinkhof, Wish List*, 407.

¹⁵⁶⁰ Cf. *Berman*, 400.

¹⁵⁶¹ Cf. Art. 41(1) TRIPs Agreement; *Straus, Fair*, 810; *Haas F.-W.*, 158.

¹⁵⁶² Cf. Preamble of TRIPs Agreement, lit. (c) and Art. 41(5) TRIPs Agreement. Cf. also *Haas F.-W.*, 154.

¹⁵⁶³ Cf. *Otten/Wager*, 403.

The USA, for example, requested consultations - even with some European states - in several cases due to the absence of measures for the enforcement of IPRs as provided for in the TRIPs Agreement¹⁵⁶⁴. The fear that this minimal protection would not be achieved¹⁵⁶⁵ by all states bound by the TRIPs Agreement became more evident later on, leading to the Enforcement Directive in the EU, and was also discussed in the WIPO Advisory Committee on Enforcement. It became clear that, in the end, national authorities could not everywhere be successfully relied on to fulfil these minimal obligations.

II. Common rules regarding civil procedure at the European level

1. Introduction

Legal unity and the harmonisation of laws are important aspects in developing common areas with similar living conditions¹⁵⁶⁶. However, there is currently no existing agreement at Community or other levels that would bind the European states sufficiently to create a fully unified civil procedure.

With the EC Treaty of Amsterdam¹⁵⁶⁷ it was decided among the EU member states to establish an area of justice and to adopt measures in the field of judicial cooperation in civil matters as provided for in Article 65¹⁵⁶⁸ of the treaty.

¹⁵⁶⁴ Cf. Dörmer Sigrid, Dispute Settlement and New Developments Within the Framework of TRIPS - An Interim Review, 2000 IIC, 1-37, 24-26.

¹⁵⁶⁵ Cf. Staehelin, 179-180; Ryberg, 910.

¹⁵⁶⁶ Cf. Prütting, 169.

¹⁵⁶⁷ Cf. Adolphsen, *Europäisches*, N 25 to N 26.

¹⁵⁶⁸ Art. 65 EC Treaty:

"Measures in the field of judicial cooperation in civil matters having cross-border implications, to be taken in accordance with Article 67 and in so far as necessary for the proper functioning of the internal market, shall include:

(a) improving and simplifying:

— the system for cross-border service of judicial and extrajudicial documents,

— cooperation in the taking of evidence,

— the recognition and enforcement of decisions in civil and commercial cases, including decisions in extrajudicial cases;

(b) promoting the compatibility of the rules applicable in the member states concerning the conflict of laws and of jurisdiction;

(c) eliminating obstacles to the good functioning of civil proceedings, if necessary by promoting the compatibility of the rules on civil procedure applicable in the member states."

This goal was obviously intended to be reached *inter alia* by transferring some of the already existing international conventions concerning judicial cooperation¹⁵⁶⁹ - in particular of the Hague Conference on Private International Law -¹⁵⁷⁰ into secondary Community law¹⁵⁷¹, making them binding among all EU member states, if they were not already, and giving rise to a uniform interpretation by the ECJ to a certain extent.

On the basis of the provision in the EC Treaty of Amsterdam, the European Commission quickly presented harmonisation proposals¹⁵⁷². Many of them have meanwhile been implemented. Amongst most EU member states there currently exist more than ten Regulations or agreements that regulate certain parts of civil proceedings¹⁵⁷³. For example, with regard to jurisdiction and the recognition and enforcement of judgments in civil and commercial matters there is Regulation 44/2001, or Regulation 2201/2003 with regard to judgments in matrimonial matters¹⁵⁷⁴. Concerning general judicial cooperation, the EU has implemented, for example, the Regulation on the service of judicial and extrajudicial documents¹⁵⁷⁵, the Regulation on court cooperation in the taking of

¹⁵⁶⁹ Cf. *Pirrung*, 790.

¹⁵⁷⁰ Cf., for example, the Hague Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters of 15.11.1965 and the Hague Convention on the Taking of Evidence Abroad in Civil or Commercial Matters of 18.3.1970.

¹⁵⁷¹ Regulation 44/2001 is, for example, grounded on the Brussels Convention but see also the Hague Convention on the Recognition and Enforcement of Foreign Judgments in Civil and Commercial Matters of 1.2.1971.

¹⁵⁷² Cf. *Remien, European*, 57.

¹⁵⁷³ Cf. *Siehr, Weg*, 91.

¹⁵⁷⁴ Council Regulation (EC) No. 2201/2003 of 27.11.2003 on the jurisdiction, recognition and enforcement of judgments in matrimonial matters and in matters of parental responsibility, repealing Council Regulation (EC) No. 1347/2000. The European Commission in the meantime also submitted a proposal to add provisions concerning applicable law in matrimonial matters to the Regulation, cf. Proposal for a Council Regulation amending Council Regulation (EC) No. 2201/2003 of 17.7.2006 as regards jurisdiction and introducing rules concerning applicable law in matrimonial matters, COM(2006) 399 final. However, the proposal is far from becoming law, as many states seem unable to comprehend the idea of applying foreign family law (cf. *Wagner*, 628).

¹⁵⁷⁵ Council Regulation (EC) No. 1348/2000 of 29.5.2000 on the service in the member states of judicial and extrajudicial documents in civil or commercial matters. As of 13.11.2008, this Regulation will be replaced by Council Regulation (EC) No. 1393/2007 of 13.11.2007. The modifications with respect to Council Regulation No. 1348/2000 particularly focus on additional harmonisation of the procedure and on increasing the efficiency of the service, such as the

- introduction of a rule that the receiving agency shall take all necessary steps to effect the service of the document as soon as possible, and in any event within one month of receipt,
- introduction of a new standard form to inform the addressee about his right to refuse to accept the document to be served at the time of service or by returning the document to the receiving agency within one week,
- introduction of a rule providing that costs occasioned by recourse to a judicial officer or to a person competent under the law of the Member State addressed shall correspond to a single fixed fee laid down by that Member State in advance which respects the principles of proportionality and non-discrimination, or the
- introduction of uniform conditions for service by postal services. Cf. also *Wagner*, 627.

evidence¹⁵⁷⁶, the Regulation on a European enforcement order for uncontested claims¹⁵⁷⁷, the Regulation on the law applicable to non-contractual obligations ("Rome II"), the Regulation establishing a small claims procedure¹⁵⁷⁸, or the Directive on common rules relating to legal aid in cross-border disputes¹⁵⁷⁹.

More proposals for EC Regulations and Directives will follow on the basis of the legal mandate of Article 65 EC Treaty¹⁵⁸⁰, not least as the revised Article 65(1) Treaty of Lisbon now holds that judicial cooperation in civil matters having cross-border implications may include the adoption of measures for the approximation of the laws and regulations of the EU member states. How far the EU can go on the basis of this (revised) provision is, however, unclear¹⁵⁸¹.

The United Kingdom, Ireland and Denmark did not participate in the adoption of the proposed measures pursuant to Article 65 EC Treaty¹⁵⁸². These countries decide on an *ad hoc* basis whether they would like to participate, and adopt and implement the EC Regulations. In particular, Denmark is rather reluctant to adopt and apply the Regulations¹⁵⁸³. Nevertheless, in 2005, for example, two agreements¹⁵⁸⁴ between the EC

¹⁵⁷⁶ Council Regulation (EC) No. 1206/2001 of 28.5.2001 on cooperation between the courts of the member states in the taking of evidence in civil and commercial matters; see also Berger Christian, Die EG-Verordnung über die Zusammenarbeit der Gerichte auf dem Gebiet der Beweisaufnahme in Zivil- und Handelssachen (EuBVO), 2001 IPRax, 522-527.

¹⁵⁷⁷ Council Regulation (EC) No. 805/2004 of 21.4.2004 creating a European Enforcement Order for uncontested claims and Commission Regulation (EC) No. 1869/2005 of 16.11.2005 replacing the Annexes to Council Regulation (EC) No 805/2004.

¹⁵⁷⁸ Council Regulation (EC) No. 861/2007 of 11.07.2007 establishing a small claims procedure. The important provisions will, however, not enter into force before 1.1.2009 (cf. Art. 29 of the Regulation).

¹⁵⁷⁹ Council Directive 2003/8/EC of 27.1.2003 to improve access to justice in cross-border disputes by establishing minimum common rules relating to legal aid for such disputes.

¹⁵⁸⁰ Cf. for example Proposal for a Council Regulation on the law applicable to contractual obligations (Rome I) of 15.12.2005, COM(2005) 650 final; cf. also *Wagner*, 628-629.

¹⁵⁸¹ Cf. *Remien*, *European*, 74-75 with regard to the EC Treaty.

¹⁵⁸² See the Protocols on the position of these three countries annexed to the EC Treaty as amended by the Amsterdam Treaty and Art. 69 EC Treaty.

¹⁵⁸³ Cf. *Nielsen*.

¹⁵⁸⁴ Cf. on the one hand, Council Decision of 20.9.2005 on the signing, on behalf of the Community, of the Agreement between the European Community and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, and the Agreement referred to (2005 O.J. EU, L 299, 61), and Council Decision of 27.4.2006 concerning the conclusion of the Agreement between the European Community and the Kingdom of Denmark on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (2006 O.J. EU, L 120, 22).

On the other hand, cf. Council Decision on the signing, on behalf of the Community, of the Agreement between the European Community and the Kingdom of Denmark on the service of judicial and extrajudicial documents in civil or commercial matters of 20.9.2005, and the Agreement referred to (2005 O.J. EU, L 300, 53), and Council Decision concerning the conclusion of the Agreement between the European Community and the Kingdom of Denmark on the service of judicial and extrajudicial documents in civil or commercial

and Denmark were concluded which expand to a great extent the Regulation on the service of judicial and extrajudicial documents and Regulation 44/2001 to the territory of Denmark¹⁵⁸⁵.

A more attentive role with regard to the harmonisation and unification of civil procedural law in Europe was also taken by the ECJ¹⁵⁸⁶. Its possibilities were, however, limited to the existing given legal framework.

Without doubt, the common rules at the European level on jurisdiction and, in particular, the *ipso iure* recognition and enforcement of each other's judgments facilitated cross-border litigation¹⁵⁸⁷.

This could be further improved with the abolition of the *exequatur* proceedings which have to be initiated in order for a judgment to be recognised and enforced in another state. This would finally lead to an automatic full mutual recognition of each other's judgments¹⁵⁸⁸.

A first step in this direction was taken with the adoption of the above-mentioned Regulation establishing a small claims procedure, where any judgment given in such a procedure is enforced under the same conditions as a judgment given in the EU member state of enforcement¹⁵⁸⁹. However, the scope of application of the Regulation is limited to claims where the value does not exceed € 2 000. It is quite clear, therefore, that this Regulation will hardly ever, if at all, apply to patent litigation.

matters of 27.4.2006 (2006 O.J. EU, L 120, 23). The agreements entered into force on 1 July 2007 (2007 O.J. EU, L 94, 70).

¹⁵⁸⁵ Cf. *Nielsen*.

¹⁵⁸⁶ Cf. *Walter/Walther*, 8-16; *Siehr, Weg*, 92.

¹⁵⁸⁷ Cf. *Stadler, Brussels*, 1638.

¹⁵⁸⁸ Cf. Frattini Franco, *European Area of Civil Justice - Has the Community Reached the Limits?* 2006 ZEuP, 225-235, 227-228.

¹⁵⁸⁹ Cf. Art. 21(1) Council Regulation (EC) No. 861/2007 of 11.07.2007 establishing a small claims procedure. The important provisions will, however, not enter into force before 1.1.2009 (cf. Art. 29 of the Regulation).

2. The patchwork approach of the European Union

The situation with regard to civil proceedings in Europe can be described as an incomplete and unfinished patchwork¹⁵⁹⁰. Initiatives in the past to overcome this situation with a common set of rules were not very successful.

Storme initiated the establishment of a unified European Code of Civil Procedure, quite some time ago. The so-called "Working Group for the Approximation of the Civil Procedural Law in Europe" created, under his leadership, a very interesting and important proposal¹⁵⁹¹ that was the subject of great respect¹⁵⁹². However, despite the official mandate of the EU given by the EU to the working group, the result was not heard at the political level¹⁵⁹³.

The legal patchwork approach¹⁵⁹⁴, as codified in the EC Treaty, shows that the EU member states do not currently have the intention of creating a common set of rules of civil procedure at the Community level.

The progress of the European Union is characterised by political discourse and careful steps forward in general. It is felt that only a continuous partial harmonisation has a real chance of success at the accepted state of European integration¹⁵⁹⁵.

The judicial unification of the rules of procedure in civil matters, as is the case with regard to private international law¹⁵⁹⁶, will therefore continue with little steps. Unfortunately, even these small steps often result in compromises, either proposing a cursory harmonisation or watering down the general suggestions so that only a very limited regulation is left¹⁵⁹⁷. As *Ullrich* observed "*a common feature of harmonisation in support of unification seems to be its limitation to a minimum*"¹⁵⁹⁸.

¹⁵⁹⁰ Cf. Storme Marcel, Die Vorarbeiten für eine Europäische Zivilprozessordnung und Österreich, 100 Jahre Österreichische Zivilprozessgesetze, Mayr Peter G. (ed.), Wien 1998, 197, 203.

¹⁵⁹¹ Cf. *Judiciary Law*.

¹⁵⁹² Cf. *Gilles*, 13.

¹⁵⁹³ Cf. *Walter/Walther*, 33; *Stadler, Europäisierung*, 674.

¹⁵⁹⁴ Cf. also Wagner Rolf, Zur Vereinheitlichung des Internationalen Privat- und Zivilverfahrensrechts sechs Jahre nach In-Kraft-Treten des Amsterdamer Vertrags, NJW 2005, 1754-1757.

¹⁵⁹⁵ Cf. *Kerameus*, 182.

¹⁵⁹⁶ For an overview cf. *Siehr, Weg*, 92-95; *Wagner*.

¹⁵⁹⁷ Cf. also *Harte-Bavendamm*, 795.

¹⁵⁹⁸ Cf. *Ullrich, Harmony*, 26.

A patchwork approach has its limits, however, as it implies a considerable danger of a jungle of differing applicable regulations based on varying legal instruments at the European and national levels, leading to unclear situations concerning law and competences. Harmonisation would not provide simplification, thereby reducing the complexity of the procedure¹⁵⁹⁹. This is not only a problem for practitioners of the law and the legislator¹⁶⁰⁰, but also for the public at large, who will question the legal protection and quality and, as a consequence, stray from a legal system¹⁶⁰¹ that becomes less and less transparent and possibly even chaotic¹⁶⁰².

Community law harmonising certain parts of law - often with a lack of coordination between the different Community instruments - cannot provide for a complete and well-adapted system that would ensure the necessary interplay between Community law and pre-existing nationally developed systems of law. In addition, Community law has been criticised for often being too quickly adopted, and consequently proven to be not very well planned¹⁶⁰³, although it should be clear that it is simply impossible to create law that fits perfectly into the legal systems of, in the meantime, 27 EU member states.

The patchwork approach may therefore endanger legal certainty in an area of the law such as civil procedure, where a functional closed system with considerable interaction seems so important. Hence, step-by-step harmonisation of civil procedure also entails a great potential for questioning an efficient and qualified implementation of substantive (patent) law¹⁶⁰⁴. All these problems will not make it any easier to convince the users of the system that the current Community approach with regard to the harmonisation of civil procedure is the right one¹⁶⁰⁵.

¹⁵⁹⁹ Cf. *Gall*, 142.

¹⁶⁰⁰ Cf. *Siehr, Weg*, 95.

¹⁶⁰¹ Cf. also *Gilles*, 30-31.

¹⁶⁰² Cf. *Siehr, Weg*, 95.

¹⁶⁰³ Cf. *Stadler, Europäisierung*, 674-675; also cf. *Cornish/Drexl/Hilty/Kur, Hamburg Group*.

¹⁶⁰⁴ For example, the Enforcement Directive should have gone much further at the beginning, introducing different but limited aspects of procedural remedies and sanctions, but it was feared that these might endanger the smooth running of national civil procedure, cf. *Cornish/Drexl/Hilty/Kur*.

¹⁶⁰⁵ Also cf. the critical remarks of the European Commission with regard to that fragmentation in the Greenpaper on Consumer Protection, COM(2001) 531 final, Brussels, 2.10.2001.

What is not very helpful in that regard is the fact that the parts of civil procedure which seem more open to harmonisation and uniformity¹⁶⁰⁶ and have less impact on national procedures are becoming fewer and fewer, and the more difficult parts, such as the organisation of jurisdiction, the detailed process of the procedure, the powers of the courts, etc., will have to be put on the negotiation table.

Once this stage has been reached, it would be much more promising to move from top to bottom with regard to the creation of a comprehensive procedural system: that is to say, harmonise or unify the fundamental principles of civil procedure first - for example some general principles, such as the principle of party decision, the principle of free evaluation of evidence, the obligation of the court to maintain an active case management, or the general structure of proceedings, including a written and oral hearing phase - and then move on to further details¹⁶⁰⁷. This would be much more easily achieved if fewer states with less different interests have to be included in the negotiations, especially if the states that actually have little or no interest in the harmonisation and uniformity of these aspects of law do not have to participate in the negotiations. The Intergovernmental conference of the EPC contracting states of Paris went that way and mandated the Working Party on Litigation to present a draft text for an *optional* patent litigation instrument¹⁶⁰⁸. It will be very important to involve states which come from different legal systems in the negotiations. Final rules which take into consideration civil and common law principles, for example, will make it easier even for other states to accept them.

The internationalisation¹⁶⁰⁹, or rather "Communitarisation" of national civil procedure¹⁶¹⁰ will continue, not least also because it must ensure the harmonised enforcement of substantive Community law¹⁶¹¹, providing for uniform results. This process could, however, slow down because of the continuous unclear integration¹⁶¹². One can only hope that Europe will soon take a clear decision on the direction in which it would like to move. Up till

¹⁶⁰⁶ For aspects of civil procedure which seem to be predestined to harmonisation to a greater or lesser extent, cf. *Prütting*, 173.

¹⁶⁰⁷ Cf. also *Gilles*, 27-28. As regards the risks, cf. §6 D.IV. Conclusions with regard to a unification of the interpretation of European patent law by way of a harmonisation of procedural law.

¹⁶⁰⁸ Cf. 1999 O.J. EPO, 548.

¹⁶⁰⁹ Cf. *Gilles*, 5.

¹⁶¹⁰ Cf. *Stadler, Europäisierung*, 673.

¹⁶¹¹ Cf. also *Delicostopoulos*.

¹⁶¹² Cf. also *Stadler, Brussels*, 1661 and Jayme Erik/Kohler Christian, *Europäisches Kollisionsrecht 2007: Windstille im Erntefeld der Integration*, 2007 IPRax, 493-506.

now, procedural law and practice have been national affairs to a great extent¹⁶¹³, as mentioned earlier¹⁶¹⁴, and therefore differ significantly throughout Europe¹⁶¹⁵.

3. Uniform law concerning patent litigation

Unified rules concerning IPR civil procedure with an impact on patent litigation exist within the EU with the Regulation on customs action against IPR-infringing goods¹⁶¹⁶ and, in particular, with the Enforcement Directive.

The project to create the Enforcement Directive would have been an important step in the direction of a unified procedure with regard to IPRs. The harmonisation goal led to the European Commission's conclusion that the Directive should have its legal basis in Article 95 EC Treaty¹⁶¹⁷, which has its objective in the establishment of the internal market through harmonisation of the legislative, regulatory and administrative provisions¹⁶¹⁸. Already, the ECJ held that different results with regard to the enforcement of IPRs in the European Union are an obstacle to the creation of a common market¹⁶¹⁹.

Unfortunately, the step now taken by the finally adopted Directive was once again too small¹⁶²⁰, only providing for minimal common grounds. The final result clearly fell short of expectations for creating "best practice" rules¹⁶²¹, as well as the first proposal made by the European Commission¹⁶²².

¹⁶¹³ Cf. *Bertrams*, 634 with reference to Brinkhof Jan, "Europees octrooirecht, internationale normen, nationale regeltoepassing" (Zwolle 1989).

¹⁶¹⁴ Cf. §3 B.V. Procedural differences and court practices.

¹⁶¹⁵ Cf. *Willems, Blueprint*, 16 and also Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final, 13-16.

¹⁶¹⁶ Council Regulation (EC) No. 1383/2003 of 22.7.2003 concerning customs action against goods suspected of infringing certain intellectual property rights and the measures to be taken against goods found to have infringed such rights.

¹⁶¹⁷ The substance of this provision did not change with the Treaty of Lisbon.

¹⁶¹⁸ Cf. *Spain v Council of the European Union*, ECJ July 13, 1995, (case C-350/92); *Federal Republic of Germany v European Parliament and Council of the European Union*, ECJ October 5, 2000 (case C-376/98); Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final, 16-18.

¹⁶¹⁹ *Kingdom of the Netherlands v Council of the European Union and the European Parliament*, ECJ October 9, 2001 (case C-377/98).

¹⁶²⁰ Cf. also *Charles*, 485.

¹⁶²¹ Cf. *Harte-Bavendamm*, 798.

¹⁶²² Cf. Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final. For a historical overview cf. *Harte-Bavendamm*, 794-798.

It should not be forgotten, however, that the aim of the European Commission was to ensure that IPRs were enforced in an equivalent fashion throughout the Community even after the accession of the ten new states, but within the existing national frameworks. It was consequently suggested by the European Commission that only an EC Directive and not an EC Regulation should be adopted¹⁶²³. Nevertheless, the double goal of satisfying both needs, to combat counterfeiting and piracy on the one hand, and the desire to harmonise national civil procedures and remedies for infringements of IPRs¹⁶²⁴ on the other, merely watered down the initial proposal - not least leading to optional and mandatory measures which have to be implemented. Whereas the IP lobby wanted the strongest measures possible, it was the European Parliament - and particularly the open source movement¹⁶²⁵ - that wanted a more limited approach. The recommended criminal sanctions were therefore excluded from the scope¹⁶²⁶, and quite a number of other suggestions that seemed to impinge on the sovereignty of the member states in relation to civil procedure became more general¹⁶²⁷.

The outcome with regard to the Enforcement Directive could be summarised as a transfer of the TRIPs Agreement enforcement rules into Community law, including minimal further harmonisation of civil procedure and remedies with regard to IPRs. As a result, it is no longer a question of whether the measures as provided for in the TRIPs Agreement are also applicable to purely Community cases¹⁶²⁸ and whether the general balance of national civil procedure was not endangered by a limited harmonisation at the Community level¹⁶²⁹.

¹⁶²³ Cf. Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final, 16.

¹⁶²⁴ Cf. Massa Charles-Henry/Strowel Alain, *The Scope of the Proposed IP Enforcement Directive: Torn between the Desire to Harmonise Remedies and the Need to Combat Piracy*, 2004 EIPR, 244-253, 244; *Würfel*.

¹⁶²⁵ Cf. *Würfel*, 209.

¹⁶²⁶ It should be noted that the European Commission has in the meantime submitted a proposal for a Directive on criminal measures (Proposal for a European Parliament and Council Directive of 12.7.2005 on criminal measures aimed at ensuring the enforcement of intellectual property rights, COM(2005) 276 final). First hearings showed that it would be difficult to reach an agreement, not least with regard to patent rights (cf. Schneider Marius/Vrins Olivier, *The EU offensive against IP offences: Should right-holders be offended?*, 2006 JIPLP, 173-176). It was consequently decided to exclude patent rights from the scope of the Directive.

¹⁶²⁷ Cf. *McGuire, Enforcement*, 256.

¹⁶²⁸ Cf. *McGuire, Enforcement*, 256.

¹⁶²⁹ Cf. also the fears in that regard expressed by *Cornish/Drexler/Hilty/Kur; Ullrich, Harmony*, 43.

It was therefore also no surprise that most national civil proceedings¹⁶³⁰ and the latest draft for an EPLA will only have to, and had to, be revised to a limited extent¹⁶³¹ to be in line with the Enforcement Directive¹⁶³².

As a consequence of this situation, variations in European procedural laws applicable to patent litigation will also in the future possibly result in different determinations of the extent of protection of a European patent. A further harmonisation of procedural law would therefore not only provide for better and more efficient enforcement of patent rights¹⁶³³ but would also be another step in the direction of uniform interpretation, consequently ensuring legal equality and legal certainty¹⁶³⁴. The question arises, then, as to what minimal standard laws have to be unified to provide for uniformity in the interpretation of European patent law.

III. Crucial points of procedure with an effect on the interpretation of European patent law

Experts seem to agree that provisional measures and the associated taking and gathering of evidence, as well as certain fundamental procedural principles¹⁶³⁵, make up a crucial part of all the important elements that should be unified¹⁶³⁶.

1. Provisional measures

The efficiency of a system which is designed to protect any right greatly depends on its ability to prevent infringing acts from occurring or continuing¹⁶³⁷.

¹⁶³⁰ Cf., for example, for France: *Brüning-Petit, Directive*; for the United Kingdom: *Huniar*, 92-99; for Germany, however, more amendments seem necessary, cf. Knaak Roland, *Die EG-Richtlinie zur Durchsetzung der Rechte des geistigen Eigentums und ihr Umsetzungsbedarf im deutschen Recht*, GRUR INT. 2004, 745-750.

¹⁶³¹ However, a new feature for most states provided by the Enforcement Directive is the right to third-party information (cf. *Kur, Enforcement Directive*, 830), which was likewise not provided for in previous versions of the EPLA (cf. revised Art. 68 draft EPLA, WPL/10/05).

¹⁶³² Cf. WPL/10/05; *Willems, Trojan Horse*, 332-333.

¹⁶³³ Cf. *Ryberg*, 907; Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final, 16.

¹⁶³⁴ Cf. *Brinkhof, Schlichtung*, 601.

¹⁶³⁵ Cf. also §6 D.II.2. The patchwork approach of the European Union.

¹⁶³⁶ Cf. *Schade, Protocol*, 174; *Brinkhof, Change*, 106; *Jacob, Future*, 116; *Ryberg*, 910-912; *Willems, Harmonisation*, 198.

Provisional measures are therefore an essential part of most civil proceedings, and especially in the intellectual property field. It is therefore also said that Article 50 TRIPs Agreement - which regulates provisional measures - is actually the most important provision of the enforcement part¹⁶³⁸.

It is generally accepted that provisional and protective measures have as their function the securing of assets out of which an ultimate judgment may be satisfied or maintenance of the status quo pending determination of the issue at trial¹⁶³⁹.

This is also reflected in Article 50(1) TRIPs Agreement, which provides that the judicial authorities shall have the authority to order prompt and effective provisional measures:

- (a) to prevent an infringement of any intellectual property right from occurring, and in particular to prevent the entry into channels of commerce in their jurisdiction of goods, including imported goods immediately after customs clearance;
- (b) to preserve evidence in regard to the alleged infringement.

However, also with regard to provisional measures, the TRIPs Agreement only regulates the minimum requirements¹⁶⁴⁰ and consequently involves a risk of differences in jurisprudence among the EPC contracting states. In the proposal for an Enforcement Directive, the suggestion was therefore made to introduce further such measures that would have supplemented those of Article 50 TRIPs Agreement¹⁶⁴¹. As already mentioned, not much extra was left in the final Article 9 Enforcement Directive¹⁶⁴².

¹⁶³⁷ See *Straus, Fair*, 812.

¹⁶³⁸ Cf. *Gervais*, N 2.422.

¹⁶³⁹ Cf. *ILA, PPM principles*, N 3; N 19; also cf. Art. 18a(2) Proposal for a Council Act establishing the Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters in the Member States of the European Union (COM(1997) 609 final, 1998 O.J. EC, C 33, 31 January 1998, 20) for a definition of the term "provisional, including protective, measures": "*For the purposes of this Convention, provisional, including protective measures means urgent measures for the examination of a dispute, for the preservation of evidence or of property pending judgment or enforcement, or for the preservation or settlement of a situation of fact or of law of the purpose of safeguarding rights which the courts hearing the substantive issues are, or may be, asked to recognize.*"

¹⁶⁴⁰ Cf. *Dreier*, 263.

¹⁶⁴¹ Cf. Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final, 21.

¹⁶⁴² Cf. *Kur, Enforcement Directive*, 825; *McGuire, Enforcement*, 256.

The variations in preliminary measures in Europe are consequently great - not only in number but also in their nature and content¹⁶⁴³, and often these differences seem to be the result of the traditions and approaches adopted by the courts¹⁶⁴⁴. As mentioned, the variation is also a reason for extensive *forum shopping*¹⁶⁴⁵. Since the possibility of obtaining preliminary injunctions is classed as a vital element in modern patent litigation,¹⁶⁴⁶ it is no surprise that harmonisation has been requested, and is still requested today.

What impact does preliminary relief have on the interpretation of (patent) law, however?

As mentioned earlier, the major task of provisional and protective measures is to maintain the status quo and to see that certain rights are safeguarded, so that the parties have a chance to argue their claims on the merits¹⁶⁴⁷. This makes it clear that differences in the time limit for requesting preliminary relief¹⁶⁴⁸, the addressees, the effect on ancillary proceedings¹⁶⁴⁹ etc., may all have a great influence on the outcome of the final judgments, although the judge on the merits is not bound by the interim decision.

2. Evidence

The author also fully agrees with others that the regulations on the gathering of evidence and the protection thereof clearly have an impact on the final judgment on the merits.

There could, for example, be consequences if the factual and expert evidence is gathered before the trial or during the trial. The same can be said if the proceedings are held in writing or heard verbally, or if the time by which evidence can be gathered or submitted varies¹⁶⁵⁰.

¹⁶⁴³ Cf. *Kessedjian*, N 2 and the description of the different measures; *Stauder, Verletzungsverfahren*, 153-157; *ILA, PPM principles*, N 4.

¹⁶⁴⁴ Cf. Proposal for a Directive of the European Parliament and of the Council of 30.1.2003 on measures and procedures to ensure the enforcement of intellectual property rights, COM(2003) 46 final, 14.

¹⁶⁴⁵ Cf. §3 B.IV. Provisional and protective measures.

¹⁶⁴⁶ Cf. *Ryberg*, 911.

¹⁶⁴⁷ Cf. *Kessedjian*, N 2.

¹⁶⁴⁸ Cf. *Ryberg*, 911-912.

¹⁶⁴⁹ Cf. *ILA, PPM principles*, N 4; N 26.

¹⁶⁵⁰ Cf. *Huniar*, 93; *Willems, Harmonisation*, 198.

However, the differences in fact-finding within accusatorial or inquisitorial principles are also significant¹⁶⁵¹. Whereas the first is in the hands of the parties, the second is the duty of the court. For example, the new EPC contracting states from Central and Eastern Europe quite vividly acted out an inquisitorial approach in proceedings¹⁶⁵². It goes without saying that a mix of the two systems - which is quite common in several European states - could lead to the result changing again.

The law is applied on the basis of fact-finding. Different rules in the fact-finding process may lead to different results and consequently to a different application of the law, again leading to different judgments. It therefore also seems clear that basic principles of the proceedings influence the outcome.

The Enforcement Directive did unify these principles to a certain extent¹⁶⁵³ and will possibly have a positive effect in relation to uniform results. Nevertheless, an additional harmonisation will be a necessity.

IV. Conclusion with regard to a unification of the interpretation of European patent law by way of a harmonisation of procedural law

Procedural law does have an impact on the implementation of substantive law¹⁶⁵⁴. As experience before different national courts shows, many of the diverging results in the judgments are not based on a different interpretation of law but rather on the differences in the fact-finding process.

A full unification of provisional and protective measures and the rules on gathering evidence and possible further points in a procedure would consequently have a positive effect with regard to a unified interpretation of patent law.

¹⁶⁵¹ Cf. *Willems, Harmonisation*, 199.

¹⁶⁵² Cf. *Sadlonova*, 125-126.

¹⁶⁵³ The Enforcement Directive tried to unify the rules on gathering evidence - Article 6 - and protecting evidence - Article 7. Article 6 deals with the obligation to produce evidence which lies in the control of the opposing party, and is heavily based on Article 43 TRIPs Agreement. Article 7 contains rules on the search for and protection of evidence and does not provide for mandatory substantial new elements that go beyond Article 50 TRIPs Agreement.

¹⁶⁵⁴ Cf. *Brinkhof, Kort geding*, 499; *Delicostopoulos*, 600.

It must, however, be reiterated that a positive effect can only be achieved if the uniform - or harmonised - rules are properly fitted into the existing national system, thus ensuring the necessary legal certainty and predictability.

It is inherent in a procedure with several instances that one step follows the other. Consequently, there is the risk that, if only one element is changed, the final result will also change. Thus, if the proceedings of the first instance vary too greatly from the appeal instance, there is an immediate danger that the appeal instance will have to repeat the fact-finding process in its entirety - if it has the authority to do so - so as to be in a position properly to decide the case.

To avoid this situation with regard to the establishment of a European Patent Court, the Intergovernmental conference of the EPC contracting states of Paris mandated the WPL to create an agreement that would commit its signatory states to an integrated judicial system with regard to litigation, *including uniform rules of procedure*¹⁶⁵⁵.

Each part of the procedure is a piece of the mosaic on the way towards the final judgment of the court. One could therefore easily argue that the procedure in its entirety must be unified and used in a common organisational framework¹⁶⁵⁶ in order *always* to arrive at a uniform result.

The request for such a framework in order to avoid diverging results does not, however, seem too convincing as, in every court system, diverging judgments are rendered¹⁶⁵⁷ even though unified procedural rules apply.

A court is composed of individuals who approach the subject matter differently and who interpret the law in various ways and with differences in their attitude¹⁶⁵⁸. The different organisation of the jurisdictions therefore seems only to have a limited impact on

¹⁶⁵⁵ Cf. 1999 O.J. EPO, 548.

¹⁶⁵⁶ One could argue that despite the unitary proceedings the result in a patent case will be different according to whether the panel of judges is composed of legally and technically qualified judges or only of legally qualified judges.

¹⁶⁵⁷ Cf. Pagenberg, *First Instance*, 490-491.

¹⁶⁵⁸ Cf. also Kur, *Enforcement Directive*, 825-826; Ullrich, *Harmony*, 44.

interpretation. It would instead be necessary also to provide for a harmonisation of legal methods, education and traditions¹⁶⁵⁹. Even then the results will vary, however.

It can be concluded that a uniform interpretation cannot be achieved by simply unifying the proceedings. Here a common authority would also be necessary to ensure a unified interpretation¹⁶⁶⁰.

It seems clear, however, that the more the steps in the proceedings are unified, the greater the chances that the judges will arrive at the same results by interpreting the law in a unified way. This would also make it necessary for the unified rules to take account of the special elements of the patent proceedings¹⁶⁶¹ in order to construe European patent law in a uniform manner as far as possible.

It is no surprise that in the past there were in fact several proposals to harmonise, at the European and Community levels, not only certain formal parts but also substantive parts concerning the infringement of patents¹⁶⁶². Bearing in mind the huge problems with regard to the implementation of the Biotech Directive¹⁶⁶³, the failed adoption of the Directive on the patentability of computer-implemented inventions¹⁶⁶⁴ and great problems regarding the making of a Community Patent Regulation¹⁶⁶⁵, it would be a great surprise, however, if the EU member states were ready to take that step at the moment.

In any case, the greater the substantive harmonisation at the Community level, the greater the necessity to harmonise procedural law at the Community level as well¹⁶⁶⁶.

¹⁶⁵⁹ Cf. *Gilles*, 23-26.

¹⁶⁶⁰ Cf. *Prütting*, 178; *Tilmann, Zukunft*, 1082; *Meier*, 319.

¹⁶⁶¹ Cf. *Messerli*, 142; *Cornish/Drexl/Hilty/Kur*, 448; *Ryberg*, 908.

¹⁶⁶² Cf. *König*, 3. *Weg*; *Bossung, Return*; *Schäfers, Anmerkungen*, 828; *Tilmann/v. Falck*, 585; but also *Brändle, Future shape*, 162-164.

¹⁶⁶³ Cf. Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions, 1998 O.J. EC, L 213, 30 July 1998, 13; Actions against four member states before the ECJ for still not having implemented the biotech patents Directive, IPR-Helpdesk: IPR Bulletin No. 12, Dec. 2003-Jan. 2004.

¹⁶⁶⁴ Cf. Proposal for a Directive of the European Parliament and of the Council of 20.2.2002 on the patentability of computer-implemented inventions, COM(2002) 92 final.

¹⁶⁶⁵ Cf. CP Regulation proposal.

¹⁶⁶⁶ Cf. also *Schade, Regelung*, 106.

V. Harmonisation of substantive patent law

The approach aimed at a more consistently interpreted law through further harmonisation of substantive patent law was mainly initiated by German experts¹⁶⁶⁷.

The proposals included the major issues of patentability¹⁶⁶⁸, the extent of protection of a patent and the nullity thereof¹⁶⁶⁹ - going beyond the rules of the EPC - but also the sanctions and damages¹⁶⁷⁰ going beyond the general regulations as provided for in Article 45 TRIPs Agreement¹⁶⁷¹. Litigation would become more predictable and could be more easily avoided if it was not really necessary¹⁶⁷².

The instruments in the proposals on ways in which harmonisation in the field of substantive patent law could be achieved vary quite extensively:

- new international agreements among the EU member states or EPC contracting states,
- creation of a Community Patent Directive¹⁶⁷³,
- conversion of the EPC into an EC Regulation including certain¹⁶⁷⁴ or all parts of the CPC 1989¹⁶⁷⁵, and
- incorporating substantive patent law into Community law and then "implanting" it into the EPC¹⁶⁷⁶.

¹⁶⁶⁷ Cf. König, 3. Weg; Bossung, Return; Schäfers, Anmerkungen, 828; Tilmann/v. Falck, 585; Stauder, Weg, 478; Tilmann, Invalidity harmonisation; but also Brändle, Future shape, 162-164.

¹⁶⁶⁸ Cf. Bossung, Return, 295.

¹⁶⁶⁹ Cf. König, 3. Weg, 343; Tilmann, Invalidity harmonisation.

¹⁶⁷⁰ Cf. Bruchhausen, Ausgleichsansprüche, 708; 715-716; Schade, Protocol, 174; Stauder, Significance, 794.

¹⁶⁷¹ As mentioned earlier, sanctions and damages have in the meantime been further harmonised to a certain extent with the Enforcement Directive.

¹⁶⁷² Cf. also Véron Pierre in: Michalland, 19.

¹⁶⁷³ Cf. König, 3. Weg, 342-344; Schäfers, Anmerkungen, 828; Tilmann/v. Falck, 585; Tilmann, Harmonisierung, 11; Tilmann, Zukunft, 1083-1083; Tilmann, Invalidity harmonisation, 72.

¹⁶⁷⁴ Cf. Bossung, Return, 302-304; 311; 314; Armitage, Policy, 556.

¹⁶⁷⁵ Cf. Straus, Present State, VI. Suggestions (i).

¹⁶⁷⁶ Cf. Bossung, Unionpatent, 3-4.

The level of harmonisation would certainly depend on the chosen Community instrument, but it seems clear that uniform law would have to fit into the existing European patent system in order to bring the expected effects.

If an EC Directive is adopted that only regulates general standards, leaving a certain authority and flexibility to the EU member states¹⁶⁷⁷, the level of harmonisation will be different from a directly applicable regulation with detailed provisions. The implementation of the Biotech Directive¹⁶⁷⁸ into national law, for example, shows that the EU member states tend towards their own interpretation in highly political fields of law when implementing the respective rules into national law¹⁶⁷⁹ if the harmonisation measure is not sufficiently detailed and if unification is limited to a minimum¹⁶⁸⁰.

At the start of the millennium the European Commission obviously had the plan to propose an EC Directive on patent law to harmonise the remaining differences in national laws governing the scope of protection conferred by national patents and differences in validity and revocation¹⁶⁸¹. A similar proposal was also made by MEP Klaus-Heiner Lehne¹⁶⁸². The European Commission made this approach part of the questionnaire on the patent system in Europe of January 2006¹⁶⁸³.

It suggested that the following could possibly be considered:

- a transfer of the main patentability criteria of the EPC, such as novelty, inventive step and industrial applicability, into Community law so that national courts could refer questions of interpretation to the ECJ,
- a more limited harmonisation picking up issues which are not specifically covered by the EPC, and

¹⁶⁷⁷ Cf. *Remien, Illusion*, 281.

¹⁶⁷⁸ Cf. Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions, 1998 O.J. EC, L 213, 30 July 1998, 13.

¹⁶⁷⁹ Cf. for example: Feldges Joachim, *Ende des absoluten Stoffschutzes? Zur Umsetzung der Biotechnologie-Richtlinie*, 2005 GRUR, 977-984.

¹⁶⁸⁰ Cf. *Ullrich, Harmony*, 27-28.

¹⁶⁸¹ Cf. *Jones/Toutoungi*, 247.

¹⁶⁸² Cf. *Lehne*, 364.

¹⁶⁸³ Cf. §7 A.III. The third phase.

- the mutual recognition by patent offices of patents granted by another EU member state, possibly linked to an agreed quality standards framework, or to a "validation" by the EPO, and provided the patent document is available in the original language and another language commonly used in business¹⁶⁸⁴.

The survey showed hardly any support for further harmonisation or mutual recognition of such a kind¹⁶⁸⁵, as it was felt by many that the patentability criteria are already sufficiently unified by the EPC¹⁶⁸⁶.

Additionally, there were some that were afraid of opening a Pandora's box if discussions on further harmonisation of substantive patent law were initiated¹⁶⁸⁷.

Nevertheless, the advantage of a Community solution with regard to a common interpretation seems clear: there is the ECJ, which should protect it¹⁶⁸⁸.

The unification effect of the ECJ's jurisprudence would, however, be limited to the issues that would be transferred to the Community level and to the particular question involved¹⁶⁸⁹, leaving room for different interpretations at the national level with regard to all other questions concerning a certain provision.

This would at least be the case until the court had been contacted in a sufficient number of cases concerning the same provisions, and until abstract principles applicable in all cases had been formulated¹⁶⁹⁰. *Forum shopping* would again be practised if legal practice varied.

In addition, the harmonising effect of ECJ rulings would depend on the goodwill of the national courts in referring questions of law to the ECJ for preliminary rulings¹⁶⁹¹ which

¹⁶⁸⁴ See Questionnaire of the European Commission on the patent system in Europe, Brussels, 09/01/06, 6.

¹⁶⁸⁵ Future Patent Policy in Europe, Public Hearing - 12 July 2006, Report, 3.

¹⁶⁸⁶ Future Patent Policy in Europe, Public Hearing - 12 July 2006, Preliminary findings: issues for debate, 15.

¹⁶⁸⁷ Cf. *Ermer*, 147-148.

¹⁶⁸⁸ Cf. *König*, 3. *Weg*, 343.

¹⁶⁸⁹ Cf. *Ermer*, 147.

¹⁶⁹⁰ Cf. *Snell*, 190.

¹⁶⁹¹ Also cf. the similar approach with regard to the CPC 1975 where it was suggested that the ECJ had jurisdiction to give preliminary rulings concerning decisions rendered by the EPO (Art. 73 CPC 1975; cf. §1 D.I. Aims and development).

often take several years to be answered by the ECJ¹⁶⁹². Furthermore, EPC contracting states which are not member states of the EU would not be bound by the rulings of the ECJ. If these states could not be involved in the system, e.g. by bilateral association agreements, it could not be ensured that the interpretation of European patent law would be entirely unified.

These disadvantages could likewise not be diminished by simply implementing the new Community rules into the EPC without creating a common court having the power to decide on facts and law and having supremacy over the EPO Boards of Appeal¹⁶⁹³ and the national courts.

It seems clear that the EPO Boards of Appeal - as a body of the European Patent Office and as part of an independent international organisation which includes EU member states and non-EU member states - could not be forced to refer questions of law to the ECJ or be bound by ECJ jurisprudence. However, the EPO Boards of Appeal would have to take into account the decisions of the ECJ when interpreting Community law which was implemented into the EPC.

The best solution seems to be simply to create a common pan-European patent court by way of an international agreement including some points that further harmonise substantive patent law or by implementing such law into the EPC. The grounds for patentability, the extent of protection and the grounds for nullity are sufficiently clearly formulated in the EPC to make it possible for a European patent court to establish a unified jurisprudence¹⁶⁹⁴. Further harmonisation in that regard with new rules to be implemented into the EPC or the Implementing Regulations would not be necessary.

It is evident that a further harmonisation of substantive patent law, such as in regard to rules on limitations to the effects of the European patent, questions on the burden of proof and prior use¹⁶⁹⁵, would only help to solve the current problems if, at the same time, a European patent court were established which could ensure a uniform interpretation.

¹⁶⁹² Cf. also *Schneider*, 203-204.

¹⁶⁹³ Consideration could also be given to integrating the EPO Boards of Appeal into the court system.

¹⁶⁹⁴ Cf. also Future Patent Policy in Europe, Public Hearing - 12 July 2006, Preliminary findings: issues for debate, 15.

¹⁶⁹⁵ Cf. also *Bosung, Unionpatent*, 4.

A simple protocol on the harmonisation of substantive European patent law added to the EPC or any other such instrument or the adoption of interpretative rules without establishing a common court is, at the same time, also undesirable¹⁶⁹⁶, as they would not solve the current problems.

To revise the Strasbourg Convention as was also proposed¹⁶⁹⁷ seems unrealistic, not least since the European Council is no longer the political body dealing with patent law¹⁶⁹⁸.

E. Cross-border injunctions

As mentioned above, cross-border injunctions were introduced *inter alia* by the Dutch courts to avoid multiple litigation and controversial decisions regarding the infringement of a European patent in different states. Other courts remained rather reluctant, however¹⁶⁹⁹, and the ECJ in *GAT v Luk*¹⁷⁰⁰ and *Roche et al. v Primus*¹⁷⁰¹ turned cross-border jurisdiction by national courts in relation to patents into theory to a great extent.

The question arises, nevertheless, as to whether a uniform interpretation of European patent law could be achieved if a liberal approach were and could be followed.

A cross-border injunction in Europe has the consequence that a judgment rendered by a court - possibly applying its own law - has a direct impact on another state's territory. Such a judgment should therefore be taken into better consideration by a court in future cases, other than a judgment that has no direct consequences on the territory where the court is located. A more profound analysis of the arguments put forward by a foreign court could clearly move in the direction of harmonisation as a form of judicial cooperation.

Again, however, it would depend on each judge and on whether or not he or she is ready for such an analysis. When taking the judgment into consideration, it may easily be argued

¹⁶⁹⁶ Cf. also *Landfermann, Litigation*, 230.

¹⁶⁹⁷ Cf. *Schäfers, Anmerkungen*, 828.

¹⁶⁹⁸ Cf. *Bossung, Unionpatent*, 6-7.

¹⁶⁹⁹ Cf. §3 C.VI.1 Cross-border injunctions.

¹⁷⁰⁰ *Gesellschaft für Antriebstechnik v LuK Lamellen und Kupplungsbau Beteiligungs GmbH & Co. KG*, ECJ July 13, 2006 (case C-4/03).

¹⁷⁰¹ *Roche Nederland BV v Primus et al.*, ECJ July 13, 2006 (case C-539/03).

that this judgment was rendered by a foreign court that did not take the home court's legal tradition or even jurisprudence into sufficient consideration. The more the crucial points of patentability and the extent of protection are at stake, the greater the chance that the court will adhere to its view, as mentioned before.

Furthermore, more than half of all current cases relating to European patents are decided by German courts¹⁷⁰². German views and traditions would therefore have a great influence on the interpretation of European patent law. This could be a problem for some courts or states if there is no common court of appeal where all states are represented.

Additionally, the common absence of a second-instance court could make the national courts suspicious of whether the other national court would really take its earlier judgments on the same subject matter into consideration and render well-balanced, European-spirited judgments. An assessor system, as mentioned above¹⁷⁰³, could therefore help to prevent possible prejudices among the courts and would also allow for foreign views to be directly introduced into the decision-making process.

Nevertheless, it seems very unlikely that extensively rendered cross-border injunctions would lead to full uniformity in the interpretation of European patent law¹⁷⁰⁴.

F. Compulsory arbitration

As concluded above, arbitration contributes to the minimisation of multiple litigation and to a uniform interpretation of European patent law only to a very limited extent¹⁷⁰⁵, if at all. However, if arbitration is made compulsory, it could contribute to a limitation of multiple litigation.

The proposal by *Kingston* was to introduce compulsory expert arbitration as a stage in dispute resolution, before any involvement with the courts¹⁷⁰⁶.

¹⁷⁰² Cf. §2 C.I. Courts of first instance.

¹⁷⁰³ Cf. §6 A.I.3. Exchanges between national judges, as well as between national judges and members of the EPO Boards of Appeal.

¹⁷⁰⁴ Cf. *de Wit*, 232.

¹⁷⁰⁵ Cf. §5 E.Conclusion.

¹⁷⁰⁶ Cf. *Kingston*, 156.

The reasons for the proposal to make arbitration compulsory¹⁷⁰⁷ were in fact the enormous patent litigation costs, and the lengthy proceedings in certain states. The main goal behind this idea is to strengthen the position of SMEs, which are very often in a weaker position when it comes to litigation as they are not able to pay the costs that a big company can.

It seems questionable, however, that arbitration could lead to a better environment for litigation, not least since experience shows that arbitration is often neither faster nor cheaper than the courts. Additionally, the arbitral award could hardly be excluded from being subject to appeal before ordinary jurisdiction.

It is therefore not really a surprise that the proposal to introduce compulsory arbitration into the UK Patents Bill 2004 was rejected by Parliament¹⁷⁰⁸.

Nevertheless, the proposal itself will encourage work towards an (inter)governmental system that is more balanced, guaranteeing high-quality decisions, and that ensures access to justice independently of the financial strength of the parties. A strict case management by the court, and giving the parties the possibility to concentrate on the important points to be decided, proved to be one important issue in tackling the problem of high litigation costs.

The London Intergovernmental conference of the EPC contracting states in 2000 came to the same conclusion with regard to patent arbitration and suggested to the EPC contracting states that arbitration be made more widely available but be kept optional¹⁷⁰⁹.

G. Common court of appeal

It is generally felt that the creation of a common supreme authority would be a necessary solution for a uniform interpretation of European patent law¹⁷¹⁰.

¹⁷⁰⁷ Cf. *Kingston*, 155.

¹⁷⁰⁸ Cf. *Nurton*.

¹⁷⁰⁹ Cf. §5 B.I. Introduction.

¹⁷¹⁰ Cf. *Beier*, *MGK* 1, N 29; *Walter H.P.*, *Auslegung*, 869; *Armitage*, *Interpretation*, 817; *Brinkhof*, *Desirability*, 229; *Jacob*, *Decisions*, 16; *Grabinksi*, *Determination*, 870; *Schäfers*, *Anmerkungen*, 824.

The Intergovernmental conference of the EPC contracting states of Paris also mandated the WPL to elaborate an optional agreement including a common court of appeal¹⁷¹¹. Obviously the COPAC served as an example for that approach.

The majority of the states interested in acceding to an EPLA opted, however, for a European solution with two instances from the beginning. There are good reasons for that decision, which will be discussed at a later stage¹⁷¹².

However, there are just a few, put forward by this majority, which would actually call into question the uniformity of interpretation if only a common appeals court were to be created¹⁷¹³:

- First, only a common European court of first instance, composed of highly qualified and experienced patent judges from different countries with different developed legal cultures, will be able to achieve the desired goal that the European patent law is applied and interpreted in a truly consistent "European" way.

- Second, multiple litigation relating to the same rights in different jurisdictions leads to inconsistent interpretation of the same substantive law in different jurisdictions and hence different outcomes and a lack of predictability.

- Third, procedural law, e.g. on pan-European injunctions, is inconsistent and causes delays, costs and legal uncertainty.

- Fourth, a simple appeal court without a common first instance would allow the current problems to persist, since much litigation only goes as far as the court of first instance and would therefore not reach the unifying level of the appeal court.

The minority of the WPL argued that it was sufficient to create a common appeal court to ensure uniformity of court decisions.

¹⁷¹¹ Cf. §7 A.I. The first phase.

¹⁷¹² f. §7 B. II.1.a)bb)aaa) Are there appropriate reasons for a "full" European solution?.

¹⁷¹³ Cf. *Structure paper*, 2000 EIPR, S-4 to S-5; 2000 IIC, 569-570; 2000 Bijblad bij de Industriële Eigendom, 265.

The argument put forward that national procedural law, as well as substantive patent law, could be harmonised without necessarily leading to different results in its interpretation, and that *forum shopping* is not necessarily bad since it gives the plaintiff the opportunity to choose the most experienced court¹⁷¹⁴, does not seem very convincing, as discussed above.

However, the arguments stated by the majority of the WPL that would make a court with two instances necessary with regard to the interpretation of law are likewise not entirely convincing.

It seems clear that a simple court of appeal with an international composition operating under extensively harmonised rules of procedure, together with specialised national courts, would also give rise to a real European jurisprudence¹⁷¹⁵ - including injunctions - even though many cases do not reach the second instance. It would just take longer¹⁷¹⁶.

However, it would not eliminate the existing differences in the national legal systems, their practices, or their experience¹⁷¹⁷.

Additionally, it should be mentioned that creating a common court of appeal capable of only checking questions of law - even if its jurisdiction were limited to nullity cases¹⁷¹⁸ - would ignore the fact that technical facts and law are very much interlinked, especially in patent litigation¹⁷¹⁹. The parties would then basically be limited to one tier, where both the law and the facts could be examined. This would hardly be acceptable to the users, most of all with regard to a court which renders decisions covering several states.

An important factor supporting two unified instances is that it seems easier for a state to relinquish its national civil procedural rules - even if only and not reasonably limited to patent disputes¹⁷²⁰ - for a full European solution. Politically, it just seems more difficult to

¹⁷¹⁴ Cf. also *Schade, Streitregelungssystem*, 832; 837; *Tilmann, Zukunft*, 1079.

¹⁷¹⁵ Cf. also *Brinkhof, Schlichtung*, 604; *Schade, Protocol*, 174.

¹⁷¹⁶ Cf. also *Burnside*, 288.

¹⁷¹⁷ Cf. *Boval, Remarques*, 165-166.

¹⁷¹⁸ Cf. *Schade, Regelung*, 106; 108.

¹⁷¹⁹ Cf. *Brack*, 56; *Tilmann, Zukunft*, 1081.

¹⁷²⁰ Cf. *Schade, Streitregelungssystem*, 831.

accept common rules of procedure for a state's national courts, only to make it easier for a following European court of second instance to establish a uniform jurisprudence.

All this seems to rule out a solution with two national instances and a common European court in third instance deciding about questions of law as well, as was also suggested¹⁷²¹.

H. National courts acting as European courts

As mentioned above¹⁷²², there has been a motion of the European Parliament based on a proposal by MEP Klaus-Heiner Lehne to create an EC Directive based on Article 95 EC Treaty harmonising (approximating) the national patent law within the entire EU¹⁷²³.

In order to ensure that a granted patent would have an effect in the entire European Union, it was suggested that those patents be mutually recognised. National courts would retain all of their powers¹⁷²⁴.

This proposal also triggered the idea that national courts could in fact act as European courts¹⁷²⁵, which was also proposed during the negotiations for an EPLA by German experts¹⁷²⁶. This approach was, however, already unacceptable to industry and several states with regard to the CPC¹⁷²⁷.

It was consequently not surprisingly noted that "*...a system of mutual enforcement will be acceptable only if industry has faith in all of the European courts*"¹⁷²⁸.

This is currently not the case, and that is one of the reasons why users have been calling for a better patent litigation system in Europe for years. This approach therefore seems to be undesired, as long as the quality of patent litigation before the national courts is not at an equally high level all over Europe.

¹⁷²¹ Cf. *Schade, Regelung*, 106; 108.

¹⁷²² Cf. §6 D.V. Harmonisation of substantive patent law.

¹⁷²³ Cf. *Lehne*, 364.

¹⁷²⁴ Cf. *Lehne*, 364.

¹⁷²⁵ Cf. *McCulloch/Coulson*.

¹⁷²⁶ Cf. §7 B.II.1.bb)aaa)iv) Conclusion.

¹⁷²⁷ Cf. §1 E.II. Jurisdictional arrangements.

¹⁷²⁸ Cf. *McCulloch/Coulson*.

A possible way out could be to train judges of national courts in patent litigation in order to bring the courts to a more or less equal level. Judges could, for example, obtain some training outside their country and do some kind of internship in courts with a good deal of expertise in patent litigation.

However, bearing in mind the limited number of patent disputes in Europe, it is quite unlikely that the judges in all national courts could sustain their specific knowledge of patent litigation. In addition, it would only make sense if the number of national courts with jurisdiction in patent litigation were limited at the European level from an economic perspective. Consequently, it was also suggested that groups of countries could jointly appoint a national court in order to tackle the problem of quality¹⁷²⁹. This seems unrealistic, however.

I. Conclusion

It has become clear that a combination of specialisation in the first instance - possibly including cooperation rules - together with a unitary set of procedural rules (or at least harmonised fundamental points of procedure) and a common court of appeal could quite possibly achieve the same results with regard to a unified interpretation as could a common court with two instances. What could not be avoided, however, is multiple litigation regarding the same European patent at issue and the negative effects of *forum shopping*. However, this was not the only reason why the Working Party on Litigation of the European Patent Organisation opted for a fully integrated solution of a European patent court including two European instances.

¹⁷²⁹ Cf. Schade, *Protocol*, 182.

CHAPTER FOUR: PROPOSALS FOR A COMMON PATENT COURT IN EUROPE

§7 THE EUROPEAN PATENT COURT BASED ON THE PROPOSAL OF THE WORKING PARTY ON LITIGATION OF THE EUROPEAN PATENT ORGANISATION

A. History and development

At the invitation of the French government¹⁷³⁰, an Intergovernmental conference of the contracting states to the EPC was held in Paris on 24 and 25 June 1999.

Background for the initiative was the launching of the 1997 Green Paper of the European Commission on the Community patent and the patent system in Europe¹⁷³¹ which motivated France to tackle the existing deficits of the European patent system¹⁷³². Among other things¹⁷³³, the conference mandated a Working Party on Litigation (WPL)¹⁷³⁴, jointly chaired by Germany, Luxembourg and Switzerland, to

...

"- define the terms under which a common entity could be established and financed to which national jurisdictions can refer, with a view to obtaining advice, that party of any litigation relating to validity and infringement

*- present a draft text for an optional protocol to the EPC which, with regard to litigation concerning European patents, would commit its Signatory States to an integrated judicial system, including uniform rules of procedure and a common court of appeal"...*¹⁷³⁵

I. The first phase

The WPL held three meetings from autumn 1999, to late spring 2000.

At its first meeting in Lucerne on 14 and 15 September 1999, the WPL mandated the co-chair to draw up a structure paper which should address the basic concepts to be enshrined in an optional agreement, including the cornerstones of the court's organization

¹⁷³⁰ Cf. Casalunga, *Le contentieux futur*, 253.

¹⁷³¹ Cf. §8 A.I. The first phase.

¹⁷³² Cf. Grossenbacher, 140.

¹⁷³³ Cf. also §2 A.III. Demand for specialised patent courts; §5 B.I. Introduction.

¹⁷³⁴ The WPL is comprised of all EPC contracting states.

¹⁷³⁵ Cf. 1999 O.J. EPO, 548.

and the rules of proceedings for a European Patent Court of first and second instance, as well as the necessary provisions of substantive law. Already at that time it became clear that the majority of delegations would desire a European patent jurisdiction with two instances. The first instance should, however, have some kind of local presence¹⁷³⁶, as it was also strongly desired by the users.

On 8 December 1999 a first draft of this structure paper was discussed in Berne with a number of experienced judges specialised in patent litigation from some EPC contracting states in presence of representatives of the countries forming the co-chair¹⁷³⁷.

The revised draft including a proposal of a court of first and second instance was submitted to the WPL at its second meeting held in Berlin from 25 to 27 January 2000. The proposal was supported by a majority of states. A minority, however, argued that the first instance of the European Patent Court should remain at the national level¹⁷³⁸.

Against the background of these divergent views, the WPL asked the co-chair to make a proposal with two alternatives taking into account both positions. At the third meeting of the WPL - held in the capital of the third co-chair, Luxembourg, 14 to 16 June 2000 - the working party agreed to submit *inter alia* the following proposal to the second Intergovernmental conference of the EPC contracting states for adoption¹⁷³⁹:

"1. *The Intergovernmental Conference takes note of the document 'Principle elements of an optional protocol on the settlement of litigation concerning European patents' and 'Proposals regarding the 'common entity' to be studied by the Working Party on Litigation under the mandate issued by the Paris Intergovernmental Conference on June 24 and 25, 1999', together with the minutes of the Luxembourg meeting of the Working Party on Litigation...*

2. *The Intergovernmental Conference mandates the existing Working Party on Litigation to submit to the governments of the member states of the European Patent Organisation, no later than the end of 2001 and in treaty language, an optional agreement on the settlement of litigation concerning European patents,*

¹⁷³⁶ Cf. *Structure paper*, 2000 IIC, 566; WPL/6/99, N 7.

¹⁷³⁷ Cf. *Structure paper*, 2000 Bijblad bij de Industriële Eigendom, 263; 2000 EIPR, S-3; cf. also Cf. *Boval, Remarques*, 160.

¹⁷³⁸ Cf. *Structure paper*, 2000 IIC, 566.

¹⁷³⁹ Cf. *Structure paper*, 2000 Bijblad bij de Industriële Eigendom, 264; 2000 EIPR, S-3.

including a separate part concerning a common entity¹⁷⁴⁰, it being understood that the member states of the European Patent Organisation shall be free to join only the part on the common entity. The work will be taken forward on the basis of documents in point 1 and shall take into consideration the relationship to a community patent..."

II. The second phase

The EPC contracting states met for their second Intergovernmental conference at the invitation of the United Kingdom government in London on 16 and 17 October 2000.

The conference accepted the proposals and also supported the request of the WPL to create a sub-group existing of the states interested in possibly joining a future patent litigation protocol which would produce a draft agreement and submit it to the WPL for consideration¹⁷⁴¹. The sub-group would also have the authority to seek expert assistance¹⁷⁴².

The sub-group¹⁷⁴³, chaired by the Netherlands, appointed *Willems*, Judge and Member of the EPO Boards of Appeal, as its expert to draft the agreement proposals. *Schade*, Judge at the *Bundespatentgericht*¹⁷⁴⁴ - now president of the German Patent and Trademark Office -, as well as *Pagenberg*, Attorney at Law in Munich, were mandated by the sub-group to investigate the option of a national first instance and a European second instance.

The main challenge of the group was to bring together the two fundamental positions of creating one or two instances at the European level. It was particularly difficult to find a

¹⁷⁴⁰ For the history, background and current situation, as well as an analysis of the "common entity", cf. §6°C.III. The Facultative Advisory Council.

¹⁷⁴¹ The mandate given to the WPL and the conclusions of the Intergovernmental Conference of London were never published.

¹⁷⁴² Cf. *Structure paper*, 2000 *Bijblad bij de Industriële Eigendom*, 264; 2000 *EIPR*, S-3.

¹⁷⁴³ Initial members of the sub-group were Denmark, Germany, Finland, France, Italy, Luxembourg, Monaco, the Netherlands, Sweden, Switzerland and the United Kingdom. The 8th meeting of the sub-group the Czech Republic, Hungary, Romania and Turkey joined the group. The European Commission, *epi* and UNICE have been observers in the meetings.

¹⁷⁴⁴ Federal Patent Court.

European solution which would make use of the existing jurisdictional experience¹⁷⁴⁵ and at the same time ensure local presence which was strongly requested by the SMEs¹⁷⁴⁶. At the third meeting of the sub-group held at The Hague from 4 to 6 April 2001, the two sides agreed that each state joining the protocol would be able to create up to three Regional Divisions on its territory which would act as European Patent Court of first instance¹⁷⁴⁷. The court panels, however, would be internationally composed in order to provide a uniform interpretation of law and claims throughout the participating states.

Over a period of ten months, the sub-group discussed three proposals¹⁷⁴⁸. Additionally, a meeting of experts in procedural law was held in Munich on 14 and 15 May 2001 to discuss related procedural issues¹⁷⁴⁹.

At the fifth meeting the sub-group decided to transfer the revised "Third Proposal for an EPLP" into treaty language. A team of the EPO¹⁷⁵⁰ under *Kolle*, Principle Director a.d., split the proposal into two parts and elaborated a draft Agreement on the Establishment of a European Patent Litigation System (draft European Patent Litigation Agreement¹⁷⁵¹; draft EPLA) and a draft Statute of the European Patent Court (draft Statute)¹⁷⁵².

In its drafts, the team followed guidelines to:

- First, retain in the draft EPLA only the most fundamental provisions, namely general, institutional and financial provisions, substantive law and jurisdiction, basic procedural provisions including the powers of the European Patent Court, provisional and protective measures, remedies, as well as transitional and final provisions.

¹⁷⁴⁵ Cf. *Schade, Regelung*, 104.

¹⁷⁴⁶ Cf. *Jones/Toutoungi*, 247 and also the *Structure paper*, 2000 Bijblad bij de Industriële Eigendom, 267; 2000 EIPR, S-8; 2000, IIC, 576.

¹⁷⁴⁷ Cf. WPL/SUB 10/01, N 15.

¹⁷⁴⁸ Cf. Willems, 1st to 3rd proposal. Cf. also Luginbuehl Stefan, Reports from the third to the fifth meeting of the sub-group to the Working Party on Litigation, 2001 sic! 352-353; 570-571 and 2002 sic! 207-208, German and French version, and <www.ige.ch/E/jurinfo/j1102.shtm> for the English versions.

¹⁷⁴⁹ Cf. WPL/SUB 15/01.

¹⁷⁵⁰ Part of the drafting team was *Joos, Schneider, Waage, Willems* and the author.

¹⁷⁵¹ The group took the view that the WPL is rather dealing with a future "agreement" and not with a "protocol" which is directly related to an existing agreement.

¹⁷⁵² WPL/SUB 2/02 available at <www.ige.ch/E/jurinfo/pdf/j1000.pdf>.

- Second, transfer to a draft Statute a number of important provisions regarding, *inter alia*, the judges, the Registrar and the European Patent Court.
- Third, put aside, for the time being, all the provisions to be included in Rules of Procedure of the European Patent Court, Services Regulations and Practice Directions¹⁷⁵³, as it was felt that a possible Diplomatic conference dealing with the proposals should not be overburdened with second level regulations.

The first two drafts in treaty language were discussed at the sixth meeting of the sub-group¹⁷⁵⁴ and submitted to the WPL at its fourth meeting on 2 and 3 December 2002. From that meeting on, the WPL and its sub-group have always met in Munich.

The WPL decided that the subgroup should meet again in the following summer in order to particularly discuss the financing of the European Patent Judiciary. It furthermore declared that it would decide at its fifth meeting whether it could convene a conference for the adoption and signature of the draft EPLA and draft Statute¹⁷⁵⁵. The sub-group met on 19 and 20 May 2003 and finalised the drafts in order to be submitted to a Diplomatic conference¹⁷⁵⁶. On 19 and 20 November 2003 the WPL agreed on the drafts and it considered them to be suitable for an Intergovernmental conference.

It was not, however, in the position to call for such a conference, and suspended its work¹⁷⁵⁷. The reasons became quite obvious in a declaration that was adopted by the WPL at that meeting:

"...3. The working party is conscious of the fact that the establishment of a litigation system for existing European patents is being paused, in view of the work being done by the European Union to introduce a Community patent with a judicial system of its own. The working party feels that its proposed judicial system for European patents also contains useful pointers towards practical solutions for the ongoing work on a

¹⁷⁵³ Cf. WPL/SUB 2/02, N 2.

¹⁷⁵⁴ Cf. Luginbühl Stefan, Sechste Konferenz der Untergruppe zur Arbeitsgruppe "Streitregelung", 2002 sic! 647, German and French version, and <www.ige.ch/E/jurinfo/j1102.shtm#3> for the English version.

¹⁷⁵⁵ Cf. Luginbühl Stefan, Vierte Konferenz der Arbeitsgruppe "Streitregelung", 2003 sic! 174-175, German and French version, and <www.ige.ch/E/jurinfo/j1102.shtm#3> for the English version.

¹⁷⁵⁶ Cf. Luginbühl Stefan, Siebte Konferenz der Untergruppe zur Arbeitsgruppe "Streitregelung", 2003 sic! 647 German and French version, and <www.ige.ch/E/jurinfo/j1102.shtm#3> for the English version; *Pagenberg, Patent*.

¹⁷⁵⁷ Cf. Luginbühl Stefan, Fünfte Konferenz der Arbeitsgruppe "Streitregelung", 2004 sic! 158-159, German and French version, and <www.ige.ch/E/jurinfo/j1102.shtm#3> for the English version.

Community patent court system. It will meet again on Wednesday, 8 December 2004. The time until the next meeting of the working party should be used for consultations with a view to resolving potential conflicts between the law of the European Union and the contemplated European Patent litigation system."¹⁷⁵⁸

III. The third phase

The Working Party on Litigation met again as scheduled a little bit more than a year later.

No progress could be noted by the co-chair of the WPL due to the potential conflicts between the works executed in the WPL and in the EU with regard to the creation of a Community patent (jurisdiction). With reference to the recommendation made by the High Level Group on the Lisbon strategy chaired by *Kok*¹⁷⁵⁹ that the Competitiveness Council should decide¹⁷⁶⁰ in Spring 2005 on whether the Community patent should go ahead or not, it was suggested that the WPL should meet again in Summer 2005¹⁷⁶¹.

The council, however, did not take any decision concerning the Community patent. The WPL therefore decided at its seventh meeting on 8 June 2005 that the sub-group should meet in autumn in order to implement the Enforcement Directive into the draft EPLA, and deal with minor remaining drafting issues. The sub-group completed its work on 22 and 23 September 2005 under its new Danish chair.

In October 2005, senior patent judges from several European countries, including France, Germany, the Netherlands and the United Kingdom met in Venice and passed a resolution¹⁷⁶² in which they supported a Diplomatic conference with a view to implementing the proposals for an EPLA along the lines of the WPL as soon as could be practical.

At the eighth meeting of the WPL in December 2005, the United Kingdom on behalf of the EU member states declared it was its intention to reach a position wherein a text for an

¹⁷⁵⁸ The declaration is available at <www.epo.org/patents/law/legislative-initiatives/epla.html> and 2004 sic! 159-160.

¹⁷⁵⁹ Cf. it was recommended by the group that "*the time has come for the Council to adopt the Community patent or drop it*", cf. Facing the challenge, The Lisbon strategy for growth and employment, Report from the High Level Group, chaired by Wim Kok, November 2004, 23.

¹⁷⁶⁰ Cf. Pagenberg Jochen, Industry, Legal Profession and Patent Judges Press for Adoption of the European Patent Litigation Agreement (EPLA), 2006 IIC, 46-49.

¹⁷⁶¹ Cf. WPL/7/04, N 12 to N 19.

¹⁷⁶² The resolution is available at <www.eplaw.org/Downloads/Venice%20Resolution.pdf>, or in 2006 GRUR INT., 37.

EPLA and a statute could be put to a Diplomatic conference as soon as could be possible. This declaration was made against a background of the European Commission's announcement that it intended to engage in a dialogue on how to provide Europe with a sound IPR framework. In that dialogue, it would also consider the improvement of the existing framework of the European Patent Organisation, especially the litigation arrangements.

The dialogue was launched by a consultation and an announced public hearing on the patent system in Europe¹⁷⁶³. The newly initiated consultation process started with the publication of a questionnaire¹⁷⁶⁴. The public hearing in context of the consultation process was held on 12 July 2006, where it was stressed by a majority of the stakeholders that the EPLA should be pursued¹⁷⁶⁵.

In the meantime, the European Commission declared that the EPLA was seen as a promising advancement towards a more unitary jurisdiction and that it would explore the possibilities of moving this project forward. However, it also made reference to some institutional hurdles that would have to be overcome if the Community was to become involved in the EPLA initiative¹⁷⁶⁶.

Also worth mentioning is that the Independent Expert Group on R&D and Innovation, appointed following the Hampton Court Summit, took the view that a globally competitive IPR regime requires, in the short term, the finalisation of the draft EPLA¹⁷⁶⁷. The mandate of the group was to provide the European Commission, ahead of the 2006 Spring European Council, with its advice and recommendations on ways to accelerate the implementation of new initiatives planned at EU or national level aimed at reinforcing EU research and innovation performance within the context of the revised Lisbon Strategy.

¹⁷⁶³ Cf. §8 A.III. The third phase.

¹⁷⁶⁴ The questionnaire is available at <ec.europa.eu/internal_market/indprop/docs/patent/consult_en.pdf>

¹⁷⁶⁵ Cf. Commission hearing back patent litigation deal, *Managing Intellectual Property News*, 1 July 2006, <www.managingip.com>; cf. also *Pagenberg, Another*, 806.

¹⁷⁶⁶ Cf. Closing remarks at public hearing on future patent policy, Speech/06/453 of Charlie McCreevy, Brussels, 12 July 2006.

¹⁷⁶⁷ Cf. *Creating an innovative Europe*, Report of the Independent Expert Group on R&D and Innovation appointed following the Hampton Court Summit chaired by Mr. Esko Aho, January 2006, 23.

This was all additional to issues and initiatives the group considered relevant. The Council did not, however, deal with the EPLA at its meetings on 23 and 24 March 2006¹⁷⁶⁸.

In October 2006 the European Parliament adopted a resolution on future patent policy in Europe wherein it urged the European Commission to explore all possible ways of improving the patent and patent litigation systems in the EU, including participation in further discussion on the EPLA¹⁷⁶⁹.

In December 2006 *Gowers* recommended in its famous IP policy review for the United Kingdom government to

*"support the establishment of a single EU court to adjudicate cross-border IP disputes by promoting the European Patent Litigation Agreement".*¹⁷⁷⁰

Germany also made it clear that it intended to move forward the negotiations on the EPLA under its EU Presidency in the first half of 2007¹⁷⁷¹.

Based on the results of the consultation, the European Commission published a Communication on the enhancement of the patent system in Europe in April, 2007¹⁷⁷². It was made clear that the improvement of the jurisdictional system for patents should be tackled at first, not least as work on a EU-wide patent jurisdiction scheme could help pave the way for progress on the creation of an affordable and legally secure Community patent.

Nonetheless, discussions with the EU member states prior to the release of the communication showed that opinions differed on the best way forward. The European Commission offered three options for discussion which is currently ongoing within the responsible bodies of the EU:

- Option one in general suggested the approval of the EPLA as it stands.

¹⁷⁶⁸ Cf. Council of the European Union, Brussels European Council, 23/24 March 2006, Presidency Conclusions of 24.3.2006, Doc. 7775/06.

¹⁷⁶⁹ Cf. P6_TA(2006)0416 of 12.10.06, C.1.

¹⁷⁷⁰ See *Gowers Review*, Recommendation 45.

¹⁷⁷¹ Cf. Weiterentwicklung des europäischen Patentsystems, Deutscher Bundestag, Wissenschaftlicher Dienst, 56/06, 23. November 2006.

¹⁷⁷² Communication from the Commission to the European Parliament and the Council of 3.4.2007 - Enhancing the patent system in Europe, COM(2007) 165 final.

- Option two proposed the creation of a community jurisdiction for European and Community patents, and

- option three offered an integrated approach which combined features of both the EPLA and a Community patent jurisdiction. The first option would therefore lead to the adoption of the EPLA structure as elaborated by the WPL.

B. Structural provisions in the draft European Patent Litigation Agreement and the draft Statute of the European Patent Court

I. The legal basis for the European Patent Litigation Agreement in the EPC

In fact it seems quite questionable as to whether the EPC contracting states would need a legal basis to conclude an international agreement, such as the EPLA. Whether or not they would interfere with other obligations of international and, in particular, Community law when adopting the EPLA is another question. Nevertheless, in order to create a clear legal basis for the EPLA - and the London Agreement¹⁷⁷³ -, and to establish an interface with the EPC, the Administrative Council of the European Patent Organisation agreed at its 79th meeting that the question as to how the two agreements should be anchored in the revised EPC should be forwarded to the Committee on Patent Law¹⁷⁷⁴.

The initiative lead to the realisation of Article 149a¹⁷⁷⁵ EPC. Paragraph 1 of Article 149a stipulates that nothing in the EPC will be construed as limiting the right of some or all the contracting states to conclude special agreements on any matters concerning European patent applications or European patents which are subject to and governed by national law under the EPC, particularly an agreement establishing a European patent court common to the contracting states that are party to it, and an agreement establishing a *common entity*¹⁷⁷⁶.

¹⁷⁷³ Cf. §1 E.III. The language provisions.

¹⁷⁷⁴ Cf. CA/PL 24/00, 1.

¹⁷⁷⁵ Cf. also *Cole*, 219, 221 and *Oser*, 524-525.

¹⁷⁷⁶ Cf. §6 C.III.1. History and background.

There will be consequently no legal hurdles in the EPC preventing the contracting states from concluding an agreement in relation to national law as referred to in Article 2 EPC¹⁷⁷⁷, therefore creating a common European patent court dealing with the infringement and validity of European patents.

II. Institutional provisions in the draft European Patent Litigation Agreement and the draft Statute of the European Patent Court

1. The European Patent Judiciary

The EPLA would establish a system of law, common to the contracting states, for the settlement of litigation concerning the infringement and validity of European patents¹⁷⁷⁸.

It would, furthermore, create a new international organisation¹⁷⁷⁹, independent from the European Patent Organisation, as it has already been suggested with regard to the COPAC¹⁷⁸⁰. This so-called "European Patent Judiciary (EPJ)" would have administrative, financial and certainly judicial autonomy¹⁷⁸¹.

Instead of creating a new international organisation it was alternatively suggested to integrate the EPJ into the European Patent Organisation as a third organ, next to the EPO and the Administrative Council¹⁷⁸². The EPJ would, thus, be realised with an ordinary EPC revision act instead of an optional agreement. Each EPC contracting state would have had the option to accede to the full version of the EPLA or to the part on the Facultative Advisory Council only.

The benefit of such an approach would be that a duplication of administrative work could be avoided to a certain extent. In addition, all EPC contracting states would be involved in the European patent litigation system.

¹⁷⁷⁷ Cf. Basic Proposal for the revision of the European Patent Convention, MR/2/00, 203, available at <patlaw-reform.european-patent-office.org/epc2000/documents/mr/_pdf/em00002a.pdf>.

¹⁷⁷⁸ Art. 2 draft EPLA.

¹⁷⁷⁹ Cf. also *Willems, Trojan Horse*, 328.

¹⁷⁸⁰ Cf. §1 D.III. Organisation.

¹⁷⁸¹ Art. 3(1) draft EPLA.

¹⁷⁸² Cf. *Landfermann, Litigation*, 230-232.

But this approach involves great risks, as not all EPC contracting states are interested in signing the EPLA. These states could consequently try to block the initiative of the other states or to water down the proposals and to impose to the others certain political driven requests which are of no - or hardly any - use for the users and the EPLA system.

Furthermore, it seems open whether the necessary independence of the court would be sufficiently guaranteed by such a construction¹⁷⁸³.

The approach for an optional agreement which is clearly separated from the European Patent Organisation seems, therefore, to be the more promising approach.

The EPJ would have legal personality¹⁷⁸⁴. Based on the model of the European Patent Organisation¹⁷⁸⁵, it would enable the EPJ to have an extensive legal capacity in the area of international law. It could consequently conclude agreements involving rights and duties. It would enjoy the most extensive legal capacity accorded to legal persons under the applicable national law of the EPLA contracting states. In particular, it could acquire or dispose of property, and could be a party to legal proceedings. It consequently would have all necessary legal capacities to participate in daily legal business, as far as is necessary to fulfil its rights and duties as provided in the EPLA, the court's statute and related acts thereof.

The EPJ would be represented by the President of the Court of Appeal¹⁷⁸⁶.

The seat of the EPJ is still open. The determination of the seat would certainly provoke stimulating political discussions.

The Protocol on Privileges and Immunities of the EPJ would define the conditions under which the employees of the EPJ would enjoy in each EPLA contracting state the privileges and immunities necessary for the performance of their duties¹⁷⁸⁷. A draft protocol has been

¹⁷⁸³ Cf. §7 B.II.2.b) Independence and impartiality of judges with a focus on the proposed possible double mandates.

¹⁷⁸⁴ Art. 6(1) draft EPLA.

¹⁷⁸⁵ Art. 5(1) EPC. Cf. also Kunz-Hallstein Hans Peter in: *Singer/Stauder*, 4. Auflage, Art. 5 N 3; Schäfers Alfons in: *Benkard, EPÜ*, Art. 5, N 2 to N 5.

¹⁷⁸⁶ Art. 6(3) draft EPLA.

¹⁷⁸⁷ Art. 8 draft EPLA.

drawn up on the basis of the Protocol on Privileges and Immunities of the COPAC and of the Protocol on Privileges and Immunities of the European Patent Organisation¹⁷⁸⁸. The Working Party on Litigation, however, agreed that the draft should be first considered by an expert group after a possible adoption of the EPLA by a Diplomatic conference¹⁷⁸⁹.

a) Organs of the European Patent Judiciary

The EPJ would comprise two organs¹⁷⁹⁰: The Administrative Committee and the European Patent Court.

aa) The Administrative Committee

The Administrative Committee is the connection point between the EPJ and the EPLA contracting states and would be the political, organisational and legislative organ.

The principle underlying the creation of this body is to ensure the necessary control¹⁷⁹¹. The clear division between the Administrative Committee and the court, however, underlines the necessary independence of the political and legislative body from the judicial body¹⁷⁹².

The initial proposal to form the committee with representatives of the members of the Administrative Council of the European Patent Organisation¹⁷⁹³ was regarded as interfering vis-à-vis the clear separation of the granting authority and the judicial authority. The Administrative Council and its organisation nevertheless served as model for the Administrative Committee. Therefore, the provisions describing the committee and its duties strongly resemble Articles 26 to 33 EPC.

Each EPLA contracting state would be able to send one representative and alternate representative to the committee¹⁷⁹⁴, and would have one vote¹⁷⁹⁵. States that would only

¹⁷⁸⁸ WPL/5/02.

¹⁷⁸⁹ Cf. WPL/8/02, N 2.

¹⁷⁹⁰ Art. 3(2) draft EPLA.

¹⁷⁹¹ Cf. *Willems*, 3rd proposal, 21.

¹⁷⁹² Cf. also *Matscher*, 370.

¹⁷⁹³ See *Willems*, 1st proposal, Art. I.3.5.3.1.

¹⁷⁹⁴ Art. 13 draft EPLA.

¹⁷⁹⁵ Art. 18(1) draft EPLA.

accede to the Facultative Advisory Council part of the EPLA¹⁷⁹⁶ would consequently also participate in the meetings. They would have, however, only a limited voting capacity¹⁷⁹⁷.

In contrast to the EPC¹⁷⁹⁸, the draft EPLA does not include a provision that the representatives of the committee could also be assisted by advisers and experts. Arguably, it would be worthwhile if the Administrative Committee could also request such assistance. The future procedural rules of the committee would thus have to include an enabling provision to this effect, as it doesn't seem necessary that such a rule dealing with the organisation of the meetings is, in fact, part of the treaty itself.

The committee would elect a chairman and a deputy chairman from among the representatives and alternative representatives. This deputy would replace the chairman if the latter was prevented from carrying out his duties¹⁷⁹⁹. Both would hold office for three years and could be re-elected.

The principle task of the chairman would be to convene and guide¹⁸⁰⁰ at least one committee meeting per year¹⁸⁰¹. The details will have to be defined in the rules of procedure of the committee. In contrast to the Administrative Council of the European Patent Organisation, the Administrative Committee would also meet at the request of at least three EPLA contracting states¹⁸⁰² or of the Executive Committee¹⁸⁰³.

It has furthermore been suggested that contracting states to the EPC not acceding to the EPLA, or other states which have the right to accede, and non-governmental organisations may all observe the meetings of the Administrative Committee¹⁸⁰⁴. They would, however, be excluded from voting¹⁸⁰⁵. By comparison to the EPC, the approach has in principle the intention to convince the states not ready to accede to the EPLA of its advantages. But it

¹⁷⁹⁶ Art. 83d(1) draft EPLA.

¹⁷⁹⁷ Art. 83f draft EPLA. The exact voting powers are, however, still in dispute.

¹⁷⁹⁸ See Art. 26(2) EPC.

¹⁷⁹⁹ Art. 14(1) draft EPLA.

¹⁸⁰⁰ Art. 15(1) draft EPLA.

¹⁸⁰¹ Art. 15(5) draft EPLA.

¹⁸⁰² Cf. Art. 29(3) EPC. The council, however, also meets at the request of one third on the EPC contracting states.

¹⁸⁰³ Art. 15(5) draft EPLA.

¹⁸⁰⁴ Art. 15(3) and (4) draft EPLA.

¹⁸⁰⁵ Art. 18(1) draft EPLA.

would also make it possible for a limited number of the different user circles, such as the epi, or EPLAW to participate in the meetings in order to provide their direct input.

The Administrative Committee would have the authority *inter alia* to amend the provisions of the Statute. This would make it possible for the Statute to be revised without a Diplomatic conference and, thus, provide the EPJ with great autonomy concerning the structural organisation of the European Patent Court and its judges and staff. It is, however, being proposed that a decision with regard to a change in the Statute could only be taken by unanimous decision¹⁸⁰⁶. This is a great hurdle which is mostly almost impossible to overcome.

The Administrative Committee could furthermore adopt or amend the European Patent Court's Rules of Procedure and its own Rules of Procedure, the Service Regulations of the court's staff, and the Financial Regulations. Additionally, it would supervise the European Patent Court¹⁸⁰⁷, certainly without the right to infringe the court's right of judicial independence¹⁸⁰⁸.

It would also set up or discontinue Regional Divisions¹⁸⁰⁹, appoint, re-appoint or remove¹⁸¹⁰ the judges and the Registrar¹⁸¹¹, and perform any other duties assigned to it by the EPLA or the Statute¹⁸¹².

Article 13 (3) draft Statute makes it clear, albeit indirectly, that the Administrative Committee could also provide in its Rules of Procedure for the establishment of committees, working parties or other subsidiary bodies with advisory functions. Such a body could be necessary with regard to the finances of the EPJ. Here, again, it is obvious that the Administrative Council of the European Patent Organisation has served as the example¹⁸¹³.

¹⁸⁰⁶ Art. 18(2) draft EPLA.

¹⁸⁰⁷ Art. 3(4) draft EPLA

¹⁸⁰⁸ Art. 5 draft EPLA.

¹⁸⁰⁹ Art. 10(2) draft EPLA.

¹⁸¹⁰ Art. 17(3) draft EPLA in conjunction with Arts. 8 and 12 draft Statute.

¹⁸¹¹ Art. 17(3) draft EPLA in conjunction with Arts. 4 and 11 draft Statute.

¹⁸¹² Art. 17(3) draft EPLA.

¹⁸¹³ Cf. Art. 14 Rules of Procedure of the Administrative Council.

bb) The European Patent Court

The European Patent Court comprises the Court of First Instance, the Court of Appeal, and the Registry¹⁸¹⁴.

As mentioned earlier, the decision to establish two European instances was strongly challenged in the WPL. Particularly Germany with its highly experienced courts specialised in patent litigation, strongly insisted on a solution with national courts in first instance and only one common appeal court¹⁸¹⁵.

However, as mentioned earlier, the majority of the states - as well as the users - interested in acceding to an EPLA, wished to go beyond the mandate of the Paris Intergovernmental conference¹⁸¹⁶ and opted for a European solution with two instances right from the start.

But are there, indeed, sufficient reasons to surpass the mandate?

aaa) Are there appropriate reasons for a "full" European solution?

i) Potential benefits for a European Patent Court of first and second instance: an analysis

The impact on the uniform interpretation of European patent law of a common court with two instances or of a common court of appeals only was already discussed and will not be repeated here¹⁸¹⁷.

The structure paper submitted to the London Intergovernmental conference listed the following benefits of a European court with two instances¹⁸¹⁸:

- First, only a common European court of first instance would ensure that European patents can be enforced and attacked in all EPLA contracting states in reliable, affordable and efficient proceedings resulting in quick, high-quality decisions. Against the notion of

¹⁸¹⁴ Art. 3(2)(a) draft EPLA.

¹⁸¹⁵ Cf. *Landfermann, Litigation*, 228; *Schade, Protocol*, 172; *Pagenberg, Roles*, 60-62; *Tilmann, Zukunft*, 1080-1083.

¹⁸¹⁶ Cf. §7 A. History and development.

¹⁸¹⁷ Cf. §6 G. Common court of appeal.

¹⁸¹⁸ Cf. *Structure paper*, 2000 *Bijblad bij de Industriële Eigendom*, 265; 2000 *EIPR*, S-4 to S-5; 2000, *IIC*, 569-570.

national courts acting in first instance is the problem of the lack of experienced patent judges in many EPC contracting states, and it would become more costly for the patent holder to defend his rights.

This argument can be supported. A sole European appeal court with national courts in first instance would not solve the problems mentioned for all states interested in joining the EPLA. And it would also not avoid all the repetitive and costly work that would be executed in multiple patent litigation¹⁸¹⁹.

Some EPC contracting states such as Germany¹⁸²⁰ or the Netherlands are not faced with problems related to inexperienced courts, slow proceedings and high litigation costs. For such states, a simple court of appeal would indeed be sufficient if the problem of multiple instances of litigation and the objective to quickly reach a unified jurisprudence were put aside. Why the Netherlands still opted for a full European solution from the start becomes obvious when looking at the reasons potentially supporting the adverse approach, namely national courts in first instance cases.

- Second, *forum shopping* is becoming a recurrent phenomenon, causes unnecessary extra costs, delays, general uncertainty, and is harmful to business'. A plurality of first instance national courts would almost inevitably perpetuate *forum shopping*. A single European patent court of first instance would put an end to these problems.

This viewpoint can also be supported, but only to a certain extent. It seems clear that *forum shopping* would be perpetuated if the national authorities would be kept in first instance¹⁸²¹. However, depending on the structure of the court, *forum shopping* could also continue inside a European Patent Court, as will be shown in short¹⁸²².

- Third, a plurality of first instance national courts working under different procedural rules would make it extremely difficult to achieve consistency and to ensure smooth interaction between first instance proceedings before a national court and the procedure before the

¹⁸¹⁹ Cf. *Laddie, I.P. Rights*, 407.

¹⁸²⁰ Cf. also *Tilmann, Zukunft*, 1080; *Sydow*, 693-694.

¹⁸²¹ Cf. §3 E.I. General.

¹⁸²² Cf. §7 D. Conclusion with regard to proposed structure of the European Patent Court and its influence on creating a uniform jurisprudence, solving the problems of *forum shopping*, and avoiding multiple litigation.

common appeal court which would have to apply its own rules of procedure. Even if the national courts followed the same set of procedural rules, they would retain an individual outlook derived from their own national legal traditions, which, again, would not promote consistency.

This argument can be supported in general. It is correct that it would be very difficult to put in place common procedural laws at the national level or even harmonise the most important parts of the proceedings¹⁸²³. However, if it was realised, consistency of the procedural rules could also be achieved with the common court of appeal¹⁸²⁴.

Another advantage of having a European court with two instances not mentioned in the structure paper would be that the spreading of legal cultures¹⁸²⁵ would already be realised in the first instance, and would help disseminate points of view in law matters much more quickly. This would imply, however, that structures should be build up in the European Patent Court safeguarding such a diffusion.

ii) Potential reasons that support a common second instance

The counter-arguments brought forward by the minority of the WPL are as follows¹⁸²⁶:

- First, a purely European court system for patent disputes conflicts with the basic structure of the EPC. The EPO grants European patents which in the designated contracting states have the same effect as national patents and can only be challenged before the national patent courts with binding effect in the designated states. A European court system giving decisions at first instance having effect in all contracting states would mean a clear departure from this basic structure.

There are several reasons why this statement is not convincing. On the one hand, it seems difficult to understand why common courts of first instance would conflict with the EPC whereas a simple unified court of appeal would not¹⁸²⁷.

¹⁸²³ Cf. Schäfers, *Anmerkungen*, 826; Laddie, *Discussion*, N 67-1.

¹⁸²⁴ Cf. Tilmann, *Zukunft*, 1082.

¹⁸²⁵ Cf. Willems, *Patent Court*, 164.

¹⁸²⁶ Cf. *Structure paper*, 2000 Bijblad bij de Industriële Eigendom, 265-266; 2000 EIPR, S-5 to S-6; 2000, IIC, 571-572.

On the other hand, neither Article 2(2) EPC which provides that a European patent, in each of the contracting states for which it is granted, has the same effects of and be subject to the same conditions as a national patent granted by that state nor any other provision in the EPC seem to prevent the EPC contracting states from providing a European patent court with the authority to decide a case involving a patent right having effect on its territory. This is now also made explicitly clear in the new Article 149a EPC¹⁸²⁸.

- Second, judicial functions should be exercised in a decentralised manner in the contracting states as much as possible, and at the European level a court should only be established for the purpose of ensuring uniformity of court decisions. A European patent court system must ensure a certain degree of proximity between the parties and the court. This is particularly important for SMEs, and is best ensured by giving first-instance jurisdiction to national courts. In many cases, patent disputes can already be decided with final and binding effect at first instance by the courts of the member states. The need for uniform decisions from a central European patent court would be adequately met if the latter had jurisdiction on appeals.

Indeed it is an advantage from the point of view of fast and easy access to justice if a court structure is organised in a decentralised manner¹⁸²⁹. That is why the majority of the WPL from the beginning supported the view that the European Patent Court should have some kind of local presence.

But as mentioned above with regard to the benefits of a full European solution, the problems of courts having no or hardly any patent litigation experience¹⁸³⁰, slow and costly proceedings, as well as the problems related to *forum shopping* and multiple litigation would not be solved with a simple common court of appeal¹⁸³¹.

¹⁸²⁷ Cf. also *Willems, First instance*, 398.

¹⁸²⁸ Cf. §7 B.1. The Legal basis for the European Patent Litigation Agreement in the EPC.

¹⁸²⁹ Cf. also *Sydow*, 693.

¹⁸³⁰ Cf. also CP Regulation proposal, 14.

¹⁸³¹ Cf. also *Boval, Remarques*, 165; 166; *Willems, First instance*, 396.

In addition as also seen above if national courts were acting in first instance it would be necessary that common rules of proceedings would have to be implemented¹⁸³². This would be difficult to achieve¹⁸³³ and it would be more difficult to amend and further develop rules of procedure rules which apply to various national courts than it would be if they only apply to a common European patent court¹⁸³⁴.

Furthermore, adequate structures would have to be put in place in order to guarantee a unified application of these rules at the national, as well as the European level.

- Third, a purely European patent court system would run the risk of being overwhelmed by the sheer number of patent disputes, which might lead to lengthy proceedings and perhaps low quality decisions. First instance jurisdiction of national courts would reduce the number of cases to be dealt with by a European appeal court. Initially, the parties would be able to bring cases before national courts issuing high-quality decisions in a timely and cost-efficient manner.

Again, high-quality decisions of national courts are issued in a timely and cost-efficient manner in some EPC contracting states but not in all of them.

However, there is the argument of patent judges lacking experience. This was, in fact, one of the major points of *critique*¹⁸³⁵ by the supporters of national courts in first instance against a centralised structure working in parallel with a Community Patent Court and national courts¹⁸³⁶.

A possible lack of qualified judges would, however, depend on whether the number of cases would increase with the creation of a common patent court and whether the active judges could only be appointed to one of the different courts.

¹⁸³² Cf. also *Stauder, Vom*, 55; *Brinkhof, Schlichtung*, 603-604; *Pagenberg, Roles*, 62; *Tilman, Zukunft*, 1082.

¹⁸³³ Judge Laddie stated that achieving harmonised rules of procedure before national courts would be "as unlikely as snow in the Sahara" (*Laddie, Discussion*, N 67-1).

¹⁸³⁴ Cf. *Willems, Patent Court*, 164.

¹⁸³⁵ Cf. also *Brinkhof, Schlichtung*, 602.

¹⁸³⁶ Cf. *Pagenberg, First Instance*, 486-488; *Schade, Protocol*, 178.

The creation of a European patent court will not necessarily lead to an increase of litigation cases: On the one hand, parallel litigation will cease to exist and consequently lead to a decrease of disputes. On the other hand, however, the European Patent Court will attract an increased number of litigators who would otherwise not go to court either due to the high costs of national proceedings¹⁸³⁷ or the lack of experience of national courts.

Should judges not be able to work in different jurisdictional bodies - as it is proposed in the draft Statute - ¹⁸³⁸, there would indeed be a certain risk that the new court would not be in a position to handle the number of incoming cases. This is particularly so since the decrease in workload at national level would only allow for a very limited number of judges who could work for the European Patent Court.

Therefore, the WPL sub-group wanted to clarify the issue and requested the EPO to study the potential number of patent cases¹⁸³⁷ that would be brought before a European patent court.

The EPO issued a questionnaire and requested the states of the sub-group for information on the number of patent disputes before their courts. Based on the results¹⁸³⁹, first estimations concerning the potential workload, the number of judges and the costs of the court could be made. However, even the most well founded assumptions can sometimes be wrong.

What seems clear is that the initial workload of the court would be rather limited¹⁸⁴⁰.

On the one hand, there is an extensive transitional period¹⁸⁴¹ of seven years proposed in the draft EPLA wherein the European Patent Court and the national authorities (having jurisdiction under national law) would share the jurisdiction with regard to proceedings for infringement and revocation of a European patent¹⁸⁴². This period should thus also be used to teach more judges about patent law.

¹⁸³⁷ Cf. *Willems, First instance*, 397.

¹⁸³⁸ Cf. §7 B.II.2.a) Requirements for office.

¹⁸³⁹ Cf. WPL/4/03.

¹⁸⁴⁰ Cf. *Brinkhof, Schlichtung*, 602.

¹⁸⁴¹ Cf. also *Willems, Patent Court*, 166.

¹⁸⁴² Cf. Art. 85 draft EPLA.

On the other hand, users will most likely first want to experience whether the new court is running well and whether the expectations can be fulfilled. The workload before the European Patent Court would thus rise slowly¹⁸⁴³. This would also help the judges of the European Patent Court to get accustomed to each other and their different legal and cultural backgrounds, as well as to get used to applying new rules of proceedings¹⁸⁴⁴.

- Fourth, first-instance national courts could also decide on cases involving further claims - e.g. under competition law - not covered by European patent law. This would avoid parallel litigation.

This argument can partly be supported: A jurisdiction limited to infringement and validity could indeed provoke multiple litigation since, in many cases, other legal fields of civil law are affected in any case involving a European patent.

Meanwhile, it has been decided by the WPL that the European Patent Court could deal with any action concerning a European patent if and to the extent the parties have so agreed¹⁸⁴⁵. It is, however, important to note that multiple litigation could certainly not be avoided if the current situation with regard to national courts in first instances was perpetuated.

- Fifth, establishing an appeal court at the European level would be less costly than creating a fully centralised system. Most patent disputes would already be decided with final and binding effect at first instance by the national courts.

Arguably, the establishment of a court with two instances might seem more expensive than a court with one instance. But costs could also be saved if an entirely new court system did not have to be established, although a decentralised system from an organisational point of view would be more expensive to run than a centralised one¹⁸⁴⁶.

¹⁸⁴³ Cf. *Willems, Patent Court*, 168.

¹⁸⁴⁴ Cf. *Brinkhof, Schlichtung*, 602.

¹⁸⁴⁵ Art. 41(1)(d) draft EPLA.

¹⁸⁴⁶ Cf. *Schade, Protocol*, 172.

In addition, a full European solution would also bring savings at the national level as the national courts would no longer have to deal with these cases. Often heavily subsidised court proceedings at the national level would thus decrease, thereby reducing state costs.

For those states which do not have specialised national courts, it also seems easier and less costly to participate in a common European scheme than to build up their own system and judicial expertise.

Furthermore, it should be noted that the costs of the European Patent Court for the EPLA contracting states will not least strongly depend on the final decision as to the extent to which the contracting states should contribute to the judiciary's costs. Currently, it is proposed that the EPJ should be basically financed by its own resources¹⁸⁴⁷, i.e. by court fees¹⁸⁴⁸. The court fees, however, have to be fixed at such level so as to ensure a balance between the parties' human right to fair access to the European Patent Court and the principle that the European Patent Judiciary's own resources should cover its costs¹⁸⁴⁹.

- Sixth, existing structures at the national level enable patent litigation to be handled competently at first instance. If litigation concerning European patents is left to the national courts at first instance, this would ensure that the courts and the legal representatives in the EPC contracting states retain their competence in patent litigation. This is necessary, since national courts will continue to have jurisdiction over patent litigation concerning purely national patents. To maintain and develop the relevant competence, individual contracting states will still be free to entrust decisions at first instance to a common court.

Using the existing well established structures is a very important factor in order to create the necessary trust of the users in a new system. Competence of the judges at national level could be safeguarded if they could be active in both court systems at the national and European level. The same can be said with regard to legal representation.

¹⁸⁴⁷ Art. 20 draft EPLA.

¹⁸⁴⁸ Art. 21 draft EPLA.

¹⁸⁴⁹ Art. 21(1) draft EPLA.

iii) *Are the principles of subsidiarity and proportionality against a centralised European patent court?*

An additional point that was brought up during the negotiations was that the principles of subsidiarity and proportionality of the EU would be overruled with the establishment of a centralised European court in first instance¹⁸⁵⁰.

The principle of subsidiarity was primarily introduced to regulate the competencies between the EU member states and the EC¹⁸⁵¹. The principle of subsidiarity was codified as a common principle of the Community in Article 3b of the Maastricht Treaty¹⁸⁵², formally known as the EU Treaty, and Article 5 EC Treaty. The latter provides that the Community acts within the limits of the powers conferred upon it by the EC Treaty and of the objectives assigned to it therein. In areas which do not fall within its exclusive competence, the Community has to take action, in accordance with the principle of subsidiarity, only if and in so far as the objectives of the proposed action cannot be sufficiently achieved by the member states and can therefore, by reason of the scale or effects of the proposed action, be better achieved by the Community¹⁸⁵³.

A basic requirement for a possible application of the principle of subsidiarity is, therefore, that the Community has the competence in the area at stake¹⁸⁵⁴. However, even if the Community powers cannot be clearly defined¹⁸⁵⁵ and are subject to interpretation¹⁸⁵⁶, the EC Treaty does not enable the Community to create a common court system dealing with the infringement and revocation of European patents¹⁸⁵⁷. There is consequently one pre-condition already not being fulfilled before one could ask whether the action to be taken at the Community level should be executed at the Community or the member state level.

¹⁸⁵⁰ Cf. *Schade, Protocol*, 172.

¹⁸⁵¹ Cf. Hirsch Günter, *Das Subsidiaritätsprinzip*, Festschrift für Walter Odersky zum 65. Geburtstag am 17. Juli 1996, Böttcher Reinhard (ed.), Berlin 1996, 197-213, 199-208.

¹⁸⁵² Cf. *Dubach*, 105.

¹⁸⁵³ Cf. also the new conditions as regards the application of the principle of subsidiarity in the Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon, 13.12.2007, Protocol on the application of the principles of subsidiarity and proportionality.

¹⁸⁵⁴ Cf. *Davies, Gareth*, 66.

¹⁸⁵⁵ Cf. *Davies, Gareth*, 66.

¹⁸⁵⁶ Cf. *Dubach*, 106.

¹⁸⁵⁷ Cf. *Oser*, 535.

The situation with regard to the application of the principle of proportionality is very similar, as it requires the existence of a common Community goal¹⁸⁵⁸. There was, however, no goal determined by the EU, namely the creation of a Community court system dealing with European patent litigation. There would consequently be no legal grounds which would bind the EU member states to the two principles in the negotiations for an EPLA.

However, it was also claimed in the WPL negotiations¹⁸⁵⁹ that the principles of subsidiarity and proportionality would be commonly accepted principles of European integration and would thus also be binding for non EU member states. This seems neither legally nor politically correct. Nevertheless, the principles could be helpful when deciding whether a full centralist approach or a decentralised approach would be more promising in reaching the formulated goals¹⁸⁶⁰. Finally, it should be noted that even if the WPL would have chosen a centralised structure for the European Patent Court the principles of subsidiarity and proportionality would have obviously been safeguarded as it was decided within the EU to create a fully centralised Community Patent Court¹⁸⁶¹.

iv) Conclusion

Both the supporters of a European court and those in favor of national courts in first instance have convincing arguments.

During the negotiations in the WPL sub-group it became clear that the principle goal of the states interested in having national courts in first instance was that the existing well-functioning structures and expertise could be safeguarded¹⁸⁶², and should not be sacrificed for a centralised European system with an unclear outcome¹⁸⁶³. Furthermore, German courts dealing with patent cases generate high income which is used to subsidise other parts of the jurisdiction¹⁸⁶⁴.

¹⁸⁵⁸ Cf. *Davies, Gareth*, 71.

¹⁸⁵⁹ Cf. *Schneider*, 260.

¹⁸⁶⁰ Cf. also *Schneider*, 261.

¹⁸⁶¹ Cf. §8 B.I.3. Developments.

¹⁸⁶² Cf. *Landfermann, Litigation*, 228; *Pagenberg, First Instance*, 492; *Dreiss*, 716.

¹⁸⁶³ Cf. *Willems, Patent Court*, 164; cf. also *Brinkhof, Schlichtung*, 602-603.

¹⁸⁶⁴ Cf. Eingabe zur Rechtsmittelreform in Zivilsachen der Deutschen Vereinigung für gewerblichen Rechtsschutz (GRUR), 2000 GRUR, 292.

The question as to whether the transfer of sovereign rights was compatible with national constitutional law¹⁸⁶⁵ seemed to be of a rather secondary nature, if a solution could have been found that would have satisfied these interests. In addition, users and particularly SME's wished to have litigation conducted within their more familiar courts, as opposed a remote European patent court¹⁸⁶⁶.

The states opting for a rather centralised approach on the other side wanted to create a common court which would avoid multiple litigation, issuing quality decisions in a timely manner, guaranteeing legal certainty in the entire area of the EPLA contracting states, and thus avoiding the negative effects of *forum shopping* at least in this area. A construction with the national courts in first instance would not satisfy these expectations.

On the one hand, concentration becomes more difficult if first-instance jurisdiction is given to the national courts¹⁸⁶⁷. On the other hand, even if the number of first instance courts at the national level could be reduced, as it was suggested in order to create better expertise at the national level¹⁸⁶⁸ - although the first such attempt within the framework of the CPC had already failed in that regard¹⁸⁶⁹ -, and even if the rules of procedure could be unified, the existing differences in the national legal systems, practice, experience, etc. and many other national deficiencies would remain¹⁸⁷⁰. *Forum shopping* would thus be perpetuated.

In addition, all the other reasons for the failure of the CPC with regard to the judicial arrangements¹⁸⁷¹, as well as the fact that the majority of users would not want a system with national courts in first instance¹⁸⁷², and the above analysis with regard to the arguments for and against the national courts in first instance support this view.

There were also concerns that if the national courts constituted the first instance, but appeals were heard by a European court, this would result in a split of the judicial system

¹⁸⁶⁵ Cf. *Schade, Protocol*, 172.

¹⁸⁶⁶ Cf. *Structure paper*, 2000 Bijblad bij de Industriële Eigendom, 267; 2000 EIPR, S-8; 2000, IIC, 576.

¹⁸⁶⁷ Cf. *Messerli*, 146.

¹⁸⁶⁸ Cf. *Schade, Streitregelungssystem*, 837-838; *Pagenberg, Roles*, 62; *Schade, Protocol*, 182; *Schäfers, Anmerkungen*, 826; *Sydow*, 694; *Brinkhof, Schlichtung*, 603.

¹⁸⁶⁹ Cf. §1 D.II. Jurisdiction.

¹⁸⁷⁰ Cf. *Boval, Remarques*, 165-166.

¹⁸⁷¹ Cf. §1 E.II. The jurisdictional arrangements; *Schade, Protocol*, 172.

¹⁸⁷² Cf. Comments of UNICE, WPL/3/00, 1; *Sedemund-Treiber, Strukturen*, 125; *Willems, First instance*, 395; *Boval, Remarques*, 166.

that would give rise to constitutional difficulties in some states¹⁸⁷³. The proposal to put the national courts under a European umbrella¹⁸⁷⁴ and to equip them with territorial jurisdiction for the entire EPLA territory, seemed therefore unacceptable to many delegations in the WPL, as well as to the users¹⁸⁷⁵.

It would also be incorrect to simply state that only a centralised structure would guarantee final decisions to be issued within two years or that only such a body would have the necessary qualification¹⁸⁷⁶ and ensure a better¹⁸⁷⁷ and unified jurisprudence¹⁸⁷⁸. All this could also be realised in a decentralised¹⁸⁷⁹ but truly European structure.

Additionally, even in a unified structure there would always be differences in interpretation¹⁸⁸⁰. But these differences would be very limited, if the panels were composed of judges from different states, if the judges communicated with each other and if the rulings were rendered in an open spirit beyond the judges' own legal traditions and views, in a structural framework which allowed work towards a uniform interpretation of European patent law. In addition, the centralised court of appeal would ensure that the possibility of even small differences in jurisprudence in a decentralised structure would be eliminated¹⁸⁸¹.

One possible way out of the dilemma of substituting well-functioning national courts with a European patent court wherein the outcome is still unknown, could have been to permanently share the jurisdiction between them¹⁸⁸².

This would, however, seem to make the current situation worse: An additional court along all national courts having jurisdiction would only foster *forum shopping* and legal uncertainty.

¹⁸⁷³ Cf. Landfermann, *Litigation*, 228.

¹⁸⁷⁴ Cf. Pagenberg, *Roles*, 62.

¹⁸⁷⁵ Cf. Comments of UNICE, WPL/3/00, 5.

¹⁸⁷⁶ Cf. Schade, *Protocol*, 172.

¹⁸⁷⁷ Cf. Ullrich, *Harmony*, 33.

¹⁸⁷⁸ Cf. Schade, *Streitregelungssystem*, 833; Schade, *Protocol*, 174-176.

¹⁸⁷⁹ Cf. Sydow, 693.

¹⁸⁸⁰ Cf. Pagenberg, *Roles*, 64.

¹⁸⁸¹ Cf. also Guldener, § 1, III.

¹⁸⁸² Cf. Willems, *Patent Court*, 166.

It would also seem difficult to reach a unified jurisprudence since it is quite open how the national courts would accept an (additional) European court and its jurisprudence.

A parallel jurisdiction between national courts and the European Patent Court is desired for a limited period of time in order to test and possibly amend the system¹⁸⁸³ and to ensure a smooth transition of powers. Seven years of parallel jurisdiction as suggested in the draft EPLA¹⁸⁸⁴ seems, however, to be too long.

The task of the WPL was to make a proposal for a litigation system which tackled the major negative factors of the current European patent system, while bringing together the different positions with regard to the first instances. The WPL suggested the structure of a Central Division and Regional Divisions in the EPLA contracting states. This approach satisfied the request for a unified European structure of first instance and proved that a decentralised structure did not necessarily require national courts in first instance¹⁸⁸⁵.

cc) The European Patent Court as two separate organisational bodies

In the "First proposal for an EPLP"¹⁸⁸⁶, *Willems* submitted two proposals with regard to the organisation of the two European instances¹⁸⁸⁷. The first proposal included two variants. Both of them were based on systems existing in two big countries outside of Europe, Canada and Australia.

The first approach was based on the Canadian model and included the suggestion to create one court with two divisions: a trial division and an appeals division¹⁸⁸⁸. The judges would be appointed to one of the divisions but would also be a member of the other division *ex officio*.

The second approach, based on the Australian model, also suggested to put both instances under one umbrella, but kept the divisions totally separate¹⁸⁸⁹.

¹⁸⁸³ Cf. *Pagenberg, Roles*, 67.

¹⁸⁸⁴ See Art. 85 draft EPLA.

¹⁸⁸⁵ Cf. also *Landfermann, Diskussionen*, 115; *Boval, Remarques*, 167; *Sedemund-Treiber, Strukturen*, 125.

¹⁸⁸⁶ Cf. *Willems, 1st proposal*.

¹⁸⁸⁷ Cf. *Willems, 1st proposal*, 9.

¹⁸⁸⁸ See Section 3 and 4 Canadian Federal Courts Act.

¹⁸⁸⁹ See Section 5 and 24 Federal Court of Australia Act 1976.

The sub-group of the WPL opted for the second proposal where two totally separated courts would be established¹⁸⁹⁰. The advantage of that structure was that most, if not all, European court structures were organised in this way and would thus facilitate a possible integration of them into the European patent litigation system¹⁸⁹¹. But it was also the familiarity of the system which played an important role.

dd) The Court of First Instance

As mentioned above, the WPL sub-group and the WPL came to the conclusion that the Court of First instance should consist of several local divisions. Therefore, it was suggested to establish a Central Division and several Regional Divisions.

aaa) Central Division

The Central Division would be set up at the seat of the European Patent Judiciary¹⁸⁹² and would be the basis of the court. The idea in creating a centralised division was to enable the court of first instance to act as a real court and make tangible the EPJ¹⁸⁹³.

bbb) Regional Divisions of the European Patent Court of First Instance

The initial proposal concerning the judicial structure of the Court of First instance was to create a centralised court which at the same time would have local presence. It was therefore suggested in the structure paper submitted to the London Intergovernmental conference that the court could create:

"regional chambers and/or to come to the defendant's place of residence or business for oral hearings or taking of evidence, sitting in a courtroom provided for by national authorities ('peripatetic court'). The core of such a chamber would be one or more judges from a national court, at the same time acting as judges of the common first instance court. Each EPLA contracting state should designate one of its courts of first instance to provide the regional chamber of the common first instance court with facilities (courtroom, communications infrastructure, etc.). The registry of that national court could also function as a sub-registry of the common European patent court. New information technology (e.g. video-conference) should be used wherever

¹⁸⁹⁰ Cf. WPL/SUB 10/01, N 6.

¹⁸⁹¹ Cf. *Willems, 1st proposal*, 9.

¹⁸⁹² Art. 10(1) draft EPLA.

¹⁸⁹³ Cf. *Willems, 3rd proposal*, 22.

possible."¹⁸⁹⁴

When the structure paper was submitted it was still open as to what the Regional Chambers of the Court of First Instance should look like.

As mentioned above, it seemed clear for the majority of the WPL that it should not simply be composed of national courts acting as European courts. *Willems* offered two alternatives for discussion in the "First proposal for an EPLP", with more or less a centralised approach¹⁸⁹⁵:

- Regional Chambers only consisting of judges also functioning as members of national courts; or
- Regional Chambers as deciding bodies in regions where there was a sufficient amount of work.

The initial alternative of the structure paper where the European Patent Court of First Instance would come to the locality of the defendant and sit in a courtroom offered by national authorities (a "peripatetic court")¹⁸⁹⁶ for oral hearings or witness examinations was no longer discussed. The idea of a travelling court appearing on request was, for most stakeholders, hard to imagine¹⁸⁹⁷. The request for some local presence in order to conduct proceedings at home suggested a somehow tangible court structure¹⁸⁹⁸.

i) National judges acting as European judges

The first proposal was to make use of the local facilities and the national patent judges. In contrast to the proposal of national courts in the first instance, the European Patent

¹⁸⁹⁴ See *Structure paper*, 2000 Bijblad bij de Industriële Eigendom, 267; 2000 EIPR, S-8; 2000, IIC, 576.

¹⁸⁹⁵ Cf. *Willems*, 1st proposal, 10-11.

¹⁸⁹⁶ The idea of a "travelling court" was also discussed in the framework of a Community Patent Court, cf. also *Rau*, 242.

¹⁸⁹⁷ Cf. *Pagenberg*, *First Instance*, 485; *Tilmann*, *Gemeinschaftspatent*, 384; *Sydow*, 693.

¹⁸⁹⁸ Cf. Comments of UNICE, WPL/3/00, 5.

Judiciary would have made use of the existing local facilities and knowledge and would have not created "functional" units of the court¹⁸⁹⁹.

The local judges would have acted both as part time national judges, and as European patent judges. In order to ensure the exchange of ideas and to create a true European court, the judges would all work once at the central chamber for at least six months¹⁹⁰⁰.

The registries of the national courts would act as sub-registries. Parties would have consequently had the possibility to file court documents at these local registries¹⁹⁰¹.

It followed from this approach that every EPLA contracting state could have a local presence of the European Patent Court.

ii) Regional chambers in states with sufficient work

Based on this second proposal the court itself would have the authority to set up Regional Chambers. Such "sub-courts" of the European Patent Court would have their own seats, judges and other personnel, and would be established if there had been sufficient work.

The sub-courts would have jurisdiction for a certain region in the area where the European Patent Court would have territorial jurisdiction.

Local judges would not necessarily have to be active in the Regional Chamber where they came from. Working at the central chamber for a certain period of time in order to create a true European jurisprudence did not seem as important as in the first proposal.

iii) The agreed principle

The sub-group of the Working Party on Litigation discussed the different proposals at its third meeting.

¹⁸⁹⁹ Cf. *Willems, First instance*, 397.

¹⁹⁰⁰ Cf. also *Sedemund-Treiber, Strukturen*, 125; *Rau*, 243.

¹⁹⁰¹ Cf. *Willems, First instance*, 397.

It agreed on a combination of the two proposals¹⁹⁰²: Each EPLA contracting state should have *the right* to establish a limited number of Regional Chambers within its territory. But it should also be possible that several states come together and establish one or more Regional Chambers on their territory.

In contrast to the initial proposal, the decision to create Regional Chambers would not be at the disposal of the court. The chambers would functionally make up part of the European Patent Court.

National judges would act as European judges in a Regional Chamber. The panel should, however, be composed internationally, as this was also requested by the users¹⁹⁰³.

The proposal of the sub-group was obviously convincing enough for the states that desired national courts in first instance, as they abandoned their approach. The proposed solution could also discard any misgivings that a centralised approach would negatively affect local expertise and local infrastructures, which could have a particularly negative impact on SMEs¹⁹⁰⁴.

iv) Further developments and the latest proposal

The idea of Regional Chambers acting as sub-courts of the court was elaborated more and more in the subsequent meetings of the WPL sub-group. The term "Regional Chamber" was replaced by "Regional Division" to make it more obvious that they were an organisational part of the European Patent Court¹⁹⁰⁵. The group confirmed the right for each EPLA contracting state or a group of states (the Benelux states, for example) to establish a Regional Division.

¹⁹⁰² Cf. also *Nilsson*, 599.

¹⁹⁰³ Cf. Comments of UNICE, WPL/3/00, 6.

¹⁹⁰⁴ Cf. Comments of UNICE, WPL/3/00, 4; *Leith, Revision*, 252.

¹⁹⁰⁵ Cf. Willems Jan, Second Proposal for an EPLP, WPL/SUB 13/01, 15, available at <www.ige.ch/E/jurinfo/documents/j14105_prop.pdf>.

There were, however, concerns in the sub-group that Regional Divisions could be established that did not provide for the necessary legal expertise¹⁹⁰⁶. Additionally, it was felt that costly Regional Divisions could be built up out of political reasons wherein, in fact, there was no real need¹⁹⁰⁷. And last but not least, EPLA contracting states with possibly only a small or no Regional Division did not want to indirectly finance other Regional Divisions.

Therefore, the sub-group (and later on the WPL) agreed that certain requirements would have to be fulfilled in order to request a Regional Division. These requirements, though, should not be too strict:

- First, the request had to indicate where the Regional Division and the sub-registry were to be located. It furthermore had to name two people who could satisfy the requirements for office as provided in Article 2 draft Statute, agree to be appointed as legally qualified judges of the Court of First Instance, and who could be assigned as permanent members to the Regional Division to be set up¹⁹⁰⁸.

- Second, a Regional Division set up by any EPLA contracting state (or a group of contracting states) would be financed by that state or group of states. The salary of the judges in any Regional Division would, however, be covered by the budget of the European Patent Judiciary¹⁹⁰⁹.

Since the establishment of a Regional Division was a right of each EPLA contracting state, the Administrative Committee could not refuse the request if the required criteria were fulfilled¹⁹¹⁰. The Common Presidium¹⁹¹¹ would have to examine¹⁹¹² whether or not at least two of the people named as appointees indeed satisfied the requirements for office¹⁹¹³.

¹⁹⁰⁶ Cf. WPL/SUB 22/01, N 21 to N 31.

¹⁹⁰⁷ Cf. also *Pagenberg, Patent*, 537.

¹⁹⁰⁸ Art. 19(1) draft Statute.

¹⁹⁰⁹ Art. 21a(1) draft EPLA.

¹⁹¹⁰ Art. 10(2) draft EPLA in conjunction with Art. 19(1) draft Statute.

¹⁹¹¹ Cf. §7 B.II.1.a)ff)bbb) Common Presidium.

¹⁹¹² Art. 19(2) draft Statute.

¹⁹¹³ Cf. §7 B.II.2.a) Requirements for office.

The question was, however, whether the Common Presidium would indeed keep the necessary distance from politics, and whether a founded decision not to accept a proposal made by a government would be politically accepted.

If the state was no longer interested in a Regional Division the Administrative Committee would have to agree unanimously in order to close it down¹⁹¹⁴. This could be problematic, not least from a financial perspective for an EPLA contracting state if it no longer desired to have a Regional Division, and if the Administrative Committee would not support the request. From a political perspective such a scenario seemed highly unlikely.

Additionally, the WPL accepted the proposal that it could be possible for a country or a group of states to have more than one Regional Division, but not more than three¹⁹¹⁵.

This would make it possible for the existing efficiency, know-how and quality to be directly introduced into the system¹⁹¹⁶. At the same time, it would be assured that the European Patent Judiciary would not be dominated by Regional Divisions from one or more certain states and, together with the criteria of an international composed panel, promote the development of a common legal culture and the alignment of the existing diverging views. Therefore, this limitation to no more than three Regional Divisions per country is an important aspect in this regard.

The request to set up further Regional Divisions would also have to be addressed by the Administrative Committee¹⁹¹⁷. The preconditions for a possible second and third Regional Division would be as follows:

- First, the initial requirements for a Regional Division must be fulfilled.
- Second, the national courts or the Regional Division set up in a EPLA contracting state (or for a group of EPLA contracting states requesting further divisions) must have dealt with more than one hundred cases concerning European patents in a year, over three

¹⁹¹⁴ Art. 22(1) draft Statute.

¹⁹¹⁵ Art. 20(1) draft Statute.

¹⁹¹⁶ Cf. *Addor*, 334.

¹⁹¹⁷ Art. 10(2) draft EPLA in conjunction with Art. 20(1) draft Statute.

successive years¹⁹¹⁸.

Therefore, the request would have to state the number of cases concerning European patents that have been dealt with during each of the last three years preceding the request, and the local competence of the Regional Divisions within the contracting state or the group of contracting states¹⁹¹⁹. The latter would make it clear what the "territorial jurisdiction" of each Regional Division would be.

It should clearly be noted that the Divisions would merely have an organisational function, comparable to that of senates or chambers in national courts, the only difference being that they would be spread out geographically throughout the EPLA contracting states. This would in no way affect the unity of the Court. The different Divisions would not be independent courts.

Based on the current existing numbers¹⁹²⁰, only France and Germany could have more than one Regional Division on their territory¹⁹²¹. It is thus to be expected that they will request more than one such division if the European Patent Court is created. It should be noted, however, that there is no precise data available on the number of cases within the EPC contracting states related to European patents. In case a state is requesting more than one division for its territory it will consequently be very difficult to check whether the number of litigations provided are correct.

As mentioned above, the Administrative Committee would have the authority to decide unanimously to discontinue a Regional Division¹⁹²². The decision would state the date from which no new cases could be brought before that Division, as well as the date on which it would cease to exist¹⁹²³. As of the date from which the Regional Division ceased to exist, the judges assigned as permanent members of the Regional Division would be assigned

¹⁹¹⁸ Art. 20(1) draft Statute.

¹⁹¹⁹ Art. 20(2) draft Statute.

¹⁹²⁰ Based on the survey made by the EPO in 2003 among the WPL sub-group only courts in France and Germany of the states interested in joining the EPLA deal with more than 100 cases per year related to European patents (cf. WPL/4/03); cf. also *Schneider*, 142-143; 151-152; 167-169; 174-176; 180-184. It seems that this situation has not changed in the meantime, cf. Working Document from the Presidency, Towards an Enhanced Patent Litigation System and a Community Patent - How to Take Discussions Further (Doc. 11622/07), available at <www.epo.org/focus/news/2007/20070725.html>.

¹⁹²¹ Cf. also *Casalonga*, *Le contentieux futur*, 255.

¹⁹²² Art. 10(2) draft EPLA in conjunction with Art. 22(1) draft Statute.

¹⁹²³ Art. 22(2) draft Statute.

to the Central Division, and cases still pending before the Regional Division would be transferred to the Central Division without a change in the panel composed for those cases¹⁹²⁴.

ccc) President, divisional presidents and Presidium

The Court of First Instance would have a President and a Presidium¹⁹²⁵.

The President would direct the court and the Presidium¹⁹²⁶. The judges of the court would appoint the President (and his substitute) for a term of three years and would have to chose him from among the legally qualified judges of the court¹⁹²⁷.

This construction seems to limit potential political influence with regard to the elections of the President, and would thus strengthen the court's independence¹⁹²⁸. To limit outside influence, it is also proposed that the President can be re-elected only once¹⁹²⁹.

The Presidium would be composed of the President of the Court, the divisional presidents and two further members, elected by the judges of the court¹⁹³⁰. The two elected members would hold office for four years¹⁹³¹ in order to make sure that they would not retire at the same time as the President. This would prevent a situation wherein the collective experience in the Presidium would disappear at once¹⁹³².

The divisional presidents would perform the functions of the President for their designated Regional Division¹⁹³³. It would therefore be necessary to establish rules on the exact duties of the President of the Court of First Instance and the divisional presidents. This would prevent any conflicts regarding competences.

¹⁹²⁴ Art. 22(3) draft Statute.

¹⁹²⁵ Arts. 14(1) und 15(1) draft Statute.

¹⁹²⁶ Art. 14(1) draft Statute.

¹⁹²⁷ Art. 14(2) draft Statute.

¹⁹²⁸ Cf. *Willems, 3rd proposal*, 39.

¹⁹²⁹ Art. 14(2) draft Statute.

¹⁹³⁰ Art. 15(2) draft Statute.

¹⁹³¹ Art. 15(4) draft Statute.

¹⁹³² Cf. *Willems, 3rd proposal*, 39.

¹⁹³³ Art. 24(3) draft Statute.

The divisional presidents would be elected for six years¹⁹³⁴ by the Presidium, having heard the permanent members of the Regional Division¹⁹³⁵. This should not only guarantee the necessary distance to governmental influence, but also ensure a certain continuation in the Regional Division. However, the possibility of the divisional presidents getting re-elected would not be limited. This could be a disadvantage. Experience in public office and in politics shows that some officials stick to their positions when, in fact, some change would be useful. It would therefore seem appropriate that re-election of the divisional presidents should also be limited, not least since only a single re-election would have the consequence that a person presides over a regional division for twelve years.

Provisions regarding the first elections of the divisional presidents are especially interesting to study.

Article 39(1) draft Statute provides that the first judges would be appointed by the Administrative Committee on proposals from the governments of the EPLA contracting states. It seems quite clear that the Administrative Committee would decide to establish Regional Divisions. Once decided upon, it would be up to the Presidium to elect the divisional presidents.

Generally, the Presidium is composed of the President of the Court, two elected members, and the divisional presidents. The election of the divisional presidents would therefore have to be executed by a Presidium composed only of the President and the two previously elected members.

A possible alternative solution could be the approach which was initially considered with regard to the elections of the first Presidents of the Court of First Instance and the Court of Appeal and their substitutes, and the first elected members of the Presidiums of the courts¹⁹³⁶: the Administrative Committee first appoints a provisional committee which would again elect these officials. This proposal could also be considered for the elections of the first divisional presidents.

¹⁹³⁴ Art. 24(2) draft Statute.

¹⁹³⁵ Art. 24(1) draft Statute.

¹⁹³⁶ Cf. *Willems*, 3rd proposal, Art. 181(3).

It seems clear, however, that such elections would open up the door for a huge amount of political dealing, which should be avoided. It would be difficult for the three members of the Presidium to refrain from politics and influence from governments when electing the divisional presidents.

Further duties of the Presidium of the Court of First Instance would be:

- to advise and assist the President with regard to administrative, organisational, budgetary and personnel matters,
- to advise the Executive Committee¹⁹³⁷ on proposals for Practice Directions of the Court,
- to carry out any task assigned to them by the Executive Committee¹⁹³⁸,
- to advise the different divisions of the court on matters concerning the functioning of the court in general¹⁹³⁹, and
- to possibly assign legally qualified judges to a Regional Division as permanent members¹⁹⁴⁰.

The Presidium could delegate duties wholly or in part to the President and to the divisional presidents¹⁹⁴¹.

A member of the Presidium could not take part in deliberations or decisions concerning himself¹⁹⁴². Since the number of Regional Divisions has not yet been decided and could again change, it is still unclear how many divisional presidents would exist. The President would therefore be given the casting vote in the event of a possible stand-off in the Presidium¹⁹⁴³.

ee) The Court of Appeal and the role of the ECJ

The Court of Appeal would also be set up at the seat of the European Patent Judiciary¹⁹⁴⁴. It would not only act as second instance, but also as Facultative Advisory Council¹⁹⁴⁵.

¹⁹³⁷ Cf. §7 B.II.1.ff)aaa) The Executive Committee.

¹⁹³⁸ Art. 16(1) draft Statute.

¹⁹³⁹ Art. 16(2) draft Statute.

¹⁹⁴⁰ Art. 23(1) draft Statute.

¹⁹⁴¹ Art. 16(2) draft Statute.

¹⁹⁴² Art. 15(5) draft Statute.

¹⁹⁴³ Art. 14(3) draft Statute.

¹⁹⁴⁴ Art. 11 draft EPLA.

¹⁹⁴⁵ For the details cf. §6 C.III. The Facultative Advisory Council.

Regional Divisions at the appeal level are not proposed, as they have also never been requested.

On the one hand, it doesn't seem necessary to have a decentralised structure also within the court of appeal, since only a limited number of cases will be appealed. Efficiency reasons would also make it necessary for Regional Divisions at the appeals level to be created that would cover a larger territory than the divisions in first instance.

On the other hand, a centralised structure guarantees the unity of legal practice more easily. The Court of Appeal would thus be better suited to intervene in case Regional Divisions should develop diverging practices¹⁹⁴⁶.

Traditionally, such regional differences develop in legal areas where local practice plays an important role, unified law affects regional interests and regional standards are used to confirm legal terms¹⁹⁴⁷. Patent litigation could indeed affect regional policy or economic interests and have an influence upon the decision. "Local practice" should, however, not to be anticipated since the panels in the Regional Divisions would include judges from different states. In addition, judges could also be assigned to several divisions.

What was not discussed was the creation of a third instance at the European level. But this would not seem necessary especially since the specialised Court of Appeal would be able to give a ruling on fact and law¹⁹⁴⁸.

In any case, the ECJ would have to be contacted by the European Patent Court for a preliminary ruling with regard to Community law based on Article 234 EC Treaty¹⁹⁴⁹. The rulings of the ECJ would be binding on the European Patent Court in so far as the latter's decision would take effect in one or more of the EPLA contracting states which are also EU member states¹⁹⁵⁰.

¹⁹⁴⁶ Cf. also *Dreiss*, 715.

¹⁹⁴⁷ Cf. *Meier*, 322-325.

¹⁹⁴⁸ Cf. also *Sedemund-Treiber*, *Strukturen*, 124.

¹⁹⁴⁹ Art. 40(1) draft EPLA.

¹⁹⁵⁰ Art. 40(2) draft EPLA.

aaa) President and Presidium

As in the Court of First Instance, the Court of Appeal of the European Patent Court would be directed by a President. He would also preside over the Presidium of the Court of Appeal¹⁹⁵¹.

The Presidium of the Court of Appeal would be composed of the President of the Court and two members, elected by the judges of the court¹⁹⁵². In contrast to the President of the Court of First Instance¹⁹⁵³, it is consequently not necessary to provide the President of the Court of Appeal with a casting vote.

The elections and terms for the President and the Presidium, as well as their functions are, in general, the same as for the Court of First Instance.

ff) Common bodies of the Court of First Instance and the Court of Appeal

aaa) The Executive Committee

The Executive Committee would be responsible for managing the European Patent Court¹⁹⁵⁴.

Having heard the Common Presidium, it would draw up proposals for the Administrative Committee, regarding the Rules of Procedure of the European Patent Court, the fees to be charged in proceedings before the court and the Practice Directions of the court.

Additionally, it could authorise judges to pursue other activities for remuneration outside of the court¹⁹⁵⁵, would prepare the annual budget, the annual accounts, the annual report of the court and submit them to the Administrative Committee¹⁹⁵⁶.

¹⁹⁵¹ Art. 14(1) draft Statute.

¹⁹⁵² Art. 15(3) draft Statute.

¹⁹⁵³ Art. 14(3) draft Statute.

¹⁹⁵⁴ Art. 17(2) draft Statute.

¹⁹⁵⁵ Art. 6(1) draft Statute.

¹⁹⁵⁶ Art. 17(3)(a) and (b) draft Statute.

It seems that the term "annual report" refers to the "management report"¹⁹⁵⁷. The designation should thus be replaced, as it would hardly be necessary that the court's annual report intended for the public on the whole be also approved by the Administrative Committee.

The Executive Committee could also request that the Administrative Committee meet outside of the ordinary annual meeting¹⁹⁵⁸.

The Executive Committee is composed of the Registrar and Presidents of the Court of First Instance and the Court of Appeal, or their substitutes¹⁹⁵⁹. It would therefore be a judicial body, in the sense that it is occupied by officers of the courts¹⁹⁶⁰. The members of the Executive Committee could not pursue any other activities for remuneration outside of the court¹⁹⁶¹, as their job is considered to be full time.

The sub-group of the WPL felt that parts of the daily management of the court could also be executed, for example, by the Presidents themselves. Therefore, it was decided to introduce a provision into the draft Statute which would make it possible that the committee, without prejudice to its own responsibility, could delegate certain tasks to one of its members or to the Presidiums of the Court of First Instance and the Court of Appeal¹⁹⁶². The members of the Presidiums might also take part in the deliberations of the Executive Committee as observers¹⁹⁶³. Their participation would bring extra expertise on the subject matters at stake in the committee and would make it possible for members of the Presidium who would be regularly present to obtain the necessary expertise needed in their function as substitutes in the committee¹⁹⁶⁴.

The meetings would be chaired by the President of the Court of Appeal¹⁹⁶⁵, but it could only take valid decisions when all three members were present¹⁹⁶⁶. This approach would

¹⁹⁵⁷ Cf. also Art. 10(2)(e) EPC.

¹⁹⁵⁸ Art. 15(5) draft EPLA.

¹⁹⁵⁹ Art. 17(1) draft Statute.

¹⁹⁶⁰ Cf. *Nilsson*, 609.

¹⁹⁶¹ Art. 6(2) draft Statute.

¹⁹⁶² Art. 17(2) draft Statute.

¹⁹⁶³ Art. 17(4) draft Statute.

¹⁹⁶⁴ Cf. *Willems*, 3rd proposal, 35.

¹⁹⁶⁵ Art. 17(1) draft Statute.

¹⁹⁶⁶ Art. 17(4) draft Statute.

make it certain - at least theoretically - that the points on the agenda would be discussed in the group before the decision is taken by a majority of votes, i.e. by two persons who are in agreement¹⁹⁶⁷.

bbb) Common Presidium

The only task of the so-called "Common Presidium" is to draw up proposals concerning the appointment, re-appointment and removal of judges and the Registrar¹⁹⁶⁸.

The body was mainly introduced to assure the quality and judicial independence of the court¹⁹⁶⁹.

On the one hand, it would make lists with the best possible candidates to serve the court, which should guarantee that the judges are not appointed by the Administrative Committee only out of political reasons but rather because they have the necessary legal and/or technical knowledge and language skills.

On the other hand, if a judge is not favored by politicians, he could not be removed from office just because he rendered certain judgments. The Common Presidium would have to propose with a three-quarters majority that the judge be removed from office. A removal could only be possible if the judge no longer meets the obligations arising from his office¹⁹⁷⁰. The Common Presidium would thus also be the disciplinary authority over the judges.

As the term "Common Presidium" suggests, it would be composed of the members of the two Presidiums and the Registrar¹⁹⁷¹. It was thus also decided to change the initial designation "Extended Executive Committee" into "Common Presidium"¹⁹⁷². It goes without saying that a member of the Common Presidium might not take part in

¹⁹⁶⁷ Cf. *Willems, 3^d proposal*, 35.

¹⁹⁶⁸ Art. 18(2) draft Statute.

¹⁹⁶⁹ Cf. *Willems, 3^d proposal*, 36.

¹⁹⁷⁰ Art. 8(1) draft Statute.

¹⁹⁷¹ Art. 18(1) draft Statute.

¹⁹⁷² Cf. WPL/SUB 2/02, Art. 19.

deliberations or decisions concerning himself¹⁹⁷³. The meetings of the Presidium would be chaired by the President of the Court of Appeal¹⁹⁷⁴.

gg) *The Registry*

The Registry of the European Patent Court would also be set up at the seat of the court¹⁹⁷⁵, thus, at the place of the Central Division and the Court of Appeal. It would serve both instances.

Sub-registries would be established at the Regional Divisions of the Court of First Instance¹⁹⁷⁶. This would make it possible for the necessary court services to be provided directly at the local level. It would also be possible to file court documents directly before the Regional Divisions. The sub-registries would also carry out a number of organisational and practical duties with regard to the cases handled in their divisions¹⁹⁷⁷.

He would be responsible for the management of the Registry¹⁹⁷⁸ not taken on by the Executive Committee¹⁹⁷⁹. It will thus again be necessary to draw up a clear list of duties, responsibilities and authorities with regard to the management of the Registry.

In principle the Registrar would provide administrative and secretarial assistance to the European Patent Court¹⁹⁸⁰. A very important task in that regard would be to coordinate the division of work between the Registry and the sub-registries in cases allocated to the Regional Divisions¹⁹⁸¹. The Registrar would also receive the fees payable to the court, communicate with the parties, keep a register of the cases and administer the funds, as well as manage the buildings and other material assets of the court¹⁹⁸². However, the management of the buildings and material assets would, to a great extent, be limited to the

¹⁹⁷³ Art. 18(3) draft Statute.

¹⁹⁷⁴ Art. 18(1) draft Statute.

¹⁹⁷⁵ Art. 12(1) draft EPLA.

¹⁹⁷⁶ Art. 12(2) draft EPLA.

¹⁹⁷⁷ Cf. *Willems, 3rd proposal, 37*.

¹⁹⁷⁸ Art. 12(1) draft EPLA.

¹⁹⁷⁹ Cf. Art. 13(1) draft Statute.

¹⁹⁸⁰ Art. 13(2) draft Statute.

¹⁹⁸¹ Art. 13(2)(a) draft Statute.

¹⁹⁸² Art. 13(2)(b) - (d) draft Statute.

court buildings located at the seat of the European Patent Judiciary, as it was decided by the WPL that the Regional Divisions set up by an EPLA contracting state or a group of contracting states would be financed by that state or group of states¹⁹⁸³.

Additionally, the Registrar would have important communication functions for the European Patent Court. On the one hand, he would provide for the publication of decisions and opinions of the court. On the other hand, he would have to publish decisions of the Administrative Committee setting up or discontinuing Regional Divisions¹⁹⁸⁴.

Based on the example of the European Patent Organisation¹⁹⁸⁵, the Registry would place at the disposal of the Administrative Committee and of any body established by it, staff, premises and equipment as necessary for the performance of their duties¹⁹⁸⁶. This rule would ensure that the administrative costs of the committee would be limited. Efficiency reasons would also require that the Administrative Committee would hold its regular meetings at the seat of the European Patent Judiciary. Whether politicians share this approach is certainly open to debate.

Depending on the amount of work in order to prepare the meetings of the committee it could be useful to create a special secretariat of the committee under the Registrar, as is the case with regard to the Administrative Council of the European Patent Organisation.

The first Registrar would be appointed by the Administrative Committee based on a proposal from the governments of the EPLA contracting states¹⁹⁸⁷. In general, he would be appointed, re-appointed and removed by the Administrative Committee on a proposal from the Common Presidium¹⁹⁸⁸.

A balance between politics and quality, as well as the necessary independence should thus also be assured with regard to the Registrar. The necessary proposal from the Common Presidium should guarantee that he would fit into the judicial culture or that he could be removed if he did not, and the appointment by the Administrative Committee

¹⁹⁸³ Cf. §7 B.II.1.a)dd)bbb)iv) Further developments and latest proposal.

¹⁹⁸⁴ Art. 13(2)(e) - (f) draft Statute.

¹⁹⁸⁵ Cf. Art. 32 EPC.

¹⁹⁸⁶ Art. 13(3) draft Statute.

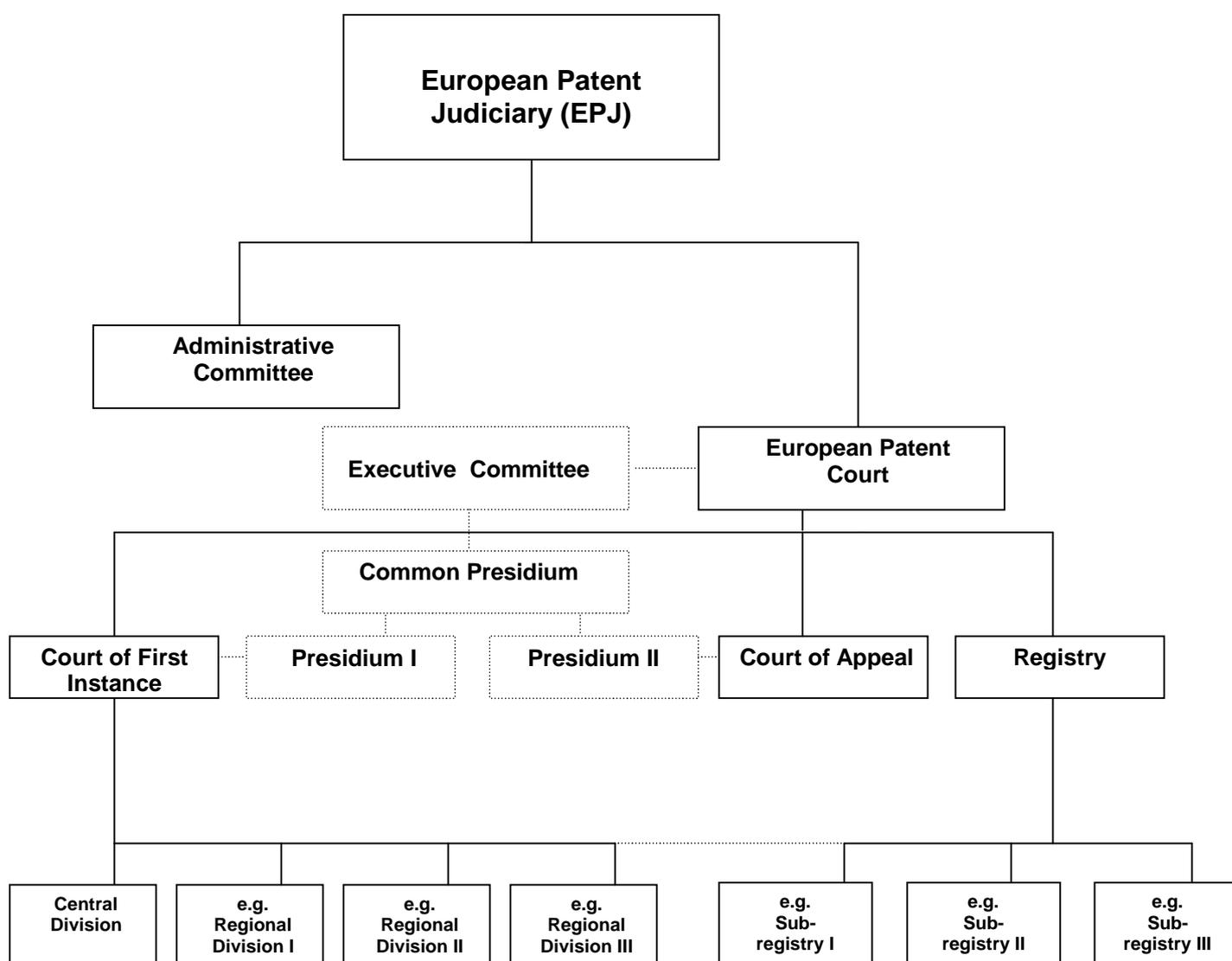
¹⁹⁸⁷ Art. 39(1) draft Statute.

¹⁹⁸⁸ Arts. 11 and 12 draft Statute.

would strengthen his position against the President of the Court of First Instance and the Court of Appeal putting him on a comparable level with the Executive Committee¹⁹⁸⁹.

The Registrar would be appointed for six years and could be re-appointed¹⁹⁹⁰. He would enjoy privileges and immunities as defined in the Protocol on Privileges and Immunities¹⁹⁹¹.

Graphic overview of the European Patent Court's organisation



¹⁹⁸⁹ Cf. *Willems, 3rd proposal, 38.*

¹⁹⁹⁰ Art. 11 draft Statute.

¹⁹⁹¹ Art. 8 draft EPLA.

2. Judges

a) Requirements for office

It can hardly be denied that a court's quality to a great extent depend on the experience and knowledge of the judges appointed to it¹⁹⁹².

In order to guarantee that only qualified candidates with high expertise in patent law and patent litigation are appointed to the court, the WPL agreed in Article 2 draft Statute upon the following three requirements for office which would have to be fulfilled cumulatively by any person to be appointed as judge to the court:

- First, the person must have a good command of at least one of the official languages.

Language abilities would be of great importance for the appointment of the judges. This is the consequence of the following: the Administrative Committee would specify the number of legally qualified judges to be permanently assigned to a Regional Division when deciding to set it up¹⁹⁹³. The language before the different divisions could, however, vary.

Based on the latest proposals, the language of proceedings of a Regional Division located in a EPLA contracting state having an official language which is one of the official languages of the EPO (e.g. France, Germany, or the United Kingdom), would be that official language¹⁹⁹⁴. If the division is located in a state having either more than one or no official language (e.g. Belgium, the Netherlands or Sweden), the language of proceedings would be any official language of the EPO designated by that state¹⁹⁹⁵. If the proceedings were held before the Central Division of the Court of First Instance, the language of the proceedings would be the one before the EPO¹⁹⁹⁶. In proceedings before the Court of Appeal, the language of the proceedings would be the language before the Court of First Instance¹⁹⁹⁷.

¹⁹⁹² Cf. *Leith, Revision*, 252; *Schade, Streitregelungssystem*, 834; *Heath*, 14.

¹⁹⁹³ Art. 21(1) draft Statute.

¹⁹⁹⁴ Art. 32(1)(b) draft Statute.

¹⁹⁹⁵ Art. 32(1)(c) draft Statute.

¹⁹⁹⁶ Art. 32(1)(a) draft Statute.

¹⁹⁹⁷ Art. 32(1)(d) draft Statute.

This makes it clear that language knowledge is very decisive the appointment to the court and a certain division.

- Second, the person must demonstrate sufficient experience in patent law.

In order to be appointed to the European Patent Court, the knowledge of patent law is just as important as the language ability. In order to guarantee that the judges fulfil this requirement, it is very important that the persons eligible for an appointment are chosen by an independent and technical body. As mentioned above, the WPL agreed that the Common Presidium composed of the Registrar and the two Presidiums of the Court of First Instance and the Court of Appeal would draw up proposals *inter alia* concerning the appointment and re-appointment of the judges¹⁹⁹⁸.

The final decision for appointment would, however, be in the hands of the Administrative Committee¹⁹⁹⁹, although only a qualified majority would be necessary. This proposal of the division of tasks between the two organs of the EPJ provides for the necessary balance between political and quality considerations regarding judges. This balance seems at risk with regard to the first appointments of the judges.

Based on the latest proposal, the first judges would be appointed by the Administrative Committee on proposals from the governments²⁰⁰⁰ of the EPLA contracting states. The door would thus seem open for purely political appointments, particularly since every EPLA contracting state would have the right to be represented in the court regardless of whether it acceded to the entire agreement or only to the Facultative Advisory Council²⁰⁰¹ part of the EPLA²⁰⁰².

However, Article 39(2) draft Statute provides that either a legally qualified judge, a technically qualified judge or respective "assessor"²⁰⁰³ from each EPLA contracting state would be appointed to the Court of First Instance and the Court of Appeal. This would give the committee the possibility to appoint a proposed candidate initially as "assessor", even

¹⁹⁹⁸ Art. 18(1) and (2) draft Statute.

¹⁹⁹⁹ Art. 17(3) draft EPLA.

²⁰⁰⁰ Art. 39(1) draft Statute.

²⁰⁰¹ Cf. §6 C.III. The Facultative Advisory Council.

²⁰⁰² Art. 39(2) draft Statute.

²⁰⁰³ Cf. §7 B.II.2.f) "Assessor".

if it was not fully convinced of his experience in patent law. In addition, the Administrative Committee would be fully aware of the fact that the court would only be accepted by the users and contribute to the goal of the creation of the EPLA, if the necessary quality and efficiency can be guaranteed by the system. This will greatly depend on the professional background of the judges.

- Third, the person has either been or is a judge in one of the EPC contracting states, or a member of a Board of Appeal of the EPO or a national patent office of one of the EPC contracting states, or has other equivalent experience enabling him to act as a judge of the European Patent Court.

The last requirement for office would, on the one hand, ensure that a person interested in being appointed to the court not only has the necessary substantive knowledge of patent law but also the required practical knowledge. On the other hand, the proposal that national judges²⁰⁰⁴, members of the EPO Boards of Appeal or any other person having equivalent experience, such as professors of patent law or experienced lawyers²⁰⁰⁵, could be appointed to the court would create a big pool of potential suitable candidates²⁰⁰⁶.

This pool could grow even more considering the proposal that the candidates could be chosen from all EPC contracting states regardless of whether or not the state participated in the EPLA. The initial suggestion went as far as accepting candidates coming from outside the EPC area. This initiative was, however, rejected, as it was partially felt that the judges of the European Patent Court should be familiar with Europe's judicial culture and traditions in order to develop a mixture of the different European schools of legal thought and practice²⁰⁰⁷.

The proposal also includes the possibility that national judges or members of the EPO Boards of Appeal could continue with their initial function²⁰⁰⁸. They would, thus, only be hired on a part-time basis by the EPJ. This avoids that the national authorities or the EPO Boards of Appeal would lose qualified people to the European Patent Court. But it also

²⁰⁰⁴ Cf. also *Brinkhof, Wish List*, 415.

²⁰⁰⁵ Cf. also *Jacob, Decisions*, 16.

²⁰⁰⁶ Cf. *Schneider*, 276.

²⁰⁰⁷ Cf. WPL/SUB 22/01, N 79 to N 85.

²⁰⁰⁸ Cf. the concerns of *Schneider*, 277 with regard to the impartiality of such members.

provides for greater flexibility in adapting the number of judges to the actual workload of the court, although the number of legally qualified judges permanently assigned to a Regional Division could only be reduced on a decision of the Presidium of the Court of First Instance with the assent of the Administrative Committee²⁰⁰⁹.

b) Independence and impartiality of judges with a focus on the proposed possible double mandates

The WPL has not yet reached a full agreement as to whether a person could be a member of the EPO Boards of Appeal and a judge of the European Patent Court at the same time²⁰¹⁰.

- First, it was criticised that the members of the EPO Boards of Appeal would not have the necessary knowledge regarding patent infringement and law on damages and that their involvement in the court would cause further delays in the opposition procedures before the EPO²⁰¹¹.

A lack of necessary knowledge of patent infringement and damages could indeed albeit a limited number of candidates, as quite a number of legal members of the EPO Boards of Appeal have already worked as judges and lawyers specialised in patent law prior to their appointment. If a member of the EPO Boards of Appeal intending to become a judge had insufficient experience in patent litigation, but would otherwise qualify for the job, he could always be appointed as "assessor" to the court²⁰¹² in order to gain the necessary experience and knowledge.

- Second, the reluctance of having members of the EPO Boards of Appeal in the court derives from concerns about a lack of independence of the court²⁰¹³ and of the judges²⁰¹⁴,

²⁰⁰⁹ Art. 21(2) draft Statute.

²⁰¹⁰ Cf. explanatory notes, Art. 2 draft Statute.

²⁰¹¹ Cf. *Pagenberg, First Instance*, 487; *Schade, Streitregelungssystem*, 836.

²⁰¹² Cf. §7 B.II.2.f) "Assessor".

²⁰¹³ Cf. also *Charles*, 508-509.

²⁰¹⁴ With regard to the judicial independence in general cf. *Walter H.P., Unabhängigkeit; Wittmann; Faller*.

as it is also noted by the open source movement²⁰¹⁵.

The right to hear a case before an independent and impartial tribunal established by law is guaranteed by Article 6 ECHR²⁰¹⁶ and Article 14 CCPR²⁰¹⁷, which are binding for all EPC contracting states. Independence and impartiality are distinct values²⁰¹⁸, although it is sometimes difficult to draw a clear line between them²⁰¹⁹.

The independence of a court describes, in general, functional and structural safeguards against unrelated intrusion into the administration of justice²⁰²⁰, such as by an executive or legislative body, or by political, economic or social lobby groups²⁰²¹. It refers to the court as such, as well as to the judges²⁰²². They must consequently be free in taking their decisions - in a neutral manner, based on law and conscience -, be self-responsible and without fear of discrimination due to their verdicts²⁰²³. The European Court of Human Rights held that in order to establish whether a tribunal can be considered as "independent" for the purposes of Article 6(1) ECHR, several factors have to be considered, such as the manner of appointment of its members and their term of office, the existence of safeguards against external influence²⁰²⁴, and the question as to whether it presents the appearance of independence²⁰²⁵. The court should therefore be organisationally insulated against political parties and the administration²⁰²⁶.

Additional factors related to internal career management or administration could also have a negative influence on the independence of the judges. The decision to propose a judge for re-appointment is usually based on reports of the judge's personal performance. Negative reports would not only challenge the judge's re-appointment or his career but also have a negative influence on his independence in case they concealed threats if he

²⁰¹⁵ Cf. Commission hearing back patent litigation deal, *Managing Intellectual Property News*, 1 July 2006, <www.managingip.com>.

²⁰¹⁶ Cf. also Art. 47(2) Charter of Fundamental Rights of the European Union.

²⁰¹⁷ Cf. §7 B.III.1. The Convention for the Protection of Human Rights and Fundamental Freedom and the International Covenant on Civil and Political Rights of the United Nations.

²⁰¹⁸ Cf. *Leigh*, 653.

²⁰¹⁹ Cf. *Matscher*, 370.

²⁰²⁰ Cf. *Rädler*, 729.

²⁰²¹ Cf. *Jacot-Guillarmod*, 397; *Haefliger/Schürmann*, 167.

²⁰²² Cf. *Matscher*, 370.

²⁰²³ Cf. *Walter H.P.*, *Unabhängigkeit*, N 1 to N 2.

²⁰²⁴ Cf. also Basic Principles on the Independence of the Judiciary, adopted by the Seventh UN Congress on the Prevention of Crime and the Treatment of Offenders, N 2 and *Jacot-Guillarmod*, 397.

²⁰²⁵ Cf. *Findlay v the United Kingdom*, ECtHR February 25, 1997, Rep. 1997-I 281, N 73.

²⁰²⁶ Cf. *Matscher*, 370.

did not decide disputes in one or the other way²⁰²⁷. A judge concerned would thus have to intervene in such cases.

As the appointments of judges from national courts are not subject to criticism, the major problem seems to be the necessary independent appearance of the European Patent Court if the members of the EPO Boards of Appeal acted as judges for the court. This seems, however, to be objectively unfounded.

The European Patent Court and the EPO Boards of Appeal would be bodies from two different international organisations located in different places. The members of the EPO Boards of Appeal are appointed on the decision of the Administrative Council of the European Patent Organisation, taken on a proposal from the President of the EPO²⁰²⁸. The members of the Administrative Council are representatives from the EPC contracting states. Each contracting state, i.e. each democratically elected government of each contracting state is entitled to appoint one representative and one alternate representative²⁰²⁹.

The judges of the European Patent Court would, however, be appointed by the Administrative Committee of the EPJ, which is composed of representatives from the EPLA contracting states based on a proposal of the Common Presidium of the European Patent Court. The influence of the governments would presumably be greater when appointing the first judges of the European Patent Court, as they would be appointed on a proposal by the governments of the EPLA contracting states²⁰³⁰. Therefore, it would always be up to the committee to decide up on the appointment of the judges and the appointment of members of the EPO Boards of Appeal.

With regard to independence, it is not important as to whether the legislative or the executive body, or the court itself, co-opts the judges²⁰³¹, as long as they are not bound to

²⁰²⁷ Cf. *Schier*, 251; *Walter H.P.*, *Unabhängigkeit*, N 3; N 8; cf. also Basic Principles on the Independence of the Judiciary, adopted by the Seventh UN Congress on the Prevention of Crime and the Treatment of Offenders, N 13.

²⁰²⁸ Art. 11(3) EPC.

²⁰²⁹ Art. 26(1) EPC.

²⁰³⁰ Art. 39 (1) draft Statute.

²⁰³¹ Cf. also *Matscher*, 371.

any instructions²⁰³². However, there seems to be little risk that the EPO Boards of Appeal or the Administrative Council of the European Patent Organisation would interfere with the European Patent Court in order to give binding instructions to the court or put pressure of any kind on the court.

To further underline the importance of independence of the members of the European Patent Court, a separate provision on independence was included into the draft EPLA, as is also the case in the EPC²⁰³³ with regard to the members of the EPO Boards of Appeal.

It is made very clear that in their decisions, the judges of the European Patent Court would not be bound to any instructions and would only have to comply with the law²⁰³⁴. The judges of the European Patent Court would therefore neither be bound to any national judgments, nor to the jurisprudence of the EPO Boards of Appeal.

The independence of the court as such can therefore not simply be disqualified only because members of the EPO Boards of Appeal could simultaneously serve as judges of the European Patent Court²⁰³⁵. Another question is whether the impartiality of the court could be guaranteed by having members of the EPO Boards of Appeal acting in the European Patent Court.

Impartiality, generally speaking relates to an open-mindedness on the part of the judges to both parties²⁰³⁶. According to the case law of the European Court of Human Rights²⁰³⁷, the impartiality of a tribunal for the purposes of Article 6(1) ECHR is being determined on the basis of a subjective and an objective approach:

- First, according to the subjective approach the personal conviction and behaviour of the judge in a given case must be taken into account;

²⁰³² Cf. *Campbell and Fell v The United Kingdom*, ECtHR June 28, 1984, Application No. 7819/77; 7878/77, N 79.

²⁰³³ Art. 23 EPC.

²⁰³⁴ Art. 5 draft EPLA.

²⁰³⁵ The background for questioning this construction seems to be that some technical boards of the EPO rendered judgments that certain stakeholders disliked (cf. Commission hearing back patent litigation deal, *Managing Intellectual Property News*, 1 July 2006, <www.managingip.com>).

²⁰³⁶ Cf. *Rädler*, 729; 730.

²⁰³⁷ Cf. *Wettstein v Switzerland*, ECtHR December 21, 2000, Application No. 33958/96, N 42; *Thomann v Switzerland*, ECtHR June 10, 1996, Rep. 1996-III 815, N 30.

- second, according to the objective approach it must be considered whether the court provided sufficient guarantees excluding any legitimate doubt in this respect.

As to the subjective approach, the personal impartiality of a judge is to be presumed until there is proof to the contrary²⁰³⁸.

With regard to the objective test, it must be determined whether, quite apart from the judge's conduct, there are ascertainable facts which may give reason to doubt his impartiality. In this respect, even the appearance may be of a certain importance. What is at stake is the confidence which the courts in a democratic society must inspire in the public²⁰³⁹. This implies that in deciding whether there is a legitimate reason to fear that a particular judge lacks impartiality in a given case, the standpoint of the person concerned is important but not decisive. What is decisive is whether this concern can be held to be objectively justified²⁰⁴⁰.

With regard to the concern as to the impartiality of judges who are also members of the EPO Boards of Appeal, it is suggested to exclude the latter from such cases that have already been dealt with by the EPO Boards of Appeal. It should be noted, however, that the European Court of Human Rights held that even if a trial judge has also dealt with a case at the pre-trial stage, this could not be held as justifying concerns as to his impartiality on its own²⁰⁴¹.

The independence and impartiality of the European Patent Court's judges would furthermore be safeguarded by several provisions in the draft EPLA and draft Statute. Most of them had also been implemented into the Statute of the COPAC²⁰⁴².

On the one hand, there are the rules with regard to the appointment of the judges²⁰⁴³ and their removal from office²⁰⁴⁴, which should ensure the necessary independence. On the other hand, judges of the European Patent Court would not be allowed to pursue any other

²⁰³⁸ Cf. *De Cubber v Belgium*, ECtHR October 26, 1984, Ser. A No. 86, N 25.

²⁰³⁹ Cf. *Castillo Algar v Spain*, ECtHR October 28, 1998, Rep. 1998-VIII 3116, N 45.

²⁰⁴⁰ Cf. *Ferrantelli and Santangelo v Italy*, ECtHR August 7, 1996, Rep. 1996-III 951-52, N 58.

²⁰⁴¹ Cf. *Bulut v Austria*, ECtHR February 22, 1996, Rep. 1996-II, N 33.

²⁰⁴² Cf. in particular Arts. 2-5 and 11 Protocol on the Statute of the Common Appeal Court.

²⁰⁴³ Cf. §7 B.II.2.d) Appointment of the judges.

²⁰⁴⁴ Cf. §7 B.II.2.e) End of term of office and removal from Office.

activities for remuneration - apart from the possibility of also being employed at national courts, the EPO Boards of Appeal or national patent offices -, unless otherwise authorised by the Executive Committee²⁰⁴⁵. Providing the Executive Committee with this authority and not the Administrative Committee, as it was first proposed²⁰⁴⁶, further promotes the independence of the European Patent Court. The possibility that judges could occupy any political or administrative office would be excluded²⁰⁴⁷.

Impartiality of the judges should be assured in the European Patent Court by the following rules:

- First, all judges have to take an oath²⁰⁴⁸ and face the legal consequences in case they would not perform the duties impartially and conscientiously. Being impartial is therefore an obligation for each judge appointed to the European Patent Court and not a right²⁰⁴⁹.
- Second, a judge or "assessor" could not take part in the hearings of any case in which he had previously taken part as adviser, acted for one of the parties²⁰⁵⁰, or was called upon to pronounce as a member of a court, tribunal or board of appeal, of a commission of inquiry or in any other capacity²⁰⁵¹.

As a further substantiation of Article 6(1) ECHR it is made clear in the draft Statute that a judge or "assessor"²⁰⁵² is always deemed biased, if he falls under one of these three categories.

But also a judge could feel that he should not sit on a particular case or that the President of the responsible court should - due to exceptional circumstances - consider the assignment of the case to a different judge. In the latter case, the President would notify the judge or "assessor" accordingly²⁰⁵³. The final decision on impartiality would be taken

²⁰⁴⁵ Art. 6(1) draft Statute.

²⁰⁴⁶ Cf. *Willems*, 1st proposal, Art. I.5.3.1.10.

²⁰⁴⁷ Art. 6(1) draft Statute.

²⁰⁴⁸ Art. 5 draft Statute.

²⁰⁴⁹ Cf. also *Wittmann*, 365; *Walter H.P.*, *Unabhängigkeit*, N 9.

²⁰⁵⁰ Cf. also *Villiger*, N 417.

²⁰⁵¹ Art. 10(1) draft Statute.

²⁰⁵² The provision on impartiality is also applied to "assessors" as they might partake in the deliberations and assist the rapporteur (cf. explanatory notes to Art. 11(1) WPL/SUB 2/02).

²⁰⁵³ Art. 10(2) draft Statute.

by a panel of the court in which the judge or "assessor" is active without his participation²⁰⁵⁴. This would avoid a judge declaring himself as biased too prematurely, as a rash conclusion in this regard could also be an infringement of the right to an independent and impartial judge²⁰⁵⁵. The jurisprudence of the European Court of Human Rights would certainly be the guideline for such a decision.

It goes without saying that the impartiality question could also be raised by a party of the proceedings²⁰⁵⁶. But, as mentioned earlier, there must be an objectively justified apprehension of a judge lacking the necessary impartiality in order for him to be removed from the panel.

c) *Legally and technically qualified judges*

The WPL sub-group shared the view²⁰⁵⁷ that the European Patent Court should comprise both legally and technically qualified judges. Initially, it was questioned whether technical judges had the necessary procedural expertise²⁰⁵⁸, not least as regards infringement cases, or whether it would be better to appoint experts from the best and most up-to-date institutions²⁰⁵⁹. The WPL agreed to appoint technical judges to the court²⁰⁶⁰.

In fact, many states²⁰⁶¹ had good experiences with the cooperation between technically and legally qualified judges on the panel in patent infringement and revocation proceedings, as it generally improved speed, quality²⁰⁶² and efficiency of the proceedings²⁰⁶³, and to a certain extent rendered court appointment of experts unnecessary²⁰⁶⁴. It should, however, be noted that many national courts, such as the

²⁰⁵⁴ Art. 10(4) draft Statute.

²⁰⁵⁵ Cf. Müller, *Grundrechte*, 576.

²⁰⁵⁶ Art. 10(3) draft Statute

²⁰⁵⁷ Cf. Rau, 242; Sedemund-Treiber, *Technischer Richter*, 1010; Boval, *Remarques*, 162; Brinkhof, *Schlichtung*, 603; Landfermann, *Diskussionen*, 115-116; Schade, *Regelung*, 107; v. Raden, 437; Holzer, *Proceedings*, 211; Gesthuysen, 335-337; König, *Richter*, 347-349; Beyer.

²⁰⁵⁸ Cf. Leith, *Revision*, 251.

²⁰⁵⁹ Cf. Pagenberg, *First Instance*, 488.

²⁰⁶⁰ Cf. also Schade, *Protocol*, 170.

²⁰⁶¹ For an overview cf. Sedemund-Treiber, *Technischer Richter*, 1007-1008. Cf. also Ryberg, 909-910.

²⁰⁶² Cf. Vogel, 187; v. Raden, 432; Beyer, 331; Brunner A., 429.

²⁰⁶³ Cf. Rogge, *Zuständigkeit*, 652; Brunner, *Patentnichtigkeit*, 26; Sedemund-Treiber, *Technischer Richter*, 1008; 1009; Keussen, 214; Holzer, *Proceedings*, 212; v. Raden, 432, 437.

²⁰⁶⁴ Cf. Vogel, 186; Gesthuysen, 338.

courts dealing with patent infringements in Germany²⁰⁶⁵ or the courts in the Netherlands²⁰⁶⁶ or the United Kingdom²⁰⁶⁷ render high quality judgment decisions without having any technical judges on the bench²⁰⁶⁸.

A technical judge is a person that is a general expert in a certain technical field²⁰⁶⁹, a professionally technically versed judge²⁰⁷⁰. Technical members of the EPO Boards of Appeal²⁰⁷¹, patent attorneys²⁰⁷² or former patent examiners²⁰⁷³ could, for example, qualify for this job. But in order to be appointed to the European Patent Court, a technical judge should also have basic expertise in patent law, as it was criticised that not all technical judges sitting on panels of national courts could always provide the required legal knowledge²⁰⁷⁴.

The principle function of a technical judge is to translate technical matters to his colleagues²⁰⁷⁵ and to point out possible technical pitfalls²⁰⁷⁶ in order to ensure that the entire panel understands correctly and quickly the relevant technical facts of the case²⁰⁷⁷.

As a judge he would partake in the decisions of the European Patent Court. The legally qualified judges would also have to make sure that the technically qualified judge understands possible complicated legal questions at stake²⁰⁷⁸. The position of the technical judge is, then, different from that of an expert²⁰⁷⁹, who is a specialist in a very limited field and who is appointed to answer highly specific technical questions²⁰⁸⁰.

²⁰⁶⁵ Cf. §2 C.I Courts of first instance and §2 C.II. Courts of further instance.

²⁰⁶⁶ Cf. *v. Nispen*, N 7-11.

²⁰⁶⁷ Cf. *Campbell*, N 1-03.

²⁰⁶⁸ Cf. *Stauder, Aspekte*, 622-623.

²⁰⁶⁹ Cf. *Vogel*, 185.

²⁰⁷⁰ Cf. *Holzer, Representation*, 96; *Brunner A.*, 428.

²⁰⁷¹ Cf. *Keussen*, 214.

²⁰⁷² Cf. *Rau*, 243; *Vogel*, 185; *Holzer, Representation*, 95.

²⁰⁷³ Cf. *Sedemund-Treiber, Technischer Richter*, 1008; *v. Raden*, 432.

²⁰⁷⁴ Cf. *Brunner, Patentnichtigkeit*, 26; Gramm Werner, *Probleme des Rechtsuchenden vor den Gerichten des Gewerblichen Rechtsschutzes*, 1981 GRUR INT., 465-469, 468.

²⁰⁷⁵ Cf. *Holzer, Representation*, 96; cf. however, *König, Richter*, 347.

²⁰⁷⁶ Cf. *Willems, 3rd proposal*, 44.

²⁰⁷⁷ Cf. *Sedemund-Treiber, Technischer Richter*, 1008; *Brunner, Verwertung*, 22.

²⁰⁷⁸ *Vogel*, 186-188 stresses that the symbiosis of technicians and jurists on the panel requires that the different members have to convince each other of their particular views on the case. This would also imply that the technical judges could follow their different view if the legal judges were unable to present persuasive arguments.

²⁰⁷⁹ With regard to the differentiation between judge and expert also cf. *Zürcher*, N 19.91 to N 19.93.

²⁰⁸⁰ Cf. *Brunner Eugène, Der Sachverständige im Patentprozess aus Schweizerischer Sicht*, 1987 GRUR INT., 481-483, 482; *Sedemund-Treiber, Technischer Richter*, 1009.

Therefore, the European Patent Court should be able to appoint experts if this was considered necessary.

It goes without saying that the technical judge would have to sit in cases of "his" technical field. It would hardly make sense if a biochemist would have to decide on the infringement of a patent related to telecommunication technology²⁰⁸¹.

The definition of the relevant technical fields to which the technical judges would be appointed²⁰⁸² is still open and will not be an easy task: should too many fields be defined, the technical judge would become a technical expert as the degree of specialisation would increase. However, if few fields were chosen, certain fields would not be dealt with sufficiently.

Currently the EPO has 24 technical chambers: seven for mechanics, three for physics, ten for chemistry and four for electricity. Such a distinction would, however, go too far for normal technical judges sitting in a civil court.

In its proposal for a Community Patent Court the European Commission, therefore, recommended to classify an "Assistant Rapporteur" into one of seven technical fields in order to provide for the necessary technical expertise of a general category:

- inorganic chemistry and materials science,
- organic and polymer chemistry,
- biochemistry and biotechnology,
- general physics,
- mechanical engineering,
- information and communication technology, and
- electrical engineering²⁰⁸³.

²⁰⁸¹ Cf. also *Boval, Remarques*, 161; *Sedemund-Treiber, Technischer Richter*, 1009.

²⁰⁸² Art. 4(2) draft Statute.

²⁰⁸³ Cf. CP Court proposal, 17

d) *Appointment of the judges*

In accordance with equivalent regulations of most international courts²⁰⁸⁴, the judges of the European Patent Court would be appointed on a proposal from the Common Presidium²⁰⁸⁵ by the Administrative Committee with a simple majority²⁰⁸⁶, as legally or technically qualified judges for a term of six years²⁰⁸⁷. Members in the Administrative Committee would have no right to make proposals. The judges could be re-appointed again on a proposal from the Common Presidium²⁰⁸⁸.

The authority of the Administrative Committee to appoint and re-appoint judges - as well as the Registrar²⁰⁸⁹ - could be problematic with regard to the requirement of Article 6(1) ECHR and Article 14(1) CCPR to establish a court which is independent.

As mentioned above²⁰⁹⁰, the European Court of Human Rights held that the independence of a court must be determined based on the manner of appointment of its members and their term of office *inter alia*, the existence of safeguards against outside pressures and the question as to whether the body presents an appearance of independence²⁰⁹¹. The approach of the UN Human Rights Committee is very similar.

It held that independence of the court and impartiality are particularly important with regard to the manner in which the judges are appointed, the qualifications for appointment, and the duration of their terms, transfer and cessation of functions, as well as their actual independence from the executive and the legislative branches²⁰⁹². *Ad hoc* appointments are problematic with regard to the independence of a court and the term of office²⁰⁹³. Abstract periods of terms of office which would ensure the necessary independence of a

²⁰⁸⁴ Cf. *Willems*, 1st proposal, 20.

²⁰⁸⁵ Art. 4(1) draft Statute.

²⁰⁸⁶ Art. 18(4) draft EPLA.

²⁰⁸⁷ The same period of office was also suggested for COPAC (cf. Art. 6(2) CP Protocol on Litigation).

²⁰⁸⁸ Art. 18(2) draft Statute.

²⁰⁸⁹ Art. 17(3) draft EPLA.

²⁰⁹⁰ Cf. §7 B.II.2.b) Independence and impartiality of judges with a focus on the proposed possible double mandates.

²⁰⁹¹ Cf. *Findlay v The United Kingdom*, ECtHR February 25, 1997, Rep. 1997-I 281, § 73.

²⁰⁹² Cf. CCPR General Comment No. 13: Equality before the courts and the right to a fair and public hearing by an independent court established by law (Art. 14): 13/04/84; N 3.

²⁰⁹³ Cf. *Rädler*, 738.

court can not, however, be set²⁰⁹⁴. What is important is that the term ensures a certain stability²⁰⁹⁵.

A period of six years as suggested by the WPL seems to serve this goal. It would therefore provide a sufficient safeguard for the court's independence, as long as the judge could only be removed from office²⁰⁹⁶ during the term in the most exceptional circumstances²⁰⁹⁷ and as long as a re-appointment was not linked to the jurisprudence of the judge concerned.

Any court's independence would seem endangered if politics or the strongly related opinion of the public could directly interfere with the jurisprudence and possibly exclude certain judges from re-appointment because they rendered controversial judgments²⁰⁹⁸. The judges could no longer enjoy functional independence from the body that nominated them²⁰⁹⁹.

Certainly the law to which any judge is bound²¹⁰⁰ could be changed in a way that limits the possibilities for its interpretation. But this would have to be done by the legislator. The fact that the Administrative Committee could only re-appoint and appoint judges who were proposed by the Common Presidium, which would be a court internal unit enjoying judicial independence²¹⁰¹, should essentially discard possible concerns about interference in the re-appointment²¹⁰².

But there could be problems with regard to the independence of the court, especially with the proposal for the first appointment of judges.

As mentioned above, the first judges would be appointed by the Administrative Council based on proposals made by the governments of the EPLA contracting states²¹⁰³. At least

²⁰⁹⁴ Cf. *Rädler*, 743.

²⁰⁹⁵ Cf. *Matscher*, 372.

²⁰⁹⁶ Cf. §7 B.II.2.e) End of term of office and removal from Office.

²⁰⁹⁷ Cf. *Campbell and Fell v The United Kingdom*, ECtHR June 28, 1984, Application No. 7819/77; 7878/77, N 80.

²⁰⁹⁸ Cf. *Walter H.P., Unabhängigkeit*, N 29 to N 31; cf. also *Faller*, 87-96.

²⁰⁹⁹ Cf. *Rädler*, 740.

²¹⁰⁰ Cf. also *Guldener*, § 1, III., 1.

²¹⁰¹ Art. 5 draft EPLA.

²¹⁰² Cf. also *Rädler*, 740.

²¹⁰³ Art. 39(1) draft Statute.

one legally qualified judge or "assessor" and technically judge (or "assessor") from each EPLA contracting state would be appointed to the Court of First Instance of the Court of Appeal²¹⁰⁴. One can, however, hardly argue that a court or certain judges are in general not independent or impartial because they have been appointed by representatives from EPLA contracting states based on a proposal by one or more governments²¹⁰⁵. The question rather raises whether such appointments would ensure the necessary quality of the court²¹⁰⁶.

The appointing decision of a judge would state the court and the fields of technology for which a technically qualified judge would be appointed²¹⁰⁷. The latter was introduced to ensure that technical judges decide upon cases in their field²¹⁰⁸. One might, however, wonder whether such a provision is really necessary, as it would seem common sense that a judge with a chemical background would not sit in a case about electricity.

The initial proposal that judges could be active in both instances was rejected by several delegations of the WPL sub-group based on constitutional or other fundamental judicial concerns. From a more practical point of view it was, however, agreed that it was advantageous to be able to appoint judges for both instances, at least for the court system's start-up phase particularly in order to ensure the proper functioning of the court. Consequently, it was decided to transfer the provision to the transitional arrangements²¹⁰⁹.

Article 40(1) draft Statute provides that during the first seven calendar years after the Statute has entered into force, judges could be members of both the Court of First Instance and the Court of Appeal at the same time, if this was necessary in order to staff the European Patent Court with judges having sufficient experience in patent law. A majority of two-thirds of the votes of the represented EPLA contracting states, and voting in the Administrative Committee would be required for appointing judges as members of both instances. This transitional period could only be extended by unanimous decision²¹¹⁰.

²¹⁰⁴ Art. 39(2) draft Statute.

²¹⁰⁵ Cf. also *Matscher*, 371; *Rädler*, 738-740; *Villiger*, N 417; with regard to political appointments cf. also *Schier*, 252-254.

²¹⁰⁶ Cf. also *Landfermann*, *Litigation*, 244.

²¹⁰⁷ Art. 4(2) draft Statute.

²¹⁰⁸ *Willems*, 1st proposal, 21.

²¹⁰⁹ Cf. WPL/SUB 22/01, N 76; WPL/SUB 32/01, N 23 to N 24.

²¹¹⁰ Art. 40(2) draft Statute.

The provision is consequently elaborated as a safety net if the workload in the initial phase would become unmanageable for the court. This situation seems rather unlikely, however, as the initial workload of the European Patent Court should be limited²¹¹¹.

e) End of term and removal from office

The term of office of a judge would be terminated on the last day of the month in which he reaches his seventieth birthday, when the period of his appointment ends, if he resigns, if he is removed from office, or on his death²¹¹².

The retirement age was chosen rather arbitrarily, but it was fixed relatively high in order to expand the pool of possible candidates to be appointed²¹¹³. The retirement age could be changed by decision of the Administrative Committee. In order to guarantee the necessary independence of the judges, any such change would only affect judges appointed for the first time after that decision²¹¹⁴.

A judge could not be removed from office during the term of his appointment, unless he no longer meets the obligations arising from his office and if the Administrative Committee, on a proposal from a three-quarters majority of the Common Presidium, takes a decision to that effect²¹¹⁵. The procedure to this end would be initiated by the Executive Committee in accordance with the Service Regulations²¹¹⁶.

This rule makes it clear that a judge is in principle not removable from office during his term of office and fulfils the requirements of Article 6(1) ECHR as the irremovability of judges is considered by the European Court of Human Rights as a necessary corollary of the court's independence²¹¹⁷.

²¹¹¹ Cf. §7 B.II.1.a)bb)aaa)ii) Potential reasons that support a common second instance.

²¹¹² Art. 7(1) draft Statute.

²¹¹³ Cf. *Willems*, 3rd proposal, 45.

²¹¹⁴ Art. 7(2) draft Statute.

²¹¹⁵ Art. 8(1) draft Statute.

²¹¹⁶ Art. 8(2) draft Statute.

²¹¹⁷ Cf. *Campbell and Fell v The United Kingdom*, ECtHR June 28, 1984, Application No. 7819/77; 7878/77, N 80.

f) "Assessor"

A person wishing to become a judge but lacking the necessary experience in patent law could be appointed as a so-called "assessor", provided he fulfils the other requirements for office²¹¹⁸. The goal of this construction is to provide a system that gives a person a chance to gain the required knowledge and serve as a legally or technically qualified judge for the court.

There are several training possibilities which can be adapted to the needs of the person to be trained: An assessor could, for example, be appointed as a supernumerary member of a panel. He could, furthermore, partake in deliberations and could assist the "judge rapporteur" (the judge preparing the case for hearing). As a trainee, he would have no vote and would be bound to confidentiality regarding the deliberations²¹¹⁹.

The "assessor" system would, thus, make it possible for those EPC contracting states to participate in the court and the development of jurisprudence from the beginning, which are unable to send persons to the European Patent Court directly qualifying as judges²¹²⁰.

The "assessor" would be appointed to the court by the Administrative Committee on a proposal from a government of an EPLA contracting state²¹²¹. He could be appointed for a term of up to six years. A re-appointment would not be possible. The decision on whether the "assessor" could be appointed as a judge would be up for decision to the Administrative Committee on a proposal of the Common Presidium. The regular rules on the appointment of a judge would also be applicable with regard to "assessors". This should guarantee the required quality of the judges and at the same time prevent persons from being automatically appointed to the court who have proved in up to six years less qualified in patent law. However, it is to be expected that the Common Presidium would usually propose an "assessor" to be appointed to the court. The appointment of "assessor" would be terminated on the date on which he would be appointed to the European Patent

²¹¹⁸ Art. 9(1) draft Statute.

²¹¹⁹ Art. 9(3) draft Statute.

²¹²⁰ Cf. *Structure paper*, 2000 Bijblad bij de Industriële Eigendom, 267; 2000 IIC, 576; 2000 EIPR, S-8.

²¹²¹ Art. 9(2) draft Statute.

Court as a judge²¹²².

g) Assignment of the judges to the different divisions of the Court of First Instance

aa) Legally qualified judges

The rules on the assignment of the legally qualified judges to the different divisions are a compromise between the initial proposal to choose all the judges from a common pool²¹²³ and have them rotating among the different divisions, and the proposal to establish national courts with national judges in first instance.

The WPL sub-group in the end generally shared the opinion that a certain continuity in the different divisions would better ensure the predictability of decisions, consistent case law and a high standard of quality. It was thus decided that the decision to set up a Regional Division would also have to specify the maximum number of legally qualified judges to be permanently assigned to it²¹²⁴. The Presidium of the Court of First Instance would have to decide on the exact number of legally qualified judges to be permanently assigned to each Regional Division²¹²⁵ and on the persons to be assigned to the individual division as a permanent member²¹²⁶. The authority of the Presidium of the Court of First Instance to decide upon the necessary number of judges to be assigned to a certain Regional Division and to assign them to a certain division should ensure the necessary flexibility and the impartiality of the judges²¹²⁷.

As noted above, the assignment would strongly depend on the language skills of the judges²¹²⁸. In addition, it would have to be accepted by the judge concerned²¹²⁹. The necessary approval of the assignment should be somehow protect the judges from being permanently appointed to a Regional Division in which they would not wish to work.

²¹²² Art. 9(2) draft Statute.

²¹²³ Cf. *Willems, First instance*, 397.

²¹²⁴ Art. 21(1) draft Statute.

²¹²⁵ Art. 21(2) draft Statute.

²¹²⁶ Art. 23(1) draft Statute.

²¹²⁷ Cf. *Willems, 3^d proposal*, 48.

²¹²⁸ Cf. §7 B.II.2.a) Requirements for office.

²¹²⁹ Art. 23(1) draft Statute.

It could, however, also involve the risk that not enough judges could be assigned to a certain division. It is unclear what the consequences would be if such a scenario became reality.

A way out could be the assignment of certain judges to such a division on a case by case basis for an interim period, particularly since a permanent assignment to a certain division would not exclude that a judge would be also active in a different division from time to time. If the number of permanently appointed judges was to be reduced below the original number determined in the decision to set up a Regional Division, the Presidium of the Court of First Instance would need the approval of the Administrative Committee²¹³⁰. The judges not permanently assigned to a certain Regional Division, or not accepting such assignment would be permanently assigned to the Central Division.

The exact number of judges to be assigned to the different divisions of the European Patent Court would have to be decided on the basis of the most recent workloads of the different national courts dealing with European patents. It was estimated that a legally qualified judge should be able to deal with about 25 cases per year²¹³¹.

As the Court of Appeal would have no Regional Divisions all the judges would be assigned to the court.

aaa) Timely limited assignment of legally qualified judges to the Central Division

A coherent organisation can only be build up if the judges communicate with each other and feel part of one court. This becomes even more important if a system is built up with divisions all over the European continent many kilometres away from each other.

It is thus suggested in the draft Statute that legally qualified judges of Regional Divisions could be assigned to the Central Division for a period of at least six months²¹³². The judge would, however, again have to agree to such a decision taken by the Presidium of the

²¹³⁰ Art. 21(2) draft Statute.

²¹³¹ Cf. WPL/4/03, 17.

²¹³² Art. 25(1) draft Statute.

Court of First Instance, which would initially have to hear the judges of the Regional Division concerned²¹³³.

Whether such an optional approach would attract a sufficient number of judges who would be ready to work for half a year for the Central Division, is open to debate. But in any case it seems necessary that the judges should regularly meet to exchange views in order to create the required common identity of the court. This could further be supported if judges were regularly active in several Regional Divisions.

bb) Technically qualified judges

The technically qualified judges would only be active in their respective technical fields. The judges are assigned on a case by case basis from a "pool" of technically qualified judges. Formally, they would be permanently assigned to the Central Division²¹³⁴. The technical judges would, thus, have to travel regularly among the different Regional Divisions²¹³⁵.

3. Composition of the panels

Towards the end of discussions on the structure of the European Patent Court the delegations supported the view that the future European Patent Litigation System should use, on the one hand, the experience and expertise of the existing national courts, and, on the other hand, guarantee that this expertise would spread to other judges in order to mix the different legal cultures and views ensure international unification²¹³⁶.

One of the essential elements was consequently the agreement on the minimal standard to compose the panels of each division internationally with technical and legally qualified judges.

²¹³³ Art. 25(2) draft Statute.

²¹³⁴ Art. 23(2) draft Statute.

²¹³⁵ This would thus also imply travelling expenses, cf. however, *Pagenberg, Patent*, 538.

²¹³⁶ Cf. *Willems, 3rd proposal*, 22.

The exact number of judges sitting on the panel was, however, left to each Regional Division²¹³⁷, as some delegations insisted on having panels with more than three judges whereas the majority wanted small panels for reasons of efficiency and availability of judges with the required expertise. Some delegations also wished that costs of the composition of the panels should be split up among the EPLA contracting states based on the "polluter pays" principle²¹³⁸. The WPL agreed on the following basic requirements to be fulfilled by all divisions:

It goes without saying that the Court of First Instance would sit in panels comprising an odd number of judges. At least one of them would have to be a technically qualified, and at least two would have to be legally qualified judges. The legally qualified judges would have to come from different countries²¹³⁹.

One of them would have to act as a rapporteur and the one as chairman. There would consequently never be the same person preparing the case and acting as chairman, as most delegations felt that placing these functions on one person would create an over-concentration of powers that could question the necessary impartiality of the court²¹⁴⁰.

Additionally, the rapporteur should be a legally qualified judge, as the instruction phase of a case is of greatest importance in proceedings and thus be great responsibility of that person²¹⁴¹. The chairman could, however, appoint another (technical) member as co-rapporteur at any stage of the proceedings, if the nature of the case required so²¹⁴². This could be necessary, for example, if complicated technical questions arose during the instruction phase and a technical judge would support the legally qualified judge²¹⁴³. The panels would, therefore, be composed of at least three judges, unless the Rules of Procedure stated otherwise. The Rules of Procedure could for example allow that a single judge could reject clearly inadmissible actions²¹⁴⁴. For efficiency reasons, it was decided by the WPL that the judge who heard a witness in a provisional hearing could be appointed as member of the panel, as he would be probably more familiar with the case.

²¹³⁷ Art. 26(4) draft Statute.

²¹³⁸ Cf. WPL/SUB 7/03, N 31 to N 32.

²¹³⁹ Art. 26(1) draft Statute.

²¹⁴⁰ Cf. WPL/SUB 22/01, N 62 and N 66.

²¹⁴¹ Cf. *Willems*, 3rd proposal, 53.

²¹⁴² Art. 26(2) draft Statute.

²¹⁴³ Cf. *Willems*, 3rd proposal, 53

²¹⁴⁴ Cf. explanatory notes, Art. 26 draft Statute.

As the Regional Divisions themselves decide about the number of judges sitting on the panel, it could also be possible that the legally qualified judges are the minority on the panel²¹⁴⁵.

Each division of the Court of First instance would have to compose its panels in accordance with the rules laid down by the Presidium of the Court²¹⁴⁶. This would exclude an arbitrary composition of the panels²¹⁴⁷. The minimum standard of at least two legally qualified judges - each of them from a different state - and one technical judge who perform their duties in the designated language(s) of proceedings of the division would be the basis for these rules. In addition, the technically qualified judge would have to come from the technical field at stake.

The requirement to legally pre-determine the composition of the panel rather than to appoint judges on a case by case basis²¹⁴⁸ was very important to Germany. The proposed provision could, therefore, take into proper account its constitutional principle of "*der gesetzliche Richter*"²¹⁴⁹, and make sure that at the beginning of the court year a system would be designed²¹⁵⁰ which would guarantee the necessary predictability and continuity in a panel's composition²¹⁵¹.

The composition of the panels of the Court of Appeal would be realised along the lines of the Court of First Instance²¹⁵².

²¹⁴⁵ Cf. *Rau*, 243 who pleads for a majority of legally qualified judges on the panel in order to guarantee a uniform jurisprudence.

²¹⁴⁶ Cf. also Basic Principles on the Independence of the Judiciary, adopted by the Seventh UN Congress on the Prevention of Crime and the Treatment of Offenders, N 14 which holds that the assignment of cases to judges within the court to which they belong is an internal matter of judicial administration.

²¹⁴⁷ Art. 26(4) draft Statute.

²¹⁴⁸ With regard to possible limits of predetermined systems, cf. *Walter H.P., Unabhängigkeit*, N 17.

²¹⁴⁹ Cf. for example Koch Harald, *Rechtsvergleichende Fragen zum „Gesetzlichen Richter“*, Festschrift für Hideo Nakamura zum 70. Geburtstag am 2. März 1996, Heldrich Andreas/Uchida Takeyoshi (eds.), Tokyo 1996, 281-300; Träger Ernst, *Der gesetzliche Richter*, Festschrift für Wolfgang Zeidler, Fürst Walther/Herzog Roman/Umbach Dieter C. (eds.), Band 1, Berlin et al. 1987, 123-145. Cf. in that regard also the so called "*Listensystem*" of the German "*Bundespatentgericht*" in *Schneider*, 150.

²¹⁵⁰ Cf. also *Casalonga, Le contentieux futur*, 257.

²¹⁵¹ Cf. WPL/SUB 22/01, N 65.

²¹⁵² Art. 27(1) draft Statute.

III. Does the structure of the European Patent Judiciary fulfil the obligations under general international treaties?

The EPC contracting states and potential contracting states of the EPLA are all parties of the Council of Europe and the WTO. The European Patent Judiciary must consequently respect the obligations of the Convention for the Protection of Human Rights and Fundamental Freedom and the TRIPS Agreement. In addition, all EPC contracting states acceded or ratified the International Covenant on Civil and Political Rights of the United Nations (CCPR). It will, therefore, also have to be examined whether the EPLA is compatible with this agreement.

One could argue that the European Patent Judiciary is not bound by the obligations of these international treaties as long as it does not accede to them or to the respective organisations. However, as the potential contracting states of the EPLA are bound by it and as they would transfer their sovereignty rights with regard to the jurisdiction of European patent litigation to the European Patent Judiciary and the European Patent Court, they would also have to ensure that the judiciary complies with these standards.

1. The Convention for the Protection of Human Rights and Fundamental Freedom and the International Covenant on Civil and Political Rights of the United Nations

On the one hand, Article 6(1) ECHR provides *inter alia* that in the determination of his civil rights and obligations, everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal established by law. On the other hand, Article 14 CCPR aims to ensure the proper administration of justice, and to this end includes a series of individual rights such as equality before the courts and tribunals and the right to a fair and public hearing by a competent, independent and impartial tribunal established by law²¹⁵³. The goal of the two provisions is obviously very similar.

The European Court of Human Rights derived from Article 6(1) ECHR the basic right of "access to a court", i.e. the right to judicial proceedings which fulfil all the conditions of

²¹⁵³ See CCPR General Comment No. 13: Equality before the courts and the right to a fair and public hearing by an independent court established by law (Art. 14): 13/04/84; N 1.

Article 6(1) ECHR²¹⁵⁴, including the "right to a court"²¹⁵⁵ - the possibility to actually contact a court²¹⁵⁶ -. However, it neither includes the right to appeal a judgment nor that several instances must hear the case²¹⁵⁷. Article 14(1) CCPR seems to be less strict and simply requires a guaranteed equal access to courts²¹⁵⁸.

The provisions' impact on the structure of the European Patent Court is the institutional requirement for an independent and impartial tribunal in civil right disputes which is established by law.

The European Court of Human Rights has never clearly defined the term "civil rights and obligations"²¹⁵⁹. Nevertheless, it held that a "civil right" is given if the subject-matter is "pecuniary" in nature and the action was founded on an alleged infringement of rights, which were likewise pecuniary rights²¹⁶⁰. According to the court's case-law, Article 6(1) ECHR applies only to "disputes" over "civil rights and obligations" which can be said, at least on arguable grounds, to be recognised under domestic law²¹⁶¹. The expression "disputes over civil rights and obligations" covers all proceedings the result of which is directly decisive for such rights and obligations²¹⁶². It may concern both questions of facts and law. "Dispute" may relate not only to the actual existence of a right but also to its scope or the manner in which it may be exercised.

It seems clear that Article 6(1) ECHR also covers patent right disputes²¹⁶³.

The same can be concluded out of Article 14(1) CCPR which provides that it should be applicable in the determination of a persons rights and obligations in a lawsuit. The

²¹⁵⁴ Cf. also *v. Dijk*, 351-353.

²¹⁵⁵ Cf. *Golder v The United Kingdom*, ECtHR February 21, 1975, Series A No. 18, § 35.

²¹⁵⁶ Cf. *Haefliger/Schürmann*, 162.

²¹⁵⁷ Cf. *Hangartner*, 134.

²¹⁵⁸ Cf. CCPR General Comment No. 13: Equality before the courts and the right to a fair and public hearing by an independent court established by law (Art. 14): 13/04/84, N 3.

²¹⁵⁹ Cf. *Hangartner*, 133; *v. Dijk*, 351.

²¹⁶⁰ Cf. *Edition périscope v FR*, ECtHR March 26, 1992, Series A No. 234-B, § 40.

²¹⁶¹ Cf. *Pudas v Sweden*, ECtHR October 27, 1987, No. 125-A, § 30.

²¹⁶² Cf. *Pudas v Sweden*, ECtHR October 27, 1987, No. 125-A, § 31; cf. also *v. Dijk*, 351-360.

²¹⁶³ Cf. *British-American Tobacco Company Ltd v the Netherlands*, ECtHR November 20, 1995, Series A No. 331 wherein the ECtHR decided that Art. 6(1) ECHR applies if an application for a patent had been rejected by the competent national authority.

responsible UN Human Rights Committee, furthermore, held that this provision is also applicable to all specialised courts²¹⁶⁴.

With the term "tribunal established by law", the European Court of Human Rights refers to bodies with certain common fundamental features, the most important of which are independence and impartiality, and the guarantees of judicial procedure²¹⁶⁵. Such bodies must be established by law, i.e. by a general and abstract provision²¹⁶⁶, and have jurisdiction with regard to clearly defined civil cases²¹⁶⁷.

Very similar are the obligations under Article 14(1) CCPR. The Human Rights Committee clarified in that regard that the contracting states should specify constitutional and legislative texts which provide for the establishment of the courts²¹⁶⁸ and ensure that these are independent²¹⁶⁹, impartial and competent²¹⁷⁰.

The organisational structure of the European Patent Jurisdiction as defined in the draft EPLA and draft Statute, as well as the clearly defined jurisdiction of the court would fulfil these basic requirements of the ECHR and CCPR. The requirement on independence and impartiality in particular relates to the judges, a point which has already been examined above²¹⁷¹.

²¹⁶⁴ Cf. CCPR General Comment No. 13: Equality before the courts and the right to a fair and public hearing by an independent court established by law (Art. 14): 13/04/84; N 4.

²¹⁶⁵ Cf. *Jacot-Guillarmod*, 397.

²¹⁶⁶ Cf. *Matscher*, 368.

²¹⁶⁷ Cf. *Haefliger/Schürmann*, 158; *Matscher*, 379.

²¹⁶⁸ The Human Rights Committee also held that specialised courts can fulfil the required standards (cf. CCPR General Comment No. 13: Equality before the courts and the right to a fair and public hearing by an independent court established by law (Art. 14): 13/04/84; N 4).

²¹⁶⁹ Cf. also Basic Principles on the Independence of the Judiciary, adopted by the Seventh UN Congress on the Prevention of Crime and the Treatment of Offenders.

²¹⁷⁰ Cf. CCPR General Comment No. 13: Equality before the courts and the right to a fair and public hearing by an independent court established by law (Art. 14): 13/04/84; N 3.

²¹⁷¹ Cf. §7 B.II.2.b) Independence and impartiality of judges with a focus on the proposed possible double mandates.

2. TRIPs Agreement

There are several provisions in the TRIPs Agreement which require the possibility of a judicial review with regard to judgments on patents²¹⁷².

The obligations with regard to the enforcement of IPRs are determined by part III of the TRIPs Agreement. The duties are, however, clearly limited to the procedure and remedies²¹⁷³. Generally, the parties must have an opportunity for review by a judicial authority of final administrative decisions and, subject to jurisdictional provisions in a WTO member's law concerning the importance of a case, of at least the legal aspects of initial judicial decisions on the merits of the case²¹⁷⁴.

There are no special requirements set by the TRIPs Agreement with regard to the judicial organisation and structure²¹⁷⁵: According to paragraph 5 of Article 41, the part on enforcement of the TRIPs Agreement does not create any obligation to put into place a judicial system for the enforcement of IPRs, any different from that for the enforcement of law in general. Nor does it create any obligation with respect to the distribution of resources between the enforcement of IPRs and the enforcement of law in general.

This provision was in fact one of the stumbling blocks during the negotiations for the TRIPs Agreement. On the one hand, the necessary resource allocation had to be guaranteed as this is often a problem in practice²¹⁷⁶. On the other hand, many developing countries preferred a provision which took into account their limited capacities²¹⁷⁷ and strived to avoid having to establish a special system to enforce IPRs²¹⁷⁸.

3. Further rights in the Charter of Fundamental Rights of the European Union

a) History and development of the Charter of Fundamental Rights of the European Union

In 1999 it was decided by the EU Council to establish a Charter of Fundamental Rights of

²¹⁷² Cf. for example Arts. 31(j) and 32 TRIPs Agreement.

²¹⁷³ Cf. §6 D.I. Introduction.

²¹⁷⁴ Art. 41 (4) TRIPs Agreement.

²¹⁷⁵ Cf. *Stahelin*, 180; *Haas F.-W.*, 154.

²¹⁷⁶ Cf. *Cottier*, 411.

²¹⁷⁷ Cf. *Dreier*, 261; *Woolridge*, 220.

²¹⁷⁸ Cf. *Gervais*, N 2.375.

the European Union including basic procedural rights guaranteed by the European Convention for the Protection of Human Rights and Fundamental Freedoms derived from the constitutional traditions common to the EU member states²¹⁷⁹. In just one year the responsible body concluded its work and adopted the draft²¹⁸⁰. At the following Nice summit in 2000, the draft was solemnly proclaimed²¹⁸¹ and it was declared that the EU Council would like to see the charter disseminated as widely as possible amongst the EU's citizens. The question of the charter's effect was, however, left open²¹⁸². It was therefore not included into the Nice Treaty.

The reasons were manifold: There were doubts as to the necessity for another human rights charter next to the ECHR and fears of substantive²¹⁸³ and judicial conflicts between the ECJ and the European Court of Human Rights²¹⁸⁴. In addition, the charter was obviously also regarded as a historical step towards a constitutionalist and federalist EU, which was not supported by all EU member states²¹⁸⁵.

It was, nevertheless, questioned as to whether the promulgated charter would still have any legal effect²¹⁸⁶, and, if so, to what extent. This was not least the case because EU institutions made some positive statements in that regard and because several advocate generals referred to the charter in some of their opinions in 2001²¹⁸⁷.

In the following discussions on the Treaty establishing a Constitution for Europe it was decided that the Charter of Fundamental Rights as part II in the draft treaty be implemented. This political decision seems to imply that the charter had a certain relevance²¹⁸⁸, but no binding legal effect on the EU member states²¹⁸⁹, especially since the Treaty establishing a Constitution for Europe had not entered into force.

²¹⁷⁹ Cf. Presidency Conclusions, Cologne European Council, 3 and 4 June 1999, Annex IV.

²¹⁸⁰ Cf. *Dagtolou*, 570.

²¹⁸¹ Cf. *Stein*, 1425; *Dagtolou*, 570.

²¹⁸² Cf. Presidency Conclusions, Nice European Council, 7 - 10 December 2000, N 2.

²¹⁸³ Cf. *Rengeling*, 232-237.

²¹⁸⁴ Cf. in that regard also *McCrudden*, 17-18; *Stein*, 1428.

²¹⁸⁵ Cf. *Dagtolou*, 571.

²¹⁸⁶ Cf. *Dutheil de la Rochère*, 3-12; *Rengeling*, 228; *Stein*, 1432-1434; cf. also European Commission on the Charter of Fundamental Rights of the European Union of the European Union, COM(2000) 559 final.

²¹⁸⁷ Cf. *Molthagen*, 13-14, 17; *Dutheil de la Rochère*, 5-8; *Dagtolou*, 572; *McCrudden*, 11.

²¹⁸⁸ Cf. *Molthagen*, 16.

²¹⁸⁹ The ECJ seemed to refuse to render normative character to the charter, cf. *Unión de Pequeños Agricultores v EU Council*, ECJ July 25, 2002 (case 50/00), N 45, cf. also in that regard Frangakis Nikos, Human Rights and European Integration, From the European Convention on Human Rights to the Charter of Fundamental Rights of the European Union of the European Union, *Mélanges en hommage à Jean-Victor Louis*, vol. I, Bruxelles 2003, 189-201, 197.

After the negative referenda in France and the Netherlands on the "Constitution" that prevented its entry into force, it was decided in Lisbon in December 2007 to amend the EU and EC treaties by a "Reform Treaty" (Treaty of Lisbon), to unhook the charter of fundamental rights and to make it clear *inter alia* that it has legally binding force²¹⁹⁰. Poland and the United Kingdom would, however, only be bound by the charter as far as the states have provided for the charter's rights in its national law²¹⁹¹.

b) Impact on the structure of the European Patent Court

First of all, it is important to note that it was declared by the Conference of the representatives of the governments of the EU member states in Lisbon²¹⁹² that the Charter of Fundamental Rights confirms the fundamental rights guaranteed by the ECHR and as they result from the constitutional traditions common to the EU member states. The provision in the charter do consequently not provide for less rights than what are already guaranteed by the ECHR. The EU member states also noted that there will be a regular dialogue between the ECJ and the European Court of Human Rights²¹⁹³.

With regard to the structure of a European Patent Court, Article 47 Charter of Fundamental Rights will be of special importance. Paragraph 2 stipulates that everyone is entitled to a fair and public hearing within a reasonable time by an independent and impartial tribunal previously established by law. In contrast to Article 6(1) ECHR the provision seems not to be limited to proceedings determining civil rights and obligations²¹⁹⁴. Whether it really has a broader effect will, however, have to be clarified by the ECJ.

²¹⁹⁰ Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon, 13.12.2007, Final Act, Declaration concerning the Charter of Fundamental Rights of the European Union of the European Union.

²¹⁹¹ Cf. Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon, 13.12.2007, Protocol on the application of the Charter of Fundamental Rights of the European Union of the European Union to Poland and the United Kingdom.

²¹⁹² Cf. Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon, 13.12.2007, Final Act, Declaration concerning the Charter of Fundamental Rights of the European Union of the European Union.

²¹⁹³ Cf. Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon, 13.12.2007, Final Act, Declaration on Article 6(2) of the Treaty on European Union.

²¹⁹⁴ Cf. *Molthagen*, 49.

C. Excursus: Relationship of the European Patent Litigation Agreement with the Hague Convention on Choice of Court Agreements

I. Introduction

In 1992 and after it became clear that the first such convention adopted by the Hague Conference on Private International Law²¹⁹⁵ would not come into effect²¹⁹⁶, the USA initiated work on a world-wide convention on the recognition and enforcement of foreign judgements in civil and commercial matters. The initiative was inspired by the hope to facilitate recognition and enforcement of judgments of US courts abroad²¹⁹⁷, and improve predictability in enforcement. Recognition and enforcement practice were to be clarified and simplified²¹⁹⁸. At the same time, the use of exorbitant jurisdictional grounds against persons not domiciled in one of the contracting states of the Lugano and Brussels Conventions was seen as problematic from a constitutional point of view²¹⁹⁹.

The Hague conference responded positively to the initiative of the US and it was decided at the 17th session to place the matter on the agenda for future work by the conference²²⁰⁰.

A special commission prepared in five meetings a preliminary draft for a Hague Jurisdiction Convention, which was then presented to a Diplomatic session to be held in two parts. The first one was held in June 2001. The differing interests and views, mainly between the European states and the US, not least with regard to intellectual property²²⁰¹, made it impossible to reach the necessary consensus in due time. It was decided to

²¹⁹⁵ The Hague Convention of 1 February 1971, on the Recognition and Enforcement of Foreign Judgements in Civil and Commercial Matters; for an overview, cf. Coester-Waltjen Dagmar, *Die Anerkennung gerichtlicher Entscheidungen in den Haager Übereinkommen*, 1993 RABELSZ, 263-302, 284-289.

²¹⁹⁶ Cf. *Jametti Greiner/Bucher*, 58; *Walter/Walther*, 39.

²¹⁹⁷ Cf. *Barbosa*, 730-731; Hague Conference on Private International Law, U.S. State Department Collects Views To Evaluate Hague Treaty Draft, 07/03 WIPR, 21-22, 21. With regard to the recognition of US Judgments in Europe cf. *Blumer, Jurisdiction*, 383-386.

²¹⁹⁸ Cf. *v. Mehren*, 455.

²¹⁹⁹ Cf. *Jametti Greiner/Bucher*, 58; *v. Mehren*, 454.

²²⁰⁰ Cf. *Jametti Greiner/Bucher*, 61.

²²⁰¹ Cf. *Kur, Hague*; Baumgartner Samuel P., *The Proposed Hague Convention on Jurisdiction and Foreign Judgments*, Tübingen 2003, 6-8; von Mehren Arthur T., *The Hague Jurisdiction and Enforcement Convention Project Faces an Impasse – A Diagnosis and Guidelines for a Cure*, 2000 IPRax, 465-468; Hess Burkhard, *Steht das geplante weltweite Zuständigkeits- und Vollstreckungsübereinkommen vor dem Aus?*, 2000 IPRax 342-343.

postpone the second part of the Diplomatic session until a way could be found to address critical issues and ensuring the successful conclusion of the negotiations²²⁰².

The discussions that followed showed that for the time being a convention on choice-of-court clauses seemed to have the highest chances of realisation²²⁰³. A proposal prepared by an informal working group²²⁰⁴ was finally submitted to the special commission in December 2003²²⁰⁵. The discussions continued in 2004 until the draft was ready to be submitted to a Diplomatic session in June 2005. The new Hague Convention on Choice of Court Agreements (HCC) was adopted by the member states of the Hague Conference on Private International law on 30 June 2005²²⁰⁶.

Although the convention has not yet entered into force, it will be interesting to study what the impact of the convention on the EPLA will be.

II. Regulation of the Hague Convention on Choice of Court Agreements

Article 26 HCC deals with the relationship of the convention to other international instruments. Paragraph 5 is applicable with regard to treaties which, in relation to a specific matter, govern jurisdiction or the recognition or enforcement of judgments. Based on this provision, such treaties always prevail over the HCC, regardless of whether they were concluded before or after the HCC and even if all states concerned are parties to the HCC.

However, this precedence of special treaties over the HCC only applies if the HCC contracting state has made a declaration in respect of the treaty concerned. If such a

²²⁰² Cf. McClean David, *The Hague Conference's Judgments Project, Reform and development of private international law, Essays in honor of Sir Peter North, Fawcett James (ed.)*, Oxford 2002, 255-271, 266.

²²⁰³ Cf. Preliminary, Doc. No. 8 (corrected) of March 2003, 3; Schulz Andrea, Report on the second meeting of the informal working group on the judgment project – January 6-9, 2003, Preliminary Document No. 21 of January 2003, 4.

²²⁰⁴ Cf. *Schulz*, 6.

²²⁰⁵ Cf. Work. Doc. No 49 E, Revised.

²²⁰⁶ For the agreement and its contents cf. Dogauchi Masato/Hartley Trevor C., Explanatory report of the Convention of 20 June 2005 on Choice of Court Agreements, Hague Conference on Private International Law, <www.hcch.net/upload/expl37e.pdf>. For a summary of the content of the convention in general, cf. *Schulz*, and with a special eye on IP rights cf. Luginbühl Stefan/Wollgast Heike, *Das neue Haager Übereinkommen über Gerichtsstandsvereinbarungen: Aussichten für das Geistige Eigentum*, GRUR Int. 2006, 208-220; Buri Ueli, *Haager Konferenz für Internationales Privatrecht: (Haager-)Übereinkommen vom 30. Juni 2005 betreffend Gerichtsstandsvereinbarungen*, 2006 sic!, 301-304.

declaration has been made, other contracting states will *"not be obliged to apply the convention to that specific matter in respect of any inconsistency, where an exclusive choice of court agreement designates the courts, or one or more specific courts, of the [HCC] contracting state that has made the declaration"*²²⁰⁷.

By virtue of this rule, the EPLA would prevail over the HCC. The precedence of the EPLA, as with any other treaty on special matters, is welcomed as it lays down more precise rules and provides for very specific solutions which serve the users of the patent system.

With EPLA precedence, the European Patent Court as a chosen court in a choice of court agreement could not only give a judgment on an infringement action of a European patent that involves no breach of a contract, but could also decide on a counterclaim for revocation of the patent²²⁰⁸. This would not be possible if the HCC prevailed, as choice of court agreements directed to both such actions are excluded from the scope of the convention²²⁰⁹.

D. Conclusion with regard to proposed structure of the European Patent Court and its influence on creating a uniform jurisprudence, solving the problems of *forum shopping*, and avoiding multiple litigation

The sub-group of the Working Party on Litigation had intensive discussions as to how to possibly ensure a uniform jurisprudence. It became quickly apparent that the qualification of the judges and their way of cooperation would be decisive. The group therefore agreed upon a system in which the existent functioning structures would basically be transferred to a European system. It added some elements which should ensure that national courts would not just become European courts over night, but that quality would be ensured by establishing Regional Divisions which would be composed of judges with sufficient knowledge and expertise in patent litigation and that a true mixture of views and legal traditions would lead to a unification of the existing different jurisprudences in Europe.

²²⁰⁷ Art. 26(5) HCC.

²²⁰⁸ Art. 41(1)(d) draft EPLA.

²²⁰⁹ Art. 2(2)(n) HCC.

Under the proposed European patent litigation system judges are encouraged to communicate, co-operate with each other. They will have to depart from their own legal systems and policy environment and find ways to bring together divergent views in an objective way and within the borders of the law set by the legislator. The crucial element would be the international composition of the court panels. But just as important will be the representation of the different European legal cultures on the panel. This could prevent judges in the Court of First Instance from sticking to national views, possibly resulting in diverging results of the panels or divisions in similar matters at stake. The judges would thus also have to communicate among the different divisions. In any case, they will be fully aware of their responsibility to reach a congruent jurisprudence and a uniform interpretation of European patent law.

Possible differences in the jurisprudence of the Regional Divisions of the Court of First Instance would be eliminated by the Courts of Appeal. It is, however, unlikely that those differences would be more significant than they are today in big European countries among courts sharing the jurisdiction or in countries with different traditions.

The unification would not only be limited to European patent litigation in the states participating in the EPLA. On the one hand, the jurisprudence would also have an impact on national patent law as the judges of the European Patent Court could simultaneously work in national courts or in patent offices. They could bring "European thinking" to the national courts. In addition, it would enable the states in which courts are rather inexperienced in patent litigation to gain expertise²²¹⁰. But the EPLA would also have a harmonisation effect outside the EPLA area, as judges from non-EPLA states could possibly be appointed to the court. This construction would probably have a more positive effect on the unification of jurisprudence than the proposed Facultative Advisory Council²²¹¹, which national courts could ask for non-binding opinions on questions of law. The fact that judges from EPC contracting states - which are not necessarily EPLA contracting states - could participate in the court, could motivate these states to join the EPLA later on. It would be an appropriate *développement à deux vitesses* of the European

²²¹⁰ Cf. Assessment of the impact of the European patent litigation agreement (EPLA) on litigation of European patents, EPO acting as secretariat of the Working Party on Litigation, February 2006, 8, available at <www.epo.org/patents/law/legislative-initiatives/epla/assessment.html>.

²²¹¹ Cf. §6 C.III.3. Can the Facultative Advisory Council unify the jurisprudence?.

patent system²²¹² towards a uniform interpretation of European patent law.

Nevertheless, multiple litigation concerning European patents and the problems with regard to *forum shopping*²²¹³ can not be entirely solved by the EPLA, as long as it is optional and applicable only on some of the EPC contracting states. However, if France, Germany, the United Kingdom and the Netherlands joined the EPLA, the vast majority of litigation concerning European patents today would be transferred to that court²²¹⁴.

Furthermore, the EPLA could work as a catalyst for an EU-wide solution²²¹⁵ after non-EPLA states are convinced of its advantages.

Another advantage of the optional approach is that European states that are ready for further harmonisation and unification can take the next step and test the system while discussions among the EU member states and the exploration of EU specific solutions are in progress. It is clearly more promising to proceed with a comprehensive solution among the interested states than involving all EPC contracting states (or EU member states) and risk that no instrument or a weak instrument is put in place that would no longer fulfil the expectations for a high quality court ensuring a uniform interpretation of European patent law and promoting legal certainty.

Inside the EPLA area the problems related to multiple litigation and cross-border jurisprudence could certainly be avoided. The problems related to *forum shopping*, however, could still exist as long as the different divisions of the Court of First Instance are not all arranged in the same way. There will consequently be some kind of competition among the divisions.

On the one hand, not all divisions would provide for the same languages of proceedings. On the other hand, judges would develop their own certain way of handling a case, as they do in any national court. As the judges would be permanently assigned to a certain division, the plaintiff might want to choose one or the other divisions to deliberate upon his

²²¹² Cf. *Grossenbacher*, 141-144.

²²¹³ Cf. *Oser*, 531; 540.

²²¹⁴ Cf. Assessment of the impact of the European patent litigation agreement (EPLA) on litigation of European patents, EPO acting as secretariat of the Working Party on Litigation, February 2006, Annex 1, N 2, available at <www.epo.org/patents/law/legislative-initiatives/epla/assessment.html>.

²²¹⁵ Cf. also *Charles*, 520.

case. These issues will, however, have no impact on the establishment of a unified jurisprudence.

The proposed European Patent Court and its structure would solve a great part of the current problems with regard to litigation of European patents. An important factor will, however, also be the creation of rules that provide for efficient and cost effective procedures before the court²²¹⁶.

E. Alternative ways forward with regard to the basic structure of the European Patent Court

I. The creation of a community jurisdiction for European and Community patents

One alternative on a possible way forward with regard to the creation of a European patent jurisdictional system was outlined by France²²¹⁷ and was included in the Communication on the enhancement of the patent system in Europe as option two²²¹⁸: The creation of a community jurisdiction for both European and Community patents.

The goal of this proposal would be to set up a unified court structure which would have the competence to deal with litigation on both European and future Community patents. It would be necessary to create a specific Community jurisdiction making use of the jurisdictional arrangements in the EC Treaty. The EU member states and other EPC contracting states interested in joining the system would confer competence on the Community judicature over European patents by way of an international agreement. Such transfer of jurisdiction should guarantee respect of the principles of the Community legal order in litigation relating to the validity and infringement of European patents and future Community patents.

²²¹⁶ See also principles relating to the rules of procedure of the European court as approved by the European patent judges, Second Venice Resolution, 4 November 2006, available at <<http://www.eplaw.org/Resolutions.asp>> and 2007 IIC, 826-833. See also Feldges Joachim, Die Durchsetzung von Patenten in europäischen Streitigkeiten, Festschrift für Tilman Schilling, Grosch Marcus/Ullmann Eike (eds.), Köln et al. 2007, 111-123, 114-123.

²²¹⁷ France: Why we oppose the EPLA, Managing Intellectual Property News, 1 January 2007, <www.managingip.com>; Entretien avec Marc Guillaume et Jean-Claude Magendie, Gazette du palais, mercredi 20, jeudi 21 décembre 2006; *Pagenberg, Another*, 810.

²²¹⁸ Cf. §7 A.III. The third phase.

The first instance court - established on the basis of Article 225a EC Treaty - would be composed of specialised divisions, using national structures. The ECJ Court of First Instance would act as the appeal instance. There should be uniform rules of procedure and the Community judges should apply Community law and the EPC.

1. Analysis

The current proposal is only available in a broad outline²²¹⁹ but it is highly questionable as to whether Articles 225a and 229a EC Treaty could be used as the legal basis for the creation of Community Patent Court dealing with European patents²²²⁰. It is clear that Article 225a EC Treaty was not included in the EC Treaty in order to provide the ECJ with new competences. A revision of the EC Treaty would be necessary in order to realise this proposal. However, at the Brussels European Council of 21/22 June 2007, it was decided that Article 229a (the extension of ECJ jurisdiction on disputes relating to European intellectual property rights) would remain unchanged in the new Treaty of Lisbon²²²¹.

Additionally, it is unclear whether EU member states could transfer sovereignty rights to the EC by means of an international agreement, i.e. outside the ordinary Community treaty framework and provide the ECJ with additional tasks not foreseen in the EC Treaty²²²², such as to deal with disputes on European patents between private parties. This could be qualified as a circumvention of the rights and obligations of the Community treaties.

One might also wonder whether there would be the necessary political will of EU member states for such an approach so short after a negative decision of the Council to transfer additional competence to the EC.

²²¹⁹ Cf. also *Pagenberg, Another*, 810-811; 819.

²²²⁰ Cf. Structural provisions in the draft Community Patent Regulation and the related draft proposals, legal basis.

²²²¹ Cf. Council of the European Union, Brussels European Council, 21/22 June 2007, Presidency Conclusions, Doc. 11177/1/07, Rev. 1, 22.

²²²² See *Lenaerts*, who makes it clear that by virtue of the principle of conferred or attributed competences, the ECJ exercises only the jurisdiction conferred on it by the Treaties (Lenaerts Koen, *The rule of law and the coherence of the judicial system of the European Union*, 2007 CML REV., 1625-1659, 1625).

EU member states obviously were also concerned that procedures under the heading of the ECJ would turn out to be inefficient and inadequate. It was furthermore questioned whether it would be possible to appoint technically educated judges with no full legal qualifications²²²³.

II. "Integrated approach"

Based on the fact that the EPLA is discussed within the EU implies that EC has some competence in the area covered by the EPLA²²²⁴. This understanding seems to be correct as the EPLA includes measures also covered in the Enforcement Directive. It is consequently necessary to provide the EC with a mandate to enter into negotiations on the EPLA²²²⁵. However, neither the EPLA option nor option two are supported by the necessary majority of EU member states²²²⁶.

In order to reach a possible compromise, the European Commission offered an outline of a third option²²²⁷: The integrated approach combined features of both the EPLA and a Community patent jurisdiction.

The principle goal would be to establish a patent litigation system which would not require a separate jurisdiction for future Community patents - as the European Patent Court established under the EPLA would only deal with litigation concerning European patents.

²²²³ Communication from the Commission to the European Parliament and the Council of 3.4.2007 - Enhancing the patent system in Europe, COM(2007) 165 final, 10.

²²²⁴ Cf. also *Fröhlinger*, 82.

²²²⁵ Tilmann takes the view that the mixed competence with regard to negotiations on the EPLA implies an accession of the EC to the EPC (*Tilmann, Neue*, 825). However, such an accession is not necessary as the EPLA would be a self-contained agreement which would not change the existing structures and powers of the European patent granting system, as governed by the EPC. Furthermore, the scope of current Community legislation in the patent field affecting the grant phase (for example the Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions, 1998 O.J. EC, L 213, 30 July 1998) is limited (cf. also *Liedl*, 313).

²²²⁶ It was also suggested to delete all provisions in the EPLA which might be considered inimical to the uniform application of Community rules in order to resolve the impasse (cf. *Arnulf/Jacob*, 214.)

²²²⁷ Communication from the Commission to the European Parliament and the Council of 3.4.2007 - Enhancing the patent system in Europe, COM(2007) 165 final, 10-11.

The Commission suggested that a system under the "integrated approach" would be strongly inspired by the EPLA model, in particular as regards the specific characteristics of patent litigation, but would allow for harmonious integration in the Community jurisdiction:

- A limited number of first instance chambers as an integrated part of a single jurisdictional system and centralised appeal court working under common rules of procedure;
- the creation of a registry allocating cases to the different chambers on the basis of clearly defined and transparent rules;
- the patent jurisdiction should comprise both legally and technically qualified judges, who should enjoy full judicial independence;
- the patent jurisdiction must respect the ECJ as the final arbiter in matters of EU law, including questions related to the *acquis communautaire* and to the validity of future Community patents.

This option of the European Commission's communication is currently being intensively discussed within the European Union.

1. Analysis

The final option does not reach far beyond a general list of principles and implies a mere repetition of the discussions on principles already elaborated within the EU on the Community patent jurisdiction and within the Working Party on Litigation on the EPLA. The differences of this option to the proposal for an EPLA as such are not very clear²²²⁸ but the suggested structure of the EPLA would quite obviously serve as basis for the compromise solution. One might wonder, however, whether the states interested in a litigation system under the EPLA would want to take the EPLA model as a starting point for negotiations within the EU. For many of them the EPLA will already be a compromise solution providing the borderline of which is politically and substantially acceptable. It will be difficult to

²²²⁸ Cf. also *Pagenberg, Another*, 812.

defend this borderline as all EU member states with all kind of different interests are involved in these negotiations.

III. Conclusion and possible way forward

Options two and three of the Communication are addressing one issue which should obviously be avoided: The creation of two patent jurisdiction systems, one dealing with European patents and another one dealing with community patents.

The European Commission suggests the creation of a system allowing for harmonious integration in the Community jurisdiction. *Scordamaglia* stresses that the Commission's view on such integration would clearly be different from the simple creation of a judicial panel within the ECJ Court of First Instance²²²⁹. It would have to respect the ECJ as the final arbiter in matters of EU law, including questions related to the *acquis communautaire* and to the validity of future Community patents.

It seems clear that a system should be created which solves the current problems, i.e. the problems with regard to European patent litigation. The fastest way forward would clearly be the realisation of the EPLA, if necessary with certain changes. Only an optional system, which may be set in motion by a limited number of interested states, could be implemented in a medium or short term. If all EU member states accepted to join the EPLA, it could very much also have been possible to reach agreement on the Community patent²²³⁰.

However, it seems that the EPLA could not be realised by way of enhanced cooperation²²³¹, as it was suggested²²³². Such cooperation is only possible in areas referred to in the EC Treaty provided it remains within the limits of powers of the Union²²³³. However, in particular the second option of the communication makes it clear that the EC has no powers with regard to litigation concerning European patents.

²²²⁹ Cf. *Scordamaglia Vincenzo*, Contribution au débat sur le système de résolution des litiges en matière de brevets en Europe, 2007 juillet/août propr. industr., 8-12, 10.

²²³⁰ Cf. also *Ullrich, National*, 21.

²²³¹ Cf. Arts. 11 and 11a EC Treaty; Arts. 43-45 EU Treaty; see also *Schneider*, 323-325.

²²³² Cf. *Willems, Trojan Horse*, 336-337; *Tilmann, Neue*, 825.

²²³³ Art. 11(1) EC Treaty, Art. 43(d) EU Treaty. This will remain unchanged with the revised EC Treaty (in the future "Treaty on the Functioning of the European Union" (cf. new Art. 280D(1)).

Furthermore, for the time being, full integration of the EPLA into the Community jurisdictional system is not a workable solution due to the inherent tension between the European bundle patent which is based on an Intergovernmental treaty and the Community framework.

The EPO in a brainstorming exercise developed an informal proposal on a possible way forward which takes into account the concerns leading to options two and three: The so-called "Transfer Solution".

The proposal includes the creation of three basic instruments to be negotiated between interested EPC contracting states and the European Commission:

- "The EPLA as it is";
- "Protocol on compliance with the Community legal order";
- "Protocol on Transfer".

To enter into force, all instruments would be subjected to accession by the European Community, and ratified by the EPLA contracting states.

The "Protocol on compliance with the Community legal order" would reinforce the existing guarantees in the draft EPLA regarding compliance with the Community legal order, i.e. the supremacy of Community law²²³⁴, requests for preliminary rulings of the ECJ²²³⁵, the binding effect of ECJ case law on the EPLA court²²³⁶ and a fast-track revision of the EPLA with a view to align it with new Community legislation²²³⁷.

By the new "Protocol on Transfer", the EPLA contracting states would commit themselves to transfer the EPLA court into the future Community patent litigation system to be established on the basis of the EC Treaty. The task entrusted by the EPLA contracting states to the EPLA court, i.e. the litigation of European patents, should be taken over by

²²³⁴ Articles 38 and 39 draft EPLA.

²²³⁵ Article 40(1) draft EPLA.

²²³⁶ Article 40(2) draft EPLA.

²²³⁷ Cf. Article 33 (1)b) EPC.

the Community patent court, once it was established. The EPLA court would consequently cease to exist as a separate court but would deal with European patent litigation as an integrated part of the Community patent court.

The desire for quickly establishing a European patent court dealing with the many European patents granted to date could consequently be reconciled with the desire to prepare for the long term "communitarisation" of patent litigation in Europe. Additionally, the creation of the Community patent and the Community patent court as a final goal is made explicit by setting up the EPLA court. Furthermore, a period of transition is provided for, during which the EPLA court could gather experience so that an experienced court would be available as soon as Community patents were granted.

It is a clear that also this approach would require a revision of the EC Treaty in order to provide the ECJ with the authority to deal with European patents. A possible change could be realised together with the necessary ratification related to the creation of the community patent court based on Articles 225a and 229a EC Treaty.

§8 THE COMMUNITY PATENT COURT BASED ON THE PROPOSALS FOR A COMMUNITY PATENT REGULATION AND RELATED INSTRUMENTS

A. History and development

The lack of success in realising a Community patent with the CPC²²³⁸ left a remarkable gap in the European patent system and the single market for the Community²²³⁹. The European Commission therefore took a new initiative to create a Community patent.

On the one hand, intellectual property had, in the mean time, become an internal economic policy issue because of the adoption of the TRIPs Agreement, and on the other hand, it was re-discovered as an instrument of innovation policy²²⁴⁰.

In the action plan for innovation in Europe in 1996, the Commission announced that it would prepare a Green Paper in 1997 on the issue of the Community patent and the patent system in Europe. The European Commission had already at that time made it clear that the CPC was no longer relevant to the changing requirements and the construction of Europe²²⁴¹.

Similar the history of the EPLA, this new approach for a Community patent could be split into three periods, the last one also with an open end.

I. The first phase

The European Commission published the Green Paper with a questionnaire on the European patent system only half a year after its announcement²²⁴².

The paper had the objective to outline the situation concerning the protection of innovation by the patent system in the Community and to examine whether new measures would be

²²³⁸ §1 C. The Intergovernmental Conference of 1989 and 1991.

²²³⁹ Cf. *Leardini*, 324; 325-326.

²²⁴⁰ Cf. *Ullrich, Integrating*, 10.

²²⁴¹ Cf. The First action Plan for Innovation in Europe of 20.11.1996, COM(1996) 589 final, 34.

²²⁴² Cf. *CP Green Paper*.

necessary, and what these new measures could involve and what form they could take²²⁴³.

The final goal of the Commission was to gather information on the actual needs of the interested circles by way of a comprehensive survey, not least find out the standpoint of the member states and assess whether a new Community initiative could successfully be concluded²²⁴⁴.

First, it asked whether the CPC should be converted to a Community Regulation, since it had become clear that the Community was competent to take action in the field of patents if that would contribute to the achievement of one of the objectives of the EC Treaty, i.e. either the free movement of goods or a system ensuring that competition was not distorted²²⁴⁵. Additionally, it prompted stakeholders to give their views with regard to the translation requirements of the CPC²²⁴⁶ and the related high costs. But it certainly also wanted to tackle the disadvantages of the CPC judicial arrangements²²⁴⁷. The European Commission made clear, however, that it would not be possible to create new courts under legal arrangements not covered by the EC Treaty. The setting up of a COPAC would therefore be excluded²²⁴⁸.

Two proposals were considered in the Green Paper:

- First, the jurisdiction with regard to counterclaims for revocation of Community patents would be transferred to the exclusive jurisdiction of a new revocation division to be set up within the EPO. The national courts would have had jurisdiction with regard to infringement actions, actions for a declaration of non-infringement and all actions in respect of the use made of the invention prior to publication of the mention of the grant of the Community patent²²⁴⁹. In case of a revocation action during infringement proceedings, the national court would have to stay proceedings until the EPO's revocation division would have decided up on the revocation. Appeals against the decision by the revocation divisions could be brought before the ECJ Court of First Instance.

²²⁴³ Cf. *CP Green Paper*, 4.

²²⁴⁴ Cf. *Leardini*, 325.

²²⁴⁵ Cf. *CP Green Paper*, 3.

²²⁴⁶ Cf. §1 E.III. The language provisions.

²²⁴⁷ Cf. §1 E.II. The jurisdictional arrangements.

²²⁴⁸ Cf. *CP Green Paper*, 12.

²²⁴⁹ Cf. *CP Green Paper*, 10.

This proposal would be a simple nullity solution²²⁵⁰, i.e. there would only be the jurisdiction with regard to nullity of Community patents at the Community level. Infringement proceedings would be regulated at the national level. Revocation and infringement proceedings would then again be separated²²⁵¹. This was, however, one of the reasons why the CPC 1975 litigation proceedings were criticised as being inefficient²²⁵². But there was also some reaction, particularly from Germany who supported the proposal²²⁵³ because it strongly resembled the system of split proceedings at the national level²²⁵⁴.

It was also discussed as to whether the EPO Opposition Divisions should be maintained if a division for revocations was created. Furthermore, it was requested that such a revocation division would be staffed by judges as it would be doing judicial work²²⁵⁵.

The proposal by the European Commission made it clear that it intended to integrate the EPO into the EU structures²²⁵⁶, as it also held that

*"questions to do with the validity and revocation of Community patents could no longer be decided by national courts, but only by bodies operating at the Community level"*²²⁵⁷.

- Second, a national court to which an action for infringement had been brought could also decide on a counterclaim for revocation. Its decision on the counterclaim would, however, affect the Community patent only in the EU member state in which the court was located. An exception could be considered in cases in which an action for infringement was brought before a court in the EU member state of the alleged infringer's domicile and related to infringements in another member state²²⁵⁸.

²²⁵⁰ Cf. *Sedemund-Treiber, Strukturen*, 122.

²²⁵¹ Cf. also *Tilmann, Patentschutzsystem*, 325-326.

²²⁵² Cf. §1 D.I. Aims and development.

²²⁵³ Cf. *Tilmann, Patentschutzsystem*, 327; Deutsche Vereinigung für gewerblichen Rechtsschutz und Urheberrecht (GRUR), Stellungnahme zum Grünbuch der EU-Kommission zum Gemeinschaftspatent und Patentschutzsystem in Deutschland, GRUR 1998, 120.

²²⁵⁴ Cf. §2 C.I.1. Split proceedings ("bifurcation").

²²⁵⁵ Cf. *Willems, Blueprint*, 10.

²²⁵⁶ Cf. also *Schäfers, Anmerkungen*, 821-822.

²²⁵⁷ See *CP Green Paper*, 11.

²²⁵⁸ Cf. *CP Green Paper*, 12.

This approach was closer to the final CPC construction²²⁵⁹. The limited effect of a revocation decision of a national court would have tackled one of the strongest *points of critique* with regard to the CPC judicial arrangements and would have been a compromise for the lacking common appeal court²²⁶⁰. However, it could have led to a Community patent which would have had effect only in some of the member states. This approach would consequently speak against the essential feature of a patent with a unitary character and an equal effect throughout the territory of the Community²²⁶¹.

The results of the survey²²⁶² showed support for the creation of a Community patent alongside the existing European and national patent. However, the cost and judicial arrangements of a Community patent would have to be attractive.

With regard to the judicial arrangements the answers went beyond the two proposals made by the European Commission²²⁶³: There was roughly an equal split between the wish for a common EU court at first instance and nationally designated Community patent courts at the national level. Emphasis was put on having judges who were experienced in patent matters. There was also an overall agreement that validity and infringement should be litigated in the same proceedings - thus excluding the EPO in the revocation procedure - and that there should be a common court of appeal of first instance decisions, possibly established within the ECJ Court of First Instance. Some stakeholders also suggested a further appeal to the European Court of Justice limited, however, to questions of law.

The survey, furthermore, underlined that the Community patent should be unitary, i.e. that a court decision on the revocation of a Community patent should have a Community-wide effect.

With regard to the translations, the majority of the responses were of the opinion that there should either be no translation or only a limited translation.

²²⁵⁹ Cf. *CP Green Paper*, 12.

²²⁶⁰ Cf. critics of *Sedemund-Treiber, Strukturen*, 123.

²²⁶¹ Cf. *Schneider*, 227.

²²⁶² Cf. CA/117/98 (Report on responses to the European Commission Green Paper on Promoting Innovation Through Patents).

²²⁶³ Cf. *Straus, Glimmer*, 421.

Most stakeholders were not interested in what institutional means would be used in realising the Community patent, and it seemed that associating the EPO more closely with the EU was generally regarded favourably²²⁶⁴.

Following the consultation process of the Green Paper, which included a hearing of the users of the patent system and a meeting of experts from the EU member states²²⁶⁵, the European Commission issued a follow-up with a communication paper in early 1999²²⁶⁶. It declared the Community patent as a new priority that should be introduced in the form of a Community Regulation based on Article 308 EC Treaty²²⁶⁷.

The approach to create an EC Regulation was not least taken because the CPC would, as an international agreement, not be subject to control and amendment by normal Community legal mechanism²²⁶⁸. The European Commission had already stressed at earlier occasions that the creation of such a regulation would need unanimity in the Council²²⁶⁹.

The Commission furthermore declared that the nature of the Community patent must be unitary, and that the Community patent must be affordable, guarantee legal certainty and coexist with the existing patent systems²²⁷⁰. With regard to the judicial arrangements it suggested to reduce as much as possible the number of national courts competent to deal with the issues of infringement and validity, as well as provisional injunctions valid across the entire Community. The best solution would be to entrust competence with regard to Community patents to one court per member state.

In an action plan the European Commission announced that it would present a draft Regulation aimed at creating a Community patent²²⁷¹. At the famous European Council in Lisbon on 23 and 24 March 2000, the Council and the Commission, together with the

²²⁶⁴ Cf. CA/117/98, 2-3.

²²⁶⁵ Cf. *Söderholm*, 2.

²²⁶⁶ Cf. Promoting innovation through patents - The follow-up to the Green Paper on the Community Patent and the Patent System in Europe of 5.12.1999, COM(1999) 42 final.

²²⁶⁷ Ex Art. 235 EC Treaty.

²²⁶⁸ Cf. *Bossung, Return*, 304; *Armitage, Policy*, 556.

²²⁶⁹ Cf. *CP Green Paper*, 3.

²²⁷⁰ Cf. Promoting innovation through patents - The follow-up to the Green Paper on the Community Patent and the Patent System in Europe of 5.12.1999, COM(1999) 42 final, 9.

²²⁷¹ Cf. Promoting innovation through patents - The follow-up to the Green Paper on the Community Patent and the Patent System in Europe of 5.12.1999, COM(1999) 42 final, 10-12.

member states where appropriate, were asked to ensure that a Community patent would be available by the end of 2001²²⁷².

II. The second phase

On 1 August 2000 the European Commission presented a draft proposal for a Regulation on the Community Patent²²⁷³ which was regarded as daring but attractive²²⁷⁴.

As the Commission called it, the main thrust of the proposal was the creation of a "symbiosis" between the EPC and the Regulation²²⁷⁵. The EC should have to *inter alia*²²⁷⁶ accede to the EPC²²⁷⁷. The Community patent would coexist with the European and the national patents.

It was emphasised that the Community patent would be a new instrument which was unitary in nature, i.e. that it would have the same effect throughout the territory of the EU, and that it would be autonomous, i.e. that it would be governed by Community law and general principles of law²²⁷⁸.

It was then suggested that the Community patent would be, in principle, granted by the EPO on the basis of the EPC but that special provisions applicable to Community patents would be implemented into the EPC²²⁷⁹. Part IX of the EPC which was created as an interface between the EPC and CPC was therefore no longer in line with the EU's latest suggestions and the EPC would have to be revised accordingly. A revision would, however, also be necessary because the EC would have to accede to the EPC²²⁸⁰.

²²⁷² Cf. Presidency Conclusions, Lisbon European Council, 23 and 24 March 2000, N 13.

²²⁷³ Cf. CP Regulation proposal.

²²⁷⁴ Cf. *Willems, Ways*, 194.

²²⁷⁵ Cf. CP Regulation proposal, 6.

²²⁷⁶ Cf. *Fawcett D.*, 19, with regard to the further effects of the "symbiosis".

²²⁷⁷ Cf. CP Regulation proposal, 7. With regard to the effects and problems related to that accession, cf.

Ullrich, Integrating, 42-49.

²²⁷⁸ Cf. *Söderholm*, 3.

²²⁷⁹ A detailed proposal was published in the Commission staff working paper - A Community policy for the realisation of the Community patent in the context of a revision of the European Patent Convention of 7.5.2001, SEC (2001) 744.

²²⁸⁰ Cf. *Nooteboom*, 569.

In order to create a cost effective Community patent, the Commission proposed a rather radical²²⁸¹ but certainly pragmatic approach with regard to the translation requirements²²⁸²:

The patent documents would have to be translated into one of the EPO's three working languages, and the claims into the other two.

For the judicial arrangements it was, in summary, proposed to create a centralized two-instance "Community Intellectual Property Court" that would apply its own rules of procedure and have the authority to grant provisional measures, determine penalties and award damages²²⁸³.

The proposal for a first instance community court seemed rather surprising after the initial remarks in the Green Paper. However, in the framework of the discussions for institutional reforms with a view to the upcoming enlargement of the Community by twelve states the ECJ proposed to create a community court specialised in intellectual property, thus, easing the burden of the court²²⁸⁴. This proposal was supported by the European Commission²²⁸⁵. It resulted *inter alia* in the new Articles 225a and 229a EC Treaty at the Nice summit.

The proposed competences of the "Community Intellectual Property Court" were clearly influenced by the outcome of the negotiations for an EPLA. The jurisdiction of the court would be exclusive with regard to infringement and validity questions, actions relating to the use of the patent or to the right based on prior use of the patent, requests for limitation or applications for a declaration of lapse and claims for damages²²⁸⁶. The Community patent would, however, not be subject to actions in respect of potential infringement²²⁸⁷.

²²⁸¹ Cf. *Kolle, Europe*, 50.

²²⁸² Cf. *Söderholm*, 4.

²²⁸³ Cf. CP Regulation proposal, 13; Arts. 42-44 CP Regulation proposal.

²²⁸⁴ Cf. *Scordamaglia, Perspectives*, 114; cf. also *Lipp*, 2659.

²²⁸⁵ Cf. Additional Commission contribution to the Intergovernmental Conference on institutional reform, Reform of the Community courts of 1.3.2000, COM(2000) 109 final, 8; CP Regulation proposal, 16-17; cf. also *Cole*, 221.

²²⁸⁶ Cf. CP Regulation proposal, Arts. 30-38.

²²⁸⁷ Cf. CP Regulation proposal, Art. 30(2).

The proposals triggered criticism and intense discussions in the EU and in the European Patent Organisation. The Internal Market Council - later called "Council (Competitiveness)" - finally agreed on the common approach of 31 May 2001²²⁸⁸.

What was quite clear in the common approach was that the national patent offices would have an important role with regard to Community patents, going as far as being allowed to carry out searches²²⁸⁹.

Concerning languages, the declaration was less clear: The Community patent system should be based *inter alia* on the principle of non-discrimination. This seemed to exclude the implementation of the Commission's proposal for a simple, three language regime²²⁹⁰.

With regard to the judicial arrangements it was agreed that the Community patent should be litigated before a specialised court of the ECJ Court of First Instance based on Article 225a EC Treaty. Due account should be taken of cost effectiveness, demand, local language, proximity to users and use of existing infrastructure and expertise. Appeals should be heard by the ECJ Court of First Instance. The influence of the WPL upon the proposed solutions was again quite obvious.

The negotiations in the EU continued but the momentum was lost. Obviously, once again, the languages²²⁹¹ and jurisdictional arrangements²²⁹² were the major obstacles in the negotiations. On the one hand, the number of translations was in dispute²²⁹³, and, on the other hand, there were discussions similar to those held in the WPL on whether a Community court with two instances or only with a common court of appeal should be created.

²²⁸⁸ Cf. Council of the European Union, Doc. 2778/01 (PI), 1.6.2001.

²²⁸⁹ Cf. *Schneider*, 264-265.

²²⁹⁰ Cf. *Schneider*, 265; *Johnson*, 20.

²²⁹¹ Cf. *Bossung*, *Unionpatent*, 19-22; *Söderholm*, 6-7; *Willems*, *Ways*, 196.

²²⁹² Cf. EU-Wide Patent Stymied Again By Inability to Agree on Jurisdiction, 12/02 WIPR, 6-7; *Bossung*, *Unionpatent*, 23-25; 29-30; *Söderholm*, 8; *Johnson*, 19-20; *Fawcett D.*, 20.

²²⁹³ Cf. *Willems*, *Awaiting*, 561; *Lyndon-Stanford*, *Patent*, 9.

Despite the intensive negotiations and the hope that an agreement on the details could be reached, the Competitiveness Council adopted another common political approach on 3 March 2003²²⁹⁴.

It was agreed, among other things, that the litigation of Community patents should first take place before a judicial panel established by a Council decision according to Article 225a EC Treaty. The appeal would lie with the ECJ Court of First Instance. This judicial panel, called "Community Patent Court" would be attached to the ECJ Court of First Instance. The Community Patent Court could hold hearings in EU member states other than those in which it was located. The court would basically conduct the proceedings in the official language of the EU member state in which the defendant was domiciled. The court would be established at the latest by 2010. Until that time each EU member state would designate a limited number of national courts having jurisdiction.

With regard to the translation requirements of the Community patent, it was agreed that upon the grant of the Community patent by the EPO, the applicant would have to file a translation of all claims into all (now 23) official Community languages, unless an EU member state renounced the translation into its official language.

With regard to the role of the national patent offices, it was agreed that they would have an important role to play²²⁹⁵: *Inter alia* the national patent offices having an official language other than the three official languages of the EPO could carry out any task up to and including novelty searches in their respective languages. If a national patent office had an official language in common with the EPO, had experience of cooperation with the EPO and needed to maintain a critical mass of work, it could carry out search work on behalf of the EPO. Since the application and granting procedure for European and Community patents would be the same, the national patent offices would also execute search work with regard to European patents²²⁹⁶.

Non-EU member states which were EPC contracting states questioned this agreement, as the search results of a national patent office to which sovereign rights were not transferred

²²⁹⁴ Community Patent – Common political approach, Council of the European Union, Doc. 7159/03, Brussels, 7.3.2003.

²²⁹⁵ Cf. also *Fawcett D.*, 21.

²²⁹⁶ Cf. *Kolle, Europe*, 52.

- but which would be directly implemented into the examination procedure of the EPO - could possibly lead to a patent granted for their territory.

Soon it became clear that this compromise did not fulfil the expectations of the users²²⁹⁷, namely the creation of a patent that would bring clear advantages to the existing European patent system, i.e. a Community patent that would be less costly than an average European patent having effect in three to five states²²⁹⁸ while increasing legal certainty.

The discussions on the translation requirements that followed in the few months after the agreement on the common approach mainly revealed that the cost problems could, in fact, not be settled²²⁹⁹. An agreement on whether the translations of the claims should have a legally binding effect²³⁰⁰, very possibly leading to a patent with a non-unitary character due to the remaining differences among the translations²³⁰¹, or whether they should fulfil purely information purposes²³⁰² - hence allowing for cheaper machine translations - has not been reached until today²³⁰³.

The declaration that the Community patent was not successful in the framework of the CPC because it was an international agreement and not a Community instrument²³⁰⁴ doesn't seem to be correct. There are highly political issues involved in the creation of a Community patent which are irrelevant to the chosen instrument.

With regard to the judicial agreements, it was particularly criticised that the proceedings would be held in the language of the domicile of the defendant²³⁰⁵.

²²⁹⁷ Cf. *Harrison*, 28; Bodoni Stéphanie, Siemens IP head reveals IP frustration, <www.legalmediagroup.com>, 28 March 2004.

²²⁹⁸ Cf. *Kolle*, *Europe*, 55.

²²⁹⁹ Cf. *Harrison*, 26; cf. also Deal on setting up single European patent, Financial Times, March 4, 2003.

²³⁰⁰ Cf. *Dreiss*, 713; *Jenkins*, 26; Bodoni Stéphanie, Irish initiative to break Community patent statement, <www.legalmediagroup.com>, 14 March 2004.

²³⁰¹ Cf. Schmidt Karl-Michael/Blanke Katrin, „Sprachen- und Rechtssicherheit in Europa“, 2004 Mitt., 494-499, with a very instructive example at 496.

²³⁰² Cf. Bodoni Stéphanie, Industry slams Community patent proposals, <www.managingip.com>, December 2003, 14.

²³⁰³ Cf. European Commission MEMO/04/117 of 19 May 2004.

²³⁰⁴ Cf. Schwartz Ivo E., Perspektiven der Angleichung des Privatrechts in der Europäischen Gemeinschaft, 1994 ZEuP, 559-584, 564-565.

²³⁰⁵ Cf. *Pagenberg*, *Community patent*, 283-284.

In the following months the European Commission further developed its ideas²³⁰⁶ and published - at the end of 2003 - two proposals for EU Council decisions:

One establishing the Community Patent Court and concerning appeals before the Court of First Instance²³⁰⁷, and a second one conferring jurisdiction to the Court of Justice in disputes relating to the Community patent²³⁰⁸.

But in any case, it is questionable whether the new EU member states which have acceded since 2004 would be bound to the latest common political approach agreed upon in March 2003²³⁰⁹.

In order to create new momentum, the High Level Group on the Lisbon strategy under Wim Kok's chairmanship recommended at the end of 2004 that the Competitiveness Council should decide whether the Community patent should go ahead or not²³¹⁰. However, no decision was taken. The Community patent proposal has remained on the table blocking the realisation of the EPLA²³¹¹.

III. The third phase

European Commissioner Charlie McCreevy announced at the end of 2005 that he intended to make one final effort towards the adoption of the Community patent proposal during his mandate. The Community patent therefore rightly remains a central aspect in the European Commission's policy²³¹².

²³⁰⁶ Cf. Commission working document on the planned community patent jurisdiction of 30.8.2002, COM(2002) 480 final.

²³⁰⁷ Cf. CP Court proposal.

²³⁰⁸ Cf. CP Court jurisdiction.

²³⁰⁹ Cf. *Sadlonova*, 101-104.

²³¹⁰ Cf. it was recommended by the group that *"the time has come for the Council to adopt the Community patent or drop it"*, cf. Facing the challenge, The Lisbon strategy for growth and employment, Report from the High Level Group chaired by Wim Kok, November 2004, 23.

²³¹¹ Cf. §7 A.III. The third phase.

²³¹² Cf. Nurton James, McCreevy revives Community patent, <www.managingip.com>, February 2006, 10.

The Commission declared that until the circumstances were right, it would like to seek the views of stakeholders on an effective IPR system in the European Union²³¹³.

Nine years after the Green Paper including the questionnaire on the European patent system, the European Commission obviously felt that a new survey was necessary in order to find out whether the demands of the users for a sound patent system in Europe had changed in the mean time.

The dialogue was launched by a consultation and an announced public hearing on the patent system in Europe. As mentioned above²³¹⁴, the consultation phase was again held with a questionnaire²³¹⁵. The questions referred to basic principles and features of the patent system, the Community patent as a priority for the European Union, the European Patent System - and in particular the EPLA -, the approximation and mutual recognition of national patents, and the patent system in general. The public hearing on the consultation was held on 12 July 2006. It revealed that the support from the stakeholders for a Community patent based on the latest proposals was limited²³¹⁶.

In the following Communication on the enhancement of the patent system in Europe in April 2007, the European Commission made clear²³¹⁷ that the creation of a single Community patent continued to be a key objective for Europe. It felt that a truly competitive and attractive Community patent could be achieved provided there was a political will to do so. The discussions on the Communication are currently ongoing within the EU and will trigger a revised proposal for a Community Patent Regulation.

²³¹³ Questionnaire on the patent system in Europe, Brussels, 09/01/06, 1, <ec.europa.eu/internal_market/indprop/docs/patent/consult_en.pdf>.

²³¹⁴ Cf. §7 A.III. The third phase.

²³¹⁵ The questionnaire is available at <ec.europa.eu/internal_market/indprop/docs/patent/consult_en.pdf>.

²³¹⁶ Future Patent Policy in Europe, Public Hearing - 12 July 2006, Report, 5.

²³¹⁷ Communication from the Commission to the European Parliament and the Council of 3.4.2007 - Enhancing the patent system in Europe, COM(2007) 165 final.

B. Structural provisions in the draft Community Patent Regulation and the related draft proposals

I. The "Community Patent Court" as first instance

1. Introduction

The Community Patent Court would be the first civil court at the Community level²³¹⁸.

Whereas the proposal for a Community Patent Regulation still referred to the creation of a "Community Intellectual Property Court", the following proposals for EU Council decisions establishing the Community Patent Court and concerning appeals before the Court of First Instance²³¹⁹ and conferring jurisdiction on the Court of Justice in disputes relating to the Community patent only used the terminology "Community Patent Court"²³²⁰. Article 225a EC Treaty itself would actually allow the creation of a court dealing with all Community IPRs²³²¹. The reason for this change in terminology, therefore, seems to be that the EU member states only wanted to create a Community jurisdiction with regard to Community industrial property rights as made clear in the Nice summit and in Article 229a EC Treaty²³²².

The content of the two proposals for Council decisions are based on the proposal for a Community Patent Regulation and the two common political approaches. They have been on the table for more than four years but have not yet been officially discussed in the European Union.

The decision taken in the 2003 common political approach that each EU member state would designate a limited number of national courts having jurisdiction until the Community Patent Court would be established at the latest in 2010, is purely of theoretical value as it is not to be expected that any Community patent would be litigated, or very possibly even granted before that time.

²³¹⁸ Cf. *Nooteboom*, 569.

²³¹⁹ Cf. CP Court proposal.

²³²⁰ Cf. CP Court jurisdiction.

²³²¹ Cf. *Nooteboom*, 570-571.

²³²² However, this might once again change as under the revised Article 229a Treaty of Lisbon it will be possible to confer jurisdiction to the ECJ in disputes related to "European intellectual property rights".

2. Legal basis

The Community Patent Court would exercise jurisdiction at first instance in disputes related to Community patents. The legal basis for the proposals of the European Commission for a Community Patent Court are Articles 220 and 225 EC Treaty, in particular Articles 225a and 229a EC Treaty. As mentioned earlier, the Community Patent Court would be created as a specialised chamber of the ECJ Court of First Instance.

Based on Article 220 EC Treaty, so-called "judicial panels" for certain specific areas may be attached to the ECJ Court of First Instance²³²³. The ECJ Court of First Instance would have jurisdiction to hear actions or proceedings brought against decisions by such judicial panels. Decisions taken by the ECJ Court of First Instance may be exceptionally subject to review by the ECJ, if the unity or consistency of Community law affected was at risk²³²⁴. The organisational status of the judicial panels is, therefore, not entirely clear²³²⁵. They seem to be neither specialised courts separated from the existing courts, nor do they make part of the ECJ Court of First Instance as the latter would deal with appeals regarding decisions of the panels²³²⁶. The Treaty of Lisbon did not help clarify this situation²³²⁷. However, they are integral parts of the Community judicial system²³²⁸ and make part of a three-tier on a case by case basis²³²⁹.

Articles 225a and 229a EC Treaty provide further details with regard to the establishment of judicial panels and the establishment of such a panel's jurisdiction concerning Community patents. Article 225a EC Treaty *inter alia* provides that the EU Council could create judicial panels to hear and determine at first instance certain classes of action of proceedings brought in specific areas. For that purpose the EU Council would have to act unanimously on a proposal from the European Commission and after consulting the European Parliament and the ECJ, or at the request of the ECJ and after consulting the European Parliament and the Commission. The decision to establish a judicial panel would

²³²³ This Article will be repealed in the Treaty of Lisbon.

²³²⁴ Art. 225(2) EC Treaty.

²³²⁵ Cf. *Sack*, 78; *Schneider*, 302.

²³²⁶ Cf. *Everling*, 1123; *Kamann*, 639-640.

²³²⁷ The terminology "judicial panels" will only be replaced by "specialised courts attached to the General Court", which again will be the new terminology for ECJ Court of First Instance (Article 225a (a) Treaty of Lisbon).

²³²⁸ Cf. *Nooteboom*, 572.

²³²⁹ Cf. *Vesterdorf*, 311; *Kamann*, 639.

lay down the rules concerning the organisation of the panel and the extent of jurisdiction conferred upon it. Decisions taken by judicial panels could be subject to a right of appeal on points of law only, or, when provided for in the decision establishing the panel, also on matter of fact before the Court of First Instance.

Article 229a EC provides that the EU Council could

"adopt provisions to confer jurisdiction, to the extent that it would determine, on the ECJ in disputes relating to the application of acts adopted on the basis of the EC Treaty which create Community industrial property rights".

The EU Council would *"recommend those provisions to the member states for adoption in accordance with their respective constitutional requirements"*. It would again have to act unanimously on a proposal from the Commission and after consulting the European Parliament.

It becomes clear that both articles were created as enabling clauses, although the European Commission expected before the amendment of the EC Treaty at the Nice summit in 2000 that a clear basis for the jurisdiction of a Community Patent Court would be created²³³⁰. Therefore, there was only a transfer of power to the EC with regard to the *possibility* of creating such panels²³³¹ and providing the European Commission and the ECJ with the right of legislative initiative in this area²³³².

In addition, it was agreed by the EU member states that an agreement to create a judicial panel with the ECJ Court of First Instance, i.e. the Community Patent Court, would have to be decided unanimously by the EU Council, as is the case for the adoption of the Community Patent Regulation based on Article 308 EC Treaty.

There was even a further hurdle added, indicating that the creation of a Community Patent Court as the first civil court at the Community level²³³³ still provoked scepticism among the

²³³⁰ Cf. Söderholm, 9; cf. also Arnulf/Jacob, 210.

²³³¹ Cf. Basedow, 203.

²³³² Cf. Johnston, 513.

²³³³ Cf. Vesterdorf, 313.

EU member states²³³⁴: the recommendation to adopt the agreement on the transfer of jurisdiction to the ECJ was based on the respective constitutional requirements of the states.

Such kind of adoption is a common procedure at the national level for international agreements but, generally, not with regard to Community law. In effect a ratification procedure would have to be initiated in most EU member states before their national parliaments.

Such an agreement would probably be ratified together with the revised EPC, implementing the Community patent. This would also ensure that no Community patent would be granted before a common court dealing with those patents was established. The Community Patent Regulation should therefore enter into force together with the other legal instruments.

Ratification procedure of instruments concerning Community patents often prove cumbersome. This might even be more so in an EU with an increasing number of member states.

Under the (revised) Article 225a Treaty of Lisbon it will no longer be necessary that the EU Council, acting unanimously, creates judicial panels. In the future

"the European Parliament and the Council, acting in accordance with the ordinary legislative procedure²³³⁵, may establish specialised courts attached to the General Court to hear and determine at first instance certain classes of action or proceeding brought in specific areas. The European Parliament and the Council shall act by means of regulations either on a proposal from the Commission after consultation of the Court of Justice or at the request of the Court of Justice after consultation of the Commission."

However, also under the Treaty of Lisbon, the decision under Article 229a conferring jurisdiction on the ECJ will still have to be adopted unanimously and subsequently approved by the EU member states in accordance with their respective constitutional requirements. The scepticism vis-à-vis a specialised IP Court at the Community level did consequently not diminish.

²³³⁴ Cf. Sack, 79.

²³³⁵ Cf. Art 249A with reference to Art. 251 Treaty of Lisbon.

3. Developments

With the proposal for a Community Patent Regulation the Community patent gathered new momentum. This led, however, to renewed discussions as to whether the first instance should include national courts or not²³³⁶.

But the discussions were also motivated by the judicial reform discussions at the Community level and the questions concerning the role of the national and Community courts in the European Union²³³⁷. The discussions at the Community level in fact offered a second opportunity to the states wishing to have their national courts in first instance to reach their goal²³³⁸. Many scientific articles on the Community patent and its potential jurisdiction system were published²³³⁹. The advantages and disadvantages of national courts in first instance will not be repeated here²³⁴⁰. Interesting, however, was the progress in the negotiations in the EU up to the final proposal on what the first instance should look like:

First, the European Commission put to discussion two proposals in the Green Paper, both with national courts in first instance and the ECJ Court of First instance acting as appeal court. This solution, which was oriented to the Community trademark litigation system, seemed the only possibility because of the lacking legal basis in the EC Treaty to create new jurisdictions at the Community level²³⁴¹. However, with a view to the institutional changes in the ECJ structure to be decided at the Nice summit, the Commission took the

²³³⁶ Cf. §7 B.II.1.a)bb)aaa) Are there appropriate reasons for a "full" European solution?

²³³⁷ Cf. for example: Jacqué Jean Paul/Weiler Joseph H.H., *On the Road to European Union - A new judicial architecture: an agenda for the intergovernmental conference*, 1990 CML Rev., 185-207; da Cruz Vilaça José Luis, *L'évolution du système juridictionnel communautaire avant et après Maastricht*, Festschrift für Ulrich Everling, Band I, Due Ole/Lutter Marcus/Schwarze Jürgen (eds.), Baden-Baden, 1995, 181-203; Scorey, David W.J., *A new model for the Communities' judicial architecture in the new Union*, 1996 E.L. Rev., 224-231; Hirsch Günter, *Dezentralisierung des Gerichtssystems der Europäischen Union?*, 2000 ZRP, 57-60; *Rasmussen*; Iglesias Rodriguez, *Der EuGH und die Gerichte der Mitgliedstaaten - Komponenten der richterlichen Gewalt in der Europäischen Union*, 2000 NJW, 1889-1896; Hakenberg Waltraud, *Vorschläge zur Reform des Europäischen Gerichtssystems*, 2000 ZEuP, 860-872; *Koopmans*; *Johnston*; *Sack*; *Lipp*; *Kamann*; *Basedow*; *Everling*; *Halberstam*; *Vesterdorf*.

²³³⁸ Cf. *Landfermann, Diskussionen*, 114.

²³³⁹ Just to mention some of the contributions: *Schade, Regelung*; *Schade, Streitregelungssystem*; *Stauder, Vom*; *Landfermann, Diskussionen*; *Boval, Remarques*; *Brinkhof, Schlichtung*; *Sydow, Dreiss/Keussen*; *Griffin*; *Laddie, I.P. Rights*; *Leith, Revision*; *Tilmann, Zukunft*; *Ullrich, Integrating*; *Söderholm*; *Willems, Awaiting*; *Bossung, Unionpatent*; *Nooteboom*; *Lipp*, 2660; 2661; *Kolle, CP*; *Straus, Beitrag*, 810-811; *Tilmann, Gemeinschaftspatent*; *Pagenberg, Community patent*; *Landfermann, Entwicklung*; *Bremi/Pedrazzini*; *Jacob, Creating*; *Jenkins*; *Schneider*; *Kolle, Europe*.

²³⁴⁰ Cf. §7 B.II.1.a)bb)aaa) Are there appropriate reasons for a "full" European solution?

²³⁴¹ Cf. *Scordamaglia, Perspectives*, 114.

next step in the Community Patent Regulation proposal and recommended the creation of a centralised Community Intellectual Property Court with two instances. The exact structure of the court was, however, still unclear.

The EC Treaty of Nice, which was adopted shortly after the publication of the proposal for a Community Patent Regulation, created the above mentioned legal basis for a Community Patent Court. The judicial construction of the court, however, again remained undecided²³⁴² leaving plenty of room for various scenarios and flexibility²³⁴³.

In the 2001 common political approach it was agreed that the Community patent should be litigated before a specialised court of the ECJ Court of First Instance based on Article 225a EC Treaty. Due account should be taken of cost effectiveness, demand and local language, proximity to users and use of existing infrastructure and expertise. Questionable was whether this agreement - and in particular Article 225a EC Treaty - would make it possible for the national courts to act in first instance²³⁴⁴. But in light of the results achieved in the WPL, it was expected that there would be at least several regional chambers in first instance of the Community patent jurisdiction system that would act as courts of first instance²³⁴⁵.

The following 2002 working document of the European Commission on the community patent jurisdiction recommended a compromise²³⁴⁶ suggesting an initial centralised chamber based on Article 225a EC Treaty and the possibility to later set up one or more regional chambers in the EU member states to which litigation has proven to be most closely connected²³⁴⁷. This was quite obviously a concession to the requests of Germany, and would have been a step towards the decentralisation of Community judicial functions²³⁴⁸. However, contrary to the approach of the WPL, there would have been no

²³⁴² Cf. Declaration No 17 on Article 229a EC Treaty attached to the EC Treaty of Nice:

"The Conference considers that Article 229a does not prejudice the choice of the judicial framework which may be set up to deal with disputes relating to the application of acts adopted on the basis of the Treaty establishing the European Community which create Community industrial property rights". In general cf. *Pache/Schorkopf*, 1380.

²³⁴³ Cf. *Kolle*, CP, 621.

²³⁴⁴ Cf. *Tilmann*, *Zukunft*, 1082, 1083; *Landfermann*, *Diskussionen*, 114; *Schade*, *Protocol*, 184; *Kolle*, CP, 620.

²³⁴⁵ Cf. *Dreiss/Keussen*, 892; *Landfermann*, *Entwicklung*, 344; *Schneider*, 296.

²³⁴⁶ Cf. *Nooteboom*, 575.

²³⁴⁷ Cf. Commission working document on the planned community patent jurisdiction of 30.8.2002, COM(2002) 480 final, 4.

²³⁴⁸ Cf. *Johnston*, 514. Cf. also the discussions on the judicial architecture of the EU at n. 2337; *Kamann*, 640-641.

right of the EU member states to create regional chambers on their territory²³⁴⁹. Regional chambers could only be created if the number of cases exceeded 150 proceedings in one year in the respective EU member state. The location of a regional chamber would be determined taking into account patent litigation activity and the actual need for a regional chamber²³⁵⁰.

The 2003 common political approach went back to the initial proposal for a fully centralised approach excluding the establishment of permanent regional divisions²³⁵¹. Obviously it was felt that the European Commission's compromise was too weak.

On the one hand, it seemed not sufficiently clear for the states interested in permanent regional chambers whether they really would²³⁵² and how many be created²³⁵³. On the other hand, regional chambers could only be established in a very limited number of EU member states particularly if the current number of patent cases litigated before the national courts were to be taken into consideration²³⁵⁴. States that actually wanted a regional chamber but lacked high figures in litigation, would opt for a centralised solution.

In addition, concerns were expressed that backlogs could be created at the centralised chamber, if the decision to create regional chambers was taken too late²³⁵⁵. But it seems that there was also a certain lack of trust in a decentralised system²³⁵⁶, as it was argued that a common jurisprudence with high quality decisions²³⁵⁷ and legal certainty regarding the unitary Community patent would be best assured by a centralised system²³⁵⁸.

²³⁴⁹ Cf. §7 B.II.1.a)dd)bbb)iii) The agreed principle.

²³⁵⁰ Cf. Commission working document on the planned community patent jurisdiction of 30.8.2002, COM (2002) 480 final, 14.

²³⁵¹ Cf. *Tilmann, Gemeinschaftspatent*, 383-384.

²³⁵² Cf. *Landfermann, Diskussionen*, 115; *Griffin*, 26.

²³⁵³ Germany obviously expected three to four regional chambers on its territory (cf. *Landfermann, Discussions*, 115).

²³⁵⁴ Based on the survey made by the EPO in 2003 among the WPL sub-group only courts in France and Germany deal with more than 150 patent cases per year (cf. WPL/4/03); cf. also *Schneider*, 142-143; 151-152; 167-169; 174-176; 180-184. However, it seems that also Italian courts deal with more than 150 patent cases per year (cf. Working Document from the Presidency, Towards an Enhanced Patent Litigation System and a Community Patent - How to Take Discussions Further (Doc. 11622/07), available at <www.epo.org/topics/news/2007/20070725.html>).

²³⁵⁵ Cf. *Griffin*, 26; *Dreiss*, 715-716.

²³⁵⁶ Cf. also §7 B.II.1.a)ee) The Court of Appeal and the role of the ECJ.

²³⁵⁷ Cf. *Nooteboom*, 574-575.

²³⁵⁸ Cf. CP Court proposal, 7.

a) Detailed structure

The detailed structure is mainly based on the proposal for EU Council decisions establishing the Community Patent Court and concerning appeals before the Court of First Instance²³⁵⁹.

The Community Patent Court would be established as a judicial panel within the framework of Article 225a EC Treaty. The seat would be in Luxembourg at the ECJ Court of First Instance²³⁶⁰ but it could hold hearings in other EU member states²³⁶¹. Based on Article 225a(6) EC Treaty the provisions of the EC Treaty relating to the ECJ and the provisions of Statute of the ECJ would also be applicable to the Community Patent Court, unless otherwise decided²³⁶². This would guarantee that a core set of rules would be applicable at all different levels of the Community jurisdiction²³⁶³. It is suggested in the CP Court proposal to add an Annex II to the Protocol on the Statute of the ECJ in which institutional provisions for the Community Patent Court would be defined.

aa) President, the Advisory Committee and the Registrar

The Community Patent Court would have a President and an Advisory Committee.

The President would preside over the court and assume administrative and representative duties²³⁶⁴. These duties are still not entirely defined. As suggested for the European Patent Court²³⁶⁵, the judges of the court would elect the President of the Community Patent Court from among themselves for a term of three years. The President could be re-elected²³⁶⁶. The first President of the Community Patent Court would be elected in the same manner

²³⁵⁹ Cf. CP Court proposal.

²³⁶⁰ Art. 1 CP Court proposal.

²³⁶¹ Art. 24 Annex II, CP Court proposal.

²³⁶² Under the Treaty of Lisbon it was added that title 1 of the statute of the ECJ (Judges and Advocates General) and Art. 64 (transitional provisions with regard to the court's language regime) thereof shall in any case apply to the specialised court.

²³⁶³ Cf. *Nooteboom*, 583.

²³⁶⁴ Cf. CP Court proposal, 7.

²³⁶⁵ Cf. Art. 14(2) draft Statute.

²³⁶⁶ Art. 4 Annex II, CP Court proposal.

as its members²³⁶⁷, unless it was decided that the abovementioned procedure would not be applicable²³⁶⁸. This is, however, highly unlikely primarily due to political reasons.

The only task of the Advisory Committee would be to give opinions about potential candidates for the judges post. It would be composed of seven members chosen from among former members of the ECJ, the ECJ Court of First Instance, the Community Patent Court, or distinguished lawyers. The appointment of members of the committee and its operating rules would be decided by the EU Council, acting by a qualified majority, on a proposal from the President of the ECJ²³⁶⁹.

The Community Patent Court would appoint the Registrar and lay down the rules governing his duties²³⁷⁰. The court would have its own Registrar, although it would be formally attached to the ECJ Court of First Instance which already has a Registry. This proposal was made in order to ensure a swift and efficient procedure before the court in consideration of the expected workload and the special type of litigation²³⁷¹. The institutional powers of the Registrar would, however, - and in contrast to the European Patent Court²³⁷² - be limited. The Registrar would have to take residence at Luxembourg. This provision has its basis in the Statute of the ECJ²³⁷³. Furthermore, rules of the statute with regard to immunities²³⁷⁴, oath and duties²³⁷⁵ and replacement of the Registrar²³⁷⁶ would be applicable *mutatis mutandis*²³⁷⁷.

²³⁶⁷ Cf. §8 B.I.3.a)bb) The judges.

²³⁶⁸ Art. 7(1), CP Court proposal.

²³⁶⁹ Art. 3(2) Annex II, CP Court proposal.

²³⁷⁰ Art. 6 Annex II, CP Court proposal.

²³⁷¹ Cf. CP Court proposal, 8; 16.

²³⁷² Cf. §7 B.II.1.a)gg) The Registry.

²³⁷³ Art. 6 Annex II, CP Court proposal in conjunction with Art. 14 Protocol on the Statute of the Court of Justice.

²³⁷⁴ Art. 6 Annex II, CP Court proposal in conjunction with Art. 3(4) Protocol on the Statute of the Court of Justice.

²³⁷⁵ Art. 6 Annex II, CP Court proposal in conjunction with Art. 10 Protocol on the Statute of the Court of Justice.

²³⁷⁶ Art. 6 Annex II, CP Court proposal in conjunction with Art. 11 Protocol on the Statute of the Court of Justice.

²³⁷⁷ Art. 6 Annex II, CP Court proposal.

bb) Judges

Based on the 2003 common political approach the judges of the Community Patent Court should be appointed on the basis of their expertise, taking also into account their linguistic skills²³⁷⁸.

The experience of the judges in this field would be crucial for the acceptance of the system by guaranteeing efficient proceedings and high quality decisions²³⁷⁹. This view was also shared within the WPL and can be fully supported. However, it seems questionable whether this goal can be achieved with the proposed appointment rules for the Community Patent Court judges²³⁸⁰:

A member of the court, i.e. a judge would be appointed by the EU Council. The judges would be chosen from distinguished candidates proposed by the EU member states²³⁸¹. Prior to the appointment decision, the Advisory Committee would have to give an opinion on the profile of candidates with particular regard to the duties of a judge within the Community Patent Court. It could also provide a list of those candidates who possess the most appropriate high level of legal experience²³⁸². Such a list would have to comprise twice the number of judges to be appointed²³⁸³. This extended list should offer a safeguard against possible predetermination of the decision of the EU Council by the committee's opinion²³⁸⁴.

As the term already indicates, the Advisory Committee would only be able to give advice on the legal expertise of the candidates. Politicians have, however, the tendency to follow their own beliefs²³⁸⁵. This concern is also supported by the decision taken in Nice – and approved in Lisbon in 2007 - that the judges of a judicial panel should be appointed by a unanimous decision of the EU Council²³⁸⁶.

²³⁷⁸ Community Patent – Common political approach, Council of the European Union, Doc. 7159/03, Brussels, 7.3.2003.

²³⁷⁹ Cf. CP Court proposal, 15.

²³⁸⁰ Cf. also *Jacob, Creating*, 87; *Pagenberg, Community patent*, 283.

²³⁸¹ Art. 2(2) Annex II, CP Court proposal.

²³⁸² Art. 3(1) Annex II, CP Court proposal.

²³⁸³ Art. 3(1) Annex II, CP Court proposal.

²³⁸⁴ Cf. CP Court proposal, 15.

²³⁸⁵ Cf. also *Bremi/Pedrazzini*, 532.

²³⁸⁶ Article 225a(4) EC Treaty.

In addition, only a few judges would be necessary for the court. It is suggested that the expected initial workload of the Community Patent Court and the requirement for its smooth operation would require the appointment of seven judges²³⁸⁷. Nonetheless, it will still not be an easy task to appoint even a small number of highly qualified judges for the 27 EU member states.

The judges of the Community Patent Court would act exclusively for the Community. Judges chosen from different states and legal cultures should ensure a common jurisprudence already in first instance²³⁸⁸. They would be appointed for a period of six years²³⁸⁹ with the possibility of a re-appointment²³⁹⁰. The memberships would, however, be partially renewed every three years, replacing four and three members alternatively. The term of office would be shorter for some of the first appointed judges.

The same rule of a graduate appointment already applies to the ECJ Court of First Instance²³⁹¹. The partial exchange makes it possible for the special expertise built up over the years to be transferred to new members. It would also contribute to a stable jurisprudence and legal certainty²³⁹².

Without going into further detail, it is suggested that many generally applicable provisions of the Statute of the ECJ, such as oath, immunity, other occupation, challenge for bias etc., should also be applicable to the Community Patent Court and its judges²³⁹³.

cc) Judicial panels

The Community Patent Court would generally sit in chambers of three judges²³⁹⁴. In contrast to the WPL within which an agreement on the number of judges sitting in the

²³⁸⁷ Art. 2 (1) Annex II, CP Court proposal.

²³⁸⁸ Cf. *Nooteboom*, 580.

²³⁸⁹ This is also the term for a judge at the ECJ and the ECJ Court of First Instance (cf. Art. 223(1) and (4) and Art. 224(2) EC Treaty).

²³⁹⁰ Art. 2(1) Annex II, CP Court proposal.

²³⁹¹ Art. 224(2) EC Treaty.

²³⁹² Cf. CP Court proposal, 14.

²³⁹³ Art. 5 Annex II, CP Court proposal.

²³⁹⁴ Art. 8(1) Annex II, CP Court proposal.

panel was not possible and left for decision to each Regional Division²³⁹⁵, it was felt in the EU that three judges would provide for the right balance between thoroughness and efficiency of handling an average case²³⁹⁶.

In consideration of the initial proposal for seven judges, the court would in the beginning be composed of two chambers.

One chamber would be presided *ex officio* by the President of the Community Patent Court. The seventh member of the court would give special support to this chamber. The president of the other chamber would also be elected by the judges from among their number for a term of three years with the possibility of a re-election²³⁹⁷.

In certain cases defined in the Rules of Procedure, the court's composition could be enlarged, or even reduced to a single judge²³⁹⁸. An enlarged composition could, for example, be necessary when fundamental questions of law are concerned. A reduced composition could come in question in cases dealing with interim measures or when simple cases in main proceedings are at stake²³⁹⁹. In order to guarantee the necessary degree of flexibility for efficient case handling²⁴⁰⁰, the composition of the chambers and the assignment of cases would be defined in the Rules of Procedure²⁴⁰¹.

The Rules of Procedure would be established by the Community Patent Court in agreement with the ECJ, and would have to be approved by the EU Council, acting on a qualified majority²⁴⁰².

dd) "Assistant Rapporteur"

The "Assistant Rapporteur" is the result of lengthy discussions at the Community level²⁴⁰³ on how to infuse technical expertise into the Community patent proceedings.

²³⁹⁵ Art. 26(4) draft Statute.

²³⁹⁶ CP Court proposal, 18.

²³⁹⁷ Art. 8(3) Annex II, CP Court proposal.

²³⁹⁸ Art. 8(2) Annex II, CP Court proposal.

²³⁹⁹ Cf. CP Court proposal, 8.

²⁴⁰⁰ Cf. CP Court proposal, 18.

²⁴⁰¹ Art. 8(4) Annex II, CP Court proposal.

²⁴⁰² Art. 225a(5) EC Treaty.

Technical judges had not been proposed for the COPAC²⁴⁰⁴. However, the European Commission initially followed the approach suggested by the WPL²⁴⁰⁵ and proposed in the 2002 working document that the Community Patent Court should be composed of legal and technical members²⁴⁰⁶. Three out of the seven judges should have a technical background and cover the basic fields of technology covering chemistry²⁴⁰⁷, physics and mechanics²⁴⁰⁸. It goes without saying that the technical judge sitting on the panel would have been chosen depending on the technical field to which the case relates. This limitation of the technical judges to the basic fields of technology was subject to criticism²⁴⁰⁹. The principle task of the technical judges would be to support the judges in better understanding the case's technical facts²⁴¹⁰. Contrary to this proposal, the EU member states, however, agreed in the 2003 common political approach that the legal judges would only be assisted by technical experts throughout the handling of the case²⁴¹¹.

Obviously many EU member states could not get accustomed to the idea of having non-lawyers on the panel²⁴¹². They preferred the approach that was mentioned as an alternative in the 2002 working document and already had a legal basis in the Statute of the ECJ²⁴¹³: Instead of technical judges, so-called "Assistant Rapporteurs" could provide the necessary technical knowledge.

As requested by the EU member states in the common approach, the "Assistant Rapporteurs" would support the three judges with their technical knowledge during the entire proceedings. In order to fulfil their duties, they would, thus, need thorough experience in patent law²⁴¹⁴. Scholars, patent attorneys or persons that once worked as

²⁴⁰³ Cf. already *Brändel*, 296.

²⁴⁰⁴ Cf. *Stauder, Vereinbarung*, 308; cf. also *Haardt*, 336.

²⁴⁰⁵ Cf. *Schade, Protocol*, 170.

²⁴⁰⁶ Cf. Commission working document on the planned community patent jurisdiction of 30.8.2002, COM(2002) 480 final, 11.

²⁴⁰⁷ Cf. Commission working document on the planned community patent jurisdiction of 30.8.2002, COM(2002) 480 final, 3.

²⁴⁰⁸ Cf. Commission working document on the planned community patent jurisdiction of 30.8.2002, COM(2002) 480 final, 13.

²⁴⁰⁹ Cf. *Landfermann, Litigation*, 244; *Keussen*, 212, 214; *Griffin*, 26.

²⁴¹⁰ Cf. *Nooteboom*, 580.

²⁴¹¹ Community Patent – Common political approach, Council of the European Union, Doc. 7159/03, Brussels, 7.3.2003.

²⁴¹² Cf. *Landfermann, Entwicklung*, 345.

²⁴¹³ Article 13 Statute of the ECJ.

²⁴¹⁴ Cf. CP Court proposal, 17.

examiners for a patent office²⁴¹⁵ would, for example, qualify for this job. They would be required, under the conditions laid down in the Rules of Procedure, to participate in the preparation, the hearing and the deliberation of cases. They would have the right to put questions to the parties but, contrary to the judge, they would have no right to vote²⁴¹⁶. This unclear position of being neither a judge nor really a court appointed expert with the necessary level of expertise was subject to criticism²⁴¹⁷.

The "Assistant Rapporteurs" would be appointed on a proposal of the ECJ by the EU Council for a period of six years with the possibility for re-appointment²⁴¹⁸ by unanimous decision²⁴¹⁹. It would seem more appropriate to vest the Community Patent Court, which is closer to the subject matter, with the authority to make the proposals. The exact number of rapporteurs was left open²⁴²⁰ and would be decided gradually depending on the gathered experience by the court²⁴²¹.

II. The Courts of second and third instances

Article 225(2)(1) EC Treaty provides that the ECJ Court of First Instance should have jurisdiction to hear and determine actions or proceedings brought against decisions of the judicial panels set up under Article 225a EC Treaty²⁴²². A decision of the Community Patent Court may thus be appealed before the ECJ Court of First Instance²⁴²³.

It is suggested that these appeals are heard before a specialised patent chamber to be established within the ECJ Court of First Instance²⁴²⁴, making thus this specialised

²⁴¹⁵ Cf. *Jenkins*, 28.

²⁴¹⁶ Art. 7(3) Annex II, CP Court proposal.

²⁴¹⁷ Cf. *Jenkins*, 29; *Jacob, Creating*, 87.

²⁴¹⁸ Art. 7(1) and (2) Annex II, CP Court proposal in conjunction with Art. 13(1) Protocol on the Statute of the Court of Justice.

²⁴¹⁹ Art. 7(2) Annex II, CP Court proposal.

²⁴²⁰ The European Commission would, however, limit the number of "Assistant Rapporteurs" to one per meanwhile seven technical fields in order to provide for the necessary technical expertise of a general kind (cf. CP Court proposal, 17).

²⁴²¹ Cf. CP Court proposal, 17.

²⁴²² This rule will not change under the Treaty of Lisbon.

²⁴²³ Art. 26(1) Annex II, CP Court proposal.

²⁴²⁴ Art. 6 Chapter II, Annex II, CP Court proposal.

chamber part of the court²⁴²⁵. Such a specialised chamber should ensure that the necessary experience exists before the ECJ Court of First Instance.

In order to maintain the legal experience²⁴²⁶, the judges would generally sit in the same chamber in a panel of three²⁴²⁷. It is thus suggested to appoint three new judges to the ECJ Court of First Instance²⁴²⁸. Two more judges from other chambers would sit in the panel²⁴²⁹, for example, in cases reaching beyond patent law and concerning the unity and consistency of Community law²⁴³⁰. A judge from another chamber would also sit in the panel if a judge from the patent appeal chamber was sick or otherwise unable to attend²⁴³¹. The approach that the ECJ Court of First Instance and its judges would be situated above the Community Patent Court and its judges was criticised. It was felt that this construction would not ensure the necessary patent legal experience of the judges²⁴³². There is, however, not much room for flexibility, as this general structure was already determined in Article 225 EC Treaty²⁴³³. Under the Treaty of Lisbon this situation will remain unchanged.

As in the proposal for a Community Patent Court, the judges for the patent appeal chamber should be chosen from candidates highly qualified in the area of patent law²⁴³⁴. They should, furthermore, be appointed on the basis of their experience. The appointments would, however, be made upon the basis of the general rules of Article 224 EC Treaty²⁴³⁵ which again was regarded critically due to the possibility of politically driven appointments.

As before the Community Patent Court, the necessary technical knowledge before the patent appeal chamber should also be ensured by "Assistant Rapporteurs"²⁴³⁶.

²⁴²⁵ Cf. CP Court proposal, 34.

²⁴²⁶ Cf. CP Court proposal, 33.

²⁴²⁷ Art. 6 Chapter II, Annex II, CP Court proposal.

²⁴²⁸ Art. 5 Chapter II, Annex II, CP Court proposal.

²⁴²⁹ Art. 6 Chapter II, Annex II, CP Court proposal in conjunction with Art. 50 Protocol on the Statute of the Court of Justice.

²⁴³⁰ Cf. CP Court proposal, 34.

²⁴³¹ Art. 6 Chapter II, Annex II, CP Court proposal in conjunction with Art. 17(5) Protocol on the Statute of the Court of Justice.

²⁴³² Cf. *Jacob, Creating*, 88.

²⁴³³ Cf. also *Tilmann, Zukunft*, 1081.

²⁴³⁴ Art. 6 Chapter II, Annex II, CP Court proposal.

²⁴³⁵ Cf. CP Court proposal, 34.

²⁴³⁶ Art. 6 Chapter II, Annex II, CP Court proposal.

The patent appeal chamber's decisions may exceptionally be subject to review by the ECJ, under the conditions and within the limits laid down in the Statute of the ECJ, where there is a serious risk of the unity or consistency of Community law being affected²⁴³⁷. The initial proposal²⁴³⁸ to entrust the ECJ Court of First Instance with jurisdiction to hear and determine questions referred to by the national courts for a preliminary ruling under Article 234 EC Treaty²⁴³⁹ was postponed until sufficient practical experience with the new jurisdictional arrangements could be gathered²⁴⁴⁰. A possible transfer of the authority for preliminary rulings to the ECJ Court of First Instance was criticised as it could jeopardise its fundamental goal of ensuring the unity of law, if the jurisdiction for preliminary rulings would have to be divided between the ECJ and its court of first instance²⁴⁴¹.

C. Conclusion with regard to the Community Patent and its proposed court with a special view on the uniformity of law and interpretation, solving the problems of *forum shopping*, and avoiding multiple litigation

The hope that the new approach of the European Commission would facilitate the completion of the Internal Market with a good Community patent system was, unfortunately, short-lived.

Once again negotiations for a Community patent could not be concluded successfully although its creation continued to be a key objective for the European Commission²⁴⁴². The growth of the EU to 27 member states, the requirement of unanimity for the adoption of the Community Patent Regulation²⁴⁴³, and the involvement of the European Commission in the negotiations seemed to make the negotiations even more difficult than those on the CPC.

²⁴³⁷ Art. 225(2)(2) EC Treaty and Art. 62 Protocol on the Statute of the Court of Justice. Cf. also *Johnston*, 514-515.

²⁴³⁸ Cf. *Nooteboom*, 581.

²⁴³⁹ Cf. Art. 225(3) EC Treaty.

²⁴⁴⁰ Cf. CP Court proposal, 9-10.

²⁴⁴¹ Cf. *Snell*, 185.

²⁴⁴² Cf. Communication from the Commission to the European Parliament and the Council of 3.4.2007 - Enhancing the patent system in Europe, COM(2007) 165 final, 4.

²⁴⁴³ Cf. *Jenkins*, 26; *Kolle, Europe*, 56.

In addition, the WPL worked out a proposal for a litigation system with regard to European patents that is supported by the users²⁴⁴⁴.

Furthermore, it became clear that some EU member states are still reluctant to confer jurisdiction to the EC²⁴⁴⁵. This becomes obvious, on the one hand, in the decision to transfer only the authority to the EC with regard to the possibility of creating a Community Patent Court in the EC Treaty. On the other hand, the reluctance of the EU member states is underlined by the required approval at the national level of the decision to create specialised judicial panels within the EU²⁴⁴⁶, such as for a Community Patent Court. Since this would be the first specialised civil court, there seems to be a certain degree of scepticism that more similar courts at the Community level would follow, once the panel for dealing with Community patents has been established²⁴⁴⁷.

The European Commission proposed a Community patent that is autonomous and unitary²⁴⁴⁸. Together with the suggested unified Community Patent Court a common system of law would be created. This is in line with the statement of the European Commission that a Community patent is essential in order to eliminate the distortion of competition which may result from the territorial nature of national protection rights and is one of the most suitable means of ensuring the free movement of goods protected by patents²⁴⁴⁹. It is therefore questionable whether the Commission's proposal that the European and national patent systems should coexist with the Community patent and that the inventors would remain free to choose the type of patent protection best suited to their needs,²⁴⁵⁰ would not speak against this fundamental goal²⁴⁵¹. The mere existence of a Community patent does not seem to eliminate, but only reduce these distortions on trade and competition, resulting from market segmentation through the use of national and

²⁴⁴⁴ Cf. Future Patent Policy in Europe, Public Hearing - 12 July 2006, Report, 4, 6.

²⁴⁴⁵ Cf. *Lyndon-Stanford, Patent*, 9.

²⁴⁴⁶ Cf. also *Pache/Schorkopf*, 1381.

²⁴⁴⁷ At the EU summit in Nice the Conference, for example, asked the Court of Justice and the Commission to prepare as swiftly as possible a draft decision establishing a judicial panel which has jurisdiction to deliver judgments at first instance on disputes between the Community and its servants (cf. Declaration No. 16 on Article 225a EC Treaty attached to the EC Treaty of Nice). The proposal for the creation of "European Union Civil Service Tribunal" was submitted in 2003 by the European Commission which led to the adoption of a EU Council decision establishing the tribunal (cf. Council Decision establishing the European Civil Service Tribunal of 2 November 2004).

²⁴⁴⁸ As mentioned above different proposals discussed in the EU Council with regard to the effect of the translations of the claims would have put to question this unity.

²⁴⁴⁹ See CP Regulation Proposal, 6; cf. also *Scordamaglia, Perspectives*, 108.

²⁴⁵⁰ See CP Regulation Proposal, 6.

²⁴⁵¹ Cf. also *Sadlonova*, 93-94.

European patents²⁴⁵². Therefore, it seems more than questionable whether the "optional solution"²⁴⁵³ should really be regarded as the final direction in which the European Commission is heading. Nevertheless, the integration of the European Union and its interlocking have further advanced since the times of the CPC.

The Community Patent Court would influence national patent systems and policy²⁴⁵⁴ and would contribute to uniformity of interpretation of European patent law. The national courts' jurisprudence with regard to European patents and national patents would not be immune to the decisions of the Community Patent Court with regard to European patent law. The fact that the Community patent would be granted upon the basis of the EPC would support this tendency. But it would also depend on whether the Community patent and its court²⁴⁵⁵ would be sufficiently attractive and actually used by industry.

In conclusion, the better the Community patent and the quality of the appointed judges, the higher the chance for a uniform jurisprudence with regard to European patent law.

In any case, the more authority the Community has over patent law, the more unity of jurisprudence could be reached. The best solution vis-à-vis a uniform interpretation would be of course if the Community Patent Court could also deal with European patents.

The effect of the Community Patent Court's jurisprudence to national courts of non-EU member states dealing with European patent law would of course be limited. It can, however, not be denied that its jurisprudence would also have a certain influence on the courts of these states.

As the Community Patent Court would be the only court dealing with Community patent litigation, it would solve the problems related to *forum shopping* and multiple litigation within the EU. They could, however, not entirely be avoided, since the European patent would continue to exist - unless the Community Patent Court also had exclusive jurisdiction regarding European patent disputes.

²⁴⁵² Cf. *Martinez*, 780.

²⁴⁵³ Cf. §1 E.I. "Switching" from the Community patent to the European patent and the "optional solution". Also cf. *Laddie, I.P. Rights*, 406-407; *Bossung, Unionpatent*, 7-9.

²⁴⁵⁴ Cf. *Ullrich, Integrating*, 69-78.

²⁴⁵⁵ Cf. *Bremi/Pedrazzini*, 533.

SUMMARY AND GENERAL CONCLUSIONS

The European Patent Convention (EPC) is an international treaty which established *inter alia* a system of law, including substantive law for the granting of patents. As such it is binding international uniform law, uniform "European patent law". All authorities dealing with European patents therefore have the obligation to construe the EPC and corresponding national law implementing the EPC in an international spirit, based on its *ratio* and with a view to creating a uniform interpretation beyond their own borders. This is particularly important if, in a revocation or infringement case, they deal with the method in order to determine the extent of protection (Article 69 EPC) and the grounds for revocation (Article 138 EPC), as well as the related patentability criteria (Articles 52-57 EPC) of a European patent. The fact that the European patent is a "bundle of patents", and thus the different parts of the patent can have a separate destiny, has no impact on this general obligation. Nevertheless, some courts of EPC contracting states ignored this duty and construed European patent law with a purely national perspective. Others executed the required legal comparative interpretation by taking each other's legal understanding and case law into practical consideration. Nevertheless, a uniform interpretation could not be fully reached, thus giving rise to legal uncertainty, and a common European patent court which could ensure it does not currently exist.

In fact a common patent court should have been created by the Community Patent Convention (CPC) in the mid 1970ies. The CPC would have created a Community patent and a Common Appeal Court (COPAC) and national courts acting as "Community court of first instance". The COPAC would have had no jurisdiction in regard to European patents. Although the COPAC's jurisprudence would not have been binding with regard to the interpretation of European patents, clearly it would have contributed to a uniform interpretation due to the fact that all the grounds for revocation of a European patent would also have applied to a Community patent and the extent of protection would have been determined on the basis of the same provisions. The fact that too many courts at the national level would have acted as Community courts, with the inherent risk of a lack of knowledge of patent law and patent litigation due to the limited number of patent disputes in Europe, would have slowed down endeavours for a uniform interpretation of European patent law and would have led to intensive *forum shopping*. Disunity could, however, not have been fully avoided, not least in view of the fact that not all EPC contracting states are

also members of the EU.

The lack of a common patent court raises the question of alternative measures which support the goal of a uniform interpretation of European patent law by the different authorities dealing with the provisions of the EPC. One such measure which paves the way for a common interpretation of this kind is the creation of a specialised patent jurisdiction at the national level. It not only better guarantees a greater knowledge of highly technical (European) patent law as such but also makes it easier to achieve a uniform interpretation, as only a limited number of authorities would deal with such law. Several examples at the national level in Europe show that such a specialised jurisdiction could be achieved either by limiting the number of authorities with jurisdiction in patent disputes or by allowing extensive *forum shopping*, which would make it possible for certain authorities to develop special knowledge due to the fact that they are regularly chosen by parties to deal with patent disputes. It seems clear, however, that there must be a healthy balance between the number of courts having jurisdiction and the number of cases occurring, in order to create and maintain good-quality jurisprudence over the entire territory.

Although *forum shopping* can create a high-quality jurisdiction, there are a great number of undesired side-effects related to *forum shopping* which become very obvious in (patent) cross-border cases, i.e. if a national court has jurisdiction over the infringement of a part of a European patent taking effect in another state. *Forum shopping* makes it possible for certain courts to be chosen with questionable intentions. However, as it also puts the plaintiff clearly at an advantage over the defendant, it could also endanger the principles of a fair procedure and an equal footing whereby both parties have a right to a well-balanced judgment and legal certainty. This could be avoided by the introduction of a limited *forum non conveniens* doctrine in Regulation 44/2001 and the Lugano Convention in order to ensure that the court contacted by the plaintiff has the possibility to transfer the case to a court which can better guarantee these fundamental principles by way of cooperation between the courts.

After all, judicial cooperation among the different authorities is a crucial aspect of achieving a uniform interpretation of law. Scientific input from scholars and practitioners can also support this aim. Nevertheless, cooperation and the exchange of views among judges alone will not lead to a full harmonisation of jurisprudence: at a certain point judges make

up their mind as to one or the other legal position and doctrine, and render a judgment. They will do this because they believe that they construe the law in a correct way. If the judges felt that they had possibly already moved close enough to one or the other legal position, it would be very difficult to move any further towards a uniform interpretation. The same would be the case even if the different authorities applied common rules of interpretation, if substantive patent law was further harmonised, or if the different proceedings were held under common rules. Nevertheless, the more the proceedings are unified, the greater the chances that the judges will reach the same conclusions by interpreting the law in a unified way.

National authorities could consider involving foreign judges by way of an exchange in disputes relating to European patents. This could prove to be very helpful on the way to the establishment of common jurisprudence, but the local judges will need to be open to new views and opinions and ready to change their positions.

The direct involvement of foreign judges at the national level, which would form part of the national decision-making process, seems a more promising way of working towards a uniform interpretation than providing purely national judicial authorities with the possibility of rendering judgments (on a regular basis) with effect on foreign territory. Such interventions by way of rendering cross-border injunctions were increasingly executed *inter alia* by the Dutch courts in order to avoid multiple litigation and controversial decisions regarding the infringement of a European patent in different states. Due to the fact that a cross-border injunction in Europe has to be generally recognised and enforced *eo ipso*, a judgment rendered by a foreign court has a direct impact on its own territory. However, the situation that foreign national authorities apply and construe (European) patent law with effect in another state led to strong criticism, not least as such authorities could make patent and related economic policy with effect on a foreign territory. Such interference with state sovereignty was proscribed, even if the basic intention for this intervention was the duty to work towards a uniform interpretation of European patent law. Making "foreign" judges part of the national authority could avoid the impression that views and opinions would be imposed on a state and courts from "outside". In addition, it would force the judges into a dialogue on the way to a uniform jurisprudence.

In any case the ECJ, to a great extent, turned into theory cross-border jurisdiction by

national courts with regard to patents. The principal reasons seem, however, to lie in its duty to work towards a uniform legal area in the common market which should, in its view, be established by Community institutions rather than by providing national authorities with cross-border jurisdiction competence: the less such competence national authorities have, the greater the desire and necessity to create a common civil judicial system with harmonised proceedings.

Analysis showed that arbitration, mediation and other forms of ADR will only contribute to a unitary interpretation of European patent law to a limited extent. The general confidentiality of arbitration and the limited number of patent cases are the main reasons for this conclusion. Nevertheless, arbitration could reduce the costs and complications of multiple litigations with different proceedings, limit the risk of contradictory decisions, and increase legal certainty.

However, under certain conditions the creation of an international referral body could be a major step forward in regard to a uniform interpretation of European patent law. First of all, a significant number of EPC contracting states dealing with a considerable number of patent cases would have to accept such a body, and the national authorities would actually refer to it. Furthermore, the national authorities would at least feel obligated also to accept the referral body's views to a certain extent. The most promising results would therefore be achieved if the referral were mandatory and the opinions of the referral body were binding. A model that is based on pure will and applies no pressure to the national authorities seems to be a rather weak option in regard to a unification of interpretation.

An even better means of working towards a uniform interpretation would be a common court of appeal. If it could be created in combination with a specialisation in the first instance at the national level - possibly including cooperation rules among the courts - and in combination with a unitary set of procedural rules, in the end it could quite possibly achieve the same results with regard to a unified interpretation as a common court with two instances. It would just take longer, since many cases do not reach the second instance. However, the existing differences in the national legal systems, practice and experience, and many national deficiencies would remain. In addition, multiple litigation regarding the same European patent, and the negative effects of *forum shopping* could not be avoided with a common court of appeals only.

Therefore, a common patent court with two instances applying its own rules of procedure would be the best and fastest way forward in creating uniform jurisprudence concerning European patent law.

Based on the mandate of the 1999 Intergovernmental Conference of the EPC contracting states, the Working Party on Litigation elaborated a draft for an optional European Patent Litigation Agreement (EPLA) which would create a two-instance European Patent Court dealing with disputes in relation to European patents. The optional approach makes it clear that every EPC contracting state would decide on its own motion whether it would like to accede to the agreement.

In the draft EPLA it is proposed to create a decentralised first instance with a Central Division and up to three Regional Divisions in the contracting states. In order to ensure uniform jurisprudence among the different divisions, it was decided that the panels will be composed of experienced legal, as well as technical, judges from different states. Legally qualified judges will be permanently assigned to a certain division in order to better ensure the predictability of decisions, consistent case law and a high standard of quality. Under the proposed European patent litigation system judges are encouraged to communicate and cooperate with each other. They will have to depart from their own legal systems and policy environment and find ways to bring together divergent views in an objective way and within the borders of the law set by the legislator. The centralised court of appeal will ensure that the possibility of even small differences of jurisprudence in a decentralised structure is eliminated. The unified jurisprudence on European patent law will also impact on the interpretation of national and European patent law by judges in states that would not accede to the EPLA. It seems clear that multiple litigation concerning European patents and the problems with regard to *forum shopping* in Europe cannot be entirely solved by the EPLA as long as it is optional and not all EPC contracting states join the agreement. However, with regard to patent litigation, if some of the major states acceded to the EPLA, the European Patent Court would necessarily deal with a great part of today's litigation concerning European patents.

The approach of the European Commission for a Community Patent Court based on the proposal of 2003 would clearly contribute to the uniformity of the interpretation of

European patent law. However, the extent will not least depend on whether the Community patent and its court would be sufficiently attractive and whether it is actually used. The better the Community patent serves the interest of the users, and the better the quality of the appointed judges, the greater will be the chance of a uniform jurisprudence with regard to European patent law. The best solution vis-à-vis a uniform interpretation of European patent law would be if the Community Patent Court could also deal with European patents. However, a Community patent, including a Community Patent Court, could only be achieved if all 27 EU member states unanimously agreed to the final compromise. This is very difficult, as history has taught us. Therefore, the fastest way forward for the creation of a common patent court would clearly be the implementation of the optional EPLA, with certain changes if necessary in order to comply with the EU legal framework and to ensure that the European Patent Court will be replaced by the future Community Patent Court as soon as the EU agrees to the Community patent. Experience has showed that only an optional system, which may be set in motion by a limited number of interested states, offers appropriate solutions and acceptable time perspectives for implementation.

As astutely observed by Wild²⁴⁵⁶, "*the bottom line is that something will need to be done at some stage to clarify how European patent law should be interpreted. Whether this is through a Community patent, a pan-European litigation system, a series of directives or a combination of them, we cannot have the situation in which different parts of what is supposed to be a single market either do, or have the ability to do, interpret patent law in completely different ways. If such a situation does persist, then the entire economic premise of the European Union is completely undermined. It seems to be that it is that serious.*"

²⁴⁵⁶ See Wild Joff, EPO board attacks UK judge as software row flares up again, IAM Magazine, 15 June 2007.

SAMENVATTING EN CONCLUSIES

Het Europees Octrooiverdrag (EOV) is een internationaal verdrag dat onder andere een rechtssysteem in het leven heeft geroepen, met inbegrip van materieel recht, voor de verlening van octrooien. Als zodanig is het bindend internationaal eenvormig recht, eenvormig “Europees octrooirecht”. Alle autoriteiten die te maken hebben met Europese octrooien, zijn daarom verplicht het EOV en het daarmee overeenkomende nationale recht ter implementatie van het EOV vanuit een internationaal gezichtspunt uit te leggen op basis van de *ratio* van het EOV en met het oog op het tot stand brengen van eenvormige uitleg buiten de eigen grenzen. Dit is in het bijzonder van belang als zij deze methode toepassen in een nietigheids- of inbreukprocedure zowel bij de bepaling van de beschermingsomvang (art. 69 EOV) en de nietigheidsgronden (art. 138 EOV), als ten aanzien van de daaraan gerelateerde vereisten voor octrooieerbaarheid (artikelen 52-57 EOV) van een Europees octrooi. Het feit dat het Europees octrooi een “bundeloctrooi” is en de verschillende delen van het octrooi dus een verschillend lot kunnen hebben, heeft geen invloed op deze algemene verplichting. Niettemin hebben sommige gerechten van de verdragsluitende staten van het EOV deze plicht veronachtzaamd en het Europese octrooirecht uitgelegd vanuit een zuiver nationaal perspectief. Andere gerechten hebben de vereiste rechtsvergelijkende uitleg toegepast door elkaars rechtsopvattingen en rechtspraak in de praktijk in aanmerking te nemen. Desondanks kon eenvormige uitleg niet volledig worden bereikt, met rechtsonzekerheid als gevolg, terwijl een gemeenschappelijk Europees gerecht dat rechtzekerheid zou kunnen verschaffen, thans nog niet bestaat.

Het Gemeenschapsoctrooiverdrag (CPC) van het midden van de jaren zeventig van de vorige eeuw had een gemeenschappelijk octrooigerecht in het leven moeten roepen. Dit verdrag voorzag in de schepping van een gemeenschapsoctrooi, een gemeenschappelijk hof van beroep (COPAC) en nationale rechtbanken die zouden functioneren als “gemeenschappelijk gerecht van eerste aanleg”. Het COPAC zou geen rechtsmacht hebben ten aanzien van Europese octrooien. Hoewel de jurisprudentie van het COPAC niet bindend zou zijn voor de uitleg van Europese octrooien, zou deze natuurlijk wel hebben bijgedragen aan de eenvormige uitleg; alle gronden voor nietigverklaring van een Europees octrooi zouden immers ook gelden voor een gemeenschapsoctrooi terwijl voorts de beschermingsomvang van een gemeenschapsoctrooi volgens dezelfde voorschriften

zou worden bepaald. Het feit dat op het nationale niveau teveel gerechten zouden functioneren als gemeenschappelijke gerechten – met het inherente risico van een gebrek aan kennis van het octrooirecht en octrooirechtspraak als gevolg van het beperkte aantal octrooigeschillen in Europa – zou de inspanningen om te komen tot eenvormige uitleg van het Europese octrooirecht hebben vertraagd en zou hebben geleid tot veel *forum shopping*. Uiteenlopende uitleg zou echter niet te vermijden zijn geweest, vooral niet vanwege het feit dat niet alle verdragsstaten van het EOV tevens lidstaten zijn van de Europese Unie.

Het ontbreken van een gemeenschappelijk octrooigerecht doet de vraag rijzen of er alternatieve maatregelen zijn ter ondersteuning van het doel van eenvormige uitleg van het Europese octrooirecht door de verschillende instanties die de voorschriften van het EOV moeten toepassen. De oprichting van een gespecialiseerd octrooigerecht op nationaal niveau is zo een maatregel die een gemeenschappelijke uitleg naderbij brengt. Dit biedt niet alleen een betere waarborg van grotere kennis van het in hoge mate technische (Europese) octrooirecht als zodanig, maar maakt het ook eenvoudiger om tot eenvormige uitleg te komen aangezien slechts een beperkt aantal instanties met dit recht te maken krijgt. Verschillende voorbeelden op het nationale niveau in Europa laten zien dat een dergelijke gespecialiseerd gerecht kan worden gerealiseerd hetzij door beperking van het aantal gerechten dat octrooigeschillen beoordeelt, hetzij door in ruime mate *forum shopping* toe te staan waardoor het voor bepaalde gerechten mogelijk wordt bijzondere kennis te ontwikkelen dankzij het feit dat zij door partijen regelmatig worden uitgekozen om octrooigeschillen te behandelen. Om kwalitatief goede rechtspraak binnen het gehele territoir te bereiken en in stand te houden lijkt het echter duidelijk dat een gezonde balans moet bestaan tussen enerzijds het aantal gerechten dat octrooigeschillen behandelt, en anderzijds het aantal zaken.

Hoewel *forum shopping* kan leiden tot rechtspraak van grote kwaliteit, is daaraan een groot aantal ongewenste neveneffecten verbonden die erg duidelijk worden in grensoverschrijdende (octrooi)zaken, dat wil zeggen: wanneer een nationaal gerecht rechtsmacht heeft met betrekking tot inbreuk op een deel van een Europees octrooi met gevolgen in een andere staat. *Forum shopping* kan ertoe leiden dat de keuze voor bepaalde gerechten voortkomt uit twijfelachtige bedoelingen. Aangezien *forum shopping* echter ook de eiser op voorsprong zet ten opzichte van de gedaagde, kan *forum shopping*

bovendien in gevaar brengen de beginselen van een eerlijk proces en van een gelijkwaardige positie van partijen waarbij beide partijen recht hebben op een evenwichtig vonnis en rechtszekerheid. Dit zou kunnen worden voorkomen door de invoering van een beperkte *forum non conveniens* doctrine in Verordening 44/2001 en het Verdrag van Lugano die verzekert dat het door de eiser aangezochte gerecht de mogelijkheid heeft de zaak te verwijzen naar een gerecht dat deze fundamentele beginselen beter kan garanderen door middel van samenwerking tussen de gerechten.

Uiteindelijk is rechterlijke samenwerking tussen de verschillende instanties van doorslaggevende betekenis voor het bereiken van eenvormige uitleg van het recht. De inbreng van wetenschappers en mensen uit de praktijk kan dit doel mede ondersteunen. Niettemin zullen uitsluitend samenwerking en uitwisseling van gezichtspunten onder rechters niet leiden tot volledige harmonisatie van de rechtspraak: op zeker moment moeten rechters vonnis wijzen en een keuze maken voor de ene of de andere juridische positie en rechtsopvatting. De keuze berust op hun overtuiging dat zij het recht op de juiste wijze uitleggen. Indien de rechters het gevoel hadden dat zij al in voldoende mate waren opgeschoven in de richting van de ene of de andere juridische positie, zou het heel moeilijk zijn nog verder te bewegen in de richting van eenvormige uitleg. Dit zou zelfs het geval zijn indien de verschillende instanties gemeenschappelijke uitlegregels zouden toepassen, indien het materiële recht nog verder was geharmoniseerd, of indien de verschillende procedures zouden worden gevoerd met inachtneming van gemeenschappelijke regels. Toch is het zo dat hoe meer de procedures geünificeerd zijn, des te groter zijn de kansen dat de rechters tot dezelfde uitkomsten komen door het uitleggen van het recht op een eenvormige wijze.

Nationale autoriteiten zouden kunnen overwegen om in het kader van uitwisseling buitenlandse rechters in te schakelen bij de beslechting van geschillen over Europese octrooien. Dit zou heel nuttig kunnen blijken te zijn voor de totstandkoming van gemeenschappelijke rechtspraak, maar de plaatselijke rechters zullen dan wel open moeten staan voor nieuwe gezichtspunten en opvattingen en bereid moeten zijn hun standpunten te wijzigen.

De directe inschakeling van buitenlandse rechters op het nationale niveau als onderdeel van het nationale besluitvormingsproces lijkt een veelbelovender manier van werken aan

eenvormige uitleg dan zuiver nationale gerechten de mogelijkheid te bieden (op een reguliere basis) vonnissen te wijzen die effect hebben in het buitenland. Zulke inmengingen door middel van het uitspreken van grensoverschrijdende verboden zag men in toenemende mate bij, onder andere, Nederlandse gerechten die daarmee wilden voorkomen dat over dezelfde inbreuk op een Europees octrooi meerdere procedures in verschillende landen zouden moeten worden gevoerd, en dat daarover uiteenlopende uitspraken zouden worden gedaan. Aangezien een grensoverschrijdend verbod in Europa in het algemeen *eo ipso* erkend en tenuitvoergelegd dient te worden, heeft een vonnis van een buitenlandse rechter een direct effect op het eigen grondgebied. De omstandigheid dat buitenlandse nationale rechterlijke instanties het (Europese) octrooirecht toepassen en uitleggen met effecten in een andere staat, leidde echter tot stevige kritiek, vooral omdat die instanties octrooi- en daarmee verbonden economisch beleid konden maken met effect op buitenlands territorium. Een dergelijke inmenging in de staatssoevereiniteit werd verworpen, zelfs indien de primaire bedoeling van deze inmenging voortkwam uit de plicht te werken aan de totstandkoming van eenvormige uitleg van het Europese octrooirecht. Indien men “buitenlandse” rechters deel laat uitmaken van het nationale gerecht, zou men de indruk kunnen vermijden dat gezichtspunten en opvattingen “van buiten” zouden worden opgelegd aan een land en de gerechten. Dit zou bovendien rechters dwingen de dialoog aan te gaan over de weg naar eenvormige rechtspraak.

In ieder geval heeft het Hof van Justitie van de Europese Gemeenschappen inmiddels de grensoverschrijdende octrooirechtspraak door nationale gerechten in grote mate tot een theoretische mogelijkheid gemaakt. De belangrijkste redenen daarvoor lijken te zijn gelegen in de verplichting van het Hof ervoor te zorgen dat binnen de gemeenschappelijke markt eenvormig recht geldt. In de visie van het Hof moet dit vooral tot stand worden gebracht door de instellingen van de Gemeenschap en niet door nationale autoriteiten te voorzien van grensoverschrijdende bevoegdheden: hoe minder nationale autoriteiten dergelijke bevoegdheden hebben, des te groter worden de wens en de noodzaak om een gemeenschappelijke (civiel)rechterlijke organisatie in het leven te roepen met geharmoniseerde procedures.

Uit de analyse is gebleken dat arbitrage, mediation en andere vormen van alternatieve geschillenbeslechting slechts in beperkte mate zullen bijdragen aan eenvormige uitleg van Europees octrooirecht. De belangrijkste redenen van deze conclusie zijn het – in het

algemeen – vertrouwelijke karakter van arbitrage en het beperkte aantal octrooizaken. Niettemin zou arbitrage de kosten en complicaties kunnen reduceren die verbonden zijn aan het procederen over dezelfde inbreuk in verschillende landen met uiteenlopende procedures. Arbitrage zou ook het risico van tegenstrijdige beslissingen kunnen beperken, en rechtszekerheid kunnen vergroten.

Onder bepaalde omstandigheden zou het in het leven roepen van een internationale instantie waaraan vragen van uitleg kunnen worden voorgelegd, een belangrijke stap vooruit kunnen zijn in de richting van eenvormige uitleg van het Europese octrooirecht. Daarvoor is in de eerste plaats nodig dat een belangrijk aantal verdragsstaten van het EOV met een aanzienlijk aantal octrooizaken een dergelijke instantie aanvaardt, en voorts dat de nationale autoriteiten daadwerkelijk vragen van uitleg aan die instantie voorleggen. Daarenboven zouden de nationale instanties zich tenminste verplicht moeten voelen de meningen van de internationale instantie tot op zekere hoogte te aanvaarden. Veelbelovende resultaten zouden daarom worden bereikt indien de verwijzing verplicht zou zijn en de meningen van de internationale instantie bindend zouden zijn. Een model dat alleen gebaseerd is op wil en dat geen druk uitoefent op de nationale autoriteiten lijkt een tamelijk zwakke optie voor de eenmaking van uitleg.

Een nog beter middel om te komen tot eenvormige uitleg zou een gemeenschappelijk gerecht van beroep zijn. Als dit in het leven zou kunnen worden geroepen tezamen met de specialisering in de eerste aanleg op het nationale niveau – zo mogelijk met inbegrip van regels inzake samenwerking tussen de gerechten – en tezamen met een pakket van identieke procedureregels, zouden daarmee uiteindelijk heel goed dezelfde resultaten kunnen worden bereikt met betrekking tot eenvormige uitleg als met een gemeenschappelijk gerecht met twee instanties. De bestaande verschillen tussen de nationale rechtssystemen, praktijk en ervaring, alsmede vele nationale tekortkomingen zouden dan echter blijven bestaan. Bovendien zouden het procederen in verschillende landen over hetzelfde Europese octrooi en de negatieve effecten van *forum shopping* niet kunnen worden vermeden met uitsluitend een gemeenschappelijk hof van beroep.

Daarom zou een gemeenschappelijk gerecht met twee instanties dat zijn eigen procesrecht toepast, de beste en snelste weg zijn naar de totstandkoming van eenvormige rechtspraak met betrekking tot Europese octrooien.

Op basis van het mandaat van de Intergouvernementele Conferentie van de EOV-verdragsstaten heeft de Working Party on Litigation een ontwerp voor een optionele European Patent Litigation Agreement (EPLA) uitgewerkt die een Europees octrooigerecht met twee instanties in het leven zou roepen voor de behandeling van geschillen over Europese octrooien. Omdat het gaat om een optionele Agreement, is duidelijk dat elke verdragsluitende staat zelf moet beslissen of hij tot de Agreement zou willen toetreden.

In het EPLA-ontwerp wordt voorgesteld een gedecentraliseerde eerste instantie in het leven te roepen met een Central Division en maximaal drie Regional Divisions in de verdragsluitende staten. Ter verzekering van eenvormige rechtspraak door de verschillende Divisions werd besloten dat de panels worden samengesteld uit ervaren juridische en technische rechters uit verschillende staten. De juridisch gekwalificeerde rechters zullen permanent worden toegewezen aan een bepaalde Division met het oog op het beter verzekeren van de voorspelbaarheid van de beslissingen, van consistente rechtspraak en een hoge kwaliteit. Onder het voorgestelde Europese systeem van octrooirechtspraak worden rechters aangemoedigd met elkaar te communiceren en samen te werken. Zij moeten loskomen van hun eigen juridische systemen en beleidsomgeving en wegen vinden om uiteenlopende visies bij elkaar te brengen op een objectieve manier en binnen de grenzen van het recht zoals vastgelegd door de regelgever. Het gecentraliseerde gerecht van beroep zal ervoor instaan dat de mogelijkheid van zelfs kleine verschillen in de rechtspraak in de gedecentraliseerde structuur wordt geëlimineerd. De geünificeerde rechtspraak over Europees octrooirecht zal ook invloed hebben op de uitleg van nationaal en Europees octrooirecht door rechters in de staten die niet wilden toetreden tot de EPLA. Het moge duidelijk zijn dat het probleem van het moeten procederen in verschillende landen en het probleem van *forum shopping* in Europa niet geheel kunnen worden opgelost zolang de EPLA optioneel is en niet alle verdragsluitende staten van het EOV zich bij de EPLA aansluiten. Indien echter enige, voor de octrooirechtspraak belangrijke landen zouden toetreden tot EPLA, zou het Europese octrooigerecht uit de aard der zaak een groot deel van de tegenwoordige rechtspraak inzake Europese octrooien voor zijn rekening nemen.

Het is duidelijk dat de benadering van de Europese Commissie ten aanzien van een Gemeenschapsoctrooigerecht gebaseerd op het voorstel van 2003 zou bijdragen aan de

eenvormigheid van de uitleg van het Europese octrooirecht. De mate waarin dat zou gebeuren zal echter vooral afhankelijk zijn van de aantrekkelijkheid van het gemeenschapsoctrooi en het gemeenschapsgerecht alsmede van de mate waarin daarvan gebruik wordt gemaakt. Hoe beter het gemeenschapsoctrooi het belang van de gebruikers dient, en hoe beter de kwaliteit van de benoemde rechters, des te groter zal de kans zijn dat eenvormige rechtspraak met betrekking tot Europees octrooirecht tot stand komt. De beste oplossing met betrekking tot eenvormige uitleg van Europees octrooirecht zou zijn als het gemeenschapsoctrooigerecht zich ook met Europese octrooien zou kunnen bezighouden. Een gemeenschapsoctrooi, met inbegrip van een gemeenschapsoctrooigerecht, kan echter alleen tot stand komen als alle EU-landen het unaniem eens zouden worden over het laatste compromis. De geschiedenis heeft ons geleerd dat dit zeer moeilijk is. Het is daarom duidelijk dat de snelste manier om te komen tot een gemeenschapsoctrooigerecht eruit bestaat dat eerst het optionele EPLA tot stand komt, met bepaalde wijzigingen indien deze noodzakelijk zijn om te voldoen aan het juridische EU-kader en om te verzekeren dat het Europese octrooigerecht zal worden vervangen door het toekomstige Gemeenschapsoctrooigerecht zodra de EU overeenstemming bereikt over het gemeenschapsoctrooi. De ervaring leert dat alleen een optioneel systeem, dat in het leven kan worden geroepen door een beperkt aantal geïnteresseerde landen, passende oplossingen biedt en perspectieven op implementatie binnen een aanvaardbare termijn.

Zoals *Wild*²⁴⁵⁷ scherpzinnig opmerkte: "*the bottom line is that something will need to be done at some stage to clarify how European patent law should be interpreted. Whether this is through a Community patent, a pan-European litigation system, a series of directives or a combination of them, we cannot have the situation in which different parts of what is supposed to be a single market either do, or have the ability to do, interpret patent law in completely different ways. If such a situation does persist, then the entire economic premise of the European Union is completely undermined. It seems to be that it is that serious.*"

²⁴⁵⁷ See Wild Joff, EPO board attacks UK judge as software row flares up again, IAM Magazine, 15 June 2007.

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