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Subject : The Separation of Invalidity and Infringement Proceedings and the Use of
Technical Judges in a European Patent Court System

1. Introduction

In the context of the open consultation on patent policy carried out by the European Commission in the year 2006, Europe's innovative industry called inter alia for the establishment of an efficient patent court system.

In several meetings during the year 2007, the Council Working Group on Patents discussed a number of aspects of such a court system. Two aspects that were also examined in the preparatory papers and addressed in the consultations held in this regard by the Portuguese Council Presidency are the separation of invalidity and infringement proceedings and the use of technical judges. These two issues which are addressed in the Presidency non-paper (ST 13675/07) are interlinked.

Both elements contribute to lending a court system the practical value-added demanded by industry and facilitate a political compromise.

2. The separation of invalidity actions and infringement actions

If invalidity actions are handled in distinct proceedings subject to the exclusive jurisdiction of a central judicial entity and infringement actions are handled separately in decentralized chambers, the procedural rules to be applied in each case can be better tailored to the respective distinctive features of the subject of the proceedings:

- The subject of invalidity proceedings is the continued existence of a legal title granted by a sovereign act, which is why the invalidity proceedings must entail procedural measures to comprehend and – if necessary – question the decision of the granting authority . In the case of patents granted by the European Patent Office, in contrast to the registration procedure in effect in some Member States, the patent application is subject to a preliminary substantive examination. Judicial review of this technical decision of the granting authority presupposes that the court is equipped with resources enabling it to reconsider the granting authority's reasoning.
- In invalidity proceedings, a decision is taken on whether the patent holder is to be divested of the rights associated with the patent with erga omnes effect within the entire area of applicability of the patent, contrary to infringement proceedings, in which only the right holder and the defendant charged with infringement are involved. Thus, infringement proceedings have a direct effect only inter partes, i.e. they only concern the actual parties to the proceeding.
- The decision hinges on a qualified technical evaluation of the patentability of the protected invention.
- Here technical expertise plays a different – more important – role in the decision-making process than in infringement proceedings; in the latter, the plaintiff patent holder can assume that the effectiveness of the patent and the patentability of the protected invention have been established.

- The different character of invalidity and infringement actions has already been recognized in the *acquis communautaire*: The general provisions on jurisdiction of the Brussels I Regulation are applicable to infringement actions but not, however, to invalidity actions because the provisions of the Regulation are not suitable for proceedings in which the revocation of rights granted by the state is at issue. This has been stressed recently by the ECJ (C-4/03, 13.07.2006).

The separation of invalidity and infringement actions can also help to resolve some politically disputed issues:

- The use of technical judges is of particular importance for invalidity proceedings and should thus be realised preferably for these proceedings.
- Concentrating of proceedings involving a decision on the validity of a European patent or a future Community patent for its entire area of applicability at a central court could enable a more concentrated establishment of technical expertise.
- By limiting the competence of the regional chambers to infringement actions simplifies the establishment of such chambers is simplified, since they need not fulfil certain conditions. Even with limited numbers of cases the regional chambers can acquire the necessary expertise since they can concentrate on issues of infringement and the legal consequences of infringement.
- The creation of separate rules of procedure for infringement cases on the one hand and invalidity cases on the other hand which are of uniform character for both kinds of procedures simplifies the formulation of such rules. Both kinds of procedures must entail different measures to take due account of the different effects of judgments: “*inter partes*” in infringement cases and “*erga omnes*” in invalidity cases.
- Finally, under a system of separation it also appears easier to reach agreement on the language(s) to be used in the proceedings. In invalidity proceedings, due account can be taken of the fact that the proceeding focuses solely on the validity of the patent notably granted in one of the three official languages of the EPO. Invalidity proceedings are more

efficient if they are conducted in the language in which the patent has been granted. Thus mirroring the EPO official languages in court proceedings is of particular importance for invalidity cases.

Without the separation of invalidity cases and infringement cases suggested in Doc. 13675/07 it will hardly be possible to reach compromises on the aforementioned points which will both satisfactorily meet the practical needs of the parties in these cases and be politically acceptable to the Member States.

A separation of invalidity and infringement cases requires accompanying rules in order to ensure a smooth functioning of patent jurisdiction: Among other things, upon appeal, both types of proceedings must be placed under the jurisdiction of a single court in order to ensure consistency of rulings. Furthermore, arrangements must be made for circumstances in which the effectiveness of a patent that is claimed to have been infringed is concurrently contested in independent invalidity proceedings or through the raising of an invalidity objection. In such cases the infringement proceedings should only be suspended if the court hearing the infringement proceedings concludes after a cursory examination that the invalidity action has prospects of success. If, by contrast, one were to only permit the court to continue the infringement proceedings if the invalidity action was deemed to have been frivolously raised, such a rule would invite patent infringers to obstructively bring invalidity actions.

3. Use of technical judges

Participation of technical judges in the decision-making process is advisable in invalidity proceedings for the following reasons:

- Even prior to the oral proceedings technical judges can help to ensure that the technical issues of relevance for the decision are also correctly set out to the legally qualified judges.
- They can direct targeted questions to the technically qualified parties.
- They ensure that the court has the same level of technical expertise as the authority whose technically well-founded decision is contested in the proceedings.

- Technical judges can more quickly determine whether a new submission of a party justifies a further delay in the proceedings.
- In many cases, technical judges can make the use of experts dispensable.
- By virtue of these advantages technical judges contribute simultaneously to expeditious and well-founded decision-making.

It is important that the recruitment procedures for technical judges ensure that they are just as independent and impartial as legally qualified judges as stated in the Presidency non-paper (ST 13675/07 No. 10). The use of technical judges should strengthen the right of plaintiffs and defendants to effectively make their positions heard in fair and impartial proceedings.
