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OPINION OF THE LEGAL SERVICE*

To : The Working Party on Intellectual Property

Subject : Draft Agreement on the European Union Patent Judiciary
- compatibility of the draft Agreement with the EC Treaty
- possible request to the EC Court of Justice for an opinion (Article 300(6) EC)

A) Introduction

1. The Working Party on Intellectual Property has examined a draft Agreement on the European Union Patent Judiciary¹ (hereinafter "the draft Agreement"), elaborated by the Presidency of the Council. The text lays down an international agreement to be concluded by the Member States and the Community and to which other States parties to the European Patent Convention may accede. The draft Agreement is aimed at setting up a new jurisdiction for disputes concerning European patents and Community patents whose decisions would apply throughout the Community (and other European States). In the course of the discussions on

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¹ Document of the Council 9124/08. A revised text has just been circulated by the Presidency on 4 November 2008 in document 14970/08.

the draft Agreement, the Working Party requested the opinion of the Legal Service on the competence of the Community to conclude such an agreement as well as to its compatibility with the EC Treaty as regards to the tasks which would be assigned by this Agreement to the Court of Justice of the European Communities.

B) Background

2. No Community patent exists as of today. However, texts aimed at creating it are being examined by the Council; these texts are based on:
 - the creation of a unitary Community patent title by a Community Regulation. That Regulation would cover the rights conferred by the patent title, possible actions for the enforcement of these rights, grounds for invalidity and the mechanisms for the granting and renewal of the patent title. It is foreseen that the grant of Community patents will be carried out by the European Patent Office;
 - the adhesion of the Community to the European Patent Convention² (hereinafter, "the EPC"), which would have to be amended accordingly. The European Patent Office would thus grant both European and Community Patents;
 - the establishment of a Community patent jurisdiction, through conferring on the Court of Justice jurisdiction in disputes relating to the infringement and validity of Community patents. The proposed legal basis for the decision conferring jurisdiction to the Court is Article 229a EC. Furthermore, pursuant to Article 225a EC, the Council would establish the Community Patent Court, a judicial panel attached to the Court of First Instance of the European Communities.

² The European Patent Convention (hereinafter "EPC"), whose official name is "Convention on the Grant of European Patents", was signed in Munich on 5 October 1973. All Member States are parties of the Convention, as well as Switzerland, Croatia, Iceland, Liechtenstein, Monaco, Norway and Turkey.

3. The proposals for a Council Regulation and Council decisions referred to in point 2, on which the Council could not agree at its meeting on may 2004, are still on the table of the Council. The Presidency tabled on 23 May 2008 a Presidency Working Document on the revised proposal for a Council Regulation on the Community patent³.
4. Under the EPC, a patent is granted in all States which are parties to the Convention and which are designated in the application for a patent. Patents granted by the European Patent Office are merely a bundle of identical national patents conferring national protection⁴. The disputes relating to the possible infringement of a patent right and/or revocation of a European patent must be judged by national courts, hence the possibility for multiple litigation. Similarly, actions for damages or compensation in respect of the protection conferred by a granted European patent must be submitted to national courts.

C) The draft Agreement on the European Union Patent Judiciary

5. The draft Agreement as elaborated by the Presidency is based on the following elements:
 - the establishment of a new jurisdictional system, to be named "European Union Patent Court", composed of a court of first instance - comprising a central division as well as local and/or regional divisions - and a court of appeal;
 - the new patents courts shall have exclusive competence in respect of actions for infringement of patents or for a declaration of non-infringement, actions or counterclaims for revocation of patents, actions for damages, actions relating to the use of the invention prior to the granting of the patent or to the right based on prior use of the patent and other actions concerning Community patents and related to licences or supplementary protection certificates;
 - the jurisdiction of the new patents courts shall cover both the European patents and the Community patents (when created);

³ Document of the Council 9465/08.

⁴ Order, case T-295/05, Document Security Systems, ECR [2007] p. II-2835, paragraph 53.

- decisions given by the new patents court of appeal may be subject to further appeal before the Court of Justice of the European Communities on points of law only ("cassation") in cases to be defined in the Statute.

6. The Commission services have participated in the discussions within the Working Party. However, the Commission has not made any recommendation for the Council - pursuant to Article 300(1) EC - to authorise the Commission to open the necessary negotiation⁵.

D) The Community's competence and the possible legal basis to conclude the draft Agreement

DELETED

⁵ Up to now, the Commission has not withdrawn or amended its proposals for a Council Decision establishing the Community Patent Court and concerning appeals before the Court of First Instance (document of the Council 5189/04) and for a Council Decision conferring jurisdiction on the Court of Justice in disputes relating to the Community patent (document of the Council 5190/04), referred to in point 2, last indent, above. Such proposals seem incompatible with the draft Agreement.

DELETED

E) The compatibility of the draft Agreement with the EC Treaty

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F) Conclusions

DELETED
