

**Preliminary  
set of provisions  
for the**

**Rules of Procedure (“Rules”) of the Unified Patent Court**

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| <b>Status</b> |
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## Abbreviations

**EPC:** European Patent Convention

**Regulation (EU) No 1257/2012:** Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (OJEU L 361, 31.12.2012, p. 1)

**Regulation (EU) No 1260/2012:** Regulation (EU) No 1260/2012 of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements (OJEU L 361, 31.12.2012, p. 89)

**Regulation (EU) No 1215/2012:** Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters

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## **PREAMBLE**

1. The Court shall conduct proceedings in accordance with the Agreement on a Unified Patent Court (“the Agreement”), the Statute of the Unified Patent Court (“the Statute”) and these Rules. In the event of a conflict between the provisions of the Agreement and/or the Statute on the one hand and of the Rules on the other hand, the provisions of the Agreement and/or the Statute shall prevail.
2. The Rules shall be applied and interpreted in accordance with Articles 41(3), 42 and 52(1) of the Agreement on the basis of the principles of proportionality, flexibility, fairness and equity.
3. Proportionality shall be ensured by giving due consideration to the nature and complexity of each action and its importance.
4. Flexibility shall be ensured by applying all procedural rules in a flexible and balanced manner with the required level of discretion for the judges to organise the proceedings in the most efficient and cost effective manner.
5. Fairness and equity shall be ensured by having regard to the legitimate interests of all parties.
6. In accordance with these principles, the Court shall apply and interpret the Rules in a way which shall ensure decisions of the highest quality.
7. In accordance with these principles, proceedings shall be conducted in a way which will normally allow the final oral hearing on the issues of infringement and validity at first instance to take place within one year whilst recognising that complex actions may require more time and procedural steps and simple actions less time and fewer procedural steps. Decisions on costs and/or damages may take place at the same time or as soon as practicable thereafter. Case management shall be organised in accordance with these objectives. Parties shall cooperate with the Court and set out their full case as early as possible in the proceedings.
8. The Court shall endeavour to ensure consistent application and interpretation of these Rules by all first instance divisions and the Court of Appeal. Due consideration shall also be given to this objective in any decision concerning leave to appeal against procedural orders.

## **APPLICATION AND INTERPRETATION OF THE RULES**

### **Rule 1 – Application of the Rules and general principles of interpretation**

1. The Court shall conduct proceedings in accordance with the Agreement on a Unified Patent Court (“the Agreement”), the Statute of the Unified Patent Court (“the Statute”) and these Rules, which include the Preamble to these Rules and the principles set out therein. In the event of a conflict between the provisions of the Agreement and/or the Statute on the one hand and of the Rules on the other hand, the provisions of the Agreement and/or the Statute shall prevail.

2. Where these Rules provide for the Court to perform any act other than an act exclusively reserved for a panel of the Court, the President of the Court of First Instance or the President of the Court of Appeal, that act may be performed by:

(a) the presiding judge or the judge-rapporteur of the panel to which the action has been assigned;

(b) a single legally qualified judge where the action has been assigned to a single judge;

(c) the standing judge designated pursuant to Rule 345.5.

3. References to persons in these Rules may apply to legal persons as well as natural persons. Words importing the masculine gender shall include the feminine and vice versa. Unless the contrary intention appears, words in the singular include the plural and vice versa.

*Relation with Agreement: Article 8(7)*

*Relation with Statute: Article 19(3) and (4)*

### **Rule 2 – Supplementary protection certificate**

1. Subject to paragraph 2, in these Rules with the exception of Rule 5 the expression “patent” and “proprietor” shall whenever appropriate include, respectively, a supplementary protection certificate as defined in Article 2(h) of the Agreement and granted in respect of the patent and the holder of such certificate.

2. References in these Rules to the language in which the patent was granted shall mean that language and not the language in which a supplementary protection certificate in respect of the patent was granted.

### **Rule 3 – Power of staff of the Registry and a sub-registry to perform functions of the Registry**

Where these Rules refer to the Registry or Registrar and provide for the Registry to perform any act that reference shall include – where applicable – the Deputy-Registrar and the relevant sub-registry and that act may be performed by the Registrar, the Deputy-Registrar or by a member of staff of the Registry or sub-registry of the relevant division.

### **Rule 4 – Lodging of documents**

1. Written pleadings and other documents shall be lodged at the Registry or relevant sub-registry in electronic form. Parties shall make use of the official forms available online. The receipt of documents shall be confirmed by the automatic issue of an electronic receipt, which shall indicate the date and local time of receipt.

2. Where it is not possible to lodge a document electronically for any reason a party may lodge the document in hard-copy form. An electronic copy of the document shall be lodged as soon as practicable thereafter.

*Relation with Agreement: Article 44*

### **Rule 5 – Lodging of an Application to opt out and withdrawal of an opt-out**

1. (a) The proprietor of a European patent (including a European patent that has expired) or the applicant for a published application for a European patent (hereinafter in this Rule 5 an “application”) who wishes to opt out that patent or application from the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall lodge an Application (hereinafter in this Rule 5 an “Application to opt out”) with the Registry.

(b) Where the patent or application is owned by two or more proprietors or applicants, all proprietors or applicants shall lodge the Application to opt out. Where the person(s) lodging an Application to opt out is not recorded as the proprietor(s) or applicant(s) in the registers referred to in Rule 8.5(a) and (b), respectively, the person(s) shall lodge a declaration pursuant to paragraph 3(e).

(c) The Application to opt out shall be made in respect of all of the Contracting Member States for which the European patent has been granted or which have been designated in the application.

2. (a) An Application to opt out or an Application to withdraw an opt-out pursuant to paragraph 8 (hereinafter in this Rule 5 an “Application to withdraw”) shall extend to any supplementary protection certificate(s) based on the European patent.

(b) Where any such supplementary protection certificate has been granted at the date of lodging the Application to opt out or the Application to withdraw, the holder(s) of the supplementary protection certificate(s) shall, if different from the proprietor(s) of the patent, lodge the Application to opt out or the Application to withdraw together with the proprietor(s).

(c) Where any such supplementary protection certificate is granted subsequent to lodging the Application to opt out, the opt-out shall take effect automatically on grant of said supplementary protection certificate(s).

(d) Paragraphs 7 and 9 shall apply *mutatis mutandis*. For the purposes of paragraphs 7 and 9, reference to actions

(i) in respect of a European patent shall apply to all supplementary protection certificates based on that European patent, and

(ii) in respect of a supplementary protection certificate shall apply to the European patent on which such supplementary protection certificate is based and

(iii) in respect of a supplementary protection certificate shall apply to all other supplementary protection certificates based on the same European patent.

(e) For the avoidance of doubt, it is not possible to opt out supplementary protection certificates, whether granted by the authorities of a Contracting Member State or otherwise, based on a European patent with unitary effect.

3. The Application to opt out shall contain:

(a) the name of the proprietor or proprietors or applicant (or applicants) for the European patent (or patents) or application (or applications) and of the holder (or holders) of any supplementary protection certificate (or supplementary protection certificates) based on the European patent (or patents) in question, and all relevant postal and, where applicable, electronic addresses;

(b) where such proprietor(s), applicant(s) or holder(s) have appointed a representative, the name and postal address and electronic address for service of the representative;

(c) details of the patent (or patents) and/or application (or applications) including the number (or numbers);

(d) details of any supplementary protection certificate (or supplementary protection certificates) granted based on the patent (or patents) concerned, including the number (or numbers); and

(e) for the purposes of paragraph 1(b), a Declaration of proprietorship that the person(s) lodging the Application to opt out is/are the proprietor(s) or applicant(s) pursuant to Rule 8.5 and entitled to lodge the Application to opt out.

4. Rule 8 shall not apply to Applications to opt out and to Applications to withdraw made pursuant to this Rule 5. Where a representative is appointed, such a representative may include professional representatives and legal practitioners as defined in Article 134 EPC in addition to those referred to in Article 48 of the Agreement.

5. The applicant(s) for an opt-out shall pay the fixed fee in accordance with Part 6. The Application to opt out shall not be entered in the register until the fixed fee has been paid. One fixed fee shall be payable in respect of each European patent or application for which an Application to opt out has been filed, including any supplementary protection certificate based on said patent or application.

6. Subject to paragraph 5 the Registrar shall as soon as practicable enter the Application to opt out in the register. Subject to paragraph 7, the opt-out which meets the requirements laid down in this Rule shall be regarded as effective from the date of entry in the register. If the requirements are missing or incorrectly recorded, a correction may be lodged with the Registry. The date of entry of the correction and the date of receipt of the payment shall be noted in the register and the later date shall be the date of correction. The opt-out shall be effective from the date of correction.

7. In the event that an action has been commenced before the Court in respect of a patent (or patents) and/or an application (or applications) contained in an Application to opt out prior to the date of entry of the Application to opt out in the register or prior to the date of correction pursuant to paragraph 6, the Application to opt out shall be ineffective in respect of the patent (or patents) and/or application (or applications) in question, irrespective of whether the action is pending or has been concluded.

8. A proprietor (or proprietors) of a patent (or patents) or an application (or applications) the subject of an opt-out pursuant to this Rule may lodge an Application to withdraw in respect of the patent or application or of one or more of the patents or applications, but not in respect of different Contracting Member States for which the European patent has been granted or which have been designated in the application. The Application to withdraw shall contain the particulars in accordance with paragraph 3 and shall be accompanied by the fixed fee in accordance with Part 6; paragraph 5 shall apply *mutatis mutandis*. Subject to the receipt of the fixed fee the Registrar shall as soon as practicable enter the Application to withdraw in the

register and the withdrawal shall be regarded as effective from the date of entry in the register. Paragraphs 1(b) and 6 shall apply *mutatis mutandis*.

9. In the event that an action has been commenced before a court of a Contracting Member State in a matter over which the Court also has jurisdiction pursuant to Article 32 of the Agreement in respect of a patent or application contained in an Application to withdraw, prior to the entry of the Application to withdraw in the register or any time before the date pursuant to paragraph 6, the Application to withdraw shall be ineffective in respect of the patent or application in question, irrespective of whether the action is pending or has been concluded.

10. Where an application for a European patent subject to an opt-out pursuant to this Rule proceeds to grant as a European patent with unitary effect, the proprietor(s) shall notify the Registry. The opt-out shall be deemed to have been withdrawn in respect of the Contracting Member States covered by the European patent with unitary effect at the date of the registration of the unitary effect and the Registrar shall as soon as practicable enter the withdrawal in the register in respect of such Contracting Member States. No fee shall be payable pursuant to paragraph 8.

11. A patent or application the subject of an Application to withdraw which has been entered on the register may not thereafter be the subject of a further Application to opt out.

12. The Registrar shall as soon as practicable notify the European Patent Office and the national patent office of any Contracting Member States concerned of the entries in the register pursuant to paragraphs 6 and 8.

[13. Applications accepted by the Registry before the entry into force of the Agreement shall be treated as entered on the Register on the date of entry into force of the Agreement.]

*Relation with Agreement: Article 83(3) and (4)*

## **Rule 6 – Service and supply of orders, decisions, written pleadings and other documents**

1. The Registry shall as soon as practicable serve, in accordance with Part 5, Chapter 2:

- (a) orders and decisions of the Court on the parties;
- (b) written pleadings and other documents of a party on the other party.

Where applicable, the Registry shall inform the parties of the opportunity to reply or to take any other appropriate step in the proceedings and of any time period for so doing.

2. The Registry shall also as soon as practicable supply to the parties copies of documents referred to in these Rules and lodged with pleadings and written evidence.

3. Where the postal or electronic address for service provided by a party pursuant to these Rules has changed that party shall give notice to the Registry and to every other party as soon as such change has taken place.

## **Rule 7 – Language of written pleadings and written evidence**

1. Written pleadings and other documents, including written evidence, shall be lodged in the language of the proceedings unless the Court or these Rules otherwise provide.

2. Where these Rules or the Court require a pleading or other document to be translated it shall not be necessary to provide a formal certification by the translator as to the accuracy of such

translation unless the accuracy is challenged by a party or such certification is ordered by the Court or required by these Rules.

#### **Rule 8 – Party and party's representative**

1. A party shall be represented in accordance with Article 48 of the Agreement unless otherwise provided by these Rules [Rules 5, 88.4 and 378.5].

2. For the purpose of all proceedings in relation to a patent, where these Rules provide that a party performs any act or that any act be performed upon a party that act shall be performed by or upon the representative for the time being of the party.

3. Except where these Rules provide otherwise, a party shall not communicate with the Court without informing the other party or parties. Where such communication is in writing, the communication should be copied to the other party or parties unless these Rules provide that the Court will supply a copy to the other party or parties.

4. For the purposes of proceedings under these Rules in relation to the proprietor(s) of a European patent with unitary effect, the person(s) shown in the Register for unitary patent protection referred to in Article 9(1)(g) and (h) of Regulation (EU) Nr 1257/2012 as the proprietor(s) shall be treated as such. If during proceedings before the Court a new proprietor is recorded in the Register for unitary protection, the former registered proprietor(s) may apply to the Court pursuant to Rule 305.1(c) for the substitution of the new proprietor.

5. Subject to paragraph 6, for the purposes of proceedings under these Rules:

(a) in relation to the proprietor(s) of a European patent, the person(s) entitled to be registered as proprietor(s) under the law of each Contracting Member State in which such European patent has been validated shall be treated as the proprietor(s) whether or not such person(s) are in fact recorded in the register of patents maintained in such Contracting Member State (hereinafter “national patent register”); and

(b) in relation to the applicant(s) for a European patent(s), the person(s) entitled to be registered as applicant(s) whether or not such person(s) are in fact recorded as such in the European Patent Register kept by the European Patent Office.

(c) For the purposes of paragraph 5, there shall be a rebuttable presumption that the person(s) shown in each national patent register and the European Patent Register kept by the European Patent Office is/are the person(s) entitled to be registered as proprietor(s) or applicant(s) as the case may be.

6. For the purposes of proceedings pursuant to Rule 43 and Rule 60 in relation to a European patent, the person(s) shown in the register of patents maintained in each Contracting Member State in which such European patent has been validated as the proprietor(s) shall be treated as such for each such Contracting Member State or, as far as no such person is registered in a national patent register, the last person shown recorded as proprietor in the European Patent Register kept by the European Patent Office.

*Relation with Agreement: Article 48*

### **Rule 9 – Powers of the Court**

1. The Court may, at any stage of the proceedings, of its own motion or on reasoned request by a party, order a party to take any step, answer any question or provide any clarification or evidence, within time periods to be specified.
2. The Court may disregard any step, fact, evidence or argument which a party has not taken or submitted in accordance with a time limit set by the Court or these Rules.
3. Subject to paragraph 4, on a reasoned request by a party, the Court may:
  - (a) extend, even retrospectively, a time period referred to in these Rules or imposed by the Court; and
  - (b) shorten any such time period.
4. The Court shall not extend the time periods referred to in Rule 198.1, Rule 213.1 and Rule 224.1.

## **PART 1 – PROCEDURES BEFORE THE COURT OF FIRST INSTANCE**

### **Rule 10 – Stages of the proceedings (*inter partes* proceedings)**

Proceedings before the Court of First Instance shall consist of the following stages:

- (a) a written procedure;
- (b) an interim procedure, which may include an interim conference with the parties;
- (c) an oral procedure which, subject to Rules 116.1 and 117, shall include an oral hearing of the parties where necessary;
- (d) a procedure for the award of damages, which may include a procedure to lay open books;
- (e) a procedure for cost decisions.

*Relation with Agreement: Articles 52, 68 and 69*

### **Rule 11 – Settlement**

1. At any stage of the proceedings, if the Court is of the opinion that the dispute is suitable for a settlement, it may propose that the parties make use of the facilities of the Patent Mediation and Arbitration Centre (“the Centre”) in order to settle or to explore a settlement of the dispute. In particular the judge-rapporteur shall during the interim procedure, especially at an interim conference in accordance with Rule 104(d), explore with the parties the possibility of a settlement, including through mediation and/or arbitration, using the facilities of the Centre. Parties who choose mediation in an attempt to settle a dispute are subsequently not prevented from initiating judicial proceedings before the Court in relation to that dispute by the expiry of limitation or prescription periods during the mediation process, which will stay the limitation or prescription periods until the end of the mediation process.

2. Pursuant to Rule 365 the Court shall, if requested by the parties, by decision confirm the terms of any settlement or arbitral award by consent (irrespective of whether it was reached using the facilities of the Centre or otherwise), including a term which obliges the patent owner to limit, surrender or agree to the revocation of a patent or not to assert it against the other party and/or third parties. The parties may agree on costs to be awarded or may request the Court to decide on costs to be awarded in accordance with Rules 150 to 156 *mutatis mutandis*.

3. Save for the purpose of enforcing the terms of any such settlement agreement by any person no opinion expressed, suggestion made, proposal put forward, concession made or document drawn up for the purposes of settlement may be relied on as evidence by the Court or the parties in proceedings before the Court or any other court unless such matter was expressed to be made on an open basis and freely disclosable to the Court or any other court.

*Relation with Agreement: Articles 35, 52(2) and 79*

## **CHAPTER 1 – WRITTEN PROCEDURE**

### **SECTION 1 – INFRINGEMENT ACTION**

#### **Rule 12 – Exchange of written pleadings (infringement action)**

1. The written procedure shall consist of:
  - (a) the lodging of a Statement of claim (by the claimant) [Rule 13];
  - (b) the lodging of a Statement of defence (by the defendant) [Rules 23 and 24]; and, optionally
  - (c) the lodging of a Reply to the Statement of defence (by the claimant) [Rule 29(b)]; and
  - (d) the lodging of a Rejoinder to the Reply (by the defendant) [Rule 29(c)].
2. The Statement of defence may include a Counterclaim for revocation [Rule 25.1].
3. If a Counterclaim for revocation is lodged:
  - (a) the claimant and any proprietor who becomes a party pursuant to Rule 25.2 (hereinafter in this Rule 12 and Rules 29 to 32, “the proprietor”) shall lodge a Defence to the Counterclaim for revocation [Rule 29(a)], which may include an Application to amend the patent by the proprietor [Rule 30];
  - (b) the defendant may lodge a Reply to the Defence to the Counterclaim [Rule 29(d)]; and
  - (c) the claimant and the proprietor may lodge a Rejoinder to the Reply to the Defence to the Counterclaim [Rule 29(e)].
4. If an Application to amend the patent is lodged by the proprietor, the defendant shall lodge a Defence to the Application to amend the patent in the Reply to the Defence to the Counterclaim, the proprietor may lodge a Reply to the Defence to the Application to amend and the defendant may lodge a Rejoinder to such Reply [Rule 32].
5. The judge-rapporteur may allow the exchange of further written pleadings, within time periods to be specified [Rule 36].

#### **STATEMENT OF CLAIM**

#### **Rule 13 – Contents of the Statement of claim**

1. The claimant shall lodge a Statement of claim with the division chosen by him [Article 33 of the Agreement] which shall contain:
  - (a) the name of the claimant, and, where the claimant is a corporate entity, the location of its registered office, and of the claimant's representative;
  - (b) the name of the party against whom the Statement is made (the defendant), and, where the defendant is a corporate entity, the location of its registered office;
  - (c) postal and electronic addresses for service on the claimant and the names of the persons authorised to accept service;
  - (d) postal and, where available, electronic addresses for service on the defendant and the names of the persons authorised to accept service, if known;

(e) where the claimant is not the proprietor or not the only proprietor of the patent (or patents) concerned, postal and where available, electronic addresses for service on the proprietor and the names and addresses of the persons authorised to accept service, if known;

(f) where the claimant is not the proprietor of the patent (or patents) concerned, or not the only proprietor, evidence to show the claimant is entitled to commence proceedings [Article 47(2) and (3) of the Agreement];

(g) details of the patent (or patents) concerned, including the number (or numbers);

(h) where applicable, information about any prior or pending proceedings relating to the patent (or patents) concerned before the Court including any action for revocation or a declaration of non-infringement pending before the central division and the date of any such action, the European Patent Office or any other court or authority;

(i) an indication of the division which shall hear the action [Article 33(1) to (6) of the Agreement] with an explanation of why that division has competence; where the parties have agreed in accordance with Article 33(7) of the Agreement, the indication of the division which shall hear the action shall be accompanied by evidence of the defendant's agreement;

(j) where applicable, an indication that the action shall be heard by a single judge [Article 8(7) of the Agreement], accompanied by evidence of the defendant's agreement;

(k) the nature of the claim, the order or the remedy sought by the claimant;

(l) an indication of the facts relied on, in particular:

(i) one or more instances of alleged infringements or threatened infringements specifying the date and place of each;

(ii) the identification of the patent claims alleged to be infringed;

(m) the evidence relied on [Rule 170.1], where available, and an indication of any further evidence which will be offered in support;

(n) the reasons why the facts relied on constitute an infringement of the patent claims, including arguments of law and where appropriate an explanation of the proposed claim interpretation;

(o) an indication of any order the claimant will seek during the interim procedure [Rule 104(e)];

(p) where the claimant assesses that the value of the infringement action exceeds [EUR\*\*\*], an indication of the value; and

(q) a list of the documents, including any witness statements, referred to in the Statement of claim, together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.1.

2. The claimant shall at the same time supply a copy of each of the documents referred to in the Statement of claim.

3. The judge-rapporteur shall decide on any request made pursuant to Rule 13.1(q) as soon as practicable after his designation pursuant to Rule 18.

#### **Rule 14 – Use of languages under Article 49(1) and (2) of the Agreement**

1. Without prejudice to Articles 49(3) to (6) of the Agreement and subject to Rules 14.2, 271.7 and Rules 321 to 323, proceedings shall be conducted:

(a) in the official language or one of the official languages designated as language(s) of proceedings pursuant to Article 49(1) of the Agreement; or

(b) in a language designated as language of proceedings by a Contracting Member State pursuant to Article 49(2) of the Agreement.

2. Where a Contracting Member State hosts a local division or participates in a regional division for which several languages have been designated pursuant to Article 49(1) and/or Article 49(2) of the Agreement:

(a) subject to paragraphs 2(b) and (c), the claimant may choose as the language of proceedings any of the language(s) designated pursuant to Article 49(1) and/or Article 49(2) of the Agreement;

(b) in proceedings before a local or regional division in a Contracting Member State against a defendant who has his domicile or principal place of business in that Contracting Member State where the action could not be brought pursuant to Article 33(1)(a) of the Agreement before any other local or regional division, proceedings shall be conducted in the official language of the Contracting Member State (paragraph 1(a)). Where a designation by a Contracting Member State having several official regional languages so indicates, proceedings shall be conducted in the official language of the region in which the defendant has his domicile or principal place of business. Where there are two or more such defendants whose domicile or principle place of business has different regional languages, the claimant may choose the language from the regional languages in question. Where a designation by a Contracting Member State having several official languages so indicates, proceedings shall be conducted in the official language of the defendant. Where there are two or more such defendants with different official languages, the claimant may choose the language from the official languages in question.

(c) Where a designation of a language under Article 49(2) of the Agreement for a regional division or for one or more local division(s) hosted in a Member State so indicates, the judge rapporteur may order in the interest of the panel to provide that judges may use in the oral proceedings the language according to paragraph 1(a) and / or to provide that the Court may make any order and deliver any decision in the language according to paragraph 1(a) together with a certified translation for the purpose of the Rule 118.8 into the language according to paragraph 1(b).

3. The Registrar shall maintain a list of languages communicated by Contracting Member States pursuant to Article 49(1) and Article 49(2) of the Agreement as well as designations by Contracting Member States made pursuant to paragraph 2(b) and (c). The list shall be made publically available online.

4. The Registrar shall return any pleading lodged in a language other than the language of

proceedings.

#### **Rule 15 – Fee for the infringement action**

1. The claimant shall pay the fixed fee for the infringement action in accordance with Part 6.
2. The Statement of claim shall not be deemed to have been lodged until the fixed fee for the infringement action has been paid, unless otherwise provided.

*Relation with Agreement: Articles 36(3), 70 and 71*

#### **Rule 16 – Examination as to formal requirements of the Statement of claim**

1. The Registry shall as soon as practicable check whether one or more of the patents concerned is the subject of an opt-out pursuant to Article 83(3) of the Agreement and Rule 5. In the event of an opt-out the Registry shall as soon as practicable inform the claimant who may withdraw or amend the Statement of claim as appropriate.
2. The Registry shall, as soon as practicable after the lodging of the Statement of claim, examine whether the requirements of Rules 13.1 (a) to (k), 13.2, 14 and 15.1 have been complied with.
3. If the claimant has not complied with the requirements referred to in paragraph 2, the Registry shall as soon as practicable invite the claimant to:
  - (a) correct the deficiencies within 14 days of service of such notification; and
  - (b) where applicable, pay the fee for the infringement action within said 14 days.
4. The Registry shall at the same time inform the claimant that if the claimant fails to correct the deficiencies or pay the fee within the time stated, a decision by default may be given, in accordance with Rule 355.
5. If the claimant fails to correct the deficiencies or pay the fee, the Registry shall inform a judge of the division who may reject the action as inadmissible by a decision by default. The judge may give the claimant an opportunity to be heard beforehand.

#### **Rule 17 – Recording in the register and assignment (Court of First Instance, infringement action)**

1. If the requirements referred to in Rule 16.2 have been complied with, the Registry shall as soon as practicable:
  - (a) record the date of receipt of the Statement of claim and attribute an action number to the file;
  - (b) record the file in the register; and
  - (c) inform the claimant of the action number of the file and the date of receipt.
2. The action shall be assigned to a panel of a division according to Rule 345.3. Where requested by the parties the action shall be assigned to a single judge in accordance with Rule 345.6.
3. The following shall determine the distribution of actions between the seat of the central division and its sections.

(a) Where an action involves a single patent having a single classification, the Registry shall allocate the action to the seat or the section of the central division appropriate to the classification of the patent according to Annex II of the Agreement. The presiding judge of the seat or that section shall assign the action to a panel.

(b) Where an action involves more than one patent and a majority of the patents have a single classification appropriate to the seat or a single section of the central division according to Annex II of the Agreement, the Registry shall allocate the action to the seat or that section of the central division. The presiding judge of the seat or that section shall assign the action to a panel.

(c) Where neither paragraph (a) nor (b) applies, especially where

(i) the action involves a single patent having more than one classification or

(ii) where the action involves more than one patent and no majority of the patents have a single classification corresponding to the seat or to one of the sections of the central division,

the Registry shall refer the action to the presiding judge of the seat or the section appropriate to the first classification of either the single patent or, where the action involves more than one patent, the patent first listed in the Statement of claim, according to Annex II of the Agreement. If the respective presiding judge considers that the reference of the action is appropriate, he shall assign it to a panel. If he considers otherwise, he shall refer the action to the presiding judge of either the seat or the other section of the central division he considers appropriate, who shall likewise consider whether the re-allocation of the action is appropriate. If that presiding judge considers otherwise, he shall refer the action to the President of the Court of First Instance, who shall allocate it to the seat or the section of the central division he considers appropriate. The respective presiding judge shall assign the action to a panel.

4. The action shall be regarded as having commenced before the Court as from the date of receipt attributed to the Statement of claim.

*Relation with Agreement: Article 7(2), Article 10*

## **Rule 18 – Designation of the judge-rapporteur**

The presiding judge of the panel to which the action has been assigned [Rule 17.2] shall designate one legal judge of the panel as judge-rapporteur. The presiding judge may designate himself as judge-rapporteur. The Registry shall as soon as practicable notify the claimant and defendant of the identity of the judge-rapporteur.

## **PROCEDURE WHEN THE DEFENDANT RAISES A PRELIMINARY OBJECTION**

### **Rule 19 – Preliminary objection**

1. Within one month of service of the Statement of claim, the defendant may lodge a Preliminary objection concerning:

(a) the jurisdiction and competence of the Court, including any objection that an opt-out pursuant to Rule 5 applies to the patent that is the subject of the proceedings;

(b) the competence of the division indicated by the claimant [Rule 13.1(i)];

(c) the language of the Statement of claim [Rule 14].

2. A Preliminary objection shall contain:

- (a) particulars in accordance with Rule 24.1(a) to (c);
- (b) the decision or order sought by the defendant;
- (c) the grounds upon which the Preliminary objection is based; and
- (d) where appropriate the facts and evidence relied on.

3. The Preliminary objection shall be drawn up in the language pursuant to Rule 14.

4. If the action has been commenced before a regional division the defendant may by a Preliminary objection request a transfer of the action to the central division pursuant to Article 33(2) of the Agreement. The Preliminary objection shall in such a case contain all facts and evidence supporting the existence of the same infringement in three or more regional divisions.

5. The Registry shall as soon as practicable invite the claimant to comment on the Preliminary objection. Where applicable, the claimant may of his own motion correct any deficiency [Rule 19.1(b) or (c)], within 14 days of service of notification of the Preliminary objection. Alternatively the claimant may submit written comments within the same period. The judge-rapporteur shall be informed of any correction made or written comments submitted by the claimant. If the deficiency referred to in Rule 19.1(b) is corrected and the claimant has indicated another division, which is competent, the judge-rapporteur shall refer the action to the division indicated by the claimant.

6. The period for lodging the Statement of defence [Rule 23] shall not be affected by the lodging of a Preliminary objection, unless the judge-rapporteur decides otherwise.

7. The defendant's failure to lodge a Preliminary objection within the time period referred to in Rule 19.1 shall be treated as a submission to the jurisdiction and competence of the Court and the competence of the division chosen by the claimant.

#### **Rule 20 – Decision or order on a Preliminary objection**

1. As soon as practicable after the expiry of the period referred to in Rule 19.5, the judge-rapporteur shall decide the Preliminary objection. The judge-rapporteur shall give the parties an opportunity to be heard. The decision shall include instructions to the parties and to the Registry concerning the next step in the proceedings.

2. Where the Preliminary objection is to be dealt with in the main proceedings, the judge-rapporteur shall inform the parties.

#### **Rule 21 – Appeal against decision or order on a Preliminary objection**

1. A decision of the judge-rapporteur allowing the Preliminary objection may be appealed pursuant to Rule 220.1(a). An order of the judge-rapporteur rejecting the Preliminary objection may only be appealed pursuant to Rule 220.2.

2. If an appeal is lodged, proceedings at first instance may be stayed by the judge-rapporteur or the Court of Appeal on a reasoned request by a party.

## **VALUE-BASED FEE FOR THE INFRINGEMENT ACTION**

### **Rule 22 – Value-based fee for the infringement action**

1. The value of the infringement action shall be determined by the judge-rapporteur, taking into account the value of the dispute as assessed by the parties, by way of an order during the interim procedure.
2. Where the value of the infringement action exceeds [EUR\*\*\*], the claimant shall pay a value-based fee for the infringement action, in accordance with Part 6 [Rules 370.2(b) and 371.4].

## **STATEMENT OF DEFENCE**

### **Rule 23 – Lodging of the Statement of defence**

The defendant shall lodge a Statement of defence within three months of service of the Statement of claim.

### **Rule 24 – Contents of the Statement of defence**

The Statement of defence shall contain:

- (a) the names of the defendant and of the defendant's representative;
- (b) postal and electronic addresses for service on the defendant and the names and addresses of the persons authorised to accept service;
- (c) the action number of the file;
- (d) an indication whether the defendant has lodged a Preliminary objection [Rule 19];
- (e) an indication of the facts relied on, including any challenge to the facts relied on by the claimant;
- (f) the evidence relied on [Rule 170.1], where available, and an indication of any further evidence which will be offered in support;
- (g) the reasons why the action shall fail, arguments of law and any argument arising from the provisions of Article 28 of the Agreement and where appropriate any challenge to the claimant's proposed claim interpretation;
- (h) an indication of any order the defendant will seek in respect of the infringement action during the interim procedure [Rule 104(e)];
- (i) a statement whether the defendant disputes the claimant's assessment of the value of the infringement action and the grounds for such dispute; and
- (j) a list of the documents, including any witness statements, referred to in the Statement of defence together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.1. Rule 13.2 and .3 shall apply *mutatis mutandis*.

### **Rule 25 – Counterclaim for revocation**

1. If the Statement of defence includes an assertion that the patent (or patents) alleged to be infringed is (are) invalid the Statement of defence shall include a Counterclaim against the

proprietor(s) of the patent (or patents) for revocation of said patent (or patents) in accordance with Rule 43. The Counterclaim for revocation shall contain:

- (a) an indication of the extent to which revocation of the patent (or patents) is requested;
- (b) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the defendant's proposed claim construction;
- (c) an indication of the facts relied on;
- (d) the evidence relied on, where available, and an indication of any further evidence which will be offered in support;
- (e) an indication of any order the defendant will seek during the interim procedure [Rule 104(e)];
- (f) where the defendant assesses that the value of the dispute including the Counterclaim exceeds the value of the infringement action by more than [EUR\*\*\*] an indication of the value of the dispute including the Counterclaim;
- (g) a statement of his position, if any, on the options provided for in Article 33(3) of the Agreement and Rule 37.4;
- (h) a list of the documents, including any witness statements, referred to in the Counterclaim for revocation together with any request that all or part of any such documents need not be translated. Rule 13.2 and .3 shall apply *mutatis mutandis*; and
- (i) insofar as the proprietor(s) of the patent (or patents) are not claimant(s) in the infringement proceedings, the information required by Rule 13.1(b) and (d) in respect of said proprietor(s).

2. Where the claimant is not the proprietor or not the only proprietor of the patent (or patents) concerned, the Registry shall as soon as practicable serve a copy of the Counterclaim for revocation on the relevant proprietor(s) in accordance with Rule 13.1(e) and shall supply a copy of each document referred to in paragraph 1(h). Rule 271 shall apply *mutatis mutandis*. The proprietor(s) in question shall become a party (parties) to the revocation proceedings and shall be treated as defendant(s) in all subsequent proceedings. The proprietor(s) shall provide details pursuant to Rule 13.1(e) if not already provided by the claimant.

#### **Rule 26 – Fee for the Counterclaim for revocation**

The defendant shall pay the fee for the Counterclaim for revocation in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

#### **Rule 27 – Examination as to formal requirements of the Statement of defence**

1. The Registry shall, as soon as practicable after the lodging of the Statement of defence:

- (a) examine whether the requirements of Rule 24.1(a) to (d) have been complied with; and
- (b) if the Statement of defence includes a Counterclaim for revocation, examine whether the obligation to pay the fee pursuant to Rule 26 has been complied with.

2. If the Registry considers that the Statement of defence or the Counterclaim for revocation does not comply with any of the requirements referred to in paragraph 1, it shall as soon as

practicable invite the defendant to:

- (a) correct the deficiencies noted, within 14 days of service of such notification; and
- (b) where applicable, pay the fee for the Counterclaim for revocation, within said 14 days.

3. The Registry shall at the same time inform the defendant that if the defendant fails to correct the deficiencies or pay the fee within the time stated, a decision by default may be given, in accordance with Rule 355.

4. If the defendant fails to correct the deficiencies or to pay the fee for the Counterclaim for revocation, as appropriate, within said 14 days, the Registry shall inform the judge-rapporteur who may give a decision by default. He may give the defendant an opportunity to be heard beforehand.

### **Rule 28 – Further schedule**

As soon as practicable after service of the Statement of defence, the judge-rapporteur shall, after consulting the parties, set a date and time for an interim conference (where necessary [Rule 101.1]) and set a date for the oral hearing. The judge-rapporteur may set one alternative date.

### **DEFENCE TO THE COUNTERCLAIM FOR REVOCATION, REPLY TO THE STATEMENT OF THE DEFENCE AND APPLICATION TO AMEND THE PATENT AND REJOINDER TO THE REPLY**

### **Rule 29 – Lodging of Defence to the Counterclaim for revocation, Reply to the Statement of defence and Rejoinder to the Reply**

(a) Within two months of service of a Statement of defence which includes a Counterclaim for revocation, the claimant shall lodge a Defence to the Counterclaim for revocation together with any Reply to the Statement of defence and any Application to amend the patent pursuant to Rule 30, if applicable.

(b) Within two months of service of a Statement of defence which does not include a Counterclaim for revocation, the claimant may lodge a Reply to the Statement of defence.

(c) Within one month of service of a Reply to the Statement of defence which does not include a Counterclaim for revocation the defendant may lodge a Rejoinder to the Reply to the Statement of defence. The Rejoinder to the Reply to the Statement of defence shall be limited to a response to the matters raised in the Reply to the Statement of defence.

(d) Within two months of service of the Defence to Counterclaim the defendant may lodge a Reply to the Defence to the Counterclaim together with any Rejoinder to the Reply to the Statement of defence and any Defence to an Application to amend the patent pursuant to Rule 32, if applicable.

(e) Within one month of the service of the Reply to the Defence to the counterclaim, the claimant may lodge a Rejoinder to the Reply together with any Reply to the Defence to an Application to amend the patent pursuant to Rule 32, if applicable. The Rejoinder to the Reply to the Statement of defence shall be limited to a response to the matters raised in the Reply to the Statement of defence.

(f) Where the claimant is not the proprietor of the patent, all references to the claimant in this Rule 29 regarding an Application to amend the patent shall be read as including the proprietor.

## **Rule 29A – Contents of the Defence to the Counterclaim**

The Defence to the Counterclaim for revocation shall contain:

- (a) an indication of the facts relied on, including any challenge to the facts relied on by the defendant;
- (b) the evidence relied on [Rule 170.1], where available, and an indication of any further evidence which will be offered in support;
- (c) the reasons why the counterclaim for revocation shall fail, including arguments of law and any argument as to why any dependent claim of the patent (or patents) is independently valid;
- (d) an indication of any order the claimant and the proprietor will seek in respect of the revocation action at the interim conference [Rule 104(e)];
- (e) the claimant's and the proprietor's response to the defendant's choice of option, if any, provided for in Article 33(3) of the Agreement and Rule 37.4;
- (f) the claimant's and the proprietor's response to the defendant's assessment of the value of the dispute (including the Counterclaim) pursuant to Rule 25.1(f); and
- (g) a list of the documents, including any witness statements, referred to in the Defence to the Counterclaim together with any request that all or part of any such document shall not be translated and/or any request pursuant to Rule 262.1. Rule 13.2 and .3 shall apply *mutatis mutandis*.

## **Rule 30 – Application to amend the patent**

1. The Defence to the Counterclaim for revocation may include an Application by the proprietor of the patent to amend the patent which shall contain:

- (a) the proposed amendments of the claims of the patent concerned and/or specification, including where applicable and appropriate one or more alternative sets of claims (auxiliary requests), in the language in which the patent was granted; where the language of the proceedings [Rule 14.3] is not the language in which the patent was granted, the proprietor shall lodge a translation of the proposed amendments in the language of the proceedings, and where the patent is a European patent with unitary effect in the language of the defendant's domicile in a Member State of the EU or of the place of the alleged infringement or threatened infringement in a Contracting Member State if so requested by the defendant;
- (b) an explanation as to why the amendments satisfy the requirements of Articles 84 and 123(2), (3) EPC and why the proposed amended claims are valid and, if applicable, why they are infringed; and
- (c) an indication whether the proposals are conditional or unconditional; the proposed amendments, if conditional, must be reasonable in number in the circumstances of the case.

2. Any subsequent request to amend the patent may only be admitted into the proceedings with the permission of the Court.

3. Where other proceedings involving the patent subject to an Application pursuant to Rule 30.1 are pending, the claimant shall notify the Court or the authority in question that such an Application has been made and provide the information required in Rule 30.1(a).

### **Rule 31 – Value-based fee for the dispute including the Counterclaim for revocation**

1. The value of the dispute (including the Counterclaim for revocation) shall be determined by the judge-rapporteur, taking into account the value as assessed by the parties, by way of an order during the interim procedure.
2. Where the value of the dispute including the Counterclaim for revocation exceeds [EUR\*\*\*], the defendant shall pay a value-based fee for the dispute in accordance with Part 6 [Rules 370.2(b) and 371.4].

### **DEFENCE TO THE APPLICATION TO AMEND THE PATENT**

#### **Rule 32 – Lodging of the Defence to the Application to amend the patent, the Reply to the Defence and the Rejoinder to the Reply**

1. Within two months of service of an Application to amend the patent, the defendant shall lodge a Defence to the Application to amend the patent setting out whether he opposes the Application to amend the patent and, if so, why:
  - (a) the proposed amendments are not allowable; and
  - (b) the patent cannot be maintained as requested.
2. Where appropriate in view of the proposed amendments, the Defence to the Application to amend the patent may contain submissions in accordance with Rule 45(d) to (h) and alternative non-infringement submissions.
3. The proprietor may lodge a Reply to the Defence to the Application to amend the patent within one month of service of the Defence and the defendant may within one month of the service of the Reply lodge a Rejoinder to the Reply. The Rejoinder shall be limited to the matters raised in the Reply.

### **APPLICATION FOR ALLOCATING A TECHNICALLY QUALIFIED JUDGE TO THE PANEL**

#### **Rule 33 – Application by a party for allocating a technically qualified judge**

1. Any party to the proceedings may lodge an Application for allocating a technically qualified judge to the panel which shall contain an indication of the relevant field of technology.
2. The Application shall be lodged as early as possible in the written procedure. An Application lodged after the closure of the written procedure [Rule 35] shall only be granted if justified in view of changed circumstances, such as new submissions presented by the other party, and allowed by the Court.
3. If the requirements of paragraphs 1 and 2 have been complied with, the President of the Court of First Instance shall allocate a technically qualified judge to the panel, after consulting the judge-rapporteur.

#### **Rule 34 – Request by the judge-rapporteur for allocating a technically qualified judge**

1. The judge-rapporteur may at any time during the written procedure, after consulting the presiding judge and the parties, request the President of the Court of First Instance to allocate a technically qualified judge to the panel.

2. Where a technically qualified judge is allocated to the panel, the judge-rapporteur may at any time consult the technically qualified judge.

#### **LAST STEPS IN THE WRITTEN PROCEDURE**

##### **Rule 35 – Closure of the written procedure**

Following the exchange of written pleadings in accordance with Rule 12.1 and, where applicable, in accordance with Rule 12.2 to .4, the judge-rapporteur shall:

(a) inform the parties of the date on which he intends to close the written procedure, without prejudice to Rule 36; and

(b) where an interim conference is necessary [Rules 28 and 101.1], confirm the date and the time set for the interim conference [Rule 28] or inform the parties that an interim conference will not be held.

##### **Rule 36 – Further exchanges of written pleadings**

Without prejudice to the powers of the judge-rapporteur pursuant to Rule 110.1, on a reasoned request by a party lodged before the date on which the judge-rapporteur intends to close the written procedure [Rule 35(a)], the judge-rapporteur may allow the exchange of further written pleadings, within a period to be specified. Where the exchange of further written pleadings is allowed, the written procedure shall be deemed closed upon expiry of the specified period.

##### **Rule 37 – Application of Article 33(3) of the Agreement**

1. As soon as practicable after the closure of the written procedure the panel shall decide by way of order how to proceed with respect to the application of Article 33(3) of the Agreement. The parties shall be given an opportunity to be heard [Rule 264]. The panel shall set out in its order brief reasons for its decision.

2. The Panel may by order take an earlier decision if appropriate having considered the parties' pleadings and having given the parties an opportunity to be heard [Rule 264].

3. Where the panel decides to proceed in accordance with Article 33(3)(a) of the Agreement, the judge-rapporteur shall request the President of the Court of First Instance to allocate to the panel a technically qualified judge if not already allocated pursuant to Rules 33 and 34.

4. Where the panel decides to proceed in accordance with Article 33(3)(b) of the Agreement, the panel may stay the infringement proceedings pending a final decision in the revocation procedure and shall stay the infringement proceedings where there is a high likelihood that the relevant claims of the patent (or patents) will be held to be invalid on any ground by the final decision in the revocation procedure.

5. Where the panel decides to proceed in accordance with Article 33(3)(b) of the Agreement and not to stay the proceedings, the judge-rapporteur of the regional or local division shall communicate to the central division the dates set for the interim conference and for the oral hearing according to Rule 28.

## **COUNTERCLAIM FOR REVOCATION REFERRED TO THE CENTRAL DIVISION UNDER ARTICLE 33(3)(B) OF THE AGREEMENT**

### **Rule 38 – Written procedure when the central division deals with a Counterclaim for revocation under Article 33(3)(b) of the Agreement**

When a Counterclaim for revocation is referred to the central division, it shall be dealt with as follows:

- (a) Rule 17.2 and .3 shall apply *mutatis mutandis*;
- (b) Rule 18 shall apply *mutatis mutandis*: the presiding judge of the panel to which the Counterclaim for revocation has been assigned shall designate one legally qualified judge of the panel as judge-rapporteur;
- (c) The judge-rapporteur shall give any further directions necessary for the future conduct of the written procedure before the central division;
- (d) Rule 28 shall apply *mutatis mutandis*: the judge-rapporteur shall after consulting the parties set a date and a time for the interim conference (where necessary [Rules 28 and 101]) and set a date, and one alternative date, for the oral hearing.

### **Rule 39 – Language of the proceedings before the central division**

1. Where the language of the proceedings before the local division or the regional division which referred the Counterclaim for revocation to the central division is not the language in which the patent was granted, the judge-rapporteur may order that the parties lodge, within a period of one month, a translation in the language in which the patent was granted of any written pleadings and such other documents lodged during the written procedure as the judge-rapporteur may direct.
2. Where appropriate, the judge-rapporteur may specify in his order that only excerpts of parties' written pleadings and other documents shall be translated.
3. Where the language of the proceedings before the local division or the regional division is the language in which the patent was granted the pleadings served in accordance with Rules 24, 25, 29, 29a, 30 and 32 shall stand.

### **Rule 40 – Accelerated proceedings before the central division**

The judge-rapporteur shall accelerate proceedings before the central division where

- (a) an Application for provisional measures has been lodged [Rule 206]; or
- (b) the regional or local division has referred the counterclaim for revocation to the central division and where the infringement action has not been stayed.

In the latter case, the judge rapporteur of the panel of the central division shall endeavour to set a date for the oral hearing on the revocation action prior to the date of the oral hearing of the infringement action.

## **ACTION REFERRED TO THE CENTRAL DIVISION UNDER ARTICLE 33(3)(C) OF THE AGREEMENT**

### **Rule 41 – Written procedure when the central division deals with the action under Article 33(3)(c) of the Agreement**

When an action is referred to the central division under Article 33(3)(c) of the Agreement, it shall be dealt with as follows:

(a) Rule 17.2 and .3 shall apply *mutatis mutandis*. The parties may request that the action be heard by a single judge;

(b) Rule 18 shall apply *mutatis mutandis*: the presiding judge of the panel to which the action has been assigned shall designate one judge of the panel as judge-rapporteur;

(c) dates already set under Rule 28 shall be confirmed wherever possible;

(d) Rule 39 shall apply *mutatis mutandis*: the judge-rapporteur may order that the parties lodge a translation in the language in which the patent was granted of any written pleadings lodged during the written procedure; where appropriate, the judge-rapporteur may specify in his order that only excerpts of parties' written pleadings and other documents shall be translated. Otherwise the pleadings lodged during the written procedure shall stand;

(e) The judge-rapporteur shall give any further directions necessary for the future conduct of the written procedure before the central division.

## **SECTION 2 – REVOCATION ACTION**

### **Rule 43 – Action to be directed against the patent proprietor**

1. Any action for the revocation of a patent shall be directed against the proprietor(s) of the patent (or patents).

2. If the action for revocation is directed against the proprietor(s) in accordance with Rule 8.6 (“the registered proprietor(s)”) but one or more of the registered proprietor(s) is not a proprietor within the meaning of Rule 8.5(a) or (b) (“the Rule 8.5 proprietor(s)”) each such registered proprietor shall as soon as practicable after service of the Statement for revocation apply to the Court pursuant to Rule 305.1(c) for the substitution of the registered proprietor(s) by the Rule 8.5 proprietor(s).

*Relation with Agreement: Articles 47(5) and 65(1)*

### **Rule 44 – Exchange of written pleadings (revocation action)**

1. The written procedure shall consist of:

(a) the lodging of a Statement for revocation (by the claimant) [Rule 45]; and

(b) the lodging of a Defence to revocation (by the defendant) [Rule 49]; and optionally

(c) the lodging of a Reply to the Defence to revocation (by the claimant) [Rule 51];

(d) the lodging of a Rejoinder to the Reply (by the defendant) [Rule 52].

2. The Defence to revocation may include:

(a) an Application to amend the patent (or patents); and

(b) a Counterclaim for infringement by the proprietor(s) of the patent (or patents).

3. If an Application to amend the patent is lodged, the claimant shall lodge a Defence to the Application to amend the patent (or patents). The defendant may lodge a Reply to the Defence to the Application. The claimant may lodge a Rejoinder to the Reply. The Rejoinder shall be limited to a response to the matters raised in the Reply.

4. If a Counterclaim for infringement is lodged, the claimant shall lodge a Defence to the Counterclaim for infringement [Rule 56], the defendant may lodge a Reply to the Defence to the Counterclaim [Rule 56.3] and the claimant may lodge a Rejoinder to the Reply [Rule 56.4].

5. Rule 12.5 shall apply.

## **STATEMENT FOR REVOCATION**

### **Rule 45 – Contents of the Statement for revocation**

The claimant shall, subject to point (b), lodge a Statement for revocation at the Registry in accordance with Article 7(2) of the Agreement and Annex II thereto. The Statement for revocation shall contain:

(a) particulars in accordance with Rule 13.1(a) to (d) and 13.1(g), (h);

(b) where the parties have agreed to bring the action before a local division or a regional division in accordance with Article 33(7) of the Agreement, an indication of the division which shall hear the action, accompanied by evidence of the defendant's agreement;

(c) where applicable, an indication that the action shall be heard by a single judge [Article 8(7) of the Agreement], accompanied by evidence of the defendant's agreement;

(d) an indication of the extent to which revocation of the patent (or patents) is requested;

(e) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the claimant's proposed claim construction;

(f) an indication of the facts relied on;

(g) the evidence relied on, where available, and an indication of any further evidence which will be offered in support;

(h) an indication of any order the claimant will seek during the interim procedure [Rule 104(e)];

(i) where the claimant assesses that the value of the revocation action exceeds [EUR\*\*\*], an indication of the value; and

(j) a list of the documents, including any witness statements, referred to in the Statement for revocation together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.1. Rule 13.2 and .3 shall apply *mutatis mutandis*.

### **Rule 46 – Language of the Statement for revocation**

1. Subject to paragraph 2, the Statement for revocation shall be drawn up in the language in which the patent was granted.

2. Where the parties have agreed to bring the action before a local or a regional division in accordance with Article 33(7) of the Agreement, the Statement for revocation shall be drawn up in one of the languages referred to in Rule 14.1(a) and (b).

*Relation with Agreement: Article 49*

#### **Rule 47 – Fee for the revocation action**

The claimant shall pay the fee for the revocation action in accordance with Rule 57.2 and Part 6. Rule 15.2 shall apply *mutatis mutandis*.

*Relation with Agreement: Articles 70 and 71*

**Rule 16 on Examination as to formal requirements of the Statement of claim** shall apply *mutatis mutandis*

#### **Rule 48 – Recording in the register and assignment (Court of First Instance, revocation action)**

1. Rule 17 shall apply *mutatis mutandis*.

2. The Registrar shall notify the European Patent Office that the patent (or patents) in question is (or are) subject to an action for revocation.

*Relation with Agreement: Articles 10 and 33*

**Rule 18 on Designation of judge-rapporteur** shall apply

**Rules 19 (other than Rule 19.4), 20 and 21 on Procedure when the defendant raises a Preliminary objection** shall apply *mutatis mutandis*

### **DEFENCE TO REVOCATION**

#### **Rule 49 – Lodging of the Defence to revocation**

1. The defendant shall lodge a Defence to revocation within two months of service of the Statement for revocation.

2. The Defence to revocation may include:

(a) an Application to amend the patent;

(b) a Counterclaim for infringement.

#### **Rule 50 – Contents of the Defence to revocation and Counterclaim for infringement**

1. The Defence to revocation shall contain the matters referred to in Rule 24.1(a) to (c). Rule 29A(a) to (d) and (f) to (g) shall apply *mutatis mutandis*.

2. Any Application to amend the patent shall contain the matters referred to in Rule 30.1(a), (c) and an explanation as to why the amendments satisfy the requirements of Articles 84 and 123(2), (3) and why the proposed amended claims are valid. Rule 30.2 shall apply.

3. Any Counterclaim for infringement shall contain the matters referred to in Rule 13.1(k) to (q) and where the defendant assesses that the value of the dispute including the Counterclaim

for infringement exceeds the value of the revocation action by more than [EUR\*\*\*] an assessment of the value of the dispute including the Counterclaim. Rule 13.2 and .3 shall apply.

#### **Rule 51 – Reply to Defence to revocation**

Within two months of service of the Defence to revocation the claimant may lodge a Reply to the Defence to revocation together with any Defence to an Application to amend the patent pursuant to Rule 44.3 and 55 as well as any Defence to the Counterclaim for infringement pursuant to Rule 56.1, if applicable.

#### **Rule 52 – Rejoinder to the Reply**

Within one month of the service of the Reply the defendant may lodge a Rejoinder to the Reply to the Defence to revocation together with any Reply to the Defence to an Application to amend the patent pursuant to Rule 44.3 and 55 as well as any Reply to the Defence to the Counterclaim for infringement pursuant to Rule 56.3, if applicable. The Rejoinder shall be limited to a response to the matters raised in the Reply.

#### **Rule 53 – Fee for the Counterclaim for infringement**

The defendant shall pay the fee for the Counterclaim for infringement in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

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| <p><b>Rule 27 on Examination as to formal requirements of the Statement of defence</b> shall apply <i>mutatis mutandis</i></p> |
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| <p><b>Rule 28 on Further schedule</b> shall apply <i>mutatis mutandis</i></p> |
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### **DEFENCE TO THE APPLICATION TO AMEND THE PATENT AND DEFENCE TO THE COUNTERCLAIM FOR INFRINGEMENT**

#### **Rule 55 – Lodging of the Defence to the Application to amend the patent, the Reply to the Defence and the Rejoinder to the Reply**

Rule 32 on Lodging of the Defence to the Application to amend the patent, the Reply to the Defence and the Rejoinder to the Reply shall apply *mutatis mutandis*.

#### **Rule 56 – Lodging of the Defence to the Counterclaim for infringement**

1. Within two months of service of a Counterclaim for infringement, the claimant shall lodge a Defence to the Counterclaim for infringement.
2. The Defence to the Counterclaim for infringement shall contain the matters referred to in Rule 24.1(e) to (h) and (j) and a statement whether the claimant disputes the defendant's assessment of the value of the dispute (including the Counterclaim) pursuant to Rule 50.3 and the reasons for such dispute.
3. The defendant may lodge a Reply to the Defence to the Counterclaim for infringement within one month.
4. Within one month of the service of the Reply to the Defence to the Counterclaim for infringement the claimant may lodge a Rejoinder to the Reply together with any Rejoinder to the Reply to the Defence to the Application to amend the patent pursuant to Rule 44.3 and 55. The Rejoinder shall be limited to matters raised in the Reply.

**Rules 33 and 34 on Request for allocating a technically qualified judge** shall apply where the revocation action is heard by local division or regional division

**Rule 35 on Closure of the written procedure** shall apply *mutatis mutandis*

**Rule 36 on Further exchanges of written pleadings** shall apply

#### **Rule 57 – Value-based fee for the revocation action**

1. The value of the revocation action shall be determined by the judge-rapporteur, taking into account the value of the dispute as assessed by the parties, by way of an order during the interim procedure.

2. Where the value of the revocation action exceeds [EUR\*\*\*] the claimant shall pay a value-based fee for the revocation action in accordance with Part 6 [Rules 370.2(b) and 371.4].

#### **Rule 58 – Value-based fee for the dispute including the Counterclaim for infringement**

1. The value of the dispute including the Counterclaim for infringement shall be determined by the judge-rapporteur, taking into account the value as assessed by the parties, by way of an order during the interim procedure.

2. Where the value of the dispute including the Counterclaim for infringement exceeds [EUR\*\*\*], the defendant shall pay a value-based fee for the dispute in accordance with Part 6 [Rules 370.2(b) and 371.4].

### **SECTION 3 – ACTION FOR DECLARATION OF NON-INFRINGEMENT**

#### **Rule 60 – Declaration of non-infringement**

1. A declaration that the performance of a specific act does not, or a proposed act would not, constitute an infringement of a patent may be made by the Court in proceedings between the person doing or proposing to do the act and the patent proprietor or licensee entitled to commence infringement proceedings pursuant to Article 47 of the Agreement, if the patent proprietor or such licensee has asserted that the act is an infringement, or, if no such assertion has been made by the patent proprietor or licensee, if:

(a) that person has applied in writing to the proprietor or licensee for a written acknowledgment to the effect of the declaration claimed, and has provided him with full particulars in writing of the act in question; and

(b) the proprietor or licensee has refused or failed to give any such acknowledgment within one month.

2. The action for a declaration shall be directed against the proprietor of the patent or the licensee who has asserted an infringement or refused or failed to give an acknowledgement pursuant to paragraph 1(b).

3. If the action for a declaration of non-infringement is directed against the proprietor(s) of the patent in accordance with Rule 8.6 (“the registered proprietor(s)”) but one or more of the registered proprietor(s) is not a proprietor within the meaning of Rule 8.5(a) or (b) (“the Rule 8.5 proprietor(s)”) each such registered proprietor shall as soon as possible after service of the statement for a declaration of non-infringement apply to the Court pursuant to Rule 305.1(c) for the substitution of the registered proprietor(s) by the Rule 8.5 proprietor(s).

## **Rule 61 – Exchange of written pleadings (action for declaration of non-infringement)**

1. The written procedure shall consist of:

- (a) the lodging of a Statement for a declaration of non-infringement (by the claimant) [Rule 62];
- (b) the lodging of a Defence to the Statement for a declaration of non-infringement (by the defendant) [Rules 65-66]; and, optionally
- (c) the lodging of a Reply to the Defence to the Statement for a declaration of non-infringement [Rule 67];
- (d) the lodging of a Rejoinder to the Reply [Rule 67].

2. Rule 12.5 shall apply.

## **Rule 62 – Contents of the Statement for a declaration of non-infringement**

The claimant shall, subject to point (b), lodge at the Registry in accordance with Article 33(4), Article 7(2) of the Agreement and Annex II thereto, a Statement for a declaration of non-infringement which shall contain:

- (a) particulars in accordance with Rule 13.1(a) to (h) and particulars confirming that the requirements of Rule 60 are met;
- (b) where the parties have agreed to bring the action before a local division or a regional division in accordance with Article 33(7) of the Agreement, an indication of the division which shall hear the action, accompanied by evidence of the defendant's agreement;
- (c) where applicable, an indication that the action shall be heard by a single judge [Article 8(7) of the Agreement], accompanied by evidence of the defendant's agreement;
- (d) the declaration sought by the claimant;
- (e) the reasons why the performance of a specific act does not, or a proposed act would not, constitute an infringement of the patent or patents concerned, including arguments of law and where appropriate an explanation of the claimant's proposed claim construction;
- (f) an indication of the facts relied on;
- (g) the evidence relied on, where available, and an indication of any further evidence which will be offered in support;
- (h) an indication of any order the claimant will seek at the interim conference [Rule 104(e)];
- (i) where the claimant assesses that the value of the declaratory action exceeds [EUR\*\*\*], an indication of the value; and
- (j) a list of the documents, including any witness statements, referred to in the Statement for a declaration together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.1. Rule 13.2 and .3 shall apply *mutatis mutandis*.

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| <b>Rules 46, 47 and 48 relating to the Statement for revocation shall apply <i>mutatis mutandis</i></b> |
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**Rules 16 and 17 on Examination as to formal requirements of the Statement of claim and Recording on the register** shall apply *mutatis mutandis*

**Rule 18 on Designation of the judge-rapporteur** shall apply *mutatis-mutandis*

**Rules 19 (other than Rule 19.4), 20 and 21 on Procedure when the defendant raises a Preliminary objection** shall apply *mutatis mutandis*

**Rule 65 – Lodging of the Defence to the Statement for a declaration of non-infringement**

The defendant shall lodge a Defence to the Statement for a declaration of non-infringement within two months of service of the Statement for a declaration of non-infringement.

**Rule 66 – Contents of the Defence to the Statement for a declaration of non-infringement**

The Defence to the Statement for a declaration of non-infringement shall contain the matters referred to in Rule 24(a) to (j). Rule 13.2 and .3 shall apply *mutatis mutandis*.

**Rule 67 – Reply to Defence to the Statement for a declaration of non-infringement and Rejoinder to the Reply**

1. The claimant may lodge a Reply to the Defence to the Statement for a declaration of non-infringement within one month.

2. The defendant may lodge a Rejoinder to the Reply within one month of service of the Reply. The Rejoinder shall be limited to the matters raised in the Reply.

**Rule 68 – Fee for the action for a declaration of non-infringement**

The claimant shall pay the fee for the action for a declaration of non-infringement [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

**Rule 27 on Examination as to formal requirements of the Statement of defence** shall apply *mutatis mutandis*

**Rule 28 on Further schedule** shall apply *mutatis mutandis*

**Rules 33 and 34 on Request for allocating a technically qualified judge** shall apply where the action is heard by a regional division or a local division

**Rule 35 on Closure of the written procedure** shall apply *mutatis mutandis*

**Rule 36 on Further exchanges of written pleadings** shall apply

**Rule 69 – Value-based fee for the action for a declaration of non-infringement**

1. The value of the action for a declaration of non-infringement shall be determined by the judge-rapporteur, taking into account the value of the dispute as assessed by the parties, by way of an order during the interim procedure.

2. Where the value of the dispute exceeds [EUR\*\*\*] the claimant shall pay a value-based fee for the action for a declaration of non-infringement in accordance with Part 6 [Rules 370.2(b) and 371.4].

## **SECTION 4 – ACTIONS WITHIN ARTICLE 33(5) AND (6) OF THE AGREEMENT**

### **Rule 70 – Revocation action and subsequent infringement action in a local or regional division (Article 33(5) of the Agreement).**

1. Where a claimant has lodged a Statement for revocation [Rule 45] before the central division and the defendant or a licensee entitled to commence proceedings pursuant to Article 47 of the Agreement subsequently initiates an infringement action in a local or regional division against the claimant in respect of the same patent (or patents) the following procedures shall apply.
2. The Registry at the local or regional division shall proceed in accordance with Rules 16 and 17. The Registry shall as soon as practicable notify the President of the Court of First Instance of the revocation action in the central division, the infringement action in the local or regional division and any counterclaim for revocation in the infringement action. The presiding judges of the panels seized shall be informed likewise about actions in the other divisions.
3. Where a counterclaim for revocation is brought in the infringement action and there is identity of parties as between the two actions, unless otherwise agreed by the parties, the panel appointed in the central division to hear the revocation action shall stay all further proceedings in the revocation action pending a decision of the panel hearing the action for infringement pursuant to Article 33(3) of the Agreement and Rule 37.
4. The panel hearing the action for infringement shall when exercising its discretion under Article 33(3) of the Agreement take into consideration how far the revocation action in the central division was advanced prior to the stay referred to in Rule 70.3.
5. Where the panel hearing the action for infringement decides to proceed in accordance with Article 33(3)(a) of the Agreement, Rules 33 and 34 shall apply *mutatis mutandis* to the action for infringement.
6. Where the panel hearing the action for infringement decides to proceed in accordance with Article 33(3)(b) or (c) of the Agreement, Rules 37.4 and 39 to 41 shall apply *mutatis mutandis*.

### **Rule 71 – Actions for declaration of non-infringement within Article 33(6) of the Agreement**

1. Where a claimant has lodged an action for declaration of non-infringement (Rule 60) before the central division against the patent proprietor or a licensee entitled to commence infringement proceedings pursuant to Article 47 of the Agreement and the defendant proprietor or licensee subsequently initiates an action for infringement in a local or regional division against the claimant in respect of the same patent or patents and with respect to the same alleged infringements the following procedure shall apply.
2. The Registry shall proceed in accordance with Rule 16 and 17. The Registry shall as soon as practicable notify the President of the Court of First Instance of the co-pending actions and the dates attributed to them. The presiding judges of the panels seized shall be informed likewise about the action in the other division.
3. If the date attributed by the Registry to the action for infringement pursuant to Rule 17.1(a) is within three months of the date attributed to the action for declaration of non-infringement the panel of the central division shall stay all further proceedings in the action for a declaration. If the date attributed to the action for infringement is outside the said three month period there shall be no stay but the presiding judges of the central division and the local or regional division

concerned shall consult to agree on the future progress of proceedings including the possibility of a stay of one action pursuant to Rule 295(k).

#### **Rule 72 – Action for declaration of non-infringement and action for revocation**

An action for declaration of non-infringement may be lodged together with an action for revocation of the patent (or patents) in question. Fees shall be paid in accordance with both Rules 47 and 57 and Rules 68 and 69.

### **SECTION 5 – ACTION FOR COMPENSATION FOR LICENCES ON THE BASIS OF ARTICLE 8 OF REGULATION (EU) No 1257/2012**

#### **Rule 80 – Compensation for a licence of right**

1. The Application for appropriate compensation [Article 32(1)(h) of the Agreement] shall contain:

- (a) particulars in accordance with Rule 13.1(a) to (d);
- (b) information on the filing of the statement as referred to in Article 8(1) of Regulation (EU) No 1257/2012;
- (c) the licence agreement referred to in Article 8(2) of Regulation (EU) No 1257/2012.

2. Rules 132, 133, 135 and 137 to 140 apply *mutatis mutandis* to the procedure for appropriate compensation.

3. The applicant shall pay the fee for compensation in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 32(1)(h)*

### **SECTION 6 – ACTION AGAINST DECISIONS OF THE EUROPEAN PATENT OFFICE IN CARRYING OUT THE TASKS REFERRED TO IN ARTICLE 9 OF REGULATION (EU) No 1257/2012**

*Relation with Agreement: Articles 32(1)(i), 47(7) and 66*

#### **Rule 85 – Stages of the proceedings (*ex parte* proceedings)**

1. Subject to Rule 85.2, where an action is brought against a decision of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012 (hereinafter "decision of the Office"), proceedings before the Court of First Instance shall consist of:

- (a) a written procedure, which shall include a possibility for interlocutory review by the European Patent Office;
- (b) an interim procedure, which may include an interim conference; and
- (c) an oral procedure which, at the request of the claimant or at the instance of the Court, may include an oral hearing.

2. This Rule and Rules 88 (save as expressly provided for in Rule 97.2), 89 and 91 to 96 shall not apply to an expedited action against a decision of the Office pursuant to Rule 97.

### **Rule 86 – Suspensive effect**

An action against a decision of the Office shall have suspensive effect.

### **Rule 87 – Grounds for annulling or altering a decision of the Office**

An action against a decision of the Office may be brought on grounds of:

- (a) infringement of Regulation (EU) No 1257/2012 or of Regulation (EU) No 1260/2012 or of any rule of law relating to their application;
- (b) infringement of any of the implementing rules of the European Patent Office for carrying out the tasks referred to in Article 9(1) of Regulation (EU) No 1257/2012;
- (c) infringement of an essential procedural requirement;
- (d) misuse of power.

### **Rule 88 – Application to annul or alter a decision of the Office**

1. The claimant shall lodge an Application at the Registry, in accordance with Article 7(2) of the Agreement and Annex II thereto, to annul or alter a decision of the Office in the language in which the patent was granted, within two months of service of the decision of the Office.

2. The Application to annul or alter a decision of the Office shall contain:

- (a) the names of the claimant and, where applicable, of the claimant's representative;
- (b) where the claimant is not the proprietor of or applicant for the European patent with unitary effect, an explanation and evidence that he is adversely affected by the decision of the Office and entitled to start proceedings [Article 47(7) of the Agreement];
- (c) postal and electronic addresses for service on the claimant and the names and addresses of the persons authorised to accept service;
- (d) a reference to the contested decision of the Office;
- (e) where applicable, information about any prior or pending proceedings relating to the patent concerned before the Court, the European Patent Office or any other court or authority;
- (f) an indication whether the action shall be heard by a single judge;
- (g) the order or the remedy sought by the claimant;
- (h) one or more grounds for annulling or altering the contested decision, in accordance with Rule 87;
- (i) the facts, evidence and arguments relied on; and
- (j) a list of the documents, including any witness statements, referred to in the Application together with any request that all or part of any such document need not be translated and/or any request pursuant to Rule 262.1. Rule 13.2 and 3 shall apply *mutatis mutandis*.

3. The claimant shall pay the fee for the action against a decision of the Office, in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

4. Rule 8 shall not apply.

*Relation with Agreement: Articles 32(1)(i), 33(9), 47(7), 48(7) and 49(6)*

#### **Rule 89 – Examination as to formal requirements (*ex parte* proceedings)**

1. The Registry shall, as soon as practicable after an Application to annul or alter a decision of the Office has been lodged, examine whether the requirements of Articles 47(7) and 49(6) of the Agreement and Rule 88.1, .2(a) to (d) and .3 have been complied with.

2. If the Registry considers that any of the requirements referred to in paragraph 1 has not been complied with, it shall invite the claimant to:

(a) correct the deficiencies noted, within 14 days from the date of service of such notification; and

(b) where applicable, pay the fee for the action against a decision of the Office, within said 14 days.

3. The Registry shall at the same time inform the claimant that if the claimant fails to correct the deficiencies or pay the fee within the time stated, a decision by default may be given in accordance with Rule 355.

4. If the claimant fails to correct the deficiencies noted or to pay the fee for the action against a decision of the Office, the Registry shall inform the President of the Court of First Instance who may reject the action as inadmissible by a decision by default. He may give the claimant an opportunity to be heard beforehand.

#### **Rule 90 – Recording in the register (*ex parte* proceedings)**

If the requirements referred to in Rule 89.1 have been complied with, the Registry shall as soon as practicable:

(a) record the date of receipt of the Application to annul or alter a decision of the Office and attribute an action number to the file;

(b) record the file in the register;

(c) inform the claimant of the action number of the file and the date of receipt; and

(d) forward the Application to the European Patent Office, with an indication that the Application is admissible.

#### **Rule 91 – Interlocutory revision by the European Patent Office**

1. If the European Patent Office considers that the Application to annul or alter a decision of the Office is well founded, it shall within two months of the date of receipt of the Application:

(a) rectify the contested decision in accordance with the order or remedy sought by the claimant [Rule 88.2(f)]; and

(b) inform the Court that the decision has been rectified.

2. Where the Court is informed by the European Patent Office that the contested decision has been rectified, it shall inform the claimant that the action is closed. It may order full or partial

reimbursement of the fee for the action against a decision of the Office, in accordance with Part 6.

#### **Rule 92 – Assignment to panel or to single judge, designation of judge-rapporteur**

Where the action is not closed in accordance with Rule 91.2, the action shall, as soon as practicable after the expiry of the period referred to in Rule 91.1, be assigned to a panel of the central division or to a single judge if requested by the claimant [Rule 88.2(f)] in accordance with Rule 345.3. Rule 18 shall apply.

#### **Rule 93 – Examination of the Application to annul or alter a decision of the Office**

1. In the examination of the Application to annul or alter a decision of the Office, the judge-rapporteur may invite the claimant to lodge further written pleadings, within a time period to be specified.

2. Where appropriate, the judge-rapporteur may, after consulting the claimant, set a date and time for an interim conference.

3. Rule 35 shall apply *mutatis mutandis*.

#### **Rule 94 – Invitation to the President of the European Patent Office to comment**

The judge-rapporteur may, on his own initiative or on request by the President of the European Patent Office, invite the President of the European Patent Office to comment in writing on any question arising in the course of proceedings under this Section. The claimant shall be entitled to submit his observations on the President's comments.

#### **Rule 95 – *Lex specialis* for the interim procedure (*ex parte* procedure)**

During the interim procedure, the judge-rapporteur shall invite the claimant to indicate whether he wishes that an oral hearing be convened. The judge-rapporteur may convene an oral hearing at his own instance.

#### **Rule 96 – *Lex specialis* for the oral procedure (*ex parte* procedure)**

1. Rules 110.3, 111, 115 and 118.6 shall apply to the oral hearing and to the decision of the Court.

2. If an oral hearing is not convened, the panel shall decide in accordance with Rule 117.

#### **Rule 97 – Application to annul a decision of the Office to reject a request for unitary effect**

1. The proprietor of a patent whose request for unitary effect has been rejected by the Office shall lodge an Application at the Registry in accordance with Article 7(2) of the Agreement and Annex II thereto, to reverse the decision of the Office, in the language in which the patent was granted, within three weeks of service of the decision of the European Patent Office.

2. The Application shall contain particulars in accordance with Rule 88.2(a), (c), (d) and (f) to (i) and the proprietor shall pay the fee for the action against the decision of the Office in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

3. If the requirements referred to in Rule 97.2 have been complied with, Rule 90 shall apply *mutatis mutandis*.

4. The Registry shall as soon as practicable forward the Application to the standing judge who may invite the President of the European Patent Office to comment on the Application, but shall in any event decide the Application within three weeks of the date of receipt of the Application.

5. A Statement of appeal by the proprietor of the patent or the President of the European Patent Office against the decisions of the standing judge pursuant to Rule 97.4 may be lodged within three weeks of service of the said decision. The Statement of appeal shall contain the particulars previously lodged pursuant to Rule 97.2 and also the reasons for setting aside the contested decision. The appellant shall pay the fee for the appeal in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*. If the requirements of this Rule 97.5 have been complied with the Registry shall record the appeal in accordance with Rule 230.1 and shall as soon as practicable assign the appeal to the standing judge of the Court of Appeal [Rule 345.5 and 345.8] who may invite the other party to comment on the appeal but shall in any event decide the appeal within three weeks of receipt by the Registry of the Statement of appeal.

6. The Registry shall as soon as practicable notify the Office of the decision on the Application or on the appeal as the case may be.

#### **Rule 98 – Costs**

The parties shall bear their own costs in any action pursuant to Rule 85 or Rule 97.

## **CHAPTER 2 – INTERIM PROCEDURE**

### **Rule 101 – Role of the judge-rapporteur (Case management)**

1. During the interim procedure, the judge-rapporteur shall make all necessary preparations for the oral hearing. He may in particular, where appropriate, and subject to the mandate of the panel, hold an interim conference with the parties which may be held on more than one occasion and may exercise the powers provided for in Rule 334.
2. The judge-rapporteur shall have the obligation to ensure a fair, orderly and efficient interim procedure.
3. Without prejudice to the principle of proportionality, the judge-rapporteur shall complete the interim procedure within three months of the closure of the written procedure.

*Relation with Agreement: Articles 43 and 52(2)*

### **Rule 102 – Referral to the panel**

1. The judge-rapporteur may refer any matter to the panel for decision and the panel may of its own motion review any decision or order of the judge-rapporteur or the conduct of the interim procedure.
2. Any party may request that a decision or order of the judge-rapporteur be referred to the panel for a review pursuant to Rule 333. Pending review, the decision or order of the judge-rapporteur shall be effective.

### **Rule 103 – Preparation for the interim conference**

1. Whether or not the judge-rapporteur decides to hold an interim conference, he may order the parties, within time periods to be specified, in particular to:
  - (a) provide further clarification on specific points;
  - (b) answer specific questions;
  - (c) produce evidence;
  - (d) lodge specific documents including each party's summary of the orders to be sought at the interim conference.

The judge-rapporteur shall at the same time inform the party concerned that if the party fails to comply with the order within the time period specified, a decision by default may be given in accordance with Rule 355.

2. If a party fails to comply with an order of the judge-rapporteur within the time period specified, the judge-rapporteur may give a decision by default pursuant to Rule 355.

## **INTERIM CONFERENCE**

### **Rule 104 – Aim of the interim conference**

The interim conference shall enable the judge-rapporteur to:

- (a) identify main issues and determine which relevant facts are in dispute;

- (b) where appropriate, clarify the position of the parties as regards those issues and facts;
- (c) establish a schedule for the further progress of the proceedings;
- (d) explore with the parties the possibilities to settle the dispute or to make use of the facilities of the Centre;
- (e) where appropriate, issue orders regarding production of further pleadings, documents, experts (including court experts), experiments, inspections, further written evidence, the matters to be the subject of oral evidence and the scope of questions to be put to the witnesses;
- (f) where appropriate, but only in the presence of the parties, hold preparatory discussions with witnesses and experts with a view to properly preparing for the oral hearing;
- (g) make any other decision or order as he deems necessary for the preparation of the oral hearing including, after consultation with the presiding judge, an order for a separate hearing of witnesses and experts before the panel;
- (h) set a date for any separate hearing pursuant to point (g) of this Rule and confirm the date for the oral hearing;
- (i) decide the value of the particular dispute which value may, in exceptional cases, differ as between the parties depending upon the parties' individual circumstances;
- (j) order the parties to submit, in advance of the decision at the oral hearing, a preliminary estimate of the legal costs that they will seek to recover.

*Relation with Agreement: Article 52(2)*

#### **Rule 105 – Holding the interim conference**

1. The interim conference should, where practicable, be held by telephone conference or by video conference.
2. On request by a party, subject to paragraph 1 and the approval of the judge-rapporteur, the interim conference may be held in Court. If the interim conference is held in Court, it shall be open to the public unless the Court decides to make it, to the extent necessary, confidential in the interests of one or both parties or third parties or in the general interests of justice or public order.
3. The judge-rapporteur may hold the interim conference in any language agreed by the parties' representatives.
4. Rule 103 shall apply *mutatis mutandis*.
5. Following the interim conference, the judge-rapporteur shall issue an order setting out the decisions taken.

#### **Rule 106 – Recording of the interim conference**

The interim conference shall be audio recorded. The recording shall be made available at the premises of the Court to the parties or their representatives after the hearing.

*Relation with Agreement: Articles 44 and 45*

## **PREPARATION FOR THE ORAL HEARING**

### **Rule 108 – Summons to the oral hearing**

The judge-rapporteur shall summon the parties to the oral hearing which shall take place before the panel on the date(s) set under Rule 28 and/or Rule 41(c) and Rule 104(h). If no date(s) have been set the judge-rapporteur shall set a date for the oral hearing. At least two months' notice shall be given, unless the parties agree to a shorter time period.

### **Rule 109 – Simultaneous interpretation during oral hearings**

1. At the latest one month before the oral hearing including any separate hearing of witnesses and experts a party may lodge a Request for simultaneous interpretation which shall contain:

(a) an indication of the language to or from which the party requests simultaneous interpretation during the oral hearing;

(b) the reasons for the Request;

(c) the field of technology concerned;

(d) any other information of relevance for the Request.

2. The judge-rapporteur shall decide whether and to what extent simultaneous interpretation is appropriate and shall, instruct the Registry to make all necessary arrangements for simultaneous interpretation. In the event that the judge-rapporteur refuses to order simultaneous interpretation the parties may request arrangements to be made, so far as practically possible, for simultaneous interpretation at their cost.

3. The judge-rapporteur may decide on his own motion to order simultaneous interpretation and shall instruct the Registry and inform the parties accordingly.

4. A party wishing to engage an interpreter at its own expense shall inform the Registry at the latest two weeks before the oral hearing.

5. Costs for simultaneous interpretation are costs of the proceedings to be decided upon under Rule 150 except where a party engages an interpreter at its own expense under paragraph 4; these costs are borne solely by that party.

*Relation with Agreement: Article 51(2)*

### **Rule 110 – Closure of the interim procedure**

1. As soon as the judge-rapporteur considers that the state of preparation of the file is adequate, he shall inform the presiding judge and the parties that the interim procedure is closed in view of the oral hearing.

2. Where final dates have been set pursuant to Rules 103 and 104 the interim procedure shall be deemed closed on the last date set.

3. The oral procedure shall start immediately after the interim procedure is closed. The presiding judge shall, in consultation with the judge-rapporteur, take over the management of the action.

## **CHAPTER 3 – ORAL PROCEDURE**

### **Rule 111 – Role of the presiding judge (Case management)**

The presiding judge shall:

- (a) have all authority to ensure a fair, orderly and efficient oral procedure; and
- (b) ensure that the action is ready for decision on the merits at the end of the oral hearing.

### **Rule 112 – Conduct of the oral hearing**

1. The oral hearing shall be held before the panel and shall be under the control of the presiding judge.
2. The oral hearing shall consist of:
  - (a) the hearing of the parties' oral submissions;
  - (b) if ordered during the interim procedure, the hearing of witnesses and experts under the control of the presiding judge.
3. The presiding judge and the judges of the panel may provide a preliminary introduction to the action and put questions to the parties, to the parties' representatives and to any witness or expert.
4. Under the control of the presiding judge, the parties may put questions to the witness or expert. The presiding judge may prohibit any question which is not designed to adduce admissible evidence.
5. With the consent of the Court a witness may give evidence in a language other than the language of proceedings.

*Relation with Agreement: Articles 52(3) and 53(1)*

### **Rule 113 – Duration of the oral hearing**

1. Without prejudice to the application of the principle of proportionality, the presiding judge shall endeavour to complete the oral hearing within one day. The presiding judge may set time limits for parties' oral submissions in advance of the oral hearing.
2. Oral testimony at the oral hearing or at any separate hearing shall be limited to issues identified by the judge-rapporteur or the presiding judge as having to be decided on the basis of oral evidence.
3. The presiding judge may, after consulting the panel, limit a party's oral submissions if the panel is sufficiently informed.

### **Rule 114 – Adjournment where the Court considers that further evidence is required**

In exceptional cases, the Court may, after hearing the parties' oral submissions, decide to adjourn proceedings and call for further evidence.

### **Rule 115 – The oral hearing**

The oral hearing and any separate hearing of witnesses shall be open to the public unless the Court decides to make a hearing, to the extent necessary, confidential in the interests of one or both parties or third parties or in the general interests of justice or public order. The hearing shall be audio recorded. The recording shall be made available to the parties or their representatives at the premises of the Court after the hearing. Rule 103 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 45*

### **Rule 116 – Absence of a party from the oral hearing**

1. A party which does not wish to be represented at the oral hearing shall inform the Registry in good time. Where both parties have informed the Registry that they do not wish to be represented at the oral hearing, the Court may decide the action in accordance with Rule 117.
2. The Court shall not be obliged to delay any step in the procedure, including the decision on the merits, by reason only of the absence of a party from the oral hearing.
3. A party that is not represented at the oral hearing shall be treated as relying only on its written case.
4. If due to an exceptional occurrence a party is prevented from being represented at the oral hearing, the Court shall on a reasoned request of that party, adjourn the oral hearing.
5. The provisions of this Rule are without prejudice to the power of the Court to give a decision by default pursuant to Rule 355.

### **Rule 117 – Absence of both parties from the oral hearing**

Where both parties have informed the Registry that they do not wish to be represented at the oral hearing the Court shall take a decision on the merits on the basis of the pleadings and evidence submitted by the parties and the court expert, if applicable, and otherwise in accordance with Rules 118 and 350 to 354.

### **Rule 118 – Decision on the merits**

1. In addition to the orders and measures and without prejudice to the discretion of the Court referred to in Articles 63, 64, 67 and 80 of the Agreement the Court may, if requested, order the payment of damages or compensation according to Articles 68 and 32(1)(f) of the Agreement. The amount of the damages or the compensation may be stated in the order or determined in separate proceedings [Rules 125-143]].
2. If, while there are infringement proceedings before a local or regional division, a revocation action is pending between the same parties before the central division or an opposition is pending before the European Patent Office, the local or regional division:
  - (a) may render its decision on the merits of the infringement claim, including its orders, under the condition subsequent pursuant to Article 56(1) of the Agreement that the patent (patents) is (are) not held to be wholly or partially invalid by the final decision in the revocation procedure or a final decision of the European Patent Office or under any other term or condition; or

(b) may stay the infringement proceedings pending a decision in the revocation procedure or a decision of the European Patent Office and shall stay the infringement proceedings if it is of the view that there is a high likelihood that the relevant claims of the patent (or patents) will be held to be invalid on any ground by the final decision in the revocation procedure or of the European Patent Office where such decision of the European Patent Office may be expected to be given rapidly.

3. Where, in the decision on the merits of a revocation action, the patent (or patents) is (are) found to be entirely or partially invalid, the Court shall revoke the patent (patents) entirely or partially according to Article 65 of the Agreement.

4. Where the Court has made orders in accordance with paragraph 2(a) any party may apply to the local or regional division within two months following a final decision of the central division or the Court of Appeal or the European Patent Office as the case may be on the validity of the patent(s) for orders consequential on such final decision [Rule 354.2].

5. The Court shall decide in principle on the obligation to bear legal costs in accordance with Article 69 of the Agreement. The Court may order in advance of the decision that the parties submit a preliminary estimate of the legal costs that they will seek to recover.

6.(a) The Court shall give the decision on the merits as soon as possible after the closure of the oral hearing. The Court shall endeavour to issue the decision on the merits in writing within six weeks of the oral hearing.

(b) The Court shall give reasons for its decision.

7. The Court may give its decision immediately after the closure of the oral hearing and provide its reasons on a subsequent date.

8. The orders of the Court referred to in paragraphs 1 and 3(a) shall be enforceable on the defendant only after the claimant has notified the Court which part of the orders he intends to enforce, a certified translation of the orders in accordance with Rule 7.2, where applicable, into the official language of a Contracting Member State in which the enforcement shall take place has been provided by the claimant and the said notice and, where applicable, a certified translation of the orders have been served on the defendant by the Registry. The Court may subject any order or measure to a security to be given by the successful party to the unsuccessful party as determined by the Court in accordance with Rule 352.

*Relation with Agreement: Article 77*

### **Rule 119 – Interim award of damages**

The Court may order an interim award of damages to the successful party in the decision on the merits, subject to any conditions that the Court may order. Such award shall at least cover the expected costs of the procedure for the award of damages and compensation on the part of the successful party.

## **CHAPTER 4 – PROCEDURE FOR THE DETERMINATION OF DAMAGES AND COMPENSATION**

### **Rule 125 – Separate proceedings for determining the amount of damages ordered**

The determination of the amount of damages ordered for the successful party may be the subject of separate proceedings. The determination shall include the determination of the amount of compensation, if any, to be awarded as a result of the provisional protection conferred by a published European patent application [Article 32(1)(f) of the Agreement, Article 67 EPC] and compensation to be paid pursuant to Rules 118.1, 198.2, 213.2 and 354.2. The expression “damages” used in Chapter 4 shall be deemed to include such compensation and interest at the rate and for the period that the Court shall decide.

### **Rule 126 – Start of proceedings for the determination of damages**

Where the successful party wishes to have the amount of damages determined, it shall no later than one year from service of the final decision on the merits (including any final decision on appeal) on both infringement and validity (or in the case of an award under Rules 118.1, 198.2, 213.2 or 354.2 from the date of the order for such award) lodge an Application for the determination of damages, which may include a request for an order to lay open books.

*Relation with Agreement: Article 68*

## **SECTION 1 – APPLICATION FOR THE DETERMINATION OF DAMAGES**

### **Rule 131 – Contents of the Application for the determination of damages**

1. The Application for the determination of damages shall contain:

- (a) particulars in accordance with Rule 13.1(a) to (d);
- (b) the date of the decision on the merits and the action number of the file;
- (c) if required a request for an order to lay open books (Rules 141 to 143) in which case the applicant shall provide the matters set out in Rule 141(b) to (e).

2. After any procedure for the laying open of books is complete, or, if that has not been requested in the Application referred to in Rule 131.1 the applicant shall indicate:

- (a) the redress (damages, licence fees, profits) and the interest thereon requested by him;
- (b) an indication of the facts relied on, in particular calculations concerning lost profits or profits made by the unsuccessful party;
- (c) the evidence relied on;
- (d) a statement as to whether the decision on the merits is the subject of an appeal;
- (e) his assessment of the amount of damages due to him.

### **Rule 132 – Fee for the Application for the determination of damages**

The applicant shall pay the fee for the determination of damages [EUR\*\*\*] in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

### **Rule 133 – Value-based fee for the determination of damages**

Where the value of damages based on the assessment under Rule 131.2(e) exceeds [EUR\*\*\*] the applicant shall pay a fee based on the value of that assessment for the determination of damages in accordance with Part 6 [Rules 370.2(b) and 371.4]

### **Rule 134 – Examination as to formal requirements of the Application for the determination of damages**

1. The Registry shall, as soon as practicable after the lodging of the Application for the determination of damages, examine whether the requirements of Rules 126, 131.1 and .2(d) and (e) and 132 have been complied with.

2. If the Application for the determination of damages does not comply with the requirements referred to in paragraph 1, the Registry shall invite the applicant to correct the deficiencies noted within a time period to be specified.

3. Rule 16.4 to .5 shall apply *mutatis mutandis*.

### **Rule 135 – Recording in the register (Application for the determination of damages) and service**

1. If the requirements referred to in Rule 131.1 and .2(d) and (e) have been complied with, the Registry shall as soon as practicable:

(a) record the date of receipt of the Application for the determination of damages;

(b) record the Application in the register;

(c) inform the applicant of the date of receipt;

(d) inform the panel which has given the decision on the merits on infringement that an Application for the determination of damages has been lodged;

(e) serve the Application upon the unsuccessful party.

2. The panel which has given the decision on the merits on infringement shall be the panel for the determination of damages unless for any reason this is not possible or practical in which case the presiding judge of the division concerned shall appoint a fresh panel. Rules 17.2 and 18 shall apply *mutatis mutandis*.

### **Rule 136 – Stay of the Application for a determination of damages**

The Court may stay the Application for a determination of damages pending any appeal on the merits pursuant to Rule 295(g) on a reasoned request by the unsuccessful party. The applicant shall be given the opportunity to be heard. If the Court continues the proceedings on the Application it may order the applicant to render a security according to Rule 352.

### **Rule 137 – Reply of the unsuccessful party**

1. If the unsuccessful party accepts the claim made in the Application for the determination of damages, it shall within two months inform the Registry. The judge-rapporteur shall make the order for the determination of damages in accordance with the Application for the determination of damages.

2. If the unsuccessful party contests the claim made in the Application for the determination of damages, it shall within two months of service of the Application for the determination of damages or, where there was a procedure for the laying open of books, within two months of service of the indication pursuant to Rule 131.2, lodge a Defence to the Application for the determination of damages.

#### **Rule 138 – Contents of the Defence to the Application for the determination of damages**

The Defence to the Application for the determination of damages shall contain:

- (a) the names of the unsuccessful party and of that party's representative;
- (b) postal and electronic addresses for service on the unsuccessful party and the names and addresses of the persons authorised to accept service;
- (c) the action number attributed to the file;
- (d) the reasons why the Application for the award of damages is contested;
- (e) an indication of the facts relied on; and
- (f) the evidence relied on.

#### **Rule 139 – Reply to the Defence to the Application for the determination of damages and Rejoinder to the Reply**

The applicant may within one month lodge a Reply to the Defence to the Application for the determination of damages, limited to the matters raised in the Defence. The unsuccessful party may lodge a Rejoinder to the Reply within one month of service of the Reply, limited to the matters raised in the Reply.

#### **Rule 140 – Further procedure (Application for the determination of damages)**

1. The judge-rapporteur may order further exchange of written pleadings, within time periods to be specified.

2. The provisions of Part 1, Chapters 2 (Interim procedure) and 3 (Oral procedure) shall apply *mutatis mutandis* but with such reduced timetable as the judge-rapporteur may order. He shall decide on the obligation to bear the legal costs of the proceedings for the determination of damages in accordance with Article 69 of the Agreement.

### **SECTION 2 – REQUEST TO LAY OPEN BOOKS**

#### **Rule 141 – Contents of the Request to lay open books**

If the applicant has made a request pursuant to Rule 131.1(c), Rules 134 to 136 shall apply *mutatis mutandis*. The Request shall contain:

- (a) particulars in accordance with Rule 131.1(a) and (b);
- (b) details of any information ordered by the Court and given by the other party pursuant to Rule 191;
- (c) a description of the information held by the unsuccessful party to which the applicant requests access, in particular documents relating to turnover and profits generated by the

infringing products or regarding the extent of use of the infringing process as well as accounts and bank documents, and any related document concerning the infringement;

(d) the reasons why the applicant needs access to this information;

(e) the facts relied on; and

(f) the evidence offered in support.

**Rule 142 – Defence of the unsuccessful party, Reply to the Defence and Rejoinder to the Reply**

1. If the unsuccessful party accepts the Request to lay open books, it shall within two months of service of the Request to lay open books inform the Registry. The judge-rapporteur shall make the order to lay open books in accordance with the Request to lay open books.

2. If the unsuccessful party contests the Request to lay open books, it shall within two months of service of the Request to lay open books lodge a Defence to the Request to lay open books.

3. The applicant may within 14 days of service of the Defence to the Request lodge a Reply to the Defence to the Request to lay open books, limited to the matters raised in the Defence. The unsuccessful party may within 14 days of service of the Reply lodge a Rejoinder, limited to the matters raised in the Reply.

**Rule 138 on Contents of the Defence to the application for the determination of damages** shall apply *mutatis mutandis*

**Rule 140 on Further procedure (Application for the determination of damages)** shall apply *mutatis mutandis*

**Rule 143 – Decision on the Request to lay open books**

1. The Court may:

(a) order the unsuccessful party to open its books to the applicant within a time period to be specified and subject to such terms as the Court may deem appropriate having regard *inter alia* to Article 58 of the Agreement and Rule 190.1 and .4;

(b) inform the applicant and specify a time period within which the procedure for the award of damages shall be continued.

2. Where the Request to lay open books is not allowable, the Court shall inform the applicant and specify a time period within which the procedure for the award of damages shall be continued [Rule 131.2].

## **CHAPTER 5 – PROCEDURE FOR COST DECISION**

### **Rule 150 – Separate proceedings for cost decision**

1. A cost decision may be the subject of separate proceedings following a decision on the merits and, if applicable, a decision for the determination of damages. The cost decision shall cover costs incurred in the proceedings by the Court such as costs for simultaneous interpretation and costs incurred pursuant to Rules 180.3, 185.7, 188, 201 and 202 and, subject to the Rules 152 to 156, the costs of the successful party including Court fees paid by that party [Rule 151(d)]. Costs for interpretation and translation which is necessary for the judges of the Court in order to conduct the case in the language of proceedings are borne solely by the Court.

2. The Court may order an interim award of costs to the successful party in the decision on the merits [Rule 119] or in a decision for the determination of damages, subject to any conditions that the Court may decide.

### **Rule 151 – Start of proceedings for cost decision**

Where the successful party (hereinafter "the applicant") wishes to seek a cost decision, it shall within one month of service of the decision lodge an Application for a cost decision which shall contain:

- (a) particulars in accordance with Rule 13.1(a) to (d);
- (b) the date of the decision and the action number of the file;
- (c) a statement as to whether the decision on the merits is the subject of an appeal, if known at the date of the Application;
- (d) an indication of the costs for which compensation is requested, which may include recovery of court fees and costs of representation, of witnesses, of experts, and other expenses; and
- (e) the preliminary estimate of the legal costs that the party submitted pursuant to Rule 118.5.

### **Rule 152 – Compensation for representation costs re decision on the merits**

1. The applicant shall be entitled to recover reasonable and proportionate costs for representation.

2. The Administrative Committee shall adopt a scale of recoverable costs which shall set ceilings for such costs by reference to the value of the dispute. The scale may be adjusted from time to time.

### **Rule 153 – Compensation for costs of experts**

The compensation for costs of experts of the parties [Rule 181] exceeding the expenses referred to in Rule 180.1 shall be based on the rates that are customary in the respective sector, with due regard to the required expertise, the complexity of the issue and the time spent by the expert for the services rendered.

### **Rule 154 – Compensation for costs of witnesses**

Where the Court has ordered the deposit of a sum sufficient to cover the expenses of a witness in accordance with Rule 180.2 or of a party's expert in accordance with Rule 181, compensation

may be requested for payments made by the Registry towards the expenses incurred by a witness or an expert.

**Rule 155 – Compensation for costs of interpreters and translators**

1. The compensation for costs of interpreters shall be the rates that are customary in the country of the division in question, depending on the interpreter's training and professional experience.
2. The compensation for costs of translators shall be the rates that are customary in the country of the division in question, depending on the translator's training and professional experience.

**Rule 156 – Further procedure**

1. The judge-rapporteur may request the applicant to provide written evidence of all costs requested in Rule 151(d). The judge-rapporteur shall allow the unsuccessful party an opportunity to comment in writing on the costs requested including any item of costs that should be apportioned or borne by each party in accordance with Article 69(1) to (3) of the Agreement.
2. The judge-rapporteur shall decide in writing on the costs to be awarded or apportioned in accordance with Article 69(1) to (3) of the Agreement.
3. The costs shall be paid within the period ordered by the judge-rapporteur.

**Rule 157 – Appeal against the cost decision**

The decision of the judge rapporteur as to costs only may be appealed to the Court of Appeal in accordance with Rule 221.

*Relation with Agreement: Article 69*

## **CHAPTER 6 – SECURITY FOR COSTS**

### **Rule 158 – Security for costs of a party**

1. At any time during proceedings, following a reasoned request by one party, the Court may order the other party to provide, within a specified time period, adequate security for the legal costs and other expenses incurred and/or to be incurred by the requesting party, which the other party may be liable to bear. Where the Court decides to order such security, it shall decide whether it is appropriate to order the security by deposit or bank guarantee.
2. The Court shall give the parties an opportunity to be heard before making an order for security. Rule 354 shall apply to the enforcement of the order.
3. The order for security shall indicate that an appeal may be lodged in accordance with Article 73 of the Agreement and Rule 220.2.
4. The Court shall, when specifying the time period in paragraph 1, inform the party concerned that if the party fails to provide adequate security within the time stated, a decision by default may be given, in accordance with Rule 355.
5. If a party fails to provide adequate security within the time stated, the Court may give a decision by default pursuant to Rule 355.

*Relation with the Agreement: Article 69(4)*

### **Rule 159 – Security for costs of the Court**

Except where deposits are rendered pursuant to Rule 180.2, the Court may order that either or both parties provide adequate security (either by deposit or bank guarantee) to cover costs incurred and/or to be incurred in the proceedings by the Court, pending a cost decision pursuant to Rule 150.1. Rules 158.2 and .3 shall apply.

## **PART 2 – EVIDENCE**

### **Rule 170 – Means of evidence and means of obtaining evidence**

1. In proceedings before the Court, the means of evidence shall include in particular the following:

- (a) written evidence, whether printed, hand-written or drawn, in particular documents, written witness statements, plans, drawings, photographs;
- (b) expert reports and reports on experiments carried out for the purpose of the proceedings;
- (c) physical objects, in particular devices, products, embodiments, exhibits, models;
- (d) electronic files and audio / video recordings.

2. Means of obtaining evidence shall include in particular the following:

- (a) hearing of the parties;
- (b) requests for information;
- (c) production of documents;
- (d) summoning, hearing and questioning of witnesses;
- (e) appointing, receiving opinions from, summoning and hearing and questioning of experts;
- (f) ordering inspection of a place or a physical object;
- (g) conducting comparative tests and experiments;
- (h) sworn statements in writing (written witness statements).

3. Means of obtaining evidence shall further include [Article 59 and 60 of the Agreement]:

- (a) ordering a party or a third party to produce evidence;
- (b) ordering measures to preserve evidence.

### **Rule 171 – Offering of evidence**

1. A party making a statement of fact that is contested or likely to be contested by the other party shall indicate the means of evidence to prove it. In case of failure to indicate the means of evidence regarding a contested fact, the Court shall take such failure into account when deciding the issue in question.

2. A statement of fact that is not specifically contested by any party shall be held to be true as between the parties.

### **Rule 172 – Duty to produce evidence**

1. Evidence available to a party regarding a statement of fact that is contested or likely to be contested by the other party must be produced by the party making that statement of fact.

2. The Court may at any time during the proceedings order a party making a statement of fact to produce evidence that lies in the control of that party. If the party fails to produce the evidence, the Court shall take such failure into account when deciding on the issue in question.

*Relation with Agreement: Article 53*

**Rule 173 – Cooperation between the courts of the Member States in the taking of evidence**

For the taking of evidence in the European Union, the Regulation (EC) No 1206/2001 on cooperation between the courts of the Member States in the taking of evidence in civil or commercial matters shall apply.

## **CHAPTER 1 – WITNESSES AND EXPERTS OF THE PARTIES**

### **Rule 175 – Written witness statement**

1. A party seeking to offer witness evidence shall lodge a written witness statement or a written summary of the evidence to be given.
2. A written witness statement shall be signed by the witness and shall include a statement of the witness that he is aware of his obligation to tell the truth and of his liability under applicable national law in the event of any breach of this obligation. The statement shall set out the language in which the witness shall give oral evidence, if necessary.
3. The written witness statement or written summary of the evidence to be given shall set out:
  - (a) any current or past relationship between the witness and the party offering the evidence; and
  - (b) any actual or potential conflict of interest that may affect the impartiality of the witness.

### **Rule 176 – Application for the hearing of a witness in person**

Subject to the orders of the Court referred to in Rules 104(e) and 112.2(b) a party seeking to offer oral witness evidence shall make an Application for the hearing of a witness in person which shall set out:

- (a) the reasons why the witness should be heard in person;
- (b) the facts which the party expects the witness to confirm; and
- (c) the language in which the witness shall give evidence.

### **Rule 177 – Summoning of witnesses to the oral hearing**

1. The Court may order that a witness be heard in person:
  - (a) of its own motion;
  - (b) where a written witness statement is challenged by the other party; or
  - (c) on an Application for the hearing of a witness in person [Rule 176].
2. An order of the Court summoning a witness to the oral hearing shall in particular indicate:
  - (a) the name, address and description of the witness;
  - (b) the date and place of the oral hearing;
  - (c) an indication of the facts of the action about which the witness is to be examined;
  - (d) information about the reimbursement of expenses incurred by the witness;
  - (e) a statement that the witness will be questioned by the Court and the parties; and
  - (f) the language of the proceedings and the possibility of arranging simultaneous interpretation between that language and the language of the witness, if necessary [Rule 109].

3. In its order summoning the witness, the Court shall also inform the witness of his duties and rights as a witness under Rules 178 and 179, including the sanctions which may be imposed on a defaulting witness.

#### **Rule 178 – Hearing of witnesses**

1. After the identity of the witness has been established and before hearing his evidence, the presiding judge shall ask the witness to make the following declaration:

"I solemnly, sincerely and truly declare and affirm that the evidence I shall give shall be the truth, the whole truth and nothing but the truth."

2. The witness shall give his evidence to the Court.

3. The hearing of a witness who has signed a written witness statement shall begin with the confirmation of the evidence given therein. The witness may elaborate on the evidence contained in his written witness statement.

4. The presiding judge and the judges of the panel may put questions to the witness.

5. Under the control of the presiding judge, the parties may put questions to the witness. The presiding judge may prohibit any question which is not designed to adduce admissible evidence.

6. The Court may allow a witness to give evidence through electronic means, such as video conference. Paragraphs 1 to 5 and 7 shall apply.

7. With the consent of the Court a witness may give evidence in a language other than the language of proceedings.

#### **Rule 179 – Duties of witnesses**

1. Witnesses who have been duly summoned shall obey the summons and attend the oral hearing.

2. Without prejudice to paragraph 3, if a witness who has been duly summoned fails to appear before the Court or refuses to give evidence or to make the declaration referred to in Rule 178.1, the Court may impose upon him a pecuniary sanction not exceeding [EUR\*\*\*] and may order that a further summons be served at the witness's own expense. The Court may send a letter rogatory to the competent national court pursuant to Rule 202.

3. Nobody shall be obliged to sign a written witness statement or to give evidence at an oral hearing if he/she is a spouse, partner equal to a spouse under applicable national law, descendant, sibling or parent of a party. A witness may also refuse to answer questions if answering them would violate a professional privilege or other duty of confidentiality imposed by the national law applicable to the witness or expose him or his spouse, partner equal to a spouse under applicable national law, descendant, sibling or parent to criminal prosecution under applicable national law.

4. The Court may decide to report to the competent authorities of the Contracting Member States whose courts have criminal jurisdiction in case of the giving of false evidence on the part of a witness.

**Rule 180 – Reimbursement of expenses of witnesses**

1. A witness shall be entitled to reimbursement of:

- (a) expenses for travelling and stay; and
- (b) loss of income caused by his hearing in person.

After the witness has carried out his duties and upon his request, the Registry shall make a payment to the witness towards the expenses incurred.

2. The Court shall make the summoning of a witness conditional upon the deposit by the party relying on the witness of a sum sufficient to cover the expenses referred to in paragraph 1.

**Rule 181 – Experts of the parties**

1. Subject to the orders of the Court referred to in Rules 104(e) and 112.2(b) a party may provide any expert evidence that it considers necessary. Rules 175 to 180 shall apply *mutatis mutandis* to experts of the parties.

2. An order of the Court under Rule 177 summoning the expert shall additionally set out that:

- (a) an expert has a duty to assist the Court impartially on matters relevant to his area of expertise which overrides any duty to the party retaining him; and
- (b) an expert is to be independent and objective, and shall not act as an advocate for any party to the proceedings.

## **CHAPTER 2 – COURT EXPERTS**

### **Rule 185 – Appointment of a court expert**

1. Where the Court must resolve a specific technical or other question in relation to the action, it may of its own motion (and after hearing the parties) appoint a court expert.
2. The parties may make suggestions regarding the identity of the court expert, his technical or other relevant background and the questions to be put to him.
3. The court expert shall be responsible to the Court and shall possess the expertise, independence and impartiality required for being appointed as court expert. The parties shall be entitled to be heard on the expertise, independence and impartiality of the court expert.
4. The Court shall appoint a court expert by way of order which shall in particular specify:
  - (a) the name and address of the expert appointed;
  - (b) a short description of the facts of the action;
  - (c) the evidence submitted by the parties in respect of the technical or other question;
  - (d) the questions put to the expert, with the appropriate level of detail, including where appropriate suggestions relating to any experiments to be carried out;
  - (e) when and under what conditions the expert may receive other relevant information;
  - (f) the time period for the presentation of the expert report;
  - (g) information about the reimbursement of expenses incurred by the expert;
  - (h) information about the sanctions which may be imposed on a defaulting expert; and
  - (i) his duties under Rule 186.
5. The expert shall receive a copy of the order, together with the documents and other evidence that the Court considers to be necessary for carrying out his task.
6. The expert shall be required upon receipt of the order to confirm in writing that he will present the expert report within the time period specified by the Court.
7. The Court shall agree with the expert on a fee covering his written expert report and his participation in the oral hearing. The Court may reduce this fee by an equitable amount if the expert does not deliver his report within the time period specified by the Court or if the report did not have the quality to be expected of the expert.
8. If an appointed court expert does not present his report within the time period specified or, if extended at the expert's request, the extended period, the Court may appoint another expert in his place. The Court may hold the expert liable for all or part of the costs of appointing and reimbursing another expert.
9. The Registry shall maintain an indicative list of technical experts.

**Rule 186 – Duties of a court expert**

1. The court expert shall present an expert report in writing within the time period specified by the Court [Rule 185.4(f)].
2. The court expert shall be under the supervision of the Court and shall inform the Court of his progress in carrying out his task.
3. The court expert shall give expert advice only on questions which have been put to him.
4. The court expert shall not communicate with one party without the other party being present or without the consent of the other party. He shall document all communications with the parties in his report.
5. The court expert shall not communicate the contents of his report to third parties.
6. The court expert shall attend the oral hearing if requested to do so by the Court and shall answer questions from the Court and the parties.
7. The court expert has an overriding duty to assist the Court impartially on matters relevant to his area of expertise. He is to be independent and objective, and shall not act as an advocate for any party to the proceedings.

**Rule 187 – Expert report**

Once the report of the court expert has been presented to the Court, the Court shall invite the parties to comment on it either in writing or during the oral hearing.

**Rule 188 – Hearing of a court expert**

Rules 178 to 180 shall apply *mutatis mutandis* to a court expert.

*Relation with Agreement: Article 57*

## **CHAPTER 3 – ORDER TO PRODUCE EVIDENCE AND TO COMMUNICATE INFORMATION**

### **ORDER TO PRODUCE EVIDENCE**

#### **Rule 190 – Order to produce evidence**

1. Where a party has presented reasonably available and plausible evidence in support of its claims and has, in substantiating those claims, specified evidence which lies in the control of the other party or a third party, the Court may on a reasoned request by the party specifying such evidence, order that other party or third party to produce such evidence. For the protection of confidential information the Court may order that the evidence be disclosed to certain named persons only and be subject to appropriate terms of non-disclosure.
2. During the written and interim procedures, a party may request such an order to produce evidence.
3. The judge-rapporteur may make such order in the written procedure or in the interim procedure having given the other/third party an opportunity to be heard.
4. An order to produce evidence shall in particular specify:
  - (a) under which conditions, in what form and within what time period the evidence shall be produced;
  - (b) any sanction which may be imposed if the evidence is not produced according to the order.
5. Where the Court orders a third party to produce evidence, the interests of that third party shall be duly taken into account.
6. An order to produce evidence shall be subject to the provisions of Rules 179.3, 287 and 288. The order shall indicate that an appeal may be brought in accordance with Article 73 of the Agreement and Rule 220.1.
7. If a party fails to comply with an order to produce evidence, the Court shall take such failure into account when deciding on the issue in question.

*Relation with Agreement: Article 59*

### **ORDER TO COMMUNICATE INFORMATION**

#### **Rule 191 – Application for order to communicate information**

The Court may in response to a reasoned request by a party order the other party or any third party to communicate such information in the control of that other party or third party as is specified in Article 67 of the Agreement or such other information as is reasonably necessary for the purpose of advancing that party's case. Rule 190.1 (second sentence), .5 and .6 shall apply *mutatis mutandis*.

*Relation with the Agreement: Article 67*

## **CHAPTER 4 – ORDER TO PRESERVE EVIDENCE (SAISIE) AND ORDER FOR INSPECTION**

### **ORDER TO PRESERVE EVIDENCE (*SAISIE*)**

#### **Rule 192 – Application for preserving evidence**

1. An Application for preserving evidence may be lodged by a party (within the meaning of Article 47 of the Agreement) (hereinafter "the applicant") at the division where the applicant has commenced infringement proceedings on the merits. If the application is lodged before proceedings on the merits have been started it shall be lodged at the division where the applicant intends to start proceedings on the merits.

2. The Application for preserving evidence shall contain:

- (a) particulars in accordance with Rule 13.1(a) to (i);
- (b) a clear indication of the measures requested [Rule 196.1], including the exact location(s) (where they are known or suspected with good reason) of the evidence to be preserved;
- (c) the reasons why the proposed measures are needed to preserve relevant evidence; and
- (d) the facts and evidence relied on in support of the Application.

Where main proceedings on the merits of the case have not yet been started before the Court, the Application shall in addition contain a concise description of the action which will be started before the Court, including an indication of the facts and evidence which may be relied on in support.

3. Where the applicant requests that measures to preserve evidence be ordered without hearing the other party (hereinafter "the defendant"), the Application for preserving evidence shall in addition set out the reasons for not hearing the defendant having regard in particular to Rule 197. The applicant shall be under a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant. The application shall not be entered on the register until notice has been given to the defendant pursuant to Rule 197.2.

4. Where the Application for preserving evidence is lodged after main proceedings on the merits of the case have been started before the Court, the Application shall be drawn up in the language of the proceedings. Where the Application is lodged before main proceedings on the merits of the case have been started before the Court, Rule 14 shall apply *mutatis mutandis*.

5. The applicant shall pay the fee for the Application for preserving evidence [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 60*

#### **Rule 193 – Examination as to formal requirements, recording in the register, assignment to panel, designation of judge-rapporteur, single judge**

1. Where main proceedings on the merits of the case have not yet been started before the Court, the Application for preserving evidence shall be dealt with in accordance with Rule 16 (formalities examination by Registry), Rule 17.1(a) to (c) and .2 (date of receipt, recording in

the register, action number, assignment to panel) and Rule 18 (designation only of judge-rapporteur by presiding judge).

2. Where main proceedings on the merits of the case have already been started before the Court, an Application for preserving evidence shall immediately be examined by the Registry in accordance with Rule 16 and forwarded to the panel to which the action has been assigned or to the judge to whom the action has been assigned [Rules 17.2 and 194.3 and .4].

3. The judge deciding on an Application for preserving evidence shall have all necessary powers of the Court.

#### **Rule 194 – Examination of the Application for preserving evidence**

1. The Court shall have the discretion to:

(a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an Objection to the Application for preserving evidence which shall contain:

(i) the reasons why the Application shall fail;

(ii) the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant;

(iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and an indication of the facts and evidence relied on in support;

(b) summon the parties to an oral hearing;

(c) summon the applicant to an oral hearing without the presence of the defendant;

(d) decide the Application without having heard the defendant.

2. In exercising its discretion, the Court shall take into account:

(a) the urgency of the action;

(b) whether the reasons for not hearing the defendant [Rule 192.3 and Rule 197] appear well-founded;

(c) the probability that evidence may be destroyed or otherwise cease to be available [Rule 197].

3. The presiding judge may decide that he or the judge-rapporteur or other single judge or the standing judge may decide on the Application.

4. In cases of extreme urgency the applicant may apply without formality for an order to preserve evidence to the standing judge designated in accordance with Rule 345.5. The standing judge shall decide the procedure to be followed on the Application, which may include a subsequent written Application.

5. If the Court decides to inform the defendant about the Application the Court will first give the applicant the possibility to withdraw the Application. In the event of such withdrawal the applicant may request that the Court shall order that the Application and its contents shall remain confidential.

6. If the patent the subject of the Application is also the subject of a Protective Letter pursuant to Rule 207 the applicant may withdraw the Application pursuant to paragraph 5.

### **Rule 195 – Oral hearing**

1. Where the Court decides to summon the parties to an oral hearing, the date for the oral hearing shall be set as soon as possible after the date of receipt of the Application for preserving evidence.

2. Rules 111 to 116 shall apply *mutatis mutandis*. Where the applicant is absent from the oral hearing without a reasonable excuse, the Court shall reject the Application for preserving evidence.

3. The decision of the Court on the Application for preserving evidence shall be given in writing as soon as possible after the closure of the oral hearing. If the Court deems appropriate, the decision may be given orally to the parties at the end of the oral hearing but shall as soon as practicable thereafter be given in writing.

*Relation with Agreement: Article 60*

### **Rule 196 – Order on the Application for preserving evidence**

1. The Court may order, in particular, the following:

- (a) preserving evidence by detailed description, with or without the taking of samples;
- (b) physical seizure of allegedly infringing goods;
- (c) physical seizure of the materials and implements used in the production and/or distribution of these goods and any related document;
- (d) the preservation and disclosure of digital media and data and the disclosure of any passwords necessary to access them.

For the protection of confidential information the Court may order that any of the above be disclosed only to certain named persons and subject to appropriate terms of non-disclosure.

2. An order to preserve evidence shall specify that, unless otherwise ordered by the Court, the outcome of the measures to preserve evidence may only be used in the proceedings on the merits of the case.

3. The order to preserve evidence shall be enforceable immediately, unless the Court decides otherwise. The Court may set conditions to the enforceability of the order, specifying in particular:

- (a) who may represent the applicant when the measures to preserve evidence are being carried out and under what conditions;
- (b) any security which shall be provided by the applicant.

If necessary, the Court may set penalties applicable to the applicant if these conditions are not observed.

4. The order to preserve evidence shall specify a person who shall carry out the measures referred to in paragraph 1 and present a written Report on the measures to preserve evidence, all

in accordance with the national law of the place where the measures are executed, to the Court within a time period to be specified.

5. The person referred to in paragraph 4 shall be a professional person or expert, who guarantees expertise, independence and impartiality. Where appropriate and allowed under applicable national law, the person may be a bailiff or assisted by a bailiff. In no circumstances may an employee or director of the applicant be present at the execution of the measures.

6. The Court may order the applicant to provide adequate security for the legal costs and other expenses and compensation for any injury incurred or likely to be incurred by the defendant which the applicant may be liable to bear. The Court shall do so where the order to preserve evidence was made without the defendant having been heard, unless there are special circumstances not to do so. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee.

7. The order to preserve evidence shall indicate that an appeal may be lodged in accordance with Article 73 of the Agreement and Rule 220.1.

*Relation with Agreement: Article 60(1)-(4)*

#### **Rule 197 – Order to preserve evidence without hearing the defendant**

1. The Court may order measures to preserve evidence [Rule 196.1] without the defendant having been heard, in particular where any delay is likely to cause irreparable harm to the applicant or where there is a demonstrable risk of evidence being destroyed or otherwise ceasing to be available.

2. Where measures to preserve evidence are ordered without the defendant having been heard, Rule 195 shall apply *mutatis mutandis* to the oral hearing without the presence of the defendant. In such cases, the defendant shall be given notice, immediately at the time of the execution of the measures.

3. Within 30 days after the execution of the measures, the defendant may request a review of the order to preserve evidence. The Request for review shall set out:

(a) the reasons why the order to preserve evidence shall be revoked or modified; and

(b) the facts and evidence relied on.

4. The Court shall order an oral hearing to review the order without delay. Rule 195 shall apply. The Court may modify, revoke or confirm the order. In case the order is modified or revoked the Court shall oblige the persons to whom confidential information has been disclosed to keep this information confidential [Rule 196.1].

*Relation with Agreement: Article 60(6)*

#### **Rule 198 – Revocation of an order to preserve evidence**

1. The Court shall ensure that an order to preserve evidence is revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days or 20 working days, whichever is the longer, from the date specified in the Court's order with due account to the date where the Report referred to in Rule 196.4 shall be presented, the applicant does not start proceedings on the merits of the case before the Court.

2. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court may order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures [Rule 354.2].

*Relation with Agreement: Article 60(8) and (9)*

## **ORDER FOR INSPECTION**

### **Rule 199 – Order for inspection**

1. The Court may, on a reasoned request by a party, order an inspection of products, devices, methods, premises or local situations *in situ*. For the protection of confidential information the Court may order that any of the above be disclosed only to certain named persons and subject to appropriate terms of non-disclosure in accordance with Article 58 of the Agreement.

2. Rules 192 to 197 and Rule 198.2 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 60*

## **CHAPTER 5 – OTHER EVIDENCE**

### **Rule 200 – Order to freeze assets**

1. Where a party has presented reasonably available and plausible evidence in support of its claim that a patent has been or is about to be infringed the Court may, whether before or after proceedings have been commenced, order a party not to remove from its jurisdiction any assets or particular assets located therein nor to deal in any assets, whether located within its jurisdiction or not.

2. Rules 192 to 197 and 198 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 61*

### **Rule 201 – Experiments ordered by the Court**

1. Without prejudice to the possibility for parties or parties' experts to carry out experiments, the Court may, on a reasoned request by a party, order an experiment to prove a statement of fact for the purpose of proceedings before the Court.

2. A party requesting to be allowed to prove a statement of fact by means of experiments shall lodge a request as soon as practicable in the written procedure or the interim procedure to carry out experiments which shall:

(a) identify the facts intended to be established by the experiments, describe the proposed experiments in detail and the reasons for carrying out the proposed experiments;

(b) propose an expert to carry out such experiments; and

(c) disclose any previous attempts to carry out similar experiments.

3. Other parties to the proceedings shall be invited to state whether they dispute the facts intended to be established by the experiments. They shall also be invited to comment on the request, including the identity of the expert proposed and the description of the experiments.

4. Unless otherwise ordered by the Court the party requesting experiments shall initially bear the costs of the experiment.

5. The order of the Court allowing the experiments shall specify the detailed experiments and:

(a) the name and address of the expert or experts who are to carry out the experiments as Court's expert(s) and draw up the report on the experiments;

(b) the time period for carrying out the experiments and, where appropriate, the exact time and place where they are to be carried out;

(c) if necessary, other conditions for carrying out the experiments; and

(d) the time period for presenting the report on the experiments and, where appropriate, directions relating to the contents of the report.

6. Where appropriate, the Court may order that the experiments be carried out in the presence of the parties and their experts.

7. Once the report on the experiments is presented to the Court, it shall invite the parties to comment on it either in writing or during the oral hearing. The expert(s) may be summoned to the oral hearing.

#### **Rule 202 – Letters rogatory**

1. The Court may, of its own motion (but only after hearing the parties) or on a reasoned request by a party, issue letters rogatory for the production of documents or the hearing of witnesses or experts by other competent courts or authorities outside the European Union. Rule 180 shall apply.

2. The Court shall draw up letters rogatory in the language of the competent court or authority or shall attach to such letters a translation into that language.

3. Subject to paragraph 4, the competent court or authority shall apply national law as to the procedures to be followed in executing such requests and, in particular, as to the appropriate measures of compulsion.

4. The Court shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place. It may inform the parties, witnesses and experts concerned.

## **PART 3 – PROVISIONAL MEASURES**

### **Rule 205 – Stages of the proceedings (summary proceedings)**

Provisional measures are treated by way of summary proceedings which shall consist of the following stages:

- (a) a written procedure; and
- (b) an oral procedure, which may include an oral hearing of the parties or of one of the parties.

### **Rule 206 – Application for provisional measures**

1. An Application for provisional measures may be lodged by a party (hereinafter "the applicant") before or after main proceedings on the merits of the case have been started before the Court.

2. An Application for provisional measures shall contain:

- (a) particulars in accordance with Rule 13.1(a) to (i);
- (b) a indication of the provisional measures which are being requested [Rule 211.1];
- (c) the reasons why provisional measures are necessary to prevent a threatened infringement, to forbid the continuation of an alleged infringement or to make such continuation subject to the lodging of guarantees;
- (d) the facts and evidence relied on in support of the Application, including evidence to support the claim that provisional measures are necessary including the matters referred to in Rule 211.2 and .3; and
- (e) a concise description of the action which will be started before the Court, including an indication of the facts and evidence which will be relied on in support of the main proceedings on the merits of the case.

3. Where the applicant requests that provisional measures be ordered without hearing the other party (hereinafter "the defendant"), the Application for provisional measures shall in addition contain:

- (a) the reasons for not hearing the defendant having regard in particular to Rule 197; and
- (b) information about any prior correspondence between the parties concerning the alleged infringement.

4. The applicant shall be under a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant including any pending proceedings and/or any unsuccessful attempt in the past to obtain provisional measures in respect of the patent (or patents).

5. Rule 14 shall apply *mutatis mutandis*. The applicant shall pay the fee for the Application for provisional measures [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

*Relation with Agreement: Articles 32(1)(c) and 62*

## **Rule 207 – Protective letter**

1. If a person entitled to start proceedings under Article 47 of the Agreement considers it likely that an Application for provisional measures against him as a defendant may be lodged before the Court in the near future, he may file a Protective letter.

2. The Protective letter shall be filed with the Registry in the language(s) of the patent(s) and shall contain:

(a) the name of the defendant or defendants filing the Protective letter and of the defendant's representative;

(b) the name of the presumed applicant or applicants for provisional measures;

(c) postal and electronic addresses for service on the defendant filing the Protective letter and the names of the persons authorised to accept service;

(d) postal and, where available, electronic addresses for service on the presumed applicant or applicants for provisional measures and the names of the persons authorised to accept service if known;

(e) where available, the number of the patent (or patents) concerned and, where applicable, information about any prior or pending proceedings referred to in Rule 13.1(h); and

(f) the statement that the letter is a Protective letter.

3. The Protective letter may contain:

(a) an indication of the facts relied on, which may include a challenge to the facts expected to be relied on by the presumed applicant or applicants and/or, where applicable, any assertion that the patent (or patents) is (are) invalid and the grounds for such assertion;

(b) any available written evidence relied on;

(c) the arguments of law, including the reasons why any Application for provisional measures should be rejected.

4. The defendant or defendants filing the Protective letter shall pay the fee for filing a Protective letter [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

5. The Registry shall as soon as practicable examine whether the requirements of paragraphs 2(a) to (f) and 3 have been complied with. If these requirements have been complied with, the Registry shall as soon as practicable:

(a) record the date of receipt and assign a number to the Protective letter;

(b) subject to paragraph 7, record the Protective letter in the register;

(c) provide details of the Protective letter to all local and regional divisions; and

(d) where an Application for provisional measures has already been lodged, inform the panel or the single judge dealing with the Application about the filing of the Protective letter.

6. If the defendant has not complied with the requirements of paragraph 2 the Registry shall as soon as practicable invite the defendant to:

(a) correct the deficiencies within 14 days of service of such notification; and

(b) where applicable, pay the fee referred to in paragraph 3.

7. The protective letter shall not be publicly available on the register until it has been forwarded to the applicant pursuant to paragraph 8.

8. Where an Application for provisional measures is subsequently lodged the Registrar shall forward a copy of the protective letter to the panel or judge appointed under Rule 208 together with the Application for provisional measures and shall forward a copy to the applicant or applicants as soon as practicable.

9. If no Application for provisional measures has been lodged within six months from the date of receipt of the Protective letter, the Protective letter shall be removed from the register unless the person who has lodged the Protective letter has prior to the expiry of such period applied for an extension of six months and paid a fee for the extension [EUR\*\*\*] in accordance with Part 6. Further extensions may be obtained on further payments of the fee.

10. Rule 15.2 shall apply *mutatis mutandis*.

**Rule 208 – Examination as to formal requirements, recording in the register, assignment to panel, designation of judge-rapporteur, single judge**

1. The Application for provisional measures shall be examined by the Registry in accordance with Rule 16. The Registry shall in addition examine whether any Protective letter relevant for the Application is recorded in the register.

2. Where main proceedings on the merits of the case have not yet been started before the Court, Rule 17 (date of receipt, recording in the register, action number, assignment to panel) and Rule 18 (designation of judge-rapporteur by presiding judge) shall apply *mutatis mutandis*. In urgent cases, the presiding judge may decide that he or an experienced judge of the panel, acting as single judge, may decide on the Application in accordance with Rules 209 to 213 with a reduced time-table.

3. Where main proceedings on the merits of the case have already been started before the Court, the Application for provisional measures shall immediately be forwarded to the panel to which the action has been assigned or to the single judge. In urgent cases (where the action has not been assigned to a single judge), the presiding judge may decide that he or the judge-rapporteur, acting as single judge, may decide on the Application in accordance with Rules 209 to 213 with a reduced time-table.

4. The single judge deciding on the Application for provisional measures shall have all necessary powers of the Court.

*Relation with Statute: Article 19*

**Rule 209 – Examination of the Application for provisional measures**

1. Without prejudice to the Court's decision on the Application for provisional measures, the Court shall have the discretion to:

(a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an Objection to the Application for provisional measures which shall contain:

- (i) the reasons why the Application shall fail;
  - (ii) the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant; and
  - (iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and the facts and evidence relied on in support;
- (b) summon the parties to an oral hearing;
  - (c) summon the applicant to an oral hearing without the presence of the defendant.
2. In exercising its discretion pursuant to Rule 209.1, the Court shall in particular take into account:
- (a) whether the patent has been upheld in an opposition procedure before the European Patent Office or has been the subject of proceedings in any other court;
  - (b) the urgency of the action;
  - (c) whether the applicant has requested provisional measures without hearing the defendant and whether the reasons for not hearing the defendant appear well-founded; and
  - (d) any Protective letter filed by the defendant; the Court shall in particular consider summoning parties to an oral hearing if a relevant Protective letter has been filed by the defendant.
3. In cases of extreme urgency the standing judge appointed in accordance with Rule 345.5 may decide immediately on the Application for provisional measures and the procedure to be followed on the Application.
4. If the applicant has applied for provisional measures without hearing the defendant and the Court decides not to grant provisional measures without hearing the defendant the applicant may withdraw the Application and may request that the Court order that the Application and the contents of the Application remain confidential.

### **Rule 210 – Oral hearing**

1. Where the Court decides to summon the parties to an oral hearing, the date for the oral hearing shall be set as soon as possible after the date of receipt of the Application for provisional measures.
2. The Court may order the parties to provide further information, documents and other evidence before or during the oral hearing, including evidence to enable the Court to make its decision in accordance with Rule 211. Part 2 of these Rules on Evidence shall be applicable only to the extent determined by the Court.
3. Rules 111 to 116 shall apply *mutatis mutandis*. Where the applicant is absent from the oral hearing without a reasonable excuse, the Court shall reject the Application for provisional measures.
4. The decision of the Court on the Application for provisional measures shall be given in writing as soon as possible after the closure of the oral hearing. If the Court deems appropriate,

its decision may be given orally to the parties at the end of the oral hearing, prior to providing its decision in writing.

#### **Rule 211 – Order on the Application for provisional measures**

1. The Court may in particular order the following provisional measures:

(a) injunctions against a defendant;

(b) the seizure or delivery up of the goods suspected of infringing a patent right so as to prevent their entry into or movement within the channels of commerce;

(c) if an applicant demonstrates circumstances likely to endanger the recovery of damages, a precautionary seizure of the movable and immovable property of the defendant, including the blocking of his bank accounts and other assets;

(d) an interim award of costs.

2. In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent.

3. In taking its decision the Court shall in the exercise of its discretion weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.

4. The Court shall have regard to any unreasonable delay in seeking provisional measures.

5. The Court may order the applicant to provide adequate security for appropriate compensation for any injury likely to be caused to the defendant which the applicant may be liable to bear in the event that the Court revokes the order for provisional measures. The Court shall do so where interim measures are ordered without the defendant having been heard unless there are special circumstances not to do so. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee. The order shall be effective only after the security has been given to the defendant in accordance with the Court's decision.

6. The order on provisional measures shall indicate that an appeal may be brought in accordance with Article 73 of the Agreement and Rule 220.1.

*Relation with Agreement: Article 62(2) and (4)*

#### **Rule 212 – Order on provisional measures without hearing the defendant**

1. The Court may order provisional measures without the defendant having been heard, in particular where any delay is likely to cause irreparable harm to the applicant or where there is a demonstrable risk of evidence being destroyed. Rule 197 shall apply *mutatis mutandis*.

2. Where provisional measures are ordered without the defendant having been heard, Rule 210 shall apply *mutatis mutandis* to the oral hearing without the presence of the defendant. In such cases, the defendant shall be given notice of the provisional measures without delay and at the latest immediately at the time of execution of the measures.

3. The defendant may request a review. Rule 197.3 and .4 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 60(5) and (6)*

**Rule 213 – Revocation of provisional measures**

1. The Court shall ensure that provisional measures are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days or 20 working days, whichever is the longer, from the date specified in the Court's order, the applicant does not start proceedings on the merits of the case before the Court. When specifying the date, the Court shall take due account, where applicable, of the date on which the Report referred to in Rule 196.4 shall be presented.

2. Where provisional measures are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court may order the applicant, upon request of the defendant, to provide the defendant with appropriate compensation for any injury caused by those measures [Rule 354.2].

*Relation with Agreement: Article 60(9).*

## **PART 4 – PROCEDURES BEFORE THE COURT OF APPEAL**

### **Rule 220 – Appealable decisions**

1. An appeal by a party adversely affected may be brought against:
  - (a) final decisions of the Court of First Instance;
  - (b) decisions terminating proceedings as regards one of the parties;
  - (c) orders referred to in Articles 49(5), 59, 60, 61, 62 or 67 of the Agreement.
2. Orders other than those referred in Rule 220.1 and Rule 97.5, may be either the subject of an appeal together with the appeal against the decision or may be appealed with the leave of the Court of First Instance within 15 days of service of the Court's decision to that effect.
3. In the event of a refusal of the Court of First Instance to grant leave within 15 days of the order of one of its panels a request for a discretionary review to the Court of Appeal may be made within 15 calendar days from the end of that period. Rule 333.3 shall apply *mutatis mutandis*. The request shall set out the matters referred to in Rule 221.2.
4. The Registrar shall assign the request for a discretionary review to the standing judge (Rule 345.5 and .8). The standing judge may deny the request without giving reasons. If the standing judge allows the request after having heard the other party, he shall order what further steps, if any, the parties shall take and within what time limits and the President of the Court of Appeal shall assign the review to a panel of the Court of Appeal for a decision. The Court of Appeal may consult the presiding judge or the judge rapporteur of the panel of the Court of First Instance which has refused the leave order.
5. The Court of Appeal may hear appeals against separate decisions on the merits in infringement proceedings and in validity proceedings together.

*Relation with Agreement: Article 73*

### **Rule 221 – Application for leave to appeal against cost decisions**

1. A party adversely affected by a decision referred to in Rule 157 may lodge an Application for leave to appeal to the Court of Appeal within 15 days of service of the decision of the Court refusing leave to appeal.
2. The Application for leave to appeal shall set out:
  - (a) the reasons why the appeal should be heard;
  - (b) where necessary, the facts, evidence and arguments relied on.
3. The Application for leave to appeal shall be assigned to the standing judge (Rule 345.5 and .8) who shall decide on granting leave to appeal.
4. If leave to appeal a cost decision is granted the standing judge shall decide the appeal.

### **Rule 222 – Subject-matter of the proceedings before the Court of Appeal**

1. Requests, facts, evidence and arguments submitted by the parties under Rules 221, 225, 226, 236 and 238 shall, subject to paragraph 2, constitute the subject-matter of the proceedings

before the Court of Appeal. The Court of Appeal shall consult the file of the proceedings before the Court of First Instance.

2. Requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance may be disregarded by the Court of Appeal. When exercising discretion, the Court shall in particular take into account:

(a) whether a party seeking to lodge new submissions is able to justify that the new submissions could not reasonably have been made during proceedings before the Court of First Instance;

(b) the relevance of the new submissions for the decision on the appeal;

(c) the position of the other party regarding the lodging of the new submissions.

*Relation with Agreement: Article 73(4)*

### **Rule 223 – Application for suspensive effect**

1. A party may lodge an Application for suspensive effect, in accordance with Article 74 of the Agreement.

2. The Application for suspensive effect shall set out:

(a) the reasons why the lodging of the appeal shall have suspensive effect;

(b) the facts, evidence and arguments relied on.

3. The Court of Appeal shall decide the Application without delay.

4. In cases of extreme urgency the applicant may apply at any time without formality for an order for suspensive effect to the standing judge [Rule 345.5 and .8]. The standing judge shall have all the powers of the Court of Appeal and shall decide the procedure to be followed on the application, which may include a subsequent written Application.

5. There shall be no suspensive effect for an appeal of an order pursuant to Rule 220.2.

*Relation with Agreement: Article 74*

## **CHAPTER 1 – WRITTEN PROCEDURE**

### **SECTION 1 – STATEMENT OF APPEAL, STATEMENT OF GROUNDS OF APPEAL**

#### **Rule 224 – Time periods for lodging the Statement of appeal and the Statement of grounds of appeal**

1. A Statement of appeal shall be lodged by the appellant:
  - (a) within two months of service of a decision referred to in Rule 220.1(a) and (b); or
  - (b) within 15 days of service of an order referred to in Rule 220.1(c) or a decision referred to in Rule 220.2 or in Rule 221.3.
2. The Statement of grounds of appeal shall be lodged by the appellant:
  - (a) within four months of service of a decision referred to in Rule 220.1(a) and (b); or
  - (b) within 15 days of service of a decision referred to in Rule 157 or an order referred to in Rule 220.1(c) or a decision referred to in Rule 220.2 or in Rule 221.3.

*Relation with Agreement: Article 73(1) and (2)*

#### **Rule 225 – Contents of the Statement of appeal**

The Statement of appeal shall contain:

- (a) the names of the appellant and of the appellant's representative;
- (b) the names of the respondent and of the respondent's representative;
- (c) postal and electronic addresses for service on the appellant and on the respondent, as well as the names of the persons authorised to accept service;
- (d) the date of the decision or order appealed against and the action number attributed to the file in proceedings before the Court of First Instance; and
- (e) the order or remedy sought by the appellant, including any order for expedition of the appeal pursuant to Rule 9.3(b) and the reasons justifying such order for expedition.

#### **Rule 226 – Contents of the Statement of grounds of appeal**

The Statement of grounds of appeal shall contain:

- (a) an indication of which parts of the decision or order are contested;
- (b) the reasons for setting aside the contested decision or order; and
- (c) an indication of the facts and evidence on which the appeal is based in accordance with Rule 222.1 and .2.

*[Rule 99 EPC]*

#### **Rule 227 – Language of the Statement of appeal and of the Statement of grounds of appeal**

1. The Statement of appeal and the Statement of grounds of appeal shall be drawn up:

(a) without prejudice to Article 50(3) of the Agreement, in the language of the proceedings before the Court of First Instance; or

(b) where the parties have agreed in accordance with Article 50(2) of the Agreement, in the language in which the patent was granted. Where the parties have agreed in accordance with Article 50(2) of the Agreement, evidence of the respondent's agreement shall be lodged by the appellant together with the Statement of appeal.

*Relationship with Agreement: Article 50*

### **Rule 228 – Fee for the appeal**

The appellant shall pay the fee for the appeal [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

### **Rule 229 – Examination as to formal requirements of the Statement of appeal**

1. The Registry shall, as soon as practicable after the lodging of the Statement of appeal, examine whether the requirements of Rules 224.1, 225, 227 and 228 have been complied with.

2. If the appellant has not complied with the requirements referred to in Rules 225, 227 or 228, the Registry shall invite the appellant to:

(a) correct the deficiencies within 14 days of service of such notification; and

(b) where applicable, pay the fee for the appeal within said 14 days.

3. The Registry shall at the same time inform the appellant that if the appellant fails to correct the deficiencies or to pay the fee within the time stated, a decision by default may be given in accordance with Rule 357.

4. If the appellant has not met the requirements of Rules 225, 227 and 228 and fails to correct the deficiencies or pay the fee the Registry shall inform the President of the Court of Appeal who shall reject the appeal as inadmissible by a decision by default. He may give the appellant an opportunity to be heard beforehand.

### **Rule 230 – Recording in the register (Court of Appeal)**

1. If the Statement of appeal complies with the requirements referred to in Rule 229.1, the Registry shall:

(a) record the date of receipt to the Statement of appeal and an action number to the appeal file;

(b) record the appeal file in the register;

(c) inform the appellant of the action number and the date of receipt; and

(d) serve the Statement of appeal on all parties to the proceedings at first instance.

2. The action shall be assigned to a panel according to Rule 345.3 and .8.

3. The panel shall as soon as practicable decide whether to grant any order for expedition pursuant to Rule 225(e) having given the parties an opportunity to be heard.

### **Rule 231 – Designation of the judge-rapporteur**

The presiding judge of the panel to which the action has been assigned shall designate one legal judge of the panel as judge-rapporteur. The presiding judge may designate himself as the judge-rapporteur. The Registry shall as soon as practicable notify the appellant and respondent of the identity of the judge-rapporteur.

### **Rule 232 – Translation of file**

1. If the language of the proceedings before the Court of Appeal is not the language of the proceedings before the Court of First Instance, the judge-rapporteur may order the appellant to lodge, within a time period to be specified, translations into the language of the proceedings before the Court of Appeal of:

- (a) written pleadings and other documents lodged by the parties before the Court of First Instance, as specified by the judge-rapporteur;
- (b) decisions or orders of the Court of First Instance.

The judge-rapporteur shall at the same time inform the appellant that if the appellant fails to lodge the translations within the time period specified, a decision by default may be given in accordance with Rule 357.

2. If the appellant fails to lodge the translations under paragraph 1 within the time period specified, the judge-rapporteur shall reject the appeal by a decision by default in accordance with Rule 357. He may give the appellant an opportunity to be heard beforehand.

3. The appellant may request that documented costs of translations be taken into account when the Court fixes the amount of costs in accordance with Part 1, Chapter 5.

*Relation with Agreement: Article 50(2) and (3)*

### **Rule 233 – Preliminary examination of the Statement of grounds of appeal**

1. The judge-rapporteur shall examine whether the Statement of grounds of appeal satisfies the requirements of Rule 226.

2. If the Statement of grounds of appeal does not comply with the requirements of Rule 226, the judge-rapporteur shall give the appellant leave to amend the Statement of grounds of appeal within such period as he may decide. If the appellant fails to amend the Statement within such period the judge-rapporteur may reject the appeal as inadmissible. He shall give the appellant an opportunity to be heard beforehand.

3. Grounds of appeal which are not raised within the period specified for the Statement of grounds of appeal in Rule 224.2 shall not be admissible.

### **Rule 234 – Challenge to the decision to reject an appeal as inadmissible**

1. The appellant may challenge a decision to reject the appeal as inadmissible under Rules 224.1, 229.2 or 233.2 within one month of service of the decision, without providing new grounds of appeal.

2. The panel to which the action has been assigned under Rule 230.2 shall decide any challenge under paragraph 1.

3. If a decision to reject an appeal as inadmissible is set aside, the appeal shall take its normal course.

## **SECTION 2 – STATEMENT OF RESPONSE**

### **Rule 235 – Statement of response**

1. Within three months of service of the Statement of grounds of appeal pursuant to Rule 224.2(a), any other party to proceedings before the Court of First Instance (hereinafter "respondent") may lodge a Statement of response, which shall be served on the appellant.

2. Within 15 days of service of grounds of appeal pursuant to Rule 224.2(b), any other party to proceedings before the Court of First Instance (hereinafter "respondent") may lodge a Statement of response, which shall be served on the appellant.

3. If the respondent fails to lodge a Statement of response, the Court of Appeal may give a reasoned decision.

### **Rule 236 – Contents of the Statement of response**

1. The Statement of response shall contain:

(a) the names of the respondent and the respondent's representative;

(b) postal and electronic addresses for service on the respondent and the names and addresses of the persons authorised to accept service;

(c) the action number of the appeal file; and

(d) a response to the grounds of appeal.

2. The respondent may support the decision of the Court of First Instance on grounds other than those given in the decision.

### **Rule 237 – Statement of cross-appeal**

1. A party who has not lodged a Statement of appeal within the period referred to in Rule 224.1 may still bring an appeal by way of cross-appeal within the period referred to in Rule 235 if one of the other parties has lodged a Statement of appeal.

2. A Statement of cross-appeal shall be included in the Statement of response. It shall comply with the requirements of Rules 225 and 226. Rules 229, 233 and 234 shall apply *mutatis mutandis* to the Statement of cross-appeal.

3. A Statement of cross-appeal shall not be admissible in any other way or at any other time.

4. A cross-appeal shall be treated as an appeal as far as the fee for the appeal is concerned. Rule 228 shall apply *mutatis mutandis*.

5. If the Statement of appeal is withdrawn, any Statement of cross-appeal shall be deemed to be withdrawn.

## **SECTION 3 – REPLY TO A STATEMENT OF CROSS-APPEAL**

### **Rule 238 – Reply to a statement of cross-appeal**

1. The appellant may, within two months of service of any Statement of cross-appeal under Rules 237, 235.1, lodge a Reply to the Statement of cross-appeal which shall contain a response to the grounds of appeal raised in the Statement of cross-appeal.
2. The appellant may, within 15 days of service of the Statement of cross-appeal under Rules 237 and 235.2, lodge a Reply to the Statement of cross-appeal which shall contain a response to the grounds of appeal raised in the Statement of cross-appeal.

|                                                                        |
|------------------------------------------------------------------------|
| <b>Rule 28 on Further schedule</b> shall apply <i>mutatis mutandis</i> |
|------------------------------------------------------------------------|

## **SECTION 4 – REFERRAL TO THE FULL COURT**

### **Rule 238A – Decision to refer**

1. The panel to which the action has been assigned may refer it to the full Court of Appeal if the panel considers, on a proposal from the presiding judge, the case to be of exceptional importance and, in particular, where the decision in the action may affect the consistency and unity of the case law of the Court.
2. The presiding judge of the panel shall request that the President of the Court of Appeal and the two judges of the Court of Appeal who are members of the Presidium to appoint the judges of the Court of Appeal to the full Court. The appointees shall be the President of the Court of Appeal and not less than ten (legal and technical) judges of the Court of Appeal to represent the initial two panels of the Court of Appeal. In the event that the Court of Appeal shall have more than two panels the appointees to the full Court shall increase by five judges, (legal and technical), for each additional panel.
3. Decisions of the full Court shall be by no less than a three-quarters majority of the judges of the full Court.

## **CHAPTER 2 – INTERIM PROCEDURE**

### **Rule 239 – Role of the judge-rapporteur**

1. Upon the expiry of the periods specified in Rules 224 to 238 the judge-rapporteur shall make all necessary preparations for the oral hearing. Subject always to the provisions of Rule 222, the judge-rapporteur shall, to the extent appropriate, have the powers and exercise the duties set out in Rules 101 to 110 *mutatis mutandis*.

2. As soon as the judge-rapporteur considers that the appeal is ready for oral hearing he shall summon the parties to the oral hearing. Except for appeals against the orders referred to in Rule 220.1(c) and 220.2, and subject to any order for expedition pursuant to Rule 230.3, at least two months' notice shall be given unless the parties agree to a shorter time period. The interim procedure shall be deemed closed and oral procedure shall start immediately on the giving of such summons. The presiding judge shall, in consultation with the judge-rapporteur take over the management of the action.

## **CHAPTER 3 – ORAL PROCEDURE**

### **Rule 240 – Conduct of the oral hearing**

Subject to Rule 241 the oral hearing shall be held before the panel and shall be directed by the presiding judge. Subject always to Rule 222, Rules 111, 112, 115, 116 and 117 shall apply *mutatis mutandis*.

### **Rule 241 – Conduct of the oral hearing for an appeal of a cost decision**

The oral hearing for an appeal of a cost decision pursuant to Rule 157 shall be heard by the standing judge [Rule 345.5 and .8] who shall have all the powers of the Court of Appeal.

## **CHAPTER 4 – DECISIONS AND EFFECT OF DECISIONS**

### **Rule 242 – Decision of the Court of Appeal**

1. The Court of Appeal shall either reject the appeal or set the decision or order aside totally or in part substituting its own decision or order, including an order for costs both in respect of the proceedings at first instance and on appeal.

2. The Court of Appeal may:

(a) exercise any power within the competence of the Court of First Instance;

(b) in exceptional circumstances refer the action back to the Court of First Instance for decision or for retrial [Rule 243]. It shall not normally be an exceptional circumstance justifying a referral back that the Court of First Instance failed to decide an issue which it is necessary for the Court of Appeal to decide on appeal.

*Relation with Agreement: Article 75*

### **Rule 243 – Referral back**

1. The decision referring an action back to the Court of First Instance shall specify whether the same panel whose earlier decision or order is revoked shall deal further with the action or whether another panel shall be appointed by the presiding judge of the division concerned.

2. Where an action is referred back to the Court of First Instance, the Court shall be bound by the decision of the Court of Appeal and its *ratio decidendi*.

*Relation with Agreement: Article 75*

## **CHAPTER 5 – PROCEDURE FOR APPLICATION FOR REHEARING**

### **Rule 245 – Lodging of an Application for rehearing**

1. An Application for rehearing may be lodged by any party adversely affected by a final decision (hereinafter "the final decision") of the Court of First Instance for which the time for lodging an appeal has expired or of the Court of Appeal (hereinafter "the petitioner").
2. The Application for rehearing shall be lodged at the Court of Appeal within the following periods:
  - (a) where the Application for rehearing is based on the ground of a fundamental procedural defect, within two months of the discovery of the fundamental defect or of service of the final decision, whichever is the later;
  - (b) where the Application for rehearing is based on an act which has been held, by a final court decision, to constitute a criminal offence, within two months of the date on which the criminal offence has been so held or service of the final decision, whichever is the later;
  - (c) but in any event no later than ten years of service of the final decision.

*Relation with Agreement: Article 81*

### **Rule 246 – Contents of the Application for rehearing**

1. The Application for rehearing shall contain:
  - (a) the names of the petitioner and of the petitioner's representative;
  - (b) postal and electronic addresses for service on the petitioner and the names and addresses of the persons authorised to accept service; and
  - (c) an indication of the decision to be reviewed.
2. The Application for rehearing shall indicate the reasons for setting aside the final decision, as well as the facts and evidence on which the Application is based.

### **Rule 247 – Fundamental procedural defects**

A fundamental procedural defect under Article 81(1) of the Agreement may have occurred, for example, where:

- (a) a judge of the Court took part in the decision in breach of Article 17 of the Agreement or Article 7 of the Statute;
- (b) a person not appointed as a judge of the Court sat on the panel which took the final decision;
- (c) a fundamental violation of Article 76 of the Agreement occurred in the proceedings which have led to the final decision;
- (d) the decision was made without deciding on a request relevant to that decision; or
- (e) a breach of Article 6 of the Convention for the Protection of Human Rights and Fundamental Freedoms has occurred.

## **Rule 248 – Obligation to raise objections**

1. An Application for rehearing based on the ground of a fundamental procedural defect is only admissible where an objection in respect of the procedural defect was raised during the proceedings before the Court of First Instance or the Court of Appeal and dismissed by the Court, except where such objection could not have been raised during the proceedings before the Court of First Instance or the Court of Appeal.

2. An application for rehearing based upon the ground of a fundamental procedural defect is not admissible where the party could have brought an appeal in respect of the defect but failed to do so.

## **Rule 249 – Definition of criminal offence**

A criminal offence shall only be considered to have occurred if it is finally held to be such an offence by a competent court or authority. A conviction is not necessary.

## **Rule 250 – Fee for the rehearing**

The petitioner shall pay the fee for the rehearing [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*. The Court may waive payment of the fee in the circumstances contemplated by Rule 245.2(a) or (b).

**Rule 230.1 on Recording in the register (Court of Appeal)** shall apply *mutatis mutandis*

## **Rule 251 – Suspensive effect**

The lodging of an Application for rehearing shall not have suspensive effect unless the Court of Appeal decides otherwise.

*Relation with Agreement: Article 81(2)*

## **Rule 252 – Examination as to formal requirements of the Application for rehearing**

1. The Registry shall, as soon as practicable after the lodging of the Application for rehearing, examine whether the requirements of Rules 245, 246 and 250 have been complied with.

2. If the petitioner has not complied with the requirements referred to in paragraph 1, the Registry shall invite the petitioner to:

(a) correct the deficiencies within 14 days; and

(b) where applicable, pay the fee for the rehearing within 14 days.

If the petitioner fails to correct the deficiencies or pay the fee the case shall be assigned to the standing judge by the Registrar (Rule 345.5 and .8) who may reject the Application for rehearing as inadmissible. He shall give the petitioner an opportunity to be heard beforehand.

## **Rule 253 – Assignment of Application for rehearing to a panel**

1. Immediately after the Application for rehearing has been recorded in the register, the Registry shall serve a copy of the Application for rehearing on all other parties and shall inform the President of the Court of Appeal that a Request for rehearing has been lodged.

2. The action shall be assigned to a panel consisting of three legally qualified judges. The President of the Court of Appeal may order that judges of the Court who participated in taking the decision to be reviewed shall not sit on the panel.

**Rule 254 – Examination of the Application for rehearing**

After hearing the parties the panel may make:

(a) a decision to reject the Application for rehearing as not allowable; such a decision shall be by a majority vote of the judges on the panel.

(b) a decision to allow the Application for rehearing; such a decision shall set aside or suspend the decision under review, in whole or in part, and re-open the proceedings for a new hearing and decisions. Where proceedings are re-opened, the panel shall give directions for the future proceedings.

*Relation with Agreement: Article 81(3)*

## **PART 5 – GENERAL PROVISIONS**

### **CHAPTER 1 – GENERAL PROCEDURAL PROVISIONS**

#### **Rule 260 – Examination by the Registry of its own motion**

1. In any proceedings before the Court, the Registry shall, as soon as practicable in the proceedings, of its own motion, examine whether an opt-out has effect for the patent or patents concerned.

2. Where the Registry notes that two or more actions concerning the same patent or patents are initiated before several divisions (whether or not between the same parties), it shall as soon as practicable inform the divisions concerned.

*Relation with Agreement: Article 83(3) and (4)*

*Relation with Statute: Articles 23 and 24*

#### **Rule 261 – Date of pleadings**

All pleadings and documents lodged with pleadings shall bear a time and a date which shall be the time and date of receipt of pleadings at the Registry. The time shall be the local time of the Registry. The Registrar shall be responsible for time and date marking.

#### **Rule 262 – Public access to the register**

1. Without prejudice to Articles 58 and 60(1) of the Agreement and subject to Rule 190.1, 194.5, 196.1, 197.4, 199.1, 207.7, 209.4, 315.2 and 365.2, written pleadings, written evidence, decisions and orders lodged at or made by the Court and recorded by the Registry shall be available to the public, unless a party has requested that certain information be kept confidential and provided specific reasons for such confidentiality. The Registrar shall ensure that information subject of such a request shall not be made available pending an Application pursuant to Rule 262.2 or an appeal pursuant to Rule 220.2. Where a party requests that parts of written pleadings or written evidence shall be kept confidential, he shall also provide copies of the said documents with the relevant parts redacted when making the request.

2. A member of the public may lodge an Application with the Court for an order that any information excluded from public access pursuant to Rule 262.1 may be made available to the applicant.

3. The Application shall contain:

- (a) details of the information alleged to be confidential, so far as possible;
- (b) the grounds upon which the applicant believes the reasons for confidentiality should not be accepted; and
- (c) the purpose for which the information is needed.

4. The Court shall invite written comments from the parties prior to making any order.

5. The Court shall allow the Application unless legitimate reasons given by the party concerned for the confidentiality of the information outweigh the interest of the applicant to access such information.

6. The Registrar shall as soon as practicable take all such steps with regard to access to the register as may be necessary to give effect to an order of the Court under this Rule.

*Relation with Agreement: Articles 10, 45, 58 and 60(1)*

*Relation with Statute: Article 24(2)*

### **Rule 263 – Leave to change claim or amend case**

1. A party may at any stage of the proceedings apply to the Court for leave to change its claim or to amend its case, including adding a counterclaim. Any such application shall explain why such change or amendment was not included in the original pleading.

2. Subject to Rule 263.3, leave shall not be granted if, all circumstances considered, the party seeking the amendment cannot satisfy the Court that:

(a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and

(b) the amendment will not unreasonably hinder the other party in the conduct of its action.

3. Leave to limit a claim in an action unconditionally shall always be granted.

4. The Court may re-consider fees already paid in the light of an amendment.

### **Rule 264 – An opportunity to be heard**

Where these Rules provide that a party or parties shall or may be given an opportunity to be heard before the Court makes an order or takes some action, the Court shall or may (as the case may be) request the parties to provide written submissions within a specified period and/or shall or may invite the parties to an oral hearing on a fixed date by the Court. The Court may also order that a hearing takes place by telephone or video conference. Rules 105 and 106 shall apply *mutatis mutandis*.

### **Rule 265 – Withdrawal**

1. As long as there is no final decision in an action, a claimant may apply to withdraw his action. The Court shall decide the application after hearing the other party (or parties). The application to withdraw shall not be permitted if the other party (or parties) has (have) a legitimate interest in the action being decided by the Court.

2. If withdrawal is permitted, the Court shall:

(a) give a decision declaring the proceedings closed;

(b) order the decision to be entered on the register; and

(c) issue a cost decision in accordance with Part 1, Chapter 5.

The withdrawal of an action by the claimant shall have no effect on any counterclaim in the action. The Court may however refer any counterclaim for revocation to the Central Division.

### **Rule 266 – Preliminary references to the Court of Justice of the European Union**

1. At any stage of the proceedings where a question is raised before the Court and the Court considers that a decision on the question by the Court of Justice of the European Union

(“CJEU”) is necessary before the Court can give judgment, the Court of First Instance may and the Court of Appeal shall request the CJEU to give a ruling thereon.

2. The Court shall in requesting a ruling follow the procedure set out in the Rules of the CJEU.

3. If the Court requests the CJEU to apply its expedited procedure the request shall in addition set out:

(a) the matters of fact and law which establish its urgency; and

(b) the reasons why an expedited ruling is appropriate.

4. The Registrar shall as soon as practicable forward the request and any request to apply the expedited procedure to the Registrar of the CJEU.

5. The Court may stay the proceedings. Where it does not stay proceedings, it shall not give judgement until the CJEU has given a ruling on the question.

#### **Rule 267 – Actions pursuant to Article 22 of the Agreement**

Where an action for damages has been brought against a Contracting Member State pursuant to Article 22 of the Agreement, the President of the Court of Appeal shall, as soon as practicable following a request from the competent authority in the Contracting Member State, provide the competent authority with copies of all pleadings, evidence, decisions and orders available to the Court in its proceedings that are relevant to the action for damages. The President of the Court of Appeal shall have an opportunity to comment.

## **CHAPTER 2 – SERVICE**

### **SECTION 1 – SERVICE WITHIN THE CONTRACTING MEMBER STATES**

#### **Rule 270 – Scope of this Section**

1. For service of the Statement of claim the rules set out in this Section and the Regulation (EC) No 1393/2007 on the service in the Member States of judicial and extrajudicial documents in civil and commercial matters (“the EU Service Regulation”) shall apply.
2. For the purpose of Rules 270 to 275 the term Statement of claim shall, where appropriate, mean all originating pleadings in actions referred to in Article 32(1) of the Agreement.

#### **Rule 271 – Service of the Statement of claim**

1. For service within the Contracting Member States, the Registry may serve the Statement of claim on the defendant at an electronic address which the defendant has provided for the purpose of service in the proceedings provided that the service is effected using appropriately high technical standards guaranteeing

- (a) the identity of the sender
- (b) the safe transmission and
- (c) the possibility for the addressee to take notice of the documents.

A list of secure identification and transmission standards is contained in Annex I of the Rules of Procedure.

2. The Registry may, under the conditions of paragraph 1(a) to (c) serve the Statement of claim where:

- (a) the defendant has provided the electronic address of a representative pursuant to Rule 8.1 as an address at which the defendant may be served with the Statement of claim; or
- (b) a representative pursuant to Rule 8.1 acting for the defendant has notified the Registry or the claimant that he accepts service of the Statement of claim on behalf of the defendant at an electronic address,

at the electronic address of that representative.

3. For the purpose of serving a Statement for revocation [Rule 45] or of serving a Statement for declaration of non-infringement [Rule 62], reference to representative under Rule 271.2(a) or (b) shall additionally include professional representatives and legal practitioners as defined in Article 134 EPC who are recorded as the appointed representative for the patent, the subject of the proceedings, in the register for unitary patent protection (Regulation (EU) No 1257/2012, Article 2(e)) or in the register of the patent office of a Contracting Member State.

4. Where service by means of electronic communication cannot be effected, the Registry shall serve the Statement of claim on the defendant by:

- (a) any other method foreseen in the EU Service Regulation, in particular by registered letter according to Article 14 of that regulation with advice of delivery;
- (b) fax provided that the requirements of paragraph 1(a) to (c) are observed; or

(c) where service in accordance with paragraphs 4(a) and 4(b) could not be effected any method permitted by the law of the Member State of the European Union where service is to be effected or authorised by the Court under Rule 275.

5. Service under Rule 271.4(a) shall be effected at the following place:

(a) where the defendant is a company or other legal person, at its statutory seat, central administration or principal place of business within the Contracting Member States or at any place within the Contracting Member States where the company or other legal person has a permanent or temporary place of business or

(b) where the defendant is an individual: at his usual or last known residence within the Contracting Member States.

(c) for the purpose of serving a Statement for revocation [Rule 45] or of serving a Statement for a declaration of non-infringement [Rule 62], at the place of business of a professional representative or legal practitioner as defined in Article 134 EPC who is recorded as the appointed representative for the patent, the subject of the proceedings, in the register for unitary patent protection (Regulation (EU) No 1257/2012, Article 2(e)) or of the patent office of a Contracting Member State.

6. Subject to Rule 272.2 and .3, a Statement of claim served in accordance with paragraphs 1 to 5 is deemed to be served on the defendant:

(a) where service takes place by means of electronic communication or by fax, on the day when the relevant electronic message was sent or the transmission of the fax was completed(GMT+1); or

(b) where service takes place by registered letter with advice of delivery such letter shall be deemed to be served on the addressee on the tenth day following posting unless it has failed to reach the addressee, has in fact reached him on a later date or the advice of delivery has not been returned. Such service shall, except where paragraph 7 applies, be deemed effective even if acceptance of the letter has been refused.

7. Where the defendant is entitled to refuse service according to Article 8 of the EU Service Regulation and where he has notified the refusal to the Register within one week of the attempted service together with an indication of the language(s) he understands, the Registry shall inform the claimant. The claimant shall provide to the Registry translations of at least the Statement of claim and the information required in Rule 13.1(a) to (p) in a language provided for by Article 8(1)(a) or (b) of the EU Service Regulation. For the determination of the date of service Articles 8(3) and 9 of the EU Service Regulation shall apply.

When serving the Statement of claim the defendant shall be informed of these rights.

#### **Rule 272 – Notice of service and non-service of the Statement of claim**

1. The Registry shall inform the claimant of the date on which the Statement of claim is deemed served under Rule 271.6.

2. Where the Registry has served the Statement of claim by registered letter with advice of delivery and the Statement of claim is returned to the Registry for any reason, the Registry shall inform the claimant.

3. Paragraph 2 shall apply *mutatis mutandis* where the Registry has served the Statement of claim by means of electronic communication or fax and the relevant electronic message or fax appears not to have been received.

## **SECTION 2 – SERVICE OUTSIDE THE CONTRACTING MEMBER STATES**

### **Rule 273 – Scope of this Section**

This Section applies to service of a Statement of claim outside the Contracting Member States.

### **Rule 274 – Service outside the Contracting Member States**

1. Where a Statement of claim is to be served outside the Contracting Member States, it may be so served by the Registry:

(a) by any method provided by:

(i) the EU Service Regulation where it applies respecting the rights of the recipient granted by the Regulation;

(ii) The Hague Convention on the service abroad of judicial and extra-judicial documents in civil or commercial matters 1965 (“the Hague Service Convention”) or any other applicable convention or agreement where it applies; or

(iii) to the extent that there is no such convention or agreement in force, either by service through diplomatic or consular channels from the Contracting Member State in which the sub-registry of the relevant division is established;

(b) where service in accordance with paragraph 1(a) could not be effected by any method permitted by the law of the state where service is to be effected or as authorised by the Court under Rule 275.

2. No Statement of claim may be served under the Rule 274 in a manner which is contrary to the law of the state where service is effected.

3. The Registry shall inform the claimant of the date on which the Statement of claim is deemed served under Rule 274.1.

4. The Registry shall inform the claimant if for any reason service pursuant to Rule 274.1 cannot be effected.

## **SECTION 3 – SERVICE BY AN ALTERNATIVE METHOD**

### **Rule 275 – Service of the Statement of claim by an alternative method or at an alternative place**

1. Where it appears to the Court on an application by the claimant that there is a good reason to authorise service by a method or at a place not otherwise permitted by this Chapter, the Court may by way of order permit service by an alternative method or at an alternative place.

2. On a reasoned request by the claimant, the Court may order that steps already taken to bring the Statement of claim to the attention of the defendant by an alternative method or at an alternative place is good service.

3. An order under this rule shall specify:

- (a) the method or place of service;
- (b) the date on which the Statement of claim is deemed served; and
- (c) the period for filing the Statement of defence.

4. No order for alternative service under this Rule shall be made permitting service in a manner that is contrary to the law of the state where service is to be effected.

## **SECTION 4 – SERVICE OF ORDERS, DECISIONS AND WRITTEN PLEADINGS**

### **Rule 276 – Service of orders and decisions**

1. Any order or decision of the Court shall be served on each of the parties in accordance with the provisions of Sections 1, 2 or 3 of this Chapter 2, as the case may be.
2. Decisions by default pursuant to Rule 355 resulting from failure of the defendant to lodge a Defence to revocation [Rule 50] or failure to lodge a Defence to the Statement for a declaration of non-infringement [Rule 65] within the time limit set by these Rules or by the Court, may be served on the defendant at the place of business of a professional representative or legal practitioner as defined in Article 134 EPC who is recorded as the appointed representative for the subject European patent with unitary effect, the subject of the proceedings in the register for unitary patent protection [Regulation (EU) No 1257/2012, Article 2(e)] or in the register of the patent office of a Contracting Member State.

### **Rule 277 – Decisions by default under Part 5, Chapter 11**

No decision by default shall be entered under Part 5, Chapter 11 unless the Court is satisfied that either:

- (a) the Statement of claim was served by a method prescribed by the internal law of the state addressed for the service of documents in domestic actions upon persons who are within its territory; or
- (b) the Statement of claim was actually served on the defendant under this Chapter 2.

### **Rule 278 – Service of written pleadings and other documents**

1. As soon as practicable after written pleadings have been received at the Registry, the Registry shall serve the pleadings and any other document lodged with the pleadings on the other party by means of electronic communication except if the pleading contains a request for an *ex parte* proceeding.
2. Where service by means of electronic communication cannot be effected, the Registry shall serve the written pleadings on the party by:
  - (a) registered letter with advice of delivery;
  - (b) fax; or
  - (c) any method authorised by the Court under Rule 275.
3. Service under paragraph 2(a) shall be effected at the following place:

(a) where the party is a company or other legal person: at its statutory seat, central administration, principal place of business or at any place within the Contracting Member States where the company or other legal person has a place of business;

(b) where the party is an individual: at his usual or last known residence within the Contracting Member States.

4. Rule 271.6 and 272 shall apply *mutatis mutandis*.

5. Where a party is represented pursuant to Rule 8, the pleadings and other documents referred to in paragraph 1 shall be served on that representative. Paragraph 2 shall apply *mutatis mutandis*.

#### **Rule 279 – Change of electronic address for service**

Where the electronic address for service of a party changes, that party must give notice in writing of the change as soon as it has taken place to the Registry and every other party [Rule 6.3].

## **CHAPTER 3 – RIGHTS AND OBLIGATIONS OF REPRESENTATIVES**

### **Rule 284 – Duty of representatives not to misrepresent facts or cases**

A representative of a party shall not misrepresent cases or facts before the Court either knowingly or with good reasons to know.

*Relation to Agreement: Article 48(6)*

### **Rule 285 – Powers of attorney**

A representative who claims to be representing a party shall be accepted as such provided however the Court may order a representative to produce a written authority if his representative powers are challenged.

### **Rule 286 – Certificate that a representative is authorised to practice before the Court**

1. A representative pursuant to Article 48(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practise before a court of a Member State of the European Union. A lawyer within the meaning of Article 48(1) of the Agreement is a person who is authorised to pursue professional activities under a title referred to in Article 1 of Directive 98/5/EC and by way of exception a person with equivalent legal professional qualifications who, owing to national rules, is permitted to practice in patent infringement and invalidity litigation but not under such title. In subsequent actions the representative may refer to the certificate previously lodged.

2. A representative pursuant to Article 48(2) of the Agreement shall lodge at the Registry the European Patent Litigation Certificate as defined by the Administrative Committee or otherwise justify that he has appropriate qualifications to represent a party before the Court. In subsequent actions such representative may refer to the certificate or other evidence of appropriate qualification previously lodged.

### **Rule 287 – Attorney-client privilege**

1. Where a client seeks advice from a lawyer or a patent attorney he has instructed in a professional capacity, whether in connection with proceedings before the Court or otherwise, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is privileged from disclosure, whilst it remains confidential, in any proceedings before the Court or in arbitration or mediation proceedings before the Centre.

2. This privilege applies also to communications between a client and a lawyer or patent attorney employed by the client and instructed to act in a professional capacity, whether in connection with proceedings before the Court or otherwise.

3. This privilege extends to the work product of the lawyer or patent attorney (including communications between lawyers and/or patent attorneys employed in the same firm or entity or between lawyers and/or patent attorneys employed by the same client) and to any record of a privileged communication.

4. This privilege prevents the lawyer or patent attorney and his client from being questioned or examined about the contents or nature of their communications.

5. This privilege may be expressly waived by the client.

6. For the purpose of Rules 287 and 288:

(a) the expression “lawyer” shall mean a person as defined in Rule 286.1 and any other person who is qualified to practise as a lawyer and to give legal advice under the law of the state where he practises and who is professionally instructed to give such advice.

(b) the expression “patent attorney” shall include a person who is recognised as eligible to give advice under the law of the state where he practises in relation to the protection of any invention or to the prosecution or litigation of any patent or patent application and is professionally consulted to give such advice.

7. The expression “patent attorney” shall also include a professional representative before the European Patent Office pursuant to Article 134 (1) European Patent Convention.

*Relation to Agreement: Article 48(4)*

### **Rule 288 – Litigation privilege**

Where a client, or a lawyer or patent attorney as specified in Rules 287.1, .2, .6 and .7 instructed by a client in a professional capacity, communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings, including proceedings before the European Patent Office, such communications shall be privileged from disclosure in the same way and to the same extent as provided for in Rule 287.

*Relation to Agreement: Article 48(5)*

### **Rule 289 – Privileges, immunities and facilities**

1. Representatives appearing before the Court or before any judicial authority to which it has addressed letters rogatory [Rule 202] shall enjoy immunity in respect of words spoken or written by them concerning the action or the parties.

2. Representatives shall enjoy the following further privileges and facilities:

(a) papers and documents relating to the proceedings shall be exempt from both search and seizure;

(b) any allegedly infringing product or device relating to the proceedings shall be exempt from both search and seizure when brought to the Court for the purposes of the proceedings.

In the event of a dispute, customs officials or police may seal those papers, documents or allegedly infringing products or devices. They shall then be immediately forwarded to the Court for inspection in the presence of the Registrar and of the person concerned.

3. Representatives shall be entitled to travel in the course of duty without hindrance.

4. The privileges, immunities and facilities specified in paragraphs 1 to 3 are granted exclusively in the interests of the proper conduct of proceedings.

5. The Court may waive the immunity where it considers that a representative is guilty of conduct which is contrary to the proper conduct of proceedings.

*Relation with Agreement: Article 48*

### **Rule 290 – Powers of the Court as regards representatives**

1. As regards representatives who appear before it, the Court shall have the powers normally accorded to courts of law, under the conditions laid down in Rule 291.
2. Representatives who appear before the Court shall strictly comply with any code of conduct adopted for such representatives by the Administrative Committee.

### **Rule 291 – Exclusion from the proceedings**

1. If the Court considers that the conduct of a party's representative towards the Court, towards any judge of the Court or towards any member of the staff of the Registry is incompatible with the dignity of the Court or with the requirements of the proper administration of justice, or that such representative uses his rights for purposes other than those for which they were granted, or that such representative is otherwise in breach of any code of conduct adopted pursuant to Rule 290.2 it shall so inform the person concerned. On the same grounds, the Court may at any time, after having given the person concerned an opportunity to be heard, exclude that person from the proceedings by way of order. That order shall have immediate effect.
2. Where a party's representative is excluded from the proceedings, the proceedings shall be stayed for a period fixed by the presiding judge in order to enable the party concerned to appoint another representative.

### **Rule 292 – Patent attorneys' right of audience**

1. For the purposes of Article 48(4) of the Agreement, the term "patent attorneys" assisting a representative referred to in Article 48(1) and/or Article 48(2) of the Agreement shall mean persons meeting the requirements of Rule 287.6(b) or Rule 287.7 and practising in a Contracting Member State.
2. Such patent attorneys shall be allowed to speak at hearings of the Court at the discretion of the Court and subject to the representative's responsibility to coordinate the presentation of a party's case.
3. Rules 287 to 291 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 48(4)*

### **Rule 293 – Change of a representative**

Any change of representative shall take effect from the receipt by the Registry of notification that a new representative shall in future be representing the party concerned. Until the moment where such statement is received, the former representative remains responsible for the conduct of the proceedings and for communications between the Court and the party concerned.

## **CHAPTER 4 – STAY OF PROCEEDINGS**

### **Rule 295 – Stay of proceedings**

The Court may stay proceedings:

- (a) where it is seized of an action relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings) before the European Patent Office or a national authority where a decision in such proceedings may be expected to be given rapidly;
- (b) where it is seized of an action relating to a supplementary protection certificate which is also the subject of proceedings before a national court or authority;
- (c) where an appeal is brought before the Court of Appeal against a decision or order of the Court of First Instance:
  - (i) disposing of the substantive issues in part only;
  - (ii) disposing of an admissibility issue or a Preliminary objection;
- (d) at the joint request of the parties;
- (e) pursuant to Rule 37;
- (f) pursuant to Rule 118;
- (g) pursuant to Rule 136;
- (h) pursuant to Rule 266;
- (i) pursuant to Rules 310 and 311;
- (j) to give effect to Union law, in particular the provisions of Regulation 1215/2012 and the Lugano Convention;
- (k) in any other case where the proper administration of justice so requires.

### **Rule 296 – Duration and effects of a stay of proceedings**

1. The stay of proceedings shall take effect on the date indicated in the order to stay or, in the absence of such an indication, on the date of that order. The Court shall stipulate what effect the stay shall have on any existing orders.
2. Where the order to stay does not fix the length of the stay, it shall end on the date indicated in the order to resume proceedings or, in the absence of such indication, on the date of the order to resume.
3. While proceedings are stayed, time shall cease to run for the purposes of procedural periods. Time shall begin to run afresh for the purposes of procedural periods from the date on which the stay of proceedings comes to an end.

**Rule 297 – Resumption of proceedings**

Any decision referred to in Rule 296.2 ordering the resumption of proceedings before the end of the stay shall be made by order of the judge-rapporteur after hearing the parties. The judge-rapporteur may refer the matter to the panel.

**Rule 298 – Accelerated proceedings before the European Patent Office**

The Court may of its own motion or at the request of a party request that opposition proceedings or limitation proceedings (including any subsequent appeal proceedings) before the European Patent Office be accelerated in accordance with the proceedings of the European Patent Office. The Court may stay its proceedings in accordance with Rule 295(a) pending the outcome of such request and any subsequent accelerated proceedings.

## **CHAPTER 5 – TIME PERIODS**

### **Rule 300 – Calculation of periods**

Any period of time prescribed by the Agreement, the Statute, these Rules or any order of the Court for the taking of any procedural step shall be laid down in terms of full days, weeks, months or years and shall be reckoned as follows:

- (a) computation shall start on the day following the day on which the relevant event occurred; in the case of service of a document, the relevant event shall be the receipt of that document in accordance with Part 5, Chapter 2;
- (b) when a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month;
- (c) when a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month;
- (d) when a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred;
- (e) day shall mean a calendar day unless expressed as a working day;
- (f) calendar days shall include official holidays of the Contracting Member State in which the division or the seat of the central division or its section concerned or the Court of Appeal is located, Saturdays and Sundays;
- (g) working days shall not include official holidays of the Contracting Member State in which the division or the seat of the central division or its section concerned or the Court of Appeal is located, Saturdays and Sundays.
- (h) periods shall not be suspended during the judicial vacations.

*[EPC Rule 131]*

### **Rule 301 – Automatic extension of periods**

1. If a period expires on a Saturday, Sunday or official holiday of the Contracting Member State in which the division or the seat of the central division or its section concerned or the Court of Appeal is located, it shall be extended until the end of the first following working day.
2. Paragraph 1 shall apply *mutatis mutandis* if documents filed in electronic form cannot be received by the Court.

## **CHAPTER 6 – PARTIES TO PROCEEDINGS**

### **SECTION 1 – PLURALITY OF PARTIES**

#### **Rule 302 – Plurality of claimants or patents**

1. The Court may order that proceedings commenced by a plurality of claimants or in respect of a plurality of patents be heard in separate proceedings.
2. Where the Court orders a separation of proceedings the Court shall decide on the payment of a new court fee (or court fees) in accordance with Part 6.
3. The Court may order that parallel infringement or revocation proceedings relating to the same patent (or patents) and before the same local or regional division or the central division or the Court of Appeal be heard together where it is in the interests of justice to do so.

#### **Rule 303 – Plurality of defendants**

1. Proceedings may be started against a plurality of defendants if the Court has competence in respect of all of them.
2. The Court may separate the proceedings into two or more separate proceedings against different defendants.
3. Where the Court orders a separation of proceedings under paragraph 2, the claimants in the new proceedings shall pay a new court fee in accordance with Part 6, unless the Court decides otherwise.

#### **Rule 304 – Court fees in the event of plurality of parties**

If and as long as a plurality of parties in an action are represented by one and the same representative and take the same position, they shall be regarded as one party as far as the payment of court fees is concerned.

### **SECTION 2 – CHANGE IN PARTIES**

#### **Rule 305 – Change in parties**

1. The Court may, on application by a party, order a person to:
  - (a) be added as a party;
  - (b) cease to be a party;
  - (c) be substituted for a party.
2. The Court shall invite other parties to the proceedings to comment on the application, as soon as practicable after service of the application.
3. When ordering that a person shall become a party or shall cease to be a party, the Court may make appropriate orders as to payment of court fees and costs as regards such party.

#### **Rule 306 – Consequences for the proceedings**

1. Where the Court orders that a party be added, removed or substituted under Rule 305.1, it shall give directions to regulate the consequences as to case management.

2. The Court shall also determine the extent to which a new party is bound by the proceedings as then constituted.

### **SECTION 3 – DEATH, DEMISE OR INSOLVENCY OF A PARTY**

#### **Rule 310 – Death or demise of a party**

1. If a party dies or ceases to exist during proceedings, the proceedings shall be stayed until such party is replaced by his successor or successors. The Court may specify a period in this respect.

2. If there are more than two parties to the proceedings, the Court may decide that:

(a) proceedings between the remaining parties be continued separately; and

(b) the stay shall only concern the proceedings regarding the party that no longer exists.

3. If the successor or successors of the party that died or ceased to exist does not or do not continue the proceedings of his or their own motion, within a period specified by the Court, any other party may apply to have the successor or successors added to or substituted for a party or parties.

4. The Court shall decide who shall be added or substituted as a party or parties pursuant to Rule 305 and 306 shall apply *mutatis mutandis*.

#### **Rule 311 – Insolvency of a party**

1. If a party is declared insolvent under the law applicable to the insolvency proceedings the Court shall stay the proceedings up to three months. They may be stayed until the competent national authority or person dealing with the insolvency has decided whether to continue the proceedings or not. Where the competent national authority or person dealing with the insolvency decides not to continue the proceedings, the Court may decide, upon a reasoned request by the other party, that the proceedings should be continued in accordance with the applicable national insolvency law.

2. Proceedings may also be stayed at the request of a temporary administrator who has been appointed before a party is declared insolvent.

3. The claimant may withdraw the action against an insolvent defendant in accordance with Rule 265 and a defendant may withdraw a Counterclaim against an insolvent claimant. Such withdrawal shall not prejudice the action against other parties.

4. If proceedings are continued, the effect of a decision of the Court as regards the insolvent party in the action shall be determined by the law applicable to the insolvency proceedings.

### **SECTION 4 – TRANSFER OF PATENT**

#### **Rule 312 – Transfer of the patent or patent application during proceedings**

1. If a patent or patent application is transferred, for one or more Contracting Member States, to another proprietor after proceedings have been started before the Court, the Court may authorise the new proprietor to be added as a party or substituted for a party pursuant to Rule 305 to the extent that the patent and the claims in the proceedings have been assigned to the new proprietor. Rule 306 shall apply *mutatis mutandis*.

2. If the new proprietor takes over the proceedings, no new court fee shall be payable, even if the new proprietor is represented by a new representative.
3. If the new proprietor chooses not to take over the proceedings, any decision in proceedings that have been recorded in the register shall be binding upon him.

## **SECTION 5 – INTERVENTION**

### **Rule 313 – Application to intervene**

1. An Application to intervene may be lodged at any stage of the proceedings before the Court of First Instance or the Court of Appeal by any person establishing a legal interest in the result of an action submitted to the Court (hereinafter “the intervener”).
2. An Application to intervene shall be admissible only if it is made in support, in whole or in part, of a claim, order or remedy sought by one of the parties and is made before the closure of the written procedure unless the Court of First Instance or Court of Appeal orders otherwise.
3. The intervener shall be represented in accordance with Article 48 of the Agreement.
4. The Application to intervene shall contain:
  - (a) a reference to the action number of the file;
  - (b) the names of the intervener and of the intervener's representative, as well as postal and electronic addresses for service and the names of the persons authorised to accept service;
  - (c) the claim, order or remedy in support of which intervention is sought by the intervener; and
  - (d) a statement of the facts establishing the right to intervene under paragraphs 1 and 2.

### **Rule 314 – Order on Application to intervene**

The judge-rapporteur shall decide on the admissibility of the Application to intervene by way of order. The other parties shall be given an opportunity to be heard beforehand.

### **Rule 315 – Statement in intervention**

1. If an Application to intervene is admissible, the judge-rapporteur or the presiding judge shall:
  - (a) inform the parties to proceedings; and
  - (b) specify a period within which the intervener may lodge a Statement in intervention.
2. The Registry shall as soon as practicable serve on the intervener any written pleading served by the parties. On a reasoned request by a party the Court may for the protection of confidential information order that a pleading or part of a pleading be disclosed only to certain named persons and subject to appropriate terms of non-disclosure.
3. The Statement in intervention shall contain:
  - (a) a statement as to the issues involving the intervener and one or more of the parties, and their connection to the matters in dispute;
  - (b) the arguments of law; and

(c) the facts and evidence relied on.

4. The intervener shall be treated as a party, unless otherwise ordered by the Court.

#### **Rule 316 – Invitation to intervene**

1. The judge-rapporteur or the presiding judge may, of his own motion after hearing the parties, or on a reasoned request from a party, invite any person concerned by the outcome of the dispute to inform the Court, within a period to be specified, whether he wishes to intervene in the proceedings.

2. If the person wishes to intervene, he shall present his Application to intervene within one month of service of the invitation and his Statement in intervention within such further period to be specified by the judge-rapporteur or the presiding judge. Rule 313.3, .4, Rule 314 and Rule 315 shall apply *mutatis mutandis*.

3. An intervener shall be bound by the decision in the action.

#### **Rule 316A – Forced intervention**

1. A party who contends that the person should be bound by the decision in the action even if he refuses to intervene shall give reasons for this contention in its reasoned request. In such a case the invitation must include these reasons and must state that the party making the request contends that the person should be bound by the decision in the action even if that person refuses to intervene.

2. If the person invited to intervene pursuant to Rule 316.1 does not intervene but wishes to contend that he should not be bound by the decision in the action, he shall lodge a statement to that effect within the one month period referred to in Rule 316.2. If no such statement is lodged within the time specified he shall be bound by the decision in the action as between himself and any other party to the action and shall not be entitled to argue that the decision in the action was wrong or that the inviting party did not conduct the proceedings leading to the decision in the action properly. If a statement is lodged within the time specified then the Court shall decide whether the person invited to intervene shall be bound having heard the parties and the person invited to intervene. If the Court so decides, the person invited to intervene may present an Application to intervene within one month of service of the Court's decision. Rule 316.2 shall apply. If the person invited to intervene fails to present such an application, he shall be bound by the decision in the action.

#### **Rule 317 – No appeal against an order on the Application to intervene**

There shall be no appeal against an order refusing an Application to intervene.

### **SECTION 6 – RE-ESTABLISHMENT OF RIGHTS**

#### **Rule 320 – Re-establishment of rights**

1. Where a party has failed to observe a time-limit set by these Rules or the Court for a cause which, despite all due care having been taken by the party, was outside his control and the non-observance of this time limit has had the direct consequence of causing the party to lose a right or means of redress, the relevant panel of the Court may upon the request of that party re-establish the right or means of redress.

2. The Application for Re-establishment of rights shall be lodged with the Registry within one

month of the removal of the cause for non-observance of the time-limit but in any event within six months of the non-observed time-limit. Within that time-limit a fee for a Request for Re-establishment of rights fixed under Rule 370 shall be paid.

3. The Application shall:

- (a) state the grounds on which it is based and shall set out the facts on which it relies; and
- (b) contain the evidence relied on in the form of affidavits from all persons involved in the non-observance of the time-limit and the persons involved in establishing the precautionary measures of due care taken in order to avoid such cases of non-compliance.

4. The omitted act shall be performed or completed together with Application for Re-establishment within the time-limit mentioned in paragraph 2.

5. There shall be no grant of Re-establishment of rights in respect of the non-observance of the time limit mentioned in paragraphs 2 and 4 of this Rule.

6. The panel shall decide on the Application for Re-establishment of rights by way of order. The other parties shall be given an opportunity to be heard beforehand.

7. There shall be no right to appeal from an order rejecting an Application for Re-establishment of rights or from an order granting Re-establishment of rights.

## CHAPTER 7 – MISCELLANEOUS PROVISIONS ON LANGUAGES

### **Rule 321 – Application by both parties to use of the language in which the patent was granted as language of the proceedings**

1. At any time during the written procedure, any party may lodge an Application by both parties to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(3) of the Agreement. The Application shall state that both parties agree to use the language in which the patent was granted as the language of the proceedings.
2. As soon as practicable, the Registry shall forward the Application to the panel.
3. The panel shall, as soon as practicable, decide whether it approves the Application by both parties to use the language in which the patent was granted as the language of the proceedings. Where the panel does not approve the Application, the Registry shall as soon as practicable inform the parties who may request, within 10 days, that the action be referred to the central division and the action shall be transferred accordingly.
4. Where the action is transferred to the central division Rule 41 shall apply *mutatis mutandis*.

*Relation with Agreement: Article 49(3)*

### **Rule 322 – Proposal from the judge-rapporteur to use of the language in which the patent was granted as language of the proceedings**

At any time during the written procedure and the interim procedure, the judge-rapporteur may, of his own motion or on a request by a party, after consulting the panel, propose to the parties that the language of the proceedings be changed to the language in which the patent was granted, in accordance with Article 49(4) of the Agreement. If the parties and panel agree the language of the proceedings shall be changed.

*Relation with Agreement: Article 49(4)*

### **Rule 323 – Application by one party to use the language in which the patent was granted as language of the proceedings**

1. If a party wishes to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(5) of the Agreement, the party shall include such Application in the Statement of Claim, in the case of a claimant, or in the Statement of Defence, in the case of a defendant. The judge-rapporteur shall forward the Application to the President of the Court of First Instance.
2. The President shall invite the other party to indicate, within 10 days, its position on the use of the language in which the patent was granted as language of the proceedings.
3. The President, having consulted the panel of the division, may order that the language in which the patent was granted shall be the language of the proceedings and may make the order conditional on specific translation or interpretation arrangements.

*Relation with Agreement: Article 49(5)*

**Rule 324 – Consequences where the language of the proceedings is changed in the course of the proceedings**

An Application under Rule 321.1 or 323.1 shall specify whether existing pleadings and other documents should be translated and at whose cost. If the parties cannot agree the judge-rapporteur or the President of the Court of First Instance, as the case may be, shall decide in accordance with Rule 323.3.

## **CHAPTER 8 – CASE MANAGEMENT**

*[Article 43 Agreement, CST RoP Part 2, Chapter 3]*

### **Rule 331 – Responsibility for case management**

1. During the written procedure and the interim procedure, case management shall be the responsibility of the judge-rapporteur subject to Rules 102 and 333.
2. The judge-rapporteur may refer a proposed order to the panel.
3. After the closure of the interim conference, case management shall be the responsibility of the presiding judge in consultation with the judge-rapporteur.
4. The Registry shall serve any case management orders on the parties as soon as practicable after the decision of the judge-rapporteur, presiding judge or panel.

### **Rule 332 – General principles of case management**

Active case management includes:

- (a) encouraging the parties to co-operate with each other during the proceedings;
- (b) identifying the issues at an early stage;
- (c) deciding promptly which issues need full investigation and disposing summarily of other issues;
- (d) deciding the order in which issues are to be resolved;
- (e) encouraging the parties to make use of the Centre and facilitating the use of the Centre;
- (f) helping the parties to settle the whole or part of the action;
- (g) fixing timetables or otherwise controlling the progress of the action;
- (h) considering whether the likely benefits of taking a particular step justify the cost of taking it;
- (i) dealing with as many aspects of the action as the Court can on the same occasion;
- (j) dealing with the action without the parties needing to attend in person;
- (k) making use of available technical means; and
- (l) giving directions to ensure that the hearing of the action proceeds quickly and efficiently.

### **Rule 333 – Review of case management orders**

1. Case management decisions or orders made by the judge-rapporteur or the presiding judge shall be reviewed by the panel, on a reasoned Application by a party.
2. An Application for the review of a case management order shall be lodged within 15 days of service of the order. The Application shall set out the grounds for review and the evidence, if any, in support of the grounds. The other party shall be given an opportunity to be heard.
3. The party seeking a review shall pay the fee for the review of a case management order, in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

4. The panel shall as soon as practicable decide the Application for review and make any necessary revised case management order.

5. A decision of the panel on an Application for review is a procedural decision for the purposes of Rule 220.2.

#### **Rule 334 – Case management powers**

Except where the Agreement, the Statute or these Rules provide otherwise, the judge-rapporteur, the presiding judge or the panel may:

- (a) extend or shorten the period for compliance with any rule or order [Rule 9.3];
- (b) adjourn or bring forward the interim conference or the oral hearing;
- (c) communicate with the parties to instruct them about wishes or requirements of the Court;
- (d) direct a separate hearing of any issue;
- (e) decide the order in which issues are to be decided;
- (f) exclude an issue from consideration;
- (g) dismiss or decide on a claim after a decision on a preliminary issue makes a decision on further issues irrelevant to the outcome of the action;
- (h) dismiss a claim summarily if it has no prospect of succeeding;
- (i) consolidate any matter or issue or order them to be heard together;
- (j) make any order pursuant to Rules 103 to 109.

#### **Rule 335 – Varying or revoking orders**

The power of the Court to make a case management order includes a power to vary or revoke such order.

#### **Rule 336 – Exercise of case management powers**

The Court may exercise its case management powers on the application by a party or of its own motion, unless otherwise provided.

#### **Rule 337 – Orders of the Court's own motion**

Where the Court proposes to make an order of its own motion, it may do so but only after hearing the parties.

#### **Rule 340 – Connection Joinder**

1. In the interests of the proper administration of justice and of avoiding inconsistent decisions, where more than one action concerning the same patent (whether or not between the same parties) is pending before:

- (a) different panels (whether in the same or different divisions); or
- (b) different panels of the Court of Appeal,

the panels may by agreement, at any time, after hearing the parties, order that two or more actions shall, on account of the connection between them, be heard together. Article 33 of the Agreement shall be respected.

2. The actions may subsequently be disjoined.

## **CHAPTER 9 – RULES RELATING TO THE ORGANISATION OF THE COURT**

### **Rule 341 – Precedence**

1. With the exception of the President of the Court of Appeal and the President of the Court of First Instance, the judges shall rank in precedence according to their seniority in office.
2. Where there is equal seniority in office, precedence shall be determined by age.
3. Retiring judges who are reappointed shall retain their former precedence.
4. The Presidium may determine the presiding judge of a panel. In the absence of such a determination by the Presidium and unless otherwise agreed by the panel the most senior judge shall be the presiding judge.

### **Rule 342 – Dates, times and place of the sittings of the Court**

1. The duration of judicial vacations shall be fixed by the President of the Court of Appeal, on a proposal from the Presidium. The dates and times of the sittings of the Court shall be decided by the presiding judge of the panel of the division in question.
2. The Court may choose to hold one or more particular sittings in a place other than that in which it has its seat. Subject to any rules agreed by the relevant Contracting Member States pursuant to Article 7(5) of the Agreement where an action is pending before a regional division the judge-rapporteur or the presiding judge shall designate the place within the region for each hearing having regard to the residence or place of business of the defendant(s) and all other relevant circumstances such as the facilities available, the financial means of the parties and the place of actual or threatened infringement.

*Relation with Statute: Article 17*

### **Rule 343 – Order in which actions are to be dealt with**

1. The Court shall deal with the actions before it in the order in which they become ready for hearing in accordance with Rule 108.
2. The presiding judge of a panel may, after hearing the parties [Rule 264]:
  - (a) direct that a particular action be given priority and that time limits provided for in these Rules be shortened;
  - (b) defer an action to be dealt with later, in particular with a view to facilitating an amicable settlement of the dispute.

*[CST RoP Article 47]*

### **Rule 344 – Deliberations**

1. The Court shall deliberate in closed session.
2. The presiding judge shall preside over the deliberations. Only those judges who were present at the oral hearing may take part in the deliberations on the decision.
3. The deliberation of the Court shall take place as soon as possible after the closure of the oral hearing.

### **Rule 345 – Composition of panels and assignment of actions**

1. The presiding judge of each local or regional division or the seat of the central division or one of its sections (being the judge appointed by the Presidium as the presiding judge) shall, after consultation, allocate the legally qualified judges assigned to his division, the seat of the central division or one of its sections to its panels.
2. The allocation shall be in conformity with Article 8 of the Agreement.
3. The actions pending in the division, the seat of the central division or one of its sections shall be assigned to the panels by the Registrar following an action-distribution-scheme established by the respective presiding judge for the duration of one calendar year, preferably distributing the actions according to the date of receipt of the actions at the division or section.
4. Each panel may delegate to one of more judges of the panel:
  - (a) the function of acting as a single judge; or
  - (b) the function of acting for the panel in the procedures of Part 1 Chapter 4 (Procedure for the Determination of Damages and Compensation, including the procedure for the laying open of books) and Chapter 5 (Procedure for Cost Decisions). These functions may be delegated to the judge-rapporteur who has prepared the action for the oral hearing.
5. The presiding judge of the division, the seat of the central division or one of its sections shall designate a judge assigned to his division, the seat of the central division or one of its sections as a standing judge for urgent actions. The assignment may be limited to certain periods of time.
6. If all parties agree to having the action heard by a single judge, the presiding judge of the panel to which the action is allocated shall assign the action to a legally qualified judge of the panel.
7. Where paragraphs 1 to 6 apply to decisions by the presiding judge of the seat of the central division or one of its sections, the President of the Court of First Instance may of his own motion review that decision.
8. Paragraphs 1 to 6 shall apply *mutatis mutandis* to the Court of Appeal. All references to the presiding judge of the division shall, regarding the Court of Appeal, refer to the President of the Court of Appeal.

*Relation with Statute: Article 19*

### **Rule 346 – Application of Article 7 of the Statute**

1. If a party objects to a judge taking part in proceedings pursuant to Article 7(4) of the Statute, the presiding judge of the local or regional division to which the judge is allocated or, if the action is pending before the seat of the central division or one of its sections, the respective presiding judge shall, after hearing the judge concerned, decide whether the objection is admissible having regard to Article 7(2) of the Statute.
2. If the objection is admissible, the respective presiding judge shall refer the action to the Presidium which shall hear the judge concerned and shall decide whether the objection shall stand or not.

3. Paragraphs 1 and 2 shall apply to a judge of the Court of Appeal. The presiding judge of the panel shall perform the functions attributed to the presiding judge of the division, the seat of the central division or one of its sections in these paragraphs.

*Relation with Statute: Article 7*

## **CHAPTER 10 – DECISIONS AND ORDERS**

### **Rule 350 – Decisions**

1. Any decision shall contain:

- (a) the statement that it is a decision of the Court;
- (b) the date of its delivery;
- (c) the names of the presiding judge, the judge-rapporteur and other judges taking part in it;
- (d) the names of the parties and of the parties' representatives;
- (e) an indication of the claim, order or remedy sought by the parties;
- (f) a summary of the facts; and
- (g) the grounds for the decision.

2. The order of the Court consequential upon the decision (other than costs) including any order giving immediate effect to an injunction, shall be appended to the decision. The Order shall comply with Rule 351.

3. Any dissenting opinion shall be attached to the Court's decision.

4. The decision of the Court of First Instance shall contain a summary of the requests and facts submitted by the parties and a statement of the facts and arguments on which the Court bases its decision.

5. All decisions shall be recorded in the register.

*Relation with Statute: Article 35(4)*

### **Rule 351 – Orders**

1. Every order shall contain:

- (a) the statement that it is an order of the judge-rapporteur, of the standing judge, of the single judge, of the presiding judge, of a President of the Court or of the Court;
- (b) the date of its adoption;
- (c) the names of any judge taking part in its adoption;
- (d) the names of the parties and of the parties' representatives; and
- (e) the operative part of the order.

2. Where, in accordance with these Rules the Court grants leave to appeal an order the order shall in addition contain:

- (a) a statement of the forms of order sought by the parties;
- (b) a summary of the facts; and
- (c) the grounds for the order.

3. All orders shall be recorded in the register.

### **Rule 352 – Binding effect of decisions or orders subject to security**

1. Decisions and orders may be subject to the rendering of a security (whether by deposit or bank guarantee or otherwise) by a party (or parties) to the other party (or parties) for legal costs and other expenses and compensation for any damage incurred or likely to be incurred by the other party (or parties) if the decisions and orders are enforced and subsequently revoked.

2. The Court may upon the application of a party release a security by order.

### **Rule 353 – Rectification of decisions and orders**

The Court may, by way of order, of its own motion or on application by a party made within one month of service of the decision or order to be rectified, after hearing the parties, rectify clerical mistakes, errors in calculation and obvious slips in the decision or order.

### **Rule 354 – Enforcement**

1. Subject to Rule 118.8 and 352 decisions and orders of the Court shall be directly enforceable from their date of service in each Contracting Member State. Enforcement shall take place in accordance with the enforcement procedures and conditions governed by the law of the particular Contracting Member State where enforcement takes place.

2. Where during an action an enforceable decision or order of the Court is subsequently varied or revoked, the Court may order the party which has enforced such decision or order, upon the request of the party against whom the decision or order has been enforced, to provide appropriate compensation for any injury caused by the enforcement. Rule 125 shall apply *mutatis mutandis*. Where an enforceable decision or order has been made pursuant to a finding of infringement of a patent and, following the conclusion of the action, the patent is amended or revoked, the Court may order, upon the request of the party against whom the decision or order would be enforceable, that the decision or order ceases to be enforceable.

3. The Court's decisions and orders may provide for periodic penalty payments payable to the Court in the event that a party fails to comply with the terms of the order or an earlier order. The value of such payments shall be set by the Court having regard to the importance of the order in question.

4. If it is alleged that a party has failed to comply with the terms of the order of the Court, the first instance panel of the division in question may decide on penalty payments provided for in the order upon the request of the other party or on its own motion. The procedure foreseen in Rule 264 shall apply. After having heard both parties the Court may make an appropriate order which may be subject to an appeal pursuant to Rule 220.2.

*Relation with Agreement: Article 82*

## **CHAPTER 11 – DECISION BY DEFAULT**

### **Rule 355 – Decision by default (Court of First Instance)**

1. Upon request a decision by default may be given against a party where:
  - (a) the Rules of Procedure so provide if a party fails to take a step within the time limit foreseen in these Rules or set by the Court; or
  - (b) without prejudice to Rules 116 and 117, the party which was duly summoned fails to appear at an oral hearing.
2. A decision by default against the defendant of the claim or counterclaim may only be given where the facts put forward by the claimant justify the remedy sought.
3. A decision by default against the defendant of the claim or counterclaim may only be given where the time limits for the defence to the claim or counterclaim have expired.
4. A decision by default shall be enforceable. The Court may, however:
  - (a) grant a stay of enforcement until it has given its decision on any Application under Rule 356; or
  - (b) make enforcement subject to the provision of security; this security shall be released if no Application is made or if the Application fails.

### **Rule 356 – Application to set aside a decision by default**

1. A party against whom a decision by default has been given may lodge an Application to set aside that decision within one month of service of the decision.
2. The Application to set aside a decision by default shall contain the party's explanation for the default. It shall mention the date and number of the decision by default. The party shall pay a fee for the Application to set aside the decision by default [EUR\*\*\*]. In the case of Rule 355.1(a) the Application shall be accompanied by the step the party has failed to take.
3. If the provisions of Rule 356.2 are met the Application shall be allowed unless a party has been put on notice in an earlier decision that a further decision by default shall be final. If the Application is allowed, a note of allowance shall be included in any publication of the decision by default.

*Relation with Statute: Article 37*

### **Rule 357 – Decision by default (Court of Appeal)**

1. Rules 355 and 356 shall apply *mutatis mutandis*, in particular where a respondent on whom a Statement of appeal and a Statement of the grounds of appeal have been duly served fails to lodge a Statement of response or where a party fails to file a Reply to a Statement of Cross-Appeal or translations ordered by the judge-rapporteur.
2. When considering whether to give a decision by default, the Court of Appeal may consider the merits of the appeal.

3. Rules 355 and 356 shall apply *mutatis mutandis* where the appellant fails to correct the deficiencies or to pay the fee pursuant to Rule 229.4 or to lodge the translations pursuant to Rule 232.1 within the period specified.

## **CHAPTER 12 – ACTIONS BOUND TO FAIL OR MANIFESTLY INADMISSIBLE**

### **Rule 360 – No need to adjudicate**

If the Court finds that an action has become devoid of purpose and that there is no longer any need to adjudicate on it, it may at any time, on the application of a party or of its own motion, after giving the parties an opportunity to be heard, dispose of the action by way of order.

### **Rule 361 – Action manifestly bound to fail**

Where it is clear that the Court has no jurisdiction to take cognisance of an action or of certain of the claims therein or where the action or defence is, in whole or in part, manifestly inadmissible or manifestly lacking any foundation in law, the Court may, after giving the parties an opportunity to be heard, give a decision by way of order.

### **Rule 362 – Absolute bar to proceeding with an action**

The Court may at any time, on the application of a party or of its own motion, after giving the parties an opportunity to be heard, decide that there exists an absolute bar to proceeding with an action, for example because of the application of the principle of *res judicata*.

### **Rule 363 – Orders dismissing manifestly inadmissible claims**

1. Orders under Rules 360, 361 and 362 shall be taken by the panel upon the recommendation of the judge-rapporteur.
2. Where the decision is taken by the Court of First Instance pursuant to Rules 360, 361 and 362 it is a final decision within the meaning of Rule 220.1(a).

## **CHAPTER 13 – SETTLEMENT**

### **Rule 365 – Confirmation by the Court of a settlement**

1. Where the parties have concluded their action by way of settlement, they shall inform the judge-rapporteur. The Court shall confirm the settlement by decision of the Court [Rule 11.2], if requested by the parties, and the decision may be enforced as a final decision of the Court.
2. At the request of the parties the Court may order that details of the settlement are confidential.
3. Subject to Rule 365.2 the decision of the Court under Rule 365.1 shall be entered on the register.
4. The judge-rapporteur shall give a decision as to costs in accordance with the terms of the settlement or, failing that, at his discretion.

*Relation with Agreement: Article 79*

## **PART 6 – FEES AND LEGAL AID**

### **COURT FEES**

#### **Rule 370 – Court fees [This Rule will be redrafted in the light of the consultation on the court fees]**

1. Court fees provided for in these Rules shall be paid to the Court. They shall be levied in accordance with the provisions contained in this Part.
2. The court fees to be paid to the Court shall be as follows:
  - (a) Fixed fees, in [EUR\*\*]

#### **Court of First Instance**

Fee for an opt-out:

Fee for withdrawal of an opt-out:

Fee for infringement action:

Fee for counterclaim for revocation:

Fee for revocation action:

Fee for counterclaim for infringement:

Fee for declaration of non-infringement:

Fee for action for compensation for licence of right

Fee for action against a decision of the European Patent Office:

Fee for application to review a case management order:

Fee for application to preserve evidence:

Fee for application for provisional measures:

Fee for application to determine damages:

Fee for application to determine compensation pursuant to Rule 125:

Fee for application for re-establishment of rights:

Fee for application to file a protective letter to or to prolong the period kept on the register:

Fee for application to set aside decision by default:

## **Court of Appeal**

Fee for appeal pursuant to Rule 220.1(a) and (b)

Fee for appeal pursuant to Rule 220.1(c) and .2

Fee for lodging a protective letter:

Fee for rehearing:

(b) Value-based fees in [EUR\*\*\*]

Value in dispute in EUR

Fees

### **Rule 371 – Time periods for paying court fees**

1. The fixed fees [Rules 5, 15.1, 26, 47, 53, 68, 132, 192.5, 206.5, 207.4, 228] shall be paid at the time of lodging the relevant pleading or application. The payment shall be made to one of the bank accounts indicated by the Court and it shall indicate the paying party or its representative together with the number of the patent (or patents) involved and the number of the case.

2. Proof of payment shall be provided together with the relevant pleading or application.

3. In cases of urgency, where a payment in advance is not possible, the representative of the party in question shall pay the fixed fee within the period set by the Court and the Court may order that the relevant pleading or application shall be deemed lodged and effective when received by the Registry if payment of the fixed fee is made within such period.

4. The value-based fee shall be paid within 10 days of service of the order determining the value of the dispute in accordance with the Rules 22, 31, 57, 58, 69, 104(i) and 133.

5. Where an Application for legal aid has been lodged in accordance with Rule 377, the rules on the obligation as to the time when to pay the fixed fees under Rule 371.1 shall not apply.

*Relation with Agreement: Article 70*

## **LEGAL AID**

### **Rule 375 – Aim and scope**

1. In order to ensure effective access to justice, the Court may grant legal aid to a party (hereinafter “the applicant”).

2. Legal aid may be granted in respect of any proceedings before the Court.

### **Rule 376 – Costs eligible for legal aid**

1. Subject to Article 71(3) of the Agreement, legal aid may cover, in whole or in part, the following costs:

(a) court fees;

(b) costs of legal assistance and representation regarding:

(i) pre-litigation advice with a view to reaching a settlement prior to commencing legal proceedings;

(ii) commencing and maintaining proceedings before the Court;

(iii) all costs relating to proceedings including the application for legal aid;

(iv) enforcement of decisions;

(c) other necessary costs related to the proceedings to be borne by a party, including costs of witnesses, experts, interpreters and translators and necessary travel, accommodation and subsistence costs of the applicant and his representative.

2. Subject to Article 71(3) of the Agreement, legal aid may also cover the costs awarded to the successful party, in the event that the applicant loses the action.

### **Rule 376A – Maximum amount to be paid for representation**

1. For the costs of representation pursuant to Rule 376.1(b) the maximum level of legal aid that may be granted by the Court shall be the maximum amount of recoverable costs laid down in the decision of the Administrative Committee pursuant to Article 69(1) of the Agreement and Rule 152.2.

2. The Administrative Committee may define thresholds below the level set in paragraph 1 for the maximum level of legal aid for representation pursuant to Rule 376.1(b), taking into account necessary costs for legal representation in the Contracting Member States and the need to guarantee adequate access to justice.

### **Rule 377 – Conditions for granting legal aid**

1. Any natural person who is a citizen of the European Union or a third country national residing lawfully in a Member State of the European Union shall be entitled to apply for legal aid where:

(a) owing to his economic situation, he is wholly or partly unable to meet the costs referred to in Rule 376; and

(b) the action in respect of which the application for legal aid is made has a reasonable prospect of success, considering the applicant's procedural position; and

(c) the claimant applying for legal aid is entitled to bring actions under Article 47 of the Agreement.

2. The Administrative Committee may define thresholds above which legal aid applicants are deemed wholly or partly able to bear the costs of proceedings set out in Rule 376. These thresholds may not prevent applicants whose economic situation is above the thresholds from

being granted legal aid if they prove that they are in fact unable to pay the costs of the proceedings referred to in Rule 376 as a result of the high level of the cost of living in the Contracting Member State of domicile or habitual residence.

3. When deciding on the grant of legal aid the Court shall, without prejudice to paragraph 1(a), consider all relevant circumstances including the importance of the action to the applicant and also the nature of the action when the application concerns a claim arising directly out of the applicant's trade or self-employed profession.

#### **Rule 377A – Conditions regarding the financial situation of the applicant**

1. When assessing a party's financial situation, his income and assets must be taken into account.

2. Income shall include all earnings in money or equivalent value after deducting all costs required by the applicant and dependent persons in order to cover their reasonable living expenses (disposable income).

3. The Administrative Committee shall define the deductions from income and assets to be taken into account when assessing the applicant's financial situation. It shall also define levels of monthly instalments to be paid by the applicant. All thresholds set by the Administrative Committee shall be adapted regularly to price and income indices.

#### **Rule 378 – Application for legal aid**

1. An application for legal aid may be lodged before or after proceedings have been started before the Court.

2. The Application for legal aid shall contain in a language of a Contracting Member State:

(a) the name of the applicant;

(b) postal and electronic addresses for service on the applicant and the names of the persons authorised to accept service;

(c) the name of the other party as well as postal and electronic addresses for service on the other party where available and the names of the persons authorised to accept service, if known;

(d) the action number of the action in respect of which the application is made or, where the application is lodged before the action has been brought, a brief description of the action;

(e) an indication of the value of the action and the costs to be covered by legal aid;

(f) where legal aid is requested for costs of legal assistance and representation, the name of the proposed representative;

(g) an indication of the applicant's financial resources, such as income, assets and capital, and of the applicant's family situation including an assessment of the resources of persons who are financially dependent on the applicant;

(h) where appropriate, a reasoned request for suspension of a time limit which would otherwise need to be observed until the date of notification of the order deciding on legal aid.

3. The application for legal aid must be supported by:

(a) evidence of the applicant's need for assistance, such as certificates attesting his income, assets and capital and family situation; and

(b) where the application is lodged before the action has been brought, an indication of the evidence in support of the action.

4. In the event of an appeal, a new application shall be lodged.

5. Rule 8 shall not apply.

#### **Rule 378A – Type of proof**

1. To be admissible, the application must contain a statement of the facts and legal situation, with specific mention of the evidence to be presented. The application must also contain a statement regarding the economic and financial situation of the applicant. The following documents shall be attached to the application:

(a) latest property and income declarations of the applicant;

(b) a document showing the personal monthly income for the previous year, or a declaration of unemployment delivered by the competent authorities, or a certificate proving that the applicant is receiving aid or financial support under a social welfare scheme;

(c) a certificate of composition of household;

(d) any other official document that can provide proof of the financial situation of the applicant.

2. Where appropriate, a certificate relating to the income of other members of the household of the applicant should also be attached to the application. The official documents shall not be older than 3 months. At the request of the Court, the applicant shall produce further documentation and, if so requested, an affidavit of the truthfulness of his statements, otherwise the application will not be admissible.

#### **Rule 379 – Examination and decision**

1. The Registry shall examine the formal admissibility of the application for legal aid and the conditions regarding the financial situation of the applicant pursuant to Rules 377.1(a), .2 and 377a.

2. If the requirements referred to in Rules 377.1(a), .2, 377a, 378 and 378a have not been met, the applicant shall, as soon as practicable, be invited to correct the deficiencies within 14 days.

3. If the requirements referred to in Rules 377.1(a), .2, 377a, 378 and 378a have been met, the decision on such application shall be taken, by way of order, by the judge-rapporteur or, where the application is lodged before the action has been brought, by the standing judge.

4. Before making a decision on an application for legal aid, the Court shall invite the other party to submit written observations unless it is already apparent from the information submitted that the conditions referred to in Rule 377.1(b) have not been met. Documents regarding the economic and financial situation of the applicant shall be made accessible to the other party only where the applicant has consented or the applicant's refusal of consent is unreasonable or in the view of the Court the other party has a right to information on the economic or financial situation of the applicant.

5. An order refusing legal aid shall state the reasons on which it is based.

6. An order granting legal aid may provide for:

- (a) an exemption, wholly or partly, from Court fees;
- (b) an interim amount to be paid to enable the applicant and/or the representative of the applicant to meet any request of the judge-rapporteur or standing judge prior to making a final order;
- (c) an amount to be paid to the representative of the applicant or a limit which the representative's disbursements and fees may not exceed;
- (d) a contribution to be made by the applicant to the costs referred to in Rule 376.1(c).

7. Legal aid may be granted only for the period from receipt of the application with the Court.

8. Where the legal aid covers, in whole or in part, the costs of legal assistance and representation the order granting legal aid shall designate the representative of the applicant.

9. On a request by the designated representative, the Court may order that an amount shall be paid by way of advance.

10. Where requested by the applicant in accordance with Rule 378.2(h), the Court shall decide on the suspension of any time limit.

#### **Rule 379A – Alteration of economic situation**

The applicant shall inform the Court promptly of any alteration in his economic situation.

#### **Rule 380 – Withdrawal of legal aid**

1. If the economic situation of the applicant which has led to the grant of legal aid according to Rule 377.1(a) alters during the proceedings, the Court may at any time, of his own motion or on a reasoned request by the other party, withdraw wholly or partly legal aid but only after having heard the applicant.

2. The Court may withdraw wholly or partly legal aid if the applicant

- (a) by inaccurately representing the circumstances of the case, has misrepresented its prospects of success, which are determinative for the approval of assistance with Court costs; or
- (b) has grossly negligently made false statements as to his personal or economic circumstances; or
- (c) has not immediately informed the Court of a considerable improvement to his financial circumstances;
- (d) has been in arrears for longer than three months with the payment of a monthly instalment or with the payment of any other amount.

3. An order withdrawing legal aid shall state the reasons on which it is based.

#### **Rule 381 – Appeal**

An order wholly or partly refusing or withdrawing legal aid may be appealed to the Court of Appeal. The appeal shall be filed with the Court of Appeal within a period of one month after

receiving the order. The Court of Appeal may grant legal aid for the conduct of the appeal pursuant to the provisions of Rules 377 to 379.

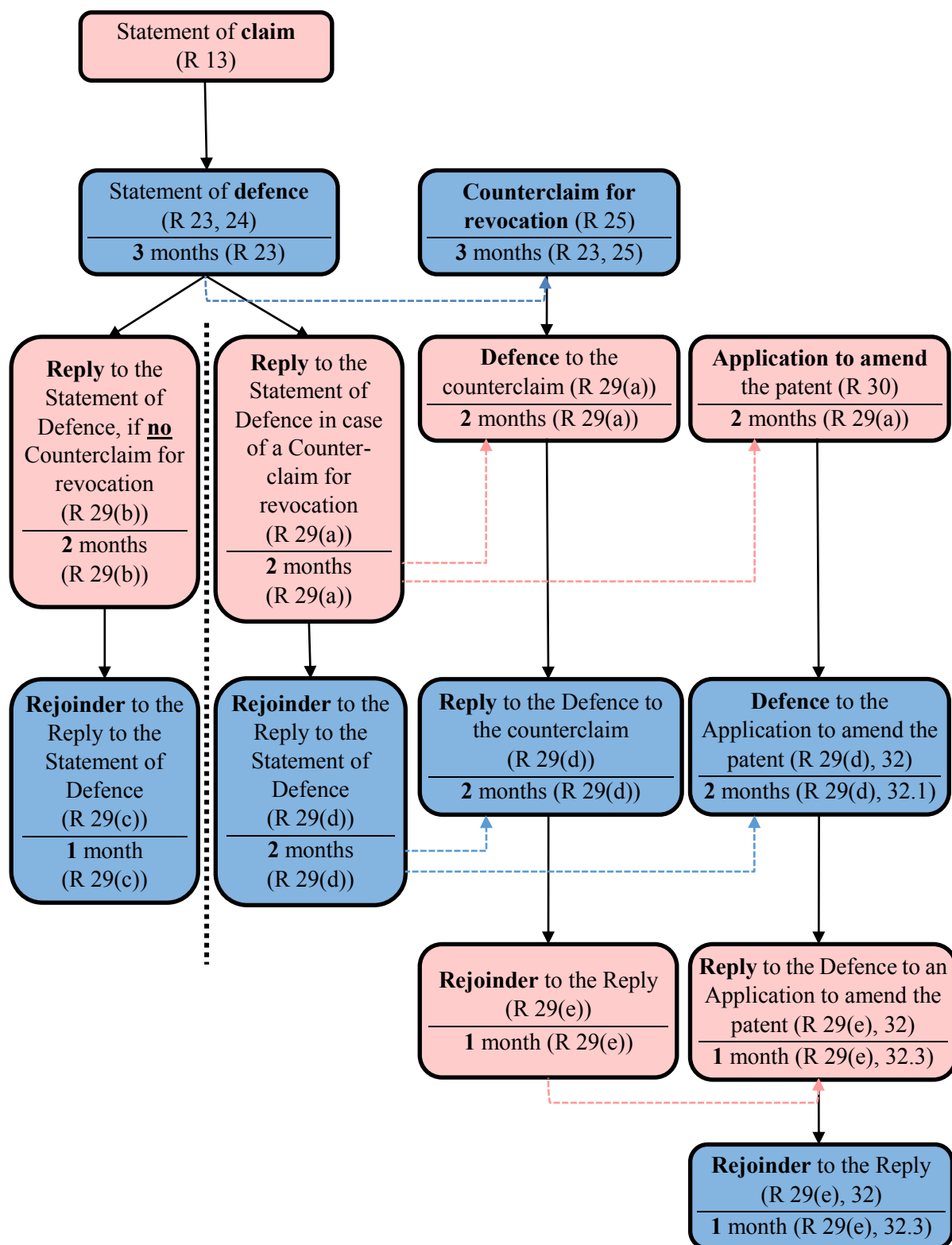
**Rule 382 – Recovery**

1. Where the Court has ordered another party to pay the costs of the applicant for legal aid, that other party shall be required to refund to the Court any sums advanced by way of legal aid. In the event of a shortfall between the costs so ordered and the sums advanced by way of legal aid the applicant may be required to meet such shortfall from any damages or compensation awarded by the Court or from any sum received by way of settlement.
2. In the event of withdrawal of legal aid under Rule 380, the applicant may be required to refund to the Court any sums advanced by way of legal aid.

**Annex I [see Rule 271.1]**

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## Annex II – Infringement proceedings



### Annex III – Revocation proceedings

