

THE EU UNIFIED PATENT COURT— BACKGROUND, STRUCTURE AND PROCEDURES

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I. INTRODUCTION

This paper provides part of the basis for discussing the current proposal for a Unified Patent Court (UPC) in the European Union (EU), and for comparing the UPC with existing courts in Europe and the United States. In particular, the paper focuses on broadly outlining the background, and the structure and procedures of the UPC, and the potential effect on the UPC proposal of the United Kingdom leaving the EU (commonly referred to as “Brexit”).¹ A separate paper for this conference, by Anthony Trenton, focuses on the choice of a court or UPC division in Europe, *i.e.*, forum shopping.

The UPC, the treaty that would create it and the rules of procedure prepared for its use are not only worthy of study because the UPC is potentially the European patent court of the future, but also as suggesting procedures for fast adjudication of patent disputes for consideration in other countries.

II. BACKGROUND AND A CONDENSED HISTORY

The current package proposal for the UPC along with a “European Patent with unitary effect” in the participating EU states (Unitary Patent” or UP) is expected to be the culmination of over 40 years of efforts to provide for a single patent and a single patent court in multiple European states.

A. European States, Treaties and Institutions

Geographically, Europe spans a large continent and surrounding islands from the Arctic Ocean in the north to the Mediterranean Sea in the south, and from the Atlantic Ocean in the west to the Ural Mountains east of Moscow. Transcontinental states Azerbaijan, Georgia, Kazakhstan, Russia and Turkey have territory both in Europe and Asia. Some definitions of Europe also include Greenland and Iceland.

There are many national states within Europe with many treaties, creating many European institutions. The most significant institutions are those of the European Union, but not all states geographically within Europe are members of the EU.

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The current European Union developed through a series of treaties, which successively created and built the European Coal and Steel Community (1951) and the European Economic Community (EEC), which started with six states in 1958, before the creation of the European Union in 1993. In 2009, the Lisbon Treaty reformed many aspects of the EU as a single entity with legal personality.

Other significant European institutions, outside the EU and having both EU and non-EU member states, include—for example—the European Court of Human Rights and the European Patent Office (EPO).

Norway, Iceland, Liechtenstein and Switzerland, are non-EU, European states that are members of the European Free Trade Association (EFTA). Three of those four states (excepting Switzerland) have close ties with the EU through the European Economic Area (EEA) Agreement of 1994, which is open to member states of either the EU or the EFTA. The EEA Agreement provides for the free movement of persons, goods, services and capital within the European Single Market of the EU and EFTA. The non-EU EEA countries have agreed in the EEA Agreement to adopt much of the law of the EU, without a vote in EU institutions. The main exceptions to EU law in the non-EU EEA states are in the areas of agriculture and fisheries. An EEA Joint Committee, consisting of the three non-EU EEA states plus the European Commission (representing the EU) coordinates the extension of relevant EU law to the non-EU members. An EEA Council meets twice yearly to govern the overall relationship between the EEA members.

The largest European state outside of the EU is Switzerland, which has negotiated well over 100 treaties with the EU (through its Commission) over a period of ten years.

B. Patents in Europe

Grants of national patents for inventions and national litigation involving patents began in or before the 19th century in most European states. The Paris Convention, which most European states joined in the 19th Century, created the right to claim the priority of an earlier application filed in a participating state and the right of foreign applicants to the same “national treatment” as the treatment of citizens in the states of filing. But it continued to be necessary to file an application in each state for which the applicant desired a patent. The substantive patent laws, and application and litigation procedures differed significantly through the first half of the 20th century, and practically every state required that applications be filed in a national language.

In the 1970s, two major patent treaties were signed by European States: The European Patent Convention (EPC) of 1973, which initially included seven states, and the Community Patent Convention (CPC) of 1975 among the nine states that were members of the European Community at that time.

The EPC was ratified. It created the European Patent Organization, including an Administrative Council and the EPO, which opened in 1977 to conduct a single examination of a patent application, which—upon grant as a “European Patent” (EP)—could be validated as national patents in some or all of the EPC member states. Translation requirements under the

EPC were somewhat simpler than before. Applications could be filed in any one of English, French or German, and full translations into other languages could await the time of national validation in the states designated by the applicant.

The CPC would have created a single “Community Patent,” to be granted by the EPO for all member states of the European Community. The CPC would have created special departments within the EPO including Revocation Divisions and Revocation Boards for appeals from those divisions. The CPC would have permitted a further appeal from a decision of a Revocation Board to the Court of Justice of the European Union, limited to violation of the CPC or of an essential procedural requirement; however, the CJEU would not have been permitted to examine the facts as determined in the decision of the Revocation Board. Infringement litigation would have been handled in national courts.

The CPC, however, was never fully ratified and the procedure for granting Community Patents never came into effect. Several other attempts were made to create a single, transnational patent in Europe and a transnational court for patent litigation in Europe in the years between 1989 and 2010, but they also failed.

Today, the EPO application procedure exists in parallel with national filings in almost all participating states and no trans-national patent litigation system has been created in Europe to date.

There was some movement in the latter part of the 20th Century, however, toward simpler international patenting procedures and substantive patent law harmonization. Notably, the Patent Cooperation Treaty (PCT) of 1970, among both European and non-European states, created a procedure and standards for an initial patentability search by a single patent office that might be relied upon in subsequent examinations in the EPO and national patent offices. Although patent matters remain almost entirely a matter of national laws, the EU has issued directives to its member states requiring them to harmonize their IP enforcement laws in specific ways, a biotechnology directive and a supplementary protection certificate (SPC) regulation. Also, in the London Agreement of 2000, several European states agreed to reduce their translation requirements for European Patents that are validated in their jurisdictions.

C. The Unified Patent Court and Unitary Patent

The current proposal in Europe is a package of the UPC Agreement (UPCA) that would create and govern the UPC, and two EU regulations that would permit the EPO to grant “European patents with unitary effect” (UPs) and limit the translation requirements for UPs. Ratification of the UPCA by a minimum of 13 EU states, which must include France, Germany and the UK, will trigger both opening of the UPC approximately four months later and authorization of the EPO to begin granting UPs.

This package is a compromise in three major respects:

- Because Spain and Italy would not agree to a system that did not require translation of Unitary Patents into their national languages, the UPCA is an

agreement of “enhanced cooperation” between some “Contracting Member States” and not an EU Agreement. (Italy has since decided to join).

- Because the Court of Justice of the European Union rejected an earlier proposal that would have permitted participation by both EU and non-EU states, the current package permits participation only by EU member states.
- Compromises in the UPC structure, and the exclusive competence of the UPC and translation requirements during initial transitional periods, were made to accommodate national interests. For example, the UPC first instance level would have many divisions in the Contracting States, and a central division with sections in London, Munich and Paris. Also, the UPC procedures are a blend of civil law and common law practices.

Prior to the June 23, 2016 Brexit Referendum in the UK, in which a majority voted to leave the European Union, ten states, including France, had already ratified the UPCA. Completion of ratification by the minimum number of states, including Germany, the UK and several other states appeared likely to occur in 2016. Therefore, it seemed likely that the EU Unified Patent Court (UPC) would open for business in the spring of 2017.

D. Brexit

In the Brexit Referendum, UK voters were asked whether they wanted the UK to “Leave” the EU or “Remain” in the EU. A 51.9% majority voted to Leave.

The Referendum result itself is not sufficient to initiate leaving the EU. Article 50 of the Lisbon Treaty provides that a state desiring to leave the EU must give notice of intent to leave the EU. The UK has not yet given notice of intent to leave the EU. It is unclear whether the Referendum vote alone is sufficient authority for the Prime Minister to give notice of intent to leave the EU or whether a vote of Parliament would be necessary. Litigation on that question is in progress. It is unclear how Parliament would vote, in view of the fact that a majority of the members favored remaining in the EU, on the one hand, and a feeling of obligation to follow the will of the people, on the other.

Pursuant to Article 50, the separation would be effective two years after the notice, unless that period is extended by agreement of all EU members. As a practical matter, the process is likely to take longer, and there is a small possibility that the UK would change its intent, and either not give notice or withdraw its notice.²

Following the Referendum, Theresa May (the new Prime Minister, who had been in the “Remain” camp) has said “Brexit means Brexit”; however, she has also indicated that the UK’s Article 50 notice would not be given before the end of 2016. Indeed, more recently, it has been

² Views differ on whether a notice of intent to leave the EU could be withdrawn. Some experts say definitely not. It is reported that two English barristers have given advice to the House of Lords in May 2016 that withdrawal of the notice would be possible before expiration of the two year period, and a recent article by Jean-Claude Piris, former director-general of the EU Council’s legal service, also expresses that view.

suggested that the notice might not be given before the end of 2017, both because the French and German positions and negotiators will not be clear before elections in 2017, and because of the work to be done in preparing for Brexit negotiations, and in preparing new UK laws and regulations to replace those of the EU.

The enormous number of tasks associated with leaving the EU, and the lack of preparation and appropriate personnel is only now becoming apparent. Withdrawal from the EU by Greenland, the only country to do that so far, took three years. The differences in complexity from the UK situation are indicated in part by the fact that Greenland's population is 0.1% of the UK's and by the major differences in the economies of those countries.

1. Brexit and the UPC

The UPCA effectively specifies that it must be ratified by the three Member States signing the Agreement that had the highest number of European patents in effect in 2012. The UK was one of those three states. The UPCA also specifies London as the site of a section of the central division. Therefore, without modification of the UPCA, it cannot take effect without ratification by the UK.

Clearly the UK could ratify the UPCA now, because it is still an EU member state. There are, however, several questions:

1. Would the UK government want to join the UPC, an EU-related court required to apply EU law, while withdrawing from the EU?
2. Could the UK negotiate to stay in the UPC after leaving the EU? (A barrister has been asked by several UK IP groups to study the EU treaties and provide an opinion of whether that is possible. That opinion is expected in September 2016).
3. Would the UK ratify the UPC without assurance it could remain in the UPC, so the UPC can begin operation and the EPO can begin granting UPs?
4. Would other states, especially Germany, ratify while the UK's relationship with the EU is in doubt?
5. Would the UK be willing to withdraw from the UPCA, permitting the other Member States to amend or replace the Agreement, and proceed without the UK?
6. Will the UK government be too busy to pay much attention to this subject?

The UPCA and procedural rules provide for a mix of British common law and continental civil law court procedures. If the UK does not ratify the UPC, the UPCA will have to be amended to eliminate the UK ratification requirement and placement of a section of the central division in London. A risk of opening the Agreement to amendment and ratification anew is that could lead to demands for other amendments, probably further delaying creation of the UPC and UP systems, and possibly also changing the current mix of British and continental procedures. Query whether the UPC would be as attractive to U.S. companies following such amendments?

III. THE UNITARY PATENT

The Unitary Patent will be a European Patent granted by the EPO under the EPC's rules and procedures, to which, upon request of the patentee, unitary effect is given for the territory of all Member States participating in the Unitary Patent scheme at the time of the grant; at least 13 states and potentially up to 26 states. The UP will be an option in participating EU states at the time of grant of a European Patent by the EPO, as an alternative to a conventional European Patent-based national patents in participating states or to patents granted by national patent offices.

The two features of a UP that are most significant, from the perspective of this paper, are that the UPC will have exclusive jurisdiction over UP infringement and validity litigation, and that a UP may be enforced in a single UPC litigation with effect in all EU participating states at the time of its grant.

IV. THE UNIFIED PATENT COURT

The UPC will be a single court system with competence (jurisdiction) for infringement and validity litigation involving a conventional European patent or a Unitary Patent. Its competence will be exclusive of national courts for UPs and is intended to eventually be exclusive for conventional nationally validated EPs. During a transitional period of at least seven years, however, both the UPC and national courts will be competent, and conventional EP owners may opt-out of the UPC's competence. Although the owner may opt-in to the UPC again, once (if a national proceeding involving the patent has not commenced), any opt-out in effect at the end of the transitional period apparently will be permanent.

A UPC Preparatory Committee is responsible for all of the arrangements to establish the UPC, including the drafting of Rules of Procedure. (It has had help in that task from advisory committees of judges and attorneys). Pursuant to a Protocol to the UPCA, portions of the UPCA will come into effect immediately after minimum ratification, so that the UPC will have legal existence and be able to complete preparations to open to accept cases about four months later. The Administrative Council of the UPC is expected to then adopt the Rules of Procedure, and hire judges and staff, etc.

Initially, the UPC is intended to have at least thirteen participating EU states, including France, Germany and the UK. Others are expected to join promptly once the minimum ratification occurs. Spain and Croatia have indicated that they are not joining, and Poland appears to be taking a wait-and-see approach.

The UPC will have a number of divisions and sections at the first instance level and a single Court of Appeals in Luxembourg City. Like national courts, the UPC will be required to refer questions of EU law that are not clear to the Court of Justice of the European Union; however, such referrals are likely to be fairly rare, because the patent laws to be applied are almost entirely "national."

The central division of the Court of First Instance will be headquartered in Paris with sections also on London and Munich. The competence of those sections will be divided by

technologies. There also will be local and regional divisions, which will have competence in all technologies. Every Contracting Member State can have one or more local divisions or participate in a regional division. States with less patent litigation activity are likely to establish regional divisions with neighbouring states. For example, a Nordic-Baltic Division is planned, based in Stockholm. States with extensive patent litigation activity may establish more than one local division. For example, Germany plans to have local divisions in Dusseldorf, Hamburg, Mannheim and Munich. (Those cities are already the sites of the most active courts in German patent litigation).

A. Competence of the UPC

The UPC is intended to eventually have exclusive competence (jurisdiction) *inter alia* in respect of:

- actions for actual or threatened infringement of European patents, including Unitary Patents, “conventional” (or “classic”) European patents and supplementary protection certificates (SPCs) based on such patents;
- related defences, including counterclaims concerning licences, as well as revocation actions of conventional European patents and Unitary Patents;
- declaratory actions asserting invalidity of SPCs or noninfringement; and
- actions related to the decisions of the EPO in carrying out its additional tasks concerning the Unitary Patent

The national courts of the Contracting Member States remain competent for actions which do not come within exclusive competence of the Court. During the initial, transitional period of seven years, which may be extended, the UPC and national courts will have parallel competence for conventional European Patents, except when the Patent Owner has opted out of the UPC. In case of an opt-out, the national courts competence will be exclusive of the UPC.

The UPCA specifies in detail the divisions in which proceedings can be brought. Infringement proceedings can be brought in any local or regional division hosted by a Contracting State in which there is infringement or threatened infringement. Also, they can be brought in the local or regional division hosted by a Contracting State in which the defendant is resident or has its principal place of business or, absent that, any place of business. Most importantly with respect to businesses not having a presence in any Contracting State, if the defendant has no residence or place of business in the UPC territory, then infringement proceedings may be brought in the relevant section of the central division. Infringement proceedings also may be brought in the central division if a Contracting State in which infringement takes place, or is threatened, does not host a local or regional division. Therefore, in the case of EU-wide infringement, there will be a wide choice of divisions in which to bring infringement proceedings.

Proceedings for a declaration of non-infringement or revocation (invalidity proceedings) must initially be brought in the central division³. However, if infringement proceedings are commenced in a local division within three months of the initiation of declaration of non-infringement proceedings, the declaration proceedings will be stayed. Also, if infringement proceedings are brought in a local division after revocation proceedings have been brought, the local division will effectively take control and decide whether (1) to hear the invalidity claim itself together with the infringement claim, or (2) to leave the two cases separate (equivalent to bifurcation), or, (3) with the agreement of the parties, to send the infringement claim to the central division to be heard together with the invalidity claim.

B. The “Actors” in the UPC

In the following sections we discuss the “actors,” *i.e.*, the persons participating in UC proceedings in principal roles: judges, professional representatives and experts.

1. UPC Judges

One of the concerns of potential users of the UPC has been about the qualifications and possible national law inclinations of the judges. Those concerns were addressed in the UPCA by providing for multinational panels of judges. There will be both legally and technically qualified judges, appointed for a term of six years, with possibility of re-appointment. At least in the beginning, some of the judges will work in the UPC part-time, for example, working the rest of the time in a national court.

The legally qualified judges shall possess the qualifications required for appointment to judicial offices in a Contracting Member State. The technically qualified judges shall have a university degree and proven expertise in a field of technology. They shall also have proven knowledge of civil law and procedure relevant in patent litigation.

In the local and regional divisions, where infringement actions normally will be filed, the panels will have three legally qualified judges. In the event of a counterclaim for revocation, the UPCA and rules provide several alternatives, with various conditions for each: the local or regional panel can request an additional technically qualified judge be assigned to the case from the pool of judges, it can transfer the revocation counterclaim to the central division, or it can transfer the entire case to the central division. Revocation actions normally would be filed in the central division where the panels comprise two legally qualified judges and one technically qualified judge. The central division also is competent to handle counterclaims for infringement. The normal composition of Court of Appeals panels is three legally qualified judges and two technically qualified judges.

³ Unless infringement proceedings in relation to the patent have already been brought in a local or regional division, in which case under Article 33(4) UPCA declaration of non-infringement and revocation proceedings must be brought (as a counterclaim) in the same local or regional division.

All of the judges will be required to have the highest standards of competence, proven experience in the field of patent litigation or completion of a course at the UPC's judicial training centre, good command of at least one of the official languages of the EPO, and be a National of a Contracting Member State.

The judicial recruitment process is now underway and, by all reports, have attracted a large number of highly qualified candidates.

2. Professional Representatives

Lawyers authorized to practice before a court of a UPC Contracting Member State will be permitted to register and appear as professional representatives. Other persons having a European Patent Litigation Certificate as defined by the Administrative Committee, usually patent attorneys, also can be professional representatives. Patent attorneys not having one of these qualifications may be permitted to participate in proceedings at the discretion of the court, but not as a professional representative.

Rule 287 provides for an Attorney-client privilege for confidential communications (whether written or oral) between client and lawyer or patent attorney as well as the work product of the lawyer or patent attorney. An additional litigation privilege, pursuant to Rule 288, protects from disclosure certain confidential communications by a client, or a lawyer or patent attorney 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.

3. Experts

The UPC rules contemplate the possibilities of both party-experts and court-appointed experts. The provisions for court-appointed experts are set forth in detail in Rules 185-188. We know that party experts should be permitted, at the court's discretion, only because they are mentioned along with other witnesses in the general rules, discussed below.

A 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. A court expert, *inter alia*:

- shall present an expert report in writing within the time period specified by the Court;
- shall give expert advice only on questions which have been put to him;
- shall not communicate with one party without the other party being present or without the consent of the other party;
- shall document all communications with the parties in his report;
- shall not communicate the contents of his report to third parties; and
- shall attend the oral hearing if requested to do so by the Court, and shall answer questions from the Court and the parties.

C. UPC Procedures

The word “procedure” is used in two ways in connection with the UPC. As discussed in the next section, the five major stages of a case are called “procedures.” The word “procedure” also has its conventional, generic meanings of an established or official way of doing something, or a series of actions conducted in a certain order or manner.

1. *Stages of a UPC Case*

The UPCA and Rules provide for several distinct stages in UPC proceedings

- (a) a written procedure;
- (b) an interim procedure, which may include an interim conference;
- (c) an oral procedure on the merits, including an oral hearing in most cases;
- (d) a procedure for the award of damages; and
- (e) a procedure for cost decisions.

Unlike American litigation, in which all of the evidence is usually presented at a single trial over a period of successive days; in the UPC, the file including pleadings and evidence accumulates through the written, interim and oral procedures, forming the basis for the decision on the merits of such issues as validity and infringement. Then, if necessary, there is a separate procedure for the award of damages; and—at the end of every case—a procedure for cost decisions.

2. *Case Management*

The UPCA and Rules provide for strong case management in the interim procedure stage by a member of the judicial panel assigned to the case, called the judge-rapporteur, and in the oral procedure stage by the Presiding Judge. That is necessary in order to achieve the ambitious goal of reaching a decision on the merits within one year, and the subsidiary goals of completing the interim stage within three months of the close of the written procedure and completing the oral hearing in one day, with the possibility of an additional, earlier day for hearing oral evidence.

According to the Rules, 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 patent mediation and arbitration centre (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.

The written procedure corresponds to the pleadings stage in U.S. litigation, in which detailed written statements are required. In the UPC, a patent owner may move to amend the patent in this stage.

Most of the evidence is gathered, submitted and added to the file in the interim procedure stage. Typically, at least one interim conference will be held. Where practicable, it will be held by telephone conference or by video conference. Following the conference, the judge-rapporteur will issue an order setting out the decisions taken.

The interim conference is intended to 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;
- (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.

Whether or not the judge-rapporteur decides to hold an interim conference, he may order the parties to: (a) provide further clarification on specific points; and (b) answer specific questions.

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. The judge-rapporteur shall summon the parties to the oral hearing, giving at least two months' notice, unless the parties agree to a shorter time period.

The oral procedure stage starts immediately after the interim procedure is closed. The presiding judge, in consultation with the judge-rapporteur, takes over the management of the action. The presiding judge may set time limits and oral testimony shall be limited to issues identified by the judge-rapporteur or the presiding judge.

The oral hearing consists of: (a) the hearing of the parties' oral submissions; and (b) the hearing of witnesses and experts under the control of the presiding judge, if ordered during the interim procedure. 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. 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. With the consent of the Court a witness may give evidence in a language other than the language of proceedings.

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

Rules 141-143 provide for a request to lay open books and defenses. Those procedures are likely to play an important role in the damages stage, corresponding somewhat to damages discovery in the United States. Such a request shall contain:

- (a) particulars of the Request;
- (b) certain details of any information ordered by the Court and given by the other;
- (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.

Because the UPC is self-funded and the UPCA provides for awards of the successful party's legal fees, there usually will be a procedure for cost decisions at the end of every UPC case.

3. Evidence

Rules 170 through 172 are the principal rules relating to the types of evidence, obtaining evidence, offering of evidence and duty to produce evidence:

Rule 170 provides:

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

In addition to the general provisions for use of experiments as evidence, Rule 201 specifically provides that 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. Such a Court order for experiments are expressly without prejudice to the possibility for parties or parties' experts to carry out experiments.

Rule 171 provides:

- 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.

The UPC rules 175 through 180 describe specific procedures for offering the testimony of witnesses, including that of experts. A signed, written witness statement or a written summary of the evidence to be given must be filed by the party offering the evidence. It must 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 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. Such an application, typically should 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 172 provides:

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.

The burden of proof in Rule 171 is comparable to the burdens of proof and going forward with evidence in the United States; however, it is not entirely clear from the rules whether the duty to produce evidence in Rule 172 includes a duty of producing evidence that might be harmful to a party. Other rules, however, provide means for a party seeking such harmful evidence to obtain its production or an adverse inference. In particular, Rule 170.2 and .3 empower the judges to require production of evidence.

In addition, UPCA Article 60 and Rules 192 through 198 provide an order to preserve evidence (*saisie*), by seizure if it appears necessary, and orders for inspection, which may be entered during a case or as a provisional measure before a case is filed. Such measures may be sought on an *ex parte* basis if the applicant can justify its reasons for not hearing the defendant.

If granted, an order for preserving evidence may include provisions:

- (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.

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

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.

Rule 199 provides that 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 UPCA.

D. Provisional Measures

Rule 205 provides that “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.”

An Application for provisional measures may be lodged by a party before or after the start of main proceedings on the merits of the case. The court may grant provisional measures either with or without hearing the non-requesting party. If such a party is not to be heard, the rules impose additional requirements on the applicant for provisional measures and on the court. In particular, 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 to disclose any unsuccessful attempt in the past to obtain provisional measures in respect of the patent (or patents).

V. CONCLUSION

The UPCA and the proposed procedural rules provide an interesting mix of British and continental patent litigation practices intended to provide relatively fast adjudication of patent disputes for most of Europe. If not derailed by Brexit, the UPC could finally provide a single court for resolving disputes spanning multiple national jurisdictions in Europe.