

**Comments on the**  
**Draft of a Decision of the Administrative Committee on**  
**Rules on the European Patent Litigation Certificate and Other Appropriate Qualifications**  
**Pursuant to Article 48(2) of the Agreement on a Unified Patent Court**

**Hoffmann Eitle (HE)** is one of Europe’s largest IP-specialized law firms. About 100 patent professionals – European Patent Attorneys (EPAs), Attorneys-at-Law, German, British, Italian, Dutch and Spanish Patent Attorneys currently work at HE, exclusively in the field of intellectual property, mostly patents.

Our clientele includes a multitude of prestigious corporations from all over the world, most of which HE has been advising for years. These corporations have quite diverse expectations of their European representatives, both in prosecution and in litigation. However, as a minimum they require being advised and represented with the highest possible quality and at reasonable cost.

HE welcomes the Preparatory Committee’s consultation on the Preparatory Committee’s draft decision on Rules on the European Patent Litigation Certificate (EPLC) and other appropriate qualifications pursuant to Art 48(2) UPCA and wishes to make some comments that are designed to assist the Preparatory Committee in the finalisation of these Rules.

As a matter of disclosure, since Hoffmann Eitle is a “mixed firm” employing both Patent Attorneys and Attorneys-at-Law, all of which are experienced in patent litigation, HE itself does not expect to suffer any own financial disadvantage from the final form of these Rules. That being said, we nevertheless take an interest in these Rules, since they may affect our clients’ options of choosing the best possible representative(s) for their individual case.

In the experience of our attorneys and patent attorneys (which covers at least the EU Member States DE, GB, IT, ES and NL), patent infringement litigation is presently typically conducted by a team of attorneys-at-law and patent attorneys. This has both legal and practical reasons, and we do not expect this situation to change much with the advent of the UPC. The main reason is that attorneys-at-law are typically (exceptions confirm the rule) not sufficiently versed and educated to understand the often times quite intricate technology of patents, particularly in the strongly litigated fields of

telecommunication, pharma and biotech inventions, so as to represent clients alone in complex patent litigation.

Nevertheless, there are cases where it would be desirable and cost-efficient if only one patent professional was able to represent a party before a court (including the UPC). In some cases, the technology may be straightforward and the main problems of the case are of a legal nature, so that an attorney-at-law would be the best representative. In other cases, there are no substantial legal questions to be discussed and the main issue at dispute is more of a technical nature so that a European and/or national patent attorney can competently handle the case alone and would be the better representative, unless the client opts for a team of a patent attorney and an attorney-at-law.

HE is of the firm opinion that the interests of parties before the UPC are served best if the parties have a choice between an attorney-at-law and a European Patent Attorney or a team of both for their individual case. This is particularly important for small or medium-sized clients. Litigation before the UPC will most likely become expensive enough, at least compared to the existing cost level in Germany. Anything the Administrative Committee can do to keep litigation costs before the UPC to a minimum may be expected to contribute to the success of the UPC. Depriving parties of a reasonable choice will not help.

European Patent Attorneys must have a suitable qualification such as a university degree in science or technology, a three-year training in the European patent profession, under the supervision of an appropriately qualified individual, and then pass a quite difficult exam covering both technical and legal aspects. Likewise, national Patent Attorneys in the countries where HE is active (DE, GB, IT, ES and NL) must undergo a thorough education and pass a patent attorney exam, as required by the individual member state, in which the clear emphasis is placed on legal questions in the patent field. There is no sound reason why at least a Patent Attorney who holds a double qualification as a European Patent Attorney and as a national Patent Attorney (in countries such as at least DE, GB, FR, IT, ES and NL where this title requires the passing of a serious exam where the emphasis is on (patent) law) should not be equally well suited and qualified to represent clients before the UPC as an attorney-at-law.

With that in mind, HE has the following proposals for the Rules on the EPLC and other appropriate qualifications.

## **I. Accredited Courses (Rules 3 to 10)**

1. HE agrees setting up accredited courses by the Administrative Committee for gaining a Litigation Certificate. This will ensure that licenced EPAs will provide high quality representation before the UPC. These will allow clients to choose between a lawyer and a suitably qualified European Patent Attorney or use both as joint representatives.

Accordingly, for EPAs who have no additional national qualification, HE considers the content and the duration of the proposed course to gain a European Patent Litigation Certificate to be appropriate.

## **II. Other Appropriate Qualifications**

If and when European Patent Attorneys hold an additional patent attorney qualification at a national level, HE considers that this should count as “other appropriate qualification”. The Rules should therefore be clarified to ensure that all EPAs who already have suitable national qualifications for representing clients in litigation, either alone or in a team with lawyers, are able to represent clients before the UPC.

HE expects that the national education systems for Patent Attorneys in the future UPC member states will soon be adapted to take account of the UPCA and its Rules of Procedure. In such a case, the UPCA and its RoP will also be part of the subject-matter that trainees for patent attorney will have to learn for passing their national Patent Attorney exams. An additional EPLC for EPAs having a “double qualification” would then appear superfluous.

HE therefore suggests that the Rules should be amended so as to

- (1) consider a national Patent Attorney exam as an “other appropriate qualification pursuant to Article 48(2) UPCA”, if it has been established that the Curriculum set forth in Rule 3 is part of the subject-matter examined (in the future)
- (2) clarify that all current EPAs who have also passed a national Patent Attorney exam, are entitled to represent parties before the UPC, either alone or in a team with another representative (for a transitional period).

- a. Rule 11

1. HE is of the view that Rule 11 in its current version is not sufficiently clear. In particular, we wonder what constitutes “an equivalent state exam in law of a Member State of the EU”. If this expression is meant to include patent attorney examinations such as required in the UK, in Germany, Austria, Italy, France, the Netherlands, Spain, etc. in order to become a national Patent Attorney, then HE would agree with such an understanding but respectfully suggest that this is spelled out more explicitly. HE concurs with the view that these examinations that are specified by a relevant national authority and include an examination of patent law and general law can be considered as “state exams”.
2. If, on the other hand, Rule 11 was meant to be limited to “real law degrees”, it would be much too narrowly drafted. A reduction of “other appropriate qualifications” to a sort of law degree cannot have been intended by Art 48(2) UPCA; in such a case “other appropriate qualifications” would have almost no practical scope of application.
3. A recognition of national qualifications, in addition to the qualification as an EPA, also seems just and equitable in view of Article 48(1) UPCA, which is governed by the principle of subsidiarity with respect to “lawyers”. In this regard, HE is also of the view that a European Patent Attorney with the additional qualification as a national Patent Attorney that entitles her/him to represent clients before at least some of the national courts (such as the Intellectual Enterprise Court in the UK or the Bundespatentgericht in Germany) should fall under Article 48(1) UPCA as “lawyers authorised to practice before a court of a Contracting Member State”. HE would welcome if this could be clearly stated in the Rules.

b. Rule 12

1. HE welcomes the provisions of Rule 12(a) in principle but suggests that it be supplemented by further courses, particularly from other countries that seem to have not yet been considered, such as Italy and the Netherlands.
2. HE, however, notes that nearly all of the courses listed were set up relatively recently. Thus, the list discriminates people who were not able to take those courses because they qualified as examined national patent attorneys before the courses were set up. Older courses, to the extent they existed, such as the German Fischbachau course, should therefore also be included in this list.

3. In many Member States, it is possible to become a national patent attorney, qualified by examination, without having to pass any of the listed courses. Thus, the Rule in its present form discriminates against older attorneys who qualified before the courses were set up. This is both unfair (possibly even an age discrimination contrary to Art 19 TFEU and Directive 2000/78/EC) and rather strange as many of those older attorneys will – due to their experience – be better suited to represent clients before the UPC than younger colleagues who happen to just have passed any of these courses. This discrimination could be avoided by allowing anyone who has passed a national patent attorney exam to represent clients before the UPC (cf. above).
4. The “Grandfather’s Clause” of Rule 12 is particularly unfortunately worded and HE respectfully submits that this part of the Rule must be amended. The current draft version of Rule 12b does not consider EPAs who have extensive litigation experience. The restriction in Rule 12b according to which only representation of a party “without the assistance of a lawyer” counts is absurd and would reduce the scope of this Rule to almost zero. We doubt that this was the intention of the Preparatory Committee.

Due to current national restrictions in most of the Member States EPAs are not entitled to represent parties on their own. Thus, EPAs practicing in a specific Member State (eg Germany, France, UK, etc who are not allowed to represent parties alone in an infringement action) would be discriminated against EPAs practicing in another Member State (eg Sweden). Moreover, even though patent attorneys are currently not allowed to represent parties before an infringement court alone in many EU states, it is a fact that we can confirm from our own experience that actions, replies, submissions, etc. are very often drafted by patent attorneys, at least to a major extent. HE’s patent attorneys also regularly appear before the infringement courts and argue our clients’ cases, together with an attorney-at-law. It would be bizarre if experienced patent attorneys were not admitted for representation before the UPC, particularly since the UPCA – to the benefit of the users - aims to overcome outdated restrictions with regard to representation by qualified attorneys and since the UPC panels will also include at least one technical judge. Thus, in our view the restriction to only consider sole representation in a number of infringement cases contravenes the rationale that underlies Article 48(2) of the Agreement, ie fair and affordable access to justice.

Patent attorneys have traditionally played a major role in patent litigation proceedings in three aspects: (i) as advocates, (ii) as technical judges (on a part-time basis, e.g. in Austria), (iii) as court experts (regularly employed e.g. in Italy). HE considers that each of these activities should be taken into account for the purposes of Rule 12(b).

Accordingly, HE proposes to amended Rule 12 (b) and add the following sub-sections (c) to (e) to **Rule 12:**

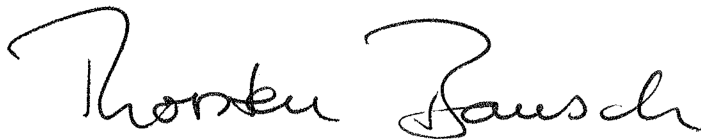
*“or,*

*(b) having represented a party together with other legal practitioners in at least three patent infringement actions, initiated before a national court of a Contracting Member State within the five years preceding the application for registration, or*

*(c) having acted as (technical) judge in at least three patent infringement actions, initiated before a national court of a Contracting Member State within the five years preceding the application for registration, or*

*(d) having acted as an expert appointed by court in at least three patent infringement actions, initiated before a national court of a Contracting Member State within the five years preceding the application for registration.*

25 July 2014

A handwritten signature in black ink that reads "Thorsten Bausch". The signature is written in a cursive, flowing style.

Dr. Thorsten Bausch  
Patentanwalt and European Patent Attorney  
For HOFFMANN EITLE  
EPO Association No. 151