orde van octrooigemachtigden

To the Legal Working Group
of the Preparatory Committee

On behalf of all members of the Orde van Octrooigemachtigden (Netherlands Institute of Patent Attorneys), we wish to thank the members of the Legal Working Group of the Preparatory Committee for their fine efforts that have led to the draft proposal and Memorandum. [1] The undersigned are members of the Board of the Orde van Octrooigemachtigden as well as members of the Board of the Committee of Dutch patent law firms (CVO). By law, each Dutch patent attorney is member of the Orde. Main tasks of the Orde include promoting good professional practice by its members as well as their professionalism.

The members of the Orde very much look forward to the great milestone when the Unitary Patent Package (UPP) enters into force, the package providing important benefits such as uniform protection at affordable costs and a single jurisdiction for patent matters, in Europe.

One of the factors that will affect the success of the UPP is the quality of professional representation before the UPC. Another factor is the availability of sufficient numbers of trained legal representatives on the date the UPP comes into force. Both factors are addressed by the Rules on the European Litigation Certificate and Other Appropriate Qualifications, concerning representation by European Patent Attorneys.

Having read the draft we hereby respectfully ask your attention for the following comments and suggestions.

Part I European Patent Litigation Certificate

Part I of the draft covers the Certificate and particularly the course for obtaining one. What are the skills that a European patent attorney needs, in addition to the qualifications that he/she has already acquired, to successfully litigate before the UPC?

Well, surely he/she should have a certain level of knowledge of law, in particular of general private law, administrative law, procedural law and patent law. Litigation will be an international and European affair so international private law and international execution law should be on the list. UPC litigation will be about patents, still, other IPRs such as copyright, trademarks, designs, know-how could be part of the dispute,

1 for Rules on the European Patent Litigation Certificate and Other Appropriate Qualifications.

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demanding knowledge of respective principles of law. The attorney should know about infringement, about differences in the various national legal systems (common law, continental law, German bifurcation system). He/she should know all relevant national case law as well as the case law of the Court of Justice. The attorney must be able to manage a case from start to finish, including trial. Since, the UPP is a totally new system, the course should cover all UPP related aspects in detail. Focus of course exams should also be directed to UPP matters. Finally, the attorney must be fit to practice: it is not only knowledge that counts but also the ability to make proper use of that knowledge, knowing about the risks of litigation, serving a client on the highest possible professional level.

The list is long: a thorough course appears to be required to train a common European patent attorney to becoming a UPC litigator.

Fortunately, many European patent attorneys have already been educated in various of the topics mentioned, via national patent attorneys courses, and may have gained experience as part of relevant work and assistance in litigation.

We have studied the proposal of the Legal Working Group concerning the rules on the certificate and are very pleased with it. Regarding Rule 3, we entirely agree with the curriculum proposed by the Legal Working Group and the focus on the contents of (f)-(i). You might consider adding further relevant topics, e.g. concerning European Competition Law, European Execution Regulation EC 44/2001 (EC 1215/2012 from 2015) and national procedural law.

The proposed duration of 120 hours is sufficient, bearing in mind that the course needs to be combined with busy working schedules in the relevant field. In our view, a significant part of the time is to be used for the UPP related issues, so that those truly new legal aspects can be spread swiftly amongst the European patent practitioners.

Concerning Rules 2 and 6 we cannot understand why the course should be limited to "*educational bodies of higher education* of a Contracting Member State". In our view it is important that the course is given by an independent body capable of setting-up the course, providing all teaching facilities required, selecting highly qualified law teachers (who may be on the payroll of Universities, or not, think of IP judges and skilled IP litigator lawyers as tutors), ensuring that the required exams can be taken under the supervision of an independent examination board. It will be the Administrative Committee who will decide on the request for accreditation, via Rule 8(1), ensuring that the required high standards will be achieved. Moreover, the requirements of Rule 8(4) and Rule 9 will ensure that the required high standards will be upheld after accreditation has been given.

Besides, in our view, the term "*higher education*" is rather vague.

We therefore request amendment of Rule 6, to read: "Universities and other bodies may offer the Course subject to accreditation by the Administrative Committee". Rule 2 is to be amended accordingly.

Part II Other appropriate qualifications

Part II of the draft concerns the other appropriate qualifications, of Article 48(2) of the UPCA.

On the date the UPP comes into force, a sufficient number of qualified representatives should be available for starting-up the system. They should be 'grandfathered' because there will be no attorneys that have obtained the Litigation Certificate yet.

The answer to the question who is and who is not to be grandfathered is not a straightforward one.

The Legal Working Group of the Preparatory Committee has proposed that European patent attorneys who have a bachelor or master degree in law (without being an advocate) should be allowed to be entered on the list of representatives. This certainly makes sense: the degree in law will provide the EPA with the extra legal skills to handle a case before the UPC. This option is embedded in Rule 11 of the draft. We think this option is a satisfactory *part* of the solution.

Unfortunately however the number of attorneys that would be able to be entered on the list of representatives via Rule 11 in the various states will be relatively low. Besides, the second option does not take into account the alternative ways that EPA's can effectively have 'appropriate qualifications', such as by having followed alternative legal courses or by having gained actual experience in patent litigation.

This is where Rule 12 comes into play.

Rule 12 should allow certain European patent attorneys not having a bachelor or master degree in law to be entered on the list of representatives during a transitional period, to ensure that the UPP can start with the desired number of representatives.

Rule 12(a) is the transitional provision that includes a list of six courses, held in only three countries, deemed as appropriate qualifications for a European Patent Attorney pursuant to art. 48(2) of the UPCA. According to page 5 of your Memorandum, this is an open list. The list may expand, and we think it should. On the other hand, first, the fundamental question should be raised if it is it really necessary to make use of such a list? Putting the list together in a fair way for all nationalities appears to be quite

challenging to say the least. Which course should be on the list and why? Which course should definitely be left out?

As a starting point, the curriculum laid down in Rule 3 appears to provide proper guidance in making the choice, however, none of the courses that are in present Rule 12(a) comply therewith because not a single one includes items f), h) and i).

Rule 12(b) proposes to grandfather European patent attorneys who have represented a party on their own without the assistance of a lawyer before a national court. This appears to be a contradictio in terminis for most jurisdictions: in most national courts European or national patent attorneys are not allowed to represent a party on their own. According to your Memorandum, point (b) would concern practical experience and case management. We think that Rule 12(b) in its present form is rather unfair to all the skilled EPAs who do handle patent litigation, gained wide expedience from practice (the experience providing litigation skills and case management skills that the diplomas of Rule 11 or courses of Rule 12(a) as such cannot offer), but are not admitted to the bar due to national procedural law.

The effect of Rules 12(a) and (b) in their present form will lead to a significant number of European patent attorneys 'being grandfathered' (i.e. being entered on the list of representatives according to Rule 15(2)). However, the selection appears to be arbitrary and unfair. The list of Rule 12 in its present form will mean that at least relatively unexperienced young German, French and English patent attorneys will be in a position to be entered on the list of representatives without having to follow the Litigation Course. Their more experienced elder German, French and English colleagues – who followed more dated national courses – as well as all attorneys from the other jurisdictions are left out. Additionally, many EPAs with a lot of patent litigation experience will not qualify under Rule 12 in its present form.

We regret to say that Rules 12(a) and (b) in their present form appear to provide an unsatisfactory compromise.

In our view, a simple and elegant solution is available, notably grandfathering all European patent attorneys who have also passed any national patent attorneys examination. This is the only way to untie the Rule 12 knot, for all member states. The solution is fair to all. It does not give certain nationalities advantages over others. Age discrimination is prevented. Besides, having passed a national patent attorneys examination actually does mean that the attorney did receive at least a basic level of additional legal training, the training already including most items of Rule 3. It will be clear that anybody (both lawyers and patent attorneys) who wishes to represent a client before the UPC should at least get thoroughly familiar with UPP related items (f), (h) and (i) of Rule 3.

We cannot deny that this solution will lead to a relatively low threshold of grandfathering European patent attorneys compared to requiring (again) all representatives to undergo rigorous training and examination, which by the way is not required for lawyers under Art. 48(1) of the UPC Agreement. Is that a problem? Absolutely not. In 1973 the European Patent Convention first entered into force, and all registered national patent attorneys at the time were allowed to become European professional representative without having to pass the EQE. And of course, all those national attorneys had to become familiar with the EPC, and they did. The present situation is the same, the solution is too.

The Dutch SBO course

In case the Legal Working Group would intend to maintain the list of Rule 12(a), the Orde van Octrooigemachtigden requests that the Dutch national patent attorneys course of Stichting Beroepsopleiding Octrooigemachtigden (SBO) is added to the list of Rule 12(a), for the following reasons.

Firstly and most importantly, the Dutch SBO course covers most of the items of Rule 3. The course runs for a total period of 2 years, including over 200 hours of true contact time and over 400 hours of self study and preparation. Lessons are given by renowned tutors from government, university, industry, private practice (IP firms and law firms). Subjects include a wide range of topics in general law (private law, procedural law, administrative law), patent law, NL law, EU law, and other laws like US, far east (e.g. CN and JP), other IP rights like trade marks, copyrights, European law (like Competition law,SPC law), practical skills such as applying for a patent / defending claims, advising clients, commercialize IP, as well as general skill modules, like communication and pleading, visit court. Each module of the course is finished by a written exam. Enclosed you will find further information concerning the SBO course.

You may also be aware that The Netherlands' Patents Act (Rijksoctrooiwet1995) contains a special provision allowing nationally qualified patent attorneys to plead in court proceedings, albeit under the responsibility of a patent litigator (cf. article 82):

Article 82

Patent attorneys shall be permitted to plead on behalf of the parties in the hearing of disputes referred to in Articles 80 and 81 without prejudice to the responsibility of the counsel.

It is the aim of the SBO course to prepare the patent attorney for every aspect of the job, including, not in the last place, this particular one.

That should be sufficient reason to enter the SBO course on the list.

Secondly, we have compared the courses that are listed in Rule 12(a) with the Dutch SBO course. The results are presented in Annex C. It clearly follows that the SBO course is at least as thorough and challenging as the courses “Diploma of international studies in industrial property” (CEIPI), “Law for Patent Attorneys” (FernUniversität Hagen), “Intellectual Property Postgraduate Certificate” (Bournemouth University), “Intellectual Property Law Postgraduate Certificate” (Brunel University) and “Certificate in Intellectual Property Law” (Queen Mary College).

Therefore and to ensure a level playing field, European Patent Attorneys who have successfully completed the Dutch SBO course should be grandfathered under Rule 12(a).

As a general note we would like to point out that the Netherlands ranks fourth amongst European countries with the highest number of patent related cases in court, after Germany, the UK and France. A relatively large number of Dutch European patent attorneys are actively involved in patent litigation, before the Courts, and e.g. in assisting preservation and seizure of evidence, as well as in opposition (appeal) proceedings. We are confident that our well-trained members ought to be perfectly capable of taking part in all proceedings before the UPC. And of course, our members will have to study the new UPC related law. Again, *doesn’t that count for all?*

In case the Legal Working Group would intend to maintain Rule 12(b), the Orde van Octrooigemachtigden requests that the rule is amended to allow much more European patent attorneys with recent litigation experience to benefit from that rule. In our opinion, true litigation experience in at least one recent legal action should be adequate. The requirement of representing a party “*on his own without the assistance of a lawyer*” is much too stringent and should be deleted. The requirement of “*at least three patent infringement actions*” should also be lifted since proven experience regarding at least one infringement action is sufficient experience. Setting the number to three would be unfair to the EPAs working in jurisdictions with relatively little patent litigation. Besides, the patent attorney carries out a significant part of the job during litigation, including studying both infringement and validity, drafting respective reports and supporting the lawyer (if any) in setting op litigation strategy, assisting in the writing the writ of summons and pleading notes, taking an active role during a trial.

Should you require any information or have questions in this matter, we ask you to contact us immediately.

the Hague, July 18 2014

for the Board of the Netherlands Institute of Patent Attorneys

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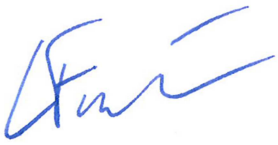

Louw Feenstra

Enclosed:

-Annex A; Power Point presentation regarding SBO course;
-Annex B; program SBO course (in Dutch);
-Annex C; Comparison of Rule 12(a) courses and SBO course.