

June 1, 2023:

# The Unified Patent Court (UPC) opens its doors!

Some observations



Valedictory address of  
Prof. Willem Hoyng

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# I. Introduction

The patent community lives today after many dark years in the sunrise period in which owners of patents have to decide if after June 1<sup>st</sup>, they want to be on the sunny beaches of the UPC or prefer to live another 7 or 14 years in the dark forests of national patent litigation.

For the whole Legal Community and I dare say for the citizens of Europe, June 1<sup>st</sup> will be an important day, and certainly if you cherish the idea as I do of a future United Nations of Europe. Why is that?

On June 1, 2023 the Unified Patent Court (the UPC) will open its doors. It is the first time in Europe that a supranational (I prefer to say federal) court will decide in first instance and on appeal civil law disputes between private parties. Parties do not litigate in a national court with national judges and under a national code of procedure as is the case today in patent matters and even with respect to true European Union rights such as EU Trademarks and Designs. In the UPC they litigate in a truly international court with judges of different nationalities under a completely new tailor-made Code of Civil Procedure of 382 articles, the so-called Rules of Procedure. 17 EU countries have taken the bold step to hand part of their national jurisdiction to the UPC. They cover a territory of more than 270 million European citizens with more than 80% of GDP of the EU. Others have indicated to be willing to join. Only Poland, Croatia and Spain have until now decided not to join but I have good hope that in the future certainly Spain will join. I have sympathy for Spain with respect to the fact that many of their fellow Europeans do not seem to realize the importance of the Spanish language in the world. However, I think and hope that the fact that in a Local Division in Madrid (and in appeal of such cases) Spanish can be used as a language of proceedings and the fact that it is certainly of long-term economic interest for an important country like Spain to participate, will eventually make Spain join.

## II. Some history

It may be good to realize that this major step in the European integration process did not come overnight.

In September 1948, the French Senator Henry Longchambon proposed to the Council of Europe the creation of a European Patent System. His ideas led to the European Patent Project. The original idea was not only to have a central European grant system (as we know nowadays) but also to have a European enforcement system. However, it proved impossible to reach consensus and it was decided to continue only with what has now become the European Patent Office. The result was that, since 1973, it became relatively easy to obtain a patent which is valid in (nowadays) 48 countries, but enforcement in the area covered by the EPC countries requires many parallel national proceedings which, especially for smaller companies, is financially impossible and easily leads to conflicting decisions regarding the same European Patent, despite the fact that on validity and infringement the same provisions of the European Patent Convention are applicable.

New efforts resulted in the Community Patent Convention of 15 December 1975<sup>1</sup>. Although some of our material provisions of domestic law (such as those on indirect infringement) resulted from that Convention, it was never ratified and even a new attempt on December 15, 1989<sup>2</sup> to revive the project ended in failure.

Towards the end of the nineties some member states of the EPC and the EPO took the initiative to come to a central litigation system which was first named the European Patent Litigation Protocol (EPLP). This inspired the French advocate Pierre Veron to assemble 20 European patent litigators in Paris and this meeting resulted in the establishment of the European Patent Lawyers Association (EPLA). A few weeks later the drafters of the EPLP changed the name in the European Patent Litigation Agreement (EPLA). The very new association of European Patent Lawyers Association (EPLA) decided wisely not to start a fight about the name but to change their name in EPLAW.

<sup>1</sup> Convention 76/76/EEC of 15 December 1975 for the European patent for the common market (Community Patent Convention) (OJEU 1976, L17).

<sup>2</sup> Agreement relating to Community patents 89/695/EEC - Done at Luxembourg on 15 December 1989 (OJEU 1989, L 401).

Meanwhile, the European Commission declared that the EPLA initiative is in violation of EU Law. Experienced patent judges supported by EPLAW during one of the first now famous San Servolo meetings in 2005 urged the EPO and the Commission to cooperate and finally this resulted in a Draft Agreement on September 2, 2011 which now, 12 years later, has led to the opening of the UPC<sup>3</sup>.

In the meantime, much work has been done by many volunteers. A small group of judges and litigators spent many weekends in creating completely new Rules of procedure<sup>4</sup>, knowing how different national proceedings are. Establishing a functioning Case Management System is something that the Netherlands, with exception of the Supreme Court, has not been able to achieve even after spending many millions of euros.

However, this certainly does not mean that everything is clear and settled. That would be impossible. If one simply looks at the number of decisions of national supreme courts with respect to only procedural issues and realizing the different national views on the same treaty provisions of material patent law, one realizes that we can expect very interesting times.

I will hereafter discuss a few of the procedural and material points of law which are all likely to arise, but first a word about the UK and the Court of Justice.

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<sup>3</sup> Agreement on a Unified Patent Court of 19 February 2013 Section Regulations (EU) no 1257/2002 and 1260/2012 on the European Patent with unitary effect (see [www.unified-patent-court.org](http://www.unified-patent-court.org))

<sup>4</sup> Final text published on [www.unified-patent-court.org](http://www.unified-patent-court.org)

### III. The UK and the Court of Justice

Of course the patent community regrets the decision of the UK to not only leave the EU but also the UPC after it has been instrumental in establishing the UPC and its Rules of Procedure. Quite frankly, after the Opinion of the European Court of Justice with respect to the UPCA<sup>5</sup>, I do not see a problem with non-EU countries that are members of the European Patent Convention adopting the (present) text of the UPC Agreement since by signing they accept (in the broadest sense) the primacy of EU law.

Anyway, it would be easy to ask the Court of Justice for an opinion based on the present text of the UPC, assuming a non-EU country would be willing to join. However, it is understandable that it is difficult for a country (and especially the UK) to join if it has to accept decisions of a court (the ECJ) about EU law that were reached without its participation. This is all the more true for patent (and more in general IP) law because the Court of Justice in that field does not have a reputation for being very competent. I experienced this myself in the *Primus-Roche*<sup>6</sup> case where the Court ruled that different infringement decisions in different countries relating to the same product and the same European patent were not conflicting (irreconcilable) decisions.

The Court stated that art. 2 of the EPC made clear that such decisions were governed by the different national laws but in order to justify it deliberately cited that article without the last five words (hereafter underlined):

*“The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that state, unless this Convention provides otherwise.”*

I say “deliberately” because this incomplete quote could already be found in the report for the hearing and during the hearing *Primus* explicitly pointed to the incomplete citation!

It is therefore to be applauded that the core clauses (about direct and indirect infringement and the exceptions thereof) have been moved from the Regulation (an EU instrument) to the UPC Agreement (which is not an EU instrument).

<sup>5</sup> Opinion I/09 of 8 March 2011(OJEU C 2011,C/211)

<sup>6</sup> CJEU 13 July 2006. C-539/03, ECLI:EU:C: 2006:458

Both practitioners (in 2011) and experienced IP judges of several countries (in 2012) urged the Commission to do so and the UK simply made it a *conditio sine qua non* for signing the UPCA.

It is hoped that the Court of Justice understands this very clear message, but experience with, for example, copyright law, where it was clearly the intention of the Member States to leave the decision on the standard for obtaining a copyright to the Member States, but the ECJ decided otherwise, does not make me very optimistic about material patent law.

It does not seem impossible for the Court of Justice to make, if it wishes, rulings via *f.i.* art. 28 of TRIPS about infringement questions such as “the doctrine of equivalence”. For example, in that art. 28 what does “making that product” mean if the patent has been granted for a product<sup>7</sup>.

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<sup>7</sup> Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS-agreement) of 15 April 1994, concerning trade-related aspects of intellectual property rights, *Trb* 1995, 130, Annex 1C Marrakesh Agreement Establishing the World Trade Organization; Article 28 TRIPS:

“1. A patent shall confer on its owner the following exclusive rights:

- (a) where the subject matter of a patent is a product, to prevent third parties not having the owner’s consent from the acts of: making, using, offering for sale, selling, or importing (6) for these purposes that product;
  - (b) where the subject matter of a patent is a process, to prevent third parties not having the owner’s consent from the act of using the process, and from the acts of: using, offering for sale, selling, or importing for these purposes at least the product obtained directly by that process.
2. Patent owners shall also have the right to assign, or transfer by succession, the patent and to conclude licensing contracts.”

## IV. Unitary Patents and SPC's

Unitary Patent (which can be obtained if a European patent with the same claims is obtained for all UPC countries) is one patent for the whole territory of the UPC and not a bundle of national patents as the classic European Patent (which also can be litigated in the UPC but in that case also national courts will have jurisdiction). Supplementary Protection Certificates are granted on a national basis. Although the SPC is an EU instrument governed by two Regulations<sup>8</sup>, one for medical and one for plant protection products, the national application of these Regulations sometimes leads to different decisions. With the Unitary patent at the horizon, the European Commission took the initiative to ask stakeholders about their opinion and to ask the Max Planck Institute for a study. However, none of this has as yet led to the possibility of a Unitary SPC.

However, this does not mean that the holder of a Unitary patent would not be able to obtain SPC's. The two Regulations are clear in that respect. They only require a "basic patent" (a patent which protects a product – "an active ingredient or a combination of active ingredients of a medicinal product" – as such etc. ). It is clear that a Unitary Patent is such a patent. This means that the owner can ask in the different UPC states for a SPC. The result will then be a bundle of SPC's with as consequence that the unitary character will be lost and that this results in the same situation as the SPC's for a European Patent. As the basic patent can only be litigated in the UPC, the same in my opinion should also be true for these SPC's, especially because the validity of the basic patent is a condition for a valid SPC<sup>9</sup>.

<sup>8</sup> Regulation (EC) No 469/2009 of the European Parliament and of the Council of 6 May 2009 concerning the supplementary protection certificate for medicinal products (OJEU 2009, L 152); Regulation (EC) No 1610/96 of the European Parliament and of the Council of 23 July 1996 concerning the creation of a supplementary protection certificate for plant protection products (OJEU 1996, L 198).

<sup>9</sup> See also Art. 30 UPCA which clearly points to the fact that SPC's should be handled in the same way as the Unitary Patent for which they are granted:

## V. Technical Judges

During the discussion about the UPCA, especially industry and patent attorney organizations have insisted on the necessity of Technical Judges and the right for patent attorneys to represent clients before the UPC. They did do a good lobbying job and got what they wanted. I have never believed in the necessity and the advantages of Technical Judges. I have also never heard that the decisions in patent cases in countries (such as Scandinavia) which use Technical Judges would be clearly better than in countries which do not use Technical Judges. On the contrary, it is generally accepted that the UK, Dutch and German decisions are of the highest quality. That does not mean that technical expertise is not necessary, but one cannot expect from a Technical Judge that he is an expert /specialist in all areas of his general technical background. In my opinion, it would be much better to have true experts in the field who are selected by the parties and who defend opposing views. If counsel for the parties ensure that judges understand the underlying technology, I believe that the judges can form their opinions and ultimately make the necessary legal decisions. That is not to say that an experienced Legally Qualified Judge who also has a technical background cannot be an advantage and fortunately we have also such Legally Qualified Judges in the UPC. The judges in the Dutch Local Division, for example, both have a technical background.

However, the hereabove mentioned lobby has resulted in the UPC having Technical Judges, albeit on a modest scale. The infringement case with a counterclaim for invalidity will be dealt with by four judges, three who are Legally Qualified and one who is a Technical Qualified Judge. The latter can never be the Presiding judge and if the vote is two against two, the vote of the Presiding judge will be decisive. In the Central Division (which deals with validity and declaration of non-infringement actions) there are two Legally Qualified and one Technical Qualified judge and on appeal the Technical Qualified judges are in the minority (two vs three Legally Qualified Judges).

The lobby to allow also European patent attorneys to represent clients in the UPC has resulted in Art. 48 under 2 UPCA. If they have “appropriate qualifications” such as a so-called European Patent Litigation Certificate, they are entitled to represent a client. Obtaining such a Certificate is not very difficult and personally I have never had a problem with patent attorneys acting as litigators, but like lawyers without solid experience in patent litigation (with a few exceptions), they have not been a success so far.

The Technical Judges are assigned to a Division or the Court of Appeal on a case-by-case basis and are appointed as part-time judges who are remunerated on a case-by-case basis. Unfortunately, this has caused some serious problems with respect to the credibility of the UPC. Although part-time Legal Judges cannot at the same time engage in any other occupation (except for being a national judge), this rule does not apply to part-time Technical Judges. They can exercise other occupations “provided there is no conflict of interest”. I have never understood why the incompatibility rule for the same function, representative in the UPC, is not the same for lawyers and patent attorneys.

Some patent attorneys who were appointed as Technical Judges were of the opinion that acting as representative did not cause a conflict, and even some law firms and Technical Judges themselves started to advertise suggesting that litigants should come to them because they would know how the Court works (and thinks), because they were also a judge in the same Court. This led to a great deal of criticism in literature and on social media saying that such a Court could not be impartial. How can a Technical Judge who or whose firm works for innovators be impartial in a case between innovators and generics? This is of course not to say that such judge would in fact be partial but it is all about perception. Indeed, some smaller countries have Technical Judges in their national system who simultaneously work as patent attorneys. The fact that this has led to (albeit unsuccessful) several cases in Strasbourg about the fundamental right to a fair trial is already enough to see that this creates the wrong perception. So, I was somewhat surprised that Technical Judges clearly thought that while part-time Legal Judges could not do any other work, they could be a Representative of a party in the same court as in which they are a judge.

The Advisory Board which in cooperation with the Presidium has drafted ethical rules has made clear that a Technical Judge cannot carry out UPC work. He can continue drafting patent applications and carry out prosecution work and opposition proceedings and work in his national system. However, he cannot act as a Representative or in any other capacity within the UPC. It may be expected that certain Technical Judges who thought that working in both capacities would be possible, will resign. In a letter to the Advisory and Administrative Committee some of them tried to convince that there was no problem, but failed to face the problem that a judge sitting in Court with colleagues on Monday and arguing

a case for a client in front of those same colleagues on Tuesday can easily be perceived as having a conflict which is detrimental to the UPC’s credibility.

In view of making sure that there will be sufficient Technical Judges the Administrative Committee decided in its meeting of February 8, 2023 to launch a new recruitment round especially among national patent offices, the Bundespatentgericht and retired members of the Boards of Appeal. The policy of not hiring examiners or active members of the Board of Appeal is maintained because it is felt, rightly in my opinion, that the granting authority (the EPO) should remain separated from the authority (UPC) that – in nullity cases – reviews their work.

## VI. The Competence of the UPC

In Art. 32 of the UPCA one finds for which matters the UPC is competent. The article can only be properly understood if one also reads Art. 2 (“Definitions”), Art. 3 (“Scope of Application”) and Art. 83 (“The Transitional Regime”). It all boils down to the fact that the competence of the UPC deviates from what Art. 32 UPCA under 1 suggests and is exclusive only with respect to Unitary Patents (and – in my opinion – for SPC’s based on Unitary Patents) and then only with respect to the actions defined in Art. 32 but f.i. not with respect to the question of entitlement or the patent as an object of property. For the rest the UPC is competent for the same actions as defined in Art. 32 with respect to European Patents which have not lapsed on June 1, 2023 and published European patent applications pending on that day and all the SPC’s issued for such patents and for Unitary Patents. However, that competence is not exclusive as the national courts (during a transitory period of 7 or 14 years) also remain competent.

This all does not seem very problematic, but nevertheless raises several questions. Art. 32 states that the UPC has jurisdiction (among others) for threatened infringement of patents (which as we know from Art. 3 are Unitary or European Patents). This obviously includes “indirect infringement”, but is that restricted to the provisions in the various national Patent Acts relating to indirect infringement or can it also include unlawful acts? For instance, allowing a third party to use a market approval of which the use is an infringement or causing infringement because the accused company assists other companies in other countries with infringement (compare Boston Scientific vs. Cook).

The UPCA itself makes clear that the Court can also act against others than infringers whose actions are (indirectly) damaging the patentee. See f.i. Art. 63 UPCA which states that the Court can act against intermediates which services are used by a third party to infringe the patent.

I therefore think that actions for an actual (or threat of) infringement in Art. 32 should be read in a broad sense encompassing all acts that cause or contribute to infringement.

As already indicated earlier, Art. 32 UPCA shows that the UPC does not have jurisdiction over questions of entitlement to the patent or the patent as an object of property as far as the plaintiff is concerned, unless there is a clear connection with the infringement or validity of the patent, as would be the case, for example,

if the invalidity claim is based on the ground of non-entitlement. However, I believe that as far as the defense against a claim for infringement is concerned, all possible defenses can be raised, such as competition law defenses, license defenses, laches, abuse of right and therefore also the fact that the patentee is no longer the owner of the patent and/or is not entitled to the patent.

### **Applicable law**

It will be clear that these non-patent defenses may involve the application of the national law of the different UPC countries, which may occasionally lead to a different decision for different UPC countries.

These complications will generally only occur with European patents as the applicable law governing Unitary Patents will be the law of the first mentioned applicant on the application which led to the Unitary Patent (see Regulation 1257/2012: Art. 5 under 3 jo. Art. 7). If there is no applicant who has its residence, principal place of business or place of business in an UPC country, German law will be applicable.

This application of one national law with respect to Unitary Patents seems strange if it comes to the typical infringement acts for which the UPC has its own provisions. The UPCA cannot be contrary to EU law and the Regulation with respect to Unitary Patents is EU law. So, while with respect to the scope of protection of European patents the UPC must apply Articles 25-28 of the UPCA with respect to a Unitary Patent, it appears that it must apply the applicable national law. In practice that will not make a difference in most of the cases, but there may be some differences. So is offering a process for using something which we do not find in the Dutch Patent Act, while renting out a patented product is an infringing act under the Dutch Patent Act but not under Art. 25 of the UPCA. However, one wonders if it is really the intention of the Regulation that the UPC court should apply a different law for Unitary Patent than for European Patents. I think that the best way of resolving this is to understand the reference to national law as including the UPCA (which is part of that national law), which means that Articles 25-29 UPCA are also applicable to Unitary Patents.

The complication with European patents lies not so much in what constitutes an infringing act and what does not, because the UPC will have to apply the UPCA (Art. 25-29) and not the various national laws. However, f.i. the rights which flow from a patent application are quite different in the different countries of the UPC. While in certain countries in conformity with Art. 60 EPC the use of the patent application is in principle an infringement in other countries like the Netherlands, it is not and the national rules in order to be entitled to damages or compensation for the use of the invention prior to the grant can be quite different. All practitioners know how many foreign patentees have been disappointed when they heard that in the Netherlands they are not entitled to even a reasonable compensation for the use of their invention prior to its grant even though they wrote timely letters reserving the right for such compensation. They did not know that in order to be entitled to compensation you have to serve a writ by a bailiff. A rather discriminatory provision which only protects the unjustifiable use of the invention by the Dutch local industry. It is about time that we remove this provision from our Patent Act.

## VII. Cross-border jurisdiction

Art. 31 of the UPC makes clear that the international jurisdiction of the UPC is determined by the Brussels Regulation and the Lugano Convention. The Brussels Regulation has been redrafted to accommodate for the UPC (and the Benelux Court).

The fourth “whereas” of Regulation (EU) No. 542/2014<sup>10</sup> which introduced articles 71a-d of the Brussels Regulation reads as follows:

*“The Unified Patent Court and the Benelux Court of Justice should be deemed to be a court within the meaning of Regulation (EU) 2015/2012 in order to ensure legal certainty and predictability for defendants who could be sued in those courts at a location in a Member State other than the one designated by the rules of Regulation (EU) no 2015/2012”.*

Art. 71b under 1 states further that a common court (such as the UPC) shall have jurisdiction where, under the Regulation, the courts of a Member State party to the instrument establishing the common court would have jurisdiction in a matter governed by that instrument.

So, we must find out what are the matters governed by the UPCA. The UPCA itself makes that clear in Art. 3 sub c mentioning “European Patent”. It is not restricted to European Patents granted for the territory of the UPC. In other words, the UPC can also deal with European Patents granted for countries outside the UPC territory if the courts of a Member State have jurisdiction with respect to such patents. This should mean that the UPC (based on Art. 4 Brussels Regulation) would for instance have jurisdiction against a company established in the UPC territory with respect to infringement of European Patents outside the UPC Territory and more specifically the Local (or Regional) Division of the country where the infringer is established and if there is no such Local (or Regional Division) Central Division<sup>11</sup>.

<sup>10</sup> (EU) No 542/2014 of the European Parliament and of the Council of 15 May 2014 amending Regulation (EU) No 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice (OJEU 2014, L 163).

<sup>11</sup> Apart from the UPC, the national court of the country of residence of the alleged infringer would also have jurisdiction based on Art. 4 Brussels Regulation.

Following the caselaw of the Court of Justice in *Solvay vs. Honeywell* this would mean that the UPC court would also have jurisdiction against codefendants located outside the UPC area if the principal defendant infringes the same patent with the same product as these codefendants. If the codefendant is established in an EU country this follows directly from Art. 8 under 1, and if located outside the EU, from Art. 71b under 2 jo. Art. 8 under 1.

I believe that the stricter rule with respect to codefendants of Art. 33 under 1 sub b UPCA would only be applicable with respect to defendants located within the UPC territory and that Art. 8 under 1 of the Brussels Regulation applies to codefendants located outside that territory which means that the UPC Court would be competent against such defendants even if there is no commercial link as long as the conditions of Art. 8 under 1 are fulfilled. I have come to this conclusion as the international jurisdiction according to Art. 31 UPCA is determined by the Brussels (and Lugano) Convention. However, if the UPC for UPC matters must be seen as one territory, as I believe, the jurisdiction with respect to codefendants located within the territory of the UPC seems a local matter governed by Art. 33 lid 1 sub b UPCA.

It will be clear that just like a national EU court the UPC cannot give a (final) judgment with respect to the validity of the EP for f.i. Spain or Turkey but if the patentee would ask in the same case for a provisional injunction, I do not see why such injunction would not be granted if f.i. the EP patent has already been found valid for the UPC. The UPC Agreement gives that possibility (Art. 62) and the Rules of Procedure do not seem to prevent this.

It is true that the Rules of Procedure as such do not provide expressly for a (conditional) application for provisional measures together with the statement of claim in main proceedings. Rule 206 considers provisional measures before or after main proceedings but for all practical purposes I think that the Rules do not prevent the filing in one document both for main proceedings and (conditionally) for provisional measures. In general, it seems prudent to ask for provisional measures (conditionally) in main proceedings for the situation in which the court cannot immediately give a final judgment after the oral procedure because on the one hand, it deems further evidence necessary, but on the other hand,

the conditions for provisional measures are fulfilled<sup>12</sup> but even if one were to consider (too formalistically!) that the application for provisional measures should be made by a separate application, one could ask the Court to hear both cases together. Finally, it would always be possible to ask for such provisional measures after the main proceedings f.i. after the Court would have suspended the main proceedings with respect to other than UPC countries because it cannot rule about the validity. However, that would result in a loss of time and would be very unpractical as the whole proceedings have to be repeated while in the main proceedings the Court has already dealt with the infringement and invalidity of the patent. However, the latter could be avoided by asking the Court to grant an *ex parte* preliminary injunction as infringement and validity (for the UPC countries) has already been established.

It is clear that if you accept that the UPC court has also jurisdiction with respect to European Patents granted for non UPC countries as defended hereabove, it means that a third party can also ask the UPC to give a declaration of non-infringement with respect to a European patent which is (also) granted for non UPC countries owned by a patentee who is established in a UPC territory. The UPCA determines that the Central Division within the UPC shall be the competent Division of the Court for such actions and also determines that the patentee can start infringement proceedings within three months before a Local or Regional Division that has jurisdiction under Art. 33 UPCA. So, it seems applying this *mutatis mutandis* with respect to a non UPC European Patent this means that if the patentee starts infringement proceedings in the countries for which the non UPC European patents are granted, the Central Division will have to suspend the case which therefore would make it impossible to obtain such cross-border declaration of non-infringement. This is basically in line with the (patentee friendly) UPC: a third party cannot determine where the infringement question is determined. However, if a third party would file such a cross-border case in the Central Division and therefore seeks the UPC court to determine the infringement question for non UPC countries, the patentee may decide to file a cross complaint for infringement (art. 8 under 3 Brussels Regulation). Alternatively, if the demand for a declaration of non-infringement would include UPC countries, the infringement case may also be submitted to the Local or

<sup>12</sup> This seems also to be the best solution in case of bifurcation and the decision of the court to continue with the infringement case. The Court can give a provisional injunction in case of infringement and a final decision after the invalidity case has been resolved in the Central Division.

Regional Division with respect to the infringement in non-UPC countries, competent to hear the infringement of the UPC patents arguing that by filing its declaration for non-infringement case in the Central Division, the third party has consented to the jurisdiction of the UPC. It should be noted that if the third party would not at all infringe, I do not think that a successful action for infringement could be started because of lack of interest<sup>13</sup>. In that case, it seems difficult for the patentee to avoid a decision of the Central Division of the UPC.

With respect to provisional measures, it seems (also) very clear that the UPC can grant cross border injunctions. This follows from Art. 7b under 2. It reads, as we have seen, as follows “Application may be made to a common court for provisional including protective measures even if the court of a third State has jurisdiction as to the substance of the matter”. The caselaw of the Court of Justice (see f.i. *Solvay vs Honeywell*)<sup>14</sup> requires a close connection to the Court which grants such measures but accepts that the court also gives a provisional view on validity. This means that if an infringer is located in the territory of the UPC or the Division of his residence (the close connection) (which as we have seen may in cases, where the country of his residence does not have a Local Division, is the Central Division) can grant preliminary injunctions for the UPC and other countries for which the EP is granted. As stated above, *Solvey vs Honeywell* means that also codefendants can be sued which infringe the same patent in the same territory assuming the conditions of Art. 33 sub b UPCA (for a UPC territory codefendant) or Art. 8 under 1 Brussels Regulation (for other defendants<sup>15</sup>) are fulfilled.

Art. 71b under 3 of the Brussels Regulation also gives a special jurisdiction over a defendant who is not domiciled in the EU in specific situations. It reads as follows:

*“Where a common court has jurisdiction over a defendant under point 2 in a dispute relating to infringement of a European Patent giving rise to damage within the Union, that court may also exercise jurisdiction in relation to damages arising outside the Union from such infringement. Such jurisdiction may only*

<sup>13</sup> This would of course have to be decided by the non UPC country in which the patentee would file an infringement action in order to try to avoid a decision of the Central Division

<sup>14</sup> CJEU 12 July 2012, C-616/10, ECLI:EU:C:2012:445 (*Solvay/Honeywell*), par 34 & 49.

<sup>15</sup> for defendants residing in a Lugano country (Iceland, Norway or Switzerland) this would be on the basis of Art.6 under 1 of the Lugano Convention.

*be established if property belonging to the defendant is located in any Member State party to the instrument establishing the common court and the dispute has sufficient connection with any such Member State.”*

The article relates to defendants for which under the normal rules of the Brussels Convention no jurisdiction can be found but for which jurisdiction exists because of Art. 71b under 2 which states that with respect to such defendants one can also apply Chapter 2 of the Brussels Regulation. We have already seen that Art. 71 under 2 means that such non-EU defendant can be sued in the UPC for infringements outside the UPC based on Art. 8 under 1. However, this article gives an extra possibility in case the conditions of the article are fulfilled<sup>16</sup>.

Again, as already stated above under the Brussels Regulation, normally the question of jurisdiction with respect to a non-EU defendant would be decided according to the national law of the court where the case is brought. In the Netherlands, a non-EU defendant can only be sued for infringement outside the Netherlands as a codefendant or if he has assets in the Netherlands. The fact that one can obtain a conservatory seizure of certain assets of such non-EU defendant as security for damages caused by infringement by this non-EU defendant elsewhere would as such not give jurisdiction with respect to that infringement except in the situation in which Art. 767 Code of (Dutch) Civil Procedure<sup>17</sup> is applicable which is the case if no decision can be obtained abroad that can be executed in the Netherlands.

The special provision of the UPC in Art. 71b (3) seems in many aspects even more limited in application because there must be damage (say: infringement) in the EU and the UPC must have jurisdiction which in general will only be the case if there is infringement in the UPC territory. If that is the case then the UPC court may also exercise jurisdiction with respect to damages caused by infringement

<sup>16</sup> The question arises what happens as to defendants having their residence in a Lugano country. It seems to follow from Art. 64(2) of the Lugano Convention that it would be contrary to the Lugano Convention for the UPC to accept jurisdiction on this basis as there is no basis for such jurisdiction in the Lugano Convention.

<sup>17</sup> Article 767 Code of Dutch Civil Procedure: “In the absence of a different way of obtaining an enforceable order in the Netherlands, the claim in the principal action – including the claim in respects of the costs of attachment – may be instituted before the District Court of which the interim relief judge has granted leave for the attachment that has been levied or that has been avoided or lifted in consideration of the provision of security. In the case of leave for garnishment, this applies only if the property to be attached is explicitly described in the petition.”

outside the EU but only if there are assets of the infringer in a Member State of the UPC and there is sufficient connection with that Member State (meaning for instance that also in that State there is infringement?). The article is not applicable with respect to defendants in EU Member States which are not a member of the UPC as that would conflict with the Brussels Regulation. Such infringer should in principle be sued in his country of residence. However, as seen above, such EU defendant from outside the UPC (like a non-EU defendant) can under certain circumstances be sued as codefendant in the UPC Court. For instance, if a company established in a UPC country exports to Spain. He can together with his Spanish distributor be sued in the UPC for the infringements in Spain.

A final remark about the reverse side of all this. First of all, the possibilities of the courts in EU countries which have not (yet) joined the UPC Agreement. These are the same as presently existing. In practice it depends on the local procedural rules (and the way they are applied by the court) whether these rules provide the possibility of provisional measures/preliminary injunctions in cross border cases like nowadays in the Dutch courts. In other words, in principle a Spanish court could grant a preliminary injunction against a Spanish company not to infringe an EP patent for all the countries where this patent is in force (including the UPC countries) and if the same national EP patent is infringed with the same products by other EU entities, the preliminary injunction could in the same proceedings also be pronounced against such companies if the conditions of Art. 8 under 1 of the Brussels Regulation are fulfilled.

This is the same for a Unitary Patent. If a Unitary Patent is infringed by a Spanish company, the Spanish Court can also pronounce provisional measures, but as with non-Spanish European Patents, it can only deal with validity on a provisional basis since validity is the sole competence of the (Central Division of the) UPC.

As to countries outside the EU (and the Lugano countries) such as the UK, it will be the national law of the UK that decides the jurisdiction with respect to foreign patents. Does the UK law give jurisdiction to the UK courts f.i. with respect to

the infringement by a UK company of EU/Unitary Patents outside the UK<sup>18</sup>? Can a company obtain an antisuit injunction from a UK court against a patentee that seeks an injunction in the UPC for a UK European Patent<sup>19</sup>? The same, of course, may be true the other way around when the UK court threatens to deal with f.i. a cross border declaration of non-infringement of a UP or EP. Apart from the question what the value of such decision is if not accompanied with an injunction not to enforce such patents, the question arises if the UPC would be willing to grant an antisuit injunction.

The ECJ has decided that EU court who has jurisdiction on the basis of the Brussels Regulation or Lugano Convention cannot refuse jurisdiction on the basis of the forum non conveniens doctrine and another EU court cannot issue an antisuit injunction to proceed with a case in another EU court which has jurisdiction on the basis of the Brussels Regulation or Lugano Convention, but in my opinion that does not exclude an EU court (such as the UPC) to grant such an injunction with respect to a non-EU court.

In conclusion it may be expected that in the coming years interesting cases with respect to jurisdictional questions will arise.

<sup>18</sup> Under the Brussels Regulation the UK Courts held that if invalidity was raised as a defense, they had no jurisdiction (Coins Control)

<sup>19</sup> In March 2022 the UK court granted an ex-parte anti-antisuit injunction against Boston Scientific until the hearing of a request for an antisuit injunction by Cook for forbidding Boston Scientific to ask for an injunction under the UK EP against Cook UK in the court of the Hague in the Netherlands. After the grant of the anti-antisuit injunction Boston Scientific decided not to pursue the case in the Netherlands based on the UK patent.

## VIII. The Rules of Procedure (general)

If one sees how many decisions there have been of the Supreme Court in countries which have a Code of Civil Proceedings with respect to the interpretation of the different articles of such Codes it is clear that we are at the start of a body of procedural law to be established by the Court of Appeal of the UPC (and in some instances the ECJ).

In many places the Rules give much discretion to the court and/or the reporting judge. It will also be clear that judges of so many different backgrounds may have very different views about how to use discretion and/or fill in the gaps. It is hoped that with training sessions the UPC judges have been convinced to forget about the national customs and try to look at the Rules of Procedure with fresh eyes and not try to read their own national rules into them as much as possible.

The Rules themselves give some guidance in the Preamble. “The Rules should be applied on the basis of principles of proportionality, flexibility, fairness and equity”. It is all about efficiency, cost effectiveness and the highest quality. These are of course principles that should apply to all civil proceedings. However, in patent law there is one specific important aspect. The value of patents lies in the fact that they grant exclusive rights for a limited period of time which only have meaning if they can be guaranteed. If it (like in many European jurisdictions still is the case) takes years to enforce a patent, the value of a patent diminishes and at the same time the goal of the patent system to stimulate innovation is endangered.

This is clearly recognized in the Rules. The Preamble states that in principle the oral hearing should take place within a year while Rule 118 sub 6 makes it clear that parties should have a judgment as soon as possible after the hearing and at least within six weeks after the hearing. So, a UPC judge should in using his discretion and in interpreting the Rules always keep this in mind. The success of the UPC will clearly depend on achieving this goal and the Rules on timing and discretion are written with that overriding goal in mind. The role of the reporting judge is in that respect crucial. He can and has to make sure that high-quality decisions are delivered in about 12 to 14 months, which is possible in view of the front-loaded system and the time limits for the exchange of written pleadings.

## IX. The opt out (Rule 5 and 5A)

At the moment (April 2023) we live in the period in which patentees who do not want their patents litigated in the UPC will have to opt out their patent. Certainly, after the change of Rule 5, which lists the requirements for an opt out, an opt out is a delicate action, because all the owners of the European patent that one wants to opt have to opt out also the owners of the European patent for non UPC countries. So, in theory 38 owners of the European patent. To make it even more complicated, the fact that being registered as the owner does not mean that this is the rightful owner.

Prior to the change of Rule 5 the opt-out was only required with respect to European patents granted for UPC countries. However, the Rule was changed when it was realized that in certain situations the UPC had competence over European patents granted to non UPC countries.

The question is why a patent owner would want to opt out its European patents from a system that is created to make enforcement of a patent more efficient. It seems to be a reaction of a typical conservative lawyer (who does not like changes) rather than a well-reasoned decision. The arguments one hears is that the quality of the Court remains to be seen and that a patent in the system means that all the eggs are in one basket while it is unknown how strict the Court will be with respect to inventive step.

Quite frankly I cannot understand these arguments. I must say that after the selection of the judges was published, the fear about the quality of the Court has clearly been diminished and was a reason for certain companies to change their mind and to not opt out.

However, even before the selection of judges, quality safeguards had been built into the system by the international composition of panels which should guarantee that also in Local Divisions with less patent litigation experienced judges will handle a case and let us not forget it is the patentee who, in most cases, has the possibility of starting a case in an experienced Local Division of his choice.

As to the selection of the judges the Agreement and Statute built in certain guarantees that this would not be a political game by making sure that the Administrative Committee (which consists of representatives of the different

participating countries) can only appoint judges which have been proposed by the Advisory Committee. Although also that Committee has representatives of the different participating countries, they need to be patent judges or practitioners in patent law with the highest recognized competence and the members “shall be completely independent in the performance of their duties and shall not be bound by any instructions”. (Art. 14 of the Agreement)

My experience as Chairman of the Committee is that indeed most members clearly meet the criteria and often have been or are distinguished patent judges in their own jurisdiction. The selection process of the judges is a rigorous process and except for the Italian representative (who until now seems to see it as his task to promote the appointment of Italian judges) all Advice rendered to the Administrative Committee have been unanimous and have been adopted by the Administrative Committee. It is generally recognized that this resulted in a Court of Appeal with two sections of the highest quality.

Apart from the fact that the patentee very often has a choice of where to file his infringement action and even in most situations can prevent the Central Division from hearing the invalidity action brought by a third party by moving the case to his favorite Local Division, there is a final safety valve if in First Instance something goes very wrong, such as an injunction that should clearly not have been issued. The standing judge of the Court of Appeal (which can be reached by the CMS system 24/24) can suspend such injunction with immediate effect (Rule 223 under 4).

I believe that the all the eggs in one basket argument does not carry much weight. First of all, in practice, already in most cases decisions with respect to the same patents are the same in different countries. Moreover, since the UPC will have to apply an interpretation of the EPC that is acceptable to all UPC countries, it seems unlikely that they will be stricter than the EPO Boards of Appeal with respect to validity, regardless of whether they apply the PSA as the Dutch courts do. I am not a fan of the PSA because in my opinion the choice of the closest prior art is sometimes arbitrary and tainted with hindsight and it excludes other prior art which may shed a different light on the inventive effort. I accept that in the EPO for examiners who have to deal with thousands of cases this is a good tool but, in a court, where there is more time for reflection, a more holistic/realistic approach seems better.

Sometimes one hears: we will opt out and see how the UPC develops, and if we think it is positive, we will opt in. However, this is a dangerous strategy because it is very easy for a competitor or generic brand that wants to make an efficient enforcement using the UPC impossible to prevent such an opt in by simply filing a case (nullity and/or declaration of non-infringement) in a national court with slow proceedings or withdrawing the case after filing it. That will make it impossible for the patentee to opt in.

So, in my view there seems no good reason to opt out other than having a patent of which one knows that it is in all likelihood invalid. In such a situation it may be attractive to stay out of the UPC and make the life of a competitor, who has to fight the patent in all different courts, more difficult. It goes (far) too far to say that opting out is a sign of anti-competitive behavior as it is completely legitimate and some cold water fear may be understandable, but opting out is certainly not born out of the wish to enforce one’s patent in an efficient cost effective way. So if you have opted out, you can still change your mind and opt in again quickly!

There is no specific rule which states that a third party can challenge an opt out as Rule 5A gives that right only to the proprietor. However, a third party can simply start litigation (f.i. a nullity action) in the UPC, and if confronted with a preliminary objection (PO) that the patent (or SPC) has been opted out, he contests the PO with the argument that the opt out is not valid (f.i. because there was no consent of all the patent holders).

The opt out provision of art. 5 states that one also can opt out expired patents. I was asked the question if that means that after June 1 you can ask in the UPC for damages with respect to infringement of a European Patent which has expired before June 1 (the day the UPC will open its doors). That is not the case, as article 3 of the UPCA states that the UPCA is not applicable for patents which have “lapsed” on the date of entry into force of the UPCA (June 1, 2023). In other words an opt out is only possible with respect to “expired” patents which were in force on the date of entry.

The somewhat confusing different use of words “lapsed” vs “expired” does not change this. They have the same meaning.

## X. Preliminary Objection and Torpedos

It is clear that often if one of the parties wants a quick decision, it is not always in the interest of the other party. When we started many years ago with the accelerated proceedings in the Netherlands, we immediately were confronted with attempts to hinder it, but the court dealt with these attempts successfully!

It is not different under the UPC. Rule 19 allows the defendant to lodge a provisional objection within a month after the service of the Statement of Claim about the jurisdiction and competence of the court including the fact that an opt out applies, or about the competence of the Division, or about the language used by the claimant.

This does, however, not stop the clock running and the defendant has to file his answer in three months except if the judge-rapporteur decides otherwise. One hopes and expects that the judge-rapporteur will make such a decision only in very exceptional cases, for example, in a situation where it is very clear that the court does not have jurisdiction.

The normal reaction of the judge-rapporteur should be to simply have the objection dealt with together with the main case as we do in the Netherlands (Rule 20 under 2).

Torpedos?

The fact that non opted out European patents can be litigated both in a national court and the UPC has given rise to so-called torpedo arguments.

Basically a torpedo is the name for an action which would frustrate the timely enforcement of the EP.

In my opinion torpedos should not work and will not work. An example.

The filing of a declaratory non infringement action in a national court by a third party does not prevent the patentee to file an infringement action in the UPC against the same third party. The UPC can deal with the infringement in all other UPC countries in a case on the merit and can pronounce a provisional measure in the same case with respect to the country where the torpedo was filed in case the case in the national court is still pending.

This is the result of art 71c under 2 of the Brussels Regulation which refers to art. 29-32 for this type of cases.

Article 34 of the UPCA should be read as that decisions of the UPC should at least cover the territory of all the Contracting member States for which the UPC has jurisdiction. I said “at least” as as we have seen the UPC has also in certain cases cross border jurisdiction.

All other scenario's should be resolved in the same way bearing in mind that art. 29-32 of the Brussels Regulation never prevent a court from issuing provisional measures.

The only thing UPC judges should not do is staying proceedings on the basis of article 30 because actions are related!

## XI. The Oral Hearing

As to oral argument the Rules state that the oral hearing should in principle be dealt with in one day which would include the possibility to hear and cross examine experts and/or witnesses. On German insistence the Rules also mention the possibility for the Presiding judge (or one of the other judges) to give an introduction of the case, which in most jurisdictions is quite unusual. I do not see a problem with that, on the contrary, it is helpful for the debate if in this presentation the judge indicates which specific issues or questions the Court would like to be addressed. However, if it becomes clear from the introduction how the court will decide (as I have seen happening in Germany) then such “introduction” would clearly go too far.

The Rules do not state how such oral hearing should be conducted. It seems to me that if one does not want the oral argument lasting more than one day, it would be best to introduce time limits. Parties have already had two rounds of written pleadings and therefore time limits do not seem to be a problem. As witnesses and experts will have already filed their written reports, the best way of conducting the oral hearing would be to start with the oral argument giving both parties a maximum of 60 minutes, and if both infringement and invalidity is an issue, then 75 minutes. Thereafter witnesses and experts can be heard which will not be more than a confirmation of their written statement and questions by the Court, if any, and cross examination by the representatives of the parties. The Rules clearly state that this happens under the control of the Presiding judge and that only relevant questions will be allowed. Thereafter both parties should get 15-20 minutes to react (only) to each other’s oral argument and to the (new) statements of witnesses and experts.

## XII. The Order to preserve evidence (Saisie Contrefaçon)

This “preserving evidence” and “inspect premises” measure which the Enforcement Directive (Art. 6, 7)<sup>20</sup> introduced in EU law can be found in Art. 60 of the UPC and in Rules 170 under 3 sub b and 192-198. These rules are very general and leave quite some room for interpretation. Although now all UPC states, thanks to the Directive, know the possibility of the seizure the practice is very different in the different countries. In France no lawyer would dare to start infringement proceedings without a saisie, but in Germany the saisie seems de facto almost a dead letter. It is clear that it would be undesirable if the Local Divisions would continue their previous national practice in the same Court (it is good to realize that a Local Division is in fact nothing else than a chamber of the same Unified Patent Court).

I believe that over the years we in the Netherlands have developed a practice that seems quite satisfactory and actually lies somewhat between French and German practice. First of all, I think it is good to realize that an evidentiary seizure is quite invasive. Because (certainly in France) it is such a routine measure I sometimes wonder if the professionals (judges, litigators, patent attorneys) realize what it means for a small company when at 9 a.m. a bailiff, a patent attorney and an IT specialist show up with a court order to carry out a saisie. I have even seen panic in large companies especially with saisies during vacation time and nowadays with 30 days vacation and many people (at least in the Netherlands) working three or four days (and stating in their emails on which day they are off) it is quite easy to pick a day and time at which the general counsel or the local lawyer of the subsidiary of the foreign multinational is not present!

So, I think as a first rule the Court should only allow a seizure if the request at least contains sufficient information to make a prima facie case of a (valid) patent and infringement. See in that respect Art. 7 of the Enforcement Directive<sup>21</sup>. Of course, in this respect the content of the protective letter (if filed – see Rule 207 –) can be important. Furthermore, the seizure should be necessary for proving infringement. If a product is freely available on the market and can be analyzed rather easily there is no such necessity. Therefore, I think especially for the

<sup>20</sup> Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights (OJEU 2004, L 157).

<sup>21</sup> “A party which has presented reasonable available evidence to support his claims”  
art 60 UPC: “A party who has presented reasonably available evidence to support the claim”  
(of infringement)

French practice this would mean a drastic change as the normal way of starting patent litigation would certainly not be a seizure. I realize that the Rule 192 does not mention the requirement of a prima facie case but art. 60 UPC is clear. Moreover Rule 190 makes implicitly clear that a saisie should only be granted if a party has presented reasonably available and plausible evidence in support of its claims (Note the addition of “plausible”).

Of course it is important for the Court to determine what exactly can be seized but that is not always easy because the request will be normally an ex parte request. However, not much can go wrong if no information is handed to the claimant before there has been a hearing of the parties about what and under which conditions (in order to preserve f.i. confidentiality) must be released to the applicant (that what is really relevant and necessary to enable the plaintiff to make his case). So I think this should be standard in the Rule 196 order.

I think that after the seizure it is up to the claimant to start proceedings under Rule 190 with the request of the release of all or certain samples, documents, descriptions etc. It is clear that the person who is carrying out the seizure (in France and many other countries the bailiff) has to make an inventory after the seizure of what is seized (See Rule 196 under 4 “a written Report”) which then forms the basis for the decision what should or should not be relevant and what can be released under which conditions.

In this respect two more questions arise:

1. Can such seizure be allowed for foreign proceedings (including proceedings during the transitory phase in national courts). The applicant should ask for this (Rule 196 under 2) but in general I see no reason to refuse this.
2. Should the Court accept evidence obtained through seizures carried out in national or foreign jurisdictions. I do not see a problem with that as long as the evidence is obtained in a legal way. I accept that this may sometimes lead to situations in which the Court may refuse a seizure or release of information while thereafter the seizure is allowed in a national jurisdiction, but if that is allowed in that national jurisdiction and evidence is therefore obtained in a legal way, I cannot see a good reason why that evidence could not be used. That has also been the decision of the Dutch Court with

evidence obtained in the US based on Section 1782 of Title 28 of the United States Code.

## XIII. PI Proceedings

As also recognized by the Court of Justice in its interpretation of Art. 9 of the Enforcement Directive the preliminary injunction plays an important role in preserving exclusive rights<sup>22</sup>. The Rules deal with this in Rules 206-213 and are based on Art. 62 (Provisional and protective measures) of the Agreement.

In a discussion with the future judges in January 2023 in Budapest there seemed to be consensus about the urgency requirement (Rule 211 under 4). One should in general<sup>23</sup> file a request within two or three months after having become aware of the infringement!

With respect to the requirement (Rule 211 under 2) that there should be a sufficient degree of certainty that the patent is valid and infringed, the general opinion was that the criterion should be that it should be more likely than not that in the case on the merit the court will hold that the patent is valid and infringed.

There is also a balance of convenience test in the UPCA and Rules, but the general view was that if the patent is infringed, the normal rule also in PI proceedings will be an injunction. Only in exceptional circumstances the court should refuse an injunction. This is in accordance with Art. 3 of the Enforcement Directive which calls for proportionality but at the same time for effective and dissuasive measures. The Drafting Committee of the Rules has been very heavily lobbied to include Rules reflecting the Ebay decision of the US Supreme Court but has refused to do so because this was not considered in line with the Enforcement Directive.

In conclusion, compared to the Dutch Kort Geding with the exception of the urgency requirement, there does not seem to be much difference for obtaining a PI in the UPC: Only in exceptional circumstances an injunction will be refused based on a balance of convenience test. One can think about circumstances in which a group patients would be deprived of their medication, or infringement of a small part of a much larger and expensive entity. In such cases, tailor-made injunctions can be sufficient to address the justified interests of patentees on the one hand and third parties (such as patients) on the other hand.

<sup>22</sup> See f.i. re Bayer case C-688/17 d.d.12 September 2019 ECLI:eu:C:2019:722

<sup>23</sup> In general: it is clear that if f.i. testing or experiments would be necessary to establish infringement this period can be longer. Rule 211 under 4 states only that there should not be an unreasonable delay.

## XIV. Prior user rights (art. 28 UPC), compulsory licenses and territoriality

It is not surprising that when the UPC deals with a bundle patent and the defendant according to the national law is entitled to a prior user right in a certain UPC country, that this right for that country is respected but does not extend to the other countries and that products put on the market by the prior user cannot flow under the doctrine of exhaustion to other UPC (and EU) countries. There is no provision in the UPC with respect to compulsory licenses, but with respect to bundle patents it seems clear to me that compulsory licenses can be granted and that the same will apply. In other words, the compulsory licensee can use the invention in the country for which the compulsory license has been granted but the products cannot flow to other EU countries because of the fact that there is no consent of the patentee, there is no exhaustion<sup>24</sup>. Basically, in one proceeding the UPC deals with the different countries for which the EP is granted. In all these countries the EP has the status of a national patent. The UPC should therefore consider the different legal situations in all these countries, such as the fact that the EP may have a different claim set in the different countries or that in one or more of these countries a compulsory license is granted. However, with respect to the question of infringement and validity the same law (the EPC) is applicable and the same is true with respect to infringing acts because these are for all countries the same as they are governed by Art. 25-Art. 29 UPCA.

With respect to a Unitary Patent for which the Regulation states that “the scope of that right and its limitations shall be uniform in all participating Member States in which the patent has Unitary effect” (Art. 5 of the Regulation) this seems different. It is therefore somewhat surprising that also with respect to Unitary Patent prior user rights have only national effect contrary to what Art. 5 of the Regulation suggests. As the UPCA must be in conformity with EU law the question can be raised if, when a prior user right exists in one country, that should not mean under a Unitary Patent that this right exists for the entire UPC territory. I think that in the end the ECJ will rule that exceptions to the general principle expressed in Art. 5 of the Regulation are possible, especially in the interest of creating one market in the EU which is best served with a Unitary patent. Patentees will not choose such UP if a prior user right would extend to the whole UPC territory. Therefore, the Unitary Patent, which can only be obtained if one has all UPC countries designated and if the text of the EP is the same for all countries, is not as unitary as suggested. Although there is no specific article in

<sup>24</sup> CJEU 9 July 1985, C-19/84, ECLI:EU:C:1985:304 (Pharmon/Hoechst), par 20 .

the UPCA, I think that compulsory licenses should be treated in the same way as prior user rights because I do not see a fundamental difference between a prior user right and a right as a compulsory licensee.

It might have been more logical if also a prior user right would have been a right which would have Unitary effect. However, this would, as stated above, have made filing for a Unitary Patent for patentees less attractive and would also have been difficult to implement because prior user rights have not been harmonized and the requirements for obtaining a prior user right and the rights flowing from it differ per country.

As stated, the infringing acts and its exceptions are listed in Articles 25-29 of the UPCA and in the UPC countries the law on the most important points of patent law are therefore the same and, in that sense, the UPC is clearly unified. The most eye-catching consequence of this is Art. 26 which deals with indirect infringement while the same articles in the national patent legislations have a double territorial requirement in the sense that the sale or offering in a country must be done for a use of the invention in the same country, in the UPC that double territory rule has now been extended to the whole of the territory of the UPC. So, selling in the Netherlands for use in Germany is an indirect infringement.

So here we see an advantage of not opting out. There are also other advantages. Some of the exceptions such as for instance under art. 27 sub d are more limited than in f.i. French and German national law. Another example is f.i. if there is a threat of infringement in the Netherlands you can obtain an injunction for the whole of the UPC even if there is not yet a threat of infringement in other UPC countries.

So the UPC is an attractive forum and a choice for a Unitary Patent means that third parties can no longer use national proceedings which may also be attractive for a patentee. Moreover, for the price of four to five countries one obtains protection for 17 countries. From an EU “one market” principle the UPC (extended to the whole EU) and only Unitary Patents would be the most optimal situation. In that case it is understandable that it was not in the interest of achieving this goal to make the UPC and/or UP less attractive with UPC-wide consequences of prior user rights or compulsory licenses.

As I said before, the UPC the law on validity (Art. 138 EPC) and infringement (Art. 69 EPC) and with respect to infringing acts and its exceptions (Art. 25 -29 UPCA) is supra national law. However, all the countries of the UPC have already been applying Art. 69 and Art. 138 in their national courts for many years and there are clear differences in the way they interpret and/or apply these provisions. It is in the end the Court of Appeal which has to decide on one interpretation and application of these provisions in the whole of the UPC.

I limit myself to two issues which I think have already caused confusion in the Netherlands, let alone between UPC countries: file wrapper estoppel and the doctrine of equivalence.

## XV. File wrapper estoppel

This basically means that the patentee is estopped to argue that a device or method is infringed based on what has happened during the prosecution of the patent. Most of the time it is the consequence of what the applicant has written (or has not written) during the prosecution or during opposition proceedings. Starting point for determining if there is an infringement should be Art. 69 EPC and the Protocol. However, the text of Art. 69 and the Protocol (also after the revision during EPC 2000) does not mention anything about the role of the file wrapper (prosecution history) with respect to the infringement question and in the past in countries like Germany (except in very special circumstances<sup>25</sup>) and the UK the file wrapper could not be used for the purpose of establishing whether there is infringement<sup>26</sup>. The UK courts were very clear about this: It is not mentioned in Art. 69 and the Protocol and one cannot expect of a third party to study the file wrapper in order to find out whether or not he is infringing. This sounds convincing but is not realistic. First of all, also SME's can be expected to ask expert advice if they want to put a product on the market (certainly if this is a me-too product) from an expert, such as a patent attorney. An SME also has a bookkeeper and somebody who helps him with his tax returns etc. So when we talk about a third party in patent law and realize that private persons are not concerned with infringements, a third party is a person skilled in the art of the patent with the knowledge of an average patent attorney. The average patent attorney will, before giving any advice, read the file wrapper. The argument that nothing is mentioned about the file wrapper in Art. 69 and the Protocol is also not very convincing as Art. 69 and the Protocol refer to the claims, the description and the drawings. As we all know, words and texts are often not 100 percent clear and require interpretation. The Dutch Supreme Court recognized this in the famous CibaGeigy-Oté Optics decision in 1995<sup>27</sup>. In that case the Court held that, if after study of the description and drawings there is still reasonable doubt about the content of the claims, it is possible to use the file wrapper also to reach the conclusion that there is infringement. However, unclarities which are caused by sloppy drafting are in principle for the risk of the patentee. In all subsequent decisions about art. 69 EPC the Supreme Court has never reversed this possible use of the file wrapper for the benefit of the patentee,

<sup>25</sup> See BGH 12 March 2002 (Kunststoffrohrteil) but in BGH 14 June 2016 (Pemetrexed) X 2R 29/15 seemed to accept the use in order to establish how the skilled person would construe the patent.

<sup>26</sup> This UK position has clearly changed in Actavis-Eli Lilly (as discussed hereafter).

<sup>27</sup> Dutch Supreme Court 13 January 1995, ECLI:NL:HR:1995:ZC1609 (Ciba Geigy/Oté Optics), par. 3.3.1.

and in my view rightly so. As said above in practice third parties will look in the file wrapper to determine whether or not they are infringing certainly in cases in which claim, description and drawings do not provide a clear answer. Nowadays the UK Supreme Court is in full agreement with the Dutch Supreme Court. In *Actavis-Eli Lilly*<sup>28</sup> Lord Neuberger formulated two instances in which the file wrapper could be used. The first one being the situation in which the point at issue is truly unclear if one confines oneself to the specification and claims of the patent and the contents of the prosecution file unambiguously resolve the point.

The patent chamber of the Court of Appeal of the Hague did not like the 1995 decision of the Supreme Court and simply ignored it by ruling every time that the description and the claims were clear. They did the same in the *Saier* case of 2006, but this time the alleged infringer argued that the patentee had avoided revocation of its patent by the Board of Appeal by arguing that “satt und dichtend” in the claim meant that the cover could not be removed by hand from the container (containing mayonnaise) and that in his device this was possible and that he therefore should not be held infringing. However, the Court of Appeal decided (again) that the claim and description had a clear meaning being that the content of the container in normal use could not escape and therefore confirmed the infringement. However, the Supreme Court decided that a third party can always invoke the file wrapper in order to argue that there is no infringement<sup>29</sup>.

In the *Saier* case it was very clear that in order to overcome the lack of inventive step the patentee had to give this (restricted) interpretation to the meaning of “satt und dichtend” and I think that every reasonable person would consider it wrong in such a situation to hold that the third party was infringing with a device that clearly did not fall under the scope of the patented invention. That is exactly the second instance in which Lord Neuberger followed by the UK Supreme Court stated that the file wrapper can be used: it would be contrary to the public interest if the contents of the file wrapper would be ignored. Of course, the *Saier* problem was caused by the Board of Appeal. The Board of Appeal should have told the patentee to mention its definition in the description. The EPO (Examiners, Opposition Divisions and Boards of Appeal) should in general make sure that the description (without leading to an extension of subject matter) is corrected or

<sup>28</sup> Supreme Court (United Kingdom) 12 July 2017, *Actavis UK Ltd v Eli Lilly & Co* [2017] UKSC 48, par. 88.

<sup>29</sup> Dutch Supreme Court 12 December 2006, ECLI:NL:HR:2006:AZ1081 (*Dijkstra/Saier*), par. 3.5.3.

adapted in such a way that it is possible to use the description to determine the scope of the claim.

I am also quite sure that even if a country does not accept file wrapper estoppel, the outcome of the above mentioned *Saier* case would normally be the same. A good judge in such a situation simply interprets the claim as it should be interpreted without explicit reference to the file wrapper. However, that may not always be the case and is of course somewhat artificial. The decision of the Court of Appeal in this case shows this!

So in the UPC we need the file wrapper estoppel doctrine in such a clear case as the *Saier*-case. However, the use of such doctrine can easily run out of hand as we have also seen in the Netherlands. If file wrapper estoppel is accepted, third parties will find all kind of arguments based on the file wrapper why they could have believed that they were not infringing. In the Netherlands this led to a finding by the Court of First Instance in The Hague<sup>30</sup> that there was no infringement in the *Pemetrexed* case because during the prosecution the patentee had restricted the claim to a version which did not literally cover the infringing product, not because that was necessary in order to establish inventive step but because in the priority application there was no basis (according to the examiner) for a broader claim.

The decision was the more remarkable as in PI proceedings judge Brinkman (now also a UPC judge) had found infringement<sup>31</sup>. The Court of Appeal reversed the decision of the Court in First Instance and joined the rest of Europe in finding infringement<sup>32</sup>.

Also, in the UK after *Actavis* infringers started to argue file wrapper estoppel based on all kind of arguments. The regretted late Justice Carr made the following very noteworthy comment in the *L'Oréal vs RV* case<sup>33</sup>: “It should be emphasized that reference to the prosecution history is the exception and not the

<sup>30</sup> Court of First Instance in The Hague 19 June 2019, ECLI:NL:RBDHA:2019:6107, par. 4.23-4.24.

<sup>31</sup> Court of First Instance in The Hague (PI Proceedings) 24 October 2017, ECLI:NL:RBDHA:2017:12046.

<sup>32</sup> Court of Appeal in The Hague 27 October 2020, ECLI:NL:GHDHA:2020:2052.

<sup>33</sup> High Court (England and Wales) 5 February 2018, *L'Oréal Société Anonyme & L'Oréal (UK) Limited v RN Ventures Limited* [2018] EWHC 173 (Pat), par. 77

rule.” However, although the Court of Appeal in the Appeal<sup>34</sup> of the preliminary injunction of the Pemetrex case had already ruled that only (patent) technical reasons justified file wrapper estoppel and not formality reasons, a recent case of a different chamber of the Court of Appeal (in the so-called balloon case<sup>35</sup>) again showed the danger of the theory. In that case the patentee removed an element in the claim that called for multiple openings. The examiner told the patentee that there was no basis for a claim without that element in the priority document and that the consequence would be that no patent could be granted because the claimed device had been put on the market by the patentee during the priority year. The patentee put the element back to restore the priority. The Court of Appeal held that this prevented the patentee to argue that the device which did not literally have multiple openings but which was according to the Court of Appeal an equivalent, was not infringing because a third party could learn from these events during prosecution that the patentee had limited his claim to cover only devices with multiple holes and not equivalents thereof.

In my view, this is clearly wrong. The doctrine of file wrapper estoppel should be an exception to the rule that the file wrapper should not play a role for establishing the scope of protection and can only be used to resolve uncertainty remaining after studying claims, description and drawings (see hereabove) and be used if a patentee wants to extend the scope of his claim to something which if claimed during prosecution would have prevented granting his patent<sup>36</sup>. In the case at hand the patentee did not claim that a product without multiple holes was infringing. On the contrary, he claimed that the infringing device fulfilled the element of the claim which required multiple holes but did so in an equivalent manner.

No third party can in my view in good faith rely on the fact that a patentee (without any reason) gives up the possibility to an equivalent form of an element that the patentee had to include in the claim to overcome a formality problem (such as priority, extension of subject matter or clarity). He can only rely on the

fact that if the element is totally absent, he is not infringing or on the fact that if his equivalent product/method is part of or a non-inventive variant of the prior art (Gilette), he is also not infringing.

<sup>34</sup> Court of Appeal in The Hague (PI Proceedings) 8 May 2018, ECLI:NL:GHDHA:2018:1105.

<sup>35</sup> Court of Appeal in The Hague 20 September 2022, ECLI:NL:GHDHA:2022:1802 (Tinnus/Koopman), par. 6.17.

<sup>36</sup> This seems also clearly be the view of the French court (Tribunal judiciaire de Paris) in the Pemetrex case: The file wrapper can be optionally used as a tool of interpretation but can only be used against the patentee if it contains a clear acknowledgment or waiver that something is not covered by the claims.

## XVI. The Doctrine of Equivalence

The law with respect to infringement is clear in the UPC. It is Art. 69 EPC and the Protocol on the interpretation of Art. 69 as amended in EPC 2000. For many years, this has been the law in the UPC states.

However, we have seen that there are quite different approaches in practice to apply Art. 69 EPC with respect to non-literal infringement. This, however, has not led in many cases to very different outcomes in the same case, although one sometimes wonders if this is not under the influence of a final decision in one country which makes it less likely that other national courts disagree, certainly if such decision is a well-reasoned decision of a national court with a good patent reputation. However, in the end it would be welcome and necessary for the Court of Appeal of the UPC to come up with some clear guidelines on how to deal with non-literal infringement. The test should preferably be simple and easy to understand by practitioners. I am sorry to say but, in my view, the German test does not qualify for that. I find it too complicated and difficult to apply.

I understand the basic German test as follows:

1. Does the variant solve the problem underlying the invention with means that objectively it has the same effect? (Technische Gleichwirkung)
2. Would the person skilled in the art, using the common general knowledge, have realized at the priority date that the variant has the same effect? (Auffindbarkeit)
3. Are the considerations which the skilled person took into account for the variant in the light of the meaning of the invention close enough to the considerations taken into account for the literal solution protected by the claims, in such a way that the skilled person considers the variant as a solution which is equivalent to the literal one? (Gleichwertigkeit).

Especially the second and third question are in my view very difficult and have led some to believe that an “inventive equivalent” cannot infringe, which is of course a misconception as it would be wrong to require that a third party should be able to find the equivalent at the priority date. What is decisive in my view is that a third party asks the infringement question with the knowledge of the equivalent (variant) and deal with that question at the time of the infringement. That equivalent can very well be inventive as the question whether the equivalent

is inventive should be answered without the knowledge of the equivalent at the time the patent for the equivalent was filed.

To answer the equivalent question at the time the equivalent is brought on the market does not mean the patent can obtain a broader scope of protection than it had at the priority date. The scope of protection is to be determined at the priority date. However, it is clear that because of the development of the technology since the priority date more could fall under the same scope of protection. If f.i. the claim reads that A is connected to B by screws withstanding a pulling force X and after the priority date of that patent a glue is invented which is withstanding the same pulling force, it is clear (assuming there was no other reason to use screws) that this equivalent would be infringing as the scope of protection at the priority date was a product in which A was connected to B in such a way that it could withstand a pulling force X.

Turning now to the Netherlands we see something interesting. In the same case two different chambers of the Court of Appeal apply two theories. In the appeal of the PI decision of the Pemetrexed case the teaching of the Supreme Court, the so-called viewpoints theory, carefully developed in a string of cases by our Supreme Court since 1995 is applied while in the appeal of the case on the merit a so-called two step approach is applied, which suggests that this is the preferred theory because that is the theory applied in most EPC countries referring to Art. 31 under 3 of the Treaty of Treaties<sup>37</sup> apparently in an effort to justify the deviation from the approach of the Supreme Court.

I do not think that the Treaty of Treaties is a justification to have a two-step theory especially because the application in all the cited countries (France, Germany and the UK) is different. A good example is that in France in the Pemetrexed case the infringing product was found to be infringing without relying on the doctrine of equivalence but on the general meaning of the claim. This is in fact very much in accordance with the viewpoints teaching of the Dutch Supreme Court.<sup>38</sup>

<sup>37</sup> Vienna Convention on the Law of Treaties 1969 . Article 31 under 3. There shall be taken into account, together with the context: (a) any subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions; (b) any subsequent practice in the application of the treaty which establishes the agreement of the parties regarding its interpretation; (c) any relevant rules of international law applicable in the relations between the parties.

<sup>38</sup> Eli Lilly v. Fresenius Kabi, Tribunal judiciaire de Paris, 11 September 2020 case 17/10421

If we now look in more detail to this new Dutch two step approach, we see that it is complicated and vague.

According to this theory, in step 1 one determines whether or not there is literal infringement. However, in determining that one does not apply the letter of the claim but one applies Article 1 of the Protocol. Now the way I read Art. 1 of the Protocol is that this clearly (by way of Art. 2 of the Protocol) includes equivalents but apparently the idea is that we apply a kind of purposive construction of the claim and in doing so, we exclude equivalents. It is not very easy to apply this rule because it means that on the one hand there is no focus on the true letter of the claim but on the other hand you still exclude certain non-literal deviations of the claim. So it is not literal but also not too much non literal. After you have decided that there is no literal infringement you must apply the following criteria to establish if there is infringement by equivalence

- a) the variant must solve the same problem and perform the same function;
- b) is it from an equitable protection point of view fitting to take the equivalent into consideration;
- c) is determining that the equivalent is infringing justified in view of the reasonable certainty for third parties;
- d) the equivalent cannot infringe if it was known before the priority date or a non-inventive variant of the prior art (Formstein/Gilette).

Of course, “a” and “d” are generally accepted criteria. However, I do not understand the requirement under “b”. If something solves the same problem and performs the same function, it seems clear that it uses the inventive idea of the invention and it seems to be covered by the one extreme of art. 1 of the Protocol which would call for protection. Of course, one has then to take into consideration the certainty of third parties which is done under c. So, c is certainly a requirement that must be considered. However, the Court of Appeal states that the starting point should be in considering this condition that there is unclarity for a third party because the equivalent is not literally described in the claim. I do think that that is the wrong starting point. The third party is in my view a person who has the knowledge of the skilled person advised by a patent attorney and in many cases, there is no doubt for someone who knows the technology and has the necessary knowledge of patent law, that the equivalent is infringing. I also think that such starting point is contrary to the Protocol which

makes it very clear that an infringement does not have to be literal. The Court of Appeal seems too much to look for an absolute certainty for third parties before you can decide on infringement. I think the water balloon case which is now pending in the Supreme Court is a perfect example of that. In the Pemetrexed case the Court came to the right decision but if one reads the reasoning it seems to be very much influenced by earlier decisions in the PI proceedings and the decisions in other countries.

The theory of the Supreme Court (the viewpoints theory) focusses much more on what a patent is all about. The core of a patent is that somebody had an idea how to solve a - at the priority date not resolved - technical problem. It is this inventive idea which the inventor tries to protect and wants to protect with its patent and that is clearly recognized in the one extreme of the Protocol. On the other hand, the Supreme Court recognized the other part of the Protocol: the certainty for third parties. So, in deciding the case the court has to take these viewpoints into consideration, (with in mind what Art. 2 of the Protocol states). Of course, other circumstances (you can call it viewpoints) in reconciling these two extremes of the Protocol should be taken into consideration such as how big a step forward the invention is and how easy it was at the priority date to see the impact of that invention? For sure Formstein and Gilette form an absolute no for finding infringement of an equivalent and surely the same is true for a true file wrapper estoppel. I agree that “clearly disclosed but not claimed” is an important factor to be taken into consideration but from experience we know that also such absolute rules make up bad law, so also here the consequences may depend on the circumstances of the case. I think that a good application of the viewpoints theory leads to tailor-made and good decisions, but I also agree that theory may not always be easy to apply because all the different viewpoints must be recognized (including “the inventive idea”) and dealt with.

My conclusion is that it may be desirable for the UPC to have more simple guidelines and quite frankly I think that the UK in the Actavis decision generally got it right. The Supreme Court of the UK said that the following questions should be asked:

1. “Notwithstanding that it is not within the literal meaning of the relevant claim(s) of the patent, does the variant achieve substantially the same result in substantially the same way as the invention, i.e., the inventive concept revealed by the patent?”
2. “Would it be obvious to the person skilled in the art, reading the patent at the priority date, but knowing that the variant achieves substantially the same result as the invention, that it does so in substantially the same way as the invention?”
3. “Would such a reader of the patent have concluded that the patentee nonetheless intended that strict compliance with the literal meaning of the relevant claim(s) of the patent was an essential requirement of the invention?”
4. In order to establish infringement in a case where there is no literal infringement, a patentee must establish that the answer to the first two questions is “yes” and that the answer to the third is “no”.

In order not to have any misunderstanding the second question means that the person skilled in the art knows the variant and knows that the variant achieves substantially the same result (so we are at the time of the infringement) and (only) then reads the patent at the priority date (so with the prior art in mind at the priority date). The latter avoids an extension of the scope of protection. Of course, also here it is clear that there is no infringement when a successful Gilette/Formstein defense is put forward and the same with respect to true file wrapper estoppel. I do think that the right interpretation of the third question does not make it the case that “disclosed but not claimed” necessarily always leads to a non-infringement argument.

The additional advantage of adopting these guidelines is that the UK and the UPC would apply the same (simple) guidelines which makes life easier for the users of the patent system.

## XVII. Dutch national proceedings and the UPC

The Rules of Procedure have been very much inspired by the Dutch so-called abbreviated procedure for patent cases which before Covid was a front-loaded system with one exchange of written pleadings and a further exchange of exhibits and an oral argument during which party experts (which had given their written advice) would be present and could be questioned. The date of the hearing would be known at the beginning of the proceedings. This resulted in judgements within a year.

The Rules of Procedure contain the following improvements:

1. There are two written exchanges. This makes it a better instruction for the judges
2. There is a reporting judge who knows the case from the beginning (and can resolve issues during the proceedings) and in the interim phase can do all that is needed to ensure there are no loose ends during the oral hearing
3. The presence and possibility of cross examination of experts and witnesses during the oral hearing is formalized

In recent years unfortunately the Court (in First Instance) in the Hague has taken much more time for its judgements so that decisions within a year became an illusion. The most curious thing is the way the abbreviated procedure has recently been changed by the Court. One would expect that they would have followed the Rules of Procedure so that there is no difference between national and UPC proceedings but instead it seems that the new regime moves further away from the Rules of Procedure especially as to the oral argument. I have the impression that this is also linked to the fact that there is a consistent lack of manpower in the IP chamber of the Court of First Instance. This seems to be a general problem with the Dutch judiciary.

The education program to become a career judge has been abolished for financial reasons. For lawyers who work in private practice it has become very unattractive to move to the judiciary because if you undertake that move even if you have a long experience as an attorney, you may after a year still hear that you cannot become a judge. In the field of patents, the ideal profile for a patent judge, in my view, is the UK model. However, nobody who is a respected and experienced patent litigator is making the switch if he is not even sure that he will be appointed as judge. Already in my inaugural speech 35 years ago I made some

remarks about those problems. No recognition of specialization, insufficient support, too long working hours, an enormous bureaucracy (the so-called Raad voor de Rechtspraak) and salaries which are too low. A rich country like the Netherlands is simply unwilling to spend sufficient money on its judiciary.

My conclusion of comparing Dutch national patent proceedings with the UPC is simple. A case in the Dutch Local Division would clearly have my preference. The procedural rules that apply seem much better than the present new regime in the Court of The Hague and there is a clear commitment in the UPC that a decision is indeed delivered in 12-14 months. Moreover, the patentee knows that for the Local Division in the Hague two experienced judges both with a scientific background have been selected: Mr Brinkman and Ms Kokke. I think that the Local Division in the Hague also among the other Local Divisions have an excellent position because its experienced judges are both used to deal with infringement and invalidity without relying on court appointed experts and their knowledge of English is such that they do not have to use Rule 14 under 25 which was put in the Rules of Procedure at the insistence of Germany which, even if the language of the proceeding is English, allows the judges to speak German during the hearing and write the decision in German.

To me that seems contrary to article 49 under 2 of the UPCA which does provide for the choice of an EPO language such as English as language of the proceedings, but not to not use the language of proceedings during the hearing.

I conclude my remarks with respect to our national patent procedure with two remarks about our Supreme Court and patent law.

After the retirement of Vice President Mr Numann, the court does not have a patent specialist among its judges anymore. However, Advocate General Mr Van Peurseem is an internationally recognized specialist in patent law and more general in IP law and the Supreme Court and more in general the Dutch IP community may be happy that he did not opt for a position in the UPC.

Of course, even a non-specialized Supreme Court does not have to follow opinions of a specialist Advocate-General but one would at least expect that when the Court does not follow the opinion, it does so with a solid reasoning. In one of the Philips cases Mr Van Peurseem concluded that the decision of the Court of

Appeal should be reversed as two complaints were justified. The Supreme Court did not follow as to one complaint with in my view a clearly wrong argumentation and even worse with respect to the second complaint with no argumentation at all (so called Art. 81 decision).

Although in Europe there are different decisions about the interpretation of the ECJ decision in Huawei<sup>39</sup> and the Court of Appeal of The Hague<sup>40</sup> in two decisions gave a very elaborate interpretation of the Huawei decision the Supreme Court<sup>41</sup> simply invoked Art. 81 and dismissed the complaints without bothering to endorse the decision of the Court of Appeal adding its weight to the European debate.

This is all rather disappointing. Now I immediately have to add that these are the remarks of someone whose professional life is about IP. For the Supreme Court this is only a small issue among the many issues they have to deal with. It is also clear to me that they simply have too many cases to deal with. All the reforms have not truly resolved this issue. On the contrary, also in IP cases I see many appeals to the Supreme Court which should not have been lodged. I think it has been somewhat wishful thinking that the Supreme Court lawyers will perform a sieve function. Nowadays everybody can become a Supreme Court lawyer by passing a simple exam, but to maintain the status of Supreme Court lawyer one is forced to deal with a minimum number of cases. That is of course no incentive to turn down requests for lodging an appeal to the Supreme Court. Furthermore, their clients often want a so-called last chance and yes, you can almost always find something in a decision of a Court of Appeal to complain about. The solution in my view lies in a license system which limits the number of cases to cases which clearly raise general points of law of general interest or which show a clear miscarriage of justice. I also think that like in the US Supreme Court judges should each have their own two or three legal assistants recruited among the brightest law graduates.

<sup>39</sup> CJEU 16 July 2015, C-170/13, ECLI:EU:C:2015:477 (Huawei/ZTE).

<sup>40</sup> Court of Appeal in The Hague 2 July 2019, ECLI:NL:GHDHA:2019:3613 (Philips/Wiko); Court of Appeal in The Hague 24 December 2019, ECLI:NL:GHDHA:2019:3537 (Philips/Wiko).

<sup>41</sup> Dutch Supreme Court 25 February 2022, ECLI:NL:HR:2022:294 (Wiko/Philips).

Although as said I realize that patent law is a minor field within civil law, the Supreme Court should realize that their decisions have authority and may influence the decisions of the future UPC Court of Appeal. So, Art. 81 may often be justified but of course does not add to judicial debate and such influence.

Finally, if you have specialized AG, think twice before you come to a different conclusion and at least do the IP community the service to give reasons if you do not agree.

## XVIII. Words of thanks

On April 1, 2023 it was 35 years ago that I was appointed as professor of Industrial Property Law. The then KUB (now Tilburg University) wanted a part-time Professor who was a practitioner, a litigator, realizing that Intellectual Property should and can in fact best be taught by a practitioner.

I have enjoyed these 35 years and I was fortunate to work in a Private law Department with great lawyers, such as Schoordijk and Vranken, my promotor, and many other smart and pleasant colleagues, always supported by excellent secretaries, in the last many years by Mandy and Lieke.

I was fortunate that Intellectual Property, even with my emphasis on patents, was a very popular course with interested students throughout the world. It was good to see some to be so inspired and talented that they became a Professor of IP law or IP practitioners or that students in later years followed my course because their fathers or mothers recommended it.

All this would not have been possible if in 1973 Teartse Schaper would not have been my inspirator and teacher and without the support of my colleagues in our law firm, but above all with the support of my wife Marie-Claire who in all these years has accepted that I didn't have a 35-hour work week and retirement at 60 as most of her French compatriots.



**Willem Hoyng** (LLM Leiden University) obtained his PhD from Tilburg University and was appointed as professor of IP Law as of April 1st 1988. He has been practicing IP Law since 1973 (HOYNG ROKH MONEGIER) and has been admitted to the bar of the Supreme court of the Netherlands. He is co-founder and former president of the European Patent Lawyers Association (EPLAW)  
Former President of the Dutch AIPPI group (VIE)  
Former Chairman of the IP Advisory Committee of the Dutch Bar  
Co-founder and former Chairman of VIEPA (association of Dutch IP litigators)  
Former member of the Government Advisory Committee on patents  
Former member of the Supervisory Board of the Academy of the European Patent Organisation  
Former co-Chairman of the patent law education program for Dutch patent attorneys  
Former member of the Examination Board for the Dutch patent attorney exam  
Member of the drafting committee of the Rules of Procedure of the UPC  
Chairman of the Advisory Committee of the UPC.

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