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## **PROPOSAL FOR A EUROPEAN AND COMMUNITY PATENTS COURT CCBE POSITION REGARDING ARTICLE 28 - REPRESENTATION**

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## Proposal for a European and Community Patents Court CCBE Position regarding Article 28 - Representation

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### Introduction

The Council of Bars and Law Societies of Europe (CCBE) represents more than 700,000 European lawyers through its member Bars and Law Societies of the European Union and the European Economic Area. In addition to membership from EU Bars, it has also associate and observer representatives from a further ten European countries' Bars.

The CCBE has recently created a Working Group on Patents, made up experts from a number of Member States. This Working Group is following the discussions taking place at a Council level concerning the proposal for a European Union Patent Court.

### Article 28 – Representation

Having examined the details of the latest proposal (5072/09 of 8 January 2009), the CCBE believes that there is an immediate issue that should be brought to the attention of the Council. This issue concerns representation as contained in Article 28 of the current draft (recent changes shown in revision marking mode).

### **Article 28** **Representation**

- (1) *Parties shall be represented by lawyers authorized to practise before a court of a Contracting ~~Party~~State.*
- (2) *Parties may also be represented by European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the European Patent Convention and who have appropriate qualifications such as a European Union Patent Litigation Certificate ~~and who are authorized to represent parties before a court of a Contracting party~~.*
- (3) *The requirements for qualifications pursuant to paragraph 2 shall be established by the Mixed Committee on the basis of a proposal from the Commission of the European Communities. A list of European Patent Attorneys entitled to represent parties before the Court shall be kept by the Registrar.*
- (4) *Representatives of the parties shall enjoy the rights and immunities necessary to the independent exercise of their duties, under the conditions laid down in the Rules of Procedure.*
- (5) *Representatives of the parties shall be obliged not to misrepresent cases or facts before the Court either knowingly or with good reasons to know.*

The CCBE believes that this latest proposal is fundamentally flawed for the following reasons:

(1) The current draft of Article 28.2 would allow direct representation by patent attorneys. If patent attorneys have the possibility to plead directly in front of the Patent Court, this would be extremely problematic as disputes involving patents are not limited to technical matters or purely patent law matters, but involve many other areas of law in which a patent attorney will have no training or experience. For patent litigation, there is a need to possess a broad legal education including many substantive and procedural legal issues which in general are not possessed by patent attorneys, either by training or experience. The following is a non-exhaustive list of specifically legal issues that arise in disputes involving patents:

- Analysis of the scope of protection of a patent (the doctrine of equivalents);
- Damages – how to assess, attribute and calculate damages;
- Equity arguments against the enforcement of a patent;
- Application of the enforcement Directive e.g. application of the rule of reason;
- Rules concerning the exhaustion of a patent;
- Licensing agreements as defence arguments/validity of licensing agreements;
- Anti-trust measures/various legal issues related to anti-trust;
- Licensing in the context of settlement agreements ;
- General aspects of criminal law that can enter patent litigation;
- Procedural law;
- Enforcement law, including court ordered inspection of property, cf. Article 35a;
- Impact of international treaties (e.g. TRIPS);
- Patent disputes arising in relation to other rights e.g. breach of contract;
- Abuse of rights;
- Classical defence arguments;
- Prescription issues/statute of limitations;
- The effect of international standards and FRAND obligations;
- Jurisdictional arguments;
- The law of evidence (e.g. hearsay, opinion evidence, experiments); and
- Res judicata, estoppel and equitable issues relating to remedies

The CCBE believes that it is in the parties' interest that disputes involving patents are carried out by a suitably qualified and properly trained professional lawyer that can guide the client through all aspects of patent disputes. Furthermore, it is unrealistic to expect that the vague concept of a *European Union Patent Litigation Certificate* could address and provide the required level of training and no guarantee of appropriate standards could be given to the public.

In addition, and in accordance with Article 49, the European and Community Patent Court may only base its decisions on the grounds, facts and evidence submitted by the parties. A well functioning system therefore requires that the parties' are represented and advised by practitioners that are competent to handle all the legal and procedural issues that arise. Procedural aspects may indeed have a critical impact on the outcome of disputes; it therefore matters, in the interests of the administration of justice and of citizens, that the parties be represented by law and procedure professionals.

(2) It is necessary for the efficient and fair functioning of the court that professional representatives are subject to clear, consistent rules of behaviour backed by an effective disciplinary procedure to ensure compliance. A certificate obtained by a patent agent provides no guarantee that he/she will behave in accordance with the principles taught or examined as part of any training. Rules concerning professional secrecy, the prohibition of conflicts of interests, behaviour in relation to the court and to other professional representatives, and the

independence of a lawyer are additional guarantees that the members of the bar bring to the protection of the interests of the parties. Such rules or guarantees do not necessarily extend to patent agents as in a number of countries of the European Union patent attorneys do not belong to any legal profession and are only subject to the deontology and rules of professional conduct of the European Patent Institute (EPI) and not to any professional order recognised by law.

- (3) It might also be interesting to note that on 20 October 2008 the Court of First Instance (CFI) delivered an Order (in case T-487/07, Imperial Chemical Industries plc v. Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)) concerning representation by a patent attorney litigator before the Court of First Instance. The CFI ruled that “*authorisation to practise before a court or tribunal or even before all courts and tribunals of a Member State cannot be sufficient to confer the right to represent an applicant before the Community judicature*” and “*that the title of ‘Patent Attorney Litigator’ does not appear among the titles comprised in the definition of ‘lawyer’ in Directive 77/249 or in Directive 98/5. It follows that, as a ‘Patent Attorney Litigator’, ...is not vested with a title which confers the status of a lawyer and is accordingly not formally recognised as being a lawyer..*” The Court went on to rule that “*for the purposes of the application both of Article 19 of the Statute of the Court of Justice and the directives referred to above, the concept of ‘lawyer’ must be given a uniform interpretation. Such an approach is the only one which avoids the paradox of permitting a person to represent a party before the Community judicature when he would not be authorised to represent that party before the national courts and tribunals of the Member States other than his State of origin.*”

#### Suggested wording for Article 28

The CCBE would like to suggest that Article 28 could be formulated as follows:

##### *Article 28*

##### *Representation*

- (1) Parties will be represented by lawyers authorized to practise before a court of a Contracting State.*
- (2) The lawyers representing the parties may be assisted by European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the European Patent Convention provided that the lawyers assisted in this way maintain full responsibility for complying with all obligations to the Court required of legal representatives.*
- (3) The lawyers representing the parties shall enjoy the rights and immunities necessary to the independent exercise of their duties, under the conditions laid down in the Rules of Procedure.*
- (4) The lawyers representing the parties shall be obliged not to misrepresent cases or facts before the Court either knowingly or with good reasons to know.*

## Conclusion

Having regard to the above, the CCBE would like to urge the members of the Council Working Group to appreciate that a well functioning judiciary requires that the parties are represented and advised by practitioners that are not only competent to handle all the legal and procedural issues that arise, but are also subject to a strict ethical rules of conduct. Lawyers consider it as their core responsibility to cooperate with the courts and to assist in establishing a consistent European Patent Jurisdiction as they have done in the past for many years with the national courts at a national level.