

## **Preliminary set of provisions for the Rules of procedure of the Unified Patent Court**

### **Status**

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8. Eighth draft dated 30 March 2012
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9. Ninth draft dated 24 May 2012
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12. Twelfth draft dated 29 November
13. Thirteenth draft dated 14 January 2013
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14. Fourteenth draft dated 31 January 2013
  - For further informal comment prior to the public consultation

### **Introductory remarks**

The present document contains a draft set of provisions for the Rules of Procedure of the Unified Patent Court (hereinafter "UPC" or "Court").

Basic principles of procedural law are already laid down in Part III of the draft Agreement on a UPC (hereinafter "draft Agreement"), for instance proportionality and fairness, case management, right to be heard, publicity, stages of the proceedings etc. The draft Agreement also contains general provisions on languages, parties, representation, means of evidence, experts, and defines the powers of the UPC to order provisional measures (in particular preliminary injunctions), to issue orders to preserve evidence (*saisie-contrefaçon*), corrective measures etc.

However, in several places in the draft Agreement, references are made to "Rules of Procedure" which shall spell out procedural details. This is a tried and tested legal technique: only the basic principles have been included in the draft Agreement, many procedural details being left for secondary legal instruments.

In accordance with Article 41(2) draft Agreement, the Rules of Procedure of the UPC shall be adopted by the Administrative Committee, on the basis of broad consultations with all stakeholders and following an opinion of the European Commission on the compatibility of the Rules of Procedure with Union law. Users of the patent system have however repeatedly requested that preparatory work on the Rules be started at an early stage, in order to enable a better assessment of the functioning of the future Court in practice.

It was envisaged that the Contracting Member States would, immediately after the signature of the Agreement, start the necessary preparations for the ratification of the Agreement to ensure its entry into force without delay. In parallel, the Contracting Member States would set up a Preparatory Committee in charge of preparing the practical arrangements for the early establishment and coming into operation of the Unified Patent Court. The Contracting Member States acknowledge the importance of appropriate Rules of Procedure for the Unified Patent Court and of their uniform application, which are vital to guarantee that the decisions of the Court are of the highest quality and that proceedings are organised in the most efficient and cost effective manner. However signature of the Agreement has been delayed pending agreement among the Contracting Member States on certain issues. This has in turn delayed the setting up of the Preparatory Committee. To avoid further delay in the work on the Rules of Procedure a small Drafting Committee of expert judges and lawyers was appointed to take this work forward.

The eighth draft prepared by the Drafting Committee was the subject of wide technical consultation with professional and industry bodies. A list of respondents who commented on that draft is set out below.

The Drafting Committee believes that this fourteenth draft is suitable for further informal comment prior to the formal public consultation. Comments should be addressed to [kevin.mooney@simmons-simmons.com](mailto:kevin.mooney@simmons-simmons.com).

The aim of the Drafting Committee remains to assist the Preparatory Committee, when appointed, to complete the draft Rules of Procedure within three months of the signature of the Agreement.

Comments on the eighth draft of the Rules of Procedure were received from

Joachim Feldges  
BDI  
EGA  
Marina Tavassi  
Gabiella Muscolo  
IP – Federation

Modiano & Partners  
Association des Praticiens Européens des Brevets  
Association of Intellectual Property Law Firms in Sweden  
Intellectual Property Lawyers Association (UK)  
Research in Motion  
The Danish Association of the Pharmaceutical Industry

Dr. Peter Guntz  
ICC – France  
Confindustria  
Interpat & EFPIA  
CCBE  
EPA Expert Group  
Thomas Bopp  
TEVA  
Watson/Arrow  
EPI – Preliminary Comments

Association des Avocats de Propriété Industrielle  
Dutch/Belgian Respondents I  
Dutch/Belgian Respondents II  
European Patent Lawyers Association I  
European Patent Lawyers Association II  
Licensing Executives Society (Britain & Ireland)  
epi  
GSMA  
Confederation of Swedish Enterprise

## Abbreviations

**EPC:** European Patent Convention

**Regulation (EU) No 1257/2012:** Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (OJEU L 361, 31.12.2012, p. 1)

**Regulation (EU) No 1260/2012:** Regulation (EU) No 1260/2012 of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements (OJEU L 361, 31.12.2012, p. 89)

**Regulation (EU) No 1215/2012:** Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters

*Levels for the various procedural fees have not been included*

*References to persons in these Rules of procedure may apply to women as well as to men.*

*For all written pleadings, parties will have to make use of forms available on-line (see Rule 4). Where a Rule lists the contents of pleadings, the sign \* recalls that a form will be available to guide parties.*

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## **PREAMBLE**

The Court shall conduct proceedings in accordance with the Agreement on a Unified Patent Court (“the Agreement”), the Statute of the United Patent Court (“the Statute”) and these Rules of Procedure. In the event of a conflict between the provisions of the Agreement and/or the Statute on the one hand and of the Rules of Procedure on the other hand, the provisions of the Agreement and/or the Statute shall prevail.

The Rules of Procedure shall be applied and interpreted in accordance with Articles 41(3), 42(1) and (2) and 52(1) of the Agreement on the basis of the principles of proportionality, flexibility, fairness and equity.

Proportionality shall be ensured by giving due consideration to the nature and complexity of each case and its importance.

Flexibility shall be ensured by applying all procedural rules in a flexible and balanced manner with the required level of discretion for the judges to organize the proceedings in the most efficient and cost effective manner.

Fairness and equity shall be ensured by having regard to the legitimate interests of all parties.

In accordance with these principles, the Court shall apply and interpret the Rules of Procedure in a way which will ensure decisions of the highest quality.

In accordance with these principles, proceedings shall be conducted in a way which will normally allow the final oral hearing on the issues of infringement and validity at first instance to take place within one year whilst recognising that complex cases may require more time and procedural steps and simple cases less time and less procedural steps. Decisions on costs and/or damages may take place at the same time or as soon as practicable thereafter. Case management shall be organised in accordance with these objectives. Parties shall cooperate with the Court and set out their full case as early as possible in the proceedings.

The Court shall endeavour to ensure consistent application and interpretation of these Rules of Procedure by all first instance divisions and the Court of Appeal. Due consideration shall be given to this objective in any decision concerning leave to appeal against procedural orders.

## **APPLICATION AND INTERPRETATION OF THE RULES OF PROCEDURE**

### **Rule 1 – Application of the Rules of Procedure**

1. The Court shall conduct proceedings in accordance with the Agreement on a Unified Patent Court (“the Agreement”), the Statute of the Unified Patent Court (“the Statute”) and these Rules of Procedure. In the event of a conflict between the provisions of the Agreement and/or the Statute on the one hand and of the Rules of Procedure on the other hand, the provisions of the Agreement and/or the Statute shall prevail.

2. Where these Rules provide for the Court to perform any act other than an act exclusively reserved for a panel of the Court, the President of the Court of First Instance or the President of the Court of Appeal, that act may be performed by

- (a) the presiding judge or the judge-rapporteur of the panel to which the case has been assigned,
- (b) a single legally qualified judge where the case has been assigned to a single judge,
- (c) the standing judge designated pursuant to Rule 345.

*Relation with draft Agreement: Article 8(7)*

*Relation with draft Statute: Article 19*

### **Rule 2 – Supplementary protection certificate**

1. Subject to paragraph 2, in these Rules of Procedure the expression “patent” and “proprietor” shall whenever appropriate include, respectively, a supplementary protection certificate as defined in Article 2(h) of the Agreement and granted in respect of the patent and the proprietor of such certificate.

2. References in these Rules of Procedure to the language in which the patent was granted shall mean that language and not the language in which a supplementary certificate in respect of the patent was granted.

### **Rule 3 – Power of staff of the Registry and a sub-registry to perform functions of the Registry**

Where these Rules refer to the Registry and provide for the Registry to perform any act that reference shall include the relevant sub-registry and that act may be performed by a member of staff of the Registry or relevant sub-registry.



#### **Rule 4 – Lodging of documents**

Written pleadings and other documents shall be lodged at the Registry in electronic form. Parties shall make use of the official forms available on-line.

*Relation with draft Agreement: Article 44*

#### **Rule 5 – Lodging of an Application to opt out and withdrawal of an opt out**

1. A person wishing to opt out of the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall lodge an Application with the Registry.

2. The \*Application to opt out shall contain:

(a) the name of the proprietor or proprietors or applicant or applicants for the patent (or patents) or application (or applications) in question and all relevant postal and, where applicable, electronic addresses; and

(b) details of the patent (or patents) and/or application (or applications) concerned including the number (or numbers), and in the case of patents the designated Contracting Member States concerned.

3. The Registrar shall as soon as practicable enter the Application to opt out in the register. Subject to paragraph 4, the opt out shall be regarded as effective from the date of entry in the register.

4. In the event that an action has been commenced in respect of a patent (or patents) and/or an application (or applications) contained in an Application to opt out prior to the date of entry of the Application in the register the Registrar shall notify the applicant of such action as soon as practicable and the Application for opt out shall be ineffective in respect of the patent (or patents) and or application (or applications) in question.

5. A person who has lodged an Application to opt out pursuant to this Rule may lodge an \*Application to withdraw the opt out in respect of any patent or application. The Application shall contain the particulars in accordance with Rule 5.2. The Registrar shall as soon as practicable enter the Application for withdrawal in the register and the withdrawal shall be regarded as effective from the date of entry in the register.

6. The Registrar shall as soon as practicable notify the European Patent Office of the entries in the register pursuant to paragraph 3 and 5.

*Relation with draft Agreement: Article 83(3) and (4)*

## **Rule 6 – Service and supply of orders, decisions, written pleadings and other documents**

1. The Registry shall as soon as practicable serve, in accordance with Part 5, Chapter 2,
  - (a) orders and decisions of the Court on the parties,
  - (b) written pleadings of a party on the other party.

Where applicable, the Registry shall inform the parties of the opportunity to reply or to take any other appropriate step in the proceedings and of any time period for so doing.

2. The Registry shall also as soon as practicable supply to the parties copies of documents referred to in and lodged with pleadings and written evidence.

3. Where the postal or electronic address for service provided by a party pursuant to these Rules has changed that party shall give notice in writing to the Registry and to every other party as soon as such change has taken place.

## **Rule 7 – Language of written pleadings and written evidence**

Written pleadings and other documents, including written evidence, shall be lodged in the language of the proceedings, unless the Court or these Rules otherwise provide.

## **Rule 8 – Party and party's representative**

1. A party shall be represented in accordance with Article 48 of the Agreement unless otherwise provided by these Rules of Procedure [Rules 88.5 and 378.5].

2. For the purpose of all proceedings in relation to a patent, where these Rules of Procedure provide that a party perform any act or that any act be performed upon a party that act shall be performed by or upon the representative for the time being of the party.

*Relation with draft Agreement: Article 24*

## **Rule 9 – Powers of the Court**

1. The Court may, at any stage of the proceedings, of its own motion or on reasoned request by a party, order a party to take any step, answer any question or provide any clarification or evidence, within time periods to be specified.
2. The Court may disregard any step, fact, evidence or argument which a party has not submitted in due time.
3. Subject to paragraph 4, on a reasoned request by a party, the Court may extend, even retrospectively, a time period referred to in these Rules or imposed by the Court. Subject as aforesaid the Court may also on a reasoned request by a party shorten any such time period.
4. The Court shall not extend or shorten the time periods referred to in Rule 224.1.

## **PART 1 – PROCEDURES BEFORE THE COURT OF FIRST INSTANCE**

### **Rule 10 – Stages of the proceedings (*inter partes* proceedings)**

Proceedings before the Court of First Instance shall consist of the following stages:

- (a) a written procedure;
- (b) an interim procedure, which may include an interim conference with the parties;
- (c) an oral procedure which, subject to Rules 116.1 and 117, shall include an oral hearing of the parties where necessary;
- (d) a procedure for the award of damages;
- (e) procedures for cost orders.

*Relation with draft Agreement: Articles 52(1), 68 and 69*

### **Rule 11 – Settlement**

1. At any stage of the proceedings, if the Court is of the opinion that the dispute is suitable for a settlement, it may propose that the parties make use of the facilities of the Patent Mediation and Arbitration Centre (“the Centre”) in order to settle or to explore a settlement of the dispute. In particular the judge-rapporteur shall at the interim conference in accordance with Rule 104(d) explore with the parties the possibility of a settlement, including through mediation and/or arbitration, using the facilities of the Centre.

2. Pursuant to Rule 365 the Court shall by order confirm the terms of any settlement, including a term which obliges the patent owner to limit, surrender or agree to the revocation of a patent or not to assert it against the other party and/or third parties. The parties may agree on costs to be awarded or may request the Court to decide on costs to be awarded in accordance with Rules 150 to 156 *mutatis mutandis*.

3. No opinion expressed, suggestion made, proposal put forward, concession made or document drawn up for the purposes of settlement may be relied on as evidence by the Court or the parties in proceedings before the Court or any other court unless such matter was expressed to be made on an open basis and freely disclosable to the Court or any other court.

*Relation with draft Agreement: Articles 35, 52(2) and 79*

## **CHAPTER 1 – WRITTEN PROCEDURE**

### **SECTION 1 – INFRINGEMENT ACTION**

#### **Rule 12 – Exchange of written pleadings (infringement action)**

1. The written procedure shall consist of
  - (a) the lodging of a Statement of claim (by the plaintiff) [Rule 13]
  - (b) the lodging of a Statement of defence (by the defendant) [Rules 23 and 24] and, optionally
  - (c) the lodging of a Reply to the Statement of defence (by the plaintiff) [Rule 29] and
  - (d) the lodging of a Rejoinder to the Reply (by the defendant) [Rule 29].
2. The Statement of defence may include a Counterclaim for revocation [Rule 25.1].
3. If a Counterclaim for revocation is lodged, the plaintiff shall lodge a Defence to the Counterclaim for revocation [Rule 29], the defendant may lodge a Reply to the Defence to the Counterclaim [Rule 51] and the plaintiff may lodge a Rejoinder to the Reply to the Defence to the Counterclaim [Rule 52]. The Defence to the Counterclaim may include an Application to amend the patent [Rule 30].
4. If an Application to amend the patent is lodged, the defendant shall lodge a Defence to the Application to amend the patent in the Reply to the Defence to the Counterclaim, the plaintiff may lodge a Reply to the Defence to the Application to amend and the defendant may lodge a Rejoinder to such Reply [Rule 32].
5. The judge-rapporteur may allow the exchange of further written pleadings, within time periods to be specified [Rule 36].

## STATEMENT OF CLAIM

### Rule 13 – Contents of the Statement of claim

1. The plaintiff shall lodge a \*Statement of claim with the division chosen by him (Article 33 of the Agreement) which shall contain
  - (a) the names of the plaintiff and of the plaintiff's representative,
  - (b) the name of the party against whom the Statement is made (the defendant),
  - (c) postal and electronic addresses for service on the plaintiff and the names of the persons authorised to accept service,
  - (d) postal and, where available, electronic addresses for service on the defendant and the names of the persons authorised to accept service,
  - (e) where the plaintiff is not the proprietor or not the only proprietor of the patent (or patents) concerned, postal and where available, electronic addresses for service on each proprietor and the names of the persons authorised to accept service, if known, [Article 47(2) and (4) of the Agreement]
  - (f) where the plaintiff is not the proprietor of the patent (or patents) concerned, evidence to show the plaintiff is entitled to commence proceedings [Article 47(2) and (3) of the Agreement],
  - (g) details of the patent (or patents) concerned, including the number (or numbers),
  - (h) where applicable, information about any prior or pending proceedings relating to the patent (or patents) concerned before the Court including any action for revocation or a declaration of non-infringement pending before the central division and the date of any such action, the European Patent Office or any other court or authority,
  - (i) an indication of the division which shall hear the case [Article 33(1) to (6) of the Agreement] with an explanation of why that division has competence; where the parties have agreed in accordance with Article 33(7) of the Agreement, the indication of the division which shall hear the case shall be accompanied by evidence of the defendant's agreement,
  - (j) where applicable, an indication that the case shall be heard by a single judge [Article 8(7) of the Agreement], accompanied by evidence of the defendant's agreement,
  - (k) the nature of the claim, the order or the remedy sought by the plaintiff,
  - (l) an indication of the facts relied on, in particular
    - (i) one or more instances of alleged infringements or threatened infringements specifying the date and place of each,
    - (ii) the identification of the patent claims alleged to be infringed,
  - (m) the evidence relied on [Rule 170.1], where available, and an indication of any further evidence which will be offered in support,
  - (n) the reasons why the facts relied on constitute infringements of the patent claims, including arguments of law and where appropriate an explanation of the proposed claim interpretation,
  - (o) an indication of any order the plaintiff will seek during the interim procedure [Rule 104(e)]
  - (p) where the plaintiff assesses that the value of the infringement action exceeds [EUR\*\*\*], an indication of the value,
  - (q) a list of the documents referred to in the Statement of Claim together with any request that all or part of any such document need not be translated.

2. The plaintiff shall at the same time supply a copy of each of the documents referred to in the Statement of Claim.
3. The judge-rapporteur shall decide on any request made pursuant to Rule 13.1(q) as soon as practicable.

#### **Rule 14 – Language of the Statement of claim**

1. The Statement of claim shall be drawn up
  - (a) in one of the languages of the local division or regional division
    - (i) which the plaintiff has chosen in accordance with Article 33 of the Agreement or
    - (ii) which the parties have agreed to bring the action before in accordance with Article 33(7) of the Agreement, or
  - (b) in the language in which the patent was granted
    - (i) where the central division shall hear the case in accordance with Article 33 of the Agreement or
    - (ii) where a Request to use the language in which the patent was granted as language of the proceedings is lodged in accordance with Rules 321 or 323 together with the Statement of claim.
  - (c) in an official language of the European Patent Office designated as the language of proceedings by a Contracting Member State pursuant to Article 49(2) of the Agreement.
2. The language in which the Statement of claim is drawn up shall be the language of the proceedings, without prejudice to Article 49(3), (4) or (5) of the Agreement or Rules 13.3, 321, 322 or 323.
3. The plaintiff may lodge a translation of the Statement of claim in an official language of the State where the defendant has his residence, or principal place of business or, in the absence of residence or principal place of business, place of business and request that the translation be served on the defendant.

*Relation with draft Agreement: Article 49*

#### **Rule 15 – Fee for the infringement action**

1. The plaintiff shall pay the fixed fee for the infringement action in accordance with Part 6.
2. The Statement of claim shall not be deemed to have been lodged until the fixed fee for the infringement action has been paid, unless otherwise provided [Rule 371].

*Relation with draft Agreement: Articles 36(3), 70 and 71*

## **Rule 16 – Examination as to formal requirements of the Statement of claim**

1. The Registry shall as soon as practicable check whether one or more of the patents concerned is the subject of an opt-out pursuant to Article 83(3) of the Agreement. In the event of an opt-out the Registry shall as soon as practicable inform the plaintiff who shall withdraw or amend the Statement of claim as appropriate.
2. In the event that the patent(s) concerned are not the subject of an opt-out the Registry shall, as soon as practicable after the lodging of the Statement of claim, examine whether the requirements of Rules 13(a) to (j), 14 and 15.1 have been complied with.
3. If the plaintiff has not complied with the requirements referred to in paragraph 2, the Registry shall as soon as practicable invite the plaintiff to:
  - (a) correct the deficiencies within 14 days; and
  - (b) where applicable, pay the fee for the infringement action within 14 days.
4. The Registry shall at the same time inform the plaintiff that if the plaintiff fails to correct the deficiencies within the time stated a decision by default may be given, in accordance with Rule 355.
5. If the plaintiff fails to correct the deficiencies or pay the fee the Registry shall inform a judge of the division who may reject the action as inadmissible by a decision by default. He may give the plaintiff an opportunity to be heard beforehand.
6. The plaintiff may make an application to set aside the decision by default in accordance with Rule 356.

## **Rule 17 – Recording in the register (Court of First Instance, infringement action)**

1. If the requirements referred to in Rule 16.2 have been complied with, the Registry shall as soon as practicable,
  - (a) record the date of receipt of the Statement of claim and attribute a case number to the file,
  - (b) record the file in the register,
  - (c) inform the plaintiff of the case number of the file and the date of receipt,
2. The President of the Court of First Instance or such judge of a division to whom the President has delegated this task shall assign the case to a panel. Unless otherwise agreed by the panel the most senior judge shall be the presiding judge.
3. The action shall be regarded as pending before the Court as from the date of receipt attributed to the Statement of claim.

*Relation with draft Agreement: Articles 10*



## **Rule 18 – Designation of the judge-rapporteur**

The presiding judge of the panel to which the case has been assigned [Rule 17.2] shall designate one legal judge of the panel as judge-rapporteur. The presiding judge may designate himself as judge-rapporteur. The Registry shall as soon as practicable notify the plaintiff and defendant of the identity of the judge-rapporteur.

## **PROCEDURE WHEN THE DEFENDANT RAISES A PRELIMINARY OBJECTION**

### **Rule 19 – Preliminary objection**

1. Within one month of service of the Statement of claim, the defendant may lodge a Preliminary objection concerning
  - (a) the jurisdiction and competence of the Court,
  - (b) the competence of the division indicated by the plaintiff [Rule 13.1(i)],
  - (c) the language of the Statement of claim [Rule 14].
2. A \*Preliminary objection shall contain
  - (a) particulars in accordance with Rule 24.1(a) to (c),
  - (b) the decision or order sought by the defendant,
  - (c) the grounds upon which the Preliminary objection is based,
  - (d) where appropriate the facts and evidence relied on.
3. The Preliminary objection shall be drawn up
  - (a) in the language of the proceedings [Rule 14.2] or
  - (b) in an official language of the Contracting Member State where the defendant has his residence, or principal place of business, or in the absence of residence or principal place of business, place of business.
4. The Registry shall as soon as practicable invite the plaintiff to comment on the Preliminary objection. Where applicable, the plaintiff may of his own motion correct any deficiency [Rule 19.1(b) or (c)], within 14 days of service of notification of the Preliminary objection. Alternatively the plaintiff may submit written comments within the same period. The judge-rapporteur shall be informed of any correction made or written comments submitted by the plaintiff.
5. The period for lodging the Statement of defence [Rule 23] shall not be affected by the lodging of a Preliminary objection, unless the judge-rapporteur decides otherwise.
6. The defendant's failure to lodge a Preliminary objection within the time period referred to in Rule 19.1 shall be treated as a submission to the jurisdiction and competence of the Court and the competence of the division chosen by the plaintiff.

*\* An on-line form will be available to guide parties*

## **Rule 20 – Decision or order on a Preliminary objection**

1. As soon as practicable after the expiry of the period referred to in Rule 19.4, the judge-rapporteur shall decide the Preliminary objection. The judge-rapporteur shall give the parties an opportunity to be heard. The decision shall include instructions to the parties and to the Registry concerning the next step in the proceedings.
2. Where the Preliminary objection is to be dealt with in the main proceedings, the judge-rapporteur shall inform the parties.

## **Rule 21 – Appeal against decision or order on a Preliminary objection**

1. An appeal against a decision or order under Rule 20 may only be lodged with the permission of the judge-rapporteur or, if permission is refused, with permission of the Court of Appeal. The appeal shall be dealt with as an urgent matter by the Court of Appeal.
2. If an appeal is lodged, proceedings at first instance may be stayed by the judge-rapporteur or the Court of Appeal on a reasoned request by a party.
3. Rule 19.5 shall apply *mutatis mutandis*.

## **VALUE-BASED FEE FOR THE INFRINGEMENT ACTION**

### **Rule 22 – Value-based fee for the infringement action**

1. The value of the infringement action shall be determined by the judge-rapporteur where the value of the dispute is assessed by one or both parties as exceeding [EUR\*\*\*] by way of order during the interim procedure.
2. Where the value of the infringement action exceeds [EUR\*\*\*], the plaintiff shall pay a value-based fee for the infringement action, in accordance with Part 6 [Rules 370.2(b) and 371.4].

## STATEMENT OF DEFENCE

### Rule 23 – Lodging of the Statement of defence

The defendant shall lodge a Statement of defence within three months of service of the Statement of claim. The period may be extended by the judge-rapporteur on a reasoned request by the defendant.

### Rule 24 – Contents of the Statement of defence

1. The \*Statement of defence shall contain

- (a) the names of the defendant and of the defendant's representative,
- (b) postal and electronic addresses for service on the defendant and the names of the persons authorised to accept service,
- (c) the case number of the file,
- (d) an indication whether the defendant has lodged a Preliminary objection [Rule 19],
- (e) an indication of the facts relied on, including any challenge to the facts relied on by the plaintiff,
- (f) the evidence relied on [Rule 170.1], where available, and an indication of any further evidence which will be offered in support,
- (g) the reasons why the action shall fail, arguments of law including any assertion that the patent (or patents) concerned is (are) invalid and any argument arising from the provisions of Article 28 of the Agreement and where appropriate any challenge to the plaintiff's proposed claim interpretation.
- (h) an indication of any order the defendant will seek in respect of the infringement action during the interim procedure [Rule 104(e)].
- (i) a statement whether the defendant disputes the plaintiff's assessment of the value of the infringement action and the grounds for such dispute
- (j) a list of the documents referred to in the Statement of Defence together with any request that all or part of any such document need not be translated. Rule 13.3 shall apply *mutatis mutandis*.

2. The defendant shall at the same time supply a copy of each of the documents referred to in the Statement of Defence.

## **Rule 25 – Counterclaim for revocation**

1. If the Statement of defence includes an assertion that the patent (or patents) alleged to be infringed is (are) invalid the Statement of defence shall include a \*Counterclaim for revocation of the patent or patents. The Counterclaim for revocation shall contain:

- (a) an indication of the extent to which revocation of the patent or patents is requested,
- (b) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the defendant's proposed claim construction.
- (c) an indication of the facts relied on,
- (d) the evidence relied on, where available, and an indication of any further evidence which will be offered in support,
- (e) an indication of any order the defendant will seek during the interim procedure [Rule 104(e)].
- (f) where the defendant assesses that the value of the dispute including the Counterclaim exceeds the value of the infringement action by more than [EUR\*\*\*] an indication of the value of the dispute including the Counterclaim.
- (g) a statement of his position, if any, on the options provided for in Article 33(3)(a), (b) or (c) of the Agreement.
- (h) a list of the documents referred to in the Counterclaim for revocation together with any request that all or part of any such documents need not be translated. Rule 13.3 shall apply *mutatis mutandis*.

2. The defendant shall at the same time supply a copy of each of the documents referred to in the Counterclaim for revocation.

3. Where the plaintiff is not the proprietor of the patent (or patents) concerned the Registry shall as soon as practicable serve a copy of the Counterclaim for revocation on the proprietor(s) in accordance with Rule 13.1(e) and shall supply a copy of each document referred to in paragraph 2.

## **Rule 26 – Fee for the Counterclaim for revocation**

The defendant shall pay the fee for the Counterclaim for revocation in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

### **Rule 27 – Examination as to formal requirements of the Statement of defence**

1. The Registry shall, as soon as practicable after the lodging of the Statement of defence,
  - (a) examine whether the requirements of Rule 24.1(a) to (d) have been complied with
  - (b) if the Statement of defence includes a Counterclaim for revocation, examine whether the requirements of Rules 25(a) and (b) and the obligation to pay the fee pursuant to Rule 26 have been complied with.
2. If the Registry considers that the Statement of defence or the Counterclaim for revocation does not comply with any of the requirements referred to in paragraph 1, it shall as soon as practicable invite the defendant to
  - (a) correct the deficiencies noted, within 14 days,
  - (b) where applicable, pay the fee for the Counterclaim for revocation, within 14 days.
3. The Registry shall at the same time inform the defendant that if the defendant fails to correct the deficiencies or pay the fee within the time stated a decision by default may be given, in accordance with Rule 355.
4. If the defendant fails to correct the deficiencies or to pay the fee for the Counterclaim for revocation, as appropriate, within 14 days, the Registry shall inform the judge-rapporteur who may give a decision by default. He may give the defendant an opportunity to be heard beforehand.
5. The defendant may make an application to set aside the decision by default in accordance with Rule 356.

### **Rule 28 – Further schedule**

As soon as practicable after service of the Statement of defence, the judge-rapporteur shall, after consulting the parties set a date and time for an interim conference (where necessary, Rule 101.1) and set a date, and one alternative date, for the oral hearing.

**DEFENCE TO THE COUNTERCLAIM FOR REVOCATION AND REPLY TO THE STATEMENT OF THE DEFENCE AND APPLICATION TO AMEND THE PATENT**

**Rule 29 – Lodging of Defence to the Counterclaim for revocation and Reply to the Statement of defence**

1.(a) Within two months of service of a Statement of defence which includes a Counterclaim for revocation, the plaintiff shall lodge a Defence to the Counterclaim for revocation and may lodge a Reply to the Statement of defence.

(b) Within one month of service of a Statement of defence which does not include a Counterclaim for revocation, the plaintiff may lodge a Reply to the Statement of defence.

(c) Within one month of service of a Reply to the Statement of defence which does not include a Counterclaim for revocation the defendant may lodge a Rejoinder to the Reply to the Statement of defence.

(d) within one month of service of the Defence to Counterclaim the defendant may lodge a Rejoinder to the Defence to the Counterclaim together with any Defence to an Application to amend the claims pursuant to Rule 32, if applicable.

2. The Defence to the Counterclaim for revocation shall contain

(a) an indication of the facts relied on, including any challenge to the facts relied on by the defendant,

(b) the evidence relied on [Rule 170.1], where available, and an indication of any further evidence which will be offered in support,

(c) the reasons why the counterclaim for revocation shall fail, including arguments of law and any argument as to why any dependent claim of the patent (or patents) is independently valid.,

(d) an indication of any order the plaintiff will seek in respect of the revocation action at the interim conference [Rule 104(e)],

(e) the plaintiff's response to the defendant's choice of option, if any, provided for in Article 33(3)(a), (b) or (c) of the Agreement.

(f) the plaintiff's response to the defendant's assessment of the value of the disputes (including the Counterclaim) pursuant to Rule 25.1(f).

(g) a list of the documents referred to in the Defence to the Counterclaim together with any request that all or part of any such document shall not be translated. Rule 13.3 shall apply *mutatis mutandis*.

3. The plaintiff shall at the same time supply a copy of each of the documents referred to in the Defence to the Counterclaim.

4. The Rejoinder to the Reply to the Statement of defence shall be limited to a response to the matters raised in the Reply to the Statement of defence

### **Rule 30 – Application to amend the patent**

1. The Defence to the Counterclaim for revocation may include an \*Application by the proprietor of the patent to amend the patent which shall contain

(a) the proposed amendments of the claims of the patent concerned and/or specification, including where appropriate one or more alternative sets of claims (auxiliary requests), in the language in which the patent was granted; where the language of the proceedings [Rule 14.2] is not the language in which the patent was granted, the plaintiff shall lodge a translation of the proposed amendments in the language of the proceedings, and where the patent is a European patent with unitary effect in the language of the defendant's domicile if so requested by the defendant

(b) an explanation as to why the amendments satisfy the requirement of Articles 84 and 123(2) and (3) EPC and why the proposed amended claims are valid,

(c) an indication whether the proposals are conditional or unconditional; the proposed amendments, if conditional, must be reasonable in number in the circumstances of the case.

2. Any subsequent request to amend the patent may only be admitted into the proceedings with the permission of the Court.

### **Rule 31 – Value - based fee for the dispute including the Counterclaim for revocation<sup>1</sup>**

1. The value of the dispute (including the Counterclaim for revocation) shall be determined by the judge-rapporteur (where the said value is assessed by one or both parties to exceed the value of the infringement action by more than [EUR\*\*\*] by way of an order at the interim conference.

2. Where the value of the dispute including the Counterclaim for revocation exceeds the value of the infringement action as agreed or ordered by the judge-rapporteur, the defendant shall pay a value-based fee for the excess in accordance with Part 6 [Rules 370.2(b) and 371.4].

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<sup>1</sup> Views received during the technical consultation on whether a defendant in an infringement action should pay a value-based fee for a counterclaim in addition to a fixed fee are mixed.

## **DEFENCE TO THE APPLICATION TO AMEND THE PATENT**

### **Rule 32 – Lodging of the Defence to the Application to amend the patent, the Reply to the Defence and the Rejoinder to the Reply**

1. Within one month of service of an Application to amend the claims, the defendant shall lodge a \*Defence to the Application to amend the claims setting out whether he opposes the Application to amend the claims and, if so, why
  - (a) the proposed amendments are not allowable and
  - (b) the patent cannot be maintained as requested.
2. Where appropriate in view of the proposed amendments, the Defence to the Application to amend the claims may contain submissions in accordance with Rule 45(d) to (h) and alternative non-infringement submissions.
3. The plaintiff may lodge a Reply to the Defence to the Application to amend the claims within one month and the defendant may within one month lodge a Rejoinder to the Reply. The Rejoinder shall be limited to the matters raised in the Reply.

## **APPLICATION FOR ALLOCATING A TECHNICALLY QUALIFIED JUDGE TO THE PANEL**

### **Rule 33 – Application by a party for allocating a technically qualified judge<sup>2</sup>**

1. Any party to the proceedings may lodge an \*Application for allocating a technically qualified judge to the panel which shall contain an indication of the relevant field of technology.
2. The Application shall be lodged as early as possible in the written procedure. An Application lodged after the closure of the written procedure [Rule 35] shall only be granted if justified in view of changed circumstances, such as new submissions presented by the other party and allowed by the Court.
3. If the requirements of paragraphs 1 and 2 have been complied with, the President of the Court of First Instance shall allocate a technically qualified judge to the panel, after consulting the judge-rapporteur.

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<sup>2</sup> The drafting committee is of the view that the allocation of a technically qualified judge pursuant to Rule 33 should be discretionary. This would require an amendment to Article 8(5) of the draft Agreement.



#### **Rule 34 – Request by the judge-rapporteur for allocating a technically qualified judge**

1. The judge-rapporteur may at any time during the written procedure, after consulting the presiding judge and the parties, request the President of the Court of First Instance to allocate a technically qualified judge to the panel.
2. Where a technically qualified judge is allocated to the panel, the judge-rapporteur may at any time consult the technically qualified judge.

#### **LAST STEPS IN THE WRITTEN PROCEDURE**

#### **Rule 35 – Closure of the written procedure**

Following the exchange of written pleadings in accordance with Rule 12.1 and, where applicable, in accordance with Rule 12.2 to .4, the judge-rapporteur shall

- (a) inform the parties of the date on which he intends to close the written procedure, without prejudice to Rule 36,
- (b) where an interim conference is necessary (Rules 28 and 101.1), confirm the date and the time set for the interim conference [Rule 28] or inform the parties that an interim conference will not be held.

#### **Rule 36 – Further exchanges of written pleadings**

Without prejudice to the powers of the judge-rapporteur pursuant to Rule 110.1, on a reasoned request by a party lodged before the date on which the judge-rapporteur intends to close the written procedure [Rule 35(a)], the judge-rapporteur may allow the exchange of further written pleadings, within a period to be specified. Where the exchange of further written pleadings is allowed, the written procedure shall be deemed closed upon expiry of the specified period.

#### **Rule 37 – Application of Article 33(3) of the Agreement**

1. As soon as practicable after the closure of the written procedure the panel shall decide by way of order how to proceed, with respect to the application of Article 33(3) of the Agreement.
2. Where the panel decides to proceed in accordance with Article 33(3)(a) of the Agreement, the judge-rapporteur shall request the President of the Court of First Instance to allocate to the panel a technically qualified judge if not already allocated pursuant to Rules 33 and 34.
3. Where the panel decides to proceed in accordance with Article 33(3)(b) of the Agreement, the panel may stay the infringement proceedings pending a final decision in the revocation procedure and shall stay the infringement proceedings where there is a high likelihood that the relevant

claims of the patent (or patents) will be held to be invalid on any ground by the final decision in the revocation procedure.

## **COUNTERCLAIM FOR REVOCATION REFERRED TO THE CENTRAL DIVISION UNDER ARTICLE 33(3)(b) OF THE AGREEMENT**

### **Rule 38 – Written procedure when the central division deals with a Counterclaim for revocation**

When a Counterclaim for revocation is referred to the central division, it shall be dealt with as follows:

- (a) Rule 17.2 shall apply *mutatis mutandis*: the President of the Court of First Instance shall assign the Counterclaim for revocation to a panel of the central division in accordance with Article 7(2) of the Agreement and Annex II thereto. The parties may request that the Counterclaim be heard by a single legally qualified judge;
- (b) Rule 18 shall apply *mutatis mutandis*: the presiding judge of the panel to which the Counterclaim for revocation has been assigned shall designate one legally qualified judge of the panel as judge-rapporteur;
- (c) Rule 28 shall apply *mutatis mutandis*: the judge-rapporteur shall after consulting the parties set a date and a time for the interim conference (where necessary, Rules 28 and 101) and set a date, and one alternative date, for the oral hearing.

### **Rule 39 – Language of the proceedings before the central division**

1. Where the language of the proceedings before the regional division or the local division which referred the Counterclaim for revocation to the central division is not the language in which the patent was granted, the judge-rapporteur may order that the parties lodge, within a period of 21 days, a translation in the language in which the patent was granted of any written pleadings and such other documents lodged during the written procedure as the judge-rapporteur may direct. The period may be extended by the judge-rapporteur on a reasoned request by a party.
2. Where appropriate, the judge-rapporteur may specify in his order that only excerpts of parties' written pleadings and other documents shall be translated.
3. Where the language of the proceedings before the regional division or the local division is the language in which the patent was granted the pleadings served in accordance with Rules 24, 25, 29, 30 and 32 shall stand.

### **Rule 40 – Accelerated proceedings before the central division**

The judge-rapporteur shall accelerate proceedings before the central division where

- (a) an Application for provisional measures has been lodged [Rule 206], and/or
- (b) the regional division or the local division has referred the counterclaim for revocation to the central division.

**CASE REFERRED TO THE CENTRAL DIVISION UNDER ARTICLE 33(3)(c) AND 33(3)(b) OF THE AGREEMENT**

**Rule 41 – Written procedure when the central division deals with the case under Article 33(3)(c) of the Agreement**

When a case is referred to the central division under Article 33(3)(c) of the Agreement, it shall be dealt with as follows:

- (a) Rule 17.2 shall apply *mutatis mutandis*: the President of the Court of First Instance shall assign the case to a panel of the central division. The parties may request that the case be heard by a single judge;
- (b) Rule 18 shall apply *mutatis mutandis*: the presiding judge of the panel to which the case has been assigned shall designate one judge of the panel as judge-rapporteur;
- (c) dates already set under Rule 28 shall be confirmed wherever possible;
- (d) Rule 39 shall apply *mutatis mutandis*: the judge-rapporteur may order that the parties lodge a translation in the language in which the patent was granted of any written pleadings lodged during the written procedure; where appropriate, the judge-rapporteur may specify in his order that only excerpts of parties' written pleadings and other documents shall be translated. Otherwise the pleadings lodged during the written procedure shall stand.

**Rule 42 – Written procedure when the central division deals with the case under Article 33(3)(b) of the Agreement**

When a case is referred to in the central division under Article 33(3)(b) of the Agreement it shall be dealt with as follows:

- (a) Rule 17.2 shall apply *mutatis mutandis*: the President of the Court of First Instance shall assign the case to a panel of the central division. The parties may request that the case be heard by a single judge;
- (b) Rule 18 shall apply *mutatis mutandis*: the presiding judge of the panel to which the case has been assigned shall designate one judge of the panel as judge-rapporteur;
- (c) Where the language of proceedings before the regional division which referred the case to the central division is not the language in which the patent was granted, the judge-rapporteur may order the parties to lodge, within a period of 21 days, a translation in the language in which the patent was granted of any written pleadings and such other documents lodged during the written procedure prior to the referral of the case as the judge-rapporteur may direct. The period may be extended on a reasoned request by a party. Where appropriate the judge-rapporteur may specify in his order that only excerpts of the parties' written pleadings and other documents shall be translated;
- (d) Where the language of proceedings before the regional division is the language in which the patent was granted, the pleadings served before the referral of the case shall stand.
- (e) The judge-rapporteur shall give directions for any further pleadings to be lodged within periods to be specified;
- (f) The judge-rapporteur shall after consulting the parties set a time and date for an interim conference (where necessary, Rule 101) or confirm that the date already set under Rule 28.

## **SECTION 2 – REVOCATION ACTION**

### **Rule 43 – Action to be directed against the patent proprietor**

Any action for the revocation of a patent shall be directed against the proprietors of the patent (or patents).

*Relation with draft Agreement: Article 47(5)*

### **Rule 44 – Exchange of written pleadings (revocation action)**

1. The written procedure shall consist of
  - (a) the lodging of a Statement for revocation (by the plaintiff) [Rule 45] and
  - (b) the lodging of a Defence to revocation (by the defendant) [Rule 49] and optionally
  - (c) the lodging of a Reply to the Defence to revocation by the plaintiff [Rule 51]
  - (d) the lodging of a Rejoinder to the Reply by the defendant [Rule 52]
2. The Defence to revocation may include
  - (a) an Application to amend the patent and
  - (b) a Counterclaim for infringement by the proprietor of the patent or by an exclusive licensee of the proprietor.
3. If an Application to amend the patent is lodged, the defendant shall lodge a Defence to the Application to amend the patent.
4. If a Counterclaim for infringement is lodged, the plaintiff shall lodge a Defence to the Counterclaim for infringement [Rule 56], the defendant may lodge a Reply to the Defence to the Counterclaim [Rule 56.3] and the plaintiff may lodge a Rejoinder to the Reply [Rule 56.4].
5. Rule 12.5 shall apply.

## STATEMENT FOR REVOCATION

### Rule 45 – Contents of the Statement for revocation

1. The plaintiff shall, subject to point (b), lodge a \*Statement for revocation at the Registry in accordance with Article 7(2) of the Agreement and Annex II thereto. The Statement for revocation shall contain
  - (a) particulars in accordance with Rule 13.1(a) to (h),
  - (b) where the parties have agreed to bring the action before a regional division or a local division in accordance with Article 33(7) of the Agreement, an indication of the division which shall hear the case, accompanied by evidence of the defendant's agreement,
  - (c) where applicable, an indication that the case shall be heard by a single judge [Article 8(7) of the Agreement], accompanied by evidence of the defendant's agreement,
  - (d) an indication of the extent to which revocation of the patent (or patents) is requested,
  - (e) one or more grounds for revocation, which shall as far as possible be supported by arguments of law, and where appropriate an explanation of the plaintiff's proposed claim construction,
  - (f) an indication of the facts relied on,
  - (g) the evidence relied on, where available, and an indication of any further evidence which will be offered in support,
  - (h) an indication of any order the plaintiff will seek during the interim procedure [Rule 104(e)].
  - (i) where the plaintiff assesses that the value of the revocation action exceeds [EUR\*\*\*], an indication of the value,
  - (j) a list of the documents referred to in the Statement for revocation together with any request that all or part of any such document need not be translated. Rule 13.3 shall apply *mutatis mutandis*.
2. The plaintiff shall at the same time supply a copy of each of the documents referred to in the Statement for revocation.

### Rule 46 – Language of the Statement for revocation

1. Subject to paragraph 2, the Statement for revocation shall be drawn up in the language in which the patent was granted.
2. Where the parties have agreed to bring the action before a local or a regional division in accordance with Article 33(7) of the Agreement, the Statement for revocation shall be drawn up in one of the languages referred to in Rule 14.1(a)(ii) or (b)(ii) or (c).
3. Rule 14.2 and .3 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 49*

#### **Rule 47 – Fee for the revocation action**

The plaintiff shall pay the fee for the revocation action in accordance with Rule 57.2 and Part 6. Rule 15.2. shall apply *mutatis mutandis*.

*Relation with draft Agreement: Articles 70 and 71*

**Rule 16 on Examination as to formal requirements of the Statement of claim shall apply *mutatis mutandis***

#### **Rule 48 – Recording in the register (Court of First Instance, revocation action)**

1. Rule 17.1(a) to (c) and .2 shall apply *mutatis mutandis*.
2. The President of the Court of First Instance shall assign the case
  - (a) to a panel of the central division,
  - (b) where the parties have agreed that a single judge should hear the case, to a single judge or
  - (c) where the parties have agreed to bring the action before a local division or a regional division in accordance with Article 33(7) of the Agreement, to a panel of the local or regional division concerned.

*Relation with draft Agreement: Articles 10 and 33*

**Rule 18 on Designation of judge-rapporteur shall apply**  
**Rules 19, 20 and 21 on Procedure when the defendant raises a Preliminary objection shall apply *mutatis mutandis***

#### **DEFENCE TO REVOCATION**

#### **Rule 49– Lodging of the Defence to revocation**

1. The defendant shall lodge a Defence to revocation within three months of service of the Statement for revocation.
2. The Defence to revocation may include
  - (a) an Application to amend the patent,
  - (b) a Counterclaim for infringement.

### **Rule 50 – Contents of the Defence to revocation**

1. The \*Defence to revocation shall contain the matters referred to in Rule 24.1(a) to (c) and Rule 29.2. Rule 29.3 shall apply.
2. Any Application to amend the patent shall contain the matters referred to in Rule 30.1(a) to (c). Rule 29.2 shall apply.
3. Any Counterclaim for infringement shall contain the matters referred to in Rule 13.1(k) to (q) and where the defendant assesses that the value of the dispute including the Counterclaim for infringement exceeds the value of the revocation action by more than [EUR\*\*\*] an assessment of the value of the dispute including the Counterclaim. Rule 13.2 and .3 shall apply.

### **Rule 51 – Reply to Defence to revocation**

The plaintiff may lodge a Reply to the Defence to revocation within one month of service of the Defence to revocation.

### **Rule 52 – Rejoinder to the Reply**

The defendant may lodge a Rejoinder to the Reply to the Defence to Counterclaim within one month of the service of the Reply. The Rejoinder shall be limited to a response to the matters raised in the Reply.

### **Rule 53 – Fee for the Counterclaim for infringement**

The defendant shall pay the fee for the Counterclaim for infringement in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

**Rule 27 on Examination as to formal requirements of the Statement of defence shall apply *mutatis mutandis***

**Rule 28 on Further schedule shall apply *mutatis mutandis***

### **DEFENCE TO THE APPLICATION TO AMEND THE PATENT AND DEFENCE TO THE COUNTERCLAIM FOR INFRINGEMENT**

**Rule 32 on Lodging of the Defence to the Application to amend the patent shall apply *mutatis mutandis***



### **Rule 56 – Lodging of the Defence to the Counterclaim for infringement**

1. Within one month of service of a Counterclaim for infringement, the plaintiff shall lodge a Defence to the Counterclaim for infringement. The period may be extended by the judge-rapporteur on a reasoned request by the plaintiff.
2. The Defence to the Counterclaim shall contain the matters referred to in Rule 24.1(e) to (h) and (j) and a statement whether the plaintiff disputes the defendant's assessment of the value of the dispute (including the Counterclaim) pursuant to Rule 50.3 and the reasons for such dispute. Rule 24.2 shall apply.
3. The defendant may lodge a Reply to the Defence to the Counterclaim for infringement within one month.
4. The plaintiff may lodge a Rejoinder to the Reply within one month of the service of the Reply. The Rejoinder shall be limited to matters raised in the Reply.

**Rules 33 and 34 on Request for allocating a technically qualified judge** shall apply where the revocation action is heard by local division or regional division  
**Rule 35 on Closure of the written procedure** shall apply *mutatis mutandis*  
**Rule 36 on Further exchanges of written pleadings** shall apply

### **Rule 57 – Value-based fee for the revocation action**

1. The value of the revocation action shall be determined by the judge-rapporteur (where the value of the dispute is assessed by one or both parties as exceeding [EUR\*\*\*]) by way of an order at the interim conference.
2. Where the value of the revocation action exceeds [EUR\*\*\*] the plaintiff shall pay a value-based fee for the revocation action in accordance with Part 6 [Rules 370.2(b) and 371.4].

**Rule 58 – Value-based fee for the dispute (including the Counterclaim for infringement)**

1. The value of the dispute including the Counterclaim for infringement shall be determined by the judge-rapporteur where the said value is assessed by one or both parties to exceed the value of the revocation action by more than [EUR\*\*\*] by way of an order at the interim conference.
2. Where the value of the dispute including the Counterclaim for infringement exceeds the value of the revocation action as agreed or ordered by the judge-rapporteur, the defendant shall pay a value-based fee for the excess in accordance with Part 6 [Rules 370, 2(b\)) and 371.4].

## **SECTION 3 – ACTION FOR DECLARATION OF NON-INFRINGEMENT**

### **Rule 60 – Declaration of non-infringement**

1. A declaration that the performance of a specific act does not, or a proposed act would not, constitute an infringement of a patent may be made by the Court in proceedings between the person doing or proposing to do the act and the patent proprietor or licensee entitled to commence infringement proceedings pursuant to Article 47 of the Agreement, if the patent proprietor or such licensee has asserted that the act is an infringement, or, if no such assertion has been made by the patent proprietor or licensee, if

(a) that person has applied in writing to the proprietor or licensee for a written acknowledgment to the effect of the declaration claimed, and has provided him with full particulars in writing of the act in question and

(b) the proprietor or licensee has refused or failed to give any such acknowledgment within one month.

2. The action for a declaration shall be directed against the proprietor of the patent or the licensee who has asserted an infringement or refused or failed to give an acknowledgement pursuant to paragraph 1(b).

### **Rule 61 – Exchange of written pleadings (action for declaration of non-infringement)**

1. The written procedure shall consist of

(a) the lodging of a Statement for a declaration of non-infringement (by the plaintiff) [Rule 62],

(b) the lodging of a Defence to the Statement for a declaration of non-infringement (by the defendant) [Rules 65-66].

(c) the lodging of a Reply to the Defence to the Statement for a declaration of non-infringement [Rule 67].

(d) the lodging of a Rejoinder to the Reply [Rule 67].

2. The Defence to the Statement for a declaration of non-infringement may include a Counterclaim for infringement [Rule 66.2].

3. If a Counterclaim for infringement is lodged, the plaintiff shall lodge a Defence to the Counterclaim for infringement [Rule 67].

4. Rule 12.5 shall apply.

## **Rule 62 – Contents of the Statement for a declaration of non-infringement**

1. The plaintiff shall, subject to point (b), lodge at the Registry in accordance with Article 7(2) of the Agreement and Annex II thereto, a \*Statement for a declaration of non-infringement which shall contain

- (a) particulars in accordance with Rule 13.1(a) to (h),
- (b) where the parties have agreed to bring the action before a local division or a regional division in accordance with Article 33(7) of the Agreement, an indication of the division which shall hear the case, accompanied by evidence of the defendant's agreement,
- (c) where applicable, an indication that the case shall be heard by a single judge [Article 8(7) of the Agreement], accompanied by evidence of the defendant's agreement,
- (d) the declaration sought by the plaintiff,
- (e) the reasons why the performance of a specific act does not, or a proposed act would not, constitute an infringement of the patent or patents concerned, including arguments of law and where appropriate on explanation of the plaintiff's proposed claim construction,
- (f) an indication of the facts relied on,
- (g) the evidence relied on, where available, and an indication of any further evidence which will be offered in support,
- (h) an indication of any order the plaintiff will seek at the interim conference [Rule 104(e)],
- (i) where the plaintiff assesses that the value of the declaratory action exceeds [EUR\*\*\*], an indication of the value,
- (j) a list of the documents referred to in the Statement for a declaration together with any request that all or part of any such document need not be translated. Rule 13.3 shall apply *mutatis mutandis*.

2. The plaintiff shall at the same time supply a copy of each of the documents referred to in the Statement for a declaration.

**Rules 46, 47 and 48 relating to the Statement for revocation** shall apply *mutatis mutandis*  
**Rules 16 and 17 on Examination as to formal requirements of the Statement of claim and Recording on the register** shall apply *mutatis mutandis*  
**Rule 18 on Designation of the judge-rapporteur** shall apply *mutatis-mutandis*  
**Rules 19, 20 and 21 on Procedure when the defendant raises a Preliminary objection** shall apply *mutatis mutandis*

## **Rule 65 – Lodging of the Defence to the Statement for a declaration of non-infringement**

The defendant shall lodge a Defence to the Statement for a declaration of non-infringement within two months of service of the Statement for a declaration of non-infringement. The period may be extended by the judge-rapporteur on a reasoned request by the defendant.

#### **Rule 66 – Contents of the Defence to the Statement for a declaration of non-infringement**

1. The \*Defence to the Statement for a declaration of non-infringement shall contain the matters referred to in Rule 24.1(a) to (h) and a statement whether the defendant disputes the plaintiff's assessment of the value of the declaratory action and the grounds for such dispute.
2. Where the Defence to the declaration of non-infringement includes a Counterclaim for infringement, it shall contain submissions in accordance with Rule 13.1(k) to (o) and (q). Rule 13.2 and .3 shall apply *mutatis mutandis*.

#### **Rule 67 – Reply to Defence to the Statement for a declaration of non-infringement and Defence to Counterclaim and Rejoinder to the Reply**

1. The plaintiff may lodge a Reply to the Defence to the Statement for a declaration of non-infringement and shall lodge a Defence to Counterclaim within one month.
2. The defendant may lodge a Rejoinder to the Reply within one month of service of the Reply. The Rejoinder shall be limited to the matters raised in the Reply.

#### **Rule 68 – Fee for the action for a declaration of non-infringement**

The plaintiff shall pay the fee for the action for a declaration of non-infringement [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

**Rule 27 on Examination as to formal requirements of the Statement of defence** shall apply *mutatis mutandis*

**Rule 28 on Further schedule** shall apply *mutatis mutandis*

**Rules 33 and 34 on Request for allocating a technically qualified judge** shall apply where the action is heard by a regional division or a local division

**Rule 35 on Closure of the written procedure** shall apply *mutatis mutandis*

**Rule 36 on Further exchanges of written pleadings** shall apply

#### **Rule 69 – Value-based fee for the action for a declaration of non-infringement**

1. The value of the action for a declaration of non-infringement shall be determined by the judge-rapporteur where the value of the dispute is assessed by one or both parties as exceeding [EUR\*\*\*] by way of an order at the interim conference.
2. Where the value of the dispute exceeds [EUR\*\*\*] the plaintiff shall pay a value-based fee for the action for a declaration of non-infringement in accordance with Part 6 [Rules 370.2(b) and 371.4].

## **SECTION 4 – ACTIONS WITHIN ARTICLE 33(5) AND (6) OF THE AGREEMENT**

### **Rule 70 – Revocation actions and subsequent infringement actions in a local or regional division (Article 33(5) of the Agreement).**

1. Where a plaintiff has lodged a Statement for revocation (Rule 45) before the central division and the defendant subsequently initiates an infringement action in a local or regional division against the plaintiff in respect of the same patent (or patents) the following procedures shall apply.
2. The Registry at the local or regional division shall proceed in accordance with Rules 16 and 17. The Registry shall as soon as practicable notify the President of the Court of First Instance of the revocation action in the central division, the infringement action in the local or regional division and any counterclaim for revocation in the infringement action.
3. Unless otherwise agreed by the parties the President of the Court of First Instance shall require the panel appointed in the central division to hear the revocation action pursuant to Rule 48.2 to stay all further proceedings in the revocation action pending a decision of the panel hearing the action for infringement pursuant to Article 33(3) of the Agreement and Rule 37.
4. The panel hearing the action for infringement shall when exercising its discretion under Article 33(3) of the Agreement take into consideration how far the revocation action in the central division was advanced prior to the stay referred to in Rule 70.3.
5. Where the panel hearing the action for infringement decides to proceed in accordance with Article 33(3)(a) of the Agreement, Rules 33 to 36 shall apply *mutatis mutandis* to the action for infringement.
6. Where the panel hearing the action for infringement decides to proceed in accordance with Article 33(3)(b) or (c) of the Agreement, Rules 37.3, 38 to 40 or Rule 41 shall apply *mutatis mutandis*.

### **Rule 71 – Actions for declaration of non-infringement within Article 33(6) of the Agreement**

1. Where a plaintiff has lodged an action for declaration of non-infringement (Rule 62) before the central division against the patent proprietor or a licensee entitled to commence infringement proceedings pursuant to Article 47 of the Agreement and the defendant proprietor or licensee subsequently initiates an action for infringement in a local or regional division against the plaintiff in respect of the same patent or patents and with respect to the same alleged infringements the following procedure shall apply.
2. The Registry shall proceed in accordance with Rule 16 and 17. The Registry shall as soon as practicable notify the President of the Court of First Instance of the co-pending actions and the dates attributed to them.
3. If the date attributed by the Registry to the action for infringement pursuant to Rule 17.1(a) is within three months of the date attributed to the action for declaration of non-infringement the President of the Court of First Instance shall require the panel of the central division to stay all further proceedings in the action for a declaration. If the date attributed to the action for infringement is outside the said three month period there shall be no stay but the presiding judges of the central division and the local or regional division concerned shall consult to agree on the future progress of proceedings including the possibility of a stay of one action pursuant to Rule 295.1(h).

### **Rule 72 – Declaration of non-infringement and action for revocation**

An action for declaration of non-infringement may be lodged together with an action for revocation of the patent (or patents) in question.



**SECTION 5 – ACTION FOR COMPENSATION FOR LICENCES ON THE BASIS OF  
ARTICLE 8 OF REGULATION (EU) No 1257**

**Rule 80 – Compensation for a licence of right**

1. The application for appropriate compensation (Article 32(1)(h)) shall contain:
  - (a) particulars in accordance with Rule 13.1(a) to (d);
  - (b) information on the filing of the statement as referred to in Article 8(1) of Regulation (EU) No 1257/2012;
  - (c) the licence agreement referred to in Article 8(2) of Regulation (EU) No 1257/2012.
2. Rules 135 to 140 apply *mutatis mutandis* to the procedure for appropriate compensation.

*Relation with draft Agreement: Article 32(1)(h)*

## **SECTION 6 – ACTION AGAINST DECISIONS OF THE EUROPEAN PATENT OFFICE IN CARRYING OUT THE TASKS REFERRED TO IN ARTICLE 9 OF REGULATION (EU) No 1257/2012**

*Relation with draft Agreement: Articles 32(1)(i), 47(7) and 66*

### **Rule 85 – Stages of the proceedings (*ex parte* proceedings)**

Where an action is brought against a decision of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012 (hereinafter "decision of the Office"), proceedings before the Court of First Instance shall consist of

- (a) a written procedure, which shall include a possibility for interlocutory review by the European Patent Office;
- (b) an interim procedure, which may include an interim conference;
- (c), an oral procedure which, at the request of the plaintiff or at the instance of the Court, may include an oral hearing.

### **Rule 86 – Suspensive effect**

An action against a decision of the Office shall have suspensive effect.

### **Rule 87 – Grounds for annulling or altering a decision of the Office**

An action against a decision of the Office may be brought on grounds of

- (a) infringement of Regulation (EU) No 1257/2012 or of Regulation (EU) No 1260/2012 or of any rule of law relating to their application,
- (b) infringement of the implementing rules of the European Patent Office for carrying out the tasks referred to in Article 9(1) of Regulation (EU) No 1257/2012,
- (c) infringement of an essential procedural requirement,
- (d) misuse of power.

## **Rule 88 – Application to annul or alter a decision of the Office**

1. The plaintiff shall lodge an Application at the Registry, in accordance with Article 7(2) of the Agreement and Annex II thereto, to annul or alter a decision of the Office in the language in which the patent was granted, within two months of service of the decision of the Office.
2. The \*Application to annul or alter a decision of the Office shall contain
  - (a) the names of the plaintiff and, where applicable, of the plaintiff's representative;
  - (b) where the plaintiff is not the proprietor of the European patent with unitary effect, an explanation and evidence that he is adversely affected by the decision of the Office and entitled to start proceedings [Article 47(7) of the Agreement];
  - (c) postal and electronic addresses for service on the plaintiff and the names of the persons authorised to accept service;
  - (d) a reference to the contested decision of the Office;
  - (e) where applicable, information about any prior or pending proceedings relating to the patent concerned before the Court, the European Patent Office or any other court or authority;
  - (f) an indication whether the case shall be heard by a single judge;
  - (g) the order or the remedy sought by the plaintiff;
  - (h) one or more grounds for annulling or altering the contested decision, in accordance with Rule 87;
  - (i) the facts, evidence and arguments relied on.
  - (j) a list of the documents referred to in the Application together with any request that all or part of any such document need not be translated. Rule 13.3 shall apply *mutatis mutandis*.
3. The plaintiff shall at the same time supply a copy of each of the documents referred to in the Application
4. The plaintiff shall pay the fee for the action against a decision of the Office, in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.
5. Rule 8 shall not apply.

*Relation with draft Agreement: Articles 32(1)(i), 33(9), 47(7), 48(7) and 49(6)*

### **Rule 89 – Examination as to formal requirements (*ex parte* proceedings)**

1. The Registry shall, as soon as practicable after an Application to annul or alter a decision of the Office has been lodged, examine whether the requirements of Articles 47(7) and 49(6) of the Agreement and Rule 88.1, .2(a) to (d) and .4 have been complied with.
2. If the Registry considers that any of the requirements referred to in paragraph 1 has not been complied with, it shall invite the plaintiff to
  - (a) correct the deficiencies noted, within 14 days,
  - (b) where applicable, pay the fee for the action against a decision of the Office, within 14 days.
3. The Registry shall at the same time inform the plaintiff that if the plaintiff fails to correct the deficiencies within the time stated a decision by default may be given in accordance with Rule 355.
4. If the plaintiff fails to correct the deficiencies noted or to pay the fee for the action against a decision of the Office, the Registry shall inform the President of the Court of First Instance who may reject the action as inadmissible by a decision by default. He may give the plaintiff an opportunity to be heard beforehand.
5. The plaintiff may make an application to set aside the decision by default in accordance with Rule 356.

### **Rule 90 – Recording in the register (*ex parte* proceedings)**

If the requirements referred to in Rule 89.1 have been complied with, the Registry shall as soon as practicable

- (a) record the date of receipt of the Application to annul or alter a decision of the Office and attribute a case number to the file,
- (b) record the file in the register,
- (c) inform the plaintiff of the case number of the file and the date of receipt and
- (d) forward the Application to the European Patent Office, with an indicating that the Application is admissible.

### **Rule 91 – Interlocutory revision by the European Patent Office**

1. If the European Patent Office considers that the Application to annul or alter a decision of the Office is well founded, it shall within one month of the date of receipt of the Application  
(a) rectify the contested decision in accordance with the order or remedy sought by the plaintiff [Rule 882(g)] and  
(b) inform the Court that the decision has been rectified.

2. Where the Court is informed by the European Patent Office that the contested decision has been rectified, it shall inform the plaintiff that the case is closed. It may order full or partial reimbursement of the fee for the action against a decision of the Office, in accordance with Part 6.

### **Rule 92 – Assignment to panel or to single judge, designation of judge-rapporteur**

Where the case is not closed in accordance with Rule 91.2, the President of the Court of First Instance shall, as soon as practicable after the expiry of the period referred to in Rule 91.1, assign the case to a panel of the central division in accordance with Rule 17.2 or to a single judge if requested by the plaintiff [Rule 88.2(f)]. Rule 18 shall apply.

### **Rule 93 – Examination of the Application to annul or alter a decision of the Office**

1. In the examination of the Application to annul or alter a decision of the Office, the judge-rapporteur may invite the plaintiff to lodge further written pleadings, within a time period to be specified.

2. Where appropriate, the judge-rapporteur may, after consulting the plaintiff, set a date and time for an interim conference.

3. Rule 35 shall apply *mutatis mutandis*.

### **Rule 94 – Invitation to the President of the European Patent Office to comment**

The judge-rapporteur may, on his own initiative or on request by the President of the European Patent Office, invite the President of the European Patent Office to comment in writing on any question arising in the course of proceedings under this Section. The President shall not become party to the proceedings. The plaintiff shall be entitled to submit his observations on the President's comments.

**Rule 95 – *Lex specialis* for the interim procedure (*ex parte* procedure)**

During the interim procedure, the judge-rapporteur shall invite the plaintiff to indicate whether he wishes that an oral hearing be convened. The judge-rapporteur may convene an oral hearing at his own instance. Rules 111 to 118 shall apply *mutatis mutandis*.

**Rule 96 – *Lex specialis* for the oral procedure (*ex parte* procedure)**

If an oral hearing is not convened, the panel shall decide in accordance with Rule 117.

## **CHAPTER 2 – INTERIM PROCEDURE**

### **Rule 101 – Role of the judge-rapporteur (Case management)**

1. During the interim procedure, the judge-rapporteur shall make all necessary preparations for the oral hearing. He may in particular, where necessary, and subject to the mandate of the panel, hold an interim conference with the parties which may be held on more than one occasion.
2. The judge-rapporteur shall have the obligation to ensure a fair, orderly and efficient interim procedure.
3. Without prejudice to the principle of proportionality, the judge-rapporteur shall complete the interim procedure within three months of the closure of the written procedure.

*Relation with draft Agreement: Articles 43 and 52(2)*

### **Rule 102 – Referral to the panel**

1. The judge-rapporteur may refer any matter to the panel for decision and the panel may of its own motion review any decision or order of the judge-rapporteur or the conduct of the interim procedure.
2. Any party may request that a decision or order of the judge-rapporteur be referred to the panel for an early review pursuant to Rule 333. Pending review, the decision or order of the judge-rapporteur shall be effective.

### **Rule 103 – Preparation for the interim conference**

Whether or not the judge-rapporteur decides to hold an interim conference, he may order the parties, within time periods to be specified, to

- (a) provide further clarification on specific points,
- (b) answer specific questions,
- (c) produce evidence,
- (d) lodge specific documents including each party's summary of the orders sought at the interim conference.

## **INTERIM CONFERENCE**

### **Rule 104 – Aim of the interim conference**

The interim conference shall enable the judge-rapporteur to

- (a) identify main issues and determine which relevant facts are in dispute,
- (b) where appropriate, clarify the position of the parties as regards those issues and facts,
- (c) establish a schedule for the further progress of the proceedings,
- (d) explore with the parties the possibilities to settle the dispute or to make use of the facilities of the Centre,
- (e) where appropriate, issue orders regarding production of further pleadings, documents, experts (including court experts), experiments, inspections, further written evidence, the matters to be the subject of oral evidence and the scope of questions to be put to the witnesses.
- (f) where appropriate, but only in the presence of the parties, hold preparatory discussions with witnesses and experts with a view to properly preparing for the oral hearing.
- (g) make any other decision or order as he deems necessary for the preparation of the oral hearing including, after consultation with the presiding judge, an order for a separate hearing of witnesses and experts before the panel.
- (h) set a date for any separate hearing pursuant to point (g) of this Rule and confirm the date for the oral hearing.
- (i) decide the value of the particular dispute which value may, in exceptional cases, differ as between the parties depending upon the parties' individual circumstances.

*Relation with draft Agreement: Article 52(2)*

### **Rule 105 – Telephone conference and video conference**

1. The interim conference may be held by telephone conference or by video conference.
2. On request by a party and subject to the approval of the judge-rapporteur, the interim conference may be held in Court.
3. The judge-rapporteur may hold the interim conference in any language mastered by parties' representatives.



### **Rule 106 – Recording of the interim conference**

1. If the interim conference is held in court it shall be open to the public and shall be [audio / video] recorded. The recording shall be made publicly available after the hearing, subject to paragraph 2.
2. After hearing the parties, the judge-rapporteur may order that the proceedings of the interim conference or parts thereof shall not be recorded.

*Relation with draft Agreement: Articles 44 and 45*

### **PREPARATION FOR THE ORAL HEARING**

#### **Rule 108 – Summons to the oral hearing**

The judge-rapporteur shall summon the parties to the oral hearing which shall take place before the panel on the date(s) set under Rule 104(h). At least two months' notice shall be given, unless the parties agree to a shorter time period.

#### **Rule 109 – Simultaneous interpretation during oral hearings**

1. At the latest one month before the oral hearing including any separate hearing of witnesses and experts a party may lodge an \*Application for simultaneous interpretation which shall contain
  - (a) an indication of the language to or from which the party requests simultaneous interpretation during the oral hearing,
  - (b) the reasons for the Request,
  - (c) the field of technology concerned,
  - (d) any other information of relevance for the Request.
2. The judge-rapporteur shall decide whether and to what extent simultaneous interpretation is appropriate and shall, instruct the Registry to make all necessary arrangements for simultaneous interpretation. In the event that the judge-rapporteur refuses to order simultaneous interpretation the parties may request arrangements to be made, so far as practically possible, for simultaneous interpretation at their cost.
3. The judge-rapporteur may decide on his own motion to order simultaneous interpretation and shall instruct the Registry and inform the parties accordingly.
4. A party wishing to engage an interpreter at its own expense shall inform the Registry at the latest two weeks before the oral hearing.

*Relation with draft Agreement: Article 51(2)*

### **Rule 110 – Closure of the interim procedure**

1. As soon as the judge-rapporteur considers that the state of preparation of the file is adequate, he shall inform the presiding judge and the parties that the interim procedure is closed in view of the oral hearing.
2. Where final dates have been set the interim procedure shall be deemed closed on the last date set.
3. The oral procedure shall start immediately after the interim procedure is closed. The presiding judge shall, in consultation with the judge-rapporteur, take over the management of the case.

## **CHAPTER 3 – ORAL PROCEDURE**

### **Rule 111 – Role of the presiding judge (Case management)**

The presiding judge shall

- (a) have all authority to ensure fair, orderly and efficient oral procedure and
- (b) ensure that the case is ready for decision on the merits at the end of the oral hearing.

### **Rule 112 – Conduct of the oral hearing**

1. The oral hearing shall be held before the panel and shall be directed by the presiding judge.
2. The oral hearing shall consist of
  - (a) the hearing of the parties' oral submissions,
  - (b) if ordered during the interim procedure, the hearing of witnesses and experts under the control of the presiding judge.
3. The presiding judge and the judges of the panel may provide a preliminary introduction to the case and put questions to the parties, to the parties' representatives and to any witness or expert.
4. Under the control of the presiding judge, the parties may put questions to the witness or expert. The presiding judge may prohibit any question which is not designed to adduce admissible evidence.
5. With the consent of the Court a witness may give evidence in a language other than the language of proceedings.

*Relation with draft Agreement: Articles 52(3) and 53(1)(a)*

### **Rule 113 – Duration of the oral hearing**

1. Without prejudice to the application of principle of proportionality, the presiding judge shall endeavour to complete the oral hearing within one day. The presiding judge may set time limits for parties' oral submissions in advance of the oral hearing.
2. Oral testimony at the oral hearing or at any separate hearing shall be limited to issues identified by the judge-rapporteur or the presiding judge as having to be decided on the basis of oral evidence.
3. The presiding judge may, after consulting the panel, limit a party's oral submissions if the panel is sufficiently informed.

#### **Rule 114 – Adjournment where the Court considers that further evidence is required**

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

#### **Rule 115 – The oral hearing**

The oral hearing and any separate hearing of witnesses shall be open to the public unless the Court decides to make a hearing, to the extent necessary, confidential in the interests of one or both parties or third parties or in the general interests of justice or public order. The hearing shall be [audio / video] recorded. Rule 106 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 46*

#### **Rule 116 – Absence of a party from the oral hearing**

1. A party which does not wish to be present at the oral hearing shall inform the Registry in good time. Where both parties have informed the Registry that they do not wish to be present at the oral hearing, the Court may decide the case in accordance with Rule 117.
2. The Court shall not be obliged to delay any step in the procedure, including the decision on the merits, by reason only of the absence of a party from the oral hearing.
3. A party absent from the oral hearing shall be treated as relying only on its written case and not wishing to contest any new submission that the other party may be allowed to make at the oral hearing.
4. If due to an exceptional occurrence a party is prevented from attending the oral hearing, the Court shall upon a reasoned request of that party, adjourn the oral hearing.

#### **Rule 117 – Absence of both parties from the oral hearing**

Where both parties have informed the Registry that they do not wish to be present at the oral hearing the Court shall take a decision on the merits on the basis of the pleadings and evidence submitted by the parties and the court expert, if applicable, and otherwise in accordance with Rules 118 and 350 to 354.

## **Rule 118 – Decision on the merits**

1. Subject to the following provisions of this Rule, in addition to the orders and measures referred to in Articles 63, 64, 66, 67 and 80 of the Agreement the Court may, if requested, order the payment of damages and compensation according to Article 68 and 32(1)(f) of the Agreement. The amount of the damages and the compensation may be stated in the order or determined in separate proceedings (Rules 125-143). The Court may subject any order or measure to a security to be given by the successful party to the unsuccessful party as determined by the Court in accordance with Rule 352.

2. In appropriate cases and at the request of the party liable to the orders and measures provided for in paragraph 1 the Court may order damages and/or compensation to be paid to the injured party instead of applying the orders and measures if that person acted unintentionally and without negligence, if execution of the orders and measures in question would cause such party disproportionate harm and if damages and/or compensation to the injured party appear to the Court to be reasonably satisfactory.

3. If a revocation action is pending before the central division, the local or regional division:

- (a) may render its decision on the merits of the infringement claim, including its orders, under the condition subsequent pursuant to Article 56(1) of the Agreement that the patent (patents) is (are) not held to be wholly or partially invalid by the final decision in the revocation procedure or a final decision of the European Patent Office or under any other term or condition, or ,
- (b) may suspend the infringement proceedings pending a final decision in the revocation procedure or a final decision of the European Patent Office and shall suspend the infringement proceedings if it is of the view that there is a high likelihood that the relevant claims of the patent (or patents) will be held to be invalid on any ground by the final decision in the revocation procedure or of the European Patent Office.

4. Where, in the decision on the merits of a direct action or a counterclaim for revocation, the patent (or patents) is (are) found to be entirely or partially invalid, the Court shall revoke the patent (patents) entirely or partially according to Article 65 of the Agreement.

5. Where the Court has made orders in accordance with paragraph 3(a) any party may apply to the local or regional division within two months following a final decision of the central division or the Court of Appeal or the European Patent Office as the case may be for orders consequential on such final decision [Rule 354.4].

6. The Court shall decide in principle on the obligation to bear the legal costs in accordance with Article 69 of the Agreement.

7. The Court shall give the decision on the merits as soon as possible after the closure of the oral hearing. The Court shall endeavour to issue the decision on the merits in writing within six weeks of the oral hearing.

8. In exceptional cases the Court may give its decision immediately after the closure of the oral hearing and provide its reasons on a subsequent date.

9. The orders of the Court referred to in paragraphs 1 and 3 shall be enforceable on the defendant only after the plaintiff has notified the Court which part of the orders he intends to enforce and the said notice has been served on the defendant by the Registry.

*Relation with draft Agreement: Article 77*

## **CHAPTER 4 – PROCEDURE FOR THE DETERMINATION OF DAMAGES AND COMPENSATION**

*Relation with draft Agreement: Article 68*

### **Rule 125 – Separate proceedings for determining the amount of damages ordered**

1. The determination of the amount of damages ordered for the successful party may be the subject of separate proceedings. The determination shall include the determination of the amount of compensation, if any, to be awarded as a result of the provisional protection conferred by a published European patent application (Article 32(1)(f) of the Agreement, Article 67 EPC) and compensation to be paid pursuant to Rules 198.2, 118.5 and 213.2. The expression “damages” used in Chapter 4 shall be deemed to include such compensation and interest at the rate and for the period that the Court shall decide.

2. The Court may order an interim award of damages to the successful party in the decision on the merits, subject to any conditions that the Court may order. Such award shall at least cover the expected costs of the procedure for the award of damages and compensation on the part of the successful party.

### **Rule 126 – Start of proceedings for the determination of damages**

Where the successful party (hereinafter “the applicant”) wishes to have the amount of damages determined, it shall no later than one year from service of the final decision on the merits (including any appeal) on both infringement and validity (or in the case of assessment under Rules 198.2, 118.5 or 213.2 from the date of the order for such assessment) lodge an Application for the determination of damages including a request for an order to lay open books.

## **SECTION 1 – APPLICATION FOR THE DETERMINATION OF DAMAGES**

### **Rule 131 – Contents of the Application for the determination of damages**

1. The \*Application for the determination of damages shall contain
  - (a) particulars in accordance with Rule 13.1(a) to (d),
  - (b) the date of the decision on the merits and the case number of the file,
  - (c) if required a request for an order to lay open books (Rules 141 to 143) in which case the applicant shall provide the matters set out in Rule 141(b) to (e).
2. After any procedure for the laying open of books is complete, or if that has not been requested, the applicant shall indicate
  - (a) the redress (damages, licence fees, profits) and the interest thereon requested by him,
  - (b) an indication of the facts relied on, in particular calculations concerning lost profits or profits made by the unsuccessful party,
  - (c) the evidence relied on,
  - (d) a statement as to whether the decision on the merits is the subject of an appeal,
  - (e) his assessment of the value of the determination of damages.

### **Rule 132 – Fee for the Application for the determination of damages**

The applicant shall pay the fee for the determination of damages [EUR\*\*\*] in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

### **Rule 133 – Value-based fee for the determination of damages**

Where the value of the determination of damages is assessed by the applicant to exceed [EUR\*\*\*] the applicant shall pay a value-based fee for the determination of damages in accordance with Part 6 [Rules 370.2(b) and 371.4]<sup>3</sup>

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<sup>3</sup> In the technical consultation it has been questioned whether a value-based fee is appropriate where such a fee has already been paid in the original infringement proceedings.

**Rule 134 – Examination as to formal requirements of the Application for the determination of damages**

1. The Registry shall, as soon as practicable after the lodging of the Application for the determination of damages, examine whether the requirements of Rules 126, 131.1 and 132 have been complied with.
2. If the Application for the determination of damages does not comply with the requirements referred to in paragraph 1, the Registry shall invite the applicant to correct the deficiencies noted within a time period to be specified.
3. Rule 16.4 to .6 shall apply *mutatis mutandis*.

**Rule 135 – Recording in the register (Application for the determination of damages) and service**

1. If the requirements referred to in Rule 132.1 have been complied with, the Registry shall as soon as practicable,
  - (a) record the date of receipt to the Application for the determination of damages,
  - (b) record the Application in the register,
  - (c) inform the applicant of the date of receipt,
  - (d) inform the panel which has given the decision on the merits on infringement that an Application for the determination of damages has been lodged,
  - (e) serve the Application upon the unsuccessful party.
2. The panel which has given the decision on the merits shall be the panel for the determination of damages unless for any reason this is not possible or practical in which case the President of the Court at First Instance or such judge of a division to whom the President has delegated this task shall appoint a fresh panel. Rules 17.2 and 18 shall apply *mutatis mutandis*.

**Rule 136 – Stay of the Application for a determination of damages**

The Court may stay the Application for a determination of damages pending any appeal on the merits pursuant to Rule 295 on a reasoned request by the unsuccessful party. The applicant shall be given the opportunity to be heard. If the Court continues the proceedings on the Application it may order the applicant to render a security according to Rule 352.



### **Rule 137 – Reply of the unsuccessful party**

1. If the unsuccessful party accepts the claim made in the Application for the determination of damages, it shall within two months inform the Registry. The judge-rapporteur shall make the order for the determination of damages in accordance with the Application for the determination of damages.

2. If the unsuccessful party contests the claim made in the Application for the determination of damages, it shall within two months of service of the Application for the determination of damages lodge a Defence to the application for the determination of damages.

### **Rule 138 – Contents of the Defence to the application for the determination of damages**

The \*Defence to the Application for the determination of damages shall contain

- (a) the names of the unsuccessful party and of that party's representative,
- (b) postal and electronic addresses for service on the unsuccessful party and the names of the persons authorised to accept service,
- (c) the case number attributed to the file,
- (d) the reasons why the Application for the award of damages is contested,
- (e) an indication of the facts relied on,
- (f) the evidence relied on.

### **Rule 139 – Reply to the Defence for the determination of damages**

The applicant may within one month lodge a Reply to the Defence for the determination of damages limited to the matters raised in the Defence.

### **Rule 140 – Further procedure (Application for the determination of damages)**

1. The judge-rapporteur may order further exchange of written pleadings, within time periods to be specified.

2. The provisions of Part 1, Chapters 2 (Interim procedure) and 3 (Oral procedure) shall apply *mutatis mutandis* but with such reduced timetable as the judge-rapporteur may order. He shall decide on the obligation to bear the legal costs of the proceedings for the determination of damages in accordance with Article 69 of the Agreement.

## **SECTION 2 – REQUEST TO LAY OPEN BOOKS**

### **Rule 141 – Contents of the request to lay open books**

If the applicant has made a request pursuant to Rule 131.1(c), Rules 134 to 136 shall apply *mutatis mutandis*. The Request shall contain

- (a) particulars in accordance with Rule 131.1(a) and (b),
- (b) a description of the information held by the unsuccessful party to which the applicant requests access, in particular accounts, bank documents and any related document concerning the infringement,
- (c) the reasons why the applicant needs access to this information,
- (d) the facts relied on,
- (e) the evidence offered in support.

### **Rule 142 – Defence of the unsuccessful party and Reply to Defence**

1. If the unsuccessful party accepts the request to lay open books, it shall inform the Registry. The judge-rapporteur shall make the order to lay open books in accordance with the request to lay open books.
2. If the unsuccessful party contests the request to lay open books, it shall within one month of service of the request to lay open books lodge a Defence to the request to lay open books.
3. The applicant may within 14 days lodge a Reply to the Defence to lay open books.

**Rule 138 on Contents of the Defence to the application for the determination of damages** shall apply *mutatis mutandis*

**Rule 139 – Reply to the Defence for the determination of damages** shall apply *mutatis mutandis*.

**Rule 140 on Further procedure (Application for the determination of damages)** shall apply *mutatis mutandis*

### **Rule 143 – Decision on the Request to lay open books**

1. The Court may

(a) order the unsuccessful party to open its books to the applicant within a time period to be specified and subject to such terms as the Court may deem appropriate having regard *inter alia* to Article 58 of the Agreement and Rule 190.1,

(b) inform the applicant and specify a time period within which the procedure for the award of damages shall be continued.

2. Where the request to lay open books is not allowable, the Court shall inform the applicant and specify a time period within which the procedure for the award of damages shall be continued.

## **CHAPTER 5 – PROCEDURE FOR COST ORDER**

*Relation with draft Agreement: Article 69*

### **Rule 150 – Separate proceedings for cost order**

1. A cost order may be the subject of separate proceedings following a decision on the merits and, if applicable, a decision for the determination of damages.
2. The Court may order an interim award of costs to the successful party in the decision on the merits or in a decision for the determination of damages, subject to any conditions that the Court may decide.

### **Rule 151 – Start of proceedings for cost order**

Where the successful party (hereinafter "the applicant") wishes to seek a cost order, it shall within one month of service of the decision lodge an \*Application for a cost order which shall contain

- (a) particulars in accordance with Rule 13.1(a) to (d),
- (b) the date of the decision and the case number of the file,
- (c) a statement as to whether the decision on the merits is the subject of an appeal
- (d) an indication of the costs for which compensation is requested, which may include recovery of court fees and costs of representation, of witnesses, of experts, and other expenses

### **Rule 152 – Compensation for representation costs re decision on the merits**

1. The successful party shall be entitled to recover reasonable and proportionate costs for representation.
2. The Administrative Committee shall adopt a scale of recoverable costs which shall set ceilings for such costs by reference to the value of the dispute. The scale may be adjusted from time to time.

### **Rule 153 – Compensation for costs of experts**

The compensation for costs of experts shall be based on the rates that are customary in the respective sector, with due regard to the required expertise, the complexity of the issue and the time spent by the expert for the services rendered.

#### **Rule 154 – Compensation for costs of witnesses**

Where the Court has ordered the deposit of a sum sufficient to cover the expenses of a witness in accordance with Rule 180, compensation may be requested for payments made by the Registry towards the expenses incurred by a witness.

#### **Rule 155 – Compensation for costs of interpreters and translators**

1. The compensation for costs of interpreters shall be the rates that are customary in the country of the division in question, depending on the interpreter's training and professional experience.
2. The compensation for costs of translators shall be the rates that are customary in the country of the division in question, depending on the translator's training and professional experience.

#### **Rule 156 – Further procedure**

1. The judge-rapporteur may request the applicant to provide written evidence of all costs requested in Rule 151(c). The judge-rapporteur shall allow the unsuccessful party an opportunity to comment in writing on the costs requested including any item of costs that should be apportioned or borne by each party in accordance with Article 69(1) to (3) of the Agreement.
2. The judge-rapporteur shall decide in writing on the costs to be awarded or apportioned in accordance with Article 69(1) to (3) of the Agreement.
3. The costs shall be paid within the period ordered by the judge-rapporteur.

#### **Rule 157 – Appeal against the costs decision**

The decision of the judge rapporteur as to costs only may be appealed to the Court of Appeal in accordance with Rule 220.2.

## **PART 2 – EVIDENCE**

*Relation with draft Agreement: Article 53*

### **Rule 170 – Means of evidence and means of obtaining evidence**

1. In proceedings before the Court, the means of evidence shall include in particular the following:
  - (a) written evidence, whether printed, hand-written or drawn, in particular documents, written witness statements, plans, drawings, photographs;
  - (b) expert reports and reports on experiments carried out for the purpose of the proceedings;
  - (c) physical objects, in particular devices, products, embodiments, exhibits, models;
  - (d) electronic files and audio / video recordings.
2. Means of obtaining evidence shall include in particular the following:
  - (a) hearing of the parties;
  - (b) summoning, hearing and questioning of witnesses;
  - (c) appointing and hearing of experts;
  - (d) ordering a party or a third party to produce evidence;
  - (e) ordering inspection of a place or a physical object;
  - (f) ordering measures to preserve evidence.

### **Rule 171 – Offering of evidence**

1. A party making a statement of fact that is contested or likely to be contested by the other party shall indicate the means of evidence to prove it. In case of failure to indicate the means of evidence regarding a contested fact, the Court shall take such failure into account when deciding the issue in question.
2. A statement of fact that is not specifically contested by any party shall be held to be true as between the parties.

### **Rule 172 – Duty to produce evidence**

1. Evidence available to a party regarding a statement of fact that is contested or likely to be contested by the other party must be produced by the party making that statement of fact.
2. The Court may at any time during the proceedings order a party making a statement of fact to produce evidence that lies in the control of that party. If the party fails to produce the evidence, the Court shall take such failure into account when deciding on the issue in question.

## **CHAPTER 1 – WITNESSES AND EXPERTS OF THE PARTIES**

### **Rule 175 – Written witness statement**

1. A party seeking to offer witness evidence may lodge a written witness statement.
2. A written witness statement shall be signed by the witness and shall include a statement of the witness that he is aware of his obligation to tell the truth and of his liability under applicable national law in the event of any breach of this obligation. The statement shall set out the language in which the witness shall give oral evidence, if necessary.

### **Rule 176 – Application for the hearing of a witness in person**

Where a party seeking to offer witness evidence cannot obtain a written witness statement, it shall make an\* Application for the hearing of a witness in person which shall set out

- (a) the reasons why the witness shall be heard in person and
- (b) the facts which the party expects the witness to confirm.
- (c) the language in which the witness shall give evidence.

### **Rule 177 – Summoning of witnesses to the oral hearing**

1. The Court may order that a witness be heard in person of its own motion or
  - (a) where a written witness statement is challenged by the other party or
  - (b) on an application for the hearing of a witness in person [Rule 176].
2. An order of the Court summoning a witness to the oral hearing shall in particular indicate
  - (a) the name, address and description of the witness,
  - (b) the date and place of the oral hearing,
  - (c) an indication of the facts of the case about which the witness is to be examined,
  - (d) information about the reimbursement of expenses incurred by the witness,
  - (e) information about the sanctions which may be imposed on a defaulting witness [Rule 179].
  - (f) a statement as to whether the witness will be questioned by the Court and the parties

### **Rule 178 – Hearing of witnesses**

1. After the identity of the witness has been established and before hearing his evidence, the presiding judge shall ask the witness to make the following declaration:

"I solemnly, sincerely and truly declare and affirm that the evidence I shall give shall be the truth, the whole truth and nothing but the truth."

2. The witness shall give his evidence to the Court.

3. The hearing of a witness who has signed a written witness statement shall begin with the confirmation of the evidence given therein. The witness may elaborate on the evidence contained in his written witness statement.

4. The presiding judge and the judges of the panel may put questions to the witness.

5. Under the control of the presiding judge, the parties may put questions to the witness. The presiding judge may prohibit any question which is not designed to adduce admissible evidence.

6. The Court may allow a witness to give evidence through electronic means, such as video conference. Paragraphs 1 to 5 and 7 shall apply.

7. With the consent of the Court a witness may give evidence in a language other than the language of proceedings.



### **Rule 179 – Duties of witnesses**

1. Witnesses who have been duly summoned shall obey the summons and attend the oral hearing.
2. Without prejudice to paragraph 3, if a witness who has been duly summoned fails to appear before the Court or refuses to give evidence or to make the declaration referred to in Rule 178.1, the Court may impose upon him a pecuniary sanction not exceeding [EUR\*\*\*] and may order that a further summons be served at the witness's own expense. The Court may send a Letter Rogatory to the competent national court pursuant to Rule 202.
3. Nobody shall be obliged to sign a written witness statement or to give evidence at an oral hearing if he/she is a spouse, partner equal to a spouse under applicable national law, descendant, sibling or parent of a party. A witness may also refuse to answer questions if answering them would violate a professional privilege or other duty of confidentiality imposed by the national law applicable to the witness or expose him or his spouse, partner equal to a spouse under applicable national law, descendant, sibling or parent to criminal prosecution under applicable national law.
4. The Court may decide to report to the competent authorities of the Contracting Member States whose courts have criminal jurisdiction in case of the giving of false evidence on the part of a witness.

### **Rule 180 – Reimbursement of expenses of witnesses**

1. A witness shall be entitled to reimbursement of
  - (a) expenses for travelling and stay and
  - (b) loss of income caused by his hearing in person.After the witness has carried out his duties and upon his request, the Registry shall make a payment to the witness towards the expenses incurred.
2. Where a party has lodged an Application for the hearing of a witness in person, the Court shall make the summoning of the witness conditional upon the deposit of a sum sufficient to cover the expenses referred to in paragraph 1.
3. Where the Court orders of its own motion that a witness be heard in person, the funds necessary shall be provided by the Court.

### **Rule 181 – Experts of the parties**

Subject to the orders of the Court referred to in Rules 104(e) and 112.2(b) a party may provide any expert evidence that it considers necessary. Rules 175 to 180 shall apply *mutatis mutandis* to experts of the parties.

## **CHAPTER 2 – COURT EXPERTS**

*Relation with draft Agreement: Article 57*

### **Rule 185 – Appointment of a court expert**

1. Where the Court must resolve a specific technical question in relation to the case, it may of its own motion (and after hearing the parties) appoint a court expert.
2. The parties may make suggestions regarding the identity of the court expert, his technical background and the questions to be put to him.
3. The court expert shall be responsible to the Court and shall possess the expertise, independence and impartiality required for being appointed as court expert.
4. The Court shall appoint a court expert by way of order which shall in particular specify
  - (a) the name and address of the expert appointed,
  - (b) a short description of the facts of the case,
  - (c) the evidence submitted by the parties in respect of the technical question,
  - (d) the questions put to the expert, with the appropriate level of detail, including where appropriate suggestions relating to any experiments to be carried out,
  - (e) when and under what conditions the expert may receive other relevant information,
  - (f) the time period for the presentation of the expert report,
  - (g) information about the reimbursement of expenses incurred by the expert,
  - (h) information about the sanctions which may be imposed on a defaulting expert.
5. The expert shall receive a copy of the order, together with the documents and other evidence that the Court considers to be necessary for carrying out his task.
6. The expert shall be required upon receipt of the order to confirm in writing that he will present the expert report within the time period specified by the Court.
7. The Court may reduce any fee agreed with the expert by an equitable amount if the expert did not deliver his report within the time period specified by the Court or if the report did not have the quality to be expected of the expert.
8. If an appointed court expert does not present his report within the time period specified or, if extended at the expert's request, the extended period, the Court may appoint another expert in his place. The Court may hold the expert liable for all or part of the costs of appointing and reimbursing another expert.
9. The Registry shall maintain an indicative list of experts.

**Rule 186 – Duties of a court expert**

1. The court expert shall present an expert report in writing within the time period specified by the Court [Rule 185.4(f)].
2. The court expert shall be under the supervision of the Court and shall inform the Court of his progress in carrying out his task.
3. The court expert shall give expert advice only on questions which have been put to him.
4. The court expert will not communicate with one party without the other party being present or without the consent of the other party.
5. The court expert will not communicate the contents of his report to third parties.
6. The court expert shall attend the oral hearing and shall be open to questions from the Court and the parties.

**Rule 187 –Expert report**

Once the final report of the court expert has been presented to the Court, the Court shall invite the parties to comment on it either in writing or during the oral hearing.

**Rule 188 – Hearing of a court expert**

Rules 178 to 180 shall apply *mutatis mutandis* to a court expert.

## **CHAPTER 3 – ORDER TO PRODUCE EVIDENCE AND TO COMMUNICATE INFORMATION**

### **ORDER TO PRODUCE EVIDENCE**

#### **Rule 190 – Order to produce evidence**

1. Where a party has presented reasonably available and plausible evidence in support of its claims and has, in substantiating those claims, specified evidence which lies in the control of the other party or a third party, the Court may upon a reasoned request of the party specifying such evidence, order that party to produce such evidence. For the protection of confidential information the Court may order that the evidence be disclosed to certain named persons only and be subject to appropriate terms of non-disclosure.
2. During the written and interim procedures, a party may request such an order to produce evidence.
3. The judge-rapporteur may make such order in the written procedure or in the interim procedure having given the other/third party an opportunity to be heard.
4. An order to produce evidence shall in particular specify
  - (a) under which conditions, in what form and within what time period the evidence shall be produced,
  - (b) any sanction which may be imposed if the evidence is not produced according to the order.
5. Where the Court orders a third party to produce evidence, the interests of that third party shall be duly taken into account.
6. An order to produce evidence shall be subject to the provisions of Rules 179.3, 287 and 288.
7. If a party fails to comply with an order to produce evidence, the Court shall take such failure into account when deciding on the issue in question.

*Relation with draft Agreement: Article 59  
[Article 6 (1) Directive 2004/48/EC; Article 43(1) TRIPS]*

## **ORDER TO COMMUNICATE INFORMATION**

### **Rule 191 – Application for order to communicate information**

1. The Court may in response to a reasoned request of a party order the other party or any third party to communicate such information in the control of that other party or third party as is specified in Article 67 of the Agreement or such other information as is reasonably necessary for the purpose of advancing that party's case .

Relation with the draft Agreement: Article 67

## CHAPTER 4 - ORDER TO PRESERVE EVIDENCE (*SAISIE*) AND ORDER FOR INSPECTION

### ORDER TO PRESERVE EVIDENCE (*Saisie*)

#### Rule 192 – Application for preserving evidence

1. An Application for preserving evidence may be lodged by a party (within the meaning of Article 46 of the Agreement) (hereinafter "the applicant") at the division where the applicant has commenced infringement proceedings on the merits. If the application is lodged before proceedings on the merits have been started it shall be lodged at the division where the applicant intends to start proceedings on the merits.

2. The \*Application for preserving evidence shall contain

- (a) particulars in accordance with Rule 13.1(a) to (i),
- (b) a clear indication of the measures requested [Rule 196.1], including the exact location of the evidence to be preserved,
- (c) the reasons why prompt measures are needed to preserve relevant evidence,
- (d) the facts and evidence relied on in support of the Application.

Where main proceedings on the merits of the case have not yet been started before the Court, the Application shall in addition contain a concise description of the action which will be started before the Court, including an indication of the facts and evidence which will be relied on in support.

3. Where the applicant requests that measures to preserve evidence be ordered without hearing the other party (hereinafter "the defendant"), the Application for preserving evidence shall in addition set out the reasons for not hearing the defendant having regard in particular to Rule 197. The applicant shall be under a duty to disclose any material fact known to it which might influence the court in deciding whether to make an order without hearing the defendant.

4. Where the Application for preserving evidence is lodged after main proceedings on the merits of the case have been started before the Court, the Application shall be drawn up in the language of the proceedings. Where the Application is lodged before main proceedings on the merits of the case have been started before the Court, Rules 14 or 46 shall apply *mutatis mutandis*.

5. The applicant shall pay the fee for the Application for preserving evidence [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 59*

*[Article 7 Directive 2004/48/EC]*

**Rule 193 – Examination as to formal requirements, recording in the register, assignment to panel, designation of judge-rapporteur, single judge**

1. Where main proceedings on the merits of the case have not yet been started before the Court, the Application for preserving evidence shall be dealt with in accordance with

- Rule 16: formalities examination by Registry
- Rule 17.1(a) to (c) .2: date of receipt, recording in the register, case number, assignment to panel
- Rule 18: designation only of judge-rapporteur by presiding judge

2. Where main proceedings on the merits of the case have already been started before the Court, an Application for preserving evidence shall immediately be

- examined by the Registry in accordance with Rule 16
- forwarded to the panel to which the case has been assigned or to the single judge to whom the case has been assigned [Rules 17.2 and 194.3 and .4]

3. The judge-rapporteur or single judge deciding on an Application for preserving evidence shall have all necessary powers of the Court.

## **Rule 194 – Examination of the Application for preserving evidence**

1. Without prejudice to the Court's decision on the Application for preserving evidence, the Court shall have the discretion to
  - (a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an \*Objection to the Application for preserving evidence which shall contain
    - (i) the reasons why the Application shall fail,
    - (ii) the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant,
    - (iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and an indication of the facts and evidence relied on in support,
  - (b) summon the parties to an oral hearing,
  - (c) summon the applicant to an oral hearing without the presence of the defendant.
2. In exercising its discretion, the Court shall take into account
  - (a) the urgency of the case,
  - (b) whether the reasons for not hearing the defendant [Rule 192.3 and Rule 197] appear well-founded,
  - (c) the probability that evidence may be destroyed or otherwise cease to be available [Rule 197].
3. The presiding judge may decide that he or the judge-rapporteur or other single judge or the standing judge may decide on the Application.
4. In cases of extreme urgency the applicant may apply without formality for an order to preserve evidence to the standing judge designated in accordance with Rule 345.5. The standing judge shall decide the procedure to be followed on the Application.
5. If the Court decides to inform the defendant about the Application the Court will first give the applicant the possibility to withdraw the Application. In the event of such withdrawal the applicant may request that the Court shall order that Application and its contents shall remain confidential.
6. If the patent the subject of the Application is also the subject of a Protective Letter pursuant to Rule 207 the applicant may withdraw the Application pursuant to paragraph 5.



## **Rule 195 – Oral hearing**

1. Where the Court decides to summon the parties to an oral hearing, the date for the oral hearing shall be set as soon as possible after the date of receipt of the Application for preserving evidence.
2. Rules 111 to 116 shall apply *mutatis mutandis*. Where the applicant is absent from the oral hearing without a reasonable excuse, the Court shall reject the Application for preserving evidence.
3. The decision of the Court on the Application for preserving evidence shall be given in writing as soon as possible after the closure of the oral hearing. If the Court deems appropriate, the decision may be given orally to the parties at the end of the oral hearing but shall as soon as practicable thereafter be given in writing.

*Relation with draft Agreement: Article 60*

## **Rule 196 – Decision on the Application for preserving evidence**

1. The Court may order the following:
  - (a) preserving evidence by detailed description, with or without the taking of samples;
  - (b) physical seizure of allegedly infringing goods;
  - (c) physical seizure of the materials and implements used in the production and/or distribution of these goods and any related document.For the protection of confidential information the Court may order that any of the above be disclosed only to certain named persons and subject to appropriate terms of non-disclosure.
2. An order to preserve evidence shall specify that, unless otherwise ordered by the Court, the outcome of the measures to preserve evidence may only be used in the proceedings on the merits of the case.
3. The order to preserve evidence shall be enforceable immediately, unless the Court decides otherwise. The Court may set conditions to the enforceability of the order, specifying in particular
  - (a) who may represent the applicant when the measures to preserve evidence are being carried out and under what conditions,
  - (b) any security which shall be provided by the applicant.If necessary, the Court may set penalties applicable to the applicant if these conditions are not observed.
4. The order to preserve evidence shall specify a person who shall carry out the measures referred to in paragraph 1 and present a written Report on the measures to preserve evidence, all in accordance with the national law where the measures are executed, to the Court within a time period to be specified.

5. The person referred to in paragraph 4 shall be a professional person or expert, who guarantees expertise, independence and impartiality. Where appropriate and allowed under applicable national law, the person may be a bailiff or assisted by a bailiff. In no circumstances may an employee or director of the applicant be present at the execution of the measures.

6. The Court may order the applicant to provide adequate security for the legal costs and other expenses and compensation for any injury incurred or likely to be incurred by the defendant which the applicant may be liable to bear. The Court shall do so where the order to preserve evidence was made without the defendant having been heard. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee.

7. The order to preserve evidence shall indicate that an appeal may be lodged in accordance with Article 73 of the Agreement.

*Relation with draft Agreement: Article 60(1)-(4)*  
*[Article 7 Directive 2004/48/EC]*

### **Rule 197 – Order to preserve evidence without hearing the defendant**

1. The Court may order measures to preserve evidence (Rule 196.1) without the defendant having been heard, in particular where any delay is likely to cause irreparable harm to the applicant or where there is a demonstrable risk of evidence being destroyed or otherwise ceasing to be available.
2. Where measures to preserve evidence are ordered without the defendant having been heard, Rule 195 shall apply *mutatis mutandis* to the oral hearing without the presence of the defendant. In such cases, the defendant shall be given notice, without delay and at the latest immediately at the time of the execution of the measures.
3. Within 10 working days after the execution of the measures, the defendant may request a review of the order to preserve evidence. The \*Request for review shall set out
  - (a) the reasons why the order to preserve evidence shall be revoked or modified,
  - (b) the facts and evidence relied on.
4. The Court shall order an oral hearing to review the order without delay. Rule 195 shall apply. The Court may modify, revoke or confirm the order. In case the order is modified or revoked the Court shall oblige the persons to whom confidential information has been disclosed to keep this information confidential. [Rule 196.1]

*Relation with draft Agreement: Article 60(6)*  
*[Article 7 Directive 2004/48/EC]*

### **Rule 198 – Revocation of an order to preserve evidence**

1. The Court shall ensure that an order to preserve evidence is revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if, within a time period not exceeding 31 calendar days or 20 working days from the date of the order, whichever is the longer, the applicant does not start proceedings on the merits of the case before the Court.
2. Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court may order the applicant, upon request of the defendant, to provide the defendant appropriate compensation for any injury caused by those measures [Rule 354.4].

*Relation with draft Agreement: Article 60(8) and (9)*  
*[Article 7 Directive 2004/48/EC]*

## **ORDER FOR INSPECTION**

### **Rule 199 – Order for inspection**

1. The Court may, either of its own motion (but only after hearing the parties) or on a reasoned request by a party, order an inspection of products, devices, methods, premises or local situations *in situ*. For the protection of confidential information the Court may order that any of the above be disclosed only to certain named persons and subject to appropriate terms of non-disclosure in accordance with Article 58 of the Agreement.
2. Rules 192 to 197 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 60*

## CHAPTER 5 – OTHER EVIDENCE

### Rule 200 – Order to freeze assets

1. Where a party has presented reasonably available and plausible evidence in support of its claim that a patent has been or is about to be infringed the Court may, whether before or after proceedings have been commenced, order a party not to remove from its jurisdiction any assets or particular assets located therein nor to deal in any assets, whether located in within its jurisdiction or not.

2. Rules 192 to 195 and Rules 197 and 198 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 61*

### Rule 201 – Experiments ordered by the Court

1. Without prejudice to the possibility for parties or parties' experts to carry out experiments, the Court may, of its own motion (but only after hearing the parties) or on a reasoned request by a party, order an experiment to prove a statement of fact for the purpose of proceedings before the Court.

2. A party requesting to be allowed to prove a statement of fact by means of experiments shall lodge a request as soon as practicable in the written procedure or the interim procedure to carry out experiments which shall

- (a) identify the facts intended to be established by the experiments, describe the proposed experiments in detail and the reasons for carrying out the proposed experiments,
- (b) propose an expert to carry out such experiments,
- (c) disclose any previous attempts to carry out similar experiments.

3. Other parties to the proceedings shall be invited to state whether they dispute the facts intended to be established by the experiments. They shall also be invited to comment on the request, including the identity of the expert proposed and the description of the experiments.

4. Unless otherwise ordered by the Court the party requesting experiments shall initially bear the costs of the experiment.

5. The order of the Court allowing the experiments shall specify the detailed experiments and

- (a) the name and address of the expert or experts who are to carry out the experiments and draw up the report on the experiments,

- (b) the time period for carrying out the experiments and, where appropriate, the exact time and place where they are to be carried out,

- (c) if necessary, other conditions for carrying out the experiments,

- (d) the time period for presenting the report on the experiments and, where appropriate, directions relating to the contents of the report.

6. Where appropriate, the Court may order that the experiments be carried out in the presence of the parties and their experts.

7. Once the report on the experiments is presented to the Court, it shall invite the parties to comment on it either in writing or during the oral hearing.

#### **Rule 202 – Letters rogatory**

1. The Court may, of its own motion (but only after hearing the parties) or on a reasoned request by a party, issue letters rogatory for the hearing of witnesses by other competent courts or authorities.

2. The Court shall draw up letters rogatory in the language of the competent court or authority or shall attach to such letters a translation into that language.

3. Subject to paragraph 4, the competent court or authority shall apply national law as to the procedures to be followed in executing such requests and, in particular, as to the appropriate measures of compulsion.

4. The Court shall be informed of the time when, and the place where, the enquiry or other legal measure is to take place. It may inform the parties, witnesses and experts concerned.

*[Council Regulation No 1206/2001 of 28 May 2001 on co-operation between the courts of the Member States in the taking of evidence in civil or commercial matters]*

## **PART 3 – PROVISIONAL MEASURES**

*Relation with draft Agreement: Articles 32(1)(c) and 62*

### **Rule 205 – Stages of the proceedings (summary proceedings)**

Summary proceedings before the Court of First Instance shall consist of the following stages:

- (a) a written procedure;
- (b) an oral procedure, which may include an oral hearing of the parties or of one of the parties.

### **Rule 206 – Application for provisional measures**

1. An Application for provisional measures may be lodged by a party (hereinafter "the applicant") before or after main proceedings on the merits of the case have been started before the Court.

2. An \*Application for provisional measures shall contain

- (a) particulars in accordance with Rule 13.1(a) to (i),
- (b) a indication of the provisional measures which are being requested [Rule 211.1],
- (c) the reasons why provisional measures are necessary to prevent a threatened infringement, to forbid the continuation of an alleged infringement or to make such continuation subject to the lodging of guarantees,
- (d) the facts and evidence relied on in support of the Application, including evidence to support the claim that provisional measures are necessary including the matters referred to in Rule 211.2 and .3,
- (e) a concise description of the action which will be started before the Court, including an indication of the facts and evidence which will be relied on in support of the main proceedings on the merits of the case.

3. Where the applicant requests that provisional measures be ordered without hearing the other party (hereinafter "the defendant"), the \*Application for provisional measures shall in addition contain

- (a) the reasons for not hearing the defendant having regard in particular to Rule 197,
- (b) information about any prior correspondence between the parties concerning the alleged infringement, and
- (c) the applicant shall be under a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant including any pending proceedings and/or any unsuccessful attempt in the past to obtain provisional measures in respect of the patent (or patents).

4. Rule 14 shall apply *mutatis mutandis*. The applicant shall pay the fee for the Application for provisional measures [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

## Rule 207 – Protective letter

1. If a person entitled to start proceedings under Article 47 of the Agreement considers it likely that an Application for provisional measures against him as a defendant may be lodged before the Court in the near future, he may file a Protective letter.

2. The \*Protective letter shall be filed with the Registry in the language of the patent and shall contain

- (a) the name of the defendant filing the Protective letter and of the defendant's representative,
- (b) the name of the presumed applicant for provisional measures,
- (c) postal and electronic addresses for service on the defendant filing the Protective letter and the names of the persons authorised to accept service,
- (d) postal and, where available, electronic addresses for service on the presumed applicant for provisional measures and the names of the persons authorised to accept service if known,
- (e) where available, the number of the patent (or patents) concerned and, where applicable, information about any prior or pending proceedings referred to in Rule 13.1(i),
- (f) the statement that the letter is a Protective letter.

The Protective letter may contain

- (g) an indication of the facts relied on, which may include a challenge to the facts expected to be relied on by the presumed applicant and/or, where applicable, any assertion that the patent (or patents) is (are) invalid and the grounds for such assertion,
- (h) any available written evidence relied on,
- (i) the arguments of law, including the reasons why any Application for provisional measures should be rejected.

3. The defendant filing the Protective letter shall pay the fee for filing a Protective letter [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

4. The Registry shall as soon as practicable examine whether the requirements of paragraphs 2(a) to (f) and 3 have been complied with. If these requirements have been complied with, the Registry shall as soon as practicable,

- (a) record the date of receipt and a number to the Protective letter,
- (b) record the Protective letter in the register,
- (c) provide details of the Protective letter to all local and regional divisions
- (d) where an Application for provisional measures has already been lodged, inform the panel or the single judge dealing with the Application about the filing of the Protective letter.

5. If the defendant has not complied with the requirements of paragraph 4 the Registry shall as soon as practicable invite the defendant to

- (a) correct the deficiencies within 14 days; and
- (b) where applicable, pay the fee referred to in paragraph 3.



6. Where an Application for provisional measures is subsequently lodged the Registrar shall forward a copy of the protective letter to the panel or judge appointed under Rule 208 together with the Application for provisional measures and shall forward a copy to the applicant as soon as practicable.

7. If no Application for provisional measures has been lodged within six months from the date of receipt of the Protective letter, the Protective letter shall be removed from the register unless the person who has lodged the Protective letter has prior to the expiry of such period applied for an extension of six months and paid a fee for the extension [EUR\*\*\*] in accordance with Part 6.

8. Rule 15.2 shall apply *mutatis mutandis*.

**Rule 208 – Examination as to formal requirements, recording in the register, assignment to panel, designation of judge-rapporteur, single judge**

1. The Application for provisional measures shall be examined by the Registry in accordance with Rule 16. The Registry shall in addition examine whether any Protective letter relevant for the Application is recorded in the register.

2. Where main proceedings on the merits of the case have not yet been started before the Court, Rule 17 (date of receipt, recording in the register, case number, assignment to panel) and Rule 18 (designation of judge-rapporteur by presiding judge) shall apply *mutatis mutandis*. In urgent cases, the presiding judge may decide that he or an experienced judge of the panel, acting as single judge, may decide on the Application in accordance with Rules 209 to 213 with a reduced time-table.

3. Where main proceedings on the merits of the case have already been started before the Court, the Application for provisional measures shall immediately be forwarded to the panel to which the case has been assigned or to the single judge. In urgent cases (where the case has not been assigned to a single judge), the presiding judge may decide that he or the judge-rapporteur, acting as single judge, may decide on the Application in accordance with Rules 209 to 213 with a reduced time-table.

4. The single judge deciding on the Application for provisional measures shall have all necessary powers of the Court.

*Relation with draft Agreement: Article 8(7)*

*Relation with draft Statute: Article 19*

## **Rule 209 – Examination of the Application for provisional measures**

1. Without prejudice to the Court's decision on the Application for provisional measures, the Court shall have the discretion to

(a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an \*Objection to the Application for provisional measures which shall contain

(i) the reasons why the Application shall fail,

(ii) the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant;

(iii) where main proceedings on the merits of the case have not yet been started before the Court, the reasons why the action which will be started before the Court shall fail and the facts and evidence relied on in support,

(b) summon the parties to an oral hearing,

(c) summon the applicant to an oral hearing without the presence of the defendant.

2. In exercising its discretion, the Court shall in particular take into account

(a) whether the patent has been upheld in an opposition procedure before the European Patent Office or has been the subject of proceedings in any other court,

(b) the urgency of the case,

(c) whether the applicant has requested provisional measures without hearing the defendant and whether the reasons for not hearing the defendant appear well-founded,

(d) any Protective letter filed by the defendant; the Court shall in particular consider summoning parties to an oral hearing if a relevant Protective letter has been filed by the defendant.

3. In cases of extreme urgency the standing judge appointed in accordance with Rule 194 may decide immediately on the Application for provisional measures and the procedure to be followed on the Application.

4. If the applicant has applied for provisional measures without hearing the defendant and the Court decides not to grant provisional measures without hearing the defendant the applicant may withdraw the Application and may request that the Court order that the Application and the contents of the Application remain confidential.

*\* An on-line form will be available to guide parties.*

## **Rule 210 – Oral hearing**

1. Where the Court decides to summon the parties to an oral hearing, the date for the oral hearing shall be set as soon as possible after the date of receipt of the Application for provisional measures.
2. The Court may order the parties to provide further information, documents and other evidence before or during the oral hearing, including evidence to enable the Court to make its decision in accordance with Rule 211. Part 2 of these Rules on Evidence shall be applicable only to the extent determined by the Court.
3. Rules 111 to 116 shall apply *mutatis mutandis*. Where the applicant is absent from the oral hearing without a reasonable excuse, the Court shall reject the Application for provisional measures.
4. The decision of the Court on the Application for provisional measures shall be given in writing as soon as possible after the closure of the oral hearing. If the Court deems appropriate, its decision may be given orally to the parties at the end of the oral hearing.

## **Rule 211 – Decision on the Application for provisional measures**

1. The Court may in particular order the following provisional measures:
  - (a) injunctions against a defendant;
  - (b) the seizure or delivery up of the goods suspected of infringing a patent right so as to prevent their entry into or movement within the channels of commerce;
  - (c) if an applicant demonstrates circumstances likely to endanger the recovery of damages, a precautionary seizure of the movable and immovable property of the defendant, including the blocking of his bank accounts and other assets.
2. In taking its decision the Court shall be satisfied with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent.
3. In taking its decision on the Application for provisional measures, the Court shall have the discretion to weigh up the interests of the parties.
4. The Court may order the applicant to provide adequate security for appropriate compensation for any injury likely to be caused to the defendant which the applicant may be liable to bear in the event that the Court revokes the order for provisional measures. The Court shall do so where interim measures are ordered without the defendant having been heard. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee. The order shall be effective only after the security has been given in accordance with the Court's decision.
5. The decision on provisional measures shall indicate that an appeal may be brought in accordance with Article 73 of the Agreement.

*Relation with draft Agreement: Article 62(2) and (3)*

### **Rule 212 – Decision on provisional measures without hearing the defendant**

1. The Court may only order provisional measures without the defendant having been heard in cases where any delay is likely to cause irreparable harm to the applicant. Rule 197 shall apply *mutatis mutandis*.
2. Where provisional measures are ordered without the defendant having been heard, Rule 210 shall apply *mutatis mutandis* to the oral hearing without the presence of the defendant. In such cases, the defendant shall be given notice of the provisional measures without delay and at the latest immediately at the time of execution of the measures.
3. The defendant may request a review in accordance with Rule 197.3 and .4.

*Relation with draft Agreement: Article 60(5) and (6)*

### **Rule 213 – Revocation of provisional measures**

1. The Court shall ensure that provisional measures are revoked or otherwise cease to have effect, upon request of the defendant, without prejudice to the damages which may be claimed, if, within a time period provided for in the Court's order not exceeding 31 days from the date of the Court's order, the applicant does not start proceedings on the merits of the case before the Court.
2. Where provisional measures are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court shall order the applicant, upon request of the defendant or any third party, to provide the defendant or such third party appropriate compensation for any injury caused by those measures [Rule 354.4].

*Relation with draft Agreement 60(9).*

## **PART 4 – PROCEDURES BEFORE THE COURT OF APPEAL**

### **Rule 220 – Appealable decisions**

1. An appeal by a party adversely affected may be brought against
  - (a) final decisions of the Court of First Instance,
  - (b) decisions terminating proceedings as regards one of the parties,
  - (c) decisions or orders referred to in Articles 49(5), 59, 60, 61, 62 or 67 of the Agreement.
2. Procedural decisions or orders of the Court of First Instance may be appealed with leave of the Court of First Instance<sup>4</sup>
3. The Court of Appeal may hear appeals against separate decisions on the merits in infringement proceedings and in validity proceedings together.

*Relation with draft Agreement: Article 73*

*[Examples of final decisions of the Court of First Instance: Rule 118 (decision on the merits), Rule 140 (decision on the award of damages), Rule 157 (decision on costs)]*

### **[Rule 221 – Application for leave to appeal]**

1. A party adversely affected by a decision or order referred to in Rule 157 may lodge an Application for leave to appeal to the Court of Appeal within 15 calendar days of service of the decision or order of the Court refusing leave to appeal.
2. The \*Application for leave to appeal shall set out
  - (a) the reasons why the appeal should be heard.
  - (b) where necessary, the facts, evidence and arguments relied on.
3. The President of the Court of Appeal shall assign the Application for leave to appeal to a single judge.

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<sup>4</sup> Members of the Drafting Committee have proposed that Article 73(2)(b)(ii) of the Agreement be altered to allow for leave to be given by the Court of Appeal.

## **Rule 222 – Subject-matter of the proceedings before the Court of Appeal**

1. Requests, facts, evidence and arguments submitted by the parties under Rules 225, 226, 230 and 238 shall, subject to paragraph 2, constitute the subject-matter of the proceedings before the Court of Appeal. The Court of Appeal shall consult the file of the proceedings before the Court of First Instance.

2. Requests, facts and evidence which have not been submitted by a party during proceedings before the Court of First Instance may be disregarded by the Court of Appeal. When exercising discretion, the Court shall in particular take into account

- (a) whether a party seeking to lodge new submissions is able to justify that the new submissions could not reasonably have been made during proceedings before the Court of First Instance,
- (b) whether the new submissions are highly relevant for the decision on the appeal,
- (c) the position of the other party regarding the lodging of the new submissions.

*Relation with draft Agreement: Article 73(4)*  
*[Article 114(2) EPC]*

## **Rule 223 – Application for suspensive effect**

1. A party may lodge an Application for suspensive effect, in accordance with Article 74 of the Agreement.

2. The \*Application for suspensive effect shall set out

- (a) the reasons why the lodging of the appeal shall have suspensive effect,
- (b) the facts, evidence and arguments relied on.

3. Rule 221.3 shall apply *mutatis mutandis*. The Court shall decide the Application without delay.

4. In cases of extreme urgency the applicant may apply at any time without formality for an order for suspensive effect to the standing judge [Rule 345.8]. The standing judge shall have all the powers of the Court of Appeal and shall decide the procedure to be followed on the application.

*Relation with draft Agreement: Article 74*

## **CHAPTER 1 – WRITTEN PROCEDURE**

### **SECTION 1 – STATEMENT OF APPEAL, STATEMENT OF GROUNDS OF APPEAL**

#### **Rule 224 – Time periods for lodging the Statement of appeal and the Statement of grounds of appeal**

1. A Statement of appeal shall be lodged by the appellant
  - (a) within two months of service of a decision referred to in Rule 220.1(a) and (b) or
  - (b) within 15 calendar days of service of a decision or order referred to in Rules 220.1(c) and .2 and 221.4(a).
2. The Statement of grounds of appeal shall be lodged by the appellant
  - (a) within four months of service of a decision referred to in Rule 220.1(a) and (b) or
  - (b) within 15 calendar days months of service of a decision or order referred to in Rules 220.1(c) and .2 and 221.4(a).

*Relation with draft Agreement: Article 73(1) and (2)*

#### **Rule 225 – Contents of the Statement of appeal**

The \*Statement of appeal shall contain

- (a) the names of the appellant and of the appellant's representative,
- (b) the names of the respondent and of the respondent's representative,
- (c) postal and electronic addresses for service on the appellant and on the respondent, as well as the names of the persons authorised to accept service,
- (d) the date of the decision or order appealed against and the case number attributed to the file in proceedings before the Court of First Instance,
- (e) the order or remedy sought by the appellant.



### **Rule 226 – Contents of the Statement of grounds of appeal**

The \*Statement of grounds of appeal shall contain

- (a) an indication of which parts of the decision or order are contested,
- (b) the reasons for setting aside the contested decision or order,
- (c) an indication of the facts and evidence on which the appeal is based in accordance with Rule 222.1 and .2.

*[Rule 99 EPC]*

### **Rule 227 – Language of the Statement of appeal and of the Statement of grounds of appeal**

1. The Statement of appeal and the Statement of grounds of appeal shall be drawn up

- (a) without prejudice to Article 50(3) of the Agreement in the language of the proceedings before the Court of First Instance or
- (b) where the parties have agreed in accordance with Article 50(2) of the Agreement, in the language in which the patent was granted; where the parties have agreed in accordance with Article 50(2) of the Agreement, evidence of the respondent's agreement shall be lodged by the appellant together with the Statement of appeal.

*Relationship with draft Agreement: Article 50*

### **Rule 228 – Fee for the appeal**

The appellant shall pay the fee for the appeal [EUR\*\*\*] or the fee for the interlocutory appeal [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.

*[EPC Article 108 and Rule 101.2]*

### **Rule 229 – Examination as to formal requirements of the Statement of appeal**

1. The Registry shall, as soon as practicable after the lodging of the Statement of appeal, examine whether the requirements of Rules 224.1, 225, 227 and 228 have been complied with.
2. If the appellant has not complied with the requirements referred to in Rules 225, 227 and 228, the Registry shall invite the appellant to:
  - (a) correct the deficiencies within 14 days; and
  - (b) where applicable, pay the fee for the appeal within 14 days.

If the appellant has not met the requirement of paragraph 1 or if the applicant fails to correct the deficiencies or pay the fee the Registry shall inform the President of the Court of Appeal who shall reject the appeal as inadmissible by a decision by default. He may give the appellant an opportunity to be heard beforehand.

### **Rule 230 – Recording in the register (Court of Appeal)**

1. If the Statement of appeal complies with the requirements referred to in Rule 229.1, the Registry shall,
  - (a) record the date of receipt to the Statement of appeal and a case number to the appeal file,
  - (b) record the appeal file in the register,
  - (c) inform the appellant of the case number and the date of receipt.
2. The President of the Court of Appeal shall assign the case to a panel. Unless otherwise agreed by the panel the most senior judge shall be the presiding judge.

### **Rule 231 – Designation of the judge-rapporteur**

The presiding judge of the panel to which the case has been assigned shall designate one judge of the panel as judge-rapporteur. The presiding judge may designate himself as the judge-rapporteur. The Registry shall as soon as practicable notify the appellant and respondent of the identity of the judge-rapporteur.

### **Rule 232 – Translation of file**

1. If the language of the proceedings before the Court of Appeal is not the language of the proceedings before the Court of First Instance, the judge-rapporteur may order the appellant to lodge, within a time period to be specified, translations into the language of the proceedings before the Court of Appeal of
  - (a) written pleadings and other documents lodged by the parties before the Court of First Instance, as specified by the judge-rapporteur,
  - (b) decisions or orders of the Court of First Instance.
2. If the appellant fails to lodge the translations under paragraph 1 within the period specified, the Court of Appeal may reject the appeal by a decision by default in accordance with Rule 357. The panel may give the appellant an opportunity to be heard beforehand.
3. The appellant may request that documented costs of translations be taken into account when the Court fixes the amount of costs in accordance with Part 1, Chapter 5.

*Relation with draft Agreement: Article 50(2) and (3)*

### **Rule 233 – Preliminary examination of the Statement of grounds of appeal**

1. The judge-rapporteur shall examine whether the Statement of grounds of appeal satisfies the requirements of Rule 226.
2. If the Statement of grounds of appeal does not comply with the requirements of Rule 226, the judge-rapporteur shall give the appellant leave to amend the Statement of grounds of appeal within such period as he may decide. If the appellant fails to amend the Statement within such period the Court of Appeal may reject the appeal as inadmissible. The panel may give the appellant an opportunity to be heard beforehand.
3. Grounds of appeal which are not raised within the period specified for the Statement of grounds of appeal in Rule 224.2 shall not be admissible.

### **Rule 234 – Challenge to the decision to reject an appeal as inadmissible**

1. The appellant may challenge a decision to reject the appeal as inadmissible under Rules 224.1, 229.2 or 233.2 within one month of service of the decision, without providing new grounds of appeal.
2. The panel to which the case has been assigned under Rule 230.2 shall decide any challenge under paragraph 1.
3. If a decision to reject an appeal as inadmissible is set aside, the appeal shall take its normal course.

## **SECTION 2 – STATEMENT OF RESPONSE**

### **Rule 235 – Statement of response**

Within three months of service of the Statement of grounds of appeal, any other party to proceedings before the Court of First Instance shall lodge any Statement of response.

### **Rule 236 – Contents of the Statement of response**

1. The \*Statement of response shall contain
  - (a) the names of the respondent and the respondent's representative,
  - (b) postal and electronic addresses for service on the respondent and the names of the persons authorised to accept service,
  - (c) the case number of the appeal file,
  - (d) a response to the grounds of appeal.
2. The respondent may support the decision of the Court of First Instance on grounds other than those given in the decision.

### **Rule 237 – Statement of cross-appeal**

1. A party who has not lodged a Statement of appeal within the period referred to in Rule 260.1 may still bring an appeal by way of cross-appeal within the period referred to in Rule 235 if one of the other parties has lodged a Statement of appeal.
2. A \*Statement of cross-appeal shall be included in the Statement of response. It shall comply with the requirements of Rules 225 and 226. Rules 229 and 233 shall apply *mutatis mutandis* to the Statement of cross-appeal.
3. A Statement of cross-appeal shall not be admissible in any other way or at any other time.
4. A cross-appeal shall be treated as an appeal as far as the fee for the appeal is concerned. Rule 228 shall apply *mutatis mutandis*.
5. If the Statement of appeal is withdrawn, any Statement of cross-appeal shall be deemed to be withdrawn.

<b>Rule 28 on Further schedule shall apply <i>mutatis mutandis</i></b>
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### **SECTION 3 – REPLY TO A STATEMENT OF CROSS-APPEAL**

#### **Rule 238 – Reply to a statement of cross-appeal**

Where the Statement of response includes a statement of cross-appeal, the appellant may, within two months of service of the Statement of response, lodge a \*Reply to the Statement of cross-appeal which shall contain a response to the grounds of appeal raised in the Statement of cross-appeal.

## **CHAPTER 2 – INTERIM PROCEDURE**

### **Rule 239 – Role of the judge-rapporteur**

Upon the expiry of the periods specified in Rules 224 to 238 the judge-rapporteur shall make all necessary preparations for the oral hearing. Subject always to the provisions of Rule 222, the judge-rapporteur shall have the powers and exercise the duties set out in Rules 101 to 110 *mutatis mutandis*.

As soon as the judge-rapporteur considers that the appeal is ready for oral hearing he shall summon the parties to the oral hearing. At least two months notice shall be given unless the parties agree to a shorter time period. The interim procedure shall be deemed closed and oral procedure shall start immediately on the giving of such summons. The presiding judge shall, in consultation with the judge-rapporteur take over the management of the case.

## **CHAPTER 3 – ORAL PROCEDURE**

### **Rule 240 – Conduct of the oral hearing**

Subject to Rule 241 the oral hearing shall be held before the panel and shall be directed by the presiding judge. Subject always to Rule 222, Rules 111, 112, 115, 116, 117 and 321 shall apply *mutatis mutandis*.

### **Rule 241 – Conduct of the oral hearing for an appeal of a costs order**

The oral hearing for an appeal of a costs order pursuant to Rule 157 shall be heard by the standing judge [Rule 223.1] alone who shall have all the powers of the Court of Appeal.

## **CHAPTER 4 – DECISIONS AND EFFECT OF DECISIONS**

### **Rule 242 – Decision of the Court of Appeal**

1. The decision shall either reject the appeal or set the decision or order aside totally or in part substituting its own decision or order, including an order for costs both in respect of the proceedings at first instance and on appeal.

2. The Court of Appeal may

- (a) exercise any power within the competence of the Court of First Instance,
- (b) refer the case back to the Court of First Instance [Rule 243].

*Relation with draft Agreement: Article 75*

### **Rule 243 – Referral back**

1. In exceptional circumstances, the Court of Appeal may refer the case back to the Court of First Instance for decision or for retrial.
2. The decision referring a case back to the Court of First Instance shall specify whether it the same panel whose earlier decision or order is revoked shall deal further with the case or whether another panel shall be appointed by the President of the Court of First Instance.
3. Where a case is referred back to the Court of First Instance, the Court shall be bound by the decision of the Court of Appeal and its *ratio decidendi*.

*Relation with draft Agreement: Article 75*

## **CHAPTER 5 – PROCEDURE FOR APPLICATION FOR REHEARING**

### **Rule 245 – Lodging of an Application for rehearing**

1. An Application for rehearing may be lodged by any party adversely affected by a final decision (hereinafter "the final decision") of the Court of First Instance for which the time for lodging an appeal has expired or of the Court of Appeal (hereinafter "the petitioner").
2. The Application for rehearing shall be lodged at the Court of Appeal within the following periods:
  - (a) where the Application for rehearing is based on the ground of a fundamental procedural defect, within two months of service of the final decision;
  - (b) where the Application for rehearing is based on an act which has been held, by a final court decision, to constitute a criminal offence, within two months of the date on which the criminal offence has been so held
  - (c) but in any event no later than ten years of service of the final decision..

*Relation with draft Agreement: Article 81  
[EPLA RoP §175+200+202, Article 112a(4) EPC]*

### **Rule 246 – Contents of the Application for rehearing**

1. The \*Application for rehearing shall contain
  - (a) the names of the petitioner and of the petitioner's representative,
  - (b) postal and electronic addresses for service on the petitioner and the names of the persons authorised to accept service and
  - (c) an indication of the decision to be reviewed.
2. The Application for rehearing shall indicate the reasons for setting aside the final decision, as well as the facts and evidence on which the Application is based.



### **Rule 247 – Fundamental procedural defects**

A fundamental procedural defect under Article 88(1) of the Agreement may have occurred, for example, where

- (a) a judge of the Court of Appeal took part in the decision in breach of Article 17 of the Agreement or Article 7 of the Statute,
- (b) a person not appointed as a judge of the Court of Appeal sat on the panel which took the final decision,
- (c) a fundamental violation of Article 67 of the Agreement occurred in the proceedings which have led to the final decision,
- (d) the Court of Appeal decided the appeal without deciding on a request relevant to that decision or
- (e) a breach of Article 6 of the Convention for the Protection of Human Rights and Fundamental Freedoms has occurred.

*[Article 112a(2) EPC and Rule 104 EPC]*

### **Rule 248 – Obligation to raise objections**

An Application for rehearing based on the ground of a fundamental procedural defect is only admissible where an objection in respect of the procedural defect was raised during the proceedings before the Court of Appeal and dismissed by the Court, except where such objection could not be raised during the proceedings before the Court of Appeal.

*[Rule 106 EPC]*

### **Rule 249 – Definition of criminal offence**

A criminal offence shall only be considered to have occurred if it is finally held to be such an offence by a competent court or authority. A conviction is not necessary.

*[Rule 105 EPC]*

### **Rule 250 – Fee for the rehearing**

The petitioner shall pay the fee for the rehearing [EUR\*\*\*], in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*. The court may waive payment of the fee in the circumstances contemplated by Rule 245.2(a) or (b).

**Rule 230.1 on Recording in the register (Court of Appeal) shall apply *mutatis mutandis***

### **Rule 251 – Suspensive effect**

The lodging of an Application for rehearing shall not have suspensive effect unless the Court of Appeal decides otherwise.

*Relation with draft Agreement: Article 81(2)*

### **Rule 252 – Examination as to formal requirements of the Application for rehearing**

1. The Registry shall, as soon as practicable after the lodging of the Application for rehearing, examine whether the requirements of Rules 245, 246 and 250 have been complied with.
2. If the petitioner has not complied with the requirements referred to in paragraph 1, the Registry shall invite the petitioner to:
  - (a) correct the deficiencies within 14 days; and
  - (b) where applicable, pay the fee for the rehearing within 14 days.If the petitioner fails to correct the deficiencies or pay the fee the Registry shall inform the President of the Court of Appeal who may reject the Application for rehearing as inadmissible. He may give the petitioner an opportunity to be heard beforehand.

### **Rule 253 – Assignment of Request for rehearing to a panel**

1. Immediately after the Request for rehearing has been recorded in the register, the Registry shall inform the President of the Court of Appeal that a Request for rehearing has been lodged.
2. The President of the Court of Appeal shall assign the case to a panel consisting of three legally qualified judges, designating one judge as judge-rapporteur. He may order that judges of the Court who participated in taking the decision to be reviewed shall not sit on the panel.

### **Rule 254 – Examination of the Application for rehearing**

1. The judge-rapporteur shall examine the Application for rehearing. He may hear the petitioner.
2. If the judge-rapporteur considers that there is no basis for reviewing the decision, he shall reject the Application for rehearing as not allowable and shall give his reasons in writing for such rejection.
3. If the judge-rapporteur considers that the Application is allowable he shall refer the Application to the panel for decision.
4. The panel may make
  - (a) a decision to reject the Application for rehearing as not allowable; such a decision shall require a unanimous vote of the judges on the panel; it shall not contain any reasons;
  - (b) a decision to allow the Request for rehearing; such a decision shall set aside the decision under review, in whole or in part, and re-open the proceedings for a new hearing and decision; where proceedings are re-opened, the provisions governing proceedings before the Court of Appeal shall apply.

*Relation with draft Agreement: Article 81(3)*

## **PART 5 – GENERAL PROVISIONS**

### **CHAPTER 1 – GENERAL PROCEDURAL PROVISIONS**

#### **Rule 260 – Examination by the Registry of its own motion**

1. In any proceedings before the Court, the Registry shall, as soon as practicable in the proceedings, of its own motion, examine whether an opt-out has effect for the patent or patents concerned.
2. Where the Registry notes that two or more actions between the same parties and concerning the same patent or patents are initiated before several divisions, it shall as soon as practicable inform the divisions concerned.

*Relation with draft Agreement: Article 83(3) and (4)*

*Relation with draft Statute: Articles 23 and 24*

#### **Rule 261 – Date of pleadings**

All pleadings shall bear a date which shall be the date of receipt of pleadings in electronic form at the Registry.

## **Rule 262 – Public access to the register**

1. Written pleadings, written evidence, decisions and orders lodged at the Court and recorded by the Registry shall be available to the public for on-line consultation, unless a party requests that certain information be kept confidential and the Court makes such an order.
2. A party may lodge an Application with the Court for an order that certain information should be excluded from public access or restricted to certain named persons on the grounds set out in and in accordance with Article 58 of the Agreement.
3. The \*Application shall contain:
  - (a) details of the information alleged to be confidential or otherwise to be restricted,
  - (b) the grounds upon which the applicant claims the information should be restricted and
  - (c) details of the persons to be prohibited from access to the information or conversely to be allowed access.
4. The Court shall invite written comments from any other party prior to making any order.
5. The Registrar shall as soon as practicable take all such steps with regard to access to the register as may be necessary to give effect to an order of the Court under this Rule.

*Relation with draft Agreement: Articles 10, 45 and 58*

*Relation with draft Statute: Article 24(2)*

### **Rule 263 – Leave to change claim or amend case**

1. A party may at any stage of the proceedings apply to the Court for leave to change its claim or to amend its case, including adding a counterclaim. Any such application shall explain why such change or amendment was not included in the original pleading.
2. Leave shall not be granted if, all circumstances considered, the party seeking the amendment cannot satisfy the Court that
  - (a) the amendment in question could not have been made with reasonable diligence at an earlier stage; and
  - (b) the amendment will not unreasonably hinder the other party in the conduct of its case.
3. Leave to limit a claim unconditionally shall always be granted.

### **Rule 264 – An opportunity to be heard**

Where these rules provide that a party or parties shall or may be given an opportunity to be heard before the Court makes an order or takes some action the Court shall or may (as the case may be) request the parties to provide written submissions within a specified period and/or shall or may invite the parties to an oral hearing on a fixed date by the Court. The Court may also order that a hearing take place by telephone or video conference.

### **Rule 265 – Withdrawal**

1. As long as there is no final decision in a case, a plaintiff may apply to withdraw his action. The Court shall decide the application after hearing the other party (or parties). The application to withdraw shall not be permitted if the other party (or parties) has (have) a legitimate interest in the action being decided by the Court.
2. If withdrawal is permitted, the Court shall
  - (a) give a decision declaring the proceedings closed,
  - (b) order the case to be removed from the register and
  - (c) issue a cost order in accordance with Part 1, Chapter 5.

## **Rule 266 – Preliminary references to the Court of Justice of the European Union**

1. At any stage of the proceedings where a question is raised by a party before the Court which in the opinion of the Court requires the Court of Justice of the European Union (“CJEU”) to give a ruling before the Court can give judgement, the Court of First Instance may and the Court of Appeal shall of its own motion or at the request of a party make an order for a reference to the CJEU for a preliminary ruling.
2. The order of the Court shall set out as clearly and succinctly as possible the question on which the Court seeks a preliminary ruling and shall in addition provide the following details:
  - (a) the division or the Court of Appeal making the reference;
  - (b) the parties;
  - (c) a summary of the proceedings including the essential facts;
  - (d) an explanation of why a ruling is sought;
  - (e) the provisions of European Union law in question;
  - (f) a copy of a decision, if any, by the Court on the question.
3. If the Court requests the CJEU to apply its urgent procedure the order shall in addition set out
  - (a) the matters of fact and law which establish its urgency, and
  - (b) the reasons why an urgent ruling is appropriate.
4. The Registrar shall as soon as practicable forward the order and any request to apply the urgent preliminary procedure to the Registrar of the CJEU.
5. Unless otherwise decided by the Court the proceedings shall be stayed until the CJEU has given a preliminary ruling on the question.

## **CHAPTER 2 – SERVICE**

### **SECTION 1 – SERVICE WITHIN THE CONTRACTING MEMBER STATES OR BY AGREEMENT**

#### **Rule 270 – Scope of this Section**

1. The rules for service of the Statement of claim set out in this Section shall apply whenever the defendant has provided an electronic address for the purpose of service of the proceedings under Rule 271.1 or .2 or has an address for service for the purpose of any one of the modes of service here provided within the territory of any of the Contracting States.
2. A Statement of claim, irrespective of where it is lodged, may be served in the manner here provided on a defendant in the territory of any of the Contracting Member States.
3. For the purpose of Rules 270 to 275 the term Statement of claim shall, where appropriate, include a Statement for revocation (Rule 45), a Statement for a declaration of non-infringement (Rule 62), an Application for preserving evidence (Rule 192) and an Application for provisional measures (Rule 206).



### **Rule 271 - Service of the Statement of claim**

1. The Registry may serve the Statement of claim on the defendant at an electronic address which the defendant has provided for the purpose of service in the proceedings.

2. Where

(a) the defendant has provided the electronic address of a representative as an address at which the defendant may be served with the Statement of claim or

(b) a representative acting for the defendant has notified the Registry or the plaintiff that he accepts service of the Statement of claim on behalf of the defendant at an electronic address, the Registry may serve the Statement of claim at the electronic address of that representative.

3. Where service by means of electronic communication cannot be effected, the Registry shall serve the Statement of claim on the defendant by

(a) registered letter with advice of delivery;

(b) fax, or

(c) any method authorised by the Court under Rule 275.

4. Service under Rule 271.3 shall be effected at the following place:

(a) where the defendant is a company or other legal person: at its statutory seat, central administration or principal place of business within the Contracting Member States or at any place within the Contracting Member States where the company or other legal has a place of business

(b) where the defendant is an individual: by leaving it with him or at his usual or last known address.

5. A Statement of claim served in accordance with paragraphs 1, 2 and 3 is deemed to be served on the defendant

(a) where service takes place by means of electronic communication or by fax: on the day where the relevant electronic message was sent or the transmission of the fax was completed (GMT+1);

(b) where service takes place by registered letter with advice of delivery: 10 working days after posting, leaving with, delivering to or collection by the relevant service provider.

### **Rule 272 – Notice of service and non-service of the Statement of claim**

1. The Registry shall inform the plaintiff of the date on which the Statement of claim is deemed served under Rule 271.5.

2. Where the Registry has served the Statement of claim by registered letter with advice of delivery and the Statement of claim is returned to the Registry, the Registry shall inform the plaintiff.

3. Paragraph 2 shall apply *mutatis mutandis* where the Registry has served the Statement of claim by fax and the fax appears not to have been received.

## SECTION 2 – SERVICE OUTSIDE THE CONTRACTING MEMBER STATES

### Rule 273 – Scope of this Section

This Section applies to service of a Statement of claim in any case in which the defendant has not provided an electronic address for service of the proceedings or otherwise may not be served within the territory of the Contracting Member States in a manner provided for under any of the methods prescribed in Section 1.

### Rule 274 – Service outside the Contracting Member States

1. Where a Statement of claim is to be served outside the Contracting Member States, it may be so served by the Registry:

(a) by any method provided by:

- (i) Regulation (EC) No 1393/2007 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters (“the EU Service Regulation”) where it applies; or,
- (ii) The Hague Convention on the service abroad of judicial and extra-judicial documents in civil or commercial matters 1965 (“the Hague Service Convention”) or any other applicable convention where it applies; or,
- (iii) to the extent that there is no such convention in force, either by service through diplomatic or consular channels from the Contracting Member State in which the Registry is established; or,

(b) by any method permitted by the law of the state where service is to be effected.

2. No Statement of claim may be served in a manner which is contrary to the law of the state where service is effected.

#### *Applicable law*

*Service within the Union (except for DK): Council Regulation (EC) No 1348/2000 of 29 May 2000 on the service in the Member States of judicial and extrajudicial documents in civil or commercial matters*

*Service in Denmark: Agreement between the EU and Denmark of 19 October 2005 on the service of judicial and extrajudicial documents in civil or commercial matters*

*Service outside the Union: The Hague Convention of 15 November 1965 on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters*

## **SECTION 3 – SERVICE BY AN ALTERNATIVE METHOD**

### **Rule 275 – Service of the Statement of claim by an alternative method or at an alternative place**

1. Where it appears to the Court that there is a good reason to authorise service by a method or at a place not otherwise permitted by this Chapter, the Court may by way of order permit service by an alternative method or at an alternative place.
2. On a reasoned request, the Court may order that steps already taken to bring the Statement of claim to the attention of the defendant by an alternative method or at an alternative place is good service.
3. An order under this rule shall specify
  - (a) the method or place of service,
  - (b) the date on which the Statement of claim is deemed served and
  - (c) the period for filing the Statement of defence.
4. No order for alternative service under this Rule outside the Contracting Member States shall be made permitting service in a manner that is contrary to the law of the state where service is to be effected.

## **SECTION 4 – SERVICE OF ORDERS AND DECISIONS**

### **Rule 276 – Service of orders and decisions**

Any order or decision of the Court shall be served on each of the parties in accordance with the provisions of Sections 1 or 2 of this Chapter, as the case may be.

### **Rule 277 – Decisions by default under Part 5, Chapter 11**

No decision by default shall be entered under Chapter 11 unless the Court is satisfied that either:

- (a) The Statement of claim was served by a method prescribed by the internal law of the state addressed for the service of documents in domestic actions upon persons who are within its territory; or
- (b) The Statement of claim was actually delivered to the defendant or to his residence or place of business by another method provided for under this Chapter 2.

### **Rule 278 – Service of other pleadings**

1. As soon as practicable after written pleadings have been received at the Registry, the Registry shall serve the pleadings on the other party by means of electronic communication.

2. Where service by means of electronic communication cannot be effected, the Registry shall serve the written pleadings on the party by

(a) registered letter with advice of delivery;

(b) fax, or

(c) any method authorised by the Court under Rule 275.

3. Service under paragraph 2(a) shall be effected at the following place:

(a) where the party is a company or other legal person: at its statutory seat, central administration, principal place of business or at any place within the Contracting Member States where the company or other legal person carries on its activities and which has a real connection with the claim;

(b) where the party is an individual: at his usual or last known residence.

### **Rule 279 – Change of electronic address for service**

Where the electronic address for service of a party changes, that party must give notice in writing of the change as soon as it has taken place to the Court and every other party.

## **CHAPTER 3 – RIGHTS AND OBLIGATIONS OF REPRESENTATIVES**

### **Rule 285 – Powers of attorney**

1. A representative who claims to be representing a party shall be accepted as such provided however the Court may order a representative to produce a written authority if his representative powers are challenged.

### **Rule 286 – Certificate that a representative is authorised to practice before the Court**

1. A representative pursuant to Article 48(1) of the Agreement shall lodge at the Registry a certificate that he is a lawyer authorised to practise before a court of a Contracting Member State. Lawyers within the meaning of Article 48(1) of the Agreement are also jurists authorised to practice in patent related matters before a court in a Contracting Member State and they shall lodge a certificate evidencing such authorisation. In subsequent cases the representative may refer to the certificate previously lodged.

2. A representative pursuant to Article 48(2) of the Agreement shall lodge at the Registry the European Patent Litigation Certificate as defined by the Administrative Committee or otherwise justify that he has appropriate qualifications to represent a party before the Court. In subsequent cases such representative may refer to the certificate or other evidence of appropriate qualification previously lodged.

### **Rule 287 – Attorney-client privilege**

1. Where a client seeks advice from a lawyer he has instructed in a professional capacity, then any confidential communication (whether written or oral) between them relating to the seeking or the provision of that advice is permanently privileged from disclosure, whether in court or arbitration proceedings of any nature or in the face of any compulsory information gathering powers of any body.
2. This privilege applies to communications between a client and a lawyer employed by the client and instructed to act in a professional capacity and a client and a patent attorney or agent (including a patent attorney or agent employed by the client) who is instructed in his professional capacity to advise on patent matters;
3. This privilege extends to the work product of the lawyer or patent attorney or agent (including communications between lawyers and/or patent attorneys or agents employed in the same firm or entity or between lawyers and/or patent attorneys or agents employed by the same client) and to any record of a privileged communication.
4. This privilege prevents the lawyer or patent attorney or agent and his client from being questioned or examined about the contents or nature of their communications;
5. This privilege may be expressly waived by the client.
6. The expressions “patent attorney” and “patent agent” shall bear the meanings given to them by the law of the contracting state to the Agreement in which the individual practises.

*Relation to draft Agreement: Article 48(4)*

### **Rule 288 – Litigation privilege**

1. Where a client, or a lawyer or patent attorney or agent instructed by a client in a professional capacity, communicates confidentially with a third party for the purposes of obtaining information or evidence of any nature for the purpose of or for use in any proceedings reasonably anticipated or pending before the Court, such communications shall be permanently privileged from disclosure in the same way and to the same extent as provided for in Rule 287.

2. Rule 287.6 shall apply *mutatis mutandis*.

*Relation to draft Agreement: Article 48(5)*

### **Rule 289 – Privileges, immunities and facilities**

1. Representatives appearing before the Court or before any judicial authority to which it has addressed letters rogatory [Rule 199] shall enjoy immunity in respect of words spoken or written by them concerning the case or the parties.
2. Representatives shall enjoy the following further privileges and facilities:
  - (a) papers and documents relating to the proceedings shall be exempt from both search and seizure;
  - (b) any allegedly infringing product or device relating to the proceedings shall be exempt from both search and seizure when brought to the Court for the purposes of the proceedings. In the event of a dispute, customs officials or police may seal those papers, documents or allegedly infringing products or devices. They shall then be immediately forwarded to the Court for inspection in the presence of the Registrar and of the person concerned.
3. Representatives shall be entitled to travel in the course of duty without hindrance.
4. The privileges, immunities and facilities specified in paragraphs 1 to 3 are granted exclusively in the interests of the proper conduct of proceedings.
5. The Court may waive the immunity where it considers that a representative is guilty of conduct which is contrary to the proper conduct of proceedings.

*Relation with draft Agreement: Article 48*

### **Rule 290 – Powers of the Court as regards representatives**

1. As regards representatives who appear before it, the Court shall have the powers normally accorded to courts of law, under the conditions laid down in Rule 291.
2. Representatives who appear before the Court shall strictly comply with any code of conduct adopted for such representatives by the Court.

### **Rule 291 – Exclusion from the proceedings**

1. If the Court considers that the conduct of a party's representative towards the Court, towards any judge of the Court or towards any member of the staff of the Registry is incompatible with the dignity of the Court or with the requirements of the proper administration of justice, or that such representative uses his rights for purposes other than those for which they were granted, or that such representative is otherwise in breach of any code of conduct adopted pursuant to Rule 290.2 it shall so inform the person concerned.

On the same grounds, the Court may at any time, after having given the person concerned an opportunity to be heard, exclude that person from the proceedings by way of order. That order shall have immediate effect.

2. Where a party's representative is excluded from the proceedings, the proceedings shall be suspended for a period fixed by the presiding judge in order to enable the party concerned to appoint another representative.

### **Rule 292 – Patent attorneys' right of audience**

1. For the purposes of Article 48(4) of the Agreement, the term "patent attorneys" assisting a representative referred to in Article 28(1) of the Agreement shall mean persons meeting the requirements of Article 134(1) or (3)(a) to (c) EPC or the professional requirements of the Contracting Member State to the Agreement in which the individual practises.

2. Such patent attorneys shall be allowed to speak at hearings of the Court at the discretion of the Court and subject to the representative's responsibility to coordinate the presentation of a party's case.

3. Rules 287 to 291 shall apply *mutatis mutandis*.

*Relation with draft Agreement: Article 48(4)*

### **Rule 293 – Change of a representative**

Any change of representative shall take effect from the receipt by the Registry of notification that a new representative shall in future be representing the party concerned. Until the moment where such statement is received, the former representative remains responsible for the conduct of the proceedings and for communications between the Court and the party concerned.



## **CHAPTER 4 – STAY OF PROCEEDINGS**

### **Rule 295 – Stay of proceedings**

The Court may stay proceedings

- (a) where it is seized of a case relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings] before the European Patent Office or a national authority;
- (b) where it is seized of a case relating to a supplementary protection certificate which is also the subject of proceedings before a national court or authority;
- (c) where an appeal is brought before the Court of Appeal against a decision or order of the Court of First Instance
  - (i) disposing of the substantive issues in part only,
  - (ii) disposing of an admissibility issue or a Preliminary objection,
  - (iii) dismissing an application to intervene [Rule 313];
- (d) at the joint request of the parties;
- (e) pursuant to Rule 37;
- (f) pursuant to Rule 118;
- (g) pursuant to Rule 136;
- (h) in particular cases where the proper administration of justice so requires.

### **Rule 296 – Duration and effects of a stay of proceedings**

1. The stay of proceedings shall take effect on the date indicated in the order to stay or, in the absence of such an indication, on the date of that order. The Court shall stipulate what effect the stay shall have on any existing orders.
2. Where the order to stay does not fix the length of the stay, it shall end on the date indicated in the order to resume proceedings or, in the absence of such indication, on the date of the order to resume.
3. While proceedings are stayed, time shall cease to run for the purposes of procedural periods. Time shall begin to run afresh for the purposes of procedural periods from the date on which the stay of proceedings comes to an end.

### **Rule 297 – Resumption of proceedings**

Any decision referred to in Rule 296.2 or ordering the resumption of proceedings before the end of the stay shall be made by reasoned order of the judge-rapporteur after hearing the parties. The judge-rapporteur may refer the matter to the panel.

### **Rule 298 - Accelerated proceedings before the European Patent Office**

The Court may of its own motion or at the request of a party request that opposition proceedings or limitation proceedings (including any subsequent appeal proceedings) before the European Patent Office be accelerated in accordance with the proceedings of the European Patent Office. The Court may stay its proceedings in accordance with Rule 295 pending the outcome of such request and any subsequent accelerated proceedings.

## CHAPTER 5 – TIME PERIODS

### Rule 300 – Calculation of periods

Any period of time prescribed by the Agreement, the Statute, these Rules of Procedure or any order of the Court for the taking of any procedural step shall be laid down in terms of full days, weeks, months or years and shall be reckoned as follows:

- (a) computation shall start on the day following the day on which the relevant event occurred;
- (b) when a period is expressed as one year or a certain number of years, it shall expire in the relevant subsequent year in the month having the same name and on the day having the same number as the month and the day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month;
- (c) when a period is expressed as one month or a certain number of months, it shall expire in the relevant subsequent month on the day which has the same number as the day on which the said event occurred. If the relevant subsequent month has no day with the same number, the period shall expire on the last day of that month;
- (d) when a period is expressed as one week or a certain number of weeks, it shall expire in the relevant subsequent week on the day having the same name as the day on which the said event occurred;
- (e) day shall mean a calendar day unless expressed as working a day
- (f) calendar days shall include official holidays of the Contracting Member State in which the division concerned or the Court of Appeal is located, Sundays and Saturdays;
- (g) working days shall not include official holidays of the contracting Member State in which the division concerned or the Court of Appeal is located, Sundays and Saturdays.
- (h) periods shall not be suspended during the judicial vacations.

[EPC Rule 131]

### Rule 301 – Automatic extension of periods

1. If a period expires on a Saturday, Sunday or official holiday of the Contracting Member State in which the division or section of the central division concerned or the Court of Appeal is located, it shall be extended until the end of the first following working day.
2. Paragraph 1 shall apply *mutatis mutandis* if documents filed in electronic form cannot be received by the Court.

## **CHAPTER 6 – PARTIES TO PROCEEDINGS**

### **SECTION 1 – PLURALITY OF PARTIES**

#### **Rule 302 – Plurality of plaintiffs or patents**

1. The Court may order that proceedings commenced by a plurality of plaintiffs or in respect of a plurality of patents be heard in separate proceedings.
2. Where the Court orders a separation of proceedings the Court shall decide on the payment of a new court fee (or court fees) in accordance with Part 6.
3. The Court may order that parallel infringement or revocation proceedings relating to the same patent (or patents) and before the same local or regional division or the central division or the Court of Appeal be heard together where it is in the interests of justice to do so.

#### **Rule 303 – Plurality of defendants**

1. Proceedings may be started against a plurality of defendants if the court has competence in respect of all of them.<sup>5</sup>
2. The Court may separate the proceedings into two or more separate proceedings against different defendants.
3. Where the Court orders a separation of proceedings under paragraph 2, the plaintiffs in the new proceedings shall pay a new court fee in accordance with Part 6, unless the Court decides otherwise.

#### **Rule 304 – Court fees in case of plurality of parties**

If and as long as a plurality of parties in a case are represented by one and the same representative and take the same position, they shall be regarded as one party as far as the payment of court fees is concerned.

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<sup>5</sup> The Drafting Committee believes that Article 33(1)(b) of the Agreement is narrower in scope than Article 6 of Regulation (EU) No 1215/2012 (Brussels Regulation).

## **SECTION 2 – CHANGE IN PARTIES**

### **Rule 305 – Change in parties**

1. The Court may, on application by a party, order a person to
  - (a) be added as a party,
  - (b) cease to be a party,
  - (c) be substituted for a party.
2. The Court shall invite other parties to the proceedings to comment on the application, as soon as practicable after service of the application.
3. When ordering that a person shall become a party or shall cease to be a party, the Court may make appropriate orders as to payment of court fees and costs as regards such party.

### **Rule 306 – Consequences for the proceedings**

1. Where the Court orders that a party be added, removed or substituted under Rule 305.1, it shall give directions to regulate the consequences as to case management.
2. The Court shall also determine the extent to which a new party is bound by the proceedings as then constituted.

## **SECTION 3 – DEATH, DEMISE OR INSOLVENCY OF A PARTY**

### **Rule 310 – Death or demise of a party**

1. If a party dies or ceases to exist during proceedings, the proceedings shall be stayed until such party is replaced by his successor or successors. The Court may specify a period in this respect.
2. If there are more than two parties to the proceedings, the Court may decide that
  - (a) proceedings between the remaining parties be continued separately and
  - (b) the stay shall only concern the proceedings regarding the party that no longer exists.
3. If the successor or successors of the party that died or ceased to exist does not or do not continue the proceedings of his or their own motion, within a period specified by the Court, any other party may, of its own motion or on an order of the Court, file continuation proceedings against such successor or successors.
4. Continuation proceedings shall be brought before the Court in accordance with Part 1. The Court shall decide whether, and if so, to what extent, the successor or successors will take the position of the defendant who has died or ceased to exist in the main proceedings.
5. The costs of continuation proceedings shall be decided independently from the costs of the main proceedings and solely on the basis of the outcome of the continuation proceedings.

### **Rule 311 – Insolvency of a party**

1. If a defendant is declared insolvent under the national law of his residence or principal place of business or, in the absence of residence or principal place of business, place of business proceedings may be stayed until the competent national authority or person dealing with the insolvency has decided whether to continue the proceedings or not.
2. The plaintiff may withdraw the case against an insolvent defendant in accordance with Rule 345. Such withdrawal shall not prejudice the case against other defendants.
3. Any costs order in favour of an insolvent party under Rule 156 shall be payable to the competent national authority or person dealing with the insolvency.
4. If proceedings are continued, the effect of a decision of the Court as regards the insolvent party in the case shall be determined by the national law of that party.

## **SECTION 4 – TRANSFER OF PATENT**

### **Rule 312 – Transfer of the patent or patent application during proceedings**

1. If a patent or patent application is transferred, for one or more Contracting Member States, to another proprietor after proceedings have been started before the Court, the Court may authorise the new proprietor to take over the proceedings to the extent that the patent has been transferred to him.
2. If the new proprietor takes over the proceedings, no new court fee shall be payable, even if the new proprietor is represented by a new representative.
3. If the new proprietor chooses not to take over the proceedings, any decision in proceedings that have been recorded in the register shall be binding upon him.

## **SECTION 5 – INTERVENTION**

### **Rule 313 – Application to intervene**

1. An Application to intervene may be lodged at any stage of the proceedings before the Court of First Instance or the Court of Appeal by any person establishing a legal interest in the result of a case submitted to the Court (hereinafter "the intervener").
2. An Application to intervene shall be admissible only if it is made in support, in whole or in part, of a claim, order or remedy sought by one of the parties and is made before the closure of the written procedure unless the Court of First Instance or Court of Appeal orders otherwise.
3. The intervener shall be represented in accordance with Article 48 of the Agreement.
4. The \*Application to intervene shall contain
  - (a) a reference to the case number of the file,
  - (b) the names of the intervener and of the intervener's representative, as well as postal and electronic addresses for service and the names of the persons authorised to accept service,
  - (c) the claim, order or remedy in support of which intervention is sought by the intervener,
  - (d) a statement of the facts establishing the right to intervene under paragraphs 1 and 2.

#### **Rule 314 – Order on Application to intervene**

The judge-rapporteur shall decide on the admissibility of the Application to intervene by way of order. The other parties shall be given an opportunity to be heard beforehand.

#### **Rule 315 – Statement in intervention**

1. If an Application to intervene is admissible, the judge-rapporteur or the presiding judge shall
  - (a) inform the parties to proceedings and
  - (b) specify a period within which the intervener may lodge a Statement in intervention.
2. The Registry shall as soon as practicable serve on the intervener any written pleading served by the parties. On a reasoned request by a party the Court may for the protection of confidential information order that a pleading or part of a pleading be disclosed only to certain named persons and subject to appropriate terms of non-disclosure.
3. The \*Statement in intervention shall contain
  - (a) a statement as to the issues involving the intervener and one or more of the parties, and their connection to the matters in dispute,
  - (b) the arguments of law,
  - (c) the facts and evidence relied on.
4. The intervener shall be treated as a party, unless otherwise ordered by the Court.

#### **Rule 316 – Invitation to intervene**

1. The judge-rapporteur or the presiding judge may, of his own motion (but only after consulting the parties) or on a reasoned request from a party, invite any person concerned by the outcome of the dispute to inform the Court, within a period to be specified, whether he wishes to intervene in the proceedings.
2. If the person wishes to intervene, he shall present his Application to intervene within one month of service of the invitation and his Statement in intervention within such further period to be specified by the judge-rapporteur or the presiding judge. Rule 313.3 and .4 and Rule 315 shall apply *mutatis mutandis*.
3. An intervener shall be bound by the decision in the case.

#### **Rule 317 – No appeal against an order on the Application to intervene**

There shall be no right to appeal from an order refusing an Application to intervene.



## **SECTION 6 – RE-ESTABLISHMENT OF RIGHTS**

### **Rule 320 – Re-establishment of rights**

1. Where a party has failed to observe a time-limit for an appeal under these Rules of Procedure or set by the Court for a cause which, despite all due care having been taken by the party, was outside his control and the non-observance of this time limit has had the direct consequence of causing the party to lose a right or means of redress, the relevant panel of the Court may upon the request of that party re-establish the right or means of redress.
2. The \*Application for Re-establishment of rights shall be lodged with the Registrar for the relevant panel within one month of the removal of the cause for non-observance of the time-limit but in any event within three months of the non-observed time-limit. Within that time-limit a fee for a Request for Re-establishment of rights fixed under Rule 370 shall be paid.
3. The Application shall
  - (a) state the grounds on which it is based and shall set out the facts on which it relies,
  - (b) contain the evidence relied on in the form of affidavits from all persons involved in the non-observance of the time-limit and the persons involved in establishing the precautionary measures of due care taken in order to avoid such cases of non-compliance.
4. The omitted act shall be performed or completed together with Application for Re-establishment within the time-limit mentioned in paragraph 2.
5. There shall be no grant of Re-establishment of rights in respect of the non-observance of the time limit mentioned in paragraphs 2 and 4 of this Rule.
6. The panel shall decide on the Application for Re-establishment of rights by way of order. The other parties shall be given an opportunity to be heard beforehand.
7. There shall be no right to appeal from an order rejecting an Application for Re-establishment of rights.

## CHAPTER 7 – MISCELLANEOUS PROVISIONS ON LANGUAGES

### **Rule 321 – Application by both parties to use of the language in which the patent was granted as language of the proceedings**

1. At any time during the written procedure, any party may lodge an \*Application by both parties to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(3) of the Agreement. The Application shall state that both parties agree to use the language in which the patent was granted as language of the proceedings.
2. As soon as practicable, the Registry shall forward the Application to the panel.
3. The panel shall, as soon as practicable, decide whether it approves the Application by both parties to use the language in which the patent was granted as language of the proceedings. Where the panel does not approve the Application, the Registry shall as soon as practicable inform the parties who may request, within 10 working days, that the case be referred to the central division and the case shall be transferred accordingly. The period of 10 working days may be extended by the judge-rapporteur on a reasoned request by one of the parties.
4. Where the case is transferred to the central division Rule 41 shall apply *mutatis mutandis*.
5. Where
  - (a) a Statement of claim is drawn up in the language in which the patent was granted, in accordance with Rule 14.1(b)(ii),
  - (b) an Application by both parties to use the language in which the patent was granted as language proceedings is not allowed and
  - (c) the parties do not request that the case be referred to the central division, the plaintiff shall lodge the Statement of claim in a language provided for in Rule 14.1(a), within 10 working days. The period of 10 working days may be extended by the judge-rapporteur on a reasoned request by the plaintiff.
6. The judge-rapporteur shall at the request of a party specify whether any other pleading or document shall be translated and at whose cost.

*Relation with draft Agreement: Article 49(3)*

**Rule 322 - Proposal from the judge-rapporteur to use of the language in which the patent was granted as language of the proceedings**

At any time during the written procedure and the interim procedure, the judge-rapporteur may, of his own motion or on a request by a party after consulting the panel, propose to the parties that the language of the proceedings (Rule 14.2) be changed to the language in which the patent was granted, in accordance with Article 49(4) of the Agreement. If the parties and panel agree the language of the proceedings shall be changed.

*Relation with draft Agreement: Article 49(4)*

**Rule 323 – Application by one party to use the language in which the patent was granted as language of the proceedings**

1. If a party wishes to use the language in which the patent was granted as language of the proceedings, in accordance with Article 49(5) of the Agreement, the party shall include such \*Application in the Statement of Claim, in the case of a plaintiff, or in the Statement of Defence, in the case of a defendant. The judge-rapporteur shall forward the Application to the President of the Court of First Instance.
2. The President shall invite the other party to indicate, within 10 days, its position on the use of the language in which the patent was granted as language of the proceedings.
3. The President, having consulted the panel of the division, may order that the language in which the patent was granted shall be the language of the proceedings and may make the order conditional on specific translation or interpretation arrangements.

*Relation with draft Agreement: Article 49(5)*

**Rule 324 – Consequences where the language of the proceedings is changed in the course of the proceedings**

An \*Application under Rule 321.1 or 323.1 shall specify whether existing pleadings and other documents should be translated and at whose cost. If the parties cannot agree the judge-rapporteur or the President of the Court of First Instance, as the case may be, shall decide in accordance with Rule 321.6 or Rule 323.3.

## **CHAPTER 8 – CASE MANAGEMENT (Measures of organisation of procedure)**

*[Article 43 draft Agreement, CST RoP Part 2, Chapter 3]*

### **Rule 331 – Responsibility for case management**

1. During the written procedure and the interim procedure, case management shall be the responsibility of the judge-rapporteur subject to Rules 102 and 433.
2. The judge-rapporteur may refer a proposed order to the panel.
3. After the closure of the interim conference, case management shall be the responsibility of the presiding judge in consultation with the judge-rapporteur.
4. The Registry shall serve any case management orders on the parties as soon as practicable after the decision of the judge-rapporteur, presiding judge or panel.

### **Rule 332 – General principles of case management**

Active case management includes

- (a) encouraging the parties to co-operate with each other during the proceedings;
- (b) identifying the issues at an early stage;
- (c) deciding promptly which issues need full investigation and disposing summarily of other issues;
- (d) deciding the order in which issues are to be resolved;
- (e) encouraging the parties to make use of the Centre and facilitating the use of the Centre;
- (f) helping the parties to settle the whole or part of the case;
- (g) fixing timetables or otherwise controlling the progress of the case;
- (h) considering whether the likely benefits of taking a particular step justify the cost of taking it;
- (i) dealing with as many aspects of the case as the Court can on the same occasion;
- (j) dealing with the case without the parties needing to attend in person;
- (k) making use of available technical means; and
- (l) giving directions to ensure that the hearing of the case proceeds quickly and efficiently.

### **Rule 333 – Review of case management orders**

1. Case management orders made by the judge-rapporteur or the presiding judge shall be reviewed by the panel, on a reasoned application by a party.
2. An application for the review of a case management order shall be lodged within two weeks of service of the order. The Application shall set out the grounds for review and the evidence, if any, in support of the grounds. The other party shall be given an opportunity to be heard.
3. The party seeking a review shall pay the fee for the review of a case management order, in accordance with Part 6. Rule 15.2 shall apply *mutatis mutandis*.
4. The panel shall as soon as practicable decide the application for review and make any necessary revised case management order.
5. A decision of the panel on an application for review is a procedural decision for the purposes of Rule 220.2.

### **Rule 334 – Case management powers**

Except where the Agreement, the Statute or these Rules of Procedure provide otherwise, the judge-rapporteur, the presiding judge or the panel may

- (a) extend or shorten the period for compliance with any rule, practice direction or order;
- (b) adjourn or bring forward the interim conference or the oral hearing;
- (c) communicate with the parties to instruct them about wishes or requirements of the Court;
- (d) direct a separate hearing of any issue;
- (e) decide the order in which issues are to be decided;
- (f) exclude an issue from consideration;
- (g) dismiss or decide on a claim after a decision on a preliminary issue makes a decision on further issues irrelevant to the outcome of the case.
- (h) dismiss a pleading summarily if it has no prospect of succeeding,
- (i) consolidate any matter or issue or order them to be heard together,
- (j) make any order pursuant to Rules 103 to 109.

### **Rule 335 – Varying or revoking orders**

A power of the Court to make a case management order includes a power to vary or revoke such order.

**Rule 336 – Exercise of managing powers**

The Court may exercise its case management powers on the application by a party or of its own motion, unless otherwise provided.

**Rule 337 – Orders of the Court's own motion**

Where the Court proposes to make an order of his own motion, it may do so but only after hearing the parties.

**Rule 340 – Connection — Joinder**

In the interests of the proper administration of justice, a presiding judge of the local or regional division where the cases are pending (after consultation with any other relevant presiding judge), the President of the Court of First Instance where the cases are in different divisions or the President of the Court of Appeal where the cases are pending may, at any time, after hearing the parties, order that two or more cases shall, on account of the connection between them, be joined. The cases may subsequently be disjoined.

## **CHAPTER 9 – RULES RELATING TO THE ORGANISATION OF THE COURT**

### **Rule 341 – Precedence**

1. With the exception of the President of the Court of Appeal and the President of the Court of First Instance, the judges shall rank in precedence according to their seniority in office.
2. Where there is equal seniority in office, precedence shall be determined by age.
3. Retiring judges who are reappointed shall retain their former precedence.
4. Unless otherwise agreed by the panel the most senior judge shall be the presiding judge.

### **Rule 342 – Dates, times and place of the sittings of the Court**

1. The duration of judicial vacations shall be fixed by the President of the Court of Appeal, on a proposal from the Presidium. The dates and times of the sittings of the Court shall be decided by the presiding judge of the local or regional division in question.
2. The Court may choose to hold one or more particular sittings in a place other than that in which it has its seat.

*Relation with draft Statute: Article 17*

### **Rule 343 – Order in which cases are to be dealt with**

1. The Court shall deal with the cases before it in the order in which they become ready for hearing.
2. The presiding judge of a local or regional division, the President of the Court of First Instance or the President of the Court of Appeal may
  - (a) direct that a particular case be given priority and that time limits provided for in these Rules be shortened;
  - (b) after hearing the parties, in particular with a view to facilitating an amicable settlement of the dispute, either on his own initiative or at the request of one of the parties, defer a case to be dealt with later.

*[CST RoP Article 47]*

### **Rule 344 – Deliberations**

1. The Court shall deliberate in closed session.
2. The presiding judge shall preside over the deliberations. Only those judges who were present at the oral hearing may take part in the deliberations on the decision.
3. The deliberation of the Court shall take place as soon as possible after the closure of the oral hearing.

### **Rule 345 – Composition of panels and assignment of cases**

1. The presiding judge of each local or regional division (being the judge in the division appointed by the Presidium as the presiding judge of the division) shall allocate the legally qualified judges assigned to his division to its panels for the duration of one year. He shall previously consult all judges of the division. The allocation shall be subject to the approval of the President of the Court of the First Instance.
2. The allocation shall be in conformity with Article 8 of the Agreement.
3. The cases pending in the division shall be assigned to the panels by the Registrar following a case-distribution-scheme established by the presiding judge of the division for the duration of one calendar year, preferably distributing the cases accordingly to the date of receipt of the cases at the division. Paragraph 1, sentences 2 and 3 shall apply *mutatis mutandis* to the establishment of the case-distribution-scheme.
4. Each panel may delegate to one or more judges of the panel
  - (a) the function of acting as a single judge or
  - (b) the function of acting for the panel in the procedures of Part 1 Chapter 4 (Procedure for the Determination of Damages and Compensation, including the procedure for the laying open of books) and Chapter 5 (Procedure for Cost Orders). These functions may be delegated to the judge-rapporteur who has prepared the case for the oral hearing.
5. The presiding judge of the division shall designate a judge assigned to his division as a standing judge for urgent cases. The assignment may be limited to certain periods of time.
6. If all parties agree to having the case heard by a single judge, the presiding judge of the panel to which the case is allocated shall assign the case to a legally qualified judge of the panel.
7. Paragraphs 1 to 6 shall apply *mutatis mutandis* to the central division. All references to the presiding judge of the division shall, regarding the central division, refer to the President of the Court of the First Instance.



8. Paragraphs 1 to 6 shall apply *mutatis mutandis* to the Court of Appeal. All references to the presiding judge of the division shall, regarding the Court of Appeal, refer to the President of the Court of Appeal.

*Relation with draft Statute: Article 19*

#### **Rule 346 – Settling difficulties arising as to the application of Article 5 of the Statute**

1. If a judge of the Court of the First Instance, during his term of office, does not respect the obligations arising from his office, pursuant to Article 7(1) and (2) of the Statute, the President of the Court of the First Instance, after hearing the judge, may formally in writing put the judge on notice of such failure. If the judge continues not to fully respect the obligations of his office, the President of the Court of First Instance shall ask the Presidium to decide on the consequences of such failure.

2. Paragraph 1 shall apply to a judge of the Court of Appeal. The President of the Court of Appeal shall perform the functions attributed in paragraph 1 to the President of the Court of First Instance.

3. If a judge of the Court, after having ceased to hold office, does not behave with integrity and discretion as regards the acceptance of appointments or benefits, the President of the Court of First Instance or the President of the Court of Appeal may ask the Presidium to decide on the consequences of such behaviour.

4. If a party objects to a judge taking part in proceedings pursuant to Article 5(4) of the Statute, the presiding judge of the local or regional division to which the judge is allocated or, if the case is pending before the central division, the President of the Court of the First Instance shall, after hearing the judge concerned, decide whether the objection is admissible having regard to Article 7(2) of the Statute.

5. If the objection is admissible, the presiding judge of the division or the President of the Court of First Instance, as the case may be, shall refer the case to the Presidium which shall hear the judge concerned and shall decide whether the objection shall stand or not.

6. Paragraphs 4 and 5 shall apply to a judge of the Court of Appeal. The President of the Court of Appeal shall perform the functions attributed in these Rules to the President of the Court of First Instance.

*Relation with draft Statute: Article 7*

## **CHAPTER 10 – DECISIONS AND ORDERS**

### **Rule 350 – Decisions**

1. Any decision shall contain
  - (a) the statement that it is a decision of the Court,
  - (b) the date of its delivery,
  - (c) the names of the presiding judge, the judge-rapporteur and other judges taking part in it,
  - (d) the names of the parties and of the parties' representatives,
  - (e) an indication of the claim, order or remedy sought by the parties,
  - (f) a summary of the facts,
  - (g) the grounds for the decision,
2. The order of the Court consequential upon the decision (other than costs) including any order giving immediate effect to an injunction, shall be appended to the decision. The Order shall comply with Rule 351.
3. Any dissenting opinion shall be attached to the Court's decision.
4. The decision of the Court of First Instance shall contain a summary of the requests and facts submitted by the parties and a statement of the facts and arguments on which the Court bases its decision.
5. Decisions shall be recorded in the register.

*Relation with draft Statute: Article 35(4)*

### **Rule 351 – Orders**

1. Every order shall contain
  - (a) the statement that it is an order of the judge-rapporteur, of the presiding judge, of a President of the Court or of the Court,
  - (b) the date of its adoption,
  - (c) the names of any judge taking part in its adoption,
  - (d) the names of the parties and of the parties' representatives,
  - (e) the operative part of the order.
2. Where, in accordance with these Rules, an order must be reasoned, it shall in addition contain:
  - (a) a statement of the forms of order sought by the parties,
  - (b) a summary of the facts,
  - (c) the grounds for the order.

### **Rule 352 – Binding effect subject to security**

Decisions and orders may be subjected to the rendering of a security by a party (or parties) to the other party (or parties) for legal costs and other expenses and compensation for any damage incurred or likely to be incurred by the other party (or parties) if the decisions and orders are subsequently revoked.

### **Rule 353 – Rectification of decisions**

The Court may, by way of order, of its own motion or on application by a party made within one month of service of the decision to be rectified, after hearing the parties, rectify clerical mistakes, errors in calculation and obvious slips in the decision.

### **Rule 354 – Enforcement**

1. Subject to Rule 118.9 and Rule 352 decisions and orders of the Court shall be directly enforceable from their date of delivery in each Contracting Member State in accordance with the enforcement procedures and conditions governed by the law of the particular Contracting Member State where enforcement takes place.
2. Decisions and orders of the Court shall be enforced in those non-Contracting Member States which are Member States of Regulation (EU) No 1215/2012 or the Lugano Convention in accordance with the provisions of the said Regulation or Convention as the case may be.
3. Decisions and orders of the Court shall be enforced in States which are not Contracting Member States or member states of the Regulation or Convention referred to in paragraph 2 in accordance with the law of that state.
4. Where an enforceable decision or order of the Court is subsequently varied or revoked the Court may order the party which has enforced such decision or order, upon the request of the party against whom the decision or order has been enforced, to provide appropriate compensation for any injury caused by the enforcement. Rule 125ff shall apply *mutatis mutandis*.
5. The Court's orders may provide for periodic penalty payments payable to the Court in the event that a party fails to comply with the terms of the order or an earlier order. The value of such payments shall be set by the Court having regard to the importance of the order in question.

## **CHAPTER 11 – DECISION BY DEFAULT**

### **Rule 355 – Decision by default (Court of First Instance)**

1. If a party fails to take a step within the time limit set according to these Rules or by the Court, the Court of First Instance may give decision by default.
2. A decision by default shall be enforceable. The Court may, however,
  - (a) grant a stay of enforcement until it has given its decision on any Application under Rule 356, or
  - (b) make enforcement subject to the provision of security; this security shall be released if no Application is made or if the Application fails.

### **Rule 356 – Application to set aside a decision by default**

1. A party against whom a decision by default has been given may lodge an Application to set aside that decision within one month of service of the decision.
2. The \*Application to set aside a decision by default shall comply with the requirements of Rule 24 or Rule 29 as the case may be together with the party's explanation for the default. In addition, it shall mention the date and number of the decision by default. The party shall pay a fee for the Application to set aside the decision by default [EUR\*\*\*].
3. If the provisions of Rule 356.2 are met the Application shall be allowed and a note of allowance shall be included in any publication of the decision by default.

*Relation with draft Statute: Article 37*

### **Rule 357 – Decision by default (Court of Appeal)**

1. Rules 355 and 356 shall apply *mutatis mutandis* where a respondent on whom a Statement of appeal and a Statement of the grounds of appeal have been duly served fails to lodge a Statement of response or where a party fails to file a Reply to a Statement of Cross-Appeal or translations ordered by the judge-rapporteur.
2. If the respondent fails to lodge a Statement of response and fails to lodge an Application to set aside pursuant to Rule 356 the Court of Appeal shall consider the merits of the appeal and if the appeal is well-founded it shall give a reasoned decision.
3. For the avoidance of doubt the provisions of Rules 355 and 356 shall not apply where a party fails to comply with the time limits set in Rule 224.1.

## **CHAPTER 12 – ACTIONS BOUND TO FAIL OR MANIFESTLY INADMISSIBLE**

### **Rule 360 – No need to adjudicate**

If the Court finds that an action has become devoid of purpose and that there is no longer any need to adjudicate on it, it may at any time, of its own motion, after giving the parties an opportunity to be heard, dispose of the action by way of order.

### **Rule 361 – Action manifestly bound to fail**

Where it is clear that the Court has no jurisdiction to take cognisance of an action or of certain of the claims therein or where the action or defence is, in whole or in part, manifestly inadmissible or manifestly lacking any foundation in law, the Court may, after giving the parties an opportunity to be heard give a decision by way of order.

### **Rule 362 – Orders dismissing manifestly inadmissible claims**

1. Orders under Rules 360 and 361 shall be taken by the panel upon the recommendation of the judge-rapporteur.
2. Where the decision is taken by the Court of First Instance pursuant to Rules 360 and 361 it is a final decision within the meaning of Rule 220.1(a).

### **Rule 363 – Absolute bar to proceeding with an action**

The Court may at any time, of its own motion, after giving the parties an opportunity to be heard, decide that there exists an absolute bar to proceeding with an action, for example because of the application of the principle of *res judicata*. The Court shall give its decision by way of a reasoned judgement. Rule 362.2 shall apply *mutatis mutandis*.

## **CHAPTER 13 – SETTLEMENT**

### **Rule 365 – Confirmation by the Court of a settlement**

1. Where the parties have concluded their case by way of settlement, they shall inform the judge-rapporteur. The Court shall confirm the settlement by decision of the Court [Rule 11.2].
2. At the request of the parties the Court may order that details of the settlement are confidential. The decision may be enforced as a final decision of the Court.
3. The case shall be removed from the register.
4. The presiding judge shall give a decision as to costs in accordance with the terms of the settlement or, failing that, at his discretion.

*Relation with draft Agreement: Article 79*

## **PART 6 – FEES AND LEGAL AID**

### **COURT FEES**

#### **Rule 370 – Court fees**

1. Court fees provided for in these Rules of Procedure shall be paid to the Court. They shall be levied in accordance with the provisions contained in this Part.

2. The court fees to be paid to the Court shall be as follows:

(a) Fixed fees, in [EUR\*\*]

##### **Court of First Instance**

Fee for infringement action:

Fee for counterclaim for revocation:

Fee for revocation action:

Fee for counterclaim for infringement:

Fee for declaration of non-infringement:

Fee for action against a decision of the European Patent Office:

Fee for application to review a case management order:

Fee for application to preserve evidence:

Fee for application for provisional measures:

Fee for application to determine damages:

Fee for application to determine compensation pursuant to Rule 125:

Fee for application of re-establishment of rights:

Fee for application to prolong the period for a protective letter to be kept on the register:

Fee for application to set aside decision by default:

##### **Court of Appeal**

Fee for appeal against final decision:

Fee for appeal against interlocutory order:

Fee for lodging a protective letter:

Fee for rehearing:

(b) Value-based fees in [EUR\*\*\*]

Value in dispute in EUR

Fees



### **Rule 371 – Time periods for paying court fees**

1. The fixed fees [(Rules 15.1, 26, 47, 53, 68, 132, 192.5, 206.4, 207.3, 228)] shall be paid at the time of lodging the relevant pleading. The payment shall be made to one of the bank accounts indicated by the Court and it shall indicate the paying party or its representative together with the number of the patent (or patents) involved.
2. Proof of payment shall be provided together with the relevant pleading.
3. In cases of urgency, where a payment in advance is not possible, the representative of the party in question shall pay the fixed fee within the period set by the Court.
4. The value-based fee shall be paid within 10 working days of service of the order determining the value of the dispute in accordance with the Rules 22, 31, 57, 58, 69, 104(i) and 133.
5. Where an Application for legal aid has been lodged in accordance with Rule 377, the rules on the obligation to pay the fixed fees under Rule 371.1 shall not apply.

*Relation with draft Agreement: Article 70*

### **Rule 372 – Reimbursement of court fees**

*[To be developed]*

## **LEGAL AID**

### **Rule 375 – Aim and scope**

1. In order to ensure effective access to justice, the Court may grant legal aid to a party who is a natural person (the applicant).
2. Legal aid may be granted in respect of any proceedings before the Court.

### **Rule 376 – Costs eligible for legal aid**

1. Subject to Article 71(3) of the Agreement, legal aid may cover, in whole or in part, the following costs:

- (a) court fees;
- (b) costs of legal assistance and representation regarding
  - (i) pre-litigation advice with a view to reaching a settlement prior to commencing legal proceedings;
  - (ii) commencing and maintaining proceedings before the Court,
  - (iii) all costs relating to proceedings including the application for legal aid.
- (c) other necessary costs related to the proceedings to be borne by a party, including costs of witnesses, experts, interpreters and translators and necessary travel, accommodation and subsistence costs of the applicant and his representative.

2. Subject to Article 71(3) of the Agreement, legal aid may also cover the costs awarded to the successful party, in the event that the applicant loses the case.

### **Rule 377 – Conditions for granting legal aid**

1. Any natural person shall be entitled to legal aid where:

- (a) due to his or her economic situation, he or she is wholly or partly unable to meet the costs referred to in Rule 376; and
- (b) the case in respect of which the application for legal aid is made has a reasonable prospect of success.

2. The Administrative Committee shall define thresholds above which legal aid applicants are deemed wholly or partly able to bear the costs of proceedings set out in Rule 376. These thresholds may not prevent applicants whose economic situation is above the thresholds from being granted legal aid if they prove that they are in fact unable to pay the costs of the proceedings referred to in Rule 376 as a result of the high level of the cost of living in the Contracting Member State of domicile or habitual residence.

3. When deciding on the grant of legal aid the Court shall, without prejudice to paragraph 1(a), consider the importance of the case to the applicant but may also take into account the nature of the case when the application concerns a claim arising directly out of the applicant's trade or self-employed profession.

### **Rule 378 - Application for legal aid**

1. An application for legal aid may be lodged before or after proceedings have been started before the Court.

2. The \*Application for legal aid shall contain in a language of a Contracting Member State:

- (a) the name of the applicant;
- (b) postal and electronic addresses for service on the applicant and the names of the persons authorised to accept service;
- (c) the name of the other party as well as postal and electronic addresses for service on the other party where available and the names of the persons authorised to accept service, if known;
- (d) the case number of the action in respect of which the application is made or, where the application is lodged before the action has been brought, a brief description of the action;
- (e) an indication of the value of the case and the costs to be covered by legal aid;
- (f) where legal aid is requested for costs of legal assistance and representation, the name of the proposed representative;
- (g) an indication of the applicant's financial resources, such as income, assets and capital, and of the applicant's family situation including an assessment of the resources of persons who are financially dependent on the applicant;
- (h) where appropriate, a reasoned request for suspension of a time limit which would otherwise need to be observed until the date of notification of the order deciding on legal aid.

3. The application for legal aid must be supported by:

- (a) evidence of the applicant's need for assistance, such as certificates attesting his income, assets and capital and family situation; and
- (b) where the application is lodged before the action has been brought, an indication of the evidence in support of the case.

4. In the event of an appeal, a new application shall be lodged.

5. Rule 8 shall not apply.

### **Rule 379 - Examination and decision**

1. The Registry shall examine the formal admissibility of the application for legal aid.
2. If the requirements referred to in Rule 378 have not been met, the applicant shall, as soon as practicable, be invited to correct the deficiencies within 14 days.
3. If the requirements referred to in Rule 378 have been met, the decision on such application shall be taken, by way of order, by the judge-rapporteur or, where the application is lodged before the action has been brought, by the standing judge.
4. Before making a decision on an application for legal aid, the Court shall invite the other party to submit written observations unless it is already apparent from the information submitted that the conditions referred to in Rule 377 are not met.
5. An order refusing legal aid shall state the reasons on which it is based.
6. An order granting legal aid may provide for:
  - (a) an exemption, wholly or partly, from Court fees;
  - (b) an interim amount to be paid to enable the applicant and/or the representative of the applicant to meet any request of the judge-rapporteur or single judge prior to making a final order
  - (c) an amount to be paid to the representative of the applicant or a limit which the representative's disbursements and fees may not exceed;
  - (d) a contribution to be made by the applicant to the costs referred to in Rule 376.1(c).
7. Where the legal aid covers, in whole or in part, the costs of legal assistance and representation the order granting legal aid shall designate the representative of the applicant
8. On a request by the designated representative, the Court may order that an amount shall be paid by way of advance
9. Where requested by the applicant in accordance with Rule 378.2(g), the Court shall decide on the suspension of any time limit.

### **Rule 380 - Withdrawal of legal aid**

1. If the economic situation of the applicant which has led to the grant of legal aid according to Rule 377.1(a) alters during the proceedings, the Court may at any time, of his own motion or on a reasoned request of the other party, withdraw wholly or partly legal aid but only after having heard the applicant.
2. An order withdrawing legal aid shall state the reasons on which it is based.

### **Rule 381 – Appeal**

An order wholly or partly refusing or withdrawing legal aid may be appealed to the Court of Appeal if the Court of First Instance grants leave to appeal – [or, leave is refused, with the leave of the Court of Appeal] [Rule 221]. If such leave is granted the Court may grant legal aid for the conduct of the appeal.

### **Rule 382 – Recovery**

1. Where the Court has ordered another party to pay the costs of the applicant for legal aid, that other party shall be required to refund to the Court any sums advanced by way of legal aid. In the event of a shortfall between the costs so ordered and the sums advanced by way of legal aid the applicant may be required to meet such shortfall from any damages or compensation awarded by the Court or from any sum received by way of settlement.
2. In the event of withdrawal of legal aid under Rule 380, the applicant may be required to refund to the Court any sums advanced by way of legal aid.

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