

**EXPLANATORY MEMORANDUM**  
**ON THE DRAFT PROPOSAL FOR RULES ON THE EUROPEAN PATENT LITIGATION**  
**CERTIFICATE AND OTHER APPROPRIATE QUALIFICATIONS**

According to Article 48(2) of the Agreement on a Unified Patent Court (UPC Agreement), European Patent Attorneys<sup>1</sup> (EPAs) who are entitled to act as a professional representative before the European Patent Office (EPO) pursuant to Article 134 of the European Patent Convention (EPC) may represent parties before the Unified Patent Court (UPC), provided they have appropriate qualifications such as a European Patent Litigation Certificate (EPLC). The wording of this article suggests that EPAs can prove having appropriate qualifications by different means, the EPLC being one of them.

Article 48(3) of the UPC Agreement states that the Administrative Committee shall establish the requirements for such qualifications. Therefore, a draft decision determining the rules on the EPLC and other appropriate qualifications (Draft EPLC decision) must be prepared, in order to be formally adopted by the Administrative Committee after the entry into force of the UPC Agreement.

This decision shall establish the rules for the grant of the EPLC and the rules governing the other appropriate qualifications EPAs can alternatively have in order to be entitled to represent parties before the UPC.

**I. Rules on the EPLC**

The rules on the EPLC must ensure the good quality of professional representation before the UPC, be as simple as possible and avoid unnecessary costs for the UPC, before and after entry into force of the UPC Agreement. Based on those considerations, the Draft EPLC decision proposes a decentralized system, in which the UPC accredits courses leading to the EPLC (Course), delivered by universities or other non-profit educational bodies of higher or professional education.

The Draft EPLC decision also involves the Training Centre for judges (Article 19 UPC Agreement) located in Budapest (Rule 10). Even if its main function is to coordinate the training of judges and candidate judges, it is legitimate for the Training Centre to organize a Course for EPAs as well, offering an equivalent alternative to the educational bodies with

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<sup>1</sup> Words importing the masculine gender shall include the feminine and vice versa.

accredited Courses, provided that the Course of the Training Centre is neutral for the budget of the Training Centre and therefore the UPC and financed by the contributions of EPAs (compare Article 38 of the UPC Agreement, which provides that only the training framework for judges shall be financed by the budget of the UPC). The Course of the Training Centre shall comply with all the requirements laid down in the Draft EPLC decision, with the exception of the accreditation requirement. This Course being under the direct control of the UPC, preliminary screening through the accreditation procedure is unnecessary. Besides organising its own training, the Training Centre may establish infrastructural co-operation with the educational bodies providing accredited Courses so that these provide the Course at an alternative location (Budapest), optionally in another language (e.g. English), thus offering an additional possibility for those EPAs to whom the alternative location is closer or for whom the alternative language is preferable. Moreover, the Training Centre may also serve as a facilitating hub for the e-learning options offered by the educational bodies providing accredited Courses.

Part I of the Draft EPLC decision deals with the details of the Course, such as content, duration, examination, course languages and e-learning facilities. It also deals with the educational bodies offering courses leading to the EPLC, as well as the accreditation procedure.

Rule 2 of the Draft EPLC decision stipulates that the EPLC may be issued by universities or other non-profit educational bodies of higher or professional education (e.g. the Academy of European Law – ERA) established in a Member State of the European Union, as well as by the Training Centre, after successful completion of the Course. The proposal opens up the range of institutions whose courses may be accredited. However, due to the public law nature of granting EPLCs and in order to ensure a satisfactory and harmonized quality level, the institution may not be a commercial provider of courses and conferences but must be at the academic level of a university.

Rule 3 deals with the content of the Course. The Course is designed for EPAs whose skills in patent law have already been tested by the European Qualifying Examination. Therefore, the aim of the proposal is to find the right balance between a basic knowledge of law (subparagraphs (a) to (d)) – covering European Union law, private law with a focus on contract law, company law and tort law, as well as private international law (incl. Brussels I, Rome I and Rome II Regulations and relevant case law of the Court of Justice of the European Union) – and advanced knowledge of the aspects of law and litigation that shall be part of the daily business of a litigator before the UPC (subparagraphs (e) to (h)). This

includes in particular specific knowledge of the Regulations on unitary patent protection, the UPC Agreement, the Statute of the UPC, the Rules of Procedure of the UPC, as well as litigation and advocacy skills and practical guidance on case management before the UPC. Subparagraph (f) also includes procedural aspects in relation to infringement proceedings and revocation of patents in Contracting Member States.

Rule 4 states that the Course includes a minimum of 120 hours of lectures and practical training, i.e. hours of self-study are not included. This shall ensure that EPAs representing parties before the UPC have sufficient knowledge of civil litigation and infringement proceedings to deal efficiently with proceedings before the UPC while not making the threshold for the EPLC too high and thus inadequate. In order to successfully complete the Course, the candidate must pass a written and oral examination, which is not part of the 120 course hours.

The universal wording of Rules 3 and 4 does not preclude further references to European educational standards (ECTS credit system, European qualification framework) at a later stage.

Rule 5 provides that the Course, including the examination, may be conducted in any language of a Member State of the European Union, which corresponds with Rule 2. It also makes clear that e-learning facilities are encouraged as part of the program of the Course, in order to ensure sufficient accessibility in every Member State, as long as practical training requires personal presence and participation.

Rule 6 provides that courses delivered by Universities or other non-profit educational bodies of higher or professional education shall need to be accredited in order to result in the issuance of an EPLC (the Training Centre is not mentioned in this Rule as it shall not need accreditation to provide the Course).

Rules 7 and 8 deal with the formalities involved in requesting accreditation and with the accreditation procedure. The request must be filed with the UPC in one of the official languages of the EPO, i.e. English, French or German. This is consistent with the fact that the use of the established EPC language regime is an integral part of EPAs' skills. This will also facilitate the processing of the request. The request must include a detailed curriculum for the proposed Course, including information on the total duration and on the number of hours for each topic, as well as detailed information about the examination, the teachers, the

course language and the e-learning facilities envisaged. The request must also include sufficient information about the status of the requestor.

The Draft EPLC decision proposes an accreditation procedure where the Administrative Committee decides on the request for accreditation, on the basis of an opinion of the Advisory Committee (see Article 14(1)(c) UPC Agreement). The Advisory Committee will give a positive opinion if the request fulfils the substantive requirements set out in Rules 3 to 6 and the formal requirements set out in Rule 7. If the requirements are not met, the Advisory Committee will give a negative opinion on the request. In such a case, the Administrative Committee will communicate the opinion to the requestor and invite him to correct the deficiencies or submit comments within a non-extendable period of two months. If the deficiencies are not corrected in due time, the Administrative Committee will reject the request. If the requestor corrects the deficiencies or submits comments, the Administrative Committee will consult the Advisory Committee once again before deciding on the request. The decision of the Administrative Committee is final, as there is no legal basis for an appeal against its decisions in the UPC Agreement or in the Statute of the UPC. Nothing precludes, however, that the rejected educational body files another request for accreditation with an amended content.

An alternative option would be to entrust the Registrar with decisions on accreditation. The Registrar is responsible for keeping and administering the list of entitled representatives [see Article 48(3) UPC Agreement and Article 23(2)(b) Statute of the UPC] and will therefore have to examine and decide on the requests for entry on that list. Similarly, the Registrar could examine the requests for accreditation and verify if the requirements for accreditation set out in the EPLC decision are fulfilled. As the Registrar works under the authority of the President of the Court of Appeal (see Article 23(1) Statute of the UPC), the Registrar's decisions to refuse accreditation could then be challenged before the President of the Court of Appeal.

However, regarding to their strategic nature, decisions on accreditation may not be an appropriate task for the Registrar. Therefore, the Draft EPLC decision suggests they are taken directly by the Administrative Committee itself.

An accreditation is granted for five years and is not automatically renewed. Therefore, an educational body interested in continuing to offer the Course after the accreditation's expiry must file a request for the prolongation of the accreditation for another five year period. Such requests may be filed, at the earliest, one year before the expiry of the accreditation and shall follow the same procedure as described above for the initial accreditation.

Rule 9 provides that educational bodies delivering a Course are required to provide the UPC with a report on the program (curriculum) conducted, examination results and statistics on the Course, in particular the number and nationality of students, the number of issued certificates, etc. The Administrative Committee takes note of the report.

Rule 10 deals with the involvement of the Training Centre. Paragraph 1 makes clear that the Training Centre shall assist the educational bodies that wish to provide the Course in Budapest as well. The Training Centre may also facilitate their e-learning options. Paragraph 2 provides that the Training Centre may offer the Course as well, if it wishes to do so (concerning financial matters see p. 2 above). The basis for this additional task may be derived from Article 11(4)(b) of the Statute of the UPC. In this case, the Training Centre's Course must comply with the requirements laid down in Rules 3 to 5. Rule 9 applies to the Training Centre as well. The Training Centre's Courses do not need to be accredited.

## **II. Other appropriate qualifications**

According to Article 48(2) of the UPC Agreement, EPAs may prove their qualifications to represent parties before the UPC by other means than the EPLC. This is particularly important, as the EPLC won't be available before the entry into force of the UPC Agreement. Therefore, the recognition of other appropriate qualifications is necessary in order to allow the UPC to start with a sufficient number of qualified EPA representatives. Also, certain robust legal qualifications render acquisition of the EPLC unnecessary.

Part II deals with the details of the required qualifications.

According to Article 48(2) of the UPC Agreement, EPAs entitled to represent parties before the UPC are not required to be authorised to practice before a Court of a Contracting Member State. This corresponds with Article 48(1), which shows that rights to conduct litigation are relevant for lawyers. Additionally, Article 48(4) rules the rights of national patent attorneys, giving them the right to speak at hearings.

Therefore, the Rules based on Article 48(2) of the UPC Agreement can neither require that EPAs have the same qualification as lawyers to conduct litigation before the national courts, nor consider the qualification as a national patent attorney as sufficient per se in order to represent parties before the UPC.

Consequently, Rule 11 provides that EPAs who have a bachelor or master's degree in law according to the relevant educational standards of a Member state of the European Union or who have passed an equivalent state exam in law in an EU Member state will qualify to apply for registration on the list of entitled representatives. Such diplomas generally don't give a right to act as an advocate before the national courts, but they provide EPAs with the necessary knowledge of private and procedural law, required to conduct patent litigation. The wording "equivalent state exam in law" refers to exams which are at least comparable to bachelor or master's degrees in law.

Rule 12 introduces a transitional measure which takes into account that specific courses are already available to prepare EPAs to patent litigation and that in some Member States patent attorneys are already authorized to represent parties before the national court of a Contracting Member State in patent infringement cases. Point (a) includes a list of courses and certificates the successful completion or grant of which is recognised as appropriate qualification under the grandfather clause. Where appropriate, other courses preparing EPAs to patent litigation in a satisfactory way may be added to this list by the Administrative Committee in its decision. The list has been established taking account of the information provided by the stakeholders and the comments received from the Contracting Member States. In the light of the Course's requirements, this list takes several criteria into consideration: the nature and location of the educational body delivering the courses, the duration of education, the curriculum, the teaching staff and the examination procedure. The enumeration of certificates ensures that national characteristics are duly taken into account, i.e. those in the United Kingdom.

Alternatively, point (b) states that practical experience acquired by having represented a party or having acted as a judge in at least three patent infringement actions initiated before a national court of a Contracting Member State within the five preceding years is also recognised as appropriate qualification. This sub-paragraph focuses on recent experience acquired as a representative or judge in patent infringement actions, in order to ensure that EPAs qualifying under this rule have acquired a personal and up-to-date practice in areas such as orders to produce or preserve evidence, provisional and protective measures, injunctions, counterclaims for revocation or evaluation of damages. In this respect, experience acquired in assisting a representative or in other actions such as revocation of patents or appeals against decisions of patent offices is not sufficient to ensure that an EPA has developed a personal and adequate knowledge of case management in all areas of competence of the UPC. The number of three patent infringement actions within five years takes into account that the amount of patent litigation varies among the UPC Member States.

EPAs fulfilling one of the alternative requirements laid down in Rule 12 will be entered on the list of entitled representatives, provided they file a request for recognition of other appropriate qualifications within one year of the entry into force of the UPC Agreement. The duration of this transitional period corresponds with Article 134(3) EPC and gives EPAs sufficient time to file a request for recognition of their qualifications.

### **III. Registration**

Part III of the Draft EPLC decision deals with procedures for addition to and deletion from the list of entitled representatives according to Article 48(3) of the UPC Agreement.

Rule 13 provides that EPAs wishing to represent parties before the UPC have to lodge the EPLC with the Registrar, who will add him to the list of entitled representatives.

Rule 14 and 15 deal with the procedure for recognition of other appropriate qualifications. The request has to be filed in one of the official languages of the EPO. If the request is based on a law degree referred to in Rule 11 or on one of the courses or certificates listed under Rule 12(a), the request must include a copy of the relevant diploma, certificate or other respective proof. If the request is based on a sufficient number of patent infringement cases as provided under Rule 12(b), the request must include all details necessary to identify the infringement actions the requestor intends to rely on.

The Registrar being responsible for keeping and administering the list of entitled representatives (see Article 48(3) UPC Agreement and Article 23(2)(b) Statute of the UPC), the Draft EPLC decision proposes to entrust him with the examination of and the decision on the request for recognition of other appropriate qualifications. The Registrar may consult the Advisory Committee for a non-binding opinion. If the request fulfils the substantive requirements set out in Rules 11 or 12 and the formal requirements set out in Rule 14, the Registrar will enter the requestor on the list of entitled representatives. If the substantive requirements are not met, the Registrar will reject the request. If the substantive requirements are met but the request fails to comply with the formal requirements, the Registrar will invite the requestor to correct the deficiencies noted within a non-extendable period of two months. If the deficiencies are not corrected in due time, the Registrar will reject the request.

Rule 16 deals with the duration of registrations on the list of entitled representatives. Paragraph 1 provides that in principal the registration of an EPA on the list is permanent. It

makes no reference to continuous training. However, this does not preclude the introduction of such obligations at a later stage. Rule 16 foresees three cases in which registration shall cease to have effect. Paragraph 2 provides that the registration will cease to have effect if the EPA ceases to be registered on the list of professional representatives maintained by the EPO (Article 134(1) EPC). In such a case, the Registrar will delete the patent attorney from the list of entitled representatives on request or *ex officio*. EPAs may then be re-entered on the list of entitled representatives if they are re-entered on the list of professional representatives maintained by the EPO. Paragraph 3 provides that the Registrar will delete the EPA from the list, if it has been established by a final decision of a competent court or authority that his registration on the list has been obtained by fraud; a conviction is not necessary (compare Article 112a(2)(e) EPC and Rule 105 EPC). Paragraph 4 provides for a removal upon request of the EPA.

The list of entitled representatives should be published, as well as the list of accredited educational bodies, but data protection issues must also be taken into consideration when determining the details of such a publication.

#### **IV. Review**

Part IV of the Draft EPLC decision deals with the review of the Registrar's decisions with regard to a request for recognition of other appropriate qualifications under Rule 15 or a deletion from the list of entitled representatives under Rule 16.

Rule 18 provides that the petition for review must be filed in writing with the Registrar in one of the official languages of the EPO within one month of the notification of the challenged decision. It must indicate the reasons on which it is based. A petition for review may not be filed by third parties, because they have no direct and personal interest in challenging the Registrar's decisions. But third parties are free to submit any relevant information, e.g. concerning fraud, to the Registrar.

Rule 19 foresees a revision by the Registrar, who may rectify the decision within one month of receipt of the petition for review if he considers it to be admissible and well-founded. If the Registrar does not rectify the decision within due time, he will forward it to the President of the Court of Appeal.

Rule 20 provides that, if the petition for review is admissible under Rules 17 and 18, the President of the Court of Appeal will examine it and, if it is allowable, will alter the decision of

the Registrar. If the petition for review is not allowable, the President of the Court of Appeal will reject it.

#### **V. Notification and Entry into force**

Part V deals with general and final provisions. Rule 21 states that the decisions of the Administrative Committee, the Registrar and the President of the Court of Appeal are notified. Rule 22 relates to the entry into force of the EPLC decision.