



The role of IP Attorneys before the European Patent Court - Advocates or Assistants?

FICPI Forum
Firenze
10 October 2008

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topics

- What is the current role of IP attorneys before national courts in Europe ?
- What is the the role of IP attorneys according to the draft for a European Patent Jurisdiction ?
- What should be the role of IP attorneys before a future European Patent Court ?





current role

current role

- at national level widely diversified
- four groups can be summarized:
 - 1. Full right** of representation (conduct, plead) in **all kind** of proceedings (HU, PL, CZ, UK...)
 - 2. Full right** of representation (conduct, plead) before **specialized courts** (invalidation, ownership, etc.) & right of audience in all other kind of proceedings (DE, AT,...)
 - 3. Right of audience** in all kind of proceedings (NL, BE,..)
 - 4. No right** of representation (FR, ES, PT,...)



current role

- usual:
 - double qualification: national IP attorney & European Patent Attorney
- full harmonization:
 - full right of representation before the BoA and EnlBoA
 - BoA „are a court“ „deciding a piece of litigation“ (Lord Justice Jacob)





the draft

the draft

- 1st draft, 4.2.08
- Representation

*The parties should be represented by **lawyers** authorized to practice before a court of a Member State. In patent litigation, questions of technology play an important part in order to reach a legally sound decision. Technical expertise is required not only on the side of the Court but also on the side of the parties. The lawyers should therefore have the possibility to involve and to act together with a European Patent Attorney who is a national of a Member State and entered on the list maintained by the EPO. Any European Patent Attorney should be allowed to speak at hearings. **It should be explored to what extent, and under which circumstances, European Patent Attorneys with proven legal knowledge and experience could solely represent a party.***

- national IP attorneys did not exist!



the draft



Legal Services Act 2007

Other lawyers

- 181 Unqualified person not to pretend to be a barrister
- 182 Licensed conveyancers
- 183 Commissioners for oaths
- 184 Trade mark attorneys
- 185 Patent attorneys
- 186 Immigration advisers and immigration service providers
- 187 Claims management services



the draft

- who is a lawyer?
 - historical interpretation:
 - Court of Justice for the European Coal and Steel Community ECSC
 - Draft, 18.4.1951: „...parties must be represented by an advocate admitted to the bar of one of the member States“
 - final Statutes - Art 19: „Only a lawyer authorised to practise before a court of a Member State or of another State which is a party to the Agreement on the European Economic Area may represent or assist a party before the Court.“
 - opening to different groups of lawyers
 - e.g. a solicitor is allowed to plead before the ECJ, although he is not allowed to do so before higher courts in England



the draft

- who is a lawyer?
 - functional interpretation:
 - CFI T-14/04, T-445/04
 - lawyer:
 - a **collaborator in the administration of justice**, required to provide, in full **independence**, and in the **overriding interests** of that cause, such legal assistance as the **client** requires;
 - subject to **professional discipline** laid down and enforced in the general interest by the institutions endowed with the requisite powers for that purpose
 - is authorised to **practise** before a **court** of a Member State or another State which is a party to the EEA
 - satisfied by German and Austrian Patentanwälte („Anwälte“), Hungarian, Polish, Czech, ... IP attorneys



the draft

- who is a lawyer?
 - **incorrect** interpretation:
 - those professions being mentioned in the Directive 98/5/EC to facilitate practice of the profession of lawyer on a permanent basis in a Member State other than that in which the qualification was obtained
 - Article 1, 2. **For the purposes of this Directive:**
 - (a) ‚*lawyer*‘ means any person who is a national of a Member State and who is authorised to pursue his professional activities under one of the following professional titles:
 - Belgium Avocat/Adcovaat/Rechtsanwalt
 - ...



the draft

- current draft, 30.6.08
- Article 28 – Representation
 - (1) The parties shall be represented by lawyers authorized to practise before a court of a Contracting Party. These representatives may be **assisted** by a **European Patent Attorney**, who is a national of a Contracting Party entitled to act as professional representative before the European Patent Office (hereafter: European Patent Attorney), **and/or by patent attorneys with proven patent litigation experience in accordance with the Rules of Procedure.**
 - (2) Notwithstanding paragraph 1, European Patent Attorneys and patent attorneys who either have proven patent litigation experience or who are in possession of a **European Union Patent Litigation Certificate** may represent the parties in actions for **revocation or declarations of non-infringement** of a patent before the central division.



the draft

- unjustified abasement of the majority of IP attorneys who have far reaching litigation rights under their national law (HU, PL, CZ, DE, AT, LV, LT,.....)
 - under national law advocates
 - according to the draft assistants (but only if experienced!?)
- needs amendment
- subsidiarity:
 - same must apply as for attorneys-at-law
 - admission before national court must lead to admission before European court



the draft

- 1. group: full right of representation
- 2. group: only invalidation & declaratory action? – what about ownership, prior user rights,...
- 3. group: right of audience
- 4. group: no rights
- European Patent Attorneys: ?





future role

future role

- patent proceedings are driven by the interconnection of legal and technical questions
- one of the reasons of the development of the whole profession is that:
 - validity
 - infringementare factual driven questions of law, i.e. *quaestio mixta*
- without a thorough understanding of the facts (=complex technical issues) no sound legal answer can be given
- specialized court needed
- specialized attorneys (=IP attorneys) should/must be admitted



future role

- for the benefit of the system & the stakeholders:
 - representatives must be legally and technically trained
 - all IP attorneys are legally and technically trained
 - technical training, usually at university – qualification not questioned
 - legal training, diverse (traineeship 2-5 years, university) – qualification questioned
 - e.g. „Proceedings before the court are legal proceedings which besides a good knowledge of patent law require not only knowledge of procedural law but also of various fields of law such as the law of contract, EU law, international private law etc.“ (EPLAW)
 - e.g. Austrian qualifying exam: civil law, procedural law, commercial law, administrative law, etc.; Germany: law studies at university
 - attorneys-at-law are generally not at all trained in patent law!



future role

- **full right** of representation, if allowed to represent before a national court
- should be clarified in the draft
- European Patent Attorneys:
 - right of audience: minimum
 - Litigation Certificate: must lead to full litigation rights, otherwise it would only be a „nullity certificate“. It would be bizarre to ask **the** European profession who litigates more than 90% of all invalidity actions (=oppositions) to get another qualification for their very own expertise
- qualification standards of attorneys-at-law: the vast majority is not trained/examined in patent law at all
- How to safeguard knowledge of patent law by attorneys-at-law:
 - Litigation Certificate?
 - proven experience?
- How to safeguard technical understanding by the representatives?
 - mandatory (co)representation by (European) patent attorney?



future role

- for the benefit of the system:
 - legally and technically trained representatives
 - if doubts with respect to legal qualification:
 - litigation certificate:
 - contents?
 - university degree in law:
 - contents?
 - harmonization of legal training of IP attorneys in Europe
 - litigation certificate may define legal areas
 - if specific legal areas are already covered by a national qualifying exam
 - ➡ exemption from the certificate
 - if the national qualifying exam includes all legal areas of the litigation certificate, litigation certificate is awarded in case of national qualification



future role

- PROS:
 - quality of submissions
 - understanding bench/party
 - efficiency of the system
 - costs

 - subsidiarity (Art 19 StCt)
 - equity (Art 104(2) PrCt), e.g. C-246/05, C-495/07, C-182/01, C-305/00
 - competition (Art3(1)g ECT)
 - right of practicing one's profession
- CONS:
 - ?



summary

- What is the current role of IP attorneys before national courts in Europe?
 - diverse, depending on national law; numerous IP attorneys qualify as lawyers in view of the jurisprudence of the CFI
- What is the the role of IP attorneys according to the draft for a European Patent Jurisdiction ?
 - numerous national IP attorneys are unjustifiedly abased to assitants; according to the principle of subsidiarity, in order not to violate professional rights of IP attorneys and not to distort competition in the internal market the draft must be amended
- What should be the role IP attorneys before a future European Patent Court ?
 - for encreasing the quality of the specialized court system and decreasing costs specialized (=IP) attorneys - subject to proper legal qualification - must be admitted as representatives of a party in all kind of proceedings





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Thank you!

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