



UPC and Bifurcation

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SOME BASICS

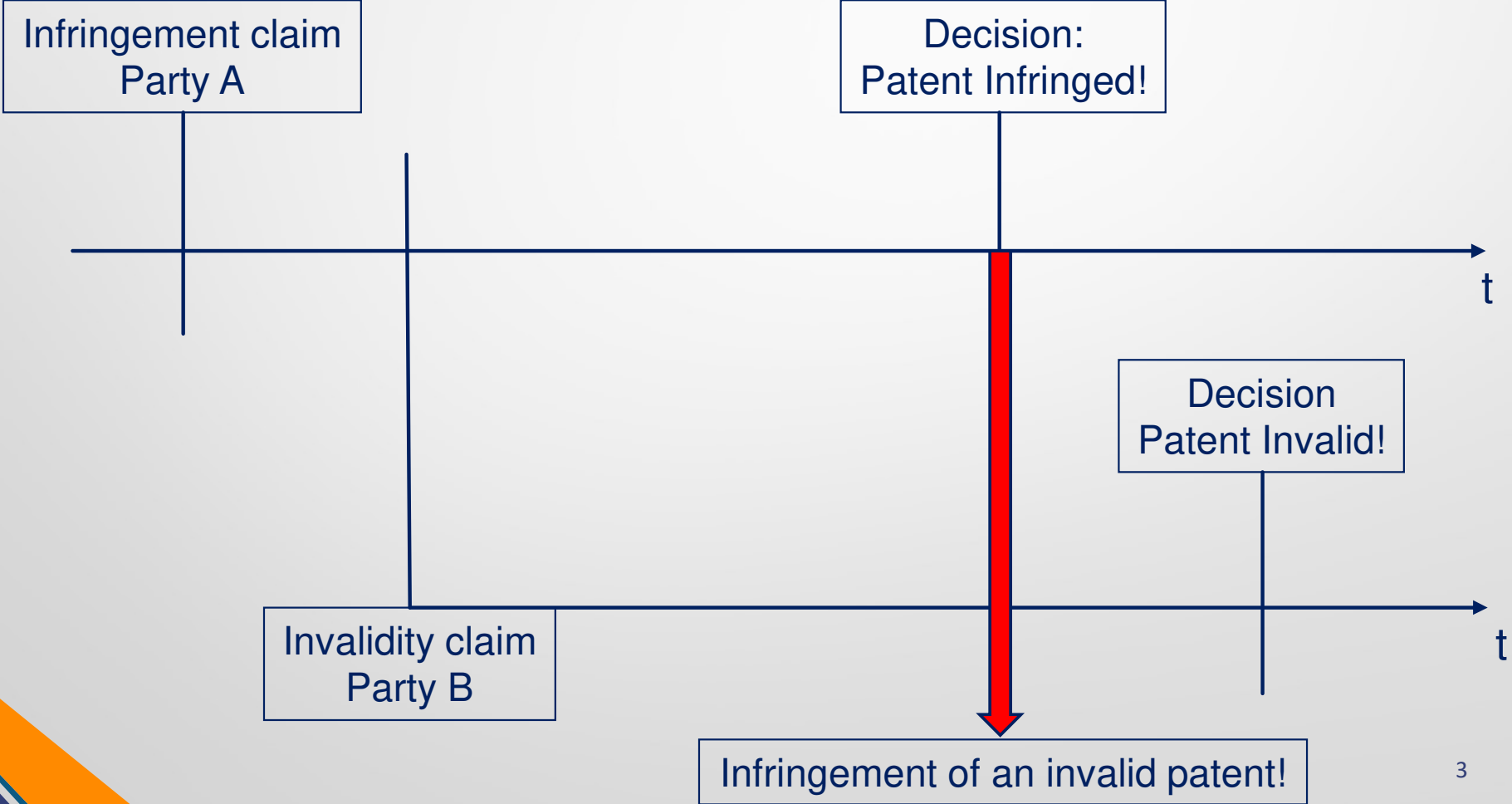


«There is no infringement of an invalid patent»

Sounds obvious! But is it (always) true?

Yes, where infringement and validity are evaluated by the same judge/panel/board/jury

BIFURCATION



UPC: a bifurcated system?



FIRST INSTANCE – ART 33(1) UPC - COMPETENCE

(1) Without prejudice to paragraph 7 of this Article, actions referred to in Article 32(1)(a), (c), (f) and (g) shall be brought before:

- (a) the local division hosted by the Contracting Member State where the actual or threatened infringement has occurred or may occur, or the regional division in which that Contracting Member State participates; or
- (b) the local division hosted by the Contracting Member State where the defendant or, in the case of multiple defendants, one of the defendants has its residence, or principal place of business, or in the absence of residence or principal place of business, its place of business, or the regional division in which that Contracting Member State participates. An action may be brought against multiple defendants only where the defendants have a commercial relationship and where the action relates to the same alleged infringement.

UPC: a bifurcated system?



FIRST INSTANCE – ART 33(4)(5) UPC - COMPETENCE

(4) Actions referred to in Article 32(1)(b) and (d) shall be brought before the central division. If, however, an action for infringement as referred to in Article 32(1)(a) between the same parties relating to the same patent has been brought before a local or a regional division, these actions may only be brought before the same local or regional division.

(5) If an action for revocation as referred to in Article 32(1)(d) is pending before the central division, an action for infringement as referred to in Article 32(1)(a) between the same parties relating to the same patent may be brought before any division in accordance with paragraph 1 of this Article or before the central division. The local or regional division concerned shall have the discretion to proceed in accordance with paragraph 3 of this Article.

UPC: a bifurcated system?



APPEAL – ART 73(1) UPC + R.340 RoP

(1) An appeal against a decision of the Court of First Instance may be brought before the Court of Appeal by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of the notification of the decision.

Rule 340 – Connection Joinder

1. In the interests of the proper administration of justice and of avoiding inconsistent decisions, where more than one action concerning the same patent (whether or not between the same parties) is pending before:

(a) different panels (whether in the same or different divisions); or

(b) different panels of the Court of Appeal,

the panels may by agreement, at any time, after hearing the parties, order that two or more actions shall, on account of the connection between them, be heard together. Article 33 of the Agreement shall be respected.

2. The actions may subsequently be disjoined.

UPC: a bifurcated system?



NO.... Parallel proceedings may happen but are NOT mandatory

The Local/Regional Division has the discretion to refer, not the obligation to refer

IT HAS THE COMPETENCE TO TAKE A DECISION

Parallel proceedings



But also in case of referral: R.37(5) RoP + R.40 RoP

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

5. Where the panel decides to proceed in accordance with Article 33(3)(b) of the Agreement and not to stay the proceedings, the judge-rapporteur of the regional or local division shall communicate to the central division the dates set for the interim conference and for the oral hearing according to Rule 28.

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]; or
- (b) the regional or local division has referred the Counterclaim for revocation to the central division and where the infringement action has not been stayed.

In the latter case, the judge-rapporteur of the panel of the central division shall endeavour to set a date for the oral hearing on the revocation action prior to the date of the oral hearing of the infringement action.

My (not only my) guess...



Referral to the Central Division, leading to possible parallel proceedings, will not be largely used

Where the Local/Regional Division is made by legal judges used to evaluating also technical facts: no reason to refer!

Where the Local/Regional Division is made by legal judges used to being supported by technical experts for evaluating technical facts, the panel will «use» the (mandatory!) technical judge



THANK YOU

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