

November 2013

CNIPA is a European body representing most of the national Institutes of Patent Attorneys throughout Europe. The Member Institutes of CNIPA are the national Institutes of Austria, Belgium, Czech Republic, Germany, Spain, France, Croatia, Hungary, Ireland, Italy, United Kingdom, Liechtenstein, the Netherlands, Poland, Portugal and Sweden. For more information on CNIPA please refer to Annex 1 attached hereto.

CNIPA as the representation of the professional organizations in Europe wants to support the Preparatory Committee of the Unified Patent Court (UPC) and stresses the importance of suitably qualified Patent Attorneys to represent parties before the UPC.

At a meeting of its Executive Committee held in Paris on 30 November 2013 CNIPA adopted the following Resolution:

## **RESOLUTION ON THE REPRESENTATION OF PATENT ATTORNEYS AT THE UNIFIED PATENT COURT**

On the one hand, there is the necessity to define the European Patent Litigation Certificate, on the other hand, we perceive it as important to consider the alternative ways that allow Patent Attorneys to demonstrate their qualification to represent clients before the UPC.

As the system should demonstrate its quality and effectiveness from the very beginning, we strongly recommend to work out the requirements for the European Patent Litigation Certificate as soon as possible, thus allowing Patent Attorneys to qualify in due time. Further we recommend to set out in time, which other circumstances will justify that the Patent Attorney has appropriate qualification.

According to Article 48 (2) of the Agreement on a Unified Patent Court,

*“the parties may be represented by European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who have appropriate qualifications such as a European Patent Litigation Certificate”.*

According to Rule 286 (2) of the Preliminary set of provisions for the Rules of Procedure (“Rules”) of the Unified Patent Court

*“a representative pursuant to Article 48 (2) of the Agreement on a Unified Patent Court 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”.*

Concerning the European Patent Litigation Certificate and the appropriate qualification we would like to make the following comments and suggestions:

## **I. European Patent Litigation Certificate**

The Certificate should cover the legal areas according to Art. 24 of the Agreement. Art. 24 determines exactly the areas of law that will be applicable by the Unified Patent Court, namely

- *“Union law, including Regulation (EU) No.1257/2012 and Regulation (EU) No. 1260/2012;*
- *this Agreement;*
- *other international agreements applicable to patents and binding on all the Contracting Member States; and*
- *national law.”*

The EPC which is also mentioned as one of the applicable sources of law should be left aside as all European Patent Attorneys have proved their knowledge by the European Qualifying Examination (EQE).

In the member states of the Agreement, universities already offer study courses and certificates for postgraduates and have a wide range of experience in that respect. As European Patent Attorneys have already passed university exams, it seems to us that the ideal institutions for providing corresponding courses for European Patent Litigation Certificates are also universities of the member states. This would allow different universities to develop courses for the European Patent Litigation Certificate covering the areas of law mentioned in Art. 24.

Actually there are already similar certificates. The CEIPI “Patent Litigation in Europe” program at the University of Strasbourg could serve as one example for other universities.

## II. Other Appropriate Qualifications

According to Art. 48 (2) of the Agreement and to Rule 286 (2) of the Preliminary set of provisions, the European Litigation Certificate is one option to prove appropriate qualification. Both regulations allow for other ways to justify representation by European Patent Attorneys. We consider that there should be a number of separate ways in which European Patent Attorneys could demonstrate their qualification to represent clients before the UPC, e.g.:

- A degree in law in a member state of the Agreement as for instance a Bachelor, Master or Diploma in Law;

or

- A national certificate or equivalent qualification in patent litigation;

or

- Practice as a Patent Attorney for at least five years and participation in at least 3 to 5 patent related matters before a court in a Contracting Member State or in appeal proceedings before the European Patent Office;

or

- Other justification of appropriate qualification to represent a party before the Court by proving knowledge in the legal areas according to Art. 24 of the Agreement.

We would be pleased if you were to take our proposals into consideration and are at your disposition for further discussions.

Nanno Lenz  
President

This resolution is supported by the following member organizations:

- Österreichische Patentanwaltskammer (AT);
- Chambre des Conseils en Propriété Industrielle de Belgique (BE);
- Komora patentových zástupců České republiky (CZ).
- Patentanwaltskammer (DE);
- Compagnie Nationale des Conseils en Propriété Industrielle (FR);
- Chartered Institute of Patent Attorneys (GB);
- Hrvatska Komora patentnih zastupnika i zastupnika za žigove (HR);
- Magyar Szabadalmi Ügyvivői Kamara (HU);
- Association of Patent and Trade Mark Agents (IE);
- Ordine dei Consulenti in Proprietà Industriale (IT);
- Orde van Octrooigemachtigden (NL);
- Polska Izba Rzeczników Patentowych (PL);
- Associação Portuguesa dos Consultores em Propriedade Industrial (PT);

## **ANNEX 1 - Information about CNIPA**

CNIPA is a European body representing most of the national institutes of patent attorneys throughout Europe. The current Member Institutes of CNIPA are the national Institutes of Austria, Belgium, Czech Republic, Germany, Spain, France, Croatia, Hungary, Ireland, Italy, United Kingdom, Liechtenstein, the Netherlands, Poland, Portugal and Sweden.

CNIPA was formed in the 1950's, with the British, Dutch, and German Institutes as founding members in response to a wish of those Institutes that there should be some representation for those Institutes that had an effective professional examination and whose member Attorneys were well trained in conducting effective examinations of patent applications before patent Offices. CNIPA held its first meeting in October 57. From those beginnings, CNIPA has now sixteen national Institutes as members. CNIPA is a committee of the member Institutes, represented by their Presidents or their substitutes.

Each member Institute must be a national or regional Institute of Intellectual Property Attorneys to which belong a significant number of that country's or region's patent attorneys on a list officially recognised by the national Patent Office or by a corresponding authority such as the European Patent Organisation. The Institute must require future patent attorneys to have a technical qualification such as an engineering or science degree and to pass an effective professional examination in patent law. The member Institutes must all be European.

Fundamentally, the main object of CNIPA is to have close co-operation between the member Institutes, exchanging opinions and agreeing on matters of interest as well as exchanging information regarding laws and practice throughout the world, in relation to all forms of intellectual property. CNIPA also has the important function of acting as a non-governmental organisation (NGO) and as such making representations to governmental and other bodies on matters of interest to patent attorneys.

At the present time, Mr Nanno Lenz (DE) is the President, Dr. Rainer Beetz (AT) is the Vice-President, and Mr Marc Bethenod (FR) is the Treasurer. Mr Patrice Vidon (FR) is the immediate past-President. His predecessor was Mr Edward Lyndon-Stanford (GB).