



# European Patent Litigator

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Un mondo  
intricato con  
nuove figure  
professionali



# European patent litigator

- An acronym for:
- European Patent Attorneys who is entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who has appropriate qualifications such as a European Patent Litigation Certificate



- **A lawyer?**
- **Barrister**
- **Advocate**
- **Advocate on record**
- **Advocate general**
- **Attorney General**
- **Solicitor General**



Che voi siate coinvolti nell'UPC come titolari o come contraffattori  
con l'UPC aumentano rischi e opportunità



La conoscenza del sistema aiuta a trasformare un salto nel vuoto in un atterraggio morbido

# Representation all'UPC: Art 48 dell'agreement

- Parties shall be represented by lawyers authorised to practise before a court of a Contracting Member State.
- Parties may alternatively be represented by European Patent Attorneys who are entitled .....





## Chi può diventarlo e come?

- The requirements for qualifications have been established by the Administrative Committee.
- Gordon Harris, Gowling “the UPC will admit all EPO-registered European patent attorneys with the necessary litigation certification. This includes UK-based patent attorneys, their colleagues from Poland, Spain and Switzerland, as well as countries that are member states of the EPC but not the UPC.” (see <https://www.juve-patent.com/news-and-stories/people-and-business/uk-and-swiss-patent-attorneys-can-represent-clients-at-upc/>)

# European Patent Litigation Certificate

Rules of the Administrative  
committee on the European  
Patent Litigation Certificate and  
other appropriate qualifications  
pursuant to Art. 48(2)

[https://www.unified-patent-court.org/sites/default/files/ac\\_06\\_22022022\\_rev\\_e\\_0.pdf](https://www.unified-patent-court.org/sites/default/files/ac_06_22022022_rev_e_0.pdf)

Effect from June 15<sup>th</sup> 2022

*Certificate of*  
**EXCELLENCE**

*Awarded to*

*for superior excellence in*

*This \_\_\_\_\_ day of \_\_\_\_\_ in the year \_\_\_\_\_*

*Signed \_\_\_\_\_*



# European Patent Litigation Course

- The Certificate may be issued by universities and other non-profit educational bodies of higher or professional education established in a Member State of the European Union as well as by the Unified Patent Court's Training Centre in Budapest
- to European Patent Attorneys who have successfully completed a course on European patent litigation accredited

## *Diploma on Patent Litigation in Europe*

*CEIPI / UNIVERSITY OF STRASBOURG*

*Leading towards the European  
Patent Litigation Certificate*



Centre d'études internationales de la **propriété intellectuelle** | CEIPI

Center for International **Intellectual Property** Studies

Institut für internationale Studien des **geistigen Eigentums**

Université de Strasbourg



# Further Appropriate qualifications

## Rule 11 – Law diplomas

European Patent Attorneys holding a bachelor or master degree in law or who have passed an equivalent state exam in law of a Member State of the European Union shall be deemed to have appropriate qualifications pursuant to Article 48(2) of the Agreement on a Unified Patent Court and may apply for registration on the list of entitled representatives.

## Rule 12 – Other qualifications during a transitional period

During a period of one year from the entry into force of the Agreement

(a) the successful completion of one course among a list reported in the rules  
or

(b) having represented a party on his own without the assistance of a lawyer admitted to the relevant court 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 years preceding the application for registration.





# PRIVILEGED COMMUNICATION

## Rights and immunities?

Representatives of the parties shall enjoy the rights and immunities necessary for the independent exercise of their duties, including the privilege from disclosure in proceedings before the Court in respect of communications between a representative and the party or any other person, under the conditions laid down in the Rules of Procedure, unless such privilege is expressly waived by the party concerned.



# Difference between confidential e privileged?

The UPC Agreement and the Rules of Procedure do not define what amounts to confidential or privileged information

Confidential information should be understood as information that is not generally known or readily accessible by the public and of which the owners want to prevent or at least restrict the dissemination.

Privileged information on the other hand is information that, in the course of legal proceedings, is typically exempt from production to an opponent or even the court because it is covered by a legal provision that prevents the information from being disclosed against the will of the party enjoying the privilege.





# Obligations of a European Patent Litigator

Representatives of the parties shall be obliged not to misrepresent cases or facts before the Court either knowingly or with good reasons to know.



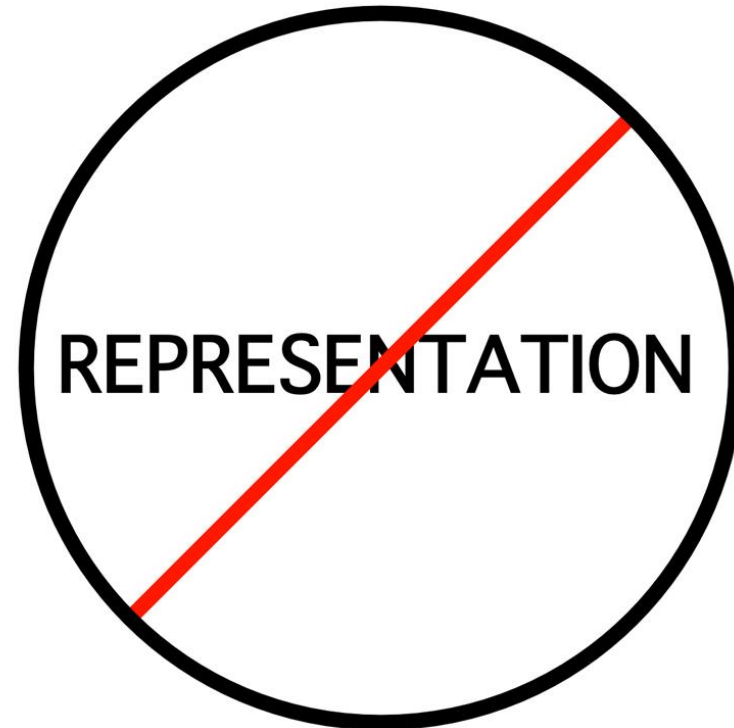
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# When the Representation of a European Patent Litigator is not necessary?

Representation in accordance with paragraphs 1 and 2 of Article 48 UCP Agreement is not required in proceedings under Article 32(1)(i):

Art 32(1)(i): actions concerning decisions of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012





# In Acts before the EPO the representative is a European Patent Attorney

- (a) to administer requests for unitary effect by proprietors of European patents;
- (b) to include the Register for unitary patent protection within the European Patent Register and to administer the Register for unitary patent protection;
- (c) (c) to receive and register statements on licensing
- (d) to publish the translations referred to in Article 6 of Regulation (EU) No 1260/2012 during the transitional period referred to in that Article;
- (e) to collect and administer renewal fees for European patents with unitary effect,
- (f) to administer the compensation scheme for the reimbursement of translation costs referred to in Article 5 of Regulation (EU) No 1260/2012;
- (g) to ensure that a request for unitary effect by a proprietor of a European patent is submitted in the language of the proceedings no later than one month after the mention of the grant is published
- (h) to ensure that the unitary effect is indicated in the Register for unitary patent protection, where a request for unitary effect has been filed and, during the transitional period provided for in Article 6 of Regulation (EU) No 1260/2012, has been submitted together with the translations referred to in that Article, and that the EPO is informed of any limitations, licences, transfers or revocations of European patents with unitary effect.

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