

U.J.U.B.

Union pour la Juridiction Unifiée des Brevets

Unified Patent Court Mock Trial

Paris April, 2nd 2015

U.J.U.B. - Union pour la Juridiction Unifiée des Brevets

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Is the Union of:



ASSOCIATION FRANÇAISE
POUR LA PROTECTION DE LA PROPRIÉTÉ INDUSTRIELLE
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3 Abrasive (3A)/LA Toilemeri

Mock Trial in two acts:

1. Request to preserve evidence

Pleading of the claimant

Decision of the Court

2. Application for provisional measures

Pleading of the claimant

Pleading of the defendant

Decision of the Court

Synopsis by Axel CASALONGA

THE MOCK TRIAL ACTORS

The Court

Legaly qualified

Mr. Paul MAIER – FR President

Sir Colin BIRSS – UK Rapporteur

Mrs. Sophie CANAS - FR

Technically qualified

Mr. Kim FINNILÄ - FI

Representants of the parties

For 3 ABRASIVE (3A)

Mr. Axel CASALONGA- FR

Me Martin KÖHLER-DE

For La Toile Emeri SA

Mr. Kay RUPPRECHT-DE

Me Grégoire DESROUSSEAUX-FR

The synopsis (1/3)

The infringement action has been engaged at time t before the local division in Paris by an US company owner of a European patent granted in English against a French company (alleged infringer) on the basis of an offer to sell the allegedly infringed product throughout Europe by Internet.

At the time of the filing of the statement of claim, no effective manufacturing or selling of the infringing product have been detected.

The plaintiff has filed the statement of claim in English since the French local division accepts as an additional procedural language, English as one of the EPC languages. The language of the procedure before the local division would then be English.

In its statement in response, the defendant have applied for revocation of the patent by way of a counterclaim for revocation which has triggered the allocation of a technical Judge to the panel. Simultaneously, the defendant would have intervened in the appeal procedure of an opposition initiated by a third party before the EPO.

The plaintiff have filed a reply to the statement of defense as well as a defense to the counter claims at time $t+4$ months.

Both parties have agreed that the panel proceed in accordance with Article 33(3)(a) of the UPCA (i.e., decide on infringement and validity) and request allocation of a technical judge. The judge rapporteur have requested such allocation and the panel comprises such technical judge.

The synopsis (2/3)

The Mock Trial itself began at time t+5 months. Following the arguments of La Toilemeri in its Statement of defense, insisting particularly on the absence of evidence of reproduction of the claimed method of manufacturing, 3A decided to file on 29 December 2014 an Application to preserve evidence (Rule 192) with a request of an order for inspection at the premises of La Toilemeri, near Paris.

The request is exceptionally transmitted to the full Panel (Rule 194-3) since it is the first case of this sort.

Act one of the mock trial will represent the unilateral hearing for the request for preservation of evidence and the request for inspection in situ.

After deliberation, the Court will give its decision.

The synopsis (3/3)

However, on 16 January, 2015, 3A detected an announcement on the web site of La Toilemeri indicating that the product of La Toilemeri was about to be launched on a great scale as from next June 8, and presented in an international exhibition in Paris beginning May 28.

3A decided therefore to file instead an Application for provisional measures (Rule 206) in order to try stopping the acts which 3A considers infringe its European patent. This Application was filed on 26 January 2015.

La Toilemeri filed observations against this Application on 3 March 2015 (Rule 209)

The oral hearing has been scheduled for today.

Act two of the mock trial will represent this inter-partes hearing for the order of provisional measures.

After deliberation, the Court will give its decision.

The chronology

Mock Trial before the Unified patent Court – 2 april 2015

EPO	
3 September 2014	Decision of Opposition Division
23 October 2014	Notice of Appeal filed by third party
21 November 2014	Statement with grounds of appeal
16 December 2014	Intervention of TE in Appeal procedure
10 March 2015	Summons to oral procedure scheduled for the 25 February 2016

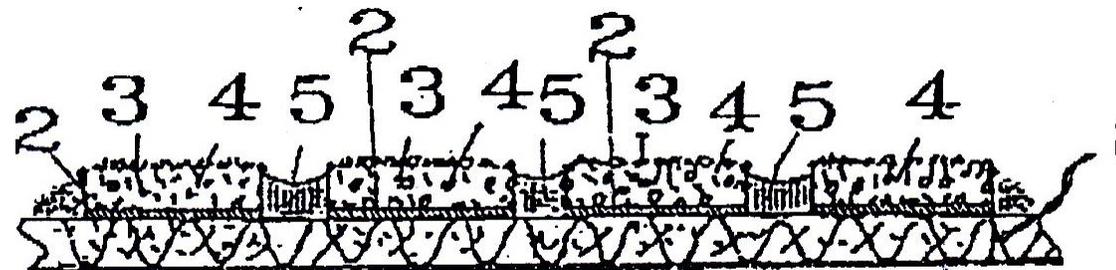
UPC	
25 August 2014	Advertisement on website by TE
13 October 2014	Statement of claim by 3A
30 October 2014	Designation of Judge Rapporteur (R18)
18 December 2014	Defense counterclaim by TE
19 December 2014	Request for Stay of proceeding (R295) + request of acceleration to EPO
22 December 2014	Allocation of Technical Judge (R33)
29 december 2014	Application for preserving evidence by 3A (R192)
5 January 2015	Oral hearing
8 January 2015	Inspection
15 January 2015	Annoucement on website by TE
26 January 2015	Request for provisional measures by 3A (R206)
3 March 2015	Objections by TE (R209)
2 April 2015	Oral hearing
28 May/3 June 2015	Expo
8 June 2015	Foreseen launch

The Patented Invention

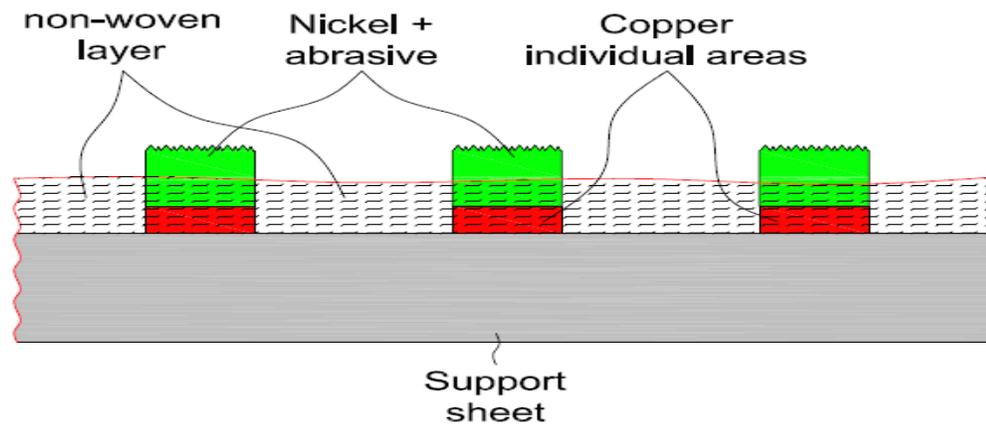
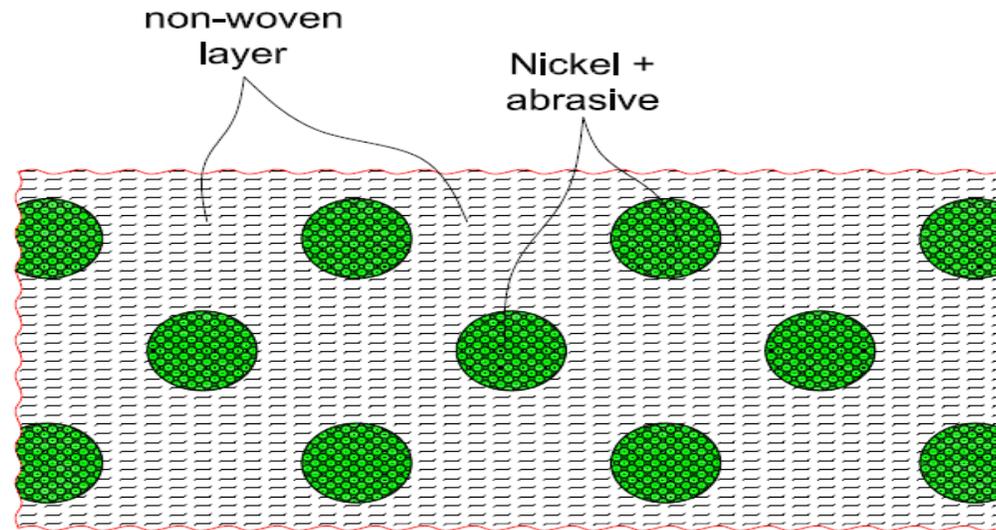
Claim

1. A method for manufacturing an abrasive member comprising a flexible sheet (1) with a multitude of discrete metal protuberances (2,3) wherein a multitude of copper protuberances (2) are formed on the flexible sheet (1), nickel protuberances (3) are electrodeposited over the copper protuberances (2) in the presence of particulate abrasive material (4) so that the particulate abrasive material becomes embedded in the nickel deposits and wherein the voids between the protuberances (2,3) are at least partially filled with resin material, the resin material being selected so as to reduce lateral movement of the nickel deposits.

The **resulting abrasive product** is illustrated on figure 1 of the Patent



The Litigated Product



The Request to preserve evidence

UPC articles and rules

Collecting evidence

- Art 53 Means of evidence
- Art 56 The general powers of the Court
- Art 59 Order to produce evidence
 - R 190
- Art 60 Order to preserve evidence and to inspect premises
 - R 192-199

Collecting evidence

UPC Agreement

Art 60 Order to preserve evidence and to inspect premises

(1/3)

- (1) At the request of the applicant which has presented reasonably available evidence to support the claim that the patent has been infringed or is about to be infringed the Court may, even before the commencement of proceedings on the merits of the case, order prompt and effective provisional measures to preserve relevant evidence in respect of the alleged infringement, subject to the protection of confidential information.
- (2) Such measures may include the detailed description, with or without the taking of samples, or the physical seizure of the infringing products, and, in appropriate cases, the materials and implements used in the production and/or distribution of those products and the documents relating thereto.
- (3) The Court may, even before the commencement of proceedings on the merits of the case, at the request of the applicant who has presented evidence to support the claim that the patent has been infringed or is about to be infringed, order the inspection of premises. Such inspection of premises shall be conducted by a person appointed by the Court in accordance with the Rules of Procedure.

Collecting evidence

UPC Agreement

Art 60 Order to preserve evidence and to inspect premises

(2/3)

- (4) At the inspection of the premises the applicant shall not be present itself but may be represented by an independent professional practitioner whose name has to be specified in the Court's order.
- (5) Measures shall be ordered, if necessary without the other party having been heard, in particular where any delay is likely to cause irreparable harm to the proprietor of the patent, or where there is a demonstrable risk of evidence being destroyed.
- (6) Where measures to preserve evidence or inspect premises are ordered without the other party in the case having been heard, the parties affected shall be given notice, without delay and at the latest immediately after the execution of the measures. A review, including a right to be heard, shall take place upon request of the parties affected with a view to deciding, within a reasonable period after the notification of the measures, whether the measures are to be modified, revoked or confirmed.

Collecting evidence

UPC Agreement

Art 60 Order to preserve evidence and to inspect premises

(3/3)

- (7) The measures to preserve evidence may be subject to the lodging by the applicant of adequate security or an equivalent assurance intended to ensure compensation for any prejudice suffered by the defendant as provided for in paragraph 9.
- (8) The Court shall ensure that the measures to preserve evidence are revoked or otherwise cease to have effect, at the defendant's request, without prejudice to the damages which may be claimed, if the applicant does not bring, within a period not exceeding 31 calendar days or 20 working days, whichever is the longer, action leading to a decision on the merits of the case before the Court.
- (9) Where the measures to preserve evidence are revoked, or where they lapse due to any act or omission by the applicant, or where it is subsequently found that there has been no infringement or threat of infringement of the patent, the Court may order the applicant, at the defendant's request, to provide the defendant with appropriate compensation for any damage suffered as a result of those measures.

Provisional measures

UPC article (1/2)

ARTICLE 62 Provisional and protective measures

(1) The Court may, by way of order, grant injunctions against an alleged infringer or against an intermediary whose services are used by the alleged infringer, intended to prevent any imminent infringement, to prohibit, on a provisional basis and subject, where appropriate, to a recurring penalty payment, the continuation of the alleged infringement or to make such continuation subject to the lodging of guarantees intended to ensure the compensation of the right holder.

(2) The Court shall have the discretion to weigh up the interests of the parties and in particular to take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.

Provisional measures

UPC article (1/2)

ARTICLE 62 Provisional and protective measures (Continuation)

(3) The Court may also order the seizure or delivery up of the products suspected of infringing a patent so as to prevent their entry into, or movement, within the channels of commerce. If the applicant demonstrates circumstances likely to endanger the recovery of damages, the Court may order the precautionary seizure of the movable and immovable property of the alleged infringer, including the blocking of the bank accounts and of other assets of the alleged infringer.

(4) The Court may, in respect of the measures referred to in paragraphs 1 and 3, require the applicant to provide any reasonable evidence in order to satisfy itself with a sufficient degree of certainty that the applicant is the right holder and that the applicant's right is being infringed, or that such infringement is imminent.

(5) Article 60(5) to (9) shall apply by analogy to the measures referred to in this Article.

Provisional measures

UPC rules 17th draft

Rule 206 – (extract)

...

2. An *Application for provisional measures shall contain:

- (b) a indication of the provisional measures which are being requested [Rule 211.1], ;
- (c) the reasons why provisional measures are necessary to prevent a threatened infringement, to forbid the continuation of an alleged infringement or to make such continuation subject to the lodging of guarantees, ;
- (d) the facts and evidence relied on in support of the Application, including evidence to support the claim that provisional measures are necessary including the matters referred to in Rule 211.2 and .3,; and
- (e) a concise description of the action which will be started before the Court, including an indication of the facts and evidence which will be relied on in support of the main proceedings on the merits of the case.

3. Where the applicant requests that provisional measures be ordered without hearing the other party (hereinafter "the defendant"), the *Application for provisional measures shall in addition contain:

- (a) the reasons for not hearing the defendant having regard in particular to Rule 197,; and
- (b) information about any prior correspondence between the parties concerning the alleged infringement.

4. The applicant shall be under a duty to disclose any material fact known to it which might influence the Court in deciding whether to make an order without hearing the defendant including any pending proceedings and/or any unsuccessful attempt in the past to obtain provisional measures in respect of the patent (or patents).

...

Provisional measures

UPC rules 17th draft

Rule 209 – Examination of the Application for provisional measures (extract)

1. ...the Court shall have the discretion to :

(a) inform the defendant about the Application and invite him to lodge, within a time period to be specified, an *Objection to the Application for provisional measures which shall contain:

(i) the reasons why the Application shall fail,;

(ii) the facts and evidence relied on, in particular any challenge to the facts and evidence relied on by the applicant; (b) summon the parties to an oral hearing,;

...

2. In exercising its discretion pursuant to Rule 209.1, the Court shall in particular take into account:

(a) whether the patent has been upheld in an opposition procedure before the European Patent Office or has been the subject of proceedings in any other court,;

(b) the urgency of the action,;

...

3. In cases of extreme urgency the standing judge appointed in accordance with Rule 345.5 may decide immediately on the Application for provisional measures and the procedure to be followed on the Application.

4. If the applicant has applied for provisional measures without hearing the defendant and the Court decides not to grant provisional measures without hearing the defendant the applicant may withdraw the Application and may request that the Court order that the Application and the contents of the Application remain confidential.

The Request for provisional measures

UPC rules 17th draft

Rule 211 Decision Order on the Application for provisional measures (extract)

1. The Court may in particular order the following provisional measures:

- (a) injunctions against a defendant;
- (b) the seizure or delivery up of the goods suspected of infringing a patent right so as to prevent their entry into or movement within the channels of commerce;
- (c) if an applicant demonstrates circumstances likely to endanger the recovery of damages, a precautionary seizure of the movable and immovable property of the defendant, including the blocking of his bank accounts and other assets;
- (d) make an interim award of costs.

2. In taking its decision the Court may require the applicant to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty that the applicant is entitled to commence proceedings pursuant to Article 47, that the patent in question is valid and that his right is being infringed, or that such infringement is imminent.

3. In taking its decision on the Application for provisional measures, the Court shall have in the exercise of its discretion to weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the granting or the refusal of the injunction.

4. The Court shall have regard to any unreasonable delay in seeking provisional measures.

5. The Court may order the applicant to provide adequate security for appropriate compensation for any injury likely to be caused to the defendant which the applicant may be liable to bear in the event that the Court revokes the order for provisional measures. The Court shall do so where interim measures are ordered without the defendant having been heard unless there are special circumstances not to do so. The Court shall decide whether it is appropriate to order the security by deposit or bank guarantee. The order shall be effective only after the security has been given to the defendant in accordance with the Court's decision. ...