

Title: Unified Patent Court Implementation - Jurisdiction IA No: BISIPO006 Lead department or agency: BIS - Intellectual Property Office Other departments or agencies: Ministry of Justice	Impact Assessment (IA)
	Date: 26/03/2014 Stage: Consultation Source of intervention: International Type of measure: Secondary legislation Contact for enquiries: Katherine Evans katherine.evans@ipo.gov.uk

Summary: Intervention and Options	RPC Opinion: Amber
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Cost of Preferred (or more likely) Option				
Total Net Present Value	Business Net Present Value	Net cost to business per year (EANCB on 2009 prices)	In scope of One-In, Two-Out?	Measure qualifies as
£0m	£0m	£0m	No	N/A

What is the problem under consideration? Why is government intervention necessary?

The current system for obtaining and enforcing European patents is fragmented. Any litigation for a European patent takes place at a national level, rather than at European level. This means that, for example, a patentee who needs to enforce their patent in more than one member state must pursue legal proceedings in several different courts, even if the patents are essentially the same. In order to resolve this, a single court will be set up under the Unified Patent Court Agreement allowing patent disputes to be decided in a single set of proceedings. To permit users in the UK to take advantage of the Unified Patent Court (UPC), certain changes to the Patents Act (1977) are necessary.

What are the policy objectives and the intended effects?

The aim is to improve the enforcement of patents across Europe, so that they can be defended in a single court rather than having to be litigated country-by-country which can cause additional cost and delay in preventing infringement. This should make it easier for businesses to exploit patent rights at a European scale.

The UK will host divisions of the UPC which should bring wider benefits by increasing the UK's reputation as a centre for litigation. There will also be benefits to innovation through the breaking down of barriers within Europe.

What policy options have been considered, including any alternatives to regulation? Please justify preferred option (further details in Evidence Base)

Option 1 - do nothing.

Option 2 - make changes necessary to give effect to the jurisdiction of the UPC in UK law.

Our preferred option is Option 2 as the benefits of the implementing UPC are expected to outweigh the costs of continuing with the fragmented system currently in place.

Will the policy be reviewed? It will be reviewed. If applicable, set review date: 7 years from entry into force of the UPC Agreement.

Does implementation go beyond minimum EU requirements?	N/A			
Are any of these organisations in scope? If Micros not exempted set out reason in Evidence Base.	Micro Yes	< 20 Yes	Small Yes	Medium Yes
What is the CO ₂ equivalent change in greenhouse gas emissions? (Million tonnes CO ₂ equivalent)	Traded: n/a		Non-traded: n/a	

I have read the Impact Assessment and I am satisfied that, given the available evidence, it represents a reasonable view of the likely costs, benefits and impact of the leading options.

Signed by the responsible SELECT SIGNATORY: Date:

Summary: Analysis & Evidence

Policy Option 1

Description: Do nothing

FULL ECONOMIC ASSESSMENT

Price Base Year 2014	PV Base Year 2014	Time Period Years	Net Benefit (Present Value (PV)) (£m)			
			Low: 0	High: 0	Best Estimate: 0	
COSTS (£m)		Total Transition (Constant Price) Years	Average Annual (excl. Transition) (Constant Price)		Total Cost (Present Value)	
Low	0	-	0	0	0	
High	0		0	0	0	
Best Estimate	0		0	0	0	
Description and scale of key monetised costs by 'main affected groups'						
No Change						
Other key non-monetised costs by 'main affected groups'						
BENEFITS (£m)		Total Transition (Constant Price) Years	Average Annual (excl. Transition) (Constant Price)		Total Benefit (Present Value)	
			0	0	0	
Low	0	-	0	0	0	
High	0		0	0	0	
Best Estimate	0		0	0	0	
Description and scale of key monetised benefits by 'main affected groups'						
Other key non-monetised benefits by 'main affected groups'						
Key assumptions/sensitivities/risks				Discount rate (%)	3.5	

BUSINESS ASSESSMENT (Option 1)

Direct impact on business (Equivalent Annual) £m:			In scope of OITO?	Measure qualifies as
Costs: 0	Benefits: 0	Net: 0	No	

Summary: Analysis & Evidence

Policy Option 2

Description: Make changes necessary to give effect to the jurisdiction of the UPC in UK law.

FULL ECONOMIC ASSESSMENT

Price Base Year 2014	PV Base Year 2014	Time Period Years 0	Net Benefit (Present Value (PV)) (£m)		
			Low: 0	High: 0	Best Estimate: 0
COSTS (£m)		Total Transition (Constant Price) Years	Average Annual (excl. Transition) (Constant Price)		Total Cost (Present Value)
Low	0	7	0	0	0
High	0		0	0	0
Best Estimate	0		0	0	0

Description and scale of key monetised costs by 'main affected groups'

We are unable to fully monetise the costs (such as court fees) at this stage as much of the detail has yet to be negotiated by the signatory states to the UPC Agreement. We will be asking questions at consultation which should help inform us.

Other key non-monetised costs by 'main affected groups'

There will be costs to businesses that experience uncertainty during the initial transition period of the UPC. Furthermore, non-pharmaceutical patent holders face the possibility of their cases being heard outside of the UK. The UPC will require contributions from Government, at least in the early stages of its existence. The exact scale of this funding will become clearer when court fees are decided.

BENEFITS (£m)	Total Transition (Constant Price)	Years	Average Annual (excl. Transition) (Constant Price)	Total Benefit (Present Value)
Low	0	7	0	0
High	0		0	0
Best Estimate	0		0	0

Description and scale of key monetised benefits by 'main affected groups'

We are unable to fully monetise the benefits at this stage, we hope to gain greater insight into the benefits at consultation stage.

Other key non-monetised benefits by 'main affected groups'

There will be benefits to businesses who will now obtain a pan-European judgement from one court. This will result in costs savings from non-duplicated legal and court fees.

There may be an influx of cases to the UK regarding pharmaceutical patents. This could directly benefit UK lawyers if foreign litigants demand their services.

Key assumptions/sensitivities/risks	Discount rate (%)	3.5
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We assume that the other required countries (France and Germany) will also ratify the Agreement, and that we are joined by 10 other Signatory States.

We also assume that the necessary changes are made to the Brussels I Regulation (Regulation (EU) No 1215/2012, recasting Regulation (EU) No 44/2001) prior to ratification.

This proposal also assumes that the UK remains part of the EU.

BUSINESS ASSESSMENT (Option 2)

Direct impact on business (Equivalent Annual) £m:			In scope of OITO?	Measure qualifies as
Costs: 0	Benefits: 0	Net: 0	No	

Problem under consideration

Currently there is no single European patent. Instead, individual national patents must be obtained separately from each national patent office. Alternatively, the European Patent Office (EPO) can grant patents in a single procedure for up to 38 European states but once granted these are treated as separate national patents (these are commonly referred to as ‘bundle patents’ and will be referred to as such below¹). This means that whilst the pre-grant process is streamlined, enforcing a patent across multiple European states is more difficult. As a national right, each patent must be defended in each separate jurisdiction, leading to duplication of court cases. This fragmented system of litigation creates difficulties because procedures around Europe differ. This means that due to diverse legal traditions outcomes of cases relating to the same patent can vary across Europe and the time taken to reach a judgment can vary also.

In summary, obtaining patent protection across Europe is costly (compared with, for example, the USA), as evidenced in IA BISIPO005. The protection is not uniform, and enforcement must be conducted separately in each country with potentially different outcomes.

Rationale for intervention

The Government wants the UK to be part of a European patent system that supports growth and provides a cost effective option for innovative business that want to protect and market their inventions across Europe. This is why The UK Government signed the Unified Patent Court (UPC) Agreement along with 25 other EU Member States on 19 February 2013.

The current, fragmented system of patent protection in Europe is seen to be a barrier to some, and as such may inhibit the potential for new businesses with an interest in patenting in Europe, especially when compared with other markets of a similar size such as the US and Japan which have single court systems. One way to achieve parity with these markets is to offer a court system that people can rely upon to give judgments that are applicable across multiple states, therefore protecting their patent across a region of comparable size to the US and Japan. This measure offers a court system that reduces the need for litigating patent disputes separately in multiple states. This measure accompanies the introduction of the Unitary Patent and permits the enforcement of the Unitary Patent in a single court. However, the benefits of the UPC are not limited to users of the Unitary Patent. People will continue to be able to obtain bundle patents and may benefit from the Court as any judgments will enforceable in all countries who are parties to the UPC Agreement.

Background on the UPC Agreement

The UPC Agreement came about as part of the negotiations to establish a Unitary Patent system for Europe. Creating the Unitary Patent required the adoption of two EU regulations² through ‘enhanced cooperation’ (establishing the concept of a Unitary Patent and the language regime).

The Agreement creates the UPC which will be a new specialist patents court common to the participating states. This court will primarily have competence to hear disputes regarding the validity and infringement of the new Unitary Patent as well as European bundle patents granted by the European Patent Office (EPO). It will also have competence over actions concerning infringement and validity of Supplementary Protection Certificates³ (SPCs) for pharmaceutical and plant protection products based on European bundle patents and Unitary Patents. The UPC will not have competence over national patent rights such as those granted by the Intellectual Property Office (IPO) and other national patent offices. Issues relating to the property rights of a patent (whether a Unitary Patent, European bundle patent, or a GB patent) will remain within the competence of UK courts (for example claims over ownership of a patent).

¹ For similar technical terms, please see the glossary in Annex A

² Regulation (EU) No 1257/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection and Regulation (EU) No 1260/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regards to the applicable translation arrangements.

³ Supplementary Protection Certificates (SPCs) are provided for in European Union Regulations (Regulation (EC) No 469/2009 and Regulation (EC) No 1610/96) and extend the period of legal protection afforded to medicinal and plant products beyond the life of the patent relating to them for up to 5 years and 6 months.

In order to implement the UPC Agreement it is necessary to amend domestic law to ensure clarity over where the UPC will have competence. The Patents Act 1977 describes what aspects of patent law UK courts have competence over; this must be changed in order that the UPC is given competence over the specific types of dispute outlined above. Intervention will provide patent holders and third parties with clarity over where UK courts have competence, and where the UPC will have competence. It also ensures that UK law is compatible with the Agreement.

The court will open three months after ratification of the Agreement by the UK, France, Germany and 10 other States; this is also the point at which the Unitary Patent Regulation, and accompanying translation Regulation come into force. The opening of the UPC is also dependent on coming into force of the amendment required to the Brussels I Regulation⁴, if this occurs later than the ratification of the necessary states, the UPC will open three months after this is complete. The proposed changes to the Patents Act would also take effect from the date of entry into force of the Agreement.

Policy objectives

By making the relevant changes to the Patents Act, the UK will be in compliance with the Agreement, allowing UK patent holders and business to enjoy the benefits of the UPC. The overall policy objective is to introduce a system which will enforce the Unitary Patent and also European bundle patents (patents granted by the EPO and validated and enforced separately in multiple European states) across the Contracting Member States which have ratified the Agreement, with the aim of reducing the complexity and uncertainty of enforcing a bundle patent or Unitary Patent in multiple jurisdictions.

Options considered

The options considered at this stage are:

Option 1 – do nothing

Taking no action to reflect the changes to jurisdiction in the Patents Act prior to ratification would mean that UK law would not be in compliance with the Agreement.

This is the baseline against which other options will be evaluated.

Option 2 – Make changes necessary to give effect to the jurisdiction of the UPC in UK law

The changes will mean a transfer of jurisdiction from the UK courts to the UPC in patent cases involving infringement and validity of European patents valid in the UK. In addition the changes will confer jurisdiction on the UPC for infringement and validity of the new Unitary Patent. The jurisdictional changes will also apply to Supplementary Protection Certificates (SPCs) based on European bundle patents valid in the UK and Unitary Patents.

Option 2 is the preferred option as it meets the policy objective of introducing a system which offers a less complex, pan-European enforcement of the Unitary Patent, European bundle patents and SPCs based upon them.

Costs and benefits of the options considered

Option 1 - Do nothing

Whilst the UK may ratify the UPC Agreement without making changes to our national law, it is likely that our law would be inconsistent with the Agreement. This could lead to a lack of legal certainty and extra expense for businesses using or challenging patents.

The Agreement as it stands cannot come into force without UK ratification because the UK is one of the three Contracting Member States whose ratification is necessary. If the UK failed to ratify the Agreement the UPC and the Unitary Patent would not come into being.

Option 2

In this option, the necessary changes are made to the Patents Act to give the UPC jurisdiction over infringement and validity of European patents valid in the UK. The Government would then be in a position to ratify the Agreement. This would allow for the entry into force of the UPC and the Unitary Patent, assuming that 12 other Signatory States including France and Germany have also ratified the Agreement.

Costs of Option 2

Those choosing to use the Unitary Patent will be required to use the UPC, as will those holding bundle patents after the transition period is over. Those holding GB patents will not use the UPC and instead will remain at national courts.

Costs during transition period

During the period of transition (7 years, potentially increasing to 14) people are able to choose whether to take a case relating to a bundle patent to a national court or to the UPC unless the proprietor has 'opted out' their bundle patent.

Owners of European patents and SPCs valid in the UK will have a choice to register an 'opt out' of the UPC in the first 7 years. They will be able to 'opt out' of the UPC for the lifetime of the patent/SPC, meaning that they would be considered by national courts rather than the UPC. It will also be possible to withdraw an 'opt out', meaning that litigation concerning those patents/SPCs would then go to the UPC. The transition period will be 7 years from the entry into force of the Agreement, but there is the possibility that it could be extended for an additional 7 years. The draft Rules of Procedure currently propose that there will be a fee charged to register a patent as opted out; the level of fee has not yet been set. During this period patent owners may incur additional costs of seeking advice from patent attorneys over the best route to take for their particular patent portfolio.

Cost to litigants

Legal fees

At present, it is not clear how much legal and patent attorney firms will charge for their services before the UPC. Given the potentially higher value of cases (due to the broader market a decision may cover) it is possible that legal fees may be higher than those for litigation in the UK alone. We are also unsure of the extent that the UPC may create a more competitive environment within Europe for legal practice, and whether this may drive up or down costs depending on where the legal firm is based.

The cost of patent litigation (court fees, fees for hearing witnesses, and attorney costs) under the existing system for bundled patents, in first instance proceedings, has been estimated by Harhoff (2009) at £53,000 (€64,000) per party, for a small to medium case, and £330,000 (€400,000) per party, for a larger case. These estimates, from 2000, are subject to caveats which suggest that they are very conservative numbers and likely underreport the total cost of litigation for the parties involved⁵. Nonetheless, the large range of costs reported reflects that the cost of attorneys is variable and depends largely on case complexity. We will be exploring the factors that may influence legal fees at consultation.

⁵ Harhoff, D. (2009), "Challenges Affecting the Use and Enforcement of Intellectual Property Rights Prepared for the Forum on the Economic Value of Intellectual Property UK Minister for Higher Education and Intellectual Property London, June 10th 2009." P. 9 Published by the IPO and available at <http://www.ipo.gov.uk/ipresearch-challenges-200905.pdf>

Court fees

The overall fee structure for the UPC has not yet been finalised by the participating Member States; however it is known that court fees will comprise a fixed element and a variable element based on the value of the claim. We anticipate there being public consultation by the Preparatory Committee on fees in autumn 2014, before the fees are agreed by Signatory States. We will be encouraging UK stakeholders to take part in this consultation in order that their opinions are considered.

The level of court fees may have a greater impact on defendants who will have no option but to pay fees to defend themselves, for example defendants in an action for patent infringement. Alongside court fees, the unsuccessful party may find that they have to cover a proportion of the successful party's costs up to a ceiling amount which is yet to be decided.

The IPO has commissioned some qualitative research into business behaviours to investigate the factors which will influence businesses in determining whether to use the UPC. We expect the outcomes to be released during summer 2014.

Inability to use IPO tribunal

For those seeking a low-cost resolution in the UK there is currently the possibility of settling low-value disputes (below £1,500) through the Intellectual Property Office (IPO). Alternatively litigants may currently choose to go to the Intellectual Property Enterprise Court (IPEC), which deals with litigation for cases where the value of damages claimed is less than £500,000. These routes will be removed as an option for patents that will become subject to the UPC, which may force some into a higher-cost process than currently.

Potential migration of cases away from UK

The UPC will be comprised of a court of first instance and a Court of Appeal (see Annex C for a diagram). The court of first instance will have a Central Division which will primarily deal with validity cases. The Central Division will be based in Paris and will also have two specialist sections in London and Munich. Cases will be divided between the three sites according to technology type (subject matter of the patent). This means that the London section of the Central Division will deal with validity actions in the chemical and pharmaceutical fields, including life sciences. It will also deal with infringement actions transferred from local or regional divisions and those from countries where there is no local or regional division. The Munich central division will cover mechanical engineering, whilst the Paris central division will deal with all other technology fields – most significantly electronics and ICT, including computing and mobile telecommunications.

The Court of First Instance will also comprise a number of local and regional divisions. A regional division may be based in a group of states who decide to jointly host their division; a local division will be based in a single state. Both local and regional divisions will deal with infringement cases irrespective of the technology of the patent.

Due to the split of technologies between the specialist divisions, it is possible that there will be a migration of cases away from the UK to the Paris or Munich central divisions. Cases that may currently come to the UK, for example relating to UK bundle patents, that relate to mechanical engineering would go to Munich, with all other cases going to Paris. This may potentially lead to loss of income for law firms specialising in these types of patents. However, we would expect this to be offset by pharmaceutical or life sciences cases which are currently heard in other parts of Europe coming to the UK.

Cremers et al (2013)⁶ provide analysis of the technologies involved in patent disputes in France, Germany, UK and Netherlands. The analysis of cases filed between 2000 and 2008 shows that in the UK a large proportion of cases concern chemical and pharmaceutical patents (31% of cases). If we apply this proportion to the number of validity cases Cremers et al identify in the UK, we could assume that of the 59 validity cases in the UK between 2000 and 2008, 18 would have concerned pharmaceuticals. This would suggest that 41 cases would have been at-risk of being heard outside of the UK. This though, is offset by 228 validity cases relating to life sciences patents cases heard in Germany, France and Netherlands. Therefore the impact of cases migrating from the UK could realistically be more than offset by cases coming to UK from other European countries.

The economic impact of cases migrating from the UK to Europe may be mitigated if the parties involved in these cases retain the services of UK lawyers. If this is observed then lawyers incomes would remain roughly the same, although they would face higher costs from travel.

The trend in migration of cases may also be affected by bifurcation. Bifurcation means that a patent case is split in two – with issues of validity and infringement being heard separately; this is a feature of the German court system due to a constitutional difference between the powers of district courts and federal courts. In the UK, infringement and validity are dealt with in a single case; it is common for a defendant in a patent case concerning infringement to use as their defence the argument that the patent in question is invalid. Judges in the UPC will have discretion over whether to bifurcate cases; this means that it is hard to predict the impact of bifurcation on case load. Where validity is raised as defence to an infringement case it is possible that the case would be bifurcated, with infringement proceedings taking place in the local division and validity proceedings taking place in the central division. Where a bifurcated case was not related to life sciences, pharmaceuticals or chemistry the revocation proceedings would not go to the UK central division.

Cost to Government

The eventual aim is for the UPC to be self-funding from court fees to cover costs. However, at least initially, this will not be possible and there will be a significant shortfall until the Court receives enough income from fees to balance its costs. This shortfall will be covered by contributions from the participating Member States during a transition period of 7 years from the date of entry into force of the Agreement. The costs to be covered by Member State contributions will comprise primarily salaries for judges and other staff, staff training, legal aid, administration costs, and facilities costs for the Court of Appeal and Registry. After the initial 7 year period if there is a shortfall then contributions have to be made by participating Member States in accordance with the scale for the distribution of annual renewal fees for Unitary Patents.

We are not yet able to accurately estimate the size of the UK contribution as the exact costs and the formula for calculating Member State contributions are still to be decided by the participating Member States. It is expected that these details will be finalised during 2014.

Work has begun on estimating the likely costs to the UK of the UPC, however until further details are known, such as the level of court fees and salaries, it is difficult to predict the level of contribution that will be required from the UK during the transition period.

In addition to contributing to the central budget of the Court, the host state is expected to pay the facilities costs of hosting divisions of the Court. As already stated, the UK will host part of the Central Division of the UPC that will deal with validity cases in the field of chemistry (including pharmaceuticals) and life sciences. It is also assumed that the UK will host at least one local division that will deal with infringement actions in all fields of technology. Facilities costs associated will likely include the cost of the premises (i.e. court rooms), IT & video-conferencing equipment, and interpretation facilities. In addition, the Government will bear the cost of the administrative staff required to operate the division during the transition period of 7 years from the date of entry into force of the Agreement. We will be better able to estimate these costs once we know how many divisions will be hosted in the UK, where the court rooms will be sited, and once IT systems have been procured.

⁶ Cremers,K., et al, 2013, *Discussion Paper No. 13-072: Patent Litigation in Europe*, (September 2013) http://ftp.zew.de/pub/zew-docs/dp_dp13072.pdf

Impact on Ministry of Justice/HMCTS

A detailed explanation of the possible impacts on HMCTS is covered in the accompanying Justice Impacts Test, this can be found in Annex B.

Benefits of Option 2

Lack of duplication

One of the features of the current system that demonstrates the relative difficulties of litigating in Europe compared to that of other jurisdictions of a similar market size – such as the US or Japan – is that some disputes over the same patents are litigated in multiple jurisdictions. For example, Cremers, et al (2013) report that:

"In UK and the Netherlands we find a relatively high number of cases that are litigated in several jurisdictions (26% and 15% of all cases litigated in the UK and the Netherlands respectively)."

The report also suggests that those cases which are duplicated are likely to be "more important" and also "more resource-intensive".⁷

Under the current system, legal proceedings for the revocation of a European patent could take place in several countries. When the UPC starts operations, patents granted by the EPO will be subject to a single set of litigation covering all of the territories that the patent covers. This reduces the need for duplicated litigation.

Lack of duplication - Legal fees

The largest cost to litigants of going to court – aside from damages – is the cost of legal fees. In the UK, it is common for the successful party to be paid some or all of their costs by the losing party. Although many reach a private settlement after the decision on the case, sometimes the case will go to a costs hearing – meaning that these costs are then made public. Helmers and McDonagh (2012) find that:

"Most cases that ended with a judgment, and for which we have data, report total costs in the region between £1million and £6million."⁸

Helmers and McDonagh acknowledge that the level of costs in the UK is generally considered to be higher than in other European countries.

The prospect of only incurring such legal fees once, rather than in multiple States will offer claimants and defendants savings.

Lack of duplication - Court fees

Court fees are generally a less significant burden than legal fees for users. The level of court fees varies across different European jurisdictions.

⁷ Cremers,K., et al, 2013, *Discussion Paper No. 13-072: Patent Litigation in Europe*, (September 2013) http://ftp.zew.de/pub/zew-docs/dp_dp13072.pdf

⁸ Helmers, C. and McDonagh, L., 2012, *"Patent Litigation in the UK"*, LSE Law, Society and Economy Working Papers 12/2012, London School of Economics and Political Science, Law Department, (available at http://papers.ssrn.com/sol3/papers.cfm?abstract_id=2154939)

In the UK, civil courts charge variable fees according to the value of the claim or the complexity of the case⁹. Court fees in other countries differ, for instance, Spain, France and Luxembourg operate on a no-fee basis. Currently, the most popular countries for validation of a bundle patent are Germany, France and the UK. The majority, nearly 70%, of bundle patents are validated in the UK¹⁰. For UK-based applicants for bundle patents Germany, France, the UK and the Netherlands are the most popular countries for validation¹¹. Therefore, it is likely that UK companies would litigate in these countries as well as the UK. We cannot say how litigation in these four states may compare to potential UPC court fees until UPC court fees are decided.

Nonetheless, we can provide some direct comparisons of current court fees across Europe. As a point of reference to demonstrate the variety in level of court fee in different countries, Table 1 from a study conducted by the EU Commission DG MARKT (2011)¹² provides a comparison of fees where the value of a dispute is approximately €100,000. This is not necessarily a typical value for patent cases, and is purely intended to illustrate the different court fee levels in European countries.

Table 1 – Comparison of court fees across a selection of European countries

Country	Value of dispute (€)	Fee (€)	Comments
Austria	72,670 to 145,350	2,518	1st Instance fee
Germany	110,000	856	
Italy	52,000 – 260,000	500	
Lithuania	100,000	1,000	Fee = 1% of value
Slovakia	100,000	6,000	Fee = 6% of value
UK	100,000 (£83,241.01)	704	
Netherlands	100,000	1,745	
France	N/A	0	No fees for patent litigation.
Spain	N/A	0	No fees for patent litigation.
Luxembourg	N/A	0	No fees for patent litigation.

Judgments that give confidence, consistency and certainty for court users

One of the inefficiencies of the current system is that due to the different legal traditions in Europe there can be different outcomes to cases concerning the same patent in different countries. An infringement may be found in one country, but the validity of the patent may be called into question elsewhere. In some countries, it may be more likely that the patent may be amended than in others where it may simply be revoked. Research by Cremers et al (2013)¹³ finds inconsistency in outcomes of cases between various jurisdictions. For example, the most likely outcome of a case decided by a judge in France is ‘no infringement’ whereas UK courts predominantly revoke disputed patents.

Another feature of the fragmented system of enforcement is the variation in the length of time it takes for a patent case to be heard in different European countries, Cremers et al (2013)¹⁴ show:

“...the median duration of an infringement case is shortest in Germany (9.2 months), followed by the Netherlands (9.8 months), and the UK (11 months). Infringement cases take a lot longer in France (19.8 months). Invalidity actions take a lot longer to decide in Germany (15 months) than in the UK (11.2 months) and the Netherlands (11.4 months). Again, invalidity cases in France take significantly longer (19.8 months) than in any other jurisdiction.”

9 For example, fees for making a money claim depend on the amount claimed, the lowest money claims (up to £300) incur a charge of £35, whereas for the highest money claims (over £300,000) the fee is £1670. A separate hearing fee of £1090 would also be charged, along with some administrative charges (court fees can be found at <http://hmctsformfinder.justice.gov.uk/courtfinder/forms/ex050-eng.pdf>). If further proceedings are required, for example for a costs hearing or for appeal, there are additional fees. The Ministry of Justice is currently reviewing court fees (<https://consult.justice.gov.uk/digital-communications/court-fees-proposals-for-reform>) so these figures may change.

10 Data provided by the EPO to the Select Committee on November 7, 2014. The Netherlands is the fourth most popular country for validation of bundle patents with 25% of all bundle patents being validated there.

11 Data from internal IPO analysis of PATSTAT data of UK based applicants for bundle patents in the 25 member states from 1980 to 2011.

12 DG Internal Market and Services, 2011, Study on the Caseload and financing of the Unified Patent Court

13 Cremers,K., et al, 2013, *Discussion Paper No. 13-072: Patent Litigation in Europe*, (September 2013) http://ftp.zew.de/pub/zew-docs/dp_dp13072.pdf

14 Cremers,K., et al, 2013, *Discussion Paper No. 13-072: Patent Litigation in Europe*, (September 2013) http://ftp.zew.de/pub/zew-docs/dp_dp13072.pdf

This means that litigating in different jurisdictions in Europe creates uncertainty over outcome, time spent waiting for judgments in different jurisdictions and the expense of both court fees and legal fees. A key benefit for users of the UPC will be that the decision reached regarding a Unitary Patent will be enforceable across all Signatory States. A single court, with a harmonised set of Rules of Procedure provides confidence that a judgment made in one division of the Court would apply equally in another division. Currently, whilst patents are granted by the EPO against the same criteria, when they are taken to national courts the slight differences in legal tradition and interpretation of national laws mean that verdicts on infringement or validity of the same patents are not always consistent. For example there is potential for a patent to be found valid in one State, but not valid in another, or subject to amendments somewhere else. The UPC offers the benefit of having a single judgement valid in multiple states leading to a reduction in the variation of outcomes experienced in the current system. This, coupled with EU-wide relief, is a significant benefit to those involved who desire certainty. The UPC offers both a court of first instance and a Court of Appeal. The Appeals process will also guarantee a further level of confidence in the rulings of the UPC.

Benefits of hosting the Central Division in London

The London-based Central Division will deal with validity actions relating to all European patents and Unitary Patents in the pharmaceuticals and life-sciences sectors as well as SPCs based on those patents. The pharmaceutical sector is one of great importance to the UK. HM Government (2012)¹⁵ report that this technology sector has a turnover of over £30 billion and employs almost 70,000 people in the UK. It is thought that having a specialised division of the UPC based in London will be a significant benefit to this relatively strong UK technological centre.

Cases relating to Supplementary Protection Certificates which are based on Unitary Patents or European bundle patents would be heard by the UK central division when involving revocation and, as outlined above, sometimes infringement. This should mean the retention of business for UK law firms, and possibly additional cases.

The British legal sector is a significant contributor to the UK economy. According to the joint Ministry of Justice and UK Trade and Investment report published in May 2011, “Plan for Growth: Promoting the UK’s Legal Services Sector” legal services generated approximately “£23.1 billion or 1.8% of the UK’s gross domestic product in 2009 and constituted £3.2 billion in exports”¹⁶. A recent estimate of current revenue for UK legal firms as a result of patent litigation was provided in a report commissioned by the Intellectual Property Lawyers’ Association (IPLA) in May 2012 where it was estimated that total fee income in 2011 was £166 million¹⁷.

We anticipate that the UK Central Division will hear cases concerning pharmaceuticals and life sciences that currently do not come to UK courts and do not involve UK claimants or defendants. This will bring benefits to UK legal firms as they are likely to receive additional business. The overall benefit of this to UK GDP depends on whether users of UK law firms are from outside the UK and paying for litigation using funds from outside the UK. If a company litigating in a UK division of the UPC pays their legal team from their UK budget this would not represent a benefit to UK GDP. Where UK-based companies use UK-based lawyers this is simply a transfer of costs so would be treated as no net cost or benefit to overall UK GDP.

There will be some revocation cases which are dealt with in UK courts at the moment that do not concern life sciences, this means that in future these cases would be heard in either Paris or Munich. This may represent a loss of some business for UK legal firms.

Evidence from Cremers et al (2013)¹⁸ suggests that the split of specialist technologies of the Central Divisions reflects the spread of the types of cases going through the national courts at present; “*The most striking difference is the share of cases involving chemical/pharmaceutical patents heard by the PHC [Patents High Court] in the UK and the regional courts in Germany (31% compared to 19%). The share of patents in mechanical engineering is relatively large for Germany (33%) and the Netherlands (38%)*”. As discussed earlier, this suggests that potentially between 2000 and 2008 228 cases held in Germany, France and Netherlands dealt with validity of patents in life-sciences sector.

15 https://www.gov.uk/government/uploads/system/uploads/attachment_data/file/36736/12-p90-strength-and-opportunity-2012.pdf

16 <http://www.justice.gov.uk/downloads/publications/corporate-reports/MoJ/legal-services-action-plan.pdf>

17 <http://www.citysolicitors.org.uk/attachments/article/115/20121019-UPC-location-report-version-for-publication-30-May-2012.pdf>

18 Based on cases heard between 2000 and 2008 - Cremers,K., et al, 2013, *Discussion Paper No. 13-072: Patent Litigation in Europe*, (September 2013) <http://ftp.zew.de/pub/zew-docs/dp/dp13072.pdf>

Cremers et al go on to suggest that more recently, the spread of cases heard in the UK may be shifting as 2012 showed a greater proportion of cases relating to patents in the ICT sector which under the UPC would go to the Paris division.

The Central Divisions will also handle infringement cases from contracting states that do not have their own local division and are not part of a regional division.

The IPO is commissioning research to obtain more up to date figures relating to the level of litigation in the pharmaceutical and life-sciences sector in order to gain some form of estimate as to the potential caseload of the central division. Overall though, it will be hard to give an accurate prediction as we cannot at this stage be certain about the extent to which UPC judges will choose to bifurcate a case.

Benefits of hosting a local division

The benefits of hosting a local division in the UK may be less significant than those of hosting a central division which is anticipated to bring new business to the UK.

We anticipate that there will be a transfer in caseload from UK courts to the UPC (for cases concerning infringement, which would be heard in a local division), and so it is less likely that this would bring *new* business to the UK legal sector. Therefore, we would not expect to see any loss of income for the UK legal sector.

For those who are defendants in the UK, the local division is important, because if an infringing action is alleged to have taken place in the UK the case would be heard in the UK rather than overseas. Whilst this may not immediately suggest it is a benefit (especially as we cannot describe the level of fees as yet) it does mean that defendants based in the UK have a local court that can be used, rather than needing to use a court overseas.

There is a risk that those alleged to have infringed a patent in multiple UPC states will have to travel to a court of first instance that is not in the UK to defend themselves, possibly incurring travel costs. However, it is fair to assume that if the alleged infringement were taking place in multiple states under the current system, the defendant would still be required to travel abroad to a court in a different jurisdiction.

Reduced translation costs

There may be some cost saving to UK businesses from a reduction in the need for the services of translators. This is due to the fact that the need to litigate in multiple national courts - which is always conducted in the local language – is reduced in the UPC where the case is only litigated once. This could be offset by those UK businesses party to litigation in divisions of the court outside of the UK, for example in either Germany or France (in validity cases at the Central Division); or elsewhere in Europe for infringement cases (at a local or regional division). Furthermore, if a case progresses to an appeal, the Court of Appeal may hear the case in a different language to the one used in the Court of First Instance.

Wider impacts

Impact on Innovation

In the long term, there may be a boost in innovation. The UPC and Unitary Patent will create a single market for patents across Europe. By reducing internal trade barriers there may be inward investment into Europe which could stimulate more research and development within the UK.

The Impact Assessment of the Unitary Patent completed by the European Commission in 2011 highlights the way that patents interact with knowledge. Patenting represents a trade-off between receiving a state-granted limited monopoly right and disclosure of the invention. It is through the requirement for disclosure that knowledge gets disseminated, and through the limited exceptions to infringement that competitors can investigate the invention. In the long run this means that competitors have the potential to build new innovations upon the initial patented invention. This brings wider benefits to the state, and the general public. The Commission's study into impacts suggests that this may become stronger with the introduction of the Unitary Patent and the Unified Patent Court.

We think that direct impacts on innovation in the UK may be small and would not expect to see any change in the level of patenting (aside from current trends) in the UK because the vast majority of European bundle patents are validated in the UK already (70%).¹⁹

Impact on SMEs and micro-entities

Intellectual Property applies to all companies irrespective of their size, and is an optional right for businesses to hold. The UPC and Unitary Patent is available for SMEs to use. There is no micro-entity exemption for this measure.

There are discussions at international level over the fee structure for SMEs. Article 36 of the Agreement makes reference to finding “the right balance” between “fair access to justice” and “the objective of a self-financing Court with balanced finances”²⁰. At the moment it is unclear how this will be interpreted, but it could mean lower fees for SMEs. It is also envisaged that there will be some form of assistance available through the court’s legal aid budget – this will be limited to natural persons, so may be relevant to micro-entities.

Risks and assumptions

The proposed changes to the Patents Act on jurisdiction will only come into effect when the Unified Patent Court Agreement comes into force. This requires UK ratification. The changes are therefore proposed based on the assumption that the UK will ratify the agreement.

The UPC will open three months after the UK, France and Germany, plus ten other states have ratified. This IA makes the assumption that the sufficient states will ratify for the Agreement to come into force.

It is also assumed that the necessary changes are made to the Brussels I Regulation (Regulation (EU) No 1215/2012) prior to ratification.

It is not clear which states will make up this initial ten states, it is possible that this will have a bearing on whether holders of European bundle patents choose to opt out, especially depending on the value of the market in these states.

¹⁹ Recent figures provided by the EPO indicate 70% of bundle patent are validated in the UK. Early estimates, suggest this number is higher (75%), as in Harhoff, Dietmar & Hoisl, Karin & Reichl, Bettina & van Pottelsberghe de la Potterie, Bruno, 2007. “Patent Validation at the Country Level - The Role of Fees and Translation costs,” Discussion Papers in Business Administration 2073, University of Munich, Munich School of Management:

“In 2003, 95% of all patents granted by the EPO were validated in Germany (DE), 80% were validated in France (FR), and 75% in the United Kingdom (UK). Generally, smaller countries seem to be less attractive (i.e., the share of patents validated is smaller than 40%).”

²⁰ <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:C:2013:175:0001:0040:EN:PDF>

Summary and preferred option

Table 2 below sets out the costs and benefits to the main parties. It should be noted that there are expected to be running costs initially for the Government, but the UPC is envisioned to be self-financing in the long-term.

Table 2 – Summary of costs and benefits on main parties

	Benefit	Cost
Businesses	<p>Only need to go to court once. Savings in terms reduced duplicated court, legal and translation fees.</p> <p>Once the court is established there will be certainty in its decisions.</p>	<p>Uncertainty over court and legal fees under UPC.</p> <p>Uncertainty during transition period.</p>
Legal Services	Potential for more foreign litigants using UK legal services.	Potential for cases that leave UK to stop using UK lawyers, or increased travel costs if services are retained.
Translators	Potential for new business if assisting those UK businesses that now have case heard in another country.	Less business as the need to litigate in multiple courts - always in the local language - falls.

The preferred option is Option 2. By making changes to the Patents Act, we can ensure that it is clear on the face of the law that the UPC has competence over Unitary Patents and European bundle patents. This will pave the way for UK ratification of the UPC Agreement which is essential for the new system to come into force thus meeting the policy objective of offering more streamlined pan-European enforcement of patent rights.

As noted, during the transition period there is choice over whether to take part in the system. During transition, owners of bundle patents will have the opportunity to choose whether to use the UPC or whether to litigate in domestic courts, and they will also have the ability to opt out their patent from its jurisdiction for the lifetime of the patent.

The UPC offers litigants in patent cases the chance to resolve a dispute in a single court, and will give decisions which are enforceable in multiple contracting states. This will mean that users of the UPC will not face the costs currently required if litigating in multiple national court systems. Going to the UPC will also mean that users do not have to navigate multiple, differing, court systems which may give different judgments and take different lengths of time to reach decisions. Once the UPC is fully established it will instead provide consistent judgments across its jurisdiction (based on uniform training of judges and a single set of rule of procedure), it will develop its own precedent through referrals to the UPC's own Court of Appeal.

Direct Costs and Benefits to Business Calculations (following OITO methodology)

The proposed legislative changes are exempt from the “One In Two Out” rule as the proposal is a result of an international treaty.

Evaluation

The UPC Agreement will be reviewed after 7 years, or 2000 cases (whichever is first). As set out in Article 87 of the Agreement there will be a broad consultation with users about the functioning of the UPC. Depending on the outcomes of this review, the details of the Agreement may be reconsidered by the Contracting Member States of the Agreement within the governing body of the Court.

Annex A – Glossary

Glossary of terms:

Bifurcation

The questions of infringement and validity are separated and decided in separate actions.

Bundle patent

One of the national patents created following the grant of a European patent in the current European patent system – one bundle patent for each country designated by the applicant. In UK patent law, this is referred to as a European patent (UK).

Claim

A statement in a patent specification which legally defines the scope of protection for that patent – the area in which third parties cannot operate without infringing the patent.

Description

The part of a patent specification which outlines the technical detail of the invention, to allow a reader to understand that invention and be able to put it into practice.

Enhanced cooperation

A special procedure for a group of Member States within the European Union to make progress on more closely together within the structures of the European Union, in circumstances where not all Member States can agree on how to achieve an objective within the competence of the Union.

European Patent Convention (EPC)

An international agreement, signed in 1973 and substantially revised in 2007, which establishes the European Patent Office and sets out the operation of the European patent system. The Convention presently covers 38 countries, including nations which are not members of the European Union.

European Patent Office (EPO)

An international organization set up under the EPC, which administers the European patent system.

Infringement

When an act is performed without the consent of the patent owner, which is one which is within the exclusive domain of the patent owner, and for which there is no exception.

Intellectual Property Enterprise Court

Formerly the Patents County Court, it is in the Chancery Division of the High Court and deals with disputes relating to intellectual property, particularly those involving small and medium enterprises, where the overall value of the claim is relatively low.

Intellectual Property Office (IPO)

An executive agency of the Department for Business, Innovation & Skills, the IPO is the government body responsible for the national framework of intellectual property rights, comprising patents, designs, trade marks and copyright.

The London Agreement

An agreement associated with the EPC, which came into force in 2008 and relaxes the translation requirements for granted European patents, therefore reducing the associated costs.

Opt out

A provision in the Unified Patent Court Agreement which allows patent holders during the transition period to withdraw their patent (or Supplementary Protection Certificate) from the jurisdiction of the Unified Patent Court so that they remain in the jurisdiction of the national court for the life of the patent (or SPC), although they can be opted back in at any time.

Preparatory Committee

A group of representatives from the countries signed up to the Unified Patent Court Agreement, charged with setting up the Court, including establishing rules of procedure, identifying facilities, recruiting and training judges and administrative staff, amongst other responsibilities.

Renewal fee

A fee paid to by a patent owner to the patent office or other relevant authority in order for the patent to remain in force.

Revocation

The court or the relevant patent office can deem the patent (or the relevant part) never to have been granted if they are not valid.

Select Committee

A special committee of the EPO Administrative Council, established by the Unitary Patent Regulations, and charged with ensuring the EPO is able to carry out the various tasks given to it under the Unitary Patent Regulation.

Specification

The combination of the description, claims, and associated diagrams.

Supplementary Protection Certificates (SPCs)

These are provided for in European Union Regulations²¹ and extend the period of legal protection afforded to medicinal and plant products beyond the life of the patent relating to them for up to 5 years and 6 months.

Transition period

A period of 7 years (which may be extended by up to another 7 years) during which patent owners may continue to bring actions for infringement and validity of bundle patents and SPCs based on bundle patents before national courts. They can also choose to opt out a bundle patent or SPC from the jurisdiction of the Unified Patent Court during the period.

Unified Patent Court

International court, set up by the Unified Patent Court Agreement, which has exclusive jurisdiction over Unitary Patents when deciding issues of validity, infringement, and revocation.

Unified Patent Court Agreement

International agreement, signed by 25 countries in February 2013, which establishes the Unified Patent Court.

Unitary Patent

A single patent valid in all the countries signed up to the Unitary Patent Regulation; European bundle patents covering the same area are converted into a Unitary Patent after grant, upon request of the patent holder.

Unitary Patent Regulation

European Regulation 1257/2012, which sets out the goals and basic operation of the Unitary Patent, as well as the obligations of Member States signed up to the Regulation.

Validity

An action to determine whether a patent, or specific claims in the patent, should not have been granted because they did not meet the legal requirements at the time. Often used as a defence against infringement, since you cannot infringe a patent that is not valid.

²¹ Regulation (EC) No 469/2009 and Regulation (EC) No 1610/96

Annex B – Justice Impact Test



Justice impact test form

Before you complete this form, please read the Justice Impact Guidance. It is available at:
<http://www.justice.gov.uk/guidance/justice-impact-test.htm>.

Please answer as many questions as possible on this form before you contact Ministry of Justice (MoJ). If exact figures are not yet known, please provide your best estimates.

Forward the completed questionnaire, with any Impact Assessment, to MoJ's Legal Policy Team at:
justiceimpact@justice.gsi.gov.uk.

1. Your contact details

Name	Katherine Evans
Department / office / business area	Unified Patent Court Taskforce / Intellectual Property Office
Telephone number	01633 813637
Email address	Katherine.Evans@ipo.gov.uk Laura.Starrs@ipo.gov.uk
By when would you like a response?	
Is this proposal marked 'Restricted'? <input checked="" type="checkbox"/> Yes <input type="checkbox"/> No	

2. General information

Ministry of Justice Policy/Operational lead if known.

Eleni Skaliotis Analytical Services 0203 334 5130

In brief, what is your proposal?

This proposal has come about because the UK is a signatory of the Unified Patent Court Agreement. We intend to make changes to UK law (specifically to the Patents Act 1977) so that the UK is in a position to ratify the Unified Patent Court Agreement in 2015. The changes will mean a transfer of jurisdiction from UK courts to the Unified Patent Court in patent cases involving disputes over infringement and validity of either a European Patent designating UK, or a unitary patent (note - this does not affect national (GB) patents). Our changes to the Patents Acts will specifically remove powers from UK courts to deal with these kinds of disputes. Disputes concerning entitlement to a patent, or the licensing of a patent will still be dealt with in domestic courts. Supplementary Protection Certificate (SPC) infringement and revocation cases based on unitary patents will go to the Unified Patent Court as will SPCs based on European bundle patents that have not been opted out.
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What is your proposal intended to achieve, over what geographical area (e.g. England, England and Wales) and in what timescale?

The Unified Patent Court Agreement has been signed by 25 European Sovereign States that are Members of the EU. This means that the Agreement is an international treaty, rather than EU law. The Unified Patent Court is a Court of First Instance and has its own Court of Appeal.

The Unified Patent Court offers those holding European bundle patents and those holding unitary patents the ability to enforce their patent across a broader jurisdiction than has so far been possible. Currently, litigating across Europe can be a prolonged process with little certainty over outcomes across different jurisdictions. The application process for a European patent is consistent through the European Patent Convention signed in 1973 and the first applications were filed at the EPO in 1978. What results from this single application process is a bundle of patents each valid in only one country rather than a single patent covering the whole of Europe. Across Europe there is a lack of consistency in what happens when disputes arise concerning this bundle of European patent.

The courts of different European states can interpret a case differently, and will also take different lengths of time to resolve it. A dispute over a European bundled patent with the same claims may result in inconsistent outcomes across states – perhaps being revoked in one country, amended in another and yet found to be valid somewhere else. In part, this is because of the differing ways in which legal traditions around Europe operate, and perceive their role to be. For some, this uncertainty will mean that they are prepared to take their case to other jurisdictions in Europe in order to test the outcome and possibly reach another ruling, however this is a costly and uncertain strategy.

The Unified Patent Court will give a single ruling covering all countries where a bundle patent is valid; or for a unitary patent, the decision will be valid across all signatory states that have ratified the Agreement.

Our proposal will cover England, Wales, Northern Ireland and Scotland - we have regular contact with the Devolved Administrations. We have also been advised by the Government of the Isle of Man that they would like the UPC and unitary patent to extend to their territory and we are working with them on this issue. We are consulting the other Crown Dependencies and are yet to receive confirmation from them about whether they want the Agreement to extend to their territories.

The Preparatory Committee for the Unified Patent Court has set a deadline for the Court to be ready to open in early 2015. In order to make the necessary changes to the Patents Act we intend to lay secondary legislation in autumn 2014, and the changes will commence from the point that the 13th Signatory State (including the UK, France and Germany) has ratified the Agreement.

What public commitments have been given and to whom?

The Prime Minister negotiated key concession on this Agreement in June 2012. The Secretary of State for Business signed the Agreement in February 2013. We have told stakeholders that we anticipate ratifying the Agreement in early 2015.

What are the options under consideration?

- a) to ratify the agreement and ensure that the Unified Patent Court has a local division and a central division in the UK, giving people access to this new court with a wider jurisdiction.
- b) do not ratify the Agreement, meaning that the current situation remains the only way for patent holders to litigate in Europe.

How does the proposal change what happens now? Who will be affected and in what numbers?

The changes will affect holders of European Patents who may have to go to the Unified Patent Court rather than national courts to litigate their patent. The changes will also introduce the unitary patent; the only instances where a holder of a unitary patent would go to a UK court would be if they had a dispute over entitlement or licensing.

It is not possible to accurately predict how many European Patents currently litigated at the UK courts will transfer to the Unified Patent Court. Levels of litigation involving EPO bundle patents and Unified Patents will depend on unknown factors such as the uptake of Unitary Patents and how many patent owners choose to switch from EPO bundle patents to the Unitary Patent. Furthermore, the Agreement also includes a 7-year transition period (which could potentially extend to 14 years) where a European (bundle) patent holder may register an 'opt out' meaning that their bundle of European patents would remain within the jurisdiction of the national courts. The opt out is valid for the lifetime of the patent - up to 20 years - although patent holders do have the ability to withdraw their opt out.

To give a sense of scale of how many cases could transfer from the UK courts to the UPC in the steady state (after the transition period), we take as our starting point the number of cases commenced at the Patent High Court in 2007-2012. We assume that once the choice to opt out EPO bundle patents from the UPC's jurisdiction has lapsed, all EPO bundle patents currently heard at the national courts will transfer to the UPC, resulting in a reduced caseload for HMCTS.

To estimate cases commenced at the Patent High Court (Chancery Division), we draw on research commissioned as part of the IPO Evaluation of the Intellectual Property Enterprise Court (IPEC) and evidence collected by the Intellectual Property Lawyers' Association (IPLA). Both pieces of research have involved researchers and paralegals going directly into the Court Archives to count cases commenced. The research has been supported by some of the leading judges in this field. Their data suggests that:

Year	Cases Commenced	Source	
2007	38	IPO IPEC Evaluation	111
2008	71	IPO IPEC Evaluation	111
2009	39	IPO IPEC Evaluation	130
2010	Not available yet	IPO IPEC Evaluation	65
2011	86	IPLA	183
2012	88	IPLA	Not available

We do not know for all years how many cases involve European Patents. IPLA find that in 2011, 46 claims (53% of cases filed) and in 2012 69 claims (78% of cases filed) involve European Patents.

Forecasting expected caseload at UPC: 28-86 cases could migrate from national courts to UPC
Given the variability in case filings, dropping from 71 cases in 2008 to 39 cases filed in 2009, we undertake a scenario analysis to predict high and lower estimates of caseload at the UPC in the steady state. To do this we vary by 50% the 2012 caseload estimate (88 claims):

- Lower scenario: Caseload in the steady state could be as low as 44 cases (0.5×88)
- High scenario: Caseload in the steady state could be as high as 132 cases (1.5×88 claims)

If we assume that approx 65% of cases filed involve European patents (based on data supplied by IPLA in 2011 and 2012), we estimate that between 28 (0.65×44 cases filed) and 86 (0.65×132 cases filed) cases commenced involve European patents in the steady state. These could migrate from the national courts to the UPC. On advice of MoJ Analytical Services, this analysis assumes cost recovery of cases. On this basis we assume that a reduction in caseload would not adversely affect HMCTS costs.

Caveats:

- IPO and IPLA data on patent cases commenced at the PHC are consistently lower than HMCTS records of cases filed. We do not think that these inconsistencies are a sign of error as HMCTS records include both patent and design cases filed, whereas IPO and IPLA data are on patents only.
- Some of these claims will involve more than one European Patent and not all claims initiated go through to a final judgement. IPLA suggests that 54% of the claims commenced in 2011 and 57% of cases initiated in 2012 were listed for a hearing. Only 44% of 2011 cases and 42% of 2012 cases were listed for trial.
- Not all cases involving European patents are heard at the PHC. Cases commenced at the Intellectual Property Enterprise Court (IPEC) are not captured in our estimates. This is unlikely to bias estimates down significantly however, as preliminary evidence from the IPO-commissioned IPEC evaluation suggests only 20-30 cases at IPEC in 2011 and 2012 relate to patents.

3. Criminal Offences and Civil Penalties and Sanctions

Are you creating new civil sanctions, fixed penalties or civil orders with criminal sanctions or creating or amending criminal offences?

No

Please provide details of the relevant legislation (where appropriate) and confirm whether the creation or amendment of criminal offences and penalties has been agreed with MoJ.

-

4. HM Courts & Tribunals Service

Increasing Business for the Courts and Tribunals

Do you expect there to be an impact on HM Courts & Tribunals Service through the creation of or an increase in applications/cases? Please provide an estimate.

We anticipate a reduction in applications or cases.

Would you expect fewer cases to come to HM Courts & Tribunals Service as a result of the proposal?

Please provide an estimate of the number of cases.

We anticipate a reduction in claims and cases. As described above this is hard to quantify, but depending on overall trends in patent litigation, there may be a reduction of 20-110 claims at the High Court when the court reaches a steady state.

This is based on the information received from IPLA which showed that in 2011, 46 claims concerned European patents, and in 2012 69 claims did. Our estimates are based on a scenario analysis that assumes claims filed can vary by as much as 50% from the 2011/12 figure. The 50% variation is informed by a drop in caseload from 71 cases filed in 2008 to 39 cases filed in 2009. We furthermore assume that approx. 50-80% of cases filed involve European patents based on IPLA data from 2011 and 2012.

All estimates are for the steady state only. In the transition phase of 7-14 years after the UPC takes effect, patentees can opt their European Patent out of the UPC's jurisdiction. As little is known about opt-out behaviour at this point, we only provide estimates for the steady state. However we expect that the transfer of caseload from the national courts to the UPC is lower in the transition phase as patent holders may take time to develop confidence in the court and feel comfortable using it.

We also assume there is no large-scale switch from European patents to national patents which would retain all cases within the national courts.

We have not made an estimate of claims that would transfer out of the Intellectual Property Enterprise Court at this stage as we are awaiting more recent information from the IPO-commissioned Evaluation of said Court. The evaluation is meant to deliver final results in spring 2014.

Appeal Rights

Does your proposal create a new right of appeal or route to judicial review? If so, how will these be handled (i.e. by HM Courts & Tribunals Service)?

Appeals will be handled by the Unified Patent Court's own Court of Appeal.

Do you expect to establish a new tribunal jurisdiction? If so, has this been discussed with HM Courts & Tribunals Service?

No.

Alternative Dispute Resolution

Has the use of alternative dispute resolution (ADR) procedures (including mediation) been considered?
If not, why not?

There will be a mediation and arbitration service provided within the Unified Patent Court; the Rules of Procedure for the UPC make provisions for judges to direct the parties to use mediation or arbitration before proceeding to a hearing.

HMCTS Enforcement

Will the proposal require enforcement mechanisms for civil debts, civil sanctions or criminal penalties?

The Unified Patent Court does not have the jurisdiction to enforce civil sanctions. As civil sanctions are dependent on where assets are held we do not expect there to be much change from the current level of enforcement relating to patents cases brought in the UK.

HMCTS Procedural Rules, Sentencing and Penalty Guidelines

Do you anticipate that Court and/or Tribunal procedural rules will have to be amended? If so, when is the likely date for the changes?

No.

Will the proposals require sentencing and/or penalty guidelines to be amended?

No.

5. Legal Aid

Is your proposal likely to have an impact on the Legal Aid fund?

No - the Unified Patent Court has its own Legal Aid fund and procedures.

If legal aid may be affected, will (i) criminal, or (ii) civil and family, or (iii) asylum legal aid be affected?

N/A

If legal aid may be affected, would legal aid costs increase or be reduced (and by what margin)?

N/A

6. Prisons and Offender Management Services

Will the proposals result in an increase in the number of offenders being committed to custody (including on remand) or probation (community sentences)? If so, please provide an estimate and reasoning behind it.

No.

Will the proposals result in an increase in the length of custodial sentences? If so, please provide details.

No.

Will the proposals create a new custodial sentence? If so, please provide details.

No.

What do you expect the impact of the proposals on probation services to be? Please give explanation/calculations.

No impact.

7. Summary

Who will be affected by this proposal in MoJ? (details from information provided above)	Volumes	Type (e.g. prison place, tribunal hearing, fixed penalty, etc.)	Estimated costs (£)
Criminal Offences and Civil Penalties and Sanctions	N/A	N/A	N/A
HM Courts & Tribunals Services	Reduction of between 28 and 86	Reduction in hearings	zero
Legal Aid	N/A	N/A	N/A

Prisons and Offender Management Services (only complete if maximum penalty is something other than a fine)

Offence	Maximum Penalty	No. of prosecutions brought per annum	Likely conviction rate	Likely sentence
N/A				

Your completed questionnaire will be considered by MoJ to establish whether the proposals will have an impact on the aspects of the justice system for which MoJ has responsibility. If there are considered to be no impacts arising from your proposals, MoJ will agree this with you and you must record this in the Impact Assessment accompanying your proposals. However, if MoJ identifies a potential impact, MoJ will contact you to discuss and agree an estimate of costs including funding arrangements for the additional costs.

If you have any queries about this form, please e-mail justiceimpact@justice.gsi.gov.uk or telephone Pavandip Gandam on 020 3334 5339.

Annex C – structure of the UPC

