ש. הורוביץ ושות'
עורכי דין, נוטריונים, עורכי פטנטים

רות אורן
היו קוברסקי
עזגד שטרן
יהושע חורש
אלקס הרטמן
טל בנד
שושנה גביש
אהוד ארצי
אנטוני בלוך
אבי אורדו
אביגיל קסטיאל
אמיר כספרי
קליפורד דיויס
אליה צונץ
מיכל ליברמן
חגי דורון
רן פוגל
בנימין שפר
מרדכי מלכה
ליאור נימין
אורית יולס-דבי
אייל דורון

ד"ר אסף רנצלר
פיליפ וולדקס
עמית שטיינמן
פנינה שפר-עמנואל
רונן ברומר
גיא פירר
דובב אפל
אופיר פוזנר
ערן בצלאל
יהודית שויגר
מיכל זלצמן
צהלה הורמן
אופיר קפלן
אודליה דנוך-שלום
מורן כ"ץ
נועם בליי
יפעת שקדי-שץ
קית' שאו
אוהד בן-יהודה
שירלי קציר
ענת גרימלנד
ליאור מימון

אוריאל פרינץ
שי גימלשטיין
אביתר אזולאי
ליאל גולני
גלעד זבידה
עינת מיטל
רן פלדמן
גל וינגולד
פרח רוסלר
טל רוזנר
ליאור מלר
גיא ורטהים
נועה גלזר-בכר
שלומי דלג'ו
גלעד כ"ץ
שי שטרן
יפה אלישקוב
שרון אבניאלי
איילת בן-גיגי
שי אבניאלי
טרודי דויטש
משה כהן

עומר כרמל
רונן מנשה
רן קמיל
לילך דנביץ'
סיון מאור
אילן מילר
ניר נורדן
גילי רגב
ארז אלקון
יואב גרוס
יאיר זיו
נועם זמיר
גיתית לוין גרינברג
לנה ערמון
יעל רוזנברג
עמיאל רז
עירית ריין-זיו
אורי אנטמן
לי בכר
מיכל ברנד-גולד
דנה חורב
הילה ביטון

עדי זונדר
ורד גיפמן
צחי דוידוביץ'
מיטל מלכיאל
ניר פרלשטין
צח רויטנברג
עדי שהם
תומר שוירמן
נועה שמידע
אבנר יצחקי

לילך גולדמן, עו"פ
חיה רוזנקנוף, עו"פ

ד"ר אמנון גולדנברג (2005 - 1935)
אברהם לוין (1988 - 1901)
נחמיה סלומון (1990 - 1903)

3 במאי 2010
H/332/250

לכבוד
ח"כ דוד רותם,
יו"ר ועדת החוקה חוק ומשפט
הכנסת
ירושלים

באמצעות דוא"ל:
drotem@knesset.gov.il
vdept4@knesset.gov.il

שלום רב,

הנדון: <u>הצעת חוק בתי המשפט (סמכות בעניינים כלכליים), התש"ע-2010</u>

בשם מרשתי, התאחדות התעשיינים בישראל, אני פונה אליכם בנושא שבנדון, ומבקשכם כדלקמן:

1. ראשית, אבקש להתנצל על ההתראה הקצרה בה מועברת הודעתי זו.

2. לאחרונה נודע למרשתי כי הצעת החוק שבנדון צפוי לעלות לדיון בוועדת החוקה, חוק ומשפט של הכנסת, בישיבתה הקבועה ליום 4.5.2010.

3. למרשתי הצעה להסתייגות – **ממוקדת וקצרה** – מהצעת החוק שבנדון.

   העתק מנוסח ההסתייגות המוצעת ומדברי ההסבר מצורף למכתבי זה.

   כמו-כן מצורף, לנוחותך, חומר הסבר מפורט יותר, עם נספחיו.

4. מרשתי מאמינה שההסתייגות המוצעת תואמת את תכלית החקיקה והינה לתועלת המערכת כולה.

5. אני מקווה שתיאותו לבחון את הצעת מרשתי.

6. במידת הצורך, אשמח לספק הסברים נוספים לגבי הצורך בהסתייגות ומשמעותה בזמן, הדיון בוועדה.

בכבוד רב ובברכה,

טל בנד, עו"ד
ש. הורוביץ ושות'

העתקים:
ח"כ אורי אורבך;
ח"כ טאלב א-סאנע;
ח"כ מיכאל בן-ארי;
ח"כ דני דנון;
ח"כ ציפי חוטובלי;
ח"כ איתן כבל;
ח"כ שלמה (נגוסה) מולה;
ח"כ אברהם מיכאלי;
ח"כ אורי מקלב;
ח"כ חנא סוייד;
ח"כ יוחנן פלסנר;
ח"כ כרמל שאמה;
גב' דורית ואג – מנהלת ועדת החוקה חוק ומשפט;
גב' סיגל קוגוט, עו"ד – היועצת המשפטית, ועדת החוקה חוק ומשפט.

הסתייגות

מוגשת בזאת הסתייגות מהצעת חוק בתי המשפט (תיקון מס' 59) (סמכות בעניינים כלכליים), התש"ע-2010 (להלן – "**הצעת החוק**").

1. בסעיף 1(2) להצעת החוק, בנוסח המוצע לסעיף קטן 40(5), לאחר פסקה (ד) יבוא:

(ד1) **תובענות והליכים לפי חוק הפטנטים, התשכ"ז-1967;**

2. בסעיף 2 להצעת החוק, בנוסח המוצע לסעיף קטן 40א(א), בסופו, יבוא:

"**מקרב שופטי בית המשפט המחוזי בתל-אביב – יפו**".

דברי הסבר

סעיף 1 עניינה של הצעת החוק בהעברת תביעות בעניינים כלכליים לסמכותו העניינית של בית המשפט המחוזי, וכן בהפניית תביעות בעניינים כאמור המוגשות לבית המשפט המחוזי בתל-אביב – יפו, למחלקה מיוחדת שתוקם לצורך זה באותו בית משפט, ואשר שופטיה יהיו בעלי מומחיות משפטית וכלכלית.

כעולה מתוך דברי ההסבר להצעת החוק, הצורך בהעברת הדיון בעניינים כאמור לערכאה בכירה ולשופטים בעלי התמחות מקצועית מיוחדת, נובע מהמורכבות הרבה הכרוכה בדיון בהם.

תביעות והליכים לפי חוק הפטנטים, השתכ"ז-1967, מתאפיינים אף הם במורכבות רבה, ומחייבים מומחיות מקצועית מיוחדת. כמו-כן, ההשלכות הכלכליות של ההכרעה בתיקים כאמור הינן כבדות משקל, הן עבור הצדדים לתיקים והן עבור הציבור. בשל כך הפקיד המחוקק את הסמכות בעניינים אלו בידי בית המשפט המחוזי. מטעם זה, מן הראוי לכלול תביעות כאמור בין ההליכים אשר יוגדרו כ-"עניינים כלכליים".

על פי הוראות חוק הפטנטים והצווים שהוצאו מכוחו, תביעות והליכים על פי חוק הפטנטים נתונים כבר כיום לסמכותם העניינית של בתי המשפט המחוזיים, ואין בהסתייגות כדי לשנות פרט זה. עם זאת, מאחר שחלק ניכר מהתביעות בענייני פטנטים מוגשות בבית המשפט המחוזי בתל-אביב – יפו (בדומה לתיקים כלכליים אחרים, כמתואר בדברי ההסבר להצעת החוק), פועלה העיקרי של ההסתייגות יהיה שהדיון בתביעות בענייני פטנטים יתנהל, אף הוא, בפני ערכאה מקצועית, בעלת בקיאות מיוחדת בנושאים הרלוונטיים לתביעה.

בדומה לתביעות אשר כבר מוגדרות כ-"עניינים כלכליים" בנוסחו הקיים של סעיף 40(5) המוצע, גם הדיון בתביעות בענייני פטנטים צפוי להתייעל במידה ניכרת אם יתנהל בפני שופטים בעלי בקיאות בנושאים הכרוכים בתחום זה, בין היתר מומחיות בתחום דיני הפטנטים, אשר מתאפיין בהוראות דין מיוחדות, רציונאלים ייחודיים וכתיבה מקצועית ענפה, וכן בקיאות בתחומים מדעיים וטכניים בהם מפותחות אמצאות שהינן עניין לפטנטים ולבקשות פטנט.

ניהול הדיון בפני ערכאה מקצועית כזו, צפוי לקצר את משך הדיונים, להבטיח וודאות לצדדים, לשפר את אמון הצדדים בבית המשפט וכן להניב תוצאות צודקות יותר בהליכים המתנהלים בענייני פטנטים.

סעיף 2 סעיף 40א(א) המוצע קובע, כי שופטי המחלקה הכלכלית ימונו על ידי נשיא בית המשפט המחוזי בתל-אביב – יפו, בהתייעצות עם שופטי בית המשפט העליון. מתוך הנוסח המוצע משתמע, כי שופטי המחלקה הכלכלית יתמנו מקרב שופטי בית המשפט המחוזי בתל-אביב – יפו, בדומה לאופן בו נבחרים שופטי בתי המשפט לעניינים מינהליים. עם זאת, הנוסח ניתן גם לפירושים אחרים. מוצע, אפוא, להבהיר נושא זה באמצעות התוספת המוצעת בהסתייגות.

הסתייגות להצעות חוק בתי המשפט (סמכות בעניינים כלכליים)

1. הצעת חוק בתי המשפט (תיקון מס' 59) (סמכות בעניינים כלכליים), התש"ע-2010 (להלן – "**הצעת החוק**") הוגשה על רקע המלצות הוועדה לבחינת קוד ממשל תאגידי בישראל, משנת 2006 (להלן – "**הוועדה**"). תכליתה של הצעת החוק, לאמץ את המלצת הוועדה באשר לסמכות הדיון בעניינים כלכליים. הכוונה היא שתביעות בעניינים אלו, שהינן מורכבות, יופנו לערכאת דיון מקצועית, ובעלת התמחות מיוחדת, מתוך מטרה לייעל את הדיון בעניינים כלכליים ולשפר את רמת האכיפה של הדינים הנוגעים להם.

2. המטרה שבבסיס הצעת החוק הינה מטרה ראויה, וכך גם אופן יישומה. נושאים מורכבים שהדיון בהם דורש בקיאות תיאורטית וניסיון מעשי, צריכים להיות מופנים לערכאה משפטית המתמחה בהם, ואשר לה הידע והניסיון הדרושים, ולמצער הכלים והמשאבים לרכוש אותם. עם זאת, ראוי וחשוב להרחיב את היקף תחולת ההוראות שבהצעת החוק, ולכלול בין הנושאים המוגדרים כ-"עניינים כלכליים" גם את תחום דיני הפטנטים.

3. הצעת החוק כוללת כיום שני שינויים עיקריים: (א) העברת עניינים כלכליים, כהגדרתם בה, מסמכותו העניינית של בית משפט השלום לסמכותו העניינית של בית המשפט המחוזי, שהינה ערכאת דיון בכירה, מקצועית ומיומנת יותר מבחינה משפטית; ו- (ב) קביעה, כי הליכים משפטיים בעניינים כלכליים שיוגשו בבית המשפט המחוזי בתל-אביב – יפו, יידונו בפני שופטי המחלקה הכלכלית שתוקם בו, שיהיו גם בעלי מומחיות מקצועית-כלכלית, המיוחדת לתיקים מסוג זה.

4. ההתמחות הנדרשת לשופטים, אמורה, על פי המלצות הוועדה, להקיף הן את הדינים הרלוונטיים והן נושאים מקצועיים-כלכליים, בהם כרוך דיון המשפטי בתחומים האמורים, דוגמת סוגיות מימוניות וניהוליות.

5. על פי דברי ההסבר, הצעת החוק באה על רקע המורכבות הרבה הכרוכה בדיון בתביעות העוסקות בעניינים כלכליים, והמומחיות הדרושה לשם דיון יעיל בהן. השאיפה היא, כי הפניית תיקים מורכבים לשופטים בעלי התמחות ובקיאות מתאימה, תאפשר את קיצור משך בירורן של התביעות, וכך גם את צמצום ההשלכות הכלכליות המזיקות הנובעות מהתמשכות הליכים. בד בבד, בירור התביעות על ידי שופטים בעלי הבנה מעמיקה בתחום הרלוונטי מן הפן המשפטי, וגם מן הפן העובדתי, תוביל ליישום נכון וראוי יותר של הדין, ולתוצאות צודקות, מאוזנות ויעילות יותר, עבור הצדדים והשוק.

6. המורכבות והצורך בבקיאות וניסיון ייחודיים, בהם מתאפיינים העניינים הכלכליים שנמנו בהצעת החוק, הינם גם נחלתם של דיני הפטנטים, ואף ביתר שאת. כתוצאה מכך, כמו ביתר העניינים הכלכליים, היעדר ערכאה מתמחה בה יושבים שופטים בעלי היכרות מעמיקה עם דיני הפטנטים ובעלי ניסיון בהתמודדות עם נושאים המערבים סוגיות מדעיות, גורם לסרבול הדיון ולהתמשכות ההליכים בענייני פטנטים, כמו גם לחוסר וודאות וחוסר עקביות בפסיקה.

7. הליכים משפטיים בענייני פטנטים מעוררים סוגיות סבוכות ביותר מבחינה משפטית. דיני הקניין הרוחני, ובפרט דיני הפטנטים, כוללים הוראות חוק מיוחדות, רציונאלים ייחודיים וכתיבה מקצועית ענפה, הדורשים מהמשפטן העוסק בתחום זה להקפיד להתעדכן בהתפתחויות הרבות בו.

8. לצד זאת, תביעות בענייני פטנטים מצריכות גם עיסוק והבנה מעמיקים בסוגיות מדעיות וטכניות מורכבות. למשל, על מנת לקבוע את קיומה של התקדמות המצאתית, שהינה תנאי הכרחי למתן פטנט, נדרש בית המשפט הדן בתיק להתעמק בהבדל בין האמצאה נשוא הפטנט או בקשת הפטנט שבפניו, לבין אמצאות שקדמו לה. על מנת לקבוע אם אירעה הפרת פטנט, נדרש בית המשפט לקבוע אם הנתבע עשה שימוש באמצאה או בתהליך אשר מוגנים בפטנט. זאת, לעיתים קרובות, ביחס לאמצאות חדשניות ומורכבות, שעניינן, למשל, בתרכובות כימיות, תהליכים פיסיקליים או שאלות מכניות והנדסיות. מטעם זה, בין היתר, מצא המחוקק הישראלי, בחוק הפטנטים, לייחס את סמכות הדיון בענייני פטנטים לבתי המשפט המחוזיים בלבד.

9. עם זאת, מעבר למקצועיות המשפטית הרבה בבתי המשפט המחוזיים, ברור כי התמודדות יעילה עם סוגיות מדעיות וטכניות כאמור, מחייבת ניסיון נרכש ונצבר בהתמודדות עימן. בהיעדר מגע שוטף עם התחומים המדעיים, ניצבים שופטים לא אחת בפני קושי שמסרבל ומאריך את הדיון.

10. מטעמים אלה, מדינות שונות בעולם, ובפרט הכלכלות המובילות, אשר חלק ניכר מהתעשייה שלהן מושתת על ידע מדעי וטכנולוגי המוגן בפטנטים, מאמצות הוראות דין שנועדו להעביר את הדיון בענייני פטנטים לבתי משפט המתמחים בתחום זה. הוראות הדין האמורות מזכירות את המבנה המוצע בהצעת החוק ביחס למחלקה הכלכלית בבית המשפט המחוזי בתל אביב.

11. במערכות דינים אלה, סמכות הדיון בענייני פטנטים מוקנית באופן ייחודי לבתי משפט מסוימים בערכאה הדיונית. באותם בתי משפט מוקמות מחלקות מיוחדות לדיון בענייני פטנטים, באופן שמאפשר לשופטים המכהנים במחלקות אלה לצבור ניסיון בטיפול בתיקים המערבים סוגיות מדעיות מורכבות, כמו גם להעמיק בלימוד דיני הפטנטים. בחלק מהמקומות השופטים המתמנים לכהונה במחלקות הפטנטים של בתי המשפט, הינם בעלי רקע מקצועי קודם בתחום דיני הפטנטים.

12. בצרפת נדונים ענייני פטנטים רק בבית המשפט בפריס, ה- *Tribunal de Grande Instance*[1].

ראו לעניין זה:

D. Harris & H. Newiss, ***International Intellectual Property Litigation*** (Sweat & Maxwell, 2010), page FRA/29 (להלן – "**Harris & Newiss**") – **נספח "א"**.

13. גם בגרמניה הוקמו בחלק מבתי המשפט האזוריים מחלקות לדיון בענייני פטנטים[2], וכך גם בבית המשפט לערעורים.

ראו לעניין זה: Harris & Newiss בעמודים GER/43-44 – **נספח "ב"**.

14. באנגליה, שתי ערכאות ייחודיות לדיון בענייני פטנטים, שהינן בעלות סמכות מקבילה מסוימת. האחת היא ה- Patents Court הפועל במסגרת ה- Chancery Division בבית המשפט הגבוה (High Court), ומיועד להתמודד עם תיקי פטנטים מורכבים הדורשים עיסוק גם בשאלות טכניות ומדעיות

---

1 Articles **D. 221-6** of the Judicial System Code – *Code de l'organisation judiciaire*

2 Section 143(2) Pat G 81

מורכבות[3]. ב- Patents Court יושבים שופטים שתפקידם יוחד לתחום עיסוק זה, והינם בעלי רקע טכני. הערכאה השנייה היא ה- Patents County Court, שהוקם בלונדון בשנת 1990 במסגרת בתי המשפט של המחוזות, ותכליתו להעניק טיפול מהיר בתיקי פטנטים המאפשרים דיון בהיקף מוגבל, תוך צמצום העלויות הכרוכות בכך[4].

ראו לעניין זה:

B. C. Reid, ***European Patents Litigation Handbook*** (Sweat & Maxwell, London, 1999), pages 6-8 – **נספח "ה"**;

וכן: Harris & Newiss בעמודים E&W/25-26 - **נספח "ו"**.

15. בשוודיה קיים בית משפט מתמחה לענייני פטנטים בעל סמכות ייחודית הן בערכאה הדיונית[5] והן בערכאות הערעור[6].

ראו לעניין זה: Harris & Newiss בעמודים SWE/29 – **נספח "ז"**.

16. בארה"ב, הדיון בענייני פטנטים הוא בסמכותם של בתי המשפט הפדראליים. הצורך בהתמחות מיוחדת מצד הערכאה השיפוטית מקבל מענה בדין האמריקני על ידי קביעת **ערכאת ערעור אחת ויחידה**. כך, ערעורים על פסקי דין בענייני פטנטים מכל שטחה של ארה"ב אינם מופנים לבתי המשפט הפדראליים לערעורים, שבתחום שיפוטם הגיאוגרפי ניתנו, אלא לבית המשפט לערעורים של המחוז הפדראלי - C.A.F.C (Court of Appeals for the Federal Circuit)[7] שהוקם לשם כך[8]. פסיקות ה- C.A.F.C בענייני פטנטים אף משמשות כתקדימים אשר מנחים את כל בתי המשפט הפדראליים.

17. בערכאה הדיונית של בתי המשפט הפדראליים בארה"ב לא נקבעו בתי משפט בעלי סמכות מיוחדת לענייני פטנטים. עם זאת, בפועל ענייני פטנטים מטופלים לרוב על ידי בתי משפט שלהם ניסיון רב בתחומים אלו. זאת, מאחר שבמשך שנים רבות הוגשו לאותם בתי משפט, באופן מסורתי, מספר רב של תביעות בענייני פטנטים. כך, באופן טבעי, נצבר באותם בתי משפט פדראליים ניסיון מעשי רב, אשר משפר יעילות הדיון בהם.

18. עובדות אלה ממחישות את הדימיון בין ענייני הפטנטים לבין העניינים שהוגדרו בהצעת החוק כ- "עניינים כלכליים", ובפרט ממחישות את הדמיון בקשיים המשותפים לדיונים המשפטיים בכל התחומים האמורים, ואף את הפתרונות המשותפים שנמצאו לקשיים אלו במערכות משפט מקבילות. מטעם זה, בין היתר, מן הראוי להתייחס לענייני פטנטים גם בישראל, כחלק מהעניינים הכלכליים, ולהחיל גם עליהם את הוראות החוק המיועדות לפתור את הקשיים המשותפים האמורים.

---

3 Supreme Court Act, 1981, section 6(1)(a) – **נספח "ג"**.

4 Copyright, Designs and Patents Act 1988, Part VI sections 287-294– **נספח "ד"**.

5 Stockholms tingsratt, 7:e avendlningen

6 Svea hovratt, 2:a avendlningen

7 28 U.S.C. § 1295(a)(4)(C) – **נספח "ח"**.

8 The Federal Courts Improvement Act, 1982– **נספח "ט"**.

19. הן בהליכים משפטיים בענייני פטנטים, והן בהליכים משפטיים ב- "עניינים כלכליים" כהגדרתם בנוסח הנוכחי של הצעת החוק, הדיון בפני ערכאות שלא התמחו בכך גורם לסירבול ההליכים והתמשכותם לאורך פרקי זמן בלתי סבירים, ומגדיל את חוסר הוודאות של הצדדים באשר לאופן יישום הדין. **הן בהליכים בענייני פטנטים והן בהליכים בעניינים כלכליים אחרים, יישום המסגרת הדיונית המוצעת בהצעת החוק ישפר את יעילות ההליך המשפטי**, ויקנה, בין היתר את היתרונות הבאים:

19.1 יקצר את משך הזמן הדרוש לשם לימוד והעמקה בסוגיות המשפטיות הייחודיות לדיני הפטנטים;

19.2 יאפשר לבית המשפט לצבור ידע ניסיון וגישה לסוגיות המדעיות המתעוררות בתיקי פטנטים ולאופן הטיפול בהן, ולייעל את הדיון בתיקים;

19.3 יאפשר לבית המשפט לצפות את השלכות פסק הדין – הן השלכות ישירות על הצדדים והן השלכות רוחב על שחקנים נוספים בתחום הרלוונטי, וכך יאפשר להגיע לתוצאה צודקת ומאוזנת יותר.

הן בעניינים כלכליים והן בעניינים כלכליים שהינם ענייני פטנטים, ניהול הדיון בפני ערכאה מקצועית כזו, צפוי לתרום לייעול ולפישוט הדיון, לקצר את משך בירור התביעות, להבטיח וודאות לצדדים, לשפר את אמון הצדדים בבית המשפט וכן להניב תוצאות צודקות יותר.

20. כפועל יוצא מכך, ישתפר גם המוניטין הבינלאומי של מערכת השפיטה הישראלית בהכרעה בתחום זה.

21. מבלי לגרוע מהאמור לעיל, נראה כי ענייני פטנטים ראויים להיכלל בין העניינים המוגדרים בהצעת החוק כעניינים כלכליים, גם מפאת החשיבות הכלכלית הרבה שתהיה למהלך כזה עבור המשק הישראלי. תיקים בתחום הקניין הרוחני הינם בדרך כלל בעלי משמעות כלכלית כבדה ביותר. זאת, הן עבור הצדדים, אשר הידע הטכנולוגי הוא מרכיב מרכזי בעסקיהם, והן עבור הציבור בכללו. זאת, מאחר ששאלת תוקפם של פטנטים ומידת ההגנה שראוי ליתן להם, משפיעה השפעה ישירה על זמינותם ומחיריהם של מוצרים בשוק, על רמת התחרות במשק ועל רמת ההתקדמות ההמצאתית בו.

22. בהקשר זה, ראוי לציין כי כלכלת המשק הישראלי נשענת בשנים האחרונות יותר ויותר על תעשיות עתירות ידע – ידע אשר מוגן על ידי דיני הקניין הרוחני, ובפרט דיני הפטנטים. לכן, לתחום משפטי זה ישנה חשיבות כלכלית מן המעלה הראשונה עבור כלכלתה של ישראל.

23. לפיכך, ראוי נכון וצודק, כי ענייני הפטנטים ידורו בכפיפה אחת עם יתר העניינים הכלכליים, כהגדרתם בהצעת החוק, והוראות הצעת החוק יחולו גם עליהן.

2 The Court System

In France, any lawsuit for revocation or infringement of an industrial property right should be filed with a court of first jurisdiction, generally a civil court (*Tribunal de Grande Instance*). We set out below, for each type of right, the relevant venue and jurisdiction. See also Appendix 2A.

Appeal may be brought in the corresponding court of appeal and further action, on questions of law only, may be filed by the losing party with the Supreme Court (*Cour de Cassation*).

An action may be initiated based on civil law and also, in most cases, on criminal law, but not based on both.

An action has to be brought before the court which has jurisdiction over the defendant (or any one of the defendants), or the place of alleged damage (that is, generally where the infringing product was found).

When the defendant has no address and no commercial activity in France, it may be difficult to determine which court has jurisdiction. Generally the competent court will then be that of the domicile or registered office of the claimant.

The plaintiff has however to select the court "permitted to render good justice". Therefore, for instance, in response to an infringement action, a nullity action should be brought in court which deals with the infringement.

2.1 COURTS OF FIRST INSTANCE

2.1.1 Patents

Since the decree of October 9, 2009 a patent case should be brought only in front of First Court of Paris *(Tribunal de Grande Instance)* (Code de l'organisation judiciaire, art.D 211-6). This also applies to the Supplementary Protection Certificates, Utility Certificates and semi-conductor topographies.

The President of the civil court of first instance of Paris may orders upon an ex parte request by the plaintiff an attachment to provide evidence (see 5.1.1). Penal action is also available (see below).

2.1.2 Designs

In bringing an action that concerns designs before the law dated October 29, 2007, the claimant could choose between the civil court of

2 The Court System

The civil courts in Germany are organised on four levels: *Amtsgericht* (county court), *Landgericht* (district court), *Oberlandesgericht* (Court of Appeal) and *Bundesgerichtshof* (Federal Supreme Court). Normally the value of the litigation (*Streitwert*) determines whether a lawsuit has to be filed with the county court or the district court at first instance. Most of the statutes concerning intellectual property rights stipulate, however, that all claims must be heard at the district court, regardless of value. There are 114 district courts in Germany, of which only 13 have a statutory jurisdiction to hear patent cases. Certain other specialised courts are stipulated for other intellectual property rights cases. For further details *see* 9.1.

The regular courts in Germany are entitled to charge standard court fees, as set out in a fee table on the basis of the value of the litigation. The fee system is similar to that for lawyers (*see* 3.4).

2.1 COURTS OF FIRST INSTANCE

The court of first instance for infringement proceedings of intellectual property rights is a district court. On the basis of their specialisation and their experience, some of the appointed district courts enjoy a high reputation as specialised courts. Recent surveys confirm, for example, that patent litigation is concentrated in Düsseldorf, Mannheim and Munich. Any chamber of a district court consists of three full-time judges. Proceedings in the chamber are governed by the Statute on Civil Procedures (*Zivilprozeßordnung*, ZPO). The court operates throughout the year and no longer takes a vacation in the summer as it did in the past.

Having experience of technical cases and technical questions the judges sitting in the patent chamber at a district court do their best to handle cases without taking evidence from a technical expert. Sometimes the briefs of the parties determine whether the court sees a need to request the assistance of a neutral technical expert.

2.2 COURTS OF APPEAL

Appeal from the district court lies to the Court of Appeal (*Oberlandesgericht*), at which specialised chambers are established. Like the cham-

bers of the district courts, the chamber of the Court of Appeal consists of three full-time judges. An appeal has to be filed within a non-extendable term of one month upon service of the written judgment on the party who wants to file the appeal.

In intellectual property rights infringement proceedings a further appeal (revision) from the Court of Appeal lies to the Federal Supreme Court where the panel consists of five full-time judges. Either the Court of Appeal or the Federal Supreme Court may grant leave for this further appeal. If the Court of Appeal grants leave for the appeal the Federal Supreme Court is bound to this decision and has to take the further appeal. If the Court of Appeal does not grant leave for the appeal the Federal Supreme Court is authorized to overrule this decision and to take the appeal upon an according motion of the party who wants to take the case to the Federal Supreme Court. Whereas both the district court and the Court of Appeal consider questions of fact, on which evidence can be submitted, the Federal Supreme Court decides only questions of law, on the basis of the fact-finding of the Court of Appeal.

In a nullity suit concerned with the validity of a patent an appeal from the Federal Patent Court (*Bundespatentgericht*) also lies as of right to the Federal Supreme Court. This means that the patent infringement suit and the nullity suit against the patent, on which the infringement suit is based, can come together at the Federal Supreme Court, and both suits (with different docket numbers) are handled by the same panel. In a nullity suit the Federal Supreme Court takes evidence as a matter of routine by appointing court's experts; these experts submit a written opinion on the subject matter of the litigious patent and the validity issues.

2.3 OTHER COURTS OR TRIBUNALS

2.3.1 Introduction

Appendix 2A sets out the court system, indicating the competences of the above courts and possibilities of appeal in patent litigation cases, including judicial review of the validity of patents in opposition and nullity actions. The right-hand column of the table also indicates the routes for the judicial review in other areas of intellectual property rights litigation.

2.3.2 Patent Office

The Patent Office does not deal with intellectual property rights infringement proceedings but is concerned mainly with the prosecution and registration of intellectual property rights. Furthermore the Patent

Office deals as a court of first instance with requests to cancel certain intellectual property rights registrations, ie utility model and trade mark registrations. For further details *see* 9.1.2.

2.3.3 Federal Patent Court

The Federal Patent Court (*Bundespatentgericht*) reviews decisions of the Patent Office. However, this court is also the court of first instance for nullity suits which everybody, including the defendant in a patent infringement case, can file against a patent. The panel of the Federal Patent Court consists of five full-time judges, two of whom are fully legally qualified, whilst the other three have a technical education.

2.3.4 European Court of Justice

The European Court of Justice in Luxembourg (ECJ) safeguards the construction and application of European law in the member states of the European Union. Cases can go to the ECJ by a referral from a national court. Courts of first instance can and courts of last instance must refer cases to the ECJ if their decision rests on a question of the construction or application of Community law which has not yet been decided. Cases can also go to the ECJ by appeal from the European Court of First Instance on a point of law

ELIZABETH II

Supreme Court Act 1981

1981 CHAPTER 54

An Act to consolidate with amendments the Supreme Court of Judicature (Consolidation) Act 1925 and other enactments relating to the Supreme Court in England and Wales and the administration of justice therein; to repeal certain obsolete or unnecessary enactments so relating; to amend Part VIII of the Mental Health Act 1959, the Courts-Martial (Appeals) Act 1968, the Arbitration Act 1979 and the law relating to county courts; and for connected purposes. [28th July 1981]

BE IT ENACTED by the Queen's most Excellent Majesty, by and with the advice and consent of the Lords Spiritual and Temporal, and Commons, in this present Parliament assembled, and by the authority of the same, as follows:—

PART I

CONSTITUTION OF SUPREME COURT

The Supreme Court

The Supreme Court.

1.—(1) The Supreme Court of England and Wales shall consist of the Court of Appeal, the High Court of Justice and the Crown Court, each having such jurisdiction as is conferred on it by or under this or any other Act.

(2) The Lord Chancellor shall be president of the Supreme Court.

PART I
The Court of Appeal.

The Court of Appeal

2.—(1) The Court of Appeal shall consist of ex-officio judges and not more than eighteen ordinary judges.

(2) The following shall be ex-officio judges of the Court of Appeal—

(*a*) the Lord Chancellor;

(*b*) any person who has been Lord Chancellor;

(*c*) any Lord of Appeal in Ordinary who at the date of his appointment was, or was qualified for appointment as, an ordinary judge of the Court of Appeal or held an office within paragraphs (*d*) to (*g*);

(*d*) the Lord Chief Justice;

(*e*) the Master of the Rolls;

(*f*) the President of the Family Division; and

(*g*) the Vice-Chancellor;

but a person within paragraph (*b*) or (*c*) shall not be required to sit and act as a judge of the Court of Appeal unless at the Lord Chancellor's request he consents to do so.

(3) The ordinary judges of the Court of Appeal (including the vice-president, if any, of either division) shall be styled "Lords Justices of Appeal".

(4) Her Majesty may by Order in Council from time to time amend subsection (1) so as to increase or further increase the maximum number of ordinary judges of the Court of Appeal.

(5) No recommendation shall be made to Her Majesty in Council to make an Order under subsection (4) unless a draft of the Order has been laid before Parliament and approved by resolution of each House of Parliament.

(6) The Court of Appeal shall be taken to be duly constituted notwithstanding any vacancy in the office of Lord Chancellor, Lord Chief Justice, Master of the Rolls, President of the Family Division or Vice-Chancellor.

Divisions of Court of Appeal.

3.—(1) There shall be two divisions of the Court of Appeal, namely the criminal division and the civil division.

(2) The Lord Chief Justice shall be president of the criminal division of the Court of Appeal, and the Master of the Rolls shall be president of the civil division of that court.

(3) The Lord Chancellor may appoint one of the ordinary judges of the Court of Appeal as vice-president of both divisions of that court, or one of those judges as vice-president of the criminal division and another of them as vice-president of the civil division.

(4) When sitting in a court of either division of the Court of Appeal in which no ex-officio judge of the Court of Appeal is sitting, the vice-president (if any) of that division shall preside.

(5) Any number of courts of either division of the Court of Appeal may sit at the same time.

The High Court

The High Court.

4.—(1) The High Court shall consist of—

(*a*) the Lord Chancellor;

(*b*) the Lord Chief Justice;

(*c*) the President of the Family Division;

(*d*) the Vice-Chancellor; and

(*e*) not more than eighty puisne judges of that court.

(2) The puisne judges of the High Court shall be styled "Justices of the High Court".

(3) All the judges of the High Court shall, except where this Act expressly provides otherwise, have in all respects equal power, authority and jurisdiction.

(4) Her Majesty may by Order in Council from time to time amend subsection (1) so as to increase or further increase the maximum number of puisne judges of the High Court.

(5) No recommendation shall be made to Her Majesty in Council to make an Order under subsection (4) unless a draft of the Order has been laid before Parliament and approved by resolution of each House of Parliament.

(6) The High Court shall be taken to be duly constituted notwithstanding any vacancy in the office of Lord Chancellor, Lord Chief Justice, President of the Family Division or Vice-Chancellor.

Divisions of High Court.

5.—(1) There shall be three divisions of the High Court namely—

(*a*) the Chancery Division, consisting of the Lord Chancellor, who shall be president thereof, the Vice-Chancellor, who shall be vice-president thereof, and such of the puisne judges as are for the time being attached thereto in accordance with this section;

(*b*) the Queen's Bench Division, consisting of the Lord Chief Justice, who shall be president thereof, and such of the puisne judges as are for the time being so attached thereto; and

PART I

(*c*) the Family Division, consisting of the President of the Family Division and such of the puisne judges as are for the time being so attached thereto.

(2) The puisne judges of the High Court shall be attached to the various Divisions by direction of the Lord Chancellor; and any such judge may with his consent be transferred from one Division to another by direction of the Lord Chancellor, but shall be so transferred only with the concurrence of the senior judge of the Division from which it is proposed to transfer him.

(3) Any judge attached to any Division may act as an additional judge of any other Division at the request of the Lord Chancellor made with the concurrence of the senior judge of each of those Divisions.

(4) Nothing in this section shall be taken to prevent a judge of any Division (whether nominated under section 6(2) or not) from sitting, whenever required, in a divisional court of another Division or for any judge of another Division.

(5) Without prejudice to the provisions of this Act relating to the distribution of business in the High Court, all jurisdiction vested in the High Court under this Act shall belong to all the Divisions alike.

The Patents, Admiralty and Commercial Courts.

6.—(1) There shall be—

(*a*) as part of the Chancery Division, a Patents Court; and

(*b*) as parts of the Queen's Bench Division, an Admiralty Court and a Commercial Court.

(2) The judges of the Patents Court, of the Admiralty Court and of the Commercial Court shall be such of the puisne judges of the High Court as the Lord Chancellor may from time to time nominate to be judges of the Patents Court, Admiralty Judges and Commercial Judges respectively.

Power to alter Divisions or transfer certain courts to different Divisions.

7.—(1) Her Majesty may from time to time, on a recommendation of the judges mentioned in subsection (2), by Order in Council direct that—

(*a*) any increase or reduction in the number of Divisions of the High Court; or

(*b*) the transfer of any of the courts mentioned in section 6(1) to a different Division,

be carried into effect in pursuance of the recommendation.

(2) Those judges are the Lord Chancellor, the Lord Chief Justice, the Master of the Rolls, the President of the Family Division and the Vice-Chancellor.

PART VI

PATENTS

Patents county courts

287 Patents county courts: special jurisdiction

(1) The Lord Chancellor may by order made by statutory instrument designate any county court as a patents county court and confer on it jurisdiction (its "special jurisdiction") to hear and determine such descriptions of proceedings—

(a) relating to patents or designs, or

(b) ancillary to, or arising out of the same subject matter as, proceedings relating to patents or designs,

as may be specified in the order.

(2) The special jurisdiction of a patents county court is exercisable throughout England and Wales, but rules of court may provide for a matter pending in one such court to be heard and determined in another or partly in that and partly in another.

(3) A patents county court may entertain proceedings within its special jurisdiction notwithstanding that no pecuniary remedy is sought.

(4) An order under this section providing for the discontinuance of any of the special jurisdiction of a patents county court may make provision as to proceedings pending in the court when the order comes into operation.

(5) Nothing in this section shall be construed as affecting the ordinary jurisdiction of a county court.

288 Financial limits in relation to proceedings within special jurisdiction of patents county court

(1) Her Majesty may by Order in Council provide for limits of amount or value in relation to any description of proceedings within the special jurisdiction of a patents county court.

(2) If a limit is imposed on the amount of a claim of any description and the plaintiff has a cause of action for more than that amount, he may abandon the excess; in which case a patents county court shall have jurisdiction to hear and determine the action, but the plaintiff may not recover more than that amount.

(3) Where the court has jurisdiction to hear and determine an action by virtue of subsection (2), the judgment of the court in the action is in full discharge of all demands in respect of the cause of action, and entry of the judgment shall be made accordingly.

(4) If the parties agree, by a memorandum signed by them or by their respective solicitors or other agents, that a patents county court shall have jurisdiction in any proceedings, that court shall have jurisdiction to hear and determine the proceedings notwithstanding any limit imposed under this section.

(5) No recommendation shall be made to Her Majesty to make an Order under this section unless a draft of the Order has been laid before and approved by a resolution of each House of Parliament.

289 Transfer of proceedings between High Court and patents county court

(1) No order shall be made under section 41 of the [1984 c. 28.] County Courts Act 1984 (power of High Court to order proceedings to be transferred from the county court) in respect of proceedings within the special jurisdiction of a patents county court.

(2) In considering in relation to proceedings within the special jurisdiction of a patents county court whether an order should be made under section 40 or 42 of the County Courts Act 1984 (transfer of proceedings from or to the High Court), the court shall have regard to the financial position of the parties and may order the transfer of the proceedings to a patents county court or, as the case may be, refrain from ordering their transfer to the High Court notwithstanding that the proceedings are likely to raise an important question of fact or law.

290 Limitation of costs where pecuniary claim could have been brought in patents county court

(1)

Where an action is commenced in the High Court which could have been commenced in a patents county court and in which a claim for a pecuniary remedy is made, then, subject to the provisions of this section, if the plaintiff recovers less than the prescribed amount, he is not entitled to recover any more costs than those to which he would have been entitled if the action had been brought in the county court.

(2) For this purpose a plaintiff shall be treated as recovering the full amount recoverable in respect of his claim without regard to any deduction made in respect of matters not falling to be taken into account in determining whether the action could have been commenced in a patents county court.

(3) This section does not affect any question as to costs if it appears to the High Court that there was reasonable ground for supposing the amount recoverable in respect of the plaintiff's claim to be in excess of the prescribed amount.

(4) The High Court, if satisfied that there was sufficient reason for bringing the action in the High Court, may make an order allowing the costs or any part of the costs on the High Court scale or on such one of the county court scales as it may direct.

(5) This section does not apply to proceedings brought by the Crown.

(6) In this section "the prescribed amount" means such amount as may be prescribed by Her Majesty for the purposes of this section by Order in Council.

(7) No recommendation shall be made to Her Majesty to make an Order under this section unless a draft of the Order has been laid before and approved by a resolution of each House of Parliament.

291 Proceedings in patents county court

(1) Where a county court is designated a patents county court, the Lord Chancellor shall nominate a person entitled to sit as a judge of that court as the patents judge.

(2) County court rules shall make provision for securing that, so far as is practicable and appropriate—

(a) proceedings within the special jurisdiction of a patents county court are dealt with by the patents judge, and

(b) the judge, rather than a registrar or other officer of the court, deals with interlocutory matters in the proceedings.

(3) County court rules shall make provision empowering a patents county court in proceedings within its special jurisdiction, on or without the application of any party—

(a) to appoint scientific advisers or assessors to assist the court, or

(b) to order the Patent Office to inquire into and report on any question of fact or opinion.

(4) Where the court exercises either of those powers on the application of a party, the remuneration or fees payable to the Patent Office shall be at such rate as may be determined in accordance with county court rules and shall be costs of the proceedings unless otherwise ordered by the judge.

(5) Where the court exercises either of those powers of its own motion, the remuneration or fees payable to the Patent Office shall be at such rate as may be determined by the Lord Chancellor with the approval of the Treasury and shall be paid out of money provided by Parliament.

292 Rights and duties of registered patent agents in relation to proceedings in patents county court

(1) A registered patent agent may do, in or in connection with proceedings in a patents county court which are within the special jurisdiction of that court, anything which a solicitor of the Supreme Court might do, other than prepare a deed.

(2) The Lord Chancellor may by regulations provide that the right conferred by subsection (1) shall be subject to such conditions and restrictions as appear to the Lord Chancellor to be necessary or expedient; and different provision may be made for different descriptions of proceedings.

(3) A patents county court has the same power to enforce an undertaking given by a registered patent agent acting in pursuance of this section as it has, by virtue of section 142 of the [1984 c. 28.] County Courts Act 1984, in relation to a solicitor.

(4) Nothing in section 143 of the County Courts Act 1984 (prohibition on persons other than solicitors receiving remuneration) applies to a registered patent agent acting in pursuance of this section.

(5) The provisions of county court rules prescribing scales of costs to be paid to solicitors apply in relation to registered patent agents acting in pursuance of this section.

(6) Regulations under this section shall be made by statutory instrument which shall be subject to annulment in pursuance of a resolution of either House of Parliament.

Licences of right in respect of certain patents

293 Restriction of acts authorised by certain licences

In paragraph 4(2)(c) of Schedule 1 to the [1977 c. 37.] Patents Act 1977 (licences to be available as of right where term of existing patent extended), at the end insert ", but subject to paragraph 4A below", and after that paragraph insert—

"4A (1) If the proprietor of a patent for an invention which is a product files a declaration with the Patent Office in accordance with this paragraph, the licences to which persons are entitled by virtue of paragraph 4(2)(c) above shall not extend to a use of the product which is excepted by or under this paragraph.

(2) Pharmaceutical use is excepted, that is—

(a) use as a medicinal product within the meaning of the Medicines Act 1968, and

(b) the doing of any other act mentioned in section 60(1)(a) above with a view to such use.

(3) The Secretary of State may by order except such other uses as he thinks fit; and an order may—

(a) specify as an excepted use any act mentioned in section 60(1)(a) above, and

(b) make different provision with respect to acts done in different circumstances or for different purposes.

(4) For the purposes of this paragraph the question what uses are excepted, so far as that depends on—

(a) orders under section 130 of the Medicines Act 1968 (meaning of "medicinal product"), or

(b) orders under sub-paragraph (3) above,

shall be determined in relation to a patent at the beginning of the sixteenth year of the patent.

(5) A declaration under this paragraph shall be in the prescribed form and shall be filed in the prescribed manner and within the prescribed time limits.

(6) A declaration may not be filed—

(a) in respect of a patent which has at the commencement of section 293 of the Copyright, Designs and Patents Act 1988 passed the end of its fifteenth year; or

(b) if at the date of filing there is—

(i) an existing licence for any description of excepted use of the product, or

(ii) an outstanding application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms of a licence for any description of excepted use of the product,

and, in either case, the licence took or is to take effect at or after the end of the sixteenth year of the patent.

(7) Where a declaration has been filed under this paragraph in respect of a patent—

(a) section 46(3)(c) above (restriction of remedies for infringement where licences available as of right) does not apply to an infringement of the patent in so far as it consists of the excepted use of the product after the filing of the declaration; and

(b) section 46(3)(d) above (abatement of renewal fee if licences available as of right) does not apply to the patent.".

294 When application may be made for settlement of terms of licence

In Schedule 1 to the [1977 c. 37.] Patents Act 1977, after the paragraph inserted by section 293 above, insert—

"4B (1) An application under section 46(3)(a) or (b) above for the settlement by the comptroller of the terms on which a person is entitled to a licence by virtue of paragraph 4(2)(c) above is ineffective if made before the beginning of the sixteenth year of the patent.

(2) This paragraph applies to applications made after the commencement of section 294 of the Copyright, Designs and Patents Act 1988 and to any application made before the commencement of that section in respect of a patent which has not at the commencement of that section passed the end of its fifteenth year.".

Patents: miscellaneous amendments

295 Patents: miscellaneous amendments

The [1949 c. 87.] Patents Act 1949 and the [1977 c. 37.] Patents Act 1977 are amended in accordance with Schedule 5.

AUSTRALIA
LBC Information Services
Sydney

CANADA & USA
Carswell
Toronto Ontario

NEW ZEALAND
Brooker's
Auckland

SINGAPORE & MALAYSIA
Thomson Information (S.E. Asia)
Singapore

SWEET & MAXWELL'S EUROPEAN PATENT LITIGATION HANDBOOK

General Editor

BRIAN C. REID

LONDON • SWEET & MAXWELL • 1999

Such appeal is a full re-hearing, but the Court will however give due weight to factual findings where such are within the Comptroller's special expertise such as licence royalty rates.[41] Further appeals to the Court of Appeal are restricted to points of law (see paragraph 1–56 below).

4. Patents Court and Patents County Court

Jurisdiction

1–09 The Patents Court was formally established only by the 1977 Act, but patent cases have been tried in the High Court[42] (of which it forms part) since at least 1602.[43] It has jurisdiction to determine not only all questions of infringement and validity relating to patents, but all other rights of action including breach of contract, copyright, registered design, unregistered design, trade mark, passing off, and breach of confidence as well as inherent jurisdiction (*e.g.* to grant declarations of non-infringement) independent of the Patents Acts.

Prior to 1977 the 1949 Act had created the position of Patents Judge, so that it has been usual since 1950 (at least) for patent disputes to be heard by a suitably specialist qualified person in the first instance.

The Patents County Court was set up in 1990 to provide cheap and informal procedures for the benefit of small firms.[44] Its jurisdiction is limited by the statute of its establishment to "any action or matter relating to patents or designs over which the High Court would have jurisdiction, together with any claims or matters ancillary to, or arising from, such proceedings".[45] There is no financial limit applicable to its cases.[46]

Both Courts may revoke patents but neither has power to grant. Where an appeal from the Comptroller's decision to refuse grant is successful the Court will simply refer the application back and direct that the patent proceed to grant.

Choice of forum

1–10 The plaintiff chooses in the first place the tribunal in which to bring an action. Cases in which discovery may be important, where there are real disputes as to facts, or where a significant amount of experimentation may be required are not suited to the County Court. Generally the longer, heavier, more complex, more important, and more valuable actions continue to belong in the Patents Court.

[41] *Allen & Hanbury's Ltd's (Salbutamol) Patent* [1987] R.P.C. 327, (see esp. pp. 373–376); *Smith Kline French (Cimetidine)* [1990] R.P.C. 203, (see esp. pp. 236–237).

[42] All proceedings in the High Court relating to patents are assigned to the Patents Court, Chancery Division by R.S.C. Order 103, rule 2(1) and any cases which fall outside the wording of the rule will in practice be assigned to the Patents Court. See *Omron Tateisi Electronics' Application* [1981] R.P.C. 125; this was a judicial review action formally brought in the Queen's Bench Division of the High Court (as required by R.S.C. Order 53) but heard by the Patents Judge sitting in that Division. The history of patents courts (including the Patents Appeal Tribunal under the 1949 Act) is discussed there at p. 133.

[43] *Darcy v. Allein* (1602) 1 W.P.C. 1; Noy 173; Moore. K.B. 671; 11 Co. Rep. 84b.

[44] As discussed more fully below. The effect has been less than expected, mainly because the Patents Court has streamlined its own procedures and thereby reduced costs in recent years.

[45] CDPA 1988, s. 287 and Patents County Court (Designation and Jurisdiction) Order 1994, S.I. 1994 No. 1609. See *McDonald v. Graham* [1994] R.P.C. 407, (copyright and patent infringement; see esp. p. 435, p. 441); *Prout v. British Gas* [1992] F.S.R. 478 (breach of confidence and patent infringement).

[46] Though there is power to set such a limit by Order in Council; s. 288, CDPA 1988.

There are some significant variations in trial procedure as between the Patents Court and Patents County Court considered in paragraphs 1–48 and 1–49, *et seq.* Other factors worthy of separate note include the following:

(a) *Pleadings.* Patents County Court actions are commenced by issuing a summons accompanied by a Statement of Case and Particulars of Infringement,[47] which must contain all facts, matters, *and* arguments to be relied upon. High Court proceedings are usually[48] commenced by issuing a writ, followed or accompanied by a Statement of Claim and Particulars of Infringement which need only set out relevant facts and matters to be relied upon. It follows that in the Patents County Court both sides learn their opponent's case early on, but sacrifice some of their freedom to present their own argument.[49]

(b) *Cost profile* (but not necessarily total costs[50]). Initial expenditure tends to be higher in the Patents County Court.

(c) *Rights of audience.* In the Patents County Court registered patent agents can appear in Court and do anything else which a solicitor can do, other than prepare a deed[51] whereas in the Patents Court they can only appear on appeals from the Comptroller. In the Patents Court only counsel, personal non-corporate litigants, and solicitors who have completed an advocacy training course have rights of audience.

(d) *Appeals* are available as of right from final determinations of the Patents Court, but appeals from the Patents County Court may in some cases be restricted under the County Court Appeals Order 1991, such that leave is required. There are other minor differences arising from the fact that the Patents County Court is subject to County Court Rules of procedure rather than those of the High Court.[52]

Transfer between Patents Court and Patents County Court

1–11 It is important to appreciate that transfer of an action commenced in the Patents County Court to the Patents Court, and vice versa, is possible. The Court[53] has a complete discretion as regards such transfers but must[54] have regard to the financial substance of the action, including the value of any counterclaim; whether the action is otherwise important or raises questions of general public interest; the complexity of the case; and whether the

[47] County Court Rules Order 48A.

[48] See below, paragraph 1–48.

[49] Jacob. J. suggested in *Slope Indicator v. Monitoring Systems* (1995) F.S.R. 867 that even in the Patents Court a party could be ordered to set out his case in similar detail to that required in the Patents County Court.

[50] The County Court standard scale of costs is lower, but the High Court scale of costs can be ordered in the Patents County Court (and frequently is, where large companies are involved); see *Wellcome Foundation v. Discpharm (No. 2)* [1993] F.S.R. 444.

[51] CDPA 1988, s. 292(1). Thus the plaintiff could be represented by a patent agent in *Pavel v. Sony*, by far the largest case (19 days) brought in the Patents County Court to date.

[52] *e.g.* normal County Courts cannot grant *Anton Piller* or *Mareva* injunctions (see below), hence it has been necessary specifically to confer such jurisdiction on the Patents County Court; *McDonald v. Graham* [1994] R.P.C. 407.

[53] *i.e.* both Patents Court and Patents County Court.

[54] High Court and County Courts Jurisdiction Order 1991, Art. 7(5).

transfer is likely to result in a more speedy trial of the action; and the financial position of the parties.[55] Other factors[56] include the financial position of the parties (and their size), costs, and all matters affecting the proper administration of justice, but it is irrelevant which action was first in time.[57] The parties can transfer by consent even after refusal of a contested application.[58]

5. Infringement

Primary infringement[59]

1–12 The following acts, if done in the United Kingdom without consent of the proprietor, constitute infringement[60]:

- *where the patent is a product*—making, disposing of, offering to dispose of, using or importing the product, or keeping the product whether for disposal or otherwise;
- *where the invention is a process*—using the process or offering it for use (but in the latter case only in the knowledge or when it is obvious to a reasonable person in the circumstances that such use would constitute infringement of the patent)[61];
- *also where the invention is a process*—disposing of, offering to dispose of, using or importing any product obtained directly[62] by means of the process or keeping any such product whether for disposal or otherwise.

"Use" means commercial use, and not simply an application to regulatory authorities to sell a product in the United Kingdom.[63] "Dispose" and "keeping whether for disposal or otherwise"[64] were introduced to U.K. law by the 1977 Act. Taken literally and together, they appear to cover virtually everything imaginable but it appears that mere warehousemen and carriers are not liable *per se*.[65]

[55] For contrasting examples see *Memminger-IRO v. Trip-lite* [1992] R.P.C. 210, (the fact that defendant planned to dispense with solicitors and counsel in the Patents County Court tipped balance in favour of transfer there); *Slope Indicator v. Monitoring Systems* [1995] F.S.R. 867, (no costs saving nor any real difference in pleading requirements between the Courts, transfer refused).
[56] See *Mannesmann Kienzle v. Microsystems Design* [1992] R.P.C. 569, *Optical Coating Laboratory v. Pilkington PE* [1995] R.P.C. 145, (case wholly inappropriate for Patents County Court even if technically within its jurisdiction as much at stake between two major industrial concerns and neither side deterred by cost of High Court litigation).
[57] *Symbol Technologies Inc v. Opticon Sensors Europe (No. 2)* [1993] R.P.C. 232, 233.
[58] *Mentor Corporation v. Colorplast A/S* F.S.R. 175. Costs of the application are to be paid by the party losing before the original judge.
[59] Or "direct" infringement—*i.e.* acts done directly in relation to patented products or processes.
[60] See PA 1977, s. 60(1).
[61] With this exception, knowledge or intention is irrelevant to primary infringement.
[62] "Directly" means "without any intervening step"; see *Pioneer Electronics v. Warner Music Manufacturing Europe* [1977] R.P.C. 757. It is noteworthy that the Court of Appeal went heavily into European law, in upholding the original decision of the Patents Court.
[63] *Upjohn v. Kerfoot* [1988] F.S.R. 1, 7; *cf. SKF v. Douglas* [1991] F.S.R. 522, (New Zealand Court of Appeal).
[64] Including keeping for use when required *McDonald v. Graham* [1994] R.P.C. 407.
[65] In *Smith Kline French v. Harbottle (Mercantile)* [1980] R.P.C. 363, 371–4 (the Court was "wholly unpersuaded" that such persons were infringers, though was expressed no final view). See also *McDonald v. Graham* [1994] R.P.C. 407, 417, Patents County Court.

Secondary infringement[66]

Infringement is also established where a person (not being the proprietor) supplies or offers to supply (other than to a licensee or other person entitled to work the invention) any of the means, relating to an essential element of the invention, for putting the invention into effect when he knows, or it is obvious to a reasonable person in the circumstances, that those means are suitable for putting, and are intended to put, the invention into effect in the United Kingdom.[67] It appears that such supply is still an infringement even if the activities of the person supplied are specifically exempted from (primary) infringement.[68] The section does not apply to the supply or offer to supply of a "staple commercial product" unless such acts are done for the purpose of inducing direct infringement by the person supplied.[69] 1–13

The only case so far to consider this section in any detail has been *Chapman v. McAnulty* (unreported); the Court observed that it must be a matter of impression as to whether any given item was "means, relating to an essential element" and held it was sufficient if shown that the invention will be put into effect for some users, disregarding only maverick or unlikely use.

Statutory exceptions to infringement

Certain acts which would otherwise infringe shall not do so if: 1–14

a) done privately *and* for non-commercial purposes[70];
b) done for experimental purposes relating to the subject matter of the invention.[71] "Experiments" in this sense are trials carried out to discover something unknown, not merely to demonstrate to third parties such as customers or regulatory bodies that something works[72];
c) such consist of extemporaneous preparation in a pharmacy of a medicine for an individual according to a medical prescription[73];
d) such relate to use on the body or operation of a ship, aircraft or other vehicle temporarily or accidentally in the United Kingdom (*i.e.* not registered there)[74]

The scope of the claims

The claim or claims define the scope of the monopoly.[75] They must however be interpreted in the light of the specification including any drawings, in accordance with Article 69 of the EPC and the Protocol on 1–15

[66] See PA 1977, s. 60(2).
[67] The section does not state whether it applies to a party who knows the intended use of the "means" he supplies but is unaware that such use is in fact covered by patent; but if it does not, it is practically worthless.
[68] *Monsanto v. Stauffer* [1985] R.P.C. 515. This argument succeeded in the Patents Court (p. 523) but the Court of Appeal, whilst recognising the force thereof (p. 542), declined to express a final opinion.
[69] The Act defines neither "staple commercial product" nor the nature of the inducement required.
[70] s. 60(5)a. See *Smith Kline & French Labs v. Evans Medical* [1989] F.S.R. 513.
[71] PA 1977, s. 60(5)b.
[72] *Monsanto v. Stauffer* [1985] R.P.C. 515.
[73] PA 1977, s. 60(5)(c).
[74] See PA 1977, ss. 60(5)(d), (e), (f).
[75] PA 1977, s. 14(5)a.

7

2 The Court System

The structure of the court system in England & Wales with particular emphasis on the jurisdictions relevant to intellectual property actions is shown diagrammatically in Appendix 2A.

2.1 COURTS OF FIRST INSTANCE

2.1.1 High Court

The High Court which has jurisdiction throughout England and Wales is divided into three divisions, the Queens Bench Division, the Chancery Division and the Family Division.

The Chancery Division hears all intellectual property actions. The Chancery Division also has the specialist Patents Court which hears patent and registered design (both UK and Community) proceedings.

In the Patents Court there are assigned judges who have a technical background. The Patents Court has extensive experience of patent law and ability to deal with complicated technologies.

Virtually all intellectual property actions are heard in London.

The High Court operates all the year round, but there are vacation periods when the court's actions are restricted and the court will only hear urgent applications. When hearing a trial the court sits usually from 10.30 a.m. to 4.30 p.m. Monday to Friday, with an hour off for lunch.

2.1.2 County Court

The county court system in England and Wales is a network of regional courts to deal with smaller or simpler claims than those dealt with by the High Court.

In September 1990, a specialist Patents County Court was opened in London with jurisdiction over patent and registered design (both UK and Community) proceedings. It now also has jurisdiction over registered trade mark and passing-off actions. Unlike other county courts, the Patents County Court has jurisdiction throughout England and Wales and no financial limit on the claims that it can deal with. The Patents County Court is located close to the High Court in Central London. In October 2001 His Honour Judge Michael Fysh Q.C. was appointed as the judge in the PCC and this appointment has led to a

revival of the PCC as an alternative forum to the Patents Court (High Court) for patent litigation in England and Wales.

For various practical and procedural reasons few intellectual property matters are brought in the normal county courts.

2.1.3 Patent Office

The Patent Office has jurisdiction to hear revocation actions, actions for declarations of non-infringement and by agreement between the parties, infringement actions. However the Patent Office does not have jurisdiction to grant injunctions and as a result the infringement jurisdiction has never been used. The Patent Office can be requested by any party to produce an Opinion on any issue relating to the infringement or validity of a Patent. The Opinion is rendered by a senior patent examiner. The fee for an Opinion is £200 and will normally take about three months to produce. The Patent Office publishes a list of requests for an Opinion as well as the patent in suit, the subject matter of the query and the identity of the requesting party. Third parties may submit observations to the Patent Office in respect of each request. The resulting Opinion is also published and therefore available to third parties.

2.1.4 Crown court

The Crown Courts are local criminal courts which hear the more serious criminal cases. They are staffed by full time judges. There is a jury system. See 12.1.7 for more details.

2.1.5 Magistrates court

The magistrates courts are local criminal courts which hear the less serious criminal cases. They are staffed by either a professional magistrate, with legal training, or a panel of lay people. Appeal is normally to the Crown Court as a rehearing, although if the ground is that the proceedings are wrong in law or that the magistrates court is in excess of jurisdiction, the appeal is to the High Court. See 12.1.5 and 12.1.6 for more details.

2.2 COURTS OF APPEAL

2.2.1 Court of Appeal

Appeals from both the High Court and the PCC lie with permission to the Court of Appeal, which consists of three judges. At least one of the judges presently in the Court of Appeal was previously a judge of the

Patents Court. Otherwise the judges have had varied experience. A scientific adviser can be appointed if necessary.

2.2.2 House of Lords

Appeals from the Court of Appeal lie with permission to the House of Lords which consists of five judges. Permission will only be granted for an appeal to the House of Lords on an issue of law of wider public importance. Appeals are rare. Again, a scientific adviser can be appointed if necessary.

2.3 OTHER COURTS OR TRIBUNALS

2.3.1 European Court of Justice

The European Court of Justice (ECJ) sits in Luxembourg and is the supreme authority on all aspects of European Community law. Cases can go to the ECJ by a referral from the national courts of member states to interpret or verify the validity of a provision of Community law under Art.234 of the Treaty of Rome. The ECJ consists of 27 judges and eight advocates general, however only 13 judges sit in the Grand Chamber and three to five in the smaller chamber. It is the practice of the ECJ to frame a decision as a single collegiate judgment following secret deliberations. The ECJ's ever-increasing workload and the increasing length of time for a case to come to judgment have led to the creation of a Court of First Instance (CFI) to hear, inter alia, certain categories of appeals from Community Institutions such as OHIM. At present it takes approximately two years for an appeal or reference from a national court to reach a hearing before the CFI or the ECJ. An appeal on points of law lies from the CFI to the ECJ.

See Part B.

2.3.2 Copyright tribunal

This tribunal has jurisdiction relating to licences and schemes of a licensing body, ie a body or society or other organisation with the main object of negotiating or granting licences, like the Performing Rights Society. The Tribunal consists of a chairman, two deputy chairmen, and between two and eight ordinary members appointed by the Secretary of State for Trade and Industry. It will only act on the complaint of a licensee, actual or potential. The tribunal's ambit is to look at a scheme and decide if it is reasonable in all the circumstances. In contrast to action within the courts, there is not as much of a "winner takes all" mentality and compromises are the norm. Proceedings can be lengthy and costly in comparison with normal court proceedings.

2 The Court System

2.1 COURTS OF FIRST INSTANCE

The Swedish court system is divided into administrative courts and ordinary courts. While matters concerning registration of intellectual property rights are handled by the Swedish Patent and Registration Office and subsequently on appeal by the administrative courts, infringement cases, including criminal proceedings, are heard by the ordinary courts, as will be described further below.

The Swedish ordinary courts are structured in a three-tier system, where the right of appeal is limited to a certain extent among the different tiers. The courts of first instance are the district courts (*tingsrätt*).

The district courts each have jurisdiction over a specific geographical area and are competent to hear all civil and criminal matters pertaining to intellectual property rights, such as infringement and revocation of registered designs, registered trade marks and company names.

A district court is normally composed of three judges with legal training at the main hearing. However, if the parties agree or if the matter is of a less complex nature, the court can hear a case with only one such judge. Also if the value of the claim does not exceed a certain level (in 2007, SEK20,150), the court will hear the case with only one judge.

The Stockholm District Court is the exclusive venue for patent litigation, including infringements and revocation of patents. At a main hearing in a patent case, the Stockholm District Court is normally composed of four judges, two with legal training and two with technical expertise in the relevant field.

If they only concern an injunction, cases under the Marketing Act 1995 are handled by the Market Court. All other cases under the Marketing Act, including claims for prohibition combined with damages, are handled under the exclusive jurisdiction of the Stockholm District Court. When the Stockholm District Court hears cases pursuant to the Marketing Act, the Court is normally composed of four judges, two with legal training and two with expertise in economics.

In criminal cases concerning infringement of other intellectual property rights than patents, the district courts are composed of one judge with legal education/training and three lay judges. In cases where a claimant pursues a claim for damages based on infringement of an intellectual property right in connection with criminal charges for the same infringement, the district court will hear the case with the com-

position of judges as above, unless the court finds a joint hearing of the criminal and civil matter will entail substantial disadvantages.

2.2 COURTS OF APPEAL

There are six courts of appeal (*hovrätt*) which hear cases from specified district courts, based on their geographic location.

Normally the courts of appeal are composed of four judges in civil matters. In criminal cases the court is normally composed of three judges with legal training and two lay judges. In matters in which the dispute concerns a lesser value (in 2007, SEK 40,300), there is a general requirement for leave of appeal to the courts of appeal.

The Svea Court of Appeal (*Svea hovrätt*) is the exclusive court of appeal for patent litigation cases. In such cases, the Svea Court of Appeal is normally composed of three judges with legal training and two judges with technical expertise. However, in cases where the court considers that the participation of technical expertise would be superfluous, it can hear the case with only three judges having legal training. The requirement for grant of leave to appeal mentioned above does not apply to patent matters.

2.2.1 The Supreme Court

The Supreme Court (*Högsta Domstolen*) hears cases on appeal from the courts of appeal. The main function of the Supreme Court is to adjudicate cases which have precedential value on issues of law. There is a general requirement for leave of appeal in order for the Supreme Court to hear a case.

The Supreme Court has a total of 16 judges.

When deciding on the grant of leave of appeal, the Supreme Court is composed of one or up to three judges with legal training. When hearing a case the Supreme Court is normally composed of five or up to seven such judges.

No judges with technical expertise participate in the Supreme Court, but certain decisions, which change earlier precedent, will be taken in plenum.

2.3 OTHER COURTS OR TRIBUNALS

2.3.1 The Market Court

The Market Court (*Marknadsdomstolen*) in Stockholm is the single court for cases under the Marketing Act 1995 (with a few exceptions

regarding fees for market disturbances and claims for damages in accordance with section 29, where the court of first instance is the District Court of Stockholm and the Market Court is the appellate court). Thus, the court system under the Marketing Act may sometimes include two instances. However, there is normally no requirement for leave of appeal in order for the Market Court to hear a case.

The Market Court has seven judges in total: three with legal training, one of whom will be the President of the Court, and four judges with expertise in economics. When hearing a case under the Marketing Act, the court consists of four judges, including the President of the Court.

2.3.2 The Patent Board of Appeal

A decision of the Swedish Patent and Registration Office in respect of the grant of a patent or registration of a trade mark or design is subject to appeal to the Patent Board of Appeal (*Patentbesvärsrätten*). The decision of this Board can in turn be appealed to the Supreme Administrative Court (*Regeringsrätten*), subject to a requirement for grant of leave of appeal.

77

LexisNexis®

LEXSTAT 28 U.S.C. § 1295

UNITED STATES CODE SERVICE
Copyright © 2010 Matthew Bender & Company, Inc.
a member of the LexisNexis Group (TM)
All rights reserved.

*** CURRENT THROUGH PL 111-160, APPROVED 4/26/2010 ***

TITLE 28. JUDICIARY AND JUDICIAL PROCEDURE
PART IV. JURISDICTION AND VENUE
CHAPTER 83. COURTS OF APPEALS

Go to the United States Code Service Archive Directory

28 USCS § 1295

§ 1295. Jurisdiction of the United States Court of Appeals for the Federal Circuit

(a) The United States Court of Appeals for the Federal Circuit shall have exclusive jurisdiction--

(1) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1338 of this title [28 USCS § 1338], except that a case involving a claim arising under any Act of Congress relating to copyrights, exclusive rights in mask works, or trademarks and no other claims under section 1338(a) [28 USCS § 1338(a)] shall be governed by sections 1291, 1292, and 1294 of this title [28 USCS §§ 1291, 1292, and 1294];

(2) of an appeal from a final decision of a district court of the United States, the United States District Court for the District of the Canal Zone, the District Court of Guam, the District Court of the Virgin Islands, or the District Court for the Northern Mariana Islands, if the jurisdiction of that court was based, in whole or in part, on section 1346 of this title [28 USCS § 1346], except that jurisdiction of an appeal in a case brought in a district court under section 1346(a)(1), 1346(b), 1346(e), or 1346(f) of this title [28 USCS § 1346(a)(1), 1346(b), 1346(e), or 1346(f)] or under section 1346(a)(2) [28 USCS § 1346(a)(2)] when the claim is founded upon an Act of Congress or a regulation of an executive department providing for internal revenue shall be governed by sections 1291, 1292, and 1294 of this title [28 USCS §§ 1291, 1292, and 1294];

(3) of an appeal from a final decision of the United States Claims Court [United States Court of Federal Claims];

(4) of an appeal from a decision of--

(A) the Board of Patent Appeals and Interferences of the United States Patent and Trademark Office with respect to patent applications and interferences, at the instance of an applicant for a patent or any party to a patent interference, and any such appeal shall waive the right of such applicant or party to proceed under section 145 or 146 of title 35;

(B) the Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office or the Trademark Trial and Appeal Board with respect to applications for registration of marks and other proceedings as provided in section 21 of the Trademark Act of 1946 (15 U.S.C. 1071); or

(C) a district court to which a case was directed pursuant to section 145, 146, or 154(b) of title 35;

(5) of an appeal from a final decision of the United States Court of International Trade;

(6) to review the final determinations of the United States International Trade Commission relating to unfair practices in import trade, made under section 337 of the Tariff Act of 1930 (19 U.S.C. 1337);

(7) to review, by appeal on questions of law only, findings of the Secretary of Commerce under U.S. note 6 to subchapter X of chapter 98 of the Harmonized Tariff Schedule of the United States (relating to importation of instruments or apparatus);

(8) of an appeal under section 71 of the Plant Variety Protection Act (7 U.S.C. 2461);

(9) of an appeal from a final order or final decision of the Merit Systems Protection Board, pursuant to sections 7703(b)(1) and 7703(d) of title 5;
(10) of an appeal from a final decision of an agency board of contract appeals pursuant to section 8(g)(1) of the Contract Disputes Act of 1978 (41 U.S.C. 607(g)(1));
(11) of an appeal under section 211 of the Economic Stabilization Act of 1970 [former 12 USCS § 1904 note];
(12) of an appeal under section 5 of the Emergency Petroleum Allocation Act of 1973;
(13) of an appeal under section 506(c) of the Natural Gas Policy Act of 1978 [15 USCS § 3416(c)]; and
(14) of an appeal under section 523 of the Energy Policy and Conservation Act [42 USCS § 6393].

(b) The head of any executive department or agency may, with the approval of the Attorney General, refer to the Court of Appeals for the Federal Circuit for judicial review any final decision rendered by a board of contract appeals pursuant to the terms of any contract with the United States awarded by that department or agency which the head of such department or agency has concluded is not entitled to finality pursuant to the review standards specified in section 10(b) of the Contract Disputes Act of 1978 (41 U.S.C. 609(b)). The head of each executive department or agency shall make any referral under this section within one hundred and twenty days after the receipt of a copy of the final appeal decision.

(c) The Court of Appeals for the Federal Circuit shall review the matter referred in accordance with the standards specified in section 10(b) of the Contract Disputes Act of 1978 [41 USCS § 609(b)]. The court shall proceed with judicial review on the administrative record made before the board of contract appeals on matters so referred as in other cases pending in such court, shall determine the issue of finality of the appeal decision, and shall, if appropriate, render judgment thereon, or remand the matter to any administrative or executive body or official with such direction as it may deem proper and just.

FEDERAL COURTS IMPROVEMENT ACT 96 Stat. 25 (1982)

This act reorganized several specialized federal courts. It merged the former COURT OF CLAIMS and COURT OF CUSTOMS AND PATENT APPEALS into a new UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, transferring to the new court the former courts' JURISDICTION, and staffing it with the judges of the superseded courts. The Federal Circuit is a CONSTITUTIONAL COURT, staffed by twelve judges with life terms.

The act also created a new CLAIMS COURT to handle the trial functions formerly performed by commissioners (later called trial judges) of the old Court of Claims. The Claims Court is a LEGISLATIVE COURT; its sixteen judges serve for fifteen-year terms. Appeals go to the Federal Circuit.

KENNETH L. KARST
(1986)

Bibliography

SYMPOSIUM 1983–1984 The Federal Courts Improvement Act. *Cleveland State Law Review* 32:1–116.

Copyright © 2000 by Macmillan Reference USA