Rules of Procedure - Expert Evidence before the Unified Patent Court

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I. Proceedings before the Court of 1\textsuperscript{st} Instance

- **Written procedure**
  - Front loading
    - written statements of the parties
    - fully fledged (no skeleton) arguments
      - all facts and all evidence relied on
      - reasons why the facts constitute or do not constitute an infringement, a defense to infringement or a ground for revocation

- **Interim procedure**
  - preparation of the oral hearing
    - orders regarding evidence

- **Oral procedure**
  - oral submissions of the parties
  - hearing of witnesses and experts
II. What questions are suitable for taking expert evidence?

- **Expert evidence is not** taken with regard to **questions of law**.
  - Questions of law are to be decided by the judges.
  - Possible exception: questions of foreign law.

- **Expert evidence may be taken in order to assist the judges when establishing facts that are relevant for deciding the case.**
  - Relevant and contested questions of fact.
  - Expert as an assistant of the judge.
III. What are questions of law, what are questions of fact in patent litigation?

- **Questions of law:**
  - patent claim interpretation
  - equivalence (partly)
  - novelty
  - inventive step (obviousness)
  - added matter
• Questions of fact:
  – general perspective of an average person skilled in the art at the priority date
    The trial judge may take expert evidence when he needs assistance in establishing
      • what the average person skilled in the art’s general knowledge was,
      • what her/his general abilities were,
      • what her/his general experience was,
      • what her/his methodological approach in determining the elements of the claim at the priority date was, etc.
  – disclosure of a prior art document
  – properties of an allegedly infringing product
  – functioning of an allegedly infringing process
IV. What kind of expert evidence is available in UPC proceedings?

- **Party experts**
  - Parties are free to submit expert evidence that they consider necessary, r. 181 (1).
  - The court may summon a party expert to the oral hearing, r. 181 (2) a).
  - A party expert is to be independent and objective and shall not act as an advocate for any party to the proceedings, r. 181 (2) b)
• Court appointed expert

  – Prerequisite
    • “Where the Court must resolve technical or other questions (of fact) in relation to the action …

  – Discretion
    • … it may of its own motion (and after hearing the parties) appoint a court expert”, r. 185 (1).

  – How to exercise the discretion?
    • Is the Court able to decide the technical question without appointing an expert on the basis of …
      – the written submissions of the parties, including technical literature, textbooks, lexica, etc.,
      – expert evidence provided by the parties,
      – the involvement of the technically qualified judge?
– Appointment
  • The Court shall appoint the court expert by way of order, r. 185 (4).

– Qualifications
  • The expert shall possess expertise, independence and impartiality, r. 185 (3).
  • Parties may make suggestions, r. 185 (2).
  • The registry shall maintain an indicative list of experts, r. 185 (9).

– Duties
  • The expert shall present an expert report in writing, r. 186 (1)
    – which the parties may comment on, r. 187.
  • The expert shall attend the oral hearing and answer questions of the Court and the parties, r. 186 (6).
V. Are the judges bound to the opinion of the expert?

– Judges are free in assessing evidence.
– They have to take into account all evidence relevant.
– They are not bound to the opinion of an expert.
– Judges can follow or deviate from the opinion of an expert but shall give reasons with regard to the essential points in the judgment.

– General principles of assessing evidence and in particular expert evidence shall be observed, e.g.:
  • All submissions of the parties have to be taken into account.
  • The assessment has to be logical, etc.

– On appeal, the Court of Appeal
  • will check weather these general principles have been observed and
  • may appoint an expert itself when necessary.
Thank you very much for your attention!