

**ASSOCIAZIONE ITALIANA DEI CONSULENTI ED ESPERTI IN PROPRIETA'  
INDUSTRIALE DI ENTI E IMPRESE**  
**ASSOCIATION OF PATENT & TRADEMARK ATTORNEYS IN ITALIAN  
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**EU Patent: AICIPI proposals in the light of the decision of the European Council dated 10 March 2011 and the opinion of the European Court of Justice dated 8 March 2011**

With the decision of the European Council of March 10, 2011, the Enhanced Cooperation procedure for the establishment of a Unitary Patent valid in the countries party to that procedure has been given the green light. 25 of the EU countries have joined the Enhanced Cooperation procedure, with the exception of Italy and Spain. Both Italy and Spain have already announced their intention to file an appeal against the Enhanced Cooperation procedure.

Moreover, on March 8, 2011, the European Court of Justice gave a negative opinion concerning the proposal of a single Court for European and Unitary Patents presented by the European Commission.

With regard to Enhanced Cooperation procedure, AICIPI has already expressed in a previous position paper (Annex A) his belief that Italy should join this process.

**AICIPI is aware that such participation is not currently planned, but calls on the Italian Government, for the reasons expressed below, to withdraw from the desire to present its own appeal, which would be additional to the appeal that Spain is willing to submit anyway.**

Furthermore, AICIPI suggests, both for the linguistic and the judicial system, possible solutions that could be used to make a further proposal for compromise. Such solutions, here briefly summarized, are detailed below:

- language system: a solution called "English Soon and Always", with a translation in English starting from the publication of the application (after about a year and a half after filing), if the procedural language is other than English. This translation would be for information purposes only and could be provided as a service and expense of the EU itself;
- the judicial system: limited to EU Member States only, with the establishment of a unified court with exclusive jurisdiction in respect of Unitary Patent (and possibly also of European Patents for the same territory), to which the EU member states transfer the powers of their national courts. All this without affecting the powers of the ECJ and, more generally, the autonomy of Union law.

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Reasons why Italy should not appeal the Enhanced Cooperation

AICIPI considers that the appeal must not be filed for several reasons.

A first reason is that the position of Italy is different from the position of Spain with respect to the Unitary Patent: Italy considers that the Unitary Patent, when granted, should be based, as much as possible, on the use of the English language, while Spain does not seem to want to give up the use of their national language. Therefore, while Italy is at a position of possible convergence to solutions of general consensus, Spain seems set on an absolutely divergent position.

Another reason is that any acceptance of the appeal would be for the industry, the worst of all evils, because it would require a resumption of the debate from the beginning, with an inevitable *impasse* (almost impossible to find a solution acceptable to 'unanimity', inability to use alternative routes in case a decision is not unanimous). To avoid this risk, the solution that seems most appropriate is to isolate Spain in its obstructionist strategy, thus forcing it to reconsider the idea of negotiation, therefore abandoning the appeal.

Italy should therefore emphasize such difference of views and position with respect to Spain, avoiding to file its own appeal and presenting instead its own proposal for a further compromise for the definition of a Unitary Patent. Italy, thereby taking a proactive role in this long history, demonstrating its will to reach a positive and shared solution on Unitary Patent within a reasonable time. It should also be stressed that a definitive failure to adhere to the Unitary Patent would be far more detrimental to the Italian production system than for Spain, as can be easily deduced from existing statistical data which shows that the EP patent applications filed by Italian applicants are about four times higher than EP patent applications filed by Spanish applicants (see <http://www.epo.org/about-us/office/statistics/residence-of-applicants.html>). AICIPI believes that this data further confirms the convenience for Italy to take a proactive role in negotiating with other EU countries rather than to follow Spain in its action against the Enhanced Cooperation procedure.

Proposal for the language system

AICIPI proposes, as regards the procedure up to grant of a Unitary Patent a system that can be defined as "English Soon and Always." Appendix B shows a schematic of this proposal, as described below.

AICIPI stresses the need to facilitate access to the Unitary Patent to the greatest number of users (including European and Italian users). In particular, access to the Unitary Patent should be facilitated in terms of cost of procedures of filing / prosecution / grant, both in terms of accurate and timely information on the existence and content of third party patents.

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In terms of the filing procedure, AICIPI agrees with the proposals circulated so far, which provide that every applicant has the possibility to file Unitary Patent in his own language, with subsequent translation into an official language of the Unitary Patent, by the applicant at a cost reimbursed by the system.

As for the official languages of the Unitary Patent, the proposals circulated so far provide that these languages be English, French and German (so-called "trilingualism"). AICIPI has no objection to this proposal, considering the fact that such a scheme, providing that the applicant chooses between one of three official languages as the procedural language, has already been used for several years by companies that have been filing patent applications internationally, being this system already provided by the European Patent Convention since 1978. Requiring English as a single language of procedure, although preferable, would require substantial changes to the European Patent Convention, resulting in undesirable further lengthening of time and introduction of further elements of uncertainty.

On the other hand, the need to facilitate access to the Unitary Patent to as many users as possible is best met by the use of English which, in fact, in the European (and international) areas is the most used language both in scientific and technological publications, and in business relationships.

In this regard, the compromise proposal presented by the Belgian EU Presidency in the second half of 2010 had already tackled this issue by providing that if Belgium had opted for French or German as procedural language, the applicant should have provided upon grant, a translation of the granted patent in English (so-called "English always"), without legal value.

AICIPI stresses, however, that the compromise proposal presented by the Belgian Presidency would only partially satisfy the need of accurately and timely inform as many people as possible on the existence of patents of third parties. The patent in fact is granted some years after filing (with no foreseeable term), whereas the application is published in the procedural language after 18 months from filing (with an established term).

For the purpose of allowing as many users as possible to know the content of the Unitary Patents in a timely manner, AICIPI therefore proposes to introduce a translation in English starting from the publication of the application, if the procedural language is other than English. This translation would be for information purposes only and for this reason, it could be delivered as a service offered by the EU and at the expense of the same, and not the applicant. The total costs to be incurred would still be low, since the number of applications to be translated would be very limited.

Such a translation, in addition to meeting the need for timely information to the public until when the automatic translations have not yet reached the necessary level of reliability, would be an excellent base to be adapted to also serve as a translation of the text of the granted patent at the end of the examination procedure by applicants, who have opted for French or German during the procedure.

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This translation system would thus ensure the availability of English translations for all Unitary Patents as from their publication (reinforcing the concept of English Always we have called it "English Soon and Always"), and thus the most ample, accurate and timely spreading and understanding of Unitary Patents.

Regarding the availability of English translations of the published patent applications and granted patents, AICIPI believes that it should be guaranteed up to availability (ascertained and accepted unanimously by the EU Member States, or at least accepted unanimously by the founding members) of a reliable automatic translation system.

AICIPI believes that this proposal could also favour companies that decide to use French or German as procedural language, because the availability of an English text since the publication would allow a greater spreading of the innovative content of their patents ( and therefore a "marketability" of their intellectual property), already at an early stage of the claimed technology.

The language should be taken into consideration to assign a weight to the Member States in the redistribution of the allocated share of the fees paid for renewal of a centralized Unitary Patent: Member States that do not have between one of their official languages an official language of the Unitary Patent should be rewarded more. Other factors to be taken into account for the redistribution of amounts due will be the number of applications filed by the Member States Applicants (based on the residency of applicants and not the address of the offices that receive the applications), and / or the population.

Proposal for the judicial system

AICIPI can only take note of the recent negative opinion by the European Court of Justice (hereinafter "ECJ") regarding single European and Unitary Patent Court.

AICIPI agrees, however, with some comments already circulated in the days immediately following the decision of the ECJ, according to which the decision itself indicates a possible way for the establishment of a judicial system based on Unitary Patent on a single supranational court. This applies, in particular, in par. 82 of the decision, citing the case at the Court of the Benelux.

Following the path indicated in par.82 of the ECJ decision, the court system could be restricted to EU Member States, with the establishment of a unified court (hereinafter "UC") with exclusive jurisdiction in respect of Unitary Patent (and, hopefully, also European Patents for the same territory), to which the EU member states transfer the relevant powers of their national courts. All this without affecting the powers of the ECJ and, more generally, the autonomy of Union law, as expressed in the opinion itself (see par. 67).

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According AICIPI the salient features of the new UC should be:

1. Court of first and second instance, with the first instance constituted by a central division and sub-divisions relocated to EU Member States, and a central Court of Appeal.
2. Multinational composition, with the three judges - one "technical" with a background mainly in scientific and patent matters - of different nationalities and belonging to the EU Member States,
3. Exclusive jurisdiction in matters of validity, infringement, declaration of non infringement / invalidity of the Unitary Patents (and possibly national validations of European Patents in the EU member states).
4. Decisions with immediate effect all over the responsibility of UC (i.e. validation countries included in that territory in the case of European Patents).
5. Competence of local divisions: actions of infringements and counterclaims for invalidity only, with established jurisdiction - as usual – on the basis of the domicile of the defendant or "loci delicti commissi". The actions of nullity are instead presented only in the central division, which is also responsible for any infringement proceedings that follow such action.
6. Language rules: the languages of the judicial system is naturally linked to the language rules of the Unitary Patent. AICIPI suggests a possible linguistic system based on the following points:
  - a. The certified text of the patent is in the language in which it was granted.
  - b. The court of first instance takes a multitude of languages, according to the criterion that each delocalized sub-section indicates its national language and possibly one or more other languages, on which it expects to conduct the proceedings; the central division, at least, must have the three languages of grant of Unitary Patent among its procedural languages.
  - c. The language of the proceedings of a particular case is ultimately determined by the defendant. The relevant dynamics is started by the plaintiff, beginning the action at a competent delocalized sub-section in the language of his choice among those admitted by said sub-section as, procedural language. The defendant may request that the language of the proceedings be one of the three official languages of the European Patent Office. If that language is not among the languages of the chosen section, the jurisdiction shifts to the central division. Actions started at the central division, e.g. declarations of non-infringements, the plaintiff may only choose one of three official languages of the EPO.
  - d. If the language chosen by the defendant is English and the plaintiff's opposing patent is in another official language, the English translation of that patent is relevant to determine the scope of protection afforded by the claims, in order to establish the infringement (as it is now for translations into national languages, with the possibility of filing amendments, that do not broaden the scope of protection rights, arising in good faith, etc. ..)

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