Intellectual Property Lawyers' Association

from the Chairman
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Lord Faulks QC
Ministry of Justice
102 Petty France
London
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Cc (by email only): Baroness Neville-Rolfe
Sam Allen

Dear Minister

UK Judges in the Unified Patent Court (UPC)

This letter sets out the views of the Intellectual Property Lawyers' Association (IPLA) on the criteria for appointment of judges in the Unified Patent Court from the UK, on which the Ministry of Justice is currently working.

Summary

1. It is important that the UK voice is heard as fully as possible in the judicial panels of the UPC.

2. To this end IPLA fully supports the Ministry of Justice in seeking to set terms which will enable current UK patent judges to participate in the UPC to the fullest extent possible.

3. IPLA urges the Ministry not to limit eligibility for appointment as a judge in the UPC, either expressly or through proposing assessment criteria for the Advisory Committee to apply, any more narrowly than section 10 Senior Courts Act 1981 (lawyers with 7 years' relevant experience). Otherwise there will be too few candidates to provide the number of UK judges required to give the UK a sufficient voice in how the new court develops.

Details

The Intellectual Property Lawyers' Association (IPLA) is an association of solicitors' firms with a specialised practice in intellectual property litigation. Member firms are responsible for most patent and other intellectual property litigation in the Patents Court, and for a substantial proportion of litigation in the former Patents County Court and in the Intellectual Property Enterprise Court.

The Unified Patent Court is an important project which will for the first time establish a supra-national court to hear litigation between private parties. It will enable owners of European Patents to litigate them before a single court for most European countries, rather than having to conduct separate cases in every country under the local part of the European patent. A measure of the

new Court's importance is that the Prime Minister took personal charge of the final stages of negotiation of the international agreement which established it.

We understand that the Ministry of Justice is leading the discussion with the Preparatory Committee for the UPC on the qualifications necessary to enable UK candidates to be considered by the UPC Advisory Committee for appointment as UPC judges. IPLA believes that it is important that the qualifications are specified in such a way that a sufficient number of UK candidates will be available, so as to give the UK a proper voice on judicial panels in the new Court across Europe, and not just in London.

UK judges, unlike their continental colleagues (who are generally appointed straight after completing their academic studies), have extensive experience of private practice, and are thus in a better position to appreciate the commercial issues lying behind the legal issues in a case. This, coupled with a more sophisticated and complex procedure, tends to make UK decision-making more pragmatic and nuanced. IPLA believes that it will greatly benefit the new court, as it develops a synthesis of national approaches to the law and procedure, that the UK approach is as fully represented as possible.

The existing English patents judges have a very high international reputation and have been actively involved in the formation of the new court. In the view of IPLA it is important for the success of the new court that they are enabled to play a full part in it. At national level, this means that there needs to be an arrangement whereby they can move between the High Court and the UPC, either dividing their time between the two as required, or perhaps spending fixed periods of time on secondment to the new court. IPLA would urge the Ministry of Justice to use its good offices to achieve this.

In addition, at UPC level, it is important that the terms of employment for UPC judges are commensurate with those for UK judges, as otherwise there will be a positive disincentive on present and future UK judges from applying for judicial office in the new court. We understand that the international negotiations on this issue are delicate, and we would encourage the Ministry to do its utmost to agree terms which are good enough not to discourage the English judges from applying. If this cannot be agreed at UPC level, then IPLA would urge that an appropriate arrangement be made at national level.

The second problem relates to the qualification for appointment as a UPC judge. Article 15(2) of the UPC Agreement requires that "Legally qualified judges shall possess the qualifications required for appointment to judicial offices in a Contracting Member State". IPLA understands that national Ministries of Justice are advising the UPC authorities what those qualifications are in their own countries. For the UK, we understand that the view has been taken that "judicial office" means a High Court, not County Court judge. The qualification for High Court judges is set out in section 10 of the Senior Courts Act 1981 ("Appointment of Judges") – in essence, any person is qualified who "satisfies the judicial-appointment eligibility condition on a seven year basis".

Although this position seems entirely clear, we understand that it has been suggested that different criteria should be set, either as express eligibility criteria or as soft assessment criteria for the Advisory Committee, based on who is already qualified to sit as a Deputy High Court Judge under section 9(1) or (4) of the Senior Courts Act 1981. IPLA urges that this is wrong as a matter of law and wrong as a matter of policy.

As a matter of law, it is clear that "qualifications required for appointment to judicial offices" means just that, and not that a person has actually been appointed. Indeed, section 9(4) draws this distinction when it says that "... the Lord Chief Justice ... may appoint *a person qualified for appointment as a puisne judge of the High Court* to be a deputy judge of the High Court ...".

Moreover, since this is a matter of law, it is not open to the Government to put forward one interpretation and subsequently to change it if, for example, it turns out that there are too few UK candidates in the future, unless the law itself is changed.

As a matter of policy, it is very important, for the reasons given above, that the UK's voice is heard as broadly as possible within the new court, in all the Divisions across Europe. However, if UK candidates to the UPC judiciary are limited to existing judges and deputies, it is likely that few will be willing and able to spend significant amounts of time in courts outside the UK, where the UK voice most needs to be heard.

Furthermore, there would be very few potential candidates. At first instance, there are four High Court patent judges (a further eight High Court judges are designated to hear less technically complex patent cases, but few if any will meet the requirement for "proven expertise in the field of patent litigation" without additional training; IPLA's perception is that none of them will want to spend time in a court where the judges sit in panels of three and hear exclusively patent cases under a new and unfamiliar procedure). The five senior barristers with extensive patent experience who hold a "section 9 ticket" as Recorders or Deputy High Court Judges will not be eligible, if they wish to be only part time in the UPC, unless there is a dispensation under Article 17(2) of the UPC Agreement. Even if one ignores the requirement in the Statute (Article 3(2)) that the Advisory Committee puts forward "at least twice as many candidates as there are vacancies", there would be barely enough UK candidates at the outset (and maybe none if the judicial employment terms are unattractive to existing judges), and no ready means of increasing the number if the court takes off.

By contrast, there are in Germany 120 judges in the Federal Patent Court, and about 40 judges who sit in the specialist patent chambers in the District Courts, all of whom are likely to be candidates to sit as UPC judges, at least on a part time basis.

There are, we believe, a number of senior practitioners (both barristers and solicitors) who qualify under section 10 of the Senior Courts Act 1981, who have no ambitions for judicial office in the UK (which requires deciding all kinds of cases not just patents), who would be willing to sit in the UPC – and could do it very well – but who would be excluded if the hard or soft eligibility criteria were set more narrowly than section 10 at a "section 9 ticket".

Many, if not most, of these practising lawyer candidates will want to continue their practice when not working as a UPC judge, and so will need the Administrative Committee's exception under Article 17(2) of the UPC Agreement, which is required if UPC judges are to engage in another occupation. The number of candidates will be increased if it could be confirmed at the time when applications are solicited that this exception will be granted for practising lawyers, provided that there is no conflict of interest (as under Article 17(4) for part time technical judges), as a routine matter and not just an occasional exception. If this cannot be done, it will close the door to existing (and future) Deputy High Court judges, and indeed everyone except existing judges, and barristers and solicitors who wish to retire from private practice.

The initial selection of UPC judges will be made by the Advisory Committee of the UPC (composed of senior judges and practitioners), doing for the UPC essentially what the JAC does for the UK courts. Setting eligibility criteria which will maximise the number of UK candidates will mean that the Advisory Committee has the widest possible field from which to select the very best of the candidates from the UK. Limiting the field to people who have already passed through a JAC selection procedure will exclude top quality candidates who want to serve in a "patent only" court and not in the High Court.

The UPC will initially share jurisdiction with the national courts during a seven year transitional period. Thereafter, it will have exclusive jurisdiction over all cases involving infringement or validity of patents granted by the European Patent Office. There will be virtually no patent litigation in the UK courts (if the new system is a success, few patents will be granted by national patent offices). At this time, the only opportunity for sitting as a judge in patent cases will be in the UPC; it would be absurd if the only people eligible to do this are those who have been selected to judge all sorts of cases in the UK, and have judicial experience of everything except patent cases.

Representatives of IPLA are willing to meet the relevant officials in the Ministry, or to facilitate meetings with representatives of Industry, which, as the ultimate user of the court, is probably the most important stakeholder.

Yours faithfully

Rowan Freeland
Chairman, IPLA