



MODIANO
& PARTNERS

P O R T O L A N O
C A V A L L O

The role of the Technical Judge at the UPC

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DISCLAIMER

Any opinion expressed in this presentation, orally or in writing, is the personal opinion of the author (Alessandro Sanchini) and in no way it represents the opinion of the UPC or the opinion of other Technically Qualified Judges of the UPC.



Expectations

The new Unified Patent Court

- quality
- predictability
- fast decisions

The Italian revolution of 2003

All patent related cases are handled by “IP specialized courts” :

Expectations before the entry into force of Italian IP courts:

- quality
- predictability
- faster decisions

The system introduced in 2003 has created judges with specific expertise in patent litigation

The Italian Patent Judge

Italian Patent Judges know:

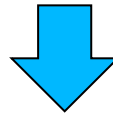
- The civil law
- The civil procedure
- the Industrial Property Code, which came into force in 2015, collecting in a single text all the articles relating to IP

and

- must be able to understand, to the extent that is possible, the technology that is necessarily involved in patent litigation.

Patent Judges and technical issues

- **Patent description and drawings** must be read and understood;
 - **The prior art** must be read and understood to get the perspective of the person skilled in the art at the priority date;
 - **Claim features** must be understood and interpreted (claim construction) to assess validity and infringement.
- Patent judges must to acquaint themselves with the technology and the technical facts of the case but the complexity of the technology can be beyond their reach.



Need of technical assistance: technical “assistant” or technical “expert”?

The «CTU» at Italian Patent Courts

CTU stands for “Consulente Tecnico d’Ufficio”. In English, the CTU is often referred to as the “CTE” = Court's Technical Expert.

However, the CTU is NOT a technical “expert”, i.e. he is not a technician with outstanding knowledge or experience in some specific technology. The CTU is a technically educated person with a technical background such that he can easily understand the technical aspects involved in the lawsuit

99% of the times the CTU also has a "legal" background, i.e. knowledge of the "patent law"



THE CTU IS A PATENT ATTORNEY WITH SOME 10+ YEARS OF EXPERIENCE

Italian Court vs UPC

Writ of summons,
Statement of defence,
Briefs ex Art. 183(6) cpc.
Parties may request the
appointment of a CTU

Legal
Phase

Judge assesses the case
and has the option to
appoint a CTU to assist on
patent validity and
infringement

Technical
Phase

Judge's decision takes into
account (but is not bound
to) the CTU's opinion

Legal
Phase

Writ of summons,
Statement of defence,
Rejoinder.
Parties may request
the appointment of a
TQJ

Written
procedure

The Judge assesses the
case and has the option to
add a TQJ to assist on
patent validity and
infringement

Interim
procedure

The TQJ takes part in
the decision

Oral
procedure

UPC: composition of the board

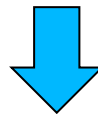
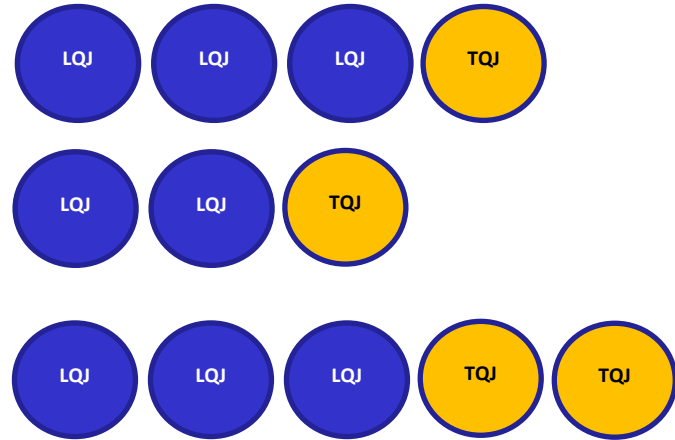
Courts of First Instance (Art. 8 UPCA):

- **Local and Regional Divisions:** three LQJs + (optionally) one TQJ

- **Central Division:** two LQJs + one TQJ

Court of Appeal (Art. 9 UPCA):

three legally qualified judges + two TQJs



TQJs are always a minority in any panel

TQJ candidates

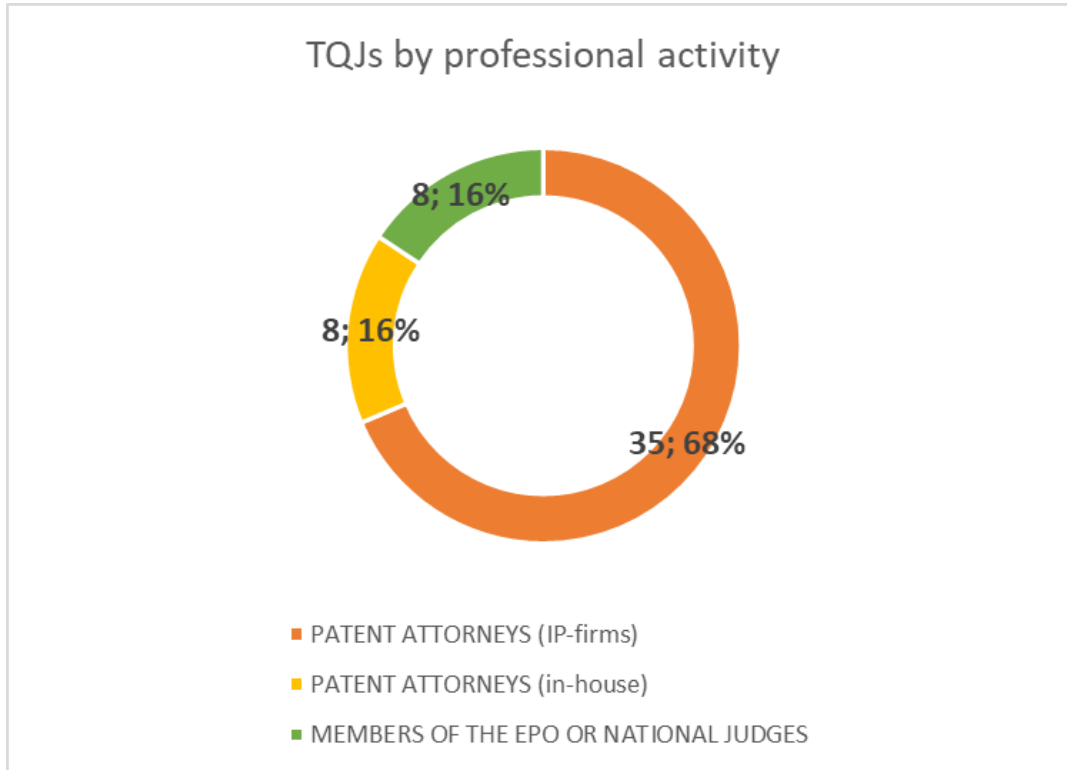
A person

- with a strong technical background
- a strong knowledge of the patent law
- familiar with patent litigation
- is a **valuable aid** for legally qualified judges to understand the technical aspects of the case better and quicker

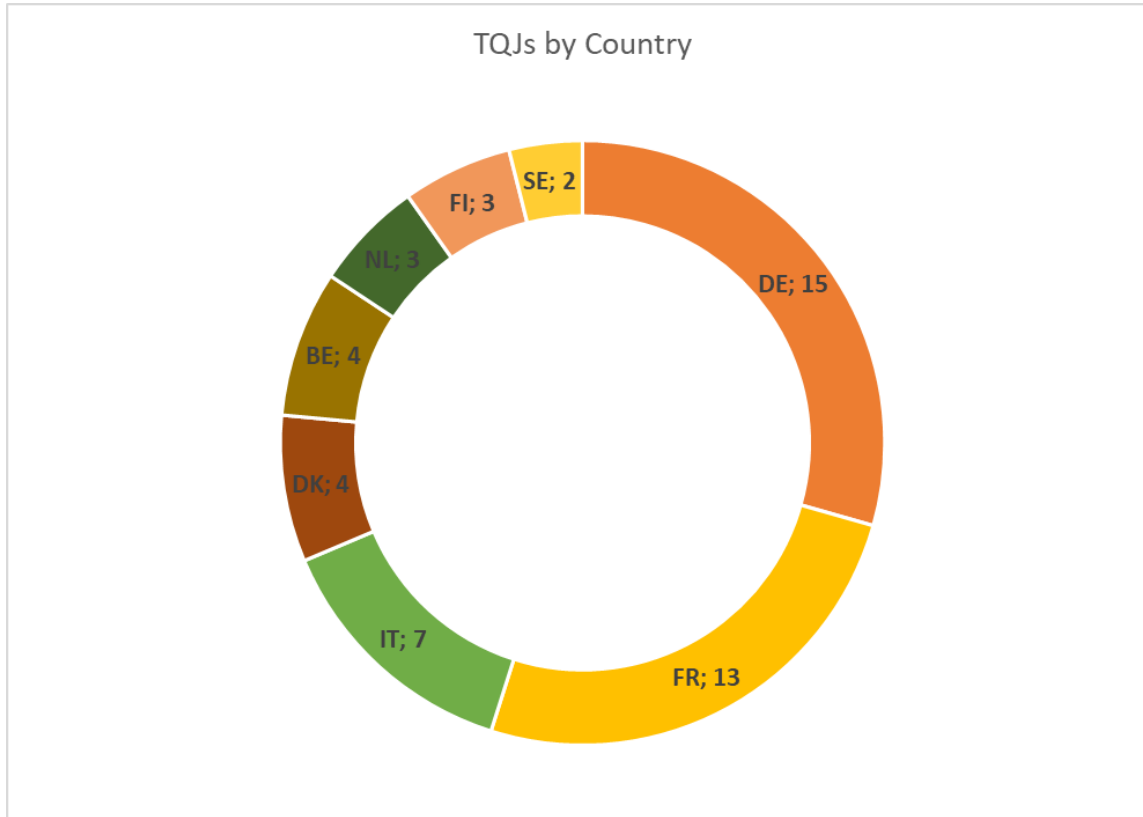


Such person is the CTU in Italy and the Technical Judge at the UPC. Italian Experience and selection of TQJs at the UPC proves that most suitable candidates are Patent Attorneys

The 51 TQJs at a glance



The 51 TQJs at a glance



Technical aspects of patent litigation

Both the Italian system and the UPC system provide for technical aid to legal judges by technically educated persons having a strong knowledge of the patent law.

All of the Italian TQJs are also CTUs.

- In Italy, CTUs only provide an opinion to assist the (legal) Judge whereas at the UPC the TQJs take part in the court's decision



The UPC system largely reflects the Italian system in the way technical aspects are handled by the Court, which:

- proves that the Italian systems is a good system;
- Italian Lawyers and Patent Attorneys will feel at home before either Court.

Hot topic – Conflict of Interest

Ideal world:

- **Italy:** the Court can afford to employ full-time CTUs and CTUs work only for the Court
- **UPC:** the Court can afford to to employ full-time TQJs and TQJs work only for the Court

Real world:

- **Italy:** CTUs are appointed when needed. CTUs may exercise other functions, provided there is no conflict of interest. CTUs can recuse themselves and the parties can recuse them.
- **UPC:** TQJs are appointed when needed. Part-time TQJs (i.e. all TQJs) may exercise other functions, provided there is no conflict of interest. Code of Conduct is under definition and so far it is exceptionally strict (much stricter than provided by national regulations).



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