

**Non-binding Guidance
for the use of the
“General Template for Decision – UPC CFI”**

Decision in an action for a declaration of non-infringement

DECISION

of the Court of First Instance of the Unified Patent Court

Central division (Paris Seat or Munich Section)/ Local division in ... / Regional division in ...

delivered on ... [dd month in words yyyy]

concerning ... [EP/UP/SPC/EP application at issue]

HEADNOTES: ... [required by R. 67 RegR] [to be provided by the Judge-rapporteur]

KEYWORDS: ... [required by R. 67 RegR] [to be provided by the Judge-rapporteur] declaration of non-infringement; interest to act; performance of specific act; proposed act; assertion that act constitutes infringement; request for confirmation of non-infringement; warning letter; parallel infringement action at LD/RD; stay of proceedings at CD; consultation between presiding judges; claim interpretation; value of the action; ... (non-exhaustive list for illustrative purposes)

REFERENCE CODE ECLI: ... [required by R. 67 RegR] [to be provided by the Deputy-Registrar]

CLAIMANT:

... [name and postal address]

represented by ... [academic title (where applicable), name, national professional title, firm]

assisted by ... [academic title (where applicable), name, national professional title, firm]

DEFENDANT:

... [name and postal address]

represented by ... [academic title (where applicable), name, national professional title, firm]

assisted by ... [academic title (where applicable), name, national professional title, firm]

PATENT AT ISSUE (data to be retrieved in databases of the EPO)

European patent n° ... [hereafter referred to by its last three digits, e.g. EP 789]

[or European patent with unitary effect n° ... [e.g. UP 789]

[or Supplementary protection certificate ... [e.g. SPC 789]

[or European patent application n° ... [e.g. EP application 789]

PANEL/DIVISION

Panel [in divisions having more than one panel number of the panel: ...] of the Local [or: Regional] Division in ... [or: of the Central Division (Paris Seat) or: of the Central Division (Munich Section)]

DECIDING JUDGES OR: DECIDING JUDGE [R. 350.1(c) RoP]:

[in case the panel is delivering the Decision]

This decision has been delivered by the presiding judge ..., the legally qualified judge ..., the legally qualified judge ... and the technically qualified judge ...

[or: ... by the presiding judge..., the legally qualified judge... and the legally qualified judge ...]

[in case a single judge is delivering the decision]

This decision has been delivered by the *single judge* ...

SUMMARY OF FACTS [R. 350.1(f), 4 RoP]

Facts and evidence that may be addressed:

- Facts and evidence relating to the Claimant's request that the performance of the following specific act or acts does not or the following proposed act would not constitute an infringement of EP / UP / SPC/ EP application 789 [R. 61.1 RoP]: ...

- Facts and evidence concerning Claimant's interest in a declaration of non-infringement by the court [R. 61.1 and R. 61(a) and (b) RoP]:
 - the Defendant (patent proprietor or licensee entitled to commence infringement proceedings under Art. 47 UPCA) has asserted that the act constitutes an infringement, as follows: ... [in writing / orally, dd month in words yyyy, e.g. warning letter, ...]
 - or
 - a written request (providing full particulars of the act in question) has been sent by the Claimant on [dd month in words yyyy] to the Defendant (patent proprietor or licensee) to give written confirmation of non-infringement – but such a confirmation has not been received within a period of one month
 - or
 - the Defendant (patent proprietor or licensee) is known to have taken the following steps ... [e.g. warning letter dated [dd month in words yyyy] or infringement action brought on [dd month in words yyyy]] against the following third party ... [e.g. company]] to enforce the patent rights

- Facts and evidence relating to the Defendant's assertion that the performed or proposed act or acts constitute an infringement: ...

- Facts and evidence concerning a denial of Claimant's interest in a declaration of non-infringement: ...

[Free text]

INDICATION OF THE PARTIES' REQUESTS [R. 350.1(e), 4 RoP]

[For Optional standard text see DECISIONS (INCLUDING ORDERS)]

THE CLAIMANT'S REQUESTS

The Claimant seeks

- a declaration of non-infringement

THE DEFENDANT'S REQUESTS

The Defendant (patent proprietor or licensee) requests the action for a declaration of non-infringement be

- dismissed

or

- referred to the local or regional division in ... [because an action for infringement relating to the same patent [EP/ UP/ SPC/ EP application 789] against the Claimant has been brought before that local or regional division, Art. 33(4), 2nd sentence UPCA]

or

- stayed [because the Defendant (patent proprietor or licensee) has brought before the local or regional division in ... an action for infringement against the Claimant relating to the same patent [EP/ UP/ SPC/ EP application 789] within three months after the date attributed to the action for a declaration of non-infringement, Art. 33(6) UPCA and R. 76.3 RoP]

or

- ...

[Free text]

MAIN STEPS IN THE PROCEEDINGS [OPTIONAL]

[Free text]

[Optional standard text]

(in case an action for infringement relating to the same patent [EP/ UP/ SPC /EP application 789] against the Claimant has been brought before a local or regional division [Art. 33(4), 2nd sentence UPCA])

Considering that fact ...

(In case an action for infringement has been commenced before a local or a regional division more than three months after the date attributed to the action for a declaration of non-infringement) (R. 76.3 RoP)

Considering

- the consultation between the presiding judges of the central division and a local or regional division and (if applicable)
- the information about any agreement on future progress of the proceedings (including the possibility of a stay of one action under R. 295(k) RoP)
- the stage reached in the proceedings relating to the action for a declaration of non-infringement

[Free text: Other procedural matters]

POINTS AT ISSUE [R. 350.4 RoP]

[Free text]

FOUNDATIONS FOR THE DECISION [R. 350.1(g), 4 RoP]

Aspects to be addressed:

- legitimate interest of the claimant in a declaration of non-infringement [R. 61.1 RoP]
- interpretation of the claims of EP / UP / SPC / EP application 789 with regard to alleged infringement, including discussion of person skilled in the art (as far as necessary)
- does the Claimant's performed act infringe the patent?
or
- would the Claimant's proposed act infringe the patent?
- do the acts (performed or proposed by the claimant) fall within the scope of the claims?

DECISION INCLUDING ORDERS (OPERATIVE PART) [R. 350.2, 1ST SENTENCE RoP]

Optional standard text (for example)

Declaration of non-infringement

- It is declared that ...
 - *[in case of a direct infringement of a product patent and to the extent requested by the Claimant, Art. 25 (a) UPCA:]* making, offering, placing on the market, using or importing or storing for these purposes of a product with the following features ... *[as specified in claimant's requests and found appropriate by the court]* does not infringe or would not constitute an infringement of EP / UP / SPC / EP application 789.
 - *[in case of a direct infringement of a process patent and to the extent requested by the Claimant, Art. 25 (b) UPCA:]* using or offering for use a process with the following features ... *[as specified in claimant's requests and found appropriate by the court]* does not infringe or would not constitute an infringement of EP / UP / SPC/ EP application 789.
 - *[in case of a direct infringement of a process patent from which a product is directly obtained and to the extent requested by the Claimant, Art. 25 (c) UPCA:]* offering, placing on the market, using, or importing or storing for those purposes a product with the following features *[as specified in claimant's requests and found appropriate by the court]* does not infringe or would not constitute an infringement of EP / UP / SPC/ EP application 789.
 - *[case of an indirect infringement, Art. 26 UPCA]* supplying or offering to supply of a product with the following features ... *[as specified in claimant's requests and found appropriate by the court]* does or would not constitute an indirect infringement of EP / UP / SPC/ EP application 789.

or

Dismissal of the action for declaration of non-infringement

- The action is dismissed
- The action is dismissed for the rest.

or

Referral of the action for declaration of non-infringement to the competent local or regional division (in case an action for infringement relating to the same patent [EP/ UP/ SPC/ EP application 789] against the Claimant has been brought before a local or regional division [Art. 33(4), 2nd sentence UPCA])

- The action for the declaration of non-infringement is referred to the local or regional division in ...

or

Stay of the action for declaration of non-infringement (in case an action for infringement has been commenced before a local or a regional division not more than three months after the date attributed to the action for a declaration of non-infringement) (Art. 33(6) UPCA and R. 76.3 RoP)

- The action for the declaration of non-infringement of EP / UP / SPC 789 / EP application 789 is stayed. Cost decision in principle [Art. 69 UPCA, R. 118.5 RoP]
 - The Claimant *[or]* Defendant is to bear the legal costs of the proceedings *[or]*
 - The Claimant is to bear ... % of the legal costs of the proceedings and the Defendant ... %.

Done and Delivered on ... [R. 350.1 (b) RoP]

[note: In case the decision is rendered in writing at the end of the oral hearing, the date of delivery is the day of the oral hearing (even if grounds are issued later on)]

NAMES AND SIGNATURES	
<p>Judges <i>[Art. 8 UPCA, Art. 35(5) UPCS]</i> Presiding judge ... Judge-rapporteur ... Legally qualified judge ... Technically qualified judge ... <i>[Or: Single judge: ...]</i></p>	<p>Deputy-Registrar <i>[Art. 35(5) UPCS]</i> Deputy-Registrar...</p>

Information about appeal

An appeal against the present Decision may be lodged at the Court of Appeal, by any party which has been unsuccessful, in whole or in part, in its submissions, within two months of the date of its notification (Art. 73(1) UPCA, R. 220.1(a), 224.1(a) RoP).

Information about enforcement (Art. 82 UPCA, Art. 37(2) UPCS, R. 118.8, 158.2, 354, 355.4 RoP)

An authentic copy of the enforceable decision or order will be issued by the Deputy-Registrar upon request of the enforcing party, R. 69 RegR.