



3 September 2013

BUSINESSEUROPE COMMENTS ON THE DRAFT RULES RELATING TO UNITARY PATENT PROTECTION SACEPO WPR 10/13 of 28.06.2013

BUSINESSEUROPE appreciates the opportunity as an observer of the Select Committee to provide at an early stage its views on the draft rules relating to Unitary Patent Protection.

GENERAL COMMENTS

The new system [European patent with unitary effect (UP) and UPC-Unified Patent Court] is a complex one, with different portions arising from different sources of law and law provisions. Yet, it is a system that can only operate as a functionally coordinated ensemble of all its elements. Consequently, working on these Rules needs to be taking into account the parallel work on the UPC Rules of Procedure (RoP) as well as the coming Rules on some aspects of the Translation Regulation (EU Regulation 1260/2012) and Regulation on Fees relating to the UP in order to have the new system “ready to operate on day one”.

In this respect, a key element is the availability of a common and user-friendly interface for the various “Register(s)” provided for in the Regulations and UPC. While it is clear that these “registers” satisfy different purposes and will be under the responsibility of different entities, it is in fact functionally important that they are from the outset reciprocally compatible. This will allow users to easily navigate from one to the other as a functionally unitary repository of information relating to the whole history of a given patent from its initial filing to any subsequent Court action (under the UPC at least) to its lapse or revocation. Also, the system should be reasonably easy to search and extract information out of it, on the basis of a minimum number of criteria. It should allow for interested users to be automatically updated by the system itself on events relating to a certain patent(s), as it is currently the case e.g. with the RegisterAlert system of the EPO.

Another area of functional integration is likely to be represented by the electronic infrastructure for the case management. While admittedly it might be more complicated and demanding for the operations under the UPC, it might be that synergies are found already at the beginning in trying to develop a functionally integrated common infrastructure.

This is a coordinated effort where each participating entity must bear its own responsibility. As far as the EPO is concerned, all the activities in this matter should be based as much as possible on the current features of the European Patent register and its ongoing development, minimizing any duplication of efforts. Also, any additional expenses must evidently follow the principles on expenses prescribed in Art 10 of EU Regulation 1257/2012.



PRELIMINARY DETAILED COMMENTS, RULE BY RULE¹

Rule 2:

- I. We would like to propose amending as follows...(1)(b) the Rules Relating to Fees **relating to the European patent with unitary effect**

Rule 3:

- I. We would like to propose amending as follows...(2) Article 10, **paragraph (1)**, paragraph (2)....

Rule 4:

- I. ..(2)(b) please *maintain the* “date on which the mention of the grant is published in the European Patent Bulletin”, as the relevant date, coherently with Art 4(1) and Recital (8) Unitary Patent Regulation (UPR).
- II. ..(2)(a) consider modifying “proprietor” in “proprietor(s)” or adding “or proprietors” after “proprietor”, to clarify that the UP can be requested also in case of multiple proprietors for the perspective unitary title.. (see also Art 7 UPR)

Rule 5:

- I. The request should be a highly automated (in its essential entries in particular), electronic form, very quick/friendly to fill in: the information should be directly conveyed into the EPO “register” system, and processed rapidly and automatically with a minimum, essential and substantial check on EPO side **before** releasing entry in the register, of course.
- II. It should not be necessary to fill in detailed information on name and address of the proprietor(s) and representative; it should be assumed that the data in the European patent register still apply, unless reported to be different by the requester..
- III. It should be considered adding a paragraph to clarify that in case of several proprietors registered for the UP, the request must be made by or on behalf of all of them. If a request is made by a European patent attorney or by a common representative (Rule 151 EPC), the request should be presumed to have been made on behalf of all proprietors.
- IV. ... (2)(a) Additionally, it is worth considering clarifying that “the proprietor”(that can be also a plurality as indicated above and in the Explanatory remarks to Rule 4, section 2) which is mentioned at paragraph (2)(a) is/are **those of record on the day of publication of the mention of grant on the European**

¹ Proposed additions are in bold and underlined, while deletions are indicated by square brackets, [..]). Each comment within a rule is indicated by a progressive Roman numeral, to make subsequent reference possibly easier.



patent Bulletin (Consequently, as long as they remain the same, a request for unitary protection can be filed as early as the date of notification of a communication under R 71(3) as envisaged in the Explanatory Remarks to Rule 5, section 3, otherwise the request must be confirmed/done again by or on behalf of the proprietor(s) of record on that date).

- V. Consider adding a paragraph to this Rule (or add a dedicated rule) to time limit calculations, in line with R 131 EPC, if necessary for clarity/ease of reference purposes.
- VI. For the 1 month period under this rule, the possibility of “conditional” early payment as outlined in the Explanatory Remarks should be clearly indicated, by way of notes/guidelines addressed to the interested users, in addition to the Explanatory Remarks.
- VII. We would like to propose amending as follows paragraph.(2)(d): **So long as required under Art 6 EU Regulation 1260/2012**, a translation...

Rule 6:

- I. ..(1)...: consider if compatible with UPR to align “date of registration” – see Art 18(2) second sentence - with “date of publication of the mention of grant...”(see e.g. Art 4(1) UPR) : practically much preferable for third parties to know at the earliest date and with certainty the territorial scope of the UP, independently of the actual length that the “registration” process (that may be very subjective/case specific e.g. the case of restitutio or refusal followed appeal proceedings...). That indeed may end up treating differently European Patents having the same date of grant.

Rule 7:

- I. ..(2): ...consider adding the sentence : “unless the new proprietor confirms the statement under paragraph 1 at the time of requesting the change of proprietorship with the EPO”, at the end of this paragraph to possibly make procedures simpler in such a specific case where the new proprietor likes the “unitary” choice made by the previous -unlawful- owner of record.

Rule 9:

- I. Always use the terminology under Art 2(d) UPR, i.e. “European patent with unitary effect”.



Rule 13:

- I. ..(q) and (r) : are there indeed interruption/stay and resumption of the proceedings under UPR ? If so, probably a rule specifying conditions, terms etc. is required, otherwise these paragraphs can be possibly deleted.

Rules 14 and 16:

- I. It should be considered adapting the wording, if necessary, to accommodate plans for electronic-only public dissemination of information.

Rule 17:

- I. It should be considered making them more immediately understandable e.g. by adding also a title or shortcut sentence to point to the subject matter to which the cited article/rule refers to.
- II. It should be considered adding A 116 (oral proceedings, e.g. in case of re-establishment of rights), A 168 (territorial field of application) and A 175 (preservation of acquired rights) to the list of EPC articles and R 4, 115, 116 (all relating to oral procedure), and R 133 (late receipt of documents) to the list of provisions of the EPC Implementing regulation

It should be considered allowing correction of translations filed under art 6 UPR at any time, with the correction taking effect on the date of its filing

Rule 19:

- I. We would like to propose amending as follows...” shall be reasoned and shall [...] **point out** the possibility of bringing an action before the Unified Patent Court “. [...]

Rule 20:

The text of the rule it appears to be fine under the current UPC RoP. However, we would like to propose considering a simplified system. Since it is a matter at the interface between implementing the EU regulations and implementing the UPC Agreement, we'll indeed propose that our proposal be considered under UPC RoP. For information here is an outline of what we consider a simpler system, in this respect.

- I. The mechanism of Appeal to UPC should be such that **the fee for Appeal becomes due only after e.g. 1 month from the expiration of the time for the Interlocutory revision by the EPO**, without it having rectified its decision to the extent that the Appellant considers that the Appeal is no longer necessary.
- II. In so doing, **the perspective Appellant will be required to file only the reasons of its appeal to trigger the time limit for the interlocutory revision by the EPO.**



- III. **If a decision is revised by the EPO to an extent that the patentee considers it to be satisfactory**, the Appeal is either expressly withdrawn or “abandoned” by non-paying the fee in time.
- IV. **In such a case the UPC does not get any fees but has no work to do.** The alternative of paying the fee and then someone (EPO or UPC) having to order reimbursement of the fee if equitable, requires work and time consumption that does not appear to be justified under the circumstances.

Alternatively, one may consider a system where the fee is paid to the EPO (who receives also the initial appeal documents), who either refunds it upon interlocutory revision favorable to appellant or otherwise forward it to UPC within the prescribed terms.

Rule 21:

We believe that the text of the rule, par (1) in particular, should be brought more in line with e.g. Art 13 of Regulation 1257/2012. Consequently, to keep the text of the rule in line with Art 10 of the EU Regulation, we would propose deleting the term “renewal” in the penultimate line of paragraph (1), since the quoted article of the Regulation refers more generally to “fees” generated...

A suggested wording for this paragraph could therefore be:

- I. The costs incurred by the European Patent Office in carrying out the tasks entrusted to it in accordance with Article 9, paragraph 1, Regulation (EU) No. 1257/2012 have to be borne by the participating member states pursuant to Art 146 EPC and shall be covered by the [...] fees generated by the European Patent with Unitary effect pursuant to Art 10 Regulation (EU) No 1257/2012, in particular the renewal fees under Art 11 of the EU Regulation, having regard of the distribution principles provided for its Art 12(1).

OTHER ISSUES TO BE CONSIDERED/DISCUSSED:

- Applicability of Art 138 EPC (different claims, description, drawings..) to UP and insertion of a reference to it in Rule 17 above.
- Provision on compensation scheme for translation costs (implementing Art 5 UPTR, EU Regulation 1260/2012).
