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BUSINESSEUROPE COMMENTS TO DRAFT RULES RELATING TO UNITARY PATENT PROTECTION¹

The procedures for requesting and obtaining unitary effect should be as straightforward and expeditious as permitted by the Regulation 1257/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (hereinafter called the Regulation).

While this objective seems to be shared by the EPO in the draft Rules relating to Unitary Patent Protection (UPP) (see comment 1 to Rule 7), some of the Rules do not help to meet it. Rule 6 for example contains several unnecessary requirements.

DETAILED COMMENTS

RULE 5 – THE REQUEST FOR UNITARY EFFECT - GENERAL

BUSINESSEUROPE supports the text proposed in the latest version of the draft Rules SC/22/13 as most consistent with the text of the Regulation.

RULE 6 – REQUIREMENTS OF THE REQUEST FOR UNITARY EFFECT

We would like to reiterate our concerns regarding the unnecessary duplication between the information already on file and the information required in the request for unitary effect. This is particularly the case for the details of the proprietor and of the representative. Only in case the information has changed, this should be indicated on the request. The more information is required in the request, the greater are the chances of mistakes to the detriment of an expeditious handling of the request.

- THE HANDLING OF EUROPEAN PATENTS GRANTED TO MULTIPLE OWNERS

The case of several owners of the granted European Patent (EP) should be handled not differently from the case of a single owner for the same territory: If the request is filed by the professional representative of record for the grant procedure it should be accepted as a declaration under her/his responsibility that the act is being performed according to the mandate received by the owners of the right.

Otherwise a common representative (as defined in Rule 151 EPC) can act on behalf of the multiple proprietors.

RULE 7 – EXAMINATION OF THE REQUEST BY THE EUROPEAN PATENT OFFICE

¹ BUSINESSEUROPE will use the numbering in the latest version of the draft Rules in document SC/22/13 regarding Rules 1-11. Regarding the subsequent rules, the numbering of document SC/16/13 is followed.



BUSINESSEUROPE believes that the “date of registration” of the UPP request should be defined in the rules in a way that allows certainty for third parties and patentees as well. Since the Regulation itself does not give such a definition, it should be defined in the Rules. BUSINESSEUROPE proposes to introduce a definition in Rule 6 (1) that mirrors article 4(1) of the Regulation, i.e. to align the “date of registration” [see Art 18(2) second sentence] with the “date of publication of the mention of grant of the European patent in the European patent bulletin”. This latter date is in fact the date indicated in Art 4(1) of the Regulation as the date on which **the unitary effect shall take effect in the participating Member States.**

This approach is much preferable in practice also for third parties. In this way, they know at the earliest possible date and with certainty which will be the territorial scope of the potential UPP, independently of the actual length of the registration process (that may be very subjective/case-specific e.g. restitutio or refusal followed by appeal proceedings).

We suggest amending Rule 7, paragraph (1) consequently, along the following lines:

- (1) If the requirements under Rule 5, paragraph 2, are met and the request for unitary effect complies with Rule 6, the European Patent Office shall register the unitary effect in the Register for unitary patent protection and communicate it to the requester. ***In agreement with Article 4(1) Regulation (EU) No 1257/2012, the date of registration of the unitary effect shall be deemed to be the date of publication by the European Patent Office of the mention of the grant of the European patent in the European Patent Bulletin.***

RULE 10 – SURRENDER

In our experience, this procedure is very rarely used. It may, however, be useful in specific circumstances, e.g. to help in settlement negotiations. To this purpose the procedure, if activated at all at UPP level, should be limited to registering a declaration from the patentee, without any active intervention.

RULE 13 – ENTRIES IN THE REGISTER FOR UNITARY PATENT PROTECTION

This Rule deals with different kinds of entries for which the information required is different, both as to its source and as to its content. It would be useful to distinguish between entries based on information directly available at the EPO and entries which rely on information provided by third parties for the specific purpose of having the information recorded in the Register. In the list currently presented in paragraph 1, most of the items belong to the former category and do not seem to raise any difficulty. This is, however, not the case for items (i), (m), (n) and possibly (s) and (t). For these items, there is a need to clarify the source and content of the information that will be used to build the respective entries.

At this stage, BUSINESSEUROPE will comment only on item (i) which is directly relevant to the business activities of its members.



In our view, the current wording of the Rule is unclear and potentially cumbersome. The Rule should refer to statements on licences and on licensing commitments undertaken in international standardisation bodies as in Article 9(c) of the Regulation and not to licenses and licensing commitments in general.

We intend that this registration procedure is completely optional and fully within the discretion of the submitting party. However it might be desirable that the rule deals with who is entitled to provide such statements and what should be contained in them to make it possible for the EPO to enter them usefully in the Register.

Lastly, it would be useful to know who is responsible for the accuracy of the statements entered and what sort of redress is available if the accuracy is challenged.
