



# Bird & Bird & The Unified Patent Court: The finish line in sight? Part 1

Virtual Event: Thursday 27 January 2022



# Presenting today



Alexander Ramsay, Chairman,  
UPC Preparatory Committee



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Edouard Treppoz, Of Counsel,  
Bird & Bird, France

# On the agenda today

9.00-11.00

Welcome

Anne-Charlotte Le Bihan

1. What's the latest news on the UPC?

Alexander Ramsay

2. What you need to do to prepare for the UPC and why you need to start now

Wouter Pors

3. UPC jurisdiction and competence

Katharine Stephens & Christopher Maierhöfer

4. Applicable law

Edouard Treppoz

# Welcome

*Anne-Charlotte Le Bihan*

Partner, IP, Paris

# 1. What's the latest news on the UPC?

*Alexander Ramsay*

Chairman of the UPC Preparatory Committee

# What have we been doing since 2016

- **”Boots on the ground”**
- **Interim teams making sure it works in practice**
  - IT
  - HR & Training
  - Registry
  - Corporate functions
  - Finance
- **Workshops – engaging with the divisions and the future staff of the UPC – head start the PAP!**

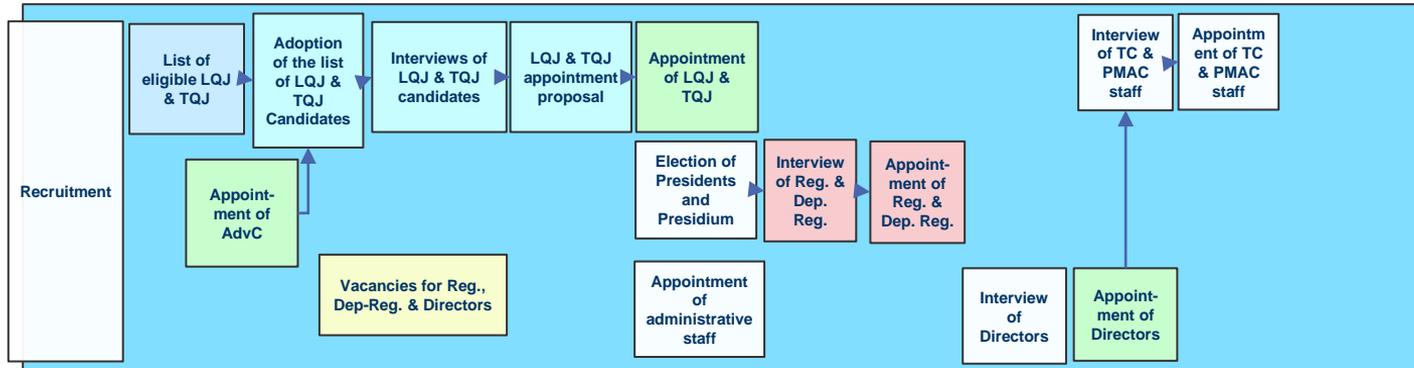
# What is the next phase

## – Provisional Application Period

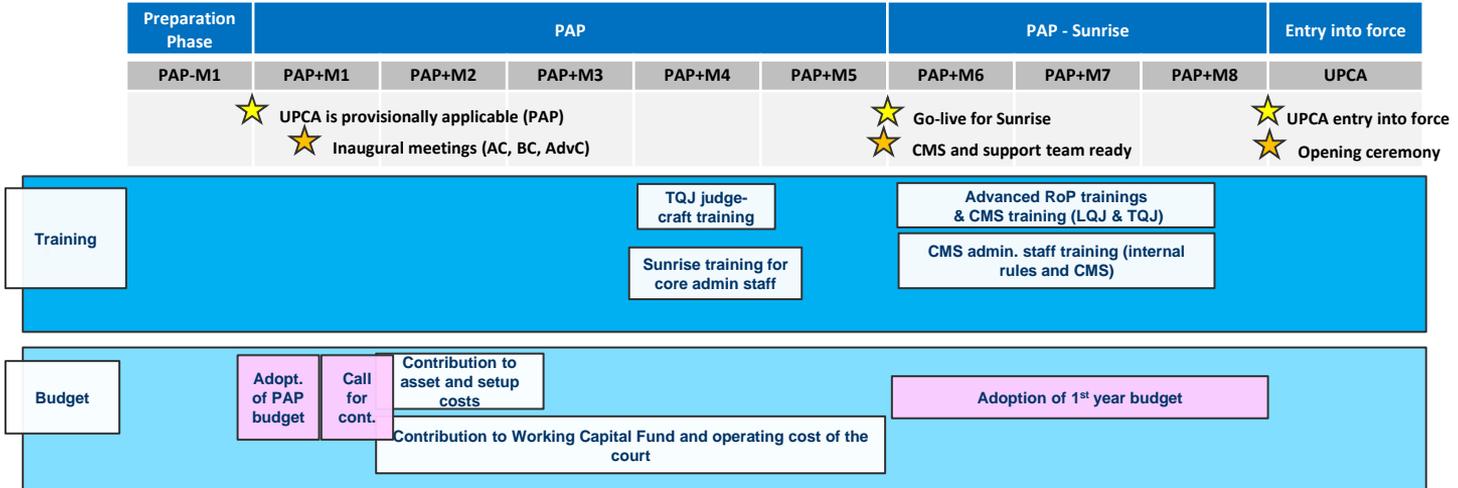
- Protocol on Provisional Application (PPA)
- Apply the institutional, organisational and financial provisions of the Agreement provisionally
- Before the UPCA enters into force
- Giving the UPC a pilot phase
  - Preparing the functionality
  - Establishing the international organisation
  - Setting up the formal structure of the organisation
  - Approximately eight months

# UPC Global Roadmap: recruitment

Preparation Phase	PAP					PAP - Sunrise			Entry into force
PAP-M1	PAP+M1	PAP+M2	PAP+M3	PAP+M4	PAP+M5	PAP+M6	PAP+M7	PAP+M8	UPCA
	★ UPCA is provisionally applicable (PAP) ★ Inaugural meetings (AC, BC, AdvC)					★ Go-live for Sunrise ★ CMS and support team ready			★ UPCA entry into force ★ Opening ceremony



# UPC Global Roadmap: training & budget



# Next step – inaugural meetings of the Committees

- **Adm Com**
  - Election of chairpersons
  - Appointment of the Advisory Committee
  - Adoption of secondary legislation
- **Advisory Com**
  - Election of chairpersons
  - Starting the interview procedure
- **Budget Com**
  - Election of chairpersons
  - Adoption of budget

# Current major proposals for amendments to the RoP

- **Rule 5A – Provision to remove unauthorised opt-outs and unauthorised withdrawals of opt-outs**
- **Rule 262 and the GDPR – Provisions to ensure sensitive personal data is withheld from the public**
- **Rule 262 and Confidentiality clubs – Provision for such arrangements**
- **Service – Amendments to take account of the Service Regulation 2020/1784**
- **Rule 112.6 – Amendment to allow for on-line oral hearings when appropriate**

# The third section of the CD

- **No section in London**
- **The Signatory States will decide where to reallocate the division**
- **Start of operations not depending on the finalisation of the decision**
- **Existing seat/section can temporarily deal with cases**

## 2. What you need to do to prepare for the UPC - and why you need to start now

*Wouter Pors*

Partner, IP, The Hague

# Recap: status and next steps

- Provisional application phase started 19 January 2022
  - Preparatory work will now be completed
  - Start date UPC & Unitary Patent:  $PAP + M8 = 1 \text{ October } 2022?$
- Germany will deposit UPCA ratification 3 months prior to the start of the Court
  - More precisely: there will be 3 full months between deposition and start
  - Participating countries to date: Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Portugal, Slovenia, Sweden
  - Countries that have signed, but not yet ratified: Cyprus, Czechia, Greece, Hungary, Ireland, Romania, Slovakia
  - Country that still needs to sign: Croatia
  - Countries that have declined: Poland, Spain, United Kingdom
- UPC Agreement and Unitary Patent Regulation enter into force on the same date

# Unitary Patent

- Prosecution under the EPC as a normal European patent application
  - Condition: same set of claims for all participating member states
  - Application for unitary effect within one month after grant, to be filed with EPO
- Sunrise period (1 July 2022?)
  - Request to delay grant of the patent possible during sunrise period (form 2025)
    - Decision by EPO President of 22 December 2021
    - **Should already be available now, since it's clear that the Unitary Patent will happen**
    - Condition: intention to grant under Rule 71(3), but text not yet approved by applicant
    - Procedure towards grant continues under Rule 71, but don't approve text
  - Request for unitary effect as of the date that Germany deposits ratification (form UP 7000)
    - Condition: intention to grant under Rule 71(3), but text not yet approved by applicant
    - EPO checks for compliance with Unitary Patent Rules
    - Applicant will be invited to correct deficiencies
    - Effective: date of mention of grant, but not before entry into force of the Regulation

# Requirements for request for unitary effect

Unitary Patent Rule 6: the request for unitary effect shall be filed in writing in the language of the proceedings and shall contain:

- a) particulars of the proprietor of the European patent making the request (hereinafter "the requester") as provided for in Rule 41, paragraph 2(c), EPC;
- b) the number of the European patent to which unitary effect shall be attributed;
- c) where the requester has appointed a representative, particulars as provided for in Rule 41, paragraph 2(d), EPC;
- d) a translation of the European patent as required under Article 6, paragraph 1, Regulation (EU) No 1260/2012, as follows:
  - where the language of the proceedings is French or German, a full translation of the specification of the European patent into English; or
  - where the language of the proceedings is English, a full translation of the specification of the European patent into any other official language of the European Union.

# Strategy: unitary and traditional patents

- Obtain both a Unitary and a traditional patent
  - Apply for divisional
  - Request early grant of patent that will remain traditional patent
  - Request delay of grant of patent for which unitary effect will be requested
    - EPO should make delay available as of now!
- The Unitary Patent will be valid for the countries that have ratified the UPC Agreement on the date of grant of the patent
  - A delay of grant may mean that more countries are covered
    - Croatia, Cyprus, Czechia, Greece, Hungary, Ireland, Romania, Slovakia?
    - This may include countries where you don't want to litigate in national courts
- Unitary Patents can't be pruned: no savings on renewal fees in later years

# Unitary Patent renewal fees

Year	Fee	Cumulative	Year	Fee	Cumulative
1	0	0	11	1.460	6.145
2	35	35	12	1.775	7.920
3	105	140	13	2.105	10.025
4	145	285	14	2.455	12.480
5	315	600	15	2.830	15.310
6	475	1.075	16	3.240	18.550
7	630	1.705	17	3.640	22.190
8	815	2.520	18	4.055	26.245
9	990	3.510	19	4.455	30.700
10	1.175	4.685	20	4.855	35.555

# Opting out

- The UPC will have exclusive jurisdiction for Unitary Patents: no opt-out possible
- Transitional regime for traditional European patents
  - Exclusive UPC jurisdiction after 7 years (2030), maybe 14 years (2044)
  - Free choice of UPC and national courts during transitional period
  - But: rules on *lis pendens* apply (Brussels Ibis Regulation)
  - Possibility for patentee to opt out from UPC jurisdiction - Sunrise period (1 July 2022?)
    - To be filed online with UPC registry
    - Blocks UPC jurisdiction for a specific patent/SPC for all UPC actions
    - Works for the lifetime of the patent & SPC
    - Application to opt-out possible as of the date that Germany deposits ratification
    - Signed by all *actual* proprietors – check carefully, patent register not decisive!
    - Declaration of entitlement to be submitted by each proprietor
    - Opt-in possible, unless action is or has ever been pending in national court
    - No second opt-out possible

# What to do now?

- Be ready by **1 July 2022!**
- Evaluate pending European patent applications
  - Decide on divisionals, request for delay, early request for unitary effect
  - Check if set of claims is the same for all UPC countries
  - Prepare translation of claims & *description*, for Unitary Patent (transitional, 6 – 12 years)
  - Decide on need to validate in non-UPC countries (including late joiners)
- Develop litigation strategy
  - To opt out or not to opt out?
  - Check entitlement – including consecutive transfers that are not registered
    - Check for patent as well as SPC's!
  - Monitor for unauthorised opt-outs during (and after) sunrise period (Rule 5A)
  - If action on the patent has been pending in a national court at any time, opt-out is final and cannot be withdrawn anymore – enforcement in UPC blocked permanently
  - Adverse party: decide on early central attack on validity
  - Beware of possible run to the court for freedom to operate

# 3. UPC jurisdiction and competence

*Katharine Stephens*

Partner, IP, London

*Christopher Maierhöfer*

Partner, IP, Munich

# International Jurisdiction of the UPC

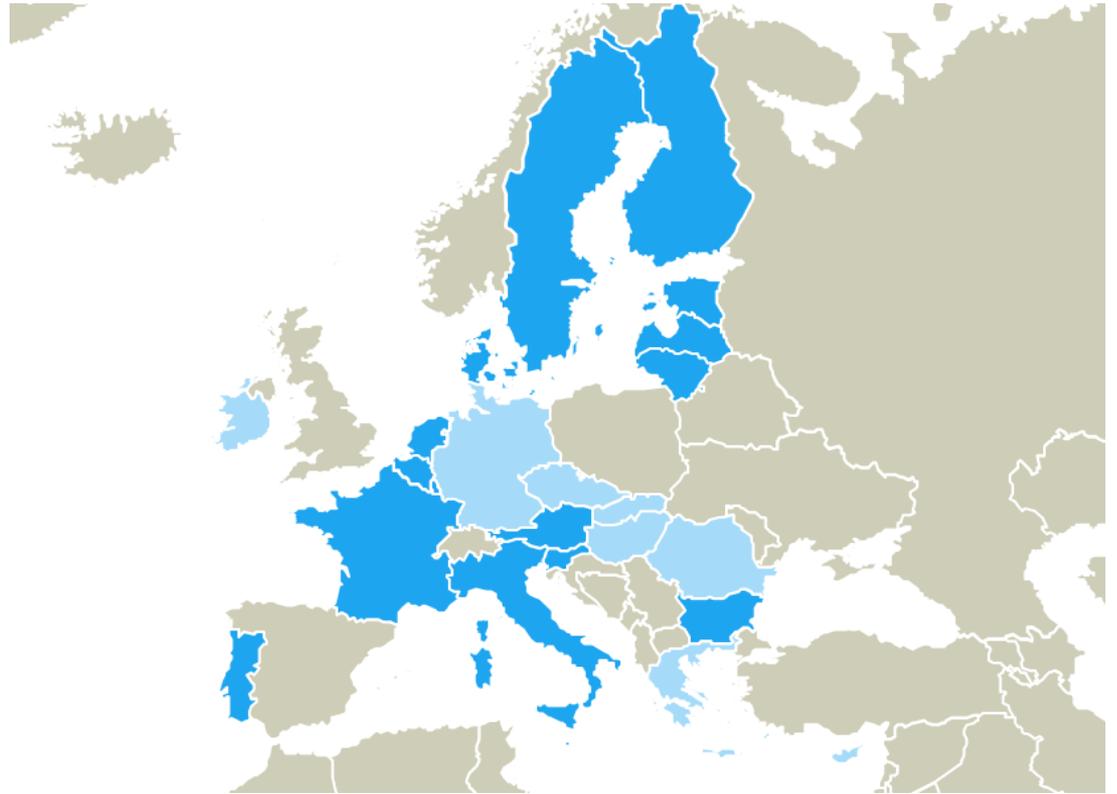
*Katharine Stephens*

# International jurisdiction of the UPC

- UPC has jurisdiction under Brussels Regulation (amended by Reg. 542/2014) and Lugano Convention [Art.31]
- Exclusive jurisdiction over actions for: [Art.32(1)]
  - actual or threatened infringement
  - DNIs
  - provisional and protective measures and injunctions
  - revocation
  - damages derived from the provisional protection conferred by a published EP application
  - prior use rights
  - licences of right
  - certain administrative decisions of the EPO in relation to UPs

# Defendant domiciled in CMS

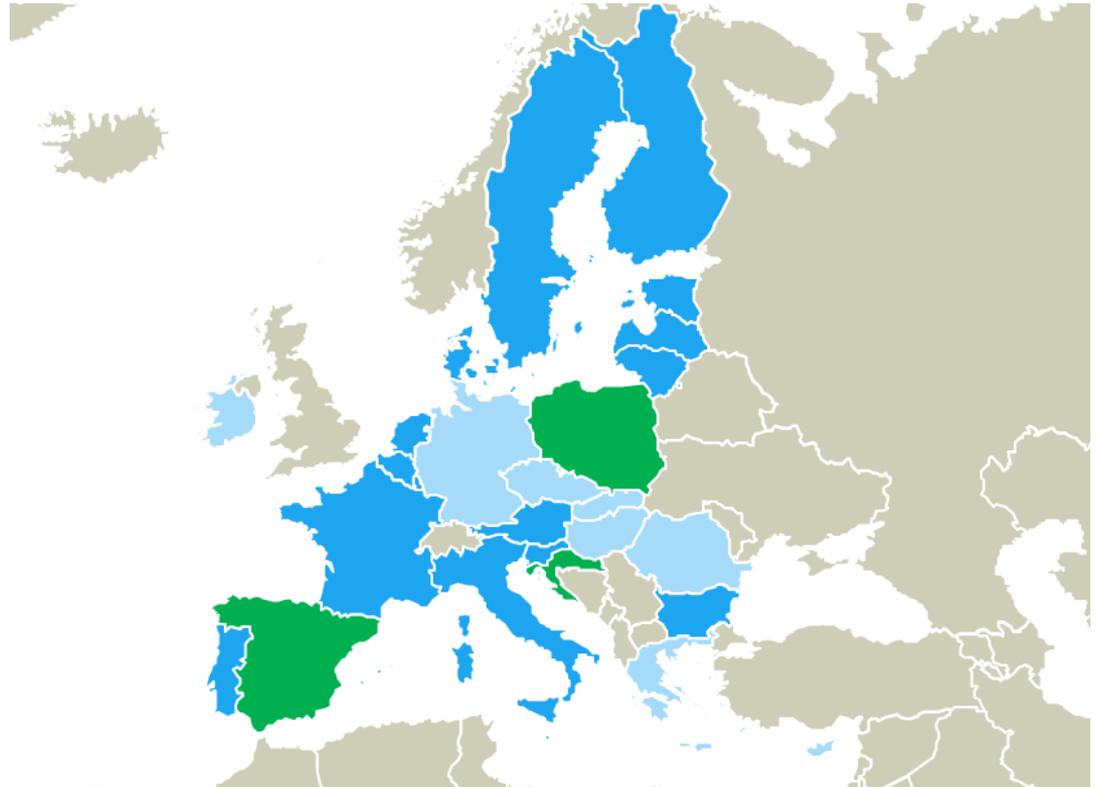
Art.71b(1) + Art.4(1) BR



# Defendant domiciled in EU MS but not CMS

Art.71b(1) + Arts.7(2) and  
8(1) BR

NB: Rules on *lis pendens* in  
Arts.29-32 BR incorporated  
by Art.71c(1)

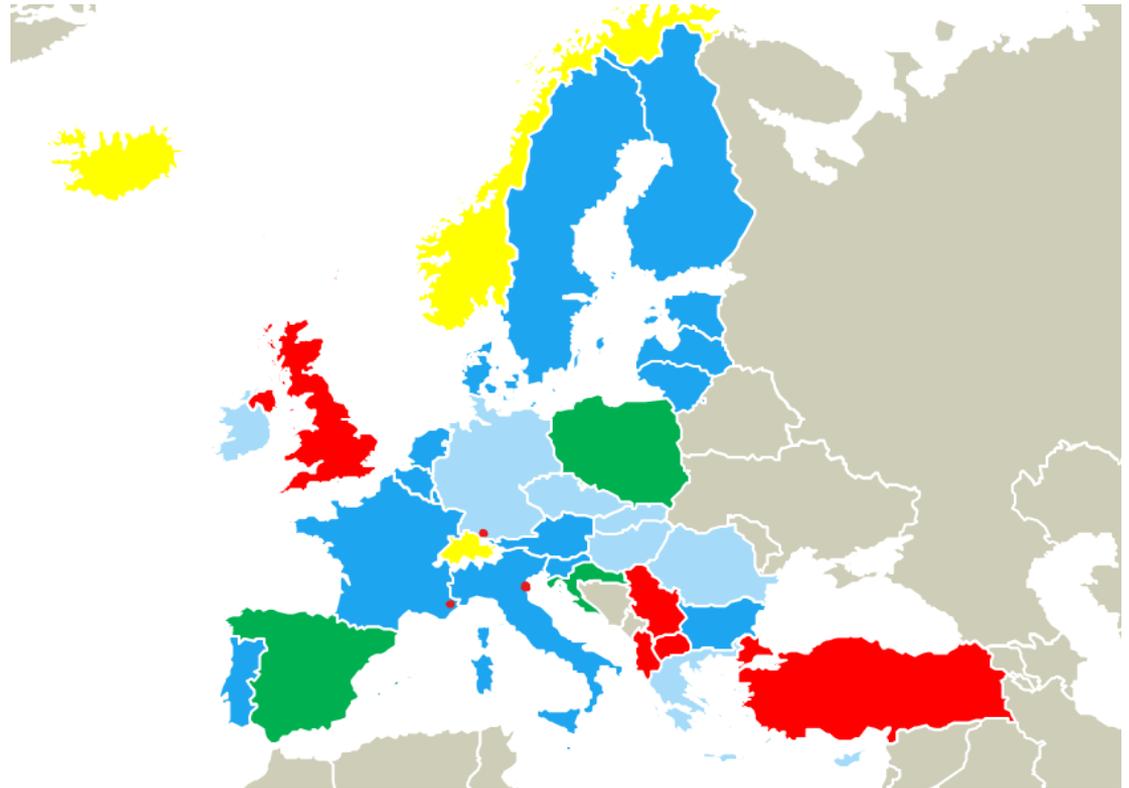




# Defendant domiciled in EPC MS but not EU or Lugano MS

## Art.71b(3) BR

- Jurisdiction under Art.71b(2)
- Infringement of an EP
- Giving rise to damage in the EU and outside EU arising from infringement
- D has property in CMS
- Action has connection with CMS

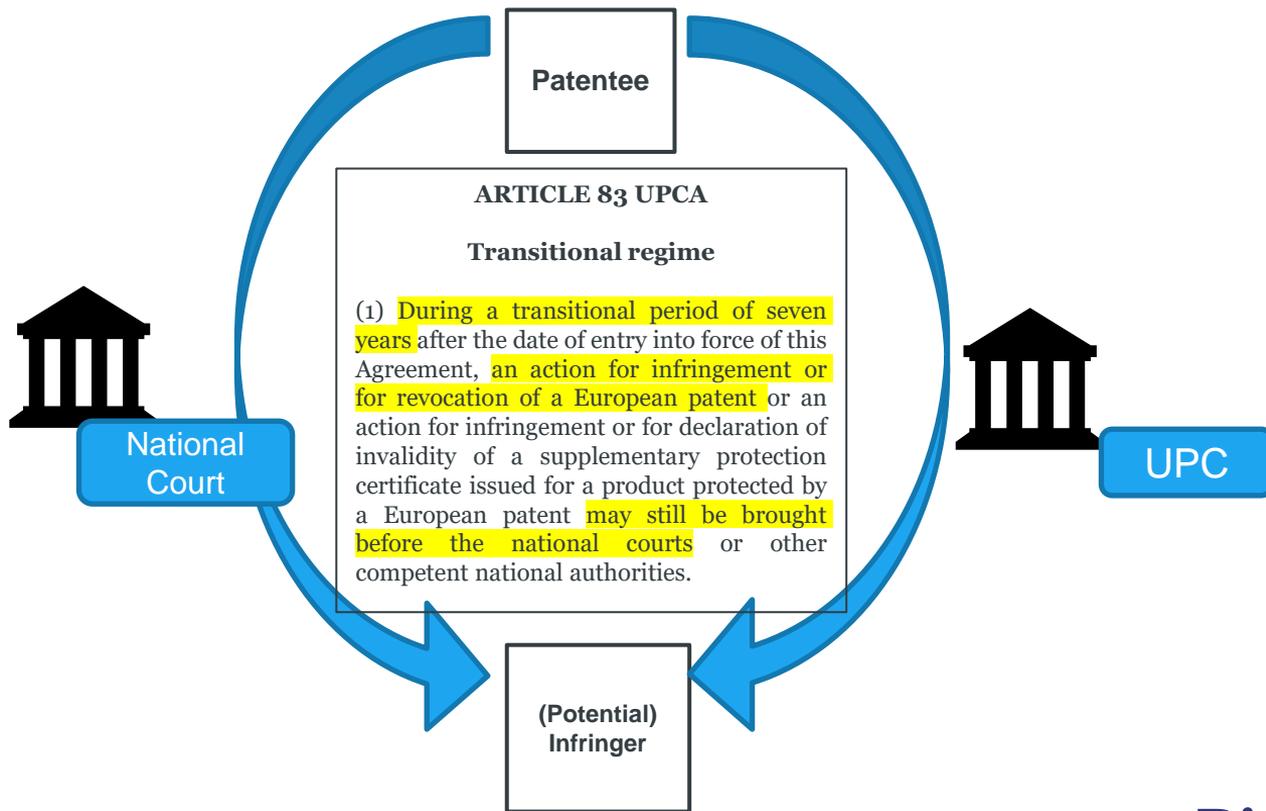


# Dual Jurisdiction for traditional EP patents

*Considerations and strategies for patentees and defendants*

*Dr. Christopher Maierhöfer*

# Dual jurisdiction during transitional period



Patentee:

1. Enforce through UPC or national courts?

## Dual jurisdiction – Options for patentees

- During transitional period, patentee in principle has "free choice" whether to enforce traditional EP centrally through UPC or – as before – through national courts.
- But where should the patentee go to?

# Dual jurisdiction – Options for patentees

## *Enforcement of existing EPs – National courts or UPC?*

### Pro opt-out, "staying national":

- Risk of central UPC revocation action, in particular against "Crown Jewel" patents
- Making use of bifurcated system (e.g. in Germany), in particular if EP has survived EPO opposition
- If one infringement action enough to stop infringing activities (e.g. manufacturing takes place in a EU MS with a reliable national enforcement option)
- If "deep pockets": filing multiple national actions to increase costs and resources for defendant, in particular for filing invalidity counter-attacks
- Uncertainty about quality of UPC in the beginning? > Possibility to "watch first" and then opt-in again (BUT: no opt-in if national action has been brought)

### Pro UPC:

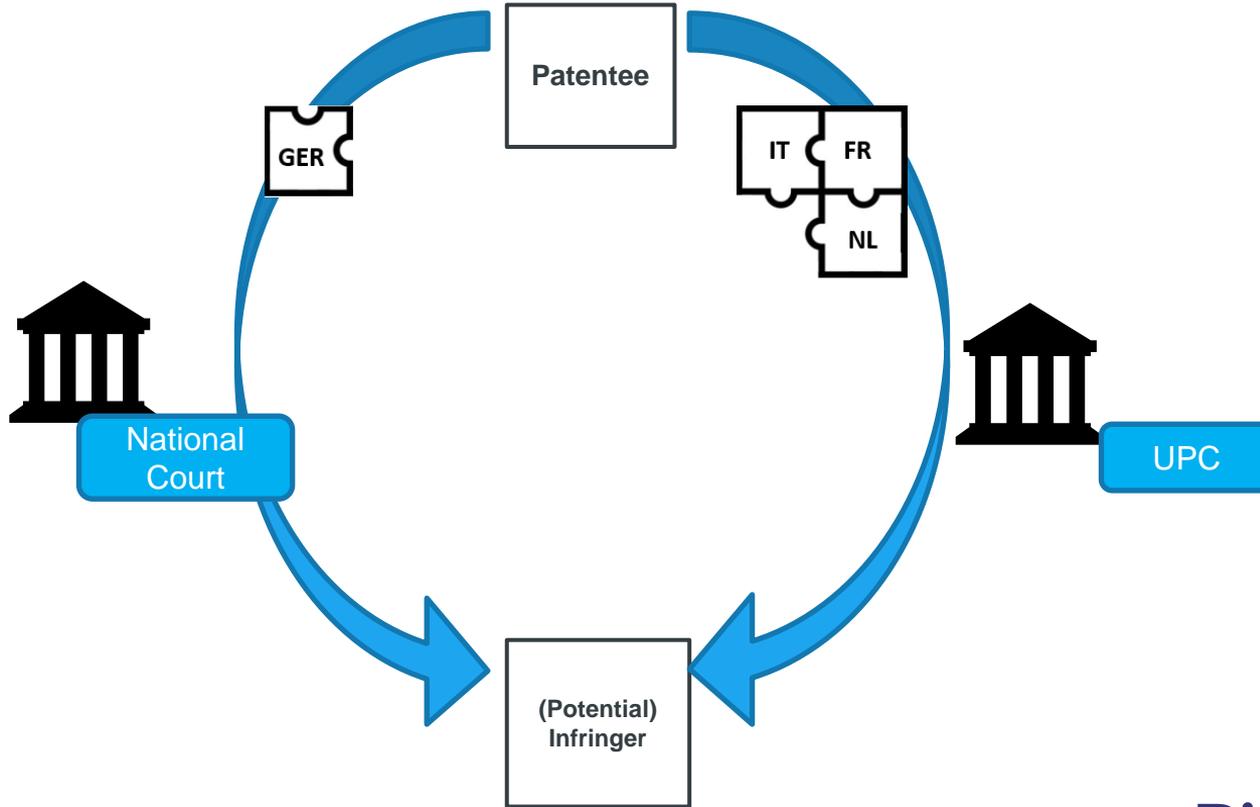
- Validity strong, already good picture of prior art
- Infringing sales scattered throughout lot of countries
- Quick overall duration of proceedings (intention: decision on infringement AND validity within 12 months),
- Actively influencing UPC jurisdiction and "trying things out"

Patentee:

2. Split strategy (UPC and national courts for same EP?)

# Dual jurisdiction – Options for patentees

*Can one and the same EP be enforced through UPC and nationally?*



# Dual jurisdiction – Options for patentees

*Can one and the same EP be enforced through UPC and nationally?*

## ARTICLE 34 UPCA

### Territorial scope of decisions

Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member State for which the European patent has effect.

- Is Art. 34 UPCA to be understood in a way that any action before UPC with respect to EP must involve all EU designations?
- Probably not, as
  - UPCA not aimed at (and not suitable for) changing legal character of traditional EP as bundle of rights
  - Would not make sense in cases where, e.g.
    - National designations have different owners
    - Action brought by Licensee who only has license to certain designations
    - EP already has different claim sets in different MS (e.g. due to prior national invalidation proceedings)
  - Fact that national court may come to different conclusion re infringement than UPC in line with CJEU *Roche v. Primus* (no risk of irreconcilable judgments since EP is bundle of rights)

# Dual jurisdiction – Options for patentees

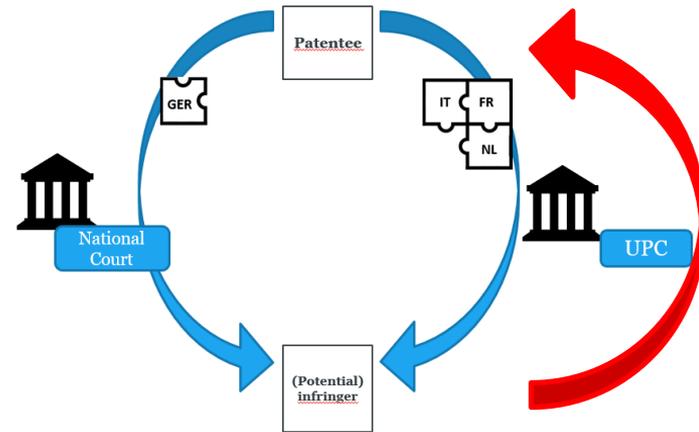
*Can one and the same EP be enforced through UPC and nationally?*

## Advantages for patentee?

- Risk diversification
- Preserving the use of "special features" of national proceedings, e.g.
  - Even faster pace of national infringement proceedings?
  - Making use of "special features" of national procedures, e.g.
    - Bifurcation (Germany)
    - Descrizione in Italy

## Risks?

- Likely exposure to central UPC revocation action which also affects carved-out national designation



(Potential) infringer:

1. General strategy considerations to be made prior to start of the UPC (i.e. NOW!)

# Dual jurisdiction – Options for potential infringers

## Basic considerations

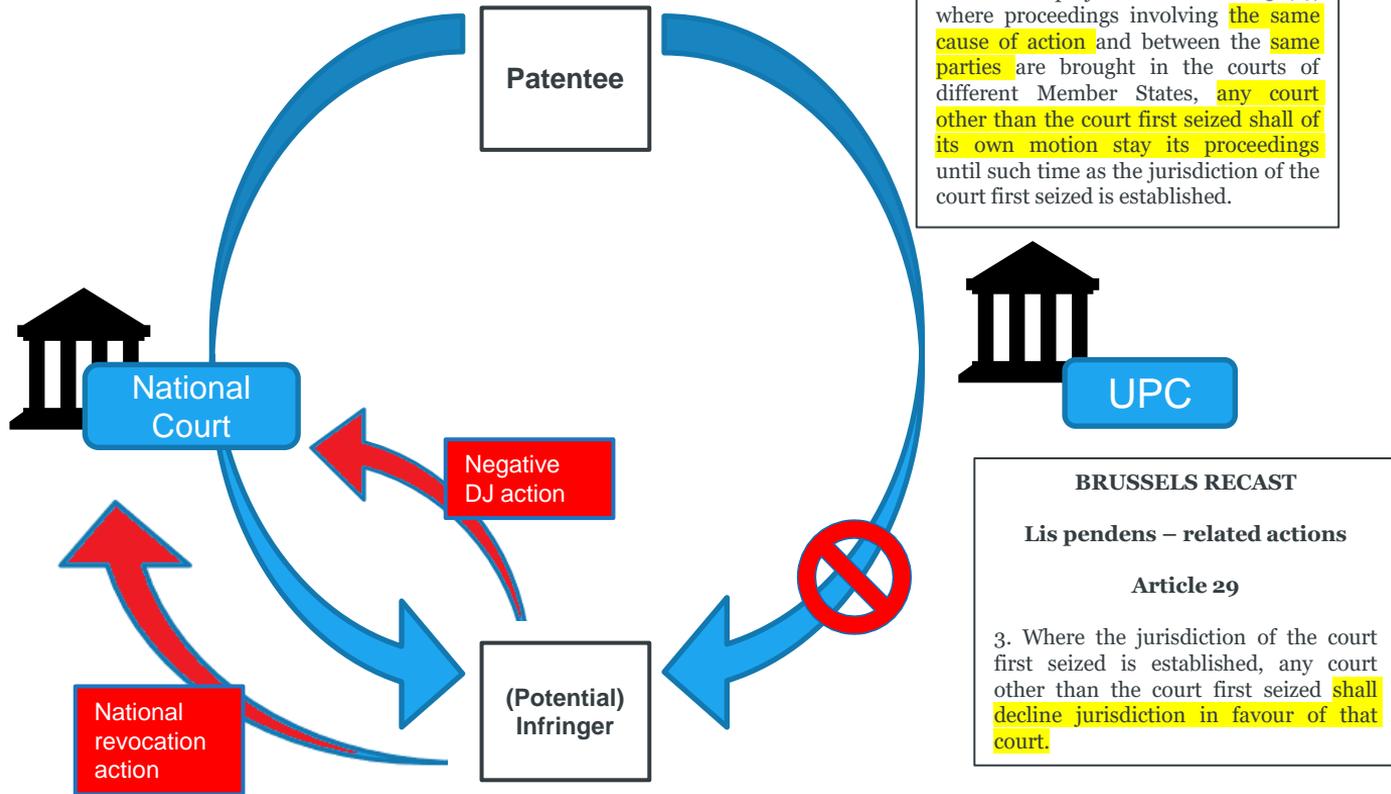
- Monitor opt-out register in UPC CMS for patents of concern
- Closely monitor divisional filings (EPO register alerts)
- If patent of concern not opted out (so far):
  - Identify what is bigger concern:
    - Central enforcement through UPC against your company?
    - ↕
    - Having to deal with multiple infringement actions, in particular fighting validity separately in each country?
- Start prior art search now and prepare UPC revocation action

Potential infringer:

2. Block or delay UPC action by filing torpedoes?

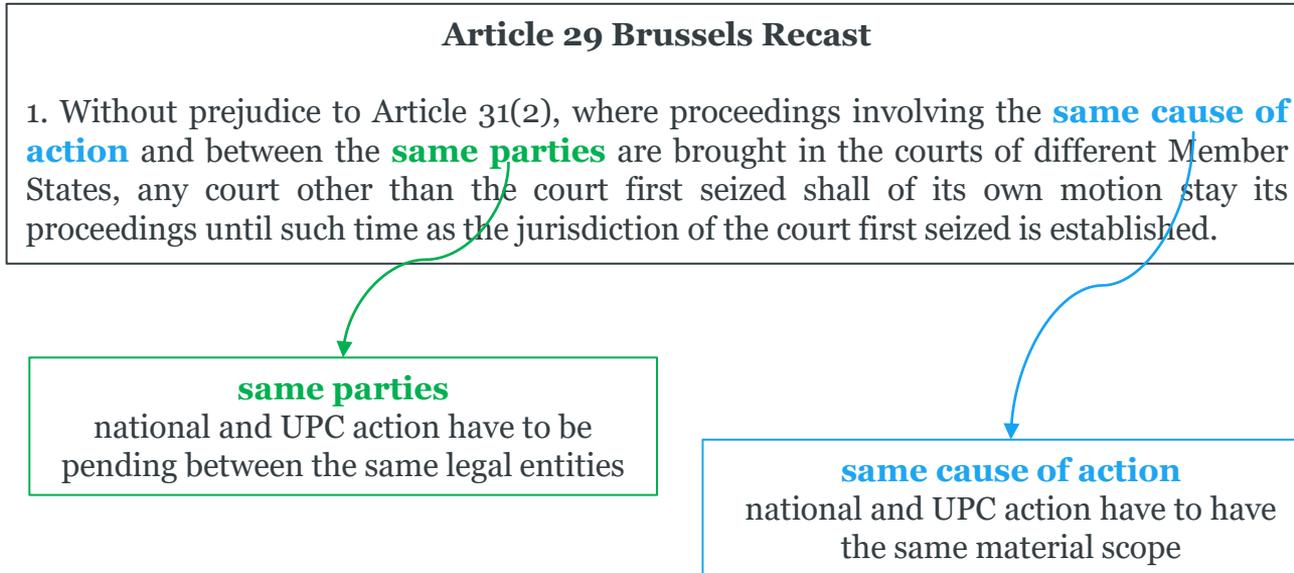
# UPC

Torpedo to avoid or at least delay UPC action?



# UPC

- *lis pendens* – requirements of blocking effect (Art. 29 BR)



# UPC

## "Full-blown" torpedo

- Action filed with one national court directed declaration of non-infringement for **all national** (EU) designations of EP
- Very likely to be regarded as "same cause of action" under Art. 29 BR, since "mirroring" an affirmative UPC action (infringement of all EU designations of EP)
- Interesting option if jurisdiction of national court can be based on domicile of defendant (e.g. patentee is Dutch company > declaratory action on non-infringement before Dutch court)

# UPC

## "Full-blown" torpedo

- Problem: If jurisdiction cannot be based on domicile of defendant (e.g. non-EU patentees), national court very likely to deny jurisdiction for foreign national designations
  - no jurisdiction of act of infringement, no jurisdiction based on "risk of irreconcilable judgments" in view of CJEU *Primus v. Roche*)
- However, as long as decision to deny jurisdiction for foreign national parts of the EP is not taken, full case is pending > blocking effect of Art. 29 applies

**BRUSSELS RECAST**  
**Lis pendens – related actions**  
**Article 29**

1. Without prejudice to Article 31(2), where proceedings involving the same cause of action and between the same parties are brought in the courts of different Member States, any court other than the court first seized shall of its own motion stay its proceedings until such time as the jurisdiction of the court first seized is established.

# UPC

## "Full-blown" torpedo in case of non-EU patentees:

- Blocking effect entirely based on expected timing for the first instance court to issue a (negative) decision on jurisdiction
- Most EU countries (e.g. DE, NL, CZ / SK) unsuitable for torpedo actions since decision denying jurisdiction will be issued too quickly to achieve sizable delay effect

## Potential venues:

- Italy?
  - Procedural particularity: Decision re denial of jurisdiction for foreign designations may still take 1.5 – 2 years from filing torpedo action, in particular if filed before "slower" court such as e.g. Rome
- Belgium?
  - Procedural particularity: Decision on jurisdiction usually only together with decision on merits;

# UPC

## "Isolated" torpedo

- Filing declaratory action on non-infringement in one or several MS jurisdictions for respective national designation only  
(e.g. file negative DJ action in France for declaration of non-infringement of French part of EP)
- "Same cause of action" under Art. 29 BR?
  - Torpedo plaintiff / potential infringer may argue that blocking effect of Art. 29 BR affects entire territory of UPC, despite national action only covering one national designation, based on Art. 34 UPCA

### ARTICLE 34 UPCA

#### Territorial scope of decisions

Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member State for which the European patent has effect.

# UPC

## "Isolated" torpedo

- "Same cause of action" under Art. 29 BR?

**ARTICLE 34 UPCA**  
**Territorial scope of decisions**  
Decisions of the Court shall cover, in the case of a European patent, the territory of those Contracting Member State for which the European patent has effect.

- However, Art. 34 UPCA likely not to be understood in a way that any UPC action has to cover all UPC MS
- UPC should have strong incentive to not have its jurisdiction blocked entirely by isolated torpedo actions
  - Likely that UPC would "carve out" jurisdiction affected by national torpedo under Art. 29 BR and continue proceedings with respect to other MS jurisdictions
- In case it is uncertain whether or not patentee plans to enforce EP at all: torpedo actions may be "poking the bear" and provoke filing of affirmative UPC / national infringement actions by patentee

# UPC

- *lis pendens* – "same parties" requirement

## Article 29 Brussels Recast

1. Without prejudice to Article 31(2), where proceedings involving the **same cause of action** and between the **same parties** are brought in the courts of different Member States, any court other than the court first seized shall of its own motion stay its proceedings until such time as the jurisdiction of the court first seized is established.

### same parties

national and UPC action have to be pending between the same legal entities

- If UPC complaint is filed by or against other entities than the one that are parties to the torpedo action(s), blocking effect of Art. 29 BR not applicable with respect to such entity!
- Patentee may transfer a grant exclusive license to EP to different group entity

Potential infringer:

3. Blocking an opt-in for opted-out EPs

# UPC

## Blocking withdrawal of opt-out

- art. 83(4) UPCA:

### ARTICLE 83

#### Transitional regime

(4) Unless an action has already been brought before a national court, proprietors of or applicants for European patents or holders of supplementary protection certificates issued for a product protected by a European patent who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt out at any moment.  
[...]

# UPC

## Blocking withdrawal of opt-out

- Art. 83(4) generally allows for the potential infringer to block a withdrawal by filing "an action" before national court
- broad term "unless **an** action has already been brought" – likely that any national action will prevent opt-in
  - by launching "random", low cost national action, potential infringer will be able to "lock out" EP from the UPC system
  - according to wording of Art. 83(4), this may even apply to scenario where national action is (immediately) withdrawn thereafter
  - exceptions to UPC 83(4) for cases in which national action is only made pending to preclude opt-in?

# Internal Competence of the UPC

*Katharine Stephens*

# Territorial competence of local/regional divisions

## *Claimant starting an infringement action*

In an infringement case, where to bring proceedings?

(1) where actual or threatened infringement occurred/may occur [Art.33(1)(a)]

(2) where the defendant is resident, or has its principal place of business or, in the absence of either, has a place of business [Art.33(1)(b)]

- Can then join multiple defendants to this action provided:
  - They have a commercial relationship; and
  - The action relates to the same alleged infringement.

(3) where (2) N/A, the central division

- Defendant must counterclaim for revocation or a DNI before same division [Art.33(3)]
- Opportunities for division shopping?

# Territorial competence of local/regional divisions

*Can defendant take pre-emptive action?*

## Revocation action

- Central division [Art.33(4)]
- Patentee can issue infringement proceedings as previous slide or central division [Art.33(5)]
- Local/regional division can: [Art.33(3)]
  - proceed with both actions
  - hear infringement action only\*
  - stay infringement action pending decision of revocation action in central division\*\*
  - with agreement of the parties refer infringement action to central division

\* Decision may be rendered under condition subsequent re patent finding. Enforcement can be subject to security [r.118].

\*\* Stay is discretionary, but shall stay if high likelihood of patent being held invalid [rr.118, 295]

# Territorial competence of local/regional divisions

*Can defendant take pre-emptive action?*

## **Declaration of non-infringement**

- Central division [Art.33(4)]
- Patentee can issue infringement proceedings as in first slide [Art.33(1)]
  - Central division must stay if: [Art.33(6)]
    - same parties; or
    - exclusive licensee and claimant in DNI action; and
    - same patent
    - PROVIDED THAT infringement action brought within 3 months\*

\* If 3 month deadline past, a stay may still be granted [r.295]

# Territorial competence of local/regional divisions

*Can defendant take pre-emptive action?*

## **Opposition or limitation in the EPO**

- Patentee can issue infringement proceedings as in first slide [Art.33(1)]
  - Court may stay when a rapid decision from the EPO is expected [Art.33(10)]
  - Stay is discretionary, but shall stay if high likelihood of patent being held invalid + decision may be expected to be given rapidly [rr.118 and 295]

## **Application relating to the use of the invention prior to the granting of the patent or to the right based on prior use of the invention**

- Patentee cannot start an action for infringement in another division [Art.33(2)]

# 4. UPC applicable law

*Edouard Treppoz*

Of Counsel, IP, Paris

Professor University of Paris 1 Panthéon-Sorbonne

# Applicable Law : Methodology (i)

## **Agreement on a Unified Patent Court**

### **Article 20**

- Primacy of and respect for Union law
- The Court shall apply Union law in its entirety and shall respect its primacy.

# Applicable Law : Methodology (ii)

## Article 24 Agreement on a Unified Patent Court

### Sources of law

1. In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on:
  - a. Union law, including Regulation (EU) No 1257/2012 and Regulation (EU) No 1260/2012;
  - b. this Agreement;
  - c. the EPC;
  - d. other international agreements applicable to patents and binding on all the Contracting Member States; and
  - e. national law.

# Applicable Law : Methodology (iii)

## Article 24 Agreement on a Unified Patent Court

### Sources of law

2. To the extent that the Court shall base its decisions on national law, including where relevant the law of noncontracting States, the applicable law shall be determined:
  - a. by directly applicable provisions of Union law containing private international law rules, or
  - b. in the absence of directly applicable provisions of Union law or where the latter do not apply, by international instruments containing private international law rules; or
  - c. in the absence of provisions referred to in points (a) and (b), by national provisions on private international law as determined by the Court.

# Applicable Law : Methodology (iv)

## Article 24 Agreement on a Unified Patent Court

### Sources of law

3. The law of non-contracting States shall apply when designated by application of the rules referred to in paragraph 2, in particular in relation to Articles 25 to 28, 54, 55, 64, 68 and 72.

# Validity Issues

## **Article 24 Agreement on a Unified Patent Court**

### **Sources of law**

1. In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on:

c. the EPC;

# UP as an Object of Property (i)

## **Article 24 Agreement on a Unified Patent Court**

### **Sources of law**

1. In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on:
  - a. Union law, including Regulation (EU) No 1257/2012 and Regulation (EU) No 1260/2012;

# UP as an Object of Property (ii)

## **A mechanism already used**

### **Article 19 Regulation 2017/1001 on the European Union trade mark**

1. Unless Articles 20 to 28 provide otherwise, an EU trade mark as an object of property shall be dealt with in its entirety, and for the whole area of the Union, as a national trade mark registered in the Member State in which, according to the Register

### **Article 7 Regulation 1257/2012**

#### **Treating a European patent with unitary effect as a national patent**

1. A European patent with unitary effect as an object of property shall be treated in its entirety and in all the participating Member States as a national patent of the participating Member State in which that patent has unitary effect and in which, according to the European Patent Register:

# UP as an Object of Property (iii)

## **Connecting factors to determine the applicable law:**

- Residence or principal place of business of the applicant,
- If not a place of business of the applicant,
- If not « the State where the EPC has its headquarters ».
- Where two or more persons are entered in the European Patent Register as joint applicants, point (a) of paragraph 1 shall apply to the joint applicant indicated first.

# The Protection Conferred to the UP (i)

## **Article 24 Agreement on a Unified Patent Court**

### **Sources of law**

1. In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on:
  - a. Union law, including Regulation (EU) No 1257/2012 and Regulation (EU) No 1260/2012;

# The Protection Conferred to the UP (ii)

## Article 5 Regulation 1257/2012

### Uniform protection

1. The European patent with unitary effect shall confer on its proprietor the right to prevent any third party from committing acts against which that patent provides protection throughout the territories of the participating Member States in which it has unitary effect, subject to applicable limitations.
2. The scope of that right and its limitations shall be uniform in all participating Member States in which the patent has unitary effect. (...)

# The Protection Conferred to the UP (iii)

## Exceptions to the uniform protection

### Regulation 1257/2012

(10) Compulsory licences for European patents with unitary effect should be governed by the laws of the participating Member States as regards their respective territories.

### Article 28 UPC Agreement

#### Right based on prior use of the invention

- Any person, who, if a national patent had been granted in respect of an invention, would have had, in a Contracting Member State, a right based on prior use of that invention or a right of personal possession of that invention, shall enjoy, in that Contracting Member State, the same rights in respect of a patent for the same invention.

# The Protection Conferred to the UP (iv)

## Article 5 Regulation 1257/2012

### Uniform protection

(...)

3. The acts against which the patent provides protection referred to in paragraph 1 and the applicable limitations shall be those defined by the law applied to European patents with unitary effect in the participating Member State whose national law is applicable to the European patent with unitary effect as an object of property in accordance with Article 7.

# The Protection Conferred to the UP (v)

## **Just an illusion ?**

Under national law articles 25 to 29 of the UPC?

As a reminder :

- Article 25 Right to prevent the direct use of the invention
- Article 26 Right to prevent the indirect use of the invention
- Article 27 Limitations of the effects of a patent

# The Protection Conferred to the UP (vi)

## Just an illusion?

### Are articles 25 to 27 sufficient?

If not how to fill the gap:

- By UPC's interpretation?
- By applying national law determined by article 7 Regulation?

### *Reminder*

## Article 24 Agreement on a Unified Patent Court

### Sources of law

3. The law of non-contracting States shall apply when designated by application of the rules referred to in paragraph 2, in particular in relation to Articles 25 to 28 (...)

# Infringement Issues (i)

## **Article 24 Agreement on a Unified Patent Court**

### **Sources of law**

1. In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on:

(...)

(b) this Agreement;

# Infringement Issues (ii)

## Is there any national law applicable?

*As a methodological reminder*

### **Article 24 Agreement on a Unified Patent Court**

#### **Sources of law**

1. In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on: (...)
  - (e) national law.
2. To the extent that the Court shall base its decisions on national law, including where relevant the law of noncontracting States, the applicable law shall be determined:
  - (a) by directly applicable provisions of Union law containing private international law rules (...)
3. The law of non-contracting States shall apply when designated by application of the rules referred to in paragraph 2, in particular in relation to Articles 25 to 28, 54, 55, 64, 68 and 72.

# Infringement Issues (iii)

**Is there any national law applicable?**

## **Article 72 UPC Agreement**

### **Period of limitation**

Without prejudice to Article 24(2) and (3), actions relating to all forms of financial compensation may not be brought more than five years after the date on which the applicant became aware, or had reasonable grounds to become aware, of the last fact justifying the action

# Infringement Issues (iv)

**How to determine PIL Rule being applicable for period of limitation?**

**Why Regulation Rome II is applicable?**

**Article 15 Scope of the law applicable**

The law applicable to non-contractual obligations under this Regulation shall govern in particular:

(h) the manner in which an obligation may be extinguished and rules of prescription and limitation, including rules relating to the commencement, interruption and suspension of a period of prescription or limitation.

# Infringement Issues (v)

**How to determine the national law being applicable ?**

**Rome II Regulation**

**Article 8 Infringement of intellectual property rights**

2. In the case of a non-contractual obligation arising from an infringement of a unitary Community intellectual property right, the law applicable shall, for any question that is not governed by the relevant Community instrument, be the law of the country in which the act of infringement was committed.

*See ECJ, Nintendo, C-24/16*

# Contractual Issues (i)

## *Reminder*

### **Article 32 UPC Agreement**

#### **Competence of the Court**

1. The Court shall have exclusive competence in respect of: (a) actions for actual or threatened infringements of patents and supplementary protection certificates and related defences, including counterclaims concerning licences;

### **Article 47 UPC Agreement**

2. Unless the licensing agreement provides otherwise, the holder of an exclusive licence in respect of a patent shall be entitled to bring actions before the Court under the same circumstances as the patent proprietor, provided that the patent proprietor is given prior notice.

# Contractual Issues (ii)

**How to determine PIL Rule being applicable ?**

**Why is Regulation Rome I (n° 593/2008) applicable?**

Article 12 Scope of the law applicable

1. The law applicable to a contract by virtue of this Regulation shall govern in particular:
  - a. Interpretation

# Contractual Issues (iii)

**How to determine the national law being applicable ?**

**Rome I Regulation**

Article 3 (Freedom of choice)

Article 4 (Characteristic performance)

# Procedural Issues (i)

## **Article 54 UPC Agreement**

### **Burden of proof**

**Without prejudice to Article 24(2) and (3), the burden of the proof of facts shall be on the party relying on those facts.**

### **Article 55 Reversal of burden of proof**

1. Without prejudice to Article 24(2) and (3), if the subject-matter of a patent is a process for obtaining a new product, the identical product when produced without the consent of the patent proprietor shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process.

# Procedural Issues (ii)

## **Rome I regulation**

Article 18 Burden of proof 1. The law governing a contractual obligation under this Regulation shall apply to the extent that, in matters of contractual obligations, it contains rules which raise presumptions of law or determine the burden of proof.

## **Rome II regulation**

Article 22 Burden of proof 1. The law governing a non-contractual obligation under this Regulation shall apply to the extent that, in matters of noncontractual obligations, it contains rules which raise presumptions of law or determine the burden of proof.

# Procedural Issues (iii)

## **Article 46 UPC Agreement**

### **Legal capacity**

Any natural or legal person, or any body equivalent to a legal person entitled to initiate proceedings in accordance with its national law, shall have the capacity to be a party to the proceedings before the Court.

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