

# Get ready for the Unitary Patent & the Unified Patent Court

*LESI Conference*  
*Patent litigation in Europe : the Unified Patent Court,*  
*last run before the kick-off ?*  
Paris • 25 April 2017

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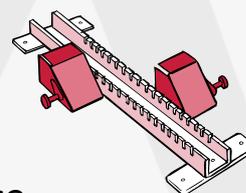
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## Contents

# Get ready for the Unitary Patent & the Unified Patent Court

- Prepare before entry into force  
(patenting strategy, research and licensing agreements)
- Transitional period
- After entry into force

## The Unified Patent Court



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## Prepare before entry into force: patenting and agreements strategy

- National patent, classical “bundle”  
European patent or Unitary patent?
- Language of the filing
- Intellectual property agreements strategy

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## National patent, classical “bundle” European patent or Unitary patent?

- National patent
- Classical “bundle” European patent
- Unitary patent (“European patent with unitary effect”)
  - ▶ Possible if the patent has the same claims for all the designated countries
  - ▶ A single action decides for all the territory covered
  - ▶ All the eggs in the same basket
- European patent + national patent when permitted by national law

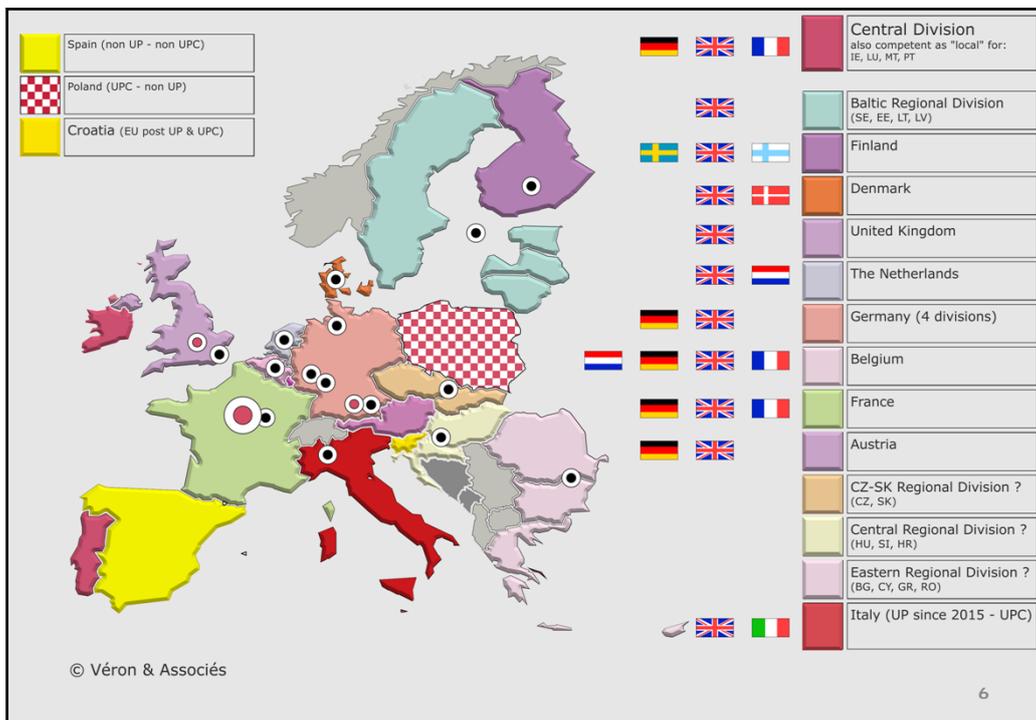


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## Choice of the language of the filing

- Impact of the language of the filing on procedures
  - ▶ Action for infringement (language depends on the division where the action is brought; local division: language(s) admitted before the division; central division: language of the patent)
  - ▶ Action for revocation or declarations of non-infringement before the central division (language of the patent)
- This applies before the UPC for both classical European patents (EP) not opted out and unitary patents (UP)
- File European patent applications in the applicant's preferred language



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## Intellectual property agreements strategy

- Review collaboration or joint research agreements leading to co-ownership of patents
- Review patent licence agreements

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## Collaboration or joint research agreements

- Choice of the language and filing of the patent applications stemming from the collaboration
- Choice between national patent, classical "bundle" European patent and Unitary patent
- The law applicable to patents held in co-ownership
- Decisions relative to the opt-out and to its withdrawal
- Right of action of the co-owners before the UPC

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## Choice of the language of the filing

- Decide in the agreement the language of the filing

## National patent, classical “bundle” European patent or Unitary patent?

- Anticipate how the co-owners will decide whether the inventions will be protected by a national patent, a classical “bundle” European patent or a Unitary patent?
- Provide for a conflict resolution clause in case of a disagreement of the co-owners on this point

## The law applicable to patents held in co-ownership

- The order of entry of applicants has an effect on the law applicable to the European patent with unitary effect as an object of property (Art. 7, Regulation n° 1257/2012)
- If the patent is filed within the framework of a collaboration agreement, this agreement can provide which applicant shall be designated first
- Unless the law applicable to the patent excludes this, the collaboration agreement can provide that any patent held in co-ownership will be subject to co-ownership rules designating another applicable law

## Co-ownership contracts: opt-out and withdrawal for classical European patents

- The opt-out and its withdrawal must be done jointly by all owners (Rules 5.1 a) and b) and 5.8.): due diligence is to be carried out as soon as possible in case of a doubt on the identity of the co-owners of a patent
- Decide in the co-ownership rules how opt-out and withdrawal decisions will be made
- Provide for a conflict resolution clause in case of a disagreement of the co-owners on this point

## Co-ownership contracts: exercise of legal action before the UPC

- The action for infringement before the UPC can be brought by one of the co-owners (rule 13.1. e) and f)): decide who can act in the co-ownership rules
- The action for revocation must be initiated against all co-owners

### Contents

## Licensing agreements

- Decisions relative to the opt-out and to its withdrawal
- Right of action of the licensee before the UPC

## Licensing agreement: opt-out and withdrawal for the “classical” European patent

- The licensee cannot opt out or withdraw, but it can be useful to provide, especially if he is exclusive, that he will be informed of those declarations
- The action for infringement before the UPC can be brought by the exclusive licensee save stipulations to the contrary in the licensing agreement (and after he has given the patent proprietor prior notice) (art. 47.2. Agreement)
- The non-exclusive licensee cannot bring actions unless the contract permits him and the patent proprietor has been given prior notice (art. 47.3. Agreement)
- The patent proprietor can always join in the action brought by the licensee

## Licensing agreements: standing of the licensee for bringing an action before the UPC

- The action for infringement before the UPC can be brought by the exclusive licensee save stipulations to the contrary in the licensing agreement (and after he has given the patent proprietor prior notice) (art. 47.2. Agreement)
- The non-exclusive licensee cannot bring actions unless the contract permits him and the patent proprietor has been given prior notice (art. 47.3. Agreement)
- The patent proprietor can always join in the action brought by the licensee

## Licensing agreements: standing of the licensee for defending an action before the UPC

- Right to defend an action for declaration of non-infringement before the UPC:
  - ▶ The action for declaration of non-infringement can be directed against the licensee (Rules 60.1. a) and 60.2.)
  - ▶ The position expressed by the licensee does not bind the patent proprietor
- From now on, licensing agreements must envisage this point

## Prepare for transitional period

- To opt out or to stay in?
- If no opt-out, concurrent jurisdiction of UPC and national courts (claimant's choice)
- Applicable law may be different before the UPC and before national courts?
- Time matters: UPC may well have jurisdiction only for infringement facts subsequent to the entry into force of the Agreement

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## Prepare for entry into force

- Superfast proceedings
- Fully electronic proceedings
- All statements and documents immediately available to the public unless specific request

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