

# Uniform protection and rights conferred: towards a limited unitary effect?

*The creation of unitary patent protection in the European Union  
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A V O C A T S

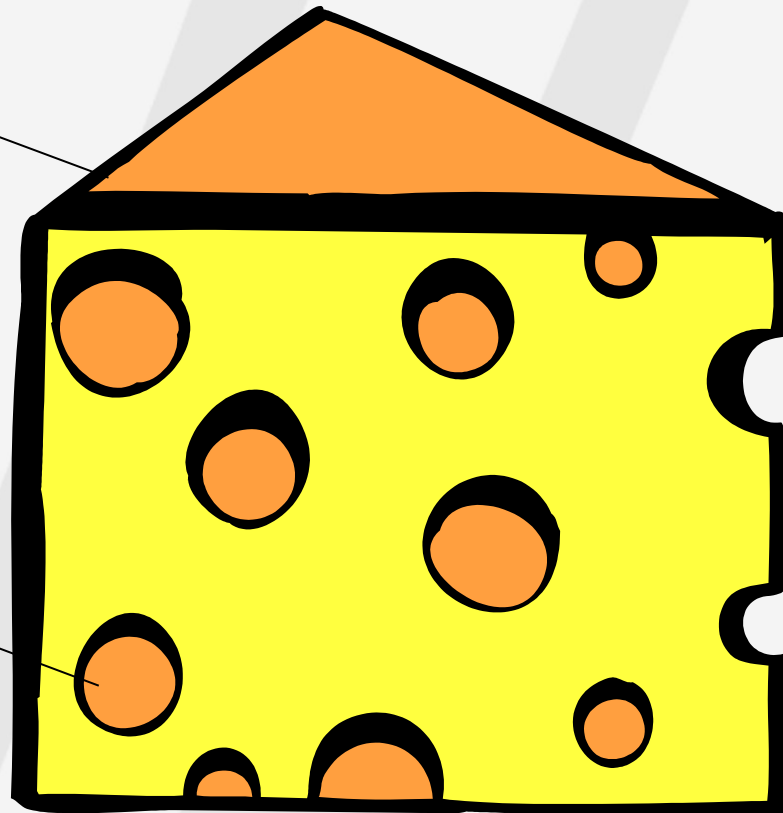
Paris ■ Lyon



# An appealing topic

Rind

Eye



## From “*Community patent*” to “*European patent with unitary effect*”

- 29 September 2009  
Proposal for a Regulation on the **Community patent** (13706/09)  
<http://register.consilium.europa.eu/pdf/en/09/st13/st13706.en09.pdf>
- 15 April 2011  
Proposal for a Regulation on **Unitary patent** (9224/11)  
<http://register.consilium.europa.eu/pdf/en/11/st09/st09224.en11.pdf>
- 26 May 2011  
Proposal for a Regulation on **Unitary patent** (10629/11)  
<http://register.consilium.europa.eu/pdf/en/11/st10/st10629.en11.pdf>
- 23 June 2011  
Proposal for a Regulation on **Unitary patent** (11328/11)  
<http://register.consilium.europa.eu/pdf/en/11/st11/st11328.en11.pdf>

# Prior rights

**15 April 2011 9224/11**

Article 5 - Prior rights

In the event of limitation or revocation on the ground of lack of novelty pursuant to Article 54(3) EPC\*, the limitation or revocation of a European patent with unitary effect shall take effect only in respect of the participating Member State(s) designated in the earlier European patent application as published.

*\* “Additionally, the content of European patent applications as filed, the dates of filing of which are prior to the date referred to in paragraph 2 and which were published on or after that date, shall be considered as comprised in the state of the art.”*

**23 June 2011  
11328/11**

Article 5 - Prior  
rights

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## Applicable law

**26 May 2011 10629/11**

Article 5a - Law applicable to a European patent with unitary effect

A European patent with unitary effect shall be governed by:

- (a) this Regulation and Regulation .../... implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements and Union law;
- (b) in matters not covered by (a), the EPC;
- (c) in matters not covered by (a) or (b), national law including rules of private international law, determined in accordance with Article 10.

**23 June 2011  
11328/11**

Article 5a -  
Law applicable  
to a European  
patent with  
unitary effect

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# Unitary patent as an object of property (1)

**23 June 2011 11328/11**

## **Article 10 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, according to the European Patent Register:

- (a) the patent proprietor had his/her residence or principal place of business on the date of filing of the application for the patent; or
- (b) where subparagraph (a) does not apply, the proprietor had a place of business on that date...

# Unitary patent as an object of property (2)

**23 June 2011 11328/11**

**Article 10 Treating a European patent with unitary effect as a national patent**

...

2. Where two or more persons are mentioned in the European Patent Register as joint proprietors, paragraph 1(a) shall apply to the joint proprietor indicated first. Where this is not possible, paragraph 1(a) shall apply to the next joint proprietor indicated in the order of entry. Where paragraph 1(a) does not apply to any of the joint proprietors, paragraph 1(b) shall apply accordingly.

...

# Unitary patent as an object of property (3)

**23 June 2011 11328/11**

**Article 10 Treating a European patent with unitary effect as a national patent**

...

3. Where no proprietor has his/her residence or a place of business in a participating Member State for the purposes of paragraphs 1 or 2, the European patent with unitary effect as an object of property shall be dealt with in its entirety and in all the participating Member States as a national patent of the State where the European Patent Organisation has its headquarters in accordance with Article 6(1) of the EPC.

...



# Unitary patent as an object of property (4)

**23 June 2011 11328/11**

**Article 10 Treating a European patent with unitary effect as a national patent**

...

4. The acquisition of a right may not be dependent on any entry in a national patent register.

# Transfer

1. The transfer of the Community patent shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void. The transfer shall be entered in the Register of Community Patents.
2. Subject to Article 6(1), a transfer shall not affect rights acquired by third parties before the date of transfer.
3. A transfer shall, to the extent to which it is verified by such written documents referred to in paragraph 1, have effect vis-à-vis third parties only after entry in the Register of Community Patents.

Nevertheless, a transfer, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights after the date of the transfer but who knew of the transfer on the date on which the rights were acquired.

## Rights *in rem*

1. The Community patent may, independently of the undertaking, be given as security or be the subject of rights *in rem*.
2. At the request of one of the parties, the rights referred to in paragraph 1 shall be entered in the Register of Community Patents and published in the Community Patent Bulletin.

# Levy of execution

1. The Community patent may be levied in execution.
2. At the request of one of the parties, the levy of execution shall be entered in the Register of Community Patents of this Regulation and published in the Community Patent Bulletin.

# Insolvency proceedings

1. The only insolvency proceedings in which a Community patent may be involved shall be those instituted in the Member State within the territory of which the centre of a debtor's main interests is situated.
2. In the case of joint proprietorship of a Community patent, paragraph 1 shall apply to the share of the joint proprietor.
3. Where a Community patent is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the Register of Community Patents and published in the Community Patent Bulletin.

# Contractual licensing

1. The Community patent may be licensed in whole or in part for the whole or part of the Community. A licence may be exclusive or non-exclusive.
2. The rights conferred by the Community patent may be invoked against a licensee who breaches any restriction in the licensing contract.
3. Article 15(2) and (3) shall apply to the grant or transfer of a licence in respect of a Community patent.

# Conditions applicable to compulsory licences

When granting the compulsory licence under Article 21, the Court shall specify the type of use covered and the conditions to be met. The following conditions shall apply:

- a) the scope and duration of the exploitation shall be limited to the purpose for which it was authorized;
- b) the exploitation shall be non-exclusive;
- c) the exploitation shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;
- d) the exploitation shall be authorized predominantly for the supply of the internal market of the Community;
- e) ...

# Licences of right

**23 June 2011 11328/11**

## **Article 11**

1. The proprietor of a European patent with unitary effect may file a statement with the European Patent Office that he/she is prepared to allow any person to use the invention as a licensee in return for appropriate compensation.
2. A license obtained under this Regulation shall be treated as a contractual license.



# Grant of compulsory licences

1. The Court may grant a compulsory licence for lack or insufficiency of exploitation of a Community patent to any person filing an application four years or later after the patent application was filed and three years or later after the patent was granted if the patent proprietor has not exploited the patent in the Community on reasonable terms or has not made effective and serious preparations to do so, unless he/she provides legitimate reasons to justify his/her inaction, and on the condition that the grant of the compulsory licence is required in the public interest. In determining the lack or insufficiency of exploitation of the patent, no distinction shall be made between products originating within the Community and products imported to the Community from a member of the World Trade Organization.

...

## Effects vis-à-vis third parties

1. Legal acts referred to in Articles 16 to 22 concerning a Community patent shall have effects vis-à-vis third parties in all the Member States only after entry in the Register of Community Patents.

Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights concerning the patent after the date of that act but who knew of the act at the date on which the rights were acquired.

2. Paragraph 1 shall not apply in the case of a person who acquires the Community patent or a right concerning the Community patent by way of transfer of the whole of the undertaking or by any other universal succession.

# The application for a Community patent as an object of property

1. Articles 9a and 14 to 19 and Article 21(3) to (6), and Article 22 shall apply to the application for a Community patent, whereby it is understood that all references to the Register of Community Patents include references to the European Patent Register provided for by the EPC.
2. The rights acquired by third parties in respect of an application for Community patent referred to in paragraph 1 shall continue to be effective with regard to the Community patent granted upon that application.

# Will art. 10 solve all these problems?

**23 June 2011 11328/11**

## **Article 10**

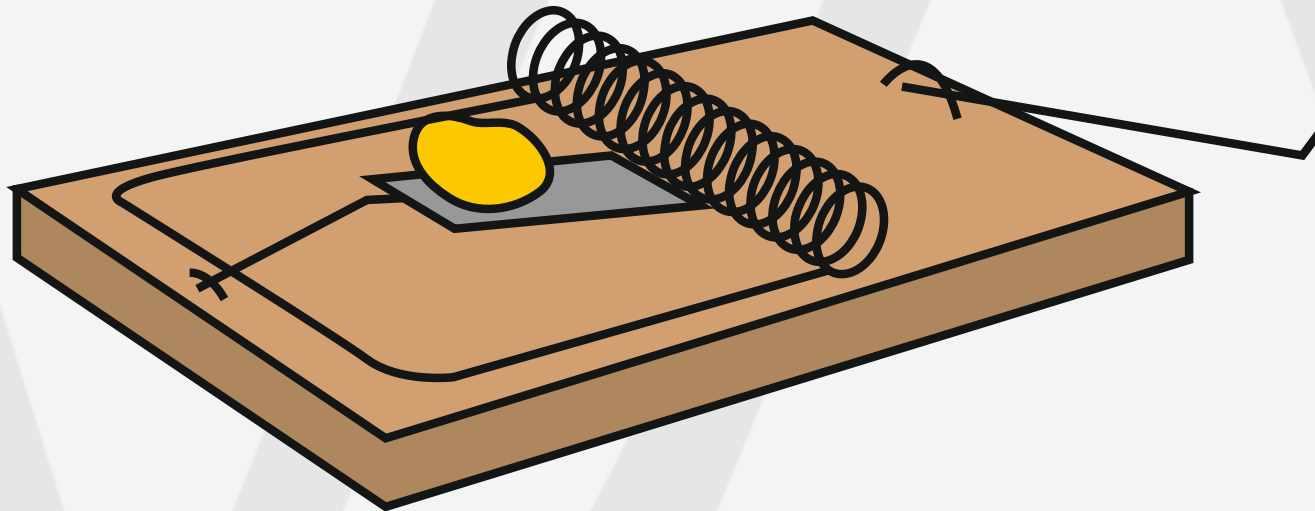
Treating a European patent with unitary effect as a national patent

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# An appealing topic?



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**Thank you**

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