

On the Status of the Patent System of the European Union¹

1. In its Statement on "The Future Patent System of the European Union" of 30 June 2011 ALLEA expressed the view that the creation of a European patent with unitary effect was long overdue and the possibility of creating a single European patent jurisdiction should be further explored. ALLEA has also encouraged the EU Commission to renew efforts to arrive at a meaningful, harmonised regulation of employee's invention law that will facilitate implementation of the future unitary EU patenting rules and to re-launch efforts aimed at ensuring that European law provides for a grace period similar to the one existing in the US law, but preceding the Union priority date.

2. Whereas ALLEA's pleadings in favour of renewed activities aimed at harmonising employee's invention laws and at re-launching actions related to the introduction of grace period remained unheard, the European Parliament and the Council on 17 December 2012 adopted the Regulation (EU) No 1257/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (Unitary Patent Regulation)². On the same day the Council Regulation (EU) No 1260/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements³ was passed. On 19 February 2013, 25 EU Member States signed an Agreement on a Unified Patent Court (UPC Agreement)⁴ as a treaty controlled by international public law rules.

3. ALLEA welcomes, in principle, the adoption of the Unitary Patent Regulation and the Regulation related to translation arrangements, as well as the signing of the UPC Agreement, despite the fact that the three legal instruments constitute a complex and complicated compromise, which does not meet all the expectations and whose implementation into practice will have to overcome several hurdles. Some of those hurdles may be predominantly technical, but some seem to be of fundamental im-

portance for the functioning of the entire system as designed. Therefore:

4. ALLEA observes that the adoption and the entry into force of the Unitary Patent Regulation, contrary to its title, has not yet created a "unitary patent protection" in the Member States participating in the enhanced cooperation because according to its Article 18 (2) (subparagraph 1) it will only be applied as from the date of entry into force of the UPC Agreement. The latter will be the case when thirteen Member States, including the three in which the highest number of European patents had effect in 2013, i.e. France, Germany and the United Kingdom, deposit their instruments of ratification or accession (Article 89 (1) of the EPC Agreement).

5. ALLEA further draws attention to Article 18 (2) (subparagraph 2) of the Unitary Patent Regulation which sets forth that a European patent for which unitary effect is registered in the Register for unitary patent protection, "shall have unitary effect only in those participating Member States in which the Unified Patent Court has exclusive jurisdiction with regard to European Patents with unitary effect at the date of registration." In other words, actual "unitary effect" will be generated by so-called "European patents with unitary effect" only for those participating Member States which are a contracting party to the UPC Agreement at the date of registration of a respective "European patent with unitary effect". No such "unitary effect" will be generated in participating Member States by "European patents with unitary effect" registered prior to their accession to the UPC Agreement. If for instance Belgium, Estonia or the Netherlands only accede to the UPC Agreement after it has entered into force, no mechanism exists in the Unitary Patent Regulation to add Belgium, Estonia or the Netherlands to the "unitary effect" that applies to such of those other Member States at the date of a particular patent's registration as a European Patent with Unitary Effect.

¹ This statement was issued by the [ALLEA Permanent Working Group on Intellectual Property Rights](#) in November 2015.

² OJ EU L 361/1 of 31.12.2012; ³ OJ EU L 361/89 of 31. 12.2012; ⁴ Doc. 16351/12.

6. ALLEA, therefore, urges the participating Member States to coordinate their accession to the UPC Agreement. Ideally, at its entry into force all signatory states should have deposited their instruments of ratification or accession. Only by doing so can a most unsatisfactory situation be avoided that even the territory of the participating Member States would constitute an area covered with registered "true" and "quasi" "European patents with unitary effect", depending on the date of their registration and/or depending on the date of the accession to the UPC Agreement by a Member State that had deferred its accession.

7. ALLEA emphasises that such coordinated accession to the UPC Agreement appears necessary also because of the complex and unusually entangled construction of the Unitary Patent Regulation and the UPC Agreement. The latter contains also substantive patent law provisions related to direct and indirect patent infringement (Articles 25 and 26), limitations of the effects of a patent (Article 27), prior user right (Article 28), exhaustion of the rights conferred by a European patent (Article 29) and effects of supplementary protection certificates (Article 30)! These core aspects of patent protection are not regulated in the Unitary Patent Regulation, and so arise outside the jurisdiction of the UPC. Arguably they would fall to be decided by national courts according to national patent law provisions of Mem-

ber States so long as they do not accede to the UPC Agreement.

8. ALLEA is of the opinion that, if at the time of entry into force of the UPC Agreement, (which is also at the date from which on the Unitary Patent Regulation will apply), not all signatories to the UPC Agreement will also be party to it, the EU Commission should undertake all necessary steps for an early revision of the EU Unitary Patent Regulation in order to at least ensure that "European patents with unitary effect" will in fact have that effect as of their actual registration in the register in all participating Member States in which the UPC will have exclusive jurisdiction, no matter whether that jurisdiction was already in place when the "European patent with unitary effect" was registered.

9. ALLEA regrets that its long-standing efforts for the introduction of a grace period in Europe, which would put European scientists on an equal footing with their colleagues, for instance in Australia, Canada, Japan and the United States of America, where such provisions exist, were again in vain. In view of the most recent international developments, such as the imminent entering into force of the Trans-Pacific Partnership (TPP) Treaty, whose chapter on Intellectual Property provides for a grace period of twelve months, however, ALLEA will not discontinue its efforts in this regard.

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