



National Prior Rights and the Unitary Patent

Young EPLAW 2015

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PNR & Classic EP

- **Not** EP-level prior art (Art 54(3) EPC)
 - No revocation ground
- **Only** national prior art to prevent double patenting (Art 139(2) EPC)
- **Three solutions**
 - Do not designate State
 - File separate claims for State
 - Fight national revocation action

PNR & Unitary Patent

- **Unitary**
 - Single right covering all participating MS
 - Same scope in all participating MS
 - Solution 1 and 2 not available
- PNR is a **ground for revocation**. Art 65 UPCA:
“Court may revoke ... on ground... 139(2) EPC”

Solution 1: Partial revocation

- **Revoke only for the problem State**
 - Fair outcome
 - Unitary effect is not Absolute (prior user rights & licenses)
- **Arguments against**
 - Not unitary
 - Why allow post-grant what is not allowed pre-grant?
 - In direct conflict with Art 3(2) Regulation

Solution 2: Apply for both

- **Art 4(2) Regulation**
 - Conflict rule for co-existence of EP-national and UP
 - EP-national has “no effect” if the UP extends to country
 - Possibility? : EP-national as a sleeping back-up for UP
- **Arguments against**
 - Expensive and a lot of hassle
 - Not in literal conflict with Regulation, but incompatible with goal
 - Possibility depends on national implementation of Art 4(2) Regulation

Solution 3: Conversion

- **Conversion is fair**
 - Patentee loses benefits of the UP because of lack of quality
 - Patentee keeps protection, if he is willing to comply with higher costs and trouble of traditional bundle
- **Legal basis:** Art 135(1)(b) EPC.
 - Needs national implementation
- **Solution is compatible with Regulation**
 - Respects unitary effect (unlike solution 1)
 - Avoids unnecessary costs and trouble (unlike solution 2)