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)