

New Article 5a of the Regulation on Unitary patent protection

Uniform Protection

- (1) The European patent with unitary effect shall confer on its proprietor the right to prevent any third party from committing acts against which the patent provides protection throughout the territories of the participating Member States in which the patent has unitary effect, subject to applicable limitations.
- (2) The scope of this right and its limitations shall be uniform in all participating Member States in which the patent has unitary effect.
- (3) The acts against which the patent provides protection referred to in paragraph 1 and the applicable limitations shall be those defined by the law applied to European patents with unitary effect in the participating Member State whose national law is applicable to the European patent with unitary effect as an object of property in accordance with Article 10.
- (4) In the report referred to in Article 20(1) the Commission shall evaluate the functioning of the applicable limitations and, where necessary, shall make appropriate proposals.

New Recitals 9 and 10 of the Regulation on unitary patent protection

Recital 9

The European patent with unitary effect should confer on its proprietor the right to prevent any third party from committing acts against which the patent provides protection. This should be ensured through the establishment of a Unified Patent Court. In matters not covered by this Regulation or by Council Regulation No .../2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regards to the application translation arrangements, the provisions of the EPC, the Agreement on a Unified Patent Court, including its provisions defining the scope of the right and its limitations, and national law including rules of private international law shall apply.

Recital 10

In the report referred to in Article 20(1) of this regulation the Commission shall evaluate the functioning of the applicable additional limitations and, where necessary, shall make appropriate proposals, taking account of the contribution of the patent system to innovation and technological progress, the legitimate interests of third parties or overriding interests of society. The Agreement on a Unified Patent Court does not preclude the European Union from exercising its powers in this field.

Explanations

1. The proposed new Article 5a of the UPP Regulation is based on the assumption that it would seem sufficient that the UPP Regulation itself provides for the right of the patent proprietor to prevent third parties from committing acts against which the patent provides protection. These acts cover both the direct and the indirect use of the patented invention by a third party (as initially spelled out in more detail in the former Articles 6 and 7 of the UPP Regulation). The right of the patent proprietor to prevent third parties from such acts is subject to applicable limitations (as initially spelled out in former Article 8 of the UPP Regulation). The details of this right and its limitations are now determined pursuant to new Article 5a(3) of the UPP Regulation – by reference to the national law of the Member State applicable under Article 10 of the UPP Regulation of which Articles 14f to 14i of the UPC Agreement (as now amended to apply also to European patents with unitary effect, see in more detail point 3 below) are an integral part.
2. The UPP Regulation furthermore stipulates in new Article 5a(2) that the right to prevent third parties from infringing the patent and the limitations to this right shall be uniform in all participating Member States in order to satisfy the requirement of the Regulation's legal basis, i.e. Article 118(1) TFEU which provides for the establishment of uniform protection. This means that participating Member States are prevented from adopting in their national law provisions which would undermine the uniformity of protection.
3. Pursuant to new Article 5a(3) UPP Regulation, uniformity of protection will be achieved by the reference to the law of the participating Member State whose law is applicable to the European patent with unitary effect as an object of property pursuant to Article 10 UPP Regulation. Implicitly this refers to Articles 14f to 14i of the UPC Agreement, which correspond to the former Articles 6 to 8 of the UPP Regulation and which define the scope of the right of the proprietor, its limitations and prior user rights. Articles 14f to 14i of the UPC Agreement which previously applied only to "classical" European bundle patents have now been amended so that they now apply also to European patents with unitary effect. These Articles defining the scope of the right, its limitations and prior use rights will form an integral part of the national law of each participating Member State in which the UPC Agreement will come into force and for which the European patent with unitary effect will become operational.

New Recital 9 recalls the link between the uniform protection provided for by the European patent with unitary effect and the creation of the Unified Patent Court and adds a reference to the provisions of the UPC Agreement to already existing references to the EPC and to national law. This underlines that the scope of the right and its limitations regulated in Article 5a UPP Regulation are those regulated in more detail in the relevant provisions of the UPC Agreement.

There is no risk that the European patent with unitary effect will come into force without the relevant provisions in the UPC Agreement being applicable, since there exists already a formal link between the entry into force of the UPC Agreement and the UPP Regulation. The latter comes into application only once the UPC Agreement has come into force and only in those participating Member States where the UPC Agreement is in force. This link has become part of the Trilogue Agreement at the request of the European Parliament. Consequently, it would seem sufficient to regulate the scope and

the limitations in the legal form of a reference to the detailed provisions defining the right and its limitations in the UPC Agreement, which will be part of the national law of each participating Member State.

4. Politically, a very sensitive issue are the limitations to the right of the patent proprietor. For this reason, new Article 5a(4) UPP Regulation explicitly recalls the role of the EU legislator to address this issue through possible future EU legislative initiatives by providing that the European Commission shall evaluate the functioning of the limitations and, where necessary, make appropriate proposals. The corresponding Recital 10 contains some criteria which the Commission should take into account when evaluating the need for additional limitations as foreseen in new Article 5a(4) UPP Regulation.
5. As a result of this new construction, the law applicable to the scope of the right of the patent proprietor, its limitations and prior user rights will be uniform. The details relating to the scope of right are no longer contained in the UPP Regulation itself but in the UPC Agreement.