

## What patent laws apply in the UPC?

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## What areas of law are at issue?

- > Acts of infringement;
- > Approach to scope of claims;
- > Validity;
- > "objects of property";
- > Law governing patent agreements;
- > Miscellaneous matters, eg unjustified threats, contempt of court etc

# Infringement law in the UPC

> Two relevant, applicable agreements:

– Regulation (EU) 1257 / 2012 ("UP Regulation"): Article 5(3);

– UPC Agreement: Article 24, sources of law:

- Union law;
- the UPC Agreement;
- the European Patent Convention;
- other international agreements applicable;
- national law.

European  
patents  
(‘classicals’)

Unitary  
Patents

## Infringement of Unitary Patents – Article 5

- > Concern that UP Regulation infringement provisions referable to CJEU;
- > Infringement provisions replaced eventually with Article 5(3);
- > Article 5(3) – the acts against which protection is provided are those defined by:

*the law applied to [Unitary Patents] in the participating Member States whose national law is applicable to the [Unitary Patent] as an object of property in accordance with Article 7.*

## Infringement of Unitary Patents – Article 5 meaning?

- > Interpretation **A**: Article 7 applies – law according to place of business etc of applicant;
- > Interpretation **B**: Article 5(3) refers to laws enacted by Member State to apply to Unitary Patent (ie the UPC Agreement and UP Regulations).
- > Most seem to agree on **B**. Five reasons:
  - B results in uniform treatment of Unitary Patents; A does not;
  - B results in equality of treatment of UPs and EPs; A does not;
  - Article 5 doesn't require Unitary Patent to be treated as national patent;
  - Explanatory note to Article 5 states that the reference to national law means UPCA (specifically Articles 25 to 27)\*;
  - **A** conflicts with Regulation (EC) 864/2007 ("Rome II").

## Infringement – sources under Article 24(1) UPCA

- > UPC Agreement applies to Unitary Patents and classicals:
  - Article 25 – right to prevent the direct use of the invention.
  - Article 26 – right to prevent the indirect use of the invention.
  - Article 27 – limitations on the effect of a patent.
  
- > EPC: Article 69 and Protocol on the Interpretation of Article 69;
  
- > How are they to be interpreted? eg:
  - infringement of second medical use claims;
  - interpretation of 'Bolar' exemption;
  - use of doctrine of equivalents?
  
- > National law is remaining choice in Article 24 UPCA; but which one?

## Infringement – which national law applies?

- > Article 24(2) UPCA provides rules on choice of applicable national law:
  - Union law containing private international law rules; or in its absence;
  - International instruments containing private international law rules; or in its absence;
  - National provisions on private international law.
  
- > Applicable Union law is Regulation (EC) 864/2007 ("Rome II").

## Infringement – national law – Rome II

- > Classicals: law of the country in which protection claimed (*lex loci protectionis* rule) (Article 8(1));
- > Unitary rights: Article 8(2) – the law of the country of infringing act.
- > Result of applying Rome II:
  - a fragmented approach depending on place of infringement?
  - application of different national laws if infringement in more than one Member State (conflicts with unitary protection (Article 5(2))?)
  - what about pan-EU declaration of non-infringement?
  - different results for different parts of a classical bundle?



## Validity

- > Article 24(1)(c) UPC Agreement applies:
  - the European Patent Convention;
  - national law.
  
- > Boards of Appeal authority not binding (but influential?);
  
- > Which national law?
  - how is law of country of protection applied to classical bundle?
  - How is law of country of protection applied to Unitary Patent?
  
- > Application of multiple, national strands of law unworkable!

## Discussion

- > Preliminary injunctions;
- > Scope of claims;
- > Acts of infringement;
- > Validity;
- > Practice.

