

Kluwer Patent Blog

Opting out European patents risks to trigger the liability of patent attorneys

Pieter Callens (Eubelius) · Sunday, January 24th, 2016

On Friday 22 January 2016, the annual ERA (Academy of European Law) conference on the Unitary Patent took place in Brussels.

Regarding the agreement reached on the renewal fees, Clemens Heusch, head of European litigation at Nokia, explained that although Nokia currently has more than 30,000 (!) patent families in its patent portfolio, he finds the current level of renewal fees acceptable. The position of Nokia was backed by the representative of Business Europe, Mr. Ilias Konteas. Hence, we could conclude that the Select Committee of the Administrative Council of the EPO, chaired by Mr. Jérôme Debrulle, met up with the expectations regarding the renewal fees of the Unitary Patent. Especially the witticism “the fees shall be less than you fear and higher than you hope” long used by the president and other representatives of the EPO, did not appear to be hollow words after all.

The president of the Preparatory Committee, Alexander Ramsay, stressed at the ERA conference that the sunrise period for opting-out European patents would in any event start during the period of provisional application of the UPC Agreement. Between the lines of the presentations of different speakers we could read that there remains a realistic chance that no fees shall be charged for opting out of the system. The electronic payment of such fees in case of opt-out appears to be one of the factors to leave out any opt-out fee.

As it is currently foreseen, patent proprietors shall have to opt-out their patents per patent family. The opt-out shall be for all EPC member states in which the patent is validated. That means that also non-UPC member states or member states having not yet ratified the Agreement, shall be included in the opt-out. This is to avoid that an additional opt-out should become necessary once a Member State would decide to ratify during the lifetime of the European patent. Because of the different data regarding your patent you have to provide to opt-out, it will not be possible to opt-out a patent portfolio by one mouse click. Each patent family will take a minute or so to electronically opt-out.

Another issue which shall be important when opting-out is to make sure that all patent proprietors are involved. Nor the EPO, nor the UPC registrar shall check whether the

opt-out has been done properly. Therefore, Kevin Mooney warned patent attorneys to carefully address opt-outs requested by the patent proprietor(s). Patent attorneys shall have to perform due diligence in order to certify if they are authorized by all patent proprietors to opt-out. It is their responsibility if opt-outs are not performed correctly. The patent attorney shall not be able to rely on the European patent register to decide who the proprietor of a European patent is. In most cases in which patents are transferred or co-owned (including the split-up per member state of the ownership), patent proprietors do not bother to register the transfer or co-ownership. Rule 5.1 (b) of the Rules of Procedure clearly provides that all proprietors of a European patent need to lodge the application to opt-out. If the person lodging the application to opt out is not recorded as the proprietor(s) or applicant(s) in the European register, that person needs to lodge a Declaration of proprietorship. In the 18th (and final) draft of the Rules of Procedure it was clarified that a “proprietor” of a European patent is the person “entitled to be registered as proprietor(s) under the law of each Contracting Member State in which the European patent has been validated”, whether or not such person is in fact recorded in the register. For persons registered in each national patent register and the European Patent Register there is a rebuttable presumption that such person is entitled to be registered as proprietor (Rule 8.5. (c) RoP). But since this presumption is rebuttable, it will be the task of the parties (and its representatives) to verify the ownership rights. Nor the EPO, nor the UPC will do so. The opt-out procedure is meant to be “mechanical”. Therefore, if afterwards it appears that the opt-out was not done properly and the patent was subject to a UPC procedure (e.g. revocation action), the liability of the patent attorney could be triggered. Since the sunrise period for opt-outs shall most likely be only a few months, it is important for patent attorneys to carefully address questions to opt-out, certainly if it concerns large patent portfolios.

For more information on the opt-out procedure we refer to the upcoming second edition of the Kluwer International Law publication: P. CALLENS & S. GRANATA “Introduction to the Unitary Patent and the Unified Patent Court”, to be published in 2016.

To make sure you do not miss out on regular updates from the Kluwer Patent Blog, please subscribe [here](#).

Want to improve your IP strategy?

- Manual of Industrial Property
- IP Analytics
- Visser – Annotated European Patent Convention

230+ jurisdictions

36,000+ cases

100+ books

600+ IP law professionals as authors



This entry was posted on Sunday, January 24th, 2016 at 3:28 pm and is filed under [EPO](#), [UPC](#)

You can follow any responses to this entry through the [Comments \(RSS\)](#) feed. Both comments and pings are currently closed.