

Kluwer Patent Blog

Kevin Mooney: Provisional period of the Unified Patent Court could start in January 2016

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January 2016: start of the so-called provisional period. October 2016: first cases taken. That may be a realistic timetable for the future Unified Patent Court, according to Kevin Mooney, chairman of the Committee that prepared the draft Rules of Procedure for the UPC.



Kluwer IP Law spoke to Mooney about the progress of the Legal Framework Group of the Preparatory Committee, which has been finalising the Rules of Procedure (RoP) for the new specialized European patent court. The [17th Draft](#) was discussed with a wide spectrum of users in Trier on 28 November 2014 and a final version of the RoP is due by July.

The provisional period is the transitory phase which is envisaged before the UPC Agreement comes into effect (with 13 ratifications, including those of France, Germany and the UK). It will give the UPC time to hire people, appoint a president, furniture and move into its premises, put the IT system in place, in other words to make all preparations necessary for its functioning.

As the UPCA doesn't provide for a transition period, there has been some discussion how to create the legal framework for this phase. Among others, Article 25 of the [Vienna Convention](#) on the law of treaties has been considered. It regulates the entry into force of treaties and specifies certain parts can 'apply from the time of adoption of its text'. The problem is that France isn't a member to the Convention. According to Kevin Mooney however, the principles as laid out in the Vienna Convention are seen as reflecting customary international law and may be the basis for the provisional period.

The creation of the transitional period is especially important for businesses that want to opt-out their patents from the jurisdiction of the UPC. This will probably concern tens of thousands, if not hundreds of thousands of patents; and it will take the UPC quite some time to handle all these opt-outs.

Under article 83 (3) of the UPC Agreement the opt-out 'shall take effect upon its entry into the register'. This is problematic, according to Mooney, because it creates a period of uncertainty between the moment companies apply for an opt-out and the moment the application has been fully processed. Moreover, if businesses can only opt-out patents on day one of the functioning of the UPC, there is a risk that parties such as NPEs will block this by starting litigation at the UPC

before entry of the opt-out on the register. In that case an opt-out is no longer possible.

There has been broad consensus that, because of these issues, companies should be able to complete the opt-out of patents during a sunrise period. But it is still not clear how this will be organized, according to Mooney. The European Patent Office has offered to register opt-outs this sunrise period, but it says it cannot receive nor administer the fees, and despite some debate with the UPC Preparatory Committee, hasn't changed its mind. If the EPO sticks to its position, it seems the Committee may have to create its own register for both registration of opt-outs and fee payments during the provisional period referred to above.

Various other issues are still under discussion at the Legal Framework Group, one of the bigger ones being a language issue, according to Mooney. 'Under the current Rules of Procedure it is the claimant who can choose the language of the proceedings where there is a choice, but some German judges have insisted on the option to write at least their judgments in their own language. This is still open.'



Kevin Mooney

As to injunctions, especially businesses in the US have been protesting the perceived lack of discretion of UPC judges under the 17th Draft to apply other sanctions in case of infringements. Critics made much of a remark in the Explanatory Notes of the 17th Draft, which states that: 'Where the Court finds an infringement of a patent it will under Article 63 of the Agreement give injunctive relief. Only under very exceptional circumstances it will use its discretion and not give such an order.' In the new Draft, it seems the phrase 'very exceptional' will be omitted.

Another problem, which until recently was overlooked, has been repaired in the proposed final, 18th Draft. The moment a patent is validated, the proprietor is registered. But when patents are sold or traded, companies most often don't bother to change the register. That is a very widespread practice.

Kevin Mooney acknowledges that 'we were very late in realizing that we had given patent "proprietors" all kinds of rights and obligations in the Rules of Procedures, but hadn't made clear who were to be considered as "proprietors". In the new Draft, we have adapted the text at some points and made clear that the "proprietor" is the not the registered person or company, but the entity that is "entitled to be registered".'

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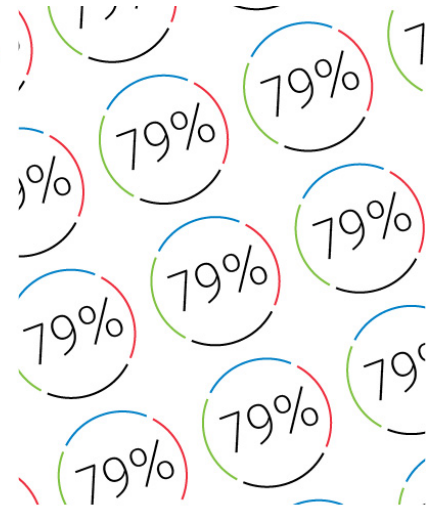
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