

Kluwer Patent Blog

Finally the ‘final’ version of the Rules of Procedure of the Unified Patent Court

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On 10 April 2017 the UPC Preparatory Committee published the ‘final’ version of the 18th draft of the Rules of Procedure, as adopted during the committee meeting of 15 March 2017. This is still a draft, since only the Administrative Committee can really adopt the Rules of Procedure. This requires that the Protocol on Provisional Application enters into force, which is expected to happen in May.

The latest draft incorporates some material changes and editorial changes. The first good news is that the numbering of the rules has not changed, so all existing publications and presentations on these rules can still be used easily. Explanatory notes were drafted for the most important changes, but apparently only for internal use within the Preparatory Committee, as these notes have not been published.

Opt-out

Rule 5 now clearly specifies that an opt-out should be done on behalf of each proprietor who is entitled to be registered in the national patent register. These are the actual proprietors, not those currently recorded in the register. The opt-out can be filed by a representative as meant in article 48 UPCA (a lawyer or a qualified European patent attorney) or by any other person. In the latter case a specific mandate should also be filed. Each proprietor should file a declaration that he is entitled to be registered in the national patent register.

Obviously, the mandate will need to be signed by a company official who is authorized to represent the company according to the national law that governs such company. Such an official can of course also file the application himself.

If any error has been made with regard to these requirements, the opt-out will only be valid as of the date when a correction has been registered. However, errors may only become clear when the Court has to decide on the admissibility of a revocation action or a declaration of non-infringement; the validity of opt-outs is not checked by the Court registry before they are registered.

When unitary effect is granted for a patent that was opted out, that opt-out is deemed to be withdrawn. This makes sense, as the UPC has exclusive jurisdiction with regard to Unitary Patents.



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It may very well be that not all Contracting Member States have already ratified the UPC Agreement when it enters into effect. At that point in time, the Court will only have jurisdiction for the countries that have ratified and the unitary effect of a Unitary Patent will only cover those countries. The proprietor will have to decide on validation as a traditional European (bundle) patent for the remaining Contracting Member States. When such states ratify later on, the unitary effect that was granted previously will not be extended to them. Thus, in those countries bundle patents will continue to exist in parallel to a Unitary Patent. A small change has now been made to Rule 5.9, due to which such bundle patents for Contracting Member States where a Unitary Patent applies to other Contracting Member States cannot be opted out of the UPC jurisdiction. The aim was to have all such patents, both the Unitary Patent and the parallel bundle patents, within the jurisdiction of the UPC. This should only be a temporary situation, as over time all Contracting Member States are expected to ratify the UPC Agreement and therefore Unitary Patents granted thereafter will apply to the whole UPC territory.

Obviously, the Preparatory Committee can change the Rules of Procedure, but not the Agreement itself. Although such bundle patents in this specific situation cannot be opted out, claimants still have the opportunity to bring actions before national courts during the transitional period.

Preserving evidence, provisional measures and protective letters

If an application to preserve evidence is filed, the Court may decide to inform the defendant, but if it intends to do so, it shall give the applicant the opportunity to withdraw the application under Rule 194.5. If there is a protective letter on file, the applicant has to be informed of this and also given the opportunity to withdraw according to Rule 194.6. The same now applies to requests for ex parte provisional measures. In such case, the withdrawn application will remain confidential. This change also makes it clear that protective letters may be aimed at measures to preserve evidence as well as at applications for provisional measures (especially ex parte injunctions).

Other amendments

Rule 94, which is part of the rules on actions against EPO decisions, now provides that the judge-rapporteur can invite the President of the EPO to submit his comments on any question also on appeal and not only in first instance.

An omission in Rule 97 has been corrected, in that the Registry shall check whether an appeal against a refusal to grant unitary effect meets the formal requirements before it is recorded in the register. The rest of the changes are corrections of minor errors, omissions and errors in cross-references.

Conclusion

There have only been some minor changes in this latest version of the Rules of Procedure. That doesn't mean that every imaginable situation is now fully regulated by the Rules of Procedure. The rules still allow for a lot of flexibility and some issues are not covered, but that must now be assumed to be intentional; it is up to the Court to fill in the gaps in its case law.

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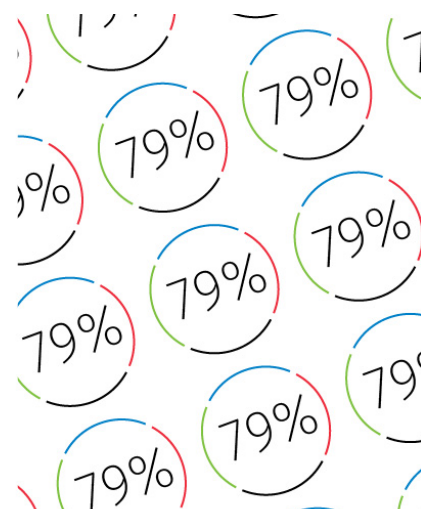
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