

# Kluwer Patent Blog

## UPC – the great paradox: why the CJEU could bring in “uniform protection” and “equal effect” when interpreting the EU’s “external” patent law (e.g. TRIPS), notwithstanding the futile efforts at keeping its grubby little hands off “internal” patent law

Miquel Montaña (Clifford Chance) · Monday, June 20th, 2022

Readers who have followed our last two blog entries and the vast number of comments received, will have seen the following two conclusions surfacing. First, although the UPC ‘s Protocol on Provisional Application, in reality, may not be in force, there is nothing to worry about because there are no police around. Second, there is nothing to worry about, either, in the crystal-clear wording of articles 7(2) and 89 of the UPCA, because the rule of law will be an accidental feature of the UPC edifice. The important thing will be the creative interpretations devised by a bunch of people holed up in a dark room with bullet-proof walls (*rectius*, transparency-proof) for the purpose of preventing ordinary European citizens and small and medium size enterprises from having a say on where the UPC should be heading after Brexit.

As a sidenote, may we recommend that readers peruse the exchange of views that followed our last blog (19 May 2022), on the primacy of EU law over international treaties or the other way round. Certainly, it is a fascinating topic that, as usual, the EU Council Legal Service tried to sweep under the rug when it initially deleted footnote 23 from its opinion of 21 October 2011 regarding the compatibility of the amended UPCA with Opinion 1/2009.

Today we will move on to a different topic, which is the removal of articles 6-8 (i.e. substantive patent law) from the text of draft Regulation 1257/2012 (the “Regulation”). As readers are well aware, the objective of removing substantive patent law from the text of the Regulation was to try to prevent the CJEU from getting its -to put it mildly- grubby little hands, on the new European patent with unitary effect. It is an irony of destiny that the Prime Minister who played such a crucial role in achieving that removal was leading a country that is no longer an actor in the UPCA theatre. In any event, the result of such removal is that the European patent with unitary effect will have anything but “uniform protection” and “equal effect,” as the effect and protection will be determined by the national law applicable to the particular patent at hand. In short, this means that, at least conceptually, different patents may have different protection and different effects, depending on whether the patent at hand is subject to, say, German or to Portuguese law. Under this light, the use of the expressions “uniform protection” and “equal effects” in article 3.2 of the Regulation is another of the very amusing features of this project. The same applies to article 5 (“uniform protection”), a title that, for the reasons explained elsewhere, appears to have been

chosen by Groucho Marx (see “La Patente Europea con Efecto unitario y el Tribunal Unificado de Patentes: de la anhelada patente de la Unión Europea a la “descomunitarización” del Derecho Europeo de Patentes”, in *Colección de trabajos en conmemoración de los 50 años (1963-2013) del grupo español de la AIPPI*, Spanish Group of AIPPI (2015), p. 629-719.)

The great paradox of all this is that the only institution that would be able to bring in the “uniform protection” and the “equal effects” required by the Regulation for European patents with unitary effect is precisely the CJEU. We already flagged-out this alert for seafarers a few years ago (in “The Practical Consequences of the CJEU Judgment of 18 July 2013 Changing Its Doctrine on the Respective Competences of the EU and its Member States to Apply the TRIPS Agreement: Have We Seen the Tip of the *Daiichi* Iceberg Yet?”, in *IIC* (2017) 48:784-812).

As that article explains, in 2012, the European Commission was conspiring with the other political institutions and the EU Member States to remove, from the CJEU’s agenda, the ability to interpret “internal” patent law (i.e. original articles 6-8 of the Regulation). In parallel, the Commission was persuading the CJEU to take over the competency to interpret “external” patent law (e.g. TRIPS). It was successful, as shown by the Judgment of 18 July 2013, where the CJEU, in changing its previous long-standing doctrine, declared that it had competence to interpret TRIPS. As mentioned above, the great paradox of all this is that the EU political institutions and the Member States’ successful efforts at removing substantive patent law from the Regulation did not take into account that, notwithstanding these efforts, substantive patent law may end up on the CJEU’s desk through the backdoor, that is, through the interpretation of the patent provisions of TRIPS.

This is because, according to article 24(1) of the UPCA:

*“In full compliance with Article 20, when hearing a case brought before it under this Agreement, the Court shall base its decisions on: (a) Union law, including Regulation (EU) No 1257/2012 and Regulation (EU) No 1260/2012; (b) this Agreement; (c) the EPC; (d) other international agreements applicable to patents and binding on all the Contracting Member States; and (e) national law.”*

The most significant of the “other international agreements” mentioned in letter (d) is precisely TRIPS.

The “external” patent law that falls within the interpretative competence of the CJEU includes not only the “enforcement” provisions of Part III of TRIPS, which have since then become “internal” patent law (i.e. Directive 2004/48), but also “substantive” patent law (i.e. Section 5 of Part II of TRIPS).

In turn, Art. 21 of the UPCA states that:

*“As a court common to the Contracting Member States and as part of their judicial system, the Court shall cooperate with the Court of Justice of the European Union to ensure the correct application and uniform interpretation of Union law, as any national court, in accordance with Article 267 TFEU in particular. Decisions of the Court of Justice of the European Union shall be binding on the Court.”*

In conclusion, as announced in the title of this blog, the great paradox of the futile efforts at trying to keep the CJEU’s grubby little hands off “internal” patent law is that only those hands, when interpreting “external” patent law, will be able to bring the “uniform protection” and “equal effect”

cherished by the Regulation.

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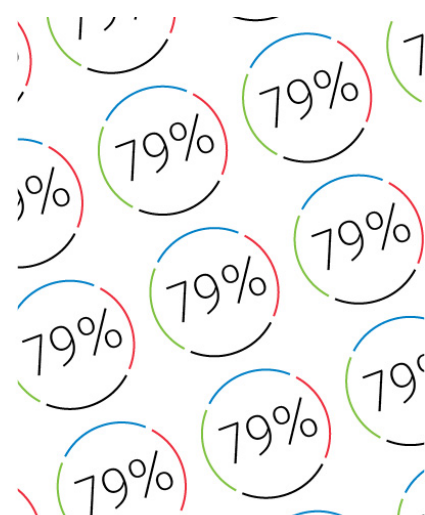
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This entry was posted on Monday, June 20th, 2022 at 6:04 pm and is filed under [European Union, Patents, Unitary Patent, UPC](#)

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