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Impact on patent owners caused by
use of national law in the Unified
Patent Court

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Contents

| | |
|---|-----------|
| SUMMARY | 1 |
| SAMMANFATTNING..... | 2 |
| PREFACE..... | 3 |
| ABBREVIATIONS | 4 |
| 1 INTRODUCTION | 6 |
| 1.1 Background | 6 |
| 1.2 Purpose and research questions | 7 |
| 1.3 Methodology and delimitations | 7 |
| 1.4 Outline | 8 |
| 2 THE EUROPEAN PATENT SYSTEM | 9 |
| 2.1 European Patent Convention..... | 9 |
| 2.2 European Patent (EP) | 9 |
| 2.3 Law and Practice | 10 |
| 2.4 European Patents as objects of property..... | 10 |
| 3 UNIFIED PATENT COURT AGREEMENT | 11 |
| 3.1 The European patent package | 11 |
| 3.2 The Unitary Patent (UP) | 11 |
| 3.2.1 What is a Unitary Patent?..... | 11 |
| 3.3 The Unified Patent Court (UPC)..... | 12 |
| 3.3.1 About the UPC | 12 |
| 3.3.2 Competences | 12 |
| 3.3.3 Legal order | 12 |
| 3.3.4 Transitional period | 13 |
| 4 USE OF NATIONAL LAW BY UPC | 14 |
| 4.1 Systematic review | 14 |
| 4.2 Exertion of explicit competences | 14 |
| 4.2.1 General on UPC's explicit competences | 14 |
| 4.2.2 General patent law issues | 15 |

| | | |
|------------|--|-----------|
| 4.2.3 | Prior usage..... | 17 |
| 4.2.4 | Preliminary measures | 18 |
| 4.3 | Issues raised by defences..... | 19 |
| 4.3.1 | General about defences | 19 |
| 4.3.2 | Contractual matters | 20 |
| 4.3.3 | Patent as an object of Property | 21 |
| 5 | ANALYSIS | 22 |
| 5.1 | When may National law be applied? | 22 |
| 5.2 | The patent owner's perspective | 22 |
| 5.2.1 | Harmonised patent law..... | 23 |
| 5.2.2 | National prior rights | 24 |
| 5.2.3 | About prior use..... | 24 |
| 5.2.4 | The lack of material regulation | 24 |
| 6 | CONCLUSION | 27 |

Summary

This thesis seeks to investigate and clarify the sources of law defined by Article 24 of the Unified Patent Court Agreement (UPCA). The legal sources of UCPA comprises a combination of the agreement itself, other common legal instruments, and national law. National law has lowest priority but may be a reason to concern when applied by a unified court, as it may cause uncertainty and contravene harmonisation.

To provide a better understanding of how the legal sources of UPC interact, the competences of UPC have been analysed, from the patent owner's perspective, to identify applicable law for different legal issues.

The review have revealed that most uncertainty regarding how the UPC will rule is not caused by application of national law but has to do with that the UPC is a completely new jurisdiction where harmonisation of patent law will to a large extent be provided when UPC starts to make decisions.

The main area where national legislation will continue to be applied, concerns material aspects of patents. This is not necessarily a major issue for patent owners, as the regulations appear to be predictable and relatively unified from the perspective of the patent owner. However, it is important that patent owners are aware about how they may influence what law will be applied to material aspects of their patents.

Sammanfattning

Denna uppsats syftar till att undersöka och klargöra den rättsordning som definieras av artikel 24 i Avtalet avseende en enhetlig patentdomstol (UPCA). UPCA:s rättskällor består av en kombination av avtalet självt, andra gemensamma rättsliga instrument och nationell lagstiftning. Nationell lag har lägst prioritet men kan ändå vara problematisk när den tillämpas av en enhetlig domstol, eftersom det kan skapa osäkerhet och motverka harmonisering.

För att ge en bättre förståelse för hur UPC:s rättskällor samverkar, har UPC:s kompetenser analyserats, ur en patentinnehavares synvinkel, för att identifiera tillämplig lag för olika rättsliga problem.

Granskningen har visat att osäkerhet avseende hur den UPC kommer att döma inte huvudsakligen beror på tillämpning av nationell lagstiftning, utan har istället att göra med att UPC är en helt ny jurisdiktion där harmonisering av patenträtten i stor utsträckning kommer att tillhandahållas när UPC börjar fatta beslut.

Det huvudsakliga område där nationell lagstiftning även fortsättningsvis kommer att appliceras, avser materiella aspekter av patent. Detta är dock inte nödvändigtvis ett problem för patentinnehavare, eftersom regelverket tycks vara förutsägbart och relativt enhetligt ur patentinnehavarens perspektiv. Det är dock viktigt att patentinnehavare är medvetna om hur de kan påverka vilken lag som kommer att tillämpas på materiella aspekter av deras patent.

Preface

The Unitary Patent and the Unified Patent Court have been discussed for so long that many people have probably lost faith in that it will ever happen. In 2016 I joined a course to improve my understanding of the complex regulations of UPCA. The day after my exam Great Britain made the decision to exit the European Union, which caused the entire collaboration to be put on hold. When I started writing this thesis, the date for the entry into force had been announced. Since then the date has been postponed once, this time due to technical problems. I believe that this confirms how complex and significant this change is, on so many levels. But at least it now seems like the UPC will finally happen, if not on June 1st, at least in a foreseeable future.

Abbreviations

| | |
|-------------------|---|
| BoA | Board of Appeal of the Unified Patent Court |
| classic EP | European Patent without unitary effect |
| EPC | 17th edition European Patent Convention, November 2020 |
| EPC states | Member states of the European Patent Convention |
| EPO | European Patent Office |
| EP | European Patent |
| EPUE | European Patent with Unitary Effect |
| EU | European Union |
| EU states | Member states of the European Union |
| EPUE Reg | Reg.1257/2012 REGULATION (EU) No 1257/2012 OF THE EUROPEAN PARLIAMENT AND OF THE COUNCIL of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection |
| EC Reg No 6/2002 | Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs |
| EU Reg. 2017/1001 | Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark |
| FRAND | Fair, Reasonable, and Non-Discriminatory |
| PatL | Swedish Patent Act (Patentlagen) |
| PMD | Swedish Patent and Market Court (Patent och Marknadsdomstolen) |
| PMÖD | Swedish Patent and Market Appeal Court (Patent och Marknadsöverdomstolen) |
| RoP | Rules of Procedure of the Unified Patent Court |

| | |
|--------------|---|
| Rome I | Regulation (EC) 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations |
| Rome II | Regulation (EC) 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations |
| TFEU | Treaty of the Functioning of the European Union |
| TRIPS | Agreement on Trade-Related Aspects of Intellectual Property Rights |
| Union states | Member states of the European Union |
| UPC | Unified Patent Court |
| UPCA | Agreement on a Unified Patent Court |
| UPCA states | EU States party of UPCA (Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Portugal, Slovenia, Sweden) ¹ |

¹ <https://www.unified-patent-court.org/en>

1 Introduction

1.1 Background

After decades of preparation, the entry into force of the UPC Agreement (UPCA) is currently planned for June 2023.² It is expected that UPCA will bring considerable benefits in terms of a simplified and more cost-efficient procedure, where patent protection can be obtained and litigated jointly in all UPCA states using one single procedure. However, there are also concerns. Along with the unified process comes the risk that a unitary patent may be revoked by one single decision, which may be particularly troublesome for companies relying on income from patent licences. Also, economical disadvantages have been identified, such the lack of a possibility to abandon individual countries of an EPUE to reduce renewal fees.³

In addition, unpredictability of UPC decisions is a hot topic. There is an ongoing discussion among various legal experts regarding how UPC will rule on issues associated with for example prior use, national prior rights, material aspects, and FRAND licences.^{4,5,6} The UPCA has on top of this received criticism for failing in achieving the harmonisation on the material aspects of patents.⁷

Some degree of unpredictability is probably inevitable when a new jurisdiction is created. However, something that is repeatedly mentioned in the discussion is application of national law. Hence, one contributing factor to the uncertainty may be associated with the legal order defined in the UPCA. The reason is that the UPC will not only apply sources of law common to all UPCA states but is also allowed to apply national law as a last resort⁸. This

² Unified Patent Court, “Adjustment of the timeline – Start of the Sunrise Period on 1 March 2023”, *UPC*, 2022, <https://www.unified-patent-court.org/en/news/adjustment-timeline-start-sunrise-period-1-march-2023>

³ Mewburn Ellis, “The Unitary Patent and the Unified Patent Court explained”, *Mewburn Ellis*, 2022, <https://www.mewburn.com/law-practice-library/the-eu-unitary-patent-and-the-unified-patent-court-explained>

⁴ Constance Krenz et. al., “How will the Unified Patent Court decide your case?”, 2022, <https://www.dlapiper.com/en-at/insights/publications/2022/02/how-will-the-unified-patent-court-decide-your-case>

⁵ Ewin Kelsey et. al., “European Patent Holders Should Address Opt-Out Question Before Unified Patent Court Begins Operations”, *The National Law Review*, 2022, <https://www.natlawreview.com/article/european-patent-holders-should-address-opt-out-question-unified-patent-court-begins>

⁶ Prock, T., Unitary Patents: Keeping prior national rights firmly in your sight, *Mark&Clerk*, 2022, <https://www.marks-clerk.com/insights/articles/unitary-patents-keeping-prior-national-rights-firmly-in-your-sight/>

⁷ Jens Andreasson. ”Motorbyte i det europeiska innovationssystemet”, *SvJT*, 2014, p. 569

⁸ Art. 24(1) UPCA

may of course at a first glance be perceived as uncertain and contradictory given that the UPC is a unified court.

1.2 Purpose and research questions

With this thesis the author aims at providing a better understanding of UPC's legal order. In particular, it is a purpose to understand when and how national law may be applied by the UPC.

A further aim is to investigate whether the prevailing uncertainty is caused by the legal order. Finally, it is a purpose to investigate consequences and considerations for the patent owner, caused by the fact that the UPC may apply national law.

In summary, the principal questions addressed in this thesis are:

- In which situations can a patent applicant expect that the UPC will apply national law? What national law will be applied in the respective situations?
- What consequences and considerations does application of national law entail for a patent applicant?
- Is the legal order sufficient to achieve desired harmonisation of patent law?

1.3 Methodology and delimitations

To achieve the above-mentioned purpose, applicable law and its effects has been analysed using a legal dogmatic method. Because UPC is a new court there is no available case law. Instead, relevant regulations of UPCA has been analysed in a systematic way based on authoritative sources, such as commentary and academic articles, to clarify where national law may impact, or be applied by, the UPC. Thereafter, implications and considerations of the patentee have been analysed for the identified situations. Effects for an alleged infringer is not within the scope.

The perspective is to some extent Swedish, in the sense that some examples are provided from a perspective of a patent practitioner serving the Swedish market, i.e., Swedish patent owners, as well as patent owners that have research and/or development in Sweden.

The aim has not been to give a complete list of all situations where national law may be applicable, which may not even be possible as it depends on what

defences are presented, but rather to provide an understanding on how national law will influence UPC's decisions.

1.4 Outline

The thesis comprises six chapters, where chapter two briefly explains the current system, and chapter three introduces the new system that introduces the UPC.

In chapter four, the UPC's competences are reviewed in a systematic way to bring clarity in when and how sources of law will be applied by the UPC.

In chapter five the findings of chapter four are analysed, and chapter six concludes the analysis.

2 The European Patent System

2.1 European Patent Convention

The UPCA is based on the European Patent Convention (EPC) which was signed on 5 October 1973, after more than 20 years of negotiations and debate. The EPC is a multilateral treaty that creates the European Patent Office (EPO) and provides for an autonomous legal system to review and grant European patents.⁹

2.2 European Patent (EP)

Patents are territorial rights, which implies that the exclusive right obtained by a patent is only applicable in the country or region in which a patent has been filed and granted, in accordance with the law of that country or region.¹⁰ Before the entry into force on the EPC, patent applicants were referred to the national patent offices to apply for patent protection. The EPC introduced a possibility to apply for patents in all EPC countries in one single application handled by one single patent authority, i.e. the EPO.

The EPO examines European patent applications and takes patentability decisions recognised by all EPC countries. Once the EP is granted, the applicant may validate the EP in one or more of the EPC countries, whereby the patent is transformed into national patents having the same legal effect as patents granted by the national authorities.¹¹ When UPCA enters into force the patent applicant will be able to choose between validating separately in the UPCA countries and requesting unitary effect.¹² A EP validated separately according to the legacy method is herein referred to as a classic EP, while a EP with unitary effect is referred to as a EPUE.

The EPO also handles an opposition procedure, which allows any person to centrally oppose and possibly revoke an EP patent before the EPO, during an opposition period of nine months from mention of the grant.¹³

⁹ EPO, “The history of the EPO”, *EPO*, 2022, <https://www.epo.org/about-us/timeline.html>

¹⁰ WIPO, “What is a patent?”, *WIPO*, 2022, <https://www.wipo.int/patents/en>

¹¹ Art. 2(2) EPC

¹² See 3.2

¹³ Art. 100 EPC

2.3 Law and Practice

The main legal sources of the EPO are the EPC, the Implementing Regulations and Rules of procedure of the Boards of Appeals. The EPC includes regulations on patentability and entitlement to an invention which are applied by the EPO during the process of granting an EP. The EPC also comprises regulations concerning effects of the EP and the EP application.

In addition, the EPO Boards of Appeals have over the years developed a substantial body of case law¹⁴ in order to clarify legal points of fundamental importance and ensure a uniform application of EPC.¹⁵ The EPO case law is highly rated among national courts and shall for example be credited great importance by the Swedish Patent and Market Court (PMD).¹⁶

2.4 European Patents as objects of property

A patent right gives the patent holder the right to prevent others from manufacturing, selling, leasing, and importing anything that falls within the scope of the patent. In the same way as other property, the patent right can be completely transferred (sold) or transferred for use (licensed).¹⁷

While an EP application is prosecuted under one legal system, the law applicable to a classic EP as an object of property is the national law of the country of protection.¹⁸ According to the law applicable to the patent as an object of property, it is determined how the process of patent exploitation must be performed in order to be valid. More specifically, this will affect how an EP is treated in rem. In principle this mean that rules concerning assignments and licences, co-ownership protection for third parties etc. of a classic EP are treated under national law in the respective contracting states.

¹⁴ Art. 112 EPC

¹⁵ EPO, Case Law of the Boards of Appeal, *EPO*, 2022, <https://www.epo.org/law-practice/case-law-appeals/case-law.html>

¹⁶ Prop. 2015/16:57, page 201

¹⁷ Persson, Annina H., Levin, Marianne & Wolk, Sanna (red.), "Immaterialrätt & sakrätt", *Juridiska fakulteten, Univ., Stockholm*, 2002, p 23

¹⁸ Arts. 2(2) and 74 EPC

3 Unified Patent Court Agreement

3.1 The European patent package

The new European patent package is based on the following treaties:

- EU Reg. 1257/2012, on creating a unitary patent protection,
- EU Reg. 1260/2012, on language regime creating a unitary patent protection, and
- The Agreement on a Unified Patent Court (UPCA).

The UPCA contains both substantive law and “choice of law” rules that should make it clear what law the UPC shall apply. In addition, UPC will use an independent set of Rules in Proceedings (RoP).

The entry into force of UPCA will also cause the entry into force of EU Reg. 1257/2012¹⁹ and EU Reg. 1260/2012²⁰.

3.2 The Unitary Patent (UP)

3.2.1 What is a Unitary Patent?

An EPUE, commonly referred to as a “Unitary Patent”, is an EP, granted by the EPO under the rules and procedures of the EPC, to which, at the patent proprietor's request, unitary effect is given for the territory of the UPCA States.²¹

For countries that have not ratified, the legacy procedure remain valid, which means that a EPUE may also be a classic EP in EPC states, that have not signed and ratified UPCA.

¹⁹ Art. 18 EPUE Reg

²⁰ Art. 7 EU Reg. 1260/2012

²¹ EPO, “Unitary Patent (2022)”, EPO, 2022, <https://www.epo.org/applying/european/unitary/unitary-patent.html>

3.3 The Unified Patent Court (UPC)

3.3.1 About the UPC

The UPC is one single court consisting of a plurality of divisions, comprising judges from all participating member states of the European Union. It is in particular set up to decide on the infringement and validity of EP with, and without, unitary effect. The UPC Court of Appeal²² will be a warrant for a uniform jurisprudence among the divisions.²³

3.3.2 Competences

The UPC has exclusive competence²⁴ in respect of a number of matters related to EPs (with and without unitary effect), including actions for infringement, revocation, protective measures etc. This means that the member states of UPCA have transferred jurisdiction of a number of matters to the UPC. In addition to the exclusive competences, the UPC is competent to handle tasks raised by a defence²⁵ to an infringement accusation.

The national courts of the Member States shall remain competent for patent related actions which do not fall within the exclusive competence of the Court.²⁶ This means that there is a double competence on certain matters and that the national courts are competent to re-examine UPC decisions that are outside its exclusive competences.²⁷

3.3.3 Legal order

Article 24 UPCA²⁸ defines legal sources of UPC in order of priority.²⁹ On the top of the list is Union law. As all UPCA states are also Union states, it is inherent that the UPCA must be subordinated Union Law, such as free movement of goods³⁰ and services and competition law³¹.

The second source on the list is the UPCA. UPCA contains five parts. The first part relates to general and institutional provisions and is most important in this context. The second and third parts are related to how the court shall

²² Art. 9 UPCA

²³ UPC, “An Enhanced European Patent System”, *UPC*, 2014, <https://www.unified-patent-court.org/en/news/enhanced-european-patent-system>

²⁴ Art. 32(1) UPCA

²⁵ Art. 32(1)(a)

²⁶ Art. 32(2) UPCA

²⁷ Tilmann, W. & Plassmann, C. (ed.), “Unified patent protection in Europe: a commentary”, First edition, *Oxford University Press*, Oxford, 2018, p 593

²⁸ See supplement 1

²⁹ Tilmann, W. & Plassmann, C. (ed.), “Unified patent protection in Europe: a commentary”, p 475

³⁰ Arts 34, 36, and 56 TFEU

³¹ Arts 101 and 102 TFEU

be formed and financed. The fourth part provides transitional provisions³² and the fifth part comprises final provisions.

The third source on the list is the EPC³³. The fourth source on the list is other international agreements applicable to patents and binding on all Contracting Member States. In particular, the Paris Convention, the Strasbourg Convention, and the TRIPs agreement are relevant.³⁴

The last source on the list is national law, which shall only be applied by the UPC, when there are no provisions in the sources listed above. UPCA further defines³⁵ how to find competent national law, by referring to applicable provisions of Union law, and as a second-choice international instruments containing private international law rules. The third choice, which is only applicable in absence of the first choices, is national provisions on private international law.

3.3.4 Transitional period

During a transitional period of seven years after the date of entry into force of this Agreement, actions concerning a classic EP may still be brought before national courts or other competent national authorities. During the transitional period it is also possible for a classic EP (or application) to be opted-out of the UPC, which means that the EP can only be treated under the legacy system.³⁶

³² See 3.3.4

³³ See 2.3

³⁴ Tilmann, W. & Plassmann, C., “Unified patent protection in Europe: a commentary”, p 479

³⁵ Art. 24(2) UPCA, supplement 1

³⁶ Art. 83 UPCA

4 Use of National law by UPC

4.1 Systematic review

To identify situations where UPC may apply national law, conformity between UPC's competences defined by Article 32 and the legal sources listed in Article 24 UPCA will be analysed to identify how well the competences are covered by the listed legal sources and where there are gaps where national law will be relevant.

The fact that the competences of UPC includes issues that can be raised as defence to infringements actions, makes the review more complex. To provide a perspicuous overview, the presentation below divided into two main parts; UPC's explicit competences and other competences related to defences.

4.2 Exertion of explicit competences

4.2.1 General on UPC's explicit competences

For the review of UPC's explicit competences, the following rough division is applied in the following chapters:

- 1) Patent law issues, Article 32 (a-b) and (d-e)

As the UPC is a "patent court" it is inherent that its competences are focused on issues of direct relevance under patent law. When exercising any one of these competences, the UPC will typically deal with issues of patent invalidity and patent infringement. Hence, it is suitable to analyse these competences jointly.

- 2) Prior usage, Article 32 (g)

Prior usage is also a matter of patent law, but it raises other issues and is not only a relevant defence to an infringement accusation, but also an individual competence of the UPC and is therefore analysed separately.

- 3) Preliminary measures, Article 32 (c) and (f)

The UPC also has exclusive competence in respect to actions associated with provisional protection conferred by a published EP application. When an EP has not been granted the considerations of the UPC will be slightly different. Therefore, these competencies are treated separately.

4) Other, Article 32 (h) and (i)

The last two competences refer to EU Regulations and consequently irrelevant for application of national law and have therefore been left out in this review.

4.2.2 General patent law issues

4.2.2.1 General on revocation and infringement

The EPC³⁷ comprises regulations regarding most aspects relevant to patent validity, such as novelty and inventive step. It is reasonable to expect that EPO case law will have a strong influence on UPC,³⁸ in the same way national courts today are reluctant to interfere with the EPO's exercise of powers.³⁹ However, EPO case law is not binding to the UPC.⁴⁰

The UPCA comprises fundamental regulations defining rights of a patent owner and acts constituting infringement acts.⁴¹ Due to the legal order, these regulations override any corresponding provisions of EPC.⁴² According to the EPC 'any infringement of an EP is dealt with by national law'. The UPCA intervenes in this reference⁴³. This means that the infringement of an EP is 'dealt with' procedurally in accordance with the UPCA and RoP. Union law does not contribute anything to this provision on competence and the procedural law provision.⁴⁴ However, UPCA does not provide any further guidance regarding how to resolve the issue of claim interpretation for the assessment of infringement and validity.

Traditionally patent claims are interpreted either technically/literally or under the doctrine of equivalence, which in some situations allows for a broader interpretation of the claims.⁴⁵ To this respect, national courts have developed parallel diverging strategies for claim interpretation.⁴⁶

³⁷ See 2.3

³⁸ Paul England, "Novelty of patents in Europe and the UPC", *Journal of Intellectual Property Law & Practice*, 2017, <https://doi-org.ludwig.lub.lu.se/10.1093/jiplp/jpx103t>, p.739

³⁹ Reinisch, A.(ed.), "Decisions of the European Patent Organization Before National Courts", in "Challenging Acts of International Organizations Before National Courts", *Oxford*, 2010, p.145

⁴⁰ EU:P-1625/2006 (ASW)

⁴¹ Art. 25-27 and 29 UPCA.

⁴² Art. 64 (1) EPC

⁴³ Art. 149a(1)(a) EPC

⁴⁴ Tilmann, W. & Plassmann, C., "Unified patent protection in Europe: a commentary", p 475

⁴⁵ Domeij, Bengt, The Swedish Doctrine of Equivalence, *SSRN*, August 2010, <https://ssrn.com/abstract=1666166>

⁴⁶ Paul England, "Novelty of patents in Europe and the UPC", p. 1

The EPC⁴⁷ states that the extent of the protection shall be determined by the claims, while the description and drawings shall be used to interpret the claims.⁴⁸ In addition, EPC expressly includes equivalents in the scope of protection of a EP.⁴⁹ This leaves room for the UPC to deviate from literal claim interpretation.

However, to apply national law when deciding on the question of validity and infringement would contravene the desire to harmonize patent law⁵⁰. Instead, it is appreciated that the UPC will develop its own case law within this area. This assumption is in line with the conclusion of a comparative study performed by Paul England, which emphasizes a consistent approach to the scope of claim for the assessment of infringement and novelty.⁵¹

It is not possible to foresee what the judges of the UPC will agree on given their different backgrounds. However, a reasonable assumption is that case law of important patent countries i.e. Germany, Netherlands and France will have major influence on UPC case law.⁵²

4.2.2.2 National prior rights of EPUE

One particular question that has been raised by patent practitioners with regards to validity of EPUE is how national prior rights⁵³ will be handled.⁵⁴ A national prior right is a national patent application for an EPC state which has an earlier priority date, but which is published after the priority date of the EP. National prior rights are not relevant to the grant of an EP but can be invoked in national proceedings as grounds for revocation.

For a classic EP, a national prior right can be addressed by filing an adapted claim set for the respective country either before the EPO or in a subsequent national proceeding.⁵⁵ This is not an option for EPUE, since only EPs granted with the same set of claims for all participating EU Member States are eligible for Unitary Patent protection.⁵⁶

Neither EPUE Reg nor UPCA contains any regulations regarding national prior rights for EPUE. However, EPO have introduced systematic “top-up”

⁴⁷ EPC revised on 29 November 2000

⁴⁸ Art. 69 EPC

⁴⁹ Art. 2 Protocol on the Interpretation of Article 69 EPC

⁵⁰ Preamble UPCA

⁵¹ Paul England, “Novelty of patents in Europe and the UPC”, p. 1

⁵² Paul England, “Novelty of patents in Europe and the UPC”, p. 1

⁵³ Art. 139(2) EPC

⁵⁴ Prock, T, Unitary Patents: Keeping prior national rights firmly in your sight, 2022

⁵⁵ Rule 138 EPC

⁵⁶ Art. 3(1) EU Reg. 1257/2012

search for earlier national rights before grant, which indicate that this is expected to be an issue.⁵⁷

For the EPUE to be unified, the UPC must develop its own case law within this area, in the same way as regarding patentability and infringement. Legal practitioners that have drawn up different scenarios for how national prior rights will be handled by UPC. A worst-case could lead to the dis-allowance of unitary patent protection.⁵⁸ An alternative would be that a national prior right in the proceedings before the UPC will lead to a revocation only in the contracting member state where the prior right exists⁵⁹. It seems like it is possible to argue for both alternatives.

4.2.2.3 Corrective measures

In accordance with UPCA the UPC has exclusive competence to order corrective measures and damages in infringement proceedings.⁶⁰ In general, UPCA and RoP are quite elaborate on the process for permanent corrective measures⁶¹. However, commenters have of course been able to find passages that can be subject to diverging interpretation.⁶² Anyhow, it cannot be considered particularly likely that national law will be applied to decide on permanent corrective measures or damages. Instead, this will also be an area where UPC case law will eventually provide interpretation to ambiguities.

4.2.3 Prior usage

The UPCA contains some explicit references to national law. In these cases, national law will take precedence over EPC and other national agreements.⁶³ One reference to national law concerns right based on prior use or possession of an invention.⁶⁴

Rights based on prior use are meant to prevent that business activities built up without patent protection, can be not stopped by a later filed patent. The background is that it would not be fair that a patent owner could make demands on someone who worked the invention before the patent application

⁵⁷ EPO, “EPO introduces systematic top-up search for earlier national rights”, *EPO Newsletter*, 25 July 2022, <https://www.epo.org/news-events/news/2022/20220725.html>

⁵⁸ Prock, T, *Unitary Patents: Keeping prior national rights firmly in your sight*, 2022

⁵⁹ Tilmann, W. & Plassmann, C., “Unified patent protection in Europe: a commentary”, p. 120

⁶⁰ Art. 64 and 68 UPCA

⁶¹ Art. 60-69 UPCA

⁶² Vadym Semenov, “How will it be? Injunctive relief in UPC practice”, *Journal of Intellectual Property Law & Practice*, 2020, <https://doi-org.ludwig.lub.lu.se/10.1093/jiplp/jpaa014>, p.134

⁶³ Art. 24(1) UPCA

⁶⁴ Art. 28 UPCA

was filed. This would be a waste of resources and not in line with the intention to promote technical development, seen to the society as a whole.⁶⁵

UPCA states that if in one member state there are legal provisions regulating prior use, those regulations will also apply to protection of an EPUE. Hence, prior use defences that may today be invoked with regards to classic EP and national patents, will be considered also by the UPC, in that particular member state. Hence, in this respect a EPUE will not be unitary, in the sense that it has the same effect in all member states, instead national law of the member state where the usage takes place will be considered.⁶⁶

4.2.4 Preliminary measures

UPC is also competent to handle action for provisional and protective measures⁶⁷. This means that the UPC is competent to order prompt and effective provisional measures to prevent an infringement.⁶⁸

An order of preliminary measures would typically have to consider merits of an infringement claim and damage caused by a possibly ongoing infringement. At this respect V. Semenov has in the article “How will it be? Injunctive relief in the UPC practice” noticed that there is a discrepancy between UPCA and the RoP with respect to the extent evidence for validity and infringement that will be required for the UPC to order preliminary measures. Semenov’s conclusion is that the UPCA provisions on preliminary injunction are flexible enough and will allow the UPC to exercise considerable discretion.⁶⁹

Hence, it remains to be seen what approach with UPC will take on this matter. In the same way as for the other exclusive competences UPC will have to develop its own case law, which will naturally be inspired by national law of contracting states.

⁶⁵ Art. 32(1)(g)

⁶⁶ 4 § PatL

⁶⁷ Art. 62 UPCA

⁶⁸ Art. 30 TRIPS

⁶⁹ Vadym Semenov, “How will it be? Injunctive relief in UPC practice, *Journal of Intellectual Property Law & Practice*”, 2020, <https://doi-org.ludwig.lub.lu.se/10.1093/jiplp/jpaa014>, p. 134

4.3 Issues raised by defences

4.3.1 General about defences

Apart from exclusive competences⁷⁰, it is expected that UPC will also rule on various claims presented in counter claims or used as defence to infringement accusations.

Many, even most, arguments presented in defences raise issues that are regulated by the legal sources which take priority over national law. However, defences may in addition raise a variety of issues that do not really have anything to do with intellectual property law.

Commenters mean that in this context, the term ‘related defences’ shall be interpreted broadly to include all objections and pleas which deprive the use of the patent of its illegality, or which may be raised against raising or conducting an infringement action. Typical examples objections are licences, right to the patent, missing entitlement (missing ownership, missing right to sue) and compliance with the claim.⁷¹

The UPCA does not include any regulations within this area, which means that this type of issues have to be handled under national law. This has been criticised, as it is considered to limit uniformity and differs from the EU regulations on trademarks⁷² and designs⁷³, which do include at least basic regulations in this area.⁷⁴

To determine national law directly applicable provisions of Union law containing private international law rules shall be used when present.⁷⁵ This means that the regulations in Rome I shall be used for contractual matters and that Rome II shall be used for non-contractual obligations, such as non-contractual aspects of the patent as an object of property.⁷⁶ In the light of this, the following chapters will first discuss how national law shall be applied with respect to contractual and thereafter to non-contractual matters.

⁷⁰ Art. 32 UPCA

⁷¹ Tilmann, W. & Plassmann, C., “Unified patent protection in Europe: a commentary”, p. 596

⁷² EU Reg. 2017/1001

⁷³ Council Regulation (EC) No 6/2002

⁷⁴ Jens Andreasson. ”Motorbyte i det europeiska innovationssystemet”, p. 569

⁷⁵ Art. 24(2)(a) UPCA

⁷⁶ Jonas Lembke, “Legal order in the Unified Court”, *Nordiskt Immateriellt Rättsskydd*, 4/2014, p 388-389

4.3.2 Contractual matters

4.3.2.1 Obligating contracts

It is not unusual that issues of ownership or disposition of a patent are based on disagreement regarding interpretation of obligating contracts, such as purchase agreement or licence agreements. For obligating contracts accompanying the disposition on the patent, the principle of free choice of law applies.⁷⁷ If no choice of law has been made by the parties an ‘obligating contract’ shall be governed by the law of the country where the party required to affect the characteristic performance of the contract has his habitual residence.⁷⁸ For contracts of assignment this is the assignor and for licence agreements the licensor. In such a scenario, the law of the assignor or licensor would have to be applied in the absence of a choice of law in the contract.⁷⁹

In conclusion, a Swedish patent owner may regulate choice of law in any contractual agreement. If law is not regulated, Rome I will generally result in that Swedish Law shall be applied when resolving issues of ownership raised in a defence.

4.3.2.2 Employee inventions

The right to an invention pertains to the inventor or his successor in title.⁸⁰ Due to a general rule in labour law, inventions produced by an employee in his/her employment accrues to the employer and not to the inventor. Regulations in this area varies by country.⁸¹

In many cases intellectual property rights are regulated in an employment agreement. In Sweden, the employer’s right to an invention is, in the absence of an agreement, further regulated by law⁸².

According to EPC, the right to an EP shall, if the inventor is an employee, be determined in accordance with the law of the State in which the employee is mainly employed.⁸³ This means that for issues brought up in a defence, relating to a Swedish employment, the UPC shall apply Swedish law.

⁷⁷ Art. 3 Rome I

⁷⁸ Art. 4(2) Rome I

⁷⁹ Tilmann, W. & Plassmann, C., “Unified patent protection in Europe: a commentary”, p. 156

⁸⁰ Art. 60 EPC, first sentence

⁸¹ Persson, Annina H., Levin, Marianne & Wolk, Sanna, *Immaterialrätt & sakrätt*, p. 215

⁸² Lag (1949:345) om rätten till arbetstagares uppfinningar

⁸³ Art. 60 EPC (1) second sentence

4.3.3 Patent as an object of Property

UPC is competent for the settlement of disputes relating to EPs with and without unitary effect.⁸⁴ However, as an object of property the UPC will have to treat EPs differently depending on whether they have unitary effect or not. As described above⁸⁵, a classic EP is, in each designated Contracting State, subject to the law applicable in that State to national patent applications. However, law to be applied to a EPUE as an object of property is defined by Article 7 EPUE Reg, which takes precedence over the regulations in EPC.

According to the first paragraph of this article, law to be applied to a EPUE as an object of property is the law of the UPCA state where (a) the applicant had his residence, principal place of business, or where (a) is not applicable (b) place of business, on the date of filing of EPUE. However, this is subject to the condition that such particulars are recorded in the European Patent Register at the date of filing.

The second paragraph clarifies that where two or more persons are entered in the European Patent Register as joint applicants, point (a) of paragraph 1 shall apply to the first indicated joint applicant having a place of business in the member state. In other words, not only the registration, but also the order in which joint applicants are registered is important.

According to the third paragraph, the law of the State where the European Patent Organisation has its headquarters (i.e. German Law⁸⁶) shall be applied for all member states, when law cannot be determined using the first or second paragraphs.

Hence, for EPUE one national law is applied in all UPCA states in accordance with these regulations, which depend on the registration in the European Patent Register.

For a patent owner, having its principal place of business in Sweden, this means that the UPC will treat a for EPUE under Swedish law with respect to all participating Member States, while a classic EP will be treated as a national patent in each contracting states. Hence, when it comes to questions related to EPUE as an object of property law will depend mainly on the nationality of the original patent applicant.

⁸⁴ Art. 1 UPCA

⁸⁵ See 2.4

⁸⁶ <https://www.unified-patent-court.org/en>

5 Analysis

5.1 When may National law be applied?

The review in chapter four indicate that national law is not expected to be directly applied when it comes to UPC's explicit competences. This is an in-born consequence of the desire to harmonise patent law. Worth noticing is that harmonisation of patent law is not always achieved by the UCPA itself but is to a large extent left to the judges of the UPC. When UPC case law is being established, it will be influenced by national law. However, this has nothing to do with the mention of national law as a "source of law" but is a consequence of the objective to harmonise patent law.⁸⁷ The only identified exception, where national law is applied by direct limitation of UPCA, is the regulation of prior usage.⁸⁸

However, when it comes to implicit competences of UPC associated with defences, the UPCA does not seem to provide any further harmonisation apart from regulations and agreements already present. Hence, for the implicit competences national law is expected to be frequently applied, both for contractual matters and for the EP as an object of property and for other matters raised.

5.2 The patent owner's perspective

During the process of obtaining a patent, a patent owner will, independent on jurisdiction, go through a process of drafting and filing of the patent application and prosecution it at the EPO. The patent owner will typically also, both before and after a patent is granted, have to handle various agreements regarding the patent, such as assignments and licence agreements. All these steps may impact what happen during litigation. The effect depend on the court and on law applied on the court.

In the current system, national litigation is the only option. This means that an owner of an EP, to be on the safe side, has to consider all relevant jurisdictions of the EP contracting states throughout the process. For example, patent claims, as well as invention assignments must be suitable for litigation in all EP contracting states where the patent owner is active.

With the introduction of UPC, the owner of an EP is now faced with the decision between considering all relevant jurisdictions where litigation may be needed (typically where a patented product or process is commercialised), or consider the jurisdiction of UPC, which may initially be uncertain. However,

⁸⁷ See 4.2.2

⁸⁸ See 5.2.3

as a patent owner often do business in several UPCA states, the former may also be rather incomprehensible, even if there is established case law in the individual jurisdictions.

The areas where uncertainties have been identified will hereafter be discussed from this point of view.

5.2.1 Harmonised patent law

The review above indicate that many of the questions raised by the community of patent practitioners, relate to issues that will naturally be resolved when the UPC starts to make decisions. This is not only the case for general patent law issues, but also for other issues, such as interpretation issues associated with contracts⁸⁹. These uncertainties are an effect of the introduction of a new system, rather than of weaknesses of the system as such.

The initial immaturity of the system, which is of course problematic to a patent owner, will be resolved by the provisions enabling patent owners to opt-out their most important patents.⁹⁰ Initially various national case law will probably have impact on decisions of UPC. However, once UPC case law has been established, the unified system will be much more comprehensible than the legacy system, as a patent owner that litigates in UPC will have to consider fewer different jurisdictions.

For a small country like Sweden, it is also reasonable to expect that the judges of PMD will consider UPC case law highly, in the same way as they today follow EPC case law.⁹¹ This may imply an initial change in case law also to patent owners that only litigate in Sweden. However, eventually this change may lead to improved predictability also in the national court, as the case law of UPC will be much more comprehensible than Swedish patent case law due to the amounts of cases. The decision on whether to litigate nationally or in UPC may then be a matter of cost and procedural matters, rather than on legal outcome.

A harmonised patent law, regarding matters such as claim interpretation, is highly advantageous to patent owners, as it makes it easier to determine scope of protection of existing rights. It is of course also easier to produce good patents, if there are not diverging rules regarding interpretation that have to be considered.

⁸⁹ See 5.2.4.2

⁹⁰ See 3.3.4

⁹¹ Prop. 2015/16:57 page 201

5.2.2 National prior rights

Regarding national prior rights it appears a bit odd that there is no regulation in place. There is also a risk that the issue of national prior rights will not be dealt with so frequently by the UPC and in particular not with the BoA, as patent owner being aware of a national prior right may avoid the UPC. Hence, it may take some time until case law has been established. Even if this issue will eventually be resolved, it would have been much clearer for patent owners if a regulation would have been in place before the UPC opened.

5.2.3 About prior use

Regarding the regulations about prior usage, it seems reasonable that prior usage remains a national concern, as prior usage rights are protecting “others” from the patent owner. Hence, it makes sense that the same rules apply for all types of patents within a state. Anything else would cause a confusing and uncertain situation for anyone starting a business.

From a patent owner’s perspective, this means that existing national prior use rules that today allows any person who was in possession of a patented idea before the patent was filed, will continue to apply in the same way independent on whether a patent is litigated before a national court or before the UPC. It may of course seem a bit messy, but at least not a deterioration and probably not a major issue.

5.2.4 The lack of material regulation

5.2.4.1 The EP as an object of property

Law applied to an EP as an object of property, is an important aspect for a patent owner to consider when drafting assignments and contract. With this regard, the main issue for the patent owner is of course that there is some kind of certainty regarding what law will be applied. Secondly, it is of course beneficial for a patent owner if the number of laws that have to be considered is limited. Finally, a patent owner is expected to prefer that the law applied is a law that is well known.

With this perspective the regulation in EPUE Reg appears beneficial to the patent owner. A Swedish company will be able to treat all EPUE under Swedish law. Considering that Swedish companies would typically have good access to Swedish lawyers with good knowledge of Swedish law, this might actually be the best option for the patent owner. For international players it is

also an improvement. One may assume that a company with principal place of business outside Europe will welcome the possibility to only have to consider one national law, typically German law, when drafting agreements etc. concerning EPUE. Hence, the criticism that the UPCA is far from uniform when it comes to the patent as an asset, does not seem valid from the patent owner's perspective.

It is even possible that further harmonisation in this area would have caused further confusion for the patent owners, something that has been highlighted by Alexander Ramsey, member of the UPCA drafting committee. Alexander Ramsey means that further harmonization of property aspects in the UPCA framework would not have been possible if uniform practice were to be guaranteed in areas where national courts have double competence.⁹² Hence, for areas where courts have double competence, regulations in the UPCA, may actually have had increased uncertainty for patent owners as decisions could then have been contested in national courts with diverging outcome. This does not mean that harmonisation is not desirable also in this area. However, maybe the UPC is not the right forum, as these regulations apply to various material objects.

What is important for a patent owner to understand, is that the decision regarding whether to validate with unitary effect or separately in different countries will affect what law is applied to material aspects of the patent. From this aspect the EPUE may be preferable.

In addition it may be important for future patent owners to bear in mind that information typed in the "Request for grant of a European patent" will influence what is entered in the European patent register and consequently also what law is applied to the EP as an object of property if the application results in an EPUE. This seems to be of particular importance for patentees having their principal place of business outside the EPUE member states or in case of multiple joint applicants of different nationalities.

5.2.4.2 Contractual matters

There is already today a harmonisation on contractual matters on EU level through Union Law and Rome I. Hence, divergence in the contractual area is not mainly a matter of applicable law, but rather a question of diverging interpretation of common law in the national courts. Also, as contractual patent matters is not an exclusive competence of the UPC, it could have caused more

⁹²Alexander Ramsey, "Ett enhetligt europeiskt patentsystem - perspektiv från insidan", *SvJT*, 2014, p.692-693

harm than good to include regulations regarding contractual matters in UPCA, in the same way as regarding patents as objects of property.⁹³

However, there are already today signs that the national courts are heading towards a largely similar approach to FRAND agreements, which is an important aspect to patent owners.⁹⁴ If UPC further contributes to harmonisation of interpretation of patent related contracts it is of course welcome from the patent owner's perspective.

⁹³ See 5.2.4.2

⁹⁴ Cappuyns, P., Al Ganim, N., "Four times FRAND: an analysis of recent judgments from the UK, Germany, the Netherlands and France, and lessons for the upcoming UPC system", *Journal of Intellectual Property Law & Practice*, 2022

6 Conclusion

The UPCA is quite a complex set of rules to grasp, and it comprises several references to legal instruments. The mention of national law in its legal order may therefore appear confusing, in particular due to that the drafting committee has left many details to be resolved by the UPC's judges. However, the conclusion of this thesis is that UPC's application of national law should not be a major concern for patent owners, as it is possible to predict when and how national law will be applied.

Many of the concerns raised has to do with that the UPC is a completely new jurisdiction where harmonisation of patent law will to a large extent be provided by the UPC's decisions. Once UPC case law has been established, the patent owner can, with at least one exception⁹⁵, expect that national law will not influence decisions related to direct patent law issues.

However, national law will also in the future be applied on material aspects of EPs, independent on whether the UPC or the legacy system is used. This is something that patent owners must continue to consider for example when drafting agreements or applying for EPs, as applicable law is different in different situations.⁹⁶ For the cases where national differences depend on interpretation of common legislation rather than on law, the UPC may through its rulings contribute to harmonisation also in this area.

In conclusion, the new system does not provide full harmonisation on all patent related matters, but the harmonisation on direct patent law issues will be a considerable step forward. This appears to be in line with the purpose of the cooperation and is presumably beneficial for patent owners.

⁹⁵ See 5.2.3

⁹⁶ See 5.2.4

Bibliography

Literature and articles

Andreasson Jens, "Motorbyte i det europeiska innovationssystemet", *Svensk Juristtidning*, 2014, p. 542-573

Cappuyns, P., Al Ganim, N., Four times FRAND: an analysis of recent judgments from the UK, Germany, the Netherlands and France, and lessons for the upcoming UPC system, *Journal of Intellectual Property Law & Practice*, Volume 17, Issue 11, November 2022, Pages 946–961, <https://doi.org/10.1093/jiplp/jpac086>, accessed 2022-12-21.

Domeij, B.: The Swedish Doctrine of Equivalence, *SSRN*, 26 August 2010, <https://ssrn.com/abstract=1666166>, accessed 2022-12-21.

England, P., Novelty of patents in Europe and the UPC, *Journal of Intellectual Property Law & Practice*, Volume 12, Issue 9, September 2017, Pages 739–746, <https://doi.org/10.1093/jiplp/jpx103>, accessed 2022-12-21

Kelsey E., Cagle R. & Love J., European Patent Holders Should Address Opt-Out Question Before Unified Patent Court Begins Operations, November 29, *The National Law Review*, 2022, <https://www.natlawreview.com/article/european-patent-holders-should-address-opt-out-question-unified-patent-court-begins>, accessed 2022-12-21

Krenz, C., Meiller, C., Feenstra, E., Alexis, F., Appl, V. & Tiberio, M., How will the Unified Patent Court decide your case?, *DLA Piper*, 23 February 2022, <https://www.dlapiper.com/en-at/insights/publications/2022/02/how-will-the-unified-patent-court-decide-your-case>, accessed 22 December 2022

The Unitary Patent and the Unified Patent Court explained, *Mewburn Ellis*, accessed 23 December 2022, <https://www.mewburn.com/law-practice-library/the-eu-unitary-patent-and-the-unified-patent-court-explained>, accessed 2022-12-21.

Persson, A. H., Levin, M. & Wolk, S. (ed.), *Immaterialrätt & sakrätt, Juridiska fakulteten*, Univ., Stockholm, 2002

Prock, T., "Unitary Patents: Keeping prior national rights firmly in your sight", *Mark&Clerk*, 02 September 2022, <https://www.marks-clerk.com/insights/articles/unitary-patents-keeping-prior-national-rights-firmly-in-your-sight/>, accessed 2022-12-21

Ramsey, Alexander, "Ett enhetligt europeiskt patentsystem - perspektiv från insidan", *Svensk Jurist Tidning*, 2014

Reinisch, A. (ed.), "Decisions of the European Patent Organization Before National Courts", in "Challenging Acts of International Organizations Before National Courts", *Oxford, 2010; online edn, Oxford Academic*, 1 Jan. 2011, <https://doi.org/10.1093/acprof:oso/9780199595297.003.0006>, accessed 2022-12-21.

Semenov, Vadym, "How will it be? Injunctive relief in UPC practice", *Journal of Intellectual Property Law & Practice*, Volume 15, Issue 2, February 2020, Pages 134–138, <https://doi-org.ludwig.lub.lu.se/10.1093/jiplp/jpaa014>, accessed 2022-12-22.

Tilmann, W. & Plassmann, C. (ed.), "*Unified patent protection in Europe: a commentary*", First edition, *Oxford University Press*, Oxford, 2018

V.O. Patents & Trademarks, Unitary patent and consequences for licence agreements, *V.O. Patents & Trademarks*, 2022, <https://www.vo.eu/unitary-patent-and-consequences-for-licence-agreements/>, accessed 27 December 2022

Electronic sources

EPO, "EPO introduces systematic top-up search for earlier national rights", *EPO Newsletter*, 25 July 2022, <https://www.epo.org/news-events/news/2022/20220725.html>, accessed 22 December 2022

EPO, "The history of the EPO", *EPO*, 2022, <https://www.epo.org/about-us/timeline.html>, accessed 22 December 2022

EPO, "Unitary Patent (2022)", *EPO*, 2022, <https://www.epo.org/applying/european/unitary/unitary-patent.html>, accessed 27 December 2022

Parliamentary question: Answer to question no P-1625/06: P-1625/2006(ASW): European Parliament. (2006). *European Parliament*, https://www.europarl.europa.eu/doceo/document/P-6-2006-1625-ASW_EN.html, accessed 27 December 2022

Swedish Intellectual Property Office (PRV), European Patent (EP) - One application for 39 countries, *PRV*, 2022, <https://www.prv.se/en/the-advanced-patent-guide/apply-in-other-countries/european-patent-ep/>, accessed 27 December 2022

Unified Patent Court (UPC), "About the Unified Patent Court (2022)", *Unified Patent Court*, 2022 <https://www.unified-patent-court.org/en>, accessed 27 December 2022

Unified Patent Court, "Adjustment of the timeline – Start of the Sunrise Period on 1 March 2023", *Unified Patent Court*, <https://www.unified-patent->

[court.org/en/news/adjustment-timeline-start-sunrise-period-1-march-2023](https://www.unified-patent-court.org/en/news/adjustment-timeline-start-sunrise-period-1-march-2023), accessed 22 December 2022

Unified Patent Court (UPC), “An Enhanced European Patent System”, *UPC*, 2014, <https://www.unified-patent-court.org/en/news/enhanced-european-patent-system>, accessed 28 December 2022

World Intellectual Property Organisation (WIPO), “What is a patent?”, *WIPO*, 2022, <https://www.wipo.int/patents/en>, accessed 27 December 2022

Legislation and treaties

International agreements

European Union, Agreement on a Unified Patent Court (UPC), OJ C175/1, <https://www.consilium.europa.eu/en/documents-publications/treaties-agreements/agreement/?id=2013001>, accessed 02 January 2023

WIPO- Agreement on Trade-Related Aspects of Intellectual Property Rights, 2005, [WTO | legal texts - Agreement on Trade-Related Aspects of Intellectual Property Rights as Amended by the 2005 Protocol Amending the TRIPS Agreement](#), accessed 02 January 2023

EU legislation

Regulation (EC) 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations [2008] OJ L177/6.

Regulation (EC) 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations [2007] OJL199/40

Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs [2002], OJ L3/1

Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection, [2012], OJ L361/1

Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, [2017], OJ L154/1

Public Print

Regeringens proposition 2015/16:57 ”Patent- och marknadsdomstol”, Stockholm den 26 november 2015, <https://data.riksdagen.se/fil/8013EFA2-6703-486E-BEAA-3AC3D0E593D8>, accessed 02 January 2023

Administrative procedures

Rules of Procedure of the Unified Patent Court (as adopted by decision of the Administrative Committee on July 2022) https://www.unified-patent-court.org/sites/default/files/upc_documents/rop_en_25_july_2022_final_consolidated_published_on_website.pdf, accessed 02 January 2023

Supplement A

(From the Unified Patent court Agreement)

Article 24

Sources of law

1. 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.

2. To the extent that the Court shall base its decisions on national law, including where relevant the law of non- contracting States, the applicable law shall be determined:

- a) by directly applicable provisions of Union law containing private international law rules, or
- b) in the absence of directly applicable provisions of Union law or where the latter do not apply, by international instruments containing private international law rules; or
- c) in the absence of provisions referred to in points (a) and (b), by national provisions on private international law as determined by the Court.