

**The Rules of Procedure
for the opt-out**

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The rules of procedure
for the opt-out

Caveat

- This presentation is based on the 18th draft of Rules of procedure of the Unified Patent Court released on 19 October 2015
- It is very likely that certain changes will be brought with respect to the opt-out
- Check the final version of the Rules of procedure before making any real life opt-out

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The rules of procedure for the opt-out

Rule 5 of the Rules of procedure

Einreichung eines Antrags auf Inanspruchnahme der Ausnahme-regelung und Rücktritt von der Inanspruchnahme der Ausnahme-regelung	Lodging of an Application to opt out and withdrawal of an opt-out	Dépôt d'une déclaration de dérogation et retrait d'une déclaration de dérogation
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The rules of procedure for the opt-out

UPC-ish spoken

- "To opt out" (but "the opt-out")
- "To withdraw the opt-out"
- ~~"To opt in"~~: "to stay in"
- "To be locked in"
- "To be locked out"

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Overview

- Legal sources
- When (sunrise, sunset)?
- How?
- Fee
- Who (representative)?
- Who (proprietor)?
- What (content)?
- For where (territory)?
- So what (effect)?
- SPCs
- Withdrawal
- Only one round
- Lock in
- Lock out

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Legal sources



-  17 December 2012
Regulation 1257/2012 enhanced cooperation creation of unitary patent protection
-  17 December 2012
Regulation 1260/2012 (translation arrangements)
-  19 February 2013
Agreement on a Unified Patent Court and draft Statute
-  19 October 2015
Draft Rules of procedure Unified Patent Court (V18)



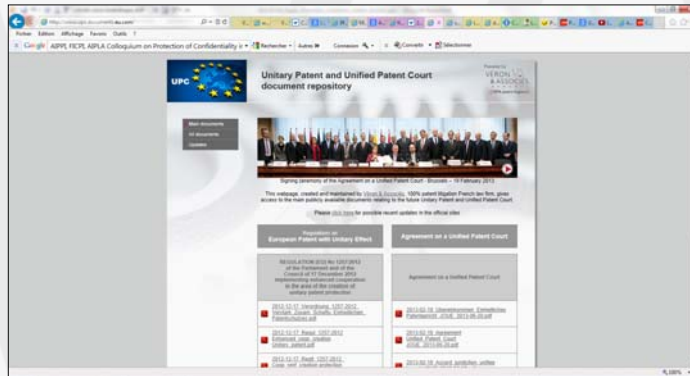
http://www.upc.documents.eu.com/PDFs/2015-10-19_Agreement_UPC_DE-EN_FR_and_Rules_Procedure_UPC_DE-EN_FR_Draft_V18.pdf

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The main publicly available documents can be found on
www.upc.documents.eu.com



The rules of procedure
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UPC's FAQ

unified patent court A single patent court covering 25 countries
home news documents faq about the upc

Opt-out

- Does the effect of an opt-out under Article 83(3) UPCA last only for the duration of the transitional period?
- Does an opt-out under Article 83(3) UPCA affect only the exclusivity of jurisdiction?
- What are the arrangements for the transitional period (opt-out scheme and choice of forum)?
- Opt-out scheme**
- How do I opt out my patent?
- What if someone else has applied to opt out my patent?
- How will I know if someone else has opted out my patent?
- Why doesn't the system restrict access to the opt out function to the registered patent proprietor?
- Will you publish a list of opted-out patents?
- The EPD offers a Smart Card system, can't the UPC system do so too?
- How does the court verify that I am who I say I am?
- But in my home country I am expected to provide proof of identity, why is this not the case at the UPC?
- Why is there a register of patent attorneys, but not of lawyers or law firms?

<https://www.unified-patent-court.org/faq/opt-out>

For what?

- European patent (even expired)
- European patent application
- SPC based on a European patent
- **not** a European patent with unitary effect
- rule 5 (10) provides that if an opt-out has been made or a patent application which matures in a unitary patent, this opt-out is deemed to be withdrawn

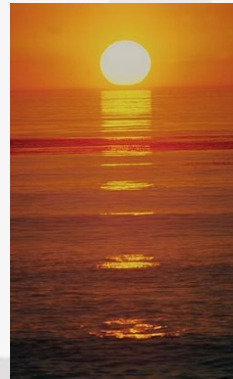
When: sunrise



Rule 5: "13. Applications accepted by the Registry **before the entry into force of the Agreement** shall be treated as entered on the register on the date of entry into force of the Agreement."

When: sunset

- Even after the patent's expiry:
Rule 5: "1. *The proprietor of a European patent (including a European patent that has expired)...*"
- Before the end of the 7-year transitional period:
Art. 83 UPCA: "*To this end they shall notify their opt-out to the Registry by the latest one month before expiry of the transitional period*"
- Except in case of lock-in (see below)



Until when? For the life of the patent

Opt-out's effect lasts also after the end of transitional period:

"It was the legislator's objective when providing for the possibility to opt-out, to give the patent holder the possibility to remove his European patent from the jurisdiction of the UPC for the whole life of that patent. This follows clearly from the fact that an opt-out can be notified until the very last day of the transitional period. The latter would make no sense and would not have been foreseen if the effect of an opt-out was to expire on the last day of the transitional period."

<https://www.unified-patent-court.org/faq/opt-out>

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How?

Rule 5: "1. The proprietor of a European patent (including a European patent that has expired) or the applicant for a published application for a European patent (hereinafter in this Rule 5 an "application") who wishes to opt out that patent or application from the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall **lodge an Application** (hereinafter in this Rule 5 an "Application to opt out") **with the Registry.**"

The Application can only be lodged in an electronic form

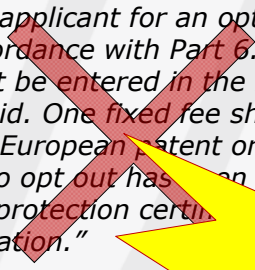
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Fee

Rule 5: "5. The applicant for an opt-out shall pay the fixed fee in accordance with Part 6. The Application to opt out shall not be entered in the register until the fixed fee has been paid. One fixed fee shall be payable in respect of each European patent or application for which an Application to opt out has been filed in respect of a supplementary protection certificate, a patent or application."



FREE!

Decision Prep Com
25/02/2016

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Who (representative)?

Rule 5: "4. Rule 8 shall not apply to Applications to opt out and to Applications to withdraw made pursuant to this Rule 5. Where a representative is appointed, **such a representative may include professional representatives and legal practitioners as defined in Article 134 EPC in addition to those referred to in Article 48 of the Agreement.**"

Rule 8 – Party and party's representative

1. A party shall be represented in accordance with Article 48 of the Agreement unless otherwise provided by these Rules [Rules 5, 88.4 and 378.5].

ARTICLE 48 UPCA Representation

- (1) Parties shall be represented by lawyers authorised to practise before a court of a Contracting Member State.
- (2) Parties may alternatively be represented by European Patent Attorneys who are entitled to act as professional representatives before the European Patent Office pursuant to Article 134 of the EPC and who have appropriate qualifications such as a European Patent Litigation Certificate.

Article 134 EPC

Representation before the European Patent Office

- (1) Representation of natural or legal persons in proceedings established by this Convention may only be undertaken by professional representatives whose names appear on a list maintained for this purpose by the European Patent Office.
- (2) Any natural person who
 - (a) is a national of a Contracting State,
 - (b) has his place of business or employment in a Contracting State and
 - (c) has passed the European qualifying examination
 may be entered on the list of professional representatives.
- (3) During a period of one year from the date on which the accession of a State to this Convention takes effect, entry on that list may also be requested by any natural person who
 - (a) is a national of a Contracting State,
 - (b) has his place of business or employment in the State having acceded to the Convention and
 - (c) is entitled to represent natural or legal persons in patent matters before the central industrial property office of that State.
 Where such entitlement is not conditional upon the requirement of special professional qualifications, the person shall have regularly so acted in that State for at least five years.
- (4) Entry shall be effected upon request, accompanied by certificates indicating that the conditions laid down in [paragraph 2](#) or [3](#) are fulfilled.
- (5) Persons whose names appear on the list of professional representatives shall be entitled to act in all proceedings established by this Convention.
- (6) For the purpose of acting as a professional representative, any person whose name appears on the list of professional representatives shall be entitled to establish a place of business in any Contracting State in which proceedings established by this Convention may be conducted, having regard to the Protocol on Centralisation annexed to this Convention. The authorities of such State may remove that entitlement in individual cases only in application of legal provisions adopted for the purpose of protecting public security and law and order. Before such action is taken, the President of the European Patent Office shall be consulted.
- (7) The President of the European Patent Office may grant exemption from:
 - (a) the requirement of [paragraphs 2\(a\)](#) or [paragraphs 3\(a\)](#) in special circumstances;
 - (b) the requirement of [paragraph 3\(c\)](#), second sentence, if the applicant furnishes proof that he has acquired the requisite qualification in another way.
- (8) Representation in proceedings established by this Convention may also be undertaken, in the same way as by a professional representative, by any legal practitioner qualified in a Contracting State and having his place of business in that State, to the extent that he is entitled in that State to act as a professional representative in patent matters. [Paragraph 6](#) shall apply mutatis mutandis.

Who (proprietor)?

Rule 5: "1. **The proprietor** of a European patent (including a European patent that has expired) or the applicant for a published application for a European patent (hereinafter in this Rule 5 an "application") who wishes to opt out that patent or application from the exclusive competence of the Court in accordance with Article 83(3) of the Agreement shall lodge an Application (hereinafter in this Rule 5 an "Application to opt out") with the Registry."

The licensee cannot opt out
(think of this in your license agreements)

Who (co-ownership)?

Rule 5 (1): "(a) Where the patent or application is owned by two or more proprietors or applicants, **all proprietors or applicants shall lodge the Application to opt out.**"

Who (registration in patent registers)?

Rule 5 (1): "(a) ...Where the person lodging an Application to opt out is not recorded as the proprietor or applicant in the registers referred to in Rule 8.5(a) and (b), respectively, the person shall lodge a declaration pursuant to paragraph 3(e)."

Rule 8:

5. Subject to paragraph 6, for the purposes of proceedings under these Rules:
(a) in relation to the proprietor of a European patent, the person entitled to be registered as proprietor under the law of each Contracting Member State in which such European patent has been validated shall be treated as the proprietor whether or not such person is in fact recorded in the register of patents maintained in such Contracting Member State (hereinafter "national patent register"); and
(b) in relation to the applicant for a European patent, the person entitled to be registered as applicant whether or not such person is in fact recorded as such in the European Patent Register kept by the European Patent Office.

What (content)?

Rule 5: "3. The Application to opt out shall contain:

- (a) the name of the proprietor or applicant [...], and all relevant postal and, where applicable, electronic addresses;
- (b) where such proprietor, applicant or holder have appointed a representative, the name and postal address and electronic address for service of the representative;
- (c) details of the patent and/or application including the number;
- (d) details of any supplementary protection certificate granted based on the patent concerned, including the number; and
- (e) for the purposes of paragraph 1(a), a Declaration of proprietorship that the person lodging the Application to opt out is the proprietor or applicant pursuant to Rule 8.5 and entitled to lodge the Application to opt out."


For where (territory)

Rule 5 (1): "(b) *The Application to opt out shall be made in respect of **all of the Contracting Member States for which the European patent has been granted** or which have been designated in the application.*"

What about the Member States which will ratify only after the entry into force of the Agreement?

So what (date of effect)?

Rule 5: "6. *Subject to paragraph 5 the Registrar shall as soon as practicable enter the Application to opt out in the register. Subject to paragraph 7, **the opt-out which meets the requirements laid down in this Rule shall be regarded as effective from the date of entry in the register.** If the requirements are missing or incorrectly recorded, a correction may be lodged with the Registry. The date of entry of the correction shall be noted in the register. **The opt-out shall be effective from the date of correction.***"



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Supplementary protection certificates (SPC) are linked with the patent

Rule 5: "2. **An Application to opt out** or an Application to withdraw an opt-out pursuant to paragraph 8 (hereinafter in this Rule 5 an "Application to withdraw") **shall extend to any supplementary protection certificate based on the European patent.**

(a) Where any such supplementary protection certificate has been granted at the date of lodging the Application to opt out or the Application to withdraw, the holder of the supplementary protection certificate shall, if different from the proprietor of the patent, lodge the Application to opt out or the Application to withdraw together with the proprietor.

(b) Where any such supplementary protection certificate is granted subsequent to lodging the Application to opt out, the opt-out shall take effect automatically on grant of said supplementary protection certificate."

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Withdrawal of the opt-out

Rule 5: "8. **A proprietor of a patent** or an application the subject of an opt-out pursuant to this Rule **may lodge an Application to withdraw** in respect of the patent or application, but not in respect of different Contracting Member States for which the European patent has been granted or which have been designated in the application. The Application to withdraw shall contain the particulars in accordance with paragraph 3 and shall be accompanied by the fixed fee in accordance with Part 6; paragraph 5 shall apply mutatis mutandis. Subject to the receipt of the fixed fee the Registrar shall as soon as practicable enter the Application to withdraw in the register and the withdrawal shall be regarded as effective from the date of entry in the register. Paragraphs 1(a) and 6 shall apply mutatis mutandis."

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Except in case of lock-in (see below)

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Only one round

Art 5: "11. A patent or application the subject of an Application to withdraw which has been entered on the register may not thereafter be the subject of a further Application to opt out."

Lock-in

Article 83 (3) UPC Agreement: "**Unless an action has already been brought before the Court**, a proprietor of or an applicant for a European patent [...] shall have the possibility to opt out from the exclusive competence of the Court. To this end they shall notify their opt-out to the Registry by the latest one month before expiry of the transitional period. The opt-out shall take effect upon its entry into the register."

Rule 5: "7. In the event that an action has been commenced before the Court in respect of a patent and/or an application contained in an Application to opt out prior to the date of entry of the Application to opt out in the register or prior to the date of correction pursuant to paragraph 6, the Application to opt out shall be ineffective in respect of the patent and/or application in question, **irrespective of whether the action is pending or has been concluded.**"

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Lock-out

Article 83 (4) UPC Agreement: "**Unless an action has already been brought before a national court**, proprietors of or applicants for European patents or holders of supplementary protection certificates issued for a product protected by a European patent who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt-out at any moment. In this event they shall notify the Registry accordingly. The withdrawal of the opt-out shall take effect upon its entry into the register."

Rule 5: "7. In the event that an action has been commenced before the Court in respect of a patent and/or an application contained in an Application to opt out prior to the date of entry of the Application to opt out in the register or prior to the date of correction pursuant to paragraph 6, the Application to opt out shall be ineffective in respect of the patent and/or application in question, **irrespective of whether the action is pending or has been concluded.**"

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Thank you

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**“To stay in
or to opt out?”**

that is the question.



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