



**Europäische  
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Administrative Council

**Organisation  
européenne des  
brevets**

Conseil d'administration

**SC/12/21**

Orig.: en

Munich, 26.11.2021

**SUBJECT:** Amendments to the Rules relating to Unitary Patent Protection regarding the Register for unitary patent protection – Rule 16 UPR

**SUBMITTED BY:** President of the European Patent Office

**ADDRESSEES:** Select Committee of the Administrative Council (for decision)

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#### SUMMARY

The present document proposes two amendments to Rule 16 of the Rules relating to Unitary Patent Protection (UPR) regarding the Register for unitary patent protection. It is proposed to remove the address of the inventor from the data published in the Register for unitary patent protection. Moreover, it is proposed that the Register for unitary patent protection be supplemented by information as to the residence or principal place of business of the applicant at the time of filing the European patent application.

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## PART I

### **I. STRATEGIC/OPERATIONAL**

1. Operational.

### **II. RECOMMENDATION**

2. The Select Committee is requested to approve the proposed amendments to the Rules relating to Unitary Patent Protection.

### **III. MAJORITY NEEDED**

3. Three-quarters (Article 9(5)(i) of the Rules of Procedure of the Select Committee).

### **IV. CONTEXT**

4. The Rules relating to Unitary Patent Protection (UPR) were adopted by the Select Committee by decision SC/D 1/15 of 15 December 2015.
5. Rule 16(1) UPR contains a list of entries in the Register for unitary patent protection, following the model of Rule 143(1) EPC. Rule 16(1) UPR needs to be amended so as to bring it into line with the recently amended Rule 143(1)(g) EPC as regards the removal of inventor addresses from the data published in the European Patent Register.
6. Moreover, the Register for unitary patent protection should be supplemented by information regarding the residence or principal place of business of the applicant at the time of filing the European patent application.

### **V. ARGUMENTS**

#### **A. REMOVAL OF INVENTOR ADDRESS FROM THE DATA PUBLISHED IN THE REGISTER FOR UNITARY PATENT PROTECTION**

7. By decision CA/D 11/20 of 15 December 2020 (OJ EPO 2021, A3), the Administrative Council of the European Patent Organisation amended Rules 19 and 143 of the Implementing Regulations to the EPC. Since 1 April 2021, the EPO no longer requires applicants to indicate full addresses (including street and house number) when designating an inventor. Instead, applicants need only provide the inventor's country and place of residence.
8. Furthermore, the EPO no longer publishes the full address of the inventor in the European Patent Register. Amended Rule 143(1)(g) EPC entered into force on 1 November 2021 and applies to all patent applications published in the European Patent Register on or after that date. In addition, inventors designated on or after 1 April 2021 for applications published before 1 November 2021 are published in the European Patent Register without their full address unless the address has nevertheless been provided by the applicant.

9. Instead of the inventor's full address, only the country and place of residence will be published for these patent applications. The same applies to inventor designations rectified under Rule 21 EPC.
10. The Rules relating to Unitary Patent Protection need to be brought into line with Rule 143(1)(g) EPC, which was amended in view of the recommendation of a common practice as regards the designation of the inventor (CA/PL 6/20). One of the main reasons for the amendment of Rule 143(1)(g) EPC was that inventors may have an interest in their inventorship being recognised in the application without the full set of personal data, especially their private address, being made available to the public – for reasons of data protection (see CA/78/20, at 23). Accordingly, it is proposed to amend Rule 16(1)(i) UPR as follows:

<p style="text-align: center;"><b>Present wording</b></p> <p style="text-align: center;"><b>Rule 16(1)(i) Entries in the Register for unitary patent protection</b></p>	<p style="text-align: center;"><b>Proposed wording</b></p> <p style="text-align: center;"><b>Rule 16(1)(i) Entries in the Register for unitary patent protection</b></p>
<p>(i) family name, given names and address of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20, paragraph 1 EPC;</p>	<p>(i) family name, given names and <b>country and place of residence</b> of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20, paragraph 1 EPC;</p>

**B. RESIDENCE OR PRINCIPAL PLACE OF BUSINESS ON THE DATE OF FILING OF THE APPLICATION FOR THE EUROPEAN PATENT**

11. Pursuant to Article 7(1) Regulation (EU) No 1257/2012, a European patent with unitary effect as an object of property shall be treated in its entirety and in all the participating Member States as a national patent of the participating Member State in which that patent has unitary effect and in which, according to the European Patent Register: (a) the applicant had his residence or principal place of business on the date of filing of the application for the European patent; or (b) where point (a) does not apply, the applicant had a place of business on the date of filing of the application for the European patent.
12. Article 7 of Regulation (EU) No 1257/2012 contains a conflict-of-laws rule in the form of a reference to national law. It is always just one single legal order which applies to an individual European patent with unitary effect as an object of property and thus allows for a uniform commercial exploitation, thereby reducing complexity and avoiding deviating formal requirements, for instance as to a licencing agreement.

13. The particulars under Article 7(1)(b) Regulation (EU) No 1257/2012 are already provided for in the Register for unitary patent protection (see Rule 16(1)(w) UPR). Users had pointed out the practical usefulness of having an indication, in the Register for unitary patent protection, of a place of business of the applicant on the date of filing of the application for the European patent. This indication is useful in cases where the applicant of a European patent application or of an international application under the PCT designating or electing the EPO (Euro-PCT application) does not have a principal place of business on the date of filing of the application in one of the participating Member States pursuant to Article 7(1)(a) Regulation (EU) No 1257/2012. In such cases, the information regarding the place of business of the applicant pursuant to Article 7(1)(b) Regulation (EU) No 1257/2012 may be provided to the EPO on a voluntary basis (see explanatory remark 18 to Rule 16 UPR, SC/D 1/15). The wording of Rule 16(1)(w) UPR ensures that the proprietor of the European patent can provide a place of business when filing the request for unitary effect or, once unitary effect has been registered by the EPO, that the proprietor of the European patent with unitary effect can provide this information at any time after the registration of unitary effect by the EPO.
14. Rule 16(1)(h) UPR sets out the particulars of the proprietor of the European patent with unitary effect as provided for in Rule 41(2)(c) EPC, namely the name, address and nationality of the applicant and the state in which his residence or principal place of business is located. This latter entry, however, is dynamic, i.e. it reflects the residence or principal place of business of the applicant which may change during the grant procedure. It does not necessarily show the residence or principal place of business at the time of filing the European patent application. Therefore, it is proposed to amend Rule 16(1) UPR so as to complement the Register for unitary patent protection with information on the residence or principal place of business at the time of filing the European patent application within the meaning of Article 7(1)(a) Regulation (EU) No 1257/2012.
15. The request for grant of a European patent is to be filed using a form drawn up by the European Patent Office (EPO Form 1001, see Rule 41(1) EPC). Moreover, for international applications under the PCT, the request must be made using Form PCT/RO/101 (see Rule 3.1 PCT). Whereas EPO Form 1001 requires the applicant to indicate his residence or principal place of business (cf. Rule 41(2)(c) EPC), Form PCT/RO/101 requires the applicant to indicate his residence (cf. Rule 4.5(c) PCT). Rule 18.1(a) and (b)(i) PCT provides that, while the question of residence in a PCT Contracting State depends on the national law of that State and is decided by the receiving Office, "possession of a real and effective industrial or commercial establishment in a Contracting State" is to be considered "residence" in that State.
16. In order to display the residence or principal place of business in the Register for unitary patent protection, the EPO will provide a link to EPO Form 1001 in case of a European patent application and a link to Form PCT/RO/101 in case of a Euro-PCT application.

17. The information displayed by the EPO in the Register for unitary patent protection will help users in determining the law applicable to a European patent with unitary effect as an object of property. It is however to be noted that the EPO does not and cannot verify the accuracy of the information provided to it and displayed in the Register for unitary patent protection for the purpose of Article 7(1)(a) and (b) Regulation (EU) No 1257/2012.
18. For the aforementioned reasons, it is proposed to add a new subparagraph (x) to Rule 16(1) UPR which reads as follows:

<p style="text-align: center;"><b>Present wording</b>  <b>Rule 16(1)(x) Entries in the Register for unitary patent protection</b></p>	<p style="text-align: center;"><b>Proposed wording</b>  <b>Rule 16(1)(x) Entries in the Register for unitary patent protection</b></p>
	<p>(x) information regarding the residence or principal place of business of the applicant on the date of filing of the application for the European patent pursuant to Article 7, paragraph 1(a), Regulation (EU) No 1257/2012.</p>

**VI. ALTERNATIVES**

19. N/A

**VII. FINANCIAL IMPLICATIONS**

20. N/A

**VIII. LEGAL BASIS**

21. Rule 2(1)(a) UPR.

**IX. RECOMMENDATION FOR PUBLICATION**

22. Yes.

## PART II

### Draft

DECISION OF THE SELECT COMMITTEE OF THE  
ADMINISTRATIVE COUNCIL  
of [date of decision]  
amending Rule 16 of the Rules relating to Unitary  
Patent Protection

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THE SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL OF THE EUROPEAN  
PATENT ORGANISATION,

Having regard to Regulations (EU) No 1257/2012 and No 1260/2012,

Having regard to Rule 2(1)(a) of the Rules relating to Unitary Patent Protection,

HAS DECIDED AS FOLLOWS:

#### Article 1

Rule 16 of the Rules relating to Unitary Patent Protection shall be amended as follows:

1. Subparagraph (i) of paragraph 1 shall read as follows:

"family name, given names and country and place of residence of the inventor designated by the applicant for or proprietor of the patent, unless he has waived his right to be mentioned under Rule 20, paragraph 1 EPC;"

2. The following subparagraph (x) shall be added to paragraph 1:

"information regarding the residence or principal place of business of the applicant on the date of filing of the application for the European patent pursuant to Article 7, paragraph 1(a), Regulation (EU) No 1257/2012."

## Article 2

Rule 16 of the Rules relating to Unitary Patent Protection as amended under Article 1 of this decision shall enter into force on the date of application of Regulations (EU) No 1257/2012 and No 1260/2012 in accordance with Article 18, paragraph 2, of Regulation (EU) No 1257/2012 and Article 7, paragraph 2, of Regulation (EU) No 1260/2012.

Done at Munich, [date of decision]

For the Select Committee of the  
Administrative Council  
The Chairperson

Jérôme DEBRULLE