



**Europäische
Patent-
organisation**

Verwaltungsrat

**European
Patent
Organisation**

Administrative Council

**Organisation
européenne des
brevets**

Conseil d'administration

SC/4/22

Orig.: en

Munich, 03.03.2022

SUBJECT: Amendments to the Rules relating to Unitary Patent Protection regarding the Register for unitary patent protection in relation with the identification of the place of business – Rule 16 UPR

SUBMITTED BY: President of the European Patent Office

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

SUMMARY

The present document proposes to amend Rule 16(1)(w) of the Rules relating to Unitary Patent Protection (UPR) regarding the entry in the Register for unitary patent protection of a place of business at the time of filing the European patent application within the meaning of Article 7(1)(b) Regulation EU No 1257/2012. It is proposed that the voluntary indication of such a place of business is registered by the EPO in the Register for unitary patent protection only if it is provided by the proprietor of the European patent together with the request for unitary effect referred to in Rule 6 UPR.

This document has been issued in electronic form only.

TABLE OF CONTENTS

Subject	Page
PART I	1
I. STRATEGIC/OPERATIONAL	1
II. RECOMMENDATION	1
III. MAJORITY NEEDED	1
IV. CONTEXT	1
V. ARGUMENTS	2
VI. ALTERNATIVES	5
VII. FINANCIAL IMPLICATIONS	5
VIII. LEGAL BASIS	5
IX. RECOMMENDATION FOR PUBLICATION	5
PART II	6

PART I

I. **STRATEGIC/OPERATIONAL**

1. Operational.

II. **RECOMMENDATION**

2. The Select Committee is requested to approve the proposed amendment to the Rules relating to Unitary Patent Protection (UPR).

III. **MAJORITY NEEDED**

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

IV. **CONTEXT**

4. The UPR were adopted by the Select Committee by decision SC/D 1/15 of 15 December 2015. Rule 16(1) UPR contains a list of entries in the Register for unitary patent protection, following the model of Rule 143(1) EPC. It was amended in December 2021: it was brought into line with amended Rule 143(1)(g) EPC as regards the removal of inventor addresses from the data published in the European Patent Register; and it was supplemented by Rule 16(1)(x) UPR, which provides for information regarding the residence or principal place of business of the applicant at the time of filing the European patent application within the meaning of Article 7(1)(a) Regulation (EU) No 1257/2012 (see decision SC/D 3/21 of 16 December 2021).
5. At the same meeting of the Select Committee, in conjunction with the adoption of the above-mentioned amendments to the UPR, the Office was requested to engage in further discussions with the user organisations so as to clarify the time frame for the voluntary indication of a place of business at the time of filing the European patent application within the meaning of Article 7(1)(b) Regulation (EU) No 1257/2012 that is provided for by Rule 16(1)(w) UPR. A meeting took place with the Chairperson of the Select Committee and representatives of epi, BusinessEurope and the EPO on 31 January 2021. User organisations unanimously expressed a wish for maximum legal certainty as to the information displayed in the Register for unitary patent protection under Rule 16(1)(w) UPR. To that effect, it was suggested that the period during which such a place of business can be registered in the Register for unitary patent protection be limited. It is therefore proposed to amend Rule 16(1)(w) UPR so as to provide that the EPO will only register a place of business within the meaning of Article 7(1)(b) Regulation EU (No) 1257/2012 in the Register for unitary patent protection if it is provided by the proprietor of the European patent together with the request for unitary effect referred to in Rule 6 UPR.

V. ARGUMENTS

6. Article 7 Regulation (EU) No 1257/2012¹ deals with the European patent with unitary effect as an object of property. It determines the law applicable to acts of commercial exploitation, such as the formal requirements governing a transfer of rights or a licensing contract. It is always just one single legal order which applies to an individual European patent with unitary effect as an object of property, and this allows for uniform commercial exploitation.
7. Article 7(1) Regulation (EU) No 1257/2012 provides for two connecting factors to determine the applicable national law. The first connecting factor is the participating Member State where the applicant had his residence or principal place of business on the date of filing of the European patent application. Where this does not apply, the second connecting factor is then the participating Member State where the applicant had a place of business on the date of filing of the European patent application. For both of these connecting factors to apply, the relevant participating Member State must be covered by the European patent with unitary effect. This means that the relevant State must have ratified the Agreement on a Unified Patent Court (UPCA). If neither of these two connecting factors applies, German law applies to the Unitary Patent as an object of property under Article 7(3) of the Regulation, since this is the State where the European Patent Organisation has its headquarters.

¹ Article 7 Regulation (EU) No 1257/2012 ("Treating a European patent with unitary effect as a national patent") reads as follows:

- "1. 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.
2. Where two or more persons are entered in the European Patent Register as joint applicants, point (a) of paragraph 1 shall apply to the joint applicant indicated first. Where this is not possible, point (a) of paragraph 1 shall apply to the next joint applicant indicated in the order of entry. Where point (a) of paragraph 1 does not apply to any of the joint applicants, point (b) of paragraph 1 shall apply accordingly.
3. Where no applicant had his residence, principal place of business or place of business in a participating Member State in which that patent has unitary effect for the purposes of paragraphs 1 or 2, the 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 State where the European Patent Organisation has its headquarters in accordance with Article 6(1) of the EPC.
4. The acquisition of a right may not be dependent on any entry in a national patent register."

8. The Register for unitary patent protection contains 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 (see Rule 16(1)(x) UPR adopted by decision SC/D 3/21 of 16 December 2021). 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). 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 (see Rule 41(2)(c) EPC), Form PCT/RO/101 requires the applicant to indicate his residence (see Rule 4.5(c) PCT). Rule 18.1(a) and (b)(i) PCT provide 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. 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 the case of a European patent application and a link to Form PCT/RO/101 in the case of a Euro-PCT application.
9. The Register for unitary patent protection also contains information on a place of business at the time of filing the European patent application within the meaning of Article 7(1)(b) Regulation (EU) No 1257/2012, if provided on a voluntary basis (see Rule 16(1)(w) UPR). At the time of adopting the UPR, users pointed out the practical usefulness of such information 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 which has ratified the UPCA, for instance in the United States of America or Switzerland.
10. The wording of Rule 16(1)(w) UPR states 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.
11. Users have since pointed out that allowing the proprietor of the European patent with unitary effect to indicate a place of business at any time during the whole lifetime of the European patent with unitary effect would in fact contravene the static regime provided for by Article 7 of Regulation (EU) No 1257/2012. The proprietor of a European patent with unitary effect would be allowed to change the law applicable to the European patent with unitary effect as an object of property at any time from German law, which may be applicable under Article 7(3) of Regulation (EU) No 1257/2012, to the law of a participating Member State having ratified the UPCA. This would bring legal uncertainty and would go against the object and purpose of Article 7 of Regulation (EU) No 1257/2012, which is to provide for a reliable and authoritative indication in the Register for unitary patent protection as regards the law applicable to the European patent with unitary effect as an object of property.

12. For these reasons, it is proposed to amend Rule 16(1)(w) UPR by deleting the possibility for the proprietor of a European patent with unitary effect to provide an indication of a place of business within the meaning of Article 7(1)(b) Regulation (EU) No 1250/2012.
13. It is moreover proposed to amend and refine the wording of Rule 16(1)(w) UPR by providing that the information pursuant to Article 7(1)(b) of Regulation (EU) No 1257/2012 will be registered in the Register for unitary patent protection only if it is submitted by the proprietor of a European patent together with the request for unitary effect referred to in Rule 6 UPR. Rule 6(1) UPR states that the request for unitary effect shall be filed with the European Patent Office no later than one month after publication of the mention of grant of the European patent in the European Patent Bulletin. The proposed wording also emphasises the fact that the indication of a place of business within the meaning of Article 7(1)(b) Regulation (EU) No 1257/2012 is voluntary.
14. Form 7000 for requesting unitary effect in the EPO's online filing software will provide a specific field for entering a place of business within the meaning of Article 7(1)(b) Regulation (EU) No 1250/2012. It will thus be very easy for users to provide the EPO with that information together with the request for unitary effect.
15. Providing that a place of business within the meaning of Article 7(1)(b) Regulation (EU) No 1257/2012 can only be filed by the proprietor of a European patent together with the request for unitary effect will increase legal certainty. It will ensure that the law applicable to the European patent with unitary effect as an object of property does not change during the lifetime of the European patent with unitary effect. For any given European patent with unitary effect, it will provide for an unalterable, static indication of the law applicable to the European patent with unitary effect in line with the object and purpose of Article 7 of Regulation (EU) No 1257/2012.
16. The information displayed by the EPO in the Register for unitary patent protection will enable users to determine the law applicable to a European patent with unitary effect as an object of property. It should be noted, however, 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 (see SC/12/21, point 17).
17. In that context, it should also be noted that, if a residence or principal place of business within the meaning of Article 7(1)(a) Regulation (EU) No 1257/2012 in one of the participating Member States having ratified the UPCA has been provided when filing the European patent application or the international application under the PCT (for example Austria), the law of that State would apply according to Article 7(1)(a) of the Regulation.
18. Given the importance of determining the applicable law in accordance with Article 7(1) of that Regulation, the proprietor of the European patent will have to take great care in providing the correct information complying with that provision, especially its hierarchy of connecting factors, in order to avoid any legal uncertainty. This is not only relevant for the proprietor but also for third parties, for whom incorrect information may have adverse legal consequences.

19. As a result of the proposed rule change and the legal effect of the information contained in the Register for unitary patent protection under proposed Rule 16(1)(w) UPR, the former explanatory remark to Rule 16(1)(w) UPR as contained in SC/D 1/15 (see explanatory remark 18 to Rule 16 UPR) is superseded.
20. For the aforementioned reasons, it is proposed to amend Rule 16(1)(w) UPR as follows:

<p style="text-align: center;">Present wording Rule 16(1)(w) Entries in the Register for unitary patent protection</p>	<p style="text-align: center;">Proposed wording Rule 16(1)(w) Entries in the Register for unitary patent protection</p>
<p>(w) information regarding a place of business of the applicant on the date of filing of the application for the European patent pursuant to Article 7, paragraph 1(b), Regulation (EU) No 1257/2012 provided by the proprietor of the European patent or of the European patent with unitary effect.</p>	<p>(w) information regarding a place of business of the applicant on the date of filing of the application for the European patent pursuant to Article 7, paragraph 1(b), Regulation (EU) No 1257/2012, which may be provided by the proprietor of the European patent together with the request for unitary effect referred to in Rule 6; or of the European patent with unitary effect.</p>

VI. ALTERNATIVES

21. N/A

VII. FINANCIAL IMPLICATIONS

22. N/A

VIII. LEGAL BASIS

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

IX. RECOMMENDATION FOR PUBLICATION

24. 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

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(1) of the Rules relating to Unitary Patent Protection shall be amended as follows:

Subparagraph (w) shall read as follows:

"information regarding a place of business of the applicant on the date of filing of the application for the European patent pursuant to Article 7, paragraph 1(b), Regulation (EU) No 1257/2012, which may be provided by the proprietor of the European patent together with the request for unitary effect referred to in Rule 6;"

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