



Institut der beim Europäischen Patentamt zugelassenen Vertreter  
Institute of Professional Representatives before the European Patent Office  
Institut des mandataires agréés près l'Office européen des brevets

## epi – the organisation of European Patent Attorneys

*Tony Tangena*  
*epi President*



European bundle patent: one procedure leads to national patents



## Two types of patent attorney

- **20%: ‘Grandfathers’ or ‘grandmothers’:** national examination or test, qualification automatically granted when country accedes European Patent Convention
- **80%: EQE qualified:** qualified through the European Qualification Examination:
  - 3 year study
  - 4 exams: passing rate <50%
- 11,550 European Patent Attorneys
  - they are obliged to be member of epi

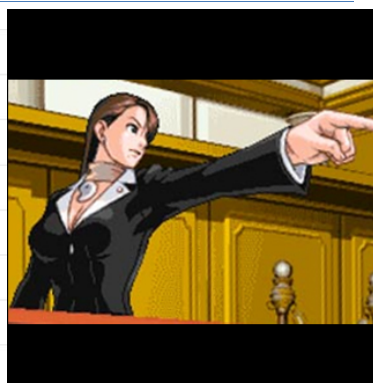
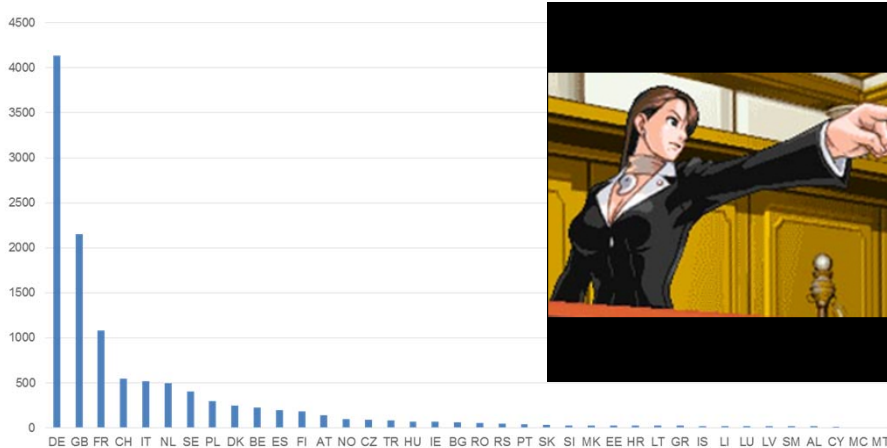


13/09/16

European Patent Institute



## Number of EU Patent attorneys 2009




Number differs largely; votes only slightly depend on numbers of attorneys




13/09/16

European Patent Institute

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## Structure epi

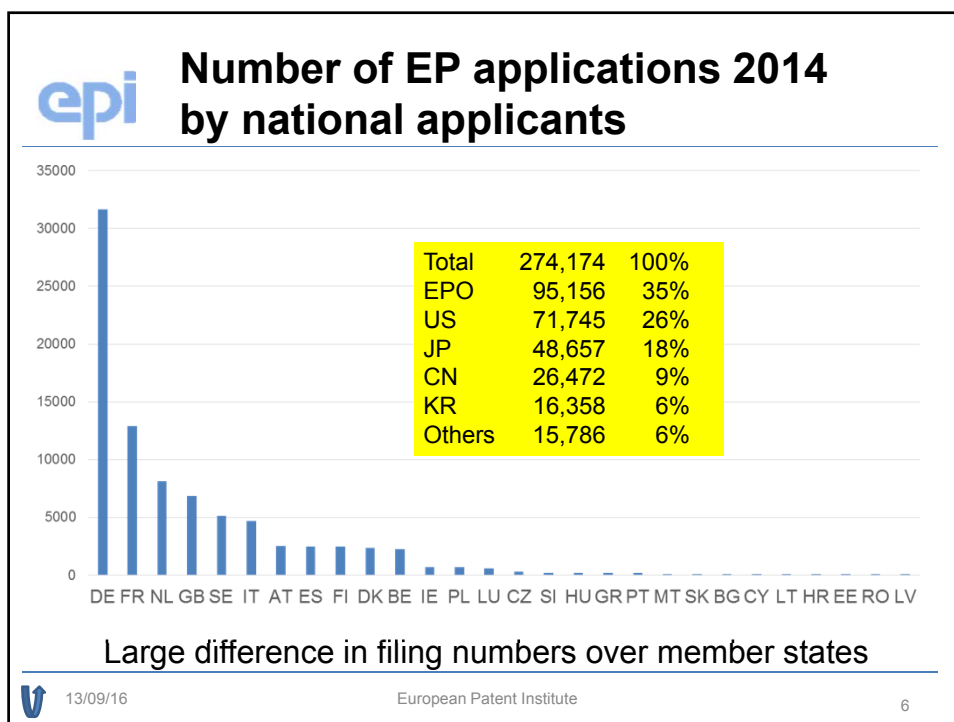


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- **Presidium:** President (NL), 2 VP (DE, RO), 1 Treasurer (CH) + 1 Deputy (EE), 1 Secretary General (PT) + 1 Deputy (FI)
- **Board:** 1 member per country, 2 for UK, DE, FR, CH. **From 2017 Presidium plus some chairs**
- **Council:** 2-6 members / country: 140 members
- **(Sub)Committees:** 14 (76) 4 – 65 members
- **Secretariat:** 11 persons in Munich

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 European Patent Institute
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## Challenges

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- Population of patent attorneys differs largely over Europe
  - Many countries have few well-trained patent attorneys
    - Candidate support program together with EPO
    - Provide more training for EPAs



- Organisation is 35 years old
    - Modernize: How can we offer more to our members?
    - Reform: Board, Council, transparency, better representation, modern communication tools, fora etc.
-



# Taiwan Patent Attorneys Association ( TWPAA )

*September 2016*



## History of Patent Attorney System in Taiwan

1 Jan. 1949	Patent Act enacted
18 Jul. 1953	Patent Agent Regulations promulgated
1988	Patent Attorney Act ("PAA") Draft submitted to the Legislative Yuan
11 Jul. 2007	PAA promulgated
11 Jan. 2008	PAA effective
23 Aug. 2008	First patent bar exam held
11 Dec. 2009	TWPAA founded



## Patent Attorney Qualifications

- National Exam (patent attorney bar)
- Mandatory pre-practice training
- Allowed to practice as a patent attorney only after joining the Patent Attorneys Association
- Shall practice in any of the following ways:
  - Set up a patent firm.
  - Employed by a firm engaging in patent professional services.
  - Employed by a judicial association or a judicial person established or registered according to the law.

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## Practice Areas

- Article 9, PAA
  1. Patent filing
  2. Patent invalidation
  3. Registration of assignment, trust, pledge, licensing and compulsory licensing of patent rights
  4. Administrative appeals and litigation pertaining to patents
  5. Patent infringement assessment
  6. Patent consultation
  7. Patent matters prescribed in other laws
- Civil litigation

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## Patent Bar

- Once a year
- 7 subjects
  - Patent laws
  - Administrative laws related to patent matters
  - Patent examination guidelines
  - Patent documents drafting
  - English or Japanese
  - General physics and chemistry
  - Engineering (6 options)
- Passing rate: 10%

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## Pre-Practice Training

- 60 hours
- Lectures by
  - Senior patent examiners
  - Judges
  - Senior patent attorneys
- Team thesis
- Final exam
- Used to be organized by the Intellectual Property Office but will be taken over by the TWPAA

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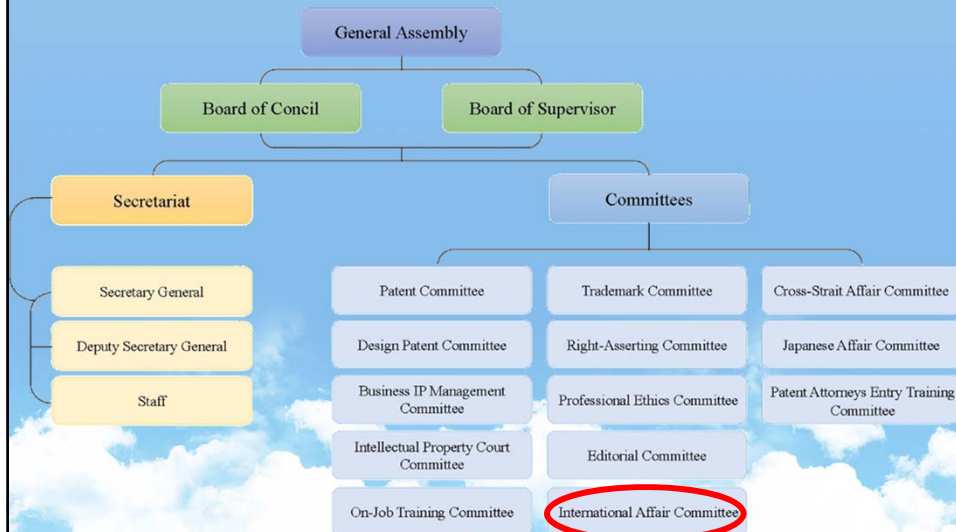
## Patent Agent v. Patent Attorney

- Before Jan. 2008, certified engineers, lawyers, and accountants, as well as patent examiners, could register with the Intellectual Property Office as a patent agent.
- Registered patent agents with actual practice experience could waive the exam requirements upon professional training satisfactorily completed within three years from the effective date of the Patent Attorney Act.
- Now, registered patent agents are allowed to continue their practice but are not allowed to join the TWPAA and cannot practice in the role of patent attorney.

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## Organization of TWPAA




\*301 members as of June 2016

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 **Outreach**

- We pay regular visits to other professional bodies overseas to
  - promote mutual understanding and benefits, and
  - host joint activities and seminars.
- We also receive frequent visits from foreign officials (e.g., EPO and JPO), practitioners (e.g., AIPLA) and judges (e.g., from the US and Germany).

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The slide features the TWPAA logo in the top-left corner. The main title is "Publication of TWPAA" in large black font. Below the title is a bullet point: "■ Patent Attorney Quarterly". To the right is a large image of the cover of the "Taiwan Patent Attorneys Journal". The cover has a dark blue background with a grid of light blue dots. The title "Taiwan Patent Attorneys Journal" is in white, with the Chinese characters "專利師" in a larger font below it. The issue number "25" and date "Apr. 2016" are in the top right. A list of articles is visible on the cover:

- 相關消費者對商標熟悉程度與商標及商標權之互動與認定  
——從智慧財產法院103年行政訴訟字第151號行政判決談起
- 專利專利制度的相關請求
- 在「美設計專利侵害判斷之過去發展與未來展望」
- 先願技術與專利侵權訴訟之適用策略
- 智慧財產權與網絡自由步禁制令中「不可回復損害」判斷之探討  
——以美國最近商標權訴訟為核心



# Thank you

Contact TWPA:

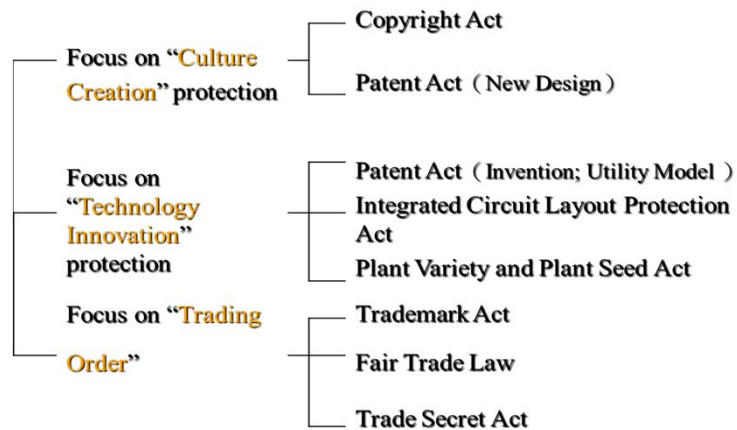
- Address : 11<sup>th</sup> Fl., 390 Fu-Hsing S. Road, Sec. 1, Taipei 106, Taiwan
- Tel : +886-2-27011990
- Fax : +886-2-27010799
- E-mail : [mail@twpaa.org.tw](mailto:mail@twpaa.org.tw)
- Website : <http://www.twpaa.org.tw>



## Table of Contents

- I. Taiwan IP Law Overview
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- III. IPC Litigation Process
- IV. Statistical Analysis on IPC/TIPO Cases
- V. A Glance at Patent Prosecution in Taiwan

## I. IP Laws in Taiwan



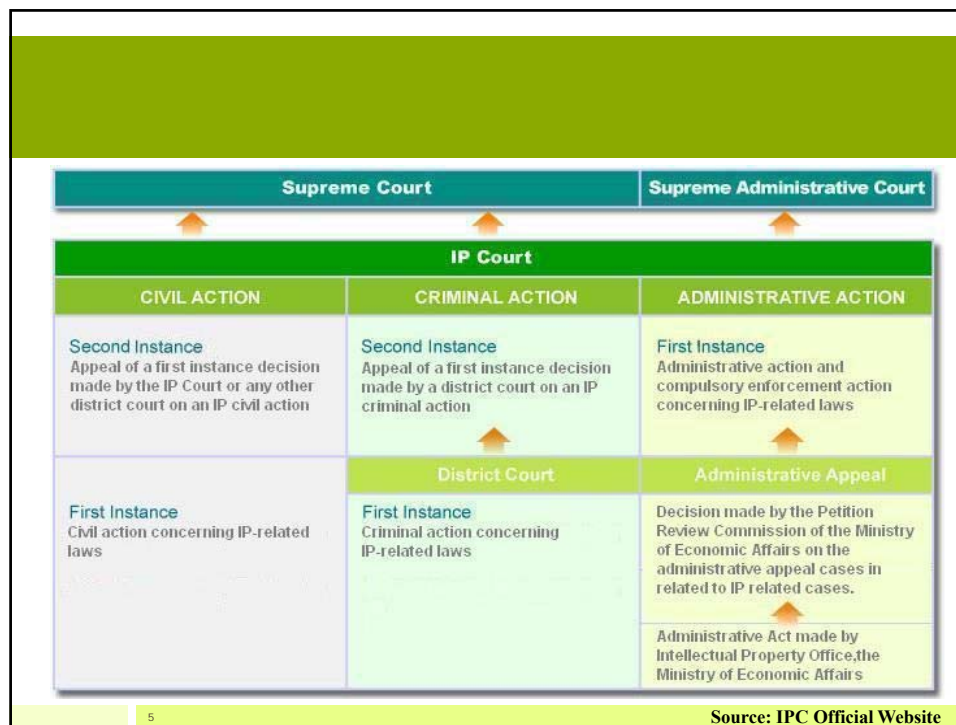
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Formosan Brothers

## II. Intellectual Property Court

- Time of Establishment
  - July 1, 2008
  
- New Act especially for IPC and IP cases
  - Intellectual Property Court Organization Act
  - Intellectual Property Case Adjudication Act

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## Key Features of the new mechanism

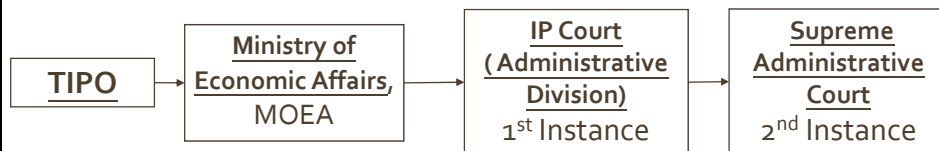
- Civil Court shall determine the issue of patent validity when the defendant raise Invalidity Defense
- Technical Examiner
- Introducing “Confidentiality Preservation Order”
- Civil Court may order TIPO to intervene when necessary
- Evidence Preservation Order
- New standard for “Preliminary Injunction”
- New Evidence in Administrative Litigation

## *Taiwan Litigation and Invalidation Procedure*

### • IP Infringement Civil Litigation:



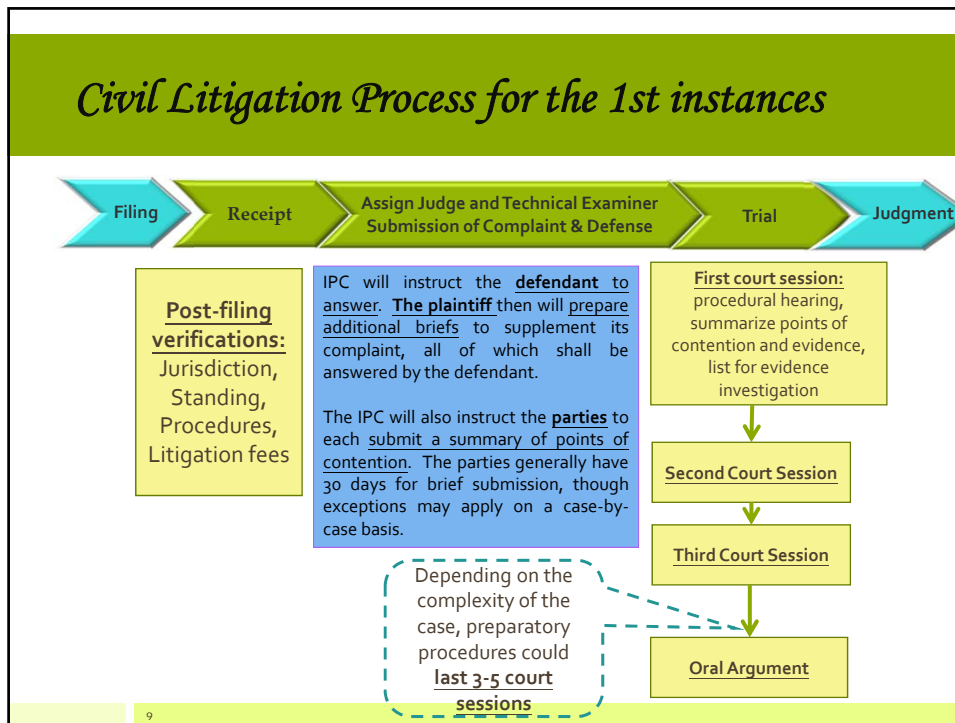
### • Invalidation action:



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## III. IPC Litigation Process

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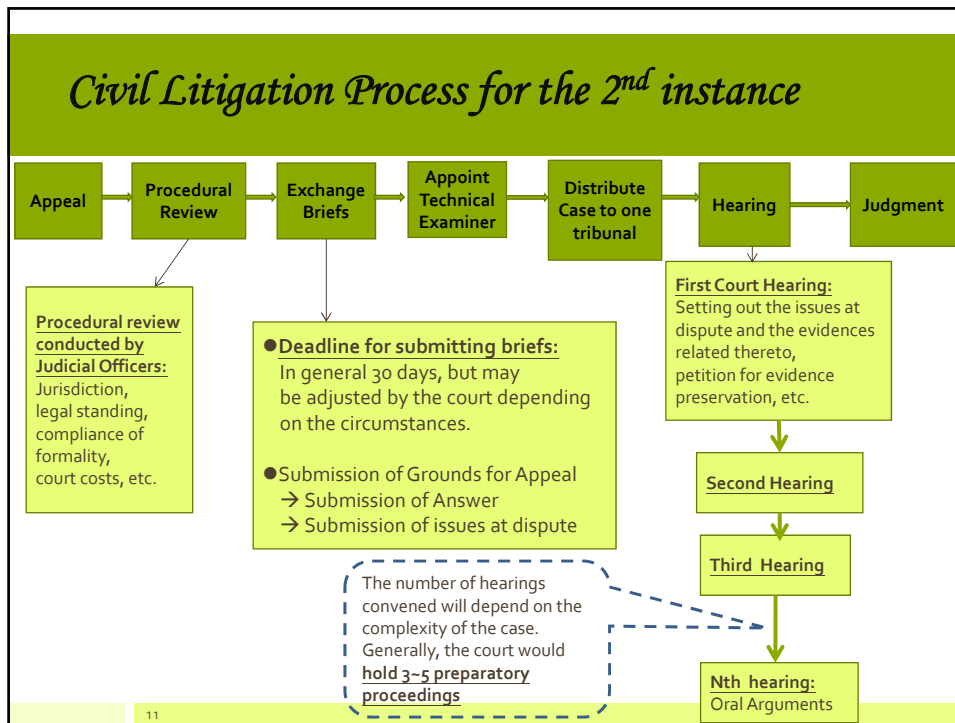


### Statistics on First Instance Civil Cases in the IP Court

	Number of Cases Accepted			Closed Cases	Pending Cases	Average Days Required to Close Case
	Total	Pending Cases from Previous Year	New Cases			
Total	3897			3708	189	206.57
2008/7-12	183		183	102	81	58.00
2009	563	81	482	410	153	128.34
2010	899	153	746	708	191	159.39
2011	652	191	461	490	162	209.17
2012	736	162	574	541	195	225.29
2013	687	195	492	476	211	231.57
2014	725	211	514	506	219	233.61
2015	664	219	445	475	189	278.28

10 2016.03.30

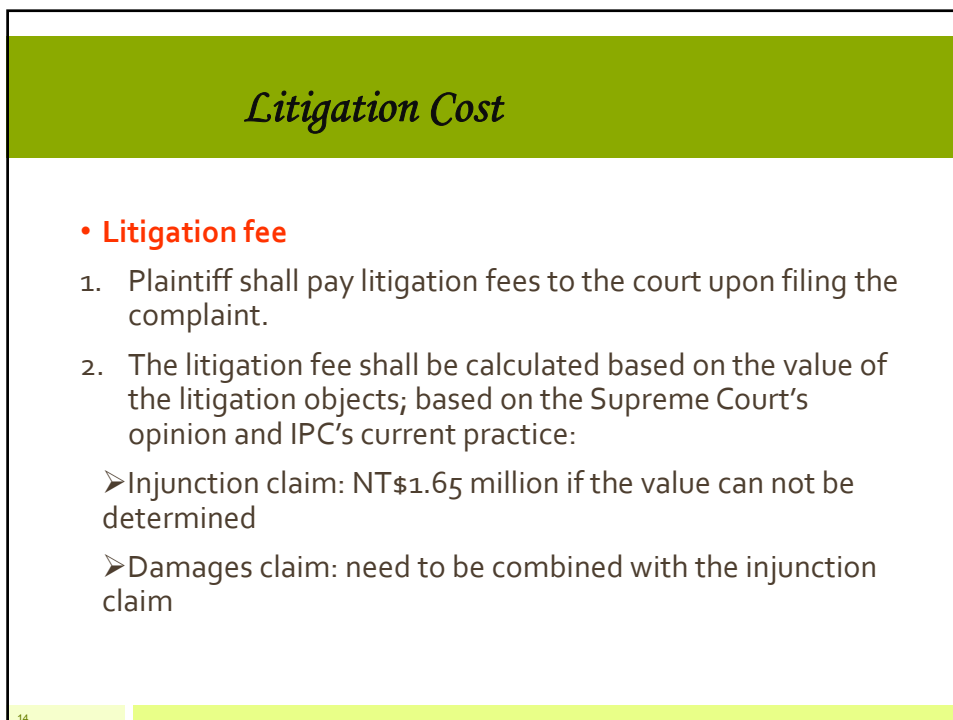
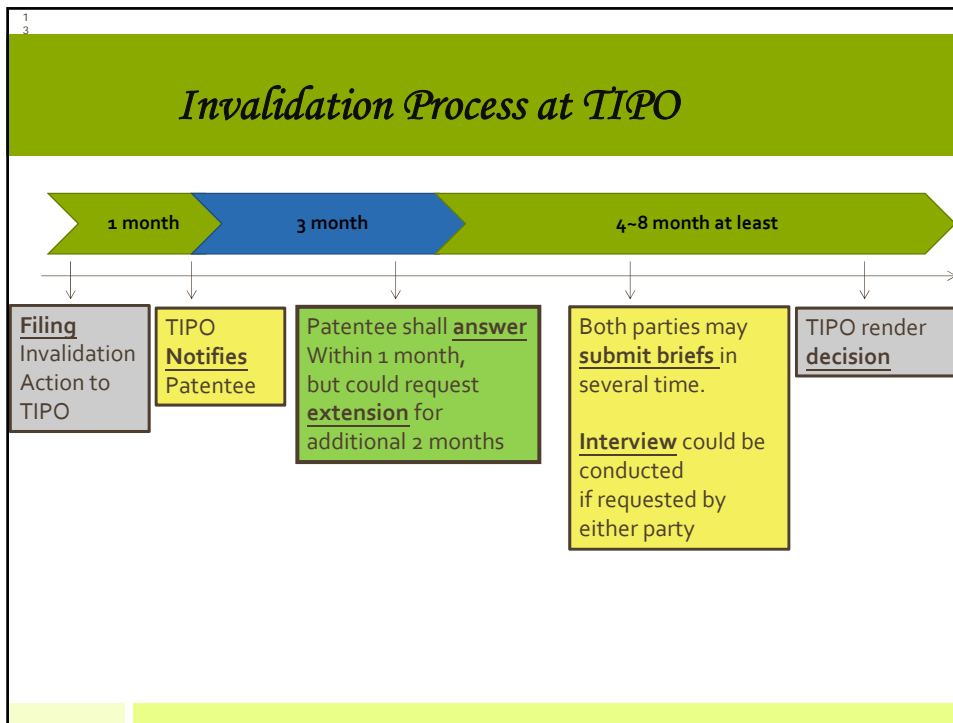




### Statistics on Second Instance Civil Cases in the IP Court

	Number of Cases Accepted			Closed Cases	Pending Cases	Average Days Required to Close Case
	Total	Pending Cases from Previous Year	New Cases			
Total	1774			1649	125	196.05
2008/7-12	92		92	46	46	48.62
2009	313	46	267	207	106	110.66
2010	417	106	311	273	144	108.53
2011	380	144	236	268	112	220.85
2012	327	112	215	222	105	204.26
2013	343	105	238	222	121	216.70
2014	321	121	200	196	125	215.91
2015	340	125	215	215	125	253.70

12    2016.03.30



## *Litigation Cost*

- **Litigation fee Security ("Security")**

1. If the plaintiff has no domicile, offices or business establishment in Taiwan, the court may order plaintiff to pay Security upon the request of defendant
2. Includes the **litigation fees for the 2<sup>nd</sup> and 3<sup>rd</sup> instances** plus **the attorney's fee for the 3<sup>rd</sup> instance**.
3. Attorney's fee for the 3<sup>rd</sup> instance: **3%** of the price value of the litigation object or no more than **NT\$500,000**
4. Defendant may refuse to answer the case before the security has been paid by plaintiff

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## *Damages Issue\_ Patent / Design*

- **Plaintiff may choose one of the following methods**

1. The patentee's lost of profit and the injury actually suffered
2. The profit earned by the infringer
3. Reasonable Royalties

- **Treble Damages**

willful infringement

- **Business reputation damages**

If the business reputation of the patentee has been downgraded or injured as a result of the infringement.

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## IV. Statistical Analysis on IPC/TIPO Cases

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### *Statistics on Patent Cases in IP Court*

© Statistics on patent civil litigation cases involving **invalidity challenge** in the first instance IP Court and the success rate thereof

	2008.7~12	2009	2010	2011	2012	2013	2014
No decision on Validity	2	10	14	13	10	16	23
Patent Valid	1	7.5	7	13	10	13	17
Patent Invalid	2	29.5	47	40	43	45	26
Total cases	5	47	68	66	63	74	66
<b>Invalidation Success Rate (%)</b>	<b>40.00</b>	<b>62.77</b>	<b>69.12</b>	<b>60.61</b>	<b>68.25</b>	<b>60.81</b>	<b>39.39</b>

The success rates for invalidate are **over 60%** from years 2009 to 2013, but the rate **dropped to 39%** in 2014

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## *Statistics on Patent Cases in IP Court*

◎ Statistics on **case numbers** and **plaintiff's (patentee) success rates** regarding patent civil litigation cases in the first instance IP Court

	2008.7~12	2009	2010	2011	2012	2013	2014	Total
Plaintiff prevails	1	3	4	7	4	8	5	32
Plaintiff prevails in part	0	8	10	16	20	18	13	85
Plaintiff loses	8	59	89	85	76	90	56	463
Case numbers	9	70	103	108	100	116	74	580
<b>Plaintiff success rate (%)</b>	<b>11.11</b>	<b>15.71</b>	<b>13.59</b>	<b>21.30</b>	<b>24.00</b>	<b>22.41</b>	<b>24.32</b>	<b>20.17</b>

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## *Statistics on Patent Cases in IP Court*

◎ Statistics on the patent civil litigation case numbers in **the first instance IP Court** from Nov. 11, 2010 to April 2014 :

Invention Patent: 126

Utility Model: 185

Design: 36

Design	
Time period	Case number
11/2010 - 10/2011	4
11/2011 - 10/2012	7
11/2012 - 10/2013	18
11/2013 - 04/2014	7
total	36

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## Statistics on Patent Cases in IP Court

© Statistics on the patent civil litigation case decisions from the second instance IP Court

	2012	2013	2014
Appeals withdrawn	11	11	6
<b>Appeals dismissed</b>	<b>49</b>	<b>55</b>	<b>38</b>
Lower court decision vacated (all)	2	10	4
lower court decision partial vacated	18	11	11
Settlement	5	4	5
Other	0	1	1
Total cases	85	92	65
<b>Appeals dismissed rate (%)</b>	<b>57.65</b>	<b>59.78</b>	<b>58.46</b>

The statistics show that during 2012 to 2014, **over 50% of the decisions** from the first instance IP Court **were sustained** by the Second instance IP Court.

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## Statistics on Patent Case in TIPO

© Statistics on Patent Invalidation Cases in TIPO (Taiwan Intellectual Property Office)

	Invalidated	Invalidated in part(*)	Not invalidated	Total cases	<b>invalidation success rate (including Invalidated in part)</b>
2005	172	0	370	542	<b>32%</b>
2006	354	0	504	858	<b>41%</b>
2007	605	0	743	1348	<b>45%</b>
2008	523	0	646	1169	<b>45%</b>
2009	719	0	602	1321	<b>54%</b>
2010	522	0	453	975	<b>54%</b>
2011	480	0	474	954	<b>50%</b>
2012	484	0	448	932	<b>52%</b>
2013	429	113	337	879	<b>62%</b>
2014	365	140	329	834	<b>61%</b>
2015	298	103	255	656	<b>61%</b>

\*Please note that a party was not allowed to challenge and TIPO was **not allowed to invalidate only part of the claims** in a patent **before Jan 1, 2013**.

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*No. of UM applications is about half of patent*

Year	Patent Applications	UM Applications
2011	50,082	25,170
2012	51,189	25,636
2013	49,218	25,025
2014	46,378	23,488
2015	44,415	21,040

*No. of UM applications is about half of patent*

Year	Patent Applications	UM Applications
2011	50,082	25,170
2012	51,189	25,636
2013	49,218	25,025
2014	46,378	23,488
2015	44,415	21,040

## *Court decisions re patent infringement in IP Court in 2015*

1 <sup>st</sup> instance decision on patent infringement	81
Patent	36
Utility model	38
Design	8

Among the 36 Patent cases			
Patent Owner wins	Total damages	Not infringed	Invalidated
4 – 11.1%	NTD 16,200,118	14	17
Among the 38 UM cases:			
Patent Owner wins	Total damages	Not infringed	Invalidated
6 – 15.8%	NTD 2,200,390	12	24
Among the 8 Design cases:			
Patent Owner wins	Total damages	Not infringed	Invalidated
2 – 25%	NTD 657,231	3	3



### *Observations*

- About the same number of UMs and Patents are enforced at the IP Court
- UM owners have a higher winning rate
- Among the losing cases, 47.2% patents and 63.2% UMs were found not valid
- UM applications are less in cost, because no substantial examinations are conducted
- Term of UM protection expires at 11<sup>th</sup> anniversary of filing

### V. A Glance at Patent Prosecution in Taiwan

## Language

- Official language: Traditional Chinese
- Specification in foreign languages may be used to obtain filing date
- Acceptable foreign languages
  - English, German, French, Spanish, Portuguese, Russian, Japanese, Korean, Arabian
- Need to submit Chinese translation within 4 months from filing date
  - Can be extended to 6 months

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## Timing

- Taiwan is NOT a member of PCT, cannot have national entry from a PCT application in Taiwan at the 30<sup>th</sup> month
- However, priority claims from foreign patent applications, including PCT applications, are acceptable within 12 months from the foreign filing date

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## Types of applications

- Invention patent, utility model, and design
- Only formality examination for utility model applications, normally grant within 4-6 months
- Invention patent applications and utility model applications can be filed simultaneously for one invention
  - Utility model will be issued first to obtain early protection
  - Applicants have to select to keep either invention patent or utility model once the invention patent application is allowed.

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## Substantive Examination for Invention Patent Applications

- Can be deferred up to 3 years
- Once an application is finally rejected during the initial examination, the applicant is entitled to file a request for re-examination
  - The application will then be handed to a "different" examiner for further examination

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## Timeline for filing divisional applications

- For applications under initial examination, divisional applications can be filed within 30 days from receiving notice of allowance
- For applications under re-examination, divisional applications have to be filed “before” final decision of the re-examination, no matter the decision is a notice of allowance or a final rejection
  - In other words, applicants are not entitled to file divisional applications after notice of allowance of applications under re-examination

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## Speed up!

- Patent Prosecution Highway (PPH)
  - Between Taiwan and the U.S., Taiwan and Spain, Taiwan and Japan, Taiwan and Korea
  - Only can request before receiving first OA
- Accelerated Examination Program (AEP)
  - Have to meet one of the following 4 conditions
    - corresponding foreign application has been approved by a foreign patent authority under substantive examination
    - The EPO, JPO or USPTO has issued an OA during substantive examination against corresponding foreign application
    - The invention application is essential to commercial exploitation
    - Inventions related to green technologies

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## Training of Patent Attorneys

Mihaela Teodorescu  
Vice-President

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Münich, 12.09.2016

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## Representation before the EPO

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### Article 134 EPC

(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.**

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Münich, 12.09.2016

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## Representation before the EPO

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Article 134 EPC

(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.**

- **First objective: training candidates for passing EQE**

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Münich, 12.09.2016

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## Training candidates for passing EQE

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- Candidates – from 38 countries
  - different starting levels
  - different daily practice and work
  - language problems

**epi** provides:

- **epi** studentship – guidance
- EQE tutorials
- Mock exams
- Specific seminars – such as “Life of a patent”

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Münich, 12.09.2016

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## Continuous professional education

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### Next objective: training European Patent Attorneys

#### >11,000 EP Attorneys

Specific seminars are designed.

EPO is the traditional partner of **epi** in organizing educational events:

- EPC2Day
- Guidelines2Day
- UP/UPC
- Opposition and appeal

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Münich, 12.09.2016

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## Professional Education Committee

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- The Professional Education Committee is the responsible body of the Institute pertaining to qualification as, and continuing education of, professional representatives.
  
- 1 member / country = 38 members

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Münich, 12.09.2016

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## Who does the training: epi Experts

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- **epi** experts are mainly experienced European Patent Attorneys who support and coach EQE candidates. They are also involved in the offer of **epi** for continuing professional education.
- **epi** experts are involved in three types of activities: tutoring, coaching and lecturing.



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**Thank you for your attention.**



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Institut des mandataires agréés près l'Office européen des brevets

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## **The unitary patent**

**The European patent with unitary effect in the  
participating Member States of the European Union**

Presentation for



**中華民國專利師公會**  
Taiwan Patent Attorneys Association

**Munich, 12 September 2016**

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### **A bit of history**



## It started some 70 years ago

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- 1947: Institut International des Brevets (search)
  - 1949: French MP Longchambon
  - 1962: Kurt Haertel
  - 1963: Strasbourg Convention (substantive patent law)
  - **1971**: Patent Cooperation Treaty (PCT)
  - **1973**: European Patent Convention (EPC)
  - **1975**: Community Patent Convention (CPC)
    - Revised 1985 and 1989
    - Language; Special instances at the EPO (revocation); Community Patent Court and Common Appeal Court; ECJ
- 

Meeting with TWPAA, 12.09.2016

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**Where do we stand now?**

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Meeting with TWPAA, 12.09.2016

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## Two regulations issued in 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.
- Council **Regulation** (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements.
- Resulting from enhanced cooperation between **25 EU member states** (i.e. all but ES, IT and HR)
  - With the addition of IT as of 30 September 2015 → **26**

Meeting with TWPAA, 12.09.2016

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## Some explanation (<http://eur-lex.europa.eu>)

- The aims set out in the EU treaties are achieved by several types of legal act:
  - **Regulation**: binding legislative act, which must be applied in its entirety across the EU.
  - Directive: legislative act that sets out a goal that all EU countries must achieve.
- Ordinary legislative procedure: the Commission submits a proposal to the European Parliament (EP) and the Council (of Ministers), who jointly adopt a Regulation
- Special procedure for language arrangements: the Council acts unanimously after consulting the EP.

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### Some explanation (<http://eur-lex.europa.eu>)

- **Enhanced cooperation** is a procedure (designed to overcome paralysis) where EU countries are allowed to establish advanced integration or cooperation in an area within EU structures but without the other EU countries being part of the initiative.
  - Authorisation to proceed with the enhanced cooperation is granted by the Council, on a proposal from the Commission and after obtaining the consent of the European Parliament.

Meeting with TWPAA, 12.09.2016

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### ... a 2013 Agreement (and a third Regulation)

- **Agreement on a Unified Patent Court (UPC)**  
done at Brussels on 19 February 2013
  - Not signed by PL (nor by ES or HR).
  - Protocol on provisional application of the UPC Agreement
- **Regulation (EU) no 542/2014** of the European Parliament and of the Council of 15 May 2014 amending Regulation (EU) No 1215/2012 as regards the rules to be applied with respect to the Unified Patent Court and the Benelux Court of Justice
  - “Brussels Regulation”

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## Unitary? Almost ...

- **Regulation 1257/2012**

**Article 3(2):** *A European patent with unitary effect shall have a unitary character. It shall provide uniform protection and shall have equal effect in all the participating Member States. It may only be limited, transferred or revoked, or lapse, in respect of all the participating Member States. [...]*

- Compulsory licensing remains national. (Whereas 10)
- Prior user rights remain national. (Art.28 UPC Agreement)
- SPC's remain national. [Supplementary Patent Certificates]

Meeting with TWPA, 12.09.2016

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## Today: bundle patent

- European patent application designating 38 States



- Publication of the mention of the grant of the European patent



DE GB FR BE RO etc...

- “The European patent shall, in each of the Contracting States for which it is granted, have the effect of and be subject to the same conditions as a national patent granted by that State, unless this Convention provides otherwise.” (EPC Article 2-European Patent, paragraph 2)

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## Regulation n°1257/2012: option

- European patent application designating 38 States
- ↓
- Publication of the mention of the grant of the European patent
- **Within 1 month**: option to file at the EPO a **request for unitary effect** in the participating member States.
  - One **condition: same set of claims** (Art. 3(1))
- **If NO**, back to the **previous slide**.
- **If YES**, see **next slide**.

Meeting with TWPAA, 12.09.2016

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## Tomorrow: bundle patent !

- European patent application designating 38 States
- ↓
- Publication of the mention of the grant of the EP patent
- **Request** for unitary effect
- **Registration** of the unitary effect
- ↓      ↓   ↓   ↓      ↓   ↓   ↓
- EP patent with unitary effect      ES HR PL etc      NO TR CH/LI etc
- non-participating      outside EU
- (ES, HR) or UPC
- does not (yet) have
- exclusive jurisdiction
- **The “unitary patent” is a European patent!**

Meeting with TWPAA, 12.09.2016

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## Regulation 1257/2012 and the EPC

- **Regulation 1257/2012 Art 1(2)** *This Regulation constitutes a special agreement within the meaning of Article 142 [EPC].*
- **EPC Article 142 - Unitary patents**
- (1) *Any group of Contracting States, which has provided by a special agreement that a European patent granted for those States has a unitary character throughout their territories, [...]*

Meeting with TWPAA, 12.09.2016

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## Regulation 1257/2012 and the EPC

- **EPC Article 143 - Special departments of the [EPO]**
- (1) *The group of Contracting States may give additional tasks to the European Patent Office.*
- **EPC Article 145 - Select committee of the Administrative Council**
- (1) *The group of Contracting States may set up a select committee of the Administrative Council [...].*
  - epi has been granted observer status at the SC meetings.

Meeting with TWPAA, 12.09.2016

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## Tasks entrusted to the EPO

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- Administration of requests for unitary effect
- Registration of unitary effect and of any limitation, licence, transfer, revocation or lapse of unitary patents
- Collection and distribution of renewal fees
- Publication of translations for information purposes during the transitional period
- Administration of a compensation scheme for the reimbursement of translation costs
  - For SME's, natural persons, non-profit organisations, universities or public research organisations in the EU
- Appeals from decisions: **UPC** exclusive competence!

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Meeting with TWPAA, 12.09.2016

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## Implementing Regulations at the EPO

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- Decision of the Select Committee of **15 December 2015** adopting:
  - 1. Rules relating to Unitary Patent Protection (RUPP)
  - 2. Rules relating to Fees for Unitary Patent Protection (RFeesUPP)
  - 3. Budgetary and Financial Rules (BFR)and
  - 4. Rules relating to the Distribution of Fees amongst the participating Member States (RDF)

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Meeting with TWPAA, 12.09.2016

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## How is the unitary effect achieved? Regulation 1257/2012

- **Article 2 (a)** *'Participating Member State' means a Member State which participates in enhanced cooperation [...] at the time the request for unitary effect [...] is made;*
- **Article 3 - European patent with unitary effect**
- 1. A European patent *granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection.*
- All the participating member states must be designated in the granted European patent. MT: 01.03.2007.

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## How is the unitary effect achieved?

- Request of the proprietor at the European Patent Office (Rule 5(1) RUPP), no later than one month after publication of the mention of grant of the European patent in the European Patent Bulletin (Rule 6(1) RUPP)
  - If the European patent was not patent granted with the **same set of claims** in respect of all the participating Member States, or if the request for unitary effect was not filed within the **one-month** period, the EPO will reject the request (Rule 7(2) RUPP)
- There is **no fee** to be paid for requesting unitary effect.

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## How is the unitary effect achieved?

- Request to be filed in writing in the language of the proceedings; it should contain:
  - (a) particulars of the requester;
  - (b) the number of the European patent;
  - (c) particulars of the representative, if appointed;
  - (d) during a transitional period, one translation.
- If the request fails to comply with these requirements, the EPO will invite the requester to **correct** the deficiencies within a non-extendable period of **one month**. If the deficiencies are not corrected in due time, the European Patent Office shall reject the request.

Meeting with TWPA, 12.09.2016

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## Transitional measure

- One full (human) translation to accompany the request;
- No legal effect, for information purposes only (in the file);
- **During 6-12 years**, until high quality machine translations are available into **all** the official languages of the Union;
- **English** translation if the EP patent is not in English;
- Else translation in **any** official language of the EU.
  - Thus, it is possible to use a translation prepared to validate in a non-participating member state (such as ES, HR) or in a participating member state where the unitary patent system is not yet in force.

Meeting with TWPA, 12.09.2016

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## Representation

- Rule 20 RUPP provides that Articles 133 and 134(1)(5)(8) EPC and Rules 151 to 153 EPC shall apply *mutatis mutandis*, and clarifies that the term “Contracting States” is to be understood as meaning the Contracting States to the EPC.
- Accordingly, all provisions relating to mandatory representation apply equally to proceedings entrusted to the EPO under the Regulations.  
Also, all European Patent Attorneys (**epi** members) can act, irrespective of their nationality or place of business.

Meeting with TWPAA, 12.09.2016

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## How is the unitary effect achieved?

- **Multiple proprietors** (in respect of the same or different participating member states)
  - Explanatory note 6 to Rule 5 RUPP
  - Unitary effect can also be requested as long as the European patent has been granted with the same set of claims in respect of all the participating member states.
  - Procedurally, the request will then have to be filed via the common representative as defined in Rule 151 EPC (which applies *mutatis mutandis*).
    - **Responsibility of the common representative!**

Meeting with TWPAA, 12.09.2016

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## How is the unitary effect achieved?

- If all requirements are met, the EPO will register the unitary effect in a Register for unitary patent protection and communicate the date of this registration to the requester.
- **Regulation 1257/2012 - Article 18 - Entry into force [...]**
- *2. [...] a European patent for which unitary effect is registered in the Register for unitary patent protection shall have **unitary effect only in those participating Member States in which the [UPC] has exclusive jurisdiction with regard to European patents with unitary effect at the date of registration.***

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## Geographical extent of the unitary effect Regulation 1257/2012

- Art. 2(a) defines “participating MS” at the time the **request** for unitary effect is made.
- Art. 3(1): **condition** for registration of the unitary effect = European patent **granted** with same set of claims in **all participating MS**
- Art. 18(2): **geographical extent** = those participating MS in which the UPC has exclusive jurisdiction with regard to EP patents with unitary effect at the **date of registration**
- Art. 4(1): **date of effect** of the unitary effect = date of publication of the mention of the **grant** of the European patent in the European Patent Bulletin

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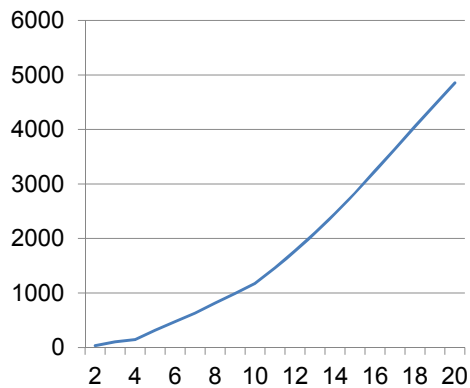
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## Rules relating to Fees for Unitary Patent Protection (RFeesUPP)

- **Article 2 - Fees**
- (1) 1. Renewal fees: →
  - from 35 to 4855 EUR
  - [DE+GB+FR+NL]
  - “TOP 4”
- 2. Surcharge: 50%
- **Article 3 – Reduction**
- 15% for licences of right

Patent year (EUR)



Meeting with TWPAA, 12.09.2016

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## No double protection EP with/without unitary effect

- **Regulation 1257/2012**
- **Article 4 - Date of effect**
- 2. *The participating Member States shall take the necessary measures to ensure that, where the unitary effect of a European patent has been registered and extends to their territory, that European patent is deemed not to have taken effect as a national patent in their territory on the date of publication of the mention of the grant in the European Patent Bulletin.*
- Double protection with **national** titles allowed in **some** countries.

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## Rights and limitations

- **Regulation 1257/2012 Art 5(3)** *The acts against which the patent provides protection referred to in paragraph 1 and the applicable limitations shall be those defined by the law applied to European patents with unitary effect in the participating Member State whose **national law** is applicable to the European patent with unitary effect as an object of property in accordance with Article 7.*
- Through the ratification of the UPC Agreement, the rights will be the **same** in all relevant national laws (the purpose was to exclude referrals to the CJ EU).

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## Rights and limitations

- **In the UPC Agreement**
  - Art 25 - Right to prevent the direct use of the invention
  - Art 26 - Right to prevent the indirect use of the invention
  - Art 27 - Limitations of the effects of a patent
  - Art 28 - Right based on prior use of the invention
  - Art 29 - Exhaustion of the rights conferred by a European patent
- Some participating MS are reviewing the rights and limitations applying to national patents and to European patents without unitary effect.

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## Has the goal been reached?

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## Had the goal been reached?

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### **Nearly.** Main hurdles:

- Setting up the UPC (Preparatory Committee):
  - The Preparatory Committee plans finishing mid-2016.
  - The UPC would be operational **early 2017**.
- Ratification of UPC (Parliaments)  
<http://www.consilium.europa.eu/en/documents-publications/agreements-conventions/agreement/?aid=2013001>
- Amendment of national laws (Parliaments)

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## Entry into force

- All other conditions having been met, the unitary patent system will enter into force on the first day of the fourth month after the deposit of the thirteenth instrument of ratification of the UPC Agreement, provided that these include the three Member States [of the EU] in which the highest number of European patents had effect in 2012
  - DE, FR and GB
  - <http://www.consilium.europa.eu/en/documents-publications/agreements-conventions/agreement/?aid=2013001>

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## Communication from the Chairmen [1 July] (Preparatory Committee and Select Committee)

- The work of the Preparatory Committee and the Select Committee is far advanced and expected to be completed before the end of the year. [...]
- At this stage it is too early to assess what the impact of this vote on the Unified Patent Court and the Unitary Patent Protection eventually could be.
- This will largely depend on political decisions to be taken in the course of the next months. [...]
- Pending more clarity [...] the chairmen [...] are of the opinion that the work dedicated to the technical implementation should continue to progress as envisaged [...].

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## IP and BREXIT: The facts [by the British IPO]

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- The referendum result has no impact on UK businesses' ability to apply to the European Patent Office for patent protection.
  - It will remain possible to obtain patents from the EPO which apply in the UK. Existing European patents covering the UK are also unaffected. British exit from the EU will not affect the current European patent system as governed by the European Patent Convention (EPC).
  - The UK remains a Contracting Member State of the Unified Patent Court at present. We will continue to attend and participate in UPC meetings in that capacity. There will be no immediate changes.
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## A few words about the UPC and the unitary patent

[www.unified-patent-court.org](http://www.unified-patent-court.org)

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## Jurisdiction of UPC (Art. 32 UPCA)

- The UPC Agreement always applies to European patents with unitary effect, but also, without prejudice to Article 83, to European patents [without unitary effect] and to European patent applications (Article 3 UPC).
  - Never for national patents
- Article 83 defines a transitional regime of 7 to 14 years during it is possible to **opt out from the exclusive competence of the UPC** (and to withdraw the opt-out)
  - Opt-out not possible when an action is pending before UPC, e.g. revocation action

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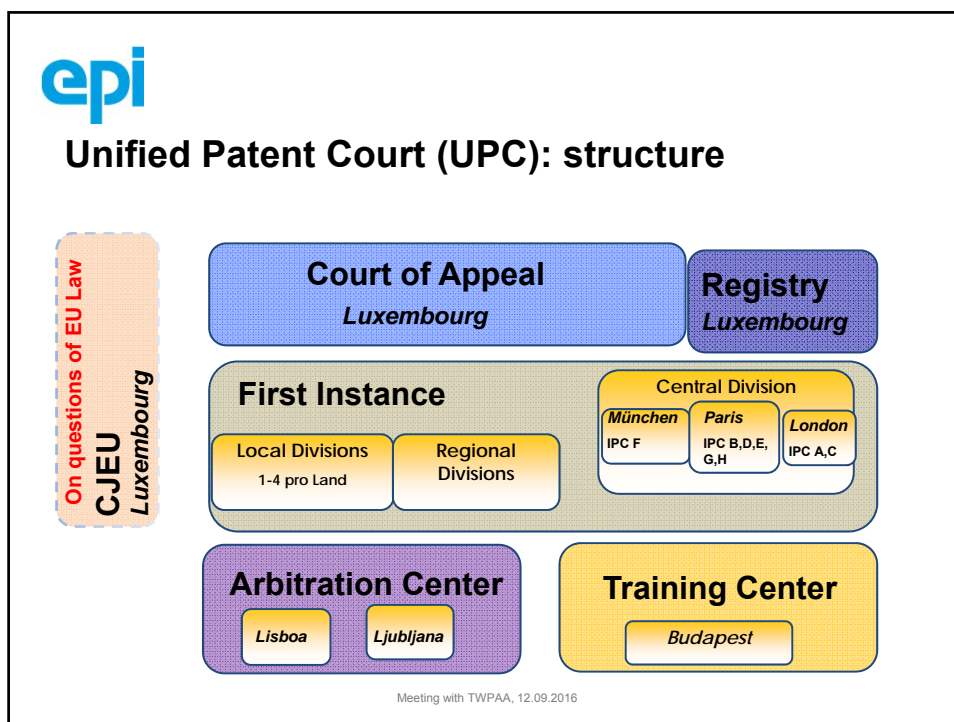


## Jurisdiction of UPC (Art. 32 UPCA)

- Infringement and revocation actions, including provisional measures
- Appeals from EPO when performing special function for Unitary patents (see Art. 9 of Unitary Pat Reg and Art. 143 EPC)
  - NOT for EPO-decisions **before** grant
- Actions for damages/compensation for pending EP-applications
- Licenses of Rights for Unitary Patents
- Prior user rights
- No jurisdiction on entitlement or compulsory licences

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**eipi** **Some points about the UPC**

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- Legally qualified judges
- Technically qualified judges (in most situations)
- Panels include at least 2 nationalities
- Language:
  - Language of the patent (English, German, French)
  - Language accepted by Local/Regional Division
- Procedural law: only UPC Rules of Procedure
  - 18<sup>th</sup> draft Rules of Procedure
- Court fees and recoverable costs:
  - Value-based system (as in DE)

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Meeting with TWPAA, 12.09.2016 38



## Some points about the UPC

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- Representation:
  - Lawyers of participating MS may represent or European Patent Attorneys with a special additional qualification
  - All Patent Attorneys can assist main representative and have the right to be heard at Court Hearings
  - Strong Attorney-Client Privilege (R. 287 of 18th draft)
    - Covering also work products drafted by patent attorneys with foreign qualifications



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**Thank you for your attention.**

**epi** may be contacted by email to [info@patentepi.com](mailto:info@patentepi.com)

The European Patent Practice Committee may be contacted by email to [eppc@patentepi.com](mailto:eppc@patentepi.com)



Institut der beim Europäischen Patentamt zugelassenen Vertreter  
Institute of Professional Representatives before the European Patent Office  
Institut des mandataires agréés près l'Office européen des brevets

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## IP Prosecution in Europe – Strategic choices

Tony Tangena

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### Agenda: IP prosecution: Strategic choices

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- Future EU system
    - System with national, EU and EPC patent rights
    - Unitary patent
    - Unified patent Court
  - Considerations for strategic choices
    - Creating value
    - External considerations
    - Internal considerations
  - Summary
-



## Future European system

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1. **National patents** granted by NPO and enforced in national courts
2. **European patents** (EP), granted by EPO and enforced in the UPC system
3. **European patents** (EP), granted by EPO but **opted out of UPC** system and enforced in national courts as bundle of patents (during the transitional period)
4. **Unitary patents** (UP), registered by EPO and enforced in the UPC system.
5. **Utility models** granted by NPO and enforced in national courts

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Future EP system

3



## Unitary Patent: benefits

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- Administrative **simplification** of patenting in Europe
- Potential for **saving costs**, including validation, translation, post-grant administration costs and agent costs
- **Geographic extension** of patent protection: ease of enforcement: border detentions
- **More value** for licensing/sale

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Future EP system

4



## Unitary Patent concerns

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- Effect of Brexit
- Level of **renewal fees**
  - Not possible to reduce costs by dropping countries
- **Centralized revocation**
- **Not all issues resolved** yet: SPCs, prior rights
- More use by **firms from outside EU?**
- **Costs of litigation** before the Unified Patent Court ?

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Future EP system

5



## Unified Patent Court benefits

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- UPC creates one **single specialized patent court:**
  - Avoiding multiple patent litigation in different jurisdictions (but now 80% in DE!)
  - Highly qualified judges
  - One set of rules of procedure
  - Harmonized and consistent jurisprudence
  - Quick and (cost?) effective
  - Patent attorneys may represent

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Future EP system

6





## Unified Patent Court concerns

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- Effect of Brexit
- Uncertainty **future functioning of UPC**:
  - More like the current national courts in Germany or more like the UK?
  - Different flavours of national or regional courts?
- UPC provide means for Non-Practising Entities known as **“trolls”** to extend their activities to Europe.

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Future EP systems

7



## Considerations for strategic choices

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- What **value** are you going to create with IPR **in that country/region**?
- Every country **costs** money
  - IP Office: filing, prosecution, maintenance
  - IP Agent
- Look at **balance value versus costs** created in country
- Look ahead 5-10 years from now






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Considerations

8

**epi** Strategy: How to create value with IP?

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<b>Exclusivity</b>	Create exclusivity	
<b>Exchange</b>	Cross-license	
<b>Licensing</b>	Pro-active license out	
<b>Asset</b>	IP as payment in M&A	
<b>Insurance</b>	IP to defend against claims	

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Value creation 9

**epi** Strategic choices: external considerations

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- **Markets** for products
  - EU (DE, FR, UK), US, CN, JP, KR
  - Development market in time: present value
- **Competitor presence** (for licensing or defense / counterattack)
- **Production countries**: DE, FR, US, CN, JP, KR, TH
- **Import / export facilities**: border detentions (NL, BE, DE)
- **Speed** of grant Patent: EU (EPO PACE), US
- **Good litigation system** or representative for region: UPC, DE

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Considerations 10



## Strategic choices: internal considerations

- Your (client's) **ambition**
- **Strength / broadness of patent** (use search / preliminary opinion)
- **Look at total portfolio**, consider not just one patent: checker board approach with larger portfolios
- **Costs** of portfolio

Considerations

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## Strategic choices: internal considerations

- **Flexibility needed**, i.e. possibility to keep options open and adapt countries/regions, depends on:
  - Exclusivity: internal focus. More certainty in choices
  - Licensing: external focus. Creating options/alternatives. Less control thus more flexibility needed.
  - Defensive. External focus. Block competitors. Less control thus more flexibility needed.
- The **later the choice the more certainty**
- Flexibility can be created by **choice of procedure**
  - PCT: national phase and major costs after 30/31 months
  - UP: all eggs in one basket
  - EP or National Patent: maintain or abandon per country
  - PPH, PACE

Considerations

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## Summary

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- Creating patent portfolio in Europe complex because of patent rights at the national, EU and EPC level with different ways of enforcement.
  - Decision in what countries/regions to file for patents depends on **value vs. costs**:
    - Value creation model
    - Value depends on external factors like market size, competitor presence, ease of enforcement and internal factors like strength IP, portfolio and ambition
    - Flexibility needed: later choice means more control
- 

Summary

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**Thank you**  
**for your attention!**

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