



14 August 2020

European Commission Intellectual Property Action Plan

epi's comments in response to the Commission Roadmap ("the Roadmap")

The Institute of Professional Representatives before the European Patent Office (**epi**) is the professional body representing all European Patent Attorneys. Currently the Institute has about 12,600 European Patent Attorneys as members coming from each of the 38 Contracting States of the European Patent Convention who work either in industry or in private practice. European Patent Attorneys help their clients and employers, which include international big corporations, SMEs and private inventors, to create value from their inventive ideas, thus providing jobs and strengthening the local economy.

epi as an organisation deals primarily with the development and implications of patent law. **epi** is at the forefront of patent law developments and regularly serves public policy leaders by issuing legal opinions and highly specialised advice.

Opening remarks

epi welcomes the initiative to upgrade the IP system, promote its smarter use, ensure better enforcement as well as promote fair play globally for IP and thanks the Commission for the work it has carried out to prepare the Roadmap. **epi** appreciates the user involvement at this early stage and is willing to cooperate in the future on more detailed proposals.

epi considers that the Roadmap is a good starting point for further action. Regrettably, the short notice given for considering this matter has made proper internal coordination and comprehensive analyses difficult. As **epi** is very interested in the questions set out in the Roadmap, it nevertheless wishes to submit the following observations:

Unitary Patent Package (UPP): Unitary Patent Protection & Unified Patent Court

It is desirable that the Commission's IP Action Plan sets priorities and, in this regard, **epi** considers that resolving the uncertainties associated with the UPP should be a priority.

Over the last 10 years, **epi** has closely followed and frequently commented on the project to harmonise and considerably increase the efficiency of the patent system in Europe via the introduction of a Unitary Patent (UP) and a Unified Patent Court (UPC). Such a system would clearly increase the attractiveness and competitiveness of Europe for innovations. **epi** would welcome the opportunity to work with the Commission and all involved institutions to make the new UP/UPC system become a useful and legally sound instrument for European economies, ensuring that its benefits are enjoyed by both big corporations and SMEs.

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From our perspective, in the current situation it is of utmost importance for all stakeholders of the patent system in Europe to trust in the new system. Thus, **epi** asks the EU Council to find a constructive solution for allowing the UP/UPC system to come into force without undue delay. The solution should address and minimize future legal uncertainties such as potential losses of rights.

An open issue with regard to the UP/UPC system is the different interpretation of Art 63(1) EPC among the EPC Contracting States according to which, in some countries, the patent expires on the anniversary date and, in others, it expires on the day before or after the anniversary date.¹ It is submitted that a harmonised solution must be found in this regard. This is also relevant with regard to e.g. the term of protection of SPCs.²

Another issue which needs to be clarified is the effect of prior national rights discovered after registration of unitary effect, which may result in the loss of the entire European patent with unitary effect. A classical European patent would have remained valid in all the Member States in which it was validated apart from the one in which the prior national right exists. It seems unjust to deprive the patent proprietor of his patent rights just because a prior national right discovered late means that one of the conditions for obtaining unitary effect (same set of claims for all States) would no longer be fulfilled. **epi** therefore invites the Commission to clarify the effect of prior national rights in this context and to find a legal basis which would solve this problematic situation before the UPC comes into force.

Consider ways to make the SPC system less fragmented

epi supports the introduction of a unitary and practicable SPC system provided that there is a unitary patent and both have the same geographical scope. **epi** would support a convergence program in the field of SPCs where the EPO is mandated to grant such unitary SPCs relying on divisions composed of examiners seconded by national offices and applying unified rules of examination, independent from those existing at a national level.

epi encourages the Commission to continue looking into the need to introduce SPC protection in sectors other than pharmaceuticals and agrochemicals.

Promote better licensing and sharing of IP-protected assets

epi subscribes to the importance of efficient licensing of intellectual property rights for achieving broad and rapid diffusion of innovation and fully supports the objective of promoting better licensing and sharing of IP-protected assets.

¹ See **epi** Note on the patent term for European patents: [epi Note on the patent term for European patents](#)

² See para. 20.2.10 and 20.2.11 Study on the Legal Aspects of Supplementary Protection Certificates in the EU, Max Planck Institute for Innovation and Competition: <https://ec.europa.eu/docsroom/documents/29524>



Costs of the patent system

epi notes that the high costs associated with patent protection particularly impact SMEs and would agree with a solution aimed at making it easier to obtain patent protection in Europe, particularly for European SMEs.

The EU IPR Enforcement Directive

epi considers that the IP Rights Enforcement Directive fulfils its goals. Nevertheless, **epi** considers that one point could be improved concerning access and preservation of evidence in the digital environment.

The increasing number of patent infringements occurring in the digital environment via websites, social media (such as Facebook pages for commercial purposes), app stores, etc. require quick and efficient means for preserving digital evidence that may easily be deleted from publicly-accessible webpages or other sources. In that regard, the IP Rights Enforcement Directive seems to be designed more with a view to the seizure of physical proof (samples of products, materials, production machines, etc.) than to the preservation of digital evidence (such as data stored on servers, old or deleted versions of web pages, etc.).