

Board Resolution 01/2017

Interpretation of Art. 83 UPCA

FEMIFI as the umbrella organization of the professional organizations of patent attorneys and patent agents in European industry is looking forward to the coming into force of the UPC Agreement (UPCA) and the Unitary Patent Regulation. FEMIFI expects a strengthening of the patent protection and innovation in Europe by unified patent protection, case law and proceedings.

In order to achieve these goals, one important element is legal certainty and predictability that can only be achieved inter alia by a clear regulation of the competence of courts. Competence of courts in the transitional period is governed by Art. 83 UPCA. Unfortunately, the wording of Art. 83 UPCA is not completely clear and in the literature different interpretations are offered. Not all of them – while being maybe legitimate interpretations – are able to guarantee the legal certainty and predictability that industry is looking for. Rather, they open up the possibility for forum shopping and co-pendency of cases before national courts and the UPC.

In the context of Art. 83 UPCA, the following questions are not clear and should be clarified at the earliest opportunity:

- Duration of opt-out from the exclusive jurisdiction of the UPC: Is it for the transitional period only or for whole life time of opted-out patent?
- Consequence of opt-out or filing an action before the UPC or a national court and remaining competence of UPC after opt-out
- Application of UPCA and rules for national courts
- National courts according to Art. 83(1) UPCA only for infringement or revocation?

1. Duration of opt-out from the exclusive jurisdiction of the UPC

Although there are good opinions, that the opt-out effect should only last for the transitional period of seven years, the majority of the commentators think that the effect of the opt-out should last for the entire life time of the opted-out European Patent. For reasons of legal certainty and predictability, FEMIFI supports this view.

2. **Consequence of opting-out or filing an action before the UPC or a national court**

Art. 83(1) and (3) UPCA can be read in a way that if a European Patent has not been opted-out, national litigation remains possible in transitional period. This appears to be logical because the effect of the opting-out only takes away the exclusive competence of the UPC. This interpretation is no longer disputed by the majority of the opinions and commentators.

Art. 83 UPCA is, however, silent about the question whether joint competence of national courts and the UPC should be possible even if a European Patent has been opted-out or an action has been filed before the UPC or a national court for a European Patent. For the sake of legal certainty and predictability, FEMIPi is in favor of a clear-cut competence regulation as outlined below.

3. **Application of UPCA and rules for national courts**

Since the transitional period should only maintain the situation before the UPCA came into force and not create any new situation, it also becomes clear that the UPC Agreement and its rules should not become applicable for national courts. This has been confirmed by the preparatory committee and is supported by FEMIPi.¹

4. **National courts according to Art. 83(1) UPCA only for infringement or revocation?**

In Art. 83(1) UPCA only two types of actions are mentioned: (i) action for infringement, and (ii) action for revocation. This might be a shortcut of all possible actions according to Art. 32(1) UPCA which is the view of the majority of the commentators. The interpretation of this norm is essential in view of possible concurrent jurisdictions. FEMIPi is in favor of the majority's interpretation for a clear-cut competence regulation.

In view of the above FEMIPi is in favor of a clear-cut competence regulation and supports the following regulation:

- a. If a European Patent has been opted-out, the UPC should not get any competence whatsoever. National rules have to be applied by the national courts. This corresponds to the current situation today where European Patents have to be litigated nationally and it seems to be logical that a transitional period should only maintain this status and not introduce any other possibilities.
- b. In the same way, if an action has been filed before the UPC for a non opted-out European Patent, national courts should lose their competence entirely.

¹ <https://www.unified-patent-court.org/news/interpretative-note-%E2%80%93-consequences-application-article-83-upca>

- c. On the other hand, if an action has been filed before a national court for a non opted-out European Patent, the competence of the UPC should cease entirely. In other words, filing an action before a national court should have the same effect as opting-out.

The above interpretations might be regarded slightly black and white. However, for patent attorneys and agents representing a major part of the European industry, legal certainty and predictability are very important. This can only be achieved by clear-cut regulations and interpretations which do not allow all options that are theoretically possible. We therefore invite the competent future judges and bodies to clarify these questions at the earliest possible opportunity.

28.8.17/BW