

Patenttiuudistus etenee – onko yrityksesi  
valmis? Patenttiseminaarin 2. osa

# Sopimukset ja riidat uuteen kuosiin?

Elinkeinoelämän keskusliitto EK  
8.3.2016

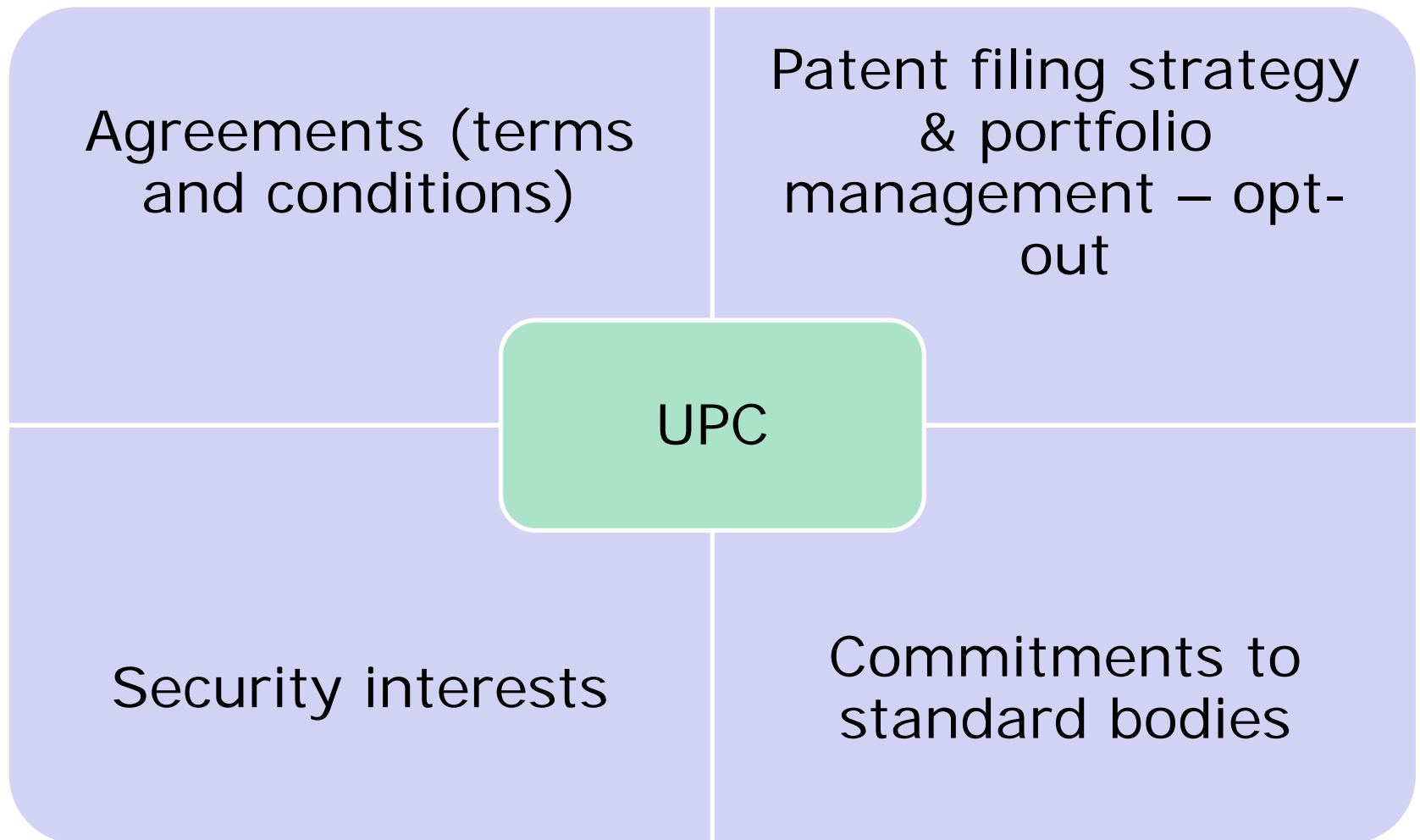
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Glykos Finland Oy

Very few European patents are ever litigated so you may think that UPC does not affect your business!

**WRONG!**

**UPC has an impact on your business if you are in patent business (generate new IP, license patents and/or make agreements on patents)**

## Impact of UPC



# Opting-out

<https://secure.unified-patent-court.org/login>

upc Version 3; Date: 2 x Patent Opt-out - UPC Case x

<https://secure.unified-patent-court.org/patent-opt-out>

unified patent court Case Management System EN JUKKA HILTUNEN  
UPC EXTERNAL

Who are **entitled** to be recorded as proprietor(s)

Details required by Rule 5.3

Proprietors/Applicants pursuant to Rule 8.5.

SPCs

Holders of any granted SPC, if different from the proprietors listed above

Opt-out Applicant Data

Data available in precompiled fields is retrieved from user profile

Applicant is a company/firm? \* Yes

Individual is a representative before the UPC \* No

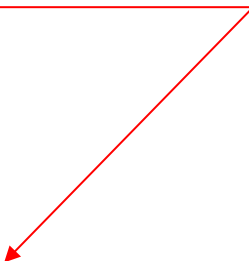
Company/Firm name \* Glykos Finland Oy

Contact e-mail \* jukka.hiltunen@glykos.fi

## Declarations and Conditions\*

- ☐ The Applicant for opt-out hereby declares that the details provided above are correct and acknowledges that if any such details are missing or incorrect, the opt-out shall be ineffective until such details are added or corrected.

Opt-out only  
effective if details  
are correct



If you think of opting-out granted EP patent(s) [and SPCs], start gathering information on "true" owners, their addresses and their permissions to opt-out  
**NOW!**

*Article 7***Treating a European patent with unitary effect as a national patent**

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**:

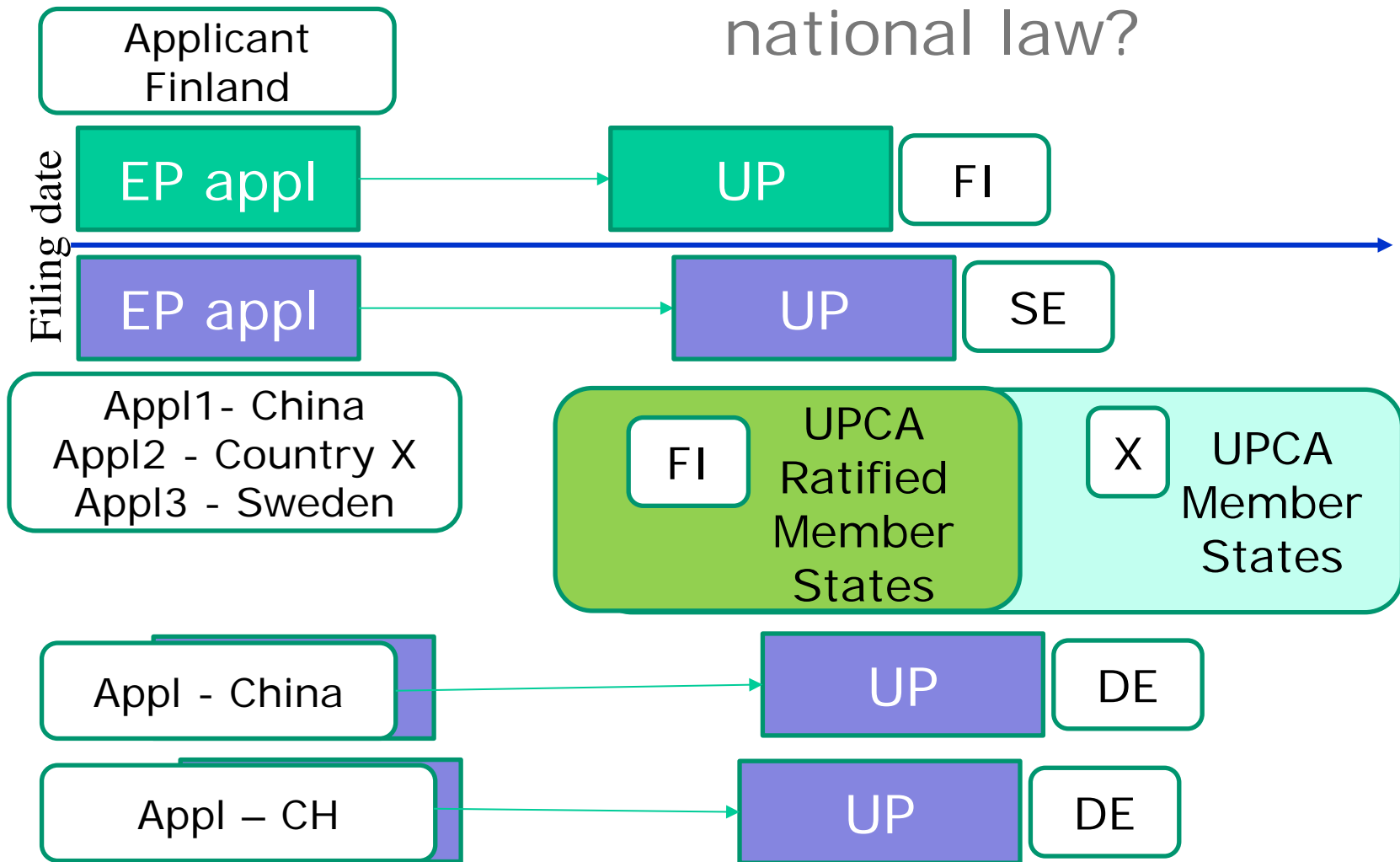
- (a) the applicant had his residence or principal place of business **on the date of filing of the application for the European patent**; or
- (b) where point (a) does not apply, the applicant had a place of business on the date of filing of the application for the European patent.

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.

# UP as object of property - Which national law?



- a UP can only be transferred as a whole, but licensed separately in different countries
- A onetime effect (does not change during the life of the patent) → you need to check the origination of the UP when assigning or licensing it

**If you are a joint owner of a UP patent\*, be sure to have a contract which includes provisions for assigning rights, use of invention, granting licenses and suing for infringement.**

**If you do not have a specific contract with your co-patentee(s), things can get very complicated because national laws are different.**

**\*or traditional EP bundle patent**



## REVIEW AND INCORPORATE INTO NEW AGREEMENTS PROVISIONS FOR:

- RISKS AND BENEFITS OF UNITARY INVALIDATION and MANAGEMENT AND CONTROL OF DISPUTES – PATENT OWNER TO RETAIN AS MUCH CONTROL AS POSSIBLE?
  - The Patent Mediation and Arbitration Centre
- FILING STRATEGY
  - **Unitary Patents**, European patents, national patents and utility models in various combinations
  - Filing, prosecution, maintenance, enforcement, defense
- LICENSING STRATEGY
  - UP vs traditional EP, progress in UPCA ratification, terms for non-exclusive and exclusive licensees; commencement of proceedings
- OPT-OUT – who decides, obligations of joint owners and SPC holders
- UP as OBJECT OF PROPERTY
  - Which national law applies
  - Agreement on joint ownership, who listed as the first applicant at the EPO
  - Collaborative projects and resulting parties to the agreements (universities, non-EU companies, ...)

## OLD AGREEMENTS

### REVIEW TERMS and CONDITIONS - WHAT CAN BE DONE

- OPT-OUT
  - Think a non opted out European patent bundle as a single asset (it has unitary effect)
  - Decision to opt-out (RISK of/to i) single proceeding enforcement vs revocation, ii) license income, iii) other licensees)
- RISKS OF UNITARY INVALIDATION and MANAGEMENT AND CONTROL OF DISPUTES
  - Can an exclusive licensee commence proceedings
  - If several licensees exist, their change of invalidating the patent

# References

- <http://www.managingip.com/Article/3418994/The-Unitary-Patent-for-non-litigators.html>
- Co-ownership of Patents across Europe, Diana D'Arcy and Malcolm Lawrence, IP Europe Quarterly, September 2012
- <http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0001:0008:en:PDF>

**KNOW THY AGREEMENTS AND BE  
PREPARED FOR THE UPC!**

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