Patenttiuudistus etenee – onko yritykvesi valmis? Patenttiseminaarin 2. osa

Sopimuukset ja riidat uuteen kuosiin?

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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

- Agreements (terms and conditions)
- Security interests
- Patent filing strategy & portfolio management – opt-out
- Commitments to standard bodies
Who are *entitled* to be recorded as proprietor(s)
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.

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
WHAT TO DO

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


- Co-ownership of Patents across Europe, Diana D’Arcy and Malcolm Lawrence, IP Europe Quarterly, September 2012

KNOW THY AGREEMENTS AND BE PREPARED FOR THE UPC!
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