

EIP

UPCA - Harmonisation of Infringement

Over a decade ago, in **2013**, when I was writing for the IPKat, I wrote a post opining that the UPC Agreement should produce a harmonisation of the substantive law of patent infringement across Europe[1], on the basis that, ostensibly:

1) Articles 25-28 of the UPCA define a law of infringement that applies to “patents”, defined in Art 2 as meaning both Unitary Patents and classical European patents, and this definition is not limited to when the matter is being litigated at the Unified Patent Court

2) Art 2 EPC says “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”, while Article 64 provides that a 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”. Thus, a European patent is to have identical effect to a national patent, and so conversely a national patent cannot have a different effect from a European patent.

Taking these provisions together, it can be argued as a matter of logic that there should be no difference in the law of infringement between a national patent, a classical European Patent, and a Unitary Patent. Being a signatory of both the UPCA and the UPC obliges each contracting member state to ensure that there is not.

Later, in **2014**, the Preparatory Committee of the Unified Patent Court (“PrepComm”) issued an “interpretative note” on whether national law would be superseded by the UPCA, even if a patent were opted out or the case was brought before a national court.[2] Taking a different view, the PrepComm opined that the legislator meant to reach a uniform interpretation of the law by setting up one common court of the contracting member states with a single appeal body rather than through obligatory harmonisation of

national patent law. An application of UPCA substantive law by national courts would bear the risk of diverging interpretation in lack of a possibility to refer interpretative questions to the UPC.

The PrepComm interpretative note has not put an end to the discussion at all. Firstly, it has no binding effect on the national courts, or indeed on the UPC. Secondly, the legal profession^[3], amongst this - to name a prominent example - Tilmann,^[4] have opined in favour of a broad degree of harmonisation not only superseding the provisions on the exclusionary effect (Art 25-28 of the UPCA), but also the remedies available to the right holder in case of an infringement, Articles 63, 64, 67, 68 and 72 of the UPCA.

The debate on the UPCA's impact on national patent infringement law did not stop and is still ongoing since – even though ratification took place – provisions diverge.

In **2016**, I wrote a post on the significant divergence of the UPCA and UK patent law despite ratification.^[5] Of course, the specifics of the UK implementation are no longer relevant since the UK is no longer participating. However, a deviation from the UPCA can be observed in all contracting states. Here are two examples from German and French law provided by my colleagues in Germany and France:

The **German** Bolar exemption according to Sec. 11 No. 2b of the German Patent Act is broader than the parallel UPC exemption in two ways: First, it is irrelevant for which territory a marketing authorisation is sought while Art 27(d) of the UPCA is limited to market authorisations sought in relation to EU member states.^[6] Second, the German provision is not limited to a specific type of drug whereas Art 27(d) of the UPCA covers only generics or biosimilars that are subject to these Directives, i.e. do not cover, innovative drugs or new indications.

Further, **French** law on infringement covers export and trans-shipment as infringing acts, Article L. 613-3 of the French Intellectual Property Code, while neither are mentioned in the corresponding Art 25 UPCA. So, both, export and trans-shipment could be acts constituting patent infringement in France, but not if a case is dealt with before the UPC.

Given these two examples it can be noted that:

- 1) There may be cases – such as the German example – where a right holder would want to rely on the substantive provision of the UPC Agreement in national patent infringement proceedings.
- 2) Conversely, there may also be cases – as the French example shows – where it could be favourable for a right holder if the UPC could base its decisions on national law. This

opposite case is basically possible under Art 24 UPCA, “Sources of Law” to the extent its provisions are not already contained in Union law, in the UPCA or in other international agreements. For the French example this means: Under Art 25 UPCA, export and trans-shipment are not mentioned in the list of infringement acts, contrary to French law. Therefore, by application of Art 24 UPCA, the UPC could apply French law to those two acts of infringement, provided that the infringing goods were exported from France to a third (i.e. non-contracting) state or trans-shipped in a French port or airport. It could thus be argued that, at least where the infringing acts relate to the territory of France, Art 24 UPCA can be used as a legal basis to apply French national infringement provisions.

The discrepancy between the UPCA infringement provisions and those of national laws may not make a difference to the outcome in most circumstances, but in a few cases it may really matter. Even if it does not make a practical difference, as a matter of principle the situation is unsatisfactory. 17 contracting member states of the UPCA have had over a decade to sort this out, yet still this issue remains live and is, in fact, more topical than ever. After the UPCA entered into force in June 2023, it is expected that both national courts and the UPC will soon (have to) take a position on this.

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[1] <https://ipkitten.blogspot.com/2013/04/harmonisation-by-back-door-what-will.html>

[2] <https://www.unified-patent-court.org/en/news/interpretative-note-consequences-application-article-83-upca>

[3] See e.g. Nieder, GRUR 2014, 627 et seq. as well as 955 et seq.; Nieder, GRUR 2015, 728, 730 et seq.; Eck, GRUR Int. 2014, 114, 119; Bopp/Kircher/Sonntag, Handbuch Europäischer Patentprozess, 2019, Sec. 13, para. 245 et seq.; discussion in BeckOK PatR/Augenstein, 28. Ed. 15 April 2023, EPGÜ Art. 83 para. 16.

[4] Tilmann, Mitt. 2014, 58, 59 et seq.

[5] <https://ipkitten.blogspot.com/2016/03/the-uk-implements-unitary-patent.html>

[6] By making a reference to Article 13(6) of Directive 2001/82/EC or Article 10(6) of Directive 2001/83/EC.