

EIP

Unitary Patent as an object of property

A registered intellectual property right such as a patent is normally considered a property right of the country in which it has effect. Rules relating to the patent as an object of property, for example what is required to legally assign the right, are governed by each country independently. This system breaks down however when a right covers multiple countries, such as in the case of the Unitary Patent.

To address this difficulty, the Unitary Patent Regulation specifies that the law of property governing a Unitary Patent shall be that of the residence or principal place of business of the applicant as recorded on the European Patent Register as at the date of filing, if that is in one of the member states of the EU participating in the Unitary Patent system. (In the case of joint applicants, it is the first named applicant that has its residence or principal place of business in a participating EU country). If no applicant has its residence or principal place of business in a participating EU country, then the default law is German law, unless at the time of filing the request for unitary effect an address within a participating EU country is given as a place of business of one of the applicants as at the date of filing of the European patent application. If such a place of business is stated, then the law of that country applies.

Thus, for non-EU applicants, German law will apply unless an assertion is made when requesting the Unitary Patent that the applicant (or in the case of joint applicants, any one applicant) had place of business within a participating EU country, in which case the law of that country will apply.

The assertion to have had a place of business within a participating EU country can only be made when requesting unitary effect, i.e. just after grant of the European patent, but the relevant date to have had such a place of business is the filing date of the application. An EU address cannot be asserted at any other time, and once the assertion is made it

cannot be modified or withdrawn. The governing law will not change if, for example, the patent or application is subsequently assigned to an entity domiciled in a different EU country.

There is no obligation to state such a place of business just because it arguably existed – it is perfectly permissible to state no place of business within a participating EU country and then German law will apply. There is no examination of the veracity of the assertion.

These rules may appear complex but similar provisions have operated in respect of EU Trademarks and Community Registered Designs for many years (except that for those the default law is Spain, because the seat of the EU IPO is Alicante). There is no reason for alarm.

In fact, we consider that German law is a reasonable default for the governing law for a Unitary Patent as an object of property as Germany has well understood laws relating to assignments, licences etc. Therefore, non-EU proprietors should not be concerned about German law applying.

The law specified under these provisions has no relevance to the law of infringement, which will be governed by the provisions of the Unitary Patent Regulation and Unified Patent Court Agreement.