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Double patenting and the unitary patent

Nicoleta Tarchila, Cabinet Enpora, discusses the unitary patent in relation to double patenting, thinking specifically about what this implementation could mean for countries currently excluding the law.

Romania is soon to finalize the process of ratification of The Agreement on the Unified Patent Court (UPCA), as declared by the representatives of the Romanian Ministry of Justice. Meanwhile, on September 14, 2016, Romania has signed the Protocol on the provisional application of the Agreement on the Unified Patent Court which enables the transition into the operational phase and ensures the proper functioning of the UPC before the entry into force of the Agreement. With Romania signing the Protocol, the number of the signatory countries increases currently to 10. This was a good opportunity for the Romanian Patent Office to organize a seminar on the implementation of the European patent with unitary effect in Romania. Discussions on the double patenting were brought in this context with the EPO specialists emphasizing on the need that the member states establish a common practice with respect to this issue. We also spotted a recommendation in favor of adopting a double patenting practice, possibly influenced by the opinions circulated in this direction by UK and Germany. In the verge of the entering into force of the Unitary Patent Package, preconized for the beginning of 2017, discussions were made about the need for a safety measure in view of the unknown procedural issues that the UPC could raise. Obtaining a national patent and a new unitary patent for the same invention will definitely secure patent owners while familiarizing with the new system.

What is the current practice?

Double patenting is not a new issue under the European Patent Convention with Article 139(3) EPC providing that any contracting state may prescribe whether and on what terms an invention disclosed in both a European patent and a national patent having same filing or priority dates may be protected simultaneously by both patents. Only a small number of countries allow double patenting under the EPC, namely Austria, Denmark, Finland, Hungary, Iceland, Norway, Poland and Sweden, while the majority, Romania included, exclude double protection and the national patent ceases to take effect the moment when the opposition deadline for the European patent lapses or opposition proceedings are concluded and the European patent maintained. With UP Regulation 1257/2012 not given concrete provisions about the way of action, questions about double patenting of national patents and European patents with unitary effect were raised and discussions were made about this issue. It seems the current trend is to move towards the direction of allowing double protection. At least so may be concluded from the revealed positions of the two major players UK and Germany. We may presume that since the two major European Patent hubs questioned and tend to tame their position towards this issue most of the member states will follow.

Double patenting – a safety net?

As it is probably expected, implementing a new system with a significant importance for the European common market comes with serious challenges. The double patenting issue is pretty much echoing the worries and fears accompanying the big impact of a single decision of the UPC. Allowing protection of the same invention for the same owner by means of a national patent and a European patent with unitary effect seems to be a solution to be embraced at least during a transitional phase. The EPO Enlarged Board of Appeal stated that the principle of the prohibition on double patenting is based on the

Résumé

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notion that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter if he already possesses one granted patent for that subject-matter. Interpreted in the light of the disadvantages brought by having a unitary patent invalidated in all member states by a single action it seems that the double protection receives such a legitimate interest.

What are the legal provisions?

Regulation (EU) No 1257/2012 implementing enhanced cooperation in the area of the creation of unitary patent protection addresses the matter in Recital 8 providing that Where unitary patent protection takes effect, the participating Member States should ensure that the European patent is deemed not to have taken effect on their territory as a national patent, so as to avoid any duplication of patent protection. The Recital is regulated in Article 4(2) according to which: The participating Member States shall take the necessary measures to ensure that, where the unitary effect of a European patent has been registered and extends to their territory, that European patent is deemed not to have taken effect as a national patent in their territory on the date of publication of the mention of the grant in the European Patent Bulletin. The direction configured by the UP Regulation is clear towards banning double protection of same European Patent as national patent by requiring member states to take necessary measures in this direction. No exact provisions about the double protection between a national patent and a UP were comprised in the Regulation. The matter of coexistence was addressed in Recital 26 of the UP Regulation as follows: Patent applicants should remain free to obtain either a national patent, a European patent with unitary effect, a European patent taking effect in one or more of the Contracting States to the EPC or a European patent with unitary effect validated in addition in one or

“ *The principle of the prohibition on double patenting is based on the notion that an applicant has no legitimate interest in proceedings leading to the grant of a second patent for the same subject-matter.* ”

more other Contracting States to the EPC which are not among the participating Member States. Consequently, the applicant has the alternative to obtain a national patent, a classic European patent or a European patent with unitary effect. However, since the issue was included only in a Recital of the Regulation the binding effect on the member states is contested. The matter is therefore shifted to the member states which are required to provide a position in their national laws relating to the European patent with unitary effect. The simplest solution seems to be for the member states to preserve same practice as before. However, things are not to be kept simple when the unitary patent is involved. Therefore the matter was opened for discussions in two countries where double patenting is prohibited, namely UK and Germany.

Views and opinions on implementation

In 2014 the UKIPO launched a consultation on proposed changes to the UK Patents Act 1977 to introduce the UPC. The issue of double patenting was specifically asked and respondents' views were evenly divided on this subject, as stated in the Technical Review and Call for Evidence Summary of responses. Those in favor of double patenting suggested that this would mean that take-up of Unitary Patents would be higher, it would provide a safety net in case a Unitary Patent will be revoked because of procedural issues or in a third opinion the possibility to hold a national patent in parallel with a Unitary Patent was considered an option of using a national route to litigate which may be cheaper than solely relying on the Unitary Patent and UPC litigation. Those opposed to introducing double patenting for Unitary Patents did so because they considered that allowing double patenting would increase litigation, with multiple actions being taken for the same invention, the risk of double recovery of damages and getting different outcomes in different courts. The position of the UK Government in response to the views expressed during the consultation was against double patenting grounded on the increase costs to businesses as they have to deal with multiple patents for the same invention and possibly face more than one infringement case in relation to the same act.

The position of Germany towards the issue of double patenting could be observed from the current draft legislation to amend the German patent law. The proposal is the amendment of the article which prohibits double patenting in Germany so that it no longer applies to European patents for which the UPC does not have exclusive competence. However, third parties in infringement proceedings are protected from being sued twice based on the European patent and the corresponding German patent as the draft regulation includes the provision that an action filed before a national German court based on a national German patent would become inadmissible if a corresponding action based on a corresponding European patent was filed before the UPC. With such provision, the German position towards double patenting is definitely more relaxed and at the same time the main concern of multiple patent actions was addressed and given a proper solution.

At this point, we are not aware of other member states expressing their point of view about this issue. This seems, however, a matter of direct interest for the contracting countries who are advised to take preferably a unanimous position towards admitting or prohibiting the double protection of national patents and European patents with unitary effect. The German position seems to tick most boxes with a proposed solution to the matter of multiple infringement actions which is the main concern when it comes to double patenting. The matter will be for certain opened for more discussions and we are definitely eager to observe the position to be adopted by the involved member states.