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SUBJECT: Draft Rules relating to Unitary Patent Protection revised version of Rules 1 to 11 of SC/16/13

SUBMITTED BY: President of the European Patent Office

ADDRESSEES: Select Committee of the Administrative Council (for opinion)

SUMMARY

Implementation at the European Patent Office of Regulations (EU) No 1257/2012 and No 1260/2012.

This document follows document SC/16/13 dated 30 August 2013 and takes into account the comments and suggestions made at the 4th meeting of the Select Committee of 18 September 2013. It contains a revised version of Rules 1 to 11, i.e. those provisions which have been subject of discussions at said meeting. The amendments to SC/16/13 are indicated by grey hatching.

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RULES

relating to Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection and to Council Regulation (EU) No 1260/2012 of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements

(hereinafter "Rules relating to Unitary Patent Protection")

PART I **INSTITUTIONAL PROVISIONS**

CHAPTER I **SUBJECT MATTER**

Rule 1 **Subject matter**

- (1) The participating Member States hereby entrust the European Patent Office with the tasks referred to in Article 9, paragraph 1, Regulation (EU) No 1257/2012. In carrying out these tasks, the European Patent Office shall apply the present Rules and shall be bound by decisions handed down by the Unified Patent Court in actions brought under Article 32, paragraph 1(i), Agreement on a Unified Patent Court.

- (2) In case of conflict between the provisions of the present Rules and either Regulation (EU) No 1257/2012 or Regulation (EU) No 1260/2012, the provisions of the Regulations shall prevail.

Rule 1 – Subject matter

1. Article 142(1) EPC stipulates that any group of contracting states may provide by a special agreement that a European patent granted for those states has a unitary character throughout their territories. Article 1 Regulation (EU) No 1257/2012 provides that the regulation constitutes a special agreement within the meaning of Article 142(1) EPC. Furthermore, Article 3(2) Regulation (EU) No 1257/2012 holds that a European patent with unitary effect has a unitary character. Therefore, in accordance with Article 142(2) EPC, the provisions of Part IX EPC, Special Agreements, apply.
2. The group of contracting states within the meaning of Article 142(1) EPC may give the European Patent Office (hereinafter "EPO") additional tasks (see Article 143(1) EPC). Special departments common to the contracting states in the group may be set up within the EPO to carry out these additional tasks (see Article 143(2) EPC). In accordance with these principles, proposed Rule 1(1) defines the subject matter of the present rules, which is to lay down the provisions required to implement the tasks entrusted to the EPO under Regulations (EU) No 1257/2012 and (EU) No 1260/2012. These rules are referred to as the "Rules relating to Unitary Patent Protection", as reflected in the title.
3. Paragraph 1 of Rule 1 holds that the additional tasks as provided for in Regulation (EU) No 1257/2012 are entrusted to the EPO by virtue of the present rules. The EPO, in carrying out these tasks, will be bound by decisions handed down by the Unified Patent Court (UPC) in actions brought under Article 32(1)(i) Agreement on a Unified Patent Court.
4. Proposed Rule 1(2) contains a conflict rule modelled on Article 164(2) EPC. It guarantees that the provisions of Regulations (EU) No 1257/2012 and No 1260/2012 take precedence over the provisions of the present rules. Where an interpretation of the present provisions runs counter to provisions and principles of either of the two regulations, that interpretation cannot be followed and the EPO will have to provide an alternative one that complies with the regulations in order to resolve the conflict.

CHAPTER II SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL

Rule 2 Competences and duties

- (1) The Select Committee of the Administrative Council shall be competent to adopt and amend
 - (a) the present Rules;
 - (b) the Rules relating to Fees;
 - (c) other rules or decisions of a financial or budgetary nature;
 - (d) its Rules of Procedure.
- (2) [The Select Committee shall adopt the budget and any amending or supplementary budget relating to the implementation of Regulations (EU) No 1257/2012 and No 1260/2012.]¹
- (3) The Select Committee shall ensure the governance and supervision of the activities related to the tasks entrusted to the European Patent Office in accordance with Rule 1, paragraph 1.

¹ To be discussed in the context of the financial issues.

Rule 2 – Competences and duties of the Select Committee

1. At their inaugural meeting of 20 March 2013, the participating member states agreed to establish the Select Committee of the Administrative Council of the European Patent Organisation within the meaning of Article 145(1) EPC and in accordance with Article 9(2) Regulation (EU) No 1257/2012.
2. Article 145(2) EPC provides that the powers and functions of the Select Committee of the Administrative Council will be determined by the group of contracting states referred to in Article 142(1) EPC.
3. Pursuant to Article 9(2) Regulation (EU) No 1257/2012, the participating member states will ensure compliance with said regulation in fulfilling their international obligations undertaken in the EPC and will co-operate to that end. Moreover, in their capacity as contracting states to the EPC, the participating member states will ensure the governance and supervision of the activities related to the tasks referred to in Article 9(1) of the regulation and will ensure the setting of the level of renewal fees in accordance with Article 12 of the regulation and the setting of the share of distribution of the renewal fees in accordance with Article 13 of the regulation. To that end they will set up a Select Committee of the Administrative Council of the European Patent Organisation within the meaning of Article 145 EPC.
4. Mirroring the competences of the Administrative Council as provided for in the EPC (see Articles 33(1)(2) and 46 EPC), it is proposed that the Select Committee should be competent to adopt and amend the present rules, the Rules relating to Fees, other rules or decisions of a financial or budgetary nature and its own rules of procedure. The wording used corresponds to the one of Article 9(5) of the Rules of procedure of the Select Committee (see also Article 16 Agreement relating to Community patents of 15 December 1989 (hereinafter "CPC")).

5. [Paragraph 2 provides that the Select Committee as a sub-body of the Administrative Council adopts the budget and any amending or supplementary budget relating to the implementation of Regulations (EU) No 1257/2012 and No 1260/2012.]
6. Paragraph 3 stipulates that the Select Committee will ensure the governance and supervision of the activities related to the tasks entrusted to the EPO, in accordance with Article 9(2) Regulation (EU) No 1257/2012 and Article 145(1) EPC.
7. The membership, chairmanship, voting rights and all other issues related to the procedures and functioning of the Select Committee are laid down in the Rules of Procedure of the Select Committee.

CHAPTER III FUNCTIONS AND POWERS OF THE PRESIDENT OF THE EPO AND SPECIAL DEPARTMENTS OF THE EPO

Rule 3 Functions and powers of the President of the European Patent Office

The Unitary Patent Protection Division referred to in Rule 4 shall be managed by the President of the European Patent Office, who shall be responsible for its activities to the Select Committee of the Administrative Council. To this end, Article 10, paragraphs 2 and 3, EPC shall apply mutatis mutandis

~~The President of the European Patent Office shall have in particular the following functions and powers:~~

- ~~(a) — he may submit to the Select Committee any proposal for amendments to the present Rules referred to in Rule 2, paragraph (1)(a) to (c), the Rules relating to Fees, for general regulations or for decisions which come within the competence of the Select Committee~~
- ~~(b) — [he shall prepare and implement the budget and any amending or supplementary budget relating to the implementation of Regulations (EU) No 1257/2012 and 1260/2012.]²~~
- ~~(2) — Article 10, paragraph 2(a), (b), (e) to (i) and paragraph 3, EPC shall apply mutatis mutandis.~~

Rule 3 – Functions and powers of the President of the European Patent Office

1. Proposed Rule 3 just reiterates and clarifies the President's functions as provided for in the EPC and in the present Rules: it sets out the power to manage, i.e. direct the special department established under Article 143 EPC which is in fact the Unitary Patent Protection Division established under Rule 4(1). This Division, pursuant to Rule 4(2), will be responsible for carrying out the tasks entrusted to the EPO under Rule 1(1).
2. The proposed Rule also reflects the principle set out in Article 145(1) EPC according to which the President of the EPO is responsible for the activities of the Unitary Patent Protection Division to the Select Committee of the Administrative Council (see also Article 10(1) EPC). In accordance with Article 143(2) EPC, and instead of enumerating all the remaining functions and powers set out in Article 10(2) and (3) EPC, it is proposed to state that Article 10(2) and (3) EPC shall apply *mutatis mutandis*, following the constant practice of the European Patent Organisation.
3. As regards the right of initiative, the President of the EPO may in particular submit proposals with respect to the Rules relating to Fees including the level of renewal fees for the European patent with unitary effect. A fundamental principle under the EPC is that the amounts of procedural fees referred to in Article 38 EPC and the proportion of the renewal fees referred to in Article 39 EPC are to be fixed at such a level as to ensure that the revenue in respect thereof is sufficient for the budget of the European Patent Organisation to be balanced (see Article 40(1) EPC).
4. This principle has been reflected in Articles 10 and 12(1)(b) and (c) Regulation (EU) No 1257/2012: Article 12(1)(b) Regulation (EU) No 1257/2012 lays down that the level of renewal fees for European patents with unitary effect shall be sufficient to cover all costs associated with the grant of the European patent and the administration of the unitary patent protection. Article 12(1)(c) Regulation (EU) No 1257/2012 holds that this level of renewal fees shall be sufficient, together with the fees to be paid to the European Patent Organisation during the pre-grant stage, to ensure a balanced budget of the European Patent Organisation.

5. Considering the potential financial impact on the European Patent Organisation, it is of the utmost importance that the President of the EPO be given an adequate role with respect to the question of the level of renewal fees for European patents with unitary effect which will directly and substantially affect the Organisation's budget and sustainable financing.
6. The right of initiative of the President shall however not encompass proposals on the share of distribution of the renewal fees set pursuant to Article 9(2) Regulation (EU) No 1257/2012, unless the participating Member States expressly request such proposals.

Rule 4 Unitary Patent Protection Division

- (1) A Unitary Patent Protection Division is hereby established within the European Patent Office as a special department within the meaning of Article 143, paragraph 2 EPC.
- (2) The tasks entrusted to the European Patent Office in accordance with Rule 1, paragraph 1, shall be carried out under the responsibility of the Unitary Patent Protection Division.
- (3) Decisions of the Unitary Patent Protection Division shall be taken by one legally qualified member.
- (4) The President of the EPO may entrust to employees who are not legally qualified members the execution of duties falling to the Unitary Patent Protection Division, and involving no legal difficulties.

Rule 4 – Unitary Patent Protection Division

1. Under Article 143(1) EPC, the group of Contracting States having availed itself of the authorisation provided for in Article 142(1) EPC, may give additional tasks to the EPO. According to Article 143(2) EPC, special departments common to the group of Contracting States may be set up within the EPO in order to carry out these additional tasks. Moreover, Article 143(2) EPC lays down that the President of the EPO shall direct such special departments and that Article 10(2) and (3) EPC shall apply *mutatis mutandis*. Finally, pursuant to Article 145(1) EPC, the select committee of the Administrative Council supervises the activities of the special departments set up under Article 143(2) EPC.
2. It is proposed to set up such a special department and to name it "Unitary Patent Protection Division". Such a special department will be responsible for the additional tasks referred to in Article 9, paragraph 1, Regulation (EU) No 1257/2012 and entrusted to the EPO under Rule 1(1) by the participating Member States. The departments referred to in Article 15 EPC are not responsible for these additional tasks lying outside the normal EPO grant procedure. Therefore, there is a need to set up a special department. This will clarify that the departments entrusted with the procedures laid down in the EPC, namely the Search, Examining, Opposition and Legal Divisions as well as the Boards of Appeal will not have any responsibility when it comes to the unitary patent. In particular, actions against decisions of the Unitary Patent Protection Division will have to be brought before the Unified Patent Court (see Articles 32(1)(i) and 47(7) UPC Agreement) and not before the EPO Boards of Appeal.
3. Given the predominantly legal nature of the decisions to be taken by the Unitary Patent Protection Division, it is proposed that its decisions be taken by one legally qualified member (see also Article 20(2) EPC). Since pursuant to Article 8(6) UPC Agreement, any panel of the central division dealing with actions under Article 32(1)(i) UPC Agreement shall sit in a composition of (three) legally qualified judges, the first instance, i.e. the Unitary Patent Protection Division should also be composed of a legally qualified member.

4. Paragraph 4 foresees that the President of the EPO may entrust to employees who are not legally qualified members (i.e. formalities officers) the execution of individual duties falling to the Unitary Patent Protection Division, and involving no legal difficulties. Accordingly, certain aspects of the procedures may be delegated to formalities officers under the conditions to be determined by the President of the EPO, e.g. where a request is not disputed or where a task does not involve complex legal questions.
5. No recruitment of additional staff will be required for the Unitary Patent Protection Division. It will in fact be a virtual division in the sense that its staff will be the existing staff of the Legal Division under Article 20 EPC which deals with tasks identical or similar to those for which the Unified Patent Division will be responsible. The department will thus wear two hats and will take decisions either in its capacity as Unified Patent Protection Division or in its capacity as Legal Division. By using the existing infrastructure and expertise, additional costs can be kept low.

PART II **PROCEDURES TO BE CARRIED OUT BY THE EUROPEAN PATENT
OFFICE UNDER REGULATIONS (EU) NO 1257/2012 AND
NO 1260/2012**

CHAPTER I **THE REQUEST FOR UNITARY EFFECT**

Rule 5 **General**

- (1) At the request of the proprietor of the European patent, unitary effect shall be registered by the European Patent Office in the Register for unitary patent protection.

- (2) Unitary effect shall only be registered if the European patent has been granted with the same set of claims in respect of all the participating Member States.

Rule 5 – The request for unitary effect – General

1. Paragraph 1 reflects the fact that procedurally, under Regulation (EU) No 1257/2012, unitary patent protection is obtained by a formal request of the proprietor of the European patent to be filed with the EPO.
2. In the case of a European patent granted to multiple proprietors in respect of different contracting states (see Articles 59 and 118 EPC and Rule 72 EPC), unitary effect can still be requested. Procedurally, the request will have to be filed via the common representative referred to in Rule 151 EPC (see Rule 17(2), which provides that Rule 151 EPC applies *mutatis mutandis*). Where unitary effect is attributed by the EPO to a European patent held by multiple proprietors in respect of different contracting states, those proprietors will become co-owners of the European patent with unitary effect by virtue of the unitary effect provided for by Article 3(2) Regulation (EU) No 1257/2012. It is understood that national law will govern the European patent with unitary effect as an object of property (Article 7 Regulation (EU) No 1257/2012) and will therefore govern the regime applicable to co-owners.
3. Paragraph 2 sets out the "substantive" requirements for obtaining unitary effect. In the light of the consultations and of the discussions on the three different proposed options contained in the former version of this document (SC/16/13), it is proposed to retain option 1 as regards the wording of proposed Rule 5(2) which is considered as the most appropriate in particular as regards conformity with Regulation (EU) No 1257/2012. ~~One option which has resulted from the consultations.~~ Accordingly, it is proposed to stick to the wording of Article 3(1) in conjunction with Recital 7 Regulation (EU) No 1257/2012: unitary effect is registered only where the European patent has been granted with the same set of claims for all the 25 participating Member States, irrespective of whether these States have ratified the UPC Agreement or not at a certain point in time. The territorial scope of a European patent with unitary effect for which unitary effect is already registered in the Register for unitary patent protection would then have to be determined under Article 18(2), second subparagraph, Regulation (EU) No 1257/2012, i.e. by referring to the date of registration. The participating member states in which the European patent with unitary effect has unitary effect will be indicated in the Register for unitary patent protection for information purposes (see Rule 13(1)(g)).

4. Where one of the two joint requirements set out in paragraph 2 (i.e. designation of all the participating Member States in the granted European patent and same set of claims for all these Member States), or even both, is/are not fulfilled, unitary effect cannot be registered by the EPO (see Article 3(1) and Recital 7 Regulation (EU) No 1257/2012). See the explanatory notes below as to the examination procedure of the request for unitary effect.
5. No express authorisation to introduce a specific fee for the request for unitary effect has been included: such a fee would constitute a supplementary formal and financial requirement not provided for by Regulation (EU) No 1257/2012 and could unnecessarily complicate and therefore delay the procedure for requesting unitary effect (it would inevitably lead to instances of non-payment, or partial payment, or late payment, and thereby necessitate remedies, surcharge, sanctions such as the request deemed not to have been filed, etc.) when, in fact, the procedure should be kept as simple and attractive as possible.

Rule 6 Requirements of the request for unitary effect

- (1) The request for unitary effect shall be filed with the European Patent Office no later than one month after publication of the mention of grant of the European patent in the European Patent Bulletin.
- (2) The request for unitary effect shall be filed in writing in the language of the proceedings and shall contain:
 - (a) particulars of the proprietor of the European patent making the request (hereinafter "the requester") as provided for in Rule 41, paragraph 2(c), EPC;(b) the number of the European patent to which unitary effect shall be attributed;
 - (c) where the requester has appointed a representative, particulars as provided for in Rule 41, paragraph 2(d), EPC;
 - (d) a translation of the European patent as required under Article 6, paragraph 1, Regulation (EU) No 1260/2012, as follows:
 - where the language of the proceedings is French or German, a full translation of the specification of the European patent into English; or
 - where the language of the proceedings is English, a full translation of the specification of the European patent into any other official language of the European Union.

Rule 6 – Requirements of the request for unitary effect

1. Rule 6 sets out the formal requirements for obtaining unitary effect, as opposed to the "substantive" requirements set out in Rule 5(2).
2. Paragraph 1 of the proposed rule, in accordance with Article 9(1)(g) Regulation (EU) No 1257/2012, stipulates a time limit of one month after the mention of the grant is published in the European Patent Bulletin for filing the request for unitary effect. Bearing in mind that this period is quite short, the request for unitary effect should in practice preferably be filed by the European patent applicant in reply to the communication under Rule 71(3) EPC or in reaction to the decision to grant (EPO Form 2006).
3. Providing the possibility to file the request in reply to the Rule 71(3) EPC communication or in reaction to the decision to grant (EPO Form 2006) would have the benefit of extending *de facto* the period in which the request may be validly filed. It also has the advantage that it is procedurally easy for the EPO to register unitary effect as soon as possible after grant if all the requirements are met. A preliminary request of this kind would be a purely practical solution and would not blur the distinction between the grant procedure and the post-grant phase for registering unitary effect because it would only become valid after grant of the European patent to which unitary effect is to be attributed.
4. Furthermore, in order to avoid any formal deficiencies, the EPO intends to provide appropriate (electronic) forms for filing the request for unitary effect which will contain checkboxes alerting the patent proprietor to all the relevant formal requirements.
5. Should the patent proprietor omit to file a request for unitary effect, i.e. file no request for unitary effect with the EPO, he may obtain re-establishment of rights in respect of the period specified in Rule 6(1). The request for re-establishment must however be filed within two months of expiry of the aforementioned period, by analogy with the re-establishment of rights for the priority period under Article 87(1) EPC (see Rule 19(2)) and the omitted act, i.e. the filing of the request for unitary effect, must also be completed in this period (Rule 19(3)). For a request for unitary effect filed too late, i.e. after the expiry of the one-month period specified in Rule 6(1), see the explanatory remarks on Rule 7 below.

6. Paragraph 2 specifies the language to be used in accordance with Article 9(1)(g) Regulation (EU) No 1257/2012, namely the language of proceedings, as well as the requirement under the EPC for the written form. Paragraph 2(a) is required so that the EPO can check the requester's identity, i.e. whether he is the patent proprietor. The number of the European patent is required to identify the patent to which unitary effect will be attributed. Paragraph 2(c) is needed in case a representative has been appointed. Paragraph 2(d) sets out the transitional translation requirement of Article 9(1)(h) Regulation (EU) No 1257/2012 and Article 6(1) Regulation (EU) No 1260/2012. It will have to be deleted as soon as the transitional period is terminated.

Rule 7 Examination of the request by the European Patent Office

- (1) If the requirements under Rule 5, paragraph 2, are met and the request for unitary effect complies with Rule 6, the European Patent Office shall register the unitary effect in the Register for unitary patent protection and communicate the date of this registration to the requester.
- (2) If the requirements under Rule 5, paragraph 2, are not met or the request for unitary effect does not comply with Rule 6, paragraph 1, the European Patent Office shall reject the request.
- (3) If the requirements under Rule 5, paragraph 2, are met and the request for unitary effect complies with Rule 6, paragraph 1, but fails to comply with the requirements of Rule 6, paragraph 2, the European Patent Office shall invite the requester to correct the deficiencies noted within a non-extendable period of one month. If the deficiencies are not corrected in due time, the European Patent Office shall reject the request.

Rule 7 – Examination of the request by the EPO

1. In view of the overriding need for legal certainty and in the interest of clarity, the procedure for requesting and registering unitary effect should be as straightforward as possible. In particular, the overall duration of this procedure should be as short as possible bearing in mind that the public, patent offices, courts (including the Unified Patent Court) and other national authorities should know as soon as possible whether unitary effect will be attributed to a granted European patent. Furthermore, the participating member states have a particular interest in a swift registration of the unitary effect since they have to ensure, where the unitary effect of a European patent has been registered, that the European patent is deemed not to have taken effect as a national patent in their territory (see Article 4(2) Regulation (EU) No 1257/2012). On the other hand, patent proprietors requesting unitary effect do have a legitimate interest in obtaining possibilities to remedy minor formal deficiencies contained in the request and in getting duly heard under Article 113(1) EPC, as is the case for any other procedure governed by the EPC and with which they are acquainted.
2. Paragraph 1 governs the case where all requirements, both formal and substantive as provided for under Rules 5(2) and 6, are met. In this case, the EPO can register the unitary effect in the Register for unitary patent protection and communicate the date of this registration to the patent proprietor.
3. Paragraph 2 governs three scenarios: (a) the request is filed within the one-month period of Rule 6(1) and the substantive requirements of Rule 5(2) are not met; (b) the request is filed after the expiry of the one-month period of Rule 6(1) and the substantive requirements of Rule 5(2) are met; (c) the request is filed after the expiry of the one-month period of Rule 6(1) and the substantive requirements of Rule 5(2) are not met. The fourth possible scenario, in which no request for unitary effect has been filed by the patent proprietor, is not governed by paragraph 2 since the EPO cannot issue a rejection in the absence of a request. See the explanatory remarks on Rule 6 for more information on this scenario.

4. In cases (a) to (c), the EPO will reject the request for unitary effect without setting a further time limit for correcting deficiencies. Before it does so, it will have to give the patentee the opportunity to comment, i.e. send out at least one communication inviting the requester to comment under Article 113(1) EPC, which applies pursuant to Rule 17(1). It is proposed that in case (b) the requester should be given the possibility to request re-establishment of rights in respect of the one-month period specified in Rule 6(1) within two months of expiry of that period (see Rule 20(2)). Procedurally speaking, the EPO may then, together with the rejection of the request, inform the patent proprietor that he may still request re-establishment of rights in respect of the period specified in Rule 6(1) within two months of the expiry of that period. Situations necessitating such requests for re-establishment of rights are unlikely to occur in practice in view of the possibility to file the request for unitary effect in reaction to the Rule 71(3) EPC communication (see explanatory remarks on Rule 6 above).
5. Paragraph 3 governs the case where the one-month period of Rule 6(1) and the substantive requirements of Rule 5(2) are met but where any of the formal requirements of Rule 6(2) have not been fulfilled. In such a case, the EPO would – as usual in proceedings before the EPO – give the requester the opportunity to remedy the deficiency within a non-extendable period of one month. If the requester fails to observe this period, re-establishment of rights is ruled out, no other legal remedy is available and the request for unitary effect is rejected (see Rule 19(6)), i.e. the EPO takes a final decision against which an action can be brought before the Unified Patent Court (see Article 32(1)(i) in conjunction with Article 66 Agreement on a Unified Patent Court).

CHAPTER II LICENCES OF RIGHT

Rule 8 Filing of the statement by the patent proprietor

- (1) The proprietor of a European patent with unitary effect may file a statement with the European Patent Office that he is prepared to allow any person to use the invention as a licensee in return for appropriate compensation. In that case, the renewal fees for the European patent with unitary effect which fall due after receipt of the statement shall be reduced; the amount of the reduction shall be fixed in the Rules relating to Fees. The statement shall be entered in the Register for unitary patent protection.
- (2) The statement referred to in paragraph 1 may be withdrawn at any time by a communication to this effect to the European Patent Office. Such withdrawal shall not take effect until the amount by which the renewal fees were reduced is paid to the European Patent Office.
- (3) The statement referred to in paragraph 1 may not be filed as long as an exclusive licence is recorded in the Register for unitary patent protection or a request for the recording of such a licence is pending before the European Patent Office.
- (4) No request for recording an exclusive licence in the Register for unitary patent protection shall be admissible after the statement referred to in paragraph 1 has been filed, unless that statement is withdrawn or ~~deemed withdrawn~~.

Rule 8 – Filing of a statement by the patent proprietor

1. Article 8(1) Regulation (EU) No 1257/2012 provides that the proprietor of a European patent with unitary effect may file a statement with the EPO to the effect that the proprietor is prepared to allow any person to use the invention as a licensee in return for appropriate compensation. Paragraph 2 of that provision specifies that a licence obtained under the Regulation will be treated as a contractual licence. In accordance with Article 11(3) Regulation (EU) No 1257/2012, renewal fees which fall due after receipt of the statement referred to in Article 8(1) of said regulation will be reduced. Recital 15 of the regulation adds that the patent proprietor should get a reduction of the renewal fees as from the time the EPO receives the statement referred to in Article 8(1) of the regulation.
2. Article 9(1)(c) Regulation (EU) No 1257/2012 provides that the EPO is given the task of receiving and registering the statements on licensing referred to in Article 8 and their withdrawal, and of licensing the commitments undertaken by the proprietor of the European patent with unitary effect in international standardisation bodies.
3. Proposed Rule 8(1) lays down the procedure for filing the statement referred to in Article 8 Regulation (EU) No 1257/2012 and specifies that the amount of the renewal fee reduction will be fixed in the Rules relating to Fees. Paragraph 2 specifies that the statement can be withdrawn by the proprietor at any time, in line with Article 9(1)(c) Regulation (EU) No 1257/2012. **The withdrawal will only take effect if** the amount by which the renewal fees were reduced **is** paid to the EPO. ~~In the case of late payment of this amount, it is proposed to provide for a further six-month payment period within which an additional fee must also be paid (amount to be fixed in the Rules relating to Fees) running from the expiry of the one-month period of Rule 7(3). If payment is not made in due time, where applicable together with the additional fee in the further six-month period, the patent will lapse according to Rule 11(1)(c). Paragraph 3 deals with cases where an exclusive licence is recorded in the register. Paragraph 4 specifies that no exclusive licence may be recorded after a statement has been filed, unless it is withdrawn or deemed to be withdrawn.~~

4. Pursuant to Article 32(1)(h) Agreement on a Unified Patent Court, the Court will have exclusive competence in respect of actions for compensation for licences on the basis of Article 8 Regulation (EU) No 1257/2012. Therefore, in the case of dispute, the Unified Patent Court will have to determine the amount of the appropriate compensation referred to in Article 8 Regulation (EU) No 1257/2012 and Rule 8(1) if a request for same is made by one of the contracting parties to the licence agreement.

CHAPTER III RENEWAL FEES

Rule 9 Payment of renewal fees for European patents with unitary effect

- (1) Renewal fees for European patents with unitary effect and additional fees for their late payment shall be paid to the European Patent Office. Those fees shall be due in respect of the years following the year in which the mention of the grant of the European patent which benefits from unitary effect is published in the European Patent Bulletin.
- (2) A renewal fee for the European patent with unitary effect in respect of the coming year shall be due on the last day of the month containing the anniversary of the date of filing of the European patent application which led to the European patent with unitary effect. Renewal fees may not be validly paid more than three months before they fall due.
- (3) If a renewal fee is not paid in due time, the fee may still be paid within six months of the due date, provided that an additional fee is also paid within that period.
- (4) Any renewal fee in respect of a European patent with unitary effect falling due within three months of the publication of the mention of the grant of the European patent shall be deemed to have been validly paid if it is paid within that period. No additional fee shall be charged in this case.
- (5) A renewal fee in respect of a European patent with unitary effect which, by virtue of the retroactive effect provided for in Article 4(1) Regulation (EU) No 1257/2012, would have fallen due under paragraph 2 in the period starting on the date of publication of the mention of the grant of the European patent in the European Patent Bulletin up to and including the date of registration by the European Patent Office of the unitary effect in the Register for unitary patent protection shall be due on that latter date. This fee and any renewal fee due within four months of that latter date may still be paid within four months of that latter date without an additional fee. If not paid within this period, paragraph 3 shall apply.

Rule 9 – Payment of renewal fees for European patents with unitary effect

1. In accordance with Article 11 Regulation (EU) No 1257/2012, proposed Rule 9(1) sets out the obligation to pay the EPO renewal fees and, where applicable, additional fees in the event of their late payment, for the European patent with unitary effect, the amount of the fees being determined in the Rules relating to Fees. Renewal fees for the European patent with unitary effect shall be due in respect of the years following the year in which the mention of the grant of the European patent which benefits from unitary effect is published in the European Patent Bulletin (see also Article 141(1) EPC).
2. Proposed paragraph 2 provides for the due date of payment of renewal fees and is almost identical to the wording of Rule 51(1) EPC. Proposed paragraph 3 is fully aligned with Rule 51(2) EPC, which provides for an additional period of six months if the renewal fees have not been paid on or before the due date. Proposed paragraph 4 provides for the safety period of Article 141(2) EPC, although the period is extended to three months in view of the post-grant procedure for requesting unitary effect.
3. If the renewal fee has not been paid on the due date, the EPO will inform, as a courtesy service (and as is the current practice with respect to renewal fees to be paid for the European patent application under Article 86 EPC), the proprietor of the European patent with unitary effect as soon as possible of the option of paying the fee, plus an additional fee, in the six months following the due date, that period having already begun. If the renewal fee is not paid within the additional six-month period, the EPO will send a communication under Rule 112(1) EPC (which applies *mutatis mutandis* pursuant to Rule 17(2)), notifying the proprietor of the European patent with unitary effect of the loss of rights. The communication does not constitute a decision within the meaning of Article 32(1)(i) Agreement on a Unified Patent Court, so an action cannot be brought against it before the Unified Patent Court. Failure to pay the renewal fee within the additional six-month period can be redressed using re-establishment of rights under Rule 19. Alternatively, if the finding of the EPO causing the loss of rights is inaccurate, a review of the finding can be requested by applying for a decision under Rule 112(2) EPC, said rule applying *mutatis mutandis*. An action against that decision could then be brought before the Unified Patent Court.

4. The computation of time limits is to be effected in accordance with the current EPO practice: When the due date falls on a date the EPO cannot receive mail within the meaning of Rule 134 EPC, the due date is not changed since it does not constitute a period which can be extended. Instead, the last day for valid payment is deferred to the first working day thereafter. Furthermore, the six-month additional period of Rule 9(3) starts on the last day of the month referred to in Rule 9(2), even if the EPO cannot receive mail on that date because of holidays, mail interruption or strike. However, Rule 134 EPC is to be applied to the expiry of the six-month additional period, deferring the last day for valid payment to the first working day.
5. The six-month period for the payment of a renewal fee with additional fee expires on the last day of the sixth month after the due date (pursuant to Rule 9(2)) and not on the day of that month corresponding in number to the due date (see Rule 131(4) EPC applying *mutatis mutandis* under Rule 17(2)(k)). Thus, the calculation is to be made from the last day of the month to the last day of the month (*de ultimo ad ultimo*, e.g. if the due date is 28 February, then the end of the six-months period will be 31 August and not 28 August).
6. The consequence of non-payment of the renewal fee, and where applicable, additional fee, is the lapse of the European patent with unitary effect in accordance with Article 11(2) Regulation (EU) No 1257/2012 (see Rule 11(1)(c)). The lapse takes effect on the due date. Pursuant to Rule 17(2), Rule 51(4)(5) EPC applies *mutatis mutandis*.
7. Proposed paragraph 4 reiterates the content of Article 141(2) EPC and extends the two-month safety period to three months. The three-month period starts on the date of the mention of the grant in the European Patent Bulletin (see Article 97(3) EPC). Consequently, no additional fee will be due where the renewal fee is paid within that period. The course of the six-month period under Rule 9(3) is unaffected: it starts running from the due date. However, Rule 9(4) has the effect that an additional fee under Rule 9(3) does not have to be paid where the renewal fee is paid within the three-month safety period.

8. Proposed paragraph 5 covers the case where the renewal fees fall due after the grant of the European patent but before the unitary effect is registered. This could in particular occur in exceptional circumstances where the procedure for registering unitary effect takes a long time owing, for example, to a request for re-establishment of rights or the involvement of the Unified Patent Court. If, at the end of such a procedure, unitary effect is finally registered by the EPO or the UPC, the European patent with unitary effect takes effect on the date of publication of the mention of the grant of the European patent in the European Patent Bulletin in accordance with Article 4(1) Regulation (EU) No 1257/2012. Owing to this retroactive effect (see Recital 8 Regulation (EU) No 1257/2012), renewal fees are then due for the period starting on the date of publication of the mention of the grant of the European patent in the European Patent Bulletin and up to and including the date of registration by the EPO of the unitary effect in the Register for unitary patent protection. Hence, by analogy with Rule 51(4) and (5) EPC, which apply *mutatis mutandis*, the renewal fees can be paid within four months of the registration without any additional fee. If not paid within this period, Rule 9(3) applies, i.e. the fees can still be paid with an additional fee within six months, starting from the date of registration of the unitary effect in the Register for unitary patent protection.

CHAPTER IV SURRENDER AND LAPSE

Rule 10 Surrender

- (1) A European patent with unitary effect may be surrendered for all the participating Member States in its entirety or by surrendering individual claims.
- (2) Surrender shall be declared in writing to the European Patent Office by the proprietor of the European patent with unitary effect. ~~It shall not have effect until it is entered in the Register for unitary patent protection.~~

Rule 10 – Surrender

1. In accordance with Article 3(1) Regulation (EU) No 1257, the European patent with unitary effect can be surrendered only in respect of all the participating member states (insofar as unitary effect extends to their territory pursuant to Art. 18(2) Regulation (EU) No 1257/2012). It may be surrendered in its entirety (by surrendering all the claims of the patent) or by surrendering individual claims only (partial surrender). Paragraph 2 specifies that, procedurally the expression of will of the proprietor i.e. the notice of surrender has to be made in writing by the proprietor of the European patent with unitary effect to the EPO.
2. The validity of a surrender and the effects of a valid surrender (for instance *ex nunc* or *ex tunc* effect) will exclusively be determined by national law in accordance with Article 7 Regulation (EU) No 1257/2012. The EPO will publish the fact that a notice of surrender has been received in the Register for unitary patent protection. This publication is of a purely declaratory nature. The substantive validity of the surrender cannot be and will not be verified by the EPO. Third parties may however request the EPO to correct the Register entry if evidence is being provided that the surrender was made in violation of national law.
3. It is understood that under Article 7 Regulation (EU) No 1257/2012, any possible obligation on the proprietor of the European patent with unitary effect to give advance notice to the licensees and holders of rights in rem, or to obtain their consent to the surrender, is also governed by national law.
4. In case of a partial surrender, no new specification will be published by the EPO. Instead, the new set of claims as filed by the patent proprietor would be made available to the public via online file inspection.
5. Regulation (EU) No 1257/2012 does not provide for a limitation procedure for European patents with unitary effect, i.e. for a procedure which would allow the patent proprietor to have the claims of his European patent with unitary effect limited by an amendment of the claims. Nor does it provide for the entrustment of the EPO with such an administrative task under Article 9, paragraph 1, Regulation (EU) No 1257/2012. Accordingly, such a limitation procedure - which would entail a substantive examination of the European patent with unitary effect to be carried out by an examining division - cannot be introduced via a provision governing the surrender of the European patent with unitary effect.

6. The proprietor of a European patent can use the centralised limitation and revocation procedures (Article 105a EPC) which allow the limitation of the granted European patent or its revocation for all the designated EPO Contracting States, including the participating Member States. Such a request can be filed at any time after grant, after opposition proceedings, or even after expiry of the patent.

Rule 11 Lapse

- (1) A European patent with unitary effect shall lapse:
 - (a) 20 years after the date of filing of the European patent application;
 - ~~(b) if the proprietor of the European patent with unitary effect surrenders it in accordance with Rule 10;~~
 - (b) if a renewal fee or the amount under Rule 7, paragraph 3, and, where applicable, any additional fee have not been paid in due time.**
- (2) The lapse of a European patent with unitary effect for failure to pay a renewal fee and any additional fee within the due period shall be deemed to have occurred on ~~the last day of the additional period under Rule 9, paragraph 3~~ **date on which the renewal fee was due.**

Rule 11 – Lapse

1. The proposed rule summarises the situations in which the European patent with unitary effect lapses. Paragraph 1(a) of the proposed rule reflects Article 63(1) EPC which provides that the term of the European patent is 20 years from the date of filing of the application. Paragraph 1(b) ~~refers to the surrender by the patent proprietor as provided for in Rule 10 and (b) covers the case of non-payment in due time of a renewal fee and, where applicable, any additional fee (see Article 11(2) Regulation (EU) No 1257/2012). Moreover, it covers the non-payment of the amount by which the renewal fees were reduced following withdrawal of the statement regarding the licence of right issued by the proprietor under Rule 7(3).~~
2. It is proposed that the date of effect of the lapse in the case referred to in paragraph 1(b) should be specified: in such a case, the lapse of a European patent with unitary effect is deemed to have occurred on the **date on which the renewal fee was due.**