

CIPA
The Chartered Institute of Patent Attorneys

95 Chancery Lane
London WC2A 1DT
T: 020 7405 9450
F: 020 7430 0471
E: mail@cipa.org.uk
w: cipa.org.uk

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Note on applicable national law and Unitary Patents Information which the EPO register will need to show

**Contact: Lee Davies
Chief Executive
lee@cipa.org.uk
020 7450 9450**

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Article 7 of the Unitary Patent Regulation provides as follows:

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.

Therefore the relevant Member State whose law will apply to a given Unitary Patent should be fixed at an early stage, both to enable the proprietor to know what laws apply to the transfer of the unitary patent right, and to enable third parties to know which infringement law applies under Art 5 of the Unitary Patent Regulation.

However, the question is what information will be recorded in the European Patent Register? Will it be a residence? A principle place of business? Will there be space for a place of business, if different from the residence or principal place of business?

The European Patent Register does not come into being on the date of filing. For EP designations of PCT applications, it only comes into being long after the filing date.

So it has yet to be clarified whether the relevant jurisdiction is something which is fixed by reference to the address given in a PCT or EPO application form on the filing date or might be changed if the applicant can point to a domicile or place of business in the EU at a later stage, e.g. during prosecution of the application, or even later.

Rule 41(c) EPC only requires recital of “the name, address and nationality of the applicant and the State in which his residence or principal place of business is located”. Hence, r143 EPC does not include, as “required Register information”, a place of business other than an applicant’s principal place of business on the date of filing of the application for the European patent. Accordingly, it cannot be determined simply from looking to the European Patent Register whether, e.g. at the time of filing the application, an applicant from a non-participating State had a place of business in a Participating Member State (Art 7(1)(b) Unitary Patent Regulation).

Further, for PCT applications, r143 EPC does not include, as “required applicant information”, the information given at the time of filing of the PCT application, which may be different from that at time of creation of the European Patent Register entry –

either for the applicant name or its address. Will an assignment in the PCT phase to an applicant resident in a different Participating Member State result in a different national law applying for property and infringement purposes?

Hence, although Art 7 Unitary Patent Regulation refers to information on the European Patent Register, the European Patent Register does not currently show all information necessary to determine the applicable law for a Unitary Patent. As long as the European Patent Register does not permit recordal of an applicant address other than the residence or principal place of business, it necessarily constrains all applicants from non-Participating Member States to German law.

Although not part of the current consultation, **the IPO is requested to press for the EPO Implementation rules to permit recordal on the EPO Register of a place of business (other than the principal place of business) at least with the request for unitary effect. The EPO register should also show the identity of the original applicant.**