

**Proposal for a Council Regulation on the Community patent**

(2000/C 337 E/45)

(Text with EEA relevance)

COM(2000) 412 final — 2000/0177(CNS)

(Submitted by the Commission on 1 August 2000)

THE COUNCIL OF THE EUROPEAN UNION,

should therefore be without prejudice to the right of the Member States to grant national patents.

Having regard to the Treaty establishing the European Community, and in particular Article 308 thereof,

(5) The objective of an affordable Community patent militates in favour of a patent that is valid throughout the Community in the language in which it was granted under the Munich Convention.

Having regard to the proposal from the Commission,

Having regard to the opinion of the European Parliament,

Having regard to the opinion of the Economic and Social Committee,

(6) Any negative effects of a monopoly created by a Community patent should be prevented through a system of compulsory licences. The Commission should therefore be given decision-making powers in this matter. Commission decisions are subject to appeal under Article 230 of the Treaty before the Court of First Instance of the European Communities and before the Court of Justice of the European Communities.

Whereas:

(1) The activities of the Community include the establishment of an internal market characterised by the abolition of obstacles to the free movement of goods and the creation of a system ensuring that competition in the internal market is not distorted. The creation of the legal conditions enabling undertakings to adapt their activities in manufacturing and distributing products to a Community dimension helps to attain these objectives. A patent to which uniform protection is given and which produces uniform effects throughout the Community should feature amongst the legal instruments which undertakings have at their disposal.

(7) For reasons of legal certainty, all actions relating to certain aspects of the Community patent should come under the jurisdiction of one court, and the decisions of that court should be enforceable throughout the Community. Exclusive jurisdiction for a certain category of actions and applications relating to a Community patent, and in particular for actions relating to infringement and validity, should therefore be given to the Community intellectual property court. Judgments of a Chamber of First Instance of that court should be subject to appeal to a Chamber of Appeal of that court.

(2) The Munich Convention on the Grant of European Patents of 5 October 1973 (hereinafter referred to as the 'Munich Convention') established the European Patent Office (hereinafter referred to as 'the Office') and entrusted it with the task of granting European patents. The expertise offered by the Office should be used in the granting and administration of the Community patent.

(8) The court ruling on infringement and validity should also be able to rule on penalties and compensation for damage on the basis of common rules. Those powers are without prejudice to the powers to apply any rules on criminal liability and unfair competition provided for under the Member States' national law.

(3) The accession of the Community to the Munich Convention will enable the Community to be included in the Convention system as a territory for which a unitary patent can be granted. The Community can, therefore, limit this Regulation to the creation of the law applicable to the Community patent once granted.

(9) The rules for proceedings before the Community intellectual property court are laid down in the court's statute and rules of procedure.

(4) Community patent law applicable to the Community patent should not replace the laws of the Member States on patents, nor European patent law as established by the Munich Convention. It would not in fact appear to be justified to require undertakings to apply for registration of their patents as Community patents, since national patents and European patents continue to be necessary for those undertakings which do not want protection of their inventions at Community level. This Regulation

(10) In accordance with the principles of subsidiarity and proportionality as set out in Article 5 of the Treaty, the objectives of the proposed action, in particular the creation of a unitary right with effect throughout the Community, can be achieved only by the Community. This Regulation confines itself to the minimum required in order to achieve those objectives and does not go beyond what is necessary for that purpose.

(11) Since the measures necessary for implementing this Regulation are measures of general scope within the meaning of Article 2 of Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission <sup>(1)</sup>, they should be adopted in accordance with the regulatory procedure laid down in Article 5 of that Decision,

HAS ADOPTED THIS REGULATION:

## CHAPTER I

### GENERAL PROVISIONS

#### Article 1

#### Community patent law

This Regulation establishes a Community law on patents. This law shall apply to all patents granted by the European Patent Office (hereinafter referred to as 'the Office') under the provisions of the European Patent Convention of 5 October 1973 (hereinafter referred to as the 'Munich Convention') throughout the entire area of the Community.

For the purpose of this Regulation, such patents shall be considered to be Community patents.

#### Article 2

#### Community patent

1. The Community patent shall have a unitary character. It shall have equal effect throughout the Community and may only be granted, transferred, declared invalid or lapse in respect of the whole of the Community.

2. The Community patent shall have an autonomous character. It shall be subject only to the provisions of this Regulation and to the general principles of Community law. However, the provisions of this Regulation shall not exclude the application of the law of Member States with regard to criminal liability and unfair competition.

3. Unless otherwise provided for, the terms used in this Regulation shall have the same meaning as the corresponding terms used in the Munich Convention.

4. For the purposes of this Regulation, the term 'application for a Community patent' shall mean an application for a European patent designating the territory of the Community.

#### Article 3

#### Application to the sea and submarine areas and to space

1. This Regulation shall apply to the sea and submarine areas adjacent to a Member State's territory in which that

Member State exercises sovereign rights or jurisdiction in accordance with international law.

2. This Regulation shall apply to inventions created or used in outer space, including on celestial bodies or on spacecraft, which are under the jurisdiction and control of one or more Member States in accordance with international law.

## CHAPTER II

### PATENT LAW

#### SECTION 1

#### RIGHT TO THE PATENT

#### Article 4

#### Right to the Community patent

1. The right to the Community patent shall belong to the inventor or his successor in title.

2. If the inventor is an employee, the right to the Community patent shall be determined in accordance with the law of the State in which the employee is mainly employed; if the State in which the employee is mainly employed cannot be determined, the law to be applied shall be that of the State in which the employer has his place of business to which the employee is attached.

3. If two or more persons have made an invention independently of each other, the right to the Community patent shall belong to the person whose Community patent application has the earliest date of filing or, where applicable, the earliest date of priority. This provision shall apply only if the first Community patent application has been published.

#### Article 5

#### Claiming the right to the Community patent

1. If the Community patent has been granted to a person who is not entitled to it under Article 4(1) and (2), the person entitled to it under that article may, without prejudice to any other right or remedy which may be open to him, claim to have the patent transferred to him.

2. Where a person is entitled to only part of the Community patent, that person may, in accordance with paragraph 1, claim to be made a joint proprietor.

3. Legal proceedings in respect of the rights referred to in paragraphs 1 and 2 may be instituted only within a period of two years after the date on which the Community Patent Bulletin, referred to in Article 57, publishes the grant of the Community patent. This provision shall not apply if the proprietor of the patent knew, at the time of the grant or of the acquisition of the patent, that he was not entitled to the patent.

<sup>(1)</sup> OJ L 184, 17.7.1999, p. 23.

4. The fact that legal proceedings have been instituted shall be entered in the Register of Community Patents referred to in Article 56. The final decision in the legal proceedings or any withdrawal thereof shall also be entered.

#### Article 6

### Effect of change of proprietorship of the Community patent

1. Where there is a complete change of proprietorship of a Community patent as a result of legal proceedings referred to in Article 5, licences and other rights shall lapse upon the registration of the person entitled to the patent in the Register of Community Patents referred to in Article 56.

2. If, before the institution of legal proceedings has been registered,

(a) the proprietor of the patent has used the invention within the territory of the Community or made effective and serious preparations to do so,

or

(b) a licensee of the patent has obtained his licence and has used the invention within the territory of the Community or made effective and serious preparations to do so,

he may continue such use provided that he requests a non-exclusive licence of the patent from the new proprietor whose name is entered in the Register of Community Patents. Such request must be made within the period prescribed in the implementing regulations. The licence shall be granted for a reasonable period and upon reasonable terms.

3. Paragraph 2 shall not apply if the proprietor of the patent or the licensee was acting in bad faith at the time when he began to use the invention or to make preparations to do so.

#### SECTION 2

### EFFECTS OF THE COMMUNITY PATENT AND THE COMMUNITY PATENT APPLICATION

#### Article 7

### Prohibition of direct use of the invention

The Community patent shall confer on its proprietor the right to prevent all third parties not having his consent:

(a) from making, offering, putting on the market or using the product which is the subject-matter of the patent, or importing or stocking the product for these purposes;

(b) from using the process which is the subject-matter of the patent or, when the third party knows, or it is obvious in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent, from offering the process for use within the territories of the Member States;

(c) from offering, putting on the market or using a product obtained directly by a process which is the subject-matter of the patent, or importing or stocking the product for these purposes.

#### Article 8

### Prohibition of indirect use of the invention

1. In addition to the right conferred pursuant to Article 7, the Community patent shall confer on its proprietor the right to prevent all third parties not having his consent from supplying or offering to supply within the territories of the Member States to a person, other than one entitled to exploit the patented invention, with means, relating to an essential element of that invention, for putting it into effect therein, when the third party knows, or it is obvious in the circumstances, that these means are suitable and intended for putting that invention into effect.

2. Paragraph 1 shall not apply when the means are staple commercial products, except when the third party induces the person supplied to commit acts prohibited by Article 7.

3. Persons performing the acts referred to in Article 9(a) (b) and (c) shall not be considered to be parties entitled to exploit the invention within the meaning of paragraph 1.

#### Article 9

### Limitation of the effects of the Community patent

The rights conferred by the Community patent shall not extend to:

(a) acts done privately and for non-commercial purposes;

(b) acts done for experimental purposes relating to the subject-matter of the patented invention;

(c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription nor acts concerning the medicine so prepared;

(d) the use on board vessels of countries other than Member States of the patented invention, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of Member States, provided that the invention is used there exclusively for the needs of the vessel;

(e) the use of the patented invention in the construction or operation of aircraft or land vehicles or other means of transport of non-member States, or of accessories to such aircraft or land vehicles, when these temporarily or accidentally enter the territory of Member States;

- (f) the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944, where these acts concern the aircraft of a country other than a Member State.

#### Article 10

### Community exhaustion of the rights conferred by the Community patent

The rights conferred by the Community patent shall not extend to acts concerning the product covered by that patent which are carried out within the territories of the Member States after that product has been put on the market in the Community by the proprietor of the patent or with his consent, unless there are legitimate grounds for the proprietor to oppose further commercialisation of the product.

#### Article 11

### Rights conferred by the Community patent application after publication

1. Compensation reasonable in the circumstances may be claimed from a third party who, in the period between the date of publication of a Community patent application and the date of publication of the mention of the grant of the Community patent, has made any use of the invention which, after that period, would be prohibited by virtue of the Community patent.

2. Reasonable compensation shall be due only if the applicant has either communicated to the person using the invention or filed with the Office a translation of the claims which the Office has made available to the public and which is in the official language of the Member State in which the person using the invention has his residence or principal place of business or, where that State has more than one official language, in the language which that person has accepted or designated, provided that the contested use constitutes infringement of the application according to the original text of the application and according to the text of the translation. However, if the person using the invention is able to understand the text of the Community patent application in the language in which it was made available to the public, reasonable compensation shall be due without communication of a translation.

3. When reasonable compensation is fixed, due account shall be taken of the good faith of the person who has used the invention.

4. The official language referred to in paragraph 2 shall be an official language of the Community.

#### Article 12

### Right based on prior use of the invention

1. A Community patent may not be invoked against a person who, in good faith and for business purposes, had

used the invention in the Community or had made effective and serious preparations for such use before the filing date or, where priority has been claimed, the priority date of the application on the basis of which the patent is granted (hereinafter referred to as 'the prior user'); the prior user shall have the right, for business purposes, to continue the use in question or to use the invention as planned during the preparations.

2. The right of the prior user may not be transferred either during the user's lifetime or following his death other than with the user's undertaking or that part of the undertaking in which the use or the preparations for use took place.

#### Article 13

### Process patents: burden of proof

1. If the subject-matter of a Community patent is a process for obtaining a new product, the same product when produced without the consent of the proprietor shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process.

2. In adducing proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and trade secrets shall be taken into account.

#### SECTION 3

### THE COMMUNITY PATENT AS AN OBJECT OF PROPERTY

#### Article 14

### Dealing with the Community patent as a national patent

1. Unless otherwise specified in Articles 15 to 24, the Community patent as an object of property shall be dealt with in its entirety, and for the whole of the Community, as a national patent of the Member State in which, according to the Register of Community Patents provided for by Article 56:

- (a) the applicant for the patent had his residence or place of business on the date of filing of the Community patent application;
- (b) where subparagraph (a) does not apply, the applicant had an establishment on that date;
- (c) where neither subparagraph (a) nor subparagraph (b) applies, the applicant's representative whose name is entered first in the Register of Community Patents had his professional domicile on the date of that entry.

In all other cases, the Member State referred to shall be that in which the European Patent Organisation has its seat.

2. If two or more persons are mentioned in the Register of Community Patents as joint applicants, the first subparagraph of paragraph 1 shall apply to the joint applicant first mentioned. If this is not possible, the first subparagraph of paragraph 1 shall apply to the joint applicants next mentioned in order of entry. Where the first subparagraph of paragraph 1 does not apply to any of the joint applicants, the second subparagraph of paragraph 1 shall apply.

3. The acquisition of a right may not be dependent on any entry in a national patent register.

#### Article 15

##### **Transfer**

1. The Community patent held by an undertaking may be transferred independently of the transfer of the undertaking.

2. A transfer of the whole of the undertaking shall include the transfer of the Community patent except where, in accordance with the law governing the transfer, there is agreement to the contrary or circumstances clearly dictate otherwise. This provision shall apply to the contractual obligation to transfer the undertaking.

3. The transfer of the Community patent shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgment; otherwise it shall be void.

4. Subject to Article 6(1), a transfer shall not affect rights acquired by third parties before the date of transfer.

5. A transfer shall, to the extent to which it is verified by the documents set out in the implementing regulations referred to in Article 59, have effect vis-à-vis third parties only after entry in the Register of Community Patents referred to in Article 56. Nevertheless, a transfer, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights after the date of the transfer but who knew of the transfer on the date on which the rights were acquired.

#### Article 16

##### **Rights in rem**

1. The Community patent may, independently of the undertaking, be given as security or be the subject of rights *in rem*.

2. At the request of one of the parties, the rights referred to in paragraph 1 shall be entered in the Register of Community Patents referred to in Article 56 and published in the Community Patent Bulletin referred to in Article 57.

#### Article 17

##### **Levy of execution**

1. The Community patent may be levied in execution.

2. At the request of one of the parties, the levy of execution shall be entered in the Register of Community Patents referred to in Article 56 of this Regulation and published in the Community Patent Bulletin referred to in Article 57.

#### Article 18

##### **Bankruptcy or like proceedings**

1. The only Member State in which a Community patent may be involved in bankruptcy or like proceedings shall be that in which the debtor has his principal centre of interests.

2. In the case of joint proprietorship of a Community patent, paragraph 1 shall apply to the share of the joint proprietor.

3. Where a Community patent is involved in bankruptcy or like proceedings, on request of the competent national authority an entry to this effect shall be made in the Register of Community Patents referred to in Article 56 and published in the Community Patent Bulletin referred to in Article 57.

#### Article 19

##### **Contractual licensing**

1. The Community patent may be licensed in whole or in part for the whole or part of the Community. A licence may be exclusive or non-exclusive.

2. The rights conferred by the Community patent may be invoked against a licensee who breaches any restriction in the licensing contract.

3. Article 15(4) and (5) shall apply to the grant or transfer of a licence in respect of a Community patent.

#### Article 20

##### **Licences of right**

1. The proprietor of a Community patent may file a written statement with the 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 Community patent 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 referred to in Article 60. Where there is a complete change of proprietorship of the patent as a result of legal proceedings under Article 5, the statement shall be deemed withdrawn on the date of entry of the name of the person entitled to the patent in the Register of Community Patents.

2. The statement may be withdrawn at any time by a written communication to this effect to the Office, provided that no-one has yet informed the proprietor of the patent of his intention to use the invention. Such withdrawal shall take effect from the date of receipt of that communication by the Office. The amount by which the renewal fees were reduced shall be paid within one month after withdrawal; Article 25(2) shall apply, but the six-month period shall start upon expiry of the above period.

3. The statement may not be filed while an exclusive licence is recorded in the Register of Community Patents or a request for the recording of such a licence is before the Office.

4. On the basis of the statement, any person shall be entitled to use the invention as a licensee under the conditions laid down in the implementing regulations referred to in Article 59. A licence obtained under the terms of this Article shall, for the purposes of this Regulation, be treated as a contractual licence.

5. On written request by one of the parties, the Commission shall determine the appropriate compensation referred to in paragraph 1 or review it if circumstances have arisen or become known which render the compensation determined obviously inappropriate.

6. No request for recording an exclusive licence in the Register of Community Patents shall be admissible after the statement has been filed, unless it is withdrawn or deemed withdrawn

7. The Member States may not grant licences of right in respect of a Community patent.

#### Article 21

##### Grant of compulsory licences

1. The Commission may grant a compulsory licence for lack or insufficiency of exploitation of a Community patent to any person filing an application four years or later after the patent application was filed and three years or later after the patent was granted if the patent proprietor has not exploited the patent in the Community on reasonable terms or has not made effective and serious preparations to do so, unless he provides legitimate reasons to justify his inaction. In determining the lack or insufficiency of exploitation of the patent, no distinction shall be made between products originating within the Community and imported products.

2. On request, the Commission may grant a compulsory licence in respect of a first patent to the proprietor of a national or Community patent or to the proprietor of a plant variety right who cannot use his patent (second patent) or his national or Community plant variety right without infringing a Community patent (first patent), provided that the invention or new plant variety claimed in the second

patent or plant variety right involves an important technical advance of considerable economic significance in relation to the invention claimed in the first patent. The Commission may take any measure it regards as useful to verify the existence of such a situation. In the case of a compulsory licence in respect of a dependent patent or plant variety right, the owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the patented invention or protected plant variety.

3. In times of crisis or in other situations of extreme urgency, or when it is necessary to remedy a practice determined after judicial or administrative process to be anti-competitive, the Commission may authorise the exploitation of a Community patent.

4. In the case of semiconductor technology, exploitation shall be possible only in the situations set out in paragraph 3.

5. A licence or exploitation set out in paragraphs 1, 2 and 3 may be granted only if the proposed user has made efforts to obtain authorisation from the patent holder on reasonable commercial terms and conditions, and if such efforts have not been successful within a reasonable period of time. However, the Commission may derogate from this condition in the situations set out in paragraph 3. In these situations, the right holder shall be informed as soon as reasonably possible.

6. The detailed rules of application and the procedures to be used for applying the principles set out in this Article shall be laid down in the implementing regulation.

#### Article 22

##### Conditions applicable to compulsory licences

1. When granting the compulsory licence under Article 21, the Commission shall specify the type of use covered and the conditions to be met. The following conditions shall apply:

- (a) the scope and duration of the exploitation shall be limited to the purpose for which it was authorised;
- (b) the exploitation shall be non-exclusive;
- (c) the exploitation shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;
- (d) the exploitation shall be authorised predominantly for the supply of the internal market of the Community unless it is necessary to correct a practice determined after judicial or administrative process to be anti-competitive;
- (e) the Commission may, on reasoned request, decide to cancel the authorisation, subject to adequate protection of the legitimate interests of the persons so authorised, if and when the circumstances which led to it cease to exist and are unlikely to recur;

- (f) the licence holder shall pay the right holder adequate remuneration, taking into account the economic value of the authorisation and any need to correct an anti-competitive practice;
- (g) in the case of a compulsory licence in respect of a dependent patent or a plant variety right, the exploitation authorised in respect of the first patent shall be non-assignable except with the assignment of the second patent or plant variety right.
2. The Member States may not grant compulsory licences in respect of a Community patent.

#### Article 23

##### Effects vis-à-vis third parties

1. Legal acts referred to in Articles 16 to 22 concerning a Community patent shall have effects vis-à-vis third parties in all the Member States only after entry in the Register of Community Patents. Nevertheless, such an act, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights concerning the patent after the date of that act but who knew of the act at the date on which the rights were acquired.
2. Paragraph 1 shall not apply in the case of a person who acquires the Community patent or a right concerning the Community patent by way of transfer of the whole of the undertaking or by any other universal succession.

#### Article 24

##### The application for a Community patent as an object of property

1. Articles 14 to 19 and Article 21(3) to (6), and Article 22 shall apply to the application for a Community patent.
2. The rights acquired by third parties in respect of a Community patent application referred to in paragraph 1 shall continue to be effective with regard to the Community patent granted upon that application.

### CHAPTER III

#### RENEWAL, LAPSE AND INVALIDITY OF THE COMMUNITY PATENT

##### SECTION 1

##### RENEWAL AND LAPSE

#### Article 25

##### Renewal fees

1. Annual renewal fees in respect of Community patents shall be paid to the Office in accordance with the implementing regulations referred to in Article 60. These fees

shall be due in respect of the years following the year in which the Community Patent Bulletin referred to in Article 57 mentions the grant of the Community patent.

2. When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of that date, provided that an additional fee is paid at the same time.

3. Any renewal fee in respect of a Community patent falling due within two months after the publication of the mention of the grant of the Community patent shall be deemed to have been validly paid if it is paid within the period mentioned in paragraph 2. No additional fee shall be charged in this case.

#### Article 26

##### Surrender

1. The Community patent may be surrendered only in its entirety.
2. Surrender must be declared in writing to the Office by the proprietor of the patent. It shall not have effect until it is entered in the Register of Community Patents.
3. Surrender shall be entered in the Register of Community Patents only with the agreement of any third party who has a right *in rem* recorded in the Register or in respect of whom there is an entry in the Register pursuant to Article 5(4), first sentence. If a licence is recorded in the Register, surrender shall be entered only if the proprietor of the patent proves that he has previously informed the licensee of his intention to surrender; this entry shall be made on expiry of the period laid down in the implementing regulations referred to in Article 59.

#### Article 27

##### Lapse

1. The Community patent shall lapse:
- 20 years after the date of filing of the application;
  - if the proprietor of the patent surrenders it in accordance with Article 26;
  - if a renewal fee and any additional fee have not been paid in due time.
2. The lapse of a patent for failure to pay a renewal fee and any additional fee within the due period shall be deemed to have occurred on the date on which the renewal fee was due.

## SECTION 2

**INVALIDITY OF THE COMMUNITY PATENT***Article 28***Grounds for invalidity**

1. The Community patent may be declared invalid only on the grounds that:

- (a) the subject-matter of the patent is not patentable according to Articles 52 to 57 of the Munich Convention;
- (b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
- (c) the subject-matter of the patent extends beyond the content of the patent application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61 of the Munich Convention, beyond the content of the earlier application as filed;
- (d) the protection conferred by the patent has been extended;
- (e) the proprietor of the patent is not entitled under Article 4(1) and (2) of this Regulation;
- (f) the subject-matter of the patent is not new having regard to the content of a national patent application or of a national patent made public in a Member State on the date of filing or later or, where priority has been claimed, the date of priority of the Community patent, but with a filing date or priority date before that date.

2. If the grounds for invalidity affect the patent only partially, invalidity shall be pronounced in the form of a corresponding limitation of the patent. The limitation may be effected in the form of an amendment to the claims, the description or the drawings.

*Article 29***Effects of invalidity**

1. The Community patent shall be deemed not to have had, from the outset, the effects specified in this Regulation, to the extent that the patent has been declared invalid either in whole or in part.
2. The retroactive effect of the invalidity of the patent shall not affect:
  - (a) any decision on infringement which has acquired the authority of *res judicata* and been enforced prior to the invalidity decision;
  - (b) any contract concluded prior to the invalidity decision, in so far as it has been performed before that decision.

However, repayment, to an extent justified by the circumstances, of sums paid under the relevant contract may be claimed on grounds of equity.

## CHAPTER IV

**JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO THE COMMUNITY PATENT**

## SECTION 1

**ACTIONS CONCERNING THE VALIDITY, INFRINGEMENT AND USE OF THE COMMUNITY PATENT***Article 30***Actions and claims relating to the Community patent  
Exclusive jurisdiction of the Community intellectual property court**

1. The Community patent may be the subject of invalidity or infringement proceedings, of action for a declaration of non-infringement, of proceedings relating to the use of the patent or to the right based on prior use of the patent, or of requests for limitation, counterclaims for invalidity or applications for a declaration of lapse. It may also be the subject of proceedings or claims for damages.
2. The Community patent may not be the subject of actions in respect of threatened infringement.
3. The actions and claims referred to in paragraph 1 come under the exclusive jurisdiction of the Community intellectual property court. In the first instance, they are brought before the Chamber of First Instance of that court.
4. Subject to the provisions of the Treaty and of this Regulation, the terms and procedures relating to the actions and claims referred to in paragraph 1 and the rules applying to the judgments given shall be established in the statute or rules of procedure of the Community intellectual property court.

*Article 31***Invalidity action**

1. Invalidity proceedings against a Community patent may be based only on the grounds for invalidity set out in Article 28(1).
2. Any person may initiate invalidity proceedings; however, in the case referred to in Article 28(1)(e), the proceedings may be initiated only by a person entitled to be entered in the Register of Community Patents as the sole proprietor of the patent, or by all the persons entitled to be entered as joint proprietors of it in accordance with Article 5 acting jointly.
3. The proceedings may be brought even if opposition may still be filed or if opposition proceedings are pending before the Office.

4. The proceedings may be brought even if the Community patent has lapsed.

#### Article 32

##### **Counterclaim for invalidity**

1. Counterclaims for invalidity against a Community patent may be based only on the grounds for invalidity set out in Article 28(1).

2. If the counterclaim is brought in a legal action to which the proprietor of the patent is not already a party, he shall be informed thereof and may be joined as a party to the action.

#### Article 33

##### **Infringement action**

1. Actions for infringement may be based only on facts referred to in Articles 7, 8 and 19.

2. Only the proprietor of the patent may bring an action for infringement. Unless otherwise stipulated in the contract, the beneficiary of a contractual licence may bring proceedings for infringement only if the patent proprietor consents thereto. However, the beneficiary of an exclusive licence and the beneficiary of a licence of right or a compulsory licence may bring such proceedings if the proprietor of the patent, after formal notice, does not himself bring infringement proceedings.

3. The proprietor of the patent shall be entitled to intervene in infringement proceedings brought by the licensee under paragraph 2.

4. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor under paragraph 2.

#### Article 34

##### **Action for declaration of non-infringement**

1. Any person may bring proceedings against the patent proprietor or the beneficiary of an exclusive licence in order to apply for a decision that the economic activity he is exercising, or making effective preparations to exercise or envisaging exercising does not affect the rights referred to in Articles 7, 8 and 19.

2. The validity of the Community patent may not be contested in an action for a declaration of non-infringement.

#### Article 35

##### **Proceedings relating to use of the invention prior to the grant of the patent**

Proceedings relating to the use of the invention during the period referred to in Article 11(1) may be brought by the applicant or proprietor of the patent. However, the beneficiary

of an exclusive licence may bring such proceedings if the proprietor, after formal notice, does not himself bring proceedings.

#### Article 36

##### **Proceedings relating to a right based on prior use of the invention**

Proceedings relating to the right based on prior use of the patent referred to in Article 12(1) may be brought by the prior user or the person to whom he has assigned his right in accordance with paragraph 2 of that Article, with a view to establishing his right to use the invention in question.

#### Article 37

##### **Request for limitation**

1. At the request of the proprietor, a Community patent may be limited in the form of an amendment to the claims, the description or the drawings.

2. The request may not be filed during the period within which an opposition may be filed or while opposition or invalidity proceedings are pending.

3. The request shall be admissible only with the agreement of any person who has a right *in rem* recorded in the Register of Community Patents or in respect of whom there is an entry in the Register pursuant to Article 5(4), first sentence. If a licence is recorded in the Register, the request shall be admissible only if the proprietor of the patent proves that he has the agreement of the licensee or at least three months from the time at which the proprietor proves that he has informed the licensee of his intention to limit the patent.

4. If, following the proceedings, the Community intellectual property court is of the opinion that, taking into consideration the amendments made by the proprietor, the grounds for invalidity referred to in Article 28 do not prejudice the maintenance of the Community patent, it shall decide to limit the patent accordingly. If the court is of the opinion that the amendments are not acceptable, it shall reject the request.

#### Article 38

##### **Application for a ruling that a patent has lapsed**

Any person may file an application for a ruling that a Community patent has lapsed on the grounds laid down by Article 27.

#### Article 39

##### **Appeals**

1. An appeal to the Chamber of Appeal of the Community intellectual property court shall lie from judgments of the Chamber of First Instance of that court in respect of proceedings arising from the actions and claims referred to in the provisions of this section.

2. The action shall be brought before the Chamber of Appeal within two months of the date of notification of the judgment in accordance with the statute of the Community intellectual property court.

3. The Chamber of Appeal shall have jurisdiction to rule on the facts of a particular case as well as on points of law and to annul or alter the contested decision.

4. The action shall be open to any party to proceedings before the Community intellectual property court adversely affected by its decision.

5. The action shall have suspensive effect. However, the Chamber of First Instance may declare its judgment enforceable while, if necessary, subjecting enforcement to the provision of security.

#### Article 40

##### Commission's capacity to act

1. Where necessary in the Community's interest, the Commission may bring invalidity proceedings against a Community patent before the Community intellectual property court.

2. The Commission may also, under the condition referred to in paragraph 1, intervene in all proceedings before the Community intellectual property court.

#### Article 41

##### Extent of jurisdiction

In the proceedings referred to in Articles 33 to 36, the Community intellectual property court shall have jurisdiction in respect of acts committed and activities undertaken in a part or in the entirety of the territory, zone or space to which this Regulation applies.

#### Article 42

##### Provisional or protective measures

The Community intellectual property court may take any necessary provisional or protective measure in accordance with its statute.

#### Article 43

##### Penalties

Where the Community intellectual property court, in proceedings referred to in Article 33, finds that the defendant has infringed a Community patent, it may issue the following orders:

(a) an order prohibiting the defendant from continuing with the acts which infringed the patent;

(b) an order to seize the products resulting from the infringement;

(c) an order to seize the goods, materials and implements which constitute the means for putting the protected invention into effect and which have been supplied or offered for supply under the conditions set out in Article 8;

(d) any order imposing other penalties adapted to the circumstances or suitable for guaranteeing compliance with the orders referred to in (a), (b) and (c).

#### Article 44

##### Actions or claims for damages

1. The Community intellectual property court shall have the power to order the payment of compensation for the damage underlying the actions referred to in Articles 31 to 36.

2. In determining the appropriate damages, the court shall take into account all relevant aspects, such as the economic consequences to the injured party of the infringement and the behaviour and the good or bad faith of the parties. The damages shall not be punitive.

3. For the purposes of paragraph 2, an alleged infringer who has his residence or principal place of business in a Member State whose official language, which is also an official language of the Community, is not the language in which the patent was granted or in which a translation of the patent has been made public in accordance with Article 58, is presumed, in the absence of proof to the contrary, not to have known nor to have had reasonable grounds for knowing that he was infringing the patent. In such a situation, damages for infringement shall be due only for the period from the time when he is notified of a translation in that official language of the Member State of the residence or principal place of business of the alleged infringer.

4. Where the Member State referred to in paragraph 3 has two or more official languages which are also official languages of the Community, the infringer shall be entitled to notification in one of those official languages that he knows.

#### Article 45

##### Period of limitation

Proceedings relating to use, to the right based on prior use, to infringement and to damages referred to in this section shall be barred after five years have elapsed from the date on which the facts justifying proceedings emerged, or, if the requesting party was unaware of those facts at the time they emerged, from the date on which he became aware of them or should have become aware of them.

## SECTION 2

**JURISDICTION AND PROCEDURE IN OTHER ACTIONS  
RELATING TO THE COMMUNITY PATENT**

## Article 46

**Jurisdiction of national courts**

The national courts of the Member States shall have jurisdiction in actions relating to Community patents which do not come within the exclusive jurisdiction of either the Court of Justice under the Treaty or the Community intellectual property court according to the provisions of Chapter IV, Section 1.

## Article 47

**Application of the Brussels Convention**

Unless otherwise specified in this Regulation, the Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters, signed at Brussels on 27 September 1968 <sup>(1)</sup> shall apply to actions brought before the national courts and to decisions given in respect of such actions.

## Article 48

**Proceedings relating to the right to a patent between an employer and an employee**

1. By way of derogation from the provisions applicable under Article 47, the courts of the Member State under whose law the right to a Community patent is determined in accordance with Article 4(2) shall have exclusive jurisdiction in proceedings relating to the right to a patent over which an employer and an employee are in dispute.

2. Any agreement conferring jurisdiction shall be valid only if it is entered into after the dispute has arisen or if it allows the employee to bring proceedings in courts other than those which would have jurisdiction under paragraph 1.

## Article 49

**Actions relating to the levy of execution on the Community patent**

By way of derogation from the provisions applicable under Article 47, the courts and authorities of the Member State determined under Article 14 shall have exclusive jurisdiction in proceedings relating to the levy of execution on a Community patent.

## Article 50

**Supplementary provisions on jurisdiction**

1. Within the Member State whose courts have jurisdiction under Article 47, those courts shall have jurisdiction which

would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to national patents granted in that State.

2. Actions relating to the Community patent for which no court has jurisdiction under Articles 47 and 48 and paragraph 1 of this Article may be heard before the courts of the Member State in which the European Patent Organisation has its seat.

## Article 51

**Obligations of the national court**

1. A national court hearing an action or application referred to in Article 30 shall declare of its own motion that it has no jurisdiction.

2. A national court hearing an action or claim relating to a Community patent other than the actions referred to in Article 30 shall treat the patent as valid unless it has been declared invalid by the Community intellectual property court in a decision which has the authority of *res judicata*.

3. A national court hearing an action or claim relating to a Community patent other than the actions referred to in Article 30 shall stay the proceedings if it considers a decision on an action or application referred to in Article 30 to be a prior condition for its judgment. Proceedings shall be stayed either by the court of its own motion, after hearing the parties, where an action or application referred to in Article 30 has been brought before the Community intellectual property court, or at the request of one of the parties, and after hearing the other parties, where proceedings have not yet been brought before the Community court. In the latter case, the national court shall invite the parties to bring such proceedings within a period prescribed by it. If such proceedings are not brought within the prescribed period, the proceedings before the national court shall continue.

## Article 52

**Applicable law of procedure**

Unless otherwise provided in this Regulation, a national court shall apply the rules of procedure governing the same type of action relating to a national patent in the Member State in which it is situated.

## SECTION 3

**ARBITRATION**

## Article 53

**Arbitration**

The provisions of this Chapter relating to jurisdiction and judicial procedure shall be without prejudice to the national arbitration rules of the Member States. However, a Community patent may not be declared invalid or be invalidated in arbitration proceedings.

<sup>(1)</sup> OJ C 27, 26.1.1998, p. 3.

## CHAPTER V

**IMPACT ON NATIONAL LAW***Article 54***Prohibition of simultaneous protection**

1. Where a national patent granted in a Member State relates to an invention for which a Community patent has been granted to the same inventor or to his successor in title with the same date of filing, or, if priority has been claimed, with the same date of priority, that national patent shall be ineffective to the extent that it covers the same invention as the Community patent, from the date on which:

- (a) the period for filing an opposition to the decision of the Office to grant a Community patent has expired without any opposition being filed;
- (b) the opposition proceedings are concluded with a decision to maintain the Community patent;

or

- (c) the national patent is granted, where this date is subsequent to the date referred to in point (a) or (b), as the case may be.

2. The subsequent lapse or invalidity of the Community patent shall not affect the provisions of paragraph 1.

3. Each Member State may prescribe the procedure whereby the effect of the national patent is determined to have been lost in whole or, where appropriate, in part. It may also prescribe that the loss of effect shall apply from the outset.

4. Simultaneous protection by a Community patent or Community patent application and a national patent or national patent application shall exist prior to the date applicable under paragraph 1.

*Article 55***National utility models and utility certificates**

Article 54 shall apply to utility models and utility certificates and to applications for utility models and utility certificates in the Member States whose laws make provision for such protection rights.

## CHAPTER VI

**FINAL PROVISIONS***Article 56***Register of Community Patents**

The Office shall keep a Register of Community Patents, which shall contain those particulars whose registration is provided

for by this Regulation. The Register shall be open to public inspection.

*Article 57***Community Patent Bulletin**

The Office shall periodically publish a Community Patent Bulletin. It shall contain entries made in the Register of Community Patents, as well as other particulars whose publication is prescribed by this Regulation or by the implementing regulation.

*Article 58***Optional translations**

The proprietor of the patent shall have the option of producing and filing with the Office a translation of his patent in several or all of the official languages of the Member States which are official languages of the Community. Those translations shall be made available to the public by the Office.

*Article 59***Implementing regulation**

1. The rules implementing this Regulation shall be adopted in an implementing regulation.

2. The implementing regulation shall be adopted and amended in accordance with the procedure laid down in Article 61(2).

*Article 60***Rules relating to fees**

1. The rules relating to fees shall determine the annual renewal fees, including additional fees, the amounts of the fees and the ways in which they are to be paid.

2. The rules relating to fees shall be adopted and amended in accordance with the procedure referred to in Article 61(2).

*Article 61***Establishment of a committee and procedure for the adoption of the implementing regulations**

1. The Commission shall be assisted by a committee, the Committee for issues relating to fees and to the rules for the implementation of the Regulation on the Community patent, composed of representatives of the Member States and chaired by the representative of the Commission.

2. Where reference is made to this paragraph, the regulatory procedure laid down in Article 5 of Decision 1999/468/EC shall apply, in compliance with Article 7 thereof.

3. The period provided for in Article 5(6) of Decision 1999/468/EC shall be three months.

*Article 62*

**Report on the implementation of this Regulation**

Every five years from the date on which this Regulation enters into force, the Commission shall publish a report on its implementation. In particular, the report shall focus on the impact of the costs incurred in obtaining and renewing the Community patent and the effect of the litigation system in respect of infringement and validity.

*Article 63*

**Entry into force**

1. This Regulation shall enter into force on the sixtieth day following that of its publication in the *Official Journal of the European Communities*.

2. Applications for a Community patent may be filed with the Office from the date laid down in a Commission Decision in accordance with the procedure referred to in Article 61(2).

This Regulation shall be binding in its entirety and directly applicable in all Member States.

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