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*Committee on Legal Affairs*

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**2011/0093(COD)**

6.12.2011

# **COMPROMISE AMENDMENTS**

## **1 - 31**

**Draft report**  
**Bernhard Rapkay**  
(PE472.059v02-00)

Proposal for a regulation of the European Parliament and of the Council  
implementing enhanced cooperation in the area of the creation of unitary patent  
protection

Proposal for a regulation  
(COM(2011)0215 – C7-0099/2011 – 2011/0093(COD))

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**EN**

*United in diversity*

**EN**

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**Amendment 1**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Recital 7**

*Text proposed by the Commission*

(7) The creation of unitary patent protection should be achieved by giving unitary effect to European patents in the post-grant phase by virtue of this Regulation and in respect of the participating Member States. The main feature of European patents with unitary effect should be their unitary character, i.e. providing uniform protection and having equal effect in all participating Member States. Consequently, a European patent with unitary effect should only be limited, ***licensed***, transferred, revoked or lapse in respect of all the participating Member States. To ensure the uniform substantive scope of protection conferred by unitary patent protection, only European patents that have been granted for all the participating Member States with the same set of claims should benefit from unitary effect. ***However, to ensure legal certainty in the event of a limitation or revocation on the ground of lack of novelty pursuant to Article 54(3) EPC, the limitation or revocation of a European patent with unitary effect should take effect only in respect of the participating Member State(s) designated in the earlier European patent application as published.*** Finally, the unitary effect attributed to a European patent should have an accessory nature and should cease to exist or be limited to the extent that the basic European patent has been revoked or limited.

*Amendment*

(7) The creation of unitary patent protection should be achieved by giving unitary effect to European patents in the post-grant phase by virtue of this Regulation and in respect of ***all*** the participating Member States. The main feature of European patents with unitary effect should be their unitary character, i.e. providing uniform protection and having equal effect in all participating Member States. Consequently, a European patent with unitary effect should only be limited, transferred, revoked or lapse in respect of all the participating Member States. ***It should be possible for a European patent with unitary effect to be licensed in respect of the whole or part of the territories of the participating Member States.*** To ensure the uniform substantive scope of protection conferred by unitary patent protection, only European patents that have been granted for all the participating Member States with the same set of claims should benefit from unitary effect. Finally, the unitary effect attributed to a European patent should have an accessory nature and should cease to exist or be limited to the extent that the basic European patent has been revoked or limited.

Or. en

**Amendment 2**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Recital 9 a (new)**

*Text proposed by the Commission*

*Amendment*

***(9a) The matter of compulsory licences is not covered by this Regulation. Compulsory licences for European patents with unitary effect should be governed by the national legislations of the participating Member States on their respective territories.***

Or. en

**Amendment 3**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Recital 11 a (new)**

*Text proposed by the Commission*

*Amendment*

***(11a) The regime applicable to damages should be governed by the law of the participating Member States, in particular the provisions implementing Article 13 of Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights.***

Or. en

**Amendment 4**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Recital 15 a (new)**

*Text proposed by the Commission*

*Amendment*

***(15a) In the framework of the Select Committee, the participating Member States should ensure the governance and supervision of the activities related to the tasks entrusted to the European Patent Office by the participating Member States, ensure that requests for unitary effect are filed with the European Patent Office within one month of the date of the publication of the mention of the grant in the European Patent Bulletin and ensure that they are submitted in the language of the proceedings before the European Patent Office together with the translation prescribed for, during a transitional period, by Council Regulation.../... [translation arrangements]. The participating Member States should also ensure the setting, in accordance with the voting arrangements in Article 35(2) of the EPC, of the level of the renewal fees and the share of the distribution of the renewal fees in accordance with the criteria set out in this Regulation.***

Or. en

**Amendment 5**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Recital 16**

*Text proposed by the Commission*

*Amendment*

(16) Patent proprietors should pay one common annual renewal fee for European patents with unitary effect. Renewal fees should be progressive throughout the term of the patent protection and, together with

(16) Patent proprietors should pay one common annual renewal fee for European patents with unitary effect. Renewal fees should be progressive throughout the term of the patent protection and, together with

the fees to be paid to the European Patent Organisation during the pre-grant stage, should cover all costs associated with the grant of the European patent and the administration of the unitary patent protection. The level of the renewal fees should be fixed with the aim of facilitating innovation and fostering the competitiveness of European businesses. It should also reflect the size of the market covered by the patent and be similar to the level of the national renewal fees for an average European patent taking effect in the participating Member States at the time where the level of the renewal fees is first fixed *by the Commission*.

the fees to be paid to the European Patent Organisation during the pre-grant stage, should cover all costs associated with the grant of the European patent and the administration of the unitary patent protection. The level of the renewal fees should be fixed with the aim of facilitating innovation and fostering the competitiveness of European businesses *taking into account the situation of specific entities such as small and medium-sized enterprises for example in the form of lower fees*. It should also reflect the size of the market covered by the patent and be similar to the level of the national renewal fees for an average European patent taking effect in the participating Member States at the time where the level of the renewal fees is first fixed.

Or. en

## **Amendment 6** **Bernhard Rapkay**

### **Proposal for a regulation** **Recital 18**

#### *Text proposed by the Commission*

(18) Renewal fees should be paid to the European Patent Organisation. ***50 percent thereof minus expenses incurred by the European Patent Office in carrying out tasks in relation to the unitary patent protection shall*** be distributed among the participating Member States, which should be used for patent-related purposes. The share of distribution should be set on the basis of fair, equitable and relevant criteria namely the level of patent activity and the size of the market. The distribution should provide compensation for having an official language other than one of the

#### *Amendment*

(18) Renewal fees should be paid to the European Patent Organisation. ***The European Patent Office shall retain an amount to cover the expenses generated at the European Patent Office in carrying out tasks in relation to the unitary patent protection in accordance with Article 146 EPC. The remaining amount shall*** be distributed among the participating Member States, which should be used for patent-related purposes. The share of distribution should be set on the basis of fair, equitable and relevant criteria namely the level of patent activity and the size of

official languages of the European Patent Office, having a disproportionately low level of patenting activity and having acquired membership of the European Patent Organisation relatively recently.

the market *and should guarantee a minimum amount to be redistributed to each participating Member State in order to maintain a balanced and sustainable functioning of the system*. The distribution should provide compensation for having an official language other than one of the official languages of the European Patent Office, having a disproportionately low level of patenting activity *established on the basis of the European Innovation Scoreboard (EIS)* and having acquired membership of the European Patent Organisation relatively recently.

Or. en

**Amendment 7**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Recital 21 a (new)**

*Text proposed by the Commission*

*Amendment*

*(21a) The jurisdiction for European patents with unitary effect should be established and governed by an instrument setting up a unified patent litigation system for European patents and European patents with unitary effect.*

Or. en

**Amendment 8**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Recital 21 b (new)**

*Text proposed by the Commission*

*Amendment*

*(21b) In order to ensure the proper functioning of the European patent with unitary effect, the consistency of the case-law and hence legal certainty, and the cost effectiveness for patent holders, the establishment of a Unified Patent Court to hear cases concerning the European patent with unitary effect is essential. It is therefore of paramount importance that the participating Member States ratify the Agreement on a Unified Patent Court in accordance with their national constitutional and parliamentary procedures and take the necessary steps for that Court to be operational as soon as possible.*

Or. en

**Amendment 9**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 3 – paragraph 1 – subparagraph 1**

*Text proposed by the Commission*

*Amendment*

European patents granted with ***an identical scope of protection*** in respect of all participating Member States shall benefit from unitary effect in the participating Member States provided that their unitary effect has been registered in the Register for unitary patent protection referred to in ***Article 12(1)(b)***.

European patents granted with ***the same set of claims*** in respect of all ***the*** participating Member States shall benefit from unitary effect in the participating Member States provided that their unitary effect has been registered in the Register for unitary patent protection ***referred to in Article 2(da)***.

Or. en



**Amendment 10**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 3 – paragraph 2 – subparagraph 2**

*Text proposed by the Commission*

*Without prejudice to Article 5*, a European patent with unitary effect may only be limited, **licensed**, transferred, revoked or lapse in respect of all the participating Member States.

*Amendment*

A European patent with unitary effect may only be limited, transferred, revoked or lapse in respect of all the participating Member States.

***A European patent with unitary effect may be licensed in respect of the whole or part of the territories of the participating Member States.***

Or. en

**Amendment 11**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 4 – paragraph 2**

*Text proposed by the Commission*

2. The participating Member States shall take the necessary measures to ensure that, where the unitary effect of a European patent has been registered, the European patent is deemed not to have taken effect as a national patent in their territory on the date of the publication of the mention of the grant in the European Patent Bulletin.

*Amendment*

2. The participating Member States shall take the necessary measures to ensure that, where the unitary effect of a European patent has been registered ***and extends to their territory***, the European patent is deemed not to have taken effect as a national patent in their territory on the date of the publication of the mention of the grant in the European Patent Bulletin.

Or. en

**Amendment 12**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 6 – point b**

*Text proposed by the Commission*

(b) using a process which is the subject matter of the patent or, where the third party knows, or should have known, 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 participating Member States;

*Amendment*

(b) using a process which is the subject matter of the patent or, where the third party knows, or should have known, 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 ***territory of the*** participating Member States ***in which that patent has unitary effect***;

Or. en

**Amendment 13**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 7 – paragraph 1**

*Text proposed by the Commission*

1. The European patent with unitary effect shall confer on its proprietor the right to prevent any third party from supplying or offering to supply within the participating Member States any person ***without the proprietor's consent***, other than a party 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 should have known, that those means are suitable and intended for putting that invention into effect.

*Amendment*

1. The European patent with unitary effect shall confer on its proprietor the right to prevent any third party ***not having the proprietor's consent*** from supplying or offering to supply, within the participating Member States ***in which that patent has unitary effect***, any person other than a party 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 should have known, that those means are suitable and intended for putting that invention into effect.

Or. en

**Amendment 14**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 8 – point e**

*Text proposed by the Commission*

(e) the use on board vessels of countries other than participating 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 participating Member States, provided that the invention is used there exclusively for the needs of the vessel;

*Amendment*

(e) the use on board vessels of countries other than participating Member States ***in which that patent has unitary effect*** 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 participating Member States ***in which that patent has unitary effect***, provided that the invention is used there exclusively for the needs of the vessel;

Or. en

**Amendment 15**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 8 – point f**

*Text proposed by the Commission*

(f) the use of the patented invention in the construction or operation of aircraft or land vehicles or other means of transport of States other than participating Member States, or of accessories to such aircraft or land vehicles, when these temporarily or accidentally enter participating Member States;

*Amendment*

(f) the use of the patented invention in the construction or operation of aircraft or land vehicles or other means of transport of States other than participating Member States ***in which that patent has unitary effect***, or of accessories to such aircraft or land vehicles, when these temporarily or accidentally enter ***the territory of the*** participating Member States ***in which that patent has unitary effect***;

Or. en

**Amendment 16**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 8 – point g**

*Text proposed by the Commission*

(g) 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 participating Member State;

*Amendment*

(g) 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 participating Member State ***in which that patent has unitary effect;***

Or. en

**Amendment 17**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 9**

*Text proposed by the Commission*

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

*Amendment*

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

Or. en

**Amendment 18**  
**Bernhard Rapkay**

## Proposal for a regulation

### Article 10 – paragraph 1 – introductory wording

*Text proposed by the Commission*

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, according to the European Patent Register:

*Amendment*

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*** in which, according to the European Patent Register:

Or. en

## Amendment 19

**Bernhard Rapkay**

## Proposal for a regulation

### Article 10 – paragraph 3

*Text proposed by the Commission*

3. Where no proprietor has his/her residence or *a* place of business in a participating Member State for the purposes of paragraphs 1 or 2, the European patent with unitary effect as an object of property shall be dealt with in its entirety and in all the participating Member States as a national patent of the State where the European Patent Organisation has its headquarters in accordance with Article 6(1) of the EPC.

*Amendment*

3. Where no proprietor has his/her residence, ***principal place of business*** or place of business in a participating Member State ***in which that patent has unitary effect*** for the purposes of paragraphs 1 or 2, the European patent with unitary effect as an object of property shall be dealt with in its entirety and in all the participating Member States as a national patent of the State where the European Patent Organisation has its headquarters in accordance with Article 6(1) of the EPC.

Or. en

## Amendment 20

**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 12 – title**

*Text proposed by the Commission*

***Implementation by the participating  
Member States***

*Amendment*

***Administrative tasks in the framework of  
the European Patent Organisation***

Or. en

**Amendment 21**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 12 – paragraph 1 – subparagraph 1 – point e**

*Text proposed by the Commission*

(e) the collection and administration of renewal fees for European patents with unitary effect, in respect of the years following the year in which the ***Register referred to in point b)*** mentions their grant; the collection and administration of additional fees paid in cases of late payment of renewal fees within six months of the due date, as well as the distribution of a part of the collected renewal fees to the participating Member States; and

*Amendment*

(e) the collection and administration of renewal fees for European patents with unitary effect, in respect of the years following the year in which the ***European Patent Bulletin*** mentions their grant; the collection and administration of additional fees paid in cases of late payment of renewal fees within six months of the due date, as well as the distribution of a part of the collected renewal fees to the participating Member States; and

Or. en

**Amendment 22**  
**Bernhard Rapkay**

**Proposal for a regulation**

**Article 12 – paragraph 1 – subparagraph 1 – point f a (new)**

*Text proposed by the Commission*

*Amendment*

***(fa) ensuring that requests by the patent proprietor for unitary effect for a European patent are submitted in the language of the proceedings as defined in Article 14(3) of the EPC no later than one month after the mention of the grant is published in the European Patent Bulletin;***

Or. en

**Amendment 23**

**Bernhard Rapkay**

**Proposal for a regulation**

**Article 12 – paragraph 1 – subparagraph 1 – point f b (new)**

*Text proposed by the Commission*

*Amendment*

***(fb) ensuring that the unitary effect is indicated in the Register for unitary patent protection, where a request for unitary effect has been filed and, during the transitional period provided for in Article 6 of Council Regulation .../... [translation arrangements], has been submitted together with the translations referred to in that Article and that the European Patent Office is informed of any limitations, licenses, transfers and revocations of European patents with unitary effect.***

Or. en

**Amendment 24**

**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 12 – paragraph 2**

*Text proposed by the Commission*

2. In their capacity as Contracting States to the EPC, the participating Member States shall ensure the governance and supervision of the activities related to the tasks referred to in paragraph 1 by the European Patent Office. To that end they shall set up a Select Committee of the Administrative Council of the European Patent Organisation within the meaning of Article 145 of the EPC.

*Amendment*

**2. *Member States shall ensure compliance with the provisions of this Regulation in implementing their international obligations undertaken in the EPC and shall cooperate amongst themselves to that end.*** In their capacity as Contracting States to the EPC, the participating Member States shall ensure the governance and supervision of the activities related to the tasks referred to in paragraph 1 by the European Patent Office ***and shall ensure the setting of the level of renewal fees in accordance with Article 15 and the setting of the share of distribution of the renewal fees in accordance with Article 16.***

To that end they shall set up a Select Committee of the Administrative Council of the European Patent Organisation within the meaning of Article 145 of the EPC.

***The Select Committee of the Administrative Council shall consist of the representatives of the Member States and a representative of the Commission as an observer, as well as alternates who will represent them in their absence. The members of the Select Committee may be assisted by advisers or by experts.***

***Decisions of the Select Committee of the Administrative Council shall be taken with due regard for the position of the Commission and in accordance with the rules set out in Article 35(2) of the EPC.***

Or. en

**Amendment 25**  
**Bernhard Rapkay**



**Proposal for a regulation**  
**Article 12 – paragraph 3**

*Text proposed by the Commission*

3. The participating Member States shall ensure effective legal protection before a ***national*** court against the decisions of the European Patent Office in carrying out the tasks referred to in paragraph 1.

*Amendment*

3. The participating Member States shall ensure effective legal protection before a ***competent court of one or several participating Member States*** against the decisions of the European Patent Office in carrying out the tasks referred to in paragraph 1.

Or. en

**Amendment 26**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 15 – paragraph 2 – introductory wording**

*Text proposed by the Commission*

2. The level of the renewal fees shall be fixed with the aim of

*Amendment*

2. The level of the renewal fees, shall be fixed, ***taking into account, among others, the situation of specific entities such as small and medium-sized enterprises,*** with the aim of

Or. en

**Amendment 27**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 15 – paragraph 3 – introductory wording**

*Text proposed by the Commission*

3. In order to reach these objectives set out in this Chapter, ***the Commission shall set*** the level of renewal fees at a level that

*Amendment*

3. In order to reach these objectives set out in this Chapter, the level of renewal fees ***shall be set*** at a level that:

**Amendment 28**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 16 – paragraph 1**

*Text proposed by the Commission*

**1. The part of the collected renewal fees to be distributed to the participating Member States referred to in Article 12(1)(e) shall be 50 percent of the renewal fees referred to in Article 14 paid for European patents with unitary effect *minus the costs associated with the administration of the unitary patent protection referred to in Article 12.***

*Amendment*

**1. The European Patent Office shall retain 50 percent of the renewal fees referred to in Article 14 paid for European patents with unitary effect. *The remaining amount shall be distributed to the participating Member States in accordance with the share of distribution of the renewal fees set in accordance with Article 12(2).***

**Amendment 29**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 21**

*Text proposed by the Commission*

The participating Member States shall notify the Commission of the measures adopted in accordance with **Articles 4(2) and 12** by the date set in Article 22(2).

*Amendment*

**1.** The participating Member States shall notify the Commission of the measures adopted in accordance with **Article 12** by the date set in Article 22(2).

**1a. Each participating Member State shall notify the Commission of the measures adopted in accordance with Article 4(2) by the date of application of this Regulation or, in the case of a participating Member State in which the Unified Patent Court does not have exclusive jurisdiction with regard to European patents with unitary**

*effect on the date of application of this Regulation, the date from which the Unified Patent Court has such exclusive jurisdiction in that participating Member State.*

Or. en

**Amendment 30**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 22 – paragraph 2**

*Text proposed by the Commission*

2. It shall apply *from [a specific date will be set and it will coincide with the date of application of Council Regulation .../... on the implementation of enhanced cooperation in the area of the creation of unitary patent protection with regard to the applicable translation arrangements].*

*Amendment*

2. It shall apply from *1 January 2014 or the date of entry into force of the Agreement on a Unified Patent Court, whichever is the later.*

*By way of derogation from Articles 3(1)-(2) and 4(1), a European patent for which unitary effect is registered in the Register for unitary patent protection referred to in Article 2(da) shall have unitary effect only in those participating Member States in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date of registration.*

*2a. Each participating Member State shall notify the Commission of its ratification of the Agreement at the time of deposit of its ratification instrument. The Commission shall publish the date of entry into force of the Agreement and a list of the Member States who have ratified the Agreement at the date of entry into force in the Official Journal of the European Union. The Commission shall thereafter regularly update the list of the*

*participating Member States which have ratified the Agreement and publish it in the Official Journal.*

Or. en

**Amendment 31**  
**Bernhard Rapkay**

**Proposal for a regulation**  
**Article 22 – paragraph 4**

*Text proposed by the Commission*

**4.** Unitary patent protection may be requested for any European patent granted on or after the date set out in paragraph 2.

*Amendment*

**4a.** Unitary patent protection may be requested for any European patent granted on or after the date set out in *the first subparagraph of* paragraph 2.

Or. en