

SUBJECT: Draft Rules relating to Unitary Patent Protection

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 has been issued in electronic form only.

TABLE OF CONTENTS

Subject		Page
PART I	INSTITUTIONAL PROVISIONS	2
CHAPTER I	SUBJECT MATTER AND DEFINITIONS	2
Rule 1	Subject matter	2
CHAPTER II	SELECT COMMITTEE OF THE ADMINISTRATIVE COUNCIL	2
Rule 2	Competences and duties	2
CHAPTER III	FUNCTIONS AND POWERS OF THE PRESIDENT OF THE EUROPEAN PATENT OFFICE	3
Rule 3	Functions and powers of the President of the European Patent Office	3
PART II	PROCEDURES TO BE CARRIED OUT BY THE EUROPEAN PATENT OFFICE UNDER REGULATIONS (EU) NO 1257/2012 AND NO 1260/2012	3
CHAPTER I	THE REQUEST FOR UNITARY EFFECT	3
Rule 4	General	3
Rule 5	Requirements of the request for unitary effect	4
Rule 6	Examination of the request by the European Patent Office	4
CHAPTER II	LICENCES OF RIGHT	5
Rule 7	Filing of the statement by the patent proprietor	5
Rule 8	Declaration of use	6
CHAPTER III	RENEWAL FEES	6
Rule 9	Payment of renewal fees for European patents with unitary effect	6
CHAPTER IV	SURRENDER AND LAPSE	7
Rule 10	Surrender	7
Rule 11	Lapse	8
PART III	INFORMATION TO THE PUBLIC	8
CHAPTER I	REGISTER FOR UNITARY PATENT PROTECTION	8
Rule 12	Establishment of the Register for unitary patent protection	8
Rule 13	Entries in the Register for unitary patent protection	9
CHAPTER II	PUBLICATIONS	10

Rule 14	European Patent Bulletin and Official Journal of the European Patent Office	10
Rule 15	Publication of translations	10
Rule 16	Publication of a new specification	11
PART IV	COMMON PROVISIONS	11
Rule 17	Common provisions governing procedure	11
Rule 18	Re-establishment of rights	12
Rule 19	Form of decisions	13
Rule 20	Interlocutory revision	13
PART V	FINANCIAL ISSUES	14
Rule 21	Cover for expenditure incurred by the European Patent Office	14
ANNEX 1	EXPLANATORY REMARKS	15

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 AND DEFINITIONS**

Rule 1 **Subject matter**

(1) The participating Member States hereby entrust the European Patent Office with the tasks referred to in Article 9 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(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.

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) 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.

(3) The Select Committee shall ensure the governance and supervision of the activities related to the tasks entrusted to the European Patent Office.

CHAPTER III FUNCTIONS AND POWERS OF THE PRESIDENT OF THE EUROPEAN PATENT OFFICE

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

(1) 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 to amend the present Rules, 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) Article 10, paragraph 2(a), (b), (e) to (i) and paragraph 3, EPC shall apply *mutatis mutandis*.

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 4 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

(a) with the same set of claims

(b) in respect of all the participating Member States in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date [on which the mention of the grant of the European patent is published in the European Patent Bulletin] [of registration of the unitary effect].

Rule 5 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 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 Examination of the request by the European Patent Office

(1) If the requirements under Rule 4, paragraph 2, are met and the request for unitary effect complies with Rule 5, 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 4, paragraph 2, are not met or the request for unitary effect does not comply with Rule 5, paragraph 1, the European Patent Office shall reject the request.

(3) If the requirements under Rule 4, paragraph 2, are met and the request for unitary effect complies with Rule 5, paragraph 1, but fails to comply with the requirements of

Rule 5, 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.

CHAPTER II LICENCES OF RIGHT

Rule 7 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) Where there is a complete change of proprietorship of the patent as a result of legal proceedings, the statement shall be deemed withdrawn upon the entry of the name of the person entitled to the patent in the Register for unitary patent protection.

(3) The statement referred to in paragraph 1 may be withdrawn at any time by a communication to this effect to the European Patent Office, provided that no-one has made a declaration of use in accordance with Rule 8, paragraph 1. Such withdrawal shall take effect from the date of its receipt by the European Patent Office. The amount by which the renewal fees were reduced shall be paid within one month after withdrawal; Rule 9, paragraph 3, shall apply, but the six-month period shall start upon expiry of said one-month period.

(4) 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.

(5) On the basis of the statement referred to in paragraph 1, any person shall be entitled to use the invention as a licensee under the conditions laid down in Rule 8.

(6) 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 Declaration of use

(1) Any person who wishes to use the invention after a statement provided for in Rule 7 has been filed shall declare his intention to the proprietor of the European patent with unitary effect by registered letter. The declaration shall be deemed to have been made on the tenth day following the posting of the registered letter. A copy of this declaration, stating the date on which the declaration was posted, shall be sent to the European Patent Office. Failing this, the European Patent Office shall, in the event of withdrawal of the statement referred to in Rule 7, paragraph 3, consider the declaration not to have been made.

(2) The declaration shall state how the invention is to be used. After the declaration has been made, the person making it shall be entitled to use the invention in the way he has stated.

(3) The licensee shall be obliged at the end of every quarter of a calendar year to report to the proprietor of the European patent with unitary effect on the use made thereof and to pay the compensation therefor. If this obligation is not complied with, the proprietor of the European patent with unitary effect may lay down a further suitable time limit for this purpose. If the time limit is not observed, the licence shall expire.

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 after 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 from that latter date may still be paid within four months of that latter date without an additional fee. Paragraph 3 shall apply.

CHAPTER IV SURRENDER AND LAPSE

Rule 10 Surrender

(1) The European patent with unitary effect may be surrendered only in its entirety.

(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.

(3) The European Patent Office shall register the surrender of the European patent with unitary effect only if the proprietor of the patent has previously informed any registered licensee of his intention to surrender.

(4) The entry in the Register for unitary patent protection under paragraph 3 shall be made on expiry of three months from the date on which the proprietor of the European patent with unitary effect has proved to the European Patent Office that he has informed any registered licensee of his intention to surrender. If, before expiry of that period, the proprietor of the European patent with unitary effect proves to the European Patent Office that any registered licensee agrees to the surrender, it may be entered immediately.

(5) Surrender shall be entered in the Register for unitary patent protection only with the agreement of any third party who has a right *in rem* recorded in the Register for unitary patent protection.

Rule 11 Lapse

(1) The 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;

(c) if a renewal fee 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 date on which the renewal fee was due.

PART III INFORMATION TO THE PUBLIC

CHAPTER I REGISTER FOR UNITARY PATENT PROTECTION

Rule 12 Establishment of the Register for unitary patent protection

(1) The Register for unitary patent protection provided for in Article 9, paragraph 1(b), Regulation (EU) No 1257/2012 is hereby established as a special part of the European Patent Register kept by the European Patent Office under Article 127 EPC.

(2) Entries in the Register for unitary patent protection shall be made in the three official languages of the European Patent Office. In case of doubt, the entry in the language of the proceedings shall be authentic.

Rule 13 Entries in the Register for unitary patent protection

- (1) The Register for unitary patent protection shall contain the following entries:
- (a) date of publication of the mention of the grant of the European patent;
 - (b) date of filing of the request for unitary effect for the European patent;
 - (c) particulars of the representative of the proprietor of the patent as provided in Rule 41, paragraph 2(d), EPC; in the case of several representatives, only the particulars of the representative first named, followed by the words "and others" and, in the case of an association referred to in Rule 152, paragraph 11, EPC, only the name and address of the association;
 - (d) date and purport of the decision on the grant of unitary effect for the European patent;
 - (e) date of registration of the unitary effect of the European patent;
 - (f) particulars of the proprietor of the European patent with unitary effect as provided for in Rule 41, paragraph 2(c), EPC;
 - (g) licences and any other rights, and transfer of such rights relating to the European patent with unitary effect, as well as licensing commitments undertaken by the proprietor of a European patent with unitary effect in international standardisation bodies;
 - (h) date of lapse of the European patent with unitary effect;
 - (i) data as to the payment of renewal fees for the European patent with unitary effect;
 - (j) date of filing or withdrawal of the statement provided for in Rule 7 and the date of the declaration of use provided for in Rule 8;
 - (k) particulars of matters regarding entitlement proceedings regarding the European patent with unitary effect (the fact that they have been instituted, date and purport of the final decision);

(l) a record of the information communicated to the European Patent Office concerning proceedings before the Unified Patent Court;

(m) date and purport of the decision on limitations or revocations of a European patent with unitary effect taken by the Unified Patent Court;

(n) date of receipt of request for re-establishment of rights;

(o) refusal of request for re-establishment of rights;

(p) date of re-establishment of rights;

(q) dates of interruption and resumption of proceedings;

(r) dates of stay and resumption of proceedings.

(2) The President of the European Patent Office may decide that entries other than those referred to in paragraph 1 shall be made in the Register for unitary patent protection.

CHAPTER II PUBLICATIONS

Rule 14 European Patent Bulletin and Official Journal of the European Patent Office

(1) The European Patent Bulletin referred to in Article 129(a) EPC shall contain, as a special part, the particulars the publication of which is prescribed by the present Rules or the President of the European Patent Office.

(2) The Official Journal referred to in Article 129(b) EPC shall contain, as a special part, notices and information of a general character issued by the President of the European Patent Office under Rule 3, as well as any other information relevant to the implementation of unitary patent protection.

Rule 15 Publication of translations

The President of the European Patent Office shall determine the form of the publication of the translations referred to in Rule 5, paragraph 2(d), and the data to be included.

Rule 16 **Publication of a new specification**

(1) If a European patent with unitary effect is maintained in amended form by the Unified Patent Court, the European Patent Office shall publish a new specification of the European patent with unitary effect as soon as possible after the mention of the limitation has been registered in the Register for unitary patent protection.

(2) The President of the European Patent Office shall determine the content and form of this publication.

PART IV **COMMON PROVISIONS**

Rule 17 **Common provisions governing procedure**

(1) The following provisions of the EPC shall apply *mutatis mutandis*:

Article 14, paragraphs 1, 3 and 7; Article 113, paragraph 1; Article 114; Articles 117 to 120; Article 125; Article 128, paragraph 4; Articles 131, 133 and 134 EPC.

(2) The following provisions of the Implementing Regulations to the EPC shall apply *mutatis mutandis*:

- (a) Rules 1, 2 and 5 EPC;
- (b) unless otherwise provided Rule 3, paragraph 1, first sentence, EPC;
- (c) Rule 3, paragraph 3, EPC;
- (d) Rule 15 EPC;
- (e) Rules 22 to 24 EPC;
- (f) Rule 50, paragraphs 2 and 3, EPC;
- (g) Rule 51, paragraphs 4 and 5, EPC;
- (h) Rules 112 and 113 EPC;
- (i) Rules 117 to 131 EPC;
- (j) Rule 134 EPC;
- (k) Rules 139 and 140 EPC;
- (l) Rule 142 EPC;
- (m) Rules 144 to 154 EPC.

(3) Rule 14 EPC shall apply *mutatis mutandis* subject to the proviso that the time limit still to run after the resumption referred to in Rule 14, paragraph 4, EPC shall not be less than one month where the interrupted time limit is that specified in Rule 5, paragraph 1.

(4) Where the EPC or the present Rules refer to "a period to be specified", this period shall be specified by the European Patent Office. Unless otherwise provided, a period specified by the European Patent Office shall be neither less than one month nor more than four months.

(5) Rule 133, paragraph 1, EPC shall apply *mutatis mutandis* subject to the proviso that the document referred to in that provision has been received no later than one month after expiry of the period.

Rule 18 Re-establishment of rights

(1) A proprietor of a European patent or of a European patent with unitary effect who, in spite of all due care required by the circumstances having been taken, was unable to observe a time limit vis-à-vis the European Patent Office shall have his rights re-established upon request if the non-observance of this time limit has the direct consequence of causing the European patent with unitary effect to lapse according to Rule 11, paragraph 1(c), of the present Rules or the loss of any other right or means of redress.

(2) Any request for re-establishment of rights under paragraph 1 shall be filed in writing within two months of the removal of the cause of non-compliance with the period, but at the latest within one year of expiry of the unobserved time limit. However, a request for re-establishment of rights in respect of the period specified in Rule 5, paragraph 1, shall be filed within two months of expiry of that period. The request for re-establishment of rights shall not be deemed to have been filed until the prescribed fee has been paid.

(3) The request shall state the grounds on which it is based and shall set out the facts on which it relies. The omitted act shall be completed within the relevant period for filing the request according to paragraph 2.

(4) The European Patent Office shall grant the request, provided that the conditions laid down in the present Rule are met. Otherwise, it shall reject the request.

(5) If the request is granted, the legal consequences of the failure to observe the time limit shall be deemed not to have ensued.

(6) Re-establishment of rights shall be ruled out in respect of the time limit for requesting re-establishment of rights and in respect of the period referred to in Rule 6, paragraph 3.

(7) Any person who has in good faith used or made effective and serious preparations for using an invention which is the subject of a European patent with unitary effect in the period between the loss of rights referred to in paragraph 1 and publication in the Register for unitary patent protection of the mention of re-establishment of those rights may without payment continue such use in the course of his business or for the needs thereof in the participating Member States.

Rule 19 Form of decisions

Decisions of the European Patent Office against which actions can be brought before the Unified Patent Court in accordance with Article 32(1)(i) Agreement on a Unified Patent Court shall be reasoned and shall be accompanied by a communication pointing out the possibility of bringing an action before the Unified Patent Court. The parties may not invoke the omission of the communication.

Rule 20 Interlocutory revision

If the European Patent Office is informed by the Unified Patent Court that an action against a decision of the European Patent Office is admissible and if it considers that the action is well founded, it shall within three months of the date of the contested decision

(a) rectify the contested decision in accordance with the order or remedy sought by the plaintiff, and

(b) inform the Unified Patent Court and the plaintiff that the decision has been rectified.

PART V

FINANCIAL ISSUES

Rule 21

Cover for expenditure incurred by the European Patent Office

(1) The costs incurred by the European Patent Office in carrying out the tasks entrusted to it in accordance with Article 9, paragraph 1, Regulation (EU) No 1257/2012 have to be borne by the participating member states pursuant to Article 146 EPC and have to be covered by the renewal fees generated by the European patent with unitary effect pursuant to Article 10 Regulation (EU) No 1257/2012.

(2) In case the application of paragraph 1 does not lead to a balance of income and expenditure, the relevant provisions of the EPC shall apply.

(3) The implementation of paragraphs 1 and 2 shall ensure cost neutral performance of the tasks entrusted to the EPO. It shall be governed by the EPO's Financial Regulations.

ANNEX 1 EXPLANATORY REMARKS

Explanatory remarks to 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 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.

Explanatory remarks to 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, as well as its own Rules of Procedure (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) 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 will be laid down in the Rules of Procedure of the Select Committee.

Explanatory remarks to Rule 3: Functions and powers of the President of the EPO

1. Proposed Rule 3 just reiterates and clarifies the President's functions as provided for in the EPC: paragraphs (1)(a) and (1)(b) clarify what the *mutatis mutandis* application of Article 10(2)(c) (right of initiative) and (d) (preparation and implementation of the budget) EPC means for the purpose of the present rules. Instead of enumerating all the remaining functions and powers set out in Article 10(2)(3) EPC, proposed Rule 3(2) reproduces the content of Article 143(2) EPC, namely that Article 10(2)(a)(b)(e) to (i) and (3) EPC shall apply *mutatis mutandis*.

Explanatory remarks to Rule 4: 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 (see Rule 17(2), which provides that Rule 151 EPC applies *mutatis mutandis*).
3. Paragraph 2 sets out the "substantive" requirements for obtaining unitary effect in accordance with Articles 3(1) and 18(2) Regulation (EU) No 1257/2012. Unitary effect can thus only be registered if the European patent has been granted
 - (a) with the same set of claims
 - (b) in respect of all the participating member states in which the Unified Patent Court has exclusive jurisdiction with regard to European patents with unitary effect at the date on which the mention of the grant of the European patent is published in the European Patent Bulletin.

4. Alternatively, one could provide that the European patent must have been granted in respect of all the 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 of the unitary effect by the EPO. This approach would have the advantage of being more in line with the wording of Article 18(2), second subparagraph, Regulation (EU) No 1257/2012. However, bearing in mind the overriding principle of legal certainty, the requester is entitled to know when filing his request for unitary effect, which member states his right will encompass territorially. The uncertainty and unpredictability as to the potential territorial scope of his right would be even greater in cases where the procedure for registering unitary effect takes a long time owing, for example, to a request for re-establishment of rights with respect to the period for filing the request for unitary effect or to an action brought before the Unified Patent Court.
5. Where one of the two requirements set out in paragraph 2, 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.
6. No express authorisation to introduce a specific fee for the request for unitary effect has been included: such a fee would constitute a supplementary requirement not provided for by Regulation (EU) No 1257/2012 and could unnecessarily complicate the procedure for requesting unitary effect.

Explanatory remarks to Rule 5: Requirements of the request for unitary effect

1. Rule 5 sets out the formal requirements for obtaining unitary effect, as opposed to the "substantive" requirements set out in Rule 4(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 the EPO can register unitary effect as soon as possible after grant if all the requirements are met.

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 5(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 5(1), see the explanatory remarks on Rule 6 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. It also allows a double check should the patent number indicated by the requester under paragraph 2(b) be erroneous. 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 translation requirement of Article 9(1)(h) Regulation (EU) No 1257/2012 and Article 6(1) Regulation (EU) No 1260/2012.

Explanatory remarks to Rule 6: 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 4(2) and 5, 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 5(1) and the substantive requirements of Rule 4(2) are not met; (b) the request is filed after the expiry of the one-month period of Rule 5(1) and the substantive requirements of Rule 4(2) are met; (c) the request is filed after the expiry of the one-month period of Rule 5(1) and the substantive requirements of Rule 4(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 5 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 5(1) within two months of expiry of that period (see Rule 19(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 5(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 5 above).

5. Paragraph 3 governs the case where the one-month period of Rule 5(1) and the substantive requirements of Rule 4(2) are met but where any of the formal requirements of Rule 5(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).

Explanatory remarks to Rule 7: 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 7(1) – which is largely based on Article 43 CPC 1989 – 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 sets out the consequences of a complete change of proprietorship as a result of entitlement proceedings: the statement will be deemed to be withdrawn. Paragraph 3 specifies that the

statement can be withdrawn by the proprietor at any time provided that no-one has made a declaration of use under Rule 8. In that case, the amount by which the renewal fees were reduced has to be paid to the EPO within one month after withdrawal. Paragraph 4 deals with cases where an exclusive licence is recorded in the register. Paragraph 5 reiterates the effect of the statement and paragraph 6 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 appropriate compensation referred to in Article 8 Regulation (EU) No 1257/2012 and Rule 7(1) if a request for same is made by one of the contracting parties to the licence agreement.

Explanatory remarks to Rule 8: Declaration of use

1. Proposed Rule 8 is modelled on Rule 10 Implementing Regulations to the CPC 1989. It is to a large extent self-explanatory. A person wishing to use the invention for which a statement under Rule 7 has been filed with the EPO has to declare his intention to the proprietor of the European patent with unitary effect by registered letter. It will be deemed to have been made ten days after posting of the registered letter. As to its content, the declaration of use must specify the extent of the intended use, namely a partial or complete use of the invention, or any other geographical or timely limitation. Paragraph 3 imposes a periodical obligation on the licensee to report on the use made of the patent and to pay the compensation therefor. Paragraph 3 also specifies the sanction, i.e. the expiry of the licence, should the obligation not be met.

Explanatory remarks to 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 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*.

5. 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, 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)(5) EPC, which applies *mutatis mutandis*, the renewal fees can be paid within four months after 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.

Explanatory remarks to Rule 10: Surrender

1. The proposed rule is modelled on Article 49 and Rule 12 CPC 1989. In accordance with Article 3(1) Regulation (EU) No 1257, the European patent with unitary effect can only be surrendered in its entirety, i.e. in respect of all the participating member states. Paragraph 2 specifies that procedurally, the surrender has to be made in writing by the proprietor of the European patent with unitary effect.
2. Paragraph 3 states that surrender will only be registered by the EPO if the proprietor of the European patent with unitary effect proves that he has previously informed any registered licensee(s) of his intention to surrender.
3. Where a licence is recorded in the Register for unitary patent protection, it is proposed that an entry concerning surrender should only be made if the proprietor of the European patent with unitary effect proves that he has previously informed the licensee of his intention to surrender (paragraph 3). Paragraph 4 adds that the entry concerning surrender will not be made until three months after the date on which the proprietor of the European patent with unitary effect has proved to the

EPO that he has informed the licensee of his intention to surrender. If, before expiry of that period, the proprietor of the European patent with unitary effect proves to the EPO that the licensee agrees to the surrender, it may be entered immediately.

4. The European patent with unitary effect may be given as security or be the subject of rights *in rem*. Where a right *in rem* is recorded in the Register for unitary patent protection, it is proposed under paragraph 5 that surrender can only be entered in the Register for unitary patent protection with the agreement of the holder of the registered right *in rem*.

Explanatory remarks to 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 (c) 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).
2. It is proposed that the date of effect of the lapse in the case referred to in paragraph 1(c) 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.

Explanatory remarks to Rule 12: Establishment of the Register for unitary patent protection

1. See the explanatory remarks below under Rule 13.

Explanatory remarks to Rule 13: Entries in the Register for unitary patent protection

1. Article 9 Regulation (EU) No 1257/2012 sets out that the participating member states will, within the meaning of Article 143 EPC, give the EPO some additional tasks to be carried out in conformity with the "internal rules" of the EPO. Pursuant to Article 9(1)(b) Regulation (EU) No 1257/2012, these tasks comprise the inclusion of the Register for unitary patent protection (hereinafter "RUPP") within

the European Patent Register and the administration thereof. Article 2(e) Regulation (EU) No 1257/2012, specifies that "Register for unitary patent protection means the register constituting part of the European Patent Register in which the unitary effect and any limitation, licence, transfer, revocation or lapse of a European patent with unitary effect are registered."

2. In accordance with the above provisions, Rule 12 provides that a Register for unitary patent protection is hereby established as an integral but special, i.e. dedicated, part of the present European Patent Register kept by the EPO under Article 127 EPC.
3. For reasons of legal certainty and transparency for the users, the RUPP should be set up as a separate part of the European Patent Register covering all post-grant entries required for the European patent with unitary effect. This will have to be adequately reflected in the online architecture of the European Patent Register/RUPP. It also implies that some of the entries presently contained in the European Patent Register (such as the particulars of the applicant/proprietor, etc.) may have to be duplicated in the RUPP for the sake of clarity and transparency and to avoid too many cross references.
4. The RUPP will have to contain all the entries expressly set out in Regulation (EU) No 1257/2012, in particular the fact that unitary effect has been registered and the date of that registration. However, since the list of entries to the RUPP of Regulation No 1257/2012 is far from being exhaustive, it is proposed that the necessary entries should be set out in addition to those already mentioned in the regulation, the provision serving as model being Rule 143(1) EPC (see also Rule 29 Implementing Regulations to the CPC 1989).
5. Furthermore, for the sake of efficiency, a paragraph 2 is proposed which lays down a provision equivalent to Rule 143(2) EPC allowing the President of the EPO to decide that entries other than those referred to in paragraph 1 be made in the RUPP (see also Article 16(1)(b) CPC 1989).
6. Regulation (EU) No 1257/2012 does not contain any provisions as regards the procedure for registering transfers, licences and other rights, in particular as to the required request, documentary evidence and administrative fee. It is proposed that Rules 22 to 24 EPC should apply *mutatis mutandis* to entries made in the RUPP (see Rule 17(2)). This would ensure full alignment with the procedure governing conventional European patent applications/patents.

7. The particulars of the applicant on the date of filing of the European patent application as provided in Rule 41(2)(c) EPC will be available via online file inspection. This will help to implement Article 7 Regulation (EU) No 1257/2012, which legislates for the European patent with unitary effect as an object of property.

Explanatory remarks to Rule 14: European Patent Bulletin and Official Journal of the EPO

1. Article 129(a) EPC provides that the EPO will periodically publish a European Patent Bulletin containing the particulars the publication of which is prescribed by the EPC, the Implementing Regulations to the EPC or the President of the EPO.
2. Obviously, no reference is presently made in Article 129(a) EPC to the present rules. Thus, a special provision appears necessary which would expressly make that reference and thereby ensure publication of all particulars set out in the present rules in the European Patent Bulletin (which contains bibliographic data as well as data laid down in Rule 143 EPC). As is the case for the Register for unitary patent protection and for file inspection, it would make sense to have a dedicated chapter for unitary patent entries in the European Patent Bulletin.
3. Since the President of the EPO will take decisions pertaining to unitary patent protection under Rule 3, such as including additional entries in the RUPP, the relevant texts will be published in a dedicated chapter of the EPO's Official Journal.

Explanatory remarks to Rule 15: Publication of translations

1. Over a transitional period of a maximum of 12 years starting from the date of application of Regulation (EU) No 1260/2012, a request for unitary effect will have to be submitted together with translations of the specification in accordance with Article 6 of said regulation.
2. Under Article 6(2) Regulation (EU) No 1260/2012, in accordance with Article 9 Regulation (EU) No 1257/2012, the participating member states will, within the meaning of Article 143 EPC, give the EPO the task of publishing the translations referred to in paragraph 1 as soon as possible after the date on which a request for unitary effect is filed. The text of such translations will have no legal value and be for information purposes only.

3. It is proposed that the translations should be published in electronic form. The President of the EPO will be empowered to select an appropriate form for such electronic publication.

Explanatory remarks to Rule 16: Publication of a new specification

1. No separate specification will be issued where unitary effect is attributed to a European patent. However, it may be deemed necessary by the participating member states to create a new form of publication in case the European patent with unitary effect is maintained in amended form by the Unified Patent Court (see Article 59 CPC 1989, as well as Articles 103 and 105c EPC). Under Article 3(3) Regulation (EU) 1257/2012, the unitary effect of a European patent will be deemed not to have arisen to the extent that the European patent has been revoked or limited.
2. According to Article 65(5) Agreement on a Unified Patent Court, where the Court, in a final decision, has revoked a patent, either entirely or partly, it will send a copy of the decision to the EPO and, with respect to a European patent, to the national patent office of any contracting member state concerned.
3. A consistent practice will have to be established by the Unified Patent Court with a view to enabling the EPO to publish a new specification with new claims and an adapted description. The easiest solution would be that the Unified Patent Court, where new claims are being submitted by the patentee, only accepts the use of the EPO language of the proceedings (see Articles 14(3) and 70(1) EPC). Any adaptation of the description should also be made to the specification as published by the EPO in the language of the proceedings.
4. Rule 30(1)(a) (Application to amend the patent) of the draft Rules of procedure of the Unified Patent Court (29 April 2013 – draft 15) reads as follows: "The Defence to the Counterclaim for revocation may include an application by the proprietor of the patent to amend the patent which shall contain (a) the proposed amendments of the claims of the patent concerned and/or specification, including where appropriate one or more alternative sets of claims (auxiliary requests), in the language in which the patent was granted; where the language of the proceedings [Rule 14.2] is not the language in which the patent was granted, the plaintiff shall lodge a translation of the proposed amendments in the language of the proceedings, and where the patent is a European patent with unitary effect in the language of the defendant's domicile if so requested by the defendant."

Explanatory remarks to Rule 17: Common provisions governing procedure

1. **General:** Regulation (EU) 1257/2012 sets out that the participating member states will, within the meaning of Article 143 EPC, give the EPO some additional tasks, to be carried out in accordance with the "internal rules" of the EPO. For the sake of clarity and definiteness, i.e. legal certainty, and since not all procedural rules of the EPC are of relevance in the present context, it is proposed that an exhaustive list of the procedural rules of the EPC (both from the Convention and the Implementing Regulations) that apply for the purpose of the present rules should be provided (see Rule 31 Implementing Regulations to the CPC 1989).
2. **Language regime:** Article 14(1) EPC determines the official languages of the EPO, and Article 14(3) EPC defines the term "language of proceedings". Both provisions are applicable as laid down in Rule 17(1). However, the request for unitary effect has to be filed in the language of proceedings (see Article 9(1)(g) Regulation (EU) No 1257/2012 and Rule 5(2)). This deviates from the EPC regime, where any of the three EPO official languages may be used as a matter of principle in written proceedings (see Rule 3(1) EPC). It is therefore proposed that unless otherwise provided, Rule 3(1), first sentence, EPC (as well as Rule 3(3) EPC) should apply *mutatis mutandis*. As a consequence, as regards the language in written proceedings before the EPO, any party may use any official language of the EPO except for the request for unitary effect itself, which has to be filed in the language of proceedings. In practice, users will complete a dedicated form when requesting unitary effect which will *inter alia* contain the request in the three official languages of the EPO.
3. In order to avoid delays in the straightforward procedure for requesting unitary effect, the EPC provisions allowing documents to be filed within a time limit in an admissible non-EPO language provided that a translation is filed within a month are not applicable (Article 14(4) EPC; Rule 3(1), second sentence, EPC; and Rule 6(2) EPC). As a result, it will for instance not be possible to file a request for re-establishment of rights in an admissible non-EPO language and to file a translation within a month (the situation is, of course, different for proceedings governed by the EPC). In practice, however, this possibility is almost never used when it comes to requests for re-establishment of rights or replying to an invitation from the EPO to rectify a deficiency within a certain period.

4. **File inspection and constitution, maintenance and preservation of files:** Documents relating to the filing of the request for unitary effect for a European patent, the translations referred to in Article 6 Regulation (EU) No 1260/2012, the statement provided for in Article 8 Regulation 1257/2012, etc., will have to be open to public file inspection. It is therefore proposed that a special part in the existing electronic file relating to all documents concerning European patents with unitary effect should be created. For that purpose, it is proposed that Article 128(4) EPC should apply *mutatis mutandis* to European patents with unitary effect (see also Article 65 CPC 1989). As a result, the files relating to a European patent with unitary effect could be inspected on request, subject to the modalities and restrictions laid down in Rules 144 to 146 EPC, which also apply *mutatis mutandis*. As regards the constitution, maintenance and preservation of files, it is proposed that Rule 147 EPC should apply *mutatis mutandis*.
5. **Representation:** It is proposed that Articles 133 and 134 EPC, as well as Rules 151 to 154 EPC, should apply *mutatis mutandis*.
6. **Stay and interruption of proceedings:** As regards stay of proceedings, it is proposed that Rule 15 EPC should apply *mutatis mutandis*. This means that the request for unitary effect may not be withdrawn and that the European patent with unitary effect may not be surrendered from the date on which a third party provides evidence that he has instituted national proceedings under Rule 14(1) EPC. Furthermore, it is proposed that Rule 14 EPC regarding running periods and their interruption should also apply *mutatis mutandis* with the proviso that the time limit still to run after the resumption referred to in Rule 14(4) EPC is not less than one month where the interrupted time limit is that specified in Rule 5(1) (see Rule 17(3)). As regards interruption of proceedings, it is proposed that Rule 142 EPC should apply *mutatis mutandis*.
7. Part VII, Chapters III and IV of the Implementing Regulations to the EPC apply *mutatis mutandis*. This covers taking of evidence, as well as notifications. As regards time limits, Rules 131, 133 and 134 EPC apply *mutatis mutandis*. Rule 133 EPC is set out separately in Rule 17(5) with the proviso that the document referred to therein must have been received no later than one month after expiry of the period.
8. Rule 112 EPC will apply in the case of non-payment of the renewal fee within the additional six-month period, in which case the EPO will send out a communication

under Rule 112(1) EPC (noting of loss of rights) and the patentee can then apply for a decision under Rule 112(2) EPC against which an action can be brought before the Unified Patent Court.

Explanatory remarks to Rule 18: Re-establishment of rights

1. It is proposed that re-establishment of rights as the only applicable means of legal redress for all the procedures relating to the European patent with unitary effect, including the procedure for requesting unitary effect, should be introduced. Due to editorial constraints, a cross reference to the numerous different EPC provisions governing re-establishment of rights and its interaction with further processing would be unclear and too difficult to read. Therefore, a new all-inclusive provision has been formulated.
2. A typical case giving rise to re-establishment of rights will be the failure to pay renewal fees in time for the European patent with unitary effect. In addition, should the proprietor of the European patent omit to file a request for unitary effect or file said request too late, it is proposed that he should be able to obtain re-establishment of rights in respect of the non-extendable one-month period specified in Rule 5(1). It is furthermore proposed that in such a case, the request for re-establishment should be filed within two months of expiry of that period, by analogy with the special period provided for the re-establishment of rights in the priority period under Article 87(1) EPC (see Rule 136 EPC). The omitted act, i.e. the filing of the request for unitary effect, must also be completed within this two-month period.
3. For more details on the request for unitary effect, please see the explanatory remarks on Rules 4 to 6.

Explanatory remarks to Rule 19: Form of decisions

1. Proposed Rule 19 reproduces Rule 111(2) EPC with some adaptations required in view of the fact that actions against EPO decisions are to be brought before the Unified Patent Court.

Explanatory remarks to Rule 20: Interlocutory revision

1. Proposed Rule 20 is largely modelled on Article 109 EPC and goes hand in hand with Rule 91 of the draft Rules of procedure of the Unified Patent Court (29 April 2013 – draft 15).

Explanatory remarks to Rule 21: Cover for expenditure incurred by the European Patent Office

1. According to Article 146 EPC and Article 10 ss Regulation (EU) No 1257/2012 the European patent with unitary effect has to be self-financing and has to be implemented in a way that ensures budget neutrality.
2. Paragraph 2 is intended to deal in particular with the situation which might occur in the initial phase.