



ARTICLE

UPC: A FORCEPS BIRTH AT THE RISK OF A PREMATURE DEATH?

Patent Law | 03/02/22 | François Pochart Lionel Martin



In a recent[1] article we announced the "top start" of the UPC following the announcement on the website of the EU Council[2] of the "entry into force" of the Protocol on the provisional application of the UPC Agreement ("PAP-Protocol"[3]). According to the EU Council, this entry into force would have taken place on 19 January 2022, the day Austria deposited its instrument of ratification of the PAP-Protocol[4].

However, looking at Article 3(1) of the PAP-Protocol, one can legitimately ask whether the conditions for the entry into force of this protocol are indeed met...

Indeed, this article expressly mentions, as cumulative conditions for the entry into force of the PAP-Protocol: the ratification of the Agreement on a Unified Patent Jurisdiction ("UPC AGREEMENT") and the signature of the PAP-Protocol by... the UK[5].

The UK did sign the PAP-Protocol on 1er October 2015[6] and did notify its ratification of the UPC Agreement on 26 April 2018[7], but finally withdrew from both following the Brexit. The pages of the EU Council website concerning these two texts indicate that this withdrawal would be effective from the date of its receipt, i.e. 20 July 2020[8].

The conditions of Article 3 of the PAP-Protocol are therefore *prima facie* not fulfilled on 19 January 2022 due to Brexit.

This does not seem to worry the Council of the European Union, which, as mentioned, indicates on its website that the PAP-Protocol would have entered into force on 19 January 2022.

However, a few months ago, the UPC Preparatory Committee seemed to be worried in advance. Indeed, on 28 October 2021, the day after the 21st UPC Preparatory Committee, a release on the UPC website[9] announced that, during the Preparatory Committee, the Signatory States to the UPC Agreement ("Signatory States") had agreed to sign a "*Declaration on the authentic interpretation of Art. 3 of the PAP-Protocol*" to "*confirm the entry into force of the PAP-Protocol, once the required 13 Member States become bound by said Protocol, recognizing that Art. 3 of the PAP-Protocol is to be interpreted as mirroring Art. 89 of the UPC Agreement*".

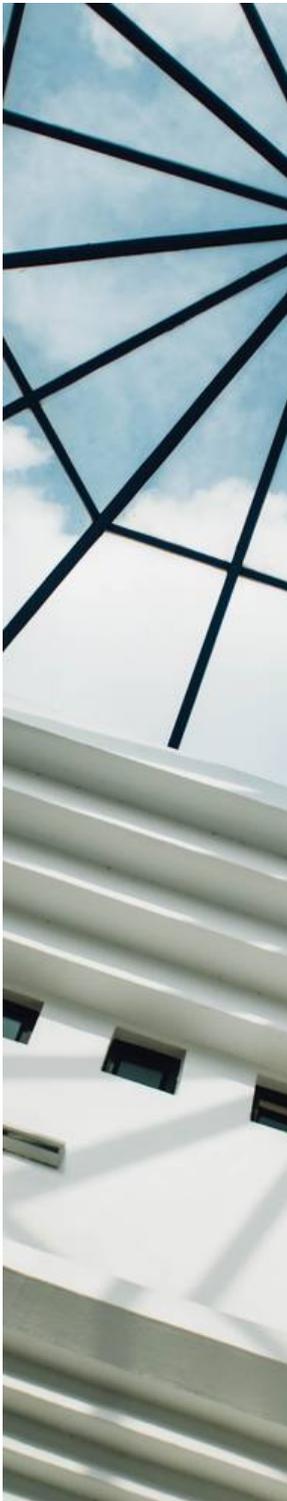
It will be recalled that Article 89 provides that the UPC[10] Agreement "*shall enter into force [...] after the deposit of the thirteenth instrument of ratification or accession in accordance with Article 84, including the three Member States in which the highest number of European patents had effect [...]*".

Therefore, it is understood that the "*Declaration on the authentic interpretation*", the draft of which was circulated on 27 October 2021 at the 21st UPC Preparatory Committee, is intended to state that Article 3 of the PAP-Protocol should be understood as conditioning the entry into force of such protocol not on the signature of 13 Signatory States, including France, Germany and the United Kingdom, but on the signature of 13 Signatory States, including the three States in which the highest number of European patents had effect in the year preceding the year in which the signature of the UPC Agreement[11]. Excluding the UK, these would be France, Germany and Italy.

The release went on to say that "*The delegations supported the approach proposed by the Chairman, hence giving him the mandate to organize a signing ceremony of the Declaration, foreseen in the margins of a future COREPER[12] meeting*".

According to the EU Council website, between 27 October 2021 and today, there have been 33 COREPER [13] meetings. However, since 27 October 2021, no more has been heard about this "*Declaration on the authentic interpretation*"...

Has the plan to sign this declaration been postponed? If so, when it is signed, will this declaration be sufficient to "rectify" the entry into force of the PAP-Protocol? Indeed, several questions will arise: if the signature takes place, as announced, "*in the margins of a COREPER meeting*", is this signature process in



conformity with EU law? The mention in the 28 October release that this declaration would be "*in line with public international law*" is, at best, incantatory.

Was the plan to sign this declaration simply aborted?

In any case, can the EU Council, by declaring the PAP-Protocol "in force", close its eyes to the absence of application of all the conditions of Article 3? This is what it did regarding the Protocol on Privileges and Immunities of the UPC (PPI), by declaring it in force since 27 October 2021[14], even though this protocol also provides that the ratification of the United Kingdom is a condition for its entry into force. Indeed, Article 18 of the Protocol states that "This Protocol shall enter into force 30 days after the date on which the last of the four State Parties – France, Germany, Luxembourg and the United Kingdom – has deposited its instrument of ratification, acceptance approval or accession".[15] However, the UK also withdrew from this protocol on 20 July 2020.

The entry into force of the PAP-Protocol is not without consequences for the possible survival of the UPC. This provisional period is intended to give birth in advance to the organs of the UPC. These organs are supposed to, among other essential tasks, approve the Rules of Procedure[16] and appoint the judges of the Court[17]. Will candidate judges rush to be appointed following a procedure whose legality questions even the preparatory committee of the UPC itself when it contemplates to use an "interpretative declaration" of the PAP-Protocol? In the event of a legal challenge to the process, an early appointment of such judges could lead to their no less hasty dismissal.

Similarly, if the PAP-Protocol is to be considered in force despite its explicit reference to the United Kingdom, will we also close our eyes, purely and simply, to the word "London" in Article 7(2) and Annex II of the UPC Agreement? Should we ignore it - and return to the Parisian seat of the UPC all the cases formerly devolved to London, or will we dare a highly imaginative geography that would replace London with Rome?

One can understand the will of the EU Council to "advance" the UPC project. Nevertheless, declaring texts to be "in force" while disregarding the provisions such texts lay down for their entry into force, is an approach that Emile Coué would not have disowned.

Will those for whom the UPC was conceived, first and foremost the rights holders, really want to get into this beautiful ULO[18] knowing that it may one day be called into question, or worse, destroyed prematurely, by a decision of the CJEU which would be seized of this question of its birth by forceps?

[1] <https://www.august-debouzy.com/en/blog/1765-upc-top-start-yes-but-how>

[2] <https://www.consilium.europa.eu/en/documents-publications/treaties-agreements/agreement/?id=2013001&DocLanguage=en>

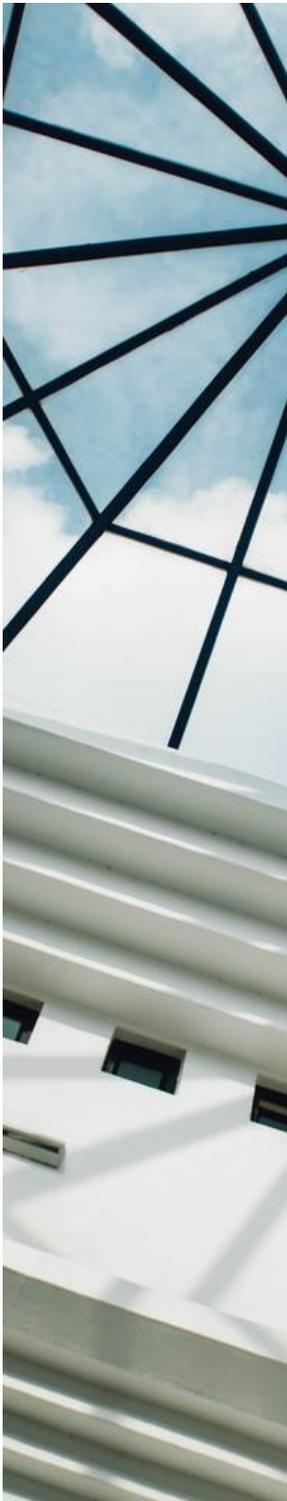
[3] https://www.unified-patent-court.org/sites/default/files/Protocol_to_the_Agreement_on_Unified_Patent_Court_on_provisional_application.pdf

[4] <https://www.unified-patent-court.org/news/austria-closes-loop-protocol-provisional-application-upc-agreement-has-entered-force>

[5] In reality, Article 3 (1) is more complex as it makes the entry into force of the PAP-Protocol conditional on 13 Signatory States, including Germany, France and the United Kingdom, having met the following two cumulative conditions:

- Condition 1: they have either ratified or informed the depositary [as defined in Article 2 (4) of the PAP-Protocol] that they have received parliamentary approval to ratify the UPC Agreement; and

- Condition 2: they have either expressed their consent to be bound by the Protocol (via one of the methods indicated in Article 2 (2) of the PAP-Protocol) or expressed their consent to be bound by the provisional application of the provisions of the UPC Agreement mentioned in Article 1 of the PAP-Protocol, by means of a unilateral declaration or in any other way. Which option is chosen within condition 2 depends on each State's own method of dealing with protocols. It is therefore difficult to know exactly when a given state has fulfilled condition 2, and therefore to verify exactly how many states are bound by the PAP-Protocol at the moment... there are 13 according to the EU Council, but who are they? does it include the UK?



[6] <https://www.consilium.europa.eu/en/documents-publications/treaties-agreements/agreement/?id=2013001&DocLanguage=en>

[7] <https://www.consilium.europa.eu/en/documents-publications/treaties-agreements/agreement/?id=2013001&DocLanguage=en>

[8] *ibid*

[9] <https://www.unified-patent-court.org/news/report-preparatory-committee-meeting-held-27-october-2021>

[10] [https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:42013A0620\(01\)&from=FR](https://eur-lex.europa.eu/legal-content/EN/TXT/HTML/?uri=CELEX:42013A0620(01)&from=FR)

[11] UPC Agreement was signed on 19 February 2013. See https://www.epo.org/news-events/news/2013/20130219_fr.html

[12] Permanent Representatives Committee

[13] <https://www.consilium.europa.eu/fr/meetings/calendar/?Category=mpo&Page=1&filtering=1&daterange=&dateFrom=2021%2F10%2F28&dateTo=2022%2F02%2F02&filters=-3>

[14] <https://www.consilium.europa.eu/fr/documents-publications/treaties-agreements/agreement/?id=2016047&DocLanguage=en>

[15] Free translation of Article 18 of the PPI, which is available here: https://www.unified-patent-court.org/sites/default/files/ppi_final_ii_en_clean.pdf

[16] By the Administrative Committee under Article 41 of the UPC Agreement referred to in the PAP-Protocol, which is itself established by Articles 11 and 12 of the Agreement, also referred to in the PAP-Protocol

[17] By the Administrative Committee under Article 19 of the UPC Agreement referred to in the PAP-Protocol, and on the proposal of the Advisory Committee itself established by Articles 11 and 14 of the Agreement, also referred to in the PAP-Protocol

[18] ULO: Unidentified Legal Object
