



**COUNCIL OF  
THE EUROPEAN UNION**

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**LIMITE**

**PI 122**

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**NOTE**

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from: Presidency  
to: Council (Competitiveness)

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Subject : PREPARATION OF THE MEETING OF THE COUNCIL ON 26 AND 27  
NOVEMBER 2003  
- Community patent  
= Proposal for a Council Regulation on the Community patent

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**A. INTRODUCTION**

1. Following the adoption by the Council (Competitiveness) of a common political approach on the Community patent on 3 March 2003 (7159/03 PI 24), the Working Party on Intellectual Property (Patents) and the Permanent Representatives Committee have worked intensively on reflecting the principles of the common political approach in the proposal for a Council Regulation on the Community patent and in proposals for amendments to the European Patent Convention which are necessary in order to accommodate the Community patent. This note concerns the proposal for a Regulation; the proposals for amendments to the European Patent Convention are dealt with in 15088/03 PI 123.

2. Agreement has been reached on most of the provisions of the proposal for a Regulation. However, a number of questions remain which the Council is invited to resolve. Section B below concerns the questions relating to translations. Section C sets out the other outstanding questions. The text of the proposal for a Regulation as it now stands is set out in the Annex to this note.

## **B. QUESTIONS RELATING TO TRANSLATIONS**

3. Paragraph 2.3 of the common political approach of 3 March 2003 provides that "*... the applicant must, upon the grant of the patent, file a translation of all claims into all official Community languages except if a Member State renounces the translation into its official language ...*". In the statement by the Council annexed to the common political approach, "*The Council states that the words "upon the grant of the patent" in paragraph 2.3 mean within a reasonable time from the date of grant of the patent. During this time, the granted patent shall be valid irrespective of availability of translations of all claims into all official Community languages. The Council notes that the German delegation considers that a reasonable time would be within two years from the date of the grant of the patent.*". Chapter IIa of the proposal for a Regulation (Articles 24a to 24d) seeks to reflect this part of the common political approach. Articles 11 and 44, as well as the proposal made by the Spanish delegation for an Article 45a, are also relevant in this context.
4. There is a divergence of views concerning the interpretation of what would constitute a "reasonable time" for the filing of the translations of the claims into all official Community languages (Article 24a(3)). Positions range from three months to twenty-four months. Six, nine and twelve months have also been mentioned as possible compromise solutions.

5. A further question which has arisen concerns the place of filing of the compulsory translations of the claims (Article 24a(1)). The **DELETED** delegation, supported by the **DELETED** delegation, has proposed that any Member State may require that the translation into its language or languages be filed with its national patent office. All other delegations and the Commission support a Presidency proposal, as supplemented by a proposal by the **DELETED** delegation, whereby the applicant may opt to file translations either directly with the European Patent Office, or via a national patent office, except where a national patent office has not made provision for acting as intermediary. In addition to the reservation by the **DELETED** delegations on the Presidency proposal, the **DELETED** delegations have scrutiny reservations on the possibility for a national patent office not to act as intermediary. The **DELETED** delegation also has a related reservation on Article 58.
6. Another outstanding question is how to ensure that patent proprietors pay sufficient attention to the quality of the translations of the claims, which are required "*for reasons of legal certainty - in particular in connection with actions or claims for damages - non-discrimination and dissemination of patented technology*" (paragraph 2.3 of the common political approach). The Presidency has sought to strike a fair balance in its proposal for Article 24c between the interests of an alleged infringer who has used the patented invention in good faith on the basis of an inaccurate translation of the claims and those of the proprietor of the patent, once the proprietor has provided a corrected translation. The **DELETED** delegation, supported by the **DELETED** delegation, has presented a proposal for an Article 45a which attempts to strike the balance in a different way.
7. Article 44(3a) also concerns the effects of an inaccurate translation, but only with respect to entitlement for damages. The **DELETED** delegations have reservations on this provision, which they consider unnecessary, particularly if the proposed Article 45a were to be adopted.

8. Agreement has not been reached on whether or not translations carried out by an authorised translator should be deemed to be in conformity with the original until proved to the contrary (Article 24d). The **DELETED** delegations have reservations on such a presumption, particularly if Article 24c is adopted.
9. Related issues to some of those set out above arise in Article 11, which concerns the situation before the grant of the patent. There is general agreement that Article 11 should be aligned on the solution to be found for the above provisions.
10. **The Council is invited to consider the above issues with a view to agreeing a compromise package covering these various questions relating to translations.**

### **C. OTHER OUTSTANDING QUESTIONS**

11. In addition to the questions set out under section B above, there remain a limited number of reservations and scrutiny reservations on other issues.

These concern:

- Article 2(2) : footnote 5 on page 13
- Article 9(b1) : footnote 6 on page 18
- Article 9a : footnote 7 on page 20
- Article 21(3a) : footnote 9 on page 28
- Chapter IV : footnote 14 on page 38
- Article 43 : footnotes 15 and 16 on page 42
- Article 53a(3) : footnote 20 on page 49
- Article 53d(3) : footnote 21 on page 51.

12. **The Presidency is confident that, once a compromise package has been agreed on the questions relating to translations, the Council will be able to find a solution on these points too.**

**D. CONCLUSIONS**

13. **The Council is invited to consider the questions set out under section B above with a view to agreeing a compromise package. In the context of this package, the Council is also invited to resolve the other outstanding questions referred to under section C above, with a view to adopting a political agreement on the whole text of the Regulation.**
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Proposal for a  
**COUNCIL REGULATION**  
**on the Community patent**  
(Text with EEA relevance)

THE COUNCIL OF THE EUROPEAN UNION,

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

Having regard to the proposal from the Commission<sup>1</sup>,

Having regard to the opinion of the European Parliament<sup>2</sup>,

Having regard to the opinion of the European Economic and Social Committee<sup>3</sup>,

Whereas:

- (1) The activities of the Community include the establishment of an internal market characterised by the abolition of obstacles to the free movement of goods and the creation of a system ensuring that competition in the internal market is not distorted. The creation of the legal conditions enabling undertakings to adapt their activities in manufacturing and distributing products to a Community dimension helps to attain these objectives. A patent to which uniform protection is given and which produces uniform effects throughout the Community should feature amongst the legal instruments which undertakings have at their disposal.
- (2) The Munich Convention on the Grant of European Patents of 5 October 1973 (hereinafter referred to as the "Munich Convention") established the European Patent Office (EPO) and entrusted it with the task of granting European patents. The expertise offered by the European Patent Office should therefore be used in the granting of the Community patent.

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<sup>1</sup> OJ C 337E, 28.11.2000, p. 278.

<sup>2</sup> OJ C 127E, 29.5.2003, p. 519

<sup>3</sup> OJ C 155, 29.5.2001, p. 80.

- (2a) The European Patent Office will play a central role in the administration of Community Patents and will alone be responsible for examination of applications and the grant of Community Patents. All national patent offices will have an important role to play, *inter alia* advising potential applicants for Community Patents, receiving applications and forwarding them to the EPO, disseminating patent information and advising SMEs. National Patent Offices will be compensated for these activities.
- (2b) Applications for Community Patents can be filed with the National Patent Office of a Member State in its working language(s). Applicants will remain free to present their patent applications directly to the EPO. They may also request that their applications be fully processed by the EPO. On behalf of the EPO and at the request of the applicant, National Patent Offices of Member States having an official language other than the three official languages of the EPO may carry out any task up to and including novelty searches in their respective language(s). National Patent Offices of Member States having as their official language one of the three EPO languages, which have experience of cooperation with the EPO and which need to maintain a critical mass may, if they so wish, carry out search work on behalf of the EPO. The relationship between National Patent Offices carrying out these tasks and the EPO will be based on partnership agreements, containing *inter alia* common criteria for quality assurance. These criteria (covering documentation, staff training and qualifications and working tools) would aim to guarantee a comparable quality and uniformity of the Community Patent. The implementation of these partnership agreements, i.e. the compliance with these objective quality standards, will be subject to independent periodic review. National patent offices will be compensated for the searches that they carry.
- (2c) The Community Patent system will include a safeguard clause according to which the Council, acting on a proposal from the Commission after consultation with the EPO, can agree to extend the involvement of any National Patent Offices in search activities to meet any severe problems of capacity in delivering Community Patents. Such arrangements must not lead to any reduction of quality of the Community Patent.

- (3) The accession of the Community to the Munich Convention will enable the Community to be included in the Convention system as a territory for which a unitary patent can be granted. The Community can, therefore, limit this Regulation in particular to the creation of the law applicable to the Community patent once granted.
- (3a) The Office should also be entrusted with the task of administering the Community patent, for example, as regards the collection of fees, the distribution of annual fees to national patent offices on the basis of a distribution key to be decided unanimously by the Council and management of the Community Patent Register. It is also appropriate to give the Office a number of other tasks relating to a Community patent, for example, limitation of the patent on application by the holder or recording the surrender or lapse of the patent. In carrying out the tasks of administering the Community patent, the Office will, while respecting Community law, as an organ of the European Patent Organisation apply the provisions of the Munich Convention. The review of decisions taken by the Office will be governed by the Munich Convention.
- (4) Community patent law applicable to the Community patent should not replace the laws of the Member States on patents, nor European patent law as established by the Munich Convention. It would not in fact appear to be justified to require undertakings to apply for registration of their patents as Community patents, since national patents and European patents continue to be necessary for those undertakings which do not want protection of their inventions at Community level. This Regulation should therefore be without prejudice to the right of the Member States to grant national patents.
- (4a) The substantive law applicable to the Community patent, for example as regards patentability, the extent of patent protection, limitation of the effects of the patent and the exhaustion of rights, must follow the same principles as the existing Community legislation with respect to national patents.

- (5) The objective of an affordable Community patent militates in favour of a patent that is valid throughout the Community in the language in which it was granted under the Munich Convention, subject, however, to the obligation on the applicant to submit a translation of all the claims into all the official Community languages. Thus, the language regime for the Community Patent will, up to grant, be the same as the one provided for in the European Patent Convention. This means that the applicant has to present a complete application document in one of the three official languages of the EPO as well as, at the time of grant of the patent, a translation of the claims into the two other EPO languages. However, where the applicant files the application in a non-EPO language and provides a translation into one of the EPO languages, the cost of that translation will be borne by the system ("mutualisation of costs"). For reasons of legal certainty - in particular in connection with actions or claims for damages - non-discrimination and dissemination of patented technology, the applicant must, at the time of grant of the patent, file a translation of all claims into all official Community languages except if a Member State renounces the translation into its official language. The translations will be filed with the EPO and the costs borne by the applicant, who decides on the number and the length of claims to be included in the patent application, thereby having an influence on the cost of translations.
- (5a) The renewal fee for a Community Patent must not exceed the level of the corresponding renewal fees for an average European Patent and will be progressive throughout the life of the Community Patent. The level of procedural fees for processing an application for a Community Patent will be the same regardless of where the application is filed and where the novelty search is carried out (EPO or national patent office). The level of fees will be related to costs for handling the Community Patent and must not lead to any indirect subsidy of national patent offices.
- (5b) Renewal fees for Community Patents will be payable to the European Patent Office, which will keep 50 percent to cover its costs, including the costs of searches carried out by National Patent Offices. The remaining 50 percent will be distributed among the National Patent Offices of the Community Member States in accordance with a distribution key, which will be decided unanimously by the Council.

- (6) Any negative effects of a monopoly created by a Community patent should be prevented through a system of compulsory licences. This is without prejudice to the application of Community competition law by the Commission or national authorities. However, the Community Patent Court should be entrusted with the grant of compulsory licences in situations not falling under Community competition law.
- (7) As Community patents are Community titles the Community jurisdiction should have the power to decide matters affecting their validity. The jurisdictional system of the Community Patent will be based on the principles of a unitary Court for the Community Patent, securing uniformity of the jurisprudence, high quality of working, proximity to the users and potential users and low operating cost. For reasons of legal certainty, all legal actions relating to certain aspects of the Community patent should come under the jurisdiction of one court, and the decisions of that court should be enforceable throughout the Community. Exclusive jurisdiction for a certain category of actions and applications relating to a Community patent, and in particular for actions relating to infringement and validity, should therefore be given to the Court of Justice of the European Communities. Jurisdiction shall reside in the first instance in the Community Patent Court (CPC) created by the decision taken pursuant to Article 225a of the Treaty and, on appeal, in the Court of First Instance. The Court of Justice may make a decision in last resort, subject to the conditions provided for in Article 62 of the Statute of the Court of Justice. This judicial system must be in place and operational by January 2010 at the latest. Until that time, it is necessary to provide for a transitional period during which disputes for which the Community courts are competent shall be heard by the national courts. Once the final judicial system is operational, the Commission shall publish in the Official Journal of the European Union the date on which it shall be applicable. The final system shall apply to actions and applications initiated after that date, whereas individual actions initiated prior to that date before the national courts shall continue to be heard by the national courts.

- (7a) The seat of the Community Patent Court shall be at the Court of First Instance. The judges shall be appointed on the basis of their expertise and taking into account their linguistic skills. The Community Patent Court may hold hearings in Member States other than that in which its seat is located.
- (7b) The judges shall be appointed by a unanimous decision of the Council for a fixed term. The candidates for appointment must have an established high level of legal expertise in patent law. Technical experts will assist the judges throughout the handling of the case.
- (7c) The Community Patent Court will conduct the proceedings in the official language of the Member State where the defendant is domiciled, or in one of them to be chosen by the defendant, where in a Member State there are two or more official languages. At the request of the parties and with the consent of the CPC, any official EU language can be chosen as language of proceedings. The CPC may, in accordance with the rules of procedure, hear parties in person and witnesses in an EU official language other than the language of proceedings. In that case translations and interpretation into the language of the proceedings from another official EU language should be provided.
- (7d) The Community Patent Court shall be established at the latest by 1 January 2010. Until then each Member State shall designate a limited number of national courts to have jurisdiction in the actions and claims related to the Community Patents.

- (8) The court ruling on infringement and validity should also be able to rule on penalties and compensation for damage on the basis of common rules. Those powers are without prejudice to the powers to apply any rules on criminal liability and unfair competition provided for under the Member States' national law.
- (9) In accordance with the principles of subsidiarity and proportionality as set out in Article 5 of the Treaty, the objectives of the proposed action, in particular the creation of a unitary right with effect throughout the Community, can be achieved only by the Community. This Regulation confines itself to the minimum required in order to achieve those objectives and does not go beyond what is necessary for that purpose.
- (10) Since the measures necessary for implementing this Regulation are measures of general scope within the meaning of Article 2 of Council Decision 1999/468/EC of 28 June 1999 laying down the procedures for the exercise of implementing powers conferred on the Commission<sup>4</sup>, they should be adopted in accordance with the regulatory procedure laid down in Article 5 of that Decision,

HAS ADOPTED THIS REGULATION:

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<sup>4</sup> OJ L 184, 17.7.1999, p. 23.

## CHAPTER I GENERAL PROVISIONS

### *Article 1*

#### **Community patent law**

This Regulation establishes a Community law on patents. This law shall apply to all patents designating the Community granted by the European Patent Office (hereinafter referred to as "the Office") under the provisions of the European Patent Convention of 5 October 1973 (hereinafter referred to as the "Munich Convention") and to all applications for a European patent in which the Community is designated.

For the purposes of this Regulation, such patents shall be considered to be Community patents and the term "application for a Community patent" shall mean an application for a European patent designating the Community.

### *Article 2*

#### **Community patent**

1. The Community patent shall have a unitary character. It shall have equal effect throughout the Community and may only be granted, transferred, declared invalid or lapse in respect of the whole of the Community.
  
2. The Community patent shall have an autonomous character. It shall be subject only to the provisions of this Regulation and to the general principles of Community law. However, the provisions of this Regulation shall not exclude the application of Community competition law, nor of the law of Member States with regard to criminal liability, unfair competition and mergers<sup>5</sup>, nor of the provisions of the Munich Convention to the extent that they are not covered by this Regulation.

2a. to 4. Deleted.

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<sup>5</sup> Scrutiny reservation by the **DELETED** delegation.

*Article 3*

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

1. This Regulation shall also apply to the sea and submarine areas adjacent to a Member State's territory in which that Member State exercises sovereign rights or jurisdiction in accordance with international law.
2. This Regulation shall apply to inventions created or used in outer space, including on celestial bodies or on spacecraft, which are under the jurisdiction and control of one or more Member States in accordance with international law.

**CHAPTER II**

**PATENT LAW**

**SECTION 1**

**RIGHT TO THE PATENT**

*Article 4*

**Right to the Community patent**

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

3. If two or more persons have made an invention independently of each other, the right to the Community patent shall belong to the person whose Community patent application has the earliest date of filing or, where applicable, the earliest date of priority. This provision shall apply only if the first Community patent application has been published under Article 93 of the Munich Convention.

#### *Article 5*

#### **Claiming the right to the Community patent**

1. If the Community patent has been granted to a person who is not entitled to it under Article 4(1) and (2), the person entitled to it under that article may, without prejudice to any other right or remedy which may be open to him, claim to have the patent transferred to him.
2. Where a person is entitled to only part of the Community patent, that person may, in accordance with paragraph 1, claim to be made a joint proprietor.
3. Legal proceedings in respect of the rights referred to in paragraphs 1 and 2 may be instituted only within a period of three years after the date on which the Community Patent Bulletin, referred to in Article 57, publishes the grant of the Community patent. This provision shall not apply if the proprietor of the patent knew, at the time of the grant or of the acquisition of the patent, that he was not entitled to the patent.
4. The fact that legal proceedings have been instituted shall be entered in the Register of Community Patents referred to in Article 56. The final decision in the legal proceedings or any withdrawal thereof shall also be entered.

*Article 6*

**Effect of change of proprietorship of the Community patent**

1. Where there is a complete change of proprietorship of a Community patent as a result of legal proceedings referred to in Article 5, licences and other rights shall lapse upon the registration of the person entitled to the patent in the Register of Community Patents referred to in Article 56.
  
2. If, before the institution of legal proceedings has been registered,
  - (a) the proprietor of the patent has used the invention within the territory of the Community or made effective and serious preparations to do so,  
or
  
  - (b) a licensee of the patent has obtained his licence and has used the invention within the territory of the Community or made effective and serious preparations to do so, he may continue such use provided that he requests a non-exclusive licence of the patent from the new proprietor whose name is entered in the Register of Community Patents. Such request must be made within the period prescribed in the implementing regulations. The licence shall be granted for a reasonable period and upon reasonable terms.
  
3. Paragraph 2 shall not apply if the proprietor of the patent or the licensee was acting in bad faith at the time when he began to use the invention or to make preparations to do so.

**SECTION 2**  
**EFFECTS OF THE COMMUNITY PATENT AND THE COMMUNITY PATENT**  
**APPLICATION**

*Article 7*

**Prohibition of direct use of the invention**

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

- (a) from making, offering, putting on the market or using the product which is the subject-matter of the patent, or importing or stocking the product for these purposes;
- (b) from using the process which is the subject-matter of the patent or, when the third party knows, or it is obvious in the circumstances, that the use of the process is prohibited without the consent of the proprietor of the patent, from offering the process for use within the Community;
- (c) from offering, putting on the market or using a product obtained directly by a process which is the subject-matter of the patent, or importing or stocking the product for these purposes.

*Article 8*

**Prohibition of indirect use of the invention**

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

2. Paragraph 1 shall not apply when the means are staple commercial products, except when the third party induces the person supplied to commit acts prohibited by Article 7.
3. Persons performing the acts referred to in Article 9(a) (b) and (c) shall not be considered to be parties entitled to exploit the invention within the meaning of paragraph 1.

*Article 8a*

Deleted

*Article 9*

**Limitation of the effects of the Community patent**

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

- (a) acts done privately and for non-commercial purposes;
- (b) acts done for experimental purposes relating to the subject-matter of the patented invention;
- (b.1) acts carried out solely for the purpose of conducting tests and trials in accordance with Article 13 of Directive 2001/82/EC or Article 10 of Directive 2001/83/EC in respect of any patent covering the reference product within the meaning of either of the said Directives;<sup>6</sup>
- (c) the extemporaneous preparation for individual cases in a pharmacy of a medicine in accordance with a medical prescription nor acts concerning the medicine so prepared;

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<sup>6</sup> Scrutiny reservation by the **DELETED** delegations, as the proposed amendments to the Directives referred to have not yet been adopted.

- (d) the use on board vessels of countries other than Member States of the patented invention, in the body of the vessel, in the machinery, tackle, gear and other accessories, when such vessels temporarily or accidentally enter the waters of Member States, provided that the invention is used there exclusively for the needs of the vessel;
- (e) the use of the patented invention in the construction or operation of aircraft or land vehicles or other means of transport of non-member States, or of accessories to such aircraft or land vehicles, when these temporarily or accidentally enter the territory of Member States;
- (f) the acts specified in Article 27 of the Convention on International Civil Aviation of 7 December 1944, where these acts concern the aircraft of a country other than a Member State;
- (g) the use by a farmer of the product of his crop for propagation or multiplication on his own holding, provided that the reproductive vegetable material was sold or otherwise commercialised by the holder of the patent or with his consent to the farmer, for agricultural purposes. The scope and the detailed methods of this use are laid down in Article 14 of Regulation (EC) No. 2100/94;
- (h) the use by a farmer of protected livestock for farming purposes, on condition that the breeding animals or other animal reproductive material was sold or otherwise commercialised to the farmer by the holder of the patent or with his consent. Such use includes the provision of the animal or other animal reproductive material for the purposes of his agricultural activity, but not the sale as part of or for the purpose of commercial reproductive activity;
- (i) the acts allowed pursuant to Articles 5 and 6 of Directive 91/250/EEC on the legal protection of computer programs by copyright, in particular, by its provisions on decompilation and interoperability;
- (j) the acts allowed pursuant to Article 10 of Directive 98/44/EC on the legal protection of biotechnological inventions.

*Article 9a*

**Government use**

Any provision in the law of a Member State allowing non-commercial use of national patents by or for the government may be applied to Community patents, but only to the extent that the use is necessary for essential defence or national security. The patentee should be informed as soon as reasonably possible about the act and be compensated in respect of the act by the government concerned. Any dispute as to whether a Community patent has been used as provided for in this Article or over the amount of compensation shall be decided by the national courts of the Member State concerned.<sup>7</sup>

*Article 10*

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

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

Article 11

**Rights conferred by the Community patent application after publication<sup>8</sup>**

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

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<sup>7</sup> Scrutiny reservation on Article 9a by the **DELETED** delegation and the Commission.

<sup>8</sup> The final text of this Article will depend on the final text of Articles 24c and 44.

2. In determining the reasonable compensation, the courts shall take into account all relevant aspects, such as the economic consequences to the injured party of the use made of the invention, as well as the undeserved profits made by the person using the invention and the behaviour and the good or bad faith of the parties. The compensation shall not be punitive.
3. For the purposes of paragraph 2, a person using the invention who has his residence or principal place of business in a Member State whose official language, which is also an official language of the Community, is not the language in which the patent application was published, is presumed not to have known nor to have had reasonable grounds for knowing that the use made of the invention would be prohibited by virtue of the Community patent after grant. In such a situation, reasonable compensation shall be due only for the period from the time when he is notified of a translation of the patent claims in the official language of the Member State of his residence or principal place of business.
- 3a The applicant for the patent is not entitled to compensation to the extent that, due to an inaccurate translation of the patent claims which has been notified in accordance with paragraph 3, the person using the invention did not know and did not have any reasonable grounds to know that the use would be prohibited by virtue of the Community patent after grant.
4. Where the Member State referred to in paragraph 3 has two or more official languages which are also official languages of the Community, the person using the invention shall be entitled to notification in the official language of his choice.

## Article 12

### **Right based on prior use of the invention**

1. A Community patent may not be invoked against a person who, in good faith and for business purposes, had used the invention in the Community or had made effective and serious preparations for such use before the filing date or, where priority has been claimed, the priority date of the application on the basis of which the patent is granted (hereinafter referred to as "the prior user"); the prior user shall have the right, for business purposes, to continue the use in question or to use the invention as planned during the preparations.
2. The right of the prior user may not be transferred either during the user's lifetime or following his death other than with the user's undertaking or that part of the undertaking in which the use or the preparations for use took place.

## Article 13

### **Process patents: burden of proof**

1. If the subject-matter of a Community patent is a process for obtaining a new product, the same product when produced without the consent of the proprietor shall, in the absence of proof to the contrary, be deemed to have been obtained by the patented process.
2. The reversal of the burden of proof provided for in paragraph 1 shall apply equally where there is a strong likelihood that the same product was obtained by the process and the holder of the Community patent has not been able, despite reasonable efforts, to determine what procedure has actually been used.
3. In adducing proof to the contrary, the legitimate interests of the defendant in protecting his manufacturing and trade secrets shall be taken into account.

**SECTION 3**  
**THE COMMUNITY PATENT AS AN OBJECT OF PROPERTY**

*Article 14*

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

1. Unless otherwise specified in Articles 15 to 24, the Community patent as an object of property shall be dealt with in its entirety, and for the whole of the Community, as a national patent of the Member State in which, according to the Register of Community Patents provided for by Article 56:
  - (a) the applicant for the patent had his residence or place of business on the date of filing of the Community patent application;
  - (b) where subparagraph (a) does not apply, the applicant had an establishment on that date.
  - (c) Deleted.

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

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

*Article 15*

**Transfer**

1. The transfer of the Community patent shall be made in writing and shall require the signature of the parties to the contract, except when it is a result of a judgement; otherwise it shall be void. The transfer shall be registered in the Register of Community Patents.
2. Subject to Article 6(1), a transfer shall not affect rights acquired by third parties before the date of transfer.
3. A transfer shall, to the extent to which it is verified by the documents set out in the implementing regulations referred to in Article 59, have effect vis-à-vis third parties only after entry in the Register of Community Patents referred to in Article 56. Nevertheless, a transfer, before it is so entered, shall have effect vis-à-vis third parties who have acquired rights after the date of the transfer but who knew of the transfer on the date on which the rights were acquired.

*Article 16*

**Rights *in rem***

1. The Community patent may, independently of the undertaking, be given as security or be the subject of rights *in rem*.
2. At the request of one of the parties, the rights referred to in paragraph 1 shall be entered in the Register of Community Patents referred to in Article 56 and published in the Community Patent Bulletin referred to in Article 57.

### *Article 17*

#### **Levy of execution**

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

### *Article 18*

#### **Insolvency proceedings**

1. The only insolvency proceedings in which a Community patent may be involved shall be those opened in the Member State within the territory of which the centre of a debtor's main interests is situated.
2. In the case of joint proprietorship of a Community patent, paragraph 1 shall apply to the share of the joint proprietor.
3. Where a Community patent is involved in insolvency proceedings, on request of the competent national authority an entry to this effect shall be made in the Register of Community Patents referred to in Article 56 and published in the Community Patent Bulletin referred to in Article 57.

### *Article 19*

#### **Contractual licensing**

1. The Community patent may be licensed in whole or in part for the whole or part of the Community. A licence may be exclusive or non-exclusive.
2. The rights conferred by the Community patent may be invoked against a licensee who breaches any restriction in the licensing contract.

3. Article 15(2) and (3) shall apply to the grant or transfer of a licence in respect of a Community patent.

#### *Article 20*

#### **Licences of right**

1. The proprietor of a Community patent may file a written statement with the Office that he is prepared to allow any person to use the invention as a licensee in return for appropriate compensation. In that case, the renewal fees for the Community patent which fall due after receipt of the statement shall be reduced; the amount of the reduction shall be fixed in the rules relating to fees referred to in Article 60. Where there is a complete change of proprietorship of the patent as a result of legal proceedings under Article 5, the statement shall be deemed withdrawn on the date of entry of the name of the person entitled to the patent in the Register of Community Patents.
2. The statement may be withdrawn at any time by a written communication to this effect to the Office, provided that no-one has yet informed the proprietor of the patent of his intention to use the invention. Such withdrawal shall take effect from the date of receipt of that communication by the Office. The amount by which the renewal fees were reduced shall be paid within one month after withdrawal; Article 25(2) shall apply, but the six-month period shall start upon expiry of the above period.
3. The statement may not be filed while an exclusive licence is recorded in the Register of Community Patents or a request for the recording of such a licence is before the Office.
4. On the basis of the statement, any person shall be entitled to use the invention as a licensee under the conditions laid down in the implementing regulations referred to in Article 59. A licence obtained under the terms of this Article shall, for the purposes of this Regulation, be treated as a contractual licence.

5. On written request by one of the parties, the Community Patent Court shall determine the appropriate compensation referred to in paragraph 1 or review it if circumstances have arisen or become known which render the compensation determined obviously inappropriate.
6. No request for recording an exclusive licence in the Register of Community Patents shall be admissible after the statement has been filed, unless it is withdrawn or deemed withdrawn.
7. The Member States may not grant licences of right in respect of a Community patent.

#### *Article 21*

#### **Grant of compulsory licences**

1. The Community Patent Court may grant a compulsory licence for lack or insufficiency of exploitation of a Community patent to any person filing an application four years or later after the patent application was filed and three years or later after the patent was granted if the patent proprietor has not exploited the patent in the Community on reasonable terms or has not made effective and serious preparations to do so, unless he provides legitimate reasons to justify his inaction. In determining the lack or insufficiency of exploitation of the patent, no distinction shall be made between products originating within the Community and imported products.
2. On request, the Community Patent Court may grant a compulsory licence in respect of a first patent to the proprietor of a national or Community patent or to the proprietor of a plant variety right who cannot use his patent (second patent) or his national or Community plant variety right without infringing a Community patent (first patent), provided that the invention or new plant variety claimed in the second patent or plant variety right involves an important

technical advance of considerable economic significance in relation to the invention claimed in the first patent. In the case of a compulsory licence in respect of a dependent patent or plant variety right, the owner of the first patent shall be entitled to a cross-licence on reasonable terms to use the patented invention or protected plant variety.

3. Deleted.
- 3a. In times of crisis or in other situations of extreme urgency, including those relating to a public interest of extreme importance, the Community Patent Court may authorise at the request of a Member State the exploitation of a Community patent.<sup>9</sup>
4. In the case of semi-conductor technology, exploitation shall be possible without the authorisation of the right holder only in the situations set out in paragraph 3a.
5. A licence or exploitation set out in paragraphs 1 and 2 may be granted only if the proposed user has made efforts to obtain authorisation from the patent holder on reasonable commercial terms and conditions, and if such efforts have not been successful within a reasonable period of time. However, the authority granting the licence may derogate from this condition in the situations set out in paragraph 3a. In these situations, the right holder shall be informed as soon as reasonably possible.
6. The detailed rules of application and the procedures to be used for applying the principles set out in this Article shall be laid down in the relevant instruments.

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<sup>9</sup> Reservations by the **DELETED** delegations on the wording of paragraph 3a.

*Article 22*

**Conditions applicable to compulsory licences**

1. When granting the compulsory licence under Article 21, the Community Patent Court shall specify the type of use covered and the conditions to be met. The following conditions shall apply:
  - (a) the scope and duration of the exploitation shall be limited to the purpose for which it was authorised;
  - (b) the exploitation shall be non-exclusive;
  - (c) the exploitation shall be non-assignable, except with that part of the enterprise or goodwill which enjoys such use;
  - (d) the exploitation shall be authorised predominantly for the supply of the internal market of the Community ;
  - (e) the Community Patent Court may, on reasoned request, decide to cancel the authorisation, subject to adequate protection of the legitimate interests of the persons so authorised, if and when the circumstances which led to it cease to exist and are unlikely to recur;
  - (f) the licence holder shall pay the right holder adequate remuneration, taking into account the economic value of the authorisation ;
  - (g) in the case of a compulsory licence in respect of a dependent patent or a plant variety right, the exploitation authorised in respect of the first patent shall be non-assignable except with the assignment of the second patent or plant variety right.
2. Deleted.

*Article 23*

**Effects vis-à-vis third parties**

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

*Article 24*

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

1. Articles 9a, 14 to 19 and Article 21(3) to (6), and Article 22 shall apply to the application for a Community patent, whereby it is understood that all references to the Community Patent Register include references to the European Patent Register provided for by the Munich Convention.
2. The rights acquired by third parties in respect of a Community patent application referred to in paragraph 1 shall continue to be effective with regard to the Community patent granted upon that application.

**CHAPTER IIa**  
**COMPULSORY TRANSLATIONS OF THE COMMUNITY PATENT**

*Article 24a*

**Compulsory translations of the Community patent**

1. When the patent is granted, the applicant shall file a translation of all the claims into all the official languages of the Community, unless all Member States which have a given language as their official language or one of their official languages agree to dispense with a translation into that language. The translation shall be filed, at the choice of the applicant, either directly with the Office or via the national patent office of a Member State which makes such provision and which has as its official language or one of its official languages the language of the translation.

Where the translation is filed directly with the Office, the Office shall immediately make it available to the national patent offices of the Member States and to the public by publishing it on its Internet database.

Where the translation is filed via a national patent office, that office shall immediately transmit the translation to the Office, which shall make it available to the national patent offices of the other Member States and to the public by publishing it on its Internet database.<sup>10</sup>

2. The decision of one or more Member States referred to in paragraph 1 to dispense with a translation must be communicated to the Commission in a statement, which it shall publish in the *Official Journal of the European Union*.
3. For the purposes of paragraph 1, if the translations into Community languages other than those required for the granting of the patent under the provisions of the Munich Convention are produced and filed at the Office within a maximum of [three] [six] [nine] [twelve] [twenty

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<sup>10</sup> Reservations by the **DELETED** delegations and scrutiny reservations by the **DELETED** delegations on paragraph 1.

four]<sup>11</sup> months of the granting of the patent, under conditions specified by the implementing rules, the holder of the patent may exploit the rights conferred by that patent as from the date of publication of the notice of granting of the patent.

4. If the translations provided for in this Article are not filed within the deadline laid down in paragraph 3, the Community patent shall be deemed to be void ab initio.

#### *Article 24b*

### **Conversion into a European patent designating one or more Member States**

1. Deleted.
2. The holder of the patent may, by a request filed with the Office within the time limit laid down in Article 24a(3) and under the conditions specified by the provisions of the Munich Convention, opt for the Community Patent to be converted into a European patent designating one or more Member States.

#### *Article 24c*

### **Effects of inaccurate translations**

Notwithstanding paragraph 3a of Article 44, an alleged infringer, who in good faith is using or has made effective and serious preparations for using the invention the use of which would not constitute infringement of the patent under the translation referred to in Articles 24a or Article 58 but constitutes infringement according to the language in which the patent was granted, may, in the Member State in the official language of which the inaccurate translation is provided, continue, subject to payment of adequate compensation, the use in question for business purposes within the territory of the Member State concerned, for two years from the moment at which a corrected translation has either been notified to him or made available to the public in accordance with the said Articles. This right may not be transferred. Article 10 is not applicable.<sup>12</sup>

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<sup>11</sup> The Council is invited to decide the length of this period.

<sup>12</sup> Reservations or scrutiny reservations by all delegations on this Article.

*Article 24d*

**Status of the translations**

The translations referred to in Articles 24a and 58, which have been carried out by a person authorized under the law of a Member State shall be deemed in the Community to be in conformity with the original, until proved to the contrary.<sup>13</sup>

**CHAPTER III**

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

**SECTION 1**

**RENEWAL AND LAPSE**

*Article 25*

**Renewal fees**

1. Annual renewal fees in respect of Community patents shall be paid to the Office in accordance with the implementing regulations referred to in Article 60. These fees shall be due in respect of the years following the year in which the Community Patent Bulletin referred to in Article 57 mentions the grant of the Community patent.
2. When a renewal fee has not been paid on or before the due date, the fee may be validly paid within six months of that date, provided that an additional fee is paid at the same time.
3. Any renewal fee in respect of a Community patent falling due within two months after the publication of the mention of the grant of the Community patent shall be deemed to have been validly paid if it is paid within the period mentioned in paragraph 2. No additional fee shall be charged in this case.

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<sup>13</sup> Reservations on Article 24d by the **DELETED** delegations, especially if Article 24c is adopted.

*Article 26*

**Surrender**

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

*Article 27*

**Lapse**

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

3. The Office shall record the lapse of the Community patent in accordance with the provisions of the Munich Convention.

*Article 27a*

**Restitutio in integrum**

1. The holder of a Community patent who, despite being able to demonstrate that he took all due care under the circumstances, was unable to meet an Office deadline, shall, on request, have his rights restored if the failure to meet the deadline directly resulted, by virtue of the provisions of this Regulation, in the loss of a right or of an avenue of appeal to the Office. The processes of restitutio in integrum laid down in the Munich Convention shall apply.
2. Where the holder of a patent has his rights restored, he may not invoke his rights vis-à-vis a third party who, acting in good faith, began to exploit, or to make effective and serious preparations to exploit in the Community an invention covered by a Community patent during the period between the loss of the right referred to in paragraph 1 and the publication of notification of the restoration of that right.

**SECTION 2**

**INVALIDITY AND LIMITATION OF THE COMMUNITY PATENT**

*Article 28*

**Grounds for invalidity**

1. The Community patent may be declared invalid only on the grounds that:
  - (a) the subject-matter of the patent is not patentable according to Articles 52 to 57 of the Munich Convention;

- (b) the patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art;
  - (c) the subject-matter of the patent extends beyond the content of the patent application as filed, or, if the patent was granted on a divisional application or on a new application filed in accordance with Article 61 of the Munich Convention, beyond the content of the earlier application as filed;
  - (d) the protection conferred by the patent has been extended;
  - (e) the proprietor of the patent is not entitled under Article 4(1) and (2) of this Regulation;
  - (f) the subject-matter of the patent is not new having regard to the content of a national patent application or of a national patent made public in a Member State on the date of filing or later or, where priority has been claimed, the date of priority of the Community patent, but with a filing date or priority date before that date.
2. If the grounds for invalidity affect the patent only partially, invalidity shall be pronounced in the form of a corresponding limitation of the patent. The limitation may be effected in the form of an amendment to the claims.
  3. In the processes before the courts referred to in Article 30 concerning the validity of the Community patent, the holder of the patent shall be entitled to limit the patent by modifying the claims. The limited patent shall then be the basis for the process.

*Article 29*

**Effects of invalidity**

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

*Article 29a*

**Request for limitation**

At the request of the holder of a patent, lodged with the Office, the Community patent may be subject to limitation in the form of an amendment to the claims. The provisions of the Munich Convention relating to the request for limitation shall apply.

**CHAPTER IV**  
**JURISDICTION AND PROCEDURE IN LEGAL ACTIONS RELATING TO THE**  
**COMMUNITY PATENT<sup>14</sup>**

**SECTION 1**  
**ACTIONS CONCERNING THE VALIDITY AND INFRINGEMENT OF THE PATENT**  
**AND THE USE OF THE INVENTION**

*Article 30*

**Actions and claims relating to the Community patent – Exclusive jurisdiction  
of the Court of Justice**

1. The Community patent may be the subject of invalidity or of infringement proceedings, of action for a declaration of non-infringement, of proceedings relating to the use of the invention prior to the granting of the patent or to the right based on prior use of the patent, or of a counterclaim for a declaration of invalidity or of a petition for the grant or revocation of a compulsory licence. It may also be the subject of proceedings or claims for damages or provisional or protective measures or requests for the determination of compensation.
  
2. In accordance with the decision giving the Court of Justice jurisdiction for matters relating to the Community patent, adopted pursuant to Article 229a of the Treaty, the actions and claims referred to in paragraph 1 shall come under the exclusive jurisdiction of the Court of Justice, except in the case of Article 9a. In accordance with the decision taken pursuant to Article 225a of the Treaty, they shall be brought in the first instance before the Community Patent Court and, on appeal, before the Court of First Instance.

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<sup>14</sup> General reservation by the **DELETED** delegation on the whole of Chapter IV pending consideration of proposals on the legal instruments establishing the jurisdictional system for the Community patent.

*Article 31*

**Invalidity action**

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

*Article 32*

**Counterclaim for invalidity**

1. Counterclaims for invalidity against a Community patent may be based only on the grounds for invalidity set out in Article 28(1).
2. If the counterclaim is brought in a legal action to which the proprietor of the patent is not already a party, he shall be informed thereof and may be joined as a party to the action.

*Article 33*

**Infringement action**

1. Actions for infringement may be based only on facts referred to in Articles 7, 8 and 19.
2. The proprietor of the patent may bring an action for infringement. Without prejudice to the provisions of the licensing contract, a licensee may bring proceedings for infringement of a Community patent only if its proprietor consents thereto. However, the holder of an exclusive licence may bring such proceedings if the proprietor of the Community patent, after formal notice, does not himself bring infringement proceedings within an appropriate period.
3. The proprietor of the patent shall be entitled to intervene in infringement proceedings brought by the licensee under paragraph 2.
4. A licensee shall, for the purpose of obtaining compensation for damage suffered by him, be entitled to intervene in infringement proceedings brought by the proprietor under paragraph 2.

*Article 34*

**Action for declaration of non-infringement**

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

*Article 35*

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

1. Proceedings relating to the use of the invention during the period referred to in Article 11(1) may be brought by the applicant for or proprietor of the patent. Without prejudice to the provisions of the licensing contract, a licensee may bring such proceedings only if the applicant for or proprietor of the patent consents thereto. However, the holder of an exclusive licence may bring such proceedings if the applicant for or proprietor of the Community patent, after formal notice, does not himself bring such proceedings within an appropriate period.
2. The Court may not decide on the merits of a case until notification of the granting of the patent has been published.

*Article 36*

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

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

*Articles 37- 38 – 39- 40*

- Deleted -

*Article 41*

**Extent of jurisdiction**

In the proceedings referred to in Articles 33 to 36, the Community courts referred to in Article 30 shall have jurisdiction in respect of acts committed and activities undertaken in a part or in the entirety of the territory, zone or space to which this Regulation applies.

*Article 42*

**Provisional or protective measures**

The Community courts referred to in Article 30 may adopt any provisional or protective measure, which may be necessary in accordance with their Statutes or Rules of Procedure. These measures may, for example, include measures to prevent acts of infringement of the right granted by the patent and, in particular, to prevent the introduction in the Community's trade channels of allegedly infringing goods, including goods imported immediately after customs clearance, and measures to safeguard evidence of the alleged infringement, as well as measures suitable for guaranteeing compliance with the above measures, including measures of a pecuniary nature.

*Article 43*

**Orders**

Where the Community courts referred to in Article 30, in proceedings referred to in Article 33, find that the defendant has infringed a Community patent<sup>15</sup>, they may issue the following orders:

- (a) an order prohibiting the defendant from continuing with the acts which infringed the patent<sup>16</sup>;

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<sup>15</sup> The **DELETED** delegation has a scrutiny reservation, as it considers that the words "or that an infringement is imminent" should be added.

<sup>16</sup> The **DELETED** delegation has a scrutiny reservation, as it considers that the words "or from starting acts which would result in infringing a Community patent" should be added.

- (b) an order to confiscate the products resulting from the infringement;
- (c) an order to confiscate the goods, materials and implements which constitute the means for putting the protected invention into effect and which have been supplied or offered for supply under the conditions set out in Article 8;
- (d) any order imposing other measures adapted to the circumstances and suitable for guaranteeing compliance with the orders referred to in (a), (b) and (c), including measures of a pecuniary nature.

#### *Article 44*

#### **Actions or claims for compensation or damages**

1. The Community courts referred to in Article 30 shall have the power to order the payment of compensation for damage underlying the actions referred to in Articles 31 to 36.
2. In determining the appropriate damages, the courts shall take into account all relevant aspects, such as the economic consequences to the injured party of the infringement, as well as the undeserved profits made by the infringer and the behaviour and the good or bad faith of the parties. The damages shall not be punitive.
3. For the purposes of paragraph 2, an alleged infringer who has his residence or principal place of business in a Member State whose official language, which is also an official language of the Community, is not the language in which the patent was granted or in which a translation of the patent claims has been made public in accordance with Article 24a or Article 58, is presumed not to have known nor to have had reasonable grounds for knowing that he was infringing the patent. In such a situation, damages for infringement shall be due only for the period from the time when he is notified of a translation of the patent claims in the official language of the Member State of residence or principal place of business of the alleged infringer.

- 3a The patent holder is not entitled to damages to the extent that, due to an inaccurate translation of the patent claims which has been made public in accordance with Article 24a or Article 58, an infringer did not know and did not have any reasonable grounds to know that he was infringing the patent.<sup>17</sup>
4. Where the Member State referred to in paragraph 3 has two or more official languages which are also official languages of the Community, the infringer shall be entitled to notification in the official language of his choice.

*Article 45*

**Period of limitation**

Proceedings relating to use, to the right based on prior use, to infringement and to damages referred to in this section shall be barred after five years have elapsed from the date on which the requesting party became aware of facts justifying proceedings or should have become aware of them and in any case after ten years have elapsed from the infringement.

*Article 45a (new)*<sup>18</sup>

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<sup>17</sup> The **DELETED** delegations have reservations on this paragraph, which is related to Article 24c and the proposed Article 45a.

<sup>18</sup> The **DELETED** delegation, supported by the **DELETED** delegation, has proposed the following Article instead of Article 24c:

"Article 45a (new) Effects of translations

Provisions of Articles 42, 43, 44 and 11(2) shall not apply if there is not infringement of the patent according to the translation of the claims or of the patent in the official language of the Member State where the invention was used. In this case, the person who in good faith was using or had made effective and serious preparations for using the invention may continue such use in the course of his business or for the needs thereof without payment.

The applicant for or the proprietor of a patent may, at any time, file a corrected translation. Such corrected translation shall not have any legal effect until published by the Office."

All other delegations and the Commission have reservations on this Article.

**SECTION 2**  
**JURISDICTION AND PROCEDURE IN OTHER ACTIONS RELATING TO THE**  
**COMMUNITY PATENT**

*Article 46*

**Jurisdiction of national courts**

The national courts of the Member States shall have jurisdiction in actions relating to Community patents which do not come within the exclusive jurisdiction of the Court of Justice under this Regulation on the basis of conferral made by the decision adopted pursuant to Article 229a of the Treaty.

*Article 47*

**Application of provisions on international jurisdiction and enforcement**

Unless otherwise specified in this Regulation, Regulation (EC) No 44/2001 or, where applicable, the Convention on Jurisdiction and Enforcement of Judgments in Civil and Commercial Matters, signed at Brussels on 27 September 1968<sup>19</sup>, referred to hereafter as "the Convention on Jurisdiction and Enforcement", shall apply to actions brought before the national courts and to decisions given in respect of such actions.

*Article 48*

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

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

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<sup>19</sup> OJ C 27, 26.1.1998, p. 3.

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

*Article 49*

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

1. By way of derogation from the provisions applicable under Article 47, the courts and authorities of the Member State determined under Article 14 shall have exclusive jurisdiction in proceedings relating to the levy of execution on a Community patent.
2. and 3. Deleted.

*Article 50*

**Supplementary provisions on jurisdiction**

1. Within the Member State whose courts have jurisdiction under Article 47, those courts shall have jurisdiction which would have jurisdiction *ratione loci* and *ratione materiae* in the case of actions relating to national patents granted in that State.
2. Actions relating to the Community patent for which no court has jurisdiction under Articles 47 and 48 and paragraph 1 of this Article may be heard before the courts of the Member State in which the European Patent Organisation has its seat.
3. The provisions of this Section shall apply to actions relating to patent applications, save to the extent that the right to obtain the patent is claimed. In this situation, the Protocol on the jurisdiction, recognition and enforcement of judgments in respect of the right to the grant of a European patent annexed to the Munich Convention shall apply.

*Article 51*

**Obligations of the national court**

1. A national court hearing an action or application referred to in Article 30 shall declare of its own motion that it has no jurisdiction, except in the case of Article 9a.
2. A national court hearing an action or claim relating to a Community patent other than the actions referred to in Article 30 shall treat the patent as valid unless it has been declared invalid by the Community Patent Court in a decision which has the authority of res judicata.
3. A national court hearing an action or claim relating to a Community patent other than the actions referred to in Article 30 shall stay the proceedings if it considers a decision on an action or application referred to in Article 30 to be a prior condition for its judgment. Proceedings shall be stayed either by the court of its own motion, after hearing the parties, where an action or application referred to in Article 30 has been brought before the Community Patent Court, or at the request of one of the parties, and after hearing the other parties, where proceedings have not yet been brought before the Community court. In the latter case, the national court shall invite the parties to bring such proceedings within a period prescribed by it. If such proceedings are not brought within the prescribed period, the proceedings before the national court shall continue.

*Article 52*

**Applicable law of procedure**

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

### **SECTION 3**

#### **ARBITRATION**

##### *Article 53*

##### **Arbitration**

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

### **SECTION 4**

#### **ACTIONS RELATING TO VALIDITY AND INFRINGEMENT OF THE PATENT AND TO THE USE OF THE INVENTION DURING THE TRANSITIONAL PERIOD**

##### *Article 53a*

##### **Legal jurisdiction during the transitional period**

1. Notwithstanding the provisions of Section 1 of this Chapter, and until the system of Community jurisdiction referred to in Article 30 has been put into place, by 1 January 2010 at the latest, competence to hear the legal actions referred to in Section 1 of this Chapter shall be governed by the provisions of this Section.
2. The date on which the Community courts referred to in Article 30 shall commence their activities shall be published by the Commission in the Official Journal of the European Union. Legal actions referred to in Section 1 of this Chapter and begun prior to that date shall be brought before the national courts, in accordance with the provisions of this Section.

3. By derogation from paragraph 2, during the period referred to in paragraph 1 the Commission shall have competence:
  - (a) to determine or review compensation in accordance with Article 20(5);
  - (b) to grant compulsory licences or authorise exploitation in accordance with Article 21.<sup>20</sup>

*Article 53b*

**Jurisdiction during the transitional period**

1. Each Member State shall designate the smallest possible number of national courts of first instance and of second instance, which shall be entrusted with the task of performing the functions assigned to them by this Section.
2. Each Member State shall communicate to the Commission, by 31 December 2005 at the latest, a list of the national courts, indicating their names and their territorial jurisdiction.
3. Any change occurring after the communication referred to in paragraph 2 relating to the number, names or territorial jurisdiction of the said courts shall be communicated to the Commission by the Member State concerned without delay.
4. The information referred to in paragraphs 2 and 3 shall be communicated to the Member States by the Commission and shall be published in the Official Journal of the European Union.

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<sup>20</sup> Reservations by the **DELETED** delegations on paragraph 3.

5. Until such time as a Member State has communicated the information referred to in paragraph 2, any procedure resulting from an action or application referred to in Article 30 and for which the courts of that Member State have jurisdiction pursuant to Article 53c and 53d, shall be brought before the court of that Member State which would have had territorial jurisdiction and competence to decide on the action or application if the procedure had concerned a national patent of the Member State in question.

*Article 53c*

**Application of provisions on international jurisdiction and enforcement  
during the transitional period**

Save where this Regulation provides otherwise, the provisions of Regulation (EC) No 44/2001 or, where applicable, the Convention on Jurisdiction and Enforcement shall be applicable to actions concerning Community patents, and to decisions handed down on those actions.

*Article 53d*

**International jurisdiction during the transitional period**

1. Subject to the provisions of this Regulation and to any provisions of Regulation (EC) No 44/2001 or, where applicable, the provisions of the Convention on Jurisdiction and Enforcement applicable by virtue of Article 53c, proceedings in respect of the actions and claims referred to in Article 30 of this Regulation shall be brought in the courts of the Member State in which the defendant is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.
2. If the defendant is neither domiciled nor has an establishment in any of the Member States, such proceedings shall be brought in the courts of the Member State in which the plaintiff is domiciled or, if he is not domiciled in any of the Member States, in any Member State in which he has an establishment.

3. If neither the defendant nor the plaintiff is so domiciled or has such an establishment, such proceedings shall be brought in the courts of the Member State where the European Patent Organisation has its seat.<sup>21</sup>
  
4. Notwithstanding paragraphs 1, 2 and 3:
  - (a) Article 23 of Regulation (EC) 44/2001 or, where applicable, Article 17 of the Convention on Jurisdiction and Enforcement shall apply if the parties agree that a court in a different Member State shall have jurisdiction;
  
  - (b) Article 24 of Regulation (EC) 44/2001 or, where applicable, Article 18 of the Convention on Jurisdiction and Enforcement shall apply if the defendant enters an appearance before a court of a different Member State.
  
5. Proceedings in respect of the actions and claims referred to in Article 30 of this Regulation, except actions and claims for a declaration of invalidity, may also be brought in the courts of the Member State in which the act of infringement has been committed.

*Article 53e*

**Extent of jurisdiction during the transitional period**

1. A court whose jurisdiction is founded on Article 53d, points a) to e), shall be competent to decide on the facts of an infringement committed in the territory of any Member State.
  
2. A court whose jurisdiction is founded on Article 53d, point f), shall be competent to decide only on the facts of an infringement committed in the territory of the Member State in which the court is located.

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<sup>21</sup> Scrutiny reservation by the **DELETED** delegation on this paragraph.

*Article 53f*

**Presumption of validity - defence on the merits**

In proceedings resulting from actions against infringement of a Community patent, the courts shall consider the Community patent to be valid. Validity may only be contested by a counterclaim for a declaration of invalidity. Nevertheless, a plea for the invalidity of the Community patent entered other than by a counterclaim shall be admissible to the extent that the defendant can demonstrate the Community patent could be declared invalid on grounds of a national right previously granted to the defendant within the meaning of Article 28(1)(f).

*Article 53g*

**Effects of a decision on invalidity during the transitional period**

Where a court decision to the effect that a Community patent is invalid has become enforceable, it shall produce the effects referred to in Article 29 of this Regulation in all the Member States according to the provisions of Regulation (EC) No 44/2001 or, where applicable, the Convention on Jurisdiction and Enforcement.

*Article 53h*

**Applicable law during the transitional period**

1. The courts shall apply the provisions of this Regulation.
2. The court shall apply its national laws, including its international private law, to all matters falling outside the scope of this Regulation.
3. Save where this Regulation provides otherwise, the court shall apply the rules of procedure applicable to the same type of procedure relating to national patents in the territory in which that court is located.

*Article 53i*

**Jurisdiction in the second instance – further appeal - during the transitional period**

1. Decisions of the courts resulting from the actions and applications referred to in this Section shall be subject to appeal before the courts of second instance.
2. The conditions under which an appeal may be brought before a court of second instance shall be determined by the national law of the Member State in whose territory that court is located.
3. Decisions of the courts of second instance shall be governed by national provisions on further appeals.

**CHAPTER V**

**IMPACT ON NATIONAL LAW**

*Article 54*

**Prohibition of simultaneous protection**

1. Where a national patent granted in a Member State relates to an invention for which a Community patent has been granted to the same inventor or to his successor in title with the same date of filing, or, if priority has been claimed, with the same date of priority, that national patent shall be ineffective to the extent that it covers the same invention for the same territory as the Community patent, from the date on which:
  - (a) the period for filing an opposition to the decision of the Office to grant a Community patent has expired without any opposition being filed;
  - (b) the opposition proceedings are concluded with a decision to maintain the Community patent;or

- (c) the national patent is granted, where this date is subsequent to the date referred to in point (a) or (b), as the case may be.
2. The subsequent lapse or invalidity of the Community patent shall not affect the provisions of paragraph 1.
  3. Each Member State may prescribe the procedure whereby the effect of the national patent is determined to have been lost in whole or, where appropriate, in part. It may also prescribe that the loss of effect shall apply from the outset.
  4. Simultaneous protection by a Community patent or Community patent application and a national patent or national patent application shall exist prior to the date applicable under paragraph 1.

*Article 55*

Deleted.

**CHAPTER VI  
FINAL PROVISIONS**

*Article 56*

**Register of Community Patents**

The Office shall keep a Register of Community Patents, which shall contain those particulars whose registration is provided for by this Regulation. The Register shall be open to public inspection.

*Article 57*

**Community Patent Bulletin**

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

*Article 58*

**Optional translations**

The proprietor of the patent shall have the option of producing and filing a translation of his patent in several or all of the official languages of the Member States which are official languages of the Community. Such translations may be filed with the Office, or with a National Patent Office of a Member State if that Member State's law so permits. National Patent Offices shall transmit a copy of such translations to the Office. The Register of Community Patents shall contain a mention of the filing of such translations. Those translations shall be made available to the public by the National Patent Offices and the Office by publishing them on their Internet databases.<sup>22</sup>

*Article 59*

**Implementing regulation**

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

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<sup>22</sup> The **DELETED** delegation has the same reservation on this Article as for Article 24a(1).

## *Article 60*

### **Rules relating to fees**

1. The rules relating to fees shall determine the annual renewal fees, including additional fees, the amounts of the fees and the ways in which they are to be paid.
- 1a. Fifty per cent of the income from renewal fees shall be distributed among the central industrial property offices of the Member States in accordance with a distribution key mentioned in the rules relating to fees. The distribution key will be based on a basket of fair, equitable and relevant criteria. Such criteria should reflect patent activities and the size of the market. In addition, considering the role to be played by National Patent Offices, a balancing factor should also be applied where Member States have a disproportionately low level of patent activities. On the basis of these criteria the Member States' share shall be adjusted periodically to current figures.
2. The rules relating to fees shall be adopted and amended in accordance with the procedure referred to in Article 61(2). However, the distribution key referred to in paragraph 1a shall be adopted and amended by the Council of the European Union acting unanimously.

## *Article 61*

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

1. The Commission shall be assisted by a committee, the Committee for issues relating to fees and to the rules for the implementation of the Regulation on the Community patent, composed of representatives of the Member States and chaired by the representative of the Commission.
2. Where reference is made to this paragraph, the regulatory procedure laid down in Article 5 of Decision 1999/468/EC shall apply, in compliance with Article 7 thereof.
3. The period provided for in Article 5(6) of Decision 1999/468/EC shall be three months.

*Article 62*

**Report on the implementation of this Regulation**

Five years from the date on which the first patent designating the Community is granted, the Commission shall present to the Council a report on the operation of the Community patent system. The assessment shall cover quality and consistency, the deadlines required for decisions, and the costs incurred by inventors. Subsequent reports on the operation of the Community patent system shall be presented by the Commission every five years.

*Article 63*

**Entry into force**

1. This Regulation shall enter into force on the sixtieth day following that of its publication in the *Official Journal of the European Union*.
2. Applications for a Community patent may be filed with the Office from the date laid down in a Commission Decision in accordance with the procedure referred to in Article 61(2).

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

Done at Brussels,

*For the Council*

The President

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