

Transposition note for the Agreement on a Unified Patent Court signed at Brussels on 19th February 2013 (“the Agreement”)

The Agreement creates a court common to the Contracting Member States (Member States of the EU who are party of the Agreement) – the Unified Patent Court (“the Court”) – which is intended to decide actions relating to the validity or infringement of European patents with unitary effect (“Unitary Patents”) and European “bundle” patents (for the UK, these are known as “European patents (UK)”). It defines the rights that a patent confers upon its proprietor to prevent the use of the invention, and the limitations on those rights.

Most of the provisions of the Agreement relate to the internal operation of the Court, or the operation of the Agreement, and do not require transposition. (Unless further explanation is needed, these provisions are omitted from the following table.)

However, others require changes to national law to ensure consistency with the Agreement and to confer the relevant jurisdiction to the Court.

The relevant provisions will be implemented in UK law by the Patents (European Patent with Unitary Effect and Unified Patent Court) Order 2016 (“the Order”), which will amend the Patents Act 1977 (“the Patents Act”).

Article of the Agreement	Objectives	Implementation in the Order	Responsibility (Secretary of State if not specified)
1	Defines the Court	No transposition is required; although Article 2(9)(a) of the Order inserts a definition of “Unified Patent Court” into section 130(1) of the Patents Act which relates to this definition.	
2	Provides definitions for later provisions	No transposition is required; although Article 2(10) of the Order inserts paragraph 5(c) of Schedule A4, which relies upon the definition in Article 2(j) of the Agreement.	

3	Sets out the patents to which the Agreement will apply, without prejudice to Article 83 (where appropriate)	Article 2(10) of the Order inserts paragraph 1 of Schedule A4, which establishes the jurisdiction of the Court; it also sets out that this jurisdiction is only in relation to Unitary Patents , European patents (UK), and supplementary protection certificates based on these, subject to the transitional provisions of paragraph 2 of Schedule A4.	
4	Establishes that the Court shall have legal personality in each Contracting Member State	A separate Order on privileges and immunities will give effect to this provision.	
25	Sets out the rights a patent confers on its owner to prevent the direct use of the invention protected by the patent	No transposition is required, as these rights are already present in UK law, as set out in section 60(1) of the Patents Act. Article 2(10) of the Order inserts paragraph 4(10)(a) of Schedule A3, which ensures the effect of the section properly reflects the territorial extent of Unitary Patents.	
26	Sets out the rights a patent confers on its owner to prevent the indirect use of the invention protected by	No transposition is required, as these rights are already present in UK law, as set out in section 60(2)-(3) of the Patents	

	the patent	Act. Article 2(10) of the Order inserts paragraph 4(10)(a) of Schedule A3, which ensures the effect of the section properly reflects the territorial extent of Unitary Patents.	
27	Specifies exceptions to the rights conferred by a patent, as follows:	See below:	
27(a)	Private and non-commercial use	This exception is already provided by section 60(5)(a) of the Patents Act.	
27(b)	Experimental use	This exception is already provided by section 60(5)(b) of the Patents Act.	
27(c)	Use of biological material for plant variety development	Article 2(3) of the Order inserts section 60(5)(j) to the Patents Act to provide this exception.	
27(d)	Acts allowed by Directives on medicinal products for human and veterinary use	This exception is already provided by section 60(5)(i) of the Patents Act. Article 2(10) of the Order inserts paragraph 4(10)(a) of Schedule A3, which ensures the effect of the section properly reflects the territorial extent of Unitary Patents.	
27(e)	Preparation of a	This exception is already	

	prescribed medicine by a pharmacy	provided by section 60(5)(c) of the Patents Act.	
27(f)	Use on board Paris Convention or WTO member vessels temporarily in the waters of the Contracting Member States	This exception is already provided by section 60(5)(d) of the Patents Act. Article 2(10) of the Order inserts paragraphs 4(10)(a) and (b) of Schedule A3, which ensures the effect of the section properly reflects the territorial extent of Unitary Patents.	
27(g)	Use in construction or operation of Paris Convention or WTO member transportation temporarily in the territory of the Contracting Member States	This exception is already provided by section 60(5)(e) of the Patents Act. Article 2(10) of the Order inserts paragraphs 4(10)(a) and (b) of Schedule A3, which ensures the effect of the section properly reflects the territorial extent of Unitary Patents.	
27(h)	Chicago Convention protection for aircraft belonging to countries other than Contracting Member States	This exception is already provided by section 60(5)(f) of the Patents Act. Article 2(10) of the Order inserts paragraphs 4(10)(a) and (b) of Schedule A3, which ensures the effect of the section properly reflects the territorial extent of	

		Unitary Patents.	
27(i)	Use by a farmer for propagation following authorised sale and harvest	This exception is already provided by section 60(5)(g) of the Patents Act.	
27(j)	Use by a farmer of protected livestock for agricultural purposes following authorised sale	This exception is already provided by section 60(5)(h) of the Patents Act.	
27(k)	Acts allowed under Articles 5 and 6 of the Software Directive	<p>Article 2(3) of the Order inserts section 60(5)(k) to the Patents Act to provide this exception.</p> <p>Article 2(4) of the Order inserts section 60(6H) to the Patents Act to ensure this is provided for European patents (UK) and Unitary Patents.</p>	
27(l)	Acts allowed by Article 10 of the Biotech Directive	This exception is already provided by paragraph 10 of Schedule A2 of the Patents Act, which is implemented by means of section 76A.	
28	Establishes that rights under national law to continue prior use of a patented invention are retained	<p>This right is provided by section 64 of the Patents Act. It is already effective for European patents (UK) by means of section 77(1).</p> <p>Article 2(10) of the Order inserts paragraph 2 of Schedule A3, which ensures the effect of the section is extended to all Unitary Patents.</p>	

29	Sets out when the rights conferred by a patent are exhausted	<p>No transposition is required –</p> <p>The doctrine that exhaustion of rights applies to the EU as a whole has been established through case-law of the Court of Justice of the European Union (C-15/74, <i>Centrafarm v Sterling Drug</i>). It is therefore already provided for European patents (UK).</p> <p>Article 6 of the Unitary Patent Regulation is directly applicable, and extends the principle to Unitary Patents.</p>	
30	Specifies that the rights conferred to a patent are equally conferred to any supplementary protection certificate based on that patent	<p>Article 5 of Regulation (EC) 469/2009 sets out that supplementary protection certificates shall confer the same rights as the patent they are based on.</p> <p>Section 128B of the Patents Act provides Schedule 4A, which modifies certain provisions of the Patents Act so they apply correctly to supplementary protection certificates, including those relating to rights conferred.</p> <p>Article 2(10) of the Order inserts paragraph 2 of</p>	

		Schedule A3, which ensures the effect of section 128B and Schedule 4A is extended to Unitary Patents.	
31	Defines the Court's international jurisdiction as established in accordance with the Brussels I Regulation or the Lugano Convention	No transposition required, as this was achieved by EU Regulation 542/2014 to provide the relevant jurisdiction in Brussels I; as recognised in UK law by means of The Civil Jurisdiction and Judgments (Amendment) Regulations 2014.	
32	Sets out the actions for which the Court will have exclusive competence, and that national courts will retain competences for all other actions.	Article 2(10) of the Order inserts paragraph 1 of Schedule A4, which establishes the exclusive jurisdiction of the Court in relation to Article 32(1); it also inserts paragraph 3 of that Schedule, which states that sections of the Act relating to equivalent actions before national courts do not apply where the Court has such jurisdiction - this is done so that national provisions do not interfere with the operation of the Court.	
34	Establishes that decisions of the Court will cover the territory where the patent has effect	Article 2(10) of the Order inserts paragraph 4 of Schedule A4, which provides that decisions of the Court have effect in the UK.	

35	Sets out the mediation and arbitration centre	<p>The Order gives effect to the objectives of this provision to enable the settlement of disputes out of court.</p> <p>Enforcement of settlements and awards reached via the centre is dealt with under Article 82 below.</p>	
41	Provides for details of how Court proceedings will function to be set out in separate Rules of Procedure	No transposition is required, as this relates to the internal operation of the Court; however, the Rules of Procedure are referenced in paragraph 2 of Schedule A4, in relation to the transitional provisions of Article 83.	
42	Establishes that the Court shall act fairly and proportionately	No transposition is required, as this is a statement of intent and relates to the internal operation of the Court.	
46	Defines who has legal capacity to be a party to proceedings, with reference to national law on this issue	<p>No transposition is required, as this relates to the internal operation of the Court.</p> <p>The Court will take into account provisions of national law that relate to legal capacity.</p>	
47	Sets out who may be entitled to bring actions before the Court	Article 2(10) of the Order inserts paragraph 3 of Schedule A4, which disapplies certain sections of the Patents Act where	

		the Court holds jurisdiction, including sections 61, 66, 67 and 72, which deal with who may bring proceedings for infringement and revocation. This is done so that national provisions do not interfere with the operation of the Court.	
54	Establishes which party holds the burden of proof of facts	No transposition is required, as this relates to the internal operation of the Court; furthermore, it does not deviate from the standard burden of proof.	
59	Provides the Court with the power to order the presentation of evidence	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these orders is dealt with under Article 82 below.	
60	Gives the Court powers to order the preservation of relevant evidence and to order the inspection of premises	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these orders is dealt with under Article 82 below.	
61	Allows the Court to grant freezing orders	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these orders is dealt with under	

		Article 82 below.	
62	Provides the Court with the ability to make provisional injunctions or other protective measures as precautionary	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these orders is dealt with under Article 82 below.	
63	Allows the Court to grant permanent injunctions	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these injunctions is dealt with under Article 82 below.	
64	Provides the Court with the ability to order corrective measures in relation to products found to be infringing	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these orders is dealt with under Article 82 below.	
65	Sets out how the court may decide on the validity of a patent	Section 72 of the Patents Act sets out the grounds on which validity may be challenged before UK courts. Article 2(10) of the Order inserts paragraph 3 of Schedule A4, which disapplies certain sections of the Patents Act where the Court holds jurisdiction, including section 72. This is done so that national provisions	

		do not interfere with the operation of the Court.	
67	Gives the Court a power to order information to be provided to a party	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these orders is dealt with under Article 82 below.	
68	Allows the Court to award damages	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these awards is dealt with under Article 82 below.	
69	Sets out the ability of the Court to award costs and security for costs	No transposition is required, as this relates to the internal operation of the Court. Enforcement of these awards is dealt with under Article 82 below.	
81	Provides for a rehearing of matters after a final decision in exceptional circumstances	Although this Article largely relates to the internal operation of the Court, Article 2(5)(a) of the Order amends section 77(5A) of the Patents Act to account for the fact the the effect of an order of the Court is not normally suspended in this situation, and to provide the necessary protection for third parties in the event the patent is	

		restored.	
82	Sets out that decisions and orders shall be enforceable in any of the Contracting Member States, and shall be enforced in the same way as a national court decision	Article 2(10) of the Order inserts paragraph 4 of Schedule A4, which provides the required enforcement mechanism for decisions and orders of the court, as well as mediation settlements. Arbitration awards will be enforced as New York Convention awards through the Arbitration Act 1996.	
83(1)	Provides a transitional period, during which certain actions can continue to be brought before national courts	Article 2(10) of the Order inserts paragraph 2(1) of Schedule A4, which makes direct reference to the provisions of Article 83(1).	
83(2)	Sets out that actions pending before national courts are unaffected by the expiry of the transitional period	Article 2(10) of the Order inserts paragraph 2(1) of Schedule A4, which states that the general provisions set out in Article 83 (including Article 83(2)) apply to actions referred to in Article 83(1).	
83(3)	Sets out that, during the transitional period, certain patents can be opted out of the Agreement, provided no action has been brought before the Court	Article 2(10) of the Order inserts paragraph 2(2) of Schedule A4, which makes direct reference to the provisions of Article 83(3).	
83(4)	Sets out that the opt-out can be withdrawn,	Article 2(10) of the Order inserts paragraph 2(3) of	

	provided no action has been brought before a national court	Schedule A4, which makes direct reference to the provisions of Article 83(4).	
89	Fixes the date of entry into force of the Agreement	No transposition is required, as this relates to the operation of the Agreement; however, the Order links its own entry into force to that of the Agreement in Article 1(2).	