

CEOE

CONFEDERACIÓN ESPAÑOLA DE
ORGANIZACIONES EMPRESARIALES



System ochrony własności przemysłowej w Polsce a możliwości rozwoju gospodarczego

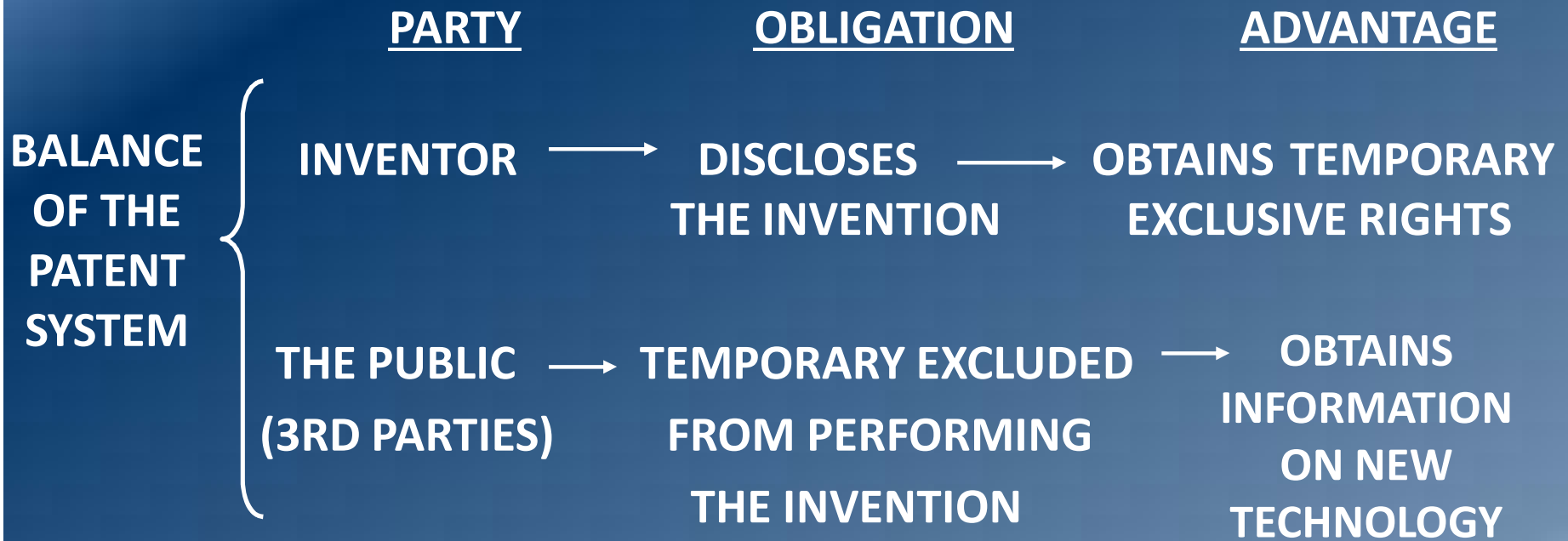
Skutki związane z wprowadzeniem Europejskiego Patentu Jednolitego rozpoznane przez takie kraje jak: Hiszpania, Polska i Niemcy

Warszawa, 6 maja 2014

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Chair of CEOE IP Committee

WITH THE UNITARY PATENT THE REQUIRED BALANCE OF ANY PATENT SYSTEM IS DISRUPTED



HOW MUST BE THE DISCLOSURE OF THE INVENTION BE GIVEN TO THE PUBLIC BY THE INVENTOR?

- THE DISCLOSURE OF THE INVENTION BY THE INVENTOR IN THE PATENT MUST BE IN A MANNER SUFFICIENTLY CLEAR AND COMPLETE FOR IT TO BE CARRIED OUT BY A PERSON SKILLED IN THE ART (ART. 83 EPC)

-THE REQUIREMENT OF INSUFFICIENCY OF DISCLOSURE IS PENALIZED BY THE EPC WITH:

a) A GROUND OF OPPOSITION [ART. 100 (b) EPC]

b) A GROUND OF REVOCATION [ART. 138 (1) (b) EPC]

WHO IS THE PERSON SKILLED IN THE ART?

- A SKILLED PRACTITIONER IN THE RELEVANT FIELD OF TECHNOLOGY WHO IS POSSESSED OF THE AVERAGE KNOWLEDGE AND ABILITY AND IS AWARE OF WHAT IS COMMON GENERAL KNOWLEDGE IN THE ART AT THE RELEVANT DATE (EPO GUIDELINES FOR EXAMINATION. PART G. CHAPTER VI. 3)
- IN THE TERRITORY WHERE THE PATENT IS PROTECTED

HOW TRANSLATIONS ARE DEALT WITHIN THE EPC?

- FILING OF A FULL TRANSLATION OF THE PATENT INTO THE OFFICIAL LANGUAGE OF THE MEMBER STATE WITHIN 3 MONTHS OF THE GRANT [ART. 65 EPC]
- IF NO TRANSLATION FILED, NO PROTECTION
- IF THE TRANSLATION GIVES A NARROWER SCOPE OF PROTECTION THAN ORIGINAL TEXT, THE NARROWER SCOPE OF PROTECTION APPLIES IN THAT MEMBER STATE [ART. 70 EPC]
- EVEN IF A CORRECTION OF THE TRANSLATION IS FILED, THE NARROWER EARLIER EFFECTS WILL APPLY TO ANY THIRD PARTY WHO HAD STARTED TO USE THE INVENTION BEFORE THE CORRECTION [ART. 70 (4) EPC]

**IN SUMMARY, THE EPC GIVES
EXTRAORDINARY IMPORTANCE TO:**

- THE SUFFICIENCY OF DISCLOSURE**
- THE QUALITY OF TRANSLATIONS AND PUTS
ALL THE BURDEN OF TRANSLATION
MISTAKES ON THE PATENTEE**

WHAT CHANGES WITH THE UNITARY PATENT?

- THE PATENTEE DOES NOT HAVE TO TRANSLATE THE PATENT TO THE OFFICIAL LANGUAGES OF THE CONTRACTING STATES WHERE OBTAINS PROTECTION
- THE EPO PROVIDES A MACHINE TRANSLATION WITHOUT LEGAL EFFECTS
- A TRANSLATION IS FILED, IN THE LANGUAGE OF THE LOCAL DIVISION AT THE TIME WHEN AN INFRINGEMENT ACTION IS FILED (THAT DOES NOT NECESSARILY NEED TO BE A LOCAL DIVISION OF THE MEMBER STATE OF THE DEFENDANT AND THAT MIGHT BE DIFFERENT FROM THE MACHINE TRANSLATION OF THE EPO)

CONSEQUENCES FOR POLISH AND SPANISH ENTERPRISES OF THE UNITARY PATENT IF THESE COUNTRIES JOIN THE SYSTEM

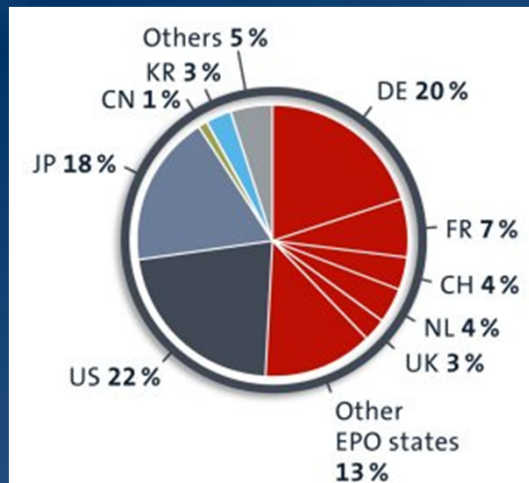
- ALL EUROPEAN PATENTS GRANTED, WHOSE OWNERS WOULD DESIGNATE THE UNITARY PATENT, WOULD BE PROTECTED IN THESE TERRITORIES WITHOUT THE NEED OF FILING ANY TRANSLATION

-THIRD PARTIES WOULD NOT BE ABLE TO UNDERSTAND IN THEIR LANGUAGE (POLISH, SPANISH) THE INVENTION WITH REGARD:

- a) The technology protected → They will not benefit from the required disclosure
- b) The scope of protection → What they should refrain from doing to skip a legal action for infringement

IMPACT IN POLAND & SPAIN VERSUS GERMANY

GRANTED EUROPEAN PATENTS PER COUNTRY OF ORIGIN OF ITS APPLICANT (2013)



TOTAL : 66.707

UNITED STATES: 14.877 (22,3%)

GERMANY : 13.425 (20,12%)

JAPAN : 12.133 (18,18%)

SPAIN : 395 (0,59%)

POLAND : 95 (0,14%)

60,6%

SOURCE: EPO

- GERMAN COMPANIES WILL BENEFIT OF TRANSLATION COST REDUCTION IN 20,12% OF CASES
- POLISH AND SPANISH COMPANIES WILL BENEFIT ONLY IN 0,14% & 0,59%, WHAT MEANS THAT THE BURDEN TO SUFFER OF UNTRANSLATED PATENTS WILL BE OF 99,86% AND 99,41% RESPECTIVELY

FOR POLISH AND SPANISH COMPANIES THE UNITARY PATENT WILL REPRESENT

- INCREASE OF PATENTS PROTECTED BY FOREIGN COMPANIES, WHILE POLISH & SPANISH COMPANIES WILL NOT BENEFIT OF THE TRANSFER OF TECHNOLOGY IN THEIR LANGUAGES
- INCREASE OF TRANSLATION COST FOR POLISH & SPANISH COMPANIES WHEN CONDUCTING FREEDOM TO OPERATE ANALYSIS IN THEIR COUNTRIES
- INCREASE LEGAL UNCERTAINTY CONCERNING RISK OF INFRINGEMENT
- NO PRACTICAL ADVANTAGE FOR DOMESTIC COMPANIES

ENVISAGED INCREASE IN NUMBER OR RIGHTS PROTECTED IN POLAND

- IN 2011 ONLY 10% (6.102 OUT OF 59.977 GRANTED EP) WERE VALIDATED IN POLAND
- WITH THE UNITARY PATENT, SINCE TRANSLATION WOULD NOT BE REQUIRED, 100% OF THE GRANTED EP COULD BE AUTOMATICALLY PROTECTED IN POLAND
- THAT WOULD REPRESENT A 90% YEAR INCREASE IN PROTECTED RIGHTS IN POLAND (99,9% OWNED BY NON POLISH PATENTEES)
- IN 2013 66.707 EP WERE GRANTED, WHAT WOULD REPRESENT AROUND 60.000 MORE PATENTS PROTECTED PER YEAR, BUT WITH 0% TRANSLATION OF THESE PATENTS INTO POLISH LANGUAGE → POLISH WOULD PRACTICALLY DISAPPEAR AS A TECHNICAL LANGUAGE FOR PATENTS

DISCRIMINATION OF POLISH AND SPANISH COMPANIES VERSUS GERMAN, FRENCH AND ENGLISH SPEAKING COMPANIES

- UNITARY PATENTS (RECOGNIZED BY A EU REGULATION) CAN BE FILED AND PROSECUTED IN ENGLISH, FRENCH AND GERMAN ONLY
- ENGLISH, FRENCH AND GERMAN CAN BE USED TO OPPOSE ANY EUROPEAN PATENT, IRRESPECTIVELY OF THE LANGUAGE CHOSEN BY THE APPLICANTS
- THIS MEANS THAT A GERMAN COMPANY CAN FILE AND PROSECUTE THEIR PATENTS IN THEIR OWN LANGUAGE (WITH THE CORRESPONDING SAVINGS), WHILE POLISH AND SPANISH HAVE TO USE A FOREIGN LANGUAGE.
- THIS ALSO MEANS THAT, EVEN PATENTS FILED IN, FOR EXAMPLE ENGLISH, BY POLISH & SPANISH COMPANIES COULD BE OPPOSED IN GERMAN LANGUAGE BY A GERMAN COMPANY. THIS IS A CLEAR DISCRIMINATION AND GIVES AN ADDITIONAL COMPETITIVE ADVANTAGE TO GERMAN COMPANIES

LITIGATION

- THE PATENTEE CAN CHOOSE TO FILE A LEGAL ACTION FOR INFRINGEMENT:
 - THE LOCAL DIVISION OF THE DOMICILE OF THE DEFENDANT
 - THE LOCAL DIVISION OF THE PLACE OF THE INFRINGEMENT
- IN PRACTICE. IT WILL BE QUITE EASY TO HAVE A PRODUCT IN A PRESELECTED MEMBER STATE (NOWADAYS FACILITATED BY SALES THROUGH INTERNET) AND SUE A DEFENDANT IN FRONT OF A FOREIGN LOCAL DIVISION.
- THE DEFENDANT WILL HAVE TO LITIGATE IN A FOREIGN LANGUAGE IN FRONT OF FOREIGN JUDGES, BUT THE EFFECTS OF THE EVENTUAL INJUNCTION WILL APPLY TO ALL MEMBER STATES OF THE UNITARY PATENT, INCLUDING THE COUNTRY OF ORIGIN OF THE DEFENDANT

PROCEEDINGS BEFORE THE CENTRAL DIVISION: ONLY

- INVALIDATION ACTIONS**
- SOME INFRINGEMENTS ACTIONS**

**COULD ONLY BE CONDUCTED IN THE LANGUAGE OF
THE EUROPEAN PATENT (ENGLISH, FRENCH, GERMAN)**

**ANOTHER DISCRIMINATION FOR POLISH & SPANISH
COMPANIES THAT REPRESENT A COMPETITIVE
DISADVANTAGE**

IMPACT IN POLISH AND SPANISH COMPANIES

- IF PL & ES ARE MEMBERS OF THE UP, AN INJUNCTION WILL PREVENT A POLISH OR SPANISH COMPANY OF MANUFACTURING THE INVENTION IN THEIR HOME COUNTRIES, EVEN FOR EXPORTS TO NON UP COUNTRIES WHERE THE INVENTION IS NOT PATENTED.
- IF PL & ES ARE NOT MEMBERS OF THE UP, SUCH AN INJUNCTION WILL NOT HAVE EFFECTS IN PL OR ES. IF THE PATENT HAS BEEN VALIDATED IN PL AND ES, A NEW LEGAL ACTION IN PL AND ES, IN POLISH AND SPANISH LANGUAGE SHOULD BE CONDUCTED.
- IF THE PATENT IS NOT PROTECTED IN PL & ES, THE DEFENDANT COULD CONTINUE MANUFACTURING & SELLING IN PL & ES AND IN ALL OTHER COUNTRIES WHERE THE PRODUCT IS NOT PATENTED