

The UPC Opt-Out

Kevin Mooney
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The UPC Opt-Out

Jurisdiction of the UPC

- Article 31 UPC Agreement – International jurisdiction
 - The international jurisdiction of the Court shall be established in accordance with Regulation (EU) No 1215/2012 (BR) or, where applicable, on the basis of the Convention on jurisdiction and the recognition and enforcement of judgements in civil and commercial matters (Lugano Convention)
 - Regulation BR was amended in 2014 by Regulation 542/2014 to accommodate the UPC and specifically to amend BR by inserting a new Article 71. This Article has the following effects:
 - Article 71a and b(1) – The UPC is treated as a court of a Member State of BR and enjoys the same jurisdiction as a court of a Member State in respect of defendants domiciled in another Member State.

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Jurisdiction of the UPC

- Article 71b(2) – The UPC has jurisdiction over defendants not domiciled in a Member State (a “third state”, eg the UK) for infringements of European Patents **within** the EU. Article 35 BR expressly applies even if the courts of the third state (UK) have jurisdiction over the substance of the dispute.
- Article 71b(3) – the UPC also has jurisdiction to grant relief over a defendant domiciled in a third state (the UK) in respect of infringements of a European patent in the third state if certain conditions are satisfied (“the long arm jurisdiction”). The relevant conditions are:
 - (i) The defendant is infringing a European patent in the EU
 - (ii) The defendant has property located in any Member State of UPC
 - (iii) The infringement dispute has “sufficient connection” with a such Member State.
- Article 71c.1 – the lis alibi pendens provisions of BR (Articles 29-32) applies to the UPC during the transitional period (see below)

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Jurisdiction of the UPC

- The BR has no effect on the internal jurisdictional arrangements in the UPC Agreement. The one exception to this is the possible application of the *lis alibi pendens* provisions of BR on Articles 32 and 33 UPCA as a result of Article 83(1) UPCA.

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Jurisdiction of the UPC

- Article 32 UPC Agreement – “Exclusive” Competence
 1. The Court shall have exclusive competence in respect of
 - a) actions for actual or threatened infringements of patents and supplementary protection certificates **and related defences, including counterclaims concerning licences**
 - b) actions for declarations of non-infringement of patents and supplementary protection certificates
 - c) actions for provisional and protective measures and injunctions
 - d) actions for revocation of patents and for declaration of invalidity of supplementary protection certificates
 - e) counterclaims for revocation of patents and for declaration of invalidity of supplementary protection certificates
 - f) actions for damages or compensation derived from the provisional protection conferred by a published European patent application

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Jurisdiction of the UPC (continued)

- g) actions relating to the use of the invention prior to the granting of the patent or to the right based on prior use of the invention
 - h) actions for compensation for licences on the basis of Article 8 of Regulation (EU) No 1257/2012; and
 - i) actions concerning decisions of the European Patent Office in carrying out the tasks referred to in Article 9 of Regulation (EU) No 1257/2012
2. The national courts of the Contracting Member States shall remain competent for actions relating to patents and supplementary protection certificates which do not come within the exclusive competence of the UPC
- e.g. pure contractual licence disputes **but a defence of license** could be considered by the UPC
 - entitlement disputes
 - employees' invention remuneration
 - Frand issues **unless, again, raised by way of defence**

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Jurisdiction of the UPC (continued)



- When the Agreement was first drafted it was proposed that this “exclusive” jurisdiction should apply from the day of the court opening. (The “purist theory” of jurisdiction)
- The purist theory of jurisdiction was subsequently diluted by the following transitional provisions

Article 83 UPC Agreement

- 1) During a transitional period of seven years after the date of entry into force of this Agreement, **an action for infringement or for revocation of a European patent or an action for infringement or for declaration of invalidity of a supplementary protection** certificate issued for a product protected by a European patent may still be brought before national courts or other competent authorities
- 2) An action pending before a national court at the end of the transitional period shall not be affected by the expiry of this period

Jurisdiction of the UPC – Transitional Provisions (continued)

3. Unless an action has already been brought before the court, a proprietor of or an applicant for a European patent granted or applied for prior to the end of the transitional period under paragraph 1 and, where applicable, paragraph 5, as well as a holder of a supplementary protection certificate issued for a product protected by a European patent, shall have the possibility **to opt out from the exclusive competence of the Court**. To this end they shall notify their opt-out to the Registry by the latest one month before expiry of the transitional period. The opt-out shall take effect upon its entry into the register
4. Unless an action has already been brought before a national court, proprietors of or applicants for European patents or holders of supplementary protection certificates issued for a product protected by a European patent who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt-out at any moment. In this event they shall notify the Registry accordingly. The withdrawal of the opt-out shall take effect upon its entry into the register

Jurisdiction of the UPC

Article 83 UPC Agreement – Issues

- Summary
 - Article 32(1) – “exclusive competence” for “actions” (a) to (i) in respect of EP and Unitary patents
EXCEPT
 - Article 83(1) – Transitional period of 7 years for parallel national actions “for infringement or for declaration of invalidity” of a European patent or SPC which have not been opted out
 - Article 83(3) – The opt-out possibility if an action has not already been brought before the UPC in respect of the relevant European patent or SPC

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Opt-Out Issues



- What is the meaning of opting out from the “**exclusive** competence” of the UPC pursuant to Art 83(3)? Does this leave a **non-exclusive** competence with the UPC?
- Better view is that there is no residual non-exclusive jurisdiction – otherwise there is no difference between Art. 83(3) and Art. 83(1) but if a party attempts a parallel UPC action (eg revocation in the Central Division response to a national action for infringement), which Court will decide the jurisdictional issue – the national Court with possible reference to CJEU under Brussels Regulation or the UPC as this involves interpretation of the Agreement
- Is Article 83 limited to the transitional period for opt-outs or is an opt-out effective for the life of the patent and for all designations and SPCs unless withdrawn (the “purist approach”). All seem to agree that the purist approach is correct.

The UPC Opt-Out

The Basic Opt-Out Provisions

- Rule 5 of the Rules of Procedure set out the opt-out provisions. Essentially a granted European bundle patent may only be opted out by the “proprietor” (and an SPC by the “holder” of the SPC) during the 7 year transitional period. Expired patents can also be opted out (Rule 5.1) and also published applications. If an application is opted out but later granted as a unitary patent the opt-out will be deemed withdrawn (Rule 5.9).
- Rule 8 – Who is the “Proprietor”?
- Rule 8.5 makes clear that the “proprietor” of a European patent is the person **entitled** to be recorded as proprietor in each country where the patent has been validated even if not in fact registered. This also applies to an applicant for a patent as well i.e. the person entitled to be granted the patent even if not the original applicant

The Basic Opt-Out Provisions

- Rule 5 provides
 - Application to opt out must be filed at the Registry (standard form will be available on the Case Management System – see later)
 - All proprietors of all designations of the parties and the holders of all existing SPCs must make the application
 - Note the proposed amendment to Rule 5 re “all designations” – see later.
 - In practice the proprietors will appoint a person to make the application. If this is a “representative” no mandate is required otherwise a mandate from the proprietor(s) must be lodged.

The UPC Opt-Out

The Basic Opt-Out Provisions



- The opt-out applied for in the sunrise period will be formally entered on the register and effective on the date that the court opens.
- The opt-out will last for the life of the patent/SPC unless withdrawn
- An opt-out may be withdrawn by all proprietors and holders.
- The manual application on the CMS will take 15 to 60 seconds to complete depending on the extent of information to be inputted.
- Applications for multiple opt-outs are possible via an API (see the UPC website)
- SPCs granted at the time of opt-out must also be opted-out as part of the same application. SPCs granted following the opt-out of the basic patent will be automatically opted out.
- There must be certification that the person lodging the application is authorised by all “proprietors” etc and for non-representatives a mandate must be lodged.

The UPC Opt-Out

The Opt-Out Provisions

- Restrictions on applications to opt out
 - a Unitary Patent cannot be opted out
 - a European Patent cannot be opted out if there has been any proceeding in the UP Court prior to the date of application
 - an opt-out cannot be withdrawn if there has been any proceeding in any national court in respect of any member of the patent family (or any granted SPC) before the date of the application
- In order to prevent fraudulent applications the identity of the person lodging the application to opt out will be assured by a “strong authentication system” still under discussion
- There will be a procedure for the cancellation of an unauthorised opt-out (eg mistaken number)

The Opt-Out Provisions

- Incorrect Details – Rule 5.6

If certain details required for opting out (Rule 5.3) are missing or incorrect the opt-out is ineffective until corrected. The details in question are essentially the names of all proprietors/applicants/holders and the countries where the EP is validated

- Sunrise procedure – Rule 5.13

This will now be operated by the Registry of the UPC as part of the provisional application of the UPCA before the Agreement and the Court comes into effect

Opting Out - requirements

- The current draft of Rule 5 states that the opt-out is to be made in respect of “*all of the Contracting Member States*” for which an EP/application is granted/designated
- This will be amended to refer to “*all of the states...*”
 - Existing wording said to be “*inconsistent with the indivisibility of the application to not opt out*” and “implies that the UPC solely has jurisdiction over [UPC states], which is not the case”
 - New wording avoids a ‘moving target’ of proprietors if additional states ratify the UPCA
- **BUT** now means:
 - Proprietors/applicants for all designations, including outside UPC states must lodge the opt-out – not just other EU states (e.g. Spain), but non-EU EPC states (e.g. Turkey)
 - Greater due diligence to ensure all proprietors/applicants of all designations are covered
 - May include designations outside of main ‘European’ commercial markets (e.g. Turkey) that may be treated differently (e.g. assigned to third parties).

The UPC Opt-Out

AIPs for 'automated' opt outs

- The UPC has published details of an API (application programming interface) to carry out automated opt-out, withdrawal and correction filings via the case management system (CMS)
- By carrying out repeated API 'calls', it can file applications for multiple patents
- The CMS will
 - search the EPO's system for the patent number (and, if found, retrieve basic information)
 - require mandatory fields to be filled (such as the applicant and patent number) and documents to be supplied (e.g. a mandate, if applicant is not a registered representative)and reject the application and return an error message if there are gaps
- The UPC provides only the API code, not the user interface
 - Commercial third parties are likely to provide this for patent proprietors
 - Patent attorney firms are expected to commission their own software and offer opt-outs/withdrawals as a service

The UPC Opt-Out

Opting out – due diligence

- **Wholly owned patents**
 - Are all designations with the same group entity (including non-EU/UPC designations)?
 - Are the right entities on all registers? Cleaner and may avoid later challenges
- **Co-owned patents**
 - All co-proprietors must opt out – who will file it? Seek a joint mandate?
 - Seek confirmations that no one else entitled and the right parties are registered?
- **Licensed patents** - licensees, even if exclusive, have no role in opt out under UPCA/Rules
 - **Patents licensed to**
 - What does the licence say about the opt-out (if anything) or control of litigation etc.?
 - Write to licensor asking them to opt out (or not to!) and reminding them to do their DD
 - **Patents licensed by**
 - Ask licensee's views on opt out? Make a recommendation?

The UPC Opt-Out

Unauthorised op-outs/withdrawals

- The UPC will use two-factor authentication using SMS and email to ensure the person logging into an account is the owner of the account, described as “balanced approach”
- Because of the lack of a definitive list of proprietors, filing opt-outs/withdrawals has not been restricted to registered proprietors – there is therefore concern about unauthorised filings
- A new Rule 5A has therefore been proposed
 - The proprietor/applicant may lodge an application to remove an unauthorised opt-out/withdrawal, setting out its reasons
 - The registrar is to decide as soon as practicable and, if he accepts the application, will delete the unauthorised opt-out/withdrawal from the register
 - The decision may be subject to an application for review by the President of the CA
- If an opt-out/withdrawal has been made by an unauthorised third party it seems likely that a declaration from the genuine proprietor to that effect would be sufficient for the Registrar to act

The UPC Opt-Out

Risk of challenge to an opt-out?

- The Registry will not conduct any substantive checks on an opt-out (or withdrawal)
- Rule 5.5 (and similar rules for withdrawal of opt-outs under Rule 5.7) provides:
 - An opt-out which meets the requirements ... shall be regarded as effective from the date of entry in the register” – so an opt-out that does not meet Rule 5 may be ineffective
 - Missing or incorrect details may be corrected, in which case the opt-out is effective from the date of correction (unless “obvious to the reasonable third party”, according to CMS)
- Uncertain how strictly the UPC will interpret “meets the requirements” – e.g.
 - Non-obvious but minor errors (e.g. an out-of-date address for the correct proprietor)?
 - More significant errors (e.g. omitting one designation/SPC, wrong entity in a group)?
- If an ‘opted-out’ EP is attacked in a revocation action, claimant is informed of opt-out (Rule 16.1) **but** not struck out
 - The claimant can continue the action and the proprietor would need to bring a Preliminary Objection (Rule 19)
 - Onus then on the proprietor – and the defence deadline continues to run
- The opt-out contains limited details (e.g. only a declaration that proprietors are entitled to be registered) so may be difficult to unpick unless wrong on its face (e.g. missing designations)

The UPC Opt-Out

Reasons for opting out

- Risk of central attack – the key risk of the UPC for patentees
 - A single revocation action for all UPC designations
- Uncertainties of a new court
 - Risk that it could start before it is ready – procedural chaos?
 - Uncertainty as to law and procedure (including how discretions will be applied, e.g. bifurcation, Pls, saisies), quality of judges and variations between divisions
 - **BUT** – important safeguards, including:
 - Germany is acting as gatekeeper for sunrise period and is invested in UPC's success
 - UPC attractive for senior judges and will be well trained and sit in multi-national panels
 - All revocation actions will include a technical judge on the panel
 - There is a mechanism for interim and procedural orders to be reviewed/appealed

Reasons for not opting out

- Ability to enforce across UPC states – the key advantage of the UPC for patentees
 - Pan-UPC provisional measures – PI (inc *ex parte*), seizure and freezing orders
 - Wide measures for obtaining evidence (e.g. saisie, disclosure, cross-examination)
 - Quick (~12 months) and likely cheaper than multiple national infringement actions
- Dual jurisdiction for EPs during transition period – maximum flexibility and leverage
 - Likely to be able to ‘mix and match’ national proceedings with the UPC
 - e.g. use EP(DE) in German courts to get benefit of ‘injunction gap’, and other EPs in UPC
 - Won’t get ‘pinned out’ of the system
- ‘Long-arm’ jurisdictions over non-EU/non-Lugano-domiciled defendants:
 - Possibility of provisional measures in non-participating EPC states
 - Assets-based jurisdiction for damages for acts in non-EU/Lugano EPC states, which could allow ‘adding on’ acts in, e.g., UK or Turkey, to a UPC infringement claim
- Experience in and influence over the court (i.e. shaping its case law)

Registration as a Representative

- Article 48 UPCA permits the following to register:
 - “Lawyers” authorised to practice before a Contracting Member State (Directive 98/5/EC)
 - European Patent Attorneys (Article 134 EPC) with an EPLC
 - European Patent Attorneys with other “appropriate qualifications (see draft Decision of the Administrative Committee Part II Rules 11 to 14)
- The procedure for registration – Rule 286
 - Each person must have an account on the CMS with “strong identity authentication”
 - Each EPA must upload (in the CMS) proof of entitlement (EPLC or other)
 - Each lawyer must upload a relevant certificate authorising legal practice
 - The Registrar is required to check the entitlement of EPAs.
 - The list of representatives (EPAs and lawyers) will be available to the public

Screenshots



Einheitliches Patentgericht
Unified Patent Court
Jurisdiction unifiée du brevet

UPC Case Management System
Beta Test Site

ENGLISH

Preparing for Sunrise

This is the Case Management System of the Unified Patent Court.

This site is currently in the test phase.

Business enquiries relating to the Unified Patent Court can be addressed using the contacts form provided on the Court's site: <https://www.unified-patent-court.org/contact>.

Sign In

Email Address

This field is required.

Password

Sign In

[Create Account](#)

[Forgot Password](#)

[Sign In](#)

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FAQ

Screenshots



The screenshot displays the 'UPC Case Management System' interface. At the top, there is a navigation bar with the 'unified patent court' logo, the text 'UPC Case Management System', and user information including 'ENGLISH', a profile icon, and 'C C UPC EXTERNAL'. A teal sidebar on the left contains icons for home, court, calendar, search, and documents.

The main content area is titled 'My Tasks' and features a search filter section with the following fields:

- Number:
- Year:
- Proceeding Type:
- Court Division:

A 'Search' button is located to the right of these filters. Below the filters, a table header is visible with columns: Number, Proceeding Type, Step, Task Name, Due Dates, and Court Division. The table body is currently empty, and a message 'Total results: 0' is displayed. A pagination bar at the bottom of the table shows 'Page 1 of 1' and a dropdown menu set to '20'. A 'No records to view' message is also present.

Below the 'My Tasks' section is a 'My Proceedings' section, which contains a light green box with the text 'No Results Found'.

At the bottom of the page, the footer includes the copyright notice '© 2022 UPC CMS v0.62. Privacy Policy Terms and Conditions' on the left and 'powered by Net Service S.p.A.' on the right. An 'FAQ' button is located in the bottom right corner.

Screenshots



The screenshot displays the 'UPC Case Management System' interface. On the left is a teal sidebar with navigation options: Dashboard, Appeals and Reviews, Opt-out, Representation, Search Register, Lists, and My Developer App. The main content area features a search filter section with dropdowns for 'Year' (set to 2022), 'Proceeding Type' (set to All), and 'Court Division' (set to -- Select Division). A search button is present, and the results show 'Total results: 0'. Below the filters is a table header with columns: Proceeding Type, Step, Task Name, Due Dates, and Court Division. The table body is empty, and a message states 'No records to view'. The page footer includes 'Privacy Policy Terms and Conditions' and 'powered by Net Service S.p.A.', along with an 'FAQ' button.

Screenshots



The screenshot displays the 'UPC Case Management System' interface. On the left is a teal sidebar with navigation options: Dashboard, Appeals and Reviews, Opt-out (expanded), Representation, Search Register, Lists, and My Developer App. The 'Opt-out' menu includes: Opt-out, Withdrawal of Opt-out, Correction of Opt-out, Correction of Withdrawal of Opt-out, Application to remove an unauthorised opt-out, and Application to remove an unauthorised withdrawal of an opt-out. The main content area features search filters for Year (2022), Proceeding Type (All), and Court Division (-- Select Division). A search button and 'Total results: 0' are visible. Below the filters is a table with columns: Proceeding Type, Step, Task Name, Due Dates, and Court Division. The table is empty, with a message 'No records to view' and pagination 'Page 1 of 1'.

Screenshots



The screenshot shows the 'UPC Case Management System' interface. The browser address bar displays 'cms.unified-patent-court.org'. The page header includes 'ENGLISH' and 'C C UPC EXTERNAL' with a user profile icon. A teal sidebar on the left contains a menu with items: Dashboard, Appeals and Reviews, Opt-out (expanded), Opt-out, Withdrawal of Opt-out, Correction of Opt-out, Correction of Withdrawal of Opt-out, Application to remove an unauthorised opt-out, Application to remove an unauthorised withdrawal of an opt-out, Representation, Search Register, Lists, and My Developer App. The main content area features a search filter with three dropdown menus: 'Year' (set to 2022), 'Proceeding Type' (set to All), and 'Court Division' (set to -- Select Division). A 'Search' button is located to the right of these filters. Below the filters, a table header is visible with columns: Proceeding Type, Step, Task Name, Due Dates, and Court Division. The table content is empty, with a message 'No records to view' and 'Total results: 0'. A pagination bar at the bottom of the table shows 'Page 1 of 1' and a dropdown for '20' items per page. At the bottom of the page, there are links for 'Privacy Policy' and 'Terms and Conditions', a 'powered by Net Service S.p.A.' notice, and an 'FAQ' button.

The screenshot shows a web browser window with the URL `cms.unified-patent-court.org`. The page title is "UPC Case Management System". In the top right corner, there is a language selector set to "ENGLISH" and a user profile icon labeled "C C UPC EXTERNAL". A vertical teal sidebar on the left contains navigation icons for home, building, document, user, search, calendar, and a copy icon.

Opt Out a Patent

In this guidance unless the context otherwise requires "patent" refers both to a granted patent and an application for a patent. Patent "proprietor" refers also to a patent applicant.

It is not possible to opt out a European patent with unitary effect. If unitary effect is given to a European patent based on the application to which this opt-out Application relates, the opt-out is deemed to be withdrawn from the date of grant of the patent pursuant to RoP5.9.

It is also not possible to opt out any patent/SPC which is the subject of a pending or prior action before the UPC.

The opt-out will be effective in respect of any SPC granted after the registration of this opt-out pursuant to RoP5.2(b).

An opt-out Application submitted before the date of entry into force of the Agreement on a UPC will be recorded but will be treated as formally lodged and effective on the date of entry into force of the Agreement in accordance with Art.83.3 of the Agreement on a UPC and RoP5.12.

Following the lodging of the opt-out Application the relevant patent application number will be entered in the register and a receipt will be available on the CMS with details of the Application which will be available to the public.

A patent proprietor who wishes to opt out must complete this Application form and must separately lodge an opt-out document fulfilling all the requirements pursuant to RoP5.3. The opt-out Application must be lodged by or on behalf of all proprietors. A template is provided below.

The opt-out Application may be lodged on behalf of each patent proprietor by a registered user of the CMS who is authorised by all proprietors and all holders of SPCs to lodge the opt-out. Such user must declare in the opt-out Application that each patent proprietor is entitled to be registered as proprietor pursuant to RoP8.5.

If at the date of the opt-out one or more SPCs have been granted in respect of the patent each SPC holder, if different from the patent proprietor(s), must lodge or authorise the opt-out Application in addition to each patent proprietor. Such a patent must be opted out even if lapsed.

If the authorised user is a representative before the UPC in accordance with Art.48 of the Agreement on a UPC a mandate authorising the opt-out is not required. If the user is not such a representative a mandate from all patent proprietors and SPC holders must be lodged specifically authorising the opt-out. A template for the mandate is provided below.

A natural person who is the sole patent proprietor may lodge the opt-out Application without a mandate.

If the opt-out Application is lodged in respect of a patent which is the subject of an unauthorised opt-out an Application to remove that unauthorised opt-out will be automatically available when this opt-out is lodged.

Templates

It is possible to download templates:

- [Template for the opt-out document](#) - this template sets out all information required to be lodged in your opt-out document
- [Template for the mandate](#)

START

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The screenshot shows a web browser window with the address bar displaying `cms.unified-patent-court.org`. The page title is "UPC Case Management System". In the top right corner, there is a language selector set to "ENGLISH" and a user profile icon labeled "C C UPC EXTERNAL". A teal sidebar on the left contains navigation icons for home, court, document, user, search, calendar, and a document icon. The main content area features a white box with the heading "Opt Out a Patent" and the message: "Application 1680/2022 Successfully Created. You are being redirected to the [case detail page](#)." At the bottom left, the footer text reads "© 2022 UPC CMS v0.62. Privacy Policy Terms and Conditions". At the bottom right, it says "powered by Net Service S.p.A." and there is a small "FAQ" button.

Screenshots



The screenshot displays the 'UPC Case Management System' interface. At the top, the browser address bar shows 'cms.unified-patent-court.org'. The page header includes 'UPC Case Management System', 'ENGLISH', and a user profile for 'C C UPC EXTERNAL'. A vertical sidebar on the left contains navigation icons for home, court, documents, user, search, calendar, and a document icon.

The main content area is divided into two sections. The left section, titled 'No. 1681 / 2022', features three buttons: 'Discard', 'Discard Stage', and 'Start related proceeding'. Below this, there is an 'Opt-out' section with a gear icon and a 'Personal Details' link. A table with three tabs ('Overview', 'Documents', 'Activities Log') is active on the 'Overview' tab, showing the following data:

Proceeding number	1681
Proceeding Type	Opt-out
Documents	0

The right section is a 'Calendar' for April 2022. It includes navigation arrows, a 'Today' button, and view options for 'day', 'week', 'month', and 'Year List'. A 'Refresh' button is located in the top right of the calendar area. The calendar grid shows the following dates:

Mon	Tue	Wed	Thu	Fri	Sat	Sun
28	29	30	31	1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	1
2	3	4	5	6	7	8

At the bottom of the page, there is a copyright notice: '© 2022 UPC CMS v0.62. Privacy Policy Terms and Conditions' and a note 'powered by Net Service S.p.A.'. A small 'FAQ' button is visible in the bottom right corner.

Go to #mm-4 on this page

The screenshot displays the 'Personal Details - Opt-out - Opt-out - 1681/2022' form in a web browser. The browser address bar shows 'cms.unified-patent-court.org'. The page title is 'UPC Case Management' and the case number is 'No. 1681 / 2022'. The form is titled 'Personal Details' and includes a sidebar with navigation icons and a 'Personal Details' tab.

Personal Details - Opt-out - Opt-out - 1681/2022

The personal details provided in this form must also be included in the opt-out document as required by RoP5.3.

Person lodging this Application to opt out on behalf of each proprietor
* indicates required data

Data available in precompiled fields is retrieved from user profile and company data

First Name *

Last Name *

Company/Firm *

Contact e-mail *

Postal address

Street *

City *

Postcode *

Country *

Registered address (only for companies)

Same as postal address

Case Reference

Internal case reference

Status of the person lodging the Application

Status of the person lodging the Application *

Registered representative before the UPC (Art. 48 UPCA)
Person authorised to lodge by a mandate
Proprietor/applicant/holder who is a natural person

Cancel

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Go to #mm-4 on this page

ENGLISH C C
UPC EXTERNAL

Refresh

Today day week month Year List April 2022

Tue	Wed	Thu	Fri	Sat	Sun
29	30	31	1	2	3
5	6	7	8	9	10
12	13	14	15	16	17
19	20	21	22	23	24
26	27	28	29	30	1
3	4	5	6	7	8

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The screenshot displays the 'UPC Case Management' interface. The main content area is titled 'Patent Data - Opt-out - Opt-out - 1681/2022'. It includes a search section with a 'Patent Number' dropdown set to 'EP' and an input field containing '12345'. A 'Search' button is located to the right. Below the search results, a table lists one patent: EP0012345, described as 'Fuel oils and their application.', with a 'Select' button. A 'List of patents' section shows one result in a table with columns for 'Patent Number', 'Description', and actions like 'Hide Detail' and 'Remove'. A light blue banner indicates 'Data retrieved from the EPO on 27.04.2022'. Below this, a detailed view of the patent is shown with fields for Patent Number, Description, Applicant, Application reference, Filing date, Priority claim date, and Date of publication of the grant. A sidebar on the right contains a calendar for April 2022 and a 'Refresh' button. The bottom left of the interface has a 'Go to #mm-4 on this page' link.

UPC Case Management

No. 1681 / 2022

Opt-out

Personal Data

Patent Data

Patent Data - Opt-out - Opt-out - 1681/2022

In this guidance unless the context otherwise requires "patent" refers both to a granted patent and an application for a patent. Patent "proprietor" refers also to a patent applicant. Search the EPO database for each patent.

Patent Number: EP 12345

Search

Search Results

Select the desired patent to add it to the list of patents.

Patent no.	Description	
EP0012345	Fuel oils and their application.	Select

List of patents

1 results

Patent Number	Description		
EP0012345	Fuel oils and their application.	Hide Detail	Remove

Data retrieved from the EPO on 27.04.2022

Patent Number	EP0012345
Description	Fuel oils and their application.
Applicant	BAYER AG
Application reference	EP19790104931
Filing date	05.12.1979
Priority claim date	
Date of publication of the grant	23.06.1982

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CC
UPC EXTERNAL

Refresh
April 2022

Sun

2	3
9	10
16	17
23	24
30	1
7	8

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FAQ

Screenshots



The screenshot displays the 'Patent Data - Opt-out - Opt-out - 1681/2022' interface. It features a sidebar with navigation icons and a main content area with a 'List of patents' table. A detailed view for patent EP0012345 is shown, including a table with columns for Patent Number and Description, and a detailed information section with fields for Applicant, Filing date, and Designated States. A 'Confirm Patents' button is visible at the bottom of the main content area.

Patent Data - Opt-out - Opt-out - 1681/2022

List of patents

1 results

Patent Number	Description		
EP0012345	Fuel oils and their application.	▲Hide Detail	Remove

Data retrieved from the EPO on 27.04.2022

Patent Number: EP0012345
Description: Fuel oils and their application.
Applicant: BAYER AG
Application reference: EP19790104931
Filing date: 05.12.1979
Priority claim date:
Date of publication of the grant: 23.06.1982
Designated States: AT, BE, CH, DE, FR, GB, IT, LU, NL, SE

Classifications
IPC: 1982/24
id: CLASSIFICATION_8766842
C10L1/22, C10L1/32
IPC: 1980/13
id: CLASSIFICATION_8766843
C10L1/32, C10L1/10

Confirm Patents

Screenshots



The screenshot displays the 'UPC Case Management System' interface. A modal window titled 'Upload Documents - Opt-out - Opt-out - 1681/2022' is open. The modal contains two light blue informational boxes: the first states that all documents must contain details and data required by the Rules of Procedure; the second notes that pleadings and other documents may be required in searchable PDF/A format. Below these is a section titled 'Documents' with an 'Add File' button and a table with columns for Document Title, Description, Files, and Document ID. The table is currently empty, and the page indicator shows 'Page 1 of 1' with a '20' per page dropdown. A second light blue box at the bottom of the modal explains that the opt-out document should contain information required by RoP5.3 and be accompanied by a mandate if required. At the bottom right of the modal are 'Cancel', 'Save', and 'COMPLETE' buttons. The background interface shows the case details for 'No. 1681 / 2022' and an 'Opt-out' section with links for 'Personal Details', 'Patent Data', and 'Upload Documents'. A calendar for April 2022 is visible on the right side of the background interface.

Screenshots



The screenshot displays the 'UPC Case Management System' interface. The main header shows 'UPC Case Management System' and 'Upload Documents - Opt-out - Opt-out - 1681/2022'. A blue banner at the top of the modal reads: 'Upload all documents as required by the Rules of Procedure. Such documents must contain all the details and data required by the relevant Rules even if entered separately on the Case Management System.'

The 'Upload document - No. 1681/2022' modal contains the following fields and instructions:

- Document Type ***: A dropdown menu with 'Application' selected. A yellow callout box states: 'This document must be lodged in searchable pdf format (PDF/A).'
- File name ***: A text input field containing 'Specimen.docx' next to a 'Choose File' button. A blue information icon is present. A note states: 'File name must be unique within the current pleading'.
- Document Title ***: A text input field containing 'Opt-out Application EP12345'. A note states: 'Max. 120 characters allowed for the Document Title'.
- Document description**: An empty text input field. A note states: 'Max. 250 characters allowed for the Description An appropriate description must be provided for any physical object.'
- Language ***: A dropdown menu with 'English' selected.

At the bottom of the modal are 'Cancel' and 'COMPLETE' buttons. The background interface shows a sidebar with 'Opt-out' settings, a calendar for April 2022, and a footer with '© 2022 UPC CMS v0.62' and 'powered by Net Service S.p.A.'.

Screenshots



UPC Case Management System

ENGLISH C C UPC EXTERNAL

No. 1681 / 2022

Discard Discard Stage Start related proceeding

Calendar

Refresh April 2022

Opt-out ⚙️

- Personal Details
- Patent Data
- Upload Documents
- Declarations

The person lodging this Opt-out confirms that the information required by RoP5.3(a), (b), (c) and (d) is provided in the document uploaded for each patent listed below and that the opt-out document also contains the declaration that the details of each proprietor/applicant provided pursuant to RoP5.3(a) are the details of each person entitled to be registered pursuant to RoP8.5.

List of patents

EP0012345

Cancel Save COMPLETE

Wed	Thu	Fri	Sat	Sun
30	31	1	2	3
6	7	8	9	10
13	14	15	16	17
20	21	22	23	24
27	28	29	30	1
4	5	6	7	8

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FAQ

OPT-OUT DOCUMENT TEMPLATE

(Note: Rule 5.3 requires the following information and declaration in respect of each patent/application/SPC listed below.)

EUROPEAN PATENT APPLICATION DETAILS (RoP 5.3)

(Note: This section must be repeated for each application the subject of this Application to opt out.)

PUBLICATION NUMBER of the European Patent Application [.....]

Details of the applicant(s) for the patent

(Note: This "Details of the applicant(s)" section must be repeated for each applicant.)

Applicant: [.....]

Postal address: [.....]

Electronic address: [.....]

EUROPEAN PATENT DETAILS (RoP 5.3)

(Note: This section must be repeated for each European patent the subject of this Application to opt out.)

PUBLICATION NUMBER of the European Patent [.....]

Proprietor(s) of each EPC designation / EPC state in which the patent has been granted

(Note: The proprietor(s) section must be repeated for each proprietor of the patent)

Country abbreviation: [.....]

Proprietor: [.....]

Postal address: [.....]

Electronic address: [.....]

Details of each granted SPC based upon each of the patents listed above (RoP 5.3(a)).

(Note: This section can be omitted if not applicable.)

Publication Number: [.....]

Country abbreviation: [.....]

SPC Number: [.....]

Holder: [.....]

(Note: The Holder section must be repeated for each holder of the SPC)

Postal address: [.....]

Electronic address: [.....]

Dpt-out Document Template Page 1 of 2 11/05/2020

PERSON LODGING THIS APPLICATION TO OPT-OUT (RoP 5.3(b))

Details of the person lodging this opt-out on behalf of each proprietor of each patent/application listed above and each holder of an SPC based on each such patent. (RoP 5.3(b)).

Name: [.....]

Company/Firm: [.....]

Postal address: [.....]

Electronic address: [.....]

Status: *(tick the applicable option)*

Representative pursuant to Article 48 of the Agreement on a UPC

User authorised to file this opt-out with a mandate

Personal proprietor of each listed patent

DECLARATION (RoP 5.3(e))

The person lodging this opt-out must provide the following declaration:

I hereby declare that each proprietor of each patent/application listed above is entitled to be registered pursuant to RoP 8.5.

Date: [.....]

Signature: [.....]

Dpt-out Document Template Page 2 of 2 11/05/2020

Screenshots



Mandate for lodging an Application to opt out / to withdraw an opt-out / to correct an opt-out / to correct a withdrawal of an opt-out pursuant to Rule 5 of the UPC Rules of Procedure

This mandate is valid from [*date*] until [*date*].

List each patent/application number:

Patent / Application number	Proprietor/Applicant pursuant to Rule 8.5

List each granted SPC:

SPC ID	Country	Holders	Patent number

The following person is authorised to lodge an Application to

- opt out
- withdraw an opt-out
- correct an opt-out
- correct a withdrawal of an opt-out

in respect of the patents/applications/SPCs referred to above on behalf of the above mentioned proprietors/applicants/holders.

Authorised by:

Name,	Position	Signature	Date

Screenshots



The screenshot displays the 'UPC Case Management System' interface. At the top, there is a navigation bar with 'ENGLISH' and a user profile for 'C C UPC EXTERNAL'. The main content area is divided into two panels. The left panel shows the case details for 'No. UPC_APP_1681/2022' with buttons for 'Discard', 'Discard Stage', and 'Start related proceeding'. Below this is a list of 'Opt-out' steps: Personal Details, Patent Data, Upload Documents, Declarations, and Review and Lodge, each with a checkmark. The right panel features a 'Calendar' for April 2022, with the 27th highlighted. The footer contains copyright information for '© 2022 UPC CMS v0.62' and 'powered by Net Service S.p.A.', along with an 'FAQ' link.

UPC Case Management System

ENGLISH C C UPC EXTERNAL

No. UPC_APP_1681/2022

Discard Discard Stage Start related proceeding

Opt-out

- Personal Details ✓
- Patent Data ✓
- Upload Documents ✓
- Declarations ✓
- Review and Lodge ✓

Overview	Patents	Personal details	Documents	Activities Log	Opt-out status
Registry Number	UPC_APP_1681/2022				
Proceeding Type	Opt-out				
Documents	2				
Case Data					
Status of the person lodging the Application	Registered representative before the UPC (Art. 48 UPCA)				
Official Case Dates					
Date of receipt / effective lodging	27/04/22 12:49:18 CEST				

Calendar

Refresh April 2022

Mon	Tue	Wed	Thu	Fri	Sat	Sun
28	29	30	31	1	2	3
4	5	6	7	8	9	10
11	12	13	14	15	16	17
18	19	20	21	22	23	24
25	26	27	28	29	30	1
2	3	4	5	6	7	8

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FAQ

Q&A Opt-out



1. Having created an account any new task does not prepopulate with the personal details of the account holder.

Details of the account are used to pre-populate details of the representative. Such details may be changed.

2. Details of each patent for opting out has to be inserted manually. It is not possible to transfer data from a spreadsheet or other database.

Limited details have to be inserted manually but the Application to be uploaded can be pre-prepared. The manual procedure is suitable for a limited number of opt-outs because details have to be inserted for each patent.

For multiple opt-outs there is an alternative namely using an API which in effect allows importing data from a spreadsheet.

Details of the API for this purpose are included on the UPC website.

3. Having entered details of a patent the name of the proprietor is not shown which would be an immediate confirmation that a correct number has been used.

The EPO database will show only the name of the applicant for each patent. There is no reliable database for current proprietors. However the data (description of the invention and the name of the applicant) that is retrieved from the EPO is some confirmation of the correct number.

4. SPCs have to be opted out per country rather than en bloc

Until there is a unitary SPC this is necessarily the case.

5. It is unclear whether digital signatures can be used or whether wet signed documents have to be scanned.
Once the protocol for strong authentication is in place, there will be the ability to digitally sign all documents as required by RoP4 (to be amended)..
6. There is no possibility for general mandates.
A representative does not require a mandate to opt out a patent. However it is recognised that the person lodging the Application may not be a representative and may require a mandate. The use of an API should avoid the problem for multiple opt-outs. The same mandate can of course be used for all patents of a particular proprietor.
7. It is not possible to check documents once uploaded.
Documents can be checked on the "Review and lodge" task before lodging the Application. If a search is made subsequently a check is possible in the "Documents" section of each Application on the register. If an error has been made an Application to correct the opt-out will be required.
8. It is unclear how to provide ownership data on patents that have different owners in different countries
At present it is necessary to provide ownership data on the CMS itself. However the decision has been made to remove this requirement so that this data is only included in the uploaded Application.
9. It seems that the only way to opt out is via the software. This cannot be done by letter or email
This is correct

10. Attempts to use the API have not provided a mechanism by which a delivery receipt can be generated.

An acknowledgement of opt-out is provided on the CMS for each opt-out Application. The document is available in the "Documents" section of each Application on the register.

11. There is no option for another person to log in and check a draft opt out prepared by someone else.

This is correct.

12. Required to add the information using the software and also a template that has to be completed saved and uploaded (duplicate information).

Certain information must be inserted into the CMS to allow the system to function. This is kept to the minimum necessary; the bulk of information is provided separately in uploaded documents.

13. Each application has to be listed separately, not possible to upload a spreadsheet to include all applications

See no.2 above.

14. Personal details (details of individual submitting the opt out applications), the details cannot be saved for future pre-population (repetitive)

Personal details of representatives are pre-populated. If an API is used it should be possible to pre-populate this information.

15. If the person submitting the details is not the Applicant/Proprietor a mandate has to be completed with a “wet signature” (but not clear), mandate printed/signed/scanned and then uploaded (time consuming).

See no.5 above.

16. If there are co-applicants, it is not clear if they also have to sign a mandate.

The mandate is signed on behalf of the proprietor or co-proprietors.

17. The mandate has to be specific by case i.e. cannot use a GPoA.

See no.6 above.

18. When details of an application have been entered if there are any SPC's from the Granted Patent, these details have to be added separately (again individually)

Only the number and country of each SPC has to be entered on the CMS. Details of holders are included in the Application document. See no.8 above.

19. Not able to review all applications that you are submitting in when complete (not good for checking for mistakes)

See no.7 above.

20. Whilst you can submit multiple applications together (albeit information individually entered), this can only be done where the applicants are the same.

Whether the procedure is manual or via an API it is possible for the same person lodging the Application to opt out multiple patents for multiple proprietors if there is an appropriate mandate or mandates.

20. Whilst you can submit multiple applications together (albeit information individually entered), this can only be done where the applicants are the same.

Whether the procedure is manual or via an API it is possible for the same person lodging the Application to opt out multiple patents for multiple proprietors if there is an appropriate mandate or mandates.

21. A Declaration also has to be submitted, to declare the person submitting the opt out application is authorised to do so.

This is correct.

22. Once these have been lodged, an e-mail is generated and sent to the submitter, however the e-mail does not contain a case reference. It contains the number it generated and a link to the UPC Case Management System.

The email contains the registration number generated by the CMS. The Applicant can use this number to access the CMS and see the details of the patent opted out with that specific number. If the Application was manual the registration number will show details of all patents opted out with that Application. If the API procedure has been used there will be a separate registration number for each patent.

