Patent Law Harmonisation in Transit

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Anna Horn

1. INTRODUCTION

There is a long and winding road to patent law harmonisation, and it has not yet reached its final destination, though it may be at an important transitional stage. Since the establishment of the Treaty of Rome and the Common Market in 1958, the European Union (EU) has strived for patent law harmonisation. However, the Union has failed to establish almost any provisions on the infringing acts and the applicable limitations. In June 2023, EU's harmonisation efforts reached a new milestone with the entering into force of the Unified Patent Court (UPC) system. Even though the EU has finally succeeded in providing a system for a unitary patent right, the regulation of its effects and limitations generally remains outside EU law.

On the 22nd of November 2024, I successfully defended my doctoral dissertation 'Harmonising the Acts of Patent Infringement in Europe' in private law at Stockholm University, Department of Law. The dissertations topic is harmonisation in Europe of the acts amounting to a patent infringement and applicable limitations.[1]

In Europe, an invention can be protected in three ways. The first is as a national patent protected within a certain state. The second is a European Patent granted by the EPO, which is a bundle of territorial protections, each limited to the state where protection has been designated. The third alternative is the newly introduced unitary patent providing protection throughout the participating Member States of the EU.

In this article I summarise my key findings and the dissertation's main contributions. I also reflect upon how my research may be relevant for today's legal developments and lastly, I note how the field of my research has developed since last year. Some parts of the following text are directly taken from my dissertation.

To begin with, I would argue that the European patent system is characterised by three irreconcilable factors: territoriality, fragmentation and harmonisation. There has been a consistent striving for harmonisation within the European patent system in response to the territorial and thereby fragmented protection of patent rights.

My study on patent law harmonisation has been conducted at three levels. First, through the legal order of the EU, including the EU's exclusive competence over the World Trade Organization's Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement). Second, through national case law from the courts of Sweden, Germany, England and Wales as well as judicial dialogues between domestic courts. Third, through the newly established UPC system. The national jurisdictions were chosen based on different criteria. The dissertation was defended at a Swedish university, and I am a Swedish lawyer. It therefore existed a predetermined interest of Swedish patent law. Further, the Swedish jurisdiction lacks a well-established case law on patent infringement proceedings. This is opposite to England and Wales which holds a high amount of court cases relating to the question of the infringing acts. England and Wales were therefore chosen due to the jurisdiction's high amount of court cases and a well-established case law. Germany was chosen due to its importance for establishing general principles of European patent law. In this sense it could be argued that German legislation and precedents have sometimes worked as models for the patent legislation.

In this article I focus on two key findings of my research. First, that judicial dialogue on a national level has created a semi harmonisation of the law on patent infringement which EU has failed to do. Second, that there are similarities in how supplementary protection certificates (SPC) and unitary patents are regulated under EU law which may give clues on how the Court of Justice of the European Union (CJEU) might handle cases regarding unitary patents. Lastly, a section follows where I reflect upon the legal developments of the UPC and what lies ahead.

2. JUDICIAL DIALOGUE'S IMPORTANCE FOR HARMONISATION

My dissertation shows that, in some instances, national courts handling patent infringement cases have acted as a vehicle for patent law harmonisation to compensate for the lack of centralised harmonisation measures in form of common European legislation. Such dialogues are not sanctioned by any common centralised legislation, instead they are self-imposed and may be an act of compensation for lack of a centralised force. These dialogues are often indirect and are conducted when courts discuss the case law of other foreign courts. The dialogue

1 Anna Horn, 'Harmonising the Acts of Patent Infringement in Europe' (PhD thesis, Stockholm University 2024) https://su.diva-portal.org/smash/get/diva2:1903902/FULLTEXT01.pdf accessed [21 January 2026].

is generally used in a persuasive manner and may have been invoked by the parties. On the basis that the dialogue occurs voluntarily and is informal, it cannot be seen as equally rigorous as centralised legislation imposing harmonisation.

The topic of indirect patent infringement is a perfect example of how harmonisation has been achieved without common legislation in force. In the case of indirect infringement, there is a high degree of harmonisation when comparing case law from Sweden, Germany, England and Wales. I argue that this is dependent on two factors. First, the Community Patent Convention 1975 and the Community Patent Agreement 1989 from the EU which never went into force but nevertheless laid down a foundation for the domestic provision in many European countries. The draft agreements have also created leeway for national courts to consider the case law of foreign courts. Hence, national courts refer more freely to foreign case law due to the different domestic legislations' common base in the Community Patent Convention 1975 and the Community Patent Agreement 1989.

The second factor that promotes harmonisation is the judicial dialogue between courts. The coherence of the case law is due to a judicial dialogue. Interestingly, this dialogue is self-imposed by the courts. I would submit that the judicial dialogue is made in the light of the Community Patent Convention 1975 and the Community Patent Agreement 1989. However, the draft agreements are not enough to ensure harmonisation. Instead, the judicial dialogue embeds the coherence achieved through the drafts in the domestic statutory laws. I would further argue that judicial dialogue becomes particularly relevant in regard to well-defined legal questions that could be easily compared across jurisdictions.

This gives the result that harmonisation has been achieved through case law. I would in this regard argue that judicial dialogue strengthens the legal reasoning of domestic courts. Foreign judgments have been employed as a reference in the studied court decisions. The judgments of a foreign court are often used as benchmark for domestic law. This in turn creates carefully deliberated judgments.

3. SIMILARTIES BETWEEN SUPPLEMENTARY PROTECTION CERTIFICATES AND UNITARY PATENTS

In order to understand the complex relationship between the unitary patent and the EU legal order one first must understand how the entire UPC system is modelled. The UPC, which was established in June 2023, adds to the EU's attempts to resolve the fragmentation of the European patent system. However, the system underlying the UPC is dependent on law outside the EU legal order, such as the European Patent Convention and the Agreement on a Unified Patent Court, an international agreement inter se the participating Member States of the EU. Arguably, the UPC system is designed to prevent the CJEU from having too much influence on the enforcement of patents. The Member States removed the provisions regulating the infringing acts and the applicable limitations from a proposal for the EU Regulation on the protection of the unitary patent. The provisions are now part of the international agreement on the UPC. Thus, they aimed at preventing the CJEU from having interpretative jurisdiction over the effects and limitations of the EU unitary patent right.

The unitary effect of a unitary patent is an add-on to a regular European patent granted by the European Patent Office (EPO). The unitary effect is regulated in Regulation (EU) No 1257/2012 of the European Parliament and of the Council of 17 December 2012 implementing enhanced cooperation in the area of the creation of unitary patent protection (UPR). The UPR can be described as a regulation in regard to the post-grant phase for patents granted by the EPO. The fact that the UPR does not regulate the infringing acts and the applicable limitations is due to a demand from the Member States to prevent the CJEU from having jurisdiction over such issues. Even though the UPR is an EU regulation within the competence of the CJEU, in accordance with article 267 TFEU, the acts deemed to be infringing and the applicable limitations relating to the unitary patent are not part of Union law.

Article 3(1) UPR simply states that 'A European patent granted with the same set of claims in respect of all the participating Member States shall benefit from unitary effect in the participating Member States provided that its unitary effect has been registered in the Register for unitary patent protection.' In summary, the EU provides for a unitary patent right but it does not regulate the right's effect or scope.

Relating to the structure of the unitary patent as a 'EU right', I would submit that there is a similarity between how the SPCs and the unitary patent are regulated. The EU provides protection, through EU regulations, in the form of SPCs for medicinal products protected as patents and plant-protected products.[2] The right is connected to an earlier 'basic patent' granted by either the EPO or a national patent authority. However, a SPC is not an extended patent right, but a sui generis right. For instance, a SPC for medicinal products protects the active ingredients or a combination of active ingredients protected by a basic patent. Generally, a SPC extends the protection up to five years after the expiry of the patent. To be granted an SPC, the applicant must hold a basic patent and a valid authorisation to place the product on the market as a medicinal product.

One of the questions on intellectual property law most frequently referred to the CJEU relates to issues concerning the interpretation of article 3 of Regulation No 496/2009 for SPC for medicinal products. Article 3

2 See Regulation (EC) 469/2009 concerning the supplementary protection certificate for medicinal products [2009] OJ L152/1; Regulation (EC) 1610/96 concerning the creation of a supplementary protection certificate for plant protection products [1996] OJ L198/30.

regulates the conditions for obtaining a SPC. The CJEU has established that the scope of protection of a SPC is decided by non-EU law relating to the protection conferred by the patent claims.[3] The Court has therefore refrained from taking further control of the scope of protection provided by SPCs. This is an interesting development, especially since there are several similarities between how SPCs are regulated under EU law and unitary patents.

For instance, article 5 in Regulation 469/2009 concerning the supplementary protection certificate for medicinal products provides that the certificate shall confer the same rights as are conferred by the basic patent and shall be subject to the same limitations and same obligations. Interestingly, the issue of infringement and scope of protection of a SPC is therefore not established by EU law even though the right is based on and granted through EU regulations. One can thus see similarities with the protection provided to unitary patents through the UPR.

The SPCs regulations are similar to the UPR as the SPCs are provided by EU law. However, the contents of the rights are decided by law outside the EU legal order. I would argue that article 3 in the regulation on SPCs for medicinal products can be compared to article 3 UPR, which establishes the requirements for obtaining unitary effects for European patents granted by the EPO.

Further, article 4 and article 5 of the regulation establishing SPCs for medicinal products and article 5 UPR are comparable as they both establish, in a very limited way, the effects of the granted rights without regulating their contents. Therefore, the CJEU's handling of the interpretation of the rights of the SPCs may provide some clues on how the CJEU would handle requests in regard to the unitary patent. The CJEU has not been involved in the direct interpretation of the scope of the SPC rights and this might be an argument against further involvement by the CJEU on matters of protection of the unitary patent.[4]

In summary, even though the SPC is a sui generis right granted through EU secondary law, its scope of protection and issues relating to infringement of such protection are not decided by EU law. Instead, these follow from the law related to the basic patent, regulated outside the EU legal order. It is possible to argue that this division of, on the one hand, EU law providing protection and, on the other hand, non-EU law determining the scope of protection has created complexities resulting in a high number of questions referred by national courts to the CJEU. The interpretation of article 3 in Regulation 469/2009 on the conditions for obtaining a certificate for medicinal products has given rise to several uncertainties. It can further be claimed that the judgments of the CJEU have not yet fully remedied the provision's unclarity. I would further argue that there are several similarities between the regulations on SPCs and the UPR regarding their relationships to the EU legal order. Therefore, the way in which the CJEU has handled issues regarding the scope of protection of SPC may give guidance on how the CJEU will handle issues relating to the scope of unitary patents.

4. FUTURE FORSIGHT

The intended increase of harmonisation achieved by the UPC system is complicated by several factors. The UPC system is based on an enhanced cooperation in the EU based on article 20 of the Treaty of the European Union, formulated in the light of the dissatisfaction of the Member States relating to EU patent law and is dependent on the international agreement on the UPC and the EPC.

3 Case C-121/17 *Teva UK Ltd v Gilead Sciences Inc* EU:C:2018:585, para 57.

4 Ibid.

This makes it both less supportive of and less supported by the EU legal order. This in turn complicates how the court system functions within the internal market of the EU.

I claim in the dissertation that the fact that the UPC is a highly specialised court indicates that its decisions will be skilful and consistent. However, it may also lead to a decrease in the influences from other legal fields, and that the decisions of the UPC may not resonate with the principles of the internal market or the EU legal order in general. National law may also, in turn, diminish in importance due to the high degree of specialisation of the UPC. A natural result of this is fewer national patent cases in domestic courts.

There are further several opportunities for increased harmonisation and cooperation *within* the UPC system, between the first instance in the form of local and regional divisions and the central division and the Court of Appeal. Hopefully, the divisions of the UPC will draw inspiration from the judicial dialogues between national courts handling patent issues and thereby cooperate with each other. The UPC may also include national decisions in its legal reasoning, as the agreement regulating the UPC is worded in a similar way as the Community Patent Convention and the Community Patent Agreement. This has not been seen yet in the case law from the court.

The fact that the agreement on the UPC mirrors the provisions in the drafts agreements from 1975 and 1989 may not be solely positive. The legislator has missed a chance to improve the provisions on the infringing acts and the applicable limitations. As a result, there has not been much development of the statutory law on the infringing acts since the creation of the draft in 1975. The provisions of the agreement are 'past-oriented', as they have not been modernised. Therefore, the legislator has missed a chance to clarify the application on certain provisions on infringement and applicable limitations. For instance, how broad the experiment exemption shall be interpreted, the application of indirect infringement to action failing in under the so-called Bolar exemption and further a general clarification of the prerequisite amounting to indirect infringement to mention some examples. Hopefully, the UPC will find space to answer unanswered questions on patent law infringement.

Studying the case law from the UPC one cannot find many surprises. The UPC is as specialized as expected. Even though it has not provided full coherence in case law between all local and regional divisions. Up to this date, December 2025, the UPC has not referred any questions to the CJEU. This might lead to the conclusion that the cases in the UPC are shielded from general EU law questions. However, in the UPC case Fujifilm *v* Kodak the local division in Dusseldorf decided before the CJEU had decided in a referral that the case in UPC was somewhat dependant on.[5] One could argue that this was a rather bold move, however, the local division's conclusions were coherent with the CJEU's judgment.

Patent law harmonisation may still be in transit. Only two and half years have passed since the UPC system went into force. Much more must be done in order to create coherence in the European patent system. The UPC is key to achieve harmonisation, but from a perspective of European law in total, it cannot be a shielded entity only deciding cases based on its own agreement. In fact, when reviewing the case law from the court, it becomes apparent that it does not refer much to legal sources outside its own agreement and sometimes the European Patent Convention.

5. CONCLUSION

I maintain that the conclusion of my dissertation remains valid. If the UPC system is to assume the role traditionally exercised by national courts within the European patent system, its divisions must cooperate closely in order to ensure consistency. Moreover, the court must take due account of the EU legal order and the functioning of the internal market if genuine harmonisation is to be achieved. The EU legal order therefore cannot be entirely insulated from the decisions of the UPC. In this respect, the UPC still has significant work to do.

In conclusion, the future of patent law harmonisation largely rests with the UPC. As a court situated at the intersection of international, EU, and national legal orders, it is obliged to take EU law fully into account while at the same time remaining attentive to established national patent practices. By doing so, the UPC has the potential to bridge long-standing divergences within the European patent landscape. Ultimately, the court must strive to deliver consistent and predictable rulings across the participating Member States, thereby strengthening legal certainty and supporting the effective functioning of the internal market. Whether the UPC succeeds in fulfilling this role will be decisive for the long-term coherence and legitimacy of the European patent system as a whole.

Anna Horn

Anna Horn (LL.D. in private law) is a Senior Researcher in Law at the Swedish Institute for European Policy Studies (SIEPS).

5 *Fujifilm v Kodak* [2025] UPC_CFI_355/2023; Case C-339/22 *BSH Hausgeräte GmbH v Electrolux AB* EU:C:2025:108.