



# *European patent with unitary effect but with variable law: regulating the right to patent for transnational inventions*

Autor/a

**Bernardo Calabrese**

*Assegnista di ricerca. Dipartimento di Scienze Giuridiche, Università di Bologna.*

**REVISTA LEX  
MERCATORIA.**

*Doctrina, Praxis, Jurispru-  
dencia y Legislación*

RLM n° 8 | Año 2018

Artículo n° 3

Páginas 29-37

revistalexmercatoria.umh.es

ISSN 2445-0936

**Abstract:** This article focuses on a specific issue involving the so called right to patent in the context of the recently approved Unitary Patent system. Considering the field of private international law related to intellectual property, the issue of the law applicable to initial ownership becomes even more thorny in the legal framework of the Unitary Patent: as a matter of fact, this normative system could convey uncertainty in its application to transnational inventions, by reason of the peculiar criterion of the law of the “(first) applicant” governing the Unitary Patent as an object of property under art. 7, Regulation EU n. 1257/2012. Therefore, an interpretative clarification on this point seems necessary.

I. – In the context of private international law related to intellectual property, the “*especially sensitive initial ownership issue*”, in terms of applicable law for regulating the entitlement to exclusive rights in transnational situations, is deeply debated<sup>1</sup>. This depends on the fact that such an issue clashes with the principle of territoriality, which is one of the fundamental paradigms of intellectual property.

In particular, the territoriality principle entails the regulation of intellectual property rights by the law of the granting legal order<sup>2</sup>. The territoriality principle derives from the historical structure of intellectual property, which arose in a context of unintegrated national systems that implies a strong bound to State sovereignty<sup>3</sup>. Although international coordination of intellectual property has early been sought since the landmark conventions of Paris and

Berne in XIX century, even today such a divided territorial structure remains one of the funding element of the international intellectual property system<sup>4</sup>.

Having regard to the issue of applicable law, the territoriality approach gives priority to the sovereign interest of States in regulating autonomously their “own” intellectual property rights. This approach demands that all the aspects related to the existence and circulation of the intellectual property title granted by a State are subject to the law of that State<sup>5</sup>. However, from a systemic point of view, the result is a bundle of national laws governing distinct titles that need to be coordinated. Such an international coordination can in fact be appreciated for most of substantive and procedural provisions of intellectual property regimes, but with the relevant exception of entitlement to such rights<sup>6</sup>. Nonetheless, this factual profile appears unfit for a division along national borders, which subordinates it to a multitude of different and unconnected national laws. Therefore, the debate on initial ownership of intellectual property in transnational creations supports possible solution to this fragmentation, tending to favor the adoption of a sole “personal” law applicable uniformly in all the legal orders under which protection is sought<sup>7</sup>.

In a certain sense, the issue of initial ownership could seem simplified for registered intellectual property rights, like patents for invention, by difference from unregistered rights, like copyright<sup>8</sup>. While for copyright the absence of a formal act of granting creates a parallel alternative on applicable law between the *lex loci protectionis* and the *lex loci originis*, for patents the existence of the title works as an anchorage: in principle, in all cases concerning registered intellectual property rights there is at least no dispute regarding the individuation of

the relevant territorial law, which is the law of the legal order that formally grants the title by means of its competent public office, referable to as “*lex territorialis*”. However, this traditional criterion of the *lex territorialis* for registered rights does not solve the issue of the law applicable to initial ownership. Even in a context of a single “undisputed” territorial law, the determination of the right to patent is a pre-condition for the protection and so it requires uniform treatment: consequently, the regulation of initial ownership is not left to the mere application of the *lex territorialis*, but it is adjusted with more subjective criteria focusing on the factual situation that led to the creation of the invention.

This is particularly true as the invention derives from an employment relationship or from a research contract: in such cases, the “personal” approach described above suggests avoiding the *lex territorialis*, in order to bind the law applicable to initial ownership to the substantive relationship at the basis of the invention. Following the general rules on contractual obligations, in such situations a certain degree of autonomy is admitted: it is considered legitimate for the parties to choose the law applicable to the contract, which consequently becomes the law applicable to the related right to patent. In absence of choice, the law applicable to the contract, and consequently to initial ownership, shall be the law of the State which the contract is most closely connected with. In case of employment, some special rules are provided, but the principles are equivalent: choice of law by the parties is possible, on condition that the chosen law does not deprive the employee of the underogable protection afforded by the law of the State of habitual work<sup>9</sup>. In absence of choice, priority is given to the State of habitual work or of business en-

agement, save the principle of closest connection<sup>10</sup>. According to this approach, also in such cases of “invention for hire” the paradigm of the *lex territorialis* is challenged<sup>11</sup>.

II. – The described legal scenario represents the common ground for any reasoning on the issue of initial ownership for patent rights. Although, as reported above, it is still deeply discussed how the “mathematical function” of the law applicable to initial ownership should be determined in relation with the general territorial criterion and the other subjective or substantive criteria, at least the terms of the equation were constants. However, in the context of the Unitary Patent system, the problem is that the *lex territorialis* is not anymore a constant but could become a variable, and also a variable technically independent from the territorial element.

More precisely, the issue of initial ownership is traditionally based on a one-to-one correspondence between patent titles and legal orders: each (national) legal order provides its (national) patents, which are respectively regulated by a single (national) law<sup>12</sup>. Conversely, the Unitary Patent is a hybrid institute of very peculiar nature<sup>13</sup>. Apart from its differentiated sources of “internal” European Union law and “external” international law, and even omitting the further degree of complexity deriving from the recourse to the enhanced cooperation procedure, the law applicable to the Unitary Patent as a title of intellectual property does not follow the classic territorial paradigm<sup>14</sup>. More precisely, its “unitary” statute consists in fact of a multitude of national laws potentially applicable: in this regard, art. 7, Reg. EU n. 1257/2012 provides that the Unitary Patent as an object of property shall be regulated by a single law, but this law is a vari-

able national law determined according to the very peculiar criterion of the “(first) applicant”<sup>15</sup>.

In particular, the Unitary Patent as an object of property shall be governed by the applicable law identified as follows. Firstly, reference is made to the law of the Member State of residence or principal place of business of the applicant on the date of filing of the application<sup>16</sup>; if residence or principal place of business are not located in a Member State, reference should be made to a non-principal place of business, if located in a Member State<sup>17</sup>. If there is neither residence nor principle or secondary place of business in a Member State, the Unitary Patent shall be governed by the law of the State where the European Patent Organization have its headquarters, *i.e.* German law<sup>18</sup>.

The system becomes even more complicated in case of co-ownership. Namely, if there is more than one applicant, the law applicable to the Unitary Patent as an object of property is determined with reference to the joint applicant indicated as first in the register. If the first joint applicant does not satisfy the requirement of residence or place of business in a Member State, reference should be made to the second joint applicant and so forth. In this way, the order of register of joint applicants for a Unitary Patent determines the law applicable to this intellectual property title<sup>19</sup>.

As it can be easily inferred by the functioning of the criterion described above, this system breaks the one-to-one correspondence that links law and territory for registered intellectual property rights, increasing the complexity of the issue of initial ownership for the Unitary Patent<sup>20</sup>.

The criterion for applicable law here summarized as the law of the “(first) applicant”

is not new, being in continuity with the past Community Patent Agreements adopted but never implemented<sup>21</sup>. It should be recognized that this criterion aims at an objective that is fully consistent with the idea of a single EU patent: this new title, not being anymore a bundle of national titles but a unique title for all European Union, must function by means of only one law. However, the objective pursued does not find a correct implementation in the rule provided for the Unitary Patent.

Actually, the solution codified in art. 7, Reg. EU n. 1257/2012 does not provide for one law, but remains a mere “rule of conflict” of private international law. It functions exactly as a reference to other national laws. This means that the law applicable to the Unitary Patent as an object of property is one at the time, but it is variable, depending on which is the law of the first applicant in that case. The result is that the proprietary aspects of the Unitary Patent are governed by one (only one, but always different) national law for all the legal orders forming the Unitary Patent system. In this way, the EU legislator created an “*extraterritorial extension of national patent law by virtue of Union law*”<sup>22</sup>.

III. – Having in mind this “*fragmentation in the rules applicable to the unitary patent*”<sup>23</sup>, it is important to evaluate correctly the relationship between the right to patent and the rule of conflict under art. 7, Reg. EU n. 1257/2012. This provision of “subjectively conditioned extraterritoriality” could in fact have critical consequences for Unitary Patents protecting transnational inventions. The obvious premise of such problems is that initial ownership of patent rights is not harmonized among Member States<sup>24</sup>. If it is true that practically all national European laws provide generally that the right

to patent belongs to the inventor or its successor in title, it is equally true that for inventions created under employment or research contract national laws are considerably different, especially for invention deriving from academic relationships<sup>25</sup>. In this sense, the case of Italian Law for academic inventions is emblematic: it provides, as a principle, that the right to patent in case of invention achieved by researchers and personnel employed by Universities shall belong to the researcher and not to the University, in contrast with the general normative praxis across Europe. Such a legislative difference means that the very ownership of the invention, and not only possible compensation rights, could depend on the application of the single national law<sup>26</sup>.

Some examples could describe better these critical implications. As a first scenario, a researcher of an Italian University is hosted as a visiting researcher by a foreign European University. If the Italian researcher, in this period of research using the facilities of the foreign University, creates a patentable invention, the issue of initial ownership of a future Unitary Patent arises. In this sense, if the researcher deems to have the right to patent and files an application, Italian law as the law of the applicant will apply to the “proprietary” aspect of initial ownership of the invention; consequently, the researcher will be acknowledged as the legitimate owner. On the other side, if the foreign University to which the invention is disclosed deems to have the right to patent and firstly files the application, the foreign law could apply with possible different outcomes on who is the legitimate owner.

As shown, the uncertainty is caused not by the substantive relationship, which is identical, but by the autonomous variable of who is the applicant: the ownership of the same in-

*European patent with unitary effect but with variable law: regulating the right to patent for transnational inventions*

vention could be legitimately claimed by different subjects, according to the respective “personal” laws, only depending on who takes the initiative first. Moreover, if one considers that normally such visiting relationships are regulated directly between the Universities involved, often with special provisions claiming the ownership of intellectual property thereby deriving, the application of one national law or another could generate further problems. Namely, if Italian law applies, the recognition of ownership by the Italian University in favour of the foreign University could be considered as an invalid assignment *a non domino*, belonging the ownership of the invention directly to the researcher.

A second scenario can be imagined as an evolution of the first, moving the case of the Italian researcher in the context of a collaborative research project among multiple parties of different EU States. In general, the consortium agreement of such projects provides for a direct choice of law applicable to the project<sup>27</sup>. However, if the right to patent for a certain invention achieved in cooperation is allocated under the project in favour of the Italian University partner, this University would be the first applicant and so the Unitary Patent would be governed by Italian Law also on the matter of initial ownership. This means that all the partners involved in the invention as co-owners, and especially foreign Universities, would be subject to Italian law, with the effect of having their researcher identified as the real legitimate owners, instead of the belonging entity, by virtue of the “extraterritorial” application of the Italian Code of Industrial Property. Vice-versa, if the application for Unitary Patent were entrusted to a foreign partner, the application of the foreign national law would deprive the Italian researcher of its right to patent otherwise granted by its national law. Even in this

scenario, it is clear how deep and maybe “unexpected” are the differences between the single national laws governing the Unitary Patent on the matter of initial ownership, depending only on the subjective element of who is the first applicant.

**IV.** – Therefore, an interpretative clarification on this point seems necessary. As said, it could be envisaged the hypothesis that the right to patent, since it is connected to (initial) ownership, might be considered as a juridical profile pertaining to the Unitary Patent as an object of property.

However, the hypothesis of including the right to patent under the application of art. 7, Reg. UE n. 1257/2012 as an object of property appears incorrect and it should consequently be refused. In particular, such a hypothesis seems to misconstrue the notion of object of property, which is technically referable only to the existence and circulation of the Unitary Patent title once granted, and so it could not extend to the factual and legal relationship that stands before the very same creation of the invention<sup>28</sup>. In other words, the solution of the question on the law applicable to initial ownership of the Unitary Patent implies the correct distinction between pre-grant phase and post-grant phase, and the exact construction of the right to patent under the former<sup>29</sup>. As such, the right to patent shall be regulated, as for all pre-grant phase profiles, by the norms governing the procedure of granting by the competent European Patent Office<sup>30</sup>. This solution is confirmed by the structure of the Unitary Patent system, which expressly refers to the European Patent Convention as a relevant source of law<sup>31</sup>. In this way, the law applicable to the right to patent shall be determined according to art. 60, § 1, EPC, which provides as follows:

“The right to a European patent shall belong to the inventor or his successor in title. If the inventor is an employee, the right to a European 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 the place of business to which the employee is attached”<sup>32</sup>.

This solution has several advantages: firstly, it gives value to the only norm that currently develops a harmonized rule of conflict specifically for the right to patent; secondly, it is in continuity with the patent system already in practice; finally, by providing for a more classic rule of conflict, it offers the possibility to resort

to the general principles of private international law as elaborated for the application to initial ownership of intellectual property<sup>33</sup>. Of course, this result is far from being fully satisfactory, leaving open all the issues that the international discussion is still trying to tackle. However, the interpretation of initial ownership as a pre-grant phase profile, excluded as such by the notion of object of property, avoids the further complexity and uncertainty brought about by the criterion of the law of the (first) applicant under art. 7, Reg. EU n. 1257/2012 and so it represents the preferable solution in the absence of an appropriate harmonization of the right to patent, which appears yet unescapable in order to create a real unitary patent system for the European Union<sup>34</sup>.

---

#### NOTAS

<sup>1</sup> In these terms R. MATULIONYTE, *The Law Applicable to Online Copyright Infringements in the ALI and CLIP Proposals: A Rebalance of Interests Needed?*, in *Journal of Intellectual Property, Information Technology and E-Commerce*, 2/26, 2011, p. 26; for a general overview see J.J. FAWCETT – P. TORREMANS, *Intellectual Property and Private International Law*, Oxford University Press, 2011, p. 693 ff.

<sup>2</sup> Traditionally the granting legal order coincides with the national State, but it could be also the European Union, such as for EU trademarks under Regulation EU n. 2424/2015, designs under Regulation EC n. 6/2002, plant breeders' rights under Regulation EC n. 94/2100; this supranational level of granting is the same rationale that inspires the creation of the European Patent with Unitary Effect, even if this system appears more peculiar as described further; on the foundations of European Intellectual Property Law see J. PILA – P. TORREMANS, *European Intellectual Property Law*, Oxford, Oxford University Press, 2016, p. 39 ff.

<sup>3</sup> In general on the territoriality principle in intellectual property see E. ULMER, *Copyright and Industrial Property*, in *International Encyclopedia of Comparative Law*, vol. XIV, Tübingen, Mohr-Siebeck, 1987, p. 5 ff.; for a specific study on the territorial implications of the Unitary Patent in case of cross-border use of the patented invention see R. ROMANDINI – A. KLICZNIK, *The territoriality principle and transnational use of patented inventions - the wider reach of a unitary patent and the role of the CJEU*, in *IIC*, 2013, p. 524 ff.; for an analysis of the territoriality principle in comparison with the universality principle in the context of exclusive jurisdiction on intellectual property rights see B. UBERTAZZI, *Exclusive Jurisdiction in Intellectual Property*, Tübingen, Mohr-Siebeck, 2012, p. 138 ff.

<sup>4</sup> For a study that epitomizes what is the relevance of the territoriality principle even in the current intellectual property international system see T. LEEPUENGTAM, *The Protection of Intellectual Property Rights in Outer Space Activities*, Cheltenham, Edward Elgar Publishing, 2015, p. 45 ff.

<sup>5</sup> In this sense it should be recalled the specific provision of art. 54, Italian Law n. 218/1995 (Reform of the Italian System of Private International Law), which states that the rights on immaterial goods shall be governed by the law of the country of use; however, as a confirmation of the strict connection between territory and governing law for intellectual property rights, this norm is in fact interpreted as referring to the law of the country for which protection is sought, as explained in terms of “*Schutzland*” by R. MASTROIANNI, *Diritti su beni immateriali*, in R. BARATTA (ed.), *Diritto internazionale privato*, Milano, Giuffrè, 2010, p. 125 ff.

*European patent with unitary effect but with variable law: regulating the right to patent for transnational inventions*

<sup>6</sup> In terms of international conventions harmonizing Intellectual Property see, on the substantive level, Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), signed in Marrakech on 15 April 1994 in the context of WTO, and, on the procedural level, Patent Cooperation Treaty (PCT), signed in Washington on 19 June 1970 in the context of WIPO. For a presentation of the institutional international system of intellectual property law with particular reference to patent see A.J. STACK, *International Patent Law: Cooperation, Harmonization, and an Institutional Analysis of WTO and the WIPO*, Cheltenham, Edward Elgar Publishing, 2011, p. 65 ff.

<sup>7</sup> For an example of the opposite approach on the controversial issue of initial ownership in Intellectual Property Rights see the debated reported in Third Committee Report of International Law Association, Johannesburg Conference (2016), *Intellectual Property and Private International Law*, p. 12 as follows: “*One of the controversial issues in the field of choice of law is initial ownership. There are multiple circumstances in which creative activities take place, and the Committee members shared the view that lex loci protectionis is no longer the most appropriate rule to allocate IP rights to newly created works. Even though the departure from the territoriality principle is widely supported, the members of the Committee did not entirely agree whether one choice of law rule would suffice, or whether several alternative provisions to various case-by-case based scenarios should be adopted. Moreover, there was a debate whether the ILA Guideline should provide several alternate choice of law provisions that would help determine initial ownership. Some Committee members expressed their strong preference to have one single law governing questions related to initial ownership. The advantage of such a solution would be legal certainty and predictability, which are very important in globally intertwined economies. Some other members of the Committee were more reserved and highlighted the need to be aware that choice of law dealing with the law governing initial ownership should be in line with other choice of law provisions (e.g., transferability of IP rights)*”.

<sup>8</sup> For an analysis of the different possible criteria for initial ownership in the context of international copyright protection see M. VAN EECHOU, *Alternatives to the lex protectionis as the Choice-of-Law Rule for Initial Ownership of Copyright*, in J. DREXL – A. KUR (eds.), *Intellectual Property and Private International Law*, Oxford, Hart Publishing, 2005, p. 289 ff.

<sup>9</sup> See respectively artt. 3, 4, §§ 3-4 and 8, § 1, Reg. EC n. 593/2008 “Rome I”.

<sup>10</sup> See art. 8, §§ 2-3-4, Regulation EC n. 593/2008 (“Rome I”).

<sup>11</sup> For a discussion of this point in terms of exception from the principle of the law of the country of registration with specific reference to “*employment contracts and research and development contracts*”, see J.J. FAWCETT – P. TORREMAN, *Intellectual Property and Private International Law* (cit.) p. 732-733; see also F. DESSEMONTET, *A European Point of View on the ALI Principles – Intellectual Property: Principles Governing Jurisdiction, Choice of Law, and Judgments in Transnational Disputes*, in *Brooklyn Journal of International Law*, 2005, p. 862, who highlights the lack of relevance and the possible overriding of the territoriality principle for intellectual property rights “*in which ownership is better regulated in a centralized manner*”.

<sup>12</sup> On the necessary correspondence between the *lex situs* and registered intellectual property rights, which in this sense resembles the “*characteristics of immovables*” see L. COLLINS (ed.), *Dicey and Morris on the Conflict of Laws*, London, Sweet and Maxwell, 2000, p. 934.

<sup>13</sup> The Unitary Patent due to its peculiarity has been even defined as “*untamable*”: see H. ULLRICH, *Harmonizing Patent Law: the Untamable Union Patent*, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 12-03, p. 1; on the long and contorted creation of the Unitary Patent system see A. PLOMER, *A Unitary Patent for a (Dis)United Europe: The Long Shadow of History*, in *IIC*, 2015, p. 508 ff.

<sup>14</sup> The so called Unitary Patent Package consists in fact not only of two instruments of EU law (Regulation EU n. 1257/2012 on patent protection and Regulation EU n. 1260/2012 on translation arrangements), but also of an instrument of international law, that is the Agreement on a Unified Patent Court of 19th February 2013 (in OJEU 2013/C 175/01); as known, the future exit of the United Kingdom could the impair the effective entry into force of the Unitary Patent; but this not only for political reasons, but also for some legal technicalities related specifically to this peculiar construction of the system: on this topic see T. JAEGER, *Reset and Go: The Unitary Patent System Post-Brexit*, in *IIC*, 2017, p. 254 ff.; in addition; the EU Regulations included in the Unitary Patent Package have been adopted recurring to the enhanced cooperation procedure, whose legitimacy was confirmed (not without criticism) by the Supreme European Court: see CJEU, 5 May 2015, case C-146/13, *Spain v. European Parliament and Council*; CJEU, 5 May 2015, case C-147/13, *Spain v. Council of European Union*; CJEU, 16 April 2013, joined Cases C-274/11 and C-295/11, *Spain and Italy v. Council of European Union*; for a critical analysis of the construction of the Unitary Patent system following a model of enhanced

---

cooperation see M. LAMPING, *Enhanced cooperation – a proper approach to market integration in the field of unitary patent protection?*, in *IIC*, 2011, p. 879 ff.

<sup>15</sup> Actually the EU legislator does not explain in depth this choice, limiting the contextualization to the following statement contained in Reg. UE n. 1257/2012, whereas 14: “as an object of property, a European patent with unitary effect should be dealt with in its entirety, and in all the participating Member States, as a national patent of the participating Member State determined in accordance with specific criteria such as the applicant’s residence, principal place of business or place of business”.

<sup>16</sup> Art. 7, § 1, letter a), Reg. UE n. 1257/2012.

<sup>17</sup> Art. 7, § 1, letter b), Reg. UE n. 1257/2012.

<sup>18</sup> Art. 7, § 3, Reg. UE n. 1257/2012. On the specific implication of this mechanism regarding applicable law to Unitary Patent for non-EU inventors see L. McDONAGH, *European Patent Litigation in the Shadow of the Unified Patent Court*, Cheltenham, Edward Elgar Publishing, 2016, p. 118 ff.

<sup>19</sup> Art. 7, § 2, Reg. UE n. 1257/2012; to tell the truth, the system is even more complex, in the sense that if the first joint applicant does not have residence or principle place of business in a Member State under art. 7, § 1, let. a), Reg. UE n. 1257/2012, the criterion calls in question immediately the second joint applicant (and following) for the same control; only if the second joint applicant and following does not meet the requirements under art. 7, § 1, let. a), Reg. UE n. 1257/2012, the rule moves to art. 7, § 1, let. b), Reg. UE n. 1257/2012, bringing back the focus on the first joint applicant and then, in second instance, to the other joint applicant; finally, if none of the applicant satisfies the requirements under letter a) and b) according to the procedure described, it applies art. 7, § 3, Reg. UE n. 1257/2012 with its residual reference to German law.

<sup>20</sup> On the possible implications of the peculiar structure of the Unitary Patent title in the context of the EU internal market see M. MALAGA, *The European Patent with Unitary Effect: Incentive to Dominate? A Look From the EU Competition Law Viewpoint*, in *IIC*, 2014, p. 621 ff.

<sup>21</sup> On the history of the Community Patent system and specifically on the lack of direct substantive harmonization of the issue of entitlement see J. PILA, *The European Patent: an old and vexing problem*, in *International and Comparative Law Quarterly*, 2013, p. 922.

<sup>22</sup> H. ULLRICH, *Select from within the system: The European patent with unitary effect*, Max Planck Institute for Intellectual Property and Competition Law Research Paper No. 12-11, p. 32.

<sup>23</sup> R. HILTY – T. JAEGER – M. LAMPING – H. ULLRICH, *The Unitary Patent Package: Twelve Reasons for Concern*, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 12-12, p. 2.

<sup>24</sup> For a presentation of the European legal scenario on this topic see J. PILA – P. TORREMAN, *European Intellectual Property Law* (cit.) p. 140 ff.

<sup>25</sup> For a comparative overview of different national legal orders see T. KONO (ed.), *Intellectual Property and Private International Law: Comparative Perspectives*, Oxford, Hart Publishing, 2012 p. 135 ff.

<sup>26</sup> On the rules provided by art. 65, Italian Code of Industrial Property on the right to patent in academic inventions see A. MUSSO, *Brevetti per invenzioni industriali e modelli di utilità*, Bologna, Zanichelli, 2013, p. 291 ff., and in a comparative perspective A. OTTOLIA, *Italy*, in S. WOLK – K. SZKALEJ (eds.), *Employees’ Intellectual Property Rights*, Alphen aan de Rijn, Kluwer Law International, 2015, p. 153 ff.; on the same topic in the context of the UK system see J. PILA, *Who owns the intellectual property rights in academic work?*, in *EIPR*, 2010, p. 609 ff.; for a comparative study on compensation for inventions in employment relationships see S. WOLK, *Remuneration of Employee Inventors – Is There a Common European Ground? A Comparison of National Laws on Compensation of Inventors in Germany, France, Spain, Sweden and the United Kingdom*, in *IIC*, 2011, p. 272 ff.

<sup>27</sup> See art. 11.7, DESCA Horizon 2020 Model Consortium Agreement, which provides for Belgian Law as default option.

<sup>28</sup> On the problematic issues concerning the circulation of the patent after granting in the context of the peculiar rule of conflict for determining the applicable law to the proprietary aspects of the Unitary Patent see H. ULLRICH, *The property aspects of the European Patent with Unitary Effect: a National Perspective for a European Perspective?*, Max Planck Institute for Intellectual Property & Competition Law Research Paper No. 13-17, p. 1 ff.

<sup>29</sup> In this sense see A. KAISI, *Finally a single European right for the EU? An analysis of the substantive provisions of the European patent with unitary effect*, in *EIPR*, 2014, p. 170 ff.

*European patent with unitary effect but with variable law: regulating the right to patent for transnational inventions*



---

<sup>30</sup> Note that the issue of initial ownership of the Unitary Patent remains outside the competence of the new Unified Patent Court, being left to the exclusive jurisdiction of national courts; on this further problematic profile of the Unitary Patent system see L. McDONAGH, *European Patent Litigation in the Shadow of the Unified Patent Court* (cit.), p. 93 ff.

<sup>31</sup> See art. 1, § 2, Reg. UE n. 1257/2012 and art. 24, § 1, Agreement on a Unified Patent Court 19th February 2013; for an analysis of the complexity of Unitary Patent system's sources of law see C. HONORATI, *Il diritto applicabile dal Tribunale unificato: il coordinamento tra fonti e i rapporti tra accordo TUB e regolamento (UE) n. 1257/2012*, in C. HONORATI (ed.), *Luci e ombre del nuovo sistema UE di tutela brevettuale – The EU Patent Protection. Lights and Shades of the New System*, Torino, Giappichelli, 2014, p. 119 ff.

<sup>32</sup> For a comment on art. 60 EPC see D. VISSER, *The Annotated European Patent Convention*, Veldhoven, Tel, 2016, p. 127 ff.; for a specific contextualization of art. 60 EPC in private international law related to intellectual property see E. ULMER, *Intellectual property rights and the conflict of laws: a study carried out for the Commission of the European Communities*, Deventer, Kluwer, 1978, p. 78.

<sup>33</sup> See artt. 3:201, 3:501-3:503, CLIP Principles on Conflict of Laws in Intellectual Property (2011); artt. 18-23, II. Draft Guidelines "Intellectual Property in Private International Law", International Law Association, Johannesburg Conference (2016).

<sup>34</sup> The Unitary Patent Package has not provided any harmonization on this point, even if some proposal were initially included in preparatory works: see M. BRANDI-DOHRN, *Some Critical Observation on Competence and Procedure of the Unified Patent Court*, in *IIC*, 2012, p. 372; for strong criticism on the consistency of the Unitary Patent system also with particular reference to the peculiar governing law of its proprietary aspects see V. DI CATALDO, *Competition (or confusion?) of models and coexistence of rules from different sources in the European patent with unitary effect. Is there a reasonable alternative?*, in C. HONORATI (ed.), *Luci e ombre del nuovo sistema UE di tutela brevettuale – The EU Patent Protection. Lights and Shades of the New System* (cit.), p. 28 ff.