

Who Needs a Mandate? - A Question to the UPC Preparatory Committee

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Our indefatigable Kluwer News Blogger has obviously not failed to realize that another draft of the Rules of Procedure has just appeared on the UPC website. To confuse everybody, this draft is still called the 18th draft and seems to date from 19 October 2015. Yet if you go through the Status history, you will find that this draft includes amendments made by the Preparatory Committee on 15 March 2017.

I do not know whether somebody on the UPC Preparatory Committee reads this blog, but in any case, I would very much appreciate if somebody could enlighten me in regard to a question that I think will be very relevant for everybody entrusted with the task of actually filing an opt-out application.

My simple question is: Do I need to file a mandate by each proprietor/applicant/holder, for an opt-out to be valid? Or can I risk not filing a mandate if I am either a representative according to Art. 48 UPC Agreement or a European Patent Attorney who has represented and is still representing the application/patent before the EPO under Art. 134 EPC and is entitled to file applications to opt-out under Rule 3(4), 2nd sentence RoP? Finally, how about in-house representatives?

The beta test site helpfully provided by the UPC on its website seems to require applicants to file a mandate in each and every case. It is stated there:

Application to Opt-out a patent

The person lodging this Application on behalf of each proprietor/applicant/holder must declare that he is authorised to lodge this Application pursuant to the mandate which must be attached to the Application and that each proprietor/applicant is the person entitled to be registered pursuant to Rule 8.5.

It is possible to download a template for the mandate. [Download the template for the mandate](#)

So far, so good. But where is the legal basis for the requirement to attach a mandate? Let us look into Rule 5(3) of the new Rules of Procedure:

(a) the name of each proprietor or applicant for the European patent or application and of the holder of any supplementary protection certificate based on the European patent in question, and all relevant postal and, where applicable, electronic addresses;

(b) the name and postal address and electronic address of (i) the representative appointed by the applicant or the proprietor in accordance with Article 48 of the Agreement or

(ii) any other person lodging the Application to opt out on behalf of the proprietor or the applicant and the mandate for lodging the Application to opt out;

(c) details of the patent and/or application including the number;

(d) details of any supplementary protection certificate granted based on the patent concerned, including the number, and

(e) for the purposes of paragraph 1(a), a declaration by or on behalf of each proprietor or applicant pursuant to Rule 8.5 that he is entitled to be registered in the national patent register.

The only reference to a “mandate” in the Rules of Procedure (save for Rule 101, which relates to something completely different) is sub lit (b)(ii) of the Rule reproduced above. But I am afraid to say that I do not really understand this rule from a grammatical point of view, maybe because I am not an English native speaker. Specifically, I wonder whether the mandate is a requirement that applies to each and every application to opt-out under lit (b), or whether a mandate is only required if the Application to opt-out is NOT filed by the representative appointed by the applicant or proprietor, but instead by “any other person” sub lit (b)(ii)?

If a mandate is required in all cases, why is this not clearly stated as a separate requirement on the same level as (a) the name of the proprietor/applicant and (c) the details of the patent? Why is the mandate only mentioned in the indented

subparagraph (ii) after “any other person”, but not also after “representative”? Or at least, why has the mandate not been listed as the first requirement of lit (b) before the names and addresses of the representatives or any other persons filing the application?

Conversely, lit (b) could also be read so as to mean “the name and address [of (i) or (ii)] and the mandate”. This reading would be consistent with the statement on the beta test website.

The troubling point is that both interpretations may make some sort of sense, although it would seem more sensible to me if the registered EPO representative could file an Application to opt-out without a separate mandate from the applicant(s)/proprietor(s). One should indeed assume, as a rule, that the Representative’s powers extend to the right to file an Application to opt-out and that any additional formal requirements add burden and costs to the applicants/proprietors.

I also worry about in-house representatives. Are they deemed to be “any other person” acting “on behalf of the proprietor or applicant” who needs to file a mandate? Or are they considered as “the proprietor or the applicant” who may directly act before the UPC and do not need to separately enter their names and postal address again and file a mandate sub lit b)?

It seems that some work should still be done on further clarifying the Rules and also in bringing the IT into conformity therewith. Right now, it is possible (I tried it out myself) to opt-out a patent both with and without filing a mandate. At least the status of both of my test patents was “opt-out” after completion of the procedure.

But to what extent can the public rely on the correctness of the opt-out register? Rule 5(6) explains:

5. The Registrar shall as soon as practicable enter the Application to opt out in the register. Subject to paragraph 6, the opt-out which meets the requirements laid down in this Rule shall be regarded as effective from the date of entry in the register. If the requirements recorded in the register are missing or incorrect, a correction may be lodged with the Registry. The date of entry of the correction shall be noted in the register. The opt-out shall be effective from the date of correction.

So, this seems to suggest that whatever the electronic status of the register is, an Application to opt-out will only be effective if it meets the requirements laid down

in Rule 5. Thus, we should indeed know exactly what these requirements are. Hence my question.

Dear Preparatory Committee, please help and clarify Rule 5(3) RoP and your software. If the filing of a mandate is indeed mandatory, I would suggest that the IT should issue an error message or warning if no mandate has been attached to the Application.