

Editorial

The European patent with unitary effect—what about unitary criminal sanctions for infringement?

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Readers of EU Regulation No 1257/2010, which might enter into force someday, learn that certain European patents granted by the European Patent Office should, at the request of the patent proprietor, benefit from ‘unitary effect’. Such a ‘European patent with unitary effect’ shall provide ‘uniform protection’ and shall have ‘equal effect in all the participating Member States’. However, as far as I can see, neither the EU Regulation nor any other part of the ‘EU patent package’ deals with the question of criminal measures in case of infringement. This, in my view, does not mean that infringement of a European patent with unitary effect could not have criminal consequences. According to Article 2 of the European Patent Convention, a European patent shall, in each of the contracting States for which it is granted, have the effect of a national patent granted by that State. Therefore, the national criminal law provisions that apply in case of infringement of a national patent should also apply in case of infringement of a European patent with unitary effect. However, the penal sanctions differ from State to State.

In Germany, according to the statute, intentional patent infringement may be punishable by up to five years’ imprisonment. In the UK, as I understand it, patent infringement is not a criminal offence. This means that the infringement of a European patent with unitary effect in Germany could be a crime, whereas the identical infringing act in the UK would have no criminal consequences. Does this mean that the European patent with unitary effect cannot provide the intended ‘uniform protection’ after all? Is the UK a better place for patent infringers than Germany because infringers in the UK are not subject to criminal sanctions? I cannot say.

In 2001, when the International Association for the Protection of Intellectual Property (AIPPI) studied the question of criminal law sanctions (Q169), the UK group of the AIPPI was of the opinion that penal sanctions should not be extended to patents (AIPPI UK Group Report Q169). Apparently, it is not at all clear whether or not the imposition of criminal liability on patent infringers enhances protection.

In Germany, the practical impact of criminal sanctions is very low. I have not heard or read of any case of imprisonment. One reason might be that patent proprietors seldom file a request for criminal prosecution because they do not

expect to achieve anything that could not be achieved—or achieved more quickly—by civil proceedings. Criminal prosecution can take a long time. This is probably because public prosecutors, due to the low number of cases, have little experience in patent matters which are typically technically and legally complex. In addition, proof of wilful intent can be difficult.

However, there have been cases in Germany in which a request for criminal prosecution—justified or not justified—has caused a lot of trouble for the alleged infringer because alleged infringing products have been seized, especially during trade fairs in Germany. However, I doubt whether such cases are a good argument in favour of imposing criminal liability because it appears to me that the more appropriate measure of the patentee would be a request for a preliminary injunction or for a measure to preserve evidence by a civil court.

The proprietors of patents in Germany do not seem to need an additional deterrent under criminal law in order to enhance protection. Therefore, I would assume that the abolishment of criminal liability for patent infringement would not have a noticeable effect.

The differences within the EU lead to the question of harmonisation. According to Article 61 of the Agreement on Trade-related Aspects of Intellectual Property Rights (TRIPS Agreement), World Trade Organization (WTO) members shall provide penal sanctions in cases of certain wilful trade mark counterfeiting or copyright piracy. WTO members may provide for criminal sanctions for patent infringement, but they are not obliged to do so. In 2005, the European Commission proposed a Directive on criminal measures (2005/0127/COD) which also applied to patents. However, in 2007, the European Parliament agreed that such a directive should not apply to patents. Finally, in 2010, the European Commission communicated the complete withdrawal of the proposal.

The birth of the European patent with unitary effect and the hopefully effective Unified Patent Court system is a good time to reconsider harmonising the penal sanctions for patent infringement in Europe—maybe by abolishing them unitarily.

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