



Albright IP

excellence in intellectual property



European Patents – Unitary Patent and Unified Patent Court

What is changing and what should I consider?

TWO MAJOR CHANGES ARE BEING INTRODUCED INTO EUROPEAN PATENT LAW.

IF YOU HAVE OR ARE RESPONSIBLE FOR A EUROPEAN PATENT OR APPLICATION, YOU NEED TO BE AWARE OF THESE CHANGES.

When a European patent grants, proprietors will soon have the option of obtaining a single patent right which comes into force in a number of European countries. This is called the Unitary Patent (UP).

Additionally, a new European Court, called the Unified Patent Court (UPC), will soon be established. Unitary Patents will be able to be enforced or revoked centrally in a single action at the Unified Patent Court. *Similarly, classically validated European patents* (i.e. European patents validated in individual countries as per the current practice) will also be able to be enforced or *centrally revoked* at the Unified Patent Court across all Unified Patent Court countries in a single action. However, classically validated European patents can be opted out of the jurisdiction of the UPC.

Unitary Patent

When will the Unitary Patent be available?

The Unitary Patent will be available from 1st June 2023.

What countries are included in the Unitary Patent?

The current list is Austria (AT), Belgium (BE), Bulgaria (BG), Denmark (DK), Estonia (EE), Finland (FI), France (FR), Germany (DE), Italy (IT), Latvia (LV), Lithuania (LT), Luxembourg (LU), Malta (MT), the Netherlands (NL), Portugal (PT), Slovenia (SI), Sweden (SE).

This list may later expand to include other countries, but Unitary Patents granted before the expansion will not come into force in those new countries.

How do I get a Unitary Patent?

First, a European patent needs to be granted in the normal way. Note that the granted claims must be the same for all of the participating Member States, and designation of a participating Member State must not have been withdrawn, in order for the Unitary Patent option to be available.

A request for unitary effect must then be filed within one month of the date of publication of grant. Assuming the specification is in English, a translation of the specification into another EU language must also be filed in this time period.

If we are the representatives for your European patent application, we will seek your instructions on this when reporting the intention to grant communication (Rule 71(3) EPC communication).

Can I get both a Unitary Patent and classically validate the European patent in non-Unitary Patent countries (e.g. in the UK)?

Yes, a Unitary Patent can be requested, and validation in non-Unitary Patent countries can be actioned as normal.

Can I classically validate individual Unitary Patent countries if I do not want a Unitary Patent?

Yes, a Unitary Patent is optional, and classical validation for Unitary Patent countries will still be available as long as a Unitary Patent is not requested.

What are some advantages and disadvantages of a Unitary Patent?

A Unitary Patent may reduce costs both on validation and during annual renewals, if considering protection in several relevant countries. Registering a transaction (e.g. assignment or licence) may also be streamlined.

However, if considering no more than a few countries, then a Unitary Patent is likely to be more expensive, both for validation and annual renewals.

Additionally, the number of territories covered by a Unitary Patent cannot be reduced to reduce the cost of annual renewal, as is possible with individually validated countries of a European patent.

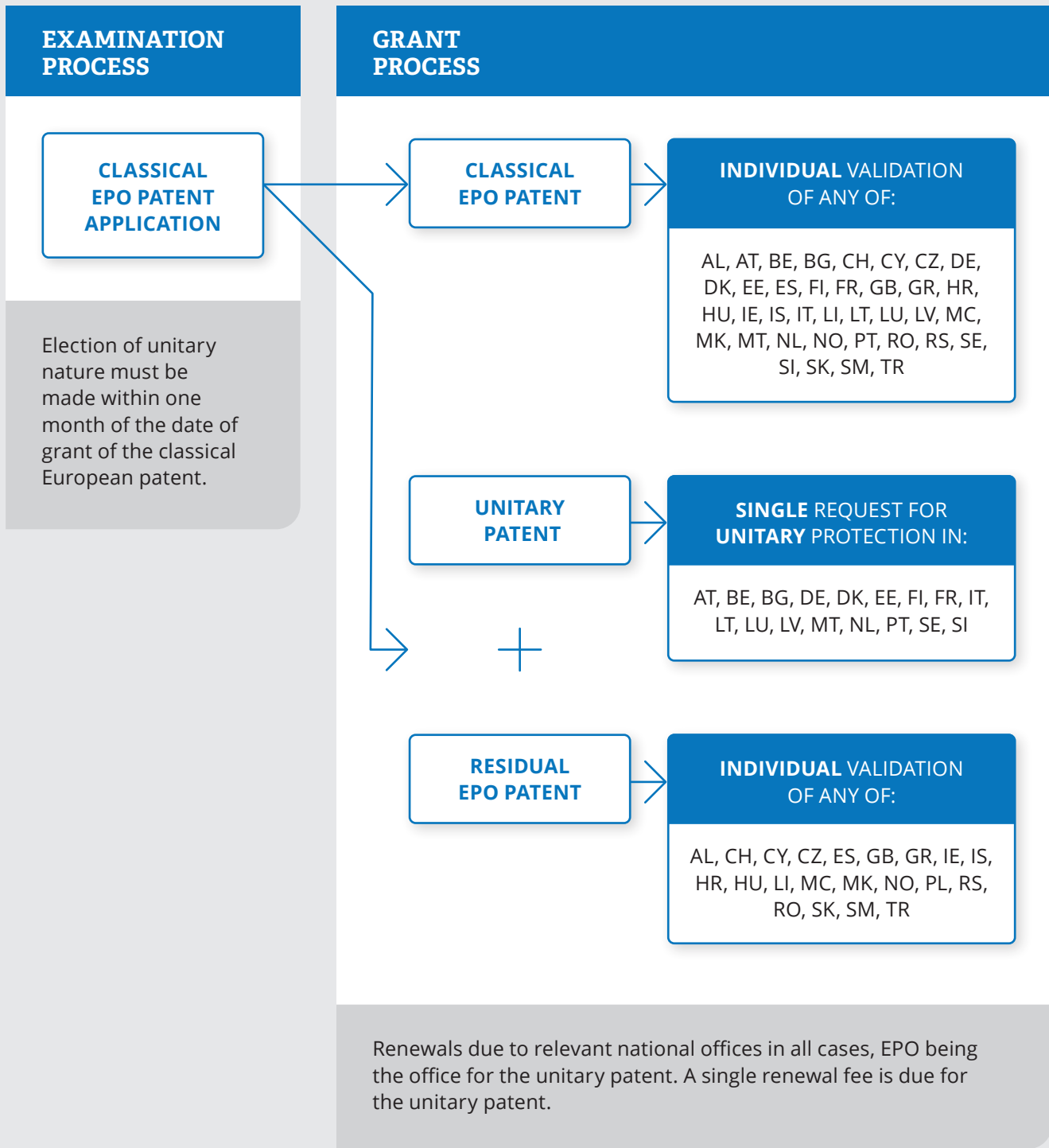
A Unitary Patent cannot be opted-out of the jurisdiction of the Unified Patent Court, and so must be enforced, and is at risk of central revocation, at this new and presently untested Court.

What if my European Patent will soon grant, but the Unitary Patent is not yet available?

Shortly before the Unitary Patent becomes available, there will be the option of filing a request to delay grant to allow time for the Unitary Patent to become available.

However, this mechanism is not yet available, so please contact us if you would like to discuss alternative options.

From 1st June 2023, after grant of a European patent application, there will be two routes for protection in Europe.



Unified Patent Court

What is the Unified Patent Court?

The Unified Patent Court will be a new Court which will have exclusive jurisdiction for infringement and revocation of Unitary Patents.

The Unified Patent Court will also have jurisdiction for infringement and revocation of classically validated European patents in relevant EU countries, including for European patents granted before the court came into existence. Classically validated European patents can be opted out of this jurisdiction, to reduce the risk of central revocation.

Which countries does the Unified Patent Court cover?

The current list is Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, Sweden.

This may be expanded to other countries in future.

When will the Unified Patent Court come into existence?

The Unified Patent Court will come into existence at the same time as the Unitary Patent, which is 1st June 2023.

Will Albright IP attorneys be able to represent me at the Unified Patent Court?

Yes, as European Patent Attorneys with appropriate litigation certificates, Albright IP attorneys will have the right of representation at the Unified Patent Court.

What are some advantages and disadvantages of the Unified Patent Court?

The Unified Patent Court will be a new and untested forum. There will therefore be greater uncertainty in the result of litigation heard there.

Additionally, the Unitary Patent or European patent will be at risk of central revocation at the Unified Patent Court. Therefore, for patents of arguable validity, it may be preferable to avoid central litigation to reduce the risk of losing protection in multiple countries at the same time based on a decision from a single court.

On the other hand, whether seeking to enforce or revoke a European patent, it could be more cost-effective to do this via the Unified Patent Court compared to a series of actions on a country-by-country basis.

Can I avoid the jurisdiction of the Unified Patent Court?

Unitary Patents cannot be opted-out of the jurisdiction of the Unified Patent Court.

During a transition period of seven years, classically validated European patents or applications can be opted-out of the jurisdiction of the Unified Patent Court, as long as an action has not yet been brought before the Unified Patent Court.

When to opt-out?

If the risk of central revocation is desired to be minimised, then an opt-out should be filed as soon as possible. The opt-out must have been registered to be effective. An opt-out can be filed during a period of three months (called the sunrise period, starting 1st March 2023) before the Unified Patent Court comes into existence.

Please let us know as soon as possible if you would like to register your interest for opting-out.

Can I opt back in?

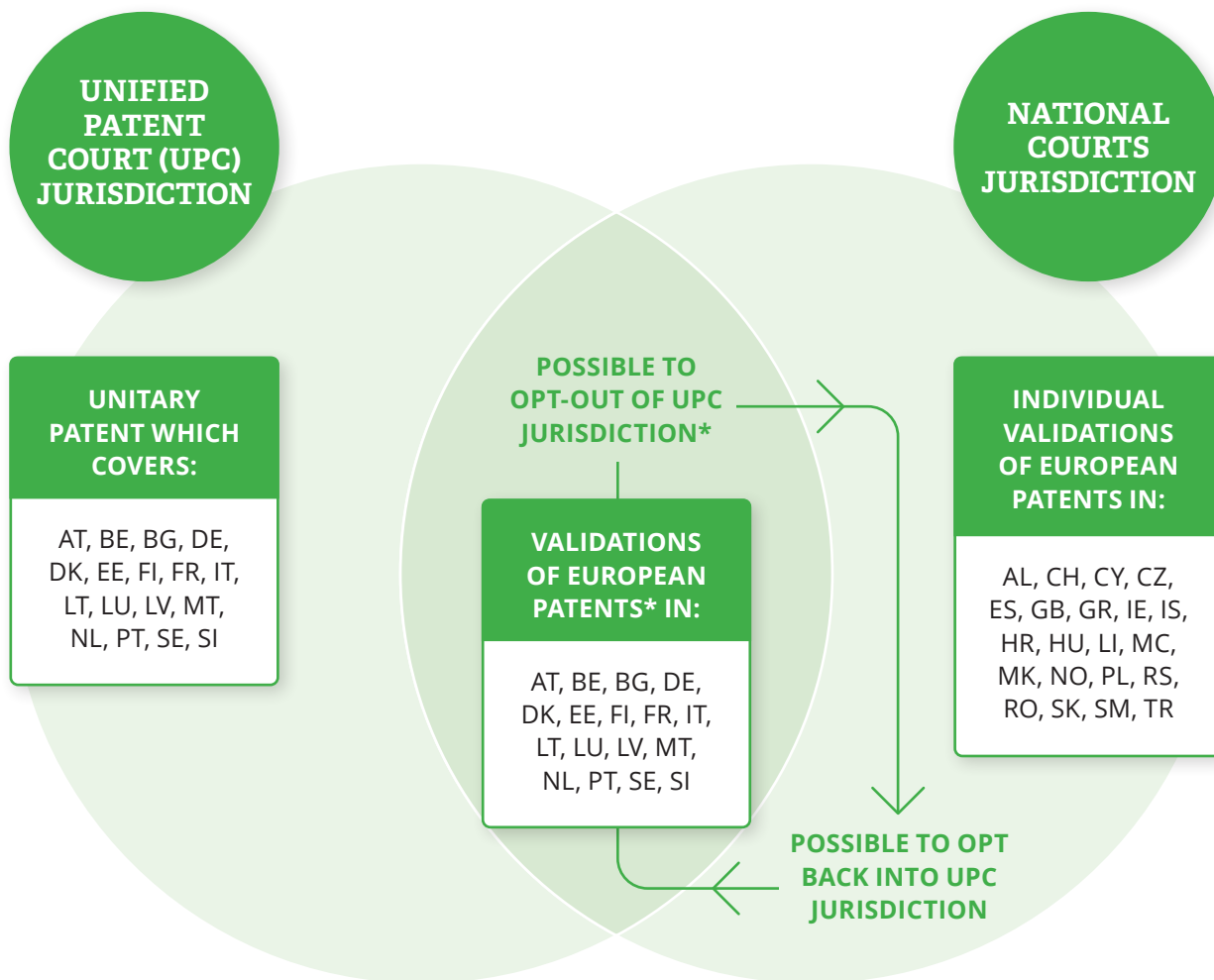
As long as an action has not yet been brought before a national court, an opted-out European patent can be opted back into the jurisdiction of the Unified Patent Court.

Who can authorise the opt-out?

Only the true owner(s) of the European patent can authorise the submission of an opt-out, and we will need to state the identity of the true owner(s) when submitting an opt-out. Otherwise, there is a risk that the opt-out will not have been validly filed.

Therefore, an audit of the ownership of your European patents may be advisable, to determine whether the ownership has been assigned without recordal having taken place.

On 1st June 2023 the Unified Patent Court will be established, it will have jurisdiction over certain European patent rights.



*After a transition period of seven years (which could be extended) opt-outs will no longer be possible and the UPC will have exclusive jurisdiction over validations of European patents in the relevant UPC countries which have not been opted out.

Our Values

