

## Unitary patent & Unified Patent Court

The new unitary patent (UP) and, in particular, the introduction of the Unified patent Court (UPC) represent the biggest change in the European patent law in the last forty years.

The unitary patent will provide a single patent right across all participating European Union member states. It will be litigated as a single unit across the territory before the Unified Patent Court. The Unified Patent Court will also be the litigation forum for “classic” European patents. However, during a transitional period it will be possible to avoid the competence of the UPC for the non-unitary European patents by opting them out of the system.

24 out of 27 member states of the European Union have agreed to take part in the new system (subject to ratification).

### - The start of the system

The new system (UP & UPC) will come into force when at least 13 participating member states, including France, Germany and the UK have ratified the Agreement.

The Protocol to the Agreement on a Unified Patent Court on provisional application (PPA) entered into force on 19.01.2022 and triggered the provisional application period for the final preparations of the UPC. It is deemed that the PPA may last at least eight months.

The date of entry into force of the Unified Patent Court agreement is estimated to be towards the end of 2022. The precise date depends on when Germany ratifies the UPC Agreement. Ratification is expected once those preparations are sufficiently advanced.

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## - Ratification progress

So far, 16 states have deposited their instruments of ratification: Austria (06.08.2013), France (14.03.2014), Sweden (05.06.2014), Belgium (06.06.2014), Denmark (20.06.2014), Malta (09.12.2014), Luxembourg (22.05.2015), Portugal (28.08.2015), Finland (19.01.2016), Bulgaria (03.06.2016), The Netherlands (14.09.2016), Italy (10.02.2017), Estonia (01.08.2017), Lithuania (24.08.2017), Latvia (11.01.2018), and Slovenia (15.10.2021).

United Kingdom also deposited the instrument of ratification (26.04.2018). However, withdrawal of its ratification was filed after Brexit and was effective as from 20.07.2020.

If you still have any questions, please feel free to contact one of our experts:

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**EN ESTA PRIMERA PÁGINA INCLUIRÍA 4 TABS:**

- **“UNITARY PATENT”**
- **“UNIFIED PATENT COURT”**
- **“HOW TO PREPARE FOR THE NEW SYSTEM”**
- **“EXTERNAL LINKS FOR FURTHER INFORMATION”**

- **[EL PRIMER TAB NOS LLEVA AQUÍ](#)**

- **The unitary patent**

The new unitary patent is a single patent which will be granted with equal effect through each and every participating member state and will be maintained as a single unit. It can be regarded as a supranational validation instead of a national validation of a European patent.

The unitary patent will be granted by the European Patent Office (EPO) like any European patent. If the applicant wants the European patent to become a unitary patent, he/she will have to register the European patent as a unitary patent within a period of 1 month after grant. During a transitional period, a translation of the patent into English (if the patent was not already in English) or into any other European language (if the patent is in English) will have to be provided together with the request.

Infringement and validity decisions concerning a unitary patent will apply equally to all participating member states.

With regard to transfers and licenses, the unitary patent will only be able to be transferred as a whole. However, it will be possible to license it in respect of the whole or part of the territories of the participating member states.

- **Territorial scope of the unitary patent**

The unitary patent will have unitary effect only in those countries that are unitary patent member states at the time of registering the unitary patent.

The conditions to be a unitary patent member state are the following:

- (i) To participate in the enhanced cooperation for the creation of unitary patent protection at the time of application for registration of the unitary effect; and
- (ii) That the Agreement on the UPC is in force in the member state at the time of registration of the unitary effect.

The number of unitary patent member states will grow over time. Thus, unitary patents will differ in the territorial scope depending on the time of their registration.

- **How to get a unitary patent**

The substantive requirement for registration of the unitary effect is that the European patent is granted with the same set of claims in respect of all participating member states. This means that all these countries must be designated in the European patent. Withdrawal of designations or limitation of the claims with respect to any of the designated states would prevent an applicant from being able to obtain a European patent with unitary effect.

Concerning the formal requirements, the request for unitary patent protection should be filed at the EPO no later than 1 month after the date on which the mention of the grant is published in the European Patent Bulletin. The request must be in writing in the language of the proceedings.

There is no official fee due for the request of a unitary patent.

Upon registration of the unitary effect, the unitary patent will have unitary character retroactively from the date of publication of mention of grant in the European Patent Bulletin, in all participating member states at the time of registration.

#### **- Cost of a unitary patent**

The costs of the unitary patent up to grant will be the same as for any other European patent. However, the validation costs might be considerably reduced after grant since only one translation will be required during a transitional period.

Concerning the renewal fees, the renewal fee scale is based on the sum of the renewal fees paid nowadays for the four most frequently validated countries.

This means that the renewal fees will be less than 5.000 EUR during the first 10 years of the patent. The cumulative total to be paid over the full 20-year term will be 35.555 EUR.

SMEs, natural persons, non-profit organisations, universities and public research organisations that have their residence of principal place of business in an EU member state, will benefit from a €500 'compensation scheme' if the European patent application or Euro-PCT application leading to the Unitary Patent have been filed in an official EU language other than English, French or German. This is intended to mitigate the costs associated with providing the translation during a 6-12 year transitional period.

A reduction of 15% of fees can be obtained if a patent proprietor is willing to license his patent and register a license of right before the EPO. This means that the renewal costs for a patent could be reduced over the maximum 20-year lifetime of a patent by around 5.000 EUR.

#### **- How the existing patents will be affected by the new system**

When the Agreement on the UPC is in force, the new system will apply to any European patent. However, during a transitional period, it will be possible to register an opt-out to avoid the UPC jurisdiction of the existing “classic” European patents, even before the Agreement is in force.

Any European patent that will be within the 1 month period after grant can be a candidate to be registered as a unitary patent provided it accomplishes the substantive and formal requirements mentioned above.

#### **- Options to get patent protection in Europe after the entry into force of the new system**

Once the unitary patent package (UP & UPC) enters into force, there will be three options to get patent protection in Europe:

- a) Unitary patent
- b) Classic bundle of national validations of the European patent
- c) National patents granted by national offices

The unitary patent will not extend to non-participating member states, to countries that have not ratified the Agreement on the UPC, or to countries outside the European Union. If it is desired to cover these territories as well, a combination of the above options such as a unitary patent and national validations of the European patent will have to be used.

#### **- Transitional measures of the EPO before the entry into force**

The EPO has already announced that, with a view to supporting patent applicants in an early uptake of the Unitary Patent, it will introduce transitional measures with respect to European patent applications having reached the final phase of the granting procedure. These measures will be made available ahead of the entry into force of the Unitary Patent system until the end of the period of the provisional application.

Thus, it will be possible to file early requests for unitary effect for those patents eligible, as well as to file a request for a delay in issuing the decision to grant a European patent after dispatch of a communication under rule 71(3) EPC and before approving the text intended for granting for those patents that would be granted before the start of the new system.

## EL SEGUNDO TAB NOS LLEVA AQUÍ:

### **- The new litigation system**

The Unified Patent Court will be a new specialised litigation system that will allow the enforcement, the defense of the validity or revocation of a European patent (with or without unitary effect) through a single decision with effect in all participating member states.

The Court was established by an international agreement in February 2013. It has been signed by 24 of the 27 member states of the European Union. Only Spain, Poland and Croatia have not signed the Agreement. As long as Poland does not sign the Agreement it will not be possible to have a unitary patent in Poland despite having signed the enhanced cooperation procedure for the creation of the unitary patent.

The UPC will start hearing cases once the Agreement has entered into force.

The territorial scope of the decisions of the UPC will change over time because it is most likely that not all participating states have ratified it, when the Agreement enters into force,

### **- The Court Structure**

The UPC will have a Court of First Instance that will comprise local divisions, regional divisions and a central division, and a Court of Appeal located in Luxembourg.

Local and regional divisions will be placed in the contracting member states at their request. The Central Division will have its main seat in Paris and a section in Munich. Still to be known is how the necessary transfer of the seat's functions allocated initially to London before Brexit will be resolved.

The cases will be divided by field of technology according to the International Patent Classification (IPC) of the WIPO.

Generally speaking, local and regional divisions will mainly hear patent infringement cases and the Central Division will hear validity cases.

Depending on the division which hears the case, the language will be different.

### **- Opt-out /Opt-in requirements**

The UPC will have exclusive jurisdiction regarding:

- a) "classic" European patents in the member states which have ratified the Agreement,



- b) unitary patents, and
- c) Supplementary Protection Certificates (SPC) based on the above patents.

However, during a transitional period it will be possible to avoid the competence of the UPC for a “classic” European patent opting it out of the system, provided that this patent has never been the subject of an action before the UPC. It will be possible to register opt-out before the system enters into force. This option is expected to be available three months before the UPC is operational.

It will also be possible to withdraw the opt-out (opt-in) at any time provided that this patent has never been the subject of an action before a national court. A second opt-out is not allowed.

There will be no fee for opt-out a European patent or patent application, nor any fee for opting it back in again.

The opt-out procedure will only be available for the first seven years (extendable up to 14 years, on review after 5 years) from when the UPC comes into force.

#### **- Stages in the proceedings before the UPC**

The procedure will comprise four stages: written proceedings (where the parties will exchange arguments in writing), interim proceedings (where a judge will make all necessary preparations for the oral hearing), the oral hearing, and the Court decision. It is expected that the UPC renders its decision in a period of 12-14 months from filing of the suit at most.

#### **- Representation before the UPC**

Representation of the parties will be compulsory before the UPC except for actions against decisions of the European Patent Office related to the unitary patent. Authorized representatives can be lawyers authorized to practice before a court of a contracting Member State or European Patent Attorneys with appropriate qualifications such as a European Patent Litigation Certificate.

#### **- The costs of litigation before the UPC**

The UPC will work with two types of fees: fixed fees (for all types of actions) and value-based fees (for certain types of actions such as infringement actions or declarations of

non-infringement). The value-based fees will have to be paid when the value of the action, which will be determined by the Court, is estimated to be above 500.000 EUR

For recoverable costs, which are the costs incurred by the successful party that will be generally paid by the unsuccessful party, ceilings will be fixed. It is estimated that they will range from 50.000 EUR for actions valued at up to 250.000 EUR to 3 million EUR for actions valued at more than 50 million EUR.

## EL TERCER TAB NOS LLEVA AQUÍ:

### **What to do before the system comes into effect**

It is advisable to review the established validation strategy. The main factors to consider in this task are the following: the possible additional cost vs. additional territorial scope (depending on the number of countries), simplified internal and external administrative process of a unitary patent compared to registering several national patents, and the loss of flexibility because a unitary patent will be maintained or lapsed in its entirety (the single renewal fee will prevent the dropping of countries over time).

Applicants would be wise to evaluate the patent portfolio to decide which patents and/or patent applications should be opted-out of the system to avoid the competence of the UPC.

Prior to the unitary patent system is in force, if the grant of a patent application which is a unitary patent candidate looks likely to occur, applicants might want to consider using the transitional measures provided by the EPO (to file early requests for unitary effect for those patents eligible, as well as to file a request for a delay in issuing the decision to grant a European patent after dispatch of a communication under rule 71(3) EPC and before approving the text intended for granting for those patents that would be granted before the start of the new system).

In new license agreements, applicants have to bear in mind to try to stipulate who has the right to make or to impose a decision on whether or not to opt-out, and who has the right to enforce a patent. A review of already existing license agreements (both patentee and licensee) to try to stipulate the previous issues is recommended as well.

- **Y EL CUARTO TAB NOS LLEVA AQUÍ:**

**UP& UPC links**

- Regulation 1257/12 on the creation of the unitary patent protection

<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0001:0008:EN:PDF>

- Regulation 1260/12 on the language regime of the unitary patent

<http://eur-lex.europa.eu/LexUriServ/LexUriServ.do?uri=OJ:L:2012:361:0089:0092:en:PDF>

- Rules of procedure of the Unitary patent

<https://www.epo.org/law-practice/legal-texts/official-journal/2016/05/a39/2016-a39.pdf>

- Agreement on a Unified Patent Court

<https://www.unified-patent-court.org/sites/default/files/upc-agreement.pdf>

- Rules of procedure of the Unified Patent Court (18<sup>th</sup> draft, 19 October 2015)

<http://www.unified-patent-court.org/images/documents/UPC-Rules-of-Procedure.pdf>

- European Patent Office – unitary patent overview

<http://www.epo.org/law-practice/unitary/unitary-patent.html>

- European Patent Office – Unified Patent Court overview

<http://www.epo.org/law-practice/unitary/upc.html>

- Preparatory Committee website

<http://www.unified-patent-court.org/>

- Ratification process

<http://www.consilium.europa.eu/en/documents-publications/agreements-conventions/agreement/?aid=2013001>

- Proposal on Court fees and recoveral costs (May 2015)

[http://www.unified-patent-court.org/images/documents/court\\_fees\\_and\\_recoverable\\_costs\\_consultation.pdf](http://www.unified-patent-court.org/images/documents/court_fees_and_recoverable_costs_consultation.pdf)