

PATENT- UND RECHTSANWÄLTE

# European Patent w/ Unitary Effect & Unified Patent Court

- Overview # Timeline # Strategies -

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# I. Introduction



# Introduction



## **EP Bundle Patent:**

**EP patent offers protection in 44 countries**

**(39 EPC member states + extension/validation system)**

## **EP Patent with unitary Effect:**

**Unitary Patent package for 18 & up to 24 participating EU member states**





# Introduction



## Excluded:

- Great Britain (BREXIT!)
- Turkey
- European Free Trade Association:  
IS, LI, NO and CH
- Several Eastern European countries

## Delayed:

- Spain Poland and Croatia are not  
(yet) signatories to the Unified  
Patent Court Agreement (UPCA)







## 18 EU member states that have already ratified the UPCA:

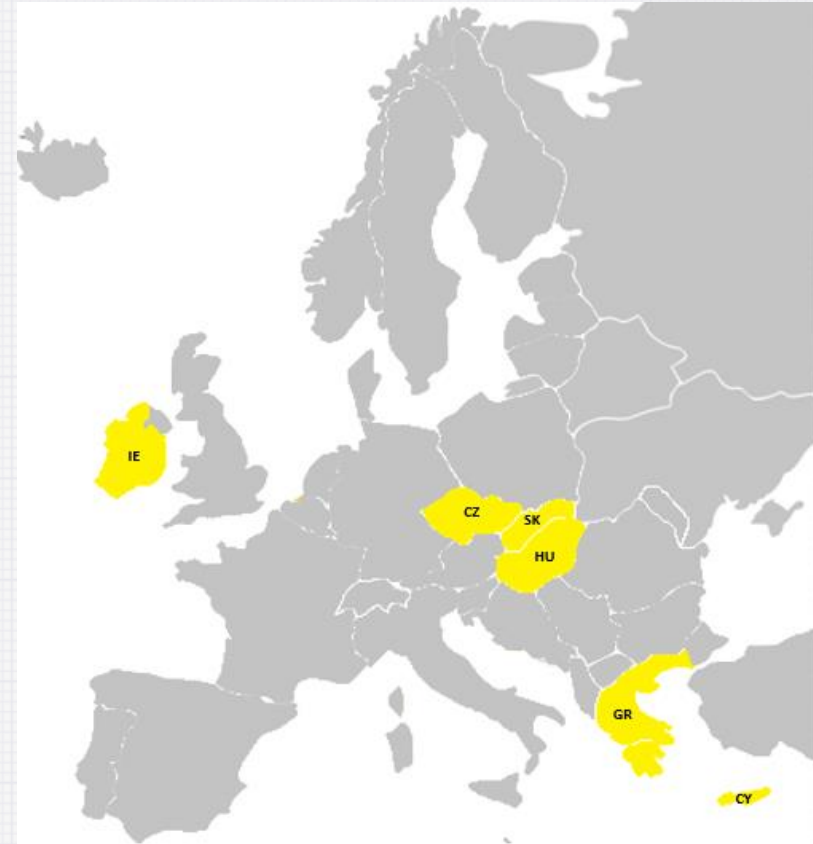
- Belgium
- Bulgaria
- Denmark
- Estonia
- France
- Germany
- Italy
- Latvia
- Lithuania
- Luxembourg
- Malta
- Netherlands
- Austria
- Portugal
- Slovenia
- Finland
- Romania
- Sweden





## Six EU member states that have signed (and therefore are likely to ratify) the UPCA ... soon?

- Czech Republic: less likely (study of impact of UPC on CZ businesses in 2019)
- Ireland: referendum required for ratification
- Greece: likely (positive statement in 2017)
- Cyprus: no information available
- Hungary: less likely (constitutional amendment required for ratification)
- Slovakia: less likely (government recommends to observe for three years)



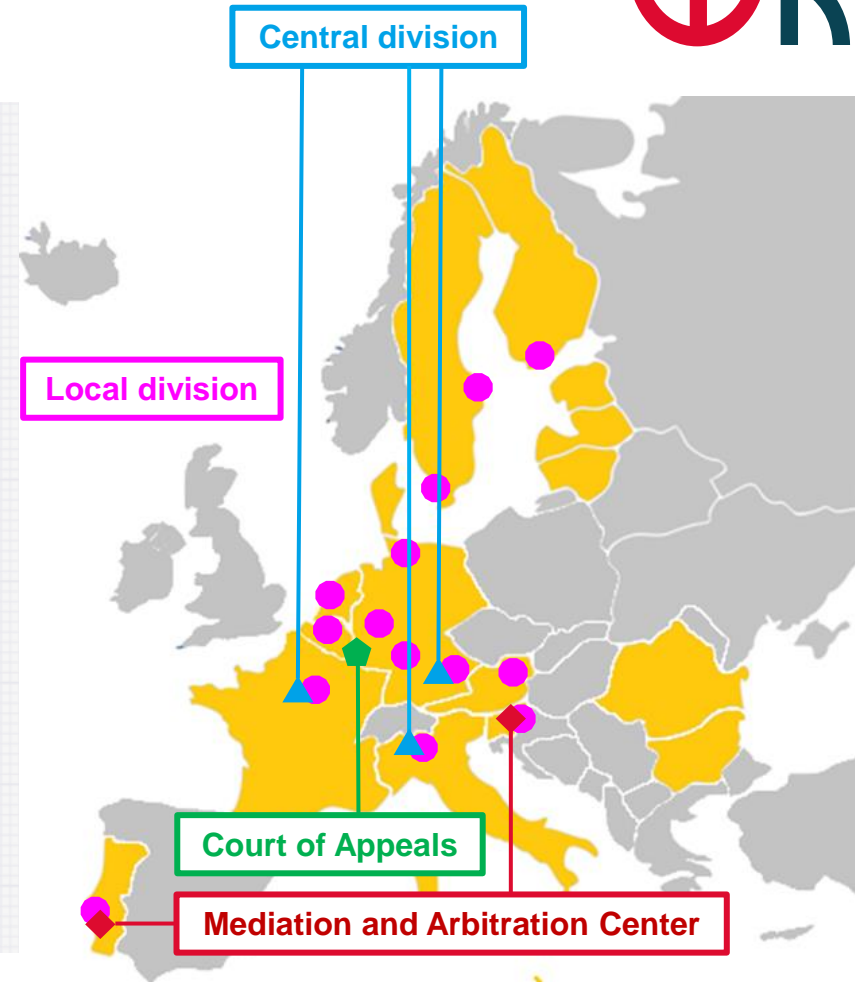


# Introduction



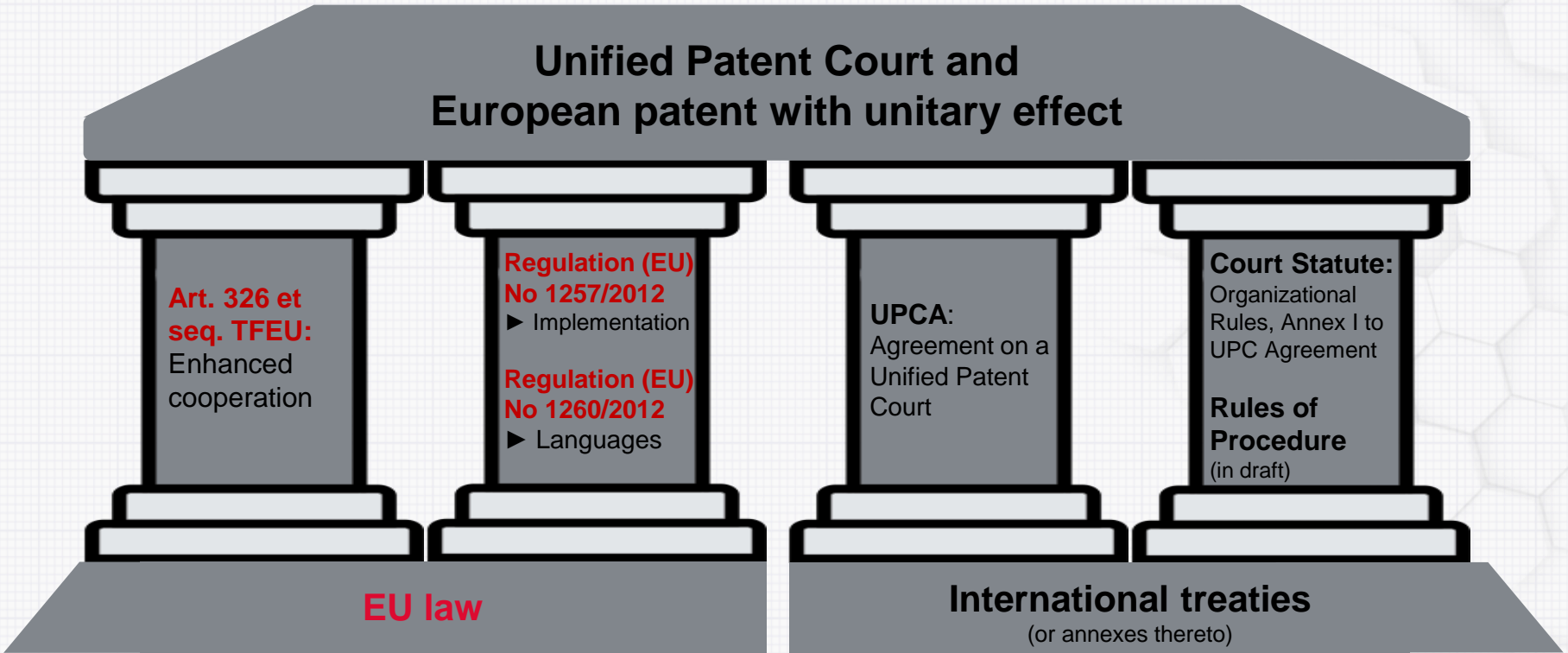
## Court locations

- First instance:
  - Central division: Paris, Munich, Milan
  - Regional division: Nordic-Baltic Regional Division in Stockholm (SE, EE, LV, LT)
  - Local division: Munich, Mannheim, Düsseldorf, Hamburg, Milan, Paris, Vienna, Brussels, Copenhagen, The Hague, Helsinki, Ljubljana, Lisbon.
- Court of Appeal: Luxembourg
- Patent Mediation and Arbitration Centre in Lisbon and Ljubljana
- Training Centre for Judges in Budapest





## II. Legal Basis





## ... and the basis in the European Patent Convention (EPC)?

### ► Article 142, paragraph 1, EPC:

*"A group of Contracting States which has determined in a special agreement that European patents granted for those States shall be unitary for the whole of their territories may provide that European patents may be granted only for all those States jointly."*

# **III. European Patent with Unitary Effect**



**European Patent with Unitary Effect is a „classic“ European patent for which a request for unitary effect for all (18 - as of July 2024) participating states is filed, within one month after grant**

(Art. 3 of Regulation (EU) No 1257/2012, Rule 6 of the EPO Rules relating to Unitary Patent Protection)

- ▶ **Filing and examination procedures remain unchanged (EPO)**
- ▶ **Unitary effect limited to those states, in which the UPCA has already entered into force on the date of registration of the unitary effect (no changes later on)**
- ▶ **all conceivable „mixed“ forms of „classic“ validation and unitary protection possible (including no unitary protection)**





## Procedural Features:

- Unitary Patents and the Unitary Effect have their own section in the register entry
- Unitary Patents can be attacked in opposition/appeal proceedings (same as „classic“ EPs)
- action for revocation is possible any time from the date of grant, **and may run in parallel with opposition proceedings**
- revocation action has comprehensive effect ("central attack")
- limitation or transfer also possible, but only for all member states
- licenses may be limited to selected member states, Art. 3(2) Reg No 1257/2012



## Translation Regime

- End Game: no further translation if patent specification of the unitary patent is published in EPO language of proceedings - English, French, German (Art. 14 para 6 EPC)
- „Information“ for all interested parties via high-quality machine translations into all official EU languages (Rec. 11 of Regulation (EU) No 1260/2012)
- **Transitional Provision:** translation into English (in case grant in DE or FR) or into another official EU language (in case of grant in ENG) has to be submitted *together with the application for unitary effect* (Art. 6 Regulation (EU) No 1260/2012)



## Annual fees / Validation costs

- calculated based on annual fees in the four member states with highest number of applications in 2015 ("True Top 4")
- paid by means of a single annual payment to the EPO
- # 10 years: approx EUR 5,000 # 20 years: approx. EUR 35,000
- Overall cost savings also due to elimination of translations in AT, BG, CY, CZ, EE, GR, IT, MT, PT, RO, SK (which have ratified the UPCA but are not party to the "London Agreement")
- CAVEAT: no option to reduce country coverage, because the unitary patent cannot be abandoned „selectively“ (annual fees for all or none)



# European Patent with Unitary Effect



## Annual fees – sample calculations

	Unitary patent+UK	DE+FR +UK	+ CH/LI + IE + BE	= subtotal = total	+ NL
5 years	600+80	466	+ 210 + 264 + 170	= 644 = 1,110	+ 140
10 years	4,685+800	3,140	+ 914 + 870 + 690	= 2,474 = 5,614	+ 1,540
12 years	7,920+1,250	5,280	+ 610 + 507 + 455	= 1,572 = 6,852	+ 2,640
15 years	15,310+2,300	10,320	+ 1,315 + 931 + 955	= 3,201 = 13,521	+ 5,040
20 years	35,555+5,200	24,623	+ 3,678 + 2,052 + 2,505	= 8,235 = 32,858	+ 11,040

- obsolete for Unitary protection: agent fees / service provider fees; basically no translation costs

# IV.

## **Opt-out** for “classic” European patents





# Opt-out for classic European bundle patents



## Unitary Patent package also affects classic EP bundle patents

- For a transitional period of seven years, all classic EP bundle patents may be either subject to proceedings at the UPC or at national courts
- → unitary patent package therefore **requires decision-taking also in regard to classic EPs**
- Within the transitional period of **seven years**, it is possible to **opt-out** from the non-exclusive competence of the Court, unless an action has already been brought before the UPC



# Opt-out for classic European patents



- Opt-out is **valid** for **whole life** of that patent
- Opt-out declared for a **patent application** will apply to the European patent granted later
- **Multiple proprietors** of a patent must act in common to exercise opt-out (otherwise no opt out)
- If an **exclusive licensee** has the right to sue for infringement, the practice of this right (i.e. filing an infringement action with the UPC) ties the patent to this jurisdiction



# Opt-out for classic European bundle patents



## How to opt out (1)

- Opt-out declarations can be submitted until 30 April 2030
- Opt-out declarations must be submitted through the **Case Management**
- **authorization** for an Opt-out request **not verified prior to** its **execution**
  - but all requests will appear on the Register which are **publicly available** on the UPC website,
  - Case Management System requires e-authentication and provides for correction procedure



# Opt-out for classic European patents



## How to opt out (2)

- How to **modify** an already requested/registered Opt-out:
  - ✓ Unless an action has already been brought before a national court, patent proprietors/applicants are entitled to **withdraw their opt-out** at any moment
  - ✓ no opt-out from the withdrawal of an opt-out

# V. Unified Patent Court





## Panels and judges of the Court

**Court of Appeal:** Panel of 3 legally and 2 technically qualified judges, from different nations  
(actions concerning decision of the EPA, Art. 32 (1)(i) UPCA : 3 legally qualified judges)

### Local division (e.g. Germany)

- Munich (2 Panels)
- Düsseldorf
- Mannheim
- Hamburg

- 2 national Judges
- 1 non-national Judge
- Optional: 1 techn. qualified Judge

### Regional division (e.g. Nordic-Baltic)

- Stockholm
- Riga
- Tallinn
- Vilnius

- 2 regional Judges
- 1 non-national Judge
- Optional: 1 techn. qual. Judge

### Central division

- Munich (IPC F)
- Paris (IPC B, D, E, G, H)
- Milan (IPC A without SPCs)

- 2 legally qualified Judges having different nationalities
- 1 techn. qualified Judge



## Jurisdiction – IP rights

UPC has jurisdiction over all Unitary Patents and for the transition period together with national Courts over classic bundle EPs.

► **except: Opt-out is declared (previous section)**

The court also has jurisdiction over SPCs (however: no unitary SPC yet).

The court does not have jurisdiction over:

- National patents
- Utility models
- Patent ownership/entitlement questions



## Jurisdiction – Proceedings (Art. 32 UPCA)

- **Action for infringement**, Counterclaim for revocation possible
- Action for declaration of non-infringement of patents and SPCs
- Provisional measures / injunctions
- **Actions for revocation of patents and SPCs**
- Actions for damages
- Actions concerning right of prior use of invention
- Proceedings in actions against decisions of the EPO concerning the scope of the delegated tasks / administrative matters ...



## Jurisdiction – Securing of evidence, Art. 60 UPCA

- Extensive and detailed provision in Art. 60: to the extent that "all reasonably available evidence" is not yet sufficient to prove patent infringement, the court may order measures to secure evidence before instituting legal proceedings
- measures include, among other, the seizure of infringing objects, as well as materials and equipment used for their manufacture and related documents
- Decisions and orders of the Court are directly enforceable in all contracting member states (Art. 82(1) UPCA)



## Jurisdiction – how to determine the competent court

	Local/regional division	Central division	
Place of infringement	✓	(✓)	If patent protection exists but no local or regional division in the country of infringement
Defendant`s place of business	✓		
Defendant`s place of business is located outside of Europe	(✓)	✓	Place of infringement
Action for revocation		✓	But: Parties can agree on a local chamber beforehand
Action for a declaration of non-infringement		✓	This jurisdiction also applies to any subsequent (counter)action for infringement





## How will an action before the UPC proceed?

► **Objective: complete first-instance proceedings within one year**

### Phases according to the Rules of Procedure (1):

- ✓ Written procedure (exchange of pleadings) – 6 to 8 months
  - After service of the statement of defence: scheduling of and summons to „interim conference" and oral hearing
- ✓ Interim procedure – within a further 3 months
  - purpose: clarify specific points and allow for preparatory measures before oral hearing, e.g. clarification of issues relating to documents or evidence, pre-examination of witnesses etc.
  - flexible: „interim conference“ is intended to be interactive, may be held in the form of a telephone or video conference; language and subject matter flexible



## Phases according to the Rules of Procedure (2):

- Oral hearing
  - Public; limited to one day, if possible
  - Hearing of the parties and taking of evidence
  - Optional: Preliminary assessment of the factual and legal situation
- Judgment with operative part and basic cost decision within 6 weeks
- Optional: Action for damages (as an annex)
  - may be requested within one year from the date of service of the judgment
  - no punitive damages, no „treble damages“



## Course of Infringement proceedings – written pleas

	Infringement	Invalidity	Amendment of claims
	Statement of claim		
+ 3 months	Statement of defence	Counterclaim for Revocation	
+ 2 months	Replica	Response to Counterclaim for Revocation	(Auxiliary) Request for amendment
+ 2 months	Duplicate	Replica on Counterclaim for Revocation	Reply to request for amendment
+ 1 month		Duplicate on Counterclaim for Revocation	Replica on Request for amendment
+ 1 month			Duplicate on Request for amendment



## Course of legal proceedings – legal remedy (appeal)

### ► Only two instances overall

- Suspensive effect in case of infringement decision only upon request
  - but: an appeal against a decision on actions or counterclaims for revocation shall always have suspensive effect, Art. 74(2) UPCA
- Appeal also against procedural decisions (Rule 220 of the draft Rules of Procedure, subject of controversial discussion)
- Structure of the appeal procedure corresponds to first instance proceedings
- New facts and new evidence may be admissible (Art. 73(4) UPCA, Rule 222 of the Rules of Procedure) under certain conditions

# **VI.**

# **Strategic considerations**



- Revocation risk
  - one action for revocation can destroy a patent for 18 countries in one stroke
- Infringement and costs upsides
  - “18 jurisdictions for the price of one” (or a few)
  - UPC attractive for multijurisdictional infringement
- The member states have allocated highly qualified, experienced patent judges to the UPC. The decisions to date show a high quality of judgement



# Strategic considerations: „meta-conclusions“



- If Patentee's position/"history" is essentially defensive (wants to keep patents, never or rarely litigates): opt out to avoid competence of the UPC
- If Patentee is offensive-minded and considers to assert (strong) patents, UPC is of interest
- „best of both worlds“ (if costs are not a primary concern): keep parent national and file **divisional** EP with unitary effect for UPC

**Thank you for your interest! Please follow up!**

**<https://www.wallinger.com/team>**

