



RELEVANT ASPECTS OF THE EUROPEAN PATENT WITH UNITARY EFFECT

Definition

The European patent with unitary effect, so-called Unitary Patent (UP), is a [European Patent](#) granted by the European Patent Office (EPO) under the European Patent Convention that benefits – after grant and upon request – of a «unitary effect» in the territory of the EU States which are part of the Unitary Patent «Package»

DEFINITION



The geography of the Unitary Patent

The Unitary Patent «Package» consist of:

1. Regulation (EU) No 1257/2012 implementing enhanced cooperation in the area of the creation of Unitary Patent protection
2. Regulation (EU) No 1260/2012 implementing enhanced cooperation in the area of the creation of Unitary Patent protection with regard to the applicable translation arrangements
3. Agreement on a Unified Patent Court (UPCA)



UNITARY
PATENT (UP)



UNIFIED
PATENT COURT
(UPC)



The geography of the Unitary Patent

In December 2012 the EU Council and the European Parliament adopted the [Regulation \(EU\) no. 1257/2012](#) and the [Regulation \(EU\) n. 1260/2012](#) relating to the creation of unitary patent protection in the context of enhanced cooperation between 25 EU Member States called «participating Member States» (PMS)



25 EU member States (2012) + IT (2015) - GB (2020)
=
25 EU member States

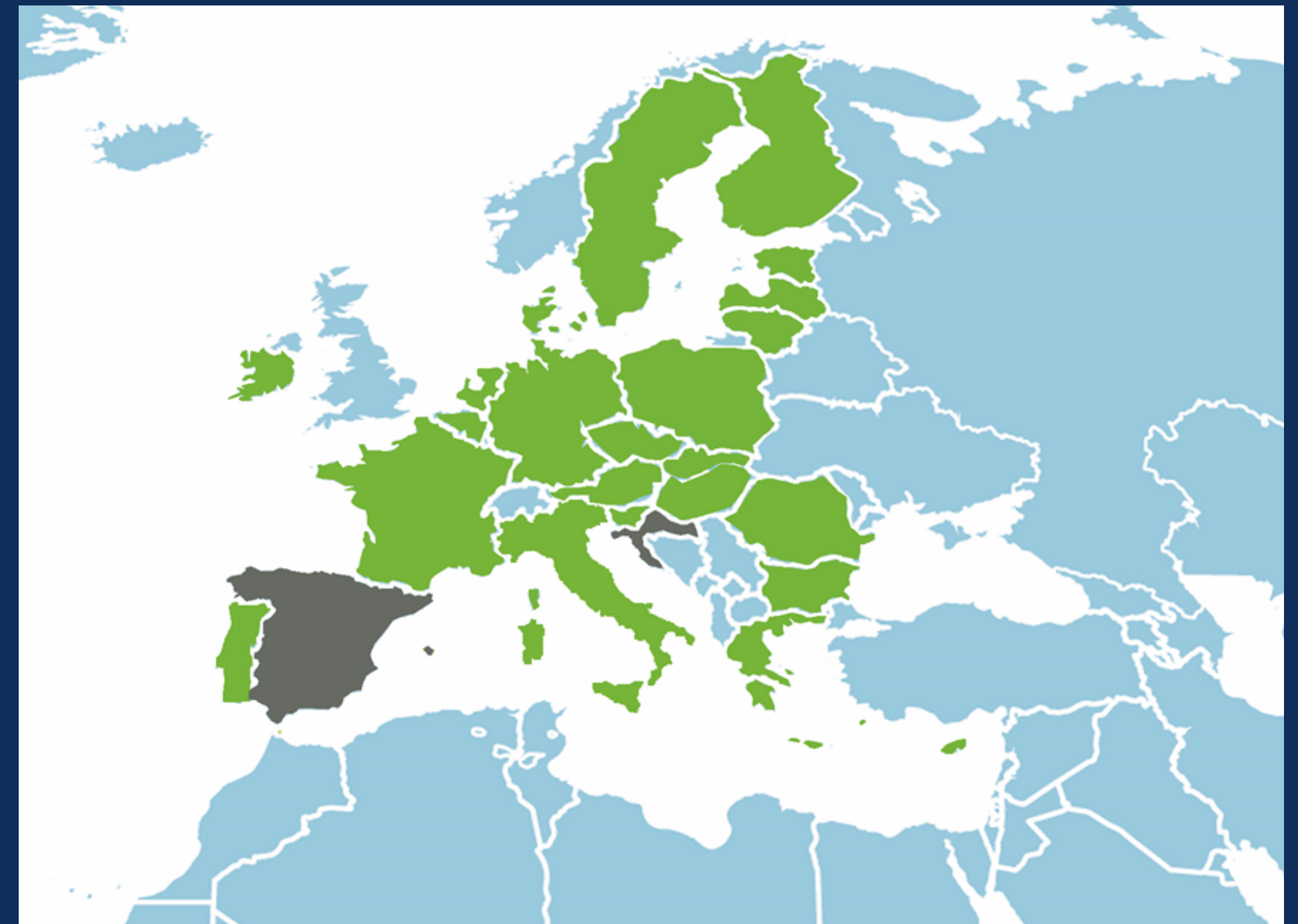
The geography of the Unitary Patent

25 participating Member States PMS:

Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Poland, Portugal, Romania, Slovakia, Slovenia, Sweden

2 EU NON-participating Member States:

Croatia, Spain





The geography of the Unitary Patent

In February 2013, the Unified Patent Court Agreement (UPCA) was signed by 25 EU Member States called «Contracting Member States» (CMS)



25 EU member States (2013) - GB (2020)
=
24 EU member States

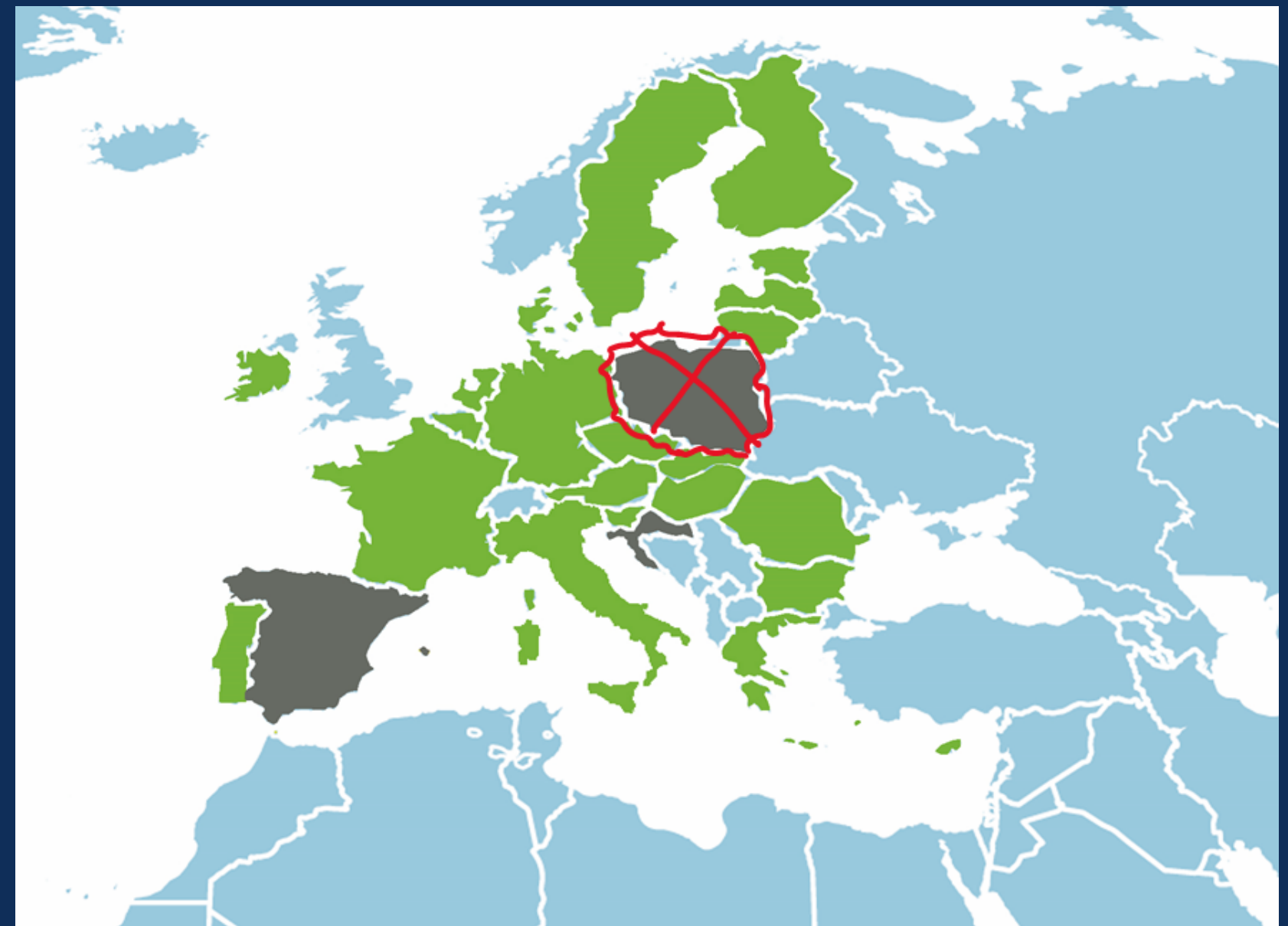
The geography of the Unitary Patent

24 contracting Member States (CMS):

Austria, Belgium, Bulgaria, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Ireland, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovakia, Slovenia, Sweden

3 EU NON-contracting Member States:

Croatia, Spain, Poland





The geography of the Unitary Patent

A European patent with unitary effect only covers EU Member States which, at the date of registration of unitary effect, are simultaneously

Participating Member States (PMS) in enhanced cooperation

AND

Contracting Member States (CMS) where the UPCA is in force



The geography of the Unitary Patent

The UPCA has so far been ratified by 17 Contracting Member States and will enter into force on June 1, 2023

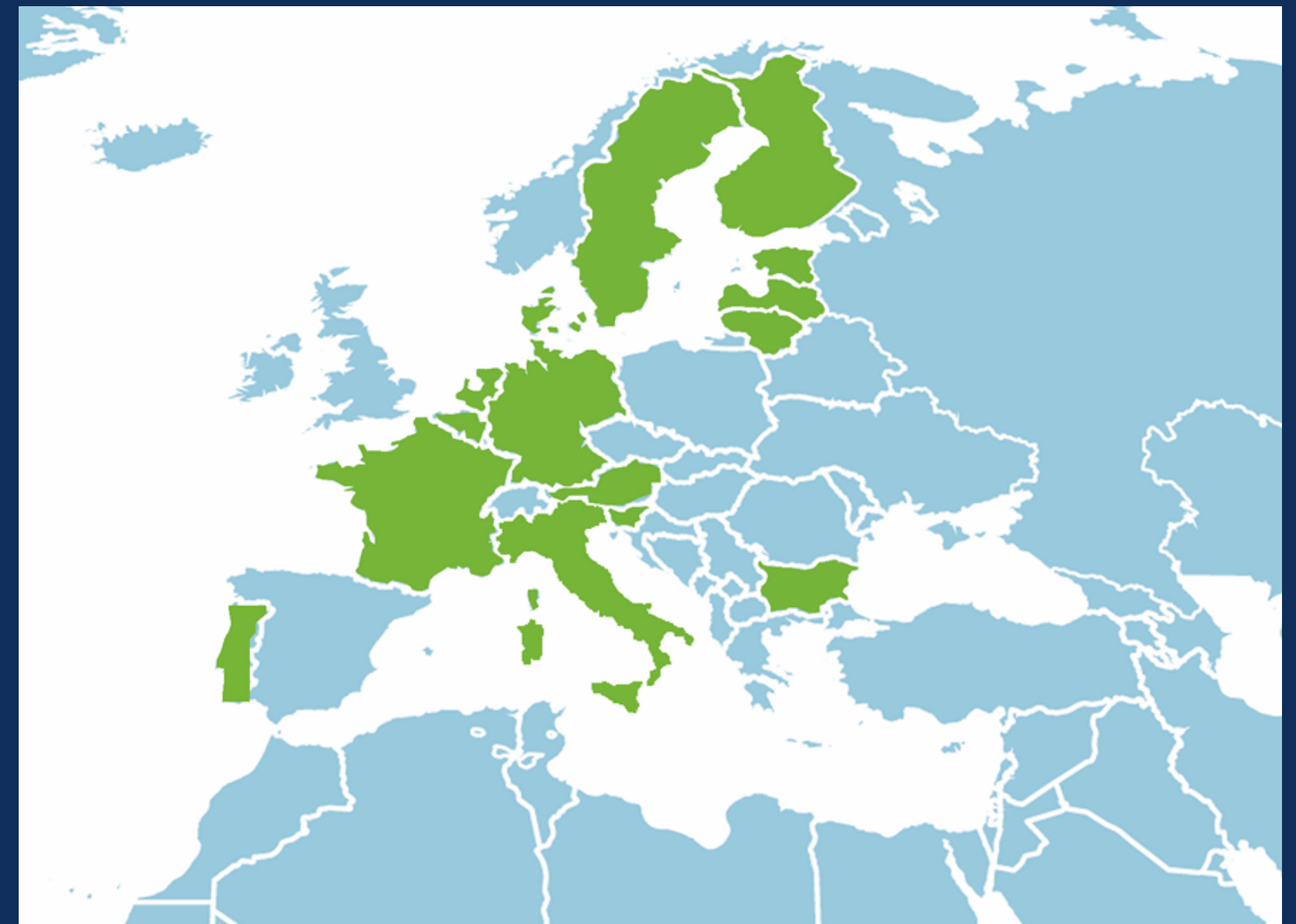
The geography of the Unitary Patent starting situation

17 Contracting Member States (CMS) where UPCA will enter into force

Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, Sweden + **Germany**

Who's missing ?

- Croatia, Spain and Poland (EU NON-contracting Member States)
- Cyprus, Czech Republic, Greece, Hungary, Ireland, Romania, Slovakia (7 EU Contracting Member States that have NOT yet ratified the UPCA)



The geography of the Unitary Patent starting situation

The «PACKAGE» territory has a dynamic coverage: starting with 17 States, it will tend to 24 States when fully operational and potentially up to 27 (all EU States can join)



BUT

the territorial coverage for a Unitary Patent is established on the date of registration of the unitary effect and will stay the same, irrespective of any subsequent ratifications

The geography of the Unitary Patent

EPC contracting states

27 EU member states:

Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Portugal, Slovenia, Sweden (SMC-UPCA in force) Romania, Slovakia, Republic of Cyprus, Czech Republic, Greece, Hungary, Ireland (SMC – UPCA NOT in force)

Croatia, Spain, Poland

+

12 Extra EU states:

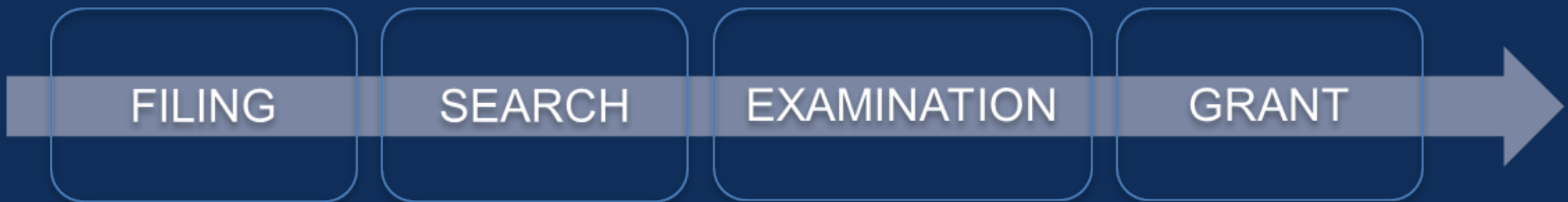
Albania, Switzerland, Macedonia, Iceland, Liechtenstein, Monaco, Montenegro, Norway, Serbia, San Marino, Turkey, United Kingdom



BEFORE



The European Patent pre-grant phase

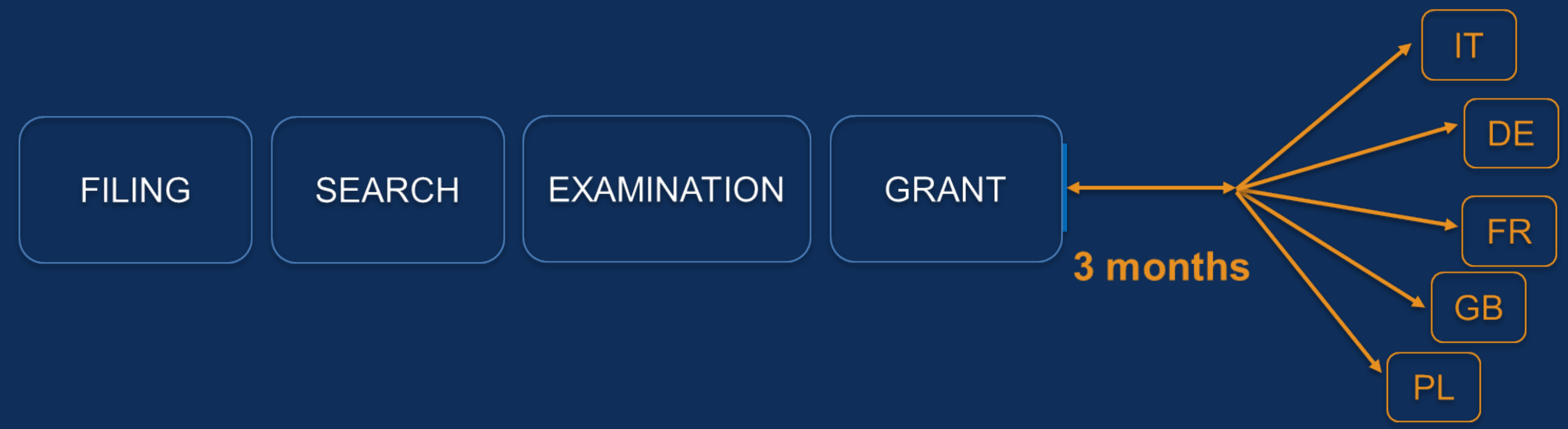


NOTHING CHANGES IN THE PRE-GRANT PHASE



The European Patent post-grant phase

The post-grant phase of the European Patent until today:



NATIONAL VALIDATIONS:
39 Contracting States of the European Patent Convention (27 EU + 12 non-EU)



The European Patent post-grant phase

Another option introduced by the «Package»: **REQUEST FOR UNITARY EFFECT**



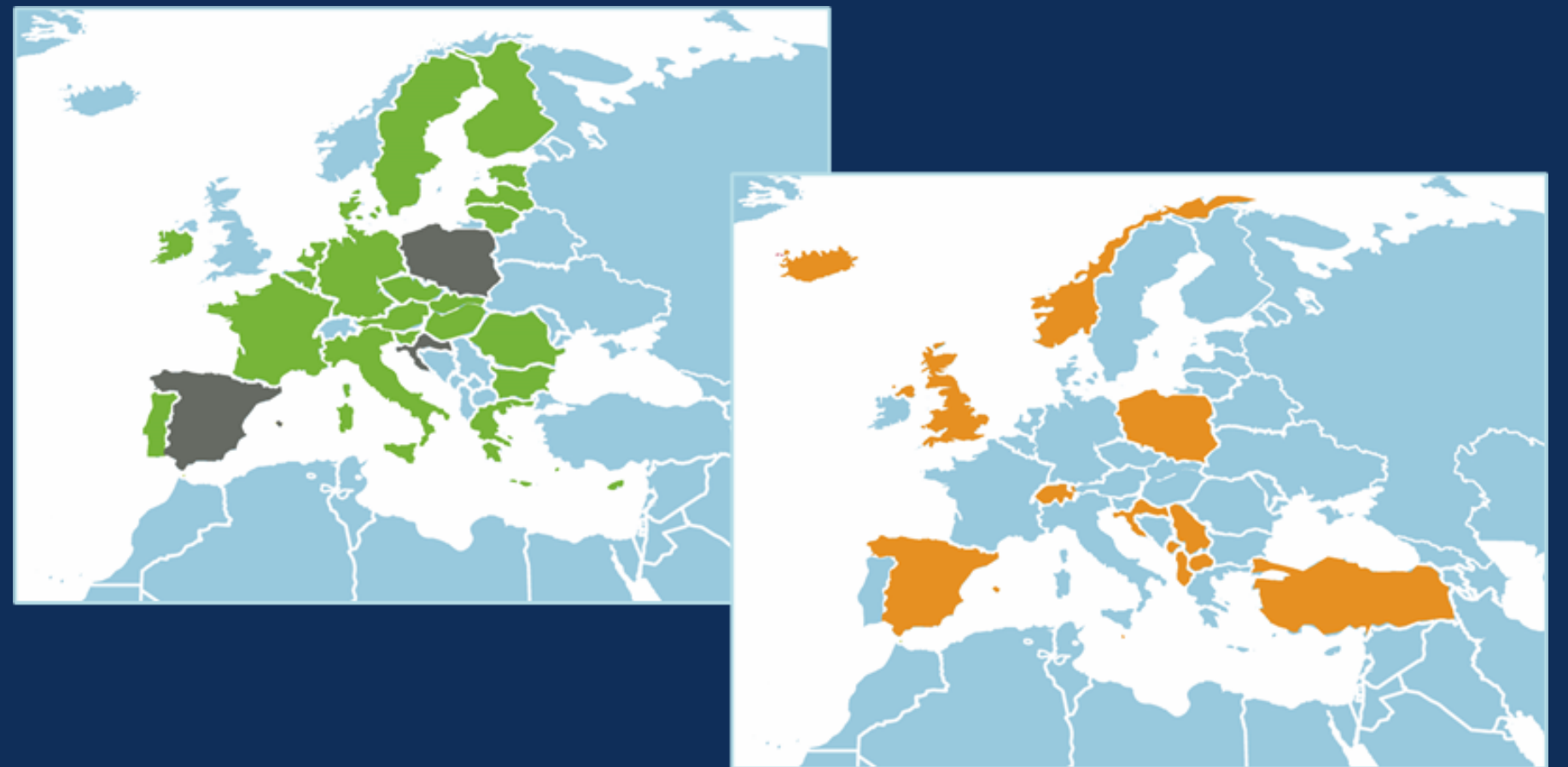
NATIONAL VALIDATIONS:
in the Contracting States of the European Patent Convention outside the «Package»

The European Patent post-grant phase

Two possible alternative post-grant options:



«Traditional» validations



Unitary effect
+
«traditional» validations

The European Patent post-grant phase

Both unitary effect and national validation cannot be requested for a state included in the 'Package' territory



The Unitary Patent

A European patent with unitary effect, so-called Unitary Patent:

- has a unitary character
- provides uniform protection
- has equal effect in all participating Member States
- may only be limited, transferred, revoked or lapsed in respect of all the participating Member States
- may be licensed in respect of the whole or part of the territories of the participating Member States

The Unitary Patent

The UPC has exclusive jurisdiction in civil litigation relating to European Patents with unitary effect, especially for:

- actions for actual or threatened infringements
- actions for declarations of non-infringement
- actions for provisional and protective measures and injunctions
- actions for revocation
- counterclaims for revocation
- actions for damages

The background is a vibrant orange color featuring a faint world map. Overlaid on the map are various financial and business-related icons, including a dollar sign with circular arrows, a bar chart, a pie chart, a document, and a pencil. The word "TAX" is prominently displayed in the center in a large, white, bold, sans-serif font with a black outline.

TAX

A solid cyan horizontal bar is positioned above the section header.

The Unitary Patent renewal fees

In order to maintain a European Patent with unitary effect, the patent proprietor will have to pay annual renewal fees to EPO.

The renewal fees have been set at a level corresponding to the sum of the renewal fees due in the four States where European Patents were most often validated in 2015.

TAXX

The Unitary Patent renewal fees

The renewal fees:

- are due for the years following the year in which the mention of the grant of the European Patent with unitary effect is published in the European Patent Bulletin
- shall be paid in advance, no later than the last day of the month in which the anniversary of the filing date of the European Patent application falls
- may not be validly paid more than three months before their due date
- may be paid within six months of the due date with the payment of an additional fee

TAXX

The Unitary Patent renewal fees

Particular situations:

- a renewal fee in respect of a European Patent with unitary effect that would have fallen due within three months from the notification of the registration of the unitary effect may still be paid within that period without an additional fee
- a renewal fee for a European Patent with unitary effect, that would have fallen due during the period from the date of publication of the mention of the grant of the European patent in the European Patent Bulletin until the date of the notification of the registration of the unitary effect, is due on the latter date and may be paid within three months from that date without additional fee

TAXX

The Unitary Patent renewal fees

If a renewal fee and, where applicable, any additional fee have not been paid in due time:

- the European Patent with unitary effect shall lapse
- the lapse shall be deemed to have occurred on the date on which the renewal fee was due
- the EPO will send a communication under Rule 112(1) EPC
- it is possible to file a request for reestablishment of rights if the proprietor can prove to have taken all due care required by the circumstances
- if the finding of the EPO causing the loss of rights is inaccurate, a review of the finding can be requested

TAXX

The Unitary Patent renewal fees

The proprietor of a European Patent with unitary effect may file a declaration with the EPO that he is prepared to allow any person to use the invention as a licensee in return for appropriate consideration

Renewal fees due after receipt of the declaration are reduced

The reduction of the renewal fees shall be 15%

The statement may be withdrawn at any time and the withdrawal shall take effect when the amount by which the renewal fees were reduced is paid to the EPO

The statement may not be filed as long as an exclusive license is recorded in the Register for unitary patent protection



The Unitary Patent

possible advantages

- single request for unitary effect: cost reduction and simplification
- compensation for translation costs for certain categories of proprietor
- single language (that of granting the European Patent)
- single representative
- single renewal fee
- changes related to ownership that can be registered directly at the EPO (transfers, licenses, etc.)
- single court competent for infringement and validity disputes (UPC): "supra-national" decision, short times, uniformity of judgment, low costs compared to a plurality of actions in several national jurisdictions



The Unitary Patent

possible advantages

- less flexibility in long-term cost management (single renewal fee equal to around four «traditional» validations)
- less flexibility in transfer (may only be transferred in respect of all the participating Member States)
- relevance of the so-called «national prior rights» and consequent expansion of the state of the art
- single court competent for infringement and validity disputes (UPC): the Unitary Patent is subject to revocation with effect on the whole territory of the "Package", higher costs compared to an action in a single national jurisdiction or in a limited number of national jurisdictions, short times, risk of national influences, initial uncertainty due to lack of specific jurisprudence

GUIDLINE

STANDARDS

REGULATION

PROCEDURE

COMPLIANCE

LAW

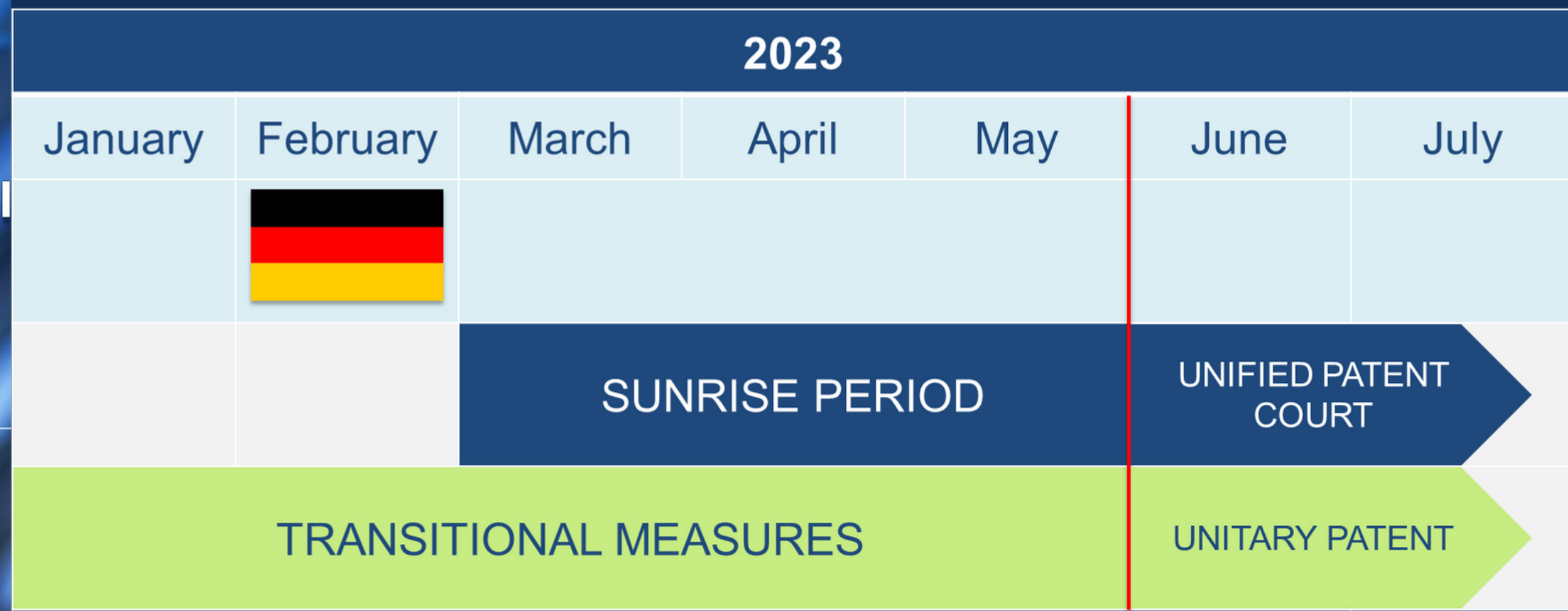


The Unitary Patent «Package» where are we now?

- Considering the status of ratifications, the UPCA enters into force on the 1st day of the 4th month after Germany deposits its instrument of ratification
- Germany's ratification marks the start of a «sunrise period» before the «Package» enters into force
- The entry into force of the UPCA is planned for June 1, 2023
- The “sunrise period” starts on March 1, 2023
- The transitional measures introduced by the EPO, applicable to European patent applications having reached the final phase of the grant procedure, are available as of 1 January 2023



The Unitary Patent «Package» where are we now?



Thank You

