




THE REQUEST FOR UNITARY EFFECT

 **bugnion**
The way to



The request for unitary effect

WHEN: no later than 1 month after publication of the mention of grant of the European patent in the European Patent Bulletin

WHERE: at the European Patent Office

HOW: the request for unitary effect shall be filed in writing in the language of the proceedings preferably by means of online filing (eOLF or Online Filing 2.0, Form 7000)



The request for unitary effect

WHO: all provisions relating to [representation](#) under the EPC apply (Art. 133 and Art. 134(1), (5) and (8) EPC - "Contracting States" means Contracting States to the EPC).




The request for unitary effect representation

No person shall be forced to be represented by a professional representative.

Natural or legal persons **not** having their residence or principal place of business in a Contracting State shall be represented by a professional representative and act through him **also for** filing the request for unitary effect.

Natural or legal persons having their residence or principal place of business in a Contracting State may be represented by an employee.



The request for unitary effect representation

The Decision of the President of the European Patent Office dated 12 July 2007 on the filing of authorisations – Special edition No. 3, OJ EPO 2007, L.1 – is not limited to representation under the EPC and the PCT therefore European patent attorneys are generally exempted from submitting authorisations.

Authorisations already filed do not cover the procedures relating to the European Patent with unitary effect. The following forms have been updated:

- Specific authorisation ([Form 1003](#))
- General authorisation ([Form 1004](#))

The request for unitary effect representation

Updated Form 1003



Europäisches
Patentamt
European
Patent Office
Office européen
des brevets

Vollmacht
Authorisation
Pouvoir

- 6 Diese Vollmacht gilt auch für Verfahren nach Artikel 9 (1) der Verordnung (EU) Nr. 1257/2012 in Verbindung mit der Durchführungsordnung zum einheitlichen Patentschutz. / This authorisation also applies to any proceedings established by Article 9(1) Regulation (EU) No 1257/2012 in conjunction with the Rules relating to Unitary Patent Protection. / Le présent pouvoir s'applique également à toute procédure instituée par le règlement (UE) n° 1257/2012 ensemble le règlement d'application relatif à la protection unitaire conférée par un brevet.

The request for unitary effect representation

Updated Form 1004



Allgemeine Vollmacht General authorisation Pouvoir général

Bitte übermitteln Sie das **Original** an die Rechtsabteilung und Abteilung für einheitliche Patente des EPA (Dir. 5.2.3) in München. / Please forward the **original** directly to the EPO, Legal and Unitary Patent Division (Dir. 5.2.3) in Munich. / Prière de faire parvenir l'**original** directement à la division juridique et du brevet unitaire (Dir. 5.2.3) de l'OEB à Munich.

- 5 Diese Vollmacht gilt auch für Verfahren nach Artikel 9 (1) der Verordnung (EU) Nr. 1257/2012 in Verbindung mit der Durchführungsordnung zum einheitlichen Patentschutz. / This authorisation also applies to any proceedings established by Article 9(1) Regulation (EU) No 1257/2012 in conjunction with the Rules relating to Unitary Patent Protection. / Le présent pouvoir s'applique également à toute procédure instituée par le règlement (UE) n° 1257/2012 ensemble le règlement d'application relatif à la protection unitaire conférée par un brevet.

Requirements

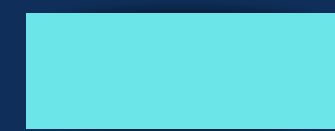
The request for unitary effect

«SUBSTANTIVE» REQUIREMENT: the European Patent has been granted with the same set of claims for all the participating Member States

«FORMAL» REQUIREMENTS:

- the request for unitary effect shall include: particulars of the proprietor(requester), of the patent and of the representative, if appointed
- during a transitional period (minimum 6 years - maximum 12 years), the request for unitary effect shall include a translation of the European patent into:
 - ENGLISH where the language of the proceedings is French or German;
 - any other EU official language where the language of the proceedings is English

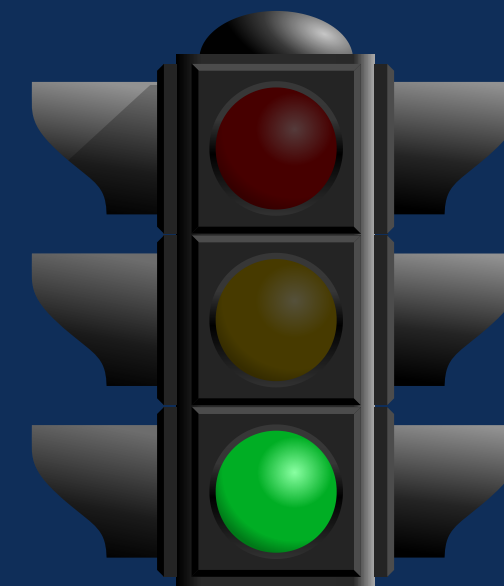
The text of such translations shall be for information purposes only (no legal effect) but should not be carried out by automated means

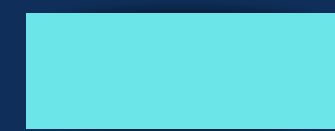


The request for unitary effect possible scenarios

SCENARIO 1: the request for unitary effect is submitted in time and all requirements are met

The EPO registers the unitary effect in the «Register for Unitary Patent Protection» and communicates to the patentee the date of registration of the unitary effect (Rule 7(1) UPR).

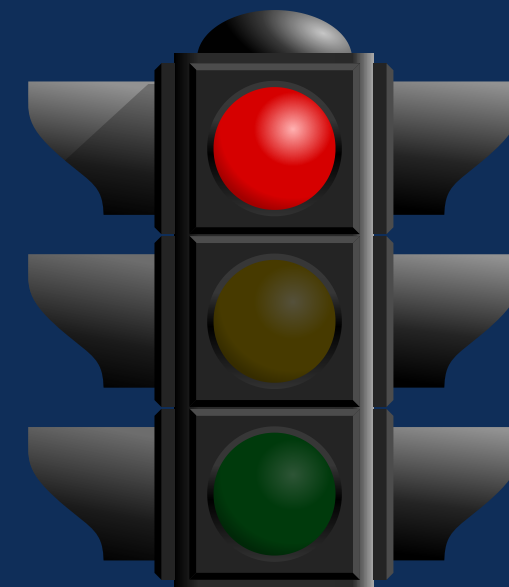


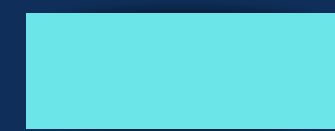


The request for unitary effect possible scenarios

SCENARIO 2: the request for unitary effect is filed in time, but the European patent has been granted with different sets of claims for different Participating Member States (substantive requirement not met).

The EPO rejects the request for unitary effect. The patentee has the opportunity to comment.

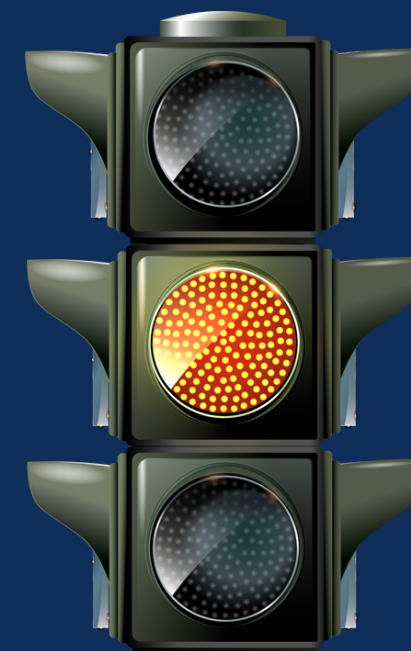




The request for unitary effect possible scenarios

SCENARIO 3: the request for unitary effect is filed after 1 month after publication of the mention of grant of the European patent in the European Patent Bulletin

The EPO rejects the request for unitary effect. The patentee can file a request for re-establishment of rights within 2 months of the expiry of the one-month period. The EPO grants / rejects the request for re-establishment of rights.



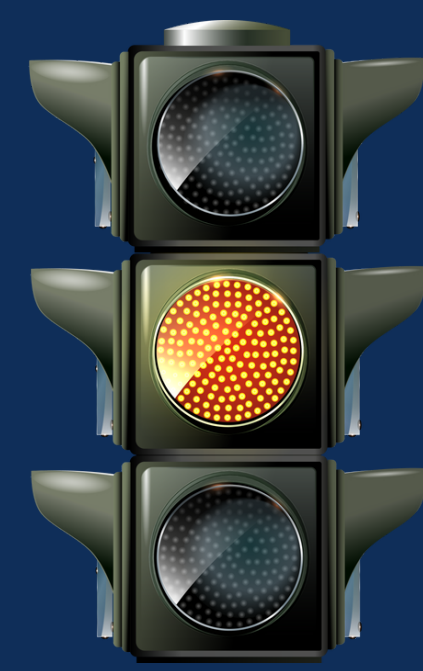


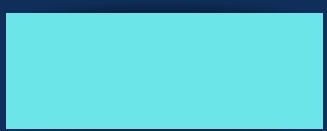
The request for unitary effect possible scenarios

SCENARIO 4: the request for unitary effect is filed in time, the substantive requirement is met but one or more formal requirements are not met

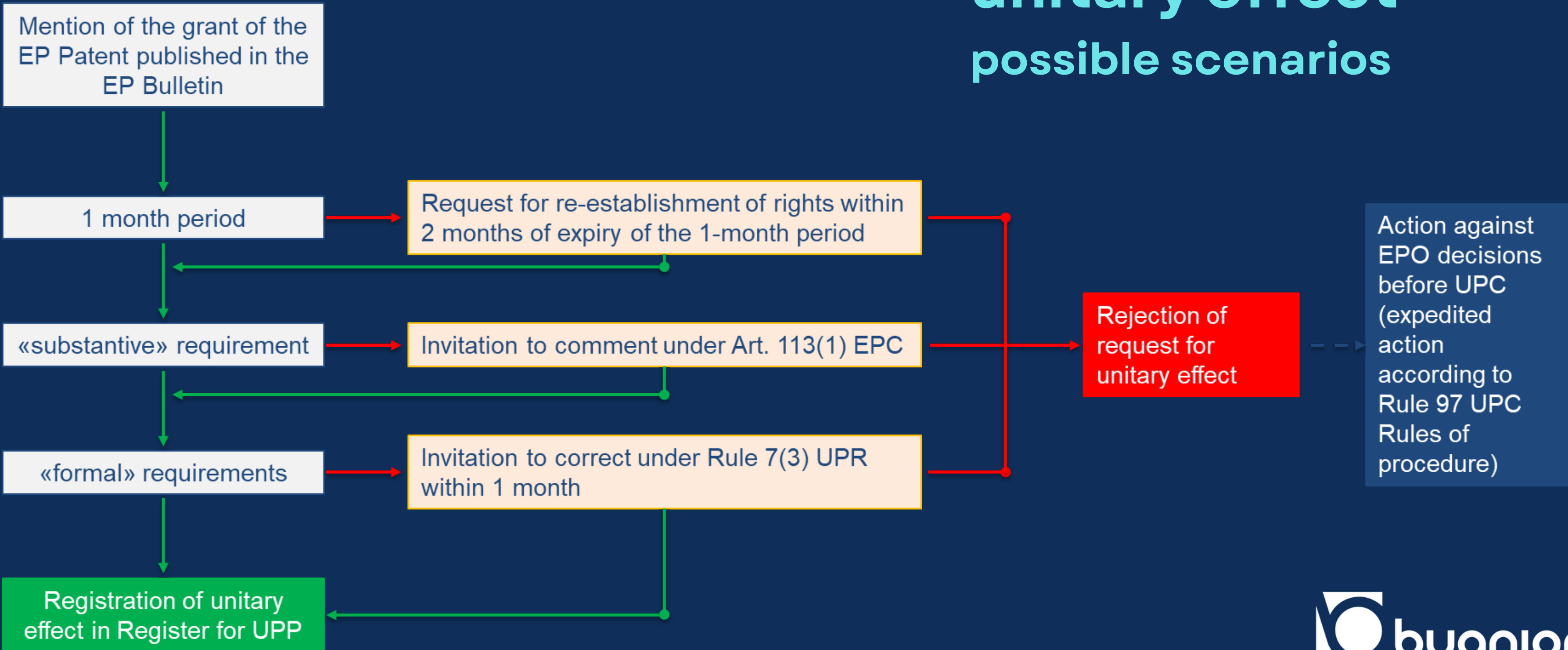
The EPO invites the patentee to correct formal defects within a non-extendable deadline of 1 month (R. 7(3) UPR). If the formal defects are not corrected, the request for unit effect is rejected.


Attention: Re-establishment of rights is not available for the one-month period according to R. 7(3).





The request for unitary effect possible scenarios



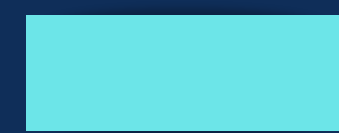


The request for unitary effect possible scenarios

SAFETY NET: if there are problems in the request for unitary effect, the decision of the EPO on the re-establishment of rights or a possible rejection of the request for unitary effect due to the failure to correct formal defects can be issued when the 3-month deadline from the publication of the mention of the grant of the EP Patent in the EP Bulletin to file the classic validations has already expired.

Some States provide for a "safety net" to avoid complete loss of rights. Info at

<https://www.epo.org/law-practice/legal-texts/national-measures-up.html>



The request for unitary effect rejection

The UPC shall have exclusive competence with regards to actions concerning decisions of the EPO in carrying out the tasks referred to in Art. 9 of Reg. 1257/2012 [Art. 32(1)(i) UPCA].

Actions shall be brought before the central division [Art. 33(9) UPCA].

If the EPO rejects a request for unitary effect, it is provided for a high-speed action according to Rule 97 RoP UPC. This procedure does not include the possibility of interlocutory revision by the EPO.



The request for unitary effect rejection

The proprietor of a European Patent whose request for unitary effect has been rejected by the EPO shall file at the UPC Registry an Application to reverse the decision within **three weeks** of service of the decision of the EPO.

The Application to reverse shall be in the language in which the European Patent was granted.

Representation is not mandatory.


The parties shall bear their own costs.



The request for unitary effect rejection

UPC procedure - Court of First Instance [Rules 85-98 RoP UPC]


- Application forwarded to the standing judge => decision within **three weeks** of the date of receipt => NO interlocutory review by the EPO
- Statement of appeal within **three weeks** of service of the decision => appeal assigned to the standing judge of the Court of Appeal => decision within **three weeks** of receipt by the Registry of the Statement of appeal
- Whole action finalized in less than **3 months**



The request for unitary effect optional content

The request for unitary effect may include:


- a request for compensation for translation costs
- information regarding a place of business of the applicant on the date of filing of the European Patent application



The request for unitary effect compensation

The request for compensation shall be filed **together with** the request for unitary effect and will be granted if the following **conditions** are fulfilled:

1. the European patent application was filed in an **official language of the EU other than English, French or German**
2. the proprietor has residence or principal place of business in a **EU Member state**
3. the proprietor falls within one of the following **categories**: natural persons, SMEs, non-profit organisations, universities, public research organisations
4. if the patent has multiple proprietors, each proprietor shall fulfil the requirements 2) and 3)
5. if the European patent application or the European patent was transferred before a request for unitary effect was filed, both the initial applicant and the proprietor of the patent shall fulfil the conditions 2) and 3)



The request for unitary effect compensation


The request for compensation will be granted / rejected after the EPO has registered the unitary effect.

Once granted, compensation shall not be rescinded, even if, as a result of changed circumstances, the proprietor no longer qualifies for it. The amount of the compensation shall be 500 €.

Should the EPO have reason to doubt the veracity of the declaration, it shall invite the patent proprietor to provide evidence that he fulfils the requirements.

If the EPO finds that the compensation was granted on the basis of a false declaration, it shall invite the patent proprietor to pay, together with the next renewal fee falling due, an additional fee = 500 € + 250 €.

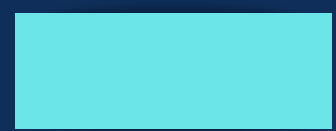
If this additional fee is not paid in due time, the European patent with unitary effect shall lapse.



The request for unitary effect compensation

Differences between «compensation» according to Art. 5 Regulation 1260/2012 and «reduction» of filing fee according to Rule 6 EPC

	“COMPENSATION”	“REDUCTION”
Categories	SMEs, natural persons, non-profit organisations, universities, public research organisations	SMEs, natural persons, non-profit organisations, universities, public research organisations
Requirements	residence or principal place of business within a EU Member State	residence or principal place of business within a EPC Contracting State having a language other than English, French or German as an official language, and nationals of that State who are resident abroad
Language of application	one of the official languages of EU that is not an official language of the EPO	official language of that EPC Contracting State
Amount	500 €	30% of the filing fee
Timing	together with the request for unitary effect	at the time of filing of the patent application



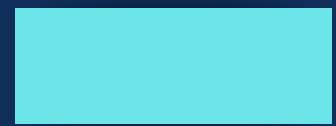
The request for unitary effect place of business

According to Art. 7 Regulation EU 1257/2012, a European Patent with unitary effect as an **object of property** shall be treated as a national patent of the participating Member State in which that patent has unitary effect and in which, according to the European Patent Register:

a) the applicant had his **residence or principal place of business** on the **date of filing** of the European Patent application; or

b) where point (a) does not apply, the applicant had a **place of business** on the **date of filing** of the European Patent application.

Where no applicant had his residence, principal place of business or place of business in a participating Member State in which that patent has unitary effect, the European patent with unitary effect as an **object of property** shall be treated as a **German national patent**.



The request for unitary effect place of business

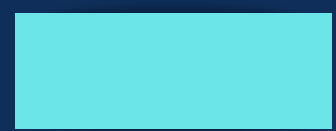
Where two or more persons are entered in the European Patent Register as **joint applicants**, point a) shall apply to the **joint applicant indicated first**.

Where this is not possible, point a) shall apply to the **next joint applicant indicated in the order of entry**.

Where point a) does not apply to any of the joint applicants, point b) shall apply to the **joint applicant indicated first**.

Where this is not possible, point b) shall apply to the **next joint applicant indicated in the order of entry**.

Where point b) does not apply to any of the joint applicants => **GERMAN LAW**



The request for unitary effect place of business

The Register for unitary patent protection (UPP) shall contain the following entries:

- information regarding a place of business of the applicant on the date of filing of the application for the European patent which may be provided by the proprietor of the European patent together with the request for unitary effect
- information regarding the residence or principal place of business of the applicant on the date of filing of the application for the European patent

The display of the place of business in the Register for unitary patent protection has no legal effect and is for information only.

Thank you

