



THE EUROPEAN PATENT WITH UNITARY EFFECT

The European patent with unitary effect (unitary patent) is about to be introduced. It is an optional protection, which can be obtained upon the grant of a European patent.

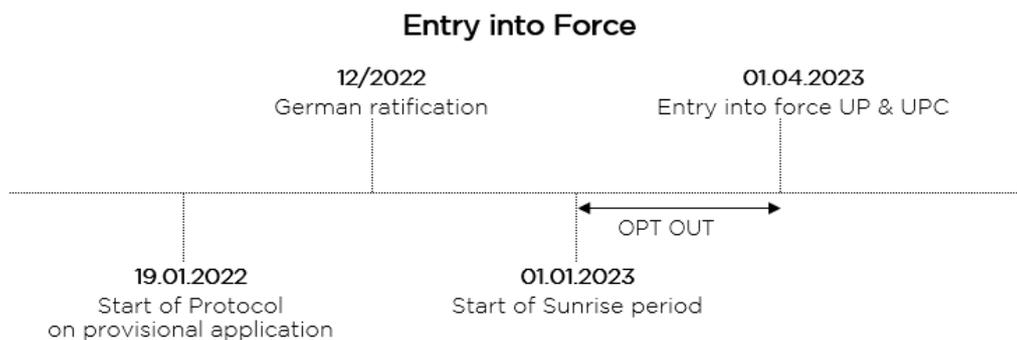
Legal framework

The unitary patent is created¹ by two EU regulations² issued in 2012, which were adopted through the route of enhanced cooperation between a number of “participating” EU member states (25 to date).

The application of the regulations depends on the entry into force of the Agreement on a Unified Patent Court (UPC) of 19 February 2013 which establishes a specialized patent jurisdiction with pan-European competence.

The protocol on provisional application of the UPC Agreement entered into force on 19 January 2022.

The regulations will enter into force on the first day of the 4th month after the ratification of the UPCA by Germany³.



A unitary patent

The unitary patent provides uniform protection and produces **identical effects** in all participating member states. It can only be limited, transferred, revoked or lapse in respect of all of them.

A single maintenance fee will be payable annually to the EPO (total cost less than €5000 over the first 10 years).

Territorial scope

Initially the unitary patent will cover the **17 countries**⁴ which have ratified the UPC Agreement: Austria, Belgium, Bulgaria, Germany, Denmark, Estonia, Finland, France, Italy, Lithuania, Latvia, Luxembourg, Malta, Netherlands, Portugal, Sweden and Slovenia.

Any participating member state (currently 25) can ratify and join the system. This does not affect the coverage of European patents for which unitary effect was previously registered.

¹ Under reinforced cooperation of the European Union between 25 participating member states

² Regulation No 1257/2012 and No. 1260/2012

³ In the graph we make the hypothesis of German ratification in December 2022.

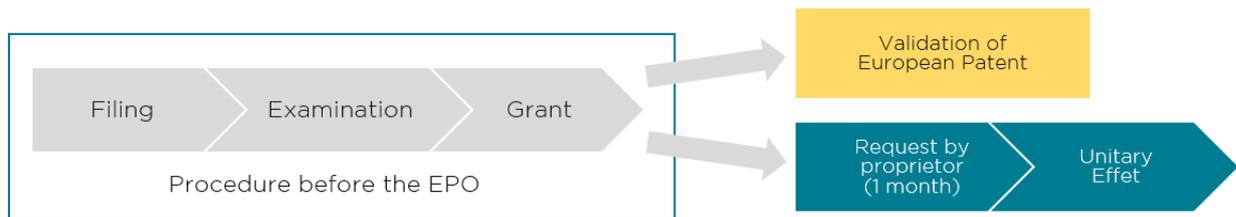
⁴ Status of ratification: <http://www.consilium.europa.eu/en/documents-publications/agreements-conventions/agreement/?aid=2013001>

Obtaining unitary effect

On grant of the European patent, the patent owner will have the choice between a unitary patent or classical validation⁵ of his patent in his countries of interest. The two protections coexist⁶.

The request for unitary effect must be submitted by the owner to the European Patent Office within one month of the mention of the publication of the grant of the European patent. No fee is required.

Unitary effect can only be obtained for a European patent filed on or after 01.03.2007, and which has the same set of claims for all participating member states.



Translations

The new system abolishes translations by relying on high quality machine translations.

For a transitional period of 6 to 12 years, an English translation will have to be provided if the patent is granted in French or German. If the patent is granted in English, a translation will have to be provided in another EU language.

Transitional measures

Two measures have been announced by the EPO. Upon ratification by Germany, it will be possible to:

- file an early request for unitary effect⁷; and
- delay the grant of the European patent⁸.

Opt-out

The UPC will have jurisdiction over European patent litigation in general. During a transitional period of 7 years, the owner of a patent (or application) will have the possibility to opt out from the exclusive jurisdiction of the UPC by notifying their opt-out to the Registry (except for unitary patents), so that litigation can be brought before a national court.

A sunrise period of 3 months will allow patentees to file their opt-outs in advance.

Practical considerations

The creation of the unitary patent and the UPC is imminent and will considerably change the European patent system.

It is time for patent holders to review their portfolios, and determine which applications will be validated by the classical route or transformed into a unitary patent. Questions of delaying the examination procedure and of the opt-out should be raised.

⁵ Validation is the only option in countries not covered by the unitary patent.

⁶ However there is no double protection. No validation in a country where unitary effect is registered.

⁷ <https://www.epo.org/law-practice/legal-texts/official-journal/2022/01/a6.html>

⁸ <https://www.epo.org/law-practice/legal-texts/official-journal/2022/01/a5.html>