

Patenting research outputs – the Unitary Patent and Unified Patent Court

Before making the leap into patent law as part of WP Thompson's chemical and life sciences team, Dr Ian Wilson worked and studied in academia for over a decade. In our continuing series, Ian investigates the key considerations for researchers as the European patent landscape receives its biggest overhaul in decades.

The status quo

As mentioned in our last article, inventors entering the national/regional phase of a patent filing strategy in Europe may choose to file a single patent application at the European Patent Office (EPO). The EPO facilitates centralised filing and prosecution of patent applications that applies to 38 countries, including all EU member states and the UK. Upon grant of their patent, applicants must request validation in each country in which protection is required. This system permits flexibility of jurisdiction of protection, and annual renewal fees permit flexibility of duration. However, the more extensive the protection sought, the more costly that protection becomes, leading many patentees to validate in only a handful of countries.

The Unitary Patent and the Unified Patent Court

Expected to become available in early 2023, the Unitary Patent (UP) will offer an alternative option following grant. Administered by the EPO, the UP will be a single patent that automatically applies across all participating EU countries, of which 17 are expected, initially. Effectively, this is a regional validation of the regional application, one requiring payment of a single renewal fee each year. Importantly, concurrent protection in all non-participating EPO member states can continue as normal with individual national validations.

Currently, nationally validated patents are enforced and litigated at the relevant national courts. However, upon the introduction of the UP system, both UPs and these nationally validated European patents will automatically be enforced and litigated before the upcoming Unified Patent Court (UPC). Helpfully, for at least a seven-year transition period, it will still be possible for owners of nationally validated European patents to opt-out of the UPC's jurisdiction and to have infringement and revocation proceedings conducted before the relevant national courts instead. Post-Brexit, UPs will not be enforceable in the UK, but they can still be granted to UK applicants and represented at the UPC by UK European patent attorneys.

Risks and Rewards

As an alternative to the traditional national validation route, UPs will offer inventors more choice in how they pursue patent protection. They will also offer potentially large financial savings. The UP pricing scheme – including validation and annual renewal fees – is set to be more cost-effective than the traditional route if protection is sought in at least four countries.

Of course, as is often the case, such financial rewards come with potentially significant risks. Via the traditional route, a third party wishing to challenge a patent must do so in each individual validated country. Conversely, to challenge a UP, they will need only file a single action at the UPC to potentially destroy that patent's protection in all 17 participating states. Inventors will therefore soon need to weigh up the risks to their flagship intellectual property rights against the beneficial cost savings of a UP.

Although the ability for a single court action to so widely destroy patent protection is seen as a risk, the UPC is an unknown quantity. At the time of writing no judges have been appointed, so we can infer nothing of individual inclinations that may influence future decisions. Further, common law applied to rulings is based on previous similar cases in relevant courts, meaning established legal systems have a wealth of legal precedent upon which to draw. As an entirely new court, the UPC need not be bound by existing decisions, and has a chance to set its own precedents – an exciting prospect but one that means any action before the UPC comes with potentially unpredictable consequences.

Watch this space

Although in development for decades, the unitary patent system looks like it will finally be with us next year. Presenting an exciting mix of potential risks and rewards, it is worth inventors knowing about the UP and UPC in the early stages of developing their invention, in order to be better prepared and better informed when it comes time to answer the question, to UP or not to UP?

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