

Is centralised European patent protection and enforcement coming at last?

The answer is probably! After years of uncertainty, both the Unitary Patent (UP) and the Unified Patent Court (UPC) could be live from as early as October 2022. These new systems will centralise patent protection and enforcement within many EU countries.

The possibility of centralised patent protection and enforcement might make the European (EP) patent system more attractive to some. Moreover, the new systems will impact all existing granted EP patents and pending EP applications, such that patent proprietors will need to make strategic decisions in relation to their EP patent portfolio.

The Unitary Patent

Currently patents granted by the European Patent Office (EPO) must be validated in all of the countries in which the patent proprietor wants to obtain patents. Although the patents are granted centrally by the EPO, the validation procedure yields a number of individual patents in the countries of interest. These individual patents must then be enforced and/or invalidated individually at the national courts.

The UP will, for the first time, offer patent proprietors the option to have a single patent covering multiple EU member states (17 at the time of writing, likely to be more in the future) as an alternative to the current validation route in different countries (which will continue). Some key features of the UP are:

- provides protection in Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, and Sweden (at the time of writing)
- requires payment of a single renewal fee
- must meet new translation requirements
- falls under the jurisdiction of the UPC
- requires limitation, transfer, revocation, or lapse in all UP member states

Is a UP an option?

To file a request for a UP, the EP patent must:

- have the same claims for each UP member state; and
- have and retain designations for all UP member states

Requirements and timing of UP request

A request for a UP must be filed within one month of the date of grant of an EP patent. During a transition period, the patent proprietor will be required to file appropriate translations. For example if the patent is in English, a translation into any other EU language will be required.

For currently pending EP patent applications where a UP is desired upon grant, there are ways to delay grant in order to keep the option of a UP open.

Jurisdiction of the UPC

The UPC is a new centralised court through which:

- a patent proprietor can enforce their EP patent against an infringer; and
- a third party can seek central revocation of an EP patent

Decisions by the UPC will be effective in all UPC member states. Infringement and revocation decisions for non-UPC countries (such as the UK, Spain, Norway, and Switzerland) will continue to be made by the national courts.

The UPC brings unknown opportunities and risks and so there will be a transitional period of at least seven years to provide better certainty for users.

Transitional Period

During transition, the national courts of UPC member states will also have jurisdiction over EP patents which are effective in these countries. A patent proprietor will be able to choose between centralised patent enforcement before the UPC or enforcement in individual national courts. Similarly, a third party can choose whether to revoke a patent before the UPC or a national court.

During transition, a patent proprietor can also request an opt out to remove their EP patents from the jurisdiction of the UPC. The patent proprietor can withdraw this request at a later stage, for example, if they wish to initiate a pan-European infringement action. The period for requesting an opt out may begin as early as July 2022 and so it is advisable to begin preparing now.

Ownership may need to be verified before requesting an opt out because the true owner(s) must file the request.

There are numerous factors to consider when deciding whether to request a UP and whether to opt out existing EP patents from the jurisdiction of the UPC. Different decisions may be appropriate for different patents in a portfolio.

For more information on the UP and the UPC, contact Kate Hickinson, Partner, Appleyard Lees.