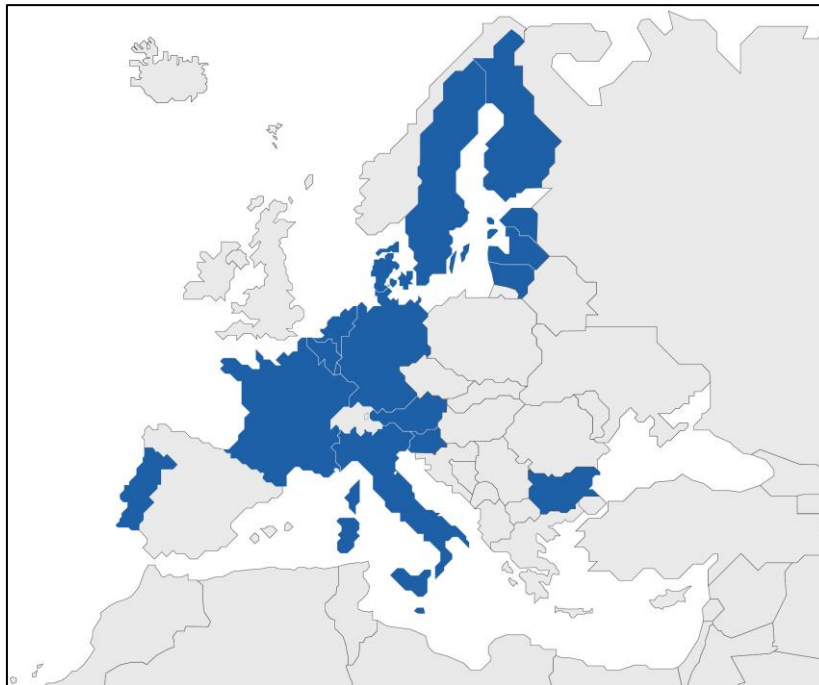


## Last ratification of the Unified Patent Court Agreement

**On February 17<sup>th</sup>, 2023, the last country, Germany, ratified the Unified Patent Court Agreement (UPCA). This ratification automatically triggers the effective entry into force of the UPCA as of June 1<sup>st</sup>, 2023 and simultaneously opens the way on the same date to the grant of Unitary patents.**

The Unified Patent Court (UPC) will have exclusive jurisdiction to determine the infringement and validity of European patents and Unitary patents: the UPC will replace the national courts for ruling on the infringement and validity of European patents.

The UPC's decisions will be directly enforceable in the entire territory of all of the 17 European Contracting Member States.



### ➤ The organization of the Unified Patent Court (UPC)

The UPC will comprise a decentralized first instance court and a centralized court of appeal.

The first instance court will be composed of:

- local divisions (one or more in most of the Contracting Member States)
- one regional division for Sweden and the Baltic countries
- a central division having its seat in Paris and a section in Munich for certain technical fields.

The central division in Paris will rule upon patent validity issues in the fields of transportation, textile, construction, physics, electricity, electronics and telecommunications.

The Munich section will handle issues of validity for patents in the mechanical field.

Cases involving patents in the fields of healthcare, chemistry and metallurgy will initially be allocated partly in Paris and partly in Munich. A political agreement may in the future allow the creation of another section in Milan (Italy) for handling some of those cases.

## Last ratification of the Unified Patent Court Agreement

### ➤ The Judges

#### ○ Local and regional divisions

The panels of the local and regional divisions will consist of three legally qualified judges of different nationalities. A fourth judge with a technical background can be added to the composition of the panel at the request of either party or at the panel's initiative.

#### ○ Central division

The panels of the central division will consist of two legally qualified judges and one technically qualified judge of different nationalities.

#### ○ Court of Appeal

The panels of the Court of Appeal will consist of five judges, two of whom will have a technical training and three a legal training.

### ➤ The language of the procedure

The language of the procedure will normally be the national language of the country where the local division is seated. Alternatively, however, a country may decide that its local division may use English, French or German as the language of the proceedings.

On request of one of the parties and after hearing the other party, the panel may decide to adopt the language in which the patent was granted. If the panel refuses the unanimous choice of the parties for such a language of proceedings, the entire case may be referred to the central division.

Before the central division, the language of the procedure is the language in which the patent was issued, that is to say, English, French or German.

On appeal, the language of the procedure is the language used in the first instance. However, the parties may agree to use the language in which the patent was granted.

### ➤ Competence of the Unified Patent Court (UPC)

The UPC has exclusive competence for European patents and Unitary patents regarding:

- Infringement actions
- Actions for declaration of non-infringement
- Provisional measures (preliminary injunctions)
- Orders for obtaining and preserving evidence
- Permanent injunctions and determination of damages.

The UPC has also exclusive competence regarding :

- Revocation actions
- Counterclaims for revocation.

## Last ratification of the Unified Patent Court Agreement

### ➤ The choice of the appropriate division of the first instance

#### ○ Infringement actions

Infringement proceedings may be brought before a local or regional division located in a Member State in whose territory an act of infringement was committed (jurisdiction based on the place of infringement). If that Member State does not host a local division (for example Luxemburg), infringement proceedings can be brought before the central division.

The action can also be brought before a local or regional division located in a Member State in whose territory one of the defendants is domiciled (jurisdiction based on the place of domicile of the defendant). Again, if that Member State does not host a local division, infringement proceedings can be brought before the central division.

Infringement proceedings can also be brought before the central division if one of the defendants is domiciled outside the territory of the Contracting Member States. This can for instance be the case if an alleged infringing product is being imported into the territory of the Contracting Member States from the asian or american countries as well as Switzerland, UK or Spain, European countries that are not part of the UPC Agreement.

#### ○ Actions for revocation

Direct actions for revocation of a European patent or a Unitary patent must be brought before the Central division.

In case of a counterclaim for revocation, presented as a defense during an infringement action brought before a local or regional division, the panel of the local or regional division has the choice between three options:

- it may decide to handle both issues of infringement and validity of the patent, in which case it must appoint a fourth judge who is technically qualified in the field of the patent in question;
- it can refer the question of validity of the patent to the central division and either decide without delay on the issue of infringement, or stay the proceedings pending the decision of the central division. This procedure is called "bifurcation";
- it may, with the agreement of the parties, refer the whole case (infringement and validity) to the central division.

### ➤ How to establish evidence of patent infringement?

The UPC may issue an order to preserve evidence, allowing an independent person to carry out an inspection *in situ* to perform a detailed description of an alleged infringing product or method, with or without the taking of samples and seize any document relating to the manufacture and distribution of the products.

Such an order can be obtained even before engaging the action on the merits and, under certain conditions, without hearing the other party. Appropriate measures may be provided to ensure the confidentiality of information gathered during this operation.

This procedure is similar to the infringement-seizure procedure that is widely used in France for obtaining evidence of an alleged patent infringement.

The UPC may also, upon request of a party, order the other party to produce additional evidence in its possession.

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### ➤ The first instance procedure

The proceedings in the first instance comprise three phases:

- a written procedure during which the parties exchange arguments, facts and evidence to sustain their requests. Each party has the opportunity to file only three written submissions (a first submission, a response and a rejoinder), the defendant having the final word. The deadlines imposed by the court are very short (1-3 months) and not easily extendable.
- an interim procedure during which a judge rapporteur may convene the parties to at least one conference to determine the main issues under debate, to clarify the position of the parties, to order, if relevant, technical experiments or the production of new evidence, to hold preparatory discussions with potential witnesses or experts and, in general, to prepare the oral hearing.
- an oral hearing during which the parties may present their technical and legal arguments. It is expected that this oral hearing will last a maximum of one day, except in exceptional cases. Experts appointed by the parties or by the court as well as witnesses may be heard during the hearing but only if their written statements or reports require explanation.

The entire procedure in the first instance should have a duration of approximately one year.

### ➤ Provisional measures

It is possible to request an expedited decision for preliminary injunction to stop an alleged infringement of a patent, even before engaging the proceedings on the merits and, in some cases, without hearing the other party.

A third party that fears having a preliminary injunction imposed without a contradictory hearing may file, at the UPC Registry, a protective letter stating the name of the person who may require a preliminary injunction and the number of the patent. The letter may set forth arguments against a claim for infringement and challenging the patentability of the invention claimed in the patent. This letter (which is valid only 6 months) will be subsequently transmitted by the UPC Registry to the first instance division before which a request for preliminary injunction has been filed.

### ➤ Transitional provisions

During a transitional period of 7 years, it will be possible to choose either the UPC or the national courts.

In addition, during the transitional period, it is possible to register, for a specific European patent application or a specific European patent, a declaration (opt-out) that only national courts shall be competent for this European patent application or European patent, during the entire life of the patent. This opt out may be withdrawn at any time under certain conditions.

### ➤ Representation

The parties must be represented in the procedures before the UPC by a lawyer authorized to practice before the courts of one of the Contracting Member States or by a European patent litigator (a European patent attorney with special qualification).

At CASALONGA, one of the few European IP boutique firm with both lawyers and patent attorneys, you will be represented by a team combining the technical knowledge and experience in EPO opposition procedures of our European patent attorneys with the legal and court experience of our patent lawyers.

## Last ratification of the Unified Patent Court Agreement

### ➤ Members of the CASALONGA patent teams

- **Patent lawyers:**
  - Arnaud Casalonga
  - Caroline Casalonga
  - Marianne Gabriel
  - Jean-Baptiste Lecoer (also qualified as a European patent attorney)
  - Floriane Codevelle
  - Pascaline Vincent
  
- **European patent litigators:**
  - Francis Zapalowicz
  - Olivier Delprat
  - Jürgen Neugebauer
  - Virginie Martin-Charbonneau
  - Julien Thon
  - Gwennaël Le Roy
  - Patricia Ledrut

Please do not hesitate to contact us if you have any questions about the UPC, the Unitary patent or the implementation of this new system.

Our teams also provide training on all these subjects.

To easily navigate through the UPC texts, do not hesitate to use our “Interactive Code” ([www.upc-casalonga.eu](http://www.upc-casalonga.eu)), accessible via a simple registration process in the three official languages of the texts ([English](#), [French](#) and [German](#)).

Before deciding to choose a Unitary patent, consult our [UPP application](#) “fees comparator”, which can be accessed directly via our website [under this link](#) and is available on [Google Play](#) and [Apple Store](#).



**PARIS:** 31 rue de Fleurus, 75006 Paris, France  
Tel. +33 (0)1 45 61 94 64 – [paris@casalonga.com](mailto:paris@casalonga.com)

**MUNICH:** Bayerstrasse 71/73, 80335 Munich, Germany  
Tel. +49 (0)89 22 30 05 – [munich@casalonga.de](mailto:munich@casalonga.de)