

Unitary patent: Are you ready?

The unitary patent and the Unified Patent Court (UPC) will soon complete the current patent protection system in Europe. At last!

The entry into force of the unitary patent and the Unified Patent Court (UPC) is currently planned for June 1st, 2023.

The unitary patent will offer its users a more cost-effective protection with the same legal effect in all the participating EU Member States.

The UPC will be able to rule centrally and in a harmonized manner on the validity and infringement of patents in Europe. Further, it will have exclusive jurisdiction to decide on the validity and infringement of unitary patents.

➤ How to obtain a unitary patent?

The unitary patent is in fact a European patent, examined and granted by the European Patent Office (EPO), but which has identical protection and the same legal effect in all EU Member States that ratified the UPC agreement. If it is invalidated or assigned, this is for all states at the same time.

The unitary patent is granted by the EPO according to the usual examination procedure for European patents.

The proprietor may apply for a unitary patent within one month (not extendable) after the date of publication of the mention of the grant of the European patent.

For a unitary patent, it is not necessary to translate all or part of the granted patent into different national languages. For the time being, and for a transitional period of 6 years (renewable once), it is only necessary to provide a translation of the patent in one language (in English if it is written in French or German or in any language of the European Union if it is written in English). The text of the translation has no legal effect.

At the end of this transitional period, no further translations will be required.

Given the unitary nature of the patent, however, the choice of a unitary patent is only possible if the claims are the same for all participating EU Member States. If an unpublished national prior right exists and requires more limited claims for that country, only a classic European patent can be obtained. Furthermore, if this national prior right is discovered later, the unitary patent will be invalidated.

It should be noted that, since September 1st, 2022, the EPO carries out a supplementary search, at the end of the patent examination procedure, which is intended to reveal possible prior national rights. This is particularly useful if the unitary patent route is envisaged.

An opposition can be filed against a unitary patent within nine months of the date of publication of the mention of grant, as for a classic European patent. The unitary patent can thus be revoked by the EPO.

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➤ Which countries does the unitary patent cover?

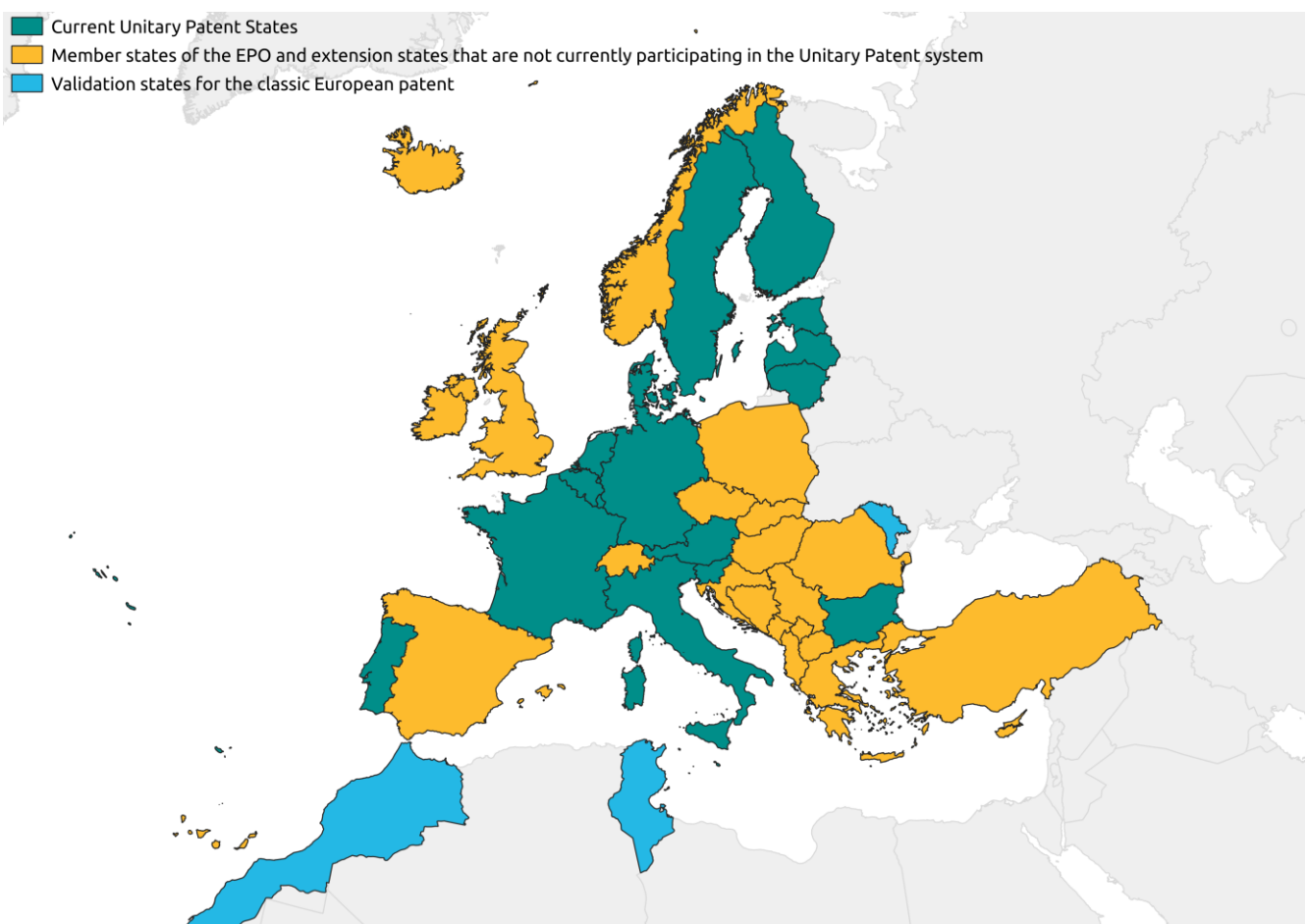
Unitary patent protection will initially be possible in the 17 EU states that have already ratified the UPC Agreement, namely: Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Portugal, Slovenia and Sweden.

Spain, Croatia and Poland have decided, for the time being, not to participate while Cyprus, Greece, Hungary, Ireland, the Czech Republic, Romania and Slovakia have decided to remain outside the unitary patent.

Countries outside the EU, such as the UK or Switzerland, cannot be covered by the unitary patent.

For greater territorial coverage, it will be possible to combine the unitary patent with a classic European patent in order to protect states outside the EU (e.g. the United Kingdom or Switzerland) or EU states not participating in the unitary patent system.

Finally, of course, the choice of a unitary patent is only an option: it is always possible to choose a classic European patent validated in several countries or several national patents.



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➤ What are the costs of the unitary patent?

No official fee is charged by the EPO for the application for a unitary patent.

As mentioned above, post-grant translation costs are reduced compared to the validation of a classic European patent, with only one translation required during a transitional period, and no translations required in the long run.

In addition, a single annual fee is required for the maintenance of the unitary patent, which is payable directly to the EPO.

This simplifies the administrative management of patent portfolio renewals with a centralized procedure and only one deadline to monitor per unitary patent.

The amount of this annual fee has been set at an attractive level for companies validating their European patents today in at least three or four countries, since its amount corresponds to the sum of the annual fees that were applied in 2015 in France, Germany, the United Kingdom and the Netherlands.

It is possible to compare the costs of annual fees for a unitary patent and for a European patent according to the countries of interest to be protected by means of the [UPP application](#) designed by Casalonga, which can be accessed directly via our website [under this link](#) and is available on [Google Play](#) and [Apple Store](#).

When comparing costs between a unitary patent and a European patent, it is also important to compare post-grant translation costs and to keep in mind that the territorial scope obtained with a unitary patent will always be much broader.

➤ Entry into force planned for June 1st, 2023

For the unitary patent to be operational, it is imperative that UPC be in force, as it is the only judicial body competent to judge the validity and infringement of this title.

The technical, administrative and infrastructural preparations to set up the UPC, and thus the unitary patent, have now entered their final phase.

The entry into force of the unitary patent and the UPC is currently planned for June 1st, 2023.

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➤ Transitional measures usable from January 1st, 2023 until May 31st, 2023

A unitary patent may be applied for in respect of any European patent granted on or after the date of entry into force of the UPC Agreement.

However, the EPO has decided to put in place transitional measures to allow the use of the unitary patent before the entry into force of this new system, for patent applications that are being considered for grant, i.e. applications for which a notification under Rule 71(3) EPC has been received.

Indeed, from a date that is scheduled to be January 1st, 2023, it will be possible, only for those patent applications for which a communication under Rule 71(3) EPC has been received, to file:

- a) an early request for unitary effect, and/or
- b) a request for a delay in issuing the decision to grant a European patent.

○ Early request for unitary effect

In the case of a request for anticipated unitary effect, the applicant will have to submit a request and provide a complete translation of the European patent (in English for a patent in French or German; in any language of the European Union for a patent in English).

The early request for unitary effect may be filed at the same time as the agreement on the text in response to the communication under Rule 71(3) EPC. It should even be possible to file an early request for unitary effect after the time limit period for responding to this communication in view of the examples presented on the EPO website.

If all requirements are met (request, translation and set of claims), the EPO will register the unitary effect that will be effective as soon as the unitary patent enters into force.

It is worth noting that, if the EPO finds formal irregularities, it will be possible to remedy them before the unitary patent comes into force.

An early request for unitary effect does not delay the grant decision. It is therefore preferable to also request the postponement of the grant decision.

○ Postponement of the grant decision

The applicant may also request a postponement of the grant decision, but only if it has not yet responded to the communication under Rule 71(3) EPC by giving his agreement to the text.

The EPO will postpone the decision to grant the European patent so that the mention of the grant is published on or immediately after the coming into force of the unitary patent.

The applicant will then have the opportunity to file a request for unitary effect one month after the publication of the mention of grant, if it wishes.

It is important to note that this second transitional measure is only of interest for European applications which, without it, would have been granted before the entry into force of the unitary patent and would therefore not have been able to benefit from it.

It should also be noted that the postponement of the grant decision does not affect the 4-month time limit for responding to the communication under Rule 71(3) EPC.

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- **How can I benefit from the transitional measures for patent applications for which the deadline to answer to the grant communication according to Rule 71(3) EPC expires before January 1st, 2023?**

The transitional measures put in place by the EPO will only be available from January 1st, 2023 until May 31st, 2023.

If one wishes to benefit from these transitional measures for patent applications for which a communication under Rule 71(3) EPC has already been received with a deadline expiring before January 1st, 2023, it is possible to make corrections on the text that the EPO intends to grant, so that a new communication is issued.

With this option, however, the examination procedure could be reopened and therefore lead to a further search by the EPO or a change of opinion by the Examining Division, even if this remains very theoretical.

Another option to benefit from the transitional measures for these patent applications is not to answer to the grant communication according to Rule 71(3) EPC and to wait for the issuance of a loss of rights communication to answer.

This second option will require, however, the payment of the applicable fee for further processing (275 EUR).

- **Double protection between unitary patent and French or German patent protection**

It will be possible for the same owner to have a double protection between the unitary patent and the corresponding French patent.

To maintain both titles, it will of course be necessary to pay both the annual maintenance fees for the French patent and the unitary patent, which increases the costs. In order to rationalize these costs, a decision should therefore be made on a case-by-case basis.

Germany has also changed its national law to allow double patenting by a unitary patent and an identical German patent for the same owner.

Do not hesitate to contact us for any further information, and in particular to define together the strategy to be implemented for the patents in your portfolio.



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