

The Unitary Patent era is about to begin: what to expect?

Marisol Cardoso, Patent Consultant at Inventa, informs us of the expectations for the implementation of the Unitary Patent across the EU member states with crucial advice for filing.

In December 2012, the European countries and the European Parliament agreed on a legislative initiative that laid the ground for the creation of the unitary patent protection in the European Union (EU). Now, the implementation of a much simpler and less expensive European patent system is highly expected for the second half of 2022.

The Unitary Patents will allow inventors (individuals, companies, universities, and research organizations) to obtain uniform patent protection across all participating EU member states by submitting a single application to the European Patent Office (EPO), which will be searched and examined under the rules of the European Patent Convention (EPC).

As regards infringement and validity issues, the Unified Patent Court (UPC) will offer a single, specialized patent jurisdiction in all Member States that have ratified the Agreement on a Unified Patent Court (UPC Agreement), therefore, ending the need for litigation in different countries.



Marisol Cardoso

“**The Applicant must first obtain a European patent. Once granted, the patent owner must file a “request for unitary effect”.**”

Résumé

Marisol Cardoso

Marisol Cardoso is a Patent Consultant at Inventa, with complete and dynamic knowledge of the entire process involving patents (prior art searches, patent drafting, patent filing, and responses to actions of patent offices), in the pharmaceutical and biotechnology sectors.

Email: mcardoso@inventa.com

EU regulations on the Unitary Patent

The two EU regulations nos. 1257/2012 and 1260/2012 establish the Unitary Patent system and entered into force on 20 January 2013. However, the Unitary Patent system is inextricably linked to the creation of the UPC, and the EU regulations will only apply as from the date of entry into force of the UPC Agreement.

The UPC Agreement was signed as an intergovernmental treaty in February 2013 by 25 states (all EU member states except Spain, Poland, and Croatia). However, for it to enter into force, one last condition must be satisfied: the three EU states with the most European patents in effect in 2012 must ratify the Agreement - and Germany still have not deposited its instrument of ratification.

It is expected that Germany will wait until the UPC administration is in operation (at this moment, the UPC is in a provisional application phase) and the Unitary Patent will, then, enter into force on the first day of the fourth month counted after the deposit of the German's instrument.

Meanwhile, all EU member states (except Croatia and Spain) are participating in the enhanced co-operation on the Unitary Patent protection.

Secondary legislations related to the establishment of a Unitary Patent Division at the EPO, the fees and methods of payment thereof, the compensation for translation costs, and management of the income and costs related to Unitary Patents further implement the Unitary Patent protection system.

The Unitary Patent framework

The Unitary Patent will be based on a European patent granted by EPO, on or after the date of entry into force of the UPC Agreement, under



the rules and the procedures of the EPC. Therefore, the pre-grant procedures, such as the high standards of search and examination applied to the European patents granted by the EPO, will be maintained.

Therefore, before a Unitary Patent can be registered by the EPO, the Applicant must first obtain a European patent. Once granted, the patent owner must file a "request for unitary effect" (free of charge) preferably online at the EPO platform to obtain a Unitary Patent.

To be eligible, the European patent must have been granted with the same set of claims in respect of all the participating Member States and the request must be filed no later than one month after the date of publication of the mention of the grant in the European Patent Bulletin. The Unitary Patents will only be registered if the requirements are fulfilled.

The EPO will provide a new Register for Unitary Patent Protection with all relevant legal status information related to licensing, transfer, limitation, revocation, and lapse of the Unitary Patent.

Coverage

When the UPC Agreement enters into force, the Unitary Patents will cover the member states which have already deposited their instrument of ratification. Up to the moment, the 17 member states which will participate in the Unitary Patent when it starts are: Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia and Sweden.

It is expected that outstanding ratifications take place successively for the members participating in the enhanced co-operation, namely, Cyprus,

Czech Republic, Greece, Hungary, Ireland, Poland, Romania and Slovakia.

Spain decided not to join the Unitary Patent system because of discrepancies with the linguistic regime adopted and the doubts about legal certainty raised by the system. As regards Croatia, the country joined the EU in 2013, i.e., after the UPC Agreement was signed and its entrance in the system is expected to occur shortly.

Therefore, Unitary Patents with different territorial coverage are likely to occur, and such coverage will remain the same for the entire patent lifetime, irrespective of any subsequent ratifications of the UPC Agreement after the date of registration of the unitary effect.

Transitional period

In the moment the Unitary Patent system enters into force, two transitional measures are predicted for the European patent applications which have reached the final phase of the grant procedure.

The first transitional measure will enable Applicants to file early requests for unitary effect already before the start of the Unitary Patent system, i.e., as soon as Germany deposits its instrument of ratification of the UPC Agreement.

In this case, the unitary effect will be registered when the Unitary Patent system starts, provided that all corresponding requirements for registration are met. Otherwise, EPO will invite the patent owner to correct deficiencies, if applicable, or reject the request. A communication concerning the result of the request for unitary effect will be issued a few days after the publication of the mention of the grant of the European patent in the European Patent Bulletin.

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The second transitional measure will provide the possibility for the Applicant to request a delay in issuing the decision to grant a European patent by the Office and before approving the text intended for grant. Since the Unitary Patent protection can only be requested to European patents granted by EPO on or after the date of entry into force of the UPC Agreement, this measure will make it possible to postpone the granting date of the European patent to make it eligible for Unitary Patent protection.

The EPO will allow requests for a delay in issuing the grant as of the date Germany deposits its instrument of ratification of the UPC Agreement and until the start date of the Unitary Patent system. The request will only be considered valid if the Applicant has not yet approved the text intended for grant.

As regards litigation involving "classic" European patents, for a transitional period of seven years (which can be extended to up to seven more years), actions for infringement or for revocation may still be brought before national courts and the patent owner will be able to opt-out of the UPC's jurisdiction for the entire lifetime of the patent.

Such possibility, however, is not available for Unitary Patents.

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**Thus, there
will be
only one
procedure,
one
currency
(euros),
and one
deadline to
be met.**
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Today, an inventor can protect an invention in Europe via a direct filing in the country of interest (national patent application using the Paris Convention) or via a regional filing in EPO (European patent).

Even though EPO examines applications for European patents centrally, granted European patents must be validated and maintained individually in each country where they take effect, in a complex and costly process.

One of the major benefits of the Unitary Patents is that the national validation processes will be no longer needed, since all post-grant administration will be handled by the EPO, further reducing costs and the administrative workload.

As regards translations, the official languages accepted by EPO are English, French and German. After a transitional period of six years (which can be extended up to 12 years), no translations will be needed when opting for a Unitary Patent.

During the transitional period, a full translation of the European patent is required to be filed, together with the request for unitary effect, in the following cases:

- If the language of the proceedings before the EPO was French or German,



a full translation of the European patent into English is required.

- If the language of the proceedings before the EPO was English, a full translation of the European patent into any other official language of an EU member state is required.

However, the translation is for information only and has no legal effect.

Also, a compensation scheme will cover the costs of translating the application in the pre-grant phase for EU-based SMEs, natural persons, non-profit organizations, universities and public research organizations, when the European patent application or Euro-PCT application leading to the Unitary Patent was filed in an official EU language other than English, French or German. The request for compensation must be filed together with the request for unitary effect.

As regards costs, the Unitary Patent owners will pay one single (and cost attractive) renewal fee to the EPO without the need of a representative. Thus, there will be only one procedure, one currency (euros), and one deadline to be met.

As regards infringement and validity issues, the UPC will have exclusive competence in the contracting member states in respect of European patents with unitary effect. This centralized legal area will be particularly advantageous to patent owners when there is a need to enforce a patent in different European countries by allowing greater objectivity.

Cons

Despite the fact that the Unitary Patent system provides a user-friendly, simpler, and cheaper way to protect inventions, patent experts and large enterprises point out some weaknesses that need to be considered.

The first point addresses to the fact that all the search and examination processes will be performed under the rules and the procedures of the EPC. EPO practice is known to be strict on the assessment of a patent application and, to be admissible by the EPO, the EPO rules and guidelines must be followed rigorously.

A second point relates to the fact that, in countries where the mother language is not an official language of the EPO, Unitary Patents would not need to be translated to produce effects.

Since patent applications contain detailed technical information on all fields of technology and are considered a valuable source of specific knowledge, not translating the patent document would raise doubts on whether interested parties would benefit from the disclosures thereof.



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Lastly, as regards proceedings before the UPC, patent owners must also accept the risk of losing the protection in all states at the same time in case the Unitary Patent is successfully challenged.

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The linguistic regime is also called into question when it relates to invalidity and non-infringement declaratory proceedings before the UPC. Local companies would have to bear the costs of the relevant translations to guarantee that there is no infringement of rights and, in case it is forced to plead, the proceedings will take place in English, French or German, even if the company is sued for infringement locally.

Lastly, as regards proceedings before the UPC, patent owners must also accept the risk of losing the protection in all states at the same time in case the Unitary Patent is successfully challenged.

Contact

Inventa

Alameda dos Oceanos 41K-21,
Parque das Nações
1990-207 Lisbon, Portugal

Tel: (+351) 213 150 970
info@inventa.com
www.inventa.com