

Action Required - Unitary Patent Package to start 1 June 2023

The long-awaited Unitary Patent package consists of:

- a Unitary Patent (UP) that will offer geographical coverage of the European Union (EU) member countries that have ratified the Unitary Patent Agreement. Applicants can obtain the UP by filing a request at the EPO, following grant of their European patent, that their patent have unitary effect; and
- a Unified Patent Court (UPC) that will provide a centralised forum for the litigation of not only the new Unitary Patents, but also “conventional” European patents, in the participating member countries unless ‘opted out’.

The Unitary Patent package will come into force on 1 June 2023. The system will increase options available for the geographical extent of patent coverage in Europe from European patent applications.

Unitary patent protection can be requested **only** for a European patent granted on or after the date on which the Unitary Patent Regulation comes into force.

Those readers who are familiar with the Unitary Patent package can skip to page 3 of this document – “[Do your clients want to take part in the new system?](#)” – to see the questions that you should now be putting to your clients. For those who require a short recap of the new system, see the sections below.

What is a Unitary Patent (UP)?

The UP is obtained through the EPO, with the prosecution process (i.e., up to grant) being the same as the current process for obtaining a European patent.

If a UP is required, then a request for unitary effect of a European patent must be filed within one month of grant. It has to be requested by the proprietor(s) (*via* their EP representatives) and it is essential to ensure that ownership is up-to-date on the EPO patent register (e.g., check for any assignments that have not been notified to the EP representative – they will need to act to record the transfer on the EPO Patent Register to ensure that the patent is in the correct name).

What is the Unified Patent Court (UPC)?

The UPC is a new European Union (EU) initiated trans-national court system for the determination of questions concerning validity and enforcement of patents (including SPCs derived therefrom) established under the European Patent Convention and also the possibility to determine other matters concerning applications for such patents.

When will the Unitary Patent package happen?

The Unitary Patent package will come into force on **1 June 2023**. The opt-out ‘sunrise’ period began on **1 March 2023**.

Warning!

EP patents that would have fallen under the jurisdiction of national courts and treated in the “classic manner”, **will now automatically fall under the jurisdiction of the UPC unless they are “opted-out” of the UPC system**. That is, national courts and the UPC effectively share jurisdiction over EP

patents until an action is started in either a national court, or the UPC. At this point, the national court, or UPC will have exclusive jurisdiction over the action. **EP applications may fall under the non-exclusive jurisdiction of the UPC system for certain matters unless opted-out.**

Opt-out

EP applications and patents can be **opted out of the new UPC system**, which, as explained below, **should be done as soon as possible** and we recommend that consideration of the merits of the system and the decision on whether to opt-out or not is made promptly.

Experience and confidence

Many UPC judges will have been judges in patent cases in their national courts. Others will have recently completed role-specific training to prepare them for the UPC. We shall have to wait until the court is active to see how a balanced and effective court is achieved in practice.

Effect of the UPC

Decisions of the UPC court will be effective automatically in all participating states. The trans-national nature of the UPC is different from conventional national litigation routes where respective national patent rights, including nationally validated EP patents, are litigated on a case-by-case basis before national courts and the decisions of those courts only have direct effect in each country. In summary, the UPC is an “all eggs in one basket” approach.

Who will be in the UPC?

Initially, the UPC will cover at least 17 of the member states of the European Union (“participating states”¹), including major jurisdictions such as France, Germany, Italy and the Netherlands. The UK is not participating and so the existing national validation procedure will apply when obtaining protection in the UK, as it will in other non-participating EU Member states, such as Spain and Poland, and other non-EU Member states, such as Norway and Turkey. However, all European Patent Attorneys, including UK nationals, will have rights of audience.

Opt-out sooner rather than later?

It will be possible to opt-out of the UPC once the UPC is up-and-running (provided proceedings at the UPC have not been initiated in relation to the patent). However, there will also be a three-month ‘sunrise’ period (which began on 1 March 2023) prior to the start of the UPC when existing EP patents and applications can be opted out of the system so that they will not fall under the jurisdiction of the UPC. It will **not be possible to opt-out** a patent application or patent of the UPC **if any UPC proceedings have been commenced** in respect of that application or patent. Once the UPC starts, a proprietor will be at risk of being trapped in the UPC system against their will. It is therefore **imperative that consideration is given to opting-out patent applications (from their publication) and patents (including SPCs) as soon as possible so that opt-out requests may be made in the sunrise period or as soon as possible thereafter.**

Delays to registering opt-out

A request for opt-out will not take effect until it has been entered on the Register, rather than it taking effect on the date on which the request has been filed. Experience in registering assignments, etc. at the EPO and the like suggests it may take weeks rather than days for a request to be registered and, of course, it is to be expected that there will be a glut of opt-out requests filed toward the end of the sunrise period.

¹ Austria, Belgium, Bulgaria, Germany, Denmark, Estonia, Finland, France, Italy, Lithuania, Luxembourg, Latvia, Montenegro, the Netherlands, Portugal, Sweden and Slovenia

Do your clients want to take part in the new system?

There are two considerations that should be borne in mind:

- Do applicants/proprietors want their existing EP patents/applications to fall under the jurisdiction of the UPC – an untried and untested new court – or do they want to maintain the *status quo*, i.e., issues relating to the patent/application are heard by the national courts in the countries in which the patent/application has effect?

- If the answer is that they want EP patents/applications to be under the jurisdiction of the UPC:

no action is required.

- If the answer is that they do not want EP patents/applications to be under the jurisdiction of the UPC:

a request to opt-out of the jurisdiction of the UPC must be filed. This can be done at any time during the life of the patent/application, unless proceedings against the application/patent have already been initiated at the UPC. The opt-out can also be filed during the ‘sunrise’ period. It would be prudent to file the opt-out request during the ‘sunrise’ period, if possible. See [Annex A](#) for our charges for filing opt-out requests.

- EP applications approaching grant at the EPO – do applicants want to request a Unitary Patent, once the EPO grants the patent?

- If the answer is no:

“validation” in the countries of interest would take place in the conventional manner.

We can attend to this in the usual way.

- If the answer is yes:

a request for unitary effect should be filed at the EPO within **one month** of the grant date of the patent. Additionally, within the same period, a human translation of the entire specification into English (or another EU language if the patent specification is in English) must be filed.

We can attend to this alongside any “validations” for countries that are selected, but which are not taking part in the UP. Our charge for filing a request for unitary effect at the EPO is **£150**. A translation cost will also be applicable, but this will vary on a case-by-case basis.

Please contact upcoptout@wpt.co.uk to provide instructions to opt-out of the UPC or with any questions concerning the opt-out process, the UPC or Unitary Patent.

Annex A

Costs for WP Thompson attending to requesting opt-out from the Unified Patent Court Agreement System

Information required for opt-out procedure

Instructions to opt-out one or more patents² under the following process shall be understood as confirmation of the consent of the current proprietor/s or applicant/s as appropriate to notifying an opt-out in accordance with Art. 83 of the Unified Patent Court Agreement. For the avoidance of doubt, an opt-out notification mandate must be completed to avoid delay in registration of the opt-out notification. The opt-out notification mandate must be executed by the or each current proprietor of the patent/s regardless of whether a change of proprietor has previously been registered on the EPO register. Where WP Thompson are not already authorised representatives for one or more patents an appointment of agent is required. For convenience a partially completed template opt-out notification mandate ([Annex B](#)) is annexed hereto.³

Requesting opt-out for cases currently represented by WP Thompson

Instructions received no later than one month from expiry of the sunrise period – i.e., before 1 May 2023, based on the start date of 1 June 2023 – £20 for a first patent, £13 per patent for each of the 2nd to 5th patents from the same proprietor, £7 per patent for each of the 6th to 10th patents from the same proprietor and £4 per patent for the 11th and subsequent patents from the same proprietor.

Instructions received less than one month before expiry of sunrise period, or after expiry of sunrise period – i.e., after 1 May 2023, based on the start date of 1 June 2023 – £40 for a first patent, £25 per patent for each of the 2nd to 5th patents from the same proprietor, £13 per patent for each of the 6th to 10th patents from the same proprietor and £7 per patent for the 11th and subsequent patents from the same proprietor.

Requesting opt-out for cases transferred to WP Thompson

Instructions received no later than one month from expiry of the sunrise period – i.e., before 1 May 2023, based on the start date of 1 June 2023 – £40 for a first patent, £25 per patent for each of the 2nd to 5th patents from the same proprietor, £13 per patent for each of the 6th to 10th patents from the same proprietor and £7 per patent for the 11th and subsequent patents from the same proprietor.

Instructions received less than one month before expiry of sunrise period, or after expiry of sunrise period – i.e., after 1 May 2023, based on the start date of 1 June 2023 – £80 for a first patent, £50 per patent for each of the 2nd to 5th patents from the same proprietor, £25 per patent for each of the 6th to 10th patents from the same proprietor and £13 per patent for the 11th and subsequent patents from the same proprietor.

² The term “patent” or the like includes a reference to a patent application or supplementary protection certificate

³ Please provide a list of titles, application numbers or patent numbers of rights to be opted-out for inclusion on supplementary sheet. There should be one mandate for each group of proprietors.

Annex B

Template Opt-out Notification Mandate

Please complete the opt-out notification mandate, on the next page, and return a copy to us.

Please add the patent (publication) number for each case that is to be opted-out, and also the proprietor/applicant name. Please also include details of any supplementary protection certificates that are to be opted-out.

For individuals, please have the proprietor/applicant add their name and position under the "Authorised by:" heading. Please also have them sign and date the mandate.

For companies, please have an authorised signatory, e.g. CEO, President, etc., complete their details and sign on behalf of the company.

Mandate for lodging an Application to opt out / to withdraw an opt-out / to correct an opt-out / to correct a withdrawal of an opt-out pursuant to Rule 5.3(b)(ii) of the Rules of Procedure (RoP)

List each patent/application number:

Patent / Application number	Proprietor/Applicant pursuant to Rule 8.5

List each granted supplementary protection certificate (SPC):

SPC ID	Country	Holders	Patent number

The following persons are authorised to lodge an Application to

- opt out
- withdraw an opt-out
- correct an opt-out
- correct a withdrawal of an opt-out

in respect of the applications/patents/SPCs referred to above on behalf of the above-mentioned applicants/proprietors/holders.

Persons authorised:

Name	Position/Firm
GILL, David Alan	European Patent Attorney/WP Thompson (Association No. 105)
POTTER, Julian Mark	European Patent Attorney/WP Thompson (Association No. 105)
McKINNON, Alistair James	European Patent Attorney/WP Thompson (Association No. 105)
FORREST, Stuart	European Patent Attorney/WP Thompson (Association No. 105)
TURP, Sarah Ann	European Patent Attorney/WP Thompson (Association No. 105)
LEONG, Chee Yeow	European Patent Attorney/WP Thompson (Association No. 105)
ENGLAND, Matthew William	European Patent Attorney/WP Thompson (Association No. 105)
MULLHOLLAND, Lewis Paul	European Patent Attorney/WP Thompson (Association No. 105)

Authorised by:

Name	Position	Signature	Date
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