



## Unitary patent system

13 June 2013

Mark Richardson  
Keltie LLP

IPcopy blog: [ipcopy.wordpress.com](http://ipcopy.wordpress.com)  
Twitter: @KeltieLLP

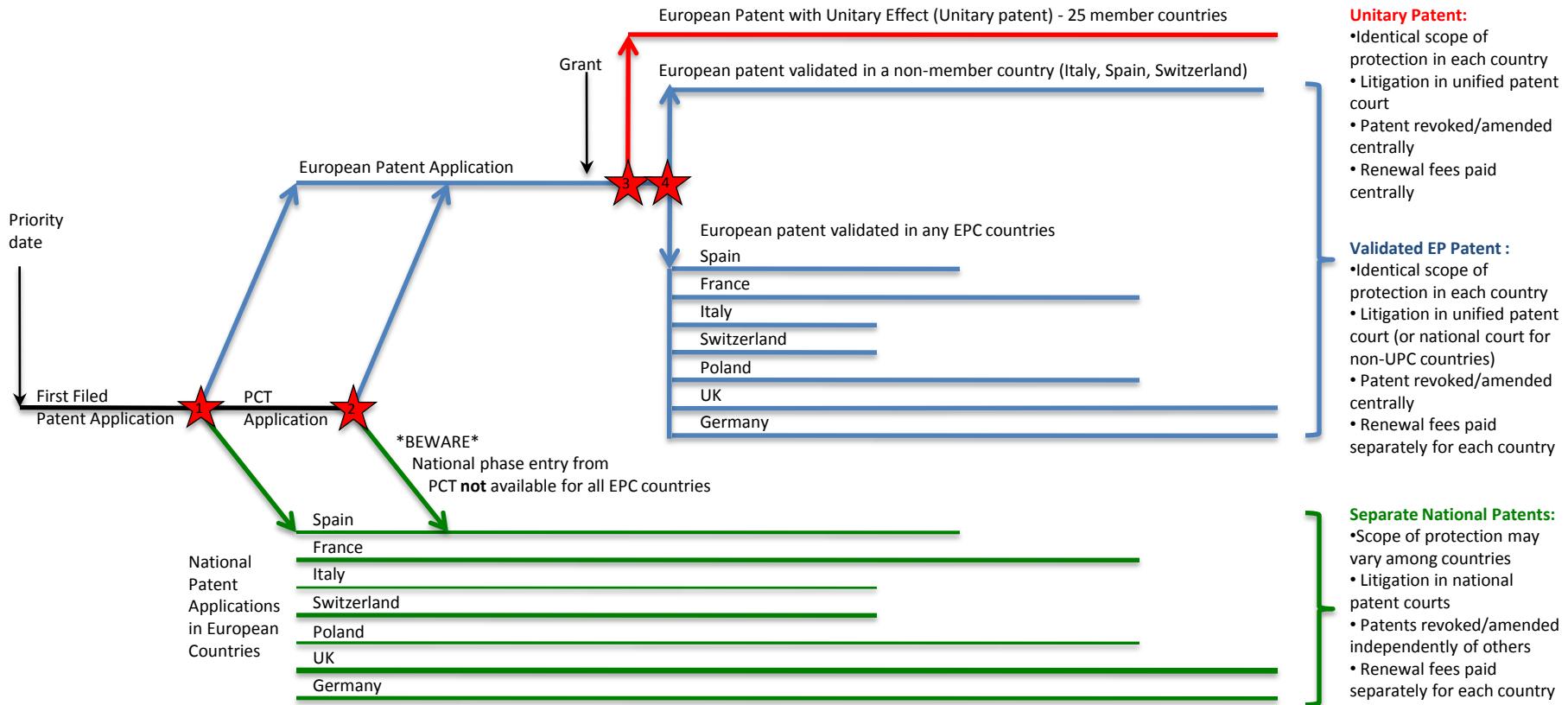


Image from Mindmatrix (Wikimedia) under Creative Commons licence

# How to get a unitary patent

- Based on current European patent application process
- Handled by EPO
- Current procedure is patent grant followed by validation in EPC territories of choice within 3 months of grant
- New procedure is the same plus an additional option of UP validation within 1 month of grant

# The European Patent with Unitary Effect – Obtaining patent protection in European countries



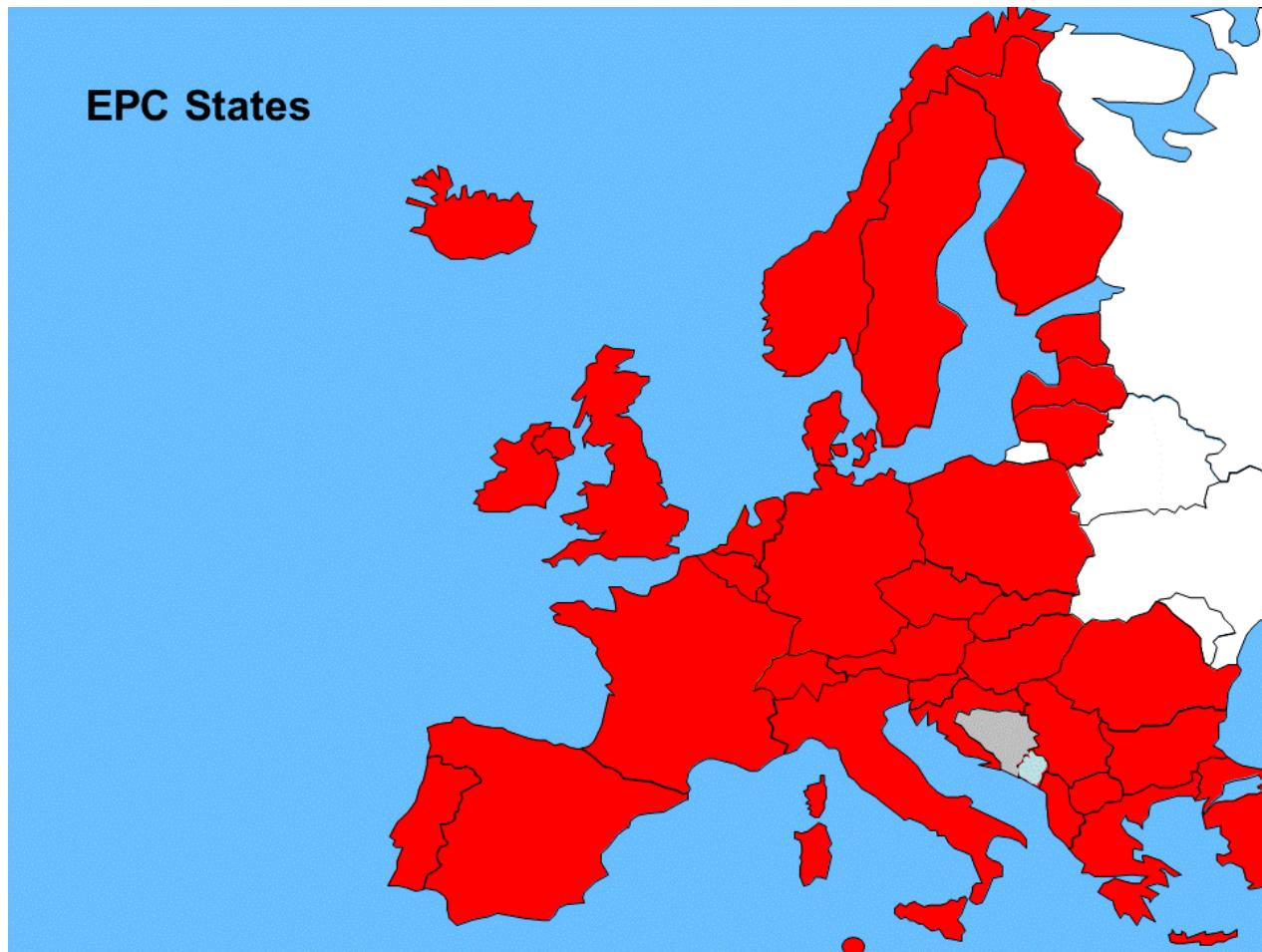
## Decision time...

- 1 **12 months from priority date:** Choose among a PCT application, a European patent application, separate national applications in European countries, or a combination of the above. NB if separate national applications are required, note that national-phase entry from a PCT application is not possible for all European countries (e.g. France, Ireland, Netherlands, Belgium, Greece, Italy). If national patents are required, a PCT application may not be the best strategy.
- 2 **30/31 months from priority date:** National/Regional phase entry of PCT application, if filed. Options are a European regional-phase patent application, and/or separate national-phase patent applications in European countries where allowable.
- 3 **Within one month of grant of a European patent:** Choose between a European patent with unitary effect (EU patent) or national validation in the EPC-contracting countries of your choice. NB the EU patent has effect in the 25 member countries.
- 4 **Within three months of grant of a European patent:** Select countries for validation. If an EU patent **was not** selected at stage 3, the patent must be validated in your selected countries. If an EU patent **was** selected at stage 3, this is the opportunity to obtain protection in non-member countries (e.g. Spain, Italy, Switzerland) by validating in those countries.

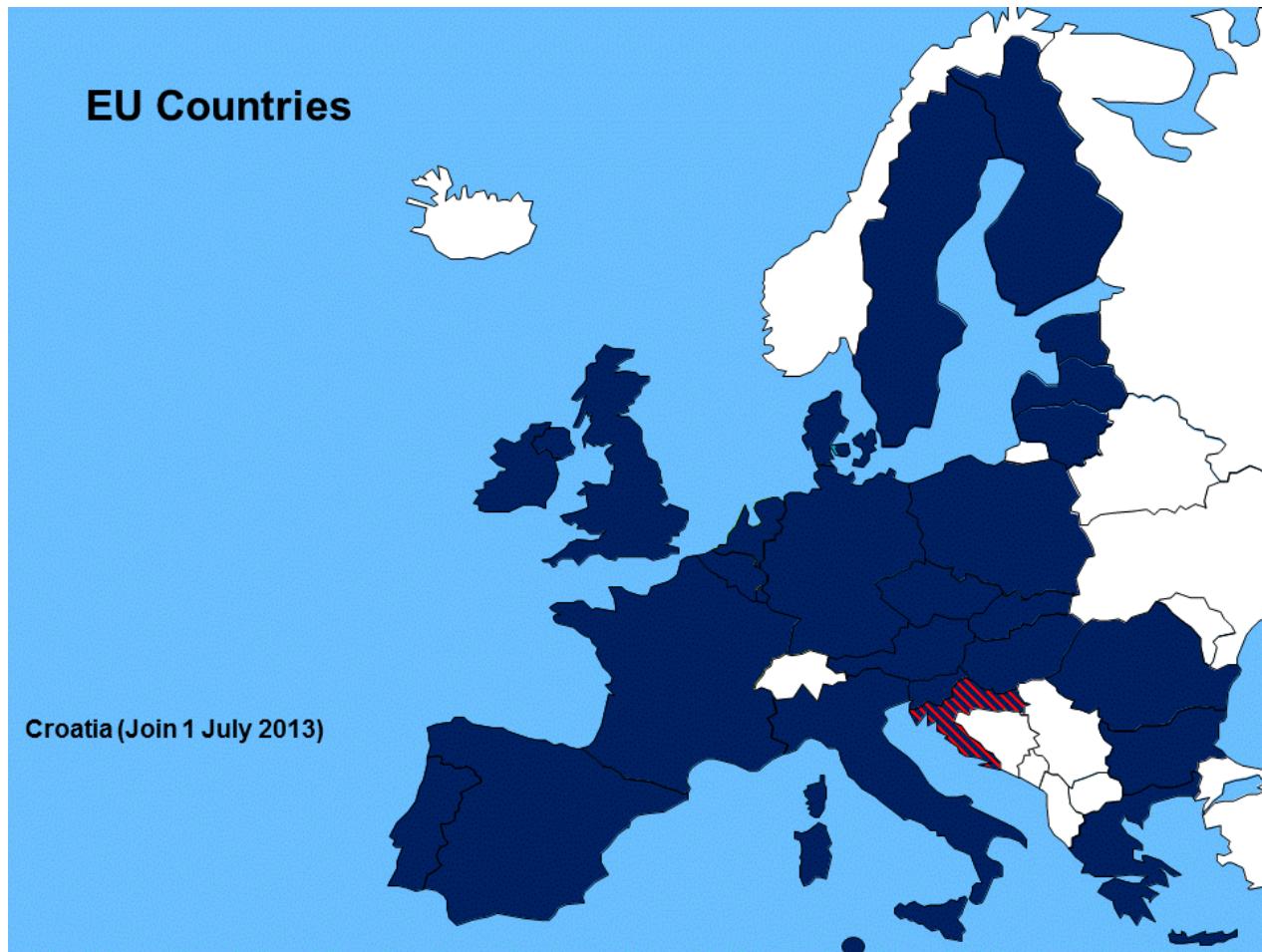
# Territorial Coverage of UP

- Two regulations cover 25 EU states (out of current 27)
- Agreement on unified patent court (signed by *slightly different* 25 EU states)
- Ratification of agreement governs territorial scope of unitary patents

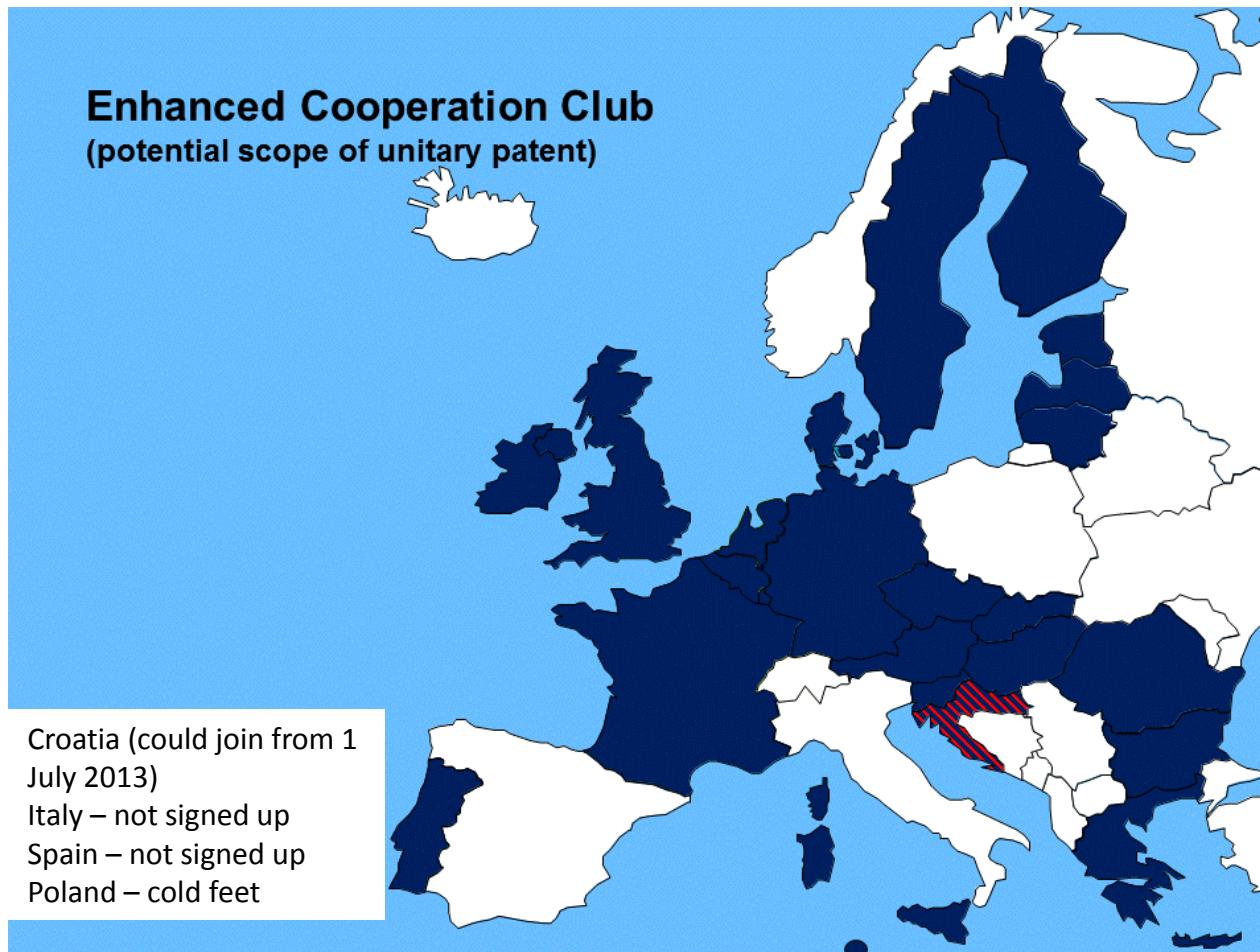
# Territorial Coverage



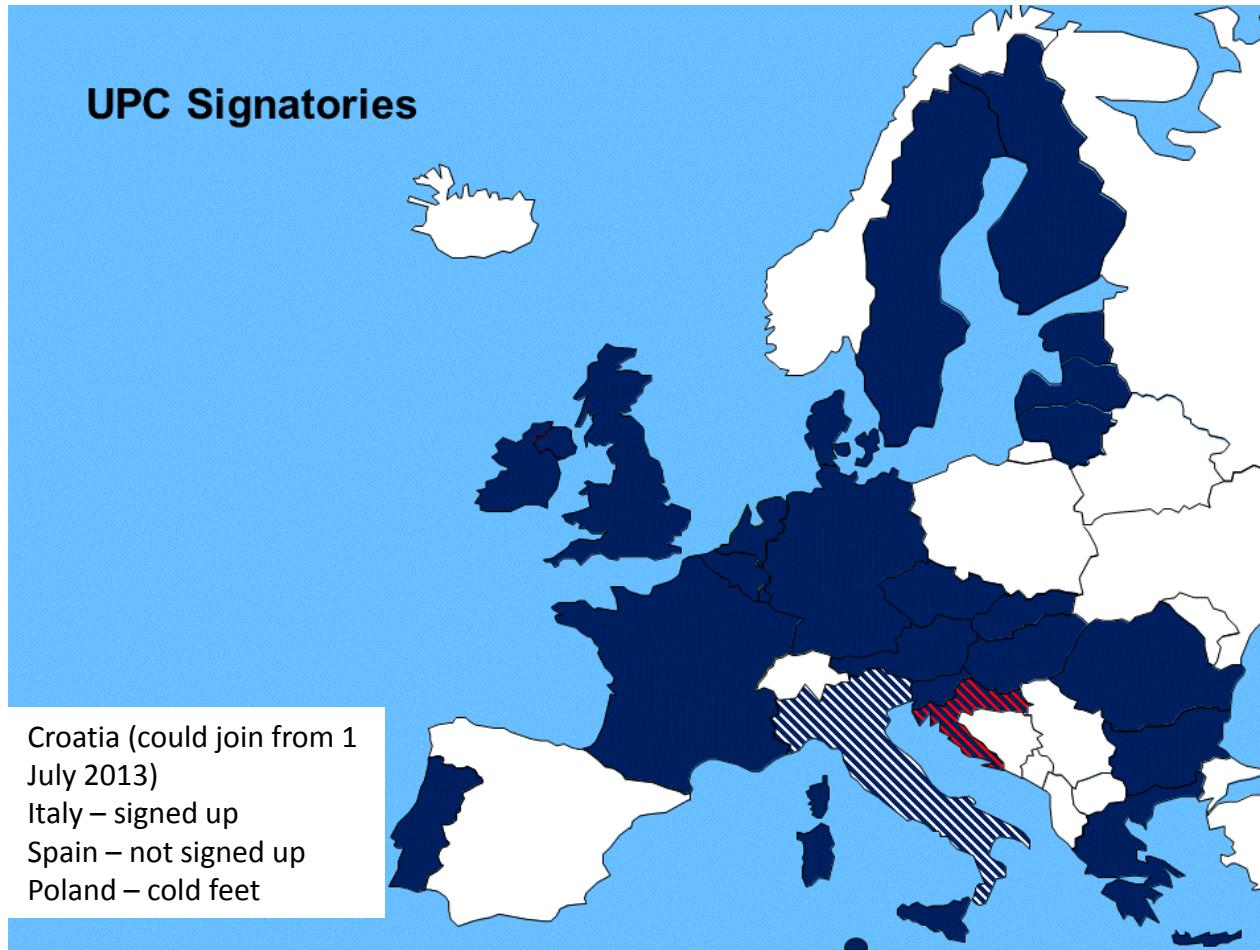
# Territorial Coverage



# Territorial Coverage

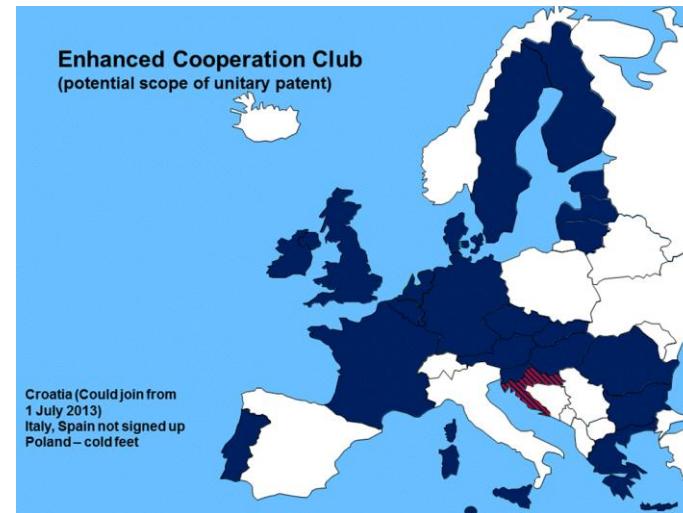
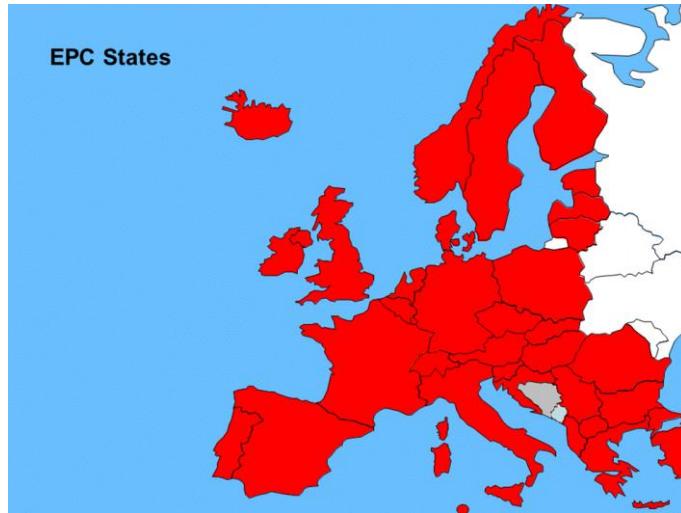


# Territorial Coverage



# Territorial Coverage

- Likely to change over time
- Mix of UP and EP needed?



# Territorial Coverage of UP

- Potentially only 12 countries at start
- Up to 24 countries could sign up (IT, ES, PL currently sitting out)
- Croatia to join after 1 July?
- IT to join?
- Mix of “classical” EP and UP or “classical” EP only?

# Costs

- Up to grant – expected to be unchanged
- Post grant now have extra options – EP validated in countries of choice and/or UP
- New fees to consider
  - Unitary patent “validation” fee?
  - Unitary patent renewal fees (full & SME levels)
  - Validated EP – opt-out fee from UPC & “opt-in” fee back into UPC!
- So, what will these fees be?

# Costs



# Costs

- Fees are subject to negotiation at present
- Much speculation about likely levels but no firm data at this point
- Could opt-out fee level determine whether national patents become more attractive?  
(will opt-out be an “admin” fee or will it try to cover lost court costs?)

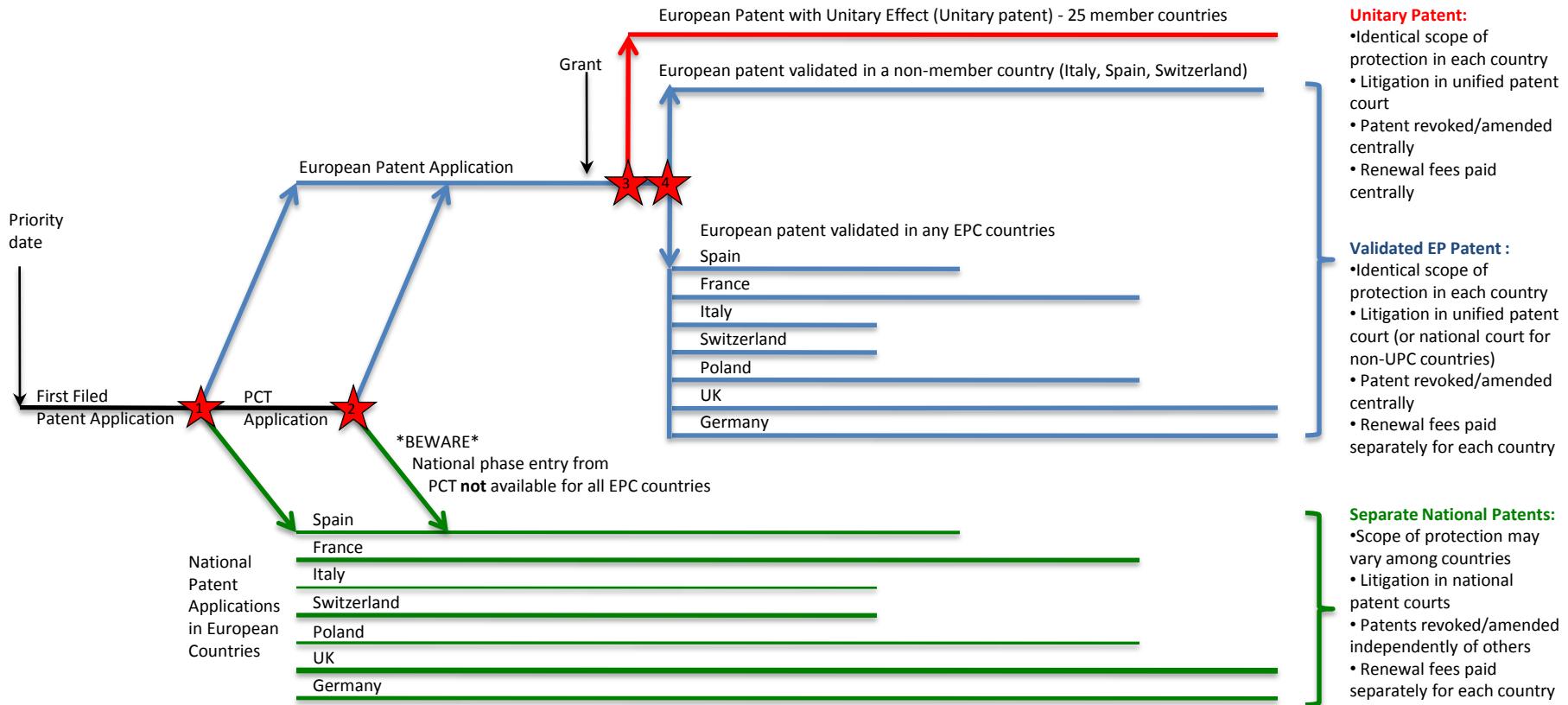
# UPs vs EPs vs National (1)

- Unitary patent – Pros
  - Unified Patent Court
  - Wide territorial coverage via one patent – one fee, greatly reduced translation burden
- Unitary patent – Cons
  - Unified Patent Court
  - One patent vulnerable to single attack

# UPs vs EPs vs National (2)

- Alternatives?
- “Traditional” EPs validated in countries of choice
  - Consider UPC opt-out during transitional period (avoids single attack issue; “tried & tested” courts)
  - Allows portfolio management via dropping of EP validations to reduce renewal payments
- National patents (either direct or via PCT)
  - Beware EPC countries that do not allow filing from PCT national phase (*Belgium, Cyprus, France, Greece, Ireland, Latvia, Malta, the Netherlands, Slovenia*)

# The European Patent with Unitary Effect – Obtaining patent protection in European countries



## Unitary Patent:

- Identical scope of protection in each country
- Litigation in unified patent court
- Patent revoked/amended centrally
- Renewal fees paid centrally

## Validated EP Patent :

- Identical scope of protection in each country
- Litigation in unified patent court (or national court for non-UPC countries)
- Patent revoked/amended centrally
- Renewal fees paid separately for each country

## Separate National Patents:

- Scope of protection may vary among countries
- Litigation in national patent courts
- Patents revoked/amended independently of others
- Renewal fees paid separately for each country

## Decision time...

**1** **12 months from priority date:** Choose among a PCT application, a European patent application, separate national applications in European countries, or a combination of the above. NB if separate national applications are required, note that national-phase entry from a PCT application is not possible for all European countries (e.g. France, Ireland, Netherlands, Belgium, Greece, Italy). If national patents are required, a PCT application may not be the best strategy.

**2** **30/31 months from priority date:** National/Regional phase entry of PCT application, if filed. Options are a European regional-phase patent application, and/or separate national-phase patent applications in European countries where allowable.

**3** **Within one month of grant of a European patent:** Choose between a European patent with unitary effect (EU patent) or national validation in the EPC-contracting countries of your choice. NB the EU patent has effect in the 25 member countries.

**4** **Within three months of grant of a European patent:** Select countries for validation. If an EU patent **was not** selected at stage 3, the patent must be validated in your selected countries. If an EU patent **was** selected at stage 3, this is the opportunity to obtain protection in non-member countries (e.g. Spain, Italy, Switzerland) by validating in those countries.

# Odd one out round



# Translation Provisions

- No translation requirements *after transitional period of up to 12 years*. “High quality” machine translations
- During transitional period – if in English need to translate into any other EU language (inc. Spanish); if in German/French need to translate into English

# What do I need to do now?

- Keep track of UP developments via your legal representative
- Consider portfolio review
- Consider your position on the UPC (opt-out?)
- Assess fees for UP versus your normal filing arrangements (when fees publish!)
- Consider slowing down current EP applications to take advantage of new system