

PATENT ALERT

Unitary Patent System in Europe – What happens now?

The Unitary Patent (UP) system and the Unified Patent Court (UPC) takes effect from 1 June 2023. This also marks the commencement of a transitional period within which the UP system runs in parallel with the existing European patent system involving national validations. European (EP) Patents validated in the 17 participating member states (Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Portugal, Slovenia, Sweden), and which have not opted out of the UPC, will be subjected to a dual jurisdiction arrangement – i.e the current jurisdiction of the respective national courts, and the jurisdiction of the UPC.

Cyprus, Czech Republic, Greece, Hungary, Ireland, Romania, and Slovakia will become participating member states upon ratifying the Agreement on a Unified Patent Court (UPCA) in due course.

It is important to note that the territorial scope of the UP is fixed at the time of the UP registration for the entire patent term and the addition of new member states later is not retroactive.

The transitional period will run for at least seven (7) years, and up to fourteen (14) years, at the end of which only the UP system would be applicable to the participating member states. This is aimed at establishing a uniform approach for granting, defending and enforcing EP patents in the various participating member states.

Obtaining an EP patent with unitary effect (UP)

- The existing centralised grant and opposition procedures at the European Patent Office (EPO) will remain unchanged.
- For an EP patent granted on or after 1 June 2023 (during the transitional period), the applicant/patentee can choose to proceed with either:-
 - national validation(s) of the EP patent (via the existing European patent system) generally within 3 months from the grant date of the EP patent; or
 - a UP within 1 month from the grant date of the EP patent, with optional national validation(s) of the EP patent in non-participating member states (Spain, Croatia, Poland, Iceland, Norway, Turkey, Switzerland, Serbia, Albania, Macedonia, and the United Kingdom) generally within 3 months from the grant date of the EP patent.
- If applying for a UP during the transitional period, translation of the patent specification into one other EU official language is required to be submitted along with the UP request. After the transitional period, no translation would need to be submitted as machine translations will be adopted.
- In order to meet the tight timeline and requirements for applying the UP, it would be advisable to start preparing the necessary documents shortly after the issuance of the Communication pursuant to Rule 71(3) EPC (i.e. an intention to grant communication) and before responding to this Communication by paying the print and grant fee for the EP patent application.

Treating a UP as a national patent

Proprietary aspects (e.g. ownership, licence) of the UP will be governed by one national legal system determined by the applicant at the filing date and will remain the same regardless of any subsequent dealings in the UP.

For a single applicant, the UP will be governed by the national legal system of the residence or principal place of business of the applicant within the participating member states as at the filing date. German law applies otherwise.

For joint applicants, the UP will be governed by the national legal system of the residence or principal place of business of the first listed applicant within the participating member states as at the filing date, if not in a participating member state, the next listed applicant will determine the national law defaulting to German law if none meets the criteria.

If you have any queries, please do not hesitate to contact us.



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A single renewal fee of a UP will be payable annually to keep the UP in force for a subsequent year. The renewal fees of a UP is expected to be lower in costs compared to paying renewals in at least 4 participating member states.

A UP provides a larger territorial scope of protection and market than existing national validations. However, it will not be possible to selectively renew the patent in selected UP participating member states later.

Unified Patent Court (UPC)

- The Unitary Patent system provides centralised post-grant infringement and revocation proceedings before the UPC for the participating member states.
- A pending EP patent application and an EP patent can be opted out of the UPC any time until one (1) month before the end of the transitional period, provided that no proceedings have been brought before the UPC for that EP patent. Currently, there is no official fee for opting out of the UPC.
- One consideration on whether to opt out of the UPC is the likelihood of a third party infringing an EP patent and a third party seeking to revoke the EP patent. If the likelihood of infringement is high, then it may be in the patentee's interests to litigate in the UPC. On the other hand, if the likelihood of revocation is high, then it may be in the patentee's interest to opt out to prevent the EP patent being revoked centrally.
- Opting out of the UPC is effective for the life of the patent and affects the whole EP patent bundle (not possible to opt out from selected participating member states). The patentee/applicant can withdraw the opt out (i.e. by opting back in) later to commence central infringement proceedings before the UPC, if national court proceedings have not been initiated, but cannot opt out of the UPC a second time.
- During the transitional period, the patentee can choose to bring infringement proceedings before the UPC, provided that the EP patent has not opted out of the UPC and there are no proceedings before the relevant national courts. Note: It is not possible to assert one patent against the same defendant for the same infringing act in the UPC and in parallel in a national court of a participating member state. However, it is possible to use (for example) different patents from one portfolio against the same defendant for the same infringing act in the UPC and in a national court.
- During the transitional period, a third party can choose to bring revocation proceedings in relation to an EP patent before the UPC, provided that the EP patent has not opted out of the UPC, and there are no proceedings before the relevant national courts.
- A UP cannot opt-out of the UPC.