

The Unitary Patent

What is the Unitary Patent?

- When it comes into effect, the Unitary Patent (UP) will be a single patent that will be enforceable across a large number of European countries. The UP will be available for most European applications filed on or after 1 March 2020 and granted as patents on or after the entry into force of UPC Agreement.
- The UPC Agreement is likely to enter into force in the second half of 2022 or early 2023.
- The first UPs will extend to at least 16 countries with the number of countries available likely increasing over time.

Why should I consider Unitary Patent protection?

- It might be cheaper than validating separate patents in each of the European countries covered by the UP: The renewal fees (“annuities”) payable to keep a UP in force will also be cheaper than paying the equivalent national office renewal fees. The renewal fees for a UP have been set at a level equivalent to the renewal fees of about four nationally- validated patents, so if you currently validate in four or more European countries, the UP should be cheaper.
- It might be simpler: Using UPs may simplify your EP portfolio and strategy. Managing a single UP that covers most European countries will be simpler than keeping track of multiple separate national patents. The UP also avoids the need for parallel litigation actions between the same parties in the national courts.
- It might provide broader European protection: Although the UP does not cover every European country, a UP will give most patentees broader patent coverage across Europe for a similar cost to what they are currently paying to validate the patent in three or four European countries.

Why might I decide not to pursue Unitary Patent protection?

- A UP does not cover all European countries: While the number of countries covered by a UP is likely to increase for patents that grant later, a UP is not expected to cover some significant European countries any time soon. For example, a UP will not extend to the UK (due to Brexit), Spain, Switzerland, Norway, Poland, Turkey, Croatia or Serbia in the near future. National validations will still need to be pursued for these countries.
- It might not be cheaper: If you currently validate your EPs in three or fewer UPC member states, a UP will be more expensive. Furthermore, the level at which the renewal fees amount has been set will be reviewed over time and may increase significantly. However, it may still be worth considering a UP because of the broader territorial scope of protection for the small additional cost.
- Inability to prune states to reduce later renewal fees: It is a common strategy for patentees who proactively manage their European portfolios to reduce the number of European countries for which they pay renewal fees as the renewal fees become expensive towards the end of the lifetime of the patents. The UP is a unitary right with a single renewal fee. Payment of the full amount of the renewal fee for the UP renews the UP for all territories for the following year. If the full amount of the renewal fee is not paid, the whole UP lapses.
- No partial assignment: The UP is a unitary right, so it is not possible to assign parts of the UP to another owner. In particular, it is not possible to assign the rights for different countries separately. For example, a patentee cannot assign the rights in the German part of the UP whilst retaining rights across the rest of Europe. However, licenses under the UP can cover only a portion of the territory covered by the UP.

- No conversion into national patents: Once a UP has been obtained, it is not possible to divide it or convert it to national patents. It stands or falls only as a single entity.
- Litigation only at the UPC: The only court that has jurisdiction over UPs is the UPC. All court actions, including those relating to infringement and invalidity, must be brought in front of the UPC. While the Court is expected to be of a similar quality to other patent courts across Europe, it is currently somewhat of an unknown quantity. Although “classical” nationally-validated EPs will also fall under the jurisdiction of the UPC by default, it will be possible to opt these out of the jurisdiction of the UPC (at least for an initial seven year transitional period). UPs cannot be opted out of the UPC.
- A UP may be revoked in a single action: As a unitary right, a single successful revocation action will be sufficient to revoke the whole UP (and also a “classical” nationally-validated EP that has not been opted out of the UPC).
- Request validation as a UP: A single request for validation as a UP must be filed at the EPO within one month of grant of the EP. A translation of the whole patent specification into one other official language of the European Union is required. At present, the rule is that if the case was prosecuted in English, any other official European Union language is sufficient. If the case was prosecuted in French or German, the translation must be into English.
- If you are also pursuing national validations in a country that requires a full translation (e.g. ES), you could use this translation for the UP validation.

Can I still obtain a European patent covering the UK after Brexit?

- While the UK is no longer part of the UPC agreement and a UP will thus not cover the UK, EU membership is not a requirement for a country to be part of the EPO. Therefore, it will remain possible to apply for and obtain patents at the EPO and for those patents to be validated as classical UK nationally-validated patents after Brexit.

How do I get a Unitary Patent?

- Obtain a granted patent from the EPO: The process of filing and prosecuting a European patent application and getting it granted by the EPO will remain exactly the same. UK based attorneys can still represent you before the EPO and can request a UP on your behalf.
- Determine whether your patent is eligible for validation as a UP: In order to validate the patent as a UP, the application must have designated all UPC member states (i.e. an effective filing date on or after 1 March 2007), and must have granted on or after the UPC enters into force.
- Furthermore, the same claims must have been granted for all UPC member states.
- Validate as a UP after grant: Once the patent is granted by the EPO, you will have the option of validating the granted patent as a UP, rather than validating nationally in each country covered by the UP. You may also wish to obtain ‘top-up’ national validations in any one or more of those countries (e.g. UK, ES, CH) that are not covered by the UP.