

„Unitary Patent“ and „Unified Patent Court“

An Introduction

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Part I: European Unitary Patent

Part II: Unified Patent Court

Part III: Should Clients apply for a Unitary Patent?

Part V: Opt-out declaration for Bundle Patent?

Part VI: Legal Basis

Part I: European Unitary Patent

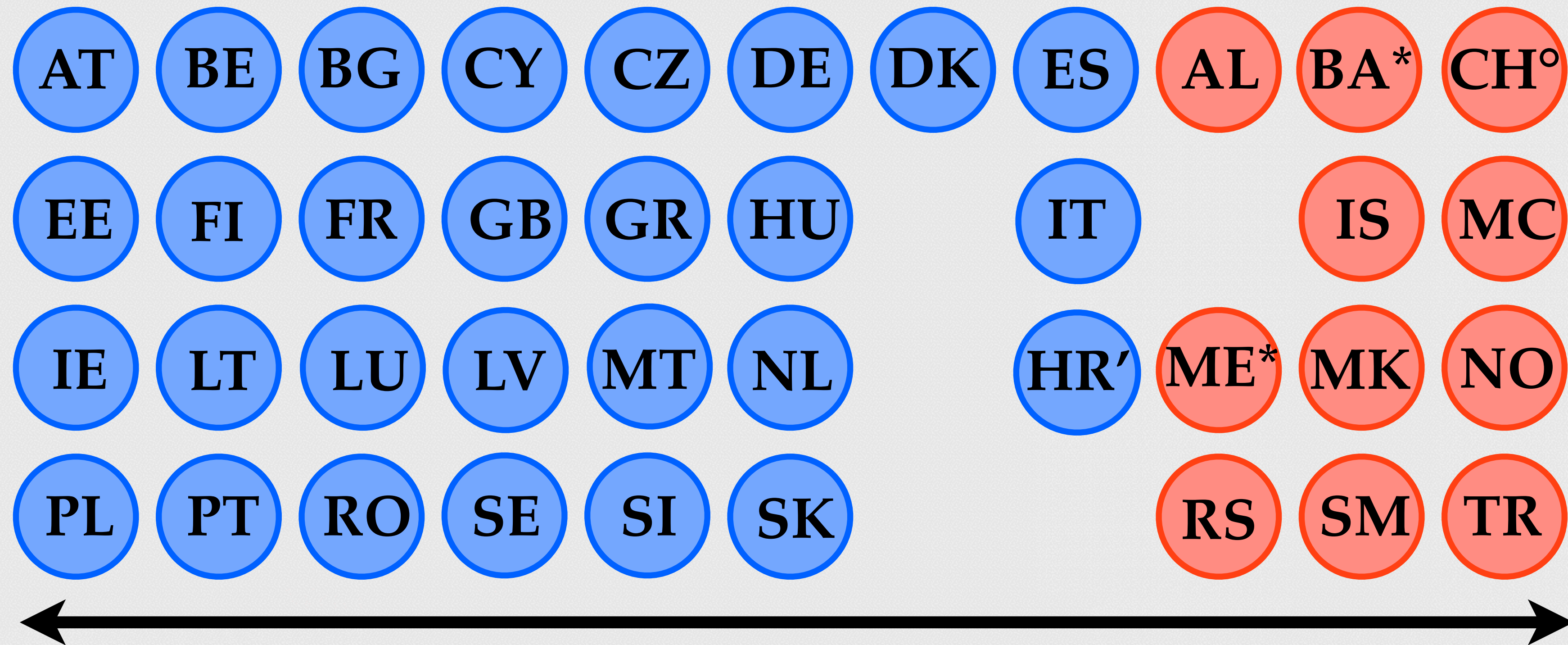
Part II: Unified Patent Court

Part III: Should Clients apply for a Unitary Patent?

Part V: Opt-out declaration for Bundle Patent?

Part VI: Legal Basis

Present Situation: European Patent = Bundle Patent



A European Patent is a bundle of national patents

* = Extension State ^o = designation also of LI ' = EU member since 2013

Present Situation: European Patent = Bundle Patent

Before Grant:

The European Patent Convention provides:

- common filing proceedings,
- common search and examination proceedings,
- common grant proceedings,
- [• common opposition proceedings]

common = common for all designated Member States of the EPC

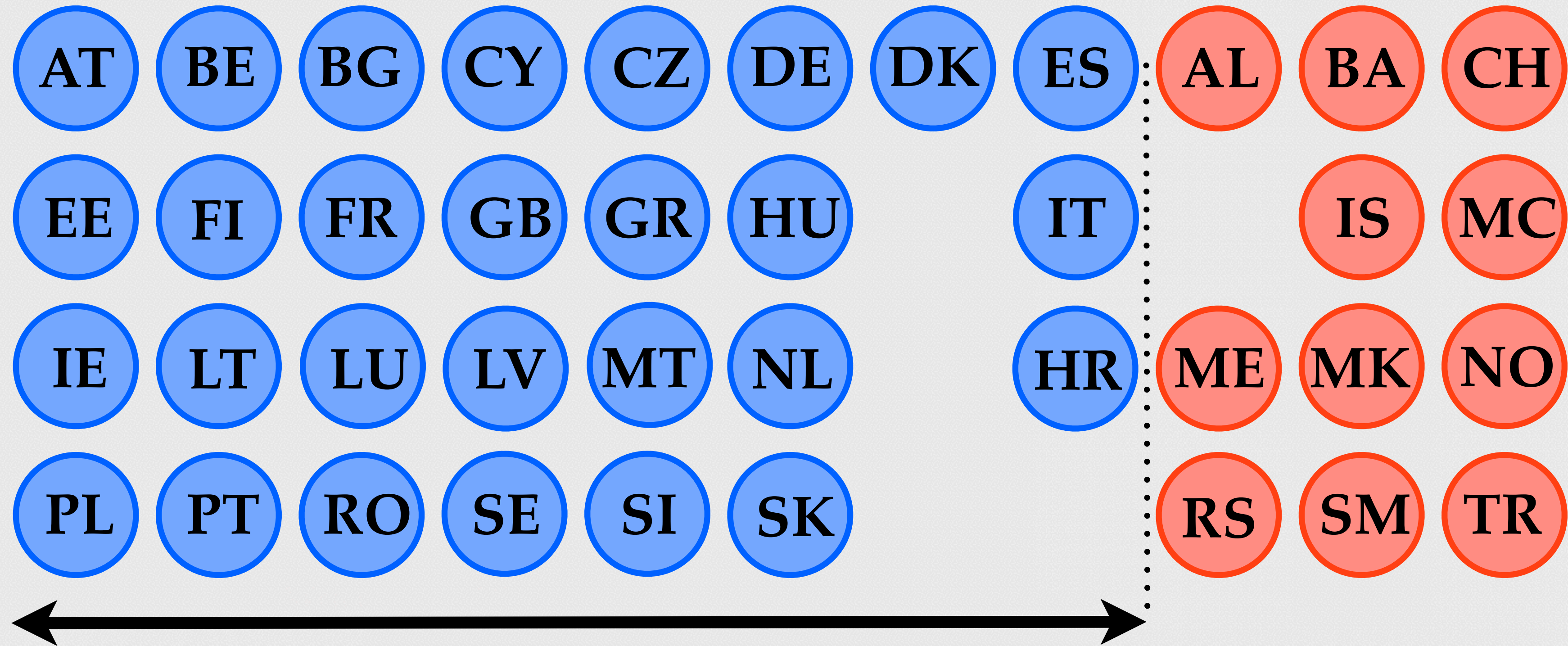
Present Situation: European Patent = Bundle Patent

After Grant:

The Member States are responsible for:

- **the administration of the respective national part of the EP patent
(including e.g. annuities)**
- **nullity and infringement proceedings**

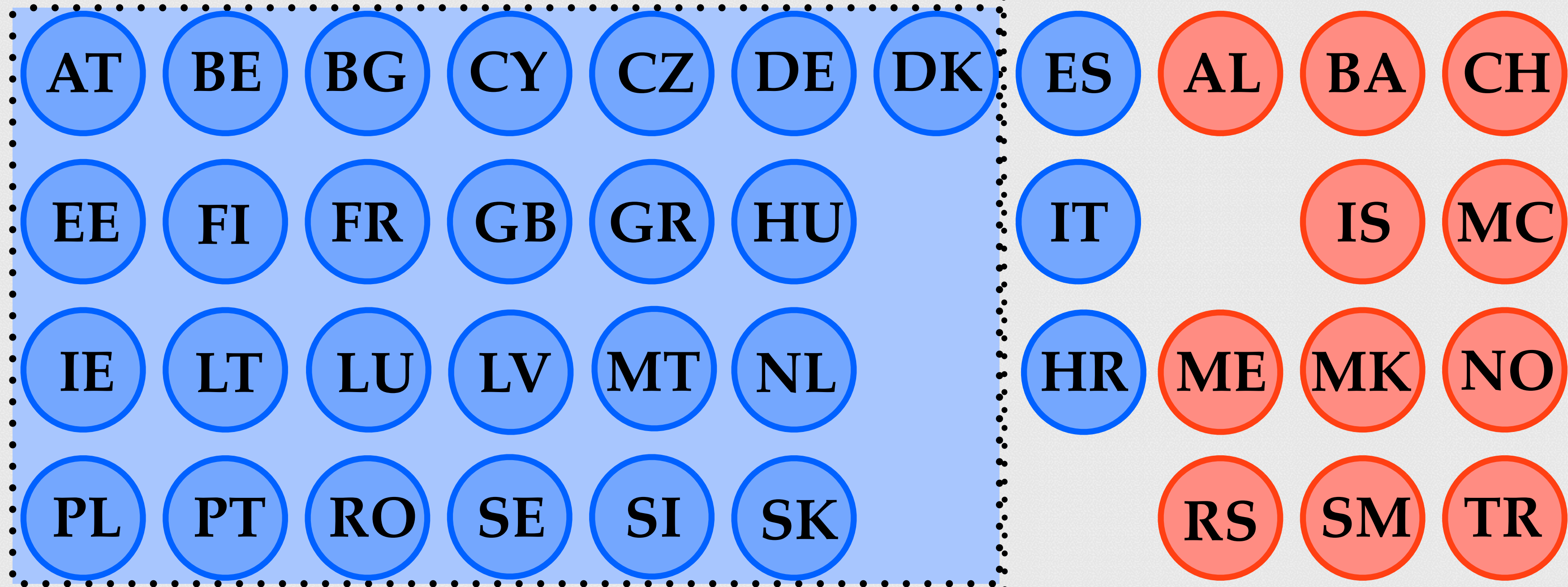
Present Situation: European Patent = Bundle Patent



All Members of the European Union are members of the European Patent Convention

Future Situation

Participating States



! After grant the applicant has the choice
between **Unitary Patent**
and **Bundle Patent**

! only
Bundle Patent
available

Future Situation: **Unitary Patent**

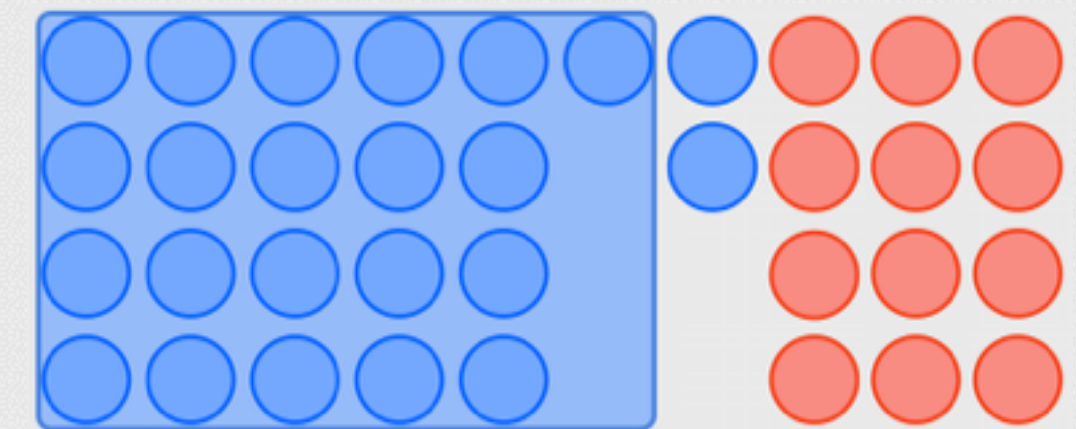
Before Grant:

no change !!!

The European Patent Convention provides

- common filing proceedings,
- common search and examination proceedings,
- common grant proceedings,
- [• common opposition proceedings]

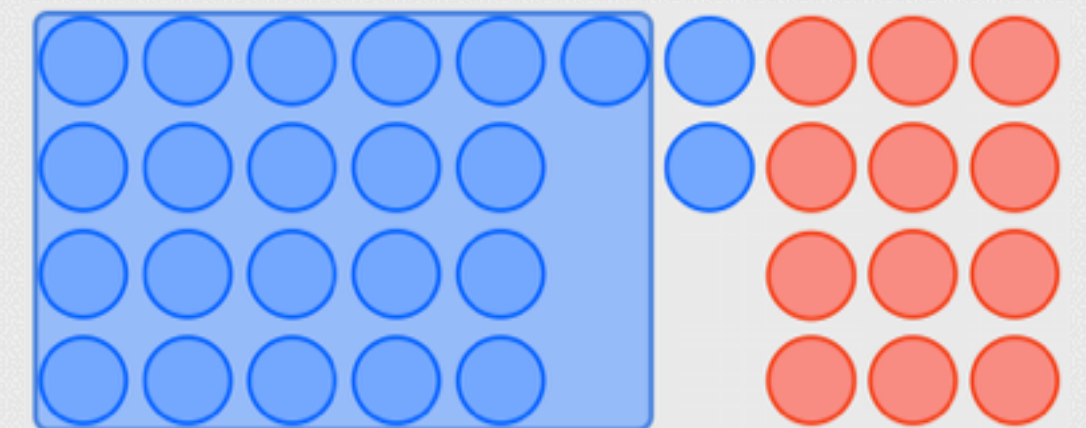
! common = common for all designated Member States of the EPC !



Future Situation: **Unitary Patent**

After Grant:

- Request for Unitary Effect within 1 month after publication of grant
- the EPO is responsible for the administration of the **Unitary Patent** (including e.g. annuities)
- the new Unified Patent Court is in charge with revocation and infringement proceedings



Future Situation: **Bundle Patent**

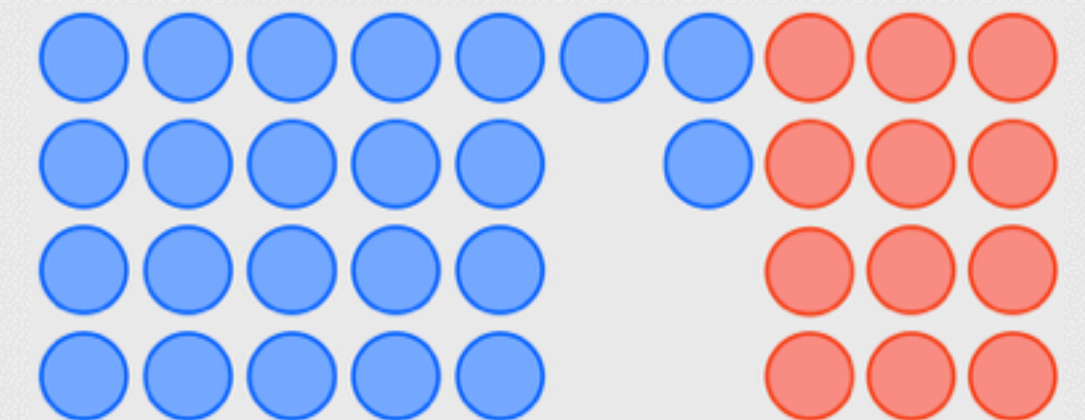
Before Grant:

no change !!!

The European Patent Convention provides:

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- [• common opposition proceedings]

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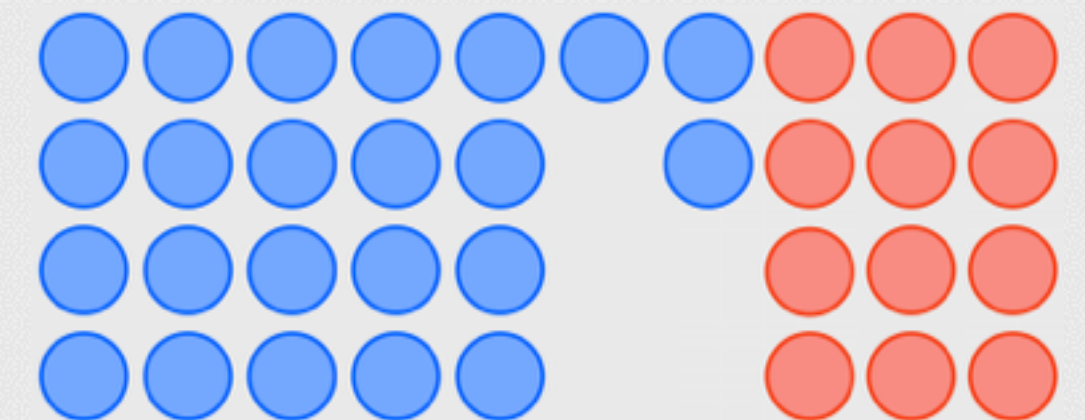
Future Situation: **Bundle Patent**

After Grant:

no change !!!

The Member States are responsible for:

- the administration of the respective national part of the EP patent
(including e.g. annuities)
- nullity and infringement proceedings



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Part VI: Legal Basis

Unified Patent Court (UPC):


UPC

The Unified Patent Court will have the

- exclusive jurisdiction for
 - **Unitary Patents**
 - **Bundle Patents** granted after the end of the „opt-out period“
- non-exclusive jurisdiction for
 - **Bundle Patents** granted before the end of the „opt-out period“
(see, however, Transitional Regulations on next slide)

Transitional Regulations

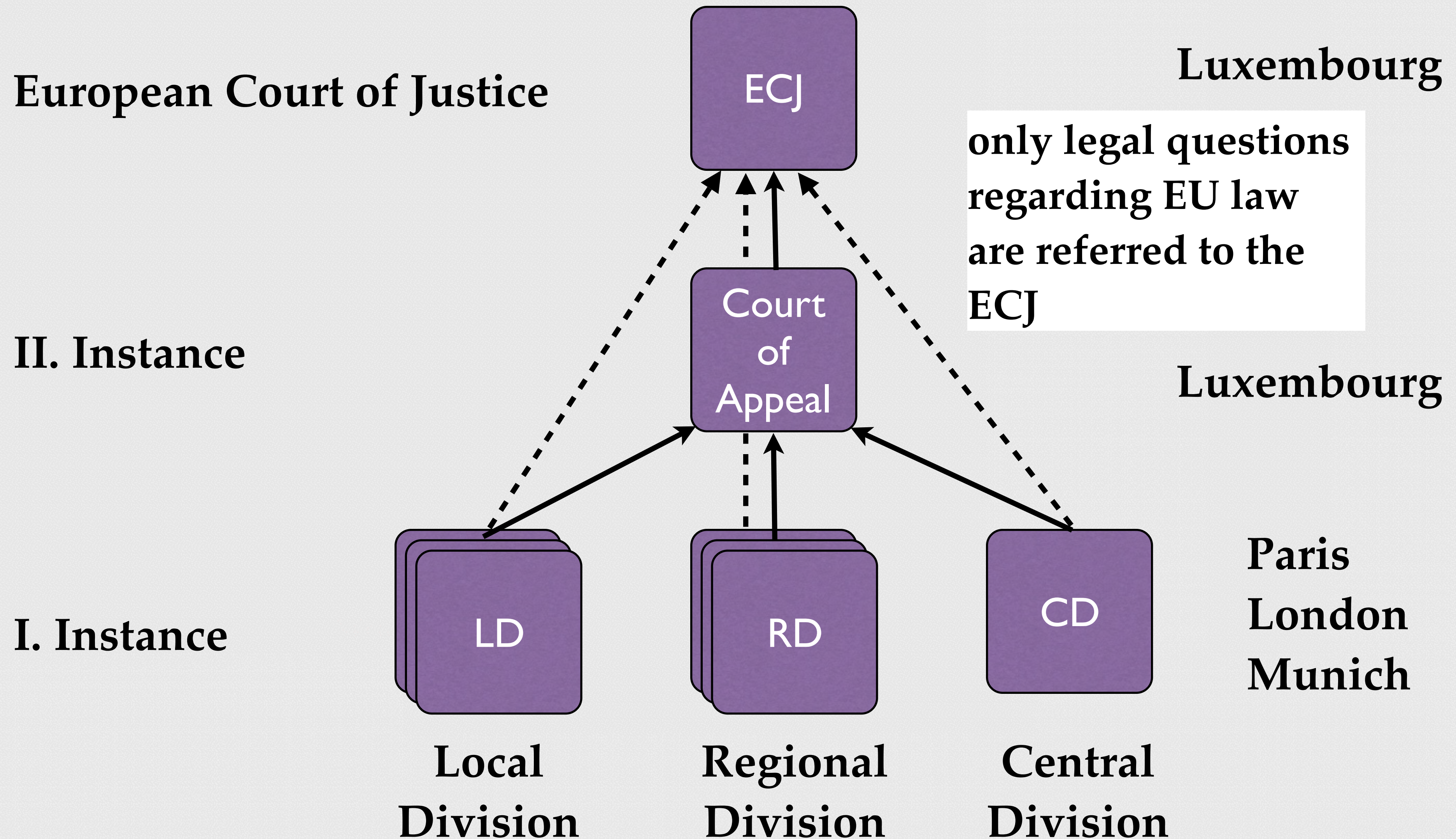
for **Bundle Patents** granted before end of opt-out period

- A) If the patent owner has not filed the opt-out declaration:
- before the end of the opt-out period:
the plaintiff has the choice between UPC and national courts
 - after the end of the opt-out period:
UPC has the exclusive jurisdiction 
- B) If the patent owner has filed the opt-out declaration during opt-out period (as long as no action is pending yet):
- national courts have the exclusive jurisdiction
(no change after opt-out period)

Transitional Regulations
for Bundle Patents granted before end of opt-out period

- C) The patent owner may withdraw the opt-out declaration as long as no action is pending at a national court
-> back to situation A)

Instances:



Local, Regional and Central Divisions:

LD

- an LD is established upon request of a Participating State
- an additional LD (up to 4) for every 100 cases per year (Germany plans to set up LDs in Düsseldorf, Mannheim, Munich and Hamburg)

RD

- an RD is established upon a common request of more than one Participating State, e.g. SE,EE,LT,LV

CD

- Paris: Seat - IPC sections B, D, E, G, H
- London: Section - IPC sections A and C
- Munich: Section - IPC section F

Central Division:



CD

The CD has the exclusive jurisdiction for the following actions:

- isolated revocation actions
- declaration of non-infringement
(to be stayed in case of a parallel infringement action)

Moreover, the CD has the exclusive jurisdiction for actions against decisions of the EPO in connection with the administration of the Unitary Patents.

Local / Regional Divisions:

LD / RD

LDs / RDs have exclusive jurisdiction for all infringement actions with exception of the following cases:

- a parallel revocation action is already pending at the CD
- the defendant has his residence or place of business outside the Participating States

->in both cases the plaintiff can file the action *also* at the CD

- the Participating State concerned has no LD/RD (eg. LU)

->the action has to be filed at the CD

Local Competence:

LD / RD

Basically, the plaintiff has to file the infringement action at the LD / RD in the Participating State in which

- either the infringement has occurred
- or the defendant has his residence or place of business.

LD / RD

However, if the defendant has his residence or place of business not in a Participating State, the plaintiff may file the action

CD

- either at the LD / RD of a Participating State in which the infringement has occurred
- or at the CD.

Contractual Competence:

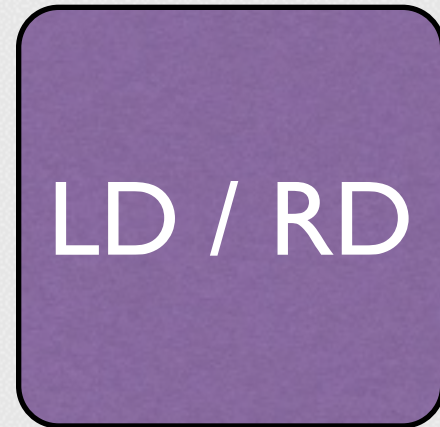
LD / RD

LD / RD

CD

The parties of a contract may agree upon a division which should be in charge (i.e. any of the LDs, RDs and the CD)

Local / Regional Divisions:



In case of a counterclaim for revocation, the LD / RD may:

- **proceed itself with both actions, i.e. the infringement action and the revocation action,**
 - **with agreement of the parties, refer both actions, i.e. the infringement action and the revocation action, to the CD,**
- or**
- **refer the revocation action to the CD and suspend or proceed with the infringement proceedings.**

Summary

Which type of **European Patent**?

Unitary Patent

▶ file „Request for Unitary Effect“

Jurisdiction of
Unified Patent Court
obligatory

Option A

Bundle Patent

▶ nationalization in
countries of interest

Jurisdiction of
Unified Patent Court ?

yes

▶ no action
necessary

Option B

no

▶ file opt-out
declaration

Option C

Summary

Which type of **European Patent**?

Unitary Patent

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Jurisdiction of
Unified Patent Court
obligatory

Option A

Bundle Patent

countries of interest

Jurisdiction of
Unified Patent Court ?

yes

▶ nothing to do

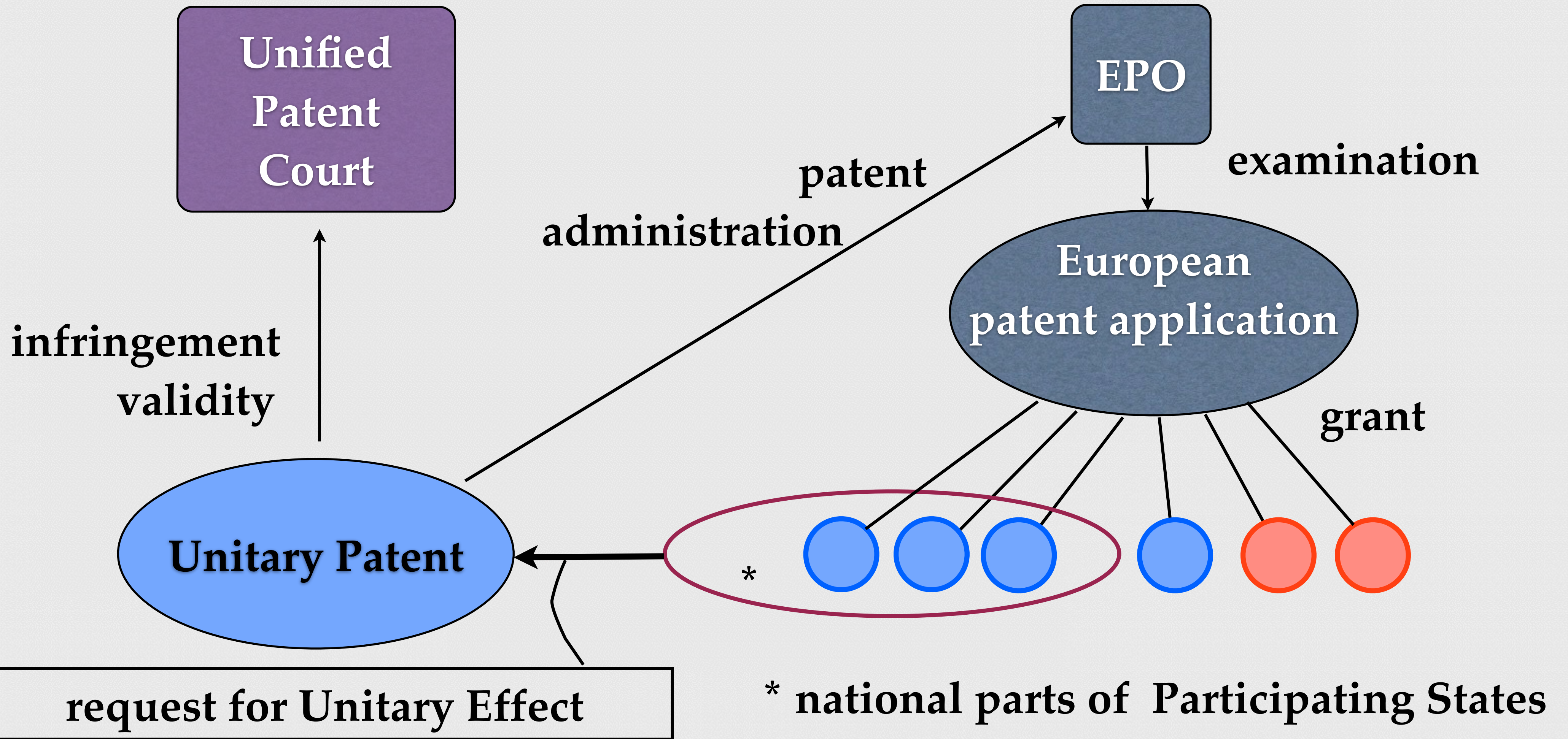
Option B

no

▶ file opt-out
declaration

Option C

Option A: new patent + new court



Summary

Which type of **European Patent**?

Unitary Patent

Bundle Patent

▶ nationalization in countries of interest

Jurisdiction of Unified Patent Court
obligatory

Jurisdiction of Unified Patent Court ?

Option A

yes

▶ nothing to do

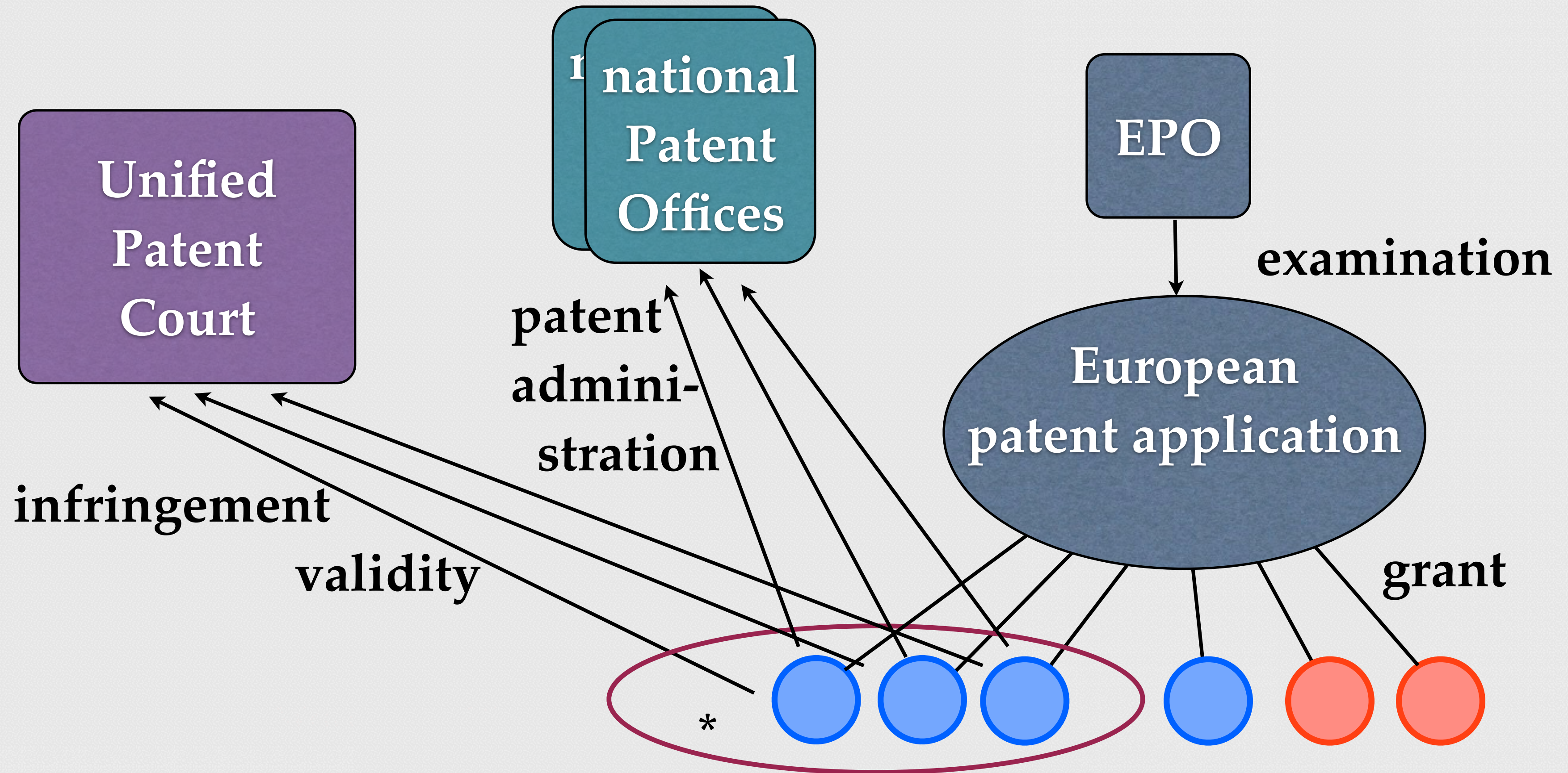
Option B

no

▶ file opt-out declaration

Option C

Option B: old patent + new court



no request for Unitary Effect

* national parts of Participating States

Summary

Which type of **European Patent**?

Unitary Patent

Bundle Patent

▶ nationalization in countries of interest

Jurisdiction of Unified Patent Court

Jurisdiction of Unified Patent Court ?

obligatory

Option A

yes

▶ nothing to do

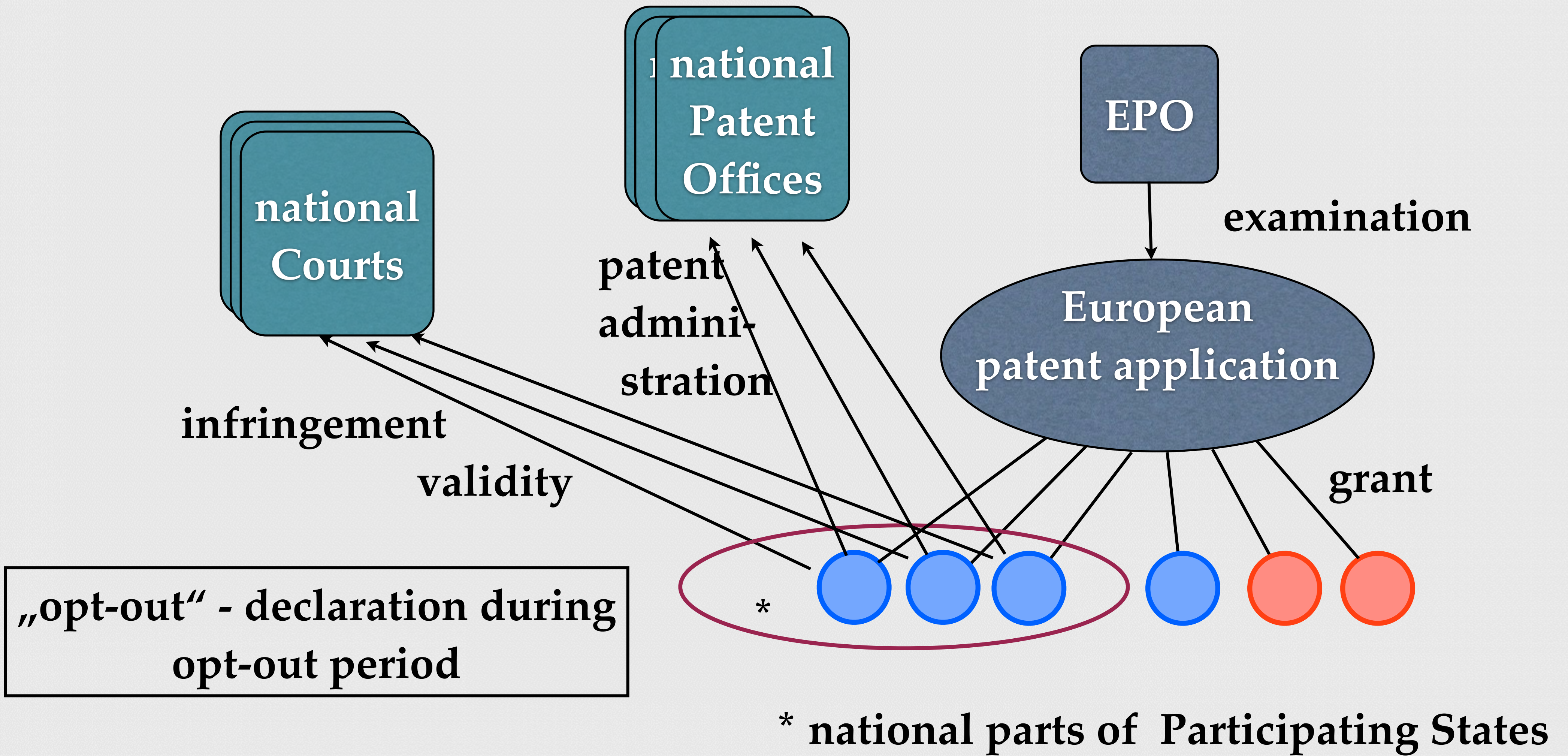
Option B

no

▶ file opt-out declaration

Option C

Option C: „old“ patent + „old“ courts



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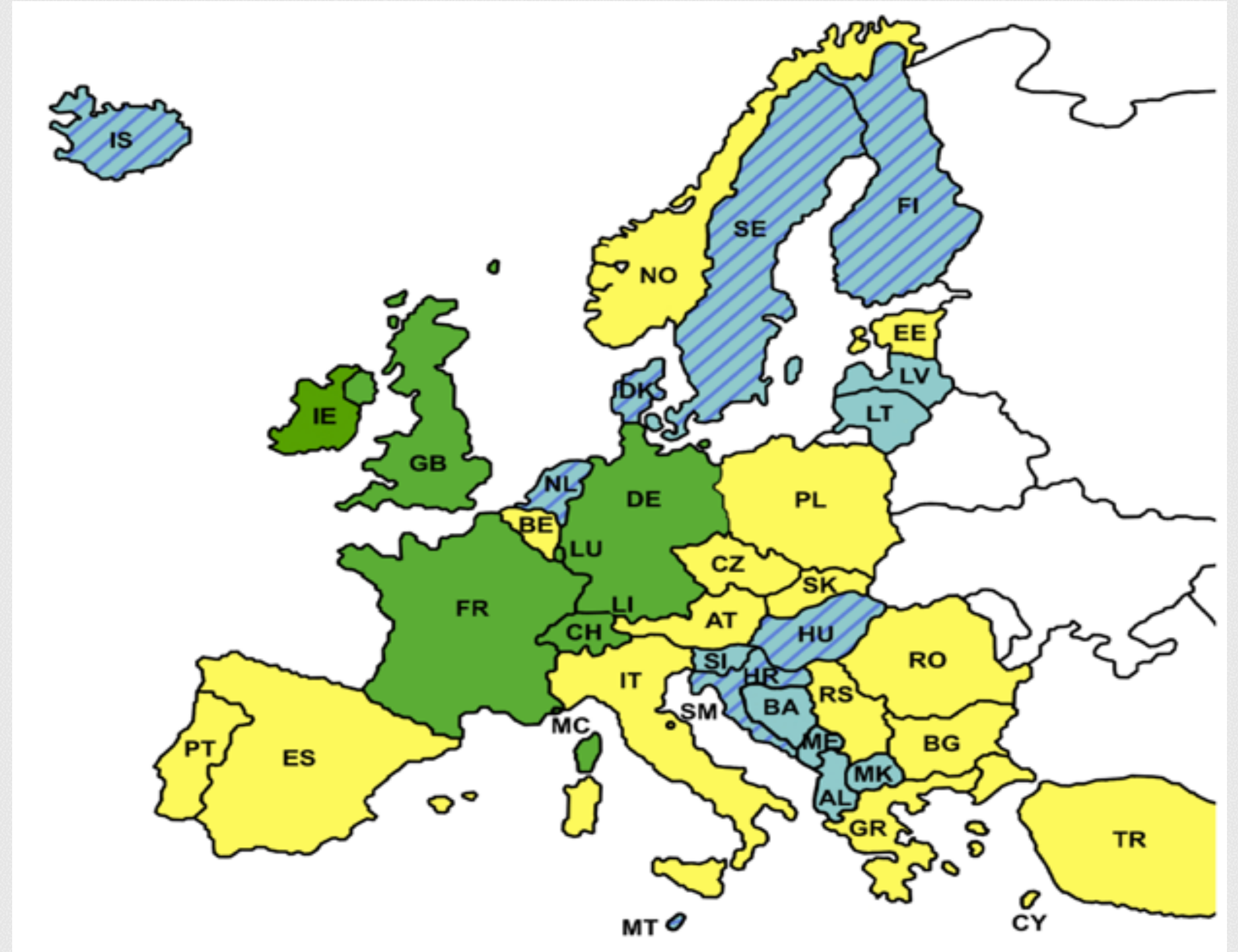
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Part VI: Opt-out declaration for Bundel Patents?

Part V: Legal Basis

Important Criteria: Costs for Translations and Annuities

- **Bundle Patent**
- Translations
 - have to be prepared according to the London Agreement
- Annuities
 - have to be paid for the countries of interest only.

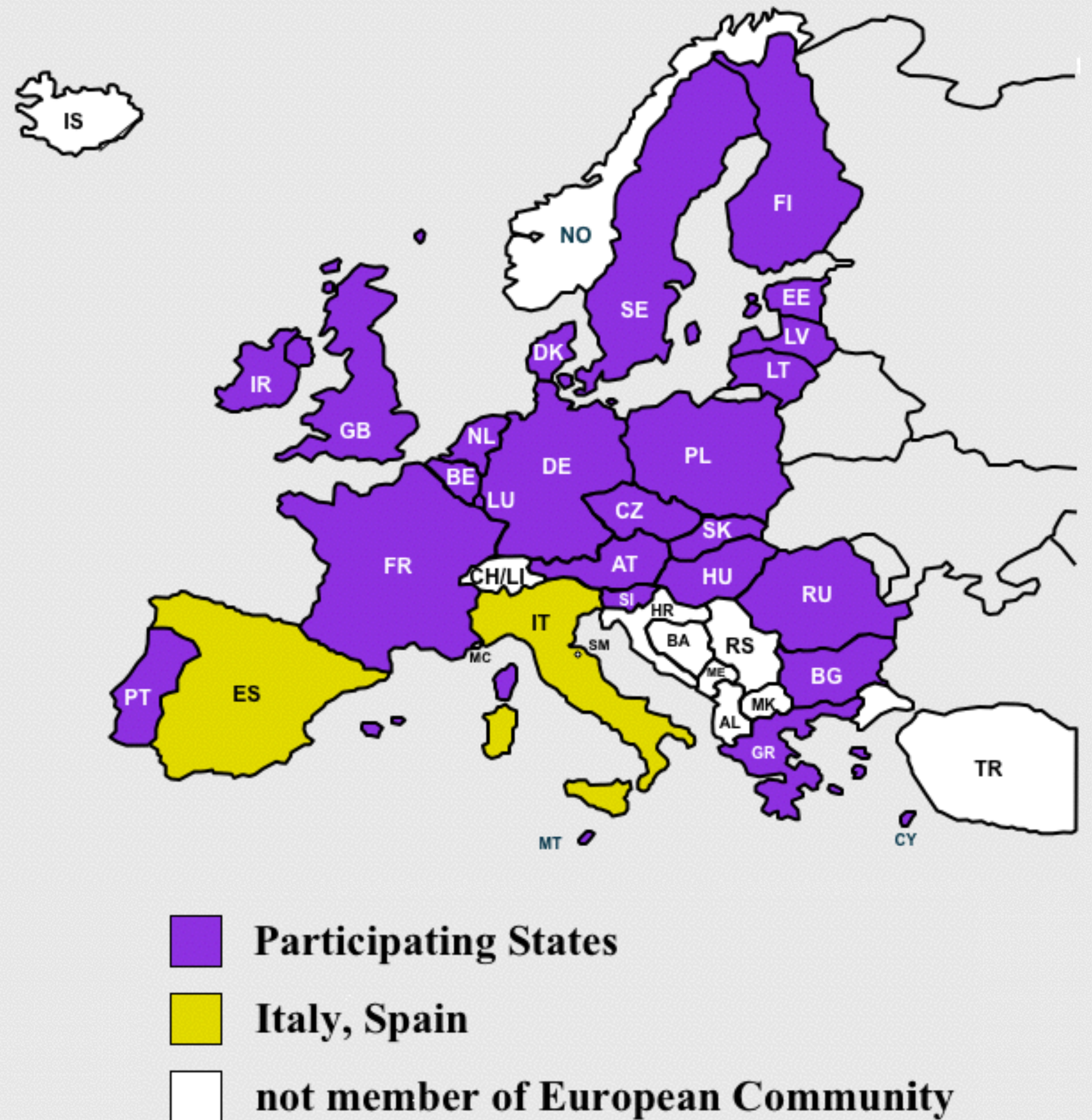


- translation of description and claims
- no translation
- translation of claims
- translations of claims + English description

Important Criteria: Costs for Translations and Annuities

- Unitary Patent

- Translations (language before the EPO: English)
 - translation of specification and claims into only one additional language (DE or FR if IT or ES is *not* to be validated)
 - limited to a time period of 12 years at maximum
- Annuities
 - not yet decided (possibly: 3 to 5 average annuities)



Part I: European Unitary Patent

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Part V: Legal Basis

PRO declaration i.e. pro national courts:

- **known performance**
- **no risk of loosing the whole Bundle Patent i.e. not „all eggs in one basket“**

CONTRA declaration i.e. pro Unified Patent Court:

- **enforcement of the Bundle Patent by one action in all Bundle States**
- **rather fast - Rules designed to have the first instance decision within 1 year**
- **costs lower than in some EU countries, e.g. GB**

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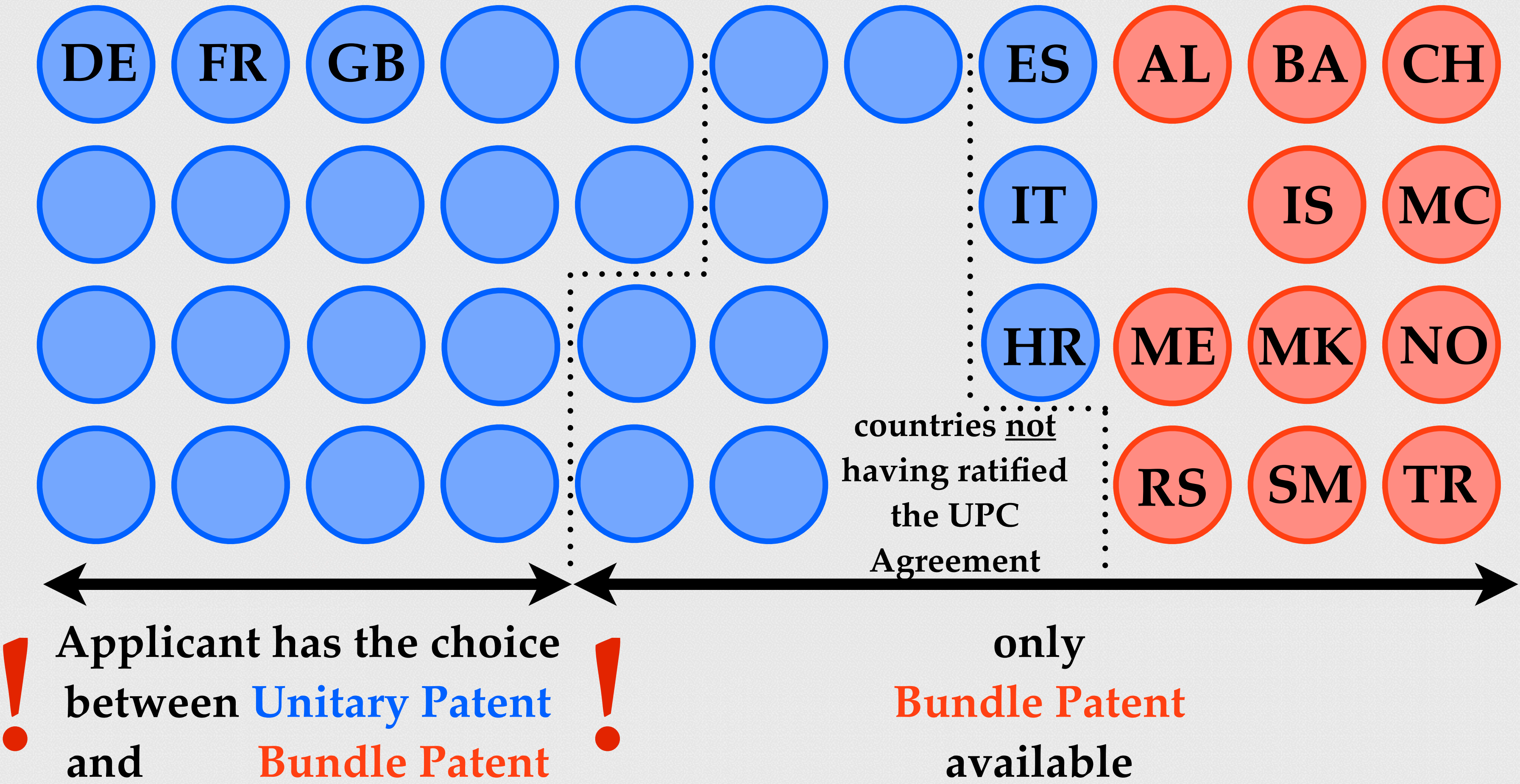
Part V: Legal Basis

- **Council Regulations (CR)**
 - a) on Unitary Patent protection CR No. 1257/2012 and
 - b) on the applicable translation arrangements CR No. 1260/2012
- **Intergovernmental Agreement No. 16351/12 about a Unified Patent Court (UPC-IA)**

Challenges for the new system:

- **Ratification - The new Unified Patent System will only enter into force after ratification of the UPC-IA by DE, FR, GB and 10 other Participating States, presently ratified by AT, FR, BE, DK and SE**
- **Actions of IT and ES filed with the ECJ against the 2 Council Regulations**
18 November 2014: opinion of the Court's Advocate General to dismiss the claims

Possible Intermediate Situation





Thank you very much for your kind attention!