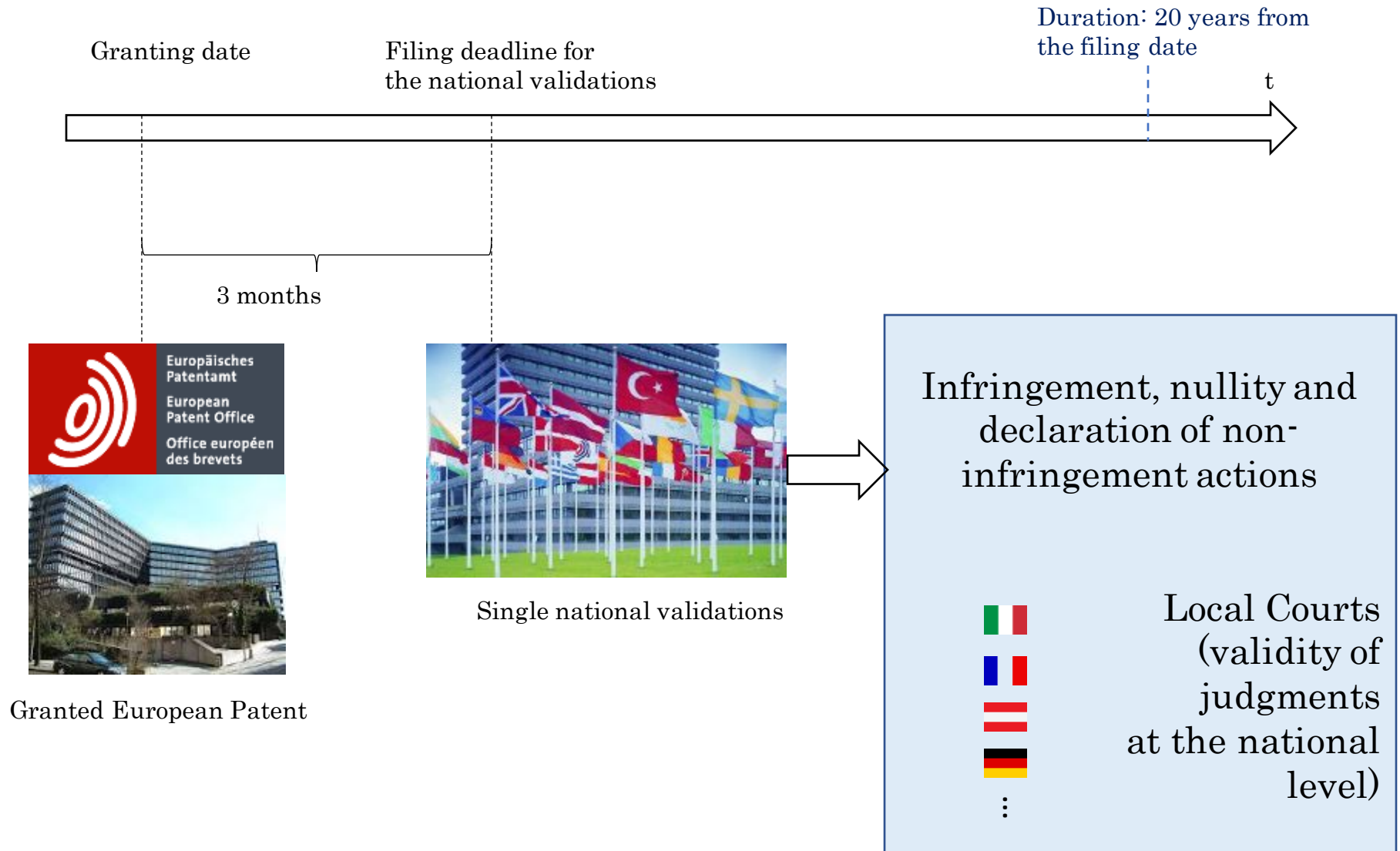


*From
European Patent
to
Unitary Patent*



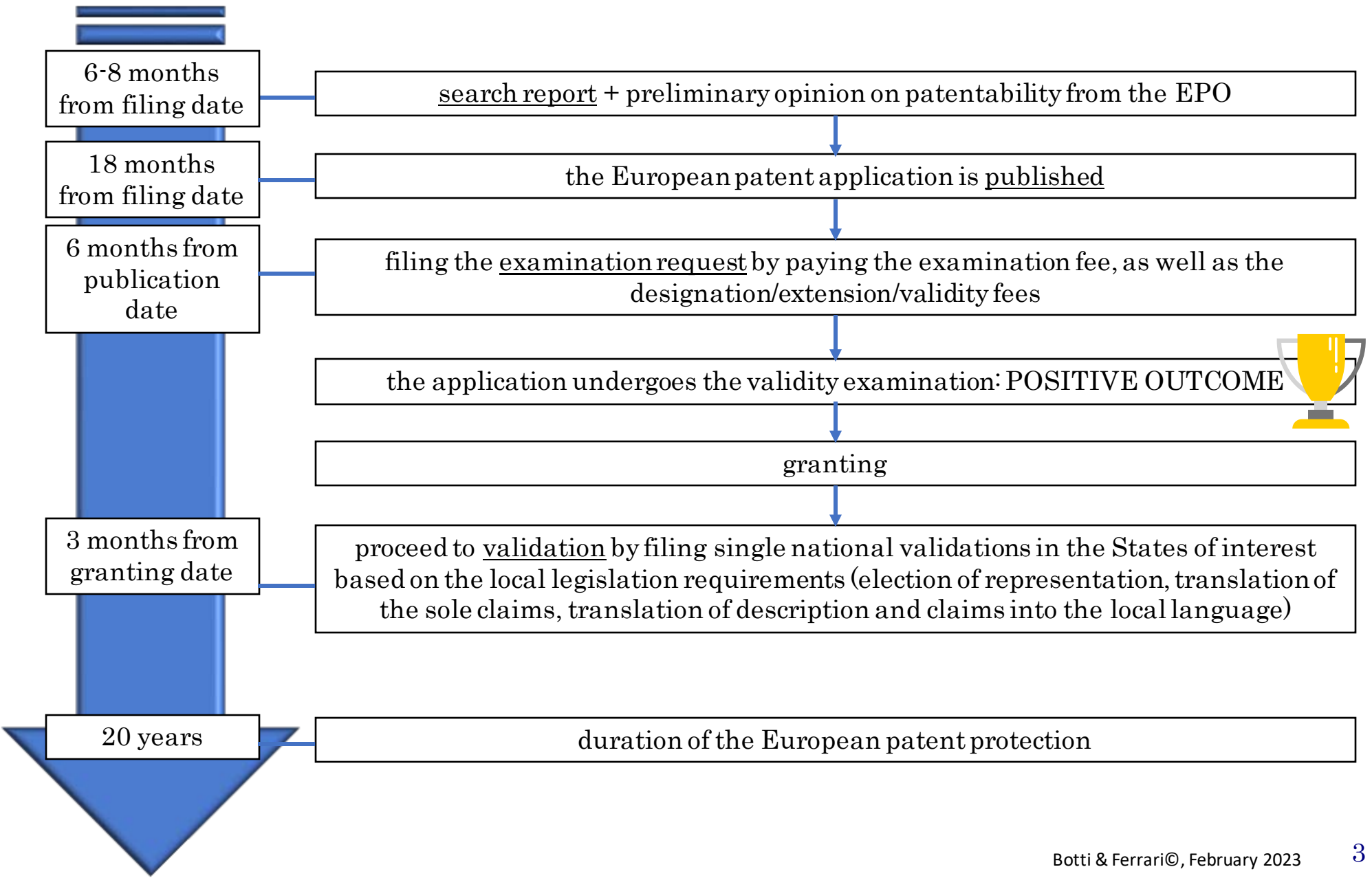


EUROPEAN PATENT APPLICATIONS (current procedure)



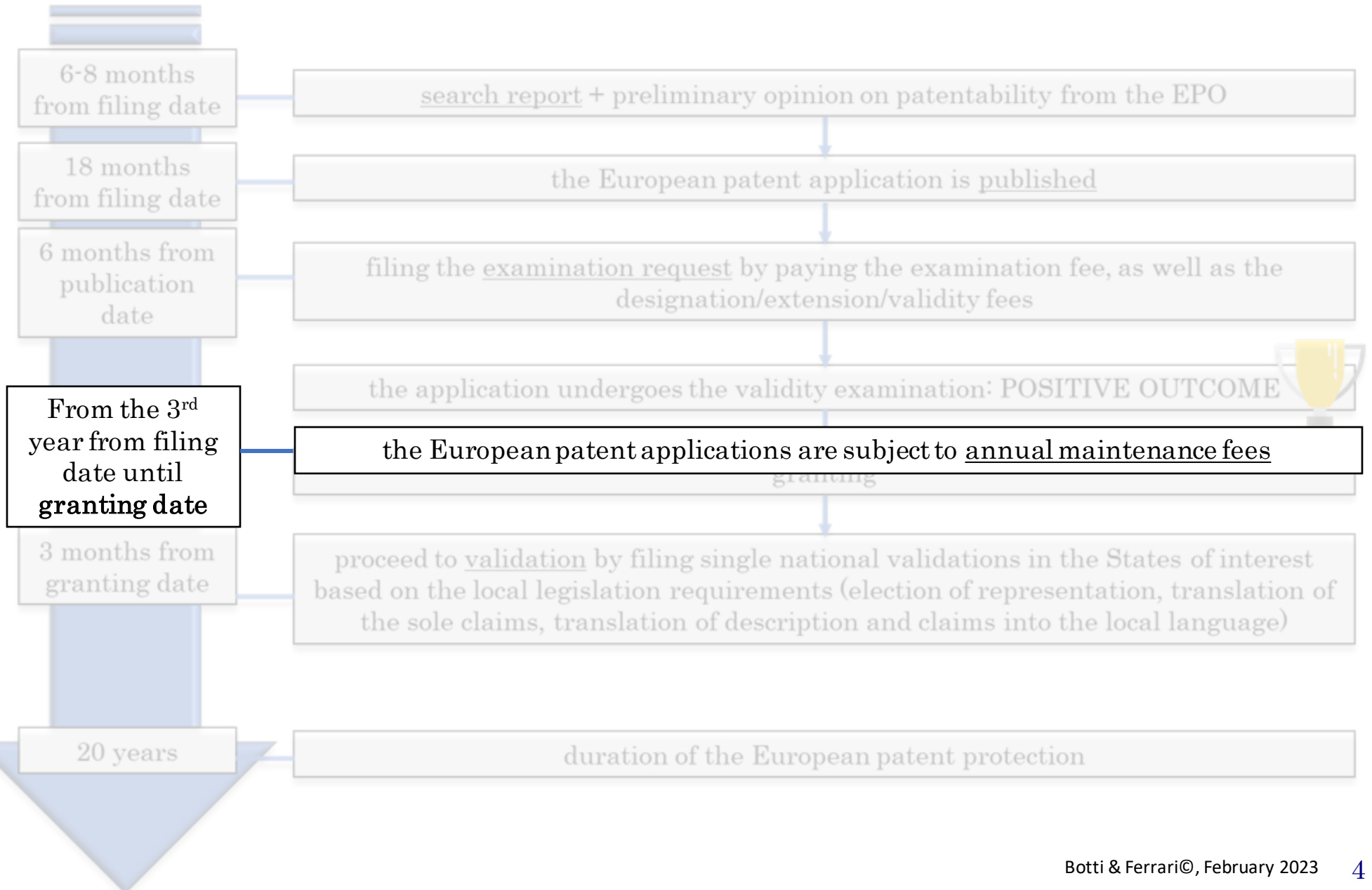


EUROPEAN PATENT APPLICATIONS (current procedure)



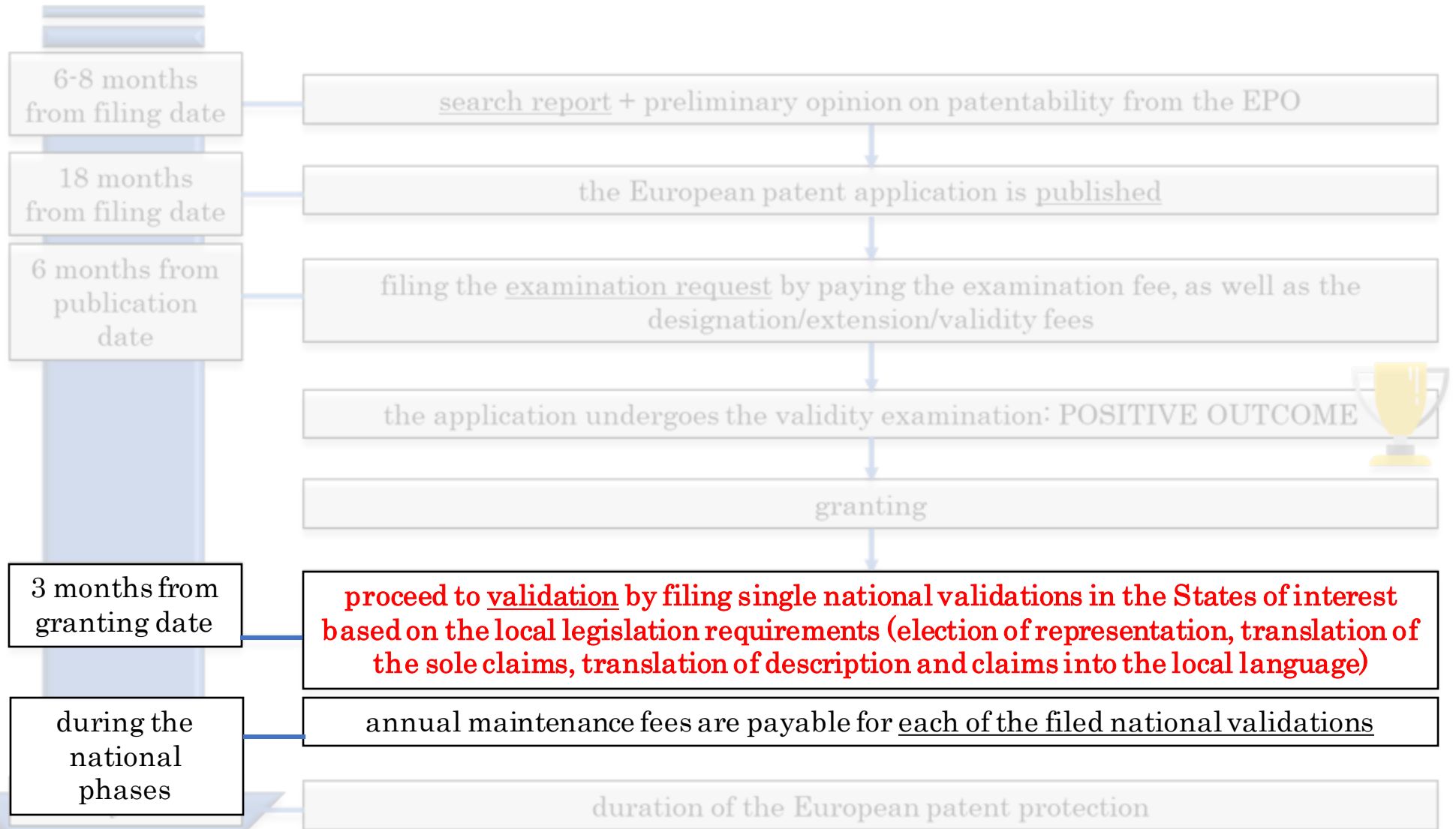


EUROPEAN PATENT APPLICATIONS (current procedure)



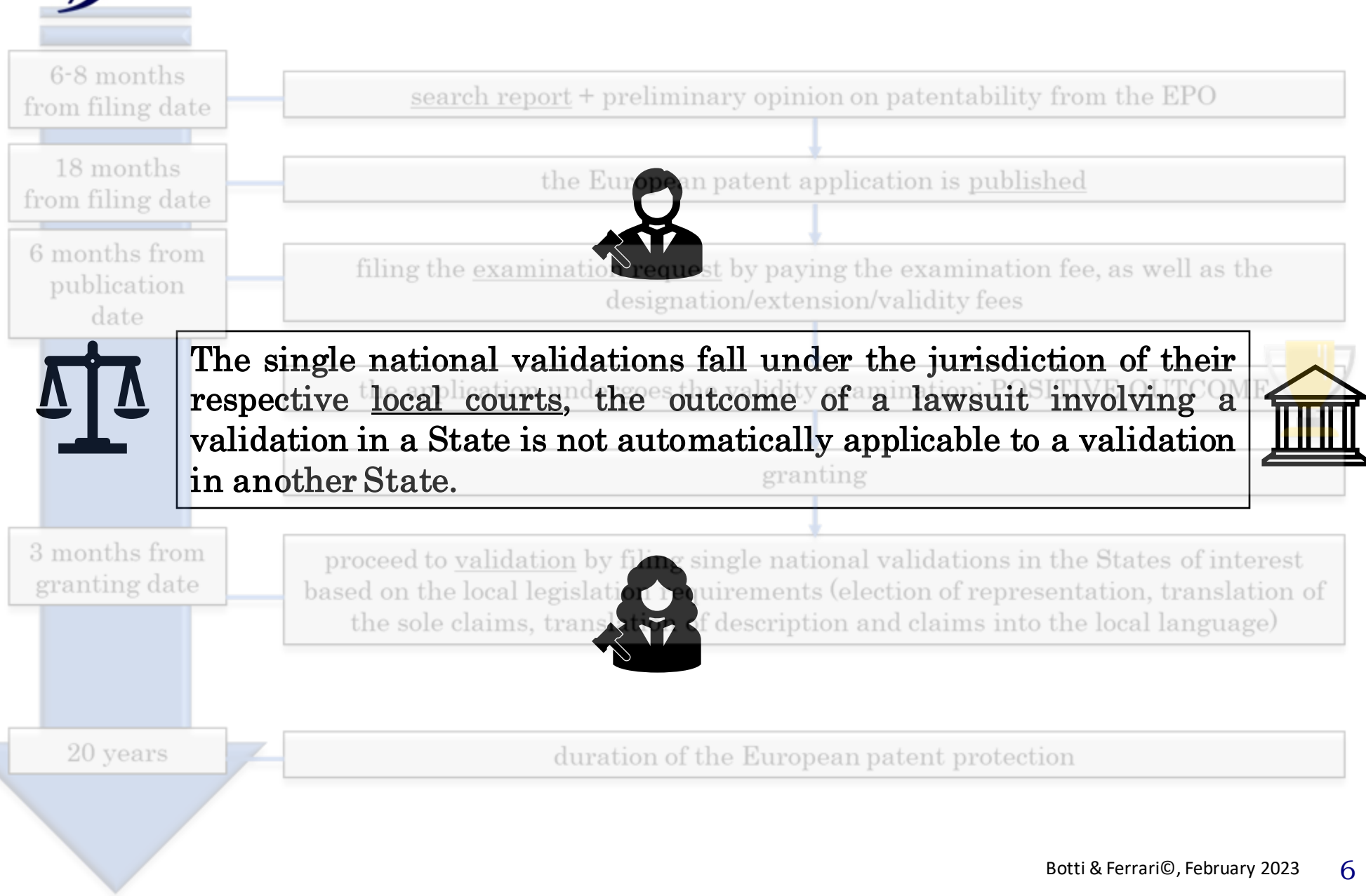


EUROPEAN PATENT APPLICATIONS (current procedure)





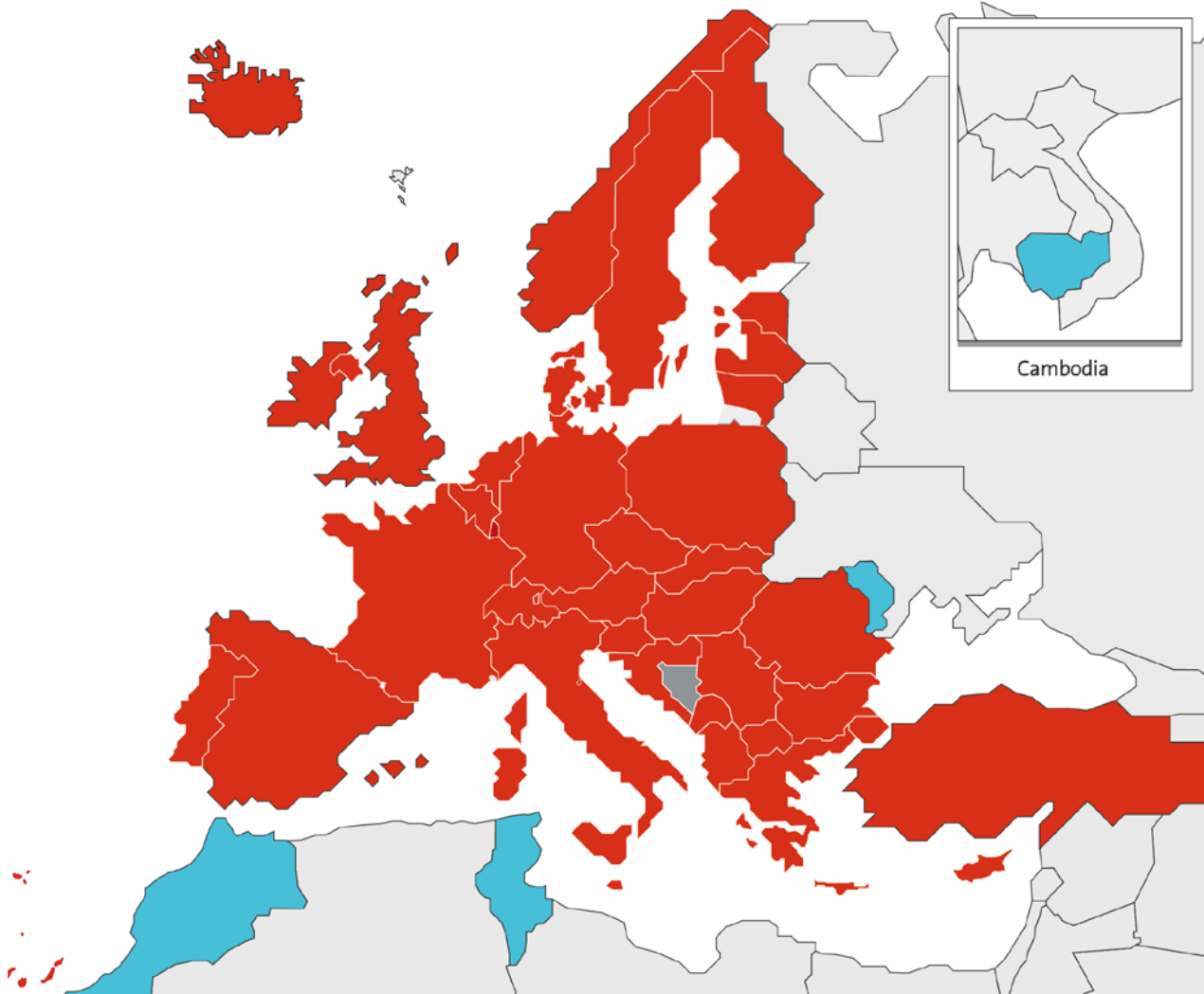
EUROPEAN PATENT APPLICATIONS (current procedure)





EUROPEAN PATENT APPLICATIONS (current procedure)

Coverage - member, extension, validation States



Member States (39)

Albania, Austria, Belgium, Bulgaria, Switzerland, Cyprus, Czech Republic, Germany, Denmark, Estonia, Spain, Finland, France, Great Britain, Greece, Croatia, Hungary, Ireland, Italy, Liechtenstein, Lithuania, Luxembourg, Latvia, Monaco, Montenegro, North Macedonia, Malta, Netherlands, Norway, Poland, Portugal, Romania, Serbia, Sweden, Slovenia, Slovakia, San Marino, Turkey

Extension State (1)

Bosnia Herzegovina

Validation States (4)

Morocco, Republic of Moldova, Tunisia, Cambodia



EUROPEAN PATENT APPLICATIONS (current procedure)

National validations

GROUP 1

STATES WHERE THE **SOLE ASSUMPTION OF
REPRESENTATION** OF A LOCAL REPRESENTATIVE IS NECESSARY

(London agreement)

Belgium, Switzerland, Germany, France, Great Britain, Ireland, Luxembourg, Monaco, Malta

GROUP 2

STATES WHERE THE **SOLE
TRANSLATION OF THE CLAIMS** IS NECESSARY

Albania, Denmark, Finland, Croatia, Hungary, Iceland, Lithuania, Latvia, North Macedonia,
Netherlands, Norway, Sweden, Slovenia

GROUP 3

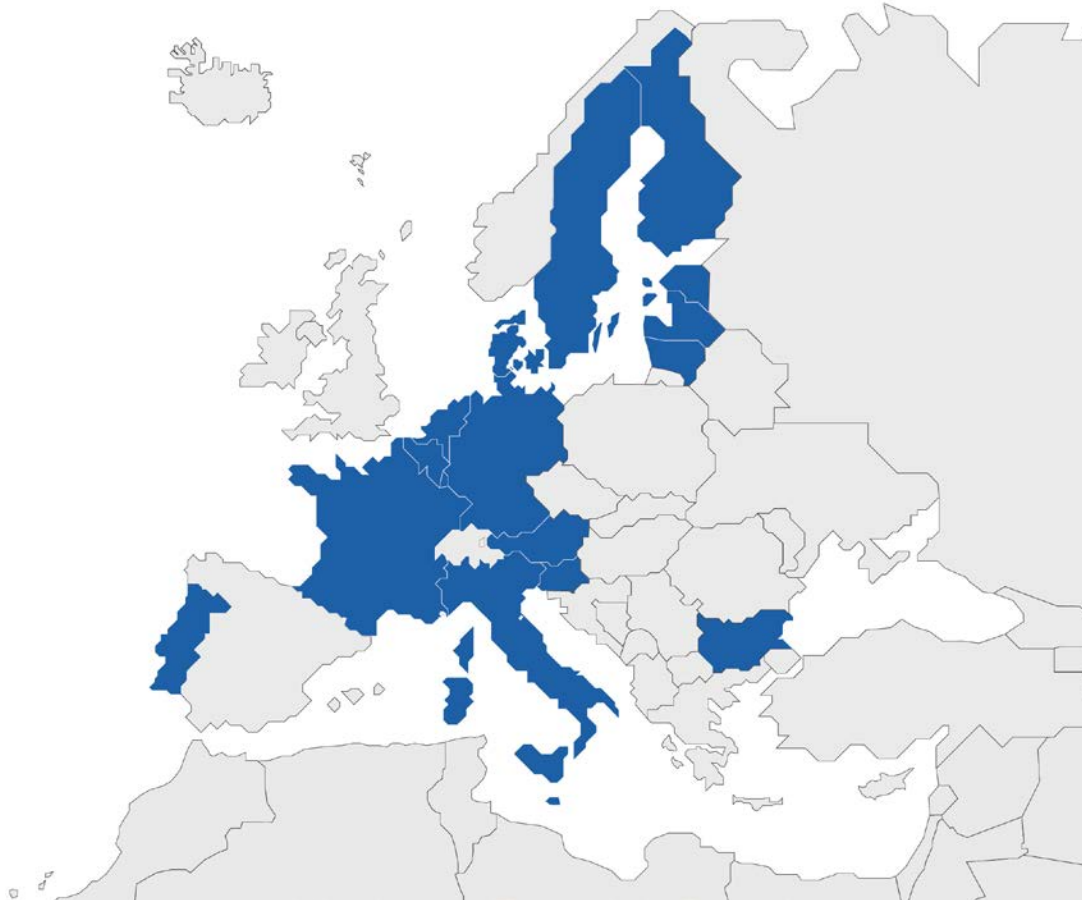
STATES WHERE THE
TRANSLATION OF THE ENTIRE TEXT IS NECESSARY

Austria, Bulgaria, Cyprus, Czech Republic, Estonia, Spain, Greece, Italy, Poland, Portugal, Romania,
Serbia, Slovak Republic, San Marino, Turkey



THE UNITARY PATENT SYSTEM (UP) - current participating States

According to the current prediction, the **Unitary Patent (UP)** system will enter into force in June 2023 and at the same time the **Unified Patent Court (UPC)** will start operating.



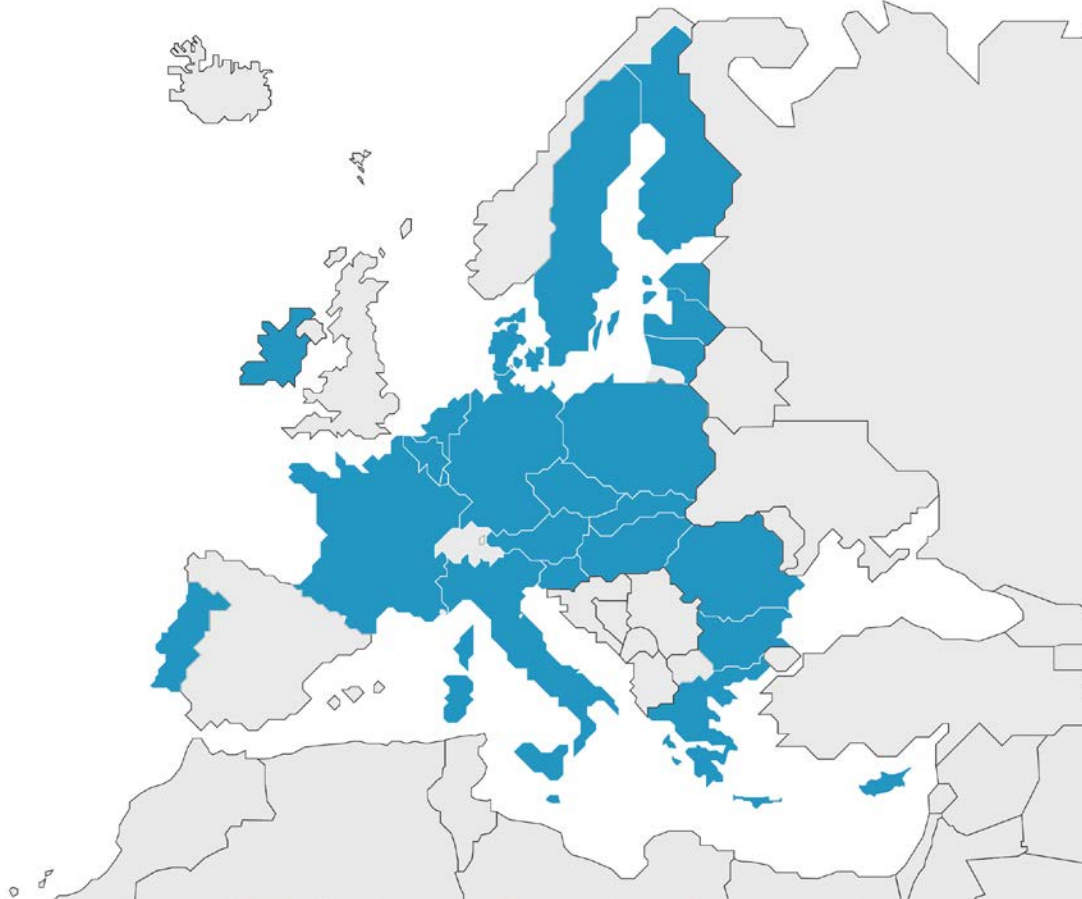
States that have currently adhered to the Unitary Patent system (17)

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

- Patent validated in a unitary manner (UP) in all participating States, without the need to proceed with separate validations in each State
- Payment of a single annuity fee
- Unified Patent Court (UPC) Jurisdiction for infringement, nullity and declaration of non-infringement actions.



THE UNITARY PATENT SYSTEM (UP) - States participating in the cooperation



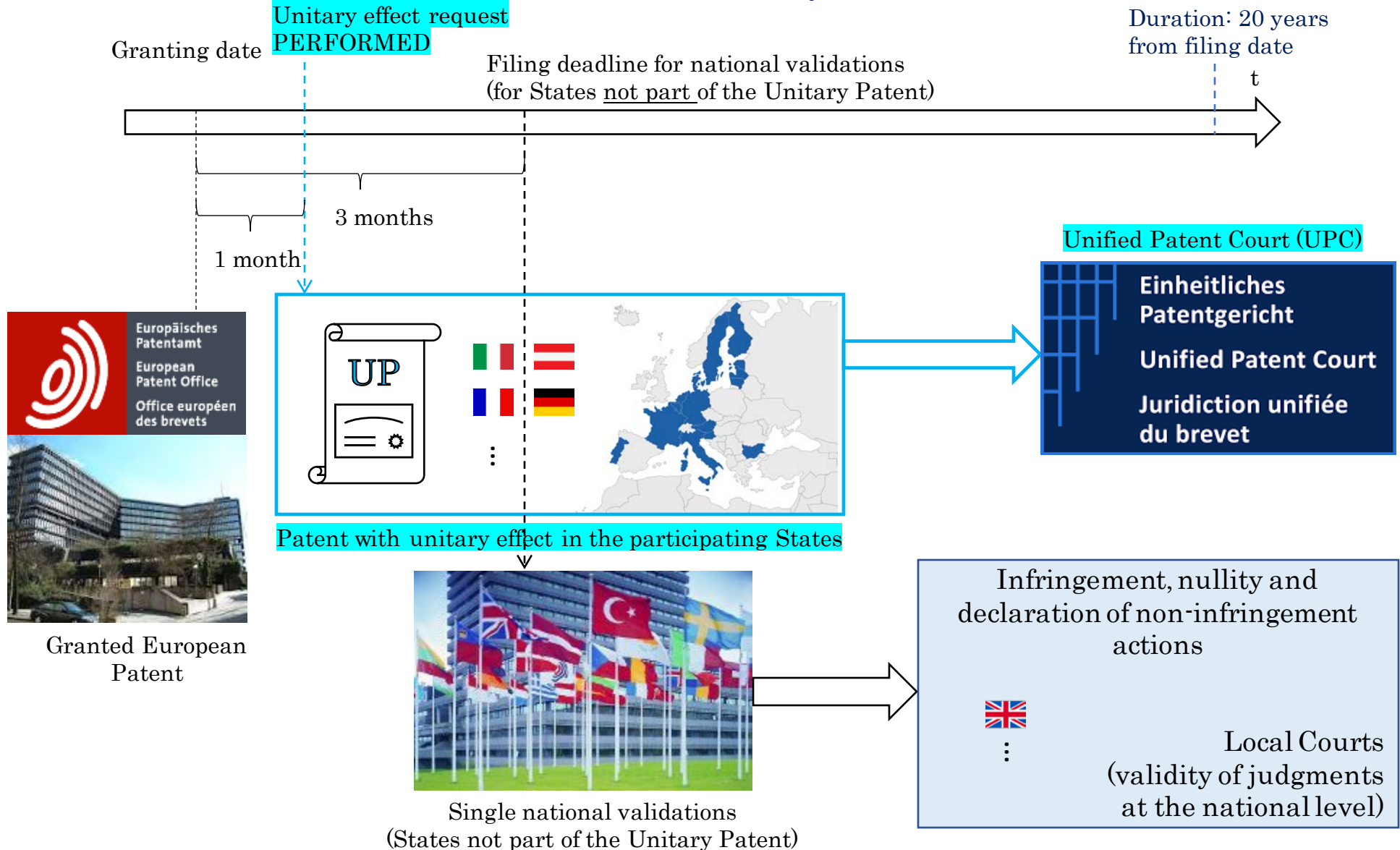
States of the European Union which have participated in the cooperation for the creation of the Unitary Patent system (25)

Will be able to join in the future (8):

*Austria, Belgium, Bulgaria, **Cyprus**, **Czech Republic**, Denmark, Estonia, Finland, France, Germany, **Greece**, **Hungary**, **Ireland**, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, **Poland**, Portugal, **Romania**, **Slovakia**, Slovenia, Sweden.*

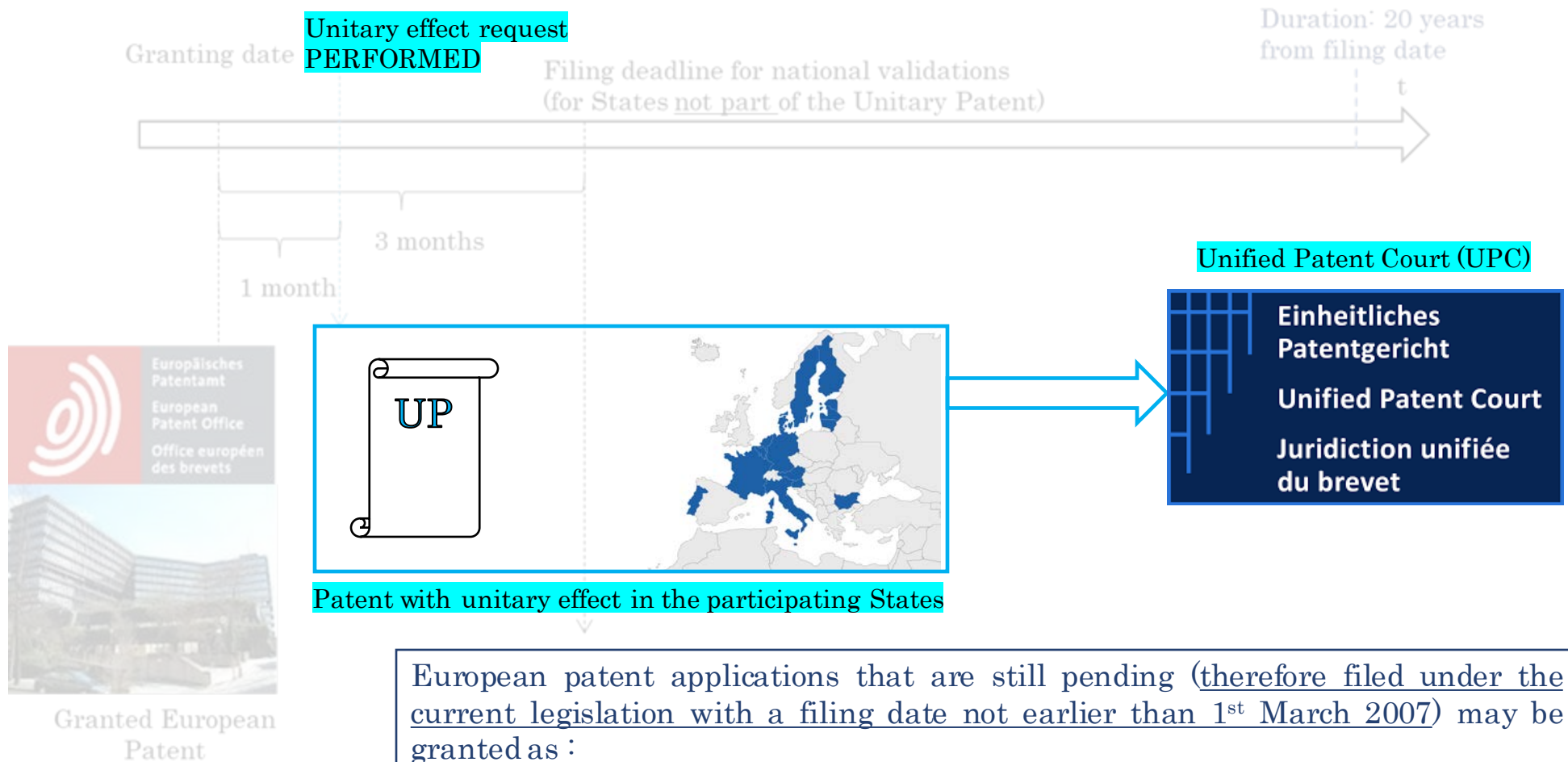


PENDING EUROPEAN PATENT APPLICATIONS (after the start of the Unitary Patent - UP)





PENDING EUROPEAN PATENT APPLICATIONS (after the start of the Unitary Patent - UP)

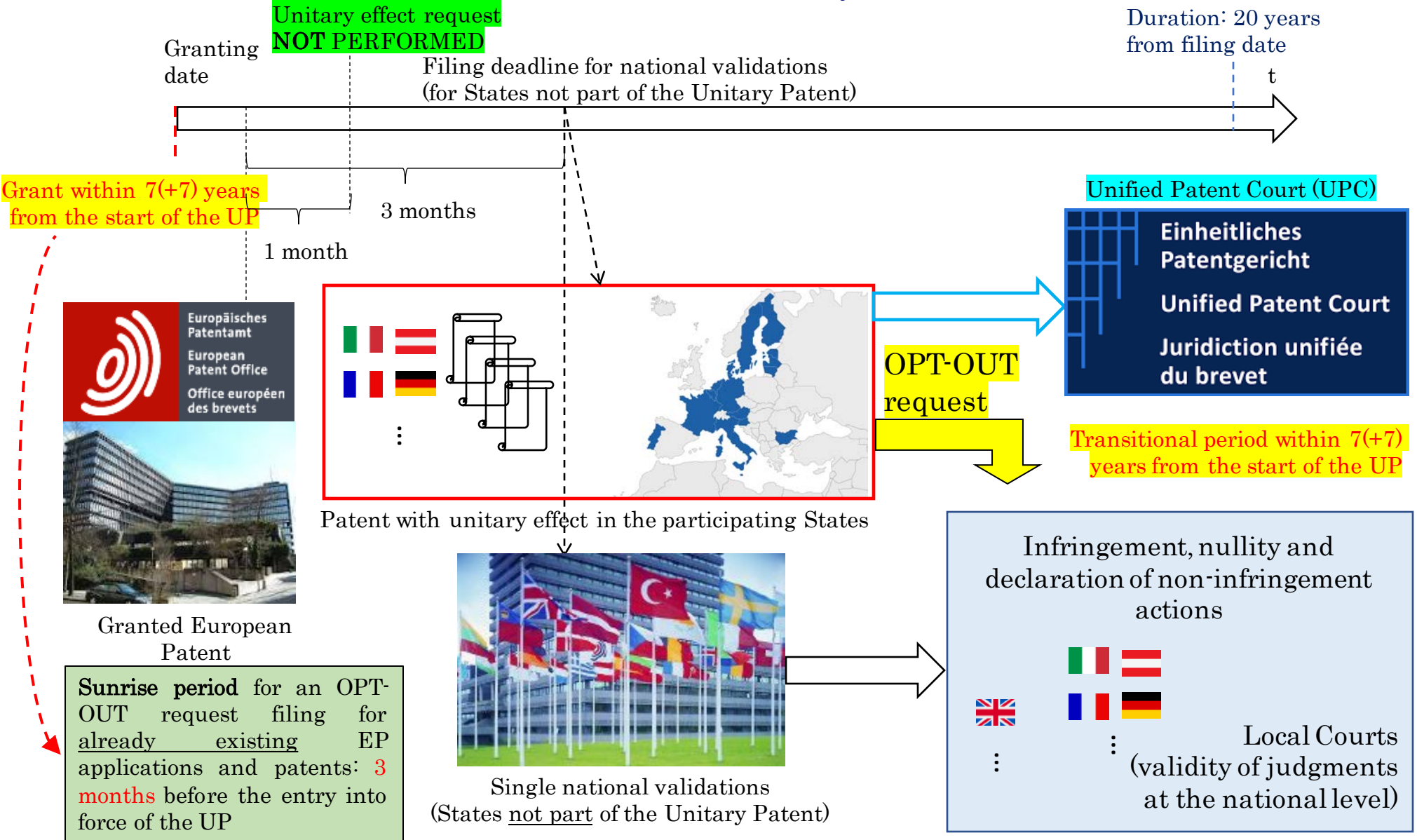


European patent applications that are still pending (therefore filed under the current legislation with a filing date not earlier than 1st March 2007) may be granted as :

- **Unitary Patents** (upon request of the owner within one month from the publication of the grant), with validity in the participating States, single annuity fee and jurisdiction of the Unified Patent Court (UPC) + single national validations for the States not participating in the UP but of interest to the owner.



PENDING EUROPEAN PATENT APPLICATIONS (after the start of the Unitary Patent - UP)





PENDING EUROPEAN PATENT APPLICATIONS (after the start of the Unitary Patent - UP)

European patent applications that are still pending (therefore filed under the current legislation with a filing date not earlier than 1st March 2007) may be granted as:

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- **“Traditional” European Patents** by filing the single national validations in all the States of interest, participating or non-participating in the UP.

Once granted, European patents, even if not transformed into Unitary Patents, fall under the jurisdiction of the Unified Patent Court (UPC) whose judgements will be valid in all participating States (currently 17) in which the patent right is in force as UP or national validation,

This will happen unless an **OPT-OUT request** is filed and jurisdiction is brought back to the individual national courts, which is possible in a **transitional period of at least 7 years**. There is a unique possibility for the patent owner to **withdraw** the OPT-OUT request, so as to definitively transfer the competence back to the UPC.

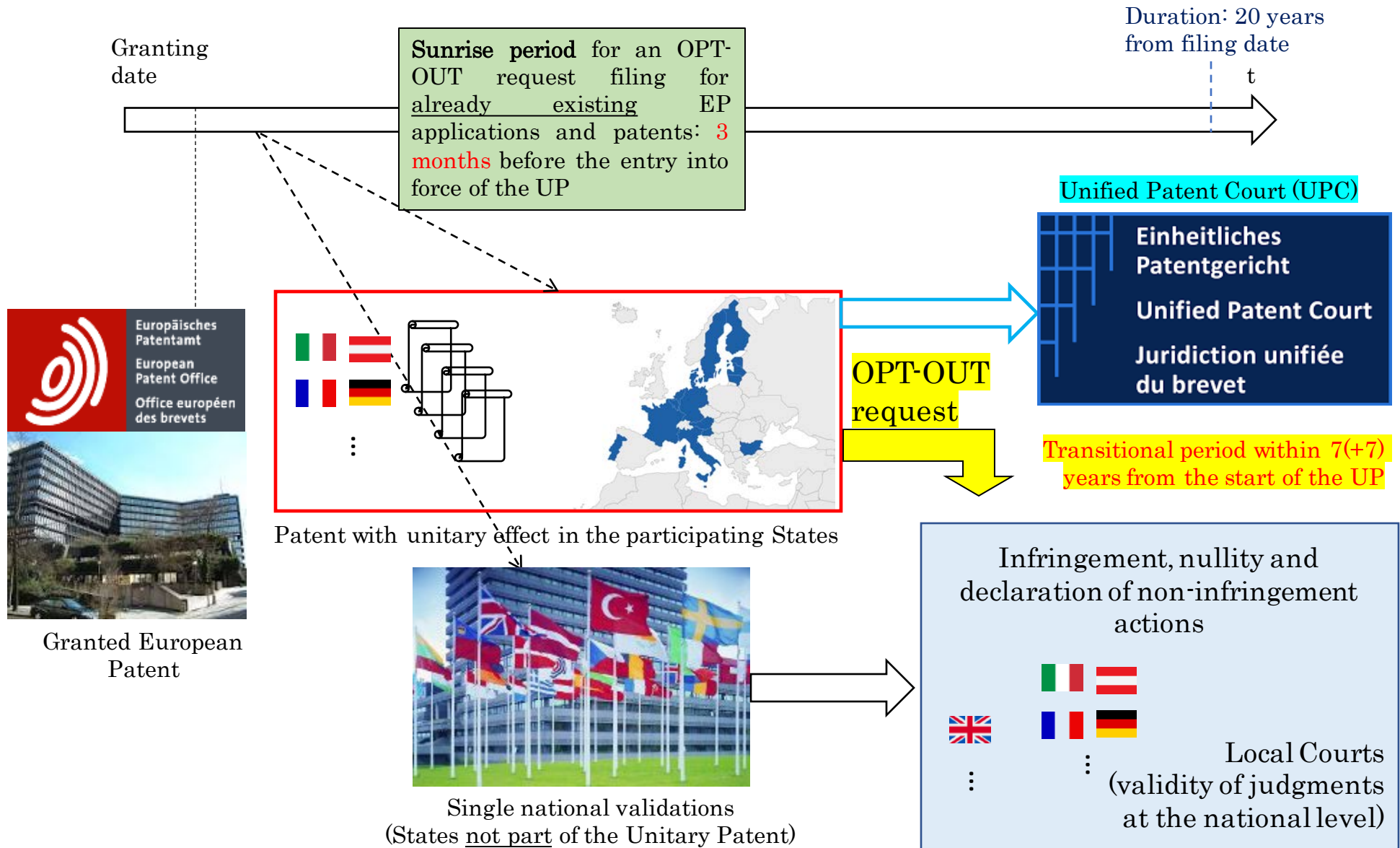


IT IS NOT POSSIBLE TO REPEAT THE OPT-OUT

Obviously, European patents granted and validated in non-participating States continue falling under the jurisdiction of the single national courts, whose judgements are only valid for the related national validation.



Already GRANTED EUROPEAN PATENTS (after the start of the Unitary Patent - UP)





Already GRANTED EUROPEAN PATENTS (after the start of the Unitary Patent - UP)



European patents already granted based on the existing legislation are not retroactively transformed into Unitary Patents, their protection not extending to the 17 States currently adhering to the same but remaining limited to the States in which the single national validations were filed at the time.

The **Unified Patent Court (UPC)** will have jurisdiction over lawsuits (both infringement and nullity ones) which also involve European patents already granted under the old legislation (which have a filing date not earlier than 1st March 2007), whose judgements will be valid simultaneously in all States participating in the UP in which the necessary national validation has already been filed.

This is unless the Owners file an **OPT-OUT request**



OPT-OUT Request -> Timing:

- within the Sunrise Period
(**3 months** before the entry into force of the UP)
- any time

also patents that are under an opposition procedure

BUT

Possibility of lawsuit, as soon as the Unitary Patent procedure has started

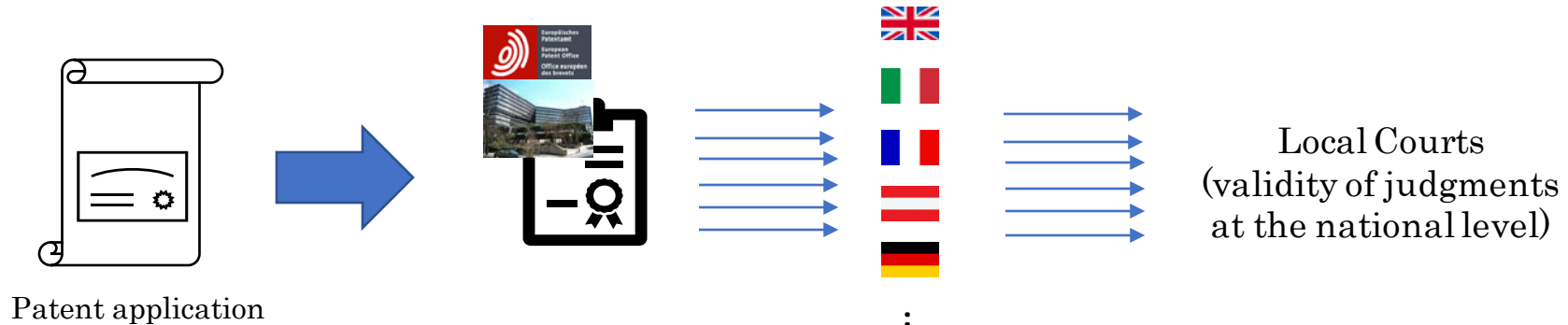


No OPT-OUT possibility

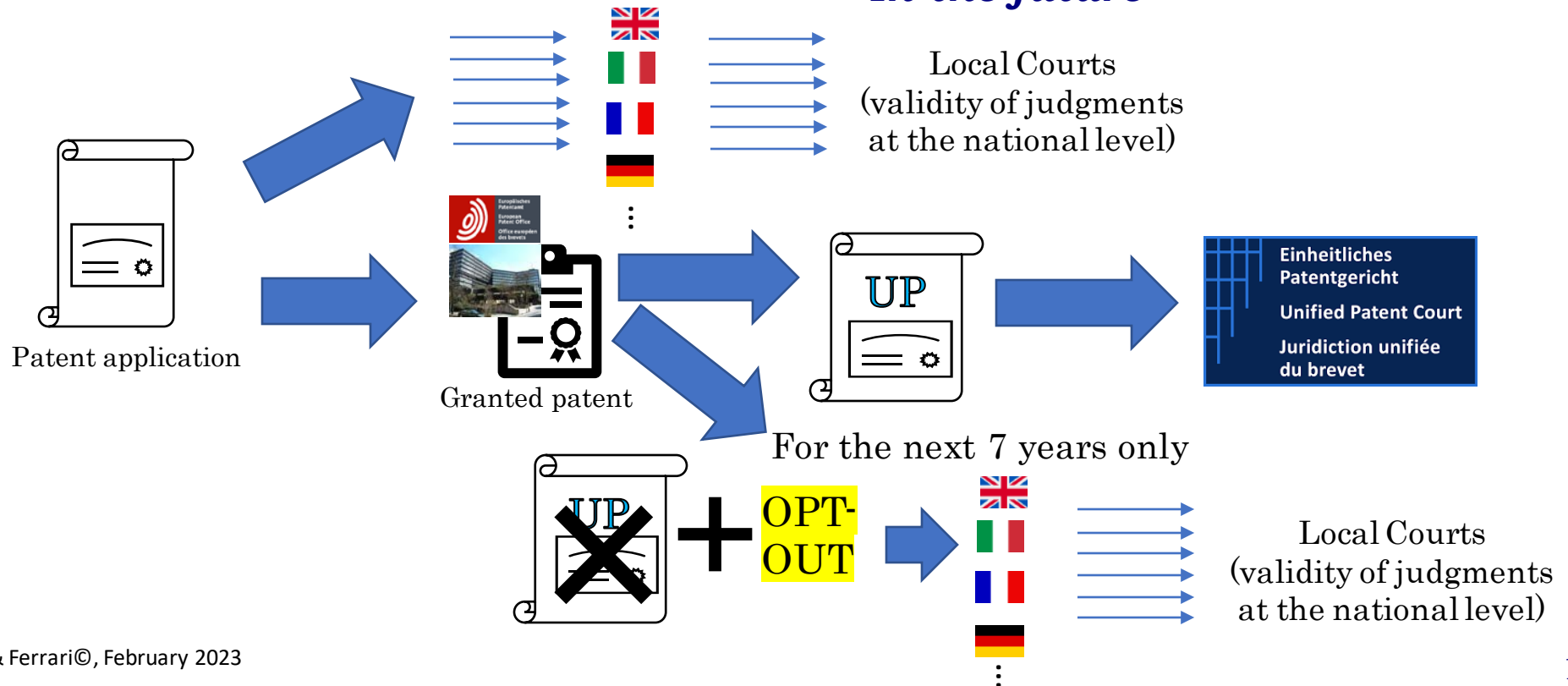


SUMMING UP...

So far



In the future





THE UNIFIED PATENT COURT (UPC)

The Unified Patent Court (UPC) is a court common to the EU member States in which a related agreement will be in force (currently the 17 States that have already joined the Unitary Patent are expected).

The UPC has exclusive jurisdiction over **European patents with unitary effect (UP)**.

The UPC also has jurisdiction over “**classical**” **European patents**, subject to exceptions during a transitional period of at least seven years; during this period, actions relating to “classical” European patents may still be brought before national courts or other competent national authorities. Furthermore, “classical” European patents can be excluded from the UPC jurisdiction by means of an OPT-OUT request.

The UPC includes:

- a First Instance Court, with central Divisions (currently, Paris and Munich) as well as local or regional Divisions in the Member States;
- a Court of Appeal in Luxembourg;
- a Patent mediation and arbitration centre.

Before a central Division, the procedural language is the one in which the patent was granted (English, French, or German).

Before a local or regional Division, the procedural language is an official language of the State hosting the concerned Division, or one of the official languages designated by the States sharing a regional Division. States may also designate one or more official languages of the European Patent Office (English, French, or German) as the procedural language of their local or regional Division.



SOME COSTS of the Unified Patent Court (UPC)

The Unified Patent Court (UPC) provides for a system of fixed government fees + a possible additional fee based on the value of the action.

The additional value-based fee may be payable for:

- Infringement actions
- Counterclaims for infringement
- Actions for declaration of non-infringement
- Statutory indemnity actions
- Claims for damages

The UPC fees obviously represent just a portion of the actual expenses to be incurred for a lawsuit, as there are additional costs for technical/legal support, any translations, out-of-pocket travel expenses where applicable, etc.

It is understood how the costs of actions before the UPC may be much higher than the usual costs to be faced before national courts, and therefore the use of these tools and a possible OPT-OUT strategy are to be carefully evaluated.

Source: https://www.unified-patent-court.org/sites/default/files/upc_documents/ac_05_08072022_table_of_court_fees_en_final_for_publication_clean.pdf



FOR INSTANCE...

Infringement action before the UPC:

- basic fee of **11,000 €**



- **a variable amount between 0 € and 325,000 €** based on the value of the action (if greater than 500k€, incrementally up to 50m€).

Nullity action of a patent before the UPC:

- basic fee for an amount of **20,000 €**, regardless of the value of the action.

BUT



THE HIGH COSTS WILL BE CAUSED BY REPRESENTATION COSTS FOR TECHNICAL/LEGAL SUPPORT

as an order of magnitude → increase by a factor of 5 compared to an Italian lawsuit.



SUMMING UP...

Court competence during the transitional period

