

Bird & Bird

The Unitary Patent (UP) & Unified Patent Court (UPC)

The Essentials

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The UP & UPC: The Essentials

UP Package

- The system started on June 1st, 2023.
- One single patent right, the Unitary Patent (UP), enforced through a single court, the Unified Patent Court (UPC), covering a large part of the EU.
- Transitional period of 7, possibly extending for up to another 7 years, during which both the UPC and national courts have jurisdiction over traditional European Patents (EPs).

Unitary Patent (UP): Essentials

- One patent, granted through the EPO, covering most of the EU.
- One renewal process, at advantageous cost (approx. the same as the renewal fees for four EU countries) compared to paying multiple national fees to maintain EPs.
- One injunction granted through one procedure in UPC. Similarly, one procedure to invalidate patent.

Unified Patent Court (UPC): Essentials

- Single court with jurisdiction over infringement, invalidity and other matters, for UPs and traditional EPs (subject to opt-out) for most of EU.
- Effective procedures for preliminary relief and evidence preservation.
- Experienced and trained patent judges supported by technical judges.

UP Package – what should I do?

- Consider whether to opt out existing (if not already done) and newly granted EPs in your portfolio so that the UPC will not have jurisdiction over them.
- Consider requesting unitary effect for newly granted patents before the EPO.
- Review licences in and out for coverage, control of opt-out and rights of action.
- Consider preparing protective letters for products at risk of infringement in EU.
- Consider status of non-UPC EU countries, in particular Spain and Poland.
- Consider status of non-EU countries covered by the EPC, in particular UK and Turkey.

UPC v national courts

UPC

One procedure and one decision for most of EU for each patent.

Same powers e.g., for preliminary relief or preservation of evidence available regardless of location of infringement (within the UPC region).

Uncertainty at present about how procedure and powers will be interpreted.

There is the ability to bifurcate infringement and validity, but indications are that such power will be sparingly used.

Specially trained and appointed patent judges, including technical judges.

Jurisdiction over UPs and EPs. No jurisdiction to deal with national-filed patents and opted-out EPs.

No jurisdiction to handle certain patent-related issues, in particular issues of entitlement, nor other subject matter such as associated tort or trade secrets-based claims, or claims based on other IP rights such as design rights.

Various language options: all UPC divisions will permit English to be used.

Costs of comparable cases in UPC should be comparable.

National courts

Multiple procedures and decisions for each patent.

Despite the IP Enforcement Directive, substantial differences remain between different countries' approaches to preliminary relief and tools for preserving evidence.

Relative certainty, in most countries, about how most procedures and powers will be interpreted.

Uncertainty in other countries where patent litigation is rare – especially smaller countries.

Judicial experience with patent or technical matters varies by country.

Jurisdiction over national patents and, for the transitional period of 7 to 14 years, EPs. Exclusive jurisdiction over opted-out EPs. No jurisdiction over UPs.

Each court has jurisdiction over all issues for national or EP-nationalised patents in that country together with associated claims permitted under the laws of that country or over which the court may have jurisdiction.

Most national courts require proceedings to be conducted in the local language.

Costs of comparable cases in different national courts differ substantially. With multiple actions, costs can multiply quickly.

UP v traditional EP v national patents – comparison

UP	Traditional EP	National patent
Single application process and single right granted by EPO covering most of EU (currently 17 and up to 24 countries).	Single application process leading to grant decision by EPO for all EPC countries (39 in Europe), allowing applicant to validate in countries of choice.	Separate application process and grant decision in each country's own patent office.
Claims must be the same for all countries.	Claims may be different for different EPC countries if required.	Claims may be and quite likely to be different in different countries.
Expected to be cheaper than validating an EP in many countries but commit to UP-scale of fees for life of patent.	Cost of validating in many countries more expensive than UP but can allow patents to lapse in countries that become unimportant over life of patent.	Cost of maintaining patent in many countries likely to exceed that of a UP.
Minimal translation requirements.	Translation requirements for validation vary by country.	Patents generally prosecuted and granted in national languages.
Patentee may declare willingness to license patent for 15% reduction in renewal fees.	Licensing of right and similar regimes differ by country.	Licensing of right and similar regimes differ by country.

Contacts

We have 21 offices across the major economies of Europe and a presence in all major UPC division jurisdictions. Our team is here to guide you on the practical and commercial steps to future proof your IP for when the new system comes into force. Please get in touch with any of the team below if you need advice.



Anne-Charlotte Le Bihan

Partner, France

+33142686362
anne-charlotte.lebihan@twobirds.com



Elisabetta Bandera

Partner, Italy

+390230356021
elisabetta.bandera@twobirds.com



Daniela Kinkeldey

Partner, Germany

+498935816000
daniela.kinkeldey@twobirds.com



Wouter Pors

Partner, Netherlands

+31703538823
wouter.pors@twobirds.com



Boris Kreye

Partner, Germany

+498935816000
boris.kreye@twobirds.com



Domien Op de Beeck

Partner, Belgium

+3222826046
domien.op.de.beeck@twobirds.com



Giovanni Galimberti

Partner, Italy

+390230356021
giovanni.galimberti@twobirds.com



Christopher Maierhöfer

Partner, Germany

+498935816000
christopher.maierhoefer@twobirds.com



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