

The Unitary Patent: Strategy, Opportunity and Risks

There are good reasons to seek a Unitary patent, and to opt into the UPC, and there are also reasons why a Unitary Patent might not be the right choice for everyone.

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Outline

The Unitary Patent and the Unified Patent Court (UPC) were slated to come into effect at the end of 2017. For a variety of reasons, that deadline has come and gone without Europe ushering in a unified patent system. The new target for the beginning of the much-anticipated unified system is December 2018.

While there may be several good reasons to seek a Unitary patent, and to opt into the UPC, there are also a number of reasons why a Unitary Patent might not be the right choice, and important strategic reasons exist for opting out of the UPC – decisions that should not be left to the last minute. Furthermore, Germany has chosen to allow double patenting, which means even if you opt into the UPC, obtaining a separate German patent as a hedge seems extremely wise.

This webinar will feature a frank discussion of the pros and cons of the Unitary Patent and the Unified Patent Court. This webinar will address: (1) What you need to know about the Unitary Patent and the UPC; (2) Pros and Cons of the Unitary Patent; (3) Pros and Cons of opting out of the UPC; and (4) Obtaining a German patent as a hedge against uncertainty.



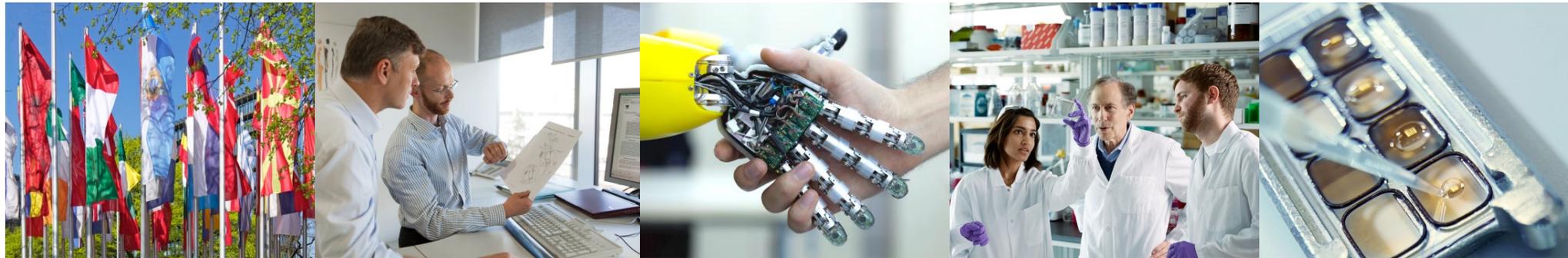
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The Unitary Patent: Strategy, Opportunities and Risks



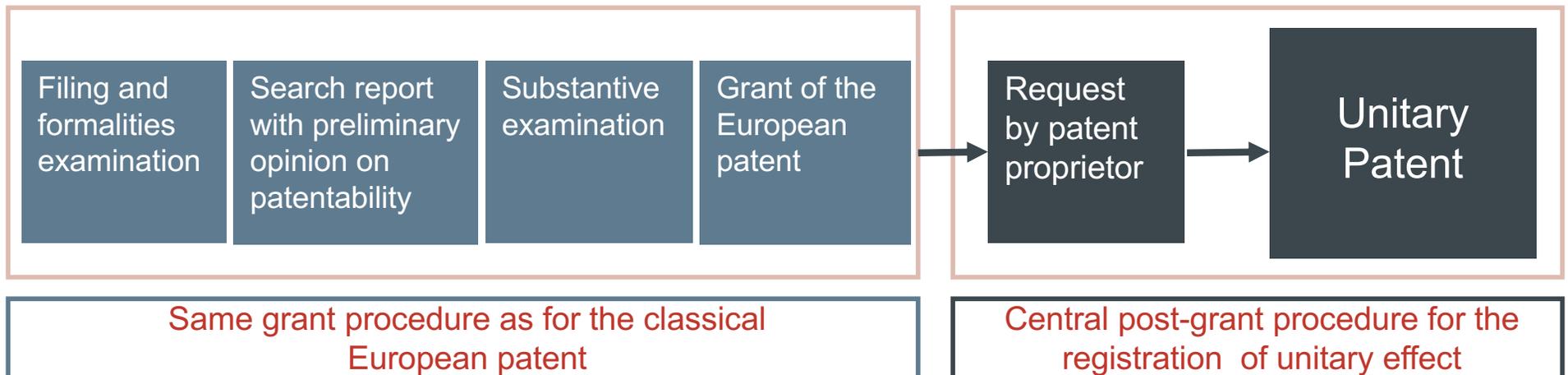
Michael Fröhlich

IPWatchdog.com webinar
18 January 2018

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Basic concept of the Unitary Patent (cont'd)



Some of the key benefits

- **Broader territorial protection** → Uniform protection for up to 26 participating MS.
- **Cost efficiency:**
 - No fee will be charged for filing, examination or registration of a Unitary Patent.
 - Business-friendly renewal fee pattern.
 - “True top 4” – Fees will be less than € 5.000 in the first 10 years – the current average lifetime of a EP.
 - Based on a comparison of fees and all associated costs, a Unitary Patent will on average be significantly less expensive than a European patent validated and maintained in four countries.
- **Reduction of red tape** → One-stop-shop at the EPO instead of national validation and translation requirements and fee payments with several national patent offices.
- **Better business opportunities** → More flexibility for trade and investment in the EU Single Market and enhanced opportunities for licensing and technology transfers.
- **Increased legal certainty and reduction of litigation costs** → Centralised enforcement thereby reducing costs and complexity resulting from the risk of multiple litigation in different jurisdictions.

State of implementation at the EPO

- EPO will offer three online filing options for the Unitary Patent (eOLF, CMS, WFF)
- Electronic filing tools are very simple and straightforward to fill in, and are designed in a way to avoid possible procedural/formal errors.

The screenshot shows the EPO case management system interface. At the top, there is a header with the EPO logo and the text "EPO case management system" in German, English, and French. Below the header, there are navigation tabs for "Applications", "Templates", "Address book", "System messages", "Account management", and "Online help". A user profile for "Elodie Kleboe - Applicants" is visible. The main content area displays case details: "Procedure: UP", "Reference: DEMO-PPT", "European application No.:", and "European patent No.:". A "Validation messages (5)" section is highlighted in red. Below this, there is a "Demo" section with a "Draft | Signed | Submitted" status. A sidebar on the left contains a list of menu items: "Unitary effect", "Patent & Application no.", "Proprietor", "Representative", "Address for correspondence", "Translation", "Documents", "Fee sheet", "Dates", and "History". A table titled "Unitary effect" is displayed with the following data:

Language of proceedings	Compensation for translation costs	Language of translation
English	Yes	

The screenshot shows the EPO Online Filing interface for a Unitary Patent (UP(7000) - Draft - EPO-UP7000). The interface includes a menu bar with "File", "Edit", "View", "Tools", "Windows", and "Help". The main content area displays the "Request" tab, which contains the following information:

- Unitary effect: Place of business at filing | Compensation
- European patent has been granted with the same set of claims in respect of all participating member states (Rule 5(2) UPR).
- European patent No.: EP _____
- Title of invention:
- European application No.: EP _____
- Date of mention of grant: dd.mm.yyyy

At the bottom, there is a disclaimer in German and French: "Hiermit wird einheitliche Wirkung für das vorstehend genannte Patent beantragt/ Unitary effect for the above-mentioned patent is hereby requested/ Un effet unitaire est demandé pour le brevet susmentionné".

State of implementation at the EPO (cont'd)

- New Forms will be available:
 - Use of trilingual EPO FORM 7000 highly recommended (not mandatory though) when filing on paper/fax/by person
 - Advisable to carefully read Explanatory notes to Form 7000
- Payments will be very easy and possible by
 - payment or transfer to a bank account held by the EPO,
 - debiting a deposit account held with the EPO,
 - using the Online Fee Payment service (OFF), or
 - credit card.



Europäisches Patentamt
European Patent Office
Office européen des brevets

Antrag auf einheitliche Wirkung
Request for unitary effect
Demande d'effet unitaire

Tag des Eingangs: nur für Internet-Einreichung
Date of receipt: for internet use only
Date de réception: usage réservé à un usage internet

1. Angaben zum Patent (Regel 6 (2) b) DOEP/2)
Data concerning the patent (Rule 6(2)(b) EPC)
Données concernant le brevet (règle 6(2)b) RPU)

1.1 Nummer des europäischen Patents /
European patent No. /
Numéro du brevet européen

1.2 Nummer der europäischen Anmeldung /
European application No. /
Numéro de la demande européenne

1.3 Tag des Hinweisess auf die Erteilung /
Date of mention of the grant /
Date de la mention de la délivrance

1.4 Zeichen des Patentinhabers oder Vertreters (max. 15 Zeichen) /
Proprietor's or representative's reference (max. 15 characters) /
Référence du titulaire du brevet ou du mandataire (max. 15 caractères)

1.5 Das europäische Patent wurde mit den gleichen Ansprüchen für alle teilnehmenden Mitgliedsstaaten erteilt (Regel 5 (2) DOEP/2) /
European patent has been granted with the same set of claims in respect of all participating member states (Rule 5(2) EPC) /
Le brevet européen a été délivré avec le même jeu de revendications pour tous les Etats membres participants (règle 5(2) RPU)

2. Antrag / Request / Demande

2.1 Hiermit wird einheitliche Wirkung für das vorstehend genannte Patent beantragt /
Unitary effect for the above-mentioned patent is hereby requested /
Un effet unitaire est demandé pour le brevet susmentionné

2.2 Hiermit wird die Kompensation von Übersetzungskosten beantragt (Regel 9 DOEP/2). Der/Each Patentinhaber erklärt hiermit, dass er gegebenenfalls der ursprüngliche Anmelder eines Patents ist oder eine natürliche Person nach Regel 8 (2) und (4) DOEP/2 ist. /
Compensation for translation costs is hereby requested (Rule 9 EPC). The/Each proprietor hereby declares that he, she or it is either the original applicant to an entry or a natural person under Rule 8 (2) and (4) EPC. /
Une compensation des coûts de traduction est demandée (règle 9 RPU). Le/Chaque titulaire du brevet déclare qu'il est soit le demandeur original ou une personne physique au sens de la règle 8 (4) RPU)

2.2.1 Es wird beantragt, die Kompensation per Überweisung auf das in Abschnitt Nr. 9 dieses Formblatts angegebene Konto beim EPA zu zahlen. /
Compensation for translation is requested to be transferred to the EPO deposit account mentioned in section 9 of this form. /
Il est demandé que la compensation soit versée par virement sur le compte courant ouvert auprès de l'OEB qui est indiqué à la rubrique 9 du présent formulaire.

2.2.2 Es wird beantragt, die Kompensation per Scheck zu zahlen. /
Compensation for translation is requested by cheque. /
Il est demandé que la compensation soit versée par chèque.

3. Übersetzung / Translation / Traduction

3.1 Verfahrenssprache ist Englisch. Eine Übersetzung des europäischen Patents in einer der anderen Amtssprachen der Europäischen Union (Regel 6 (2) d) DOEP/2) ist beigefügt, nämlich: /
Language of proceedings is English. A translation of the European patent into one of the other official languages of the European Union (Rule 6(2)(d) EPC) is enclosed, namely: /
La langue de la procédure est anglaise. Une traduction du brevet européen dans une autre langue officielle de l'Union européenne (règle 6(2)d) RPU) est jointe, à savoir dans la langue suivante: Sprache / Language / Langue

3.2 Verfahrenssprache ist Deutsch oder Französisch. Eine Übersetzung des europäischen Patents in Englisch (Regel 6 (2) d) DOEP/2) ist beigefügt. /
Language of proceedings is French or German. A translation of the European patent into English (Rule 6(2)(d) EPC) is enclosed. /
La langue de la procédure est le français ou l'allemand. Une traduction en anglaise du brevet européen (règle 6(2)d) RPU) est jointe.

EPN/EP0/03/2001_01/7

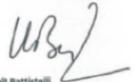
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State of implementation at the EPO (cont'd)

- New UP Register will be integral part of the European Patent Register, but designed separately

The screenshot shows the European Patent Register interface. At the top, there is a header with the EPO logo and name in German, English, and French, along with a 'Contact' link. Below this is a navigation bar with 'About European Patent Register' and 'Other EPO online services'. A search bar is present with options for 'Smart search', 'Advanced search', 'Search results', and 'Help'. The main content area displays the details for patent EP1234567 C0. The title is 'EP2326124 - CARRIER SWITCHING METHOD AND SYSTEM WITHIN BASE STATION'. The status is 'Unitary effect registered' with a database update date of 14.04.2016. The most recent event is a 'Public notification' dated 29.02.2016, published on 02.03.2016. The proprietor is 'Schumacher, Ines', located at 'Frühlingstrasse 43, D-45133 ESSFN / DE'. The patent is a 'Unitary Patent'.

State of implementation at the EPO (cont'd)

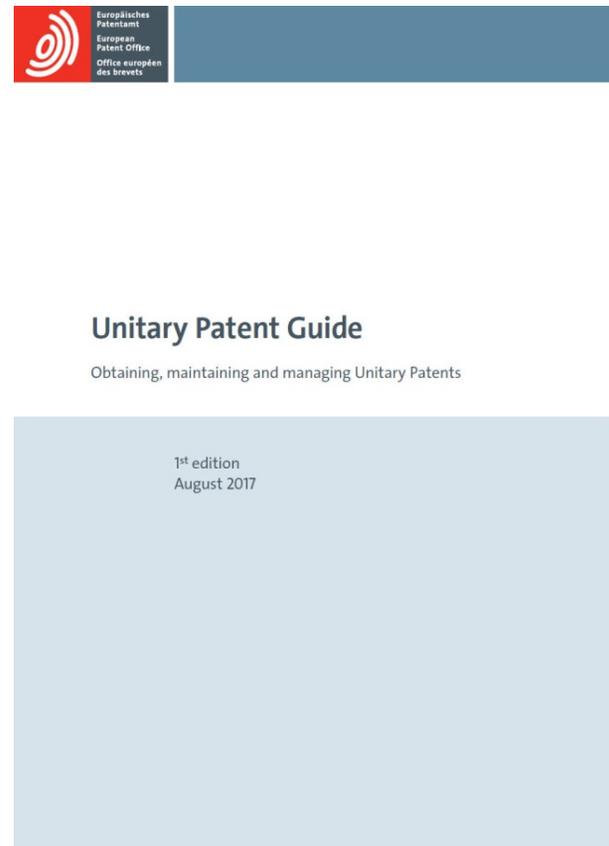
URKUNDE	CERTIFICATE	CERTIFICAT
Einheitliches Patent	Unitary Patent	Brevet unitaire
Hiermit wird bescheinigt, dass die einheitliche Wirkung für das nachstehende Patent im Register für den einheitlichen Patentschutz eingetragen wurde.	It is hereby certified that unitary effect has been registered in the Register for unitary patent protection for	Il est certifié que l'effet unitaire a été inscrit au registre de la protection unitaire conférée par un brevet pour
Europäisches Patent Nr. European patent no. Brevet européen n°	1052769	
Tag der Eintragung Day of registration Date d'inscription	10.05.2015	
Territorialer Geltungsbereich Territorial scope Champ d'application territoriale	AT, BE, BG, DE, DK, FI, FR, IT, LU, MT, PT, SE, GB, HR, CY, MK, GR	
Tag des Eintritts der Wirkung Day of effect Date de prise d'effet	01.01.2018	
Patentinhaber Proprietor(s) of the patent Titulaire(s) du brevet	Dodd, Chris Alexander 1 Tackley Place Oxford, Oxfordshire OX26 6RR/GB Hunsley, Colin 251 Kempshott Lane Basingstoke Hants RG22 5LZ/GB O'Connor, John Quarry Manor 9 Beaumont Road Headington Oxford, Oxfordshire OX36 3JN/GB Murray, David Wycliff OudBeeson House Whinsley Road Oxford, Oxfordshire OX44 9HB/GB	
		
		
		Benoît Battistelli Präsident des Europäischen Patentamts President of the European Patent Office Président de l'Office européen des brevets
München, den Munich, le Munich, le	01.01.2018	

- EPO will issue a certificate to document that unitary effect has been registered.
- The certificate will also include some information about the date of registration, the territorial scope and the patent holder.

State of implementation at the EPO (cont'd)

▪ Unitary Patent Guide

- Provides companies, inventors and their representatives with an outline of the procedure involved in obtaining a Unitary Patent.
 - Deals also with the accessory procedures relating to Unitary Patents (eg compensation scheme for translation costs, registering a statement on licences of right) and gives overview of the rules on how to pay renewal fees for Unitary Patents).
- Available at: www.epo.org/law-practice/unitary/unitary-patent/unitary-patent-guide.html



Accompanying measures at EU and at national level

- Supplementary Protection Certificate (SPC).
 - Unitary SPC envisaged by the European Commission, but this is likely to raise a number of challenges and may not be achievable in the short term. Pending the creation of Unitary SPCs, the Commission will clarify that national SPCs can be obtained on the basis of a UP.
- National validations in case request for unitary effect is rejected after expiration of the national deadline for validations.
 - Safety net system implemented or in the process of being implemented in a number of countries.
- Double protection between European patents that are subject to the jurisdiction of the UPC and national patents.
 - Double-protection for the same invention by a Unitary Patent and a classical European patent on the territory of the 26 participating Member States is not allowed.
 - Question whether double-protection by a Unitary Patent and a national patent is possible has been left open in the Regulation and is to be decided at national level.

State of implementation at the UPC

- Preparatory Committee finalized its work after 19 meetings in April 2017. Work resulted in, e.g.:
 - Finalisation of the secondary legislation incl. 18th draft version of the Rules of Procedures. Formal adoption by the UPC Administrative Committee during Provisional Application Phase.
 - Agreement on final suite of legal, HR and financial documents.
 - Judicial recruitment process launched on 12 May 2016. 840 application received. Finalisation of recruitment process during provisional application phase.
 - Case management system (CMS): Users have access to the latest CMS-version which has been tailored for the preparation of the Sunrise opening with an emphasis on opt-out.
- Operational team is overseeing the final preparations.
- A number of Member States who will host a UPC division have already confirmed their locations and provided the premises.

When will the new system start?

- The Unitary Patent Regulations are in force for 26 EU Member States. But they apply only from the date of the entry into force of the UPCA, which is expected in 2H2018:
 - UPCA enters into force on the first day of the fourth month after the deposit of the 13th instrument of ratification, incl. the three most patent intensive contracting states (i.e. FR, DE and UK).
 - So far, fourteen EU Member States have deposited their instruments of ratification incl. FR. More are in the pipeline making it reasonable to expect that operations will begin with closer to 20 contracting states.
 - UK: Announced to proceed with ratification despite Brexit-vote. Last outstanding steps have been completed in Scottish Parliament and are about to be completed in the UK Parliament. It is expected that the UK will be in a position to ratify by February 2018.
 - DE: parliamentary approval for the ratification has been obtained on 31 March 2017. But a complaint is currently pending at the German Federal Constitutional Court. This causes delay to the German ratification of the UPCA and the Protocol on Provisional Application.

**For more information on the Unitary Patent package
please check www.epo.org/unitary**



Thank you for your attention!

Michael Fröhlich
Director, European and International Legal Affairs, PCT

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www.epo.org



Translation Requirements
Under the UPC

The UPC is only open to the 28 members of the European Union.
 3 of the 28 EU countries have chosen not to participate...
 Which means EP Validation will still be required.

 EU countries that chose not to participate	Translation Requirements				
	Specification	Claims	Figures	Abstract	None*
 Croatia		✓			
Poland	✓	✓	✓		
Spain	✓	✓	✓		

The other 25 EU Member States signed the UPC Agreement on February 19, 2013.
 11 of those signatory countries have still not ratified it...meaning EP Validation will still be required.

Signatory countries that have not ratified		Translation Requirements				
		Specification	Claims	Figures	Abstract	None*
	Cyprus	✓	✓	✓	✓	
	Czech Republic	✓	✓	✓		
	Germany					✓
	Greece	✓	✓	✓	✓	
	Hungary		✓			
	Ireland					✓
	Latvia		✓			
	Romania	✓	✓	✓		
	Slovakia	✓	✓	✓		
	Slovenia		✓			
	United Kingdom					✓

**There are no translation requirements for countries that are part of the London Agreement.*

10 EPO countries are not part of the EU.
 Non-EU countries can not participate in the UPC...
 Which means EP Validation will still be required.

EPO countries not covered by the UPC		Translation Requirements				
		Specification	Claims	Figures	Abstract	None*
	Albania		✓			
	Iceland		✓			
	Macedonia		✓			
	Monaco					✓
	Norway		✓			
	San Marino	✓	✓	✓	✓	
	Serbia	✓	✓	✓		
	Switzerland/ Liechtenstein					✓
	Turkey	✓	✓	✓	✓	

**There are no translation requirements for countries that are part of the London Agreement.*