

Unitary Patent and Unified Patent Court

The option to centrally protect granted European patent rights in multiple countries via the Unitary Patent (UP) system has been available since 1 June 2023. The Unified Patent Court (UPC) also opened its doors on that date and is the sole forum for litigation involving UP rights as well as being available to hear litigation involving some other European patent rights.

What is the Unitary Patent (UP)?

European patents are applied for centrally at the European Patent Office (EPO) and historically on grant these have been converted into a bundle of individual national patent rights via the validation process. The UP allows a patentee to choose a UP validation when their European patent grants and this gives a unitary patent right providing protection in all EU states that have signed up to the UP at that time.

The countries that are currently covered by a UP validation are Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia and Sweden.

As an alternative, the patentee is able to obtain protection in any or all of the countries covered by a European patent application by national validations following the traditional route. Further, even if a UP validation is requested the patentee can still protect the invention in any other desired countries that are not covered by the UP.

This means that the patentee may end up with just a UP, or just a bundle of separate national patents, or a bundle made up of a UP and separate national patents.

What is the deadline for requesting a UP?

A request for a UP validation must be filed within one month after grant of the European patent.

In contrast, the deadline for converting a European patent into a bundle of individual national patent rights is normally three months from grant.

What are the translation requirements for a UP?

A translation of the complete specification into one other official language of an EU state is required for an English language specification; patents that grant in French or German must be translated into English. This cannot be a machine translation.

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The translation can be filed late, which is useful since the one-month UP validation window is fairly short. In this regard, a UP validation can be requested without filing the translation, and then a new one-month term is set for filing the translation.

What is the cost of requesting a UP?

The costs of requesting a UP will normally be the same magnitude as traditional validation in one country that requires a full translation of the granted patent into its local language.

However, in cases where the patentee chooses a UP alongside a national validation in a country where a full translation into an EU language is required (e.g. Spain, the Czech Republic, or Poland), the cost of a UP will be significantly reduced because the translation can be re-used. The cost for the UP validation will then be the same magnitude as traditional validation in one country that does not require any translation.

What is the cost of maintaining a UP?

There is a single renewal fee each year to maintain the UP in all countries, because it is a unitary right. The official renewal fees for the UP were set to match the official fees for renewing a patent over its 20-year term in Germany, France, the UK and the Netherlands, but were weighted to make the first 10 years cheaper than the second 10 years.

There is only be a single service charge, because there is a single official fee to pay, rather than there being a professional charge per country to pay the local renewal fees in each country.

This is clearly good value if most or all of the 18 countries are of commercial interest. However, it is a less clear-cut decision if the patentee generally only validates a patent in two or three countries. Equally, there is an additional cost to be factored in for any countries that are not part of the UP, which still need to be protected and renewed separately.

Importantly, under a UP validation, the payment of a single annual renewal fee for all countries covered means that the patentee cannot reduce their renewal cost by letting protection lapse in countries that become of less importance over time.

What are the pros and cons?

The key benefit is value for money. As discussed above, a UP validation can be obtained to provide protection for 18 countries at a cost that is approximately comparable to obtaining protection in just a single country. Meanwhile, the ongoing annual renewal costs will be comparable to renewing in three or four EPC countries.

A downside is that the UP stands or falls as a single right throughout its lifetime. A UP validation falls under the jurisdiction of the Unitary Patent Court (UPC), rather than the existing national patent court systems. This means that a single ruling is given that applies across all 18 EU countries covered by the UP validation.

Therefore, patentees have to weigh up cost savings/greater country coverage for the same cost against the risk of losing their patent rights from a single centralised attack and being committed to renewing the UP even if only one country is of interest in later years.

The Unitary Patent validation route is of course optional, and we suggest that its use should be decided on a case-by-case basis.

What is the Unified Patent Court (UPC)?

The UPC has the power to both revoke and decide on infringement of UP validations for all participating member countries in a single action.

The UPC includes a court of first instance having a decentralised structure, spread over the member states; this includes a central division and a number of local/regional divisions. There is also a common Court of Appeal, with its seat in Luxembourg, and a Centre for Arbitration and Mediation, with seats in Ljubljana and Lisbon.

Advantageously, the UPC allows a patent owner to bring a single infringement action in a single court to obtain injunctions and damages for infringement of a patent throughout the countries covered by the UP. This avoids the cost and difficulty of bringing legal actions in many different countries.

However, a downside to the UPC structure is that a single invalidity action may be brought centrally against a UP, which if successful leads to the cancellation of the patent rights throughout all of the UP member states.

By default, the UPC also has jurisdiction over any patents obtained through traditional validation in any country that has ratified the UPC Agreement. This includes all of the UP countries.

However, it is possible to opt-out from the UPC for European patents where there are traditional validations, such that the UPC does not have jurisdiction over those traditional validations.

Should I opt out of the UPC?

During a transitional period lasting up to 1 June 2030, patentees who follow the traditional route of obtaining a European patent and converting this into a bundle of individual national patent rights can file an opt-out request, if they do not wish their granted European patent to fall within the jurisdiction of the UPC. There is the possibility that the transitional period could be extended by a further seven years.

However, it is not possible to request a UP validation and opt-out of the UPC; opting out is only possible if the patentee validates the EPO patent in the traditional way.

One strategy for patentees is to choose to opt-out, at least for their most valuable patents, to avoid the risk of central attack at the UPC. It is still possible to opt back in at a later date, in order to be able to bring infringement proceedings centrally, provided that no national court actions relating to the European patent have commenced at that time.

Once the transitional period has ended, existing opt-outs will remain in place, but it will no longer be possible to file any new opt-outs from the UPC's jurisdiction. Therefore, all European patents granted after that date will be subject to the UPC in respect of those EU countries that have ratified the UPC Agreement. For these countries, direct national filings would be the only way to avoid the use of the UPC.

What next?

If you would like more information, then please get in touch. You can email us at info@barkerbrettell.co.uk or call us on **+44 (0)121 456 0000**.

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