

Unitary Patent Information

1. What is a Unitary Patent (UP)?

A UP is a single patent right, covering a number of European countries with uniform effect, that is obtained by validating a European patent on the Register of Unitary Patents maintained by the European Patent Office. The UP system could start within a year of ratification by Germany – the main hurdle to implementation of the system. UPs can only be obtained based on European patents that are granted after the UP system enters into force. This information sheet aims to help your early planning. We will let you know the start date when it is officially confirmed.

2. What countries will it cover?

The coverage is determined by which European states have ratified the legislation¹ relating to the Unitary Patent on the day the European patent is granted. We refer to these states as **UP-participating states**. 25 European states are eligible to participate and all are expected to ratify the legislation in the next few years.

It is expected that, when the UP system comes into force, the initial UP-participating states will be at least Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Italy, Latvia, Lithuania, Luxembourg, Malta, Portugal, The Netherlands and Sweden, plus the UK and Germany – 17 states in total.

The 40 states that participate in the European patent system (EPC states and Extension States), along with their status in the new UP system, are shown to the right.

¹Participation requires ratification of the Agreement on the Unified Patent Court (UPC).

- Initial UP-participating state
- Eligible for UP participation
- Non participating state

<input type="checkbox"/> Albania	<input checked="" type="checkbox"/> Lithuania
<input checked="" type="checkbox"/> Austria	<input checked="" type="checkbox"/> Luxembourg
<input checked="" type="checkbox"/> Belgium	<input type="checkbox"/> Macedonia
<input type="checkbox"/> Bosnia & Herzegovina	<input checked="" type="checkbox"/> Malta
<input checked="" type="checkbox"/> Bulgaria	<input type="checkbox"/> Monaco
<input type="checkbox"/> Croatia	<input type="checkbox"/> Montenegro
<input checked="" type="checkbox"/> Cyprus	<input checked="" type="checkbox"/> The Netherlands
<input checked="" type="checkbox"/> Czech Republic	<input type="checkbox"/> Norway
<input checked="" type="checkbox"/> Denmark	<input type="checkbox"/> Poland
<input checked="" type="checkbox"/> Estonia	<input checked="" type="checkbox"/> Portugal
<input checked="" type="checkbox"/> Finland	<input checked="" type="checkbox"/> Romania
<input checked="" type="checkbox"/> France	<input type="checkbox"/> San Marino
<input checked="" type="checkbox"/> Germany	<input type="checkbox"/> Serbia
<input checked="" type="checkbox"/> Greece	<input checked="" type="checkbox"/> Slovakia
<input checked="" type="checkbox"/> Hungary	<input checked="" type="checkbox"/> Slovenia
<input type="checkbox"/> Iceland	<input type="checkbox"/> Spain
<input checked="" type="checkbox"/> Ireland	<input checked="" type="checkbox"/> Sweden
<input checked="" type="checkbox"/> Italy	<input type="checkbox"/> Switzerland
<input checked="" type="checkbox"/> Latvia	<input type="checkbox"/> Turkey
<input type="checkbox"/> Liechtenstein	<input checked="" type="checkbox"/> United Kingdom

3. Is a UP more cost-effective than traditional European validations?

This depends on the geographic extent of protection that you require, and the value to you of having additional geographic protection under the UP in states that you may not normally cover. Few patent owners validate in all 40 European states that are available via traditional national validations. The number of national validations varies widely, but typically patent owners validate in only 3-6 states.

Patent owners will have to decide on the value of having a UP according to their own particular requirements.

There are two cost factors to bear in mind – (1) the cost of the validation procedure (see Question 4 below); and (2) the annual renewal costs (see Question 5 below).

4. Regarding the cost of the validation procedure – will that be cheaper as a UP than separate national validations?

Validation as a UP requires a translation of the specification. To validate an English-language European patent as a UP, a translation into any other official language of the EU will be required. To validate a French- or German-language European patent as a UP, a translation into English will be required. The translation costs will vary from case to case.

Nevertheless, we expect that the cost of validating a European patent as a Unitary Patent will be lower than the cost of national validations in more than about 3 UP-participating states.

Note that the pre-grant procedure will remain the same – for example, we will continue to need to file translations of the claims after allowance of the European patent application, so that the patent is granted with claims in English, French and German.

5. Regarding the cost of renewal fees – will that be cheaper as a UP than separate national validations?

As a general guideline, it will be cheaper to annually renew a Unitary Patent than to individually renew 4 or more nationally-validated parts of the patent in the UP-participating states.

In more detail, the official fees for renewal of a Unitary Patent at current rates are set out in the table below. The first renewal fee that is payable for a Unitary Patent is for the Year that starts on the anniversary of filing, after the date of grant. For example, if the PCT or European patent application was filed on 5 January 2015 and the European patent is granted on 5 April 2018 and validated as a UP, the first post-grant renewal fee will be the fee that is payable for Year 5 (that is: the year from 5 January 2019 to 4 January 2020), and it will be due in January 2019:

Year	EPO fee €
2	35
3	105
4	145
5	315
6	475
7	630
8	815
9	990
10	1175

Year	EPO fee €
11	1460
12	1775
13	2105
14	2455
15	2830
16	3240
17	3640
18	4055
19	4455
20	4855

[Renewal Service will be provided by HL Renewals LLP]

6. Are there any other cost savings with a Unitary Patent?

We expect that the post-grant recording of licences and assignments will be substantially cheaper and less complex than the procedures in each national Patent Office.

7. Which court has jurisdiction over Unitary Patents?

The introduction of the Unitary Patent will be accompanied by the establishment of a new court – the Unified Patent Court (UPC). The UPC will have exclusive jurisdiction for all litigation involving UPs.

The UPC will also have jurisdiction for traditionally-validated European patents in the UP-participating states, although patent owners can choose to opt such patents out of that jurisdiction of the UPC. Please let us know if you require information about that procedure.

8. Are there any disadvantages associated with the all-in-one nature of a Unitary Patent?

Firstly, there is no freedom to exclude countries from a UP. Because it is one patent right, its coverage automatically extends to all the UP-participating states at the time when it was first validated (see Question 2 above).

That means that you cannot reduce renewal costs during the life of a UP by reducing the country coverage, as you can with traditional national validations. A UP will need to be renewed if even just one of its countries remains of interest.

Secondly, a UP automatically comes under the jurisdiction of the new UPC court, and cannot be “opted out” from that court’s jurisdiction

(see Question 7 above). Being under the UPC's jurisdiction is fine if you want to enforce the patent in the UPC – however, it is less attractive if you have competitors who may wish to apply for revocation of the patent or for a declaration of non-infringement in the UPC. A challenge to a UP at the UPC, if successful, would apply across all the countries that the UP covers.

This applies equally to Supplementary Protection Certificates (SPCs) based on a UP, which also come under the exclusive jurisdiction of the UPC. SPCs are rights which extend the term of protection for patented medicines and agrochemicals.

9. Can I convert a Unitary Patent into separate national patents later?

No. The unitary nature of the UP is fixed and cannot be changed later. Similarly, the jurisdiction of the UPC over all litigation involving the UP (and any SPCs based on it), is also permanent.

This rigidity contrasts with the greater freedom given to the owner of the nationally validated parts of a European patent in the UP-participating states. In that case, the patent owner can opt the patent out of the UPC's jurisdiction, so that the jurisdiction stays with the national courts in the UP-participating states that are covered (see Question 7 above).

10. What will be the impact of Brexit on the UK's participation in the UP system?

It is currently unclear whether the UK could continue to participate in the UP system after Brexit.

If continued participation is enabled by negotiation, then UPs will continue to have effect in the UK. If the UK leaves the UP system, then we expect that special provisions will be enacted to allow existing UPs to continue to have effect in the UK, effectively as national UK patents.

If the UK leaves the UP system, the level of the UP renewal fees may change, as the formula for calculating the UP renewal fees (see Question 5 above) would change from the current formula that includes a factor related to the national renewal fees charged by the UK Intellectual Property Office.

11. What should I do if I have an allowed European patent application and I want to obtain coverage in countries that are not participating in the UP system on the day the European patent will be granted?

Non-EU countries, Poland, Spain and Croatia

These countries are not able to participate either because they are outside the EU, or in the case of Poland, Spain and Croatia, they have chosen not to sign the Agreement on the UPC. You will need to continue to use the traditional national validation procedure for all of them.

For information: The non-EU countries referred to above are: Albania, Iceland, Macedonia, Monaco, Norway, San Marino, Serbia, Switzerland/Liechtenstein and Turkey. These are the non-EU countries that, depending on the patent's filing date, may be designated in a European patent. Subject to appropriate country-specific fees having been paid at the start of the EPO procedure, European patents may also be made effective in the non-EU countries Bosnia-Herzegovina and Montenegro (Extension States), and Morocco and the Republic of Moldova (Validation States).

Czech Republic, Cyprus, Greece, Hungary, Romania, Slovakia and Slovenia

These EU countries have signed the Agreement on the UPC but have not yet ratified it (and do not need to ratify it to allow the system to start). They are expected to ratify in the next few years. If you would like to have a UP covering any of these EU countries, you should ask us about the options to delay the grant of your European patent, or to file a divisional European patent application. This will buy time in the hope that the desired country(ies) will ratify the Agreement on the UPC in the relatively near future.

If that is not practicable, or if the additional costs are not warranted, then you will need to nationally validate the European patent in the traditional way for the EU countries on this list.

12. What should I do to use both unitary and national validation options in any or all of the UP-participating states?

You should ask us about the options to file one or more divisional European patent application, assuming that you have a pending European patent application.

Provided that there is no double patenting between the parent and the divisional patent, all permutations of unitary and national validation across the different members of the parent-divisional family will be possible, and the different grant dates will present different opportunities as more countries become UP-participating states in the future.

Haseltine Lake LLP
HL Renewals LLP