

Basics of the Unitary Patent system. Part 6: opting out of the UPC

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Europe is preparing for the launch of the new Unitary Patent and the Unified Patent Court (UPC). A provisional phase for the UPC is expected to start later this year, with a view to a full start of the system in the spring of 2017. In a series of articles, Kluwer IP Law explains the upcoming changes and the consequences they have for patent practitioners. The sixth blogpost: **opting out of the UPC**



1. Does the proprietor of a European patent have to accept the jurisdiction of the UPC?

No. During a transitional period of minimum 7 years and maximum 14 years, proprietors of European patents can opt-out of the jurisdiction of the UPC. If a European patent has been opted-out, no proceedings relating to that European patent can be started before the Unified Patent Court. The opt-out is no longer possible if proceedings have already been started before the UPC. This also applies if the proceedings before the UPC have already been concluded (Rule 5.7. RoP).

If there is no opt-out for a European patent, the claimant in an infringement or revocation action has the choice during the transitional period to start proceedings before the national courts or before the UPC.

2. Can an opt-out be withdrawn by the patent proprietor(s)?

Yes. As long as no action has been brought before a national court, the opt-out can be withdrawn (Rule 5.8). After the withdrawal of an opt-out, the patent proprietor(s) cannot lodge a new (second) application to opt-out (Rule 5.11).

3. Does an opt-out also extend to a supplementary protection certificate?

Yes. An application to opt out or an Application to withdraw an opt-out for a European patent shall extend to any supplementary protection certificate based on that European patent. This includes supplementary protection certificates which were granted after lodging the application to opt out.

4. Who has to apply for an opt-out of a European patent?

Rule 5.1 (b) of the Rules of Procedure clearly provides that all proprietors of a European patent need to lodge the application to opt-out. In the 18th (and final) draft of the Rules of Procedure it was clarified that a "proprietor" of a European patent is the person "entitled to be registered as proprietor(s) under the law of each Contracting Member State in which the European patent has been validated", whether or not such person is in fact recorded in the register.

For persons registered in each national patent register and the European Patent Register there is a rebuttable presumption that such person is entitled to be registered as proprietor (Rule 8.5. (c) RoP). But since this presumption is rebuttable, it will be the task of the parties (and its representatives) to verify the ownership rights to be sure that the European patent is in fact really opted out of the jurisdiction of the UPC. Nor the EPO, nor the UPC will check the ownership rights. The opt-out procedure is meant to be "mechanical".

If the person lodging the application to opt out is not recorded as the proprietor(s) or applicant(s) in the European register, that person needs to lodge a Declaration of proprietorship.

5. Does the proprietor have to pay a fee to opt-out?

No. Although in previous drafts of the RoP, a fee for opting out was provided, the Preparatory Committee decided in February 2016 that the opt-out and the withdrawal of an opt-out will not be subject to a fee.

6. Is there an opt-out possibility for Unitary Patents?

No. If one chooses for a Unitary Patent, there is an automatic and exclusive jurisdiction of the UPC.

7. Can licensees opt-out European patents?

No. Nor the UPCA, nor the RoP provide a possibility for (exclusive) licensees to opt out European patents. Therefore, it can become important to provide in license agreements some kind of involvement of the licensee in the decision of the patent proprietor(s) to opt-out patents.

8. Will patent proprietors be able to opt out European patents before the start of the UPC?

Yes. The Preparatory Committee plans to start a sunrise period for opting out European patents from the UPC jurisdiction. This sunrise period would start in the second half of 2016.

Pieter Callens is co-author of the book "Introduction to the Unitary Patent and the Unified Patent Court". An updated version of this book shall become available in 2016.

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