How to prepare for the upcoming Unitary Patent and the Unified Patent Court, which are expected to start functioning on 1 December 2017. It will be a good idea to prepare in advance in order to be ready for the new system. On the other hand, the preparatory work should not be done in a rush. The preparatory work should be done systematically and carefully in order to avoid any mistakes.

The Unified Patent Court will open for business this year.

If you are interested in knowing more about the Unitary Patent and the Unified Patent Court, please visit the Kluwer Patent blog for the latest updates and news. The blog is available at http://patentblog.kluweriplaw.com/2017/02/21/to-do-list-for-the-unitary-patent-package/

The to do list for the Unitary Patent Package

Kluwer Patent Blog

January 21, 2017


Evaluate your patent portfolio now!

For pending patent applications that are close to grant, the applicants need to consider whether they want to opt for unitary effect and take the necessary previsions, including to request in the EPC to publish the decision of the grant of the patent prior to 1 December 2017 and file a request for unitary effect with the EPO using the so-called "pre-published" system.

If the UPC indeed opens on 1 December 2017, you may want to file an action already on that date. For all EPO-pending patent applications, there is a lot of work to be done for patent proprietors at short notice and also for their adversaries. There is certainly no time to lose for a well-executed approach.

Opt in or require prepayment

Opt out rights are further through the UPC case management system. First of all, this requires getting acquainted with the system and preparing its registration as a user. Currently a beta version of the case management system is available. It is worthwhile to open a user account just to get an idea of how this might look.

The opt-out period starts on 1st of September, a true user account will be needed. This will include identity verification, permission or notification authorization to the party in question and sharing of contacts information, such as a passport, a bank or a driving license. Stakes of the improvements will then become easier.

For as long as you valid where it is performed by all proprietors of the patent not at least of unitary effect, the patent will not be the object of any action, but the actual proprietor (the person entitled to be regarded as proprietor in each country concerned by the UPC where the patent is valid) will be notified. This is especially important is to be able to submit the opt-out to the EPO within a limited period.

The opt-out may be filed on an official representation of the company. This would qualify as such a representation is determined by the law of incorporation of the patent proprietor. Every other person will want express authorization. This needs to be secured preferably before 1st of September.

According to European law, you can only be up to 21 countries out of the 25 that are envisaged. For the scope of the Unitary Patent the date of operation of the opt-out effect is decisive, so applications should be closed in countries to secure these differences to be published in the Opt-Out Register as of the 1st of September. The opt-out will therefore allow the filing of applications for unitary effect in relation to patent applications. The National Phase will then be filed on the day that the UPC agreement enters into force and a Unitary Patent will be granted.

For existing and future traditional European patents, a decision needs to be taken whether or not to file for an opt-out. Once an action has been started at the EPO, it is in general a fairly easy step to become a Unitary Patent. The patent is not only transferred to the UPC, but the National Phase of the same patent proceeds to be granted by the Unified Patent Court. This is however important is to be able to ensure the full effect of the opt-out.

Licensees and ownership agreements

The UPC Agreement authorizes exclusive licensees to transfer the patent without consent from the proprietor, unless agreed otherwise. A subsequent clause for the revocation of the patent (with effect for the whole EPC territory) is inserted in the proprietor by the UPC registry, dragging the proprietor into a validity action. It is therefore crucially important and where needed review such licence agreements prior to 1 December 2017, as the new rules now apply to existing licenses with immediate effect.

On the other hand, non-exclusive licensees may only have to pay the registration fee to the proprietor. The proprietor has to be notified within one month after the mention of the grant of the European Patent Bulletin. Unitary effect can only apply to granted European Patents. Hence, it is important to make sure that you have an up-to-date list of your patent portfolio and that you are aware of any changes in the ownership of your patents.

Are you ready for the first actions?

If the UPC indeed opens on 1 December 2017, you may want to file an action already on that date. For all EPO-pending patent applications, there is a lot of work to be done for patent proprietors at short notice and also for their adversaries. There is certainly no time to lose for a well-executed approach.

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If you want to file the opt-out to the Unified Patent Court, you may want to file the opt-out before 1st of September. You also need to check whether any national regulations on the patent in pending on file have already been pending, as this would affect the application.

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Time to prepare all of these electronic documents in the months before that.

It is equally important to note that the Statement of Defence has the same requirements and needs to be submitted within three months of service of the Statement of Claim. This deadline will in principle not be extended if a preliminary objection is filed. Therefore, if you expect that a UPC action may be filed against you, it is wise to start collecting evidence and prepare the defence well in time.

If you have reason to fear an ex parte injunction, which will probably be a rare phenomenon, you may want to file a protective letter. At the moment it is still uncertain whether protection letters will also be available against pre-trial seizures of evidence, the so-called saisie, but since that will be the case in the next edition of the Rules of Procedure, protective letters may also need to be ready to be filed by the 1st of December.

It is clear that both patent proprietors and their opponents need to take action now, in order to be ready for the new Unitary Patent Package by the 1st of September for the start of the sunrise period and by the 1st of December for obtaining unitary effect and for actions at the UPC.

For regular updates on the Unitary Patent and the Unified Patent Court, subscribe to this blog and the free Kluwer IP Law Newsletter.