



Client Information | April 2022

## INTERESTED IN THE UNITARY PATENT? MAYBE DELAY EP EXAMINATION PROCEDURE!

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### Interested in the unitary patent? Maybe delay EP examination procedure!

We had already reported that the Unitary Patent, i.e. a unitary patent protection in at least the most important EU countries, will in all likelihood become a reality (see most recently our client information of February 2022, available at [https://www.prinz.eu/fileadmin/Newsletter/Client\\_Information\\_February\\_2022.pdf](https://www.prinz.eu/fileadmin/Newsletter/Client_Information_February_2022.pdf)).

Unfortunately, the precise date for the availability of the Unitary Patent is still unclear. Estimates vary between autumn 2022 and spring 2023. The reason for this lack of clarity is that the European Patent Office, which registers Unitary Patents, and also the Unified Patent Court, which is responsible for patent infringement actions based on Unitary Patents and for nullity actions against Unitary Patents, have not yet completed all administrative preparations. Germany has agreed to withhold the ratification document of the Agreement on the Unitary Patent and the Unified Patent Court until the European Patent Office and the Unified Patent Court are ready to start.

In case you or your clients are considering a Unitary Patent for the participating countries of the European Union (currently 17 countries, namely Austria, Belgium, Denmark, Germany, France, Luxembourg, Malta, Portugal, Sweden, Finland, Bulgaria, Estonia, Italy, Latvia, Lithuania, Slovenia and the Netherlands) instead of the conventional separate validations in one or more of these EPC contracting states, the following should be noted: A Unitary Patent can only be registered for EP patents granted after the start date of the Unitary Patent. Consequently, if a Unitary Patent is desired, it may be reasonable to delay the examination proceedings of a European patent application if grant is to be expected soon.

This applies in particular to European patent applications in which amended claims are filed which correspond to those indicated as being allowable by the examiner in an earlier office action. In these cases, the patent is usually granted fairly quickly.

However, to enable you to obtain a Unitary Patent in these cases, we recommend delaying the examination proceedings to defer the grant until after the start date of the Unitary Patent. The examination proceedings can be delayed by, for example, the following steps:

- filing a request for extensions of the time limit for responding to an office action
- or not replying to the office action with a detour for further processing

Even in cases where the examination procedure is actually completed, the formal grant of the patent can still be postponed.

If you are interested in the Unitary Patent, we will be pleased to advise you.



### **QUESTIONS?**

If you have any questions regarding unitary patents, please feel free to get in touch with Jochen Sties by e-mail: [j.sties@prinz.eu](mailto:j.sties@prinz.eu) or by phone: +49 (0) 89 / 59 98 87-103.

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