



Client Information | December 2022

## START OF UNITARY PATENT POSTPONED TO 1 JUNE 2023 EPO REMAINS START FOR TRANSITIONAL MEASURES

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### **Unified Patent Court postpones start to 1 June 2023 EPO remains start of transitional measures on 1 January 2023!**

Just in time for the end of the year race, we are delighted to present you with information on when the Agreement on the Unified Patent Court (UPCA) and, thus, also the Unitary Patent System will enter into force and when you will be able to take action.

First and foremost, the Unified Patent Court (UPC) has postponed the start of the Unitary Patent System and the Unified Patent Court by two months to 1 June 2023, and thus the Sunrise Period to March 1, 2023. This is due to technical issues with the Case Management System (CMS) for requesting opt-outs from the Unitary Patent System and the procurement of appropriate, approved authentication hardware for this purpose. In response to the postponement, the EPO has surprisingly announced that it will maintain the 1 January 2023 start date for the so-called transitional arrangements, thus decoupling them in time from the sunrise period. What does that mean?

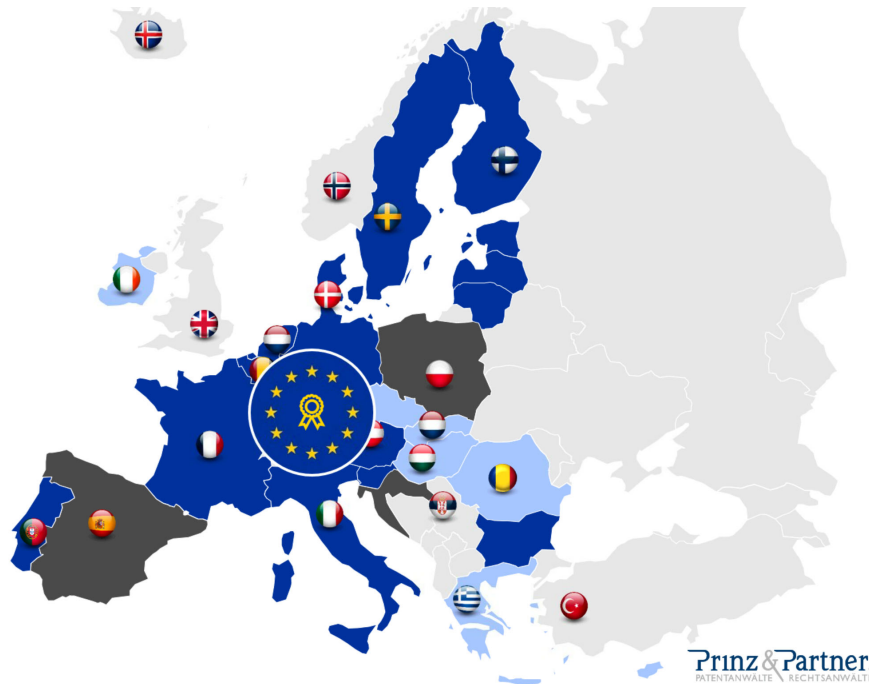
From **1 January 2023**, you can **request a delay** in issuing the decision to grant a European patent. This request rules out the possibility that a European patent will be granted before the start of the Unitary Patent System on 1 June 2023 (i.e. too early), which would block your path to the Unitary Patent.

You can also file an **early request for unitary effect** for a current EP application as early as **1 January 2023**. By doing so, you determine in advance that a Unitary Patent will take effect for your future EP patent in the 17 participating EU member states of the Unitary Patent System.

Importantly, **Opt-Out request** from the Unitary Patent System can only be validly filed from the start of the Sunrise Period, i.e. from **1 March 2023**.

## All granted EP patents generally fall under the jurisdiction of the UPC

Importantly, from 1 June 2023, all existing and future granted EP patents having effect for the 17 participating EU member states Austria, Belgium, Bulgaria, Denmark, Germany, Estonia, Finland, France, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia and Sweden will also fall under the central jurisdiction of the Unified Patent Court. This means that in particular infringement and revocation actions can be filed centrally at the UPC and have an effect in all the 17 participating member states. Unless an action in the same matter is already pending at the UPC, law suits may be filed with the respective national courts in the 17 participating member states within a transitional period of currently 7 years, i.e., until 31 May 2030.



In the 17 participating EU member states marked in dark blue, the UPCA and unitary patent system will enter into force on 1 June 2023.

### What is to be done now?

#### Granted EP patents of your portfolio

Now is the time to review your EP patent portfolios and to identify those existing EP patents and EP patent applications, which should not fall under the jurisdiction of the Unified Patent Court.

We recommend filing an Opt-Out request from jurisdiction of the Unified Patent Court in particular for those IP rights, which should not be exposed to a possible central invalidity attack having effect in the 17 participating member states.

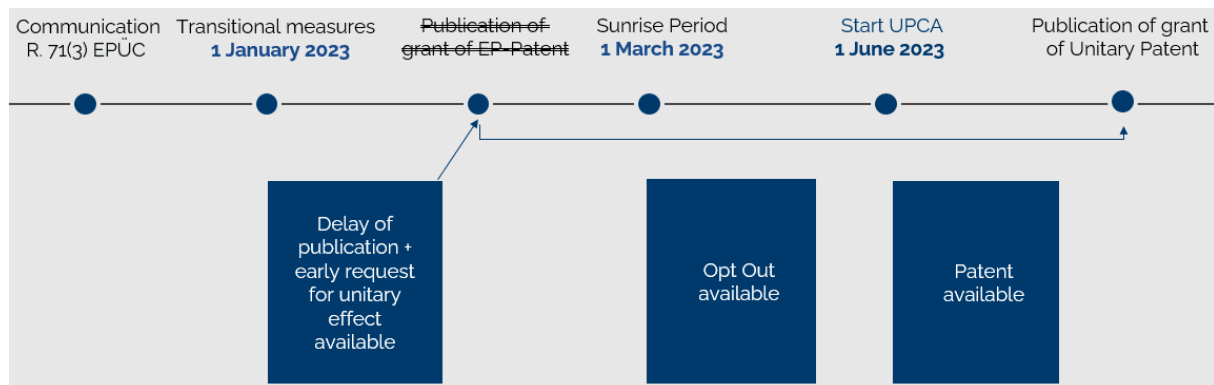
Such IP rights could be your "crown jewels", i.e., those IP rights that substantially protect your products and services. You may also include "weaker" IP rights, i.e., IP rights that are confronted by strong prior art.

In order to avoid the risk of a central invalidity attack from the first day of entry into force of the UPCA on 1 June 2023, we strongly recommend filing the Opt-Out requests already in the Sunrise Period, i.e. from 1 March 2023 to 31 May 2023.

## EP patent applications of your portfolio

In case you would like to obtain a Unitary Patent for EP patent applications for which the Rule 71(3) EPC communication has already been issued but the deadline for meeting the grant requirements expires prior to 1 January 2023, you need to delay grant of the patent now, e.g., by failing to meet the Rule 71(3) EPC response requirements and requesting further processing.

With regard to EP patent applications in your portfolio for which the time limit for responding to the Rule 71(3) notice expires on or after 1 January 2023, you can file an early request for unitary effect during the Sunrise Period in order to obtain a Unitary Patent. If necessary, an additional request for deferment of grant must be filed in order to publish the notice of grant of the Unitary Patent from 1 June 2023.



**Please contact us now and let us know for which EP patents we should file an Opt-Out request or for which pending EP patent applications we should file an early request for unitary effect or delay grant.**

In the event that you are the licensor of an existing EP patent, it would be necessary to check to what extent you are obliged to involve the licensee in the decision to opt out.

## Future alignment of your patent portfolio

In our previous client information mails (02/2022 and 05/2022) we had already provided detailed information on the advantages and disadvantages of a unitary patent. Due to the opposing advantages and disadvantages, it is unfortunately not possible to provide you with a one-fits-all answer on how to tailor your patent portfolio in order to gain the best position in your competitive field.

Decisions on the use of Unitary Patents, Opt-Outs and/or national IP rights in the patent portfolio should be aligned with your individual competitive situation and should be based, for example, on the extent of infringement claims against competitors, the relevant countries for infringement claims, the risk of nullity actions against your patents and the strength of your own patents compared to the prior art.

**Arrange an appointment with us so that we can advise you individually on the alignment of your patent portfolio in the Unitary Patent System.**

## **Strengthen your competitive position**

Are you prevented from using a certain technology in Europe by an existing EP patent of a competitor? Then, from 1 June 2023, a central nullity action at the Unified Patent Court could be interesting for you as. If your competitor has not filed an Opt-Out request during the Sunrise Period, you could, within one year, obtain a central decision on invalidity at the first instance having effect in the 17 participating member states listed above.

Use centralised preliminary injunction proceedings for multiple participating EU member states against possible patent infringers from 1 June 2023. You can also base the request on your classic, existing EP patents.

Optimize your in-house procedures and temporary staff replacement arrangements to be best prepared for the short deadlines at the Unified Patent Court in the event of infringement or nullity actions filed by competitors.

**Contact us if you would like us to research the state of the art on granted EP-patents of competitors, prepare central injunction measures or support you in optimizing your in-house processes.**

We will keep you informed about the current developments concerning the Unitary Patent System and the Unified Patent Court.



### **QUESTIONS?**

We will be pleased to advise and assist you in all matters relating to the preparation and benefits of the Unitary Patent System and the Unified Patent Court.

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