

## **New European Unified Patent Court - Opt-Out - Unitary Patent**

It is anticipated that on 1 June 2023 a new patent protection system will enter into force in a part of the EU, and with this system European patents with unitary effect (so-called European Unitary Patents) on one hand and a Unified Patent Court (UPC) on the other hand will be established.

As from the start of this system, the participating EU member states are:

Austria (AT), Belgium (BE), Bulgaria (BG), Germany (DE), Denmark (DK), Estonia (EE), Finland (FI), France (FR), Italy (IT), Lithuania (LT), Luxemburg (LU), Latvia (LV), Malta (MT), The Netherlands (NL), Portugal (PT), Sweden (SE) and Slovenia (SI).

Further EU member states are expected to join at a later time.

Non-EU member states, for example Switzerland (CH) and Great Britain (GB), are not affected by this new patent protection system.

### European Unitary Patent

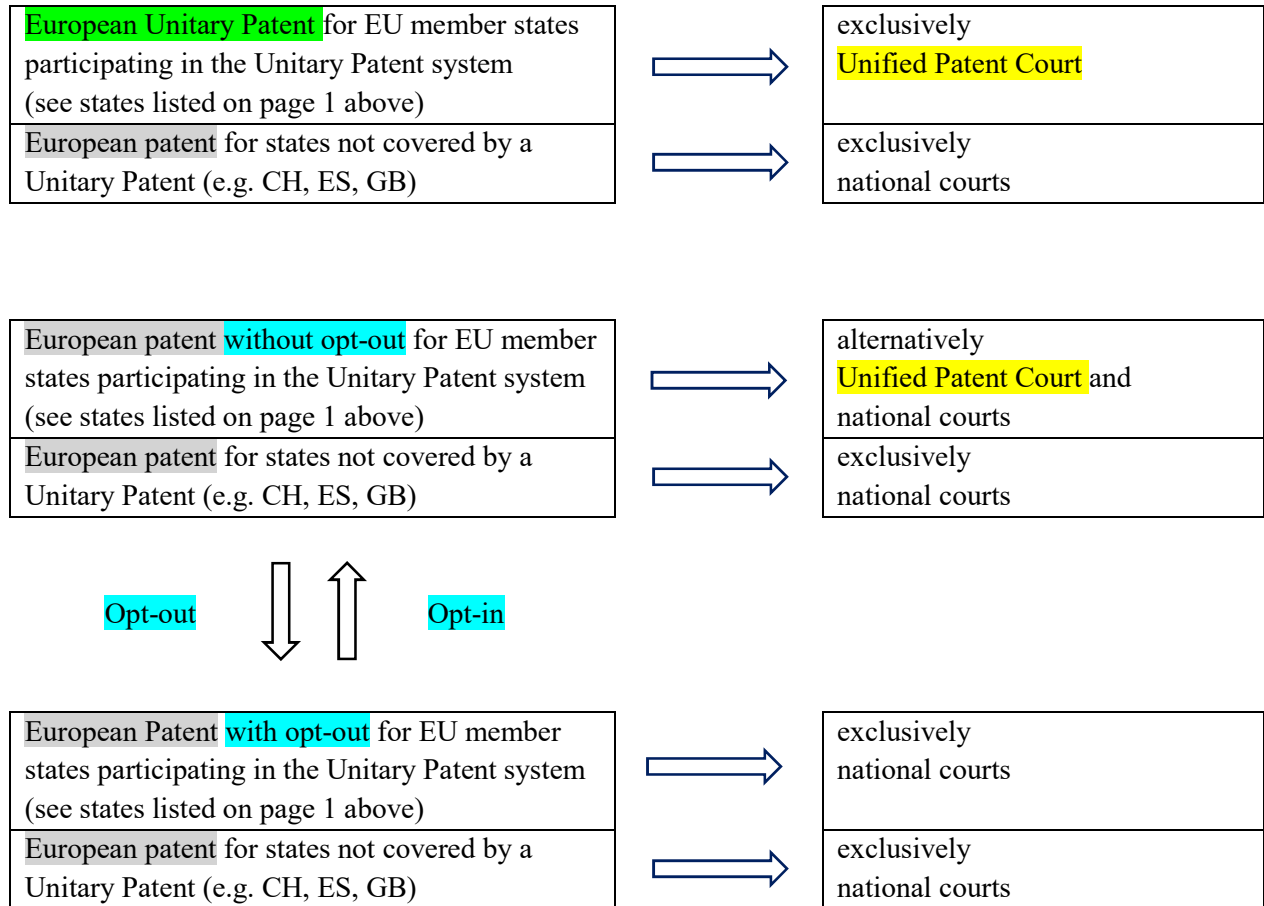
A European Unitary Patent results from a classical European patent application in case at the time of grant of the European patent a request for the patent to have unitary effect will be filed for the participating EU member states. In addition, the European patent may be validated in the remaining designated member states as this has been done in the past. In case no European patent with unitary effect is requested for the participating EU member states, the European patent may be nationally validated in these states, too, as this has been done in the past.

### Unified Patent Court

The Unified Patent Court has exclusive competence in civil procedures related to infringement and validity of European Unitary Patents.

Moreover, in the participating EU member states the Unified Patent Court - in addition to the existing national courts - has alternative competence in the said civil procedures for (classical) European patents without unitary effect as well as for Supplementary Protection Certificates based on such European patents. This alternative competence will exist for a transitional period of at least seven years, unless the patent proprietor or the holder of the Certificate explicitly excludes the competence of the Unified Patent Court (so-called 'opt-out').

The competence of the courts in civil procedures related to infringement and validity of European patents are schematically illustrated in the following:



From this illustration it is evident that within the transitional period of at least seven years, the alternative competence of the Unified Patent Court for European patents without unitary effect (i.e. for classical European patents, but also for future European patents without unitary effect) and also for Supplementary Protection Certificates based thereon may be excluded by filing an opt-out declaration.

An opt-out declaration may be withdrawn by filing an opt-in declaration, however, filing a second opt-out declaration is then not possible anymore.

There are reasons in favour of an opt-out of a European patent or a Supplementary Protection Certificate based thereon, as well as reasons against an opt-out.

Reasons in favour of an opt-out

- Risk of a central invalidity suit before the Unified Patent Court against a European patent without an opt-out can be excluded. Such a central invalidity suit has effect for all EU member states participating in the Unitary Patent system and covered by the European patent.
- Uncertainty about the quality of the new Unified Patent Court as well as uncertainty with regard to the jurisprudence to be expected.
- At the Unified Patent Court a tight procedure with short deadlines is planned which may be in favour of claimants since they can determine the time of filing the lawsuit.

Reasons against an opt-out

- By means of a central infringement suit at the Unified Patent Court it is possible to simultaneously take action against infringements occurring in a plurality of states (i.e. in the participating EU member states)
- For an opt-out and a possible later opt-in, all actual patent proprietors must act together.
- Expense for an opt-out and a later opt-in.

Upon weighing the reasons for and against an opt-out out of a European patent or a Supplementary Protection Certificate based thereon, from our point of view in most of the cases the risk of a central invalidity suit may be most important.