

# WELCOME

*& thank you for joining us*

## UNITARY PATENT

*The New Way To Protect Innovation in 2023*

16 February 2023



# Our Speakers



**SPEAKER**  
**Elliott Davies**



**SPEAKER**  
**Rob Davey**

# WHO IS AIPEX?

the leading European IP service provider

AIPEX was established in 2010 to offer pan-European IP services, to meet the needs of foreign clients who increasingly demand a broader service than purely national firms can provide.

By working together as a team of professionals, we combine national and local knowledge, as well as professional capacity and experience in all the necessary technical and legal specialties.

Working directly with AIPEX connects you directly to all the attorneys and their expertise in all the member firms.





# CURRENT ROUTES

for patent protection in Europe  
& the new Unitary Patent (UP)

# NATIONAL PATENTS/APPLICATIONS

- Separate patent applications
- Separate prosecution
- Separate fees
- Different languages
- Invalidity and enforcement conducted at national level



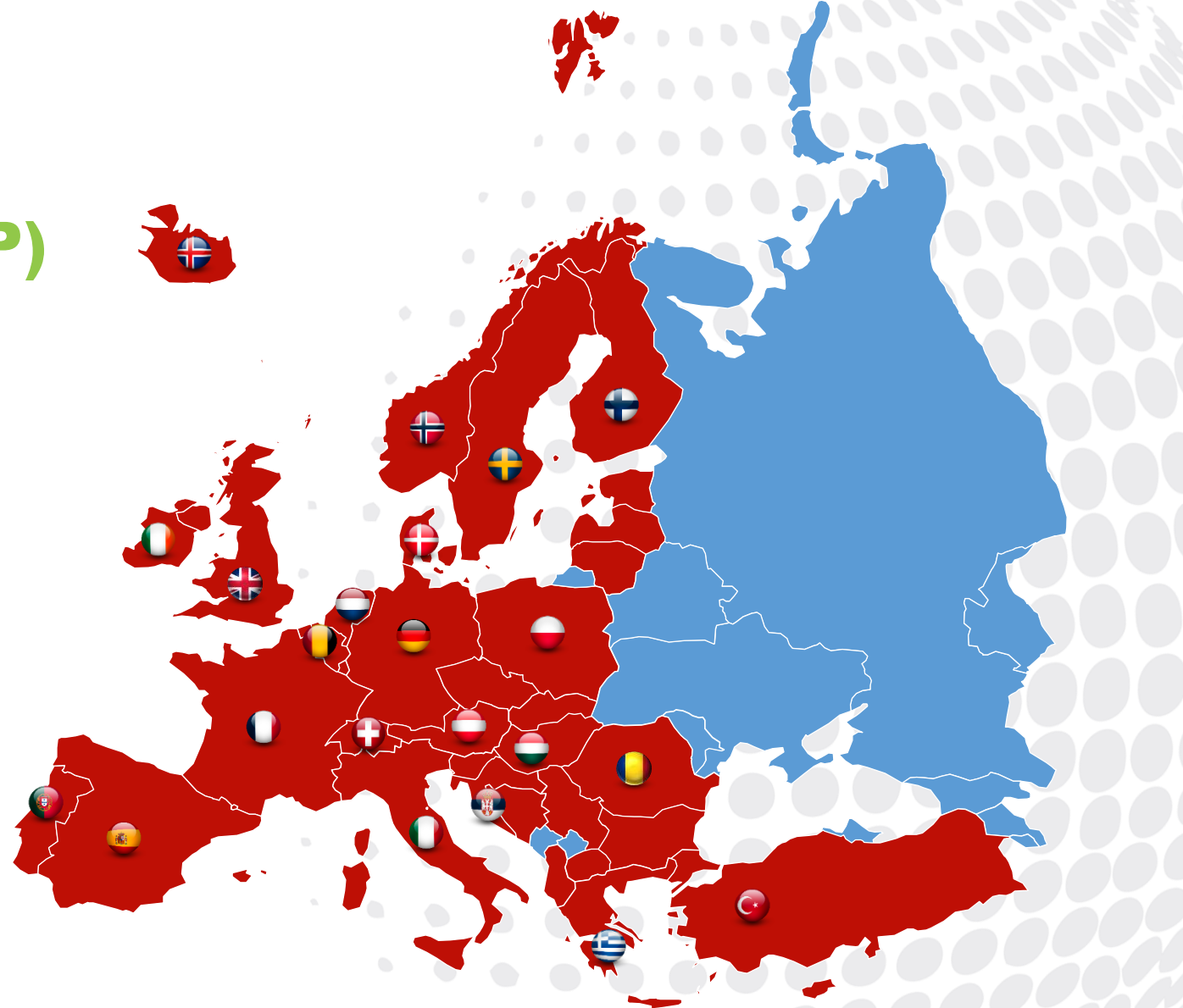
# EUROPEAN (EP) PATENT APPLICATION

- EPC member states unchanged
- EPC states  $\neq$  EU member states
- Single EP patent application covering all EPC states
- Prosecution in one language



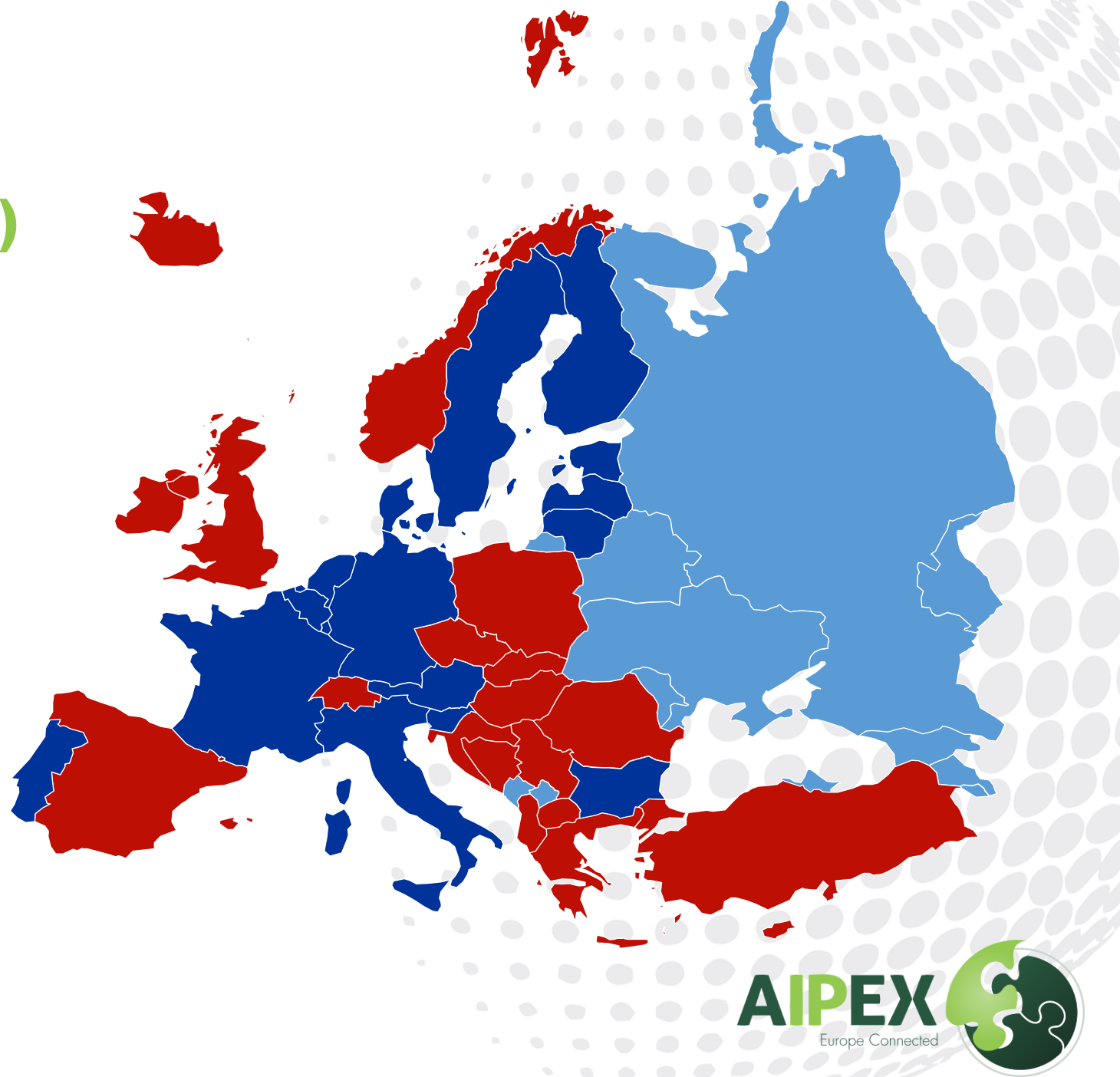
# EUROPEAN PATENT (EP)

- Post grant validation - single EP patent gives rise to a number of national patents
- National patents derived from the EP patent are vulnerable to central attack during opposition period (9 months)
- Post opposition, national patents can only be challenged on a national basis
- National patents enforced separately



# UNITARY PATENT (UP)

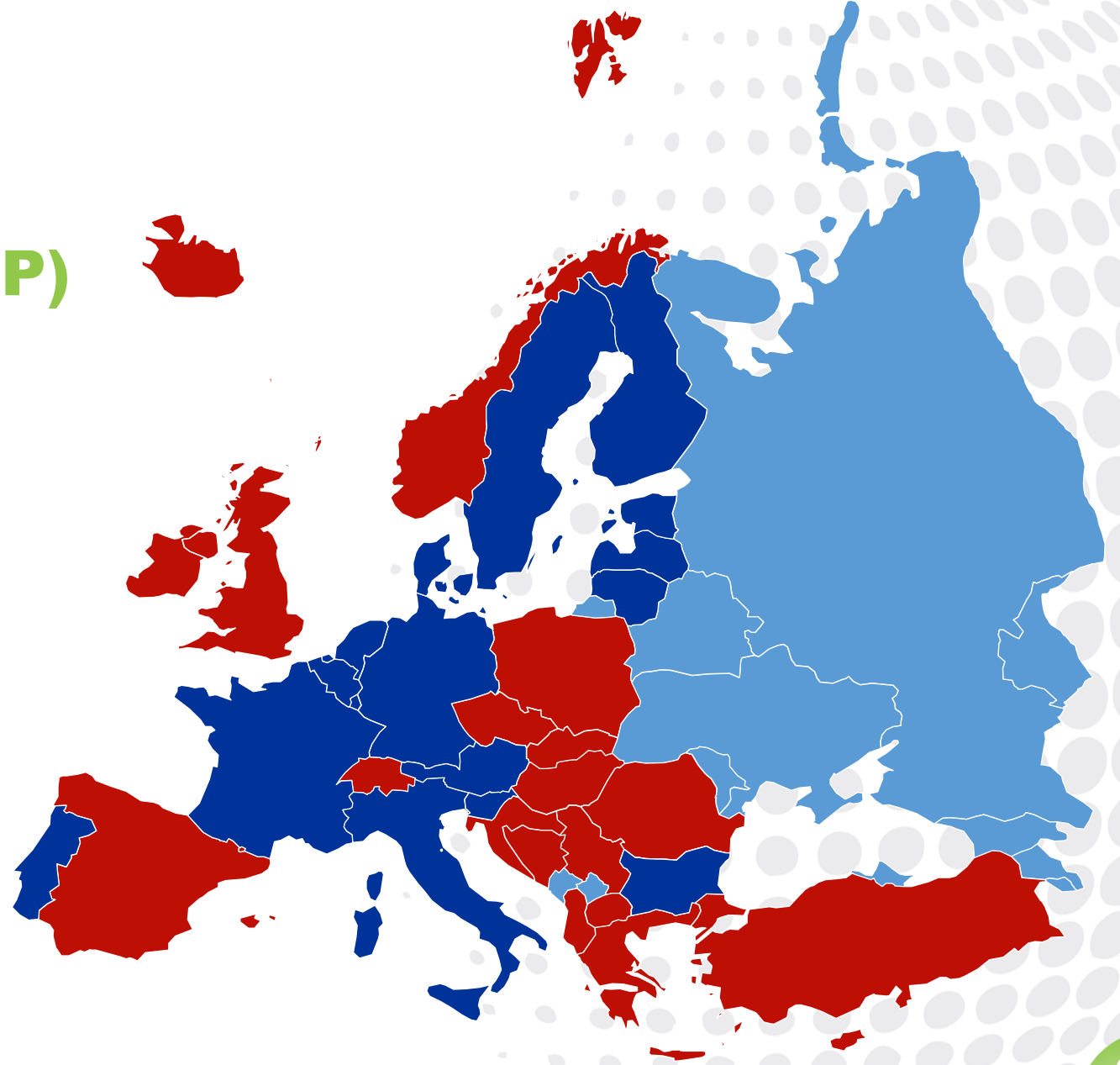
- Available via the EP patent application system
- A new “pseudo territory” available for validation (post EP grant)
- Single patent covering a subset of EU member states (currently 17 of a possible 24 states) – single renewal fee
- Vulnerable to central attack even after 9-month EP opposition period
- Enforcement across all member states





## UNITARY PATENT (UP)

- 1 month for submitting request for unitary effect
- Submit translation (machine)
- Claims must be the same for all participating UP member states



## Example

Patent protection for GB, DE, FR, IT, ES

Your future options:

- a) Classic EP patent with validation in 5 countries or

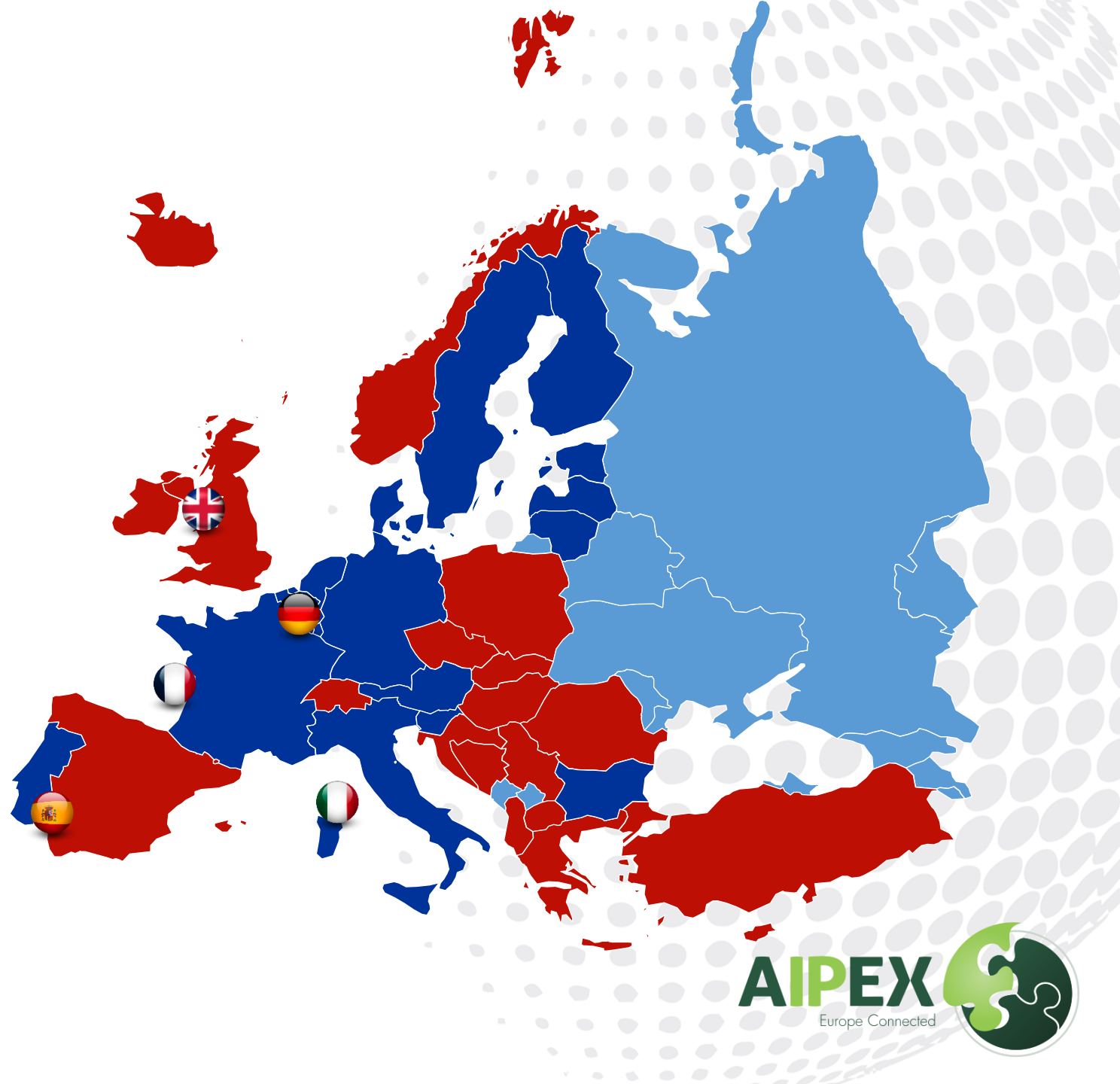


## Example

Patent protection for GB, DE, FR, IT, ES

Your future options:

- b) Unitary patent (all remaining 14 UP states are also included) + validation in GB and ES



# Costs

- Examination
- Validation
- Maintenance
- Litigation

# Costs

Unitary Patent / European patent – Examination Validation & Maintenance

## Examination costs

- **Identical** between European patent and Unitary patent
- **No official fee** for requesting unitary effect

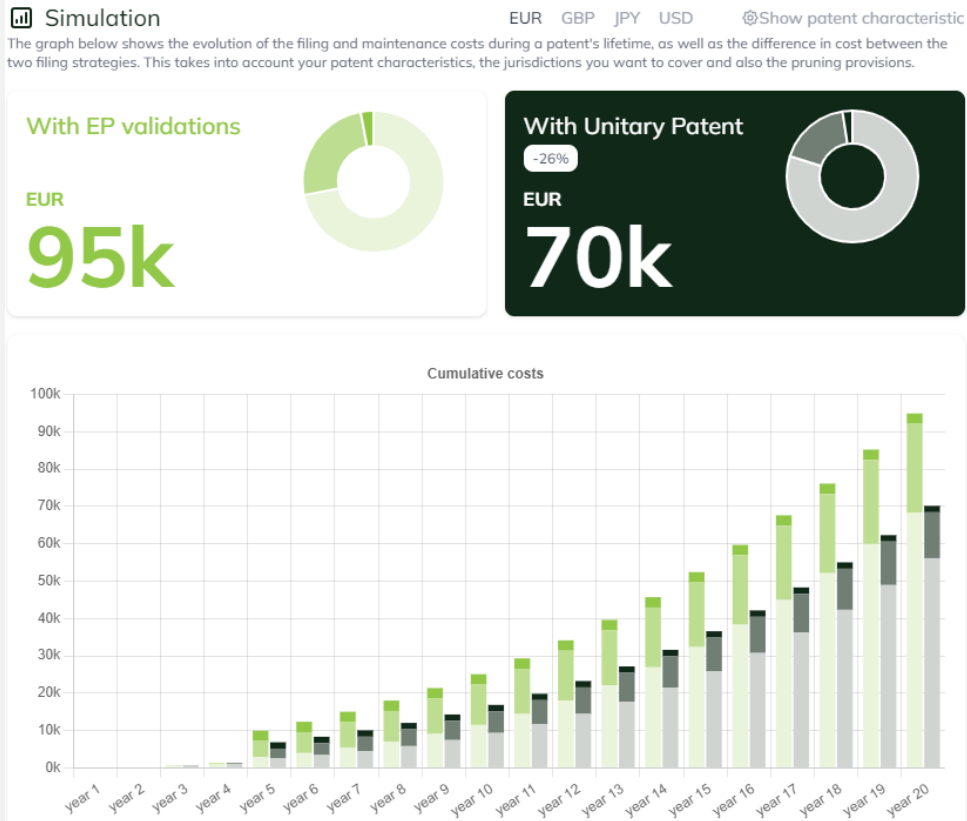
## Validation and maintenance costs











- **No validations** for a Unitary patent
- Annual fees for Unitary patent are roughly equivalent to what has to be paid for **four validation states**.
- unlike with an EP patent, **individual country parts** cannot be abandoned for a UP patent ( to reduce the cost for renewal fees towards the end of the term).
- *See examples below*



# Costs Comparison (I)

## Unitary Patent / European patent



	Germany	UP	<input type="radio"/> 20 years	<input type="checkbox"/>
	France	UP	<input type="radio"/> 20 years	<input type="checkbox"/>
	United Kingdom		<input type="radio"/> 20 years	<input type="checkbox"/>
	Italy	UP	<input type="radio"/> 20 years	<input type="checkbox"/>
	Spain		<input type="radio"/> 20 years	<input type="checkbox"/>
	Belgium	UP	<input type="radio"/> 20 years	<input type="checkbox"/>
	Turkey		<input type="radio"/> 20 years	<input type="checkbox"/>
	Netherlands	UP	<input type="radio"/> 20 years	<input type="checkbox"/>
	Switzerland		<input type="radio"/> 20 years	<input type="checkbox"/>
	Sweden	UP	<input type="radio"/> 20 years	<input type="checkbox"/>

## Example I

- Grant after 4 years
- Protection via « classical » EP patent: 10 states
- Protection via Unitary patent + EP patent: 21 states
  - 17 Unitary patent
  - 4 Classical EP patents in non participating states

# Costs Comparison (II)

## Unitary Patent / European patent

### Simulation

EUR GBP JPY USD Show patent characteristic

The graph below shows the evolution of the filing and maintenance costs during a patent's lifetime, as well as the difference in cost between the two filing strategies. This takes into account your patent characteristics, the jurisdictions you want to cover and also the pruning provisions.

With EP validations

-31%

EUR

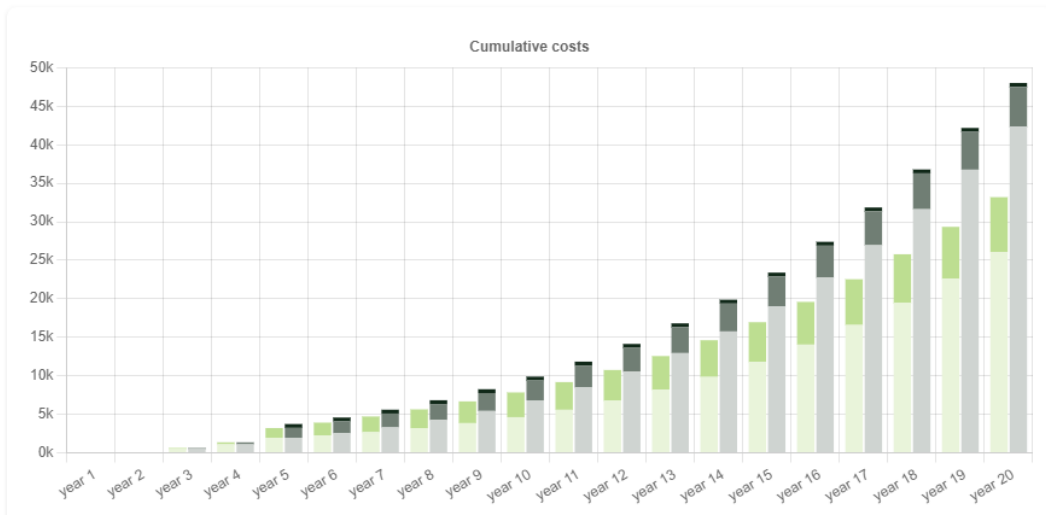
33k



With Unitary Patent

EUR

48k



## Example III



- Grant after 4 years
- Protection via « classical » EP patent: 3 states
- Protection via Unitary patent + EP patent: 18 states
  - 17 Unitary patent
  - 1 Classical EP patents in non participating states

# Costs

## Summary

### Examination costs

- Identical between European patent and Unitary patent

### Validation and maintenance costs

- Difficult to compare since the geographical scope of protection is different
- Best option depends on the number of countries of interest and if said countries are in the UP or not.
- Use the AIPEX cost calculator

### Litigation costs

- Costs probably higher before the UPC than before 1 or 2 national courts
- but decision might be enforced in several countries



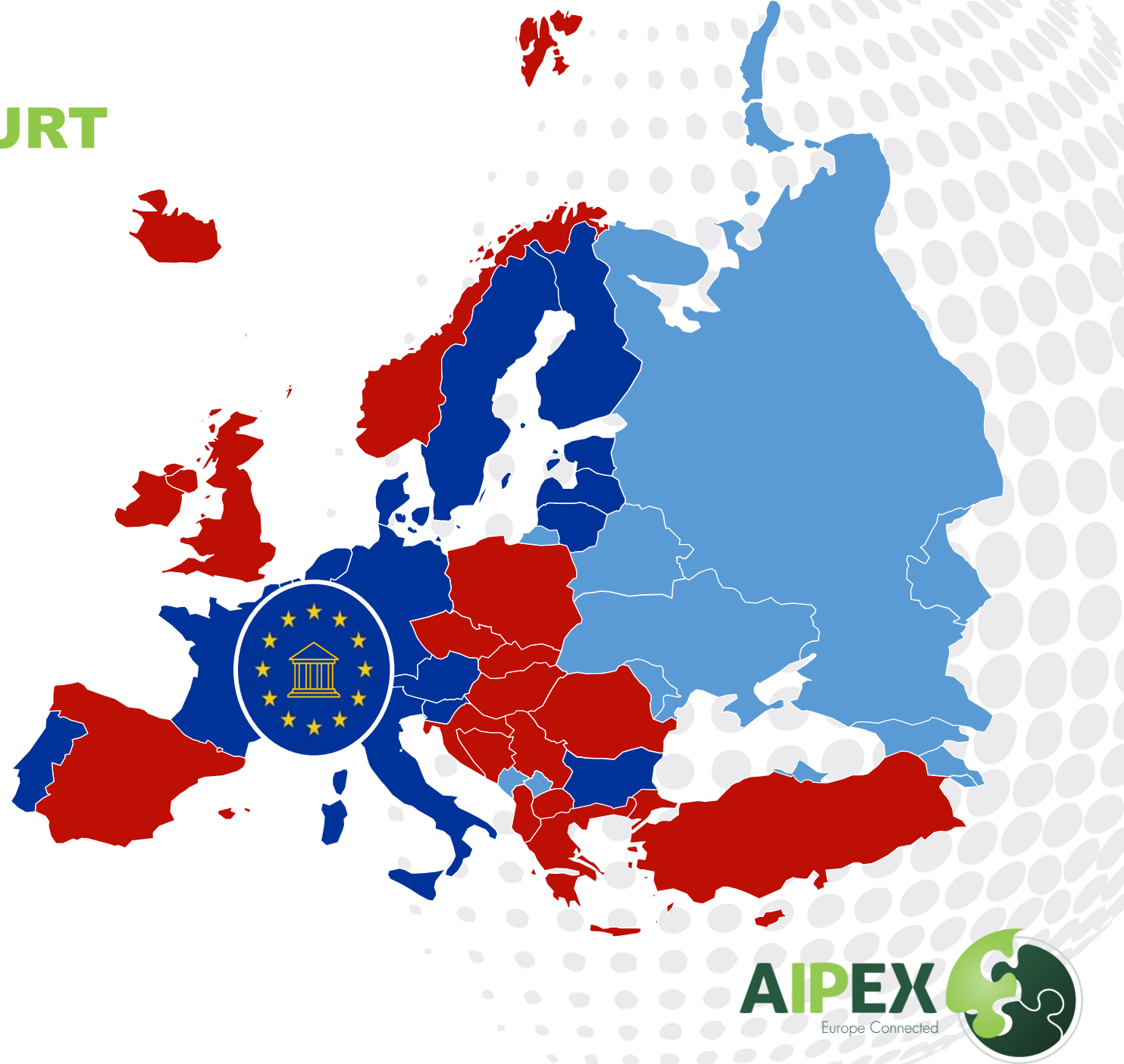
# *Unified Patent Court*

*A separate, new court system and regulations are installed for the upcoming unitary patents*



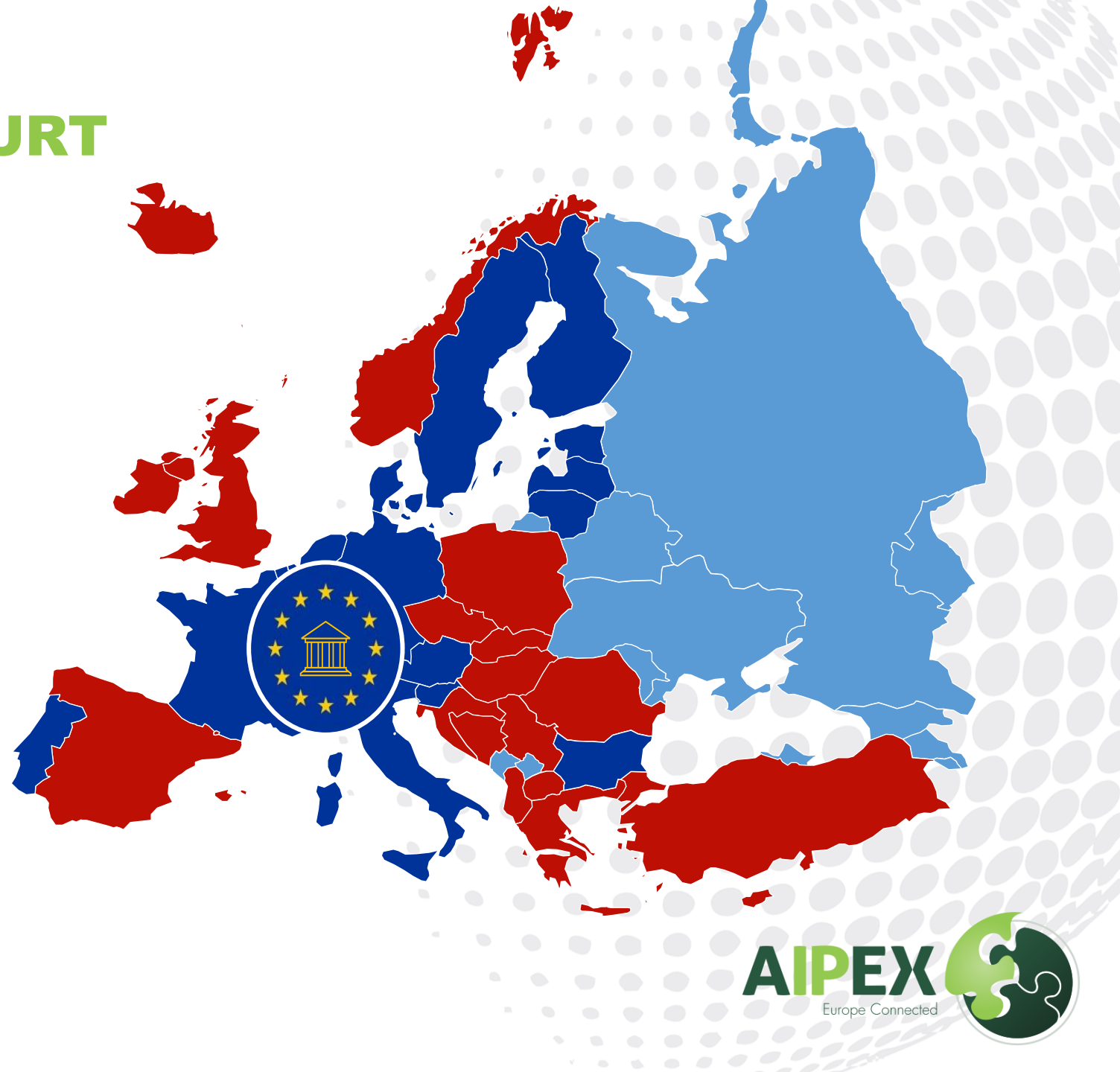
# UNIFIED PATENT COURT (UPC)

- Unitary Patents (UP) can be enforced centrally before the Unified Patent Court.
- The UPC (1<sup>st</sup> instance) has central chambers in Paris and Munich plus local chambers in most of the member states.
- The judges will mostly be experienced patent judges (technical judges will also be members of the chambers).
- A favourable decision for the patentee is enforceable in all 17 member states of the UP system.



# UNIFIED PATENT COURT

- In infringement proceedings the court also decides on patent validity (i.e. no bifurcated system like in DE).
- A UP can also be centrally attacked (before an infringement suit) by a nullity suit so that the UP patent can be invalidated for all member states (drawback of UP!) at low costs.



*Opt-in or Opt-out*



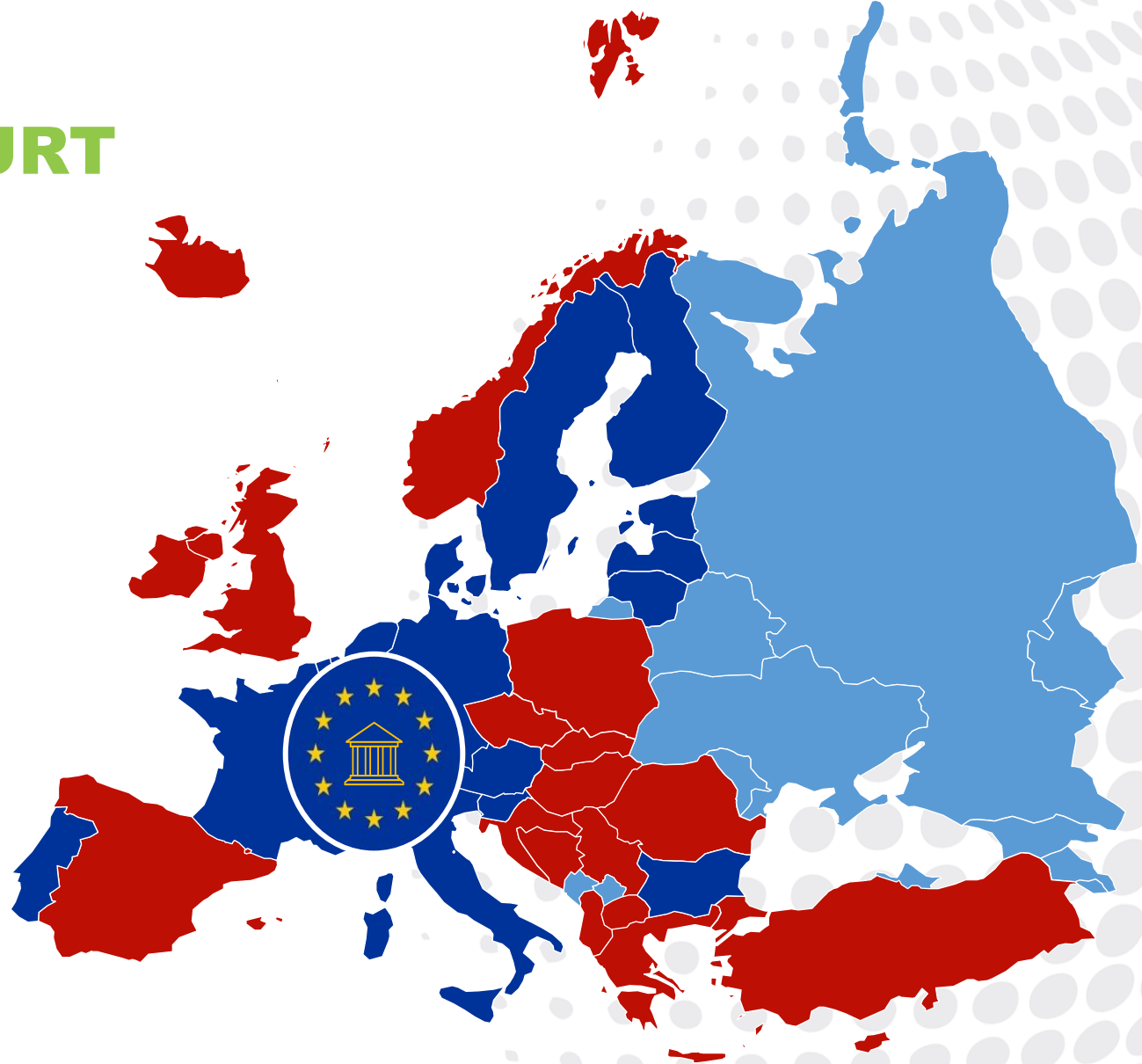
# UPC

**Also responsible for classic existing and upcoming EP patents**

Existing, classically validated EP patents and future EP patents will automatically fall under the jurisdiction of the UPC unless an opt-out request is filed.

# UNIFIED PATENT COURT

- During a transitional period of at least 7 years (final decision will be taken at the end of the 7 years period) the UPC is responsible for handling EP patents (existing and future patents)
- Patentee and nullity plaintiff can initially decide whether they use the UPC or national courts. This is a final decision for the EP patent (for the UP member states)
- After the 7 years transitional period, the UPC will be responsible for existing and upcoming EP patents (with exception opt-out declaration)



# Example for existing and upcoming EP patents

EP patent validated in GB, DE, FR, IT, ES

Options for enforcement

- a) National courts (decisions can be different from country to country)



# Example for existing and upcoming EP patents

EP patent validated in GB, DE, FR, IT, ES

Options for enforcement

- b) - for all UP member states (in blue) before the UPC (here for DE, FR, IT) **and**
- for non-UP members before national courts (here GB, ES)





~~UPC~~

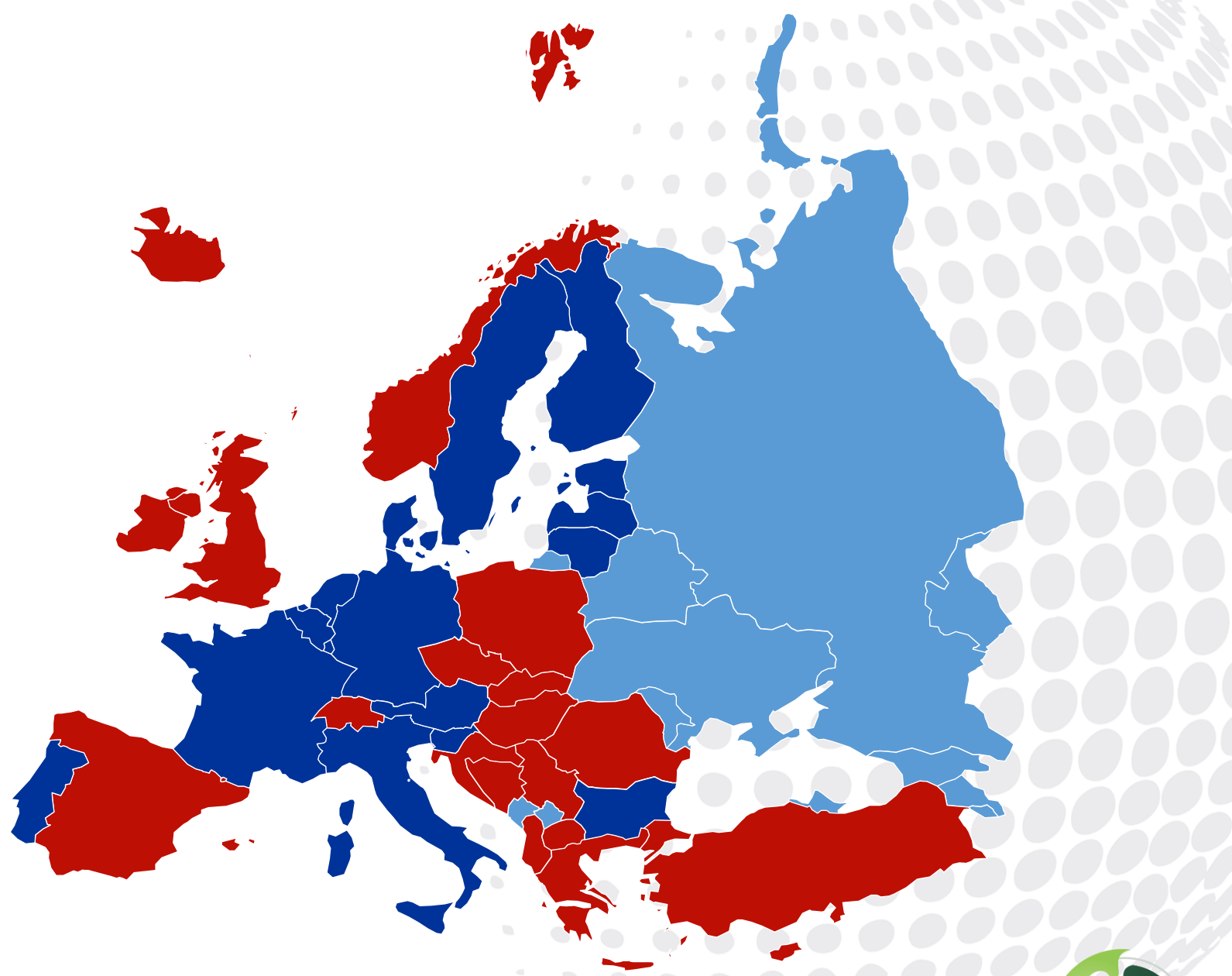
~~Also responsible for  
classic existing and  
upcoming EP patents~~

**Opt-out** declaration  
prevents UPC from taking  
jurisdiction over existing and  
upcoming EP patents

Opt-out declaration can be filed within the upcoming 7 years to prevent the UPC from taking jurisdiction over EP patents for the UP member states in which the EP patent is validated.

The declaration can be withdrawn once.

Opt-out helps to avoid central nullity attack against weak EP patents via UPC.



Situation after opt-out is  
the same as it is now



## Your options with existing and future EP patents

EP patents are enforced/attacked before the national courts during transitional period



EP patents are enforced/attacked centrally before the UPC

Opt-Out:  
EP-patent suits will be exclusively handled by national courts

# Get in touch



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Q&A Session

# Questions?

**THANK YOU**

*for joining us*