

Is the unitary patent (UP) meeting expectations? A review after six months of operation

ZBM Patents & Trademarks

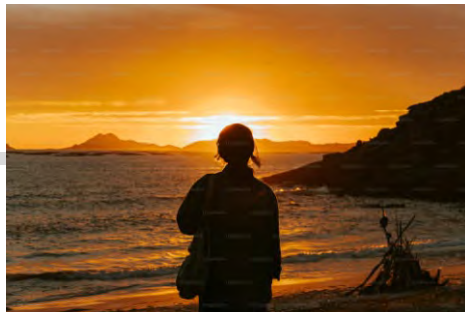
Patent Mondays. Madrid, 20 November 2023

Montserrat Jané

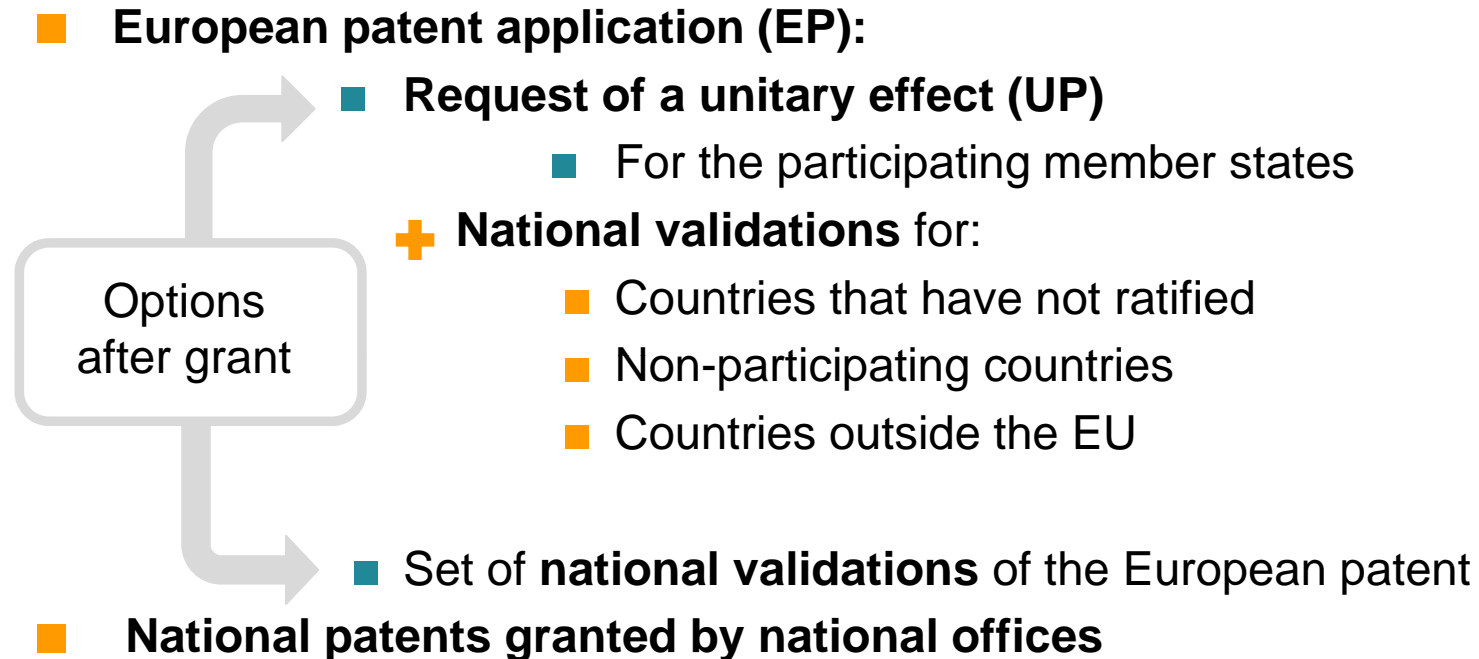
Despite of



1st June 2023



Choice between UP/National validations/national patents



- The rights may coexist (unitary patent and national patents) with limitations established by national laws
- Not possible registering unitary patent and national validate in the MS of the unitary patent

What are the main features of the Unitary patent (UP)?

■ A single patent:

- which is granted with the same effect in all countries participating in the system
- which is maintained as a unit
- Thus, one step procedure after grant

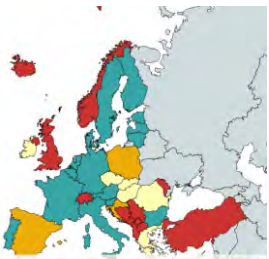
■ Unitary effect implies:

- A single fee
- A single object of property
- A single court
- Uniform protection in 17 EU member states

■ Initial coverage (17 countries, 80% UE PIB) – EPC members + EU members + enhanced cooperation + ratification UPC:

- Austria, France, Sweden, Belgium, Denmark, Malta, Luxembourg, Portugal, Finland, Bulgaria, The Netherlands, Italy, Estonia, Lithuania, Latvia, Slovenia, and Germany

- The **staggering of accession over time** will lead to **different generations** of unitary patents, Ireland **referendum** in 2024



New jurisdiction under the UPC

- As any new system that entry into force, implies changes and revision of the patent policy
- Now, any European patent can **be enforced or invalidated before the UPC** with effect **in all participating countries**
- **This includes those that already made national validations years ago and are still in force**
- The proprietor **can avoid the risk of centralized revocation** by removing the patents from the UPC's jurisdiction with an **opt out**
 - Only possible during a **transitional period** (regarding jurisdiction) starting 01.03.2023
 - After the transitional period: national patents are the only ones that will remain under the jurisdiction of the national courts

The new system has entailed making decisions

- New EU package introduces new options but also uncertainties, and entail making new decisions:
 1. For **European (EP) patents applications when granted:**
 - **Unitary patent or national validations**
 2. For **existing national validations of granted EP patents or the future national validations of EP applications:**
 - **Whether or not to avoid the jurisdiction of the UPC**



**What the
statistics
tell us
about the
use of the
new
system?**

Some facts from EPO press releases

- “In total, the EPO had **received about 800 requests for unitary effect by the end of May**, as well as **4500 requests for deferred publication of the grant of the European patent** which will make those patents eligible for requesting unitary effect in June and early July.’
- 14 June 2023: 600 registered unitary patents
- “In just **the first month** of the new Unitary Patent system, the EPO has already **received 2575 requests** for unitary effect on recently granted European patents, with **1 886 already registered as such**”



From the EPO

#UnitaryPatent



EUROPEAN
PATENT
CONVENTION

**Requests for
unitary effect:**

2,575

... on recently granted European patents

1,886

Registered Unitary Patents

To date, after nearly 6 months in



From the EPO Dashboard

Requests for unitary effect

Last updated
15.11.2023

This dashboard shows the location of patent proprietors; the status and evolution of their [requests for unitary effect](#); the technology fields (IPC) to which their patents relate; as well as the language in which their European patents were published and subsequently translated. Click on any block or map location to customise your display. The [35 technology fields](#) are those defined by WIPO and as used in the [Patent Index](#). The uptake rate is the percentage of requests received with respect to all European patents granted.

Requests received
13 796

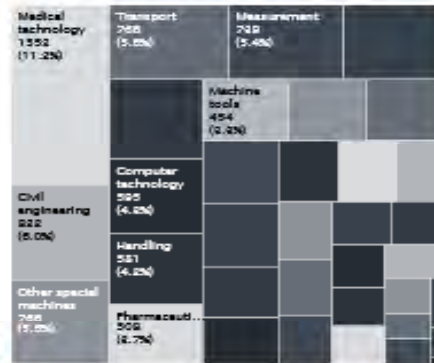
Registered Unitary Patents
13 415

Uptake Rate cumulative (current year)
15.9%

Status of registration



WIPO's technology fields (IPC)



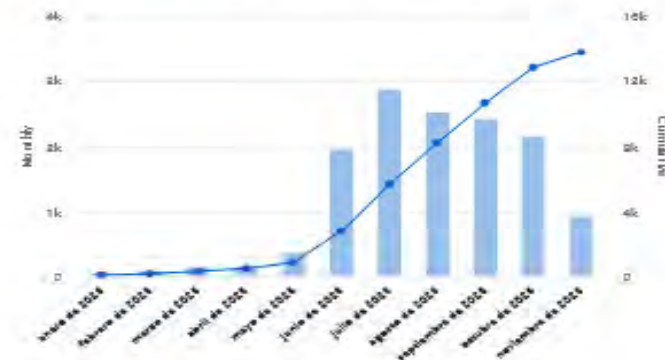
Procedural language



Translation language



Evolution of requests received



Origin of proprietors (first named on requests received)

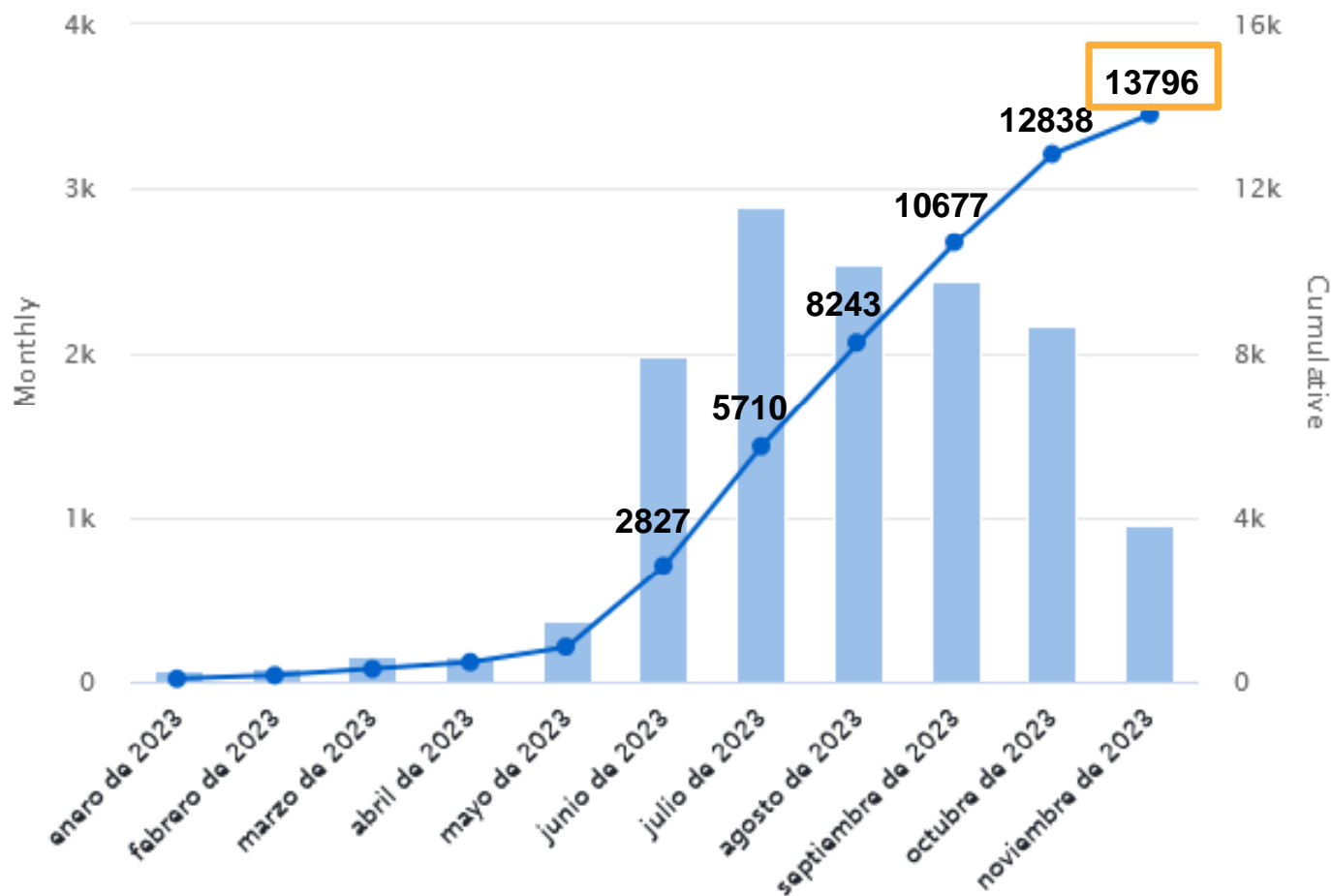


Evolution of UP requests received

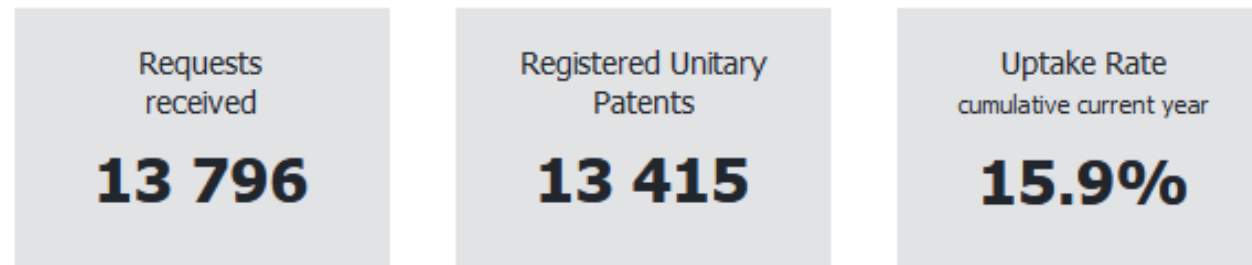


From the EPO Dashboard 15.11.2023

Evolution of requests received



What has been the acceptance of the unitary patent?



1 out of every **6** patents are estimated to be a unitary patent



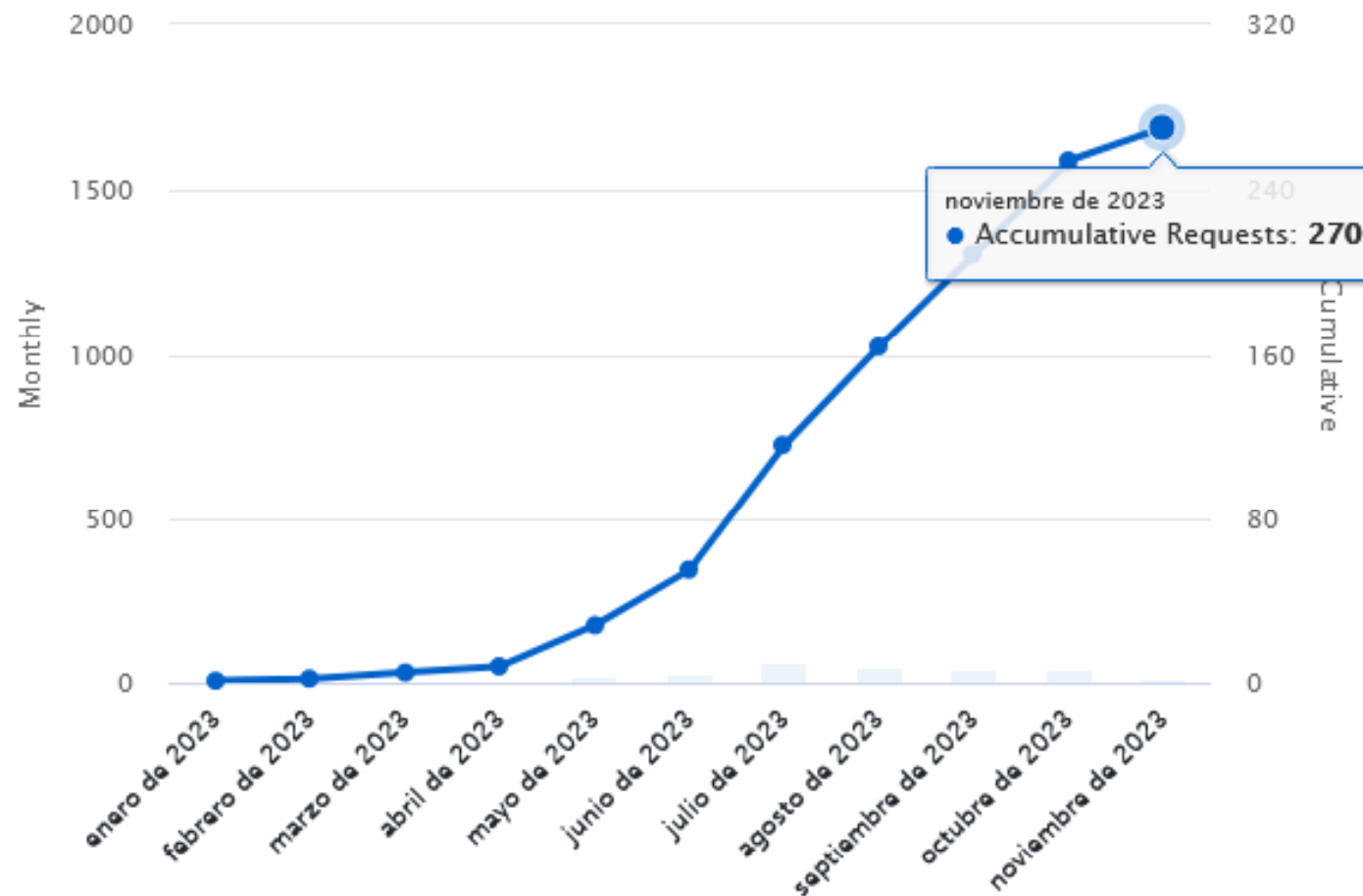
Rate of acceptance higher than expected prior to the entry into force of the new system.

Evolution of UP requests received in Spain



From the EPO Dashboard 15.11.2023

Spain



- Spain approx. 2% of the total of requests
- Germany: 2655 requests
- Spain 2% vs. Germany 19.3%

Unitary patent pros and cons

PROS

- Broad coverage
- Less expensive if wide EU coverage
- Single fee
- Limited translation costs
 - Single translation
- Simplification of the administrative procedure
- Central litigation forum
- Pan-EU remedies
- A single license can be granted in respect of a UP for all countries

CONS

- Limits in geographical scope (UK, Spain, Poland.....)
- More expensive if only needed limited coverage
- Loss of flexibility by not being able to abandon the patent only in some countries during the life of the patent
- National prior rights
- Central revocation
- Loss of flexibility in licensing (transfer of rights as a unity)

Costs and translation languages

- Cost until grant:
 - the same as for any European patent
- After grant:
 - savings in **translations** and savings in agent fees
 - During a transitional period (6 years + 6 years): **a single human translation** will be required to inform the content of the patent, but it will have no legal effect
 - FR or DE → EN
 - EN → Translation to another official language of the UE
 - Annuity costs

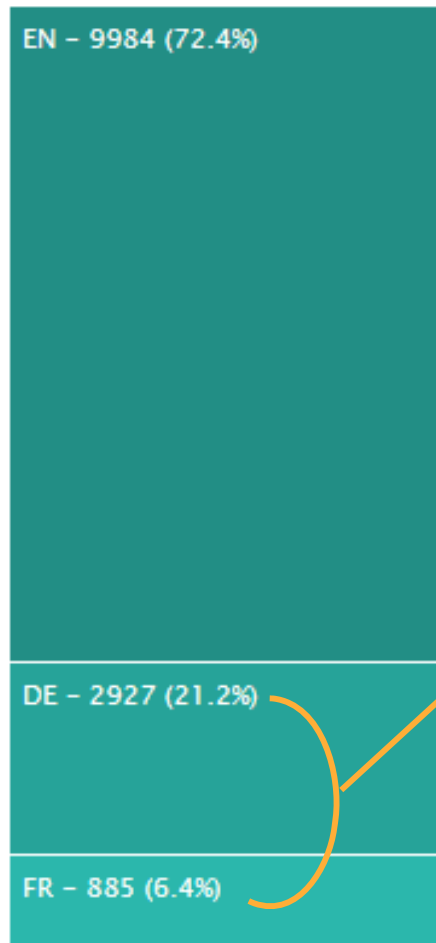
Year	UP	25 MS	EEUU
2	35	200	
3	105	1.452	
4	145	1.857	2.000
5	315	2.506	
6	475	3.250	
7	630	3.861	
8	815	4.615	3.760
9	990	5.554	
10	1.175	6.463	
11	1.460	7.526	
12	1.775	8.655	7.700
13	2.105	9.584	
14	2.455	11.028	
15	2.830	12.189	
16	3.240	13.569	
17	3.640	14.912	
18	4.055	16.166	
19	4.455	17.729	
20	4.855	19.227	
SUMA	35.555	160.633	13.460

What are the languages most used for the translation?

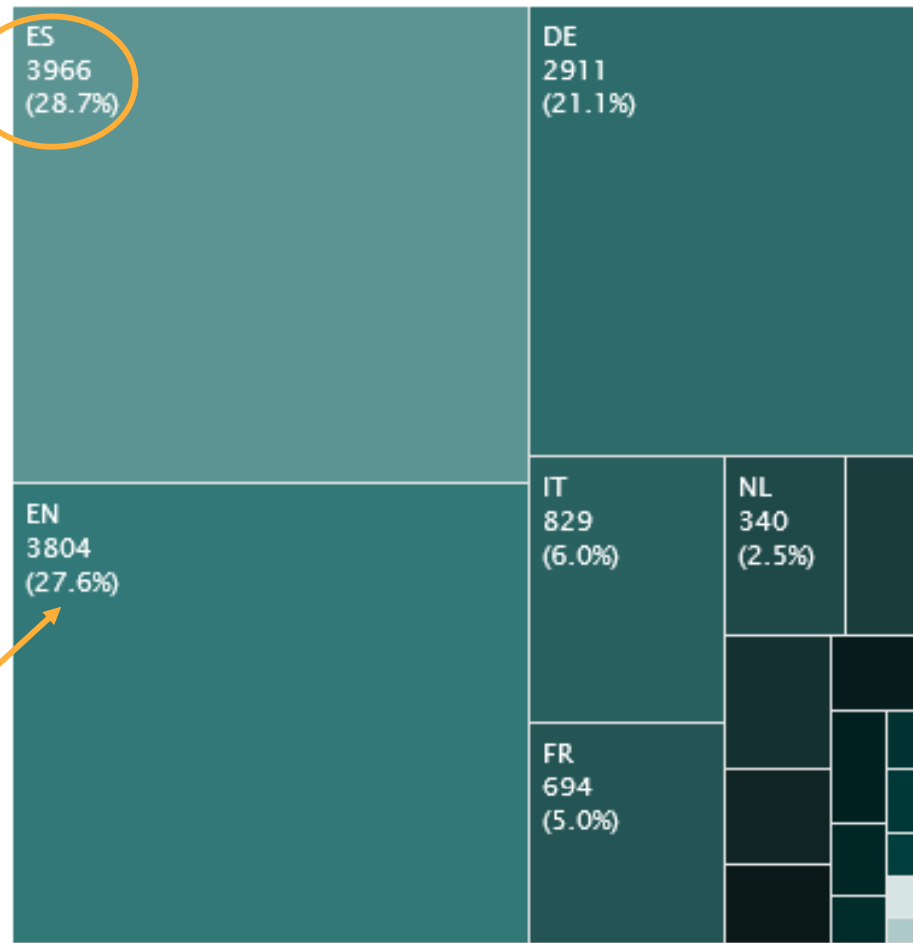


From the EPO Dashboard 15.11.2023

Procedural language



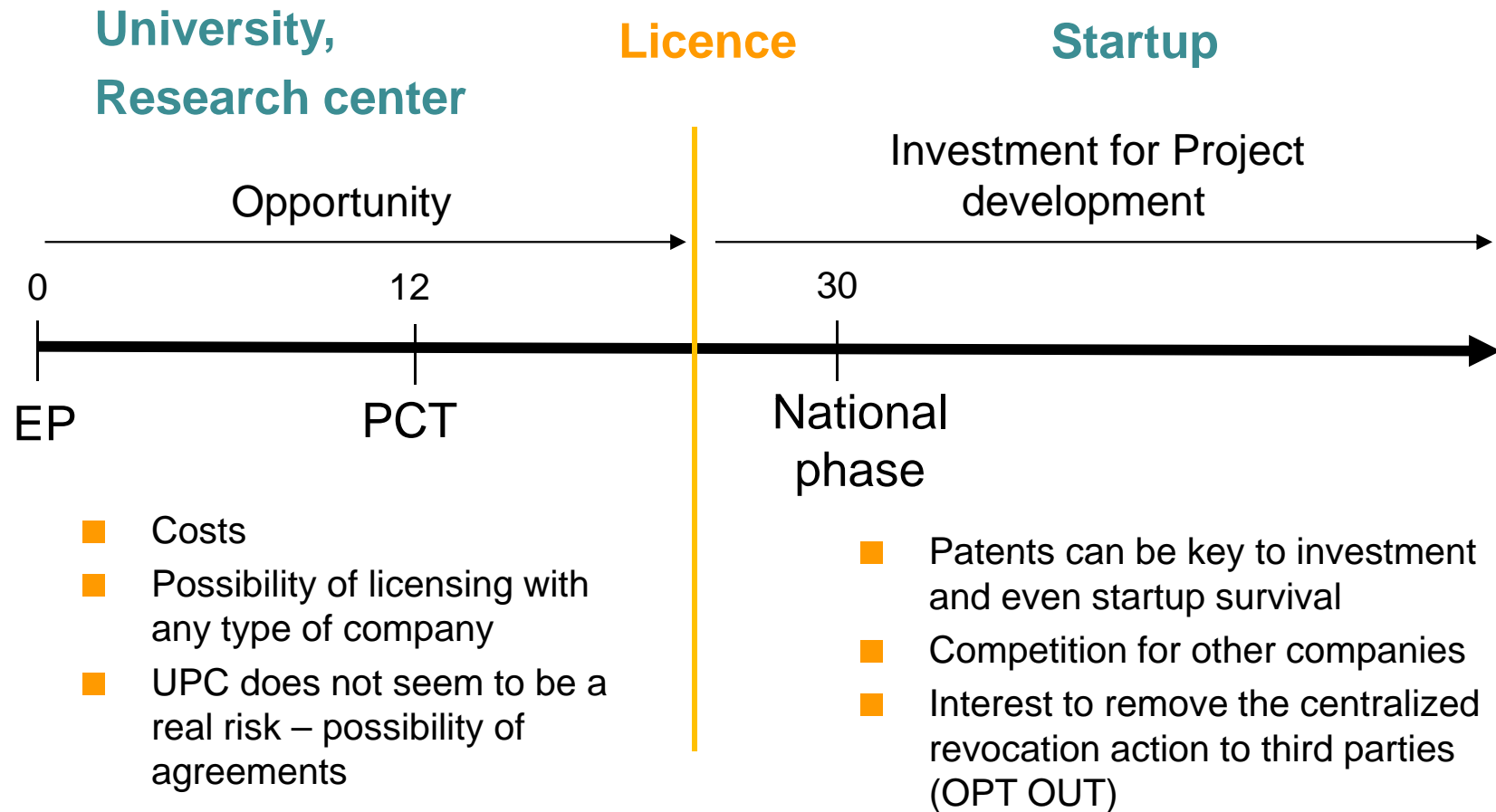
Translation language



¿Is the unitary patent suitable for all applicants?

- Unitary Patents will not be suitable for all applicants
- **Applicants who before starting the new system, after grant only maintain the patent in in the UK, Germany, and France**
 - **Around 50%** of European patent applications e.g., automobile sector
 - The combined **market** size of **these three countries** is approximately **three-quarters** the size of the combined market protected by a **Unitary Patent**.
 - Cheaper approach
 - No translation costs will be incurred beyond the costs of the claim translations required as part of the European Patent Office grant procedure.
 - Maintenance fees will also be lower
- **Applicants who are concerned about the risk of central invalidation of patent rights**

Same patent, different situations, own and third parties' interests change



What were small and medium/large companies expected to do?



Companies with small patent portfolios (with low litigation/validity conflicts)

- For new patents, the patent strategy will take precedence from a financial point of view
- But action before UPC could be devastating (budget)
- For classical EP patents consider opt-out



Companies with medium and large patent portfolios or even small ones with high conflict

- Costs will not be the main factor
- Litigation strategy will take precedence:
 - The strength of the patent
 - If a nullity action is expected
 - If an opposition is ongoing
 - Whether actions against infringers are to be brought centrally at the UPC
 - The bias/uncertainty of the UPC
- Contractual obligations

From which fields of technology are the companies that request the most unitary patents?



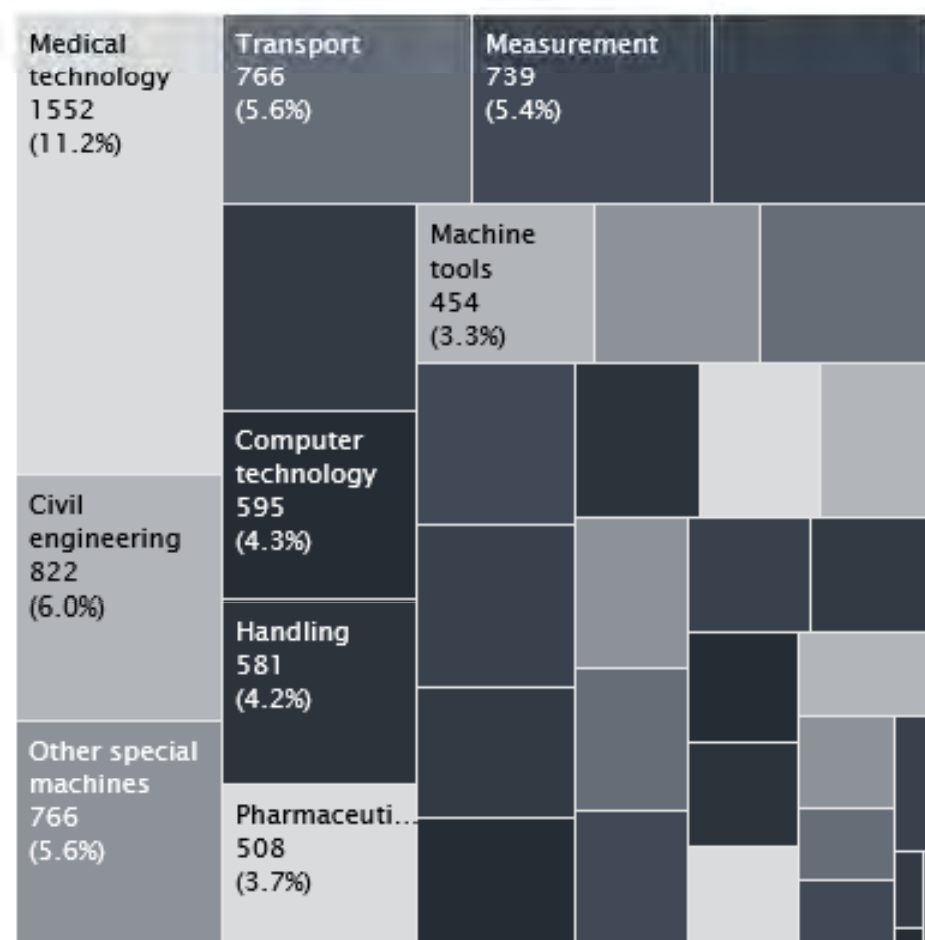
From the EPO Dashboard

16.09.2023
Technology



15.11.2023

WIPO's technology fields (IPC)



Nationality of the proprietors



From the EPO Dashboard

Origin of proprietors (first named on requests received)



18.10.2023

- Europe leads the way:
 - 68% of the total requests come from EPC states (particularly, DE, FR, UK)
 - Less enthusiastic:
 - 14% from the US
 - 11% from East Asian states
-
- 64% of the total requests based on Euro-PCT applications
 - 36% on Euro direct applications

Owners of unitary patents



From Kluweiplaw

- Companies with the most requests for unitary effect to date (data from 03.11.2023):

1. Siemens AG (219)
2. Volvo Truck Corporation (125)
3. Huawei Technologies (91)
4. Vestas Wind Systems (79)
5. Koninklijke Philips (58)

- Huawei Technologies is also the [top filer of opt-outs](#) from the UPC.
- The other 4 companies of the list are based in Europe.

<https://patentblog.kluweriplaw.com/2023/07/30/upc-proceedings-and-unitary-patents-statistics-and-trends-two-months-in/> (updated numbers at 03.11.2023)

Owners of unitary patents



From Siemens

SIEMENS

Contact English

Products & Services Industries Company

Search for...

Home > Company > Press

Press Release 30 October 2023 Siemens AG Munich

Siemens takes first place in the application for unitary patents

- Opportunities from European Unitary Patent, above all, in digital technologies
- Offerings on Siemens Xcelerator platform can be protected much more effectively with European Unitary Patent

Siemens is at the forefront of unitary patent applications. The European Unitary Patent – together with the associated Unified Patent Court (UPC) – started in June 2023. Since then, the European Patent Office has received more than 12,000 applications for the new European Unitary Patent – most of these applications came from Siemens.

The decision of
unitary effect must be
made beforehand

How the
unitary
effect is
obtained?

¿How is the unitary effect obtained?

- **Request of unitary patent of a granted EP before the EPO**
 - No later than **1 month** after the date of mention of the grant has been published in the EP bulletin.

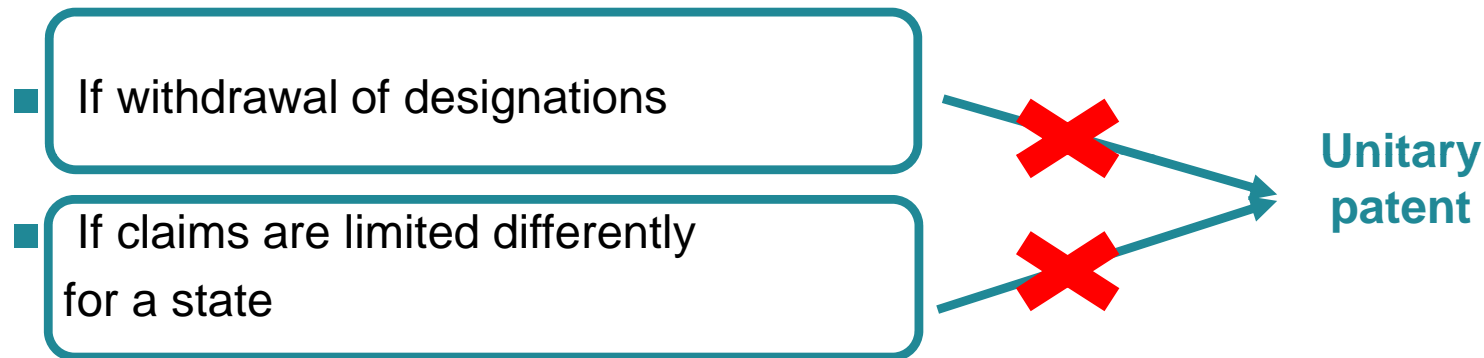


1 month vs. the usual 3 months for current Spanish validations!

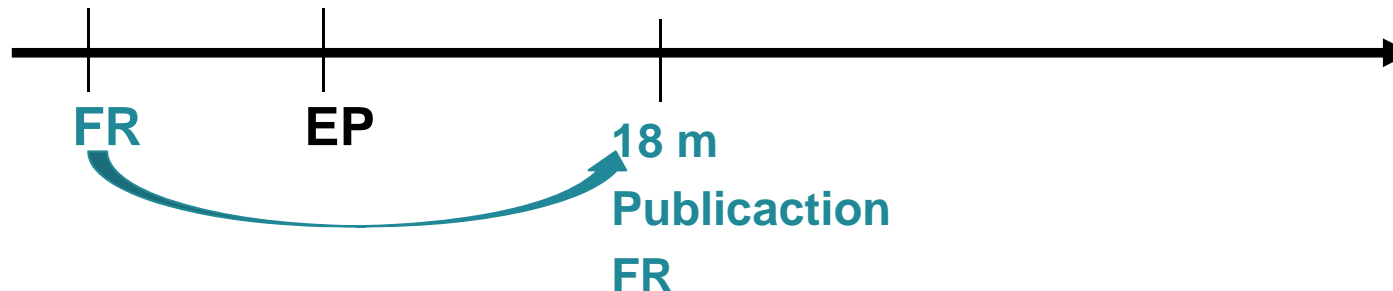
- In **writing**
 - In the **language of the proceedings** (different than CPE, use Form EPO with the 3 languages)
- **There are no fees** for the application for a unitary patent (to speed up the registration)

Conditions for registering the unitary effect

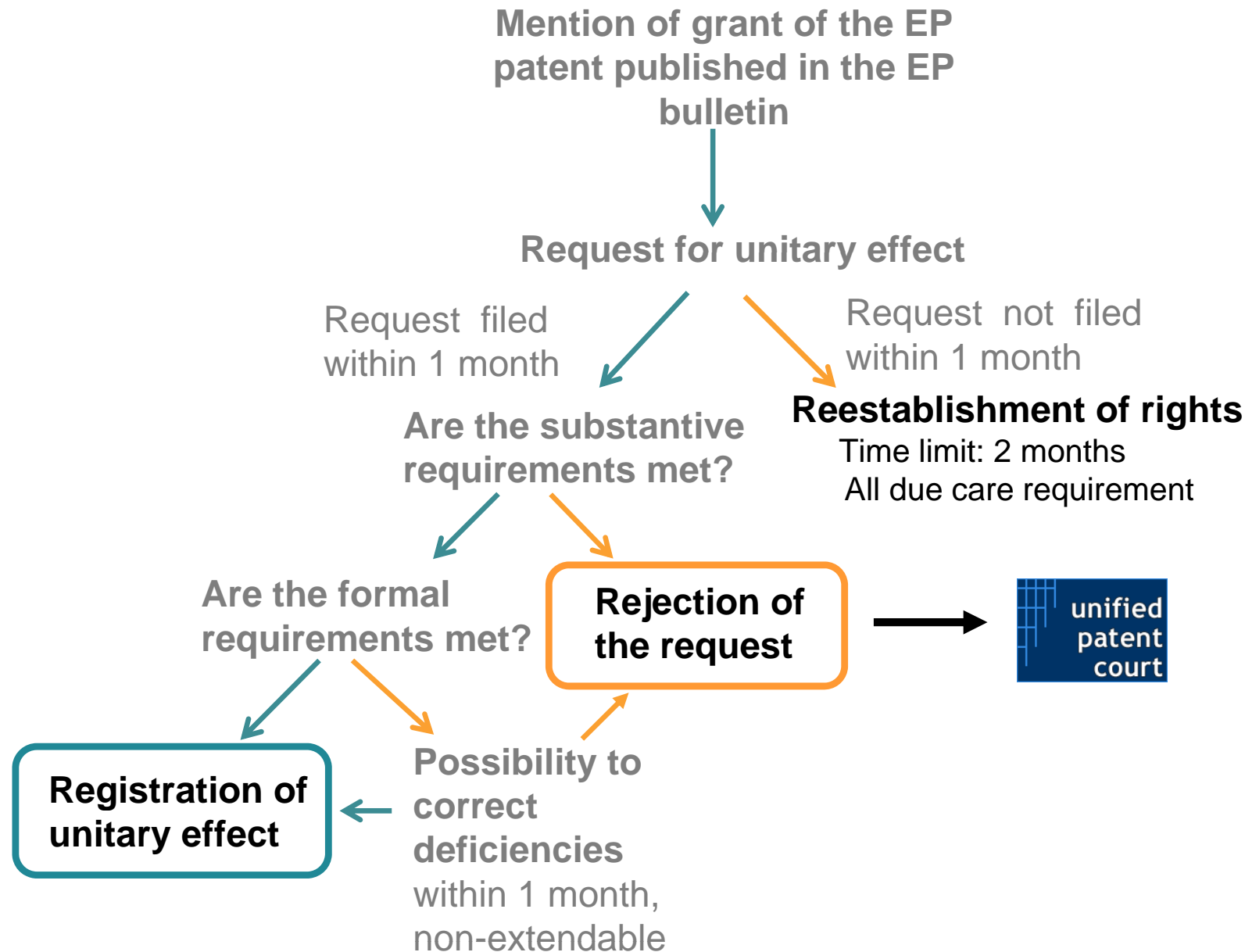
- Substantive requirement: European patent granted with **the same set of claims** in all participating Member States (25 MS)
- This means that **all these countries must be designated in the European patent.**



- Example to have withdrawn a designation or have limited the claims differently: Prior national rights



Registration of unitary effect



Appeal of the decision of the EPO to reject UE

- **Lodge an application** at the registry to reverse the decision of the EPO
 - In the language of the proceedings / Within 3 weeks / Fee: 1000 €
- Standing **judge to decide** the application
 - May invite the President of the EPO to comment on the application
 - Decide the application within 3 weeks
- Statement of **appeal by proprietor or EPO** against the decision of the standing judge
 - Decision within 3 weeks / Fee: 1000 €
- Standing appeal **judge to decide**
 - May invite the other party to comment
 - Decision within 3 weeks
- Parties bear their own costs

Safety net

- It **may be** that the **request** for unitary effect is only **rejected at a later stage** (1 month + 2 months reestablishment) after the deadline for national validation in certain countries has passed
- There might not, therefore, be time to get national validations *in lieu* of a unitary patent if the request for unitary effect fails
- Most countries taking part in the UP are providing a "**safety net**" in their national law
 - It means it will be **possible to validate a European patent late** in that country if a request for unitary effect has been rejected



Are there patent documents published for Unitary Patents?

- **If everything went well**, once unitary effect has been registered, a certificate is sent to the unitary Patent proprietors
- A specific identifier (the identifier "C0") is assigned to Unitary Patents in:
 - the Register for unitary patent protection
 - the European Patent Bulletin
 - In the data sets provided by the EPO, (to identify them through the EPO's patent information products and services, e.g., Espacenet and Global Patent Index)

The EPO publishes the European patent specification under the EPC, but **not additional documents are published for a Unitary Patent.**

UP Register has been operational since the new system came into force

Information from the unitary effect register

UP register and the information that can be retrieved

- The UP register is administered by the European Patent Office
- The UP register is integrated within the European Patent Register
- It has the same basic structure and functionality as the European Patent Register, but with some UP-specific data fields including, for example,
 - the date of filing of the request for unitary effect for the relevant European patent and
 - the “participating Member States” in which the UP has effect

<https://register.epo.org/regviewer>

When is unitary patent register displayed?

A

European procedure
EP About this file
EP Legal status
EP Federated register
EP Event history
EP Citations
EP Patent family
EP All documents
Unitary Patent
UP About this file
UP Event history
UP All documents

- EP patents granted on/after the entry into force of the system and unitary effect requested during 3 months after grant (1 month for request + 2 months time of reestablishment)

B

European procedure
EP About this file
EP Legal status
EP Federated register
EP Event history
EP Citations
EP Patent family
EP All documents
Unitary Patent

- EP patents granted on/after the entry into force of the system. For 3 months after publication of EP patent if unitary effect is not requested

C


European procedure
EP About this file
EP Legal status
EP Federated register
EP Event history
EP Citations
EP Patent family
EP All documents

- EP patents granted before 01.06.2023
- EP patent applications filed before 01.06.2023
- EP granted on/after 01.06.2023 – unitary effect not requested during 3 month after grant

UP register – About this file



From the UP register



Europäisches Patentamt
European Patent Office
Office européen des brevets

European Patent Register

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EP3666132

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- Unitary Patent**
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UP About this file: EP3666132 C0

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EP3666132 - BEVERAGE-MANUFACTURING DEVICE [\[Right-click to bookmark this link\]](#)

Status	Unitary effect registered <i>Database last updated on 21.10.2023</i>
Most recent event 	25.08.2023 New entry: Payment of renewal fee
Proprietor(s)	For all participating member states Daito Giken, Inc. 1-14, Higashi-Ueno 1-chome Taito-ku, Tokyo, 110-0015 / JP [2023/28]

UP register – About this file




From UP Register

Procedural language	EN
(Principal) place of business on the date of filing ⓘ	Principal place of business ⓘ
Unitary Patent Protection	07.06.2023 Date of request for unitary effect [2023/28]
	12.06.2023 Decision on the request for unitary effect: Positive [2023/28]
	12.06.2023 Date of registration [2023/28]
	07.06.2023 Date of legal effect [2023/28]
Member States covered by Unitary Patent Protection ⓘ	12.06.2023 AT, BE, BG, DE, DK, EE, FI, FR, IT, LT, LU, LV, MT, NL, PT, SE, SI [2023/28]

UP register – Event history



From UP Register



Europäisches Patentamt
European Patent Office
Office européen des brevets

European Patent Register

Deutsch English Français
Contact

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✉ Register Alert (email alerts)

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European procedure

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✕ UP Event history: EP3666132 C0

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UP register - Documents



From UP Register



Europäisches Patentamt
European Patent Office
Office européen des brevets

European Patent Register

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European procedure

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Quick help

→ What does C0 stand for?

→ What documents are displayed in this section?

Maintenance news

⊗ UP All documents: EP3666132 C0 Dossier alert: RSS Email

🔍 Refine search ↓ Selected documents ↓ Zip Archive ↗ Espacenet 📄 Report error 🖨 Print

All documents(5) Search

Number of documents: 5

Total number of pages: 346

Espacenet – Legal events



From the Espacenet

☆ **EP3666132A1 BEVERAGE-MANUFACTURING DEVICE**

Bibliographic data Description Claims Drawings Original document Citations **Legal events** Patent family

Register ↗ **Unitary Patent** ⓘ **Global Dossier** ↗

Applicants TREE FIELD INC [JP] +

Inventors KIHARA KAISHUN [JP]; TORIZU TAISUKE [JP] +

Classifications

IPC A47J31/00; A47J31/36; A47J31/42; A47J31/44; A47J31/60; B67D1/08; G07F13/06;

GPC A47J19/02 (US); A47J31/00 (EP); A47J31/36 (EP); A47J31/41 (US); A47J31/42 (EP,KR,US); A47J31/44 (EP); A47J31/4407 (KR); A47J31/468 (US); A47J31/52 (EP); A47J31/525 (KR); A47J31/60 (EP,KR); B67D1/08 (KR); G07F13/06 (EP,KR); B67D1/08 (EP);

Priorities JP2017152703A:2017-08-07; JP2018028916W:2018-08-01

Application EP18843133A:2018-08-01

Publication EP3666132A1:2020-06-17

Published as CA3075421A1; CN110996730A; EP3666132A1; EP3666132A4; EP3666132A5; ES2947058T3; JP2019030430A; JP6467614B1; KR102501401B1; KR20200163485A1; WO2019031362A1

Bibliographic data Description Claims Drawings Original document Citations **Legal events** Patent family

Data originating from sources other than the EPO may not be accurate, complete, or up to date.

Event indicator	Category	Event description	Countries	Event date	Effective date	Details
EP 17P	D: Search and examination	REQUEST FOR EXAMINATION FILED		2020-06-17	2020-03-05	
EP AX	W: Other	REQUEST FOR EXTENSION OF THE EUROPEAN PATENT	BA ME	2020-06-17		
EP DAX	Y: Correction/deletion of event information	REQUEST FOR EXTENSION OF THE EUROPEAN PATENT (DELETED)		2020-11-11		
EP U01	W: Other	REQUEST FOR UNITARY EFFECT FILED		2023-07-12	2023-06-07	
EP DAV	Y: Correction/deletion of event information	REQUEST FOR VALIDATION OF THE EUROPEAN PATENT (DELETED)		2020-11-11		
EP A4	D: Search and examination	SUPPLEMENTARY SEARCH REPORT DRAWN UP AND DESPATCHED		2020-06-24	2020-05-26	
EP U07	W: Other	UNITARY EFFECT REGISTERED	AT BE BG DE DK EE FI FR IT LT LU LV MT NL PT SE SI	2023-07-12	2023-06-12	

The introduction of the unitary patent has a number of implications on lesser-known factors that are worth considering

Patents as
objects of
property.
Licencing
conditions.
What
changes?

Impact of the new system on patents as objects of property




- There is a question to be considered regarding the applicable law
- Which law applies?
 - The unitary patent regulation **makes direct reference to national law**, but the UP must be governed by the property **law of a single country**
 - The law of the EU participating **MS** in which the applicant has its **residence or principal place of business**
 - For **non-participating MS**, the applicable law is **German law**
 - The applicable law does not change even in case of transfer of the patent

Why does the applicable law matter on patents as objects of property?

- It matters because it **determines several asset-related issues**
 - The requirements for a transfer to be valid
 - Who is entitled to the patent
 - The possibility of securing a loan using the patent as collateral
- It also **determines the rights and obligations of co-owners** in the case of co-ownership
 - The default position varies between jurisdictions, and this may have significant implications for how the UP can be exploited
 - Whether co-owners **need consent** of the other party to *licensing (non-exclusive license)*: FR not required but notification and fair payment; DE required
 - Whether co-owners are **permitted to practise the invention** without the agreement of the other co-owner
 - Whether one co-owner can **assign its share** of the patent without the other co-owner's agreement; and
 - Whether one co-owner can **sue for infringement** without the agreement of the other co-owners

Applicable law to UPs as objects of property for joint applicants



First applicant (Principal place of business)	First applicant (place of business)	Second applicant (principal place of business)	Second applicant (place of business)	Applicable law
France	-	Italy	-	France
Spain	-	Italy	-	Italy
Spain	France	US	-	France
Spain	-	UK	Italy	Italy
Spain	-	US	-	Germany

In R&D collaborations / companies working together, agree over whose **name** is going **to be listed first** for co-owned patents

UP register about this file - Principal place of business



From the Register

Procedural language

DE

(Principal) place of business
on the date of filing



Principal place of business

Unitary Patent Protection

04.10.2023 Date of request for

13.10.2023 Decision on the request

13.10.2023 Date of registration

20.09.2023 Date of legal effect

Click to view the residence or principal place of business on the date of filing (Article 7(1)(a) Regulation (EU) No 1257/2012) as indicated in EPO Form 1001 or PCT Form RO/101.

7-1

Name:

Bouaouaja, Herr Kamal

8-1

Anschrift:

Wasendorferweg 1
8750 Judenburg
Österreich

Staatsangehörigkeit (Staat):

Österreich

Staat des Wohnsitzes oder Sitzes:

Österreich

Anmelder 2

7-2

Name:

Bouaouaja, Herr Daniel Karim

8-2

Anschrift:

Kornweg 8
8753 Fohnsdorf

Impact on the new system on licenses and collaboration agreements



- The **UP** is a unitary right
 - It can only be assigned in its entirety (all UP MS)
 - It can be licensed in individual UP MS
 - Even for parts of the territory of such a state
- All licenses of **EP patents** are affected by the introduction of the UPC
 - If not opt-out is done, they are subject to the jurisdiction of the UPC
 - Licensees do not have automatic right to be involved in the opt-out decision
 - Dialogue with the patent owner to align the position with respect to the opt-out
 - In case of multiple licensees, patent owner may be in difficult position if the licensees have different views among them

Issues that should be addressed

■ Decision whether opt-out or not:

- It is up to the patentee to file the opt-out or withdraw it
- Exclusive licensee may want to influence or control the decision of opt-out, and to opt back in

■ Decision to enforce a patent:

- Exclusive licensee
 - has the authority to enforce a patent without consent from the patentee unless provided otherwise in the license
 - Need notification to the patent proprietor
- Non-exclusive licensee:
 - Can bring an action if the agreement expressly provides for it and the patentee is informed
 - The patentee may join an action commenced by a licensee
 - Both patentees and non-exclusive licensees should check their licenses to agree with who can be a party to an action before the UPC

Issues that should be addressed

- **Decision to defend the validity of a patent:**
 - Before an infringement action by a licensee, validity can only be contested if the patentee participates. The other party will have to bring a revocation action against the patentee
 - Exclusive licensee: It seems reasonable that could have also the control of the defense (their business is directly affected)
 - If multiple licenses, rights often best kept by licensor
 - Licensor will want to have a degree of control and coordination in relation to revocation proceedings
 - If revocation counterclaim is successful:
 - Loss of the patents in the designated states
 - Impact on agreements with other licensees

Ownership /co-ownership situation

- **If only one applicant** for all states:
 - No problem. Licensing to one or more parties
- **If co-ownership of EP patent:**
 - Needs to coordinate for the decisions to be made:
 - opt-out
 - UP
 - who listed as first applicant (applicable law to the contract different to applicable law to the UP as object of property)
- **If different owners for different countries:**
 - Upon registration of UE, they become **join proprietors**
 - Such co-owners also need to coordinate for the decisions to be made
 - The question remains, whether each of the owners could separately dispose of their parts of the UP by assignment



Licenses of right



- Option of interest to some companies, institutions for instance dedicated to transfer

- **Requirements:**

- The patent must be granted with unitary effect
- The proprietor should file a statement before the EPO stating that he is prepared to allow any person to use the invention as a licensee in return for appropriate compensation

- **Reduction of fees** falling due after receipt of the declaration by 15%

- Possible reduction by about **5.000 euros** over the maximum 20-year life of a patent

- **Simplification:** single entry in the UP register

- In case of dispute: UPC will determine the appropriate amount

- It can be withdrawn at any time

- If the license is withdrawn, the amounts should be returned
- The withdrawal does not take effect until the amounts are returned

- Not available if there is an exclusive license registered in the UP Registry

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Coverage, codes and statistics

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Weekly updates

Updated regularly

Weekly updates

These files are updated every Thursday. If Thursday is a public holiday, the update takes place on Friday.

File description	File type	File size	Last updated	Download
Contents and coverage of the DOCDB bibliographic data	XLSX	1.2 MB	W 40/2023	📄 download
Contents and coverage of the INPADOC legal event data	XLSX	779 KB	W 40/2023	📄 download
Legal event codes	XLSX	285 KB	W 40/2023	📄 download

<https://www.epo.org/en/searching-for-patents/data/coverage/weekly>

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From Inpadoc 15.11.2023

Number of
events

Description

10304	20230609	+	REQUEST FOR UNITARY EFFECT FILED
3	20230609		DATE OF FILING OF THE REQUEST FOR UNITARY EFFECT CHANGED
1	20230609		REQUEST FOR UNITARY EFFECT REJECTED
1	20230609		REQUEST FOR UNITARY EFFECT DELETED
10022	20230609		UNITARY EFFECT REGISTERED
14	20230609		DATE AND/OR PURPORT OF DECISION ON REQUEST FOR UNITARY EFFECT FOR THE EUROPEAN PATENT CHANGED [DECISION IS POSITIVE]
1	20230914		MEMBER STATES COVERED BY UNITARY PATENT PROTECTION DELETED
12	20230609		WITHDRAWAL OF THE REQUEST FOR UNITARY EFFECT
11	20230914		DATE OF REGISTRATION OF UNITARY EFFECT CHANGED
1	20230914		DATE OF REGISTRATION OF UNITARY EFFECT DELETED
1	20230914		DATE OF LEGAL EFFECT OF UNITARY PATENT PROTECTION DELETED
15	20230627		UNITARY EFFECT: PLACE OF BUSINESS CHANGED
59	20230704		NAME OR ADDRESS OF THE PROPRIETOR CHANGED [AFTER THE REGISTRATION OF THE UNITARY EFFECT]
31	20230913		TRANSFER OF RIGHTS OF THE UNITARY PATENT AFTER THE REGISTRATION OF THE UNITARY EFFECT
65	20230704		APPOINTED REPRESENTATIVE FOR THE UNITARY PATENT PROCEDURE CHANGED [AFTER THE REGISTRATION OF THE UNITARY EFFECT]
10	20230913		APPOINTED REPRESENTATIVE FOR THE UNITARY PATENT PROCEDURE DELETED [AFTER THE REGISTRATION OF THE UNITARY EFFECT]
1975	20230626	+	RENEWAL FEE PAID [UNITARY EFFECT]
4	20230626	+	RENEWAL FEE PAID WITH PENALTY [UNITARY EFFECT]
3	20230627		ACTION FILED AT THE UNIFIED PATENT COURT [INFORMATION PROVIDED BY THE UPC]
1	20230920		REQUEST FOR RE-ESTABLISHMENT OF RIGHTS ACCEPTED [UNITARY EFFECT]
4	20230628		INTENTION TO LICENSE DECLARED [UNITARY EFFECT]

<https://www.epo.org/en/searching-for-patents/data/coverage/weekly>

Searches in EP Bulletin



From EP Bulletin 15.11.2023

Criteria

Licence

ULCC Licensing commitment

ULCCSB Licensing commitment (standardisation body)

USLC Statement concerning licences of right

USLCWD Withdrawal of statement concerning licences of right

ULCS Licensee

ULCRG Licence registration

ULCRGC Licence registration (country)

Lapse

Other

EP + UP BULLETIN

Index USLC

Go to

Term

2023

202306

Query

USLC=2023

= < <= > >= [] () " # ? * [Copy] [Paste] [Print]

History


ID	Database	Result	Query	Parsed query
\$1	BULL 2023/46	5	USLC = 2023	USLC = 2023

<https://data.epo.org/expert-services/index.html>

Searches in EP Bulletin













From EP Bulletin 15.11.2023





Query 

USLC = 2023

100%





Result list  1 / 5 

Publication







3173704




3517631

3599421

3611668

3901450

Document  1 / 5 

3173704

UP - Most recent event
Renewal fee - Published on 15.11.2023 [N/P]

UP - Unitary patent protection
07.07.2023 - Request for unitary effect
19.07.2023 - Registration of unitary effect
07.06.2023 - Legal effect of unitary effect

UP - Member states covered
AT BE BG DE DK EE FI FR IT LT LU LV MT NL PT SE SI

UP - Proprietor
Howatherm Klimatechnik GmbH
Keiperweg 11-15, 55767 Brücken / DE

UP - Representative
Westphal, Mussnug & Partner Patentanwälte mbB
Am Riettor 5, 78048 Villingen-Schwenningen / DE

UP - Statement concerning licences of right
19.07.2023 - Registration

UP - Renewal fee
09 - Renewal fee payment: 11.10.2023

Espacenet / UP Register – intention to license



From the Espacenet /Register

Espacenet

1. >

☆ EP3517631A1 MUTANT MICROORGANISMS TO SYNTHESIZE COLANIC ACID, MANNOSYLATED AND/OR FUCOSYLATED OLIGOSACCHARIDES Available in ▾ ⋮

Bibliographic data Description Claims Drawings Original document Citations Legal events Patent family

Data originating from sources other than the EPO may not be accurate, complete, or up to date.

Event indicator ^	Category ^	Event description ▾	Countries ^	Event date ^	Effective date ^	Details ^
PATENT						APPLICATION HAS BEEN PUBLISHED -
EP INTG	D: Search and examination	INTENTION TO GRANT ANNOUNCED		2022-12-28	2022-11-30	
EP U79	S: Licensing information	INTENTION TO LICENSE DECLARED [UNITARY EFFECT]		2023-08-02	2023-06-19	

UP Register

Licences of right

19.06.2023

Filing of a statement concerning licences of right

[2023/31]

Centralized revocation is possibly one of the major concerns of users of the new system

Central revocation UPC vs. opposition at the EPO

Central revocation at the UPC

- Given the **broad territorial coverage of UPs**, the existence of a **UP may trigger conflicts that did not exist under the old system**, and prompt parties to file a revocation or opposition action that might not otherwise have arisen
- Although the likelihood is low, the unitary patent is also affected by **national prior rights**
 - Prior national rights are those national Applications of one or more states designated in the EP application whose filing dates are prior to the filing or priority date of the EP application and which are published as national applications or patents on or after that date

Is any safeguard against the effects of a central revocation at the UPC?

- **Option taken by some countries: Allow double protection**
(simultaneous protection for the same subject matter, in the same state, by two patents but with different territorial level, e.g. national patent / unitary patent, same filing date) => **Parallel filing options**
- Only possible in some states

It avoids “all eggs in one basket” situation. For countries with largest economies, a national patent may provide a safeguard

This option also opens new strategies in litigation

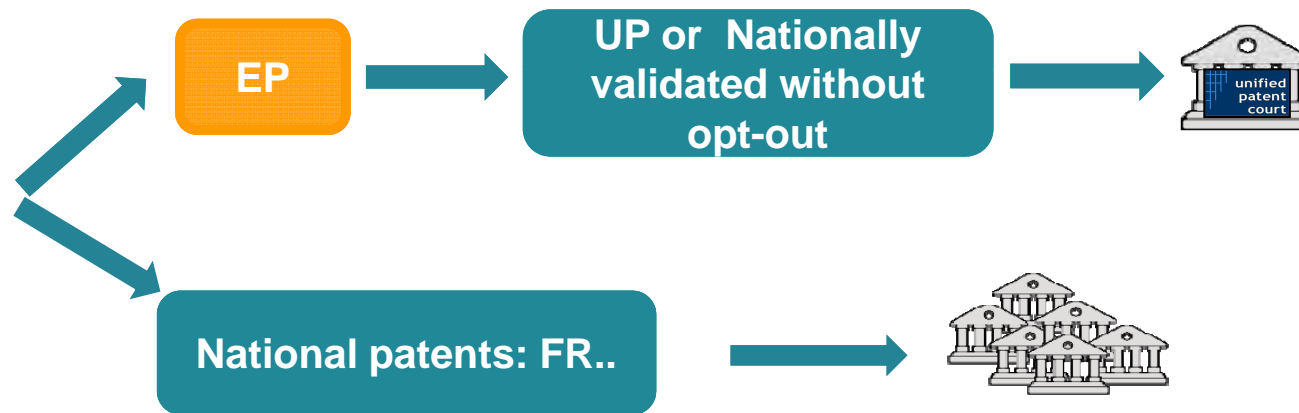


Double protection provisions in the participating UPC MS

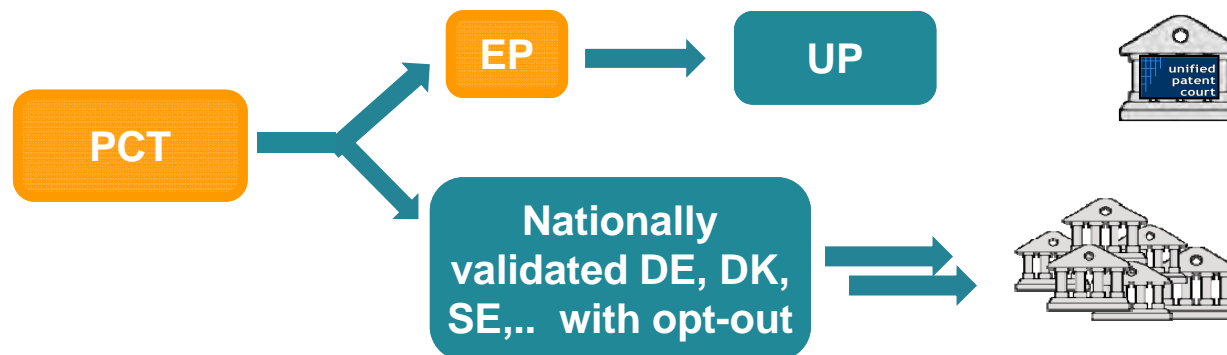
Participating MS	Double protection allowed for a national patent and EP/UP?
Austria	Yes
Finland	Yes
Sweden	Yes
Denmark	Yes
Portugal	Yes
France	Yes, but for EPs only if are not opted out
Germany	Yes, but for EPs only if are not opted out Also, new provision as a safeguard for defendants against simultaneous assertion of patents (Article II § 18 IntPatÜG)
Estonia	Yes, but only for national patent and UP
Italy	YES Italian patent will maintain its effect and coexist with a European patent designating Italy or a European patent with unitary effect for the same invention. Not safeguard for defendants
Netherlands	No
Belgium	No
Bulgaria	No
Lithuania	No
Luxembourg	No
Latvia	No
Slovenia	Allowed for EPs under certain considerations
Malta	No information

Strategic considerations under the new system on parallel filing options

- Think about combining filings in **core European countries**, same or similar protection in a country by:



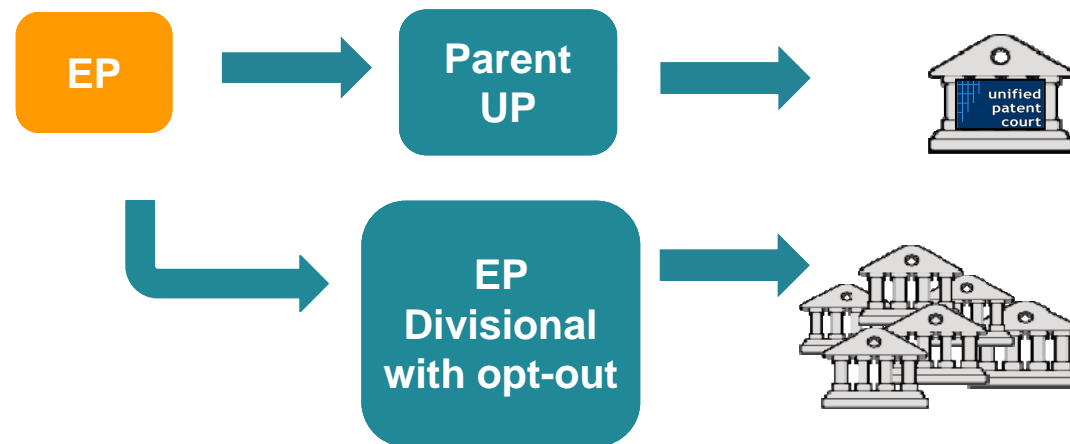
- For new or pending PCT application consider:



Is any other strategy to mitigate the effects of a central revocation that could be taken by the patentee?

■ What?

- **Split approach** based on a **combination** of parent and divisional:



- Also open to choose to **initiate a dispute before the UPC** with different patents (patent in the new system) or **national courts** (patent outside the system)

Parent and divisional strategy cont.

■ When?

- During the **transitional period of opt-out**

■ Scope?

- Provisions on **double patenting** at the EPO (G4/19)
 - Small differences may be enough. Largely overlapping subject-matter is accepted
 - After EPO issue R71(3) EPC communication. Possibly same examiner. Quick grant expected
 - Generally, interest in slow grant
 - Advisable to maintain the more limited patent in the UPC
 - Strategy of maintaining open the option of new divisional applications for covering activities of the possible infringers gain more importance under the new system

Opposition proceedings at the EPO



- The option of centralized revocation at the EPO **provides a cost-effective alternative to the UPC**
- It is not expected that the number of oppositions will fall
- Advantages:
 - Affect the entire patent (e.g., UP and EP-ES)
 - Well-established rules
 - Opposition fee much lower than the basic fee for revocation or the fee for a counter-claim for revocation at the UPC (880 € vs. 20000 €)

Opposition at the EPO vs. central revocation at the UPC

- The choice may depend on the speed at which the Boards of Appeal of the EPO decide appeals in opposition.
 - The RPBA20 in force since 01.01.2020 have also the **aim of enhancing the throughput of the Boards**
 - In 2023 proposal of **amendments** to the rules of procedure with the same objective
 - The Boards of Appeal are steadily reducing their backlog. According to BoA conference in November 2023:
 - Expected **backlog** at the end of 2023: ≤ 5000 cases
 - **Currently** 90% cases in 30 months
 - **Objective** end 2025: less than 10% cases pending for more than 24 months
- The **Unified Patent Court (UPC)** will offer opponents **a second chance** by providing another forum for central revocation (in respect of the UPC states)
- Revocation actions at the UPC will not replace EPO oppositions, but they **will supplement** them

Opposition and revocation actions running simultaneously

- It is possible to **file a revocation action** or a **counterclaim for revocation** before the UPC:
 - If the opposition period has not expired or
 - **If opposition proceedings are currently pending**
- In this scenario, due to the difference in speed of the UPC vs. EPO opposition proceedings, EPO will always be behind
- To close the gap:
 - UPC can ask to the EPO (opposition division and BoA) to accelerate proceedings for the same patent
 - UPC may stay proceedings in case of existing an opposition against the same patent, when the decision is expected rapidly or by requesting to the EPO for acceleration
 - Rapidly could mean no more than 6 months

When Opposition/central revocation at the UPC

When opposition



- If still within the 9-month opposition period
- If the patent has been opted out
- If limited budget
- If you can afford waiting for a decision
- If there is interest in invalidating the patent in non UPC countries (e.g., ES)
- If you want to use a strawman

When UPC



- If you have missed the opposition period
- If there are national prior rights
- If there are issues of lack of entitlement
- If sufficient budget and a quick decision is needed
- If you have a good case and expect to win the case and recover costs
- If infringement action before the UPC, more sense to file a counterclaim for revocation than an opposition

When both



- If new and pertinent prior art is found and it can no longer be introduced into the pending opposition proceedings (late filing)
- If costs do not play a role
- If you want to apply pressure on the patentee
- If opposition already ongoing, as defense against an infringement actions before the UPC

Number of revocation actions before the UPC vs. Number of oppositions



From the UPC

- The number of **patents opposed at the EPO** each year is typically around 4000 (about 3% of granted patents)
- The number of **UPC revocation actions** are around 34 cases (direct and counterclaim)
- Of the 21 cases in which there is a **direct revocation action at the UPC**, 12 also have an **opposition pending**.

What await us?



What's next?

- With **more proposals of the EU comission to armonize EU rules** and support the unitary patent system
 - **Standard essential patents** (SEPs) that set out requirements for complying with industry standards, such as 5G mobile standards
 - The **compulsory licensing** of patents in crisis situations
 - **Supplementary protection certificates** through which pharma companies can extend the patent life of drugs

Standard Essential Patents (SEPs)

- Inventions that are necessary to implement a particular standard or technical specification.(e.g,. technology 5G, wireless connectivity, navigation systems in cars)
- The EU Commission's SEP Proposal opts for:
 - A more regulated approach to SEP licensing and litigation
 - Establishing guidelines for the negotiation and determination of fair, reasonable, and non-discriminatory (FRAND) terms and royalties
- Creation of an alternative dispute resolution mechanism:
 - **SEP owners** will need to register their SEPs with a new administrative body "Competence Centre" to be established within the EUIPO
 - **Competence Centre**
 - Perform essentiality checks and
 - Determine FRAND terms and conditions
- The UPC will be responsible for the procedures resulting from a UP
 - Possibility of obtaining injunctions at European level
- However, owners will be barred from seeking court remedies for unlawful patent use, **prior to having completed the mandatory FRAND determination process**

Compulsory licensing

- To strengthen the compulsory licensing mechanism in specific crisis scenarios. Nowadays 27 national law applicable.
- It enables the **European Commission** to authorize third parties to use certain patents, utility models, or SPCs without the consent of the rightsholders
- This proposal establishes the **general conditions, the remuneration, and the procedural aspects** of these licenses
- It also sets out the **circumstances in which this mechanism can be applied**, specifically during public health emergencies
- The European Commission will receive assistance and advice from an **advisory board** regarding the feasibility of granting compulsory licenses.
- The advisory board will do this by issuing **non-binding opinions** to the European Commission

Centralized SPC system

- Creation of a unitary SPC to supplement the unitary patent
- The centralized SPC procedure may be used by any company or institution that holds
 - A valid patent for a medicinal product or plant protection product
 - A commercial authorization in the EU
- A combined application for the grant of both may be requested:
 - Unitary SPC
 - National SPC for countries not covered by the unitary patent
 - A single examination for all of them
- New system simplifies both the application and examination procedure
- National offices will continue to be able to grant national SPCs
- A product cannot be protected by both a unitary SPC and a national SPC in the same state

TO BE
CONTINUED...

A hand holding a red marker is shown on the right side of the image, having just finished writing the word 'CONTINUED...' in red marker. The dots of the ellipsis are being drawn as the hand moves away from the text.



Thank you for your attention

mjane@zbm-patents.eu