

EIP

What are the options if you want to be able to use the UPC?

All unitary patents will fall within the competence of the Unified Patent Court (UPC). Additionally, classical validations of European Patents in states which have ratified the UPC agreement will fall within the competence of the UPC (unless opted-out).

The European Patent Office (EPO) has announced procedural options which applicants can use to delay grant. After the date of German ratification of the UPC agreement, for any case where a R71(3) EPC communication (a notice of allowance) has been issued but the patent has not yet granted, it will be possible to request delay of grant until after the Unitary Patent system is live, to allow the patent to be converted into a Unitary Patent.

During the transitional period, national courts and the UPC share competence in respect of classical validations of European patents (that are not opted out) in the member states participating in the UPC. If an action is brought in a national court, it may no longer be possible to use the UPC for an action involving the same parties in respect of that patent (under the court jurisdiction rules set out in the “Brussels” Regulation, although some aspects of how these rules will apply as between the UPC and national courts remain unclear). Therefore, if use of the UPC is important, there is merit in being the party to initiate litigation so that you choose the forum.

If you wish to delay grant until after the UPC is operational, it may be worth considering using strategies to delay prosecution (e.g. deadline extensions, further processing). Your usual EIP contact can advise on these if of interest.

Interested in learning more about the UPC? This is one of a series of short explainers about the Unitary Patent and Unified Patent Court. The full list of articles is:

- What is the Unitary Patent, and how do I get one?
- What is the Unified Patent Court?
- What is the likely timing of the UPC and UP coming into being?
- How does the opt-out work in the transitional period of the UPC Agreement?
- What are the options if you want to be able to use the UPC?
- What are the options if you want to avoid the UPC?
- What languages does the UPC use?
- Member States participating in UPC