

### European Patent Office now Accepting Early Requests for Unitary Patent

As of January 01, 2023 the European Patent Office (EPO) is now accepting early designations of the Unitary Patent for European patent applications in the rule 71(3) EPC late stage of grant. This is a transitional provision pending the Unitary Patent system coming into force later this year on the expected date of June 01, 2023.

There are two provisions which are already in force as of January 01, 2023, those being:

- an early request to designate the Unitary Patent can now be made; and
- a request to delay grant of the European patent until the Unitary Patent system comes into force.

The final pre-grant stage of the European patent involves the EPO issuing a communication under Rule 71(3) EPC which contains the text in which the EPO intends to grant the patent. There is a four-month period from issue of the Rule 71(3) communication in which the applicant must:

- file a translation of the claims only into two other official languages, so that the published granted patent contains claims in the three EPO official languages of English, French and German;
- pay the grant and print fees; and
- approve the text for grant contained in the Rule 71(3) communication

The four-month period for responding to the Rule 71(3) communication is non-extendable.

### Requesting Delayed Grant

As a temporary measure until the Unitary Patent formally commences, it is now possible to request delayed grant of European Patent applications which have received their Rule 71(3) EPC communication in order to push the grant date back until after the Unitary Patent comes into force.

The primary reason for requesting delayed grant of your European patent would be to make sure that the European patent is eligible for continuation as a Unitary Patent.

### Advantages of Requesting Delayed Grant

- Your European patent will be eligible to be continued as a Unitary Patent.
- The Unitary Patent gives a wide geographical coverage for lower cost compared to the "classic" European Patent national phase validations.
- Annual renewal fees will still need to be paid on the Unitary Patent but these are less than the annual renewal fees on the equivalent European national validation patents. For example the official maintenance fee on a year 3 European Patent (DE) covering Germany only is currently €70, whereas the year 3 official maintenance fee on a Unitary Patent is €105, but includes 16 additional states. For the 20<sup>th</sup> year maintenance fee the official fee on a European Patent (DE) covering Germany only is currently €2,030 and the official fee on a Unitary Patent covering 17 states including Germany, France, and Italy is €4,855. Other maintenance fee years have a similar cost ratio

### Disadvantages of Requesting Delayed Grant

- The date of grant of the European patent is delayed - but the delay is only short until June 2023.
- Injunctions to prevent infringers cannot be obtained until the European patent is finally granted.
- Delaying grant also means that national validation patents in countries which are not in the Unitary Patent are also delayed and therefore injunctions cannot be obtained until those patents are granted.

Within a few months, the opportunity to request delayed grant will become unnecessary as the June 2023 date of introduction of the Unitary Patent becomes nearer.

### **Early Request for Unitary Effect of a European Patent**

The EPO is now accepting early requests for unitary effect.

Requesting unitary effect means:

- requesting a single Unitary Patent covering 17 states party to the Unitary Patent; and
- for those 17 states accepting exclusive jurisdiction of the Unified Patent Court (UPC) for matters of infringement and validity.

Unitary effect means that for the 17 states which have ratified the Unitary Patent agreement, there will be one single patent that replaces the equivalent individual national patents at the end of the European Patent procedure. The 17 Unitary Patent states which have ratified the agreement are:

*Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, Sweden. (17 states)*

You will have one Unitary Patent covering all of these states. It is not possible to have a Unitary Patent and a separate European national phase validation patent for the same states at the same time, the Unitary Patent replaces a national phase validation patent for each of the states which are in the Unitary Patent. Opting into the Unitary Patent is irrevocable for the states party to the Unitary Patent.

For other states which are members of the European Patent Convention, but which are not currently in the Unitary Patent system, if you wish to continue your European patent in any of those states, you will still need to validate the European patent in each state individually (the current system being unchanged). The states which are not currently party to the Unitary Patent system are:

*Albania, Croatia, Cyprus, Czech Republic, Greece, Hungary, Iceland, Ireland, Lichtenstein, Lithuania, Monaco, Montenegro, North Macedonia, Norway, Poland, Romania, San Marino, Serbia, Slovakia, Spain, Switzerland and Turkey (22 states)*

For the “extension” states, being states which are not members of the European Patent Convention, but which have agreed that the European patent can be extended to them, these are not included in the Unitary Patent and there is no change to the existing system. There is only one “extension” state - *Bosnia and Herzegovina*

For the “validation” states which are not member states of the European Patent Convention, but which have assimilated their laws similarly to the European Patent Convention the present system is unchanged. If you wish to continue your European patent protection in the “validation” states, you will need to request validation as a separate national patent, there is no change to the existing system. The “validation” states are: *Cambodia; Morocco; Republic of Moldova; Tunisia.*

Unitary Patents will remove the need for complex and costly national validation procedures in the Unitary Patent participating states. Features of the Unitary Patent include:

- The EPO acts as a one-stop-shop, allowing for a simple registration of a Unitary Patent.
- No fees are due for the filing and examination of the request for unitary effect or for registration of a Unitary Patent.
- No post-grant translations of the Unitary Patent for litigation purposes will be required after a six-year transitional period. During this period, a translation will be required for information only and will not have any legal effect.
- For EU-based SMEs, natural persons, non-profit organisations, universities and public research organisations a new compensation scheme will cover costs related to the translation of the patent application if it was filed in an official EU language other than English, French or German. They will be paid a lump sum of EUR 500 when their Unitary Patent is registered.
- Unitary Patents will also not be subject to the currently fragmented multiple national patent renewal fee system: there will be only one renewal procedure, in one currency and one renewal deadline and no obligation to use a professional representative.
- The renewal fees have been set at a competitive level and are particularly attractive for the first ten years, the average lifetime of a European patent. But applicants will also save on indirect costs such as currency exchange costs, and attorney fees for multiple separate renewals. The more countries in which the European patent would have been validated, the greater the savings.
- All post-grant administration will be handled centrally by the EPO, further reducing costs and the administrative workload.
- The online register will include legal status information relating to Unitary Patents – notably on licences and transfers. This will also help to foster technology transfer and investment in innovation.
- Unitary Patents will confer truly uniform protection since the substantive patent law governing the scope and any limitations of the rights and the remedies available in cases of infringement has been harmonised in the Agreement on a Unified Patent Court.

### Summary

If you have a European patent application where the communication under rule 71(3) EPC has issued but where you have not yet approved the text for grant, you can:

- request that the grant of your patent is delayed until the Unitary Patent comes into force on June 01, 2023 so as to have the option of obtaining a Unitary Patent within 1 month of grant of the European Patent; or
- Make an early request now that your European Patent is continued as a Unitary Patent.

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