

The 4 Decisions You Need to Make as Regards the European Unitary Patent System

Executive Summary

The European Unitary Patent System will soon enter into force. A new European Unified Patent Court will be established. We expect this system to enter into force in the second half of 2022.

It will then be possible for patentees of European patents to have one Unitary Patent covering 17 European states. This is different from the current situation, where a European patent disintegrates into national patents after grant (referred to as "classical" European patent).

The Unified Patent Court (also referred to as "UPC") will have sole responsibility as regards the newly granted Unitary Patents.

Furthermore, the Unified Patent Court will also have the competence to handle cases relating to presently existing national parts of European patents. Both the national courts and the Unified Patent Court will be competent to handle cases relating to these patents. The competence for an individual matter is determined by the first court action started for this matter. In case no court action relating to this patent has been initiated at the UPC, the patentee can also "opt out", such that only the national courts will be competent as regards this patent. After an opt-out, the patentee can also opt-in to the Unified Patent Court, provided that no national proceedings were started prior to the opt-in.

Thus, the following decisions need to be made:

- (1)** For patentees of "classical" European patents: Should an "opt out" relating to the Unified Patent Court be declared?
- (2)** For applicants of European applications expecting a grant of a patent: Is it preferable to have a Unitary Patent or "classical" European patent with its national parts?
- (3)** For competitors of patentees of "classical" European patents: Should a court action be started to prevent the patentee from declaring the opt-out or the opt-in?
- (4)** For applicants seeking patent protection in individual states of Europe: Does the possibility of obtaining a European Unitary Patent provide such benefits that it is preferable to patent protection in individual states in Europe?

The present white paper provides further considerations to assist you in making these decisions.

Key Takeaways

- The Unitary Patent System will likely enter into force in the second half of 2022.
- One part of the Unitary Patent System is the Unified Patent Court. This Court will be competent to handle cases relating to Unitary Patents and “classical” European patents with their national parts. The Unified Patent Court will be exclusively competent for Unitary Patents. Both the Unified Patent Court and the national courts will be competent to handle cases relating to “classical” European patents – this applies to states that participate in the Unitary Patent System.
- Until now, 17 member states of the European Union have ratified the relevant agreement. These member states have a total GDP approximately 3 times the GDP of Germany. The member states include, e.g., Germany, France, Italy, and the Netherlands, but not, e.g., the UK and Spain.
- The court fees will (in most cases) be substantially lower than the court fees in German court proceedings. The reimbursable attorney fees will be substantially higher than in German proceedings.
- The Unified Patent Court will be responsible for handling both patent infringement cases and patent invalidity cases. These cases will be heard together, which is different to Germany, where there are different courts responsible for patent infringement and patent invalidity cases.
- There will be two instances at the Unified Patent Court, and it is intended that each instance takes 12 to 14 months, such that a final decision will be rendered within 28 months. In comparison, German proceedings greatly vary as regards their duration and can also take up to 60 months until a final ruling.
- At the Unified Patent Court, invalidity proceedings are admissible while opposition proceedings are still ongoing. This is different to Germany, where nullity proceedings are only admissible after termination of opposition proceedings or after the expiration of the opposition period if no opposition is filed.
- At the UPC, the written submissions by the parties will be accessible to the public through an online file register. This is different to Germany, where only the oral proceedings are public, but not the written submissions of the parties.

- A post-published national prior right (a national “Art. 54(3) EPC document”) will be relevant for the complete Unitary Patent. This is different to the current situation, where such a national prior right is relevant for the corresponding national part of the European patent.
- There is no restitution for the Unitary Patent. That is, the patentee does not owe damages to the infringer in case a Unitary Patent is revoked at a later stage.
- The annuities for the Unitary Patent correspond to the aggregated annuities for the national parts of a European patent in Germany, the UK, France, and the Netherlands.
- The Unitary Patent can only be abandoned as a whole. This is different to “classical” European patents, where the patentee can always decide to abandon the patent for individual states, and therefore “tune” the scope of spatial protection and the annuity fees to be paid.

Munich, February 2022

1. How to use this white paper

Below, we will explain the present situation with regard to European patents, and the concept of the newly established Unitary Patent System (section 2). We will then answer related general questions as regards the new Unitary Patent System (sections 2 to 5). Sections 6 and 7 relate to considerations which are relevant for “classical” European patents (section 6) and for Unitary Patents (section 7, but we note that section 6 is also relevant in this regard). Based thereon, we provide recommendations as regards the relevant questions in section 8.

We generally recommend reading the complete white paper. However, depending on your familiarity with the topic, it is also possible to primarily study the above *Executive Summary*, the *Key Takeaways*, and section 8 relating to our *Recommendations*, and to only read the other more detailed sections if needed.

2. Present situation

Since its formation in 1977, the European Patent Office has granted “European patents”. Until now, the following mechanism has applied after grant:

When a European patent is granted, the applicant decides in which European countries the patent shall be validated, and the European patent essentially becomes a national patent in these countries.

Example: When an applicant decides to validate a European patent in Germany, France, and the Netherlands, they will then have a German, France, and Dutch patent, which are mostly independent from one another.

This is particularly relevant when the patent is infringed and the patentee decides to initiate legal action against the infringer, as a national court can only grant a court order for one country.

Example (continuing the above): The patent is infringed in Germany and France. The patentee decides to initiate court proceedings in Germany. The German court orders the infringer to cease and desist, and to pay damages. The court

orders are only relevant for Germany. Importantly, this has no effect on the infringer's activities in France (provided that they have no relation to Germany).

Additional laws will soon come into effect. These laws provide the patentee with the possibility to obtain a European Unitary Patent with unitary effect, i.e., one patent that is effective in different European states, and establishing a Unified Patent Court. This Unified Patent Court can render decisions being effective in all the participating states.

Example (under the new provision): A Unitary Patent is infringed in Germany and France. The patentee initiates court proceedings before the Unified Patent Court, and the Unified Patent Court orders the infringer to cease and desist, and to pay damages. The court order is then relevant for all countries participating in the Unitary Patent System.

3. Participating states

The following countries have already ratified the agreements for the Unitary Patent and Unified Patent Court: Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, and Sweden. These countries will thus participate in the Unitary Patent System.

The following countries participated in the process, but have not yet ratified the agreements: Cyprus, Czech Republic, Greece, Hungary, Ireland, Poland, Romania, and Slovakia. It therefore remains to be seen whether these countries will participate, and it is generally noted that any country in the European Union could join the Unitary Patent System.

4. When will the Unitary Patent System come into force?

We expect the Unitary Patent System to come into force in the second half of 2022.

Deep Dive: This all depends on when Germany deposits its ratification with the European Union. The Unitary Patent System will enter into force three to four months after the German deposit (e.g., on 01 October 2022 if Germany deposits its ratification in June 2022). N.B. According to our understanding, Germany is in discussions with the people setting up the court and awaits their statement

that the preparations are so far advanced that the court can be set up within three to four months, before depositing its ratification.

5. For which patents will the Unified Patent Court be responsible?

5.1 Future Unitary Patents

When a new European patent is granted, the applicant will be able to decide whether the European patent should be granted as a Unitary Patent, or as a plurality of individual national patents. If the applicant chooses a Unitary Patent, the Unified Patent Court will have sole responsibility for the Unitary Patent. If the applicant chooses the plurality of individual national patents, the patents will be national patents in each of the countries validated by the patentee (i.e., “classical” European patents) and both the Unified Patent Court and the national courts will be able to handle cases relating to such patents. The possibility to choose between these two options (i.e., Unitary Patent vs. “classical” European patent with national parts) will be present for all patents granted by the European Patent Office after the Unitary Patent System comes into force, and also for patents granted shortly prior to that.

5.2 Classical European patents

As stated, the Unified Patent Court will also have the competence to handle “classical” European patents, i.e., patents granted by the European Patent Office, which have then become national patents by means of their validation. Notably, this competence also applies to patents which were already granted prior to the Unitary Patent System, e.g., a patent granted in 2020.

More particularly, both the national courts and the Unified Patent Court will be competent to handle currently existing European patents.

More particularly, there are the following options:

- (1) The Unitary Patent System enters into force, and the patentee of a “classical” European patent takes no further action.

In this case, both the national courts of the countries where the patent has been validated and the Unitary Patent are competent to handle cases relating to this

patent, e.g., infringement cases, cases relating to declarations of non-infringement, and nullity cases.

In a particular matter (defined by the parties and an act of an alleged patent infringement), the first court where this case is filed is authorized. In case the particular matter is also filed at another court, this court is not authorized to hear this case.

Example: A patentee has a “classical” European patent validated in Germany, France, and the Netherlands. The Unitary Patent System enters into force, and the patentee does not take any further action.

A competitor files an action seeking declaration of non-infringement of the Dutch part for their product X with a Dutch court. The action is directed against the patentee.

With regard to this matter (competitor vs. patentee, Dutch patent, product X), the Unified Patent Court is no longer authorized to handle the case. A respective infringement suit by the patentee at the Unified Patent Court would thus be inadmissible in that regard.

However, this only concerns the Dutch part of the patent. That is, the patentee could still initiate infringement proceedings against the competitor as regards product X based on the German and French parts of the European patent with the Unified Patent Court.

- (2) The patentee also has the option to “opt out” of the Unitary Patent System for a “classical” European patent. In this case, only the national courts of the countries where the patent is validated will be competent to handle cases relating to this patent. However, this “opt out” is only possible when there has been no court action relating to this patent at the Unified Patent Court.

Example: The Unified Patent Court starts operation on 01 October 2022. The patentee of a “classical” European patent validated in Germany, France, and the Netherlands does not declare an “opt out”. On 05 October 2022, a competitor files an invalidation action against this patent with the UPC. The patentee can then no longer declare the “opt out”.

Notably, there will also be a period before the Unified Patent Court starts accepting cases, where it will be possible to declare the “opt out”.

- (3) In case the patentee has declared their “opt out” of the Unitary Patent System, they can later also again declare their “opt in” to the Unitary Patent System. However, this is only possible if no case relating to this patent has been handled by any of the national courts. That is, by opting out, the patentee risks not being able to later opt in again, e.g., in case a competitor files a case relating to declaration of non-infringement or invalidity with a national court.

After a successful “opt in”, again, both the national courts and the Unified Patent Courts will be competent to handle cases relating to this patent (as in option (1)).

Further, after the patentee has “opted out” and then back “in”, there is no further possibility to again “opt out” of the Unitary Patent System.

6. Considerations for “classical” European patents (i.e., the national parts thereof)

This section relates to “classical” European patents, i.e., the national parts of the “disintegrated” European patents. This relates to questions (1) and (3) of the executive summary, i.e., whether an “opt-out” should be declared for your own patents and how to proceed with respect to European patents of competitors.

6.1 Legal considerations

The legal considerations mainly relate to the question of whether the expected chances of succeeding are higher at the Unified Patent Court or at the national courts.

Notably, there is presently no case law available for the Unified Patent Court and it is therefore uncertain how the Unified Patent Court will decide on different legal questions.

In contrast thereto, ample case law is available for the national courts.

Based thereon, one may consider which implications the particulars of the national case law would have on the individual case, and then decide whether these particulars are beneficial or detrimental to the individual patent. The decision as regards which court system to use is then based on this decision.

Example A1: A patentee has a granted “classical” European patent, which is validated in Germany, France and the Netherlands. This patent was granted three years ago and no opposition was raised. During the examination proceedings, substantial changes were performed to claim 1, and a competitor could argue that some of the changes are not directly and unambiguously derivable.

In this case, we would recommend to the patentee to “opt out” of the Unified Patent Court.

While essentially the same legal provisions apply, the German courts are generally relatively liberal as regards amendments. That is, one would generally have good chances to argue that there is support for a certain amendment. Further, even if there is no support for an amendment performed during examination, this only leads to the invalidity of the patent if this amendment leads to an “*aliud*”, i.e., to an invention (substantially) different to the originally described invention. Thus, in such a scenario, the German case law is to the patentee’s favor.

On the other hand, there is no case law indicating how the Unified Patent Court would handle such a scenario, and it is possible that the Unified Patent Court would follow a stricter approach, e.g., an approach identical or similar to the European Patent Office.

In such a case, we would thus recommend to the patentee to “opt out”, in order to ensure that only the national courts are competent to handle this case.

Example A2: Conversely, in the above scenario, we would recommend to a competitor of the patentee to file an invalidity action at the Unified Patent Court, to prevent the patentee from declaring an “opt out”. N.B. This would of course only be possible if the patentee did not declare an “opt out” prior to filing the invalidation action.

6.2 Costs

A second relevant factor will be the costs. In short, when comparing the fees with German proceedings, the court fees will be lower than the court fees for national

proceedings, and the reimbursable attorney fees will be higher. In the following, we compare the costs for proceedings at the Unified Patent Court with costs for proceedings in Germany.

Court Fees for Infringement Proceedings (all in approx. €)			
	Matter value	UPC	DE
First instance	500,000	11,000	12,000
	1,000,000	15,000	18,000
	2,000,000	24,000	30,000
	5,000,000	43,000	65,000
	10,000,000	76,000	125,000
Second Instance	500,000	11,000	16,000
	1,000,000	15,000	24,000
	2,000,000	24,000	40,000
	5,000,000	43,000	87,000
	10,000,000	76,000	167,000
Third instance	500,000	No third instance proceedings	20,000
	1,000,000		30,000
	2,000,000		50,000
	5,000,000		108,000
	10,000,000		208,000

Table 6.1

Court Fees for Invalidation Proceedings (all in approx. €)			
	Matter value	UPC	DE
First instance	500,000	Flat fee: 20,000, but not more than fee for infringement proceedings	18,000
	1,000,000		25,000
	2,000,000		44,000
	5,000,000		98,000
	10,000,000		187,000
Second Instance	500,000	Flat fee: 20,000, but not more than fee for infringement proceedings	24,000
	1,000,000		33,000
	2,000,000		59,000
	5,000,000		131,000
	10,000,000		249,000

Table 6.2

Reimbursable Attorney Fees for Infringement Proceedings (all in approx. €)			
	Matter value	UPC	DE
First instance	500,000	up to 56,000	18,000
	1,000,000	up to 112,000	26,000
	2,000,000	up to 200,000	43,000
	5,000,000	up to 600,000	92,000
	10,000,000	up to 800,000	174,000
Second Instance	500,000	up to 56,000	20,000
	1,000,000	up to 112,000	29,000
	2,000,000	up to 200,000	48,000
	5,000,000	up to 600,000	103,000
	10,000,000	up to 800,000	194,000
Third instance	500,000	No third instance proceedings	41,000
	1,000,000		59,000
	2,000,000		98,000
	5,000,000		210,000
	10,000,000		397,000

Table 6.3

Reimbursable Attorney Fees for Invalidation Proceedings (all in approx. €)			
	Matter value	UPC	DE
First instance	500,000	up to 56,000	18,000
	1,000,000	up to 112,000	26,000
	2,000,000	up to 200,000	43,000
	5,000,000	up to 600,000	92,000
	10,000,000	up to 800,000	174,000
Second Instance	500,000	up to 56,000	33,000
	1,000,000	up to 112,000	48,000
	2,000,000	up to 200,000	80,000
	5,000,000	up to 600,000	171,000
	10,000,000	up to 800,000	324,000

Table 6.4

Another aspect relating to costs, which is presently uncertain, is how exactly the proceedings will be conducted, e.g., how much weight will be given to written evidence and how important expert statements will be. This will have a major impact on the amount of work that will need to be done for preparing and conducting the proceedings and thus on the attorney fees. As there will also be technically qualified judges, we expect (and hope) that the proceedings will be conducted similarly to present proceeding at the European Patent Office, or at German courts, where in most cases, there is a single hearing on a single day.

6.3 No bifurcation

At the Unified Patent Court, one court will handle both the infringement case and the invalidity case. This is a difference to Germany, where these cases are heard by different courts.

6.4 Duration of proceedings

Notably, the Unified Patent Court intends that each instance only takes 12 to 14 months, such that a final decision is rendered within a maximum of 28 months.

This is different to Germany, where the duration of infringement and nullity proceedings vary greatly, and can overall take up to 5 years.

6.5 Invalidity proceedings admissible during opposition proceedings

Furthermore, invalidity proceedings are also admissible while post-grant opposition proceedings are ongoing. This is different to German invalidity proceedings, which are only admissible after termination of the opposition proceedings, or after termination of the opposition time limit, if no opposition is filed.

6.6 Single decision

A further aspect that may be of interest is that the Unified Patent Court will render one ruling, whereas one would have multiple (potentially diverging) rulings by different national courts in the alternative.

6.7 Online file register

There will be an online file register for proceedings at the Unified Patent Court. This is particularly different to the handling of infringement proceedings in Germany. While oral proceedings in a German infringement case are public, it is not readily possible for a third party to access the written submissions by the parties.

7. **Considerations for Unitary Patents**

This section relates to Unitary European patents, and more particularly to the question of whether one should request that the granted European patent be converted to a Unitary Patent or not.

Firstly, for such patents, all of the considerations mentioned in section 6 also apply. Additionally, the following considerations apply.

7.1 National prior rights

An additional legal consideration for a Unitary Patent relates to national prior rights, i.e., patents or patent applications relating to the same invention as the patent in question, which have an effective filing date (i.e., filing date or priority date) prior to the effective filing date of the patent in question, but a publication date after the effective filing date of the patent in question (i.e., the national equivalents of documents according to Art. 54(3) EPC).

Such a national post-published prior right will be relevant for the whole Unitary Patent. This is different to the situation for a "classical" European patent, which disintegrates into national parts after its grant.

Example: There is a German prior right relevant for a European patent. If the European patent is a "classical" European patent, i.e., it consists of different national patents, the German prior right is only relevant for the German part of the European patent. That is, only the German part could be invalidated by the German prior right. However, this is different for a Unitary Patent. Here, the complete Unitary Patent could be invalidated by means of the German prior right.

7.2 No restitution

Importantly, there is no restitution for a Unitary Patent, and this concept is best explained by an example.

Example A (with restitution): Consider a presently granted German part of a “classical” European patent. The patentee files a court action against an infringer, and this court action is finally decided in the patentee’s favor in 2023. The infringer is ordered to pay damages in the amount of € 500,000 and to cease and desist from using the invention of the patent.

Later, another party files an invalidity suit against this patent. In these invalidity proceedings, the patent is finally revoked in 2026.

The prior infringer then files a restitution action to reinstitute the legal situation in view of the now revoked patent. The patentee has to repay the damage payment they received, and any other damage incurred by the infringer, due to the infringer ceasing and desisting from using the patent after the first decision.

Example B (without restitution): This relates to the above example A, but with a Unitary Patent.

In this case, there is no restitution. Thus, after the revocation of the patent in 2026, the first decision of 2023 is no longer valid for the future. That is, the prior infringer may again make use of the invention of the patent after the revocation of the patent. However, the prior infringer does not receive a reimbursement for the damages they paid, or for the damages experienced in the interim.

Overall, the financial risk for the patentee due to a later revocation of a patent is substantially reduced.

7.3 Costs for the Unitary Patent

In addition to the above considerations relating to the court and attorney fees for the proceedings, the annuity fees are relevant for the Unitary Patent.

The annuity fees for the Unitary Patent generally correspond to the sum of the annuity fees for a European patent that has been validated in Germany, the UK, France, and the Netherlands.

The below is a comparison of the annuity fees to be paid for a Unitary Patent vs. the fees to be paid for the German part of a European patent. When reading the table, one should bear in mind that the Unitary Patent provides protection in 17 countries having a combined GDP approximately 3 times the GDP of Germany.

Comparison of Annuities (rounded to 100 €)				
	Annual costs		Cumulative costs	
Year	Germany	Unitary Patent	Germany	Unitary Patent
1	0	0	0	0
2	0	0	0	0
3	100	100	100	100
4	100	100	200	200
5	100	300	300	500
6	100	500	400	1,000
7	200	600	600	1,600
8	200	800	800	2,400
9	300	1,000	1,100	3,400
10	400	1,200	1,500	4,600
11	500	1,500	2,000	6,100
12	600	1,800	2,600	7,900
13	800	2,100	3,400	10,000
14	900	2,500	4,300	12,500
15	1,100	2,800	5,400	15,300
16	1,200	3,200	6,600	18,500
17	1,400	3,600	8,000	22,100
18	1,600	4,100	9,600	26,200
19	1,800	4,500	11,400	30,700
20	1,900	4,900	13,300	35,600

Table 7.1

A further aspect to be taken into consideration are the service fees associated with payment of the annuities. For the Unitary Patent, a single annuity fee has to be paid every year, whereas multiple annuity fees (i.e., one per country where the patent is in

force) have to be paid for a “classical” European patent, and the service providers will likely have a higher fee for the payment of a multitude of individual fees than for the payment of a single fee for the Unitary Patent.

Further, a Unitary Patent can only be upheld as a whole, thereby not allowing the flexibility of a “classical” European patent with its national parts. That is, the patentee either has to pay the fees indicated in Table 7.1 for the Unitary Patent or abandon the patent completely. This is different for a “classical” European patent, as indicated by the below example.

Example: A patentee has a “classical” European patent validated in Germany, France, the Netherlands, Italy, and Sweden. At some point, the patentee decides that the business value of this patent does no longer justify the payment of the annuities for these states. The patentee can then decide, e.g., to discontinue paying the fees in the Netherlands, Italy, and Sweden (effectively abandoning the patent in these states), but continue to pay the fees for Germany and France. Thus, the patent will only be active in these states, and the number of annuities to be paid is reduced. This flexibility is not possible with the Unitary Patent.

8. Recommendations as regards decisions

8.1 Preliminary remarks

In view of the above, one will appreciate that many different aspects have to be taken into consideration for the decisions relating to the Unitary Patent System. The below points can therefore only serve as a general guideline. Each user of the patent system should still carefully consider which approach is best in their individual situation.

8.2 Decision (1): For patentees of presently existing European patents: Should an “opt out” relating to the Unified Patent Court be declared?

In view of section 5.2 above, the relevant considerations for this question are the following:

“Opting out” is associated with the risk of the patentee not being able to use the Unified Patent Court with regard to the patent. This would happen if national proceedings relating to a national part of this patent are initiated (e.g., national invalidity proceedings, or national proceedings relating to declaration of non-infringement).

Not “opting out” is associated with the risk that a competitor could also initiate proceedings against the European patent at the Unified Patent Court (e.g., invalidity proceedings).

In view thereof, we believe that the most relevant questions for this decision are particularly the following.

(A) Are there particular considerations with regard to national case law that are relevant for the patent?	Depends on details of legal considerations
(B) How interesting is the option of enforcing the patent in different states?	High interest disfavors “opt-out”

8.3 Decision (2): For applicants of European applications expecting a grant of a patent: Is it preferable to have a Unitary Patent or a number of national parts of a European patent?

As regards this decision, it is important to note that only a small percentage of all patents (i.e., less than 5%) undergoes litigation or invalidity proceedings. In view thereof, a relatively large weight should be given to the running costs, i.e., the annuity fees to be paid for the patent.

Overall, we think that the four questions below are the most relevant when deciding between a Unitary Patent and a “classical” European patent:

(A) In how many states should the patent be valid?	High number favors UP
(B) How interesting is the possibility of later abandoning individual states to reduce annuities?	High interest favors “classical” EP patent
(C) How interesting is the fact that there is no restitution for Unitary Patents?	High interest favors UP
(D) Are there particular legal considerations (e.g., a national prior right, known case law in a state) that are relevant?	Depends on legal consideration

Examples: (i) A patent without any particular legal consideration and without any particular interest in the absence of restitution, where the patentee has an interest that the patent is valid in Germany and France. In this case, we would

normally recommend a “classical” European patent validated in Germany and France.

(ii) A patent without any particular legal consideration and without any particular interest in the absence of restitution, where the patentee has an interest that the patent is valid in 8 states of the Unitary Patent System, and where it is likely that the business value of the patent is such that the patentee will always have an interest of maintaining the patent in 8 states. In this case, we would normally recommend a Unitary Patent.

(iii) A patent protecting a manufacturing method without there being any particular legal consideration. For such a manufacturing method, it would most likely be advisable to have protection in many different countries, so that the patent cannot be easily circumvented by shifting the production to another country. In such a case, we would typically recommend a Unitary Patent.

(iv) A patent for which a highly relevant national post-published prior right exists in Italy. In this case, we would normally recommend a “classical” European patent, as a Unitary Patent could be completely invalidated by the Italian national prior right.

(v) A patent having undergone amendments during the examination, where there is a substantial risk that the amendments will not be considered to be “directly and unambiguously derivable” in later proceedings. In this case, e.g., the German case law is relatively favorable, and it is not yet clear how such a case would be decided by the UPC. We would therefore lean to a “classical” European patent.

8.4 For competitors of patentees of presently existing European patents: Should a court action be started to prevent the patentee from declaring the opt-out or the opt-in?

This decision will be associated with an immediate cost risk of several € 10,000s. In view thereof, we recommend to consider this question on a case-by-case basis.

8.5 Decision (4): For applicants seeking patent protection in individual states of Europe: Does the possibility of obtaining a European Unitary Patent provide such benefits that it is preferable to patent protection in individual states in Europe?

There are also companies presently not filing European patent applications, but individual national patent applications in Europe, e.g., a patent application in Germany and a patent application in the UK.

As the new Unitary Patent offers another possibility when filing a European patent application, one may consider whether this added possibility is so interesting that the European patent application is more favorable than the individual filings.

However, we believe that the overall assessment will still favor the individual national filings in most cases.

Firstly, according to our experience, companies choosing national routes usually only seek patent protection in a small number of European states (usually only 2 or 3). This generally renders the option of the Unitary Patent less attractive than would be the case if seeking patent protection in a plurality of states.

Secondly, according to our experience, companies choosing the national routes mostly seek patent protection only in Germany and the UK. Thus, only one country (i.e., Germany) where protection is presently sought is covered by the Unitary Patent System, further disfavoring this system.

We therefore believe that the assessment still favors the national only route for most companies presently following this route.

We hope that we could hereby provide a guideline as to how to proceed as regards the European Unitary Patent System.

Please feel free to contact us in case of any question or comment as regards this white paper, either by email to mail@stellbrink-partner.com or via telephone by calling +49-89-41112880.