

19 JANUARY 2022

PROTOCOL ON PROVISIONAL APPLICATION OF THE UPC AGREEMENT ENTERS INTO FORCE

The transition to the operational phase commences, in particular:

- the Unified Patent Court (UPC) acquires legal personality
- UPC's central, regional and local divisions are established
- Registry is set up at the seat of the Court of Appeal (Luxembourg)
- the Administrative Committee, Budget Committee and Advisory Committee are set up
- UPC judges are appointed
- a patent mediation and arbitration center is established in Lubljana (Slovenia) and Lisbon (Portugal)
- financial, organization and procedural provisions are implemented

AT LEAST 8 MONTHS

PREPARATION FOR OPTING OUT EXISTING EUROPEAN PATENTS/SPCs

The UPC will have exclusive jurisdiction over existing European patents and SPCs, making a central revocation attack possible. Owners of a European patent as well as holders of an SPC may opt-out from the exclusive competence of the UPC for at least 7 years and thus we recommend that you:

- determine your opt-out strategy
- carry out due diligence review of your patent/SPC portfolio to identify the patents/SPCs that will be opted-out
- correct issues related to chain of title
- identify co-owners of such patents/SPCs and obtain their consent to opt-out
- review your license agreements related to such patents/SPCs to ensure that there are no contractual obstacles to opting-out
- review litigation strategy with your current licensees given its impact on the right to opt-out/opt-in

DEFINE STRATEGY FOR PENDING APPLICATIONS

- identify the patent applications that will be opted-out
- draft joint ownership / license agreements to ensure that (1) an appropriate process is in place for managing opt-out/opt-in and unitary effect decisions and (2) litigation provisions are coherent with opt-out/opt-in strategy

SUNRISE PERIOD

The sunrise period provides the option for opting out European patents, European patent applications and SPCs and should begin three months before the UPC becomes operational and, thus, before any action is brought before the UPC. (Source: EPO website, FAQ on the UPC)

In addition, as of the date of deposit of Germany's instrument of ratification of the UPCA (which essentially overlaps with the sunrise period), applicants of European patents at the final phase of the grant procedure may take steps in order to request unitary patent protection.

APPROX. 3 MONTHS

OPTING -OUT

You may opt-out from jurisdiction of the UPC by notifying your opt-out with the Registry of the UPC.

REQUEST FOR UNITARY EFFECT

As of the date of deposit of Germany's instrument of ratification of the UPCA, if you are an applicant for a European patent at the final phase of the grant procedure, you may obtain a Unitary Patent, by filing:

- an early request of unitary effect or
- a request for a delay in issuing the grant decision until after the UPC start date

UP AND UPC SYSTEM IS OPERATIONAL