

UPC OPT-OUTS

FROM IDEA TO IP

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Company News and
Highlights
UPC OPT-OUTS

Practical guidance for filing UPC opt-out requests and our conditions

With the below outline we want to provide some clarity on what the requirements are for requesting an opt-out from the competence of the UPC for your classical European patents and patent applications. We can help you with strategical considerations upon emailing to info@dcp-ip.com or you can check our [website](#) under the UP&UPC tab (or you can take a look at the brochure which is available here <https://www.dcp-ip.com/up-upc>)

Is this applicable for patents only or also for patent applications?

For both; you can file an opt-out request for either a granted EP patent or a pending EP patent application, such that only the national courts but not the UPC will be competent for the granted and opted-out patent. One precondition is that no action has been commenced before the UPC prior to the opt-out becoming effective.

Applicants who will soon have granted EP classic European Patents may wish to opt-out their European patent applications, ideally before the UPC becomes operational on June 1, 2023. To this end, a 3-month sunrise period started on March 1, 2023 during which such opt-outs can be filed. Importantly, because an opt-out only becomes effective upon its entry in the UPC register, any opt-out of already granted EP patents should preferably be notified to the UPC Registry well in advance of June 1, 2023.

Which information do we need from you?

In order to be valid, an opt-out has to be lodged in the name of all actual patent proprietors/applicants, whereby the “true” patent proprietor /applicant must be indicated – i.e., the party that currently owns the patent rights, regardless of whether they actually are recorded in the European patent register or not. It is therefore important to carefully check the ownership of any patent or application to be opted out in order to reduce the risk that the validity of an opt-out could later be challenged before the UPC.

For each case the EP publication number, information identifying the “true” proprietor/applicant - so the precise name, the postal address, and where applicable electronic address - will be needed since this information has to be included in the opt-out request.

What are the costs related to the opt-out?

In terms of costs, there is no official fee for an opt-out. The filing of opt-out requests requires active steps to be taken, typically via a European Patent Attorney, which entails costs. These costs are encompassed by our formality fee for an opt-out for each single EP patent/patent application (150 EUR, excl. VAT). This fee will apply to situations where the information received appears complete.



In order to act, we will assume without further inquiry that this information is factually correct, and that the client (applicant(s)/proprietor(s)) providing the instructions to us has(ve) obtained the agreement of all actual co-applicants or co-proprietors of the patent for all EPC states to request the opt-out.

Any other actions, such as additional communications and reminders to obtain missing information, will be charged either on hourly basis or according to our standard schedule of charges, depending on the nature of the activity.

A thorough manual review can be performed (upon request) by our Patent Attorneys and Paralegals if we receive specific instructions to do so, for example when we would be requested to obtain missing information, or (only upon your request) contacting co-applicants, licensors, etc. to seek their instructions, inspecting co-ownership or licensing contracts. **The costs for such a manual review (if desired) will be charged either on hourly rate basis and will depend on the actual time involved.**

How do we assure the opt-out is valid?

An opt-outed patent which is recorded by the Registry of the UPC, can later still be challenged by third parties in terms of validity, e.g. in the context of a centralized revocation procedure before the UPC. Any errors in the opt-out request (such as wrong proprietor/applicant, omission of a designated state, or the omission of any existing SPC rights) can potentially render the opt-out invalid for the entire EP patent (and any SPCs based on the patent). It is therefore of utmost importance that the data to be used for the opt-out request are correct and complete.

Therefore, please make sure that the data you provide us with are the correct data for the EP patents/applications to be opted out. **In order to act, we will assume without further inquiry that the information you provide us is factually correct and we assume no liability for the correctness and completeness of such data for the validity of the corresponding opt-out, and that the client (proprietors or applicant(s)) providing the instructions to us has(ve) obtained the agreement of all actual co-proprietors or co-applicants to request the opt-out.**

Take note of some important considerations

Should you choose for a Unitary Patent, you have no choice, you cannot opt-out.

In case of a group of proprietors/applicants, the **consent** will be required of all actual co-proprietors/applicants (**preferably a written agreement**) to opt-out said patent/application.

For patents/applications that are subject to **license agreements**, it is advisable to **verify** who is allowed to decide about the filing of an opt-out request. It should be noted that an (exclusive) licensee is not entitled to request an opt out! The licensee will need to **contact the owner(s) of the patent/application** and request them to provide their **opt-out instructions**.

An opt-out can only be requested for a European patent as a whole, including all designated states and all **supplementary protection certificates (SPCs)** based on the patent. We need to indicate all states for which the patent was originally granted, regardless of whether they participate in the UPC, and including also any states in which the patent has not been validated or has been allowed to lapse. For further information regarding cases with one or more SPCs, please contact us and we will be pleased to assist you.

In case you wish to opt-out of the competence of the UPC, we strongly recommend this is done before grant, to avoid that a third party starts an action before the UPC against the granted patent immediately after grant.

Attractively, an opt-out may be later withdrawn, allowing the future patent proprietor to initiate an infringement action before the UPC for those of the 17 Contracting Member States in which the patent has an effect. In case an opt-out is later withdrawn, the corresponding classic EP patent (including any related SPCs) is again subject to the competence of the UPC. Such a withdrawal is possible only if no action relating to the patent has been commenced before a national court yet. Moreover, the withdrawal of an opt-out is final, i.e., it will not be possible to file a second opt-out for the same patent.

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