

# The Unitary Patent & Unified Patent Court

# What is the Unitary Patent?

Under the European Patent Convention (EPC), European Patents (EP) are filed, examined and granted by the European Patent Office (EPO) in a centralized procedure for 39 EPC contracting states. These include all 27 European Union (EU) states and an additional 12 non-EU states [1].

At this moment, upon the grant of a European patent, the patent holder needs to choose in which of the EPC contracting states the European patent is to be maintained. For each of the states where validation is desired, national official fees, agent fees and often translation fees need to be paid. In addition, yearly renewal fees also need to be paid for each of the chosen states. This is known as a classical validation or system.

As from June 1, 2023, it became possible to request unitary effect for European Patents granted on or after that date. The 'Unitary Patent' covers the following 18 EU states:

**Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Romania [2], Slovenia and Sweden.**

All 18 states are covered by the UP as a block; it is not possible to make a smaller selection. The number of participating EU states is expected to grow in the coming years, although Spain, Croatia and Poland are already known to remain outside of the system for the foreseeable future. Still, the 18 states already represent almost 70% of the EU's population and 80% of the EU's gross domestic product (GDP).

Registration of the unitary effect is initiated by a single request to the EPO, requiring only one translation of the granted EP patent (during a transitional period of 6 years or, if extended, 12 years) and annual payment of a single renewal fee. All post-grant administration, including the registration of the unitary effect and the payment of the renewal fee, is handled centrally by the EPO.

[1] For an up to date list of EPC contracting states, see <https://www.epo.org/about-us/foundation/member-states.html>.

[2] Romania has joined the Unitary Patent system with effect from September 1, 2024

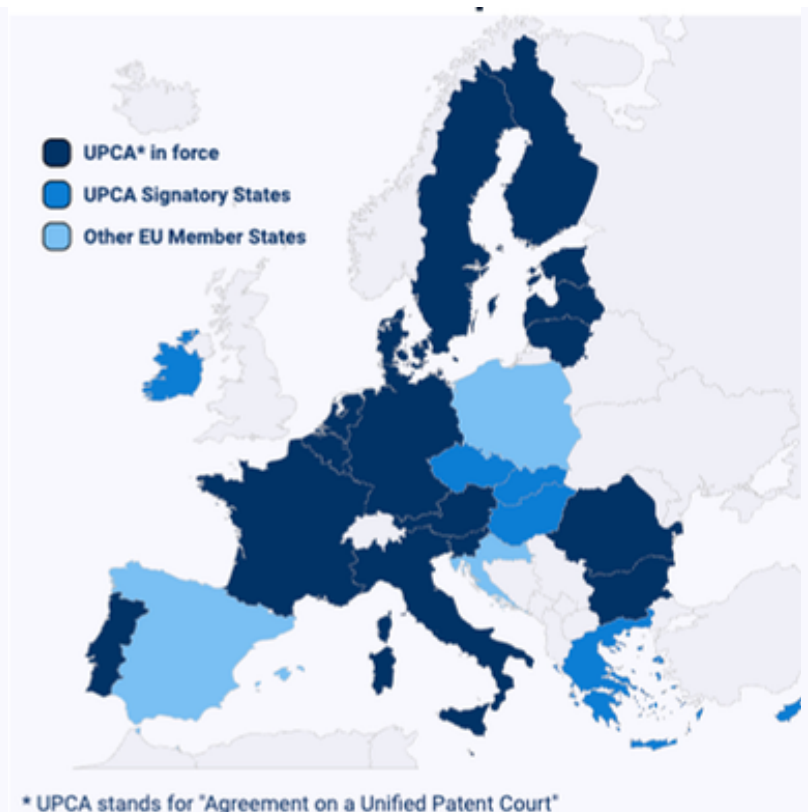
Importantly, the choice for a Unitary Patent is optional, and patent holders may instead use the existing classical system of validations in the individual EPC states. The classical validation remains necessarily in place for EU states not (yet) participating in the Unitary Patent system and for all non-EU EPC states.

it is not possible to retroactively convert granted European patents classically validated in participating EU states into a Unitary Patent or vice versa. The decision for a Unitary Patent or classic EP needs to be taken with care.

All in all, the Unitary Patent makes it possible for patent holders to obtain uniform patent protection in the 18 participating EU states at a much lower cost. There is a cost saving compared with individual validations in 5 or more of these states. Keep in mind, however, that the unitary nature of the Unitary Patent also means that it can only be maintained or allowed to lapse as a whole for all 18 states.

If an Applicant does not desire unitary protection, but only wishes a classically validated EP patent, then the application can be prosecuted to grant and afterwards validated in the desired individual EPC states.

|            |               |                  |
|------------|---------------|------------------|
| ● Austria  | ● Latvia      | ● Cyprus         |
| ● Belgium  | ● Lithuania   | ● Czech Republic |
| ● Bulgaria | ● Luxembourg  | ● Greece         |
| ● Denmark  | ● Malta       | ● Hungary        |
| ● Estonia  | ● Netherlands | ● Ireland        |
| ● Finland  | ● Portugal    | ● Slovakia       |
| ● France   | ● Romania     | ● Croatia        |
| ● Germany  | ● Slovenia    | ● Poland         |
| ● Italy    | ● Sweden      | ● Spain          |



# Unified Patent Court litigation: Our collaborative approaches

The Unified Patent Court has fundamentally changed how patent disputes are handled in Europe, requiring early strategic choices and close alignment between legal and technical expertise.

To meet these demands, De Clercq & Partners cooperates with ALTIUS in a **non-exclusive collaboration** for UPC litigation through the Altius De Clercq initiative. Building on an established working relationship across a wide range of matters, this collaboration brings together patent attorneys and lawyers to address the specific procedural and strategic demands of UPC proceedings.

Clients work with one aligned team from day one, combining legal and technical expertise in infringement and revocation actions before the UPC, operating in line with the court's procedural structure at both first instance and on appeal, and ensuring efficient, consistent and client-driven UPC litigation support.

For clients of De Clercq & Partners who have their own preferred IP lawyers or IP law firms working with De Clercq & Partners, the trusted advisers at De Clercq & Partners are, of course, happy to serve you as well still on your UPC cases as patent attorneys and UPC representatives.

Learn more about the Altius De Clercq initiative at: <https://upc-patents.com/>



# The Unified Patent Court (UPC)

National courts were responsible for infringement and/or revocation actions relating to European patents validated in their respective territories, often leading to parallel court procedures in case infringement takes place on a pan-European level.

The Unified Patent Court (UPC) is a new court common to the participating EU states aiming to provide a simpler and more efficient judicial system, with one court having jurisdiction across all EU states that have ratified the UPC agreement for all European patents and Supplementary Protection Certificates (SPC) obtained based on European patents.

The UPC therefore issues judgments on the infringement and/or validity of European patents having effect throughout the EU states participating in the UPC agreement.

As of June 1, 2023, it became a court common to initially 17 EU states.

As from September 1, 2024, Romania has joined the Unitary Patent system. In the 18 states mentioned above ('UPC Contracting Member States') the court has exclusive competence for actions on the infringement and revocation of both Unitary Patents and classically validated European Patents, as well as SPCs obtained based on such patents.

Importantly, the decisions of the UPC taken for classic EP patents cover the territory of those 18 UPC Contracting Member States in which the European Patent has been validated.

Consequently, a revocation action or a counterclaim for revocation concerning a Unitary Patent and a classic European Patent may lead to the loss of the patent in all of the above 18 UPC Contracting Member States by a single decision of the UPC.

This sharply contrasts with the current situation, where national courts can only revoke their respective national designations of a classic European Patent.

Similarly, an infringement action can be invoked in all 18 UPC Contracting Member States with a single procedure.

# Transitional period and UPC opt-outs

During a transitional period of 7 years (which may be prolonged by up to a further 7 years), actions for infringement and/or revocation of classic European Patents may be brought before national courts or before the UPC.

A proprietor of or an applicant for a European patent however has the option to opt-out of the UPC's exclusive competence before the end of the transitional period, such that only the national courts will be competent for the opted-out patents throughout their lifetime.

One precondition is that no action has been commenced before the UPC prior to the opt-out becoming effective. After the expiry of the transitional period, the UPC will have exclusive competence over both EP patents with unitary effect and non-opted-out classical EP patents in the 18 UPC Contracting Member States.

Proprietors of previously granted EP patents or applicants who will in the future obtain granted classic European Patents may wish to opt-out their European patents or applications during the transitional period to avoid litigation at the UPC. For patent applications this should ideally be done before grant.

Attractively, an opt-out may later be withdrawn, allowing the patent proprietor to initiate an infringement action before the UPC for those Contracting Member States in which the patent has effect.

The withdrawal of an opt-out is final. It is not possible to file a second opt-out for the same patent.

Please do not forget that in case you choose for a Unitary Patent, it is not possible to opt-out of the competence of the UPC.

# How to Opt Out

**Notifying an opt-out to the UPC registry is as such a relatively straightforward formal act.**

In order to be valid, however, an opt-out has to be lodged in the name of all actual patent applicants/proprietors in all EPC states, not just in the 18 UPC states.

The “true” applicants/proprietors must be indicated, i.e., the party that currently owns the patent rights, regardless of whether they are actually recorded in the European patent register or the national patent registers.

It is therefore important to carefully check the ownership of any applications/patents to be opted out. While licensees do not have the right to request an opt-out, applicants/proprietors need to verify who is allowed to decide about the filing of an opt-out request.



The validity of an opt-out which is recorded by the UPC Registry can later still be challenged. Any errors in the opt-out request (wrong proprietor, omission of a state, or missing SPCs) can potentially render the opt-out invalid.

# Strategic Considerations

Several opt-out strategies can be considered:

(i) Given that an opt-out will safeguard a granted classic EP patent from a centralized revocation action by third parties before the UPC, while the patent applicant/proprietor retains the flexibility to withdraw the opt-out at a later date, opting out your EP applications/patents may constitute one possible strategy to keep control over the choice of future litigation procedures.

(ii) Avoiding the risk of centralized revocation by the UPC may be more relevant for some patents than others.

## When is an Opt-Out a Good Idea?

- Very valuable patents (“crown jewels”)
- Patents generating licensing revenue
- Patents with past opposition or litigation history
- Weaker patents in terms of validity
- Patents validated/infringed in only 1–2 states (national procedures may be cheaper)



# Costs & Support

**In terms of costs, there is no official fee for an opt-out.**

**Our formality fee for an opt-out of a single EP application/patent is 150 EUR (excl. VAT).**

This applies to cases where the information received is complete.

The filing of opt-out requests requires active steps to be taken, typically via a European Patent Attorney, which entails costs.

Any additional work (e.g. reminders, contacting co-applicants) will be charged either hourly or per our fee schedule.

We also invite you to have a look at our website (<https://www.dcp-ip.com/en/services/up-upc>) for further details, legal background and strategic considerations regarding the Unitary Patent (UP), the Unified Patent Court (UPC) and opt-outs.

# de clercq & partners

## MAIN OFFICE

Edgard Gevaertdreef 10a  
B-9830 Sint-Martens-Latem  
Belgium

## LEUVEN OFFICE

Silo T2  
Fonteinstraat 1/A 0201  
B-3000 Leuven  
Belgium

## HASSELT OFFICE

Corda Campus - Corda Gebouw 2  
Kempische Steenweg 293/16  
B-3500 Hasselt  
Belgium

 @DeClercqPartners  
 +32 (0)9 280 23 40

 @DeClercqPartners  
 info@dcp-ip.com

 @DeClercqPartners

 @de-clercq-and-partners