

Unified Patent Court - Opt-Outs

Opting Out – Practical Guidance

With this guide, we want to clarify what's required for filing opt-out requests under the UPC system. We'll also explain who can request it, what it costs, how to do it properly, and what risks to avoid.

This guide answers:

- Can I opt-out pending applications?
- What information do I need to submit?
- What are the costs and risks?



Need advice tailored to your portfolio? Contact us at:
info@dcp-ip.com

Applicability

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.

Applicants who will soon have granted EP classic European Patents may wish to opt-out their European patent applications.

One precondition is that no action has been commenced before the UPC prior to the opt-out becoming effective.

Required Information



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.

True owner \neq name on register.
Always verify ownership.

Costs & Manual Review

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:

€150 per opt-out (excl. VAT)
Extras billed hourly if info is incomplete

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.

Ensuring Validity

An opted-out 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 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 (proprietor(s) or applicant(s)) providing the instructions to us has obtained the agreement of all actual co-proprietors or co-applicants to request the opt-out.

Key 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.

Timing & Withdrawal

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.

An opt-out may be later withdrawn, allowing the future patent proprietor to initiate an infringement action before the UPC for those of the 18 Contracting Member States in which the patent has an effect.

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.

In case an opt-out is 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.



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