New European Patent System with Unitary Effect (UP)

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Authors

Gustavo Haas Vieiralves

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Gustavo Vieiralves

A new unitary patent system ("European Patent with Unitary Effect", "UP-system" or simply "UP") will become effective in the European Union (EU) in June 2023. According to the new system, patents granted in Europe and included in the UP-system will be valid in the vast majority of countries belonging to the European Union, without the need for the current validation procedure, separately, for each country of interest.

Such system is one of the pillars of the new patent protection program in Europe that will be implemented together with the agreement called "European Unified Patent Court (UPC)". Said Court will be responsible for ensuring and consummating all the procedures related to infringement and nullity actions regarding patents under the new system, as well as patents already granted under the system still in effect.

According to the UP-system, applicants for patent applications must request participation in such a program within one month after the publication of the notification of intention to grant the European patent. There is no extension for this deadline. It is also possible for the applicant to choose not to have its patent included in the UP-system ("opt-out"). In this case, the patent will follow the usual validation procedure (and eventual translation) individually in each country of interest.

Furthermore, the costs associated with filing and prosecuting patent applications will remain the same, as the UP-system will not alter procedures that were already practiced up to the time of grant. On the other hand, it is possible that there will be a significant reduction in the validation procedure costs, depending on the selection of countries where the patent protection is of interest.

For example, the validation of a European patent by the traditional method, in 17 countries separately, would cost around 20,000 to 40,000 Euros. However, when using the UP-system in all the same 17 countries, the costs involved would be around 2,000 to 4,000 Euros[1].

It is important to point out that patents that have already been granted through the standard procedure[2] cannot be converted into unitary patents. It is also important to emphasize that even if the UP-system has already been started, it will still be possible to use the traditional validation procedure of a patent granted in Europe individually in countries of interest, i.e., via "opt-out" of the UP-system. The decision on which patent route to follow is at the discretion of the applicant. The main aspects to be considered in this decision-making process are:

- costs analysis;
- strategic aspects;

- number of countries of interest;
- portfolio analysis;
- strength of patents in an individualized and unified manner, among others.

Given that the new system will be established by the EU, all countries of the European continent that are not part thereof will not adopt the new system, such as Switzerland, Norway and the United Kingdom. It should also be mentioned that some countries, despite being members of the EU, such as Spain and Croatia, will not adopt the UP-system in their patentary scope.

There is no doubt that the implementation of the Unitary Patent System – UP will represent the biggest change in the patent area in Europe in the last years. However, the consequences arising from such a system can only be ascertained after its implementation.

NOTES:

[1] Estimated costs include local intellectual property agency fees, official fees, and translation costs, which can vary considerably depending on the size of the patent text.

[2] Standard procedure means the procedure currently adopted for patents granted in Europe, in which there is a need for individual validation in the countries of interest after granting thereof.

>>> This article was writen by our Intellectual Property associates: Gustavo Felipe Haas Vieiralves and Letícia dos Santos Viana.

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Gustavo Haas Vieiralves