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Is 2022 the year of the UPC?

The Unified Patent Court finally looks like it will be up and running in Europe by the end of 2022 or in early 2023, after decades of false starts and long pauses.

In January this year, Austria ratified the Protocol on Provisional Application of the UPC Agreement to become the thirteenth state to do so, the minimum number required for the Protocol to come into force. The final action that must occur for the UPC to become a reality is the deposit of Germany's instrument of ratification of the Unitary Patent Court Agreement (UPCA), which then starts a 3 to 4 month countdown to the UPCA coming into force.

Once the unitary patent system is up and running, the parallel unitary patent system will take effect and will be part of the post-grant procedure of the European Patent Office ("EPO"). Pre-grant proceedings at the EPO will continue as they do presently. The decision to have a unitary patent or a bundle of national patents will need to be made post-grant. The UPC will still have jurisdiction, as well as national courts, for non-unitary patents, unless the European patent has been opted-out.

Despite the exact date of the start of UPCA being unknown, *now* is the time for applicants to think about whether they wish certain of their pending European patent applications to be part of the unitary patent system.

The EPO is introducing two transitional provisions ahead of the UPCA coming into force; the ability to request a unitary effect early, and the ability to request delay of grant until the UPCA is in force. Both of these provisions will be available to applicants on the date that Germany deposits its instrument of ratification of the UPCA, expected to be in the next few months. The transitional provisions only apply to applications for which an Intention to Grant notification has been dispatched (a 71(3) communication) but a response approving the text for grant has not yet been filed.

The **first transitional measure** is the ability to make an early request for unitary effect. Once the request has been filed, the EPO will notify the applicant of any formal deficiencies, such that the applicant may correct them before entry into force of the UPCA. A patent will then grant as a unitary patent, provided the UPCA has come into force on or by the date of grant.

The **second transitional measure** allows for an applicant to request to delay the grant of a pending European patent application such that it grants on the coming into force of the UPCA. The proprietor will then have one month to make the decision whether they wish the patent to have unitary effect and make such a request. The request to delay grant can be filed alongside an early request for unitary effect or on its own.

The deposit of the instrument of ratification by Germany will also trigger the three-month 'sunrise' period for opting-out of the jurisdiction of the UPC. The ability to opt-out (and the ability to withdraw the opt-out), however, will be available for at least 7 years after the UPC comes into force, provided certain conditions are met.

The decision of whether to obtain a unitary patent or a bundle of national patents, and whether to opt-out will depend greatly on an applicant's portfolio, commercial requirements and budget, among many other factors. At HG we are

evaluating the various options for our clients and are very happy to discuss the issues with you at any time. Please contact us for any further information and we shall keep you informed as timings become clearer.