

## Preparing for the UPC: What to do when\*

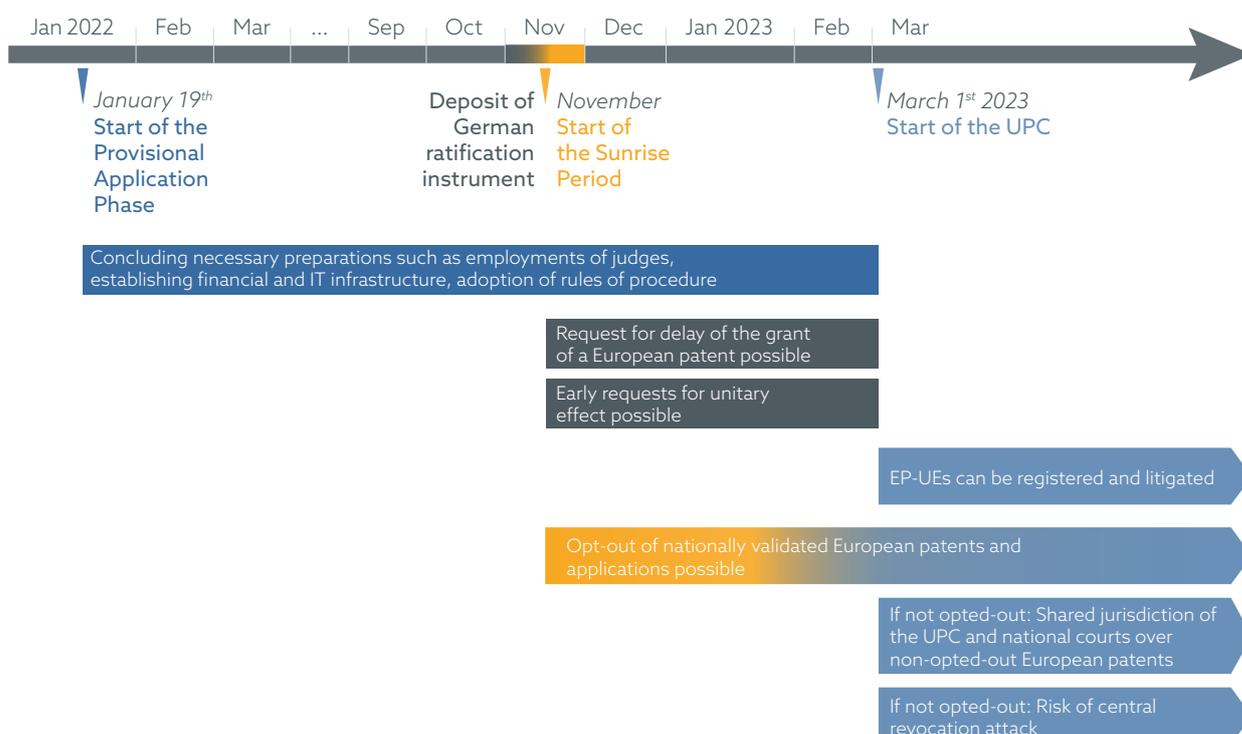
With the Unified Patent Court (UPC) and the European Patent with Unitary Effect (EP-UE), a new patent system will come to Europe in early 2023 (likely on March 1, 2023), introducing a major change in the European patent litigation system. On January 19, 2022 the provisional application period (PAP) began. The UPC has come into existence as a legal entity and is conducting the necessary preparations before the new system can commence.

Once it is clear when the UPC will be functional, Germany is expected to deposit its ratification instrument triggering the opening of the UPC. The new system will start on the first day of the fourth month after Germany's ratification. According to the Administrative Committee's estimate this can reasonably be expected in early 2023 while March 1, 2023 is considered as the most likely starting date. The following is a brief outline of the overall time line based on the assumption that the UPC (and the entire new system) will start on March 1, 2023:

### January 19, 2022: Beginning of the PAP

- The UPC exists as a legal entity and concludes the necessary preparations:
  - Adoption of the Rules of Procedure (done on July 8, 2022)
  - Selections and appointment of judges and staff
  - Legal, financial and IT infrastructure preparations
  - Establishment of the working capability of the divisions and function test

Outline of the overall time line based on the assumption that the UPC will start on March 1, 2023



\*This is an updated version of the article "Preparing for the UPC: What to do when" which was originally published in the HOFFMANN EITLE Quarterly in March 2022".

## November 2022: Germany deposits its ratification instrument

- The German ratification will trigger the opening of the UPC on the first day of the 4<sup>th</sup> month thereafter (i.e. for the UPC to start on March 1, 2023, Germany will have to deposit its ratification instrument in November 2022).
- Applicants can request a delay in issuing the decision to grant a European patent in response to a communication under Rule 71(3) EPC, so that the patent will be granted only after the new system has come into force and unitary effect will become available for the EP patent.
- Early requests for unitary effect may be filed for European patent applications.

## At the same time: Start of the sunrise period

- The German deposit will also mark the start of the sunrise period.
- Opt-outs for European patents can be declared at the UPC. Opting out removes the UPC's jurisdiction over a given European patent and avoids, for example, a central revocation attack. The sunrise period offers patentees a head start before competitors have a chance to initiate a revocation action before the UPC.
- Opt-outs are also possible for pending EP patent applications. By opting out an EP patent application (during or after the sunrise period), the applicant can ensure that the opt-out is registered before the patent is granted. As a result, an action against the granted patent before the UPC can be avoided.

## March 1, 2023: Legal proceedings can begin

- European patents with unitary effect (EP-UE) can be obtained at the EPO and litigated before the UPC.
- Revocation actions or actions for declaration of non-infringement can be filed before the UPC in relation to EP-UEs and European patents which have not been opted out.

- The UPC and national courts have shared jurisdiction over European patents which are not opted out during a transitional period of seven years (which can be extended up to 14 years). This means that the plaintiff can choose whether to file an action before a national court or before the UPC. Depending on the case, there will be a race between the alleged infringer and the proprietor as to who is the first to file an action before the most favoured court.
- An opt-out is no longer possible if an action has been filed in respect of the relevant European patent before the UPC, and the withdrawal of an opt-out is no longer possible if an action has been filed before a national court in relation to an opted out EP patent.
- In Germany and France, new rules on double patenting will come into force, allowing double patent protection for a national patent for the same invention alongside an EP-UE or a traditional European patent as long as the latter is not opted out.

If you are interested in learning more about this new court system in Europe, please see the [Questions and Answers](#) on HOFFMANN EITLE website. We provide answers to the most frequently asked questions and include further guides and recorded lectures for those who are interested in a more detailed explanation. For any further questions, please do not hesitate to contact us at [upc@hoffmanneitle.com](mailto:upc@hoffmanneitle.com).

### Nikita Alymov

LL.M. IP (Queen Mary University of London)  
Attorney-at-law  
HE Patent Litigation and Contracts practice group



### Dirk Schüßler-Langeheine

Dr. jur.  
Partner | Attorney-at-law, Mediator  
HE Patent Litigation and Contracts practice group

