

EXPLANATORY LETTER

Registration/validation of your European patent as per 1 September 2024

Once a European patent has been definitively granted, it must then be registered in order to obtain an effective protection under the law.

This registration step is also referred to as the validation of your European patent.

Once the European patent has been validated, you are entitled to enforce the patent against third parties in the countries for which the validation is effective.

Country coverage of a European patent

The validation of a European patent is possible for the following countries:

Albania, Belgium, Bulgaria, Cyprus, Denmark, Germany, Estonia, Finland, France, Greece, Hungary, Ireland, Iceland, Italy, Croatia, Latvia, Lithuania, Luxembourg, Macedonia, Malta, Monaco, Montenegro, the Netherlands, Norway, Austria, Poland, Portugal, Romania, San Marino, Serbia, Slovenia, Slovakia, Spain, Czech Republic, Turkey, United Kingdom, Sweden and Switzerland/Liechtenstein.

Validation of a European patent

For each individual country, it is possible to carry out what is referred to as a national validation, on which each country imposes its own conditions.

As per 1 September 2024, it will also be possible for applicants in a group of 18 EU-countries to register a unitary patent by which validation for all 18 EU-countries can be achieved by a single validation, instead of having to carry out individual national validations.

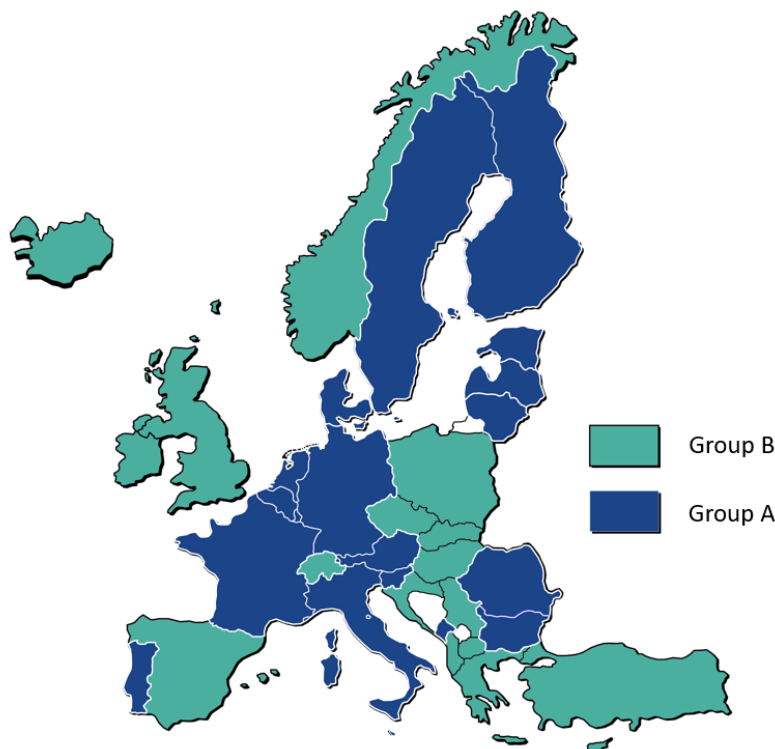
The group of 18 EU-countries that can be covered by a unitary patent are: Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Romania, Slovenia and Sweden.

This means that, for the purposes of the validation of a European patent, country coverage is broken down into two groups:



- Group A:
The 18 EU-countries wherein validation of a unitary patent is available, and wherein national validation remains available as an alternative.
- Group B:
Other countries not participating in the unitary patent legislation, and wherein only national validation is available.

The countries that can be covered by a European patent are shown in the map below, with Group A countries being indicated in dark blue and Group B countries in green.



For Group A countries (coloured blue), it is therefore possible to choose between:

- national validations in individual Group A countries
- registration of a unitary patent for all Group A countries

For Group B countries (coloured green), European patent registration is possible only by carrying out national validations in individual Group B countries.

Selection form with a cost overview

The enclosed selection form for European patent registrations provides the indicative costs for national validations for each Group A and Group B country.

The costs are largely determined by each country's formal requirements for national validation, which vary from country to country. The most important factor in that respect is whether a country requires a full or partial translation of the patent as a formal condition.

For Group A countries, the selection form distinguishes between the two possible ways (options A1 and A2) to validate a European patent:

- under option A1 you will find the costs for national validations
- under option A2 you will find the costs for validating a unitary patent

Here you should choose one of the two options A1 or A2. Choosing one validation option excludes the other.

In order to register a unitary patent, it is necessary for a translation of the entire text of the patent to be submitted with the application for registration of a unitary patent. The expected costs of such a translation are specified separately under option A2.

Choice between a unitary patent or national validations for Group A

Financial aspects

It is clear that if you want to validate a European patent for protection in a significant number of Group A countries, it soon becomes financially beneficial to opt for a unitary patent instead of national validations.

This financial benefit relates purely to the step of validating the European patent, and therefore exists on a one-off basis.

In addition, it is necessary to pay annual fees for each validated European patent. In this respect also, there is a significant difference between the cost of national validations and that of a unitary patent:

- for a nationally validated patent, you will have to pay an annual fee in each individual country;
- for a unitary patent, you will have to pay one annual fee which is equivalent to the sum of four individual sets of annual fees for the EU countries in Group A.

So, as a rule of thumb, it can be concluded that if you seek protection in more than four Group A countries, it will be financially beneficial to opt for a unitary patent. The greater the number of Group A countries in which you seek protection, the greater that financial benefit will be.

The only thing to be pointed out here is that a unitary patent requires one fixed annual fee, and if you stop paying it you lose the patent right in all participating countries.

On the contrary, for national validations, each year it is possible to consider whether to stop paying annual fees in one or more countries while still retaining your patent right in a core group of countries.

Thus, for a European patent with national validations, each year you can consider reducing your costs in annual fees to an amount similar to, or even lower than, that for a unitary patent.

Legal aspects

Unitary patent:

- *compulsorily attached to a single supranational court*

A special aspect of the unitary patent is that legal actions concerning a unitary patent may be brought only before a new supranational court: the Unified Patent Court (UPC).

The UPC's ruling then produces its effects throughout the entire group of countries in respect of which the unitary patent is registered.

The effectiveness of a ruling by the UPC is therefore attractive on account of its supranational nature, but the same holds true whether the ruling is advantageous or disadvantageous. Moreover, it will have to be taken into account in the early stages that the UPC is a new court with new rules, on account of which judicial process will be less predictable initially.

Lastly, it should be noted that the cost of bringing an action before the UPC will generally be significantly higher than that of bringing an action before a national court.

National validations:

- a choice between different courts

For a European patent with national validations in Group A countries, the judicial process is organised somewhat differently:

With effect from 1 June 2023 and for a transition period of 7 to 14 years, the legislation offers the possibility, in the case of national validations in Group A countries, to choose whether to bring proceedings before:

- the UPC as a supranational court; or
- a national court of your choosing.

You can decide which of the two routes is most attractive to you in each specific situation. The two routes will remain available alongside one another throughout the transition period and you can switch between them depending on the situation.

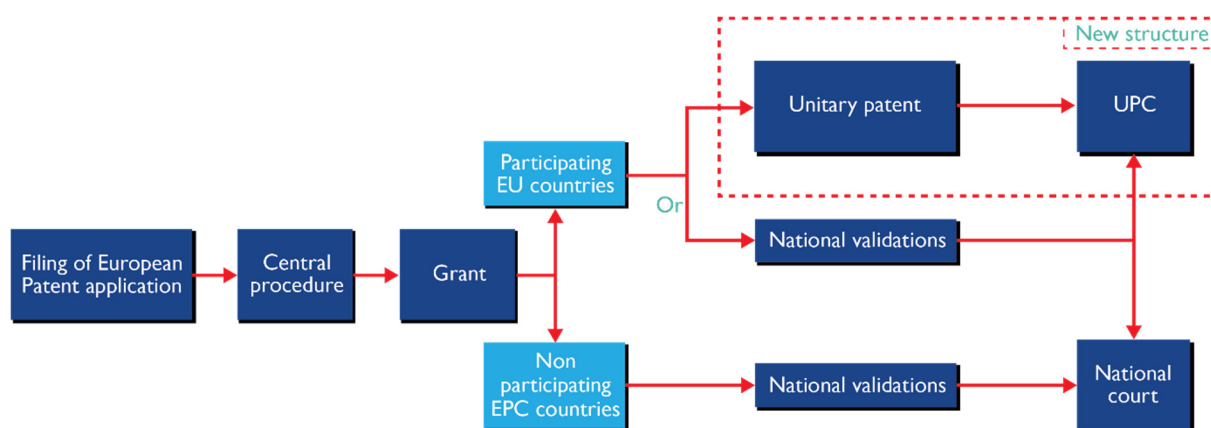
Therefore, if you wish to keep both the national and supranational channels of judicial process open for your European patent, you will have to register the patent by way of national validations.

After the transition period has expired, the UPC will eventually handle all cases and it will no longer be possible to bring proceedings before a national court.

Schematic overview

The diagram below provides an overview of how the various forms of registering a European patent and the possible channels of judicial process are linked.

This scheme will apply during a transitional period of 7 to 14 years, starting from 1 June 2023.



Additional option for national validations for Group A: opt-out

If you opt for national validations in Group A countries in the selection form (option A1), you have the option of making another choice for your European patent, appearing on the last line as 'UPC opt-out registration'.

A UPC opt-out registration is an additional act we can perform to exclude the jurisdiction of the UPC for your European patent.

This effectively means that actions against your European patent can be brought only before national courts.

Patent proprietors can withdraw an opt-out once at a later time of their choosing, provided that no national proceedings have been or are being brought against the patent in question. The withdrawal of the opt-out results in a situation where both the UPC and national courts have jurisdiction.

Considerations relating to opt-outs: the benefits are limited



In having an opt-out registered, a patent proprietor prevents third parties from bringing an invalidity action against the patent before the UPC on their own initiative. An opt-out therefore eliminates, in advance, the risk of an unwanted finding of invalidity by the UPC and the effectiveness of that finding in all Group A countries where the patent has been validated.

One downside of opt-outs is that they can no longer be withdrawn if national proceedings have ever been conducted or are still being conducted against the European patent in question. In such a case, the opt-out becomes permanent, and the exclusion of the UPC is then irreversible.

Therefore, under certain circumstances, an opt-out cannot be subsequently withdrawn once it has been submitted and it may thus result in a definitive exclusion of the jurisdiction of the UPC.

A further important consideration when it comes to opt-outs is that their defensive effect should not be overestimated in the case of a European patent that has just been granted:

The European Patent Convention allows third parties to file an opposition to the grant of the patent before the European Patent Office within 9 months of the grant of the patent.

Such an opposition has a greater effect than invalidity proceedings before the UPC, because if the European Patent Office declares the patent to be invalid, that decision is effective in all countries in which the patent is registered. Moreover, the cost of filing an opposition is significantly less than that of bringing invalidity proceedings before the UPC.