

What Happens if I Miss the Deadline for Requesting a Unitary Patent?

The Unitary Patent (UP) system will open on 1 June 2023. From this date, applicants for European Patents will be able to decide whether the European Patent should become a Unitary Patent for those countries participating in the UPC or whether to proceed with individual national validations of the European Patent in all or some of those countries. For countries not participating in the UPC, validation will proceed as before.

Of the 38 countries that are members of the European Patent Convention (EPC), the Unitary Patent will cover at least 17 EU countries and ultimately 24 countries when all have ratified. The Unitary Patent will provide a cost-effective way to obtain protection across a large part of Europe because only a single translation will be required to request a Unitary Patent. In contrast, individual national validations typically require a translation of all or part of the patent into a relevant official language. The cost and administrative burden of maintaining a Unitary Patent will also be reduced relative to individual national validations, as a single annual renewal fee equivalent to the total cost of renewal fees in the UK, Germany, France and the Netherlands will be payable.

Procedure to obtain a Unitary Patent

A Unitary Patent must be requested within one month of grant of a European Patent. Extensions to the one-month term are not available. This is in striking contrast with the term for pursuing individual national validation, which is typically three months from grant.

The short, one-month term for requesting a Unitary Patent is compounded by the requirement for a complete translation of the patent into another EU language (where the patent is granted in English) or into English (where the patent is granted in French or German). Furthermore, according to EU Regulation 1260/2012 on the translation arrangements for Unitary Patents, translations should not be carried out by automated means. As preparation of a non-machine translation of a long specification may take several weeks, applicants previously accustomed to deferring their choice of validation countries until grant of a European Patent may now find that a decision needs to be taken earlier should a Unitary Patent be of interest, for instance at allowance.

It can be foreseen, therefore, that circumstances may arise that result in non-availability of the required translation by the one-month deadline for requesting a Unitary Patent, or even in the deadline being accidentally missed in its entirety. Options for continuing in the pursuit of protection in each case are discussed below.

Translation not available by one-month deadline

If a non-machine translation is not available by the one-month deadline for requesting a Unitary Patent, the request may be filed without the translation initially. In accordance with Rule 7(3) of the Rules relating to Unitary Patent Protection (UPR), the EPO will then invite the requester to provide the translation within a further non-extendable one-month period.

Should the translation not be filed within the period for responding to the invitation, the request for a Unitary Patent will be finally rejected. Re-establishment of rights is not available in respect of this deadline. Therefore, the only way to proceed with protection would be via individual national validations. The national validation route remains available for all countries covered by the Unitary Patent.

The deadline for national validation is typically three months from grant of the European Patent. However, most countries participating in the Unitary Patent will be introducing provisions that permit late national validation in the case that a request for a Unitary Patent is rejected after the normal deadline for national validation. Of the 17 countries participating in the Unitary Patent from 1 June 2023, provisions have, at the time of writing, already been introduced in Bulgaria, Belgium, Estonia, Finland, France, Italy, Lithuania and Sweden. Austria, Denmark, Germany, Latvia, the Netherlands, and Slovenia have confirmed that they intend to introduce such provisions, and Luxembourg and Portugal are considering the matter. Of the countries intending to participate in the Unitary Patent at a later date, the Czech Republic, Hungary, Romania intend to introduce provisions, and Greece, Ireland, and Slovakia are considering the matter.

Deadline for requesting a Unitary Patent is accidentally missed

Re-establishment of rights

If the one-month deadline for requesting a Unitary Patent is accidentally missed in its entirety, it will be possible to request re-establishment of rights at the EPO, in accordance with Rule 22(1) UPR. In this case, the deadline for filing a request for re-establishment is two months from expiry of the one-month term (Rule 22(2) UPR). This is notably different from the deadline for requesting re-establishment with respect to most other time periods at the EPO, for which the deadline may be two months from the removal of the cause of non-compliance with the time period. However, setting the deadline as two months from expiry of the one-month term brings the deadline for re-establishment with respect to requesting a Unitary Patent in line with the typical three-month period for national validation.

A request for re-establishment must be accompanied by a request for a Unitary Patent (including the necessary translation) and payment of the required fee (Rule 22(3) UPR). The request must

be substantiated, and will only be granted in situations where it is proven that the one-month deadline was missed in spite of all due care required by the circumstances having been taken. The bar for successful re-establishment is therefore high, and it will not suffice to show that the deadline was merely missed unintentionally.

Given the need for substantive evaluation, the outcome of any given request for re-establishment is likely to be uncertain until a final decision is taken by the EPO, which may take several months.

Aborting to national validations

Another way of remedying a missed one-month deadline may be to drop the quest for a Unitary Patent and instead pursue protection via individual national validations. The national validation route provides certainty of protection because a request for national validation will be allowed provided that the relevant formal requirements are met. Pursuing protection via the national validation route may therefore provide an attractive alternative to requesting re-establishment, as it avoids the uncertainty associated with such a request. The national validation route is likely also be preferred in cases where a request for re-establishment has low chances of success, for instance where it is not possible to demonstrate that the requirement for all due care was met or where it is undesirable to put the explanation for the error into the public domain by filing a request for re-establishment of rights.

As the deadline for national validation is typically three months from grant of the European Patent, the timeframe for proceeding with this option is essentially the same as that for requesting re-establishment with respect to requesting a Unitary Patent. Beyond the three-month window, re-establishment is unavailable but it may still be possible to use the national validation route to pursue protection in a number of countries that permit validation after the usual three-month deadline. The national validation route may therefore provide an option for partial recovery of rights, should the three-month deadline for re-establishment also be missed.

Aborting to national validation may, however, prove more expensive than re-establishing rights to a Unitary Patent. Where protection is desired in an extensive range of countries, the initial

cost of national validation is likely to be large. This may be offset to some degree by the significant costs involved with substantiating a request for re-establishment to demonstrate that the requirement for all due care is met. In the longer term, though, the renewal fees payable for an extensive series of national validations will be far greater than the single annual fee payable for a Unitary Patent. Some proprietors may therefore prefer to pursue re-establishment, despite its more uncertain nature.

Late national validation - a safety net favouring re-establishment?

As mentioned above, most countries participating in the Unitary Patent will be providing a safety net that allows late national validation of a European Patent where a request for a Unitary Patent has been rejected after the usual validation deadline. Using the safety net, it will be possible to pursue protection via national validation even after expiry of the period for requesting such validation, should a request for a Unitary Patent be rejected after that point.

This means that, if the one-month deadline for requesting a Unitary Patent is missed, it will be possible to request re-establishment of rights at the EPO in the first instance, with the safety net being used to obtain national validations should the request be refused after expiry of the usual validation period.

As a request for re-establishment can prove costly due to the substantive nature of the procedure, reliance on the safety net is likely to be reserved for cases in which there is a good chance of being able to show that the one-month deadline for requesting a Unitary Patent was missed in spite of all due care required by the circumstances having been taken. In these cases, the savings afforded by obtaining a Unitary Patent are likely to outweigh the costs associated with re-establishment. The availability of the safety net will afford proprietors confidence to pursue such savings, in the knowledge that national validations should be available as a fall-back if the right to a Unitary Patent is not ultimately re-established. That said, proprietors for high-value patents may prefer the certainty provided by routine national validation over the potential cost-saving benefits of re-establishment, at least until the safety net provisions have been tested in practice and case law has been established.

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