Proskauer

Preparing for Europe's Unified Patent Court

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After years of contemplation and delays, Europe's Unified Patent Court will be operational in about one year. U.S.-based Life Sciences patent applicants should start preparing now to ensure that their applications withstand scrutiny under the new patent court.

Europe is finalizing the establishment of the European Unified Patent Court (UPC). Once in operation, the UPC will be a centralized court devoted to settling patent disputes across Europe. The establishment of the UPC will allow patent owners to enforce European patents (and defendants to challenge them) in a single venue, instead of the current practice of bringing enforcement actions in the courts of each respective European state. There will be a transitional period during which European patents may be opted-out of UPC jurisdiction. However, all European patents applied for after the transitional period will fall under the jurisdiction of the UPC. Of course, courts of a particular country will continue to have jurisdiction over patent applications filed directly in that particular country using the Paris Convention.

Political and constitutional issues in the United Kingdom (i.e., Brexit) and Germany, respectively, have delayed the implementation of the UPC despite its ratification in 2013. These issues have (mostly) been resolved and, as of January 19, 2022, thirteen states have ratified the start of the Provisional Application Period of the UPC agreement. This means the final stages of implementing the UPC may commence (e.g., recruiting judges). Current estimates indicate an official start date of early 2023 with Courts of First Instance in Milan, Munich, Paris, and Stockholm, and a Court of Appeal in Luxembourg.

The establishment of the UPC also means the birth of the Unitary Patent – a single patent that provides uniform patent protection across UPC member states. Once the UPC is official, any European patent granted may become a Unitary Patent upon request. The list of states that will participate in the Unitary Patent once the UPC becomes operational includes Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia, and Sweden. Cyprus, Czech Republic, Greece, Hungary, Ireland, Poland, Romania, and Slovakia plan on joining shortly thereafter.

Takeaways

An established UPC will make European patents more attractive to U.S.-based applicants and will have practical implications in all fields, including Life Sciences of which there were over 10,000 related applications filed in Europe in 2020. Usually, U.S.-based patent applications are filed in Europe within a year or thirty-one months of their U.S. priority date via the Paris Convention or the Patent Cooperation Treaty, respectively. Chances are applications that are currently being drafted by a U.S.-based applicant will be filed in Europe after the UPC and Unitary Patent are in effect. Care should be taken to ensure these applications are drafted to withstand European scrutiny – especially because this new European patent court will not have settled case law of its own. For example, specifications should be drafted with enough description and support (more than is typically required in the U.S.) to withstand “added matter” rejections. Also, of particular importance to the Life Sciences, applicants should be careful when drafting claims that can be construed as methods of treatment, as such claims are generally prohibited in Europe unless they fall within a specific exception such as the exception for “purpose-limited product” claims. Ensuring that applications meet these and other European patent application thresholds will allow U.S.-based applicants to hit the ground running once the European patent court opens its doors next year.

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