



## Critical Dates for Europe's New Unified Patent and Unitary Patent Court Now Certain

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Now is the time to act if you have European patents or a pending application. Europe's new Unified Patent and Unitary Patent Court (UP/UPC), which have been in development for the better part of a decade, are finally on the verge of taking effect now that Germany has ratified the [Agreement on the UP/UPC](#).

### **Go Live Date is *June 1, 2023***

Once the new system "goes live" on June 1, 2023, European patent owners and challengers will have the option to litigate across most of Europe in a single enforcement or invalidity challenge. In contrast, Europe's existing patent system requires lawsuits to be filed in each country where the patent is active. Seventeen European countries are signatories to the new UP/UPC system. Seven additional countries are expected to join. While the United Kingdom (UK) was expected to be a leader in the new system, as a result of Brexit the UK was withdrawn from the European Union, and thus the UP/UPC. A color-coded map and list of the UP/UPC member states, as they are referred to, can be found on the UPC website [here](#).

### **An Opt-out Sunrise Period Starts *March 1, 2023***

The new system permits patent owners to "opt-out" of the UPC so as to enforce their patent(s) nationally under the existing European patent system. This "opt-out" is for the first seven years once the new system takes effect, and may be extended up to 14 years under the existing enactment [regulations](#). A "sunrise period" begins March 1, 2023, when patent owners can begin using the [Registry of the UPC](#) to opt-out. The opt-out is a measure available to exclude the competence of the UPC to decide on the infringement or validity of a traditional (=non-unitary) European Patent. Patents that are not affirmatively opted-out will automatically be opted-in to the UPC.

### **The Mechanics and Timing of the Opt-out Option**

When considering the mechanics of deciding whether to opt-out or opt-in your patents/applications to the new system, it's important to get a clear picture of the ownership situation of your portfolio as soon as possible. Based on the ownership situation, arranging for declarations or getting the registers up-to-date may be necessary before opting out. If the opt-out is filed in the wrong name, the opt-out is not valid even though it will be registered. The validity of the opt-out will only be attacked during trial. The opt-out can also be filed by service providers with a valid mandate for the opt-out from the correct owner. All co-proprietors/co-applicants must lodge the opt-out together. It's also advisable to coordinate your opt-out strategy with your licensees.

A request to opt out must be lodged with the Registry of the UPC and not the EPO. The opt-out will take effect once entered into the register. No checks as to the validity of the request are made and no processing fees are required. The opt-out must be lodged for all states in which the European Patent is validated, not only the UPC member states.

The request to opt out can be filed any time up to the last month before expiry of the transitional period, but only if no national litigation was initiated in the meantime. A European Patent without an opt-out is subject to the jurisdiction of the UPC exposing the patent to a central revocation action.

It is possible at any time during the transition period to opt back into the UPC (opt-in), but once back in, there are no further opt-outs available. And, if a European patent application for which an opt-out has been filed proceeds to grant and a Unitary Patent is requested, the prior opt-out is deemed to be withdrawn.

### **Next Steps**

We strongly encourage patent owners/applicants to consider the strategic ramifications of opting in or out of the UPC. Our team is available to assist you in evaluating and navigating your options for managing your European patent portfolio.

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