

Litigating before a new Court: **The Unified Patent Court**

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Roadmap

1. Historical bits and purpose
2. Competences, structure and composition
3. Key procedural aspects

Q&A

Contextualization



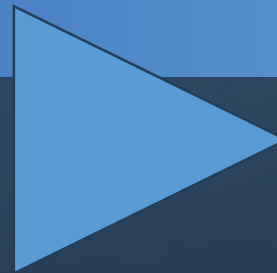
European
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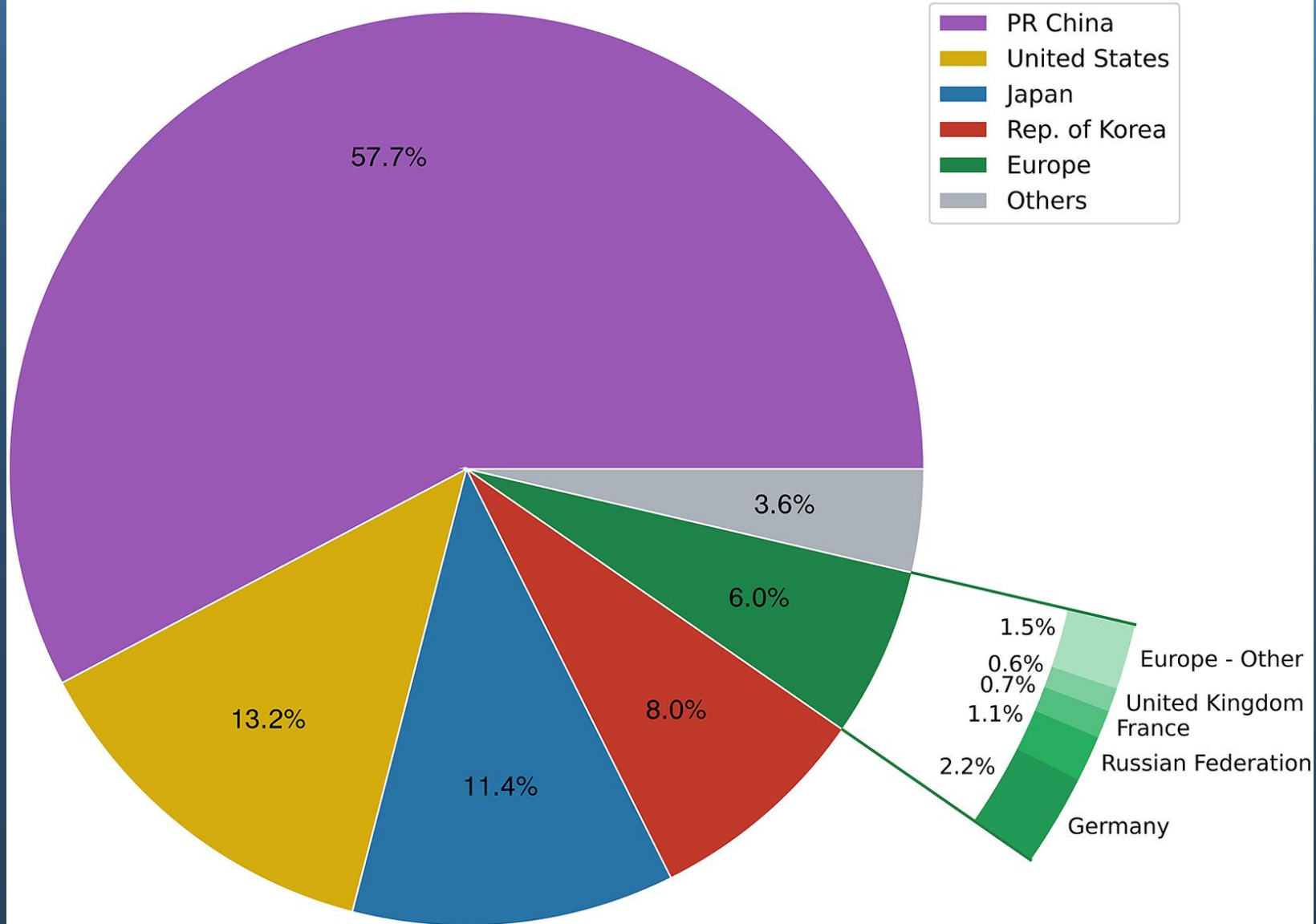
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EU competitiveness: Looking ahead



Breakdown of Patent Applications by Applicant Residence, 2020



Bostrom/Nayyar (2023)
“Fit for purpose? The patents regime, the Fourth Industrial Revolution, and sustainable development” Data & Policy vol.5

Specific underlying rationale

- Attracting and supporting innovators
- Reducing litigation costs
- Harmonizing legal interpretation
- Enhancing legal certainty

A long path towards patent legal approximation

- Since 1950s: attempts towards EU patent legal entitlements
 - **1973: European Patent Convention + European Patent Office**
 - Centralized patent examination and granting body
 - 1975: Luxembourg Community Patent Convention (insufficient ratifications)
 - Effective unified patent legal protection and enforcement

Difficulties in consensus re translation and jurisdictional arrangements

Reluctancy towards amending national patent legal systems

- 2000: Renewed proposal for a Community Patent Regulation
 - Focus on jurisdictional arrangements
- 2007: EC Communication “Enhancing the patent system in Europe”
- 2011: Grand Chamber rejects EC proposal due to Treaties incompatibility
(national courts deprived of their power to interpret EU law, CJEU deprived of its power to clarify via preliminary rulings)
- 2020: “Rapid roll-out” of the **Unitary patent package**
- **1 June 2023: UPC started its operations** (over 340 cases registered so far)

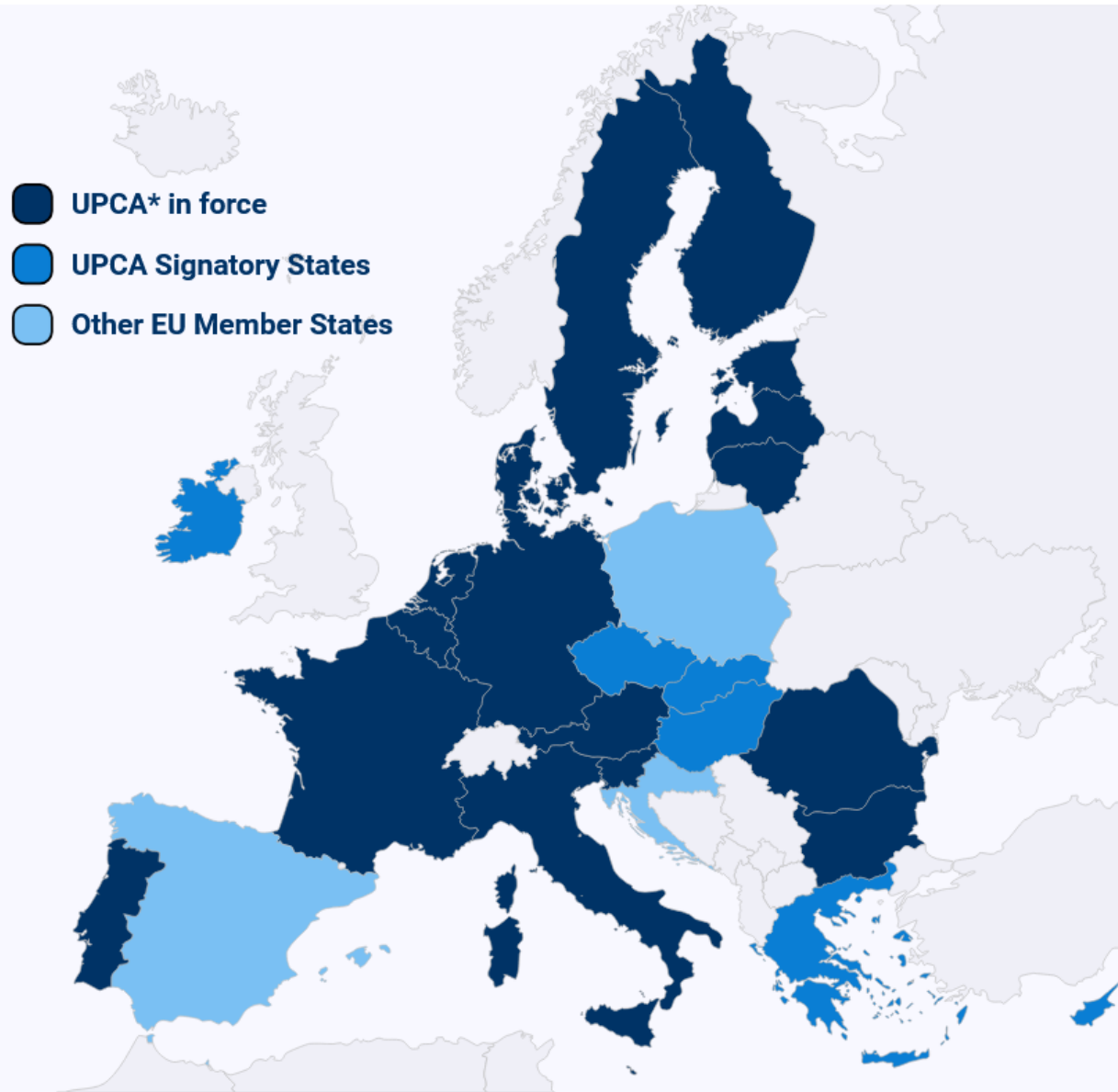
The EU Unitary Patent package

- **Unitary Patent Regulation (UPR) 1257/2012**
- **Translation Regulation (TR) 1260/2012**

- **Agreement on a Unified Patent Court (UPCA) 2013**
 - Not EU legislation
 - Intergovernmental treaty



UPC Member States map



* UPCA stands for "Agreement on a Unified Patent Court"

Select a Member State below to learn more

- | | | |
|------------|---------------|------------------|
| ● Austria | ● Latvia | ● Cyprus |
| ● Belgium | ● Lithuania | ● Czech Republic |
| ● Bulgaria | ● Luxembourg | ● Greece |
| ● Denmark | ● Malta | ● Hungary |
| ● Estonia | ● Netherlands | ● Ireland |
| ● Finland | ● Portugal | ● Slovakia |
| ● France | ● Romania | ● Croatia |
| ● Germany | ● Slovenia | ● Poland |
| ● Italy | ● Sweden | ● Spain |

UPCA currently in force in 18 EU Member States

EP with UP effect: An additional option

- National patent
- “Traditional” European Patents (EPC + national patent laws):
bundle of national patents, validated in each designated country
- **European Patents with UP effect (UPR, TR, UPCA)**
 - Granted and administered by EPO according to regular EPC procedure
 - 1 month time since granting date: applicant’s request for UP effect
(no additional costs)
 - EPO examination of UP effect request + decision
 - If all requirements met: publication of EP with UP effect (no bundled national patents)
 - Renewal fees due to maintain UP effect (see renewal costs in last slides)

Competences of the Unified Patent Court (Art 32 UPCA)

Exclusive jurisdiction of the **Unified Patent Court**

~~○ National patents~~

- **From 2023 until 2030, unless opted-out: “traditional” European Patents**
- European Patents with UP effect
- Supplementary Protection Certificates

Type of actions

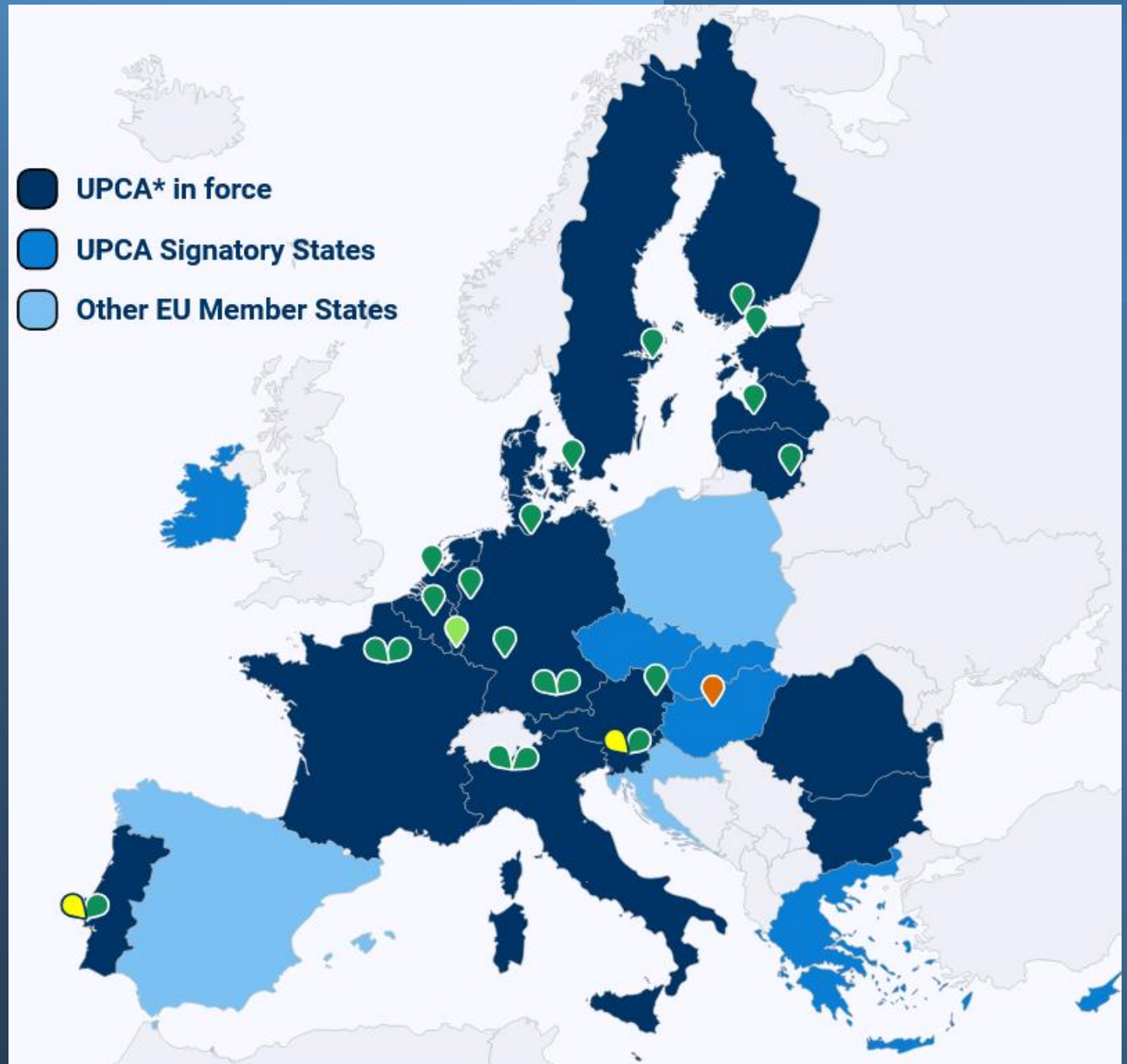
- Validity/revocation
- Infringement (actual or threatened)
- Revocation counter-claims
- Declarations of non-infringement
- Provisional and protective measures and injunctions



Jointly or
bifurcated

Structure and composition

A decentralized Court



Luxembourg



Court of Appeal (last instance)

Paris



Milan



Munich



+ Regional Divisions
*Stockholm, Riga
Tallinn, Vilnius*

+ Local Divisions
*Brussels, Copenhagen,
Dusseldorf, Hamburg,
Helsinki, Lisbon, Ljubljana,
Mannheim, Milan, Munich,
Paris, The Hague, Vienna*

Court of First Instance (Central Division)

Lisbon



Ljubljana



Patent Mediation and Arbitration Centre

Competence distribution - type of actions

- Validity/revocation **Central Division only**
- Infringement (actual or threatened) **Regional/Local Divisions**
- Revocation counter-claims **Regional/Local Divisions**
- Declarations of non-infringement **Central Division only**
- Provisional and protective measures and injunctions **Reg./Local Divisions**

Competence distribution - territory

Regional/Local Divisions

- Residence/place of business
- Place where infringement occurred/may occur
- If defendant domiciled outside contracting Member States: **Central Division** or place of infringement
- If Member State without Regional/Local Division: **Central Division**

Competence distribution – subject matter



**Transport; Textile;
Buildings; Physics;
Electricity; Execution of
operations; Supplementary
Protection Certificates
(SPCs)**



**Life science;
Pharmaceuticals;
Human needs**
eg agriculture and food
products, tobacco, clothing,
jewellery, furniture, sanitary
items, entertainment...
(excluding SPCs)



**Mechanical engineering;
lighting; heating;
weapons; explosives;
metallurgy
(excluding SPCs)**

Composition of UPC

- Eligibility criteria (Art.15 UPCA)
 - **Legally qualified judges** – expertise in patent law
 - **Technically qualified judges** – technical or scientific expertise to assist in cases involving complex technological matters
-
- Local and Regional Divisions: **3 legally qualified judges**
 - Central Division: **2 legally qualified judges + 1 technically qualified judge**
 - Court of Appeal: **3 legally qualified judges + 2 technically qualified judges**

Key procedural aspects

Translation arrangements

- Application for EP with UP effect at EPO: **English, French, or German**
+ compensation mechanism (Art.5 Translation Regulation)
- Publication of EP with UP effect **in English, French, and German** (no further EU languages)
- **Litigation: possible request for translation into any other official EU language**

Costs

Requesting UP effect in EP patent application

No additional costs

Renewal fee - “true top-4” approach

Fee equivalent to the cost of patent renewal with Germany, France, UK, and the Netherlands as designated countries

Costs

Table of Court fees

I. Fixed fees (Court of First Instance)

Procedures/actions	Fixed fee
Infringement action [R. 15]	11,000 €
Counterclaim for infringement [R. 53]	11,000 €
Action for declaration of non-infringement [R. 70]	11,000 €
Action for compensation for license of right [R. 80.2]	11,000 €
Application to determine damages [R. 132]	3,000 €

Costs

II. Value-based fees (Court of First Instance and Court of Appeal)

Value of action	additional value-based fee
Up to and including 500,000 €	0 €
Up to and including 750,000 €	2,500 €
Up to and including 1,000,000 €	4,000 €
Up to and including 1,500,000 €	8,000 €
Up to and including 2,000,000 €	13,000 €
Up to and including 3,000,000 €	20,000 €
Up to and including 4,000,000 €	26,000 €
Up to and including 5,000,000 €	32,000 €
Up to and including 6,000,000 €	39,000 €
Up to and including 7,000,000 €	46,000 €
Up to and including 8,000,000 €	52,000 €
Up to and including 9,000,000 €	58,000 €
Up to and including 10,000,000 €	65,000 €
Up to and including 15,000,000 €	75,000 €
Up to and including 20,000,000 €	100,000 €
Up to and including 25,000,000 €	125,000 €
Up to and including 30,000,000 €	150,000 €
Up to and including 50,000,000 €	250,000 €
more than 50,000,000 €	325,000 €

Costs

III. Other procedures and actions (Court of First Instance)

Procedures/actions	Fixed Fee
Revocation action [R. 46]	20,000 €
Counterclaim for revocation [R. 26]	same fee as the infringement action subject to a fee limit of 20,000 €
Application for provisional measures [R. 206.5]	11,000 €
Action against a decision of the European Patent Office [R. 88.3, 97.2]	1,000 €
Application to preserve evidence [R. 192.5]	350 €
Application for an order for inspection [R. 199.2]	350 €
Application for an order to freeze assets [R. 200.2]	1,000 €
Filing a protective letter [R. 207.4]	200 €
Application to prolong the period of a protective letter kept on the register [R. 207.9]	100 €
Application for re-establishment of rights [R. 320.2]	350 €
Application to review a case management order [R. 333.3]	300 €
Application to set aside decision by default [R. 356.2]	1,000 €



Thank you

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Suggested readings

Justine Pila (2022) *Seville's EU IP Law and Policy* (Edward Elgar);

Justine Pila (2013) *The European Patent: An Old and Vexing Problem* (ICLQ 62);

Max Planck Institute for IP and Competition Law (2012) *The Unitary Patent Package: Twelve reasons for concern*;

Aurora Plomer (2015) *A Unitary Patent for a (Dis)United Europe* (IIC);

Tuomas Milly (2017) *Hovering between Intergovernmentalism and Unionization* (CMLR).