

ARTICLE

EPO ANTICIPATES UNITARY PATENT WITH START OF TRANSITIONAL MEASURES

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The European Patent Office ("EPO") has activated these two measures opening up the use of the unitary patent for patent applications ready to be granted, including the request for deferment of grant.

The entry into force of the patent package at European level will allow the advent of a unitary European patent for all Community States, which will also be members of the Unified Patent Court Agreement ("UPCA"), (for the record Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Slovenia and Sweden).

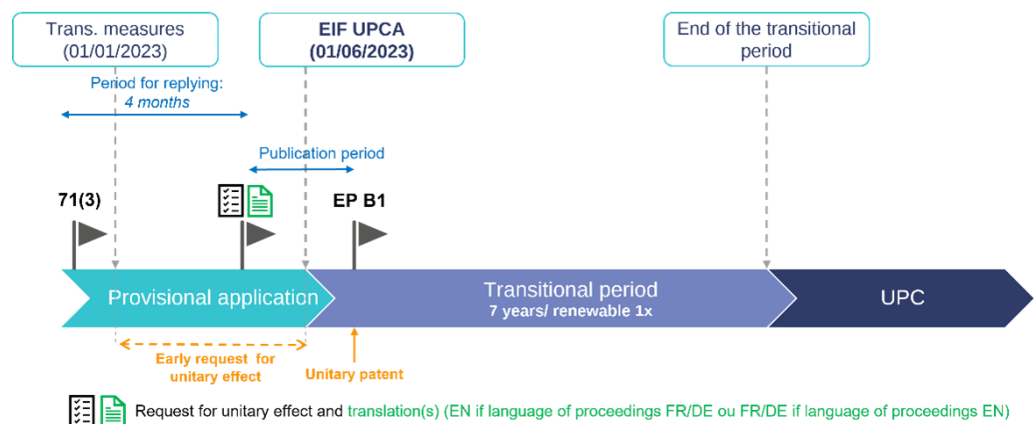
Any European patent granted after the entry into force may then be given unitary effect in the 17 States party to the UPCA, subject to an ad hoc declaration filed within one month of grant. This unitary effect will in particular imply possibilities of cost savings due to annual maintenance fees in the territory covered being lower than the separate annual fees of about 3 to 4 countries in that territory.

This entry into force is announced for 1 June 2023, but in order to take the opportunities of unitary effect now for European patent applications whose grant date is close, whether before or after 1 June 2023, the EPO has introduced two different transitional measures, the **early request for unitary effect** and the **postponement of the date of the decision to grant a European patent**.

The request for early unitary effect

The early application for unitary effect is intended for applicants for whom a grant of patent is expected after the entry into force of the UPCA but who do not wish to wait for the forthcoming grant (and therefore after 1 June 2023) by making an early application for unitary effect.

In addition to the requirements of Rules 5 and 6 of the Rules relating to Unitary Patent Protection (same set of claims for all participating Member States and translation(s) into English if the language of proceedings is German or French and one of these two languages if the language of proceedings is English), two additional conditions must be fulfilled for the application for anticipated unitary effect to be admitted by the EPO, on the one hand the application for early unitary effect must have been filed **after 1 January 2023** (date of entry into force of the EPO transitional measures) and on the other hand, **after the issue of a notification of intention to grant (communication under Rule 71(3) EPC)**. It should be noted that this request for early unitary effect may be filed even though the response to the notification of intention to grant has already been transmitted. The mechanism is illustrated below.



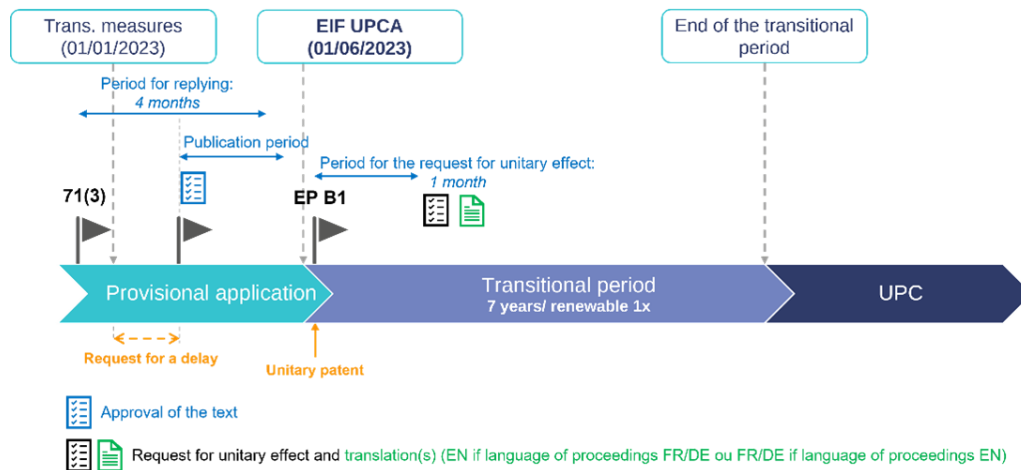
Upon entry into force of the UPC, the EPO will record the unitary effect of the patent and notify the applicant of the date of such recording after publication of the mention of grant in the European Patent Bulletin. If the application contains formal irregularities, the EPO will inform the applicant before the entry into force of the UPC so that he can make corrections.

In practice, the EPO prefers an online application via eOLF or Online filing 2.0. Whether the application is filed online or by post or fax, the use of Form 7000 is also strongly recommended. However, an early request for unitary effect alone does not affect the grant date of a patent. Since a patent granted before the date of entry into force of the UPCA cannot benefit from unitary effect, the anticipated request for unitary effect would therefore be ineffective[1], a request for postponement of the decision to grant a European patent is then necessary. It is in this case, that the second transitional measure introduced by the EPO is of interest.

The request for postponement of the decision to grant a European patent

For European patent applications for which the grant decision would be likely to be issued before the entry into force of the UPCA, applicants may request the postponement of the grant decision so that the mention of the grant is published in the European Patent Bulletin on or immediately after the date of entry into force of the UPCA.

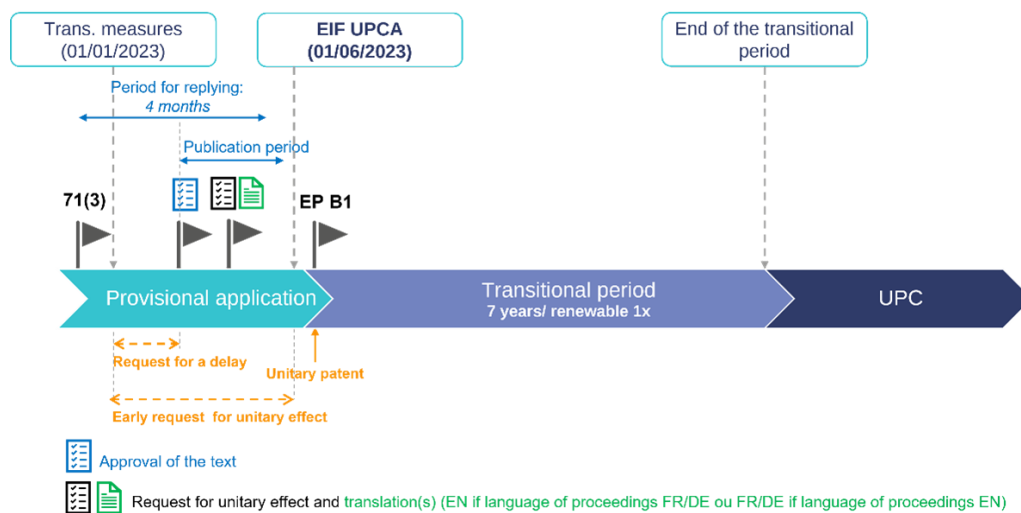
Like the early application for unitary effect, a request for a delay in issuing the decision to grant is **only** admissible **after 1 January** and for patent applications for which a **communication under Rule 71(3) EPC has been issued**. However, the applicant wishing to make use of this measure must **not have approved the text intended for grant or must submit the request for delay on the same date as his approval of the text**. This timing is illustrated by the diagram below



Note that the request for delay of the decision to grant a European patent does not extend the four-month time limit for responding to the notification under Rule 71(3) EPC, so applicants are required to respond while ensuring that they submit their request for delay before or on the date of their agreement on the text.

The request will be made according to the form 2025. In contrast to the early request for unitary effect, the use of the form indicated by the EPO is here a condition for the admission of the request for delay. As such, this deferral of grant does not imply a request for unitary effect. The applicant may thus decide to postpone the granting decision and then allow himself further time to decide whether or not to request unitary effect.

If, however, the same applicant has already decided to request for unitary effect at the time of the request for deferral of the grant, the applicant may apply for it at the same time, with cumulation of provisional measures being possible, as illustrated below:



Do not hesitate to contact us at patents@august-debouzy.com for any additional information or to assist you in these procedures.

[1] The publication of the mention of the grant takes place after a period of four weeks after the issue of the decision to grant the patent. *European Patent Office, CNotice, 25 April 2006, concerning the completion of technical preparations for the publication of European patent specifications, https://archive.epo.org/oj/issues/2006/06/p409_fr.html*