



Dennerg – UP/UPC service offering

2022

Our team of expert speakers



Dr. Mathieu Buchkremer
Patent Engineer
mbuchkremer@dennemeyer-law.com



Dr. Massimo Galluppi
Italian and European
Patent Attorney
mgalluppi@dennemeyer-law.com



Damien Sabathié
Commercial Product
Manager
dsabathie@dennemeyer-law.com

Agenda

- An overview of the upcoming **changes with the UP/UPC**
- Q&A session I
- **Dennemeyer service offering - How we can support you:**
 - **Now:** portfolio audit and strategy
 - **During the Sunrise period:** opt-outs in bulk and early request for unitary effect
 - **Once the system goes live:** an end-to-end digital solution for all UPC services
- Q&A session II

UP / UPC – Main considerations

Current situation

Only a **centralized European patent granting procedure** (before the EPO)

- Leads to a bundle of national patents after the validation procedure



New opportunities... and risks

- 1 translation (for UP),
- 1 renewal (with the EPO),
- 1 specialized court rendering quick decision,
- 1 decision for enforcement in 17 countries,
- low cost for a patent covering 17 countries
BUT
- risk of central revocation
- uncertainty about UPC case law
- costly if usually validate in 4 or less UPC countries
- some key countries not covered by UP
- not possible to let lapse some countries and to renew some others



Unitary Patent

A patent covering simultaneously **all UPC Member States**

- no need for a validation procedure

A pan-European patent enforced in several EU member states at once

Unitary Patent ≠ Unified Patent Court

- **The Unitary Patent (UP)** is an IP right, a patent, an object of property
- **The Unified Patent Court (UPC)** is a patent court with the power to issue decisions on infringement (including preliminary injunctions) and validity of both:
 - “classical” EP validated rights
 - the new Unitary Patent rights (exclusive jurisdiction)

UPC's competence is not limited to the UP!

Geographical coverage

Classic EP (also for extra EU Countries)

Member States of EPO (39)



Source: www.epo.org

39 Member States of EPO + 5 Validation and Extension States (in blue)

EP with Unitary Effect only for EU Countries

17 member states (ratified by start) -> UP in effect

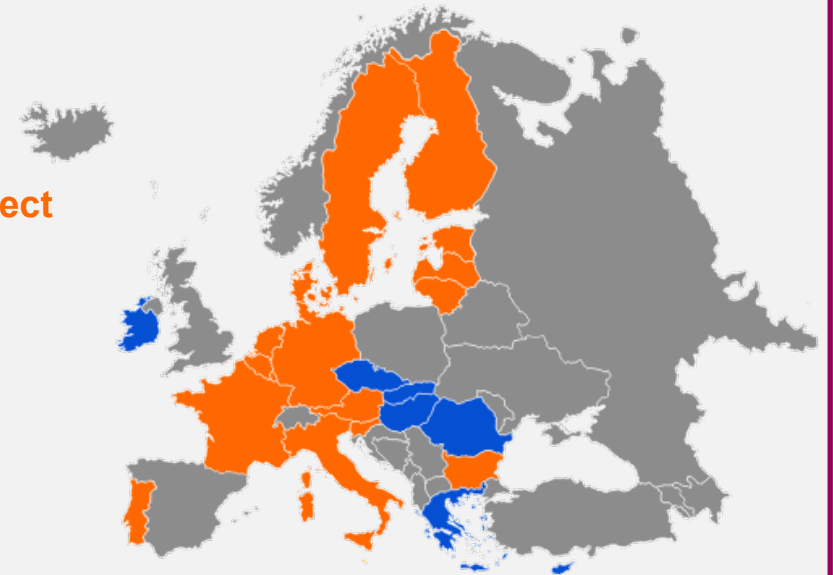
- Austria
- Belgium
- Bulgaria
- Denmark
- Estonia
- Finland
- France
- Germany
- Italy
- Latvia
- Lithuania
- Luxembourg
- Malta
- Netherlands
- Portugal
- Slovenia
- Sweden

7 member states may ratify at a later stage

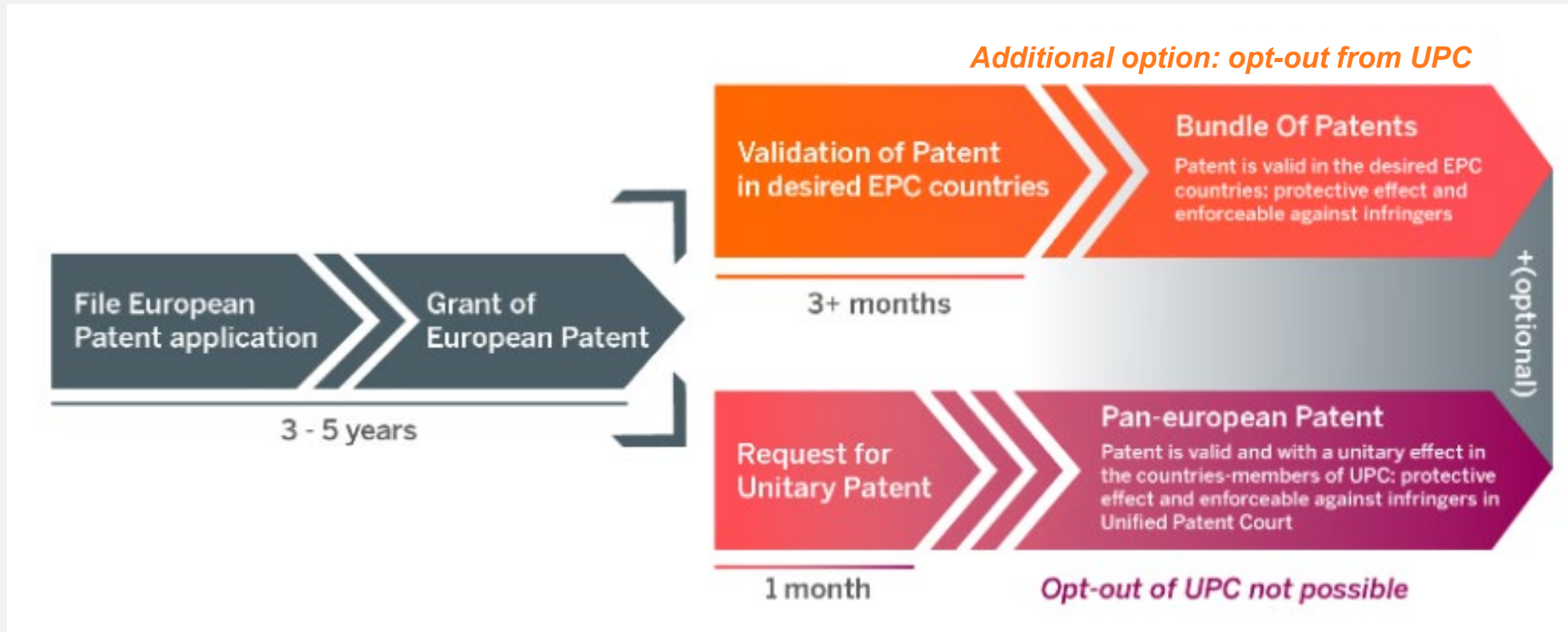
- Cyprus
- Czech Republic
- Greece
- Hungary
- Ireland
- Romania
- Slovakia

3 member states are not part of UPC agreement

- Spain
- Poland
- Croatia



Unitary Patent System and UPC the available options

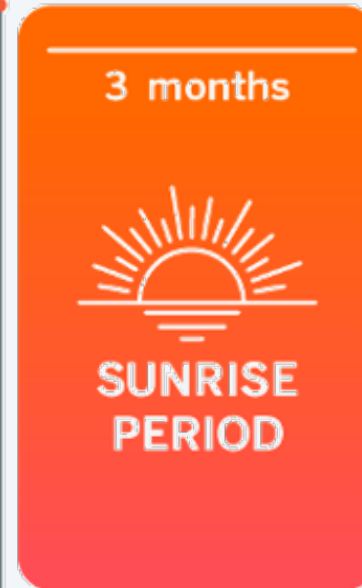


A combination of both options is possible

START

January 1 March 1, 2023

Germany will trigger
the start of the
Sunrise Period



April 1 June 1, 2023

Simultaneous start of



Unitary Patent



Unified Patent Court

**2 transitional
measures** as of Jan. 1

- Delay of the grant
- Early request for UP

Opt-out possible

Transitional period (7Y+7Y)

- UPC and national court have shared jurisdiction for classical EP patents

Opt out from the UPC

WHAT'S

an opt out?

It is an administrative procedure to **remove a given EP family from the jurisdiction of the UPC**.

What can be opted out?

- Any published European patent application
- Any granted European patent

WHY

to opt out?

Avoid the risk of a central revocation
(rather than several national actions
before each relevant national court).

Possibility to "opt back in" once

WHEN


to opt out?

The safest is to opt-out
during the Sunrise period
(avoid any action to be placed before
the UPC).

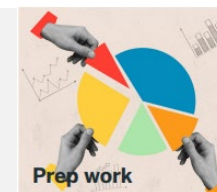
However, opt-outs will be possible
during the whole transitional period
(7 to 14 years).



The opt-out is filed once for the whole EP family. No official fee is charged.

The background of the slide features a stylized sunburst design. Numerous orange rays of varying lengths radiate from the left side towards the right. In the upper-left quadrant, there is a large, solid orange speech bubble with a small tail pointing towards the bottom-left. Inside this bubble, the text "Any questions about the new system?" is written in a bold, dark blue, sans-serif font.

**Any questions
about the new
system?**



Some prep' work

TIMELINE: Pre-Sunrise Period i.e., from Now to March 1, 2023

Data Ownership Audit

Only the owner of a European patent (EP) or supplementary protection certificate (SPC), or their representative, can validly file an opt-out request.

Our Records department

will check the owners of the patents listed on the European or national registers against your own data.

If necessary, this can be followed by an update of the patent register(s) via a Recordal project.

Strategic consultancy

Not having a clear strategy in place to take advantage of the new system and all the options available carries risks:

- loss of strategic assets through central revocation
- unnecessary expenses
- loss of competitiveness, etc.

Our European Patent Attorneys will help you define a suitable and balanced strategy that takes all factors into account. We review the importance of the patent in question, the risk of central revocation, the financial means available and the potential costs when making our recommendations.

The first half hour is for free!

+ Our attorneys also offer freedom-to-operate searches, analyses and opinions to minimize your risk exposure and assist you in selecting the best approach

Our Bulk opt-out service

TIMELINE: During Sunrise Period from March 1 to May 31, 2023

General

- Our **integration with the official UPC API** allows our UPC team to quickly submit on our Clients' behalf **hundreds of opt-out** requests to the UPC **with just a few clicks**.
- Dennemeyer **dockets and keeps track of all opt-outs** performed on your behalf in its IPMS
- **A dedicated European patent Attorney** supervise your bulk opt-out project
- **Predictable economical pricing** – obtain a quote based on volume of EP families to opt-out

Patent renewal clients

- Use our **Portfolio Management App** to easily select the **EP families you want to opt out** and request a cost estimate.

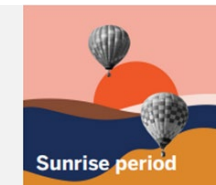
All existing clients

- Benefit from our bulk opt-out **discount of -5%** during the sunrise period.



DIAMS iQ clients

- Our **DIAMS iQ customers** will be able to benefit from **new features** integrated in the IP Management System allowing them to perform their own **opt-outs in a few clicks and free of charge**.



Bulk Opt-out - What do we need from you?

The requested information and documents to perform the Opt-outs in bulk

1. **The number of EP families** (or SPC) you want to opt out
→ We provide you with a price.
2. An Excel document with **the details of the EP families to opt out** following a certain format
→ This is a must for the migration of data from our IPMS to the UPC Customer Management System to work properly.
3. **A Mandate pre-filled by our care** with the cases to opt out + **An Engagement Letter (incl. a Quote)** is sent for your execution
→ These are legal and contractual requirements.
4. Upon receipt of the executed Mandate and EL
→ **We are good to go!**

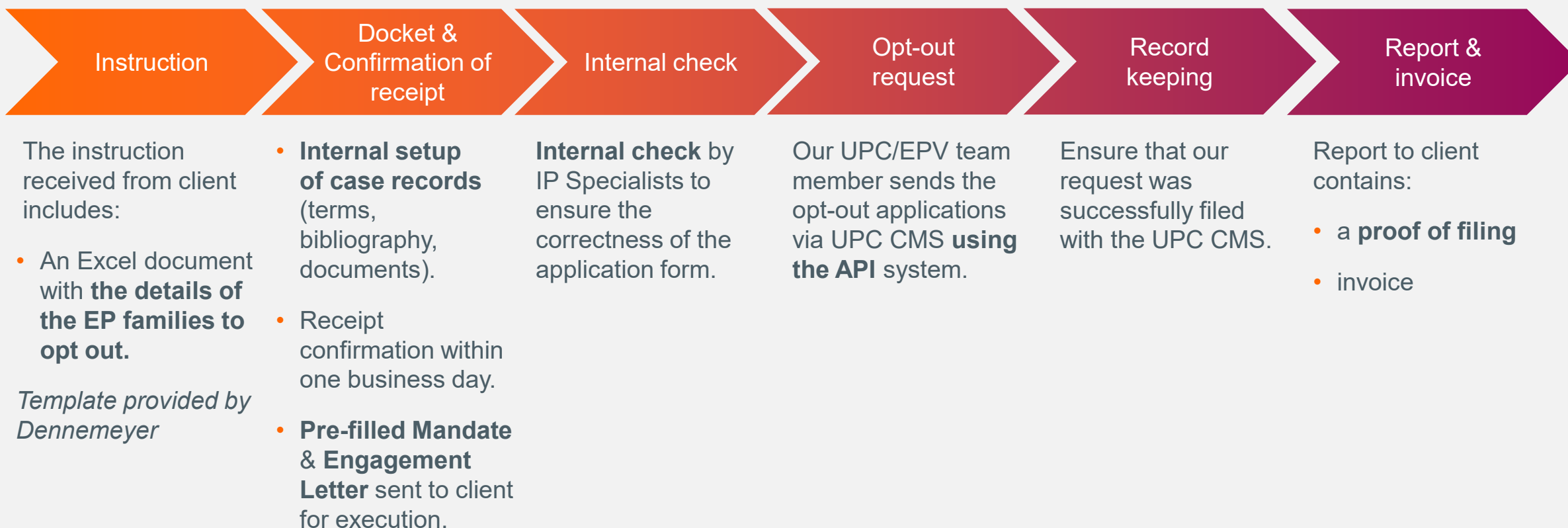


We provide you with the templates of all required documents.



Our process for the UPC bulk opt-out service

Our UPC/EPV department handles client's instructions and performs the service



The whole process is supervised by an experienced European Patent Attorney



Ancillary services

We provide all UPC services available during the Sunrise Period

Request a delay in issuing the grant of a European patent (Rule 71(3) EPC)

Ensure that the unitary effect of your EP patent shall be registered on day 1 of the UPC.

Request early unitary effect

Ensure that the unitary effect of your EP shall be required before the UPC starts

Monitoring

The fact that some competitors choose to opt out some of their patents rather than others reveals that they are of particular importance to them. We check this for you.



Whatever your strategy, our teams led by our EP Attorneys have the means to support you.

Once the UP/UPC goes live



An end-to-end digital solution

TIMELINE: Once the UP/UPC goes live in June 2023

Digital solutions for all UPC and EP validation services

Via our UPC-EPV App the Client will be able to obtain a quote and place an order for:

- Single opt-outs
- Classic EP validations
- UP applications
- All related translations

A screenshot of the Denneweyer EPV App interface. The top navigation bar includes the Denneweyer logo and links for "EP Validations", "Get estimate", "My cases", "My company cases", and "Administration". The main content area is titled "Cost estimate" and features a "Drag and drop countries one by one or use quick select" section. Under "By geographical region", there is a "European Patent Convention countries" list with options for Albania, Serbia and Montenegro, Croatia, Cyprus, Czech Republic, Greece, Hungary, and Ireland, each with a price in EUR. To the right, a "Your budget" slider is set to 10000 EUR, and a "Sort by" dropdown is set to "A-Z". Below this is a table with columns for "Country", "Denneweyer ...", "Agent fee, EUR", "Official fee, E...", "Translation fee, EUR", and "Total, EUR". The table shows a single entry for "Italy (Patent/Italian)". At the bottom right, there are buttons for "Save estimate" and "Place your order".

**One portal for all UPC/EPV services → Denneweyer provides an end-to-end digital solution.
These new features will be presented during our second webinar next January!**

Thank you, for your attention!

Do you have any questions?

Contact the EPV / UPC team!
We are always happy to help

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