

The European patent blocked outside the jurisdiction of the Unified Patent Court after the transitional period of Article 83: "PhantomPatent" or "GhostPatent"?¹

Announced several years ago², the creation of the Unified Patent Court will profoundly modify patent invalidity and infringement actions. While a **transitional period** and the **possibility of derogating from the jurisdiction** of this new court would reassure **patent users**, do these solutions not risk leading to phantom patents?

1. Within a few months, users of patent law will have to make choices:
 - to apply to the European Patent Office for **the grant of a unitary patent** or to limit itself to European patents as we know them today,
 - and **whether or not to waive the jurisdiction of the Unified Patent Court** for European patents and their applications.
2. A priori, would the choice of one command the choice of the other since it is not possible to derogate from the competence of the Unified Patent Court for unitary patents? Such an approach would considerably reduce the stakes of these issues for the users of patents, which must be measured per invention and not globally per owner.
3. **There is therefore no imperative link** between the answer to either of these questions. Let us limit ourselves here to the situation of European patents which have been the subject of a waiver of jurisdiction by the Unified Patent Court.

1. DURING THE TRANSITIONAL PERIOD, THERE WILL BE COMPETITION BETWEEN THE UNIFIED PATENT COURT AND THE NATIONAL COURTS IN ACTIONS FOR INVALIDITY AND INFRINGEMENT OF EUROPEAN PATENTS.

4. While the Unified Patent Court has been given exclusive jurisdiction over certain actions relating to unitary patents, European patents and their applications, and supplementary protection certificates, national courts retain jurisdiction over other actions. **But it is not these other actions³ that are at issue here.**

¹ Subject to some modifications, this is the article published on 27 January 2023 on the Village of Justice website: [*JUB: what real effects to the European patent blocked by opt-out?*](#)

² See 2013 article, [*Most European innovation to be protected by Unified Jurisdiction created with unitary patent*](#)

³ Provided for in Article 32, 1 of the Unified Patent Jurisdiction Agreement.

5. The implementation of the Unified Patent Court will indeed start with a **so-called transitional period** as regards its competence⁴ .
6. **Concurrently with the exclusive jurisdiction of the Unified Patent Court**, it will still be possible during this transitional period to **bring an action for infringement or invalidity of** a European patent or a supplementary protection certificate on the basis of a European patent before the national courts or authorities which until now have had exclusive jurisdiction⁵.
7. The so-called transitional period has an initial duration of 7 years from the date of entry into force of the Unified Patent Court , which may be extended once for a maximum of 7 years⁶ .
8. At most, this transitional period could therefore last 14 years, but currently the duration of this transitional period of competition of competences is limited to **7 years**.

2. THE COMPETENT COURT DURING THE TRANSITIONAL PERIOD IN CASE OF AN OPT-OUT.

9. During this transitional period and a Sunrise period, the proprietor of a European patent application or a European patent granted or expired⁷ may **waive the exclusive jurisdiction of** the Unified Patent Court , this waiver is generally referred to as the opt-out⁸ .
10. Subject to the respective perimeters of invalidity and infringement actions within the meaning of the Unified Patent Court and the competent national courts or authorities in the States acceding to the Agreement⁹ , during the transitional period, the jurisdiction of invalidity and infringement actions shall be distributed as follows:

⁴ Three months before this entry into force a so-called Sunrise period will have started for the JUB registry, the European Patent Office for its part has also foreseen measures allowing to postpone the granting of patent applications for unitary patents.

⁵ Article 83, 1 of the AJUB.

⁶ Article 83, 5 of the AJUB

⁷ Rule 5 of the Rules of Procedure of the Unified Patent Court.

⁸ Article 83, 3 of the English version of the AJUB.

⁹ Also to be combined with the international jurisdiction of this new court, Article 31 of the AJUB.

- **Unitary patents:** these actions remain subject to the exclusive jurisdiction of the Unified Patent Court.
- **European patents in force or expired and their published applications, and supplementary protection certificates based on a European patent** :
 - **Except in the case of an opt-out:** these actions will be brought before the Unified Patent Court or before the national courts and authorities which have hitherto had jurisdiction.
 - **Opt-out cases:** these actions will remain within the sole jurisdiction of national courts and authorities.

3. THE SITUATION OF THE TITLE BLOCKED OUTSIDE THE UNIFIED PATENT COURT AFTER THE TRANSITIONAL PERIOD.

11. Of course, the Agreement provides for **the possibility of withdrawing this waiver**, i.e. the owner of the title may again place it under the jurisdiction of the Unified Patent Court, this possibility is referred to as the opt-in¹⁰ .
12. However, **reasons must be given for this withdrawal, which is not the case for the opt-out request**. To date, the conditions of this reasoning are not sufficiently described¹¹ , Consequently, we do not know whether the possibility of this withdrawal will be limited or not only to cases of illicit or abusive opt-out.
13. In addition to this **uncertainty** about the reasons for withdrawal, there is also uncertainty about the **date of withdrawal**. The possibility of withdrawal after the transitional period is not explicitly provided for¹² .
14. At least one situation **precludes the possibility of such a withdrawal**, the bringing of an action on this title before a national court.
15. However, at the end of the transitional period, **the competition of competences** between the national courts and authorities and the Unified Patent Court **will cease in favour** of the latter.

¹⁰ ." The withdrawal of the opt-out" in Article 83, 4 of the English version.

¹¹ In Rule 5A, only « *an unauthorised Application to opt out or withdrawal of the opt-out from the Registry setting out the reasons* » are envisaged.

¹² It is true that "*at any time*" is indicated, but this is in point 4 of Article 83 entitled "*Transitional regime*" in Part IV "*Transitional provisions*".

16. **Will the end of the transitional period be the end of the effects of the opt-out?**

- Either the end of the transitional period will automatically lead to the end of any opt-out, but **this hypothesis finds no support** in the Agreement or in the procedural rules. Such automatism would appear to be out of all proportion to the motivation expected in the case of a request for withdrawal, and would be contrary to the blocking in the case of national action.
- That is, at the end of the transitional period, all the national courts and authorities of the States adhering to the Agreement having lost their jurisdiction over these titles, **all the titles still subject to the opt-out will no longer be able to be the subject of an invalidity or infringement action!**

17. This second hypothesis, surprising as it is, would place this patent blocked outside the Unified Patent Court as a **ghost patent**.

18. But we are not yet at the stage of creating a new category of patents, this situation will only become apparent at the end of the transitional period or perhaps in 5 years' time when the Administrative Committee of the Unified Patent Court decides to extend **the duration of the transitional period, or until the conditions for the motivation of the withdrawal or renunciation are clarified**. Until then, these **phantom patents** will be "*PhantomPatents*".

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