

4th Annual HBCU Tech Law Summit  
&  
19th Annual IP and Social Justice CLE Seminar

**Session A: The Unified Patent Court: Strengthening the Global Patent System**



**DEVON GRANT**



**DIEGO BLACK**



**BRIANNA KADJO**



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## **Devon Grant**

Devon Grant is Senior Patent Counsel and a member of Global Intellectual Property team at Visa. Devon previously worked as in-house patent counsel at TomTom, Cisco Systems and Sun Microsystems. Devon also worked as an associate for several law firms, where he drafted and prosecuted US and international patent applications related to electronics, semiconductor, telecommunications, and computer software. Prior to attending law school, Devon worked as an engineer for Lockheed Martin.

Devon received his J.D. from the Howard University School of Law, and a B.S. in Electrical Engineering from the Georgia Institute of Technology.

## **Diego Black**

Diego is a UK and European patent attorney at Withers & Rogers. He is a Partner in their Electronics, Computing and Physics practice group. He specialises in Computer Implemented Inventions – he has a particular interest in machine learning and automotive software – from in car connectivity to vehicle autonomy.

## **Brianna L. Kadjo**

Brianna Kadjo has an extensive background in litigation with a focus on patent litigation. Brianna has experience deposing fact witnesses; drafting and revising claim construction briefs; and drafting petitions and responses for inter partes review proceedings. She has also drafted office actions for ex parte reexamination, discovery responses, invalidity/non-infringement claim charts and motions.

Brianna has predominately defended parties against NPEs in small (6 patents) and very large (32 patents) cases. Most notably, in addition to drafting claim construction briefs and expert declarations, she developed the construction for a dispositive term during claim construction proceedings and won a favorable construction. She has also argued at a Markman and won. When it comes to specific discovery issues regarding NPEs, Brianna has successfully moved to compel information regarding the NPE's investors and patent valuation at the time of purchase.

Brianna's work has covered a wide range of technologies, including computer systems and software, LEDs, telecommunications and wireless communications, video processing, pharmaceuticals, rare-earth magnets, semiconductors and radio-frequency identification (RFID).

Brianna's pro bono work includes representing a pro se inventor in settlement negotiations, drafting an amicus curiae brief for a nonprofit organization and representing domestic violence victims in restraining order cases.

While earning her J.D. at American University Washington College of Law, Brianna was a legal intern for the U.S. International Trade Commission and a judicial intern for the late Honorable Judge John J. Thomas of the U.S. Bankruptcy Court for the Middle District of Pennsylvania.

Prior to law school, Brianna worked as a FAB engineer in the semiconductor industry, specifically working on cost measures and quality control in the oxide CMP process.



## Recap of existing system for European Patents



### Pre-grant

- Single patent office (EPO). Not a European Union (EU) institution
- Single EP application with central examination and granting process

### Post Grant

- EP patent must be validated nationally for each country of interest
- National validations of EP have to each be enforced through separate national courts
- Options for national validations include all EU countries and many non-EU countries



## Overview of the Unitary Patent Package (UPP)

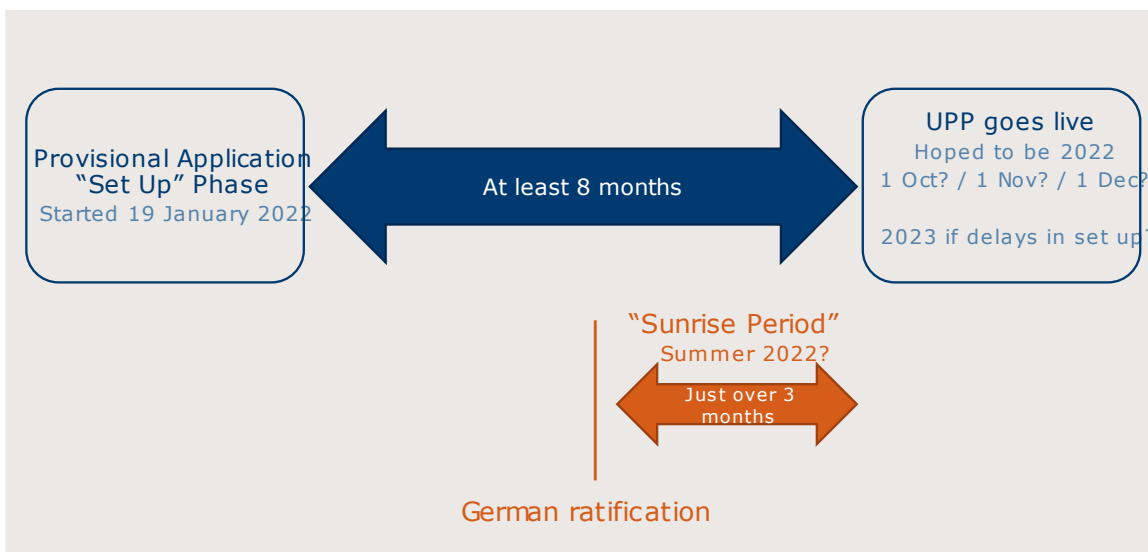
A new patent right - the Unitary Patent (UP)

- A European Union (EU) initiative
- The UP will not cover non-EU countries

A new patent court - the Unified Patent Court (UPC)

- The UPC is for litigating UPs
- The UPC is also for litigating traditional EPs (i.e. EPs validated nationally) in the relevant countries
- For EPs, opt-out provisions will exist for at least 7 years, and up to 14 years

## Timeline





## The Unitary Patent: Coverage & Features

Single patent right covering the most of the EU\*:

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

\* Other countries will join later likely including Ireland, Romania and Greece. Spain and Poland have yet to sign up.

Single patent right covering the EU's single market:

- >300 million people
- >US\$13 trillion GDP



## Coverage of European and Unitary patents



Current coverage of national validations of European patents

38 Member States + 2 Extension States + 4 Validation States



Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Monaco, Netherlands, North Macedonia, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, United Kingdom, Bosnia and Herzegovina, Montenegro, Morocco, Republic of Moldova, Tunisia, Cambodia

First generation unitary patents

17 States



Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Monaco, Netherlands, North Macedonia, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, United Kingdom, Bosnia and Herzegovina, Montenegro, Morocco, Republic of Moldova, Tunisia, Cambodia

Future Unitary patents potential coverage

25 States



Albania, Austria, Belgium, Bulgaria, Croatia, Cyprus, Czech Republic, Denmark, Estonia, Finland, France, Germany, Greece, Hungary, Iceland, Ireland, Italy, Latvia, Liechtenstein, Lithuania, Luxembourg, Malta, Monaco, Netherlands, North Macedonia, Norway, Poland, Portugal, Romania, San Marino, Serbia, Slovakia, Slovenia, Spain, Sweden, Switzerland, Turkey, United Kingdom, Bosnia and Herzegovina, Montenegro, Morocco, Republic of Moldova, Tunisia, Cambodia

Source: <https://www.epo.org/law-practice/unitary/unitary-patent.html>

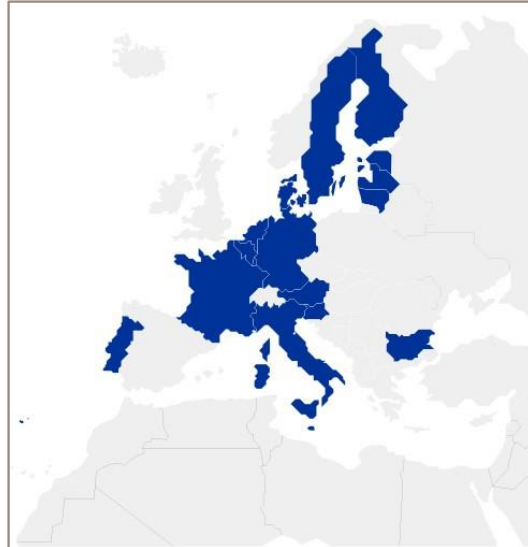


## The Unitary Patent: Coverage & Features



Can licence country-by-country

**Cannot** assign country-by-country



## The Unitary Patent: Procedure



- The procedures for obtaining a Unitary Patent and a conventional European Patent are procedurally indistinguishable until grant
- A request for unitary effect must be filed at the EPO with one month of the publication of the notice of grant
- Any EP application can become a UP after “go live”
- A Unitary Patent can be obtained alongside national validations outside the 17 countries (so you can for example obtain a UP, UK and Spanish patent from same EP application)



## The Unitary Patent: Filing, Prosecution and Grant Costs

- Filing fee – same as EP
- Prosecution fees – same as EP
- Grant and printing fee – same as EP
- No “registration or validation” fee

so, taking EP validation costs into account, obtaining a UP can be much cheaper than obtaining EP validations – but this depends on the number of countries in which you normally validate, and there's one catch...



## The Unitary Patent: Post-Grant Translations

- The aim is to eventually forgo the filing of translations, and have each UP translated using a machine translator being developed by Google and the EPO
- Technology isn't ready just yet
- Initially, and for at least 6 years, applicants will be required to file the following translation with their request for unitary effect
  - a full translation of the application into English if proceedings before the EPO were in French or German, or
  - a full translation of the application into “any other official language of the Union” if proceedings were in English
- This requirement will be ongoing until such time as the EPO deem the quality of the machine translations to be adequate

translations into “any other official language of the Union” cost between £900 and £3000, depending on the language



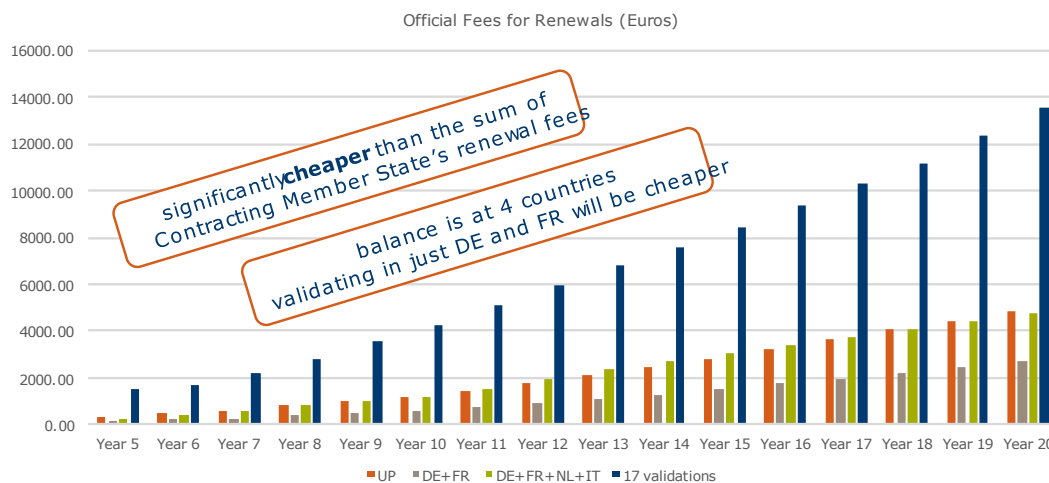
## The Unitary Patent: Renewal fees

Cutting a very long story short the "True Top 4 model" was agreed- with the UP renewal fee for a particular year being based on the sum total of renewal fees for France, Germany, the Netherlands and the UK for that same year. This has not changed with the UK's exit.

Provision for licences of right (15%).



## The Unitary Patent: Renewal Fee Comparison





## The Unified Patent Court: Locations

- Single patent right covering 17 countries of the European Union
- Central Division
  - Electronics and software Paris (Seat)
  - Mechanical- Munich
  - Life sciences & chemistry???
- Local Divisions
  - Any participating Contracting Member State can create up to four Local Divisions: *Düsseldorf, Munich, Mannheim, Hamburg, Paris* Possibly also *The Hague, Brussels, Milan, Helsinki, Copenhagen, Vienna, Ljubljana...*
- Regional Divisions
  - Two or more participating countries can group together to create a Regional Division: *“Nordic-Baltic” Division (Sweden, Lithuania, Estonia & Latvia) in Stockholm*
- Court of Appeal
  - Luxembourg



## The UPC: Forum Shopping

In infringement actions the claimant will hold the cards

Which Local/Regional or Central?

- Any CMS in which the infringement occurred, or in which the defendant is based
- Claimant can choose Central Division if no Local/Regional Division exists (e.g. Malta or Luxembourg) where infringement occurred

Which language?

- Usually enough choice of Local/Regional/Central Division to use English if required

“Rocket dockets”?

- This would happen if local judges in, for example, Germany started to be particularly patentee friendly
- The powers of the President of the Court of First Instance can control Local Division panels with three legally qualified judges from the CMS pool only restricted by nationality



## The UPC: A Flavour of the Rules of Procedure

### Front-Loaded

- Comprehensive written submissions prior to hearing and likely limitations in presenting new facts or arguments at late stage

### Actively Managed

- Extensive and proactive case management by the presiding judge

### Expeditious

- It is intended that a final hearing take place within **1 year** of the claim being filed, and the presiding judge will endeavor to complete the oral hearing within **one day**
- Whilst both disclosure/discovery and cross-examination of witnesses are potentially available (unlike some present continental systems), the judge has discretion in ordering either



## Understanding the Transitional Period and Opt -Out

### Background

- Long term aim for both UPs and EP validations to come under jurisdiction of UP Court only
- Jurisdiction will only apply to UP states

### Effect

- For UPs– UPC will always have exclusive jurisdiction
- During transitional period EP validations can be litigated before UPC or national courts
- Transitional period was created to allay concerns about an untested court

### Duration

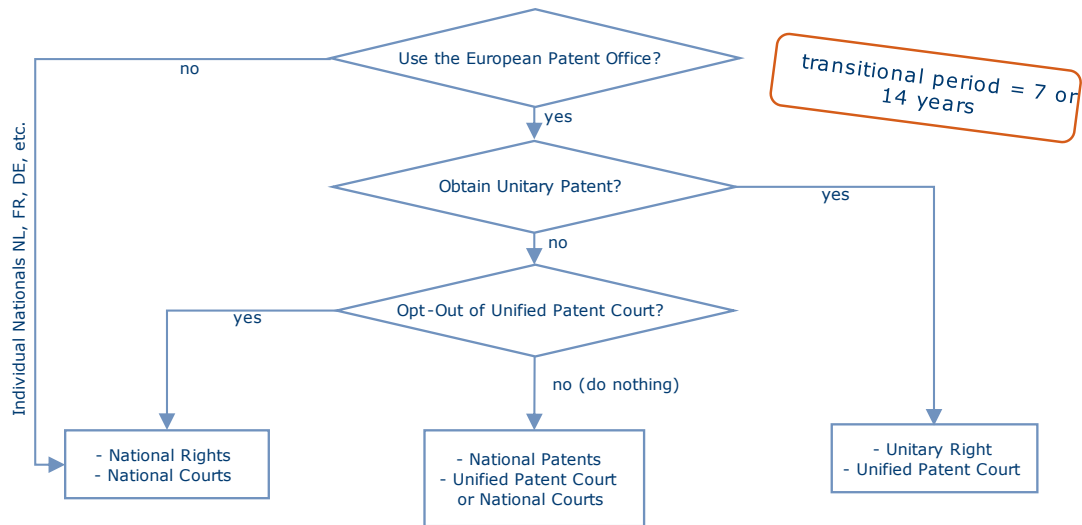
- 7 years
- Applies to EP validations in UP states (NOT UPs)
- Can be extended to 14 years

### Opt-out

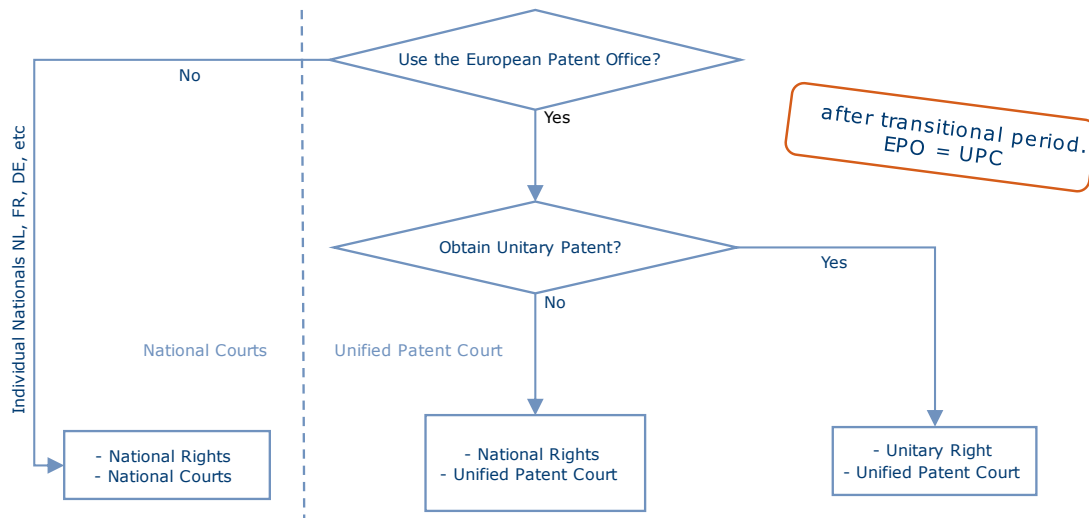
- Can only be filed during 7- 14 year transitional period
- Results in complete exclusion from jurisdiction of UPC for that Patent
- Exclusion from jurisdiction lasts for the for life of the Patent



## Transitional Period: Three Questions



## Post-Transitional Period: Two Questions



## Summary of Strategic Considerations: The Unitary Patent



### Pros

- Single right for large market
- Much cheaper than same geographical coverage via EPs

### Cons

- Single point of failure
- Cannot assign on a country-by-country basis

## Summary of Strategic Considerations: Opting -Out



### Pros

- Avoid central attack (though EPO opposition for recently granted cases)
- Avoid the possibility of a wobbly start to UPC?

### Cons

- Can be locked out of UPC
  - Can't get a pan-European injunction
  - Can't get pan-European damages
- Can never refer a favourable decision of one of the 17 national courts to the UPC



## Summary of Strategic Considerations: Opting -Out

There is no one size fits all approach to opting out, though there are a few things to consider:

	Defensive Strategy	Offensive Strategy
Commercial relevance of the Patent	If you have good licencing revenue or the deterrent effect of the patent is working (i.e. acting as a great barrier to entry), then avoid central attack and optout, thereby spreading the risk of invalidation across multiple national rights	If infringers are not being deterred go for the mighty pannational injunction and damages from large market
Strength of the Patent	If your patent is weak, then it may also be desirable to avoid the threat of central attack and optout, allowing you to keep some bargaining chips in the event of a national invalidation	If your patent is strong you could optout until ready to bring an action for infringement, and then withdraw the optout – but beware of competitors bringing DNI and revocation actions in national courts and blocking their withdrawal!
Technology	If your patent is in a field in which its common to file EPO oppositions and to “clear the way” consider optout	If contributory infringement may be relevant to your patent’s claims consider use of UPC

Competitor Intelligence competitor may analyse each other’s portfolios to determine which patents

Why not file a divisional and get the best of both worlds?



## “Sunrise” Period

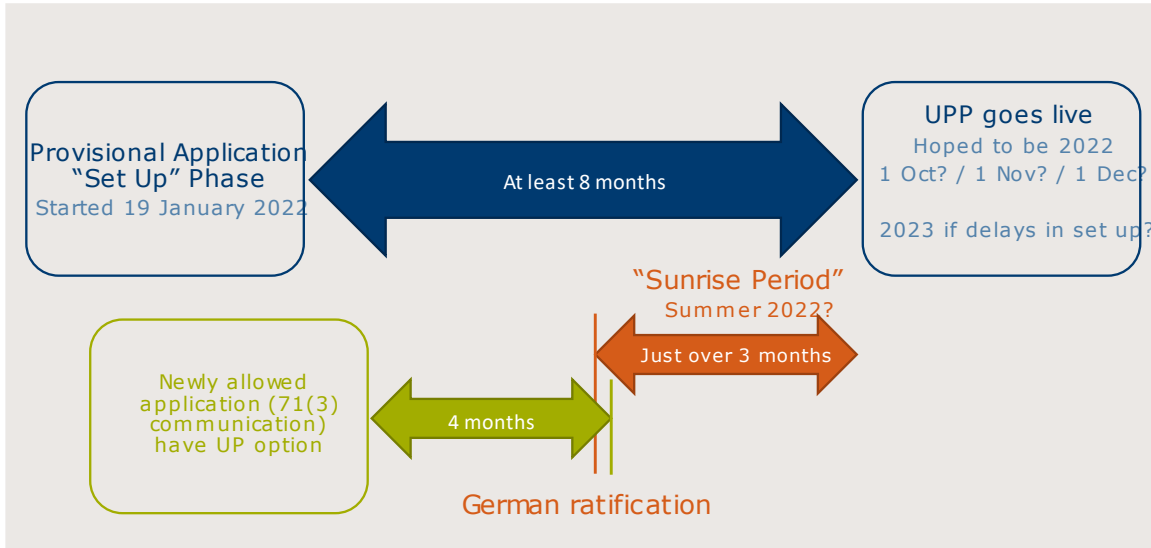
**Starts 3 -4 months before UPP goes live, triggered by Germany depositing ratification (currently expected in Summer 2022)**

### Has at least 4 effects:

- Means that the “go live” date of UPP becomes legally certain
- Opt-outs can be filed:
  - These will take effect when the sunrise period finishes and the UPP is in operation
- UP requests can be filed:
  - These will take effect when the sunrise period finishes and the UPP is in operation provided grant does not occur before then
- New EPO procedure for deferring grant in the Sunrise period:
  - Defers grant until the end of the Sunrise period and UPP system is operational provided text intended for grant has been approved before Sunrise period begins



## Timeline



Any questions?



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