



Proposal for Best Patent Filing/Prosecution Strategy in Europe in View of UP/UPC/BREXIT - State of Considerations December 5, 2017

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The present situation and status, resp., of the EU Patent Package is described e.g. in an article of Klaus Haft "The Unitary Patent System from an SME Perspective", published in Les Nouvelles, Volume LII No. 4, December 2017, pp. 274 ff.

As far as foreseeable in early December 2017, from the viewpoint of the author of this brief "guidance" it is unclear when, and possibly even whether at all, the Patent Package will come into force. The reason: As rumors say, a comment of the German government requested by the German Constitutional Court (GCC) concerning a complaint pending against the constitutionality of the Package in Germany will only be given in spring 2018. Then, GCC might take until about end 2018 to come to a decision how to handle the aforementioned complaint. The complaint has, as generally known, led to the stopping of the ratification process of the Package in Germany. If that "decision" results by GCC to the Court of Justice to the European Union (CJEU), the procedure there might take another 2 - 3 years.

All this might mean that the Package might come into force only in 2022 – 2024, if at all.

In view of all these uncertainties, numerous patent applicants, according to what the author of this paper has heard, presently use the following filing strategy for Europe:

1. Tier 1 inventions: EPC application with parallel national German patent application, the latter filed, if EPC application in English, also in English, with filing of translation (machine only?) postponed as long as possible and request for examination equally postponed up to 7 years from effective filing date in/for Germany.
2. Tier 2 inventions: Filing EPC only, but filing divisional just before patent grant, opting out after patent grant "main" patent and leaving divisional in prosecution, deciding only at grant time of the latter whether to file another divisional, opting out, etc..
3. Tier 3 inventions: Filing national patent application in Germany only, trusting on the decisive/persuasive influence of a possible later German patent litigation for the whole of Europe, knowing that presently about 80% of all patent litigation cases in Europe are filed in Germany, with only about 5 - 10% of cases having parallels in other EU countries.

It should be duly noted that the above mentioned described scenario/recommendation might quickly change beyond the basis of discussion as available in early December 2017, so that this paper should not be misunderstood as having any prophetic, even less, of course, "binding" character.

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