



PATENT- UND RECHTSANWÄLTE

Case law update – The UPC has been busy over the last year. What have we learned so far?

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Pierre Véron: “UPC is off to an excellent start”

Interview 31 May 2024 by Christina Schulze, www.juve-patent.com



“I am happy to say that I think the UPC is off to an excellent start. The judges are enthusiastic. They like working in this international context and they are keen to keep the promise to deliver judgments in about a year’s time. The months of June and July 2024 are likely to be busy for observers, as we begin to read the first decisions on the merits of the cases filed when the court opened its doors. **I am sure they will not disappoint because the judges are excellent. Although not all the excellent patent judges are in the UPC, all those who are in the UPC are excellent. They give very good decisions.** I read almost all the decisions. So far I haven’t said, “Oh, how stupid is this decision!” I have read one or two decisions where I personally would have taken a different position, but I understand the position that has been taken by the judges.

Expectations of the EU Commission: Low uptake: 7 cases in the first year
High uptake: 123 cases in the first year”

UPC News Caseload update end of May 2024: **Since the Court’s start of operations on 1 June 2023, the Court of First Instance has received a total number of 373 cases.**



By way of comparison, the **European Patent Office building** in Munich, now known as the Isar building, was designed to give the possibility to handle **40,000 patent applications a year**. However, there were a number of experts who doubted that the EPO would ever receive that many applications per year.

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 **What are we talking about?**
EPO Statistics 

Granted Patents



	2017	2018	2019	2020	2021	2022	2023
Granted Patents	99,721	107,822	133,714	137,603	129,123	102,263	104,609
Opposed	3,647	3,416	3,673	3,247	3,192	2,432	
Percentage	4.0	3.7	3.2	2.7	2.4	2.5	

Opt-out requests and Unitary Patents

	2023	01-05/2024
Opt-out requests	535,152	
Patents with Unitary Effect	17,258 = 17,5 %	10,408 = 24,0 %

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 **What are we talking about?**
UPC – Actions filed from 1 June 2023 to 31 May 2024 

	Central Division		Local and Regional Divisions													Total
	Paris	Munich	Munich	Düsseldorf	Mannheim	Hamburg	Nord. Baltic RD	Milan	The Hague	Brussels	Helsinki	Copenhagen	Lisbon	Ljubljana	Vienna	
Infringement	1		54	25	16	7	6	4	4	1	1	1				134
Application for provisional measures		13		5	4				3						1	26
Revocation	35	4														39
Counterclaims for revocation	2	1	74	14	26	12	11	1	3							165

The 165 counterclaims for revocation have been filed in 63 infringement cases – Unofficially: In 10 cases, EPO opposition and UPC revocation proceedings run in parallel.

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 **Competence of the Court**

Are there inconsistencies? – Kluwer Patent Blog 2 May 2024

Art. 83 (1) UPCA	“During a transitional period of seven years (...), an action for infringement or for revocation of a European patent (...) may still be brought before national courts or other competent national authorities.”
Art. 83 (3) UPCA	“Unless an action has already been brought before the Court , a proprietor of or an Applicant for a European patent (...) shall have the possibility to opt out from the exclusive competence of the Court.”
Art. 83 (4) UPCA	“Unless an action has already been brought before a national court , proprietors of or Applicants for European patents (...) who made use of the opt-out in accordance with paragraph 3 shall be entitled to withdraw their opt-out at any moment . In this event they shall notify the Registry accordingly. The withdrawal of the opt-out shall take effect upon its entry into the register.”
Decision of the LD Vienna of 13 Sep. 2023 (UPC_CFI_182/2023)	Facts: On 27 June 2023, the Applicant brought an application for provisional measures before the LD Vienna. On 6 July 2023, the Applicant requested an opt-out. Decision: The opt-out of 6 July 2023 is invalid (see Rule 5.6 RoP). The LD Vienna of the UPC remains competent to decide. Decision is in compliance with Art. 83 (4) UPCA and Rule 5.6 RoP.

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 **Competence of the Court - Decisions**

Are there inconsistencies?

Decision of the LD Helsinki of 13 Sep 2023 (UPC_CFI_182/2023)	Facts: On 12 May 2023, the Applicant opted out the patent in suit and withdrew the opt-out on 5 July 2023. On 14 July 2023, the Applicant brought an application for provisional measures before the LD Helsinki. At the same time, both infringement proceedings and revocation proceedings were pending before national courts in Germany. Decision: In application of Article 83 (4) UPCA, the withdrawal of the opt-out on 5 July 2023 (...) following the opt-out lodged on 12 May 2023 is ineffective due to the national infringement and invalidity proceedings brought before the German national courts. Hence, the opt-out for the patent in suit is effective and the UPC lacks competence. The decision is in compliance with Art. 83 (4) UPCA.
Decision of the LD Munich of 10 Oct 2023 (UPC_CFI_17/2023)	On 1 June 2023, the Applicant brought an application for provisional measures before the LD Munich. With regard to the German part of the patent in suit, a revocation action is pending before the German Federal Patent Court (BPatG). There was no discussion of the Court's competence with regard to Art. 83 UPCA. According to Art. 83 (1) UPCA, there is parallel jurisdiction and since no opt-out request has been filed, there is no need to withdraw it, which would not be possible under Art. 83 (4) UPCA. The decision is therefore also in accordance with Art. 83 UPCA.

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Public Access to the Register - Composition of the Panel (1)

Decision of the Court of Appeal, 2. Panel, of 10 April 2024 - UPC_CoA_404/2023

Facts	The appeal was brought against the decision of the Nordic-Baltic RD (dated 17 October 2024, CFI_11/2023) to grant a third party access to the file of infringement proceedings which had been closed by a settlement between the parties. The Court of Appeal decided to hear the appeal in the composition of three legally qualified judges.
Art. 9 (1) UPCA	(1) Any panel of the Court of Appeal shall sit in a multinational composition of five judges . It shall sit in a composition of three legally qualified judges who are nationals of different Contracting Member States and two technically qualified judges with qualifications and experience in the field of technology concerned . Those technically qualified judges shall be assigned to the panel by the President of the Court of Appeal from the pool of judges in accordance with Article 18.
Grounds mn.18	The wording <i>“shall be assigned to the panel”</i> confirms that they are not appointed permanently to the Court of Appeal and as such not part of the panel, until assigned to one on a case-by-case basis.

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Public Access to the Register - Composition of the Panel (2)

Decision of the Court of Appeal, Second Panel, of 10 April 2024 - UPC_CoA_404/2023

Grounds, mn. 29	Rule 254.2 RoP: Actions for rehearing are assigned to a CoA panel consisting of three legally qualified judges.
Art. 21 (3) Statute	The panel may delegate, in accordance with the Rules of Procedure, certain functions to one or more of its judges.
Grounds, mn. 30	The appeals on procedural matters are nearly always urgent (...). If the procedural appeal shall have any impact on the proceedings in the Court of First Instance, justice must be swift . Assigning technically qualified judges also adds to the costs of proceedings for the Court.
Grounds, mn. 31	Thus, interpreting Art. 9 (1) UPCA as being non-exhaustive ensures the effectiveness of proceedings and efficiency.

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Public Access to the Register – Scrutiny of the Court

Decision of the Court of Appeal of 10 April 2024 2. Panel - UPC_CoA_404/2023

Facts as before	The Applicant requested access to the file of an infringement case that had been settled. The RD granted the request, which was opposed by the Claimant in the infringement proceedings. The CoA dismissed the Appeal of the Claimant.
Art. 45 UPCA	The proceedings shall be open to the public unless the Court decides to make them confidential, to the extent necessary, in the interest of one of the parties or other affected persons, or in the general interest of justice or public order.
Grounds, mn. 43	The interests of a member of the public of getting access to the written pleadings and evidence must be weighed against the interests mentioned in Art. 45 UPCA . The general interest of justice includes the protection of the integrity of proceedings .
Grounds, mn. 47	Both parties agree that a member of the public generally has an interest that written pleadings and evidence are made available. This allows for a better understanding of the decision rendered , in view of the arguments brought forward by the parties and the evidence relied on. It also allows scrutiny of the Court , which is important for trust in the Court by the public at large. This general interest of a member of the public usually arises after a decision was rendered . At this point, there is a decision that needs to be understood and the handling of the dispute by the Court can be scrutinised.

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Public Access to the Register – Integrity of Proceedings


Decision of the Court of Appeal of 10 April 2024 - UPC_CoA_404/2023

Grounds, mn. 48	The protection of the integrity of proceedings ensures that the parties are able to bring forward their arguments and evidence and that this is decided upon by the Court in an impartial and independent manner , without influence and interference from external parties in the public domain . The interest of integrity of proceedings usually only plays a role during the course of the proceedings .
Grounds, mn. 49	This means that these interests – the general interest referred to above and the protection of integrity of proceedings – are usually properly balanced and duly weighed against each other, if access to written pleadings and evidence is given to a member of the public after the proceedings have come to an end by a decision of the court .
Grounds, mn. 50	The Court of Appeal notes that if the decision is rendered by the Court of First Instance and an appeal is or may be lodged, this applies only to the written pleadings and evidence in the proceedings at first instance .
Grounds, mn. 54	A member of the public may also have a more specific interest in the written pleadings and evidence of a particular case than the general interest (...) such as the validity of a patent that he is also concerned with (...). In weighing such a direct interest against the general interest of integrity of proceedings, the balance will generally be in favour of granting access to the written pleadings and evidence of such proceedings .

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 **Language of the proceedings – Court of Appeal**
Order of the Court of Appeal 2. Panel of 17 April 2024 - UPC_CoA_101/2024




Facts	10x Genomics filed a request for provisional measures against Curio Bioscience (CB) with the LD Düsseldorf in German language. CB applied for a change of language to English, the language of the patent.
Art. 49 (5) UPCA	(5) At the request of one of the parties and after having heard the other parties and the competent panel, the President of the Court of First Instance may, on grounds of fairness and taking into account all relevant circumstances, including the position of parties, in particular the position of the Defendant, decide on the use of the language in which the patent was granted as language of proceedings.
President of the CFI, 26 Feb 2024	Application is rejected. CB claims to be a small company but provided no data or proof to the court for comparison.
CoA	Order of CFI is set aside. English shall be the language of the proceedings. Relevant circumstances: nationality or domicile of the parties; the size of the parties relative to each other, delay by change of language. Not relevant: Languages skill of the representatives, nationality of the judges. Position of Defendant is more important. Here, CB claims to have only 30 employees

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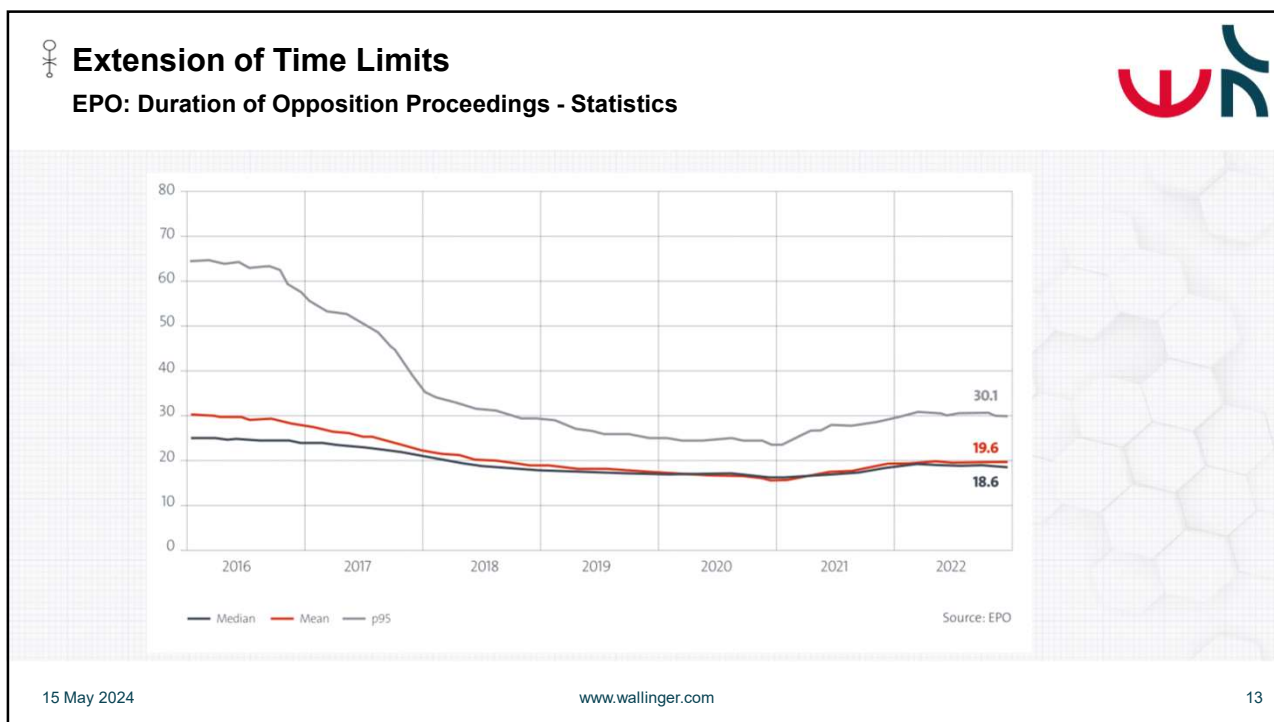
 **Language of the proceedings – President CFI**
Order of the President of the Court of First Instance of 30 May 2024 - UPC_CFI_26/2024



Facts	Headwater Research LLC brought an infringement action against Samsung Electronics, Germany, Samsung Electronics France, Samsung Electronics Benelux and Samsung Electronics Co. Ltd, Korea in German language based on EP3110069 before the LD Düsseldorf. Samsung applied for a change of language to English, the language of the patent. The application was granted.
Samsung's Arguments	The application must be allowed for reasons of fairness and taking into account all circumstances, in particular the interests of the parties. A disproportionate disadvantage is not required , and particular account must be taken of the Defendants' position.
Headwaters' Arguments	A change of the language of the proceedings may be considered if the language originally chosen by the Claimant significantly impairs the defendant.
O. of the Pres	It can be inferred from all these observations that the current use of German, although impairing both parties, is more detrimental to Samsung which did not choose the language in which it is being sued and needs to organize its defense in English before the submissions are translated.

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Extension of time limits

UPC Scheduled Duration of Revocation Proceedings based on RoP

Date	Months	Procedural Step	Time limit (months)
12/2023	-6	Comm. under Rule 71 (3) EPC containing the text intended to be granted published in EPO register.	
13/6/2024	0	Mention of the grant – Art. 95 (3) EPC.	
14/6/2024	0	Filing of a revocation action with the central division in the language of the patent.	
06/2024		Forwarding the complaint to the patent proprietor.	
08/2024	2	Reply by the proprietor (R. 49.1 RoP) e.g. with (auxiliary) amendments (R. 49.2 RoP).	2
10/2024	4	Reply by the Claimant to the Defence of the proprietor (R. 51 RoP).	2
11/2024	5	Proprietor may file a rejoinder to the reply, limited to the matters raised in the reply (R. 52).	1
12/2024	6	Reply by the Claimant if the claims were amended (R. 32.3 and R. 55 RoP).	1
		Interim proceedings – the judge-rapporteur prepares the oral hearing and, where appropriate, holds one or more interim (video-)conferences with the parties (R.101 RoP, R. 104 (g) RoP).	
12/2025	8	Time limit for the summons to the oral hearing (R.108 RoP) – may be shorter if the Parties agree.	2
02/2025		Oral Hearing – should be completed within one day (R. 113.1 RoP), the decision should be announced „immediately after the closure of the oral hearing” (R.118.7 RoP).	1 ^{1/2}
04/2025	9 ^{1/2}	The decision should be issued in writing within six weeks of the oral hearing (R. 118.6 RoP).	

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 **Extension of time limits – Only in exceptional cases**

Procedural Order of the LD Düsseldorf of 19 January 2024 - UPC_CFI_457/2023

Facts	On 30 November 2023, Dolby Int. brought an infringement action against HP Germany, HP Inc., USA and 13 other HP Group companies in various European UPC member states before the LD Düsseldorf. Although the action had only been served against three Defendants, the representatives of the HP Group appointed themselves for all 15 Defendants and waived further service. 12 January 2024 was entered as the date of service in the CMS for the Defendants concerned. The Claimant had agreed to the extension.
LD Düsseldorf	Insofar as Rule 9.3 (a) of the Rules of Procedure grants the possibility of extending the time limit, this should only be used with caution and only in justified exceptional cases against the background of the strict time limit regime to be found in the Rules of Procedure, which serves to ensure that proceedings are conducted as quickly as possible. The slight extension of the opposition and defence periods requested by the Defendants in return for individual Defendants leads to a uniform time limit and therefore appears appropriate.

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 **Extension of time limits – You may pay for it**

Procedural Order of the LD Munich of 3 January 2024 - UPC_CFI_62/2023


Facts	Philips N.V. brought an infringement action against Belkin Germany and five further Defendants before the LD Munich. The German Federal Patent Court declared the German part of the patent in suit invalid in its judgement of 9 August 2023. The written grounds for the judgement were served on the parties on 22 December 2023. The judge-rapporteur has already agreed with the parties on 14 May 2023 as the date of the main proceedings. With reference to the delivery of the judgement on 22 December and the Christmas holidays, the Claimant applied for an extension of the deadline for reply, which ended on 8 January, by one week. The Defendants opposed this and referred to their request for a stay.
LD Munich	The extension of the time limit is to be granted, because the written reasons for the judgment of the Federal Patent Court of 9 August 2023 were only served on 22 December 2023 and a precise analysis of the reasons for the judgment was made more difficult due to the Christmas holidays. Furthermore, the shortening of the revocation reply time period by one week offered by the Claimant will not result in any overall delay in the proceedings.

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Extension of time limits – No exceptional reason: no chance.



Procedural Order of the LD Düsseldorf of 20 January 2024 - UPC_CFI_363/2023


Facts	Seoul Viosys Co., Ltd., brought an infringement action against two German companies. The Defendants <u>requested a two-week extension of the deadline</u> to reply to the infringement action and to file a counterclaim for revocation, since they had been served with the action in paper form.
LD Düsseldorf	<p>Insofar as R. 9.3 (a) RoP allows for the possibility of extending the time limit, this should only be used with restraint and against the background of the strict time limit regime to be found in the Rules of Procedure, which serves to ensure that the proceedings are conducted as quickly as possible in justified exceptional cases (see UPC_CFI_475/2023 (LD Düsseldorf), order of 19 January 2024).</p> <p>Reasons which, exceptionally and despite the Claimant's objection, justify an extension in the present case of the time-limit for lodging the statement of defense and the counterclaim have not been able to demonstrate. The mere general reference to the fact that access to the CMS was not possible "over a long period of time" is clearly insufficient. The statement of claim, including the attachments, was served on the Defendants in paper form. It was therefore fully available to them at all times from the time of service and irrespective of possible malfunctions of the CMS.</p>

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Simultaneous EPO opposition proceedings and/or UPC infringement and/or revocation actions



Art. 33 (10) UPCA	A party shall inform the Court of any (...) limitation or opposition proceedings before the European Patent Office , and of any request for accelerated proceedings before the European Patent Office . The Court may stay its proceedings when a rapid decision may be expected from the European Patent Office .
R. 118.2 RoP	<p>If, while there are infringement proceedings before a LD or RD, a revocation action is pending between the same parties before the Central Division or an opposition is pending before the EPO, the LD or RD:</p> <p>(a) may render its decision (...) under the condition (...) that the patent is not held to be wholly or partially invalid by the final decision; or</p> <p>(b) may stay infringement proceedings (...) if it is of the view that there is a high likelihood that the relevant claims of the patent will be held to be invalid by the final decision (...) of the CD or the EPO where such decision (...) may be expected to be given rapidly.</p>

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Stay of the proceedings – Not a realistic expectation

Order of the Court of Appeal 1. Panel of 28 May 2024 - UPC_CoA_22/2024

Facts	On 29 June 2023, Bitzer Electronic brought an action against Carrier Corp. before the CD Seat Paris asking for the revocation of the patent at issue to the extent of claim 1. On 20 November 2023, Carrier lodged a statement of defence as well as an application to amend the patent. On 1 December 2023, <u>Carrier requested the stay of the proceedings in view of pending accelerated opposition proceedings before the EPO.</u>
Decisions	On 8 January 2024, the CD rejected the application. The CoA rejected the appeal.
CoA 1. Panel 1 st Headnote	Art. 33(10) UPCA and R. 295(a) RoP must be applied and interpreted in accordance with the fundamental right to an effective legal remedy and a fair and public hearing within a reasonable time as guaranteed by Art. 6 of the ECHR (...) . These provisions must also be applied and interpreted in accordance with Articles 41(3), 42 and 52(1) UPCA on the basis of the principles of proportionality, flexibility, fairness and equity (point 2 of the Preamble of the RoP) .
2 nd Headnote	In accordance with these principles, proceedings must be conducted in a way which will normally allow the final oral hearing at first instance to take place within one year (...) .
3 rd Headnote	The mere fact that the revocation proceedings before the UPC relate to a patent which is also the subject of opposition proceedings before the EPO is not sufficient to allow an exception to the principle that the Court will not stay proceedings.

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Stay of the proceedings or Referral to the Central Division (1)

Order of the LD Munich of 2 Feb. 2024 - UPC_CFI_14/2023

Facts	The Claimant brought an infringement action against Defendants 1 to 4 before the LD Munich. Defendants 1 to 3 have filed oppositions with the EPO and a revocation action with the Central Division. Defendant 4 has filed a counterclaim for revocation with the LD Munich.
R. 37.1 RoP	As soon as practicable after the closure of the written procedure the panel shall decide by way of order how to proceed with respect to the application of Article 33(3) of the Agreement.
R. 37.2 RoP	The Panel may by order take an earlier decision if appropriate having considered the parties' pleadings and having given the parties an opportunity to be heard [Rule 264].
LD Munich	In the exercise of its discretion, this Panel refers the counterclaim of Defendant 4 to the Central Division for decision . All parties requested that the counterclaim be referred to the Central Division. Unanimous requests by all parties will be granted unless strong counterarguments require a different decision.

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Stay of the proceedings or Referral to the Central Division (2)

Order of the LD München of 2 May 2024 - UPC_CoA_14/2023

R. 75.1 RoP	Where a Claimant has lodged a Statement for revocation [Rule 44] before the central division and the Defendant or a licensee entitled to commence proceedings pursuant to Article 47 of the Agreement subsequently initiates an infringement action in a local or regional division against the Claimant in respect of the same patent the following procedures shall apply:
R. 75.3 RoP	Where a Counterclaim for revocation is brought in the infringement action and there is identity of parties as between the two actions, unless otherwise agreed by the parties, the panel appointed in the central division to hear the revocation action shall stay all further proceedings in the revocation action pending a decision of the panel hearing the action for infringement pursuant to Article 33(3) of the Agreement and Rule 37.
LD Munich	If Defendants 1 to 3 had wished to have the Local Division Munich decide exclusively on the validity arguments , they could have filed counterclaims for revocation pursuant to Rule 75 RoP together with their Statement of Defence, in addition to the independent revocation actions already filed. If they had done so, the Local Division Munich would have been able to decide on all four counterclaims. The Central Division would have been obliged to stay the proceedings on the individual revocation actions pursuant to Rule 75(3) RoP.

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Jurisdiction - Security Deposit

Order of the Central Division Section Munich of 4 and 30 October 2023 - UPC_CFI_252/2023

Facts	On 25 August 2022, NanoString Germany GmbH brought a revocation action against the German national part of EP 2 794 928 to the German Federal Patent Court. The oral hearing in said action was scheduled for 7 May 2024. On 27 July 2023, NanoString Europe UK , brought a revocation action against EP '928 to the CD Section Munich, requesting revocation of the Patent for the territory of Germany, France, and the Netherlands.
Order of 4 October 2023	On 28 August 2023, the Defendant filed a preliminary objection including a request to have the revocation action dismissed as inadmissible in so far as it relates to the German part of EP '928, and an application for security for costs pursuant to Rule 158 RoP. The Court finds that the parties agree that the UPC has jurisdiction over at least the non-German parts of EP '928 and therefore concludes that this preliminary objection should be dealt with in the main proceedings.

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Security Deposit – UK Claimant

Order of the Central Division Section Munich of 4 and 30 Oct. 2023 - UPC_CFI_252/2023

Rule 158 (1) RoP	At any time during proceedings , following a reasoned request by one party, the Court may order the other party to provide, within a specified time period, and other expenses incurred and/or to be incurred by the requesting party, which the adequate security for the legal costs their party may be liable to bear.
Order of 30 October 2023	It may be necessary to order the provision of security if there is concern that: <ol style="list-style-type: none"> 1. the party does not have the financial means to settle the cost claim at the relevant time, or 2. a cost title of the UPC cannot be enforced or can only be enforced with unreasonable effort.
Headnote 2	<p>Imposing a security for legal costs serves to protect the position and (potential) rights of the Defendant. This has to be balanced against the burden for the Claimant caused by an order to provide security. There should not be an unjustified interference with the right to an effective remedy and to a fair hearing. The Court must weigh the relevant facts and circumstances.</p> <p>According to the AC ceiling table, the corresponding security for a value in dispute of EUR 7.5 million would be EUR 600,000. The Court finds it fair, reasonable and proportionate to order the Claimant to provide a security to the amount of EUR 300,000. First of all, the table as drawn up by the AC relates to a ceiling for recoverable costs, i.e. the maximum amount of costs recoverable. Moreover, Article 69 UPCA contains a number of additional safeguards, e.g. "reasonable and proportionate" and "equity" that might lower a possible cost order.</p>

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Identity of the parties

Order of the Central Division Paris Seat 13 Nov. 2023 - UPC_CFI_255/2023


Facts	On 4 August 2023, the Applicant, Meril Italy, a subsidiary of Meril India, filed a revocation action against the patent in suit with the CD Paris. The Applicant, Edwards Lifescience had previously filed an infringement action against Meril India and Meril Germany with the LD Munich on 1 June 2023, which is pending. The Applicant requests that the action be dismissed as inadmissible under Art. 33 (4) UPCA and, alternatively , that the proceedings be stayed until the Defendants in the Munich proceedings have submitted their defence and the Respondent is ordered to provide (...) adequate security for the legal costs.
Order	The court rejects the preliminary objection and the application for a security deposit for the legal costs.
Grounds mn.s 45, 46	<p>The issue at hand is if the Respondent Meril Italy and Meril India (or Meril Germany) are the same parties. According to the Applicant the term "the same parties" in the UPCA should be interpreted broadly in light of this Regulation and the judgment of the ECJ of 19 May 1998 in Case C-351/96.</p> <p>Actions for revocation of patents (...) shall be brought before the CD. The rule that allocates these actions to the LD and RD before which an infringement action is pending between the same parties constitutes an exception to a general principle that, as such, does not permit a broad interpretation.</p>
Grounds mn. 90	The Court deems that the mere circumstance that the Respondent is, at the moment, not active in the market and that it has a share capital of only Euro 10,000.00 is not a sufficient reason to believe that the Applicant will not be able to enforce its claim for reimbursement of costs.

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Order for Provisional Measures ex parte – Protective letter?



Order of the LD Düsseldorf of 22 June 2023 - UPC_CFI_177/2023

Facts The patent in dispute relates to a combination structure of a bicycle frame. The contested embodiment was not yet available on the market but could be test ridden at the important bicycle trade fair EUROBIKE, which took place from 21 June 2023 to 25 June 2023. **The patent proprietor unsuccessfully requested a cease-and-desist declaration from the Defendant on 22 June 2023, and thereupon applied for provisional measures.** The Defendant had filed a protective letter under Rule 207 RoP, which was taken into account by the court when deciding on the application. The Defendant claimed that the patent was not infringed, that it was invalid and that the patent rights had been exhausted.

Order **The LD Düsseldorf issued the requested order on the same day as the application was filed.**

Grounds The contested embodiment **infringed the patent literally, and the Defendant had not disputed this in any significant way, either out of court or in the protective letter.**

The application was **urgent within the meaning of Rule 209.2(b) RoP in relation to the current trade fair EUROBIKE.**

The **validity of the patent was confirmed to the required extent.** The patent grant was published in 2015 and no opposition or action for revocation had been filed against the patent to date. **Further, the Defendant did not present any relevant prior art.**


The **order for provisional measures was necessary** because the exhibition of the contested embodiment at this trade fair could lead to a loss of the Applicant's sales and market share that would be difficult to reverse.

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Order for Provisional Measures – a Landmark Decision (1)



Order of the LD Munich of 19 Sep. 2023 - UPC_CFI_2/2023

Facts On 1 June 2023, 10x Genomics and the Patent Proprietor filed an application for provisional measures against NanoString US, DE and NL, based on EP 4 108 782, a patent with unitary effect. The Defendants argued: The Local Division Munich was not competent, the patent was not infringed, the patent was not valid because of inadmissible amendments, insufficient disclosure, missing novelty and inventive step; the Applicants did not have the right to sue, there was no need for legal protection, the Defendants could rely on a grant of a licence, the enforcement of the claims was contrary to antitrust law.


Order The LD Munich granted the request after two days of oral proceedings and reasoned the judgement on 113 pages.


Grounds p.40 **Competence** of the LD Munich. Alleged patent-infringing products had been offered for sale on the internet for shipment to the member states of the EU and thus also to Germany. Whether this actually results in a patent infringement in the end is not decisive for the answer to the question of competence.

Need for legal protection In view of an earlier judgement of the Munich Regional Court for a parallel patent against the same embodiment: **Since the requested order has effect for all participating EU states in the case of a patent with unitary effect (as opposed to the effect of the judgement only in Germany), there is a general need to go to the UPC.** Moreover, the patents in question were different and thus the subject matter of the dispute was different.

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 **Order for Provisional Measures – a Landmark Decision (2)**
Order of the LD Munich of 19 Sep. 2023 - UPC_CFI_2/2023




p.48	Obligation of the court to examine validity: The Court agrees with the Defendants that R. 211.2 and R. 209.2(a) RoP impose an obligation on the Court to independently assess the legal status of the patent in suit.
p.53	Claim interpretation: The court discusses the features in dispute of the claim under Article 69 EPC on the basis of the wording of the claim and the explanations in the description and the drawings.
p.58	"Sufficient degree of certainty" standard: According to Rule 211.2 RoP the court must be satisfied "with a sufficient degree of certainty" of the validity of the patent. A predominant probability is necessary, but also sufficient.
p.61	Inadmissible amendment: As could be expected, the LD follows the generally accepted "gold standard" of the Enlarged Board of Appeal of the EPO.
p.63	Novelty: The court further assumes "with a sufficient degree of certainty" that the patent in suit will not be revoked for lack of novelty.
p.65	Inventive step - closest prior art: "Aspects such as the designation of the subject-matter of the invention, the formulation of the original problem as well as the intended use and the effects to be achieved should generally be given more weight than a maximum number of identical technical features ".

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 **Order for Provisional Measures – a Landmark Decision (3)**
Order of the LD Munich of 19 Sep. 2023 - UPC_CFI_2/2023





p. 66	Inventive step – obviousness: The court examines whether the prior art renders the subject-matter of the claim obvious. In doing so, the court examines both whether the skilled person had an incentive to act in a certain way (e. g. page 62, 2 nd paragraph) and whether the skilled person would actually have done so (page 69, 2 nd paragraph). The court does not apply the problem-solution approach.
p. 69	Insufficient disclosure: According to the court, insufficient disclosure is given "if serious doubts, substantiated by verifiable facts", exist "that a skilled reader of the patent would not be able to carry out the invention on the basis of his general knowledge of the subject-matter." This wording is identical with the wording of EPO BoA decisions e. g. T 19/90 – Onco-Mouse (OJ EPO 1990, 476), point 3.3 of the grounds.
p. 84	Necessity of ordering provisional measures: The court finds that both factual and time-related circumstances are relevant in assessing the necessity of granting provisional measures according to R. 206.2 (c) and R. 209.2 (b) RoP.
p. 88	Potential damages: The court follows the Applicants' submission that they are threatened with damages if the injunction is not granted, as Defendants' products could then permanently block the market. Damages caused by the actions of third parties brought into play by the Defendants are not to be taken into account, since Art. 62 UPCA only deals with the balancing of the interests of the parties against each other.

Urgency – unreasonable delay: not relevant, as the patent was granted on 11 May 2023 and the application was filed on 1 June 2023, i.e. on the first possible date.

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 **Order for Provisional Measures – a Landmark Decision (4)**
Order of the LD Munich of 19 Sep. 2023 - UPC_CFI_2/2023





p. 90	Alleged grant of licence: In the District Court of Delaware's judgment of 10 July 2023, the US court found that NanoString was not a third-party beneficiary of the contract between NIH and the patent proprietor. The Munich LD UPC agreed with this opinion.
p. 69	Licence claim under US competition or US antitrust law: In the opinion of the LD Munich the Defendants' argument that they are entitled to a licence claim under US competition or antitrust law is a mere legal assertion which is not based on a court decision of a US court in favour of the Defendants. Moreover, the LD missed concrete explanations why such a legal claim should also extend to the territory of the contracting states of the UPCA.
p. 84	Licence claim under EU antitrust law: The LD found that the Defendants had not sufficiently presented the evidence of the Applicants' alleged dominant position and the abuse of such a dominant position, which would be a prerequisite for a licence claim.
p. 99	Injunction is not disproportionate: The LD missed a corresponding concrete factual submission and also sees no legal principle in the UPCA to the effect that rights of third parties may be infringed by a complex product without entailing an injunction. Further, the LD missed concrete factual evidence as to which research projects etc. were in danger. Finally, the court did not see any provision in the UPCA or in the Rules of Procedure that precludes the ordering of provisional measures in the case of highly complex technologies or a multitude of issues to be dealt with.

Security: The LD found that there is no evidence requiring the provision of security in light of the Applicants' "economic condition" and US enforcement law. The requested measures are therefore ordered without security.

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 **Claim interpretation – The most important decision so far?**
Order of the Court of Appeal, First Panel, of 26 February 2024 - UPC_CoA_335/2023



Facts	The companies of the Nanostring Group, which had lost the previously discussed proceedings before the LD Munich, appealed against the decision. The oral hearing in these proceedings took place on 18 December 2023. In its above-mentioned decision, the CoA overturned the decision of the LD Munich and rejected 10x Genomics' application for provisional measures.
Headnote 2	The patent claim is not only the starting point, but the decisive basis for determining the protective scope of a European patent under Art. 69 EPC in conjunction with the Protocol on the Interpretation of Art. 69 EPC. [... citations from Art. 69 EPC and the respective protocol ...]. These principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent.
Comment	It took the Court of Appeal only 271 days from the start of the UPC to decide that Art. 69 EPC applies both to the determination of the scope of protection and to the determination of the subject-matter of the patent in revocation proceedings.
Novelty p. 26 and 30	Contrary to the Court of First Instance's understanding, it cannot be inferred from patent claim 1 that the detection reagents must remain bound to the respective analytes throughout the entire detection procedure according to feature group 4. D6 thus discloses all the features of claim 1 (see also the preliminary opinion of the German Federal Patent Court of 7 February 2023 [BP9] regarding the parent patent, p. 5 et seq.)

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Claim interpretation at the EPO - The confusion caused by the BoA

Facts	The EPC was signed on 5 October 1973 and the European Patent Office became operational on 2 November 1977. To date, the BoA have not been able to find a common line on the application of Art. 69 EPC.
Art. 69 (1) EPC	(1) The extent of the protection conferred by a European patent (...) shall be determined by the claims. Nevertheless, the description and drawings shall be used to interpret the claims.
Application of Art. 69 EPC by the BoA	The Boards of Appeal essentially takes three different approaches to claim interpretation: <ol style="list-style-type: none">One group believes that the description should not be used at all to interpret the claim. e. g. T 1127/16, Grounds 2.6.2.Another group says that the description should only be used to interpret the claim if the claim is unclear, e. g. T 169/20, Grounds 1.13.Finally, a third group is of the opinion that the description should always be used to interpret the claim (e.g. T 1473/19)
Art.112 (1) EPC	(1) In order to ensure uniform application of the law , or if a point of law of fundamental importance arises: (a) the Board of Appeal shall, during proceedings on a case and either of its own motion or following a request from a party to the appeal, refer any question to the Enlarged Board of Appeal if it considers that a decision is required for the above purposes (...). Breaking news: According to several consistent sources, a referral to the Enlarged Board of Appeal is to be made in case T 0439/22 concerning EP 3 076 804 on the question of the application of Art. 69. The decision is to be published on 1 July 2024 according to the EPO Patent Register.

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Claim interpretation – Prosecution history may be considered

Order of the LD Munich of 20 Dec. 2023 - UPC_CFI_ 292/2023


Facts	On 4 September 2023, the Applicant requested a provisional order against the Defendants for them to refrain from offering, placing on the market, etc., electronic labels according to the wording of claim 1 and 3 of EP 3 466 498. EP '489 teaches to arrange a printed circuit board on which a radio frequency communication module is mounted inside the housing of the electronic label on the side of the rear surface of the housing and on which an antenna is mounted on or inside the housing on the side of the front surface of the electronic label.
Order	The LD Munich dismissed the application because it was not convinced that the contested embodiment made use of feature 7 of claim 1. For the interpretation of feature 7, according to which a printed circuit board (35) is accommodated in the housing (30) on the side of the rear surface of the housing, the LD referred to the description of the patent but also to the claims of the originally filed documents.
Headnote 1	The original claim version of a European patent may be used as an aid to interpretation in connection with amendments to the claim version made during the grant procedure.

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🔗 Claim interpretation – Prosecution history must not be considered

Order of the LD Düsseldorf of 9 April 2024 - UPC_CFI_ 452/2023



Facts	On 1 December 2023, the Applicant requested a provisional order against the Defendants for them to refrain from offering , placing on the market, etc. avalanche victim search devices according to the wording of claim 1 of EP 3 883 277. The parties disputed whether the claimed term "sound signal" also includes sound patterns such as those emitted by the contested embodiment. The Defendants referred to a prior art patent document that was supposed to show the general understanding of the skilled person, but which was not mentioned in the patent in suit.
Order	The LD granted the application. With regard to the difference between the terms "sound signal" and "sound pattern", the LD referred to the broad definition of the term "sound signal" in the description of the patent in suit. To the extent that the Defendants referred to statements made by the Applicant in the grant proceedings the court found, such statements are in principle not admissible interpretative material. They are therefore not to be taken into account from the very beginning.
Headnote 1	Art. 24 (1)(c) UPCA in conjunction with Art. 69 EPC conclusively determine which documents are to be used for the interpretation of the patent claims, which determine the scope of protection, namely the patent description and the patent drawings. Since the prosecution file is not mentioned in Art. 69 EPC, it does not constitute admissible material for interpretation. If the Applicant has commented on the meaning of a feature or term during the examination procedure, this can at most be indicative of how the person skilled in the art understands the feature in question.

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🔗 Claim interpretation – Relevance of prosecution history remains open

Order of the CoA, First Panel, of 13 May 2024 - UPC_CoA_1/2024



Facts	The Applicant, whose application for provisional measures based on patent EP 3 883 277 (electronic label) was rejected by the Munich Regional Court, appealed against this decision.
Order	The Court of Appeal dismissed the appeal. The court confirmed the LD Munich's claim construction, but did not refer to the prosecution history, basing its opinion solely on the description and drawing of the disputed patent. With regard to the prosecution history relied on by the LD Munich for its interpretation, the Court of Appeal states:
Grounds 37	The parts of the documents relating to the examination proceedings before the European Patent Office cited by the parties do not shed any new light on that interpretation. Consequently, the Court of Appeal does not need to consider in the present case whether the prosecution history can be taken into account when determining the scope of protection of a European patent.

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PATENT- UND RECHTSANWÄLTE

Thank you for your attention!

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