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Contributing Editor:

Katharine Stephens

Bird & Bird LLP

glg Global Legal Group

The First Year of the Unified Patent Court

Bird & Bird LLP



Trevor Cook

After many years of false starts, the Unified Patent Court (UPC) eventually opened on 1 June 2023, and although it is only now starting to produce decisions in actions on the merits, there have in its first year of operation been numerous decisions on procedural issues and many reasoned decisions in applications seeking provisional relief which already give a good idea of the attitude of the new court and which are discussed below.

The UPC, established by the Unified Patent Court Agreement (UPCA), is a single court with exclusive jurisdiction as to the new European patents with unitary effect (uptake of which is now running at 25% of grants) and, for now, non-exclusive jurisdiction, shared with national courts, over “traditional” European patents that are not “opted out” of the UPC jurisdiction in those 17 (shortly to be 18) EU Member States that have ratified the UPCA – namely Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, the Netherlands, Portugal, Romania (as from 1 September 2024), Slovenia and Sweden. A referendum that Ireland requires in order to ratify the UPCA and which had been planned for June 2024 has been postponed, and no new date has yet been set for it, so Ireland remains out of the system for now.

Despite its being a single court, the UPC at first instance is split into divisions. Thus, in addition to a central division (itself further split between Paris, Munich and, since 27 June 2024, Milan, the appropriate location depending on the nature of the technology in issue), there are 13 local divisions (four of which are in Germany) and one regional division (the Nordic Baltic Regional Division). Revocation actions must be started in the central division of the UPC, but infringement actions (and revocation counterclaims), along with proceedings for provisional measures (interim injunctions) and preservation measures (such as a *saisie*), generally proceed in local or regional divisions. There is only one level of appeal in the UPC, to the Court of Appeal, based in Luxembourg, and whose business is currently divided between two panels.

Statistics

The UPC has attracted a respectable body of patent litigation during its first year, namely, as to proceedings on the merits, 134 infringement actions (104 of which were brought in the four German local divisions), in 63 of which infringement counterclaims had been filed, and 39 revocation actions. After a further month, the corresponding figures were 155, 122, 73 and 40. In addition, there were 32 applications for provisional measures, preservation of evidence and orders for inspection, most of which will have been followed by

actions on the merits. However, to put matters in perspective, one should compare this number of actions with the several hundred patent infringement cases that are brought annually in Germany alone, although this figure dropped in 2023, suggesting that many cases that would have previously been brought in Germany, as Europe’s largest market, are now proceeding in the UPC, even though the nature of the split system in Germany, by which the infringement proceedings are determined more quickly than revocation proceedings, provides a procedural benefit for patentees which in practice they lack in the UPC.

The relatively low number of UPC revocation proceedings (at least as compared with the 3,000–4,000 EPO oppositions mounted each year) no doubt reflects the large proportion of traditional EP “bundle” patents that have been opted out of the UPC, probably representing those patents judged by their proprietors to be the most commercially important – in several cases such proprietors have opted their patents back in to immediately commence UPC proceedings on them. To the eyes of English practitioners, the proportion of infringement actions that have been met with revocation counterclaims, at a little under 50%, looks low, and although the time lag between an action being started and a counterclaim to it being mounted will always reduce the proportion, this effect overall should by now be relatively small. Another factor may be that actions which settle, either formally or informally, before a counterclaim can be filed, but as to which statistics are less readily available.

As to the language of proceedings, at the end of the first year 50% of proceedings were in English (which can be used in all divisions), with most of the rest in German, although the proportion of proceedings in English can be expected slowly to increase over time because many of the early proceedings were filed in German as the German authorities did not designate English as an official language of their local divisions until shortly before the UPC opened. Also, as discussed below, where the patent is in English, applications to change the language of proceedings to English have often succeeded.

Actions have been brought in the UPC in relation to a wide range of technologies, and although the ICT sector leads in terms of simple numbers, this largely reflects the larger number of patents encountered in this sector, with some disputes involving several patents, and several corresponding actions. Medtech makes a strong showing in second place, with consumer goods in third place. There are relatively few cases in pharma and biotech as yet but those that there are form part of some major international disputes, such as that relating to PCSK-9 inhibitors, and actions are now being started in the UPC over biosimilars.

Applications for Provisional Measures

One aspect of UPC procedure that has been explored in some detail during this first year has been that of applications for “provisional measures” under Article 62 UPCA, namely in English terminology interim injunctions, which have effect through to trial on the merits. There have been a relatively large number of decisions on applications for provisional measures, as listed below.

Date	Claimant	Defendant	Patent	Division	Outcome
22.06.23 30.06.23	myStromer	Revolt Zycling	EP 2546134	Dusseldorf LD	Granted Rectification denied
13.09.23	CUP&CINO	Alpina Coffee	EP 3398487	Vienna LD	Denied
19.09.23 26.02.24	10x Genomics	Nanostring	EP 4108782	Munich LD	Granted Reversed on appeal
10.10.23	10x Genomics	Nanostring	EP 2794928	Munich LD	Denied
20.10.23	AIM Sport	Supponor	EP 3295663	Helsinki LD	Denied
11.12.23 09.04.24	Ortovox Sportartikel	Mammut Sports	EP 3466498	Dusseldorf LD	Granted <i>ex parte</i> Upheld on review
20.12.23 13.05.24	VusionGroup (ex SES-Imagotag)	Hanshow	EP 3883277	Munich LD	Denied Upheld on appeal
30.04.24	10x Genomics	Curio Bioscience	EP 2697391	Dusseldorf LD	Granted
21.05.24	Dyson	SharkNinja	EP 2043492	Munich LD	Granted
03.06.24	Ballinno	UEFA	EP 1944067	Hamburg LD	Denied
19.06.24	Abbott	Sibio	EP 2713879	Hague LD	Granted
19.06.24	Abbott	Sibio	EP 3831283	Hague LD	Denied
26.06.24	Alexion	Amgen	EP 3167888	Hamburg LD	Denied

In order to secure provisional measures, a claimant must convince the court that it is more likely than not to prevail on the merits, that the relief sought is urgent and that there has been no untoward delay in seeking it, and that the balance of the interests of the parties and the potential harm to each of granting or not granting the injunction favours grant. As to the merits, although the patentee has the burden of proof to demonstrate infringement, on questions of validity the burden is on the defendant. The standard of proof in each case is a “sufficient degree of certainty”, which the Court of Appeal in *10x Genomics v Nanostring* (EP 4108782) held to mean “more likely than not”.

The first such order made, in *myStromer v Revolt Zycling*, in the context of a trade show, and concerning a patent for a combination structure of bicycle frame and motor hub for electric bicycles, was granted *ex parte* despite the defendants having previously been filed a protective letter with the UPC. The purpose of protective letters, the existence of which is not known to the claimant unless and until they bring an action on the patent that such letter identifies, is to prevent the grant of *ex parte* relief and to give the prospective defendant the opportunity to argue *inter partes*. A protective letter expires after six months and so must be refiled to stay effective. However, to fulfil its purpose, a protective letter must itself be convincing, which was evidently not the case here. It did not set out any attacks on validity and the only arguments it presented were as to non-infringement and exhaustion. The Court disagreed with the former and noted, as to the latter, that a Swiss court had already rejected the argument that an existing licence agreement covered the product at issue. The provisional injunction, which also provided for delivery up of the bicycles on display at the trade show, was enforceable on provision of security

of EUR 500,000 payable by the claimant within 10 days from service, was subject to a penalty of up to EUR 250,000 for each violation of the order. An attempt by the patentee to rectify the order to extend it to another UPC country in which the patent was in force but which had been omitted in the original application through oversight failed. The claimant complained of certain breaches by the defendant of the order and on 18 October 2024 the Court levied a fine totalling EUR 26,500 in respect of those complaints that it found to be substantiated.

Applications for provisional measures have been denied for a variety of reasons. In *AIM Sport Vision v Supponor*, the Court held that it lacked jurisdiction because the claimant’s attempt to withdraw its opt-out was ineffective. It gave its decision orally on the day of the hearing and followed this with its written decision a month later. In *CUP&CINO v Alpina Coffee* and *SES-Imagotag v Hanshow*, the Court was not convinced with sufficient certainty that the patents in issue were infringed, with which view the Court of Appeal agreed in the latter case. Those applications that have been denied because of significant doubts as to the validity of the patent in suit have been *10x Genomics v Nanostring* (EP 4108782) and *Abbott v Sibio* (EP 3831283). In *10x Genomics v Nanostring* (EP 4108782), in which the claim related to a method of detecting analytes in a cell or tissue sample using detection reagents, the UPC Court of Appeal adopted a broader claim construction than had the local division, as a consequence of which it considered certain prior art to be of much greater significance than the local division, whose decision granting provisional measures it reversed. In *Abbott v Sibio* (EP 3831283), relating to a continuous glucose monitoring device, the Court (applying the so-called “gold standard” disclosure test, which it noted, citing the EPO *Case Law of the Boards of Appeal* and the EPO Enlarged Board of Appeal decisions that this in turn cited was also the standard used in many Contracting Member States of the UPC), considered an added matter attack on the patent to be more likely to succeed than not, whereas in *Abbott v Sibio* (EP 2713879) issues of validity and infringement did not arise. This was because the defendant had already given a cease-and-desist undertaking on this patent, but with which it had apparently not complied, and so it had no legitimate interest in opposing the provisional measures. In *10x Genomics*

v Nanostring (EP 2794928), the Court expressed concerns not only as to both validity and infringement, but also urgency, because the patent here was a bundle patent which, unlike the unitary patent that had initially been successfully asserted in *10x Genomics v Nanostring* (EP 4108782) could have been asserted earlier in national proceedings seeking provisional measures. Another case in which provisional measures were denied because the claimant had not treated the matter with the necessary urgency was *Ballinno v UEFA*, in which the claimant had waited several months after becoming aware of the alleged infringement before seeking provisional measures, although the Court was also not convinced with sufficient certainty as to infringement.

A defendant that successfully resists an application for provisional measures should get an immediate award of its costs, whereas for a successful claimant, recovery of such costs depends on its also succeeding at the full hearing on the merits, the action for which it must initiate within the time limit set by the Rules of Procedure. Because only a successful claimant for a provisional injunction is obliged to commence proceedings on the merits on the patent on which it has secured relief, an adverse ruling in an application for provisional measures at first instance may well result in no corresponding proceedings on the merits ever being brought.

Applications for Preservation of Evidence and Orders for Inspection

Another aspect of UPC procedure to have been explored in its early months has been that of orders for the preservation of evidence and for inspection. Such orders have long been a feature of litigation in national jurisdictions in Belgium, France and Italy and it is notable that it is in the local divisions of the UPC that are based in those countries that such orders have so far been sought. Such orders tend, by their nature, to be granted *ex parte* in cases where the urgency issue is paramount, such as at a trade fair.

the order for inspection cease to have effect and the evidence collected be returned, but allowed the claimant time to appeal and apply for suspensive effect, which appeal succeeded.

The two orders made in *C-Kore v Novawell* provide between them the fullest analysis to date of this particular procedure and are worth reviewing in more detail as it will not be so not familiar to those from outside the jurisdictions listed above. The patent related to subsea apparatus and its testing. On the basis of images taken from the defendant's website, the Paris local division considered the claimant to have sufficiently discharged its burden of providing reasonable evidence at this stage that claim one of the patent was infringed, and accepted the claimant's explanation that the further evidence sought was needed to establish which other claims of the patent were infringed. The claimant had taken less than three months to file its application to preserve evidence, which the Court considered to be a reasonable delay in the present case. The Court also accepted that the order needed to be granted *ex parte*, considering to be a reasonable risk, given the nature of the information sought (not apparently a high threshold), of evidence being destroyed or otherwise ceasing to be available. The order made by the Court specified in detail where the measures ordered were to be executed, to what these applied, the identity of those attending (an expert, who was "in the list of patent experts who are used to cooperate with the national Courts" and who was to be "assisted by the competent bailiff, as it is appropriate and allowed under national law" and one representative of the claimant – its lawyer), their obligations of confidentiality, what steps they could take in order to execute the measures ordered, and the deadline for the expert to file the report of the inspection. After execution of the inspection, the defendant filed a request for review, which could, if successful, have resulted in the revocation of the order made by the Court, but the Court considered and rejected or considered as irrelevant each of the various arguments advanced by the defendant, such as its attack on the validity of the patent, which there was no reason for the Court to

Date	Claimant	Defendant	Patent	Division	Outcome
13.06.23	Oerlikon	Himson	EP 2145848	Milan LD	Granted <i>ex parte</i>
14.06.23	Oerlikon	Bhagat	EP 2145848	Milan LD	Granted <i>ex parte</i>
21.09.23	Nelissen	OrthoApnea	EP 2331036	Brussels LD	Granted <i>ex parte</i>
25.09.23 08.04.24	Progress	AWM and Schnell	EP 2726230	Milan LD	Granted <i>ex parte</i> Revoked on failure to start proceedings on the merits Reversed on appeal
14.11.23 01.03.24	C-Kore	Novawell	EP 2265793	Paris LD	Granted <i>ex parte</i> Upheld on review

The first two such orders were made by the Milan local division in proceedings concerning a textile machinery patent and an alleged infringement on display at a trade fair. That granted by the Brussels local division concerned a patent for a device for treating sleep apnoea exhibited at a two-day symposium.

The order in *Progress v AWM and Schnell* concerned a patent for a method and apparatus for continuously manufacturing lattice girders, which was also granted by the Milan local division, and also included provision allowing inspection of premises. Although there was not the urgency of a trade fair or symposium, the order was made *ex parte* as the Court was satisfied there was a demonstrable risk of evidence being destroyed or otherwise ceasing to be available. However, the claimant then failed to initiate proceedings on the merits within what the Court (wrongly) considered to be the requisite period, with the consequence that the Court ordered that

explore at this stage of proceedings, or its non-infringement arguments, as the order was concerned with preserving evidence at an early stage of the proceedings and the Court had rightly considered that the applicant had provided sufficient available reasonable evidence of the alleged infringement. In response to the argument that the order sought should have been for inspection rather than for preservation of evidence, because the *saisie* measures ordered were carried out at the defendant's premises, the Court explained that these were two distinct procedures with different purposes, the one aimed at collecting and seizing evidence by detailed description or physically, and the other for inspecting "products, devices, methods and premises or local situations *in situ*". There was no need to combine the two measures, even though the first obviously required the right to enter a private place.

Decisions on the Merits

In July 2024, decisions on the merits at first instance in the UPC, as listed below, have started to emerge. The Court can accordingly be seen to be fulfilling its stated aim of conducting proceedings in such a way as will normally mean that the final oral hearing at first instance takes place within one year from service of the proceedings.

Date	Patent owner	Other party	Patent	Division	Outcome
03.07.24	Kaldewei	Bette	EP 3375337	Dusseldorf LD	Valid and infringed
04.07.24	Dexcom	Abbott	EP 3435866	Paris LD	Invalid – lack of inventive step Infringement not addressed
16.07.24	Amgen	Sanofi-Aventis	EP 3666797	Munich CD	Invalid – lack of inventive step
16.07.24	Amgen	Regeneron	EP 3666797	Munich CD	Invalid – lack of inventive step
19.07.24	Edwards	Meril (x 3)	EP 3646825	Paris CD	Valid

In the decision in *Kaldewei v Bette*, concerning a patent for bath fittings, the patentee succeeded on the basis of a narrower claim set filed in the course of proceedings. The decision considers issues of contributory infringement as well as personal prior use under Article 28 UPCA, and is especially interesting for the specific and extensive nature of the relief granted, in all the UPC countries in which the patent was in force, including a permanent injunction, enforceable by penalty payments with no upper limit, the recall and removal of products already in the distribution chain, the provision of sales data to enable pecuniary relief to be assessed, and the payment of costs and provisional damages.

In *Dexcom v Abbott*, the Court held that the UPC had jurisdiction over the German designation of the patent notwithstanding ongoing proceedings in Germany. It did not address the issue of infringement because it revoked all designations of the patent, on the ground of lack of inventive step of the main claim set and the auxiliary request claim set that it considered to be otherwise allowable, having rejected attacks alleging added matter and lack of novelty.

In *Sanofi-Aventis v Amgen* and *Regeneron v Amgen* (which both concern the same Amgen patent, to a functionally defined antibody, and contain identical reasoning) the Munich central division rejected the claimant's attack on technical priority, citing EPO Enlarged Board of Appeal decision G2/98. It then discussed the correct approach to inventive step in detail at [8.2] to [8.10], without referring to EPO case law, and although considerations of space do not allow this to be quoted here, it is a discussion, making no reference to EPO practice or case law, that is likely to be relied on in subsequent UPC cases.

In *Meril Italy srl v Edwards* and each of the two counterclaims in *Edwards v Meril GmbH and Meril Life Sciences Pvt Ltd*, the Paris central division upheld the validity of an amended version of the patent, to an artificial heart valve, rejecting the claimant's attack on legal priority (citing EPO Enlarged Board of Appeal decisions G-1/22 and G-2/22) and as to lack of inventive step. Although it does not discuss the approach to inventive step in the details of *Sanofi-Aventis v Amgen* and *Regeneron v Amgen* the Court comments on the fact that “the EPO and some national jurisdictions” apply the “problem-solution approach”, implicitly accepting that it is not doing so. However, it then goes on to explain why, applying the “problem-solution approach” in this case would not lead to a different conclusion.

Jurisdictional Issues

The Court has so far had to consider two main types of jurisdictional issue – those relating to opt-outs from the UPC, and

those relating to proceedings brought on bundle European patents as to which there are parallel national proceedings in one or more UPC Member States.

Opt-outs were first addressed in the application for provisional measures in *AIM Sport Vision v Supponor* (Helsinki LD 20 October 2023), in which the Court held that it lacked jurisdiction because the patentee's attempt to withdraw its opt-out was ineffective. Although an appeal was filed (see

Court of Appeal Orders of 26 February 2024 and 26 April 2024, addressing the admissibility of the appeal), it is not clear whether it is proceeding. The Court held that it did not have competence to hear the matter where the patentee had opted out its patent, but then purported to withdraw the opt-out when seeking provisional measures in the UPC. This was because the withdrawal of the opt-out was ineffective because two national actions were pending in Germany, both at the date of the opt-out and at the date of its purported withdrawal. *Neo Wireless v Toyota* (CoA 4 June 2024) upheld the decision of the Judge-Rapporteur in the Paris local division that in order to be valid and exclude the jurisdiction of the UPC, an opt-out application must be lodged by or on behalf of all proprietors of all national parts of a European patent.

The effect on UPC proceedings of parallel proceedings brought on bundle European patents in UPC Member States has been considered in two decisions at first instance. The central division has held (*Mala Technologies v Nokia Technology* Paris CD 2 May 2024) that the *lis pendens* provisions of the Brussels I Regulation do not apply when a national action (in this case a German nullity action) had been started before the UPC came into force and thus there was no basis for staying the UPC revocation action. In *Dexcom v Abbott* (Paris LD 4 July 2024), where there was also a German nullity action on foot, the Court proceeded on the basis that such *lis pendens* provisions did apply, and that the national and UPC proceedings were “related actions” on the basis of which the Court had a discretion that it could exercise, but that since the German national Court would not give its final decision until after that of the UPC it was “not in the interests of the proper administration of justice either to decline jurisdiction in favour of the German national court or to stay proceedings pending the decision of the national court”.

Claim Construction

Even though decisions on the merits are only now starting to emerge, the Court, in applications for provisional measures, both at first instance and on appeal, has expressed its views on various matters of substantive law when considering whether there is a “sufficient degree of certainty” on matters of infringement and validity.

Of particular note is the Court's approach to claim construction, an area of substantive law as to which the UPC Court of Appeal has already been able to make important statements of principle in applications for provisional measures, first doing so in *10x Genomics v Nanostring* (EP 4108782) (CoA 26 February

2024). Here it adopted a broader claim construction than the Munich local division, as a consequence of which it considered certain prior art to be of greater significance than had the local division, whose decision it reversed on the basis that it considered it was more likely than not that the patent lacked inventive step. As the Court of Appeal subsequently stated in *VusionGroup (formerly SES-Imagotag) v Hanshow* (CoA 13 May 2024), when upholding the view of the Munich local division that it was more likely than not that there was no infringement:

“26. In its order in the *10X and Harvard/Nanostring* case (UPC_CoA_335/2023 App_576355/2023), the UPC Court of Appeal has adopted the following standard for the interpretation of patent claims.

- i. The UPC Court of Appeal proceeds from the following principles in accordance with Art. 69 of the Convention on the Grant of European Patents (EPC) and the Protocol on its Interpretation.
- ii. The patent claim is not only the starting point, but the decisive basis for determining the protective scope of the European patent.
- iii. The interpretation of a patent claim does not depend solely on the strict, literal meaning of the wording used. Rather, the description and the drawings must always be used as explanatory aids for the interpretation of the patent claim and not only to resolve any ambiguities in the patent claim.
- iv. However, this does not mean that the patent claim serves only as a guideline and that its subject-matter may extend to what, from a consideration of the description and drawings, the patent proprietor has contemplated.
- v. The patent claim is to be interpreted from the point of view of a person skilled in the art.
- vi. In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.
- vii. These principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent. This follows from the function of the patent claims, which under the European Patent Convention serve to define the scope of protection of the patent under Art. 69 EPC and thus the rights of the patent proprietor in the designated Contracting States under Art. 64 EPC, taking into account the conditions for patentability under Art. 52 to 57 EPC.”

However, in *VusionGroup*, the Court of Appeal, whilst agreeing with the conclusions of the Munich local division, did not find it necessary to follow one controversial aspect of its reasoning, namely its reliance on the scope of the corresponding claim as in the original application. Instead, the Court of Appeal relied on the discussions of the embodiments in the description of the patent for its interpretation of the claim.

Many subsequent UPC decisions have cited the Court of Appeal decision, and in one of the first decisions on the merits the central division, in *Sanofi-Aventis v Amgen* (Munich CD 16 July 2024) has gone on to elaborate on what the Court of Appeal said:

“6.6 When interpreting a patent claim, the person skilled in the art does not apply a philological understanding, but determines the technical meaning of the terms used with the aid of the description and the drawings. A feature in a patent claim is always to be interpreted in light of the claim as a whole (CoA UPC 13 May 2024, *VusionGroup/Hanshow*, point 29). From the function of the individual features in the context of the patent claim as a whole, it must be deduced

which technical function these features actually have individually and as a whole. The description and the drawings may show that the patent specification defines terms independently and, in this respect, may represent a patent’s own lexicon. Even if terms used in the patent deviate from general usage, it may therefore be that ultimately the meaning of the terms resulting from the patent specification is authoritative.”

Procedural Matters

Hundreds of procedural orders have been made by the various divisions of the UPC in its first year of operation, some of which also have been considered by the Court of Appeal. These have concerned a wide range of matters, including service of proceedings, the calculation of time limits, the provision of security for costs, scheduling, disclosure of documents and the establishment of confidentiality regimes.

In two particular areas of procedure, those of access to submissions and language of proceedings, the Court of Appeal has ruled so as to impose some consistency, where different local divisions of the Court had previously adopted differing approaches to the question. In another area of procedure, that of staying proceedings pending the outcome of an opposition in the EPO, the Court of Appeal has, in *Carrier v BITZER Electronics* (CoA 28 May 2024) confirmed the practice of the central division in this case (Paris CD 8 January 2024) and in *Astellas v Helios* (Munich CD 20 November 2023), that, as a general principle, the Court will not stay its proceedings unless a decision from the EPO is imminent. Given the speed to trial in the UPC, such cases are likely to be rare, even in the light of the EPO practice of accelerating proceedings where there are parallel ones in the UPC or national courts.

Most decisions and orders are publicly available on the UPC website, but the submissions of the parties are only available to those third parties who make a “reasoned request” (filed by an authorised representative) under R.262.1(b) of the UPC Rules of Procedure. After some rather restrictive interpretations by some local divisions as to what constituted a “reasoned request”, the Court of Appeal in *Ocado v Stothers* (CoA 10 April 2024) upheld the more permissive approach of the Nordic-Baltic regional division at first instance and ordered access to the statement of claim in proceedings which had settled where the “reasoned request” was of a general nature, noting that once proceedings have come to an end, the balance between the interests of the public in getting access to the written pleadings and evidence, as against the interests mentioned in Art. 45 UPCA, such as the protection of confidential information and personal data, as well as the general interest of justice, including the protection of the integrity of the proceedings, is usually in favour of allowing access to non-confidential information. Subsequently, and applying the principles set out by the Court of Appeal, the central division in *NJOY v Juul* (Paris CD 24 April 2024) granted access to various documents from the case file of an ongoing action to a third party which was opposing the patent in suit at the EPO, noting the greater public interest in a revocation action than in infringement proceedings, because the existence of an invalid patent “constitutes an objectively unjustified impediment to competition”.

Where English is the language of the patent, applications to change the language of proceedings to English have often succeeded. This has particularly been the case since the decision of the Court of Appeal in *10x Genomics v Curio* (CoA 17 April 2024), a dispute between two US companies, which set aside the order of the Dusseldorf local division and ordered that the

language of proceedings be changed from German to English. In so doing, it held that: “When deciding on a request to change the language of proceedings into the language of the patent on grounds of fairness, all relevant circumstances shall be taken into account. Relevant circumstances should primarily be related to the specific case and the position of the parties, in particular the position of the defendant. If the outcome of balancing of interests is equal, the position of the defendant is the decisive factor.”

Before the UPC started, one concern amongst practitioners had been the scope that the UPCA provided for bifurcation as between the central and local divisions of the UPC as to issues of infringement and validity. In German proceedings, the consequence of such bifurcation is that an infringement action can be brought to trial much more quickly than a nullity proceeding, with the risk that a final injunction might be granted on a patent that is subsequently held to be invalid – the so-called “injunction gap”. Experience so far suggests that this should not be a concern for the UPC. Local divisions in which infringement proceedings have been brought have shown no great inclination to transfer revocation counterclaims to the central division as is permitted by the rules, as in *MED-EL v Advanced Bionics* (Mannheim LD 10 July 2024), where the Court only ordered bifurcation “by way of exception ... because almost all attacks against the patent in suit contained in the nullity counterclaim are also already asserted in the previously filed central nullity action”. Indeed, in two cases where bifurcation has occurred, in one by accident (*Sanofi-Aventis v Amgen* (Munich CD 24 August 2024)), and the other by design (*Meril Italy srl v Edwards* (Paris CD 13 November 2023)), where an associated company of the defendant to an existing infringement claim started a free-standing revocation action, the hearing of the revocation actions and counterclaims has taken place before any determination as to infringement.

Conclusions

As was to be expected given the recognised quality of its judiciary, the UPC in its first year has already established its reputation for sound, generally well-reasoned decisions. Although

in some areas, and especially those where there is EPO Enlarged Board of Appeal case law, the UPC seems content to adopt EPO law, it is also starting to establish its own body of substantive law as to claim construction and inventive step – the area of claim construction being one as to which there is currently controversy in the EPO, as evidenced by the current referral to the Enlarged Board in G1/24.

The ready availability of provisional measures, at least as compared with some national jurisdictions, also makes the UPC an attractive forum in appropriate cases. The careful scrutiny which the Court undertakes in such applications of the main aspects of the case also has the benefit of giving the parties an early neutral insight into those issues which might prove determinative when a successful patentee, as it must, subsequently commences an action on the merits, and so may contribute to settlement. The UPC procedure has also been shown to be such as can indeed bring a dispute to a full hearing on the merits, as to both infringement and validity, within a year from service of proceedings, after which the Court has been able to give decisions without undue delay. The only real problem with the UPC seems to be with its Case Management System, use of which is obligatory, with the multiple workflows that it generates for each case, the management of which imposes a significant staffing overhead on practitioners (and, it seems, the judges). The UPC authorities are well aware of such problems and indeed, on 19 July 2024 announced cooperation with the EPO to establish a new Case Management System which it is hoped will be up and running by mid-2025.

Now that the UPC has found its feet, it will be interesting to see how its case load ramps up in the years to come, especially given that several times the amount of patent litigation that it is currently handling continues for now to proceed in national courts in those EU Member States that have already ratified the UPC. Will it be able to maintain its quality and speed as its case load increases and, assuming that it can, will such quality and speed, amplified by the extensive geographic reach of its decisions, compensate for the level of fees, the risk of having to pay substantial costs to the winning party if one loses and the problems (but hopefully for not much longer) with the current Case Management System?



Trevor Cook is an English solicitor with over 40 years' experience in IP, in particular global patent litigation. He also advises on life sciences regulatory law. Mr. Cook is Of Counsel at Bird & Bird LLP. He was previously a partner at Bird & Bird LLP from 1981 to 2013 and in Wilmer Cutler Pickering Hale & Dorr LLP from 2014 to 2022. He chairs the British Copyright Council and was for several years President of the UK group of the International Association for the Protection of Intellectual Property (AIPPI). He is on the World Intellectual Property Organization (WIPO) list of arbitrators.

In addition to countless articles and book chapters, Mr. Cook has authored the following books: *A User's Guide to Patents; Pharmaceuticals Biotechnology and the Law; EU Intellectual Property Law; A European Perspective as to the Extent to Which Experimental Use, and Certain Other, Defences to Patent Infringement, Apply to Differing Types of Research;* and *The Protection of Regulatory Data in the Pharmaceutical and Other Sectors*. He is co-author of *Practical Intellectual Property Precedents and International Intellectual Property Arbitration*. He is a general editor of *The Modern Law of Patents* and is editor of: *Sterling on World Copyright Law; Trade Secret Protection – A Global Guide;* and *The Patent Litigation Law Review*.

Bird & Bird LLP
12 New Fetter Lane
London, EC4A 1JP
United Kingdom

Tel: +44 20 7415 6000
Email: trevor.cook@twobirds.com
LinkedIn: www.linkedin.com/in/trevor-cook-6254b510

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