



Unified Patent Court  
Einheitliches Patentgericht  
Juridiction unifiée du brevet

# The Unified Patent Court (UPC): State of Play 15 Months after its Launch

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International Symposium, Tokyo, 13 September 2024

All written and said is my personal view and not a communication of the UPC Court of Appeal.

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# **I. State of Play until 31 May 2023**

- Before 1977:
  - Only national patents are granted by national patent offices in Europe.
- Since 1977
  - **European Patents (EP) are granted in a centralized procedure by the European Patent Office (one stop shop).**
    - 38 Contracting States, including all 27 EU Member States and 11 other non-EU Member States

### “Bundle patent”

- The EP has **the effect of a national patent** in each Member State, Art. 2(2), 64(1) EPC
  - Validation and maintenance state-by-state
  - In practice, enforcement state-by-state.

## **II. State of Play as of 1 June 2023 (Entering into force of the UPC Agreement)**

## 1 June 2023

- **Agreement on a Unified Patent Court of 19 February 2013** entered into force.
  - **Establishment of the Unified Patent Court (UPC).**
- **Regulations (EU) No 1257/2012 and No 1260/2012 of 17 December 2012** became applicable.
  - **Creation of unitary patent protection (European patent with unitary effect = Unitary patent)**

## Unitary patent

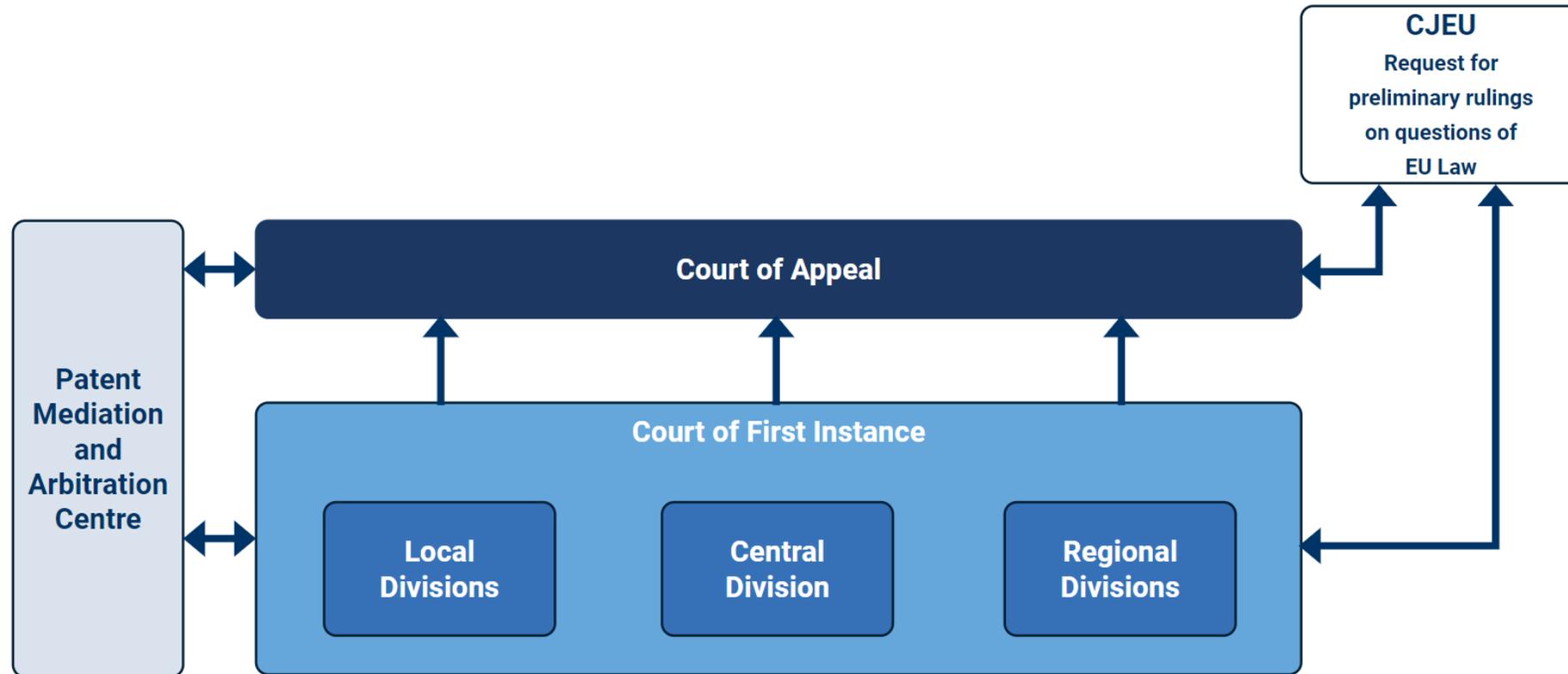
- **Building on the centralised EP granting procedure at the EPO.**
- **Request after grant of the EP within one month.**
- **Validation and maintenance only at the EPO.**
- **Unitary protection throughout the territory of all UPC-States.**
- **Requests for a Unitary patent registered (2.8.2024): 32 825**
  - **Languages: EN (74.5 %), DE (20.0 %), FR (5.5 %)**
- **Uptake rate (25.8.2024): 24.7 % / Uptake rate EPO States: 35.0 %**

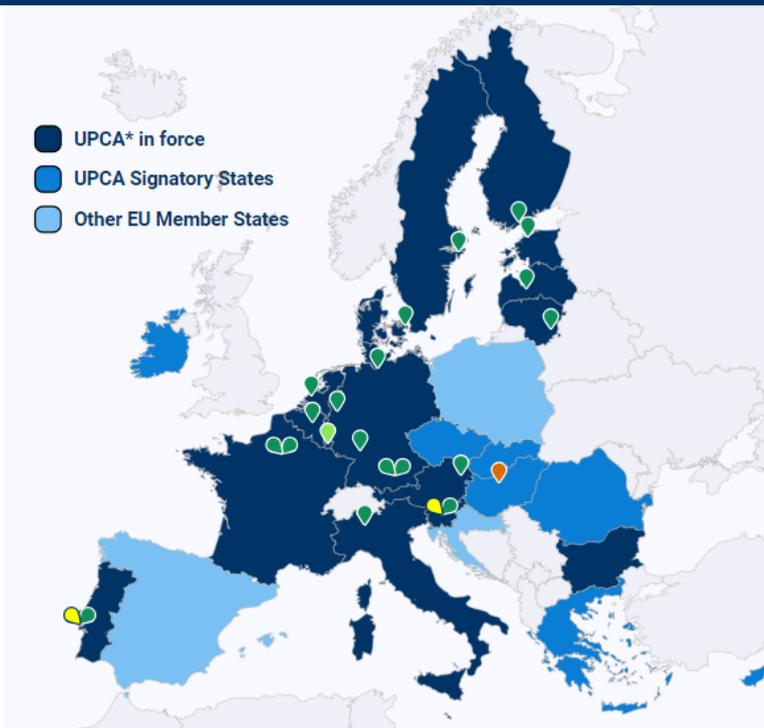
## Unified Patent Court

- **Court common to (currently 17) EU Member States**
  - **AT, BE, BG, DE, DK, EE, FI, FR, IT, LV, LT, LU, MT, NL, PT, SL, SE.**
  - **RO ratified the UPCA and is a UPC member state as of 1 September 2024.**

## Unified Patent Court

- **Jurisdiction on the validity and infringements of**
  - **European Patents with Unitary Effect (Unitary Patents)**
  - **European Patents (Bundle Patents)**
    - **that have not been opted-out**





\* UPCA stands for "Agreement on a Unified Patent Court"

**Show location types**

- Court of Appeal
- Court of First Instance
- Training Centre
- Patent Mediation and Arbitration Centre

**Select a Member State below to learn more**

- |  |   |  |
|--|---|--|
| <span style="color: darkblue;">●</span> Austria  | <span style="color: darkblue;">●</span> Latvia      | <span style="color: blue;">●</span> Czech Republic |
| <span style="color: darkblue;">●</span> Belgium  | <span style="color: darkblue;">●</span> Lithuania   | <span style="color: blue;">●</span> Greece         |
| <span style="color: darkblue;">●</span> Bulgaria | <span style="color: darkblue;">●</span> Luxembourg  | <span style="color: blue;">●</span> Hungary        |
| <span style="color: darkblue;">●</span> Denmark  | <span style="color: darkblue;">●</span> Malta       | <span style="color: blue;">●</span> Ireland        |
| <span style="color: darkblue;">●</span> Estonia  | <span style="color: darkblue;">●</span> Netherlands | <span style="color: blue;">●</span> Romania        |
| <span style="color: darkblue;">●</span> Finland  | <span style="color: darkblue;">●</span> Portugal    | <span style="color: blue;">●</span> Slovakia       |
| <span style="color: darkblue;">●</span> France   | <span style="color: darkblue;">●</span> Slovenia    | <span style="color: lightblue;">●</span> Croatia   |
| <span style="color: darkblue;">●</span> Germany  | <span style="color: darkblue;">●</span> Sweden      | <span style="color: lightblue;">●</span> Poland    |
| <span style="color: darkblue;">●</span> Italy    | <span style="color: blue;">●</span> Cyprus          | <span style="color: lightblue;">●</span> Spain     |

**Select a Location below to learn more**

- |   |  |   |
|---|--|---|
| <span style="color: lightgreen;">●</span> Luxembourg (LU) | <span style="color: green;">●</span> Copenhagen (DK)/L | <span style="color: green;">●</span> Milan (IT)/L     |
| <span style="color: green;">●</span> Paris (FR)/C         | <span style="color: green;">●</span> Düsseldorf (DE)/L | <span style="color: green;">●</span> Munich (DE)/L    |
| <span style="color: green;">●</span> Munich (DE)/C        | <span style="color: green;">●</span> Hamburg (DE)/L    | <span style="color: green;">●</span> Paris (FR)/L     |
| <span style="color: green;">●</span> Stockholm (SE)/R     | <span style="color: green;">●</span> Helsinki (FI)/L   | <span style="color: green;">●</span> The Hague (NL)/L |
| <span style="color: green;">●</span> Riga (LV)/R          | <span style="color: green;">●</span> Lisbon (PT)/L     | <span style="color: green;">●</span> Vienna (AT)/L    |
| <span style="color: green;">●</span> Tallinn (EE)/R       | <span style="color: green;">●</span> Ljubljana (SI)/L  | <span style="color: yellow;">●</span> Lisbon (PT)     |
| <span style="color: green;">●</span> Vilnius (LT)/R       | <span style="color: green;">●</span> Mannheim (DE)/L   | <span style="color: yellow;">●</span> Ljubljana (SI)  |
| <span style="color: green;">●</span> Brussels (BE)/L      |  | <span style="color: orange;">●</span> Budapest (HU)   |

C: Central division L: Local division R: Regional Division

- **365 cases filed in the Court of First Instance (31 August 2024)**
  - **181 actions for infringement**
    - Local/Regional Divisions
  - **95 counterclaims for revocation**
    - Local/Regional Divisions
  - **43 actions for revocation**
    - Central Division (Paris seat or Milan or Munich section)
  - **2 actions for declaration of non-infringement**
    - Central Division (Paris seat) and Local Division Munich
  - **1 action for damages**
    - Local Division
  - **35 requests for preliminary measures**
    - Local/Regional Divisions
  - **7 requests for preserving evidence**
    - Local/Regional Divisions
  - **1 request for inspection**
    - Local/Regional Division

- **84 appeals, 7 discretionary reviews filed in the Court of Appeal and 1 application for a rehearing (31 August 2024)**
  - **7 appeals pursuant to Rule 220.1(a), (b) RoP**
    - From final decisions or other decisions terminating proceedings
  - **25 appeals pursuant to Rule 220.1 (c) RoP**
    - From orders mainly in preliminary measures, preservation of evidence and change of language cases
  - **52 appeals pursuant to Rule 220.2 RoP**
    - From procedural orders with leave to appeal granted
  - **7 discretionary reviews pursuant to Rule 220.3 RoP**
    - Regarding decisions not to grant leave to appeal a procedural order
  - **1 application for a rehearing pursuant to Rule 245 RoP**

## Central Division

- **Panel of 3 judges**
  - **2 legally qualified judges** from different CMS
  - **1 technically qualified judge**

## Local/Regional Division

- **Panel of 3 or 4 judges**
  - **3 legally qualified judges** partly from and partly not from the CMS hosting the Local Division or from the CMS that share a Regional Division**and, most of the time,**
  - **1 technically qualified judge**  
(to be allocated when a counterclaim for revocation has been filed which has not been referred to the central division for decision [bifurcation] or upon request of a party or on initiative of the panel).

## Court of Appeal

- **Panel of 5 judges**
  - **3 legally qualified judges**
  - **2 technically qualified judges**

## Central Division

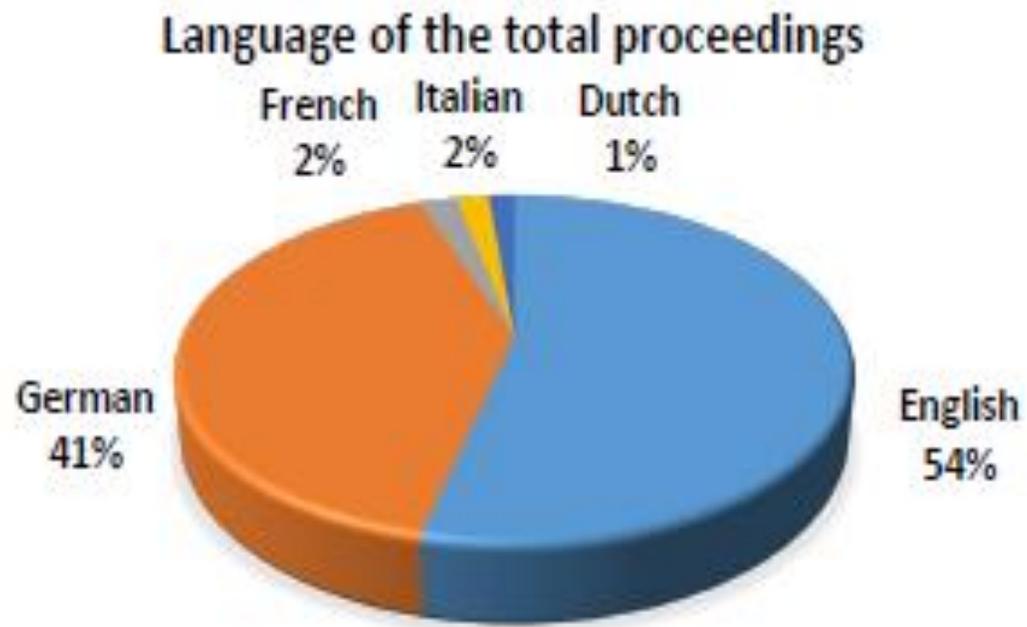
- Language in which the patent concerned was granted.

## Local/Regional Division

- Official language(s) of the CMS hosting a LD or sharing a RD.
- CMS may designate one or more of the official EPO languages. (In practice all CMS designated English.)
- With the agreement of the parties and consent of the panel: the language in which the patent was granted (English, French or German)
- At the request of one party and after having heard the other parties, the CFI President may decide on the language in which the patent was granted.

## Court of Appeal

- Language of proceedings before the CFI.
- Parties may agree on the language in which the patent was granted.
- Exceptionally the CA may decide on another official language of a CMS.



31 August 2024

- **Change of the language of proceedings**, Art. 49(5) UPCA (Court of Appeal, order of 17 April 2024 – Curio Bioscience/10x Genomics )
  - 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.
    - Relevant circumstances might be:
      - Nationality or domicile/seat of the parties,
      - language mostly used in the field of technology,
      - the size of the parties relative to each other,
      - effects of a change of language to the course of the proceedings in relation to delay and urgency of the case, etc.
  - If the outcome of balancing of interests is equal, the position of the defendant is the decisive factor.

- **Stages of proceedings of an EP infringement action**
  - **Written procedure**
    - Front loaded (all relevant facts and evidence relied on have to be submitted).
    - Deadlines for written submissions
  - **Interim procedure**
    - Preparation of oral hearing
    - Exploration of possibilities to settle the case
  - **Oral procedure**
    - Preliminary introduction to the case by the judges possible
    - Pleadings of the parties
      - Time limits may be set in advance
    - Hearing of witnesses and experts. Judges and parties may put questions.
    - Endeavour to complete the oral hearing in one day.

– **Further procedural aspects:**

▪ **Videoconference**

- Oral hearings take place in person but parties and representatives may be allowed to attend the oral hearing by video conference
- Parties, witnesses or experts may be heard by video conference
- Oral hearings may be held by video conference if all parties agree or under exceptional circumstances.

▪ **Public access to the register**

- decisions and orders are published
- written pleadings and evidence are available upon reasoned request by decision of the judge-rapporteur after consulting the parties (see also slide 20)
- A party may request that certain information be kept confidential.

▪ **Protection of confidential information**

- Confidentiality club available
- Representatives and at least one natural person from each party

- Court of Appeal, decision of 10 April 2024 - Ocado/Autostore concerning **public access to the register, R. 262.1(b) RoP:**
  - **Weighing of interests of**
    - the member of the public (MP) to get access to the written pleadings and evidence
    - the interests of one of the parties or other affected persons and the general interest of justice and public order, which includes **the integrity of proceedings.**
  - Access may generally be given to a MP **only after the proceedings have come to an end,**
    - as the interest of a MP usually arises only after a decision was rendered and the integrity of proceedings usually only plays a role during the course of proceedings.
  - A MP may have a **special interest** in getting access,
    - in particular **when the validity of a patent** is the subject-matter of the proceedings and **the MP is accused of infringing the patent.**

- **Preliminary injunction**

**Discretionary decision, R. 211 RoP**

- **Reasonable evidence to satisfy the Court with a sufficient degree of certainty**  
on
  - entitlement of the applicant,
  - infringement of the patent,
  - validity of the patent.
- **Weighing up of interests of the parties**
  - potential harm for either of the parties resulting from the granting or refusal of the injunction,
  - no unreasonable delay in seeking a preliminary injunction,
  - proportionality,
  - etc.

- Court of Appeal order of 26 February 2024 - NanoString/10x Genomics
  - **Standard of proof in preliminary injunction cases**
    - Threshold is **a balance of probabilities**.
    - **Applicant** has to show that **entitlement and infringement of the patent** and any other contested circumstances alleged in supporting the request are **more likely than not**.
    - **Defendant** has to show that **invalidity of the patent** and any other contested circumstances alleged in supporting a rejection of the request are more likely than not.

- Court of Appeal order of 26 February 2024 - NanoString/10x Genomics
  - **Interpretation of patent claims**
    - The patent claim is the decisive basis for determining the protective scope of the patent.
    - Description and drawings must always be used as an explanatory aid.
    - The patent has to be interpreted from the point of view of a person skilled in the art.
    - These principles apply to the assessment of an infringement and the legal validity of a patent alike.

- Court of Appeal order of 26 February 2024 - NanoString/10x Genomics
  - **Inventive Step/Obviousness**
    - It can be **the starting point for the assessment of obviousness** that a piece of prior art would have been of interest to a person skilled in the art (psa), who at the priority date of the patent was seeking to find a solution of the problem underlying the patent.
    - In the case-at-hand the problem underlying the claimed invention was
      - **to develop high-throughput optical multiplexing methods for detecting target molecules in a sample.**

- For a person skilled in the art prior who was seeking to solve this problem one of the pieces of prior art, D6, would have been of interest to the psa, as it describes such a method.
- However, it described the method only for a large number of amplified single molecules (ASMs) stored *in vitro* in an array format.
- Since there was a need for multiplex analysis techniques, especially for test samples, there was **an incentive for the psa** to also consider whether the detection method disclosed in D6 could be transferred to the detection of ASMs *in vivo* in cell or tissue samples which would have brought him to the invention claimed by the patent.

- Court of Appeal, order of 23 July 2024 – Progress/AWM and Schnell
  - **Order to preserve evidence and to inspect premises, Art. 60 UPCA**
    - In the case-at-hand, the Court of First Instance had issued 2 orders to preserve evidence and to inspect premises of the respondents to be carried out by court-appointed experts and a bailiff.
    - The orders were executed on respondents' premises and the experts lodged their reports in sealed envelopes also containing the official report of the bailiff and the evidence gathered during the inspection with the court.
    - 4 months later, the applicant filed a request for access to the expert reports.
    - The Court of First Instance rejected the request.
    - The Court of Appeal set the order aside and referred the case back to the Court of First Instance.

The Court of Appeal held the following:

- The application for an order to preserve evidence and to inspect premises implies a **request to disclose to the applicant the outcome of the measures, including a report** written by the person who carried (e.g. an expert, a bailiff, etc.) out the measures.
- However, the order must be subject to **the protection of confidential information.**
- This entails that the Court must **hear the other party** before deciding whether and to what extent **the evidence (in particular the report) is disclosed to the applicant.**
- **If the other party makes a confidentiality request** (e.g. that certain information in the report is deleted) **the applicant must be provided with an opportunity to respond in a manner that respects the potential confidentiality interests of the other party**, e.g. by granting access to the evidence (in particular the report) only to the representatives of the applicant subject to appropriate terms of non-disclosure.
- The Court of Appeal referred the case back to the Court of First Instance so that it can proceed as described.

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Thank you for your attention

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