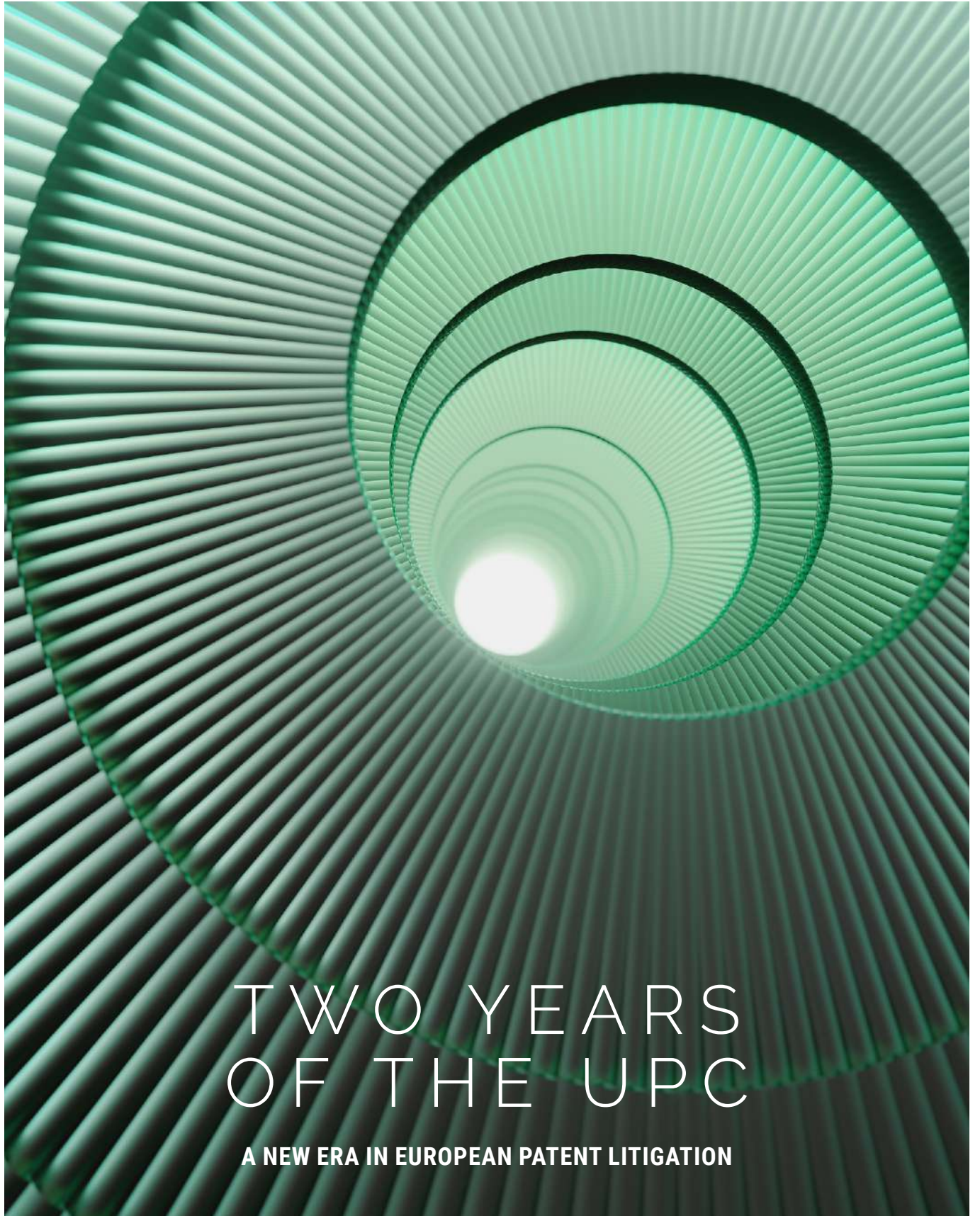


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TWO YEARS OF THE UPC

A NEW ERA IN EUROPEAN PATENT LITIGATION

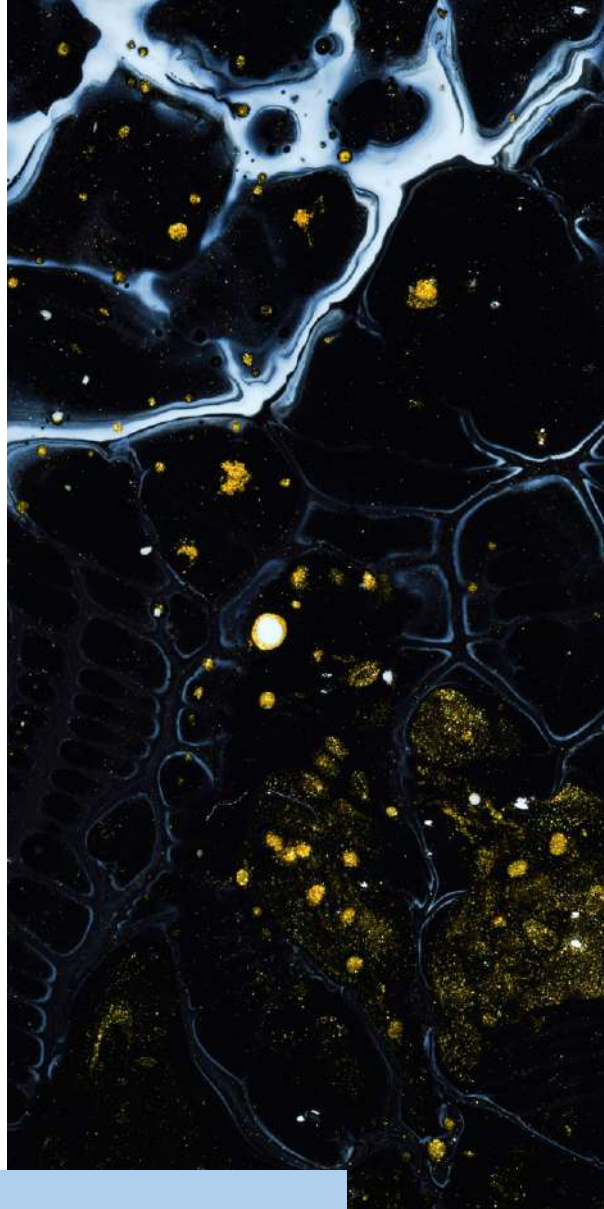
JUNE 2025

TWO YEARS OF THE UPC:
A NEW ERA IN EUROPEAN PATENT LITIGATION

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TABLE OF CONTENT



INTRODUCTION

Page 5

CHAPTER I

WHAT THE STATISTICS SHOW

Page 6

CHAPTER II
JURISDICTION
Page 12

CHAPTER III
LANGUAGE REGIME
Page 15

CHAPTER IV
PARALLEL
PROCEEDINGS –
BIFURCATION –
STAY
Page 16

CHAPTER V
CLAIM CONSTRUCTION
AND INFRINGEMENT
Page 19

CHAPTER VI
CLAIMS ARISING
FROM INFRINGEMENT
Page 23

CHAPTER VII
PRIOR USE
Page 31

CHAPTER VIII
PRELIMINARY
INJUNCTIONS (PIs)
Page 32

CHAPTER IX
VALIDITY
Page 39

CHAPTER X
PRESERVING
EVIDENCE
Page 45

CHAPTER XI
CONFIDENTIALITY
ISSUES
Page 48

CHAPTER XII
FRAND
Page 51

CHAPTER XIII
COSTS
Page 55

CHAPTER XIV
APPEAL
Page 58

The background is a complex, abstract pattern. It features a dark, almost black, base color. Overlaid on this are intricate, swirling, and cell-like structures in a deep blue or navy color. Scattered throughout these structures and the background are numerous small, bright gold or yellow particles, some of which are larger and more concentrated, creating a sense of depth and texture. The overall effect is reminiscent of a microscopic view of a material or a celestial nebula.

INNOVATE FEARLESSLY,
PROTECT SEAMLESSLY.

INTRODUCTION

It's now been two years since the Unified Patent Court (UPC) opened its doors on June 1, 2023. The same date also marked the introduction of the new unitary patent (UP) with effect across all 18 countries participating in the UPC at the time of grant.

The start of the UPC has caused a major shift in the landscape of European patent litigation. The numbers speak for themselves: More than 300 infringement cases, most involving a counterclaim for invalidity, and a further 60+ standalone revocation actions. By all indications, the new system is highly attractive, offering as it does the opportunity to obtain remedies across a large part of Europe. And it benefits from the extraordinary quality and skill of the legal and technical UPC judges. Judgments are often rendered within 15 months, making the UPC a true "rocket docket".

Germany is clearly the center of action, accounting for the majority of all infringement cases by far. Especially the Local Division Munich has turned out to be a "go to" court.

From day one, Grünecker has represented its clients before the UPC. We now celebrate the UPC's second birthday by providing some guidance based on relevant case law that has evolved over the past two years. Some decisions may be known to you, others will be new. The presentation is not intended to be exhaustive or definitive, nor can it be given the limited capacity of a slim booklet and the ongoing development of the field. But even two years is enough to discern first trends, justifying the aim of providing an overview of court practice thus far. We look forward to counselling you in any questions you may have.

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CHAPTER

WHAT THE STATISTICS SHOW

When the Unified Patent Court ("UPC") launched in June 2023, expectations were high. Two years later, the numbers speak for themselves. By the end of April 2025, the court had received 836 proceedings – a remarkable docket for a new European institution. It is already

clear that users are not simply testing the waters, but actively integrating the UPC into their litigation strategies. With each published case, the contours of this new legal forum become more defined and more transparent, which may increase the attractiveness of this venue.



*THE UPC HAS ESTABLISHED ITS
ROLE AS AN IMPORTANT PART OF THE
EUROPEAN LITIGATION LANDSCAPE [...]*

1. SHIFTING DYNAMICS IN PATENT LITIGATION

The UPC has not replaced national courts, but it has certainly changed the landscape. Litigants now have new strategic options, and the data shows that many are seizing them. The available figures indicate a measurable shift of national proceedings toward the UPC, with a noticeable decrease the former.

Looking at the sheer numbers of cases, the German Local Divisions ("LDs") of the UPC have emerged as central venues. By April 2025, 232 of 305 UPC infringement actions (approximately 76%) were filed in Germany. Munich leads with 103 cases, followed by Düsseldorf (63), Mannheim (43), and Hamburg (23). Rather than turning away from Germany, parties are using its familiar legal environment within the new UPC framework. The UPC has established its role as an important part of the European litigation landscape, particularly in cross-border constellations and complex enforcement campaigns.

2. MONTHLY CASE LOAD UPDATES

The UPC regularly publishes updates on its docket, offering more or less real-time insight into how the court is being used. As of 30 April 2025, the court of First Instance had received:

- 305 infringement actions
- 292 counterclaims for revocation (corresponding to 167 underlying infringement cases)
- 61 standalone revocation actions
- 82 applications for provisional measures

The fact that the number of counterclaims for revocation exceeds the number of underlying infringement actions is due to earlier procedural requirements. Initially, each defendant had to file a separate counterclaim, even when responding to the same action.

Not every defendant, however, filed a counterclaim for revocation, which is why the number of infringement actions also exceeds the number of counterclaims. Some cases may also have been settled or withdrawn before a counterclaim was filed.

In terms of language, English dominates with 55% of proceedings, followed by German (38%). While German led in the court's early months, English has since overtaken German. Small percentages of cases are conducted in French (3%), Italian (2%), Danish (1%), and Dutch (1%).

This distribution aligns with the multinational scope of the Court and suggests a trend towards English as the *de facto* procedural language, contributing to the UPC becoming an international court.

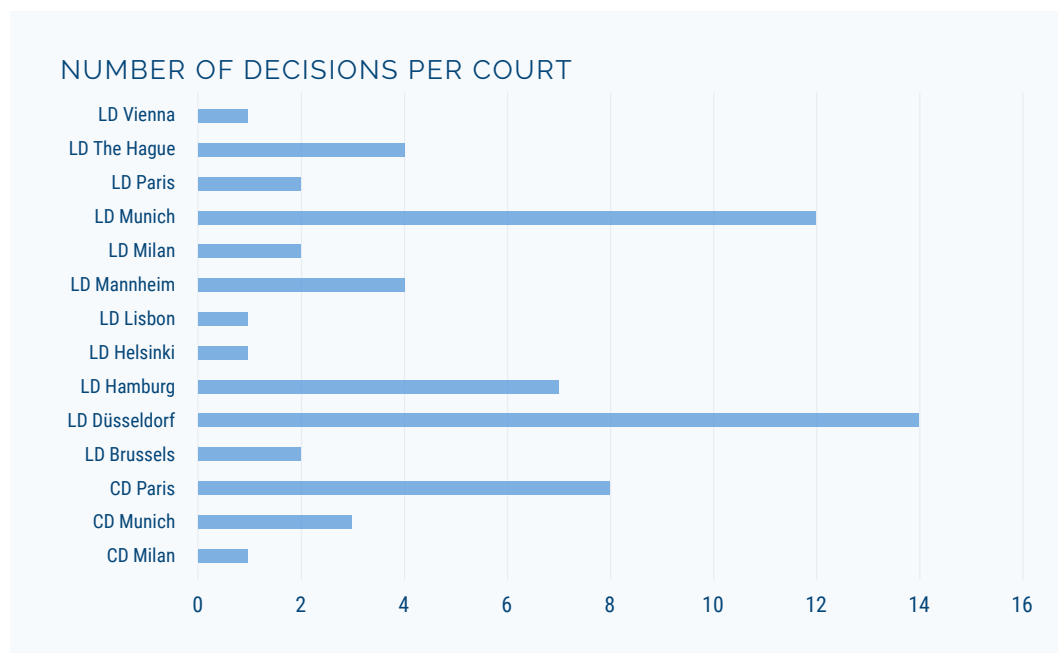
The Court of Appeal ("CoA") has already addressed a substantial number of procedural appeals. Substantive appeals are still limited, as first instance decisions on the merits have only recently begun to issue.

3. FIRST INSIGHTS FROM SUBSTANTIVE RULINGS

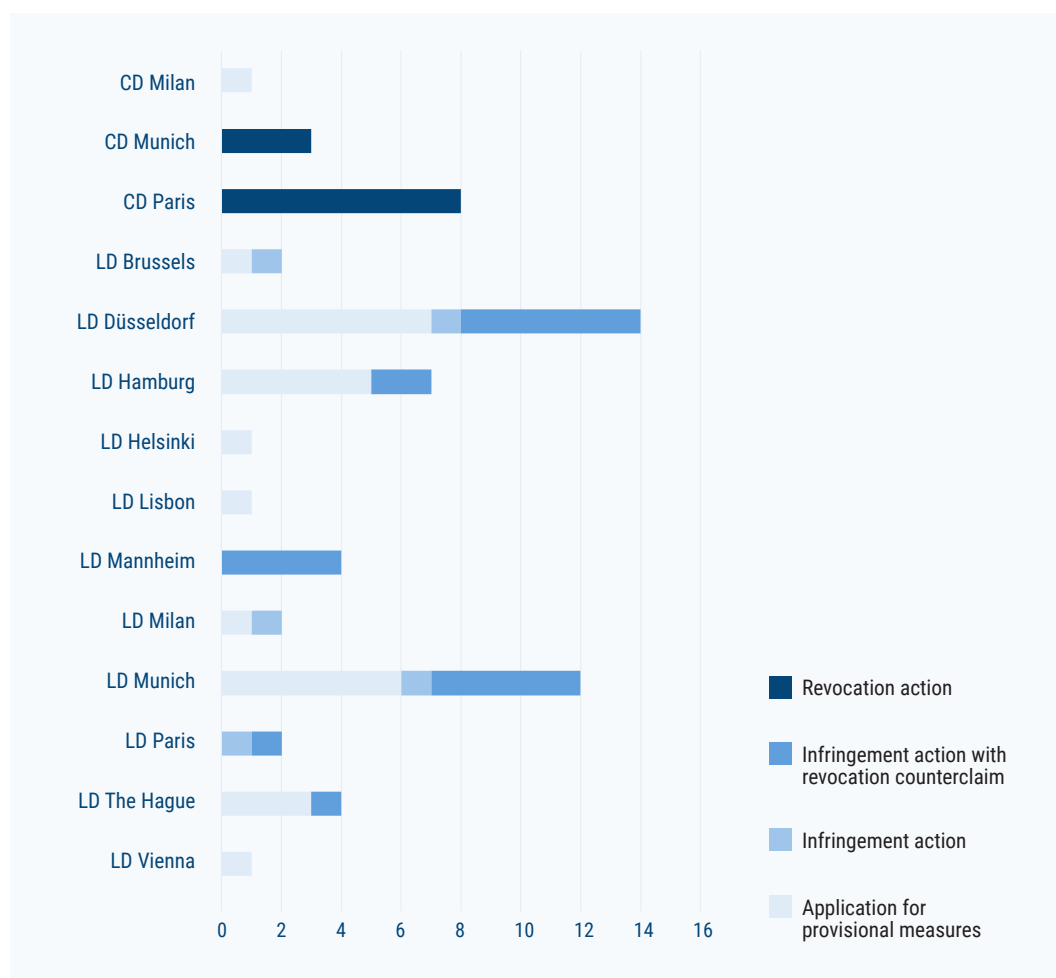
For those observing or considering litigation before the court, the growing number of published decisions provides a valuable first look at how the UPC is applying its rules and shaping its case law. To understand how proceedings are currently being resolved, we reviewed 62 first instance decisions to the end of April 2025, all of which contain a decision on the merits. These include infringement actions (both with and without counterclaims for revocation), standalone revocation actions and applications for provisional measures. Procedural rulings were disregarded. We also reviewed eight substantive decisions from the court of Appeal, all of which to date concern provisional measures.

3.1 GEOGRAPHIC DISTRIBUTION OF DECISIONS

The distribution of published decisions closely reflects the overall caseload seen at the UPC, with a clear concentration in Germany. Most decisions originate from the LDs in Düsseldorf and Munich, followed by Hamburg, Mannheim and the CD Central Division ("CD") Paris:



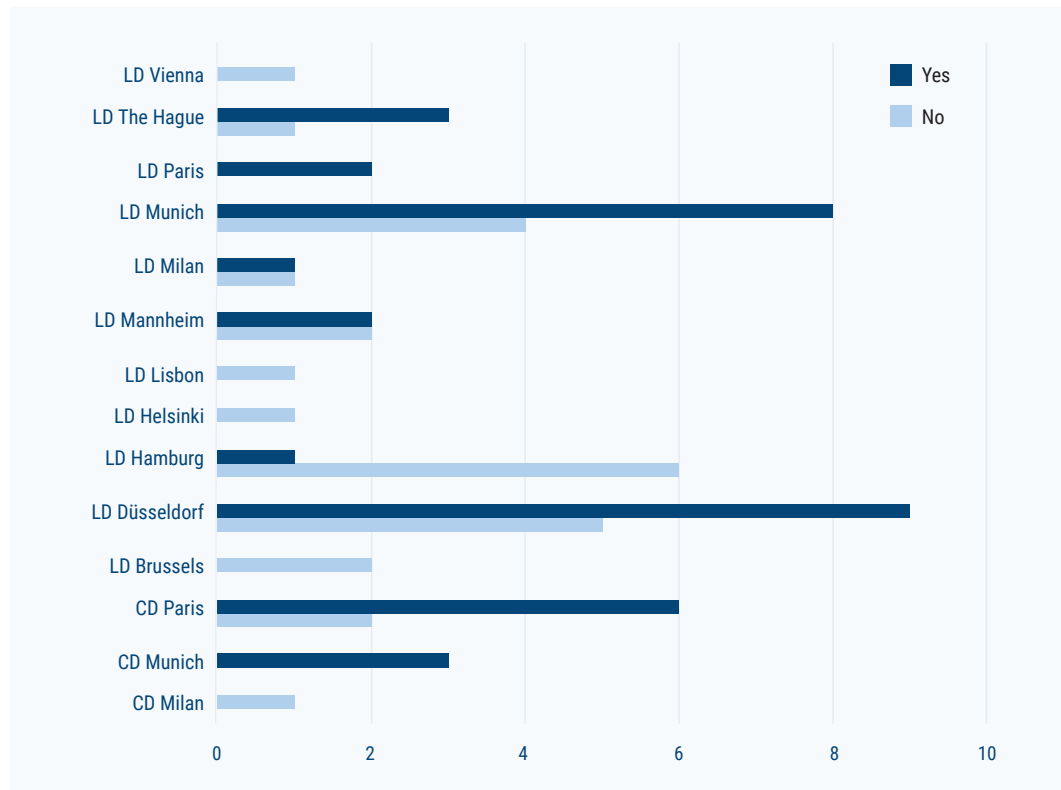
In addition to geographic spread, it is also worth noting the distribution of decisions by type of action across the venues. Most of the published decisions still concern applications for provisional measures, which make up 27 out of the 62 rulings. Infringement actions with counterclaims for revocation account for 19 decisions, standalone revocation actions for 11, and pure infringement actions for just 5:



3.2 CLAIMANT SUCCESS RATE

A central question in every litigation strategy is the likelihood of success. In the decisions reviewed, the claimants prevailed in 56 % of all first instance cases. This figure includes both patentees and revocation applicants, depending on the nature of the proceedings.

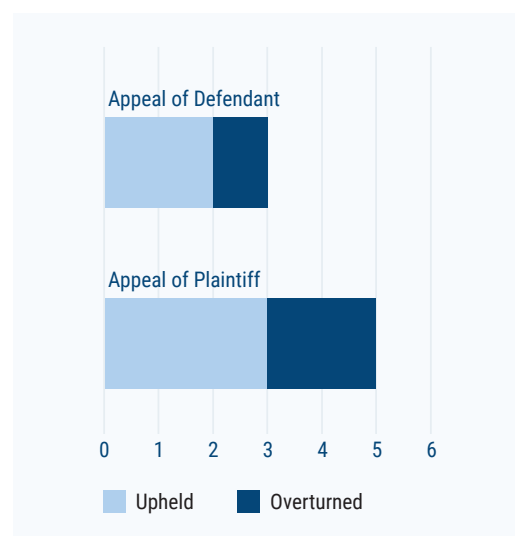
The following chart presents claimant success rates across divisions, with "Yes" indicating a successful outcome for the claimant - whether in an infringement action or in a standalone revocation proceeding:



As the chart above shows, some LDs – such as Düsseldorf and Munich – account for a higher number of published decisions and show a relatively balanced outcome profile. In contrast, other divisions have so far published only one or two decisions. At this stage, no conclusions can be drawn as to whether certain venues are more favorable to patentees than others.

3.3 APPEALS

Since the UPC began operating only in mid-2023, decisions from the CoA are still limited. So far, eight appeal decisions on the merits have been published. In three of these cases, the decision at first instance was overturned, while in the remaining five it was upheld, indicating a roughly balanced outcome:

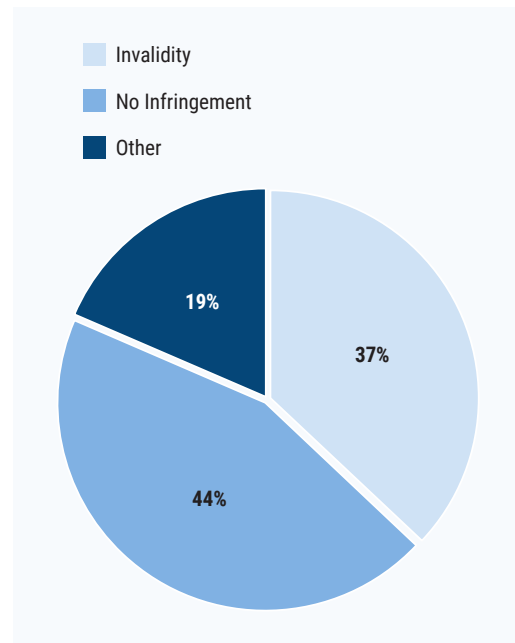


3.4 OUTCOME PATTERNS IN UNSUCCESSFUL CASES

Among the reviewed decisions in infringement and PI proceedings, the main reasons for unsuccessful outcomes are relatively evenly split between non-infringement and invalidity findings, with a slight tilt toward the former.

The higher proportion may be explained in part by the fact that in several infringement cases, the defendant did not challenge the validity of the patent i.e. raise a counterclaim for revocation.

A smaller number of cases were dismissed for procedural reasons, such as lack of urgency in PI proceedings.



3.5 DURATION OF PROCEEDINGS

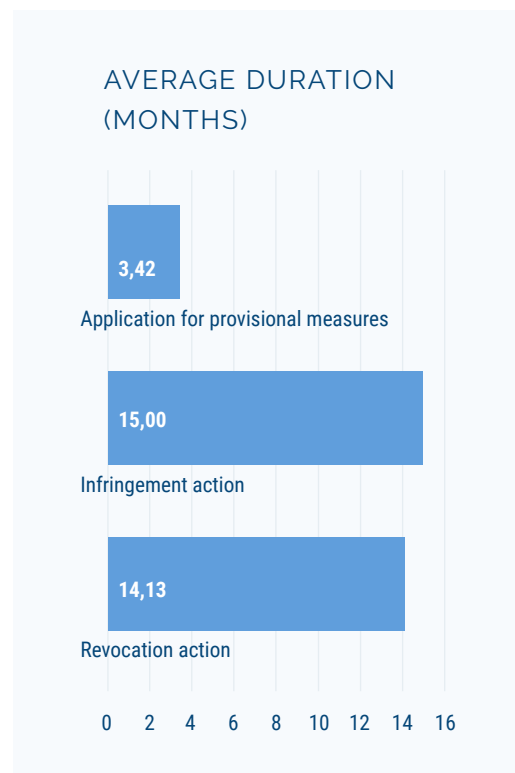
Another interesting aspect is the duration of proceedings. The UPC was introduced with the promise of a streamlined and fast-paced system. Under the Rules of Procedure, a decision on the merits in infringement cases is generally expected within one year from filing.

While not all decisions are published with corresponding procedural dates, available information suggests that the court is broadly in line with its expected timelines:

4. OUTLOOK

The available decisions already offer a solid first impression of how the UPC is operating in practice. While the overall number remains limited, the reasoning is generally consistent and procedurally sound.

With time, and as more decisions are published, particularly those on the merits at the appellate level, it will become possible to assess more precisely how the court differentiates in its application of legal standards. This will also allow for a more informed evaluation of whether the expectations placed on the system with regard to consistency, outcomes and duration are being met.



CHAPTER



JURISDICTION



At the start, the UPC was known to "merely" have jurisdiction for all European patents without regard to either unitary character or filing date pre- or post-dating the UPC's inception. In the meantime, it has been established that this jurisdiction can extend also to non-UPC countries:

The UPC indeed has jurisdiction for European patents which are older than the UPC, but not for those which have lapsed before June, 1, 2023. In *Fujifilm v. Kodak*¹, the Local Division (LD) Mannheim held that the UPC has no jurisdiction over national parts of a European patent that had already lapsed before June 1, 2023, regardless of whether the national part is in a UPCA member state or not. Any claims relating to such lapsed patents must be asserted before national courts. The decision is grounded in Article 3(c) UPCA, which vests UPC jurisdiction only over European patents that have not lapsed as of the UPCA's entry into force. The court interpreted "any European patent" in Article 3(c) UPCA as referring specifically to each national part still in force on June 1, 2023. The court emphasized that the UPCA was intended to harmonize future patent litigation and not to retroactively affect lapsed national parts. Thus, the UPC's jurisdiction is limited to patents (or national parts) still in force at the time the UPC opened its doors. Legal commentaries and reports agree.

There was, and to some extent still is, discussion with respect to SEPs. Of course the UPC has jurisdiction for the FRAND defense. The LD Mannheim, however, has established that the UPC also has jurisdiction for FRAND counterclaims, i.e. claims for a license, in *Panasonic v. Oppo*². It is unfortunate that in the end all of the many auxiliary motions of the counterclaim were dismissed. Yet it appears that the LD would be willing to hear creative motions, effectively making the court decide on what it considers to be a FRAND royalty rate. We expect that the decisions by the other LDs will not substantially differ. It is the position of willingness which will be critical. Should the LDs also require "willingness" in the way they do so far, or for an implementer to have a sufficient interest in counterclaim for a specific royalty, counterclaims will be dismissed as is the traditional FRAND defense. While the UPC does not contest the FRAND defense as such, the defense has been dismissed every time due to the facts of the specific case.

The *Panasonic v. Oppo* decision³ is silent on the possibility to file corresponding motions without first having been sued by the patentee or a licensee. Doubts in this regard are substantial given the wording of Art. 32(1) (a) UPCA, even though one hears rumors that judges

are considering to accept jurisdiction in such constellations as well. For the time being, we urge caution in assuming jurisdiction too lightly. This is reflected by, for instance, Samsung having chosen the German District Court of Frankfurt to pursue an isolated claim for a FRAND license against ZTE.

The *Panasonic v. Oppo* decision is likewise silent on an interim license as has been granted in the UK in *Lenovo v. Ericsson* and *Panasonic v. Xiaomi*⁴. Given that in most cases the decision on injunctive relief and on the FRAND counterclaim will be issued simultaneously, any need for such interim license will in any case be small.

Cross border litigation is back with the decision of the CJEU in *BSH v. Electrolux*⁵. This decision - and no longer *Gat v. Luk*⁶ - is the precedent. In its recent decision, the CJEU ruled that the national court of domicile has jurisdiction not only for infringement of the "part" of the European patent in that particular member state but also for all other national parts. From that, the UPC has rightly concluded that the LD of domicile can also decide on infringement of the parts of a European patent in non-UPCA member states like Spain and Poland - and even non-EU states like the UK or Turkey.

The CJEU made discussions on this issue by the UPC in other cases (for instance in *Fujifilm v. Kodak*⁷ confirming jurisdiction of the UPC for the British part of a European patent) moot. While the interpretation of Art. 71a and 71b Brussels Ibis Regulation may be worth discussing on a scholarly level, practitioners now have a clear guideline.

It is noteworthy that the decision of the CJEU in *BSH vs. Electrolux* has impact on national European courts as well. Also those courts benefit from the CJEU decision. They also have jurisdiction for deciding on infringement of the national patents in other countries. The consequences can be substantial. Instead of filing an infringement litigation in the UPC, a patentee might opt to file in the national court of the domicile of the defendant.

¹ *Fujifilm v. Kodak*, LD Mannheim, UPC_CFL_365/2023, April 2, 2025, (Link).

² *Panasonic v. Oppo*, LD Mannheim, UPC_CFL_210/2023, November 22, 2024, (Link).

³ *Panasonic v. Oppo*, LD Mannheim, UPC_CFL_210/2023, November 22, 2024, (Link).

⁴ [2025] EWCA Civ. 182, *Lenovo v. Ericsson*; [2024] EWCA *Panasonic v. Xiaomi*.

⁵ *BSH v. Electrolux*, CJEU, C-339/22, February 25, 2025, GRUR 2025, 568.

⁶ *Gat v. Luk*, CJEU, C-4/03, July 13, 2006, GRUR 2007, 49.

⁷ *Fujifilm v. Kodak*, LD Düsseldorf, UPC_CFL_355/2023, January 28, 2025, (Link).

Still, standards will need to be established describing the requirements for a stay of an infringement action pending before the UPC based on a patent which is challenged on a national level only.

Also up for a final decision is how to handle a situation where the territories for injunctive relief and revocation are not identical. This was the fact pattern in the above *Fujifilm v. Kodak*⁸ decision. Infringement of the national parts of a European Patent, including the German part and the UK part, was pleaded before the UPC. There was – rightfully – a counterclaim only for revocation with respect to UPC Member States, but not for the UK part. And there was no national nullity action in the UK. The UPCA found for invalidity. As a result, the infringement suit was of course dismissed for all UPC Member States. For the UK, it would have been feasible to render a decision in favor of the patentee arguing the absence of any attack against validity of the UK part, and that the UPC had no jurisdiction for a revocation of the UK part. The UPC's holding did not follow this thinking.

Rather, the UPC stressed that the validity of the patent in suit is a prerequisite for an injunction. Although lacking jurisdiction to rule on the validity of the UK part of the patent in suit, the UPC deemed it sufficient to state:

*"..., it would have been up to the Claimant to comment specifically on the differences between the Contracting Member States and the UK and to explain why these (possibly) lead to a different assessment of the validity of the UK part of the patent in suit. The Claimant has not done so. It must therefore be assumed that the grounds for invalidity set out in detail above also apply to the UK part of the patent in suit, irrespective of any differences between the Contracting Member States and the United Kingdom. Even if the Court cannot decide on the validity of the UK part of the patent in suit, and certainly cannot revoke that part, the infringement action cannot be successful in such a factual and legal situation."*⁹

While the finding itself may be satisfying, its reasoning is not. It results in the UPC deciding on the validity at least *inter partes*. The UPC also pointed out that there was no room for a stay in the absence of a national revocation action.

Irrespective of which court - UPC or national court - may target another jurisdiction, cross border claims may result in defendants feeling compelled to file – national – nullity actions in all addressed jurisdictions in order to ensure a stay of proceedings. Relying on the CJEU seemingly giving some leeway to the courts, or the above *Fujifilm v. Kodak* decision, will not be considered sufficient to ensure a desired stay.

⁸ *Fujifilm v. Kodak*, LD Mannheim, UPC_CFI_365/2023, April 2, 2025, ([Link](#)).

⁹ *Fujifilm v. Kodak*, LD Düsseldorf, UPC_CFI_355/2023, January 28, 2025, p. 60 ([Link](#)).

Any consideration of language regime entails statistical and legal aspects.

Looking at the language of the decisions, the majority (548 of the first 1000) is in English. Initially, the overwhelming number of cases was brought in German, however, now only 390 of the first 1000 decisions are in German. Other languages appear to be much less prevalent (26 decisions in French, 22 decisions in Italian, 11 decisions in Dutch and 3 decisions in Danish).

In view of these figures, the complicated rules of the UPCA and the Rules of Procedure (RoP) on the language regime have less impact than expected. It is rather the change of the language regime pursuant to R. 323 RoP which is turning out to be significant.

In September 2024, the CoA found in *Ona v. Apple and Google*¹ that a change of language from the first language of the LD (in that case from German to English) is to be ordered upon request where the parties communicate in English and no party is headquartered in Germany. The fact that national (parallel) litigation was pending in Germany was not given much weight. Concerns had been raised that a change of language to English, at least if that is the language of the patent, should rather be the standard.

Yet in January 2025, in *ParTec v. Nvidia*², the President of Court of First Instance (CFI), Judge Florence Butin, denied a motion by Nvidia to switch the language of proceedings to that of the patent in suit, English. The President emphasized the objective to ensure fair access to justice also for medium-sized companies.

It is difficult to extract a general rule from the above. Nevertheless, it is fair to assume that change of language will be difficult for parties if small and medium-sized parties are involved. The issue of how many judges are available for the language in question might be an issue as well.

¹ *Ona v. Apple and Google*, CoA, UPC_CoA_349/2024, (Link) and UPC_CoA_354/2024, September 18, 2024, (Link).

² *ParTec v. Nvidia*, LD Munich, UPC_CFI_627/2024, January 16, 2025, (Link).

PARALLEL PROCEEDINGS – BIFURCATION – STAY

CHAPTER

IV

Bifurcation has a negative ring when it comes to defendants from countries outside Germany - especially from common law countries. Those who have defended in patent infringement litigation in Germany all seem to have been confronted with one court deciding on validity and another court deciding on infringement (having only the possibility to stay the infringement proceeding if invalidity appears to be rather obvious). It is not that German infringement courts act this way by choice. Rather, bifurcation is embedded in German law. As a consequence, quite a number of defendants have had to endure the so-called "*injunction gap*". This means that an infringement court finds for injunctive relief, renders an enforceable first instance decision, which the claimant enforces, while the defendant is still waiting for the results in the revocation action pending before another court. It is moot to discuss the reasons why the revocation actions are decided later. Attempts have been made to soften the (potential) negative result like a preliminary opinion on validity issued by the court deciding on the revocation action before a hearing in the infringement case. In many cases, however, such a preliminary opinion does not issue in time and one continues to wait in vain until the date of the hearing in the infringement case.

There should be no injunction gap in proceedings before the UPC since infringement suit and counterclaim for revocation should be decided simultaneously. Yet the "German lobby" was successful in pushing for allowance of bifurcation in the UPCA. Art. 33(3) UPCA provides for the possibility to refer a counterclaim for revocation filed in response to an infringement suit before an LD to the CD. The LD can decide to suspend/stay the action for infringement or to proceed with it. (With the agreement of the parties it can even refer the entire case, infringement and revocation, to the CD).

The UPCA considers such a split to be rather the exception. As a rule, infringement and validity shall be decided by one body (LD or CD).

There seems to be have been no precedent so far in which a LD decided to refer the case to the CD matching this rather simple fact pattern described in Art. 33(3) UPCA. There are cases, however, where parallel proceedings were pending regarding validity.

In *Plant-e v. Arkyne*¹, the LD The Hague felt compelled to rule on the issue and decided to not bifurcate even though none of the parties had so requested. The LD The Hague stated that a joint hearing of the infringement action and the counterclaim seemed to be appropriate in particular for reasons of procedural expediency, and avoided the risk of delay that might be involved with bifurcating. The LD The Hague further stated that it was also preferable because it allowed both issues – validity and infringement – to be decided on the basis of a uniform interpretation of the patent by the same panel composed of the same judges. The LD thus merely cited the obvious reasons for not bifurcating. Other LDs tend to decide similarly.

Only under special circumstances will the UPC bifurcate. In *MED-EL v. Advanced Bionics*², the LD Mannheim decided to actually assign a counterclaim for revocation to the CD Paris.

One of the three defendants of the infringement case had filed an isolated revocation action with the CD Paris on September 27, 2023 (served on October 16, 2023). The patentee MED-EL reacted with an infringement suit filed on November 11, 2023 – shortly after service of the isolated revocation action. The infringement suit was directed against the claimant of the isolated revocation action and two affiliated companies. The defendants reacted with a counterclaim for revocation and sought to have the entire case moved to the CD Paris.

In principle, this fact pattern is the one where both actions should be handled by the Local Division. And indeed, the LD Mannheim pointed out:

*In principle, the present panel is of the opinion that it is regularly appropriate for the Local Division to also hear and decide on the nullity counterclaim pursuant to Art. 33(3) (a) UPCA.*³

referring to orders of other LDs.

At the same time, the LD Mannheim asserted its own discretion in the matter, which it exercised by assigning the counterclaim for revocation to the CD Paris. The LD Mannheim stressed the referral as being an exception. Still, the LD Mannheim considered that the case should proceed in Paris and contended that it was more efficient to have the CD Paris decide on validity. The LD Mannheim did elaborate on arguments of the patentee but dismissed them all.

More importantly, the LD Mannheim decided to continue with the infringement matter – despite an appeal the patentee had filed against the bifurcation decision. The case is important if potential infringers fear that being sued in a LD may be perceived as too friendly to patentees. Indeed, the fact pattern allows an argument for the revocation action to be assigned to the CD Paris. Still, potential infringers will only benefit from the revocation issue being referred, if

- the CD decides on the revocation earlier than the LD or
- the respective LD stays the infringement case until there is a (final) decision on validity, or
- the respective LD decides that its decision is rendered under the condition of validity.

As *MED-EL v. Advanced Bionics* shows, bifurcation is far from certain even if the revocation action is filed early on in the CD.

¹ *Plant-e v. Arkyne*, LD The Hague, UPC_CFI_239, November 22, 2024, ([Link](#)).

² *MED-EL v. Advanced Bionics*, LD Mannheim, UPC_CFI_410/2023, July 10, 2024, ([Link](#)).

³ *MED-EL v. Advanced Bionics*, LD Mannheim, UPC_CFI_410/2023, July 10, 2024, p. 3, ([Link](#)).

*Amgen v. Sanofi*⁴ is a case with similar facts. Here, too, infringement as well as revocation action had been filed on day 1 of UPC operations, June 1, 2023 (as can also be taken from the docket number). The isolated revocation action was filed 19 minutes earlier than the infringement suit.

Patentee Amgen was in any event entitled to enforce its patent in a LD/Regional Division (RD). As a consequence, the LD Munich remained competent. Since the parties of the two suits were not identical, a counterclaim for revocation had to be and was lodged by the additional defendants in the infringement case.

The UPC assigned the case to the CD Paris – yet, upon motion of all parties. Hence, the case is of limited relevance for strategy.

It is, however, *Edwards Lifesciences v. Meril*⁵ which appears to be the most interesting. Edwards first lodged proceedings against two Meril defendants in the LD Munich for infringement of its European patent.

Later, an affiliate of the defendants, Meril Italy, lodged a revocation action against the patent in the CD Paris⁶.

Edwards disputed whether Meril Italy was in reality the "same party" as the parent company Meril Life Sciences Pvt. Ltd, which was one of the defendants in the LD Munich. If it was, the stand-alone revocation action would be impermissible under Art. 33 UPCA.

The CD Paris held that Meril Italy was not the "same party" as its parent company. This was despite the fact that the subsidiary was found to be newly created and wholly owned by, organised by, directed by, conditioned by, and conformed to the strategic plan of the corporate parent.

The result was that the stand-alone revocation action could continue in the CD, in parallel to revocation counterclaims lodged by the defendants in the infringement action in the LD Munich, despite having been lodged later.

The UPC also acknowledged that this parallel action in the CD could provide a reason why the LD might transfer the revocation counterclaim to the CD and in fact referred the counterclaims to the CD Paris. The LD Munich decided to continue with the infringement proceeding. The LD Munich did not, however, decide on the infringement matter before the decision in the CD Paris. The decision of the CD Paris was issued in time before a decision by the LD Munich on infringement. In fact, only after the CD Paris had decided on all three revocation actions did the LD Munich hold an interim conference, before finally finding for the patentee Edwards.

Edwards had again tried to stay infringement proceedings subject to an appeal of the CD Paris decision, and was rejected. The LD Munich again dismissed the request, pointing out that a stay after a decision of the CD is only possible under R. 295(c), (i) or (m) RoP stating different requirements than Art. 33(3) UPCA.

A possibility, thus, indeed exists to have validity decided not by the respective LD but by the CD in Paris, Milan or Munich. Of course one has to keep in mind that following the example of Meril with employing an affiliate will not always work.

⁴ *Amgen v. Sanofi*, LD Munich, UPC_CFL_1/2023, July 16, 2024, ([Link](#)).

⁵ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFL_501/2023, April 4, 2025, ([Link](#)).

⁶ *Meril Italy v. Edwards Lifesciences*, CD Paris, UPC_CFI_255/2023, July 19, 2024, ([Link](#)).



CLAIM CONSTRUCTION AND INFRINGEMENT

1. CLAIM CONSTRUCTION

1.1 PRINCIPLES LAID DOWN IN NANOSTRING V. 10X GENOMICS AND SUBSEQUENT DECISIONS

The CoA established the fundamental principles of claim construction at an early stage. These principles have consistently been applied by the Court of First Instance and have been reaffirmed and further specified by the CoA in subsequent decisions. A few of these will be outlined below.

In the initial decision *NanoString v. 10x Genomics*¹, the CoA found:

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.

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.

This does not mean that the patent claim merely serves as a guideline but that its subject-matter also extends to what, after examination of the description and drawings, appears to be the subject-matter for which the patent proprietor seeks protection.

The patent claim is to be interpreted from the point of view of a person skilled in the art. In applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties.

These principles for the interpretation of a patent claim apply equally to the assessment of the infringement and the validity of a European patent.

In *Alexion v. Samsung Bioepis*² and *Alexion v. Amgen*³, the CoA addressed the approach to correcting erroneous patent claims by way of interpretation. It affirmed a strict approach aimed at minimizing legal uncertainty, holding that both the existence of the error and the precise way to correct the error must be sufficiently clear to the average skilled person.

¹ *NanoString v. 10x Genomics*, CoA, UPC_CoA_335/2023, APL_576355/2023, February 26, 2024, Headnote 2 and p. 26, ([Link](#)). **Just to note:** The question of how much the description should be used to interpret the claim is currently the subject of a referral to the EPO's Enlarged Board of Appeal (G 1/24).

² *Alexion v. Samsung Bioepis*, CoA, UPC_CoA_402/2024, APL_40470/2024, December 20, 2024, para. 24 et seq., ([Link](#)).

³ *Alexion v. Amgen*, CoA, UPC_CoA_405/2024, APL_40553/2024, December 20, 2024, para. 24 et seq., ([Link](#)).

In this context, statements made during the patent grant proceedings may be relevant to the view of the skilled person when assessing the claim errors during infringement proceedings.

In *VusionGroup v. Hanshow*⁴, the CoA reaffirmed the principles established in *NanoString v. 10x Genomics*, emphasizing that claim features must always be interpreted in light of the claim as a whole.

In *Sumi Agro v. Syngenta*⁵, the CoA held that the interpretation of a specific claim feature must be guided by an understanding of the core of the invention, as well as a careful reading of the patent specification and its examples. It reiterated that claim features must always be construed in the context of the claim as a whole (cf. also *VusionGroup v. Hanshow*), and in light of the specification as a whole.

The rather recent decision *Abbott v. Sibio*⁶ provides important guidance on the UPC's treatment of functional claim language and the persistently debated issue of added matter. Applying the general principles of claim construction established in *NanoString v. 10x Genomics*, the CoA addressed the correct approach to the interpretation of means-plus-function language. Means-plus-function language refers to patent claim language whereby a feature is defined by its function rather than its specific structure. It stated that

[a]s a general principle of claim interpretation, means-plus-function features must be understood as any feature suitable for carrying out the function.

As such "configured to" should be understood to mean "suitable for" (para. 47).

The CoA's decision in this case appears to follow the approach of the European Patent Office to functional claim language, even if the CoA does not expressly make this link.

In the recent decision *Edwards Lifesciences v. Meril*⁷, the LD Munich emphasized that

a narrowing construction of a broader claim language ('Auslegung unterhalb des Wortlauts') on the basis of the description or drawings should only be allowed in exceptional cases.

1.2 OPEN QUESTIONS

Despite the clarity already achieved, open questions remain, including, maybe most importantly, the question of whether or not the file wrapper (prosecution history) should be consulted when construing patent claims.

Divisions of the Court of First Instance have adopted differing positions on this question. Unfortunately, the CoA has so far refrained from providing guidance, leaving the legal approach unsettled. For instance, in its decision to reject the request for a preliminary injunction in *VusionGroup v. Hanshow*⁸ the CoA declined to address this issue. This was somewhat disappointing, as the matter formed one of the most compelling aspects of the first instance ruling by the LD Munich⁹, which had taken the original version of the claim (the file wrapper) into account when interpreting the granted claims. In any case, guidance by the CoA is eagerly awaited by practitioners.

2. INFRINGEMENT

2.1 APPLICABLE LAW

One of the first and fundamental steps to take when assessing an alleged infringement is determining the applicable substantive law. There is, in particular, the LD Mannheim decision *Hurom v. NUC Electronics*¹⁰ that deals with this issue. It remains to be seen whether other divisions of the Court of First Instance and in particular the CoA will follow.

The LD Mannheim found that when determining the applicable substantive law, one must respect the fundamental principles governing retroactivity being enshrined and recognized in European and international law.

⁴ *VusionGroup v. Hanshow*, CoA, UPC_CoA_1/2024, APL_8/2024, May 13, 2024, para. 29, ([Link](#)).

⁵ *Sumi Agro v. Syngenta*, CoA, UPC_CoA_523/2024, APL_51115/2024, March 3, 2025, para. 39 et seq., ([Link](#)).

⁶ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, APL_39664/2024, February 14, 2025, para. 37 et seq., ([Link](#)).

⁷ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFL_501/2023, April 4, 2025, p. 17 ([Link](#)).

⁸ *VusionGroup v. Hanshow*, CoA, UPC_CoA_1/2024, APL_8/2024, May 13, 2024, para. 37, ([Link](#)).

⁹ *SES-imagotag v. Hanshow*, LD Munich, UPC_CFL_292/2023, ACT_567009/2023, December 20, 2023, p. 20, ([Link](#); available in German only).

¹⁰ *Hurom v. NUC Electronics*, LD Mannheim, UPC_CFL_159/2024, March 11, 2025, ([Link](#)).

With regard to the determination whether substantive law as laid down in the UPCA or substantive national laws of the UPCA Member States applies to acts allegedly infringing traditional European bundle patents, the LD Mannheim found the following to apply (cf. Headnote 3):

- a) to acts committed after the entry into force of the UPCA, the substantive law as laid down in the UPCA applies;*
- b) to acts committed before the entry into force of the UPCA, the substantive national laws apply;*
- c) to ongoing acts started before the entry into force of the UPCA and continued after the entry into force on 1 June 2023, the substantive law as laid down in the UPCA applies.*

Whether infringing acts are "ongoing" and justify the application of the UPCA must be viewed from a normative and evaluative perspective. It is justified to apply the UPCA to ongoing acts if the infringer continues its infringing behavior although it could have stopped the infringement in view of the entry into force of the UPCA on June 1, 2023. However, each party may rely on provisions of national laws for acts before June 1, 2023 if this is favorable to its position as compared to the provisions of the UPCA / RoP. That party bears the burden to provide the arguments on the national law to be applied.

It emphasized that the requirements of such behavior cannot be defined in an abstract manner, but require an analysis of "all of the relevant facts and circumstances". Relevant facts may include (para. 183):

- *the extent or significance of the allegedly infringing use,*
- *the relevant market including what is customary on that market,*
- *the market share of the claimed use compared to other uses,*
- *what actions the alleged infringer has taken to influence the respective market,*
 - *either 'positively', de facto encouraging the patented use,*
 - *or 'negatively' by taking measures to prevent the product from being used for patented use.*

The LD Düsseldorf's approach might be inspired by but is still different from German case law. Unlike in German case law, the UPC's approach does not expressly distinguish between liability based on manifest arrangement and liability without manifest arrangement but applies a broad analysis taking into account multiple factors, allowing a more flexible assessment.

2.2 INFRINGEMENT OF SECOND MEDICAL USE CLAIMS

A recent first decision on infringement of a second medical use patent indicates how the UPC may treat this type of claim. In *Sanofi/Regeneron v. Amgen*¹¹, the LD Düsseldorf adopted a two-pronged approach, incorporating an objective and a subjective element. According to the court (para. 182):

- *The alleged infringer must offer or place the medicinal product on the market in such way that it leads or may lead to the claimed therapeutic use of which the alleged infringer knows or reasonably should have known that it does (objective element).*
- *In addition, the infringer must know this or reasonably should have known (subjective element).*

2.3 INDIRECT INFRINGEMENT

The LD Munich was the first to address indirect patent infringement in *Hand Held Products v. Scandit*¹². The patent in suit concerned a mobile computer configured for reading decodable characters such as bar codes, while the defendant had supplied a software development kit (SDK). The LD Munich granted a preliminary injunction based on indirect infringement arising from the offer or supply of the SDK. The defendant was found to have the required knowledge that the kit was both suitable and intended for use in implementing the invention—specifically, that the customer would utilize the kit to develop the software in a particular manner—based on the videos and documentation provided by the defendant.

¹¹ *Sanofi/Regeneron v. Amgen*, LD Düsseldorf, UPC_CFI_505/2024, May 13, 2025, (Link).

¹² *Hand Held Products v. Scandit*, LD Munich, UPC_CFI_74/2024, August 27, 2024, p. 36 et seq., (Link; available in German only).

The LD Munich addressed the relevant criteria and clarified that direct infringement of a device claim may be established where the infringer effectively utilizes customers as an 'extended workbench', rendering it inequitable, from a valuation perspective, to hold the infringer liable only for an indirect patent infringement. However, the court emphasized that such a finding of direct infringement is subject to a high threshold, given the need to preserve the distinction between the legal consequences of direct and indirect infringement. In particular, the final, patent-compliant configuration of the device must be expected "with certainty".

In *Mammut v. Ortovox*¹³, a case involving an avalanche transceiver used for locating and rescuing avalanche victims, the CoA affirmed the reasoning of the LD Düsseldorf. It held that the contested embodiment was objectively suitable for infringing use, as was evident from the overall circumstances, especially the defendant's marketing, which highlighted the embodiment's suitability for such use. It found that based on the advertising measures taken, the defendant also knew (or at least should have known) that the products could objectively be used in a patent-infringing manner.

Both decisions align with the wording of Article 26(1) UPCA and demonstrate that the UPC adopts a consistent and relatively strict approach to ensuring effective enforcement of rights.

In *Kaldewei v. Bette*¹⁴, the LD Düsseldorf held that indirect infringement under the UPC regime entails a dual territorial requirement: the offer and/or supply of the essential element must occur within the territory of the UPC, and the invention must also be used within that territory. The court acknowledged that it remains an open question whether it is sufficient for the offer or supply to occur in only one Contracting Member State while being intended for the direct use of the invention in another. However, it found that this question need not be resolved in the present case, as the defendant satisfied the objective elements of contributory infringement even under the narrower interpretation.

2.4 INFRINGEMENT UNDER THE DOCTRINE OF EQUIVALENTS

In *Plant-e v. Arkyne*¹⁵, the UPC provided its first decision applying the doctrine of equivalence.

The possibility to cover equivalent embodiments under the scope of protection is laid down in Art. 2 of the

Protocol on the Interpretation of Art. 69 EPC. However, the UPCA and RoP do not contain any guidance on how the UPC should approach the assessment of an infringement by equivalence in practice. Judgements addressing this issue are therefore eagerly awaited.

The LD The Hague set out a novel four-question test for assessing equivalence apparently drawn from various national jurisdictions. The test appears relatively patentee-friendly, with the LD The Hague finding for infringement even though the attacked product lacked features of the invention.

Under the test applied, a variation is deemed equivalent if the following four questions are answered affirmatively:

- 
- 1) *Technical equivalence: does the variation solve (essentially) the same problem that the patented invention solves and perform (essentially) the same function in this context?*
 - 2) *Fair protection for patentee: is extending the protection of the claim to the variation proportionate to a fair protection for the patentee in view of their contribution to the art, and is it obvious to the skilled person from the patent publication how to apply the variation (at the time of infringement)?*
 - 3) *Reasonable legal certainty for third parties: does the skilled person understand from the patent that the scope of the invention is broader than what is claimed literally?*
 - 4) *Is the allegedly infringing product novel and inventive over the prior art?*

The decision of the LD The Hague provides some indication of how the UPC may approach equivalence in the future. This remains to be seen. There is plenty of room for other divisions of the UPC to develop divergent approaches. Ultimately, the CoA will set the test to be applied.

¹³ *Mammut v. Ortovox*, CoA, UPC_CoA_182/2024, APL_21143/2024, September 25, 2024, para. 215, (Link).

¹⁴ *Franz Kaldewei v. Bette*, LD Düsseldorf, UPC_CFI_7/2023, July 3, 2024, p. 27, (Link; available in German only).

¹⁵ *Plant-e v. Arkyne*, LD The Hague, UPC_CFI_239/2023, App_549536/2023, CC_588768/2023, November 22, 2024, Headnote 3 and para. 88, (Link).

CHAPTER

VI

CLAIMS ARISING FROM INFRINGEMENT

1. INJUNCTIVE RELIEF

1.1 ACTS OF INFRINGEMENT

The claim for injunctive relief (Art. 62(1), 63(1) UPCA) extends to prohibition of the continuation of the infringement as defined in Art. 25 and 26 UPCA.

The CoA¹ ruled in preliminary injunction proceedings *Abbott v. Sibio* that substantiating a particular act of infringement, e.g. offering, is sufficient to justify a general preliminary injunction covering all (other) acts of infringement. For instance, in the case of a device claim, such an injunction may extend to all acts of infringement under Art. 25(a) UPCA, including the manufacture of the device.

This is in line with previous CFI decisions on the merits: The LD Vienna² found for direct infringement of a device claim in *Swarco v. Strabag* and held that offering and/or placing on the market establishes a rebuttable presumption of the defendant also importing and/or possessing the attacked embodiments for the purposes of offering, placing on the market and using, Art. 25(a) UPCA. The LD Düsseldorf³ came to the same conclusion in *Franz Kaldewei v. Bette*. In both CFI decisions, however, it could remain undecided whether the presumption also extends to the manufacture - the claimant had not sought an injunction in this respect.

¹ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, para. 142, ([Link](#)).

² *Swarco v. Strabag*, LD Vienna, UPC_CFI_33/2024, January 15, 2025 p. 20, ([Link](#)).

³ *Franz Kaldewei v. Bette*, LD Düsseldorf, UPC_CFI_7/2023, July 3, 2024, p. 26, ([Link](#)).

1.2 MATERIAL SCOPE OF THE INJUNCTION

In *Abbott v. Sibio*, the CoA⁴ further constituted that the applicant's claim for injunctive relief does not need to be restricted to a specific attacked embodiment. Instead, a rather broad injunction is permissible as it must be interpreted in light of the grounds of the respective decision. Consequently, the CoA issued a preliminary injunction covering "any infringing acts as set forth in Art. 25(a) UPCA with any product according to claim 1 of the patent at issue (EP...), in particular with the [...] Device".⁵

1.3 TERRITORIAL SCOPE OF THE INJUNCTION

Pursuant to Art. 34 UPCA, decisions of the UPC shall, in principle, extend to all Contracting Member States in which the European patent has effect. Whereas the extension of the scope appeared to be applied as a matter of course⁶, the CoA⁷ implied in *Sumi v. Sygenta* that territorial limitations may be justified. In the court's view, such limitations, however, require the existence of "certain circumstances" – for instance, in view of Art. 76(1) UPCA, this could apply if it was the claimant who restricted the territorial scope of the action to less countries than he was entitled to under Art. 34 UPCA.

In *Insulet v. EOfFlow*, the CoA⁸ provided further guidance: It held that Art. 34 UPCA applies even in cases where the attacked embodiments are proven to be not (or no longer) marketed in certain Contracting Member States, provided that no sufficient cease-and-desist declaration has been issued by the defendant regarding the patent in suit.

Earlier Court of First Instance decisions, which adopted a rather broad restriction of Art. 34 UPCA, appear difficult to reconcile with the approach established by the CoA:

In *Seoul Viosys v. Laser Components*⁹, the holder of a European patent sought injunctive relief for France, Germany, the Netherlands, and the United Kingdom, based on a test purchase in France. Although the (French) defendant did not contest the territorial scope, the LD Paris¹⁰ held that this single test purchase was insufficient to prove infringement in both the UK and the Contracting Member States other than France, as the group website provides for a segmentation of sales areas within the defendant's group.

In *Hurom v. NUC*, the LD Mannheim¹¹ applied a similar understanding. However, the question did not become decisive since the LD found that the defendant had not sufficiently contested infringement in other Contracting Member States. Such was also the case for the LD Vienna¹² in its decision *Swarco v. Strabag*.

1.4 CONTINUATION OF INFRINGEMENT

The CoA¹³ addressed in *Insulet v. EOfFlow* whether under certain conditions the claim for injunctive relief may lapse. The court held that, in principle, an act of infringement implies that such act be continued/repeated. Such risk can only be excluded by providing a cease-and-desist declaration which is backed up by an adequate contractual penalty, to be paid for any case of violation. This had already been held by the LD Munich in *Edwards Lifesciences v. Meril*¹⁴. By contrast, the LD Düsseldorf previously appeared to adopt a more lenient approach: In *Franz Kaldewei v. Bette*¹⁵, the LD Düsseldorf had merely imposed on the defendant, in general terms, the burden of proof that all acts of previous use had ceased.

According to the CoA¹⁶, the requirement to provide a cease-and-desist declaration in order to escape an injunction also applies where the product is no longer offered or distributed in a Contracting Member State pursuant to a cease-and-desist declaration relating to a different patent. As the decision concerned a European patent with unitary effect, it remains uncertain whether the same would hold true for European (bundle) patents. Notably, however, the CoA did not draw any distinction in this regard.

⁴ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, para. 158, ([Link](#)).

⁵ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, operative part item (b), ([Link](#)).

⁶ cf. *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFL_15/2023, November 15, 2024, p. 58, ([Link](#)); *Plant-e v. Arkyn*, LD The Hague, UPC_CFL_239/2023, November 22, 2024, para. 105, ([Link](#)); *Yellow Sphere v. Knaus Tabbert*, LD Düsseldorf, UPC_CFL_50/2024, April 10, 2025, para. 219, ([Link](#)).

⁷ *Sumi v. Sygenta*, CoA, UPC_CoA_523/2024, March 3, 2025, ([Link](#)).

⁸ *Insulet v. EOfFlow*, CoA, UPC_CoA_768/2024, May 1, 2025, para. 124 et seq., ([Link](#)).

⁹ *Seoul Viosys v. Laser Components*, LD Paris, UPC_CFL_440/2023, April 24, 2025, ([Link](#)).

¹⁰ *Seoul Viosys v. Laser Components*, LD Paris, UPC_CFL_440/2023, April 4, 2025, para. 103 et seq., ([Link](#)).

¹¹ *Hurom v. NUC*, LD Mannheim, UPC_CFL_162/2024, March 11, 2025, para. 111 et seq., ([Link](#)).

¹² *Swarco v. Strabag*, LD Vienna UPC_CFL_33/2024, January 15, 2025 p. 20, ([Link](#)).

¹³ *Insulet v. EOfFlow*, CoA, UPC_CoA_768/2024, May 1, 2025, para. 101, 113, ([Link](#)).

¹⁴ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFL_501/2023, April 4, 2025, p. 96 et seq., ([Link](#)).

¹⁵ *Franz Kaldewei v. Bette*, LD Düsseldorf, UPC_CFL_7/2023, July 3, 2024, p. 28, ([Link](#)).

¹⁶ *Insulet v. EOfFlow*, CoA, UPC_CoA_768/2024, April 30, 2025, para. 113, 125, ([Link](#)).

1.5 IMMINENT INFRINGEMENT

*Insulet v. EOFlow*¹⁷ concerns the legal framework governing injunctive relief for past acts of infringement. In a complementary manner, in *Novartis v. Celltrion*, the LD Düsseldorf¹⁸ addressed the temporal counterpart: the conditions under which injunctive relief may be granted for imminent, but not yet realized, acts of infringement.

According to the LD, one must assess on a case-by-case basis, and taking into account the practices of the relevant industry, whether the potential infringer has set the stage for infringement to occur. This requires that the (pre-launch) preparations have been fully completed and that infringement is only a matter of starting the action. In this case, the LD found the mere granting of a pharmaceutical market authorization for the attacked embodiment and a related advertising message on a trade fair booth insufficient. Beyond this, the claimant had failed to demonstrate that a pricing process had been initiated or that the embodiment had been marketed to potential customers. Accordingly, the LD held that the evidence was insufficient to show a case of imminent infringement.¹⁹

1.6 PROPORTIONALITY

The general rule is that the UPC grants permanent injunctive relief if it finds the patent in suit to be infringed.²⁰ However, Art. 63(1) UPCA provides for a discretion of the court ("may"). In preliminary injunction cases the discretion of the court is even broader, Art. 62(1), (2) UPCA. Case law shows that the UPC is open to limitations for reasons of proportionality. In particular, such proportionality considerations may originate from the realm of the defendant itself or be based on third party or public interests.

In preliminary injunction proceedings *Valeo v. Magna*²¹, the defendant had argued that a specific OEM customer (1) would have to cease production of certain vehicles as the attacked embodiment could not be easily replaced and (2) would be entitled to considerable recourse claims, should the injunction be granted. The LD Düsseldorf chose a pragmatic approach. As the required amount for an adequate security would have hindered the claimant to enforce the injunction, the LD restricted the scope of the preliminary injunction as far as supplies to the OEM were concerned that had been contractually agreed upon.²²

In preliminary injunction proceedings *Hand Held Products v. Scandit*²³, the LD Munich weighed in on proportionality of a total ban in case of contributory infringement. In particular, it paved the way for a "disclaimer" solution if a non-infringing use of the embodiment is possible and the risk of direct infringement by the customers can be averted by means of a respective warning.

In the end, however, the LD found for a total ban as it was possible to reconfigure the device reasonable effort through an update to prevent it from being used in a patent infringing manner.²⁴ In *Häfele v. Nehl*, the LD Munich²⁵ further elaborated on the issue of proportionality in case a non-patent infringing use of the attacked embodiment is possible – even though the application was ultimately dismissed.

The claimant had submitted auxiliary requests providing for (1) a "disclaimer" being attached to each offer and (2) a cease-and-desist declaration with a penalty clause being issued by customers in each case of distribution.²⁶

However – with respect to a specific embodiment – the LD held that even such limited ban would be disproportionate. Instead, it would suffice to enjoin the defendant from the joint offering and/or distribution of the attacked embodiment together with – separately attacked – tools.²⁷

¹⁷ *Insulet v. EOFlow*, CoA, UPC_CoA_768/2024, May 1, 2025, ([Link](#)).

¹⁸ *Novartis v. Celltrion*, LD Düsseldorf, UPC_CFL_166/2024, September 6, 2024, ([Link](#)).

¹⁹ *Novartis v. Celltrion*, LD Düsseldorf, UPC_CFL_166/2024, September 6, 2024, p. 15 et seq., ([Link](#)).

²⁰ cf. *Ortovox v. Mammut*, LD Düsseldorf, UPC_CFL_16/2024, January 14, 2025, p. 35, ([Link](#)); *Swarco v. Strabag*, LD Vienna UPC_CFL_33/2024, January 15, 2025 p. 20, ([Link](#)).

²¹ *Valeo v. Magna*, LD Düsseldorf, UPC_CFL_368/2024, October 31, 2024, ([Link](#)).

²² *Valeo v. Magna*, LD Düsseldorf, UPC_CFL_368/2024, October 31, 2024, p. 36 et seq., ([Link](#)).

²³ *Hand Held Products v. Scandit*, LD Munich, CFL_74/2024, August 27, 2024, ([Link](#)).

²⁴ *Hand Held Products v. Scandit*, LD Munich, CFL_74/2024, August 27, 2024, p. 59, ([Link](#)).

²⁵ *Häfele v. Nehl*, LD Munich, UPC_CFL_443/2024, November 25, 2024, p. 36 et seq., ([Link](#)).

²⁶ *Häfele v. Nehl*, LD Munich, UPC_CFL_443/2024, November 25, 2024, p. 13 et seq., ([Link](#)).

²⁷ *Häfele v. Nehl*, LD Munich, UPC_CFL_443/2024, November 25, 2024, p. 41., ([Link](#)).

In *Edwards Lifesciences v. Meril*²⁸, the LD Munich discussed several limitations. Despite being largely dismissed in this particular case, the decision shows that, in principle, a restriction of injunctive relief is possible:

→ The defendant invoked prevailing third parties' and public interest – the infringement related to a transcatheter heart valve and associated delivery systems. It was undisputed between the parties that the defendant's XL-sized embodiment valve sometimes still seemed to be the best option for patients. Still, without being legally obliged, the claimant permitted the use of such XL-sized embodiment by way of single-use licenses where clinically necessary. For other infringing embodiments, a notable enhancement compared to competing products could not be proven by the defendant.

In view of this, the LD Munich rejected the objection that an injunction was disproportionate, with the exemption of only those XL-sized-embodiments that had been scheduled for implantation in individualized patients by the date the decision was rendered.²⁹

→ Further, the LD Munich denied the grant of a grace period. However, this was rather due to the individual circumstances as the oral hearing had already been postponed. Thus, any further postponement by means of a grace period would have imperiled the claimant's legitimate interest in prompt enforcement of the decision.³⁰ However, one should not infer from this a general rejection of grace periods.

→ Eventually, the LD Munich indicated that – in general – compensation by payment in lieu of an injunction could be deemed appropriate. However, this would, at least, require an offer for a sufficient financial settlement by the defendant. In the case at hand, the defendant was found an unwilling licensee.³¹

Third party interests were also considered by the LD Düsseldorf in *Ortovox v. Mammüt* relating to avalanche transceivers.³² However, with competing products available on the market, the LD did not consider the availability of the infringing devices absolutely necessary for improving the chances of survival of avalanche victims. Thus, injunctive relief was granted without limitations.

1.7 LIABILITY OF MANAGING DIRECTORS

According to the CoA in *Philips v. Belkin*³³, the managing director of a company that is found to infringe a patent is not *per se* liable for patent infringement as an "intermediary" under Art. 63(1) 2 UPCA. The position of managing director makes the person a representative of the company, thus initially precluding the status as a "third party." In first instance, the LD Munich³⁴ had ruled to the contrary. However, the CoA ordered for suspensive effect of the defendants' appeal in this respect, Art. 74 UPCA, R. 223 RoP.

If further circumstances arise, however, these may in turn give rise to liability of a managing director as an intermediary.³⁵ The CoA did not have to decide on when this would be the case. This question therefore remains open for the time being.

1.8 PENALTY PAYMENT

According to Art. 63(2) UPCA, where appropriate, non-compliance with the injunction shall be subject to a recurring penalty payment payable to the court. Whereas the amount will ultimately be determined in subsequent enforcement proceedings, the court establishes at least a maximum amount in their decisions. To date, the LDs chose different approaches to determine the amount:

²⁸ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFI_15/2023, November 15, 2024, p. 58 et seq., (Link).

²⁹ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFI_15/2023, November 15, 2024, p. 65, (Link).

³⁰ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFI_15/2023, November 15, 2024, p. 65, (Link).

³¹ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFI_15/2023, November 15, 2024, p. 65, (Link).

³² *Ortovox v. Mammüt*, LD Düsseldorf, UPC_CFI_16/2024, January 14, 2025, p. 35, (Link).

³³ *Philips v. Belkin*, CoA, UPC_CoA_549/2024, ORD_53377/2024, October 29, 2024, (Link).

³⁴ *Philips v. Belkin*, LD Munich, UPC_CFI_390/2023, September 13, 2024, (Link).

³⁵ *Philips v. Belkin*, CoA, UPC_CoA_549/2024, ORD_53377/2024, October 29, 2024, para. 66, (Link).

The LD Düsseldorf does not appear to consider specific calculations, but to leave the assessment for the enforcement proceedings. In *myStromer v. Revolt*³⁶ (PI Proceedings) as well as in *SodaStream v. Aarke*³⁷ and *Yellow Sphere v. Knaus Tabbert*³⁸, the LD ordered for amounts of up to EUR 250.000. The LD Vienna has endorsed this approach in *Swarco v. Strabag*³⁹ ordering for a penalty payment of up to EUR 100.000. Both LDs emphasized the need for flexibility to take into account the circumstances of the individual case, including the behavior of the infringer, and on that basis set an appropriate penalty payment in enforcement proceedings. In subsequent *myStromer v. Revolt* enforcement proceedings, the LD Düsseldorf⁴⁰ proved to comprehensively weigh in on such proportionality considerations.

Other LDs do not choose this rather formulaic approach, but instead consider different criterions depending on the circumstances of the specific case:

In *Edwards Lifesciences v. Meril*, the LD Munich⁴¹ ordered, in accordance with the claimant's motion, for a penalty of up to EUR 20.000 with the price of the attacked embodiments being in a similar range.

In *Oerlikon v. Bhagat*, the LD Milan⁴² took into account the type of ascertained infringement (promotion on an international trade fair) and industry royalties for the high-value machines (EUR 750.000) as quantified by the parties, resulting in a EUR 12.000 penalty.

In *Seoul Viosys v. Laser Components*, the LD Paris⁴³ imposed a penalty of a maximum of EUR 50 per infringing device, which is a multiple of the actual sales price (between EUR 2.60 and EUR 4.70) but in absolute terms still seems rather low.

Ultimately, only enforcement proceedings will show whether these different approaches also tend to result in differently severe penalty payments imposed.

2. INFORMATION

The claim for information has been shaped by decisions to date in terms of both the scope and the enforceability of the claim.

In *Franz Kaldewei v. Bette*, the LD Düsseldorf⁴⁴ ruled on the scope of the claim for information. Art. 67 UPCA, in itself, merely defines the information to be provided. However, this alone does not suffice to verify the accuracy of the information disclosed.

The LD found that Art. 68(3) (a), (b) UPCA, in conjunction with R. 191.1 RoP, provides a substantive right to request both information on the cost factors relied on by the defendant in calculating its profits and the production of supporting evidence for the information pursuant to Art. 67(1) UPCA – namely invoices or, if these are not available, delivery notes. In the subsequent *Grundfos v. Hefei* decision, the LD Düsseldorf⁴⁵ confirmed this understanding and granted an even broader claim including individual deliveries and offers.

The order issued by the LD Munich in *Philips v. Belkin*⁴⁶ carries considerable practical implications: According to the LD, claimants must explicitly request that information under Article 67 UPCA be provided in electronic form. Absent such a request, defendants are free to produce the information in paper form – in the present case, no such condition had been included in the operative part of the decision. As a result, the claimant's representatives were served with sixteen boxes containing printed invoices and an additional box containing a printed table. Given the substantial additional burden on the part of the claimant in conducting the examination, the importance of a comprehensive and precisely worded motion can therefore hardly be overstated.

³⁶ *myStromer v. Revolt*, LD Düsseldorf, UPC_CFL_177/2023, June 22, 2023, ([Link](#)).

³⁷ *SodaStream v. Aarke*, LD Düsseldorf, UPC_CFL_373/2023, October 31, 2024, p. 24, ([Link](#)).

³⁸ *Yellow Sphere v. Knaus Tabbert*, LD Düsseldorf, UPC_CFL_50/2024, April 10, 2025, para. 276 et seq., ([Link](#)).

³⁹ *Swarco v. Strabag*, LD Vienna UPC_CFL_33/2024, January 15, 2025 p. 21, ([Link](#)).

⁴⁰ *myStromer v. Revolt*, LD Düsseldorf, UPC_CFL_177/2023, ORD_557761/2023, October 18, 2023, p. 14 et seq., ([Link](#)).

⁴¹ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFL_15/2023, November 15, 2024, p. 66, ([Link](#)).

⁴² *Oerlikon v. Bhagat*, LD Milan, UPC_CFL_241/2023, November 4, 2024, para. 8.5, ([Link](#)).

⁴³ *Seoul Viosys v. Laser Components*, LD Paris, CFL_440/2023, April 24, 2025, para. 114, ([Link](#)).

⁴⁴ *Franz Kaldewei v. Bette*, LD Düsseldorf, UPC_CFL_7/2023, July 3, 2024 p. 28, ([Link](#)).

⁴⁵ *Grundfos v. Hefei*, LD Düsseldorf, UPC_CFL_11/2024, May 8, 2025, para. 164, ([Link](#)).

⁴⁶ *Philips v. Belkin*, LD Munich, UPC_CFL_390/2023, ORD_60616/2024, December 17, 2024, ([Link](#)).

Eventually, the CoA⁴⁷ established in *Abbott v. Sibio* that the claim for information under Art. 67 UPCA can be asserted not only in proceedings on the merits, but already in proceedings for provisional measures. However, the applicant is required to substantiate a sufficient interest and urgency in relation to the specific information requested. In the present case and subsequently in *Insulet v. EOFlow*⁴⁸, the CoA granted the claim with respect to information on the origin, the distribution channels as well as quantities and third parties involved since this would support the applicant in preventing further infringements. However, the court denied the claim for information related to the price as this was relevant only to the calculation of damages.⁴⁹

3. RECALL / DEFINITIVE REMOVAL FROM CHANNELS OF COMMERCE / DESTRUCTION

The claim for definitive removal from channels of commerce pursuant to Art. 64(2) (d) UPCA is separate from and complements the recall claim according to Art. 64(2) (b) UPCA.

The LD Düsseldorf⁵⁰ and the LD Vienna⁵¹ both stipulated that the claim shall only be granted if the defendant has the actual and legal means to effect (definite) removal. From the claimant's perspective, it is therefore crucial to ensure that the wording of the application is specific and sufficiently precise to allow for concrete measures to be taken. This would, for instance, be the case if the defendant is required to instruct its commercial customers to cancel orders of the infringing products and/or to take back the recalled items for the purpose of destruction.

Proportionality considerations also apply here and are taken into account by the UPC, cf. Art. 64(4) UPCA. Consequently, the LD Munich⁵² converted the limitations set out in *Edwards Lifesciences v. Meril* regarding the injunctive relief to recall and destruction. The LD Düsseldorf⁵³ established guidelines for the boundaries of the proportionality objection in *Grundfos v. Hefei* in that, *inter alia*,

- the recall claim is not disproportionate if the attacked embodiments are integrated into a complex systems, as only a recall notice is required, not a removal;
- mere license negotiations prior to litigation do not constitute a sufficient basis of trust that a license agreement would be concluded;
- in case of redesigns of the attacked embodiments, the proportionality objection could at best apply if such a workaround ensures that the infringing embodiments cannot be restored to a patent-infringing state and then placed on the market.

⁴⁷ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, para. 160 et seq., ([Link](#)).

⁴⁸ *Insulet v. EOFlow*, CoA, UPC_CoA_768/2024, May 1, 2025, para. 129 et seq., ([Link](#)).

⁴⁹ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, para. 163 et seq., ([Link](#)).

⁵⁰ *Franz Kaldewei v. Bette*, LD Düsseldorf, UPC_CFL_7/2023, July 3, 2024, ([Link](#)).

⁵¹ *Swarco v. Strabag*, LD Vienna UPC_CFI_33/2024, January 15, 2025, ([Link](#)).

⁵² *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFL_15/2023, November 15, 2024, p. 66 et seq., ([Link](#)).

⁵³ *Grundfos v. Hefei*, LD Düsseldorf, UPC_CFL_11/2024, May 8, 2025, para. 160 et seq., ([Link](#)).

4. DAMAGES

4.1 INTERIM AWARD

The court may order that preliminary damages be paid even though the final determination of the amount should be subject of separate proceedings. The legal basis of such claim is Art. 68(1) UPCA, R. 119 RoP.

Under recent case law, the award shall at least cover the claimant's expected costs of the procedure for the award of damages, which may be calculated based on the limit according to the value in dispute.⁵⁴ The expected actual damage is to be taken into account, as well.⁵⁵

However, preliminary damages are only awarded to the extent the claimant provides evidence. As the claimant failed to do so in *Ortovox v. Mammüt*, the LD Düsseldorf⁵⁶ limited the amount to the minimum amount of court fees. The LD Paris dismissed respective claims in full due to lack of substantiation in *HP v. LAMA France*⁵⁷ and *Seoul Viosys v. Laser Components*⁵⁸.

To the extent such amounts are sufficiently substantiated or undisputed by the defendant, the LDs do not appear to apply limitations despite the preliminary character of the claim.⁵⁹ The LD Milan⁶⁰ even awarded damages based on mere reputational damage the existence and the amount of which it considered proven.

4.2 COMPENSATION FOR NON-MATERIAL DAMAGES

The UPCA does not provide for an isolated claim on compensation for moral damages, but merely specifies it as an aspect for the court to consider when setting the (amount of) damages, Art. 68(3) (a) UPCA.

The LD Mannheim⁶¹ left open whether the UPCA provides for an individual claim. However, on this occasion, the LD set out that moral damages would require special circumstances which go beyond the usual consequences of an infringement suffered by the claimant and which are not fully compensated by the other remedies.

The Milan LD⁶² appears to apply a more permissive understanding, ordering the defendant in *Oerlikon v. Bhagat* to payment of interim damages for exhibiting the (not yet distributed) infringing product on the most important trade fair in the world, organized every four years.

4.3 PRE-GRANT COMPENSATION

According to Art. 32(1) (f) UPCA, the UPC is competent for actions for damages or compensation derived from the provisional protection conferred by a published European patent application. However, the UPCA does not provide for a uniform legal basis for such claim.

The LD Düsseldorf⁶³ concludes that, considering Art. 67 EPC, the national laws apply. Thus, the claimant shall substantiate such claim for each Contracting Member State. As the decision related to a European (bundle) patent, it remains to be seen whether the same will apply for European patents with unitary effect.

4.4 LIMITATION

The claimant may seek damages for a period of five years upon the date he obtained / could have obtained knowledge of the infringement, Art. 72 UPCA.

The CoA⁶⁴ ruled – in line with the LD Munich⁶⁵ – that claimants may seek damages also for infringement prior to the UPC's entry into force on June 1, 2023 if the patent has not lapsed before that date.

⁵⁴ *SodaStream v. Aarke*, LD Düsseldorf, UPC_CFI_373/2023, October 31, 2024, ([Link](#)).

⁵⁵ *Plant-e v. Arkyne*, LD The Hague, UPC_CFI_239/2023, November 22, 2024, ([Link](#)).

⁵⁶ *Ortovox v. Mammüt*, LD Düsseldorf, UPC_CFI_16/2024, January 14, 2025, p. 38, ([Link](#)).

⁵⁷ *HP v. Lama France*, LD Paris, UPC_CFI_358/2023, November 13, 2024, para. 314, ([Link](#)).

⁵⁸ *Seoul Viosys v. Laser Components*, LD Paris, CFI_440/2023, April 24, 2025, para. 123, ([Link](#)).

⁵⁹ cf. *Yellow Sphere v. Knaus Tabbert*, LD Düsseldorf, UPC_CFI_50/2024, April 10, 2025, para. 269, ([Link](#)).

⁶⁰ *Oerlikon v. Bhagat*, LD Milan, UPC_CFI_241/2023, November 4, 2024, p. 16 et seq., ([Link](#)).

⁶¹ *Fujifilm v. Kodak*, LD Mannheim, UPC_CFI_365/2023, April 2, 2025, para. 135 et seq., ([Link](#)); *Hurom v. NUC*, LD Mannheim, UPC_CFI_162/2024, March 11, 2025, para. 123, ([Link](#)).

⁶² *Oerlikon v. Bhagat*, LD Milan, UPC_CFI_241/2023, November 4, 2024, p. 15 et seq., ([Link](#)).

⁶³ *Yellow Sphere v. Knaus Tabbert*, LD Düsseldorf, UPC_CFI_50/2024, April 10, 2025, para. 273 et seq., ([Link](#)).

⁶⁴ *Fives v. REEL*, CoA, UPC_CoA_30/2024, APL_4000/2024, January 16, 2025, ([Link](#)).

⁶⁵ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFI_15/2023, November 15, 2024, ([Link](#)).

5. PUBLICATION OF DECISION

From the premise that the publication includes a further punitive – and per the language of the LD Munich “humiliating”⁶⁶ – element, the UPC appears to take a restrictive approach on Art. 80 UPCA.

Publication should, therefore, only be granted if the protection of the claimant is not provided effectively and not sufficiently ensured by other measures ordered. This may be the case if there was a greater public interest at stake and the publication in the public media is intended to eliminate uncertainty among the customers⁶⁷, to dissuade customers from doing business with the infringer⁶⁸, to raise public awareness and/or to deter future infringers⁶⁹.

To date, the claim for publication of the decision has been granted just once, whereas the Hague LD⁷⁰ did not specifically consider the above case law: In *Plant-e v. Arkyne*, the claimant applied for a publication of a specific text with a specific layout only on the homepage of the defendant's website along with a link to the decision for a period of two months. The Hague LD partially granted the claim, limiting the layout of the text and the period of the publication to one month.

Previously, the LD Munich⁷¹ had granted the claimant in *Edwards Lifesciences v. Meril* the right to publish the decision – apparently at its own costs – in five public media including industry journals of its choice making available at least the full text of the rubric and the complete operational part of the decision.

⁶⁶ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFI_15/2023, November 15, 2024, p. 67, ([Link](#)).

⁶⁷ *SodaStream v. Aarke*, LD Düsseldorf, UPC_CFI_373/2023, October 31, 2024, ([Link](#)).

⁶⁸ *Oerlikon v. Bhagat*, LD Milan, UPC_CFI_241/2023, November 4, 2024, p. 17, ([Link](#)).

⁶⁹ *Swarco v. Strabag*, LD Vienna UPC_CFI_33/2024, January 15, 2025, ([Link](#)).

⁷⁰ *Plant-e v. Arkyne*, LD The Hague, UPC_CFI_239/2023, November 22, 2024, para. 111, ([Link](#)).

⁷¹ *Edwards Lifesciences v. Meril*, LD Munich, UPC_CFI_15/2023, November 15, 2024, p. 67, ([Link](#)).



VII PRIOR USE

1. DECISIONS RENDERED SO FAR

To date, defendants have not yet successfully established the private prior use objection. This does not come as a surprise considering the strict requirements under Art. 28 UPCA.

In *Franz Kaldewei v. Bette*, relating to a European patent, the LD Düsseldorf¹ confirmed the narrow wording of Art. 28 UPCA holding that there is no harmonized "European prior use objection". This entails two key consequences:

- Firstly, contrary to the claimant's allegation of infringement (Art. 34 UPCA), the defendant's prior use objection must be asserted and substantiated individually for each Contracting Member State;
- Secondly, for each Contracting Member State, the respective national provisions and evidentiary requirements apply. Although not explicitly confirmed, the LD's reasoning suggests that this interpretation also applies to European patents with unitary effect.

The LD Düsseldorf² confirmed this interpretation in *Yellow Sphere v. Knaus Tabbert*. In two proceedings (*Fujifilm v. Kodak*), the LD Mannheim also emphasized the incomplete harmonization under UPCA in principle, and applied national law seemingly as a matter of course⁴.

This interpretation of Art. 28 UPCA further narrows the prospects of mounting a successful prior use defence – all the more across multiple jurisdictions.

The procedural question whether private prior use must be asserted by means of (counter-)claim was left open by the LD Düsseldorf⁵; however, in light of further decisions – all of which involved infringement proceedings without such counterclaims – this question appears increasingly moot.

2. OUTLOOK

Once private prior use can be conclusively substantiated in one Contracting Member State, it is already foreseeable that interesting follow-up questions will arise:

In *Yellow Sphere v. Knaus Tabbert*, the LD Düsseldorf⁶ did not need to decide whether, on the basis of the Free Movement of Goods under Article 28 et seq. TFEU, a right of prior use once established extends to other Contracting Member States.

Whether the UPC will apply the same narrow interpretation of Art. 28 UPCA – and consequently divergent prior use provisions – for European patents with unitary effect, also remains to be seen.

¹ *Franz Kaldewei v. Bette*, LD Düsseldorf, UPC_CFI_7/2023, July 3, 2024, p. 26, ([Link](#)).

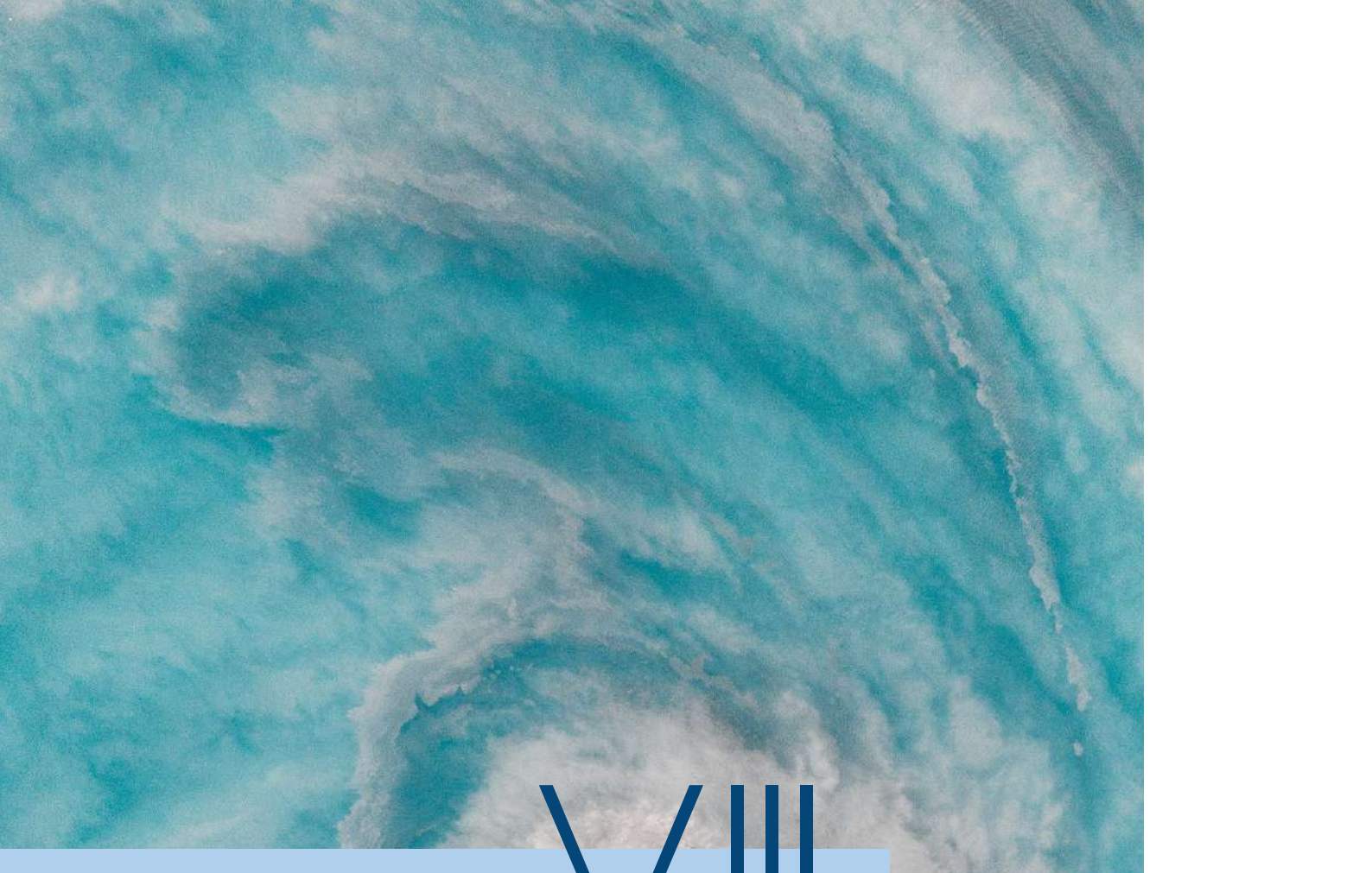
² *Yellow Sphere v. Knaus Tabbert*, LD Düsseldorf, UPC_CFI_50/2024, April 10, 2025, para. 222 et seq., ([Link](#)).

³ *Fujifilm v. Kodak*, LD Mannheim, UPC_CFI_359/2023, April 2, 2025, para. 38, ([Link](#)).

⁴ *Fujifilm v. Kodak*, LD Mannheim, UPC_CFI_365/2023, April 2, 2025, para. 117 et seq., ([Link](#)).

⁵ *Yellow Sphere v. Knaus Tabbert*, LD Düsseldorf, UPC_CFI_50/2024, April 10, 2025, para. 224, ([Link](#)).

⁶ *Yellow Sphere v. Knaus Tabbert*, LD Düsseldorf, UPC_CFI_50/2024, April 10, 2025, para. 237, ([Link](#)).



VIII

CHAPTER

PRELIMINARY INJUNCTIONS (PIs)

1. INTRODUCTION

The UPC enjoys great popularity for Preliminary Injunctions (PIs). Since the UPC started its work two years ago, 62 applications for a PI have been filed through the end of April 2025 compared to 391 actions on the merits. Statistically, slightly more than half of them were granted. This popularity is based not only on the short-term nature of these proceedings, but also on the fact that the UPC

does not impose high hurdles for granting a PI. Especially regarding the entitlement to initiate proceedings, the validity of the patent in suit and the infringement of such patent a *prima facie* analysis of a "more likely than not" standard suffices. However, the UPC only grants a PI in cases where the provisional measure is appropriate, requiring evidence from the applicant regarding urgency and the applicant's interest overall outweighing the respondent's interest.

In *Barco v. Yealink*¹ the relevant gateway for a successful application for a PI is described by the LD Brussels:

Initiation of a case on the merits should be considered the standard (default) for initiating patent infringement actions. Therefore, an application for provisional measures should be the exception to this standard (default). Since the rights of the defence in such proceedings are not protected to the same extent as they are in proceedings on the merits, a request for provisional measures can only be granted in exceptional circumstances. These exceptional circumstances may relate to temporal and/or factual necessity, considering a balance between the rights of the applicant and the rights (of the defence) of the respondent (which are already limited by nature – due to the summary nature of the provisional measures procedure).

The guiding principles for the assessment of an application for provisional measures have been established in the UPC case law and were listed by the LD Lisbon in *Ericsson v. Asustec*²:

Regarding preliminary injunctions, the applicant may be required by the court to provide reasonable evidence to satisfy the court with a sufficient degree of certainty that the applicant is entitled to initiate proceedings under Art. 47 UPCA, that the patent is valid and that its rights are being infringed, or that such infringement is imminent (R. 211.2 RoP). Additionally, the granting of a preliminary injunction requires that urgency and balance of interests are considered [...]. These requirements are cumulative.

2. ENTITLEMENT

When claiming entitlement, especially, the applicant registered as patentee in the European Patent-Register or in the national register(s) may initially rely on the rebuttable presumption of being the patentee. Such strong presumption attached to the registered patent can only be rebutted in PI proceedings if the title is manifestly erroneous.

In *Valeo v. Magna*³, the LD Düsseldorf indicated that based on such rebuttable presumption, the burden of proof shifted to Magna and ultimately deemed that Valeo had sufficient right to institute proceedings in this case as Magna had not challenged Valeo's entitlement via a national vindication action prior to the filing of the Application for provisional measures and the infringement action on the merits. This position is taken regularly, for example recently by the LD Hamburg in *Teleflex v. Speed Care*⁴.

3. VALIDITY

The applicant has to provide reasonable evidence with a sufficient degree of certainty that the patent in suit is valid. Conversely, it is up to the respondent to provide such evidence when asserting that the patent in suit is invalid or other circumstances supporting the respondent's position⁵. Besides the lower standard of proof in PI proceedings, such allocation of the burden of proof in PI proceedings is consistent with the burden of proof in the main proceedings.

The LD Munich, in various decisions⁶, limits the number of validity arguments to be presented by the respondent to three, stating that it is his responsibility to select the best three arguments to be examined in detail.

Such limitation bases on the fact that a full examination of any argument raised against the validity of the patent in suit is not possible in PI proceedings, especially as a summary examination of legal issues is – unlike factual issues – not possible. As such arguments need to be examined comprehensively, the summary nature of PI proceedings must be taken into account by limiting the number of arguments.

¹ *Barco v. Yealink*, LD Brussels, UPC_CFL_582/2024, March 21, 2025, para. 50, ([Link](#)).

² *Ericsson v. Asustek*, LD Lisbon, UPC_CFL_317/2024, October 15, 2024, para. 44, ([Link](#)).

³ *Valeo v. Magna*, LD Düsseldorf, UPC_CFL_368/2024, October 31, 2024, p. 14 et seq., ([Link](#)).

⁴ *Teleflex v. Speed Care*, LD Hamburg, UPC_CFL_701/2024, February 21, 2025, p. 7, I., ([Link](#)).

⁵ *10x Genomics v. NanoString, CoA*, UPC_CoA_335/2023, February 26, 2024, p. 27 et seq., ([Link](#)); *Teleflex v. Speed Care*, LD Hamburg, CFL_701/2024, February 21, 2025, p. 8, 1, ([Link](#)).

⁶ *Syngenta v. Sumi Agro*, LD Munich, UPC_CFL_201/2024, August 27, 2024, ([Link](#)); *Hand Held Products v. Scandit*, UPC_CFL_74/2024, LD Munich, August 27, 2024, ([Link](#)); *Dyson v. SharkNinja*, UPC_CFL_443/2023, LD Munich, May 21, 2024, ([Link](#)).

The UPC does not require that the patent in suit has been tested in inter partes proceedings. Rather, the granting of a patent by the EPO in light of third party observations was no indication for the LD Hamburg to affirm in *Alexion v. Amgen & Samsung*⁷ the sufficient degree of certainty regarding the validity of the patent in suit. In fact, the LD found that the third party observations did not involve the arguments discussed in the PI proceedings and decided independently of the EPO conclusions and on the self-supposed assumption of the likelihood that the EPO will also revoke the patent in its future decision in the opposition proceedings. Such position of the LD Hamburg was affirmed in the appeal proceedings by the CoA⁸.

In *Valeo v. Magna*⁹, the LD Düsseldorf noted that no conclusions can be drawn from the general revocation rates of patents, as only the likely validity of the patent is of relevance.

In the outcome, the UPC sets the standard of proof regarding the validity of the patent in suit not too high. However, this should not obscure the fact that the question of validity is - to the quantitatively limited extent - comprehensively and diligently examined, *Abbott v. Sibio* by the LD The Hague¹⁰ as well as the CoA¹¹.

Within PI proceedings, the applicant is not entitled to introduce auxiliary requests to amend the patent in suit (according to R. 30 RoP related to actions on the merits) in order to optimize the likelihood that the patent in suit will more likely than not be judged valid¹².

In *Insulet v. Menarini*¹³, the LD Milan rejected Insulet's argument that the claim amendments were amendments to their case and therefore had to be evaluated according to R. 263 RoP. However, the LD Milan stated that the entitlement of the applicant to amend their case in R. 263.2 RoP refers to the pleading amendments and does not relate to patent amendments pursuant to R. 30 RoP, inter alia justified by the necessary expediency in PI proceedings.

4. INFRINGEMENT

As pointed out with regard to entitlement and validity, the UPC requires that it is more likely than not that the patent in suit is infringed or that the infringement is imminent. Nevertheless, the UPC also examines the issue of infringement in significant detail. The standard was already set in *10x Genomics v. NanoString*¹⁴, being the first PI heard at the UPC, LD Munich, discussing direct and indirect infringement.

With regard to imminent infringement, it had been unclear prior to the LD Düsseldorf decision in *Novartis v. Celltrion*¹⁵ whether the UPC was responsible for imminent infringement at all. Celltrion had disputed this, arguing that their previous activities had no connection to UPC territory. However, the LD rejected this argument: In order for a patent infringement to be considered imminent, there must be concrete indications in the overall circumstances that an infringement is imminent. The situation must be characterized by certain circumstances which indicate that the infringement has not yet occurred but, that the potential infringer has already "set the stage" for it to occur by fully completed preparations so that the infringement is only a matter of starting the action.

Even though the respondents obtained a marketing authorization for the contested embodiment and promoted the contested embodiment at the EAACI Congress as "now approved", the LD Düsseldorf denied that the respondents had completed the pre-launch preparations. The advertising "now approved" did not show any specific timeline and information on price negotiations or reimbursement applications were missing, as well as any situation in which samples were presented to potential customers.

The LD Munich affirmed an imminent infringement in *Syngenta v. Sumi Agro*¹⁶, stating that distributing a patent infringing composition outside the Contracting Member States and advertising a composition under the same name within the Contracting Member States, can create a risk of first infringement that patent infringing compositions will be manufactured, advertised and distributed in the territory of the Contracting Member States.

⁷ *Alexion v. Amgen & Samsung*, LD Hamburg, UPC_CFL_124/2024, June 26, 2024, ([Link](#)).

⁸ *Alexion v. Amgen & Samsung*, CoA, UPC_CoA_405/2024, December 20, 2024, ([Link](#)).

⁹ *Valeo v. Magna*, LD Düsseldorf, UPC_CFL_368/2024, October 31, 2024, p. 21, a), ([Link](#)).

¹⁰ *Abbott v. Sibio*, LD The Hague, UPC_CFL_131/2024, June 19, 2024, ([Link](#)).

¹¹ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, ([Link](#)).

¹² *Insulet v. Menarini*, LD Milan, UPC_CFL_400/2024, November 22, 2024, ([Link](#)); *Ericsson v. Asustek*, LD Lisbon, UPC_CFL_317/2024, October 15, 2024, ([Link](#)).

¹³ *Insulet v. Menarini*, LD Milan, UPC_CFL_400/2024, November 22, 2024, p. 21 et seq., ([Link](#)).

¹⁴ *10x Genomics v. NanoString*, LD Munich, UPC_CFL_2/2023, September 19, 2023, p. 71 et seq., ([Link](#)).

¹⁵ *Novartis v. Celltrion*, LD Düsseldorf, UPC_CFL_166/2024, September 6, 2024, p. 14, Ziffer 3. a), ([Link](#)).

¹⁶ *Syngenta v. Sumi Agro*, LD Munich, UPC_CFL_201/2024, August 27, 2024, p. 13 et seq., ([Link](#)).

In *Abbott v. Sibio*¹⁷, the CoA affirmed an imminent infringement by one of the respondents on the basis that the other respondent had placed infringing products on the market within the UPC territory. The imminent threat of importing the contested product by the respondent was clear since he acted as an importer for the EU territory. This was sufficient for the CoA to issue a PI covering all possible acts of infringement listed in Art. 25(a) UPCA (i.e. extending also to making, offering, using, placing on the market and/or storing infringing products), even though it had only been shown that the respondent had imported them.

5. URGENCY

The question when the applicant has to act is a balancing act between the need to obtain sufficient evidence on the patent infringement and the need to prove its interest to promptly enforcing its patent rights.

5.1 GAINING OF KNOWLEDGE

In *Dyson v. SharkNinja*¹⁸, the LD held that the patentee has to act as soon as he gained knowledge of the infringement without willful negligence, but also pointed out that the patentee is not required to actively monitor for infringement.

In *10x Genomics vs. Curio*¹⁹, the applicant supplied evidence that it had gained knowledge of the contested embodiments only two weeks before filing the PI application – even though the contested product had already been on the market for several years, the court agreed they had acted promptly to investigate the products and had filed as soon as they had the necessary knowledge. In a second step, the court discussed whether the applicant's lack of knowledge had been the result of willful negligence, pointing out that maintaining a lack of knowledge must be considered equivalent to having positive knowledge. However, the court stated the patentee shall not be under a general obligation to observe the market.

5.2 REASONABLE TIMELINE

A patentee needs only to apply to the court if it (i) has reliable knowledge of all those facts that make legal action in the interim legal protection proceedings promising, and (ii) if it can make the relevant facts credible in such a way that prevailing is reasonably probable.

The applicant bears the burden of proof for urgency. In *Ericsson v. Asustek*²⁰, the applicant relied solely on the date of the test purchase, May 05, 2024, not even arguing that date as being the one on which it became aware of the contested embodiments. However, the facts indicated that knowledge could have been gained as early as in 2019. The LD Lisbon thus dismissed the application for a PI due to lack of urgency.

It is essential what timeline between the patentee becoming aware of the alleged infringement and the filing of an application for a PI is considered reasonable. A 'safe harbor' of two months after the first notice of an alleged infringement has been accepted by the LD Munich in a number of decisions, including *Dyson v. SharkNinja*²¹ and *Syngenta v. Sumi Agro*²². However, this two-month safe harbor is not universally followed. In *Ortovox v. Mammüt*²³ as well as *10x Genomics v. Curio*²⁴ the LD Düsseldorf found that the safe harbor should be no more than one month after the applicant has all the knowledge and documents that reliably enable a promising legal action.

Related to the investigation phase, the LD Düsseldorf stated in *Mammüt v. Ortovox*²⁵ that the applicant can obviously not be instructed to further investigate during ongoing proceedings to obtain the necessary documents retrospectively. On the other hand, the applicant must not delay unnecessarily. Here, the LD Düsseldorf, confirmed by the CoA²⁶, held that the facts of the case justified an investigation phase of 1.5 months to gain the knowledge necessary. The presentation of one prototype, showing the emergency number "Europe 112", at a US trade fair could not result in a sufficient knowledge of the applicant, as the patent in suit was not validated in all European countries and as the presented "Barryvox S 2" was only one of several prototypes. Accordingly, Ortovox was able to take a look at the version on display for the first time at the German trade fair to gain the sufficient degree of knowledge.

¹⁷ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, para. 142, ([Link](#)).

¹⁸ *Dyson v. SharkNinja*, LD Munich, UPC_CFL_443/2023, May 21, 2024, ([Link](#)).

¹⁹ *10x Genomics v. Curio Bioscience*, LD Düsseldorf, UPC_CFL_463/2023, April 30, 2024, ([Link](#)).

²⁰ *Ericsson v. Asustek*, LD Lisbon, UPC_CFL_317/2024, October 15, 2024, para. 51 et seq., ([Link](#)).

²¹ *Dyson v. SharkNinja*, LD Munich, UPC_CFL_443/2023, May 21, 2024, ([Link](#)).

²² *Syngenta v. Sumi Agro*, LD Munich, UPC_CFL_201/2024, August 27, 2024, ([Link](#)).

²³ *Ortovox v. Mammüt*, LD Düsseldorf, UPC_CFL_452/2023, April 9, 2024, ([Link](#)).

²⁴ *10x Genomics v. Curio*, LD Düsseldorf, UPC_CFL_453/2024, April 30, 2024, ([Link](#)).

²⁵ *Ortovox v. Mammüt*, LD Düsseldorf, UPC_CFL_452/2023, April 09, 2024, ([Link](#)).

²⁶ *Mammüt v. Ortovox*, CoA, UPC_CoA_182/2024, September 25, 2024, ([Link](#)).

In *10x Genomics v. Curio*²⁷, the court considered that some delay, between becoming aware of allegedly infringing products and filing the application, is necessary for the applicant to carry out an investigation and make an analysis on infringement. Here, the court explicitly stated that a delay of up to 2 months should not constitute an unreasonable delay.

*Amycel v. Szymon Spyra*²⁸ represents an extreme case on the spectrum of possible timelines and demonstrates how the specific facts of the case may impact the court's assessment of urgency. The applicant first became aware of the infringement of its patent for brown mushroom strains in July 2023. However, it filed its application for a PI only one year later. The applicant was able to argue that the delay was reasonable, as it had to obtain evidence about the specific strains in order to anticipate arguments the respondent would likely make, and the nature of the samples meant that cultivation was a time-consuming process. The LD The Hague recognized such procedure as necessary and concluded that the applicant had commenced proceedings as soon as it had gathered the necessary evidence.

The LD Brussels²⁹ set a guideline regarding the reasonable timeline between the granting of the European patent and the filing of an application for a PI when the patentee is aware of the facts of the infringement before the European patent is granted. The LD determines a rather short timeline of one month as being reasonable, stating that the actual filing of the PI application with the UPC 3.5 months after the granting lacks urgency. The allegedly infringing product was already on the market for a long time and the applicant had received the EPO's written intention to grant the European patent. Therefore, the applicant could already have taken the necessary preparatory steps, even before the date of grant.

5.3 GRANT/CONFIRMATION OF THE EUROPEAN PATENT INFRINGED

Another factor that makes the urgency clock tick is the grant or confirmation of the European patent, even if the embodiment now allegedly infringing such patent was already on the market with the knowledge of the patentee; only since then it is possible for the patentee to gain knowledge of an infringement of its (just granted/maintained) patent. In *Häfele v. Nehl*³⁰, the LD Munich decided that the timeline is to be measured at the earliest from the day the reference to the grant of the patent in suit was published, or at least from the granting of the application for unitary effect. Knowledge of any infringement of a valid patent could only exist from one of these dates and an application for interim measures could only be initiated at this point of time.

Subsequently, the LD Brussels was the first LD to further elaborate the issue of which date - granting of the European patent or registration of the unitary effect - is to be taken into account in *Barco v. Yealink*³¹. This decision discussed the question of when the urgency for a granted European patent begins, if the unitary effect is only registered retrospectively. Based on the substantive jurisdiction of the UPC to hear infringement actions or provisional measures for European patent, the LD stated that the date of grant of the European patent is decisive as the objective earliest date to file an action (for provisional measures) with the UPC and not the date of registration of the unitary effect of this European patent.

Concluding and practically speaking, once the applicant becomes aware of (imminent) infringement, the applicant should – in any case – document the steps taken from that point through to filing the application.

6. WEIGHING THE INTERESTS OF THE PARTIES – WHY NOT WAIT?

Probably the most important issue in practice is to justify why the case cannot wait to be decided in an action on the merits. Insofar, the court has the discretion to weigh the interests of the parties and to take into consideration the potential harm for either of them resulting from the grant or the refusal of the PI³².

²⁷ *10x Genomics v. Curio Bioscience*, LD Düsseldorf, UPC_CFI_463/2023, April 30, 2024, ([Link](#)).

²⁸ *Amycel v. Szymon Spyra*, LD The Hague, UPC_CFI_195/2024, July 31, 2024, ([Link](#)).

²⁹ *Barco v. Yealink*, LD Brussels, UPC_CFI_582/2024, March 21, 2025, para. 57, ([Link](#)).

³⁰ *Häfele v. Nehl*, LD Munich, UPC_CFI_443/2024, November 25, 2024, p. 46, ([Link](#)).

³¹ *Barco v. Yealink*, LD Brussels, UPC_CFI_582/2024, March 21, 2025, para. 57, ([Link](#)).

³² *Valeo v. Magna*, LD Düsseldorf, UPC_CFI_347/2024, October 31, 2024, p. 30, V., ([Link](#)).

The CoA already confirmed in *Mammut v. Ortovox*³³, that irreparable harm is not a necessary condition for ordering provisional measures. The appropriate approach is rather to balance whether the applicant's interest overall outweighs those of the respondent. Hence, the CoA agreed with the LD Düsseldorf stating that, by awaiting main proceedings, the distribution of the contested embodiment (an avalanche transceiver), would deprive the applicant's market opportunity associated with the patent protection. Proceedings on the merits could not affect the distribution of the contested embodiment in the upcoming winter season. The option that the orders in favor of the respondent would be canceled and demand would be revived in case of a granting decision on the merits, would force the applicant to pre-produce the products at their own risk in order to cover the potential demand that would eventually increase at short notice.

In *10x Genomics v. NanoString*³⁴, the LD Munich decided in favor of the applicant as the court was convinced with a significantly higher probability that the patent in suit was valid and infringed. As the LD also did not consider the possibility of long-term harm caused by the order for provisional measures or their dismissal to be unilaterally detrimental to the respondents, the LD granted the PI. In contrast, the CoA³⁵ decided that the patent in suit was more likely than not invalid and therefore lifted the PI.

In *Abbott v. Sibio*³⁶, the CoA granted an application for provisional measures. In first instance, the application had been denied by the LD The Hague³⁷. On the balance of probabilities, it was held that the patent in suit would more likely than not be held invalid in proceedings on the merits due to added subject matter. The CoA was convinced that Abbott had an (urgent) interest that Sibio was enjoined from bringing their infringing products ("on-body devices" which form part of an applicator system configured to handle insertion of an in vivo glucose sensor and offered at lower prices) on the market. The damages of the respondent due to a later market

entry, should the injunction be lifted in proceedings on the merits, would be easier to determine, whereas the applicant's damages due to the long term effect of price erosion was difficult to quantify, also in view of its influence on the price of similar devices marketed by third parties and on the prices set by insurers. The CoA also considered as decisive that the respondent was based in China with no apparent assets within UPC territory, and the associated uncertainty as to whether any damages suffered by the patentee could be recovered.



In *Valeo v. Magna*³⁸, the LD Düsseldorf held that the interest of the applicant outweighed the interest of the respondent. The applicant's market would be initially blocked and threatened with a permanent loss of market share, once a car manufacturer had decided in favor of the respondent. It was clear to the LD that the PI had to be granted. However, the LD excluded further supplies to customer BMW based on already existing delivery obligations from such PI. Herewith, the court respected the outweighing interest of the respondent based on extensive damage due to considerable recourse claims. The court

stated explicitly that it was not necessary to decide whether the interests of third parties should also be taken into account in the balancing of interests. The respondent had submitted evidence that BMW would suffer substantial damage, as the infringing products used in the BMWs could not be easily replaced by the applicant's system. On such basis, BMW could claim compensation for such resulting damage.

³³ *Mammut v. Ortovox*, CoA, UPC_CoA_182/2024, September 25, 2024, ([Link](#)).

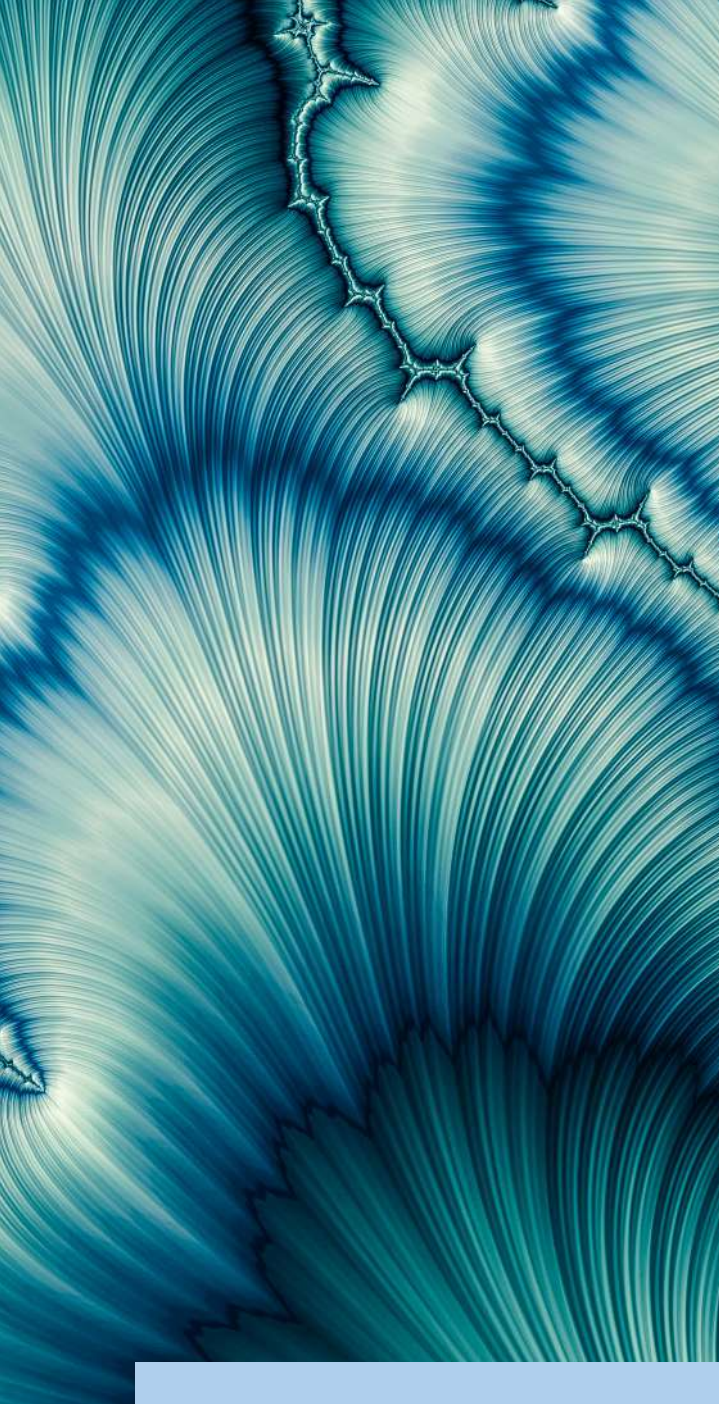
³⁴ *10x Genomics v. NanoString*, LD Munich, UPC_CFI_2/2023, September 19, 2023, ([Link](#)).

³⁵ *10x genomics v. NanoString*, CoA, UPC_CoA_335/2023, February 26, 2024, ([Link](#)).

³⁶ *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, ([Link](#)).

³⁷ *Abbott v. Sibio*, LD The Hague, UPC_CFI_131/2024, June 19, 2024, ([Link](#)).

³⁸ *Valeo v. Magna*, LD Düsseldorf, UPC_CFI_347/2024, October 31, 2024, p. 33, 2 a) bb), ([Link](#)).



6. EX PARTE APPLICATIONS

A PI may be necessary without hearing the respondent (i.e., *ex parte*) in two cases in particular. Firstly, if a delay is likely to cause irreparable damage to the applicant or, secondly, if there is a demonstrable risk that evidence will be destroyed. For these cases, the applicant has the option to apply for an *ex parte* PI. The urgency required for the *ex parte* decision goes beyond the intensity of the urgency already required for the injunction. Such a case is, for example, an only temporary offer of allegedly infringing products, e.g. in the context of a trade fair that has ended before the possible holding of an oral hearing. Irreparable damage, which must also be of more than minor importance in order to outweigh the interest of the respondent, will rarely be caused by the delay associated with a prior hearing: the hearing can be held within a few days or even hours. In fact, the first *ex parte* PI in *myStromer v. Revolt*³⁹ was issued by the LD Düsseldorf on the day of filing of the application.

Damage can usually be compensated. However, relevant irreparable harm may be obvious (i) in typical trade fair cases (such as in *myStromer v. Revolt*, cf. above), or (ii) if seasonal products are at issue (such as in *Ortovox vs. Mammut*⁴⁰).

If the court decides that it cannot rule on the application for the PI without hearing the opponent, the court must inform the applicant. The applicant may then withdraw its application. Otherwise, the respondent will be heard.

In case of a withdrawal of an application for a PI *ex parte*, the applicant can request that the application for a PI be treated confidentially. Otherwise, the court declares the proceedings terminated in a decision and orders the entry of the decision in the register.

7. PROTECTIVE LETTERS

The court takes a protective letter into consideration when deciding on the PI request. However, this does not automatically result in a hearing, as is shown by *myStromer v. Revolt*⁴¹. In this case, even though Revolt had filed a protective letter with the UPC before myStromer filed its PI application, the court did not consider the arguments brought forward in such protective letter to show non-infringement, and rendered an *ex parte* PI.

³⁹ *myStromer v. Revolt*, LD Düsseldorf, UPC_CFL_177/2023, June 22, 2023, ([Link](#)).

⁴⁰ *Mammut v. Ortovox*, CoA, UPC_CoA_182/2024, September 25, 2024, ([Link](#)).

⁴¹ *myStromer v. Revolt*, LD Düsseldorf, UPC_CFL_177/2023, June 22, 2023, ([Link](#)).

CHAPTER

IX

VALIDITY

1. NOVELTY

As a new court, the UPC has had to establish its own case law on how novelty of a patent in suit is assessed. This is shaped by both the LDs via the counterclaims for revocation and also the CD in isolated revocation actions – and, of course, also by the CoA.

The LD Paris ruled in *DexCom v. Abbott*¹ that the novelty test requires whether the invention of the patent in suit is found (i) integrally, (ii) directly and (iii) unambiguously in (iv) one single prior art reference. Furthermore, "it must be identical with its constitutive elements, in the same form, with the same arrangement and the same features". The LD Munich applied the same standard in the parallel case *DexCom v. Abbott*², clarifying further that all claim features must be derived directly and unambiguously from the prior art to anticipate claimed subject matter. The standard of review of the content that is disclosed is what "can and may be expected

from the knowledge and understanding of an average person skilled in the relevant art". The CD Paris applied the same standards in *Kinexon v. Ballinno*³.

According to the CD Munich in *Nanostring v. Harvard*⁴, assessing novelty of a patent requires that the whole content of the prior art is determined. The court repeated that one has to assess whether the subject-matter of the claim with all features is directly and unambiguously disclosed in the prior art.

All in all, it seems as if the UPC has established a joint understanding of how to test novelty.

¹ *DexCom v. Abbott*, LD Paris, UPC_CFI_230/2023, July 4, 2024, ([Link](#)).

² *DexCom v. Abbott*, LD Munich, UPC_CFI_233/2023, July 31, 2024, ([Link](#)).

³ *Kinexon v. Ballinno*, CD Paris, UPC_CFI_230/2024, August 21, 2024, ([Link](#)).

⁴ *Nanostring v. Harvard*, CD Munich, UPC_CFI_252/2023, October 17, 2024, ([Link](#)).

2. INVENTIVE STEP

2.1 DIFFERENT APPROACHES FOR EXAMINATION OF INVENTIVE STEP

The question is whether the standards applied in the UPC decisions so far are more influenced by a German (or any other national) approach, the EPO approach or an entirely new UPC approach.

The EPO problem solution approach calls for

- identifying the closest prior art as starting point for assessing inventive step and determining the difference(s) between the invention and the closest prior art;
- determining the technical effect attributable to those difference(s), and defining the objective technical problem in terms of that technical effect; and
- assessing whether or not the claimed solution represents an obvious solution to the formulated objective technical problem in view of the prior art in general.

National courts in the Contracting Member States, however, do not necessarily follow this EPO approach. By way of example, German courts

- define the relevant prior art at the relevant date, the skilled person and associated level of knowledge, accepting multiple prior art as alternative starting points;
- determine the direction in which efforts are made by the skilled person at the relevant date and whether the skilled person had reason to combine two prior art documents.

To date, the UPC case law on inventive step is not homogeneous (or „unitary“). However, outlines of some common ground is emerging: a careful selection of the starting point, the definition of a problem and the evaluation of the entire prior art.

2.2 CASE LAW OF THE COURT OF APPEAL (CoA)

The CoA provided first thoughts on the assessment of inventive step in its decision *Nanostring v. 10x Genomics*⁵, without, however, setting general guidelines. As far as it concerns the choice of the starting point, the court did not rely on the closest prior art, but rather chose the prior art as the starting point which *would have been of interest to a person skilled in the art who, at the priority date of the patent at issue, was seeking to develop a certain method having a similar underlying problem as the claimed invention*. The CoA introduced an element of subjective evaluation and comparison, instead of simply establishing which prior art shows the most identical features to the claimed invention. In *Mammut v. Ortovox*⁶, the CoA confirmed that several starting points were possible, which then had to be discussed.

Another question addressed in the same decision was whether or not the skilled person had an incentive to think in the direction of the invention, resulting from the solutions and the teaching in the prior art⁷. Further, the CoA discussed the question of a reasonable expectation of success.

In summary, this approach comes closer to the German approach than to the problem solution approach applied in the EPO.

2.3 CASE LAW OF THE COURT OF FIRST INSTANCE

In its most recent decision *NJOY v. VMR*⁸, the CD Paris also referred to the skilled person's interest in the art, while determining one or more realistic starting points for the examination of inventive step, repeating the CoA's considerations in *Nanostring v. 10x Genomics*.

⁵ *Nanostring v. 10xGenomics*, CoA, UPC_CoA_335/2023, February 26, 2024, page 31 et seq., ([Link](#)).

⁶ *Mammut v. Ortovox*, CoA, UPC_CoA_182/2024, September 25, 2024, para. 195-204, ([Link](#)).

⁷ Also see in this regard *Nanostring v. Harvard*, CD Munich, UPC_CFI_252/2023, October 17, 2024, page 41 et seq., ([Link](#)).

⁸ *NJOY v. VMR*, CD Paris, UPC_CFI_311/2023, January 21, 2025, para. 55 et seq., ([Link](#)).

In *NJOY v. JUUL*⁹, the CD Paris took into account considerations known from the problem solution approach. The court stated that limiting the evaluation of inventive step to certain elements of the prior art generally bore the risk of introducing subjective elements into the evaluation. However, for reasons of procedural efficiency, it might be justified in certain cases to focus the debate on a certain element or on certain elements of the prior art, introducing the thought of the closest prior art (problem solution approach) in the evaluation of the starting point.

Since the patent in suit did not formulate an underlying problem, the court interpreted the problem of the patented invention¹⁰, comparing the invention and the claim with the prior art. This approach of the CD Paris – freely choosing the problem solution approach or elements thereof, and also relying on other evaluations and principles – is in line with its decision in *Meril v. Edwards Lifesciences*¹¹, in which it stated that the problem solution approach was not explicitly provided for in the EPC and, therefore, did not appear to be mandatory.

In *Sanofi v. Amgen*¹², the CD Munich clearly defined criteria for assessing inventive step. Not strictly following the problem solution approach, the CD stated that the assessment of inventive step started from a realistic starting point of the prior art.

The court followed the idea of the evaluation of the starting point on the basis of the interest of the skilled person, as also chosen by the CoA in *Nanostring v. 10x Genomics*. Regarding obviousness, the CD Munich relied on the motivation of the skilled person, considering the claimed solution and implementing it as a next step in further developing the prior art. The court also made it clear that in order to deny inventive step, it is sufficient that the skilled person would arrive at a result within the claim without inventive contribution.

In *Mammut v. Orthovox*¹³ and in *Sanofi v. Amgen*¹⁴, the LD Düsseldorf followed many aspects of the CD Munich's lead in the above-quoted decision, further stressing the need to evaluate and examine the inventive step in each single case from the point of view of the skilled person, thus also eschewing the concept of the closest prior art. The LD Düsseldorf further considered it admissible to combine disclosures of the prior art, depending on the circumstances of the case.

In *Meril v. Edwards Lifesciences*, the LD Munich has now taken a rather clear view in favour of the problem solution approach, summarizing in its second headnote:

For assessing whether an invention shall be considered obvious having regard to the state of the art, the problem solution approach developed by the European Patent Office shall primarily be applied as a tool to the extent feasible to enhance legal certainty and further align the jurisprudence of the Unified Patent Court with the jurisprudence of the European Patent Office and the Boards of Appeal.

At the same time, the court stressed¹⁵ that both tests – the so-called German test applied by the German Federal Court of Justice and the problem solution approach – should lead to the same results in the majority of the cases,

(...) both tests requiring a realistic starting point and an incentive for the skilled person to do the next step, e.g. to amend the technical solution disclosed by the starting point to arrive at the patented solution. As none of the tests is enshrined in the European Patent Convention (EPC) and lead basically to the same results, both can be applied as a tool to assess inventive step. However, this panel takes the decision to apply the PSA as practiced by the EPO, including the BOAs, to the extent feasible and to state this explicitly as there is a need for legal certainty for both the users of the system and the various Divisions of the Unified Patent Court. Applying the PSA further aligns the jurisprudence of the Unified Patent Court with the jurisprudence of the EPO and the BoA.

⁹ *NJOY v. JUUL*, CD Paris, UPC_CFI_315/2023, November 5, 2024, Recital 12.1. et seq., ([Link](#)).

¹⁰ Recitals 7.41 to 7.43.

¹¹ *Meril v. Edwards Lifesciences*, CD Paris, UPC_CFI_255/2023, July 19, 2024, para. 153, ([Link](#)).

¹² *Sanofi v. Amgen*, CD Munich, UPC_CFI_1/2023, July 16, 2024, especially headnotes 4 and 5, ([Link](#)).

¹³ *Mammut v. Orthovox*, LD Düsseldorf, UPC_CFI_16/2024, January 14, 2025, p. 27 et seq., ([Link](#)).

¹⁴ *Sanofi v. Amgen*, LD Düsseldorf, UPC_CFI_505/2024, May 13, 2025, para. 127 et seq., ([Link](#)).

¹⁵ *Meril v. Edwards Lifesciences*, LD Munich, UPC_CFI_501/2023, April 4, 2025, p. 68 et seq., ([Link](#)).

2.4 POSSIBLE CRITERIA FOR INVENTIVE STEP AND CONCLUSION

In the case law of the UPC so far, some criteria for inventiveness can be filtered out, such as an additional creative effort (meaning the invention does not result from the usual approach of the person skilled in the art.)¹⁶ or the fact that the prior art is not consistent with its teaching¹⁷. Obviousness was assumed, for example, by the CoA in *Nanostring v. 10xGenomics*¹⁸, where the claimed invention merely transitioned from a prior art setting in vitro to in situ as claimed.

The LD Paris in *DexCom v. Abbott*¹⁹ considered that application of technical knowledge plus simple operations implied obviousness, as did the CD Munich in *Sanofi v. Aventis*²⁰ for an arbitrary selection out of several possibilities.

Although the UPC – to date – seems to tend towards the problem solution approach of the EPO, this approach should not be seen as mandatory, as the UPC seems to also take into consideration other aspects and different points of view in its assessment of inventive step.

For the time being, and until the approach finally solidifies, one should therefore strive to include several lines of argumentation relating to inventive step in UPC proceedings.

3. ADDED SUBJECT MATTER

With respect to added subject matter, the tests applied by the UPC so far appear to align well with those applied in the EPO.

The LD The Hague decided in *Abbott v. Sibio*²¹, that it will follow the so-called "gold standard" disclosure test as applied by the (Technical and Enlarged) Board of Appeal of the EPO. Consequently, amendments can

...only be made within the limits of what a skilled person would derive directly and unambiguously, using common general knowledge, and seen objectively and relative to the date of filing, from the whole of the application as filed.

The LD The Hague stressed that this was a stricter test than assessing whether the claimed subject matter was "obvious" to the skilled person (at no. 3.5). On appeal, the CoA²² applied the same definition, adding that

...implicitly disclosed subject-matter, i.e. matter that is a clear and unambiguous consequence of what is explicitly mentioned, shall also be considered as part of its content.

In *NJOY v. Juul Labs*²³, the CD Paris followed the same approach. The court emphasized that since the granted claims were not disclosed *verbatim* in the applications, it was the patentee's burden of proof to show that the changes made are directly and unambiguously derivable from the application (at no. 9.8).

The court discussed the various arguments at length and came to the conclusion that the patent is to be revoked since it extended beyond the content of the application.

In *Kinexon v. Ballinno*²⁴, the CD Paris confirmed the aforementioned previous case law and held that the patent was to be revoked in view of added subject matter. In this case, the patent related to sensing the acceleration signal produced by a ball.

While the original disclosure required that the acceleration signal is sensed inside the ball, the (auxiliary) claim left the position of the sensing means open, i.e. also allowed for sensing outside of the ball.

¹⁶ *Kaldewei v. Bette*, LD Düsseldorf, UPC_CFL_7/2023, July 3, 2024, under I 2., (Link).

¹⁷ *Meril v. Edwards Lifesciences*, CD Paris, UPC_CFL_255/2023, July 19, 2024, para. 135, (Link).

¹⁸ *Nanostring v. 10xGenomics*, Court of Appeal, UPC, CoA_335/2023, February 26, 2024, para. 31 et seq., (Link).

¹⁹ *DexCom v. Abbott*, LD Paris, UPC_CFL_230/2023, July 4, 2024, Recital 23 et seq., (Link).

²⁰ *Sanofi v. Aventis*, CD Munich, UPC_CFL_1/2023, July 16, 2024, Recital 8.66 et seq., (Link).

²¹ *Abbott v. Sibio*, LD The Hague, UPC_CFL_131/2023, June 19, 2024, para. 3.4., (Link).

²² *Abbott v. Sibio*, CoA, UPC_CoA_382/2024, February 14, 2025, para. 52, (Link).

²³ *NJOY v. Juul Labs*, CD Paris, UPC_CFL_131/2024, January 17, 2025, para. 9.2., (Link).

²⁴ *Kinexon v. Ballinno*, CD Paris, UPC_CFL_230/2024, April 30, 2025, (Link).

Interestingly, in *Meril v. Edwards Lifesciences*²⁵, the concept of an intermediate generalization was acknowledged by the CD Paris. The CD followed the EPO in conclusions reached in a case relating to a patent from the same family. The UPC followed well established EPO case law by holding (at para. 54):

An undue extension may result from an amendment to the claims or the description consisting of an intermediate generalisation, i.e. by extracting one or more isolated features which, in the initial application, were disclosed only in combination with other features, thereby extending the claimed subject matter, which is no longer limited to this initial combination of features.

The court regarded the subject matter as extending beyond the content of the original application by way of an intermediate generalization, since a non-optional feature was isolated even though originally it was disclosed only in combination with the other features in the earlier application.

4. PRIORITY

Similarly as with UPC case law developed relating to added subject matter, the UPC seems to follow the EPO approach in assessing priority entitlement. In the recent decision *Sanofi v. Amgen*, the LD Düsseldorf held that a claimed invention is to be considered the "same" invention as the one in the attacked patent

*if the skilled person can derive the subject-matter of the claim directly and unambiguously, using common general knowledge, from the previous application as a whole...*²⁶

5. INSUFFICIENCY OF DISCLOSURE

In *Sanofi v. Amgen*, the LD Düsseldorf²⁷, took the position that in order for the subject matter to be sufficiently disclosed, the patent needed to demonstrate the workability of the claimed subject-matter. The skilled person's general knowledge was to be taken into account when considering sufficiency of disclosure. The court came to the conclusion that no serious doubt had been raised about the sufficiency of disclosure.

In *Fujifilm v. Kodak*, the LD Düsseldorf²⁸ held that the subject-matter of claim 1 as granted was insufficiently

disclosed, and the patent was revoked. The court held that when considering sufficiency of disclosure, all technically sensible claim interpretations must be taken into account. It stressed that the skilled person must be enabled to use the invention across the entire scope claimed without undue burden. The court also held that sufficiency of disclosure constitutes a matter of fact.

6. CLAIM AMENDMENTS

In *Carrier v. Bitzer*²⁹, the CD Paris observed that the request to amend a patent is inadmissible to the extent that it amends the patent beyond the claims challenged by the revocation action. This is regarded to introduce new subject matter that broadens the scope of the proceedings, which is set by the invalidity claim. The panel acknowledged that this issue was not addressed in any of the relevant sources of law. It regarded patent amendment during litigation as a means to avoid a declaration of invalidity, i.e. limited in its nature to a mere defence only (at paras. 18-21). Accordingly, the court concluded that a patentee's right to amend its patent is limited to addressing only the claims under challenge.

7. AUXILIARY REQUESTS

The number of auxiliary requests has already been an issue of various judicial reviews:

In *Nehl v. Häfele*, the CD Munich³⁰, held that two sets of 40 auxiliary requests each (in total 80) were not reasonable in number, given the circumstances of this case. The court held that it must weigh all the relevant circumstances of the case and the interests of the parties to decide on reasonableness.

²⁵ *Meril v. Edwards Lifesciences*, CD Paris, UPC_CFI_255/2023, July 19, 2024, para. 54., ([Link](#)).

²⁶ *Sanofi v. Amgen*, LD Düsseldorf, May 13, 2025, UPC_CFI_505/2024, para. 111, ([Link](#)); The court cited in support of its opinion *Sanofi v. Amgen*, CD Munich, UPC_CFI_1/2023, July 16, 2024 and *Fujifilm v. Kodak*, LD Düsseldorf, UPC_CFI_355/2023, January 28, 2025.

²⁷ *Sanofi v. Amgen*, LD Düsseldorf, May 13, 2025, UPC_CFI_505/2024, para. 162, ([Link](#)).

²⁸ *Fujifilm v. Kodak*, LD Düsseldorf, UPC_CFI_355/2023, January 28, 2025, ([Link](#)).

²⁹ *Carrier v. Bitzer*, CD Paris, UPC_CFI_263/2023, April 30, 2024, para. 18-21., ([Link](#)).

³⁰ *Nehl v. Häfele*, CD Munich, UPC_CFI_526/2024, April 18, 2025, ([Link](#)).

The court acknowledged that the RoP do not address the sanctions in the event the proposed amendments exceeded a reasonable number. It held that it would consider such amendments (only) until a "*reasonable number has been reached*". The patentee was given the opportunity to limit and/or re-order its proposed auxiliary requests to ensure that it can select the fallback positions considered most relevant. In this specific case, the court gave guidance as to the number of auxiliary requests it was willing to hear, namely up to 10.

In an earlier decision, however, the CD Paris, in *Meril v. Edwards Lifesciences*³¹ regarded a total of 84 auxiliary requests to be admissible. The court acknowledged that while the number of amendments was extremely high, it would not appear that that number was unreasonable considering the extreme complexity of the case, the importance of the patent issued and the relationship with other proceedings. The court added that the lack of a consistent interpretation of the expression "*reasonable in number*" also suggested a less strict interpretation of Rule 30.1 (c) RoP.

8. CERTAIN PROCEDURAL ASPECTS

Late filing and its consequences are an issue before the UPC with its strict rules and deadlines regarding the individual submissions of the parties.

According to the CoA in *Mammut v. Ortovox*³², the CoA is not bound by the decision of the Court of First Instance regarding late filing and whether or not it allows a party to rely on prior art which had been introduced outside of the case management regime (in this case a day before the oral hearing). The CoA exercised its discretion and allowed the defendant to rely on the "*late filed*" prior art document, in particular also because this would not have caused a delay to the proceedings.

The UPC proceedings are front-loaded. This affects also the invalidity discussion. In line with the CD Munich in *Nanostring v. Harvard*³³, a party seeking to rely on a new set of auxiliary requests introduced into the proceedings after closure of the written proceedings and the interim conference, must present a valid reason for the late filing. Otherwise, the court would, as it did in this case, refuse permission to amend the application by the new auxiliary requests. One of the crucial questions is whether the party could (and should) have introduced such requests earlier, taking into account the circumstances of the whole case.

In *Nehl v. Häfele*³⁴, the CD Munich decided that even though a prior art document may have already been cited in the statement for revocation (but only in a "*brief and generic*" capacity), relying on it later in the proceedings can constitute late filing, resulting in the court disregarding it.

In *NJOY v. Juul*³⁵, the CD Paris stressed that the parties are under an obligation to set out their full case as early as possible and to provide all legal and factual arguments and any supporting evidence in a timely manner. The court held that "a generous standard" shall be applied when deciding whether an argument has newly been introduced or raised as a mere reaction to previously filed arguments, since a clear distinction may not always be drawn. From that, one may take that the CD Paris applies a more liberal approach compared to the CD Munich in *Nehl v. Häfele*³⁶.

The CD Paris in *NJOY v. VMR*³⁷ allowed certain documents to the proceedings, which were filed by the claimant as a response to the defence to the revocation action considering the common general knowledge and claim construction.

According to the CD Munich in *Nehl v. Häfele*³⁸, the court will not consider any number of auxiliary requests, but only a reasonable number, finding that ten was a reasonable number in this case. The CD Paris in *NJOY v. Juul*³⁹ considered twelve auxiliary requests to be reasonable.

³¹ *Meril v. Edwards Lifesciences*, CD Paris, UPC_CFL_255/2023, July 19, 2024, ([Link](#)).

³² *Mammut v. Ortovox*, CoA, UPC_CoA_182, 2024, September 25, 2024, ([Link](#)).

³³ *Nanostring v. Harvard*, CD Munich, UPC_CFL_252/2023, October 17, 2024, ([Link](#)).

³⁴ *Nehl v. Häfele*, CD Munich, UPC_CFL_526/2024, April 18, 2025, ([Link](#)).

³⁵ *NJOY v. Juul*, CD Paris, UPC_CFL_316/2023, January 17, 2025, ([Link](#)).

³⁶ *Nehl v. Häfele*, CD Munich, UPC_CFL_526/2024, April 18, 2025, ([Link](#)).

³⁷ *NJOY v. VMR*, CD Paris, UPC_CFL_311/2023, January 21, 2025, ([Link](#)).

³⁸ *Nehl v. Häfele*, CD Munich, UPC_CFL_526/2024, April 18, 2025, ([Link](#)).

³⁹ *NJOY v. Juul*, CD Paris, UPC_CFL_316/2023, January 17, 2025, ([Link](#)).

Burden of proof lies with the party relying on the asserted facts¹. In many cases, the patentee, however, has difficulties in providing the necessary evidence for infringement of the patent claims. In several member states of the European Union, such as France or Belgium (in the latter case even for patent infringement cases in a third state), and now under the UPC regime, *saisie* requests have therefore been granted by courts in order to force the defendant to allow the search for evidence on its premises.

This opportunity gains special weight under the UPC regime, which establishes so-called front-loaded proceedings and makes the collection of the necessary evidence – in many cases even pre-loaded – more and more important².

The assessment regarding grant of the order to preserve evidence is in the sole discretion of the court³. Further, the court shall, in its own discretion, assess the question of the hearing of the parties, if – as in many cases – the applicant requests an *ex parte* order.

To date, the following decisions of the UPC have shown that the Court carefully balances the interests of the parties – paying attention to the principle of proportionality – throughout its assessments regarding the hearing of the parties, the decision on the grant of the requested order and the modalities of the ordered preservation of evidence.

¹ cf. also Art. 55 UPCA and R. 171 RoP

² For the front-loaded proceeding, *OrthoApnea v. Vivisol*, CoA, UPC_CoA 456/2024, November 21, 2024, para. 26 et seq. ([Link](#)).

³ cf. Art. 60 UPCA: the court may [...] order prompt and effective provisional measures to preserve relevant evidence

CHAPTER

PRESERVING EVIDENCE

1. ASSESSMENT OF A REQUEST FOR AN ORDER EX PARTE – CASE LAW OF THE UPC

According to R. 194 (2) RoP, the court shall take into account within its decision the urgency of the action – whether the reasons for not hearing the defendant appear well founded – and the probability that evidence may be destroyed or otherwise cease to be available..

The UPC has especially dealt with cases where "extreme urgency" had been asserted by the applicant. In *Tiru v. Valinea Energy*⁴, the LD Paris stated that even after two months, starting with the information on the existence of the allegedly infringing item, such ex parte order to preserve evidence was still possible, as two months were considered as a reasonable time to compile the file. In the same case, the court explained that "extreme urgency", as asserted by the applicant, could not be assumed, as this "would need to be dealt with immediately by the duty judge on the day of the referral"⁵.

However, in several cases regarding trade fairs, the UPC has even accepted "extreme urgency", such as in the decision of the LD Milan in *Oerlicon v. Himson*⁶, where time constraints would not have allowed the parties to be convened before the end of the trade fair (which was on the next day in that case), also taking into consideration the risk that the evidence would no longer be accessible to the applicant after the exhibition, since the defendant was based abroad and the documents indicated were easy to conceal and destroy.

Those considerations in favor of an order ex parte were also applied by the LD Brussels in *Nelissen v. OrthoApnea S.L.*⁷, where the request was assumed to be urgent in view of a symposium taking place only within two days and the expectation that the evidence would not be available in the relevant territory thereafter. This assumption was not altered by the fact that the documents showed that the claimant had already been aware of the defendant's expected attendance at the symposium two months before.

Further, the UPC evaluates whether or not the allegedly infringing item can be easily destroyed or transported, as the LD Paris in *Tiru v. Valenia Energy*⁸ and the LD Brussels in *Nelissen v. OrthoApnea*⁹ held. Especially if the order to preserve evidence also pertains to computer data, the Divisions readily accept a risk of destruction of evidence, as, e.g., the LD Paris held in *C-Kore Systems v. Novawell*¹⁰.

Thus, one can conclude that the UPC is willing to accept ex parte orders to preserve evidence, often focusing on the aspect that the evidence may be destroyed or otherwise cease to be available. Many decisions so far concerned cases of tradefairs, symposia or other chronologically limited accessions to evidence.

2. ASSESSMENT OF GRANT

The first question is whether the order shall be granted at all, the second refers to the specific measures taken and their execution.

The assessment of grant requests the balance of interests, as summarized by the LD The Hague in *Data Detection Technologies v. Doytec*¹¹:

The weighting up of the interest of all parties implies granting the measure, considering the potential risk of harm for each of the parties, in the case of granting - for the defendant - or denial of the measure - borne by the applicant. Taking into consideration the principle of proportionality, the threat of definitive loss of the evidence borne by the applicant is deemed to be prevalent over the defendant's exposure to the enforcement of the required measures.

The LD Munich decided in *Swarco-Futurit v. Yunex*¹² that the grant of such order was no longer necessary and therefore not proportionate, since the need for the plaintiff to provide evidence had ceased, the defendant having not contested the statements.

⁴ *Tiru v. Valinea Energy*, LD Paris, UPC_CFI_814/2024, March 24, 2025, Recital 4.1 ([Link](#)).

⁵ Applications marked as "extremely urgent" are generally dealt with by a standing Judge (R. 345 (5) RoP).

⁶ *Oerlicon v. Himson*, LD Milan, UPC_CFI_127/2023, June 13, 2023, Recital 2.1 et seq., ([Link](#)).

⁷ *Nelissen v. OrthoApnea S.L.*, LD Brussels, UPC_CFI_329/2023, September 21, 2023, ([Link](#)).

⁸ *Tiru v. Valenia Energy*, LD Paris, UPC_CFI_184/2024, March 24, 2025, ([Link](#)).

⁹ *Nelissen v. OrthoApnea S.L.*, LD Brussels, UPC_CFI_329/2023, September 21, 2023, para. 3 et seq., ([Link](#)).

¹⁰ *C-Kore Systems v. Novawell*, LD Paris, UPC_CFI_397/2023, November 14, 2023, para. 4, ([Link](#)).

¹¹ *Data Detection Technologies v. Doytec*, LD The Hague, UPC_CFI_554/2024, September 25, 2024, ([Link](#)).

¹² *Swarco-Futurit v. Yunex*, LD Munich, UPC_CFI_156/2024, February 19, 2025, ([Link](#)).

It is worth mentioning that the UPC does not examine validity of the patents in suit in this context. As long as there are no pending proceedings challenging validity, the UPC generally considers the patent to be valid, as was held by the LD Paris in *Novawell v. C-Kore Systems*¹³ or the LD The Hague in *Data Detection Technologies v. Doytec*.

In its decision on the application for an order, the court "may grant" such order subject to the protection of confidential information, Art. 60 (1) UPCA. In *Progress v. AWM*¹⁴, the CoA requested that the granting of an application for preservation of evidence or inspection of premises did not imply an unconditional order to disclose the evidence to the applicant:

Pursuant to Article 60 (1) UPCA, the order must be subject to the protection of confidential information [...] where the evidence may contain confidential information. This entails that the court must hear the other party before deciding whether and to what extent to disclose the evidence to the Applicant. In this context, the court must give the other party access to the evidence and must provide the party with the opportunity to request the court to keep certain information confidential and to provide reasons for such confidentiality. If the other party makes such a confidentiality request, the court must provide the applicant with the opportunity to respond in a manner that respects the potential confidentiality interests of the other party.

3. ASSESSMENT OF THE MODALITIES OF EXECUTION

The exact steps to be taken within the measure of preserving evidence are described within the order. Often a seasoned patent attorney, without any relationship to either of the parties, and assisted by a competent bailiff, conducts the measure. An operative part accompanies the order, describing the measures to be taken in detail (cf. LD The Hague in *Data Detection Technologies v. Doytec*¹⁵). In *Maschio Gaspardo v. Spiridonakis*¹⁶, the CD Milan ordered the gathering of "dynamic" evidence, while seeing a certain machine in operation at the defendant's site.

The authorized measure is then carried out according to the domestic national law in the territory in which the action is to be carried out.

In line with these principles, the LD Paris has, e.g., stated in *Tiru v. Valinea*¹⁷ that access to any informa-

tion and documents gathered by the expert responsible for carrying out the actions be limited to the party's representatives:

A confidentiality circle would then be set up, and information relevant to the case as well as information considered a business secret, to be kept confidential so that access is limited to specific persons.

Further, the order generally states who may have access to the description provided by the expert after the preservation action, cf., e.g., the LD Milan in *Oerlikon v. Himson*¹⁸:

The applicant may attend the description operations by means of his trusted lawyers and one of his trusted technical advisors, with the express prohibition for other representatives, employees or servants of the appellant to be present at the execution of the measure. The appointed expert shall file a written report of the activities carried out [...] it is ordered that the documents acquired be accessible under further order of the court only to the applicants, to lawyers, and the technical expert of his choice. The evidence acquired may be used only in the future judgment on the merits as better indicated in the operative part.

In this context, one may also refer to the considerations of the CoA in *Progress v. AWM*¹⁹ and of the LD The Hague in *Data Detection Technologies v. Doytec*²⁰.

¹³ *C-Kore Systems v. Novawell*, LD Paris, UPC_CFI_397/2023, November 14, 2023, para. 4, ([Link](#)).

¹⁴ *Progress v. AWM*, CoA, UPC_CoA_177/2024, July 23, 2024 ([Link](#)).

¹⁵ *Data Detection Technologies v. Doytec*, LD Munich, UPC_CFI_554/2024, September 25, 2024, ([Link](#)).

¹⁶ *Maschio Gaspardo v. Spiridonakis*, CD Milan, UPC_CFI_513/2024, May 15, 2025, p. 2, ([Link](#)).

¹⁷ *Tiru v. Valinea*, LD Paris, UPC_CFI_814/2024, March 24, 2025; Recital 6.3., ([Link](#)).

¹⁸ *Oerlikon v. Himson*, LD Milan, UPC_CFI_127/2023, Recital 4.2., June 13, 2023, ([Link](#)).

¹⁹ *Progress v. AWM*, CoA, UPC_CoA_177/2024, July 23, 2025, ([Link](#)).

²⁰ *Data Detection Technologies v. Doytec*, LD Munich, UPC_CFI_554/2024, September 25, 2024, ([Link](#)).

CONFIDENTIALITY – PROTECTING SENSITIVE DATA BEFORE THE UPC



CHAPTER



1. PROTECTION OF SENSITIVE DATA AS A KEY TO A FAIR TRIAL

Even the earliest adopters of the UPC acted to protect sensitive information in their proceedings. This resulted in a number of decisions by the UPC from its very beginning, issuing orders to protect such information.

Since then, the court has frequently been confronted with requests from either of the parties to allow them to produce information they deem sensitive and, hence, worthy to protect, but, on the other hand, necessary to be produced to bolster their argumentation.

2. PROCEDURAL ASPECTS AND REQUIREMENTS

The LD Düsseldorf¹ decided in *10x Genomics v. Curio Bioscience* that preliminary confidentiality measures can be granted without hearing the other party. Only the final order stipulating the confidentiality measures requires hearing the other party before issuance.

In case the request of a party for a confidentiality regime is not or not fully granted, the UPC typically informs the respective party allowing withdrawal of the request, including the accompanying documents, which will in the end result in the documents not having become part of the proceedings. This was for instance the case in the LD Mannheim's decisions *Panasonic v. Xiaomi* and *DISH v. Aylo*². In such a case, the documents will also not be served on the other party.

3. SCOPE OF PROTECTION

3.1 DATA TO BE PROTECTED

Art. 2 (1) of the Trade Secrets Directive³ provides for a definition of what constitutes a "trade secret". A trade secret is any information that is not generally known, has commercial value due to its secret nature and is subject to reasonable means to keep it secret. Aside from this "classic" definition, the UPC can also qualify other data as confidential, thereby protecting it from unrestricted access and use. An example for such other information is personal data, protected by e.g. the German Data and Privacy Act, which is explicitly mentioned in Art. 58 UPCA.

In order to facilitate the whole process, the party seeking to disclose the sensitive information does not have to prove to the court's full satisfaction that the information constitutes a trade secret. According to the LD Hamburg in *AGFA v. Gucci*⁴, the threshold is that it is "predominantly probable" that the requirements of a trade secret are met.

On that basis, the UPC has ordered protection measures for a variety of information, such as

- technical details of a product⁵,
- technical aspects of quality control⁶,
- details of the supply chain⁷,
- details of manufacturing tools⁸,
- sales information⁹
- financial records of a company¹⁰, and
- license agreements covered by NDAs¹¹.

The LD Mannheim¹² held in *Panasonic v. OPPO* that the existence of an NDA that already provides protection for the specific information does not preclude the court from issuing a protective order – simply, because this will extend the already existing protection.

Given that many cases are not only single infringement matters, but are rather part of a larger litigation campaign, the UPC also had to decide on what happens if the disputed information is subject to multiple divergent protection standards and even on what might impair the status as protectable information. According to the LD Mannheim in *Panasonic v. OPPO*, confidentiality measures do not become inapplicable simply due to the information having already been accidentally submitted in another UPC proceeding¹³.

In line with the LD The Hague in *Plant-e v. Arkyne*¹⁴ confidentiality measures can also limit use of information to specific types of proceedings, for instance restricting use for determining the security deposit for costs of proceedings.

3.2 CONFIDENTIALITY CLUB

The concept of providing for a fair trial is also taken into account when R. 262A(6) RoP stipulates that the number of persons having access to the sensitive information is limited. It provides that the number shall be no greater than what is minimally necessary to ensure compliance with the right of the parties to an effective remedy and to a fair trial. This confidentiality club shall – according to R. 262A(6) RoP – include, at least, one natural person from each party, their lawyers and other representatives to the legal proceedings.

¹ *10x Genomics v. Curio Bioscience*, LD Düsseldorf, UPC_CFI_463/2023, February 23, 2024, ([Link](#)).

² *Panasonic v. Xiaomi*, LD Mannheim, UPC_CFI_210/2023, February 14, 2024, ([Link](#)); *DISH v. Aylo*, LD Mannheim, UPC_CFI_471/2023, July 22, 2024, ([Link](#)).

³ EU Directive 2016/943.

^{4, 5, 6, 7, 8} *AGFA v. Gucci*, LD Hamburg, UPC_CFI_278/2023, August 9, 2024, ([Link](#)).

⁹ *Abbott v. Dexcom*, LD Paris, UPC_CFI_230/2023, January 30, 2024, ([Link](#)).

¹⁰ *Plant-e v. Arkyne*, LD The Hague, CFI_239/2023, March 4, 2024, ([Link](#)).

¹¹ *Microsoft v. Suinno*, CD Paris, UPC_CFI_164/2024, September 16, 2024, ([Link](#)).

^{12, 13} *Panasonic v. OPPO*, LD Mannheim, UPC_CFI_210/2023, July 9, 2024, ([Link](#)).

¹⁴ *Plant-e v. Arkyne*, LD The Hague, CFI_239/2023, March 4, 2024, ([Link](#)).

Initially, the LD Düsseldorf held in *10x Genomics v. Curio Bioscience* that the confidentiality club may even exclude paralegals¹⁵. It is questionable, though, if this is really a reasonable approach, since a lot of the work relating to handling filings, engaging with the CMS and finally drafting the submissions is performed with paralegal cooperation and help. Excluding them may impose restrictions that will automatically make handling the cases much more difficult and consume more attorney resources. There seems to be a shift in case law, now also allowing access to support staff, such as paralegals. This emerges from the decision by the LD Düsseldorf in *Valeo v. Magna*¹⁶.

In terms of numbers, case law seems to have shifted from stipulating a specific number of members, such as four lawyers, two patent attorneys, three party representatives (LD Düsseldorf in *10x Genomics v. Curio Bioscience*)¹⁷ to the actual teams handling the cases¹⁸ (LD Düsseldorf in *Valeo v. Magna*; LD Mannheim in *DISH v. Aylo*).

According to the LD Mannheim in *DISH v. Aylo*¹⁹, addition of members to the confidentiality club cannot proceed without first testing their eligibility. A member of the confidentiality club must be a reliable person and it must be warranted that the person will not misuse any knowledge about confidential information.

Further, the very party's interest in having the specific person become member of the confidentiality club needs to be considered. It seems however that, despite existence of information to the contrary, the court assumes that the members suggested by a party fulfill the requirements.

In particular, parties with a US/UK background or US/UK litigation experience are accustomed to even stricter protective orders with a more limited confidentiality club. Neither the Trade Secrets Directive, the UPCA nor the RoP allow for an attorneys-eyes-only ("AEO") limitation. However, at least some LDs are willing to order for such AEO protective orders if all parties agree²⁰ (LD The Hague in *Plant-e v. Arkyne*; LD Milan in *Oerlikon v. Bhagat*; LD Paris in *C-Kore v. Novawell*).

3.3 REQUEST TO PRODUCE EVIDENCE AND THIRD PARTY INTERESTS

Upon request, the UPC can issue an order to produce evidence against the other party – even against a third party not involved in the proceedings.

R. 190(1) RoP stipulates for this case that the court may order that the evidence be disclosed to certain named persons only and be subject to appropriate terms of non-disclosure.

3.4 REMEDIES IN CASE OF BREACH

With its protective order, the court can impose a penalty payment upon the receiving party for each case of breach. The respective penalty can be determined by the court in the event of a violation of the protective order.

4. SUMMARY

From what we can see from the decisions and orders dealing with confidentiality issues, the UPC gives great deference to protecting sensitive information and allowing for a fair trial for all the parties.

¹⁵ *10x Genomics v. Curio Bioscience*, LD Düsseldorf, UPC_CFI_463/2023, February 23, 2024, ([Link](#)).

¹⁶ *Valeo v. Magna*, LD Düsseldorf, UPC_CFI_347/2024, August 21, 2024, ([Link](#)).

¹⁷ *10x Genomics v. Curio Bioscience*, LD Düsseldorf, UPC_CFI_463/2023, February 23, 2024, ([Link](#)).

¹⁸ *DISH v. Aylo*, LD Mannheim, UPC_CFI_471/2023, July 22, 2024, ([Link](#)); *Valeo v. Magna*, LD Düsseldorf, UPC_CFI_347/2024, August 21, 2024, ([Link](#)).

¹⁹ *DISH v. Aylo*, LD Mannheim, UPC_CFI_471/2023, July 22, 2024, ([Link](#)).

²⁰ *Plant-e v. Arkyne*, LD The Hague, CFI_239/2023, March 4, 2024, ([Link](#)); *Oerlikon v. Bhagat*, LD Milan, UPC_CFI_241/2023, May 6, 2024, ([Link](#)); *C-Kore v. Novawell*, LD Paris, UPC_CFI_397/2023, March 26, 2024, ([Link](#)).

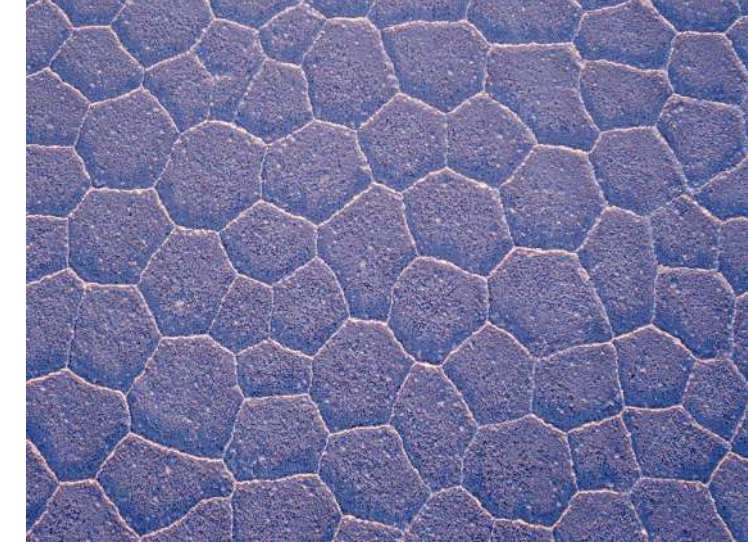


1. THE UPC ENTERS THE FRAND ARENA

Since its launch in June 2023, the UPC has swiftly positioned itself as a central forum for pan-European patent litigation also in the field of standard essential patents (SEPs) /FRAND disputes.

The FRAND concept – referring to licensing terms that are Fair, Reasonable, And Non-Discriminatory – comes into play when a patent is essential to a standardized technology. In infringement proceedings, implementers may invoke a FRAND defense, arguing that the patentee has failed to comply with its licensing obligations and that an injunction would amount to an abuse of dominance under Article 102 TFEU.

While the underlying principles of FRAND were laid down by the court of Justice of the European Union *Huawei v. ZTE*¹, the interpretation and application of FRAND obligations have varied widely across national courts. In the last two years, three key developments have contributed to a shifting legal landscape in Europe:



- The European Commission submitted *amicus curiae letters*², criticizing the burden placed on implementers under German case law.
- UK courts have increasingly relied on the concept of an "interim license" – a procedural mechanism allowing implementers to maintain access to SEP technology while negotiations or litigation are ongoing.
- Most significantly, the UPC has begun to articulate its own approach to FRAND disputes, setting the tone for a more harmonized framework.

FRAND

XII

CHAPTER



2. THE FIRST DECISIONS ON FRAND AT THE UPC

As of April 2025, the UPC has handed down two noteworthy decisions addressing the legal framework surrounding FRAND defenses in SEP litigation. Both decisions originated from German LDs: the LD Mannheim in *Panasonic v. OPPO*³ and the LD Munich in *Netgear v. Huawei*⁴. They provide initial indications of how the court assesses parties' negotiation conduct, evaluates the plausibility of license offers, and defines procedural obligations in SEP disputes.

¹ *Huawei v. ZTE*, CJEU, C-170/13, July 16, 2015, ([Link](#)).

² *European Commission, amicus curiae letters dated April 15, 2024, submitted in HMD v. VoiceAge, Munich Court of Appeal, docket nos. 6 U 5066/22 Kart and 6 U 3824/22 Kart, decision issued March 20, 2025, (Link)*.

³ *Panasonic v. OPPO, LD Mannheim, UPC_CFI_210/2023, November 22, 2024, (Link)*.

⁴ *Netgear v. Huawei, LD Munich, UPC_CFI_9/2023, December 18, 2024, (Link)*.

2.1 PROCEDURAL BACKGROUND AND CASE OVERVIEW

In *Panasonic v. OPPO*, Panasonic pursued an infringement action before the UPC as part of a broader, multi-jurisdictional enforcement strategy. Shortly before decision, OPPO moved for a suspension of the UPC case, citing continuing negotiations. The court denied the request and issued its decision before any settlement had been finalized. The parties subsequently resolved the matter.

In *Netgear v. Huawei*, claimant Huawei initiated infringement proceedings before the LD Munich as part of a broader Wi-Fi 6 enforcement campaign targeting several implementers, including *AVM*, *Amazon*, and *Stellantis*. Similar to the Panasonic case, the UPC issued a decision shortly before the dispute was settled.

In both cases, the LDs addressed submissions by the European Commission, which had filed *amicus curiae* letters⁵ in a German national proceeding. These letters reflected the Commission's concerns regarding the evolving FRAND jurisprudence in Germany, particularly with respect to how courts assess negotiation behavior under the *Huawei v. ZTE* framework.

The Commission used that context to set out its position on how the FRAND steps established by the court of Justice in *Huawei v. ZTE* should be applied. It expressed concern that some courts, in particular the Regional court of Munich, had adopted a front-loaded analysis focused heavily on the conduct of the implementer.

In that approach, courts often reviewed the entire negotiation behavior of the implementer already at step two, which frequently led to findings that the implementer was not a willing licensee. This prevented any substantive review of whether the SEP holder's offer complied with FRAND conditions.

The Commission argued that the FRAND steps should be reviewed in a strictly sequential manner. In its view, step two, the implementer's initial declaration of willingness to take a license, should not be burdened with additional requirements or assessed in light of the implementer's overall conduct. The threshold for step two should remain low and separated from later stages of the analysis.

Both the Mannheim and Munich LDs acknowledged the content of the Commission's letters but did not adopt the approach proposed. In each case, the court treated the letters as non-binding and applied a more flexible assessment based on the full course of negotiation conduct by both parties.

2.2 APPLICATION OF THE HUAWEI V. ZTE FRAND STEPS BY THE UPC

Step 1: Notice of Infringement

In *Panasonic v. OPPO*, held that Panasonic had provided sufficient notice of infringement. The court found that it was not necessary for all relevant information to be included in a single document. A claim chart referring to a Chinese patent family member, which included an explicit reference to the asserted European patent, was accepted as adequate. The court noted that OPPO, if acting as a cooperative licensee, could have raised any concerns regarding the claim chart at an earlier stage.

In *Netgear v. Huawei*, the LD Munich⁷ also found that the SEP holder had sufficiently notified the defendant. It confirmed that the provision of claim charts is generally sufficient. However, the court clarified that referring only to a website does not meet the standard required for proper notification.

In both cases, the courts stated that objections regarding the adequacy of the notice, when raised only during litigation, were not considered timely.

Step 2: Willingness to Take a License

In *Panasonic v. OPPO*, the LD Mannheim⁸ assessed whether the defendant had expressed a sufficient willingness to take a license. The court did not treat a written statement of willingness alone as conclusive. It considered the defendant's overall conduct during the negotiation period. The court stated that objections to the SEP holder's offer should have been raised at the

⁵ European Commission, *amicus curiae* letters dated April 15, 2024, submitted in *HMD v. VoiceAge*, Munich Court of Appeal, docket nos. 6 U 5066/22 Kart and 6 U 3824/22 Kart, decision issued March 20, 2025, ([Link](#)).

⁶ *Panasonic v. OPPO*, LD Mannheim, UPC_CFI_210/2023, November 22, 2024, para. 206, ([Link](#)).

⁷ *Netgear v. Huawei*, LD Munich, UPC_CFI_9/2023, December 18, 2024, p. 128 f., ([Link](#)).

⁸ *Panasonic v. OPPO*, LD Mannheim, UPC_CFI_210/2023, November 22, 2024, para. 206 f., ([Link](#)).

appropriate time during negotiations and that conduct such as delaying or withholding objections until litigation may be taken into account when evaluating willingness.

In *Netgear v. Huawei*, the LD Munich⁹ also held that a mere written declaration of willingness does not satisfy the requirement. According to the court, willingness must be assessed in light of the implementer's entire negotiation behavior. It found that a written statement must be accompanied by concrete and cooperative actions that demonstrate a genuine intent to conclude a license.

In both cases, the courts did not treat the expression of willingness as a low-threshold requirement. Each court considered whether the defendant had engaged constructively with the licensing process and reacted appropriately to the information and offers provided.

Step 3: Licensing Offer by the SEP Holder

In *Panasonic v. OPPO*, the LD Mannheim¹⁰ reviewed the license offers submitted by the SEP holder. The court acknowledged that large parts of the underlying documents were redacted but noted that the offer must be assessed in the context of the overall negotiation. The LD Mannheim found that SEP holders are not required to provide a fully detailed draft license agreement at the early stages of the negotiation process. It further stated that the level of detail required depends on the negotiation phase and on the information exchanged between the parties.

Any later adjustment of the offered royalty rate does not in itself indicate that the original offer was not FRAND compliant. According to the decision, modifications of the offer may occur for various reasons, including the aim to reach a timely agreement.

In *Netgear v. Huawei*, the LD Munich¹¹ found that the SEP holder is not required to ensure that every offer made during negotiations meets the FRAND standard. Rather, the obligation is fulfilled if at least one of the outstanding offers, whether it be a bilateral license or a pool license, is FRAND. The court emphasized that the initial offer does not need to be FRAND compliant in every detail. Its function is to initiate negotiations and provide a foundation for meaningful discussion. A fully executed draft agreement is not required at this stage. It is sufficient if the offer enables the implementer to understand the essential commercial parameters and to respond with a counterproposal if appropriate.

An abuse of a dominant position may only be established if the SEP holder ultimately refuses to move towards FRAND-compliant terms at the conclusion of genuine negotiations.

Both courts confirmed that the SEP holder's offer is not subject to a detailed review where the implementer has not fulfilled its own obligations under the negotiation framework, in particular regarding disclosure and security.

Step 4: Counteroffer by the Implementer

In *Panasonic v. OPPO*, the LD Mannheim¹² examined the counteroffer submitted by the implementer. OPPO's counteroffer was found to be not FRAND compliant. Among other reasons, the court pointed to the territorial structure of the offer, which proposed a regional split covering the European Union, the United States, and Japan, while deferring other territories to a separate determination by a Chinese court. According to the LD Mannheim, this approach is incompatible with the objective of reaching a comprehensive global license. Additionally, the counteroffer lacked sufficient detail regarding OPPO's use of the asserted patents. OPPO had relied primarily on third-party market data and had not provided adequate information about its actual sales figures in the opinion of the court.

In *Netgear v. Huawei*, the LD Munich¹³ did not conduct a review of the counteroffer submitted by the implementer. Instead, the court rejected the FRAND defense on the grounds that the implementer had not provided adequate security. As a result, neither the SEP holder's offers nor the implementer's counteroffer were subject to substantive review.

In both cases, the courts made clear that an assessment of the counteroffer is contingent on the implementer having fulfilled its preliminary duties, including timely disclosure of relevant information and provision of financial security.

⁹ *Netgear v. Huawei*, LD Munich, UPC_CFL_9/2023, December 18, 2024, p. 131, (Link).

¹⁰ *Panasonic v. OPPO*, LD Mannheim, UPC_CFL_210/2023, November 22, 2024, para. 219, 221 f., (Link).

¹¹ *Netgear v. Huawei*, LD Munich, UPC_CFL_9/2023, December 18, 2024, p. 133 ff., (Link).

¹² *Panasonic v. OPPO*, LD Mannheim, UPC_CFL_210/2023, November 22, 2024, para. 231, (Link).

¹³ *Netgear v. Huawei*, LD Munich, UPC_CFL_9/2023, December 18, 2024, p. 142 f., (Link).

Step 5: Disclosure and Security

The LDs emphasized that implementers must disclose relevant information on their use of the patented technology and provide adequate security for past and ongoing use.

In *Panasonic v. OPPO*, the LD Mannheim¹⁴ found that OPPO had failed to submit sufficient usage data, relying instead on third-party market estimates. The bank guarantee offered was also considered inadequate, particularly due to concerns about enforceability in the event of insolvency. As a result, OPPO had not fulfilled the conditions necessary to support a FRAND defense.

Netgear v. Huawei reached a similar outcome. The LD Munich¹⁵ held that the implementer had neither provided usage data nor offered any form of security. It therefore refrained from reviewing the FRAND compliance of the SEP holder's offer. The court also stressed that security deposits must be accompanied by a binding declaration allowing conversion into licensing fees, and that such security should ideally be provided before litigation begins.

Taken together, the decisions confirm that full disclosure and adequate financial safeguards are essential prerequisites for a FRAND defense to be considered.

2.3 PROCEDURAL CONDUCT AND CONSISTENCY

The UPC not only assessed the parties' negotiation conduct but also took into account procedural behavior, particularly where the implementer's litigation strategy was found to be inconsistent.

In *Panasonic v. OPPO*, the LD Mannheim¹⁶ commented on OPPO's procedural behavior. The court noted that OPPO had initially challenged the jurisdiction of the UPC, but later filed a counterclaim requesting a determination of FRAND licensing terms. This approach was deemed inconsistent.

In *Netgear v. Huawei*, the LD Munich¹⁷ held that parties must maintain procedural consistency under Article 48(6) UPCA and Rule 284 RoP. It is not permissible for

a party to assert mutually exclusive factual positions in the same proceeding. Netgear's simultaneous claim that the patent was not essential and that Huawei held market power was found to be incompatible. The court stated that a finding of market power under FRAND presupposes essentiality and that the implementer must take a consistent position.

2.4 DETERMINATION OF FRAND TERMS: STILL OUTSTANDING

Neither decision resulted in a determination of a FRAND license rate. In *Panasonic v. OPPO*, the LD Mannheim confirmed that such a claim is in principle admissible under the UPC. However, the counterclaim failed due to the implementer's non-FRAND offer. A judicial determination remains possible, but it will likely face high procedural and substantive thresholds.

3. THE BEGINNING OF A NEW FRAND CHAPTER

The UPC's early FRAND case law reveals two developments that are likely to influence its future approach. First, the LDs have adopted a substantive, context-driven approach to the *Huawei v. ZTE* framework. The negotiation steps are acknowledged as a structural guide, but not applied as rigid procedural thresholds. Instead, the courts evaluate the overall conduct of both parties, with a strong emphasis on the implementer's genuine willingness and cooperation throughout the process.

Second, the decisions underscore the procedural and evidentiary burden placed on implementers. Timely disclosure of usage data and the provision of adequate financial security are treated as prerequisites for invoking a FRAND defense. Where these elements are lacking, the UPC has shown no inclination to proceed to a substantive assessment of the SEP holder's offers.

Looking ahead, questions such as the assessment of license terms, the role of comparable licenses, and the allocation of burdens remain open. Upcoming decisions, particularly from LDs outside Germany, will introduce additional perspectives shaped by other national FRAND traditions. These contributions will be essential to the continued development of this dynamic and evolving area of UPC case law.

Further SEP/FRAND disputes that had been initiated before the UPC show that the case law seems to put patent owners at sufficient comfort to employ the UPC as a default venue for their litigation campaigns.

¹⁴ *Panasonic v. OPPO*, LD Mannheim, UPC_CFI_210/2023, November 22, 2024, para. 233 f., ([Link](#)).

¹⁵ *Netgear v. Huawei*, LD Munich, UPC_CFI_9/2023, December 18, 2024, p. 142 f., ([Link](#)).

¹⁶ *Panasonic v. OPPO*, LD Mannheim, UPC_CFI_210/2023, November 22, 2024, para. 235, ([Link](#)).

¹⁷ *Netgear v. Huawei*, LD Munich, UPC_CFI_9/2023, December 18, 2024, p. 139 f., ([Link](#)).

CHAPTER

XIII

RECOVERABLE
COSTS

One issue that has been the subject of much debate among lawyers in the run-up to the opening of the UPC - and which has caused headaches in advising clients wishing to use the new forum - is the issue of cost reimbursements.

The background to this is that the UCPA, the RoP and, in particular, the scale of ceilings for recoverable costs, only provide for a specific figure up to which costs can be reimbursed (in the event of success). However, when

advising clients, it was (and to a certain degree still is) difficult to make reliable statements as to what costs incurred in the course of the proceedings are actually recoverable.

The development of case law has answered some questions, but others remain open. This is likely to remain the case for some time, at least until further decisions of the CoA issue in the near future.

1. LEGAL FRAMEWORK

R. 152.1 RoP briefly states that the applicant (in proceedings for a decision on costs) shall be entitled to recover reasonable and proportionate costs of legal representation. Art. 69 (1) UPCA provides a little more detail, stating that reasonable and proportionate legal costs and other expenses incurred by the successful party shall, in principle, be borne by the unsuccessful party, unless equity requires otherwise, up to a limit to be determined in accordance with the Rules of Procedure.

The scale of ceilings for recoverable costs (referred to in R. 152.2 RoP) defines said ceiling on the basis of the value in dispute. For example: The ceiling for recoverable costs of an infringement action and a counterclaim for revocation with a combined value of the proceedings of EUR 2,500,000 amounts up to EUR 400,000. If the combined value of the proceedings is EUR 1,500,000, the limit for recoverable costs is EUR 200,000.

2. REASONABLE AND PROPORTIONATE

The CoA has not yet provided a clear definition of the terms, but has instead approximated them. In *Stäubli Tec-Systems GmbH*¹, it stated that an exception to the general rule of Art. 69 (1) UPCA that the unsuccessful party must bear the reasonable and proportionate legal costs and other expenses incurred by the successful party may apply if a claimant files a revocation action without the patent holder having given rise to the action and the patent holder surrenders the patent immediately at the beginning of the proceedings.

The LD Düsseldorf, on the other hand, has attempted to define the terms in *Ortovox v. Mammut*² (translated from German):

Taking this into account, reasonable essentially means necessary. In principle, based on the ex ante point of view of a reasonable and economically sensible party, the decisive factor is whether the measure incurring costs appeared objectively necessary and suitable to achieve the legitimate objective of the proceedings. Accordingly, the measure must have appeared appropriate for the purpose of pursuing or defending the legal action.

Proportionality essentially focuses on the amount of the costs. The costs actually caused by the necessary measure must not be disproportionate in terms of the specific amount. In particular, they must not be disproportionate to the value in dispute, the importance of the matter, the degree of difficulty and complexity of the legal and factual points in dispute relevant to the decision, or the prospects of success of the measure incurring the costs. Here too, an ex-ante consideration is appropriate.

Ultimately, however, the terms must be given substance by the judges in each specific case. In practice, there seems to be a tendency for judges to encourage the parties to agree on an amount in advance. If a sum is agreed (within the ceiling for recoverable costs), it is likely the responsible judges will consider it reasonable and proportionate, e.g. *Sanofi v. Amgen*³.

3. LEGAL COSTS

The LD Munich stated in *MSG Maschinenbau GmbH v. EJP Maschinen GmbH*⁴ that the legal costs of the proceedings are those that have been (actually) incurred, including the costs listed in R. 151 (d) RoP. Other recoverable costs are those that have not been incurred in the pending proceedings, but are directly and closely related to the proceedings. UPC case law already provides for an overview of the types of costs that can be considered recoverable.

In *SES-imagotag v. Hanshow*⁵, the LD Munich clarified that the involvement of several attorneys (and patent attorneys) is justified, if the total costs are reasonable and proportionate. Concerning the obligation to provide evidence of attorney's costs, the CD Munich specified in *NanoString v. Harvard*⁶ that the Court and parties must have access to information showing at least a detailed description of the number of hours spent working on the case, by whom, what for and at what rate.

¹ *Stäubli Tec-Systems GmbH, CoA, UPC_CoA 290/2024; APL_31428/2024, March 26, 2025, (Link).*

² *Ortovox v. Mammut, LD Düsseldorf, UPC_CFL_16/2024, April 22, 2025, para. 36 et seq., (Link).*

³ *Sanofi v. Amgen, CD Munich, UPC_CFL_1/2023, July 16, 2024, p. 51, (Link).*

⁴ *MSG Maschinenbau v. EJP Maschinen, LD Munich, UPC_CFL_696/2024, March 19, 2025, para. 19, (Link).*

⁵ *SES-imagotag v. Hanshow, LD Munich, UPC_CFL_292/2023; App_3393/2024, October 11, 2024, p. 7 et seq., (Link).*

⁶ *NanoString v. Harvard, CD Munich, UPC_CFL_252/2023, January 31, 2024, p. 4, (Link).*



In this respect, the submission of an overview containing the above information appears to be sufficient⁷. However, this apparently depends on the individual case, as the submission of the corresponding invoices has also been ordered⁸.

Notably, the LD Düsseldorf in *Ortovox v. Mammut*⁹ sided with the applicant in proceedings for provisional measures on the question whether an infringement analysis prior to the proceedings is recoverable. In the case at hand, the analysis served the preparation of proceedings on the merits, which is why the LD considered it justified to consider the costs incurred recoverable (in the main proceedings).

4. INTEREST

Neither the UPCA nor the RoP provide for interest on costs awarded in proceedings for a cost decision. Accordingly, it was uncertain whether interest could be claimed.

The LD Munich held in *Edwards v Meril*¹⁰ that, contrary to national German case law, no interest should be added to recoverable costs determined in proceedings for a cost decision, as there is no legal basis in R. 151 RoP. The LD explained that R. 125 and R. 131 RoP (granting interest in proceedings for determination of damages) show that the legislator was aware of the issue, but nevertheless decided that no interest should be added to recoverable costs of proceedings.

5. SECURITY FOR LEGAL COSTS

The UPC Divisions exercise wide discretion when ordering security for legal costs (Art. 69 (4) UPCA, R. 158 RoP), taking into account several factors such as the financial situation of the party concerned, the enforceability of possible cost orders and the balance of interests between the parties.

For example, in *Ballinno v. Kinexon/UEFA*¹¹, the CoA ordered the applicant to provide security for legal costs due to concerns that any costs order against the applicant might not be recoverable. In *SodaStream v. Aarke AB*¹², the LD Düsseldorf denied such a request for security of costs as it considered the claimant to be financially capable to comply with any cost decision. In *Plant-e v. Arkyne*¹³, the LD The Hague denied a request mainly because the party concerned was located in an EU country – leaving no room for concerns about the recognition or enforceability of a cost decision.

As a result, case law indicates that the UPC will weigh in particular the financial situation and the location of the parties when deciding on security for legal costs.

⁷ *Ortovox v. Mammut*, LD Düsseldorf, UPC_CFL_16/2024, April 22, 2025, para. 40, ([Link](#)).

⁸ *Teleflex Life Science II LLC v Speed Care Mineral GmbH*, LD Hamburg, UPC_CFL_235/2025, May 12, 2025, not yet published

⁹ *Ortovox v. Mammut*, LD Düsseldorf, UPC_CFL_16/2024, April 22, 2025, para. 43, ([Link](#)).

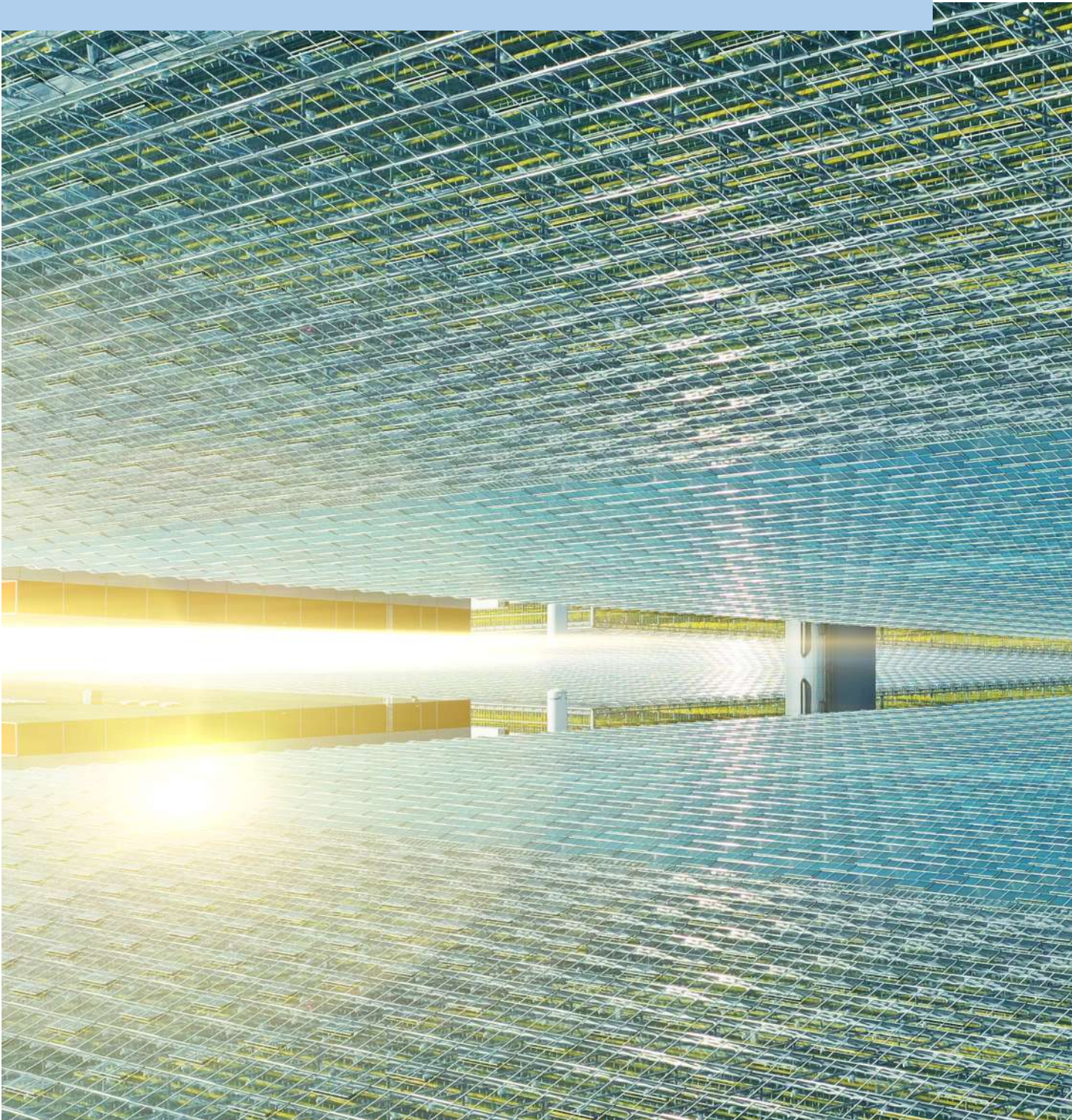
¹⁰ *Edwards v. Meril*, LD Munich, UPC_CFL_249/2023, January 10, 2025, para. 3 et seq., ([Link](#)).

¹¹ *Ballinno v. Kinexon/UEFA*, CoA, UPC_CoA_328/2024, August 26, 2024, ([Link](#)).

¹² *SodaStream Industries v. Aarke AB*, LD Düsseldorf, UPC_CFL_373/2023, September 6, 2024, para. 26 et seq., ([Link](#)).

¹³ *Arkyne Technologies v. Plant-e Knowledge*, LD The Hague, UPC_CFL_239/2023, February 13, 2024, ([Link](#)).

CHAPTER XIV APPEAL



1. FILING AN APPEAL

Particularly for lawyers familiar with the German legal system, it may have been surprising that the RoP already require the statement of appeal, which must be filed within two months upon service of the decision, to contain the remedies sought, see R. 225 (e) RoP.

The grounds of appeal must be filed within two months after the statement of appeal and must specify the contested parts of the decision, the reasons for setting aside the decision and the facts and evidence on which the appeal is based (R. 226 RoP).

A practical problem encountered by several parties when filing appeal briefs in the Case Management System (CMS) was getting access to the correct CMS template. The reason was that, in some instances, the decision to be appealed was not properly uploaded by the courts in all relevant workflows, and that for purely technical reasons the CMS would not allow an appeal to be filed. We trust this problem is largely solved by now. Hopefully, the new CMS will avoid such problems.

2. SCOPE OF REVIEW OF THE COURT OF APPEAL

The subject matter of the appeal proceedings is determined in accordance with R.222 RoP. Pursuant to R. 222.1 RoP, requests, facts, evidence and arguments submitted by the parties under R. 221, 225, 226, 236 and 238 RoP shall constitute the subject matter of the proceedings before the Court of Appeal. The Court of Appeal shall consult the file of the proceedings before the Court of First Instance.

Art. 73 (4) UPCA additionally stipulates that new facts and new evidence may only be introduced in accordance with the RoP and where the submission thereof by the party concerned could not reasonably have been expected during proceedings before the Court of First Instance.

In *Mammut v. Ortovox*¹, the CoA clarified on the basis of R. 222.1 RoP that the subject matter of the proceedings is limited to the submissions in the specific case. The subject matter of the appeal proceedings for the review of provisional measures is therefore in principle limited to the submissions made in the proceedings for the grant of provisional measures and does not include submissions made in parallel proceedings on the merits.

Consequently, it seems advisable not only to refer to the statements made in parallel proceedings in the appeal proceedings, but to actively present the argument/evidence in its entirety.

R. 222.2 RoP ("*Requests, facts and evidence [...] may be disregarded*") gives the CoA wide discretion on the question whether to admit or disregard new subject matter.

Once again in *Mammut v. Ortovox*², the CoA – although the Court of First Instance considered a prior art document to be late-filed – exercised its discretion in favor of the party relying on the document to admit it into the proceedings. In particular, the CoA took into account that the proceedings would not be delayed by admitting the prior art document and that the opposing party had sufficient opportunity to comment on it.

In *SharkNinja v. Dyson*³, the CoA exercised its discretion to the detriment of the party seeking to introduce new evidence. Referring to R. 222 RoP, the CoA found that it was not sufficiently clear why the new evidence (allegedly inconsistent statements made by the opposing party in parallel US proceedings) was of relevance to the appeal. Accordingly, the CoA did not see convincing reasons to justify the admission of new evidence in the proceedings.

In summary, the case law to date suggests that the admissibility of new facts or evidence on appeal is ultimately a matter of discretion, depending largely on the specific circumstances of each case.

¹ *Mammut v. Ortovox*, CoA, UPC_CoA_182/2024, September 25, 2024, para. 73 et seq., ([Link](#)).

² *Mammut v. Ortovox*, CoA, UPC_CoA_182/2024, September 25, 2024, para. 111 et seq., ([Link](#)).

³ *SharkNinja v. Dyson*, CoA, UPC_CoA_297/2024, October 21, 2024, para. 3 et seq., ([Link](#)).

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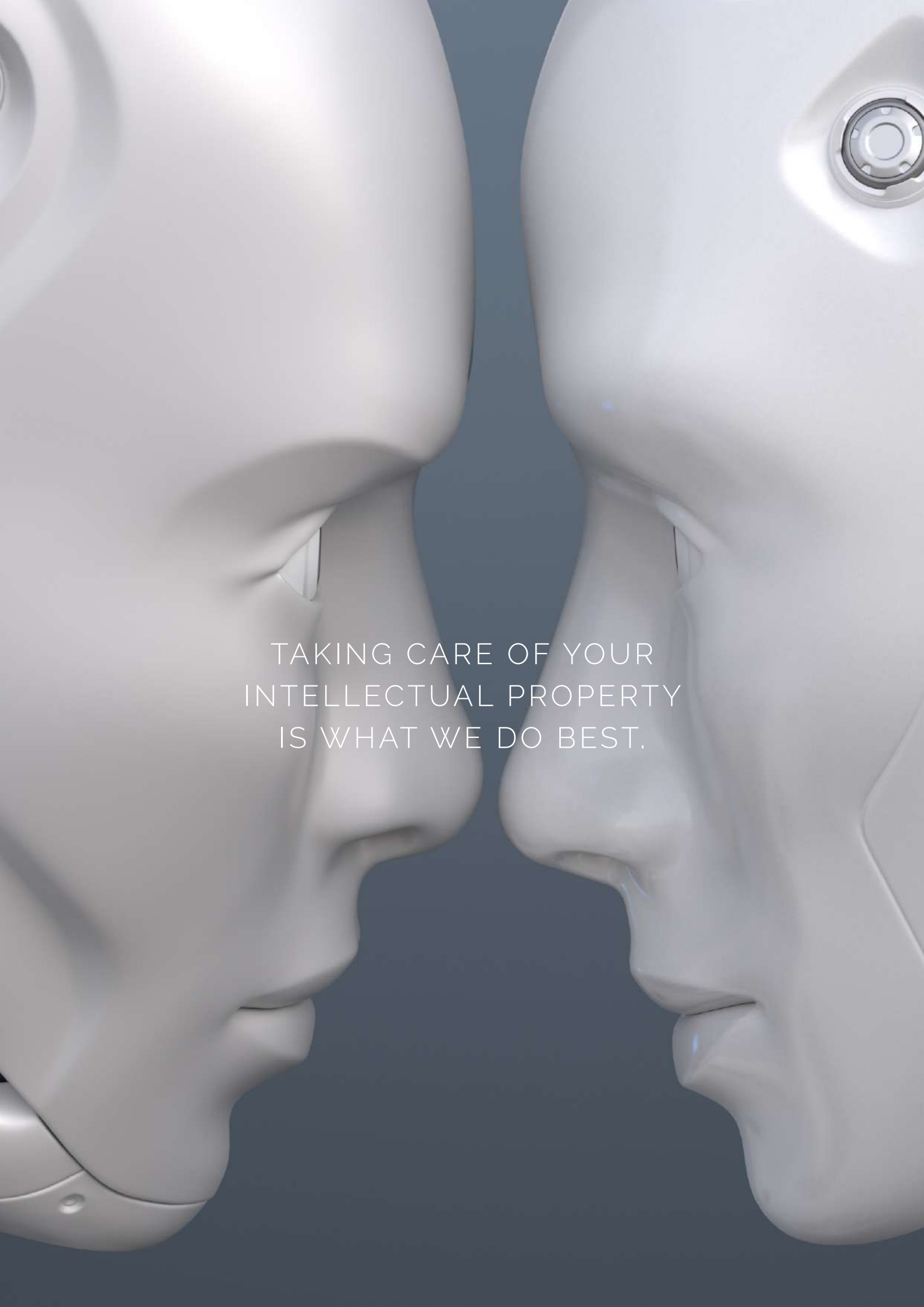
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The image features two white, stylized robotic faces positioned symmetrically on either side of the frame, facing each other. The faces have a smooth, matte finish and are set against a dark, solid background. The central text is overlaid on the space between the two faces. The text is in a clean, white, sans-serif font, arranged in four lines. The overall composition is balanced and minimalist, emphasizing the theme of artificial intelligence and intellectual property.

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