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ARTICLE

Amendments in UPC proceedings: current developments and practical guidelines

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Recent decisions from various UPC divisions provide valuable guidance for parties seeking to amend their cases or patents. The decisions emphasize that it is crucial for parties to know how to distinguish between the rules for amending patents and patent actions, as each has its own requirements and scope. This will enable them to file proper applications and to make strategic decisions to defend their patent rights as effectively as possible.

Legal framework

Amendments to the case: Under R. 263.1 of the Rules of Procedure (RoP), a party may, at any point during the proceedings, request the Court's permission to alter its claim or amend its case, which may include the addition of a counterclaim. The rule is primarily concerned with ensuring that late or unclear amendments to a case do not unduly hinder the other party in its defense.

Patent amendments: Under R. 30.1 RoP, the patent proprietor may defend their patent in an amended version against a counterclaim for revocation. In addition to Art. 76 UPCA, R. 30 RoP specifies what requirements a patent holder needs to meet in order to file a clear and comprehensive application to amend the patent.

Recent amendment cases

In *JingAo/Astroenergy* (March 31,2025, <u>UPC_CFI_425/2024</u>), the Munich Local Division, in accordance with R. 30 RoP and R. 263 RoP, granted all of the claimants' requested changes, including patent amendments in light of an EPO opposition decision, and the addition of new versions of allegedly infringing products discovered after the initial filing.

In *Supponor/AIM Sport* (April 11, 2025, <u>UPC_CoA_169/2025</u>), the Court of Appeal (CoA) allowed the addition of a new defendant, territorial extension, and amendments to the infringement action on the basis of R. 263 RoP.

In *Fujifilm/Kodak* (April 2, 2025, <u>UPC_CFI_359/2023</u> and <u>UPC_CFI_365/2023</u>), the Mannheim Local Division, taking into account both provisions, permitted clarifying amendments to the claims but refused implicit patent amendments, emphasizing the need for a proper, formal application.

Practical guidelines from these cases

Based on these decisions, the practical guidelines can be summarized as follows.

CLAIM AMENDMENTS (R. 263 ROP)	CLAIM AMEND ROP)
 "Any change to the subjectmatter of the claims" → changes in the wording of a claim, relying on a combination of claims as new independent claim, etc. No need for changes to be limited to addressing directly the grounds for invalidity asserted in the counterclaim. Introduction of claim versions amended by the EPO to help synchronize its proceedings with those before the UPC. 	 Amendments of the origination of specificity and to the content of the when the nature or service dispute changes (eg territorial scope and introduction of counter are included in auxiliar requests under Rule patentee must also be amend the infringement accordingly in order a synchronization of probefore both the UPC Amendments to the infringement action, in the patent, requested to the statement of d the counterclaim for should be regarded, case of doubt, as an irequest pursuant to I RoP and should be a accordingly. Amendments in resp concerns raised by the lack of specificity amendment respond would concern the statement of a statement of a statement respond would concern the statement of a statement of a specificity amendment respond would concern the statement of a statement of a statement respond would concern the statement of a specificity amendment respond would concern the statement of a statement of a statement respond would concern the statement respond would concern the statement respond would concern the statement for statement respond would concern the statement for statement respond would concern the statement for should be regarded.
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DETAILS	CLAIM AMENDMENTS (R. 263 ROP)	CLAIM AMENDMENTS ROP)
What isn't covered?	 Informal or implied amendments, such as mere elaboration on the patentability of subclaims. 	 Amendments refining wording or procedure clarifications without the substantive scop The addition of infring equivalence, because are still based on the and the same patent. Unconditional ameno patent's claim do not separate application
Formalities	 Clear and comprehensive (detailed) application, reasonable number of proposed amendments. Where appropriate, submit alternative sets of claims in the language in which the patent was granted (with translation, if necessary). Specify the order of priority / ranking when submitting alternative / conditional amendment proposals. Explain how the amendments comply with the requirements of Articles 84 and 123(2) and (3) EPC and why the amended 	 amend under R. 263 Explain why the char included in the origin Convince the Court t change could not hay made any earlier in th proceedings and will reasonably hinder the party. The details can be pr an appendix. The frontloaded natu proceedings must be

Key takeaways

- Applying the correct rule is essential for the admissibility and effectiveness of any amendment in UPC patent litigation. Therefore, it is important to know the differences between R. 30 and R. 263 RoP.
- 263 RoP covers the lack of specificity and the amendment responding to it concerning the substance of the request, not the wording.
- When it comes to amending the patent itself, R. 30 is *lex specialis* to R. 263 RoP.
- Patent amendments need not be linked to the invalidity grounds in the counterclaim for revocation.
- It is possible to introduce an amendment based on a decision of the EPO division, since the RoP aim to synchronize UPC proceedings with EPO proceedings.

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