The UPC – Two years on

July 2025

With the UPC turning two years old, we look at the practices and themes that are becoming established in this new patent court system and particular developments in the 6 months since our last briefing (linked here The UPC at 18 months).

The CJEU's decision in *BSH Hausgerate v Electrolux* (Case C-399/22) (***BSH***) made headline news in the patent world in February this year and has provided the backdrop for some interesting changes in dynamics between national patent courts and the UPC over recent months. In this briefing, we look at how the UPC has taken this decision on board and its longer-term implications for the big picture in European patent litigation, before going on the consider a selection of other developments from the UPC, including:

- Jurisdiction over pre-UPC infringements and damages and the applicable law
- Jurisdiction and opt-out (and its withdrawal)
- Claim interpretation and the UPC's doctrine of equivalence
- Front-loaded procedure and late pleadings/claims
- Criteria for PIs
- Determining imminent infringement
- Novelty – the "legal standard"
- Inventive step/Obviousness
- Added matter
- Stays and suspensive effect
- Security
- Access to pleadings
- Second medical use patents
- SEPs and FRAND at the UPC (and anti-suit injunctions)

Lastly, we touch on the potential use of UPC proceedings to promote settlement of disputes, in particular in the tech and life sciences sectors, both those already in play in multiple jurisdictions worldwide and those initiated solely in within this new patent dispute resolution system.

To start with, we examine the UPC's caseload and the continuing uptake of unitary patents.

Decisions on the merits and preliminary injunctions

Although each case turns on its own facts, it is interesting to review the UPC's decisions to see whether any trends are emerging:

- Since 1 June 2023, there have been over 50 decisions on the merits with 18 patents being revoked (and two found valid/revoked in part) and 27 held infringed (including two found infringed by default). Overall, where validity has been contested, patents have been upheld in approximately 60% of cases (this includes those held valid as amended during the proceedings).
- The balance, granted to refused, of the 30+ preliminary injunction applications so far at the UPC, is sitting at around 50/50, even allowing for the few that have been reversed on appeal.

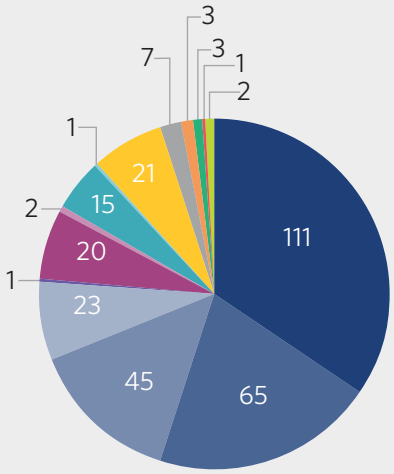
UPC filings

The UPC case filings statistics show a strong upward trajectory through the first two years of operation, demonstrating the continuing demand for the new court.

Cumulative UPC filings from commencement (1 June 2023)	6 months	12 months	18 months	2 years
Total UPC cases	160	373 (+213, +133%)	635 (+262, +123%)	883 (+248, +95%)
Infringement actions	67	134 (+67, +100%)	239 (+105, +157%)	320 (+81, +77%)
Revocation actions	24	35 (+11, +45%)	55 (+20, +181%)	65 (+10, +50%)

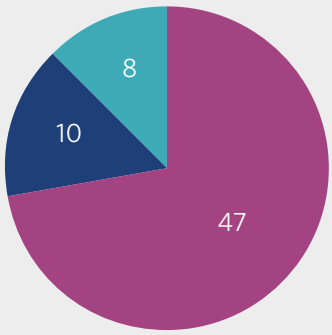
Table shows, in brackets, first the additional cases in that 6 month period and then the increase in filings as compared to filings in the previous 6 month period (sourced from statistics published on the News page of UPC website).

Infringement actions (total 320 since start of UPC)



- Munich LD
- Dusseldorf LD
- Mannheim LD
- Hamburg LD
- Lisbon LD
- Paris LD
- Paris CD
- Milan LD
- Milan CD
- Hague LD
- Nordic-Baltic RD
- Brussels LD
- Copenhagen LD
- Helsinki LD
- Vienna LD

Standalone revocation actions (total 65 since start of UPC)



- Paris CD
- Munich CD
- Milan CD

Languages

English is now firmly established as the language of the majority of proceedings. The statistics released by the UPC at the end of the first two years of its operation showed that (cumulatively) 55% of cases had proceeded or were proceeding in English (including those that have started in another language and changed to English) and 38% in German (French 2%, Italian 2%, Danish 1% and Dutch 1%).

Speed

The speed with which the court is dealing with proceedings does seem to have slowed slightly from the initial pace, with fewer cases reaching hearings within the ambitious 12 month window set out in the UPC Agreement. This was only to be expected now that the forum has become established as a reliable one for patent disputes resolution and has consequently become more popular with stakeholders, leading to more cases being filed and needing to be dealt with at the same time with a limited resource of courts. However, the UPC's continuing focus on deciding cases quickly is evident in its approach to case management, its appointment of new judges and creation of new judging panels in the busiest divisions.

Unitary patent uptake

Although the number of cases involving unitary patents (**UP**) at the UPC has been relatively low due to the youth of such patents, the enthusiasm for the UPC itself seems to be reflected in the statistics on requests for unitary effect (unitary patent status-UPs only – being enforceable in the UPC and not in national patent courts). By July 2025 the cumulative total of EPs registered with unitary effect, i.e. as UPs, since UPs became available on 1 June 2023, was over one third of the total EPs granted in that period. If you look at UPs registered to EU-based proprietors, this rises to almost two-fifths of those EPs granted.

At the time of going to press in July 2025, after two years of the UPC, there has been an overall uptake of UP status in newly granted patents of 22.8% (corresponding statistics for proprietors based in EPO states and EU states are 32.6% and 33.2%, respectively) with the statistics in 2025 so far being 27.8% overall (and 38.6% and 39.0% respectively).

Jurisdiction and the impact of *BSH v Electrolux* on the UPC and the role of "anchor defendants" and defendants in a commercial relationship

Even before the outcome of *BSH*, the UPC was considering these issues and, although several cases were stayed, in *Fujifilm v Kodak* (Dusseldorf LD, 28 January 2025) the Dusseldorf LD decided it did not need to stay proceedings to await the *BSH* decision and held that if a defendant was domiciled in a contracting member state (eg Germany in this case), the UPC has jurisdiction to hear the infringement action in respect of a non-contracting state (here the UK). However the court held there was no infringement and so it did not consider the UK aspect (due to the finding of non-infringement and because the revocation counterclaim did not cover the UK).

The UPC was heralded during its development as a one-stop-shop for multi-jurisdictional patent disputes. The innovation was to solve the problem of having to enforce an EP nationally in multiple separate national proceedings across the EPO territories. Although, with Romania now an additional ratifier of the UPC Agreement (**UPCA**) there are now 18 EU member states participating in the UPC and the unitary patent, there are several other jurisdictions in which patentees are likely to wish to enforce their patents both in the EU and the broader EPC territories (in particular other EU member states which are not currently members of the UPC: Croatia, Cyprus, Czech Republic, Greece, Hungary, Ireland, Poland, Slovakia and Spain, and in other EPC states such as Norway, Switzerland and the UK) which do not fall under the direct jurisdiction of the UPC. However, the so-called "long-arm" jurisdiction of the UPC – the ability to hear cases relating to non-UPC European patents – has received more judicial attention in the last year. In particular following the CJEU's decision in *BSH v Electrolux* on 25 February 2025, the spotlight has been on the UPC to demonstrate the enhanced benefits of UPC proceedings now that the CJEU had enlarged the remit of individual national patent courts with respect to their international reach.

The Paris LD was first UPC court post-*BSH* to tackle the issue, in *Mul-T-Lock v IMC Creations* (CFI 702/2024, on 21 March 2025). Here there were Spanish and Swiss patents involved and a French defendant (amongst others). The Paris LD confirmed the meaning of *BSH* as follows (emphasis added):

- Where validity defences are raised in an infringement action involving EP designations from other states
  - in relation to EU state patent designations (and Lugano Convention state patent designations), these can only be dealt with by the courts of the state in which the patent is registered – but this does not remove jurisdiction from the court in which the infringement action is brought to deal with the infringements of these patents.
    - NB If there is a "reasonable and significant chance that the patent will be invalidated by the court of the Member State in which the patent was granted", *the court where the infringement action is being brought may stay the infringement proceedings pending the outcome of the national determination(s) of the patent*
  - in relation to third state patents, arguments on the validity of these can be considered by the court of the state in which the infringement actions are being brought *but the impact of any findings on validity will only be inter partes*

(See **our post** on the HSFKramer IP blog **www.hsfkramer.com/notes/ip** for more on the CJEU's *BSH* decision).

The Paris LD concluded in *Mul-T-Lock* that the UPC had jurisdiction to hear the infringement action as regards the Spanish patent, if necessary, by suspending the proceedings, pending the decision of the national court hearing the invalidity action, if there was a reasonable and non-negligible risk that the patent would be invalidated by the court of the State granting the patent; and to hear the action for infringement of the UK part of the patent, and to rule on the validity of the title, if necessary, provided that the decision on the objection of invalidity of the patent has only inter partes effect. The Paris LD also claimed jurisdiction over the Swiss defendant's infringement of the Swiss designation of the EP involved.

The Paris LD confirmed its support of the CJEU decision by quoting from it, stating that "*The patent proprietor must be able to concentrate all his infringement claims, in the event of infringement disputes in several Member States of the European Union, and obtain global compensation before a single forum and avoid the risk of divergent decisions*".

There has therefore yet to be a determination relating to UK EPs although the UPC has patently not denied its jurisdiction in this respect. In April 2025, the Mannheim LD gave its decision in two cases, which had been stayed pending the outcome of the *BSH* CJEU judgment. The UK EP was made the subject of separate proceedings (to allow for validity assessment) and the court refused to grant a preliminary injunction (**PI**) in relation to the UK in the interim: *"As far as Claimant requests that the Court grant a provisional injunction for the UK in the event the Court should find any reason to stay the proceedings as they relate to infringing acts carried out in the UK, or not to grant a permanent injunction for the UK until further conditions are fulfilled, the proceedings have been separated and will be dealt with in subsequent proceedings after having discussed the consequences of the ECJ's decision without there being a basis for granting such interim relief in the meantime"*.

Later in April and May: in *Alpinestars v Dainese* (CFI 792/2024, 8 April 2025) the Milan LD held that as the court of domicile of the defendant it had jurisdiction over that defendant's infringement in Spain; and in *Hurom*

(Paris LD, CFI 163/2024 23 May 2025) where the defendant was domiciled in France, the court applied *BSH* and held it had jurisdiction over infringement of a Polish EP (however, Hurom (the claimant) did not meet the burden of proof for the alleged infringement in Poland (relying only on availability of the relevant websites throughout Europe and an allegation that the first defendant's turnover covered all of Europe) and so the claim was dismissed).

Subsequently, in *Genevant & Arbutus v Moderna* (CFI 191/2025 &192/2025, 23 May 2025), The Hague LD held it had jurisdiction over all 15 defendants domiciled in multiple different UPC, EU (non-UPC) and other EPC (non-EU, non-UPC) countries, on the basis of related infringement with an "anchor defendant" in the Netherlands. This was due to that defendant's central role in the sale and supply across Europe of the allegedly infringing items, and threatened infringement in collaboration with Norwegian, Spanish and Polish entities.

> Under Art 8(1) Brussels Regulation: *A defendant domiciled in an EU MS may also be sued, when it is one of a number of defendants, in the courts for the place where one of them is domiciled, provided the claims are so closely connected that it is expedient to hear and determine them together to avoid the risk of irreconcilable judgements (Lugano Convention has an equivalent provision).*

Genevant claimed that Moderna NE was such an anchor defendant for all Moderna defendants in Poland, Spain and Norway. The Hague LD held that the claimants had sufficiently substantiated alleged infringement in those defendants' home countries jointly with Moderna NE (and hence there was jurisdiction under Art 8(1) BR for Spain and Poland and equivalent provisions in Lugano Convention re Norway): Moderna ES was the MA holder; Moderna PL's website supported the infringement of the other defendants; and, although there was no information on Moderna NO, the court found infringement could not be ruled out so there was at least a threat of infringement in Norway. This was enough to establish jurisdiction of the UPC.

Moderna was quickly followed by another new case discussing jurisdiction and the use of anchor defendants – *Headwater Research LLC v. Motorola Mobility LLC* and others CFI 149/2024 (Munich LD 20 June 2025). Here there was a German anchor defendant (with US and Dutch defendants).

Here the Munich LD upheld its jurisdiction over the German defendant and two US defendants to claim jurisdiction over a group of defendants who all acted in a close and interdependent commercial relationship (referencing Art 33(1)(b) UPCA and its interpretation in *Novartis v Celltrion* (CFI 166/2023 and CFI 165/2023 Dusseldorf LD, 6 September 2024) where jurisdiction was derived over parties as part of a chain from Korean defendant to EU and UPC-state based defendants whose actions could all be attributed to each other). Under Art 33(1)(b) UPCA, the local division hosted by the Contracting Member State where the defendant or, in the case of multiple defendants, one of the defendants has its residence, or principal place of business, or in the absence of residence or principal place of business, its place of business, or the regional division in which that Contracting Member State participates, has jurisdiction. However, an action may be brought against multiple defendants only where the defendants have a commercial relationship and where the action relates to the same alleged infringement.

The Munich LD in Headwater held that *"The requirement of a business relationship implies a certain quality and intensity. However, in order to avoid multiple actions for the same infringement and the risk of irreconcilable decisions resulting from such separate proceedings, and to comply with the principle of efficiency within the UPC, the connection between the defendants in the sense of a business relationship must not be understood too narrowly. In this respect, it is sufficient for the defendants to belong to the same group of groups or the same group of legal entities and to carry out interrelated commercial activities with the same purpose as research and development, manufacture, sale and distribution of the same products."*

This "commercial relationship" provision, along with the scope that BSH provides for it also, as a common court, to include infringements of foreign patents within its remit in relation to specific domiciled defendants, creates a strong position for the UPC as a forum of choice in the right circumstances, even where BSH has given national patent courts a boost with its extended jurisdiction.

This decision continues a trend that has been evident for some time, that the UPC will take jurisdiction and be pragmatic on case management wherever possible to enhance its position as an accommodating forum for European patent litigation.

STOP PRESS - THE UPC FLEXES ITS "LONG ARM" MUSCLES

As mentioned above, the Mannheim LD decided to move the UK EP aspects of the dispute between Fujifilm and Kodak (CFI 365/2023 and CFI 359/2023) into separate proceedings to deal with the differential treatment of UK patents as non-EU EPs following *BSH*. The court published its decision in relation to CFI 365/2023 dispute on 18 July 2025, immediately before this briefing went to press, awarding Fujifilm an injunction covering the UK and requiring Kodak to provide information sufficient for an assessment of damages in that jurisdiction. It remains to be seen how the award of such an injunction plays out in practice.

In a separate decision on the same day, the court rejected Fujifilm's complaint in CFI 359/2023, in relation to a separate UK EP, finding that that UK part of the EP bundle lacked patentability (attempts to introduce amendments via auxiliary requests failed). As per the CJEU's decision in *BSH*, this finding of invalidity has *inter partes* effect only.

The Mannheim LD confirmed, in both decisions, that (i) the UPC has jurisdiction to decide upon the infringement of the UK part of a European Patent (**EP**); (ii) the defendant in an infringement action before the UPC which relates to the UK part of a European bundle patent is allowed to raise an invalidity defence without being obliged to file a national action for revocation in the UK; (iii) the UPC will then assess validity as a mere prerequisite for infringement (the outcome having inter partes effect only). However, the court held that in the absence of pending national revocation proceedings in the UK, there is neither a reason to stay the infringement proceedings before the UPC, nor to make the decision conditional upon the validity of the UK part of the EP. Further, there is no legitimate interest of a defendant obtaining a declaration that the UK part of an European bundle page is invalid, since such declarator relief is not binding on national authorities (only *inter partes* as per *BSH*).

In the following sections we analyse how specific procedural and legal areas are developing at the UPC with particular emphasis on those of the last 6 months since our briefing The UPC at 18 months.

1. Jurisdiction over pre-UPC infringements and damages and applicable law

The Court of Appeal of the UPC confirmed its jurisdiction over any EP that is not opted out currently and which had not lapsed at the commencement of the UPC on 1 June 2023 (*Fives v REEL* CoA 30/2024, 16 January 2025).

This includes jurisdiction:

- over acts of infringement occurring prior to the UPC start date (*Edwards v Meril* CFI 15/2023, 15 November 2024)
- damages in relation to acts of infringement prior to that 1 June 2023 start date (*XSYS v Esko-Graphics* CoA 156/2025, 2 June 2025)
- to determine damages even where the determination of infringement was made by a national court before the UPC started (*Fives v REEL*)

As a corollary, the Mannheim LD confirmed that it did not have jurisdiction over any parts of a bundle of EPs that had lapsed at 1 June 2023 (*Fujifilm v Kodak* CFI 159/2024)

The UPC has also had to consider what law to apply to acts of infringement committed prior to the UPC coming into action, ie before 1 June 2023. In the *Hurom* decisions (CFI 159/2024 and CFI 162/2024) of 11 March 2025, the Mannheim LD stated clearly that:

"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 following applies:

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.*

... Before this backdrop it is justified to apply the UPCA as a harmonized set of national law of the contracting member states of the UPCA to ongoing acts, if the infringer continues its infringing behaviour although he could have stopped the infringement in the light of the entry into force of the new regime on 1 June 2023. In that case, however, each party reserves the right to rely on provisions of the national laws for acts before 1 June 2023 being favourable to its position compared to the provisions of the UPCA and the RoP. The party which advances the argument based on national law has to elaborate on such rules of national law and set out with a sufficient degree of substantiation why that rule of national law supports its argument."

This would seem to contradict the Paris LD which had earlier held, on 13 November 2024 in *HP v Lama* (CFI 358/2023), that there was no application of national law in relation to pre-UPC infringements, holding that "*when assessing acts of infringement occurring before 1 June 2023, it is not relevant to refer to sources of national law; the sources of substantive law applicable before the UPC that define what constitutes an act of infringement are Articles 25 and 26 UPCA*". The Paris LD found that the UPC's jurisdiction to deal with matters arising prior to 1 June 2023 was clear and the Court refused a request to refer the issue to the CJEU. However, it did not make clear whether the infringements it was considering spanned the pre and post UPC era.

The Mannheim LD has already applied its reasoning in *Hurom* in subsequent decisions such as *Fujifilm v Kodak* (CFI 365/2023) on 2 April 2025, where it applied UPCA law to "ongoing" infringements and gave some guidance on how to interpret what one was, but also some leeway to prevent any "hardship" that the application of UPCA law might create:

" ... *What is decisive is that from an evaluative perspective the alleged infringer could have stopped its ongoing production in the light of the entry into force of the UPCA but still made the decision to continue.*"

"*However, in order to avoid potential hardship, the party concerned may rely on the provisions of the respective substantive national law in force prior to the entry into force of the UPCA with regard to acts of past use which lie before 1 June 2023*"

Here the court held that "*the substantive law to be applied on the instant facts of the case is the UPCA as the attacked embodiments had been marketed at least also after 1 June 2023*".

National law has been applied where the UPCA dictates that it should be, such as the law on prior user (UPCA Art 28), and it was applied again by the Mannheim LD in *Fujifilm v Kodak* (CFI 365/2023, 2 April 2025) and earlier by the Dusseldorf LD in *Kaldewei v Bette* (CFI 7/2023, 3 July 2024).

It had long been anticipated that national law (and indeed national procedural conventions) might also be applied where there was no specific provision in the UPCA (or RoP) for a certain issue. One highlighted area was the doctrine of equivalence. As discussed further below, this has been proved to be true to a certain extent. Another example is where the Munich LD has applied German law principles to issues of claim construction (see below).

2. Jurisdiction and opt-out (and its withdrawal)

The UPC has held that once an opt-out has been withdrawn, it has jurisdiction over the period when a patent had previously been opted out: "*In case of an effective withdrawal from an effective opt-out, the UPC is competent to decide on alleged acts of infringement which have occurred during the time period between the date of the opt-out and that of the withdrawal*" *(XSYS v Esko-Graphics* CoA 156/2025, 2 June 2025).

The Munich LD had previously held the same stating that the jurisdiction of the UPC "*includes infringement actions insofar as they are based on acts of use that are said to have taken place before the entry into force of the UPCA and/or in the period between an opt-out and the withdrawal therefrom*" in *Phoenix v Industria Lombarda* (CFI 342/2024, 10 February 2025). However it warned that jurisdiction and applicable law are distinct aspects that must be assessed separately.

3. Claim interpretation & the UPC's doctrine of equivalence

As we set out in our briefing The UPC at 18 months, the criteria for claim interpretation (both for validity and infringement) were set out by the CoA in February 2024, in the appeal from the award of a PI to 10x Genomics in the first ever case in which a UPC court granted a PI: *10x Genomics v NanoString* (CFI 2/2023). In revoking the PI that the CFI had awarded (on the basis of the likely invalidity of the patent), the CoA (CoA 335/2023, 26 February 2024) set out the criteria to be applied when interpreting patent claims. This was adopted and re-phrased by the CoA in *VusionGroup v Hanshow* (CoA 1/2024 13 May 2024) and has now become a standard reference point for courts assessing patent claims in both the context of infringement and validity. See for example its application by the Paris CD in its revocation decision in December 2024 *Advanced Bionics v MED-EL* (CFI 338/2023 & 410/2023, 26 December 2024) (where the patent survived) and in one of the most recent decisions on the merits covered in this briefing, another revocation before the Paris CD, *NJOY v Juul Labs* (CFI 316/2023 17 January 2025) where the patent was revoked. In both decisions, the Paris CD quoted from the combined *10x* and *VusionGroup* CoA decisions (the below from *NJOY* (formatting adapted)) stating that:

- in accordance with Art. 69 EPC and the Protocol on its interpretation, a patent claim is not only the starting point, but the decisive basis for determining the scope of protection of a European patent;
- 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;
- however, this does not mean that the patent claim merely serves as a guideline and 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. When interpreting a patent claim, the person skilled in the art does not apply a philological understanding, but determines the technical meaning of the terms used with the aid of the description and the drawings;
- a feature in a patent claim is always to be interpreted in light of the claim as a whole (CoA UPC 13 May 2024, VusionGroup/ Hanshow). From the function of the individual features in the context of the patent claim as a whole, it must be deduced which technical function these features actually have both individually and as a whole;
- the description and the drawings may show that the patent specification defines terms independently and, in this respect, may represent a patent´s own lexicon. Even if terms used in the patent deviate from general usage, it may therefore be that ultimately the meaning of the terms resulting from the patent specification is authoritative;
- in applying these principles, the aim is to combine adequate protection for the patent proprietor with sufficient legal certainty for third parties;
- the relevant point in time for interpreting a patent claim for the assessment of validity is the filing (or priority) date of the application that led to the patent; and
- the patent claim must be interpreted from the point of view of a person skilled in the art. (see below for a discussion of the CoA's interpretation of this person).

Claim scope was considered in *SodaStream Industries Ltd. v Aarke AB* (CFI 373/2023, 31 October 2024) where the Düsseldorf LD granted an injunction rejecting what appeared to be a *Gillette/Formstein* defence (that if what the defendant is doing is covered by the prior art, it cannot be an infringement – either because if falls outside the scope of the claims or the patent is invalid if the patentee alleges it is within the scope of the claims). The LD held that:

- the claim must not be limited to the scope of preferred embodiments. The scope of a claim extends to subject-matter that the skilled person understands as the patentee's claim after interpretation using the description and drawings. A claim interpretation which is supported by the description and drawings as a whole is generally not limited by a drawing showing only a specific shape of a component;
- pursuant to Art. 69(1) S. 1 EPC, the extent of the protection conferred by a European Patent shall be determined by the claims. It is therefore the claim that defines the outer limit of the scope of protection;
- nevertheless, the description and the drawings shall be used to interpret the claims. Prior art is not mentioned there;
- the limitation to the description and the drawings as interpretation material serves the purpose of legal certainty, since the scope of protection can be conclusively determined from the patent itself;
- this does not mean that prior art is irrelevant to the definition of the scope of the patent and thus to claim construction;
- if this prior art is discussed in the description of the patent in suit, the relevant considerations must be taken into account. If the patent distinguishes itself from the prior art in a particular way, an interpretation that negates that distinction must be avoided.

However, the following month, in *Plant-e v Arkyne* (CFI 239/2023, 22 November 2024), The Hague LD held that the *Gillette* defence could play a part in an assessment of infringement under the doctrine of equivalence, although it did not play a major role in the proceedings and was referred to in the context of determining the doctrine of equivalence in relation to a question it applied as part of a doctrine of equivalence test: "*Is the allegedly infringing product novel and inventive other prior art (ie no successful Gilette/ Formstein defence*)"..

In *Edwards v Meril* CFI 501/2023 4 April 2025, the Munich LD laid down what it called "the legal standard" on construction of claims, stating that a narrowing construction of a broader claim language on the basis of the description or drawings should only be allowed in exceptional cases. The decision references the *Fujifilm v Kodak* (CFI 355/2023, 28 January 2025) decision of the Dusseldorf LD, in which that court held that:

- *The terms used in a claim should normally be given their broadest technically sensible meaning in the context of the claim in which they appear. Art. 69 EPC and its Protocol do not provide a justification for excluding what is literally covered by the terms of the claims by a narrowing claim construction based on the description or the drawings. A narrowing interpretation of the claims which deviates from the broader general understanding of the terms used therein by a skilled person can only be permitted if there are convincing reasons based on the circumstances of the individual case in question.*

In *Edwards v Meril* the Munich LD held that German law applied re construction:

- Edwards pointed out that it is settled case law in Germany that exemplary embodiments are generally not intended to limit or broaden the scope of an independent claim.
- A limitation is only possible in exceptional cases, eg if the technical teaching of the

patent is only possible if the teaching of the narrower exemplary embodiment is applied.

- Insofar as Meril relies on the case law of the German Federal Court of Justice according to which a patent is to be regarded as "its own dictionary", the court held that such case law only applies if the claim uses a term which differs from its usual understanding in the CGK. This was not the case here, as the term "body portion" used corresponded to the terminology used by the person skilled in the art.

This approach is consistent with the subsequent decision of the Enlarged Board of appeal of the EPO in Case G1/24 (published 18 June 2025) that the claims are the starting point and the basis for assessing the patentability of an invention, and that the description and drawings must always be consulted to interpret the claims for this assessment.

The UPC has considered the application of the doctrine of equivalence (**DoE**) in several cases:

- *Ballinno v UEFA & Kinexon* (CFI 151/2024, 2 June 2024) in the context of a PI application (where the Hamburg LD found no infringement, either direct, indirect or by equivalence);
- *Plant-e v Arkyne* (CFI 239/2023, 22 Nov 2024) where The Hague LD applied the DoE using Dutch-derived DoE approach (with the consent of the parties) in a decision on the merits, finding the patent valid and infringement by equivalence and granting an injunction;
- *OrthoApnea* (CFI 376/2023, 17 January 2025) where the Brussels LD found no infringement by equivalence; and
- *Dish v Aylo* (CFI_471/2023, 6 June 2025) where the Mannheim LD considered the applicable law but determined that no applicable law, either national or UPC would mean that there was infringement here by equivalence as no functional or technical equivalence).

The first three of these were discussed in our briefing The UPC at 18 months but the most recent is particularly illustrative of the UPC's development of its own DoE approach.

In *Dish v Aylo* the Mannheim LD found no infringement by equivalence. The UPC concluded that the method of streaming videos (which was the subject of the patent) used in the challenged embodiments, did not make equivalent use of the teaching of the patent. The court held that they did not infringe the patent because they lacked technical-functional equivalence. The Mannheim LD, referencing the Brussels LD's approach in *OrthoApnea* (above), commented that "*According to all equivalence doctrines or equivalence tests of the UPC contracting states, an equivalent patent infringement is excluded if there is no technical-functional equivalence of the means of exchange in the sense that the modified means do not perform essentially the same function in order to achieve essentially the same effect. Insofar as the same function is not taken into account, at least essentially the same effect is taken into account*".

In terms of what law to apply in relation to DoE, the Mannheim LD recognised that there was "much to suggest" that it should apply national law of UPC member states on DoE. It recognised that

> *"The fact that there are differences in the equivalence doctrines of the contracting member states of the UPCA in this respect is probably largely due to the fact that there is no higher-level judicial authority that could standardise the different nuances in the UPCA contracting states. The respective national jurisprudence practice in the application of Art. 69 EPC and the Protocol of Interpretation is likely to be regarded as an integral part of the respective national substantive judicial law and is a consequence of the further development of the law entrusted to the national courts in the respective Contracting Member States.*".

but concluded that it had no mandate to harmonise DoE standards across UPC member states:

"the UPCA does not give the UPC a mandate to unify the law of its contracting member states for acts that are subject to their national substantive law, including judicial law. Accordingly, the UPC is likely to have to apply the doctrine of equivalence of the respective Member State to acts that are subject to the substantive national law of the UPC contracting states in the same way as a purely national court of that member state would apply it."

The court continued saying there was also *"much to suggest that for acts that are subject to the substantive law of the UPCA, the UPC will have to develop its own doctrine of equivalence, if necessary by recalling the traditions of the UPC member states*". It noted that *"the UPC member states have delegated to the UPC the application of the EPC and thus at the same time the unification and further development of the law in connection with such acts that are subject to the substantive law of the UPCA. ... Without such a uniform determination of the material scope of protection of a European bundle patent across all national parts of the contracting member states, the elimination of fragmentation regarded as detrimental to economic development intended by the establishment of the UPC would remain incomplete in one crucial respect. This applies equally to the determination of the material scope of protection with a view to literal and equivalent protection."*

However the Mannheim LD concluded that it was not required to make a final decision on this since " [i]*rrespective of which doctrine of equivalence applies to the acts at issue here, an equivalent patent infringement is excluded according to all equivalence doctrines or equivalence tests of the UPC contracting member states if there is no technical and functional equivalence of the means of substitution in the sense that the modified means do not perform essentially the same function in order to achieve essentially the same effect. Insofar as the same function is not taken into account, at least essentially the same effect is taken into account ..."*

Nevertheless, the case represents a helpful exploration of the approach the UPC could take if a final decision was required in another case.

4. Front-loaded procedure and late pleadings/claims

The UPC has a very front-loaded procedure with the case being put forward almost exclusively through written pleadings with little allowed to be left to be presented at hearings. Attempts at late filing of pleadings or additional pleadings or claims have generally been refused. See for example the failed request for leave to file further pleadings in *Grundfos v Hefei* (CFI 11/2924, Dusseldorf LD 26 February 2025) and the attempt in *Photon Wave v Seoul Viosys* CFI_238/2024 Paris LD 24.01.2025 for an intervenor to file its own statement of defence (deemed out of time), or the Court of Appeal's strict interpretation of the rules of procedure in *Amazon v Nokia* CoA 835/2024, 24 March 2025) to decline any more submissions (although it said the parties could wait until the hearing the following day), or the Mannheim LD's dismissal of Sunstar Engineering Europe GmbH's application to amend its counterclaim for revocation against CeraCon GmbH, which sought to introduce a new novelty attack based on a prior art document *(Sunstar Engineering Europe GmbH v CeraCon GmbH* CFI 745/2024, 6 June 2025).

In *Tridonic v CUPOWER* CFI 459/2023 on 7 March 2025, the Dusseldorf LD held that new attacks on the validity of the patent that only occur in the course of the oral hearing are not to be taken into account and declared that strategic tactics aimed at surprise effects are alien to the UPC's Rules of Procedure.

In the revocation action in *EOFLOW v Insulet* (CFI 597/2024, 11 April 2025) the Milan CD held the submission of new prior art after the end of the written procedure or at the reply stage, prevents the other party from responding fully at a crictical stage of the proceedings and is contrary to the principles under Art 76 UPCA:

> "*.... when a party files an action before this court, it must take care to show and possess the evidence in support of the claim in advance.*
>
> *Therefore, in a revocation action, prior art (potentially detrimental to the patent or not) cannot be filed at a later stage ....*
>
> *Submission of a document at a later stage appears to be justified only if the party submitting it proves that the document was not previously available or could not have been submitted earlier.*"

An application to add an extra EP to a revocation action was also refused by the Munich LD in *Esko-Graphics v XSYS* (CFI 483/2024, 28 February 2025) – since the defendant had failed to show that it could not have been done "with reasonable diligence" at an earlier stage (RoP 263.2(a)). Even where both parties wished to file further pleadings within time in terms of the written procedure, this was rejected by the Dusseldorf LD (*Hartmann v Omni-Pac* CFI 115/2024, 4 March 2025). These included pleadings relating to equivalent infringement in the counterclaim in a revocation action.

However in the *10x Genomics v Curio* (CFI 140/2024, 16 June 2025), the Dusseldorf LD ruled that 10x Genomics could introduce new construction claim in relation to Claim 1 to broaden its scope and make an allegation of indirect infringement, during the oral hearing. Context is important here as the court deemed that claim construction is a matter of law (not fact – so new evidence should not impact it) but also that the point raised by 10x was consistent with its earlier argument on how to interpret the word "array". Nevertheless, it was still a surprising approach by the court, given the number of times the "front-loaded" nature of UPC proceedings has been emphasised by the court, including in the above decisions, but shows that the UPC can be flexible when it wants to be.

We anticipate that the UPC's desire to keep cases on timetable is also a relevant factor in its decision-making on this issue

5. Criteria for Preliminary Injunctions (PIs)

The Dusseldorf LD set out the UPC's guiding principles for the award of a PI in its decision of 21 March 2025 in *Barco v Yealink* (CFI 582/2024).

- **Entitlement:** an applicant should provide reasonable evidence with a sufficient degree of certainty that he is entitled to initiate proceedings under Art. 47 UPCA.
- **Validity and infringement:** an applicant should provide reasonable evidence with a sufficient degree of certainty that the patent is valid and that its rights are being infringed, or that such infringement is imminent (R. 211.2.).
- **Urgency:** an applicant should prove its need for early and prompt protection of its right to avoid further damage resulting from delays in resolving the case on its merits. This would not be the case if an applicant has acted negligently or hesitated in requesting provisional measures after gathering all the necessary elements for legal action (from an objective standpoint and taking into consideration factual circumstances). To assess urgency from an objective standpoint, it is necessary that the applicant provides the Court with a specific date when he became aware the alleged infringement. (R. 211.4.)
- **Weighing the interest of the parties**: an applicant should prove that the balance of interests weighs in its favour (R. 209(1)(b), 211(2) and (3)).

In *Barco*, the PI failed on grounds of delay/non-urgency. The court also confirmed that the time from which to judge any delay on the part of the party seeking an PI, starts from the date of grant of the EP (and not the date of grant of UP status if such status is requested).

The court emphasised that the conditions to be met to grant preliminary measures are of a cumulative nature such that if the applicant fails to meet one of these conditions the application for provisional measures will be held unfounded (and the court will not need to, or be under any obligation to, further assess any other requirements. In this case, since the court found lack of temporal urgency, the court said it did not need to consider the other aspects.

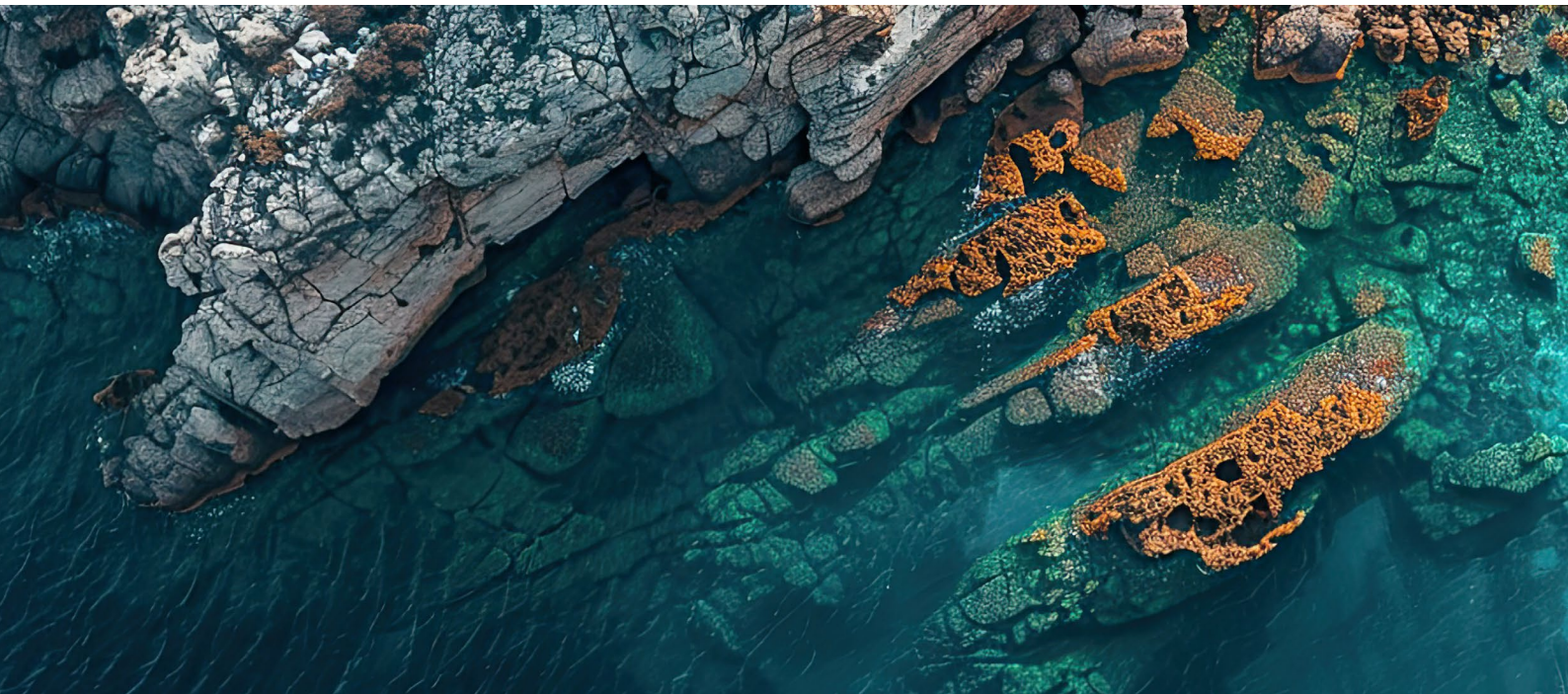
The detailed approach of the courts in PI applications to the determination of validity and infringement, and more so on appeal, suggests that pleadings and evidence will need to be very "front loaded" in this context in particular. There is effectively a mini-trial on validity and infringement at a preliminary stage in this context. Also of note is that validity appears to be reviewed in much more detail and generally requires more "proof" in *inter partes* applications compared to *ex parte* ones.

Parties have had to grapple with determining what level of detail is necessary to meet the threshold of providing "*a sufficient degree of certainty that the patent is valid*" in the context of PI applications.

This was a consideration in *Hand Held v Scandit* (CFI 74/2024, 27 August 2024) where the Munich LD held that (following its decision in *SharkNinja v Dyson* CFI 443/2023, 21 May 2024) the number of arguments put forward against the validity of the patent is usually to be reduced to the best three from the respondent's point of view. The court said that while there may be a summary assessment of the facts, there is no "summary" way to assess a point of law: "the court will either examine appoint of law or not. If the court decides to examine the question, it will do so comprehensively". In order to make this manageable at PI stage, the number of points raised on validity should be reduced to three. The same approach was applied, again by Munich LD in *Syngenta v Sumi* (CFI 201/2023, 27 August 2024).

In contrast, the CoA in the appeal of the PI in *Ortovox v Mammut* (CoA 182/2024, 25 September 2024) found that the deliberate restriction of the defendant's legal defence like this was not justified. The CoA wanted all relevant arguments on validity to be put before it – nine in total in that case – nevertheless, the PI remained in place.

While the UPC may consider the result of EPO oppositions or their likely outcome on issues of validity, it will ultimately take its own view on these questions by reference to the provisions of the EPC. There is no requirement that the patent has been tested at the EPO or anywhere else for that matter for a PI to be granted. If it has been and has survived this might be a strong evidential indication of validity, but is not a prerequisite. Other factors like the patent having been around for many years post-grant but not having been challenged may also be taken as indications of validity.



In March 2025, the Court of Appeal in *Sumi v Syngenta* (CoA 523/3024, 3 March 2025) considered the impact of sales of infringing product on the patentee's business in the context of the necessity criteria for awarding a PI for a pharmaceutical product. The Court of Appeal declared that a move from a market in which only the patentee's product is available, to one where there are two competing products can be expected to lead not just to price pressure but to a permanent price erosion. That was held to be an important factor when considering whether a preliminary injunction is necessary in such circumstances. Significantly the Court of Appeal considered that the PI should be granted to cover areas of its jurisdiction where the defendant did not have the regulatory approvals necessary to sell the product, on the basis that the defendant could later obtain them and begin marketing there.

Both the first instance and Court of appeal decisions in this case contain interesting discussions of particular relevance to the infringement of patents for pharmaceuticals and the relevance of marketing authorisations, product advertising and associated issues.

6. Determining imminent infringement

The Dusseldorf LD provided guidance in *Novartis v Celltrion* (CFI 166/2024, 6 September 2024) on how to interpret "imminent infringement". Although the court held that the circumstances must be assessment on a case-by-case basis "*The question to be answered is whether the conduct of the [Defendant(s)] leads to the conclusion that they are more likely than not intend to enter the market during the patent term without any further ado*". The court considered that "*Applicants are not required to accept a situation that would lead to the renegotiation of their contracts with their customers for their own product in 2024, or that would affect their ability to negotiate of new contracts in 2025. This would certainly be the case if a concrete offer of the challenged embodiment were made to the market, which would constitute direct infringement. It is sufficient for an offer if the act in question actually creates a demand for the product which the offer is likely to satisfy*". See our briefing The UPC at 18 months for more detail on this case but compliance with all the regulator measures, in the case of pharmaceuticals, and mentioning a specific price, were held to be key elements demonstrating imminent infringement risk.

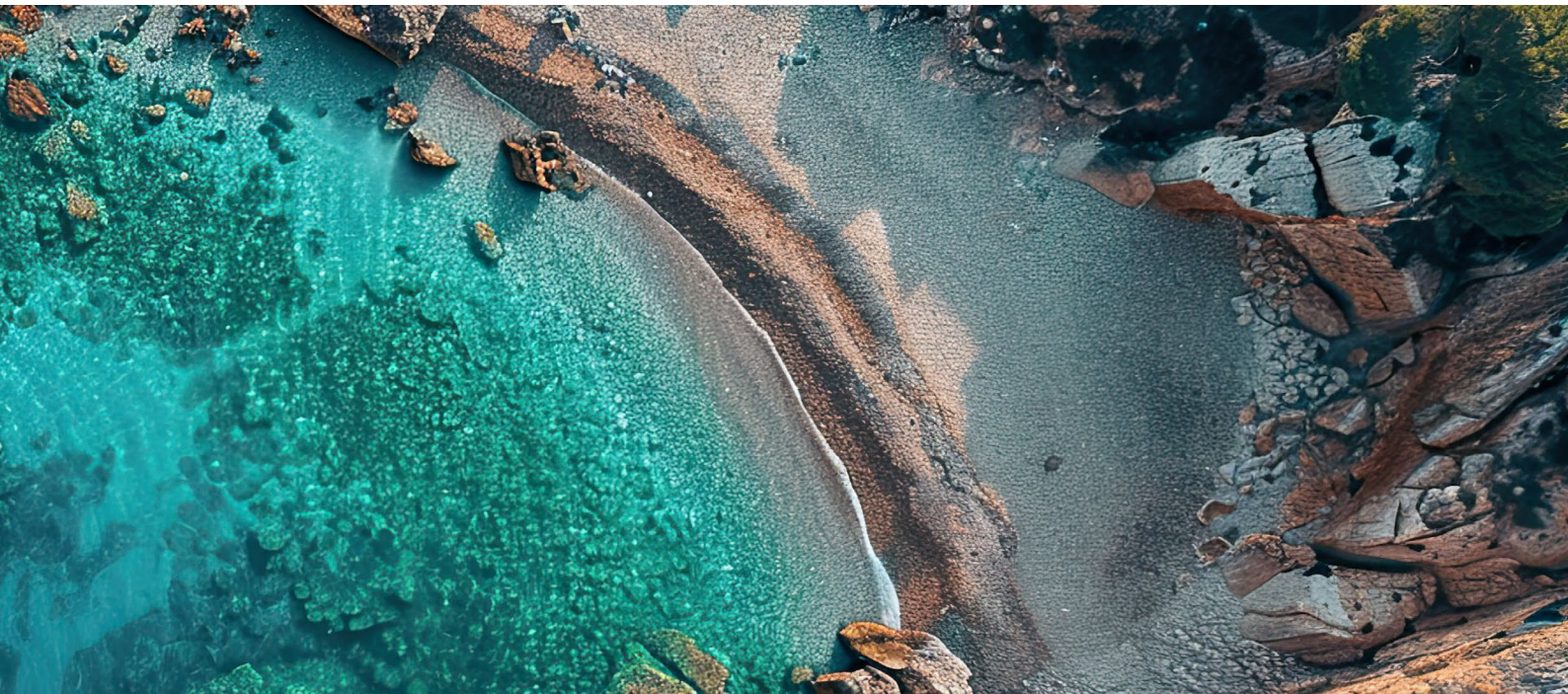
More recently in *Boehringer v Zentiva* (Lisbon LD, 8 May 2025), a PI decision based on an SPC, the PI was refused for lack of proof of imminent infringement. This is an interesting discussion by the court on the relevance of MA and PEP applications and grant, and their implications for imminent infringement. There the fact of regulatory approval was not held to mean that the drug would go on the market before the patent had expired.

In contrast, earlier in the year in *Insulet Corporation v EOFlow Co., Ltd.* (CoA 768/2024, an appeal in case CFI 380/2024) on 30 April 2025, the Court of Appeal ordered a PI to be granted that had been refused by the CFI, finding that a risk of the continuation of infringement arose from a prior infringement "*if the infringer does not issue a cease-and-desist declaration with a sufficient penalty clause*".

7. Novelty – the "legal standard"

The Munich LD set out the "legal standard" for added matter, inventive step and novelty in its decision of 4 April 2025 in *Edwards v Meril* (CFI 501/2023). In relation to novelty it concluded that:

- a European patent may be revoked with effect in a Contracting State on the ground that the subject-matter of the European patent is not patentable under Articles 52 to 57 EPC;
- an invention is considered to be new if it does not belong to the state of the art – the state of the art is to be taken to mean everything that has been made available to the public by means of a written or oral description, by use, or in any other way, before the date of filing of the European patent application (or, where applicable, the priority date);
- the assessment of novelty requires an examination of the entire content of the prior publication; and
- It is decisive whether the subject-matter of the claim is directly and unambiguously disclosed with all its features in the prior art references, as confirmed by the Court of Appeal in *Mammut v Orotvox* (CoA 182/2024, 25 September 2024).



8. Inventive step/Obviousness

In terms of inventive step, the UPC appears to be acknowledging the problem-solution approach of the EPO but only as one possible option, and the UPC is following a different path of its own. In *Meril v Edwards* (CFI 15/2023 and CFI 255/2023) 19 July 2024), the Paris CD directly addressed the use of the problem-solution approach, stating that "*this test is not explicitly provided for in the EPC and, therefore, does not appear to be mandatory*", although it added that applying the problem-solution approach would not have led to a different conclusion. This is a clear indication that the UPC intends to develop its own approach to obviousness.

In summary, the EPO's problem-solution approach involves identifying the closest single piece of prior art (the most promising springboard) whereas the UPC in *Sanofi-Aventis v Amgen* (Munich CD) held that "*The assessment of inventive step starts from a realistic starting point in the prior art. There can be several realistic starting points*. It is not necessary to identify the most promising starting point" and that any document that '*would have been of interest to a skilled person*' is a suitable starting point. For example, in January 2025, in *NJOY v VMR* (CFI 311/2023, 21 January 2025) the Paris CD started from a combination of two pieces of prior art in its assessment of invention step in this revocation action, finding the patent was not obvious.

In April 2025, in *Edwards v Meril* (CFI 501/2023, 4 April 2025), the Munich LD awarded a PI and in discussing the "legal standard" for inventive step, concluded that when *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 UPC with the jurisprudence of the EPO and the Boards of Appeal*".

From the above it would seem that although the problem-solution approach has a role, different divisions of the UPC appear to be taking varied approaches, not rigidly following the analysis used by the EPO, although with some divisions keener to use it than others. We await a Court of Appeal decision to clarify and harmonise this.

9. Added matter

The below decisions illustrate the UPC's approach to added matter, all with similar themes.

The Hague LD's decision in *Plant-e* (CFI 239/2023, 22 November 2024) applied the EPC test for added matter, stating that

> "*... any amendment to the parts of a European patent application relating to the disclosure (the description, claims and drawings) can therefore, irrespective of the context of the amendment made, 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. After the amendment, the skilled person may not be presented with new technical information.*"

Subsequently the Paris CD in *NJOY v Juul Labs* (17 January 2025, CFI 316/2023) applied The Hague LD's approach in *Abbot v Sibio* (CFI 131/2024, 19 June 2024): "*An amendment is regarded as introducing subject-matter which extends beyond the content of the application as filed, and therefore unallowable, if the overall change in the content of the application (whether by way of addition, alteration or excision) results in the skilled person being presented with information which is not directly and unambiguously derivable from that previously presented by the application, even when account is taken of matter which is implicit to a person skilled in the art. Any amendment can only be made within the limits of what a skilled person would directly and unambiguously derive, using common general knowledge, and seen objectively and relative to the date of filing (or the priority date, where appropriate), from the whole of the documents as filed*".

More recently, the Dusseldorf LD produced its own approach on added matter in *Fujifilm v Kodak* (CFI 355/2023, 28 January 2025) that:

"*To comply with Art. 123(2) EPC (added matter), the subject-matter of an amended claim must be*

directly and unambiguously taught to the skilled person by the original application.

- *A direct teaching requires that the subject-matter is originally taught as specific, clearly defined and recognizable individual embodiment, either explicitly or implicitly, without the necessity of applying any deductive skills.*
- *An unambiguous teaching requires that it has to be beyond doubt – not merely probable – that the claimed subject-matter of an amended claim was disclosed as such in the application as originally filed.*"

In April, the Munich LD in *Edwards v Meril* (CFI 501/2023, 4 April 2025), referring to Art 65(2) UPCA and Art 138(c) EPC, set out what the court termed the "legal standard" for added matter:

"*... in order to determine whether there is added matter, the court must first determine what the person skilled in the art would deduce directly and unambiguously from the whole of the application as filed, using his common general knowledge and viewed objectively and in relation to the date of filing, whereby implicitly disclosed subject matter, ie matter which is a clear and unambiguous consequence of what is expressly mentioned, is also considered to be part of the content of the application as filed.*"

Where, as in this case, the patent is a divisional application, this requirement applies to each earlier application.

The Munich LD also referred to the Court of Appeal's decision in *Abbo v Sibio* CoA 382/2024, 14 February 2025) which it noted that "*the assessment of added matter cannot be limited to those parts of the original application which the patentee has indicated as the basis for an amended claim during the examination proceedings before the EPO, since a proper understanding of those parts also requires an assessment of their content in the context of the disclosure of the application as a whole*". Nevertheless, no added matter was found.

10. Stays and suspensive effect

There are various situations where stays may occur at the UPC. These include:

- stays pending the outcome of national proceedings (and whether this applied to proceedings that were ongoing at the start of the UPC start date or completed before then, and the impact on the court's discretion (or otherwise) to stay proceedings;
- refusal of stay of execution of a decision on the merits pending appeal;
- suspensive effect in cases of extreme urgency;
- suspensive effect in relation to appeals or errors in orders impacting on director's liability;
- suspensive effect where there were errors in the injunction order

These are discussed in more detail in our briefing The UPC at 18 months. Since that was written, there have been several more decisions on stays and suspensive effect. As a general trend, stays pending EPO proceedings have often not been successful except where more recently there was an application where both parties consented to the stay and appeal proceedings were stayed pending the opposition proceedings at the EPO, where opposition proceedings could be expected to result in a final decision soon afterwards, or at least before any oral hearing date at the CoA (see *Juul Labs v NJOY* CoA 327/2025, 28 April 2025 and *Juul Labs v NJOY* CoA 5/2025, 30 April 2025).

In *NUC Electronics Co., Ltd v Hurom Co., Ltd* CFI 162/2024 (Mannheim LD, 6 June 2025) the court refused to stay an order for provision of information on origin of infringing goods or third parties involved in infringement despites a pending appeal; the disclosure of information had to proceed regardless (ie the appeal did not have suspensive effect).

A pattern is emerging such that where both parties agree then stays are much more likely to be granted, in particular where there are settlement discussions on-going (see also our comments below on the UPC and settlements). Otherwise, the UPC has a clear preference for keeping cases moving wherever possible.

11. Security

In November 2024, in *Aarke AB v SodaStream* (CoA 548/2024 (29 November 2024), the CoA held that when deciding on a request for security for costs

- failing any guarantees or other special circumstances, it is not relevant whether the claimant belongs to a financially sound group of companies. It is only the financial position of the claimant itself that is relevant;
- it is not relevant whether a claimant is willing to reimburse the defendant if a cost order would be issued in favour of the defendant;
- it is also not relevant whether a cost order in favour of the defendant is to be expected. The Court should not engage in evaluating the likelihood of the outcome of the case;
- it is not required that it is proven that enforcement is impossible. It is sufficient for a defendant to establish that enforcement of a cost order is unduly burdensome. The burden of showing this is on the applicant of an order for security for costs. To this end, the applicant shall not only provide evidence as to the foreign law applicable in the territory where the order shall be enforced, but also its application.

Generally the courts seem to be approaching this by asking questions such as the following, to determine whether to exercise their discretion to award security:

- whether the financial position of the claimant gives rise to a legitimate and real concern that a possible order for costs may not be recoverable and/or the likelihood that a possible order for costs by the UPC may not, or in an unduly burdensome way, be enforceable *Emboline v AorticLab* CFI 628/2024 (16 April 2025, Munich LD) and *EOFLOW v Insulet* (CFI 597/2024, 11 April 2025, Milan CD) applying the Court of Appeal in *NST v Audi*

The Milan CD confirmed that the burden of substantiating and proving why an order for security for costs is appropriate in a particular case lies with the defendant making such a request, but that – once the reasons and facts in the request have been credibly presented – it is for the claimant to challenge those reasons and facts in a substantiated manner, especially since that party will normally have knowledge and evidence of its financial situation. It is for the claimant to argue that and why a security order would unduly interfere with its right to an effective remedy.

In *Chint New Energy v JingAo Solar* CFI 425/2024 (19 March 2025) the Munich LD held that where a country fails in its Hague service obligations this can be sign that enforcement will be difficult and can aid an application for security for costs: "*... it has to be assumed that an order for reimbursement of costs by the UPC may not be enforceable in this country or just in an unduly burdensome way*". Thus security for costs can be appropriate in such a situation.

In our briefing The UPC at 18 months, we also discussed security against SMEs, NPEs and defendants (see the briefing for more detail) but more recently, in July 2025, the court rejected a request for security against an intervenor, ruling that intervenors are treated as a party but it is at the court's discretion whether they should provide security also (*SWARCO v. Yunex*, CFI 245/2025, Munich LD, 2 July 2025).

12. Access to pleadings

The CoA's decision in *Ocado v Autostore* (CoA 404/2023,10 April 2024) provided the approach that the UPC courts now follow, but it still leaves room for interpretation. The decision set out the criteria for the "reasoned request" which needs to be made under RoP 262.1(b) for public access to the Register. The CoA held that a 'reasoned request' in R.262.1(b) RoP meant "a request that not only states which written pleadings and evidence the applicant wishes to obtain, but also specifies the purpose of the request and explains why access to the specified documents is necessary for that purpose, thus providing all the information that is necessary for the judge-rapporteur to make the required balance of interests mentioned in Art. 45 UPCA. This includes but is not limited to an assessment whether the request is abusive or not. Nor are the reasons only relevant when determining whether there is a need to keep information confidential".

Following this decision, successful applications were made in several cases and the principle that PI pleadings and evidence could be accessed following the conclusion of the PI proceedings was established by The Hague LD in *Abbott v SiBio*. The Hamburg LD in *Ballinno v UEFA* also allowed access following a PI, with the applicant requesting access simply in order to "*gain a better understanding of how court dealt with PI application*".

Consistent with these decisions, subsequent applications suggest that the UPC will take a permissive approach on this issue once the matter to which the requested documents relates has been dealt with at a hearing. Parties should therefore work on the basis that access to documents will generally be granted in such situations (though subject to redaction of particularly sensitive information).

13. Second medical use patents

In May 2025, the UPC gave a decision on its first set of proceedings involving a second medical use patent. In *Sanofi & Regeneron v Amgen* CFI 505/2024 (13 May 2025), the Dusseldorf LD dismissed both the infringement action and the counterclaim for revocation, but provided a clear exposition of the UPC's approach to such patents and evidencing their infringement.

The court found that:

- for a finding of infringement of a second medical use claim, the alleged infringer must offer or place the medical 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. The requirements of such behaviour cannot be defined in an abstract manner but require an analysis of all relevant facts and circumstances of the patent claim in question; and
- in order to benefit from the notional novelty afforded by Art. 54(5) EPC, second medical use claims must relate to a specific use in a method according to Art. 53(c) EPC. The sole reason why such claims can still be patented is the novelty (and inventiveness) of the new use.

In terms of inventive step, the subject matter of the claim may be obvious if the skilled person would have been motivated to implement it as the next step in the view of the problem. A motivation to implement may be absent or negated if the skilled person is faced with many uncertainties or expected difficulties. If there is no motivation at all or a negated motivation, the subject matter of the claim is not obvious and involves an inventive step.

One issue the court considered in that case was whether doctors were prescribing the allegedly infringing product for the use claimed in the patent. The court, acknowledging he purpose-limitation of the product claim in this case held that "*... to find infringement of a purpose-limited product claim, the claimants must ... prove that the allegedly infringing product fulfils the "use" feature(s) of the claim*".

The court held that for a finding of infringement of a second medical use claim, the alleged infringer must offer or place the medical product on the market in such a way that it leads or may lead to the claimed therapeutic use and that the alleged infringer knows or reasonably should have known that it would. The court identified two required elements for there to be infringement:

- an objective element – there must either be a prescription for the claimed use or there must be at least circumstances showing that such a use may be expected to occur; and
- a subjective element – "*the infringer must know this* [the above] *or reasonably should have known*".

The court set out non-exclusive list of considerations that would need to be interrogated in the process of determining the objective and subjective elements. The requirements of such behaviour cannot be defined in an abstract manner but require an analysis of all the relevant facts and circumstances of the case at hand. Starting from the construction of the patent claim in question, relevant facts and circumstances may include:

- 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 court held that the manufacturing of the product and in particular the package insert and the Summary of Product Characteristics of a pharmaceutical product can be important. "*However, they are not always the only decisive factor to be taken into account in assessing whether the alleged infringer is in the end liable for patent infringement. Additionally, the extent to which the alleged infringer knows or should have known that the product will be used for the claimed purpose is of relevance*".

14. SEPs and FRAND at the UPC (and anti-suit injunctions)

In the two years since the UPC opened its doors it has become a popular destination for FRAND disputes. The EPO reported in its May 2025 Standards study that there have been 23 SEP cases as of mid-March 2025, establishing the UPC as a key forum for FRAND licensing disputes. For example, the UPC has seen disputes between major players in this space, such as *Panasonic v Oppo/Xiaomi, Huawei v Netgear, Samsung v ZTE, Huawei v MediaTek* and *Dolby v HP*.

There have so far been three final first instance decisions in SEP-related disputes at the UPC. The first (although not a classic SEP/FRAND case) is from September 2024 in the case of *Philips v Belkin* at the Munich Local Division (UPC CFI 390/2023). While this case involved SEPs, in this instance no FRAND defence was raised by the implementer and so the court was not engaged with FRAND issues. Ultimately, a multi-jurisdiction injunction was awarded to Philips with the patent upheld in full.

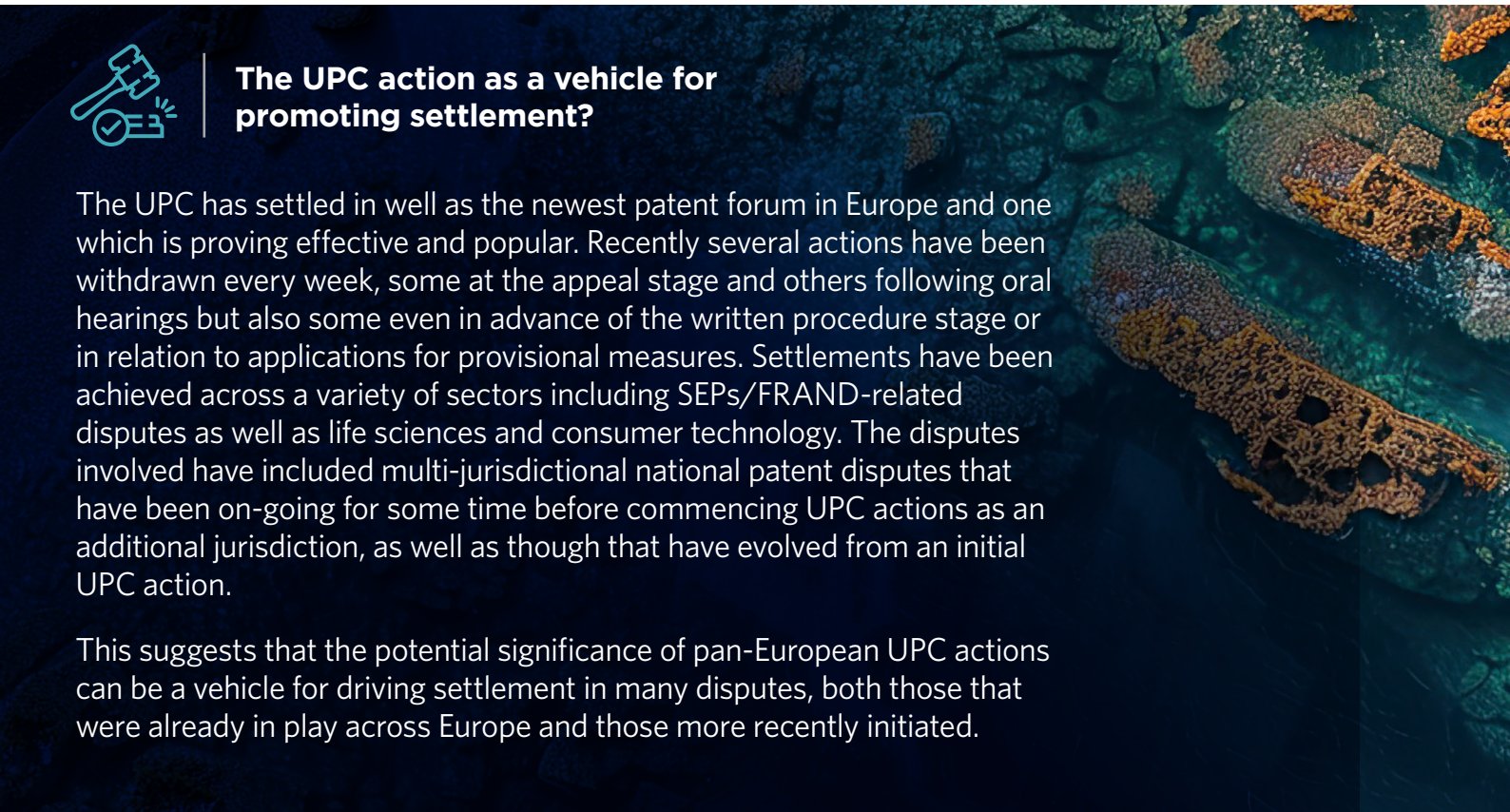
The Mannheim Local Division's decision in the *Panasonic v Oppo* case (UPC CFI 210/2023) was the first decision at the UPC to consider FRAND licensing issues substantively. In its decision the court dismissed the FRAND defence, finding that the defendant was an unwilling licensee, and ordered an injunction covering multiple UPC territories. The Mannheim Local Division's approach was notably very similar to the German national court's approach to FRAND – the court followed the steps set out in the CJEU's decision in *Huawei v ZTE* and focused on the parties' conduct. The UPC declined to engage in the process of determining FRAND licence terms itself (cf The UK courts' approach which has been to decide FRAND licence terms) – a FRAND determination counterclaim was held admissible but unfounded because the defendant's offer was not FRAND. The Munich Local Division followed soon after in *Huawei v Netgear* (UPC CFI 9/2023), citing the Mannheim Local Division's decision and following its approach closely. This again resulted in the award of an injunction against the implementer across multiple UPC territories.

While there have only been two substantive FRAND cases so far, the UPC has shown it is prepared to order injunctive relief against implementers. The German approach to dealing with SEP disputes is often considered favourable to the SEP holder and many commentators have suggested the UPC is moving in the same direction, although there have been differing out of court statements from judges from other jurisdictions recently. The trend for SEP holders to commence proceedings in the German local divisions of the UPC certainly suggests that SEP holders are looking for a similar approach, but with the greater threat of a pan-UPC injunction across multiple jurisdictions.

Interestingly, the Munich Local Division in the *Huawei* case also awarded an anti-anti-suit injunction (UPC CFI 791/2024). In this order, which was awarded *ex parte* and applied German and European law, Huawei was awarded an anti-anti-suit injunction against Netgear to prevent an anti-suit injunction filed by Netgear in the US, which had aimed to prevent Huawei enforcing at the UPC. The UPC has therefore also shown itself willing and able to protect its jurisdiction over FRAND disputes. Just days earlier, the Munich Local Division had issued the first ever UPC anti-anti-suit injunction in the case *Avago v Realtek*. In February 2025 the Munich Regional Court also issued an anti-anti-suit injunction in *Nokia v Shanghai Sunmi* (CFI 112/2025, Munich LD, 19 February 2025), granted in relation to anti-suit applications in a Chinese court.

While it is helpful to have guidance from these initial decisions, all of the cases have so far settled before any appellate proceedings and so we are yet to receive unifying guidance on the UPC's approach to FRAND disputes from the UPC Court of Appeal. As noted above, these decisions have also all come from the German local divisions of the UPC and it will be interesting to see whether there are moves by SEP holders to test other local divisions, and whether the approach of those divisions might diverge from Germany. Finally, some commentators have suggested that in future cases the UPC might be open to a more UK-style approach of setting court determined FRAND licence terms, but this will be in tension with the UPC's goal of dealing with cases within a year of proceedings being commenced. On the other hand, at the launch event of the EPO's May 2025 Standards study Rian Kalden, Presiding Judge of the second panel at the UPC Court of Appeal, discussed possible ways to obtain a FRAND determination from the UPC and suggested that an SEP holder may request an injunction conditional on the implementer not accepting a court-determined FRAND rate, or that the implementer may start a "declaration of non-infringement" arguing that it does not infringe because it will pay a FRAND rate set by the UPC court.

In the coming years further SEP cases will work their way through the UPC system and will hopefully yield further insights into the UPC's approach to FRAND disputes.



The UPC action as a vehicle for promoting settlement?

The UPC has settled in well as the newest patent forum in Europe and one which is proving effective and popular. Recently several actions have been withdrawn every week, some at the appeal stage and others following oral hearings but also some even in advance of the written procedure stage or in relation to applications for provisional measures. Settlements have been achieved across a variety of sectors including SEPs/FRAND-related disputes as well as life sciences and consumer technology. The disputes involved have included multi-jurisdictional national patent disputes that have been on-going for some time before commencing UPC actions as an additional jurisdiction, as well as though that have evolved from an initial UPC action.

This suggests that the potential significance of pan-European UPC actions can be a vehicle for driving settlement in many disputes, both those that were already in play across Europe and those more recently initiated.

UPC contacts

Our fully integrated, market leading team, is on the ground in Germany, Italy, France and the UK and has decades of experience in running multi-jurisdictional patent litigation in respect of our clients' most valuable products. The Herbert Smith Freehills Kramer pan-European patent team has already been active in the UPC, representing several parties in multiple actions.

If you would like to discuss the UPC in further detail, please contact a member of our team.

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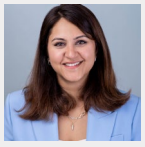

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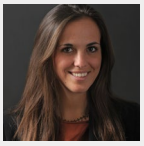

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