



HOFFMANN EITLE

Unified Patent Court

First ¹⁰⁰ days – pending cases, case management and the first hearings

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September 15, 2023

— Agenda

— 1. Expectations vs. reality

Did the UPC turn out as expected, so far?

— 2. First decisions, hearings and orders

What is the quality of the UPC?

— 1. Expectations vs. reality

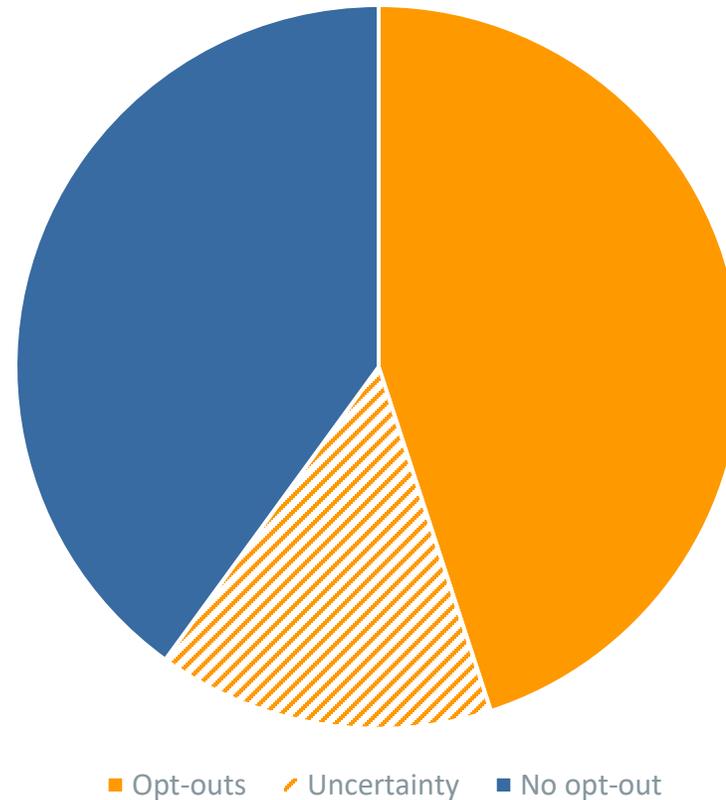
Did the UPC turn out as expected, so far?

Expectation:

“Many patents will be opted-out.”

During the sunrise period, there were almost **500.000 opt-outs**, that's about **45-60%** of all EPs (granted patents/pending applications).

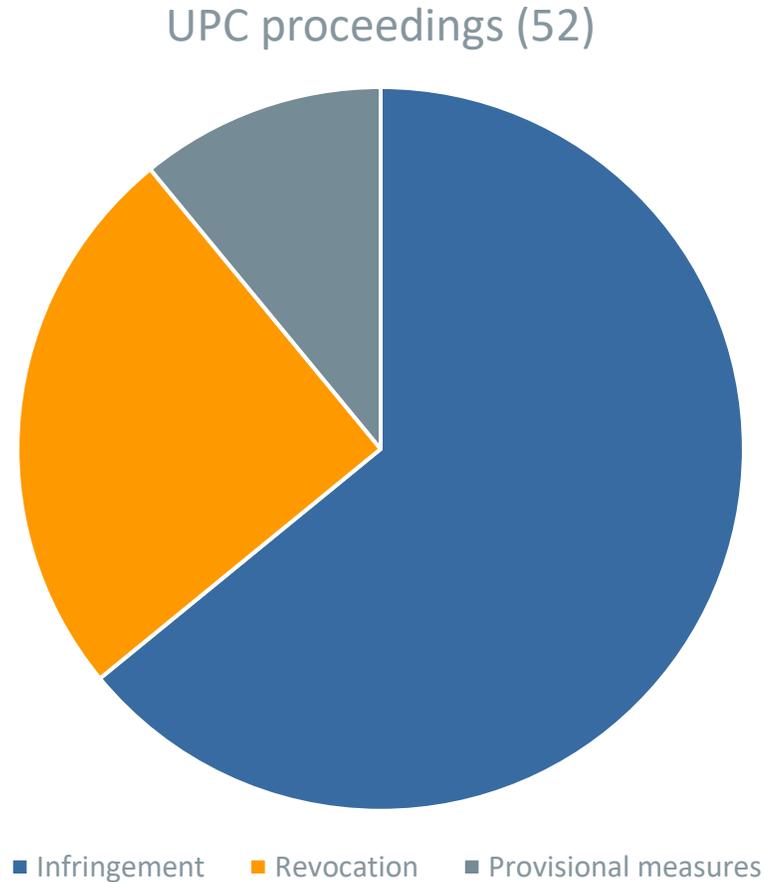
Opt-outs (during sunrise period)



Expectation:

“There will be many proactive validity attacks.”

So far, only **seven revocation actions** have been filed compared to **35 infringement actions**.

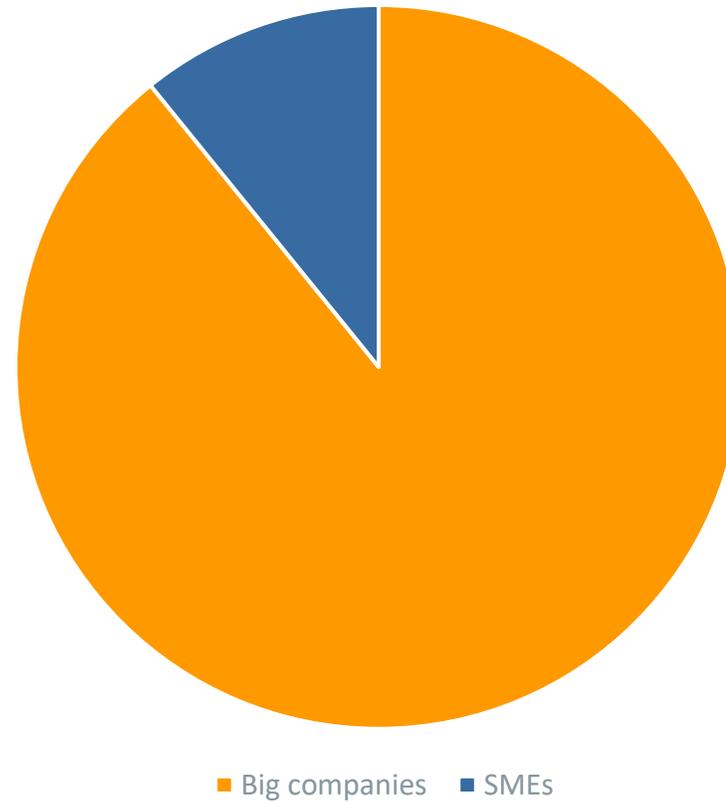


Expectation:

“SMEs will not use the UPC, that’s only for big companies.”

Most claimants are big companies,
but already **four SMEs** have filed infringement actions.

Infringement actions (35)



Expectation:

“The UPC will mostly be used to enforce SEPs.”

One SEP owner is enforcing **five patents** against **two implementers** at the LDs Munich and Mannheim – so far, no rush in that regard.



(19)  **EP 3 096 315 B1**

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and of the grant of the patent: **16.10.2019 Bulletin**

(21) Application number: 1

(22) Date of filing: 12.03.2017

(19)  **EP 2 568 724 B1**

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and of the grant of the patent: **17.12.2014 Bulletin**

(54) **DEVICE AND METHOD FOR TRANSMITTING AND RECEIVING SIGNALS**

(21) Application number: 1

(22) Date of filing: 13.08.2012

(19)  **EP 3 024 163 B1**

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and of the grant of the patent: **05.07.2017 Bulletin**

(54) **Radio Communication Device and Method**

(21) Application number: 1

(22) Date of filing: 28.10.2010

(19)  **EP 2 207 270 B1**

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and mention of the grant of the patent: **19.09.2012 Bulletin**

(51) Int. Cl.: **H04W 72/04 (2009.01)**

(54) **RADIO COMMUNICATION DEVICE AND METHOD**

(21) Application number: 1

(22) Date of filing: 28.10.2010

(19)  **EP 2 584 854 B1**

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and mention of the grant of the patent: **14.09.2016 Bulletin 2016/37**

(51) Int. Cl.: **H04W 72/04 (2009.01) H04J 11/00 (2006.01) H04W 28/06 (2009.01) H04L 5/00 (2006.01)**

(54) **WIRELESS COMMUNICATION METHOD**

(21) Application number: 13151604.9

(22) Date of filing: 26.12.2008

(54) **Channel arrangement method and wireless communication base station device**

Kanalanordnungsverfahren und drahtlose Kommunikationsbasisstationsvorrichtung

Procédé d'agencement de canal et dispositif de station de base de communication sans fil



Expectation:

“The UPC first has to prove itself before it is ready to handle provisional injunction requests.”

One *ex parte* provisional injunction (PI) granted; one *inter partes* PI denied; decisions on **two *inter partes* PIs** are expected next week.

Unified Patent Court

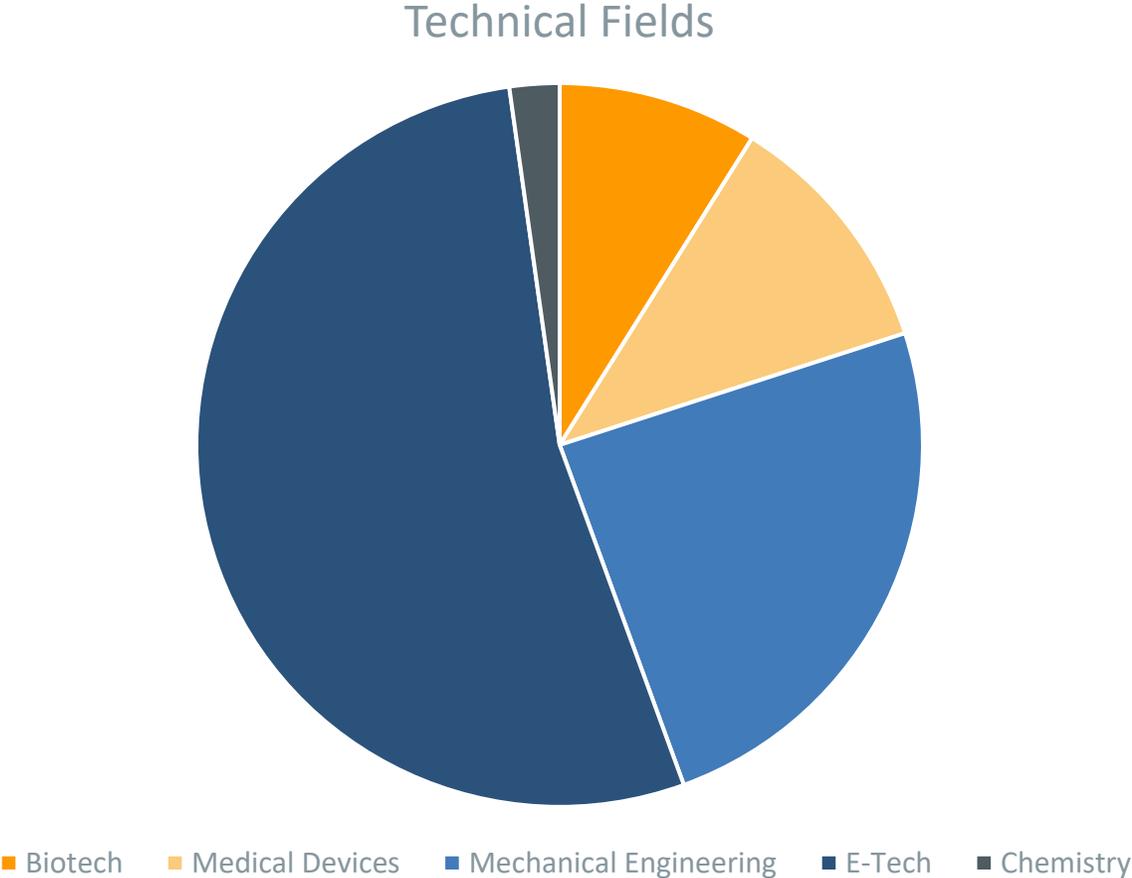
Panel preview: The judges behind the UPC's first major hearing



Expectation:

“At first, pharma patents will not be enforced due to opt-outs.”

Two infringement actions are based on pharma patents, about **25% of infringement actions** are from IPC class A.



Expectation:

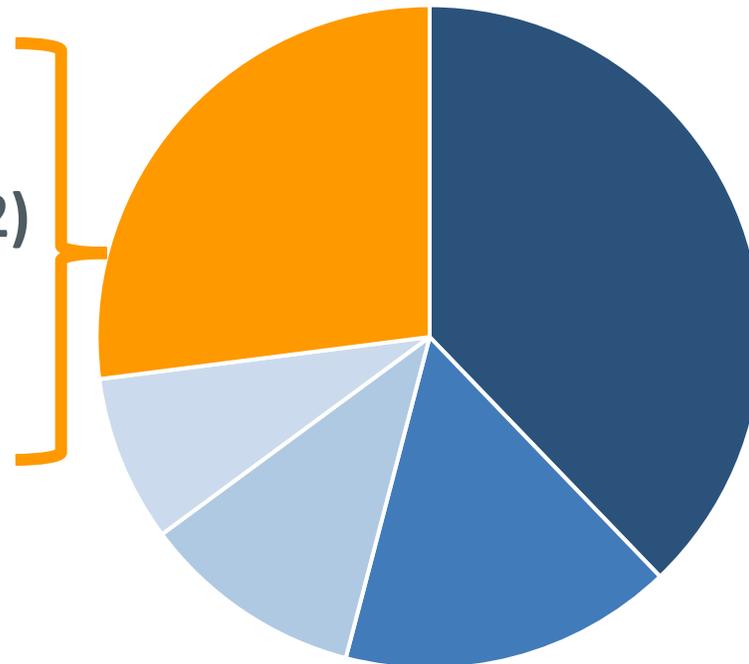
“The German local divisions will attract the most cases.”

— Over ⅔ of infringement proceedings* filed at German local divisions.

*Infringement actions (35)
+ Applications for PIs (7)

Other LD/RDs:

- LD Milan (5)
- LD Helsinki (3)
- RD Nordic-Baltic (2)
- LD Paris (1)
- LD The Hague (1)
- LD Vienna (1)



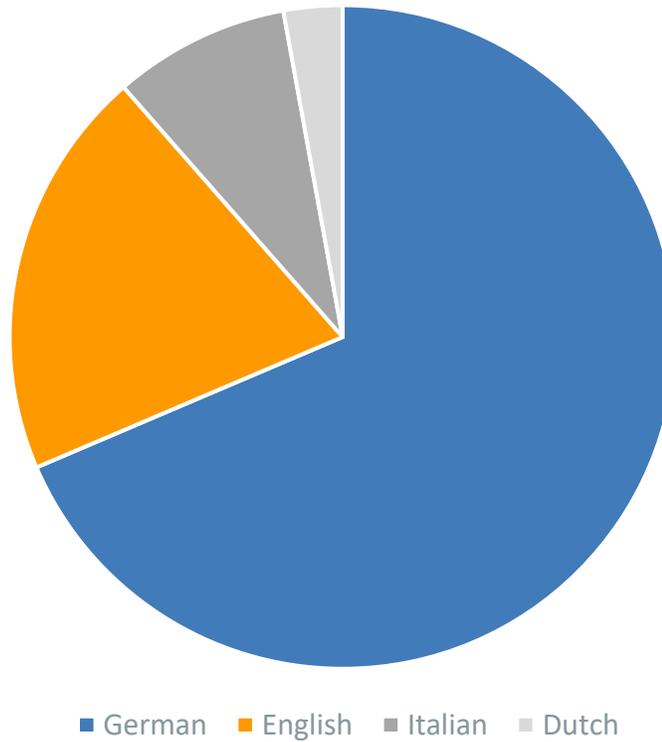
■ LD Munich ■ LD Mannheim ■ LD Dusseldorf ■ LD Hamburg ■ Other LD/RDs

Expectation:

“Most UPC proceedings will be conducted in English.”

German is the most widely used language before the UPC.

*Infringement actions (35)
+ Applications for PIs (7)



Expectation:

“Especially as a new court, the UPC should be transparent.”

— Transparency is still lacking, but UPC judges are taking this seriously.

- Hearings are announced on the UPC website well in advance; public can attend only in person, not via video link
- LD Munich
 - Instructions for the press and the public on how to attend
 - Additional “overflow” room available (27 people) due to limited capacity in the court room (10 people)
 - Large screens in both rooms to view relevant documents
- UPC website
 - Cases are only visible with delay
 - Less information visible compared to the CMS, some data is incorrect/misleading
 - Some decisions/orders have been published; it is planned to publish all of them (eventually)
- Access to pleadings upon “reasoned” request (RoP 262.1); first decision on how this is applied is expected soon

— 2. First decisions, hearings and orders

What is the quality of the UPC?

— First *ex parte* inspection proceedings (UPC_CFI_127/2023)

- **Oerlikon (DE) v. Himson (IN) / Bhagat (IN)**
- EP 2 145 848 B1: “False-twist texturing machine for the texturing of a plurality of multifilament threads”
- Inspection request filed June 12, 2023
- “ITMA” trade show in Milano from June 8 to 14, 2023
- Application transferred by the standing judge to the presiding judge of the LD Milan on the same day
- Order of June 14, 2023 by the **LD Milan**:
 - Inspection order granted
 - In one case, the inspection does not appear to have taken place, likely they ran out of time before the trade show ended
- Main infringement actions filed afterwards

- First ***ex parte* provisional injunction** (UPC_CFI_177/2023)
 - **myStromer** (CH) v. **Revolt Zycling** (CH)
 - EP 2 546 134 B1: “A combination structure of bicycle frame and motor hub”
 - Protective brief filed on June 19, 2023
 - Defense: non-infringement argument, alleged exhaustion of rights (Art. 29 UPCA), no validity attack pending
 - “Eurobike” trade show started in Frankfurt on June 21, 2023
 - **LD Dusseldorf** granted *ex parte* PI for all validated UPC states on June 22, 2023, same day the request was filed
 - Infringement confirmed, Swiss Federal Patent Court rejected exhaustion by order of June 8, 2023
 - Security payment of Applicant (EUR 500,000); provisional cost reimbursement of Respondent (EUR 16,000)
 - Quality comparable to German *ex parte* provisional injunction proceedings

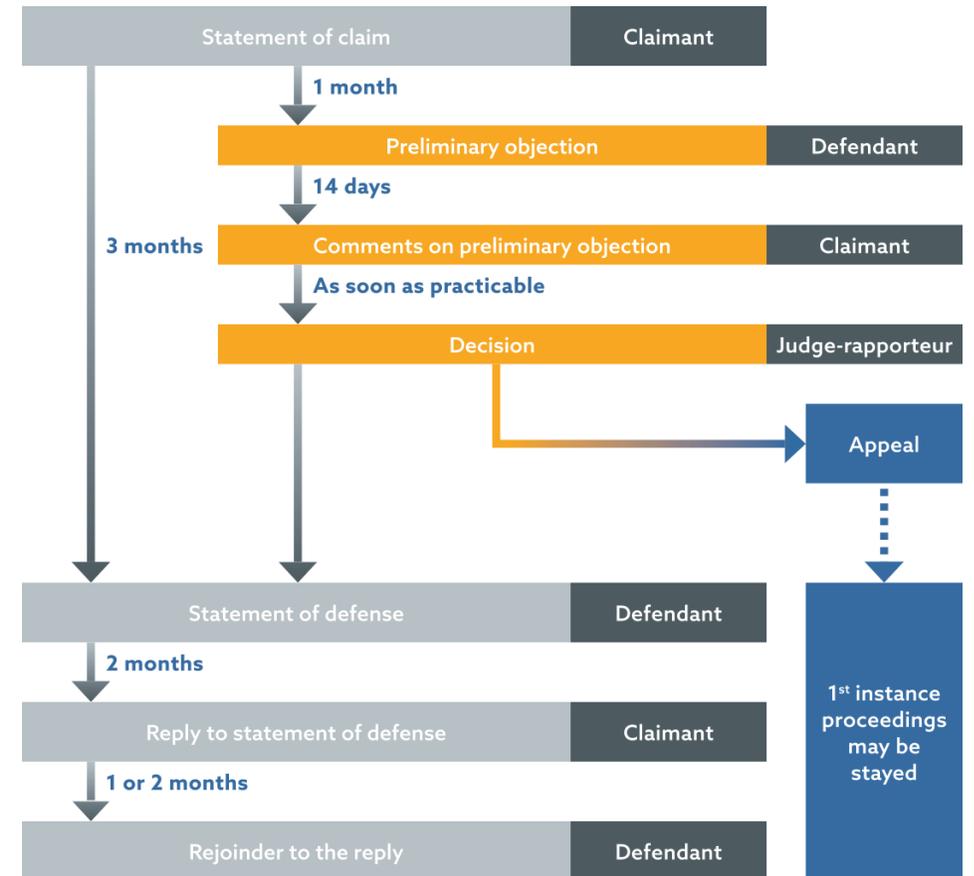
First hearing in a revocation action (UPC_CFI_1/2023)

Art. 33(4) UPCA: “Revocation actions shall be brought before the central division. If, however, an action for infringement [...] between the same parties relating to the same patent **has been brought** before a local or a regional division, these actions may only be brought before the same local or regional division.”



Who filed first?

RoP 4.2: “Where it is not possible to lodge a document electronically for the reason that the electronic case management system of the Court has ceased to function a party may lodge a document in hard-copy-form at the **Registry or a sub-registry.**”



— First **hearing in a revocation action** (UPC_CFI_1/2023)

- **Sanofi (FR) v. Amgen (US)**
- Amgen's infringement action was filed without exhibits in hard-copy at the LD Munich on June 1, 2023
- Sanofi's revocation action filed with exhibits in hard-copy at the Registry on June 1, 2023
- Preliminary objection in revocation action (RoP 19) – lots of work spent on procedural issue (45 pages of briefs, 20 pages of orders)
- Issues considered by the **CD Munich**:
 - Can hardcopies be filed in Luxembourg? Does the time of the day matter? Does filing without exhibits count?
 - Construction of UPCA and RoP: „*ordinary meaning of terms in their context and in the light of the object and purpose*“, compare EN/FR/DE versions, EU law, RoP history

— First hearing in a revocation action (UPC_CFI_1/2023)

- **CD Munich** rejected Amgen’s preliminary objection on August 24, 2023:
 - *“The rules determining the (internal) competence of the UPC must, [...], be clear and predictable.”*
 - *“The way to unequivocally and objectively determine which action has been brought first in time is by establishing and comparing the exact date and time of lodging of the Statement(s) of claim and the Statement of revocation.”*
 - *“The Statement of revocation was lodged in hard-copy at the Registry in Luxembourg on June 1, 2023 at **11.26** in the morning.”*
 - *“The Statement of claim in the infringement action was lodged in hard-copy at the sub-registry at the Munich LD on June 1, 2023 at **11.45** in the morning.”*
 - *“Based on these facts, [...], the Court finds that the revocation action was brought before the infringement action was brought and therefore considers itself competent [...].”*

— First **hearing in a PI proceeding** (UPC_CFI_2/2023)

- **10x Genomics (US) v. NanoString (US)**
- EP 4 108 782 B1 (EP-UE): “method for detecting a plurality of analytes in a cell or tissue sample”
- PI request filed on June 1, 2023; patent was granted on June 7, 2023
- Preliminary opinion by the German Federal Patent Court on parent patent
- EPO opposition pending
- Hearing on September 5/6, 2023 before the **LD Munich**:
 - In-depth discussion of claim construction, infringement, and validity
 - LD Munich applies EPO’s standard on validity
 - Procedural issues: urgency, irreparable harm, auxiliary claims in PI proceedings
 - Legal issues: licensing relationship, US and European antitrust law, territorial scope of PI

— Second **hearing in a PI proceeding** (ACT_528738/2023)

- **CUP&CINO** (DE) v. **Alpina** (AT)
- EP 3 398 487 B1: “method for production of milk foam with adjustable temperature”
- PI request filed at end of June 2023
- Nullity action pending at Austrian Patent Office
- Hearing on September 13, 2023 before the **LD Vienna**:
 - Three legally qualified judges, no technically qualified judge
 - Discussion of claim construction, infringement and validity
 - Procedural issues: ineffective opt-out and urgency

— First round of **procedural orders**

- Extension of timelines
 - A few extensions have been granted but this will change once the CMS is working properly
- Effect on timelines if annexes are not filed with statement of claim, instead only after service on defendant
 - RoP 13.2 (Contents of the Statement of claim): “*The claimant shall at the same time supply a copy of each of the **documents referred to** in the Statement of claim.*”
 - **LD Munich**: Annexes not relevant for defendant’s terms for preliminary objection and statement of defense
 - Defendants’ appeal to CoA; stay of proceedings requested, RoP 295(m): proper administration of justice
- Translation of protective briefs into language of the infringement proceedings before the LD

Questions?



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