HOFFMANN EITLE

Unified Patent Court

The first 6 months of the UPC
Statistics on pending cases, the first decisions & orders and strategic aspects

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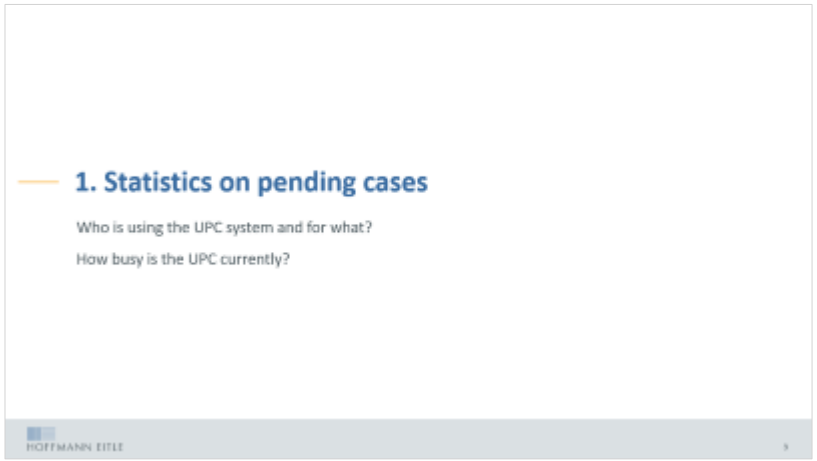
January 19, 2024

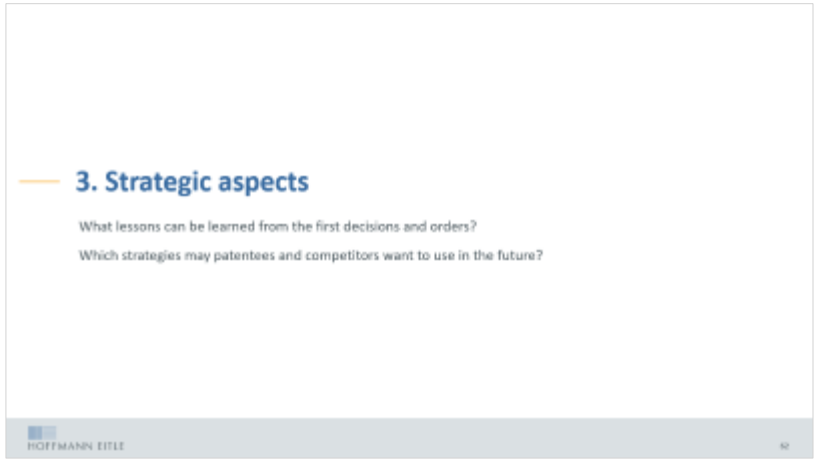
Agenda

1. Statistics on pending cases

Who is using the UPC system and for what?

How busy is the UPC currently?





1. Statistics on pending cases

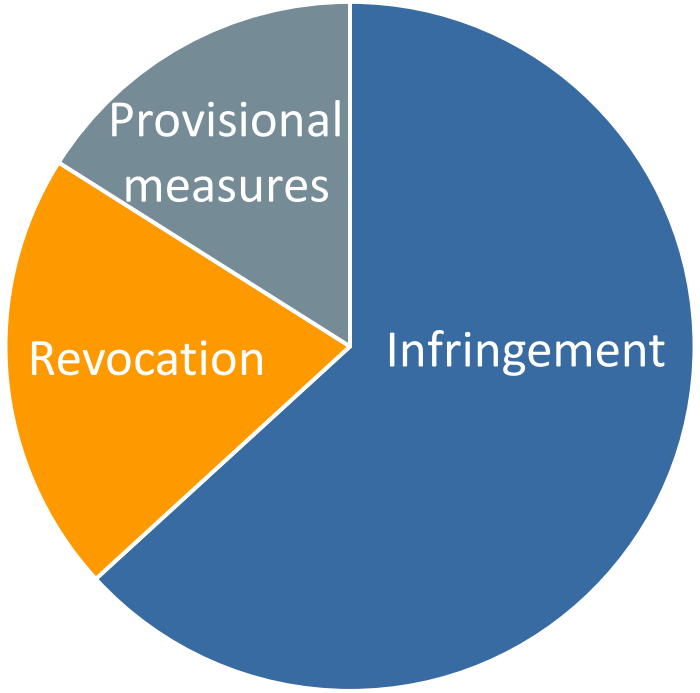
Who is using the UPC system and for what?

How busy is the UPC currently?

The UPC is used more for enforcing patents than for validity attacks

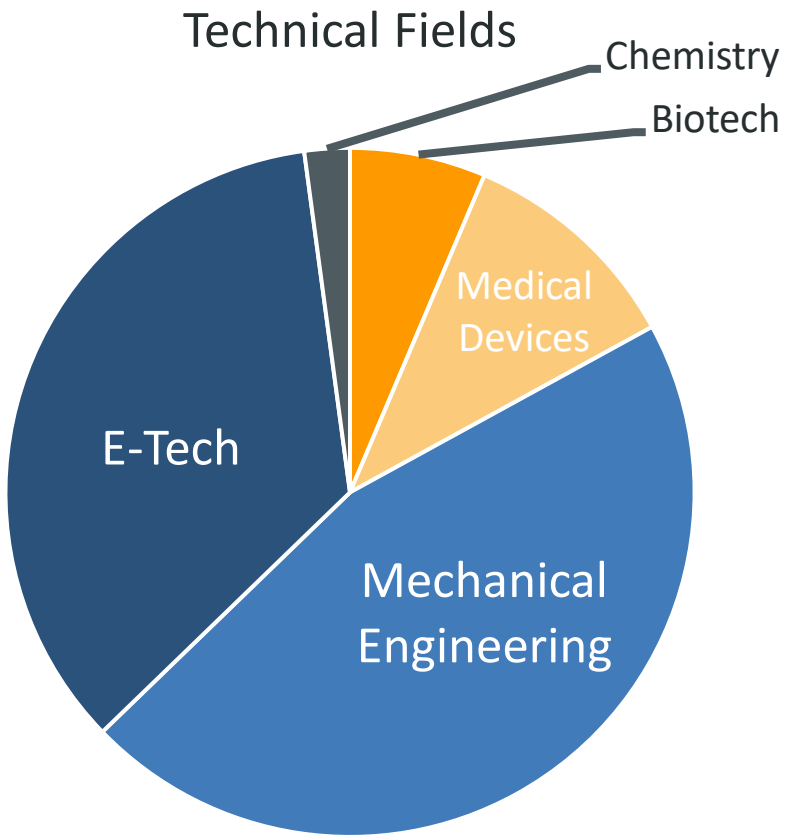
Only **22 revocation actions** have been filed compared to **67 infringement actions**

UPC proceedings (106; excl. revocation counterclaims)



The UPC deals with patents from all fields of technology

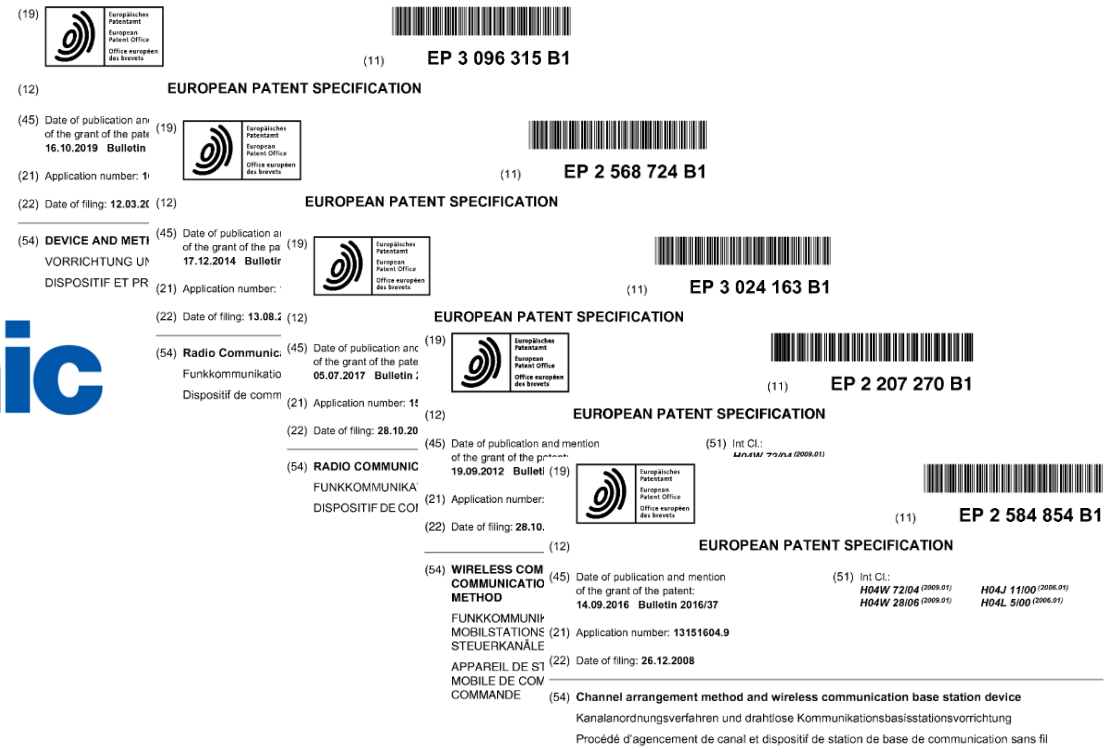
Two infringement actions are based on pharma patents, about **17%** are from IPC class A (human necessities)



SEP enforcement is still rare before the UPC

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

Panasonic



(19) Europäisches Patentamt / European Patent Office / Office européen des brevets

(11) EP 3 096 315 B1

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication an
of the grant of the pate
16.10.2019 Bulletin

(21) Application number: 1

(22) Date of filing: 12.03.2

(54) DEVICE AND METI
VORRICHTUNG UN
DISPOSITIF ET PR

(19) Europäisches Patentamt / European Patent Office / Office européen des brevets

(11) EP 2 568 724 B1

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication a
of the grant of the pa
17.12.2014 Bulletir

(21) Application number:

(22) Date of filing: 13.08.2

(54) Radio Communic
Funkkommunikatio
Dispositif de comm

(19) Europäisches Patentamt / European Patent Office / Office européen des brevets

(11) EP 3 024 163 B1

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication anc
of the grant of the pate
05.07.2017 Bulletin

(21) Application number: 1

(22) Date of filing: 28.10.20

(54) RADIO COMMUNIC
FUNKKOMMUNIKA
DISPOSITIF DE CO

(19) Europäisches Patentamt / European Patent Office / Office européen des brevets

(11) EP 2 207 270 B1

(12) EUROPEAN PATENT SPECIFICATION

(45) Date of publication and mention
of the grant of the pat
19.09.2012 Bulleti

(51) Int Cl.:

(21) Application number:

(22) Date of filing: 28.10.

(54) WIRELESS COM
COMMUNICATIO
METHOD
FUNKKOMMUNIK
MOBILSTATIONS
STEUERKANÄLE
APPAREIL DE ST
MOBILE DE COM
COMMANDE

(19) Europäisches Patentamt / European Patent Office / Office européen des brevets

(11) 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)

(21) Application number: 13151604.9

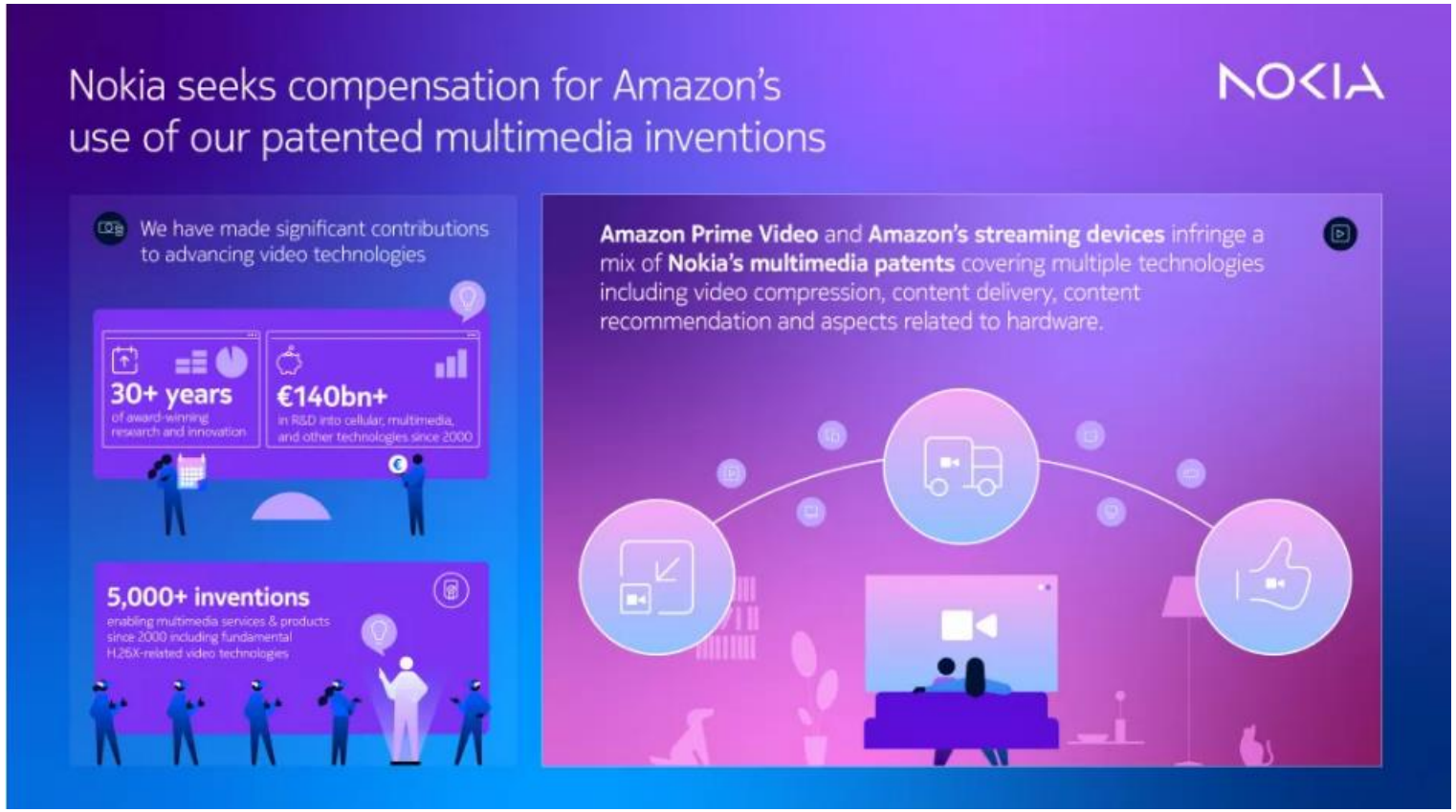
(22) Date of filing: 26.12.2008

(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

xiaomi

oppo

Another SEP owner is enforcing video-compression SEPs against **one implementer** at the LD Munich



The UPC has decided six PI proceedings, with mixed results

One *ex parte* provisional injunction (PI) granted; **three *inter partes* PIs** denied; **two *inter partes* PI** granted

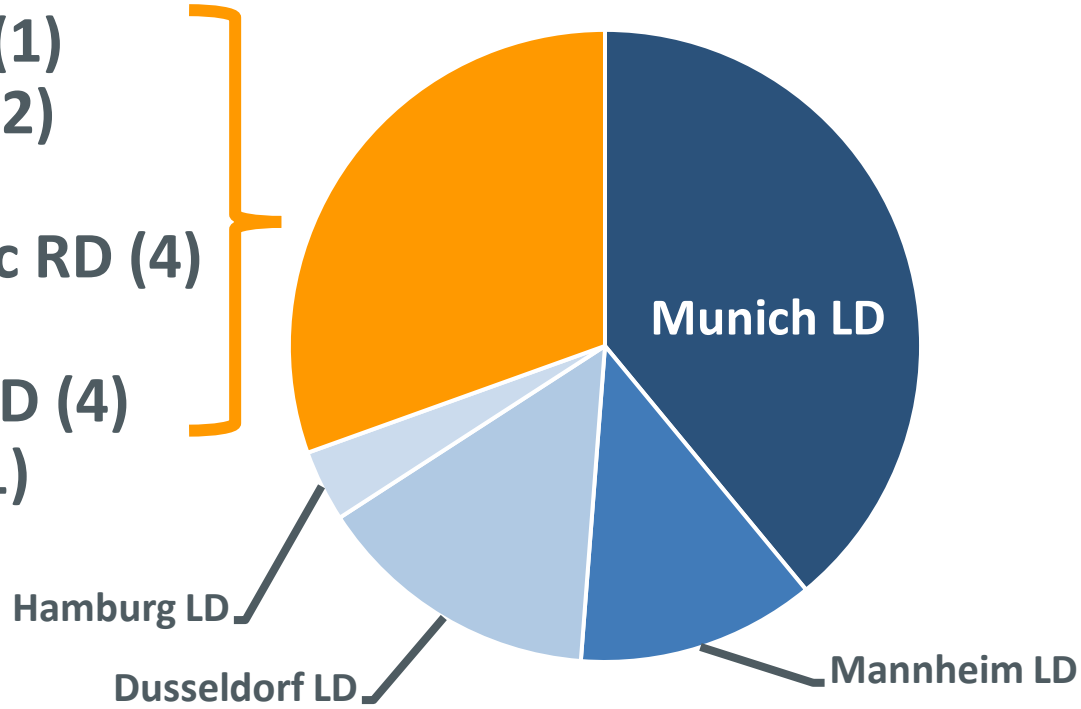
The German LDs have by far the most cases

⅔ of infringement proceedings filed at German LDs

Infringement actions (67)
+ Applications for PIs (17)

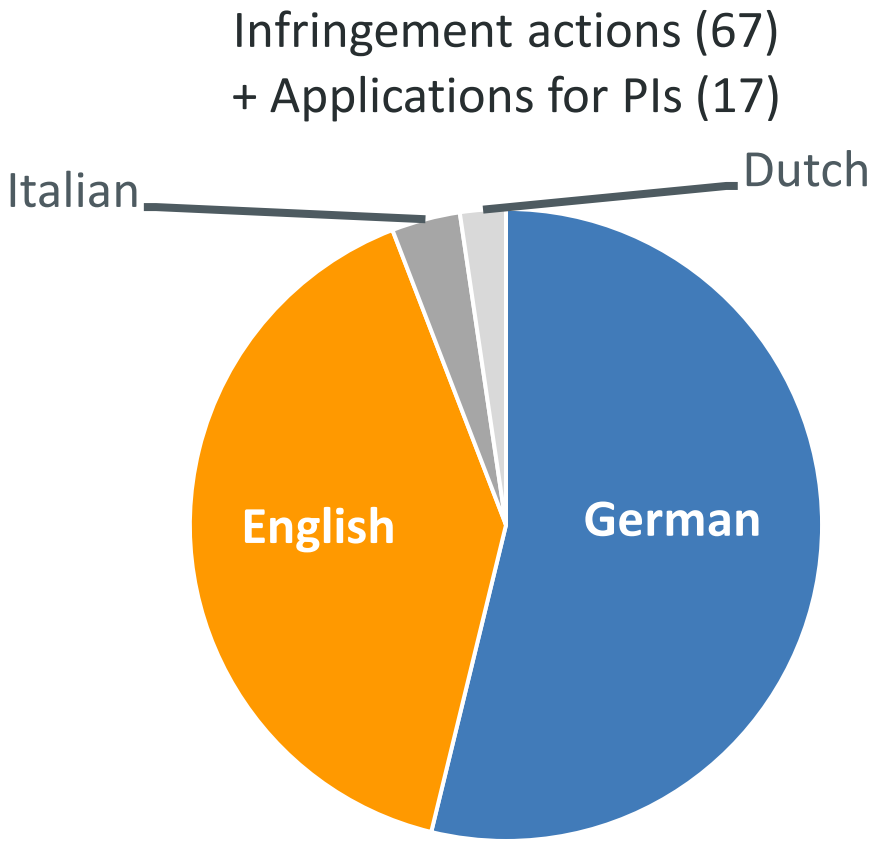
Other LD/RDs:

- **Brussels LD (1)**
- **Helsinki LD (2)**
- **Milan LD (7)**
- **Nordic-Baltic RD (4)**
- **Paris LD (6)**
- **The Hague LD (4)**
- **Vienna LD (1)**



German is the most widely used language,
but German LDs are beginning to handle more cases in English

So far, **German** is the **most widely used language** before the UPC, but **English** is **increasing steadily**



2. The first decisions & orders

What is the quality of the UPC so far?

10x Genomics v. NanoString

10x Genomics v. NanoString (PI Proceedings)

- Two patents on "*method(s) for detecting a plurality of analytes in a (cell or tissue) sample*"
  - EP 4 108 **782** B1 (EP-**UE**) granted on June 7, 2023 (EPO opposition pending)
  - EP 2 794 **928** B1 (EP) granted on February 20, 2019 (already enforced in Germany, nullity action pending)
- Hearings on September 5/6 and 19, 2023:
  - Four-judge panel: three LQJ (DE, DE, NL) and a TQJ (FR)
  - In-depth discussion of claim construction, infringement, and validity
  - Procedural issues: urgency, irreparable harm, auxiliary claims in PI proceedings
  - Legal issues: licensing relationship, US and European antitrust law, territorial scope of PI
- **Outcome: PI granted** for EP'782 (appeal pending), but **denied** for EP'928 (no appeal filed)

10x Genomics v. NanoString – Decision (EP'782)

EP'782 - Decision of September 19, 2023 (UPC_CFI_2/2023) – 113 pages

- PI **granted** against
  - Analytic system and
  - Specific supply components
- Enforcement is **not** subject to security by the Applicants
- Consequences:
  - NanoString's **stocks fall 13%** after the decision was announced → Financial markets monitor UPC activites
  - (Previous drop of 30% after decisions in main infringement proceedings in Germany in May 2023)

10x Genomics v. NanoString – Decision (EP'782)

- **Applicants' standing to sue**
  - Applicant 2) is the registered owner of the patent-in-suit, Art. 47(1) UPCA
  - Applicant 1) is (at least) a non-exclusive licensee
    - U.S. District Court Delaware: Commitment vis-à-vis NIH "to offer non-exclusive patent licenses"
    - Such a commitment would contradict an exclusive-licensee position
    - Non-exclusive licensee has standing to sue with permission of patent owner, Art. 47(3), (4) UPCA
    - PI application was filed by both applicants together

10x Genomics v. NanoString – Infringement of Claim 1 (EP'782)

– *A method for detecting a plurality of analytes in a cell or tissue sample, comprising: (a) mounting the cell or tissue sample on a solid support; (b) contacting the cell or tissue sample with a composition comprising a plurality of detection reagents, the plurality of detection reagents comprising a plurality of subpopulations of detection reagents; (c) incubating the cell or tissue sample together with the plurality of detection reagents for a sufficient amount of time to allow binding of the plurality of detection reagents to the analytes; wherein each subpopulation of the plurality of detection reagents targets a different analyte, wherein each of the plurality of detection reagents comprises: a probe reagent targeting an analyte of the plurality of analytes and one or a plurality of pre-determined subsequences, wherein the probe reagent and the one or the plurality of pre-determined subsequences are conjugated together; (d) detecting in a temporally-sequential manner the one or the plurality of pre-determined subsequences, wherein the detecting comprises: (i) hybridizing a set of decoder probes with a subsequence of the detection reagents, wherein the set of decoder probes comprises a plurality of subpopulations of decoder probes and wherein each subpopulation of the decoder probes comprises a detectable label, each detectable label producing a signal signature; (ii) detecting the signal signature produced by the hybridization of the set of decoder probes; (iii) removing the signal signature; and (iv) repeating (i) and (iii) using a different set of decoder probes to detect other subsequences of the detection reagents, thereby producing a temporal order of the signal signatures unique for each subpopulation of the plurality of detection reagents; and (e) using the temporal order of the signal signatures corresponding to the one or the plurality of the pre-determined subsequences of the detection reagent to identify a subpopulation of the detection reagents, thereby detecting the plurality of analytes in the cell or tissue sample.*

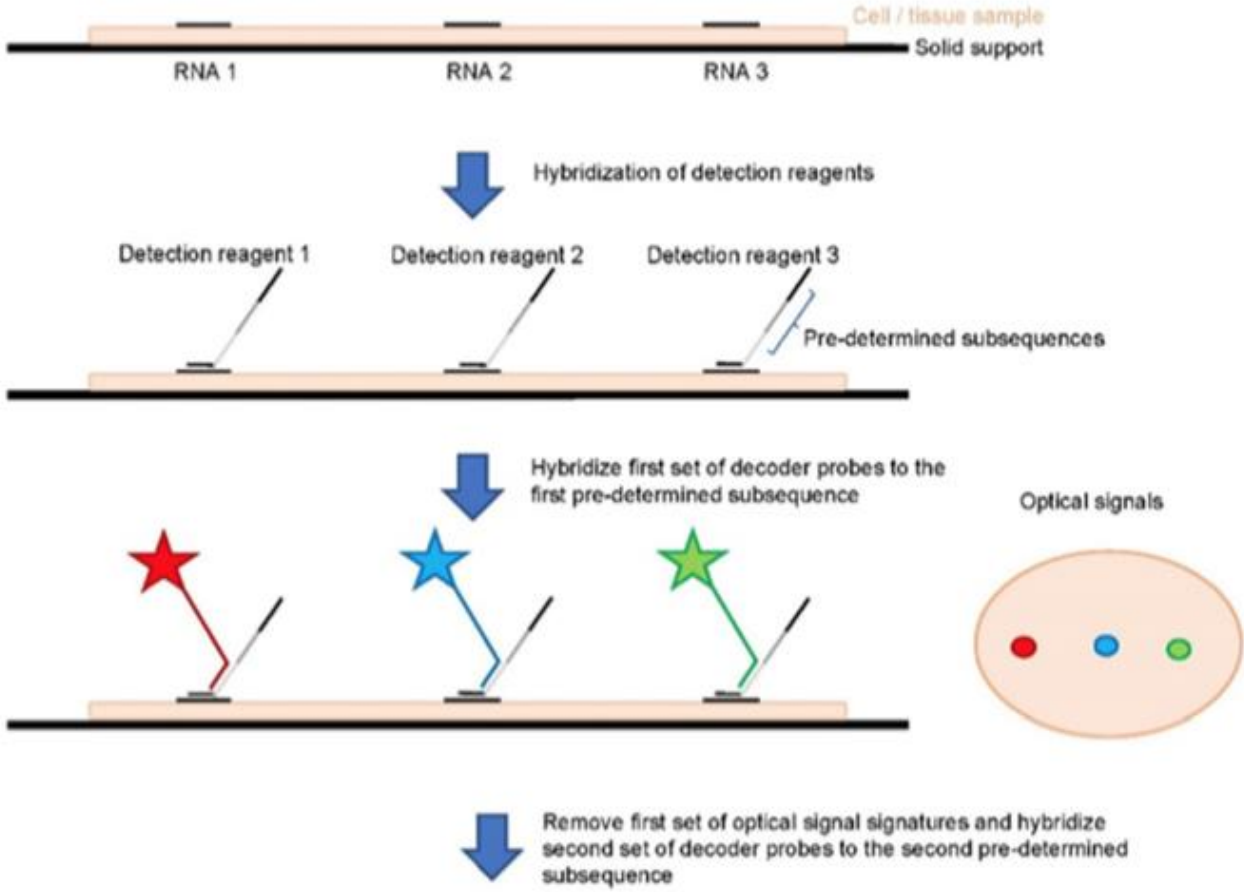
10x Genomics (EP'782) - Claim 1 simplified (Part I)

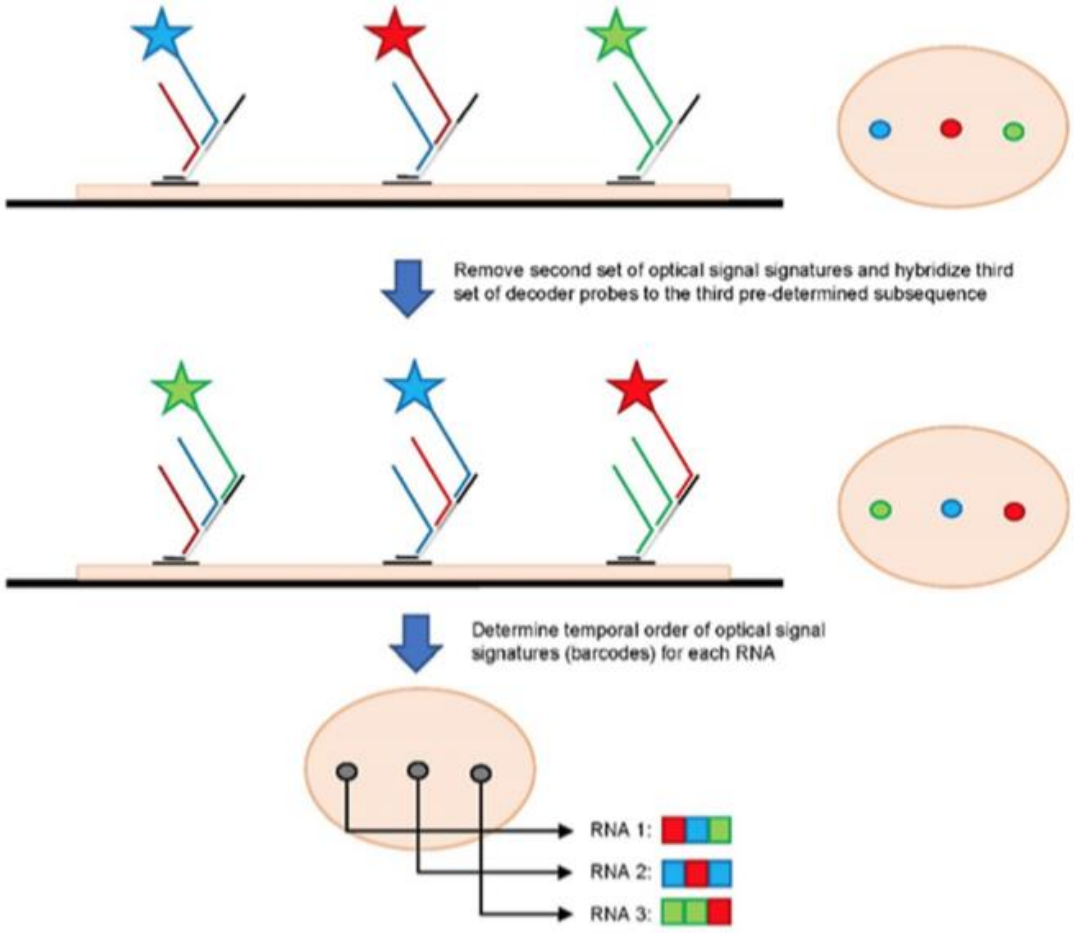
- *A method for detecting multiple analytes in a tissue sample, comprising:*
- *(a) mounting the tissue sample on a support;*
- *(b) contacting the tissue sample with several detection reagents, which comprise subpopulations of detection reagents;*
- *(c) incubating the tissue sample together with the detection reagents to allow binding of the detection reagents to the analytes; wherein each subpopulation of the detection reagents targets a different analyte, and wherein each of the detection reagents comprises: a probe reagent targeting an analyte and several pre-determined subsequences, which are conjugated together;*
- *(d) detecting in a temporally-sequential manner the pre-determined subsequences, wherein the detecting comprises:*

10x Genomics (EP'782) - Claim 1 simplified (Part II)

- *(d) detecting in a temporally-sequential manner the pre-determined subsequences, wherein the detecting comprises:*
  - *(i) hybridizing decoder probes with a subsequence of the detection reagents, wherein each of the decoder probes comprises a detectable label, each detectable label producing a signal signature;*
  - *(ii) detecting the signal signature produced by the hybridization of the set of decoder probes;*
  - *(iii) removing the signal signature; and*
  - *(iv) repeating (i) and (iii) using a different set of decoder probes to detect other subsequences of the detection reagents,* ***thereby producing a temporal order of the signal signatures unique*** *for each subpopulation of the plurality of detection reagents; and*
- *(e) using the temporal order of the signal signatures to identify a subpopulation of the detection reagents,* ***thereby detecting the plurality of analytes in the tissue sample****.*

10x Genomics (EP'782) - Claim 1 even more simplified





10x Genomics (EP’782) - What did Defendant do?

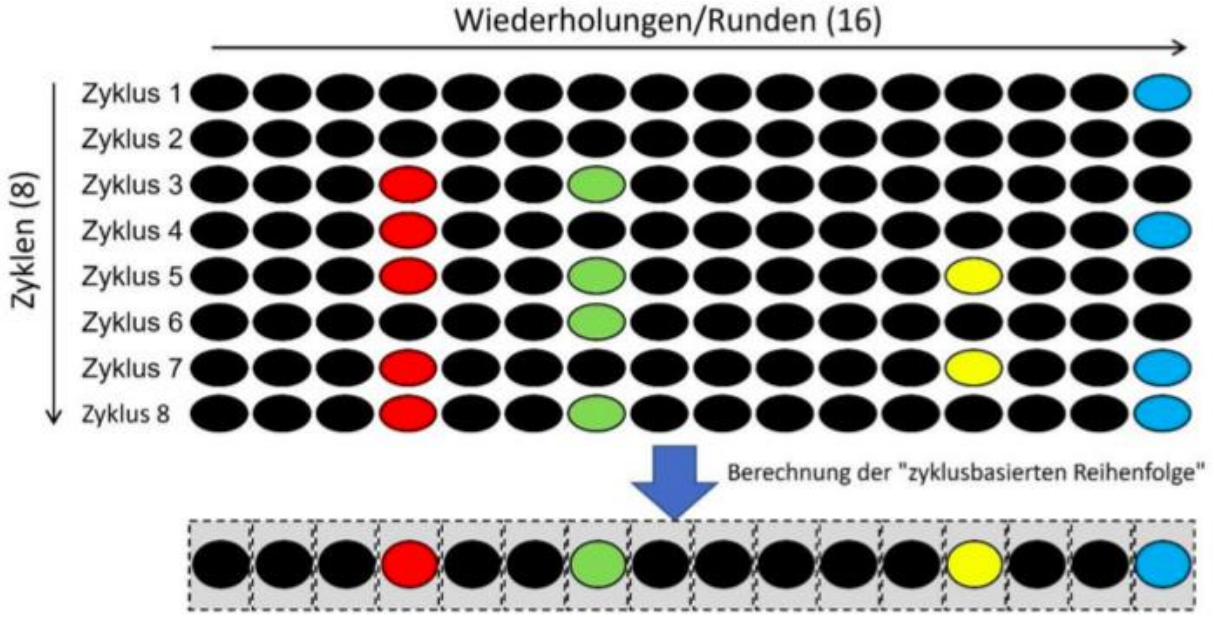


Abbildung 1: *Der Verletzungsgegenstand 1 CosMx™ Spatial Molecular Imager.*

10x Genomics v. NanoString – Decision (EP’782)

- **Infringement**
  - Patentee-friendly claim construction
  - Scope:
    - Direct infringement by offering analytic system, Art. 25(b) UPCA
    - Indirect infringement by offering supplies, Art. 26(1) UPCA
    - Injunction claim prevents only future infringement, past infringement do not have to be “undone”
  - Injunction can be worded according to the asserted patent claim, not limited to contested products

10x Genomics v. NanoString – Decision (EP'782)

- **Validity: Burden of Proof**
  - Guidance in the UPCA/Rules?
    - Art. 62(4) UPCA: *"The Court **may**, […], **require the applicant** to provide any reasonable evidence in order to satisfy itself with a sufficient degree of certainty that the **applicant is the right holder** […]."*
    - RoP 211.2: *"In taking its decision the Court **may require the applicant** to provide reasonable evidence to satisfy the Court with a sufficient degree of certainty […], that the **patent in question is valid** […]."*
  - But:
    - Art. 54 UPCA: *"[…] the burden of the proof of facts shall be on the **party relying on those facts**."*
    - Presumption of validity for granted EPs (*CJEU* C-44/21 – Phoenix Contact v. Harting) – CJEU decisions are binding on UPC (Art. 21 UPCA)
  - **Respondent bears burden of proof** regarding (lack of) validity

10x Genomics v. NanoString – Decision (EP'782)

- **Validity: threshold and assessment**
  - Guidance in UPCA/Rules
    - Art. 62(4) UPCA / RoP 211.2: "sufficient degree of certainty" regarding validity
    - RoP 209(2)(a): *"In exercising its discretion* […]*, the Court shall in particular take into account:*
      (a) whether ***the patent*** *has been upheld in an opposition procedure before the European Patent Office or has been the subject of proceedings in any other court;"*
  - Approach of the LD
    - General rules/statistics for or against validity are not relevant, case-by-case basis
    - Previous cases on patents from the family generally irrelevant
    - Standard adopted by LD: validity "**more likely than not**"
    - Significantly less strict as approach applied e.g. by German courts

10x Genomics v. NanoString – Decision (EP'782)

- **Validity: threshold**

> Insofar as the Defendants rely on the fact that, according to German case law on the prognosis of the validity of the patent in proceedings for provisional legal protection, the revocation of the patent does not have to be preponderantly likely, but only *possible* on the basis of the Defendant's revocation claim, this case law on national procedural rules is not relevant in the scope of application of the UPCA and the RoP.

10x Genomics v. NanoString – Decision (EP'782)

- **Balancing of Interests**
  - PI requires more than just a likelihood of future infringements
  - RoP 206(2)(c): *"the **reasons why provisional measures are necessary** to prevent a threatened infringement"*
  - **Urgency**
    - RoP 211(4): *"The Court shall have regard to any **unreasonable delay** in seeking provisional measures."*
  - **Other circumstances**
    - RoP 211(3): *"the Court shall in the exercise of its discretion **weigh up the interests of the parties** and, **in particular**, take into account the **potential harm for either of the parties** resulting from the granting or the refusal of the injunction."*
    - *Likelihood that patent will be upheld*

10x Genomics v. NanoString – Decision (EP’928)

EP’928: Decision of October 10, 2023 (UPC_CFI_17/2023) – 44 pages

- PI **denied** because
  - LD not convinced of infringement
  - LD not convinced of validity, because Federal Patent Court had opined that the unamended patent is invalid and because claimant's claim interpretation raised additional validity questions (added matter, extension of scope of protection)
- No appeal filed

10x Genomics v. NanoString – Claim 1 (EP'928)

– *A method for detecting a plurality of analytes in a sample, comprising: a. contacting the sample with a composition comprising a plurality of detection reagents, wherein each subpopulation of the detection reagents targets at least one different analyte, wherein the analyte is fixed on a solid substrate or support and wherein the solid substrate or support is a chip, a microarray, a blotting membrane or a microscopic slide, and wherein each detection reagent comprises: at least one probe reagent targeting an analyte and at least one nucleic acid label comprising a plurality of pre-determined subsequences, wherein said at least one probe reagent and said at least one nucleic acid label are conjugated together; and wherein at least a portion of said plurality of pre-determined subsequences form an identifier of said at least one probe reagent; b. removing any unbound detection reagents; c. detecting in a temporally-sequential manner said plurality of pre-determined subsequences of said detection reagent, wherein said detection of the subsequences comprises: i) hybridizing a set of decoder probes with a subsequence of the detection reagents, wherein each subpopulation of said decoder probes comprises an optical detectable label, each optical detectable label generating an optical signal signature corresponding to each subsequence; ii) detecting said optical signal signature produced upon the hybridization of said set of decoder probes and obtaining an image; iii) removing said optical signal signature produced by the hybridization of said set of decoder probes; iv) repeating steps (i) through (iii) for other subsequences of said detection reagents, thereby producing a temporal order of optical signal signatures corresponding to the plurality of pre-determined subsequences, wherein the temporal order of the optical signal signatures corresponding to said plurality of pre-determined subsequences of said detection reagent identifies a subpopulation of the detection reagents and is unique for each subpopulation of the detection reagents; and d. comparing said temporal order of the optical signal signatures with different identifiers of said at least one probe reagent, wherein an agreement between the temporal order of the optical signal signatures and a particular identifier of said at least one probe reagent identifies the analyte in the sample.*

10x Genomics – Claim 1 (EP'928) simplified

- *A method for detecting a plurality of analytes in a sample, comprising: a. contacting the sample with a composition comprising a plurality of detection reagents, (…) wherein each detection reagent comprises: at least one probe reagent targeting an analyte and at least one nucleic acid label comprising a plurality of pre-determined subsequences, wherein said at least one probe reagent and said at least one nucleic acid label are conjugated together; and wherein at least a portion of said plurality of pre-determined subsequences form an identifier of said at least one probe reagent; b. removing any unbound detection reagents; c. detecting in a temporally-sequential manner said plurality of pre-determined subsequences of said detection reagent (…)*

- **Claimant argued this is an obvious error in the language and should correctly read "form an identifier of the analyte"**

The Local Division was not convinced

- However, in the context of ordering **provisional measures**, it does **not** seem **sufficiently certain** to the local division to affirm a patent infringement on the basis of an **interpretation** of the patent claim that **deviates from the understanding conveyed by the wording** of the claim in connection with a specific embodiment. In particular,the interpretation must always be compatible with the requirements of Art. 69 EPC and its Protocol on Interpretation. Accordingly, the requirement of sufficient legal certainty for third parties must also be taken into account; as a rule, it may be expected that the applicant sufficiently clearly expresses that which he wants to claim.

10x Genomics v. NanoString – Takeaways

- UPC can handle even legally, technologically and commercially complex cases in PI proceedings with high quality
- No reluctance to issue PI with potentially long-lasting, disruptive effect on market shares
- Patentee friendly claim construction in the LD Munich
  - Stricter interpretation re EP'928 (PI denied) of little help to defendants
- Application of EPO case law
- Low chances for Respondent to win on “formalities”
- Joint action by patentee and licensee can avoid difficulties re standing to sue
- Generous approach regarding validity requirement in PI proceedings (“more likely than not”), however
- Comprehensive balancing of interests including validity (likelihood of revocation)

CUP&CINO v. Alpina

CUP&CINO v. Alpina – Facts

- PI request filed on June 27, 2023
  - **EP** 3 398 **487** B1: *“method/device for production of milk foam with adjustable temperature”*
  - Granted on March 9, 2022
  - Nullity action pending at Austrian Patent Office
- Hearing on September 13, 2023 before the **Vienna LD**:
  - Three-judge panel: three LQJ (AT, DE, NL), no technically qualified judge
  - Discussion of claim construction, infringement and validity (added matter, inventive step)
  - Procedural issues: ineffective opt-out and urgency
- **Outcome: PI denied**

CUP&CINO v. Alpina – Decision

Decision of September 29, 2023 (UPC_CFI_182/2023) – 20 pages:

- **Opt-out** was **ineffective**, filing a PI request, like filing a main action, prevents a later opt-out (so no problem)
  - RoP 5.6: *"In the event that **an action** has been commenced before the Court in respect of a patent* […] ***prior to the date of entry of the Application to opt out in the register*** […]*, **the Application to opt out shall be ineffective** in respect of the patent* […]*, irrespective of whether the action is pending or has been concluded."*
  - If an opt-out would be effective a PI could be withdrawn without the Court's permission contrary to RoP 265
- **Urgency** (only discussed during hearing)
  - Contested product is sold since 2019
  - Test purchase in March 2023
  - (Allegedly) important trade show in October 2023

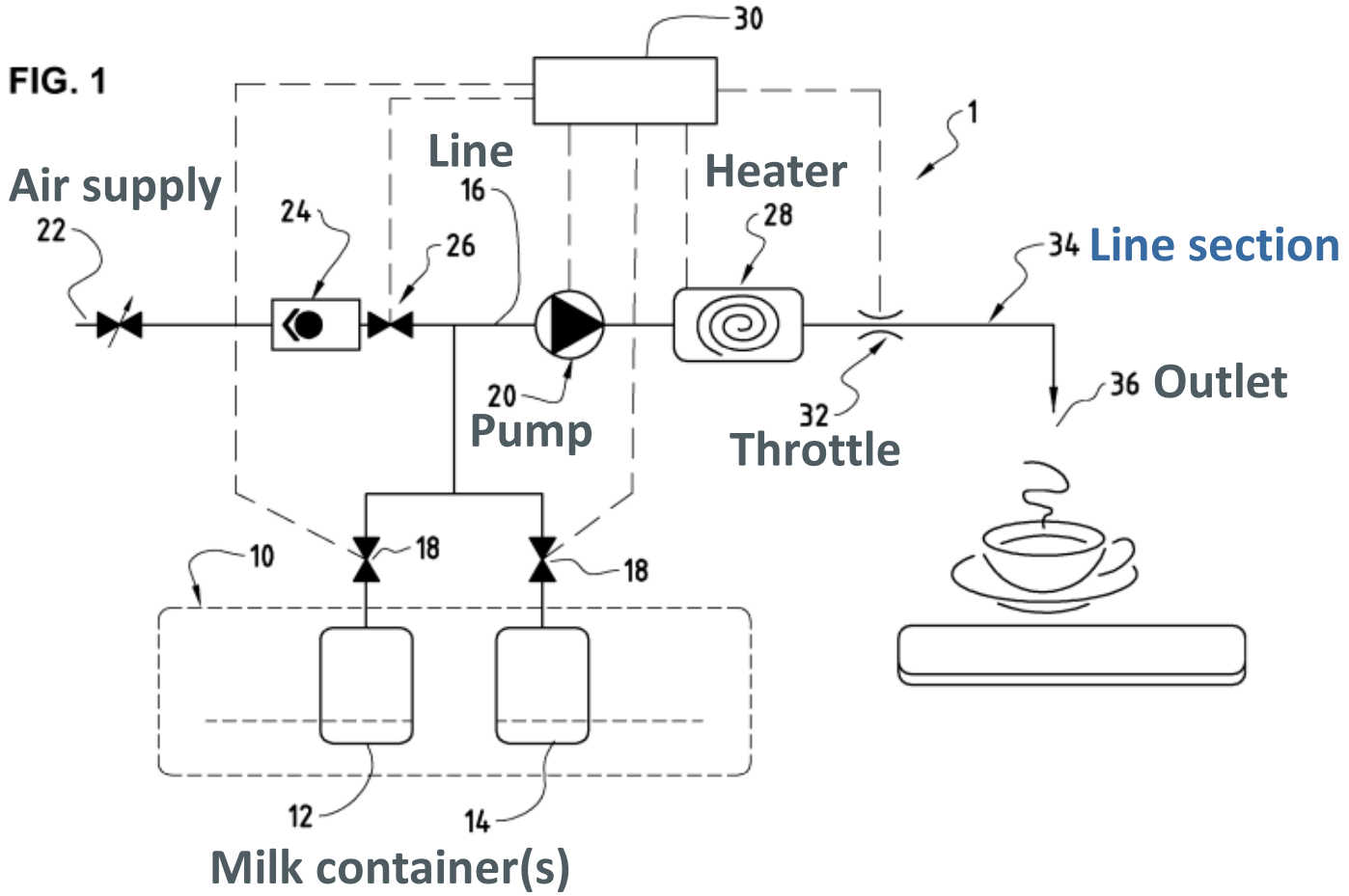
CUP&CINO v. Alpina – Decision

- Claim construction

Device (1) for production of milk foam

comprising a **pump** (20) for conveying milk from one container (12, 14) in line (16, 34) to an outlet (36), an **air supply** (22) for delivering air into the line (16), a continuous **flow heater** (28) and a **throttle device** (32),

characterized in that the **inner diameter of the line (16)** upstream and **of a line section (34)** downstream of the throttle device (32) are **different**.



CUP&CINO v. Alpina – Decision

- Claim construction (cont'd)

Device (1) for production of milk foam

comprising a **pump** (20) for conveying milk from one container (12, 14) in line (16, 34) to an outlet (36), an **air supply** (22) for delivering air into the line (16), a continuous **flow heater** (28) and a **throttle device** (32),

characterized in that the **inner diameter of the line (16)** upstream and **of a line section (34)** downstream of the throttle device (32) are **different**.

[0026] Erfindungsgemäss ist stromabwärts der Drosseleinrichtung ein Leitungsabschnitt vorgesehen, dessen Querschnitt und Länge bis zum Auslass derart gewählt ist, dass die Schaumqualität des Milchschaums verbessert wird. Dieser Leitungsabschnitt stellt eine Art Beruhigungsstrecke dar, in der die Luft in dem Milch-/Luftgemisch, welche zumindest teilweise noch in Form von grossen Blasen vorliegen kann, in feine Blasen dispergiert. Darüber hinaus beeinflusst der Leitungsab-

According to the invention a line section is provided is downstream of the throttle device, the cross section and length of which up to the outlet is selected so that the foam quality of the milk foam is improved. This line section represents a type of calming section in which the air in the milk/air mixture, which can at least partially still be in the form of large bubbles, is dispersed into fine bubbles.

CUP&CINO v. Alpina – Decision

– **Claim construction (cont'd)**

Device (1) for production of milk foam

comprising a **pump** (20) for conveying milk from one container (12, 14) in line (16, 34) to an outlet (36), an **air supply** (22) for delivering air into the line (16), a continuous **flow heater** (28) and a **throttle device** (32),

characterized in that the **inner diameter of the line (16)** upstream and **of a line section (34)** downstream of the throttle device (32) are **different**.

Patent description: (embodiments)

den ist. Die Länge des Leitungsabschnitts 34 liegt in einem Bereich von 0,5 bis 2 m, bevorzugt bei ca. 1,5 m.

The length of the line section 34 is in a range from 0.5 to 2 m, preferably around 1.5 m.

CUP&CINO v. Alpina – Decision

- **Claim construction (cont'd)**

8. Device (1) according to one of the claims 2 to 7, **characterized in that** a line section (34) with a length of 0.5 to 2 m to the outlet (36) is provided downstream of the throttle device (32).

  - Typically, if a dependent claim requires an additional feature (here: a certain length of the line section) the independent claim is construed to be broader and as that feature is not required by the independent claim.

CUP&CINO v. Alpina – Decision

- **No infringement:**
  - Claim 1 (process claim), no infringement alleged
  - Claim 2 (product claim) requires “a line section”
  - Based on a functional construction of this term according to the description the skilled person understands this “line section” to require a certain length, not necessarily within the range according to claim 8 but still with a certain minimum length not too far from to the lower end of the provided range starting at 50 cm
  - Contested embodiment has a line section of about 10 cm, too short to be a line section according to claim 2
- **Cost reimbursement** (provisional):
  - CUP&CINO (1 attorney-at-law, 1 patent attorney): EUR 21,800.-
  - Alpina (2 patent attorneys): EUR 25,600.-

CUP&CINO v. Alpina – Takeaways

- In non-complex matters, PI proceedings can be handled without a technically qualified judge
- Be prepared for unexpected events, develop a “plan B” in advance
  - If the PI request is denied, can you file a main action at a different LD/RD?
- Reasonable arguments on urgency are needed
- Live demonstrations in the hearing must be relevant and effective, judges will have limited patience otherwise

SES-imagotag v. Hanshow

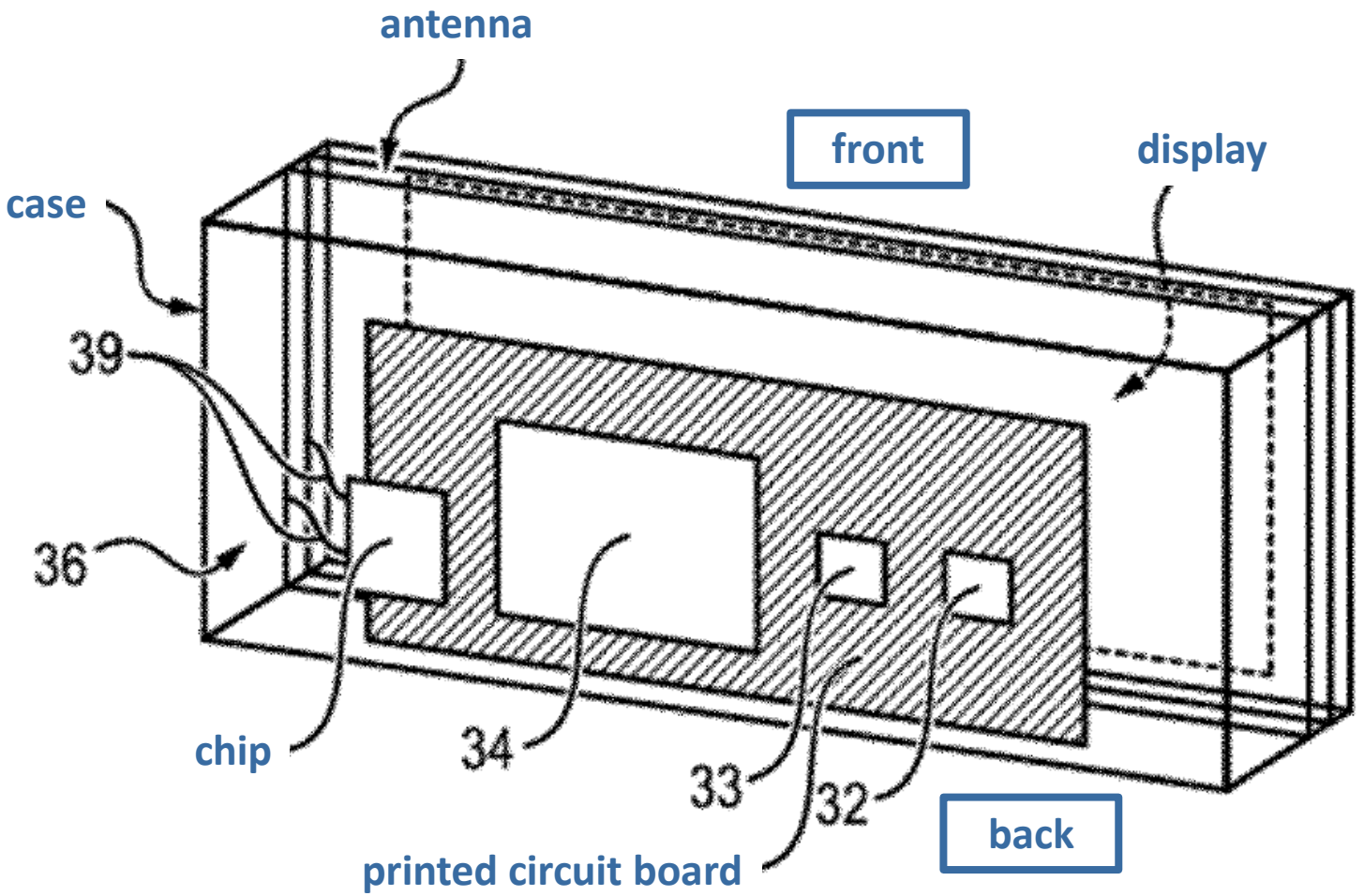
SES-imagotag v. Hanshow – Facts

- PI request filed on September 4, 2023
  - **EP** 3 883 **277** B1 (**EP-UE**): *“electronic label for sales area with a series of distributed electronic labels”*
  - Granted on August 9, 2023
  - Opt-out filed on April 28, 2023 but withdrawn on August 29, 2023 together with a request for unitary effect
  - Hanshow filed a protective letter on August 10, 2023
- Hearing on November 28, 2023 before the **Munich LD**:
  - Four-judge panel: three LQJ (DE, DE, NL) and a TQJ (DE)
  - Discussion of claim construction, infringement and validity
  - Procedural issues: costs of protective letter
- **Outcome: PI denied**

SES-imagotag v. Hanshow – Claim 1

- [1] *Electronic label for sales area with a series of distributed electronic labels,* [1.1] *each electronic label being identified by a unique label identifier specific to it, comprising:* [2] *a* ***radio frequency communication module*** […]; [3] *a* ***memory*** […]; [4] *a* ***display screen*** […]; [5] *a* ***microcontroller*** […]; [6] *a* ***case****;*
- [7] *a* ***printed circuit board*** *housed in the case on the side of the* ***back of the case*** *and* [7.1] *on which are arranged the radio frequency communication module, the memory and the microcontroller;*
- [8] *a* ***radio frequency device*** […], [8.1] *the radio frequency device comprising an antenna and an electronic chip* […], [8.2] […], [8.3] *the electronic* ***chip*** *of the radio frequency device being disposed on the printed circuit board and* [8.4] *the* ***antenna*** *of the radio frequency device being disposed on or in the housing on the side of the* ***front of said electronic label****.*

SES-imagotag v. Hanshow – Figure 3

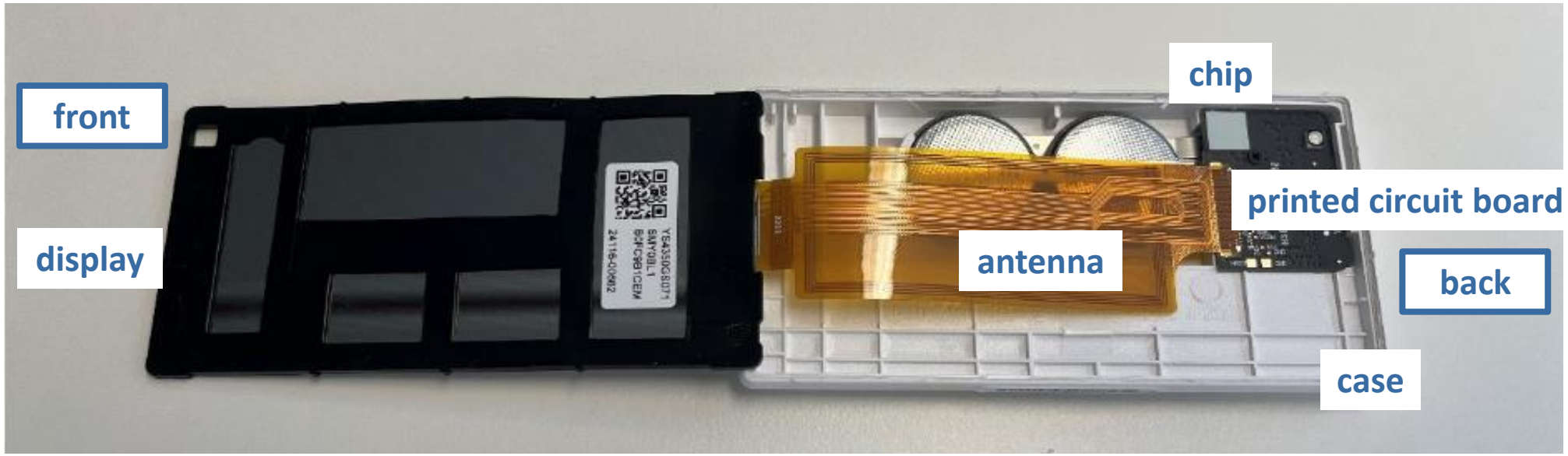


SES-imagotag v. Hanshow – Decision

Decision of December 20, 2023 (UPC_CFI_292/2023) – 26 pages:

- **Claim construction:**
  - Relationship between the arrangement of (a) the "*printed circuit board with the electronic chip of the radio frequency device"* and (b) the "*antenna"*
  - Patent requires that the printed circuit board with the **chip** of the radio frequency device is "on the side of the **back** of the case" whereas the **antenna** is "*on or in the housing on the side of the **front***"
  - For interpreting the claims, the original claim language in the application and changes during prosecution can be considered
    - [8.4] "*the antenna of the radio frequency device ~~being spaced apart~~ being disposed on or in the housing on the side of the front of said electronic label*"
  - Patent wants to separate chip and antenna to reduce interferences

SES-imagotag v. Hanshow – Contested product



SES-imagotag v. Hanshow – Decision

- **No infringement:**
  - The back side of the display is not the front side of the case, the front is the frame holding the display
  - The antenna cannot be – at the same time – on the front and back side, it is on one or the other side
  - At least part of the antenna contacts the inner wall of the **back** side of the case and is thus, not "*on or in the housing on the side of the **front** of said electronic label*" as required by claim 1

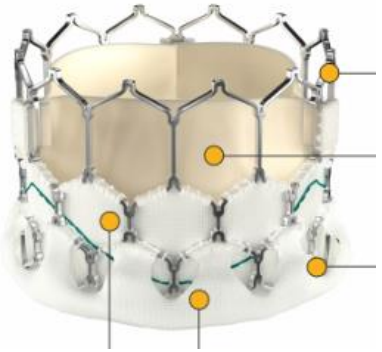
SES-imagotag v. Hanshow – Takeaways

- Protective letters can be help preventing a PI (or at least trigger further briefings and a hearing)
  - But a protective letter with weak or no arguments on certain points can backfire!
- Considering the prosecution history for claim interpretation is different from the approach of national courts
- With a good strategy, a patent can first be opted-out to prevent a UPC revocation actions and then be enforced

Meril (IT) v. Edwards

Meril (IT) v. Edwards

Meril (IT) v. Edwards – Facts



- EP 3 646 825 (Edwards): "*A prosthetic valve (for aortic valve)*"
- June 1, 2023: Edwards files infringement action against Meril Life Sciences Pvt. Ltd. and Meril GmbH (DE subsidiary) at the **LD Munich.**
- August 4, 2023: Meril Italy srl (IT subsidiary, founded in March 2023) files stand-alone revocation action with **CD Paris.**
  - Edwards files a Preliminary Objection (PO) on September 14, 2023 on the grounds that
    - Meril should have filed revocation counterclaim with LD Munich instead because of pending infringement action.
- Hearing October 26, 2023: **PO rejected** by judge-rapporteur Paolo Catallozzi
- Written decision issued November 13, 2023.

Meril (IT) v. Edwards – Decision

- Art. 33(4) UPCA
  - "[Revocation actions] *shall be brought before the central division. If, however, an* [Infringement action] *between the* ***same parties*** *relating to the same patent has been brought before a local or a regional division,* [a revocation action] *may only be brought before the same local or regional division.*"
- General principle: revocation actions shall be brought before the CD. The CD has the "primary role" as the judge of the revocation actions. Art. 33(4) is a **narrow exception**.
- Meril IT (subsidiary) is not "the same party" as Meril IN (parent) or Meril DE in terms of Art. 33(4) UPCA:
  - A "party" must be defined in accordance with national law (Italian law in that case) pursuant to Art. 46 UPCA -> Meril Italy Srl can be considered a party.
  - Literal interpretation: Meril IT is a **different legal entity** from Meril IN and Meril DE.
  - CJEU decision on "same parties" in Art. 29 Brussels I Regulation (recast) where "interests are identical" not applicable as the UPCA has autonomous rules for parallel proceedings
  - No evidence that Meril IT is acting as a "strawman" (fictitious entity) for infringement defendant Meril IN
- "Two shots" to invalidate the patent can be avoided if LD/RD refers revocation counterclaim to the CD, Art. 33(3) UPCA

Meril (IT) v. Edwards – Takeaways

- The concept of “the same parties” according to Art. 33(4) UPCA is interpreted narrowly; different members of the same company group do not qualify as “the same parties".
- Defendants can challenge validity before the CD even if infringement action is pending by having the revocation action filed by a different entity.
- Time of filing revocation action is less critical.
- UPCA offers mechanisms to avoid conflicting decisions: A counterclaim for revocation brought in an infringement action before a LD/RC can be referred to the central division (Article 33 UPCA).

Amgen v. Sanofi & Regeneron (Court of Appeal)

Amgen v. Sanofi & Regeneron (Court of Appeal)

- Infringement action filed on June 1, 2023
  - EP 3 666 797 B1: *"A monoclonal antibody* […] *for use in treating or preventing hypercholesterolemia* […]"
  - **No exhibits** filed with the Statement of claim
- **Effect on timelines** if the exhibits are filed later
  - RoP 13.2 : "*The claimant shall at the same time supply a copy of each of the* ***documents referred to*** *in the Statement of claim.*"
  - **LD Munich**: Exhibits not relevant for defendant's response terms
  - **CoA**: Statement of claim *can* be validly served without exhibits.
    - BUT: defendant's terms are extended so as to begin only upon service of the exhibits

Amgen v. Sanofi & Regeneron (Court of Appeal)

Takeaways:

- “Interlocutory appeals” (with LD/RD’s leave, RoP 220.2) ensure fast harmonization of procedure
- Court of Appeal applies common sense, efficient procedure and is time-sensitivety
- If service is needed outside the EU (or on many defendants): you can serve without exhibits, which should be uploaded ASAP after service

3. Strategic aspects

What lessons can be learned from the first decisions and orders?

Which strategies may patentees and competitors want to use in the future?

Decisions infringement and validity by different UPC divisions

- Before the start of the UPC there was a concern that “bifurcated” proceedings allow patentees to enforce injunctions before the defendant can invalidate the patent ("window of opportunity")
- Now, potential defendants wish to attack the patents (also) before the CD – *they* seem to prefer bifurcation
- Once an infringement action is pending, the UPCA gives the accused infringer **two options** for attacking validity:
  - filing a revocation counterclaim and/or
  - filing a (standalone) revocation action
  - **both** have to be filed **before the same LD/RD** where the infringement action is pending
- A **third option** could be filing a (standalone) revocation action by another entity which is not a defendant in the infringement action (the **Paris CD** has accepted this approach, position of the Munich CD and the CoA unclear)

Infringement and revocation actions before different UPC divisions

- Options under the UPCA, if infringement and revocation actions are pending before different divisions:
  - **LD/RD** can **stay the infringement action** pending the outcome of the revocation action, RoP 295(m)
  - **Panels** agree to **hear both actions together**, RoP 340 (subject to Art. 33 UPCA)
  - **Parties** agree to **transfer the infringement action to the CD,** Art. 33(7) UPCA

Accused infringer: file **preemptive revocation action** at the CD

- Expectation: (some) LDs/RDs may be more patentee-friendly than the CD; chosen by patentee
- Approach: **“Be first”** with the validity attack
- Potential advantage by filing a preemptive revocation action at the CD
- After an infringement action has been filed, a revocation action (between the same parties) can only be filed at the same LD/RD; limited forum shopping opportunity for revocation claimants
- If a patentee opts-out, file a national (nullity) action to prevent a withdrawal of the opt-out (RoP 5.8)

Patentee: prevent/circumvent a revocation action at the CD

- Expectation: A revocation action at the CD can make patent enforcement more difficult
- Approach 1: **“Be first”**
  - File the infringement action at a LD/RD before a revocation action has been filed
- Approach 2: **“Be bold”**
  - Request a provisional injunction
- Approach 3: **“Eat the cake and have it too” – having it both ways**
  - Opt-out the patent to avoid a UPC revocation action at the CD; then withdraw opt-out and immediately start infringement action before UPC LD/RD
  - Risk: withdrawal of an opt-out is precluded if national action has been started
  - Counter measure: Upgrade patent to EP-UE with “opt-in effect”, which is not precluded by a national action (cf. RoP 5.9, Art. 3(a), 83), possible up to one month after grant (cf. Art. 9.1(g) EU UPP Reg., R 6 EPO RUPP)

Thank you!

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