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# Two and a Half Years of the UPC – trends and turning points

## January 2026

Welcome to our latest briefing, in which we look back at Unified Patent Court (**UPC**) developments in the last six months (July to December 2025) since our last briefing (The UPC Two Years On – published July 2025) and consider what this increasingly well-established jurisdiction may offer us in 2026.

We start by looking at some of the key issues which may be resolved by the UPC Court of Appeal in 2026 before considering what will be new in the UPC system in 2026. We then review the success of the unitary patent and set out some statistics on the UPC's first two and a half years in operation and shine a spotlight on SEP and FRAND issues before providing more detailed updates on specific developments across UPC topics including jurisdiction, validity, infringement, injunctions and various important procedural matters. In the last few pages of this briefing we set out a reminder of some key issues relating to unitary patents and UPC litigation which are worth keeping in mind in IP transactions.

## Issues for the UPC Court of Appeal in 2026

The Court of Appeal (**CoA**) of the UPC was busy in 2025, dealing with many key aspects of law and procedure. The growing number of CoA decisions providing definitive guidance on key issues is of great assistance to all stakeholders involved in or contemplating UPC litigation as it helps to increase predictability.

### The true extent of extra-territorial ("long-arm") jurisdiction

The past year has seen a striking expansion of the Unified Patent Court's approach to jurisdiction, marking the rise of the UPC's application of its "long-arm" jurisdiction. This development has been supported by the CJEU's judgment in *BSH Hausgeräte v Electrolux* (***BSH***) which reshaped the landscape for cross-border patent enforcement in Europe. *BSH* permits EU-domiciled defendants to be sued in their home courts for their alleged infringement of patents granted in other countries (whether EU Member States or not). The decision states that while validity cannot be raised in defence in relation to patents granted in EU/Lugano states, it can be decided *inter partes* as part of a defence to infringement for patents granted elsewhere.

The UPC has adopted the *BSH* reasoning, applying it to take jurisdiction over alleged infringements occurring both inside and outside UPC participating states, though only in relation to EPs (as the UPC does not have jurisdiction over other national patents). Recent first-instance decisions — such as *Fujifilm v Kodak, HL Display v Black Sheep Retail,* and *Dyson v Dreame* — show the court asserting jurisdiction over a defendant domiciled in a UPC territory in relation to infringing acts taking place in any country in which the patentee has an EP in force (whether or not a UPC participating country).

In other cases, the UPC has found that it has jurisdiction to hear such extra-territorial infringement actions against a defendant which is not domiciled in a UPC participating country, provided that the defendant has a sufficiently "close connection" to another "anchor" defendant in the case which is domiciled in a UPC participating country (see e.g. *Dyson v Dreame*). Further, even if all of the defendants are domiciled outside the UPC, then the UPC has concluded that it can take extraterritorial jurisdiction if damage is deemed to arise within a Member State, as illustrated in *Hurom v NUC Electronics*. The Paris Division's ruling in *KEEEX v Adobe, OpenAI and Ors* confirms that online availability alone may suffice to create the necessary territorial link.

These trends underscore the UPC's willingness to interpret its jurisdiction expansively, but they also highlight the provisional nature of the current jurisprudence, which to date consists only of first instance rulings. As questions regarding the commercial connection of defendants required to loop them all into an action and the reach of UPC's jurisdiction into non-UPC territories continue to be brought before the courts of first instance (CFI), we expected these important issues to reach the CoA before long. This will provide an opportunity for the CoA to harmonise the approach and define the proper boundaries of the UPC's extra-territorial competence.

*See further discussion of the impact of BSH on the UPC at section 1.*

### A universal approach to the doctrine of equivalence?

As discussed in further detail in section 11, different approaches have been adopted in the UPC regarding the Doctrine of Equivalents in the absence of any specific test being set out in the UPCA. Notable cases include *Plant-e v Arkyne*, November 2024, in which The Hague Local Division (**LD**) applied a four step test based on the approach of the Dutch national courts, by agreement of the parties, and *Raccords,* October 2025, in which the Paris LD advocated for a 'harmonised' approach melding together the essence of the various national tests. This is a prime area for guidance from the CoA in 2026, given the right opportunity.

### Jurisdiction to determine FRAND licence terms?

FRAND disputes continue to play out before courts worldwide and parties have been considering the role that the UPC can play in such campaigns. In the FRAND disputes before the UPC that have reached a final decision to date, the UPC courts have taken an approach in line with the German national courts, resulting in a finding that the implementer had not acted as a willing licensee and ordering an injunction without assessing what would be appropriate FRAND licence terms.

In *Sun Patent Trust v Vivo Mobile Communication Co. and others* at first instance the Paris LD held that the UPC has jurisdiction to hear Sun's request for a determination of FRAND licence terms alongside its claim for infringement. This is unusual as, so far, the request for determination of such terms has come from the implementer, whereas Sun is the SEP holder in that case. It is an open question as to whether the UPC has jurisdiction to do this in the way that some national courts commonly do (most notably China and the UK). The CoA is expected to give its views on this in the appeal question during 2026 (it has already refused a stay of the main proceedings pending the outcome of the appeal (UPC_CoA_904/2025, UPC_CoA_905/2025, 27 November 2025)).

*See more on SEPs and FRAND at the UPC on page 5.*

## New for 2026

**More Appeal Judges:** The increasing workload of the CoA has triggered the appointment of a third panel of judges, which is welcome. The new panel will begin hearing cases from January 2026. Concerns that the different CoA panels could issue diverging decisions on key issues have been alleviated by two recent decisions on inventive step issued by the CoA (*Amgen v Sanofi-Aventis/ Regeneron* UPC_CoA_528/2024 and UPC_CoA_529/2024 and *Edwards v Meril* (UPC_CoA_464/2024 et al) – 25 November 2025). While each case was decided by a different CoA panel, it is notable that the CoA had aligned the timing of the decisions, handing both down on the same day. The decisions both set out the UPC's approach to inventive step in near identical terms, making it clear that the CoA is willing to take a pragmatic approach behind the scenes to ensure coordination and consistency on key legal principles.

The new legally qualified judges for the CoA are:

**Panel 3:**

- Ms Ulrike Voß (DE) (previously presiding judge at the UPC's Court of First Instance in the Munich LD and CD)
- Mr Bart van den Broek (NL) (an IP litigator specialising in both national and international patent litigation)
- Ms Nathalie Sabotier (FR) (a French Cour de Cassation magistrate)

The first and second panels of the CoA are comprised as follows:

**Panel 1:**

- Klaus Grabinski (DE), President of the Court of Appeal
- Peter Blok (NL), legally qualified judge and judge-rapporteur
- Emmanuel Gougé (FR), legally qualified judge

**Panel 2:**

- Rian Kalden (NL), presiding judge and judge-rapporteur
- Patricia Rombach (DE), legally qualified judge
- Ingeborg Simonsson (SE), legally qualified judge

**The UPC's Patent Mediation and Arbitration Centre (PMAC):** The PMAC is due to commence operation in Q2 2026 with the inauguration ceremony recently announced as 2 June 2026, following the formal adoption of the Mediation, Arbitration and Expert Determination Rules which is expected February 2026. The ceremony will take place in Ljublijana, one of the two official seats of the PMAC (the other being Lisbon). Once it commences operations, the PMAC will offer specialised patent dispute resolution for disputes within the UPC's jurisdiction through mediation and arbitration.

Draft mediation and arbitration rules have already been published following a series of consultations. Under the draft rules, the UPC cannot compel parties to go to PMAC arbitration/mediation, it can only recommend that they do so. However, parties to a dispute can also refer themselves for mediation/arbitration by agreement at any stage (including pre-action), without the need for any intervention from the UPC (though, if the parties agree, it may stay any active litigation while the PMAC process is followed through).

The first round of applications for positions as arbitrators or mediators closed on 10 October 2025 and the second round will open early in 2026. The Director (currently Mr Aleš Zalar) and the Expert Committee of PMAC will meet at least once a year to establish and maintain a list of qualified arbitrators, mediators and expert determinators to act in PMAC arbitrations/mediations.

## The success of the unitary patent so far

In December 2025, the EPO published its contribution to the European Commission's forthcoming report on the Unitary Patent (UP) system, which is due for submission to the European Parliament and the Council of the European Union by June 2026 as required by the UP Regulation. The EPO concludes that the UP package has been "a markedly strong success", achieving the core objectives identified during its development phase.

Evidence of the success of the UP is visible in the proportion of European patents being converted to UPs by patentees after grant.

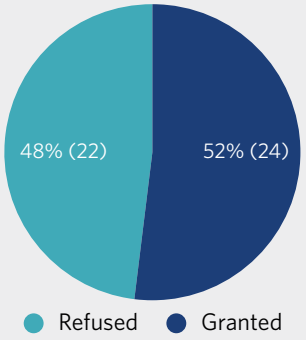
- In 2023, its first six months of operation, the EPO received 17,254 requests for unitary effect, representing 17.5% of all EPs granted in that period.
- By the end of 2025 the number of requests had surpassed 78,000, an uptake of 28.3% – so more than a quarter of all EPs granted in 2025 have been converted to UPs.
- Uptake has been even stronger amongst patentees from the EU, with around 40% of granted EPs being converted to UPs in 2025. In total 39.5% of all applications from patentees based in all the EPC states were converted to UPs.
- Geographically, in 2025 around 60% of UP proprietors are located in the EPC Contracting States. UP proprietors from the United States make up around 16%, while those from Japan, South Korea and China account for around 15%.
- Uptake of UPs by Small and Medium Enterprises (SMEs), universities and public research organisations has been strong, with such users accounting for around 40% of all UPs annually. 66% of European SMEs holding a European patent have requested registration of unitary effect since the system came into effect.

## UPC statistics (June 2023 to December 2025)

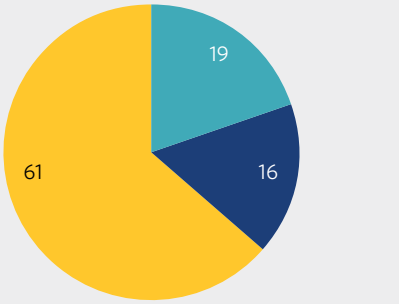
We set out below some statistics for the UPC, showing cumulative figures from the commencement of the UPC on 1 June 2023 to December 2025.

The Preliminary injunction (**PI**) decisions chart represents final results of PI applications, incorporating decisions on appeal. There have been 15 appeals of PIs decisions to date, two of which were still awaiting decision by the CoA at the time of writing. Of those 13 appeals decided, there were: six where the CoA overturned the first instance decision (one where the CoA refused a PI which had been granted at first instance, and five where the PI was granted by the CoA having been refused by the CFI), and seven where the CoA confirmed the first instance decisions on appeal (four where the CoA upheld a refusal and three where it upheld the grant of a PI).

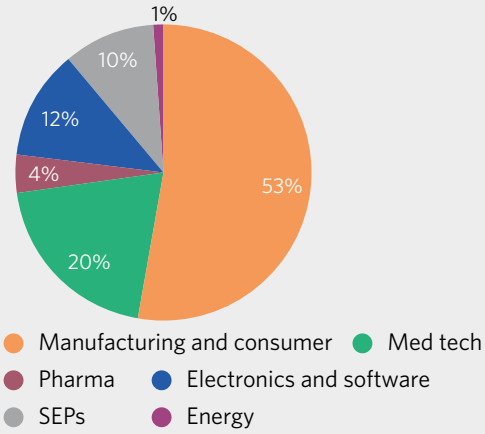
**Preliminary injunction decisions**



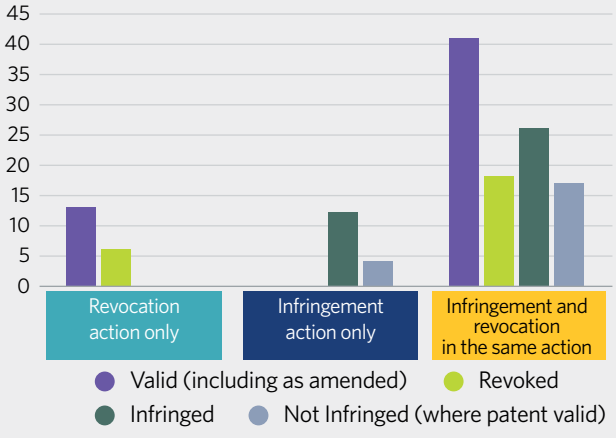

**Decisions on the merits (numbers)**



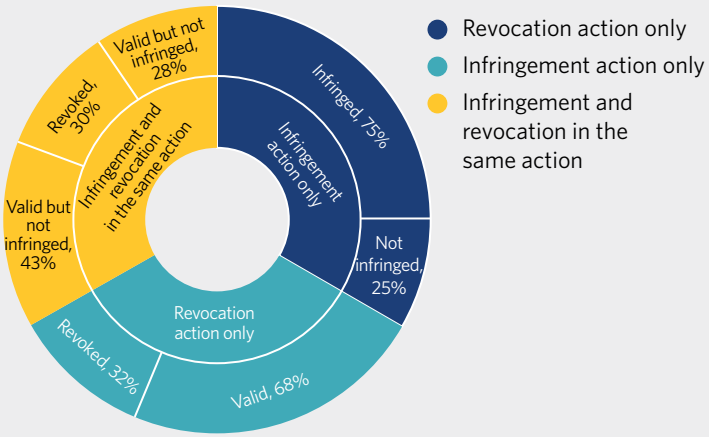

**Decisions on the merits by sector**




**Decisions on the merits – outcomes**




**Decisions on the merits – outcomes**




Only nine decisions on the merits have been appealed (around 10%). Of these, two appeals are currently pending, one was withdrawn, and six have reached a final decision from the CoA.

Of those six which have been decided on appeal:

- in two appeals the CoA overturned the decision of the CFI – resulting in one patent that was held valid and infringed at the CFI being found invalid by the CoA, and one patent revoked at the CFI being held valid by the CoA; and
- in four appeal the decisions of the CFI were upheld: two as valid and infringed, one as revoked (a counterclaim) and one revoked in a standalone revocation action.

## SEPs & FRAND

### FRAND licence determinations

As discussed above, one of the most significant recent developments in FRAND at the UPC is the confirmation in *Sun Patent Trust v Vivo Mobile Communication Co.* from the Paris LD that the UPC has jurisdiction to determine FRAND licence terms. While there had been much commentary outside the court to suggest it should in principle be possible to seek such determinations from the UPC, this is the first confirmation from the court itself that it is willing to do so. If the UPC CoA confirms the UPC's jurisdiction this will shift the already complex landscape of multi-jurisdictional SEP disputes.

One key question that arises out of this decision is how precisely the UPC will go about determining FRAND licence terms, and how proactive the court will be in setting the terms of the licence itself. In the UK, the licence determination is based on disclosure of a substantial number of comparable licences and a significant amount of expert evidence, including cross-examination of experts and fact witnesses at trial. The UPC has been operating on much tighter timeframes to get to judgment and has not so far relied on expert evidence in the same way as the UK. This will be an interesting case to watch as it unfolds, including whether the ultimate determination is seen to be more favourable to the SEP holder or implementer.

If a licence determination is ultimately perceived as more favourable to implementers, that leads to the question of whether implementers can seek their own licence determinations in UPC – whether as a defence to infringement proceedings or even in a standalone action.

### Anti-interim licence injunctions

The past few months have seen friction between the UPC and UK national courts. Over the past year or so the UK courts have developed an approach of making interim licence declarations prior to a final FRAND trial to determine licence terms. Such interim declarations have been seen by some to step on the toes of other national courts as they have resulted in proceedings outside the UK terminating when the parties agree to enter into an interim licence.

This came to a head in proceedings between Amazon and InterDigital in which both the UPC and German national courts ordered so called 'anti-interim licence injunctions' on an *ex parte* basis, preventing Amazon from seeking interim licence declarations in the UK. The UK courts responded with an anti-suit injunction preventing InterDigital from interfering with the final UK FRAND determination, but the anti-interim licence injunction remained in place in that case.

The position further developed when Warner Brothers obtained an anti-anti-suit injunction against Nokia in the UK preventing Nokia from seeking anti-interim licence relief elsewhere, including in the UPC. It remains to be seen how the award of anti-interim licence injunctions will work itself out between the UK, the UPC and other courts, but it seems clear that a race to filing and judgment will remain a key component of multi-jurisdictional FRAND disputes.

### Confidentiality

There have been a number of UPC decisions on confidentiality in SEP disputes over the past several months. The UPC now has a relatively well-established practice of ordering disclosure of certain relevant licences subject to confidentiality restrictions. This typically includes limiting access to the confidential material to certain named individuals within the parties to the proceedings.

In proceedings involving Ericsson and Sun Patent Trust the SEP holders had requested that licences be disclosed on an 'external eyes only' basis – essentially preventing anyone within the implementers from accessing the confidential material. This was rejected at first instance, with the courts allowing access to named individuals, but is under appeal. Interestingly Apple (as counterparty to some of the licences) has sought to intervene in the appeals to support the position that the licences should be disclosed on an 'external eyes only' basis. It remains to be seen whether such outside counsel eyes only confidentiality arrangements are permissible in the UPC.

### EU SEP regulation

One final issue to watch for on the horizon is the potential return of regulation of SEP licensing by the European Union. Proposals to regulate in this area were previously shelved by the European Commission but the European Parliament has recently taken the unusual step of taking legal action against the Commission in relation to its decision to withdraw the regulation. While any regulation is likely to take some years to work its way through the system (if the outcome is indeed regulation at all), it does have the potential to significantly impact the operation of the UPC in relation to SEP disputes and so developments in this area are well worth monitoring.

*David Webb*

## Specific developments

### Jurisdiction



### Validity



### Claim interpretation



### Infringement



### Preliminary injunctions



### Final (Permanent) injunctions



### Liability of Directors



### Gathering Evidence



### Stays



### References to the CJEU



### Practice points



In our last briefing (The UPC Two Years On – published July 2025), as well as the topics we look at in this edition, we also reviewed the UPC's approach to claim construction, criteria for PIs, jurisdiction and opt-out, jurisdiction over pre-UPC infringement and damages and the applicable law, stays and suspensive effect, access to pleadings, security and more, much of which is now well established, but do look back at that briefing and our earlier ones linked within it, if you need a reminder.

## Jurisdiction

### 1. The CJEU decision in *BSH v Electrolux* and the UPC's international jurisdiction

2025 could have been termed "the year of the 'long-arm'", with the UPC exercising its "extra-territorial" jurisdiction in relation to defendants and the infringement of European patent (EP) designations in countries that are outside the UPC territory, and the CJEU's decision in *BSH Hausgeräte v Electrolux* (C-399/22) adding to the UPC's jurisdiction and that of all EU national patent courts.

In February 2025, the CJEU gave judgment in *BSH Hausgeräte v Electrolux* (***BSH***), deciding that where a defendant is domiciled in an EU Member State, that defendant can be sued:

- in the national courts of that Member State for infringement of a patent granted in another EU Member State, but the defendant cannot raise invalidity as a defence in those proceedings (it must do so in a separate revocation action before the courts of the Member State in which the patent was granted), giving rise to the possibility of cross-border 'injunction gaps'; and
- in the national courts of that Member State for infringement of patents granted in third states (ie any non-EU country) and, in contrast to the above, in these circumstances the defendant can raise invalidity as a defence in those proceedings (the Court will decide the issue *inter partes,* ie only to resolve the dispute between the parties before it, without having any effect on the validity of the patent itself), provided that no international treaties prevent it from doing so.

This represented a change from the position following the CJEU's 2006 decision in *GAT v LuK,* pursuant to which EU national courts had been required to stay any cross-border patent actions in their entirety as soon as validity was put in issue.

A robust recent illustration of the impact of this new era of cross-border relief in the EU national courts is the Munich Regional Court's award to Regeneron of a preliminary injunction over Formycon's aflibercept formulation in 22 countries within the EU, applying the CJEU's *BSH* reasoning. Separately, Onesta (an NPE) brought three infringement actions against BMW in the Munich court in relation to automobile technology concerning acts of manufacture in Germany but also sales in the US, which Onesta claims infringe its US patents. This was followed by a Texas court issuing a temporary restraining order against Onesta pending the determination of a request by BMW for an anti-suit injunction to prevent Onesta from pursuing infringement claims on US patents overseas.

While the *BSH* case was decided in the context of European national courts, it also applies to the UPC (though only in relation to European Patents, not those granted in third states). The court was quick to adopt the principles of the *BSH* decision into its jurisdictional assessments, adding to its confidence in taking jurisdiction over cases involving the infringement of European Patents stemming from countries which are not UPC signatory states. We discussed the early impact of this in our briefing six months ago, The UPC Two Years On. Since then there has been a marked increase in instances of the UPC taking "extra-territorial" (or "long-arm") jurisdiction, in a range of circumstances:

- the UPC continues to confirm that it has jurisdiction to decide cases involving a defendant domiciled in a UPC territory in relation to infringing acts taking place in any country in which the patentee has an EP in force (whether or not a UPC participating country) – this is a relatively straightforward case of extraterritorial jurisdiction following the fact pattern of the decision in *BSH* – see for example:
  - *Fujifilm v Kodak* (UPC_CFI_365/2023, 18 July 2025) in which the Mannheim LD ordered a permanent injunction in relation to the infringement of a European Patent in the UK by three defendants all domiciled in Germany;
  - *HL Display v Black Sheep Retail* (UPC_CFI_386/2024, UPC_CFI_610/2024, 10 October 2025) in which the Hague LD ordered a permanent injunction in relation to the infringement of a European Patent in the UK, Switzerland, Norway, Poland and Ireland by a defendant domiciled in the Netherlands;
- in addition, the UPC has found that it has jurisdiction to hear such extra-territorial infringement actions against a defendant which is *not* domiciled in a UPC participating country, provided that the defendant has a sufficiently "close connection" to another defendant in the case which *is* domiciled in a UPC participating country (a so-called "anchor defendant", based on an application of Art. 8(1) of the Brussels Regulation Recast (Reg. 1215/2012 as amended)) – see for example:
  - *Dyson v Dreame* (UPC_CFI_387/2025, 14 August 2025) in which the Hamburg LD held that it had jurisdiction to hear a case involving a Hong Kong-domiciled Dreame entity in relation to allegations of infringement of an EP in both the UPC countries and in Spain (remember that Spain is not a UPC member state) by virtue of that Dreame entity's "close connection" to a German-based "anchor defendant"

Eurep, Dreame's European Authorised Representative (which was also found to be infringing the EP in the same countries);

- finally, the UPC has also decided that it has jurisdiction to hear extra-territorial infringement actions even where *none* of the defendants in the case are domiciled in a UPC participating country, provided that the damage arising from the act of infringement occurred in a UPC participating country – see for example:
  - *Hurom v NUC Electronics* (UPC_CFI_162/2024, 2 October 2025) in which the Mannheim LD decided that it had jurisdiction over the sole defendant in the case (domiciled in Korea), in relation to allegations that it had infringed an EP in Spain, Poland and the UK (none of which are UPC participating countries), on the basis that the defendant shipped the allegedly infringing products to (thereby potentially giving rise to damage in) Poland, Spain and the UK via its German subsidiary and its French distributor; and
  - *KEEEX v Adobe, OpenAI and Ors* (UPC_CFI_530/2025, 27 November 2025) in which the Paris LD rejected preliminary objections raised by the defendants regarding international jurisdiction, deciding that it did have jurisdiction over the defendants in that case (all of whom were domiciled in Ireland or the US) in relation to allegations that they had infringed an EP in the UPC participating countries and also in Ireland, Norway, Poland, Spain, Switzerland and the UK, on the basis that the digital tools alleged to infringe KEEEX's EP were made available via the internet on websites accessible in (thereby potentially giving rise to damage in) France.

It can be seen that the UPC is continuing the general trend established over its first two years of operation, namely that it is generally keen to establish jurisdiction over as wide a range of cases as possible. It should be noted, however, that these issues have only been determined in first instance decisions at the time of writing. The scope of the UPC's extra-territorial jurisdiction (ie the question of exactly how far its 'long arm' really does reach) is likely to be a hot topic for the CoA during 2026 and one which could, in the right circumstances, necessitate a referral to the CJEU given that it revolves around questions of interpretation of the Brussels Regulation.

## 2. Previous national proceedings and *res judicata*

In October 2025, the UPC CoA granted a permanent injunction to Philips in disputes with various Belkin entities (3 October 2025, UPC_CoA_534/2024, 19/2025 and 683/224). However, this was a more complex decision than it might first appear, as Philips had previously brought an infringement action in relation to the DE designation of the EP against two of the Belkin defendants (Belkin GmbH and Belkin Ltd) in the German national court (Düsseldorf), where the patent had already been found not to be infringed. A question therefore arose over the extent to which the prior German national decision would prevent the UPC hearing the case.

The UPC CoA concluded, having regard to German law, that only the "*legal consequence*" of the German case (ie the finding that Belkin GmbH and Belkin Ltd did not infringe the German part of the EP) was *res judicata*, not the "*the reasons underlying the operative part and thus the interpretation of the patent*". The CoA noted that the UPC was being asked to assess a different factual and legal situation to that considered by the Düsseldorf court. This meant that the UPC was free to consider and come to its own conclusions on:

- the interpretation of the patent (including the German part of the EP);
- infringement of the German part of the EP by Belkin International (as it had not been party to the previous German proceedings); and
- infringement of all other parts of the EP which were in issue (XYZ) by all three Belkin entities.

The CoA expressly dismissed an argument from Belkin that Art. 34 of the UPCA, read in combination with Art. 36 the Brussels I Regulation, required that an interpretation of a patent which is binding on one Member State must be applied to all Contracting States in which the contested patent is in force. In doing so, it made clear that the *res judicata* doctrine should be narrowly applied. It ultimately concluded in the case before it that the EP was infringed by Belkin International in all countries and by Belkin GmbH and Ltd in all countries other than Germany, issuing an injunction accordingly.

## 3. Patentees are free to decide who and where to sue under the UPCA

In *Barco v Yealink* (UPC_CoA_317/2025, UPC_CoA_376/2025, 28 November 2025) the UPC CoA has made it clear that the question of which UPC divisions are competent to hear a given case at first instance is one which is governed by the UPCA alone. As it is a matter internal to the UPC, it is not subject to provisions of the Brussels Regulation (which in this context is concerned only with jurisdictional questions as between national courts and the UPC as a whole).

The CoA dismissed an argument from Yealink that a patentee is required to seek information and try to sue a distributor if the infringer itself is domiciled outside the UPC Contracting Member States. The CoA confirmed that a patentee is free to decide against whom to bring proceedings and where to do so, in accordance with Art 33(1) – there is no 'hierarchy' which means a patentee is required to try to sue in the court of the state of domicile of the defendant (Art 33(1)(b)) in preference to the court of the state where damage has occurred or is likely to (Art 33(1)(a) UPCA).

The CoA then dealt with the question of whether competence under Art. 33(1)(a) UPCA must be established separately for each defendant, based on their individual alleged acts of infringement in the territory of the LD. The CoA held that there is no need to look for connecting factors in the territory of the LD seised in relation to each defendant to establish competence: "*To determine competence under Art. 33(1)(a) UPCA, the existence of infringing activities, for example an offer or the possibility to obtain the allegedly infringing devices through a website accessible in the Contracting Member State hosting the local division, needs to be established*".

The CoA noted that the assessment of competence by a first instance division "*shall be made on the hypothetical assumption that the facts brought forward by the claimant or applicant are correct*" and it is for the defendant to raise a preliminary objection at that stage if it disagrees. Consistent with this, there will not be a comprehensive evaluation of the evidence by the first instance divisions. Instead, "*the Court will take a cursory look at the parties' allegations and evidence as provided, if any*".

## 4. Same parties and straw people: strategic implications

Two cases so far have challenged the character of parties bringing revocation actions, questioning whether they were really different parties to those already involved as defendants in infringement actions that were already on foot in the UPC. This has important strategic implications, because the UPC rules on internal competence (Art. 33(4)) dictate that a subsequent revocation action between the "same parties" must be brought as a counterclaim to the infringement action before the LD. If, however, the action does not involve the "same parties" then the revocation action must be brought in the central division (**CD**). A stand-alone revocation action may proceed more quickly at the CD than the infringement action before the LD. A stand-alone revocation action may also allow the revoking party to take positions less encumbered by 'squeezes' with any defence to infringement that would arise in a counterclaim.

The recent decisions of the CoA in *Meril v Edwards and* the Paris CD in *Seoul Viosys v Emporia UK and Ireland Ltd* (see below) both suggest that only rarely will the UPC find that two separate entities are the "same party" this context.

***Meril v Edwards* (CoA):** In *Meril v Edwards* (UPC_CoA_464/2024 et al, 25 November 2025), Edwards had sued Meril India and Meril Germany in the Munich LD for patent infringement. Meril Italy subsequently brought a stand-alone revocation action in the Paris CD (in relation to the same patent alleged to be infringed in the Munich LD action). This revocation action was challenged by Edwards who argued that that Meril India and Meril Italy were in effect the "same party", so the CD should decline to hear the revocation action which should instead be brought as a counterclaim to the infringement proceedings before the LD.

The Paris CD disagreed with Edwards and found that Meril Italy was entitled to proceed with its standalone revocation action (UPC_CFI_255/2023). On appeal, the CoA upheld the CD's decision, finding that the concept of the "same parties" must be understood as requiring the parties to be identical.

The CoA held that the requirements of Art. 33(4) UPCA were not met in the Meril case. It found that Meril Italy was not the same legal

entity as Meril India or Meril Germany and that: "*There is not such a degree of identity between their interests that a judgment delivered against one of them would have the force of res judicata as against the other*". In coming to this conclusion, the CoA considered that it was relevant that Meril Italy was established before the commencement of the infringement action and had a proper function (running the business of distributing Meril's products in Italy). The CoA concluded that Meril Italy therefore had a legitimate interest of its own in bringing a revocation action in anticipation of Edwards' potential actions against Meril Italy. It dismissed Edwards' arguments that this was inconsistent with the fact that Meril Italy was a wholly owned subsidiary of Meril India, with its only officers/employees being also Meril India employees, with no independent office in Italy (only a registered address corresponding to an accounting firm), and which did not appear to be a commercial concern and had only been formed in March 2023.

Whilst acknowledging that this interpretation could result in fragmentation of the proceedings, the CoA reminded the parties that the UPCA and UPC Rules of Procedure (**RoP**) offer the Court a number of instruments to mitigate this disadvantage, eg by referring the counterclaims for revocation to the CD (Art. 33(3)(b) UPCA), as the Munich LD had done in the infringement proceedings.

***Seoul Viosys v Emporia* (CD):** Seoul Viosys had sued expert klein GmbH for patent infringement before the Dusseldorf LD and expert klein responded with a counterclaim for revocation in those proceedings. The LD's decision was that there was infringement and the court dismissed the revocation counterclaim. expert appealed the latter finding.

Subsequently, Emporia UK and Ireland Ltd. filed a stand-alone revocation action in relation to the same patent at the Paris CD. Emporia was the supplier of the embodiment accused and ex-pert klein was its distributor. Seoul Viosys claimed that Emporia was acting as a "straw company" for the defendants in the parallel infringement proceedings in the LD, in particular in relation to expert klein GmbH – and that they should be considered the "same party".

In this decision of the Paris CD (UPC_CFI_258/2025 1 September 2025), handed down prior to the CoA ruling in the *Meril* case above, the CD held that the "straw company" theory may be relevant for the purpose of assessing the "same parties" element under Article 33 (4) UPCA. However, in the CD's view, the fact that two companies have concerted a common procedural strategy to defend against an infringement action is not sufficient to establish that the company involved in the second proceeding acted as a "straw company" for (and is the same party as) the company involved in the first.

The CD dismissed arguments that the two parties were the same on the basis that they were represented by the same legal counsels in the two proceedings, that the Emporia parent company demonstrated detailed knowledge of the litigation involving expert klein GmbH from the outset, that the attacks on the patent's validity raised by the two companies in their respective proceedings were substantially overlapping and that expert klein GmbH requested a stay of the proceedings pending before the CoA in view of the filing of the revocation action. The CD held that these factors may be considered indicative of a coordination of the two companies' litigation strategies, but they did not constitute proof that Emporia UK and Ireland Ltd. was created or used as a nominee for expert klein GmbH to carry out specific initiatives concerning exclusively the latter's business activities. The fact that the two companies resorted to substantially overlapping defence strategies did not mean that they were not conducting autonomous business activities or pursuing their own interests, even if, in this case, those interests converged in challenging the patent claimed by the applicant. "*Indeed*", said the Paris CD, "*from a business standpoint, it is entirely reasonable for a distributor facing an action for patent infringement to inform its supplier and for them to coordinate their defensive strategies, including in judicial proceedings*".

Although handed down before the CoA ruling in the *Meril* case, the Paris CD's decision seems very much in keeping with the narrow approach to the interpretation of the 'same parties' requirement which the CoA has since adopted.

In any case, the appeal from the Dusseldorf LD's decision to dismiss the revocation counterclaim brought by expert, was successful and the CoA revoked Seoul Viosys's patent for added matter (*expert e-Commerce GmbH and another v Seoul Viosys Co., Ltd* UPC_CoA_764/2024 & UPC_CoA_774/2024, 2 October 2025) – see Added Matter at section 6 below.

## Validity

### 5. The Court of Appeal's approach to inventive step

In two recent decisions, *Amgen v Sanofi-Aventis/Regeneron* (UPC_CoA_528/2024 and UPC_CoA_529/2024) (relating to antigen binding proteins) and *Edwards v Meril* (UPC_CoA_464/2024 et al) (relating to heart valves) both given on 25 November 2025, the CoA has set out the principles to be applied in the consideration of inventive step.

The CoA panels summarised their starting point as follows:

*"National courts of the various EPC countries have different approaches and use different guidelines when assessing whether an invention involves an inventive step. One of those approaches is the so-called 'problem-solution-approach' used by the European Patent Office (EPO) and the Technical Boards of Appeal (TBA) of the EPO. In some jurisdictions, such as France, Italy, The Netherlands and Sweden, this approach is applied as well, but not necessarily as the only possible approach. In other jurisdictions, such as Germany and the UK, other approaches – sometimes referred to as more 'holistic' – are used. Despite the differences in approach, all of these are just guidelines to assist in the establishment of inventive step as required by Art. 56 EPC, that, when properly applied, should and generally do lead to the same conclusion."*

As mentioned in the introduction to this briefing, the CoA issued these two decisions in tandem, significantly, with clearly stated principles re interpretation of inventive step. There is an identification of the problem to be solved (like the problem-solution approach at the EPO) but it is clear that the single best piece of prior art starting point is not in play at the UPC – instead it is stated that there can be multiple realistic starting points, but each much be inventive. The decisions went on to set out the following overarching principles to be applied when assessing inventive step, drawing on the previous decision in *Nanostring*:

- The burden of proof in establishing that the invention is obvious lies on the party arguing that the patent is invalid.
- The first step of the analysis is to establish the object of the invention, ie the objective problem to be solved. This must be assessed from the perspective of the skilled person, with their common general knowledge as at the application or priority date of the patent. The aim is to establish what the invention adds to the state of the art (the inventive concept) by examining the claim as a whole in the context of the description and the drawings and considering the technical effect that the skilled person understands is achieved by the claimed invention from their reading of the patent application.
- In order to avoid hindsight, the objective problem should not contain pointers to the claimed solution.
- The claimed solution is obvious if, at the relevant date, the skilled person wishing to solve the objective problem and starting from a realistic starting point in the state of the art in the relevant field of technology would (not only could) have arrived at the claimed solution.
- The relevant field of technology is the field relevant to the objective problem to be solved as well as any field in which the same or similar problem arises and of which the person skilled in the art of the specific field must be expected to be aware.
- A starting point is realistic if its teaching would have been of interest to a skilled person who, at the relevant date, wished to solve the objective problem (for example where the relevant piece of prior art discloses several features similar to those relevant to the invention as claimed and/or addresses the same or a similar underlying problem as that of the claimed invention).
- As the skilled person has no inventive skills and no imagination, they will only take a step in the direction of the claimed invention if there is a pointer or motivation to do so. A claimed solution will generally be obvious if the skilled person would (not just could) take a step prompted by a pointer, or as a matter of routine, and arrive at the claimed invention.
- There can be more than one realistic starting point and the claimed invention must be inventive starting from each of them. There is, therefore, no requirement to identify and limit the arguments to a single piece of prior art, ie the closest prior art, as there is before the EPO.

In the *Amgen* case, the CoA stated that a claimed solution is obvious if the skilled person would have taken the next step in expectation of finding a solution to the technical problem identified, which will generally be the case where the results of the next step were clearly predictable or where there was a reasonable expectation of success.

In considering what is required for a reasonable expectation of success in this context, the CoA held that:

- A reasonable expectation of success implies the ability of the skilled person to predict rationally, on the basis of scientific appraisal of the known facts before a research project was started, that the project would be concluded successfully within acceptable time limits.
- Whether there is a reasonable expectation of success depends on the circumstances of the case.
  - The more unexplored a technical field of research, the more difficult it would have been to make predictions about its successful conclusion and the lower the expectation of success.
  - Practical, technical or financial difficulties which would have been envisaged by the skilled person in testing whether the desired result will be obtained when taking a next step may also deter the skilled person from taking that step.
  - On the other hand, the stronger the pointer towards the claimed solution in the prior art, the lower the threshold for a reasonable expectation of success.
- If the patentee alleges (and sufficiently substantiates) uncertainties and/or practical or technical difficulties which it says would prevent a skilled person from having a reasonable expectation of success, the burden of proof shifts to the party alleging obviousness to show that these issues would not in fact have presented the skilled person from proceeding.
- The fact that other persons or teams were working contemporaneously on the same project does not necessarily imply that there was a reasonable expectation of success. It may also indicate that it was an interesting area to explore with a mere hope to succeed.

In the *Edwards* case, the CoA also concluded that it is not necessary to show improvement of the technical teaching as defined by the patent claims over the prior art for an inventive step to be present. A non-obvious alternative to solutions known in the prior art may also be a basis for finding a patent inventive.

Applying these principles to the facts, the CoA found the patents were inventive in both cases, endorsing the Paris CD's first instance decision which had found the Edwards patent valid but reversing the Munich CD's first instance decision to revoke the Amgen patent.

The outcomes were that both Amgen's and Edwards' patents were maintained (Edwards' in amended form).

## 6. Added matter

In *expert v Seoul Viosys* (UPC_CoA_764/2024, UPC_CoA_774/2024, 2 October 2025), the CoA set out a summary of the approach to be taken to added matter in the UPC, stating that

*"An inadmissible extension of the subject-matter exists if the subject-matter of the granted claim extends beyond the content of the application as filed. In order to determine this, the court must first determine what information the skilled person would derive directly and unambiguously from the entirety of the application as filed if viewed objectively and on the date of filing with his general knowledge. The following are also implicitly disclosed objects are to be regarded as part of the content, ie those which are clear and unambiguous from what is expressly mentioned. Where, as in the present case, the patent is the result of a divisional application, this requirement applies to any earlier application. The subject-matter of granted claim 1 must therefore not be disregarded beyond (1) the disclosure of the originally filed application of the patent in suit and (2) the disclosure of the original PCT application which has entered the regional phase and constitutes the parent application of the divisional application".*

In determining the subject-matter of the granted claim in this context, the CoA applied its established approach to interpretation of patent claims (per *10x Genomics v Nanostring*, UPC_CoA_335/2023) focusing not only on its exact wording in a linguistic sense, but also having regard to the description and the drawings as explanatory aids.

The CoA concluded that the Dusseldorf LD which had upheld the patent at first instance had been "*generous to the patentee*" and the CoA reversed the decision, finding that there was added matter and that the patent was therefore invalid.

Another, subsequent, CoA decision (*Amgen v Sanofi-Aventis & Regeneron*) UPC_CoA_528/2024, UPC_CoA_529/2024, 25 November 2025) also addressed added matter in a similar fashion. Consistent with its approach in *expert v Seoul*, the CoA held that: *"The underlying rationale for this requirement is that the patentee cannot claim more than he actually contributed to the state of the art at the priority date. Therefore, an amendment that is made after the priority date should not provide the skilled person with additional technically relevant information which was not derivable from the original application."*

## 7. Sufficiency

The CoA in the *Amgen v Sanofi-Aventis & Regeneron* appeal (discussed above in the context of inventive step) also looked at the standards to be applied to an assessment of sufficiency, holding that:

- Sufficiency has to be examined on the basis of the patent as a whole (ie on the basis of the claims, description and drawings) from the perspective of the skilled person with their common general knowledge at the filing or priority date.
- The test to be applied, held the CoA, is whether the skilled person is able to reproduce the claimed subject matter on the basis of the patent without any inventive effort and without undue burden. An invention is sufficiently disclosed if the patent specification shows the skilled person at least one way of performing the claimed invention.
- Where a claim contains one or more functional features, it is not necessary for the patent to include specific instructions as to how each and every conceivable embodiment within the functional feature(s) should be obtained. However, variants of specifically disclosed embodiments that are equally suitable to achieve the same effect, which could not have been envisaged without the invention, should also be protected by the claim. Consequently, any non-availability of some embodiments of a functionally defined claim is immaterial to sufficiency, as long as the skilled person through the disclosure is able to obtain suitable embodiments within the scope of the claim.
- The need for a reasonable amount of trial and error does not mean that the invention is insufficient.
- The burden of proof lies with the party arguing that the patent is insufficient.

## 8. Standing to sue in revocation actions

In November, in *Pari Pharma GmbH v Koninklijke Philips N.V.* (UPC_CFI_613/2024) the Milan CD considered the requirement in Art. 47(6) that a party must be "concerned by a patent" in order to have standing to bring an action before the UPC (in particular in reference to revocation actions).

The Milan CD said that it was clear both from the systematic approach of the UPCA and from the RoP that a claimant does not have to show a specific legal or economic interest in the patent in order to bring a revocation action. It held that: "*Any person or entity potentially trying to ascertain their "freedom to operate", therefore any party (potentially) operating in the technical field of the patent are "concerned" by a party and have a standing to sue under Art. 47(6) UPCA*".

Accordingly, while a person or entity who was notified of a possible infringement by a patentee, received a warning letter, or is sued, is certainly "concerned by a patent", such an action by the patentee is not required for the claimant to have standing to sue. In this case, the court found that as the party seeking revocation was a competitor of the patentee, it had standing to sue.

## Claim Interpretation

### 9. Relevance of the file wrapper to claim construction

The principal decision on whether statements made during the prosecution of a patent can be taken into account when determining the interpretation of claims, was made by the UPC CoA in *Alexion v Samsung* (UPC_CoA_402/2024, 20 December 2024). There the CoA held that:

"*The patent claim must be interpreted from the perspective of the person skilled in the art. The applicant's assertions during the grant proceedings, and in particular the TBA's endorsement thereof, can be seen as an indication of the view of the person skilled in the art at the filing date*".

More recently, in *Alexion v Amgen* (UPC_CoA_405/2024, 19 June 2025), the CoA held that when interpreting a claim, the court will consider and weigh the arguments and facts brought forward by the parties. In that context, it said that: "*... there is no reason why the decision of the Technical Boards of Appeal in the opposition proceedings relating to the patent at issue, if relied on by one of the parties, cannot be considered as an indication of the views of the person skilled in the art at the filing date*".

*Alexion* has been referred to in several decisions that considered "file wrapper". For example, in *Philips v Belkin* (ibid, 3 October 2025) the CoA approved the approach, stating that the patent claim must be interpreted from the perspective of the person skilled in the art. Alexion's assertion during the grant proceedings, and in particular the TBA's endorsement thereof, could be taken as an indication of the view of the person skilled in the art at the filing date, "[h]*owever, no other understanding can be inferred from Philip's statement in the grant proceedings*". This was also the view of the Hamburg LD in *Dyson v Dreame* in August 2025, which also followed the CoA's conclusions in *Alexion v Samsung*.

In October 2025, in *Raccords et Plastiques Nicoll v First Plast* (UPC_CFI_612/2024, 24 October 2025, mentioned in our comments on decisions likely from the CoA in 2026), while interpreting the proper construction of the claims in terms of literal infringement, the Paris LD also considered the representations made by the patentee in the course of the grant procedure. Again, referencing the UPC CoA decision in *Alexion v Samsung*, where the CoA concluded that the applicant's statements during the grant proceedings are only indicative: "*the applicant's assertions during the grand proceedings ... can be seen as an indication of the view of the person skilled in the art at the filing date*", the Paris LD held that the statements made by the patentee during the grant procedure could be used to inform the interpretation of the claims. The court held that statements made during prosecution invoked an interpretation of the patent that, if applied to the claims, meant that the alleged infringing product would not be caught by the patent under literal infringement. However, the granting procedure is not by itself relevant for interpretation of a claim.

### 10. Other issues of claim construction

**Dependent claims as an aid to construction of the main claim:** In *Sanofi-Aventis v Amgen* (UPC_CoA_528/2024 UPC_CoA_529/2024, 25 November 2025), the CoA held that the question of whether conclusions can be drawn from the subject matter of a dependent claim and its features when interpreting the main claim depends on the circumstances of the individual case. If the dependent claim is only adding an additional feature that does not provide a more specific description of the features of the main claim, it generally argues against the possibility of drawing conclusions about the interpretation of the main claim from this dependent claim.

**Medical use claims:** In the *Sanofi* decision, the court also found that when the claims are drafted in 'medical use-format', it is an inherent claim feature that the claimed product must be objectively suitable for the claimed use, ie be therapeutically effective. This requires that the claimed treatment causes a noticeable improvement of the medical condition of the patient suffering from the disease mentioned in the claim, ie the treatment must be meaningful. The fact that the skilled person does not derive any minimum required effect from the claim or the description does not lead to another conclusion, since the feature of therapeutic effect does not follow from the claim language that is to be interpreted, but from the use of the medical use claim format.

**Embodiments in the specification:** The *Edwards v Meril* appeal (UPC_CoA_464/2024 et al, 25 November 2025) also had something to add on claim interpretation/construction. As a general rule, a product or process presented as an embodiment by the patent specification may be considered covered by the patent claims. However, there is room for an exception where the patent as a whole clearly teaches the person skilled in the art that the disclosed embodiment is not claimed, eg when it only illustrates a technical specification that is not addressed by the teaching of the patent claim.

## Infringement

### 11. Doctrine of equivalents

In *Raccords* (ibid), the parties disagreed on which national test for infringement by equivalence to apply, with Raccords proposing a test consistent with the French, German and Italian national practices to assess equivalence and First Corporation putting forward the Dutch test comprised of four questions.

The Paris LD had to determine a DoE test to apply, since no specific test is set out in the UPCA (although Art 24 UPCA includes, as sources of law to be applied by the UPC, the European Patent Convention (**EPC**) which does refer to infringement by equivalence). Referring to its own decision in *NJ Diffusion SARL v Gisela Mayer GmbH* (UPC_CFI_363/2024, 1 August 2025) which itself referred to the Mannheim LD's decision in *DISH v AYLO* (UPC_CFI_471/2023, 6 June 2025), the Paris LD stated that:

" *... in the absence of an agreement between the parties to apply a particular national law on* [the DoE], *it is appropriate to apply case law pursuing a harmonised approach to equivalence, using criteria derived from a compromise between the different doctrines used within the Member States, in order to comply with the objectives of the UPC.*"

In view of these decisions and also that of the Brussels LD (*Nelissen v Orthoapnea*, UPC_CFI_376/2023, 17 January 2025) the court concluded that for infringement by equivalence to be found, "*it is necessary that at least the function be reproduced*" and that "*in the absence of such reproduction, there would in any case be no reproduction by equivalence*". The Paris LD therefore concluded that, in simple terms, the question to be answered in determining infringement by equivalents was: "*Do the modified (or substituted) means essentially fulfil the same function to achieve the same effect*". Applying this test to the facts of the case, the Paris LD concluded that there was no infringement by equivalence.

As noted above, this approach contrasts with the approach in *Plant-e v Arkyne* and, more recently, *Washtower v BEGA* (UPC_CFI_479/2025, 11 September 2025), in which The Hague LD used the Dutch test for infringement by equivalents by agreement of the parties. It remains to be seen if the CoA will have the opportunity to issue guidance on the correct approach in 2026.

## 12. Imminent infringement

The UPC's approach to the test for whether there is "imminent" infringement (which is relevant to determining whether to grant provisional measures such as preliminary injunctions) was first set out by the Dusseldorf LD in *Novartis v Celltrion* (UPC_CFI_166/2024, 6 September 2024):

"*A situation of imminent infringement may be characterised by certain circumstances which suggest that ... the potential infringer has already set the stage for it to occur. The infringement is only a matter of starting the action. The preparations for it have been fully completed. These circumstances must be assessed on a case by case basis.*"

**Pharmaceuticals in Portugal:** In May 2025 in *Boehringer v Zentiva* the Lisbon LD refused a PI application for insufficient proof of imminent infringement. However, this decision was subsequently overturned on appeal (*Boehringer v Zentiva*, UPC_CoA_446/2025, 13 August 2025) with the CoA granting a preliminary injunction across all 17 UPC states where the EP was valid.

The CoA followed the approach in *Novartis v Celltrion*, referring to the relevance of the alleged infringer already having set the stage and preparations having been fully completed. It noted that the mere application for an MA by a generics company does not amount to an imminent infringement, nor does the grant of an MA, but the completion of national procedures for health technology assessment, pricing and reimbursement for a generic medicine can amount to imminent infringement, saying that "*the only way a completed* [administrative procedure] *can be of any use for Zentiva from an objective point of view is for the offering of the generics*".

The CoA's approach perhaps contrasts with the new proposals for the Bolar exemption currently being finalised by the European Parliament as part of the "EU Pharma Package" (and which will bind the UPC), which allows much greater scope than the provisions of the UPCA for use of the invention by generics in preparations for launch of their products on "day one" after patent rights have expired.

**Pricing and reimbursement rates:** In November, in *Merz Therapeutics GmbH and others v Viatris Santé* (UPC_CFI_697/2025, 21 November 2025), the Paris LD concluded that the point at which infringement becomes imminent in relation to a generic product in the French market is where an MA has been granted and the pricing and reimbursement rates have been obtained. Consistent with the approach in *Novartis v Celltrion*, the focus was on whether the relevant national administrative procedures required for launch had been completed or not.

"*In the present case, it is necessary to determine the event in the French administrative procedure allowing the generic manufacturer to place its product on the market. The parties agree that this event is the obtaining of the price and reimbursement rate.*"

**CE Marking:** The obtaining and publicising of CE mark approval was considered as evidence of imminent infringement by the Hamburg LD which granted a PI preventing Lepu Medical Technology (Beijing) Co from offering, placing on the market or using, or importing or storing for those purposes embodiments which were held likely to be infringing Occlutech GmbH's European patent in Germany, France, Italy, Netherlands and Ireland. The LD concluded that:

"*... the CE-mark approval does also give an indication that a market entry into Germany is to be expected in the foreseeable future, since the CE marking is required for placing a medical device in any of the EU member states, not just, but including in Germany. Also, an expected (and in fact occurred) presentation of the attacked embodiments on a trade fair in Germany is a sufficient indication that marketing the products is prepared for the German market in particular.*"

## 13. "Offering" interpreted broadly for infringement

In October, in *Koninklijke Philips NV v Belkin GmbH and others* (UPC_CoA_534/2024, 19/2025 and 683/2024, 3 October 2025), the CoA gave a broad interpretation to what could count as "offering" as an infringing activity under Article 25(a) UPCA.

The CoA held that offering is "*to be understood in the economic sense and not based on the legal meaning in the sense of a binding contractual offer. Therefore, the offer does not have to contain all of the details that would be necessary for the immediate conclusion of a contract by mere acceptance of the offer. It is sufficient to present an object in such a way that viewers can make an offer for transfer, for example, for the conclusion of a purchase, rental or lease agreement. It is not necessary, therefore, to indicate a price.*"

The court also stated that a willingness to deliver, or the possibility of delivery, is not relevant for the concept of offering.

## 14. Supply of disassembled parts can be direct infringement

In *bellissa HAAS Gmbh v Windhager GmbH* (UPC_CFI_338/2024, 12 September 2025) the Mannheim LD considered whether there can be direct infringement of a patent claiming an assembled system where the parts of the system are offered as an unassembled kit or as separate parts.

The infringement claims and counterclaim for revocation proceedings centred on bellisa's patent for a system of "edging for beds and grassland areas consisting of at least two strips of sheet metal that can be connected to each other" characterised by its tongue-and-groove attachment mechanism designed for straightforward on-site assembly. The court held that Windhager's product realised the same features as belissa's patented product when two or more sections were assembled as intended, thus constituting direct infringement.

"*...the mere offering and distribution of all components of a patent-infringing product, which in a modular system only need to be assembled in a simple manner by the purchaser at the place of use without the addition of any additional items, constitutes a direct patent infringement within the meaning of Article 25 of the UPCA*".

Moreover, the court highlighted that the injunction granted included the offering and placing on the market of a single component. It was concluded that, where a patent-infringing product consists of at least two identical, coordinated components, the selling of one component may also constitute direct infringement provided "*reference is made to the possibility of assembling or if this is otherwise obvious*", and no additional subject-matter is needed.

This decision avoids the need for patentees to pursue such claims under indirect infringement (ie arguing that there has been supply of essential elements of an invention to provide the means to recreate that invention) which comes with additional requirement that the alleged infringer will be used by the primary (direct) infringer to infringe the patent.

## Preliminary Injunctions

### 15. PIs and (unreasonable) delay and the balancing of interests when awarding a PI

**Background on unreasonable delay:** While Art. 62(2) of the UPC Agreement (UPCA) and Rule 211.3 RoP do not contain an explicit "urgency" requirement for preliminary injunctions to be awarded, Rule 209.2(b) RoP instructs the Court to "*take into account* [...] *the urgency of the action*" and Rule 211.4 RoP requires to Court to consider "*any unreasonable delay in seeking provisional measures*". UPC case law has now firmly established that undue delay can be fatal to a PI application. However, so far, the UPC has rejected the application of rigid deadlines. The CoA has repeatedly emphasised that delay must be assessed on a case-by-case basis, considering all circumstances.

This represents a shift away from divergent national approaches seen before the launch of the UPC: Whereas German courts traditionally apply a strict one-month deadline, jurisdictions like Italy or Finland do not assess delay as a standalone requirement but in the context of overall balancing of interest, often times allowing timeframes of several months before refusing PI applications due to delay. Other jurisdictions, like France, do not take into account any delay in the context of PI applications. In contrast, UK courts treat delay as one discretionary factor among many.

The UPC sits somewhere in between. There is no fixed cut-off, but a clear expectation that patentees act without delay once they have gathered all the information they need to make an application (and have done that gathering and investigating without unreasonable delay). Interim relief is only intended for urgent cases, not as a shortcut for cases where the patentee itself has contributed to delay.

The CoA in *Barco v Yealink* (UPC_CoA_317/2025 & UPC_CoA_376/2025) 28 November 2025 confirmed this, holding:

"*Delay within the meaning of R. 211.4 RoP shall be calculated from the day on which the applicant became aware, or should have become aware, of the infringement that would enable him, in accordance with R. 206.2 RoP, to file an application for provisional measures with a reasonable prospect of success. Thus, the decisive point in time is when the applicant has, or should have had, after exercising due diligence, the necessary facts and evidence within the meaning of R. 206.2(d) RoP. Whether there has been an unreasonable delay within the meaning of R. 211.4 RoP depends on the circumstances of the individual case (order of 25 September 2024, UPC_CoA_182/2024, Mammut vs Ortovox)*"

Earlier in the year, the decision of The Hague LD in *Cilag v RiVolution* (UPC_CFI_374/2025, 29 August 2025) reviewed the CoA decisions in *Nanostring v 10x Genomics* (UPC_CoA_335/2023, 26 February 2024), *Mammut v Ortovox* (UPC_CoA_182/2024, 25 September 2024) and *Boehringer Ingelheim vs Zentiva* (UPC_CoA_446 and _520/2025), 13 August 2025) setting out the criteria for unreasonable delay. The Hague LD held that it followed from these decisions that:

" *... an applicant does not need to apply to the Court until it has – or should have had – reliable knowledge of all the facts which make an action for interim measures likely to succeed including evidence to credibly substantiate those facts. The applicant may prepare for any possible procedural situation that may arise in the circumstances in such a way as to be able to submit the requested information and documents to the court upon an appropriate order and to successfully respond to the opposing party's submissions. On the other hand, the applicant must not delay unnecessarily. As soon as it becomes aware of the alleged infringement, it must investigate it, take the necessary steps to clarify the matter and obtain the necessary documents to support its submission. In doing so, the applicant must pursue the necessary steps with determination and bring them to a conclusion*".

Once the applicant is in possession of all the knowledge and documents that are reasonably likely to lead to a successful prosecution of the case, it must normally file an application for provisional measures without delay (*Dyson Technology Limited v SharkNinja Europe Limited* (UPC_CFI_443/2023, 21 May 2024) and *Syngenta Limited v Sumi Agro Limited* (UPC_CFI_201/2024, 27 August 2024)).

**Examples of cases where there was held to have been no delay:** Several LDs have accepted filing delays in application for a PI of one to two months without requiring detailed justification from the applicant – especially where time was needed to investigate the infringement or prepare a technically complex case. In *Dyson v SharkNinja* (UPC_CFI_443/2023, 3 September 2025) and *Hand Held Products v Scandit* (UPC_CFI_74/2024, 21 May 2024), the Munich LD held that a preparatory period of up to two months was compatible with the urgency requirement, particularly in light of the UPC's front-loaded procedures. In *Scandit*, the Munich LD even explicitly rejected the one-month deadline applied earlier by the Düsseldorf LD in (*Ortovox v Mammut*, UPC_CFI_452/2023, 11 December 2023; *10x Genomics v Curio* UPC_CFI_463/2023, 30 April 2023).

These decisions contributed to the initial impression of inconsistent standards across LDs and may partly explain why Munich LD became a preferred venue for many patentees. That perception has since been tempered by clearer guidance from the CoA. In *Mammut v Ortovox* (UPC_CoA_182/2024, 25 September 2024), the CoA confirmed that there is no fixed urgency deadline. It stressed that urgency depends on whether, in light of all circumstances, the applicant acted without undue delay. Following this guidance, even divisions that had previously referenced a one-month benchmark have clarified that such timeframes are merely indicative, not absolute (see for example the Düsseldorf LD in *Valeo v Magna* (UPC_CFI_347/2024, 21 October 2024). Here, Ortovox first became aware of an imminent patent infringement on 28 November 2023, and was held not to have waited an unreasonably long time to file the application of 1 December 2023. The approximately three weeks it took to then file the orders on 21 and 22 December 2023 was not found to be a circumstance related to the period of time taken to file the application. Even then, it was held that it would not have been an unreasonably long period taking into account all of the circumstances.

Exceptional cases also show that even longer delays can be justified. In *Amycel v Spyra* (UPC_CFI_195/2024, 31 July 2024), The Hague LD granted a PI despite a delay of nearly one year. The court accepted that infringement could only be proven after time-consuming biological testing and cultivation and that therefore the delay resulted from unavoidable evidence gathering, not strategic hesitation. While such cases remain rare, they confirm the UPC's flexible, fact-driven approach to urgency.

**Examples of cases where unreasonable delay was found to have occurred:** In November 2025, in *Barco v Yealink* (UPC_CoA_317/2025, 28 November 2025), the CoA, considering an

appeal from the Brussels LD's rejection of a PI application on the grounds of unreasonable delay (UPC_CFI_582/2024, 21 March 2025), agreed with the LD and held that Barco had waited an unreasonably long time to apply for provisional measures. The CoA found that Barco could have applied for unitary protection within a few weeks of grant, had Barco acted diligently, and this furthermore did not detract from the finding from the Brussels LD that Barco's knowledge of the allegedly infringing devices was from much earlier. The CoA concluded that Barco could have applied for provisional measures in July 2024. The CoA also did not accept arguments from Barco that products put on the market may be amended at short notice to avoid infringement, and this risk of amendments would lead to Barco's ability to undertake test purchases and analyse the products at an earlier time being frustrated. Barco's submissions that products that are put on a market can be altered at short notice by Yealink, to avoid patent infringement, and that the risk of such alterations would frustrate Barco's ability to make test purchases and carry out analysis at an earlier point in time, were rejected by the Court: "*Barco's submissions that the rapid changes of products in this part are basically blank statements and cannot be accepted. Moreover, as a rule potential changes of products on the market do not justify a delay within the meaning of Rule 211.4 RoP.*"

The decision of The Hague LD in *Cilag v RiVolution* in August 2025 provides another illustration of unreasonable delay, leading to the refusal of a PI application. Here a delay of over 5 months from the point at which the Applicant had, or should have had, after exercising due diligence, the reasonably necessary facts and evidence (within the meaning of R. 206.2(d) RoP) was considered too long. The court considered that Cilag had not demonstrated the necessary temporal urgency was not convinced by Cilag's reasonings for the delay. Cilag had tried to argue that urgency had been revived due to an expansion of a study using the allegedly infringing products, stockpiling and the potential announcement of a tender. However, this was rejected by The Hague LD, saying Cilag should have been aware the day it obtained a German injunction against the manufacturers for the same product. The Hague LD considered that in the context of UPC proceedings where a hearing on the merits is expected to take place within a year of filing of a claim, if a patentee acts with unreasonably delay, they should not be able to "jump the queue".

In *Merz Therapeutics GmbH and others v Viatris Santé* (UPC_CFI_697/2025, 21 November 2025), the Paris LD rejected Merz's application for provisional measures against Viatris, finding that Merz had unreasonably delayed seeking interim relief after becoming aware of the alleged infringement, and ordered Merz to pay interim costs to Viatris.

The case in dispute has two distinctive features: the product alleged to be infringing is a generic version of a product protected by an SPC; and the rights to the title on which the application is based were repurchased by the Defendant during the same period when the administrative procedure for authorising the generic product to be placed on the French market was ongoing. This prompted the court to ask the question: In the context of a generic product, at what point was or should the person who purchased the rights have been informed of an event that could justify an application for interim measures?

The court held that either the moment when they became aware of infringement was imminent or the moment of actual infringement could be the trigger points for assessing delay, whichever was the earlier. Here the date by which all administrative procedures (including MA application, setting of prices and reimbursement rate) required to market in France were finalised (about which the patentee would have been informed by the authorities) was the trigger date for imminent infringement and thus the date from which delay would be judged, not the actual generic launch date. Viatris had informed the French Health Products Economic Committee on 3 October 2024 that it intended to market its generic product within six months, which was before the expiry of the SPC. The date of publication of the price of the generic in France was 22 November 2024 and the date of application for a PI was 31 July 2025 which was held to be unreasonable delay such that a PI would not be granted.

**Balancing of interests when awarding a PI:**

In July, in *Aesculap v Shanghai* (UPC_CFI_213/2025, 10 July 2025) the Düsseldorf LD set out considerations for balancing interests in the decision to award a PI, weighing the interest of the parties, taking into account in particular the harm that would be caused to one of the parties by granting or refusing interim measures.

- Consider whether the matter can await a decision in the main proceedings on the merits (derived from the CoA's decisions in *Biolitec v Light Guide* (UPC_CoA_540/2024, 24 February 2025) and *Insulet v EOFlow* (UPC_CoA_768/2024, 30 April 2024).
- Interim measures are necessary if a delay would cause irreparable harm for example, although damage is not a necessary prerequisite for ordering interim measures (*Mammut v Ortovox* (UPC_CoA_182/2024, 25 September 2024) and *Biolitec* and *Insulet* (above) in this regard.
- The need for interim measures may also arise from the fact that there is direct competition between the challenged embodiment and the patent proprietor's product (*Biolitec*). In these cases interim measures may be justified if they are necessary to maintain the status quo prior to the alleged infringement pending a decision on the substance of the case (*Mammut* and *Biolitec* and others).
- The necessity for an interim measure may also result from the fact that without it the market profile would immediately change from a situation in which only one product is available, to a situation with two competing products. The courts recognised that such a transition can lead not only to price pressure but also to permanent price erosion (*Sumi v Syngenta* UPC_CoA_533/2024, 3 March 2024 and *Insulet*).

When weighing up these interests the court will also take in to account an unreasonable delay in applying for the PI, as discussed above, because by unreasonably delaying the patent proprietor has demonstrated through his behaviour that the enforcement of his rights is not urgent for him. The court stated that in such a situation, there is no need to order interim measures. In this case, however, the court found that there were no indications of such an unreasonable delay on the part of the applicant. The court reiterated the finding in several decision including *Ballinno v UEFA* (UPC_CFI_151/2024, 3 June 2024) *that "the temporal urgency required for the ordering of interim measures is only lacking if the injured party has pursued his claims so negligently and hesitantly that it can be objectively assumed that he has no interest in the rapid enforcement of his rights and that it therefore does not appear appropriate to order interim measures".*

*Maximillian Martini, Amelia Chammas and Rachel Montagnon*

## Final (permanent) injunctions

### 16. Carve-outs to final injunctions are possible (but likely to be rare)

In the *Edwards v Meril* disputes relating to prosthetic heart valves, the Munich LD issued a permanent injunction with a "public health interest" exception for Meril's XL-size valves on the basis that while they infringed the patent, they were not available from Edwards or any other legitimate source (UPC_CFI_15/2023, 15 November 2024). A process was established in the LD's order by which doctors would upload relevant individual patient data to a portal which allowed doctors at Edwards to determine whether they agreed that Edwards could not offer any viable alternative product (and only if they came to that conclusion would Edwards grant an exception to the injunction, on a case by case basis).

The need for a carve-out was endorsed by the CoA and the court also agreed with Meril that

*"The availability of these products should not depend on the willingness of Edwards to maintain the portal or on the assessment by Edwards' team of doctors. A notification of an intention to use Meril's XL device by a physician confirming that such product is the only available treatment option for a particular patient should be sufficient".*

The CoA therefore endorsed the injunction granted by the Paris CD in the interim in the parallel consolidated proceedings (UPC_CFI_189/2024 & 434/2024)) and granted an injunction in respect of the Munich LD proceedings Meril parties such that the making, offering, placing on the market and use of Meril's XL devices, and the importing and storing of the products for those purposes, were not covered by the injunction, provided that a physician has submitted the required notification. The court held that Meril was free to make doctors aware of the availability of the XL devices where it would be the only treatment option for a particular patient (without the date restrictions that the Munich LD had previously included).

## Liability of Directors

### 17. Comfort for company directors on liability for infringement

The UPC CoA has provided guidance on the liability of managing directors for the infringement of a patent by their companies (*Koninklijke Philips NV v Belkin GmbH and others* UPC_CoA_534/2024, 19/2025 and 683/2024, 3 October 2025).

The CoA held that an infringer can be someone who does not themselves carry out the infringing acts specified in Article 25 of the UPCA but to whom the infringing acts of a third party are attributable because they are an instigator, accomplice or accessory to the infringing acts (effectively confirming the possibility of joint liability for patent infringement in the UPC). However, merely holding the position of managing director and carrying out general management, control and organisational duties does not make a person an accomplice or accessory to a company's patent infringement.

The CoA concluded that a managing director can only be held liable if their contested action goes beyond their typical professional duties as managing director. This is particularly the case if they deliberately use the company to commit a patent infringement. However, it also applies if the managing director knows that the company is committing a patent infringement and fails to take action to stop it, despite it being possible and reasonable for them to do so.

Notably, the CoA held that if a managing director seeks legal advice on the matter, they can generally rely on this advice (of non-infringement) until a first-instance decision has been issued establishing the company's patent infringement.

On the facts, the CoA held that the Belkin managing directors were not liable for infringement. No director of the third corporate defendant (Belkin International Inc) was sued in this action.

## Gathering evidence

### 18. Saisies (preservation orders)

So far at the UPC, as published before the end of December 2025, there have been a total of 26 saisie applications, of which 21 have been granted (over 80%), and 5 denied or withdrawn.

In July 2025, the UPC CoA decided on the appeals of the Paris LD's grant of saisies (an order to preserve evidence) in *Maguin v Tiru* (UPC_CoA_327/2025, 15 July 2025) and *Valinea v Tiru* (UPC_CoA_002/2025, 15 July 2025), providing helpful guidance on the criteria the UPC should apply in considering an application for a saisie. These are different to those used for a PI application, for example, since the validity of the patent is not required to be assessed and there is no "unreasonable delay" element involved either.

- When examining an application for preserving evidence, the Court exercises its discretion by taking into account the urgency of the action in order to determine whether, and to what extent, it wishes to hear the defendant, summon the parties to an oral hearing, summon the applicant to an oral hearing without the presence of the defendant, or decide the Application without having heard the defendant.

- In exercising its discretion to determine whether an application for preserving evidence should be granted, the Court does not need to consider unreasonable delay as it does in a PI application. The risk of the disappearance or unavailability of evidence must be assessed with reference to probability or to the demonstrable risk of evidence being destroyed or otherwise ceasing to be available, and not with reference to the certainty of the disappearance or the unavailability of evidence.
- Unlike provisional measures, where the Court must be satisfied – with a sufficient degree of certainty – that the patent is valid, no such criterion is required to order measures to preserve evidence. The Court is therefore not required to assess the validity of the patent at issue. This matter remains solely within the competence of the judge ruling on the merits or on provisional measures, except where the presumption of validity can clearly be called into question, for example, following a decision by an Opposition Division or a Board of Appeal of the European Patent Office in a parallel opposition procedure, or in revocation proceedings before another court concerning the same patent.
- The assessment of the relevance of a prior art document remains, however, within the competence of the judge ruling on the merits or, to a different extent, of the judge competent to decide on applications for provisional measures. Accordingly, it is not for the applicant seeking measures to preserve evidence, at the stage of the application, to identify and disclose prior art of which it may be aware, unless such prior art is, for specific reasons, likely to influence the ex parte decision to be taken. Nor is it for the judge responsible for ordering measures to preserve evidence and inspect premises to examine any prior art that may be submitted to them, unless such prior art is, for obvious reasons, likely to influence their decision.

Most saisie decisions relate to seizure of allegedly infringing goods at trade fairs and *Ecovacs Robotics Co., Ltd. v Roborock (HK) Limited* (UPC_CFI_834/2025, Düsseldorf LD, 19 December 2025) is no exception in that respect with the court granting an *ex parte* order for inspection and preservation of evidence. However, on appeal, the CoA was much stricter in its approach, determining that Ecovac's application breached Rule 192.3 RoP by presenting an incomplete and misleading picture of the availability of evidence. The CoA accepted Roborick's argument that samples could easily have been obtained via the internet, making an ex parte order inappropriate as it lacked the requisite urgency or necessity. However, the confidentiality obligations and related penalty threats remain in force, and Ecovacs must bear the costs of the inspection and the expert's detailed description.

Another decision late in 2025, and one of significant interest to those in the pharma sector, was from the Brussels LD in *Genentech & Hoffmann La Roche v Organon* (UPC_CFI_407/2025 & UPC_CFI_408/2025, 12 November 2025). Genentech had applied for and had been awarded two ex parte evidence-preservation and inspection orders in a dispute over a pertuzumab biosimilar. Organon requested a review of the judge rapporteur's decision by the panel of the Brussels LD, which panel then confirmed the order finding that Genentech and Roche showed a plausible risk of imminent infringement by Organon, and dismissed Organon's requests to revoke or narrow the scope of the order. The orders were very wide, in particular considering they were made in the absence of the defendant. They included seizure of samples as well as documentation, at multiple locations and countries (at the defendant's premises in both the Netherlands and Belgium) involving. There was also provision for the evidence gathered to be used in parallel national proceedings.

In its assessment of whether the ex parte saisie order had been correctly granted, the panel considered that the scope of the review assessment does not pertain to the execution of the order to preserve evidence/for inspection, the outcome of such execution, or any information (evidence) gathered during execution. Any requests made by the applicant relating to the execution of the order to preserve evidence/for inspection, the alleged fact that no evidence proving the infringement was found, or the alleged fact that more was seized than was authorised, are to be dismissed in review proceedings. Such requests must be assessed in separate proceedings and/or as part of the defence after the introduction of PI proceedings and/or proceedings on the merits, which may affect the admissibility and value of such evidence.

The panel also commented on the general purpose of an order to preserve evidence/for inspection, which is:

a. to enable an applicant who has "*presented reasonably available evidence to support the claim*" to access additional information (evidence) that is not publicly available (and, if necessary, protected by a confidentiality order) in order to prove the infringement and/or the acts constituting infringement; and

b. if granted, and based on the preserved/gathered information (evidence), enable the applicant to evaluate the reliable prospects of success in initiating subsequent infringement proceedings.

More specifically, the applicant is brought in the position to evaluate whether:

i. to initiate provisional measure proceedings in accordance with the "no unreasonable delay" condition set out in Rule 211.4 RoP;

ii. to initiate a procedure on the merits, in accordance with Rule 13.1(l)(i) RoP, which refers to an indication of the facts relied upon, particularly the "alleged or threatened infringement";

iii. not to initiate proceedings where there would be insufficient evidence of infringement or threatened infringement.

The Brussels LD also confirmed that, given the general purpose of an order to preserve evidence or for inspection, the term "about to be infringed" in Art. 60(1) UPCA and Art. 60(3) UPCA did not have the same meaning as "urgency" (in the sense of Rule 194(2) RoP) nor "unreasonable delay" (in the sense of Rule 211.4 RoP (cf. CoA order 15 July 2025, UPC_CoA_327/2025)), nor "threatened infringement" (in the sense of Rule 13.1(l)(i) RoP) (as discussed in the CoA decision above).

*"The applicable threshold is that of "about to be infringed", which must be proven by the applicant with a certain degree of plausibility. Therefore, there must be a risk of infringement and it must be apparent that it will occur in the future. The specific facts of the case will determine the duration of this period.... in an order to preserve evidence/for inspection* [the] *appointed experts' task is to filter (evaluate) the gathered/preserved information (evidence) and use only such information (evidence) which he/she deems necessary as possible evidence to prove or disprove the actual infringement of the patent-in-suit."*

Organon subsequently requested the CoA to apply suspensive effect to this order, but this was refused by the CoA (UPC_CoA_913/2025 & 914/2025).

## Stays

### 19. Stays pending EPO oppositions

The issue of whether the UPC should stay proceedings when EPO opposition proceedings are pending has challenged the courts since the commencement of the UPC. Under RoP 295(a) the court may stay where it is seized of an action relating to a patent which is also the subject of opposition proceedings or limitation proceedings (including subsequent appeal proceedings) before the European Patent Office or a national authority where a decision in such proceedings may be expected to be given rapidly. Where stays have been granted this has been in situations where the opposition result was imminent, but again this has not always been the case. The UPC is generally very keen to keep to its "year from filing to trial" ambition set out in the UPCA and makes procedural decisions accordingly.

So, for example in September 2025, the Mannheim LD refused to allow a stay pending the outcome of EPO opposition proceedings, reasoning that the case was ready for hearing and that a stay would risk unjustifiable delay and conflicting decisions. The court decided to proceed with the scheduled hearing to ensure justice and consistency.

A stay pending the outcome of EPO proceedings is more likely to be granted where parties are in agreement and jointly request one from the court or one party requests and the other agrees – see for example recent decisions in *Edwards Lifesciences Corp v Meril Life Sciences PVT Ltd & Ors* (UPC_CFI_775/2025, UPC_CFI_776/2025, UPC_CFI_777/2025, 5 December 2025) before the Nordic-Baltic Regional Division, *Husqvarna AB v POSITEC Germany GmbH* (UPC_CFI_351/2025 & UPC_CFI_689/2025, 16 October 2025) before the Dusseldorf LD and *Atlas Global Techonologies GmbH v TP-LINK CORPORATION PTE.LTD. and others* (UPC_CFI_416/2024 & UPC_CFI_417/2024, 18 September 2025) before the Dusseldorf LD. A stay by joint request of the parties is, after all, an alternative ground for a stay under RoP 295 (under RoP 295(d)).

However, where the court suggests a stay but the parties do not agree with the court, it appears unlikely that one will be granted nonetheless. In the appeal in the *Sanofi-Aventis v Amgen* revocation action, the court requested comments on a possible stay in light of the parallel proceedings pending before the TBA of the EPO concerning the patent in issue. However, the parties unanimously indicated as their primary position that they did not see the need for a stay at that stage of the proceedings and so one was not granted.

## References to the CJEU

### 20. Interpreting the UPC Agreement and Rules is not a matter for the CJEU

In August 2025, the UPC CoA clarified that only relatively narrow aspects of law and practice will be referred for interpretation to the Court of Justice of the European Union (**CJEU**) in *expert e-Commerce GmbH and expert klein GmbH v Seoul Viosys Co., Ltd.* (UPC_CoA_380/2025, 20 August 2025).

The CoA acknowledged that there may be a need to interpret EU law in the context of the application of the UPCA or the RoP and where the UPC applies EU law, recognising that the UPC must interpret its own substantive and procedural law in a manner that is consistent with EU law. In rare case where such interpretation (in line with EU law) is impossible the UPC must disapply of its own motion any rule or practice which is contrary to a provision of EU law with direct effect (which can also open up questions on interpretation of EU law).

However, the CoA went on to make clear that the UPC cannot ask the CJEU to interpret the UPCA. The UPCA is an international agreement and forms part of international law. Similarly, the UPC cannot ask the CJEU to interpret the RoP.

There was therefore no need for a preliminary ruling from the CJEU where established case-law of the CJEU already resolves the point of law in questions. The same applies where there is no scope of any reasonable doubt about the application of the principles.

The CoA denied appellants expert e-Commerce GmbH and expert klein GmbH (together, expert) leave to appeal the refusal to allow their application for a costs decision which application had been rejected by the standing judge due to it being time barred under Rule 151 RoP. The CoA further declined to refer experts' questions on related issues of interpretation of the RoP and UPCA to the CJEU, finding that the CJEU did not have jurisdiction to consider the RoP or UPCA in this context and that there was no reasonable doubt regarding the interpretation of EU law or procedural fairness) and thus no jurisdiction for CJEU involvement. It was clear from what expert had brought forward that it did not take issue with the content of Art. 69 UPCA, which implements Art. 14 of the Enforcement Directive, as such, but with the one-month time limit in Rule 151 RoP for lodging an application for a cost decision. The facts of the case before the UPC concerned the application of this Rule and this was not within the scope of EU law and the CoA did not consider the CJEU had any jurisdiction to give a preliminary ruling where a legal situation did not come with the scope of EU law.

## Practice points

### 21. Narrowing and prioritising arguments

The UPC has recently issued several orders seeking to encourage parties to narrow their cases and prioritise their arguments. This seems to be particularly focussed on cases or submissions which are so broad as to be impractical for the court and/or the other parties to deal with.

So, for example, in *bioMérieux UK Limited v bioMérieux SA and others* (UPC_CFI_497/2024, 18 July 2025) the Milan CD issued a procedural order in this revocation action, directing bioMérieux to narrow its 50 invalidity attacks and prioritise arguments for the oral hearing, focusing on selected arguments and prior art. In *Merz Therapeutics GmbH and others v Viatris Santé* (UPC_CFI_697/2025, 17 September 2025) the Paris LD court ordered Viatris to file a condensed 70-page summary of its 470-page objection in a provisional measures case initiated by Merz Therapeutics GmbH and affiliates, citing procedural economy and fairness. Merz was directed to limit its response to 40-pages focused on validity issues.

### 22. Admissibility of an application to amend the patent

The CoA in the *Meril v Edwards* appeal (ibid) considered the admissibility of applications to amend the patent. Under Rule 49.2 RoP, the Defence to revocation may include an application to amend the patent. The CoA held that any request to amend the patent made after the Defence is filed may only be admitted into the proceedings with the permission of the court, under Rule 50.2 RoP read in conjunction with Rule 30.2 RoP.

*"When deciding on a subsequent request to amend the patent, the Court must take into account all the relevant circumstances of the case, including whether the party seeking the subsequent amendment is able to justify that i) the amendment in question could not have been made with reasonable diligence at an earlier stage, and ii) the amendment will not unreasonably hinder the other party in the conduct of the action. The Court of First Instance has a margin of discretion in this respect. The review by the Court of Appeal is therefore limited".*

On the facts of that case, the CoA concluded that the application to amend the patent which Edwards submitted in the direct revocation action was admissible (Meril challenged its admissibility when it appealed the failure of its revocation action at the CFI). The CoA held that Edwards could not reasonably have introduced the amendments at an earlier stage and Edwards explained the purpose of the amendments was to present as single set of requests in the direct revocation action and the counterclaims for revocation which had been consolidated at the CD. Edwards could not have done so at the time of filing its Defence to revocation, since Meril India and Meril Germany had not yet lodged their counterclaims for revocation at that point in time. The CoA held that the claim amendment order granted by the judge-rapporteur was within his discretion to allow.

## Transactions in the era of the unitary patent and UPC

### Key issues in transactions involving UPs (and EPs in the context of the UPC)

#### Unitary patents

The Unitary Patent (UP) is a European patent (EP) which has been granted and which the proprietor has requested should have unitary effect, rather than selecting particular EU states be designated. It is a single patent right effective across all EU Member States participating in the UPC system at the date the unitary right is granted. The application process is the same as for a "classical" EP. Once any EP is granted, the proprietor has one month after grant of that EP to request unitary effect, after which any application for unitary effect will be denied (see the UPC CoA's confirmation of this in *Bodycap v EPO* UPC_CoA_796/2025, 16 September 2025).

**Enforcement & revocation:** UPs may only be enforced via the UPC and cannot be litigated in national courts. This has both positives and negatives, streamlining protection and enforcement while giving rise to the risk that a UP could be centrally revoked across all UPC states. This in turn could impact on the perceived value of the patent by any potential purchaser, depending on their attitude to risk or concern about the strength of the patent and so the unitary effect of an EP is worth highlighting during any due diligence process.

**Coverage:** By virtue of this, each UP has its own specific territory however – that of the UPC member states at the date the unitary effect was granted (note not the date the underlying EP was granted. This means that over time, as more EU states join the UPC, there will be greater variation in the coverage of each, depending on their date of grant of unitary status. We already have a distinction between those UPs granted from 1 June 2023, when the UPC commenced hearing cases, to 31 August 2024 (inclusive), which cover only the initial 17 UPC member states (Austria, Belgium, Bulgaria, Denmark, Estonia, Finland, France, Germany, Italy, Latvia, Lithuania, Luxembourg, Malta, Netherlands, Portugal, Slovenia, Sweden) and those granted unitary effect on 1 September 2024 or later, which also cover Romania (ie granted once Romania had fully ratified the UPC Agreement (UPCA) and become a member of the UPC). When further EU states join the UPC this will make a further distinction (and those UPs already in place will not expand their territories but will stay with those of the UPC member states at the date of their grant of unitary effect.

This is a very significant issue to bear in mind therefore when acquiring a UP – check the date of grant of unitary effect as this will determine its reach; do not rely on the current UPC membership as an indication of the states in which you would be able to enforce the UP.

A UP does not cover all the states to which a "classical" EP can be designated. The cost of a UP is approximately the same as maintaining 4-5 individual nationally designated EPs, so it is good value if you intend to cover many more of the UPC states. However, to provide patent coverage for other EPC member states, EPs will need to be designated for those. So an EP application might request unitary effect but also designations for Spain, the UK and Switzerland or Turkey, for example.

**Licensing & assignment:** Although it is possible to licence a UP in part to individual UPC participating states, a UP can only be assigned, (enforced, limited, revoked or lapse) with respect to all those states.

**The law of property that governs a UP:** Consideration should always be given to the law of property governing a UP. For "classical" EPs (those prosecuted through the EPO and then converted into a bundle of nationally designated EPs), the law of property applying to them is the law of the state to which they are each designated. For a UP which covers multiple states, the law of property of each is determined through rules set out in the Unitary Patent Regulation (1257/2012) and involves an examination of the domicile or principal place of business (or a place of business) of the first named applicant. one needs to look at the applicants to determine the law of the UP as an item of property being transferred.

Where the applicant of a granted UP is a single entity, the applicable law that governs how the UP is treated as an object of property is the law of the UPC participating member state in which, according to the EP Register, the applicant has either its residence or principal place of business on the date of filing of the patent application. Where the sole applicant does not reside or have a principal place of business in a UPC participating member state, the relevant governing law is determined as that of the participating member state where the applicant has a place of business on the date of filing the application. If neither apply, the applicable law is determined as German law (the law of the place of the location of the EPO).

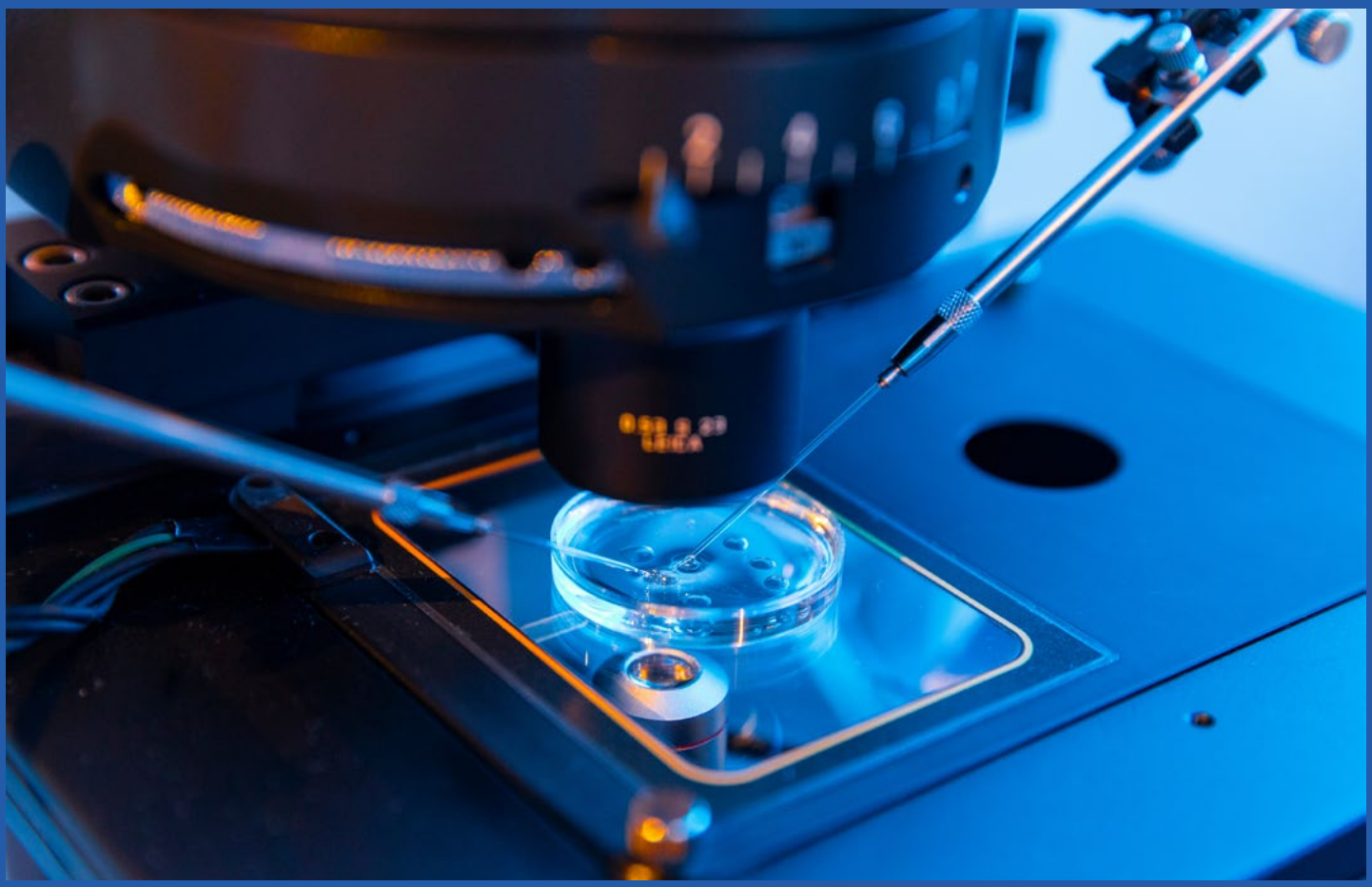
Where there are joint applicants (two or more) then the applicants are considered in the order that they are listed on the patent application. If the first applicant does not fulfil the domicile or principal place of business in the EU test, then the second applicant is examined in this way. If no UPC state is identified, then the third applicant will be examined etc. Only if none of the applicants is domiciled or has a principal place of business in a UPC state will the second question (a place of business) be addressed, also with the first applicant first and then with subsequent ones in order until a UPC sate connection is found. If none is found then, again, German law will apply.

This rather complex assessment is important to consider since the applicable law does not change on transfer and any practicalities needed to register a licence or assignment should follow the applicable law as identified using these tests. As laws on transferring and licencing intellectual property are not the same across all participating Member States, it is important to be aware of what body of law governs the rights and obligations surrounding the ownership of the UP.

This is particularly important where the UP is co-owned. Depending on the jurisdiction of the governing law, there may be limits on the ability of one of the co-owners to assign rights in, mortgage its share of, or grant a licence under the UP without the consent of all other co-owners. Nonetheless, co-owners can agree to vary their rights and obligations contractually. This can set out the approach to assigning rights, obtaining a mortgage or licencing the patent and steps to resolve issues where there is disagreement to mitigate future difficulties. This would not change the registration or other property law and regulations applying to the patent transaction however.

#### Classical EPs and the UPC

**Jurisdiction:** Whilst UPs can only be enforced via the UPC, for a transitional period (7 years from the start of the UPC – so until the end of May 2030) a classical EP may be enforced either in a national court or in the UPC. Once a particular designation of an EP has been the subject of infringement proceedings in a national court it cannot be the subject of such proceedings in the UPC however, so there is a form of "torpedo" effect with respect to the ability to enforce in the UPC in future if an action is brought in the national court.



The converse is also true of course. An appreciation of the history of enforcement of a particular EP designation should therefore be part of any due diligence exercise.

**Opt-out:** For those proprietors who would prefer not to use the UPC and who wish to remove the risk of a revocation action being brought for all their designations in one go at the UPC, then there is the option of opting their EPs out of the UPC's jurisdiction. This is done via the UPC (not the EPO) and is for all designations of the EP (and cannot be for one of a subset of the EP designations) although both thhe EPO register and the UPC's own database will indicate the current opt-out status of anr EP (note that UP's cannot be opted out of the UPC's jurisdiction, it is their only forum) An EP that has been opted out can only be litigated in the national courts. The proprietor can withdrawn the opt-out if it decides that it wishes to use the UPC for enforcement, but not it proceedings have been commenced in a national court already (post 1 June 2023).

The presence or otherwise of opt-outs is a key piece of information for due diligence in the UPC era. Although it is only the proprietor and not a licensee of any sort who can request an opt-out or the withdrawal of such, a licence may provide for the licensee to have some control over the decision to opt-out a patent or not. Exclusive licensees in particular might see the ability or option to enforce in the UPC as an advantage and therefore may wish to have some influence or control over the opt-out or withdrawal of opt-out in their licence terms. Others may consider the risk of revocation of multiple EPs in one forum reduces the value of the licence. Both are considerations for due diligence exercises. Parties should be aware that the extent of control a licensee has over the conduct of proceedings varies. Unless the licencing agreement provides otherwise, the holder of an exclusive licence for a UP can bring an action under the same conditions as the UP proprietor, although must give notice when doing so. As explained, ongoing litigation in the UPC or in a national court can prevent the opt out or withdraw of an opt-out of the patent, limiting the options open to the patent holder. As such, it is important to check what licence provisions have been agreed by the current UP proprietor.

Whether a patent has lapsed or been revoked and whether there are any registered licences or encumbrances under the patent will be recorded in the EPO register. All information should be confirmed with the current patent owner as not all licences and encumbrances are recorded on the EPO register. The UPC database will indicate any current litigation enforcing or attacking the patent as well as any previous litigation outcomes.

It should be noted that the infringement of multiple EPs can now be heard and determined in one EU national court, even where validity counterclaims have been filed, following the CJEU's decision in *BSH Hausgeräte v Electrolux* (C-399/22, 25 February 2025). Once proceedings (post 1 June 2023) have been commenced in a national court, in relation to an EP then the opt-out cannot be withdrawn and an action in the UPC is no longer possible.

*Jonathan Turnbull, Rachel Montagnon, Jess Welborn and Kate Peck*

## 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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