Unified Patent Court Review 2025

Our annual review of cases in the Unified Patent Court

Bristows

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Contents

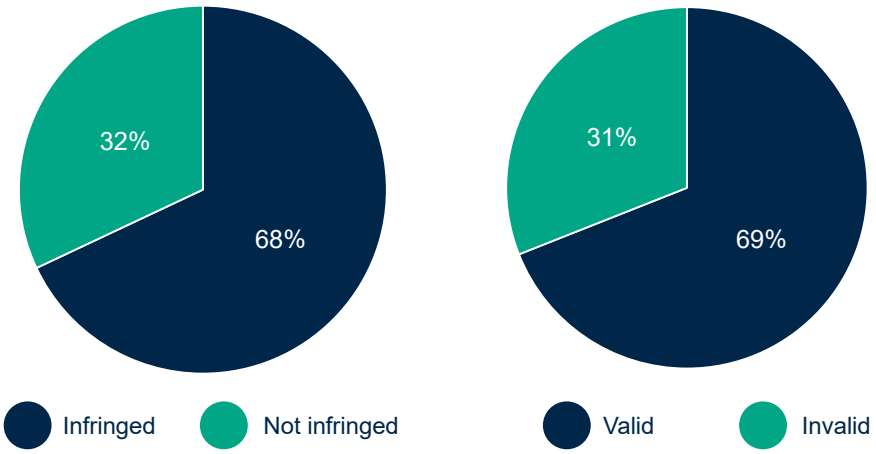
Introduction

The UPC has continued to grow in importance in 2025. Key developments have included establishing jurisdiction over issues relating to European Patents (**EP**s) of non-Contracting Member States following the CJEU's decision in *BSH v Electrolux*[1] and issuing interim measures to prevent anti-suit and anti-enforcement injunctions. The UPC has also introduced a new Case Management (**CMS**) System and consultation has taken place on draft rules for arbitration, mediation and expert determination at the UPC's Patent Mediation and Arbitration Centre (**PMAC**), with plans to open the centre in 2026.

The growing confidence of patentees in the new court system is reflected by the number of cases. From a slow trickle of cases at the UPC's inception in June 2023, the number of infringement actions filed in the UPC now stands at over 400, with more than 70 revocation actions filed against patents that have not been opted out of the system (in this respect, the UPC is still very much a patentee's court until the end of the transitional period, with patentees having full control over whether or not their patents can be challenged in the UPC). The sectors represented in UPC actions have also continued to diversify, with an increasing number of large pharmaceutical companies now choosing to dip their toe into the UPC. We have even seen the first pan-UPC preliminary injunction to prevent sales of a generic pharmaceutical product in *Boehringer Ingelheim v Zentiva*[2].

The German Divisions have continued to be the most popular divisions for infringement actions at first instance, with an extraordinary 78% of UPC infringement actions being filed in German Local Divisions, and 36% of infringement actions being filed in the Munich Local Division. In an attempt to address the growing backlog of cases and an inability to stick to the ambitious timelines set out in the UPC Rules of Procedure, the Munich Local Division introduced a second panel in May 2025. The Court of Appeal has also been extremely busy this year, and introduced a third panel to deal with its increased workload in October 2025.

The UPC is also continuing to prove a patentee-friendly venue with approximately 69% of patents being held valid at first instance (whether in a revocation claim or counterclaim) and approximately 68% of patents being held to be infringed (whether or not validity was put in issue). These statistics may be influenced, as noted above, by the fact that patentees have freedom to control whether or not their patents are subject to the UPC system during the transition period. It may be that they simply reflect patentees putting their best foot forward.



Validity and infringement outcomes in the Court of First Instance from 1 June 2023 to 23 October 2025

1 Case C-339/22

2 UPC_CoA_446/2025; UPC_CoA_520/2025, Order of 13 August 2025

From a developing jurisdiction giving rise to the first injunction on a European patent in a non-EU, non-Contracting Member State and various anti-anti-suit injunctions, to a growing portfolio of substantive decisions on infringement and validity, the authors have endeavoured to cover the important developments in 2025. It is, however, inevitable that not every decision is mentioned, particularly in light of the prolific output of the Courts of First Instance and Court of Appeal. Where an official English language version of an order is not available, the authors have relied on machine translations so, in these instances, quotes may not be exact. For brevity, we use **LD** to refer to Local Division, **RD** to refer to Regional Division and **CD** to refer to Central Division; any reference to an Article (or **Art.**) without further reference refers to the Unified Patent Court Agreement (**UPCA**)[3] and any reference to a Rule (**r.**) refers to a Rule of the UPC Rules of Procedure (**RoP**)[4]. **PI** refers to preliminary injunction.

Claim construction

The question of how to construe claims at the UPC was addressed by the Court of Appeal quite early on, in the seminal case of *10x Genomics v NanoString*[5]. Over the last 12 months the courts have consistently referenced the approach set out in that case, endorsing the principle that the patent claim is the starting point and decisive basis for determining the scope of protection in a manner consistent with Art. 69 EPC and the Protocol on the Interpretation of Art. 69 EPC[6]. As such, the drawings and description must always be used in claim interpretation (not only in cases of ambiguity), but that does not mean that the claim language is relegated to the status of a mere guideline to the protected subject matter. Moreover, the claim is to be interpreted from the view of a person skilled in the art.

Other approaches to claim construction that risked deviating from this principle have been reined in. As discussed further in the **PI section below**, in *Alexion v Amgen & Samsung Bioepis*[7] the Court of Appeal took issue with a decision of the Hamburg LD that suggested a skilled person would interpret the claim in a manner that would provide a technical teaching that, if carried out, would lead to the intended success of the invention. The Court of Appeal called this approach "*legally flawed*" and reiterated that claim construction must be performed in a manner consistent with the principles set out in *10x Genomics v NanoString*.

Further developments have, however, continued to refine this guidance, with the Court of Appeal applying further direction where appropriate.

In *Insulet v EO Flow*[8], the Court of Appeal emphasised that claim interpretation is a matter of law and that it is therefore not for experts to construe the claim. Furthermore, the Court confirmed that the person skilled in the art is a notional legal entity, and not a real person. As such, the individual knowledge and abilities of real people is not the focus, but rather the knowledge that is customary in the relevant specialist field.

The Court of Appeal has also stated in *Meril v Edwards*[9] that as a general rule it can be assumed that product or process embodiments set out in a patent specification are covered by the claims. However, the Court clarified that an exception to this rule exists where the patent as a whole clearly teaches the person skilled in the art that the embodiment is not claimed. This was a case in which the exception applied as the description distinguished clearly between the non-hexagonal prosthetic valve frames depicted in Figures 1 to 4 and the frames according to the claimed invention, which had side struts and hexagonal cells.

3 Agreement on a Unified Patent Court (2013/C 175/01)
4 Rules of Procedure of the Unified Patent Court as adopted by decision of the Administrative Committee on 8 July 2022
5 UPC_CoA_335/2023, Order of 26 February 2024
6 Protocol on the Interpretation of Article 69 EPC of 5 October 1973 as revised by the Act revising the EPC of 29 November 2000
7 UPC_CoA_402/2024 (Samsung Bioepis), Order of 20 December 2024 & UPC_CoA_405/2024, Order of 20 December 2024 (Amgen)
8 UPC_CoA_768/2024, Order of 30 April 2025
9 UPC_CoA_464/2024, UPC_CoA_530/2024, UPC_CoA_21/2025, UPC_CoA_457/2024, UPC_CoA_532/2024, UPC_CoA_27/202, UPC_CoA_458/2024 & UPC_CoA_533/2024 , Decision of 25 November 2025

In *Amgen v Sanofi*[10], the Court of Appeal made two important points in relation to claim construction. First, it said that it is not appropriate in all situations to use the subject matter of dependent claims to construe the main claim. The specific circumstances of the case must be assessed, and if the dependent claim simply adds an additional feature that does not provide a more specific description of the features of the main claim it is unlikely to assist in the interpretation of the main claim. In this instance, the presence of dependent claims to the use of the claimed antibodies together with at least one other cholesterol-lowering agent did not inform the level of required therapeutic effect in the main claim.

Second, with respect to "*medical use*" style claims, the Court stated that an inherent feature of such claims is that the claimed product is "*objectively suitable*" for the claimed use. In other words, the claimed product must be therapeutically effective, and capable of causing a noticeable improvement of the medical condition. See the **Infringement** section for discussion of how the Courts have been approaching infringement of these types of claims.

Guidance has also been provided on how to interpret "*means-plus-function*" claims before the UPC, with the Court of Appeal in *Abbott v Sibio*[11] confirming that the same approach is to be taken as at the EPO and that means-plus-function features are to be understood as any feature suitable for carrying out the invention.

However, one of the developments of greatest relevance to claim construction at the UPC in the last 12 months was not a UPC decision at all, but rather the decision of the Enlarged Board of Appeal of the EPO in *G1/24 ("Heated Aerosol")*. The Enlarged Board's guiding principles align comfortably with the UPC's approach: it concluded that claims are the starting point and basis for patentability but "*the description and drawings must always be consulted to interpret the claims*", not only when the claim language is ambiguous. This pronouncement was explicitly aimed at harmonizing EPO examination practice with UPC case law and the ruling reinforces the convergence between EPO and UPC on claim construction methodology.

Relevance of prosecution history

As noted in last year's Review, diverging approaches had emerged at first instance in 2024 in relation to the relevance of the file history. The Munich LD had relied on the claims as filed to interpret amendments made during prosecution in *SES-imagotag v Hanshow*[12]. The Düsseldorf LD had set out the view in *Ortovox v Mammut*[13] and *10x Genomics v Curio*[14] that the file history did not constitute admissible material for claim construction, although the file history could nevertheless have indicative significance for how the skilled person might understand the claim.

In the past year, further clarity has begun to emerge on the extent to which the file history may be used in claim construction. In *Alexion v Amgen & Samsung Bioepis*[15], the Court of Appeal specifically addressed the issue in what was also a significant case more generally on the topic of claim construction. The Hamburg LD, as Court of First Instance, had taken the view that arguments made by the patentee before the EPO's Boards of Appeal did not have to be considered because they had since been abandoned by the patentee in favour of a different position. However, the Court of Appeal took issue with this approach. It commented that such an approach "*ignores the fact that the patent claim must be interpreted from the perspective of the person skilled in the art*", and that the patentee's arguments during prosecution and "*in particular*" the Board of Appeal's endorsement of these arguments "*can be seen as an indication of the view of the person skilled in the art at the filing date*". While this approach stops some way short of full file wrapper or prosecution history estoppel, it does make the prosecution history an important factor in obviousness assessments.

10 UPC_CoA_528/2024 & UPC_CoA_529/2024, Decision of 25 November 2025
11 UPC_CoA_382/2024, Order of 14 February 2025
12 UPC_CFI_292/2023, Order of 20 December 2023
13 UPC_CFI_452/2023, Order of 9 April 2024
14 UPC_CFI_463/2023, Order of 30 April 2024
15 UPC_CoA_402/2024 (Samsung Bioepis), Order of 20 December 2024 & UPC_CoA_405/2024, Order of 20 December 2024 (Amgen)

This approach has since been explicitly referenced by Courts of First Instance. In *Dyson v Dreame*[16], the Hamburg LD (notably also the first instance court in *Alexion*) referred to the *Alexion* decision, holding that while the file history is "*not by itself relevant for the interpretation of the claim*", the claim must be interpreted by the person skilled in the art, and the prosecution history can be taken as an indication of the skilled person's view. The Paris LD has arguably taken things a step further in *Raccords v First Plast*[17]. In this case the patentee had not only made relevant statements during prosecution, but drew conclusions from these statements and implemented them by way of patent amendment to overcome a novelty objection. The Paris LD implied that this factual difference distinguished the case from *Alexion* and appears to have concluded that the patentee could not deviate from their previous construction, an approach much closer to classic file history estoppel.

The approach therefore does not appear to be entirely settled yet. At a minimum, reference to the file history in order to inform the view of the skilled person has now been endorsed by the Court of Appeal in *Alexion* and may well be the consistent approach going forward in the UPC. Whether there remains a place for prosecution history estoppel in the UPC in certain scenarios, such as that addressed by the Paris LD in *Raccords*, is yet to be determined and may require a further Court of Appeal decision to clarify the position.

Infringement

Infringement under the doctrine of equivalents

In 2024, we saw the first considerations of infringement under the doctrine of equivalents. Most notably, a four-step test set out by The Hague LD in *Plant-e v Arkyne*[18] that bore a striking resemblance to the Dutch national law approach. This year, further decisions from LDs have added more colour to how the UPC might approach the doctrine of equivalents, however the Court of Appeal is yet to provide guidance on this issue.

The earliest decision this year was from the Brussels LD in *Jozef Frans Nelissen v OrthoApnea*[19]. In this decision, the Court did not apply a specific test but considered that the question of equivalence will at least require a preliminary step of analysis to conclude that the *same technical function* is performed.

This case concerned devices used to prevent a patient's tongue slipping back and blocking the airway whilst the patient is asleep. The patent claimed such a device where closure of the jaw is prevented by a "*contact surface*" and a "*stop*" within the coupling element. The Court found that the OrthoApnea product did not prevent the closure of the mouth using parts within the coupling element, but instead by the meeting of the upper and lower sections which fit over the teeth. On this basis there was no literal infringement.

The claimant asserted infringement by equivalents under two tests: the "*function-way-result*" and "*insubstantial differences*" tests. The Court found that a necessary element for both tests is the existence of technical functional equivalence. The technical function of a "*stop*" and "*contact surface*" within the coupling element was to prevent the upper and lower sections from making contact. As these sections did make contact in the OrthoApnea device, the Court found that the functional effect sought in the patent was not present in the OrthoApnea device, and therefore there was no infringement by equivalents, regardless of which test was used. It is worth noting that this requirement also forms part of the first question previously set out by The Hague LD in *Plant-e v Arkyne*.

16 UPC_CFI_387/2025, Order of 14 August 2024
17 UPC_CFI_612/2024, Decision of 24 October 2025
18 UPC_CFI_239/2023, Order of 22 November 2024
19 UPC_CFI_376/2023, Order of 17 January 2025

Similarly, the Mannheim LD considered the question of equivalence in *DISH v Aylo*[20] and considered that there were two requirements: i) the same function being performed; and ii) achieving the same effect:

> *"The substitute means are not equivalent means because they do not essentially perform the same function or achieve essentially the same effect as the substituted means. Therefore, there is no need to decide whether the substitute means identified by the plaintiffs are actually implemented by the contested embodiments."* (emphasis added and machine translation)

This first requirement is the same as that put forward by the Brussels LD in *Jozef Frans Nelissen v OrthoApnea* and, combined with the second, results in the first question of the four-step test set out by The Hague LD in *Plant-e v Arkyne*: "*does the variation solve (essentially) the same problem that the patented invention solves and perform (essentially) the same function in this context?*".

Similarly, the Paris LD considered infringement by equivalents in *NJ Diffusion v Gisela Mayer*[21] and having reviewed the case law to date reached the same conclusion, summarising as follows:

> *...it is appropriate to adopt the most harmonised interpretation possible within the UPC to rule on claims for infringement by equivalence and... it is appropriate to answer first of all a question which is the lowest common denominator and which constitutes the first criterion for examining equivalence: Do the modified (or substitute) means essentially fulfil the same function to obtain essentially the same effect."* (emphasis added and machine translation)

On the basis of these decisions by different divisions it seems likely that the technical function requirement, and the first question of the *Plant-e* test will be a key part of any future UPC test for equivalents.

Most notably this year, we also saw a PI granted on the basis of infringement by equivalents by The Hague LD in *Washtower v Wasombouw*[22]. Washtower initiated PI proceedings against the defendants, alleging infringement of a patent for a washing machine cabinet that holds a washing machine securely at waist level. The defendants argued that there was no infringement as their L-shaped retaining member is made of plastic rather than metal, as required by the claim.

Applying the four-part equivalents test from *Plant-e v Arkyne* (put forward by both parties, and in the absence of a test being set by the Court of Appeal) the Court concluded that the plastic strip performed the same function (preventing the washing machine from sliding off the carrier) with essentially the same result. The Court dismissed arguments that the plastic strip was merely aesthetic, noting that it was positioned and dimensioned to serve a retaining function. It also found that extending protection to cover the plastic variant was fair to the patentee and did not undermine legal certainty for third parties, especially given the absence of any technical reason in the patent why only metal would suffice.

Infringement of second medical use claims

As in national law, UPC legislation does not provide any express provisions regarding infringement of second medical use claims. The approach by national courts in Europe is not yet harmonised on this issue so all eyes are on the UPC to confirm what approach it will take.

20 UPC_CFI_471/2023, Order of 6 June 2025
21 UPC_CFI_363/2024, Order of 1 August 2025
22 UPC_CFI_479/2025, Order of 11 September 2025

The Düsseldorf LD was the first division to tackle second medical use claims in *Sanofi & Regeneron v Amgen*[23]. Noting the difficulty in finding a balance between fair protection for the patentee and a reasonable degree of legal certainty for third parties, the Court stated that, for a finding of infringement "*the alleged infringer must offer or place the medical product on the market in such a way that it leads or may lead to the claimed therapeutic use of which the alleged infringer knows or reasonably should have known that it does*". In the case at hand, which concerned the use of PCSK9 antibodies to lower Lp(a) levels, that required either a prescription in order to lower Lp(a) levels or at least circumstances showing that such a use may be expected to occur. In addition, as a subjective element the infringer must know this, or reasonably should have known.

The Court noted that the requirements of such behaviour cannot be defined in an abstract manner but require an analysis of all the relevant facts and circumstances, which may include:

- the extent or significance of the allegedly infringing use;
- the relevant market, including what is customary on that market;
- the market share of the claimed use compared to other uses; and
- what actions the alleged infringer has taken to influence the respective market either "*positively*", *de facto* encouraging the patented use, or "*negatively*", by taking measures to prevent the product from being used for the patented use.

The package insert and SmPC[24] are "*not always the only decisive factor to be taken into account*", although the decision indicates that they will, unsurprisingly, play a key role in the assessment.

On the facts, the claimants' infringement case failed. The defendants' product, Repatha®, is approved for lowering low density lipoprotein-C (LDL-C) and mixed hyperlipodemia, not for lowering Lp(a) levels. Although physicians could take note of studies reported in the SmPC showing that Repatha could lower Lp(a) levels, there was no evidence that Repatha was actually prescribed for reducing Lp(a) and the potential "*windfall*" effect of lowering Lp(a) alongside reducing LDL-C was considered irrelevant from an infringement perspective. The claimants had not shown any marketing efforts by the defendants aimed at selling the drug for the reduction of Lp(a) or demonstrated that the placement of the product on the market may lead to the claimed use notwithstanding the absence of approval for lowering Lp(a) (which, according to the Düsseldorf LD, could have been shown by providing evidence that such prescriptions had already been made or that there was a substantial likelihood that they would be made).

As with all early UPC decisions, the position is not yet settled, so we look forward to the Court of Appeal considering the point and providing further clarity for originator and generic/biosimilar companies on this issue.

Indirect infringement

Since the last Review, the Court has continued to develop jurisprudence on indirect infringement according to Art. 26. In the key consumables case, *Brita v Aquashield*[25], the Munich LD found that third party water filter cartridges for Brita jugs indirectly infringed the patent. It defined "*means relating to an essential element*" broadly: any component that functionally interacts with a device to realize the inventive concept is an "*essential*" means, and not only elements relating to the "*core*" of the invention or ones that distinguish the claim from the prior art. As such, the Court took the view that "*all features specified in the patent claim are generally essential elements of the invention*". The related issue of what

23 UPC_CFI_505/2023, Decision of 13 May 2025

24 The Summary of Product Characteristics, a regulatory document for medicinal products that forms the basis of information for healthcare professionals on use of the product.

25 UPC_CFI_248/2024, Decision of 22 August 2025

constitutes repair/rehabilitation of a patented product already on the market (thus subject to an exhaustion defence) and what constitutes creation of a new infringing product was also addressed in this case. The Court ruled that while restoration of functionality that had been impaired through wear and tear was permitted as part of a product's intended use, taking measures that result in the reproduction of a product covered by the patent is prohibited. The economic interests of the patent holder in the exploitation of the invention are relevant when addressing this issue.

The boundary between direct and indirect infringement has also been considered this year. In *bellissa HAAS v Windhager*[26], the Mannheim LD took an expansive view of direct infringement. The Court stated that where a patented product is designed so that its components can be easily assembled at the place of use without adding anything else, a simple offer or supply of all of those parts constitutes direct infringement under Art. 25(a), and not mere indirect infringement. Likewise, if a patented device consists of identical coordinated components intended to be assembled (e.g. two interlocking parts), then selling even a single such component can be treated as a direct infringement – not just an indirect one – whenever the assembly is indicated or otherwise obvious. The case in question related to identical lawn edging modules that could be interconnected on site to create an extended border, with the patent requiring two or more of such modules to be interconnected. It remains to be seen how far the Court will extend these principles in cases of more complex kits comprising heterogenous components.

Right of prior use

Decisions this year have reinforced the early decisions expressing the view that there is no pan-UPC private prior use defence under Art. 28. In *Erwin Härtwich & Yellow Sphere v Knaus Tabbert*[27], in the context of a right of prior use assertion in relation to a bundle of European patents, the Düsseldorf LD reaffirmed its previously established view that the narrow wording of Art. 28 means a defendant must plead and substantiate the infringement defence of private prior use in each relevant country. Whether the same test would be applied in relation to a unitary patent remains to be seen.

In *Fujifilm v Kodak*[28], the Mannheim LD took the view - insofar as a private prior use under German law was concerned - that the alleged prior user must have taken a "*firm and final decision*" to use the invention before the priority date.

Intermediary liability

The past year has seen further case law develop on the issue of what constitutes an intermediary in the sense of Art. 63(1) second sentence. In certain cases, having an intermediary amongst the defendants has also allowed the claimant to successfully pursue wider objectives.

In *Dyson v Dreame*[29], the Hamburg LD held that an Authorised Representative in the EU (under Regulations 2023/988/EU on general product safety and 2019/1020/EU on market surveillance and compliance) may be regarded as an intermediary and thus subject to an injunction. In addition, it was held that such an entity is an indispensable party in the distribution of electronic products, and as such, they may be regarded as an anchor defendant under Art. 8(1) of the Brussels I Recast Regulation (addressed in further detail in the **Jurisdiction** section).

26 UPC_CFI_338/2024, Decision of 12 September 2025

27 UPC_CFI_50/2024, Decision of 10 April 2025
28 UPC_CFI_365/2023, Decision of 2 April 2025
29 UPC_CFI_387/2025, Decision of 14 August 2025

Similarly, in *Aesculap v Shanghai*[30], the Düsseldorf LD decided that an Authorised Representative in the EU under the Medical Device Regulation (EU) 2017/745 was at a minimum an intermediary (citing a similar principle set out by The Hague LD in *Arbutus v Moderna*[31]) and, as such, potentially subject to an injunction. In similar situations, where the alleged primary infringer is based in a territory beyond the UPC and subject to a potentially lengthy service period, focussing on the acts of the Authorised Representative may prove to be an effective way to obtain a preliminary injunction under Art. 62 or a permanent injunction under Art. 63.

In a landmark ruling, the Court of Appeal in *Philips v Belkin*[32] overturned the Munich LD's earlier decision[33] that had found Belkin's managing directors liable as intermediaries under Art. 63(1). The Court held that mere status as a managing director does not suffice to establish intermediary liability. Managing directors may only be held liable if their conduct goes beyond typical professional duties, such as deliberately using the company to commit patent infringement or failing to act despite knowledge of the infringement. Liability will only arise if the managing director is aware that the company's acts infringe the patent. Furthermore, reliance on legal advice may shield them from liability until a decision has been issued by the Court of First Instance establishing the company's patent infringement. The Court also reiterated its earlier position[34] that the managing director of a company cannot be a "*third party*" in relation to that company and therefore cannot be an intermediary. It remains to be seen whether the Court of Appeal will similarly limit the expansive approach taken by the Courts of First Instance as to whether Authorised Representatives can be treated as intermediaries.

30 UPC_CFI_213/2025, Order of 10 July 2025
31 UPC_CFI_191/2025 & 192/2025, Order of 23 May 2025
32 UPC_CoA_534/2024, UPC_CoA_19/2025, UPC_CoA_683/2024, Decision of 3 October 2025
33 UPC_CFI_390/2024, Decision of 13 September 2024
34 UPC_CoA_549/2024, Order of 29 October 2024

Declarations of non-infringement (DNIs)

The UPC is yet to issue a decision in response to a request for a DNI, with only a handful of such requests having been filed and all such requests having been subsequently withdrawn or rejected. The UPC has competence to grant such declarations under Art. 32.

The most recent standalone claim for a DNI is *Accord v Novartis*[35]. Accord filed a claim at the Milan CD for a DNI relating to Novartis' patent protecting the administration of nilotinib (an anti-cancer medication) dispersed in apple sauce. However, the parties settled the proceedings, which were closed without any finding by the Milan CD[36]. Previously, in *Tandem v Roche*[37], Tandem had filed a revocation action and DNI in the Paris CD in November 2023, relating to a patent held by Roche in the field of insulin infusion therapy. In response, Roche filed an infringement claim in the Hamburg LD within 3 months of Tandem's filing so the DNI action was stayed pursuant to Art. 33(6)[38]. However, in June 2025, the Paris CD confirmed that the parties had concluded a confidential settlement agreement[39] and the DNI case was therefore closed. In *Netgear v Huawei*[40], Netgear had filed a DNI action at the Munich LD against two of Huawei's patents concerning its Wi-Fi 6 technology but, again, a settlement between the parties was reached in early 2025 and the DNI action was withdrawn.

DNIs in response to infringement actions

In *Abbott v Dexcom*[41] in The Hague LD, Dexcom applied to amend its counterclaim to include a DNI following withdrawal of part of the infringement claim by Abbott. The amendment was allowed, as it could not have been filed at an earlier stage of the proceedings. However, the claims were later withdrawn, and the proceedings were closed in January 2025[42].

35 UPC_CFI_698/2024
36 UPC_CFI_698/2024, Order of 1 April 2025
37 UPC_CFI_454/2023, UPC_CFI_455/2023
38 UPC_CFI_455/2023, Order of 25 March 2024
39 UPC_CFI_455/2023, Order of 12 June 2025
40 UPC_CFI_152/2024, Order of 10 January 2025
41 UPC_CFI_424/2023
42 UPC_CFI_424/2023, Order of 29 January 2025

Another case in which a defendant sought to introduce a DNI to an infringement action is *Cretes v Hyler*[43]. Following several rounds of pleadings, Hyler sought to introduce a claim for a DNI based on proposed amendments to its product. However, the Brussels LD determined that the correct procedure under r. 263 (request for amendment of claim) had not been followed. Hyler was also unable to convince the Court that the claim could not have been brought earlier "*with reasonable diligence*" so the DNI claim was rejected[44].

We will therefore need to wait a little longer for guidance on the Court's approach to DNIs and to assess whether this will prove to be a useful tool for potential defendants in the UPC beyond encouraging settlements.

Validity

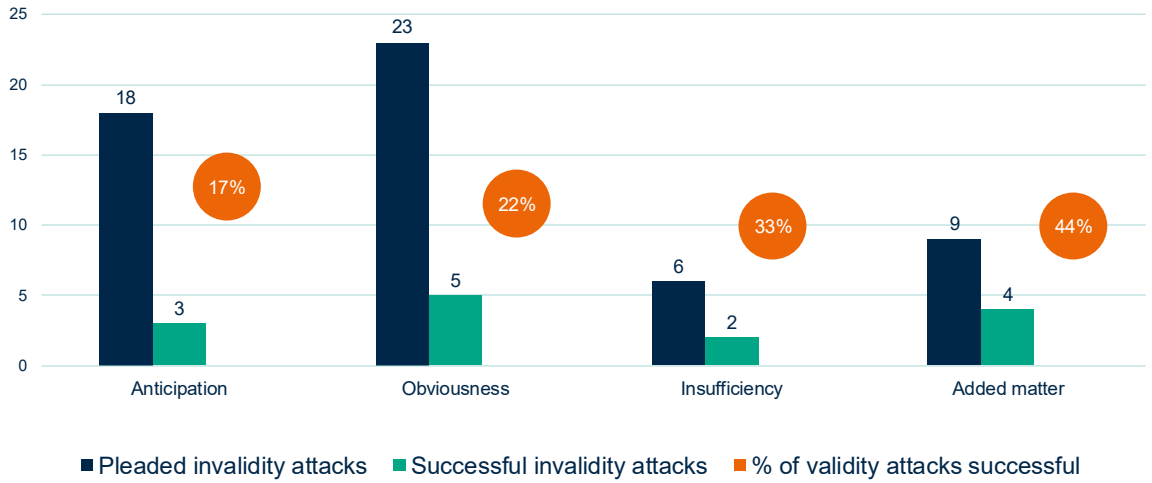
The last year has seen a number of validity decisions by Courts of First Instance and the Court of Appeal, both in the context of PI proceedings (as part of which the Court will assess whether it is more likely than not that the patent is valid), and in main action revocation proceedings and main action infringement proceedings with a counterclaim for revocation.

The overall statistics are interesting, indicating that added subject-matter has been the most successful validity challenge to date, with 44% of patents challenged being found invalid for added subject-matter. Surprisingly, patent challengers have had limited success with obviousness attacks so far, with only 22% of such attacks succeeding. Whether this is reflective of the strength of the patents being challenged in the UPC (bearing in mind that only unitary patents and European patents that have not been opted out may be the subject of a validity attack) or a more permissive approach to inventive step in the UPC remains to be seen.

Two and a half years into the new system, we are starting to see some of the discrepancies in approach by different first instance divisions being ironed out and, in some areas, clarity as to the UPC's preferred approach beginning to emerge.

Novelty

We have continued to see the familiar theme of the EPO's "*gold standard*" in novelty assessments this year. In an excellent summary of case law to date (so much so that it is copied in full below) the Hamburg LD succinctly set out the relevant test and its considerations in *AGFA v Gucci*[45]:



Outcomes of validity attacks at first instance from 1 June 2023 to 23 October 2025

43 UPC_CFI_216/2024; UPC_CFI_556/2024
44 UPC_CFI_216/2024, UPC_CFI_556/2024, Order of 20 February 2025
45 UPC_CFI_278/2023, Decision of 30 April 2025

> *For lack of novelty to be found, each and every feature of the claimed subject-matter must be derivable directly and unambiguously from one single prior art document. This question must be answered from the vantage point of the notional skilled person, taking into account this person's common general knowledge at the publication date of the cited document in the case of prior art cited under Art. 54(2).*
>
> *For the purposes of assessing novelty it is not relevant which problem is solved by a prior art document as long as the problem is not a feature of the claim or construed as such. Relevant is a feature-by-feature comparison of a claim with the teaching of a document of the prior art showing that all features are disclosed in combination by said prior art document. The decisive point is whether a prior art document discloses a composition that contains all the ingredients required for falling within the ambit of the claim. If such composition is described, for example, in an individualized form in an example of a prior art document, this is sufficient to deny novelty. Nevertheless, in assessing novelty, it is not possible to combine different passages or embodiments of a document, except if the corresponding combination is derivable directly and unambiguously by the skilled person reading this document.*" (emphasis added)

Further decisions have added colour to this assessment in different contexts, such as implicit disclosure, inevitable results, public prior use and second medical use claims.

Purpose-oriented features

The Munich LD considered how to approach the assessment of novelty in relation to purpose-oriented features in *Brita v Aquashield*[46], stating that purpose features generally define a product in such a way that it must be *suitable* for being used for the function and purpose stated in the patent claim. In outlining the impact such features have for novelty assessments, the Court stated that the assessment of novelty generally depends solely on whether the prior art discloses a device comprising all the structural and physical features required by the patent for the device. This is different only if the device disclosed in the prior art is unsuitable for the intended use of the patent or would first need to be modified in order to be used for that purpose.

Implicit disclosure and inevitable results

Similar to the case law on added matter, implicit disclosure can be a key element of the assessment of novelty. The Düsseldorf LD addressed this in *Fujifilm v Kodak*[47], stating that "*Implicit disclosure means no more than the clear, immediate and unambiguous consequence of what is explicitly mentioned in a prior-art document... Therefore, "implicit disclosure" encompasses any feature which a person skilled in the art would objectively consider as necessarily implied in the explicit content of a prior-art document, e.g. in view of general scientific laws.*"

The Düsseldorf LD also touched on the issue of anticipation by inevitable result, outlining how a claimed feature is also implicitly disclosed if, in carrying out the teaching of a prior art document, the skilled person would inevitably arrive at a result falling within the terms of a claim.

Continuing the theme of inevitable results, the Mannheim LD made similar statements in another *Fujifilm v Kodak* case[48]. The Court emphasised that when assessing novelty, the disclosure of a prior art document also extends to a result which is automatically achieved as a result of working a procedure, provided it is described in a manner that allows the skilled person to do so (i.e. in an enabling way). However, the Court rejected arguments by the defendant based on a (re)working by one of the named inventors of the prior art citation, who stated that he carried out the reworking by

46 UPC_CFI_248/2024, Decision of 22 August 2025

47 UPC_CFI_355/2023, Decision of 28 January 2025
48 UPC_CFI_365/2023, Decision of 2 April 2025

applying "*the same procedure*" he used "*at that time*". The Court did not consider this reflective of process conditions which the average person skilled in the art in the art would be able to extract from the disclosure of the document, as it was based on specialist knowledge of one of its inventors, and therefore rejected the argument of an inevitable result. This suggests that greater emphasis may have been placed on the same evidence had it come from an independent expert who the Court would have deemed more reflective of the skilled person, who would have had to rely on the common general knowledge to determine any process conditions missing from the prior art citation.

Novelty of second medical use claims

As noted above, this year also saw the UPC's first consideration of second medical use claims, by the Düsseldorf LD in *Sanofi & Regeneron v Amgen*[49], which related to the use of PCSK9 inhibitors to lower lipoprotein(a) (**Lp(a)**) levels.

Where a substance or composition is already known, it may still be patentable under Art. 54(4) EPC if the known substance or composition was not previously disclosed for use in a method referred to in Art. 53(c) EPC. Where a substance or composition is already known to have been used in a "*first medical use*", it may still be patentable under Art. 54(5) EPC for any second or further use in a method referred to in Art. 53(c) EPC, provided that use is novel and inventive.

Applying these principles, the Düsseldorf LD found the patent in suit novel. There was no prior art document that directly and unambiguously disclosed the use of an anti-PCSK9 antibody for lowering Lp(a) levels, let alone in patients with the specific claimed characteristics (risk of cardiovascular disease, not on a therapeutic statin and exhibiting serum Lp(a) levels above 30 mg/dL).

The Court rejected the defendants' argument that the known use of PCSK9 inhibitors to lower low-density lipoprotein cholesterol levels inherently encompasses the use of PCSK9 inhibitors to lower Lp(a) levels because this result occurs as an "*automatic and inevitable effect*", finding that such a view would amount to ignoring the notional novelty of second medical use claims as afforded by Art. 54(5) EPC. Rather, the relevant question for assessing the novelty of second medical use claims is whether the *therapeutic use as claimed* is directly and unambiguously disclosed in the prior art.

Public prior use

This year has also seen the first decisions covering attacks based on public prior use. These decisions suggest that the threshold for evidence of public prior use is quite high, consistent with the EPO's body of case law and many national law approaches.

In *Fujifilm v Kodak*[50], the Mannheim LD rejected a public prior use attack for lack of evidence, in particular lack of evidence to refute an implicit confidentiality regime.

The defendants had argued that 70 of 300 printing plate precursors had been used in private testing but the remaining 230 printing plate precursors remained in the possession of an entity which could allegedly "*freely dispose of them and planned to use them for a job at the end of June*". There were allegedly "*no instructions as to how [the entity] should proceed with the test plates or dispose of them after use or how to discuss the results with other partners within the trade*".

The Court found that these facts were not sufficient to show that there were no confidentiality restrictions in place. Rather, the fact that the tests carried out and the results of such tests were dealt with in a report marked as "*confidential/for internal use only*" suggested the contrary. The same report also stated that the remaining plates would be used for printing jobs of other entities, and this

49 UPC_CFI_505/2023, Decision of 13 May 2025

50 UPC_CFI_365/2023 and CFI_359/2023, Decision of 2 April 2025

indicated that the plates were not intended for external use or distribution. Crucially, the Court considered that the facts presented gave no indication whatsoever that an interested member of the public would have been granted access to the test plates.

The Court indicated that it would have been decisive, in their eyes, for the defendants to submit facts and present evidence that the entities involved in these test runs understood the delivery not to be subject to any confidentiality restrictions and that the test plates could therefore be shared with anyone. Because the defendants did not offer any evidence in the form of witnesses from the entities involved to support the allegations, the necessary burden of proof was not met.

In PI proceedings at the Hamburg LD in *Steros v Otec*[51], the defendant attempted to run a defence on the basis of prior public use. The relevant features of claim 1 were: "*a set of solid electrolyte particles, comprising solid particles that retain a conductive solution, the set presenting an electrical conductivity greater than 10 µS/cm... and a non-conductive fluid immiscible in the conductive solution... the non-conductive fluid when being at rest at room temperature not significantly conducting electrical current*".

The defendant claimed that prior to the priority date of the patent it had sold an electropolishing machine with an electrolytic medium comprising: a) a set of solid particles; and b) an emulsion comprising both conductive and non-conductive components immiscible in the conductive solution. By way of evidence, the defendant submitted a safety data sheet and conductivity measurements for the emulsion alone and the emulsion with the solid electrolyte particles.

The Court found that one feature of claim 1 (requiring a set of solid electrolyte particles retaining a conductive solution with electrical conductivity >10 µS/cm on the Court's construction) was not directly and unambiguously disclosed in the public prior use because the defendant had failed to provide conductivity measurements for the set of solid electrolytic particles alone. Furthermore, when this was challenged by the applicant, a subsequent witness statement regarding the testing was ambiguous and lacked clarity on whether the correct component was measured.

Finally, the Court commented that because the attacked embodiment of the defendant and the alleged prior use differed in their composition, no conclusion could be drawn regarding the measurements of the attacked embodiment (the measurements which had been performed by the applicant) with regard to the public prior use.

Whilst not ultimately successful in invalidating the patent, in *AGFA v Gucci*[52] the standard of proof for demonstrating an earlier product was publicly available on the market was met by the defendants submitting a wealth of evidence including an excerpt from worldwide direct sales data, receipts, a table showing the website traffic for the website featuring the product, and other publications such as excerpts from an editorial and fashion magazines. They also submitted two witness statements, one concerning sales data and another regarding the manufacturing process. Taken together, this evidence left little room for doubt that the products were already on sale prior to the filing date of the patent in suit. However, in the end, they were found to not be novelty destroying.

We are yet to see any successful public prior use attacks, but hope that future decisions will continue to clarify the level and nature of evidence the Court will require in such cases.

Inventive step

Shortly before publication of this edition of the Review, last year's key question of whether the UPC would adopt the EPO's problem-solution approach was resolved by two decisions, issued on the same day, in the appeals in

51 UPC_CFI_281/2025, Decision of 16 June 2025

52 UPC_CFI_278/2023, Decision of 30 April 2025

Sanofi v Amgen[53] and *Meril v Edwards*[54]. These decisions, issued from two different panels of the Court of Appeal, were clearly aligned in their guidance on inventive step, both adopting a "*holistic*" approach rather than adhering to the problem-solution approach. The headnotes provide clear guidance on the steps to be taken and are summarised below, following a brief review of the case law that led us to this point.

Conflicting approaches at first instance

Before the Court of Appeal settled the matter, many LD decisions were already indicating a slightly divergent practice from the EPO's problem-solution approach, aligned with what we referred to in last year's Review as a "*multifactorial approach*", first seen in the PI appeal decision in *10x Genomics v NanoString*[55]. However, more recently, there had been some calls for the UPC to adopt the EPO's approach for the sake of legal certainty and harmonization, and a number of LDs applied this approach.

Until the definitive guidance on this issue arrived from the Court of Appeal, most parties were playing it safe, addressing inventive step following both the EPO problem-solution approach and the "*multifactorial approach*". However, following the Court of Appeal's guidance, it is clear that the latter is the way forward.

The biggest resistance we have seen against the multifactorial approach has been from the most active LD at the UPC, the Munich LD, for example in *Meril v Edwards*[56]. In this decision, the Munich LD acknowledged that the two differing approaches described above had been applied by LDs in the past and had the following to say on which was the correct test to apply in assessing inventive step:

> *For assessing whether an invention shall be considered obvious having regard to the state of the art, the problem-solution approach developed by the European Patent Office shall primarily be applied as a tool to the extent feasible to enhance legal certainty and further align the jurisprudence of the Unified Patent Court with the jurisprudence of the European Patent Office and the Boards of Appeal*." (emphasis added)

For a contrasting decision that exemplifies other first instance divisions that have continued to favour the multifactorial approach, we can look to the Paris CD in *NJOY v VMR*[57]. In this revocation action, the Paris CD outlined a test for inventive step that followed many of the previous decisions seen last year. The Court summarised this as, first, requiring a determination of one or more teachings in the prior art that would have been of interest to a person skilled in the art who, at the priority date of the patent in suit, was seeking to develop a product or process similar to that disclosed in the prior art (i.e. "*realistic starting points*"). Second, it must be assessed whether it would have been obvious for the skilled person to arrive at the claimed solution to the "*underlying technical problem*" on the basis of a realistic disclosure of the selected prior art. This appears to be slightly different to the "*objective technical problem*" of the EPO's problem-solution approach. The EPO's "*objective technical problem*" is framed based on differences over the prior art. In contrast, the "*underlying problem*" of the UPC is framed based solely on the teachings of the patent, i.e. the problem the patent sets out to solve.

The Paris CD went a step further in *Meril v Edwards*[58]. With reference to supporting Court of Appeal case law (in the context of PIs), the Court expressly endorsed what it referred to as the "*holistic approach*". The Court described this as a "*broader way of assessing non-obviousness by considering the invention as a whole, rather than just focusing upon isolated*

53 UPC_CoA_528/2024 and 529/2024, Decision of 25 November 2025
54 UPC_CoA_464/2024 et al, Decision of 25 November 2025
55 UPC_CFI_2/2023, Order of 15 December 2023
56 UPC_CFI_501/2023, Decision of 4 April 2025
57 UPC_CFI_311/2023, Decision of 21 January 2025
58 UPC_CFI_434/2024, Decision of 20 October 2025

distinguishing features" and emphasised that in general, this is more appropriate. The reference to isolated distinguishing features appears to be a clear reference to the problem-solution approach.

Expanding upon its statements in *NJOY v VMR*, the Court outlined three steps that this "*holistic approach*" entails:

1. the identification of the objective problem underlying the claimed invention, which must be carried out in light of the patent's specification;
2. the identification of the state of the art at the time of the claimed invention, which can be represented by one or more realistic starting points and is left to the initiative of the parties; and
3. whether it would have been obvious for the person skilled in the art to arrive at the claimed solution.

The Court also provided some commentary on what constitutes a realistic starting point for the purpose of this test, stating that a realistic starting point is a document "*of interest*" for solving the objective problem. According to the decision, in general, realistic starting points are those which a) disclose the main relevant features of the challenged patent and b) for that reason constitute the basis for the development of the inventive idea and/or address the same or a similar underlying problem.

The Court of Appeal's approach

In *Meril v Edwards* and *Amgen v Sanofi*, the Court of Appeal has now endorsed the "*holistic*" approach, which is presented as being derived from the principles first set out by the Court of Appeal in *10x Genomics v NanoString*[59]. In both decisions, the Court of Appeal acknowledged that national courts have adopted various tests to assess inventive step, including the problem-solution approach used by the EPO, and the "*holistic*" approaches used in the UK and Germany. The Court commented that, when properly applied, these approaches "*should and generally do lead to the same conclusion*". However, the guidance is clear - the holistic approach is preferred by the UPC and the headnotes set out clear steps to be followed in the analysis.

The Court of Appeal's guidance can be broadly summarised as comprising three steps that mirror those outlined by the Paris CD in *Meril v Edwards*[60]:

1. framing the "*objective problem*" of the invention;
2. selecting one or more realistic starting points in the prior art; and
3. assessing whether the claimed solution would be obvious, starting from each realistic starting point in light of the objective problem, specifically whether the skilled person would be motivated to implement the claimed solution as the next step (i.e. would, not only could).

What is the objective problem?

The Court of Appeal has confirmed that this should be assessed from the perspective of the skilled person with their common general knowledge at the priority date. It must not contain pointers to the invention and is to be based on the claim as a whole, in the context of the description and the drawings. In this context, the objective problem should be based on the technical effect that the skilled person understands to be achieved on the basis of the application. This is different to the EPO's approach, where the problem is instead framed by reference to distinctions over the prior art.

What is a realistic starting point?

A starting point is realistic if it would have been of interest to the skilled person who wishes to solve the underlying problem. This may be the case if the relevant piece of prior art already discloses several features similar to those relevant to the invention as claimed and/

59 UPC_CFI_2/2023, Order of 15 December 2023

60 UPC_CFI_434/2024, Decision of 20 October 2025

or addresses the same or a similar underlying problem as that of the claimed invention. There may be more than one realistic starting point and in those cases "*the claimed invention must be inventive starting from each of them*".

The Court of Appeal confirmed that the relevant field of technology is not only the field relevant to the objective problem, but also fields where the same or a similar problem has arisen and of which the skilled person must be expected to be aware.

When will a claimed invention be obvious?

The Court of Appeal clarified that a claimed invention will be obvious if the skilled person would (not only could) arrive at the claimed solution, starting from a realistic starting point and wishing to solve the objective problem. This is similar to the EPO's "*could-would*" approach.

The Court of Appeal stressed that the skilled person is uninventive, and for a claimed invention to be obvious, there must be a pointer or motivation from the starting point that would lead the skilled person to implement a modification resulting in the claimed invention as the "*next step*", with a reasonable expectation of success in solving the objective problem. A solution is obvious where the skilled person would take the next step, indicated by the pointer, if the next step was clearly predictable, or if they would do this as a matter of routine.

When the patentee brings forward and sufficiently substantiates uncertainties and/or practical or technical difficulties with a proposed next step, the burden to prove the expectation of success then lies with the party asserting invalidity. A reasonable expectation of success implies that whilst the skilled person may perform some routine experimentation as part of the next step, they must also have been able to rationally predict, based on the known facts, that this work would be successful.

This question will always depend on the circumstances of the case. The more unexplored the technical field, the lower the expectation of success. Practical and technical difficulties, as well as the costs involved in testing whether the desired result will be obtained, are also relevant factors. However, generally, the stronger the pointer to the claimed solution, the lower the threshold for a reasonable expectation of success.

With guidance now set from the Court of Appeal on inventive step we have no doubt that next year will see a wealth of further case law applying these steps in the assessment of inventive step. For now, parties can at least be assured that they need not apply the problem-solution approach in their submissions before the Court.

Added subject-matter

Last year, we saw added subject-matter being assessed at the UPC following an approach reminiscent of the EPO's "*gold standard*", requiring that claimed subject-matter is disclosed directly and unambiguously in the application as filed. The first decision we covered in this regard was The Hague LD's PI decision in *Abbott v Sibio*[61]. This year, the first decision we look at is that of the Court of Appeal overturning it[62].

At first instance, The Hague LD had explicitly applied the EPO's "*gold standard*" test to find that the patent more likely than not contained added matter *via* an intermediate generalisation due to the omission of an elastomeric sealing member or a second elastomeric unit in the wording of the claim. They denied a PI accordingly.

However, the Court of Appeal applied a more nuanced approach, characterising the disclosed subject-matter as:

61 UPC_CFI_131/2024, Decision of 19 June 2024
62 UPC_CoA_382/2024, Order of 14 February 2025

> *...what the skilled person would derive directly and unambiguously using his common general knowledge and seen objectively and relative to the date of filing, from the whole of the application as filed, whereby implicitly disclosed subject matter, i.e. matter that is a clear and unambiguous consequence of what is explicitly mentioned, shall also be considered as part of its content*". (emphasis added)

The Court noted that "*the assessment of added matter cannot be restricted to only those parts of the original application which the patent proprietor indicated as a basis for an amended claim during the examination proceedings at the EPO, since a proper understanding of these parts also requires an assessment of their content in the context of the disclosure of the application as a whole*".

Although these principles align with the EPO's "*gold standard*" approach and earlier case law, the Court of Appeal placed particular emphasis on the fact that implicit disclosures must be taken into account. Applying this approach, the Court of Appeal reached a different conclusion to The Hague LD, finding that claim 1 did not contain an unallowable intermediate generalisation. The core basis of this finding was that the original application did not provide "*any particular guidance in terms of specific advantages or disadvantages of the various methods of sealing, neither in general, nor in relation to specific configurations*". The Court of Appeal was satisfied that, when looking to the function of the elastomeric sealing, the skilled person would understand that "*the exact method of sealing does not contribute to, and is thus not relevant for, the technical teaching of the invention as disclosed in the original application...*" and the skilled person "*would not consider the use of an elastomeric sealing to be necessary for achieving the overall aim and effect of the invention*". In effect, the lack of any disclosure regarding a technical distinction in this regard was taken as an implicit disclosure to the skilled person that the features were not strictly required. These statements suggest that the Court might take a more patentee-friendly approach regarding added matter in relation to features that are not core to the inventive concept.

A similar approach was followed by the Paris LD in *Hurom v NUC*[63]. When considering whether Hurom's claim amendments added matter *via* an alleged intermediate generalisation, the Paris LD applied the Court of Appeal's test from *Abbott v Sibio*. In doing so, the Court rejected the defendant's arguments that different features were "*inextricably linked*" as the defendant had not demonstrated such a link and "*the skilled person would understand that in describing an embodiment, features may be used to illustrate its working that are not necessarily an essential part of the invention*".

More recently, in *Sanofi v Amgen*[64], the Court of Appeal appears to have again taken a slightly more lenient approach than the EPO might have. The Court stated that literal support is not required, nor is it required that all features of the claim can be found in one paragraph or one example of the application. Rather, it is sufficient if the skilled person can derive the subject matter of the claim from the application as a whole. The defendants ran an argument that appears similar to the EPO's "*two-lists principle*": that each of the features required a selection from lists and that there was no pointer for the skilled person to the specific combination of the features of the claim. However, based on the facts of the case, this argument was rejected by the Court. The Court considered that the fact that the application also provides alternatives for features of the claim does not necessarily mean the skilled person is required to make an arbitrary selection from various lists.

63 UPC_CFI_758/2024, Decision of 23 May 2025
64 UPC_CoA_528/2024 and 529/2024, Decision of 25 November 2025

However, the first main action decision on added matter from the Court of Appeal in *expert v Seoul Viosys*[65] suggests that the Court will not always be so generous to patentees. This decision focusses entirely on added matter, finding the patent to be invalid and overturning the original decision of the Düsseldorf LD.

At first instance[66], the Düsseldorf LD determined that the skilled person would recognise that the features in question were not the important technical features of the invention and so the skilled person would recognise that they could be generalised further than features directly related to the inventive concept. However, the Court of Appeal rejected this on the facts of the case. Whilst repeating the statements from *Abbott v Sibio*, including the emphasis on implicit disclosure, the Court of Appeal pointed to a statement made in the parent application describing technical advantages of the invention that arise because of a combination of the missing feature (a *plurality* of mesas) with other features. On this basis, the omitted feature could not be considered irrelevant in the Court of Appeal's view and at least partly contributed to the inventive concept. Further, none of the other embodiments of the parent application provided the necessary basis as they related to different embodiments to the claims.

Notably, the Court of Appeal stated:

> *In the absence of any clear indication to this effect in the parent application and a substantiation by Viosys – for example by a Party expert opinion – which shows that the skilled person inevitably assumes that the cutting process results in... a single mesa, the mere theoretical possibility that... a single mesa could be produced is not sufficient to constitute a clear and unambiguous disclosure*." (emphasis added)

This suggests that where added matter issues are finely balanced it may be useful to rely on expert evidence to support a party's position. The case also demonstrates that whilst statements and earlier decisions may suggest that the UPC's approach to added matter may be more lenient than the EPO's strict gold standard, the presence of implicit disclosure will be very fact-sensitive.

In the recent decision of *Meril v Edwards*[67], the Court of Appeal also found that there had been an intermediate generalisation, although this time in line with the first instance decision. The Court stated "*As correctly observed by the Central Division, added matter may result from an intermediate generalisation, i.e. the extraction of a specific claim feature from an originally disclosed combination of features. There will be added matter where the person skilled in the art would not [sic] consider the use of omitted features necessary for achieving the overall aim and effect of the invention based on their common general knowledge*." This finding was also in line with findings from the EPO's Opposition Division and Board of Appeal for a related patent in the same family.

This spread of cases, including the fact that the Court of Appeal has now overturned first-instance decisions on added matter twice, means the debate over whether the UPC or the EPO has a more rigid added-matter standard is likely to continue - or, indeed, whether they are more alike than first thought. Regardless, intermediate generalisations will continue to present a threat for patentees.

Priority

The few detailed assessments of priority we have seen this year mirror the approaches to added matter and novelty discussed above, and are reminiscent of the EPO's "*gold standard*". Many decisions simply cross-refer to conclusions regarding added matter when making findings on priority (where the issues in dispute are the same). Furthermore, this year we are seeing decisions explicitly refer to

65 UPC_CoA_764/2024, Decision of 2 October 2025 (a decision of the same panel of the Court of Appeal as *Abbott v Sibio* – Panel 2)
66 UPC_CFI_363/2023, Decision of 10 October 2024
67 UPC_CoA_464/2024 et al, Decision of 25 November 2025

the gold standard. For example, in *Plant-e v Arkyne*[68] The Hague LD stated the following:

> *...the requirement of "the same invention" in Article 87 EPC is met if the skilled person can derive the subject-matter of the claim of an invention directly and unambiguously, using common general knowledge, from the previous application as a whole (the so-called 'gold standard'), in line with EPO case law and the standard used in several Contracting Member States."* (emphasis added)

Applying these considerations to the case at hand, The Hague LD rejected an argument from the defendants that priority was not valid because claim 13 of the priority document disclosed a feedstock containing an electron donor compound whereas in the corresponding claim of the patent, the phrase "*an electron donor compound*" was not mentioned as a feature of the feedstock. The Court agreed with the patentee that priority is to be assessed, using common general knowledge, from the previous application as a whole, rather than from the claims of the previous application only. One paragraph of the description taught that it was optional for the feedstock to contain an electron donor compound, which was sufficient for priority to be upheld.

Similarly, in *Fujifilm v Kodak*[69] the Mannheim LD explicitly stated that the decisive element in this context is "... *what is being disclosed by the priority document as a whole and the same test as for novelty applies*".

Practitioners should therefore be mindful of the larger bodies of case law on novelty and added matter (especially implicit disclosures) when considering priority issues at the UPC.

Sufficiency

Case law addressing sufficiency continues to develop and still draws heavily on established EPO principles.

An example of this is The Hague LD's assessment of an insufficiency attack in *Plant-e v Arkyne*[70]. The Court first set out how the skilled person wishing to implement the claimed invention would read the claims "*in a technically sensible manner*", which appears similar to the concept of a "*mind willing to understand, not a mind desirous of misunderstanding*" seen in EPO case law[71]. The Court went on to say that, in line with this principle, an objection of insufficient disclosure of the invention is not to be based on embodiments that are meaningless and not consistent with the teaching of the application as a whole (with a reference to T 521/12).

The Court summarised the purpose of the sufficiency requirement as:

(i) to ensure that the application contains sufficient technical information to enable a skilled person to put the invention as claimed into practice; and

(ii) to enable the skilled person to understand the contribution to the art which the invention as claimed has made.

In relation to one feature, the defendant had pointed out that the term "*living plant*" was defined broadly in the patent and that the patent did not explain which plants would actually work best in the invention. They argued that the skilled person could not carry out the invention because it only worked with certain species of grass that are able to withstand waterlogging, which was not disclosed in the patent. However, the Court was of the opinion that the skilled person would interpret the term "*living plant*" in line with the term "*energy plant*" used elsewhere in the patent, in the sense of a plant that produces organic compounds as electron donors, and that the skilled person would

68 UPC_CFI_239/2023, Decision of 22 November 2024
69 UPC_CFI_365/2023, Decisions of 2 April 2025
70 UPC_CFI_239/2023, Decision of 22 November 2024
71 For example, in T 1084/10, T 1009/12, T 916/15

recognise that the type of "*living plant*" for use with the claimed method and device would depend on the specific application and situation, including environmental conditions. The plant characteristics that the defendant mentioned were based on a report published by Plant-e in 2014 regarding use in wetlands and the Court found that they related to a specific environment that did not apply to other applications of the invention, and so did not cast doubts on sufficiency of the claim.

The Court of Appeal has also set guidance on sufficiency in the merits appeal of *Sanofi v Amgen*[72], summarising the test as "*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*." The Court of Appeal stated that an invention is sufficiently disclosed if the patent specification shows the skilled person at least one way, and in the case of functional features, one technical concept of performing the claimed invention. On the topic of functional features, the Court of Appeal also clarified that where a claim contains one or more functional features, it is not required that the disclosure includes specific instructions as to how each and every conceivable embodiment within the functional definition should be obtained and one such way may be enough.

The Court of Appeal therefore appears to be setting some constraints on sufficiency attacks, also making it clear that a "*reasonable amount*" of trial and error does not prevent an invention from being enabled. Interestingly, the sufficiency attack from the defendants in this case was rejected in part because no "*proof of a failed attempt*" to achieve the claimed invention had been submitted in the proceedings. Evidence, expert statements and possibly experiments may therefore become more relevant in this regard as case law progresses.

"Whole range sufficiency"

Commonly referred to as "*Biogen insufficiency*" in the UK, we are now also seeing cases from the UPC that deal with the issue of sufficiency across the breadth of the claim.

The Düsseldorf LD in *Fujifilm v Kodak*[73] outlined how sufficiency of disclosure requires that the skilled person is enabled by the patent to obtain substantially all embodiments falling within the ambit of the claims and that, as such, the patent´s disclosure must allow the claimed invention to be performed across the whole range claimed ("*whole range sufficiency*"). The Court further elaborated how, to define the whole range claimed, all technically sensible claim interpretations must be taken into account.

The Court also drew a distinction between sufficiency and support, outlining how specifying one way of carrying out the claimed invention may be enough to satisfy the description requirement under r. 42.1(e) of the EPC's Implementing Regulations, but it is not necessarily enough to satisfy the requirements for sufficiency under Art. 83 EPC. Rather, the person skilled in the art must be enabled by the patent and their common general knowledge to use the claimed invention across the entire scope without having to start a research programme (i.e. without undue burden).

The Court made reference to the fundamental patent bargain that underpins the sufficiency requirement, stating:

> *"The requirement that the disclosure must enable the implementation of the claimed invention in its entire scope is consistent with the concern that, in principle, the right of exclusion conferred by a patent with respect to its scope of protection must be commensurate to the actual contribution of the patent to the state of the art."*

72 UPC_CoA_528/2024 and 529/2024, Decision of 25 November 2025

73 UPC_CFI_355/2023, Decision of 28 January 2025

Similar comments were made by the Munich LD in *Edwards v Meril*[74].

Insufficiency by ambiguity

Turning to another strand of sufficiency case law, the UPC has now also dealt with the issue of insufficiency by ambiguity, where - for example - a claim contains an ill-defined or ambiguous parameter and, as a consequence, a skilled person would not know whether they were working within or outside the scope of the claim.

In *Boskamp v ALDI*[75] the Mannheim LD rejected an ambiguity insufficiency attack on the basis that the alleged insufficiency was easily cured with the skilled person's common general knowledge. The patent in question related to a treatment for head lice. The defendants had argued that the patent specification did not specify the temperature at which claimed viscosities were to be determined and also lacked the specific measurement parameters of the measuring stand to be used. In particular, they argued that a specification of the temperature was essential due to the strong temperature dependence of viscosity.

The Court rejected this, stating that the claimed viscosities must be present at least within the usual temperature range for application to the human head at room temperature and that the skilled person would be able to address any uncertainties, particularly due to any temperature variation in the application areas, with their specialist knowledge and expertise by applying a safety margin or discount.

Interplay with errors

The Court of Appeal was called upon to assess a case where an alleged error could lead to insufficiency in *Alexion v Samsung Bioepis*[76]. The headnote of this decision sets out the following (with emphasis added):

> *A linguistic error, a spelling mistake or any other inaccuracy in a patent claim can only be corrected by way of interpretation of the patent claim if the existence of an error and the precise way to correct it are sufficiently certain to the average skilled person on the basis of the patent claim, taking into account the description and the drawings and using common general knowledge.*"

In the body of the decision the Court of Appeal stated that this "*is a rather strict standard since an error as such implies some legal uncertainty for third parties*".

In the case in question, the existence of an error and the way to correct it were deemed not sufficiently certain to the average skilled person, and so the patent was most likely insufficient (in the context of an application for provisional measures).

The Nordic-Baltic RD applied these statements of the Court of Appeal in *Edwards v Meril*[77], again reflecting the strict standard for corrections to be recognised. Here, the patentee had failed to satisfy the Court that the person skilled in the art would immediately understand that a reference to an "*inner sleeve (190) in dependent claim 9*" should be to a "*flex activating member (154)*". Therefore, the examination of whether the invention according to claim 9 was sufficiently disclosed was carried out under the assumption that this was not an error. This was a crucial issue in the case, and the claim was found to be insufficient as a result.

Distinction with clarity

The Düsseldorf LD made short work of "*disguised*" clarity objections in *Grundfos v Heifu*[78]. The defendant had argued that the skilled person was faced with the problem of implementing the "*means for switching or connecting*" mentioned in the claim, but then either i) did not know whether the means for switching related to a single component or

74 UPC_CFI_501/2023, Decision of 4 April 2025
75 UPC_CFI_541/2024, Decision of 20 December 2024
76 UPC_CoA_402/2024, Decision of 20 December 2024
77 UPC_CFI_380/2023, Decision of 21 July 2025
78 UPC_CFI_11/2024, Decision of 8 May 2025

whether several components were required, or ii) envisaged several means for connecting and switching, but then learnt nothing from the patent regarding the design of the means for connecting. The Court considered that neither of these situations concerned sufficiency of the claimed invention, and at most were issues regarding clarity which is not a ground for invalidity within the meaning of Art. 138 EPC.

Plausibility

In *Sanofi & Regeneron v Amgen*[79] the Düsseldorf LD touched on the issue of plausibility (although they did not use that term) in the context of second medical use claims, stating that "*in a case of a second medical use claim, the claimed use, which is based on a therapeutic effect, is part of the claim. Therefore, the use (including the therapeutic effect) has to be sufficiently (reproducibly) disclosed in the patent (as a whole).*" (emphasis added)

The patent in question related to the use of PCSK9 inhibitors to lower lipoprotein(a) (**Lp(a)**) levels. It was not in dispute between the parties that PCSK9 inhibitor antibodies were compounds known to the person skilled person. Likewise, it was not in dispute that the skilled person knew how to make those compounds and how to administer them to a patient. However, the defendants argued that the patent, in particular the data provided within it, did not sufficiently disclose the therapeutic effect of reducing Lp(a) in patients that were not on statins.

However, the Court agreed with the claimant that Table 6 of the patent showed a clear reduction of the Lp(a) levels for patients treated with a PCSK9 inhibitor and a statin. Even if those patients were on a daily statin regimen, which was not part of the scope of the claim, the skilled person would take these results as confirmation that the Lp(a) reducing effect of PCSK9 inhibitors would also be achieved in patients who are not on a statin regimen, because the effect of the anti-PCSK9 antibody in patients receiving only 10 mg atorvastatin was almost the same than the effect in patients receiving a far higher dose (80 mg) of atorvastatin and it was also known before the priority date that statins do not affect Lp(a) levels. The patent was not therefore insufficient on that basis.

Claim amendments

How many requests is too many?

The UPC has continued to shape its own jurisprudence around procedural fairness and efficiency in relation to the number of auxiliary requests a patent proprietor may submit during litigation. While the RoP do not impose a strict numerical cap, r. 30.1(c) requires that auxiliary requests be "*reasonable in number in the circumstances of the case*." This standard has led to differing outcomes in early UPC decisions, reflecting the Court's flexible, context-sensitive approach.

In setting a minimum number for what may be "*reasonable*" the Munich LD in *10x Genomics v Bruker*[80] stated that "*...a total of 4 auxiliary request is indisputably in each case reasonable in number*".

At the other end of the scale, in *Kunststoff v Häfele*[81] the Munich LD was faced with a patentee who submitted 80 auxiliary requests. The Court found this excessive, especially given the relatively low complexity of the technology involved (furniture fittings) and agreed with Kunststoff that the number of auxiliary requests and the way in which they were presented would make it unreasonably difficult for Kunststoff to focus its arguments against the requests and for the Court to prepare the oral hearing. It considered that such a volume of requests was procedurally burdensome and disproportionate and ordered the patentee to reduce / re-order the requests, suggesting that up to 10 auxiliary requests would be more appropriate in such a case. Notably, the Court stated that the existence of multiple proceedings elsewhere in relation to the patent and other patents in the same

79 UPC_CFI_505/2024, Decision of 13 May 2025

80 UPC_CFI_298/2023, Order of 11 April 2025
81 UPC_CFI_526/2024, Order of 18 April 2025

family, some of which were far more advanced than the UPC action, should enable Häfele to limit the number of auxiliary requests to only the most relevant.

By contrast, in *10x Genomics v NanoString*[82], the Munich LD took a more permissive stance. The patentee had submitted 55 auxiliary requests, which the judge-rapporteur initially deemed excessive and ordered to be reduced. However, on appeal to the full panel of judges, this case management decision was overturned, with a finding that the number was reasonable in light of the case's extreme complexity and the existence of parallel proceedings at the EPO. The full panel considered that the requests were well-structured and justified by the technical and legal intricacies of the dispute.

In *NJOY v Juul*[83], the Paris CD considered that the complexity of the case meant that 12 auxiliary requests would have been considered reasonable. The Court also noted that there is no provision to dismiss *all* auxiliary requests as a whole simply because together they are considered too numerous. This suggests that patentees will at least be given an opportunity to reduce the number of requests if the initial number is considered unreasonable.

These cases illustrate that the UPC will not apply a one-size-fits-all rule. Instead, the Court will evaluate the reasonableness of the number of requests based on factors such as the complexity of the technology, the number of invalidity grounds, the presence of parallel proceedings, and the clarity and structure of the requests themselves. While single-digit numbers may be expected in straightforward cases, more extensive sets may be tolerated where justified and manageable.

Additional amendments during proceedings

Statements in early case law last year suggested a restrictive approach to late applications seeking to introduce auxiliary requests. In particular, LDs emphasised that in the context of patent litigation, amendments are strictly a defensive measure to address specific invalidity claims raised by a third party. This year, in a positive development for patentees, it appears that applications to amend may be granted outside of requests relating solely to invalidity attacks. However, it remains crucial that these applications align with the front-loaded nature of the UPC.

For example, in *JingAo v Chint*[84] the Munich LD allowed the patentee to introduce into UPC infringement proceedings auxiliary requests that a) had been upheld by the Opposition Division and b) related to a new version of the allegedly infringing device that had come onto the market. The Munich LD emphasised that the UPC must aim to "*synchronise*" its proceedings with those of the EPO in line with r. 295(a), and this could only be achieved "*if it is possible to introduce claim versions amended by the EPO into proceedings before the UPC*".

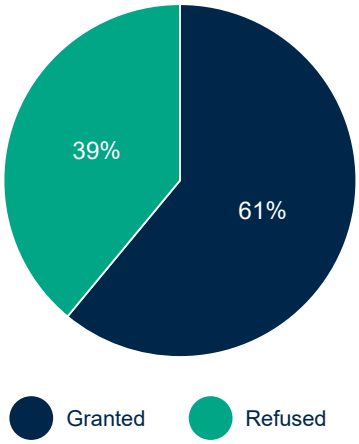
However, in a contrasting decision from the Paris CD in *NJOY v VMR*[85], the Court rejected an attempt by the patentee to introduce auxiliary requests that had been presented in parallel EPO proceedings. The Court considered that the patentee had initially taken a different approach in its defence to the counterclaim and noted that the patentee had not indicated in its earlier defence that it intended to coordinate its defence strategy at the EPO and UPC. As such, the application to amend constituted a change in strategy of the defendant.

82 UPC_CFI_298/2024, Order of 31 March 2025
83 UPC_CFI_316/2023, Order of 7 November 2024
84 UPC_CFI_425/24, Order of 31 March 2025
85 UPC_CFI_310/2023, Order dated 22 January 2025

Whilst the Court acknowledged that "*Aligning the defence of the patentee by presenting the same auxiliary requests to amend the patent in both parallel proceedings may be considered in the interest of the legal certainty*" this does not override the front-loaded nature of the UPC, and "*is not sufficient to allow an exception to the principle for the functioning of the Court*".

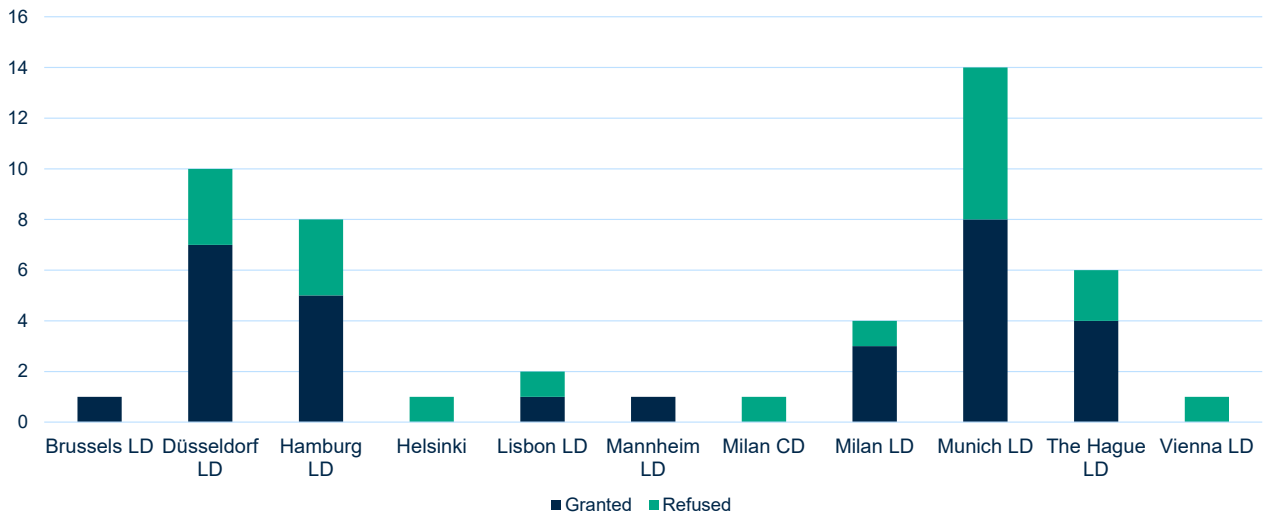
Preliminary injunctions (PIs)

The number of PI applications in the UPC has grown considerably, and in light of the shorter timetables involved in PI proceedings, we now have a large number of decisions from different divisions, from which we can see consistent themes emerging. Looking at the data so far, it's not surprising that patentees are becoming increasingly keen to take advantage of this remedy in the UPC. As shown below, the success rate for PI applications so far is reasonably high: over 60% of PI applications have been granted in some form and (where relevant) upheld on appeal. The statistics indicate that the Court of Appeal is taking a neutral approach to reviewing first instance decisions as an equal number of first instance PI grants and refusals have been reversed on appeal.



PI outcomes over the period 1 June 2023 to 23 October 2025

The breakdown of these outcomes according to the Court of First Instance in which proceedings were filed (incorporating the ultimate outcome from the Court of Appeal where relevant) is shown below. It is difficult to draw any firm conclusions, particularly given that many divisions have decided only a small number of PI cases, but as things stand there is no clear pattern to suggest that certain divisions are more or less likely to grant a PI than others.



PI outcomes by division over the period 1 June 2023 to 23 October 2025

By the end of 2024, the UPC had already established the general approach to assessing PI applications. In particular, the Court of Appeal had confirmed in *NanoString v 10x Genomics*[86] that a "*sufficient degree of certainty*" in accordance with Art. 62(4) and r. 211(2) requires the Court to consider on the balance of probabilities that it is more likely than not that the applicant is entitled to initiate proceedings and that the patent is infringed (for which the applicant has the burden of proof) and that the patent is valid (for which the defendant has the burden of proof). It was also clear from the early cases that the UPC would undertake a thorough examination of both validity and infringement in PI proceedings.

The UPC has continued to evaluate validity and infringement in detail, including the assessment of experimental data[87] and video evidence[88] where appropriate. This remains a point of distinction from many national courts in Europe, which either do not take validity into account at all or limit the consideration of validity to the contents of the EPO file and any prior national decisions. As a consequence, seeking a PI (or resisting a PI application) in the UPC can be a significant undertaking, in terms of both written submissions and evidence and the length of the hearing. In general parties can expect to spend a full day in Court, and sometimes longer. However, the upside is also significant, with decisions potentially covering the territory of the 18 UPC Contracting Member States plus additional territories following the CJEU's decision in *BSH v Electrolux*[89] (addressed in further detail in the **Jurisdiction** section).

The Court of Appeal has also demonstrated that, as in the early cases, it will not shy away from reaching a different conclusion to the Court of First Instance where appropriate. This is exemplified by a number of Court of Appeal decisions:

- In *Insulet v EOFlow*[90] the Court of Appeal adopted a fundamentally different – and narrower – claim construction to that of the Milan CD, which changed the infringement assessment and resulted in the PI being granted on appeal, having been rejected at first instance.
- In *Alexion v Samsung & Amgen*[91] the Court of Appeal disagreed with the Hamburg LD's claim construction (which had corrected an error in the amino acid sequence set out in the patent) and found that the patent was not more likely than not to be infringed[92].
- In *Dyson v SharkNinja*[93], having inspected the challenged handheld vacuum cleaner and observed videos of it in action, the Court of Appeal decided that the patent was not more likely than not to be infringed, contrary to the decision of the Munich LD, and overturned the PI order.
- In *Abbott v Sibio*[94] the Court of Appeal disagreed with The Hague LD's finding that the patent was more likely than not to add matter and granted the PI on appeal.
- In *Boehringer Ingelheim v Zentiva*[95] the Court of Appeal adopted a more generous approach to the assessment of imminent infringement than the Lisbon LD, resulting in the PI being granted on appeal.

86 UPC_CoA_335/2023, Order of 26 February 2024
87 See for example *Sumi v Syngenta* UPC_CoA_523/2024, Order of 3 March 2025, *Speedcare v Teleflex* UPC_CFI_701/2024, Order of 21 February 2025
88 See for example *Dyson v SharkNinja* UPC_CoA_297/2024, Order of 3 December 2025
89 C-339/22, Decision of 25 February 2025
90 UPC_CoA_768/2024, Order of 30 April 2025
91 UPC_CoA_402/2024, Order of 20 December 2024
92 This did not change the overall result, the PI having been rejected at first instance due to doubts about the patent's validity based on the Hamburg LD's alternative construction.
93 UPC_CoA_297/2024, Order of 3 December 2025
94 UPC_CoA_382/2024, Order of 14 February 2025
95 UPC_CoA_446/2025; UPC_CoA_520/2025, Order of 13 August 2025

Parties to PI proceedings would therefore be well advised not to celebrate – or lose hope – until the Court of Appeal has determined the PI application, although the overall proportion of decisions being overturned on appeal is relatively low (the lower court decision has only been reversed in 8% of PI decisions so far).

Necessity and balancing of interests

An applicant for a PI is required to provide reasons why such measures are necessary, supported by facts and evidence (r. 206(2)(c-d)). In deciding whether to grant the PI, the Court must weigh up the interests of the parties and, in particular, take into account the potential harm for either of the parties resulting from the grant or refusal of the PI (Art. 62(2) and r. 211.3). As we reported last year, the UPC does not require irreparable harm as a condition for granting a PI[96] and it is merely one factor to be taken into account when balancing the interests of the parties. The Court of Appeal confirmed this approach in 2025 in *Biolitec v Light Guide*[97] and provided additional clarity regarding the factors that should be considered, which include:

i. whether there is direct competition between the parties' products;

ii. whether there is a move from a market situation where only one product is available to one where there are two competing products, which can be expected to lead to price pressure and permanent price erosion[98];

iii. lock-in effects, such that market access is blocked once the alleged infringing product is adopted by patients and hospitals;

iv. the *status quo* and whether there is already an established market for the contested embodiment;

v. the expected date of the decision on the merits;

vi. where appropriate, the interests of patients; and

vii. the likelihood that the patent is valid and infringed by the challenged embodiments.

The application of these factors can be seen in a number of decisions. In *Steros v OTEC*[99], which concerned a patent to an electrolytic medium and electropolishing process, the Hamburg LD's assessment of necessity focused on the opening of a new market segment as a result of the defendant launching a new electrofinishing machine that was particularly well suited to smaller dental laboratories. The machine itself did not infringe the patent but it could be used with the attacked embodiment (electrofinishing media), which was expected to result in increased sales of media by the defendant and a lasting loss of market share for the applicant. This, combined with the fact that the defendant's products were offered at lower prices than the applicant's, tipped the balance in favour of granting the PI.

The price differential between the patentee's products and the alleged infringing products has also been influential in other cases. For example, in *Dyson v Dreame*[100] the Hamburg LD commented that "*the attacked embodiments are offered for half the price, which is a strong indicator for the risk of loss of market shares and price erosion*". Similarly, in *Hewlett-Packard v Andreas Rentmeister & Shenzhen Moan*[101] the "*significantly lower price*" of the defendant's products was expected to result in a loss of market share for the patentee by incentivising customers to shift their purchasing preferences and start to look for further illegal clone cartridges from other sources even if the defendant's products were to be subjected to a final injunction after the main proceedings. The likelihood that the defendants would offer products at significantly lower prices was also a key part of the assessment in *Occlutech v Lepu*[102].

96 See *Mammut v Ortovox*, UPC_CoA_182/2024, Order of 25 September 2024
97 *Biolitec v Light Guide*, UPC_CoA_540/2024, Order of 24 February 2025. See also example *Insulet v EOFlow*, UPC_CoA_768/2024 (Order of 30 April 2025) and *Abbott v Sibio*, UPC_CoA_382/2024 (Order of 14 February 2025)
98 This was found to be the case in *Abbott v Sibio*, UPC_CoA_382/2024, Order of 14 February 2025, where there was a risk that promotions and discounts offered by Sibionics would lead to a negative price spiral that would be very difficult for Abbott to reverse.
99 UPC_CFI_281/2025, Order of 16 June 2025
100 UPC_CFI_387/2025, Order of 14 August 2025
101 UPC_CFI_515/2025, Order of 17 October 2025
102 UPC_CFI_553/2025, Order of 21 October 2025

Also in *Abbott v Sinocare & Menarini*[103] The Hague LD awarded a PI against the defendants after factoring in the expectation of "*aggressive pricing*" by the defendants and the impact of the defendants' sales extending from the small cash-pay market into the much larger reimbursement market, noting that "*damage caused by such loss of sales and price erosion is difficult to quantify and may run for many years due to long contracts with payers and the irreversibility of price reductions*".

Reputational harm to the patentee from the sale of lower quality consumable products compatible with the patentee's printer devices was also a factor that pointed in favour of granting a PI in *Hewlett-Packard v Andreas Rentmeister & Shenzhen Moan*.

In *Biolitec v Light Guide*[104], the Court of Appeal emphasised the importance of the "*time factor*" when weighing up the interests of the parties. In that case, Light Guide's products had been on the market since at least 2021 and the patentee had failed to demonstrate that a PI was necessary to protect its current market share or prices or for any other purpose that could not await a decision on the merits. The Court of Appeal therefore upheld the Düsseldorf LD's decision to reject the PI application. However, an alleged infringer will not necessarily avoid a PI where their products are already on the market. In *Abbott v Sibio*[105], the fact that Sibionics was based in China without any apparent assets within the UPC territory led the Court of Appeal to determine that it was uncertain whether any damages suffered by Abbott could be recovered, which weighed in favour of granting a PI and disturbing the *status quo*.

The fact that an alleged infringer is already being kept off the market as a result of a pre-existing injunction does not appear to be an important factor in the weighing of the parties' interests. In *Boehringer Ingelheim v Zentiva*[106], both the Lisbon LD and the Court of Appeal rejected Zentiva's argument that a PI was not needed because the Portuguese Intellectual Property Court had already issued a PI covering the same product - this was based on a separate IP right (an SPC based on a different patent) and, unlike the UPC application, was territorially limited to Portugal.

Further innovation by the alleged infringer is also an irrelevant factor according to *Abbott v Sibio*[107], in which the Court of Appeal stated that further innovation does not change the position that being able to prevent competition by infringing products is "*at the core of the exclusive right a patent offers*" and "*cannot be accepted as fair*".

Imminent infringement

2025 has also brought some clarity as to what will amount to imminent infringement under Art. 62(1) and (4). In *Boehringer Ingelheim v Zentiva*[108], the Court of Appeal confirmed that the correct test is that established in *Novartis & Genentech v Celltrion*[109] last year: has the potential infringer already "*set the stage*" for infringement to occur so that the infringement is only a matter of starting the activity?

In a pharmaceutical context, it appears clear from both the *Novartis* and *Boehringer Ingelheim* decisions that neither applying for nor obtaining a marketing authorisation (**MA**) will meet that test. Completion of national procedures for health technology assessment, pricing and reimbursement for a generic medicine *may* amount to imminent infringement, however the circumstances must be assessed on a case-by-case basis and with due regard to the national regulatory and legislative context. In the *Boehringer Ingelheim* case, Zentiva had not only obtained MAs in Portugal for its generic nintedanib products but had also applied to the national authority, INFARMED, for an agreed price and reimbursement rate and completed the Prior Evaluation Procedure (**PEP**) that established the conditions under which public hospitals could acquire its products more than a year

103 UPC_CFI_624/2025, Order of 17 October 2025
104 UPC_CoA_540/2024, Order of 24 February 2025
105 UPC_CoA_382/2024, Order of 14 February 2025
106 UPC_CoA_446/2025; UPC_CoA_520/2025, Order of 13 August 2025
107 UPC_CoA_382/2024, Order of 14 February 2025
108 UPC_CoA_446/2025; UPC_CoA_520/2025, Order of 13 August 2025
109 UPC_CFI_165/2024, Order of 6 September 2024

before patent expiry. The Lisbon LD had not considered this to be enough to establish imminent infringement but the Court of Appeal disagreed, determining that Zentiva had completed the PEP prematurely and the only real mechanism preventing Zentiva from offering its generic product in Portugal was self-restraint. The Court therefore overturned the first instance decision of the Lisbon LD and granted the PI.

Based on these early cases, evidence regarding the various national procedures for bringing pharmaceutical products to market and the specific steps required to be taken by MA holders prior to launch is likely to be critical to the outcomes of future PI applications against generic and biosimilar companies in the UPC. In a recent decision of the Paris LD in *Merz v Viatris*[110], the Court took the view that imminent infringement was clear from the date on which Viatris completed pricing and reimbursement steps in France but the position may be different in other countries depending on the relevant national procedure.

Moving from pharmaceuticals to medical devices, the role of an EU certification of conformity (**CE mark**) was considered in the context of imminent infringement in *Occlutech v Lepu*[111]. Unlike a generic drug, which usually requires certain national procedures to be completed after an MA is granted before it can be placed on the market, a medical device may be placed on the market anywhere in the EU as soon as it has passed a conformity assessment and obtained its CE mark[112]. The Hamburg LD considered that the combination of Lepu obtaining CE mark approval for its products, its announcement that it would showcase its products at a trade fair and its active and constant presence at key medical conferences was sufficient to "*set the stage*" to market its products and therefore prove the threat of imminent infringement.

110 UPC_CFI_697/2025, Order of 21 November 2025
111 UPC_CFI_553/2025, Order of 21 October 2025
112 Art. 5.1 of Regulation (EU) 2017/745 of 5 April 2017 on medical devices

Urgency

It is important for any patentee seeking a PI from the UPC to act swiftly as the Court will have regard to any unreasonable delay when assessing the application[113]. In particular, a PI will not be available where the applicant has acted negligently or hesitated in requesting a PI after gathering all the necessary elements for legal action[114]. In *Cilag v RiVOLUTiON*[115], The Hague LD explained the rationale: given that the main proceedings at the UPC are to be concluded within (a little over) a year, a patent holder who acts with unreasonable delay should not be allowed to jump the queue with PI proceedings.

The amount of delay that is reasonable will depend on the particular facts of the case. In *Boehringer Ingelheim v Zentiva*[116], the urgency requirement was met by Boehringer Ingelheim lodging its PI application within a month and a half of the point in time when it had, or should have had, after exercising due diligence, the necessary facts and evidence under r. 206.2(d) (in that case, the date of publication of the approval of the PEP for the Zentiva generics). Similarly, filing a PI application within a month and a half of first becoming aware of an offer for sale was acceptable in *Hewlett Packard v Andreas Rentmeister & Zhuhai Ougan*[117]. Filing a PI application within 2 months of first becoming aware of an allegedly infringing product was also acceptable in *Aesculap v Shanghai International Holding Corporation GmbH*[118], *Hewlett Packard v Andreas Rentmeister & Shenzhen Moan*[119] and *Abbott & Sinocare & Menarini*.[120]

Conversely, in *Cilag v RiVOLUTiON*[121], The Hague LD considered a delay of over 5 months from the date on which Cilag first became aware that RiVOLUTiON was seeking participants for a study using allegedly

113 r. 211.4
114 The test established by the Court of Appeal last year in *10x Genomics v Curio* (UPC_CFI_463/2023, Order of 30 April 2024)
115 UPC_CFI_374/2025, Order of 28 August 2025
116 UPC_CoA_446/2025; UPC_CoA_520/2025, Order of 13 August 2025
117 UPC_CFI_449/2025, Order of 3 September 2025
118 UPC_CFI_213/2025, Order of 10 July 2025
119 UPC_CFI_515/2025, Order of 17 October 2025
120 UPC_CFI_587/2025, Order of 22 October 2025
121 UPC_CFI_374/2025, Order of 28 August 2025

infringing products to be unreasonable. The Court did not consider it plausible that more than a month was needed to establish infringement by RiVOLUTiON's products and did not accept that Cilag's recent awareness of the expansion of the scope of the study caused a revival of urgency.

However, a longer period may be acceptable in some situations. For example, in *Sumi v Syngenta*[122] the Court of Appeal considered a period of over 4 months to be acceptable where the product was a toxic regulated substance that required customs clearance, which meant it took longer for Syngenta to receive the product for testing. In *Abbott v Sibio*[123], a period of 5 months between Abbott attending a trade fair and filing a PI application was also considered acceptable to allow time for Abbott to order and obtain samples of Sibionics' continuous glucose monitoring products and inspect them, particularly given that these steps fell over the holiday season. At the top of the scale, a period of over 9 months was determined to be reasonable by The Hague LD in *Amycel v Szymon Spyra*[124] to allow for genetic and morphological testing and analysis of a mushroom strain.

The question of when the clock should start ticking in the context of a unitary patent was an important factor in the assessment of urgency in *Barco v Yealink*[125]. Barco did not confirm the date on which it became aware of the alleged infringement by Yealink, arguing that this was irrelevant as it could not have initiated proceedings before August 2024, the date on which unitary effect was registered. The Brussels LD disagreed: the objective earliest date for Barco to have filed the action was in mid-June 2024, when Barco was granted a European patent, not the later date when unitary effect was registered. The evidence indicated that Barco was already aware of Yealink's products some time before June 2024 and, in light of this, waiting until October 2024 to file the PI application was considered to involve an unreasonable delay and the PI application was rejected.

However, according to the approach of The Hague LD, an applicant is not expected to take action to investigate a potential infringement until the patent has been formally granted. In *Washtower v Wasombuow*[126], where the patentee had filed the PI application less than 2 months after patent grant, the Court rejected the defendants' argument that Washtower had unreasonably delayed by waiting until the patent granted to order the defendants' allegedly infringing cabinets and should have taken action when it received notification of the EPO's intention to grant the patent. That said, evidence that a patentee has taken steps to investigate an alleged infringement in advance of patent grant may count in its favour. That appears to have been the case in *Steros v OTEC*[127], where the Hamburg LD commented favourably on the fact that the patentee had examined the attacked embodiment by the end of 2024, in advance of the publication of grant of the patent in February 2025, despite the patentee waiting until a month after patent grant to file the PI application.

The Hamburg LD noted in *Occlutech v Lepu*[128] that in a case of imminent infringement, whether the applicant has acted with sufficient speed will only be assessed from the point in time at which the threat of infringement was imminent (in that case when the CE mark was obtained for Lepu's products) so the fact that Occlutech could have assessed product features based on a product catalogue before the CE mark was obtained was irrelevant. CE mark approval marked the starting point for the patentee to investigate.

122 UPC_CoA_523/2024, Order of 3 March 2025
123 UPC_CoA_382/2024, Order of 14 February 2025
124 UPC_CFI_195/2025, Order of 31 July 2024
125 UPC_CFI_582/2024, Order of 21 March 2025
126 UPC_CFI_479/2025, Order of 11 September 2025
127 UPC_CFI_281/2025, Order of 16 June 2025
128 UPC_CFI_553/2025, Order of 21 October 2025

The Court noted that "*the assessment of urgency does somewhat mirror the establishment of competence*" since the point in time at which the patentee is able to prove the threat of imminent infringement in a relevant territory is also the point in time that a patentee should investigate and prepare for a PI application.

More recently, the Paris LD confirmed in *Merz v Viatris*[129] that if the clock has already started ticking because infringement is imminent, the clock will not be reset at the point in time that actual infringement begins. In that case Merz's PI application, which was filed a month after Viatris launched its product, was too late. Viatris had completed pricing and reimbursement steps 7 months earlier, which made infringement imminent and was the point in time from which urgency should be assessed. An additional factor was that Merz had not acquired direct exploitation rights from its licensee until two months after completion of the pricing and acquisition steps by Viatris. However, the Court took the view that proper due diligence would have flagged the imminent infringement so Merz should have been ready to act immediately rather than waiting for a further 6 months to file the PI. This suggests that there will be no grace period for urgency following an acquisition of patent rights and acquirors should be ready to act quickly to enforce their new rights.

Although not strictly part of the test for urgency, patentees should heed the Court of Appeal's warning in *Insulet v EOFlow*[130] that where an applicant fails to initiate main proceedings promptly after filing a PI application, this may be to their disadvantage notwithstanding that r. 213 does not formally require an applicant to start proceedings on the merits until after a PI has been issued. This is a strikingly different approach to that taken by the English courts in pharmaceutical cases, where the onus is on generic companies to "*clear the way*" well in advance of launch to avoid a PI.

Interplay with EPO proceedings

Although the UPC will undertake its own assessment of validity, the Court of Appeal's decision in *Alexion v Samsung & Amgen*[131] indicates that submissions made to the EPO may be taken into account when assessing whether it is "*more likely than not*" that the patent is valid in PI proceedings. This was an unusual case, in that the light chain antibody sequence in the claim contained an N-terminal signal peptide sequence that had been included by the patentee by error. Alexion had submitted in proceedings before the TBA that the skilled person would not be caused to doubt that the claimed antibody (including the N-terminal signal peptide) would bind to its target due to the distance between the CDR sequences[132] and the N-terminal signal peptide. This led the TBA to conclude that the claimed antibody was sufficiently disclosed. However, the submission came back to bite Alexion in the later UPC proceedings where Alexion stated that an antibody including the N-terminal signal peptide would be non-functional and tried to argue that the skilled person would understand the sequence to contain an error such that they would read in a deletion of the erroneous sequence from the claim. This argument was successful at first instance but the Court of Appeal relied on Alexion's submissions to the TBA (alongside other factors) to determine that it would not be clear to the skilled person that the antibody sequence in the claim contained an error that should be corrected. Based on a literal reading of the claim, it was more likely than not that the subject-matter of the claim was insufficiently disclosed under Art. 83 EPC so the PI was rejected.

129 UPC_CFI_697/2025, Order or 21 November 2025
130 UPC_CoA_768/2024, Order of 30 April 2025
131 UPC_CoA_402/2024, Order of 20 December 2024
132 Complementarity-determining region sequences, which are the portions of an antibody responsible for binding to its target.

Auxiliary requests in PI proceedings

The Court of Appeal established last year in *Ortovox v Mammut*[133] that auxiliary requests may be admissible in interim relief provisions. However, the Munich LD noted that there should be a limit to this principle in *Onward Medical v Niche Biomedical*[134], stating that a PI will not be granted if the patent must be amended to be considered valid. Interim measures cannot be granted if a patent is recognisably defective in its granted form and the Court cannot consider an application to amend the patent under r. 30 in proceedings for interim measures.

Infringement by equivalence in PI proceedings

Any practitioners who take the view that infringement by equivalence is too complex for PI proceedings may need to think again in a UPC context given the in-depth infringement analysis undertaken by the Court. As noted above, in *Washtower v Wasombuow*[135] The Hague LD applied the test for equivalence set out in *Plant-e v Arkyne*[136] last year to find that the defendants' products were more likely than not to infringe Washtower's patent and granted a PI. This case demonstrates that the "*more likely than not*" assessment of infringement may also entail an assessment of equivalents.

Territorial scope

According to Art. 34, decisions of the UPC shall cover, in the case of a European patent, the territory of those Contracting Member States in which the patent has effect. In *Sumi v Syngenta*[137] the Court of Appeal interpreted Art. 34 to mean that injunctions "*as a rule*" should cover all of those Contracting Member States and any restriction would require the presence of certain circumstances such as a restriction of the territorial scope of an action according to Art. 76(1).

This "*rule*" has been applied to the letter in PI decisions to date, notwithstanding the fact that the threshold for granting a PI may not have been met in every Contracting Member State. For example, the PI granted by the Court of Appeal in *Insulet v EOFlow*[138] covered all Contracting Member States for which the patent had effect, including Germany and other countries where EOFlow did not offer the attacked embodiments. Similarly, in *Boehringer Ingelheim v Zentiva*[139], the Court of Appeal issued a PI covering all Contracting Member States covered by the patent despite Zentiva not holding any MAs outside Portugal, and in *Sumi v Syngenta*[140] the Court of Appeal granted a PI covering Contracting Member States in which Sumi held no MAs on the basis that Sumi could obtain MAs and begin marketing in those states later. It therefore appears to be sufficient for a patentee to establish that the alleged infringer has "*set the stage*" for infringement in only one Contracting Member State in order to obtain a broad pan-UPC injunction.

The Court of Appeal has also been generous in relation to later extensions to the territorial scope of a PI. In *Sumi v Syngenta*[141], the PI was extended on appeal to cover Romania, which had not acceded to the UPCA at the time Syngenta filed its PI application in April 2024 or when the PI was granted by the Munich LD in August 2024. However, an extension to the original territorial scope of the PI sought by Abbott at first instance to cover Ireland on appeal was not allowed in *Abbott v Sibio*[142] where this was not part of the original request.

Decisions by default in PI applications

The Court's position regarding decisions by default in PI proceedings does not yet appear to be settled, with the Munich LD and Düsseldorf LD apparently taking different approaches. In *air up v Guangzhou Aiyun Yanwu Technology*[143] the Munich LD issued short decisions by default in PI

133 UPC_CoA_182/2024
134 UPC_CFI_693/2025, Order of 17 October 2025
135 UPC_CFI_479/2025, Order of 11 September 2025
136 UPC_CFI_239/2023, Order of 22 November 2024
137 UPC_CoA_523/2024, Order of 3 March 2025
138 UPC_CoA_768/2024, Order of 30 April 2025
139 UPC_CoA_446/2025; UPC_CoA_520/2025, Order of 13 August 2025
140 UPC_CoA_523/2024, Order of 3 March 2025
141 UPC_CoA_523/2024, Order of 3 March 2025
142 UPC_CoA_382/2024, Order of 14 February 2025
143 UPC_CFI_508/2023 and UPC_CFI_509/2023, decisions of 9 January 2025

proceedings against the defendant following the defendant's failure to respond to the PI applications. The reasoning in the decisions is limited, comprising a brief statement that "*[as] a result of defendant's default, a decision by default is to be issued in accordance with the application*".

A contrasting approach was taken by the Düsseldorf LD in *Aesculap v Shanghai International Holding Corporation GmbH*[144], where the defendant initially filed an objection to Aesculap's PI application but later informed the Court that it did not wish to be represented at the oral hearing. The Düsseldorf LD determined that the absence of the defendant at the hearing does not prevent a decision on the merits of the case and, in particular, does not force the issuance of a judgment in default. Pursuant to r. 116, the Court is not obliged to postpone a procedural step, including a decision on the merits, simply because a party does not appear at the hearing and a party not represented at the hearing will be treated as if it relied only on its written submissions.

A similar approach was taken by the Düsseldorf LD in *Hewlett Packard v Andreas Rentmeister & Zhuhai*[145]. In that case, Hewlett Packard and Andreas Rentmeister had reached a settlement, as part of which Andreas Rentmeister agreed not to defend itself against the PI application. Both parties requested a decision by default but the Court determined that a regular order should be issued. Having considered the applicant's submissions and the absence of any other national or UPC revocation actions against the patents, the Court found it more likely than not that the patents were valid and infringed by the offer and distribution of the challenged ink cartridges by the defendant and granted both the PI and a request to provide information regarding the origin and distribution channels of the challenged embodiment in line with the applicant's original request. Defendants should not assume, therefore, that a settlement will avoid a substantive UPC PI decision, even where the patentee agrees to a decision by default.

As an interesting side note to the *Hewlett Packard* case, while Hewlett-Packard and Andreas Rentmeister settled their dispute, attempts to serve the PI application on Andreas Rentmeister's co-defendant, a Chinese company offering printer cartridges via the online platform Amazon, proved unsuccessful. Despite Hewlett-Packard verifying the address of the Chinese supplier according to the Amazon website and the proper service route being followed by the Düsseldorf LD in accordance with The Hague Service Convention[146], the Chinese authorities informed the Court three and a half months after receiving the documents for service that service had not been effected as the respondent did not exist at the provided address. Since there was no other means to determine the address, and a further attempt at formal service would be incompatible with the urgent request for provisional measures, the Court ordered that the steps already taken to bring the PI application to the attention of the defendant amounted to good service[147]. Similar difficulties serving a Chinese co-defendant were encountered in a parallel infringement action against Andreas Rentmeister (which was also settled between Hewlett Packard and Andreas Rentmeister, but not the Chinese co-defendant) and had not been resolved at the time of writing[148]. It will be interesting to see what decisions ensue against the Chinese entities in these cases.

Permanent injunctions and other final remedies

The UPC has demonstrated its flexible and pragmatic approach to awarding permanent injunctions in a number of decisions. In *Edwards v Meril*[149] the Munich LD awarded an injunction against Meril, whose devices had been found to infringe Edwards' transcatheter heart valve patent, but excluded from the

144 UPC_CFI_213/2025, Order of 10 July 2025
145 UPC_CFI_449/2025, Order of 3 September 2025
146 Convention of 15 November 1965 on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters
147 UPC_CFI_449/2025, Order of 16 October 2025
148 UPC_CFI_515/2025, Order of 17 October 2025
149 UPC_CFI_15/2023, Decision of 15 November 2024

scope of the injunction Meril's XL-sized heart valves that had already been scheduled for implantation in individualised patients by the date of the decision. The exclusion was created to address the "*clear and pressing public need*" for Meril's XL-sized valves, the panel having been persuaded that there may be certain patients with large aortic annuli who could only be treated with those valves. An existing system allowed doctors to request a single-use licence from Edwards to use Meril's XL-sized valves via Edwards' Medical Request Portal and the parties agreed that this would continue to apply post-injunction but the Court explained that the carve-out from the injunction would ensure that no patient would be harmed during the interim period required to disseminate information regarding its applicability to specific patients.

More recently, the Paris CD awarded an injunction in a separate *Edwards v Meril*[150] case concerning a different patent in the same subject area and subject to the same issue regarding the need for Meril's XL-sized valves for certain patients. This injunction was subject to an ongoing carve-out regarding Meril's XL-sized valves, to the extent that they remained the sole available treatment for certain patients, rather than the time-limited carve-out ordered by the Munich LD. The Paris CD rejected a proposal that would have made the use of the XL valves subject to Edwards' request and authorization procedure on the basis that this was neither necessary nor appropriate. The Court noted that the addition of a bureaucratic compliance requirement would be cumbersome for doctors, and that the imposition of partial scrutiny over patient evaluations would be inappropriate. This therefore reflects a divergence of approach, albeit with a view to achieving the same objective in terms of ensuring that appropriate treatments are not blocked for patients in need.

The Court has also had the opportunity to illustrate when an injunction may be limited in cases of indirect infringement. In *Brita v Aquashield*[151] a limited injunction was considered appropriate since it was possible to use the defendant's cartridge without infringing the patent. Appropriate measures to facilitate non-infringing acts in relation to a product where there is an indirect infringement risk include warnings to customers not to act in an infringing manner as well as contractual cease and desist agreements with customers linked to penalty payments to the rights holder. In the case at hand, the Munich LD considered that warnings were sufficient.

By contrast, in *Fujifilm v Kodak*[152] the Mannheim LD considered an unrestricted permanent injunction to be justified because it was not apparent that the attacked embodiment could be used without making use of the invention. In a later decision[153], the Mannheim LD extended the injunction to include the UK part of the European Patent. This was notwithstanding the fact that the UK part of the patent had not been amended in line with the auxiliary request upheld as valid and infringed in the UPC proceedings (discussed further in the **Jurisdiction** section).

In considering whether to order a permanent injunction in *Oerlikon v Bhagat*[154] the Milan LD emphasised that it is for the defendant to prove that there is no risk of future repetition. A mere undertaking not to continue infringement was not regarded in that case as a sufficient basis to avoid an injunction. The Court noted that, among other things, an undertaking would not be accompanied by a penalty for non-compliance.

150 UPC_CFI_189/2024 & UPC_CFI_434/2024, Decision of 20 October 2025

151 UPC_CFI_248/2024, Decision of 22 August 2025
152 UPC_CFI_365/2023, Decision of 2 April 2025
153 UPC_CFI_365/2023, Decision of 18 July 2025
154 UPC_CFI_241/2023, Decision of 4 November 2024

Corrective measures

Turning to the corrective remedies of recall, removal and destruction provided for in Art. 64, the UPC appears to be taking a fairly hard line in many cases.

In *Erwin Härtwich v Knaus Tabbert AG*[155] the defendant had been found to infringe a patent to a lightweight vehicle frame and the Düsseldorf LD had ordered the recall, removal and destruction of the defendant's products, which amounted to entire caravans with a value of up to €41,400 each. The Court held that the defendant could not rely upon alleged fiduciary duties of the claimants arising from an earlier development agreement to avoid this remedy where the agreement did not include a licence to the caravan models found to infringe the patent. Nor could the defendant rely on the fact that it had made a settlement offer of €100,000 for an exclusive licence without recognising that it owed a legal obligation to the claimant. The Court, therefore, exercised its discretion to award these remedies, observing that they were not disproportionate since the accused caravans could not be put into a patent-free state. The Court of Appeal agreed, in the context of an application for suspensive effect by the defendant, that no manifest error had been made by the Düsseldorf LD: the patent protected the basic construction of the caravan rather than individual components and, even if the disagreements between the parties were of a purely financial nature, the order for destruction was justified[156].

In *Hurom v NUC*[157], the Mannheim LD observed that the environmental aspects of destruction are a regular consequence of the remedy and do not justify a dismissal. Similarly, the fact that infringing products are sold to private end users does not provide a grounding for disproportionality. Destruction was ordered on the basis that the defendants did not sufficiently substantiate the fact that the infringing products could be modified to be non-infringing. Recall was also ordered in this case: the fact that the infringement could not be seen from the outside and may be of no relevance to the purchasing decision did not suffice for disproportionality.

Destruction should reliably prevent infringing products from entering or re-entering the market. The Düsseldorf LD held in *Ortovox v Mammut*[158] that the abstract possibility of transferring the contested embodiment to a patent-free country did not constitute a reason to refrain from destruction with regard to direct infringement. However, this logic does not apply to indirect infringement, which generally precludes an order for destruction. Consequently, the order for destruction in this case was limited to direct infringement.

Similarly, in *Brita v Aquashield*[159] the Munich LD explained that Art. 64 does not apply in the case of indirect patent infringement. A means essential does not, in itself, fulfil all the characteristics of a patent claim and, therefore does not amount to a "*product found to be infringing a patent*" pursuant to Art. 64. The Court noted that this does not contradict the power of the Court to order other remedies under Art. 63, 67 or 68 in the case of indirect infringement as these provisions are worded differently.

Damages

There is relatively little case law on damages to date given that the first main action decisions have only recently been issued by the UPC. The questions of quantum and the correct method of assessment will no doubt be topics of significant argument in future cases, however for the time being we summarise a few cases of interest below.

The Mannheim LD clarified the applicable law in *Hurom v NUC*[160]. Where the infringement occurred exclusively before the UPC's establishment, national law applies. If infringement began after the UPC's launch, only UPC law applies. In cases of overlap, the initial position is that UPC law will apply where

155 UPC_CFI_50/2024, Decision of 10 April 2025
156 UPC_CoA_365/2025, Order of 21 May 2025
157 UPC_CFI_159/2024, Decision of 11 March 2025
158 UPC_CFI_16/2024, Decision of 14 January 2025
159 UPC_CFI_248/2024, Decision of 22 August 2025
160 UPC_CFI_159/2024, Decision of 1 March 2025

infringement is before and after UPC launch, but a party may invoke national law with proper substantiation.

The appropriate wording for a damages claim was addressed in *Sunstar v CeraCon*[161], in which the Mannheim LD considered the scope of Sunstar's damages claim in the context of an application by Sunstar to amend its claim for damages pursuant to r. 263. The original wording of the damages claim referred broadly to "*all damages resulting from the patent infringement*" but did not make explicit reference to the sales of certain sealing materials and related service contracts, which Sunstar sought to include expressly. The Court held that the claim as originally drafted already covered damages arising from such sales if and insofar as these are relevant for the assessment of the amount of damages generally. A clarifying amendment in the circumstances did not require an application under r. 263, but was permitted if necessary.

The Düsseldorf LD considered a knotty issue in *Erwin Härtwich v Knaus Tabbert*[162]: compensation for the infringement of a published patent application under Art. 32(1)(f). The Court noted that there is no standardised regulation on this issue across Contracting Member States so it is up to the claimant seeking compensation to set out the requirements for the individual member states in question. The claimant in that case had only done this for Germany and was therefore only awarded reasonable compensation for Germany and the action was dismissed in all other respects.

The same case also addressed the application of the limitation period according to Art. 72, which provides that actions may not be brought later than five years after the claimant became aware, or should have become aware, of the last fact justifying the action.[163] In this case, the defendant's argument that the claim fell outside the limitation period failed. The Court was unconvinced by the defendant's reference to the development agreement entered into between the parties in 2016, based on which they said the claimants were aware, or should have been aware, of all of the defendant's actions since 2018. The allegation of infringement by the claimants was based on a test purchase in June 2023 (within the limitation period) and the blanket assertions made by the defendant had failed to show that the plaintiffs already had or should have had knowledge of all the facts necessary for examining and demonstrating infringement by the defendant's products before that date. The defendant had also argued that a shorter limitation period of 3 years should apply in relation to Germany (which has a 3 year national limitation period) but the Court declined to address this point on the basis that the same considerations would apply as in relation to the UPC's 5 year limitation period.

Erwin Härtwich v Knaus Tabbert[164] also considered a claim for interim damages under Art. 68. An award of €100,000 was made in circumstances where the defendant had already offered this sum in settlement and had conceded a significant number of sales of the challenged products. By contrast, interim damages were refused in *Seoul Visosys v Laser*[165] and *Hurom v NUC*[166] due to a lack of justification on the facts.

Finally, the Court of Appeal held in *Fives v Reel*[167] that the UPC is competent to hear a standalone damages claim based on a finding of infringement by a national court that establishes an obligation for the infringer to pay damages. In that case, the standalone damages claim was based on a finding of infringement by the Düsseldorf Regional Court. This overturned the earlier decision of the Hamburg LD, which had dismissed the claim by Fives in December 2023. We address this decision in further detail in the **Jurisdiction** section.

161 UPC_CFI_745/2024, Order of 6 June 2025
162 UPC_CFI_50/2024, Decision of 10 April 2025
163 The Court notes in the decision that the German language version of the UPCA uses the term "*letzten Ereignis*" ("*last event*") but the English version refers to the "*last fact*" and the French version similarly refer to the "*dernier fait*", which the Court took to make clear that it is the last fact or circumstances that gave rise to the action that is key.
164 UPC_CFI_50/2024, Decision of 10 April 2025
165 UPC_CFI_440/2023, Decision of 24 April 2025
166 UPC_CFI_159/2024, Decision of 1 March 2025
167 UPC_CoA_30/2024, Order of 16 January 2025

Enforcement

Given the fact that the UPC, by its nature, relies on penalty payments for enforcement of its remedies, including injunctions (as opposed to a procedure like contempt of court in the English courts, which may lead to imprisonment) it is interesting to see examples of penalties being imposed for failure to comply with aspects of the Court's orders relating to remedies, in these cases relating to the provision of information.

In *Fujifilm v Kodak*[168] the claimant filed a notification of intended enforcement, asking the Mannheim LD to issue a warning to the defendants with a €30,000 per day penalty for failing to comply with the order for provision of information. The Court's order had not specified a fixed time period for the provision of information and did not set a penalty, merely stating that the infringer should provide information as soon as possible[169]. The claimant's request was rejected on the basis that this issue should be addressed in the course of an application to impose penalties.

The initial rejection was reinforced in a panel review[170] but Fujifilm was subsequently successful in an application to impose a penalty before the same division[171]. A lump sum penalty of €100,000 was imposed for the past period of non-compliance and a moderate daily penalty payment of €2,500 was imposed for a time period up until 4 August 2025 for the defendants to catch up on what should already have been provided. Thereafter, a more drastic daily penalty payment of €10,000 per day was imposed for further non-compliance, which could be increased on further application of the claimant.

The Court reiterated that where a time limit has not been proposed for the provision of information, it is the responsibility of the claimant to set a time period when notifying the defendant of the intention to enforce the decision. In this case the claimant specified three weeks, which the Court did not regard as too short. The defendant had also not challenged the reasonableness of this period when it was time to do so.

A similar issue was addressed by the Court of Appeal in *Philips v Belkin*[172], following an original remedies order from the Munich LD that did not specify a time period for compliance. The Court of Appeal indicated that, as a general rule, the Court should determine the appropriate time period at first instance. If not, the claimant should specify a reasonable time period in the notice to enforce. The Court of Appeal did not consider that Philips' specified time period for the provision of information was reasonable, but nevertheless imposed a penalty on Belkin for failure to comply with the first instance order. Penalty payments are, at least in part, punitive in nature, and may therefore be imposed notwithstanding belated compliance. On the facts, Belkin had complied with the order, in part, only after the date that the Court of Appeal considered reasonable.

The Paris LD took a more pragmatic approach from the outset in *Seoul Viosys v Laser*[173], ordering information disclosure within a time period of one month from notification of the decision and a €1,000 per day penalty for non-compliance.

The issue of enforcement will become particularly important as the UPC flexes its jurisdictional muscles and extends its remedies beyond the territory of the UPC.

Jurisdiction

Since the inception of the UPC, the question of jurisdiction has been a major battleground, evolving significantly over time. Most notably in 2025, the UPC has been grappling with questions relating to the extent of its long-arm jurisdiction. Much has been written on this topic already, but we would be remiss to exclude it from this Review given its key role in UPC strategy and the interplay between the UPC and national courts.

168 UPC_CFI_365/2023, Order of 3 June 2025
169 UPC_CFI_365/2023, Decision of 2 April 2025
170 UPC_CFI_365/2023, Order of 16 July 2025
171 UPC_CFI_365/2023, Order of 23 July 2025
172 UPC_CoA_845/2024 & UPC_CoA_50/2025, Order of 30 May 2025
173 UPC_CFI_440/2023, Decision of 24 April 2025

Long-arm jurisdiction

The CJEU's decision in *BSH v Electrolux*[174] in February 2025 fundamentally redefined jurisdictional boundaries in the IP context, including in the UPC.

BSH had brought proceedings in Sweden against Electrolux (a Swedish company) claiming infringement of a European patent validated across multiple jurisdictions, including those outside the EU. In response, Electrolux counterclaimed for the revocation of the Swedish designation of the patent and raised the invalidity of other designations as a defence. This led to the referral of a number of questions to the CJEU by the Swedish court.

In summary, the CJEU concluded that it is possible for a claimant to bring a patent infringement action in the court of the EU Member State where a defendant is domiciled under Art. 4(1) of Regulation (EU) No 1215/2012[175] (the **Brussels Recast Regulation**), regardless of where the patent is registered. Where the validity of a patent registered in an EU Member State is raised as a defence to infringement, the court seised cannot rule on the validity of that patent as this falls under the exclusive jurisdiction of the EU Member State court where the patent is registered under Art. 24(4) of the Brussels Recast Regulation. The court can, however, continue with the infringement proceedings or, optionally, stay the proceedings where there is a "*reasonable and non-negligible chance*" that the patent may be held invalid in the EU Member State court which has jurisdiction over validity issues.

In relation to patents registered outside the EU, the CJEU took a different approach and decided that the court hearing the infringement action may also consider the *validity* of a non-EU patent as Art. 24(4) does not apply.

While this would not have an effect on the patent entry in the relevant national register, validity of a non-EU patent may be determined by the court seised of the infringement action on an *inter partes* basis. This could apply to any non-EU patent unless (i) the country of that patent is a contracting state to the Lugano Convention[176] or another bilateral agreement giving that country exclusive jurisdiction for the validity of patents registered there or (ii) parallel proceedings are already pending in the non-EU court so Art. 33 and 34 of the Brussels Recast Regulation apply.

Cases prior to the Electrolux decision

Even prior to the *Electrolux* decision, the UPC had begun embracing long-arm jurisdiction in cases such as *Fujifilm v Kodak*[177]. In January 2025, the Düsseldorf LD held that it had jurisdiction to decide an infringement action in relation to both the German and UK designations of a European patent, although in that case the revocation counterclaim challenged only the German designation so there was no need for the Court to determine whether it had jurisdiction over revocation claims relating to non-EU patents. Having found that the German designation was invalid, the Court dismissed the infringement claim relating to both the German and UK designations on the basis that Kodak had not demonstrated that there would be differences in the validity assessment between the UK and Germany.

The Mannheim LD took a more cautious approach in *Hurom v NUC*[178], deciding to stay infringement proceedings in relation to the Polish, Spanish and UK designations of Hurom's patent until after the *Electrolux* decision. However, due to the involvement of a Korean defendant, the points at issue went beyond the application of Art. 4(1) of the Brussels Recast Regulation to a defendant domiciled within the EU.

174 C-339/22
175 Regulation (EU) No. 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments
176 Convention on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters, Official Journal of the European Union, L 339, 21 December 2007
177 UPC_CFI_355/2023, Decision of 28 January 2025
178 UPC_CFI_162/2024 and UPC_CFI_159/2024, Decisions of 11 March 2025

Cases following the Electrolux decision

The UPC has fully embraced the CJEU's decision in *Electrolux* and generally appears to be willing to allow claimants to expand the territorial scope of their claims to encompass non-UPC territories.

One of the first notable UPC decisions to apply *Electrolux* was the Paris LD's decision in *IMC Creations v Mul-T-Lock*[179], an infringement action based on a unitary patent and a European patent with designations in Spain, the UK and Switzerland. The Mul-T-Lock defendants (one French, one Swiss) filed a preliminary objecting contesting the jurisdiction of the UPC regarding the European patent covering Spain, the UK and Switzerland (which are not UPC Contracting Member States). The Paris LD, noting that Switzerland is a party to the Lugano Convention, held that it had jurisdiction to consider infringement in relation to the Swiss or Spanish designations of the patent, but acknowledged it may be necessary to stay proceedings if there was a reasonable chance the patents would be found invalid by those national courts. In contrast, the Paris LD considered that it was competent to decide on both infringement and validity of the UK patent (with the validity assessment being on an *inter partes* basis).

In *Dainese v Alpinestars*[180], an infringement action covering the UPC territories and Spain, the Milan LD determined that it had "*universal jurisdiction to adjudicate on infringement issues related to European patents over the defendants domiciled in Italy*" under Art. 32 UPCA as well as Art. 4(1), 71a and 71b of the Brussels Recast Regulation. However, the validity of the Spanish patent was not in issue as no revocation claim or counterclaim had been filed in respect of the Spanish designation.

Another decision that demonstrates the UPC's expansive approach to jurisdiction post-*Electrolux*, although it does not address long-arm jurisdiction directly, is *Genevant and Arbutus v Moderna*[181] , which addressed both questions of international jurisdiction under the Brussels Recast Regulation and local jurisdiction under Art. 33 UPCA. Moderna submitted that The Hague LD lacked *international* jurisdiction in relation to the Moderna defendants in Norway, Spain and Poland as they fell outside the UPC territories and the claimants had not "*conclusively alleged*" that these companies had committed infringing acts within a UPC territory. In addition, Moderna argued that The Hague LD had no *local* jurisdiction over various Moderna defendants as they were based outside of the Netherlands and were not accused of committing infringing acts inside the Netherlands. Moderna also challenged the Court's long-arm jurisdiction in relation to acts performed beyond the UPC territories, but this element of the preliminary objection was reserved to be dealt with in the main proceedings.

In relation to the international jurisdiction challenge, The Hague LD held that the specific facts and locations of the infringement would be determined later, but there was sufficient evidence that Moderna Norway, Spain and Poland infringed the relevant national designations jointly with Moderna Netherlands. Therefore, the UPC did have jurisdiction. The Court also rejected Moderna's local jurisdiction challenge, stating that it was enough that one of the defendants was domiciled in the Netherlands, there was a commercial relationship with the other defendants and the action against each defendant related to the same alleged infringement. It is arguable that this approach is contrary to established CJEU case law, in particular *Roche v Primus*[182]. In that case, the CJEU did not accept that subsidiaries of the same parent company selling the same allegedly infringing products in their local markets were so closely connected that the infringement claims against them should be heard together. *Roche v Primus* was not addressed by The Hague LD in its decision.

179 UPC_CFI_702/2024, Order of 21 March 2025
180 UPC_CFI_792/2024, Order of 8 April 2025
181 UPC_CFI_191-192/2025, Order of 23 May 2025
182 C-539/03

Although the early decisions indicate an eagerness by the UPC to exercise long-arm jurisdiction, they also suggest that the UPC will be strict when requiring evidence to support infringement beyond the UPC states. For example, in *Seoul Viosys v Laser Components*[183] the Paris LD stated that a claim for infringement in the UK was admissible. However, in the end the remedies were limited to the territory of France as Seoul Viosys had failed to provide evidence of acts of infringement in any jurisdiction outside France and had only brought the action against the French entity which, on the facts, could not support the acts of the group as a whole.

Similarly, in *Hurom v NUC*[184], Hurom's claim in relation to infringement in Turkey was deemed inadmissible by the Mannheim LD. This was because Hurom had failed to allege sufficient facts to support a claim for infringement in Turkey, regardless of the jurisdiction issues. In separate proceedings between Hurom and NUC, relating to a different Hurom patent[185], the Paris LD confirmed that, in light of *Electrolux*, a claim concerning infringing acts in Poland was admissible in principle, but the claimant had failed to provide enough evidence to support the portion of its claim relating to Poland so the claim was dismissed.

Long-arm injunctions

Following on from these cases, in August 2025 the Mannheim LD granted the UPC's first long-arm injunction post-*Electrolux*, covering the UK. In *Fujifilm v Kodak*[186], infringement had been asserted in relation to both the German and UK designations of a European patent. The proceedings relating to the UK patent were separated from the proceedings relating to the German patent as the *Electrolux* decision had not been delivered by the date of the oral hearing. The Mannheim LD confirmed that, in light of *Electrolux*, the UPC can hear infringement cases in relation to a UK patent, even where invalidity is raised as a defence.

The Court deemed the UK designation of the patent (in an amended form proposed by the patentee in the UPC proceedings) valid for the same reasons that the German designation had been found to be valid in an earlier decision in April 2025, no arguments having been put forward by Kodak that the English courts may have reached a different finding on validity. However, the Court declined to make a declaration that the UK part of the patent was invalid, noting that such declaratory relief would not be binding on the national authorities. The Mannheim LD re-iterated that a finding of validity would only have *inter partes* effect with respect to the UK and would not affect the existence or content of the patent in the UK.

In terms of infringement, after considering the evidence, the Mannheim LD found that the German defendants were directly or jointly carrying out infringing acts in the UK. The Court determined that it had discretion to grant a permanent injunction under both UK law and the UPCA, and ordered an injunction against Kodak, restraining its activities in the UK.

A few months later, in *HL Display v Black Sheep Retail Products*[187], The Hague LD granted a permanent injunction against a Dutch defendant covering several UPC states plus a number of non-UPC Contracting Member States. The jurisdictional assessment was more complicated in this case. The non-UPC states included EU member states (Ireland and Poland), non-EU Lugano member states (Switzerland and Norway) and non-EU, non-Lugano member states (the UK and Liechtenstein). The defendant had originally filed a counterclaim for revocation against all designations of the patent, but clarified during the proceedings that its counterclaim was to be considered a defence in relation to the non-UPC states. In addition, no national revocation claims had been instituted.

183 UPC_CFI_440/2023, Decision of 24 April 2025
184 UPC_CFI_159/2024 and UPC_CFI_162/2024, Decisions of 11 March 2025
185 UPC_CFI_163/2024, Decision of 23 May 2025
186 UPC_CFI_365/2023, Decision of 18 July 2025
187 UPC_CFI_386/2024, Decision of 10 October 2025

In relation to:

i) the UPC Contracting Member States, the Court made a finding that the patent was valid and the counterclaim for revocation was rejected;

ii) the UK and Liechtenstein (the non-UPC, non-EU, non-Lugano member states), the Court made a finding that the patent was valid on an *inter partes* basis; and

iii) Ireland, Poland, Switzerland and Norway (the non-UPC EU and Lugano member states), the Court determined that there was no "*serious, non-negligible chance the patent will be revoked by the competent national court*" and therefore it could determine the infringement claim.

The Court therefore assumed competence for hearing the infringement claims regarding all designated countries for the European patent, including the non-UPC Contracting Member States, and issued an injunction covering all designations.

The first instance of a long-arm preliminary injunction can be found in *Dyson v Dreame*[188]. The Hamburg LD granted a preliminary injunction covering all UPC territories and Spain, having decided that it was more likely than not that the patent was valid and that both the old and new models of Dreame's products infringed. An additional feature of this decision is that one of the Dreame defendants was domiciled in Hong Kong so did not fall within Art. 4(1) of the Brussels Recast Regulation. However, it had an authorised representative in Germany which served as an 'anchor defendant' under Art. 8 of the Brussels Recast Regulation (on the basis that the representative was an indispensable intermediary under EU product safety regulations). The Hague LD determined that it had jurisdiction over the Hong Kong defendant via the anchor defendant in Germany for acts of infringement in Spain. This marks the first time that an extraterritorial injunction has been granted against a defendant via an anchor defendant, and potentially opens the door for similar actions against defendants domiciled outside the UPC territory.

Amendments to proceedings post-Electrolux

The UPC has generally allowed amendments to pleadings following *Electrolux*. In *TGI Sport v AIM Sport Development*[189], the Court of Appeal upheld the Helsinki LD's decision to allow amendments to the Statement of Clam to extend the territorial scope of the claim to Spain. The Court balanced the risk of delay due to a potential need to stay proceedings against the risk of irreconcilable decisions should separate national proceedings be filed in Spain. A similar approach was taken by the Munich LD in *Syngenta v Sumi Agro*[190] in allowing Syngenta to amend its UPC claim to cover infringement of the Polish, Czech and UK designations of its European patent post-*Electrolux*.

Opt-outs

During the UPC's transitional period, patentees may opt their European patents out of the UPC system and many patentees have taken advantage of this option while the UPC finds its feet. As of 21 November 2025, over 653,000 opt-outs had been filed, with around 5,200 being withdrawn after filing.

Perhaps the most notable case in relation to opt-outs in 2025 is that of *Xsys Italia v Esko-Graphics*[191]. Esko-Graphics had opted out its patent and subsequently withdrew the opt-out in order to initiate infringement proceedings against Xsys Italia in the UPC. The infringement claim included acts that had occurred before the commencement of the UPC, and after the commencement of the UPC but during the opted-out period, i.e. before the date of the withdrawal. Xsys argued that the UPC should not have jurisdiction for acts predating the commencement of the UPC and during the opted-out period. Both the Munich LD and the Court of Appeal rejected

188 UPC_CFI_387/2025, Order of 14 August 2025

189 UPC_CoA_169/2025, Order of 11 April 2025
190 UPC_CFI_566/2024, Order of 14 April 2025
191 UPC_CoA_156/2025, Order of 2 June 2025

this jurisdiction challenge on the basis that under Art. 32, jurisdiction depends on the filing date of the action, not the timing of the infringing acts. Once an opt-out is withdrawn, the UPC has full jurisdiction over a patent, including for acts which occurred before the commencement of the UPC and during the opted-out period. The Court of Appeal did, however, reserve judgment in relation to which law (substantive UPC law or otherwise) applies to infringing acts committed prior to the UPC's commencement or during any opted-out period.

In another case, *Sun Patent Trust v Roku*[192], it was argued by Roku that the UPC lacked jurisdiction because the withdrawal of Sun Patent Trust's opt-out was not accompanied by evidence that its UPC representative was authorised to carry out such withdrawal. However, the Munich LD gave this argument short shrift, finding that there is no need for UPC representatives to submit evidence of authorisation when filing opt outs.

Parallel proceedings

As we explored in last year's UPC Review, there have been a number of cases since the commencement of the UPC relating to the UPC's jurisdiction in cases where there are parallel national proceedings. Generally, the UPC has been keen to accept and exercise jurisdiction and has taken a rather liberal approach to the application of the Brussels Recast Regulation and *lis pendens* assessments. In contrast to the large number of cases addressing this topic in 2023 and 2024, there have been relatively few significant cases in 2025. Defendants to UPC actions have potentially taken the view that the early cases set the tone for further liberal decisions on the issue such that they are less willing to spend costs on jurisdictional challenges that are likely to be fruitless.

The *Fives v Reel*[193] case, referred to in the **Damages** section above, was an exception to this trend. In 2022 the Düsseldorf Regional Court determined that Reel had infringed the German designation of the relevant patent, and Reel was ordered by the German court to pay damages to Fives for this infringement, but the determination of the amount of the damages payment had not yet taken place. Fives subsequently filed a UPC action for the determination of these damages with the Hamburg LD. Reel filed a preliminary objection, arguing that the UPC did not have jurisdiction, and the Hamburg LD initially denied jurisdiction[194], finding that the UPC has jurisdiction to determine damages only after the UPC itself has ruled on infringement. However, the Court of Appeal overturned this decision, noting that Art. 32(1)(a) is ambiguous: it does not exclude separate actions for damages, but nor does it explicitly prescribe such jurisdiction. The Court of Appeal also considered that assuming jurisdiction for a pure damages action was not contrary to the object and purpose of the UPCA. In particular, Art. 68 sets out substantive law on damages and, as a result, there is an advantage to the UPC assuming jurisdiction, as it allows for the application of a complete set of substantive rules across the Contracting Member States. Finally, following an analysis of the RoP in light of the UPCA, the Court of Appeal determined that r. 126-144, which requires a request for determination of damages to be an application, could be ignored, and instead damages could be a separate action. The Court of Appeal also rejected Reel's argument that assuming jurisdiction could lead to forum shopping. The determination of the amount of the damages payment was therefore remitted back to the Hamburg LD.

The Court has also been called upon to consider a situation where related actions are filed in different UPC divisions. In *Biolitec v Light Guide Optics*[195], Biolitec filed an infringement action at the Munich LD. Light Guide Optics argued that the action was

192 UPC_CFI_254/2024, Order of 18 March 2025

193 UPC_CoA_30/2024, Order of 16 January 2025
194 UPC_CFI_274/2023, Decision of 17 November 2023
195 UPC_CFI_714/2024, Order of 12 February 2025

inadmissible under Art. 33(2) and that the case should have been filed in the Düsseldorf LD where the PI application had been heard. An appeal against the PI decision was still pending at the time the infringement action was filed before the Munich LD. Considering the objection, the Munich LD stressed that Art. 33(2) aims to prevent multiple divisions from handling the same case simultaneously. However, a case is not "*pending before a division of the Court of First Instance*" according to Art. 33(2) if it is pending before the Court of Appeal. At the time Biolitec filed the infringement action, there was no pending action between the parties in relation to the same patent at another Court of First Instance so the preliminary objection was rejected.

Legitimacy of the UPC

In a rather "*meta*" case for the UPC, the Munich LD had to opine, in *Dolby v Roku*[196], on the legitimacy of the UPC itself. This followed allegations from Roku that the UPC lacked jurisdiction due to the UPCA being incompatible with EU law. In its objection, Roku cited CJEU Opinion 1/09 which had stated that the 2009 draft of the UPCA was not compatible with EU law and asserted that changes made to the UPCA following this opinion were not sufficient to remedy the incompatibility. Perhaps unsurprisingly given the challenge to its very existence, the Munich LD rejected Roku's objection as inadmissible. The reason for the rejection was that such an argument did not constitute a ground for opposition within the meaning of r. 19(1) and, in any event, it should be assumed that the UPCA grants the UPC the relevant jurisdiction. Roku appealed this decision, but the Court of Appeal confirmed[197] that the UPC's jurisdictional regime is fully compatible with EU law and does not constitute an interference with the allocation of functions between the CJEU and national courts.

Entitlement to bring proceedings

Finally, the UPC has been keen to stress that questions regarding an entity's entitlement to bring proceedings are separate from questions relating to the UPC's jurisdiction. In *GXD-Bio Corporation v Myriad Genetics*[198], Myriad filed a preliminary objection asserting that the UPC should decline competence in relation to acts of infringement which took place before the claimant was registered as the proprietor of the relevant patent. However, the Munich LD stated that this issue was irrelevant for the assessment of jurisdiction under Art. 32. The Court's jurisdiction or competence was deemed not to be linked to whether an entity that brings an action is ultimately entitled to bring the action and/or whether that entity is in fact fully entitled to the asserted claims. Such issues should be discussed in the main proceedings and not as a preliminary issue.

Inspection and preservation orders (*saisies*)

Art. 60 provides for orders for inspection and orders to preserve evidence (also known as "*saisies*"), which may be requested prior to the commencement of a main action. Applications under Art. 60 have proven popular amongst patentees, being the second most popular type of application for provisional measures after PIs.

Inspection orders are covered under r. 199, whereas *saisies* are covered under r. 192 and have a broader scope than orders for inspection. Most applicants therefore opt to apply for a *saisie*, as an inspection similar to that available under r. 199 can also be ordered as part of the *saisie* procedure. Typically, the "*raid*" team to execute the order will include a bailiff (which is sometimes mandatory depending on the UPC Contracting Member State in which the saisie is taking place), a patent attorney with expertise in the subject-matter of the patent and an IT expert (for digital records).

196 UPC_CFI_235/2024, Order of 18 March 2025
197 UPC_CoA_291/2025, Order of 6 October 2025
198 UPC_CFI_437/2024, Order of 14 February 2025

In *Genentech v Organon*[199] the Brussels LD set out a four-stage process for deciding whether to grant a preservation order:

1. Consideration of which of the options the Court should apply under r. 194 : (i) inform the defendant of the application and invite them to lodge an objection; (ii) summon the parties to an oral hearing; (iii) summon the applicant to an oral hearing without the defendant; and/or (iv) decide the application without having heard the defendant.
2. Substantive assessment: the key questions are (1) whether the patent is likely to be valid and (2) whether it is likely that there is infringement or that infringement is imminent. According to the Brussels LD, the standard of proof is "*a certain degree of plausibility*".
3. Consideration of whether the requests cover the purpose for which the application to preserve evidence / for inspection was made – this is a balancing act between the fundamental rights of the parties.
4. Consideration of whether any additional conditions surrounding the execution of the order should be ordered based on the circumstances of the case.

Taking this approach, the Brussels LD granted the request on an *ex parte* basis, allowing Roche and Genentech to obtain information regarding Organon's biosimilar pertuzumab product from its manufacturing sites in Belgium and the Netherlands.

However, in a subsequent case, *Maguin v Tiru*[200], the Court of Appeal took a different approach, without explicitly referring to *Genentech v Organon*. In particular, the Court of Appeal set out a number of clarifications when assessing applications for orders to preserve evidence, the third of which appears to be at odds with the *Genentech v Organon* approach:

1. There is a difference between the assessment of urgency for a preliminary injunction and orders to preserve evidence. There is no requirement in the UPCA or RoP that the time taken by the applicant to file the application for preserving evidence should be part of the assessment.
2. There is no requirement that the disappearance or destruction of evidence is "certain" to grant an order ex parte; there only needs to be a risk.
3. There is no requirement for there to be a sufficient degree of certainty that the patent is valid within the framework of the Court's discretion to order measures to preserve evidence. This matter may therefore remain 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 (such as by a successful opposition or national court revocation action).

The Düsseldorf LD followed the Court of Appeal decision in *Otec v Steros*[201], stating that it was not necessary to look at the counterclaim for invalidity as there was no reason to doubt the validity of the patent.

Subsequent to those decisions, the Brussels LD considered an application for review of the decision in *Genentech v Organon* under r. 197.3[202]. It did not take the opportunity to directly address the apparent conflict with the approach in *Maguin v Tiru*, however one reading of the decision is that the Brussels LD has now dropped the requirement for validity to be considered in step 2 of its test. The relevant passage from the review decision (which concluded that the *saisie* order had been rightly granted) described step 2 without any reference to validity as follows:

199 UPC_CFI_407/2025, Order of 30 May 2025
200 UPC_CoA_327/2025, Order of 15 July 2025. The same approach was taken in the parallel decision of the Court of Appeal in *Valinea v Tiru* on the same day (UPC_CoA_002/2025, Order of 15 July 2025).
201 UPC_CFI_885/2025, Order of 22 September 2025
202 UPC_CFI_407-408/2025, Order of 12 November 2025

> *48. In the Court's substantive assessment of whether or not to grant the requests (see §48 – 59 Orders) (second step)...*
>
> *...*
>
> *More, specifically, the Court has to assess whether the patent "has been infringed or is about to be infringed".*
>
> *Regarding the standard of proof for these assessments, the Court rightfully referred in its Orders to the LD Mannheim 3 March 2025, UPC_CFI_142/2025 and cited that "a certain degree of plausibility of the infringement or the threat thereof" should be taken into consideration. The Court, upon review, rephrases this standard to "a certain degree of plausibility of the patent being infringed or about to be infringed" with reference to above wording of Art. 60(1) and (3) UPCA. The Court further rightfully stated in its Orders (§37 Orders) that the standard of proof for applicants is lower compared to infringement actions (on the merits) and preliminary measures actions. The Court finally stated rightfully that the burden of presenting and proving facts rests on GENENTECH & ROCHE (referring again to R. 192.3 (second sentence) RoP)."*

The parties had disagreed on the interpretation of "*about to be infringed*" under Art. 60(1) and (3), with Organon arguing that the term should be read as "*imminent*" in line with the urgency assessment for PIs and therefore arguing that the *saisie* order was premature. The Brussels LD disagreed, referring to the Court of Appeal's decision in *Maguin v Tiru* and stating that "*about to be infringed*" has a different meaning to "*urgency*" in the sense of r. 194(2), "*unreasonable delay*" in the sense of r. 211.4 and "*threatened infringement*" in the sense of r.13.1(I)(i). According to the Brussels LD, there must be a risk of infringement and it must be apparent that it will occur in the future, with the specific facts of the case determining the duration of this period. On the facts of the case, it was plausible that Organon's marketing authorisation would be granted in early 2026 and Organon had made various additional statements to indicate that it intended to proceed with launch of its pertuzumab biosimilar after the grant of the marketing authorisation.

There have now been numerous successful applications under Art. 60 and for a range of different measures. A relatively low threshold has been applied for *ex parte* orders to date, with the Courts citing risks surrounding the ease of deletion and alteration of digital data in many cases such as *Mammoet v PTS*[203], *Prinoth Spa v Xelom*[204] and *3V Sigma v AGA*. Situations where there is an upcoming or ongoing trade fair have also resulted in *ex parte* orders being granted.

While some Courts choose to look for a protective letter on the file as part of the formal requirements (such as in *3V Sigma v AGA* and *Mammoet v PTS*), the Brussels LD in *Genentech v Organon*[205] took the view that checking for a protective letter is not a requirement of r. 192. In *Nanoval v ALD Vacuum*[206], a protective letter was filed but a *saisie* order was granted anyway.

In *Centripetal v Palo Alto*[207], following an initial rejection of the request by the Mannheim LD, the Court of Appeal accepted an *ex parte* application (referring it back to the Mannheim LD to make the order) for real-time monitoring of the respondent's network solution, with the respondent being given only 2 hours to seek legal advice upon the applicant team's arrival at the premises. The 2 hour grace period was also limited to the real-time monitoring element of the order due to its technical complexity; all other parts of the inspection could be implemented immediately upon arrival. As it turned out, access to the system could not be obtained at the premises identified in the order (a co-working space with only one sales person). The Court declined to impose a penalty on the defendant,

203 UPC_CFI_16/2025, Order of 22 January 2025
204 UPC_CFI_127/2025, Order of 18 March 2025
205 UPC_CFI_407/2025, Order of 30 May 2025
206 UPC_CFI_63/2025, Order of 28 May 2025
207 UPC_CFI_636/2025, Order of 3 June 2025

ruling that it had not breached the order[208]. This underlines the importance of conducting in-depth research to identify the premises most likely to yield information; once lost, the element of surprise cannot be regained if alternative premises are identified later.

In *3V Sigma v AGA*[209] an order for samples of the alleged infringing product and relevant technical documents was granted by the Milan LD. This decision indicated that documents not at risk of destruction/alteration will not be included in an order. In this instance, accounting documents were excluded as retention of these documents was required under Italian national law (so these was no risk of destruction). However, the Brussels LD took a different approach in *Genentech v Organon*[210], finding that it was sufficient for there to be a probable risk that regulatory material would be moved from its initial location, even if it would be improbable that such material would be destroyed.

Ordinarily, the use of a *saisie* report is restricted to particular UPC proceedings in accordance with r. 196(2). However, this does not appear to be a strict requirement. In *Genentech v Organon*, the Brussels LD permitted use of the report in parallel Dutch national proceedings.

208 UPC_CFI_636/2025, Orders of 25 July 2025 & 2 October 2025
209 UPC_CFI_342/2025, Order of 19 May 2025
210 UPC_CFI_407-408/2025, Order of 12 November 2025

FRAND[211]

FRAND enthusiasts will be aware that the UPC's second substantive SEP decision engaging with a FRAND defence, *Huawei v Netgear*[212], was issued at the end of 2024. The Munich LD took the view that there was no urgent need for a referral to the CJEU, notwithstanding the fact that the European Commission's amicus brief[213] in *HMD v VoiceAge*[214] proposed a very different approach to assessing the steps to be taken by SEP holders and implementers according to the CJEU's *Huawei v ZTE*[215] decision than that adopted by the Court in *Panasonic v Oppo*[216] or more generally in the German national courts. The Munich LD elected instead to take into account the (non-binding) opinion of the Commission in its assessment.

In doing so, the Munich LD largely rejected the Commission's approach. The key points are summarised below.

1. Notice – the Court dismissed the formulistic approach set out in the amicus brief, taking a more permissive attitude to the notice requirement in Huawei v ZTE.
2. Declaration of willingness – the Court observed that behaviour must be considered in an overall view, rather than simply focusing on an initial statement made by the implementer.
3. Further behaviour – the Court emphasised that transparency goes both ways, referring to the licensing conditions (known to the patent holder and not the implementer) and the circumstances surrounding infringements (known to the

212 For those readers not accustomed to the world of standard-essential patents (**SEPs**), the English Judge, Birss J, provided helpful guidance in *TQ Delta v ZyXEL* [2019] EWHC 1089 (Pat) on the distinction between fair, reasonable and non-discriminatory licence terms: **FRAND** and **RAND**: "*This action concerns standard essential patents which relate to the ITU-T standard concerned with DSL. The obligation which the standard essential patent holders have relating to this standard setting environment is to give licences on a RAND basis. The obligation is RAND rather than FRAND. I will almost certainly use the expression FRAND by force of habit but it makes no difference whatsoever.*"
212 UPC_CFI_9/2023, Decision of 18 December 2024
213 Amicus brief sent to the Munich Higher Regional Court on behalf of the European Commission dated 15 April 2024
214 Decision of Munich Regional Court I, dated 25 May 2022, under appeal (at that time) to the Munich Higher Regional Court.
215 Case C-170/13 *Huawei Technologies Co. Ltd v ZTE Corp., ZTE Deutschland GmbH*
216 UPC_CFI_210/2023, Decision of 22 November 2024

implementer and not the patent holder). The Court also noted that complaints that have only been raised by an implementer in Court against the background of an impending injunction are not sufficient. In other words, an implementer must raise objections at the appropriate time in commercial negotiations, providing a patent holder with an opportunity to remedy any deficiency in that context, in order for the objection to be taken into account in the assessment of willingness.

4. Offer by the patent holder – in contrast to the Commission's view, the Court held that the last offer by a patent holder is the relevant one, reasoning that the patent holder is only obliged under antitrust law to provide a licensing route that satisfies FRAND. The Court also noted that a patent holder can fulfil its obligations by offering a pool licence (see further discussion below) and that the offer does not have to be ready to sign.

5. Counteroffer, information and security – the Court held that the infringer may only benefit from a FRAND defence if it has submitted a concrete counteroffer without delay and has provided appropriate security and information on its acts of use. Security must be at least in the amount of the counteroffer. It was not necessary, in the circumstances of this case, to consider whether security needs to be at the level of the patent holder's latest offer.

On the facts, Netgear did not show sufficient willingness, delayed negotiations, and failed to provide security or sufficient information on its acts of use. The FRAND defence was, therefore, dismissed.

Since these issues were not corrected by the end of the hearing, it was not necessary to consider whether it is possible for an implementer to remedy an earlier failure in the *Huawei v ZTE* process.

As noted above, the Court indicated that a patent holder may satisfy its FRAND obligation by offering a pool licence. The Court went as far as saying that the Sisvel pool could be taken as a FRAND offer because the defendant had not made a presentation to the contrary and that in itself would discharge the FRAND defence. This appears to be at odds with one of the fundamental underpinnings of pool licences, from an anti-trust perspective, that they are not forced upon implementers as bilateral licensing is always an option.

Anti-anti-suit & anti-anti-enforcement injunctions

There have been a number of SEP cases in which the Court has been called upon to flex its interim measure muscles to prevent applications for foreign anti-suit and anti-enforcement injunctions.

The first of these was *Avago v Realtek*[217]. Realtek brought a US action against Avago, which was referred to the Delaware District Court, alleging a breach of a licence agreement and claiming, among other things, a prohibition against Avago pursuing claims for infringement of SEPs in Germany or enforcing any injunction in Germany.

Avago obtained an anti-anti-suit injunction from the Munich Regional Court and sought the same, on an *ex parte* basis, from the Munich LD.

The Court held that subject-matter jurisdiction for the adoption of such interim measures was present in Art. 32(1) on the basis that interference with the patentee's property right by prohibiting the assertion of that right is to be regarded as an infringement of the underlying patent. Exercising its discretion to order interim measures, the Court observed

217 UPC_CFI_755/2024, Order of 9 December 2024

that the applicant had substantiated the imminent infringement of its property rights, and that the order was urgent both in terms of time and objectively.

Realtek ultimately withdrew the US lawsuit and the wider dispute settled.

A similar interim measure was obtained in *Huawei v Netgear*[218]. Following a lack of response to an infringement notice and follow-up correspondence, Huawei filed proceedings in the Düsseldorf Regional Court, and subsequently in the Munich LD of the UPC, on patents declared essential to the Wi-Fi 6 standard. Huawei also obtained a cease and desist order in patent infringement proceedings in China.

Netgear filed an anti-trust action in the Central District of California. This included an application for an anti-suit/anti-enforcement injunction, aimed at depriving Huawei of the opportunity to enforce its patent tights relating to the Wi-Fi 6 standard in the UPC.

The Munich LD granted Huawei an *ex parte* interim measure prohibiting the pursuit of this anti-suit/anti-enforcement injunction in the US Court. The prohibition was subject to a €250,000 per day penalty, and Huawei was required to provide a security deposit of €3,000,000.

In *Nokia v Sunmi*[219], an *ex parte* interim measure was granted by the Munich LD to protect Nokia against a potential anti-suit injunction in Sunmi's rate-setting claim in China, on the basis that filing an anti-suit injunction is a "*classic litigation strategy*". Nokia had served Sunmi with UPC infringement proceedings and the Court reasoned that Sunmi would not want to give up the advantage of its first filed rate-setting claim proceeding without interruption from infringement claims in the meantime.

The interim measures ordered were limited to preventing Sunmi from applying for an anti-suit injunction and were not framed to prevent Sunmi from pursuing its rate-setting claim. The order was also limited in geographical scope to China.

The penalty for non-compliance was set at the same level as in the *Huawei v Netgear* case. The Court reasoned that the circumstances justified an exceptional departure from the usual rule of ordering security on an *ex parte* interim order on the basis of the low potential damages and urgency.

SunPatent Trust and Dolby sought and obtained *ex parte* interim measures in respect of a lawsuit filed by Roku in the US District Court of Massachusetts that included a request to prohibit the enforcement of injunctive relief in the UPC during the course of the US action. The Court subsequently[220] held that the defendant, Roku, should bear the costs of the interim measures application, notwithstanding the fact that it was made *ex parte*, on the basis that it was objectively reasonable for the claimants to assume at the time that they would not be able to exercise their rights without judicial assistance.

In *InterDigital v Disney*[221] an anti-anti-suit injunction was awarded by the Mannheim LD against Disney, followed by an order that it may be served on Disney's representatives in the main UPC proceedings. The defendants' representatives refused to submit the acknowledgement of receipt, claiming that the order had not been properly served on the basis that they were not appointed as authorised representatives in the anti-anti-suit proceedings. This resulted in an order for service on Disney's representative personally by bailiff, with a €100,000 penalty for non-compliance. The Court observed that a party cannot limit the authorisation to conduct a legal dispute before the UPC to individual acts at the party's discretion. It also noted that the conduct of the defendants' representative

218 UPC_CFI_791/2024, Order of 11 December 2024
219 UPC_CFI_112/2025, Order of 19 February 2025
220 UPC_CFI_59/2025, Order of 19 May 2025 & UPC_CFI_58/2025, Order of 19 May 2025
221 UPC_CFI_445/2025, Order of 9 July 2025

was in violation of the Code of Conduct for Representatives, r. 290.2 (Fair Conduct of Proceedings).

Anti-interim licence

In *Interdigital v Amazon*[222], InterDigital applied for and obtained *ex parte* interim measures from the Mannheim LD with the aim of preventing Amazon from obtaining specific performance of an interim licence or a declaration that InterDigital would be an unwilling licensor if it failed to offer an interim licence.

While the logic of an "*anti-interim licence injunction*" is clear in the case of an application by Amazon to obtain specific performance that would compel InterDigital to enter into an interim licence (something that the UK Court has not done, or given any indication it would do, to date), mirroring that discussed above for anti-suit injunctions, it is perhaps surprising to see this extended to a declaration that does not tie the hands of foreign courts.

The reasoning of the Mannheim LD was that a UK interim licence declaration would amount to a *de facto* prohibition on foreign litigation, on the basis that it is the UK Court's stated intention that the declaration would serve the purpose of causing the implementer to consider changing their position. The Court regarded it sufficient that negative consequences would be imposed on the patent holder if it did not enter into an interim licence. This would appear to significantly broaden the scope of interim measures, which could potentially be used in the context of a party seeking an order or even merely encouragement from a judicial body to mediate a dispute for example.

In response, the English Patents Court granted Amazon a temporary anti-anti-suit injunction on an *ex parte* basis to block InterDigital from interfering with Amazon seeking final FRAND relief in the UK, and expedition of those proceedings[223]. The anti-anti-suit injunction was granted for the short period until the *inter partes* hearing, which took place at the end of October. At the time of writing, no decision had been handed down.

Disclosure of comparable licences

Analysis of comparable licences is one of the principal techniques employed by courts to assess FRAND royalty rates for SEPs. We covered the decision of the Mannheim LD in *Panasonic v Xiaomi*[224] on this topic in last year's Review. The Mannheim LD had an opportunity to consider a request for disclosure of comparable licences again this year in *Huawei v Mediatek*[225]. In response to an application by the defendant, the Mannheim LD ordered disclosure of the licence agreements relied on by Huawei in its statement of claim, but not specific additional licence agreements identified by Mediatek. These additional licence agreements were said to relate to network infrastructure rather than mobile devices, but the Court reasoned, in any event, that it is up to the patent holder whether to submit comparable licence agreements, and if so, how many it submits in the proceedings to counter a possible FRAND objection by the defendant.

222 UPC_CFI_936/2025, Order of 30 September 2025

223 [2025] EWHC 2708 (Pat)

224 UPC_CFI_218/2023, UPC_CFI_219/2023 & UPC_CFI_223/2023, Order of 30 April 2024

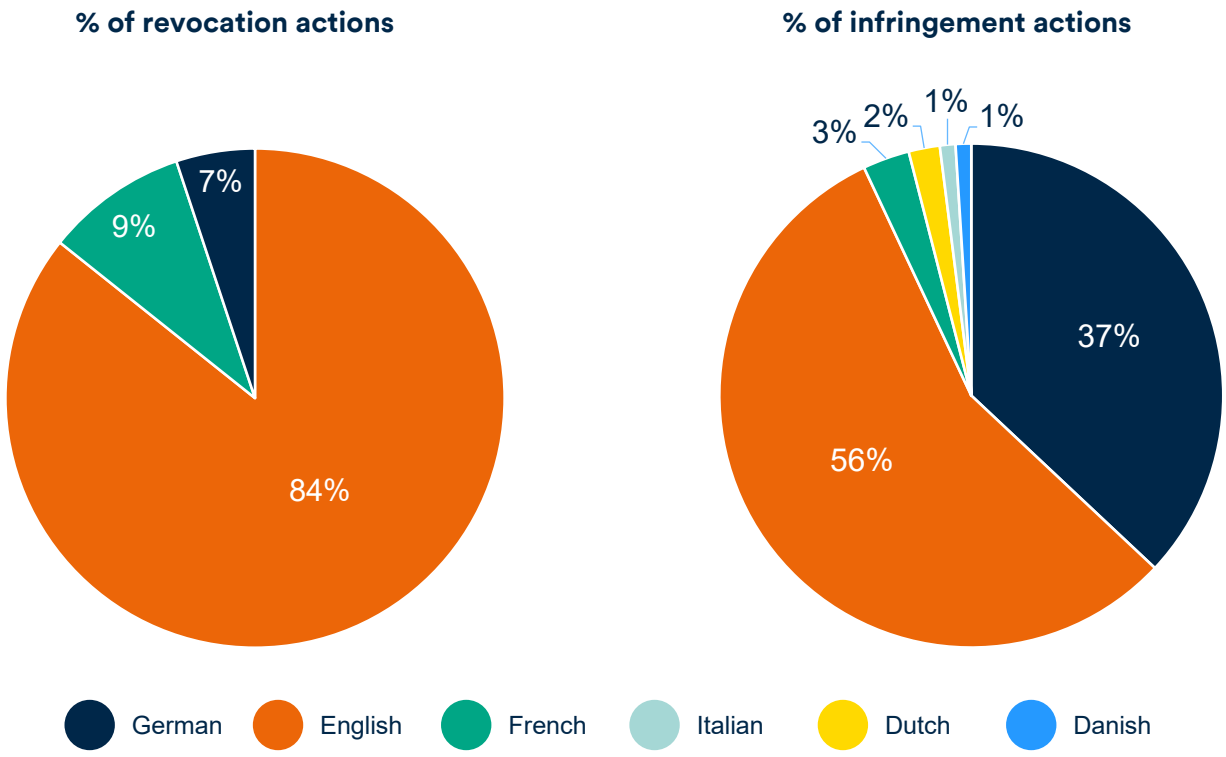
225 UPC_CFI_247/2025, Order of 16 September 2025

Language of proceedings

The use of the English language has continued to dominate in revocation actions in 2025, and is now also the language of proceedings in the majority of infringement actions. This shift towards the UPC becoming a predominantly English language court has been encouraged by UPC judges to promote the efficiency of the Court.

Pursuant to Art. 49(1), the language of the proceedings must be one of the official languages of the Contracting Member State(s) hosting a division or another language designated pursuant to Art. 49(2). All divisions of the UPC offer the possibility to use English. Should a party wish to change the language of the proceedings to the language of the granted patent for reasons of fairness (Art. 49(5)), the Court will consider all circumstances relating to the specific case.

An example of the application of Art. 49(5) in 2025 is the decision of the Munich LD in *Renault v Avago*[226]. Renault, the defendant in the main proceedings, requested that the language of the proceedings be changed from German to English. Renault's reasoning was that English was generally the language of the technical field of the patent, titled "*Method and system for a centralised vehicular electronics system utilizing Ethernet with audio video bridging*" and was used in various submitted exhibits and prior art. The parties were also internationally active companies whose business language was English. Avago countered, among other things, that the alleged infringement took place solely in Germany and this was where the decision would need to be enforced.



Language of proceedings in UPC revocation and infringement actions as of 29 November 2025

226 UPC_CFI_448/2025, Order of 3 July 2025

The Munich LD noted that the circumstances of the parties, and in particular the nature of internal communications, is of greater relevance than the conditions in which the final decision may be enforced in the territory where the alleged infringement occurred. The Court therefore granted Renault's request on the basis that the circumstances invoked by Avago failed to overcome the general principle established by case law that the Defendant's perspective is the decisive factor, all else being equal.

Third party access to documents

The Court of Appeal established last year in *Ocado v AutoStore*[227] that in order for members of the general public to gain access to written pleadings and evidence while proceedings are pending in the UPC, they must demonstrate a direct interest in the subject-matter of the proceedings. This effectively rules out access to documents in pending proceedings by general members of the public, although they may obtain access after proceedings have come to an end. Cases in 2025 have provided further clarity as to when a party will be considered to have a direct interest and therefore be granted early access.

In the case of *Dolby v Beko*[228], concerning pending proceedings before the Düsseldorf LD, the applicant, Epson, was able to show a direct interest in the validity of the patent in suit, since Dolby had brought an infringement claim against Epson in the Hamburg LD based on the same patent in suit and Epson had indicated its intention to make a revocation counterclaim if necessary. However, the Court considered that Epson had failed to make a sufficiently specific reference to the infringement proceedings, notwithstanding the fact that the allegation of infringement was based on the patent being essential to the use of a codec adopted in version 5.0 of the Android TV operating system used by both Beko and Epson.

The Court emphasised that applicants cannot invoke a general interest to inspect the file whilst proceedings are still ongoing. The Court considered, on the facts, that Epson's request went beyond the scope of its special interest, encompassing a general request which may only arise once proceedings have concluded. Access to documents was therefore only granted in relation to the validity proceedings.

In *Nicoventures v NJOY and Juul Labs*[229], the Court of Appeal granted Nicoventures' request for immediate access to written pleadings and evidence in the ongoing validity proceedings between NJOY and Juul Labs in the Paris CD. The request was initially rejected by the Paris CD[230] but the Court of Appeal was satisfied that Nicoventures had a direct interest in the subject-matter as they were involved in ongoing Board of Appeal proceedings at the EPO involving the same patent.

Nicoventures' request encompassed all written pleadings and evidence in the CMS at the point in time at which the order was granted. The Court was prepared to grant access to written evidence and pleadings that had not yet been filed at the time of the request for access but were added to the case file before a party had commented on the request. However, the Court made it clear that blanket requests for pleadings or evidence added after a party comments on the request or after a decision on the request has been issued are not admissible and a separate request would need to be made for access to such documents.

To protect the integrity of the proceedings, the Court imposed the condition that Nicoventures were not permitted to file the written pleadings in question in part or full at any other courts or judicial instances, including the EPO Boards of Appeal. However, this did not prevent Nicoventures from using the same arguments or prior art, or informing the EPO of the arguments or prior art in the UPC proceedings.

227 UPC_CoA_404/2023, Order of 10 April 2024
228 UPC_CFI_135/2024, Order of 9 April 2025
229 UPC_CoA_237/2025, Order of 25 April 2025
230 UPC_CFI_316/2023, Order of 17 January 2025

In *Bhagat v Oerlikon and Himson*[231], Bhagat made a request to access the case file of the counterclaim for revocation brought by Himson in response to Oerlikon's infringement action in the Milan LD. The proceedings concerned a patent that Oerlikon had also asserted against Bhagat in proceedings before the Milan LD[232], though Bhagat had not itself counterclaimed for revocation. Bhagat's alleged interest in the documents related to its application for suspensive effect (discussed further below), which the Court of Appeal had already rejected. The Milan LD did not regard this as a sufficient basis to grant access, also noting that access is not permitted where the information sought can be obtained from other sources, for example on the CMS, or in the final decision made available at the close of proceedings.

Stay of proceedings

The year has seen further refinement of the circumstances and mechanisms for staying proceedings, particularly in the context of parallel EPO opposition or appeal proceedings. Most applications continue to turn on whether a decision from the Opposition Division or Boards of Appeal can be expected "*rapidly*" under r. 295(a). Appellate guidance has emphasised discretion and proportionality, encouraging divisions to manage conflict risk by sequencing hearings and post-hearing steps rather than pausing cases as a rule, while still granting stays where timing and party positions make a swift EPO outcome decisive.

EPO timing

Recent decisions confirm that an imminent Opposition Division hearing does not, without more, satisfy the requirement for a decision "*expected to be given rapidly*" under r. 295(a). In *Meril v Edwards*[233], the Nordic-Baltic RD declined to stay proceedings in circumstances where the Opposition Division hearing was scheduled the day after the UPC hearing. Instead, the Court directed the parties to notify the Court of the Opposition Division outcome so that the Court could decide whether any further procedural steps would be needed. Noting that proceedings before the UPC should usually be conducted to allow the final oral hearing to take place within one year, the Court considered this approach to represent an appropriate balance of interests taking into account the parties' interests and the relevant circumstances of the case.

This reflects the broader trend we observed in the case law last year, namely: the risk of conflicting outcomes can be managed by sequencing the UPC timetable; rescheduling oral hearings until after the Opposition Division decision; holding hearings as scheduled and deciding further steps once the Opposition Division outcome is known; or proceeding to the point of decision and exercising stay powers at that stage rather than halting the UPC action outright.

A further example is *Aylo v DISH*[234], where the Paris CD refused to stay revocation proceedings pending EPO opposition, despite an accelerated Opposition Division timetable and preliminary opinion, because the case was already at an advanced stage and the Court prioritised expeditious, predictable proceedings aimed at a roughly one-year timeline. The panel canvassed the parties after the Opposition Division set oral proceedings for June 2025, and, with no compelling reasons for a stay, kept the UPC hearing on schedule.

By contrast, in *Juul v NJOY*[235], the Court of Appeal stayed a revocation appeal on the parties' agreement, noting that the EPO Boards of Appeal had accelerated proceedings to a hearing likely to overlap with the UPC's own timetable. The Court held that the Board of Appeal decision could be expected before or shortly after the projected UPC hearing ("*in any case rapidly*") and that a stay was therefore warranted.

231 UPC_CFI_240/2023, Order 20 February 2025
232 UPC_CFI_241/2023
233 UPC_CFI_380/2023, Order of 11 December 2024
234 UPC_CFI_198/2024, Decision of 28 May 2025
235 UPC_CFI_237/2025, Order of 28 April 2025

Joint requests

Where parties jointly request a stay under r. 295(d), the Milan LD has stated in *Dainese v Alpinestars*[236] that the Court is obliged to order a stay, notwithstanding the use of the word "*may*" in the RoP. In reaching this decision, the Milan LD relied on Art. 43 and 76(1) and cited previous case law such as *Dolby v HP*[237]. The decision also indicates that partial stays are available: the Milan LD stayed proceedings with respect to one patent while keeping proceedings for a second patent on schedule.

Insolvency stays

In *Visibly v Easee*[238] the Hamburg LD granted a three-month stay under r. 311.1 following Dutch insolvency orders against two corporate defendants. The Court noted that insolvency does not automatically stay UPC proceedings but, upon proof of insolvency, a stay is mandatory and generally covers the entire case. In this case, the presence of a natural person (a company director) as a defendant did not prevent the stay. The Court also recorded that the stay suspended an existing security for costs obligation (with an appeal pending on the security order, the Hamburg LD lacked power to revoke it).

Stays pending referral to the CJEU

In *XSYS v Esko*[239], the Court of Appeal was asked to stay proceedings under r. 266.5 in connection with a prospective CJEU reference. The Court rejected the request, holding that there was no need to refer questions under Art. 267 TFEU, as even the most favourable interpretation of the relevant law for the appellant would not have changed the outcome. Both the referral and stay requests were dismissed.

Expedition of proceedings

Guidance on the expedition of proceedings at the UPC continues to derive primarily from appeal decisions, with the Court of Appeal further clarifying the circumstances in which requests for expedited timetables may be granted.

Under r. 9.3(b), the Court may shorten any time period on a reasoned request by a party. In considering such a request, the Court must balance the interests of both parties while ensuring that the principles of due process are adequately taken into account. The Court has emphasised that expedition will only be granted in exceptional circumstances, and the interests put forward by the applicant must outweigh those of the respondent in having the proceedings dealt with within the timeframe provided for by the RoP.

This approach was affirmed in *Chint v JingAo*[240], where the appellant sought both suspensive effect and expedition of appeal proceedings following an order for security for costs issued by the Munich LD. Chint argued that the requirement to provide security before the appeal was determined constituted an undue burden and requested that the appeal be expedited. The Court of Appeal rejected the request, finding that the interests advanced by Chint – namely, the administrative inconvenience of arranging security and allegations of incorrect reasoning in the impugned order – did not justify expedition at the expense of JingAo's legitimate interest in having the appeal dealt with within the standard timeframe. The Court reiterated that the mere fact of inconvenience or disagreement with the reasoning of the lower court is not sufficient to warrant expedition.

236 UPC_CFI_472/2024 & CFI 181/2025, Orders of 2 June 2025
237 UPC_CFI_457/2023, Order of 29 October 2024
238 UPC_CFI_525/2024 and UPC_CFI_14/2025 Order of 30 July 2025
239 UPC_CFI_483/2024, Order of 16 June 2025
240 UPC_CoA_430/2025, Order of 20 May 2025

Similarly, in *ICPillar v ARM*[241], the appellant requested that the time period for lodging the statement of response be shortened and that the oral hearing and decision be scheduled within a highly compressed timetable. The Court of Appeal again declined to expedite the proceedings, noting that sufficient time for debate must be given and that the circumstances of the case were not so urgent as to outweigh the interests of the respondent and the principles of due process. The Court also observed that the fact the appellant had not used the full time available to lodge its statement of grounds did not justify shortening the respondent's time to reply.

The Court's reasoning in these cases reflects a consistent approach: requests for expedition must be specific, substantiated, and demonstrate a genuine urgency or exceptional circumstance that would justify departing from the standard timetable. Administrative inconvenience, strategic considerations, or dissatisfaction with the lower court's reasoning are unlikely to suffice. The Court has also made clear that expedition should not compromise the principles of equality of arms or due process.

Extensions of time

The UPC applies a rigorously case-managed and front-loaded approach to extensions under r. 9.3(a), granting extensions only on narrowly defined, case-specific grounds. Recent decisions confirm that panels exercise their discretion with marked restraint, consistently emphasising that extensions are exceptional and must be justified by concrete, verifiable circumstances. The Courts are mindful of the need to safeguard both the right to a fair hearing and the UPC's procedural timelines, typically favouring targeted, proportionate adjustments over any wholesale disruption of the written procedure. Harmonisation of deadlines, particularly where staggered service dates or multiple defendants are involved, is permitted to ensure procedural equality and efficient case management, but always without compromising the overall pace of proceedings. Across divisions, panels have repeatedly stressed that the integrity of the UPC's timetable is paramount, and extensions are calibrated to balance party interests against the imperative of swift, predictable resolution.

Standard and discretion

Panels continue to cite the narrow discretion to extend time periods under r. 9.3(a), emphasising that extensions "*should only be used with caution and only in justified exceptional cases*". This formulation was expressly adopted by the Düsseldorf LD in *GSK v Pfizer*[242], where a two-month extension request for the defendant's rejoinder was trimmed to one month. The Mannheim LD has followed the same line, granting a three-week extension in *Fingon v Samsung*[243] and two weeks in *Hurom v NUC*[244], each time balancing the parties' interests against the need to maintain efficient proceedings and uphold the integrity of the timetable set out in the RoP.

Requests for extensions must be anchored in concrete, verifiable facts. In *Fingon v Samsung*, a three-week extension was justified by genuinely new technical material introduced in reply, reliance on third-party software, and the need for expert input (whereas holiday absences and lack of expert availability due to conferences were held to be non-decisive). By contrast, in *Irdeto v SZ DJI*[245], bare assertions of "*technical complexity*" and general preparation needs were too vague to justify a longer extension. Only a limited adjustment was allowed to align later-served co-defendants, with broader extensions declined.

241 UPC_CoA_301/2024, Order of 19 June 2024

242 UPC_CFI_468/2024 & UPC_CFI_687/2024, Order of 4 March 2025
243 UPC_CFI_750/2024, Order of 16 July 2025
244 UPC_CFI_162/2024, Order of 4 August 2025
245 UPC_CFI_344/2025, Order of 27 June 2025

Coordination with EPO proceedings

In *Dainese v Alpinestars*[246], the Milan LD opted for a short, tailored extension under r. 9 as a proportional alternative to a stay, accommodating an imminent EPO decision. With the EPO appeal hearing scheduled for 13 February 2025, the deadline for Alpinestars' Statement of Defence and any revocation counterclaim was extended from 20 January to 27 February 2025, allowing the parties to address the Board's decision while keeping the UPC action moving. The Court anchored its reasoning in the principles of proportionality, flexibility, and fairness, citing r. 9, r. 118, r. 295(a), and Art. 33(10), and provided a defined r. 36 window (further exchanges of written pleadings) for observations on the EPO decision, thereby preserving equality of arms.

Applying the same logic, the Milan LD later granted Dainese a matching extension for its reply/defence to counterclaims and invited the parties to submit a joint plan to harmonise future deadlines across all defendants, including scope to supplement earlier pleadings filed before the EPO decision[247].

Harmonising timetables

Where staggered service dates risk divergent tracks, the Court has harmonised schedules to protect procedural equality and simplify case management, without delaying the overall pace of proceedings. In *Genevant v Moderna*[248], The Hague LD imposed a single Statement of Defence deadline for all 15 defendants, reasoning that streamlining deadlines to the earliest possible date was preferable, especially for defendants in the same corporate group. Similarly, in *Dainese v Alpinestars*[249], the Milan LD aligned deadlines across multiple defendants and invited a joint plan for future milestones.

In *Samsung v ZTE*[250], the Mannheim LD, acting on the parties' agreement, aligned all three ZTE defendants to a single Statement of Defence date, combining a modest extension for the earliest-served entity with a shortening for the later-served entities, and confirmed that the unified date governed any counterclaim for revocation.

Interplay with bifurcation

In *GSK v Pfizer*[251], where the Düsseldorf LD referred the counterclaim for revocation to the Milan CD and proceeded with infringement (discussed further under **Bifurcation** below), the LD granted a one-month extension for the rejoinder because the bifurcation decision had been issued close to the deadline and related CD deadlines had also been extended.

Beyond pleadings: extensions for penalty responses

Panels apply the same cautious, fact-driven approach under r. 9.3(a) to court-set periods outside the main pleading track. In *Hurom v NUC*[252], the Mannheim LD granted only a brief two-week extension for comments on a penalty request, underscoring that the time required to remedy any alleged information deficiency is distinct from the time allowed to respond to the penalty application itself. The Court made clear that generic references to time zones, international coordination, or staff absences due to vacations are insufficient to justify a substantial extension. While a short extension was permitted in light of the summer holiday period, the decision reaffirmed that extensions must be anchored in specific, substantiated circumstances, and should not unduly delay the imposition of penalties or the efficient conduct of proceedings.

246 UPC_CFI_472/2024, Order of 15 January 2025
247 UPC_CFI_472/2024, Order of 7 February 2025
248 UPC_CFI_191/2025 and 192/2025, Order of 16 April 2025
249 UPC_CFI_472/2024, Order of 7 February 2025
250 UPC_CFI_189/2025, Order of 9 May 2025
251 UPC_CFI_468/2024 and UPC_CFI_687/2024, Order of 4 March 2025
252 UPC_CFI_162/2024, Order of 4 August 2025

Procedural posture matters

The Court has also confirmed that extension requests must be brought via the proper route and not embedded in preliminary objections. In *Dainese v Alpinestars*[253], the Milan LD dismissed an attempt to fold a three-month Statement of Defence extension request into r. 19 objections, holding that such relief must be sought separately under r. 9. The Court emphasised that timing relief is a case management question, distinct from jurisdiction or admissibility objections.

Bifurcation

The UPC's approach to bifurcation under Art. 33(3) remains pragmatic, with LDs and RDs typically deciding early (often under r. 37.2) whether to keep infringement and revocation claims together, refer the revocation counterclaim to the CD, or, with the parties' agreement, send the entire case to the CD. This early determination helps set timetables and ensures the right panel composition, including the appointment of technically qualified judges where appropriate.

Default against bifurcation

As highlighted in last year's Review, the prevailing practice is to avoid bifurcation unless procedural economy clearly demands it. Panels frequently retain both infringement and revocation counterclaims, especially where technical expertise can be ensured within the same forum and uniform claim construction is desirable.

Recent decisions reinforce this default position. In *Huawei v Netgear*[254], the Munich LD ordered a joint hearing of the infringement claim and revocation counterclaim, noting both parties' requests and the absence of any reason to separate the issues. Similarly, in *Lenovo v ASUS*[255], the Munich LD retained both claims and requested a technically qualified judge under Art. 18(3). The Düsseldorf LD followed suit in *TRUMPF v IPG*[256] and *Wonderland v Cybex*[257], making early r. 37.2 decisions, emphasising efficiency and the benefits of consistent claim interpretation by the same panel.

Referral where procedural economy demands it

Bifurcation is more likely where a parallel CD revocation action is already well advanced and overlaps substantially with the counterclaim for revocation in an infringement action. In *Daedalus Prime v Xiaomi*[258], the Hamburg LD referred the revocation counterclaim to the Paris CD, which was already seised of a standalone revocation claim based on largely the same prior art, and had already fixed an oral hearing. The Hamburg LD proceeded with infringement, reserving the option to revisit suspension or separation of the proceedings later.

In *GSK v Pfizer*[259], the Düsseldorf LD referred the revocation counterclaim to the Milan CD on the parties' agreed request, but proceeded with infringement (contrary to the defendants' request), noting that a stay under r. 37.4 requires a "*high likelihood*" of invalidity, and that assessing that threshold was not possible at this early stage of the proceedings. The panel reserved the right to revisit a stay as the proceedings developed.

Tiru v Valinea/Maguin[260] illustrates the Court's flexibility. Two infringement actions brought by Tiru before the Paris LD concerning the same patent and the same allegedly infringing furnace were joined for efficiency. However, the revocation counterclaims were referred to the Paris CD, which was already seised of a parallel revocation action commenced by Veolia (in the same company group as Valinea), because the validity issues substantially overlapped, the CD was first seised and was expected to decide more quickly, and referral served procedural economy. The Paris LD

253 UPC_CFI_792/2024, Order of 8 April 2025
254 UPC_CFI_168/2024, Order of 2 January 2025
255 UPC_CFI_302/2024, Order of 27 January 2025
256 UPC_CFI_733/2024 and UPC_CFI_255/2025, Order of 25 July 2025
257 UPC_CFI_807/2024 and UPC_CFI_334/2025, Order of 5 August 2025
258 UPC_CFI_169/2024 & UPC_CFI_436/2024, Order of 16 January 2025
259 UPC_CFI_468/2024 and UPC_CFI_687/2024, Order of 4 March 2025
260 UPC_CFI_130/2025, Order of 22 July 2025

declined to stay the infringement action, citing the parties' shared interest in a prompt merits decision and the operational and economic impact of delayed commissioning of the furnaces, while noting it could later manage coordination through stays under r. 295(m) or conditional relief under r. 118.2.

Across these referrals, two themes recur: (1) an advanced, earlier-seised CD revocation action on overlapping validity material is a strong case management reason to refer; (2) divisions aim to maintain progress on infringement in line with the UPC timetable, preserving the ability to take account of the CD's validity outcome.

Stays post-referral

Panels continue to apply r. 37.4 (stays of infringement proceedings) strictly: a stay is only mandated where there is a high likelihood that the relevant claims will be held invalid. Otherwise, Courts tend to proceed with infringement claims, reserving the right to revisit a stay once the Court file is fuller or the CD's timetable is clearer.

This issue was considered in the Munich LD's merits judgment in *Edwards v Meril*[261]. The Court said that where the CD has upheld a patent in amended form, the usual next step is to decide infringement. Any further stay must be grounded in r. 295(c)(i) (stay pending appeal) or r. 295(m) (stay for the proper administration of justice), and any deviation from proceeding to decide infringement requires a manifest and *prima facie* error in the CD's decision. The panel emphasised that the mere existence of an appeal or dissatisfaction with the CD's reasoning is not enough. The Court also noted that conditional relief under r. 118.2 remains available, but was not warranted in the circumstances because the patent had been upheld, all arguments were addressed, and Meril's procedural tactics did not justify further delay.

Applications to intervene

The UPC maintains a strict approach to applications to intervene under r. 313, requiring a "*legal interest*" that is direct, present, and specific to the relief sought by the supported party. However, where this threshold is met, the Court has shown pragmatism and flexibility regarding the timing and scope of intervention.

Legal interest standard

A prospective intervener must demonstrate a direct and present interest in the specific relief sought, not merely a parallel commercial or factual interest, nor an indirect stake arising from similar products, carve-outs, or market context. The Court has repeatedly emphasised that factual alignment or market similarity alone does not suffice.

In both *Daedalus v Xiaomi*[262] and *Sun Patent Trust v Vivo*[263], the Court of Appeal confirmed that a direct and present interest in the outcome – such as the protection of confidential technical or commercial information – can establish a sufficient legal interest for intervention under r. 313.1. In *Daedalus v Xiaomi*, intervention by MediaTek was allowed because the confidentiality order concerned MediaTek's processor architecture. Similarly, in *Sun Patent Trust v Vivo*[264], the Court of Appeal granted Apple permission to intervene, as a licence counterparty, in Sun Patent Trust's appeal against a confidentiality order by the Paris LD even though Apple's licensing agreements had already been disclosed to certain Vivo employees. The Court held that being a party to the agreements and facing ongoing potential harm from the confidentiality regime was enough to justify intervention, since the appeal could still affect further access and use of the information.

261 UPC_CoA_511/2024, Order of 21 November 2024

262 UPC_CoA_621/2024, Order of 8 January 2025
263 UPC_CoA_755/2025 and UPC_CoA_757/2025, Order of 23 September 2025
264 UPC_CoA_755/2025 & UPC_CoA_575/2025, Order of 23 September 2025

By contrast, in *Accord v Novartis*[265], the Milan CD refused Zentiva's application to intervene in the DNI proceedings. Applying the principles from *Ocado v AutoStore*[266], the Court held that r. 313 requires a legally qualified, direct, and present interest in the specific order sought. Zentiva's interest, based on similar carve-outs from the label for its generic medicine and product overlap with Accord, was deemed merely parallel and not sufficient to establish a direct stake in the requested declaration. The Court clarified that concerns about future Courts being influenced by the reasoning in the present case do not meet the threshold, as *res judicata* principles in EU and national law prevent such "*guiding effect*" from conferring a legal interest.

The Court further advised that future litigants should pursue their own actions rather than seek intervention based on similar factual circumstances. Connections between proceedings on the same patent are properly managed under Art. 33, through bifurcation, stays, or joint decisions. Intervention is not a discretionary case-management shortcut but requires a right endangered by failure to intervene.

Timing and procedural scope

While r. 313.2 ties admissibility of interventions to the written phase, the Court may "*order otherwise*" where justified. In *MediaTek v Daedalus/Xiaomi*[267], where infringement proceedings had been brought against both MediaTek and Xiaomi but the infringement action was not served on MediaTek until many months after Xiaomi (by which time confidentiality orders had been made as between Daedalus and Xiaomi), the Court of Appeal admitted a narrowly tailored intervention by MediaTek, limited to providing oral support to Xiaomi at an appeal hearing, without requiring a statement of intervention or service of earlier pleadings. This approach protected MediaTek's interest in maintaining the confidentiality of information relating to the architecture of its smartphone processors while avoiding delay. The Registry was directed to provide MediaTek with the videoconference details, and MediaTek's existing access to the file via the CMS as a defendant in the infringement action obviated the need for further service. The Court also required Xiaomi and MediaTek to coordinate submissions, confirming that existing time limits would suffice, with discretion to extend if necessary.

Interventions in PI proceedings

Intervention in provisional measures proceedings is permitted only in exceptional cases. In *Insulet v EOFlow*[268], Menarini sought to intervene in the PI proceedings before the Milan CD, arguing that an injunction would affect its upstream contractual position with EOFlow and downstream customer relationships. The Court refused, emphasising that interim measures are summary and non-final, and must not be burdened with steps that risk delay, especially where the would-be intervener can defend its interests in parallel proceedings. Menarini, which was also defending against an application for provisional measures from Insulet, was aware of the parallel case with EOFlow but only sought to intervene after a request for joinder of the proceedings was refused, just before the scheduled hearing. The Court viewed this late intervention as tactical and incompatible with the expedited nature of interim proceedings.

The Court reiterated that a legally qualified, direct, and present interest is required. A *de facto* interest in supporting a party's defence or managing perceived risks of divergent outcomes is not enough. Art. 33 provides the appropriate tools for managing connected cases.

265 UPC_CFI_698/2024, Order of 27 March 2025
266 UPC_CoA_404/2023,
267 UPC_CoA_621/2024, Order of 8 January 2025
268 UPC_CFI_380/2024, Order of 1 October 2024

Relationship with supported party

The Milan CD in *Zentiva/Accord v Novartis*[269] (DNI) emphasised that intervention must be "*in support, in whole or in part*" of the supported party's relief under r. 313.2. The intervener's requested relief must not conflict with or materially diverge from the supported party's remedies and intervention cannot be used to advance autonomous objectives or reshape the party's case. The Court suggested that intervention is most appropriate where the intervener's rights depend on the supported party's rights at issue (e.g. according to licence or distribution agreements), not where the applicant seeks to influence general market guidance or economise litigation costs by joining a similar case.

Applications for suspensive effect

The Court of Appeal continues to treat suspensive effect under Art. 74 as an exceptional remedy, available only where the applicant demonstrates truly compelling circumstances. The default position remains that appeals do not suspend enforcement, and the burden rests squarely on the applicant to establish specific facts evidencing either a manifestly erroneous order or that the appeal would otherwise be rendered devoid of purpose (*ICPillar v ARM*[270]). Generalised assertions, such as vague doubts about validity, reliance on third-party revocation actions, or non-specific claims that "*a decision is expected soon*", are insufficient (*Bhagat v Oerlikon*[271]).

In *Knaus Tabbert v Yellow Sphere & Erwin Härtwich*[272], referred to earlier in this Review, Knaus' application for suspensive effect failed. The Court of Appeal found no manifest error in the remedies ordered by the lower Court. The Düsseldorf LD's refusal to require security for enforcement was justified, as Knaus Tabbert was aware of the patent and had therefore knowingly taken a calculated risk regarding infringement. Further, the fact that the destruction of a caravan could not be reversed did not render the appeal pointless because Knaus Tabbert could be compensated in damages if it was successful on appeal.

Knaus Tabbert was prevented from raising, for the first time on appeal, arguments concerning the patentee's poor financial position as a reason to suspend enforcement on the basis that such arguments should have been made before the Court of First Instance.

Knaus Tabbert's objection to the Court of Appeal's order dismissing its application for suspensive effect was ruled inadmissible[273]. Even if it had been admissible, the Court of Appeal determined that it had been right to disregard allegations about the patentee's finances that had not been raised earlier.

The Court of Appeal also clarified in *Sun Patent Trust v Vivo*[274] that an application for suspensive effect is inadmissible if the statement of appeal has not been lodged and the appeal fee paid. Lodging the statement of grounds of appeal, however, is not a prerequisite.

Not "devoid of purpose"

Suspensive effect is routinely refused where compliance with the impugned order can be reversed or compensated, ensuring the appeal retains practical value even if enforcement proceeds. For example, where security for costs can later be released or interim payments recovered, the appeal is not rendered pointless (*Chint v JingAo*[275]; *Barco v Yealink*[276]). Similarly, undertakings that preserve the *status quo*, such as a patentee's voluntary commitment not to publish a decision pending appeal, undermine arguments that enforcement would irreparably prejudice the appellant (*Meril v Edwards*[277]).

269 UPC_CFI_698/2024, Order of 27 March 2025
270 UPC_CoA_301/2024, Order of 19 June 2024
271 UPC_CoA_12/2025, Order of 16 January 2025
272 UPC_CoA_365/2025, Order of 21 May 2025
273 UPC_CoA_365/2025 & UPC_CoA_413/2025, Order of 17 June 2025
274 UPC_CoA_740/2025 & UPC_CoA_741/2025, Order of 15 August 2025
275 UPC_CoA_430/2025, Order of 20 May 2025
276 UPC_CoA_329/2025, Order of 17 April 2025
277 UPC_CoA_166/2025, Order of 18 April 2025

The manifest error threshold

The threshold for suspensive effect based on manifest error remains high. "*Manifest error*" is interpreted as findings that are clearly untenable even on a summary assessment – a standard repeatedly cited from *Belkin v Philips*[278] and applied to reject relief in cases such as *Fujifilm v Kodak*[279], *Meril v Edwards*[280], and *OTEC v Steros*[281].

A rare example of suspensive effect being granted is the decision in *Easee v Visibly*[282], where an intervening Court of Appeal decision rendered the first instance order legally unsustainable. Specifically, in *AorticLab v Emboline*[283], the Court of Appeal had confirmed that Art. 69(4) does not empower an infringement claimant to obtain security for costs from a defendant, including in response to a revocation counterclaim. The Hamburg LD's order, which had ordered security for costs, was therefore deemed a manifest legal error, justifying suspension for the managing director defendant and provisional suspension for the defendant companies pending resolution of a representation issue.

Information orders and confidentiality

Information orders under Art. 67, which require disclosure of commercial data by infringers, are treated as measures securing a high level of IP protection. The Court will only contemplate suspending their enforcement in truly exceptional circumstances. In *NUC v Hurom*[284], the Court of Appeal declined to suspend enforcement, finding that the applicant's assertions of confidential harm were broad and unsubstantiated, and that the first instance decision already limited use of the information to legitimate purposes, mitigating any risk of misuse.

In *Sun Patent Trust v Vivo*, Sun Patent Trust's application for suspensive effect was refused[285]. The Court of Appeal considered that disclosure of confidential information did not render the appeal redundant as the confidentiality regime could still be modified by the Court of Appeal if necessary. Furthermore, Sun Patent Trust provided no evidence that these confidentiality obligations would be breached.

Procedural handling

Consistent with r. 223.3, the Court may decide applications for suspensive effect without hearing the respondent where appropriate, and without delay, particularly where the applicant's submissions are insufficient to persuade the Court that suspension is appropriate (see, e.g., *Chint v JingAo*[286]; *OTEC v Steros*[287]).

Decisions by default

A default judgment may be issued in accordance with Art. 37(1) and r. 355 if the following conditions are met:

1. the plaintiff requests the issuance of such a judgment;
2. the defendant fails to submit a written response to a document instituting proceedings; and
3. the time limit for responding to the action has expired, thereby ensuring that the defendant had sufficient time to prepare its defence.

In *igus v Whale*[288], the Düsseldorf LD found these conditions to be met where the defendant failed to submit a statement of defence within the three-month response period (r. 23). The service of the statement of claim on the defendant (a company based in China) was deemed proper under r. 271.5(a), which provides for service to be effected at any place within the Contracting

278 UPC_CoA_549/2024, Order of 29 October 2024
279 UPC_CoA_312/2025, Order of 17 April 2025
280 UPC_CoA_166/2025, Order of 18 April 2025
281 UPC_CoA_581/2025, Order of 10 July 2025
282 UPC_CoA_542/2025, Order of 26 June 2025
283 UPC_CoA_393/2025, Order of 20 June 2025
284 UPC_CoA_434/2025, Order of 6 June 2025
285 UPC_CoA_758/2025, Order of 25 August 2025
286 UPC_CoA_430/2025, Order of 20 May 2025
287 UPC_CoA_581/2025, Order of 10 July 2025
288 UPC_CFI_318/2025, Decision of 5 August 2025

Member States where the legal entity has a permanent or temporary place of business. The Düsseldorf LD held that a trade fair stand (in this case the defendant's stand at the "*Hannover Messe*" trade fair) can constitute a temporary place of business if advertising for deliveries is conducted there, a condition which was presumed to be met in this case based on the defendant sending an electronic catalogue to potential customers who visited the stand.

In *Amycel*[289], The Hague LD issued a decision by default that the defendant's brown mushroom strain, sold under the name 'Cayene', infringed Amycel's patent. This was an interesting situation, in that the Court had previously granted a PI against the Polish defendant following an *inter partes* hearing but the defendant's representative at the PI hearing had not been retained for the merits action and would not accept service on the defendant's behalf. Various alternative routes of service (including letters from the Registry and attempted service through a Dutch bailiff) had failed so Amycel filed an application for alternative service on the defendant. Judge-Rapporteur determined that Amycel's service attempts were in accordance with the UPC principles of efficiency and fairness and constituted good service pursuant to r. 275.

A copy of the order of the date of deemed service was sent to the defendant's representative from the PI hearing, who was asked to forward it to the defendant. The defendant eventually registered a representative for the merits action but did not file its statement of defence until after the deadline. Despite a number of subsequent applications to re-establish the rights in respect of the deadline under r. 320, the Court determined that the factual and legal arguments had not changed since the PI hearing so a permanent injunction was issued with immediate effect, alongside other remedies including recall and destruction.

The defendant was also held liable for damages and ordered to pay an interim award of €50,000. A salient reminder that dragging one's feet is generally not a good strategic move in UPC proceedings.

A decision by default must be objectively justified. R. 355.2 outlines that the issuance of a decision by default against a defendant (in a revocation or infringement claim) requires verification that the facts put forward by the claimant justify the asserted claim. The Milan CD provided clarification on this point in *EOFlow v Insulet*[290], emphasising that r. 355.2 requires the Court to verify that the case file contains sufficient, precise and consistent evidence to enable the judgment to be issued.

The Milan CD distinguished between a decision by default against a defendant and a decision by default against a claimant. If a claimant fails to fulfil an obligation (a procedural violation), the decision by default results in the dismissal of the case. In *EOFlow v Insulet*, the revocation application filed by EOFlow was dismissed by default because EOFlow knowingly evaded an order to pay security for costs. This failure impaired the trial and deprived Insulet of reasonable security for recovering legal costs. This dismissal was found to be consistent with the purpose of Art. 69(4), which aims to protect a defendant against an insolvent claimant. The decision to take independent action to invalidate the patent lay with EOFlow, whose refusal to pay the security resulted in the case being dismissed.

Costs related to setting aside a decision by default

The Paris CD addressed the treatment of costs associated with an application to set aside a decision by default in *BMW v ITCiCo*[291]. ITCiCo's application to set aside the Court's decision by default in that case was dismissed without making provision for the costs of the application. BMW applied for rectification of the order under r. 353 on the basis that the

289 UPC_CFI_499/2024, Decision of 21 October 2025

290 UPC_CFI_597/2024, Decision of 22 July 2025
291 UPC_CFI_412/2023, Order of 31 March 2025

order should have required ITCiCo to bear BMW's legal costs of the failed application.

The Court clarified that rectification of orders (r. 353) is limited to clerical mistakes, errors in calculation, or obvious slips, and cannot be used to introduce a judgment on costs. However, since an application to set aside a decision by default is an internal procedural remedy, not suitable for giving rise to a decision on the merits, the Court indicated that a separate decision on the obligation to bear those costs is not required. BMW's costs of the application could, therefore, be claimed and assessed as part of the costs of the main proceedings concluded with the decision by default.

Confidentiality regimes

In addressing confidentiality, the Court balances the claimant's right to be heard and have access to documents against the defendant's interest in protecting confidential information. Both principles must be considered on the facts of the case.

In the absence of agreement between the parties, the UPC has consistently required that a confidentiality club includes at least one named individual from each party, in addition to legal representatives. In *Promosome v BioNTech*[292], the Munich LD reinforced that the confidentiality club must include at least one natural person per party and the legal team, but only those actively involved in the case. Requests to expand the club (e.g., to additional employees or technical experts) must be justified by necessity for the case.

The Court is reluctant to allow large or shifting clubs. In *Huawei v MediaTek*[293] the claimant requested access for up to nine named individuals, but the Mannheim LD limited the club to six, primarily from the legal/IP team, and excluded a technical expert due to insufficient justification, stating that the Court must have consideration of the circumstances of the case before it and that the confidentiality club should not be larger than necessary as this could create practical difficulties in managing the confidential information. Similar reasoning was given in *Vivo v Sun Patent Trust*[294] where the Paris LD refused to allow more than three named employees access to highly confidential information, stating that further expansion was not justified.

The nature of the confidential information will be taken into account by the Court when determining an appropriate confidentiality club. For example, in *Nintendo v Malikie*[295], the Hamburg LD confirmed that highly sensitive business information (sales/profit) can be restricted to a very limited group, and the claimant must ensure no third-party confidentiality obligations are breached. The Court also confirmed that witness names are not trade secrets but must be handled as personal data in line with data protection laws. In *Novartis v Zenvita*[296], the Milan CD confirmed that legal costs and invoices will generally not be considered to be confidential unless they reveal sensitive information such as company strategy, financial capacity or the importance of the patent as a corporate asset.

In evidence preservation applications, the confidentiality club may initially be very narrow (legal representatives only) but can later be expanded to include individuals from each party. In *Maguin v Tiru*[297], the Paris LD emphasised efficiency, proportionality, and the need for a narrow circle, especially in *ex parte* measures.

Oral testimony

While the norm in UPC proceedings is for expert and fact evidence to be submitted in written form with no oral testimony, the Court has the power under Art. 53 to order experts and witnesses to be heard in person. Some examples of cases where that power has been exercised are outlined below, although they are few and far between.

292 UPC_CFI_846/2024, Order of 10 March 2025
293 UPC_CFI_247/2025, Order of 11 September 2025
294 UPC_CFI_361/2025, Order of 31 July 2025
295 UPC_CFI_537/2024, Order of 23 March 2025
296 UPC_CFI_382/2025, Decision of 31 July 2025
297 UPC_CFI_813/2024, Order of 6 March 2025

In *Dexcom v Abbott*[298], the hearing of party experts was ordered in the Nordic-Baltic RD. The hearing took place in December 2024, with each witness being taken through examination, cross-examination and questioning from the Court, subject to a twenty minute time limit per round of questioning. The case settled before a decision was issued.

The Paris LD has also heard the oral testimony of a witness (an employee of a subsidiary of the claimant group) on issues of infringement in *HP v LAMA*[299], despite objections from the defendant. The witness was required to testify under oath, with the Court specifying the subject-matter of the questions to be put to the witness. The Court noted that the oral testimony enlightened the panel on the method used to identify the geographical origin of the cartridges alleged to infringe.

In *Advanced Bionics v MED-EL*[300] the Paris CD summoned both experts to be heard in person. This was considered appropriate in light of the parties' respective written expert opinions directly challenging one another. The examination of the experts, by the parties and the panel, was limited to the facts establishing the common general knowledge at the priority date. In the same proceedings, the inventor of the patent at suit was not permitted to be heard in person as an expert or a witness. The CD held that, as inventor, he may have a direct interest in the outcome of the case and therefore did not meet the requirements for impartiality, objectivity, and independence specified in r. 181(1)(a) and (b).

More recently, in *Sanofi v Accord, Stada, Dr Reddy's and Zentiva*[301], the Munich LD ordered that two party experts be heard in person at the oral hearing on factual issues relating to inventive step. The Court specified that the examination of the experts would focus on 10 specific questions relating to what information a person working in the industry at the priority date would have derived from the relevant clinical study, and whether there was a reasonable expectation of success. The order provided a timetable for the experts to be questioned together in a so-called 'hot tub' format, first by the panel (allowing 2 hours), with parties able to put their own questions (for a further 2 hours) after a short break. The hearing took place in October 2025, but the decision has not been reported at the time of writing. At the hearing itself, it was clear that the panel did not welcome "*American-style*" questioning by the parties. The judges appeared to find the 'hot tubbing' of experts based on their own pre-prepared questions a more useful exercise.

In other cases, more limited involvement of experts at the hearing has been permitted. For example, in *Winnow v Orbisk*[302], The Hague LD allowed the remote attendance of experts and the experts were asked by the judges to give their opinion on one aspect of the common general knowledge during the hearing, nothing more.

Withdrawal

The UPC has begun to make a name for itself as a venue for promoting settlement between parties. Since the UPC's opening, the withdrawal of actions and procedural applications has become a recurring feature of the early case law. The past year has seen a significant number of cases where parties have withdrawn infringement actions, revocation counterclaims and procedural applications (such as for costs or confidentiality). The Court's approach has evolved, providing greater clarity on the requirements, consequences, and cost implications of withdrawal under r. 265.

The Court has consistently held that a claimant may withdraw an action at any time before a final decision, provided the other party does not have a legitimate interest in a decision (see for example *Abbott v Dexcom*[303],

298 UPC_CFI_430/2023, Order of 7 October 2024
299 UPC_CFI_358/2023, Order of 13 November 2024
300 UPC_CFI_338/2023, Order of 26 December 2024
301 UPC_CFI_145-148/2024, Orders of 15 September 2025 (there are two orders of the same date, one dealing with r. 105.5 following the second interim conference, and one summoning the party experts to the oral hearing)
302 UPC_CFI_327/2024, no written order
303 UPC_CFI_424/2023, Order of 29 January 2025

Qualcomm v Shenzhen[304] and *NEC v TCL*[305]). Express consent from the opposing party is not required if they are given an opportunity to object and do not do so (*Bentley v Network Systems*[306]). In several cases, both sides have withdrawn their claims (this was the case, for example, in *Abbott v Dexcom*, *Valeo v Magna*[307] and *Ona v Ekahau*[308]), leading to the closure of proceedings without a decision on the merits.

Under r. 265.2(c), a cost order is generally required when withdrawal is permitted. However, if both parties agree to bear their own costs and make no application, the Court will not issue a cost order (*Abbott v Dexcom*[309], *Eyesmatch v Microsoft*[310] and *GSK v Pfizer*[311]). The same withdrawal principles apply at appellate level.

A notable development is the routine reimbursement of 60% of the court fees to the claimant when an action is withdrawn before the closure of the written procedure (r. 370.9(b)(i)). This approach has been applied in cases such as *Qualcomm v Shenzhen*[312], *NEC v TCL*[313], *GSK v Pfizer*, and *Eyesmatch v Microsoft*. If withdrawal occurs after the written procedure or oral hearing, reimbursement may be lower or not granted. For example, in *Dexcom v Abbott* only 20% of the court fee was reimbursed and in *ICPillar v Arm*[314] the Court awarded a 40% reimbursement due to the late stage of the withdrawal.

This approach arguably incentivises parties to reach early settlement, allowing parties to withdraw actions with minimal procedural hurdles and clear guidance on costs and fee reimbursement.

The Court has also permitted the withdrawal of applications for costs and confidentiality, clarifying that no cost order is warranted for the withdrawal of such applications (*Edwards v Meril*[315] and *Avago v Tesla*[316]).

In-house UPC representatives

The position in relation to the ability of in-house counsel to represent their employers before the UPC has changed since last year's Review and there may now be scope for suitably independent in-house counsel to act in the UPC.

As discussed in last year's Review, the Paris CD in *Suinno Mobile v Microsoft*[317] ruled that an application by Suinno was inadmissible due to lack of independence (under Art. 48) of the UPC representative who had filed the application. In February 2025, the Court of Appeal[318] rejected Suinno's appeal and confirmed the Paris CD's position in relation to that particular in-house representative. However, it did not uphold the Paris CD's interpretation of "*independence*", instead setting out the broader principle that it is possible for an in-house representative to act as a company's UPC representative, so long as they are able to act independently.

The Court of Appeal held that Art. 48 means that a natural person may not self-represent, and since there is no distinction in the text between natural and legal persons it follows that a corporate party must use a UPC representative who is as distant as they would be were the party a natural person. This would not be the case for individuals with high levels of financial or administrative powers, or significant shareholders in the corporate party. In this case, Suinno's representative was its managing director and main shareholder and was found to have extensive administrative and financial powers within Suinno.

304 UPC_CFI_390/2024, Decision of 28 January 2025
305 UPC_CFI_153/2024, Decision of 22 January 2025
306 UPC_CFI_170/2024, UPC_CFI_171/2024, UPC_CFI_167/2024, Order of 7 March 2025_
307 UPC_CoA_689/2024, Order of 13 January 2025
308 UPC_CFI_99/2024, Order of 5 September 2025
309 UPC_CFI_402/2023, Decision of 10 January 2025
310 UPC_CFI_486/2025, Decision of 12 September 2025
311 UPC_CFI_468/2024, Decision of 11 April 2025
312 UPC_CFI_421/2024, Order of 28 January 2025
313 UPC_CFI_487/2023, Order of 15 January 2025
314 UPC_CFI_495/2023, Order of 13 December 2024
315 UPC_CFI_501/2023, Order of 9 April 2025
316 UPC_CFI_52/2023, Order of 23 December 2024
317 UPC_CFI_164/2024, Order of 16 September 2024
318 UPC_CoA_563/2024, Decision of 11 February 2025

The Court of Appeal separately considered what is meant by a representative's "*independent exercise of duties*" (as contemplated by Art. 48(5)). On this point, it diverged from the CJEU's interpretation[319], which precludes any in-house lawyer from representing their employer on the basis that they lack independence. Instead the Court interpreted Art. 48(5) as excluding "*any representative who fails to act independently, whether employed or not*" but held that the mere fact of a representative being employed by their client is not sufficient to undermine their independence.

On its divergence from the CJEU case law, the Court noted that the CJEU's case law on this issue applies to EU Courts, but not national Courts of Member States. The Court reasoned that the UPC is a Court common to the participating Member States, subject to the same obligations under Union law as any national court of the Contracting Member States (Art. 1) and is thus not an EU Court. The Court therefore, like the national courts of its Contracting Members States, did not consider itself bound by the CJEU's interpretation of Art. 19(5) of the Statute of the CJEU[320].

A further order was made by the Court of Appeal the day after *Suinno* concerning representation in *Meril v Respondent 1 and SWAT Medical*[321]. Here, the Court of Appeal decided that the fact that a party is a lawyer or European Patent Attorney does not exempt them from the requirement of separate representation under Art. 48. Respondent 1, a European Patent Attorney and UPC Representative, was precluded both from self-representing in a third party access request for pleadings and evidence pursuant to r. 262(1)(b) and from representing SWAT Medical, the latter decision being based on the incompatibility of his position as Chair of the SWAT Medical Board with independence.

The Court also dismissed the proposal for a separate law firm to act as a representative of SWAT Medical since no particular practitioner had been named.

Costs

The fundamental principle governing cost outcomes at the UPC is that reasonable and proportionate legal costs and other expenses incurred by the successful party shall, as a general rule, be borne by the unsuccessful party, up to a ceiling set in accordance with the RoP. This principle is derived from Art. 14 of the Enforcement Directive 2004/48/EC. Where a party achieves only partial success, the Court has the discretion to apportion costs equitably or order that the parties bear their own costs.

The application of this principle is exemplified in *Edwards Lifesciences Corporation v Meril*[322]. The claimant (Edwards) was successful in the infringement action but only partially successful in defending the counterclaim for revocation. The Court had initially ordered that an equitable distribution required the defendants to reimburse 100% of the claimant's reasonable and proportionate costs in the infringement action and 75% of the claimant's reasonable and proportionate costs in the counterclaim(s) for revocation. The defendants sought rectification of this order to clarify that the claimant should bear 25% of the defendants' costs on the counterclaim, arguing that this was necessary to ensure that the Court's distribution of the costs burden was all-encompassing. The Court rejected this request, noting that the wording of the original order has the effect that the claimant shall bear the remaining 25% of its costs of the counterclaim and the defendants shall bear all of their own costs.

319 See C-515/17 P, C-561/17 P and C-573/11 P
320 Protocol (No 3) on the Statute of the Court of Justice of the European Union, C 83/210
321 UPC_CoA_635/2024, Decision of 12 February 2025
322 UPC_CFI_380/2023, Order of 2 September 2025

The Court requires proof that costs claimed are both reasonable and proportionate. If requested by the Judge-Rapporteur under r. 156.1, the party claiming costs must provide sufficient written evidence, as failure to substantiate costs may lead to dismissal of the request. For instance, in *Novartis v Zentiva*[323], Novartis had not provided invoices, relying instead on an internal affidavit, and was awarded only the minimal undisputed amount of €3,000.

Applications for costs incurred during PI appeal proceedings must be filed with the Court of First Instance. A number of decisions have indicated a preference for conducting an overall assessment of costs rather than parcelling out costs solely based on the outcome of the PI phase if the merits phase is pending, citing proportionality and efficiency concerns.

In *SharkNinja v Dyson*[324], the Court of Appeal noted that the one month period for lodging an application for a cost decision pursuant to r. 151.1 begins with the service of the decision in the proceedings on the merits, not with the service of an order on provisional measures. However, if an applicant does not start proceedings on the merits, for example because a PI application has been unsuccessful, r. 150 and 151 apply *mutatis mutandis*, such that a party can seek its costs from the unsuccessful party in the absence of a merits decision.

In *Insulet v EOFlow*[325], the Milan CD, referring to *SharkNinja*, maintained that where a PI is followed, irrespective of its outcome, by an action on the merits, any decision on the costs must be considered at the end of the proceedings on the merits. The costs of the case, including the costs of a PI appeal, were therefore considered following the first instance decision on the merits[326], and give a useful snapshot of a costs assessment in the UPC.

Insulet's total eligible costs for the PI were €702,292 but Insulet was awarded only €162,292 after the Court deducted amounts already effectively reimbursed in a parallel case against EOFlow's distributor, Menarini. The Court characterised Insulet's choice to bring almost identical actions before two different divisions with two different legal teams as lawful but disproportionate.

Since Insulet had not provided a costs estimate for the merits phase, the Milan CD chose to deal with this on a preliminary basis under r. 150.2, making an interim award of €200,000. This figure took into account the recoverable costs cap of €600,000 (based on the value of the case of €7,500,000) and the fact that the defence in the merits phase reiterated many of the arguments presented in the PI but nonetheless incurred expenses at least a third of the value of those of the PI.

The costs of proceedings are not inherently covered by confidentiality under r. 262A or by attorney-client privilege. However, confidentiality regarding costs may be granted in specific circumstances where the information reveals sensitive corporate details (*Insulet v EOFlow*[327]). Furthermore, while the Court may refuse to restrict the opposing party's access to full cost information necessary to defend against unreasonably incurred costs (to uphold the right to a fair trial), it may restrict public access to such documents under r. 262.2, as fees are typically negotiated case-by-case, and a party has a legitimate interest in keeping those rates confidential from the public (*Novartis v Zentiva*[328]). Cost information cannot be withheld from the Court itself on the grounds of confidentiality, as the confidentiality procedure (r. 262A) applies to third parties, not the Court.

323 UPC_CFI_382/2025, Decision of 31 July 2025
324 UPC_CoA_297/2024, Order of 20 January 2025
325 UPC_CFI_380/2024, Order of 15 February 2025
326 UPC_CFI_597/2024, Decision of 22 July 2025
327 UPC_CFI_477/2025, Order of 5 June 2025
328 UPC_CFI_382/2025, Decision of 31 July 2025, citing UPC_CFI_367/2023, Order of 30 July 2024

The UPC generally does not award interest on assessed costs. Neither the UPCA nor the RoP provides a legal basis for such a claim in costs assessment proceedings, unlike procedures for determining damages or compensation (r. 125 and 131). In *Edwards Lifesciences v Meril*[329], the applicant (Edwards) specifically requested that the fixed costs be subject to interest at five percentage points over the respective base rate. Edwards argued that the reimbursement of interest resulted from the corresponding application of r. 125 and 131, noting that without interest, the time value of the invested funds would be disregarded, resulting in a financial disadvantage due to lost interest gains. The Munich LD definitively rejected this request, finding that there was no unintended regulatory gap justifying the application of r. 125 and 131 to costs assessments.

Security for costs

The starting point for security for costs is that Art. 69(4) explicitly and deliberately restricts the possibility of ordering security to being "*at the request of the defendant*". While r. 158 employs a broader test of allowing a request by "*one party*", the Court of Appeal has confirmed in *AorticLab v Emboline*[330] that Art. 69(4) does not provide a legal basis for granting security for costs at the request of the claimant in an infringement action. This restriction is based on the rationale that the rule exists primarily to protect the defendant against an insolvent claimant who initiates an action, thereby compelling the defendant to incur legal costs.

Although the defendant formally becomes the claimant in a counterclaim for revocation, the Court of Appeal held that the counterclaim is intrinsically linked to the original infringement action and would be a necessary defence in response to the claim initiated by the patentee. Therefore, the defendant (as counterclaimant) may also request security for costs incurred through the counterclaim for revocation. Crucially, the claimant in the infringement claim (the defendant in the revocation counterclaim) cannot request security in response to the counterclaim, as that would "*unreasonably limit the defendant in its defence*". If a defendant were forced to provide security merely to raise a validity defence in an action they did not initiate, they could be faced with a default judgment/ injunction if they lacked the financial means to do so, creating an unbalanced situation. This overturned a previous ruling by the Munich LD, which had ordered AorticLab to provide €200,000 in security to Emboline[331].

In *Audi AG v Network System Technologies LLC*[332] the Court of Appeal affirmed that the Court exercises its discretion in ordering security for costs based on whether the claimant's financial position gives rise to a "*legitimate and real concern*" that costs ordered may not be recoverable, or may only be recoverable in an unduly burdensome way. The initial burden of substantiation rests with the defendant requesting the security. However, once credible facts are presented, the burden shifts to the claimant to substantiate their financial situation, as they typically possess this evidence.

Proof of actual insolvency is not required; it is sufficient if doubts exist regarding the recoverability of a future costs order. This concern arises frequently in cases involving non-practising entities (**NPE**s) or licensing entities. In *Headwater Research LLC v Motorola*[333], the Munich LD found sufficient grounds for concern. The claimant, an NPE, was relying on a patent licensing business model. Doubts were reinforced by a "*low*" credit rating reported by Experian and exposure to significant cost risks arising from being involved in numerous US patent infringement proceedings. The claimant failed to adequately substantiate its financial capacity, liquid assets, or the valuation of its patent portfolio. The court pointedly observed that "*Innovation power and entrepreneurial spirit*" do not constitute enforceable assets. Similar concerns arose in *Total Semiconductor v Texas Instruments*[334], where the US claimant

329 UPC_CFI_249/2023, Order of 10 January 2025
330 UPC_CoA_393/2025, Order of 20 June 2025
331 UPC_CFI_628/2024, Order of 16 April 2025
332 UPC_CoA_217-219-221/2024, 17 September 2024
333 UPC_CFI_127-149/2024, Order of 3 July 2025
334 UPC_CFI_132/2024, Order of 12 September 2025

was recently founded, lacked an operative business (i.e. had no current revenue) and operated from a co-working space, which the Mannheim LD viewed as a "*warning sign*" indicating the business might not be permanent. Furthermore, the claimant had provided only vague statements regarding financial commitments from its parent company to cover potential cost reimbursement claims.

One situation in which security for costs was not granted despite concerns that the claimant would not be good for the money occurred in *Gisela Mayer v NJ Diffusion*[335], where the request was dismissed as inadmissible after the infringement claimant entered "*redressement judiciare*" and an administrator was appointed under French law. The Paris LD found that granting security in such circumstances would contravene the principle of equality of all creditors of NJ Diffusion by putting Gisela Mayer in a better position than other creditors.

Where a claimant is domiciled within the EU, enforcement risks are generally not a relevant parameter because UPC decisions are directly enforceable in Member States (Art. 82). When dealing with claimants domiciled outside the EU, such as the US, the defendant bears the specific burden of showing that enforcement would be "*unduly burdensome*". The Düsseldorf LD, addressing a US-domiciled claimant in *Hologic v Siemens Healthineers*[336], held that this requires evidence not only of the applicable foreign law but also of its practical application.

The determination of the amount, type, and period for providing security falls within the Court's discretion. The security amount is typically guided by the maximum recoverable costs determined by the value of the proceedings. The recoverable costs ceiling must reflect the combined value of the infringement action and any counterclaim for revocation. Importantly, the value of the proceedings reflects the claimant's objective interest at the time of filing the action, according to r. 370(6). In *Suinno v Microsoft*[337] the Paris CD held that any subsequent reduction in the damages claimed is deemed immaterial to the initial determination of this value.

In *Total Semiconductor v Texas Instruments*[338], the Court of Appeal provided guidance on the procedural nature of these orders. An order concerning security for costs (r. 158) is classified as a case management order (r. 333). While a Judge-Rapporteur may issue the order, the Judge-Rapporteur is not competent to decide on leave to appeal the order. That decision must be reserved for the panel following panel review (r. 333).

If the factual circumstances underlying the security order change (e.g., in relation to insolvency risk or enforceability), the affected party may apply to the Court to revoke the order or vary its terms. In *Visibly v Easee*[339], the Hamburg LD considered this a necessary power to keep the measure consistent with its protective purpose.

One recent decision of the Munich LD addresses a number of factors in the determination of security for costs applications, in particular the burden of proof, the relevance of the financial status of co-claimants and the calculation of estimated costs. In *BFexaQC & ParTec v NVIDIA*[340], the defendants sought €168,000 in security for costs, citing ParTec's liquidity issues and the risk of unenforceability. Evidence included press reports of unpaid salaries and halted projects, which the Munich LD considered sufficient to shift the burden to ParTec to provide substantiated evidence of its financial liquidity (such information being in ParTec's hands, rather than the defendants). The Court was unconvinced by ParTec's counterarguments and ordered the provision of security for costs of €80,500 by ParTec.

335 UPC_CFI_363/2024, Order of 19 June 2025
336 UPC_CFI_758/2024, Order of 21 May 2025
337 UPC_CFI_164/2024, Order of 27 December 2024
338 UPC_CoA_651/2024, Order of 14 January 2025 & UPC_CFI_132/2024, Order of 12 September 2025
339 UPC_CFI_525/2024, Order of 26 June 2025
340 UPC_CFI_729/2025, Order of 28 October 2025

There were no doubts as to the financial capacity of the other claimant, BFexaQC, but the Court determined this to be irrelevant as the two claimants are not jointly and severally liable for costs, but liable on a pro rata basis. In reaching a figure of €80,500 to be deposited by ParTec, the Court took into account the following: (i) although the costs cap for the case was €200,000, the scale assumes that recoverable costs will generally be below the ceiling; (ii) the costs of a future counterclaim for revocation should be taken into account when calculating the costs cap and estimated recoverable costs (such counterclaim not having been filed in advance of the application for security as the time limit under r. 23 and r. 25 had not yet expired); (iii) based on the representation costs submitted by the defendants to date, total costs of representation were estimated by the Judge-Rapporteur to amount to €150,000; and (iv) of that amount, €75,000 was attributable to BFexaQC on a pro rata basis.

Looking ahead to 2026

As will be apparent from this year's Review, 2025 marked a huge step forward for the UPC in terms of case law development and case management, which appears to have given patentees increased confidence in the new system. What can we expect from 2026?

- Additional guidance from the Court of Appeal on key issues as merits proceedings reach the appellate stage. We have already seen different panels of the Court of Appeal coordinating on the approach to inventive step in *Meril v Edwards* and *Sanofi v Amgen* and it seems likely that this will be the direction of travel in future as the Court of Appeal seeks to harmonise approaches across the various divisions at first instance. Guidance from the Court of Appeal would be welcomed on topics including the application of the doctrine of equivalents and the test for infringement of second medical use claims.
- Further testing of jurisdictional boundaries by the UPC, buoyed by the *BSH v Electrolux* decision. In this regard, it will be interesting to watch the interplay with national courts as they also reassess their jurisdictional limits. We have already seen a cross-border permanent injunction issued by the Munich Regional Court based on infringement under the doctrine of equivalents in a dispute between Regeneron/Bayer and Formycon. Will other national courts follow suit, and what does that mean for the UPC?
- A significant increase in Court fees from 1 January 2026. On 4 November 2025, the Administrative Committee adopted amendments to the Table of Court Fees, the relevant provisions of the RoP and the Guidelines on the determination of Court fees. The new fees reflect an adjustment for inflation, a 10% increase in value-based fees for appeals and the introduction of value-based fees for provisional measures and other applications, although there are

measures to mitigate these effects for SMEs. Whether or not this curbs patentees' current enthusiasm for the new court system remains to be seen.

- The UPC's Patent Mediation and Arbitration Centre (**PMAC**) is expected to open for business in 2026, providing a further forum for dispute resolution in Europe. Parties looking for a confidential mechanism to resolve patent disputes, particularly those involving issues beyond substantive patent law (including rate-setting, licensing and other contractual issues), may now turn to the PMAC. Attracting parties away from established arbitral institutions like the London Court of International Arbitration and the International Chamber of Commerce to the untested PMAC for patent-related disputes is likely to be an uphill battle but the PMAC's association with the UPC may give it a fighting chance.
- The *SPT v Vivo* case in the Paris LD may provide the UPC with an opportunity to grapple with setting a FRAND rate for a global portfolio. The Court of Appeal is set to look at Vivo's preliminary objection concerning whether a patentee can seek a FRAND rate setting claim.
- Additional litigation in the pharmaceutical space. After a slow start, pharmaceutical litigation is beginning to gain momentum in the UPC and Boehringer Ingelheim's success this year in obtaining a pan-UPC PI based on imminent infringement in Portugal may encourage other pharmaceutical companies to take a chance on the UPC, particularly if national prospects are less favourable.

Whatever the year may bring, we look forward to reporting on it next year.

Bristows UPC

The authors

James Boon
Partner

James is a representative at the UPC and specialises in patent litigation with a particular focus on high tech disputes. He has more than 20 years of experience litigating standard essential patents and dealing with issues relating to FRAND.

Lalya Camara
Litigation Support Manager

Lalya has a passion for the procedural aspects of litigation and assists with managing patent litigation know-how and the research and production of Bristows' Irides weekly update, a round-the-world summary of notable patent cases and legal updates, including the UPC.

Charlie French
Partner

Charlie is an experienced IP litigator and UPC representative. She focuses predominantly on patent disputes in the pharmaceutical and biotechnology sectors. In addition to her experience in the English courts, she coordinates multinational patent litigation strategies for clients and has a particular interest in the UPC.

Matthew Raynor
Of Counsel

Matthew's practice focuses on patent litigation, particularly in the technology and telecommunications sectors. He advises on UK and cross-border litigation, SEP and FRAND disputes, global IP strategy and patent licensing, combining technical expertise with strategic insight.

Lucy Sewter
Litigation Technology & Knowledge Manager

Lucy has extensive experience in patent litigation and cross-border actions. She manages litigation knowledge with a strong focus on the UPC, curating and delivering updates on the Court's proceedings and procedural developments to keep teams and clients ahead of the curve.

Eden Winlow
Associate

Eden is a UPC representative, as well as a qualified European and Chartered (UK) Patent attorney with experience across the full life cycle of pataents. Eden works predominately in patent litigation within the tech sector, where he utilises his knowledge of mechanical/ electrical engineering and physics.

Naoise Gaffney
Of Counsel

Naoise is a dual-qualified patent litigator, admitted to practice before the UPC and as a patent attorney in both Europe and the United States. With an academic background in life science and computer science, and ten years' in-house experience, he is adept at handling complex disputes across both life sciences and high-tech sectors.

Patrick Newlands
Associate

Patrick has a background in aerospace engineering and advises on a range of patent litigation issues covering the technology and life sciences sectors. He has experience of actions where there has been cross-border coordination, including in the UPC.

Florence Plisner
Associate

Florence is an experienced intellectual property litigator whose practice spans the range of IP rights for clients in various industries. Florence is a representative at the UPC.

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Bristows LLP
100 Victoria Embankment
London EC4Y 0DH
T +44 20 7400 8000

Bristows LLP
Avenue des Arts 56
1000 Bruxelles
Belgium
T +32 2 801 1391

Bristows (Ireland) LLP
18 - 20 Merrion St Upper
Dublin 2 D02 XH98
Ireland
T +353 1 270 7755

bristows.com