Unified Patent Court
Einheitliches Patentgericht
Juridiction unifiée du brevet

Opening presentation

Dr Klaus Grabinski, President of the UPC Court of Appeal

Judicial Symposium on Intellectual Property (JSIP) 2024, Tokyo, 24 October 2024

All written and said is my personal view and not a communication of the UPC Court of Appeal.

I. Career

Career

- Study of law at the Universities of Trier, Geneva and Cologne
- Award of doctorate of law at Trier University in 1991
- Legal traineeship, 1989-1992
- Judge at the Düsseldorf Regional Court, 1992-1997
- Law clerk at the Federal Court of Justice, 1997-2000
- Judge at the Düsseldorf Higher Regional Court, 2000-2001
- Presiding Judge at the Düsseldorf Regional Court, 2001-2009
- Judge at the Federal Court of Justice, 2009-2022 (Vice Presiding Judge, 2020-2022)
- President of the UPC Court of Appeal and Chairman of the UPC Presidium since 2022

II. Characteristics of the Unified Patent Court (UPC)

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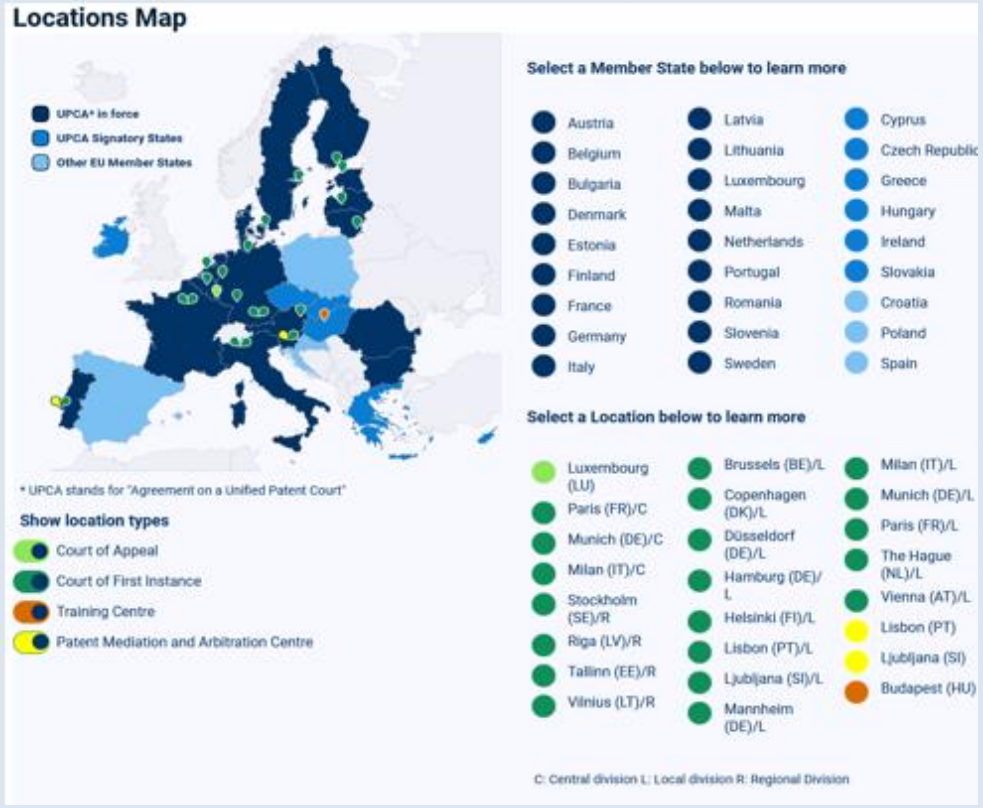
Characteristics of the Unified Patent Court (UPC)

The Unified Patent Court

- is a court common to several (currently 18) EU Member States,



- UPC Agreement in force.
- Signatory State of the UPC Agreement.
- EU Member State that has neither signed nor ratified the UPC Agreement.

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Characteristics of the Unified Patent Court (UPC)

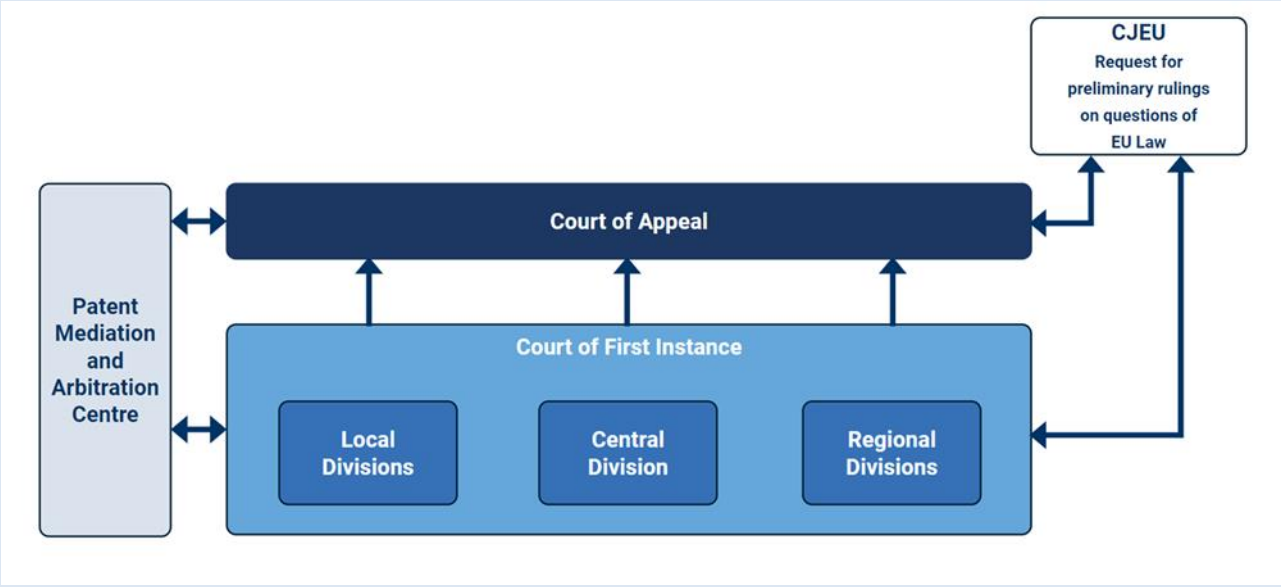
The Unified Patent Court

- is a specialist court that
- has jurisdiction on the validity and infringements of
  - European Patents with Unitary Effect (Unitary Patents) and
  - European Patents (Bundle Patents)
    - that have not been opted-out.

Characteristics of the Unified Patent Court (UPC)

The Unified Patent Court

- comprises a Court of First Instance with a Central Division, Local and Regional Divisions, a Court of Appeal and a Registry.



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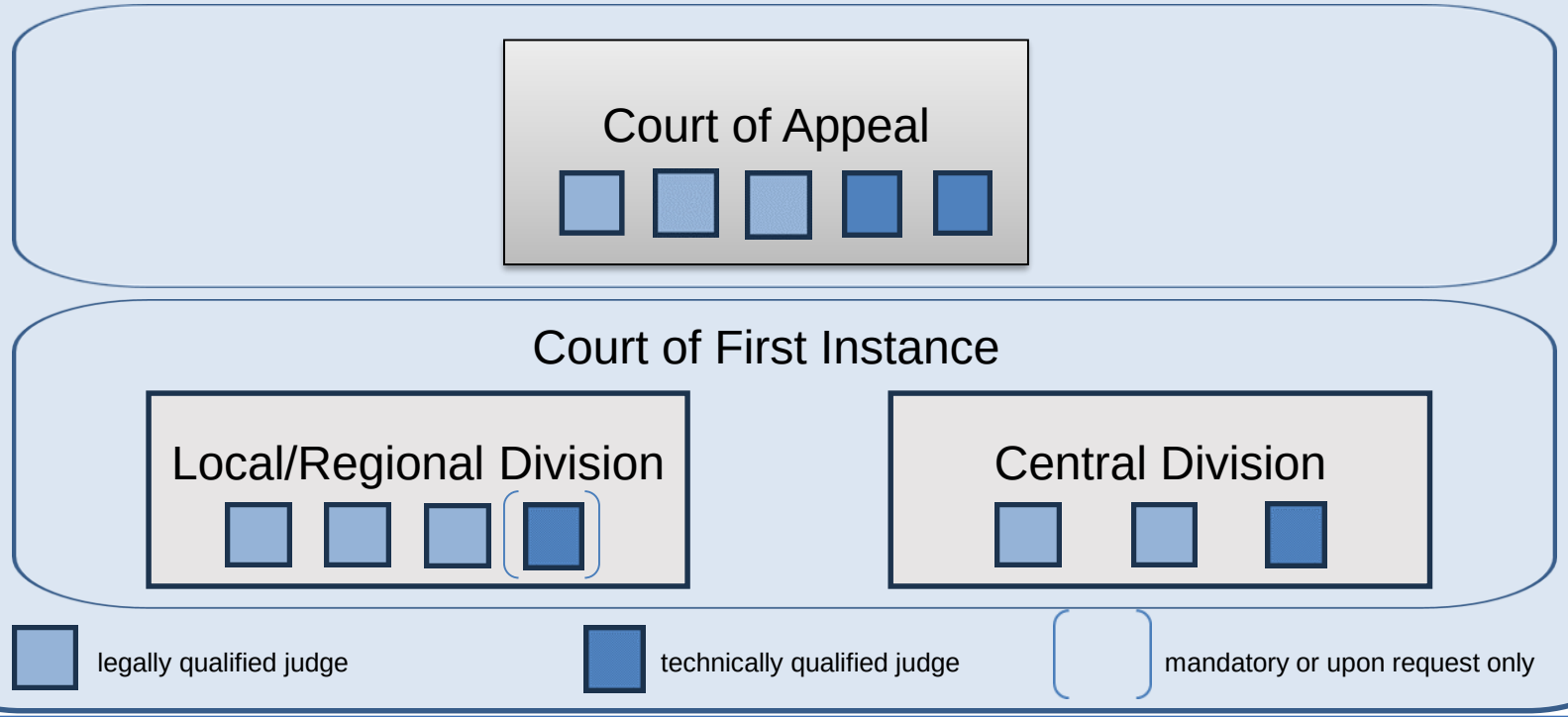
Characteristics of the Unified Patent Court (UPC)

The Unified Patent Court

- decides by panels of legally qualified judges (LQJ) and (in most cases) technically qualified judges from different UPC Member States



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Characteristics of the Unified Patent Court (UPC)

Proceedings before the Unified Patent Court consist of

- a written procedure
  - front loading
  - strict deadlines
- an interim procedure
  - aims at preparing the oral procedure and explore possibilities for a settlement of the case
- an oral procedure
  - endeavour to have it taken place within 1 year whilst recognising that complex actions may require more time.

Language of proceedings

The language of proceedings before the Unified Patent Court

- Local Division
  - Official language(s) of the State hosting the Local Division or
  - English
- Nordic Baltic Regional Division
  - English
- Central Division
  - Language of the patent (English, German or French)
- Court of Appeal
  - Language of proceedings of the First Instance

Language of proceedings

31 August 2024

III. How can an alleged infringer claim invalidity before the UPC?

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How can an alleged infringer claim invalidity before the UPC?

- The alleged infringer has **two possibilities** to claim invalidity before the UPC.
- It may either

  1) aafter the patent proprietor has brought **an action for infringement of the patent** before a Local or Regional Division or (in exceptional cases) before the Central Division,

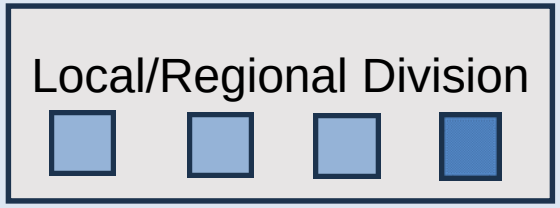
     bring **a counterclaim for revocation** before the same Division, or

  2) bring right away **an action for revocation of the patent** before the Central Division of the UPC Court of First Instance.

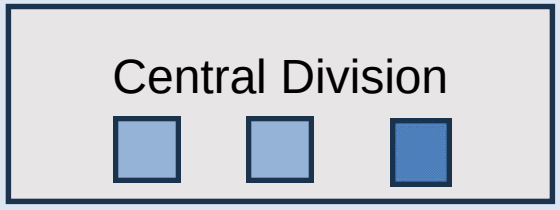
Composition of panels

Composition of panels

- An infringement action with counterclaim for revocation is decided in a Local or Regional Division by a panel of 3 legally qualified judges and 1 technically qualified judge.



- An action for revocation is decided in the Central Division by a panel of 2 legally qualified judges and 1 technically qualified judge.



Stages of proceedings of an infringement action with counterclaim for revocation

Stages of proceedings of an infringement action with counterclaim for revocation

1) Written procedure

- Exchange of written pleadings
  - infringement action
  - defence
  - reply
  - Rejoinder
  - counterclaim for revocation
  - defence
  - reply
  - rejoinder
  - amendment of patent
  - defence
  - reply
  - rejoinder
- Deadlines apply to all statements.

Stages of proceedings of an infringement action with counterclaim for revocation

2) Interim procedure

- Preparation of the oral hearing
- Exploration of possibilities to settle the case

3) Oral procedure

- Preliminary introduction to the case by the judges possible
- Pleadings of the parties
  - Time limits may be set in advance
- Hearing of witnesses and experts. Judges and parties may put questions.
- Endeavour to complete the oral hearing in one day.

Written procedure

4) Decision on the counterclaim for revocation/action for revocation

- Total revocation of the patent
  - with *erga omnes* effect
  - in the Contracting Member States in which the patent has been validated.
- Partial revocation of the patent (upon request of amendment)
  - with erga omnes effect
  - in the Contracting Member States in which the patent has been validated
- Rejection of the counterclaim/action for revocation.

IV. Recent developments in patent disputes before the UPC

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Actions and Appeals filed before the UPC

Recent developments in patent disputes before the UPC

- The UPC is up an running since 1 June 2023.
- **389 cases have been filed in the Court of First Instance** as of 30 September 2024, including
  - 192 actions for infringement
  - 103 counterclaims for revocation
  - 45 actions for revocation
  - 49 actions for preliminary injunction, preservation of evidence and inspection
- **96 appeals, mainly procedural appeals but also appeals in preliminary injunction and preservation of evidence cases, have been filed in the Court of Appeal** as of 30 September 2024

Case law on patent claim interpretation

- Court of Appeal order of 26 February 2024 - NanoString/10x Genomics
  - **Interpretation of patent claims**
    - The patent claim is the decisive basis for determining the protective scope of the patent.
    - Description and drawings must always be used as an explanatory aid.
    - The patent has to be interpreted from the point of view of a person skilled in the art.
    - These principles apply to the assessment of an infringement and the legal validity of a patent alike.

Case law on obviousness

- **Obviousness**
  - It can be **a starting point for the assessment of obviousness** that a piece of prior art would have been of interest to the person skilled in the art (psa) who, at the priority date of the patent, was seeking to find a solution of the problem underlying the patent.
  - In UPC CoA, 26 Feb. 2024 - NanoString/10x Genomics, it was the assumption that one of the pieces of prior art “D6”, put forward by the defendant, would have been of interest to the psa who at the priority date of the patent at issue, was seeking to develop high-throughput optical multiplexing methods for detecting target molecules in a sample.

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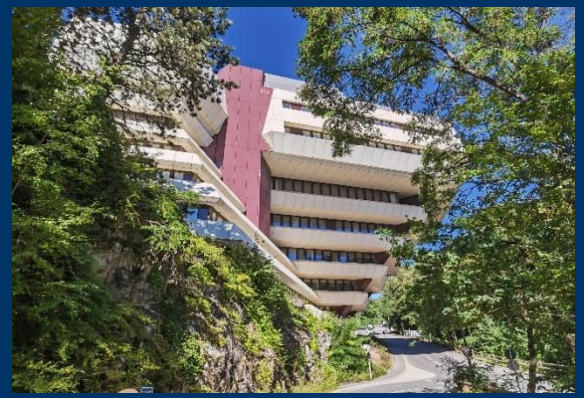

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Thank you for your attention